

Notice of Allowability	Application No. 18/371,413	Applicant(s) Pratt et al.	
	Examiner BAO-THIEU L NGUYEN	Art Unit 3732	AIA (FITF) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the claims set filed 11-07-2023.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☒ The allowed claim(s) is/are 6-16 and 18-20. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892) 2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____. 3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____. 4. ☐ Interview Summary (PTO-413), Paper No./Mail Date. _____.	5. ☒ Examiner's Amendment/Comment 6. ☐ Examiner's Statement of Reasons for Allowance 7. ☐ Other _____.
--	--

/BAO-THIEU L NGUYEN/
Primary Examiner, Art Unit 3732

DETAILED ACTION

Notice of Pre-AIA or AIA Status

1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Terminal Disclaimer

2. The terminal disclaimer filed on 11-07-2023 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No: 11633005 and Patent No. 1163006 and Applicant No. 17/965516 and Applicant No. 18671414 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Allowable Subject Matter

3. Claims 6-16 and 18-20 are allowed.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BAO-THIEU L NGUYEN whose telephone number is (571)270-0476. The examiner can normally be reached M-F 7am-4pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KHOA D. HUYNH can be reached on (571)272-4888. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BAO-THIEU L. NGUYEN
Primary Examiner
Art Unit 3732

/BAO-THIEU L NGUYEN/
Primary Examiner, Art Unit 3732

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael Pratt	Examiner: Bao-Thieu L. Nguyen
Appln. No.: 18/371,413	Group Art Unit: 3732
Filing Date: September 21, 2023	Confirmation No.: 2382
Title: Rapid-entry footwear having a stabilizer and an elastic element	Docket No.: P-03037

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

AMENDMENT

This Amendment is responsive to the Non-Final Office Action dated October 30, 2023, and includes the following sections:

Amendments to the Claims beginning on page 2;

Remarks, beginning on page 6.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Cancelled).
2. (Cancelled).
3. (Cancelled).
4. (Cancelled).
5. (Cancelled).
6. (Original) A rapid-entry shoe comprising:
a sole portion;
an upper coupled to the sole portion and including a rear portion, a side portion, and a forward portion, the upper defining a foot opening;
a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening; and
a plurality of elastic elements positioned forward of the rear portion of the upper, the plurality of elastic elements operable to enlarge the foot opening when expanded and operable to reduce the foot opening when contracted, wherein the plurality of elastic elements includes at least a first elastic element and a second elastic element, the first and second elastic elements being separated by a non-elastic portion of the upper.

7. (Original) The rapid-entry shoe of claim 6, wherein the first elastic element is positioned at the side portion of the upper and the second elastic element is positioned at a forward portion of the upper.
8. (Original) The rapid-entry shoe of claim 6, wherein first elastic portion defines a portion of the foot opening.
9. (Original) The rapid-entry shoe of claim 6, wherein the first elastic element defines at least a portion of the upper.
10. (Original) The rapid-entry shoe of claim 6, wherein the second elastic element extends across a vamp of the upper.
11. (Original) The rapid-entry shoe of claim 6, wherein the second elastic element is spaced from the foot opening.
12. (Original) The rapid-entry shoe of claim 6, wherein the elastic element includes third elastic element, wherein the side portion includes a lateral side portion and a medial side portion, and wherein the first elastic element is positioned on the lateral side portion and the third elastic element is positioned on the medial side portion.
13. (Original) The rapid-entry shoe of claim 6, wherein at least one of the plurality of elastic elements includes a 2-way stretch.
14. (Original) The rapid-entry shoe of claim 6, wherein at least one of the plurality of elastic elements includes a 4-way stretch.
15. (Currently Amended) A rapid-entry shoe comprising:
a sole portion;

an upper coupled to the sole portion and including a rear portion, a side portion, and a forward portion, the upper defining a foot opening;
a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening; and
a plurality of elastic elements positioned along at least a portion of the upper, the elastic element configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion, wherein the plurality of elastic elements includes a first elastic element defining a first longitudinal axis and a second elastic element defining a second longitudinal axis, wherein the first longitudinal axis defines a first angle relative to a vertical axis and the second longitudinal axis defines a second angle relative to the vertical axis, wherein the first angle and the second angle are different.

