



16 August 2018

Ms. Wang Binying
Deputy Director General, Brands and Designs Sector
World Intellectual Property Organization
34, chemin des Colombettes 34
1211 Geneva 20, Switzerland

VIA EMAIL ONLY (sctforum@wipo.int)

Re: Circular C. 8776 (11 June 2018) Relating to the Request by the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT)

Dear Ms. Wang:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments in C. 8776 concerning the request by the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) to the Secretariat to “invite Members, Intergovernmental Intellectual Property Organizations with observer status and accredited Non-Governmental Organizations (NGOs) to submit further inputs, including detailed questions which they would like to see answered, concerning (1) the requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product and (2) the methods allowed by offices for the representation of animated designs.” (C. 8776 at 1.)

SCT included a number of questions concerning Topics (1) and (2) in a previous questionnaire. (C. 8776 at 2 n.5; *see also* SCT/36/2/Rev. 2 and SCT/37/2 Rev.)¹ Accordingly, SCT has requested that NGOs not submit the same questions, but

¹The relevant questions included in the previous questionnaire were:

Topic (1): The requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product

- Can a GUI and/or icon be patented/registered as such (*i.e.*, independently of the product that incorporates it or in relation to which it is to be used, e.g., smartphone, tablet computer, computer screen)?
- Is the scope of protection of GUI, icon or typeface/type font designs limited by the classification of the industrial design?
- Is a GUI and/or icon protected in relation to one product (e.g., a smartphone) also protected against its use in relation to another product (e.g., the display of a car)?

Topic (2): The methods allowed by offices for the representation of animated designs

- How may a GUI, icon, typeface/type font be represented in an application for a design patent/industrial design registration in your jurisdiction?
- Are additional or special requirements applicable to a GUI and/or icon which is animated (moving images design, transformation transition, change of colors, or any other animation)?
- What are the additional or special requirements applicable to a GUI and/or icon which is animated?

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rather provide more detailed and in-depth questions pertaining to Topics (1) and (2). (C. 8776 at 2.) SCT has further invited submission of other inputs, *e.g.*, references to offices' filing and examination guidelines, examples of GUI and icon applications - refused or accepted, lists of practical issues encountered by users in protecting GUI, icon, typeface/type font designs, reports of successful protection cases in various jurisdictions, as well as office and court decisions. (*Id.*)

Background About IPO

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO's membership includes about 200 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO's Response to C. 8776

Regarding Topic (1), the requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product, IPO would like to see the following questions answered:

1. If a "link" between a GUI, Icon, Typeface/Type Font Design and an article or product is required, does a prior art design have to be linked to a similar article or product for purposes of assessing patentability/registrability or validity?
2. If no "link" between a GUI, Icon, Typeface/Type Font Design and the article or product is defined by the party seeking protection, but a link is required for patentability/registrability, is the party seeking protection or the examining authority empowered to define such a "link" during prosecution?
3. What role, if any, do functional aspects of the article or product displaying the GUI, Icon, Typeface/Type Font Design play in assessing a "link" between such Design and the article or product?
4. If a GUI and/or icon protected in relation to one product can also be protected against its use in relation to a different product, how similar do the products have to be for protection to be available?

5. How do indirect infringement doctrines, such as induced infringement, impact the “link” between GUIs, Icons, Typeface/Type Font Designs and an article or product? For example, could a user who causes a GUI, Icon, Typeface/Type Font Design to be “applied” to a device display screen, be deemed to have been “induced” to have done so by the device provider? If so, under what circumstances?

Regarding Topic (2), the methods allowed by offices for the representation of animated designs, IPO would like to see the following question answered:

Can applicants seeking protection for animated designs include animated files that disclose and describe such designs, *e.g.*, movie files such as .avi, .flv, .wmv, .mp4 or .mov files? If so, how are such files being integrated into published design documents?

Other inputs

IPO submits the following other inputs for your information, without endorsing any particular policy or decision.

U.S. Patent and Trademark Office (USPTO) filing and examination guidelines relating to GUI, icon, typeface/type font designs. Section 1504.01(a) of the USPTO Manual of Patent Examination and Procedure (MPEP) specifies the guidelines for disclosing computer-generated icons. A copy of MPEP § 1504.01(a) is attached to this correspondence as Exhibit 1.

Examples of GUI and icon applications. For examples of GUI and icon applications that the USPTO has allowed, please refer to the court decisions concerning GUI, icon, typeface/type font designs referenced below. Two recent successful design patent protection cases involved GUI and icon designs. Copies of the design patents-in-suit are attached as Exhibits 2-6.

USPTO decisions concerning GUI, icon, typeface/type font designs. Examples of non-precedential decisions from the U.S. Patent Trial & Appeal Board (PTAB) include *Ex parte Sadler*, No. 2014-001032 (P.T.A.B. Feb. 24, 2017) (in a GUI application, PTAB held that the removal of the disclaimer language from the original specification does not negate its availability as a source of support in the original disclosure (which applicant relied on in removing certain text from the GUI figures in an amendment)) and *Ex parte Thai*, No. 2015-007954 (P.T.A.B. Apr. 18, 2017) (in a GUI application, the PTAB reversed the examiner’s § 103 obviousness rejection because a *prima facie* case of obviousness had not been established). Copies of these PTAB decisions are attached as Exhibits 7-8.

Court decisions concerning GUI, icon, typeface/type font designs. Recent successful design patent protection cases in the United States that concern GUI,

icon, or typeface/type font designs include *Apple Inc. v. Samsung Elecs. Co.*, No. 11-cv-1846 (N.D. Cal.) and *Microsoft Corp. v. Corel Corp.*, No. 5:15-cv-5836-EJD (N.D. Cal.).

A recent unsuccessful design patent protection case in China that concerns GUI, icon, or typeface/type font designs is *Beijing Qihu Tech. Co. and Qizhi Software Co. v. Beijing Jiangmin New Sci, Tech. Co.* The *Qihu* case demonstrates the negative effects on patent owners of the requirement for a link between GUIs and icons and an article or product. In the *Qihu* case, the Plaintiffs and Defendant were software companies. To comply with China's requirement that a GUI design patent must show the hardware on which the GUI is displayed, the Plaintiffs' patent showed its GUI design on a computer display screen, as represented below.



Because China does not allow broken lines in design patent applications, the scope of the patent included both the GUI and the hardware shown in the drawings. But, the Defendant only made software—not the underlying hardware. The court held that the software did not infringe the Plaintiffs' design patent because the subject matter of the design patent was a computer and the accused software was not considered to be an identical or similar product as a computer. This decision has been seen as significantly reducing the availability and worth of GUI and icon design patents in China, particularly for companies that produce software alone — and for software that is usable on a variety of devices.

We again thank WIPO for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,

Mark Lauroesch
Executive Director

Attachments

EXHIBIT 1

Chapter 1500 Design Patents

1501	Statutes and Rules Applicable
1502	Definition of a Design
1502.01	Distinction Between Design and Utility Patents
1503	Elements of a Design Patent Application Filed Under 35 U.S.C. chapter 16
1503.01	Specification
1503.02	Drawing
1504	Examination
1504.01	Statutory Subject Matter for Designs
1504.01(a)	Computer-Generated Icons
1504.01(b)	Design Comprising Multiple Articles or Multiple Parts Embodied in a Single Article
1504.01(c)	Lack of Ornamentality
1504.01(d)	Simulation
1504.01(e)	Offensive Subject Matter
1504.02	Novelty
1504.03	Nonobviousness
1504.04	Considerations Under 35 U.S.C. 112
1504.05	Restriction
1504.06	Double Patenting
1504.07	[Reserved]
-1504.09	
1504.10	Priority Under 35 U.S.C. 119(a)-(d), 386(a) and (b)
1504.11	[Reserved]
-1504.19	
1504.20	Benefit Under 35 U.S.C. 120
1504.21	[Reserved]
-1504.29	
1504.30	Expedited Examination
1505	Term of Design Patent
1506	[Reserved]
-1508	
1509	Reissue of a Design Patent
1510	Reexamination
1511	Protest
1512	Relationship Between Design Patent, Copyright, and Trademark
1513	Miscellaneous
1501	Statutes and Rules Applicable
[R-07.2015]	

Design patents are provided for in 35 U.S.C. chapter 16. In addition, international design applications filed under the Hague Agreement Concerning the International Registration of Industrial Designs

(“Hague Agreement”) are provided for in 35 U.S.C. chapter 38. Certain statutory provisions in 35 U.S.C. chapter 38 provide for the applicability of the provisions of 35 U.S.C. chapter 16 to international design applications. See [35 U.S.C. 382\(c\)](#), [383](#), and [389\(b\)](#). See [MPEP Chapter 2900](#) for additional information concerning international design applications.

The right to a patent for a design stems from:

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

For design applications filed under 35 U.S.C. chapter 16:

37 CFR 1.151 Rules applicable.

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

For international design applications designating the United States:

37 CFR 1.1061 Rules applicable.

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of § [1.74](#), § [1.84](#), except for § [1.84\(c\)](#), and §§ [1.152](#) through [1.154](#) shall not apply to international design applications.

Other rules relating only to design applications, such as [37 CFR 1.152-1.155](#) and those contained in 37 CFR Part 1, Subpart I, are reproduced in the sections of this chapter and in [MPEP Chapter 2900](#), as appropriate.

It is noted that design patent applications are not included in the Patent Cooperation Treaty (PCT), and the procedures followed for PCT international

design classes. It is also mandatory that the search be extended to the mechanical classes encompassing inventions of the same general type. Catalogs and trade journals as well as available foreign patent databases are also to be consulted.

If the examiner determines that the claim of the design patent application does not satisfy the statutory requirements, the examiner will set forth in detail, and may additionally summarize, the basis for all rejections in an Office action. If a reply to an Office action overcomes a rejection either by way of an amendment to the claim or by providing convincing arguments that the rejection should be withdrawn, that rejection must be indicated as withdrawn in the next Office action, unless such action is a notice of allowability. Likewise, any amendment to the specification or claim, or new drawing or drawing correction submitted in reply to an objection or objections in an Office action must be acknowledged in the next Office action, unless such action is a notice of allowability. When an examiner determines that the claim in a design application is patentable under all statutory requirements, but formal matters still need to be addressed and corrected prior to allowance, an *Ex parte Quayle* action will be sent to applicant indicating allowability of the claim and identifying the necessary corrections.

¶ 15.19.01 Summary Statement of Rejections

The claim stands rejected under [1].

Examiner Note:

1. Use as summary statement of rejection(s) in Office action.
2. In bracket 1, insert appropriate basis for rejection, i.e., statutory provisions, etc.

¶ 15.58 Claimed Design Is Patentable (Ex parte Quayle Actions)

The claimed design is patentable over the references cited.

¶ 15.72 Quayle Action

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 OG 213 (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

If it is determined that a rejection of the claim should be given after a reply to a *Quayle* action, the indication of allowability set forth in the previous action must be withdrawn and prosecution reopened using the following form paragraph:

¶ 15.90 Indication of allowability withdrawn

The indication of allowability set forth in the previous action is withdrawn and prosecution is reopened in view of the following new ground of rejection.

