



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.
14/746,476	06/22/2015	Michael Toschi	ATZ00065-MT-01	2697
34399	7590	11/07/2019	EXAMINER	
GARLICK & MARKISON 100 Congress Avenue, Suite 2000 AUSTIN, TX 78701			TRIEU, TIMOTHY K	
			ART UNIT	PAPER NUMBER
			3732	
			NOTIFICATION DATE	DELIVERY MODE
			11/07/2019	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MMurdock@TEXASPATENTS.COM
bpierotti@texaspatents.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL TOSCHI

Appeal 2019-003344
Application 14/746,476
Technology Center 3700

Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and
LISA M. GUIJT, *Administrative Patent Judges*.

REIMERS, *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, 6–15, and 17–22 under 35 U.S.C. § 103 as unpatentable over Elliott (US 7,228,649 B2, issued June 12, 2007) and Clark (US 2007/0039210 A1, published Feb. 22, 2007). Claims 5 and 16 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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 Michael Toschi. Appeal Brief (“Br.”) 2, filed April 5, 2018.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates generally to athletic shoes and more particularly to an athletic shoe with a power extension.” Spec. 1:14–15, Figs. 1, 2. Claims 1 and 12 are independent.

Claim 1 is illustrative of the claimed subject matter and recites:

1. A dominant side athletic shoe comprises:
an upper section;
a mid-sole coupled to the upper section; and
an out-sole coupled to the mid-sole, wherein at least one of the mid-sole and the out-sole includes an extension on a medial side of the dominant side athletic shoe, wherein the extension has a width, wherein the extension has a length that extends from a toe section of the dominant side athletic shoe to a mid-foot section of the dominant side athletic shoe and extends, from a top perspective, beyond the upper section by at least the width to provide an increase in force during performance of a rotational athletic task.

ANALYSIS

Appellant does not offer arguments in favor of independent claim 12 or dependent claims 2–4, 6–11, 13–15, and 17–22 separate from those presented for independent claim 1. *See* Br. 5–9. We select claim 1 as the representative claim, and claims 2–4, 6–15, and 17–22 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Elliott discloses the dominant side athletic shoe of claim 1 substantially as claimed except “Elliott does not disclose a midsole.” Final Act. 2.² The Examiner finds that Clark discloses “similar

² Final Office Action (“Final Act.”), dated May 4, 2017.

footwear art . . . including an upper 104, insole 154, midsole 107 and an outsole 102.” Final Act. 2 (citing Clark ¶ 41, Fig. 3B). The Examiner reasons that it would have been obvious “to provide the midsole of Clark incorporated with the footwear article of Elliott in order to increase the protection of the wearer[’s] foot.” *Id.* at 3. The Examiner finds that outsole 52 of Elliott “includes an extension,” in that Figure 9 of Elliott “shows a housing 47 extending from the above of the toe area to the middle region on both sides of the shoe[] on a medial side of dominant side the athletic shoe.” Final Act. 9; *see also id.* at 3. The Examiner further finds that the extension “has a width (thickness of the wall element 47)” and a length (citing one of the Examiner’s annotated versions of Figure 9 of Elliott (*see* Final Act. 3)) “that extends from a toe section of the dominant side athletic shoe to a mid-foot section of the dominant side athletic shoe and extends, from a top perspective, beyond the upper section . . . to provide an increase in force during performance of a rotational athletic task.” Final Act. 9; *see also id.* at 3. The Examiner reasons that because the combined teachings of Elliott and Clark “provide all the structure of the claimed invention,” a skilled artisan would recognize that the combination of Elliott and Clark “would provide an increase in force during performance of a rotational athletic task as claimed” and that this “functional recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.” Final Act. 9–10; *see also* Ans. 4.³

³ Examiner’s Answer (“Ans.”), dated July 26, 2018.

Appellant contends that the Examiner's reason for combining the teachings of Elliott and Clark, i.e., "in order to increase the protection of the wearer['s] foot," "fail[s] to meet the requirement for obtaining a thorough understanding of the [subject] invention." Br. 6–7; *see also* Final Act. 3. In particular, Appellant contends that "[t]he present[ly] claimed invention is not about increasing protection of the wearer's foot; it is, at least in part, about increasing force during performance of a rotational athletic task." *Id.* at 7.

"In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. . . . [A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419–20 (2007). Moreover, it is well established that the reason to modify the reference may often prompt a person of ordinary skill in the art to do what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggests the combination to achieve the same advantage or result discovered by an applicant. *In re Kahn*, 441 F.3d 977, 987–88 (Fed. Cir. 2006). In this case, the Examiner's reason to modify the teachings of Elliott with Clark, i.e., "in order to increase the protection of the wearer['s] foot," is sound and based on rational underpinnings. Appellant does not provide persuasive evidence or argument apprising us of Examiner error.

Appellant contends that "the Examiner has inappropriately taken official notice with respect to increasing force during performance of a rotational athletic task." Br. 8. In particular, Appellant contends that

“Elliot[t] does not mention the word ‘force’ in [its] specification” and that the Examiner provides “no other facts regarding an increase in force during performance of a rotational athletic task other than to say, ‘Figure 9 can perform that task.’” Br. 7. Appellant also contends that the claimed extension is not “taught by Elliot[t], is not taught by any other reference to [] Appellant’s knowledge, and is not capable of instant and unquestionable demonstration as being well-known.” *Id.* at 8.

Here, the Examiner correctly points out in the Answer that “[o]fficial notice has not been taken.” Ans. 5. The Examiner also explains that the annotated versions of Figure 9 of Elliott provided by the Examiner are “used to help further clarify each portion of the attachment device to correspond to each portion of the sole/footwear.” Ans. 5; *see also id.* at 6 (one of the Examiner’s annotated versions of Figure 9 of Elliott); Final Act. 3. Further, in response to Appellant’s argument, the Examiner takes the position that the wall thickness and the length of housing 47 of Elliott provides an extension and wider base for the sole and that the wider base “provides a wider pivot point contact between the bottom surface of the attachment/footwear and the ground surface [therefore] allowing the body of the user to safely turn along with swing movement or rotational force of golf club/baseball bat, thus reducing knee or hip injury to the player.” Ans. 5; *see also id.* at 4. Appellant does not apprise us of Examiner error.⁴ Additionally, as

⁴ As Appellant has not filed a Reply Brief, Appellant has waived any arguments against the Examiner’s findings. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (“Informative”) (“[A]rguments that could be made in the reply brief, but are not, are waived.”).

previously pointed out by the Examiner in the Final Office Action, given that the combined teachings of Elliott and Clark “provide all the structures of the claimed invention,” a skilled artisan would recognize that the combination of Elliott and Clark “would provide an increase in force during performance of a rotational athletic task as claimed” and that this “functional recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.” Final Act. 9–10; *see also* Ans. 4; *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). Appellant does not provide persuasive evidence or argument apprising us of Examiner error.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 1 as unpatentable over Elliott and Clark. Accordingly, we sustain the Examiner’s rejection of claim 1. We further sustain the rejection of claims 2–4, 6–15, and 17–22, which fall with claim 1.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6–15, and 17–22	103	Elliott and Clark	1–4, 6–15, and 17–22	

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