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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,497	04/28/2015	D559197	131131.00049	3198

14458                      7590                      07/14/2015  
Hanley, Flight and Zimmerman, LLC (Sonos, Inc)  
150 S. Wacker Drive  
Suite 2200  
Chicago, IL 60606

EXAMINER
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LY, DARLINGTON

ART UNIT	PAPER NUMBER
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2914

MAIL DATE	DELIVERY MODE
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07/14/2015

PAPER

**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.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/013,497.

PATENT NO. D559197 ET AL..

ART UNIT 2914.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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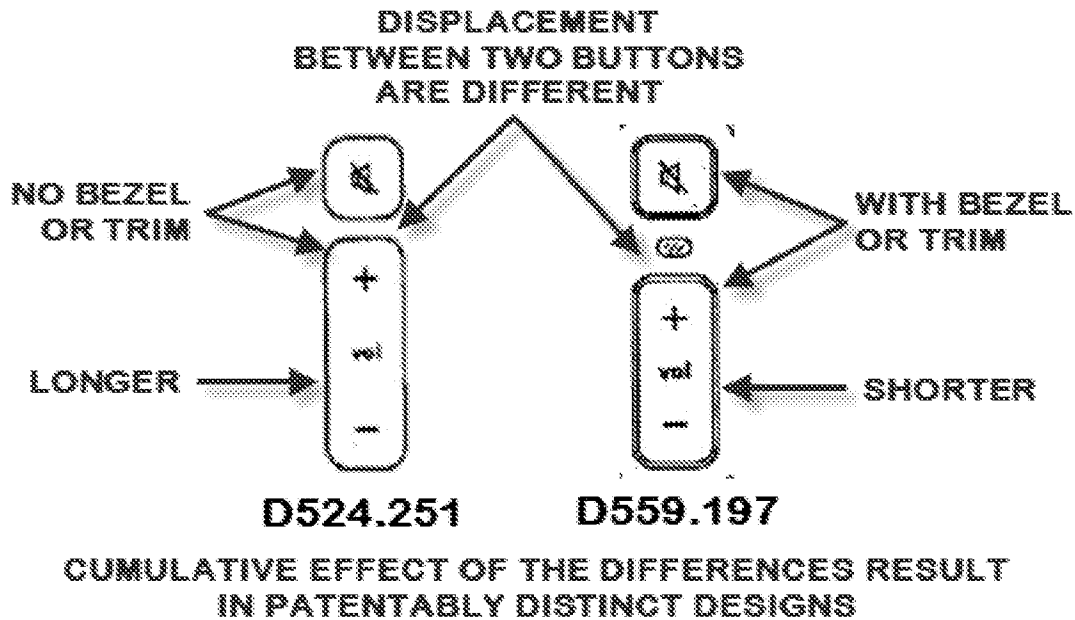
**DECISION GRANTING EX PARTE REEXAMINATION****Remarks**

1. The present application is being reexamined under the pre-AIA first to invent provisions.
2. In this request for reexamination, the requester asserts the design in U.S. Patent D559,197, which issued 08 January 2008 to Lim et al. (hereinafter "the '197 Patent"), is identical to the designs of the *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* that were on sale and publicly available since at least 31 January 2005. The requester further contends that the '197 Patent is not entitled to benefit from the filing date of 11 February 2004 to U.S. Patent D524,251 (hereinafter "the '251 Patent") because the '197 Patent adds new matter not supported in the earlier patent. As a consequence, the earliest priority date of the '197 Patent for the purposes of prior art consideration is its filing date of 01 May 2006.
3. In consideration of the aforementioned dates, the sale and publication of the *Sonos ZonePlayer ZP100*, the *Sonos Controller CR100* since 31 January 2005 and the '197 claim to continuity, the examiner agrees that a substantial new question of patentability affecting the claim of United States Patent Number D559,197 is raised by the request for *ex parte* reexamination.
4. Further details in the decision to grant an *ex parte* reexamination is set forth below:

**Domestic Priority**

5. The '197 Patent was filed on 01 May 2006 as a continuation of '251 Patent, to which was filed on 11 February 2004. The requestor contends that the '197 Patent was not entitled to the earlier priority date of the '251 Patent. The examiner agrees with the requestor in their analysis. The claim to priority under *35 U.S.C. § 120* is improper and consideration of prior art may be based on the actual filing date of the '197 application.
6. The design in the '197 Patent is different from that of the earlier patent in that the two buttons forming the control strip are shown raised significantly from the surface of the electronic device, includes a pronounced narrow bevel at the top edge of each button, the bottom button is significantly shorter in length, and the displacement between the buttons is greater. These cumulative effect of these differences result in the '197 design being new relative to the '251 design.

