

Ex parte Baschmakoff

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

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PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte THIERRY DE BASCHMAKOFF

Appeal No. 96-1117  
Design Application 29/019,875<sup>1</sup>

HEARD: March 4, 1997

Before COHEN, BARRETT, and CRAWFORD, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

Appellant appeals from the final rejection of the claim in this design patent application.

<sup>1</sup> Application for design patent filed November 30, 1992, which is a continuation of Design Application 29/002,141, filed November 30, 1992, now abandoned.

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The sole claim reads:<sup>2</sup>

The ornamental design for a combined bottle and stopper as shown and described.

The claimed design is considered to be the bottle and stopper in the assembled condition, as shown in figures 1-5.<sup>3</sup> Because the design is to a combined bottle and stopper, the separated parts in figures 6 and 7 have been required to be bracketed (Paper No. 4) as in figure 9.

The characteristic features of the design as perceived by appellant are summarized as follows (Brief, page 3):

There is a characteristic and unique visual impression afforded by the upper portion of the container, the neck of the container and the stopper characterized by the square shoulders of the container, the recessed and smallish nature of the neck and the successive and cooperating relation of the stepped surfaces of the neck

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<sup>2</sup> The claim is shown as amended by the amendment filed June 28, 1995 (no paper number), with the Brief (Paper No. 13). This amendment has not officially been entered in the file wrapper and examiner does not comment on the status of this amendment after final rejection in the Examiner's Answer. We note that the claim in the original specification filed November 30, 1992, has been amended as shown, indicated to be per amendment A, which is the Examiner's Amendment attached to the Notice of Allowability in the parent '141 application (Paper No. 4). However, we find no corresponding amendment in the Examiner's Amendment. We treat the June 28, 1995, amendment as if entered in view of the examiner's intent in Paper No. 4, but note that there should be a formal entry of the amendment.

<sup>3</sup> The examiner states that "[t]he invention is shown in Figures 1 through 4 in the drawings" (Examiner's Answer, page 1). The perspective view in figure 5 also shows the assembled bottle and stopper and, hence, the claimed design. The exploded views in figures 6-9 appear to be superfluous to the claimed design.

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and the mushroom shape of the stopper. The annular peripheral edge of the mushroom head is intended to have the impression of being suspended with respect to the neck portion and the differences in diameter of the stepped neck and stopper portions with the protruding annular lip are intended to provide the reverse of the mushroom configuration of the stopper.

#### THE REFERENCES

The Examiner relies on the following references:

Walton                      Des. 259,332              May 26, 1981

Spanish design              90,050                  August 1977

Whitall, Tatum & Co. Catalog, 1907, page 6 stoppers #712, #711, and #723 (hereinafter "Whitall").

#### THE REJECTION

The claim stands rejected under 35 U.S.C. § 103 as unpatentable over the Spanish patent, Whitall, and Walton. The Examiner's position is as follows (Examiner's Answer, pages 2-3):

The Spanish patent discloses a bottle that is quite similar to the claimed design, differing essentially in the closure and in the neck finish.

The Whitall, Tatum & Co. Catalog discloses a stopper, item # 712, that is similar to the one employed herein. The Whitall, Tatum & Co. Catalog, items #711 and #723 show the conventionality of a flange around the base of a stopper.

The ancillary patent to Walton was cited merely to show that the neck finish used by applicant is old in the analogous art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Spanish patent bottle by substituting a stopper like

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item #712 in the Whitall Tatum catalog. To merely provide a bead around the top of the bottle neck and a bead around the base of the stopper are obvious modifications as readily suggested by the Whitall, Tatum & Co. Catalog stoppers #711 and #723 and the patent to Walton. Moreover, to make these modifications to the Spanish reference would result in a combined bottle and stopper that is strikingly similar to the claimed design and no patentable ornamental advance is seen thereover.

#### OPINION

We reverse.

#### Legal standards

The relevant standards for determining obviousness of a claimed design are summarized in In re Borden, 90 F.3d 1570, 1574-75, 39 USPQ2d 1524, 1526-27 (Fed. Cir. 1996), which we briefly highlight.

The central inquiry is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784-85 (CCPA 1981).

