

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.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 HOWARD S. LEIGHT

Appeal No. 96-3568
Application 29/009,122¹

ON BRIEF

Before GARRIS, HAIRSTON and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed June 3, 1993.

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DECISION ON APPEAL

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

The ornamental designs for Cap For Banded Earplug as shown and described.

The invention is directed to the ornamental design of a cap that, as seen in Figures 1 and 3 of the application,² lies at an end of a banded ear plug. As noted in appellant's specification, the broken line showing of the banded ear plug is for illustrative purposes only and forms no part of the claimed design. As explained on page 2 of the brief,

the cap has a front half forming a small convex bump which is greatly rounded. The cap has a larger diameter rear that looks like the outside of a donut, with gently rounded front and rear end portions. The gently rounded rear end enhances the appearance, because the phantom lines indicating a band end, show that much of the rear is exposed.

The sole reference relied upon by the examiner is:

² New formal drawings were filed by appellant on October 24, 1994 (Paper No. 3) and include figures numbered as Fig. 1 through Fig. 4.

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Saito

D-269,611

July 5, 1983

The appealed design claim stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Saito.

According to the examiner (answer, page 3), the claimed design's gentle convex curves at the front and rear, versus the prior art's sharp cut-offs at the front and rear, are not believed to be different enough to make them patentably distinct from each other. The examiner goes on to indicate that the differences are deemed to be minor in terms of the overall configuration of the claimed design and concludes that such minor variations are not sufficient to distinguish the overall appearance of appellant's design over the prior art.

Reference is made to the examiner's answer (Paper No. 9, mailed December 13, 1995) for the examiner's full reasoning in support of the above-noted rejection. Attention is directed to appellant's brief (Paper No. 6, filed April 27, 1995) for an exposition of appellant's arguments thereagainst.

OPINION

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Having carefully considered the anticipation issue raised in this appeal in light of the applied prior art, 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. § 102(b) cannot be sustained. Our reasons for this determination follow.

Initially, we note that the proper test for determining novelty under 35 U.S.C. § 102 with respect to designs is the "ordinary observer" test (as distinguished from the "ordinary designer" test applicable in determining obviousness under 35 U.S.C. § 103). See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). With respect to the "ordinary observer" test for determining whether novelty is present under § 102 the court in In re Barlett, 300 F.2d 942, 943-944, 133 USPQ 204, 205 (CCPA 1961) set forth (in quoting with approval from Shoemaker, Patents for Designs, page 76):

If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, novelty of design is deemed to be present. The degree of difference required to establish novelty occurs when the average

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observer takes the new design for a different, and not a modified already-existing, design.

It therefore follows that, in order to establish lack of novelty (i.e., anticipation), the ordinary observer must take the general or ensemble appearance-effect of the design under consideration to be the same as that of an already-existing design (even though a degree of difference may actually be present).

In the present case, for the reasons aptly expressed by appellant on pages 3-4 of the brief, we do not agree with the examiner that the differences between the claimed design and the cap seen in Saito involve merely minor variations which are insufficient to distinguish the overall appearance of the claimed design from that of the prior art cap of Saito. Stated differently, and in accordance with the test for novelty in designs, we are of the opinion that the ordinary observer would view the general or ensemble appearance-effect of the claimed design to be different from that of the cap seen in Saito.

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Like appellant, we are of the view that the distinctly rounded appearance of the convex bump at the front portion of the cap of the claimed design, as opposed to the clearly truncated or cut-off front portion of the bump on the cap seen in Saito (e.g., in Figures 6, 7 and 8), along with the gradually rounded appearance of the rear portion of the cap of the claimed design, versus the truncated or cut-off appearance of the rear portion of the

cap of Saito, is enough to establish a clearly different overall visual impression to the ordinary observer than that created by the cap of Saito. This being the case, we will not sustain the examiner's rejection of the design claim on appeal under 35 U.S.C. § 102(b) as being clearly anticipated by Saito.

In accordance with the foregoing, the decision of the examiner rejecting the claimed design under 35 U.S.C. § 102(b) is reversed.

REVERSED

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