

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICIA A. HARDY

Appeal No. 97-2900
Application No. 29/039,134¹

ON BRIEF

Before ABRAMS, PATE, and NASE, 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.

We REVERSE.

¹ Application for patent filed May 22, 1995.

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BACKGROUND

The appellant's invention relates to a design for a pellet.
The claim on appeal is:

The ornamental design for a pellet for tossing at weddings as
shown and described.

The prior art reference of record relied upon by the
examiner as evidence of anticipation under 35 U.S.C. § 102 is:

Grodberg et al. (Grodberg)	3,345,265	Oct. 3, 1967
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The design claim stands rejected under 35 U.S.C. § 102(a),
(b) and (e) as being anticipated by Grodberg.

Rather than reiterate the conflicting viewpoints advanced by
the examiner and the appellant regarding the § 102 rejection, we
make reference to the examiner's first Office action (Paper No.
2, mailed January 29, 1996) and the examiner's answer (Paper No.
7, mailed March 17, 1997) for the examiner's complete reasoning
in support of the rejection, and to the appellant's brief (Paper
No. 6, filed November 17, 1996) for the appellant's arguments
thereagainst.

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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. § 102(a), (b) and (e) as being anticipated by Grodberg cannot be sustained.

We initially note that the "ordinary observer" test (as distinguished from the "ordinary designer" test used in determining obviousness under 35 U.S.C. § 103) is applicable in determining the presence of novelty under § 102. See In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 785 (CCPA 1981). With respect to the "ordinary observer" test for determining whether novelty is present under § 102 the court in In re Barlett, 300 F.2d 942, 943-44, 133 USPQ 204, 205 (CCPA 1961) set forth (in quoting with approval from Shoemaker, Patents for Designs, page 76):

If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, **novelty** of design is deemed to be present. The degree of difference required to

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establish **novelty** occurs when the average observer takes the new design for a different, and not a modified already-existing, design.

It therefore follows that, in order to establish lack of novelty (i.e., anticipation), the ordinary observer must take the general or ensemble appearance-effect of the design under consideration to be the same as that of an already-existing design (even though a degree of difference may actually be present).

Here, we are of the opinion that the ordinary observer would take the appellant's design to be a different design from that shown by Grodberg. The different overall impressions created by the tablet of Grodberg and that of the appellant's pellet would be readily appreciated by an ordinary observer such as a purchaser. Specifically, the ordinary observer would readily discern the difference in appearance of the curved ends of the two designs. That is, as pointed out by the appellant, the overall appearance of the present design is not virtually identical to the Grodberg design due to Grodberg having blunter semi-spherical ends which are readily discernibly different in appearance from the more bullet shaped ellipsoid ends of the present design. This being the case, we will not sustain the

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rejection of the design claim on appeal under 35 U.S.C. § 102(a),
(b) and (e) as being anticipated by Grodberg.

CONCLUSION

To summarize, the decision of the examiner to reject the
design claim under 35 U.S.C. § 102(a), (b) and (e) is reversed.

No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APJ NASE

APJ PATE

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

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