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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/798,750	07/09/2021	Xi CHEN	1612.881	7527

26396 7590 06/24/2025
SAIDMAN DESIGNLAW GROUP
George D. Raynal
6116 Executive Boulevard
SUITE 350
North Bethesda, MD 20852

EXAMINER

VINE, ANA MARIA

ART UNIT	PAPER NUMBER
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2913

NOTIFICATION DATE	DELIVERY MODE
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06/24/2025

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):

ptomail@designlawgroup.com



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APPLICATION NO.	ISSUE DATE	PATENT NO.
29/798,750	24-Jun-2025	D1080640

SAIDMAN DESIGNLAW GROUP
George D. Raynal
6116 Executive Boulevard
North Bethesda, MD 20852

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 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.

26396 7590 03/12/2025
SAIDMAN DESIGNLAW GROUP
George D. Raynal
6116 Executive Boulevard
SUITE 350
North Bethesda, MD 20852

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.

via Patent Center (Typed or printed name)
(Signature)
May 19, 2025 (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/798,750	07/09/2021	XI CHEN	1612.881	7527

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	06/12/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
VINE, ANA MARIA	2913	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 Saidman DesignLaw Group, LLC

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)

TOYOTA JIDOSHA KABUSHIKI KAISHA

Toyota-shi, Japan

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. 19-0031

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 /Meera Kamath #70301/

Date May 19, 2025

Typed or printed name Meera Kamath

Registration No. 70,301



UNITED STATES PATENT AND TRADEMARK OFFICE

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NOTICE OF ALLOWANCE AND FEE(S) DUE

26396 7590 03/12/2025
SAIDMAN DESIGNLAW GROUP
George D. Raynal
6116 Executive Boulevard
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North Bethesda, MD 20852

EXAMINER

VINE, ANA MARIA

ART UNIT

PAPER NUMBER

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DATE MAILED: 03/12/2025

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nonprovisional	UNDISCOUNTED	\$1300	\$0.00	\$0.00	\$1300	06/12/2025

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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North Bethesda, MD 20852

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

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

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Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/798,750	07/09/2021	Xi CHEN	1612.881	7527
26396	7590	03/12/2025	EXAMINER	
SAIDMAN DESIGNLAW GROUP			VINE, ANA MARIA	
George D. Raynal			ART UNIT	
6116 Executive Boulevard			PAPER NUMBER	
SUITE 350			2913	
North Bethesda, MD 20852			DATE MAILED: 03/12/2025	

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. 29/798,750	Applicant(s) CHEN et al.	
	Examiner Ana M Vine	Art Unit 2913	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 Patent Board Decision filed 21 February 2025 .
☐ 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 09 July 2021 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:
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)).
- * 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. ☒ Notice of References Cited (PTO-892) | 4. ☒ Examiner's Amendment/Comment |
| 2. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Receipt Date ____ | 5. ☐ Examiner's Statement of Reasons for Allowance |
| 3. ☐ Interview Summary (PTO-413),
Paper No./Mail Date ____ | 6. ☐ Other ____ . |

NOTE: ____

/A.M.V./
Examiner, Art Unit 2913

/RACHEL A. VOORHIES/
Primary Examiner, Art Unit 2923

NOTICE OF ALLOWABILITY

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.

Examiner's Comment

In view of the Patent Trial and Appeal Board decision submitted February 21, 2025, the rejection under 35 U.S.C. 103 is withdrawn.

Conclusion

This application is in condition for allowance. The prior art made of record and not relied upon is considered pertinent to the appearance of the claimed design. The claimed design is patentable over the references cited.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M. Vine whose telephone number is (571)272-1348. The examiner can normally be reached Monday-Thursday, 6 a.m.-4 p.m. ET.

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>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amber Stiles can be reached on (571) 272-7611. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A.M.V./
Examiner, Art Unit 2913

/RACHEL A. VOORHIES/
Primary Examiner, Art Unit 2923



UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XI CHEN and KOHEI MOROTOMI

Appeal 2024-000640
Application 29/798,750
Technology Center 2900

Before DANIEL S. SONG, GRACE KARAFFA OBERMANN, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

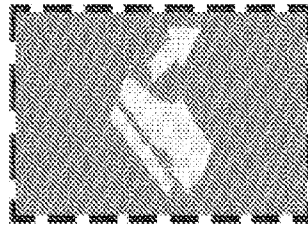
Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner's decision to reject the claimed design. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ “Appellant” refers to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Toyota Jidosha Kabushiki Kaisha. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claimed design is directed to a “DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE.” Appeal Br. 3. The sole figure of the claimed design is reproduced below:



The above figure depicts a shaded rectangular box with its boundary in dashed lines and, within the box, a lightened depiction of an outline of a shoe slightly above a narrow rectangle that is angled upwardly to the left and a slightly curved arrow above the toe of the shoe, the arrow pointing diagonally upward and toward the right.

REFERENCES

The Examiner relies on the following references to reject the claims:

Name	Reference	Date
Mazda	Mazda 6 Owners Manual: Electric Parking Brake (https://www.mazda6info.net/electric_parking_brake-216.html)	Dec. 18, 2016
Cadillac	Cadillac Escalade: Adjustable Throttle and Brake Pedal (https://www.fsuvs.com/adjustable_throttle_and_brake_pedal-966.html)	Oct. 30, 2020
Black Arrows	“Black arrows. Curved signs stock illustration” (https://www.istockphoto.com/vector/black-arrows-curved-signs-gm1050385984-280873451?phrase=curved arrow)	Sept. 1, 2022

REJECTION

The Examiner maintains the following rejections:

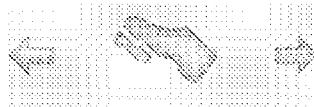
Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis
1	103	Cadillac, Mazda, Black Arrows
1	103	Mazda, Cadillac, Black Arrows

OPINION

The Examiner rejects the claimed design under 35 U.S.C. § 103 as unpatentable finding that:

The design of Cadillac has basically the same design characteristics as the claimed design, in that both designs disclose a similar shaped shoe, a thick line of similar weight underneath the shoe, a gap between the shoe and the thick line of similar weight, and a rightward pointing arrow to the right of the shoe.

Final Act. 2–3. The Examiner determines that “[t]he claimed design is different from the design of Cadillac in that the arrow is curved and arranged diagonally above the shoe, and the thick line below the shoe is slightly more elongated.” Final Act. 3. The relevant portion of Cadillac is reproduced below:



The portion of Cadillac reproduced above shows a shoe with a shaded rectangular box and, within the box, a darker shaded depiction of a shoe slightly above a narrow rectangle that is angled upwardly to the left, one horizontal arrow pointing toward the right, and one horizontal arrow pointing toward the left.

The Examiner also makes similar findings with respect to Mazda, determining that in Mazda, “one arrow [is] arranged above the toe portion of

the shoe” and that “[t]he claimed design is different from the design of Mazda in that the pedal does not have an intersecting line and the arrow is slightly curved and points away from the icon.” Final Act. 3. The relevant portion of Mazda is reproduced below:



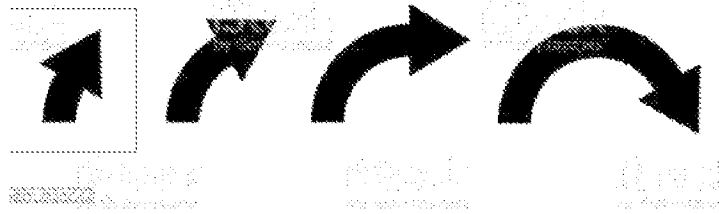
The portion of Mazda reproduced above shows a shoe slightly above an angled T-shaped design, and one arrow pointing downwardly at a slight angle near toward the toe of the shoe.

The Examiner relies on Black Arrows for disclosing “a rounded arrow pointing away” and concludes that:

It would have been obvious to modify Cadillac by elongating the pedal and placing the arrow above the toe box of the shoe, as seen in Mazda, or to modify Mazda by using the shoe icon seen in Cadillac, and by pointing the arrow away and rounding it, as taught by Black Arrows.

Final Act. 3–4.² According to the Examiner, Black Arrows is “so related in that it shows a range of arrow icon types” and “[t]he differences between the claimed design and the prior art are such that the claimed design as a whole would have been obvious.” Final Act. 4. The relevant portion of Black Arrows is reproduced below:

² Hence it is clear that the Examiner applies two different rejections to the claimed design, namely: (1) Cadillac in view of Mazda and Black Arrows, and (2) Mazda in view of Cadillac and Black Arrows. Final Act. 4.



The portion of Black Arrows reproduced above shows four different arrows that are arched to the right and are of different lengths, the left-most arrow being short and generally pointing upward while the right-most arrow being long and forming a semi-circle.

The Appellant argues that Cadillac is not a proper *Rosen* reference because in Cadillac: there are only straight arrows pointed to the left and right at the left and right sides; there is no curved arrow leading away from the shoe toe; the pedal is substantially less long; the shoe toe and heel portions are different than in the claimed design; elements have an outer darker outline than the inner gradient shading that fades in the center; and has a light background instead of a dark background as in the claimed design. Appeal Br. 13. The Examiner disagrees and responds that both the claimed design and Cadillac disclose, *inter alia*, “a rightward pointing arrow” and that “taken as a whole, Cadillac is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design.” Ans. 4.

The Appellant also argues that Mazda is not a proper *Rosen* reference because in Mazda: the straight arrow points downward into the shoe toe; the line below the shoe does not extend as far toward the heel; there is a perpendicular lower line opposite the downwardly pointing arrow; shoe toe and heel portions are shaped differently; and all elements are solid black on a white background instead of a dark background as in the claimed design.

Appeal Br. 14. The Examiner again disagrees and responds that the claimed design and Mazda are similar and that “[t]he presence of an intersecting line underneath the pedal does not disqualify Mazda as a primary reference.”

Ans. 6.

As evident from the above, the Examiner’s rejection and the Appellant’s arguments are generally based on the obviousness analysis as set forth in *In re Rosen* and its progeny, i.e., are based on the *Rosen-Durling* test. *In re Rosen*, 673 F.2d 388 (CCPA 1982); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996). However, subsequent to the rejection and briefing in the present appeal, the Federal Circuit held that the *Rosen-Durling* test for evaluating obviousness in designs was too rigid, and that obviousness should be analyzed applying the framework set forth in *Graham v. John Deere Co. LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280, 1292–95 (Fed. Cir. 2024) (en banc) (citing *Graham v. Deere*, 383 U.S. 1 (1966)). Thus, the new framework as articulated in *LKQ* applies in the present 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.* For the reasons discussed below, we find the Examiner’s rejections insufficient to support the conclusion of obviousness.

Cadillac in view of Mazda and Black Arrow

To adequately support the rejection, the Examiner must provide “some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified” the design of Cadillac to provide a slightly curved arrow above the toe of the shoe, the arrow pointing diagonally upward and toward the right. *LKQ*, 102 F.4th at 1299. As the Appellant points out, Cadillac merely “includes left and right arrows,” and we observe that both of these arrows are horizontally oriented. Reply Br. 19. In addition, as the Appellant further argues, Mazda’s arrow points downward in an opposite direction as the claimed design. Reply Br. 18.

The Examiner explains that “Cadillac already shows the rightward arrow pointing away from the shoe so when placed above the toe box, the arrow would still be pointing away similarly to the claimed design.” Ans. 7; *see also id.* at 8 (“Cadillac also shows having a straight arrow pointing away from the shoe. . . . The direction of the arrow, pointing away from the shoe, is additionally reinforced by the arrow pointing away from the shoe in Cadillac”). However, notwithstanding the fact that Cadillac’s arrow is spaced significantly away from the shoe such that its association with the

shoe (much less the toe) is attenuated, we disagree with the Examiner's apparent position that Cadillac's teaching of arrows pointing away from the shoe can be disassociated with the direction in which these arrows actually point, namely, in horizontal directions.

The Examiner has relied on Mazda for positioning an arrow at the toe of the shoe and relied on Black Arrows for disclosing a slightly curved arrow pointing diagonally upward and toward the right, and seemingly, also for disclosing an arrow that points "away." Final Act. 3. However, as the Appellant argues, "comparison of the claimed design to Mazda fails to describe the directional orientations of the arrows, in that the two designs depict the arrows in opposite directions." Appeal Br. 10. In particular, Mazda's arrow points in a direction that is opposite to that of the claimed design. It is not clear where the Examiner and the record sufficiently establishes a reason why a designer of ordinary skill in the art would have modified the design of Cadillac to incorporate a slightly curved arrow above the toe of the shoe, wherein the arrow points diagonally upward, which is in an opposite direction of Mazda's arrow, and toward the right. Although the Examiner asserted that "Cadillac already shows the rightward arrow pointing away from the shoe," this determination based on a horizontally pointing arrow is deficient for the reason discussed above. Ans. 7.

As to the reasoning for applying Black Arrows for the design of the arrow, all that we are provided for in the record is that Black Arrows is "pointing away" and that it is "so related in that it shows a range of arrow icon types." Final Act. 3, 4. It is unclear how Black Arrows in isolation is "pointing away" and how or why the disclosed arrow would motivate a

designer of ordinary skill to change the Mazda's arrow to point in the opposite direction when applied to Cadillac.

Mazda in view of Cadillac and Black Arrows

The Examiner's rejection of the claimed design based on Mazda in view of Cadillac and Black Arrows is also deficient for similar reasons discussed above in that the Examiner does not sufficiently explain, nor the record sufficiently establish, why a designer of ordinary skill in the art would have modified the design of Mazda to modify its arrow so that it is slightly curved and points diagonally upward and toward the right in an opposite direction to that of Mazda. We again note that the horizontal arrows of Cadillac are insufficient to provide such motivation, and the Examiner's application of Black Arrows does not remedy that deficiency.

Disposition of the Rejections

Therefore, in view of the above considerations, we reverse the Examiner's rejections of the claimed design based on Cadillac in view of Mazda and Black Arrows, and on Mazda in view of Cadillac and Black Arrows. The Appellant's further arguments asserting that the suggested combination still fails to result in the claimed design, and the Examiner's response that such differences are obvious and/or *de minimis*, are moot. Appeal Br. 9–10, 14–17; Ans. 5; Reply Br. 15, 18. In addition, the Appellant's arguments regarding the differing intended purpose of the claimed design to those of Cadillac and Mazda, and the Examiner's responses thereto, are also moot. Appeal Br. 16; Ans. 9, 12; Reply Br. 13–14, 19. Furthermore, the Appellant's arguments asserting that the applied

prior art are not analogous art, while pertinent to the *LKQ* analysis, is nonetheless moot in view of the above. Reply Br. 2, 6–12.

