

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD M. WAHRHEIT

Appeal No. 1997-1316
Application No. 08/272,147¹

HEARD: November 16, 1999

Before HAIRSTON, JERRY SMITH, and FRAHM, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 17.

¹ Application for patent filed July 8, 1994. According to appellant, the application is a continuation in part of Application No. 08/067,239, filed May 26, 1993.

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The disclosed invention relates to a multiple-part, foot-support sole.

Claim 1 is the only independent claim on appeal, and it reads as follows:

1. A multiple-part foot-support sole, comprising: a cork foot support having a thickness that is minimal under a heel and under a ball of a wearer's foot; a wedge arranged under the foot support so that a front edge of the wedge lies approximately under the ball of the wearer's foot and forms an angle between 75 and 80° relative to a longitudinal center line of the sole, said wedge being of a lightweight and flexible material, said wedge having an upper side and a lower side that are substantially flat; and an outsole provided under the wedge and the cork foot support, a front part of the lower side of the wedge and the outsole being sharply raised in a toe region, the cork foot support being only slightly curved in the toe region.

The references relied on by the examiner are:

Gilbert 1897	588,977	Aug. 31,
Messler 1928	1,694,353	Dec. 4,
Tax 1958	2,838,776	June 17,
Hollister et al. (Hollister) 23, 1977	4,043,058	Aug.
Hashimoto et al. (Hashimoto) 20, 1986	4,590,123	May
Telecemian 1987	4,663,865	May 12,
Franklin et al. (Franklin) 1989	4,794,707	Jan. 3,

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Claims 1, 5, 6, 9 and 11 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hollister in view of Tax and Messler.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hollister in view of Tax, Messler and Hashimoto.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hollister in view of Tax, Messler, Hashimoto and Gilbert.

Claims 7 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hollister in view of Tax, Messler and Telecemian.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hollister in view of Tax, Messler and Franklin.

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The obviousness rejection of claims 1 through 17 is reversed.

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According to the examiner (Answer, page 2), Hollister discloses "a sole with a foot support member (16), a wedge (14) with a front edge which terminates at the ball area of the foot of a wearer, an outsole (12), and the toe portion of the wedge

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and the outsole being raised (figure 1) substantially as claimed except for the exact material and thickness for the foot support member and the angle of the front edge of the wedge." For the foot support material and the thicknesses of the foot support material in the heel and the ball area of a foot, the examiner turns to Tax which discloses the use of "cork, rubber or a combination of both" for body 17 (column 2, lines 1 and 2), and a body 17 that has such noted minimal thicknesses (Figure 3). Messler is cited by the examiner (Answer, page 2) for a teaching of "ending the front portion of a wedge (10) in an angle (figure 3) to coincide with the actual ball area of the wearers' foot." The examiner concludes (Answer, pages 2 and 3) that "[i]t would have been obvious to make the foot support member from cork with minimum thicknesses in the heel and ball area as taught by Tax and to angle the front edge of the wedge as taught by Messler in the sole of Hollister to provide a more comfortable and conforming foot support layer and to provide an angled front edge to more closely follow the angle of the wearers natural flex line." With respect to the specifically claimed angles, the

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examiner indicates (Answer, page 3) that "it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art."

Appellant argues (Brief, page 14) that "[a]lthough Tax teaches a cork layer there is absolutely no teaching in Tax which would suggest that any type of cork layer or construction could be utilized in a running shoe as taught by Hollister."

Based upon the teachings of Tax, it appears that cork is an interchangeable material with foam rubber when the cork/foam rubber is used as an internal layer beneath the foot support. On the other hand, appellant has correctly argued that there are no teachings of record for using a cork layer as a foot support, especially in an athletic shoe such as the one disclosed by Hollister. Thus, we are likewise in agreement with appellant's argument (Brief, page 14) that "teachings from one specific type of footwear are not obvious to combine with completely different types of footwear unless there is some suggestion or teaching supporting the combination. (Emphasis added). It is for this reason that we

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also disagree with the examiner's conclusion that it would
have been obvious to the skilled artisan to replace the

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uniform thickness of the foot support disclosed by Hollister with the noted minimal thicknesses of the Tax foot support. With respect to the teachings of Messler, the examiner has not provided any evidence or a convincing line of reasoning that "an angled front edge to more closely follow the angle of the wearers natural flex line" is either needed or wanted in the athletic shoe disclosed by Hollister.

In short, the obviousness rejection of claims 1, 5, 6, 9 and 11 through 17 is reversed because "[i]t is well settled that it is impermissible to use the claimed invention as a template to piece together the teachings of the prior art so as to render the claimed invention obvious" (Brief, page 15).

The obviousness rejection of claims 2 through 4, 7, 8 and 10 is reversed because the teachings of Hashimoto, Gilbert, Telecemian and Franklin do not cure the noted shortcomings in the teachings of Hollister, Tax and Messler.

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DECISION

The decision of the examiner rejecting claims 1 through
17 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ERIC FRAHAM)	
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APJ JERRY SMITH

APJ FRAHM

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: June 15, 2000

Draft Final

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OB/HD GAU

PALM/ACTS 2/BOOK
DISK(FOIA) REPORT