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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARIO POLEGATO MORETTI

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Appeal 2017-010905  
Application 13/393,041  
Technology Center 3700

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Before LINDA E. HORNER, STEFAN STAICOVICI, and  
ANNETTE R. REIMERS, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject under 35 U.S.C. § 103(a): (1) claims 29–42 and 58 as unpatentable over Peikert (US 2009/0172971 A1, published July 9, 2009) and Moretti '183 (US 2006/0162183 A1, published July 27, 2006); and (2) claims 43–45, 48, 57, and 59 as unpatentable over Peikert and Moretti '238 (US 2007/0275238 A1, published Nov. 29, 2007), and to reject claims 29–31, 36–45, and 48 on the ground of non-statutory double

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as GEOX, S.P.A. Appeal Brief (“Appeal Br.”) 2, filed Apr. 21, 2017.

patenting as unpatentable over claims 1–13 and 16 of U.S. Patent No. 9,032,642 (“the ’642 patent”). Claims 46, 47, and 49–56 have been withdrawn from consideration. Claims 1–28 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

### CLAIMED SUBJECT MATTER

The claimed subject matter “relates to an insert for vapor-permeable and waterproof soles.” Spec. 1:3–4, Figs. 1, 2. Claims 29 and 43 are independent.

Claim 29 is illustrative of the claimed subject matter and recites:

29. An insert for vapor-permeable and waterproof soles, having a stratified and cohesive monolithic sheet-like structure, comprising:

a plurality of waterproof and vapor permeable functional layers, each of the functional layers being made of a polymeric material that is permeable to water vapor and impermeable to water in the liquid state such that no water through passages are present in each of the functional layers, and water in the liquid state is prevented from passing in each of the functional layers from a first side surface of a respective functional layer to a second side surface of the respective functional layer opposite the first side surface; and

at least one functional portion of said insert for soles having such a thickness as to give it a penetration resistance of more than approximately 10 N, assessed according to the method presented in chapter 5.8.2 of the ISO 20344-2004 standard,

wherein the plurality of functional layers are adhered to each other to form the stratified and cohesive monolithic sheet-like structure.

## ANALYSIS

### *Obviousness over Peikert and Moretti '183*

#### *Claims 29–42 and 58*

Independent claim 29 is directed to an insert for vapor-permeable and waterproof soles, having a stratified and cohesive monolithic sheet-like structure that includes a plurality of waterproof and vapor permeable functional layers, “wherein the plurality of functional layers are adhered to each other to form the stratified and cohesive *monolithic* sheet-like structure.” Appeal Br. 17 (Claims App.) (emphasis added). The Examiner finds that “Peikert discloses an insert (33b & d, 237) for vapor-permeable and waterproof soles, having a stratified and cohesive monolithic sheet-like structure (Fig.23).” Final Act. 3<sup>2</sup>; *see also* Ans. 3.<sup>3</sup> (“Peikert’s 237 and 33b & 33d when directly attached to one another and assembled into a finished sole do constitute a monolithic insert insofar as is claimed.”). The Examiner also finds that “when in combination Peikert and Moretti teach the plurality of functional layers are adhered to each other to form the stratified and cohesive monolithic sheet-like structure (as they would all form one unit in a completed product).” Final Act. 4.

Appellant contends that the claimed insert “is not just a mere sum of separate layers, but rather it is a ‘monolithic’ insert.” Reply Br. 3.<sup>4</sup> Citing to Merriam Webster’s online dictionary, Appellant states that the term “monolithic” means “*formed or composed of material without joints or seams*” or “*consisting of or constituting of a single unit*.” *Id.*

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<sup>2</sup> Final Office Action (“Final Act.”), dated Sept. 20, 2016.

<sup>3</sup> Examiner’s Answer (“Ans.”), dated June 19, 2017.

<sup>4</sup> Reply Brief (“Reply Br.”), filed Aug. 21, 2017.

Appellant further contends that “Peikert discloses a mere sum of separate layers (the functional-layer laminate 237 and the barrier material 33b & d) which are ‘*directly attached to one another*’ . . . : therefore the separate layers disclosed by Peikert do not constitute an insert ‘*without joints and seams*’” and that “the separate layers disclosed by Peikert do not ‘*constitute a single unit*’ at least in the areas of the through holes 135 wherein the attaching glue is not applied.” Reply Br. 3 (bolding omitted) (citing Ans. 3, Peikert ¶ 207); *see also* Appeal Br. 7.

