

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH MICHAELI

Appeal No. 99-0837
Application 29/074,268¹

HEARD: April 21, 1999

Before STONER, Chief Administrative Patent Judge, McCANDLISH,
Senior Administrative Patent Judge, and McQUADE,
Administrative Patent Judge.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

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

The ornamental design for a Drinking Glass

¹ Application for patent filed July 14, 1997.

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as shown and described.

The Claimed Design

According to appellant's specification, the drinking glass as illustrated in Figures 1-6 of the drawings is "shaped like a coconut . . ." In his brief (see page 2), appellant describes the illustrated drinking glass as having "a generally prolate ellipsoid shape with a flat bottom." The drinking glass is shown to have a circumferential parting line dividing the drinking glass into what appellant describes on page 2 of the brief as upper and lower hemispheres. The lower hemisphere is truncated to provide the flat bottom. The upper hemisphere is shown to have three indentations or depressions which are symmetrically arranged about the upper extremity of the hemisphere.

The Appealed Rejection

The appealed claim stands rejected under 35 U.S.C. § 171 "as being directed to non-statutory subject matter as it simulates a naturally occurring object and, therefore, lacks originality" (answer, page 4). There are no other rejections of the appealed claim, and no prior art has been cited in support of the standing rejection. Accordingly, the only issue

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before us is the propriety of the examiner's rejection under §
171. This section of the statute provides in pertinent part:

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

In the office action mailed November 24, 1997 (see page 2), the examiner concluded that "[t]he [claimed] design is merely simulating [sic, merely simulates] a coconut shell which the applicant himself did not invent." In support of this position, the examiner states in the final office action mailed March 31, 1998 (see page 2) that:

The statute requires that for a design to be patentable it must be "original". The *prima facie* [sic] basis for the rejection of the claim is that the design clearly simulates a known and naturally occurring object without any departure from the normal and expected appearance of that object and is, therefore, not original. It is not necessary to rely on prior art in a rejection of the claim as not being directed to statutory subject matter under 35 U.S.C. 171 as the rejection is not based on prior art but rather an evaluation of the claim with a category of known objects, namely coconuts. The rejection does not take the position that the claim copies a particular object/coconut but that it *simulates* that type of object. The examiner is aware that all coconuts are not identical but the differences between the many coconuts are not patentable ones.

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Appellant's Position

In support of patentability, appellant does not contend that the statutory basis (namely § 171) for the appealed rejection is improper. Nor does appellant challenge the examiner's rationale underlying the § 171 rejection, namely that a rejection may be based on § 171 if the claimed design lacks originality and thus does not meet all of the requirements for patentability in § 171.

Instead, appellant points out on page 4 of his brief that "there are at least six significant differences between the claimed design and a natural coconut" as shown in the photographs appended to his Request for Reconsideration filed February 27, 1998. Given these differences, appellant maintains that his claimed design, when viewed as a whole, is sufficiently different from the naturally occurring form of a coconut to satisfy the "originality" requirement in § 171.

Discussion

As a preliminary matter, we consider it appropriate to address the propriety of the statutory basis for the appealed rejection inasmuch as the examiner has cited no authority explicitly recognizing § 171 as the appropriate statutory

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basis for a rejection where originality of the claimed design is lacking.² Our review of the matter reveals that there is ample precedent for making a rejection under § 171 where one or more requirements of that section of the statute have not been met, albeit not for the "originality" requirement itself. For example, the requirement of ornamentality was involved in a § 171 rejection in In re Webb, 916 F.2d 1553, 1557, 16 USPQ2d 1433, 1435 (Fed. Cir. 1990). In addition, the requirement that a design be embodied in an article of manufacture was involved in a § 171 rejection in Ex parte Tayama, 24 USPQ2d 1614, 1616 (Bd. Pat. App. & Int. 1992) and also in a § 171 rejection in In re Zahn, 617 F.2d 261, 267, 204 USPQ 988, 994 (CCPA 1980). In all three of these cases, § 171 was expressly or implicitly recognized as the proper statutory basis for a rejection where a requirement in § 171 had not been met.

In In re Wise, 340 F.2d 982, 144 USPQ 354 (CCPA 1965) the underlying issue of originality was involved in one of the

² The Manual of Patent Examining Procedure (7th ed., July 1998), § 1504.01(d) indicates that § 171 may be the proper statutory basis for a design that lacks originality, but cites no supporting precedent under the Patent Act of 1952.

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rejections under review, but no specific statutory basis for that rejection was stated. The Wise court nevertheless recognized that a mere simulation of a naturally occurring form, namely a tear drop, was not a patentable design. Id. 340 F.2d at 938, 144 USPQ at 355-356.

The issue of originality also was involved in In re Smith, 77 F.2d 513, 25 USPQ 359 (CCPA 1935) (hereinafter Smith I) and in In re Smith, 77 F.2d 514, 25 USPQ 360 (CCPA 1935) (hereinafter Smith II). However, both of these cases were decided under the Revised Statute § 4929, May 9, 1902, ch. 783 (hereinafter the 1902 Act), not the 1952 Patent Act. Both Smith I and Smith II are nevertheless pertinent to our inquiry inasmuch as the relevant provision requiring a design to be "new, original and ornamental" in the 1902 Act, was reenacted in 35 U.S.C. § 73 (1946) and again in 35 U.S.C. § 171. See Tayama, at 1616.

