



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
29/490,118 05/07/2014 Steven Richard Scott 60795-301910 7297

73744 7590 12/26/2018
Patent Law Office of Larry Guernsey
P.O. Box 720247
San Jose, CA 95172-0247

Table with 1 column: EXAMINER

AMAN, ANNA KATHY

Table with 2 columns: ART UNIT, PAPER NUMBER

2914

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

12/26/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

larrygpatent@sbcglobal.net

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* STEVEN RICHARD SCOTT

---

Appeal 2017-002509  
Application 29/490,118  
Technology Center 2900

---

Before JILL D. HILL, GEORGE R. HOSKINS, and  
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Steven Richard Scott (“Appellant”)<sup>1</sup> appeals under 35 U.S.C. § 134 from the Examiner’s rejection of his design claim under 35 U.S.C. §§ 112(a) & 112(b), for lack of enablement and for indefiniteness. Non-Final Act. (mailed Dec. 10, 2015, “Non-Final Act.”), 1; MPEP § 1504.04(I)(A). The Board has jurisdiction over the appeal under 35 U.S.C. §§ 6(b) & 171(b).

We REVERSE.

---

<sup>1</sup> Motion Pro, Inc. is the applicant (37 C.F.R. § 1.46), and is identified in the Appeal Brief as the real party in interest (Appeal Br. 2).

### CLAIMED SUBJECT MATTER

The claim is directed to “the ornamental design for a FUEL INJECTOR CLEANER BLOCK as shown and described.” Appeal Br. 18 (Claims App.). The claimed design is shown in Figures 1–8. *See* Application (filed May 7, 2014), Original Figs. 1–4 & 6–8; Response (filed Feb. 24, 2015), Replacement Fig. 5; Non-Final Act. 2–8 (analyzing original Figs. 1–4 and 6–8, and replacement Fig. 5).

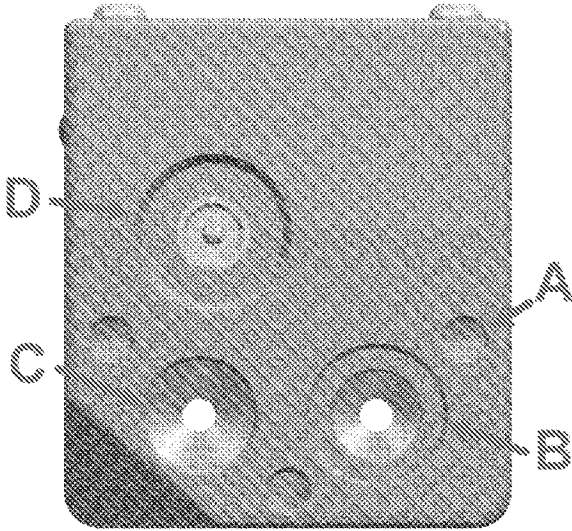
Figures 1–6 show plan views of the six faces of the block design, identified respectively as a top view, a front view, a right side view, a rear view, a left side view, and a bottom view. Appeal Br. 18 (Claims App.). Figures 7 and 8 show top and bottom isometric views of the block design. *Id.*

### ANALYSIS

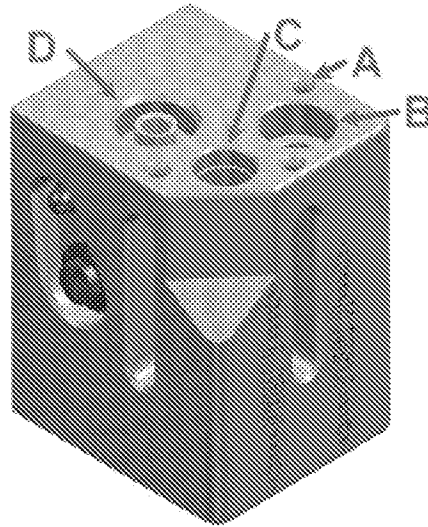
The Examiner identifies several features of the claimed design that, in the Examiner’s view, are indefinite, and therefore non-enabling. *See* Non-Final Act. 1–9; Ans. 2–8. We first identify the features at issue, then we consider the Examiner’s rejection and Appellant’s arguments in opposition.

*A. Features of Claimed Design At Issue*

Figures 1 and 7 are reproduced below, with annotations identifying particular features A, B, C, and D:

