

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LERMAN CONTAINER CORPORATION
Patent Owner and Appellant

Appeal 2021-002799
Reexamination Control 90/014,262
Patent D781,151 S
Technology Center 2900

Before DANIEL S. SONG, RAE LYNN P. GUEST, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

GUEST, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(b) and § 306, Appellant¹ appeals from the Examiner's decision to reject the claimed design of U.S. Patent D781,151 S² solely under 35 U.S.C. § 103. *See* Examiner's Final Office Action ("Final Act."), dated December 26, 2019; Appellant's Brief on

¹ We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42 (a). Appellant identifies the real party in interest as Lerman Container Corp. Appeal Br. 3.

² US Patent D781,151 S issued on March 14, 2017 to Robert Lerman (hereinafter "the '151 Patent"). The claimed design was not amended during this reexamination proceeding.

Appeal (“Appeal Br.”), dated June 8, 2020; and Examiner’s Answer (“Ans.”), dated January 25, 2021. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Appellant’s invention is titled “JAR.” The claimed design is an ornamental design for a jar as illustrated in the figures. *See* Appeal Br. 33–36. Representative Figures 1 and 2 are reproduced below.

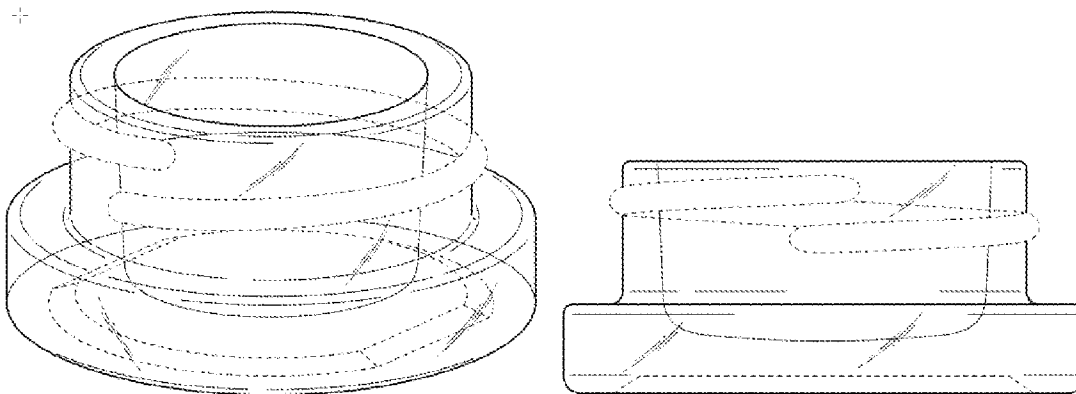


FIG. 1

FIG. 2

Figure 1 of the '151 Patent, reproduced above left, depicts a top, front, right side perspective view of the claimed jar design. Figure 2 of the '151 Patent, reproduced above right, depicts a front elevation view of the claimed jar design. *See* '151 Patent, Description.

The claimed jar has a wide and thick circular base, and a tall narrow circular neck extending upwardly from the base. *See*, Appeal Br. 5. The base and the neck are concentric, and the base encompasses about 40% of the total height of the jar. *See*, Appeal Br. 5. The neck encompasses the remainder of the jar’s height that is about 60% of the total height. *See*,

Appeal Br. 5. The jar defines an exteriorly visible interior storage chamber that extends downwardly from the top of the neck through the entire height of the neck, and partially into the base. *See*, Appeal Br. 6. The interior storage chamber has a slight frustoconical shape within the neck, and an ellipsoidal shape within the base. *See*, Appeal Br. 6. The interior storage chamber is also described as having a bowl-like shape with a curved bottom edge extending below the shoulder of the thick circular base. *See*, Appeal Br. 6. All of the claimed exterior edges of the jar are curved but for the top surface of the neck, which is flat and has an interior right angle with the interior storage chamber. The jar is entirely transparent. *See*, Appeal Br. 5. The thread and punt of the jar, depicted in broken lines, form no part of the claimed design. *See* '151 Patent, Description.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Zamberlan et al.	US D634,202 S	March 15, 2011
Beauty Packaging, <i>McKernan Adds Low Profile, Frosted Glass Jars</i> (June 2012) (https://www.beutypackaging.com/issues/2012-06/view_design-center/mckernan-adds-low-profile-frosted-glass-jars) (printed Jan. 24, 2019) (“Exhibit B1”).		
McKernan Catalogue, published February 2012 (“Exhibit B2”).		
Image of McKernan jar, available from archive.org as of October 30, 2013 (“Exhibit B3”).		
McKernan Packaging Clearing House, part drawings, identifying Part Number EL-28595 and dated March 21, 2011 (“Exhibit B4”). ³		

