

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER BERTOLINI

Appeal No. 96-3571
Application 29/021,754¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, LYDDANE
and MEISTER, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 22, 1994.
According to appellant, this application is a continuation-in-
part of Application 29/003,430, filed January 6, 1993, now
Patent No. D-348,395, issued July 5, 1994.

Appeal No. 96-3571
Application No. 29/021,754

This is a decision on an appeal from the examiner's refusal to allow the following design claim:

The ornamental design for a jar as shown and described.

The jar design is depicted in a perspective view in Figure 1 of the drawings, in a front elevational view in Figure 2, in a right side elevational view in Figure 3, and in top and bottom plan views in Figures 4 and 5, respectively.

The following references are relied upon by the examiner as evidence of obviousness in rejecting appellant's design claim under 35 U.S.C. § 103:

The Vaseline® Pure Petroleum Jelly jar (hereinafter, Vaseline® jar) depicted in the photographs filed with appellant's Information Disclosure Statement (Paper No. 3, dated January 30, 1995), which appellant admits to have been on sale prior to January 1993.

Kipperman et al.
(Kipperman)

Des. 318,620

July 30, 1991

Appeal No. 96-3571
Application No. 29/021,754

A new reference relied upon by this panel of the Board of Patent Appeals and Interferences in a new ground of rejection pursuant to the provisions of 37 CFR § 1.196(b) is:

Bertolini

Des. 348,395

July 5, 1994

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over the Vaseline® jar design in view of Kipperman.

Rather than reiterate the examiner's statement of the rejection and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 2 through 7 of the examiner's answer and to pages 4 through 7 of the appellant's brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's claimed design, to the designs of the applied prior art references, and to the respective views on the issue of obviousness advanced by the appellant in the brief and by the examiner in the answer. As a result of our evaluation of all the evidence before us, it

Appeal No. 96-3571
Application No. 29/021,754

is our conclusion that a designer of ordinary skill would not have derived appellant's claimed design from a consideration of the designs portrayed in the applied references. Thus, we cannot sustain the examiner's rejection of the design claim under

35 U.S.C. § 103. However, we do make a new rejection of the design claim pursuant to the provisions of 37 CFR § 1.196(b). Our reasoning for these determinations follows.

In determining the patentability of a design under 35 U.S.C. § 103, the proper standard is whether a design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See Avia Group Int'l, Inc. v. L.A. Gear Calif., Inc., 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1554 (Fed. Cir. 1988); In re Nalbandian, 661 F.2d 1214, 1215, 211 USPQ 782, 783 (CCPA 1981). Additionally, to support a holding of obviousness there must be a reference, something in existence, the design characteristics of which are basically the same as the claimed design. Once a reference meets the

Appeal No. 96-3571
Application No. 29/021,754

test of a basic design reference, features may reasonably be interchanged with or added from those in other pertinent references. See In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996); In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

While we agree that the Vaseline® jar design possesses design characteristics which are basically the same as appellant's claimed design, thus meeting the requirements of a "Rosen" reference and that the appearance of certain ornamental features in the Kipperman design would have suggested the application of those features to the Vaseline® jar design, we cannot agree with the examiner that it would have been obvious to a designer of such jars having ordinary skill to modify the Vaseline® jar by selecting only the arcuate configuration shown by Kipperman for the top edge of the front and rear of the jar base as proposed by the examiner in the rejection of the claimed design. It is our view that such a designer of ordinary skill would have necessarily incorporated the oval configuration of the jar body (as depicted in the perspective view of Figure 1 and the top and bottom plan views of Figures 4 and 5 of Kipperman) along with

Appeal No. 96-3571
Application No. 29/021,754

the arcuate configuration of the top edge of the front and rear of the base in modifying the design features of the Vaseline® jar.

Clearly, the jar design resulting from such modification would not include the features of appellant's claimed design including side portions having the "'squared-off' segment" as argued by appellant on pages 5 and 6 of the brief and as depicted in Figures 1 and 3 of appellant's drawings. Thus, even though we agree that it would have been obvious to the designer of ordinary skill to incorporate features of Kipperman into the Vaseline® jar design, the jar resulting from such modification would not have the overall appearance of appellant's claimed design. Consequently, it is our opinion that a designer of jars having ordinary skill would not have found the overall appearance of appellant's claimed jar design to have been obvious from a consideration of the design characteristics of the Vaseline® jar design and the Kipperman design.

Thus, we cannot sustain the examiner's rejection of the design claim under 35 U.S.C. § 103.

Appeal No. 96-3571
Application No. 29/021,754

We make the following new rejection pursuant to the provisions of 37 CFR § 1.196(b).

The design claim is rejected under the judicially created doctrine of obviousness-type double patenting in view of the design claim of Design Patent No. 348,395 to Bertolini. While the claimed design of Bertolini differs from the instant design claim in that the former includes the upper portion of the jar and a cap for the jar as part of the overall design, the claimed design on appeal would have been obvious, within the meaning of 35 U.S.C. § 103, in view of the lower portion of the jar of the design of Bertolini, which portion is identical in overall appearance to appellant's claimed jar design. While the claimed design on appeal is not identical in overall appearance to the combined jar and cap design of Bertolini, it is our opinion that the designer of ordinary skill in the art would have found the overall appearance of the design of the jar portion to be obvious therefrom by merely removing the cap and portion of the jar covered thereby.

Appeal No. 96-3571
Application No. 29/021,754

A properly filed terminal disclaimer would overcome this new ground of rejection on obviousness-type double patenting.

Accordingly, the decision of the examiner rejecting the design claim under 35 U.S.C. § 103 is reversed, and a new rejection of the design claim has been made on the ground of obviousness-type double patenting pursuant to the provisions of 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of showing of facts not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

Appeal No. 96-3571
Application No. 29/021,754

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)

REVERSED - 37 CFR § 1.196(b)

Harrison E. McCandlish, Senior)	
Administrative Patent Judge)	
)	
)	
)	
William E. Lyddane)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
James M. Meister)	
Administrative Patent Judge)	

Appeal No. 96-3571
Application No. 29/021,754

Unilever United States, Inc.
Patent Department
45 River Road
Edgewater, NJ 07020