In order for a design to be unpatentable for obviousness, there must first be a basic design reference in the prior art, "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." In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

In order for designs of other references to be considered, there must be some suggestion in the prior art to modify the

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basis design with features from the secondary references. Id. That is, the teachings may be combined only when the designs are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). As stated in In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993):

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. If, however, the combined teachings suggest only components of a claimed design, but not its overall appearance, an obviousness rejection is inappropriate. [Citations omitted.]

#### Factual findings

The Spanish design entitled "Bottle" ("Un envase") shows a bottle and a cap intended to be screwed onto the neck of the bottle. The bottle is cylindrical and has two flat inclined planar surfaces at its upper end, which intersect at an acute angle along the center and which each form a curved intersection with the cylindrical body. A cylindrical neck having threads intersects the intersection line of the two planar surfaces. The cap, which is illustrated separated from the bottle, is a relatively thick planar solid viewed from the side with parallel horizontal top and bottom surfaces and a vertical edge between the top and bottom surfaces. The cap has

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the shape of an equilateral triangle with rounded corners in the top view. The cap has a small, projection centered on its bottom surface slightly larger than the diameter of the neck. The cross-section markings show that the neck screws fully into the cap, so the neck is almost entirely concealed by the cap.

The top of stopper #712 in Whitall is generally similar in appearance to the upper portion of the stopper of the claimed design in having a flat cylindrical top although the stem portion is flared out toward the stopper and out toward the top instead of just toward the top as in appellant's stopper.

Walton discloses a bottle design with a lip around the top of the cylindrical neck.

#### Obviousness conclusion

It would have been helpful to us if appellant had analyzed the rejection according to the modern design case law principles set forth by the examiner. Nevertheless, after a de novo review it is our opinion that the rejection fails to establish a prima facie case of obviousness.

First, we consider whether the Spanish design constitutes a Rosen reference. The legal test for obviousness requires that the basic design reference, the Rosen reference, be for the claimed invention, the combined bottle and stopper. The elements of bottle and stopper which make up the overall design are not independent segregable parts, the obviousness of which

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can be addressed separately. We understand the Spanish design relied upon by the examiner to be the combined bottle and screw-on cap, i.e., the design resulting from the cap having been screwed onto the bottle. This is evident from the examiner's statement of the rejection which is based on substituting a stopper (Examiner's Answer, pages 3 and 5).

Comparing the assembled bottle and cap in the Spanish design to the claimed bottle and stopper, we conclude that the Spanish design is not a Rosen reference because it does not have basically the same overall appearance as the claimed design. In the Spanish design, the large cap with its prominent triangular shape screws down close to the top of the bottle covering the neck and dominating the appearance of the top of the bottle. We perceive significant differences between the overall visual appearance of the Spanish design vis-à-vis the claimed design, because in the claimed design: (1) the cylindrical neck and the stopper in the neck opening are plainly exposed; (2) the stopper has a mushroom shape with a relatively small diameter cylindrical top suspended high above the body; (3) the neck and stopper meet in a series of recesses and stepped lips; and (4) the flat surfaces of the shoulders where the inclined planes meet is a distinctive characteristic of the appearance not found in the Spanish design.

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However, assuming, arguendo, that the Spanish bottle is a Rosen reference, the question is whether it would have been obvious, in a design sense, to combine the stopper in Whitall with the Spanish bottle. The examiner's position is, apparently, that it would have been obvious to the ordinary designer to combine any stopper, such as those in Whitall, with the Spanish bottle. In our opinion, the examiner fails to establish a prima facie case of obviousness.

The examiner applies an inappropriate utility patent analysis in concluding that it would have been obvious to substitute a stopper for the cap in the Spanish design. The fact that it may have been obvious in a utility sense to substitute a stopper for a screw-on cap says nothing about the obviousness of the design of the claimed bottle and stopper. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1664 (Fed. Cir. 1987) ("The design of every bottle cap having a recessed flap would not necessarily have been obvious because it would have been obvious to construct caps having recessed flaps.").

We also find no suggestion in the prior art to combine the references and their visual ornamental features. See Harvey, 12 F.3d at 1064-65, 29 USPQ2d at 1209 ("The CCPA held in In re Glavas, 230 F.2d at 451, 109 USPQ at 53, that the Board erroneously rejected an application for a design patent where the component features of the claimed design were all found in



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