

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(2) is not binding precedent of the Board.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. 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 CHARLES A. CASWELL

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Appeal No. 97-3824  
Application 29/042,728<sup>1</sup>

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ON BRIEF

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Before McQUADE, MARTIN, and WARREN, Administrative Patent  
Judges.

MARTIN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the  
examiner's rejection of appellant's design claim under 35  
U.S.C. § 103. We reverse.

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<sup>1</sup> Application for design patent filed August 3, 1995.

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**A. The claim**

The claims reads: "The ornamental design for a back support belt, as shown and described."

**B. The references and ground of rejection**

The rejection is based on the following references:

Yewer, Jr. (Yewer)	5,036,864	Aug. 6, 1991
Schiek, Sr. (Schiek)	5,316,022 <sup>2</sup>	May 31, 1994
Glover et al. (Glover)	5,388,274	Feb. 14, 1995

The claim stands rejected under § 103 for unpatentability over Yewer in view of Schiek and Glover.

**C. The merits of the rejection**

The first issue raised by appellant is whether Yewer constitutes a "Rosen" reference. As explained in In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996),

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<sup>2</sup> The reply brief explains (at 2) that the substitute opening brief (paper No. 9), in discussing this Schiek patent, erroneously identified it as Schiek Patent No. 5,046,488, which is also of record in the application file.

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[t]he central inquiry in analyzing an ornamental design for obviousness is whether the design would have been obvious to "a designer of ordinary skill who designs articles of the type involved." Avia Group [Int'l Inc. v. L.A. Gear Calif., Inc.], 853 F.2d [1557,] at 1564, 7 USPQ2d [1548,] at 1554 [(Fed. Cir. 1988)]; In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784-85 (CCPA 1981). That inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features. Petersen Mfg. Co. v. Central Purchasing, Inc., 740 F.2d 1541, 1548-49, 222 USPQ 562, 567-68 (Fed. Cir. 1984); In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982).

In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, "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 349; see In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). A finding of obviousness cannot be based on selecting features from the prior art and assembling them to form an article similar in appearance to the claimed design. In re Jennings, 37 C.C.P.A. 1023, 182 F.2d 207, 208, 86 USPQ 68, 70 (1950) (the claimed design "must be [. . .] compared with something in existence, not with something that might be brought into existence by selecting individual features from prior art and combining them"); see L.A. Gear[, Inc. v. Thom McAn Shoe Co.], 988 F.2d [1117,] at 1124, 25 USPQ2d [1913,] at 1918 [(Fed. Cir.), cert. denied, 510 U.S. 908, 114 S.Ct. 291, 126 L.Ed.2d 240 (1993)]; In re Sung Nam Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1664 (Fed. Cir. 1987).

Furthermore, a reference is not a "Rosen" reference if the modifications required to achieve the claimed design would

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destroy fundamental characteristics of the reference design.  
Rosen, 673 F.2d at 391, 213 USPQ at 350.

The examiner (Answer at 3) explains that Yewer, the principal reference, "discloses a belt with a strap and buckle like that of the claimed design" but which differs from the claimed design in that it lacks the following features: "the overlapping contoured belt, the strap with loop and pile closing means, and the rear tab." Of these differences, appellant relies on only the contouring and the rear tab. However, appellant's descriptions of these features contain some inaccuracies. More particularly, whereas appellant argues that Yewer fails to disclose "a back portion having parabolic shaped upper and lower edges" (Opening Brief at 3), it is not apparent from appellant's drawings that these edges are parabolic. In our view, the shape of these edges is more correctly described as simply convex (Yewer's corresponding edges are straight). Appellant also describes the contour of claimed belt design as including "side portions having concave shaped upper edges and convex shaped lower edges which extend between the back portion and the overlapping end portions" (our emphasis) (Opening Brief at 3). However, it is apparent

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from appellant's drawings that the lower edges of the side portions, like the upper edges thereof, are concave rather than convex (Yewer's corresponding edges are straight).

Next, appellant correctly notes contends that Yewer lacks a "back portion . . . with a width [i.e., vertical dimension] greater than the width of the overlapping end portion[s]" (Opening Brief at 4).

Finally, appellant gives the following description of what the examiner refers to as the "rear tab" feature: "a tightening strap disposed in a V-shaped configuration along the back portion and stabilized in such a position by a substantially centrally disposed sleeve" (Opening Brief at 3). This description is inaccurate in two respects. First, it is not apparent from the drawings that the centrally disposed element in question is a sleeve. Second, the stabilizing function is entitled to no weight because "a design patent only protects the ornamental aspects of the design." OddzOn Products Inc. v. Just Toys Inc., 122 F.3d 1396, 1404, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997). Consequently, we would characterize the feature in question as a V-shaped configuration of the tightening strap on the outside of the

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back portion of the belt, with the legs of the V extending from opposite sides of a small centrally disposed rectangular element having a vertical dimension slightly greater than the width of the strap.

The examiner explains the case for obviousness as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to made to modify Yewer, Jr. by providing it with the overlapped contoured belt . . . as taught by Schiek, Sr., and the rear tab as taught by Glover et al[.] to obtain essentially the herein disclosed and claimed design. [Answer at 4.]

Appellant's position is that

modification of Yewer with selected, dissected elements of Schiek and Glover et al. would destroy the belt disclosed by Yewer in that a majority of the features of Yewer must be modified. These modifications clearly destroy the fundamental characteristics of the design of the Yewer belt. [Opening Brief at 8.]

We agree with appellant and therefore hold that Yewer is not a proper primary reference, which is reason enough to reverse the rejection. Rosen, 673 F.2d at 391, 213 USPQ at 350.

Nevertheless, we have also considered whether the collective teachings of the references yield the claimed design. As evidence of the obviousness of using appellant's V-shaped

configuration for the tightening strap at the rear portion of the belt, the examiner relies on Glover's straps 43 and 45 (Fig. 2),<sup>3</sup> which extend in a V-formation from opposite sides of a vertical strap 38 (apparently incorrectly identified in the Answer as "a central tab 47").<sup>4</sup> We agree with appellant that

even if one accepts the Examiner's position that Glover et al. disclose[s] the rear tab to be old in the art, one would not know which elements to select from the secondary references or how to modify such elements for incorporation into the belt of the primary references (or which elements to discard as unused features of the references) to arrive at the claimed design, absent hindsight teaching. [Opening Brief at 4-5.]

The reason is that Glover's straps 43 and 45 do not correspond to Yewer's webbing strap 12, which is the element to be modified; instead, Glover's static belt 20 does.<sup>5</sup> As a result, we are not persuaded that one skilled in the art would have been motivated to apply the V-shaped configuration of

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<sup>3</sup> Answer at 5.

<sup>4</sup> Numeral 47 refers to the point of the V-shaped projection 41 formed by straps 43 and 45 (Glover, col. 4, lines 36-40).

<sup>5</sup> We note that the rear portion of Glover's static belt 20 is in the shape of an inverted V.

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Glover's straps 43 and 45 to Yewer's webbing strap, let alone with the legs of the V extending from opposite sides of a centrally disposed rectangular element having a vertical dimension slightly greater than the width of the strap, as in the claimed design.

Because we are reversing the rejection for the foregoing reasons, we need not decide the merits of appellant's argument that his design is also patentable over the cited references

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because the rear portion of his belt is wider than the overlapping end portions.

**REVERSED**

JOHN P. McQUADE	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN C. MARTIN	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	

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