16. (Original) The rapid-entry shoe of claim 15, wherein the plurality of elastic elements includes a first elastic element defining a first longitudinal axis and a second elastic element defining a second longitudinal axis, wherein the first longitudinal axis is parallel to the second longitudinal axis.
17. (Cancelled).
18. (Original) The rapid-entry shoe of claim 15, wherein the plurality of elastic elements includes a longitudinal axis that conforms to a shape of a curvature of at least a portion of the upper.
19. (Original) The rapid-entry shoe of claim 15, wherein at least a portion of the plurality of elastic elements define at least a portion of the side portion of the upper.
20. (Original) The rapid-entry shoe of claim 15, wherein the side portion of the upper includes an ankle support portion that is predominantly vertically extending and the forward portion of the upper includes a vamp portion that is predominantly horizontally

extending, wherein the elastic element extends along a curve of the upper along at least a portion of the ankle support portion and the vamp portion of the upper.

REMARKS

Claims 1-20 are pending in the application. Claims 1-20 are rejected. Claims 1-5 and 17 are cancelled herein. Claim 15 is currently amended. The Applicant respectfully requests allowance of the currently pending claims for the following reasons:

Allowable Subject Matter

The Applicant appreciates that claims 6-14 and 17 are found to be novel and nonobvious in view of the prior art. In view of the lack of prior art rejections of those claims, Applicant directs the Examiner's attention to the listing of the claims, which cancels claims 1-5 which are rejected in view of a cited reference. Additionally, the subject matter of claim 17 is amended into independent claim 15, from which claim 17 depended. Additionally, Applicant directs the Examiner's attention to the Terminal Disclaimer that is filed herewith. Accordingly, Applicant submits that the only rejection of claims 6-14 is overcome by the terminal disclaimer and that the prior art rejection of claim 15 is overcome by including the novel and nonobvious features of claim 17 therein and double patenting rejection is overcome by the terminal disclaimer. As such, Applicant believes the application to be in condition for allowance as all other rejections are now moot in view of this response.

Section 112 Rejections

The Office rejected claim 5 under 35 U.S.C. § 112(a), first paragraph, as failing to comply with the written description requirement. Applicant directs the Examiner's attention to the listing of the claims. Claim 5 is cancelled and therefore the rejection is now moot.

The Office rejected claim 5 under 35 U.S.C. § 112(b), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention. Applicant directs the Examiner's attention to the listing of the claims. Claim 5 is cancelled and therefore the rejection is now moot.

Section 102 Rejections

The Office rejected claims 1-5, 15-16, and 18-20 under 35 U.S.C. § 102(a)(1) as being anticipated by US 2018/0110292 by Beers (hereinafter “Beers”). Applicant directs the Examiner’s attention to the listing of the claims. Claims 1-5 are cancelled and the rejection of those claims is now moot. Regarding claim 15, Applicant directs the Examiner’s attention to the amendment which includes the novel and nonobvious features of claim 17. As such Applicant submits that claim 15 is now novel in view of Beers. As claims 16 and 18-20 depend from claim 15, Applicant submits that those claims are likewise novel over Beers. As such, Applicant respectfully requests that the 35 U.S.C. §102 rejection of the claims of the application be withdrawn.

Double Patenting

The Office rejected claims 1-20 on the ground of nonstatutory double patenting as being unpatentable over claims 1-3 of US Patent No. 11,633,005.

The Office rejected claims 1-20 on the ground of nonstatutory double patenting as being unpatentable over claims 1-6 of US Patent No. 11,633,006.

The Office provisionally rejected claims 1-20 on the ground of nonstatutory double patenting as being unpatentable over claims 1-7, 9-11, 13-17, and 20-24 of copending US Application No. 17/965,516.

The Office provisionally rejected claims 1-20 on the ground of nonstatutory double patenting as being unpatentable over claims 1-20 of copending US Application No. 18/371,414.

Applicant directs the Examiner’s attention to the Terminal Disclaimer submitted herewith. The Terminal Disclaimer addresses the rejection of the pending claims of the application. As the co-pending applications cited in the provisional rejections have not since issued, Applicant submits that the provisional rejections are moot in view of the allowability of these claims and the co-pending applications not yet proceeding to allowance. As such, Applicant respectfully requests that the nonstatutory double patenting rejections be withdrawn from the application.