With respect to *pro se* design applications, the examiner should notify applicant in the first Office action that it may be desirable for applicant to employ the services of a registered patent attorney or agent to prosecute the application. Applicant should also be notified that the U.S. Patent and Trademark Office cannot aid in the selection of an attorney or agent. See [MPEP § 401](#). If it appears that patentable subject matter is present and the disclosure of the claimed design complies with the requirements of [35 U.S.C. 112](#), the examiner should include a copy of the “Guide To Filing A Design Patent Application” with the first Office action and notify applicant that it may be desirable to employ the services of a professional patent draftsman familiar with design practice to prepare the drawings. Applicant should also be notified that the U.S. Patent and Trademark Office cannot aid in the selection of a draftsman. The following form paragraph, where appropriate, may be used.

¶ 15.66 Employ Services of Patent Attorney or Agent (Design Application Only)

As the value of a design patent is largely dependent upon the skillful preparation of the drawings and specification, applicant might consider it desirable to employ the services of a registered patent attorney or agent. The U.S. Patent and Trademark Office cannot aid in the selection of an attorney or agent.

A listing of registered patent attorneys and agents is available at <https://oedci.uspto.gov/OEDCLI/>. Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

1504.01 Statutory Subject Matter for Designs [R-07.2015]

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—Whoever invents any new, original, and ornamental design for an article of manufacture may obtain

a patent therefor, subject to the conditions and requirements of this title.

(b) **APPLICABILITY OF THIS TITLE.**—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) **FILING DATE.**—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

The language “new, original and ornamental design for an article of manufacture” set forth in [35 U.S.C. 171](#) has been interpreted by the case law to include at least three kinds of designs:

(A) a design for an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia);

(B) a design for the shape or configuration of an article of manufacture; and

(C) a combination of the first two categories.

See *In re Schnell*, 46 F.2d 203, 8 USPQ 19 (CCPA 1931); *Ex parte Donaldson*, 26 USPQ2d 1250 (Bd. Pat. App. & Int. 1992).

A picture standing alone is not patentable under [35 U.S.C. 171](#). The factor which distinguishes statutory design subject matter from mere picture or ornamentation, *per se* (i.e., abstract design), is the embodiment of the design in an article of manufacture. Consistent with [35 U.S.C. 171](#), case law and USPTO practice, the design must be shown as applied to or embodied in an article of manufacture.

A claim to a picture, print, impression, etc. *per se*, that is not applied to or embodied in an article of manufacture should be rejected under [35 U.S.C. 171](#) as directed to nonstatutory subject matter. The following paragraphs may be used.

¶ **15.07.01 Statutory Basis, 35 U.S.C. 171**

The following is a quotation of [35 U.S.C. 171](#):

(a) **IN GENERAL.**—Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) **APPLICABILITY OF THIS TITLE.**—The provisions of this title relating to patents for inventions

shall apply to patents for designs, except as otherwise provided.

(c) **FILING DATE.**—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

¶ **15.09 35 U.S.C. 171 Rejection**

The claim is rejected under [35 U.S.C. 171](#) as directed to nonstatutory subject matter because the design is not shown embodied in or applied to an article.

Examiner Note:

This rejection should be used when the claim is directed to surface treatment which is not shown with an article in either full or broken lines.

¶ **15.42 Visual Characteristics**

The design for an article consists of the visual characteristics or aspect displayed by the article. It is the appearance presented by the article which creates an impression through the eye upon the mind of the observer.

¶ **15.43 Subject Matter of Design Patent**

Since a design is manifested in appearance, the subject matter of a Design Patent may relate to the configuration or shape of an article, to the surface ornamentation on an article, or to both.

¶ **15.44 Design Inseparable From Article to Which Applied**

Design is inseparable from the article to which it is applied, and cannot exist alone merely as a scheme of ornamentation. It must be a definite preconceived thing, capable of reproduction, and not merely the chance result of a method or of a combination of functional elements (35 U.S.C. 171; 35 U.S.C. 112(a) and (b) or pre-AIA 35 U.S.C. 112, first and second paragraphs). See *Blisscraft of Hollywood v. United Plastics Co.*, 189 F. Supp. 333, 127 USPQ 452 (S.D.N.Y. 1960), 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961).

Form paragraphs 15.38 and 15.40 may be used in a second or subsequent action, where appropriate (see [MPEP § 1504.02](#)).

**1504.01(a) Computer-Generated Icons
[R-07.2015]**

To be directed to statutory subject matter, design applications for computer-generated icons must comply with the “article of manufacture” requirement of [35 U.S.C. 171](#).

I. GUIDELINES FOR EXAMINATION OF DESIGN PATENT APPLICATIONS FOR COMPUTER-GENERATED ICONS

The following guidelines have been developed to assist USPTO personnel in determining whether design patent applications for computer-generated icons comply with the “article of manufacture” requirement of [35 U.S.C. 171](#).

A. General Principle Governing Compliance With the “Article of Manufacture” Requirement

Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation. See, e.g., *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) (computer-generated icon alone is merely surface ornamentation). The USPTO considers designs for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection under [35 U.S.C. 171](#). Thus, if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the “article of manufacture” requirement of [35 U.S.C. 171](#). Since a patentable design is inseparable from the object to which it is applied and cannot exist alone merely as a scheme of surface ornamentation, a computer-generated icon must be embodied in a computer screen, monitor, other display panel, or portion thereof, to satisfy [35 U.S.C. 171](#). See [MPEP § 1502](#).

“We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design ‘for an article of manufacture.’” See *In re Hruby*, 373 F.2d 997, 1001, 153 USPQ 61, 66 (CCPA 1967) (design of water fountain patentable design for an article of manufacture). The dependence of a computer-generated icon on a central processing unit and computer program for its existence itself is not a reason for holding that the design is not for an article of manufacture.

B. Procedures for Evaluating Whether Design Patent Applications Drawn to Computer-Generated Icons Comply With the “Article of Manufacture” Requirement

USPTO personnel shall adhere to the following procedures when reviewing design patent applications drawn to computer-generated icons for compliance with the “article of manufacture” requirement of [35 U.S.C. 171](#).

(A) Read the entire disclosure to determine what the applicant claims as the design and to determine whether the design is embodied in an article of manufacture.

Since the claim must be in formal terms to the design “as shown, or as shown and described,” the drawing provides the best description of the claim. [37 CFR 1.153](#) or [1.1025](#).

(1) Review the drawing to determine whether a computer screen, monitor, other display panel, or a portion of any of those articles, is shown.

Although a computer-generated icon may be embodied in only a portion of a computer screen, monitor, or other display panel, the drawing must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article.

(2) Review the title to determine whether it clearly refers to the claimed subject matter. [37 CFR 1.153](#) or [1.1067](#).

The following titles do not adequately describe a design for an article of manufacture under [35 U.S.C. 171](#): “computer icon”; or “icon.” On the other hand, the following titles do adequately describe a design for an article of manufacture under [35 U.S.C. 171](#): “computer screen with an icon”; “display panel with a computer icon”; “portion of a computer screen with an icon image”; “portion of a display panel with a computer icon image”; or “portion of a monitor displayed with a computer icon image.”

(3) Review the specification to determine whether a characteristic feature statement is present. If a characteristic feature statement is present, determine whether it describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof. See *McGrady v. Aspenglas Corp.*, 487 F.2d 859, 208 USPQ 242 (S.D.N.Y. 1980)

(descriptive statement in design patent application narrows claim scope).

(B) If the drawing does not depict a computer-generated icon embodied in a computer screen, monitor, other display panel, or a portion thereof, in either solid or broken lines, reject the claimed design under [35 U.S.C. 171](#) for failing to comply with the article of manufacture requirement.

(1) If the disclosure as a whole does not suggest or describe the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof, indicate that:

(a) The claim is fatally defective under [35 U.S.C. 171](#); and

(b) Amendments to the written description, drawings and/or claim attempting to overcome the rejection will ordinarily be entered, however, any new matter will be required to be canceled from the written description, drawings and/or claims. If new matter is added, the claim should be rejected under [35 U.S.C. 112\(a\)](#).

(2) If the disclosure as a whole suggests or describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof, indicate that the drawing may be amended to overcome the rejection under [35 U.S.C. 171](#). Suggest amendments which would bring the claim into compliance with [35 U.S.C. 171](#).

(C) Indicate all objections to the disclosure for failure to comply with the requirements of the Rules of Practice in Patent Cases. See e.g. [37 CFR 1.71](#), [1.81-1.85](#), and [1.152-1.154](#). Suggest amendments which would bring the disclosure into compliance with the requirements of the Rules of Practice in Patent Cases.

(D) Upon reply by applicant:

(1) Enter any amendments; and

(2) Review all arguments and the entire record, including any amendments, to determine whether the drawing, title, and specification clearly disclose a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof.

(E) If, by a preponderance of the evidence (see *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992)) (“After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”), the applicant has established that the computer-generated icon is embodied in a computer screen, monitor, other display panel, or portion thereof, withdraw the rejection under [35 U.S.C. 171](#).

II. EFFECT OF THE GUIDELINES ON PENDING DESIGN APPLICATIONS DRAWN TO COMPUTER-GENERATED ICONS

USPTO personnel shall follow the procedures set forth above when examining design patent applications for computer-generated icons pending in the USPTO as of April 19, 1996.

III. TREATMENT OF TYPE FONTS

Traditionally, type fonts have been generated by solid blocks from which each letter or symbol was produced. Consequently, the USPTO has historically granted design patents drawn to type fonts. USPTO personnel should not reject claims for type fonts under [35 U.S.C. 171](#) for failure to comply with the “article of manufacture” requirement on the basis that more modern methods of typesetting, including computer-generation, do not require solid printing blocks.

IV. CHANGEABLE COMPUTER GENERATED ICONS

Computer generated icons including images that change in appearance during viewing may be the subject of a design claim. Such a claim may be shown in two or more views. The images are understood as viewed sequentially, no ornamental aspects are attributed to the process or period in which one image changes into another. A descriptive statement must be included in the specification describing the transitional nature of the design and making it clear that the scope of the claim does not include anything that is not shown. Examples of such a descriptive statement are as follows:

“The subject matter in this patent includes a process or period in which an image changes into another

image. This process or period forms no part of the claimed design;” or

“The appearance of the transitional image sequentially transitions between the images shown in Figs. 1-8. The process or period in which one image transitions to another image forms no part of the claimed design;” or

“The appearance of the transitional image sequentially transitions between the images shown in Figs. 1-8. No ornamental aspects are associated with the process or period in which one image transitions to another image.”

1504.01(b) Design Comprising Multiple Articles or Multiple Parts Embodied in a Single Article [R-08.2012]

While the claimed design must be embodied in an article of manufacture as required by [35 U.S.C. 171](#), it may encompass multiple articles or multiple parts within that article. See *Ex parte Gibson*, 20 USPQ 249 (Bd. App. 1933). When the design involves multiple articles, the title must identify a single entity of manufacture made up by the parts (e.g., set, pair, combination, unit, assembly). A descriptive statement should be included in the specification making it clear that the claim is directed to the collective appearance of the articles shown. If the separate parts are shown in a single view, the parts must be shown embraced by a bracket “}”. The claim may also involve multiple parts of a single article, where the article is shown in broken lines and various parts are shown in solid lines. In this case, no bracket is needed. See [MPEP § 1503.01](#).

