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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,952	05/08/2017	D746078	812.008RE	5275
28083	7590	07/05/2017	EXAMINER	
Goldberg Cohen LLP 1350 Avenue of the Americas 3rd Floor New York, NY 10019			RUDZINSKI, KEVIN KEITH	
			ART UNIT	PAPER NUMBER
			2911	
			MAIL DATE	DELIVERY MODE
			07/05/2017	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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1350 AVENUE OF THE AMERICA

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NEW YORK, NY 10019

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/013,952.

PATENT NO. D746078.

ART UNIT 2911.

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)).

DECISION GRANTING EX PARTE REEXAMINATION

A substantial new question of patentability affecting the claim of United States Patent Number D746,078 (hereinafter '078) is raised by the request for *ex parte* reexamination.

References Cited in Request for Reexamination

The requester presented the following prior art publications in the request for reexamination of the single claim of US Patent D746,078:

- A. Karti Marketing Materials flyer published 2013 and Facebook post published on November 9, 2013 (Ex. 4);
- B. U.S. Patent No. 5,111,868 by Sawaya issued May 12, 1992 (Ex. 5);
- C. Chinese Patent No. CN 203852180 by Xihuai issued October 1, 2014 (Ex. 6);
- D. Chinese Design Patent No. CN 302766325 by Xianhuai issued March 19, 2014 (Ex. 7);
- E. Statement of Undisputed Facts Material to Carnation's Motion for Summary Judgment, Pursuant to Local Rule 56.1, United States District Court for the S.D.N.Y. filed July 27, 2009 (Ex. 8);
- F. U.S. Patent No. 6,376,777 by Ito issued April 23, 2002 (Ex. 9);
- G. U.S. Patent No. 676,650 by Mendels issued June 18, 1901 (Ex. 10);
- H. U.S. Patent Pub. No. 2008/0178423 by Patel filed December 15, 2006 (Ex. 11); and
- I. U.S. Patent No. 6,494,248 by Zahner issued December 17, 2002 (Ex. 12).

Comment on Claim for Domestic Priority

The D746,078 patent, issued from application 29/530,488, claims priority to application 14/458,664. However, the claim for priority is improper. Specifically, the parent application '664 does not disclose the design as is presented in the child application '488. The later-filed application must be an application for a patent for an invention, which is also disclosed in the prior application. The disclosure of the invention in the parent application and in the later-filed application must be sufficient

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to comply with the requirements of 35 U.S.C. 112(a). See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971) and *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551,32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application '664 fails to provide adequate support for the claim of the later-filed application '488 in accordance with 35 U.S.C. 112(a). Application '488 claims the ornamental design for a shower curtain having a set of curtain rings with a specific spatial relationship between two rings and a particular thickness of the face of the rings. However, application '664 provides a single front elevation view (FIG. 21) of an embodiment having the appearance of the claim in application '488, without disclosing a specific thickness and without the additional curtain ring to form a set. To attempt to arrive at the claim of application '488, one must pick and choose design characteristics from several embodiments in application '664, but the exact ratios, spatial relationship and thicknesses would not be consistent with what is shown in application '488. Top views are provided in FIGS. 4C, 7, 8, 10 and 29 but the embodiment containing FIG. 21 makes no connection to the top views in the written description, making it impossible to determine how the design shown in FIG. 21 relates to the other embodiments. Since application '664 does not show or describe how the embodiment containing FIG. 21 would look applied to a curtain with additional rings, to disclose the exact spatial relationship between two rings, and does not provide a view or description of the exact thickness of the ring, the claim of application '488 presents subject matter that has no support from application '664. Accordingly, the claim for domestic priority is improper, making the effective filing date of the '488 application 06/17/2015.

Substantial New Question of Patentability

The claim in D746,078 is directed to the design for a shower curtain. The following cited references raise substantial new questions of patentability as to the claim of '078 for the reasons stated:

A. Karti Marketing Materials flyer published 2013 and Facebook post published on November 9, 2013 (Ex. 4)

The EZY-HANG shower curtain rings shown in Karti Marketing Materials (Exhibit 4) discloses a design for a pair of shower curtain rings that has an overall appearance that is substantially the same as that of the claimed design in '078 according to the test of anticipation. Specifically, the claim in '078 and

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the rings in the Karti Marketing Materials show a set of U-shaped curtain rings with a curved bottom edge and flat top edge, a circular aperture in the center, having a specific thickness visible from perspective views and include a top edge of a curtain-like feature with a particular space between rings.

