

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT M. RISDON and TIMOTHY M. O'HARE

Appeal 2007-4521
Application 29/177,452
Technology Center 2900

Decided: January 29, 2008

Before THOMAS A. WALTZ, JOSEPH L. DIXON, and
DONALD E. ADAMS, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of the sole claim in this design application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to surface ornamentation particularly adapted for use on a variety of furniture pieces, where the surface ornamentation is a braided pattern formed in a long strip

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along the show surface of the furniture piece (App. Br. 2-3).¹ The sole claim on appeal reads as follows:

We claim the ornamental design for a Surface Ornamentation for Furniture as shown and described.

The Examiner has relied on the following prior art reference as evidence of anticipation:

Herzog US 2,949,807 Aug. 23, 1960

ISSUE ON APPEAL

The sole claim on appeal stands rejected under 35 U.S.C. § 102(b) as anticipated by Figure 4 of Herzog (Ans. 3).²

Appellants contend that the Examiner erred in applying a “design concept” for the braid pattern rather than specific design characteristics (Br. 5-6).

Appellants contend that the Examiner does not deny that differences exist between the claimed design and the Figures of Herzog, namely the parallel edges in Herzog as compared to the non-parallel edges of the invention (Br. 6-7, citing Fig. 1 of Herzog and Fig. 8 of the invention).

Appellants contend that Herzog has braids in three-dimensions while the present ornamentation is flat with no depth (Br. 7-8; Reply Br. 3-4).

Appellants also contend that the Examiner ignores differences in the designs and provides no factual basis for her conclusion (Br. 8).

¹ We refer to and cite from the “**SUBSTITUTE APPEAL BRIEF**” dated Mar. 7, 2006.

² We refer to and cite from the Examiner's Answer dated Apr. 10, 2006, as amended by the Letter dated Sep. 18, 2007.

The Examiner contends that the “braiding claimed herein is virtually identical” to Fig. 4 of Herzog, “[a]n average observer would perceive no distinction” between the claimed design and Fig. 4 of Herzog, and the shape and appearance of Herzog’s design “is identical in all material respects” to the claimed design (Ans. 3).

Accordingly, we determine from this record that the issue in this appeal is as follows: Has the Examiner established a factual basis to support the conclusion that the claimed design is identical in all material respects to the design of Fig. 4 of Herzog?

We determine that the Examiner has not met the initial burden of establishing a prima facie case of anticipation, and thus we REVERSE the sole ground of rejection presented in this appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons that follow.

OPINION

It is well settled that the Examiner bears the initial burden of establishing a prima facie case of unpatentability, whatever the ground of rejection. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). In design patent applications, a prior art reference “must be identical in all material respects” to constitute an anticipation of the claimed design. *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1461 (Fed. Cir. 1997). Anticipation is a question of fact. *See In re Paulsen*, 30 F.3d 1475, 1478 (Fed. Cir. 1994).

Appellants have presented comparisons of Fig. 1 of Herzog (allegedly identical to Fig. 4 of Herzog) with Fig. 8 of the present application, finding differences between the two designs (Br. 7). The Examiner has not presented any comparisons nor made any factual findings regarding any

identical portions or similar portions of the prior art and claimed designs (Ans. 3-4). The Examiner has presented conclusions that the claimed and prior art designs are “virtually identical,” an average observer would “perceive no distinction,” and the shape and appearance of the designs are “identical in all material respects” (Ans. 3). However, these conclusions do not appear to be based on any factual findings. Accordingly, on this basis alone, we cannot sustain the Examiner’s rejection.

Additionally, we determine that the claimed design (e.g., Fig. 8) and the design of Herzog (Fig. 1 or Fig. 4) are made up of many repeating segments directed to the left and right to make up the braid, such as the one labeled in parts as H₁ and H₂ in Herzog Fig. 1 on page 7 of the Brief. In our opinion, the segments disclosed by the designs of Herzog contain two straight lines, with the end of each straight line connected by a curved line. This is contrasted with the segments disclosed in the Figures of this application, where all three lines making up each segment appear curved to some extent (*see* Br. 3 and 7; *see especially* the line denoted as “B” in Fig. 8 reproduced on Br. 7). Accordingly, we determine that the designs disclosed by Herzog are not identical in all material respects to the claimed designs. Therefore, we cannot sustain the Examiner’s rejection of the sole design claim under § 102(b) as anticipated by Herzog.

The decision of the Examiner is REVERSED.

REVERSED

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