

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRAMPTON E. ELLIS III

Appeal No. 2004-0253
Application 09/933,821

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 through 34, 36, 37, 39 through 42, 44 through 53, 55 through 57, 59 and 60. At the time of the final rejection, claim 43 was objected to as being dependent upon a rejected base claim, but was also indicated to be allowable if rewritten in independent form, while claims 1 through 20, 35, 38, 54 and 58 were canceled. Subsequent to the final rejection, the

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examiner has now indicated (answer, page 8) that the rejections of claims 48, 51 and 52 have been withdrawn, and that these claims (like claim 43) are also objected to and allowable. Thus, the appeal as to claims 48, 51 and 52 is dismissed, leaving only claims 21 through 34, 36, 37, 39 through 42, 44 through 47, 49, 50, 53, 55 through 57, 59 and 60 for our consideration on appeal.

Appellant's invention relates to a shoe sole construction and, more particularly, to a contoured sole structure that conforms to the natural shape of the foot sole, including the bottom and sides, when the foot sole deforms naturally during locomotion, thereby permitting the foot to react naturally with the ground as it would if the foot were bare, while continuing to provide a cushioned stable support base for the foot and ankle. In addition, appellant's invention relates to the use of deformation sipes or slits (e.g., 181, 182) in the shoe sole to provide it with enhanced flexibility to parallel the frontal plane deformation of the foot, which creates a stable base that is wide and flat even when tilted sideways in natural pronation and supination motion in extreme exercise. Figure 9D of the application drawings best exemplifies the invention defined in

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the claims presently on appeal. Independent claim 21 is representative of the subject matter on appeal, and a copy of that claim may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the claims on appeal are:

Holcombe, Jr. (Holcombe)	3,964,181	Jun. 22, 1976
Landay et al. (Landay)	4,245,406	Jan. 20, 1981
Dassler	4,614,046	Sept. 30, 1986
Autry	4,624,062	Nov. 25, 1986

Claims 21 through 34, 36, 37, 39, 44 through 47, 49, 50, 53, 55 through 57, 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landay in view of Dassler or, in the alternative, as being unpatentable over Dassler in view of Landay.

Claims 40 through 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied above, and further in view of Autry or Holcombe.

Rather than reiterate the conflicting viewpoints advanced by appellant and the examiner regarding the above-noted rejections,

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we refer to the examiner's answer (Paper No. 16, mailed May 19, 2003) and to appellant's brief (Paper No. 15, filed April 29, 2003) and reply brief (Paper No. 17, filed July 24, 2003) for a full exposition thereof.

OPINION

Having carefully reviewed the obviousness issues raised in this appeal in light of the record before us, we have made the determinations which follow.

Before we specifically address the examiner's prior art rejections and appellant's arguments thereagainst, we direct attention to the marked-up version of Figure 9D shown on page 4 of appellant's brief for a better understanding of the various sole portions or sections and other relationships defined in the claims on appeal, particularly the "at least one convexly rounded portion of the inner midsole surface," the "at least one concavely rounded portion of the outer midsole surface" and the "rounded portion of the midsole located between said convexly

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rounded portion of the inner midsole surface and said concavely rounded portion of the outer midsole surface," as set forth in claim 21.

Looking to the examiner's rejection of claims 21 through 34, 36, 37, 39, 44 through 47, 49, 50, 53, 55 through 57, 59 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Landay in view of Dassler, the examiner directs us to Figures 1 and 9a of Landay, urging (answer, page 3) that Landay shows a shoe comprising a bottom sole (12) and a midsole (14) with rounded side portions, and a cushioning means (formed by 34) substantially as claimed except for the exact means for cushioning. To account for this perceived difference the examiner turns to Dassler, contending that this patent teaches

forming cushioning means by providing an insert (14) fit into a recess (13) internal of a sole (see figures 5 and column 3 lines 49-51) (or the entire structure of elements 1, 5, and 14 which is interior to the peripheral midsole 18) which inherently forms slits between all of the surfaces of the insert (14) and the other adjacent sole elements.

The examiner then concludes that it would have been obvious "to provide cushioning means as taught by Dassler '046 in the shoe of

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Landay to provide custom support for a specific wearer or activity.”

In the alternative obviousness rejection based on Dassler in view of Landay, the examiner contends that Dassler shows a shoe having a bottom sole (20) and a midsole (19) which has a plurality of slits therein (around element 14) “substantially as claimed except for rounded side portions.” The examiner then turns to Landay, urging that this patent teaches forming midsole sides with rounded inner and outer surfaces (Figs. 1 and 9a). From the collective teachings of the applied prior art, the examiner concludes (answer, page 4) that it would have been obvious “to make the sides rounded as taught by Landay in the shoe of Dassler ‘046 to make the shoe better sealed, more comfortable, and to increase the durability of the shoe.”

For the reasons aptly set forth by appellant in the brief and reply brief, we will not sustain the examiner’s above-noted rejections of claims 21 through 34, 36, 37, 39, 44 through 47, 49, 50, 53, 55 through 57, 59 and 60 under 35 U.S.C. § 103(a). Like appellant, it is clear to us that the rubber outsole (12) of Landay, in going from the flat condition seen in Figure 6 of that

patent to the somewhat compressed and curved configuration in the lower mold half (48) as seen in Figure 9a, although not loaded by a wearer's foot, must of necessity be placed under a load and that the examiner's assertions to the contrary are without merit. Moreover, we agree with appellant's assessment that the examiner's statement on page 5 of the answer that the formed shoe in Landay is "clearly shown in figure [sic] 9 and 9a which shows that when the shoe is completed the outsole and midsole are curved/rounded at the periphery," is wholly based on speculation and conjecture, since the final configuration of the outsole (12) and midsole (14) in the completed shoe of Landay, as viewed in a frontal plane cross-section, after removal of the shoe from the mold, cannot be determined from either Figure 1 or Figures 9 and 9a of that patent.

In addition, from our perspective, the examiner's proposed wholesale modification of the midsole of Landay in view of the totally different midsole of Dassler in an effort to create a sole structure that purportedly will "inherently" be responsive to the shoe sole construction as set forth in appellant's claims on appeal is without merit and represents a clear case of impermissible hindsight reconstruction of the claimed invention

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based on appellant's own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

As for the alternative obviousness rejection wherein the examiner proposes a modification of Dassler's shoe sole arrangement in view of the teachings of Landay, that rejection falls for the reasons already set forth above, i.e., that Landay does not teach or suggest the rounded midsole surfaces and portions, as urged by the examiner, in a completed shoe after removal from the mold and as viewed in a shoe sole frontal plane cross-section when the shoe is upright and in an unloaded condition.

With respect to the rejection of dependent claims 40 through 42 under 35 U.S.C. § 103(a) as being unpatentable over Landay and Dassler as applied above, and further in view of Autry or Holcombe, we agree with appellant's assessment (brief, page 31-

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38) and, for those reasons, will not sustain the examiner's rejection of claims 40 through 42 under 35 U.S.C. § 103(a).

In summary: the examiner's proposed rejections of claims 21 through 34, 36, 37, 39 through 42, 44 through 47, 49, 50, 53, 55 through 57, 59 and 60 under 35 U.S.C. § 103(a) have not been sustained. Thus, the examiner's decision in the application before us on appeal is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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