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precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT FEDOR, PAUL ANGELO LOGIUDICE,
BRIAN DEMERS and RYAN WILLIAMS

Appeal No. 2006-2074
Application No. 10/158,197
Technology Center 3700

HEARD: AUGUST 10, 2006

Before FRANKFORT, OWENS and NAPPI, **Administrative Patent
Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 36 through 63, claims 1 through 35 are canceled. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 36 through 63.

THE INVENTION

The invention relates to a set of knives in a knife block. The knives have labels in the butt of the handle that identify the type and/or length of the knife blade. Claim 36 is representative of the invention and is reproduced below:

36. A cutlery set comprising:

a plurality of cutlery implements, including at least a first knife and a second knife, each of the first knife and said second knife having a working element comprising a blade, and a handle to which the working element is attached, wherein the blade of the first knife differs from the blade of the second knife;

a block including a plurality of openings configured to receive the cutlery implements, the plurality of openings including at least a first opening configured to receive the blade of the first knife and a second opening configured to receive the blade of the second knife, so that when the first knife and the second knife are positioned, respectively, in the first opening and the second opening, the handle of the first knife and the handle of the second knife extend out of the block;

a first alphanumeric marking disposed on a butt end portion of the handle of the first knife so as to face generally away from the block when the blade of the first knife is sheathed in the first opening, the first marking indicating at least the type or length of the blade of the first knife; and

a second alphanumeric marking disposed on a butt end portion of the handle of the second knife so as to face generally away from the block when the blade of the second knife is sheathed in the second opening, the second marking, differing from the first marking and indicating at least the type or length of the blade of the second knife.

THE REFERENCES

The references relied upon by the examiner are:

Arnold	4,947,713	Aug 14, 1990
Fierthaler	5,081,770	Jan. 21, 1992
Howell	5,245,756	Sep. 21, 1993
Bond	5,341,707	Aug. 30, 1994
Seber	5,528,834	Jun. 25, 1996
Mangol	5,791,055	Aug. 11, 1998
Sanelli	6,560,877	May 13, 2003 (filed Feb 5, 2001)

THE REJECTIONS AT ISSUE

Claims 36, 37, 41, 42, 49, 50, 51, 55, 56, and 63 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sanelli in view of Howell, Arnold and Bond. Claims 38 through 40, 43 through 45, 52 through 54 and 57 through 59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sanelli in view of Howell, Arnold, Bond, and Fierthaler. Claims 46 through 48 and 60 through 62 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sanelli in view of Howell, Arnold, Bond, Fierthaler, Seber and Mangol. Claims 36 and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sanelli in view of Howell. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs, the evidence of secondary considerations proffered by appellants, along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejections of claims 36 through 63 under 35 U.S.C. § 103.

The examiner rejects independent claims 36 and 50 under 35 U.S.C. § 103 being unpatentable over Sanelli in view of Howell, Arnold and Bond and also under 35 U.S.C. § 103 being unpatentable over just Sanelli in view of Howell, asserting that the differences between Sanelli and Howell reside in the non-functional descriptive material printed on the handle of the knives. Appellants argue, on page 7 of the brief, that the labels on the knives in Sanelli are to group the knives based upon the food for which they will be used and that the labels do not use alphanumeric information to identify the specific blade of the knife. Appellants assert, on page 9 of the brief, that Sanelli and Howell do not teach alphanumeric information on the butt of the knife handles such that they are visible when the knives are in the block and that Bond and Arnold do not make up for this deficiency as they are non-analogous art. Further on page 10 of the brief, appellants argue that even if they were analogous art the examiner has not provided proper

motivation to combine the references. Further, on page 13 of the brief, appellants argue that modifying Sanelli to include an indicia of the type of blade would remove the foodstuff label on Sanelli's knives.