The Karti Marketing Materials (Exhibit 4) was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider the Karti Marketing Materials important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

B. U.S. Patent No. 5,111,868 by Sawaya issued May 12, 1992 (Ex. 5)

The REPLACEMENT EYELET FOR FLEXIBLE CURTAINS by Sawaya (US Patent 5,111,868) contains a design for a curtain ring that could serve as a secondary reference in an obviousness analysis because said reference shows individual design features that are similar to those of the claimed design in '078. Both the REPLACEMENT EYELET FOR FLEXIBLE CURTAINS by Sawaya and the patented design in '078 show a curtain ring having a rounded bottom edge and flat top edge with a circular aperture in the center and a similar thickness. The reference is so related to the claimed design in '078 that the appearances of those features would suggest their application to a primary reference in an obviousness analysis.

REPLACEMENT EYELET FOR FLEXIBLE CURTAINS by Sawaya was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider said reference important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

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C. Chinese Patent No. CN 203852180 by Xihuai issued October 1, 2014 (Ex. 6)

The Chinese Patent No. CN 203852180 contains a design for a curtain ring that could serve as a secondary reference in an obviousness analysis because said reference shows individual design features that are similar to those of the claimed design in '078. Both CN 203852180 and the patented design in '078 show a curtain ring having a rounded bottom edge and flat top edge with a circular aperture in the center. The reference is so related to the claimed design in '078 that the appearances of those features would suggest their application to a primary reference in an obviousness analysis.

CN 203852180 was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider said reference important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

D. Chinese Design Patent No. CN 302766325 by Xianhuai issued March 19, 2014 (Ex. 7)

The Chinese Patent No. CN 302766325 contains a design for a curtain ring that could serve as a secondary reference in an obviousness analysis because said reference shows individual design features that are similar to those of the claimed design in '078. Both CN 302766325 and the patented design in '078 show a curtain ring having a rounded bottom edge and flat top edge with a circular aperture in the center. The reference is so related to the claimed design in '078 that the appearances of those features would suggest their application to a primary reference in an obviousness analysis.

CN 302766325 was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

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There is a substantial likelihood that a reasonable examiner would consider said reference important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

E. Statement of Undisputed Facts Material to Carnation's Motion for Summary Judgment, Pursuant to Local Rule 56.1, United States District Court for the S.D.N.Y. filed July 27, 2009 (Ex. 8)

The Carnation reference contains a design for a curtain ring that could serve as a secondary reference in an obviousness analysis because said reference shows individual design features that are similar to those of the claimed design in '078. Both Carnation and the patented design in '078 show a curtain ring having a rounded bottom edge and flat top edge with a circular aperture in the center, having substantially the same appearance in front elevation views. The reference is so related to the claimed design in '078 that the appearances of those features would suggest their application to a primary reference in an obviousness analysis.

Carnation was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider said reference important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

F. U.S. Patent Pub. No. 2008/0178423 by Patel filed December 15, 2006 (Ex. 11)

The HOOKFREE CURTAIN AND FIXTURE THEREOF by Patel (US Patent Publication 2008/0178423) contains a design for a set of curtain rings that could serve as a primary reference in an obviousness analysis because the overall appearance of the design has design characteristics that are basically the same as those of the claimed design. Specifically, the rings in the HOOKFREE CURTAIN AND FIXTURE THEREOF by Patel and the claim show a set of U-shaped curtain rings with a curved bottom edge and flat top edge, a circular aperture in the center, having a specific thickness visible from perspective views and

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include a top edge of a curtain-like feature with a particular space between rings. The reference is so related to the claimed design in '078 that the appearance of the set of U-shaped curtain rings would suggest its application as a primary reference in an obviousness analysis.

