

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH COUNTEE JR.

Appeal No. 2002-1818
Application 29/094,432

HEARD: December 11, 2002

Before GARRIS, FRANKFORT, and SAADAT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The ornamental design for a RECLOSABLE, EXPANDED SNACK CARTON as shown and described.

As is apparent from the drawings and description in the specification of the present design application, appellant's invention is directed to a reclosable snack carton in an expanded or flexed, open configuration, i.e., where the top closure

portion of a normally rectangular parallelepiped carton has been fully opened and pressure applied to the narrow side panels of the carton to cause the large front and back panels of the carton to flex in a particular way to provide an expanded, open configuration shown in a first embodiment in Figures 1 through 7 and a second embodiment in Figures 8 through 14 of the application.

More particularly, as noted on pages 2 and 3 of appellant's brief, it is apparent that the claimed expanded carton includes specific score lines arranged on each of the large front and back panels extending from the bottom corners of the panels to the center of the top edge of the panels and a single score line extending from that point to the top edge of each of the front and back closure flaps, thereby providing a hexagonal appearance to the top opening of the flexed and expanded carton (e.g., Fig. 6) and three triangular, planar portions bounded by straight lines on each of the front and back panels (e.g., Figs. 1, 2 and 4). As is further apparent from the side views (e.g., Figs. 3 and 5), the expanded carton has a straight tapered appearance which narrows from the top edges of the front and back panels to the bottom of the carton. In addition, as can be clearly seen in Figure 7, for example, the claimed expanded carton also has a

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hexagonal appearance when viewed from the bottom of the carton. Four separate top flaps with no connection at their side edges and a liner inside the carton are also shown in the drawings.

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

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| Luckett | 2,176,912 | Oct. 24, 1939 |
| Zoss et al. (Zoss) | 5,292,058 | Mar. 8, 1994 |

The appealed design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Zoss in view of Luckett. In the examiner's opinion, Zoss discloses basically all the characteristics of the claimed design with the only difference residing in the configuration of the score lines on the front and rear panels of Zoss' package. To account for this difference, the examiner turns to the container of Luckett (Fig. 3), urging that it would have been obvious to a designer of ordinary skill in the art at the time the invention was made "to have modified the Zoss package by replacing it's score line configuration (elements 72f, 74f and 76f) with that of the score line configuration (elements 31, 32 and 33) of the Luckett package" (answer, page 3).¹

¹Although not expressly stated, it is clear that the examiner must also consider it to have been obvious to replace the score line configuration (elements 72b, 74b and 76b) on back

OPINION

Having carefully considered the issues raised in this appeal in light of the examiner's position and remarks as set forth in the examiner's answer (Paper No. 19, mailed February 25, 2002) and appellant's arguments as set forth in the brief (Paper No. 18, filed December 18, 2001) and reply brief (Paper No 20, filed April 29, 2002), it is our conclusion that the examiner's rejection of the present design claim under 35 U.S.C. § 103 will not be sustained. Our reasons follow.

In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration. See In re Rosen, 673 F.2d 288, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type presented in the application under consideration. The "ordinary designer" is one who brings certain background and training to the problems of

panel (28) of the package in Zoss with the score line configuration (elements 31, 32 and 33) of the Lockett package, thereby resulting in an article (carton) the examiner characterizes as being "strikingly similar in general overall appearance of [sic, to] the claimed design" (answer, page 3).

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developing designs in a particular field. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784-85 (CCPA 1981).

Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent references, when such references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, supra, and In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). If, however, the combined teachings of the applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663-64 (Fed. Cir 1987).

In the present case, appellant has challenged the examiner's determination that the expanded package seen in Zoss is a Rosen-type reference (brief, pages 4-6 and reply brief, pages 3-4). Appellant further argues with regard to the applied prior art references that a designer of ordinary skill who designs cartons

like that claimed in the present application would not have made the substitution posited by the examiner, because such a modification would greatly change the overall curved and geodesic appearance of the Zoss package into a planar angular design with straight borders, thereby changing the overall appearance of the top, bottom, front and back, and the sides of the Zoss package, i.e., changing nearly every element of Zoss' package (brief, pages 7-8). In addition, appellant argues that the modification proposed by the examiner is an inappropriate modification of the Zoss package because Zoss "teaches away" from any such modification of the score line configuration therein (brief pages 9-11 and reply brief, pages 4-6).

Dealing with the Rosen reference issue first, we note that the only showing of the expanded package of Zoss is found in Figure 1 of that patent, which appears to be a top, front perspective view of the package in its expanded configuration. Apparently, from this view alone the examiner contends that the package of Zoss "discloses basically all the characteristics of the claimed design" (answer, page 4), with the "only difference" residing in the configuration of the score lines on the front and rear panels of Zoss' package. The examiner then concludes that the design characteristics of Zoss satisfy the Rosen requirement

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under 35 U.S.C. § 103 of being a "something in existence."

However, after careful consideration of the teachings of the Zoss reference as a whole, we agree with appellant's assessment in the brief and reply brief that the expanded package seen in Zoss is not a "something in existence" the design characteristics of which are basically the same as the claimed design, and thus conclude that Zoss is not a Rosen reference.

