

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte PAUL ROWAN

---

Appeal No. 2001-0466  
Application No. 29/112,628

---

ON BRIEF

---

Before KRATZ, BAHR and BLANKENSHIP, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

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

the ornamental design for a PICTURE FRAME as shown and described.

In rejecting the appealed claim under 35 U.S.C. § 103, the examiner relies upon the following two references:

(1) Burnes of Boston 1984 Catalog, p. 23, item 5552 (Burnes).

Appeal No. 2001-0466  
Application No. 29/112,628

(2) Exposures, Summer II 1991, p. 6, item A112211 (Exposures).

The appealed claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Burnes in view of Exposures.

Reference is made to the brief (Paper No. 11) and the answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

We note, at the outset, that appellant's claimed design is directed to two embodiments. The embodiment of Figures 1-3 is a picture frame design having a square<sup>1</sup> outer frame exhibiting a planar front face and a square inner frame centered within the outer frame, the inner frame also exhibiting a planar front face. A planar matting recessed from the front face of the outer frame is provided between the inner and outer frames. The embodiment of Figures 4-6 differs from the embodiment of Figures 1-3 in that the inner frame, while exhibiting a planar face, is circular rather than square.

---

<sup>1</sup> The term "square" as used in this decision denotes a plane figure having four equal sides and four right angles. Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

Appeal No. 2001-0466  
Application No. 29/112,628

The examiner has not required restriction of the design application to one of the two embodiments. Instead, the examiner considers the two embodiments to present overall appearances that are not distinct from one another and thus comprise a single inventive concept. Accordingly, both embodiments have been retained in the application (Paper No. 5, page 2).

The examiner's rejection as set forth on pages 2 and 3 of the answer is as follows:

The overall visual impression conveyed by the instant frame is held to be similar to Burnes of Boston #5552, the essential difference being the proportions of the mat versus picture area.

Exposures shows similar proportions of the mat versus picture area.

Thus it is held that it would have been obvious to a person of ordinary skill in the art at the time the article was made to modify Burnes of Boston #5552 as taught by Exposures.

Moreover, the result would be an appearance over which the claimed article possesses no patentable difference.

Appeal No. 2001-0466  
Application No. 29/112,628

The examiner's rejection overlooks an important difference between appellant's claimed design<sup>2</sup> and the Burnes picture frame. The Burnes picture frame includes inner and outer frames which are rectangular (i.e., having four sides and four right angles<sup>3</sup>) but not square, in that the height dimension is noticeably larger than the width dimension. We do not share the examiner's opinion (answer, page 4) that the difference in shape (square versus rectangular, non-square) between the claimed design and the Burnes picture frame is de minimis in nature and unrelated to the overall aesthetic appearance of the design. On the contrary, it is our opinion that this difference does affect the appearance of the claimed design as a whole and the impression that the design would make to the eye of a designer of ordinary skill. Cf. Ex parte Pappas, 23 USPQ2d 1636, 1638 (Bd. Pat. App. & Int. 1992) and In re Carter, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982).

---

<sup>2</sup> While, as discussed above, the claimed design encompasses two embodiments, the examiner's rejection focuses primarily on the embodiment of Figures 1-3 having the square inner frame.

<sup>3</sup> Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

Appeal No. 2001-0466  
Application No. 29/112,628

The Exposures picture frame also comprises rectangular inner and outer frames, which, in contrast to appellant's claimed design (Figures 1-3), are non-square. Like appellant's claimed design (Figures 1-3), the area enclosed by the inner frame appears to be about one-fourth the area of the outer frame.

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. See id. and In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). Furthermore, in order to support a holding of obviousness under § 103, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design. See In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Even assuming, arguendo, that Burnes is a Rosen type reference and further that Exposures would have suggested modification of the Burnes picture frame so as to make the area enclosed by the inner frame smaller as a proportion of

Appeal No. 2001-0466  
Application No. 29/112,628

the area enclosed by the outer frame as proposed by the examiner, such modification would not result in the claimed design. The resulting picture frame would not give the impression of square inner and outer frames (appellant's Figures 1-3) or a square outer frame and circular inner frame (appellant's Figures 4-6).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

We are cognizant of the examiner's assertions on page 4 of the answer that "[t]his simple change in proportions (the choice of square versus rectangle) is notoriously old in the picture frame art, [and] would have been obvious to one skilled in the art." However, these assertions are conclusory in nature and are not supported by any evidence supplied by the examiner in making the rejection.

Appeal No. 2001-0466  
Application No. 29/112,628

In failing to supply evidence to support the conclusion that it would have been obvious to modify the Burnes picture frame to make the inner and outer frames square so as to arrive at the claimed design, the examiner has failed to meet the burden of establishing a prima facie case of obviousness of the claimed design. Accordingly, we cannot sustain the examiner's rejection.

CONCLUSION

Appeal No. 2001-0466  
Application No. 29/112,628

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C. § 103 is reversed.

REVERSED

PETER F. KRATZ	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JENNIFER D. BAHR	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

Appeal No. 2001-0466  
Application No. 29/112,628

Perry J. Saidman, Esq.  
SAIDMAN DesignLaw Group  
1110 Bonifant Street  
Suite 510  
Silver Spring, MD 20910