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29/373,730	05/16/2011	Richard A. Carlow	092847.001099	1801
59081	7590	07/30/2014	EXAMINER	
KING & SPAIDING, I.L.P. 1100 LOUISIANA ST., STE. 4000 ATTN.: IP Docketing HOUSTON, TX 77002-5213			CHILCOT, RICHARD E	
			ART UNIT	PAPER NUMBER
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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 2014-005760
Application 29/373,730
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. D613,328 S, issued April 6, 2010, containing Figures 1 to 7 and a written description of those figures.

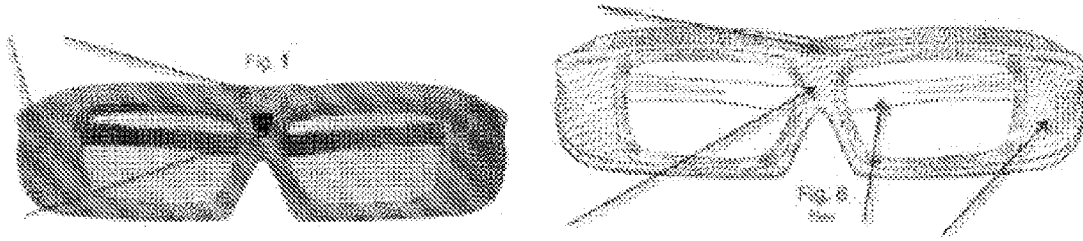
In the reissue declaration accompanying the reissue application, Appellants stated that they believe their patent "to be wholly or partly inoperative or invalid by reason of the patentees claiming more or less than patentees had a right to claim in the patent." Reissue Application Declaration and Power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

REJECTIONS

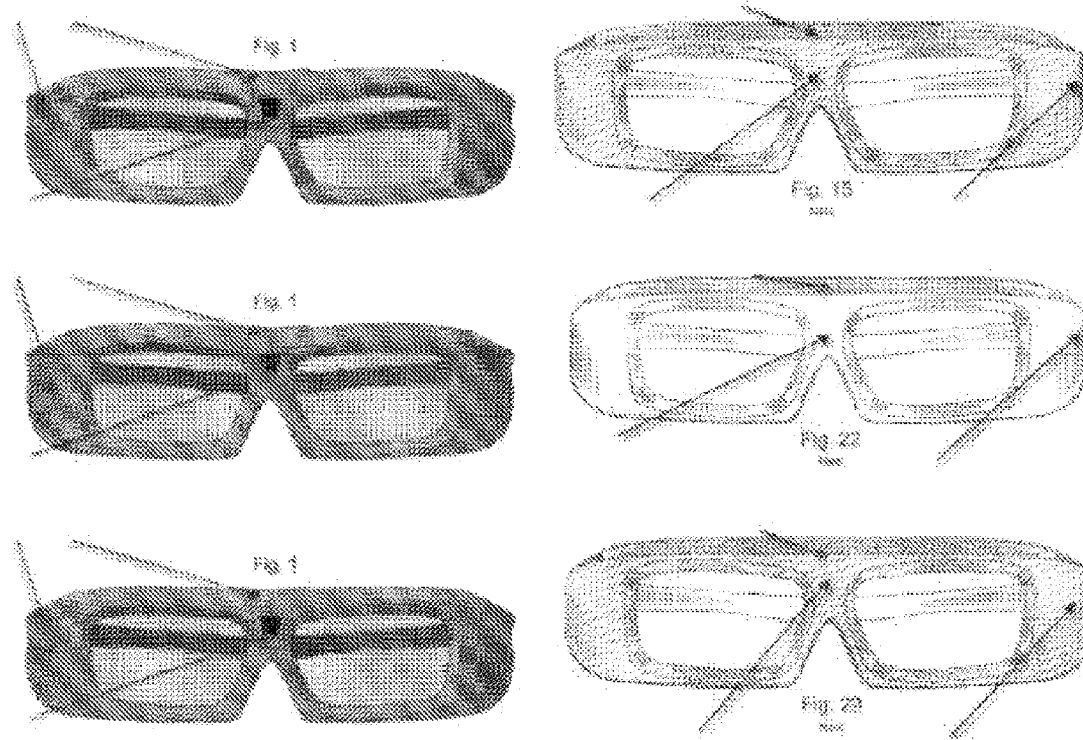
Claim 1 stands rejected as being based on a defective reissue declaration under 35 U.S.C. § 251. Ans. 2.

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, 15, 22, and 29 in the annotated figures below, with the figures on the left depicting Figure 1 of the sole embodiment of the patented design and the figures on the right depicting views representing separate new embodiments depicted in Figures 8, 15, 22, and 29.



Ans. 3.



Ans. 4.

Appellants argue:

The ornamental design of Figs. 8-35 is clearly visible in the original ornamental design of Figs. 1-7, demonstrating to an artisan viewing the reissue application that the inventors had possession at that time of the later claimed, and broader, design of Figs. 8-35. The ornamental elements removed from the original design of Figs. 1-7 to arrive at the broader ornamental design of Figs. 8-35 are mere minor overlying ornamental elements that do not override the underlying design of Figs. 8-35.

App. Br. 11. Appellants argue that, therefore, the rejection of claim 1, as based on a defective reissue declaration, should be withdrawn. *See 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 does 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" (App. Br. 3, 5, 7, 9) and "dip along the upper surface of the front frame" (App. Br. 5, 8, 10), obscure the underlying design of the external surface. Removal of these elements of Appellants' design, and the subsequent replacement of these elements with a smooth external surface in Figures 8–35, is not supported by Appellants' original disclosure. In addition, Appellants' "battery cover on the inside of the right temple" (App. Br. 3, 5, 7, 9) obscures the underlying design of the internal surface, and *removal* of Appellants' "depression . . . on the inside of

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the temples” feature (App. Br. 5, 7, 9), which is not an overlying ornamental element at all, would not produce the smooth surface at the temples shown in Appellants’ drawings presented by the amendment filed May 16, 2011. Removal of these elements of Appellants’ design, and the subsequent replacement of these elements with a smooth surface in Figures 8–35, 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

pgc