

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte KIM L. GRANT

---

Appeal No. 2000-2183  
Application No. 29/082,343

---

ON BRIEF

---

Before CALVERT, FRANKFORT and LAZARUS, Administrative Patent Judges

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of the claim in appellant's design application.

The claim on appeal reads:

The ornamental design for a SHOWER CAP as shown and described.

The references applied in the final rejection are:

Owen	3,247,521	Apr. 26, 1966
------	-----------	------------------

Appeal No. 2000-2183  
Application No. 29/082,343

Vance et al. (Vance)	5,455,970	Oct. 10, 1995
Adkins	5,477,561	Dec. 26, 1995

The claim stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Vance in view of Owen and Adkins.

We note initially that the examiner has required appellant to cancel Fig. 5 on the ground that it is improper in that it shows the interior construction of the stretch band and does not concern the external appearance of the article, the design of which is claimed. Although appellant argues the merits of this requirement in the brief, it is a matter which is not within our jurisdiction to review under 35 U.S.C. §§ 7(b) and 134, since it does not relate to a matter involving the rejection of the claim. See In re Hengehold, 440 F.2d 1395, 1340, 169 USPQ 473, 480 (CCPA 1971), and cf. Ex parte Milner, 21 USPQ 589, 590 (Bd. Apps. 1933).

Turning to the rejection under § 103(a), appellant describes the claimed invention on page 3 of the brief as:

a shower cap in which the dominant feature of the design is a wide, smooth band at the bottom of the shower cap. The design characteristics lie in two aspects, that the band is substantially wider than has been known before and that the surface of the

Appeal No. 2000-2183  
Application No. 29/082,343

band is smooth.<sup>[1]</sup>

Vance discloses a shower cap having, in its "small mode" (Fig. 4), an upper crown 14 with a band 12 at the bottom. The examiner states the basis of the rejection on pages 4 and 5 of the answer as follows:

Vance discloses a shower cap with a headband and a crown portion like that of the claimed design. The differences to [sic: from] that of the claimed design are the shape or fullness of the crown and the smooth band. Adkins teaches the shape or fullness of the crown. Owen discloses a smooth band to be old in the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vance by providing it with a shape or fullness of the crown as taught by Adkins and the smooth band as taught by Owen to obtain essentially the herein disclosed and claimed design.

In response to appellant's argument that the smooth band of Owen

is thin, not wide, the examiner states at page 6 of the answer:

The difference in the width of the band is seen to be minor to the overall appearance, which is not sufficient to support unobviousness[.] In re Cooper[, 480 F.2d 900,] 178 USPQ 406 [(CCPA 1973)].

---

<sup>1</sup> The wide, smooth band of appellant's claimed design is shown in Figs. 1, 2 and 4. Fig. 5 further illustrates the smoothness of the surface of the band.

Appeal No. 2000-2183  
Application No. 29/082,343

With regard to the question of the obviousness of the claimed design, it is well settled, as stated in Durling v. Spectrum Furniture Co., 101 F.3d 100, 103, 40 USPQ2d 1788, 1790 (Fed. Cir. 1996):

In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (C.C.P.A. 1982). More specifically, the inquiry is whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. See In re Borden, 90 F.3d at 1574, 39 USPQ2d at 1526.

Before one can begin to combine prior art designs, however, one must find a single reference, "a something in existence, the design characteristics of which are basically the same as the claimed design." In re Rosen, 673 F.2d at 391, 213 USPQ at 350. Once this primary 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 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993).

In the present case, the claimed shower cap and the shower cap

Appeal No. 2000-2183  
Application No. 29/082,343

of Vance, the primary reference, each consist, from an appearance standpoint, of two basic elements: a crown, and a band encircling the bottom (opening) of the crown. As stated in the above-quoted basis of the rejection, the examiner finds that there are differences between the claimed cap and the Vance cap in the appearance of each of these two elements, but contends that it would have been obvious to modify both of the elements in view of Adkins and Owen, respectively, to arrive at the design of the

claimed cap. Appellant argues at page 5 of the brief that Vance is not a so-called Rosen reference, "since the Examiner had to substitute all of the elements for Vance to make the rejection." Also, appellant contends that even if the smooth band of Owen were substituted for the band of Vance (or Adkins), the resulting cap would not have a wide band, as claimed.

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, and in the examiner's answer, we conclude that the claimed shower

Appeal No. 2000-2183  
Application No. 29/082,343

cap is patentable over the applied prior art. It is difficult to see how Vance can be said to have design characteristics which are basically the same as the claimed design, i.e., can be said to constitute a Rosen reference, when, as appellant argues, all (both) of its design elements would have to be modified in order to arrive at the claimed design. Comparing the cap design disclosed by Vance with that claimed by appellant, we conclude that Vance does not constitute a Rosen reference, and, therefore, the rejection cannot be sustained.

Conclusion

The examiner's decision to reject the claim is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
CHARLES E. FRANKFORT	)	BOARD OF PATENT
	)	APPEALS AND

Appeal No. 2000-2183  
Application No. 29/082,343

Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
RICHARD B. LAZARUS	)	
Administrative Patent Judge	)	

iac/vsh

Appeal No. 2000-2183  
Application No. 29/082,343

FULBRIGHT AND JAWORSKI  
865 S. FIGUEROA STREET  
29TH FLOOR  
LOS ANGELES, CA 90017