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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PATRICK ALT and LISA FOELLINGER

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Appeal 2020-001447  
Application 35/502,286  
Technology Center 2900

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Before KEN B. BARRETT, GEORGE R. HOSKINS, and  
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s decision rejecting the pending design claim in this application under 35 U.S.C. § 112(a) as failing to comply with the written description requirement, and under 35 U.S.C. § 112(b) as indefinite. *See* Final Act. (dated June 15, 2018), 7–9. We have jurisdiction under 35 U.S.C. §§ 6(b) and 171(b).

We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies WEISS UMWELTTECHNIK GMBH as the real party in interest. Appeal Br. 1.

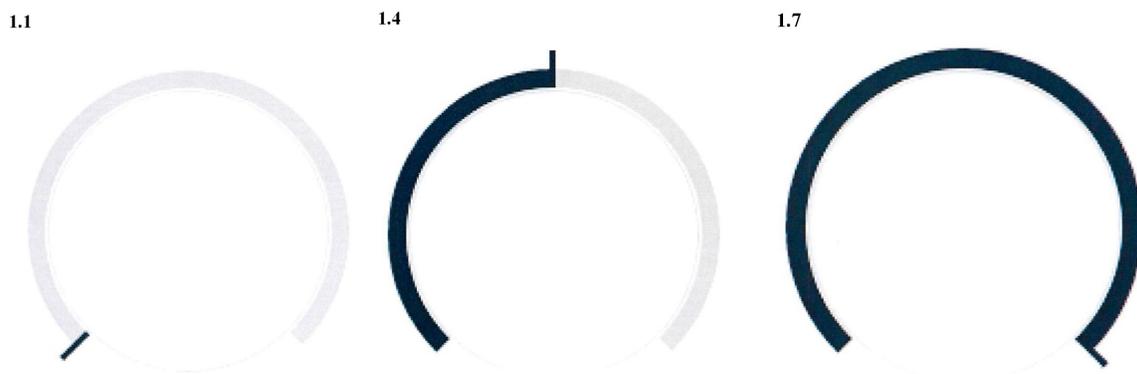
## CLAIMED DESIGN

This application was filed on January 13, 2017 (hereafter “the original Specification” or “Spec.”), and amended on March 21, 2018 (hereafter “the Amendment” or “Amend.”). Various aspects of this amendment are at issue on appeal, which we discuss in some detail here.

The original Title was “Animated icons.” *See* WIPO Int’l Reg. Pub. Data (Jan. 13, 2017), 2. This was amended to “Display Screen or Portion Thereof with Animated Icon.” *See* Amend. 2.

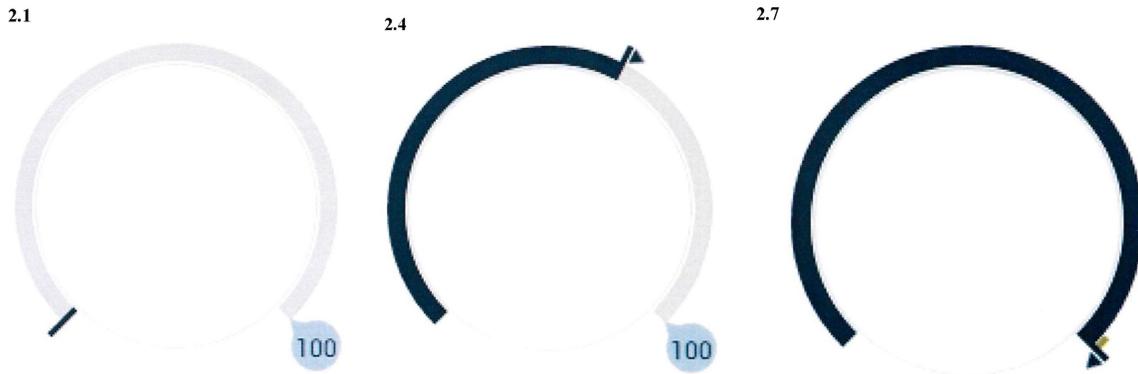
The original claim recited: “The ornamental design for measured value display as shown and described.” Spec. 3. This was amended as follows: “The ornamental design for a measured value display icon shown on a computer screen, monitor, other display panel, or a portion thereof, as shown and described.” Amend. 4.

