

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye
Serial No.: 10/790,923
Filing Date: March 1, 2004
Confirmation No.: 1435
Group Art Unit: 3728
Examiner: Marie D. Patterson
Title: SHOE AND LAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the final decision of the Examiner issued October 6, 2011 finally rejecting Claims 1, 5-7, 11, 15, 16, 19, and 21-24. In response to the Notice of Panel Decision from Pre-Appeal Brief Review issued June 15, 2012, Applicant respectfully submits herewith their brief on appeal.

REAL PARTY IN INTEREST

The present application is owned by inventor/applicant Nancy C. Frye.

RELATED APPEALS AND INTERFERENCES

There are no known current appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal. The present Application was earlier appealed to the Board resulting in a Decision on Appeal issued March 1, 2010.

SUMMARY OF CLAIMED SUBJECT MATTER

With respect to Independent Claim 1, there is provided a shoe 810 including an upper 814 and an insole 816 enclosed by the upper 814. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. An outsole 812 supports the insole 816 and has a planar support surface 818 directly supporting the forward toe section and the rear heel section of the insole 816 and a planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 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. The forward toe section of the insole 816 has a substantially constant thickness 820 from a forward periphery edge 822 of the shoe 810 to the rear heel section, the rear heel section of the insole 816 having a decreasing thickness 826 from the forward toe section of the insole 816 to a rear periphery edge 828 of the shoe 810. The rear heel section of the insole 816 and the forward toe section of the insole 816 meet at a point substantially halfway with respect to the upper surface. (See FIGURE 14 and page 29, lines 6-28).

With respect to Independent Claim 11, there is provided a shoe 810 comprising an upper 814 and an insole 816 under the upper. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. The insole 816 is configured with a constantly thick forward toe section 820 and a decreasingly thick rear heel section 826. A outsole 812 lies under the insole 816 and has a planar support surface directly supporting the forward toe section of the insole 816 and the rear heel section of the insole 816 and a planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 to place a wearer's foot in a dorsiflexion position, wherein the constantly thick forward toe section 820 of the insole 816 and the decreasingly thick rear heel section 826 of the insole 816 meet at a point substantially halfway with respect to the outsole 812. (See FIGURE 14 and page 29, lines 6-28).

With respect to Independent Claim 16, there is provided a shoe 810 comprising an upper 814 and an insole 816 enclosed by the upper 814. The insole 816 is a single piece layer of the shoe 810 and has a forward toe section and a rear heel section. A midsole 829 separates an outsole 812 from the forward toe section of the insole 816 and the rear heel section of the insole 816. An outsole 812 supports the midsole 829 and the insole 810 and has a planar support surface supporting the midsole 829 and the insole 816 and has a planar walking surface. The rear heel section of the insole 816 has a surface closer to the planar walking surface of the outsole 812 than a surface of the forward toe section of the insole 816 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. The forward toe section of the insole 816 has a substantially constant thickness 820 from a forward periphery edge 822 of the shoe 810 to the rear heel section of the insole 816. The rear heel section of the insole 816 has a decreasing thickness 826 from the forward toe section of the insole 816 to a rear periphery edge 828 of the shoe 810. The rear heel section of the insole 816 and the forward toe section of the insole 816 meet at a point substantially halfway with respect to the outsole 812. (See FIGURE 14 and page 29, lines 6-28).

ARGUMENT

1. The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. The Examiner has indicated that the drawing changes submitted to show every feature of the claimed invention, namely adding a midsole 829 and moving the location of point 824 where the first portion 820 and the second portion 826 meet, constitute new matter. Applicant respectfully traverses this objection.

The Examiner stated in the Final Action of October 6, 2011 that the midsole, provided in Claims 16 and 21-24, must be shown and no new matter should be entered. With respect to the addition of midsole 829, Applicant's specification discloses a midsole that is a feature of Claims 16 and 21-24. Applicant submitted a replacement drawing sheet including a midsole 829 as specifically requested by the Examiner. The Examiner objected to the replacement drawing sheet as containing new matter. The Examiner stated that the specification does not provide clear basis for claiming a midsole. Applicant has shown that the specification clearly discloses that the shoe can have one or more midsoles. See page 29, lines 11-13, of Applicant's specification, where insole 816 may be in direct contact with surface 818 of outsole 812 or may be separated therefrom by one or more midsoles. The replacement drawing sheet requested by the Examiner does no more than show a midsole 829 separating an insole 816 from an outsole 812 as expressly disclosed in Applicant's specification. Moreover, the Examiner took Official Notice earlier during examination of the present Application that the use of midsoles between an insole and an outsole is well known and conventional but still continues to assert that new matter is being added to the drawings with the

insertion of a midsole despite this Official Notice and despite the express disclosure in Applicant's specification. The replacement drawing sheet (FIGURE 14) did not add any special characteristics to midsole 829 when amended to include a midsole as requested by the Examiner. The addition of midsole 829 is consistent with the language of Applicant's specification. Thus, Applicant's specification provides clear basis for claiming a midsole.

