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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/355,801	01/23/2012	Michael R. Adair	ATZ00003	1012
34399	7590	11/01/2019	EXAMINER	
GARLICK & MARKISON 100 Congress Avenue, Suite 2000 AUSTIN, TX 78701			LYNCH, MEGAN E	
			ART UNIT	PAPER NUMBER
			3732	
			NOTIFICATION DATE	DELIVERY MODE
			11/01/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL R. ADAIR and TIMOTHY W. MARKISON

Appeal 2019-002809
Application 13/355,801
Technology Center 3700

Before JENNIFER D. BAHR, JOHN C. KERINS, and LISA M. GUIJT,
Administrative Patent Judges.

BAHR, *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 and 3–13. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION.

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 Athalonz LLC. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Appellant’s invention is directed to “footwear and more particularly to athletic positioning footwear.” Spec. 1:19–20. Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. An apparatus comprises:

a heel platform section that has a uniform height from an outer edge to an inner edge of the apparatus at the rear edge of the apparatus, wherein the uniform height establishes a reference slope from the outer edge to the inner edge, the reference slope substantially parallel to a bottom surface of the apparatus;

a mid-foot section juxtaposed to the heel platform section; and

a toe section juxtaposed to the mid-foot section, wherein the mid-foot section and the toe section form an angled support platform that has a first slope along the inner edge of the apparatus from a front edge of the apparatus to the heel platform section, a second slope along the front edge of the apparatus from the inner edge to the outer edge of the apparatus, and a third slope along the outer edge of the apparatus from the front edge of the apparatus to the heel platform section, the first slope, second slope, and the third slope each greater than the reference slope, wherein the toe section is lower than the heel platform section as a result of the first, second, and third slopes.

EVIDENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Kerrigan	US 2002/0139011 A1	Oct. 3, 2002
Chapman	US 2008/0163513 A1	July 10, 2008
Kraisosky	US 2010/0115793 A1	May 13, 2010

REJECTIONS

- I. Claims 1, 3, 4, 6, 7, 9, 10, and 12 stand rejected under U.S.C. § 102(b) as anticipated by Chapman.
- II. Claims 5, 8, and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chapman and Kerrigan.
- III. Claim 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Chapman and Kraisosky.

OPINION

Rejection I—Anticipation

Claims 1, 3, 4, 9, 10, and 12:

Independent claims 1 and 9 require, in pertinent part, that the uniform height of the heel platform establish a reference slope from the outer edge to the inner edge, the reference slope being “substantially parallel to a bottom surface of the [apparatus or sole],” and “a second slope along the front edge of the [apparatus or sole section] from the inner edge to the outer edge of the [apparatus or sole section]” that is “greater than the reference slope.”

Appeal Br. 10, 12–13 (Claims App.).

The Examiner finds that Chapman’s shoe sole 100 comprises all of the features of the “apparatus” of claim 1 and the “sole section” of claim 9. Final Act. 2–5. In particular, the Examiner finds, in pertinent part, that the “second slope (Fig.10 from 150 to 140)” is “greater than the reference slope (as seen in Fig.5, 200 has no slope from 150 to 140 and the [second slope is] angled which is greater than a region with no slope).” *Id.* at 3.

Appellant emphasizes that claim 1 recites “a second slope along the front edge of the apparatus from the inner edge to the outer edge of the apparatus,” and asserts that, in contrast, “Chapman teaches that, at the ball of

foot area, the shoe is flat from the medial to lateral side.” Appeal Br. 6. Appellant relies on the same argument for independent claim 9, which has substantially the same “second slope” limitation. *Id.*

In response, in support of the finding that Chapman discloses “a second slope along the front edge of the apparatus from the inner edge to the outer edge of the apparatus” that is greater than the reference slope established by the uniform height of the heel platform section, the Examiner states that Figures 4 and 10 of Chapman show “that the top surface of the sole slopes upward at the edges, providing a second slope as claimed along the front edge of the sole from the inner to the outer edges of the sole.” Ans. 4. The Examiner errs in reading the “second slope” of claim 1 on the upward slope of the medial or lateral edge of the front edge (*see* Chapman, Fig. 10) because this upward (positive) slope does not extend “from the inner edge to the outer edge of the apparatus” as required in claim 1. Further, given the similarity in the upper profile of the transverse slice of Chapman’s shoe sole across the rear heel area illustrated in Figure 5 and the transverse slice of the shoe sole across the toe area illustrated in Figure 10, both of which have side walls 400 separated by a flat region, the Examiner’s position that the toe area shown in Figure 10 has a second slope from inner edge 150 to outer edge 140 that is angled and, thus, greater than no slope, appears to be at odds with the Examiner’s position that the rear heel area shown in Figure 5 has no slope from inner edge 150 to outer edge 140.

