

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JEFFERY R. PARKER  
and  
TERRENCE P. HOPKINS

---

Appeal No. 96-2393  
Application 08/147,961<sup>1</sup>

---

ON BRIEF

---

Before FRANKFORT, STAAB and NASE, Administrative Patent  
Judges.

---

<sup>1</sup> Application for patent filed November 4, 1993.

Appeal No. 96-2393  
Application 08/147,961

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 63 through 81. Claims 2, 3, 8 through 12, 14, 16 and 25 through 62 stand withdrawn from further consideration under 37 CFR § 1.142(b). Claims 1, 4 through 7, 13, 15 and 17 through 24 have been canceled.

Appellants' invention relates to a light distribution and/or information display system in combination with an object for distributing light to one or more areas of the object for decorative and/or safety reasons. Claims 63 and 78 are representative of the subject matter on appeal and a copy of those claims, as they appear in the Appendix to appellants' brief, is attached to this decision.

The prior art references relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. § 103 are:

Appeal No. 96-2393  
Application 08/147,961

Powell 1978	4,130,951	Dec. 26,
Daniel 1980	4,234,907	Nov. 18,
Lin 1986	4,611,416	Sept. 16,
Rodgers 1989	4,848,009	July 18,

Claims 63 through 66, 68, 69 and 74 through 81 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lin in view of Daniel and Rodgers.

Claims 67 and 70 through 73 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lin in view of Daniel and Rodgers as applied above, and further in view of Powell.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 13, mailed February 5, 1996) for the examiner's reasoning in support of the rejections, and to appel-

Appeal No. 96-2393  
Application 08/147,961

lants' brief (Paper No. 12, filed December 18, 1995) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 are not well founded and will therefore not be sustained. Our reasoning in support of this determination follows. In addition, we have determined that a remand to the examiner for further search is necessary in this case.

Looking first at the examiner's basic rejection relying on Lin, Daniel and Rodgers, we are in agreement with appellants that the examiner has relied upon impermissible hindsight and combined these references in light of appellants' own teachings so as to arrive at the claimed subject

Appeal No. 96-2393  
Application 08/147,961

matter. Absent appellants' disclosure, we see no reasonable teaching or suggestion in the references themselves which would have fairly led one of ordinary skill in the art to (a) use the light emitting fabric of Daniel as a small information or display card similar to the card (30) in Lin, and (b) to so size the light emitting fabric of Daniel and its light source (17) that they would be able to fit into the small pocket on the shoe of Lin. Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellants' own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of independent claims 63 and 78 under 35 U.S.C. § 103, or that of claims 64 through 66, 68, 69, 74 through 77 and 79 through 81 which depend therefrom.

Our review of Powell, relied upon by the examiner in rejecting dependent claims 67 and 70 through 73 under 35 U.S.C. § 103, has revealed nothing which would supply the missing teaching and/or suggestion lacking in the basic combination of Lin, Daniel and Rodgers as noted above. Accord-

Appeal No. 96-2393  
Application 08/147,961

ingly, we also will not sustain the rejection of these additional claims under § 103.

The decision of the examiner to reject claims 63 through 81 under 35 U.S.C. § 103 is reversed.

In addition, this application is REMANDED to the examiner for further search, particularly with regard to claims 78 through 81 which are clearly not limited to the footwear art of Class 36 and illumination in combination with wearing apparel or body support of Class 362, subclass 103, searched by the examiner. A more expansive search in Class 362, "Illumination," would appear appropriate. The examiner should also note the patents of record to Wall (5,239,450) and Crews (5,149,489), both of which deserve consideration with regard to independent claim 78 and the claims which depend therefrom.

The patent to Wall discloses an illuminated button member (1) including a light distribution system comprising an

Appeal No. 96-2393  
Application 08/147,961

area light emitting portion (44), a light source (48), a power source (36), and a holder or housing (6, 8) having a window (10) through which light is emitted from said area light emitting portion. Note also that Wall discloses a circuit board (50) having a circuit means "to flash the lights 48 at periodic intervals" (col. 4, lines 40-41), and a closeable access opening (at 14) which when opened permits removal and replacement of the battery (36).

As for Crews, we direct attention to the illuminated ski pole (70) therein, noting that it includes a light distribution system comprising an area light emitting portion (93, 95), a light source (91), a power source (87), and a holder or housing having a window (73) through which light is emitted from said area light emitting portion. The ski pole also includes an R-C circuit (90) to allow the light source (91) to flash at any desired frequency, and it has a closeable access opening (at 83, 85) which when opened permits removal and replacement of the batteries (87).

Appeal No. 96-2393  
Application 08/147,961

This application, by virtue of its "special" status,  
requires an immediate action, MPEP § 708.01(d).

REVERSED AND REMANDED

	CHARLES E. FRANKFORT	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	LAWRENCE J. STAAB	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	
		)	
	JEFFREY V. NASE	)	
	Administrative Patent Judge	)	

Appeal No. 96-2393  
Application 08/147,961

Donald L. Otto  
Renner, Otto, Boisselle & Sklar  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, OH 44115

APPENDIX

63. In combination, a shoe and a light distribution system for said shoe, said light distribution system comprising an area light emitting portion, a light source for supplying light to said area light emitting portion, a power source for said light source, and a holder for said area light emitting portion and said light source, said holder being located at an upper portion of said shoe and including a window through which light is emitted from said area light emitting portion.

78. In combination, an object and a light distribution system for said object, said light distribution system comprising an area light emitting portion, a light source for supplying light to said area light emitting portion, a power source for said light source, and a holder on said object for said area light emitting portion and said light source, said holder including a window through which light is emitted from said area light emitting portion.