

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(2) is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANE PALLERA

Appeal No. 96-2724
Application 08/343,201¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
FRANKFORT and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed November 22, 1994. According to appellant, the application is a continuation of Application 08/116,358, filed September 2, 1993, abandoned.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4 through 10, which are all of the claims remaining in the application. Claims 1 through 3 and 11 through 17 have been canceled. In a paper filed April 25, 1996 (Paper No. 31) appellant withdraws the appeal as to claims 8 and 9. Accordingly, the appeal as to those claims is dismissed and only claims 4 through 7 and 10 remain for our consideration in this appeal.

Appellant's invention is directed to a shoe having a display assembly attached to an outer surface of the shoe upper. Claim 10, the only independent claim on appeal, is illustrative of the subject matter on appeal and a copy of claim 10, as it appears in the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Adams et al. (Adams)	2,801,477	Aug. 6, 1957
Webb	4,677,008	June 30, 1987

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Sigoloff	4,712,314	Dec. 15, 1987
Swartz	5,379,533	Jan. 10, 1995
		(filed Dec. 6, 1991)

Claims 4, 5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swartz.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Swartz in view of Webb.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Swartz in view of Sigoloff or Adams.²

The full text of the examiner's rejections with regard to claims 4 through 7 and 10 and rebuttal to the arguments presented by appellant appears in the answer (Paper No. 30, mailed February 21, 1996). Rather than reiterate appellant's position on the issues raised in this appeal, we make reference to the main and reply briefs (Paper Nos. 29 and 32) for the complete statement of appellant's arguments.

² The rejections of claims 8 and 9 under 35 U.S.C. § 112, second paragraph, and of claims 8 and 9 under 35 U.S.C. § 103, as found in the examiner's answer, are moot in view of appellant's withdrawal of the appeal as to those claims in Paper No. 31.

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OPINION

Having carefully considered appellant's specification and claims, the applied references, and the respective viewpoints of appellant and the examiner, it is our determination that the examiner has failed to establish a prima facie case of obviousness with regard to claims 4 through 7 and 10 on appeal. Our reasoning for this determination follows. In addition, pursuant to our authority under 37 CFR § 1.196(b), we have also decided to enter a new ground of rejection of appealed claims 4 through 7 and 10 under 35 U.S.C. § 112, second paragraph.

Turning first to the examiner's rejection of claims 4, 5 and 10 under 35 U.S.C. § 103, we do not share the examiner's view that it would have been obvious, absent any suggestion or incentive recognized in the applied prior art, to merely eliminate the fluid from the chambers (e.g., 14, 16) of the display assembly associated with the shoe of Swartz. While it is true that in In re Karlson, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963) the Court stated that

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omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before,

we observe, as appellant has on page 7 of the brief, that the Court has also recognized that this is not a mechanical rule, and that such language in Karlson was not intended to short circuit the determination of obviousness mandated by 35 U.S.C. § 103. See In re Wright, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965). Thus, as in reviewing any obviousness determination, we must first look to the prior art and ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification proposed by the examiner. See, e.g., In re Lulu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

In this particular case, we share appellant's view as expressed on pages 4-8 of the brief and in the reply brief that the elimination of the fluid from the chambers of the display apparatus of Swartz would not have been obvious to a person of ordinary skill in the art based on any teaching, suggestion or

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motivation found in the applied reference. Like appellant, we believe that the examiner's modification of Swartz in the specific manner posited in the final rejection and answer is based on the hindsight benefit of appellant's own teachings and not on anything fairly suggested by the reference itself. Moreover, as

appellant has urged, the critical nature of the fluid filled chambers to the invention in Swartz clearly dictates against any such removal, and if the fluid were removed from the chambers, the very nature of the display apparatus therein would be altered to the extent that such display apparatus would not be capable of performing the same functions as before. Thus, we will not sustain the examiner's rejection of claims 4, 5 and 10 under 35 U.S.C. § 103 based on Swartz.

Turning to the examiner's rejections of claims 6 and 7 under 35 U.S.C. § 103, we share appellant's view concerning the obviousness of using radioactive spheres (as in Webb) in the footwear of Swartz, and appellant's view concerning the examiner's proposed downsizing of the picture in either Sigoloff or Adams, given the express disclosure in each of these

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references that the picture or insert therein is sized to fill the recess or pocket of the respective display assemblies disclosed in the references. Accordingly, the examiner's rejections of claims 6 and 7 under 35 U.S.C. § 103 will likewise not be sustained.

In accordance with our authority under 37 CFR § 1.196(b), we enter the following new rejection of claims 4 through 7 and 10 under 35 U.S.C. § 112, second paragraph.

Claims 4 through 7 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as her invention.

The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re

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Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

This is not to say that a lack of precision in claim language automatically renders a claim indefinite. However, definiteness problems often arise when words of degree are used in a claim. In such a case, it must be decided whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. See Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

In the present case, independent claim 10 was amended in Paper No. 23, filed July 7, 1995, to include a limitation regarding the sealed compartment of the display assembly therein being "substantially free of liquid." Appellant's specification does not provide any guidance as to what might constitute a sealed compartment that is "substantially free of liquid," and it does not appear to us that this claim language has any clear meaning when read in light of the originally filed specification. Page 3 of the specification describes the embodiment of Figure 1 as including a sealed pouch (12) provided with a large number of discrete, luminescent glow pieces (22). The specification is silent as to any fluid in the pouch (12). The embodiment of

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Figure 4 is described as having a star-shaped pouch (30) which carries a mixture of sand (32) and oil (34). There is no indication in the specification as to how much of the pouch is filled with oil, although it appears from Figure 4 that only about half of the pouch is filled with the mixture. Thus, the originally filed specification leaves us in the dark as to what the new claim language "substantially free of liquid" is intended to mean. Appellant's attempt in Paper No. 23 to be a post-hoc lexicographer and thereby explain the meaning of this language added to claim 10, is unavailing, since it is the original

disclosure itself which must provide support and antecedent basis for this language. Finding no clear understanding of exactly what the limitation of claim 10 regarding the sealed compartment being "substantially free of liquid" means, we find this claim and the claims which depend therefrom to be indefinite.

To summarize, the decision of the examiner rejecting claims 4 through 7 and 10 under 35 U.S.C. § 103 is reversed. However, as provided for in 37 CFR § 1.196(b), a new rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, has been entered by this panel of the Board.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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REVERSED, 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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CHARLES E. FRANKFORT)
Administrative Patent Judge)
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LAWRENCE J. STAAB)
Administrative Patent Judge)

BOARD OF PATENT
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APPENDIX

10. A shoe comprising a sole, a shoe upper mounted on the sole, and a display assembly attached upon an outer surface of said shoe upper,

said display assembly comprising:

an outer member comprising a translucent wall at least partially defining a sealed compartment having an arbitrary shape that is defined by dimensions of width, thickness and length, said translucent wall comprising a central portion and generally upstanding sidewalls extending about the periphery of said central portion, said sealed compartment being substantially free of liquid, and

at least one solid decorative device disposed within said sealed compartment,

said translucent wall permitting viewing of said at least one decorative device disposed within said sealed compartment, and

said at least one solid decorative device having dimensions of width, thickness and length, the width of said at least one decorative device being significantly less than the width of the sealed compartment, the thickness of said at least one decorative device being significantly less than the thickness of said sealed compartment, and the length of said at least one solid decorative device being significantly less than the length of said sealed compartment, in a combined dimensional relationship selected to permit free movement of said solid decorative device within said sealed compartment.