



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.
10/790,923	03/01/2004	Nancy C. Frye	063293.0110	1435
5073	7590	08/29/2012	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3765	
			NOTIFICATION DATE	DELIVERY MODE
			08/29/2012	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):

ptomail1@bakerbotts.com  
ptomail2@bakerbotts.com



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/790,923  
Filing Date: March 01, 2004  
Appellant(s): FRYE, NANCY C.

---

Charles S. Fish  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/15/12 appealing from the Office action mailed 10/6/11.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

1, 5-7, 11, 15, 16, 19, and 21-24.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

Art Unit: 3765

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5-7, 11, 15, 16, 19, and 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification and drawings are confusing and inconsistent and therefore do not provide adequate basis to enable one of ordinary skill in the art to make the claimed

Art Unit: 3765

shoe because it is not clear where the location of point 824 is to be located. The specification states "approximately 1/2 the length" however the drawings clearly show such a location to be in the forefoot of the footwear. One of ordinary skill in the art would not be able to determine which location is appropriate for the invention. Also the drawings do not show a midsole and one of ordinary skill in the art would not know what thickness, shape, exact location etc. would be appropriate. Therefore the specification lacks enablement for a midsole or the location of the point which the forward toe section of constant thickness of the insole meets the heel section of the insole with a decreasing thickness.

***Allowable Subject Matter***

3. Claims 1, 5-7, 11, 15, 16, 19, and 21-24 are allowable over the prior art.

**(10) Response to Argument**

In response to applicants' arguments directed towards the addition of a midsole to the drawings, the notations reference by applicant, page 22 lines 7-12 and page 29 lines 11-13 merely state that "there may be one or more midsoles separating a wearer's foot from upper surface 712U to provide additional cushioning. Preferably, the midsole would have substantially planar surfaces in order to provide the benefits of the negative heel configuration of shoe 711" or "Insole 816 may be in direct contact with surface 818 of outsole 812 or may be separated therefrom by one or more midsoles". There is no language as to how thick the midsole is, the length, the shape, exact location, etc. of a midsole (relative to the other elements of the shoe shown in the drawings). In fact the statement on page 22 is confusing, and not clear as to how planar surfaces of a midsole

Art Unit: 3765

would provide the claimed benefits of a negative heel configuration as stated. These passages do not provide clear basis for claiming a midsole or for addition of a midsole to the drawings. The specification as a whole lacks enablement for claiming a midsole.

In response to applicants' arguments directed towards the change of the location of number 824 in the drawings, it is noted that the original specification stated that point 824 is substantially halfway across a length of the shoe. The original applications as a whole was confusing, in that due to the location shown in the original drawings the span of the area considered appropriate for encompassing applicants language of "substantially halfway" appeared to be large, i.e. the area encompassing the central half of the length of the footwear. Applicant has attempted to change this meaning by amending the drawings to locate number 824 at the exact half way location which is different from the original description in the specification of substantially halfway across the length of the shoe in view of the location shown in the original drawings. The specification does not provide any basis for changing the location of element 824 to the location exactly halfway across the length of the shoe. There was never an original disclosure of the point 824 being at the point as shown in amended figure 14. Original figure 14 showed the transition from the constant thickness in the forefoot section to the decreasing thickness in the rear foot (rear heel) section at a point that was clearly rearwardly displaced from where applicant now wants to show the transition. There is absolutely no support for locating point 824 in any specific location other than where it was in original figure 14.

Art Unit: 3765

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Marie Patterson/

Primary Examiner 3765

Conferees:

/Khoa D. Huynh/

Supervisory Patent Examiner, Art Unit 3765

/Len Tran/

Supervisory Patent Examiner, Art Unit 3752