RE: APPEAL FROM THE FONAL RE-JECTION OF APPLICATION BY PATENT EXAMINER

EX-PARTE CASE NO. 213

Appln. Serial No. D-5221 Filed: November 17, 1983 Applicant: Sy Pio Lato For: WALL DÉCOR

SY PIO LATO,

Applicant-Appellant.

DECISION NO. 88-7 (PAT.)

February 3, 1988

DECISION

This is an ex-parte appeal from the final rejection of the Patent Examiner of Patent Application Serial No. D-5221 for a "Wall Decor" filed on November 13, 1983 by Sy Pio Lato of 415 McArthur Highway, Valenzuela, Bulacan.

The application was rejected on the ground that the design sought to be patented lacks novelty.

The sole reference of the application is a patented wall decor design (Letters Patent No. D-3157 issued on September 5, 1983 in favor of Luis D. Go), the characteristic features of which consist of a glass covered planar decorated body bound by a generally quinti foil-shaped frame having a suspender at the top portion thereof. Shown in the planar body are dotted lines forming a design of a vase with flower and an animal figure, both supported on a decorative center table.

Comparison of the drawings show that the design of the frame in both the cited reference and the subject application are identical. The apparent difference consists of Appellant-Applicant's specific surface design of a printed vase with a flower and an animal figurine, both supported on a decorative table. We agree with the Examiner's view, however, that this specific surface design clearly resembles the surface design in dotted lines of the cited reference.

Rule 122 of the Rules of Practice in Patent Cases provides:

"<u>Requisites for patentability of industrial design</u>. - According to the law, in order to be entitled to a patent, an industrial design must be new, original, and ornamental, and it must be for an article of manufacture. (Republic Act No. 165, Section 55, as amended by R.A. No. 864, Section 1)"

Further, Rule 123 of the said Rules of Practice reads:

"Requisites for patentability explained. - The object of the statute is to encourage the decorative arts and a design which merely pleases the eye is a proper subject for a design patent x x x. That is to say, a patentable design must not only be new and original but ornamental as well. Ornamentation implies beauty, the giving of a pleasing appearance. Patentable designs must, however, meet certain tests applicable to mechanical patents, and it is held (Knapp vs. Will & Balmer Co., 273 F. 380) that the subject matter must be novel and <u>must clearly indicate an exercise of the inventive</u> <u>faculties. Both are essential and necessary</u>." (Keene & Bessant Inc. vs. Eaglet Metal Spinning Co., 54 F /2d/ 131; underscoring supplied) The above requirements of law render Appellant-Applicant's design unpatentable. The Go patent makes the design application wanting in novelty, originality or inventiveness. In Patent Law, "original" has special reference to inventive genius in creating design, the inventor must have created a design that is essentially different and superior to design that might be created by person skilled in the art; mere exercise of routinary skill does not amount to design invention. It was held that to constitute a new design that would have been patentable as such, it had to be so different from all other existing before, as to have appeared to have been such to ordinary observer (Perry vs. Starret, CCC-NY Tod. Cas 11012). On the same token, it was held in the case Norman, 69 USPQ 553, 587 O.G. 186, that "mere differences or variation in form, however pleasant and appealing, do not of themselves constitute patentable differentiation. What is required is that the design shows some originality beyond the competency of the routine designer, some characteristically different effect not suggested by the prior art or conventional formal variation which every designer, or craftsman employs in the normal performance of his functions".

Appellant-Applicant's argument that in the case of spoons, forks, plates and the like, where the articles have the same outline or general appearance but of different surface design have been granted patent is without merit. This Bureau subscribes to the Examiner's contention that spoons, forks, plate and the like have <u>universally accepted shape</u> and that they differ only in surface ornamentation printed or engraved on their surface. This cannot apply to the case at bar. The design of the wall décor in issue cannot be considered as a universally accepted shape. Applicant had an infinite variety of shapes and forms to choose from and did not have to adopt one which is identical in form with that of the Go patent.

WHEREFORE, premises considered the Examiner's final rejection of Application Serial No. D-5221 filed on November 17, 1983 is AFFIRMED.

Let the records of this case be remanded to the Mechanical and Electrical Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO Director