In the Final Action of October 6, 2011, the Examiner objected to the midsole in the replacement drawing sheet as the thickness, shape, and exact location were considered to be new matter. Applicant's specification discloses the thickness, shape, and exact location for a midsole at page 22, lines 7-12, and page 29, lines 11-13. In particular, the specification states that the midsole provides cushioning, the shape of the midsole includes substantially planar surfaces, and the exact location of the midsole is between the insole and the outsole. Thus, the replacement drawing sheet requested by the Examiner does no more than show a midsole well known to those of skill in the art separating an insole providing the claimed benefits of a negative heel configuration from an outsole as expressly disclosed in Applicant's specification. The Examiner has improperly denied entry of the replacement drawing sheet on the grounds of new matter despite the more than ample support for the matter in Applicant's specification. As a result, the Examiner's insistence that new matter beyond the disclosure of Applicant's specification has been added with respect to a midsole is without justification. Therefore, Applicant respectfully submits that the replacement drawing sheet does not contain new matter by the addition of midsole 829 and is in compliance with 37 C.F.R. §1.83(a).

With respect to the location of midpoint 824, Applicant has also shown that Applicant's specification clearly shows that the first portion 820 and the second portion 826 meet at a point 824 substantially halfway with respect to the upper or outsole of the shoe. (See page 29, lines 16-20, of Applicant's specification). Point 824 in the replacement drawing sheet is shown at the substantially halfway point of the shoe. The changes made to the drawings, as specifically required by the Examiner, literally track the exact language of Applicant's specification without deviation therefrom. Despite this express description of the location of point 824 being substantially halfway across a length of the shoe, the Examiner stated that the specification does not provide any basis for changing the location of point 824 to the specified location. However, as pointed out above, Applicant's specification expressly states the location of point 824 and thus the Examiner's reason that Applicant's specification does not provide any basis for changing the location of point 824 is without merit. Moreover, in the Decision on Appeal of March 1, 2010, the Board stated that the Examiner was amenable to the change of location of point 824. Therefore, Applicant respectfully submits that the replacement drawing sheet is in compliance with 37 C.F.R. §1.83(a) and no new matter has been added in accurately reflecting the location of point 824 pursuant to Applicant's specification.

For the convenience of the Board, attached herewith is a copy of the original drawing and a copy of the drawing changes made to accurately show the midsole 829 and the point 824. The drawing changes were made to provide consistency with Applicant's specification and do not add any new matter to the Application. Thus, there is no basis for the Examiner's position of new matter being added by the corrections made to

the drawings. Therefore, Applicant respectfully submits that the amended drawings are in accordance with 37 C.F.R. §1.83(a).

2. Claims 1, 5-9, 11, 14-16, and 19-24 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. The Examiner rejects the claims due to confusion between the specification and drawings as to a location of point 824 and the inclusion of a midsole 829. Applicant respectfully traverses this rejection.

For Claims 16 and 21-24, one of ordinary skill in the art would clearly recognize from Applicant's specification that the exact location of the midsole 829 is between the insole and the outsole and the midsole 829 has cushioning and a shape with planar surfaces to define its thickness to allow the negative heel configuration to be provided by the insole in accordance with the claimed invention. See page 22, lines 7-22, and page 29, lines 11-13, of Applicant's specification. Moreover, for Claims 1, 11, and 16, the specification clearly describes the location of the point 824 where the constantly thick forward toe section of the insole meets the decreasingly thick heel section as being substantially halfway across the shoe. See page 29, lines 16-20, of Applicant's specification. As a result, everything provided in the claims is expressly described in and enabled by Applicant's specification. The Examiner has yet to dispute that there is clear disclosure in Applicant's specification for the language provided in the claims. As a result, the claims contain subject matter that is described in the specification to enable one of skill in the art to make and/or use the invention.

The basis for this rejection is the apparent inconsistency between the specification and the original drawings. The claims have not been rejected for adding new matter. A proper replacement drawing sheet with amendments to FIGURE 14 has been submitted to clear up any apparent consistencies with Applicant's specification by showing a

midsole 829 and point 824 substantially halfway across a length of the shoe. Applicant's attempt to address any inconsistency between the specification and drawings through minor changes to the drawings, changes expressly described in Applicant's specification, have been rebuffed for adding new matter. However, no justification has been provided for the Examiner's conclusion of new matter as the two minor changes to the drawings, the depiction of a basic midsole 829 and the location of point 824, are expressly provided for in Applicant's specification. Despite any inconsistencies, one of skill in the art would be able to easily make or use the invention provided in the claims from the subject matter described in Applicant's specification. Therefore, Applicant respectfully submits that Claims 1, 5-7, 11, 15, 16, 19, and 21-24 are in compliance with 35 U.S.C. §112, first paragraph.

The issue of new matter in the corrected drawings were raised on a previous appeal to the Board of Patent Appeals and Interferences. In the Decision on Appeal, the Board stated therein it would not take up the Examiner's objections to the drawings as this issue is reviewable by petition. Applicant subsequently petitioned for entry of the replacement drawing sheet. The petition was dismissed as being appropriate for consideration on appeal to the Board of Patent Appeals and Interferences. Applicant submitted a renewed petition to point out inconsistencies between the Board's position that the issue is reviewable by petition and the Director's petition that the issue is ripe for appeal. The renewed petition was denied stating that the rejections under 35 U.S.C. §112, first paragraph, and the correction of the drawings depend on the same issue. Thus, it appears that the recourse is to request review herein of this issue by the Board.