REJECTION

Claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over McKernan in view of Zamberlan.

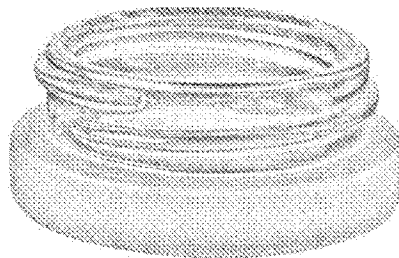
OPINION

After reviewing carefully each of Appellant’s arguments for patentability, we determine that a preponderance of the evidence supports reversing the Examiner’s determination that a designer of ordinary skill would have arrived at the claimed design by modifying the frosted glass jar of McKernan with the transparent jar of Zamberlan. Accordingly, we reverse the Examiner’s rejection of the claimed design under 35 U.S.C. § 103.

McKernan’s jar, illustrated in Exhibit B3, which is reproduced below discloses a jar having a wide base that is frosted, to which a concentric and transparent neck or opening is attached or formed. McKernan shows a jar

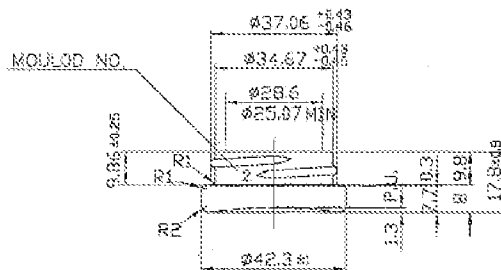
³ The four McKernan references (Exhibits B1-B4) are collectively referred to as “McKernan” or “the McKernan jar.” Each references was submitted by Appellant in an Information Disclosure Statement filed May 7, 2019, and is admittedly prior art.

having edges that are rounded and a neck that comprises threads. The photograph in Exhibit B3, reproduced below, provides a limited view of the interior of the McKernan jar so that the shape of the interior storage chamber of the jar cannot be ascertained.



The McKernan Exhibit B3 figure depicts a black and white photograph of a jar, in a perspective view.

The Examiner further relies on schematic drawings, illustrated in Exhibit B4, from the McKernan company, allegedly of the same frosted jar, which is reproduced below.



The McKernan Exhibit B4 figure is a schematic plan view of a side of a jar.

Zamberlan, Figures 6 and 7 of which are reproduced below, discloses a front elevation view of a jar having a wide base and a short narrower neck. The base comprises a significant portion of the jar and has a narrowed “waistline” in the middle of the base. The jar has an internal storage

chamber that transitions from the neck of the jar, which is concentric with the base, down into the base of the jar. The jar illustrated in Figures 6 and 7 of Zamberlan is transparent and from this view we are able to ascertain an interior storage chamber that has rounded corners inside the base.

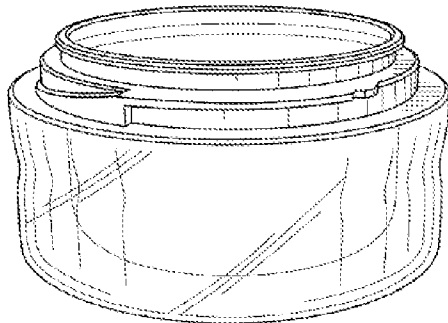


FIG. 6

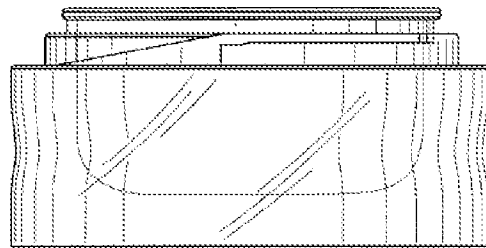


FIG. 7

Zamberlan Figure 6, reproduced above left, depicts a top perspective view of the flask (base) portion of the claimed design. Figure 7, reproduced above right, depicts a front elevation view of the same flask (base) portion. *See Zamberlan, Description.*