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7. Therefore the claim in the '197 Patent does not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, needed to receive the benefit of the '251 filing date under 35 U.S.C. § 120. When a design is changed, the result is a new and different design; the original design remains just what it was.<sup>1</sup> Without the benefit of the filing date in the '251 Patent the *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* qualifies as prior art under 35 U.S.C.
8. § 102(b).
9. Given the proper priority date, the new teachings of the *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* are such that a reasonable examiner would consider the new teachings to be important in deciding to allow the claim being considered.

#### **Substantial New Question of Patentability**

10. The claim in the above patent is directed to a volume control strip with a rectangular shaped bottom button and a squared shaped top button that is suitable for electronic appliances or devices.
11. The requestors' cited two NPL references, *The Advent of Multi-Room Digital Music: An Overview of the Sonos Digital Music System*, as published by The Envisioneering, and the Wayback Machine Images of Sonos Website both discloses the same products of the *Sonos ZonePlayer*

<sup>1</sup> In re Mann, 8 USPQ2d 2030 (Fed. Cir. 1988)

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*ZP100* and the *Sonos Controller CR100*. Moreover, both cited NPL references showing the same *Sonos* products raises a substantial new question of patentability for the same following reason:

12. The *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* show a vertically oriented control strip having a top squared button, bottom rectangular button of equal width, a thin bezel surrounding each button, and a shallow depth to each of the buttons. Moreover, the *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* shows the buttons in a vertical alignment and describes various distances of separation between the buttons.
13. Therefore, the references of the *Sonos ZonePlayer ZP100* and the *Sonos Controller CR100* shows a control strip design with an overall appearance that is sufficiently similar to that of the claimed design to serve as a reference in an anticipation analysis. The disclosures of the *Sonos* products could also serve as primary references in an obviousness analysis because they disclose overall appearances having design characteristics that are basically the same as those of the claimed design. The cited references were not previously considered nor addressed in the prior examination of the patent or final hold of invalidity by the Federal Courts and there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable.
14. In view of the foregoing, the examiner has concluded that a substantial new question of patentability is found and reexamination is warranted.

#### **Additional Information**

15. Extensions of time under *37 CFR § 1.136(a)* will not be permitted in these proceedings because the provisions of *37 CFR § 1.136* apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, *35 U.S.C. § 305* requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (*37 CFR § 1.550(a)*). Extensions of time in *ex parte* reexamination proceedings are provided for in *37 CFR § 1.550(c)*.

#### **Litigation Activity**

16. The patent owner is reminded of the continuing responsibility under *37 CFR § 1.565(a)*, to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. D559,197 throughout the course of this reexamination proceeding. See *MPEP §§ 2207, 2282 and 2286*.

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### **Conclusion**

In summary, the two pieces of prior art submitted by the requester raise a substantial new question of patentability affecting the claim of United States Patent Number D559,197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darlington Ly whose telephone number is 571-272-2617. The examiner can normally be reached on *Monday - Friday From 9AM-5PM*. If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Philip Hyder can be reached on 571-272- 2621. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in the USA or CANADA) or 571-272-1000.

/D. L./  
Examiner, Art Unit 2914

/PHILIP S HYDER/  
Primary Examiner, Art Unit 2917

Conferees:

/Adir Aronovich/

/Joel Sincavage/

<b>Order Granting Request For Ex Parte Reexamination</b>	<b>Control No.</b> 90/013,497	<b>Patent Under Reexamination</b> D559197 ET AL.
	<b>Examiner</b> DARLINGTON LY	<b>Art Unit</b> 2914

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

The request for *ex parte* reexamination filed 28 April 2015 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)  PTO-892,      b)  PTO/SB/08,      c)  Other: IDS dated 04/28/2015

1.  The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/DARLINGTON LY/ Examiner, Art Unit 2914		
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