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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266
160596	7590	06/10/2025	EXAMINER	
Haynes and Boone, LLP (70228)			TUNG, MELANIE H	
ISRG			ART UNIT	PAPER NUMBER
2801 N. Harwood St.			2917	
Suite 2300			NOTIFICATION DATE	DELIVERY MODE
Dallas, TX 75201			06/10/2025	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):

ipdocketing@haynesboone.com
patent.group@intusurg.com



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APPLICATION NO.	ISSUE DATE	PATENT NO.
29/732,483	10-Jun-2025	D1078749

Haynes and Boone, LLP (70228)
ISRG
2801 N. Harwood St.
Dallas, TX 75201

EGRANT NOTIFICATION

Your electronic patent grant (eGrant) is now available, which can be accessed via Patent Center at <https://patentcenter.uspto.gov>

The electronic patent grant is the official patent grant under 35 U.S.C. 153. For more information, please visit <https://www.uspto.gov/electronicgrants>

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via the USPTO patent electronic filing system.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

By fax, send to: (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications. **Because electronic patent issuance may occur shortly after issue fee payment, any desired continuing application should preferably be filed prior to payment of this issue fee in order not to jeopardize dependency.**

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

160596 7590 04/23/2025
Haynes and Boone, LLP (70228)
ISRG
2801 N. Harwood St.
Suite 2300
Dallas, TX 75201

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via the USPTO patent electronic filing system or by facsimile to (571) 273-2885, on the date below.

Sidney Buchanan	(Typed or printed name)
/Sidney Buchanan/	(Signature)
May 7, 2025	(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266

TITLE OF INVENTION: DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	UNDISCOUNTED	\$1300	\$0.00	\$0	\$1300	07/23/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
TUNG, MELANIE H	2917	D14-485000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/AIA/122 or PTO/SB/122) attached.

☒ "Fee Address" indication (or "Fee Address" Indication form PTO/AIA/47 or PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Haynes & Boone, LLP.

2

3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

INTUITIVE SURGICAL OPERATIONS, INC.

SUNNYVALE, CALIFORNIA

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. Fees submitted: ☒ Issue Fee ☐ Publication Fee (if required)

4b. Method of Payment: (Please first reapply any previously paid fee shown above)

☒ Electronic Payment via the USPTO patent electronic filing system ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☒ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. 08-1394

5. Change in Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29

☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature /Julie M. Nickols/

Date May 7, 2025

Typed or printed name Julie M. Nickols

Registration No. 50,826



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NOTICE OF ALLOWANCE AND FEE(S) DUE

160596 7590 04/23/2025
Haynes and Boone, LLP (70228)
ISRG
2801 N. Harwood St.
Suite 2300
Dallas, TX 75201

EXAMINER

TUNG, MELANIE H

ART UNIT

PAPER NUMBER

2917

DATE MAILED: 04/23/2025

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29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266

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nonprovisional	UNDISCOUNTED	\$1300	\$0.00	\$0	\$1300	07/23/2025

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 40% the amount of undiscounted fees, and micro entity fees are 20% the amount of undiscounted fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Maintenance fees are due in utility patents issuing on applications filed on or after Dec. 12, 1980. It is patentee's responsibility to ensure timely payment of maintenance fees when due. More information is available at www.uspto.gov/PatentMaintenanceFees.

PART B - FEE(S) TRANSMITTAL

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160596 7590 04/23/2025
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ISRG
2801 N. Harwood St.
Suite 2300
Dallas, TX 75201

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(Typed or printed name)
(Signature)
(Date)

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29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266

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Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____



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29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266
160596	7590	04/23/2025	EXAMINER	
Haynes and Boone, LLP (70228)			TUNG, MELANIE H	
ISRG			ART UNIT	
2801 N. Harwood St.			PAPER NUMBER	
Suite 2300			2917	
Dallas, TX 75201			DATE MAILED: 04/23/2025	

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (Applications filed on or after May 29, 2000)

The Office has discontinued providing a Patent Term Adjustment (PTA) calculation with the Notice of Allowance.

Section 1(h)(2) of the AIA Technical Corrections Act amended 35 U.S.C. 154(b)(3)(B)(i) to eliminate the requirement that the Office provide a patent term adjustment determination with the notice of allowance. See Revisions to Patent Term Adjustment, 78 Fed. Reg. 19416, 19417 (Apr. 1, 2013). Therefore, the Office is no longer providing an initial patent term adjustment determination with the notice of allowance. The Office will continue to provide a patent term adjustment determination with the Issue Notification Letter that is mailed to applicant approximately three weeks prior to the issue date of the patent, and will include the patent term adjustment on the patent. Any request for reconsideration of the patent term adjustment determination (or reinstatement of patent term adjustment) should follow the process outlined in 37 CFR 1.705.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013).

<https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to:

- 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law;
- 2) a federal, state, local, or international agency, in response to its request;
- 3) a contractor of the USPTO having need for the information in order to perform a contract;
- 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record;
- 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;
- 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;
- 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;
- 8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));
- 9) the Office of Personnel Management (OPM) for personnel research purposes; and
- 10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

<p align="center">Notice of Allowability For A Design Application</p>	<p>Application No. 29/732,483</p>	<p>Applicant(s) Argo et al.</p>	
	<p>Examiner Melanie H Tung</p>	<p>Art Unit 2917</p>	<p>AIA (FITF) Status Yes</p>

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308. This notice does not set or reset the time period for paying the issue fee. The issue fee must be paid within THREE MONTHS FROM THE MAILING DATE of the Notice of Allowance (PTOL-85) or this application shall be regarded as ABANDONED. This statutory period cannot be extended. See 35 U.S.C.151.

1. ☒ This communication is responsive to request for CPA 4/8/25 .
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____ .
2. ☐ 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.
3. ☒ The claim is allowed.
4. ☒ Acceptable drawings:
(a) ☒ The drawings filed on 4/24/20 are accepted by the Examiner.
(b) ☐ Drawing Figures filed on ____ and drawing Figures filed on ____ are accepted by the Examiner.
5. ☐ The claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) is acknowledged.

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)).
- * Certified copies not received: ____ .

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirement for corrected drawings noted in item 6 below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE. See 37 CFR 1.85(c). **NOTE: This notice does not set or reset the time period for paying the issue fee.**

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____ .

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 4. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Receipt Date <u>4/8/25</u> | 5. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| 3. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date ____ . | 6. <input type="checkbox"/> Other ____ . |

NOTE: ____

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917

Notice of Pre-AIA or AIA Status

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

The request filed on April 8, 2025 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 29/732,483 is acceptable and a CPA has been established. An action on the CPA follows.

Conclusion

The claimed design is patentable over the references cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie H. Tung whose telephone number is (571)272-2613. The examiner normally can be reached Monday through Friday, 7AM-3PM, ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susan Krakower, can be reached on (571)272-4496. 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 Patent Center. Status information for published applications may be obtained from Patent Center. Status information for unpublished applications is available through Patent Center for authorized users only. Should you have questions about access to Patent Center, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) Form at <https://www.uspto.gov/patents/uspto-automated-interview-request-air-form>.

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917
April 17, 2025

FOR DESIGN APPLICATIONS ONLY: CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

CHECK BOX, if applicable:

☐

DUPLICATE

Address to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attorney Docket No.
of Prior Application

P06170-US-CON [70228.745US02]

First Named Inventor

Lauren L. Argo

Examiner Name

MELANIE H. TUNG

Art Unit

2917

Priority Mail Express® Label No.

This is a request for a ☒ continuation or ☐ Divisional application under 37 CFR 1.53(d),
(continued prosecution application (CPA)) of prior application number 29/732,483

filed on April 24, 2020, entitled DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE

NOTES

A CPA may **only** be filed in a **design** application but not in an international design application. A CPA **cannot** be filed in a utility or plant application. See "Elimination of Continued Prosecution Application Practice as to Utility and Plant Applications; Final Rule," 68 FR 32376 (May 30, 2003). Applicant may consider filing a Request for Continued Examination (RCE) under 37 CFR 1.114 in utility or plant applications. See MPEP 706.07(h) and form PTO/SB/30.

Filing Qualifications: The prior application identified above must be a design application that is complete as defined by 37 CFR 1.51(b).

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the Application Data Sheet (ADS). A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(d)(4).

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

1. ☐ Enter the unentered amendment previously filed on _____
under 37 CFR 1.116 in the prior design application.
2. ☐ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventor(s) named in the prior application, 37 CFR 1.53(d)(4).
 - a. ☐ **DELETE** the following inventor(s) named in the prior design application:

 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney (PTO/AIA/82) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed;
 - a. ☒ PTO/SB/08, PTO-1449 or equivalent
 - b. ☐ Copies of IDS Citations

Page 1 of 2

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0032. Public burden for this form is estimated to average 24 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.** If filing this completed form by mail, send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

6. ☐ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Director is hereby authorized to credit overpayments or change the following fees to Deposit Account No. 08-1394:
- a. ☐ Fees required under 37 CFR 1.16.
- b. ☐ Fees required under 37 CFR 1.17.
- c. ☐ Fees required under 37 CFR 1.18.
8. ☐ A check in the amount of \$ _____ is enclosed.
9. ☐ Payment by credit card. Form PTO-2038 is attached.
10. ☒ Payment made via USPTO patent electronic filing system.
11. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of _____ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
12. ☐ New Attorney Docket Number, if desired _____
[Prior application Attorney Docket Number will carry over to this CPA unless a new Attorney Docket Number has been provided herein.]
13. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)
- b. ☐ Return Receipt Postcard (Should be specifically itemized. See MPEP 503)
14. ☐ Other:

NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

14. NEW CORRESPONDENCE ADDRESS

☐ The address associated with Customer Number:

--

OR ☐ New correspondence address below

Name			
Address			
City		State	
Zip Code		Country	Email

15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	/Austin Lorch/
Name (Print/Type)	Austin Lorch
Registration No. (Attorney/Agent)	81190
Date	April 8, 2025
Telephone Number	972-739-8624



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

NOTICE OF ALLOWANCE AND FEE(S) DUE

160596 7590 02/03/2025
Haynes and Boone, LLP (70228)
ISRG
2801 N. Harwood St.
Suite 2300
Dallas, TX 75201

EXAMINER

TUNG, MELANIE H

ART UNIT

PAPER NUMBER

2917

DATE MAILED: 02/03/2025

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266

TITLE OF INVENTION: DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	UNDISCOUNTED	\$1300	\$0.00	\$0.00	\$1300	05/05/2025

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 40% the amount of undiscounted fees, and micro entity fees are 20% the amount of undiscounted fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Maintenance fees are due in utility patents issuing on applications filed on or after Dec. 12, 1980. It is patentee's responsibility to ensure timely payment of maintenance fees when due. More information is available at www.uspto.gov/PatentMaintenanceFees.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via the USPTO patent electronic filing system.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

By fax, send to: (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications. **Because electronic patent issuance may occur shortly after issue fee payment, any desired continuing application should preferably be filed prior to payment of this issue fee in order not to jeopardize copendency.**

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

160596 7590 02/03/2025
Haynes and Boone, LLP (70228)
ISRG
2801 N. Harwood St.
Suite 2300
Dallas, TX 75201

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via the USPTO patent electronic filing system or by facsimile to (571) 273-2885, on the date below.

(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266

TITLE OF INVENTION: DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	UNDISCOUNTED	\$1300	\$0.00	\$0.00	\$1300	05/05/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
TUNG, MELANIE H	2917	D14-486000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/AIA/122 or PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/AIA/47 or PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

1 _____

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. Fees submitted: ☐ Issue Fee ☐ Publication Fee (if required)

4b. Method of Payment: (Please first reapply any previously paid fee shown above)

☐ Electronic Payment via the USPTO patent electronic filing system ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. Change in Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29

☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266
160596	7590	02/03/2025	EXAMINER	
Haynes and Boone, LLP (70228)			TUNG, MELANIE H	
ISRG			ART UNIT	
2801 N. Harwood St.			PAPER NUMBER	
Suite 2300			2917	
Dallas, TX 75201			DATE MAILED: 02/03/2025	

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (Applications filed on or after May 29, 2000)

The Office has discontinued providing a Patent Term Adjustment (PTA) calculation with the Notice of Allowance.

Section 1(h)(2) of the AIA Technical Corrections Act amended 35 U.S.C. 154(b)(3)(B)(i) to eliminate the requirement that the Office provide a patent term adjustment determination with the notice of allowance. See Revisions to Patent Term Adjustment, 78 Fed. Reg. 19416, 19417 (Apr. 1, 2013). Therefore, the Office is no longer providing an initial patent term adjustment determination with the notice of allowance. The Office will continue to provide a patent term adjustment determination with the Issue Notification Letter that is mailed to applicant approximately three weeks prior to the issue date of the patent, and will include the patent term adjustment on the patent. Any request for reconsideration of the patent term adjustment determination (or reinstatement of patent term adjustment) should follow the process outlined in 37 CFR 1.705.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013).

<https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to:

- 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law;
- 2) a federal, state, local, or international agency, in response to its request;
- 3) a contractor of the USPTO having need for the information in order to perform a contract;
- 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record;
- 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;
- 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;
- 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;
- 8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));
- 9) the Office of Personnel Management (OPM) for personnel research purposes; and
- 10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

Notice of Allowability For A Design Application	Application No. 29/732,483	Applicant(s) Argo et al.	
	Examiner Melanie H Tung	Art Unit 2917	AIA (FITF) Status Yes

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308. This notice does not set or reset the time period for paying the issue fee. The issue fee must be paid within THREE MONTHS FROM THE MAILING DATE of the Notice of Allowance (PTOL-85) or this application shall be regarded as ABANDONED. This statutory period cannot be extended. See 35 U.S.C.151.

1. ☒ This communication is responsive to PTAB decision 12/11/24 .
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____ .
2. ☐ 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.
3. ☒ The claim is allowed.
4. ☒ Acceptable drawings:
 (a) ☒ The drawings filed on 4/24/20 are accepted by the Examiner.
 (b) ☐ Drawing Figures filed on ____ and drawing Figures filed on ____ are accepted by the Examiner.
5. ☐ The claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) is acknowledged.

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)).
- * Certified copies not received: ____ .

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirement for corrected drawings noted in item 6 below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.** See 37 CFR 1.85(c). **NOTE: This notice does not set or reset the time period for paying the issue fee.**

6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____ .

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 4. <input type="checkbox"/> Examiner's Amendment/Comment |
| 2. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Receipt Date ____ | 5. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| 3. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date ____ | 6. <input type="checkbox"/> Other ____ . |

NOTE: ____

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917



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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266
160596	7590	12/11/2024	EXAMINER	
Haynes and Boone, LLP (70228)			TUNG, MELANIE H	
ISRG			ART UNIT	PAPER NUMBER
2801 N. Harwood St.			2917	
Suite 2300			NOTIFICATION DATE	DELIVERY MODE
Dallas, TX 75201			12/11/2024	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):

ipdocketing@haynesboone.com
patent.group@intusurg.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LAUREN L. ARGO, CRISTIAN BIANCHI, and
JASON S. LAFRENAIS

Appeal 2023-002547
Application 29/732,483
Technology Center 2900

Before DANIEL S. SONG, GEORGE R. HOSKINS, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from an Examiner's decision rejecting the design claim in this application under 35 U.S.C. § 103 as unpatentable over Leong (U.S. Design Patent No. D836,121 S, issued Dec. 18, 2018) and Gilra (U.S. Patent No. 8,438,495 B1, issued May 7, 2013). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies Intuitive Surgical Operations, Inc., as the real party in interest. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Appellant claims: “The ornamental design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE as shown and described.” Appeal Br. 14 (Claims App.). The claimed design is shown in Figures 1–3. *See* Amendment (filed Dec. 21, 2021) (“Amend.”), 2. Figure 1 is representative, and is reproduced below.

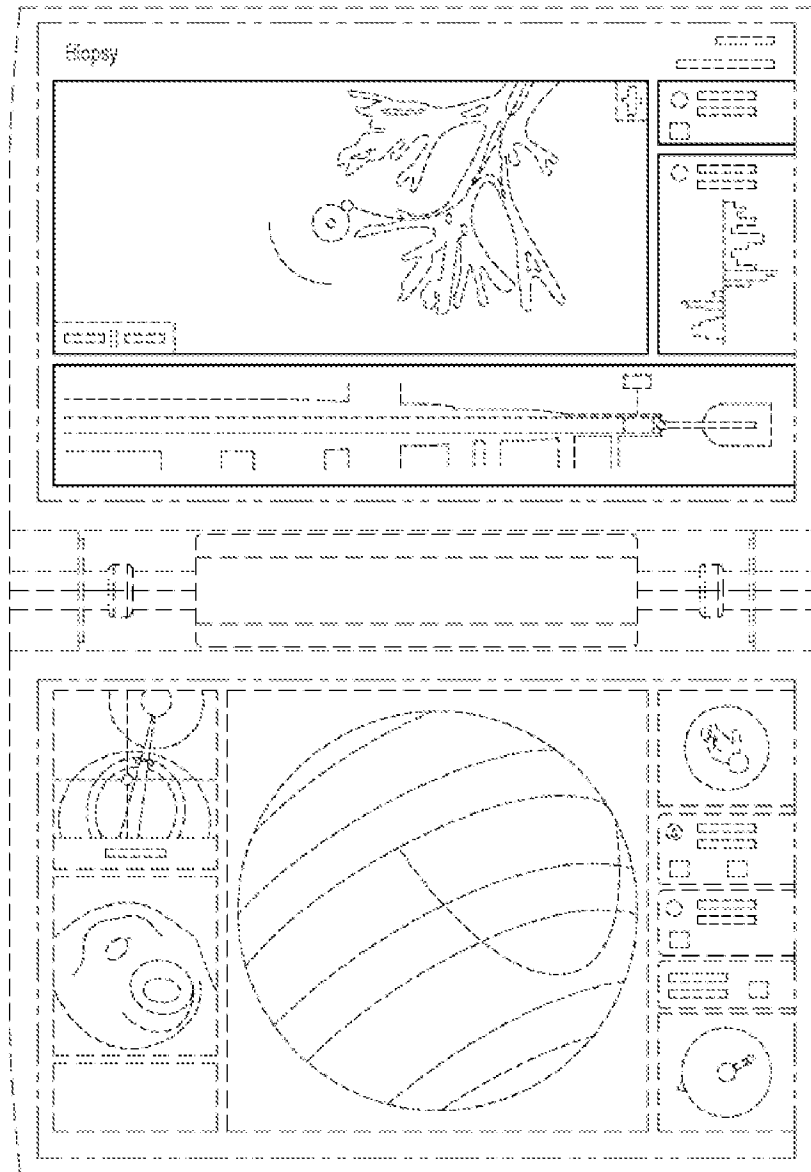
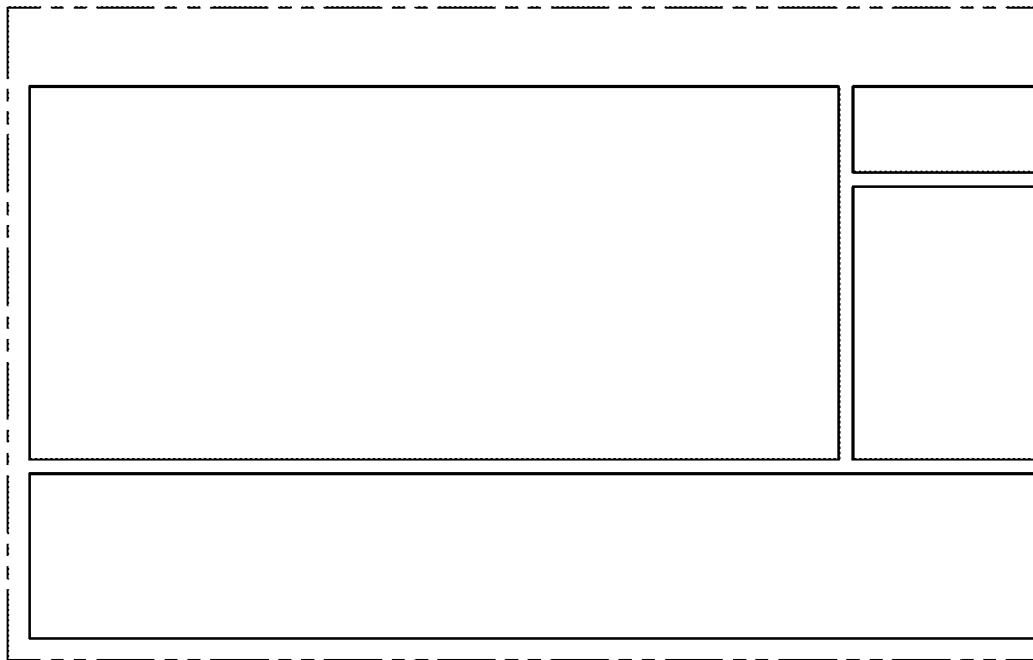


Fig. 1
Appellant's Figure 1.

