The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR MILLER

Appeal No. 2003-1760
Application No. 29/159,145

ON BRIEF

Before NASE, BLANKENSHIP, and PAWLIKOWSKI, Administrative Patent Judges.

BLANKENSHIP, 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 AN INFLATABLE SPORTS BALL IN THE STYLE OF A BASKETBALL, as shown and described.

We reverse.

BACKGROUND

The examiner relies on the following reference:

Henderson	3,512,777	May 19, 1970

The claim stands rejected under 35 U.S.C. § 112, first paragraph, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same.

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Henderson, Figure 23.

We refer to the Rejection (Paper No. 4),[1] the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 12) for a statement of the examiner's position and to the Brief (Paper No. 11) and the Reply Brief (Paper No. 13) for appellant's position with respect to the claim which stand rejected.

OPINION

The examiner has rejected the claim under 35 U.S.C. § 112, first paragraph. The examiner contends that the claim is non-enabling since the detail within surface portions of the design outside the enlarged area in Figs. 4-5 is "left to conjecture from the present sketchy and incomplete hatching shown in Figs. 1-3." (Rejection at 2.) Further,

[1] The Examiner's Answer refers to both the Final Rejection and to Paper No. 4, the first Office action on the merits. Cf. MPEP § 1208, "ANSWER," 8th ed., Rev. 1, Feb. 2003 ("Only those statements of grounds of rejection appearing in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.").

the examiner contends that the raised and depressed areas shown in Figure 4 are poorly differentiated, and the sectioned area "is not fully consistent between the sectional view and the portions of Fig. 4 lying along the section line...." (Id.)

Appellant responds that no reasonable person, and particularly not one "versed in the art dealing with an article of manufacture imparted with an ornamental design," would understand the "surface texture" shown in Figure 4 to be limited to that particular area. (Brief at 5.) Appellant also refers to a declaration, filed December 17, 2002 (Paper No. 8), submitted by the draftsman who prepared the instant drawings. The draftsman avers therein that the area shown in Figure 4 is representative of the surface ornamentation of the entire surface of the object, and did not feel it was humanly possible to draw the surface ornamentation as it appears throughout the entire surface, particularly due to the different perspectives of view represented by the figures. The draftsman also avers that, in his opinion, the instant drawings would be effective to anyone knowing how to read and interpret drawings to enable visualization of the object.

The examiner responds (Answer at 4) that the surface texture in a model submitted by appellant, but not discernable in the claim, provides evidence that the Section 112, first paragraph rejection is proper. The examiner also asserts that the declaration does not constitute evidence of sufficiency of the disclosure of the claim.

In general, requirements for patentability for design applications are the same as those for utility applications. 35 U.S.C. § 171. With respect to enablement under the

first paragraph of Section 112, the examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection is thought to be not adequately enabled by the disclosure. If that burden is met, the burden then shifts to the applicant to provide proof that the disclosure is indeed enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Every design application relies to some extent upon knowledge of the person skilled in the art to complement that which is disclosed in order to make it enabling within the meaning of the first paragraph of 35 U.S.C. § 112. Ex parte Asano, 201 USPQ 315, 317 (Bd. App. 1978). In a design application, the person of ordinary skill in the art is the designer of ordinary skill who designs articles of the type claimed. In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981).

In view of this record, we agree with appellant that the designer of ordinary skill who designs articles of this type would have inferred, absent some clear indication to the contrary, that the surface treatment shown in Figures 4 and 5, other than that representative of a seam, is repeated throughout substantially the entire surface of the ball. We note in particular the lack of correspondence between the shading in the Figure 3 section -- the section shown in detail in Figure 4 -- and the Figure 4 detail. The inference to be drawn is that the shading shown in Figures 1 through 3 is not representative of the surface ornamentation, but representative of the spherical nature of the ball. In our view, there is insufficient basis to question whether the ordinary designer could, within reason, be able to make and use the disclosed design.

Further, the examiner's description at page 2 of the Final Rejection appears to belie the position that the surface detail is poorly shown. The examiner refers to "fan-like rib elements," and a "random arrangement." We find the drawings to reasonably convey a ball having surface ornamentation of clusters of about 4 to 6 ribs, the ribs within a cluster spaced closer together at one end than the other, with some of the ribs bifurcating at one end into two joined ribs, and with the clusters arranged in seemingly random orientations. How closely the claim may or may not match the model submitted by appellant is not relevant to the present inquiry related to the effort required of the ordinary designer to reproduce the claimed design.

With respect to the rejection under 35 U.S.C. § 103, the ultimate inquiry under Section 103, in the design context, is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. Durling v. Spectrum Furniture Co., 101 F.3d 100, 103, 40 USPQ2d 1788, 1790 (Fed. Cir. 1996).

As suggested by appellant, the Section 103 rejection appears founded on the view that the claim is not understood. We agree with appellant that a case for obviousness over Henderson has not been established. Figure 23 of the reference merely depicts a seamed ball comprising a composite cover layer 2400 (Fig. 24). Henderson col. 6, ll. 14-53.

While the examiner asserts that the differences between the claim and the reference are de minimis, the rejection fails to specify what the differences are believed

to be, much less provides evidence or a persuasive explanation with respect to why the differences would be regarded as de minimis. Moreover, the rejection fails to show why a designer of articles of the type claimed would consider differences in surface details minor or unimportant in the context of the overall appearance of such an article.

We therefore sustain neither of the rejections applied against the claim.

CONCLUSION

The rejection of the claim under 35 U.S.C. § 112, first paragraph is reversed.

The rejection of the claim under 35 U.S.C. § 103 is reversed.

REVERSED

JEFFREY V. NASE Administrative Patent Judge	)	
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

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