

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

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERMENEGILDO NOSELLA

Appeal No. 2000-2151
Application No. 29/099,783

ON BRIEF

Before HAIRSTON, NASE, and TIMM, *Administrative Patent Judges*.
TIMM, *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 COSMETIC BOTTLE, as shown and described.

The design is depicted in a perspective view, a side elevation view (the other side elevations being the same except for the conventional screw threading on the bottle neck), a bottom view and a top view in Figures 1 through 4, respectively.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Goncalves (French Patent ¹)	2,578,403	Sep. 12, 1986
Fenton et al. (Fenton)	D378,665	Apr. 1, 1997

Avon Catalog, Campaign 26, 1988, page 11, “Sunsparklers Nail Enamel” bottle (Sunsparklers bottle).

The appealed design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over the French Patent in view of the Sunsparklers bottle and Fenton. We reverse for the reasons that follow.

OPINION

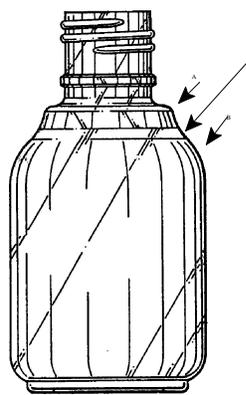
“In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration.” *In re Rosen*, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). In ornamental design cases, a proper obviousness rejection based on a combination of references requires that the visual ornamental features (design characteristics) of the claimed design appear in the prior art in a manner which suggests such features as used in the claimed design.” *In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). “If,

¹A translation of the French Patent is enclosed.

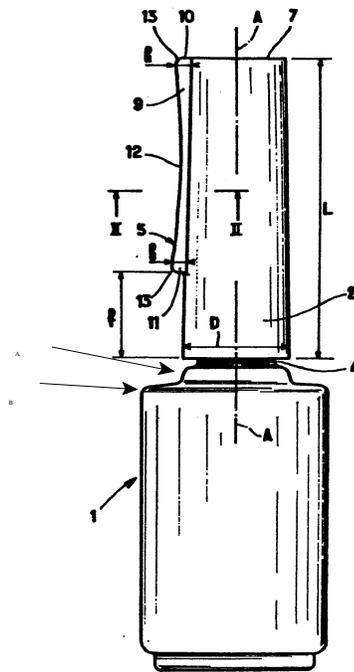
however, the combined teachings suggest only components of a claimed design, but not its overall appearance, an obviousness rejection is inappropriate.” *Id.*

We agree with the Appellant that the overall visual impression created by the claimed bottle is not suggested by the applied prior art (Brief, page 3).

The primary reference, i.e. the French Patent, depicts a bottle with a stepped down transition from the cylindrical neck to the cylindrical side wall. The “steps”, i.e. what the Examiner calls the tapered portion “A” and the shoulder “B” (Exhibit A), differ from the curved and transitions on Appellant’s claimed bottle.



Appellants’ Bottle



French Patent Bottle

side wall. The “steps”, and curved neck (Answer, page 6, more rounded Appellant’s claimed

We particularly note the the conical neck portion A and i.e. the portion we have denoted transition region is substantially depicts a convex curve of small portion and the shoulder.

In order to justify the applies the Sunsparklers bottle. Sunsparkler bottle appears to be note that the cover restricts the view of the intersection of the shoulder with the neck and thus the design of that portion is unclear.



Sunsparklers Bottle

gradually sloping transition region between the rounded shoulder B of Appellant's bottle, as "C" above. This neck portion-shoulder conical. In comparison, the French Patent radius of curvature between the conical neck rounding of the shoulder, the Examiner As noted by Appellant, the shoulder of the a simple, single convex curved shape. We

We agree with the Appellant that there is no motivation to replace the shoulder B of the French patent with the rounded shoulder of the Sunsparklers bottle (Brief, page 3). We also agree that even if a designer of ordinary skill were to attempt to make the modification, one would not arrive at a shoulder which is visually similar to that disclosed by the invention (Brief, pages 3 and 4). Note particularly that the conical portion we have labeled “C” is not depicted in either reference. Nor is this aspect of the design depicted in Fenton, the reference cited by the Examiner to show the conventional threaded neck portion of the bottle.

As an aside, we note that neither any evidence nor any argument has been presented with respect to the appearance of the bottom of the bottle as shown in Figure 3. The Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It is possible that the features depicted on the bottom lack ornamentality because they are the result of, or a by-product of, functional or mechanical considerations. *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

However, such a finding has not been made by the Examiner.

CONCLUSION

To summarize, the decision of the Examiner to reject the design claim on appeal under 35 U.S.C. § 103 is reversed.

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