

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOJI NAGASHIMA

Appeal No. 98-0068
Application 29/030,090¹

HEARD: May 5, 1998

Before COHEN, FLEMING and HANLON, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

¹ Application for design patent filed October 20, 1994.

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DECISION ON APPEAL

This is an appeal from the final rejection of the following design claim:

The ornamental design for an AUTOMOBILE as shown and described.

As described in the specification (page 2), Figures 1 through 7 correspond to perspective right side, perspective right side,² rear, perspective left side, front, rear, and top views, respectively, of the claimed automobile design.

As evidence, the examiner has applied the document specified below:

Autocar & Motor, "BMW carves a new benchmark," November 3, 1993, pages 36, 37.

The following rejection is the sole rejection before us for review.

² The description of Figure 2 in the specification is inconsistent with the portrayal of the automobile in Figure 2. The showing in Figure 2 is not a right side perspective view, but simply a right side view. The description in the brief (page 2) correctly describes Figure 2 as a right side view.

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The design claim stands rejected under 35 U.S.C. § 102(a) as being anticipated by the Autocar & Motor reference. As stated by the examiner (Paper No. 5; page 2, paragraph 5):

Despite the presence of minor differences, the automobile shown in the Autocar & Motor article is seen as of substantially the same appearance as the claimed design in the eyes of the ordinary viewer, thus precluding patentability.

The full text of the examiner's response to the argument presented by appellant appears in the answer (Paper No. 16), while the complete statement of appellant's argument can be found in the brief (Paper No. 12).

OPINION

In reaching our conclusion on the anticipation issue raised in this appeal, this panel of the board has carefully considered appellant's specification, Figures 1 through 7, and design claim, the design shown in the applied reference, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

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We are constrained to reverse the rejection on appeal. Simply stated, this panel of the board shares the argued view of appellant (brief, pages 6 and 7) that the applied reference is deficient in that it fails to display the rear view and top views of the automobile design, thereby preventing us from assessing the reference automobile design as a whole. Our full analysis follows.

With respect to the rejection of a design claim as being anticipated, an ordinary observer test is applicable for determining the novelty of the design under 35 U.S.C. § 102. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 785 (CCPA 1981). As to the particular test for the novelty of a design, the court in In re Bartlett, 300 F.2d 942, 943-44, 133 USPQ 204, 205 (CCPA 1961) set forth (in quoting from Shoemaker, Patents for Designs, page 76):

If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, novelty of design is deemed to be present. The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design.

To apply the aforementioned test, we must be able to consider each of the claimed and reference designs in their entirety. As pointed out by appellants (brief, pages 6 and 7), rear and top views are part of the presently claimed design, but the rear view and the top view of the reference design are not shown. Since portions of the overall automobile design of the reference are not shown, we cannot fairly assess the reference design relative to the claimed design. Solely for this reason, we are constrained to reverse the rejection of appellant's design claim under 35 U.S.C. 102(a).³

³ The applied reference portrays a BMW automobile and the appeal brief (page 1) informs us that the real party in interest in this design application is "Bayerische Motoren Werke AG" (BMW). The automobile shown in the reference has a license plate mounted thereon. This circumstance leads us to question whether the overall appearance of this vehicle may have been available to the public prior to appellant's invention. If publicly available, it would appear reasonable to say that other automobile periodicals may have published a more complete design showing of the automobile. Additionally, we note that appellant has argued differences between the automobile design partially shown in the applied reference and the claimed design (brief, pages 4 through 6). However, we are not certain from the record if the reference automobile (new 5-series BMW due in 1995) is a version of the same model year automobile for which design patent protection is now being sought.

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In summary, this panel of the board has reversed the rejection of appellant's design claim under 35 U.S.C. § 102(a) as being anticipated by the Autocar & Motor reference.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
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Administrative Patent Judge)	

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