Appellants' arguments have not convinced us of error in the examiner's *prima facie* case of obviousness. Initially, we note that there are no arguments directed to the combination of Sanelli's knife with indicia on the butt of the handle and Howell's knife block. We are not persuaded that the indicia on the handle of the knife functionally relates to the knife. Appellants' arguments make much of the indicia on the butt of the knife reducing the wear on the knife. We are not persuaded by this line of reasoning. The indicia provides an indication of the type of knife in the knife block. The indicia aids the user in selecting the knife prior to removing it from the block, saving the user time and reducing the number of times the knife is removed from the block. Thus, reducing wear is a potential benefit, not the function, of the label if the user makes use of the indicia. Further, the indicia is not functionally related to the substrate (the knife) the indicia merely describes the knife, it does not relate to the function of the knife, i.e. it does not effect the knives' ability to cut. In *In re Gulack*, 703 F. 2d 1381, 217 USPQ 401 (Fed. Cir. 1983), the court held that the printed matter would not achieve its educational purpose without the substrate (a band) and the band without the printed matter would not be able to produce the desired result. In this case, the claimed knife will be able to perform its function of cutting regardless of what is indicated on the handle.

Thus, even without the additional teachings of Arnold and Bond we find that the examiner has made a *prima facie* case of obviousness.

However, we consider the combination with Arnold and Bond to also be proper. Bond teaches a method of labeling tools on the butt handle of the tool (See figure 1-5). The label on the butt of the tool can indicate type of tool, using either symbols or characters. See column 4, lines 29 through 33. Further, Bond teaches that the purpose of the indicia is that when the tools are in a tool belt/pouch, where the butt end is usually in the user's line of vision, the user can select the appropriate tool for the job. See column 5, lines 57 through column 6, line 5. We find that this teaching shows both that Bond is analogous art and provides suggestion to modify Sanelli's knives. As stated by appellants, on page 9 of the brief, prior art is analogous if it is pertinent to the problem with which the inventor is involved, in this case both the invention, Sanelli and Bond are concerned with providing an indication relating to the use of a tool which is visible to a user to aid in selection of the proper tool for a given job. Further, we consider Bond's teaching that that the indicia facilitates selecting the proper tool, to provide a suggestion to modify the knife of Sanelli. Contrary to appellants' arguments we find no indication that this would result in the user no longer being able to determine the type of foodstuff with which Sanelli's knife can be used. We note that claim 36 recites "the first marking indicating at least the type or length of the blade of the first knife", claim 50 contains a similar limitation. Thus, the claims do not require that the indication provide both type and length of the blade. Bond's teaching of a marking identifying the type of tool, which in combination with Sanelli suggests indicating the type of knife, meets the claim limitation. As such the examiner's reliance on Arnold to show marking tool size is overkill. For the forgoing reasons, we are not

persuaded by the appellants' arguments that the examiner's rejection of independent claims 36 and 50 is in error and we find that the examiner has established a prima face case of obviousness.

Dependent claims 37 through 49 and 51 through 63 ultimately depend upon either claim 36 or 50 and are rejected 35 U.S.C. § 103 (a) as being unpatentable over Sanelli and Howell in conjunction with other references. For the reasons stated *infra*, we find that the evidence of secondary considerations outweighs the examiner's prima face case of obviousness over Sanelli and Howell. Accordingly, we will not further address the rejections, of claims 37 through 49 and 51 through 63, as our finding that the evidence of secondary considerations outweighing the evidence presented in Sanelli and Howell also applies to the rejections applied to claims 37 through 49 and 51 through 63.

In rejecting claims under 35 U.S.C. § 103 (a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Appellants have presented evidence of secondary considerations to show non-obviousness.

In the instant case appellants have presented two affidavits from Mr. Scott Fedor to show, commercial success in the form of increased market share, customer praise, and copying by competitors.

On pages 9 through 10 of the answer, the examiner states that the evidence submitted by appellants is insufficient to establish commercial success. The examiner reasons that the evidence does not compare similar products, further the examiner states, on page 10 of the answer:

customers may have purchased the Contemporary knives simply due to the trend of customers to purchase the "latest and greatest" products to hit the market. In other words, customers buy a specific product simply because it is new, and they want to have the most recent line of knives introduced to the market. The trends of the Unit Share factually support this assumption as shown in Tables 3A. Note that the Unit Share of the Contemporary line peaked in May of 2003, then steadily declined in June through April of 2004.

Further, the examiner states that the consumer praise is weak as no demographic information is provided. Finally, the examiner states that Sanelli was available prior to the invention, implying that the evidence could be showing that Sanelli was the product being copied. Additionally the examiner states, "copying a product to sell does not make it patentable, merely a desirable commodity for selling."

While we concur with the examiner that the individual pieces of evidence alone may not establish commercial success, we find that on balance the Appellants' evidence as a whole does present sufficient facts to outweigh the examiner's *prima facie* case of obviousness.