In determining *prima facie* obviousness, the proper standard is “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *See Spigen Korea Co., Ltd. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383 (Fed. Cir. 2020) (quoting *Durling v. Spectrum Furnit. Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)); *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380–81 (Fed. Cir. 2009).

An obviousness analysis must involve two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design,” often referred to as a *Rosen* reference (*see In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)); second,

“[o]nce 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.” *Durling*, 101 F.3d at 103 (internal quotations and citation omitted); *see also Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012); *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013). However, in doing so, “the teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one [design] would suggest the application of those features to the other.’” *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996) (quoting *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956)).

Primary Reference

The Examiner finds both the McKernan jar and the jar of the ’151 Patent consist of a short and wide cylindrical body topped with a taller narrower cylindrical neck. Final Act. 2. The Examiner finds any differences in proportions or shaping are negligible. *Id.* The Examiner acknowledges the frosted finish on the body of the McKernan jar, where the claimed jar design body is transparent. *Id.* The Examiner finds the designs are “basically the same” because their primary characteristics include stubby cylindrical bodies topped with taller narrower cylindrical necks, the wall thicknesses of both designs appear to be substantially the same, and overall the basic design characteristics are the same. *Id.* at 4. The Examiner finds the frosted finish on the McKernan jar does not affect the “underlying form” or “underlying design,” the “basic shape,” and the “overall form.” *Id.* at 4; Ans. 7, 9. The Examiner finds that the frosted surface does not alter the basic shape or

detract from the overall similarities of the jars. Ans. 9. The Examiner acknowledges other differences (e.g., marginally taller neck) but finds those to be negligible as well. Final Act. 4–5. The Examiner concedes the frosted appearance makes it impossible to see how deep the chamber extends into the jar but finds the perspective view of the McKernan jar in Figure B3 establishes there is an interior chamber. Ans. 7. The Examiner finds that a side by side comparison of the McKernan jar and the jar of the '151 Patent shows that the jars have the same overall visual appearance. Final Act. 5–6.

Appellant contends McKernan cannot be a primary reference as a matter of law because it is not “basically the same” visual impression as the claimed jar design found in the '151 Patent. Appeal Br. 12. Appellant argues the visual impression created by the claimed jar design as a whole is one of openness and clarity, which contrasts the visual impression of McKernan’s jar, in which the “visually prominent” frosted finish base diffuses or blocks the transmission of light and gives the impression of a solid opaque object that is visually closed. *Id.* at 12–13; Reply Br. 10–11. Appellant contends that the Examiner’s “underlying form” position is comparing only the outlines of the two jar designs and nothing else, which is “from too high a level of abstraction” and not the legal test. Appeal Br. 17. Appellant also argues that, even assuming McKernan’s jar has an interior opening, it has an unknown shape and size due to the limited view of the opening. *Id.* at 18; Reply Br. 11–12.

In considering the evidence and arguments of record, we are persuaded the Appellant has the better argument. Initially, we take judicial notice that there are many types of jars, and even the “small jar” art is a

crowded art. Thus, the differences in small details will have more weight than in less crowded arts. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 675 (Fed. Cir. 2008) (noting, in the context of infringement, that “similarity ‘is not to be determined by making too close an analysis of detail,’ nonetheless, ‘where in a crowded art the composite of differences presents a different impression to the eye of the average observer’”) (quoting *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933)).

