

DECISION OF THE COMMISSIONER

NONSTATUTORY NOVELTY: Solely Aesthetic Appeal in Effect.

The product is known except for its surface design as having "more numerous and deeper cuts" which have been machine produced as opposed to hand hewn. Such a difference in ornamental effect, in which novelty lies solely in its decorative appeal as opposed to a shape which subserved some functional purpose, and which is within the province of the artisan, is not proper subject matter for a patent.

FINAL ACTION: Affirmed

IN THE MATTER OF a request for a review by the
Commissioner of Patents of the Examiner's Final Action
under Section 46 of the Patent Rules.

AND

IN THE MATTER OF a patent application serial
number 044,282 filed February 28, 1969 for an invention
entitled:

TEXTURED PANELS

Agent for Applicant

Messrs. Kirby, Shapiro,
Curphey & Eades,
Ottawa, Ontario.

This decision deals with a request for review by the
Commissioner of Patents of the Examiner's Final Action dated
July 22, 1971 on application 044,282. This application was
filed in the name of Donal F. Luebs et al and refers to
"Textured Panels".

In the prosecution terminated by the Final Action the
examiner refused the claims and the application in that the
subject matter is directed to an old product. In this action
the examiner stated:

The claims define a panel having a surface fashioned
to simulate a hand hewn product, and which is nearly
indistinguishable from old, conventionally produced
panels. The dimensional limitations of cuts defined

in the claims do not introduce any patentable difference since they fall within the range that may be produced by hand using an adze or axe. The claims, therefore, define nothing but an old product i.e. a hand hewn panel and are not allowable. The applicant's argument, that the added limitation stating merely that the panel is made by means of automatic machinery, renders the claim patentable, is not acceptable since it was held that: --"It is essential to the validity of a claim that the thing claimed should have novelty" and to suggest that the process lends novelty to the product is "an artificial attribution". Further applicant's arguments that, because of the mechanised method of manufacture, his panels possess various desirable features not found in hand hewn panels are irrelevant, as follows below.

It is pointed out that the object of applicant's invention has been set forth as simulating the random rough hewn cuts of a hand-hewn panel. Applicant pointed out that the prior patents of record being directed to machine processes gave too much monotonous regularity. Then in the most recent response applicant has pointed to the limitation that the surface is "automatically fashioned by rotary cutters" and implies that standardizing the product lends patentability thereto. The arguments are therefore inconsistent and it is held as stated above that neither the simulation of rough hand work nor the standardization of cuts lends patentability to the product.

The applicant in his response dated August 24, 1971 stated:

The claims now in the application are for a "textured distressed panel" and not to a picture of a hand hewn board. It is true that the automatic machinery is adjusted to manufacture multi-ply, i.e., three-ply, five-ply, etc. panels that have the artistic semblance of a solid lumber hand hewn plank, but the external semblance is the only similarity; if such similarity actually exists. The manufactured panels are bonded three-ply cross-grained, stronger, and also thinner than a solid, but weaker hand hewn board that ordinarily might be used in its place. There is no similarity between the two products except the appearance at a distance. As pointed out in the last amendment of May 18, the panels have a surface devoid of splinters and excessive rough spots. The panels are easier to clean and will not snag clothing or other fabrics. The cuts in applicants' device are much more numerous, and much deeper. Also, cut in cuts can't exist in hand hewn planks.

The Examiner has rejected all the claims simply because the product looks like something else. This is believed to be a false reason for rejection. The article, including the three-ply construction and the surface cuts, is new and deserves patent protection.

After reviewing the ground for rejection set forth by the examiner, as well as the arguments set forth by the applicant, I am satisfied that the rejection is well founded.

Claim 1 of the application defines a textured finish consisting of a plurality of overlapping "valleys" formed on the surface of a plywood panel by means of removing portions of that surface. This however produces, in accordance with the disclosure (page 1, lines 1-13 and page 3, lines 24-28), an effect simulating the adze marks on a hand-hewn panel which is obviously not new. The fact that this finish is produced on a plywood panel, rather than a single thickness panel, is not considered to render the claims patentably distinct. It is obvious from the teachings of the cited United States Patent 3,234,978 that plywood panels have been textured by cutting away portions of the surface of the topmost ply. Furthermore, substitution of plywood for solid wood does not produce any unexpected result as far as the surface finish is concerned. The applicant acknowledges this in the disclosure by stating on page 1, lines 19-22, that his method of texturing applies "to any fibrous product, particularly of wood such as plywood, lumber or hardboard".

In claim 2 the restriction, "... include ridges and hollows to simulate an irregular cutting edge", is meaningless. In claim 3 the restriction, "... said ridges ... parallel to the grain in the face bonded ply, and at right angles to the underlying ply", is only a reference to the standard property of plywood. The limitations in claims 4-7 add nothing more than obvious features and dimensional limitations.

The references to, "a three-ply construction" and adjacent plies bonded at right angles to each other whereby high strength will be imparted to said panel", may be regarded only as a definition of the well-known features of a standard plywood panel and therefore patentably insignificant. Also, the reference to, "the cuts in the panel are much more numerous and deeper", is purely a matter of choice.

I am satisfied that it is within the province of the artisan in this field to produce any decorative or ornamental design on a panel without giving rise to the dignity of invention. Articles where the novelty lies solely in the use of design, pattern, ornament or aesthetic appeal are not considered patentable. This does not, however, rule out the fact that articles of special shape may be patentable where the shape subserves some functional purpose.

Applicant has produced a panel different only in the sense of its decorative effect or appeal. Therefore, I find that there is no novelty that might result apart from any aesthetic appeal or effect; thus, the claimed subject matter lacks invention.

I recommend that the decision of the examiner, to refuse the application for lack of novelty, be upheld.

R.E. Thomas,
Chairman, Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse the grant of a patent. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 13th day of October, 1971.