The original application contained Figures 1.1–1.7, 2.1–2.7, 3.1–3.7, 4.1–4.7, 5.0, 6.0, and 7.0 (hereafter “Original Figures”). Spec. 1–2. Original Figures 1.1, 1.4, and 1.7 are reproduced here:



These figures are each described as “Front” views of an “Animated Icon.” Spec. 1.

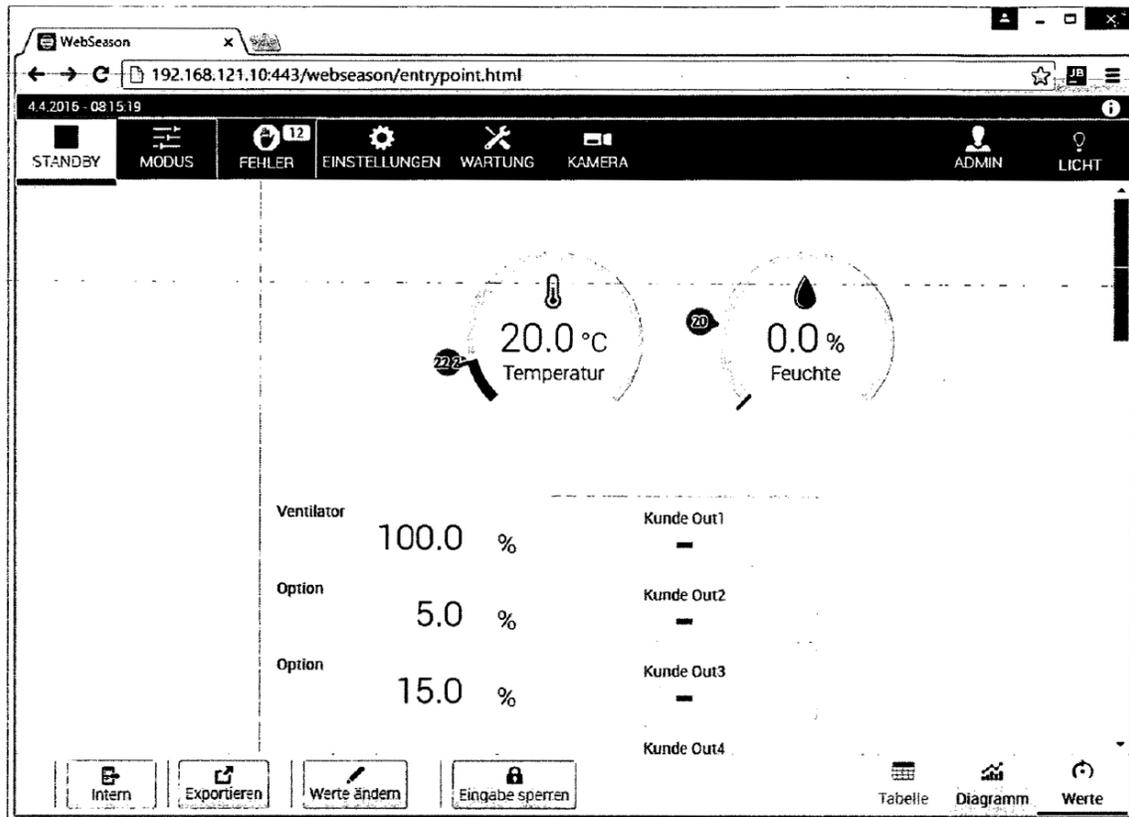
Original Figures 2.1, 2.4, and 2.7 are reproduced here:



These figures are each described as “Front” views of an “Animated Icon.”  
Spec. 1.