CONCLUSION

The Examiner’s rejections are reversed.

DECISION SUMMARY

The following table summarizes our decision:

Claim Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1	103	Cadillac, Mazda, Black Arrows		1
1	103	Mazda, Cadillac, Black Arrows		1
Overall Outcome				1

REVERSED

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

In re Application of	⌘	Conf. No.: 7527
<i>Xi CHEN et al.</i>	⌘	Art Unit: 2913
Serial No.: 29/798,750	⌘	Examiner: Ana Maria Vine
Filed: July 9, 2021	⌘	Atty Dkt.: 1612.881

For: **DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER
INTERFACE**

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT’S REPLY BRIEF

Commissioner:

Further to Appellant’s Notice of Appeal, the following Reply Brief is submitted under 37
C.F.R. §41.41.

1. INTRODUCTION

This Reply to the Examiner's Answer, dated September 22, 2023, is filed to address recent and intervening case law regarding the article of manufacture in design patent analysis and raises what are believed to be significant questions of first impression: (1) whether the "same article" limitation of recent Federal Circuit decisions also applies to primary and/or secondary references for obviousness rejections; and (2) whether non-interactive graphic designs are appropriate prior art against designs directed to graphical user interfaces which appear on a display screen, panel or monitor and are integral to the operation of a programmed computer.

Applicant respectfully submits that in view of the holdings of *In re SurgiSil*, *Curver v. Home Expressions*, and *Columbia v. Seirus*, and considering the field of endeavor and problem being solved by designer of ordinary skill, prior art used for design patent obviousness analysis, must also be limited to "same article" or same field of endeavor. Furthermore, Applicants respectfully submit that non-interactive graphic designs are not appropriate prior art against claims directed to graphical user interfaces which are integral to the operation of a programmed computer and appear on a display screen, panel or monitor. Moreover, Applicant respectfully submits that in this case, the Examiner has not adequately considered and limited the asserted prior art to the type of design identified in Applicant's title and claim, or the apparent use context of Applicant's design as understood from the figure, priority application, and the underlying problem to be solved.

This Reply also addresses the arguments and demonstrative illustrations of the Examiner's Answer and argues that the Examiner's proposed primary references are deficient because they lack important visual elements of the claimed design and their modification to incorporate such elements would impermissibly destroy their fundamental characteristics. Moreover, the Examiner's proposed primary and secondary references are not "so related" in problem to be

solved and field of endeavor to permit combination. To the extent that the proposed secondary references are pertinent, that the Examiner's selective combination of parts of elements from secondary references is impermissible and indicative of hindsight bias, and that the proposed combinations are unpredictable, if not inaccurate and are therefore indicative of impermissible hindsight.

2. REPLY BASED ON RECENT AND INTERVENING CASE LAW AND SIGNIFICANT UNRESOLVED QUESTIONS ABOUT ARTICLE LIMITATION FOR OBVIOUSNESS ANALYSIS

On September 15, the Federal Circuit issued its decision in *Columbia Sportswear N. Amer., Inc. v. Seirus Innovative Accessories, Inc.*, 21-2299(hereinafter *Columbia II*)¹ concluding that “to qualify as comparison prior art, the prior art design must be applied to the article of manufacture identified in the claim. It held so based on *In re SurgiSil*, 14 F.4th 1380, 1382 (Fed. Cir. 2021)(holding that for a design prior-art design to anticipate, it must be applied to the article of manufacture identified in the claim; claim scope limited to a lip implant; designs applied to other articles-there, an art tool-could not anticipate) and *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336, 1340, 1343 (Fed. Cir. 2019)(claim scope limited to a chair; design applied to a basket could not infringe).²

¹ https://cafe.uscourts.gov/opinions-orders/21-2299.OPINION.9-15-2023__2190910.pdf (last accessed Nov. 22, 2023).

² This Board has adopted the “same article” limitations described in *In re SurgiSil* and *Curver Luxembourg, SARL v. Home Expressions Inc.* For example, see *Ex parte Lee* (Appeal No. 2019-003505, Serial No. 29/527,945); *Ex parte Tsakiris* (Appeal No. 2019-003772, Serial No. 29/562,030); *Ex parte Richmond* (Appeal No. 2021-005119, Serial No. 29/619,024).

The requirement for the same article of manufacture logically must also extend to design patent obviousness analysis and is inherent in the perspective of a designer of ordinary skill in the art, from which obviousness is determined. *In re Nalbandian*, 661 F.2d 1214 (C.C.P.A. 1981).

The first part of design patent obviousness analysis requires “a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design. *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996)(quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982). Secondary references “may only be used to modify the primary reference if they are “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. *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996)(quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996).

In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must be in the same field of endeavor, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)(combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.) In *MRC Innovations, Inc. v. Hunter Mfg., LLP*, the Federal Circuit found references to be “so related” to be combinable when they were articles of the same kind (in that case, all dog jerseys) *and* had similar overall visual appearances. 747 F.3d 1326, 1334 (Fed. Cir. 2014).

In re Glavas states “it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design,” however this is just when the problem is “merely giving an attractive appearance to a surface.” 230 F.3d 447, 450 (C.C.P.A.):

“On the other hand, when the proposed combination of references involves material modifications of the basic form of one article in view of another, the nature of the articles involved is a definite factor in determine whether the proposed change involves invention. Obviously, almost every new design is made up of elements which, individually, are old somewhere in the prior art, but the fact that the individual elements of a design are old, does not prove want of invention in assembling them.”

Id. citing *Whiting*, 48 F.2d 912 (C.C.P.A.)

Moreover, for references to be considered “so related” to be combined, they must be “closely akin.” *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996).

Thus, for a primary reference and for a secondary reference, to have design characteristics which are basically the same, the reference must be the same type of article or at least be from a the same or a similar field of endeavor.

Even to the extent that a designer of ordinary skill might look to art beyond their specific problem being solved, the Federal Circuit appears to have left open the issue of whether “ordinary observer” (with its “same article” prior art limitation) applies to obviousness. Pursuant to the Federal Circuit’s decision in *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009), the “ordinary observer” test for infringement also ultimately applies in an obviousness determination:

“Seaway argues that adopting the ordinary observer test for anticipation will blur the distinction between the tests for obviousness under § 103 and for anticipation under § 102, resulting in jury confusion. According to Seaway, the test for invalidity due to obviousness is whether a designer of ordinary skill in the art would have found the patented design, as a whole, obvious in light of the prior art. *Litton*, 728 F.2d at 1443. The test for invalidity due to anticipation, on the other hand, requires the jury to consider the perspective of the ordinary consumer. There is in fact no potential for confusion. For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of prior art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been

constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art.”

Subsequently, the Court declined to confirm whether the ordinary observer test applies to obviousness, leaving it open. *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372 (Fed. Cir. 2009.) Applicant respectfully submits that the Rosen-Durling standard for design characteristics which are basically the same is essentially coextensive with the ordinary observer test for “substantially the same” appearance.

For the foregoing reasons, the “same article” limitation of design patent infringement, anticipation and comparison prior art also must apply to both primary and secondary obviousness references.

For the following reasons, Applicant respectfully submits that the Examiner’s prior art references fail the “same article” limitation which must apply to design patent obviousness:

1. The references are merely non-interactive graphic images, as opposed to prior art references directed to display screens or portions thereof with graphical user interfaces (where patentability is predicated on being integral to the operation of a programmed computer) and therefore fail to meet the “same article” limitation which must apply for design patent obviousness; and
2. The references are directed to distinct problems and are not reasonably pertinent to the problem being solved by the claimed design, consequently they fail the same article limitation or at least teach away from modification of their appearance which would destroy their design intent and appearance.

1. The asserted non-interactive graphic references do not meet the “same article” limitation which must apply to obviousness.

Design patentable graphical user interfaces are not mere surface ornamentation but are statutory subject matter when integral to the operation of a programmed computer and shown on a display screen, panel or monitor. See M.P.E.P. 1504.01(a); Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces, 88 FR 80277 (November 17, 2023) available at <https://www.govinfo.gov/content/pkg/FR-2023-11-17/pdf/2023-25473.pdf> (last accessed November 22, 2023).

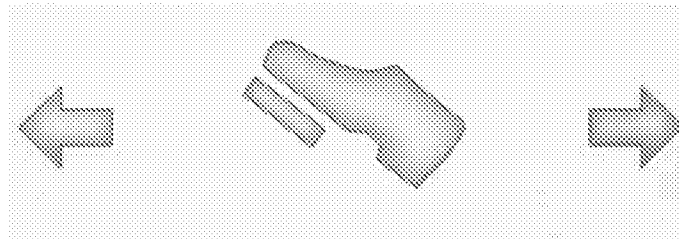
Merely illustrating a picture displayed on the screen of a computer or other display device, such as a television or movie screen, is sufficient, alone, to convert a picture into a design for an article of manufacture.” *Ex parte Strijland*, 26 U.S.P.Q. 2d 1259 (B.P.A.I. 1992), *Ex parte Cady*, 1916 C.D. 62, 232 O.G. 621 (Comm’r Pat. 1916).

The Examiner’s proposed primary references fail the “same article” limitation which must apply to obviousness because they merely present images on a screen, which alone are not patentable. The Examiner made no showing of the references being interactive and integral to the operation of a programmed computer, and a plain understanding of the references demonstrates they are not, and therefore cannot be used to challenge the obviousness of the claimed design, being directed to statutory subject matter of a graphical user interface on a display screen, understood to be integral to the operation of a programmed computer.

The Cadillac reference is apparently a digitized excerpt of a Cadillac Escalade Owner's Manual, and its graphic illustration relates to adjustable throttle and brake pedals that allow a user to change pedal positions. The image of Cadillac is not described or reasonably understood as a graphical user interface integral to the operation of a programmed computer.

The vehicle has adjustable throttle and brake pedals that allow you to change their positions.

The feature will not operate when the vehicle is in R (Reverse) or while using the cruise control.



The switch used to adjust the pedals is located on the center console below the climate control system.

Press the right and left arrows to move the pedals either closer or further from your body.

Before you start driving, fully press the brake pedal to confirm the adjustment is right for you. While driving, make only small adjustments.

The vehicle has a memory function which allows the pedal positions to be saved and recalled. See Memory Seats .

Cadillac reference

A plain reading of the Mazda reference reveals it is an illustration of an indicator light in a vehicle instrument cluster, not a display screen or portion thereof with graphical user interface, integral to the operation of a programmed computer.

(Type B instrument cluster)

The brake pedal operation demand indicator light in the instrument cluster turns on.



Electric parking brake automatic release

If the accelerator pedal is depressed with the electric parking brake applied and all of the following conditions met, the parking brake is released automatically.

- The engine is running.
- The driver's door is closed.
- The driver's seat belt is fastened.

Mazda reference

It is evident from the references that the references do not disclose the same article of manufacture as the claimed design, despite being available digitally on the Internet -- this is merely

information displayed on a screen, and the underlying designs are likewise directed to a printed graphic and a dashboard indicator light, not graphical user interfaces.³

2. The Examiner's proposed primary reference must fail they are directed to designs with different purposes and consequently the proposed references have different overall appearances.

To the extent that the asserted, non-interactive references are applicable against the claimed design, the references nevertheless fail the "same article" limitation which must apply to design patent obviousness because the references are clearly directed to solving different problems than the claimed design.

Columbia II notes that a natural, relevant consideration for distinguishing one article from another involves looking to the articles' respective functions; referencing functionality to distinguish articles of manufacture is not categorically impermissible. (FN1, see page 26.)

Applicant respectfully submits that the Examiner's proposed primary references must fail because they illustrate and otherwise teach designs with different purposes. A reference which merely depicts some visually similar elements but arranged in a different way for a different use context should not qualify as prior art pertinent to a designer of ordinary skill solving a different problem, albeit with visually related components.

³To the extent that *In re Schnell*, 46 F.2d 203, 208 (C.C.P.A. 1931) indicates that a "particular article" requirement does not apply to surface ornamentation designs, design patent statutory graphical user interfaces are more than mere surface ornamentation. *Ex parte Strijland*, 26 U.S.P.Q. 2d 1259 (B.P.A.I. 1992).

Moreover, even if applicable, the purpose-consequent overall appearances of the cited references are different from the claimed design, not basically the same.

The Cadillac reference is apparently a digitized excerpt of an automobile owner's manual, and its graphic illustration relates to adjustable throttle and brake pedals that allow a user to change pedal positions. Therefore, its left and right arrows are significant to its design characteristics. The claimed design depicts an arrow up from the pedal and foot, indicating that the design is directed to graphical user interface for controlling deceleration. A designer of ordinary skill would not look to Cadillac when setting out to design for the use context depicted in the claimed design because a graphic image illustrating adjustability of pedals forward and backward to accommodate a user, the design characteristics of Cadillac, is a different problem to be solved than creating a graphical user interface relating to and depicting acceleration and deceleration, as in the claimed design.



Reference view from Japanese Priority Document

The image produced above is a reference view from the Japanese Priority Document and the text roughly translates to push to accelerate.”

The Mazda reference is also apparently a digitized excerpt of an owner’s manual. The Mazda reference includes an illustration of an indicator light of a vehicle instrument cluster and is related to brake pedal operation and electric parking brake automatic release by accelerator pedal depression, likewise, different problem to be solved than creating a graphical user interface depicting acceleration / deceleration, as in the claimed design.

3. REPLY TO EXAMINER'S ANSWER

- A. The Examiner's proposed primary references are deficient because they lack important visual elements of the claimed design and their modification to incorporate such elements would impermissibly destroy their fundamental characteristics.

In the Board decision *Vanguard Identification Systems, Inc. v. Bank of America Corp.*, Appeal 2009-002973 (July 31, 2009), an Examiner had rejected the design for a data card as being obvious in view of a purported primary reference data card which did not possess the claimed design's circular aperture, but was taught in a secondary reference. The Board held that the Examiner failed to consider the Appellant's claimed design as a whole by disregarding the visual impression created by the aperture. The secondary reference provides a missing feature that is significant to the overall appearance and visual effect of the card design claimed. The Examiner was impermissibly selecting features to form an article similar to the claimed design, which may be appropriate in analysis of utility claims, but not with designs. The Board agreed that obviousness should not focus on individual features, but becomes significant if the feature is integral to the visual impression of the claimed design.

