

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL K. KUEHNE and KEVIN L. KRYSIAK

Appeal 2007-1759
Application 29/206,334
Technology Center 2900

Decided: July 11, 2007

Before BRADLEY R. GARRIS, ERIC B. GRIMES, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

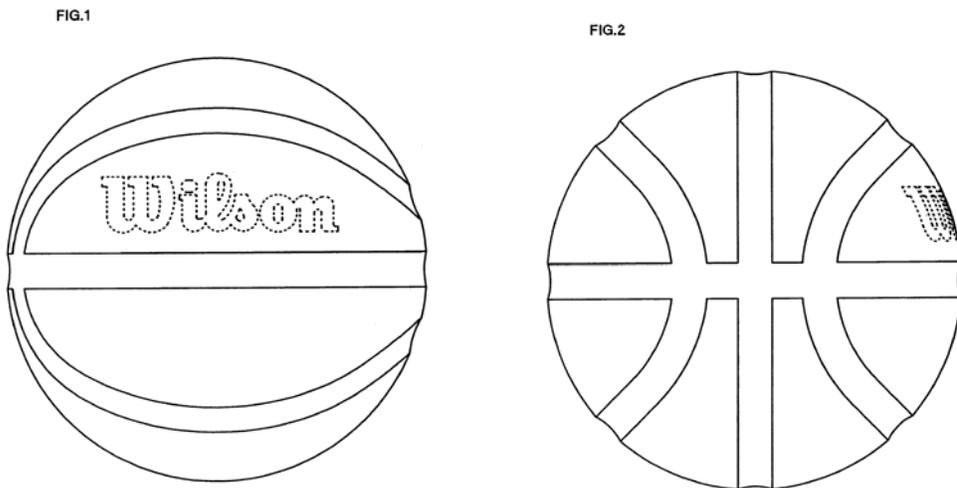
The Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of the sole claim in the pending application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellants' claim is to an ornamental design for a basketball. Representative Figures 1 and 2, depicting a front view and a side view, respectively, of the claimed ornamental design, are reproduced below.



Figures 1 and 2 of U.S. Patent Appl. No. 29/206,334

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Molitor	US 3,119,618	Jan. 28, 1964
Ou	US 2002/0098928 A1	Jul. 25, 2002

The sole claim stands rejected under 35 U.S.C. § 103(a) as unpatentable over Molitor and Ou.

ISSUE

The Appellants contend there is no suggestion or motivation to modify the prior art references or to combine reference teachings to produce the ornamental design of the claim (Appeal Br. 4). In particular, the Appellants contend that the significantly widened channels present on the claimed ornamental design for a basketball represent a significant, unique, and non-obvious departure from the appearance of the basketball of Molitor and conventional basketballs (Appeal Br. 5-6). The Appellants further contend that there would have been no motivation or reason to consider the image of the unfinished, misshapen ball carcass of Figure 4 of Ou, which is concealed in the normal use of the ball for which it is designed, for modifying the disclosure of Molitor (Appeal Br. 8, 10).

The Examiner found that the claimed design is similar in appearance to the basketball shown in Molitor except for the enlarged proportional width of the seal elements (Answer 3). The Examiner found that Ou discloses a playing ball having seam demarcations similar in proportional width to those in the claimed design (*Id.*). The Examiner concluded it would have been obvious to a designer of ordinary skill in the art at the time the invention was made to modify the basketball of Molitor by providing widened seams, as shown and suggested by Ou, and that such modification would result in a basketball having a strikingly similar overall appearance to the claimed design (*Id.*).

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting the claimed design as unpatentable over Molitor and Ou. In particular, the issue focuses on whether the appearance of certain features in Ou

would have suggested the application of those features to the basketball of Molitor that would have led to the claimed design.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Molitor discloses a molded basketball having mold lines, as shown in Figure 1, reproduced below (Molitor, col. 1, ll. 70-71).

