



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/036,698	02/28/2011	MICHAEL RIEBER	1612 MR 01 CIP	5440
75207	7590	11/10/2016	EXAMINER	
Gearhart Law LLC 41 River Road Suite 1A Summit, NJ 07901			CONLEY, FREDRICK C	
			ART UNIT	PAPER NUMBER
			3673	
			MAIL DATE	DELIVERY MODE
			11/10/2016	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* MICHAEL RIEBER

---

Appeal 2014-008036  
Application 13/036,698  
Technology Center 3600

---

Before: CHARLES N. GREENHUT, THOMAS F. SMEGAL, and  
GORDON D. KINDER, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims  
1 and 5–17. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### CLAIMED SUBJECT MATTER

The claims are directed to a heel support. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1 A cushioned heel support, comprising:  
a sleeve having a top surface and a bottom surface; and  
a cushioning material disposed within said sleeve, said cushioning material having a 50% compression force deflection in a range of 2.5 to 4 psi, a 25% compression force deflection in a range of 0.25 psi to 1 psi, wherein the cushioning material has a thickness in a range of 0.25 inches to 2 inches and the cushioning material has a compression set characteristic such that after being compressed to 50% of an original thickness for 22 hours, the material returns to 100% of said original thickness.

### REJECTIONS

Claims 1, 5, 8–11, 13, 14, and 17<sup>1</sup> are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schecter (U.S. 6,988,286 B2) and PU Magazine (Vol. 4, No. 5 Oct. 2007).

Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schecter, PU Magazine, and Cooper (U.S. 5,896,603).

Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schecter, PU Magazine, and Kaiserman (U.S. 6,311,350B1)

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schecter, PU Magazine, and Lilley (U.S. 5,855,415).

---

<sup>1</sup> Claim 17 was omitted from the rejection statement but discussed in the rejection. Final Act. 2.

OPINION

Appellant's arguments are grouped according to the rejections, with substantive arguments presented only for the first grouping and the remaining groupings argued based on dependency. *See* 37 C.F.R. § 41.37(c)(iv).

At the outset we must reject Appellant's contention that a dispositive issue in this case is whether it would have been obvious to select the two particular stress ranges recited in each of the independent claims before us, claims 1 and 17. *See* App. Br. 12; dec'l. 3. The Examiner's position, which does not appear to be disputed, is that it would have been obvious to *use the material Akton*, which was known for use in cushions and pads, in Schecter's device. Final Act. 2 (citing PU Magazine 268, 270). This, in combination with selecting a particular size for Schecter's device, would yield the claimed subject matter because the so-called stress ranges of claims 1 and 17 are latent properties of the Akton material. Final Act. 2-3; Ans. 6-8; *see* Spec. 10-12 (confirming the properties of Akton).<sup>2</sup> It is not dispositive that the particular properties are not expressly disclosed in the prior art or form the basis for the material selection process. "What matters

---

<sup>2</sup> *See, e.g., In re Thorpe*, 777 F. 2d 695, 697-99 (Fed. Cir. 1985)(admissions in an applicant's own specification indicating that the applicant's claim distinguish from the prior art by merely reciting latent properties or characteristics of an old product, may be used against an applicant to reject those claims.); *see also Elan Pharmaceuticals, Inc. v. Mayo Foundation*, 304 F.3d 1221 (Fed. Cir. 2002), J. Dyk, *dissenting* (distinguishing inherency from hindsight)(*vacated on other grounds at* 314 F.3d 1299 (Fed. Cir. 2002) (en banc)).

is the objective reach of the claim. If the claim extends to what is obvious, it is [unpatentable] under § 103.” *KSR Int’l. v. Teleflex* 127 S. Ct. 1727, 1742 (2007).

Appellant’s next contention, that the thickness of a cushion was not a known result-effective variable (App. Br. 13–14) is clearly contradicted by the record. Schecter expressly acknowledged that the thickness of the cushion, and its size generally, were parameters to be determined, providing a figure, a discussion, and some examples regarding selecting the filler and overall cushion thicknesses. *See* Schecter Fig. 10; col. 9, l. 54–col.10, l. 15.

We agree with and adopt as our own the Examiner’s analysis of the Kalyon Declaration. Ans. 9–10. In particular, in addition to discussing the issues addressed above, it consists largely of opinion testimony that the claimed subject matter would not have been obvious, without factual supporting evidence. “[A]n expert’s opinion on the legal conclusion of obviousness is neither necessary nor controlling.” *Avia Group Intern., Inc. v. L.A. Gear Calif., Inc.*, 853 F.2d 1557, 1564 (Fed. Cir. 1988). We also note that we agree with the Examiner’s characterization of the disclosure of Schecter spanning columns 7 and 8. *See* Final Act. 2. Although Schecter uses the term “hardness” it is clear that Schecter is not referring to an indentation type hardness, as Appellant contends (dec’l 3–4), because Schecter is expressing values in units of force, Newtons, as opposed to indentation hardness (e.g., Rockwell, Vickers, Shore, or Brinell).

On the record before us, we agree with the Examiner that the evidence of obviousness outweighs the evidence against.

Appeal 2014-008036  
Application 13/036,698

**DECISION**

The Examiner's rejections are affirmed.

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

**AFFIRMED**