Therefore, it is not proper to alter primary reference as it destroys the fundamental characteristic of the design regardless of the functionality behind the design. Cadillac is an owner's manual that shows how adjust the position of the throttle and brake pedal closer or farther away from your body. If you take the arrows away like the Examiner wants to, then it destroys what Cadillac is about. Mazda is an owner's manual that shows how to release a parking brake by pushing down on the accelerator pedal. If you change the direction of the arrow or remove an integral piece of the pedal itself, it destroys what Mazda is about. Furthermore, on page 5 of the Answer, the Examiner states that although Cadillac has a pedal that does not fully extend to the heel, one skilled in the art would not miss the teachings of Mazda to extend the pedal. However,

As noted above, Cadillac reference is apparently a web-page version of an Owner's Manual which includes a pedal graphic with left and right arrows to indicate that the vehicle has adjustable throttle and brake pedals. The Mazda reference also comes from an Owner's Manual which includes a pedal graphic with an arrow pointed downward to indicate how to release a parking brake. The Black Arrows is merely a stock image of an arrow, of which there are countless variations of. Cadillac and Mazda are not relevant to each other as they teach completely different functions and feature illustrations that would not be combinable in the context of their source material. Similarly, Black Arrows isn't relevant to either Cadillac or Mazda as it is just a stock image of arrow which is not the same in terms of angle, orientation, direction or size as either arrow found in Cadillac or Mazda. The arrow in Black Arrows is in no way shape or form related

B. The Examiner's proposed primary and secondary references are not "so related" in problem to be solved and field of endeavor to permit combination.

design.

of depression. To remove the T shape here would be removing a fundamental characteristic of this and therefore there are many ways to illustrate accelerator pedals to reflect those different methods. There are many types of accelerator pedals which do not incorporate such an intersecting element, intent that this intersecting line formed part of the Mazda pedal design to form this distinct T shape. intersecting line beneath the pedal because they consider it an indicia, however there was clear needed for a primary reference. Similarly, on page 6 of the Answer, the Examiner states that the accelerator pedal. Therefore, Cadillac does not share a fundamental characteristic that would be purposes. It would not make sense to extend a brake pedal to the same length or shape as an the pedals in Cadillac and Mazda are completely different types of pedals, meant for different

to the pedals illustration of Cadillac or Mazda. One cannot simply rely on a database of arrows to incorporate to alter the appearance of an unrelated image. Even in the context of countless way to depict an arrow, the Examiner chose an arrow that is of a different angle, shape, proportions and size as the arrow in the claimed design which further removes Black Arrow from being related to any of the claimed and cited art in this matter. Therefore, the references are not so related in the problem being solved that an Examiner would be motivated to combine these things and be further motivated to combine them in the specific orientation and combination of elements to create the claimed design.

C. To the extent that the proposed secondary references are pertinent, that the Examiner's selective combination of parts of elements from secondary references is impermissible and indicative of hindsight bias.

The Examiner has impermissibly selected portions of secondary references to create a hindsight impression of a design to compare to the claimed design. There is no motivation to combine the applied secondary reference and there is no motivation to teach the same appearance. Black Arrows is directed to a stock image of a slightly curved arrow. On page 10 of the Answer, the Examiner states that Black Arrows is employed to teach the directional orientation of the arrow of the claimed design "i.e., an arrow pointing away from the shoe". However, even in the Examiner's own recreation of the "Black Arrows as applied to the two Primary References", they had to move the arrow from a central location and further rotate and reduce the size of the arrow to try and match the arrow of the claimed design. Furthermore, if Black Arrow is meant to teach an arrow pointing away from the shoe, why not place it in a location other than the toe box, why not further rotate the arrow so it is pointing full to the right, why not rotate the arrow so it points away from the shoe, but downward, why not use a straight arrow pointing away from the shoe?

By combining the primary and secondary references and stating that they did not glean any information from the Appellant's disclosure, the Examiner purported that it was within the realm of their knowledge to illustrate an acceleration pedal with an arrow pointed away to encourage deceleration. In comparison, Cadillac shows a throttle or brake pedal with a left arrow and right arrow that shows how the pedal's position can be moved closer or farther from your body. The Examiner cannot just take away the arrows and extend the pedal into a different kind of pedal as these are integral elements to the Cadillac design. In Mazda, there is an integrated perpendicular "T" shaped element to the pedal. This integrated element cannot just be removed. Mazda further shows an arrow pointing down, which removed or replaced would greatly alter the reference. Finally, Black Arrows just shows a curved arrow pointing up. There are numerous types of arrows and locations the arrow the can be placed. This particular arrow is a stock image, the primary

The Examiner has impermissibly selected portions of the primary and secondary references to create a hindsight impression of a design to compare to the claimed design. There is no motivation to combine the primary and secondary references and there is no motivation to teach the same appearance. On page 10 of the Answer, the Examiner states that if they use only the knowledge within the level of ordinary skill at the time the claimed invention was made, and do not include knowledge gleaned from the Appellant's disclosure, reconstruction is proper.

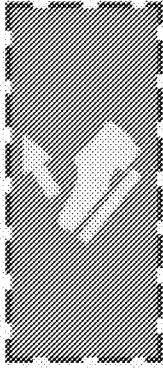
D. The proposed combinations are unpredictable, inaccurate, and indicative of impermissible hindsight.

The numerous possibilities of how one could illustrate a secondary reference to show an arrow pointing away from a shoe further supports that there is some level of impermissible hindsight to place this arrow in a certain location, of a certain size, rotated to a certain angle to appear as the arrow in the claimed design appears.

element of which is the arrow itself, displayed prominently front and center, not moved to any particular location as a secondary element to an overarching design. It is impermissible hindsight to only take a part of an integral element from a design, to take this piece without this other key piece which fundamentally alters the design. Here, the Examiner has chosen altered pieces to create a specific look to achieve similarity with the claimed design. There is no cited reference teaching this combination or knowledge found in one of ordinary skill to have created this specific combination. If anything, the three cited references would teach away from the claimed design unless one had gleaned knowledge from the claimed design. Why not keep the left and right arrows, why not put Black Arrows under the pedal, why remove the perpendicular attachment that forms the “T” shape? The Examiner has clearly used impermissible hindsight, having gleaned information from the claimed design to recreate something similar but still not the same as the claimed design.

E. Additional responses to Examiner’s arguments

In its Principal Brief, Appellant takes the position that Mazda has a distinct pedal, which is T-shaped, whereas the claimed design has a simple line, which extends past the arch, under the heel. On page 6 of the Answer, the Examiner takes the position that the presence of an intersecting line underneath the pedal does not disqualify Mazda as a primary reference, because “indicia around or within the designs seen in prior art do not necessarily discount the prior art as applicable reference.” Thus, the Examiner takes the position that the rejection can rely on Mazda for just a section of its pedal feature that matches the claimed design, and disregard the actual overall appearance of the pedal feature from Mazda.

Claimed Design	Examiner's Primary Reference Mazda
	

The rationale cited by the Examiner is mere argument and does not come from any published Office examination guidance or case law and is not consistent with the general mandate for design patent analysis which requires assessing overall visual appearance and disallows dissection.

On page 7 of the Answer the Examiner takes the position that Mazda teaches extending the pedal in Cadillac “below the heel of the shoe....” Applicant respectfully disagrees, noting that Mazda’s T-shaped pedal ends prior to or adjacent to the front edge of the heel portion, and therefore does not in fact teach extending the pedal below the heel of the shoe.

Also on page 7 of the Answer, the Examiner takes the position that it would be obvious to modify Cadillac by placing the arrow of Mazda above the toe box, and rounding it as taught by Black Arrows. Applicant respectfully disagrees, noting that the arrow of Mazda points downward, in generally the opposite direction as the claimed design, resulting in a distinct appearance. If Mazda is applied to Cadillac, its pedal appearance and its arrow appearance should be applied to Cadillac, and when they are, the claimed design does not result. The Examiner is improperly selecting portions of Mazda and editing them with no basis or suggestion in the prior art except with hindsight to achieve the claimed design.

On page 8 of the Answer the Examiner takes the position that the function of a graphical user interface or icon has no bearing on the scope of applicable prior art under *In re Glavas*, 230 F.2d 447 (CCPA 1956). The Examiner takes the position that Cadillac and Mazda are “so related” in ornamental appearance that certain ornamental features in one would suggest the application of those features to the other. Applicant respectfully submits that the prior art reference Black Arrow is not so related in appearance to suggest combination with either Mazda or Cadillac because Black Arrow reference shows an arrow alone, not in the similar context of shoe + pedal + arrow designs.

On page 10, the Examiner takes the position that Cadillac “already shows an arrow pointing away from the shoe....” Applicant respectfully disagrees. Cadillac reference includes left and right arrows to indicate that the pedal assembly can be positioned toward or away from the driver. The Examiner has not adequately explained why a designer of ordinary skill should disregard and factor out Cadillac’s left and right facing arrows (impermissible defeating its design appearance and function) and instead include Mazda’s arrow, let alone change arrow direction and curvature. The Cadillac reference is apparently a web-page version of an Owner’s Manual which includes a pedal graphic with left and right arrows to indicate that the vehicle has adjustable throttle and brake pedals. A designer of ordinary skill, familiar with Cadillac would not modify Cadillac with Mazda because Cadillac is designed specifically to include the left and right arrows to indicate adjustability of the pedals. Despite some conceptual similarities, the actual purpose of the graphic in Cadillac and its consequent appearance are immediately distinct from the claimed design.

On page 12 of the Answer, the Examiner takes the position that “the claimed design and the prior art in the respective entirety were considered by the Examiner and found to be so related as graphical user interfaces showing a shoe with a stylized pedal and arrows. Applicant notes that the “Black Arrows” reference is not so related as showing a shoe with a stylized pedal and arrows,

but rather shows an arrow alone, therefore it cannot be properly combined with other prior art references to render the claimed design.

4. CONCLUSION

In view of the evidence and arguments presented above, the Examiner's final rejection of the claimed design under 35 U.S.C. 103 must be reversed.

Respectfully submitted,

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November 22, 2023

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VINE, ANA MARIA

ART UNIT

PAPER NUMBER

2913

NOTIFICATION DATE

DELIVERY MODE

09/22/2023

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):

ptomail@designlawgroup.com



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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 29/798,750

Filing Date: 9 Jul 2021

Appellant(s): TOYOTA JIDOSHA KABUSHIKI KAISHA

George D. Raynal
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 13, 2023 appealing from the Office action mailed February 22, 2023.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated February 22, 2023 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.”

(2) Restatement of Rejection

The following ground(s) of rejection are applicable to the appealed claims.

Claim Rejections – 35 U.S.C. § 103

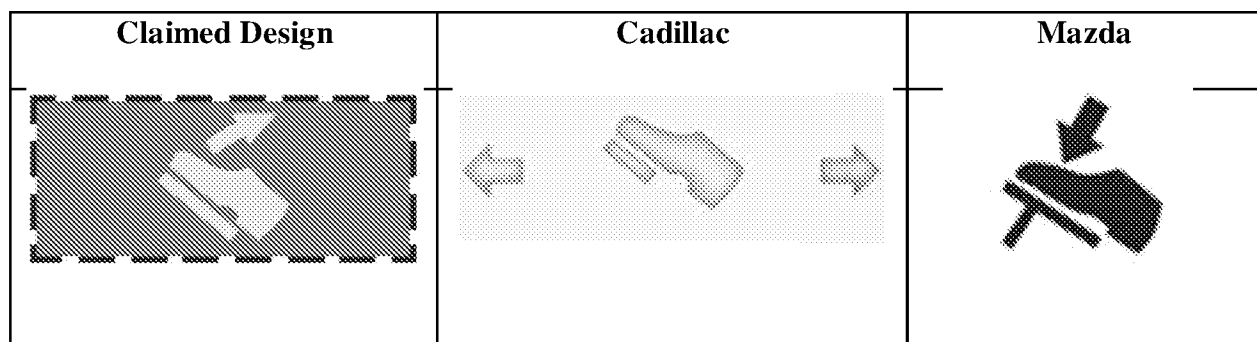
The claim is rejected under 35 U.S.C. 103 as being unpatentable over “Cadillac Escalade: Adjustable Throttle and Brake Pedal,” published on or about October 30, 2020 (hereinafter Cadillac) and “Mazda 6 Owner’s Manual: Electric Parking Brake,” published on or about December 18, 2016 (hereinafter Mazda) in view of the “iStock Black Arrows,” first available October 7, 2018 (hereinafter Black Arrows).

(3) Response to Argument

As set forth in the appeal brief, Appellant argues the claimed design is patentable over Cadillac and Mazda in view of Black Arrows due to differences between the cited references and the claimed design.

Overall Visual Appearance

Appellant argues Cadillac and Mazda have substantial ornamental features which distinguishes their overall visual impression from that of the claimed design, noting the relatively thick line extending around 25% of the heel of the sole, the intended appearance of the heel on the bottom right side, mirrored in the toe side of the shoe, and the angle, length, shape and location of the start and end points of the arrow. (Appeal Brief, 9) Appellant also argues the Examiner failed to discern the correct visual impression of the claimed design as a whole such that the primary references omit key characteristics. Mainly, Cadillac does not differentiate the angle, relative placement, curvature and relative size compared to other design features of the arrow and Mazda fails to describe the directional orientations of the arrows, the heel and relative size of the arrow and the absence of an intersecting line in the pedal. (Appeal Brief, 10) Furthermore, Appellant argues the characterization of the claimed design and the cited references fails to acknowledge that these differences are not minor but arise from different design purposes and result in different design appearances due to their operation as graphical user interfaces. (Appeal Brief, 10)



The general appearance of the claimed design disclosed when compared with the disclosed design in Cadillac, has basically the same design characteristics. Both disclose a design consisting of a landscape-oriented, rectangular graphical user interface containing a similar shaped shoe, a rightward pointing arrow, and a thick line of similar weight with a similar size

gap in between the shoe and a thick line stylization of a pedal. Both shoe icons have a rounded toe with a slight indentation to indicate the sole, the same instep, an angled heel, similar curvature to the midsole, similar curvature of the topline and the same curve from toe to the top of the shoe. Thus, taken as a whole, Cadillac is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design. MPEP § 1504.03 (II), *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982), *In re Harvey*, 12 F.3d 1061, 29 USPQ2d 1206 (Fed. Cir. 1993).

The Appellant points out the styled pedal in the primary reference does not extend around 25% of the heel of the sole but that is an obvious modification. One skilled in the art would not miss the teaching of Mazda, the second primary reference, to extend the styled pedal in Cadillac.

Moreover, the heel and toe box indentation the Appellant views as a major design characteristic in the claimed design are so minor that these features get lost visually when the claimed design is viewed as a whole and therefore are not significant enough to create patentable distinction.

