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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DALE BATHUM

Appeal 2014-007437
Application 11/829,848
Technology Center 3700

Before MICHAEL L. HOELTER, THOMAS F. SMEGAL, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant¹ appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1–5, 7–12, 14, and 17–34.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Appellant identifies Ra Footwear, LLC as the real party in interest. Appeal Br. 2.

² Claims 6, 13, 15, and 16 are cancelled. Appeal Br. 12–17 (Claims App.).

THE CLAIMED SUBJECT MATTER

The claims are directed to “footwear and, more particularly, toward shoes with side panels including decorative elements.” Spec. ¶1. Claims 1, 8, and 18 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A shoe assembly, comprising:
 - a sole assembly;
 - an upper coupled to the sole assembly, the upper including a first panel; and
 - a hand gesture element on the first panel, the hand gesture element including at least three simulated digits of a hand, wherein at least one of the at least three simulated digits is in a simulated position other than a fully extended position.

REFERENCES

In rejecting the claims on appeal, the Examiner relied upon the following prior art:

Hard	US D164,235	June 29, 1950
Winters	US D341,474	Nov. 23, 1993
Hatfield	US 5,377,430	Jan. 3, 1995
Nguyen	US D451,664 S	Dec. 11, 2001

REJECTIONS

The Examiner made the following rejections:

1. Claims 1, 5, 8, 12, and 18–22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hard.
2. Claims 1, 2, 4, 5, 7–9, 11, 12, 14, 17–29, and 31–34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hatfield.

3. Claims 1, 4, and 30–32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen.

4. Claims 2, 3, 9, 10, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hard and Winters.

Appellant seeks our review of these rejections.

ANALYSIS

The Rejection of Claims 1, 5, 8, 12, and 18–22 As Anticipated By Hard

Appellant argues claims 1, 5, 8, 12, and 18–22 as a group. Appeal Br. 4–6. We select claim 1 as the representative claim, and claims 5, 8, 12, and 18–22 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

In response to the Examiner’s finding that Hard discloses all of the limitations of claim 1, Appellant argues that, according to the Specification, “hand gesture elements ‘are expressive of an idea, phrase, symbol, opinion, emotion’” Appeal Br. 4 (citing to Spec., p. 4:11-12). Appellant continues that the “recited hand gesture element is not simply an arbitrary image of a hand, but is instead a hand element arranged to communicate a particular *message* to those who view it. In contrast, Hard portrays an image of a cowboy holding a pair of guns in his hands.” *Id.* (footnote omitted, emphasis added). According to Appellant, Hard’s “hands are not configured to communicate any particular *message*. Instead, those hands simply grip the handles of the guns as part of the cowboy image, and are fully occupied with that task.” *Id.* at 4–5 (emphasis added). In response, the Examiner states “the meaning of the image of a hand is a matter of personal interpretation, and so the images of hands seen in Hard . . . may be considered as gesture elements operating to communicate.” Final Act. 6.

The Specification's definition of "hand gesture element," however, is broader than merely communicating a *message*, as asserted by Appellant. According to Appellant's Specification, the hand gesture element may also express an idea or an emotion. The definition of an "idea" is (1) "something that you imagine or picture in your mind," or "a visible representation of a conception: a replica of a pattern" (Merriam-Webster Dictionary, <http://www.merriam-webster.com/dictionary/idea>, last visited November 2, 2016), or (2) "a mental representation of something" (Free Dictionary, <http://www.thefreedictionary.com/idea>, last visited November 2, 2016). The definition of an "emotion" is "any strong feeling, as of joy, sorrow, or fear." (Free Dictionary, <http://www.thefreedictionary.com/emotion>, last visited November 2, 2016.)

Here, Hard's gloved cowboy is a whimsical image expressing the idea of a smiling young cowboy waiving a pair of pistols in his hands. In view of the Specification's and Appellant's broad construction of "hand gesture element," a person of ordinary skill in the art would understand that Hard discloses a hand gesture element (e.g., idea, emotion) as recited in claim 1.

