

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL A. HUTCHINS
and JOHN H. PASCALOFF

Appeal No. 97-3183
Application 29/046,917¹

HEARD: June 8, 1998

Before COHEN, MEISTER and FRANKFORT, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the following design claim:

The ornamental design for a surgical saw blade hub as shown and described.

The references relied upon by the examiner are:

¹ Application for patent filed November 21, 1995.

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Walen	Des. 343,247	Jan. 11, 1994
Goris	Des. 362,065	Sep. 5, 1995
Mongeon	4,386,609	Jun. 7, 1983

The claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Goris in view of Walen and Mongeon. This rejection is explained on page 3 of the answer.

Reference is made to pages 2-6 of the brief and pages 4-10 of the answer for the arguments of the appellants and examiner in support of their respective positions.

OPINION

Having carefully considered the respective positions advanced by the appellants in the brief and the examiner in the answer, it is our conclusion that the references relied on by the examiner fail to establish the obviousness of the design claim on appeal within the meaning of 35 U.S.C. § 103.

The test for determining obviousness of a claimed design under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. *In re Carter*, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982) and *In re Nalbandian*, 661 F.2d 1214,

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1216, 211 USPQ 782, 784 (CCPA 1981). The appellants' design lies in the realm of designers of surgical saw blade hubs.

In order to support a holding of obviousness under section 103, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references. *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Although we agree with the examiner that Goris can be considered a *Rosen* reference, we do not believe that a combined consideration of Goris, Walen and Mongeon establishes the obviousness of the appellants' design. In particular, we observe that the claimed design has a large V-shaped cut-out wherein the sloping sides that define the *v* intersect with the curved outer periphery of the hub in such a manner so as to form a *sharp edge*. The examiner, by stating on page 3 of the answer that the claimed design differs from Goris, *inter alia*, by *a v-shaped opening extending to its outer periphery,* appears to recognize that Goris fails to teach or suggest such a feature and, in an effort to overcome this deficiency, relies on the teachings of Walen.

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In Walen, however, the sloping sides which define the cut-out do not intersect the curved outer periphery of the hub at all. Instead, Walen's sloping sides intersect a horizontal surface of significant extent that in turn intersects with the curved outer periphery of the hub, thus giving the end of the hub of Walen a significantly **truncated** appearance vis-à-vis the end of the hub in the claimed design. In our view, the large V-shaped cut-out in the end of the hub of the claimed design, wherein the sloping sides that define the **V?** intersect with the curved outer periphery of the hub in such a manner so as to form a **sharp edge**, creates a distinctive overall appearance that is not suggested by the relied on prior art.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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) BOARD OF PATENT
JAMES M. MEISTER)
Administrative Patent Judge) APPEALS AND

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) INTERFERENCES
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