

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. WHITSON

Appeal No. 1999-2009
Application No. 29/052,870

ON BRIEF¹

Before McCANDLISH, Senior Administrative Patent Judge, NASE and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the single design claim pending in this design application.

¹ We note that the appellant has requested an oral hearing (Paper No. 14, filed April 12, 1998), but under the circumstances a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence.

We REVERSE.

BACKGROUND

The appellant's invention relates to a design for a garden area edging unit. The claim on appeal is:
The ornamental design for an edging unit, as shown and described.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dean, Jr. (Dean)	5,564,240	Oct. 15, 1996
Burr	2,415,782 ² (Germany)	Oct. 16, 1975

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Figure 61 of Burr in view of Dean.

² In determining the teachings of Burr, we will rely on the Derwent abstract and the partial translation provided by the appellant (both of record).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 8, mailed May 13, 1998) and the answer (Paper No. 13, mailed February 4, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 12, filed November 16, 1998) and reply brief (Paper No. 14 ½, filed April 12, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's drawings, specification and claim and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have determined that the examiner's rejection of the appellant's design claim under 35 U.S.C. § 103 cannot be sustained.

At the outset, we keep in mind that, in a rejection of a design claim under 35 U.S.C. § 103, there is a requirement

that there must be a single basic reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) and In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

For purposes of this appeal, we will consider Figure 61 of Burr as the basic design reference, i.e., as a "Rosen" reference even though the appellant argues (reply brief, pp. 4-5) that Figure 61 of Morris does not have the basic design characteristics as the claimed design.

At this point, we note that once such a basic design reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. See In re Harvey, 12 F.3d at 1063, 29 USPQ2d at 1208. These secondary references may only be used to modify the basic design reference if they are so related to the basic design reference that the appearance of certain

ornamental features in one would have suggested the application of those features to the other. See In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996). However, such modifications cannot destroy fundamental characteristics of the basic design reference. See In re Rosen, supra. Thus, the focus in a design patent obviousness inquiry should be on visual appearances rather than design concepts. See In re Harvey, 12 F.3d at 1064, 29 USPQ2d at 1208.

The difficulty we have with the examiner's rejection is that the examiner concludes that it would have been obvious to modify Figure 61 of Burr to include a raised bevel top surface (answer, p. 4) as taught by Dean. We do not agree. We see no suggestion of why a designer of ordinary skill would have modified the building plate depicted in Figure 61 of Burr to have included a raised bevel top surface for the reasons set forth by the appellant (brief, pp. 5-6; reply brief, pp. 5 and 7-8). In our view, the examiner's proposed modification of Figure 61 of Burr to include a raised bevel top surface as taught by Dean destroys a fundamental characteristic of the

basic design reference (i.e., Burr) by removing the planar top surface which permits the building plates to be formed into building elements (see Figures 91-102 of Burr).

CONCLUSION

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
))	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

Appeal No. 1999-2009
Application No. 29/052,870

Page 8

FROST & JACOBS
2500 PNC CENTER
201 EAST FIFTH STREET
CINCINNATI, OH 45202

Appeal No. 1999-2009
Application No. 29/052,870

Page 9

JVN/ks