

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUTOMU HARUNA
and SADAO KITA

Appeal No. 1999-2020
Application D-29/058,031¹

HEARD: DECEMBER 6, 1999

Before THOMAS, LALL, and GROSS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of the following design claim:

The ornamental design for a pre-recorded optical

¹ Application for patent filed August 6, 1996.

Appeal No. 1999-2020
Application D-29/058,031

disk, as shown and described.

The examiner has relied upon the following reference:

Benne et al. (Benne) 4,747,093 May 24, 1988

The design claim stands rejected under 35 U.S.C. § 103.
As evidence of obviousness, the examiner relies upon Benne
alone.

We refer to the briefs and the answer for the respective
positions of the appellants and the examiner.

OPINION

Having considered the obviousness issue raised in this
appeal in light of the teachings of the applied prior art and
in light of the examiner's remarks and appellants' arguments,
it is our conclusion that the examiner's rejection of the
present design claim must be affirmed.

"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

Appeal No. 1999-2020
Application D-29/058,031

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 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 for a § 103

rejection,

there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design:

Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.

Rosen at 673 F.2d 391, 213 USPQ 350.

Appellants' summary of the invention at pages 2 through 4 of the brief discusses and depicts in part the nature of the prior art, conventional pre-recorded optical disks such as

CDs. Much of what is conventional in prior art CDs is also discussed in Benne. Generally speaking, prior art optical disks are primarily opaque and non-reflective when viewed from the printed top side, and opaque and reflective when viewed from below. This opaqueness and reflectiveness on the respective sides in most prior art CDs generally extends substantially the full radial extent or the diameter of the CD.

Whereas a relatively narrow, approximately three millimeter, extreme outer annular region of a conventional CD is unmetallized and transparent, the present claimed invention presents a relatively wide annular transparent region of the overall disk in its outer radial region. As discussed in the paragraph bridging pages 3 and 4 of the brief, the present invention relates to disks of relatively short music or information duration that can be accommodated on a full diameter disk rather than on a relatively narrower diameter disk in which the prior art also presents pre-recorded singles or the like. Thus, it is apparent that the appellants have used a conventional diameter

CD to present a relatively short music or information track rather than do so on the smaller prior art disk. Benne in part is also concerned with such limited information content CDs as indicated at least at column 5, lines 21 through 33 and in the latter portions of column 8. Benne is also concerned with the overall visual appearance of the CD as a whole as discussed in the summary of the invention at column 2, as well as the last two paragraphs of column 8.

Figures 1 and 2 of Benne appear to be the most pertinent to the issue at hand. The corresponding outer zone A depicted in Figure 1 is most analogous to the subject matter of the characterization feature of the claimed invention before us. Figure 2 and the discussion thereof at column 5 depicts different approaches to achieve Benne's aims. In this respect, appellants have fairly described in the brief the subject matter of Benne in that this region A generally has disposed within or on it a matte finish or some other light-diffusing or light-absorbing imprint for purposes of concealing defects within that region, such as would be visible when a limited content CD is made and the radial

extent of printing or imprinting or the reflective material containing the data content does not extend the full radial extent of the conventional sized disk. Note, for example, the discussion in association with Figure 2 at column 3, lines 31 through 37 of Benne. Appellants' earlier noted discussion of the conventional disk structure in the summary of the invention in the brief, as well as the background portion of Benne at column 1, both confirm that the entire prior art substrate material comprising conventional disks is transparent.

We agree with the examiner's conclusion of obviousness of the certain matter of the present design claim on appeal in light of Benne. We again make reference to Benne's Figure 1 and Figure 2 and the discussion of Figure 2 at column 5, lines 41 through 68 which indicate that, according to the exemplary regions depicted in Figure 2 and discussed in this noted portion of Benne, the respective outer zone A or any zone may have any color imprinted thereon. This is confirmed at column 8, lines 54 through 68 of Benne.

