

PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NANCY C. FRYE

Appeal 2009-006013
Application 10/790,923
Technology Center 3700

Decided: February 26, 2010

Before DAVID J. KAPPOS, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*, SHARON R. BARNER, *Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office*, MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, and WILLIAM F. PATE III, LINDA E. HORNER, and KEN B. BARRETT, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

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STATEMENT OF THE CASE

Nancy C. Frye (Appellant) seeks our review under 35 U.S.C. § 134 (2006) of the Examiner's decision rejecting claims 1, 5, 8, 11, 14-16, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b) (2006).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellant's claimed invention is a shoe having a forwardly-inclined, reverse wedge. Spec. 5:6. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A shoe, comprising:

an upper;

an insole enclosed by the upper, the insole being a single piece layer of the shoe, the insole having a forward toe section and a rear heel section;

an outsole supporting the insole, the outsole having a planar support surface directly supporting the forward toe section and the rear heel section of the insole, the outsole having a planar walking surface;

wherein the rear heel section of the insole has a surface closer to the planar walking surface of the outsole than a surface of the forward toe section of the insole to place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions;

wherein the forward toe section of the insole has a substantially constant thickness from a forward periphery edge

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of the shoe to the rear heel section, the rear heel section of the insole having a decreasing thickness from the forward toe section of the insole to a rear periphery edge of the shoe, wherein the rear heel section of the insole and the forward toe section of the insole meet at a point substantially halfway with respect to the upper surface.

THE EVIDENCE

The Examiner relies upon the following evidence:

Borgeas	US 3,990,159	Nov. 9, 1976
Snabb	US 5,491,912	Feb. 20, 1996

THE REJECTIONS

Appellant seeks review of the following rejections:

1. The Examiner rejected claims 1, 5, and 11 under 35 U.S.C. § 102(b) as being anticipated by Snabb.
2. The Examiner rejected claims 8, 14, 16, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Snabb.
3. The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Snabb and Borgeas.

ISSUE

The Examiner found that Snabb discloses an insole 24 with the claimed shape and found that the location where the rear heel section and the forward toe section meet appears to be the same location as shown in Appellant's figure 14 and is considered to be "substantially halfway" as

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claimed. Ans. 5, 8. This same finding of fact as to the scope and content of Snabb underlies both the Examiner's ultimate finding of anticipation of claims 1, 5, and 11 and the Examiner's final conclusions of obviousness of claims 8, 14-16, 19, and 20.

Appellant contends that the location at which Snabb's insole transitions from a section having a rearwardly decreasing thickness to a section having a constant thickness would never be considered to be at a halfway point of the shoe. App. Br. 12.¹

The issue presented by this appeal is:

Has the Examiner erred in finding that Snabb discloses a shoe having an insole with a forward toe section of substantially constant thickness and a rear heel section having a decreasing thickness that meet at a point "substantially halfway" with respect to the upper surface or outsole, as called for in independent claims 1, 11, and 16?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellant's Specification describes figure 14 as "an alternate shoe embodiment incorporating features of the present invention" and

¹ "App. Br." refers to Appellant's Supplemental Appeal Brief, filed September 22, 2008.

having: an “[i]nsole 816 [which] includes a first portion 820 of substantially constant thickness that extends rearward from a forward periphery 822 of outsole 812 and shoe upper 814 to a point 824 approximately halfway across a length of shoe 810” and “a second portion 826 that extends forwardly from a rear periphery 828 of outsole 812 and shoe upper 814 to meet the first portion 820 at point 824” where “[s]econd portion 826 has an increasing thickness from rear periphery 828 to point 826 [sic 824].” Spec. 29:6-7 and 16-25.