Evidence of Secondary considerations such as commercial success have relevancy in determining obviousness or non-obviousness *Graham v.*

John Deere 383 U.S. 1, 17 148 USPQ 459, 467 (1966). Evidence of non-obviousness must be commensurate in scope of the claims *In re Tiffin* 448 F.2d 791, 171 USPQ 294 (CCPA 1971). Copying of the invention by competitors is another form of secondary evidence.

Appellants submitted two declarations under 37 C.F.R. §1.132, from Scott Fedor (co-inventor), the first was submitted on July 23, 2004 (hereinafter declaration) and the second, a supplemental declaration, was submitted on November 23, 2004 (hereinafter supplemental declaration). In the declarations Scott Fedor discusses the success of Calphalon's "Contemporary" line of knife sets, which are asserted to embody the claimed invention. See declaration, paragraph 9. Mr. Fedor's declarations use Calphalon's "Traditional" line of knife sets as a basis of comparison. See declaration, paragraph 10. Mr. Fedor states: "It is my understanding that there are no substantial price or quality difference between the Traditional and Contemporary lines, nor were the marketing efforts associated with the introduction of these lines substantially different." See declaration, paragraph 12. In paragraphs 14 through 17 of the declaration, and accompanying tables, Mr. Fedor shows when the "Contemporary" knife sets were introduced, they enjoyed a larger market share (both in terms of dollar share and unit share) than associated with the "Traditional" knife sets.¹ We note, as the examiner points out, the sales of the "Contemporary" knife sets peaks in May 2003 and steadily declines through April 2004. However, we

also note that the sales in April 2004 (both in terms of dollar share and unit share) are greater than shown for the “Traditional” knife set in any one of the months for which data was presented by appellants. Thus, we concur with appellants that the evidence shows that the “Contemporary” knife set achieved a measure of commercial success. However, this evidence alone is not sufficient to overcome the examiner’s prima facie case of obviousness. In paragraph 12, of the Declaration, Mr. Fedor states “Traditional knives are substantially similar to the Contemporary knives according to the invention, except the prior Traditional knives lack the alphanumeric marking (see Fig. A-3) called for in claims 36 and 50 and the contoured handle (see Fig. A-2 and A-4) called for in claims 48 and 62.” Thus, we do not find that the evidence differentiates whether the commercial success for the “Contemporary” knife sets is due to the label on the butt of the handle as claimed in independent claims 36 and 50 or due to the shape of the handle, i.e. the evidence does not unequivocally show that the commercial success is due to the claimed alphanumeric marking.

Turning to the evidence of consumer praise, we similarly do not find that there is a clear connection between the “Contemporary” knives praised and the invention claimed in claims 36 and 50. In reviewing the comments submitted as Exhibits E of the Declaration, we note the positive comments are directed to both the shape of the handle and the label or marking on the butt of the knife handle.

¹ We note there are several inconsistencies between the statements in, Mr. Fedor’s declaration and the supporting data. For example paragraph 14 of the declaration states that there are no data points for the “Traditional” knife sets after August 2002, however

Finally turning to the evidence of copying, which is presented in paragraphs 21 through 24 of the declaration and paragraphs 8 through 11 of the supplemental declaration. Mr. Fedor describes three instances of copying. The first discussed is, the “Farberware Pro Forged” depicted in Exhibit F, which Mr. Fedor identifies as being introduced for sale in August 2003. See declaration, paragraph 22. The second discussed is the “Professional Gourmet Cutlery,” depicted in Exhibit G, sold by Tools of The Trade which Mr. Fedor identifies as being introduced for sale in October, 2003. See declaration, paragraph 23. The third discussed is a set sold by The Great Indoors, depicted in Exhibit H, which Mr. Fedor identifies as being introduced for sale in June 2004. See declaration, paragraph 24. Mr. Fedor, in paragraph 11 of the supplemental declaration, states: “ I am very confident that the similarities in design of the Great Indoors set and the Contemporary line, including the marking on the butt end of the knives, resulted from copying of the invention claimed in the ‘197 application. In fact the set shown in Exhibit H was manufactured, without Calphalon’s authority, by the very same supplier that manufactures [Calphalon’s] Contemporary products.”