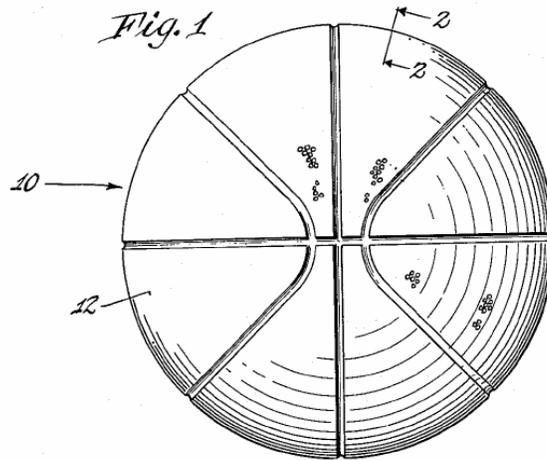


Figure 1 of U.S. Patent No. 3,119,618

2. The ornamental design of the subject application also has lines, as shown for example in Figure 2, reproduced below.

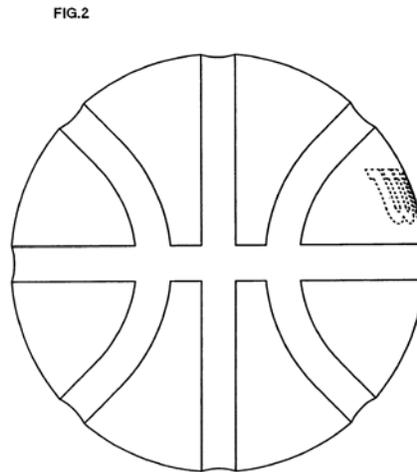


Figure 2 of Appl. No. 29/206,334

3. The ornamental appearance of Molitor's basketball differs from the design of the subject application in that the mold lines depicted in Figure 1 of Molitor are narrower in proportional width than the lines depicted in the subject application.
4. Ou discloses an inflatable sportsball having a cushioned carcass (Ou, 1:¶ 0003).
5. Ou shows, in Figure 4, a perspective view of a semi-finished ball carcass (Ou, 2:¶ 0028).
6. Ou describes, with reference to Figure 4, that an elongated rubber film 141 is adhered along rubber strips 14, wherein two side edges of the rubber film 141 are arranged to stick along the side portions of the two adjacent cushion panels 13 to form a semi-finished ball carcass 101 (Ou, 3:¶ 0039).
7. Ou discloses that the semi-finished ball carcass 101 is placed in a spherical mold and heat molded so that all the rubber materials are fused

into a single fusion layer of the ball carcass 10, as shown in Figure 1 (Ou, 3:¶¶0041, 0042).

8. As such, the finished end product of Ou is the ball shown in Figure 1, reproduced below.

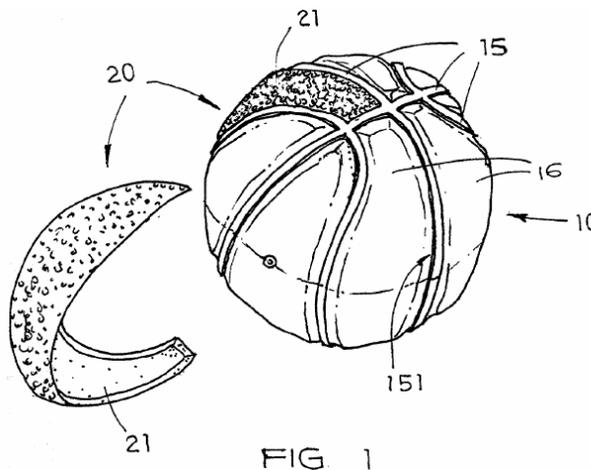


Figure 1 of U.S. Patent Appl. Pub. No. US 2002/0098928 A1

9. In Ou's finished ball, the final seam channels 15 are similar in proportional width to the mold lines in Molitor's ball and are narrower than the lines depicted in the subject application (Ou, Figure 1).

PRINCIPLES OF LAW

The patentability of a design is determined by a consideration of the overall appearance, the visual effect as a whole of the design. *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. *In re Nalbandian*, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). When a

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Section 103 rejection is based on a combination of references, “the long-standing test for the proper combination of references has been ‘whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” *Rosen*, 673 F.2d at 391, 213 USPQ at 350 (quoting *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956)).

The test for obviousness of a design has been further described as follows:

In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence -- not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature, as would be required here.

In re Jennings, 182 F.2d 207, 208, 86 USPQ 68, 70 (CCPA 1950). Further, if the combined teachings of the applied references would have suggested only components of the claimed design, but not its overall appearance, a conclusion of obviousness under Section 103 is inappropriate. *In re Cho*, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663-64 (Fed. Cir. 1987).

ANALYSIS

Neither the basketball of Molitor nor the ball of Ou, in their respective final end products, has seams or mold lines of a proportional width as claimed in the subject application (Findings of Fact 3, 9). The Examiner improperly relied on the depiction of the intermediate unfinished ball, shown in Figure 4 of Ou, for a suggestion to modify the ball of Molitor with wider mold lines. The test to

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determine a proper combination of references is whether the references are so related that the appearance of certain ornamental features in one would have suggested the application of those features to the other. *Rosen*, 673 F.2d at 391, 213 USPQ at 350; *Glavas*, 230 F.2d at 450, 109 USPQ at 52. The wider seams in Figure 4 of Ou, relied upon by the Examiner, are not “ornamental features” because, as argued by the Appellants, these wider seams are “concealed and hidden in the end product sportsball” (Appeal Br. 6).

The Examiner responded that only the drawing figure (Figure 4) of Ou has been relied upon and “the entire discussion that relates to the written description in [the] application publication, including that which describes what is intended to be shown in Fig. 4 or what is intended to be the finished product are irrelevant to the [issue of obviousness]” (Answer 4). We disagree. The Examiner should not have relied on Figure 4 in a vacuum without regard to the description provided of that figure. In this case, Ou’s description of Figure 4 clearly indicates that the figure represents a semi-finished ball carcass (Finding of Fact 6) and all the rubber materials, including the wider seams relied upon by the Examiner, are fused into a single fusion layer of the ball carcass 10 resulting in the final end product shown in Figure 1 (Findings of Fact 7, 8). As such, the features of the final end product of Figure 1 would have contained the only ornamental features in Ou that would have provided any suggestion to an ordinary designer. Figure 1 of Ou shows final seam channels 15, which are similar in proportional width to the mold lines in Molitor’s ball and are narrower than the lines depicted in the subject application (Finding of Fact 9). As such, a designer of ordinary skill in the art, considering the ornamental

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features of Ou, would not have been led to modify the mold lines of Molitor's basketball to result in the claimed design.

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting the sole claim under 35 U.S.C. § 103(a) as unpatentable over Molitor and Ou.

DECISION

The decision of the Examiner to reject the sole claim is reversed.

REVERSED

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