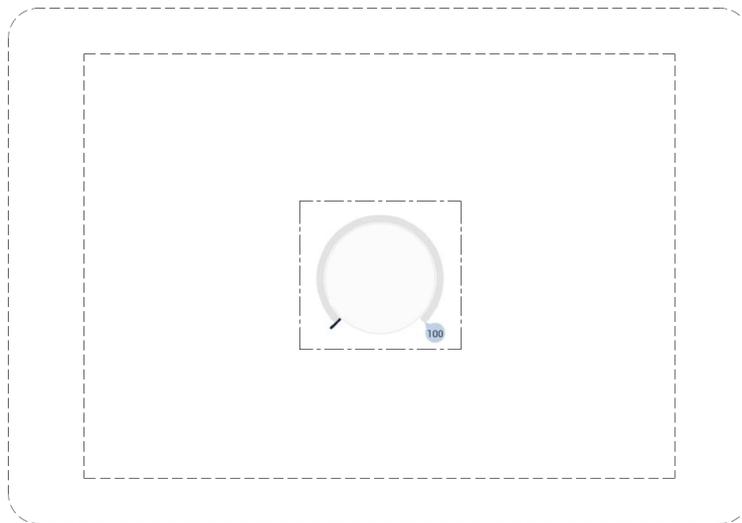
Original Figure 5.0 is reproduced here:

5.0



This figure is described as a “Front” view of a “Graphical User Interface.”  
Spec. 1–2.

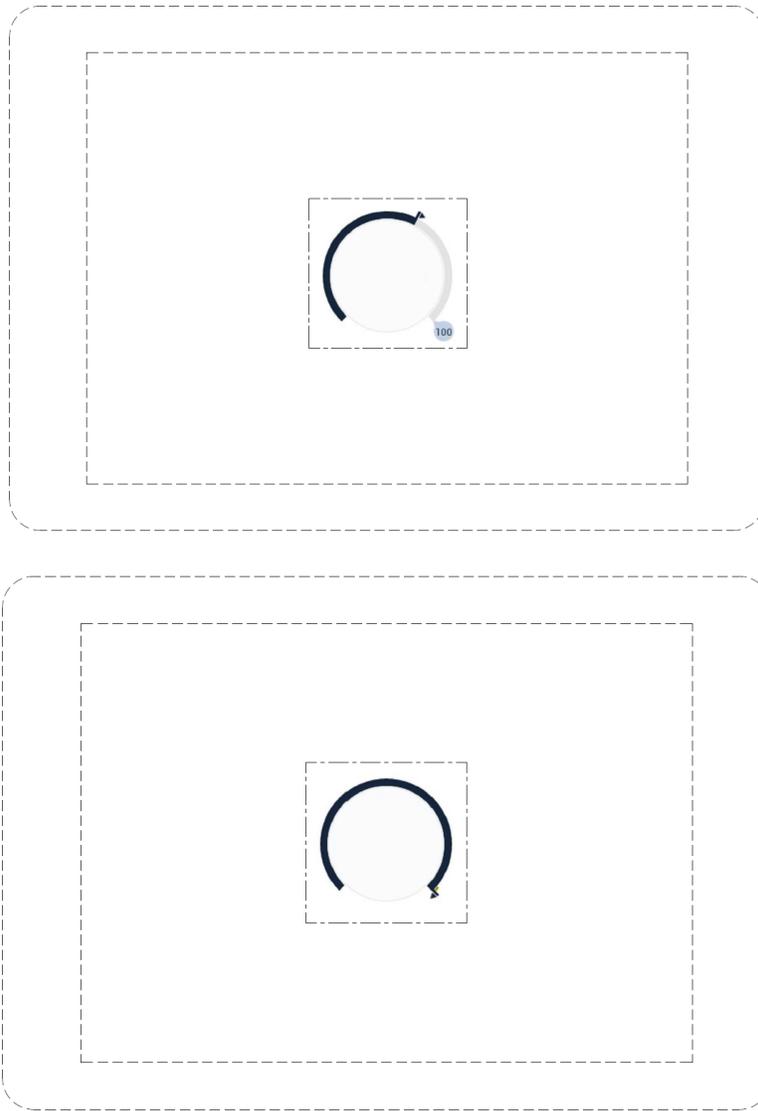
The Amendment canceled Figures 3.1–3.7, 4.1–4.7, 5.0, 6.0, and 7.0. Amend. 3. Appellant intended Figures 1.1–1.7 and 2.1–2.7 to remain in the application, in an amended form.<sup>2</sup> However, the submitted replacement drawing sheets contained only seven unnumbered replacement figures (hereafter “Replacement Figures”). It is undisputed that these unnumbered figures represent amendments to Original Figures 2.1–2.7.<sup>3</sup> The Replacement Figures that correspond to Original Figures 2.1, 2.4, and 2.7 are reproduced here:



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<sup>2</sup> See Amend. 3 (“Replacement sheets for Figs. 1.1–2.7 are submitted herewith.”); *id.* at 2 (amending descriptions of Figures 1.1–1.7 and 2.1–2.7).

<sup>3</sup> See, e.g., Final Act. 4 (stating the “Replacement Drawings only include reproductions 2.1–2.7,” and “the following action assumes this was an inadvertent omission” of reproductions 1.1–1.7); Response to Final Office Action (filed Aug. 13, 2018), 7 (“The last response inadvertently omitted the reproductions of Figs. 1.1–1.7”).



The Replacement Figures are described as showing “a transitional image icon that sequentially transitions between the Figures shown to illustrate a measurement value display for devices and apparatuses for measuring, controlling and regulating physical variables such as temperature and humidity.” Amend. 2.

OPINION

A. *Written Description*

1. *Displaying the Animated Icon on a Computer Display*

The Examiner rejected Appellant’s amended claim under 35 U.S.C. § 112(a) “as failing to comply with the description requirement.” Final Act. 7. The Examiner determined the original Specification “does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed” via the Amendment. *Id.* In particular, the Examiner found “there is no support in the original disclosure for the [amended] title ‘display screen or portion thereof with animated icon.’” *Id.*

The Examiner further determined Appellant’s “original claim referred to a ‘measured value display,’ which is understood to be an actual read-out that shows the numbers and the changing values and *not a display screen or a computer display.*” *Id.* at 7–8 (emphasis added). In particular, the Examiner discerned “no visual or verbal indications in the original disclosure that directs or guides one skilled in the art to the subject matter claimed,” and found “[t]here is nothing in the original disclosure to commend the overall appearance of the claimed design to a person of ordinary skill to the exclusion of any of a large number of other designs that might be later composed from the elements originally disclosed.” *Id.* at 8.

Appellant argues the original Specification supports the presently claimed animated icon shown on a “display screen” (Title) or “computer screen, monitor, [or] other display panel” (claim), which we shorten here to “computer display.” Appeal Br. 4. Appellant asserts the written description inquiry “requires an evaluation of the [originally-filed] disclosure as a

whole,” including all of Original Figures. *Id.* (emphasis by Appellant). Appellant contends the original Specification employs common computer terminology, in describing Figures 1–4 as illustrating “icons.” *Id.* at 5; Spec. 1. According to Appellant: “The term ‘icon’ . . . would be understood by one of ordinary skill in the art to identify a graphical symbol on a computer display screen,” so disclosure of an icon demonstrates possession of displaying the icon on a computer display. Appeal Br. 5 (citing dictionary definitions found in the Appeal Brief’s Evidence Appendix).

Appellant additionally relies on Original Figures 5.0 and 7.0, which were described as illustrating “Graphical user interfaces.” Appeal Br. 5; Spec. 1. According to Appellant: “The term ‘graphical user interface’ or ‘GUI’ is . . . a well-known term in computer fields,” and would be understood by one of ordinary skill in the art to mean “a user interface in which program features are represented by icons.” *Id.* (emphasis by Appellant) (quoting *McGraw Hill Dictionary of Computing & Communications*, found in the Appeal Brief’s Evidence Appendix). Thus, Appellant asserts “these definitions clarify that ‘icons’ are used on ‘graphical user interfaces,’” so a designer of ordinary skill in the art “would understand that the icons of Figs. 1–4 are correlated to the graphical user interface of Figs. 5–7.” *Id.* This is confirmed, in Appellant’s view, by the collection of Original Figures viewed as a whole, because Figures 5.0 and 7.0 illustrate graphical user interfaces including icons that are very similar to the icons illustrated in Figures 1.0–4.7. *Id.* at 6–7. Appellant thus concludes the Examiner’s narrow interpretation of the term “measured value display” in Appellant’s original claim, as not encompassing the presently claimed computer display, is inconsistent with the original Specification.