1504.01(c) Lack of Ornamentality [R-07.2015]

I. FUNCTIONALITY VS. ORNAMENTALITY

An ornamental feature or design has been defined as one which was “created for the purpose of ornamenting” and cannot be the result or “merely a by-product” of functional or mechanical considerations. See *In re Carletti*, 328 F.2d 1020, 140 USPQ 653, 654 (CCPA 1964); *Blisscraft of Hollywood v. United Plastic Co.*, 189 F. Supp. 333,

337, 127 USPQ 452, 454 (S.D.N.Y. 1960), *aff’d*, 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961). It is clear that the ornamentality of the article must be the result of a conscious act by the inventor, as [35 U.S.C. 171](#) requires that a patent for a design be given only to “whoever *invents* any new, original, and ornamental design for an article of manufacture.” Therefore, for a design to be ornamental within the requirements of [35 U.S.C. 171](#), it must be “created for the purpose of ornamenting.” See *In re Carletti*, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964).

To be patentable, a design must be “primarily ornamental.” “In determining whether a design is *primarily functional or primarily ornamental* the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.” See *L. A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir. 1993). The court in *Norco Products, Inc. v. Mecca Development, Inc.*, 617 F.Supp. 1079, 1080, 227 USPQ 724, 725 (D. Conn. 1985), held that a “primarily functional invention is not patentable” as a design.

A determination of ornamentality is not a quantitative analysis based on the size of the ornamental feature or features but rather a determination based on their ornamental contribution to the design as a whole.

While ornamentality must be based on the entire design, “[i]n determining whether a design is primarily functional, the purposes of the particular elements of the design necessarily must be considered.” See *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240, 231 USPQ 774, 778 (Fed. Cir. 1986). See, e.g., *Smith v. M & B Sales & Manufacturing*, 13 USPQ2d 2002, 2004 (N. D. Cal. 1990) (if “significant decisions about how to put it [the item] together and present it in the marketplace were informed by primarily ornamental considerations”, this information may establish the ornamentality of a design.).

EXHIBIT 2



US00D604305S

(12) **United States Design Patent**
Anzures et al.

(10) **Patent No.:** **US D604,305 S**

(45) **Date of Patent:** **** *Nov. 17, 2009**

(54) **GRAPHICAL USER INTERFACE FOR A DISPLAY SCREEN OR PORTION THEREOF**

(75) Inventors: **Freddy Anzures**, San Francisco, CA (US); **Imran Chaudhri**, San Francisco, CA (US)

(73) Assignee: **Apple Inc.**, Cupertino, CA (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/281,460**

(22) Filed: **Jun. 23, 2007**

(51) **LOC (9) Cl.** **32-00**

(52) **U.S. Cl.** **D14/486**

(58) **Field of Classification Search** D14/485-95;
D18/24-33; D19/6, 52; D20/11; D21/324-33;
715/700-867, 973-77

See application file for complete search history.

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(Continued)

Primary Examiner—Melanie H Tung
(74) *Attorney, Agent, or Firm*—Sterne, Kessler, Goldstein & Fox P.L.L.C.

(57) **CLAIM**

The ornamental design for a graphical user interface for a display screen or portion thereof, as shown and described.

DESCRIPTION

The patent file contains at least one drawing executed in color. Copies of this patent with a color drawing will be provided by the Office upon request and payment of the necessary fee.

FIG. 1 is a front view of a graphical user interface for a display screen or portion thereof showing our new design; and,

FIG. 2 is a front view of a second embodiment thereof.

The broken line showing of a display screen in both views forms no part of the claimed design.

1 Claim, 2 Drawing Sheets
(1 of 2 Drawing Sheet(s) Filed in Color)



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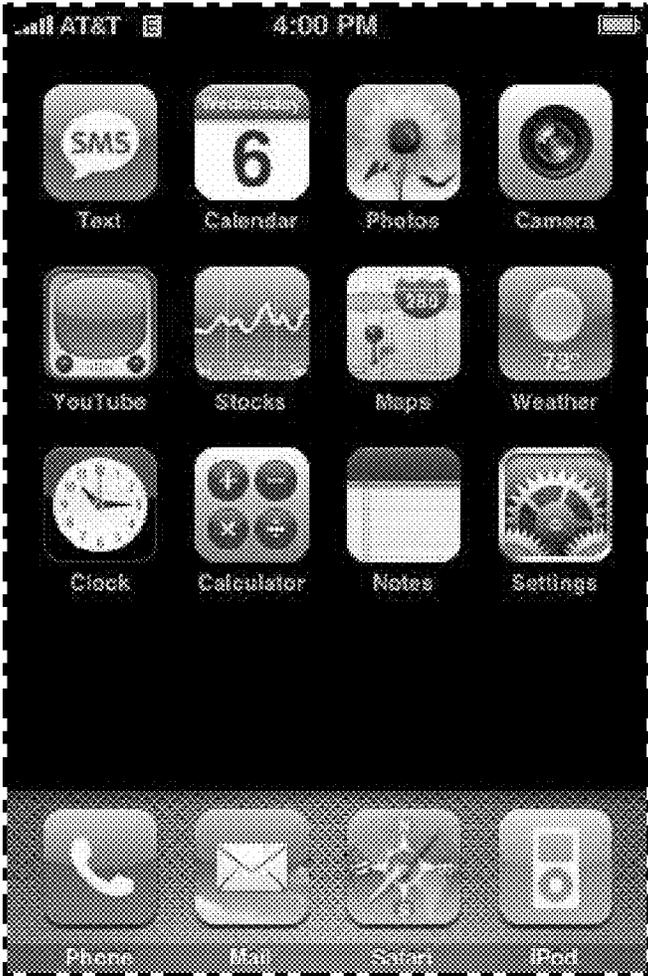


FIG. 1

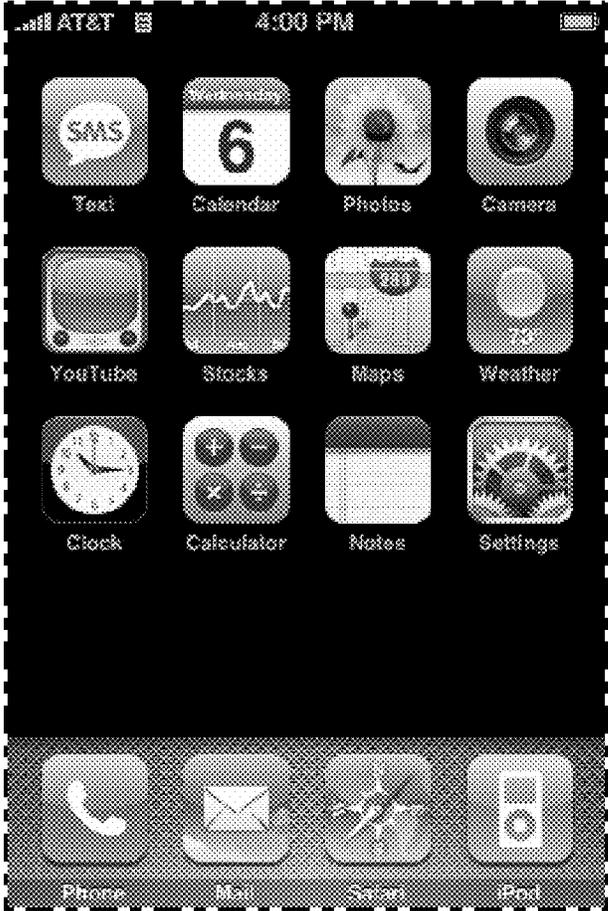


FIG. 2



US00D604305C1

(12) **EX PARTE REEXAMINATION CERTIFICATE** (10979th)
United States Patent
Anzures et al.

(10) **Number:** **US D604,305 C1**
(45) **Certificate Issued:** **Oct. 27, 2016**

(54) **GRAPHICAL USER INTERFACE FOR A DISPLAY SCREEN OR PORTION THEREOF**

(75) Inventors: **Freddy Anzures**, San Francisco, CA (US); **Imran Chaudhri**, San Francisco, CA (US)

(73) Assignee: **APPLE INC.**, Cupertino, CA (US)

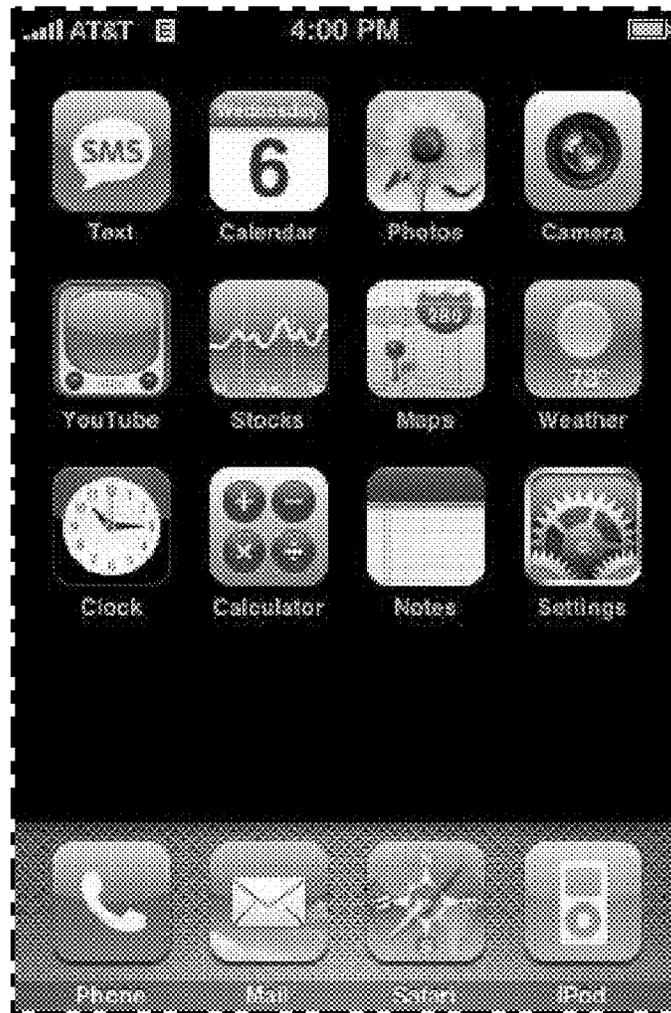
Reexamination Request:
No. 90/012,990, Oct. 7, 2013

Reexamination Certificate for:
Patent No.: **Des. 604,305**
Issued: **Nov. 17, 2009**
Appl. No.: **29/281,460**
Filed: **Jun. 23, 2007**

(51) **LOC (10) Cl.** 14-04
(52) **U.S. Cl.**
USPC **D14/486**

(58) **Field of Classification Search**
USPC D14/485-495
CPC .. G06F 3/048; G06F 3/0481; G06F 3/04817; G06F 3/0482
See application file for complete search history.

