

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LESLIE O. JONES, JR.

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Appeal No. 2001-2217  
Application 09/358,532

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ON BRIEF

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Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Leslie O. Jones, Jr. appeals from the final rejection of claims 1 through 8, all of the claims pending in the application.

THE INVENTION

The invention relates to a slipper having interchangeable inserts, each of which provides a distinctive "massage effect."

Representative claim 1 reads as follows:

1. A slipper comprising:  
a body portion adapted to be worn on the feet of a user,  
said body portion having a top and a bottom,  
aperture means for receiving a selected insert adjacent said bottom,

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said aperture means extending along substantially the entire bottom of said body portion and communicating with an outside surface of said body portion,  
a plurality of inserts adapted to be positioned within said aperture means,  
fastener means for securing said insert within said aperture means.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Hale	1,030,085	Jun. 18, 1912
Potter	2,400,023	May 7, 1946
Schoesler	5,878,510	Mar. 9, 1999
Mozayan European Patent Document <sup>1</sup>	0383685A1	Aug. 22, 1990

THE REJECTION

Claims 1 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hale in view of any one of Potter, Mozayan and Schoesler.

Attention is directed to the appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

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<sup>1</sup> An English language translation of this reference, prepared on behalf of the United States Patent and Trademark Office, is appended hereto.

DISCUSSION

Hale, the examiner's primary reference, discloses a slipper designed to be readily washed or cleaned. To this end, the slipper comprises an upper 5 and a base portion made of any suitable washable material such as cloth, toweling or canvas. The base portion consists of an inner sole 1 and an outer sole 2 secured along their peripheries except at their rear ends 3. The space between the soles defines a pocket 4 for removably receiving a stiffening means 6 which maintains the slipper in an operative shape. The rear end of the inner sole carries a flap 7 which can be sprung over the rear portion of the stiffening member to retain it within the pocket.

Determining that Hale does not meet the limitation in independent claim 1 requiring a plurality of inserts or the various limitations in dependent claims 2 through 8 requiring each of the inserts to comprise a hollow portion having a different filling, e.g., water, gel, sand, spherical objects and/or balls, the examiner takes the position that

there is nothing unobvious about providing more than one inset [sic, insert] 6 for use with the slipper of Hale so that the original maybe [sic, may be] replaced when it becomes worn. Clearly, one of ordinary skill in this art, as evidenced by the references of record, would have found it obvious to employ the commonplace

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art feature of replaceable shoe components such as inner soles, cleats, heels etc to provide more than one insert to replace the originals. Claim 1 requires no more. Also, providing inserts with a hollow portion filled with sand, fluid, spherical objects or any other material which are all interchangeable for conditioning, massaging and circulating of the blood in the feet is so old and conventional in this art as to hardly require citation of a reference. However, Potter, Moza[yan] and Schoesler are cited merely as examples of this common practice. These references each disclose a hollow portion in a shoe sole containing a variety of filings, [sic, fillings] each with purported desirable effects such as massaging, reduction of pressure, cushioning etc. Therefore, it would have been obvious to one having ordinary skill in the art and in view of any one of Potter, Moza[yan] and Schoesler to provide inserts with hollow portions filled with different materials in the slipper of Hale to provide better comfort, massaging and cushioning effects to the feet of the wearer. While it is submitted that the secondary references are not needed to reject claim 1, they have been left in because applicant's attorney has argued, and continues to argue, that claim 1 requires two inserts which are different [answer, pages 3 and 4].

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner's contention that it would have been obvious to provide the Hale slipper with extra inserts or stiffening means 6 so that a worn insert may be replaced seems reasonable on its face; however, as correctly pointed out by the appellant, the examiner has failed to advance the requisite factual basis or evidence to support this conclusion. The examiner's general allusion to "the references of record" in this regard is not proper<sup>2</sup> and is too vague and ambiguous to satisfy even the most rudimentary principles of due process. In a similar vein, the Potter, Mozayan and Schoesler secondary references fall far short of curing Hale's deficiencies with respect to the insert characteristics set forth in dependent claims 2 through 8. As accurately noted by the appellant, none of these secondary references pertains to footwear having an insert, let alone footwear having plural inserts.

Notwithstanding these flaws in the examiner's position, the Hale reference does in fact furnish an evidentiary basis sufficient to support a conclusion of obviousness with respect to

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<sup>2</sup> Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

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the subject matter recited in claim 1, albeit not for the reasons expressed by the examiner. Although Hale describes a single slipper having an insert or stiffening means 6, a person of ordinary skill in the art surely would have appreciated that slippers of the sort disclosed by Hale are conventionally intended, as are most elements of footwear, to be used in pairs. A pair of Hale's slippers would include two inserts or stiffening means 6. Given the symmetrical configuration of the stiffening means (see Figure 5), each would be adapted to be positioned within the aperture means embodied by one of the slippers as recited in claim 1. Hence, the two inserts embodied by the pair of slippers which would have been suggested by Hale respond to the "plurality of inserts" limitation recited in claim 1. This limitation does not require the inserts to be different.

In light of the foregoing, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, but not the standing 35 U.S.C. § 103(a) rejection of claims 2 through 8. As our rationale with regard to claim 1 differs from that espoused by the examiner, we hereby designate our action in sustaining the rejection of this claim as a new ground of rejection pursuant to 37 CFR § 1.196(b) to afford the appellant a fair opportunity to react thereto.

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SUMMARY

The decision of the examiner to reject claims 1 through 8 is affirmed with respect to claim 1 and reversed with respect to claims 2 through 8, with the affirmance being designated as a new ground of rejection pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b).

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
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	)	APPEALS AND
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	INTERFERENCES
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JOHN P. MCQUADE	)	
Administrative Patent Judge	)	

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