

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT FINCH KELLERMAN and  
BRI MALASPINO

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Appeal 2009-009310  
Application 29/302,817  
Technology Center 2900

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Decided: September 22, 2009

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Before MURRIEL E. CRAWFORD, JOHN C. KERINS, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

### STATEMENT OF THE CASE

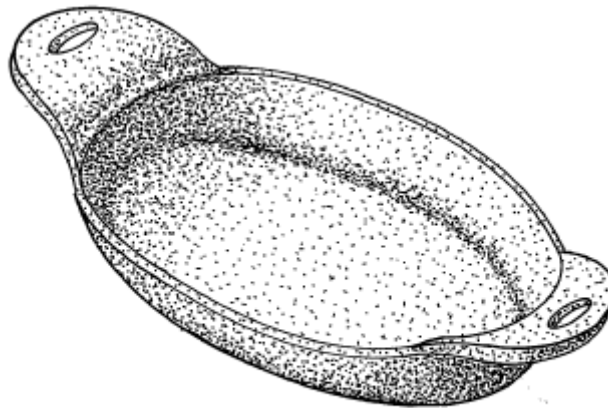
The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of the sole claim pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

### SUMMARY OF THE DECISION

We REVERSE.

### THE INVENTION

The Appellants' claimed invention is directed to an ornamental design for an oval server. Figure 1, reproduced below, is representative of the subject matter of appeal.



**FIG. 1**

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Henry

US D459,635 S

Jul. 2, 2002

Thonis	US D483,616 S	Dec. 16, 2003
Watson	US D483,617 S	Dec. 16, 2003

The sole claim pending is rejected under 35 U.S.C. § 103(a) as unpatentable over Henry, Thonis, and Watson.

### THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejection.

This issue turns on whether it would have been obvious to modify the teachings of Henry, Thonis, and Watson to obtain the ornamental design of the claimed invention.

### FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>1</sup>

FF1. The Appellant's design has a handle with an "almond shaped" opening therein (Fig. 2).

FF2. The Appellant's design has a handle which slopes upwardly and then flattens out while remaining in a fairly constant width (Fig. 3).

FF3. The Appellant's design has a bottom with an outer ring portion and a flat interior portion (Fig. 4).

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF4. Watson discloses an oval dish having a handle with an oval shaped opening that is slightly flattened at the two ends as shown in the top view (Fig. 4).

FF5. Watson shows a handle which slopes upward for substantially all its length in a side view (Fig. 2).

FF6. Watson shows a bottom portion which has a raised inner ring portion in the bottom view (Fig. 5).

FF7. Henry discloses an oval dish with a handle portion which slopes upwardly then turns back down, not remaining flat (Fig. 2).

FF8. Henry discloses an oval dish which has a bottom portion which is flat in the center portion (Fig. 5).

FF9. Thonis discloses an oblong dish (Fig. 1).

## PRINCIPLES OF LAW

### *Principles of Law Relating to Obviousness*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“Section 103 applies to design patents in much the same manner as it applies to utility patents. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1441 (Fed.Cir.1984) (‘35 U.S.C. § 103 (and all the case law interpreting that statute) applies with equal force to a determination of the obviousness of either a design or a utility patent.’)” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001).

“[W]hen a § 103 rejection is based upon a combination of references, there must be a 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 (Cust. & Pat. App. 1982). The designs of other references may properly be relied upon for modification of this basic design when the references 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*, 43 CCPA 797, 801, 230 F.2d 447, 450 (1956).” *In re Carter*, 673 F.2d 1378, 1380 (CCPA 1982).

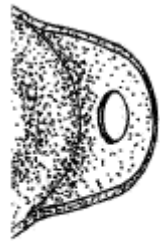
## ANALYSIS

The Appellants argue that the rejection of the claim is improper for several reasons including 1) the Appellants’ design has handles which curve upwardly and then extend almost parallel to the upper surface of the sidewalls whereas Watson’s handles simply extend upwardly (Br. 4); 2) that the Appellants’ design has different shaped handle openings than the rounded type rectangular shape of Watson’s; and 3) that the Appellants’ design does not have a distinctive oval in the middle of its bottom as shown in Watson (Br. 6). The Appellants have argued that upon reviewing the references cited by the Answer, one would have been led in a different path

than taken by the Appellants' design and that combining Watson, Henry and Thonis still omits many of the design elements provided by the Appellants' design (Reply Br. 2-3).

In contrast, the Examiner has determined that Watson, Henry and Thonis are properly combined to meet the claim (Ans. 5-9). The Examiner has determined that the differences in the use of metal design (Ans. 5), handle differences (Ans. 6-7), side wall differences (Ans. 7), and bottom differences (Ans. 8) would have been obvious and suggested by the prior art. The Examiner has presented a well drafted Answer with Figures used to explain the rejection of record.

