



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/373,729	05/16/2011	Richard A. Carlow	19007.105001	4807
59081	7590	07/07/2014	EXAMINER	
KING & SPAIDING, I.I.P. 1100 LOUISIANA ST., STE. 4000 ATTN.: IP Docketing HOUSTON, TX 77002-5213			CHILCOT, RICHARD E	
			ART UNIT	PAPER NUMBER
			2916	
			NOTIFICATION DATE	DELIVERY MODE
			07/07/2014	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):

jvillegas@kslaw.com
houpatentdocket@kslaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD A. CARLOW, EUGENIA J. CHEN,
MICHAEL J. CHEN, CRAIG STEEL, ASHLEY TILLING,
ROOZBEH MOUSAVI, and DAVID T. HAMM

Appeal 2014-005649
Application 29/373,729
Technology Center 2900

Before: JOHN C. KERINS, BIBHU R. MOHANTY, and JILL D. HILL,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard A. Carlow, Eugenia J. Chen, Michael J. Chen, Craig Steel, Ashley Tilling, Roozbeh Mousavi, and David T. Hamm, (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting the single design claim pending in this reissue application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention relates to a design for 3D glasses. The claim on appeal is: The ornamental design for 3D glasses, as shown and described.

U.S. Patent No. D616,486 S, issued May 25, 2010, containing Figures 1 to 7 and a written description of those figures.

In the reissue declaration accompanying the reissue application, Appellants stated that they believe their patent "to be wholly or partly inoperative or invalid by reason of the patentees claiming more or less than patentees had a right to claim in the patent." Reissue Application Declaration and Power of Attorney by the Inventors, p. 2.

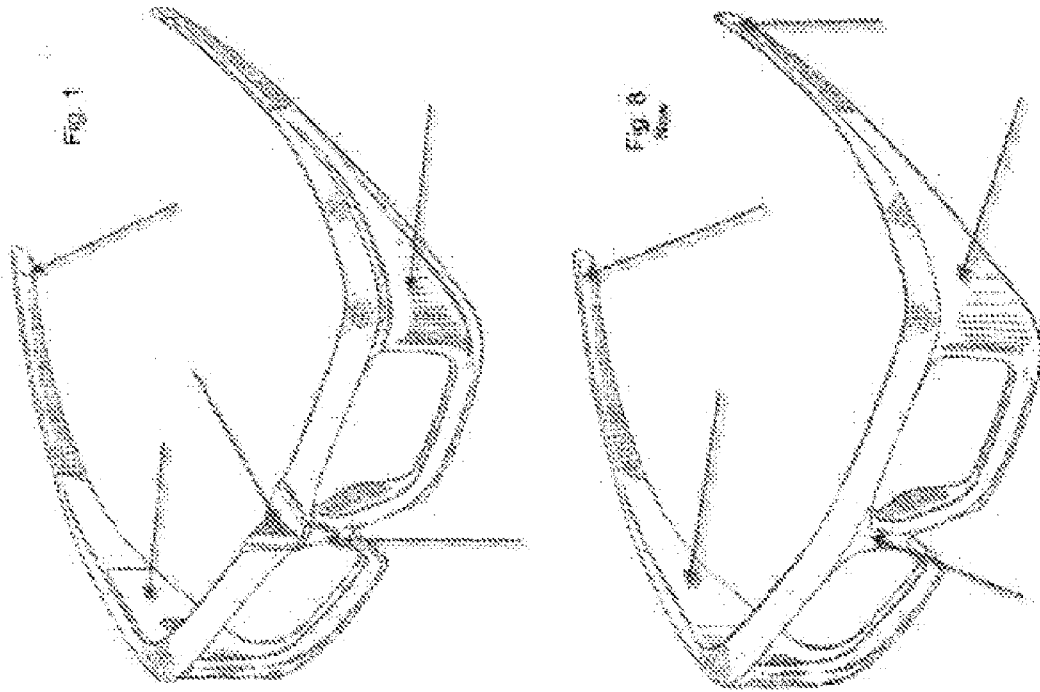
REJECTIONS

Claim 1 stands rejected as being based on a defective reissue declaration under 35 U.S.C. § 251. Ans. 2.

