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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LESLIE EMERY

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Appeal 2019-002179  
Application 14/932,894  
Technology Center 3600

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Before EDWARD A. BROWN, CHARLES N. GREENHUT, and  
WILLIAM A. CAPP, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 6–9, 11, 13–15, and 20–23. *See* Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as the inventor, Leslie Emery. Appeal Br. 3.

### CLAIMED SUBJECT MATTER

The claims are directed to a flexible animal shoes. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A flexible animal shoe, comprising:
  - a base, the base including at least an adjustable width defining at least one perimeter;
  - two or more overlapping plates, the two or more overlapping plates disposed within an interior perimeter of the base, wherein the adjustable width of the base is adjusted by slidably aligning the two or more overlapping plates within the at least one perimeter defined by the base, the adjustment operable to at least one of increase or decrease a degree of overlap among the two or more overlapping plates;
  - a cuff, the cuff including at least five independent substantially flexible panels coupled with the base along at least a portion of the at least one perimeter of the base; and
  - at least one removable girdle configured to securably wrap around at least a portion of the cuff, the at least one girdle including at least:
    - at least one strap with an upper portion and a lower portion;
    - at least one fastener, the at least one fastener securably coupled with the at least one lower portion and configured to receive the at least one upper portion; and
    - at least one heel pad configured to be placed over a heel of a hoof.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
St. John	US 1,043,978	Nov. 12, 1912
Lysiak	US 1,435,169	Nov. 14, 1922
Battle	US 4,212,356	July 15, 1980

## REJECTIONS

Claims 7, 14, 20, 21, and 23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Non-Final Act. 3.

Claims 1, 6–9, 11, 13–15, and 20–23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Non-Final Act. 5.

Claims 1, 6–9, 11, 13–15, and 20–23 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over St. John, Lysiak, and Battle. Non-Final Act. 7.

## OPINION

### *The Written Description Requirement*

New or amended claims which introduce elements or limitations which are not supported by the as filed disclosure violate the written description requirement. *See, e.g., In re Lukach*, 442 F.2d 967 (CCPA 1971). The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation. *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). Although there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath, Inc.*, 935 F.2d at 1563–64.

When an explicit limitation in a claim is not present in the written description it must be shown that a person of ordinary skill would have understood that the description requires that limitation. *Hyatt v. Boone*, 146 F.3d 1348, 1353, (Fed. Cir. 1998). In an appropriate situation, drawings may be used to provide descriptive support required by 35 U.S.C. § 112, first paragraph. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1565. If the originally filed disclosure does not provide support for each claim limitation, a new or amended claim must be rejected under 35 U.S.C. § 112, paragraph 1, as lacking adequate written description.

*Claims 7 and 23*

Claim 7 was amended during prosecution to recite, “the at least one heel pad is disposed such that it exerts a forward force on the heel of the hoof when the at least one removable girdle is fastened.” Claim 23 contains a similar limitation. The Examiner rejected claims 7 and 23 as failing to comply with the written description requirement because, according to the Examiner, “[a]lthough the heel pad is discussed in paragraphs 0022 and 0026, no description as to any force the heel pad exerts or how the heel pad functions in relation to the heel of the hoof is provided.” Non-Final Act. 4, 5.

Based on paragraphs 22 and 26 of the original disclosure<sup>2</sup>, read in conjunction with Figure 1, or any of the other Figures illustrating the heel pad 110 coupled with a girdle, one skilled in the art would recognized, just

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<sup>2</sup> As the Examiner points out, it is unclear why Appellant cites to the substitute specification where the issue is the presence or absence of descriptive support in the original disclosure. Appeal Br. 9. We refer to paragraphs of the original disclosure for purposes of discussing compliance with the written description requirement.

as the Examiner does that when the girdle is fastened, there would be “a constricting force on the cuff.” Ans. 5. It does not follow from this finding that there would “not [be] a forward force on the heel” as the Examiner reasons. Ans. 5; Appeal Br. 9. A circumferential constricting force would generally be expected to produce a radially inward force at all points along the circumference of the element constricted. At the point of the heel such a radially inward force would be in the forward direction with respect to the normal orientation of the animal donning the shoe. Accordingly, for the foregoing reasons, we are not apprised of any reasonable basis for, and do not sustain, the rejection of claims 7 and 23 for failing to comply with the written description requirement.

