

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye
Serial No.: 10/790,923
Filing Date: March 1, 2004
Confirmation No.: 1435
Group Art Unit: 3728
Examiner: Marie D. Patterson
Title: SHOE AND LAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REPLY BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the Final Action of the Examiner issued October 6, 2011 finally rejecting Claims 1, 5-7, 11, 15, 16, 19, and 21-24. Applicant respectfully submitted a Notice of Appeal and Request for Pre-Appeal Brief Review on March 6, 2012. The Examiner issued a Notice of Panel Decision from Pre-Appeal Brief Review on June 15, 2012 stating that the Application was to proceed to the Board of Patent Appeals and Interferences. Applicant respectfully submitted an Appeal Brief on August 15, 2012. In response to the Examiner's Answer issued August 29, 2012, Applicant respectfully submits herewith their brief in reply.

REMARKS

As explained in more detail below, the Examiner's objections to the Application and the rejections of the claims cannot be properly maintained. Appellant respectfully requests the Board to reverse these rejections and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

The Examiner's Answer dated August 29, 2011 consists of substantially identical arguments to those presented in the Final Action issued October 6, 2011, along with brief additional comments for each issue responding to Appellant's arguments presented in the Appeal Brief. To reduce the burden on the Board, Appellant specifically addresses only the comments of the Examiner's Answer directed to Appellant's arguments in the Appeal Brief. The remaining portions of the Examiner's Answer have already been addressed in Appellant's Appeal Brief.

1. Claims 1, 5-7, 11, 15, 16, 19, and 21-24 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification. The Examiner maintains that the specification and drawings are confusing and inconsistent and do not provide adequate basis to enable one of ordinary skill in the art to make the claimed invention.. The Examiner asserts that it is not clear where the location of point 824 is to be located and one of ordinary skill in the art would not be able to determine which location is appropriate for the invention based on the disclosure in Applicant's specification in comparison to the original drawings. The Examiner also asserts that the drawings do not show a midsole and one of ordinary skill in the art would not know what thickness, shape, and exact location would be appropriate.

With respect to the location of point 824, the invention defined by the claims state that the rear heel section of the insole and the forward toe section of the insole meet at a point substantially halfway with respect to the upper surface (Claim 1) or the outsole (Claims 11 and 16). There is no confusion in the claims to one of skill in the art with respect to where this meeting point occurs. Applicant's specification states at page 29, lines 16-20, that a first portion 820 extends rearward from a forward periphery 822 of outsole 812 and shoe upper 814 to a point 824 approximately halfway across a length of shoe 810. Thus, there is no confusion from Applicant's specification to one of skill in the art that point 824 is to be approximately halfway across a length of shoe 810. The only confusion is that raised by Examiner in that the original drawings did not accurately depict the location of point 824 as provided by the claims and Applicant's specification. Applicant's attempts to make a minor change to the drawings to provide consistency with Applicant's specification were rebuffed by the Examiner as adding new matter. Now the Examiner is arguing for the first time that the amended drawings show the location of point 824 is at the exact half way location and this is different than the substantially halfway across the length of the shoe. Point 824 in the amended drawings is shown in an approximately halfway location with respect to the shoe and not in an exact half way location as asserted by the Examiner. A measurement of point 824 shows that it is not in the exact half way location of the shoe. The location of point 824 in the amended drawing is not inconsistent with Applicant's specification and Applicant has not changed any meaning of the term substantially halfway by locating point 824 in a position as described in Applicant's

specification. The Examiner keeps stating that there is no support for locating point 824 other than as shown in the original drawings despite the clear language of Applicant's specification clearly stating otherwise. Moreover, as stated in the Appeal Brief, the Board stated in the Decision of Appeal of March 1, 2010 that the Examiner was amenable to Applicant's change in the location of point 824. As a result, the Examiner's position is without merit. Therefore, one of skill in the art could readily make and use the invention provided by the claims from the description in Applicant's specification.

With respect to the midsole, the Examiner has stated during examination of this Application that the prior art shows, and thus one of skill in the art is readily aware, that a midsole lies between an insole and an outsole of a shoe. Moreover, as pointed out by the Examiner, Applicant's specification clearly states that insole 816 may be separated from outsole 812 by one or more midsoles. Thus, the location of a midsole is not a mystery to one of skill in the art. Further, as pointed out by the Examiner, Applicant's specification states that the midsole provides additional cushioning. As a result, one of skill in the art would not be confused as to a thickness of the midsole in providing this additional cushioning. The Examiner states confusion as to the shape of the midsole and how it could provide the claimed benefits of the negative heel configuration. The midsole is described in Applicant's specification as having planar surfaces. It is necessary for the midsole to have planar surface as the midsole, contrary to the Examiner's confused position, does not provide the claimed benefits of the negative heel configuration. The benefits of the negative heel configuration are clearly provided by the insole as described in


Applicant's specification. Thus, Applicant's specification provides clear support for the inclusion of a midsole in the claims and the amendment to the drawings to include a minimal midsole does not add new matter beyond that disclosed in Applicant's specification. Therefore, one of skill in the art could readily make and use the invention provided by the claims from the description in Applicant's specification.

CONCLUSION

Applicant has clearly demonstrated that the present invention as claimed is clearly distinguishable over all the art cited of record, either alone or in combination, and satisfies all requirements under 35 U.S.C. §§101, 102, and 103, and 112. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments associated with this Application to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
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