

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTOPHER CUNNINGHAM, CHRISTOPHER  
DOYLE, NOAH DECKER, and BRYAN DAVIS

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Appeal 2008-003778  
Application 10/910,262  
Technology Center 3600

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Decided:<sup>1</sup> July 1, 2009

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Before WILLIAM F. PATE, III, STEFAN STAICOVICI, and FRED A.  
SILVERBERG, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF CASE

This is an appeal from the final rejection of claims 72-74, 77-79, 87-92, and 95-100. Claims 75, 76, 80, 81, 93, 94, 101, and 102 stand withdrawn from consideration. Claims 1-71 and 82-86 are canceled. We have jurisdiction under 35 U.S.C. §§ 134 and 6.

The claimed subject matter is directed to a strap for securing a snowboarding boot to a snowboard. The strap is convertible from a so-called toe cap strap configuration to a toe strap configuration.

Claim 72, reproduced below, is further illustrative of the claimed subject matter:

72. An apparatus for securing a toe area of a snowboarding boot, the toe area of the boot having a top surface, a bottom surface and a front wall extending therebetween, the apparatus comprising:

a convertible toe strap having:

a generally cup shape adapted to extend across and overlie the top surface of the boot and to extend around and overlie the front wall of the boot whereby, when the apparatus is tightened about the boot in a cap strap configuration, the convertible toe cap strap conforms to the top surface and the front wall of the boot; and

a generally bow shape adapted to extend across and engage the top surface of the boot whereby, when the apparatus is tightened about the boot in a toe strap configuration, the convertible toe cap strap conforms to the top surface of the boot so as to eliminate gaps between the strap and the top surface of the boot;

wherein the apparatus is selectively and repeatedly convertible between the cap strap configuration whereby both upward movement and forward movement of the toe area of the boot is resisted and the toe strap configuration whereby upward movement of the toe area of the boot is resisted.

The references of record relied upon by the Examiner as evidence of obviousness are:

Couderc	US 2003/0127832 A1	Jul. 10, 2003
Naito	US 2004/0135348 A1	Jul. 15, 2004

Claims 72-74, 77-79, 87-92 and 95-100 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Naito in view of Couderc.

### ISSUES

The Examiner is of the view that Figure 24 of Naito shows a toe cap strap 32a, 32b securing a boot to a snowboard. The Examiner further states that the straps 32a, 32b are movable relative to each other due to the expansible nature of the material they are formed of. Since strap 32a could be moved adjacent to strap 32b, the Examiner is of the view that this embodiment of Naito is a convertible toe cap strap. The Examiner further states that Couderc teaches the desirability of arranging the toe strap to closely conform to the top surface of the boot. Therefore, the Examiner opines, that in view of the teaching of Couderc to provide the strap 32b to expand and compress to a degree sufficient to ensure close conformity with the strap and the top of the boot, it would have been obvious to modify Naito such that this conformity is assured.

Appellants argue that Naito is not concerned with convertibility, and does not disclose a toe cap strap that is convertible to a toe strap. Appellants further argue that Naito and Couderc do not recognize the problem of the desirability of having a convertible strap. To the extent that the Examiner

states that Naito discloses a convertible strap, Appellants argue that this is not the case. There is no evidence in Naito that the strap is convertible, nor is there evidence that Naito recognizes the desirability of having a convertible strap. Appellants further argue that Couderc is not concerned with the flexibility or extensibility of the strap disclosed therein. Instead, Couderc is said to teach the flexibility of the lateral and medial flanges so that these flanges are not rigid and do not cut into the snow boot.

Therefore, the issue for consideration is whether the Appellants have established that the Examiner erred in determining that the combined teachings of Naito and Couderc render obvious Appellants' convertible toe cap strap.