*Claim 14*

Claim 14 was amended to recite that “the at least five independent substantially flexible panels lay substantially flat against the hoof.” The Examiner correctly pointed out that laying “flat” as recited in claim 14, is a different thing from laying “flush,” as described in the Specification. Ans. 7 (“in the 03/20/2018 Non-Final Rejection, the Office provided evidence that “flat” and “flush” are not synonymous terms.”). The Examiner correctly and persuasively reasons, “Hoofs are known to have undulations and while the panels may be flush against the hoof, matching the surface contour, it is not clear from Appellant’s disclosure that they are flat against the hoof.” *Id.*

Appellant “respectfully points to figures 1 and 18, which show panels resting smoothly and evenly against the hoof.” Appeal Br. 10. Although, as discussed above, there are certain instances where Figures alone may provide sufficient disclosure but that is not the case regarding this issue. If

anything, the Figures show at least one of the five panels, the front-most, appearing to curve around the front of the hoof, directly contradicting the “flat” language in question. To the extent the Appellant relies on the Figures to show a surface texture of being “smooth,” this is not reasonably conveyed by the Figures alone, which are nowhere indicated to represent any particular surface texture, free of undulations, for example. Appellant only points to the portion of the Specification that both Appellant and the Examiner agree describes the “flush” nature of the panels in that they conform to the hoof. Reply Br. 5 (citing Spec. para. 21).

Accordingly, for the foregoing reasons, the Examiner has the better position regarding the lack of descriptive support for the subject matter now claimed according to claim 14.

#### *Claims 20 and 21*

Regarding claim 20, the Examiner found there was no descriptive support for “a lower girdle guide disposed substantially parallel to upper edges of the panels.” Claim 21 contains a similar limitation regarding both the upper and lower girdle guides. Non-Final Act. 4–5. Appellant provides an annotated version of Figure 2 in response. Appeal Br. 11. However, Appellant’s annotations refer only to the parallelism of the *upper* girdle guide with the upper edge of the panels where the subject matter at issue involves the *lower* girdle guide. Were the annotated lines extended from the lower girdle guide as opposed to the upper one, the lines would intersect at roughly a cuff length behind the illustrated cuff. Ans. 9. Thus, as the Examiner correctly points out the Figure provided by Appellant does not provide support for the limitation at issue. Ans. 9. Appellant did not provide

any alternate response in the Reply Brief. Reply Br. 5. Accordingly, we sustain the Examiner's rejection of claims 20 and 21 as failing to comply with the written description requirement.

*Relationship between restriction practice and the written description requirement*

Appellant and the Examiner have each expressed views regarding the relevance of restriction practice to the written description requirement. We expressly note that there was no need to reach such issues to render decisions regarding the § 112 first paragraph rejections of the claims indicated hereinabove. The Examiner's comments concerning the written description requirement are not developed with great detail. Ans. 8–9. We understand the Examiner to be cautioning one of two things.

First, if the subject matter of a dependent claim derives its descriptive support from an embodiment or species, the relevant features of which are nowhere disclosed as combinable with the embodiment or species of its parent claim, there will be a lack of descriptive support regardless of any election or restriction. This can often arise in the context of electing to prosecute a particular invention or species without a linking claim covering both elected and non-elected embodiments. *See* MPEP § 809. However, the Examiner has not made of record whether the Examiner believes that to be the case here, as would be incumbent upon the Examiner in order to sustain a rejection on any such basis. 37 C.F.R. § 1.104(a)(2) (“The reasons for any adverse action . . . will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant . . . to judge the propriety of continuing the prosecution.”); 35 U.S.C. § 132.