Figure 1 is a front view of a first embodiment of Appellant's display screen with graphical user interface. *See* Amend. 2. "The outer and central even broken lines and the long-dash/short-dash/short-dash broken lines show a display screen or portion thereof and form no part of the claimed design." *Id.* "The broken lines within the long-dash/short-dash/short-dash broken lines show portions of the graphical user interface that form no part of the claimed design." *Id.*

Thus, the graphical user interface component of Appellant's claim consists of: one rectangle shape defined by four solid lines; and three other rectangular shapes each defined by an upper solid line, a left side solid line, a bottom solid line, and a right side long-dash/short-dash/short-dash broken line. This is seen best in the following excerpt from Appellant's Figure 3:



Appellant's Figure 3 (Excerpt).

Figure 3 is a front view of a second embodiment of Appellant's display screen with graphical user interface, from which we have excerpted the solid line aspects along with the nearest surrounding broken lines. *See* Amend. 2.

OPINION

A. Legal Standards

The recent decision in *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (en banc), issued after briefing was completed in this appeal.

Pursuant to *LKQ*, the obviousness inquiry asks “whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design ‘to create the same overall visual appearance as the claimed design.’” *LKQ*, 102 F.4th at 1299 (quoting *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021)). “[T]he motivation to combine . . . need not come from the references themselves,” “[b]ut there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design.” *Id.* Factors to consider in this regard include an ordinarily skilled designer’s experience and creativity; market demands and industry customs in the relevant field; and which ornamental features are commonplace in the relevant field. *See id.*

B. Leong

Leong is a United States Design Patent titled “Display Panel with Graphical User Interface with Layered Effect.” Leong, codes (12) & (54). Leong’s Figure 1 is reproduced below.

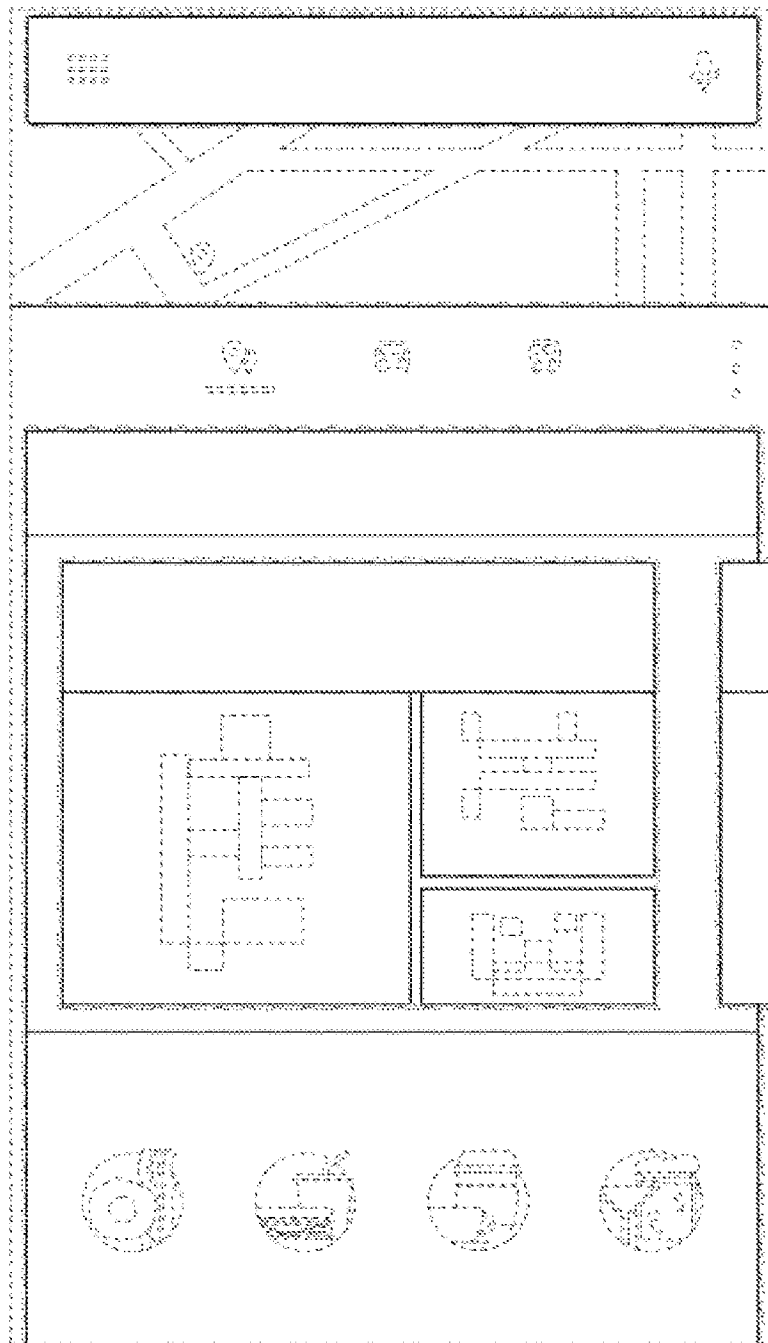
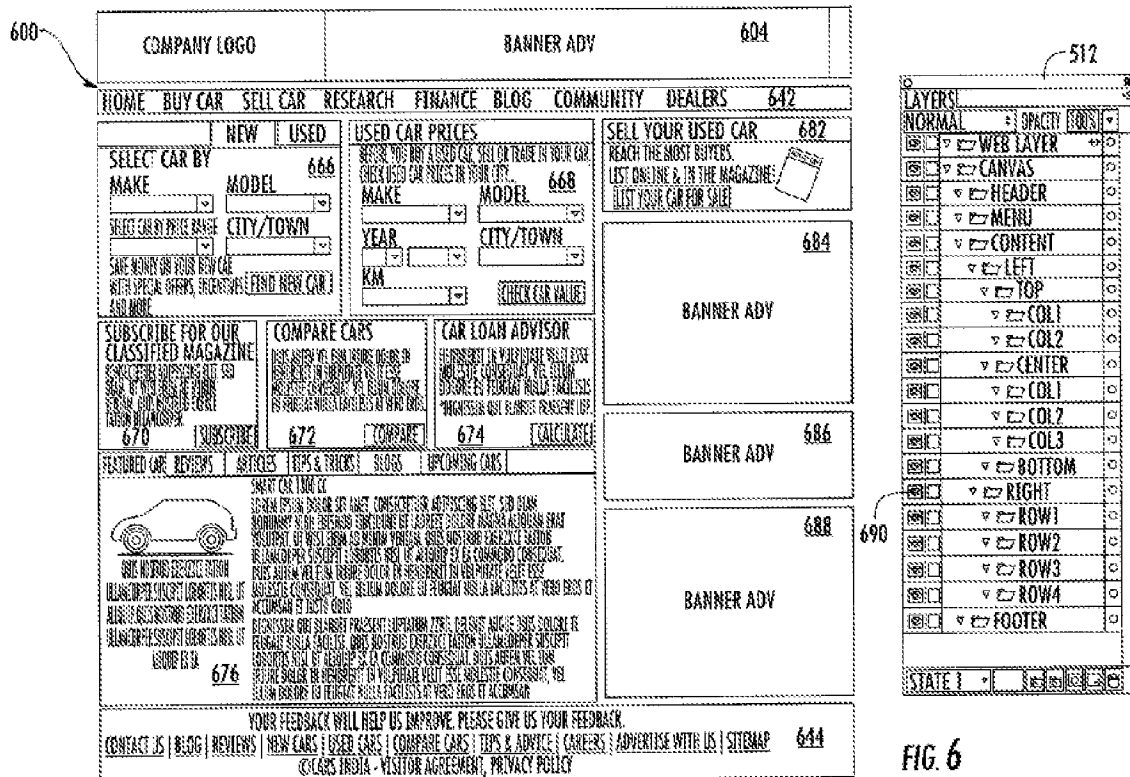


FIG. 1
Leong, Figure 1.

Leong's Figure 1 is "a front view of the first image in a sequence for a display panel with graphical user interface with layered effect." Leong, "DESCRIPTION."

C. Gilra

Gilra is a United States Utility Patent titled “Methods and Systems for Creating Wireframes and Managing Containers.” Gilra, codes (12) & (54). Gilra’s Figure 6 is reproduced below.



Gilra, Figure 6.

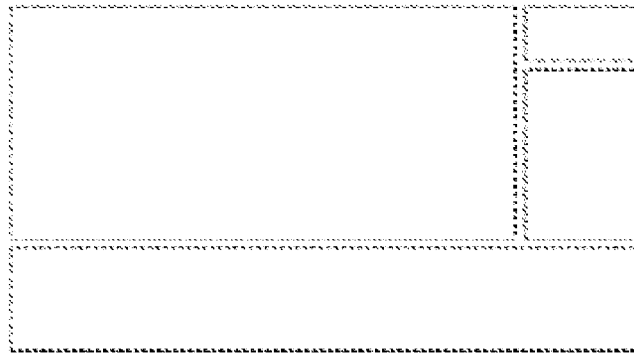
Gilra’s Figure 6 “illustrates an example of using a wireframe for layout and selection of content items of a composite media object.” Gilra, 2:48–50.

D. The Final Office Action

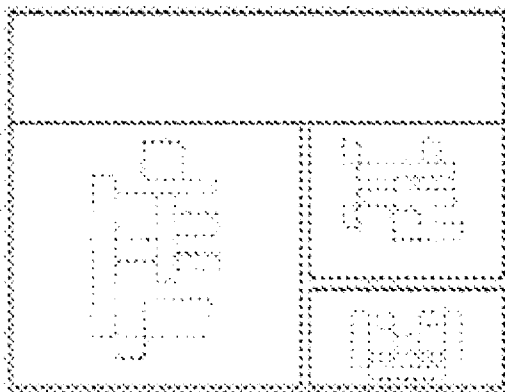
The Examiner rejects Appellant’s claim under 35 U.S.C. § 103 as unpatentable over Leong and Gilra. See Final Act. 2–5.

The Examiner relies on Leong as a “primary reference [having] design characteristics which are basically the same as [Appellant’s] claimed design.” *Id.* at 2. To demonstrate this, the Examiner provides the following

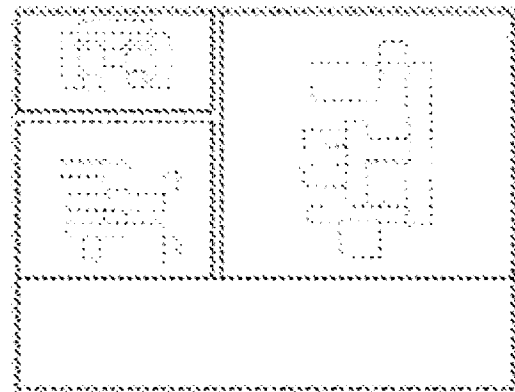
visual comparison of Appellant’s claimed design (top row) with a portion of Leong’s graphical user interface display (bottom row). *See id.* at 2–3.



Appellant’s Claimed Design.



**Leong, Figure 1 (Excerpt)
(Native Orientation).**



**Leong, Figure 1 (Excerpt)
(Rotated 180°).**

Here, the Examiner compares the solid line definition of Appellant’s claimed design (top row) with an excerpt from Leong’s Figure 1 (bottom row) in its native orientation (at left) and as “rotated 180 degrees” (at right). *Id.* Based on this comparison, the Examiner finds Leong’s graphical user interface comprises, like Appellant’s claimed design, “an elongated rectangle, a shorter and taller rectangle, and two smaller rectangles (one smaller than the other) aligned on one side.” *Id.* at 2. The Examiner also determines “[w]hether the two smallest rectangles are shown on the right [as in Appellant’s claim] or left side [as in Leong’s Figure 1 when rotated 180°] is

a de minimis difference and well within the knowledge of one skilled in the art.” *Id.* at 3.

The Examiner concludes Leong differs from Appellant’s claimed design in that Leong “does not show the small space between the elongated rectangle and the other two rectangles aligned along one long edge.” *Id.* The Examiner finds Gilra’s Figure 6 “shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge.” *Id.* The Examiner determines “[i]t would have been obvious to a designer of ordinary skill . . . to have modified [Leong] by providing a small space between the elongated rectangle and the two rectangles that are aligned with one long edge as shown by [Gilra] to meet the overall appearance of the claimed design.” *Id.* In particular: “This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.” *Id.* at 3–4 (citing, *inter alia*, *In re Rosen*, 673 F.2d 388 (CCPA 1982)).

E. The Appeal Brief

Appellant objects to the Examiner’s focus on certain features of Leong’s Figure 1 (which Appellant describes as “truncating” the figure), as well as the Examiner’s rotation of Leong’s Figure 1 by 180°, as improper attempts to make Leong’s design resemble Appellant’s claimed design. Appeal Br. 3–9.

Appellant also argues that, even assuming the Examiner’s foregoing consideration of Leong’s Figure 1 is proper, the end result still exhibits design characteristics that are not “basically the same” as the claimed design

to qualify Leong as a primary reference per the *Rosen* test for obviousness. *See id.* at 9 (citing *Durling v. Spectrum Furniture Co. Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996); *Rosen*, 673 F.2d at 391). Appellant asserts the two designs differ in that: (a) Appellant’s design has a small space between all four of the rectangles, which Leong’s design lacks between the elongated rectangle and its two adjacent rectangles; (b) Appellant’s claimed design has the two smallest rectangles on the right side of the design, whereas Leong’s design has them on the left side; and (c) the various rectangles have “differing proportions.” *Id.* at 9–10.

F. The Examiner’s Answer

The Examiner’s Answer defends the rejection’s consideration of Leong’s Figure 1. *See* Ans. 6–12.

The Examiner further maintains the end result of that consideration “has design characteristics which are basically the same as [Appellant’s] claimed design.” *Id.* at 3, 12–13. Those characteristics, according to the Examiner, are: “a long, horizontally oriented rectangle, two smaller rectangles along one edge (the upper small rectangle is shorter than the other), and a fourth rectangle that is the same height as the two stacked smaller rectangles,” wherein “[t]he width of the two stacked rectangles and the fourth rectangle align with the length of the longer rectangle” to “form[] an overall rectangular shape.” *Id.* at 3–4, 13. Further according to the Examiner, “the position of the rectangles are the same” in Leong’s Figure 1 and Appellant’s claim. *Id.* at 12.

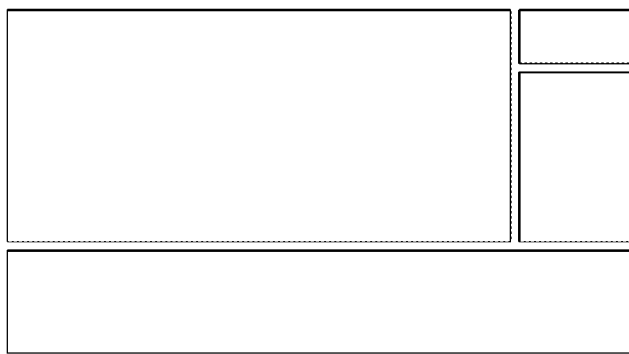
G. Appellant's Reply Brief

In reply, Appellant continues to object to the Examiner's consideration of Leong's Figure 1. *See* Reply Br. 3–7.

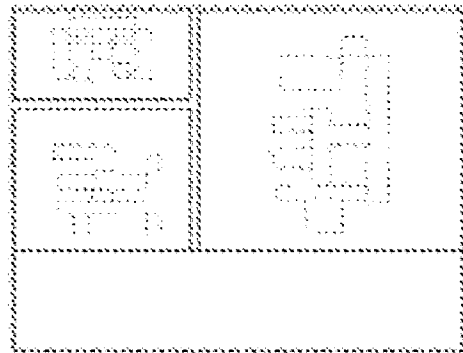
Appellant also attacks the Examiner's determination that the end result of that consideration has design characteristics which are basically the same as Appellant's claimed design. *See id.* at 7–8. Appellant particularly objects to the Examiner's finding in the Answer that “the position of the rectangles are the same” in Leong's Figure 1 and Appellant's claim. Ans. 12; *see* Reply Br. 8.

H. Analysis and Conclusion

Firstly, we conclude that the end result of the Examiner's consideration of Leong's Figure 1 materially differs from Appellant's claimed design. We reproduce below an excerpt of Appellant's Figure 3 (on the left), and the end result of the Examiner's consideration of Leong's Figure 1 (on the right).



**Appellant's Figure 3
(Excerpt).**



**Leong's Figure 1
(Excerpt, Rotated 180°).**

Appellant's Figure 3 (at left) is a front view of Appellant's claimed graphical user interface design consisting of four rectangles, and Leong's Figure 1 (at right) is a front view of a portion of Leong's graphical interface

design consisting of four rectangles. We find that the arrangement of the top three rectangles in the respective designs is materially different — in Appellant’s claim the two smallest rectangles are disposed at the right side of the arrangement, and in Leong’s design the two smallest rectangles are disposed at the left side of the arrangement.

We cannot sustain the Examiner’s dismissal of this difference as being *de minimis*.² See Final Act. 3. Appellant’s claim is directed to a specific arrangement of four rectangle shapes on a graphical user interface, and nothing more. In that simple context, rearranging three of the four rectangles is a significant difference, not a *de minimis* difference.

Secondly, per *LKQ*, obviousness requires articulation of “some record-supported reason (without hindsight) that an ordinary designer in the field of [graphical user interfaces] would have modified [Leong] . . . to create the same overall appearance as the claimed design.” *LKQ*, 102 F.4th at 1299–1300. For the reasons provided above, the end result of the Examiner’s consideration of Leong’s Figure 1 does not have “the same overall appearance” as Appellant’s claimed design, per *LKQ*. Moreover, the rejection on appeal does not articulate any reasoning as to why an ordinary designer would have been motivated to modify that end result by rearranging the top three rectangles to correspond to the arrangement of Appellant’s claimed design. Instead, the Examiner relies solely on the *de minimis* doctrine in this regard, which we cannot sustain as described above.

² As defined in *Black’s Law Dictionary* (6th Ed. 1990), the “De minimis doctrine” provides that “[t]he law does not care for, or take notice of, very small or trifling matters” and “[t]he law does not concern itself about trifles.”

The Examiner cites *In re Stevens*, 173 F.2d 1015 (CCPA 1949), as holding that “[o]bvious changes in arrangement and proportioning are no more patentable in one case than in the other.” Ans. 12. However, in *Stevens*, the court found that “[t]he over-all appearance of appellant’s [rotary] brush does not differ substantially from the [prior art] brush,” in part because “[t]he exact proportioning of the cylinder, the size of the brush tufts, and the provision or omission of a driving pulley or of a gap in the row of tufts, are matters involving ordinary skill only.” *Stevens*, 173 F.2d at 1015 (emphasis added). In the present case, by contrast, the overall appearance of the four rectangles in Appellant’s claimed graphical user interface design differs substantially from the end result of the Examiner’s consideration of Leong’s Figure 1, as discussed above.

For the reasons provided above, we *reverse* the Examiner’s rejection of Appellant’s design claim under 35 U.S.C. § 103 as unpatentable over Leong and Gilra. We do not reach the remaining issues argued.

CONCLUSION

We *reverse* the Examiner’s rejection of Appellant’s design claim as unpatentable over Leong and Gilra.

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

REVERSED

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

In re application of:	§	
Lauren L. Argo et al.	§	Group Art Unit: 2917
	§	
Application No.: 29/732,483	§	Examiner: Melanie H. Tung
	§	
Filing Date: April 24, 2020	§	Confirmation No.: 5266
	§	
For: DISPLAY SCREEN OR PORTION	§	Docket No.: P06170-US-CON
THEREOF WITH GRAPHICAL	§	(70228.745US02)
USER INTERFACE	§	

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Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellant submits this Reply Brief in Reply to the Examiner's Answer filed on March 30, 2023, with respect to the above-identified patent application. Appellant respectfully requests that the present appeal be considered based on the arguments as set forth in both the Appeal Brief and this Reply Brief.

The appeal forwarding fee has been provided for by credit card separately but concurrently herewith. If any additional fees are necessary, the Commissioner is hereby authorized to charge those fees to Haynes and Boone, LLP's Deposit Account No. 08-1394.

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STATUS OF THE CLAIM

As detailed in the Examiner's Answer (the "Answer") filed on March 30, 2023, the Office maintains the rejection. Accordingly, the pending claim stands rejected under 35 U.S.C. § 103 over U.S. Patent No. D836,121 (filed Jan. 5, 2017) ("Leong") in view of U.S. Patent No. 8,438,495 (filed Aug. 17, 2009) ("Gilra").

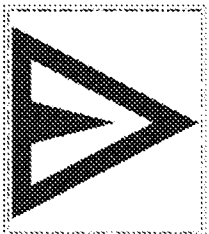
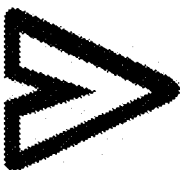
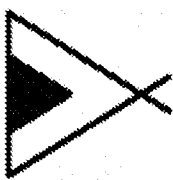
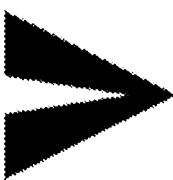
ARGUMENT

1. The Examiner improperly relies on hindsight bias to rotate Leong and to produce "Created Leong".

Appellant respectfully argues that the Examiner rotates Leong (hereinafter "Created Leong") based on a hindsight desire to create alleged similarities between Leong and the claimed design. Appellant maintains that the rejection is improper because it is based on impermissible hindsight.

In assessing obviousness, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP § 2142.