CONCLUSION

For the reasons explained above, all pending claims are now in condition for allowance. Accordingly, the Applicant respectfully requests that the Office issue a *Notice of Allowance*. Any amendments to the claims are made to expedite prosecution of this application, without acquiescing to the Office's rejections or characterizations of the claims or references in the Office Action. Even if not expressly discussed above, the Applicant respectfully traverses each of the rejections, assertions, and characterizations regarding the disclosure and teachings of the cited references, including the prior art status and the propriety of proposed combinations of cited references. Unless expressly and specifically stated herein, nothing in this paper should be construed as the Applicant's intent to concede any issue with regard to any claim. The Office should not interpret any claim amendment or statements herein as an admission or concession of unpatentability of the subject matter claimed prior to such amendments. The Applicant specifically reserves the right to prosecute the previously claimed subject matter and claims of a broader or different scope in a continuation application.

The Applicant has made a good faith effort to respond to all rejections set forth in the Office Action and to place the pending claims in condition for immediate allowance. If the Examiner has any questions or comments, the Examiner is requested to contact the undersigned.

Respectfully submitted,

By: /Eric Nielsen/_____
Eric Nielsen
Reg. No. 60,183

Eric Nielsen
Chief IP Officer and General Counsel
1172 West 700 North, Suite 200
Lindon, UT 84042
C:480-229-7581
eric@handsfreelabs.com

Dated: 11/7/23



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.
18/371,413	09/21/2023	Michael Pratt	P-03037	2382
164668	7590	10/30/2023		
FAST IP, LLC 1172 West 700 North Suite 200 Lindon, UT 84042			EXAMINER NGUYEN, BAO-THIEU L	
			ART UNIT	PAPER NUMBER
			3732	
			NOTIFICATION DATE	DELIVERY MODE
			10/30/2023	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):

enielsen@kizik.com

Office Action Summary

Application No.

18/371,413

Applicant(s)

Pratt et al.

Examiner

BAO-THIEU L NGUYEN

Art Unit

3732

AIA (FITF) Status

Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 09-21-2023.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 1-20 is/are pending in the application.

5a) Of the above claim(s) ____ is/are withdrawn from consideration.

6) ☐ Claim(s) ____ is/are allowed.

7) ☒ Claim(s) 1-20 is/are rejected.

8) ☐ Claim(s) ____ is/are objected to.

9) ☐ Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☐ The specification is objected to by the Examiner.

11) ☒ The drawing(s) filed on 09-21-2023 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some** c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

3) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date ____.

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

4) ☐ Other: ____.

Paper No(s)/Mail Date ____.

DETAILED ACTION

Notice of Pre-AIA or AIA Status

1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “an intermediate structure” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

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

(a) IN GENERAL.—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 or joint inventor of carrying out the invention.

4. **Claim 5** is rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for applications subject to pre-AIA 35 U.S.C. 112, the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5 is rejected because it recites limitations “intermediate structure”. The limitation is failing to comply with the written description requirement since it does not have any support in the specification.

5. The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

6. **Claim 5** is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor (or for applications subject to pre-AIA 35 U.S.C. 112, the applicant), regards as the invention.

Claim 5 is rejected because it recites limitations “intermediate structure”. It is not clear what and where is that structure since it does not have any support in the specification.

Claim Rejections - 35 USC § 102

7. In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis (i.e., changing from AIA to pre-AIA) for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

9. **Claim(s) 1-5, 15-16, and 18-20** is/are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Beers (2018/0110292).

Regarding claim 1, Beers discloses a rapid- entry shoe comprising:

a sole portion (fig 5, member 34);

an upper (member 38) coupled to the sole portion and including a rear portion, a side portion, and a forward portion, the upper defining a foot opening;

a stabilizer (member 10) having a unitary structure extending from the sole portion toward a rear portion of the foot opening; and

a connector arm including an elastic material (fig 14, member 435) extending along at least a portion of the side portion of the upper, the elastic material configured to retain the rapid entry shoe about a user's foot.

Regarding claim 2, Beers discloses the connector arm extends from the side portion to the forward portion of the upper (fig 14, member 435).

