

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARMEN RAPISARDA

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Appeal No. 96-0688  
Application 08/105,465<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE, and LEE, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final  
rejection of claims 19 through 29, which are all of the claims

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<sup>1</sup> Application for patent filed August 9, 1993. According to  
applicant, the application is a continuation of Application  
07/806,925, filed December 11, 1991, which is Abandoned.

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remaining in this application. Claims 1 through 18 have been canceled.

Appellant's invention relates to footwear, more specifically, to a shoe having a flexible sole and at least one light-emitting diode (LED) in the sole and visible from the exterior of the sole for emitting light on an intermittent basis during walking or running. Critical to appellant's invention is the specific manner in which the LED (17), seen in Figures 5 and 6 of the application drawings, is mounted in relation to the wafer battery (20) to effect the intermittent electrical connection necessary to provide the desired intermittent operation of the LED. An adequate understanding of the invention can be had from a reading of representative claim 19, a copy of which is appended to this decision.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reichert	4,014,115	Mar. 29, 1977
Evanyk	5,033,212	Jul. 23, 1991
Goldston et al. (Goldston)	5,285,586	Feb. 15, 1994
	(Filing Date Jun. 26, 1992)	
Bott et al. (Bott)	28 38 770	Mar. 20, 1980
	(Offenlegungsschrift)	
Dana III	0 121 026	Oct. 10, 1984
	(Published European Application)	

Claims 19 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dana III in view of Reichert or alternatively, Reichert in view of Dana III.

Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claim 19 above and further in view of Evanyk.

Claims 23 through 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claim 19 above and further in view of Bott.

Claims 19 through 29 stand additionally rejected under "the judicially created doctrine of non-statutory double patenting" as being unpatentable over claims 1-5 of U.S. Patent No. 5,285,586.

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According to the examiner,

[t]he now claimed subject matter is described in and encompassed within the scope of the claim(s) in Applicant's U.S. Patent No. 5,285,586 and therefore, a claim for the now claimed subject matter could have been presented therein (answer, page 7).

Reference is made to the answer (Paper No. 19, mailed July 21, 1995, pages 3-12) for the examiner's reasoning in support of the rejections before us on appeal and to appellant's brief (Paper No. 18, filed February 21, 1995, pages 11-26) for the arguments thereagainst.

#### OPINION

Having carefully reviewed and evaluated the issues raised in this appeal in light of the record before us, we have come to the conclusion, for the reasons which follow, that the examiner's rejections of appealed claims 19 through 29 will not be sustained.

We turn first to the examiner's rejection of claims 19 through 21 under 35 U.S.C. § 103 as being unpatentable over Dana III in view of Reichert or alternatively, Reichert in view of Dana III. After a brief discussion of the teachings of the applied references (answer, pages 3-4), the examiner concludes that

[t]he skilled artisan would have found it obvious to substitute the pressure sensitive switch connections

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taught by Reichert for the connections taught by Dana III given the advantages of automatically only lighting the shoe when in use and thereby extending battery life.

Alternatively placing the lighting device of Reichert in an athletic shoe would have been obvious in view of Dana III given that it is clearly known to light such a footwear. The substitution of LEDs for the lamp of Reichert is deemed an obvious substitution of known equivalents, as official notice is taken as to their well known interchangeability.

Moving the conductors as claimed or the battery as taught by Reichert is not seen as being a patentable distinction as the relative movement is the same in either case (answer, page 4).

Like appellant, we are of the opinion that Dana III and Reichert would not have been logically combinable by one of ordinary skill in the art so as to result in and render obvious the particular arrangement of LED, conductors and wafer battery defined in appellant's claims on appeal. Absent any fore-knowledge of appellant's own teachings, we fail to find in the disclosures of Dana III and Reichert, or in the examiner's above-quoted rather cryptic assertions of obviousness, any teaching or suggestion of a light-emitting diode (LED) having a first conductor thereof which extends in a cantilevered manner from the light emitting portion of the LED and with said cantilevered conductor also being positioned adjacent but not touching one of the terminals of a wafer battery so that when weight is exerted

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over the cantilevered conductor by walking, the cantilevered conductor is moved downwardly into contact with said one terminal of the wafer battery, and means for electrically connecting the second conductor to the other of said terminals of said wafer battery so that the circuit between the LED and the battery is completed and the LED is energized when weight is being exerted over the cantilevered conductor, and when weight is removed over the cantilevered conductor, the natural elasticity of the cantilevered conductor will cause it to move out of contact with said one terminal of the wafer battery thereby de-energizing the LED.

In light of the absence of any reasonable teaching or suggestion in the applied references, or otherwise, of the particular arrangement of LED, conductors and wafer battery defined in appellant's claims on appeal, we will not sustain the examiner's rejection of claims 19 through 21 under 35 U.S.C. § 103 as being unpatentable over Dana III in view of Reichert or alternatively, Reichert in view of Dana III.

