

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STUART J. LEDINGHAM

Appeal No. 2003-1862
Application No. 29/153,657

HEARD: DECEMBER 9, 2003

Before THOMAS, FRANKFORT and JEFFREY T. SMITH, Administrative Patent Judges.

THOMAS, 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 clamp, as shown and described.

The examiner has relied on the following references:

5,335,782 Herzog 08-1994

Valu Guide rod cross block in Bulletin No. 153; November 1994

Valu Guide transition cap assembly on page 30.2A; May 1994

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The design claim stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Herzog's element 36 or the Valu Guide rod cross block in Bulletin No. 153, each in view of the Valu Guide transition cap assembly on page 30.2A.

We refer to the Brief and the Reply Brief as well as the Answer for the respective positions of the appellant and the examiner.

OPINION

Having carefully considered the obviousness issues raised in this appeal in light of the teachings of the applied prior art and in light of the examiner's remarks and the appellant's arguments, it is our conclusion that the examiner's rejection of the present design claim must be reversed. Our reasoning is essentially is two-fold.

"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 388, 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 involved. See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there

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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, 673 F.2d 388 at 391, 213 USPQ 347 at 350 (CCPA 1982); In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956); In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). 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 (Fed. Cir. 1987).

The examiner’s reasoning of combinability at pages 3 and 4 of the Answer concludes that it would have been obvious for the ordinary designer to have modified Herzog’s element 36 or the Valu Guide rod cross block in Bulletin No. 153 by the addition of raised bosses around the circular openings as taught by the Valu Guide transition cap assembly on page 30.2A. Following the above noted case law, the examiner reaches this conclusion because of the view that the applied references are so related that the appearance of features shown in one would suggest the application of those features

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to the other. On the other hand, appellant asserts that the examiner has not established a prima facie case of obviousness, principally based upon that the assertion that there is no motivation within 35 U.S.C. § 103 for the modification proposed by the Examiner.

We generally agree with this assertion by appellant, even in view of the examiner's amplified reasoning of combinability of pages 5 and 6 of the Answer. Appellant argues in the Brief that the Valu Guide transition cap assembly shows only a single boss around a single opening, concluding that this is insufficient evidence to establish obviousness as to the claimed four openings that have a symmetrical nature, whereas the reference has an asymmetrical nature. The examiner reasons "while the transition cap assembly shows only a single boss, it does show a boss around it's circular openings that may be interpreted as teaching the placement of a boss around all openings of a clamp." The examiner continues by citing older case law, "that the mere duplication of parts is obvious, unless a new visual effect results."

We do not agree with this amplified reasoning by the examiner. To the extent that both primary or Rosen-type references (Herzog's element 36 and Valu Guide's rod cross block in Bulletin Number 153) each do not show any bosses protruding from the four holes of Herzog's element 36 or the four holes of the Valu Guide rod cross block in Bulletin Number 153, the most that we can conclude is that the ordinary designer would have chosen to modify only one opening in each of these references in view of the

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transition cap assembly of Valu Guide's page 30.2A by utilizing only one boss on one opening among the four in the two Rosen-type references. This combination does not yield the overall appearance of the claimed design.

More telling, however, as a basis of reversing the examiner's rejection is the examiner's reasoning that it would have been obvious to the ordinary designer to have duplicated the parts or otherwise considered the teaching of the placement of a boss around all of the openings of the clamp, based upon the showing of a single boss from a transition cap assembly from the Valu Guide brochure page 30.2A. The examiner's basic rationale, that it would have been obvious to the ordinary designer to have varied the number of bosses, is further misplaced. As discussed in In re Harvey 12 F.3d at 1064, 29 USPQ2d at 1208, the examiner's rationale appears to be utilizing design concepts. The examiner's basic rationale may have some place in utility patent application analysis, but not in ornamental designs. The examiner's evidentiary void cannot be filled by a conceptualized approach. It is thus apparent that the examiner has applied an improper analytical framework within 35 U.S.C. §103 as a basis of the rejection on the applied prior art.

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In view of the foregoing, the decision of the examiner rejecting the design claim on appeal under 35 U.S.C. §103 is reversed¹.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

JDT/dpv

¹ Since we have concluded the Examiner's failure to set forth a prima facie case of obviousness, we have no need to consider appellant's secondary evidence of commercial success.

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