In a similar appeal before the Board, the Board held that a secondary reference was not "so related" to the primary reference because the Examiner improperly rotated the secondary reference in their rejection, and the Board stated that the "only reason [they] can discern for this rotation, based on the present record, is a hindsight desire to establish a similarity in appearance." *Ex parte Sehee Lee*, No. 2021-003216, 10-11, 13 (PTAB January 31, 2022). Whereas the test for a primary reference is "something in existence, the design characteristics of which are basically the same as the claimed design considering the visual impression created by the patented design as a whole," the test for a secondary reference is that the secondary reference "must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Id.* at 2-3 (citing *MRC Innovations Inc. v. Hunter Mfg., LLP* 747 F.3d 1326, 1331 (Fed. Cir. 2014) (Internal quotations omitted)). In *ex parte Sehee Lee*, the Examiner had rejected the claimed design under 35 U.S.C. § 103 over a Basicons icon as a primary reference, a rotated Smoothfill Travel icon as a secondary reference, and a Goggle Material Design (not at issue in appeal) as another secondary reference, which are shown in the chart below.

Examiner's Combination	29/643,557 (claimed design)	Basicons icon (Primary reference)	Smoothfill Travel icon (secondary reference)	Google Material Design (secondary reference)
		 Basicons.	 Smoothfill Travel (rotated 90° clockwise).	 Google

Applicant appealed the rejection. On appeal, the Board found that when comparing the Basicons icon and the Smoothfill Travel icon “in its **native orientation**” (i.e., not rotated), the icons are not “so related.” *See id.* at 6, 12. In particular, “the overall visual impression of the Basicons icon is that of a chevron pointing from left to right,” and the “overall visual impression of the Smoothfill travel icon, by contrast, is that of an open teepee,” as evidenced by “the context of the set of icons on iconfinder.com where the Examiner found this icon.” *Id.* at 10. The Board further clarifies that “the different overall visual impressions are germane here because they are one facet of how a designer of ordinary skill would view and compare the respective appearance of the two icons.” Accordingly, the Board reversed the Examiner’s decision, citing *inter alia* that “the Examiner’s rotation of the Smoothfill travel icon” was troubling and that the “only reason [that the Board] can discern for this rotation, based on the present record, is a **hindsight desire to establish a similarity in appearance**” between the two icons. *Id.* at 11-12 (emphasis added). Therefore, the Board reversed the Examiner’s decision.

Here, the Examiner rotated a primary reference, rather than a secondary reference. However, applying a primary reference requires a more stringent test, than applying a secondary reference. As mentioned above, the primary reference must be “basically the same” as the claimed design, whereas the secondary reference only has to be “so related” to the primary reference as to suggest applying the features of the secondary reference to the primary reference. *See MRC Innovations Inc. v. Hunter Mfg., LLP* 747 F.3d 1326, 1331 (Fed. Cir. 2014) (Internal

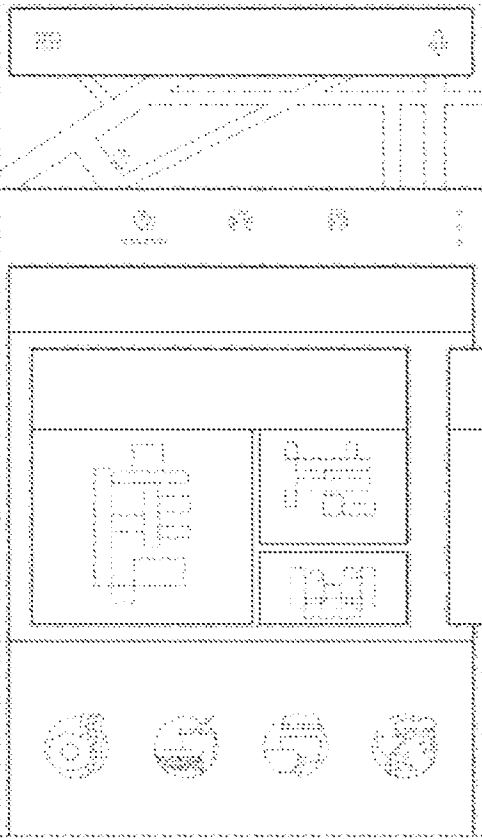
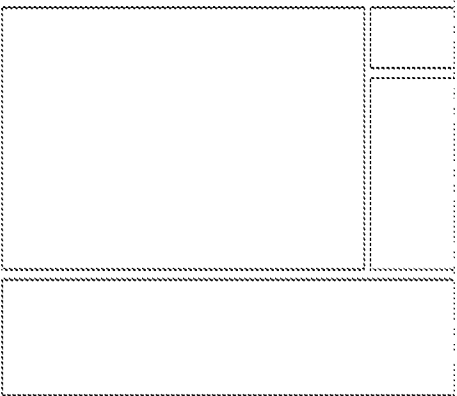
quotations omitted)). Like *ex parte Sehee Lee*, the present claimed design involves computer-generated icons. “Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation.” MPEP § 1504.01(a)(I). It follows that like *ex parte Sehee Lee*, the native orientation of Leong should be considered in determining the “overall visual appearance.” The native orientation is germane to how a designer of ordinary skill would view the computer-generated icon, and as discussed in the Appellant’s Appeal Brief on pages 4-5 and 9-12, the overall visual appearance of Leong, in its native orientation, differs from the claimed design. Therefore, the Examiner has changed the orientation of Leong as a “hindsight desire to establish a similarity in appearance,” and for this reason alone, “Created Leong” is an improper primary reference. *Ex Parte Sehee Lee*, pp. 11-12.

For the foregoing reasons, the rejection of the claimed design under 35 U.S.C. § 103 over “Created Leong” in view of Gilra is improper.

2. The Examiner has failed to establish a *prima facie* case of obviousness because Leong, in its native orientation, is not basically the same as the claimed design, and therefore, Leong is an improper primary reference.

As outlined in the Appellant’s Appeal Brief, Appellant maintains that the “basically the same” test should apply to Leong, in its native orientation, and that in its native orientation, Leong fails the requirements of “basically the same.” The “basically the same” test requires “consideration of the visual impression created by the patented design *as a whole* [emphasis added].” *MRC Innovations, Inc.*, 747 F.3d at 1331.

Here, the Examiner improperly ignores the requirement to consider the visual impression as a whole. As detailed in Appellant’s Appeal Brief, when properly viewed as a whole, the claimed design creates a visual impression that is not basically the same as that of Leong. *See Appeal Brief*, 3-7. Appellant’s Appeal Brief describes individual differences between the claimed design and Leong, and Appellant maintains that when all of the individual differences are viewed together in the aggregate, the overall visual appearance of the claimed design is not basically the same as Leong. *See id.* More specifically, as shown in the side-by-side comparison of Leong, in its native orientation, and the claimed design below the designs are substantially different in overall appearance and thus are not basically the same.

Figure 1 of Leong (Native Orientation)	Pending Claimed Design
 <p data-bbox="427 1276 500 1308">FIG. 1</p>	

The Examiner states that “[a]ttributing meaning or a specific interpretation to unclaimed features in the primary reference is based on conjecture.” *Answer*, p. 9. Appellant respectfully disagrees that attributing an orientation to the primary reference is based on conjecture. “Since a patentable design is **inseparable from the object to which 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.” MPEP § 1504.01(a). Therefore, in order for a design application of a computer-generated icon to be patentable, the design must be embodied in a computer screen or monitor—otherwise, a computer-generated icon would be mere surface ornamentation in the abstract. Since a computer-generated icon is

“inseparable from the object to which it is applied” the orientation with respect to the computer monitor or display should be taken into account when determining obviousness from the perspective of a designer of ordinary skill. Therefore, Applicant maintains a designer of ordinary skill would compare Leong in its native orientation (rather than “Created Leong”) to the claimed design and find that Leong is also an improper primary reference.

Additionally, the Examiner notes, “[a] primary reference need not be ‘substantially the same,’ which is the standard for anticipation under 102.” *Answer*, p.13. Appellant respectfully disagrees. While Appellant does not argue that Leong must share each and every element of the claimed design to qualify as a primary reference, Appellant does wish to point to section 1504.03 of the MPEP, entitled “Prima Facie Obviousness,” which states:

[I]n order to support a holding of obviousness, *a primary reference must be more than a design concept* [emphasis added]; it must have an appearance *substantially the same* [emphasis added] as the claimed design. *See In re Harvey*, 12 F.3d 1061, 29 U.S.P.Q.2d 1206 (Fed. Cir. 1993). Absent such a reference, no holding of obviousness under 35 U.S.C. 103 can be made, whether based on a single reference alone or in view of modifications suggested by secondary prior art.

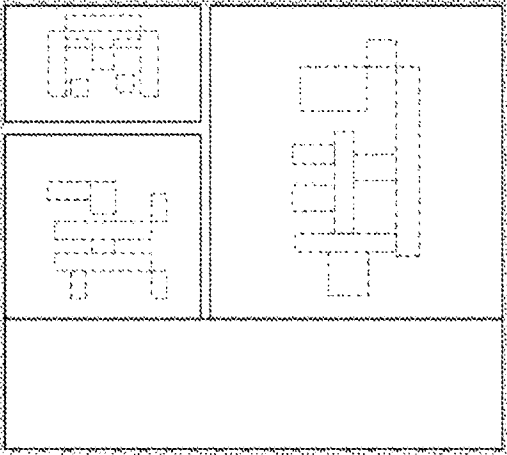
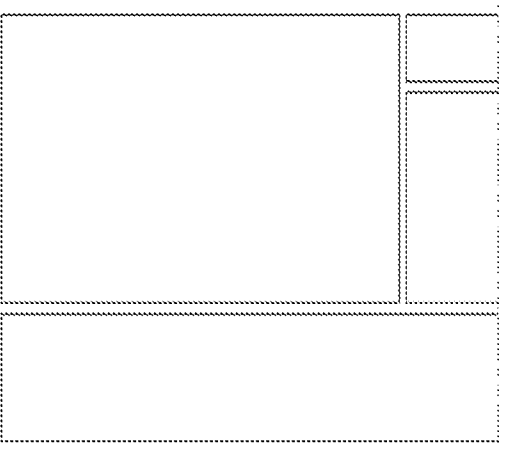
Therefore, since there are significant differences between Leong’s design and the Appellant’s design, these differences present different design characteristics that result in different overall visual appearances, as shown in the side-by-side comparison above. Thus, based on these differences, Leong does not meet the standards necessary to be considered a primary reference in a rejection under 35 U.S.C. § 103 against the pending claim.

For the foregoing reasons, the Examiner improperly ignores the requirement to consider the visual impression as a whole when determining that Leong and the claimed design are basically the same, which they are not. Therefore, the rejection of the claimed design under 35 U.S.C. § 103 is improper.

3. The Examiner has failed to establish a *prima facie* case of obviousness because “Created Leong” is not basically the same as the claimed design, and therefore, “Created Leong” is an improper primary reference.

Appellant respectfully argues that even assuming *arguendo* that “Created Leong” is prior art and its creation is proper (both points not conceded by the Applicant), “Created Leong”

cannot be used as the primary reference because the Examiner has failed to consider the visual impression created by the patented design as a whole. To support an obviousness rejection of a claimed design, a primary reference must be something in existence, and this primary reference must be “basically the same” as the claimed design, with the basically-the-same test requiring “consideration of the visual impression created by the patented design as a whole.” *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). In the Answer, the Examiner asserts that “Created Leong” is a proper primary reference on the basis that it is “basically the same” as Appellant’s claimed design. In particular, the Examiner states: “the position of the rectangles are the same, and the relationship of the rectangles create an overall rectangle shape, the overall visual appearance is the same.” *See Answer*, pp. 12-13; *see also* pp. 3-6, 14. However, the position of the rectangles are, in fact, not the same even in “Created Leong,” as shown below and on page 10 of the Appellant’s Appeal Brief.

Examiner’s “Created Leong” (Orientation as Improperly Rotated)	Pending Claimed Design
	

Therefore, the position of the rectangles of the “Created Leong” differs from the claimed design. For this reason alone, Appellant maintains that the differences between “Created Leong” and the claimed design, which are further outlined in pages 9-12 of the Appellant’s Appeal Brief, render “Created Leong” an improper primary reference under the “basically the same” test.

CONCLUSION

For the reasons discussed above and in Appellant's Appeal Brief, Appellant respectfully submits the rejection of the claim is erroneous. Accordingly, Appellant respectfully requests the Board reverse the rejection.

Respectfully submitted,

Respectfully submitted,

/Peyton L. Meyer/

Date: May 18, 2023
Haynes and Boone, LLP
IP Section
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P06170-US-CON/745US02	5266
160596	7590	03/30/2023	EXAMINER	
HAYNES AND BOONE, LLP (70228)			TUNG, MELANIE H	
IP Section			ART UNIT	PAPER NUMBER
2323 Victory Avenue			2917	
Suite 700			NOTIFICATION DATE	DELIVERY MODE
Dallas, TX 75219			03/30/2023	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 29/732,483
Filing Date: 24 Apr 2020
Appellant(s): INTUITIVE SURGICAL OPERATIONS, INC.

Alan N. Herda
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 12, 2022.

(1) Ground of Rejection to be Reviewed on Appeal

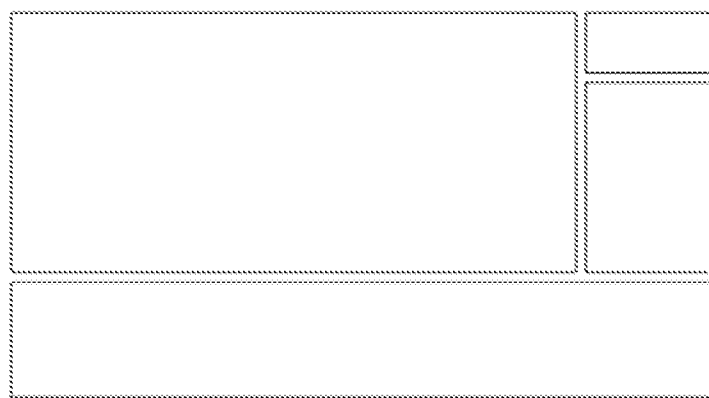
Every ground of rejection set forth in the Office action dated April 6, 2022 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The following ground of rejection are applicable to the appealed claim.

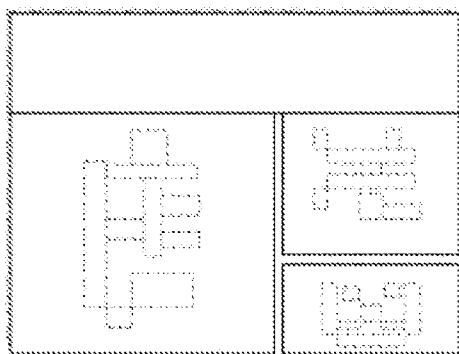
The claim is again and FINALLY REJECTED under 35 U.S.C. 103 as being unpatentable over Leong et al. in view of Gilra et al.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

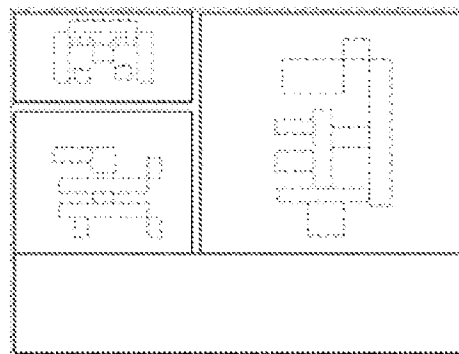
The primary reference has design characteristics which are basically the same as the claimed design -- a long, horizontally oriented rectangle, two smaller rectangles along one edge (the upper small rectangle is shorter than the other), and a fourth rectangle that is the same height as the two stacked smaller rectangles. The width of the two stacked rectangles and the fourth rectangle align with the length of the longer rectangle. This relationship forms an overall rectangular shape. Leong et al. is rotated 180 degrees.



Claimed design, most broken lines omitted



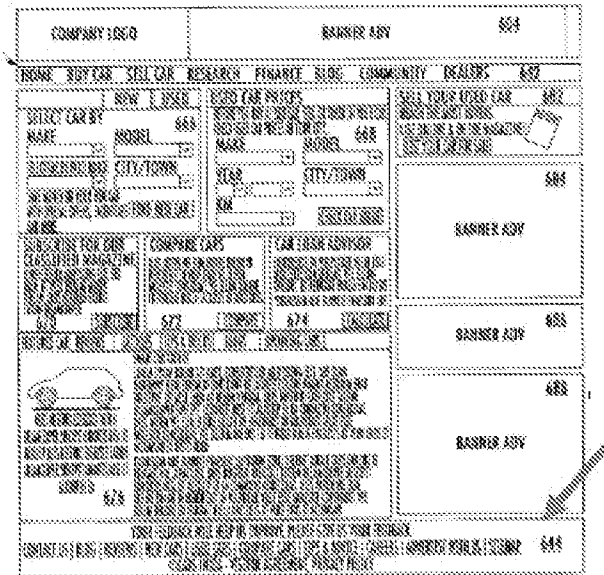
Leong et al., Fig.1



Leong et al., Fig.1, rotated 180 degrees

The Leong et al. graphical user interface does not show the small space between the elongated rectangle and the other two rectangles aligned along one long edge. The Gilra et al. patent shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge. Whether the two smallest rectangles are shown on the right or left side is a de minimis difference and well within the knowledge

of one skilled in the art. The exact proportions of the rectangles also are a de minimis difference.



Gilra et al, Fig.6

It would have been obvious to a designer of ordinary skill not later than the effective filing date of the present claimed invention to have modified the Leong et al. graphical user interface by providing a small space between the elongated rectangle and the two rectangles that are aligned with one long edge as shown by the Gilra et al. patent to meet the overall appearance of the claimed design.

The claimed design would have no patentable distinction over the examiner's combination of references.

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213

USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that a designer skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

(2) Response to Argument

1. Primary reference Leong et al. has not been considered as a whole.

The argument that Leong et al. has not been considered as a whole for all that it teaches is not persuasive. The argument is that since Leong et al. has been improperly rotated and truncated, it is “created.”

Leong et al. is not created. Features in the primary reference that are embodied in less than the entire article are applied to the 103 rejection. Nothing prohibits a prior art reference that shows more than the claimed design from being applied in a 103 rejection. Stated otherwise, a primary reference that shows characteristics that are basically the same as the claimed design need not be devoid of any other elements.

The practice of claiming a design embodied in less than the entire article was confirmed in the decision of *In re Zahn*, 204 USPQ 988 (CCPA 1980). This practice

also opens to the examiner the liberty of relying upon the features of a reference embodied in less than the entire article.

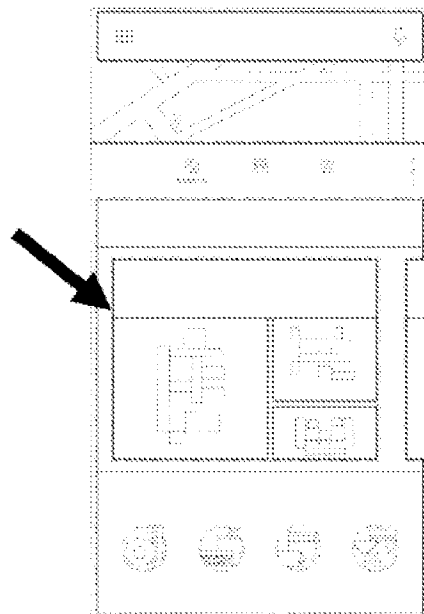
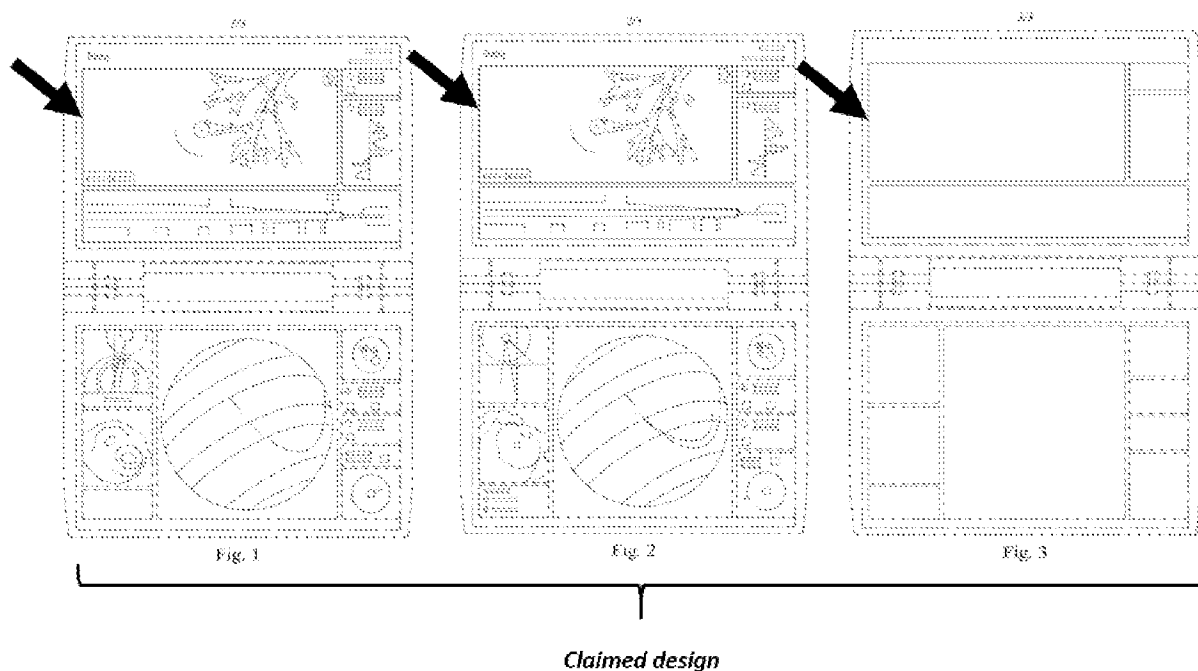


FIG. 1

Leong et al, Fig.1

Reflecting this permissible and existing practice in designs, Appellant's own claimed design is a display screen or portion thereof, with only a portion of the graphical user interface claimed. Other features, such as additional rectangles, circles, and curved lines, are shown in broken lines, and thus not claimed. However, they are present on the display screen.