2. Figure 14, as originally filed, is reproduced below:

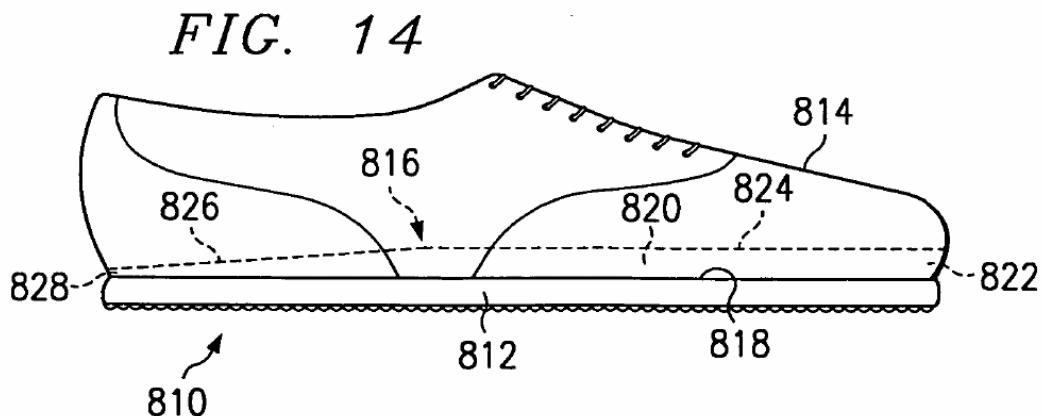


Figure 14 depicts a shoe with an outsole affixed to a shoe upper and an insole which lies over a surface of the outsole enclosed by the shoe upper.

3. The Examiner admits that the placement of element number 824 in figure 14, as originally filed, is inconsistent with Appellant’s description of the location of point 824 in the Specification as being the point where portions 820 and 826 meet:

The shape shown in figure 14 of the original drawings shows an insole with a shape in which the location of the meeting of the portions 820 and 826 is considered to be “approximately halfway” (emphasis added) as recited in the specification originally filed. It would be admissible if applicant were to file drawings in which only number 824 is moved to the location shown in originally filed drawings as the point where the portions 820 and 826 meet.

Ans. 7.

4. When referring to the “substantially halfway” limitation, the Specification uses the word “approximately” as a substitute for the word “substantially,” connoting a term of approximation. Spec. 29:20 (“approximately halfway”). An ordinary meaning of “approximately” includes “Reasonably close to: nearly, almost, about.” *Webster’s Third New International Dictionary, Unabridged* (1996).
5. An ordinary meaning of “halfway” includes “equally distant from the extremes of a space or course: midway between two points: *a halfway point.*” *Webster’s Third New International Dictionary, Unabridged*, defn. 1 (1996).
6. Snabb discloses a shoe with an outer sole 20, an upper 22 attached to the outer sole 20, and an inner sole 24 “sloped upwardly relative to the horizontal from the heel **26** toward the ball of the foot at **28.**” Snabb, col. 3, ll. 42-45; fig. 2.

7. Snabb further discloses that “[t]he slope [of the insole] is preferably changed to 0° under the toes as indicated at **29**.” Snabb, col. 3, ll. 49-50; fig. 2.
8. In particular, Snabb teaches:

[T]he applicants have determined from the testing that braking and cutting in explosive sports is enhanced by the negative slope, in particular, the negative slope shown in FIG. 2 wherein the slope is flat and constant from the center of pressure of the heel **26** to the ball centers of pressure of the foot **28**. Forward of the ball **28** centers of pressure the negative slope is decreased to 0° under the toes at **29**. The change in slope occurs beyond the ball centers of pressure as shown.

Snabb, col. 4, ll. 32-40.