As a matter of design case law, transparency appears to

Appeal No. 1999-2020
Application D-29/058,031

be considered a color. In re Cohn, 80 F.2d 65, 27 USPQ 412 (CCPA 1935) concerns a design consisting of a cellulosic ribbon, with a preferably transparent center portion; the edges of the ribbon were said to be a different color than the center portion and may be either transparent, translucent, or opaque. In applying prior art the court observed that alternating stripes of colors arranged in the manner claimed were sufficiently shown by the applied prior art. Novelty was alleged to be in the appearance of the transparent ribbon with colored edges. As such, it was contended that such a design was entirely different in appearance from anything heretofore shown by the art. The court observed at 27 USPQ 413 that:

It cannot be successfully argued that patentability of a design may rest on color alone.

The court concluded its discussion as follows:

The fact that the design here presented shows a transparent portion rather than a stripe of different color, as it seems to us, creates no patentable novelty in the design. The fact that the material upon which the design is placed is in this case transparent, while it may create a more pleasing and beautiful effect, is indistinguishable in principle from a case where the material upon which the design was placed is translucent or opaque.

What is apparent here is that the underlying substrate material in Cohn was transparent, the only variation being the manner or extent in which the stripe of any color was displayed on this transparent portion. Stated differently, the patent-ability of the design in effect resided upon the extent to which the underlying substrate "color" was revealed.

A similar observation is present in the instant claim on appeal where a conventional transparent substrate material for a pre-recorded optical disk was admitted by appellants to be known in the art as well as recognized and taught in Benne. Generally speaking, the same radial extent of the colored and transparent regions of the claimed invention are present in Figures 1 and 2 of Benne as well. Thus, the underlying nature of the disk substrate being transparent is presented in a specific location and to specific or general radial extent as compared with the known prior art disk represented by Benne. Indeed, Benne confirms that prior art disk substrates are transparent and have a reflective coating to any radial extent thereon generally visible on one side and/or a colored or

Appeal No. 1999-2020
Application D-29/058,031

matted surface to any radial extent thereof generally visible on the other side of the disk in the manner claimed. Again, it is emphasized that the

same radial extent to which the transparent region is visible in the claimed invention is shown to exist in the prior art Figures 1 and 2 of Benne.

The basic rubric of Cohn that patentability of a design may not rest on color alone is repeated and followed in In re Iknayan, 274 F.2d 943, 944, 124 USPQ 507, 508 (CCPA 1960).

The court went on to indicate that a design claim distinguishing over a reference only on the basis of coloring was properly rejected since selection of a different color would not have provided any basic alteration or unexpected appearance. It is further emphasized here that the presently claimed design on appeal presents no different shaped pre-recorded optical disk in the claim on appeal than that admitted and known in the prior art represented by Benne. Appellants' claimed design merely exposes what is already there anyway to the same extent known to exist in the prior

Appeal No. 1999-2020
Application D-29/058,031

art as shown by the radial distance in Figures 1 and 2 of Benne. That is, appellants' design merely exposes the underlying prior art transparent nature of the substrate on which the claimed design and the admitted and known prior art designs in Benne are illustrated.

On the other hand, we observe that the Board reversed a rejection under 35 U.S.C. § 103 where the claimed design was made of transparent material but which had roughened surfaces which were determined to produce the unobvious claimed ornamental appearance on its edges in Ex parte Widdowson, 195 USPQ 463, 464 (Bd. App. 1976). The Board also agreed with the examiner "that use of a transparent material would be prima facie obvious since a designer of ordinary skill could reasonably be expected to visualize in advance what ornamental appearance the card stand of the Clawson patent would have if made of transparent members."

As noted earlier, even though we recognize as urged by appellants that Benne generally indicates that the A region of Figures 1 and 2 may be considered as generally not transparent, the earlier noted portions of Benne indicate that

Appeal No. 1999-2020
Application D-29/058,031

any color may be utilized in that region. There is no difference in shape between the applied prior art and the claimed invention. The existing state of the law appears to compel a conclusion that transparency is a form of coloring and therefore obvious within 35 U.S.C. § 103 for designs. We affirm the examiner's rejection of the design claim on appeal.

Appeal No. 1999-2020
Application D-29/058,031

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

AFFIRMED

	JAMES D. THOMAS)	
	Administrative Patent Judge)	
)	
)	
	PARSHOTAM S. LALL)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	ANITA PELLMAN GROSS)	
	Administrative Patent Judge)	

Appeal No. 1999-2020
Application D-29/058,031

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Appeal No. 1999-2020
Application D-29/058,031

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