The ability of an inventor to identify a design that is less than the whole is likewise afforded to references applied in 103 rejections. To state otherwise would be inconsistent reasoning.

Appellant further asserts that the primary reference teaches away from the claimed invention because the orientation matters. This is addressed and discussed in a next argument.

2. When viewed as a whole, the orientation of Leong et al. matters

The argument asserted is that the orientation of Leong et al. is intentional and based on features shown in broken lines (and thus not part of the claim), specifically certain icons. This argument is not persuasive for numerous reasons.

Attributing meaning or a specific interpretation to unclaimed features in the primary reference is based on conjecture. The Leong et al. does not specifically describe or identify the nature or functionality of the unclaimed features. This is not an omission. No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. MPEP 1503.01 II. In fact, the broken lines are described as “portions of the display panel with graphical user interface with layered effect and form no part of the claimed design.” That is the extent of the description of the broken lines. While Appellant may identify Leong et al. unclaimed features as “microphone” icon or “fast food,” “coffee,” and “bar” icons intended to be viewed in one direction, the inventor may have different intentions, or even no intentions for the unclaimed features - a café? Snacks? Breakfast? Happy hour? Icons or images? Wallpaper or pattern? What is pertinent here is not guessing the purpose or utility of those unclaimed features. What is pertinent here is that ascribing a specific function or purpose to unclaimed broken line features is not germane to a design patent, and relying on what they might represent is conjecture.

Two-dimensional designs are displayed and positioned on the given underlying media (e.g. screen, planar surface, paper, canvas, etc...). However, this does not limit

how media is viewed. The media can be rotated. The media can be static and physically approached by a viewer from an infinite number of viewpoints.

For example, if a photograph is placed on a desk, a viewer easily can approach the desk and view the image from infinite viewpoints, depending on from which direction the viewer approaches and how the photograph is positioned on the desk. The example provided in the Appeal Brief (Appeal p. 7) is also applicable. "It is common for such a GUI design to be automatically reoriented if the screen on which the GUI design is displayed is turned, thereby keeping the right-side-up orientation of the GUI design the same." If a first viewer holds a smartphone and the graphical user interface is oriented to the first viewer, and a second viewer faces the first viewer, the graphical user interface will be seen 180 degrees relative to the second viewer. The second viewer cannot "unsee" the graphical user interface in a 180-degree rotation. If the first viewer turns the smartphone (display), the graphical user interface will rotate and be seen from different views as it is rotating. A viewer cannot "unsee" these multiple views of the same design rotated. The graphical user interface is still the same design regardless of whether or not it is rotated any degree.

In addition, viewing an image rotated is an inherent knowledge to one of ordinary skill in the art. Word processing, computer aided design, and photo editing programs have long contained tools for rotating an image an infinite number of degrees. See the attached references of tutorials and web pages showing basic rotating tools in Microsoft excel 2007, AdobePress illustrator CS3, Microsoft Powerpoint 2013, Inkscape, and Photoshop CS6, to name a few.

Viewing Leong et al. from a different rotation does not teach away from the claimed invention.

“If the proposed combination of the references so alters the primary reference that its broad function can no longer be carried out, the combination of the prior art would not have been obvious to a designer of ordinary skill in the art. It is permissible to modify the primary reference to the extent that the specific function of the article may be affected while the broad function is not affected. For example, a primary reference to a cabinet design claimed as airtight could be modified to no longer be airtight so long as its function as a cabinet would not be impaired.”

MPEP 1504.03 II.A.

Here both the Leong et al. reference and the claimed design show graphical user interfaces. Rotating Leong et al. does not teach away from the broad function of a graphical user interface. Boxes, squares, and rectangles and can be shown in a variety of arrangements, all maintaining the broad function of a graphical user interface. See the numerous cited references.

Appellant broadly admits that a situation may exist (Appeal Brief, p.7) where rotation is acceptable, however not Leong et al. Why some two-dimensional images may be rotated but others not, is not explained. Whether or not a two-dimensional image is rotated, it is the same design.

3. Leong et al. is not prior art

The argument that Leong et al. is not “something in existence” is not persuasive. The argument again is that rotating and applying certain features in Leong et al.

“creates” a reference. The rebuttals in the first and second arguments pertain to this argument.

The primary reference exists. Leong et al. shows a long, horizontally oriented rectangle, two smaller rectangles stacked along one edge (the upper small rectangle is shorter than the other), and a fourth rectangle that is the same height as the two stacked smaller rectangles. The width of the two stacked rectangles and the fourth rectangle align with the length of the longer rectangle. This relationship forms an overall rectangular shape. The design in Leong et al. has not been altered.

4. Leong et al. does not show characteristics that are basically the same as the claimed design

The argument that Leong et al. does not show characteristics that are basically the same as the claimed design is not persuasive. Specifically, the primary reference is challenged as not having the same visual impression as the claimed design nor is it basically the same as the claimed design. For clarification, *Rosen* requires that the primary reference “show characteristics that are basically the same as the claimed design.” *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Appellant asserts that Leong et al.’s top right box is narrower, the top left box is taller, the middle left box is shorter than the corresponding rectangles in the claimed design. These slight differences in proportion are not a patentable difference. Obvious changes in arrangement and proportioning are no more patentable in one case than in the other. *In re Stevens*, 81 USPQ 362 (CCPA 1949). Since the position of the rectangles are the same, and relationship of the rectangles create an overall rectangle

shape, the overall visual appearance is the same. Leong et al. shows a long, horizontally oriented rectangle, two smaller rectangles along one edge (the upper small rectangle is shorter than the other), and a fourth rectangle that is the same height as the two stacked smaller rectangles. The width of the two stacked rectangles and the fourth rectangle align with the length of the longer rectangle. This relationship forms an overall rectangular shape. These characteristics are basically the same as the claimed design, and create the same overall visual appearance as the claimed design - a long, horizontally oriented rectangle, two smaller rectangles along one edge (the upper small rectangle is shorter than the other), a fourth rectangle that is the same height as the two stacked rectangles. The width of the two stacked rectangles and the fourth rectangle align with the length of the longer rectangle. This relationship forms an overall rectangular shape.

The identification of the minor difference (the small space between the elongated rectangle and the other two rectangles aligned along one edge of the elongated rectangle) as not shown in the Leong et al. graphical user interface does not invalidate the primary reference. A primary reference need not be “substantially the same,” which is the standard for anticipation under 102. If the primary reference shows characteristics that are basically the same as the claimed design, then a secondary reference may be combined to show that minor differences would have been obvious to one of ordinary skill in the art. MPEP 1504.03 II.A. Here, secondary reference Gilra et al. is cited to show the minor difference – the small space between the longer rectangle and the other two rectangles aligned along the horizontal edge.

The argument further asserts that the Rosen primary reference is a difficult and high standard to meet, citing *Ex parte Chaudhri* et al. First, the case was decided on the specific features of the claimed design and the cited prior art. Rejected claims may not properly be measured by allowed claims in order to determine the patentability of the former, but must be considered in the light of their own limitations or lack of limitations. This rule is so well known and well fixed that no citation of authority is necessary to support it. *In re Zalkind*, 49 USPQ 97 (CCPA 1941). Second, this decision is not precedential. Third, the decision did not establish a new “difficult and high standard” for a proper primary reference.

The purpose of 35 U.S.C. 171 is to grant patents for ornamental designs that are “new, original.” Basing patentability on a rotation, which is not only well known to one of ordinary skill in the art, and as stated above, is merely viewing a design from a different viewpoint, cannot be what the statute envisioned as a “new, original, and ornamental design.”

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917

Conferees:
/KAREN E KEARNEY/
Supervisory Patent Examiner, Art Unit 2923

/BARBARA FOX/
Supervisory Patent Examiner, Art Unit 2914

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Lauren L. Argo <i>et al.</i>	§	Group Art Unit: 2917
	§	
Application No.: 29/732,483	§	Examiner: Melanie H. Tung
	§	
Filed: April 24, 2020	§	Confirmation No.: 5266
	§	
For: Display Screen Or Portion Thereof	§	Docket No.: P06170-US-CON
With Graphical User Interface	§	(70228.745US02)
	§	
	§	

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This Appeal Brief is submitted in connection with an appeal from the final rejection of the Examiner mailed April 6, 2022 (the “Final Rejection”), finally rejecting this application. Appellant filed the Notice of Appeal on July 5, 2022.

REAL PARTY IN INTEREST

The real party in interest in this appeal is Intuitive Surgical Operations, Inc., a corporation having its principal office and place of business in Sunnyvale, California. Intuitive Surgical Operations, Inc. is the Assignee of the above-referenced patent application, with the Assignment having been recorded in the United States Patent and Trademark Office (the “PTO”) on April 24, 2020, at Frame 0341 of Reel 052487.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences involving this application or its subject matter.

STATUS OF THE CLAIM

This design application on appeal has one pending claim. As required, the pending claim, as reflected in Figures 1-3 of the application, is presented in the Claim Appendix of this Brief. The claim stands rejected and forms the subject matter of this appeal.

STATUS OF AMENDMENTS

In the specification, the description as originally filed was replaced with an amended description as set forth in the Amendment in response to the Office Action mailed September 30, 2021, which Amendment was filed on December 21, 2021; the amended description was deemed acceptable by the Examiner on page 2 of the Final Rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Because this is an application for a design patent, there are no reference numerals contained in the application. The claimed subject matter is the ornamental design for a Display Screen or Portion Thereof With Graphical User Interface as shown in Figures 1-3 and described in Appellant's application. See Figures 1-3 in the Claim Appendix.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The claim stands rejected under 35 U.S.C. § 103 over U.S. Patent No. D836,121 ("Leong") in view of U.S. Patent No. 8,438,495 ("Gilra").

ARGUMENT

Appellant submits that the claim has been improperly rejected as being obvious over Leong in view of Gilra. Pursuant to 35 U.S.C. § 171, "[w]hoever 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." One of those requirements is that the design be nonobvious. 35 U.S.C. § 103(a); *see also* 35 U.S.C. § 171 ("The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."). For design patents:

“the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. To answer this question, a court must first determine whether one of ordinary skill would have combined teachings of the prior art to create the **same overall visual appearance** as the claimed design. That inquiry involves a two-step process. First, the court must identify a single reference, a something in existence, the design characteristics of which are **basically the same** as the claimed design. The basically the same test requires consideration of **the visual impression created by the patented design as a whole**.... Once the primary reference is found, other ‘secondary’ references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. These secondary references must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.”

MRC Innovations, Inc. v. Hunter Mfg., LLP, 747 F.3d 1326, 1331 (Fed. Cir. 2014)
(citations, brackets, and quotation marks omitted) (emphasis added).

As articulated in M.P.E.P. § 1504.03:

“in order to support a holding of obviousness, ***a primary reference must be more than a design concept***; it must have an appearance ***substantially the same*** as the claimed design. *See In re Harvey*, 12 F.3d 1061, 29 U.S.P.Q.2d 1206 (Fed. Cir. 1993). Absent such a reference, no holding of obviousness under 35 U.S.C. 103 can be made, whether based on a single reference alone or in view of modifications suggested by secondary prior art.” (emphasis added).

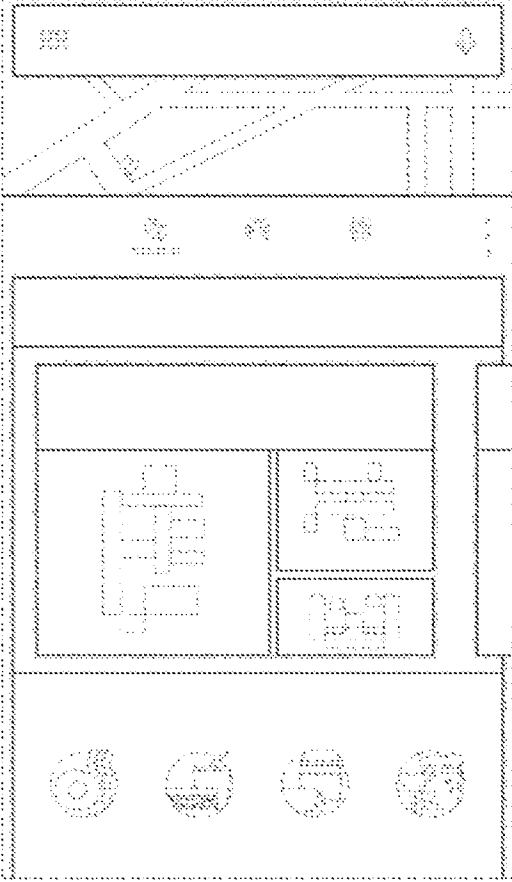
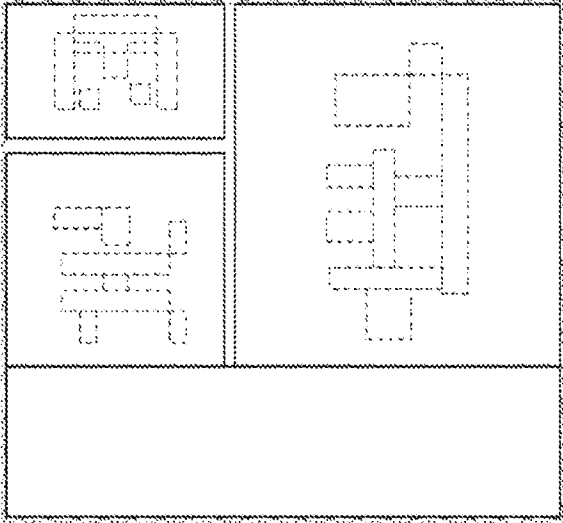
In assessing obviousness, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

Here, the Examiner has erred in maintaining a rejection of the claimed design under 35 U.S.C. § 103 over Leong in view of Gilra for at least the four (4) reasons set forth below.

1. The Examiner failed to consider Leong’s Figure 1 as a whole.

In the Response to the Final Rejection, which Response was filed June 2, 2022 (the “Response”), Appellant argued that contrary to MPEP § 2141, which requires a

primary reference to be “considered in its entirety, *i.e.*, as a whole,” the Examiner failed to consider Leong’s Figure 1 in its entirety for all that it teaches. Instead, the Examiner improperly rotated and truncated Leong’s Figure 1 in an attempt to better resemble the claimed design. More particularly, rather than relying on the entirety of Figure 1 for all that it teaches, the Examiner rotated the figure 180° and truncated the top, bottom, right, and left portions of the figure to create a primary reference, *i.e.*, “Created Leong.” The table below compares Figure 1 of Leong in its entirety to the Examiner’s “Created Leong.”

Figure 1 of Leong	Examiner’s “Created Leong”
 <p data-bbox="440 1709 516 1738">FIG. 1</p>	

As shown above, the Examiner's "Created Leong" is very different from Leong's Figure 1, clearly demonstrating a failure by the Examiner to consider Leong's Figure 1 in its entirety, as required by MPEP § 2141. Since "Created Leong" gives a false impression of Leong's Figure 1, it cannot properly be relied upon to support an obviousness-based rejection of the claimed design. For this reason alone, Appellant argued that the obviousness-based rejection of the claimed design over "Created Leong" should be reconsidered and withdrawn.

Nevertheless, the Advisory Action mailed June 14, 2022 (the "Advisory Action"), reasserts the Examiner's reliance on "Created Leong," providing that:

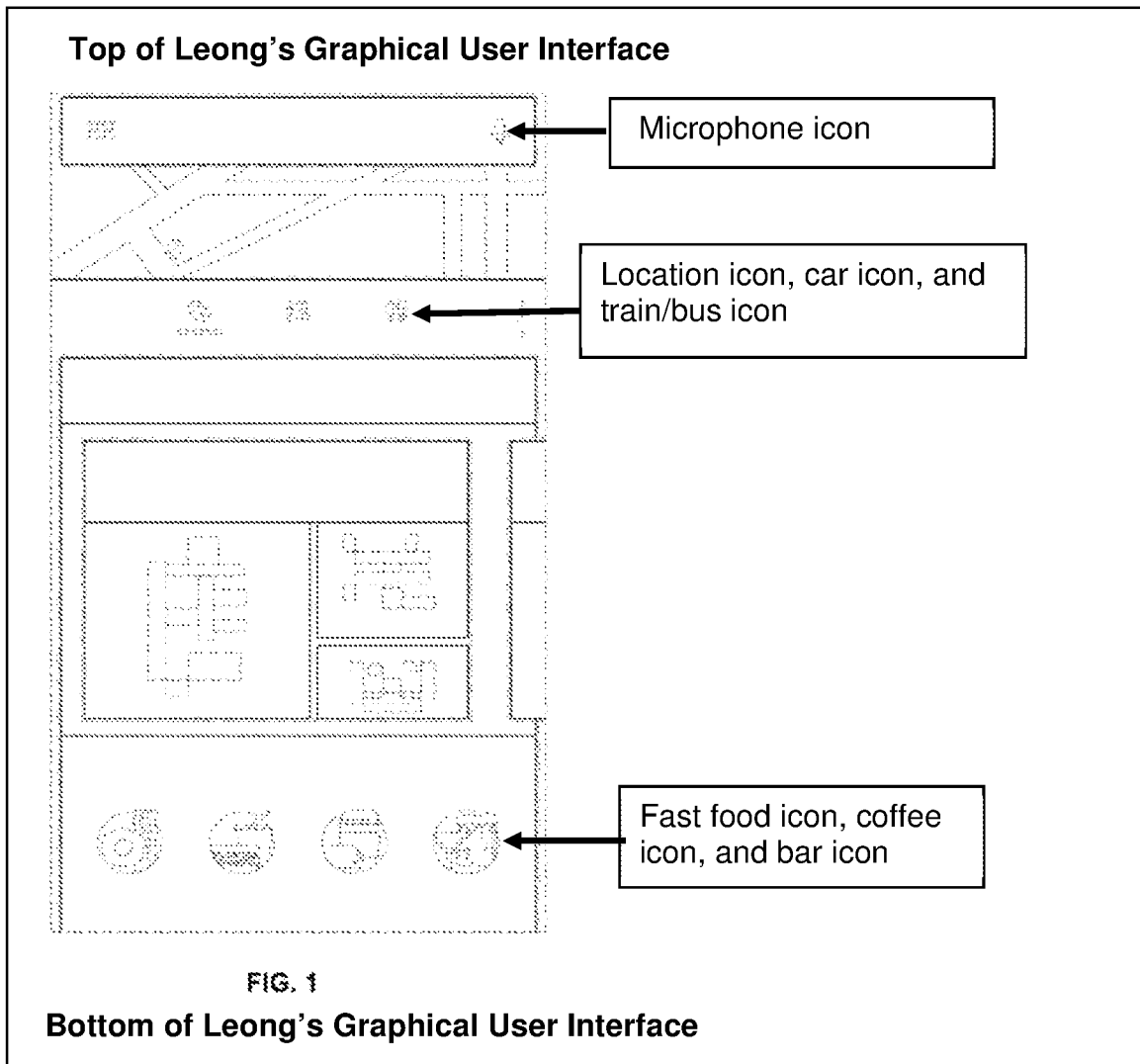
*[T]his argument is not persuasive because the practice of claiming a design embodied in less than the entire article was confirmed in the decision of *In re Zahn*, 204 USPQ 988 (CCPA 1980). This practice also opens to the examiner the liberty of relying upon the features of a reference embodied in less than the entire article. Nothing prohibits a prior art reference that shows more than the claimed design from being applied in a 103 rejection. Stated otherwise, a primary reference that shows characteristics as the claimed design need not be devoid of any other elements.*

Appellant respectfully disagrees, acknowledging that, while a situation may exist in which it is appropriate to rely on the features of a reference embodied in less than the entire article, this is not it. Here, instead, Appellant has refuted the Examiner's proposed truncation of Leong's Figure 1 by "show[ing] that the art in any material respect 'taught away' from the claimed invention." See MPEP § 2141.02 and § 1504.03 (citing *In re Haruna*, 249 F.3d 1327 (Fed. Cir. 2001)). In this regard, Appellant respectfully submits that the truncated features of Leong's Figure 1 are important to the overall design because they serve to demonstrate that the orientation of Leong's GUI matters, as will be discussed in further detail below. For this reason alone, the obviousness-based rejection of the claimed design over "Created Leong" should be reconsidered and withdrawn.

