

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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SVEN E. OBERG and DAVID P. MITCHELL

Appeal No. 2000-2061
Application No. 08/463,843

HEARD: MARCH 21, 2001

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-27, 29-34, 39-43, 46, 47 and 49-52, which are all of the claims pending in this application.¹

We REVERSE.

¹Claims 41, 50, 51 and 52 were amended after the final rejection to overcome issues under 35 U.S.C. § 112, second paragraph.

BACKGROUND

The appellants' invention relates to a method of manufacture of footwear and to an article of footwear. An understanding of the invention can be derived from a reading of exemplary claims 15 and 27, which appear in an appendix to the appellants' Brief.

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

Makovski	3,007,184	Nov. 7, 1961
Funck	3,913,160	Oct. 21, 1975
Huh et al. (Huh)	4,635,384	Jan. 13, 1987
British Patent Specification (Desma-Werke)	1,145,809	Mar. 19, 1969
French Patent Document (Vibram)	2,034,828	Dec. 18, 1970

The following rejections stand under 35 U.S.C. § 103:²

- (1) Claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 46, 47 and 50-52 on the basis of Funck in view of Desma-Werke.
- (2) Claims 17, 19, 22, 24, 29, 31-33 and 49 on the basis of Funck in view of Desma-Werke, Huh and Vibram.
- (3) Claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 46 and 47 on the basis of Makovski in view of Desma-Werke.

² Claim 46, which depends from claim 39, was not listed as being included in any of the rejections in the final rejection or in the Answer, nor has it been canceled, allowed, or withdrawn from consideration. In the absence of mention of this situation by the appellants in their Briefs, we consider this omission to be an inadvertent error on the part of the examiner, and shall group claim 46 with independent claim 39, from which it depends.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 41) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 36) and Supplemental Brief (Paper No. 40) for the appellants' arguments thereagainst.³

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

All of the rejections are under 35 U.S.C. § 103. The guidance provided by our reviewing court for evaluating rejections under Section 103 is as follows: The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art

³ We wish to point out that a provisional rejection of claims 34, 39-42, 46, 47 and 49 under the judicially created doctrine of double patenting, which appeared in the final rejection (Paper No. 38), was not repeated in the Answer (Paper No. 41), presumably because the appellants agreed to file a terminal disclaimer if and when a patent issued on the claims of copending application number 08/332,275 (upon which the rejection was based (Paper No. 40)).

would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The Rejection Based Upon Funck And Desma-Werke

This rejection is applied against claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 47 and 50-52, the method claims of which require that there be a mold insert on the bottom of the last which extends continuously from the toe region to the heel region of the shoe, and the article claims that there be a cavity in the tread sole extending continuously from the toe region to the heel region.

Funck illustrates two embodiments of a shoe in which cushion inserts are utilized for the purpose of providing "extremely good supporting characteristics" (column 1, lines 18-23). As can be seen in Figure 1, in a first embodiment a first cushioning insert is located in a cavity beneath the toe region of the wearer's foot and a second cushioning insert is installed beneath the heel region, separated from the first. Therefore, it is apparent that the last for producing such a shoe would have two spaced mold inserts. Figure 4 discloses a

last for producing a second shoe embodiment, which comprises four separate and unconnected cavities for receiving cushioning inserts. With regard to the method of manufacture, neither embodiment would require that there be a mold insert extending continuously from the toe region to the heel region of the shoe, as is required by claim 15. In addition, the Funck specification gives rise to a third, and unillustrated, embodiment of the invention, in which an insert is present only in the toe region of the shoe (7 in Figure 1). This stems from the statement that the additional mold inserts shown in Figures 1 and 4 need not be present, to wit, the invention “can have, besides the extension under the ball part, additional extensions under the joint and heel parts which in the sole member form several cavities which are subdivided by webs” (column 2, lines 49-53, emphasis added).

Desma-Werke discloses a shoe in which cushioning material is located in a cavity that extends continuously from the toe region to the heel region of the shoe. The purpose of this construction is to “be ensured that an adequate or genuine air-cushion effect can be achieved with the sole” (page 1, lines 43-45). The method by which the Desma-Werke shoe is made is not disclosed.

