

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANKLIN B. MORSE, JR. and RICHARD L. HINKLE

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Appeal No. 98-0919  
Application 29/042,395<sup>1</sup>

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ON BRIEF

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Before CALVERT, GARRIS and HAIRSTON, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of the claim in appellants' design application.

The claim reads: The ornamental design for a "ROD HOLDER", as shown.

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<sup>1</sup>Application for patent filed August 9, 1995.

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The references applied in the final rejection are:

Cummings	4,235,409	Nov. 25, 1980
McLean	4,658,534	Apr. 21, 1987

The claim stands finally rejected under 35 USC § 103 as unpatentable over Cummings in view of McLean.

The examiner states the basis of the rejection as  
(answer, page 4):

The overall appearance of [the] claimed design is substantially disclosed by Cummings (Items 18, 20, 22), except for a bend at a 45 degree angle, a head on the stake, tapered lower end, and the fact that it is attached to a surface.

McLean discloses a free-standing rod holder with a straight stake with a head on top and tapered lower end--like [the] claimed design--to be notoriously old in the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cummings by removing it from the surface, as taught by McLean, straightening the bend in the stake, adding a head to the top and tapering the lower end, as disclosed and taught by McLean, in order to obtain substantially the herein disclosed and claimed design.

In determining whether a claimed design would have been obvious, Durling v. Spectrum Furniture Co., 101 F.3d 100, 103, 40 USPQ2d, 1788, 1790 (Fed. Cir. 1996), states:

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Before one can begin to combine prior art designs however one must find a single reference, "a something in existence, the design characteristics of which are basically the same as the claimed design." In re Rosen, 673 F.2d [388,] 391, 213 USPQ [347,] 350 [(CCPA 1982)]. Once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). These secondary references may only be used to modify the primary reference if they are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other." In re Borden, 90 F.3d [1570,] 1575, 39 USPQ2d [1524,] 1526-27 [(Fed. Cir. 1996)].

Appellants contend that Cummings does not constitute a so-called "Rosen reference". We agree. In our view, the rod holder disclosed by Cummings does not have basically the same design characteristics as the design here claimed. In particular, we consider that the bend in Cummings' rod 18, and the base plate 16 at the lower end of the rod, together cause the visual effect as a whole of the Cummings holder not to be "basically the same" as the visual impression created by appellants' claimed design.

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Accordingly, since Cummings is not a "Rosen reference",  
secondary references such as McLean cannot properly be used to

modify it to create a design with same overall appearance as  
that  
claimed herein. The rejection will therefore not be  
sustained.

The examiner's decision to reject the claim is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
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KENNETH W. HAIRSTON                    )  
Administrative Patent Judge        )

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