

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT J. FRATTAROLA

Appeal No. 1999-1013
Application No. 29/014,141

HEARD: DECEMBER 11, 2002

Before GARRIS, FRANKFORT, and SAADAT, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim:

The ornamental design for a captive screw as shown.

The captive screw design claimed by the appellant may be described as comprising three major sections. These three sections include an upper cylindrical knob which may be smooth or knurled, a central barrel and a knurled lower end. Figures 2 and

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designs articles of this type to be mere manifestations of the same basic design, rather than characteristically different designs." Id.

In the answer, the examiner has introduced a new rejection of the appealed claim under 35 U.S.C. § 103 "as being unpatentable over the Southco Fastener at the top right corner of Page C-7 (note the fastener at the bottom right corner of the picture), in view of the Molina patent." Id. On pages 3 and 4 of the answer, the examiner expresses his conclusion of obviousness in the following manner:

The only difference between the claimed design and the prior art is that the claimed design has vertical knurled ribs on the bottom shank portion.

The secondary Molina patent reference 4,975,007 is cited for showing the conventionality of the vertical knurled ribs on the shank portion of a captive screw. Note feature number 35 in the drawings.

It would have been obvious to one of ordinary skill in the art to have provided the basic Southco reference retractable captivescrew with a vertically ribbed shank or bottom portion in view of what the Molina captive screw shows and suggests. Moreover, the combination of references would have resulted in an overall appearance strikingly similar to the claimed design and no patentable ornamental advance is seen there over [sic].

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We refer to the brief and reply brief as well as to the answer and supplemental answer for a complete exposition of the respective viewpoints expressed by the appellant and by the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we cannot sustain either of the Section 103 rejections advanced by the examiner on this appeal.

The patentability of a design is determined by a consideration of the overall appearance, the visual effect as a whole of the design. In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Moreover, when a Section 103 rejection is based on a combination of references, the long standing test for a proper combination has been whether the references are so related that the appearance of certain ornamental features in one would have suggested the application of those features to the other. Rosen, 673 F.2d at 391, 213 USPQ at 350; In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA

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1956). However, if the combined teachings of the applied references would have suggested only components of the claimed design, but not its overall appearance, a conclusion of obviousness under Section 103 is inappropriate. In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663-64 (Fed. Cir. 1987).

Our application of these legal principles to the factual circumstances before us on this appeal lead to the clear determination that each of the examiner's Section 103 rejections is improper.

Concerning the Section 103 rejection based on the Southco reference alone, the examiner fully appreciates the difference in knurling between the here claimed and prior art designs but dismisses this difference as "a minor detail which does not patentably distinguish the article's overall appearance." Answer, page 3. The examiner has proffered utterly no rationale or evidence in support of this position.¹ From our perspective, the knurling on the lower end of the appellant's claimed captive screw design quite plainly impacts the overall appearance and

¹Indeed, whatever support might exist for the examiner's position is undermined by his earlier espoused position regarding a now-dropped Section 112 rejection which was based on the presence versus absence of ribs or knurling in certain figures of the originally filed drawing (see page 3 of paper no. 5).

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visual effect as a whole of the design and therefore must be taken into consideration. Rosen, 673 F.2d at 390, 213 USPQ at 349.

As for the Section 103 rejection based on the Southco reference in view of Molina, we share the appellant's view that the knurling feature in Molina would not have suggested application of that feature to the Southco design. Id., 673 F.2d at 391, 213 USPQ at 350. This is because, as correctly argued by the appellant, the Molina design does not relate to a captive screw of the type displayed in the Southco reference (or of the type here claimed). In fact, the examiner is clearly erroneous in identifying element 35 of Molina as "vertical knurled ribs on the shank portion of a captive screw." Answer, page 4. While element 35 relates to a knurl feature, it is disposed on a plug 33 rather than the shank of screw 10 (e.g., see lines 18-45 in column 3). Thus, the examiner's obviousness conclusion is inappropriate because the combined teachings of the applied references, at best, would have suggested only components of the here claimed design but not its overall appearance. Cho, 813 F.2d at 382, 1 USPQ2d at 1663-64.

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Under the circumstances recounted above, it is apparent that we cannot sustain either of the Section 103 rejections advanced by the examiner on this appeal.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MAHSHID D. SAADAT)	
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BRG:hh

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