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EXAMINER

MOHANDESI, JILA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YUEN MOU LAW

Appeal 2015-000757
Application 12/958,103
Technology Center 3700

Before ANNETTE R. REIMERS, LISA M. GUIJT, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

GUIJT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134 of the Examiner's decision² rejecting claims 1–7. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is the sole independent claim on appeal and also representative of the claims on appeal.

¹ Appellant identifies the real party in interest as Magic Land Limited. Br. 1.

² Appeal is taken from the Final Office Action dated September 3, 2013 (“Final Act.”).

1. A slipper body with a sole (1) and a vamp (2), wherein the vamp (2) is a band of material having an inner surface (22) capable of contacting an instep and a decorative surface (21) opposite to the inner surface (22), characterized in that at least one fixing slot (23) is arranged between the inner surface (22) and the decorative surface (21) on the vamp (2) for fixing an ornament.

REJECTIONS

I. Claims 1–5 and 7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Chien (US 2006/0007668 A1; pub. Jan. 12, 2006).

II. Claims 1–7 stand rejected under 35 U.S.C. § 102(e) as anticipated by Chase (US 2012/0234042 A1; pub. Sept. 20, 2012).

ANALYSIS

Rejection 1

Regarding independent claim 1, the Examiner finds, *inter alia*, that any one of Chien’s holes H1–H6 corresponds to the claimed fixing slot arranged between the inner and decorative surfaces of the vamp. Final Act. 2. The Examiner determines that Chien’s holes H1–H6 are arranged between the claimed surfaces because holes H1–H6 “are set into and across the space separating the surfaces.” Ans. 3; *see also* Adv. Act. 1.

Appellant argues that Chien’s holes H1–H6 “pass through the inner surface and the decorative surface of the vamp rather than being arranged between the inner surface and the decorative surface [of the vamp],” and as a result, when Chien’s buttons (or light units I1–I6) are installed in the holes, the buttons contact the wearer’s foot and impair the decorative surface, in contrast to Appellant’s invention. Br. 3–4 (citing Chien ¶ 32, Figs. 1, 5). Appellant submits that “[a] claim term ‘must be read in view of the specification of which [it is] a part’” (*id.* at

4 (citing *Outside Box Innovations, LLC V. Travel, Inc.*, 260 Fed. Appx. 316 (2008))), and argues that Appellant’s Specification expressly provides that “by being ‘situated between the inner surface and the decorative surface’ the fixing slots will not influence either the inner surface or the decorative surface.” *Id.* In further support, Appellant cites to *M-Edge Accessories LLC v. Amazon.com*, 2013 WL 6154558 (D. Md. 2013), wherein, according to Appellant, the court construed “formed between” to mean “located between.” *Id.*

The Examiner responds that Appellant is arguing limitations that are not recited in the claims. Ans. 2 (citing *In re Van Geuns*, 988 F.2d 1181 (Fed. Cir. 1993)). In particular, the Examiner determines that claim 1 does not require the slots to prevent installed buttons from influencing the surfaces. *Id.*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 998 F.2d at 1184; *see also Outside the Box Innovations, LLC*, 260 Fed. Appx. at 319.

Claim 1 recites that “at least one fixing slot (23) is arranged between the inner surface (22) and the decorative surface (21) on the vamp (2).” Br. 8, Claims App. Claim 1 does not specify an orientation of slots 23 relative to decorative and inner surfaces 21, 22 of the band of material forming the vamp 2 (or relative to any other structures of the slipper body). Claim 1 also does not specify dispositions of

the *openings* of slots 23 relative to surfaces 21, 22 (or relative to any other structures of the slipper body). Further, claim 1 is written in open-ended fashion using the transitional term “comprising.”

The Specification discloses, with reference to Figure 2, that “fixing slot 23 contained between the inner surface 22 and the decorative surface 21 extends through the vamp 2.” Spec. ¶ 1022. Figure 2 depicts vamp 2 as having side surfaces that separate top (decorative) and bottom (inner) surfaces 21, 22 of vamp 2.³ If we define the longitudinal axis of the slot as the axis extending from one opening of the slot to the opposite opening, Figure 2 depicts slot 23 as “contained between” the surfaces 21, 22, such that the slot’s longitudinal axis is *parallel* to surfaces 21, 22, with the slot’s openings on *side* surfaces of the vamp.