Appellant also argues that the Examiner "engages in 'hindsight reasoning' that stretches Hard to cover concepts that one of ordinary skill simply would not have recognized from Hard." Reply Br. 2–3. Appellant asserts that "putting aside the fact that (if anything) it is the gun [in Hard] that conveys any intention to shoot and not the hands, the Answer relies on hindsight to attach some communicative meaning to the configuration of those hands in order to find the recited 'hand gesture element.'" *Id.* Appellant, however, does not identify any knowledge relied upon by the Examiner that was gleaned only from Appellant's disclosure and that was

not otherwise within the level of ordinary skill in the art at the time of the invention, thereby obviating Appellant's assertion of hindsight. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Appellant's arguments do not show error by the Examiner. Thus, the rejection of claim 1 is sustained, and claims 5, 8, 12, and 18–22 fall with claim 1.

*The Rejection of Claims 1, 2, 4, 5, 7–9, 11, 12,
14, 17–29, and 31–34 As Anticipated By Hatfield*

In finding that Hatfield discloses all of the limitations of claims 1, 2, 4, 5, 7–9, 11, 12, 14, 17–29, and 31–34, the Examiner explains that Hatfield's straps 56 represent four simulated fingers of a hand and strap 118 represents a simulated thumb. Final Act. 3. We agree with Appellant that these "‘elongated shapes' are simply unrecognizable as fingers of a hand, let alone the recited hand gesture element." Appeal Br. 6. Thus, we cannot sustain the rejection of claims 1, 2, 4, 5, 7–9, 11, 12, 14, 17–29, and 31–34 as anticipated by Hatfield.

*The Rejection of Claims 1, 4, and 30–32
As Unpatentable Over Nguyen*

Claim 1, 4, and 30–32 recite, in part, that one of the "three simulated digits is in a simulated position other than a fully extended position." The Examiner finds that Nguyen's shoe has a first panel, wherein the "first panel has a hand gesture element (hand element, as seen in Fig. 3). The hand gesture element includes at least three simulated digits of a hand. At least one of the digits is in a simulated position other than fully extended (for example, bottom most digit as seen in Fig. 3, this digit being shorter,

therefore simulating a non-extended position).” Final Act. 4. In response, Appellant correctly argues that “Nguyen portrays a pair of Mickey Mouse hands with all four digits fully extended,” Appeal Br. 9 (citing to Nguyen, Figures 3 and 4). Thus, Nguyen does not disclose all of the limitations of the claims, and we cannot sustain the rejections of claims 1, 4, and 30–32 as unpatentable over Nguyen.

*The Rejection of Claims 2, 3, 9, 10, and 24
As Unpatentable Over Hard and Winters*

Appellant argues that claims 2, 3, 10, and 24, which depend from independent claims 1 and 8, are patentable because claims 1 and 8 are patentable over Hard, and Winters does not remedy the deficiencies of Hard. Because we disagree with Appellant regarding the applicability of Hard (*see supra*), and because Appellant does not identify any other patentable features in claim 2, we sustain the Examiner’s rejection of claim 2.

Further, Appellant does not address the rejection of claim 9, and as such we summarily sustain the rejection of claim 9.

Claims 3, 10, and 24 broadly recite a “first hand gesture” that is different from a “second hand gesture.” With respect to these claims, Appellant argues that “the rationale provided by the [Examiner] simply does not follow from the disclosure of Hard, even in view of Winters. In particular, both of the cowboy’s hands in Hard are in the same configuration (i.e., fingers wrapped around the grip, thumb on opposite side of grip, with the index finger near the trigger), so that duplicating that image would not result in two distinct visual elements.” Appeal Br. 11.

In response, the Examiner correctly finds “the left and right hands depicted in Hard are clearly different (a right hand is inherently different than a left hand, they have different orientations, and they are located in different places on the shoe). Therefore, a first (right) hand gesture element would be different than a second (left) hand gesture element.” Ans. 6. Thus, Appellant does not identify error by the Examiner, and the rejections of claims 3, 10, and 24 are sustained.

DECISION

For the above reasons, the Examiner’s rejections of claims 1–3, 5, 8–10, 12, 18–22, and 24 are AFFIRMED.

The Examiner’s rejections of claims 4, 7, 11, 14, 17, 23, and 25–34 are REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2015).

AFFIRMED-IN-PART