UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RON MAATITA

Appeal 2015-005829
Application 29/404,677
Technology Center 2900

Before JOHN C. KERINS, BIBHU R. MOHANTY, and JILL D. HILL, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the decision of the Examiner rejecting the sole claim on appeal. The Examiner rejected the claim under 35 U.S.C. § 112, first and second paragraphs. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The claim is directed to an ornamental shoe bottom. Figure 1, the only figure in Appellant's Specification, is reproduced below.

FIG. 1

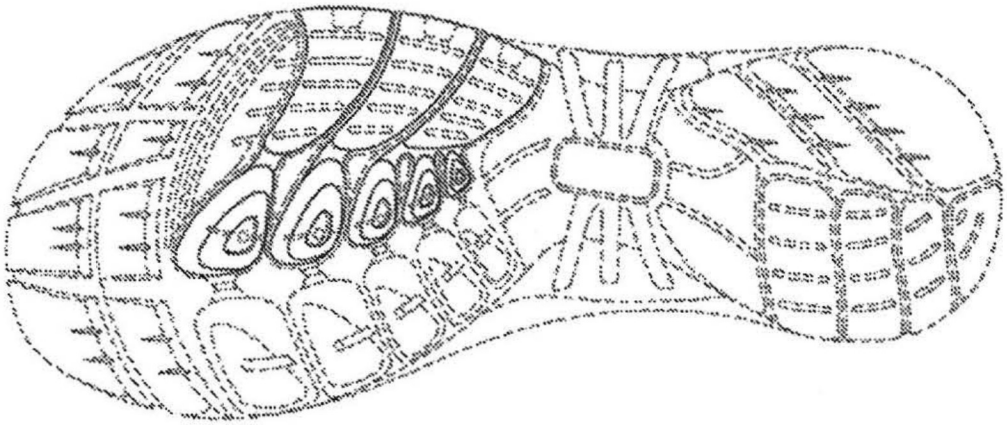
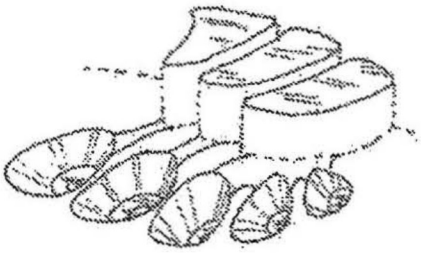


Figure 1 is a plan view of the shoe bottom.

OPINION

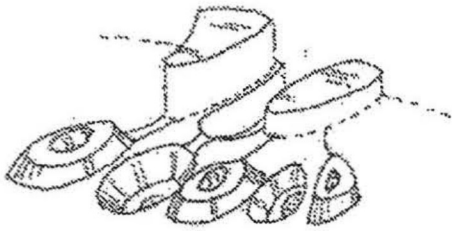
The issue, as argued, boils down to whether Appellant's claim is permissibly broad or impermissibly non-enabled and indefinite. Ans. 14.

The Examiner contends that the claims are indefinite and non-enabled, because the disclosed design is not understandable to a designer of ordinary skill in the art without resorting to conjecture. Final Act. 2. The Examiner gives four examples of the multiple ways that the claimed design could be construed (presumably given such conjecture). The four examples are reproduced below.

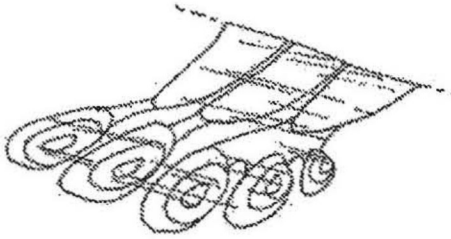


In this attempt to apply Appellant's design, the designer has guessed that the three elements at the edge of the sole are raised and the five oval elements are recessed with flat centers.

In this attempt to apply Appellant's design, the three elements at the edge of the sole are recessed and the five oval elements are raised with concave centers.



In this attempt to apply Appellant's design, alternating elements are raised and recessed with the centers of the five oval elements having convex appearances.



A less imaginative interpretation of the claim would have a designer applying Appellant's design as an image on a flat surface in a single plane with the rest of the bottom surface.

The Examiner's examples above are not numbered and are accompanied by a narrative explaining how each could be construed by a designer. Ans. 10–11; Final Act. 9. According to the Examiner, each of the above designs is patentably distinct, such that the claim covers multiple patentably distinct designs. *Id.*

Appellant admits that the claim covers multiple embodiments (Appeal Br. 9 ("as the Examiner notes, multiple different embodiments can be

encompassed within this scope"); *id.* at 5 (the claim is intended to cover a variety of relative planes of the shapes on the sole that create the depicted visual impression)), does not refute that the claim covers the Examiner's various depicted embodiments, and does not refute that the covered embodiments may be patentably distinct. According to Appellant, "one of ordinary skill has complete discretion as to what may be included within those portions and still remain within the claim scope." *Id.* at 10.

Appellant argues that, even if the Examiner is correct that it is impossible to discern a specific depth for certain of the presently-illustrated design features, such a situation would not lead to the conclusion that the claimed design is not enabled because the depth of the design features is not a limitation of a claimed design. Appeal Br. 4, 10–11. Appellant also contends that the depth of the tread, alleged by the Examiner to be unclear, involves "no particular creativity" and is often selected based on "functional considerations" such as traction needed for an intended use. Reply Br. 5–6.

