

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. JOHNSON, JR.
and WILLIAM G. THOMAS

Appeal No. 1998-2081
Application No. 08/562,009

HEARD: APRIL 7, 2000

Before FRANKFORT, STAAB, and BAHR, Administrative Patent
Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 1998-2081
Application No. 08/562,009

This is a decision on an appeal from the examiner's final rejection of claims 1-18 and 20-24, all the claims currently pending in the application.¹

Appellants' invention pertains to an "improved cushioned footwear of the type such as goodyear welt constructed footwear" (specification, page 1). Claim 1 is representative and reads as follows:²

1. An improved footwear of goodyear welt construction including an upper [60], an insole [10] having a forward and rear heel portion and an opening in the heel portion thereof, an outsole [19] having a forward and rear heel portion and an opening thereof in alignment with said opening in the heel portion of the insole, a heel [20], nails [21, 22] which extend into the heel portion of said insole and said outsole but not into the openings in the heel portion of said insole and said outsole and a cushioning element [24] having a heel plug [28] which extends into the openings in said insole and said outsole.

The references relied upon by the examiner as evidence of obviousness are:

Hurley	1,718,906	Jun. 25, 1929
Blakely	1,781,715	Nov. 18, 1930
Cohn 1935	1,993,208	Mar. 5,

¹An amendment filed subsequent to the final rejection canceling claim 19 has been entered.

²The bracketed reference numerals added to the claim relate the claim elements to appellants' Figure 1.

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22 extending into the heel portions of the insole and the outsole (see Figure 2), and a cushioning element B having a heel plug 14. The cushioning element B of Cohn is interposed between the insole and the outsole.

Hurley discloses a cushion heel shoe comprising an upper 12, an insole 14 having an opening in a heel portion thereof, an outsole 20 having an opening in a heel portion thereof in alignment with the opening in the insole, a heel 24, and a cushion heel support 30 (see Figure 1) having a plug 34 extending into the openings in the insole and outsole.

The examiner considers that Cohn discloses the invention substantially as claimed "except for the exact cushioning element and openings in the insole and outsole for receiving the heel plug of the cushioning element" (answer, page 4). It is the examiner's position, however, that it would have been obvious to one of ordinary skill in the art

to provide openings in the insole and outsole as taught by Hurley in the shoe of Cohn to improve comfort by placing the cushion above the insole and to improve cushioning in the heel portion of the shoe by increasing the depth of the heel plug.
[Answer, page 4.]

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It thus appears that the examiner proposes to relocate the cushioning element B of Cohn to a position above the insole 3, and to provide aligned openings in the heel portions of the insole and outsole of Cohn to receive the heel plug 14 of the relocated cushioning element, in view of Hurley.

We appreciate the similarities between various elements of the claimed footwear and the footwear of Cohn and Hurley. Nevertheless, it is our view that the standing rejection of claims 1, 2, 6-8, 12, 20 and 21 is not sustainable. For one thing, the examiner's motivation for the proposed modification, namely, "to improve cushioning the heel portion of the shoe by increasing the depth of the heel plug" (answer, page 4), is suspect because there is no suggestion in Cohn or in Hurley that the cushioning element B of Cohn's shoe might be inadequate for its intended purpose, or that the proposed modification of Cohn would actually result in improved cushioning as suggested by the examiner. In addition, Cohn expressly states that locating the cushioning element between the insole and the outsole is advantageous "in points of simplicity and efficiency, and, at the same time proves itself comparatively inexpensive in cost of manufacture" (page 1,

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left column, lines 21-24). In our opinion, this express statement of the advantages of locating Cohn's cushioning element between the insole and the outsole would have acted as a clear disincentive to one of ordinary skill in the art to relocate that cushioning element as proposed by the examiner. Furthermore, the examiner's proposed "modification" of Cohn is more along the lines of a complete reworking of the shoe construction thereof for no apparent reason other than to meet the terms of the claims.

Our court of review has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), *cert. denied*, 480 USPQ 947 (1987). We think that, in this

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instance, the examiner has improperly relied upon hindsight in an attempt to piece together the subject matter required by the appellant's claims 1, 2, 6-8, 12, 20 and 21. It follows that the standing rejection of these claims as being unpatentable over Cohn in view of Hurley cannot be sustained.

We have also reviewed the Leahy reference, applied along with Cohn and Hurley against claims 3-5 and 9-11, and the Blakely reference, applied along with Cohn and Hurley against claims 12-15 and 22-24. In addition, we have considered the combined teachings of Leahy and Blakely, applied along with Cohn and Hurley against claims 16-18. In each instance, we find nothing in Leahy and/or Blakely which makes up for the deficiencies of Cohn and Hurley noted above. Accordingly, we also will not sustain the standing 35 U.S.C. § 103 rejections of claims 3-5, 9-18 and 22-24.

The decision of the examiner is reversed.

REVERSED

Charles E. Frankfort)
Administrative Patent Judge)
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PATENT	Lawrence J. Staab) BOARD OF
	Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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