

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2003-0043
Application 29/065,720

ON BRIEF

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

FRANKFORT, 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 PAPERBOARD CONTAINER as shown.

As may be seen best from Figures 1, 2, 4 and 5, appellant's paperboard container includes rectangular end panels that converge from parallel side edges of a rear or back panel toward a rectangular front panel that is of lesser width than the width

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of the rear panel. Trapezoidal top and bottom panels complete an enclosure portion of the container, and the container further includes a portion of the rear panel that extends and projects above the enclosure portion of the container to a height of about one third the height of the front panel of the enclosure portion. The projecting portion of the rear panel is also trapezoidal in configuration and includes side edges that are inclined slightly inwardly beginning at the level of the top panel of the enclosure portion and extending to the top edge of the rear panel. The rear panel has a central straight top edge that has a substantial length, i.e., a length of at least about 80% of the width of the rear panel.

As noted on page 2 of the brief, the broken line showing of eyelets adjacent the top edge of the projecting portion of the rear panel of the container "is for illustrative purposes only and forms no part of the claimed design."

The references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Smyth et al. (Smyth) Des. 275,370 Sept. 4, 1984

A photocopy of a paperboard container for Gillette Sensor for Women razor cartridges, dated 1992 (Gillette package).

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A photocopy of a front, left, top isometric view of a rectangular paperboard container supplied by appellant in the Information disclosure Statement filed May 22, 1997 (Paper No. 2) and admitted by appellant to be prior art (hereinafter, the APA)

The appealed design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over the Gillette package in view of Smyth and the APA. According to the examiner

It would have been obvious to a designer of ordinary skilled in the art at the time the invention was made to have modified the rear baseboard panel of the Gillette package by providing it with the angled side corner cuts similar to as suggested by the Smyth et al. Furthermore, to provide the relative overall proportions of the Drawing reference [the APA] to the rear panel and the front blister (enclosure) to the Gillette package would result in an article quite similar in general overall appearance of the claimed design by appellant.

The modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other (answer, pages 3-4).

Reference is made to the examiner's answer (Paper No. 11, mailed January 29, 2002) for the examiner's full reasoning in support of the above-noted rejection. Attention is directed to appellant's brief (Paper No. 10, filed October 15, 2001) for a full exposition of the arguments thereagainst.

OPINION

Having carefully considered the issues raised in this appeal in light of the applied prior art references, the examiner's remarks and appellant's arguments, it is our conclusion that the examiner's rejection of the present design claim under 35 U.S.C. § 103 is not sustainable. Our reasons for this determination follow.

In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration. See In re Rosen, 673 f.2d 288, 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. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, 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 the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent references, when such references are "so

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related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, supra; In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). If, however, the combined teachings of the applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663-64 (Fed. Cir 1987).

In the present case, appellant has not challenged the examiner's determination (answer, pages 5-6) that the Gillette package is a Rosen-type reference. Instead, appellant has urged that even if the references were combined in the manner posited by the examiner, the resulting container would not have the overall distinctly different appearance of the container claimed by appellant. More particularly, appellant has argued that the prior art references relied upon by the examiner do not reasonably teach or suggest a projecting portion of a rear panel of a paperboard container that has a configuration like that required in the claimed container design. We agree.

Even if a designer of ordinary skill who designs paperboard containers were to provide the rear panel of the Gillette package with angled side corner cuts similar to those seen on the

cassette box display holder of Smyth, as has been urged by the examiner to have been obvious, and modified the proportions of the Gillette package following the teachings of the APA, it is our view that such designer would not come up with the paperboard container design presently before us on appeal. As was noted above, in appellant's paperboard container design the trapezoidal shaped projecting portion of the rear panel has side edges that are inclined slightly inwardly beginning at the level of the top panel of the enclosure portion and extending to the top edge of the rear panel, with the rear panel having a central straight top edge that has a substantial length, i.e., a length of at least about 80% of the width of the rear panel. By contrast, the projecting portion of the cassette box display holder in Smyth that extends above a cassette box which would be carried in the window of the holder is of an entirely different configuration and provides a distinctly different aesthetic appearance.

The projecting portion of the holder seen in Smyth has side edges that are straight/vertical in the area immediately above the cassette box and then steeply angled from those straight portions to the top edge of the projecting portion. The top edge itself includes a central straight portion that is relatively short, i.e., on the order of one third the width of the rear

panel. Thus, we do not see how a designer of ordinary skill providing the projecting portion of the Gillette container with side corner cuts "similar to" those suggested in Smyth could arrive at a paperboard container having the distinct ornamental appearance of the container claimed by appellant.

In the final analysis, we are of the opinion that the collective teachings of the applied prior art would not have led the designer of ordinary skill in the art to modifications of the Gillette container which would have resulted in a container having an overall appearance and creating a visual impression like that of the paperboard container claimed by appellant. It is our view that the evidence before us considered as a whole would simply not have been suggestive of the distinct ornamental appearance of appellant's claimed container design.¹ For that reason, we will not sustain the examiner's rejection of appellant's design claim under 35 U.S.C. § 103.

¹In reaching this conclusion, we have also considered the teachings to be derived from the APA, relied upon by the examiner to provide the above modified Gillette container with overall proportions like that seen in the APA. However, the teachings of the APA do not overcome or provide for the deficiencies we have noted above in the basic combination of the Gillette package and Smyth.

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Since we have determined that the examiner has failed to establish a prima facie case of obviousness with regard to the claimed design, it follows that the decision of the examiner rejecting the claimed design under 35 U.S.C. § 103 is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
CHARLES E. FRANKFORT)	
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