We note that the initial sales dates of the competitors’ knives shown in Exhibits F through H, are after the initial sales data of the “Contemporary” knives. Further, in response to the examiner suggestion that the manufacturers of the knives shown in Exhibits F through H may have been copying Sanelli’s device, we find no evidence to support such speculation.

the data shows sales data points until August 2003. Accordingly, we base our conclusions upon the statements and underlying data submitted as Exhibit C.

There is no evidence that the manufacturer's of these knives were providing labels based upon the type of food the knife is to be used on as is disclosed by Sanelli. We also observe that of the three knife sets in exhibits F through H, all three have labels on the butt end of the knife handle, but only one has the contoured handle. The Farberware knife set (exhibit F) and the Tools of the Trade knife set (exhibit G) both have riveted handles similar to Calphalon's "Traditional" knife set. Whereas, the Great Indoors knife set has both the contoured handle and the labels on the butt ends of the knife handles. We consider this to be evidence that the copying is directed to the labels on the butt end of the handles. Thus based on the evidence of copying, in conjunction with the evidence of commercial success and, public praise, we find that the declaration and supplemental declaration present sufficient evidence of secondary considerations to outweigh the examiner's prima face case of obviousness. Accordingly, we will not sustain the examiner's rejection of independent claims 36 and 50 under 35 U.S.C. § 103. Similarly, we will not sustain the examiner's rejections under 35 U.S.C. § 103 of the dependent claims.

Conclusion

In summary, we find that the evidence of secondary considerations submitted by the appellants outweighs the examiner's evidence supporting the rejections of claims 36 through 63 under 35 U.S.C. § 103. Accordingly, the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	

OWENS, Administrative Patent Judge, dissenting.

Sanelli discloses a knife set wherein each knife has, on its butt end, an insert (50a, 50b) that is marked with either a color code or a symbol to identify a predetermined typology of foodstuff for which the knife must be used (col. 8, lines 19-25). It is undisputed that it would have been obvious to one of ordinary skill in the art to store Sanelli's knives in Howell's knife block (10) (declaration of Scott Fedor, ¶ 4).

The appellants argue that Sanelli's knives having the same color insert (or symbol) may be of different sizes and types (brief, pages 7-8).² The appellants' claims do not exclude knives of different sizes and types having on their butt ends the same color or symbol. The claims merely require that a marking on a first knife is different from a marking on a second knife, and that the markings indicate at least the type or length of the blade. The knives, for example, can be marked "K" for "kitchen" and "S" for steak, both of which are in the appellants' set (exhibit E, first page). The kitchen knives can be different types and have different sizes. Even if a marking is peculiar to one type of kitchen knife, the same marking can be placed on knives having different sized blades. For example, an "M" marking can appear on meat knives having 8" and 10" blades.

² Citations herein to the brief are to the supplemental brief filed May 23, 2005.

The appellants argue that two of Sanelli's knives that are identical, such as two 8" chef knives, can be in two different groups (reply brief, page 2).

Sanelli's disclosure that the knives having each symbol are used for a different typology of foodstuff (col. 8, lines 22-25) would have fairly suggested, to one of ordinary skill in the art, different symbols for different types of knives; for example, a loaf of bread symbol or a "B" symbol for a bread knife, and a cow head symbol or an "M" symbol for a meat knife.

The appellants argue that Sanelli's symbol is intended to identify a general category of foodstuff such as "vegetables" for which a set of knives is to be used, rather than a specific type of blade adapted for use with a type of food (reply brief, page 3). At least some of Sanelli's different typologies of foods would require different types of lengths and blades. For example, a bread knife or a vegetable knife would have a different blade type and length than a meat knife. Consequently, Sanelli would have fairly suggested, to one of ordinary skill in the art, first and second knives having different markings that indicate the type and/or length of each knife's blade.

The appellants argue, regarding dependent claim 41 and 45, that Sanelli discloses an insert rather than a cap (brief, pages 15-16). The appellants' claims do not require that the cap covers the whole butt end of the knife. Therefore, Sanelli's insert reasonably can be considered a cap within the meaning of the appellants' claims.

With respect to dependent claims 49 and 63, the appellants argue that Sanelli does not suggest a marking that indicates the length of the blade (brief, page 16). The appellants' claims do not require that the marking states the length of the blade, only that it indicates the length of the blade.

