

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. ECKMANN

Appeal No. 99-1024
Application 29/062,504¹

ON BRIEF

Before MEISTER, McQUADE and RUGGIERO, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

James A. Eckmann appeals from the final rejection of the following claim for an ornamental design:

The ornamental design for wrist or ankle weight as shown and described.

¹ Application for design patent filed November 18, 1996.

As characterized by the appellant in the brief (Paper No. 6),

[t]he body of the wrist or ankle weight of this invention is in plan relatively long, generally rectangular, with two, generally parallel long edges, and two generally parallel short edges, and rounded corners between them. In the embodiment shown, there is piping along the entire outer margin. In this embodiment, the body has five evenly spaced, short, transverse lines of stitching centered between the two long edges. These lines of stitching occupy about one third of the center section of the body, leaving one third of the body on each side of the stitching uninterrupted between the outer edges of the transverse stitching and the long edges of the weight. The transverse stitching extends all the way through to the opposite broad side. When, as is the case with weights of this sort, the weight is filled with heavy pellets or particulate matter, the filler is continuous along both long edges, so that in side elevation the weight has a plump, somewhat wavy, but uninterrupted appearance, and when wrapped around an ankle or wrist, has a generally circular perimeter in side elevation, uninterrupted except at the meeting ends of the weight, as shown in Figure 1. As shown in Figures 2 and 3, the device, when wrapped around a wrist or ankle, has uninterrupted margins of substantial width as compared with the strap by which it is secured, with the width of which the transverse stitching is coincident [pages 2 and 3].

The reference relied upon by the examiner as evidence of obviousness is:

Appeal No. 99-1024
Application 29/062,504

Winston

4,966,365

Oct. 30, 1990

The appealed claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Winston.

Reference is made to the appellant's brief (Paper No. 6) and to the examiner's answer (Paper No. 7) for the respective positions of the appellant and the examiner with regard to the merits of this invention.

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). 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 ordinary skill of the art 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

Appeal No. 99-1024
Application 29/062,504

alone or on the basic reference in view of modifications suggested by secondary references. In re Rosen, supra. The test for the proper combination of references to support a rejection under §103 is whether they are so related that the appearance of certain ornamental features in one would have suggested the application of those features to the other. Id; In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). If, however, the combined teachings of the references suggest only components of the claimed design but not its overall appearance, a rejection under 35 U.S.C. § 103 is inappropriate. In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663-64 (Fed. Cir. 1987).

According to the examiner, the claimed design is unpatentable under 35 U.S.C. § 103 because

[t]he Winston patent reference 4,966,365 discloses an exercise weight in figures 2, 5, 6, 7, and 8, which is similar in overall appearance to the claimed design. The only difference is that on the claimed design the grommet has been omitted, and a buckle has been added to secure the strap.

The Winston patent reference 4,966,365 is further cited for its' showing of a prior art weight in figures 1, 3, and 4. In the prior art drawings, the Winston patent reference shows that it is conventional to provide the weight with a buckle for the strap, and to have omitted the grommet from the

Appeal No. 99-1024
Application 29/062,504

weight.

It would have been obvious to a designer of ordinary skill in the art at the time the invention was made to have provided the Winston patent reference 4,966,365 weight with a buckle for the strap, and to have omitted the grommet, in view of what is shown and suggested by the prior art disclosed in the Winston patent reference. Moreover, said modification would have resulted in an overall appearance strikingly similar to the claimed design and no patentable ornamental advance is seen there over [answer, pages 2 and 3].

The appellant does not dispute (1) the examiner's implicit determination that the Winston wrist or ankle weight design meets the threshold Rosen requirement for something in existence, the design characteristics of which are basically the same as those of the claimed design, or (2) the propriety of the examiner's proposed combination of the Winston design and the prior art design discussed by Winston. The appellant does submit, however, that the short, transverse lines of stitching in the claimed design render it patentably distinct from any design which would have been suggested by Winston (see pages 3 and 4 in the brief). As best shown in Figures 3 through 6 in the Winston reference, both the Winston design and the prior art design discussed by Winston include transverse lines of stitching which extend through

Appeal No. 99-1024
Application 29/062,504

substantially the full width of the respective wrist or ankle weights. In contrast, the claimed design includes relatively short transverse lines of stitching which extend through only the center third or so of the wrist or ankle weight width. These relatively short transverse lines of stitching imbue the claimed design with an overall appearance which differs substantially from the starkly segmented visual effect afforded by the full width lines of stitching disclosed by Winston. Thus, while the combined teachings of the Winston design and the prior art design discussed by Winston arguably would have suggested certain components of the claimed design, they would not have suggested its overall appearance.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of the appealed claim as being unpatentable over Winston.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)

Appeal No. 99-1024
Application 29/062,504

Administrative Patent Judge)	
)	
)	
)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

Appeal No. 99-1024
Application 29/062,504

Polster, Lieder, Woodruff & Lucchesi
763 South New Ballas Road
St. Louis, MO 63141

JPM/ki