2. When properly viewed in its entirety, i.e., as a whole, the orientation of Leong's Figure 1 matters.

In the Final Rejection, the Examiner asserted that "the intention of inventors Leong et al. [for the design to be viewed in a particular orientation] is not supported by evidence."

Page 5. However, in the Response, Appellant further argued that, when Leong's Figure 1 is properly viewed in its entirety, it is clear that the orientation of the design is, in fact, intentional. More particularly, portions of Leong's Figure 1 indicate that there is a specific orientation intended for the graphical user interface (*i.e.*, a top and a bottom portion); Leong's Figure 1 is reproduced in annotated form below to illustrate this point.



As shown above, when properly viewed in its entirety, Leong's Figure 1 does indeed have a particular intended orientation because the Examiner's proposed 180° rotation of Leong's Figure 1 would result in upside-down icons for the microphone, location, car, train/bus, fast food, coffee, and bar. Since these icons (and thus the

graphical user interface in its entirety) are clearly intended to be viewed in a right-side-up orientation, and not the upside-down orientation suggested by the Examiner, it would not be appropriate to rotate Leong's Figure 1 as proposed. For this reason alone, Appellant argued that the obviousness-based rejection of the claimed design over "Created Leong" should be reconsidered and withdrawn.

Nevertheless, the Advisory Action reasserts the Examiner's reliance on "Created Leong," further asserting that *"this argument is not persuasive"* because *"the functional considerations of a graphical user interface have no bearing on what it shows. As stated in the final rejection, viewing an image rotated is inherent to one of ordinary skill in the art."*

Appellant respectfully disagrees, acknowledging that, while a situation may exist in which it is appropriate to rotate a reference, this is not it. Here, instead, Appellant has refuted the Examiner's proposed 180° rotation of Leong's Figure 1 by "show[ing] that the art in any material respect 'taught away' from the claimed invention." See MPEP § 2141.02 and § 1504.03 (citing *In re Haruna*, 249 F.3d 1327 (Fed. Cir. 2001)). In this regard, Appellant reiterates that Leong's designer clearly intended the GUI shown in Figure 1 to be viewed in a right-side-up orientation, and not an upside-down orientation, as proposed by the Examiner. Indeed, for many electronic device screens, it is common for such a GUI design to be automatically reoriented if the screen on which the GUI design is displayed is turned, thereby keeping the right-side-up orientation of the GUI design the same. Appellant respectfully submits that it would thus be inappropriate to rotate Leong's GUI design to an upside-down orientation, as proposed by the Examiner, because Leong contains no suggestion to modify the GUI design shown in Figure 1 in this manner, nor does the Examiner even allege such a suggestion. For this reason alone, the obviousness-based rejection of the claimed design over "Created Leong" should be reconsidered and withdrawn.

3. The Examiner's "Created Long" is not prior art.

In the Response, Appellant further argued that, even assuming *arguendo* that it is proper to consider only a portion of Leong's Figure 1, and to both rotate and truncate

Leong's Figure 1, the resulting reference created by the Examiner ("Created Leong") is not prior art because it was not "something in existence" prior to the effective filing date of the claimed design.

As discussed above, when evaluating whether a claimed design is obvious, the claimed design as a whole must be compared with **something in existence**. MPEP § 1504.03(II) (citing *In re Jennings*, 182 F.2d 207 (C.C.P.A. 1950)) (emphasis added). That is, the claimed design must be "compared with something in existence—**not with something that might be brought into existence by selecting individual features** from prior art and combining them, particularly where combining them would require modification of every individual feature." *In re Jennings*, 182 F.2d at 207, 208 (emphasis added).

Here, by rotating and truncating portions of Figure 1 of Leong, the Examiner has **created** a reference, rather than using "something in existence" to reject the claimed design. "Created Leong" as applied is not prior art because it did not exist prior to the effective filing date of the claimed design, but instead was created by the Examiner for the sole purpose of rejecting the claimed design. Since the Examiner's "Created Leong" is not prior art, Appellant argued that the obviousness rejection is improper and should be withdrawn for this reason alone.

Nevertheless, the Advisory Action reasserts "Created Leong," providing that:

This argument is not persuasive because what the primary reference shows has not been created. The assembled design of a[n] elongated rectangle, the shorter and taller rectangle, and the two smaller rectangles aligned on one side all exist in the primary reference. These features are the 'something in existence' shown in the primary reference.

Appellant respectfully disagrees, reiterating that "Created Leong" is not prior art because it did not exist in its truncated and rotated form prior to Appellant's filing date, but was instead created by the Examiner for the sole purpose of rejecting the claimed design. Indeed, by truncating and rotating Leong's Figure 1, which is a GUI design, to produce "Created Leong," the Examiner has **created** a reference rather than using

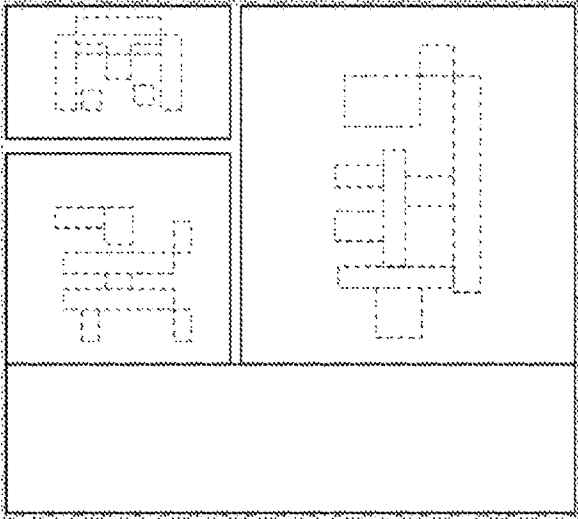
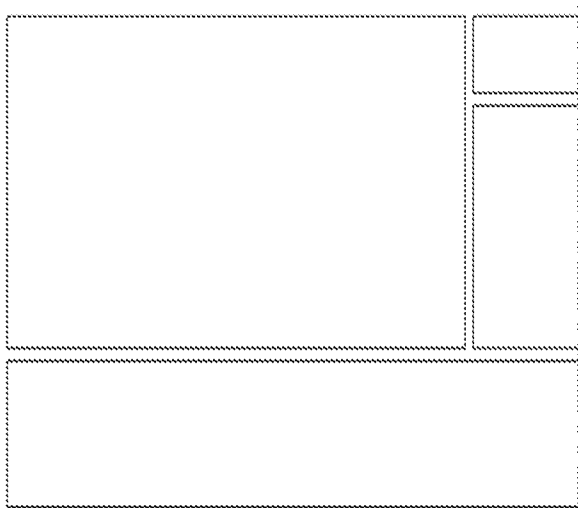
“something in existence.” For this reason alone, the obviousness-based rejection of the claimed design over “Created Leong” should be reconsidered and withdrawn.

4. Assuming *arguendo* that the Examiner’s “Created Leong” is prior art and its creation is proper, it cannot be used as a primary reference because its design characteristics are not basically the same as the claimed design.

In the Response, Appellant further argued that, even assuming *arguendo* that Created Long is prior art and its creation is proper (both points not conceded by the Appellant), “Created Leong” cannot properly be used as a primary reference because it is not “basically the same” as the claimed design. In this regard, for a primary reference to be proper, one must, from the viewpoint of a designer of ordinary skill in the art: “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.” *Durling v. Spectrum Furniture Co. Inc.*, 101 F. 3d 100, 103 (Fed. Cir. 1996) and *In re Rosen*, 673 F. 2d 388, 391 (CCPA 1982). In other words, to be a proper primary reference, “Created Leong” must be shown to be a reference in existence **“the design characteristics of which are basically the same as the claimed design.”** *In re Rosen*, 673 F.2d 388, 391 (emphasis added).

However, “Created Leong” neither creates the same visual impression as the claimed design, nor is it basically the same as the claimed design. In fact, the Examiner concedes that “[t]he Leong et al. graphical user interface does not show the small space between the elongated rectangle and the other two rectangles aligned along one edge,” instead relying on the Gilra reference for this feature, alleging that the “Gilra et al. patent shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge.” Final Rejection, pages 3 and 4. The Examiner further alleges that the “two smallest rectangles [being] shown on the right or left side is a de minimis difference.” *Id.*, page 4.

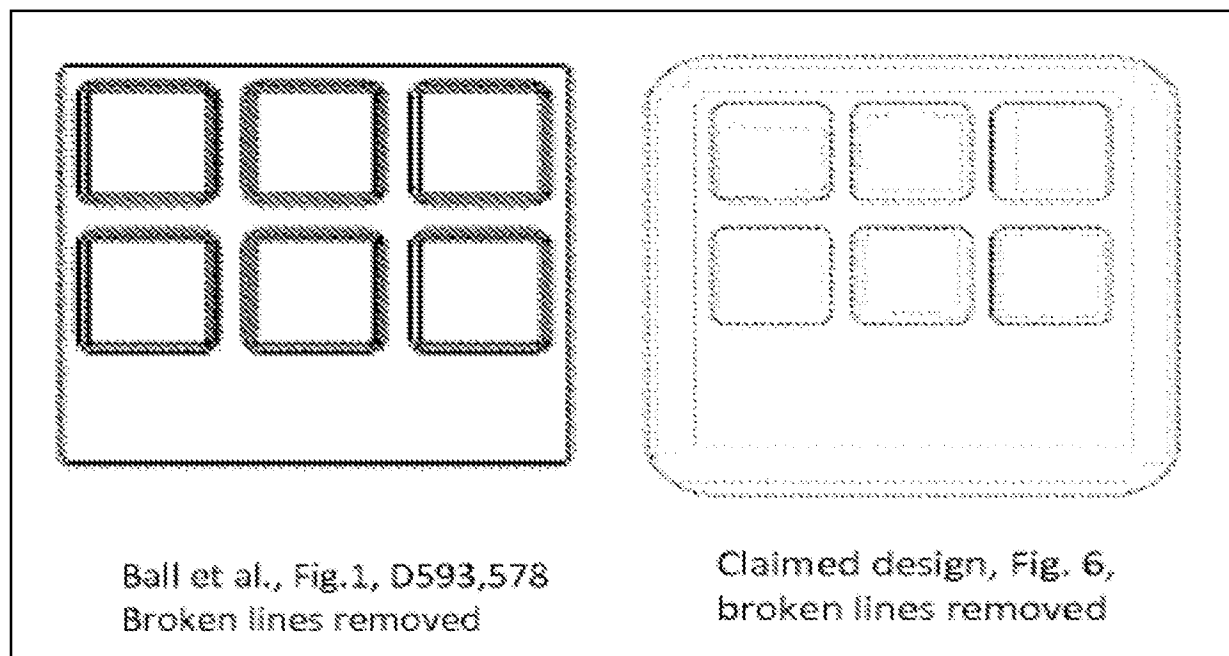
The Examiner’s “Created Leong” is reproduced below alongside the claimed design to illustrate the differences therebetween:

Examiner's "Created Leong"	Pending Claimed Design
 <p>The diagram shows a rectangular frame divided into three horizontal sections. The top section is further divided into two vertical boxes: a narrow one on the left and a wider one on the right. The middle section is a single wide box. The bottom section is a single wide box. Each of these three main sections contains a pattern of small squares and lines, representing a stylized design.</p>	 <p>The diagram shows a rectangular frame divided into three horizontal sections. The top section is further divided into two vertical boxes: a wide one on the left and a narrow one on the right. The middle section is a single wide box. The bottom section is a single wide box. Each of these three main sections contains a pattern of small squares and lines, representing a stylized design.</p>

As shown above, the Examiner's Created Leong is not "basically the same" as the claimed design because the boxes have differing proportions. Specifically, the top-right box of "Created Leong" is narrower than the claimed design's allegedly corresponding upper-left portion, the top-left box of "Created Leong" is taller than the claimed design's allegedly corresponding upper-right portion, and the middle-left box of "Created Leong" is shorter than the claimed design's allegedly corresponding middle-right portion. Thus, even after truncating and rotating Leong's Figure 1, "Created Leong" still creates an overall visual impression that is significantly different from the claimed design, such that the two designs are not basically the same. Since the two designs are not basically the same, "Created Leong" cannot properly be relied upon as a primary reference to support an obviousness-based rejection of the claimed design.

Additionally, Appellant respectfully submits that the standard for establishing two designs as being "basically the same" from the viewpoint of an ordinary designer is a **difficult and high** standard to meet. Indeed, this difficult and high standard was considered by the PTAB in *Ex parte Chaudhri et al.*, No. 2018-001766 (PTAB Dec. 19, 2019), an appeal challenging the rejection of a pending design claim for a display screen.

In that case, the Appellant asserted that “[t]he differences in shape and orientation between the applied reference underscore Appellant’s position that designers not only appreciate the visual differences ... they [also] use those differences in creating their designs.” *Id.* at 5. The claimed design from *Ex parte Chaudhri* is reproduced below alongside the applied reference from that case, namely Figure 1 of U.S. Patent No. D593,578 to Ball et al. (“Ball”):



Although acknowledging that the two designs shown above were similar, the PTAB found that they did not meet the difficult and high standard of being “basically the same.” Moreover, in the process of concluding that the Examiner had “not established that Ball is a proper primary reference,” the PTAB also emphasized that “[m]inor points of difference ... can play a greater role in differentiating simple designs.” *Id.* at 5-6. While not precedential, *Ex parte Chaudhri* provides a pertinent example of a situation in which the difficult and high standard for establishing that two designs are “basically the same” was **not** met, and informs a similar comparison here between “Created Leong” and the claimed design. In this regard, there are far fewer differences between Ball and the claimed design in *Ex parte Chaudhri* than between “Created Leong” and the presently claimed design. As a result, Appellant argued in the Response that “Created Leong”

similarly fails to meet the difficult and high standard for establishing that it is “basically the same” as the claimed design.

Nevertheless, the Advisory Action reasserts “Created Leong,” providing that:

[T]his argument that the primary reference does not show the small space between elongated rectangle and the other two rectangles aligned along one edge is not persuasive because this is a minor difference. The minor difference is shown to be obvious in light of the secondary reference, Gilra et al. Also, the slight difference in proportion is a de minimis difference. The overall visual appearance of the primary reference and the claimed design are basically the same. Ex parte Chaudhri is noted, however, is not precedential. Rejected claims may not be properly measured by allowed claims, since each case stands on its own merits. See In re Zalkind, 49 USPQ 97 (CCPA 1941).

Appellant respectfully disagrees, reiterating that, since the claimed design is a relatively simple one, the differences in proportion between “Created Leong’s” boxes and the claimed design’s allegedly corresponding portions, although arguably minor, play a significant role in differentiating the claimed design from “Created Leong,” such that “Created Leong” fails to meet the difficult and high standard of being “basically the same” as the claimed design. Therefore, even assuming *arguendo* that Created Long is prior art and its creation is proper (both points not conceded by the Appellant), “Created Leong” cannot properly be used as a primary reference because it is not “basically the same” as the claimed design. For this reason alone, the obviousness-based rejection of the claimed design over “Created Leong” should be reconsidered and withdrawn.

For all the foregoing reasons, it is respectfully requested that the rejection of the pending design claim under 35 U.S.C. §103 over Leong in view of Gilra be reconsidered and withdrawn, as no *prima facie* case of obviousness exists in the record as to the claimed design.

Conclusion

In view of the foregoing, Appellant has identified multiple grounds for overturning the rejection. Any one of these grounds is sufficient to rule in favor of Appellant. Accordingly, it is clear that the rejection of the claim under 35 U.S.C. § 103 over Leong in view of Gilra is improper and should be withdrawn.

Respectfully submitted,

/Alan N. Herda/

Alan N. Herda
Registration No. 50,426

Date: August 12, 2022
HAYNES AND BOONE, LLP
IP Section
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Telephone: 214-651-5924
IP Facsimile: 214-240-0853

CLAIM APPENDIX

What is claimed is:

The ornamental design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE as shown and described.