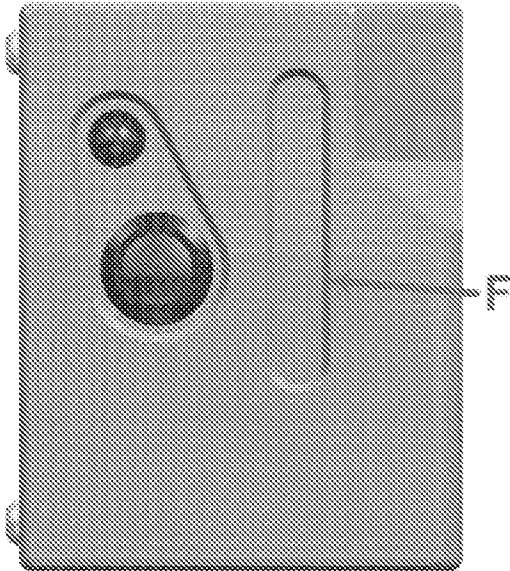


**Figure 1 (top face)**

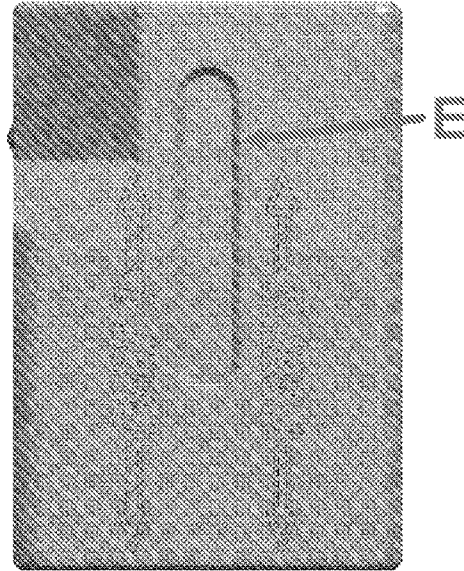


**Figure 7 (top isometric view)**

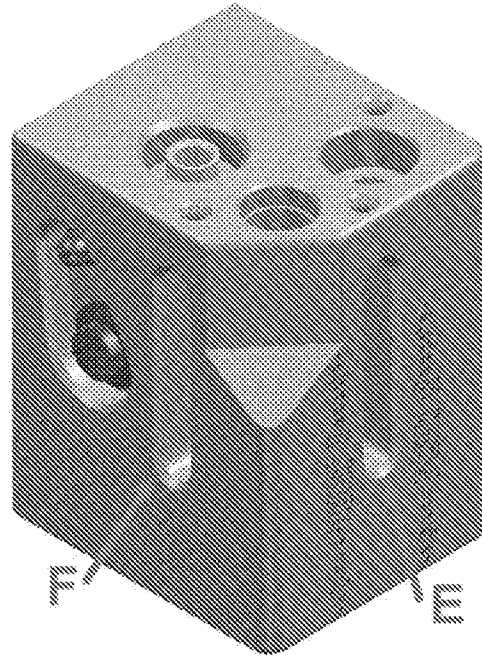
Figures 2, 5, and 7 are reproduced below, with annotations identifying particular features E and F:



**Figure 5 (left face)**

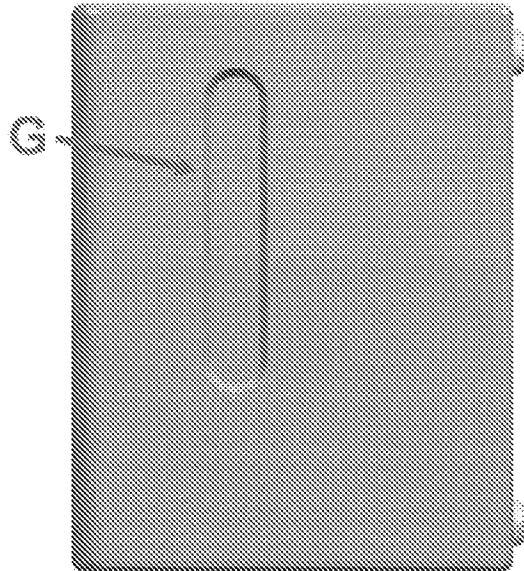


**Figure 2 (front face)**



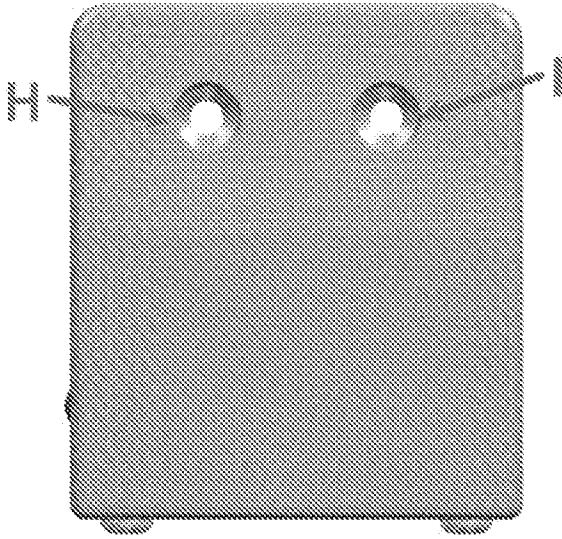
**Figure 7 (top isometric view)**

Figure 3 is reproduced below, with an annotation identifying a particular feature G. The block face shown in Figure 3 is not seen in the isometric views of Figures 7 and 8.