(56) **References Cited**
To view the complete listing of prior art documents cited during the proceeding for Reexamination Control Number 90/012,990, please refer to the USPTO's public Patent Application Information Retrieval (PAIR) system under the Display References tab.
Primary Examiner — Darlington Ly



**EX PARTE
REEXAMINATION CERTIFICATE**

NO AMENDMENTS HAVE BEEN MADE TO 5
THE PATENT

AS A RESULT OF REEXAMINATION, IT HAS BEEN
DETERMINED THAT:

The patentability of the sole claim is confirmed. 10

* * * * *

EXHIBIT 3



US00D550237S

(12) **United States Design Patent** (10) **Patent No.:** **US D550,237 S**
Armendariz (45) **Date of Patent:** **** Sep. 4, 2007**

(54) **USER INTERFACE FOR A PORTION OF A DISPLAY SCREEN**

D518,487 S * 4/2006 MacKenzie et al. D14/486
D523,443 S * 6/2006 Hone et al. D14/488
D530,338 S * 10/2006 Winjum et al. D14/485

(75) Inventor: **Nerea Armendariz**, Seattle, WA (US)

OTHER PUBLICATIONS

(73) Assignee: **Microsoft Corporation**, Redmond, WA (US)

www.windowsatoz.com, Microsoft Office 12 Beta 1 review, Nov. 19, 2005.*

(**) Term: **14 Years**

* cited by examiner

(21) Appl. No.: **29/246,955**

Primary Examiner—Alan P. Douglas
Assistant Examiner—Deanna Fluegeman

(22) Filed: **May 22, 2006**

(74) *Attorney, Agent, or Firm*—Banner & Witcoff, Ltd.

(51) **LOC (8) Cl.** **14-04**

(57) **CLAIM**

(52) **U.S. Cl.** **D14/487**

The ornamental design for a user interface for a portion of a display screen, as shown and described.

(58) **Field of Classification Search** D14/485–495;
D18/24–33; D19/6; D20/11; 715/700–845,
715/856–867, 973–977

See application file for complete search history.

DESCRIPTION

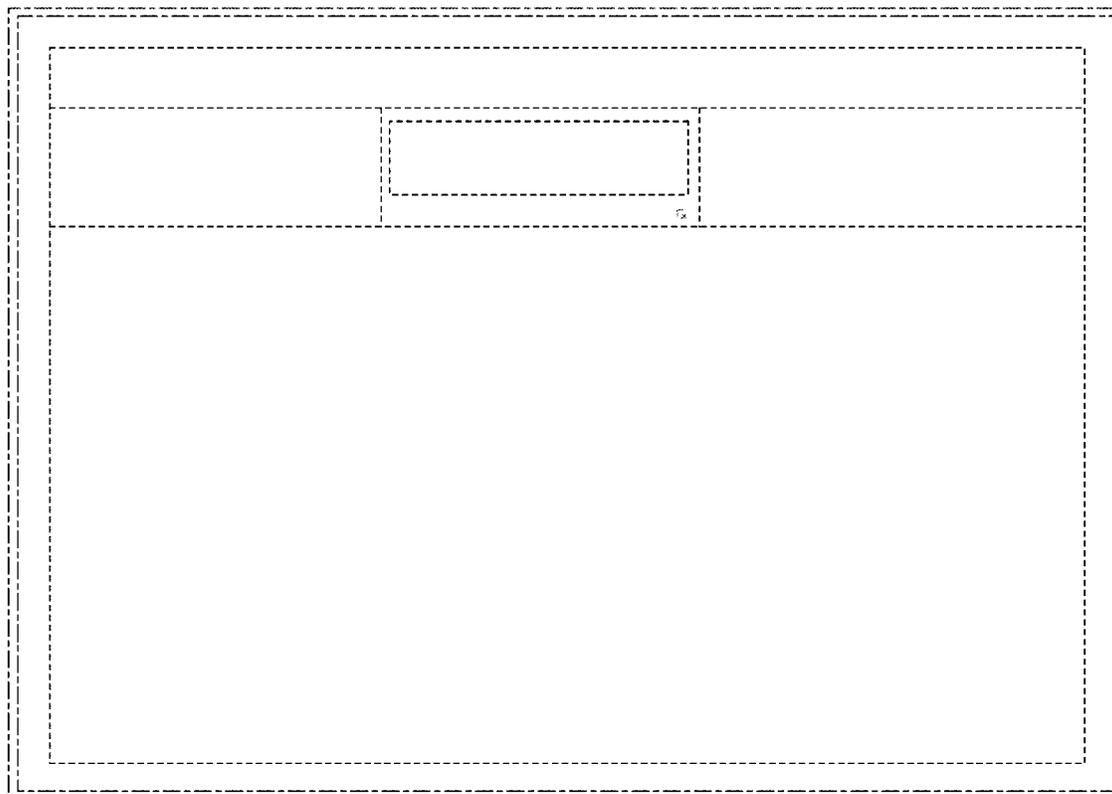
(56) **References Cited**

FIG. 1 is a front view of a user interface for a portion of a display screen showing my new design; and,
FIG. 2 is an enlarged view of the shaded region in FIG. 1.
The broken line showing of various regions and the unshaded areas there within form no part of the claimed design. The broken line showing of the display screen is for illustrative purposes only and forms no part of the claimed design.

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1 Claim, 2 Drawing Sheets



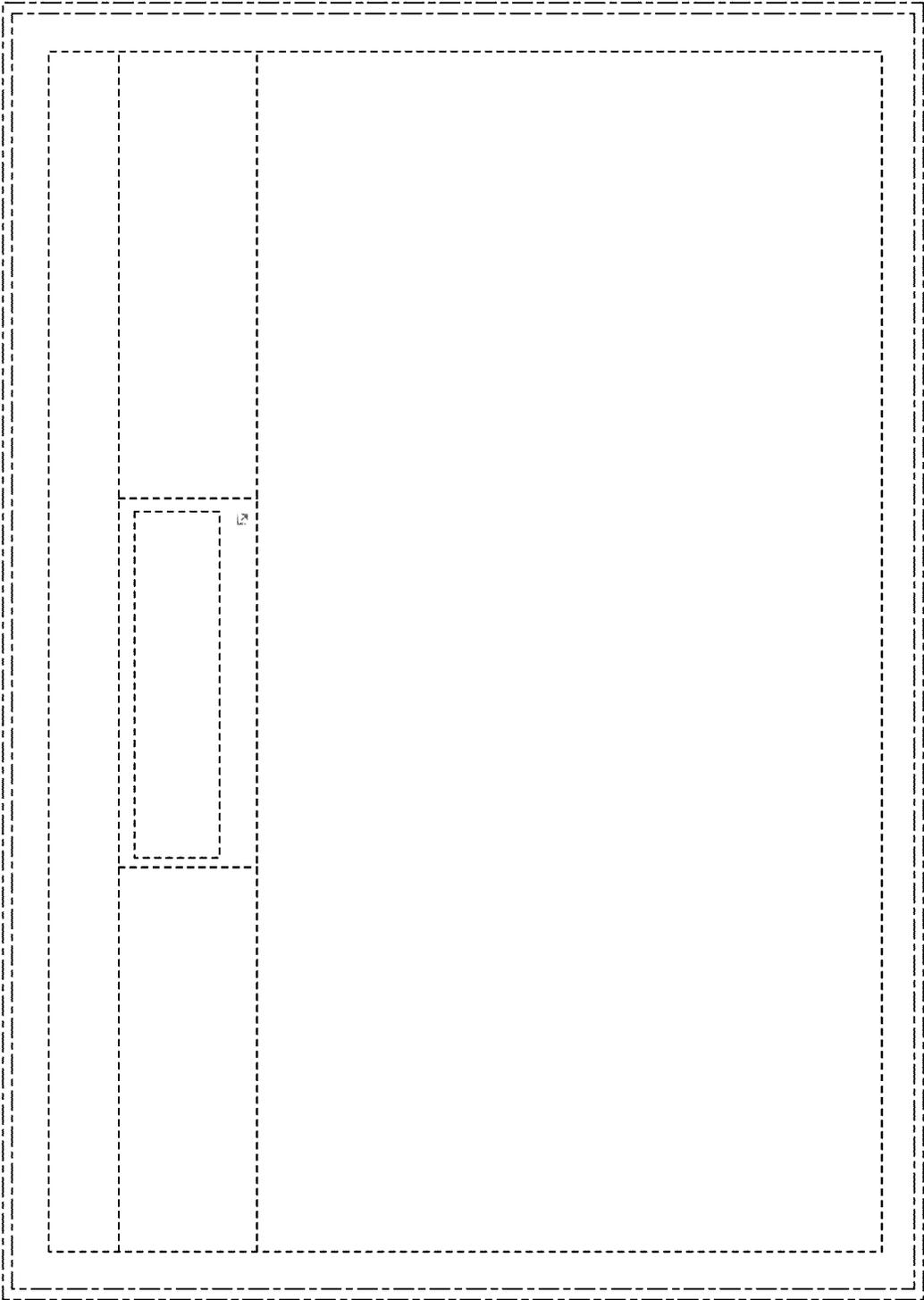


FIG. 1

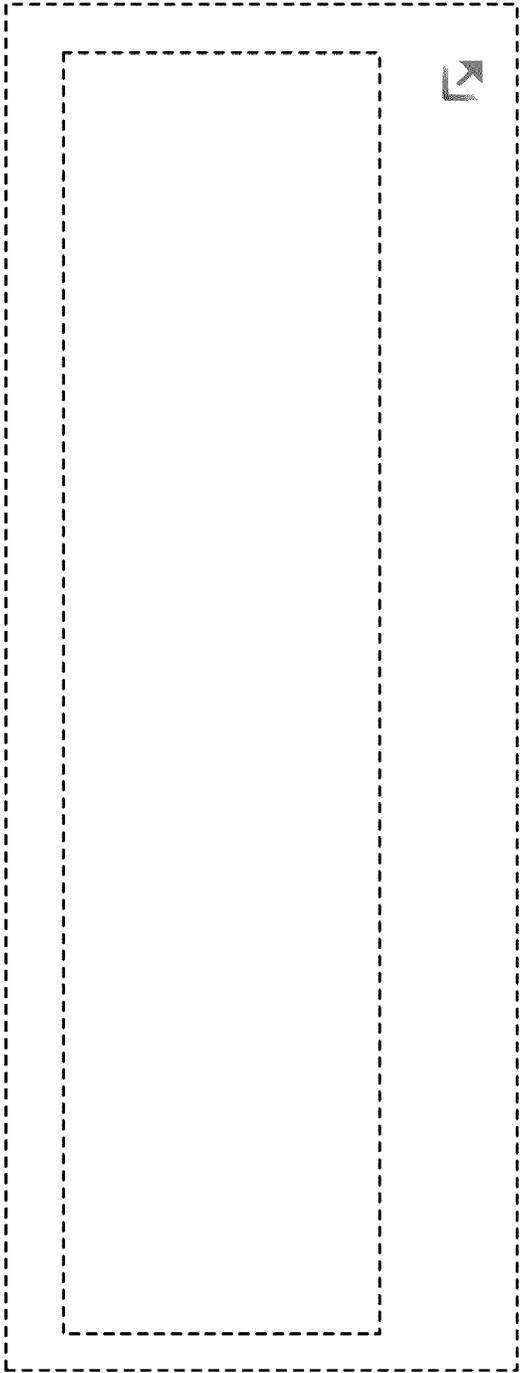


FIG. 2

EXHIBIT 4



US00D554140S

(12) **United States Design Patent**
Armendariz

(10) **Patent No.:** **US D554,140 S**

(45) **Date of Patent:** **** Oct. 30, 2007**

(54) **USER INTERFACE FOR A PORTION OF A DISPLAY SCREEN**

(75) Inventor: **Nerea Armendariz**, Seattle, WA (US)

(73) Assignee: **Microsoft Corporation**, Redmond, WA (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/246,936**

(22) Filed: **May 22, 2006**

(51) **LOC (8) Cl.** **14-04**

(52) **U.S. Cl.** **D14/487**

(58) **Field of Classification Search** D14/485-495;
D19/6; D20/11; 715/700-867, 973-977
See application file for complete search history.

