

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY P. FRANKOSKI and RANDAL J. JOLITZ

Appeal No. 1998-2173
Application No. 08/829,620

HEARD: February 7, 2000

Before, COHEN, McQUADE and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

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

The ornamental design for a hip and ridge cover as shown and described.

We REVERSE.

The hip and ridge cover design is depicted in perspective

Appeal No. 1998-2173
Application No. 08/829,620

view, top view, right side view, left side view, front end
view,

back end view and bottom view in Figures 1 through 7 respec-
tively, with Figure 1 being the most representative when
evaluating the examiner's rejection.¹

The references applied by the examiner are:

| | | |
|----------|-----------|----------|
| Bird | 1,153,418 | Sep. |
| 14, 1915 | | |
| Olsen | 2,009,812 | Jul. 30, |
| 1935 | | |

The design claim stands rejected under 35 U.S.C. § 103 as
being unpatentable over Bird in view of Olsen.

The full text of the examiner's rejection and the
responses to the arguments presented by appellants appear in
the final rejection (Paper No. 16, mailed July 30, 1997) and
the answer (Paper No. 19, mailed March 19, 1998), while the

¹ Figures 2 through 8, as originally filed on September 22, 1994, have
been renumbered as Figures 1 through 7, respectively, and the figure
originally numbered Figure 1 has been canceled (see Paper No. 6). All
references in this decision to appellants' drawings refer to the drawings as
amended by Paper No. 6.

Appeal No. 1998-2173
Application No. 08/829,620

complete statement of appellants' arguments can be found in the brief (Paper No. 18, filed January 2, 1998).

OPINION

We begin our analysis by pointing out that the standard for evaluating the patentability of a design is whether it would have been obvious to a designer of ordinary skill in the art involved. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). In rejecting a claim to an ornamental design under 35 U.S.C. § 103, the examiner must supply a primary or basic reference that bears a substantially identical visual appearance to the claimed design. In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed Cir. 1993). That is, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design; once a reference meets this test, reference features may reasonably be interchanged with or added from those in other pertinent references. In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The examiner concluded that Bird constitutes a sufficient

Appeal No. 1998-2173
Application No. 08/829,620

"Rosen" reference. The appellants argue that Bird does not. We need not consider this issue, however, because even assuming that Bird is a sufficient "Rosen" reference which discloses essentially the same basic design as that of the appellants, we reject the examiner's position that an ordinary designer would have been motivated to provide the exposed surface of the shingle disclosed by Bird with light and dark areas in view of the teaching of Olsen.

The appellants' design is for a roofing hip and ridge cover which includes the ornamental appearance of a rectangular upper layer and a lower layer approximately half the size of the upper layer. As shown in appellants' Figures 1 and 2, the upper surface, i.e., the surface of the hip and ridge cover exposed to view when installed on a roof, has the appearance of light and dark areas of comparable size. The upper and lower layers create the visual impression of a pair of coplanar edges of comparable length having squared off corners and a visible break line between the upper and lower layers.

It is the examiner's position that the only significant

Appeal No. 1998-2173
Application No. 08/829,620

difference between the Bird shingle and the claimed design is that the "showface is divided into two equal sections of lighter and darker areas" (final rejection, page 2). The examiner describes Figure 1 of Olsen as teaching a shingle having an exposed surface divided into two equal sections of light and dark areas and takes the position that

[i]t would have been obvious to . . . provide the roofing element of Bird with a showface that is divided into two equal sections of lighter and darker areas. (Final rejection, page 2)

Appellants argue that the shading shown in Figure 1 of Olsen is not indicative of shingle color or light and dark areas, but merely illustrates a coating of asphalt and slate granules applied over the butt end of the shingle.

Based on our review of Olsen, we find appellants' argument to be well taken. Olsen teaches a shingle composition comprising a mixture of mica and asphalt. The shingle is described as having a tapered construction with a butt end **2** exposed to the weather and a thin end **3**. The butt end may be coated with a layer of asphalt **5** and a layer of slate granules **6** of desired size and color (page 1, left-hand

Appeal No. 1998-2173
Application No. 08/829,620

column, lines 29-37 and right-hand column, lines 38-42). Olsen does not describe the butt end **2** of the shingle, i.e., the end having the asphalt and granule coating, as being darker in color than the thin end **3**. When viewed in the context of Olsen's description of the invention, it appears that the Figure 1 depiction actually portrays a difference in texture between the uncoated thin end **3** and the coated butt end **2**, not a difference in color as suggested by the examiner. Thus, even if a designer of ordinary capability in the art would have been motivated to apply an asphalt and granule coating to half of the exposed face of the shingle taught by Bird, it is not a certainty that the resulting shingle would have had an exposed face with light and dark areas as claimed by appellants.

We also agree with appellants' argument that Bird and Olsen do not collectively teach or suggest the appearance of a two-layered shingle, including upper and lower layers having a pair of coplanar edges of comparable length presenting a squared off appearance and a visible break line between the upper and lower layers (answer, pages 13 and 14) as seen in

Appeal No. 1998-2173
Application No. 08/829,620

the claimed design. We do not view the differences between the claimed design and the applied prior art to be "de minimis."

Since the applied prior art fails to teach or suggest the aesthetic features of the claimed design, we will not sustain the standing 35 U.S.C. § 103 rejection based on Bird and Olsen.

The decision of the examiner is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
| |) | |
| |) | |
| JOHN F. GONZALES |) | |
| Administrative Patent Judge |) | |

vsh

Appeal No. 1998-2173
Application No. 08/829,620

Christopher R. Benson
Arnold, White & Durkee
P.O. Box 4433
Houston, TX 77210