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INTERNATIONAL REGISTRATION NO.	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
DM/090026	35/500,829		Felix Rohner		9224

World Intellectual Property Organization
34, chemin des Colombettes, P.O. Box 18
1211 Geneva 20, Switzerland

DATE MAILED : 03/17/2017

NOTIFICATION OF REFUSAL

(Rule 18 of the Common Regulations under the Hague Agreement/ 37 CFR 1.1063)

Applicant must file any reply to this communication directly with the United States Patent and Trademark Office. Applicant may **NOT** file such reply through the International Bureau.

This refusal relates to all the industrial designs that are the subject of the international registration

Office Action Summary

Application No.
35/500,829

Applicant(s)
ROHNER, FELIX

Examiner
MICHAEL A. PRATT

Art Unit
2914

**AIA (First Inventor to File)
Status**
Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

- 5) Claim(s) _____ is/are pending in the application.
 5a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 6) Claim(s) _____ is/are allowed.
- 7) Claim(s) _____ is/are rejected.
- 8) Claim(s) _____ is/are objected to.
- 9) Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to FPHfeedback@uspto.gov.

Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) All b) Some** c) None of the:
- Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
 Paper No(s)/Mail Date _____
- 3) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 4) Other: _____

Art Unit: 2914

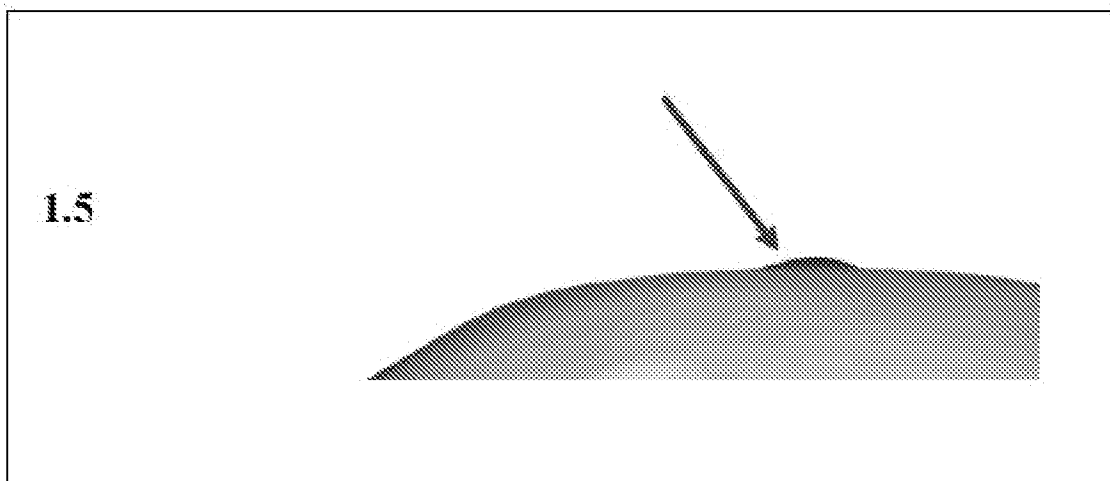
The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

**DETAILED ACTION: REFUSAL
REJECTION UNDER 35 U.S.C. 112 PARAGRAPHS 1 AND 2**

The claim is rejected under 35 U.S.C. 112(a) and (b) or 35 U.S.C. 112 (pre-AIA), first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is nonenabling because the specification, while being enabling for most of the design, does not reasonably provide enablement for the exact shape and appearance of the claimed design. The specification does not enable any person skilled in the art to make or use the invention commensurate in scope with this claim. The scope of a design includes all that is shown in solid lines.¹ "The only use possible for an ornamental design is its embodiment, exhibition, and observation."² In other words, if one cannot determine what the design looks like from the specification, the claim is not enabled. This claim is not enabled because the design's appearance seen from the drawing views of the Percussion Instrument is insufficiently disclosed.

Specifically, in figures 1.4 through 1.7 show a small dark black semicircular protrusion on the uppermost edge of the curved surface while in figure 1.2 there appears to be no structure that appears to correspond to figures 1.4 through 1.7 (**See annotated drawing below**)



The claim is indefinite because the appearance of portions of the design as seen from the drawing views cannot be determined without resorting to conjecture. The scope of a claim is definite only when it is supported by an enabling disclosure.³ When the scope of protection sought exceeds what is enabling in the disclosure, the claim is indefinite.

¹ See *Ex parte Remington*, 114 O.G. 761, 1905 C.D. 28 (Comm'r Pat. 1904); *In re Blum*, 153 USPQ 177 (CCPA 1967); MPEP § 1503.01

² *In re Mann*, 8 USPQ2nd 2030

³ A patent claim is invalid if it is not supported by an enabling disclosure. MPEP 2164

Art Unit: 2914

The claim scope must be less than or equal to the scope of the enablement.⁴ The scope of enablement, in turn, is that which is disclosed in the specification and is understandable to a designer of ordinary skill in the art without resorting to conjecture.

This rejection may be overcome amending the drawing and description as follows:

- In Figures 1.4 through 1.7 remove the dark black semicircular element.