(56) **References Cited**

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Primary Examiner—Cathron C. Brooks

Assistant Examiner—Deanna Fluegeman

(74) *Attorney, Agent, or Firm*—Banner & Witcoff, Ltd.

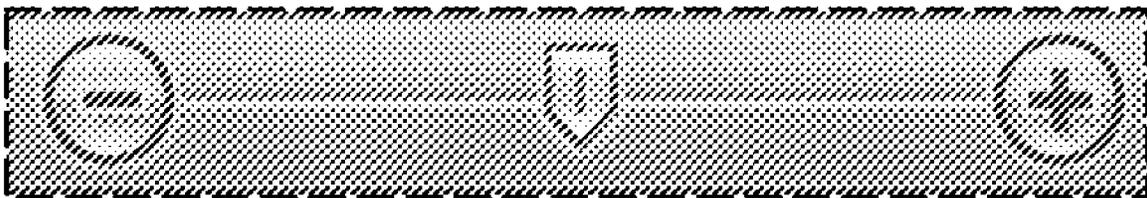
(57) **CLAIM**

The ornamental design for a user interface for a portion of a display screen, as shown and described.

DESCRIPTION

FIG. 1 is a front view of a user interface for a portion of a display screen showing my new design; and, FIG. 2 is an enlarged view of the shaded region in FIG. 1. The broken line bounding the shaded region represents an unclaimed boundary of the design. The broken line showing of various regions and the unshaded areas there within form no part of the claimed design. The broken line showing of the display screen is for illustrative purposes only and forms no part of the claimed design.

1 Claim, 2 Drawing Sheets



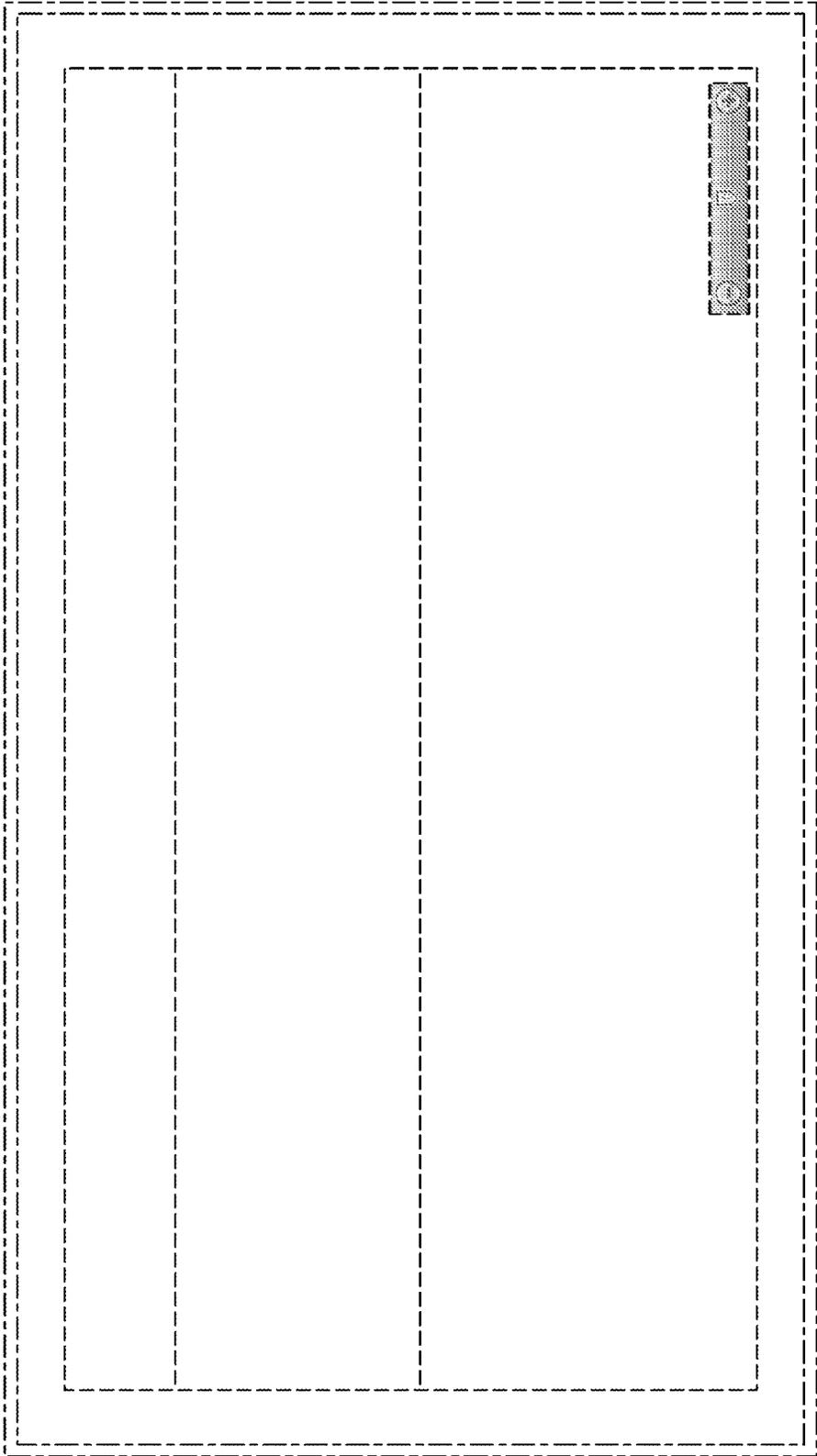


FIG. 1

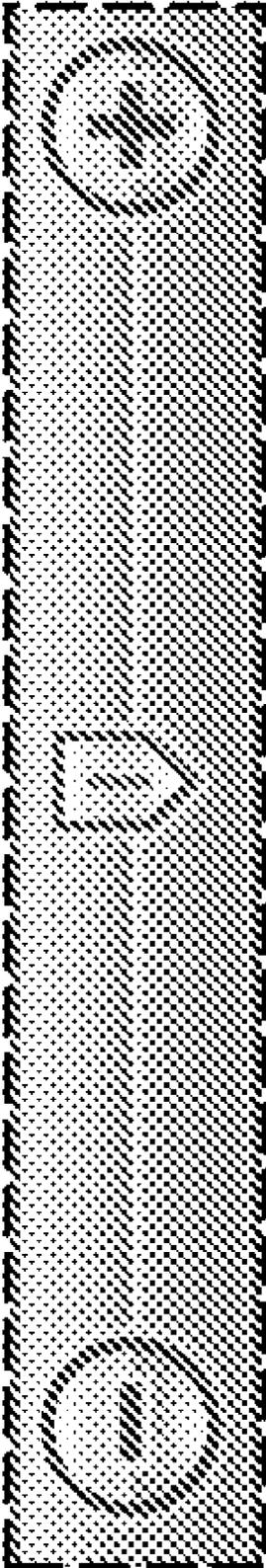


FIG. 2

EXHIBIT 5



US00D564532S

(12) **United States Design Patent**
Sadler

(10) **Patent No.:** **US D564,532 S**

(45) **Date of Patent:** **** Mar. 18, 2008**

(54) **USER INTERFACE FOR A PORTION OF A DISPLAY SCREEN**

(75) Inventor: **Jennifer L. Sadler**, Seattle, WA (US)

(73) Assignee: **Microsoft Corporation**, Redmond, WA (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/246,978**

(22) Filed: **May 23, 2006**

Related U.S. Application Data

(63) Continuation of application No. 29/246,933, filed on May 22, 2006.

(51) **LOC (8) Cl.** **14-04**

(52) **U.S. Cl.** **D14/487**

(58) **Field of Classification Search** D14/485-95;
D18/24-33; D19/6; D20/11; D21/324-33;
715/700-867, 973-77

See application file for complete search history.

(56) **References Cited**

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D501,214 S *	1/2005	Melander et al.	D14/487
D513,009 S *	12/2005	Hone	D14/486

D522,525 S *	6/2006	Melander et al.	D14/487
D528,549 S *	9/2006	McLees et al.	D14/485
D529,506 S *	10/2006	McLees et al.	D14/485
D529,509 S *	10/2006	Stabb	D14/485
D536,342 S *	2/2007	Stabb	D14/487
D541,810 S *	5/2007	Cummins et al.	D14/487
D544,872 S *	6/2007	Sadler et al.	D14/485
D544,878 S *	6/2007	Cummins et al.	D14/487
D550,230 S *	9/2007	Tolle	D14/487
D550,232 S *	9/2007	Tolle	D14/487

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Primary Examiner—Melanie H Tung

(74) *Attorney, Agent, or Firm*—Banner & Witcoff, Ltd.

(57) **CLAIM**

The ornamental design for a user interface for a portion of a display screen, as shown and described.

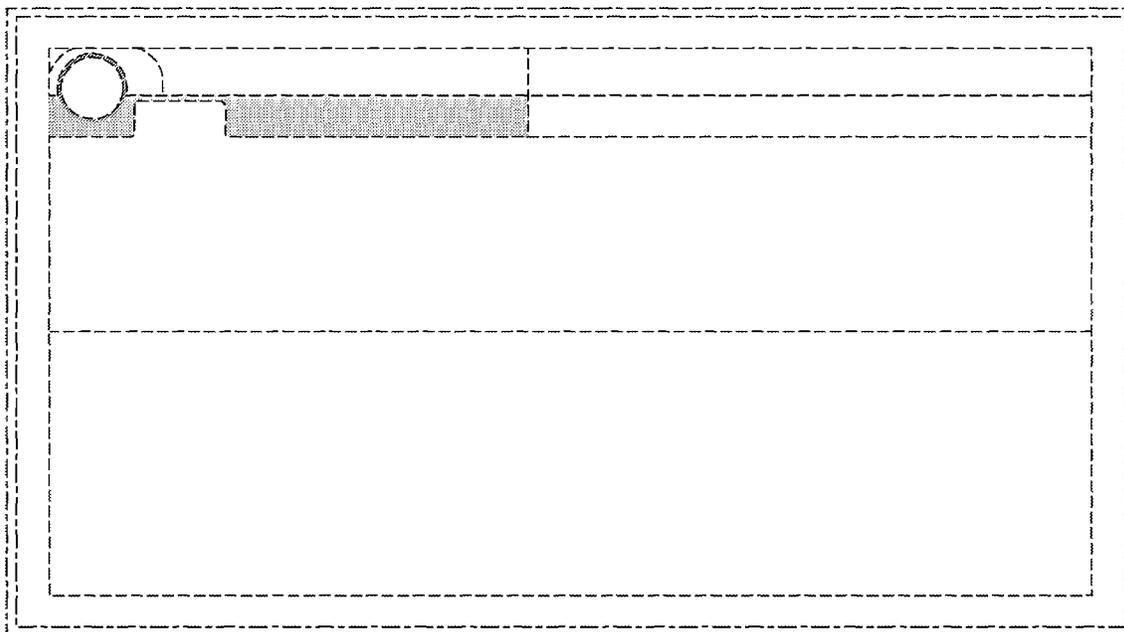
DESCRIPTION

FIG. 1 is a front view of a user interface for a portion of a display screen showing my new design; and,

FIG. 2 is an enlarged view thereof, only a portion is shown for clarity of illustration.