Thus, a “B” symbol for a bread knife in Sanelli’s set would give some indication of the blade length as being suitable for bread, whereas an “M” symbol indicating a meat knife would indicate a blade length that is suitable for cutting meat.

Moreover, the appellants’ markings are nonfunctional descriptive material and, therefore, do not distinguish the knives over knives having different markings. **See In re Gulack**, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). The appellants’ 8” bread knife performs the same function of cutting bread whether the symbol on the butt end is “8” or “BREAD” or any other symbol such as a star. The appellants’ symbol, whether it is “8” or “BREAD”, performs the same function of providing the information “8” or “BREAD” regardless of the substrate on which it appears. The appellants’ argument that the marking reduces wear on the blade when being placed into and removed from a block (brief, page 1) does not pertain to the functional relationship between the marking and the knife but, rather, relates to the effect on the knife of being used in a particular way.³ Regardless, even if the marking is functionally related to the knife, Sanelli’s knife and symbol indicating the typology of foodstuff for which the knife is used, e.g., bread or meat, have that functional relationship. One would not have to pull Sanelli’s bread knife out of a knife block to determine that the knife is not a meat knife.

³ That wear is reduced by the slots in the appellants’ block being oriented horizontally (exhibit E, first page).

Thus, there is a strong prima facie case of obviousness of the appellants' claimed invention over Sanelli in view of Howell.

Moreover, Bond discloses placing a symbol, indicator or indicia on the butt end of tool handles so that tool users can see the symbol, indicator or indicia when looking down at the tools in a tool pouch and thereby select the correct tool from the pouch (col. 3, lines 41-44; col. 5, line 64 – col. 6, line 6). The indicia indicate the configuration and orientation of the tool head (abstract). Bond's disclosure that the tools can be screwdrivers and "pliers, hammers, wrenches and the like" (col. 3, lines 56-58) would have fairly suggested, to one of ordinary skill in the art, that the "and the like" tool can be a knife. Thus, Bond further would have fairly suggested, to one of ordinary skill in the art, placing a symbol on the butt end of Sanelli's knife handle to indicate the configuration or orientation of the blade.

The appellants argue that Bond, which relates to hand held tools, is nonanalogous art (brief, pages 9-10). Bond is analogous art because it is reasonably pertinent to the problem with which the inventors were involved of identifying knives from their butt ends.

Arnold discloses placing numeric size indicia on a sleeve at the end of a wrench socket so that a user can quickly identify the size of the socket (col. 3, lines 35-42). This disclosure would have fairly suggested, to one of ordinary skill in the art, the use of numeric symbols at the end portions of Sanelli's knife handles to identify the size of the knives. The appellants argue that Arnold, which relates to wrench sockets, is nonanalogous art (brief, pages 9-10). Arnold is analogous art because it is reasonably

pertinent to the problem addressed by the appellants of identifying knives from the end portion of their handles.

The appellants argue that Bond and Arnold do not provide motivation to apply an alphanumeric marking on the butt end of a knife handle to reduce wear and tear on the knife blade (brief, page 12). To establish a prima facie case of obviousness, references need not be combined for the purpose of solving the problem solved by the appellants. **See In re Kemps**, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); **In re Beattie**, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); **In re Dillon**, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (**en banc**), **cert. denied**, 500 U.S. 904 (1991). One of ordinary skill in the art would have been motivated to combine the references for the reasons set forth above.

The appellants argue that if Sanelli's symbol identified the type or length of the knife blade, the symbol would no longer indicate the type of foodstuff with which the knife must be used (brief, pages 13-15). If Sanelli's symbol indicated that the type of blade is a bread cutting blade or a meat cutting blade, the symbol still would indicate the type of foodstuff (bread or meat) on which to use the knife.

Thus, Bond and Arnold strengthen the strong prima facie case of obviousness of the claimed invention over Sanelli in view of Howell.

The appellants argue, in reliance upon a declaration and supplemental declaration by Scott Fedor, that they have provided evidence of commercial success, consumer praise and copying which overcomes any prima facie case of obviousness (brief, pages 17-18). For the following reasons the

evidence relied upon by the appellants is insufficient for its intended purpose.

