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EXAMINER

FAN, HONGMIN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRISTAN LISA AHMILL

Appeal 2015-000210
Application 12/765,526
Technology Center 2600

Before ST. JOHN COURTENAY III, CARLA M. KRIVAK, and
JOYCE CRAIG, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a non- final
rejection of claims 1–42. An Oral Hearing was held November 10, 2016.

We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention is directed "to a personal tracking device integrally associated with a removable insole for footwear" (Spec. ¶1).

Independent claim 1, reproduced below, is exemplary of the subject matter on appeal.

1. A multilayer insole for removable placement in an article of footwear, the multilayer insole comprising:
 - a top side;
 - an underside;
 - two or more layers between the top side and the underside formed from flexible material configured to provide cushioning and/or support to a foot of a wearer within the article of footwear;
 - an insole location data receiver configured to receive an input signal relating to a location of the insole; and
 - an insole location data transmitter configured to transmit an output signal relating to the location of the insole;wherein the insole location data receiver and the insole location data transmitter are both integrally associated with the insole.

REFERENCES and REJECTIONS

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 112 (b) as failing to distinctly claim subject matter Appellant considers as their invention.

The Examiner rejected claims 1, 2, 4, 5, 8–27, and 29–42 under 35 U.S.C. § 103(a) based upon the teachings of Daniel (US 7,714,709 B1; May 11, 2010) and Son (US 2010/0004566 A1; Jan. 7, 2010).

The Examiner rejected claims 3 and 28 under 35 U.S.C. § 103(a) based upon the teachings of Daniel, Son, and Huang (US 5,875,571; Mar. 2, 1999).

The Examiner rejected claims 6 and 7 under 35 U.S.C. § 103(a) based upon the teachings of Daniel, Son, and Schrock (US 2010/0063779 A1; Mar. 11, 2010).

ANALYSIS

Rejection of claims 9 and 10 under 35 U.S.C. § 112 (b)

Appellant contends the Examiner erred in rejecting claims 9 and 10 as having no antecedent basis for the limitations “the bottom surface” and “the top surface.” Appellant asserts an ordinarily skilled artisan “would appreciate that the recitation of ‘a top surface’ is the same as a ‘top side’ and that a ‘bottom surface’ is the same as ‘an underside’” (App. Br. 7). We agree. Thus, we do not sustain the Examiner’s rejection of claims 9 and 10 under 35 U.S.C. §112 (b).

Rejection of claims 1–42 under 35 U.S.C. §103

Appellant contends the Examiner erred in finding Son teaches or suggests embedding a transmitter into a shoe, as the Examiner merely makes conclusory statements about embedding a processor including a transmitter into an insole (App. Br. 10–11). Further, Appellant asserts it would not have been obvious to integrally incorporate the electronics module taught by Daniel into an insole so it can be easily movable between different shoes, as Daniel’s electronic module is already moveable between shoes, and therefore “teaches away from integrating the module into an insole which *cannot* be interchanged between shoes of different sizes,” as the Examiner finds (App. Br. 11–13). We do not agree.

We first note Son is cumulative to the Examiner’s findings, as Daniel discloses the electronic module 10 “comprises communication circuitry 14

which enables it to transmit (and selectively receive) signals” (emphasis omitted) (Daniel col. 5, ll. 17–19), thus disclosing a transmitter in an electronic module integrally associated with an insole as claimed. Appellant is arguing the references separately and not the combination asserted by the Examiner.

Second, we note Daniel also “embeds” an electronic module into a sole “integrally located with the insole”), as shown in Figure 2 and within the ordinary meaning of that term.¹ Daniel’s electronic module is also moveable between shoes (the module can be inserted and removed from a cavity within the insole (Daniel col. 5, ll. 48–50; Fig. 2)).

We also find Appellant’s teaching away argument is not persuasive. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citation omitted). In this case, Appellant fails to present evidence that the references criticize or even discourage the proposed combination, particularly, as noted above, Daniel teaches the electronic module can be inserted and removed from a cavity.

¹ Embed: verb **-beds, -bedding, -bedded**

1. (usually foll by in) to fix or become fixed firmly and deeply in a surrounding solid mass: to embed a nail in wood

2. (transitive) to surround closely: hard rock embeds the roots

3. (transitive) to fix or retain (a thought, idea, etc) in the mind

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For the above reasons, on this record, we are not persuaded the Examiner erred. We find a preponderance of the evidence supports the Examiner's ultimate legal conclusion of obviousness, and therefore sustain the Examiner's rejection of independent claims 1, 24, 29, 31, 33, 35, 37, and 40 argued for substantially the same reasons, and their dependent claims 2–23, 25–28, 30, 32, 34, 36, 38, 39, 41, and 42.²

DECISION

The Examiner's decision rejecting claims 9 and 10 under 35 U.S.C. §112 (b) is reversed.

The Examiner's decision rejecting claims 1–42 under 35 U.S.C. §103 is affirmed.

² Claim 31 recites a step of “transmitting an insole output signal, relating to a location of an insole according to claim 1, from the insole” Method claim 31 thus includes a reference to the “insole according to claim 1,” as does method claim 35. In the event of further prosecution, we leave it to the Examiner to determine whether method claims 31 and 35 meet the requirements of 35 U.S.C. § 112, fourth paragraph, for failing to further limit the subject matter of apparatus claim 1. To the extent claims 31 and 35 depend upon claim 1, these method claims fails to specify a further limitation of the subject matter of claim 1 to which it refers, because method claims 31 and 35 are completely outside the scope of apparatus claim 1. *See Pfizer, Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284, 1292 (Fed. Cir. 2006). Moreover, “[a] single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.” MPEP § 2173.05(p)(II) (citing *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (citing *IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005))). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) §1213.02.

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Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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).

AFFIRMED