Therefore, the slight difference in the heel and toe box curvature and gradient shading for contrast in appearance is de minimis in nature and unrelated to overall aesthetic appearance of design. “De minimis changes which would be well within the skill of an ordinary designer in the art do not create a patentably distinct design.” *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982).

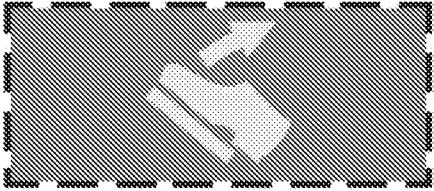
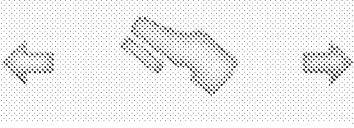
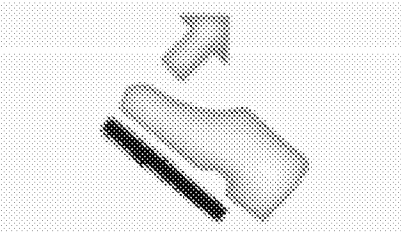
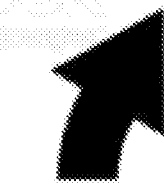
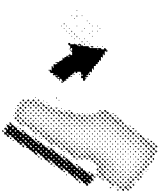
Therefore, in a comparison of the prior art with the claim, the claimed design is interpreted to be directed to a shoe icon over a stylized pedal and a rightward pointing arrow. Cadillac discloses what is claimed, namely a shoe icon of similar appearance, a stylized pedal, and a rightward pointing arrow. The examiner identifies Cadillac as a proper primary reference

because it is a reference showing design characteristics and appearance which are basically the same as the claimed design.

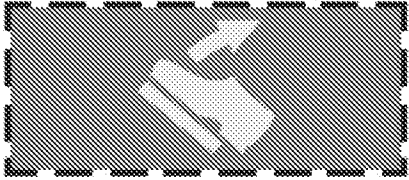
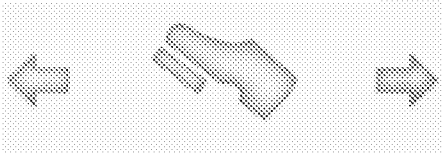
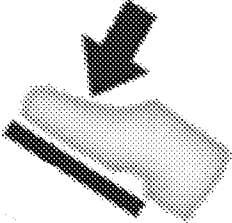
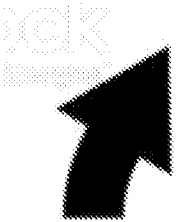
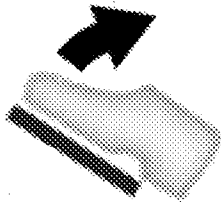
Additionally, this argument is found unpersuasive because Mazda is a proper second primary reference which also shows design characteristics which are basically the same as the claimed design. The general appearance of the claimed design disclosed when compared with the disclosed design in Mazda has basically the same design characteristics. Both disclose a design consisting of a similar shaped shoe, an arrow placed over the toe portion of the shoe, and a thick line of similar weight that reaches under the heel of the shoe with a similar size gap in between the shoe and the thick line. Both shoe icons have a rounded toe with a slight indentation to indicate the sole, the same instep, an angled heel, similar curvature to the midsole, similar curvature of the topline and the same curve from toe to the top of the shoe. The presence of an intersecting line underneath the pedal does not disqualify Mazda as a primary reference, because indicia around or within the designs seen in prior art do not necessarily discount the prior art as applicable references. When a design exists within the environment of other design features, there may be no reason for that selected portion to exist or be shown independently. The mere selection of the scope of a claim is not in itself an inventive trait of a design, and does not discount prior art which makes no such selection. (Final Rej. 6-7) Meaning, determining novelty and non-obviousness calls for considering whether a design that looks like the claim was already in existence, whether in isolation or within environment. Without the liberty to make that consideration, the peculiarity of the selection, per se, becomes the novelty of the design. With a design that exists around or within other designed environment, there may be no reason for that particular design to exist independently in the prior art. This does not imply that it is not in itself, a design. Therefore, requiring the prior art to show a design in existence in isolation cannot be

the standard for evaluating designs understood to exist within other designed environment, as with the instant claim. Thus, Mazda is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design. Mazda is not applied in its entirety and there is no need to teach removal of the elements as they are not applied as or required to be part of the rejection.

Mazda teaches extending the pedal in Cadillac below the heel of the shoe, and moving the rightward arrow pointing away from the shoe above the shoe's toe box. "It would have been obvious to modify Cadillac by elongating the pedal and placing the arrow above the toe box of the shoe... and rounding it, as taught by Black Arrows." (Final Rej. 4) Cadillac already shows the rightward arrow pointing away from the shoe so when placed above the toe box, the arrow would still be pointing away similarly to the claimed design.

Claimed Design	Cadillac	Mazda
		
Mazda as Applied to Cadillac	Back Arrow	Black Arrow as applied to Mazda as Applied to Cadillac
 Teaching to extend the pedal to the heel and the arrow over the toe box.		 Replacing the arrow in Cadillac which is now over the toe box with Back Arrow with is slightly curved.

Mazda already shows a shoe, a stylized pedal that extends to the heel and an arrow above the toe box. Cadillac also shows having a straight arrow pointing away from the shoe. (Final Rej. 8) Therefore, “It would have been obvious to modify Mazda ...by using the shoe icon seen in Cadillac, and by pointing the arrow away and rounding it, as taught by Black Arrows” (Final Rej. 4). The direction of the arrow, pointing away from the shoe, is additionally reinforced by the arrow pointing away from the shoe in Cadillac.

Claimed Design	Mazda	Cadillac
		
Cadillac as Applied to Mazda	Back Arrow	Black Arrow as applied to Mazda as Applied to Cadillac
 Teaching the shape of the shoe as shown in Cadillac.		 Teaching the arrow away from the shoe box and curved.

Appellant further argues the primary references do not take into account that the remaining differences are not minor but arise from design purposes and a designer of ordinary skill would not be motivated to combine the references.

MPEP § 1504.01(I)(B) states, “Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which are alone surface ornamentation. See, e.g., *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) (computer-generated icon alone is merely surface ornamentation).”

The function of a graphical user interface or icon has no bearing on the scope of applicable prior art under *In re Glavas*, 230 F.2d 447 (CCPA 1956), which held that, “[a] design, from the standpoint of patentability, has no utility other than its ornamental appearance,” and that the obviousness inquiry thus involves appearances, and not uses. That the cited primary references’ appearance are for a graphical display or icon is sufficient in this case for them to be considered applicable to the present graphical user interface design.

The long-standing test for properly combining references has been “...whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” See *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). Cadillac and Mazda, as graphical user interfaces or icons that show angled lines, shoes, and arrows, are so related to suggest the application of features, in one to the other, to one with ordinary skill in the art.

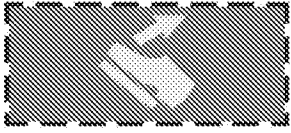
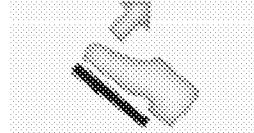
Validity of the Secondary Reference

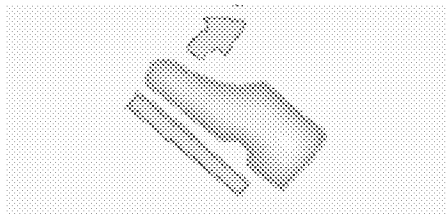
In arguing that prior art must be considered in its entirety, Appellant further argues that Black Arrows is a flawed secondary reference because it does not teach the same appearance as the claimed design and a combination of the primary and secondary references would not result in the claimed design. Appellant then argues that the obviousness of the proposed modifications are not supported because the secondary reference, Black Arrow, does not teach the same

appearance as the claimed design and there is no motivation to combine the applied reference without using impermissible hindsight. (Appeal Brief 14-15) Appellant's arguments indicating that Black Arrows is not a valid secondary reference is not persuasive.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Additionally, the Appellant argues the rejection improperly selects and applies a feature of the alleged secondary reference to the alleged primary reference, which suggests impermissible hindsight. Specifically, the rejection employs Black Arrows to teach the directional orientation of the arrow of the claimed design, i.e., an arrow pointing away from the shoe, a feature which applicant argues should be present in the purported primary references. (Appeal Brief 16) However this is not so, as stated prior, the primary reference Cadillac already shows an arrow pointing away from the shoe while Mazda already shows having an arrow above the toe box of the shoe. Black Arrow only teaches the arrow above the toe box having a slight curvature.

Claimed Design	Mazda as Applied to Cadillac	Cadillac as Applied to Mazda	Black Arrows	Black Arrows as applied to the two Primary References
				

Examiner's Final Rendering of Primary References and Secondary Reference


One with ordinary skill in the art would not fail to recognize the Black Arrows' teaching of a rounded arrow pointing up and to the right, and varying the degree of curvature.

Appellant holds there would be no teaching, suggestion or motivation to combine references because the references are purpose designed to have their specific appearance, and Black Arrows is not "so related" in purpose or appearance as the Examiner suggests simply because it is an ornamentation for a display screen. Appropriateness of a secondary reference should be determined by considering purpose and appearance, whereas the Examiner's selection of this arrow element is simply based on impermissible hindsight trying to recreate the claimed design. (Appeal Brief 16) Black Arrow is so related to the primary references because all

three show arrow icons and are graphical user interfaces. Again, the function of a graphical user interface or icon has no bearing on the scope of applicable prior art under *In re Glavas*. The purpose of a graphical user interface or icon is that of surface ornamentation, and as such, the combination of primary and secondary references is proper.

Combination of Cadillac and Mazda with Black Arrow is Proper

Appellant argues the combination of Cadillac and Mazda with Black Arrow relies on impermissible hindsight, because of the omission of the design features cited by Appellant would only be done in view of the claim. (Appeal Brief, 15-16) The examiner respectfully disagrees that impermissible hindsight was used.

In this case, the claimed design and the prior art in the respective entireties were considered by the examiner and found to be so related as graphical user interfaces showing a shoe with a stylized pedal and arrows. When viewed as a whole, the additional elements disclosed in the prior art reference features do not hide the more specific information offered or distract one from being inspired by specific information present in the cited references. It would be within the level of ordinary skill in the art at the time the claimed invention was made to identify the teachings of Cadillac, Mazda and Black Arrows and to apply the teaching of Black Arrows to Cadillac and Mazda to arrive at the claimed design without knowledge of Appellant's disclosure.

Accordingly, it remains the position of the Examiner that the claimed design is unpatentable over the Cadillac and Mazda references in view of Black Arrows reference.

(4) Conclusion of the Examiner's Answer

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

Respectfully submitted,

/A.M.V./
Examiner, Art Unit 2913

Conferees:

/RACHEL A. VOORHIES/
Primary Examiner, Art Unit 2923

/SHANNON W MORGAN/
Supervisory Patent Examiner, Art Unit 2913

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
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

In re Application of	⌘	Conf. No.: 7527
<i>Xi CHEN et al.</i>	⌘	Art Unit: 2913
Serial No.: 29/798,750	⌘	Examiner: Ana Maria Vine
Filed: July 9, 2021	⌘	Atty Dkt.: 1612.881

**For: DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER
INTERFACE**

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192

Commissioner:

Pursuant to Appellant's Notice of Appeal, filed herewith, Appellant hereby submits the following Appeal Brief.

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1. REAL PARTY IN INTEREST

This application has been assigned to Toyota Jidosha Kabushiki Kaisha, a corporation of the country of Japan.

2. RELATED APPEALS AND INTERFERENCES

Appellant is aware of no related appeals or interferences.

3. STATUS OF CLAIMS

The sole claim on appeal in this application stands finally rejected as set forth in the Examiner's Action of September 14, 2022. An Amendment filed December 13, 2022 was acknowledged by the Examiner and the final rejection maintained in her Office action of February 22, 2023. A clean copy of the claim on appeal is as follows: "...the ornamental design for a DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE as shown and described." A copy of the specification and the drawings are attached as an Appendix.

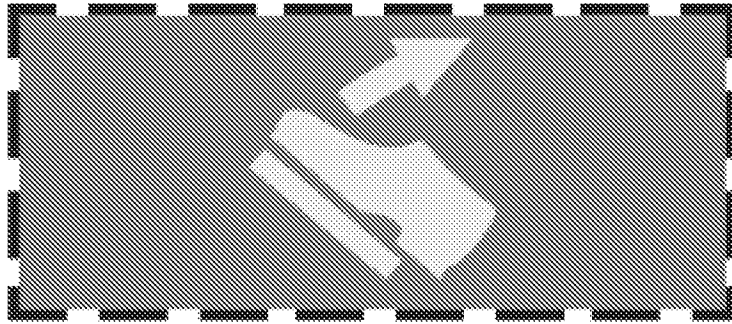
4. STATUS OF AMENDMENTS

The Amendment filed December 13, 2022 was acknowledged by the Examiner in her Office action of February 22, 2023. All earlier Amendments were entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

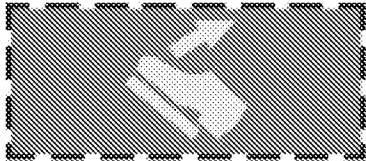
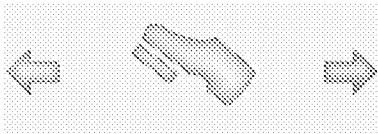
The claimed design is for a display screen or portion thereof with graphical user interface.

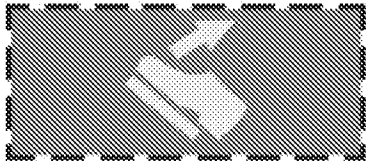
The sole figure is reproduced below:



6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issue on appeal is whether the claimed design is obvious under 35 U.S.C. §103 over the Examiner's prior art citation and rejection, illustrated below.

Claimed Design	Examiner's Primary Reference Cadillac	Examiner's Secondary Reference Black Arrows
		

Claimed Design	Examiner's Primary Reference Mazda	Examiner's Secondary Reference Black Arrows
		

7. PROSECUTION HISTORY

In a final rejection dated February 22, 2023 [“Fin. Rej.”], the Examiner rejected the claimed design as obvious and unpatentable over three cited references:

The claim is **FINALLY** rejected under 35 U.S.C. 103 as being unpatentable over “Cadillac Escalade: Adjustable Throttle and Brake Pedal,” published on or about October 30, 2020 (herein Cadillac) and “Mazda 6 Owner’s Manual: Electric Parking Brake,” published on or about December 18, 2016 (herein Mazda) in view of the “iStock Black Arrows,” first available October 7, 2018 (herein Black Arrows).

