

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN M. MCGOVERN
and GLENN KAUFMAN

Appeal No. 2000-2150
Application 29/083,483

ON BRIEF

Before THOMAS, FRANKFORT and WALTZ, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim reproduced from page 1 of the specification:

We claim: The ornamental design for the Open-End Wrench Head [and Handle Therefor] as shown and described.

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In response to an earlier restriction requirement by the examiner in this application, appellants filed an amendment on January 4, 1999, to change the title to read --OPEN-END WRENCH HEAD--. At the same time it appears that the Office implicitly interpreted this title change as a basis to cancel the bracketed portion of the claim on appeal. It was not until the amendment filed on May 5, 1999, that appellants actually canceled the description of Figures 6-8 and implicitly any claim that may have been directed to these figures to the handle portion of the design claim, characterized by the examiner as a second embodiment depicted in these canceled figures which were non-elected by appellants in accordance with the restriction requirement. As noted in footnote 1 of page 2 of the brief, there has been no formal amendment by appellants to the design claim on appeal. For purposes of our review and decision in this appeal, we construe the claim as implicitly being directed to the design for an open-end wrench head as shown and described (active Figures 1-5) only since there are no active figures in the file (Figures 6-8) which reflect a handle therefor anyway. Should

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appellants continue prosecution of this application, a formal amendment should be submitted to properly amend the claim.

The examiner has relied upon the following references:

Vallone	D 111,094	Aug. 30, 1938
Huebschen et al. (Huebschen)	5,148,726	Sep. 22, 1992

The design claim stands rejected under 35 U.S.C. § 171 as being directed to non-statutory subject matter in that it lacks ornamentality. Additionally, the design claim on appeal stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Huebschen in view of Vallone.

We refer to the brief and answer for the respective positions of the appellants and the examiner unless otherwise indicated in our opinion.

OPINION

We reverse both rejections.

Turning first to the rejection of lack of ornamentality within 35 U.S.C. § 171, in the first Office action, mailed on February 1, 1999, appellants were given the opportunity to

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present affidavits within 37 CFR § 1.132 to provide evidence of ornamentality. As part of a response, appellants submitted a first declaration by Daniel M. Eggert on May 5, 1999. Since the examiner maintained the rejection in the final rejection mailed on July 19, 1999, appellants submitted a second response via facsimile on October 11, 1999, including a second declaration by Mr. Eggert.

Because the examiner erred in failing to consider the merits of these two declarations, we reverse the rejection. Paragraph 2 of the initial declaration by Mr. Eggert states that the "intent behind the creation of the wrench head was in part ornamental." Similarly, in paragraph 4 of this declaration, Mr. Eggert stated that "the thought behind the creation of the wrench head was in part ornamental." As explained in paragraph 2 of the second declaration, Mr. Eggert clarified this "in part" language by stating that this language "was intended to mean that the head and the handle have different thickness, and, therefore, there must be a line of demarcation and the existence of the line of demarcation is functional." By this, we understand Mr. Eggert as

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indicating that because of the different thicknesses between the head and the handle there must be some kind of line of demarcation that is functional in nature to transition between the different thicknesses. Mr. Eggert continues in paragraph 2 of the second declaration by stating "[h]owever, the particular shape of the line is entirely ornamental. In other words, the line of demarcation being straight is entirely ornamental." Correspondingly, Mr. Eggert previously stated in paragraph 3 of the first declaration that this line of demarcation was "ornamental" and a feature of the design which "distinguishes the design depicted in figs. 1 to 5 from open-end wrench heads of others."

The weight of the evidence before us, based primarily upon the two declarations by Mr. Eggert considered collectively, indicates that the rejection of the design claim on appeal under 35 U.S.C. § 171 must be reversed. The examiner has no countervailing line of reasoning or argument, in our view, on which to conclude at the bottom of page 5 of the answer that appellants have "failed to establish that said straight line of demarcation was created with 'the thought of ornament' and not a product of functional details which also looks [sic, look] ornamental."

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent references, when such references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, 673 F.2d 388 at 391, 213 USPQ 347 at 350 (CCPA 1982); In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956); In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). If, however, the combined teachings of the

applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987).

As to the rejection of the design claim on appeal under 35 U.S.C. § 103, we also reverse this rejection. The earlier noted first Office action took the position that with the exception of the grooves of the interior jaw, Huebschen shows all basic aspects of the claimed design. Since Vallone disclosed a planar interior jaw, the examiner considered it obvious to the ordinary designer to have modified the entire jaw of Huebschen (Figure 12) by making the grooved surface planar as shown by Vallone because the applied references were so related that the appearance of features shown in one would have suggested the application of them to the other. Implicitly, the examiner has asserted that Huebschen is a Rosen-type reference. In response to appellants' amendment to this first Office action the examiner maintained the position that the design claim on appeal was obvious within 35 U.S.C. § 103. The examiner characterized the line of demarcation in Huebschen as a "shallow curved line" in

the final rejection, mailed on July 19, 1999, page 2. The examiner considered the difference between it and the claim design as de minimis and not of patentable distinction. The same position has been essentially maintained in the answer.

Even if we can agree with the examiner's position that it would have been obvious for the artisan to have modified Huebschen's Figure 12 according to the design features of a planar jaw and a planar V-shape throat from the Figure 1 showing in Vallone within 35 U.S.C. § 103, we reverse the rejection.

The so-called line of demarcation of the claimed design is immediately evident, even upon first impression. We consider it a dominant feature of the overall design of the open-end wrench head depicted in Figures 1-5 for the claimed invention. The transition from the curved area of the head to the straight line of demarcation between the head and the handle appears to us to be striking and therefore patentably distinct even in view of the examiner's fair characterization of the line of demarcation between the head and the handle in Figure 12 of Huebschen as a shallow curved line. We therefore conclude that the ordinary designer would not have considered this line of demarcation presented in the design claim on appeal as de minimis on the basis of the applied prior art.

In view of the foregoing, we reverse the rejection of the design claim on appeal under 35 U.S.C. § 103. As such, we have no need to consider the evidence provided by the second declaration to Mr. Eggert as to commercial success.

Finally, we make note of the examiner's comment at page 6 of the answer where the examiner states "said line of demarcation is old in the art as evidenced by Bonney Wrenches (right bottom of page 9 of Bonney wrenches Catalog)." This comment by the examiner is noted, but it is untimely. This reference is not part of the stated rejection under 35 U.S.C. § 103. Note In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). A study of the application file reveals that this reference to Bonney wrenches was filed as part of the application papers as Paper No. 2 by appellants utilizing PTO Form 1449 as a part of appellants' Information Disclosure Statement.

Pursuant to 37 CFR § 1.196(a) and the Manual of Patent Examining Procedure (MPEP) § 1211, this application is remanded to the examiner to consider instituting art rejections under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 based upon the Bonney wrenches reference since the examiner has indicated at page 6 of the answer that "said line of demarcation is old in the art."

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In summary, we have reversed both rejections of the design claim on appeal, the rejection of the design claim under 35 U.S.C. § 171 and the separate rejection of it under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting the design claim on appeal is reversed. Additionally, we have remanded this application to the examiner for consideration of instituting new rejections under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

REVERSED AND REMANDED

James D. Thomas)	
Administrative Patent Judge)	
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Charles E. Frankfort)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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