

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID MITCHELL

Appeal No. 2002-1082
Application No. 09/474,179

HEARD: NOVEMBER 5, 2002

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 10-20 as amended subsequent to the final rejection (see Paper Nos. 20 and 21)¹, which are all of the claims pending in this application.

We REVERSE.

¹ An earlier amendment after final (Paper No. 17) was not entered (see Paper No. 18).

BACKGROUND

The appellant's invention relates broadly to the field of safety shoes and more particularly to safety shoes having a steel toe box for protecting the wearer's toes (specification, page 1). Claim 10 is representative of appellant's invention and reads as follows:

10. An improved safety shoe having an upper, a protective toe, and an outsole comprising a substantially flat partial insole tuck having an edge surface located within the protective toe, wherein said partial insole tuck prevents rearward movement of the protective toe and wherein the length of said partial insole tuck is less than the length of the shoe interior.

The following are the only rejections before us on appeal.²

Claims 10, 15 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hansen³.

Claims 11-14, 16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hansen in view of Official Notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 24) for the examiner's complete reasoning in support of the rejections and to

² The rejection under 35 U.S.C. § 112, second paragraph, of claims 10-20 was overcome by the amendment of Paper No. 20 (see Paper No. 21).

³ U.S. Patent No. 5,111,597, issued May 12, 1992.

the brief and reply brief (Paper Nos. 23 and 25) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the Hansen patent, and to the respective positions articulated by the appellant and the examiner. On the basis of this review, for the reasons which follow, we cannot sustain the examiner's rejections.

Even assuming that Hansen's dance shoe is a "safety shoe" having a "protective toe" as used in claim 10, in light of the broad definition in the Dictionary of Shoe Industry Terminology appended to appellant's brief, a point on which we do not necessarily agree with the examiner⁴, the Hansen shoe lacks a partial insole tuck having an edge surface located within the protective toe which prevents rearward movement of the protective toe (the toe support 44), as required by claim 10. The examiner's position (answer, page 5) that the short shank 50, which the examiner considers to be the "partial insole tuck," will to some degree prevent rearward movement of the protective toe by abutting the forward end of the inner sole 62 does

⁴ While the relatively rigid toe support 44 and relatively rigid short shank 50 of Hansen's dance shoe, which cooperate to provide support enabling the wearer of the dance shoe to stand on the end of his or her toes (column 3, lines 43-45), may broadly be considered a safety feature to protect the foot of the wearer, thereby meeting appellant's proffered definition, it appears from a reading of appellant's underlying disclosure that appellant's use of "safety shoe" refers to a term which has established a meaning in the art as a shoe adapted for hazardous work environments to provide protection to the wearer's foot from impact and puncture injuries. One skilled in the art would certainly not consider the dance shoe of Hansen, even with its toe support feature, to be such a "safety shoe."

not appear reasonable to us. To the extent that the abutment of both the toe support 44 and the short shank 50 against the forward end of the inner sole 62 prevents rearward movement of the toe support, it is the inner sole 62, not the short shank 50, which prevents such movement. The only stated function of the short shank 50 is to cooperate with the toe support 44 to provide a support enabling the wearer to stand on his or her toes. Hansen provides no indication that the short shank 50 will serve to prevent rearward movement of the toe support 44.

In light of the above, we conclude that the examiner has failed to set forth a prima facie case that the subject matter of claim 10, or claims 15 and 17 which depend therefrom, is anticipated by Hansen. Thus, this rejection will not be sustained.

As for the examiner's obviousness rejection of claims 11-14, 16 and 18-20 which depend from claim 10, even if the examiner is correct that it would have been obvious to make the modifications proposed therein, this would still not cure the deficiency of the Hansen shoe discussed above. Accordingly, we also shall not sustain this rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10, 15 and 17 under 35 U.S.C. § 102(b) and claims 11-14, 16 and 18-20 under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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