Like appellant, we note that the examiner's position that "the only difference resides in certain configuration of score lines of the front and rear side panels" (answer, page 4), is in error, because it fails to take into account the overall visual impression created by the expanded package of Zoss, which visual impression a designer of ordinary skill would have fully appreciated after having read the specification of the Zoss patent. More particularly, while Zoss discloses a package or carton having score lines on its front and back surfaces, the patent makes clear (col. 6, lines 3-15) that the arrangement of the score lines therein allows the panels (18, 28, 46, and 60) to be

flexed into a non-planar shape with edges 48, 56, 62, and 68 of panels 18, 24, 28, and 32, respectively, and edges 47, 78, 96, and 80 of panels 46, 54, 60, and 66 being open and generally of an oval shape (emphasis added).

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In addition, at column 6, lines 35-42, Zoss notes that spacing score lines 72, 74, and 76 from side edges 20 and 22 of panel 18 and side edges 26 and 30 of panel 28 and from bottom edges 44 gives rigidity to panels 18 and 28 to assist in their return to a static, planar condition. Additionally, the Y-shape divides panels 18 and 28 into 3 flat areas which have a geodesic configuration when panels 18 and 28 are flexed outwardly and have a tendency to return to a static planar condition.

On page 6 of the brief, appellant provides a definition of "geodesic" which indicates that this term pertains to the geometry of curved surfaces, in which geodesic lines take the place of straight lines of plain geometry.

In light of the foregoing, it is clear to us that a designer of ordinary skill who designs articles of the type claimed in the present application would have readily recognized and appreciated that the expanded package shown in Figure 1 of Zoss has three interconnected areas on each of the front and back panels which are rounded or curved (i.e., are of geodesic configuration) and which provide the expanded package of Zoss with an overall curved appearance and thereby provide the package and opening thereof with a generally oval shape, whereas appellant's claimed carton creates an overall planar, tapered and triangular visual impression with a hexagonal top opening.

Accordingly, for the reasons set forth by appellant on pages 5 and 6 of the brief, and pages 3 and 4 of the reply brief, we find that the expanded package shown in Figure 1 of Zoss differs significantly from the expanded carton claimed by appellant and that major modifications would be required to make the expanded package of Zoss, with its geodesic (curved) areas and generally oval configuration, look like appellant's claimed expanded carton having tapering flat, planar triangular areas and a hexagonal top opening. Thus, we conclude that Zoss does not qualify as a basic design reference meeting the Rosen requirement and for that reason alone would refuse to sustain the examiner's rejection under 35 U.S.C. § 103.

As for the examiner's assertions on pages 5 and 6 of the answer that the visual impression of both appellant's carton and that of Zoss created on any prospective buyer would be basically a regular rectangular shaped carton, and that the expanded configuration of appellant's carton is "merely a functional feature of the claimed design," we find such position to be untenable. As emphasized by appellant in both the specification, brief and reply brief, the claimed design is directed to an expanded snack carton, not the carton in its rectangular parallelepiped form. Moreover, the mere fact that the expanded

carton may have functional aspects does not allow the examiner to assume lack of ornamentality. In this case, we agree with appellant's assessment on page 2 of the reply brief that because there are many other ways to allow for access to a carton of the type involved in the present application and for removal of its contents, the particular appearance of appellant's claimed expanded carton design has a primarily ornamental purpose and cannot be ignored.

Moreover, even if we were to assume for the sake of argument that Zoss was a Rosen-type reference, we must agree with appellant (brief, pages 9-11, and reply brief, pages 4-6) that Zoss and Luckett are not properly combinable in the manner urged by the examiner, because Zoss explicitly "teaches away" from a score line configuration like that seen in Luckett. More specifically, Zoss (col. 5, lines 1-53) teaches that the score lines are spaced from the side edges of the front and back panels and from the bottom edge (44) of the panels, with said spacing providing "rigidity to panels 18 and 28 to assist in their return to a static, planar condition" (col. 6, lines 35-39) and also contributing to achieving the geodesic (curved) configuration of the package in its flexed or expanded condition. In addition, as noted by appellant in the brief and reply brief, language

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relating to such spacing of the score lines or flex allowing means was added to independent claim 1 of the Zoss patent during prosecution thereof specifically to distinguish from a score line configuration like that in Lockett. Thus, the teachings of Zoss when considered as a whole would have led a designer of ordinary skill in the carton field in a direction divergent from the path that was followed by appellant and discourage an expanded carton with the claimed design.

As was made clear in In re Haruna, 249 F.3d 1327, 1335, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001), 35 U.S.C. § 103 (and all the case law interpreting that statute) applies with equal force to a determination of obviousness of either a design or a utility patent and, therefore, a prima facie case of obviousness in a design application can be rebutted if the applicant can show that the art in any material respect taught away from the claimed invention. In this case, appellant has clearly demonstrated that the Zoss patent teaches away from the claimed design.

Thus, even if Zoss were a Rosen reference, we have determined that the evidence before us as a whole would not have been suggestive of the modifications posited by the examiner and thus of the distinctive ornamental appearance of appellant's claimed expanded snack carton.

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In accordance with the foregoing, the decision of the
examiner rejecting appellant's claimed design under 35 U.S.C.
§ 103 is reversed.

REVERSED

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| BRADLEY R. GARRIS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | APPEALS AND |
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