Fin. Rej., p. 2

The design of Cadillac has basically the same design characteristics as the claimed design, in that both designs disclose a similar shaped shoe, a thick line of similar weight underneath the shoe, a gap between the shoe and the thick line of similar weight, and a rightward pointing arrow to the right of the shoe.

Fin. Rej., p. 3

The design of Mazda discloses a design with basically the same design characteristics as the claim, in that both designs disclose a similar shaped shoe, a thick line of similar weight and length underneath the shoe, a gap between the shoe and the thick line of similar weight and length, and one arrow arranged above the toe portion of the shoe.

Fin. Rej., p. 3

Black Arrows shows a rounded arrow pointing away.

Fin. Rej., p. 3

It would have been obvious to modify Cadillac by elongating the pedal and placing the arrow above the toe box of the shoe, as seen in Mazda, or to modify Mazda by using the shoe icon seen in Cadillac, and by pointing the arrow away and rounding it, as taught by Black Arrows.

Fin. Rej., p. 4

Appellants, in their immediately preceding response filed December 13, 2022, had argued on p.

5:

Applicant respectfully submits that the claimed design is not obvious in view of the cited art, and that the rejection is improper and should be withdrawn because (1) the rejection fails to discern the correct visual impression created by the claimed design as a whole, (2) fails to identify a primary reference with basically the same design characteristics as the claimed design, and (3) improperly relies on a secondary reference to arbitrarily supply characteristics which are fundamental to the claimed design, and the combination of the primary and secondary references would not result in the same design as the claimed design.

On p. 7, Appellants drew attention to *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009) and *In re SurgiSil*, 14 F.4th 1380 (Fed. Cir. 2021) noting that design use is relevant to prior art for determining “substantial similarity” for anticipation and is also relevant to a designer of ordinary skill for determining “basically the same” design characteristics for obviousness, for suggestion or motivation to combine, and to whether the designs are “so related” as to be combined in an obviousness rejection.

On pp. 7-8, Appellants noted that the PTAB has reversed obviousness rejections on grounds that the purported primary references are not visually similar enough to the claimed designs, due to certain differences between the two designs that were deemed obvious or patentably indistinct modifications to the examiners. See *Ex parte Robertus Christianus Elisabeth Mariet and Patrick Hofmann*, Appeal 2019-001901 (September 19, 2019) (rejection reversed); *Ex parte Chicisimo S.L.*, Appeal 2018-004018 (November 21, 2018) (rejection reversed); *Ex parte Tom Thai et al.*, Appeal 2015-007954 (April 18, 2017) (rejection reversed).

On p. 9, Appellants drew attention to *Premier Gems Corp. v. Wing Yee Gems & Jewelry*, IPR 2016-00434 (July 5, 2016)(institution denied); *Sketchers USA v. Nike, Inc.*, IPR 2016-01043 (November 16, 2016)(institution denied); *Vanguard Identification Sys., Inc., v. Patent of Bank of Amer. Corp.*, Appeal 2009-002973 (July 31, 2009) (rejection reversed) where the PTAB noted that a secondary reference cannot be used to teach a fundamental design characteristic which should be present in the primary reference, and selective use of certain design features of secondary references while deliberately ignoring other design features just so the claimed design would result indicates that the rejection is based on hindsight reconstruction rather than objective teachings of the references.

In the final rejection, the Examiner rejected the Appellant’s argument that the Cadillac reference shows a difference in specific positions and direction orientations which would result in a different overall appearance form that of the claimed design is not a proper primary reference:

Both disclose a design consisting of a portrait-oriented, rectangular graphical user interface containing a similar shaped shoe, a rightward pointing arrow, and a thick line of similar weight with a similar size gap in between the shoe and the thick line. Thus, taken as a whole, Cadillac is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design.

Fin. Rej., p. 6.

Furthermore, the Examiner rejected the Appellant's argument that the Mazda reference fails to describe the appearance of the pedal and the directional orientation of the arrow creating an overall appearance that is different from the claimed design:

Both disclose a design consisting of a similar shaped shoe, an arrow placed over the toe portion of the shoe, and a thick line of similar weight that reaches under the heel of the shoe with a similar size gap in between the shoe and the thick line. The presence of an intersecting line underneath the pedal does not disqualify Mazda as a primary reference, because indicia around or within the designs seen in prior art do not necessarily discount the prior art as applicable references. When a design exists within the environment of other design features, there may be no reason for that selected portion to exist or be shown independently. The mere selection of the scope of a claim is not in itself an inventive trait of a design, and does not discount prior art which makes no such selection.

Fin. Rej., pp. 6-7.

Finally, the Examiner rejected the Appellant's argument that the proposed modifications to the primary references are not supported because the secondary reference, Black Arrow, does not teach the same appearance as the claimed design and there is no motivation to combine the applied reference without using impermissible hindsight.

Black Arrow is so related to the primary references because all three show arrow icons.

...

One with ordinary skill in the art would not fail to recognize the Black Arrow's teaching of a rounded arrow pointing up and to the right, and varying the degree of curvature. As the primary and secondary references are so related due to all being ornamentation for display screens, it would be obvious to one with ordinary skill in the art to apply the teachings of the secondary reference to the combination of Cadillac and Mazda.

Fin. Rej., pp. 7-9.

In response to the final rejection, this Appeal was filed.

8. ARGUMENT

Appellants respectfully submit that the rejection on appeal alleging that the claimed design is unpatentable as obvious over the Examiner cited references is critically flawed and reversal is respectfully requested. The Examiner's visual impression of the claimed design is incomplete and stops with some basic similarities to the purported primary references. The primary references are improper and do not possess basically the same design characteristics as the claimed design. The secondary reference is likewise improper as it does not teach the same appearance as the claimed design and its combination with the primary references would not result in the same design as the claimed design.

A. Design Patent Obviousness

For design patents, the obviousness inquiry consists of two steps, the first of which itself is a two-part inquiry. *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). First, in order to reject a design under 35 U.S.C. §103(a), an Examiner must (1) discern the correct visual impression created by the claimed design as a whole; and (2) identify a single reference that creates “basically the same” visual impression. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311-12 (Fed. Cir. 2013), *quoting Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). Regarding the second part of this first step, an Examiner must not only identify a single reference that creates “basically the same” visual impression as the claimed design, but also undergo an extensive analysis of the “distinctive ‘visual appearances’” of the two designs. *Apple*, 678 F.3d at 1332.

Once a proper primary reference is found, secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design, provided that

such modifications do not destroy the fundamental characteristics of the primary reference. *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982). See also *Durling*, 101 F.3d at 103-104; *Apple*, 678 F.3d at 1329; *High Point Design*, 730 F.3d at 1311; *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). A finding of obviousness cannot be based on selecting features from the prior art and assembling them to form an article similar in appearance to the claimed design. *In re Jennings*, 182 F.2d 207, 208 (CCPA 1950), (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”). See *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *In re Sung Nam Cho*, 813 F.2d 378, 382 (Fed. Cir. 1987).

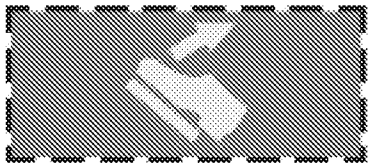
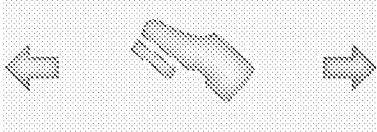
B. The Examiner Has Failed to Discern the Correct Visual Impression of the Claimed Design.

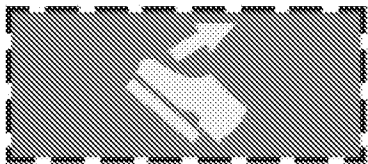
Appellants respectfully submit that the Examiner has an incomplete visual impression of the claimed design, stopping with some basic similarities to the two cited primary references. More particularly, Applicant notes that the Examiner fails to appreciate and neither the cited references nor their combination teach the individual elements or overall appearance of the claimed design, including its relatively thick line extending around 25% of the heel of the sole, the indented appearance of the heel on the bottom right side, mirrored in the toe side of the shoe, and the angle, length, shape and location of the start and end points of the arrow.

The Examiner compares the claimed design and Cadillac as graphical user interfaces wherein “Both disclose a design consisting of a portrait-oriented, rectangular graphical user interface containing a similar shaped shoe, a rightward pointing arrow, and a thick line of similar weight with a similar size gap in between the shoe and the thick line.” (*Fin. Rej.*, p.6). Similarly,

the rejection provides an abstract and incomplete comparison of the claimed design to Mazda, describing the designs as graphical user interfaces wherein “Both disclose a design consisting of a similar shaped shoe, an arrow placed over the toe portion of the shoe, and a thick line of similar weight that reaches under the heel of the shoe with a similar size gap in between the shoe and the thick line.” (*Fin. Rej.*, p.6).

In this abbreviated characterization, the rejection fails to discern the correct visual impression of the claimed design as a whole, omitting characteristic features absent from the purported primary references. For example, the comparison of the claimed design to Cadillac does not differentiate the angle, relative placement, curvature and relative size compared to other design features of the arrow. The comparison of the claimed design to Mazda fails to describe the directional orientations of the arrows, in that the two designs depict the arrows in opposite directions. Furthermore, the Mazda comparison fails to show the differentiation in the heel and relative size of the arrow compared to other design features and the absence of an intersecting line in the pedal. The Examiner notes that the lack of the intersecting line does not disqualify Mazda as a primary reference as “when a design exists within the environment of other design features, there may be no reason for that selected portion to exist or be shown independently.” (*Fin. Rej.*, p. 7) In doing so the Examiner is not just picking and choosing what elements of a design to compare, but is choosing to remove portions of connected lines and features when its presence or absence as in this case substantially changes the appearance of the design. These details are not de minimis, rather they are integral to the appearance of the designs in view of their operation as graphical user interfaces. The characterization of the claimed design and the cited references fails to acknowledge that these differences are not minor but arise from different design purposes and result in different design appearances.

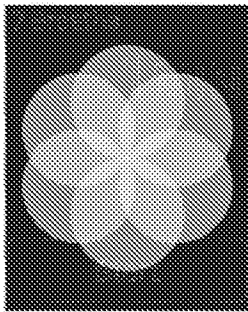
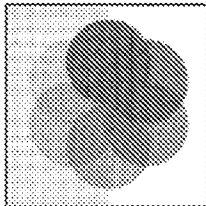
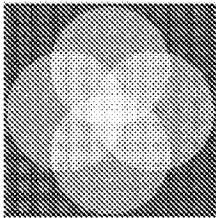
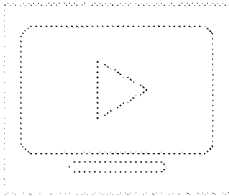
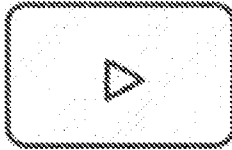
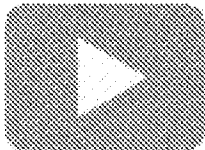
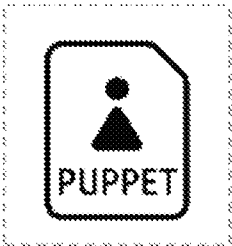
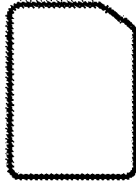
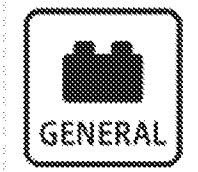
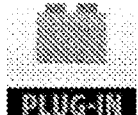
Claimed Design	Examiner's Primary Reference Cadillac	Examiner's Secondary Reference Black Arrows
		

Claimed Design	Examiner's Primary Reference Mazda	Examiner's Secondary Reference Black Arrows
		

C. The Examiner Has Failed to Identify a Primary Reference With Basically the Same Design Characteristics as the Claimed Design.

In recent decisions regarding graphical user interface designs, Appellant notes that the PTAB has reversed obviousness rejections on grounds that the purported primary references are not visually similar enough to the claimed designs, due to certain differences between the two designs that were deemed obvious or patentably indistinct modifications to the examiners. See *Ex parte Robertus Christianus Elisabeth Mariet and Patrick Hofmann*, Appeal 2019-001901 (September 19, 2019) (rejection reversed); *Ex parte Chicisimo S.L.*, Appeal 2018-004018 (November 21, 2018) (rejection reversed); *Ex parte Tom Thai et al.*, Appeal 2015-007954 (April 18, 2017) (rejection reversed). Although these decisions are not precedential, they offer recent indications

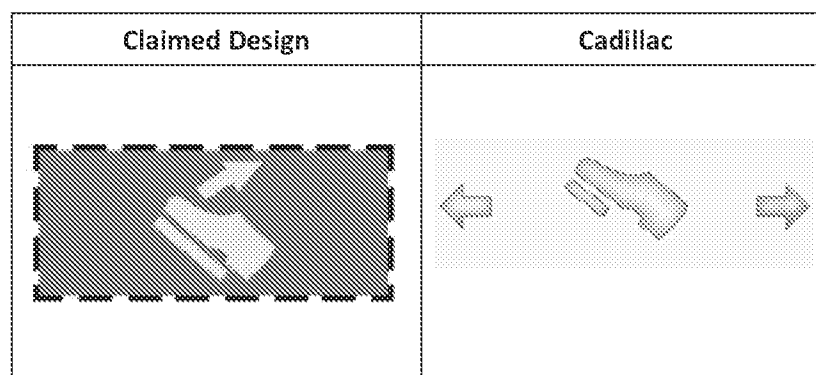
of how the Board reviews obviousness rejections, and are examples of the relatively high bar for identifying a primary reference, which is not met in this case. Further examples of recently reversed rejections include:

Decision	Claimed Design	Cited References
<i>Ex parte Samuel Howard</i> <i>Bebbington et al.</i> Appeal 2020-004518		 
<i>Ex parte Steve Rura et al.</i> Appeal 2020-006017		 Kokoro  Fleximind
<i>Ex parte Rebecca Noble et al.</i> Appeal 2020-006030		 Iconswebsite  Safety  Revicon
<i>Ex parte Rebecca Noble et al.</i> Appeal 2021-002247		 Robio  Firestopper  Baby Unacore

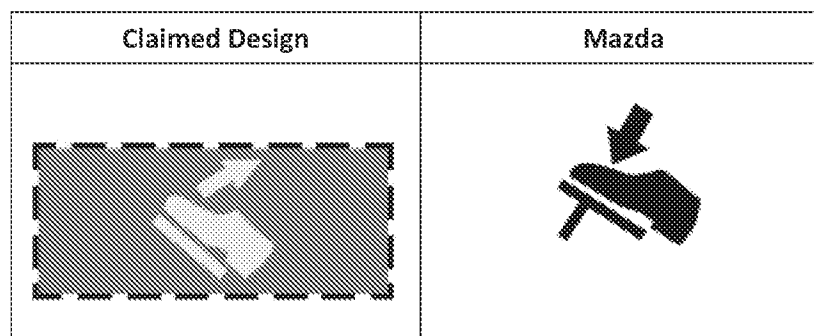
Although these decisions are not precedential, collectively they illustrate the stringency of identifying a true primary reference with design characteristics which are basically the same as the claimed design, which the Examiner has not met in this case.