The HOOKFREE CURTAIN AND FIXTURE THEREOF by Patel was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider the HOOKFREE CURTAIN AND FIXTURE THEREOF by Patel important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

G. U.S. Patent No. 6,494,248 by Zahner issued December 17, 2002 (Ex. 12)

The SUSPENDED MATERIALS HAVING EXTERNAL SLITS by Zahner (US Patent 6,494,248) contains a design for a set of curtain rings that could serve as a primary reference in an obviousness analysis because the overall appearance of the design has design characteristics that are basically the same as those of the claimed design. Specifically, the rings in the SUSPENDED MATERIALS HAVING EXTERNAL SLITS by Zahner and the claim show a U-shaped curtain ring with a curved bottom edge and flat top edge and a circular aperture in the center. The reference is so related to the claimed design in '078 that the appearance of the U-shaped curtain ring in FIG. 21 would suggest its application as a primary reference in an obviousness analysis.

The SUSPENDED MATERIALS HAVING EXTERNAL SLITS by Zahner was not considered nor addressed in the prior examination of the patent or in a final holding of invalidity by the Federal Courts.

There is a substantial likelihood that a reasonable examiner would consider the SUSPENDED MATERIALS HAVING EXTERNAL SLITS by Zahner important in deciding whether or not the claim is patentable. Therefore, the reference is sufficient to raise a substantial new question of patentability.

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Substantial New Question of Patentability Not Raised

The following cited references do not raise a substantial new question of patentability as to the claim of '078 for the following reasons:

H. U.S. Patent No. 6,376,777 by Ito issued April 23, 2002 (Ex. 9)

The GROMMET by Ito et al. (US Patent 6,376,777) does not contain a design that has an overall appearance that is substantially the same as that of the claimed design and could not serve as a primary reference in an obviousness analysis. Further, the characteristics that are considered similar are merely simple and common shapes. Specifically, the only similarity among the claimed design and the GROMMET by Ito et al. is the overall U-shape of the design and a circular aperture in the center.

The GROMMET by Ito et al. was not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts.

There is not a substantial likelihood that a reasonable examiner would consider the GROMMET by Ito et al. important in deciding whether or not the claim is patentable. Therefore, the reference is not sufficient to raise a substantial new question of patentability.

I. U.S. Patent No. 676,650 by Mendels issued June 18, 1901 (Ex. 10)

The COAT HOLDER by Mendels (US Patent 676,650) does not contain a design that has an overall appearance that is substantially the same as that of the claimed design in '078 according to the test of anticipation since it only discloses a single feature rather than two rings with a claimed edge of fabric between the two rings. Further, although the COAT HOLDER by Mendels has an overall appearance that is substantially the same as that of one of the rings in the claimed design, the reference would not be considered analogous art with the claim of '078, and therefore could not serve as a primary reference or a secondary reference in an obviousness analysis. Specifically, a designer having ordinary skill in the art of shower curtains would not apply the appearance of a coat holder to curtain rings.

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The COAT HOLDER by Mendels was not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts.

There is not a substantial likelihood that a reasonable examiner would consider the COAT HOLDER by Mendels important in deciding whether or not the claim is patentable. Therefore, the reference is not sufficient to raise a substantial new question of patentability.

Conclusion

Due to the aforementioned reasons, the examiner has concluded that a substantial new question of patentability is found and reexamination is warranted.

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).

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to:

Mail Stop Ex Parte Reexam

Central Reexamination Unit

Commissioner for Patents

United States Patent & Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to:

Application/Control Number: 90/013,952

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(571) 273-9900

Central Reexamination Unit

By hand:

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/KEVIN RUDZINSKI/

Primary Examiner, Art Unit 2911

Conferees:

/PHILIP S HYDER/

Primary Examiner, Art Unit 2917

Joel Sincavage /JS/

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/013,952	Patent Under Reexamination D746078 ET AL.
	Examiner KEVIN RUDZINSKI	Art Unit 2911

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

The request for *ex parte* reexamination filed 08 May 2017 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: _____

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.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
- b) by credit to Deposit Account No. _____, or
- c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/KEVIN RUDZINSKI/ Primary Examiner, Art Unit 2911		
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