The broken line showing of the elements within the portion of a display screen and the unshaded areas within them form no part of the claimed design. The broken line showing of the display screen is for illustrative purposes only and forms no part of the claimed design.

1 Claim, 2 Drawing Sheets



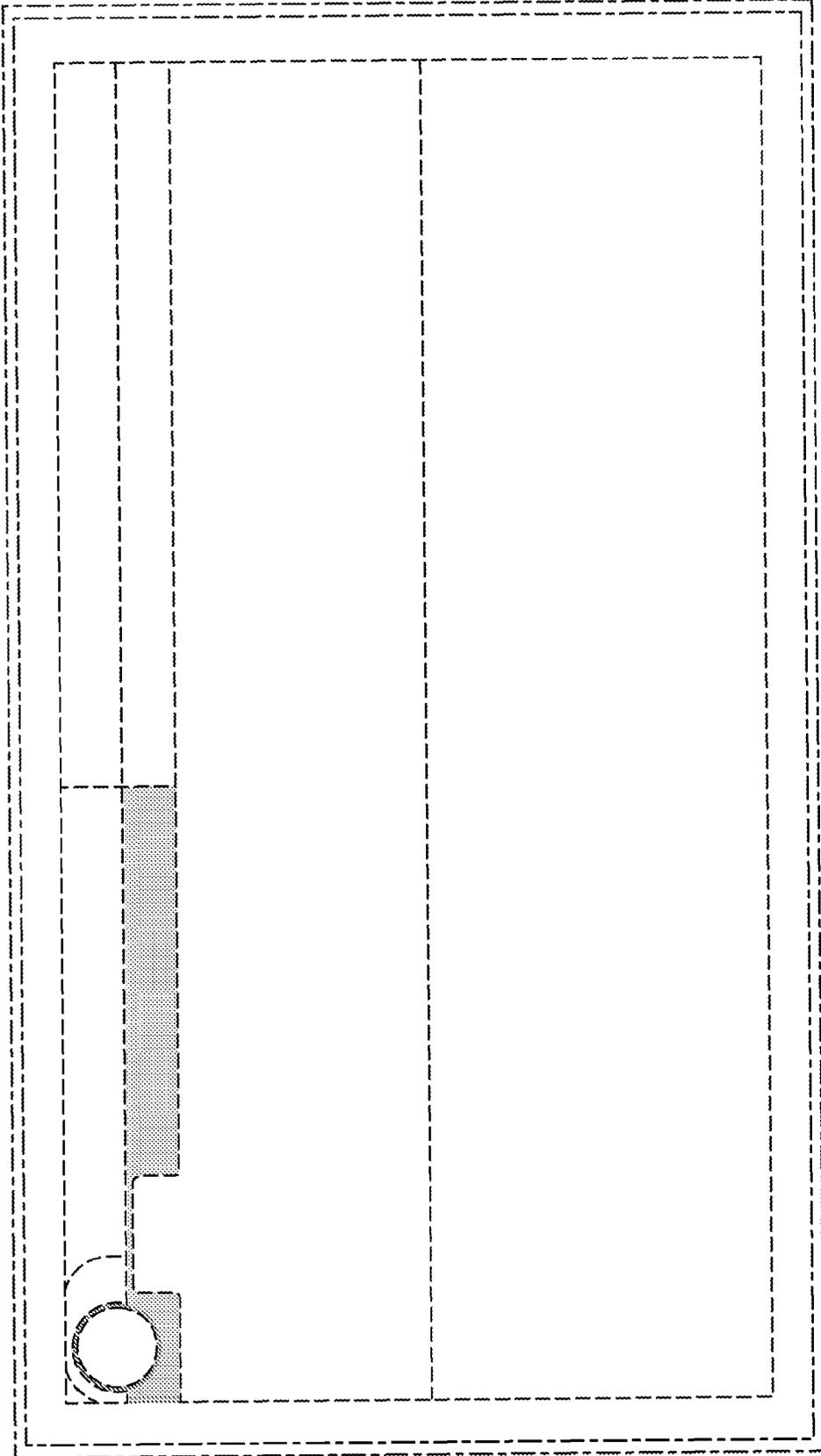


FIG. 7

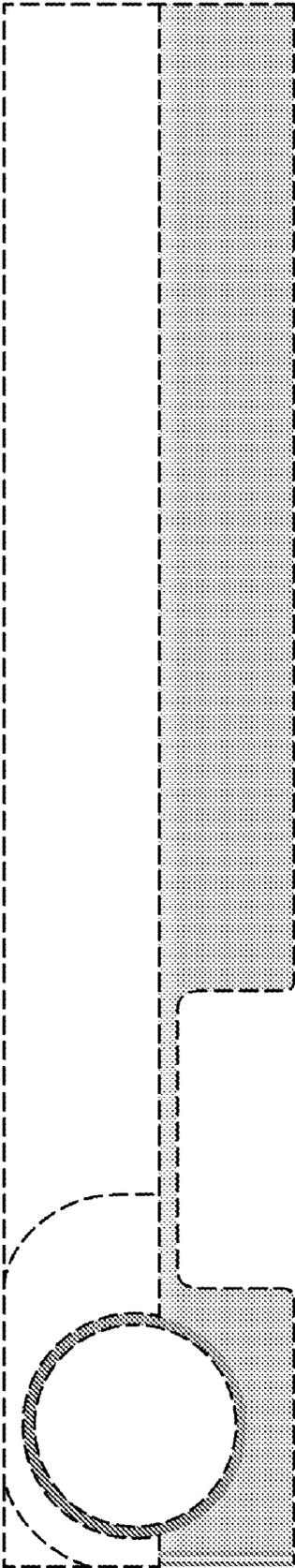


FIG. 2

EXHIBIT 6



US00D570865S

(12) **United States Design Patent**
Sadler

(10) **Patent No.:** **US D570,865 S**

(45) **Date of Patent:** **** Jun. 10, 2008**

(54) **USER INTERFACE FOR A PORTION OF A DISPLAY SCREEN**

(75) Inventor: **Jennifer L. Sadler**, Seattle, WA (US)

(73) Assignee: **Microsoft Corporation**, Redmond, WA (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/247,012**

(22) Filed: **May 23, 2006**

Related U.S. Application Data

(63) Continuation of application No. 29/246,933, filed on May 22, 2006.

(51) **LOC (8) Cl.** **14-04**

(52) **U.S. Cl.** **D14/487**

(58) **Field of Classification Search** D14/485-95;
D18/24-33; D19/6; D20/11; D21/324-33;
715/700-867, 973-77

See application file for complete search history.

(56) **References Cited**

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D552,619 S * 10/2007 Sato et al. D14/486
D556,766 S * 12/2007 Keohane D14/487

* cited by examiner

Primary Examiner—Melanie H Tung

(74) *Attorney, Agent, or Firm*—Banner & Witcoff, Ltd.

(57) **CLAIM**

The ornamental design for a user interface for a portion of a display screen, as shown and described.

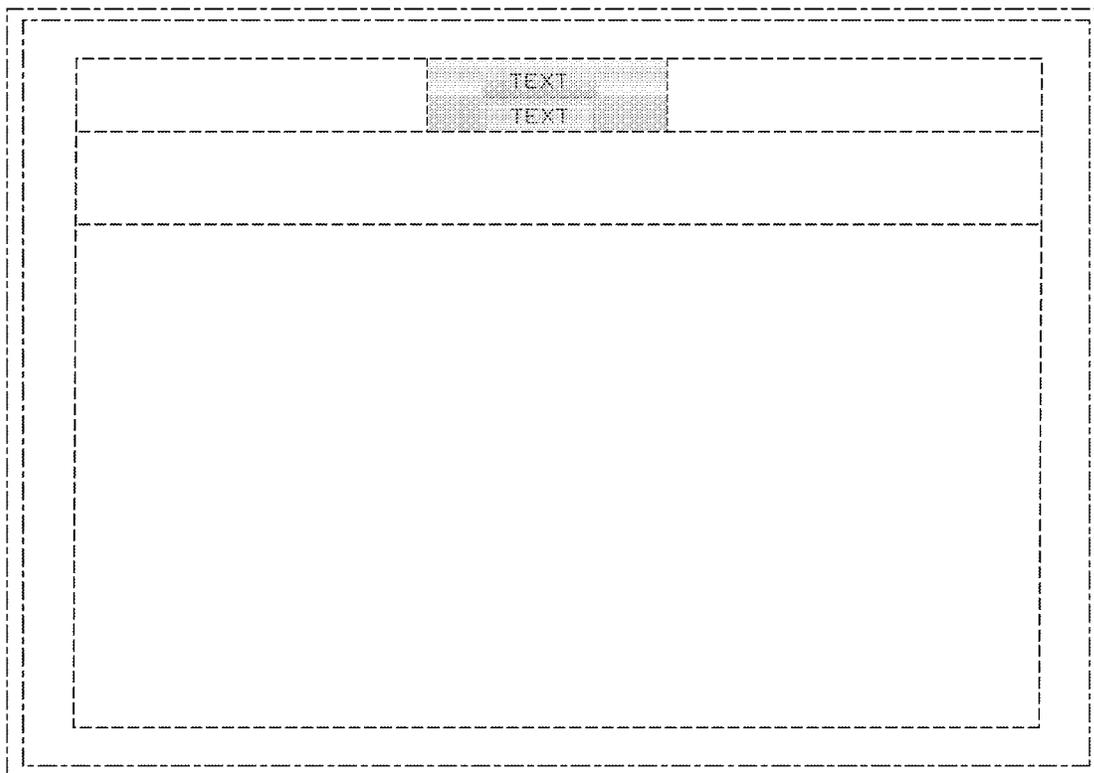
DESCRIPTION

FIG. 1 is a front view of a user interface for a portion of a display screen showing my new design; and,

FIG. 2 is an enlarged front view thereof, the user interface is shown separately for clarity of illustration.

In both figure views, the broken line showing of the text forms no part of the claimed design. The broken line showing of a portion of a display screen in FIG. 1 is for illustrative purposes only and forms no part of the claimed design.

