

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

MAY 29 1996

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH BIRKE

Appeal No. 96-0026
Application 07/890,612¹

HEARD: MAY 8, 1996

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

DECISION ON APPEAL

Josef Birke (appellant) appeals from the final rejection of claims 1-8, all the claims in the application.²

Appellant's invention pertains to an orthopedic shoe

¹ Application for patent filed MAY 29, 1992.

²An amendment filed on August 29, 1994 (Paper No. 13), subsequent to the final rejection, has been entered.

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insert for correction of the adduction of the large toe, the details of which are readily understood from a reading of independent claim 1, reproduced below:

1. An orthopedic shoe insert of plastic material for correcting the adduction of a large toe of a foot, comprising:

a generally horizontal rear foot shell having a front edge lying approximately beneath a ball of the large toe, the ball having a tread;

a rear edge and first and second side edges of the rear foot shell being integral with the bottom of a first portion of an approximately vertical wall;

a second portion of the wall being integral with the first portion and extending forward beyond the front edge;

the second portion being an approximately vertically standing thermoplastic material corrective lobe laterally supporting the large toe, wherein said corrective lobe is molded on a side of said rear foot shell for enabling lateral motion of the large toe, wherein the corrective lobe is inclined slightly; and said corrective lobe having a slightly curved concave inside surface and a lower edge convexly curved for enabling the unimpeded rolling motion of the foot during walking.

A reference of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 is:

Cook

4,729,369

Mar. 8, 1988

In addition, the examiner relies upon appellant's admitted prior art (AAPA) as described on page 2, second paragraph, of appellant's specification.

Claims 1-8 stand rejected under 35 U.S.C. § 103 as

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being unpatentable over AAPA in view of Cook.³ The examiner states:

The instant specification, page 2, paragraph 2 discloses known corrective inserts substantially as claimed including a corrective lobe molded on the side of the rear foot shell of the insert adjacent the large toe. Cook teaches the use of a corrective splint for conditions in which non-rigid immobilization of the large toe is desired, column 3, lines 1-5. The splint is formed of any suitable thermoplastic material, column 3, lines 52+ Column 4, lines 1-7, state that the splint is required only to have a degree of rigidity at body temperature. Further, the splint is molded manually to approximate the contours of the foot or great toe and therefore can assume any number of configurations. In would have been obvious . . . to provide the lobed corrective device of the instant specification with a lobe formed from a thermoplastic material, as taught by Cook, because doing so provides a corrective device which may be altered to suit each particular wearer. [answer, pages 3-4]

Although not specifically stated, as we understand it, it is the examiner's position that modification of the AAPA insert in the manner described above, and use of the resulting insert in the manner set forth in Cook, i.e., molding the

³In the final rejection, claims 1-8 were also rejected under 35 U.S.C. § 112, second paragraph. Since (1) these claims have been amended subsequent to the final rejection in such a manner so as to apparently overcome the examiner's rejection on this ground and (2) no mention of this rejection has been made by either appellant in their brief or the examiner in the answer, we presume the examiner has withdrawn the final rejection of the appealed claims on this ground. See *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

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thermoplastic material to conform to the individual user's foot, would inherently result in an orthopedic insert which corresponds to the claimed insert in all respects.

We will not sustain this rejection.

We begin with a discussion of the admitted prior art. In pertinent part, the description of the admitted prior art found on page 2 of the specification upon which the examiner relies reads as follows:

Such inserts . . . typically consist of a foot bed-like rear foot shell which has a corrective lobe molded on the side adjacent to the large toe. The lobe is constructed such that the large toe is pressed into the desired direction toward the remaining toes. With progressive correctional success however, expensive new inserts are necessary since such correctional devices cannot be secured to this type of insert.

