

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT E. RASMUSSEN

Appeal No. 98-0070
Application 29/019,900¹

ON BRIEF

Before LEE, TORCZON and CARMICHAEL, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of the claimed storage pen design.

References relied on by the Examiner

Miscoe	3,404,818	Oct. 08, 1968
Allen, Davis & Co. Ltd. (Allen) (British Patent)	GB 693,826	Jul. 08, 1953
Unilever (Danish Patent)	DK 105,325	Dec. 05, 1966

¹ Application for design patent filed March 14, 1994.

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The Rejections on Appeal

The design claim is rejected under 35 U.S.C. § 103 as being unpatentable over Allen and Unilever.

The design claim is also rejected under 35 U.S.C. § 103 as being unpatentable over Miscoe.

The Invention

The invention is directed to the ornamental design of a storage pen. Figure 1 of the claimed design is reproduced below:

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Opinion

We do not sustain the rejection of the design claim over Allen and Unilever.

We also do not sustain the rejection of the design claim over Miscoe.

The rejection based on Allen and Unilever

In an obviousness rejection of a design claim, there must be a reference which discloses essentially the same basic design as that claimed in order to support a holding of obviousness. In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). In our view, the examiner is incorrect in regarding Allen as a "Rosen" reference. As is pointed out by the appellant, the claimed design is characterized by four substantially rectangular compartments wherein the longer dimension of the compartments is aligned in parallel to the longer dimension of the rectangular peripheral wall. Allen's design shows alignment in the other direction, and appears substantially different from the appellant's claimed design. The rejection based on Allen as the

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"Rosen" reference cannot stand.

Unilever shows four square compartments, and the Examiner did not regard it as the basic "Rosen" reference for this

rejection. Thus, we need not address that alternate scenario. Our discussion is limited to the rationale on which the rejection was actually based. We decline to introduce a new or alternate rationale in the first instance on appeal. Also, it should be noted that the examiner has failed to account for the appearance of the transverse partition between the compartments of the claimed design.

For the foregoing reasons, we do not sustain the rejection based on Allen and Unilever.

The rejection based on Miscoe

We reject the appellant's argument that the examiner rejected the claimed design based on a single top plan view illustrated in Miscoe. The entire description pertaining to the embodiment corresponding to Miscoe's Figure 3 was the basis of the examiner's rejection. Note that in column 2, lines 1-3 and 9-18, Miscoe contains discussions about the Figure 3 embodiment.

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We do not sustain this rejection, because we disagree with the examiner's account of the design feature on the internal partition between the compartments. In the appellant's claimed design, one segment of a transverse partition has a double-lined appearance. In our view, this gives the overall design a

distinctively different appearance relative to that of Miscoe. We reject the examiner's position that the double-in-part transverse partition is primarily functional. If structural integrity were the real issue, there is little reason to strengthen only one segment of the partition, and a thicker segment without the double panel/lining look would serve just as well. While it is true that a patentable design must have an unobvious appearance distinct from that dictated solely by functional considerations, Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188, 5 USPQ2d 1625, 1627 (Fed. Cir. 1988), we do not regard the internal partition feature at issue as being dictated solely by functional considerations. We reject, however, the appellant's contention that patentable distinction also stems from (1) the ratio between the height of the compartments and the

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enclosed floor space, and (2) the presence of hinges in Misco's storage pen. In our view, the height of the compartments as well as the use of hinges is dictated solely or at least primarily by functional considerations of a storage pen.

For the foregoing reasons, we do not sustain the rejection of the claimed design over Miscoe.

Conclusion

The rejection of the design claims over Allen and Unilever is reversed.

The rejection of the design claim over Miscoe is also reversed.

REVERSED

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JAMESON LEE)	
Administrative Patent Judge)	
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RICHARD TORCZON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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Cumpston & Shaw
2 State Street
Suite 850
Rochester, NY 14614