While the McKernan jar has a shape similar to that of the jar of the claimed design, it falls short of creating an overall visual impression that is “basically the same” as the claimed jar to qualify as a proper primary reference as defined by *Rosen*. We agree with the Appellant that the overall visual impression of the claimed jar design as a transparent jar conveys an impression of openness and clarity that is lacking in the frosted finish of McKernan’s jar, which creates a visual impression of being masked or visually closed from the outside due to the prominent opaque base. The Examiner relies on the “underlying form” or shape of the jar as the sole basis for applying the reference and considers all other features minor or not otherwise affecting that overall shape. Yet, an overall visual impression, particularly in a crowded art, must reflect more than an overall shape, which is only one aspect of a design. We also find the lack of disclosure of the shape and depth of the interior chamber due to the limited views of the reference to be problematic. Part of the overall visual effect of a transparent jar necessarily will be reflected by the interior surfaces of the jar’s container.

Accordingly, the frosted aspect of McKernan's jar is more significant to the overall visual impression than argued by the Examiner.

Combination of References

Even if one were to find McKernan a suitable *Rosen* primary reference, we are not persuaded that a skilled artisan would have arrived at the claimed invention in combining the references.

The Examiner finds the Zamberlan reference discloses a similar stubby jar design where the body does not have a frosted finish and is fully transparent to reveal an inner cavity that has rounded contours. Final Act. 2. The Examiner concludes it would have been obvious to a designer of ordinary skill in the art at the time of filing to have modified the McKernan jar by removing the frosted finish from the base of the jar to reveal an inner cavity having rounded corners as suggested by Zamberlan. *Id.* at 2–3.

Appellant contends the Zamberlan reference cannot bridge the gap between the McKernan jar and the claimed invention. Appeal Br. 20. Specifically, Appellant argues that the base of the Zamberlan jar makes up virtually the entire jar including the internal storage area (about 73% according to Appellant), while the neck is significantly smaller. *Id.* at 22; Reply Br. 8. Appellant also points out the Zamberlan jar has a step-like neck which is different in appearance from the neck of the McKernan jar. Appeal Br. 20. Moreover, Appellant points out the Zamberlan jar has a visually prominent interlocking mechanism and an inwardly directed “waistline” curve located circumferentially about the base. *Id.* at 23. Other differences noted by Appellant include an inner chamber that extends in a vertical, not sloping direction as in the claimed design. Reply Br. 8.

Appellant thus argues the Examiner has arbitrarily and improperly combined selected features from the McKernan and Zamberlan jars based on hindsight reasoning. Appeal Br. 25. Specifically, Appellant contends the Examiner has failed to demonstrate why an ordinary designer would only borrow the interior chamber and clear exterior finish of the Zamberlan to the exclusion of the other features, such as the small neck, middle “waistline,” and prominent threading, in order to modify the McKernan jar to arrive at the claimed jar design. *Id.* at 26. Appellant argues the appearance of the McKernan jar modified with the teachings of Zamberlan would be substantially different from the claimed jar design, i.e., the base would constitute essentially the entire body of the jar and have a minuscule neck and a middle “waistline.” *Id.* Appellant concludes the Zamberlan jar is not “so related” to the McKernan jar in appearance, an ordinary designer would not be motivated to modify the McKernan jar with teachings of Zamberlan. *Id.* at 28.

The Examiner contends that a secondary reference is not required to “display an appearance that is basically the same as, or strikingly similar to, the claimed design.” Ans. 9. The Examiner takes the position that a designer of jars, charged with knowledge of all jars, would be sufficiently skilled to modify one jar with certain aesthetics of another jar. *Id.* The Examiner contends Zamberlan and McKernan disclose cylindrical jars with chambers extending from a top opening and an ordinary jar designer would have removed the frosted finish, as taught by Zamberlan, so the chamber is visible to the base of the jar depicted in McKernan. *Id.* at 9–10. The Examiner further responds that foremost any combination of references is in a sense a

reconstruction based on hindsight reasoning and that 35 U.S.C. § 103 does not require all the features of Zamberlan to be incorporated into the McKernan jar. *Id.* at 10. Instead, the Examiner argues the intent of 35 U.S.C. § 103 is that the integrity of the primary reference is maintained with minor modifications based on the teachings of the secondary reference. *Id.* The Examiner argues the modifications of the McKernan jar with some features of the Zamberlan jar are not conceptual and are applied in whole to cure minor deficiencies of the McKernan jar in teaching the claimed jar design. *Id.* at 11.