Appellant has the better position here. Although Appellant’s Specification does not explicitly define the term “monolithic,” the Specification describes that the insert is “characterized in that it has a stratified and cohesive monolithic sheet-like structure, which comprises a plurality of functional layers made of a polymeric material.” Spec. 7:26–30. The Specification further describes that the production process of the insert includes the sintering step, which “provides for heating the stratified and cohesive sheet to a sintering temperature comprised between the crystalline melting point and the degradation temperature of the material of which it is made” and that sintering of the polytetrafluoroethylene (PTFE) polymer of the plurality of functional layers “is performed by means of the passage of the stratified and cohesive sheet on a roller that is heated to the sintering temperature, each section of the stratified and cohesive sheet remaining in contact with the roller for the sintering time.” *See* Spec. 10:4–8, 11:2–13:5. As sintering the plurality of functional layers would result in a structure that constitutes “a single unit” that is “without joints or seams,” Appellant’s proposed definitions of the term “monolithic” are consistent with Appellant’s use of the term in the Specification.

Peikert discloses:

The shaft **103** is provided on its lower end area on the sole side with a shaft bottom **221**, which has a waterproof, water-vapor-permeable shaft-bottom functional layer, which can be a waterproof, water-vapor-permeable membrane. The functional layer is preferably a component of a multilayer functional-layer laminate [237] that has at least one protective layer, for example, a textile backing, as processing protection, in addition to the functional layer.

Peikert ¶ 182; *see also id.* ¶ 197 (“The shaft-bottom functional layer laminate **237** can be a three-ply laminate, whereby the shaft-bottom functional layer [247]<sup>5</sup> is embedded between a textile backing [246] and another textile layer [244]”); ¶¶ 373, 378, 380, 381; Fig. 23.

Figure 23 of Peikert, cited by the Examiner at page three of the Final Office Action, is a detailed view of Figure 21 of Peikert. *See* Peikert ¶¶ 131, 133. Peikert discloses that Figure 21

shows an example of a barrier unit **35**, in which a piece of barrier material **33** is provided on the bottom with at least one stabilization bar **37**. On the surface area of the barrier material **33** opposite the stabilization bar **37**, an adhesive **39** is applied, with which the barrier material **33** is joined to the waterproof, water-vapor-permeable shaft bottom **221**, which is situated above the barrier unit **35** outside the composite shoe sole. *The glue 39 is applied in such a way that the shaft bottom 221 is joined to the barrier material 33 wherever no material of the stabilization bar 37 is situated on the bottom of the barrier material 33. In this way, it is ensured that the water-vapor-permeability function of the shaft bottom 115 is interfered with by glue 39 only where the barrier material 33 cannot permit any*

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<sup>5</sup> Peikert discloses reference number 248 rather than reference number 247. *See* Peikert ¶ 197. Reference number 248 refers to sealing material. *See id.*; *see also id.* ¶¶ 205, 382. We consider this a typographical error.

*water-vapor transport in any case, because of the arrangement of the stabilization bar 37.*

Peikert ¶ 203 (emphases added), Fig. 21.

From this disclosure, we understand Peikert to disclose that shaft bottom 221, which includes shaft-bottom functional layer laminate 237, is joined via glue 39 to barrier material 33, which includes barrier material parts 33b and 33d, everywhere except where a stabilization bar 37 (i.e., a joint) is situated below barrier material 33. Thus, as shaft-bottom functional layer laminate 237 and barrier material parts 33b and 33d of Peikert are not “directly attached to one another” where barrier material parts 33b and 33d have stabilization bars (i.e., joints) 37, shaft-bottom functional layer laminate 237 and barrier material parts 33b and 33d do not form a “monolithic” insert as claimed. *See Reply Br. 3; see also Ans. 3.*

Additionally, as the Examiner looks to the teachings of Moretti ’183 merely for the disclosure of an auxiliary layer with a functional layer and does not direct us to any discussion in Moretti ’183 of “a plurality of functional layers adhered to each other” to form a stratified and cohesive monolithic sheet-like structure, we disagree with the Examiner that “in combination, Peikert and Moretti teach the plurality of functional layers are adhered to each other to form the stratified and cohesive monolithic sheet-like structure,” as claimed. *See Final Act. 3–4.*<sup>6</sup>

For these reasons, we do not sustain the Examiner’s rejection of claims 29–42 and 58 as unpatentable over Peikert and Moretti ’183.