To interpret claim 1 as requiring such a parallel orientation of the slot (as compared to, for example, a perpendicular orientation), or as excluding the slot’s openings from being disposed *on* surfaces 21 or 22, is to read limitations from the Specification into the claims, which we decline to do. We remind Appellant that the burden to precisely define the invention is Appellant’s, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellant always has the opportunity to amend the claims during prosecution, and broad interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than justified. *In re Prater*, 415 F.2d 1393, 1404–05 (CCPA 1969).

An ordinary definition of the claim term “between,” in view of the Specification, is “in an intermediate position in relation to two other objects.”

³ Figure 1 of Appellant’s Specification appears to depict an embodiment wherein surfaces 21, 22 bound one another, for example, along one edge, such that the openings of the slots shown would necessarily be on one or both surfaces 21, 22, because the openings of the slots are depicted as greater than the width of the boundary or edge between surfaces 21, 22.

WEBSTER’S THIRD NEW INT’L DICTIONARY, p. 209 (1993). Chien’s holes H1–H6 are arranged between the inner and decorative surfaces of a vamp, as claimed, because Chien’s holes H1–H6 are in an intermediate position in relation to the surfaces. Although the longitudinal axes of Chien’s holes H1–H6 (which, for each slot, extends from one opening of the slot to the other) are *perpendicular* to the top and bottom surfaces of Chien’s vamp, rather than extending parallel to surfaces 21, 22 as described in Appellant’s Specification, and although the openings of Chien’s holes extend (or pass) through the top and bottom surfaces of Chien’s vamp, claim 1 neither specifies the orientation of the slots, nor the dispositions of the openings of slots 23, relative to surfaces 21, 22, as discussed *supra*. Therefore, we are not apprised of error in the Examiner’s finding.

Accordingly, we affirm the Examiner’s rejection of independent claim 1 as anticipated by Chien. Appellant chose not to present separate arguments for the patentability of claims 2–5 and 7 depending from claim 1. Br. 5. Therefore, we also sustain the Examiner’s rejection of claims 2–5 and 7 for the reasons stated *supra*.

Rejection II

Regarding independent claim 1, the Examiner finds, *inter alia*, that any one of Chase’s receiving holes 216 corresponds to the claimed fixing slot arranged between the inner and decorative surfaces of the vamp. Final Act. 3. The Examiner determines that Chase’s holes 216 are arranged between the claimed surfaces because holes 216 “are set into and across the space separating the surfaces.” Ans. 3; *see also* Adv. Act. 1.

Appellant argues that “[s]imilar to Chien . . . , Chase does not provide one or more fixing slots arranged between the inner surface and decorative surface of the vamp,” but rather, that Chien’s holes 216 “pass through” the surfaces. Br. 5–6.

Chase's receiving holes 216 are arranged between the inner and decorative surfaces of a vamp, as claimed, because Chase's holes 316 are in an intermediate position relative to the surfaces. Although, similar to Chien, the longitudinal axes of Chase's holes 216 (which, for each slot, extend from one opening of the slot to the other) are perpendicular to the top and bottom surfaces of Chase's vamp, rather than extending parallel to surfaces 21, 22 as described in Appellant's Specification, and although the openings of Chase's holes extend (or pass) through the top and bottom surfaces of Chase's vamp, claim 1 neither specifies the orientation of the slots, nor the dispositions of the openings of slots 23, relative to surfaces 21, 22, as discussed *supra*. Therefore, we are not apprised of error in the Examiner's finding.

Accordingly, we affirm the Examiner's rejection of independent claim 1 as anticipated by Chien. Appellant chose not to present separate arguments for the patentability of claims 2–7 depending from claim 1. Br. 6. Therefore, we also sustain the Examiner's rejection of claims 2–7 for the reasons stated *supra*.

DECISION

The Examiner's decision to reject claims 1–5 and 7 under 35 U.S.C. § 102(b) as anticipated by Chien is affirmed.

The Examiner's decision to reject claims 1–7 under 35 U.S.C. § 102(e) as anticipated by Chase is affirmed.

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