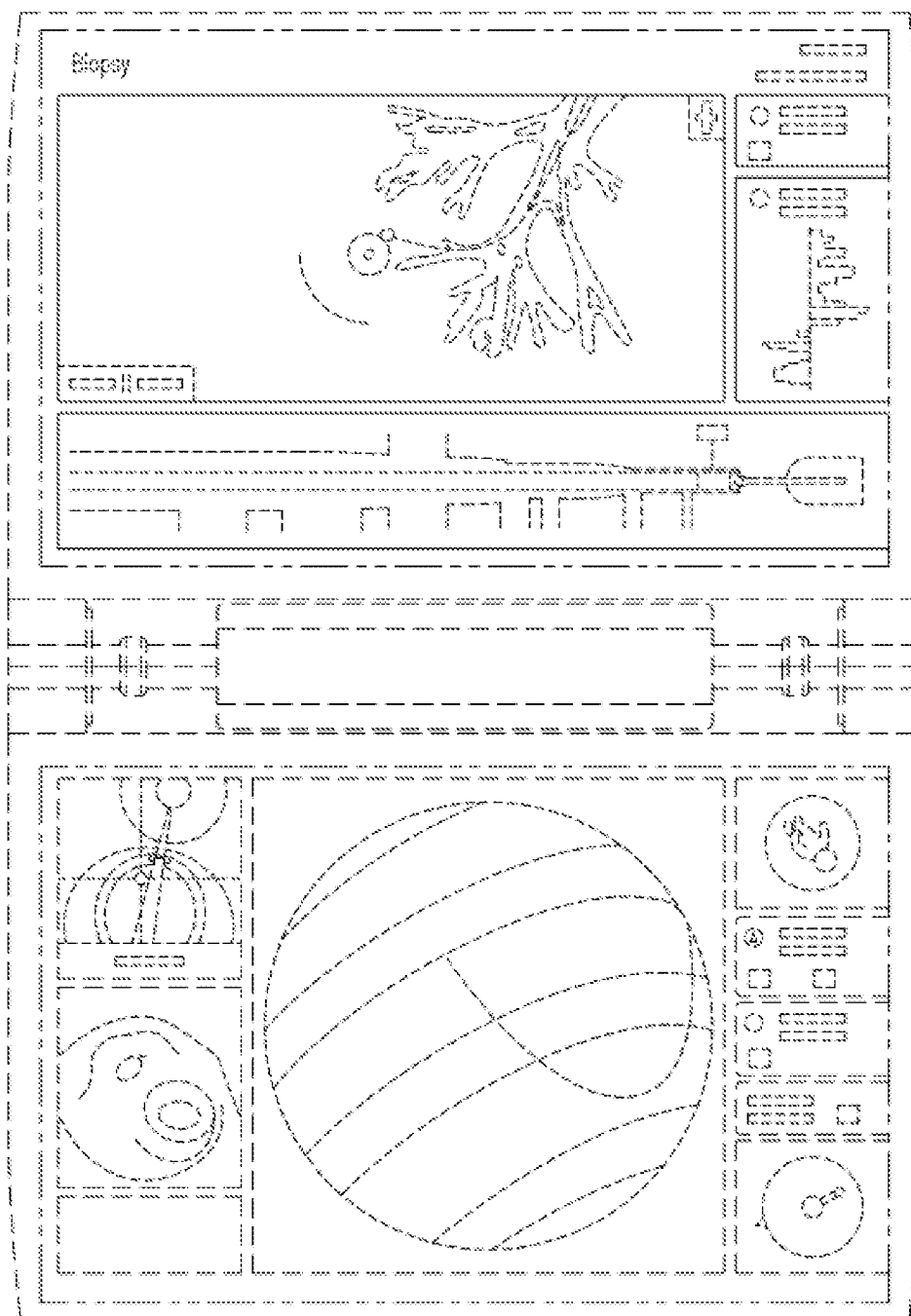


Fig. 1

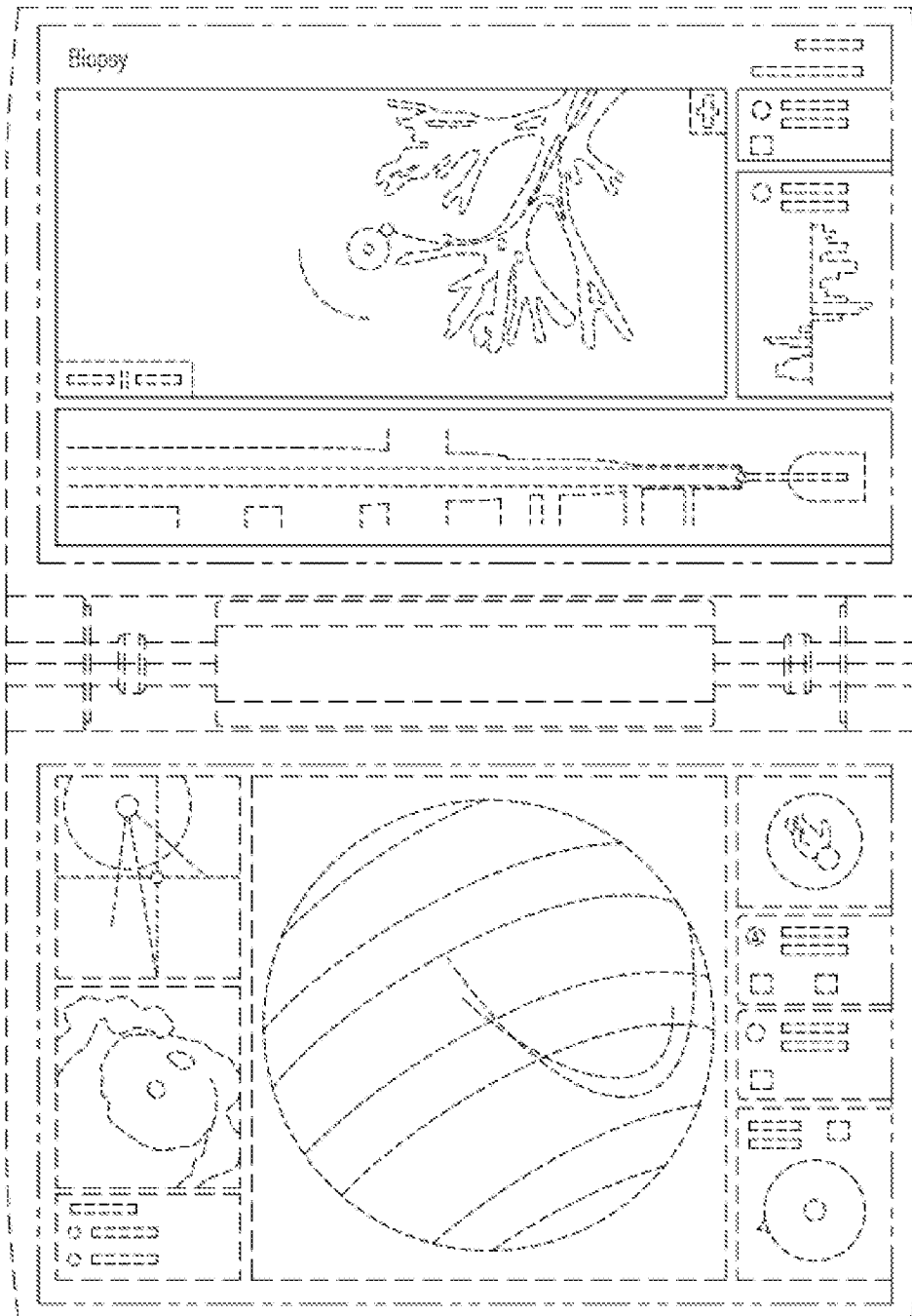


Fig. 2

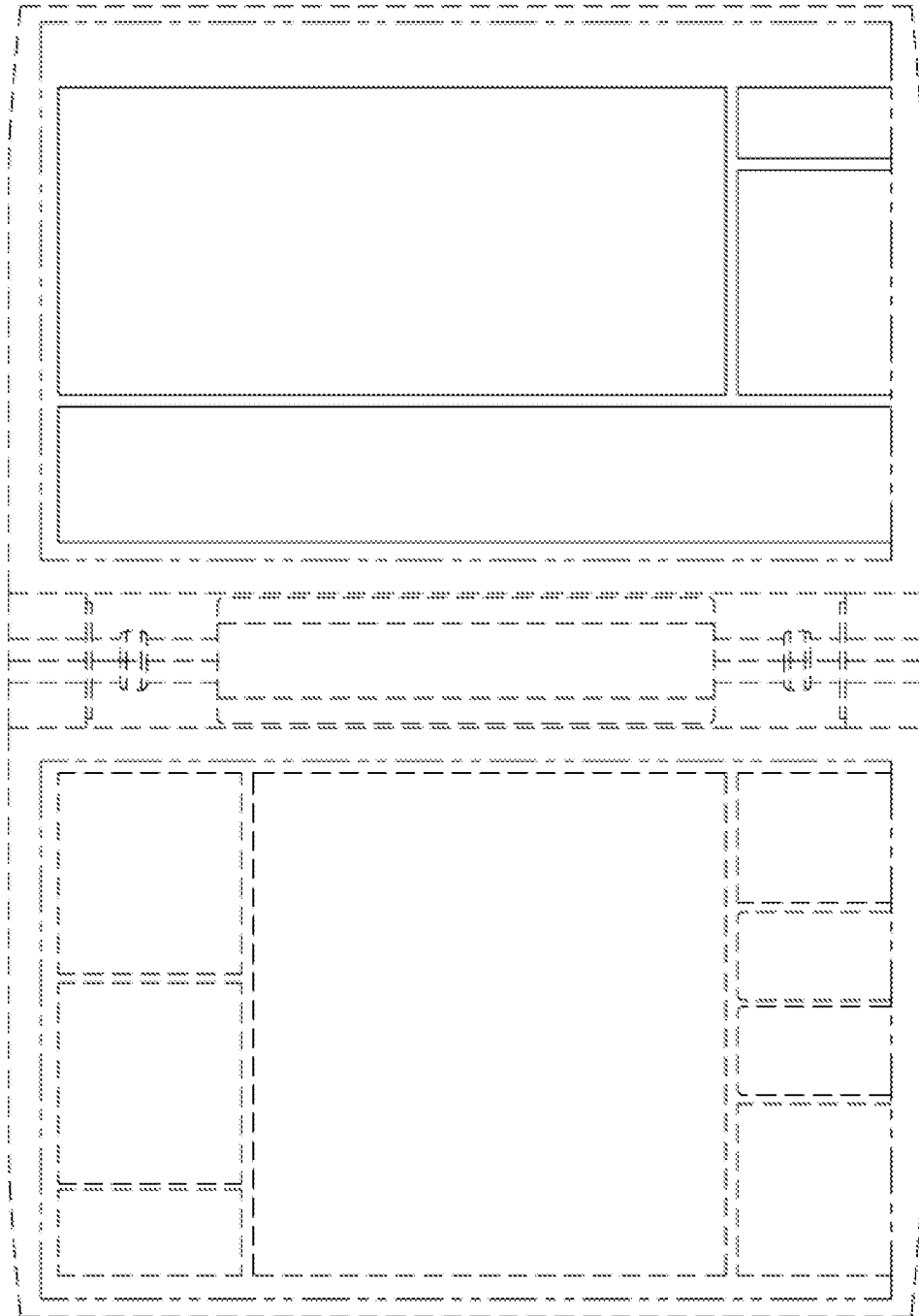


Fig. 3

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NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD		Docket Number (Optional) 70228.745US02								
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the USPTO's patent electronic filing system, or deposited with the United States Postal Service with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 5, 2022</u> . Signature <u>/Q Dismuke/</u> Typed or printed name <u>Q Dismuke</u>	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 2px;">First Named Inventor Lauren L. Argo</td> </tr> <tr> <td style="padding: 2px;">Application Number 29/732,483</td> <td style="padding: 2px;">Filed April 24, 2020</td> </tr> <tr> <td colspan="2" style="padding: 2px;">For DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE</td> </tr> <tr> <td style="padding: 2px;">Art Unit 2917</td> <td style="padding: 2px;">Examiner Melanie H. Tung</td> </tr> </table>		First Named Inventor Lauren L. Argo		Application Number 29/732,483	Filed April 24, 2020	For DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE		Art Unit 2917	Examiner Melanie H. Tung
First Named Inventor Lauren L. Argo										
Application Number 29/732,483	Filed April 24, 2020									
For DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE										
Art Unit 2917	Examiner Melanie H. Tung									
<p>Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.</p> <p>The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ <u>840</u></p> <p><input type="checkbox"/> Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is: \$ _____</p> <p><input type="checkbox"/> Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 75%, and the resulting fee is: \$ _____ Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <u>081394</u>.</p> <p><input checked="" type="checkbox"/> Payment made via USPTO's patent electronic filing system (Patent Center or EFS-Web).</p> <p><input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 30%;"> <input type="checkbox"/> applicant </div> <div style="width: 30%;"> <input checked="" type="checkbox"/> attorney or agent of record Registration number <u>68,500</u> </div> <div style="width: 30%;"> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number _____ </div> </div> <p>Signature <u>/Zachary A. Halbur/</u></p> <p>Typed or printed name <u>Zachary A. Halbur</u></p> <p>Telephone Number <u>817-347-6678</u></p> <p>Date <u>July 5, 2022</u></p> <p>NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> * Total of <u>1</u> forms are submitted.</p>										

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0031. Public burden for this form is estimated to average 12 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	70228.745US02	5266

160596 7590 06/14/2022
HAYNES AND BOONE, LLP (70228)
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

EXAMINER

TUNG, MELANIE H

ART UNIT	PAPER NUMBER
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2917

NOTIFICATION DATE	DELIVERY MODE
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06/14/2022

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):

ipdocketing@haynesboone.com
patent.group@intusurg.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 29/732,483	Applicant(s) Argo et al.	
	Examiner Melanie H Tung	Art Unit 2917	AIA (FITF) Status Yes

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

THE REPLY FILED 02 June 2022 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

NO NOTICE OF APPEAL FILED

1. ☒ The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires ____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

c) ☐ A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires ____ months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANTS FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because

a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

b) ☐ They raise the issue of new matter (see NOTE below);

c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): (a) ☐ will not be entered, or (b) ☐ will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____

9. ☐ The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

10. ☐ The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

11. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

12. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

13. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

14. ☐ Other: _____

STATUS OF CLAIMS

15. The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: single claim.

Claim(s) withdrawn from consideration: _____

/MELANIE H TUNG/ Primary Examiner, Art Unit 2917	
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Continuation of REQUEST FOR RECONSIDERATION/OTHER 12. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: The arguments set forth in the after final response are addressed:

1) The primary reference was not considered as a whole: this argument is not persuasive because the practice of claiming a design embodied in less than the entire article was confirmed in the decision of *In re Zahn*, 204 USPQ 988 (CCPA 1980). This practice also opens to the examiner the liberty of relying upon the features of a reference embodied in less than the entire article. Nothing prohibits a prior art reference that shows more than the claimed design from being applied in a 103 rejection. Stated otherwise, a primary reference that shows characteristics as the claimed design need not be devoid of any other elements.

2) If the primary reference is viewed as a whole, the orientation matters: this argument is not persuasive for the reason set forth in 1) above. In addition, the functional considerations of a graphical user interface have no bearing on what it shows. As stated in the final rejection, viewing an image rotated is inherent to one of ordinary skill in the art.

3) The primary reference has been "created": This argument is not persuasive because what the primary reference shows has not been created. The assembled design of a elongated rectangle, the shorter and taller rectangle, and the two smaller rectangles aligned on one side all exist in the primary reference. These features are the "something in existence" shown in the primary reference.

4) The primary reference is not basically the same as the claimed design: this argument that the primary reference does not show the small space between elongated rectangle and the other two rectangles aligned along one edge is not persuasive because this is a minor difference. The minor difference is shown to be obvious in light of the secondary reference, *Gilra et al.* Also, the slight difference in proportion is a de minimis difference. The overall visual appearance of the primary reference and the claimed design are basically the same. *Ex parte Chaudhri* is noted, however, it is not precedential. Rejected claims may not be properly measured by allowed claims, since each case stands on its own merits. See *In re Zalkind*, 49 USPQ 97 (CCPA 1941).

II. Remarks

Consideration of this application in light of the following remarks is respectfully requested.

A. Rejection Under 35 U.S.C. §103

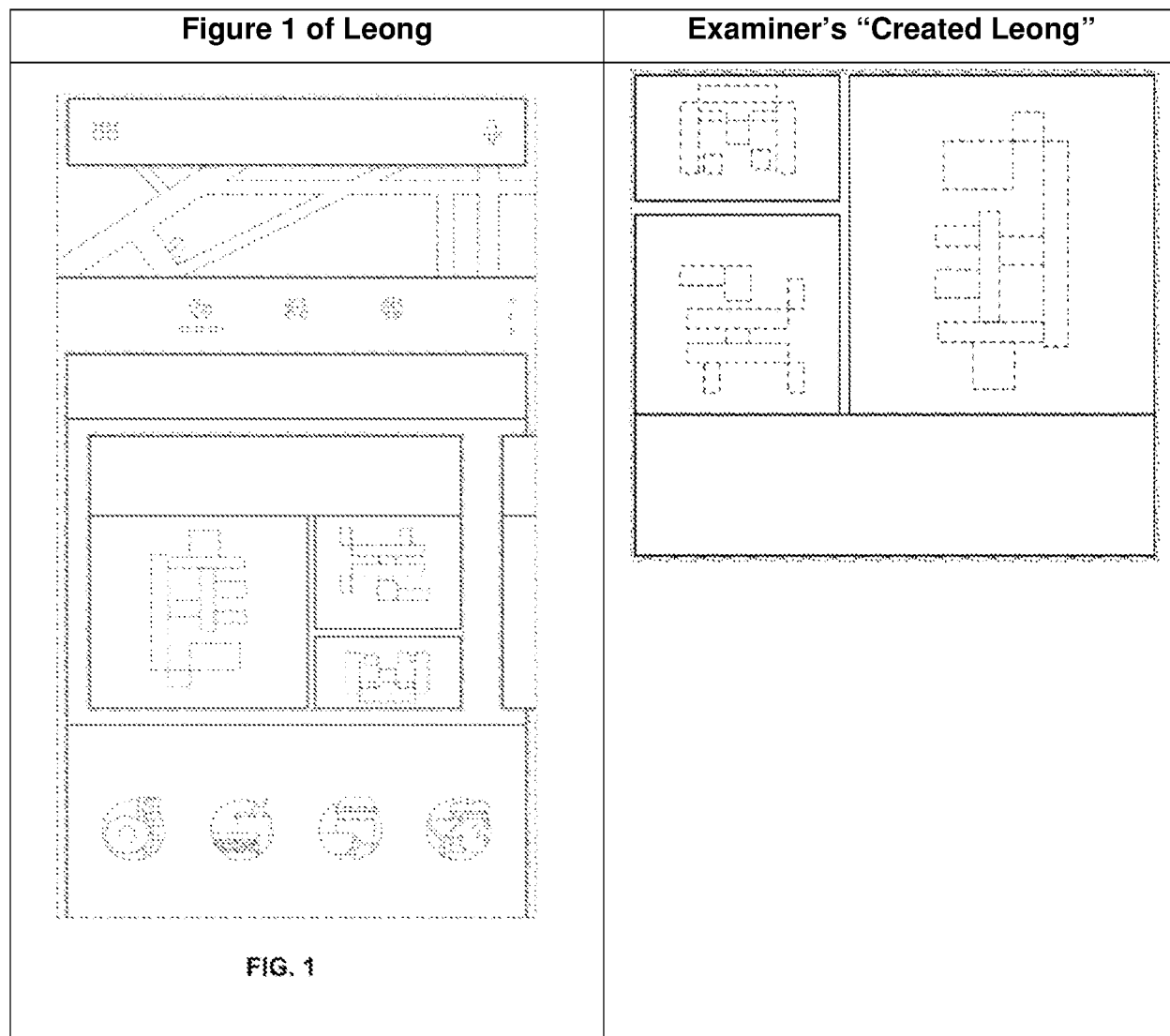
The claim stands rejected under 35 U.S.C § 103 over U.S. Patent No. D836,121 (“Leong”) in view of U.S. Patent No. 8,438,495 (“Gilra”). This obviousness rejection is respectfully traversed.

1. The Examiner did not consider Leong as a whole.

In the obviousness inquiry, the primary reference “must be considered in its entirety, i.e., as a whole.” See MPEP § 2141.

Here, the primary reference relied on by the Examiner is Leong, Figure 1. *Office Action*, pages 3-4. However, the Examiner has not considered Leong’s Figure 1 in its entirety for all that it teaches. Instead, Leong’s Figure 1 has been rotated and truncated to better resemble the present claimed design. Instead of relying on the entirety of Figure 1 of Leong, the Examiner, has *inter alia*, rotated the figure 180° and truncated the top, bottom, right, and left portions of the figure to create a primary reference, i.e., “Created Leong.”

The table below compares Figure 1 of Leong in its entirety to the Examiner’s Created Leong:

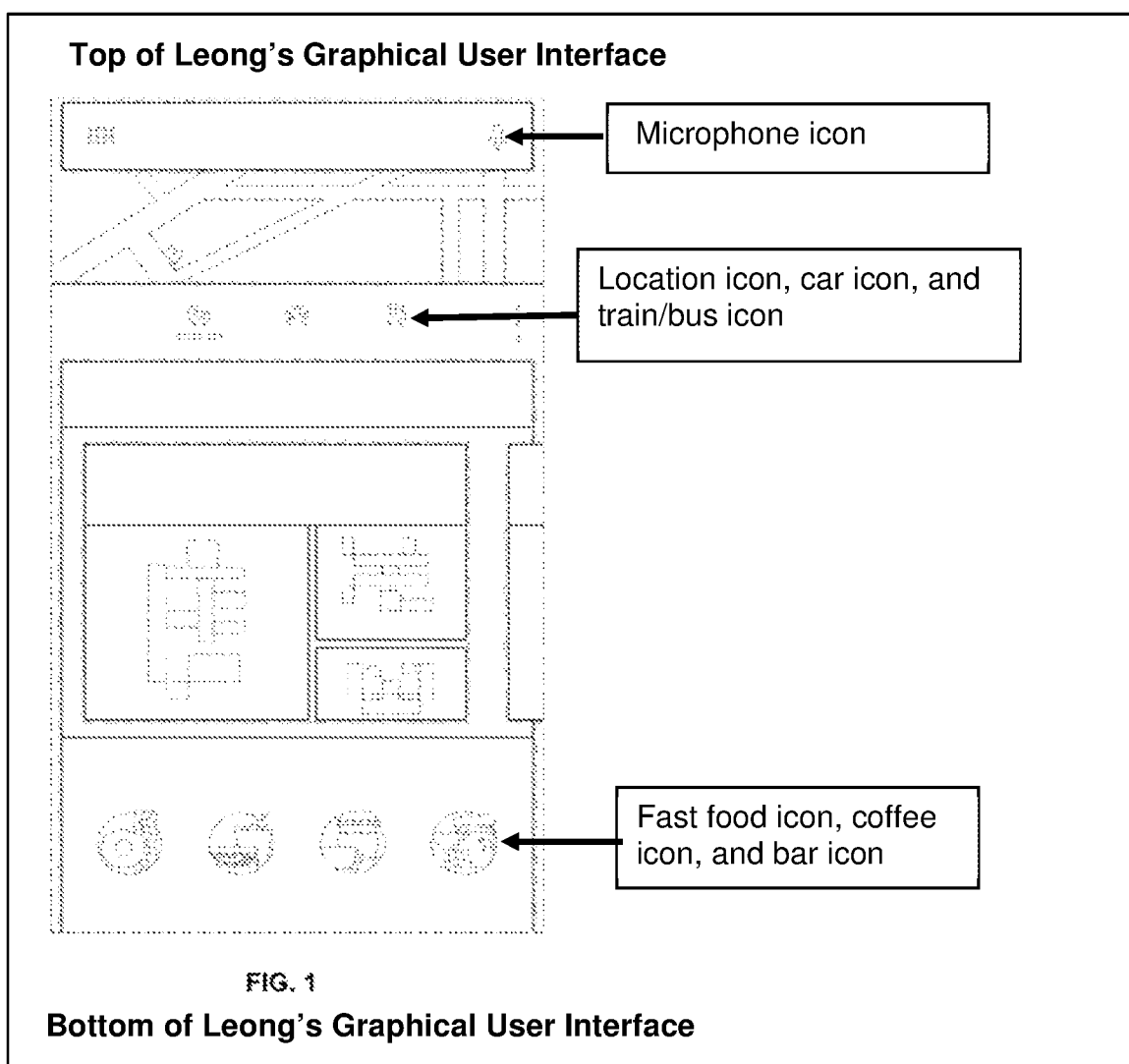


The above comparison shows that the Examiner's Created Leong is very different from Figure 1 of Leong in its entirety.

Since the Examiner did not evaluate Figure 1 of Leong as a whole, in its entirety as required by MPEP § 2141, the obviousness rejection is improper and should be withdrawn for this reason alone.

2. If Leong is properly viewed in its entirety, the orientation of Leong's Figure 1 matters.

The Examiner states that “the intention [for the design to be viewed in a particular orientation] of inventors Leong et al. is not supported by evidence.” *Office Action*, page 5. However, when Figure 1 of Leong is viewed as a whole, it is clear that the orientation of the design is, in fact, intentional. Portions of Figure 1 of Leong indicate that there is a specific orientation for the graphical user interface (a top and a bottom portion). Figure 1 of Leong has been reproduced below and annotated.



As shown above, when viewing Leong, Figure 1 in its entirety, the design does indeed have a particular orientation. If Leong's Figure 1 was rotated, the microphone,

location, car, train/bus, fast food, coffee, and bar icons would be upside down, which would include upside down cars, upside down coffee cups, etc. These icons are intended to be viewed in a certain orientation, and therefore, the graphical user interface of Figure 1 of Leong, as a whole, is intended to be viewed in a particular orientation. Thus, it is inappropriate to rotate the graphical user interface of Figure 1 of Leong as described by the Examiner, as there is no suggestion to modify Leong in this way.

Since there is no reason to rotate Figure 1 of Leong, the obviousness rejection is improper and should be withdrawn.

