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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT C. HOLT

Appeal 2019-000267
Application 14/451,468
Technology Center 3700

Before JOHN C. KERINS, CHARLES N. GREENHUT, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–4, 6, 8–10, 12–14, 16, 17, and 21–26. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ 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 Nike, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a sole structure for an article of footwear with spaced recesses. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A sole structure for an article of footwear comprising:
 - a midsole that has a first side with a first surface and a second side with a second surface;
 - wherein:
 - the second side is opposite from the first side;
 - wherein the midsole has a heel portion, a midfoot portion, and a forefoot portion, the forefoot portion extending from a foremost extent of the midsole to the midfoot portion;
 - the first side has a plurality of recesses in at least the forefoot portion and the midfoot portion;
 - each of the recesses extends toward the second side without extending to the second surface;
 - each of the recesses is configured so that a thickness of the midsole between the second side and a deepest extent of each of the recesses is substantially uniform in dimension;
 - the midsole is a unitary foam material that has a first density in a first portion along the first surface and the second surface, and a second density in a second portion inward of the first portion; and
 - the second density is less than the first density.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Dean	US 2011/0232135 A1	Sept. 29, 2011
Lin	US 2012/0151793 A1	June 21, 2012
Sullivan	US 2012/0180336 A1	July 19, 2012

REJECTIONS

Claim 26 is rejected under 35 U.S.C. § 112(b) as being indefinite.
Final Act. 2.

Claims 1–4, 6, 8–10, 12, 21, 23, and 24 are rejected under 35 U.S.C.
§ 103 as being unpatentable over Sullivan and Dean. Final Act. 3.

Claims 13, 14, 16, 17, 22, 25, and 26 are rejected under 35 U.S.C.
§ 103 as being unpatentable over Sullivan and Lin. Final Act. 9.

OPINION

Indefiniteness

Claim 26 is rejected as indefinite because, in the Examiner's view, claim 26 should recite "the remainder of the midsole" for concordance with claim 13, as opposed to simply "the remainder." Ans. 2. However, "the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." Manual of Patent Examining Procedure (MPEP) § 2173.05(e) (9th ed., Rev. 08.2017, Jan. 2018). Although references to a portion of a thing may inherently implicate the presence of "a remainder," here, the only portion ever referenced in any of claims 26, 25, or 13 in conjunction with a "remainder" is the "outer surface" of the midsole. The Examiner acknowledges "the remainder" was intended to refer to "the remainder of the midsole," the portion that is not the midsole's outer surface. The Examiner has not apprised us of any other possible portion of the claimed structure to which the recited phrase, "the remainder" could reasonably refer. Absent any such ambiguity or lack of clarity there is no indefiniteness for failing to reproduce

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the exact terminology of a previously recited claim element. MPEP § 2173.05(e). Accordingly, we do not sustain the indefiniteness rejection *Obviousness*

Both obviousness rejections are premised on construing similar language, “substantially uniform” in claim 1, and “substantially unvarying” in claim 13, as either covering the spacing between the bottom of the recesses and the underside of the midsole depicted in Sullivan’s Figure 12, or by being suggested by paragraph 8 of Sullivan. Final Act. 4–5, 9–11.

When a relative term, such as “substantially,” is combined with terms of degree such as “uniform” or “unvarying,” in a claim, it must be determined whether the specification provides some standard for one of ordinary skill in the art to understand what is claimed when the claim is read in light of the specification. MPEP 2173.05(b). “[T]he PTO must. . .tak[e] into account any definitions presented in the specification.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) quoting *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002). Appellant’s Specification provides, “[a]s used herein, substantially uniform means that the variation in the thickness 56 is not more than the dimensional tolerance that would be permitted in a production midsole 10.” Para. 40. The Examiner states:

After a full review of Appellant’s specification there is no further explanation as to what parameters are attributed to a “dimensional tolerance”, therefore the recitation of a “dimensional tolerance” does not lend any further specificity (i.e. metes and bounds) to the claimed limitation of a “substantially uniform/unvarying” thickness.

Ans. 6.

Notably, the Examiner has not rejected the claim under § 112(b) for indefiniteness associated with the “substantially uniform/unvarying” terms

in question. Thus, the only issues squarely before us are whether Sullivan discloses (in Figure 12) or suggests (in paragraph 8) uniformity within production dimensional tolerances, and if not, whether the Examiner has articulated sufficient reasons for modifying Sullivan to arrive at subject matter including this.

Clearly, Figure 12 of Sullivan does not disclose uniformity within production dimensional tolerances because undulations are clearly visible and are never described by Sullivan as, for example, greatly exaggerated for purposes of illustration. The most relevant disclosure of cited paragraph 8 states, “[v]oids defined in the metatarsus and calcaneus portions of the sole body may have a depth of between about 45% and 90% a thickness of the sole body.” This may suggest variation of the thickness in question but does not suggest making the thickness uniform or unvarying over each of the recesses in the forefoot and midfoot regions as required by claims 1 and 13, respectively. The Examiner reasons that it would have been obvious to provide such uniformity “in order to provide a midsole having a thickness which delivers the desired optimum support and flexibility to the user’s foot.” Final Act. 5. However, the Examiner has provided neither evidence nor reasoning supported by rational underpinnings to demonstrate why uniformity of thickness under the recesses, specifically, facilitates achieving this goal. Our reviewing court has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). As the Examiner has not established obviousness of

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the subject matter claimed, we do not sustain the Examiner's obviousness rejections.

CONCLUSION

The Examiner's rejections are REVERSED.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
26	112(b)	Indefiniteness		26
1-4, 6, 8-10, 12, 21, 23, 24	103	Sullivan, Dean		1-4, 6, 8-10, 12, 21, 23, 24
13, 14, 16, 17, 22, 25, 26	103	Sullivan, Lin		13, 14, 16, 17, 22, 25, 26
Overall Outcome				1-4, 6, 8-10, 12-14, 16, 17, 21-26

REVERSED