Regarding claim 3, Beers discloses the connector arm is a portion of the upper (fig 14, member 435).

Regarding claim 4, Beers discloses the side portion of the upper includes both a lateral side portion and a medial side portion, wherein the connector arm includes a first connector arm that extends along at least a portion of the lateral side portion and a second connector arm that extends along at least a portion of the medial side portion (there is).

Regarding claim 5, Beers discloses the connector arm is coupled to the sole portion via an intermediate structure (figs 10-14, member 442).

Regarding claim 15, Beers discloses a rapid-entry shoe comprising:

a sole portion (figs 11-14, member 434);

an upper (member 438) coupled to the sole portion and including a rear portion, a side portion, and a forward portion, the upper defining a foot opening;

a stabilizer (member 410) defining a unitary structure extending from the sole portion toward a rear portion of the foot opening; and

a plurality of elastic elements (member 435 on both side) positioned along at least a portion of the upper, the elastic element configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion (fig 39-40).

Regarding claim 16, Beers discloses the plurality of elastic elements includes a first elastic element defining a first longitudinal axis and a second elastic element

defining a second longitudinal axis, wherein the first longitudinal axis is parallel to the second longitudinal axis (member 435 are on both side and parallel to each other therefore, its own axis must be parallel to each other).

Regarding claim 18, Beers discloses the plurality of elastic elements includes a longitudinal axis that conforms to a shape of a curvature of at least a portion of the upper (fig 14).

Regarding claim 19, Beers discloses at least a portion of the plurality of elastic elements define at least a portion of the side portion of the upper (fig 14).

Regarding claim 20, Beers discloses the side portion of the upper includes an ankle support portion (fig 5-6, member 38) that is predominantly vertically extending and the forward portion of the upper includes a vamp portion that is predominantly horizontally extending, wherein the elastic element extends along a curve of the upper along at least a portion of the ankle support portion and the vamp portion of the upper.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP § 2146 *et seq.* for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The filing of a terminal disclaimer by itself is not a complete reply to a nonstatutory double patenting (NSDP) rejection. A complete reply requires that the terminal disclaimer be accompanied by a reply requesting reconsideration of the prior Office action. Even where the NSDP rejection is provisional the reply must be complete. See MPEP § 804, subsection I.B.1. For a reply to a non-final Office action, see 37 CFR 1.111(a). For a reply to final Office action, see 37 CFR 1.113(c). A request for reconsideration while not provided for in 37 CFR 1.113(c) may be filed after final for consideration. See MPEP §§ 706.07(e) and 714.13.

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The actual filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25,

PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/apply/applying-online/eterminal-disclaimer.

11. **Claims 1-20** are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 11,633,005. Although the claims at issue are not identical, they are not patentably distinct from each other because both applications claim essentially the same elements such as the sole, an upper, an elastic element, a convex portion, and a stabilizer with window and deformable element.

12. **Claims 1-20** are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 11,633,006. Although the claims at issue are not identical, they are not patentably distinct from each other because both applications claim essentially the same elements such as the sole, an upper, an elastic element, a convex portion, and a stabilizer with window and deformable element.

13. **Claims 1-20** are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-7, 9-11, 13-17, and 20-24 of copending Application No. 17/965,516. Although the claims at issue are not identical, they are not patentably distinct from each other because both applications claim

essentially the same elements such as the sole, an upper, an elastic element, a convex portion, and a stabilizer with window and deformable element. This is a provisional nonstatutory double patenting rejection because the patentably indistinct claims have not in fact been patented.

14. **Claims 1-20** are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over **claims 1-20** of copending Application No. 18/371,414. Although the claims at issue are not identical, they are not patentably distinct from each other because both applications claim essentially the same elements such as the sole, an upper, an elastic element, a convex portion, and a stabilizer.

Conclusion

The prior art made of record and not relied upon, is listed on the attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BAO-THIEU L NGUYEN whose telephone number is (571)270-0476. The examiner can normally be reached M-F 7am-4pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KHOA D. HUYNH can be reached on (571)272-4888. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BAO-THIEU L. NGUYEN
Primary Examiner
Art Unit 3732

/BAO-THIEU L NGUYEN/
Primary Examiner, Art Unit 3732
s