

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* WILLIAM P. APPS

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Appeal 2008-4778  
Application 11/389,832  
Technology Center 3700

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Decided: December 04, 2008

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Before DEMETRA J. MILLS, ERIC GRIMES and FRANCISCO C. PRATS, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 involving claims to a tray for carrying bottles, which the Examiner has rejected based on obviousness-type double patenting. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

**STATEMENT OF THE CASE**

Claims 1-13 are pending and on appeal. Claims 1 and 10 are representative and read as follows:

1. A low depth tray for bottles, comprising:
  - a first pair of opposed walls;
  - a second pair of opposed walls attached to the first pair of opposed walls to form a wall structure;
  - a base attached to the wall structure;
  - at least one interior column projecting upwardly within the wall structure, the at least one interior column having a height less than the height of bottles loaded in the tray; and
  - a plurality of interior divider walls which project upwardly from the base and extend between the at least one column and the wall structure, the divider walls having a double-walled construction, wherein the divider walls, the at least one interior column, the base, and the wall structure define a plurality of bottle retaining pockets, each pocket including at least one divider wall and sized to receive a single bottle therein.
10. The tray according to claim 1, wherein each of the second pair of opposed walls includes a handle, each handle including a cutout portion formed adjacent to the base, and a slot formed above the cutout portion, such that a user's fingers can be inserted into the cutout portion and through the slot in a palm-up orientation, and into the slot and through the cutout portion in palm-down orientation.

The Examiner has rejected claims 1-13 for obviousness-type double patenting based on the claim of either of two design patents: Apps '756<sup>1</sup> or Apps '417.<sup>2</sup>

*Issue*

Appellant contends that a “two-way test” should be applied – “[t]hat is, the claims of the utility application must be an obvious variation of the

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<sup>1</sup> Apps, U.S. Patent D485,756 S, issued Jan. 27, 2004.

<sup>2</sup> Apps, U.S. Patent D465,417 S, issued Nov. 12, 2002.

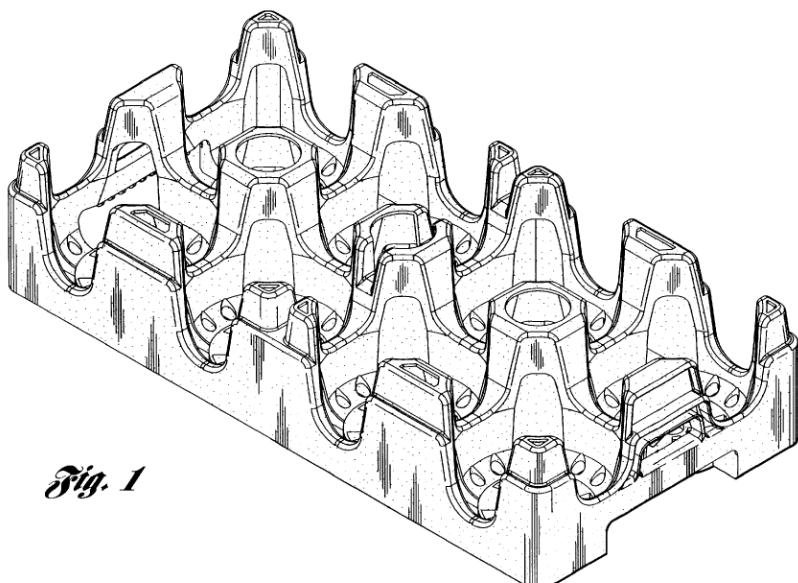
subject matter of the design patent, and the claims of the design patent must be obvious in view of the claims of the utility application” (Appeal Br. 3) – and that neither prong of the two-way test is satisfied here (*id.* at 4-5).

The Examiner’s position is that “the open language equates to claim 1 including all of the claimed disclosure of the present invention so that there is no difference present between the claims or disclosure of the design patents and the present utility patent application. Therefore, claims 1-13 anticipate the design patents and the design patents are not patentably distinct from claims 1-13” on appeal (Answer 4-5).

The issue with respect to this rejection is: Did the Examiner err in concluding that the claims on appeal are obvious variants of the design claimed in Apps ‘756 and Apps ‘417, and vice versa?

*Findings of Fact*

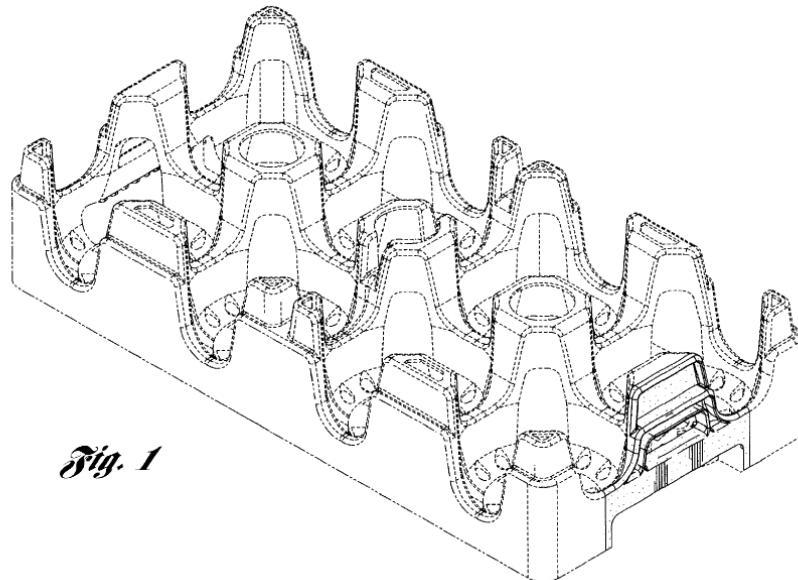
1. Apps ‘417 claims an “ornamental design for a stackable low depth tray, as shown and described” (Apps ‘417, claim).
2. Figure 1 of Apps ‘417 is reproduced below:



The figure shows a rectangular tray having, among other features, a base with a four-by-two configuration of roughly circular indentations separated from each other by low barriers or walls. The outer walls of the tray include portions that are higher than the walls separating the indentations. Four of these higher portions are at the corners of the tray; the longer sides have three higher portions aligned with the low barriers separating the indentations, and the shorter walls have a single higher portion that also includes a handle. The higher portions of the outer walls are separated by portions that are curved at the bottom and lower than the low barriers separating the indentations. In the middle of the tray, at each intersection of four low barriers between indentations is a hollow pillar that is roughly as tall as the higher portions of the outer walls of the tray.

3. Apps '756 claims an "ornamental design for handle portion for stackable low depth crate, as shown and described" (Apps '756, claim).

4. Figure 1 of Apps '756 is reproduced below:



The figure shows a rectangular tray identical to that of Apps ‘417 except that the entire tray is shown in broken lines except for the handle portion on the shorter outer wall. Apps ‘756 states that the part of the design shown in broken lines is “not part of the claimed design” (Apps ‘756, Description).

*Principles of Law*

“In the prosecution of a patent, the initial burden falls on the PTO to set forth the basis of any rejection, i.e., a *prima facie case.*” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007).

“Obviousness-type double patenting is a judicially created doctrine grounded in public policy, which prevents the extension of the term of the original patent via the patenting of an obvious variation. Under obviousness-type double patenting, a patent is invalid when it is merely an obvious variation of an invention disclosed and claimed in an earlier patent by the same inventor.” *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1326 (Fed. Cir. 1999).

“The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents.” *In re Dembiczak*, 175 F.3d 994, 1002 (Fed. Cir. 1999). “In these cases, a ‘two-way’ test is applicable. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that ‘the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa.’” *Id.*, quoting *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983).

“In the design patent context, the ultimate inquiry under section 103 is . . . whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design.”

*Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

“The first step in the [obviousness] analysis, when the subject is design, is whether there is ‘a reference to something in existence, the design characteristics of which are basically the same as the claimed design, in order to support a holding of obviousness.’” *L.A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

#### *Analysis*

The Examiner’s rejection is proper only if the claims on appeal define an obvious variant of the design claimed in either Apps ‘417 or Apps ‘756, *and* the design claimed in Apps ‘417 or Apps ‘756 is an obvious variant of the tray defined by the claims on appeal.

Apps ‘756 claims the ornamental design for a tray handle. The Examiner has not adequately shown that the tray-handle design claimed in Apps ‘756 is an obvious variant of the tray *per se* defined by the claims on appeal. Even claim 10, which recites various features of a tray handle, defines a tray that includes handles rather than the handle itself.

Apps ‘417 claims the ornamental design for a tray but the Examiner has not adequately shown that the design claimed in Apps ‘417 would have been obvious based on the claims on appeal. Claim 1, the only independent claim on appeal, defines a “low depth tray for bottles,” comprising a base and two pairs of opposed walls, “at least one interior column projecting upwardly within the wall structure,” and a plurality of bottle retaining pockets formed

by the base, walls, interior column, and “interior divider walls which project upwardly from the base and extend between the at least one column and the wall structure.”

The Examiner has not adequately explained why the very broad limitations of claim 1 would have suggested the very specific design claimed in Apps ‘417. Among other differences,

- claim 1 requires only “a plurality” of bottle retaining pockets, while the design in Apps ‘417 has eight pockets arranged in a four-by-two configuration;
- claim 1 requires only a single interior column, while the design in Apps ‘417 has three columns;
- claim 1 requires only two pairs of opposed walls attached to a base, while the design in Apps ‘417 includes walls that have high portions alternating with low, curved portions; and
- claim 1 requires only “interior divider walls,” while the design in Apps ‘417 has divider walls intermediate in height between the higher and lower portions of the outer walls.

We can assume for the sake of argument that the Examiner correctly found that the instant claims encompass the design claimed in Apps ‘417. Even so assuming, however, a rejection for obviousness-type double patenting is proper here only if the design patent claim is also obvious in view of the utility patent claims. The Examiner has not adequately explained why that is the case. The Examiner’s observation that the “drawings of the design patents and utility patents are identical” (Answer 5) does not settle the

Appeal 2008-4778  
Application 11/389,832

issue, since obviousness-type double patenting is based on the claims, not the disclosures, of the patent and application at issue.

#### CONCLUSIONS OF LAW

The Examiner has not established that the ornamental design claimed in Apps '417 or Apps '756 is an obvious variant of the tray defined by the claims on appeal.

#### SUMMARY

We reverse the rejection of claims 1-13 for obviousness-type double patenting based on the claims of Apps '417 and Apps '756.

#### REVERSED

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