We again agree that Appellant has the better argument. Unlike with a utility application, there is no particular reason we can point to that a skilled designer would apply a feature of one design into another. Thus, the suggestion must come from some similar aspects between the primary and secondary design to suggest minor changes in the primary reference. Even if not required to be basically the same or similar, the primary and second reference must be “so related” that the secondary reference suggests modifying the primary reference with such features. *Glavas*, 230 F.2d at 450. We agree with Appellant that a designer of ordinary skill in the art would not have modified the features of the McKernan jar with only the transparency of the Zamberlan jar, nor can we find that the artisan would have arrived at the claimed jar design in doing so. Appellant notes the differences in the McKernan jar and the Zamberlan jar, namely the relative side and shapes of the bases and necks of the jars and the prominent “waistline” of the Zamberlan jar, in addition to the transparency. These differences are not minor and would not suggest the skilled artisan pull only

one aspect, the transparency, from Zamberlan to apply to McKernan. Accordingly, the references are not “so related” to suggest the skilled designer create a transparent McKernan jar.

Moreover, even if the references were combined, we agree with Appellant that the interior chamber of Zamberlan is visually different than the interior of the claimed design. We cannot determine the shape and depth of McKernan’s jar, and thus the skilled artisan would have only Zamberlan’s design. We note that Zamberlan’s interior chamber extends substantially through the base with vertical walls, and find that a skilled designer in the art would have had to incorporate these aspects into the design as well. Yet, the claimed design has relatively shallow depth with respect to the base, the interior chamber residing mostly in the neck of the jar and taking up less than half of the depth of the base, in sharp contrast to Zamberlan’s design. Further, in the claimed design, the sides of the interior chamber are sloped down with a slight curve to an entirely sloped bottom, while the sides of Zamberlan’s interior chamber are substantially vertical and form a sharper curve down to a primarily flat bottom. We find these aspects of the design to be of significance in the overall visual impression of such an otherwise simple design, particularly in an otherwise crowded art. Thus, even in combining the visual features of the two references, the skilled artisan would not have arrived at the claimed design.

Secondary Considerations

Appellant argues that the claimed jar is patentable based on the secondary consideration of commercial success. Appeal Br. 29. For support, Appellant points to the Declaration of the inventor Robert Lerman, who

testifies about continuous sales growth of the product based on the claimed jar design over the last several years. *Id.* Mr. Lerman also declares that jars embodying the claimed design comprise 65% of all jars that are purchased by licensed cannabis producers nationwide. *Id.* at 31. Appellant concludes this information and other evidence in the declaration establishes a proper nexus because the commercially successful jar is the design of the '151 Patent. *Id.*

While we need not address Appellant's arguments regarding commercial success in light of our positions above, we agree with the Examiner that Appellant has not shown the commercial success of the product is based on the particular design of the claimed jar.⁴ Ans. 11. Appellant has not distinguished sales of the claimed jar from the growth of cannabis sales in the U.S. *Id.* We agree with the Examiner that Appellant has not demonstrated a nexus between the jar's design and increased growth in sales, outside of its connection to cannabis sales.

CONCLUSION

We reverse the Examiner's rejection.

⁴ Further, to the extent that the jar is particularly suited to a particular use, here cannabis packaging, such a finding suggests a functional correlation between the jar and particular product stored therein (e.g., due to the size or transparency) rather than a correlation based purely on ornamental aspects of the jar. Functional features cannot be a basis of patentability for a claimed design. *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993) ("A design patent protects the non-functional aspects of an ornamental design as shown in a patent.").

Appeal 2021-002799
Reexamination Control 90/014,262
Patent D781,151 S

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1	103	McKernan, Zamberlan		1

REVERSED

PL Initials:
hh

For Appellant:

GOTTLIEB RACKMAN & REISMAN PC
270 MADISON AVENUE
8TH FLOOR
NEW YORK, NY 10016-0601