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<sup>6</sup> We note that the “auxiliary layer” is recited in dependent claim 32 not independent claim 29. *See Appeal Br. 17, 18 (Claims App.).*

*Obviousness over Peikert and Moretti '238*

*Claims 43–45, 48, 57, and 59*

Similar to independent claim 29, independent claim 43 recites “an insert for soles that has a stratified and cohesive monolithic sheet-like structure, comprising a plurality of waterproof and vapor permeable functional layers,” “wherein the plurality of functional layers are adhered to each other to form the stratified and cohesive monolithic sheet-like structure.” Appeal Br. 17, 19–20 (Claims App.).

The Examiner relies on the same unsupported findings in Peikert as discussed above for claim 29. *See* Final Act. 9. As stated above, because shaft-bottom functional layer laminate 237 and barrier material parts 33b and 33d of Peikert are not “directly attached to one another” where barrier material parts 33b and 33d have stabilization bars (i.e., joints) 37, shaft-bottom functional layer laminate 237 and barrier material parts 33b and 33d do not form a “monolithic” insert as claimed. *See* Reply Br. 3; *see also* Ans. 3.

Additionally, we note that neither independent claim 43 nor any of its dependent claims calls for an “auxiliary/intermediary layer.” *See* Appeal Br. 19–23 (Claims App.). The Examiner looks to the teachings of Moretti '238 for “an insert (100) having two polymeric, waterproof and vapor permeable functional layers (112; para. 52 & 61) disposed on either side of an intermediary layer (11) (Fig. 2).” Final Act. 10. The Examiner reasons that the combined teachings of Peikert and Moretti '238 disclose “two waterproof and vapor permeable functional layers being placed on either side of an intermediary layer.” *Id.* However, claim 43 does not require an auxiliary/intermediary layer between two functional layers; rather, claim 43

requires “a plurality of functional layers adhered to each other” to form the stratified and cohesive monolithic sheet-like structure. Appeal Br. 19–20 (Claims App.).

As the Examiner does not direct us to any discussion in Moretti ’238 of “a plurality of functional layers adhered to each other” to form a stratified and cohesive monolithic sheet-like structure, we disagree with the Examiner that “in combination, Peikert and Moretti teach the plurality of functional layers are adhered to each other to form the stratified and cohesive monolithic sheet-like structure,” as claimed. *See* Final Act. 10.

For these reasons, we do not sustain the Examiner’s rejection of claims 43–45, 48, 57, and 59 as unpatentable over Peikert and Moretti ’238.

#### *Double Patenting*

*Claims 29–31, 36–45, and 48*

Appellant requests that this rejection be held in abeyance, pending the outcome of the subject appeal. *See* Resp. After Final Act. 5.<sup>7</sup> This rejection is not a provisional rejection based on a co-pending application, which would give rise to the possibility that the claims cited in rejecting the appealed claims might be amended during the pendency of the appeal, and possibly mooted or changing the underlying basis for the rejection. Rather, the rejection is based on an already-issued patent. *See* Final Act. 12–15. Thus, the rejection is ripe for our review.

Having made no arguments traversing the Examiner’s double patenting rejection, Appellant has not apprised us of error in the rejection.

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<sup>7</sup> Response After Final Office Action (“Resp. After Final Act.”), filed Nov. 21, 2016.

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The Examiner's double patenting rejection of claims 29–31, 36–45, and 48 is therefore sustained. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.”).

#### DECISION

We AFFIRM the Examiner's decision to reject claims 29–31, 36–45, and 48 on the ground of non-statutory double patenting as unpatentable over claims 1–13 and 16 of U.S. Patent 9,032,642.

We REVERSE the decision of the Examiner to reject claims 29–42 and 58 as unpatentable over Peikert and Moretti '183.

We REVERSE the decision of the Examiner to reject claims 43–45, 48, 57, and 59 as unpatentable over Peikert and Moretti '238.

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-IN-PART