As we understand the examiner’s rejection, it is grounded in the statement in Funck, quoted above, that the extensions in the last in the heel portion of the shoe that are shown in Figure 4 (and one of which would be present in a last for making the embodiment of

Figure 1) are not essential to the construction, but are optional. The examiner then opines that it would have been obvious to extend the toe portion cavity disclosed by Funck along the entire length of the shoe by providing a continuous mold insert on the last, in view of the teaching of Desma-Werke, suggestion being found in the stated advantage of providing increased impact absorption and comfort. See Answer, pages 3 and 4. We do not agree with this conclusion. It is our opinion that even if considering that Funck discloses an embodiment having only a single cushioning element located in the toe region of a shoe, one of ordinary skill in the art would have been taught by this reference that if cushioning is to be extended beyond the toe region toward the heel region, it should be placed in other separate and unconnected cavities, such as at 7 and 15 in the embodiment of Figure 1 and those formed by last extensions 9 in the embodiment of Figure 4. This would have operated as a disincentive to the artisan to extend the cavity in Funck continuously beyond the toe region to the heel region, for it would interfere with the accomplishment of the objectives and advantages of the Funck invention set forth in column 2, which are achieved by means of the separate chambers and the webs provided therebetween.

It thus is our conclusion that the combined teachings of Funck and Desma-Werke fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim method claim 15. The same can be said for independent method claims 20, 34, 39 and 50, which also require a continuous mold insert, and independent

article claims 27, 30, 42, 51 and 52, which require a continuous cavity. This rejection of the independent claims and, it follows, of those claims depending therefrom, is not sustained.

The Rejection Based Upon Funck, Desma-Werke, Huh And Vibram

This rejection applies to independent claim 29 and dependent claims 17, 19, 22, 24, 31-33 and 49, all of which contain the limitation regarding continuous mold extension or continuous cavity, that has been discussed in the preceding section of this opinion. Huh and Vibram have been added by the examiner to the basic combination of references with regard to additional limitations recited in these claims which relate to the relationship between the insole and the insert. Be that as it may, neither Huh nor Vibram alleviate the problem with the combination of Funck and Desma-Werke that was discussed above. This being the case, we will not sustain this rejection, either.

The Rejection Based Upon Makovski And Desma-Werke

Claims 15, 16, 18, 20, 23, 35-27, 30, 34, 39-43 and 47 stand rejected here.

Makovski is directed to the manufacture of lightweight footwear, such as slippers (column 1, lines 15 and 16). Disclosed in this reference is a method in which an upper 16 and a sole 34 are formed around a last 10 that comprises a mold insert 12 on the bottom. The disclosed method of making a footwear article from this last includes attaching a cord 18 to the last margin of the upper in order to draw it into contact with

the last, and passing the cord transversely beneath the upper, where knots are tied. To accommodate this, a transverse groove 22 is provided in the mold insert. See column 2, lines 24-41. The depth of the groove is not specified.

In meeting the terms of the claims that are the subject of this rejection, which require either that the mold insert extend continuously from the toe region to the heel region or that the shoe have a cavity so extending, the examiner has taken the position that the groove “may not extend entirely through the land to the body portion . . . and therefore may be a superficial groove,” in which case the mold insert would be “continuous” from the toe region to the heel region (Answer, page 5, emphasis added). The claims also require that the mold extension or cavity be thicker at the heel portion than at the other portions, and for this feature the examiner looks to Desma-Werke, concluding that it would have been obvious to modify the Makovski footwear by providing a thicker heel cavity, as disclosed in the secondary reference (Answer, page 5).

The appellants point to the unidentified broken line visible in Figure 3 as support for their argument that the Makovski groove extends entirely through the mold insert, thus dividing it into two parts, whereupon neither it nor the cavity it creates extend continuously from the toe region to the heel region. They also urge that it would not

have been obvious for one of ordinary skill in the art to add a thickened heel cavity to the Makovski footwear.

We cannot subscribe to the examiner's position regarding the Makovski groove, for there is no explicit language in the reference that supports it and thus the conclusion the examiner reaches is based only upon speculation. Moreover, the appellants' argument regarding the broken line in Figure 3 cannot be ignored, and it certainly detracts from the examiner's theory. We reach the same conclusion with regard to thickening the cavity at the heel of the Makovski article, for we agree with the appellants that one of ordinary skill in the art would not have been motivated to add a thickened heel area to flat slipper-type footwear of the type disclosed by Makovski.

For the reasons set forth above, it is our opinion that the combined teachings of Makovski and Desma-Werke fail to establish a prima facie case of obviousness with respect to the subject matter recited in claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 46 and 47. This rejection is not sustained.

SUMMARY

The rejection of claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 46, 47 and 50-52 as being unpatentable over Funck and Desma-Werke is not sustained.

The rejection of claims 17, 19, 22, 24, 29, 31-33 and 49 as being unpatentable over Funck in view of Desma-Werke, Huh and Vibram is not sustained.

The rejection of claims 15, 16, 18, 20, 21, 23, 25-27, 30, 34, 39-43, 46 and 47 as being unpatentable over Makovski in view of Desma-Werke is not sustained.

The decision of the examiner is REVERSED.

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	AND
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