Having reviewed the additional references to Evanyk and Bott applied by the examiner against claims 22 through 29, we note that such references do not supply or account for the deficiencies noted above with regard to the basic combination of

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references (Dana III and Reichert). Accordingly, we will likewise not sustain the examiner's rejections of claims 22 through 29 under 35 U.S.C. § 103, each of which is premised on the examiner's combination of Dana III in view of Reichert or alternatively, Reichert in view of Dana III.

Appellant's brief, at page 19, makes reference to a declaration of commercial success which is said to be "attached" to the brief. However, we find no such declaration attached to the brief. Our review of the application file reveals that the only evidence of commercial success proffered was attached to Paper No. 13, filed June 13, 1994, and was an "Affidavit of Commercial Success" signed by the inventor, Carmen C. Rapisarda. In view of our disposition of the obviousness (§ 103) rejections above, we find no need to review this secondary evidence of nonobviousness.

The next rejection posited by the examiner is that of claims 19 through 29 under "the judicially created doctrine of non-statutory double patenting" as being unpatentable over claims 1-5 of U.S. Patent No. 5,285,586. On page 7 of the answer, the examiner notes that

[t]he non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent

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the unjustified or improper timewise extension of the "right to exclude" granted by a patent (citations omitted).

On page 12 of the answer, the examiner points to In re Schneller, 397 F.2d 350, 353-54, 158 USPQ 210, 214 (CCPA 1968) and In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015-16 (Fed. Cir. 1993) in support of the double patenting rejection.

Unlike the situations involved in Schneller and Goodman, the subject matter of the Goldston et al. patent relied upon by the examiner here involves an improvement or modification invented after the filing by appellant of the initial application on the basic invention (Serial No. 806,925, filed December 11, 1991), and from which the application before us on appeal is a continuation and the patent No. 5,285,586 (resulting from an application filed June 26, 1992 by another inventive entity including the appellant) is said to be a continuation-in-part. For this reason alone we consider that Schneller and Goodman are distinguishable.

Moreover, even if there might be some timewise extension of the patent protection of the Goldston et al. structure, we note that only if the extension of patent rights is unjustified is a double patenting rejection appropriate. See, e.g., In re Braat, 937 F.2d 589, 594, 19 USPQ2d 1289, 1293 (Fed. Cir. 1991) and In

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re Borah, 354 F.2d 1009, 1010, 148 USPQ 213, 214 (CCPA 1966). On the facts of the case before us on appeal, we do not see, and the examiner has not explained, why claims 19 through 29 before us on appeal would result in an unjustified or improper timewise extension of the right to exclude granted by U.S. Patent No. 5,285,586, issued February 15, 1994. Thus, for the above reasons, we will not sustain the examiner's rejection of claims 19 through 29 on appeal based on "non-statutory double patenting."

In summary:

The examiner's rejection of claims 19 through 21 under 35 U.S.C. § 103 as being unpatentable over Dana III in view of Reichert or alternatively, Reichert in view of Dana III is not sustained.

The examiner's rejection of claim 22 under 35 U.S.C. § 103, and that of claims 23 through 29 under 35 U.S.C. § 103 are also not sustained.

The examiner's rejection of claims 19 through 29 under "the judicially created doctrine of non-statutory double patenting" as being unpatentable over claims 1-5 of U.S. Patent No. 5,285,586 is not sustained.

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In accordance with the foregoing, the decision of the  
examiner rejecting claims 19 through 29 is reversed.

REVERSED

	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMESON LEE	)	
Administrative Patent Judge	)	

APPENDIX

19. An improved shoe of the type having a flexible sole and having a heel and a toe and having at least one light-emitting diode in the sole thereof, said light emitting diode having a light emitting portion, a first conductor and a second conductor, said at least one light emitting diode being supported in the sole of the shoe so that the light-emitting portion thereof is visible from the exterior of the shoe, at least one wafer battery having a first surface and a second surface and a positive terminal on one surface and a negative terminal on the other surface, said at least one wafer battery being held by said shoe and electrically connectable to said first conductor and said second conductor of said at least one light-emitting diode when weight is exerted on the sole of said shoe, wherein the improvement comprises:

supporting said light emitting portion of said at least one light emitting diode so that the first conductor thereof extends in a cantilevered manner from said light emitting portion and is a cantilevered conductor and said cantilevered conductor is adjacent but not touching one of the terminals of said at least one wafer battery so that when weight is exerted over the cantilevered conductor by walking, the cantilevered conductor is moved downwardly into contact with said one of said terminals of said at least one wafer battery; and

means for electrically connecting the second conductor to the other of said terminals of said wafer battery so that the circuit between the light emitting diode and the wafer battery is completed and the light emitting diode is energized when weight is being exerted over the cantilevered conductor and when the weight is removed over the cantilevered conductor, the natural elasticity of the cantilevered conductor will cause it to move out of contact with said terminal of said wafer battery thereby de-energizing the light emitting diode.

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