As is apparent from the above, this description is short on details of the insert. For example, it is not clear whether the AAPA insert has a corrective lobe second portion extending forward beyond the front edge of the shell, as required by claim 1. It is also not clear whether the corrective lobe portion of the AAPA insert is made of thermoplastic material, as set forth claim 1. Furthermore, it is would appear that the corrective lobe of the AAPA insert does not enable lateral motion of the large toe, as called for in claim 1, since the AAPA insert is described as pressing the large toe into the desired direction

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toward the remaining toes. Finally, claim 1 also requires that the corrective lobe is inclined slightly to the vertical, has a slightly curved concave inside surface, and has a lower edge convexly curved for enabling the unimpeded rolling motion of the foot during walking. It is not clear that the corrective lobe of the AAPA insert has any of these features. Thus, contrary to the examiner, we do not consider the second paragraph on page 1 of appellant's specification to disclose a known corrective insert "substantially as claimed."

Turning to Cook, the correction device thereof comprises a splint made of thermoplastic material rigid at body temperature. The splint may be heated until soft, shaped to conform to the foot of the user, and then allowed to cool, whereupon it once again becomes rigid for use. While Cook's specification at column 3, lines 1-5, states that the device may be used for "any condition in which non-rigid immobilization of the great toe is desirable," this statement must be read in the context of the remainder of the disclosure. For example, Cook elsewhere states that "[i]t is necessary that the splint member 20 maintain rigidity at body temperature" (column 3, lines 61-62) and that the thermoplastic material from which the split is made is selected "so [that] splint member 20 has the necessary rigidity at body temperature, yet can be molded into the desired configuration at a temperature which can be manually handled

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comfortably" (column 4, lines 4-7). In addition, an important objective of Cook is for "holding the great toe in the necessary position for proper bone alignment" (column 2, lines 57-59). To this end, the toe encircling section 24 "is molded around the great toe 44 so as to hold it in the desired position" (column 4, lines 58-60). It is our view that when the Cook disclosure is read in its entirety, it would be regarded by one of ordinary skill in the art as teaching a splint that provides at least semi-rigid retention or immobilization of the large toe.

We agree with the examiner that it would have been obvious to make the AAPA insert of thermoplastic material in view of Cook. However, following a fair reading of the teachings of Cook, it appears to us that in so doing the ordinarily skilled artisan would have selected a thermoplastic material that is rigid at body temperature. Since the lobe of the AAPA insert "is constructed such that the large toe is pressed into the desired direction toward the remaining toes" and since the splint of Cook is designed "for holding the great toe in the necessary position for proper bone alignment," it is highly doubtful that the resulting insert would be inherently capable of enabling lateral motion of the large toe, as implied by the examiner. Moreover, we cannot support the examiner's position that the ordinarily skilled artisan would have selectively incorporated only so much of the structure of Cook's toe splint into the insert

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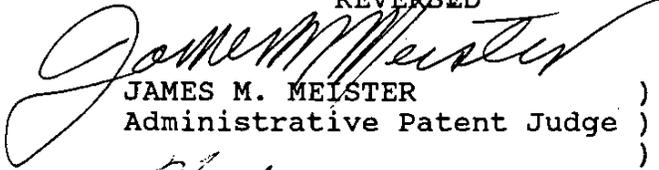
of AAPA such that the result would be an integral first portion extending forward beyond the front edge of the rear foot shell and having the structural features called for in the last paragraph of claim 1. From our perspective, the examiner has used the appellant's disclosure as a road map to incorporate only those teachings of Cook in the AAPA insert which support the rejection while disregarding those teachings of Cook, i.e., a rigid loop section which completely encircles the large toe, which teach away from the claimed subject matter. As aptly pointed out by appellant on page 7 of the brief, such selective use of the teachings of the prior art is improper. See *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

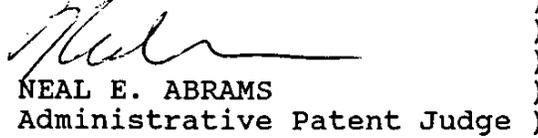
While we appreciate that certain structural features called for in the last paragraph of claim 1 may be said to exist in Cook, it is our view that the combined teachings of AAPA and Cook, at best, would have suggested to one of ordinary skill in the art the incorporation into the AAPA insert of a toe encircling band or loop which rigidly retains and immobilizes the large toe. Such a construction, however, would not correspond to the claimed subject matter.

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The decision of the examiner is reversed.

REVERSED


JAMES M. MELSTER)
Administrative Patent Judge)


NEAL E. ABRAMS)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)

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