9. Figure 2 of Snabb is reproduced below:

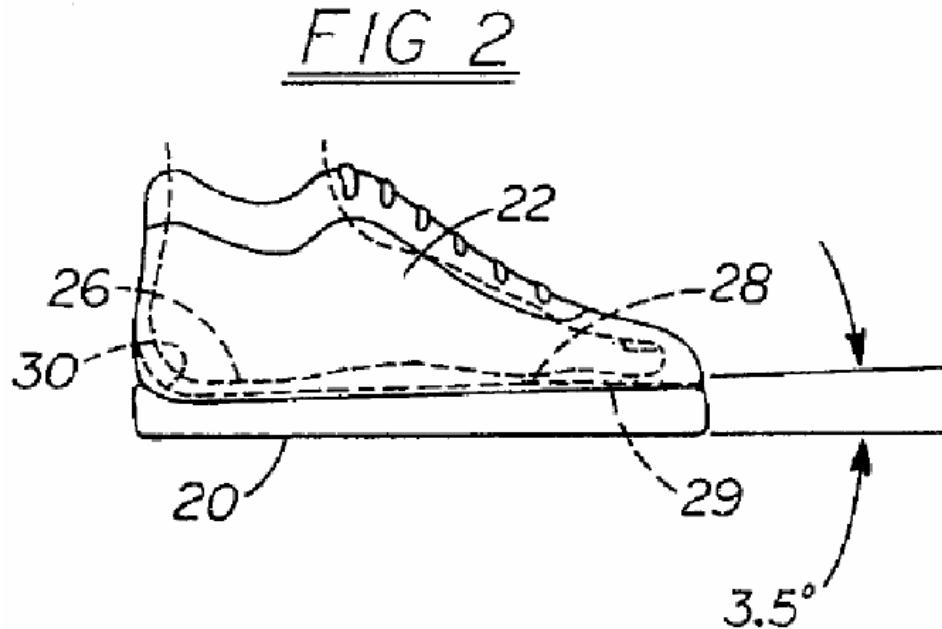


Figure 2 of Snabb depicts a shoe with an inner sole sloped upwardly relative to the horizontal from the heel toward the ball of the foot where the slope is decreased to zero degrees under the toes.

PRINCIPLES OF LAW

Standard of Review

The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope that he seeks – the so-called “*prima facie* case.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden of proof is on the USPTO “to produce the factual basis for its rejection of an application under sections 102 and 103”). (quoting *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). As the Federal Circuit has observed, “[t]he term ‘*prima facie* case’ refers only to the initial examination step.” *Oetiker*, 977 F.2d at 1445; *see also Oetiker*, 977 F.2d at 1449 (“The process of patent examination is an interactive one.”) (Plager, J., concurring). The “*prima facie* case” serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472. Applicant’s rebuttal evidence “may relate to any of the *Graham* factors including the so-called secondary considerations.” *Piasecki*, 745 F.2d at 1472 (citations omitted). The

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examiner then determines patentability “on the totality of the record, by a preponderance of the evidence with due consideration to the persuasiveness of argument.” *Oetiker*, 977 F.2d at 1445.

The Board’s role in any subsequent appeal is to, “*on written appeal of an applicant*, review adverse decisions of examiners upon applications for patents.” 35 U.S.C. § 6(b) (2006) (emphasis added). An appellant may attempt to overcome an examiner’s obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Similarly, the applicant may submit evidence of secondary considerations of non-obviousness. *See Kahn*, 441 F.3d at 985-86 (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998), *overruled in part on other grounds*, KSR, 550 U.S. at 422).

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 (“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.”) (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief must include “the contentions of appellant with respect to each ground of rejection presented for review in paragraph

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(c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on”). Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived); *In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004) (declining to consider the appellant's new argument regarding the scope of a prior art patent when that argument was not raised before the Board); *In re Schreiber*, 128 F.3d 1473, 1479 (Fed. Cir. 1997) (declining to consider whether prior art cited in an obviousness rejection was non-analogous art when that argument was not raised before the Board). Thus, the Board will generally not reach the merits of any issues not contested by an appellant. Cf. *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant . . . ”). For example, if an appellant contests an obviousness rejection only on the basis that a cited reference fails to disclose a particular limitation, the Board need not review the other, uncontested findings of fact made by the examiner underlying the rejection, such as the presence of uncontested limitations in the prior art.

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Cf. In re Reuning, 276 Fed. Appx. 983, 986 (Fed. Cir. 2008) (nonprecedential) (rejecting Reuning’s argument that the Board erred in affirming the obviousness rejection by failing to “explain how each and every element of the rejected claims is taught by the cited references” as “premised on a mistaken assignment of burdens between the PTO and an applicant-appellant” and citing applicant’s obligations to respond to a *prima facie* case with “some argument or evidence”).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

Obviousness

“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 406-07 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

ANALYSIS

Appellant contends that the Examiner erred in finding that Snabb’s forward section of substantially constant thickness, i.e., the section of the insole having a slope of zero degrees, meets the rearward section of the insole “at a point substantially halfway” with respect to the upper surface or the outsole as called for in independent claims 1, 11, and 16. Appellant contends that this erroneous underlying finding of fact pervades the Examiner’s finding of anticipation of claims 1, 5, and 11 and the Examiner’s ultimate conclusions of obviousness of claims 8, 14-16, 19, and 20.

