

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAMI TANIGUCHI and YOSHIHIKO TANAKA

Appeal No. 1999-0356
Application 29/050,057 Design

ON BRIEF

Before JERRY SMITH, LALL and DIXON, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim under 35 U.S.C. § 103:

The ornamental design for a TONER CARTRIDGE as shown and escribed.

The following reference is relied upon by the examiner as evidence of obviousness in support of the rejection:

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Taniguchi et al. (Taniguchi)
10, 1994

D 346,819

May

The appealed design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Taniguchi.

We have carefully reviewed the entire record, including all of the arguments advanced by the examiner and appellants. This review leads us to conclude that the examiner's § 103 rejection is not well-founded. Accordingly, we will not sustain the examiner's § 103 rejection for substantially the reasons set forth in the brief. We add the following primarily for emphasis.

In rejecting the appellants' design claim, the examiner concedes that Taniguchi does not show an identical shape, but contends that the difference between the claimed design and the applied prior art is unpatentable. The Examiner asserts [answer, page 5] that she "believes she has found a Rosen reference in Taniguchi." The Examiner further states [id. 5] that "[the overall appearance of the subject design is very similar to the overall appearance of the [Taniguchi] reference."

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The appellants argue [brief, page 7] that "the Final Action admits the left side wall of the claimed design is different from that in Taniguchi." The appellants further argue [id. 8] that "[i]n order for the differences to be obvious, there must be some

motivation to make the change; the motivation can be in the form of a secondary reference or within the general knowledge of the designer who designs articles of the type at issue." The appellants contend that "[the Office Action offers no motivation for a designer to modify the reference in a manner which would yield the claimed invention."

We next review the applicable laws and cases. "In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of

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ordinary skill who designs articles of the type involved. See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based on a combination of references, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may

reasonably be interchanged with or added from those in other pertinent references, when such references are "so related that the appearance of certain ornamental features in one would

suggest the application of those features to the other." See In re Rosen, 673 F.2d at 391, 213 USPQ at 350 (CCPA 1982); In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956); In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). If, however, the combined teachings of the applied references suggest only components of the claimed design, but not its overall appearance, an obviousness rejection is

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inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987).

In the instant case, whereas we agree with the Examiner that there is a similarity between the designs of the Appellants and the reference, however, the two designs are substantially different in appearance. Specifically, Figs. 7 to 9 of the claimed design look substantially different from the design of the second embodiment of Taniguchi (Figs. 8 to 14) which is employed in the final rejection. For example, the left side of the claimed design (Figs. 7 and 8) is provided with special

curves for a particular appearance whereas the corresponding left side of Taniguchi's design (Fig. 14) has no hint of any curve, but instead is provided with a uniformly sloping planar surface. We are of the view that the examiner has not provided any evidence, in the form of either a secondary reference or a logical reasoning, which would make the claimed design obvious. Furthermore, the Federal Circuit has stated that "[the] mere fact that the prior art may be modified in the

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manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 311-313 (Fed. Cir. 1983). Here, we do not find basis for the Examiner's assertion that the differences between the claimed design and that shown by the

reference are obvious. Therefore, we do not sustain the rejection over Taniguchi.

REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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