Quoted above, the instant rejection provides a comparison of the claimed design to Cadillac and Mazda, the alleged primary references. These comparisons fail to mention visually significant characteristics of the claimed design.

More specifically, first, regarding alleged primary reference Cadillac, it shows straight arrows pointed to the left and right at the left and right sides of the user interface, and importantly, no curved arrow leading away from the shoe toe. The representation of the pedal is substantially less long. The shoe toe and heel portions of Cadillac are different than in the claimed design. All elements of Cadillac have an outline within which there is gradient shading, with the outer appearing darker, fading lighter toward the center, distinguishing the elements from the, shaded light background, whereas all design elements of the claimed design are shaded uniformly light in contrast to a dark background.



Second, regarding alleged primary reference Mazda, it shows a straight arrow pointing downward into the shoe toe. The line below the shoe does not extend as far as the line below the shoe in the claimed design and moreover, Mazda shows a perpendicular lower line opposite the arrow pointing down toward the shoe toe. The shoe toe and heel portions of Mazda are different than in the claimed design. All elements of Mazda are solid black on a white background, whereas all design elements of the claimed design are shaded uniformly light in contrast to a dark background.



The selection of Cadillac or Mazda as primary references is improperly based upon understanding of the claimed design which is improperly general and conceptual and without regard to the particular purpose and appearances of the designs. Each of the claimed designs' major design elements is distinguishable from the cited art and cannot be considered *de minimis*. For example, the Board noted that “minor points of difference [...] can play a greater role in differentiating simple designs” when considering the visual differences between a square and a rectangle (see Appeal 2018-001766, decided December 19, 2019 (Application No. 29/443,590)).

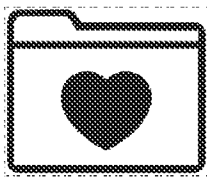
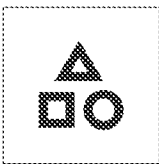
D. The Examiner Has Failed to Identify a Secondary Reference to Teach the Same Appearance of the Claimed Design.

The rejection improperly relies on a secondary reference – Black Arrows – to teach a fundamental design characteristic of the claimed design. Reliance on this secondary reference is

also flawed because it does not teach the same appearance as the claimed design, and a combination of the primary and secondary references would not result in the same design as the claimed design.

First, Appellant notes that the PTAB has recently noted that a secondary reference cannot be used to teach a fundamental design characteristic which should be present in the primary reference, and selective use of certain design features of secondary references while deliberately ignoring other design features just so the claimed design would result indicates that the rejection is based on hindsight reconstruction rather than objective teachings of the references. See *Premier Gems Corp. v. Wing Yee Gems & Jewelry*, IPR 2016-00434 (July 5, 2016)(institution denied); *Sketchers USA v. Nike, Inc.*, IPR 2016-01043 (November 16, 2016)(institution denied); *Vanguard Identification Sys., Inc., v. Patent of Bank of Amer. Corp.*, Appeal 2009-002973 (July 31, 2009) (rejection reversed). Although these decisions are not precedential, they offer recent indications of how the Board reviews obviousness rejections.

The Examiner improperly concluded that Black arrow is so related to the primary references because all three show arrow icons (*Fin. Rej.*, p. 8). Such an understanding of the relation between primary and secondary references would lead to the understanding that any reference that includes a basic shape, could preclude the validity of a claimed design that also illustrates that basic shape. As evidenced by such designs as D956,100 and D969,860, among countless others, the placement, relative size, relative proportion of the design and inclusion of other elements of a basic shape which affects the overall visual impression would not be precluded from patentability due to the presence of an unrelated reference.

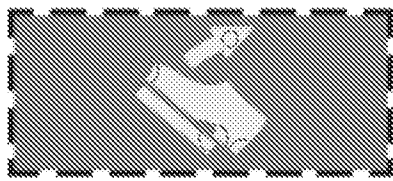
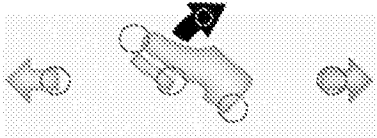
D956,100	D969,860
	

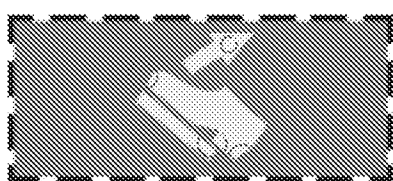
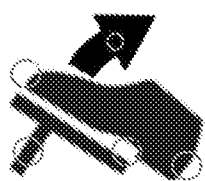
In this case, the rejection improperly selects and applies a feature of the alleged secondary reference to the alleged primary reference, which suggests impermissible hindsight. Specifically, the rejection employs Black Arrows to teach the directional orientation of the arrow of the claimed design, i.e., an arrow pointing away from the shoe, a feature which should be present in the purported primary references. Black Arrow discloses an arrow in a direction that would be contrary to the design and motivation of the primary references. Introduction of Black Arrow into Mazda and Cadillac would improperly and substantially modify or defeat their intended use.

Even if it were proper to incorporate the features of Black Arrows, the purported secondary reference, into Cadillac or Mazda, the purported primary references, the resulting design would still not be substantially the same as the claimed design, with substantial differences in appearance between major elements such as the arrow above the shoe, the details of the shoe, and the line elements.

There is no teaching, suggestion or motivation to combine references because the references are purpose designed to have their specific appearance, and Black Arrows is not “so related” in purpose or appearance as the Examiner suggests simply because it is an ornamentation for a display screen. Appropriateness of a secondary reference should be determined by considering purpose and appearance, whereas the Examiner’s selection of this arrow element is simply based on impermissible hindsight trying to recreate the claimed design. Moreover, even upon combination,

there remain substantial differences that present the resulting design from appearing substantially the same as the claimed design.

Claimed Design	Hypothetical design Cadillac + Black Arrow
	

Claimed Design	Hypothetical design Mazda + Black Arrow
	

9. CONCLUSION

In view of the evidence and arguments presented above, the Examiner's final rejection of the claimed design under 35 U.S.C. 103 must be reversed.

Respectfully submitted,

SAIDMAN **DesignLaw** Group

/George Raynal #68390/

George D. Raynal
Attorney for Appellants
Registration No. 68,390

June 13, 2023

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(301) 585-8601

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NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD		Docket Number (Optional) 1612.881
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, EFS-Web transmitted to the USPTO, or deposited with the United States Postal Service with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, on Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 19, 2023</u> . Signature <u>/George Raynal #68390/</u> Typed or printed name <u>George D. Raynal</u>	In re Application of <u>Xi CHEN et al.</u> Application Number <u>29/798,750</u> Filed <u>July 9, 2021</u> For <u>DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE</u> Art Unit <u>2913</u> Examiner <u>Ana Maria Vine</u>	
Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.		
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))		\$ <u>840</u>
☐ Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is:		\$ _____
☐ 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.		\$ _____
☐ A check in the amount of the fee is enclosed. ☒ Payment by credit card. Form PTO-2038 is attached. ☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____. ☐ Payment made via EFS-Web. ☐ 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.		
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.		
I am the		
☐ applicant	☒ attorney or agent of record Registration number <u>68,390</u>	☐ attorney or agent acting under 37 CFR 1.34 Registration number _____
Signature <u>/George Raynal #68390/</u>		
Typed or printed name <u>George D. Raynal</u>		
Telephone Number <u>(301) 337-3210</u>		
Date <u>May 19, 2023</u>		
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*.		
☒ * Total of <u>1</u> forms are submitted.		

This collection of information is required by 37 CFR 41.20(b)(1) and 41.31. 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 1.11, 1.14 and 41.6. This collection is estimated to take 12 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, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **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 and select option 2.

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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. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/798,750	07/09/2021	Xi CHEN	1612.881	7527
26396	7590	02/22/2023	EXAMINER	
SAIDMAN DESIGNLAW GROUP			VINE, ANA MARIA	
George D. Raynal			ART UNIT	
8601 GEORGIA AVE			PAPER NUMBER	
SUITE 603			2913	
SILVER SPRING, MD 20910			NOTIFICATION DATE	
			DELIVERY MODE	
			02/22/2023	
			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):

ptomail@designlawgroup.com

Office Action Summary

Application No.

29/798,750

Applicant(s)

CHEN et al.

Examiner

Ana M Vine

Art Unit

2913

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 13 December 2022.

☐ 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) 1 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) 1 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 09 July 2021 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)

3) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date ____.

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

4) ☐ Other: ____.

Paper No(s)/Mail Date ____.

DETAILED ACTION

General Information

The response filed December 13, 2022 is acknowledged and has been entered. The amendment to the specification overcomes the rejection under 35 U.S.C. 171, and the rejection is withdrawn.

The merits of the case have been carefully examined again in light of applicant's response. The arguments against the rejection under 35 U.S.C. 103 have been carefully considered but are not persuasive. Therefore, the rejection under 35 U.S.C. 103 is set forth again and made **FINAL**. Accordingly, **THIS ACTION IS MADE FINAL**.

Rejection under 35 U.S.C. 103

The claim is **FINALLY** rejected under 35 U.S.C. 103 as being unpatentable over "Cadillac Escalade: Adjustable Throttle and Brake Pedal," published on or about October 30, 2020 (herein Cadillac) and "Mazda 6 Owner's Manual: Electric Parking Brake," published on or about December 18, 2016 (herein Mazda) in view of the "iStock Black Arrows," first available October 7, 2018 (herein Black Arrows).

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.

A designer may point out and claim a design within the environment of a larger design. In this scenario, determining novelty and non-obviousness calls for considering whether a design that looks like the claim was already in existence, whether in isolation or within environment. Without the liberty to make that consideration, the peculiarity of the selection, per se, becomes the novelty of the design. With a design that exists around or within other designed environment, there may be no reason for that particular design to exist independently in the prior art. This does not imply that it is not in itself, a design. Therefore, requiring the prior art to show a design in existence in isolation cannot be the standard for evaluating designs understood to exist within other designed environment, as with the instant claim.

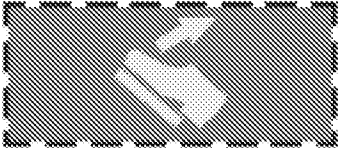
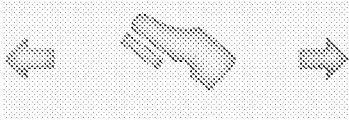
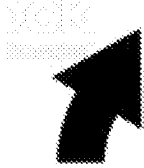
The design of Cadillac has basically the same design characteristics as the claimed design, in that both designs disclose a similar shaped shoe, a thick line of similar weight underneath the shoe, a gap between the shoe and the thick line of similar weight, and a rightward pointing arrow to the right of the shoe.

The claimed design is different from the design of Cadillac in that the arrow is curved and arranged diagonally above the shoe, and the thick line below the shoe is slightly more elongated.

The design of Mazda discloses a design with basically the same design characteristics as the claim, in that both designs disclose a similar shaped shoe, a thick line of similar weight and length underneath the shoe, a gap between the shoe and the thick line of similar weight and length, and one arrow arranged above the toe portion of the shoe.

The claimed design is different from the design of Mazda in that the pedal does not have an intersecting line and the arrow is slightly curved and points away from the icon.

Black Arrows shows a rounded arrow pointing away.

Claimed Design	Cadillac	Mazda	Black Arrows
			

It would have been obvious to modify Cadillac by elongating the pedal and placing the arrow above the toe box of the shoe, as seen in Mazda, or to modify Mazda by using the shoe icon seen in Cadillac, and by pointing the arrow away and rounding it, as taught by Black Arrows.

Any further difference is not significant enough to warrant a patent for the overall appearance of the claimed design over the prior art. *In re Lapworth*, 172 USPQ 129 (CCPA 1971); *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (1961).

This modification of the primary references 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).

Cadillac and Mazda are so related in that they are both graphical user interfaces showing shoe icons above a thick line indicative of a pedal and an arrow. The secondary reference is so related in that it shows a range of arrow icon types.

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 differences between the claimed design and the prior art are such that the claimed design as a whole would have been obvious before the effective filing date of the claimed design to a person having ordinary skill in the art to which the claimed design pertains.

Response to Applicant's Arguments

Applicant argues examiner has failed to discern the correct visual impression of the claimed design because there are characteristic features absent from the primary references that are the result of different design purposes. Applicant then characterizes Cadillac as being for adjusting a throttle or brake pedal and Mazda as demanding brake pedal operation, asserting these different uses result in different appearances.

MPEP § 1504.01(I)(B) states, "Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which are alone surface ornamentation. See, e.g., *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) (computer-generated icon alone is merely surface ornamentation)."

The function of a GUI or icon has no bearing on the scope of applicable prior art under *In re Glavas*, 230 F.2d 447 (CCPA 1956), which held that, "[a] design, from the standpoint of patentability, has no utility other than its ornamental appearance," and that the obviousness inquiry thus involves appearances, and not uses. That the cited primary references' appearance are for a graphical display or icon is sufficient in this case for them to be considered applicable to the present graphical user interface design.

The argument that the cited references are improper primary references because of differences in purpose or function is not persuasive.

Applicant argues Cadillac is not a proper primary reference because of the difference in the specific positions and directional orientations of the arrows which would result in a different overall appearance from that of the claimed design. When the broadly claimed design disclosed as a whole is compared with the disclosed design in Cadillac, the claimed design and the primary references have basically the same design characteristics. Both disclose a design consisting of a portrait-oriented, rectangular graphical user interface containing a similar shaped shoe, a rightward pointing arrow, and a thick line of similar weight with a similar size gap in between the shoe and the thick line. Thus, taken as a whole, Cadillac is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design. MPEP § 1504.03(D)(II), *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982), *In re Harvey*, 12 F.3d 1061, 29 USPQ2d 1206 (Fed. Cir. 1993).