3. The Examiner's "Created Leong" is not prior art.

Assuming for the sake of argument that it is proper to consider only a portion of Figure 1 of Leong, and to both rotate and truncate Figure 1 of Leong, the resulting reference created by the Examiner ("Created Leong") is not prior art because it was not "something in existence" prior to the effective filing date of the claimed design.

When evaluating whether a claimed design is obvious, the claimed design as a whole must be compared with **something in existence**. MPEP § 1504.03(II) (citing *In re Jennings*, 182 F.2d 207 (C.C.P.A. 1950)) (emphasis added). That is, the claimed design must be "compared with something in existence—**not with something that might be brought into existence by selecting individual features** from prior art and combining them, particularly where combining them would require modification of every individual feature." *In re Jennings*, 182 F.2d at 207, 208 (emphasis added).

Here, by rotating and truncating portions of Figure 1 of Leong, the Examiner has **created** a reference, rather than using "something in existence" to reject the claimed design. "Created Leong" as applied is not prior art because it did not exist prior to the effective filing date of the claimed design, but instead was created by the Examiner for the sole purpose of rejecting the claimed design.

Since the Examiner's "Created Leong" is not prior art, the obviousness rejection is improper and should be withdrawn for this reason alone.

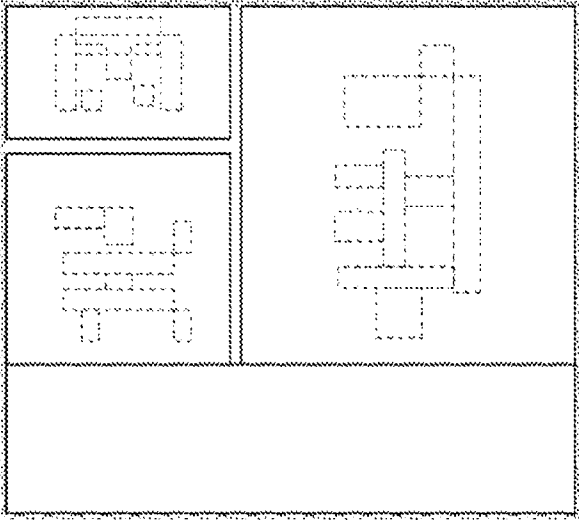
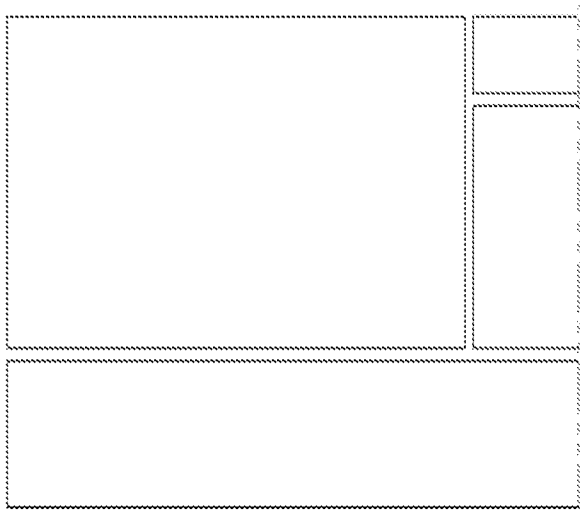
4. Even if the Examiner’s “Created Leong” is prior art and its creation is proper, Created Leong is not “basically the same” as the claimed design.

Assuming *arguendo* that Created Leong was prior art (a point not conceded by the Applicant), Created Leong is still not “basically the same” as the claimed design.

To determine a proper primary reference, one, using the viewpoint of the designer of ordinary skill in the art, must: “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.” *Durling v. Spectrum Furniture Co. Inc.*, 101 F. 3d 100, 103 (Fed. Cir. 1996) and *In re Rosen*, 673 F. 2d 388, 391 (CCPA 1982).

In order for Created Leong to be a proper primary reference, Created Leong must be a reference in existence that “the ***design characteristics of which are basically the same as the claimed design.***” *In re Rosen*, 673 F.2d 388, 391 (emphasis added). However, Created Leong does not create the same visual impression as the claimed design, nor is it basically the same as the claimed design. In fact, the Examiner concedes “[t]he Leong et al. graphical user interface does not show the small space between the elongated rectangle and the other two rectangles aligned along one edge.” *Office Action*, page 3. In rejecting the claimed subject matter, the Examiner states that the “Gilra et al. patent shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge.” *Office Action*, page 4. The Examiner further asserts that the “two smallest rectangles [being] shown on the right or left side is a de minimis difference.” *Id.*

A comparison of Created Leong and the claimed design is reproduced below to show the differences therebetween:

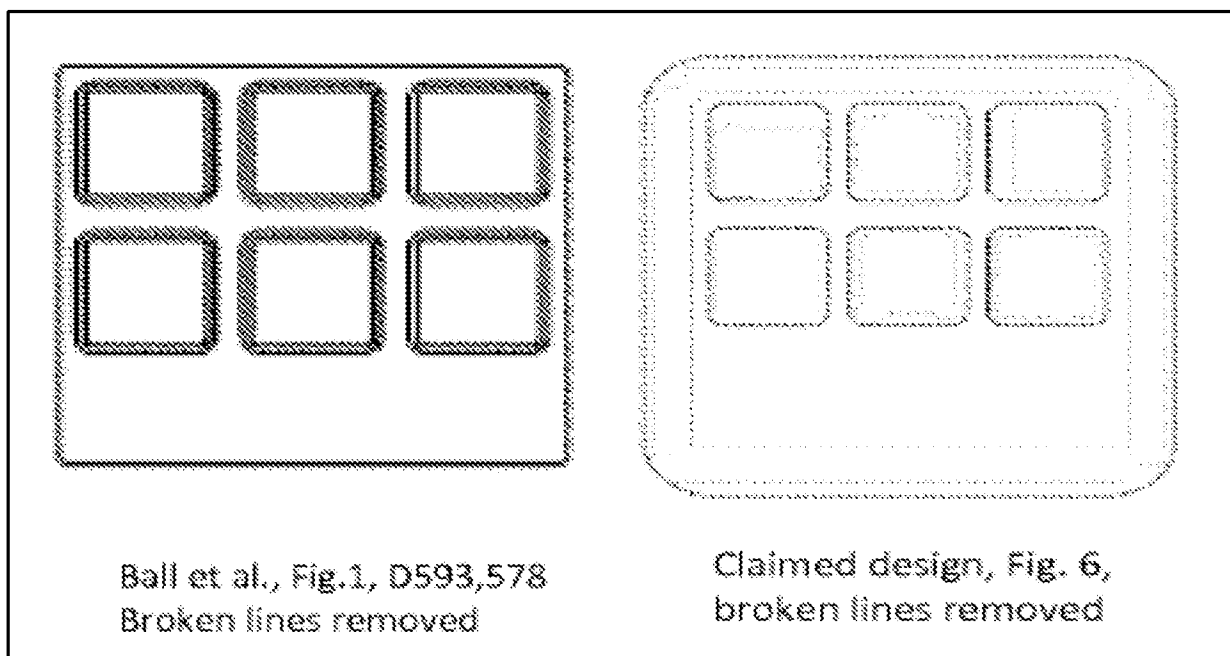
Examiner's Created Leong	Pending Claimed Design
 <p>The diagram shows a rectangular frame divided into three sections. The top-left section is a small square containing a stylized pattern of horizontal and vertical lines. The middle-left section is a rectangle containing a similar stylized pattern. The right section is a large rectangle containing a stylized pattern of horizontal and vertical lines, with a small square at the top right.</p>	 <p>The diagram shows a rectangular frame divided into three sections. The top-left section is a large rectangle containing a stylized pattern of horizontal and vertical lines. The middle-right section is a small square containing a stylized pattern of horizontal and vertical lines. The bottom section is a large rectangle containing a stylized pattern of horizontal and vertical lines.</p>

As shown above, Created Leong and the claimed design are not “basically the same.” The boxes have differing proportions. The top left box of Created Leong has a larger height than the claimed design’s upper-right portion, and the middle-left box of Created Leong has a smaller height than the claimed design’s middle portion. Therefore, even after truncating the Leong reference, after rotating the Leong reference, after the addition of Gilra as a secondary reference to add a space above the bottom box, Created Leong still creates an overall visual impression that is different from the claimed design, such that the two designs are not basically the same.

Since Created Leong is not “basically the same” as the claimed design, Created Leong cannot be considered a primary reference in a rejection under 35 U.S.C. §103.

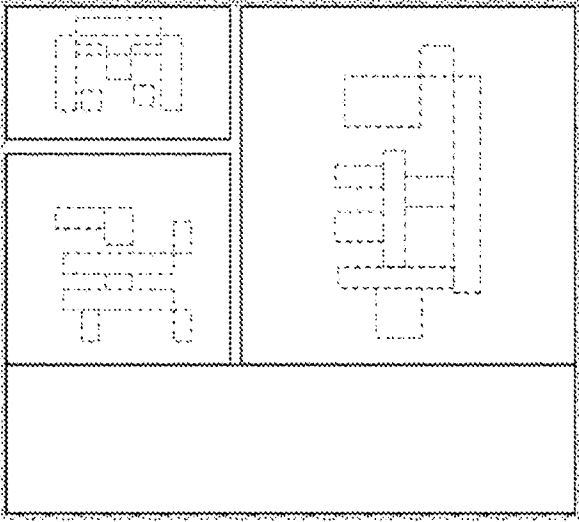
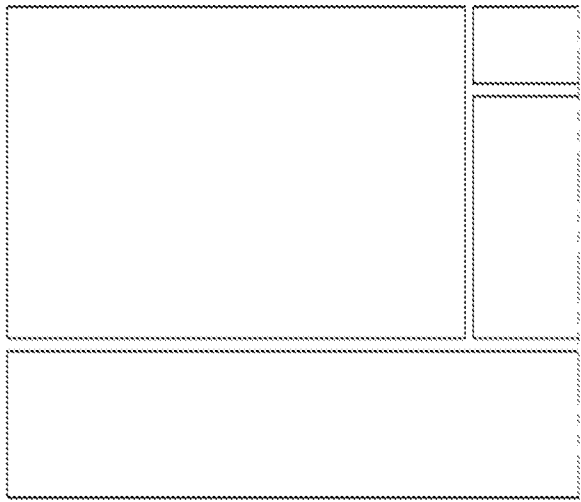
Additionally, the standard for “basically the same” from the viewpoint of an ordinary designer is a **difficult and high** standard to meet. This high standard was considered by the Patent Trial and Appeal Board (PTAB) in *Ex parte Chaudhri et al.*, No. 2018-001766 (PTAB Dec. 19, 2019), in an appeal challenging the rejection of a pending design claim for a display screen. The Appellant asserted that: “[t]he differences in shape and

orientation between the applied references underscore Appellant's position that designers not only appreciate the visual differences . . . [but also] they use those differences in creating their designs." *Id.* at 5. Below is a chart comparing the claimed design in *Ex parte Chaudhri* to the reference applied to reject the claimed design, namely Figure 1 of U.S. Patent No. D593,578 to Ball et al. ("Ball"):



The PTAB found that while the above two designs were similar, they did **not** meet the high standard of "basically the same." Indeed, the PTAB stated that "[m]inor points of difference, however, can play a greater role in differentiating simple designs" and reversed the rejection in favor of the Appellant, stating that the Examiner had "**not** established that Ball is a proper primary reference." *Id.* at 5-6 (emphasis added).

While *Ex parte Chaudhri* is not a precedential decision, this decision does demonstrate the difficulty of satisfying the **high standard** of "basically the same," further informing the comparison between the present claimed design and Created Leong: if the PTAB found that Ball does not meet the high standard of "basically the same" as the design shown immediately to the right of Ball, Created Leong cannot be "basically the same" as the pending claimed design, as again shown below:

Examiner's Created Leong	Pending Claimed Design
	

Even assuming *arguendo* that the truncation and rotation of Figure 1 of Leong was proper to create “Created Leong,” and even assuming *arguendo* that Created Leong is prior art, for the aforementioned reasons Created Leong still does not meet the high standard of “basically the same” to be considered a proper primary reference with respect to the pending claimed design. Therefore, the obviousness rejection is improper and should be withdrawn for this reason alone.

For all the foregoing reasons, it is respectfully requested that the rejection of the pending design claim under 35 U.S.C. §103 over Leong in view of Gilra be reconsidered and withdrawn, as no *prima facie* case of obviousness exists in the record as to the claim.

B. Conclusion

It is believed that all matters set forth in the Office Action mailed April 6, 2022 have been addressed.

A Notice of Allowance is respectfully requested.

The Examiner is invited to call the undersigned attorney at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

/Alan N. Herda/

Alan N. Herda
Registration No. 50,426

Date: June 2, 2022
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IP Section
2323 Victory Avenue
Suite 700
Dallas, Texas 75219
Telephone: 214-651-5924
IP Facsimile: 214-200-0853

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Lauren L. Argo et al.	§	Group Art Unit: 2917
	§	
Application No.: 29/732,483	§	Examiner: Melanie H. Tung
	§	
Filed: April 24, 2020	§	Confirmation No.: 5266
	§	
For: DISPLAY SCREEN OR PORTION	§	Docket No.:
THEROF WITH GRAPHICAL	§	P06170-US-CON (70228.745US02)
USER INTERFACE	§	

RESPONSE TO OFFICE ACTION MAILED APRIL 6, 2022

I. Introductory Comments

This document is submitted in response to the Office Action mailed April 6, 2022.

No fees, including extension-of-time fees, are believed necessary for consideration of this document. However, if any additional fees, including any additional extension-of-time fees, are necessary, the Commissioner is hereby authorized to charge such fees, including any additional extension-of-time fees, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

Remarks begin on page 2 of this document.



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	70228.745US02	5266

160596 7590 04/06/2022
HAYNES AND BOONE, LLP (70228)
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

EXAMINER

TUNG, MELANIE H

ART UNIT	PAPER NUMBER
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2917

NOTIFICATION DATE	DELIVERY MODE
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04/06/2022

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):

ipdocketing@haynesboone.com
patent.group@intusurg.com

Office Action Summary	Application No. 29/732,483	Applicant(s) Argo et al.	
	Examiner Melanie H Tung	Art Unit 2917	AIA (FITF) 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 12/21/21.
☐ 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) finally 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 PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 4/24/20 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:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ 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: ____.

Notice of Pre-AIA or AIA Status

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

The response received December 21, 2021 is acknowledged.

The amendments to the specification are acceptable.

Final Rejection under 35 U.S.C. 103

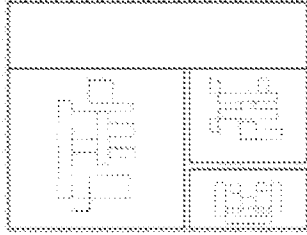
The claim is again and FINALLY REJECTED under 35 U.S.C. 103 as being unpatentable over Leong et al. in view of Gilra et al.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

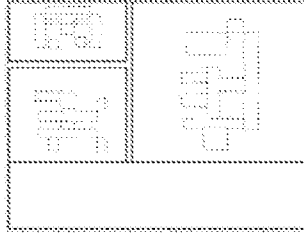
The primary reference has design characteristics which are basically the same as the claimed design -- an elongated rectangle, a shorter and taller rectangle, and two smaller rectangles (one smaller than the other) aligned on one side. Leong et al. is rotated 180 degrees.



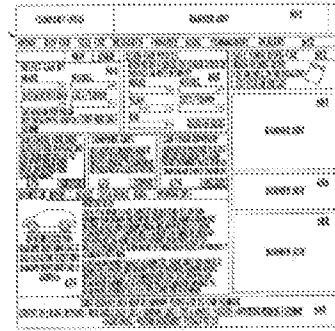
Claimed design



Leong et al., Fig 1



Leong et al., Fig 1, rotated 180 degrees



Gilra et al., Fig 6

The Leong et al. graphical user interface does not show the small space between the elongated rectangle and the other two rectangles aligned along one long edge. The Gilra et al. patent shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge. Whether the two smallest rectangles are shown on the right or left side is a de minimis difference and well within the knowledge of one skilled in the art.

It would have been obvious to a designer of ordinary skill not later than the effective filing date of the present claimed invention to have modified the Leong et al. graphical user interface by providing a small space between the elongated rectangle and the two rectangles that are aligned with one long edge as shown by the Gilra et al. patent to meet the overall appearance of the claimed design.

The claimed design would have no patentable distinction over the examiner's combination of references.

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features

shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that a designer skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 35 U.S.C. 103 should be withdrawn.

- 1) Since Leong is not basically the same as the claimed design, it is not an appropriate primary reference.

Applicant asserts that the Leong elongated rectangle is above three rectangles rather than below three rectangles shown in the claimed design. This argument is not persuasive because when Leong is rotated 180 degrees, it shows the elongated rectangle above the large, medium and small rectangles. Leong shows characteristics that are basically the same as the claimed design - an elongated rectangle, a shorter and taller rectangle, and two smaller rectangles (one smaller than the other) aligned on one side. These characteristics constitute the overall visual appearance. Merely viewing Leong turned 180 degrees is inherent to one of ordinary skill in the art.

2) No reason is provided to rotate the Leong, the primary reference

Applicant asserts that no reason is provided why Leong would be rotated 180 degrees. This argument is not persuasive because viewing an image rotated is inherent to one of ordinary skill. All word processing, computer aided design, photo imaging programs contain tools to rotate an image. In addition, any image on physical media, such as paper, can be viewed upside down. If a printed patent was placed on a surface, such as a desk, a viewer easily could approach the surface and view the image upside down, depending on how the printed patent was placed on the table.

Furthermore, applicant asserts that the Leong graphical user interface matters and was created to be viewed from a particular orientation. This argument is not persuasive because the intention of inventors Leong et al. is not supported by evidence. The design patent document does not contain the inventor's intention; it shows the claimed design.

Applicant states that for many electronic devices, the graphical user interface automatically reorients if the screen is turned. This supports that a graphical user interface commonly is seen rotated.

No prohibition that a design cannot be viewed upside down or turned. For example, if a triangle shape is oriented on a piece of paper with the point upwards, the triangle shape can be viewed with the point downwards. This is easily envisioned by anyone viewing a triangle, or any other design. Furthermore, although applicant asserts that the examiner has created a reference, nothing is created by viewing an existing design from a different vantage point. A new reference has not been created.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie H. Tung whose telephone number is (571)272-2613. The examiner normally can be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susan Krakower, can be reached on (571)272-4496. 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://portal.uspto.gov/external/portal>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917
April 1, 2022

II. Amendments to the Specification

In the specification, please replace the description as originally filed with the following amended description:

FIG. 1 is a front view of a first embodiment of a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE showing our new design;

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

FIG. 3 is another front view of the second embodiment thereof, ~~but with broken lines omitted.~~ the broken line showing portions of the graphical user interface are omitted.

The outer and central even broken lines and the long-dash/short-dash/short-dash broken lines show a display screen or portion thereof and form no part of the claimed design.

The broken lines within the long-dash/short-dash/short-dash broken lines show portions of the graphical user interface that form no part of the claimed design.

~~The even broken lines and the long-dash/short-dash/short-dash broken lines outside of the graphical user interface in all views show a display screen and form no part of the claimed design.~~

~~The broken lines within the graphical user interface in Figs. 1 and 2 show portions of the graphical user interface that form no part of the claimed design.~~

III. Remarks

Consideration of this application in light of the above amendments and the following remarks is respectfully requested.

A. Objection to the Specification

The specification stands objected to because of a figure description and portions of the broken line statements.

In response, Applicant has amended the figure description and the broken line statements, in accordance with the Examiner's suggestions.

Therefore, the objection to the specification should be withdrawn.

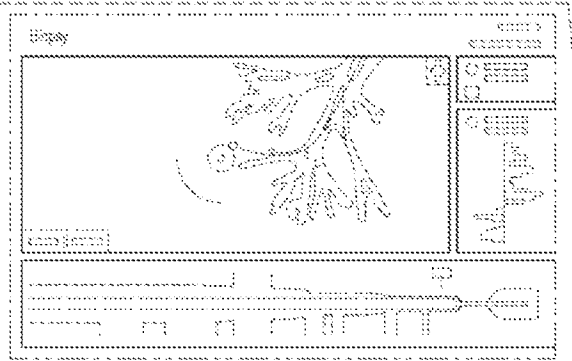
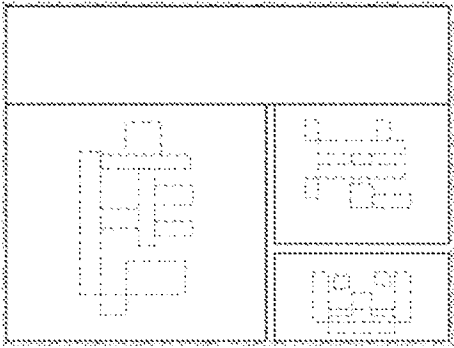
B. Rejection Under 35 U.S.C. §103

The claim stands rejected under 35 U.S.C § 103 over U.S. Patent No. D836,121 ("Leong") in view of U.S. Patent No. 8,438,495 ("Gilra"). This rejection is respectfully traversed.

(1) Leong is not basically the same as the claimed design, and therefore Leong is an inappropriate primary reference.