Appellant’s Specification describes a point 824 on insole 816 of figure 14 as being the point at which a first portion 820 of substantially constant thickness and a second portion 826 of increasing thickness meet (Fact 1). Figure 14, as originally filed, shows that first portion 820 and

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second portion 826 meet at a point approximately where the end of the arrow for number 816 is located (Fact 2). This location is consistent with the description in the Specification of this meeting point as being “approximately halfway across a length of shoe 810” (Fact 1). Original figure 14, however, places the number 824 and its associated lead line considerably forward of a halfway point across the length of the shoe and considerably forward of the point at which first portion 820 and second portion 826 meet (Fact 2). The Examiner admits that the placement of element number 824 in figure 14, as originally filed, is inconsistent with Appellant’s description of the location of point 824 in the Specification (Fact 3). The Examiner further states that she would admit a drawing in which only number 824 is moved to the location shown in originally filed drawings as the point where the portions 820 and 826 meet (Fact 3). Appellant also agrees to submit this drawing change. App. Br. 10. Since the Appellant is agreeable to correct the mistaken placement of element number 824, and the Examiner is agreeable to the correction, the mistaken placement of element number 824 and its correction is not in contention for purposes of deciding the issue presented on appeal.

Snabb discloses a shoe with an inner sole 24 sloped upwardly relative to the horizontal from the heel 26 toward the ball of the foot at 28, and then forward of the ball 28 the slope changes so that it becomes zero degrees at a point marked as 29 in figure 2 (Facts 6-9). As such, the point at which the section of Snabb’s insole having an increasing thickness meets the section of Snabb’s insole having a constant thickness is depicted in figure 2 of Snabb

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as the point marked 29. (*Id.*) This point 29 is described in Snabb as being under the wearer's toes and is forward of the point of the insole on which the ball of the wearer's foot would rest. (*Id.*)

The Examiner's finding that Snabb discloses a meeting point located "substantially halfway" (Ans. 5) as claimed rests on an unreasonably broad interpretation of "substantially halfway". Depending on its usage, the word "substantially" can denote either language of approximation or language of magnitude. *Deering Precision Instruments, L.L.C. v. Vector Distribution Sys., Inc.*, 347 F.3d 1314, 1323 (Fed. Cir. 2003) (recognizing the "dual ordinary meaning of th[e] term ["substantially"] as connoting a term of approximation or a term of magnitude"). Here, when referring to the "substantially halfway" limitation, the Specification uses the word "approximately" as a substitute for the word "substantially" (Fact 4). Thus, consistent with its usage in the Specification, the ordinary and customary meaning of "substantially" includes "reasonably close to: nearly, almost, about", connoting a term of approximation (Fact 4). The ordinary meaning of "substantially halfway" is thus reasonably close to or nearly at the midpoint between the forwardmost point of the upper or outsole and the rearwardmost point of the upper or outsole (Facts 4, 5). As such, we disagree with the Examiner's finding that the point at which the section of Snabb's insole having an increasing thickness meets the section of Snabb's insole having a constant thickness is "substantially halfway" with respect to the upper surface or outsole of the shoe. Rather, we find that this point, marked with the number 29 in figure 2 of Snabb, is too far forward of a

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halfway point with respect to the upper surface or outsole of Snabb's shoe to be the "substantially halfway" point as claimed.

Our decision is limited to the finding before us for review. The Board does not "allow" claims of an application and cannot direct an examiner to pass an application to issuance. Rather, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. *See* 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner").² The Examiner in the present case has not based any of the rejections for our review on a theory that locating the claimed point "substantially halfway" as claimed would have been obvious to a person having ordinary skill in the art at the time of Appellant's invention in view of the prior art, and thus we take no position on this issue in the present opinion.