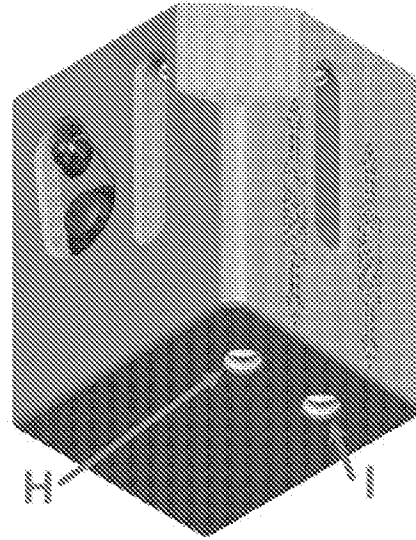


**Figure 3 (right face)**

Figures 6 and 8 are reproduced below, with annotations identifying particular features H and I:



**Figure 6 (bottom face)**



**Figure 8 (bottom isometric view)**

*B. Examiner's Rejection and Appellant's Opposition*

The Examiner determines the depth of feature A is “not known.” Non-Final Act. 2; Ans. 2. In particular, the Examiner determines it is unclear whether feature A is an aperture opening into the recess of feature G of Figure 3, or a recess having a bottom above the recess of feature G. Non-Final Act. 7–8 (including annotations to Figure 3 illustrating the two possibilities); Ans. 7.

The Examiner determines the “configuration of the details inside [feature D] are left to the imagination.” Non-Final Act. 3; Ans. 3, 7–8. The Examiner provides a drawing of three “possible examples” of cross-sectional views of the shape in the central area of feature D, if viewed from the side, as follows:



**Examiner's Drawings of Different Cross-Sectional Configurations of the Central Detail in Feature D**

Non-Final Act. 8; Ans. 8, 17–18 (“The detail[] could be recessed deep into the cavity, the detail could be a cylindrical pillar, or the detail could be a tapered pillar.”)

The Examiner determines the respective depths of the tapered interior walls of features B, C, H, and I are each “unclear.” Non-Final Act. 3; Ans. 3, 4. The Examiner determines the depth of the details inside feature D is “left to the imagination.” Non-Final Act. 3; Ans. 3. The Examiner determines the respective depths of the oval recess features E, F, and G are each “unclear” or “left to conjecture.” Non-Final Act. 2, 3, 4; Ans. 3, 4, 5.

In the Examiner's view, “[a] designer of ordinary skill must be able to observe the design in a narrowly understood meaningful way.” Non-Final Act. 5 (citations omitted); Ans. 5–6. The Examiner determines the respective depths and tapering walls of the features identified above “are subject to multiple interpretations as they could be understood to be configured several ways,” including a few that the Examiner identifies with annotations. Non-Final Act. 5–8; Ans. 6–7.

Appellant contends the Examiner's rejection “demonstrates a profound and basic misunderstanding of the fundamentals of design patent law.” Appeal Br. 4. In Appellant's view, a design patent claim covers “only that exact same ornamental appearance which is exhibited in [Appellant's] drawings, no more and no less.” *Id.* Thus, Appellant contends the Examiner has improperly required Appellant to identify “the One True Configuration

to the exclusion of all other possible configurations that produce the same ornamental appearance” shown in Figures 1–8, including unclaimed features not shown in those Figures. *Id.* at 4–7. Thus, specifically regarding the Examiner’s findings concerning feature A, Appellant maintains “the depth of that feature is such that it produces that same ornamental appearance shown in Figure 1 when viewed at that same angle and same lighting conditions.” *Id.* at 14 (emphasis omitted).

The Examiner responds that features A–I are part of Appellant’s claimed design, so they must not be “left to conjecture” such as the “depths of details that are simply not shown.” Ans. 9, 12, 16. The Examiner further contends “[A]ppellant is *not* entitled to protection of a range of designs within a scope, without showing them.” *Id.* at 10–11, 13 (citing *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) (“Design patents have almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings.”)).

### C. *Analysis*

The Examiner erred in determining that the breadth of the presently claimed design renders it indefinite. *See In re Gardner*, 427 F.2d 786, 788 (CCPA 1970) (“Breadth is not indefiniteness.”); *In re Maatita*, 900 F.3d 1369, 1377–79 (Fed. Cir. Aug. 20, 2018). We agree with the Examiner’s finding that the various features A–I identified above do not *precisely* define the *exact* depth of the various passages within the claimed block design. However, we disagree with the Examiner’s conclusion, based on that finding, that Appellant’s claim is indefinite. “[A] design patent is indefinite under § 112 if one skilled in the art, viewing the design as would



an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *Maatita*, 900 F.3d at 1377. We determine Appellant’s claim covers a variety of depths for the various features A–I, and is not thereby indefinite.

We also agree with the Examiner that the central detail of feature D is not *precisely* defined, either in its height, or its shape. *See, e.g.*, Ans. 17–18. Nonetheless, based on the views shown in Figures 1 and 7, the scope of the claimed block design, while broad in those particular respects, is clear with reasonable certainty to an ordinary observer. *See Maatita*, 900 F.3d at 1377.

The non-enablement aspect of the Examiner’s rejection is premised solely on the Examiner’s conclusion that the claim is indefinite, which we do not find to be supported by the evidence for the reasons provided above. *See* Non-Final Act. 1, 5; MPEP § 1504.04(I)(A).

Thus, we determine the Examiner errs in rejecting the presently claimed design as lacking enablement and as indefinite. We, therefore, do not sustain the rejection.

DECISION

The Examiner’s rejection is reversed.

REVERSED