

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS KENNEDY
and BRIAN FEENEY

Appeal No. 2000-0658
Application 29/084,939

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
COHEN, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Thomas Kennedy et al. appeal from the final rejection of the following claim for an ornamental design:

The ornamental design for a CONVEX BUBBLE BAT as

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shown and described.

Drawing Figures 1 through 4, copies of which are appended hereto, show the claimed bat design to embody a cylindrical barrel portion having a relatively large diameter, a cylindrical handle portion having a relatively small diameter, a knob at the free end of the handle portion, and a tapered transition portion and convex bubble between the barrel and handle portions.

The claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. Des. 344,777 to Lo.

Lo discloses a baseball bat design having a tapered barrel portion, an oppositely tapered handle portion, a knob at the free end of the handle portion, and a convex bubble between the barrel and handle portions.

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. In re Rosen,

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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 of the articles involved. In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). As a starting point, there must be a reference, a something in existence, the design characteristics of which are basically the same as those of 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. In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993); In re Rosen, *supra*. De minimis changes which would have been well within the skill of an ordinary designer in the art do not create a patentably distinct design. In re Carter, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982) (see also In re Cooper, 480 F.2d 900, 902, 178 USPQ 406, 408 (CCPA 1973); and In re Lapworth, 451 F.2d 1094, 1096, 172 USPQ 129, 131 (CCPA 1971)).

The examiner's determination (see page 4 in the answer, Paper No. 11) that the bat design disclosed by Lo satisfies the so-called Rosen requirement for something in existence

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having design characteristics basically the same as those of the claimed design is reasonable on its face, and has not been specifically challenged by the appellants. The appellants, however, do dispute (see pages 3 through 6 in the brief, Paper No. 10) the examiner's conclusion (see pages 4 and 5 in the answer) that the differences between the claimed and Lo designs involve de minimis changes which would have been well within the skill of the ordinary designer and do not patentably distinguish the claimed design from the prior art.

The contrasts between the claimed design and that disclosed by Lo are perhaps best illustrated by comparing Figure 1 of the appellants' drawings and Figure 2 of Lo's drawings, both of which show front elevational views of the respective bat designs. From our perspective, the dissimilarities embodied by the cylindrical shape of the barrel and handle portions of the claimed design versus the tapered shape of the barrel and handle portions of the Lo design, the relative lengths of the barrel and handle portions of the claimed design versus the relative lengths of the

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barrel and handle portions of the Lo design, and the shape and relative position of the convex bubble of the claimed design versus the shape and relative position of the convex bubble of the Lo design imbue the claimed design with an overall appearance which differs significantly from that of the Lo design. Thus, the differences between the two designs cannot be dismissed as involving merely de minimis changes. Inasmuch as the examiner has failed to advance any evidentiary basis to support a conclusion that the above noted differences are such that the claimed design as a whole would have been obvious at the time the invention was made to a designer of ordinary skill, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of the appealed claim as being unpatentable over Lo.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)

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IRWIN CHARLES COHEN
Administrative Patent Judge

INTERFERENCES

JOHN P. McQUADE
Administrative Patent Judge

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