#### FINDINGS OF FACT

1. Naito is principally directed to ways of attaching a toe strap to a snowboard binding. However, in Figures 24-29, Naito teaches a toe cap strap for a snowboard boot. The toe cap strap is comprised of two belts 32a, 32b, joined by an expansible pad or connecting member 35. The material of the belts is material that can be expanded and compressed to a slight degree. See Naito, para. [0079]. Naito describes the advantages of this cap as the advantages assigned to a normal toe cap strap. See Naito, para. [0085]. Naito does not describe this strap as a convertible strap, and does not mention the desirability of having a single strap be convertible from a toe cap strap to a toe strap configuration.

2. Couderc is also concerned with fastening a snowboard boot to a snowboard. Couderc recognizes that in the prior art, the attachment flanges of the binding, such as flanges 5 and 6 shown in Figure 1 of Couderc, sometimes cut into the snowboard boot when the snowboard boot is tilted laterally. See Couderc, para. [0013]. In order to ameliorate this problem Couderc suggests that the flanges 5 and 6 should be made of a flexible or semi-rigid structure. See Couderc, para. [0018]. Therefore, the entire contact surface between the device and the upper boot is made flexible or semi-rigid to conform to the surface of the boot.

#### PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

Recognition of the problem is part of the invention as a whole. *In re Spinnoble*, 405 F.2d 578, 585 (CCPA 1969) (“[D]iscovery of the source of a problem” is part of the “subject matter as a whole” to be considered in determining obviousness).

### ANALYSIS

The Examiner’s rejection is premised upon two points. The Examiner states that it would have been obvious to move the lower strap or belt 32b adjacent strap 32a to convert the toe cap strap of Naito into a toe strap. Secondly, since strap 32b is apparently longer than necessary when moved adjacent to strap 32a, the Examiner states that it would have been obvious to either make this strap elastic or extensible, so that it closely conforms to the boot top when moved into the adjacent position. Naito discloses that his straps can be made of slightly expansible or compressible material. See Naito, para. [0079]. A teaching for modification of this strap so that it lies close to the surface is said by the Examiner to come from Couderc, which teaches that the entire contact surface between the device and the upper boot should be continuously flexible or semi-rigid.

The first flaw in the Examiner’s analysis is that Naito does not contemplate moving the two bands 32a and 32b adjacent one another into toe strap position. Naito is silent with respect to adjustment to a toe strap configuration, and Naito does not recognize the desirability of a convertible toe cap strap configuration. Thus, it is apparent that the only teaching of moving the two straps 32a and 32b together, adjacent the 32a strap position, comes from the Appellants’ suggestion of the desirability of a convertible toe cap strap to toe strap binding. In other words, just because Naito could

be so modified, it does not teach or suggest the desirability of the modification.

Secondly, Couderc is silent with respect to a toe cap strap, or the desirability of converting a toe cap strap to a toe strap. Couderc is only concerned with toe straps. In addition, while Couderc is concerned with making the strap and the attached flanges flexible or semi-rigid, this does not necessarily equate to a strap that is expanded and compressed to a more than a slight degree. To say something is flexible is not to say that it is elastic or stretchable. The Examiner states that modification of the strap of Naito to be capable of functioning as a convertible strap would have been obvious in order to obtain the benefit disclosed by Couderc of making the flange and the strap flexible to conform to the surface of the boot. However, Couderc only teaches this confirmation in the context of a toe strap, and cannot suggest this desirability with respect to band or strap 32b of Naito when used in a different position than the strap is disclosed as being disposed in. In short, there is nothing in either reference to suggest the repositioning of strap 32b to be adjacent 32a so that both straps are in toe strap configuration. This is the teaching that is missing from the combined teachings of the prior art. Since this disclosure or element of the binding is missing from the combined teachings of the prior art, we are constrained to reverse the obviousness rejection of all claims on appeal.

#### ORDER

The rejection of claims 72-74, 77-79, 87-92, and 95-100 under 35 U.S.C. § 103(a) as unpatentable over Naito in view of Couderc is reversed.

Appeal 2008-003778  
Application 10/910,262

REVERSED

mls

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