1 Claim, 2 Drawing Sheets



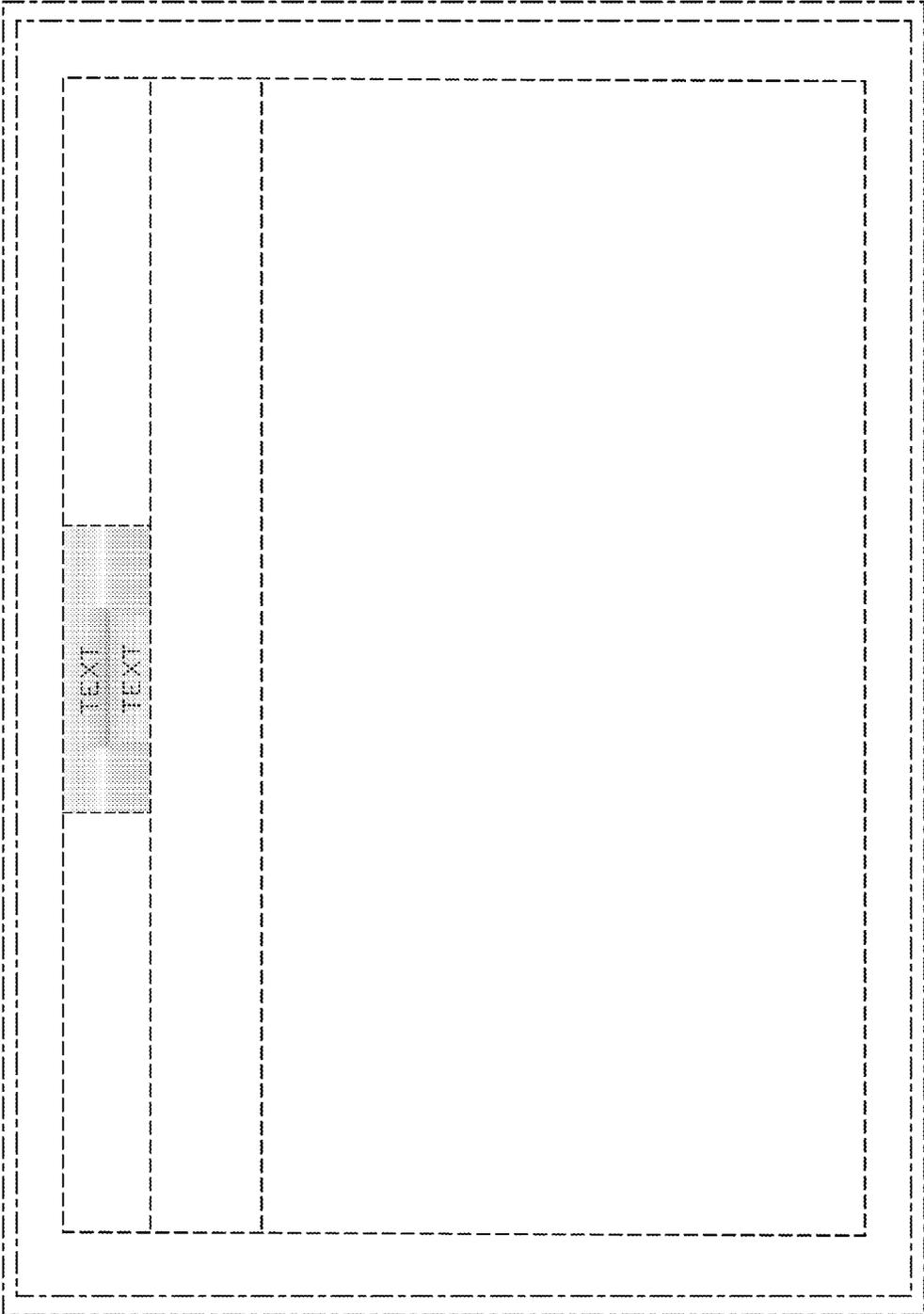


FIG. 1

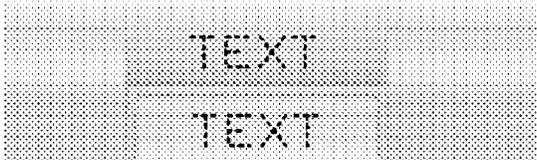


FIG. 2

EXHIBIT 7

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JENNIFER L. SADLER, XIAOGANG YANG,
NEREA ARMENDARIZ, MARIA M. CAMERON,
JESSE CLAY SATTERFIELD, ROBERT F. KEOHANE,
SANGRAM SALUNKHE, and SANDER M. VIEGERS

Appeal 2014-001032
Application 29/275,866
Technology Center 2900

Before JILL D. HILL, MITCHELL G. WEATHERLY, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jennifer L. Sadler et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting the single design claim pending in this appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a design for user interfaces. The claim on appeal is "[t]he ornamental design for USER INTERFACES FOR A PORTION OF A DISPLAY SCREEN as shown and described." Spec. 7.

REJECTIONS

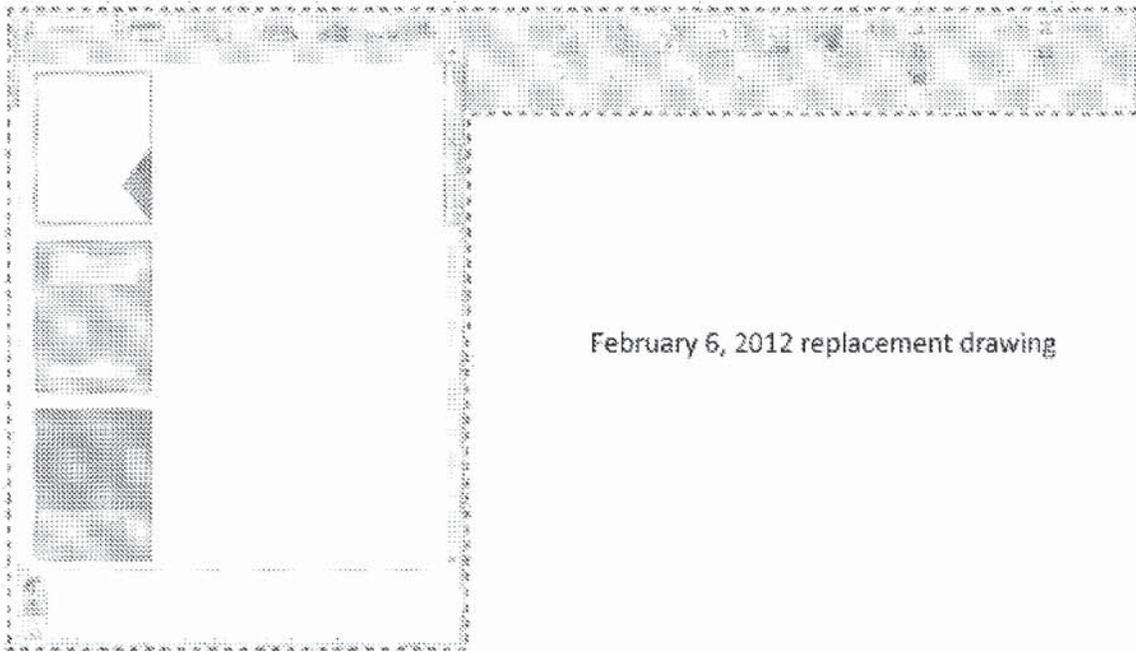
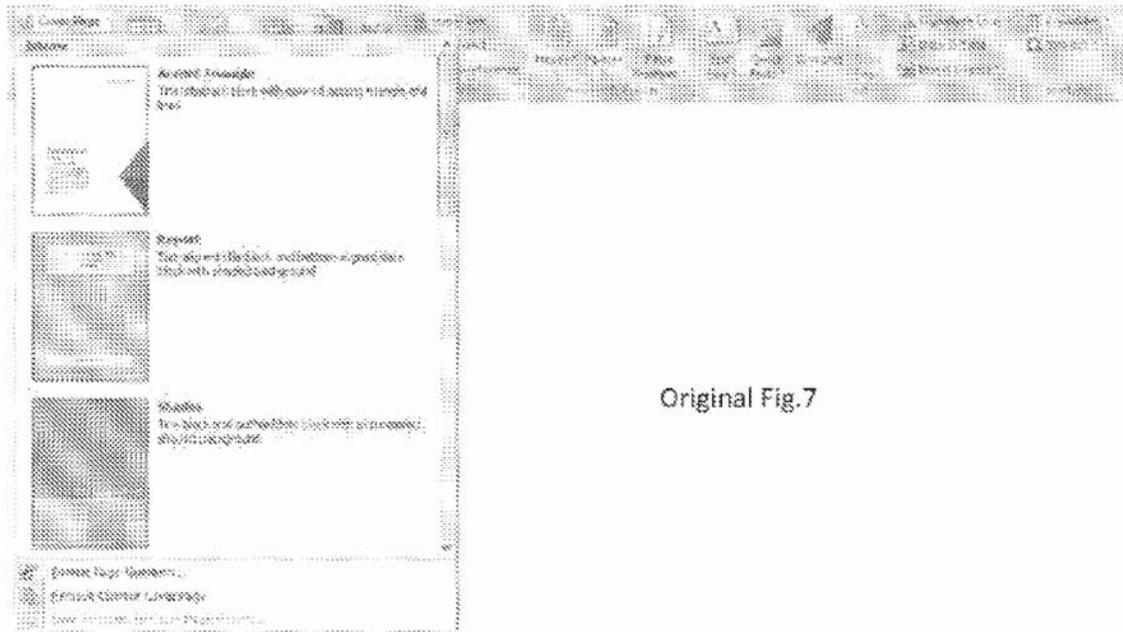
The claim stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement "since the drawing submitted February 6, 2012 introduces new matter not supported by the original disclosure." Final Act. 2; Ans. 2.

OPINION

The only issue before us on appeal is whether removal of text from the user interface design, as represented in the Replacement Sheet submitted February 6, 2012, presented new matter in violation of 35 U.S.C. § 112, first paragraph. Final Act. 3–4.¹

A comparison of originally-filed Figure 7 and the amended Replacement Sheet is provided on page 3 of the Answer, and is reproduced below.

¹ The written description rejection based on the addition of a broken line immediately adjacent to the graphical user interface (GUI) was withdrawn. Ans. 1.



Ans. 3.

Appellants argue that the originally-filed disclosure makes clear that the inventors, at the time of filing, had possession of the design claimed in the amended Figure. Br. 3 (citing *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)).

Appellants refer to the following language (the “disclaimer language”) of the original disclosure as supporting removal of text in the amendment:

Some of the Figures also bear graphical indicia, including a trademark and/or letters, *words* and/or symbols. Applicants reserve the right to amend this application and/or to file one or more continuation and/or divisional applications to specifically claim or disclaim any such indicia and to present the designs void of any such indicia.

Original Spec. 6 (dated Jan. 1, 2007) (emphasis added).²

The Examiner disagrees, contending that the rejection is proper because Appellants removed the above language from the Specification, so that “it is not part of the disclosure and cannot be relied on at this stage of the prosecution.” Final Act. 4. Appellants counter that removal of disclosure during prosecution does not negate the existence of such disclosure in the original Specification, and thus fully supports Appellants throughout prosecution. Br. 5.

We agree with Appellants that removal of the disclaimer language from the original Specification does not negate its availability as a source of support in the original disclosure. It is well accepted that a satisfactory description for the purposes of 35 U.S.C. § 112, first paragraph, may be found in any portion of the originally-filed specification and claims. The Examiner has provided no support for the contention that removal of disclosure during prosecution can negate that disclosure’s availability as written description support.