The Examiner contends that, given the various depicted embodiments, the claims are indefinite because an ordinary designer would have to resort to conjecture. Final Act. 2, 3, 6, 11 (citing *Ex parte Salsbury*, 38 USPQ 149 (Comm'r. Pat. 1938) (a design patent application "should disclose the configuration and complete appearance of the article in which the design is embodied, so fully, clearly and with such certainty as to enable those skilled in the art to make the article without being forced to resort to conjecture.")).

Under this line of reasoning by Appellant and the Examiner, the question of whether the claims are permissibly broad or impermissibly non-enabled and indefinite then turns on whether or when a designer's discretion amounts to requiring conjecture. Appellant argues that a designer having

"some discretion as to how to implement a given claimed design" does not rise to the level of *forcing* a designer to resort to conjecture in making the article. Appeal Br. 9; Reply Br. 10. Appellant contends that the test for indefiniteness is more along the lines of whether one skilled in the art would not be capable of producing the claimed design. Appeal Br. 9. Appellant argues that there is no specific allegation that one of ordinary skill would not be able to produce the claimed design, i.e., that such a person would be incapable of selecting an appropriate depth for any of the illustrated design features. Appeal Br. 3, 5.

35 U.S.C. § 112, first paragraph, states that "[t]he specification shall contain a written description of the invention . . . in such full, clear, concise, and *exact* terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." (Emphasis added). As noted by Appellant, MPEP § 1504.04 give examples of when a rejection under 35 U.S.C. § 112 would be appropriate. Appeal Br. 4. The examples include: (1) inconsistencies between drawing views; (2) visual disclosure of the claimed design as originally filed being of poor quality; or (3) the specification referring to embodiments not shown in the drawing. *Id.* Appellant argues that the pending claims present none of these situations. *Id.*

Because the curvilinear shapes of the different surfaces of the claimed shoe bottom design cannot be determined with any specificity, including whether each is convex or concave, and because the single view does not adequately reveal the relative depths and three dimensionality between the surfaces provided, the Specification does not reveal enough detail to enable the claimed shoe bottom, under 35 U.S.C. § 112, first paragraph. The same

lack of clarity and detail also makes the scope of the claim indefinite under 35 U.S.C. § 112, second paragraph.

We are not convinced that allowing a designer to have "some discretion" in implementing a claimed design, in this instance, is anything but requiring that the designer resort to conjecture to understand or implement the claimed design. It is this requirement for conjecture, here, that moves the claimed design from the realm of being permissibly broad to the realm of being non-enabled and indefinite. Thus, the claim lacks an enabling description providing the required *exact* terms that would enable a designer to make and use the claimed design, as required by 35 U.S.C. § 112, first paragraph. That tread depth in shoe design involves "no particular creativity" and is selected based on "functional considerations" does not refute that the claim lacks the exactness of written description required, particularly when it is unclear whether the claimed surfaces are flat, concave, or convex. The same lack of clarity and detail also makes the scope of the claim indefinite under 35 U.S.C. § 112, second paragraph. Regarding the examples of circumstances warranting a Section 112 rejection set forth in MPEP § 1504.04, Appellant's drawings as a whole, which include only one view, can be described as "being of poor quality" if the topography of the claimed surface cannot be discerned.

We therefore sustain the rejection of the claim as indefinite and thereby non-enabling.

DECISION

We AFFIRM the Examiner's rejection of the claim under 35 U.S.C. § 112, first and second paragraphs for being indefinite and thereby non-

enabling.

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

CERTIFICATE OF SERVICE

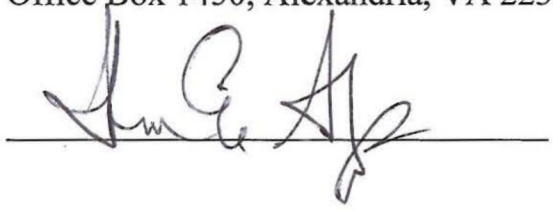
I hereby certify that a copy of the foregoing NOTICE OF APPEAL, and of the attached Decision on Appeal referred to therein, are being deposited with the United States Postal Service as Priority Mail Express in an envelope addressed to Office of the General Counsel, United States Patent and Trademark Office, Post Office Box 1450, Alexandria, VA 22313-1450, that a copy of the said NOTICE OF APPEAL, including the said attachment, is being deposited with the United States Postal Service as Priority Mail Express in an envelope addressed to Patent Trial and Appeal Board, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, and that a copy of the said NOTICE OF APPEAL, including the said attachment, is being transmitted to the Office of the Clerk, United States Court of Appeals for the Federal Circuit by CM/ECF, all on May 15, 2017.

Dated: May 15, 2017

STEVEN E. SHAPIRO

ADDITIONAL CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF APPEAL, and of the attached Decision on Appeal referred to therein, are being deposited with the United States Postal Service as Priority Mail Express in an envelope addressed to Office of the Solicitor, United States Patent and Trademark Office Mail Stop 8, Post Office Box 1450, Alexandria, VA 22313-1450 on May 15, 2017.



Dated: May 15, 2017