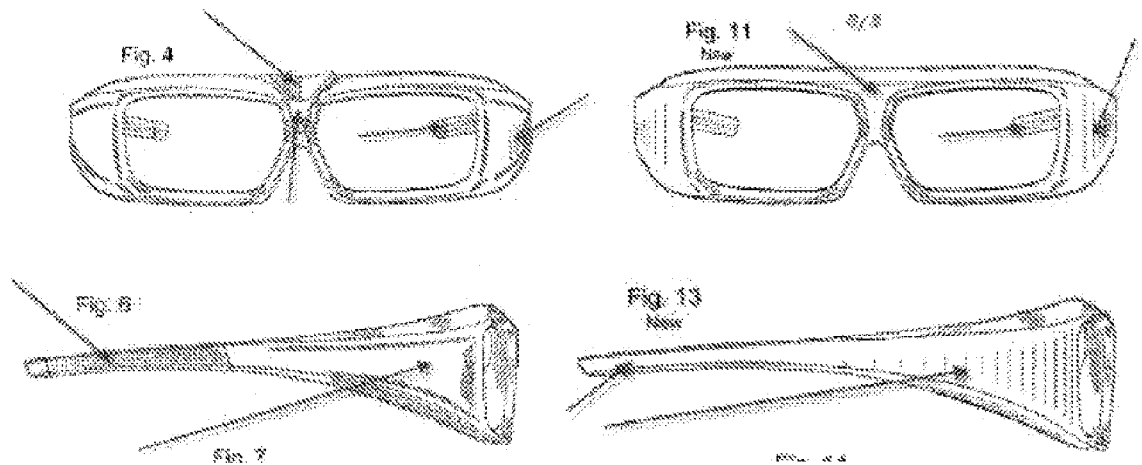
OPINION

The Examiner determined that the reissue declaration was defective because "[t]he additional drawings presented by the amendment filed May 16, 2011, are not supported by the original Patent. Without any antecedent support, the newly added drawings correct no error in the Patent." Ans. 2.

The Examiner also found that “removal of specific features from each set of drawing[s] constitutes new designs which were not previously disclosed.” *Id.* The Examiner compares Appellants’ patented design to added Figures 8–14 in the annotated figures below, with the figures on the left depicting some views of the patented design and the figures on the right depicting corresponding views representing the subject matter of Figures 8–14.



Ans. 3.



Ans. 4.

Appellants argue that “the ornamental design of Figs. 8-14 was fully disclosed in the ornamental design of original Figs. 1-7 because the changes made to arrive at the ornamental design of Figs. 8-14 merely constitute removing mere minor overlying ornamental elements included in the original Figs. 1-7.” App. Br. 5. Appellants argue that, therefore, the rejection of claim 1, as based on a defective reissue declaration, should be withdrawn. *Id.* (citing *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998)).

Regarding Appellants’ reliance on *In re Daniels*, the court in *Daniels* permitted, in a subsequent application, the removal of surface ornamentation (a leaf pattern) in a claimed design depicted in an earlier application because the surface ornamentation *did not obscure* the underlying design, *all details of which* were visible in the drawings of the earlier filed application. *See Daniels*, 144 F.3d at 1457. The surface ornamentation was considered a “mere indicium that did not override the underlying design.” *Id.* Because the superimposition of the surface ornamentation upon the underlying design did not obscure the underlying design itself, the court considered the prior application to have provided support for the broader subject matter claimed in the second application, thereby entitling the appellant to benefit under 35 U.S.C. § 120 of the earlier filing date.

The facts of Appellants’ feature removal can be distinguished from the facts presented in *Daniels*. Unlike the leaf pattern surface ornamentation removed from *Daniels*’ device, Appellants’ “trapezoid-shaped ornamental detail . . . at the top-center of the front frame” and “pronounced dip” “underlying the location of the . . . trapezoid-shaped ornamental detail” (App. Br. 3), obscure the underlying design itself. Removal of these

Appeal 2014-005649
Application 29/373,729

elements of Appellants' design, and the subsequent replacement of these elements with a smooth surface in Figures 8–14, is not supported by Appellants' original disclosure. We therefore sustain the Examiner's rejection of claim 1 as based on a defective reissue declaration under 35 U.S.C. § 251.

AFFIRMED

Tkl/pgc