

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. CASTIGLIONE

Appeal No. 99-0065
Application No. 29/051,335¹

ON BRIEF

Before CALVERT, ABRAMS, and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed February 20, 1996. According to appellant, this application is a continuation of Application No. 29/029,750 filed October 14, 1994, now abandoned.

This is an appeal from the final rejection of the following design claim:

The ornamental design for a NOSE CLIP for a filtering face mask, as shown and described.

The design is depicted in two front perspective views (Figures 1 and 6), and in front, top, side and bottom elevational views (Figures 2-5).

THE REFERENCE

The sole reference cited by the examiner is:

Castiglione	5,558,089	Sept. 24,
1996		

THE REJECTION

The design claim stands rejected under 35 U.S.C. § 171 as being directed to non-statutory subject matter in that it lacks ornamentality.

The rejection is explained in the Examiner's Answer (Paper No. 15).

The opposing viewpoints of the appellant are set forth in the Brief (Paper No. 14) and the Reply Brief (Paper No. 16).

OPINION

It is the examiner's opinion that the appearance of the design is the result of functional concerns rather than ornamentality, and therefore it is not in accordance with the requirements of 35 U.S.C. § 171. As support for this position, the examiner cites the appellant's utility patent (Castiglione) "which describes the functional aspects of a nose clip, of which the claimed design is one embodiment" (Answer, page 3), explaining that "to be patentable, a design *must* be created for the purpose of ornamenting an article of manufacture" (Answer, page 3). Because of the explanations provided in Castiglione regarding the reasons for the shape of the nose clip, the examiner opines that the design "was not created for the purpose of ornamenting and not motivated by thought of ornament," and concludes that a *prima facie* case is established that the claimed design does not conform to Section 171 (Answer, page 5). This, the examiner goes on to state, has not been rebutted by evidence from the appellant which might establish "that the intent behind the creation of the nose clip was ornamental" (Answer, page 5).

Essentially for the reasons set forth by the appellant in the Brief and the Reply Brief, we do not agree with the examiner's conclusion.

The guidance provided by our reviewing court on this issue is whether other designs could be used, that is, whether there are other ways to achieve the function of the article. That the design of an article is related to its functional use may not defeat patentability; to qualify for design patent protection a design must have an ornamental appearance that is not dictated by function alone. See, for example, *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1459, 43 USPQ2d 1887, 1890 (Fed. Cir. 1997) and *Barry Sterling Corp. v. Pescor Plastics Inc.*, 122 F.3d 1452, 1455, 43 USPQ2d 1953, 1956 (Fed. Cir. 1997). The appellant has pointed out that Castiglione discloses in Figures 3a-3c other designs of nose clips as alternatives to the one of Figure 3, which accomplish the same objectives. We also note that the Castiglione specification sets out ranges of angles, lengths and thicknesses which deviate from those shown in the claimed design, the application of which would give rise to designs other than the claimed

design. Furthermore, from our perspective, it is clear that designs other than that of the claimed design, such as ones with widened end portions, for example, could be utilized within the functional objectives and the scope of the claims of the referenced patent. It therefore is our view that Castiglione buttresses the appellant's position, rather than the examiner's.

It is our conclusion that the claimed design is not dictated solely by functional considerations and therefore does not run afoul of 35 U.S.C. § 171. This being the case, we will not sustain the rejection.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Karl G. Hanson
3M Office of Intellectual Prop Counsel
P.O. Box 33427
St. Paul, MN 55133-3427