After reviewing the record, however, we agree with the Appellants. We note first as illustrated in the Examiner's Answer at page 6, and copied below, differences exist in the shape of the oval dish's handle opening.



*Handle of the claimed design re Fig. 2*



*Handle detail of Watson re Fig. 4*

First, we find that the handle of Appellants design includes an “almond shaped” opening (FF1) which differs from the “oval shaped opening” that is slightly flattened at the two ends as shown by Watson (FF4). The Examiner has not disagreed with this contention but instead has determined this change to be minor and not sufficient to patentably characterize the claimed invention and instead considers this only an obvious design expedient (Ans. 6-7).

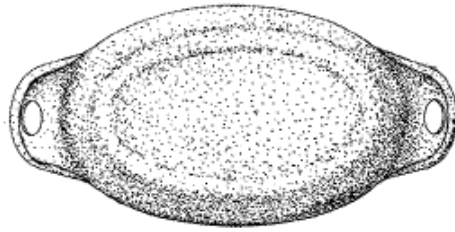
Secondly, we note, as illustrated in the Examiner's Answer at page 7, and copied below, that the side view of the handle of the Appellants' design slopes upwardly and then substantially parallel to the edge of the dish while those of Henry and Watson do not.



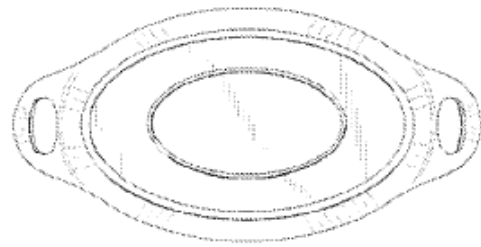
*Wall of claimed design re Fig. 3    Wall detail of Henry re Fig. 2    Wall detail of Watson re Fig.2*

The Examiner contends that Henry shows this shape for the handle side wall (Ans. 7-8), but we disagree. The invention has a handle which slopes upwardly and then flattens out while remaining in a fairly constant width (FF2) while Henry shows an oval dish with a handle portion which slopes upwardly then turns back down, not remaining flat (FF7). Thus, the prior art fails to disclose a handle which has a side view shape identical to the Appellants' design and the side view of the handle of the prior art would have to be modified to meet this ornamental feature as well.

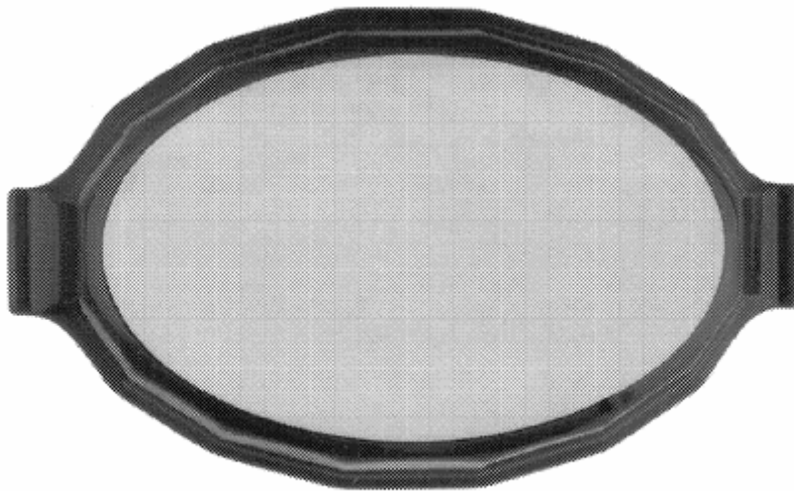
Thirdly, we note, as illustrated in the Examiners Answer at pages 8-9, and copied below, that differences exist between the claimed design which has a flat bottom central portion and that of Watson. Henry in Fig. 5, and copied below, in contrast does have a flat bottom portion.



*Bottom of the claimed design re Fig. 4*



*Bottom of Watson design re Fig. 5*



Henry Fig. 5

Appellants' design has a bottom with an outer ring portion and a flat interior portion (FF3) while, in contrast, Watson shows a bottom portion having a raised inner ring portion in the bottom view (FF7). Henry does disclose an oval dish that has a bottom portion which is flat in the center portion (FF9) and the Examiner contends that would suggest such a surface as the Appellants' design.

Taken together, the prior art would have to be further modified to at least include: 1) an "almond shaped" handle opening not shown in the prior

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art; 2) a handle which “slopes upwardly and then flattens out” while remaining in a fairly constant width which is also not shown in the prior art; and 3) a bottom with a flat center portion as disclosed by Henry, in order to meet the ornamental design characteristics as disclosed and we hold such a combined modification to not be obvious. The Examiner has not established that the ornamental features of the prior art are so related that they would specifically suggest as obvious the combination of all these particular features claimed in order to meet the claimed ornamental design. For these reasons the rejection of the claim is not sustained.

#### CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting the claim.

#### DECISION

The Examiner’s rejection of the claim is reversed.

#### REVERSED

MP

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