

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** STEPHEN J. DAVIS

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Appeal No. 1995-4961  
Application No. 29/014,077

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HEARD: OCTOBER 15, 1997

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Before FLEMING, PAK, and NASE, **Administrative Patent Judges**.

PAK, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of the sole claim in a patent application for the ornamental design of a squash racquet depicted in Figures 1 through 3 in the application.



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the same' as the claimed design." ***In re Harvey***, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993); ***In re Rosen***, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). The examiner must then explain why the difference, if any, between the prior art design and the design for which patent protection is sought would have been obvious to, or would have been seen as ***de minimis*** by, the ordinary designer. ***In re Carter***, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982); ***In re Nalbandian***, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). In assessing obviousness, the design involved must be considered as a whole viewed from the perspective of the designer of ordinary skill of the articles involved. ***Rosen***, 673 F.2d at 391, 213 USPQ at 349.

The examiner states (Answer, page 3) that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the basic reference racquet [described in Gagon] without a throat piece and to have strung the racquet into the throat as shown and suggested by the ancillary Carlton and page 78 Tennis magazine references. Moreover, said modification would have resulted in an overall appearance strikingly similar to the claimed design and no patentable ornamental advance is seen thereover.

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We find, however, that Gagon does not constitute "a basic reference," for it fails to illustrate "design characteristics which are basically the same as the claimed design." In that regard, we note that the tennis racquet shown in Gagon has a head defining a round stringing design, rather than the claimed tear drop stringing design. The round stringing area is formed by providing a throat piece that is not present in the claimed squash racquet design. In addition to these significant differences in overall appearance, the examiner has not viewed the tennis racquet described in Gagon from the perspective of the designer of ordinary skill of the articles involved. See Answer, page 4. According to appellant, the Rule 132 declaration of Davis and testimony of Mr. Maxton and Mr. Morgan establish that the tennis racquet illustrated in Gagon would not have been viewed in the same manner as the examiner from the perspective of the designer of ordinary skill. See Brief, pages 10-15. The examiner, however, improperly ignores such evidence without explaining the deficiency of the declaration and testimony. See Answer, page 4. Therefore, we conclude that the examiner has not established a **prima facie** case of obviousness. Accordingly, we reverse the examiner's § 103 rejection of the sole claim in this application.

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**REMAND**

We remand this application to the examiner for appropriate action. Our review of the record indicates that the *French Pim Pam set* (1900) and a patent drawing designated as 990394 submitted by appellant appear to illustrate a racquet having "design characteristics which are basically the same as the claimed design." Upon return of this application, the examiner is to determine whether these drawings, together with Carlton and Fischer, would have rendered the claimed subject matter **prima facie** obvious.

Once the examiner determines that the claimed subject matter would have been **prima facie** obvious in view of the prior art mentioned above, the examiner must also determine whether it is rebutted by the secondary evidence proffered by appellant. In this regard, we note that as a rebuttal to the **prima facie** case of obviousness, appellant relies on declarations of Peter Maxton, Timothy Mott, Christopher Charles Hughes, Robert B. Smith, and Stephen Davis, and testimony and statements given in a trial or before a trial. See, e.g., Brief, pages 10-14 and 16-28. The declarations and testimonies are relied upon to show commercial success, copying by others and the perspective of the designer of

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ordinary skill in the articles involved. **Id.** Appellant also refers to specific portions of evidence and declarations to support his positions. **Id.** The examiner has not specifically responded to many of these arguments. See Answer in its entirety. Nor has the examiner made adequate factual analyses on the sufficiency of these declarations and other factual evidence relied upon by appellant. **Id.**

In addressing the sufficiency of each and every evidence relied upon by appellant, the examiner must keep in mind that appellant has the burden of supplying sufficient proof to establish his position. To establish commercial success, for example, appellant must provide sufficient proof to demonstrate that the claimed squash racquet is commercially successful and the sales are directly resulted from the merits of the claimed subject matter. **See In re Huang**, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689-90 (Fed. Cir. 1996). To establish copying by others, appellant must demonstrate that there was a widespread acceptance and adoption of the claimed subject matter and a nexus between the adoption and the merits of the claimed subject matter. **See Cable Electric Prods. v. Genmark, Inc.**, 770 F.2d 1015, 1028, 226 USPQ 881, 889 (Fed. Cir. 1985).

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### **CONCLUSION**

In view of the foregoing, the examiner's § 103 rejection is reversed and this application is remanded to the examiner to review the prior art discussed above to determine the existence of a **prima facie** case of obviousness and, if present, make adequate factual analyses on the sufficiency of the secondary evidence of record, including all of the declarations, testimonies and statements, relied upon by appellant to determine whether the **prima facie** case is rebutted.

This application, by virtue of its "special" status requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., Rev. 1, Feb. 2000). It is important that the Board be promptly informed of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***REVERSED/REMANDED***

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

CKP:hh

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