

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT V. LYNCH

Appeal No. 98-2105
Design Application 29/052,205¹

HEARD: August 5, 1998

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

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim under 35 U.S.C. § 103:

The ornamental design for an angled shaft for a putter as shown and described.

¹ Application for design patent filed March 26, 1996.

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The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under § 103:

Hyde	3,066,936	Dec. 4, 1962
Lombardo	5,409,220	Apr. 25, 1995

The appealed claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Hyde in view of Lombardo. The examiner considers Hyde to be a Rosen reference² and takes the following position:

It would have been obvious to a designer of ordinary skill in the art at the time the invention was made to have modified the basic shaft of Hyde by having a more acute angled shaft as disclosed by Lombardo; to do so would have resulted in an article substantially similar in overall appearance as appellant's claimed design. [Answer, page 3].

In support of patentability, appellant argues that Hyde is not a Rosen reference because it does not create the same basic visual impression as appellant's design. In addition, appellant

² See In re Rosen, 673 F.2d 388, 213 USPQ 347 (CCPA 1982).

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contends in substance that Lombardo does not suggest the examiner's proposed modification of Hyde.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that the rejection of the appealed claim cannot be sustained.

The Hyde reference does not show any angled bend in the putter shaft. Instead, this reference merely shows a gradually curved bend of relatively large radius in an intermediate portion of the putter shaft. In contrast, appellant's putter shaft design has a sharply angled bend lying between straight shaft portions about midway between the ends of the putter shaft.

Nevertheless, even if it is assumed that the Hyde reference satisfies the Rosen requirements, we cannot agree that the teachings of the applied references would have suggested the overall appearance of the claimed design as required in In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987). Hyde obviously lacks a suggestion of the overall appearance of appellant's design because, as noted supra, it lacks an angled

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bend in the putter shaft. Lombardo, on the other hand, does show an angled bend in the putter shaft, but this bend, rather than being located about midway between the ends of the putter shaft, lies near the lower end of the shaft adjacent to the putter head.

If anything, Lombardo suggests an angled bend but at a location spaced substantially from the location of appellant's angled bend to provide a distinctively different appearance as compared with appellant's design. Furthermore, contrary to the examiner's findings, the midpoint of Hyde's curved bend is not located midway between the ends of the putter shaft. Instead, it appears to be located substantially closer to the lower end of the shaft so that even if the proposed substitution were made, there still would be significant differences between the modified Hyde design and appellant's design.

At best, the combined teachings of the applied references suggest only components of appellant's design. However, absent a suggestion of the overall appearance of appellant's design, a rejection under § 103 is inappropriate. Cho, 813 F.2d at 382, 1 USPQ2d at 1663-1664.

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Furthermore, it appears that the examiner has improperly treated this design case as if it were an application for a mechanical utility patent, looking upon appellant's design as a ?combination of old elements? and citing In re Antle³, which involves a utility patent application. However, the issue here is whether appellant's claimed design would have been obvious from a design standpoint, not from a utility standpoint. Cho, 813 F.2d at 382, 1 USPQ2d at 1664.

In view of the foregoing, we cannot agree that the examiner has made out a prima facie case of obviousness. His decision rejecting the appealed claim is therefore reversed.

REVERSED

HARRISON E. McCANDLISH)
Administrative Patent Judge)
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)
) BOARD OF PATENT
IRWIN CHARLES COHEN)
Administrative Patent Judge) APPEALS AND

³ 444 F.2d 1168, 170 USPQ 285 (CCPA 1971).

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) INTERFERENCES
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JAMES M. MEISTER)
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