Applicant further argues Mazda, the second primary reference, is also not a proper primary reference because it fails to describe the appearance of the pedal and the directional orientation of the arrow creating an overall appearance that is different from the claimed design. With this reference as well, when the broadly claimed design disclosed as a whole is compared with the disclosed design in Mazda, the claimed design and Mazda have basically the same design characteristics. Both disclose a design consisting of a similar shaped shoe, an arrow placed over the toe portion of the shoe, and a thick line of similar weight that reaches under the heel of the shoe with a similar size gap in between the shoe and the thick line. The presence of an intersecting line underneath the pedal does not disqualify Mazda as a primary reference, because indicia around or within the designs seen in prior art do not necessarily discount the prior art as

applicable references. When a design exists within the environment of other design features, there may be no reason for that selected portion to exist or be shown independently. The mere selection of the scope of a claim is not in itself an inventive trait of a design, and does not discount prior art which makes no such selection. Thus, Mazda is a valid primary reference that has basically the same design characteristics and an appearance that is substantially the same as the claimed design.

Applicant again argues the primary references do not take into account that the remaining differences are not minor but arise from design purposes and a designer of ordinary skill would not be motivated to combine the references. As discussed above, computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation.

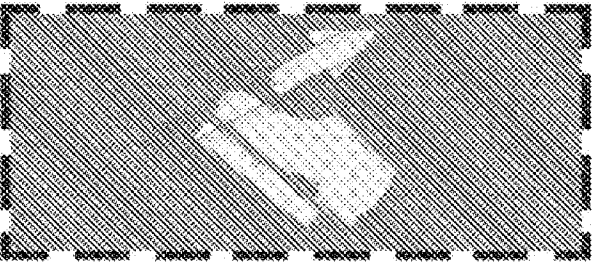
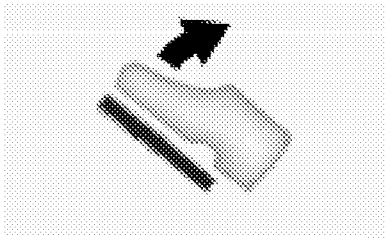
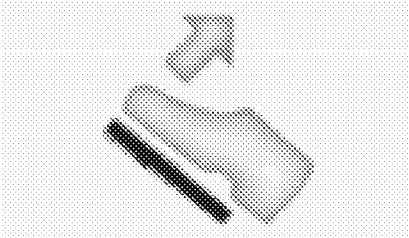
The long-standing test for properly combining references has been “...whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” See *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). Cadillac and Mazda, as graphical user interfaces or icons that show angled lines, shoes, and arrows, are so related to suggest the application of features, in one to the other, to one with ordinary skill in the art.

Applicant then argues that the obviousness of the proposed modifications are not supported because the secondary reference, Black Arrow, does not teach the same appearance as the claimed design and there is no motivation to combine the applied reference without using impermissible hindsight.

In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Black Arrow is so related to the primary references because all three show arrow icons. Again, the function of a graphical user interface or icon has no bearing on the scope of applicable prior art under *In re Glavas*. Furthermore, the applicant argues that the arrow in the claimed design is straight. As shown below, the arrow in the claimed design is slightly curved. Even if the arrow in the claimed design was straight, as claimed by the applicant, Mazda shows a straight arrow over the shoe, and Black Arrow teaches pointing that arrow away from the shoe. Moreover, Cadillac shows having a straight arrow pointing away from the shoe; positioning that arrow over the shoe is taught by Mazda.

	
Claimed Design with guides to show curvature of the arrow stem.	Mazda and Black Arrow as applied to Cadillac
	
Mazda as applied to Cadillac	

One with ordinary skill in the art would not fail to recognize the Black Arrow's teaching of a rounded arrow pointing up and to the right, and varying the degree of curvature. As the primary and secondary references are so related due to all being ornamentation for display screens, it would be obvious to one with ordinary skill in the art to apply the teachings of the secondary reference to the combination of Cadillac and Mazda.

Applicant holds there would be no teaching, suggestion or motivation to combine the primary references and secondary reference, because the references are designed to have their specific appearance due to their purpose. The purpose of a GUI or icon is that of surface ornamentation, and as such, the combination of primary and secondary references is proper.

A patent for a claimed invention may not be obtained 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 to a person having ordinary skill in the art. The applicant's argument is not convincing in overturning the finding of obviousness under this standard. The differences between the claimed design and the prior art, as exemplified by the direction and placement of the arrow and the length of the thick solid line, are such that the claimed invention as a whole would have been obvious before the effective filing date.

Conclusion

The claim is again and **FINALLY** rejected under 35 U.S.C. 103.

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.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M. Vine whose telephone number is (571)272-1348. The examiner can normally be reached Monday-Thursday, 6 a.m-4 p.m. ET.

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>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shannon Morgan can be reached on (571)272-7979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/A.M.V./

Examiner, Art Unit 2913

/RACHEL A. VOORHIES/

Primary Examiner, Art Unit 2923



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29/798,750	07/09/2021	Xi CHEN	1612.881	7527
26396	7590	12/15/2022	EXAMINER	
SAIDMAN DESIGNLAW GROUP			VINE, ANA MARIA	
George D. Raynal			ART UNIT	PAPER NUMBER
8601 GEORGIA AVE				
SUITE 603			2913	
SILVER SPRING, MD 20910			NOTIFICATION DATE	DELIVERY MODE
			12/15/2022	ELECTRONIC

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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):

ptomail@designlawgroup.com

<i>Applicant-Initiated Interview Summary</i>	Application No. 29/798,750	Applicant(s) CHEN et al.		
	Examiner Ana M Vine	Art Unit 2913	AIA (First Inventor to File) Status Yes	Page 1 of 1

All Participants (applicant, applicants representative, PTO personnel)	Title	Type
Ana M Vine	Examiner	Telephonic
Rachel A. Voorhies	Primary Examiner	
George Raynal	Attorney of Record	
Charles An	Attorney	

Date of Interview: 07 December 2022

Issues Discussed:

35 U.S.C. 103

Applicant and Examiner discussed arguments for the 103 rejection. Applicant indicated the written response will include an argument opposing the use of secondary teaching references and requesting the examiner consider the purpose of the icon upon reconsideration of the claimed design. No agreement on overall patentability was reached.

/A.M.V./ Examiner, Art Unit 2913	/RACHEL A. VOORHIES/ Primary Examiner, Art Unit 2923
Applicant is reminded that a complete written statement as to the substance of the interview must be made of record in the application file. It is the applicants responsibility to provide the written statement, unless the interview was initiated by the Examiner and the Examiner has indicated that a written summary will be provided. See MPEP 713.04 Please further see: MPEP 713.04 Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews, paragraph (b) 37 CFR § 1.2 Business to be transacted in writing	

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

AMENDMENT(S) TO THE SPECIFICATION

Please amend the specification as indicated below, wherein material to be added is underlined and material to be deleted appears in strikethrough or double brackets:

To All Whom It May Concern:

BE IT KNOWN THAT WE, Xi CHEN and Kohei MOROTOMI, have invented a new, original and ornamental design for a **DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE** of which the following is a specification, reference being had to the accompanying drawings forming a part hereof.

Cross-Reference to Related Application

This application claims priority from Japanese Design Application No. 2021-000441, filed January 11, 2021, which is expressly incorporated by reference herein.

☞ The sole figure shows a front view of a display screen or portion thereof with graphical user interface showing the claimed design.

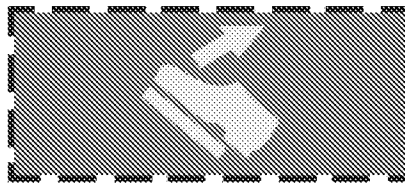
The peripheral dashed broken lines illustrate a display or portion thereof, and form no part of the claimed design.

REMARKS

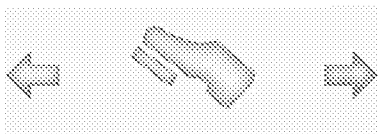
In the Office action dated September 14, 2022, the Examiner rejected the claim under 35 U.S.C. §171, alleging that the design is not shown embodied in or applied to an article of manufacture. In response, Applicant hereby amends the specification to add a descriptive statement to address the Examiner's 35 U.S.C. §171 rejection. This amendment presents no issue of new matter.

Furthermore, the Examiner rejected the claim under 35 U.S.C. §103 as unpatentable over "Cadillac Escalade: Adjustable Throttle and Brake Petal" (hereinafter "Cadillac") and "Mazda 6 Owner's Manual: Electric Parking Brake" (hereinafter "Mazda"), in view of "iStock Black Arrows" (hereinafter "Black Arrows"). The claimed design and the cited designs are reproduced below.

Claimed Design (GUI)



Cadillac (Purported Primary Reference)



Black Arrows (Purported Secondary Reference)



Mazda (Purported Primary Reference)



Black Arrows (Purported Secondary Reference)

The Applicant would like to thank the Examiners for the telephone interview of December 7, 2022. As discussed in the interview, Applicant respectfully traverses the Examiner's rejection per below.

For design patents, the obviousness inquiry consists of two steps, the first of which itself is a two-part inquiry. *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012). First, in order to reject a design under 35 U.S.C. §103(a), an Examiner must (1) discern the correct visual impression created by the claimed design as a whole; and (2) identify a single reference that creates "basically the same" visual impression. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311-12 (Fed. Cir. 2013), *quoting Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). Regarding the second part of this first step, an Examiner must not only identify a single reference that creates "basically the same" visual impression as the claimed design, but also undergo an extensive analysis of the "distinctive 'visual appearances'" of the two designs. *Apple*, 678 F.3d at 1332.

Once a proper primary reference is found, secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design, provided that such modifications do not destroy the fundamental characteristics of the primary reference. *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982). See also *Durling*, 101 F.3d at 103-104; *Apple*, 678 F.3d at 1329; *High Point Design*, 730 F.3d at 1311; *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). A finding of obviousness cannot be based on selecting features from the prior art and assembling

them to form an article similar in appearance to the claimed design. *In re Jennings*, 182 F.2d 207, 208 (CCPA 1950), (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”). See *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *In re Sung Nam Cho*, 813 F.2d 378, 382 (Fed. Cir. 1987).

Applicant respectfully submits that the claimed design is not obvious in view of the cited art, and that the rejection is improper and should be withdrawn because (1) the rejection fails to discern the correct visual impression created by the claimed design as a whole, (2) fails to identify a primary reference with basically the same design characteristics as the claimed design, and (3) improperly relies on a secondary reference to arbitrarily supply characteristics which are fundamental to the claimed design, and the combination of the primary and secondary references would not result in the same design as the claimed design.

1. Failure to discern the correct visual impression of the claimed design

In the rejection, the visual impression of the claimed design is incomplete, stopping with some basically similarities to the purported primary reference. The rejection begins with an abstract and incomplete comparison of the claimed design to Cadillac, the purported primary reference, describing the designs as graphical user interfaces wherein “both designs disclose a similar shaped shoe, a thick line of similar weight underneath the shoe, a gap between the shoe and the thick line of similar

weight, and a rightward pointing arrow to the right of the shoe.” (Office action, page 5). Similarly, the rejection provides an abstract and incomplete comparison of the claimed design to Mazda, describing the designs as graphical user interfaces wherein “both designs disclose a similar shaped shoe, a thick line of similar weight and length underneath the shoe, a gap between the shoe and the thick line of similar weight and length, and one arrow arranged above the toe portion of the shoe.” (Office action, Page 6).

In this abbreviated characterization, the rejection fails to discern the correct visual impression of the claimed design as a whole, omitting characteristic features absent from the purported primary references. For example, the comparison of the claimed design to Cadillac does not mention the specific positions and directional orientations of the arrows, namely, that the arrow of the claimed design is positioned above the shoe and angled diagonally, whereas the arrow of Cadillac is positioned to the right of the shoe and angled horizontally. The comparison of the claimed design to Mazda fails to describe the specific appearances of the pedals and the directional orientations of the arrows, in that the pedal of the claimed design does not have an intersecting line and that the two designs depict the arrows in opposite directions. These details are not de minimis, rather they are integral to the appearance of the designs in view of their operation as graphical user interfaces. The characterization of the claimed design and the cited references fails to acknowledge that these differences are not minor but arise from different design purposes and result in different design appearances. More specifically, Cadillac is for adjusting throttle or brake pedal and thus, its specific surface

ornamentation selected for that graphical user interface should not be disregarded or changed. Mazda is for demanding brake pedal operation when electric parking brake is released, and was designed to appear as it does, not to be modified with different graphical features. The different design uses result in their meaningful different appearances. Design use is relevant to prior art for determining “substantial similarity” for anticipation (*Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009); *In re SurgiSil*, 14 F.4th 1380 (Fed. Cir. 2021)) and is also be relevant to a designer of ordinary skill for determining “basically the same” design characteristics for obviousness, for suggestion or motivation to combine, and to whether the designs are “so related” as to be combined in an obviousness rejection.

2. Improper Primary References

Applicant respectfully submits that the rejection fails to identify primary references with basically the same design characteristics as the claimed design. In recent decisions regarding graphical user interface designs, Applicant notes that the PTAB has reversed obviousness rejections on grounds that the purported primary references are not visually similar enough to the claimed designs, due to certain differences between the two designs that were deemed obvious or patentably indistinct modifications to the examiners. See *Ex parte Robertus Christianus Elisabeth Mariet and Patrick Hofmann*, Appeal 2019-001901 (September 19, 2019) (rejection reversed); *Ex parte Chicisimo S.L.*, Appeal 2018-004018 (November 21, 2018) (rejection reversed); *Ex parte Tom Thai et al.*, Appeal 2015-007954 (April 18, 2017) (rejection reversed). Although these decisions are

not precedential, they offer recent indications of how the Board reviews obviousness rejections, and are examples of the relatively high bar for identifying a primary reference, which is not met in this case.

As quoted above, the instant rejection provides a comparison of the claimed design to Cadillac and Mazda, the alleged primary references. These comparisons fail to mention visually significant characteristics of the claimed design, as discussed in the previous section, as well as Cadillac and Mazda. First, the rightward arrow of Cadillac is in a different position and pointed in a different direction compared to the arrow of the claimed design. Furthermore, in Cadillac, the arrows teach away from the movement of the pedal shown in the claimed design. The overall visual impression of the claimed graphical user interface is to remove the foot to reduce acceleration. Instead, Cadillac shows that it is for adjusting the pedal for throttle and braking, which is in direct contrast to the claimed design. Similarly, the appearance of the claimed design is in direct contrast to Mazda, wherein the foot and corresponding arrow is shown to depress a brake pedal to release a parking brake.

The selection of Cadillac or Mazda as primary references is improperly based on too general an understanding of the claimed design and without regard to the particular purpose and appearances of the designs. In view of the simplicity of these designs, each feature contributes to their visual appearances and cannot be considered *de minimis*. For example, the Board noted that “minor points of difference [...] can play a greater role in differentiating simple designs” when considering the visual differences between a square and a rectangle (see Appeal 2018-001766, decided December 19, 2019

(Application No. 29/443,590)).