The examiner makes note that removing the unknown feature in figures 1.4 through 1.7 this will **NOT** be considered new matter with the understanding that figure 1.2 provides support for the removal. In the alternative, any attempt to provide clarification by adding the missing dark black element to figure 1.2 may result in an introduction of new matter because from this view point additional structure and or a specific location may be revealed that there is no support for in figure 1.4 through 1.7.

Applicant is reminded that any reply to this Refusal must be signed either by a patent practitioner (i.e., a patent attorney or agent registered to practice before the United States Patent and Trademark Office) or by the applicant. If the applicant is a juristic entity, the reply must be signed by a patent practitioner. See 37 CFR 1.33(b).

The claim stands rejected under 35 U.S.C. 112, first and second paragraphs. The references cited are possible pertinent art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. PRATT whose telephone number is (571)272-2145. The examiner can normally be reached on 6:00 - 2:00 MST. M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Celia Murphy can be reached on (571) 272-2654. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL A. PRATT/
Primary Examiner, Art Unit 2914

⁴ *National Recovery Technologies Inc. v. Magnetic Separation Systems Inc.*, 49 USPQ2d 1671 (Fed. Cir. 1999) See *Goodman*, 11 F.3d at 1050, 29 USPQ2d at 2013 ("the specification must teach those of skill in the art 'how to make and how to use the invention as broadly as it is claimed' ") (citing *Vaeck*, 947 F.2d at 496); *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)

Notice of References Cited	Application/Control No. 35/500,829	Applicant(s)/Patent Under Reexamination ROHNER, FELIX	
	Examiner MICHAEL A. PRATT	Art Unit 2914	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-8,552,279 B2	10-2013	Rohner; Felix	G10D13/08	84/402
*	B	US-D737,370 S	08-2015	Rohner; Felix		D17/22
*	C	US-D737,368 S	08-2015	Rohner; Felix		D17/22
*	D	US-D737,366 S	08-2015	Rohner; Felix		D17/22
*	E	US-D737,367 S	08-2015	Rohner; Felix		D17/22
*	F	US-D737,369 S	08-2015	Rohner; Felix		D17/22
*	G	US-D759,747 S	06-2016	Rohner; Felix		D17/22
*	H	US-D766,356 S	09-2016	Rohner; Felix		D17/22
*	I	US-D774,128 S	12-2016	Young; Matthew Pinner		D17/22
*	J	US-D777,245 S	01-2017	Rohner; Felix		D17/22
	K	US-				
	L	US-				
	M	US-				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	CPC Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.




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BIB DATA SHEET

CONFIRMATION NO. 9224

SERIAL NUMBER 35/500,829	FILING or 371(c) DATE 03/14/2016 RULE	CLASS D17	GROUP ART UNIT 2914	ATTORNEY DOCKET NO.	
APPLICANTS PANART HANGBAU AG, Bern, SWITZERLAND INVENTORS Felix Rohner, Berne, SWITZERLAND; ** CONTINUING DATA ***** ** FOREIGN APPLICATIONS ***** ** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY ** 05/19/2016					
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No 35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input type="checkbox"/> No Verified and /MICHAEL AARON PRATT/ Acknowledged Examiner's Signature	<input type="checkbox"/> Met after Allowance _____ Initials	STATE OR COUNTRY SWITZERLAND	SHEETS DRAWINGS 7	TOTAL CLAIMS 1	INDEPENDENT CLAIMS 1
ADDRESS BOVARD LTD Patent and Trademark Attorneys Optingenstrasse 16 Bern, CH-3000 SWITZERLAND					
TITLE Percussion instrument					
FILING FEE RECEIVED 0.00	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit		

Search Notes 	Application/Control No. 35500829	Applicant(s)/Patent Under Reexamination ROHNER, FELIX
	Examiner MICHAEL A PRATT	Art Unit 2914

CPC- SEARCHED		
Symbol	Date	Examiner
G10D13/02;G10D13/006; G10D13/00;G10D13/08	3/14/2017	/map/

CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner
d17	22,24,99	3/14/2017	/map/
d21	405	3/14/2017	/map/

SEARCH NOTES		
Search Notes	Date	Examiner
PE2E Inventor Name Search	3/21/2017	/map/
EAST Inventor Name Search (See attached search history printout)	3/21/2017	/map/
EAST Applicant Name Search (See attached search history printout)	3/21/2017	/map/
EAST - US- PGPUB;USPAT;USOCR;FPRS;EPO;JPO;DERWENT;IBM_TDB;CPC	3/21/2017	/map/
EAST Backwards/Forwards Citation Search on References Cited	3/21/2017	/map/
EAST Text Search (See search history printout)	3/21/2017	/map/
Google Image Search - http://images.google.com/ Keywords: Hang and Drum	3/21/2017	/map/
Youtube - http://youtube.com/ Keywords: Hang and Drum	3/21/2017	/map/

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner
d17	22	3/14/2017	/map/

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EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L7	8	((("PANART") near3 ("HANGBAU") near3 ("AG")).AANM.	USPAT	AND	ON	2017/03/14 11:59
L8	10	((("ROHNER") near3 ("Felix")).INV.	US-PGPUB; USPAT; USOCR	AND	ON	2017/03/14 11:59
L12	3988	percussion adj instrument	US-PGPUB; USPAT; USOCR	AND	ON	2017/03/14 12:02
L17	159	idiophone	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	AND	ON	2017/03/14 12:06

3/ 14/ 2017 12:51:14 PM

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