

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIMMY TSEN, JASON L. NEVANS, JONATHAN BEARDSLEY
and MATTHEW SUMNER

Appeal No. 2005-1496
Application 09/994,439

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jimmy Tsen et al. appeal from the final rejection of claims 1 through 6, 8 through 27 and 29 through 32, all of the claims pending in the application.¹

¹ Claims 8 and 29 have been amended subsequent to final rejection.

THE INVENTION

The invention relates to "a shoe constructed using a vulcanization process" (specification, page 1). Representative claim 1 reads as follows:

1. A shoe comprising

a molded rubber outsole;

a molded midsole disposed within said outsole, said midsole being contoured to approximate the shape of the sole of a wearer's foot;

an upper; and

a foxing, said foxing being fused to said upper and said outsole along an interface there between by application of a vulcanization process permanently securing together said upper and said outsole.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Campagna	2,481,389	Sep. 06, 1949
Taber	3,932,950	Jan. 20, 1976
Giese et al. (Giese)	5,572,805	Nov. 12, 1996

Appeal No. 2005-1496
Application 09/994,439

THE REJECTION

Claims 1 through 6, 8 through 27 and 29 through 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taber in view of Giese and Campagna.

Attention is directed to the main and reply briefs (filed February 19, 2004 and May 21, 2004) and answer (mailed March 19, 2004) for the respective positions of the appellants and examiner regarding the merits of this rejection.

DISCUSSION

I. Grouping of claims

As the appellant, stating that "[c]laims 1-6, 8-27, and 29-32 stand or fall together" (main brief, page 2), has not argued separately the patentability of any particular claim apart from the others, all of the appealed claims shall stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

II. The merits

Taber, the examiner's primary reference, discloses an athletic shoe 20 comprising an upper 22, an insole 24, a midsole 26 and a rubber outsole 28. For purposes of the appealed rejection, the examiner focuses on the embodiment illustrated in Figure 7 wherein "the upper 22 may be . . . fastened by tape 52 to the outsole 28" (column 2, lines 63 through 65).

It is not disputed that this prior art shoe responds to all of the limitations in representative claim 1 except for those requiring the midsole to be disposed "within" the outsole, the midsole to be "contoured to approximate the shape of the sole of a wearer's foot," and the foxing to be "fused" to the upper and outsole along an interface therebetween "by application of a vulcanization process." In this regard, Taber shows midsole 26 as disposed on but not "within" outsole 28, does not describe midsole 26 as being contoured, and does not convey the particular manner in which tape or foxing 52 is affixed to the upper and outsole along their interface to secure them together. To account for these deficiencies, the examiner turns to Giese and Campagna.

Giese discloses a shoe bottom having a desirable combination of cushioning and stability (see column 2, lines 14 through 22). In general, the bottom 1 includes a relatively firm lower layer 2, a relatively soft upper layer 3 having an upper surface contoured to complement the shape of a wearer's sole and, when the bottom 1 is used in an athletic shoe, a rubber outsole 5 beneath the lower layer 2. As shown in Figures 78 through 82, the outsole 5 may take the form of a shell having an upwardly extending peripheral rim for receiving the lower and upper layers therein (see column 10, lines 36 through 47). Giese explains with respect to the embodiment shown in Figures 6 through 10 that such a shell or cup-shaped configuration maintains the relatively soft layer in the center of the shoe bottom to assist its shock absorbing function and prevents lateral deformation thereof which can lead to premature failure of the layer (see column 8, lines 51 through 64; and column 1, line 60, through column 2, line 4).

Campagna discloses a shoe comprising, inter alia, an upper 1, a rubber outer sole 7 and a foxing 9 composed of gum rubber or a rubber-coated fabric vulcanized over the joint or seam between the upper and outer sole (see Figure 2 and column 4, lines 20 through 30).

Appeal No. 2005-1496
Application 09/994,439

In proposing to combine Taber, Giese and Campagna to reject representative claim 1, the examiner submits that it would have been obvious "to provide a sole comprising a contoured midsole and shell shaped outsole as taught by Giese and to form a seam between the outsole and upper and vulcanize a foxing thereon as taught by Campagna in the shoe and method of Taber to increase comfort, support, stability, durability, etc." (answer, pages 3 and 4).

The appellants counter that the examiner's rejection is unsound because it is predicated on an impermissible hindsight reconstruction of the claimed invention wherein the examiner has selectively chosen and combined features from Taber, Giese and Campagna without any suggestion in these references to do so.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

In the present case, Giese's description of the cushioning and stability benefits afforded by (1) the contoured upper surface of soft upper layer 3 (which effectively constitutes a midsole) and (2) the shell configuration of outsole 5 would have provided the artisan with ample suggestion or motivation to so contour and configure Taber's midsole 26 and outsole 28, respectively. Moreover, Campagna's use of a vulcanization step to affix foxing 9 would have provided the artisan with ample suggestion or motivation to utilize this conventional technique to effect the fixing of Taber's tape or foxing 52 to upper 22 and outsole 28 to secure them together. Hence, the appellants' hindsight arguments are not persuasive.

As so modified in view of Giese and Campagna, the shoe disclosed by Taber would respond to all of the limitations in claim 1. Thus, the combined teachings of these references justify the examiner's conclusion that the differences between the subject matter recited in this claim 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. We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of representative claim 1, and claims 2

Appeal No. 2005-1496
Application 09/994,439

through 6, 8 through 27 and 29 through 32 which stand or fall therewith, as being unpatentable over Taber in view of Giese and Campagna.

SUMMARY

The decision of the examiner to reject claims 1 through 6, 8 through 27 and 29 through 32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
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Appeal No. 2005-1496
Application 09/994,439

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