When evaluating whether a claimed design is obvious, the claimed design as a whole must be compared with something in existence. MPEP § 1504.03(II) (citing *In re Jennings*, 182 F.2d 207 (C.C.P.A. 1950)). This "**something in existence**" is "a reference ... the **design characteristics of which are basically the same as the claimed design.**" *In re Rosen*, 673 F.2d 388, 391 (emphasis added). If the design characteristics of the reference are not basically the same as the claimed design, then the reference is not an appropriate primary reference. Without such a primary reference, "no holding of obviousness ... can be made, whether based on a single reference alone or in view of modifications suggested by secondary prior art." MPEP §1504.03(II).

Here, the Examiner states that the “primary reference [Leong] has design characteristics which are basically the same as the claimed design – an elongated rectangle, a shorter and a taller rectangle, and two smaller rectangles aligned on one side.” *Office Action*, page 4. The chart below compares the claimed design and Leong.

Claimed Design	Leong, FIG. 1
	

The above comparison shows that the design characteristics of Leong are **not** basically the same as those of the claimed design.

In this regard, MPEP § 1504.03 (II) provides that “it is clear that ‘design characteristics’ means overall visual appearance.” (emphasis in original).

The overall visual appearance of Leong is not basically the same as the claimed design. For example, Leong’s elongated rectangle is **above** three rectangles, rather than **below** three rectangles as shown in the claimed design. Therefore, Leong has an overall visual appearance that is different from the claimed design and thus Leong is an inappropriate primary reference.

Additionally, the inadequacy of Leong as a primary reference is evidenced by the fact that the Examiner rotates the reference to try to make Leong resemble the claimed design – this rotation is further discussed in Section B(2) below.

Thus, Leong does not meet the necessary standards to be considered a primary reference in a rejection under 35 U.S.C. §103 against the pending claim.

(2) Assuming arguendo that the claimed design and primary reference Leong are basically the same, no reason is given to rotate the primary reference.

MPEP § 2143 provides that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” (emphasis added).

Here, in order to try to make Leong resemble the claimed design, the Examiner states that “Leong et al. is rotated 180 degrees.” *Office Action*, page 4. However, there is no clear articulation of the reason why Leong is rotated 180 degrees.

Since no reason is given to rotate the primary reference, the rejection of the pending claim under 35 U.S.C. §103 is improper.

Even if a reason for rotation was given, the MPEP provides that a cited art reference must be considered in its entirety for all that it teaches, and a “*prima facie* case of obviousness can be rebutted if the applicant ... can show that the art in any material respect ‘taught away’ from the claimed invention.” See MPEP § 2141.02 and § 1504.03 (citing *In re Haruna*, 249 F.3d 1327 (Fed. Cir. 2001)). Here, the orientation of the Leong GUI matters. The designer of Leong created their GUI design to be viewed in a particular orientation. For many electronic device screens, it is common for a GUI design to be automatically reoriented if the screen on which the GUI design is displayed is turned, thereby keeping the orientation of the GUI design the same. Therefore, it is inappropriate to rotate the Leong GUI as described by the Examiner, as there is no suggestion to modify Leong in this way, nor does the Examiner allege such a suggestion.

By rotating Leong, which is a GUI design, the Examiner has created a reference (“Rotated Leong”) rather than using “something in existence.” Rotated Leong is not prior art because it did not exist prior to Applicant’s filing date, but instead was created by the Examiner.

For at least the foregoing reasons, it is respectfully requested that the rejection of the pending claim under 35 U.S.C. § 103 over Leong in view of Gilra be reconsidered and withdrawn, as no *prima facie* case of obviousness exists in the record as to the claim.

C. Conclusion

In view of the foregoing amendments and remarks, it is believed that all matters set forth in the Office Action mailed September 30, 2021 have been addressed.

A Notice of Allowance is respectfully requested.

The Examiner is invited to call the undersigned attorney at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

/Alan N. Herda/

Alan N. Herda
Registration No. 50,426

Date: December 21, 2021
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Suite 700
Dallas, Texas 75219
Telephone: 214-651-5924
IP Facsimile: 214-200-0853

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Lauren L. Argo et al.	§	Group Art Unit: 2917
	§	
Application No.: 29/732,483	§	Examiner: Melanie H. Tung
	§	
Filed: April 24, 2020	§	Confirmation No.: 5266
	§	
For: DISPLAY SCREEN OR PORTION	§	Docket No.:
THEROF WITH GRAPHICAL	§	P01290-US-CON (70228.745US02)
USER INTERFACE	§	

AMENDMENT IN RESPONSE TO OFFICE ACTION MAILED SEPTEMBER 30, 2021

I. Introductory Comments

This document is submitted in response to the Office Action mailed September 30, 2021. No fees, including extension-of-time fees, are believed necessary for consideration of this document. However, if any additional fees, including any additional extension-of-time fees, are necessary, the Commissioner is hereby authorized to charge such fees, including any additional extension-of-time fees, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

Amendments to the Specification begin on page 2 of this document.

Remarks begin on page 3 of this document.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/732,483	04/24/2020	Lauren L. Argo	P01290-US-CON	5266
160596	7590	09/30/2021		
HAYNES AND BOONE, LLP (70228)			EXAMINER	
IP Section			TUNG, MELANIE H	
2323 Victory Avenue				
Suite 700			ART UNIT	
Dallas, TX 75219			2917	
			PAPER NUMBER	
			2917	
			NOTIFICATION DATE	
			09/30/2021	
			DELIVERY MODE	
			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):

ipdocketing@haynesboone.com
patent.group@intusurg.com

Notice of Pre-AIA or AIA Status

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

Incorporation by Reference

This application incorporates by reference US design patent application 29/665,540. All the material from the design application that is essential to the claimed design is included in this application. Amendments of the claim may be based on the content of the incorporated material. However, with or without a specific amendment, it is understood that any material in the design application that is not present in this application forms no part of the claimed design.

Multiple Embodiments

This application discloses the following embodiments:

Embodiment 1 – Fig. 1

Embodiment 2 – Figs. 2 and 3

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the above identified embodiments.

Specification

Since Fig.3 shows broken lines, the figure description must be amended to read:

-- FIG.3 is a another front view of the second embodiment thereof, the broken line showing of portions of the graphical user interface are omitted. --

For a clear description of the article of manufacture, the first sentence of the broken line description must be amended to read:

-- The outer and central even broken lines and the long-dash/short-dash/short-dash broken lines show a display screen or portion thereof and form no part of the claimed design. --

For a clear description of the broken lines that show portions of the graphical user interface, the second special description must be amended to read:

-- The broken lines within the long-dash/short-dash/short-dash broken lines show portions of the graphical user interface that form no part of the claimed design. --

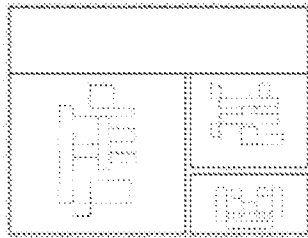
Correction is required. 37 C.F.R. § 1.121.

Rejection under 35 U.S.C. 103

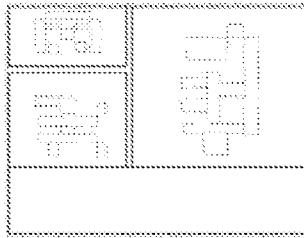
The claim is rejected under 35 U.S.C. 103 as being unpatentable over Leong et al. in view of Gilra et al.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a designer having ordinary skill in the art to which the claimed invention pertains, the invention is not patentable.

The primary reference has design characteristics which are basically the same as the claimed design -- an elongated rectangle, a shorter and taller rectangle, and two smaller rectangles aligned on one side. Leong et al. is rotated 180 degrees.



Leong et al., Fig 1



Leong et al., Fig 1, rotated 180 degrees



Gilra et al., Fig 6

The Leong et al. graphical user interface does not show the small space between the elongated rectangle and the other two rectangles aligned along one long edge. The Gilra et al. patent shows a small space between the elongated rectangle and the other two rectangles aligned along one long edge. Whether the two smallest rectangles are shown on the right or left side is a de minimis difference and well within the knowledge of one skilled in the art.

It would have been obvious to a designer of ordinary skill not later than the effective filing date of the present claimed invention to have modified the Leong et al. graphical user interface by providing a small space between the elongated rectangle and the two rectangles that are aligned with one long edge as shown by the Gilra et al. patent to meet the overall appearance of the claimed design.

The claimed design would have no patentable distinction over the examiner's combination of references.

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re*

Rosen, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956).

Further, it is noted that case law has held that a designer skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

Conclusion

The claim is rejected under 35 U.S.C. 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie H. Tung whose telephone number is (571)272-2613. The examiner normally can be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susan Krakower, can be reached on (571)272-4496. 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://portal.uspto.gov/external/portal>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MELANIE H TUNG/
Primary Examiner, Art Unit 2917
September 26, 2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Lauren Argo, Cristian Bianchi, and Jason LaFrenais request that a Design Letters Patent be granted for the new and original design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE as set forth in the following specification.

Specification

We, Lauren Argo, Cristian Bianchi, and Jason LaFrenais, have invented a new, original design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE, of which the following is a specification, reference being made to the accompanying drawings forming a part hereof.

Cross Reference to Related Applications

This application is a continuation of U.S. Patent Application No. 29/665,540, filed October 4, 2018 bearing Attorney Docket No. ISRG13450/US (70228.745US01), the entire disclosure of which is hereby incorporated herein by reference.

This application is related to U.S. Patent Application No. _____, filed _____ bearing Attorney Docket No. P01290-US-CON2 (70228.745US03).

Description

FIG. 1 is a front view of a first embodiment of a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE showing our new design;

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

FIG. 3 is a front view of the second embodiment thereof, but with broken lines omitted.

The even broken lines and the long-dash/short-dash/short-dash broken lines outside of the graphical user interface in all views show a display screen and form no part of the claimed design.

The broken lines within the graphical user interface in Figs. 1 and 2 show portions of the graphical user interface that form no part of the claimed design.

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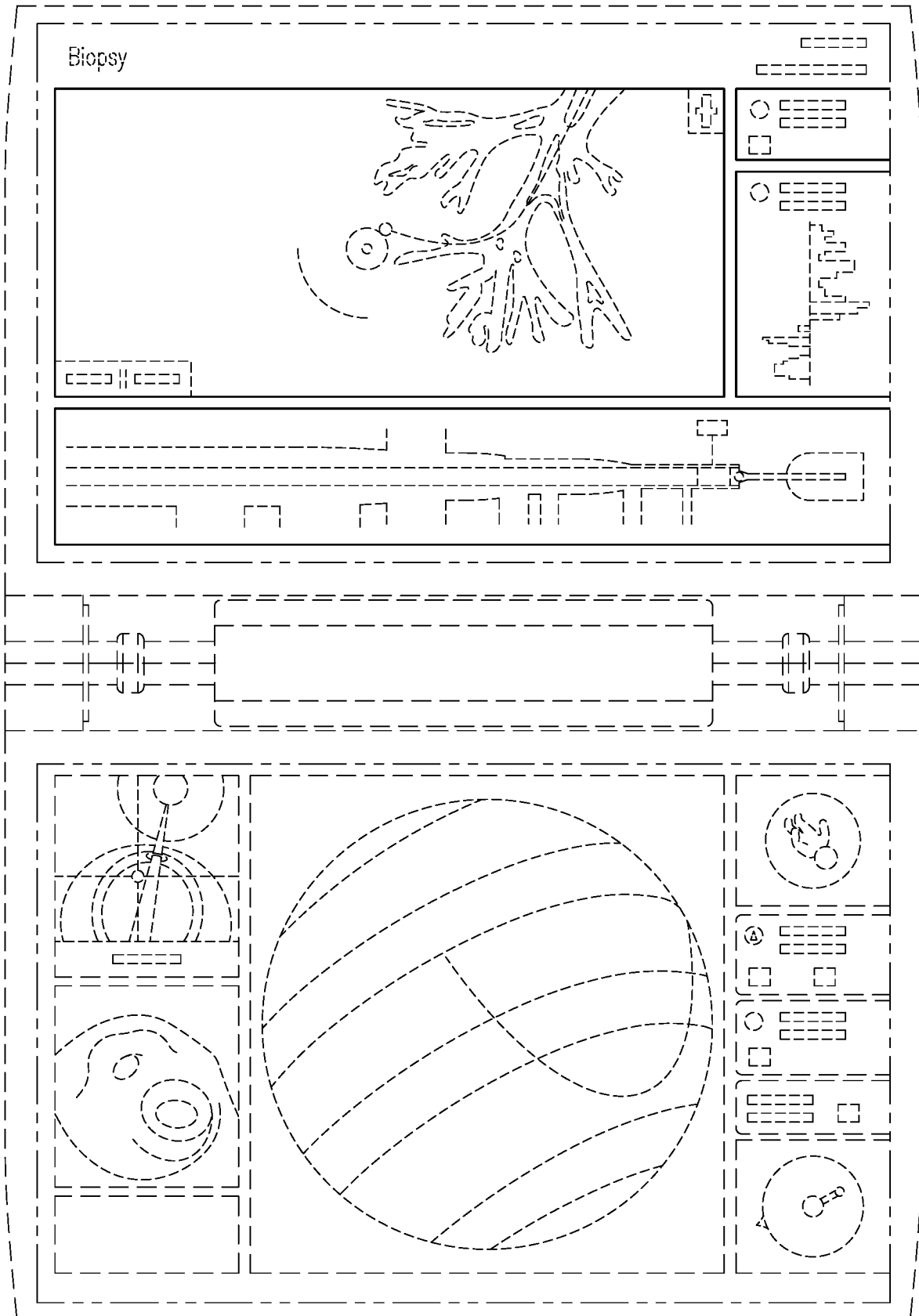


Fig. 1

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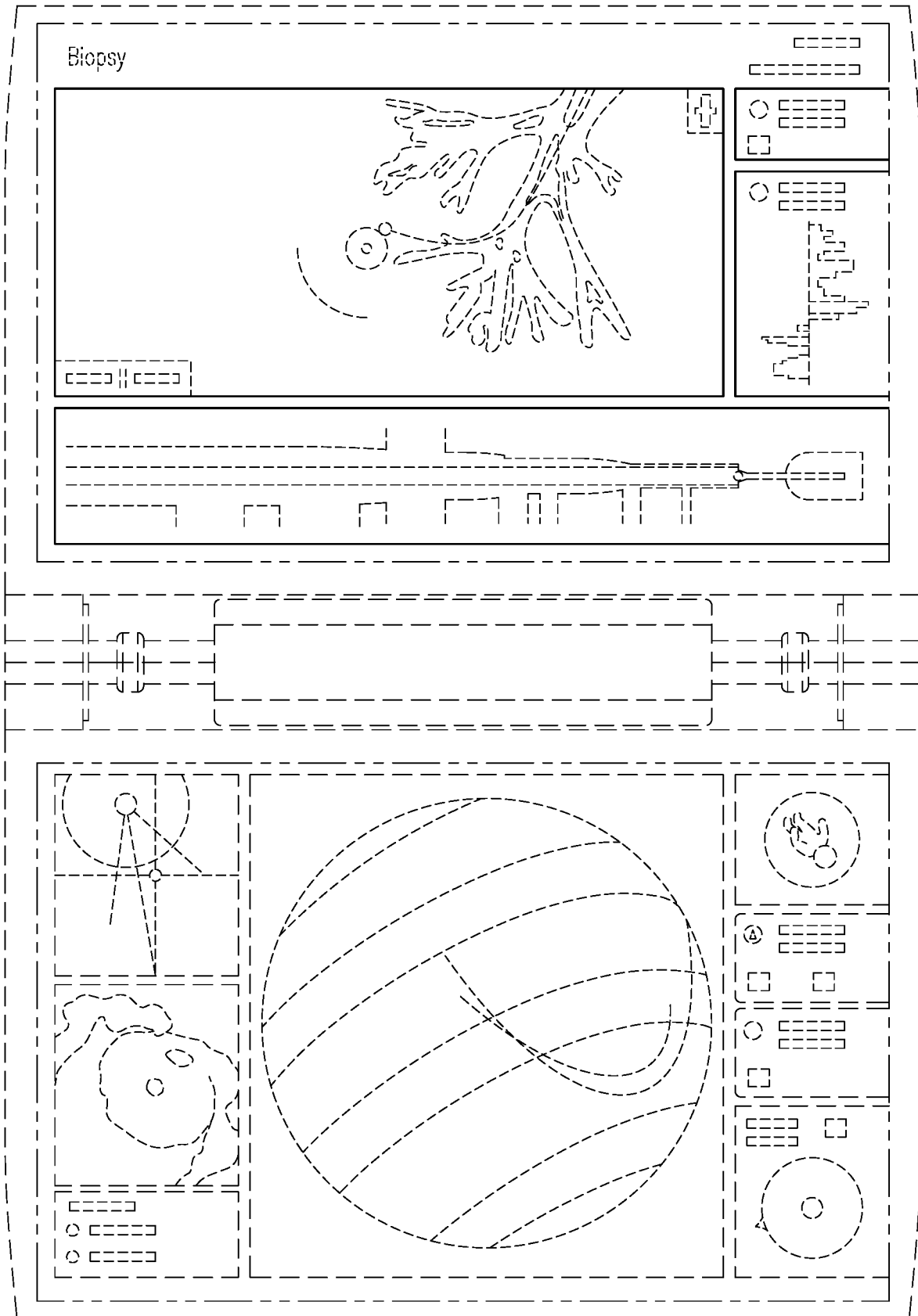


Fig. 2

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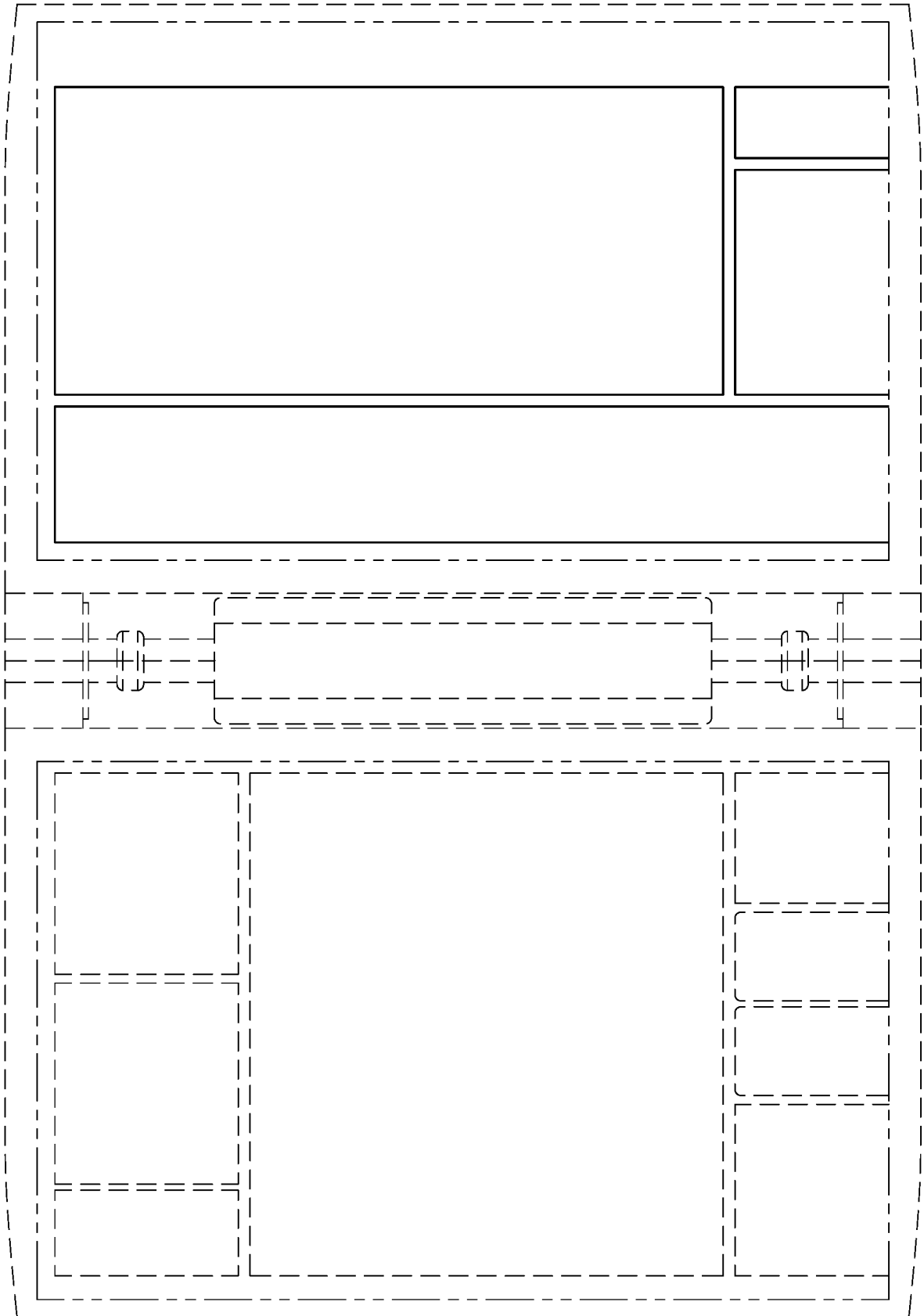


Fig. 3

What is claimed is:

The ornamental design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE as shown and described.