The second possible point the Examiner may be alluding to by mentioning the election is that 37 C.F.R. § 145 generally requires claims presented after an office action to be directed to the invention previously claimed and 37 C.F.R. § 1.142(b) permits the Examiner to withdraw from consideration any claims directed to inventions not elected. *See* MPEP § 821.03. Appellant's argument alleging descriptive support is derived from non-elected embodiments may constitute an admission of sorts that the claims in question fail to comply with 37 C.F.R. § 145. However, the fact that the Examiner did not exercise the Examiner's discretion under 37 C.F.R. § 1.142(b) to withdraw claims for that reason, does not, without more necessarily demonstrate that Appellant's disclosure lacks descriptive support under § 112, first paragraph, for those claims.

Accordingly, although we have sustained the rejection of claims 14, 20, and 21 as failing to comply with the written description requirement, on the record before us, we do not rely on Appellant's election in doing so.

### Indefiniteness

#### *Claim 1*

The Examiner correctly determined that the recitations respecting the perimeters of claim 1 render claim 1 unclear and indefinite. Non-Final Act. 6. The first perimeter of the claim is introduced in the clause:

The base including at least an adjustable width defining at least one perimeter

The next perimeter is introduced in the clause:

the two or more overlapping plates disposed within an interior perimeter of the base

First, as the Examiner correctly points out, on its face, it is not immediately clear whether the perimeter defined by the adjustable width of the base can include the interior perimeter of the base. Non-Final Act. 5–6. A structure, particularly a structure that can exhibit a horseshoe or U shape (*see* base elements 816, 826, 836, 846 in Figs. 8A–D), may “include[]” more than one width, such as an inner or outer width, that can define a perimeter. It is important to know whether the at least one perimeter defined by the width of the base can encompass the interior perimeter to determine within which perimeters the elements subsequently indicated in the claim as being within various perimeters must be. However, as the Examiner also correctly points out, the subsequent references to the perimeters are also unclear. Non-Final Act. 6. The first subsequent reference to a perimeter recites:

slidably aligning the two or more overlapping plates within the at least one perimeter defined by the base

This limitation is subject to multiple interpretations that would alter the scope of the claimed subject matter based on the interpretation chosen.

It is not clear if the slidably aligning *function* is what is intended to be restricted to occur “within the at least one perimeter defined by the base,” or if “within the at least one perimeter defined by the base” was intended to refer back to the recited attribute of the overlapping plates that they must be “disposed within an interior perimeter of the base.” Non-Final Act. 6. If “within the at least one perimeter defined by the base” was intended to refer back to the perimeter defined by the adjustable width of the base, the claim is imprecise for omitting the “adjustable width” language. If “within the at least one perimeter defined by the base” was intended to refer back to the recited attribute of the overlapping plates, as the Examiner appears to

believe, the claim is imprecise for omitting the “interior” language. Non-Final Act. 6. Although the claim does not use express language to indicate that the *interior* perimeter is “defined by” the base it would seem implicit that an interior perimeter “of the base” would be coextensive, and therefore effectively “defined by,” an interior edge of the base.

If the omissions noted above occurred where there was no doubt as to what subsequent references to an element were referring, it could potentially be regarded as just imprecise drafting not rising to the level of indefiniteness. However, that would require the skilled artisan to be able to make a more definitive determination regarding this limitation than can be done here. Both possible interpretations would allow the overlapping plates to exit the interior perimeter when they are adjusted, but only the first interpretation would confine the location where the slidably aligning occurs to be within the first of the two perimeters set forth in the claim.

The final reference to a perimeter is:

at least five independent substantially flexible panels coupled with the base along at least a portion of the at least one perimeter of the base.

Aside from the absence of the uncertainty introduced by the functional clause, this limitation presents substantially similar issues to those discussed directly above with regard to the “slidably aligning the two or more overlapping plates within the at least one perimeter defined by the base” limitation.

Appellant’s only argument is that *we* should select Appellant’s preferred one of the possible interpretations. Appeal Br. 12–13. We might do so if this involved choosing the broadest reasonable interpretation or we

were apprised of something in Appellant’s disclosure indicating one particular interpretation was correct over another. However, that is not the case here. The claim is ambiguous due to its express language and that ambiguity is more than a matter of breadth alone. Accordingly, the Examiner is justified in requiring the Appellant to resolve this ambiguity during prosecution while Appellant has the opportunity to do so. *See Ex Parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) *accord In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014). In prosecution before the PTO “it is the applicants’ burden to precisely define the invention, not the PTO’s.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

*Claim 22*

We summarily sustain the rejection of claim 22 under 35 U.S.C. § 112, second paragraph, because this rejection is not contested. *In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (Affirming the Board’s affirmance of an uncontested rejection, holding that the appellant had waived the right to contest the rejection by not presenting arguments on appeal to the Board); *Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“the applicant can waive appeal of a ground of rejection”).