PETITIONABLE MATTERS

Appellant also seeks our review of the Examiner's objection to the drawings under 37 C.F.R. § 1.83(a) and the Examiner's refusal to enter

² The Board also has discretion to enter a new ground of rejection of a claim should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim. 37 C.F.R. § 41.50(b). *See also* Manual of Patent Examining Procedure (MPEP), 8th ed., rev. July 2008, § 1213.02 ("Since the exercise of authority under 37 C.F.R. § 41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion").

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Appellant's proposed amended drawings because they contain new matter. App. Br. 8, Issue 1, and App. Br. 9-10. In particular, the Examiner objected to the drawings because they do not show the claimed midsole and because the point 824 in figure 14 is in the wrong position. Ans. 3-4. Appellant submitted a drawing with proposed drawing corrections to figure 14 to add a midsole and to move point 824 to the correct location. App. Br. 9. The Examiner refused to enter the proposed drawing. Ans. 3. As noted *supra*, the Examiner states that she would admit a drawing in which only number 824 is moved to the correct location (Fact 3), but she refuses to enter the proposed drawing because the midsole is considered to be new matter. The Examiner's refusal to enter the proposed drawing showing the midsole is unrelated to any rejection before the Board. We take this opportunity to direct the Appellant's attention to MPEP § 1201, which states:

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 1201, 8th ed., rev. July 2008. In the present case, Appellant has not filed a petition to resolve either the Examiner's objections to the drawings or the Examiner's refusal to enter proposed drawing amendments prior to the matter reaching the Board. The Examiner's objections to the drawings and refusal to enter an amendment are reviewable by petition under 37 C.F.R.

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§ 1.181 and are thus not within the jurisdiction of the Board. 37 C.F.R. § 1.127 (2009); *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403-1404 (CCPA 1971) (stating that there are a host of various kinds of decisions an examiner makes in the examination proceeding – mostly matters of a discretionary, procedural or nonsubstantive nature – which have not been and are not now appealable to the board when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner and holding that “the kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims”)) and *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967) (holding that the refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion, and any abuse of discretion is remedied by a Rule 181 petition to the Commissioner of Patents, and not by appeal to the Board of Appeals)).

See also MPEP § 1002.02(c), 8th ed., rev. July 2008, Petitions and Requests Decided by the Technology Center Directors (delegating the Director’s authority to the Technology Center Directors to decide certain petitions, including petitions invoking the supervisory authority of the Director of the USPTO under 37 C.F.R. § 1.181 involving any *ex parte* action or requirement in a patent application by the examiner which is not subject to appeal, including refusal to enter an amendment under 37 C.F.R. § 1.111 or 37 C.F.R. § 1.115). *See also* MPEP § 1002, 8th ed., rev. July 2008, which states:

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37 C.F.R. 1.181(f) provides that any petition under that rule which is not filed “within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.” Often, the “action or notice from which relief is requested,” for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a 3-month period for reply. Under such circumstances, if applicant requests reconsideration, under 37 C.F.R. 1.111(b), of the requirement for a new drawing, the examiner’s action on this request, if adverse, establishes the beginning of the 2-month period for filing the petition. The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period.

In general, since petitions should be made within two months of the mailing date of the action or notice from which relief is requested, 37 C.F.R. § 1.181(f), petitionable matters should be addressed before an appeal reaches the Board. In the present case, it would have been desirable for the Appellant to have resolved the objections to the drawings and refusal to enter proposed drawing amendments by petition prior to the matter reaching the Board.

CONCLUSION

The Examiner erred in finding that Snabb discloses a shoe having an insole with a forward toe section of substantially constant thickness and a rear heel section having a decreasing thickness that meet at a point substantially halfway with respect to the upper surface or outsole, as called for in independent claims 1, 11, and 16.

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DECISION

The decision of the Examiner to reject claims 1, 5, 8, 11, 14-16, 19, and 20 is REVERSED.

REVERSED

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BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980