In both Smith I and Smith II, the design was for a naked baby doll having natural or life-like characteristics. See e.g., Smith II, 77 F.2d at 514, 25 USPQ at 361. In both cases, the examiner's rejection was based on the determination that the design was substantially nothing more than a mere

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imitation or simulation of known or recognized expressions of a young baby. In Smith I, the court held that "to take a natural form, in a natural pose, . . . does not constitute [a patentable] invention." Smith I, 77 F.2d at 515, 25 USPQ at 360. In Smith II, the court stated that it found "no authority . . . which supports the conclusion that a naked baby doll simulating the natural features . . . of a baby without embodying some grotesqueness or departure from the natural form can involve such invention as to comply with the requirements of the design patent statute." Smith II, 77 F.2d at 515, 25 USPQ at 362. Although the rejections in Smith I and Smith II were not expressly based on any particular provision of the 1902 Act, the court, as noted supra in Smith II, specifically held that a design of a naked baby doll simulating the natural features of a baby did not comply with the requirements of the design patent statute. Id.

Summarizing the state of the law discussed supra, several cases (Webb, Zahn, and Tayama) have recognized § 171 as a proper statutory basis for a rejection where a patentability requirement of § 171 has not been met. There also is post-1952 authority (Wise) to support a rejection of a design that

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merely simulates a naturally occurring form. Finally, there is authority (Smith I and Smith II) to support a rejection of a design of a naturally occurring form that lacks "originative faculty" under a design statute where originality is one of the requirements for patentability. Smith I, 77 F.2d at 513, 25 USPQ at 360. The foregoing authorities constitute appropriate precedent for concluding that § 171 constitutes a proper statutory basis for a rejection of a design claim that lacks originality.

Turning now to the merits of the examiner's rejection, the Smith II court held that a claimed design must represent "some grotesqueness or departure from the natural form" of an object in order to be patentable. See Smith II, 77 F.2d at 515, 25 USPQ at 362. Application of such test obviously requires a comparison of the claimed design with the natural form of the object in question. The court in Smith I and Smith II had before it prior art representations of the natural form of a living baby in order to make such a comparison.

In the present case, the examiner proffered no evidence of the naturally occurring form of a coconut. She stated,

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instead, that "there is no need to rely on prior art to establish the lack of originality of a design claim" (answer, page 5).

While it may be true that prior art is not required in the sense of 35 U.S.C. § 102(b), § 103, the comparison required to apply the test in Smith II nevertheless cannot be made in a vacuum. Instead, evidence of the appearance of the naturally occurring form of the object in question is required to make such a comparison. Such evidence, although not supplied by the examiner, is nevertheless present in the record before us in the form of the above-mentioned photographs which accompanied appellant's Request for Reconsideration filed on February 27, 1998. We will therefore rely upon those photographs to make the required comparison between the claimed design and the naturally occurring form of a coconut.

On pages 2 and 3 of the brief, appellant has pointed out several uncontested differences between the claimed design and the naturally occurring form of a coconut as depicted in the above-mentioned photographs. Of particular interest are the flat bottom of the illustrated design, the circumferential

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parting line dividing the illustrated drinking glass in upper and lower hemispheres, the overall truncated oval shape of the illustrated design, the symmetrical arrangement of the three depressions of the same size and shape near the extremity of the upper hemisphere, and the lack of hairy or fibrous projections found on the natural form of a coconut.

The examiner's dismissal of such distinctions as the circumferential parting line and the flat bottom as being "functional features" (see page 5 of the answer) is unwarranted. A similar position was advanced and rejected in L. A. Gear Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993). There, the court stated at 1123, 25 USPQ2d at 1917:

A design patent is directed to the appearance of an article of manufacture. An article of manufacture necessarily serves a utilitarian purpose, and the design of a useful article is deemed to be functional when the appearance of the claimed design is "dictated by" the use or purpose of the article. *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964); *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 238, 231 USPQ 774, 777 (Fed. Cir. 1986) (patented design must be primarily ornamental).

. . .[T]he utility of each of the various elements that comprise the design is not the relevant inquiry with respect to a design patent. In determining

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whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article (citations omitted).

In the present case, the configurations of such features as the parting line and the bottom of the drinking glass are not dictated by functional considerations alone. Instead, these features may have multitude of different configurations. Accordingly, the mere fact that these features may relate to certain functions does not mean that the claimed design is devoid of ornamentality. In our viewpoint, the overall appearance of the claimed design is not dictated by the utilitarian purpose of the article, thus requiring consideration of the foregoing distinctions in determining the patentability of the claimed design.

These differences and the resulting overall appearance of the claimed design are not to be viewed in the context of the "average observer" as argued by appellant on page 4 of the brief. Instead, the relevant viewer is a designer of ordinary capability who designs articles of the type claimed. In re

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Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA
1981).

To such a designer of ordinary capability, we are of the view that the cumulative effect of the foregoing differences between the claimed design and the naturally occurring form of a coconut creates a significant and patentably distinct departure of the overall appearance of the claimed design from the naturally occurring form of a coconut as shown in the above-mentioned photographs. The claimed design therefore satisfies the "originality" requirement in § 171. Accordingly, we cannot sustain the examiner's § 171 rejection of the appealed claim.

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The examiner's decision rejecting the appealed claim is reversed.

REVERSED

	Bruce H. Stoner, Jr., Chief)	
	Administrative Patent Judge)	
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	Harrison E. McCandlish, Senior)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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