*Obviousness*

The claims subject to the obviousness rejection are argued as a group based on representative sole independent claim 1. Appeal Br. 14–19; *see* 37 C.F.R. § 41.50(c)(1)(iv).

The Examiner relied on St. John for the basic device claimed, with Lysiak teaching the use of five independent panels to surround a hoof and Battle teaching embodying a girdle as a strap. Non-Final Act. 7–8.

Appellant first argues the Examiner’s proposed modification of St. John with the panels of Lysiak would render St. John’s device unsatisfactory for its intended purpose because the gaps in Lysiak’s panels would hinder medicament and moisture control. Appeal Br. 15. The Examiner correctly points out that claim 1 does not call for any gaps between the panels and there is no need for, or indication that the Examiner’s proposed combination was based on, incorporating Lysiak’s gaps between the panels. Ans. 13. “It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). It is also well-established that limitations not appearing in the claims cannot be relied upon for patentability. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). To this end, Appellant shifts the argument to assert that the term “independent” in claim 1 necessarily implies the presence of a gap. Reply Br. 6. Like playing cards arranged in a deck, items can be independent while being arranged without gaps between those items. We are not apprised of any reason to impose this limitation on claim 1 where Appellant chose to omit any language requiring it. Our reviewing court has “cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) (citations omitted).

Appellant's next argument, that St. John fails to teach five panels and Lysiak fails to teach flexible panels (Appeal Br. 16.), merely points out that each reference lacks what the other reference was cited for. Arguments must address the Examiner's Action. 37 C.F.R. § 41.37(c)(1)(iv) ("The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant"). "Non-obviousness cannot be shown by attacking references individually when the rejection is predicated upon the teachings of a combination of references." *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citation omitted); Ans. 13.

Appellant next argues, "element 10 of St. John is a 'tongue' disclosed as being a portion of the cuff, not the girdle." Appeal Br. 17. This argument is not supported by pointing to any specific disclosure in St. John or any other evidence to confirm one skilled in the art would have that understanding. The rear of St. John's boot upper is severed to provide a tongue 10 facilitating access to the frog and under side of the hoof. St. John 2:24–34. As the Examiner correctly explains, this tongue is in contact with and cinched by cords 20 in much the same way as Appellant's heel pad 110 is with the strap of Appellant's girdle 106 (Figure 1). Ans. 17. Thus, we are not apprised of any reason why it is unreasonable to regard tongue 10 as the recited "heel pad" included with the cord 20 in a "girdle" according to claim 1. Battle was cited for the teaching that cord 20 may be replaced with a strap and need not also disclose a heel pad for which St. John was cited. *See* Appeal Br. 17. Again, contrary to Appellant's arguments (Appeal Br. 17) Battle need not teach subject matter for which other references were relied on and combining the teachings of Battle related to the strap securement

method does not require incorporating Battle's specific structure, including the external enlargement 16. *See* Appeal Br. 17.

For the foregoing reasons, we sustain the Examiner's obviousness rejection.

### CONCLUSION

With the exception of the Examiner's rejection of claims 7 and 23 under 35 U.S.C. § 112, first paragraph, the Examiner's rejections are affirmed.

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
7, 14, 20, 21, 23	112	first paragraph, written description	14, 20, 21	7, 23
1, 6-9, 11, 13-15, 20-23	112	second paragraph, indefinite	1, 6-9, 11, 13-15, 20-23	
1, 6-9, 11, 13-15, 20-23	103(a)	St. John, Lysiak, Battle	1, 6-9, 11, 13-15, 20-23	
<b>Overall Outcome</b>			1, 6, 8, 9, 11, 13-15, 20-22	

### TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED<sup>3</sup>

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<sup>3</sup> “The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.” 37 C.F.R. § 41.50(a)(1).