

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES POMEROY
and JOHN T. BYCRAFT

Appeal No. 2004-0401
Application 29/160,956

ON BRIEF

Before WINTERS, WARREN and BAHR, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of the design claim:

The ornamental design for **CHAIR GLIDER** as shown and described, under 35 U.S.C. § 103(a) as being unpatentable over Pomeroy '599 in view of Pomeroy '340.¹

¹ The examiner states that the ground of rejection is set forth in the Office action mailed November 21, 2002 (Paper No. 3) (*see* answer, page 3). Pomeroy '599 is United States Design Patent 417,559, and Pomeroy '340 is United States Design Patent 410,340, both to Pomeroy et al. (*see* answer, page 2).

In order to establish a *prima facie* case of obviousness of the claimed design, the examiner must provide “a reference, a something in existence, the design of which is basically the same as the claimed design,” *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982), which can be combined with other teachings of the prior art by a designer of ordinary skill who designs articles of the type involved, in order to modify the design of the primary reference to create a design that has the same overall visual appearance as the claimed design. *See generally, In re Borden*, 90 F.3d 1570, 1574-75, 39 USPQ2d 1524, 1526-27 (Fed. Cir. 1996); *In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993); *Rosen*, 673 F.2d at 390-91, 213 USPQ at 349-50. In order to combine the prior art designs, there must be some suggestion in the prior art to modify the basic design of the primary reference with the features from the design in a secondary reference; the suggestion is provided where the design of the secondary reference is so related to the design of the primary reference that the appearance of certain ornamental features in the design of the secondary reference would have suggested the application of the features to the design of the primary reference. *See Borden* and cases cited therein, 90 F.3d at 1574-75, 39 USPQ2d at 1526-27. However, where a major modification would be required to make the design of the primary reference have the same overall appearance of the claimed design, the design of the primary reference “cannot qualify as a basic design.” *Harvey*, 12 F.3d at 1063, 29 USPQ2d at 1208. In other words, the modification of the “basic design” of the primary reference necessary to achieve the claimed design cannot destroy the fundamental characteristics of the “basic design” of the primary reference. *Rosen*, 673 F.2d at 391, 213 USPQ at 350.

The examiner concedes that significant modifications are necessary to the design of Pomeroy ‘559 by stating that it would have been obvious to one of ordinary skill in the art “to modify the armrests of glider chair of [Pomeroy ‘559] so as to have the *same armrests* as taught in the glider of” Pomeroy ‘340 (Paper No. 3, page 2; emphasis supplied). In our view, appellants accurately describe, physically, the “arm supports of the glider chair . . . [of Pomeroy ‘559 as] an upside-down U-shape,” and those of Pomeroy ‘340 as “arm supports that begin at the back of the loveseat, extend across the entire seat portion, then downwardly towards the feet of the loveseat, across the bottom, and then up to near the starting position . . . creating this near-loop” (brief,

page 6). Appellants further describe the overall visual appearance of the “glider chair” of Pomeroy ‘559 as “a clean, seat-dominated image,” and that of the “loveseat-type glider” of Pomeroy ‘340 as having “a sturdy appearance . . . dominated by the seat” (*id.*). Appellants describe the overall visual appearance of the claimed design as “a chair that is sturdy where the arm supports dominate” (*id.*). In the answer, the examiner agrees that “the glider of [Pomeroy ‘559] . . . does not have the same broken loop armrest as in the present design,” but maintains that when modified with Pomeroy ‘340, “the result would be a chair with a sturdy look wherein the arm supports dominate the image as in the claimed design” (answer, pages 3-4).

We find that each “upside-down U shape” arm support of Pomeroy ‘559 visually interacts with the single chair in two places: a point on the forward end of the seat; and a point on the lower end of the back. We further find that each “near-loop” arm rest of Pomeroy ‘340 visually interacts with the loveseat chair in three places: a point on the forward end of the seat; a point at the middle of the back; and at a length on the lower end of the back. We determine that the visual overall appearance to which the arm supports contribute in each instance supports appellants’ position that the overall visual appearance of the “loveseat-type glider” of Pomeroy ‘340 has “a sturdy appearance” vis-à-vis “a clean . . . image” of Pomeroy ‘559 in the “seat dominated” glider chair designs in these references..

On this record, we are of the opinion that the examiner’s finding that it is necessary to *entirely* replace the “upside-down U shape” arm support of Pomeroy ‘559 with the “near-loop” arm rest of Pomeroy ‘340 in order to create the same overall visual appearance of the claimed chair glider design, constitutes evidence of a major modification of the “basic design” of Pomeroy ‘559 that destroys the fundamental characteristics of that design. In other words, even upon casual observation, the arm support shown in the claimed design of Pomeroy ‘559 is an integral characteristic of the overall visual appearance of that glider chair design as a whole which would materially change in a fundamental way if the arm support is replaced with that of Pomeroy ‘340 as the examiner proposes.

Thus, we find that Pomeroy ‘559 does not provide “a basic design” necessary to establish a *prima facie* case of obviousness, and accordingly, we reverse the ground of rejection.

The examiner's decision is reversed.

Reversed

SHERMAN D. WINTERS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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