

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES SAUNDERS  
and SCOTT WEBB

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Appeal No. 2000-1905  
Design Application 29/095,094<sup>1</sup>

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ON BRIEF

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Before STONER, Chief Administrative Patent Judge, and  
WILLIAM SMITH and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for design patent filed October 16, 1998, entitled (as amended) "OIL FILTER WRENCH."

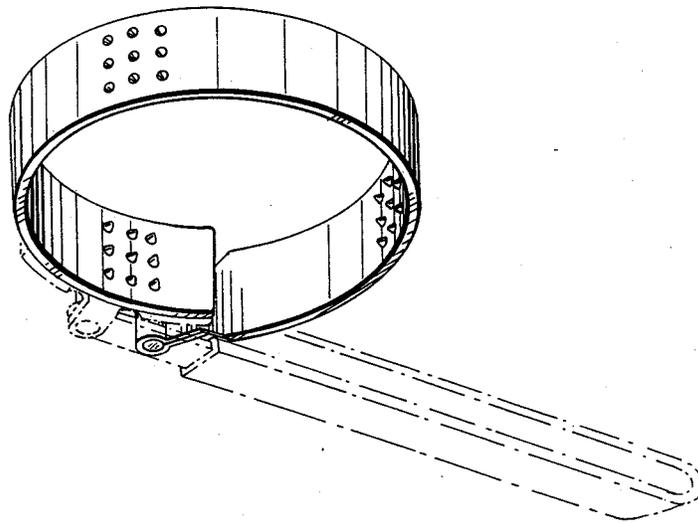
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Appellants appeal from the final rejection of the claim  
in this design patent application to:

The ornamental design for an oil filter wrench as  
shown and described.

The design is reproduced below.

FIG. 1



PRIOR ART

No prior art is relied upon by the Examiner in the  
rejection of the claim on appeal.

THE REJECTION

The claim stands rejected under 35 U.S.C. 171 as being  
directed to non-statutory subject matter because it is said to  
lack ornamentality. The rejection (Paper No. 2, pp. 2-3) is  
form paragraph 15.08 from the Manual of Patent Examining

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Procedure § 1504.01(c). The reasoning specific to this design is as follows (Paper No. 2, p. 2):

The following evidence establishes a prima facie case of lack of ornamentality:

, The claimed design appears to be a plain wrench strap having projections for gripping purposes. The appearance of the design when evaluated in light of the examiner's knowledge and a review of the prior art does not evidence that the design was "created for the purpose of ornamenting" the article in which it is embodied and, therefore, the claim is not directed to statutory subject matter

#### OPINION

#### Legal standards for "ornamental"

The function of the article itself must not be confused with "functionality" of the design of the article. Avia Group Int'l, Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563, 7 USPQ2d 1548, 1553 (Fed. Cir. 1988) (distinguishing the functionality of the feature from the design of the feature). "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." L.A. Gear v. Thom McAn Shoe Co., 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993) (quoting

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In re Carletti, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964)). "In determining 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." L.A. Gear, 988 F.2d at 1123, 25 USPQ2d at 1917.

As stated in Hupp v. Siroflex of America Inc., 122 F.3d 1456, 1460-61, 43 USPQ2d 1887, 1890 (Fed. Cir. 1997):

In determining whether the statutory requirement is met that the design is "ornamental," it is relevant whether functional considerations demand only this particular design or whether other designs could be used, such that the choice of design is made for primarily aesthetic, non-functional purposes. L.A. Gear v. Thom McAn, 988 F.2d at 1123-24, 25 USPQ2d at 1917 ("When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose."); In re Carletti, 51 C.C.P.A. 1094, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964) (determining whether the appearance is "directed by" the use of the article).

As further stated in Carletti, id.: "[I]t has long been settled that when a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple reason that it is not

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'ornamental' ) was not created for the purpose of  
ornamenting."

### Analysis

Appellants argue that the equidistant spacing of the groups of gripping knobs around the strap together with the fact that they are grouped in a 3-by-3 pattern and the pyramidal shape of the gripping knobs with rounded tops are pure design features (Brief, Paper No. 9, p. 4). Appellants filed a declaration (attached to Paper No. 5) by Robert Jacoff, Vice President of the assignee, Great Neck Saw Manufacturers, Inc. Mr. Jacoff states that the knob pattern, spacing, and shape of the knobs give the design a distinctive ornamental appearance and states that changes could be made which would not affect the function, but would affect the aesthetic appearance. Appellants further argue that the prior patents cited by the Examiner together with those submitted by Appellants in the Information Disclosure Statement (IDS) (Paper No. 2<sup>2</sup>) disclose numerous configurations of oil filter

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<sup>2</sup> Although the Information Disclosure Statement was given Paper No. 2, it was not entered on the file wrapper contents and, consequently, the first Office action was also given Paper No. 2. The Examiner should have this clerical problem corrected by, e.g., having the Information Disclosure

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wrenches and similar devices with gripping knobs, indicating that there are many variations which perform the function but have different appearance (Brief, p. 4).

The Examiner states (Examiner's Answer, Paper No. 10, p. 3): "In order to overcome a rejection of the claim under 35 U.S.C. 171 as lacking in ornamentality, it is necessary that the motivation of the inventor be the basis for the evidence that the design was created with 'thought of ornament.' In re Carletti, 140 USPO 653, 655 (CCPA 1964)."

The Examiner states that the declaration by Mr. Jacoff "does not convincingly establish knowledge of the ornamental intent behind the creation of the design; however, to the extent that the declaration be accepted, the mere description of pyramidal gripping knobs and the symmetry of their placement does not characterize these features as having sufficient effect on the overall appearance to render the claimed design as primarily ornamental" (Examiner's Answer, pp. 3-4).

The Examiner has failed to persuade us that the design is directed by the use of the article, so as to be primarily functional. Functional considerations do not demand only this

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Statement renumbered as Paper No. 1½.

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particular design. It is particularly persuasive to us that the prior art cited by the Examiner, and by Appellants in their IDS, show many different structures of gripping protrusions, which indicates that the choice of design is made for primarily aesthetic, non-functional purposes. See L.A. Gear, 988 F.2d at 1123, 25 USPQ2d at 1917 ("When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose."). The Examiner fails to address this evidence. As to the question of subjective intent, i.e., of whether Appellants created the design with "thought of ornament," the fact that many other designs existed for oil filter wrenches and similar articles is sufficient evidence of intent to ornament by selection of the pattern, spacing, and shape of the raised knobs.

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For the reasons discussed above, we conclude that the Examiner erred in rejecting the claimed subject matter as non-statutory. The rejection of the single claim is reversed.

REVERSED

BRUCE H. STONER, JR.	)	
Chief Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
WILLIAM F. SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
LEE E. BARRETT	)	
Administrative Patent Judge	)	

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