The Fedor declaration provides evidence that the appellants' contemporary line (the claimed knife set) has sold better than the appellants' traditional line (tables 1A, 1B, 2A, 2B, 3A and 3B). Fedor states that "[i]t is my understanding that there is no substantial price or quality difference between the Traditional and Contemporary lines, nor were the marketing efforts associated with the introduction of these lines substantially different" (§ 12). Fedor does not provide evidence to support that understanding, or set forth the basis for that understanding. Hence, Fedor's understanding is entitled to little weight. Regarding marketing, it is noteworthy that the appellants' contemporary set is advertised as having a list price of \$418.00 marked down to \$179.99 (exhibit E, first page). Thus, consumers are given the impression that for an affordable \$179.99 they are getting a very high quality set that normally would be within the financial reach of only the wealthy. There is no evidence of that marketing strategy being applied to the traditional line, and no evidence that it was not a major reason for consumers purchasing the set.

Moreover, one of ordinary skill in the art would have expected the contemporary line, which its modern looking, contoured handle that provides a comfortable grip and is rivetless, to appeal to more consumers than the traditional line's rectangular-shaped handle having rivets that are perceived as being susceptible to rusting (exhibit E, second page) and may

be considered unattractive.⁴ Not all consumers, of course, chose the contemporary line, because some consumers believe visible rivets make a handle more durable (exhibit E, second page), and may prefer a plainer appearance. Thus, the appellants' evidence of commercial success tends to establish obviousness, rather than unobviousness, of the claimed invention.

Fedor argues that consumer testimony shows commercial success of the contemporary line that is due to the claimed invention (§ 20). The consumer testimony includes features of the contemporary line that are not required by the appellants' claims, particularly the claims that do not require the contoured handle. Those features include great heft, fit to large hands, substantial casting, good sharpness, excellent balance, durability, comprehensiveness of the set, absence of rivets, strong blades, easy cleanup, good price, and good quality. Consequently, the consumer testimony does not indicate that consumers purchased the contemporary set because of the features recited in the appellants' claims, i.e., the marking on the butt end, alone or in combination with the contoured handle.

Fedor argues that copying of the contemporary cutlery set by others is evidence of unobviousness of the claimed invention (§§ 21-24). The evidence of copying is a Faberware Pro Forged set having handles that are contoured, riveted, and marked on their butt ends (exhibit F, figures 1-7), a Tools of the Trade Professional Gourmet Cutlery set having riveted handles that are marked on their butt ends but lack the appellants' contour (exhibit G, figures 1-5), and a Great Indoors set having rivetless handles that are not

⁴ Both contoured (Fierthaler, figure 1) and rivetless (Seber, figure 1) knife handles were known in the art at the time of the appellants' invention.

contoured but are marked on their butt ends (exhibit H, figures 1-5).

According to the Fedor declaration, each of these sets was introduced after the appellants' contemporary set and, therefore, can be presumed to have been copied from the appellants (§§ 22-24).⁵

The evidence does not establish copying of the contoured handle. That handle shape was known in the art as evidenced by Fierthaler (figure 1) and, out of all the manufacturers of cutlery sets, the appellants provide evidence of only one set by one manufacturer having a handle with that contour.

All three of the cutlery sets in the evidence have markings on the butt ends of their handles that indicate the type of knife, alone or in combination with the length of the blade. Since the appellants do not provide evidence of any other cutlery sets having knives with markings on their butt ends, it is presumed that any other cutlery sets made by the above manufacturers and all cutlery sets made by other manufacturers do not have such markings. Thus, the markings appear to be on only a small percentage of the cutlery sets on the market. The evidence, therefore, is not of widespread copying but, rather, limited copying. There is no evidence that the lack of markings on the other cutlery sets is due to the appellants' patent application rather than being due to the markings being considered undesirable.

⁵ There is no evidence of record that the markings on any of the cutlery sets in the evidence were copied from the appellants.

Because the appellants' evidence indicating copying of the appellants' markings is presumed, rather than proven, evidence of copying and is limited to three cutlery sets out of all cutlery sets on the market, the weight to which the evidence is entitled in determining whether the appellants' claimed invention would have been obvious to one of ordinary skill in the art is small. Consequently, a balance of that evidence in combination with the above-discussed weak evidence of commercial success and consumer praise and strong evidence of prima facie obviousness weighs in favor of a conclusion of obviousness of the claimed invention. Accordingly, I dissent from the majority's decision to reverse the examiner's rejections.

TERRY J. OWENS
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Appeal No. 2006-2074
Application No. 10/158,197

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