3. Improper Secondary Reference

The rejection improperly relies on a secondary reference – Black Arrows – to teach a fundamental design characteristic of the claimed design. Reliance on this secondary reference is also flawed because it does not teach the same appearance as the claimed design, and a combination of the primary and secondary references would not result in the same design as the claimed design.

First, Applicant notes that the PTAB has recently noted that a secondary reference cannot be used to teach a fundamental design characteristic which should be present in the primary reference, and selective use of certain design features of secondary references while deliberately ignoring other design features just so the claimed design would result indicates that the rejection is based on hindsight reconstruction rather than objective teachings of the references. See *Premier Gems Corp. v. Wing Yee Gems & Jewelry*, IPR 2016-00434 (July 5, 2016)(institution denied); *Sketchers USA v. Nike, Inc.*, IPR 2016-01043 (November 16, 2016)(institution denied); *Vanguard Identification Sys., Inc., v. Patent of Bank of Amer. Corp.*, Appeal 2009-002973 (July 31, 2009) (rejection reversed). Although these decisions are not precedential, they offer recent indications of how the Board reviews obviousness rejections.

In this case, the rejection improperly selects and applies a feature of the alleged secondary reference to the alleged primary reference, which suggests impermissible hindsight. Specifically, the rejection employs Black Arrows to teach the directional

orientation of the arrow of the claimed design, i.e., an arrow pointing away from the shoe, a feature which should be present in the purported primary references. Black Arrow discloses an arrow in a direction that would be contrary to the design and motivation of the primary references. It would create completely different contextual cues in Mazda. In Cadillac, there would be no place for the Black Arrows to be placed that would make sense for the design. Also, the visual appearance of the arrow in Black Arrows is not the same as the arrow of the claimed design, namely, because the stem is curved whereas the claimed arrow stem is straight.

Therefore, even if it were proper to incorporate the features of Black Arrows, the purported secondary reference, into Cadillac or Mazda, the purported primary references, the resulting design would not even be the same as the claimed design because the imported arrow of Black Arrows is not the same as the corresponding feature of the claimed design. Even if the imported arrow was the same as the arrow of the claimed design, the combination of the purported primary and secondary references would still lack the arrow positioning and directional orientation shown in the claimed design. Moreover, there is no teaching, suggestion or motivation to combine references because the references are purpose designed to have their specific appearance.

In view of the foregoing amendment and remarks, Applicant respectfully requests reconsideration and allowance of the application.

No fee is believed to be due with this submission. The Commissioner is hereby authorized to charge any fee deficiency to Deposit Account No. 19-0031.

Should further communication be necessary, the Examiner is invited to contact the

undersigned by telephone.

Respectfully submitted,

SAIDMAN **DESIGN**LAW GROUP

/George Raynal #68390/

George D. Raynal
Reg. No. 68,390

December 13, 2022

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

First Named Inventor:	⌘	Conf. No.: 7527
<i>Xi CHEN</i>	⌘	Art Unit: 2913
App. No.: 29/798,750	⌘	Examiner: Ana Maria Vine
Filed: July 9, 2021	⌘	Atty. Dkt.: 1612.881

For: **DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE**

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

RESPONSE TO OFFICE ACTION

Commissioner:

In response to the Office action dated September 14, 2022, please enter the following amendments and remarks in the application:

Amendment(s) to the Specification begin on page two.

Remarks begin on page three.



UNITED STATES PATENT AND TRADEMARK OFFICE

USPTO Automated Interview Request (AIR)

Nov 29 2022

This paper requesting to schedule and/or conduct an interview is appropriate because:

This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

Name(s) :
George Raynal

S-signature:
/George Raynal/

Registration Number:
68390

U.S. Application Number:
29798750

Confirmation Number:
7527

E-mail Address:
george.raynal@designlawgroup.com

Phone Number:
+1 3154806914

Proposed Time of Interview:
12-7-2022 2:00 PM ET

Alternative Proposed Time(s) of Interview:
12-8-2022 2:00 PM ET

Alternative Proposed Time(s) of Interview:
12-9-2022 2:00 PM ET

Preferred Interview Type:
Telephonic

I am the applicant or applicant's representative for this application.

Topic for Discussion:
103 rejection



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PATENT AND TRADEMARK OFFICE



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/798,750	07/09/2021	Xi CHEN	1612.881	7527
26396	7590	09/14/2022		
SAIDMAN DESIGNLAW GROUP			EXAMINER	
George D. Raynal			VINE, ANA MARIA	
8601 GEORGIA AVE				
SUITE 603			ART UNIT	PAPER NUMBER
SILVER SPRING, MD 20910			2913	
			NOTIFICATION DATE	DELIVERY MODE
			09/14/2022	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):

ptomail@designlawgroup.com

Office Action Summary

Application No.

29/798,750

Applicant(s)

CHEN et al.

Examiner

Ana M Vine

Art Unit

2913

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 _____.
☐ 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) 1 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) 1 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 09 July 2021 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 20210709.
- 3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 4) ☐ Other: _____.

DETAILED ACTION

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.

Examiner's Comment

This application incorporates by reference Japanese Patent Application No. 2021-000441, filed on January 11, 2021. All the material from the incorporated applications which 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 incorporated applications which is not present in this application forms no part of the claimed design.

Rejection under 35 U.S.C. 171

The claim is rejected under 35 U.S.C. 171 as directed to nonstatutory subject matter because the design is not shown embodied in or applied to an article of manufacture. 35 U.S.C. 171 defines the proper subject matter for a design patent:

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

To be considered statutory subject matter under 35 U.S.C. 171, a claimed design must be embodied in "an article of manufacture." *In re Zahn*, 617 F.2d 261, 268, 204 U.S.P.Q. 988, 995 (CCPA 1980). The phrase "an article of manufacture" has been interpreted to be a tangible object or physical substance. See *Henry Hanger & Display Fixture Corp. of America v. Sel-O-Rak*

Corp., 270 F.2d 635,640, 123 U.S.P.Q. 3, 6 (5th Cir. 1959); *Pelouze Scale & Mfg. Co. v. American Cutlery Co.*, 102 F. 916, 918 (7th Cir. 1900). *Kim Craftsmen, Ltd. v. Astra Products, Inc.*, 212 U.S.P.Q. 268 (D.N.J. 1980); 1 E. Lipscomb, *Walker on Patents*, 2:11 (1984), 1 W. Robinson, *The Law of Patents*, 200 (1890).

A design may be embodied in an article of manufacture (1) as a configuration for an article of manufacture, (2) as a surface ornamentation for an article of manufacture, or (3) a combination of both. *Gorham v. White*, 81 U.S. 511, 525 (1871); *In re Schnell*, 46 F.2d 203, 209 (CCPA 1931); MPEP § 1502.

Pursuant to the guidelines for examination of design patent applications for computer generated icons, 1185 O.G. 60, 61 F.R. 11380 (1996), a design for a computer-generated icon may be considered statutory subject matter if the following conditions are present:

- 1) The computer screen, monitor, other display panel, or portion thereof is shown in broken or solid lines with the icon displayed on it, and
- 2) The claim is directed to the subject matter as embodied in an article of manufacture.

The subject matter of the instant application does not meet these conditions.

Consequently, a design for a computer-generated icon per se is unpatentable since it is not embodied in a specific article of manufacture. *Ex parte Strijland*, 26 U.S.P.Q.2d 1259 (BdPatApp & Inter 1992), *Ex parte Tayama*, 24 U.S.P.Q.2d 1614 (BdPatApp & Inter 1992), *Ex parte Donoghue*, 26 U.S.P.Q.2d 1266 (BdPatApp & Inter 1992); *Ex parte Donoghue*, 26 U.S.P.Q.2d 1271 (BdPatApp & Inter 1992), and *Ex parte Donaldson*, 26 U.S.P.Q.2D 1250 (BdPatApp & Inter 1992).

Applicant's claim refers to a display screen or portion thereof, but an identifiable display screen or portion thereof is not shown in the drawing. The computer-generated graphical user

interface must comply with the “article of manufacture” requirement of 35 USC 171.

The title of the claimed design suggests that the article of manufacture is a display screen or portion thereof. The broken line description does not indicate that any of the broken lines in the drawings depict the article of manufacture.

In a Computer-Generated Icon-type design (see MPEP § 1504.01(a)), the broken line subject matter illustrates any or all of three distinct features: the environment of the design (e.g. a mobile/electronic device); the article of manufacture (e.g. the display screen/panel), which is embodied in the environment if present; and the graphical user interface, which is the design itself and serves as ornamentation of the article of manufacture. These three portions should all be appropriately identified. This particularly ensures that the design complies with the article of manufacture requirement of 35 U.S.C. § 171 in identifying that such an article exists in the drawing(s) and is clearly understood as such.

It is suggested the broken line statement be amended to clarify which broken lines show the article of manufacture. The following broken line statement is suggested:

-- The outermost broken line rectangle illustrates a display screen or portion thereof and forms no part of the claim. --

Rejection under 35 U.S.C. 103

The claim is rejected under 35 U.S.C. 103 as being unpatentable over “Cadillac Escalade: Adjustable Throttle and Brake Pedal,” published on or about October 30, 2020 (herein **Cadillac**) (see PTO-892, Page 1, Ref U) and “Mazda 6 Owner’s Manual: Electric Parking Brake,” published on or about December 18, 2016 (herein **Mazda**) (see PTO-892, Page 1, Ref V) in view

of the “iStock Black Arrows,” first available October 7, 2018 (herein **Black Arrows**) (see PTO-892, Page 1, Ref X).

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.

A designer may point out and claim a design within the environment of a larger design. In this scenario, determining novelty and non-obviousness calls for considering whether a design that looks like the claim was already in existence, whether in isolation or within environment. Without the liberty to make that consideration, the peculiarity of the selection, per se, becomes the novelty of the design. With a design that exists around or within other designed environment, there may be no reason for that particular design to exist independently in the prior art. This does not imply that it is not in itself, a design. Therefore, requiring the prior art to show a design in existence in isolation cannot be the standard for evaluating designs understood to exist within other designed environment, as with the instant claim.

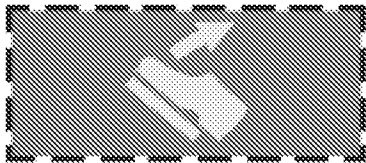
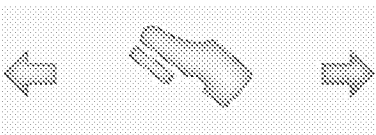
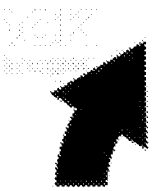
The design of Cadillac has basically the same design characteristics as the claimed design, in that both designs disclose a similar shaped shoe, a thick line of similar weight underneath the shoe, a gap between the shoe and the thick line of similar weight, and a rightward pointing arrow to the right of the shoe.

The claimed design is different from the design of Cadillac in that the arrow is curved and arranged diagonally above the shoe, and the thick line below the shoe is slightly more elongated. The design of Mazda discloses a design with basically the same design characteristics

as the claim, in that both designs disclose a similar shaped shoe, a thick line of similar weight and length underneath the shoe, a gap between the shoe and the thick line of similar weight and length, and one arrow arranged above the toe portion of the shoe.

The claimed design is different from the design of Mazda in that the pedal does not have an intersecting line and the arrow is slightly curved and points away from the icon.

Black Arrows shows a rounded arrow pointing away.

Claimed Design	Cadillac	Mazda	Black Arrows
			

It would have been obvious to modify Cadillac by elongating the pedal and placing the arrow above the toe box of the shoe, as seen in Mazda, or to modify Mazda by using the shoe icon seen in Cadillac, and by pointing the arrow away and rounding it, as taught by Black Arrows.

Any further difference is not significant enough to warrant a patent for the overall appearance of the claimed design over the prior art. *In re Lapworth*, 172 USPQ 129 (CCPA 1971); *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (1961).

This modification of the primary references 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).

Cadillac and Mazda are so related in that they are both graphical user interfaces showing shoe icons above a thick line indicative of a pedal and an arrow. The secondary reference is so related in that it shows a range of arrow icon types.

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 differences between the claimed design and the prior art are such that the claimed design as a whole would have been obvious before the effective filing date of the claimed design to a person having ordinary skill in the art to which the claimed design pertains.

Conclusion

The claim stands rejected under 35 U.S.C. 171 and 35 U.S.C. 103. The prior art made of record and not relied upon is considered pertinent to the appearance of the claimed design.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M. Vine whose telephone number is (571)272-1348. The examiner can normally be reached Monday-Thursday, 6 a.m-4 p.m. ET.

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>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shannon Morgan can be reached on (571)272-7979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A.M.V./
Examiner, Art Unit 2913

/RACHEL A. VOORHIES/
Primary Examiner, Art Unit 2923



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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
29/798,750	07/09/2021	Xi CHEN	1612.881

CONFIRMATION NO. 7527

INFORMAL NOTICE



26396
SAIDMAN DESIGNLAW GROUP
George D. Raynal
8601 GEORGIA AVE
SUITE 603
SILVER SPRING, MD 20910

Date Mailed: 07/14/2021

INFORMATIONAL NOTICE TO APPLICANT

Applicant is notified that the above-identified application contains the deficiencies noted below. No period for reply is set forth in this notice for correction of these deficiencies. However, if a deficiency relates to the inventor's oath or declaration, the applicant must file an oath or declaration in compliance with 37 CFR 1.63, or a substitute statement in compliance with 37 CFR 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment. See 37 CFR 1.53(f).

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

- A properly executed inventor's oath or declaration has not been received for the following inventor(s):
Xi CHEN
Kohei Morotomi

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

/elbanaybanay/

Attorney Docket No.: 1612.881

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

DESIGN PATENT SPECIFICATION

To All Whom It May Concern:

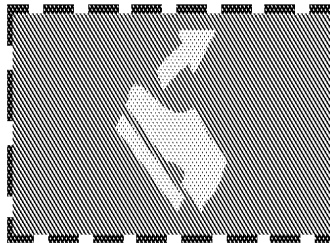
BE IT KNOWN THAT WE, Xi CHEN and Kohei MOROTOMI, have invented a new, original and ornamental design for a **DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE** of which the following is a specification, reference being had to the accompanying drawings forming a part hereof.

Cross-Reference to Related Application

This application claims priority from Japanese Design Application No. 2021-000441, filed January 11, 2021, which is expressly incorporated by reference herein.

- ⌘ The sole figure shows a front view of a display screen or portion thereof with graphical user interface showing the claimed design.

1/1



WE CLAIM:

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