The Examiner also contends that, even if the disclaimer language were re-inserted into the Specification, it “is vague and indefinite and would

² The language was removed from the Specification in the Amendment of September 9, 2008.

be the basis of a rejection under 35 U.S.C. 112, first and second paragraph,” because the “language does not clearly point out which indicia are claimed or unclaimed in future or amended variations of the original disclosure.”

Final Act. 4. According to the Examiner, all of the indicia could be removed from the design, leaving no claimed subject matter. *Id.* The Examiner then states that the language “does not . . . specifically support the removal of the text,” because “there is no language that specifically states that the text is not part of the claimed design.” *Id.*; Ans. 11.

We first note that the disclaimer language specifically states that the Figures include “graphical indicia, including . . . words,” and that Appellants “reserve the right to amend this application . . . to specifically claim or disclaim any such indicia.” Original Spec. 6. We are not persuaded that the disclaimer language failed to cover the words, or text portions, that were removed from the Figure.

Regarding the Examiner’s contention that, given the scope of the disclaimer language, all of the indicia could be removed from the design, leaving no claimed subject matter, Appellants respond by pointing out that they have amended the claim (i.e., the Figure) only by removing text labels. Br. 6. Thus, Appellants contend, the issue is whether the originally-filed disclosure “reasonably convey[s] to a designer of ordinary skill in the art at the time of the invention that the Appellants were in possession of the design now claimed.” *Id.* We agree with Appellants that the issue before us is limited to whether the removed text creates a new design that is not supported by the original disclosure.

Although the Examiner contended that a designer of ordinary skill would not understand that Appellants were in possession of the design now

claimed (Final Act. 2; Ans. 2), the Examiner provided no reasoning applicable to the actual amended Figure and resulting claim. Rather, the Examiner warns that (1) “[w]hen, by amendment, Appellants broaden a design claim by designating less than the entire original design, there is a hazard of creating a new design,” and (2) when an amended design “is not recognizable in the original design, to the exclusion of other designs, then the resulting design is new relative to the original one.” Ans. 5. Such warnings do not persuade us that Appellants’ amended Figure itself presents a new design that lacks written description support.

Regarding text specifically, the Examiner contends that a designer of ordinary skill would “appreciate that placement and appearance of text fonts has a role as a design component in the overall graphic image and is not merely a functional or secondary consideration. Font design has aesthetic. . . value, and font placement is inextricably tied to the graphic that is created.” Ans. 10. While this may be true, the Examiner again fails to point out actual differences between original Figure 7 and the amended Figure, and to explain why such differences cause Appellants’ amended Figure to present a new design that lacks written description support.

Here, Appellants are removing discrete portions of design detail to broaden the claim. We discern no fundamental problem with such broadening when disclaimer language covers this removal and is available as written description support, and the Examiner has not persuaded us that the text removal rises to the level of creating a new design that lacks written description support. For this reason, we do not sustain the pending rejection.

Appeal 2014-001032
Application 29/275,866

DECISION

We REVERSE the rejection of the claim under 35 U.S.C. § 112, first paragraph.

REVERSED



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BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			TUNG, MELANIE H	
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EXHIBIT 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOM THAI, JOHN KILPATRICK,
DEJAN SORMAZ, RAMON ESPINOSA,
DAVID EDWARD MILLER, and KARIN JO EANES

Appeal 2015-007954
Application 29/376,570
Technology Center 2900

Before: JENNIFER S. BISK, JILL D. HILL, and CYNTHIA L. MURPHY,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Tom Thai et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting the single design claim pending in this appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a design for a display apparatus. The claim on appeal is "[t]he ornamental design for A DISPLAY APPARATUS INCLUDING A COMPUTER GENERATED ICON, as shown and described." Spec. 4.

REJECTION

The claim stands rejected under 35 U.S.C. § 103(a) as unpatentable over Cadiz (US 2003/0164862 A1, pub. Sept. 4, 2003) and Mogilevsky (US 7,647,553 B2, iss. Jan. 12, 2010). Final Act. 2.

OPINION

The Examiner finds that Cadiz discloses a user interface with design characteristics that "are basically the same as those of the claimed design." Final Act. 2. According to the Examiner, Cadiz's Fig. 5 shows three rectangular elements in the same arrangement as the claimed design, including "an elongated rectangular element on the right side and two rectangular elements of the same width arranged in a vertical orientation on the left side, wherein the rectangular element on the right side has a greater height than the combined height of the two rectangular elements on the left side." *Id.* The Examiner finds the following differences between Cadiz and the claimed design: (1) unlike Cadiz, the right rectangular element of the claimed design is narrower in width than the two rectangular elements on the left side, (2) the two left rectangular elements of Cadiz are the same height while the two left rectangular elements of the claimed design are different heights, with the bottom left rectangular element having a greater height

than the top left rectangular element, (3) the spacing between the three rectangular elements of the design of Cadiz is consistent, while the claimed design's spacing between the right rectangular element and the left rectangular elements is wider than the space between the two left rectangular elements, and (4) the combined height of Cadiz's two left rectangular elements is shorter relative to the height of the right rectangular element. *Id.* at 2–3. The Examiner provides the following side-by-side comparison of Cadiz's Figure 5 and the claimed design.

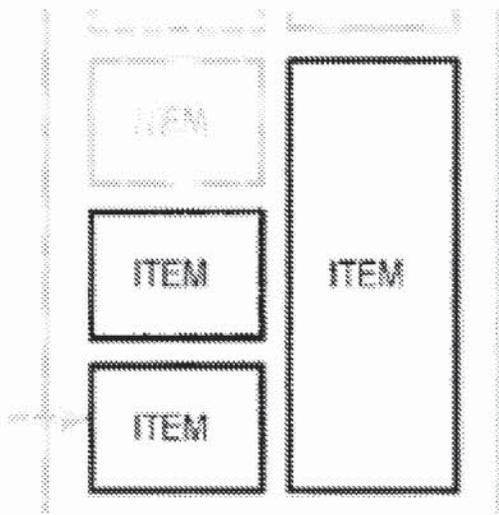


Fig. 5 of 2003/0164862 of Cadiz et al.



The claimed design of the present application

The Examiner proposes to combine Cadiz with Mogilevsky, concluding that it would have been obvious to a designer of ordinary skill in the art to modify Cadiz's user interface in accordance with Mogilevsky's illustrated user interface design so that (1) the right rectangular element is narrower than the two left rectangular elements, (2) the bottom left rectangular element has a greater height than the top left rectangular element, and (3) the space between the right and left rectangular elements is wider than the space between the two left rectangular elements. *Id.* at 4. The Examiner contends that the combination of Cadiz and Mogilevsky

“would result in an appearance over which the claimed design shows no patentable difference.” *Id.*

The Examiner then contends that the following remaining differences between the combined teachings of Cadiz and Mogilevski and the claimed design exist, but are *de minimis*: (1) “that the right rectangular element is approximately $\frac{1}{2}$ the width of the left rectangular elements in the design of Mogilevsky while the right rectangular element is approximately $\frac{3}{4}$ the width of the left rectangular elements in the claimed design,” (2) a difference between the actual heights of the rectangular elements of Mogilevsky and the claimed design, and (3) the difference in actual spacing between the rectangular elements of the user interface of Mogilevsky and the claimed design. *Id.*

Appellants argue, *inter alia*, that “Fig. 5 of Cadiz is not an appropriate primary reference,” because the Examiner erred in determining that the selected portion of Cadiz’s Fig. 5 is “basically the same” as the claimed design. Appeal Br. 11 (emphasis omitted); see *In re Rosen* 673 F.2d 388, 391 (1982) (“There must be a reference, a something in existence, design characteristics of which are basically same as claimed design in order to support holding of obviousness.”). According to Appellants, “the overall appearance of the three items of Cadiz present a different overall visual impression in terms of shape of the elements and their respective spacing than [Appellants’] claimed design.” *Id.* (emphasis omitted). Appellants provide a detailed list of the differences between the Examiner’s selected portion of Cadiz’s Fig. 5 and the claimed design, which are similar to the differences acknowledged by the Examiner, defined in part as differing “aspect ratios” of the boxes and overall symmetry. *Id.* at 12–13. Appellants

contend that “[t]he Examiner cannot reasonably assert that the aspect ratios do not significantly change the overall appearance of the elements, and hence the overall appearance of the design.” *Id.* at 12. Appellants support their contention by asserting that “differences in shape and spacing between the elements collectively gives the claimed design a much different overall visual appearance,” because “Cadiz appears to strive for balance by having a right item that is equivalent in height [of the] three left items and by placing the elements equidistant from one another,” whereas the “claimed design has elements that do not have such a visually-balanced relationship as in Cadiz and have not been placed equidistant from one another.” *Id.* at 13 (emphasis omitted).

The Examiner responds that, despite the acknowledged differences between the selected portion of Cadiz and the claimed design, “the differences between the two designs are secondary, rather than primary, considerations, and do not rise to the level of causing the two designs to have overall different impressions.” Ans. 10. The Examiner continues that the designs are basically the same because each of the designs comprises three rectangular features, wherein two rectangular features are stacked on the left side and the third rectangular feature is on the right, the right rectangular feature is taller than the stacked two left rectangular features, and the spacing between all three rectangular features is relatively narrow. *Id.* According to the Examiner, “[t]he widths and heights of the rectangles and the spacing between the rectangles, while objectively different . . . , do not vary so wildly that they significantly affect the visual impression,” and thus “do not constitute primary design characteristics that must be present in the primary reference.” *Id.*

We agree with Appellants that Cadiz is not a suitable primary (or *Rosen*) reference, at least because the selected portion of Cadiz does not have design characteristics that are basically same as claimed design. As acknowledged by the Examiner, there are four differences between the selected portion of Cadiz and the claimed invention. Final Act. 2–3. Indeed, even after combining the selected portion of Cadiz with Mogilevsky, the Examiner acknowledges three differences between the proposed combination and the claimed design. *Id.* at 4. The Examiner contends that these differences are not “primary” design characteristics and thus do not prevent Cadiz from being a suitable primary reference. Ans. 9. We are not aware of any case law recognizing that design characteristics can be categorized as “primary” and “secondary,” much less any case law holding that a reference is still a suitable primary (or *Rosen*) reference even though it has multiple different “secondary” design characteristics.

Even though the selected portion of Cadiz also shows three rectangular features being narrowly spaced from each other, with two rectangular features stacked on the left side and a taller third rectangular feature on the right side, these similarities are not enough to create basically the same design characteristics. We agree with Appellants that the selected portion of Cadiz has a “much different overall visual appearance,” because “Cadiz appears to strive for [symmetry or] balance,” whereas the “claimed design has elements that do not have such a visually-balanced [or symmetrical] relationship.” Appeal Br. 13. The contrast between symmetry and asymmetry prevents the designs from having “basically the same” design characteristics or the same “overall visual appearance” as required for a primary (or *Rosen*) reference. Because Cadiz is not a suitable primary

Appeal 2015-007954
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reference, prima facie obviousness has not been established and we do not sustain the obviousness rejection.

DECISION

We REVERSE the rejection of the claim under 35 U.S.C. § 103(a) as unpatentable over Cadiz and Mogilevsky.

REVERSED



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PRATT, DEANNA L

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