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 EARL F. GOLDEN and LOUIS N. NETZ

Appeal No. 2001-0337
Application No. 29/091,083

ON BRIEF

Before FLEMING, NASE, and KRATZ, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim:

> The ornamental design for a SIDE PORTION OF A MOTORCYCLE ROCKER BOX as shown and described.

We REVERSE and REMAND.

BACKGROUND

The design application was filed with two figures. Figure 1 being a side view of a side portion of a motorcycle rocker box. Figure 2 is an enlarged side view of the side portion of a motorcycle rocker box of Figure 1. On the sole page of the specification, the appellants state that

> [t]he present invention is directed to the design illustrated in the drawings. The other features of the drawings, such as the motorcycle shown in Fig. 1, are not considered part of the design sought to be patented, and have accordingly been shown in broken lines.
>
> The design sought to be patented is not visible in the front, rear, top, bottom and left side views. Accordingly, these views have been omitted.

The sole rejection before is in this appeal is the rejection of the design claim under 35 U.S.C. § 112, first paragraph, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the first Office action (Paper

No. 5, mailed November 29, 1999), the final rejection (Paper No. 7, mailed March 1, 2000) and the answer (Paper No. 10, mailed September 29, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 9, filed July 24, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' drawings, specification and claim and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we have determined that the examiner's rejection of the appellants' design claim under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The examiner's basis for the rejection under appeal (answer, p. 3-4) is that the appearance of the claimed design is not definite since the surface shading on the side and middle portions of the claimed design (see Figure 2) indicate changes in contour which cannot be understood in the absence

of a drawing view from a different point of view.

Specifically, the examiner states (answer, p. 4) that

> [i]n the absence of a disclosure of the specific contours, configuration, and spatial and planar relationship and configuration of the disclosed elements of the claimed design, the claimed design is subject to conjecture and could be achieved by different configurations.

The appellants state (brief, p. 4) that the design sought to be patented is the ornamentality provided by a rocker box when viewed from the side, and is not limited to the specific three-dimensional geometry of their commercial design. The appellants argue (brief, pp. 5-6) that one skilled in the art could make and use the design illustrated in the drawings. We agree. In that regard, the ornamental design for a side portion of a motorcycle rocker box as shown and described in the appellants' application constitutes a complete disclosure of the side portion of a motorcycle rocker box in all essential respects, is so far as its appearance in side view is concerned. Any side portion of a motorcycle rocker box having substantially the appearance depicted in the appellants' drawings would constitute an infringement of any

patent to be issued, and we see no reason for holding the appealed design claim to be unpatentable under the enablement requirement of the 35 U.S.C. § 112, first paragraph. Accordingly, the decision of the examiner to reject the design claim under 35 U.S.C. § 112, first paragraph, is reversed.

REMAND

We remand this application to the examiner to determine whether or not the design claim should be rejected under the judicially created doctrine of double patenting over the appellants' Patent No. Des. 408,828, issued April 27, 1999.

CONCLUSION

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C. § 112, first paragraph, is reversed.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED; REMANDED

MICHAEL R. FLEMING Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

JOSEPH A. GEMIGNANI
MICHAEL BEST & FRIEDRICH
100 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202-4108

JVN/jg