

**Keywords:** relative terms; *de novo* review; review waiver; standard of review; appealable matter

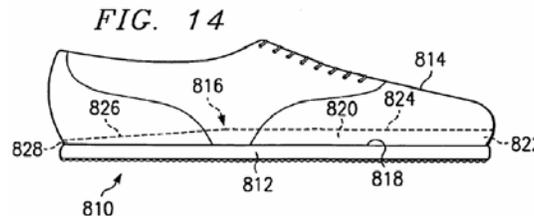
**General:** The B.P.A.I. finds that an appellant is entitled to *de novo* review only of issues specifically challenged by the appellant. Further, such review does not give deference to an examiner's positions.

*Ex parte Frye*

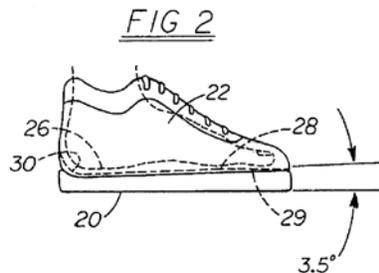
94 U.S.P.Q. 2d 1072 (B.P.A.I. 2010) (precedential)  
Decided February 26, 2010

**I. Facts**

Nancy C. Frye, a sole inventor, filed a patent application in 2004 with claims directed to a shoe having a forwardly inclined "reverse wedge." The shoe design is described as being able to improve the conditioning and tone of several muscle groups of a wearer and accommodate an extremely wide variety of fashion. Claim 1, which is representative of the subject matter appealed, is directed to a shoe (810) having an insole (816) enclosed by an upper (814), the insole (816) having a forward toe section (820) and a rear heel section (826) "wherein the rear heel section (826) of the insole (816) and the forward toe section (820) of the insole (816) meet at a point (824) *substantially halfway* with respect to the upper surface." (Emphasis added.) Note that section (826) has an incline (increasing thickness) while section (820) is flat (substantially constant thickness).



During prosecution, the Examiner objected to the drawings as failing to show the point (824) at an area where the rear heel section (826) and the forward toe section (820) actually meet. The Examiner rejected claim 1 (among others) under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,491,912 to Snabb (hereinafter "Snabb"), FIG. 2 of which is provided below. Specifically, the Examiner indicated that a section under the heel of a foot (26) which has an incline, and a section under the ball of the foot (28) which is flat, meet substantially halfway at a point (29). The Examiner also rejected other claims under 35 U.S.C. § 103(a) based on this interpretation of Snabb.



In response to the Examiner's objection to the drawings, the Appellant eventually filed a replacement drawing, moving the point (824) to the correct location and adding a midsole. In a subsequent action, the Examiner indicated that the addition of the midsole added new matter, objected to the replacement

drawing, and did not enter the replacement drawing. The Examiner also maintained the rejections under Sections 102 and 103 based on Snabb, despite the Appellant's arguments that the point (29) of Snabb is not "substantially halfway" through the length of the shoe. The Appellant filed an appeal brief setting forth arguments that Snabb does not show such a substantially halfway meeting point, and that this erroneous finding of fact pervaded all of the rejections set forth by the Examiner. Additionally, the appeal brief contained arguments regarding the objection to the drawings.

## II. Issue

Did the Examiner err in finding that Snabb discloses a shoe having an insole with a forward toe section of substantially constant thickness and a rear heel section having a decreasing thickness that meet at a point "substantially halfway" with respect to the upper surface or outsole, as recited in the rejected claims?

## III. Discussion

Yes. Citing *In re Oetiker*<sup>1</sup>, the Board (including Director Kappos and Deputy Director Barner) reviewed the finding by the Examiner that Snabb discloses the point (29) as "substantially halfway" *anew* in light of the Appellant's arguments and all evidence in support of the issue. Therefore, when considering the Appellant's arguments, the Board did *not* give deference to the positions taken by the Examiner. However, the Board also noted that since the Appellant only contested the "substantially halfway" aspect of the rejections, that all other aspects would be considered waived (uncontested). To interpret the language of the claims, the Board looked to the Appellant's Specification for reference to the "substantially halfway" limitation. The Specification uses the word "approximately" as a substitute for the term "substantially." Relying on a dictionary, the Board found that an ordinary meaning of "approximately" includes "[r]easonably close to: nearly, almost, about," and that an ordinary meaning of "halfway" includes "equally distant from the extremes of a space or course: midway between two points." Therefore, the Board noted that the ordinary meaning of "substantially halfway" should read, in the context of the claims, as "reasonably close to or nearly at the midpoint between the forwardmost point of the upper or outsole and the rearwardmost point of the upper or outsole." In this regard, the Board further noted that the point marked with the number 29 in Snabb is too far forward with respect to the outsole or upper of the shoe in Snabb to be reasonably construed as "substantially halfway." Not surprisingly, the Board found that the Examiner's interpretation of the phrase "substantially halfway" in the claims was unreasonably broad, and reversed the rejections.

The Board further clarified that "[o]ur decision is limited to the finding before us for review," and that the Board does not allow claims of an application and cannot direct an examiner to issue a patent. The Board noted that the Examiner made no rejections based on a theory that it would have been obvious at the time of the Appellant's invention to locate the claimed point "substantially halfway" based on the applied prior art. Despite the Board's discretion to enter new grounds of rejection and their recognition that such a rejection could be a possibility, the Board declined to take a position on this issue.

Regarding the Appellant's arguments that the replacement drawing contained new matter, the Board noted that such refusal to enter the proposed replacement drawing was unrelated to any rejection before the Board. The Board indicated that such matters are reviewable by petition under 37 C.F.R. § 1.181 and are thus not within the jurisdiction of the Board. The Board went on to cite *In re Berger*<sup>2</sup>, stating that "the kind of adverse decisions of examiners which are reviewable by the board must be those which relate, *at least indirectly*, to matters involving the rejection of claims." (Emphasis added.)

<sup>1</sup> *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

<sup>2</sup> *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002).

Interestingly, the Board did not comment on the Examiner's refusal to enter the replacement drawing and subsequent maintenance of the rejections using Snabb as a reference, in which the location of the point 29 seems to correspond to the location of the point 824 (the "substantially halfway" point) of the Appellant's original drawings.

#### **IV. Conclusion**

The Board reversed the Examiner's decision to reject the Appellant's claims. However, the Board did not reverse, affirm, or otherwise address the merits of the issue of the Examiner's refusal to enter the replacement drawing filed by the Appellant. The Board made clear that the Board reviews the particular finding(s) contested by an appellant *anew* in light of all the evidence and argument on that issue, and that deference is *not* given to positions taken by the examiner when considering an appellant's argument specifically challenging the examiner's findings. The Board also cautioned that an appellant must present arguments to all issues (i.e., aspects of rejections) that the appellant wishes to contest, else the appellant essentially waives review of the uncontested aspects of the rejection.

In his blog about the opinion, Director Kappos indicated at least some of his thoughts regarding the rule of "waiver":

The well-respected principles of appellant advocacy reaffirmed in *Frye* are also essential to the effective functioning of a Board whose projected inventory of appeals for FY 2010 is 16,500 cases. It would be unreasonable to expect the Board's roughly 80 Administrative Patent Judges (APJs) to consider arguments that appellants could have raised but did not raise in the briefs.