

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

\_\_\_\_\_  
Ex parte ERNESTO GRINBERG

\_\_\_\_\_  
Appeal No. 99-1028  
Application 29/067,859<sup>1</sup>

\_\_\_\_\_  
ON BRIEF  
\_\_\_\_\_

Before STAAB, McQUADE and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the final rejection of the following design claim:

The ornamental design for a disposable mitten as shown and described.

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<sup>1</sup> Application for patent filed April 7, 1997.

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The disposable mitten design is depicted in front view, first side view, second side view, top view and bottom view in Figures 1 through 5 respectively, with Figure 1 being the most representative when evaluating the examiner's rejection.

**THE REFERENCES**

The references applied by the examiner are:

O'Connell	2,364,749	Dec. 12,
1944		
Humphrey	2,782,912	Feb. 26,
1957		

**THE REJECTION**

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over O'Connell in view of Humphrey.

The rejection is explained in the Examiner's Answer (Paper No. 11).

The opposing viewpoints of the appellant are set forth in the Brief (Paper No. 10).

**OPINION**

The appellant's design is for a disposable mitten having separate thumb and four-finger pockets with rounded upper contours. A U-shaped gap or valley is provided between the

thumb and four-finger pockets. The front and rear surfaces of the

glove are depicted in Figures 2-5 as being flat, except where the

front and rear sides converge along the sides and top to form a uniform seam or trim. As depicted in Figure 1, the lower portion of the glove flares outwardly in a fairly symmetrical manner.

We begin our analysis by pointing out that the standard for evaluating the patentability of a design is whether it would have been obvious to a designer of ordinary skill in the articles involved. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). In rejecting a claim to an ornamental design under 35 U.S.C. § 103, the examiner must supply a primary or basic reference that bears a substantially identical visual appearance to the claimed design. In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed Cir. 1993). That is, there must be a reference, a something in existence, the design characteristics of which are basically

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the same as the claimed design; once a reference meets this test, reference features may reasonably be interchanged with or added from those in other pertinent references. In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Initially, we note that there seems to be some confusion as to the figure in O'Connell relied on by the examiner as being the

"something in existence, the design characteristics of which are basically the same as the claimed design." Appellant understands the "something" to be the mitten shown in O'Connell's Figure 5 (brief, page 2 and Exhibit I filed August 5, 1998). The examiner, on the other hand, relies on the "mitten" shown in O'Connell's Figure 1 (answer, page 4 and Exhibit A). In fact, the examiner acknowledges that what is shown in O'Connell's Figure 5 is a one finger mitten having a thumb pocket, an index finger pocket and a separate three-finger pocket. The examiner also states that since she is relying on a four-finger mitten, the appellant's argument concerning O'Connell's Figure 5 is moot (answer, page 5).

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Therefore, we understand the examiner's position to be that O'Connell's Figure 1 is the Rosen reference.

It is the examiner's position that the only difference between the O'Connell "mitten" shown in Figure 1 and the claimed design is the absence of the trim around the sides and top. The examiner suggests that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Connell by providing it with the trim around the sides and top as taught by Humphrey to obtain essentially the herein disclosed and claimed design (answer, page 3).

As to appellant's argument (brief, pages 2 and 3) that the

O'Connell mitten does not satisfy the threshold Rosen requirement, the examiner replies that

O'Connell is seen to be a proper Rosen reference in that, it shows the overall appearance of the seamless mitten with one thumb portion and separate four finger pocket and tapered wrist as in appellant's design (answer, page 5).

We do not agree. First, we point out that O'Connell's Figure 1 does not show a mitten design, but a piece of fabric **6** which must be combined with a thumb back **7** and a one piece palm **8** in order to form a complete mitten having a pocket for

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receiving a hand (see O'Connell, page 1, right-hand column, lines 15-45). O'Connell also states that

the back **6** is cut for a so called one fingered mitten which has a finger **9** for the index finger of the hand and a cover **11** for the remaining fingers of the hand (page 1, left hand column, lines 34-37).

Appellant's mitten design includes a front piece and a back piece secured together along side and top edges to form a pocket. At the very least, these basic characteristics of appellant's design are not shown in O'Connell's Figure 1. In addition, the U-shaped gap between the thumb and four-finger pockets and the symmetrical flare in the lower portion of the mitten are absent

in O'Connell's Figure 1. Accordingly, we do not view O'Connell's Figure 1 as a proper Rosen reference and we shall not sustain the standing 35 U.S.C. § 103 rejection of the appealed claim.

The decision of the examiner is reversed.

**REVERSED**

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LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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