Thus, we do not sustain the rejection of independent claims 1 and 9, or their dependent claims 3, 4, 10, and 12, as anticipated by Chapman.

Claims 6 and 7:

For the reasons explained below in the new ground of rejection of claims 6–8 under 35 U.S.C. § 112, second paragraph, claims 6 and 7 are indefinite. Having determined that these claims are indefinite, we cannot sustain the rejection of these claims under 35 U.S.C. § 102(b) because to do so would require speculation as to the scope of the claims. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a) because the rejection was based on speculative assumptions as to the meaning of the claims).

Rejections II and III—Obviousness

Claims 5, 11, and 13:

The Examiner’s application of *Kerrigan* and *Kraisosky* does not make up for the deficiency in the rejection of claims 1 and 9, from which claims 5, 11, and 13 depend. *See* Final Act. 7–8; Appeal Br. 11, 13, 14 (Claims App.). Thus, we do not sustain the rejection of claims 5 and 11 as unpatentable over *Chapman* and *Kerrigan* or the rejection of claim 13 as unpatentable over *Chapman* and *Kraisosky*.

Claim 8:

For the reasons explained below in the new ground of rejection of claims 6–8 under 35 U.S.C. § 112, second paragraph, claim 8 is indefinite. Thus, as with claims 6 and 7, we cannot sustain the rejection of claim 8 under 35 U.S.C. § 103(a) because to do so would require speculation as to the scope of the claims. *See In re Steele*, 305 F.2d at 862–63.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50 (b), we reject claims 6–8 under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims, when read in light of the specification, must “reasonably apprise those skilled in the art both of the utilization and scope of the invention” using language “as precise as the subject matter permits.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014). In determining whether a claim is definite under 35 U.S.C. § 112, second paragraph, “[t]he USPTO, in examining an application, is obliged to test the claims for reasonable precision according to [this principle].” *Id.*

Claim 6 recites that “the toe section is lower than the heel platform section as a result of the first, second, and third slopes.” Appeal Br. 11 (Claims App.). It is unclear to what “the first, second, and third slopes” in claim 6 refer because claim 6 does not expressly mention a “second slope” or a “third slope.” *See id.* Claim 6 recites the “heel platform section having a *reference slope* from its outer portion to its inner portion,” as well as “a mid-foot section having a *first slope* from its outer portion to its inner portion.” *Id.* (emphasis added). Claim 6 also recites that “the line between the heel platform and the mid-foot section has *zero slope*.” *Id.* (emphasis added). One might speculate that “the first, second, and third slopes” in claim 6 are intended to refer to the mid-foot first slope, the reference slope, and the zero slope. However, such an interpretation would render unclear the limitation that “the toe section is lower than the heel platform section as a result of the first, second, and third slopes” because three slopes defined from the outer portion to the inner portion would not logically result in the toe section being lower than the heel platform section. Consequently, the

metes and bounds of the recitation “the toe section is lower than the heel platform section as a result of the first, second, and third slopes” are not clear, thereby rendering claim 6, as well as claims 7 and 8, which depend from claim 6, indefinite.

Moreover, there is some ambiguity as to what is meant by “dimension” in claim 6. Even if we construe “dimension” in accordance with its ordinary and customary meaning as a measure in one direction, claim 6 does not clearly recite either the direction or the end points between which such a measure is taken. For example, claim 6 recites that the geometric shape defined by the mid-foot section and the toe section has “a first dimension along a line between the heel platform section and the mid-foot section.” Appeal Br. 11 (Claims App.). Is this dimension measured: (1) in a lateral direction, between the inner and outer edges along this line; (2) in a vertical direction, between the upper surface and the lower surface of the apparatus in a vertical plane taken through the “line”; or (3) in a vertical direction, from the lowest point of the lower surface of the apparatus to height of the upper surface at the “line”? Similarly, how are the “second dimension” and the “third dimension” measured?

For the above reasons, claim 6 does not reasonably apprise those of skill in the art of the scope of the claimed invention. Thus, claim 6, and claims 7 and 8, which depend from claim 6, are indefinite.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1, 3, 4, 6, 7, 9, 10, 12	102(b)	Chapman		1, 3, 4, 6, 7, 9, 10, 12	
5, 8, 11	103(a)	Chapman, Kerrigan		5, 8, 11	
13	103(a)	Chapman, Kraisosky		13	
6-8	112, second paragraph	Indefiniteness			6-8
Overall Outcome				1, 3-13	6-8

FINALITY AND TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion

of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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).

REVERSED; 37 C.F.R. § 41.50(b)