*See id.* at 7–8 (“The term ‘measured value display’ must include computer displays.”).

The Examiner answers that Appellant’s Original Figures 5.0 and 7.0 “were not . . . part of Embodiments 1 or 2 and no correlation was made between 1.1–1.7, 2.1–2.7 (Animated icons) and 5.0, 6.0, or 7.0 (Graphical User Interfaces).” Advisory Act. (Sept. 5, 2018). The Examiner’s position is that “[d]isclosure as a whole’ refers to the disclosure of the design,” which must be limited to the design elected by Appellant in response to the Examiner’s restriction requirement—that is, the icons shown in Original Figures 1.1–1.7 and 2.1–2.7. Ans. 6–7, 11, 13–14 (citing MPEP § 1504.05(II)(A)). This is because, in the Examiner’s view, the original Specification does not identify differences between embodiments, as is required for the disclosure in Figures 5.0–7.0 to provide antecedent basis for the proposed amendment in the elected invention of Figures 1.1–1.7 and 2.1–2.7. *Id.* Further according to the Examiner, “the animated icons claimed in 1.1–1.7 and 2.1–2.7 *are not shown in* reproductions 5, 6 or 7,” which instead show only “similar design features.” *Id.* at 11–12 (emphasis added), 13.

The Examiner moreover finds Appellant’s Specification describes Figures 1.1–1.7 and 2.1–2.7 as illustrating “animated icons,” *not* “computer icons or computer icons on a computer display.” Ans. 10 (emphasis omitted). The Examiner concludes the dictionary definitions of “icon” and “graphical user interface” proffered by Appellant are not probative of written description support here, because the Specification lacks “any direction or guidance . . . that the ‘icons’ occur on a computer display screen,” and “[t]he term ‘icon’ does not inherently identify a graphic symbol on a computer screen.” *Id.* at 10–11 (“An ‘icon’, according to

Merriam-Webster’s 5th definition of ‘icon’, is *a pictorial representation: IMAGE.*”). Thus, according to the Examiner, Appellant’s “animated icons could be an illustration as might be seen in a flipbook or in a step-by-step instruction manual.” *Id.* at 11.

Appellant replies that the Examiner errs in relying on Appellant’s election in response to a restriction requirement as limiting the written description inquiry to the elected embodiments. Reply Br. 1–2<sup>4</sup> (citing MPEP §§ 608 & 608.04(a)). Appellant also contends that, even if we apply MPEP § 1504.05(II)(A) as the test here, still the original Specification satisfies this test because it includes a descriptive statement identifying different embodiments of animated icons and graphical user interfaces. Reply Br. 2–3. Appellant also asserts the original Specification “included a single claim incorporating all seven embodiments,” because it recites: “The ornamental design for measured value display *as shown and described.*” *Id.* at 2 (emphasis added). Concerning the Examiner’s proffered definition of the term “icon,” Appellant asserts “[t]he ordinary and customary meaning of the term is not encompassed by the fifth definition,” and Appellant reiterates the original Specification taken as a whole demonstrates possession of the amended claim. *Id.* at 4 (emphasis by Appellant).

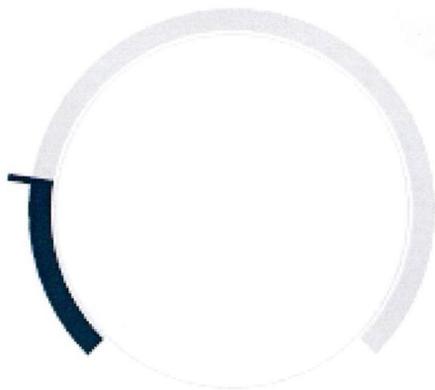
In short, the issue presented here is whether the original Specification provides written description support for the animated icons illustrated in Original Figures 1.1–1.7 and 2.1–2.7 being *shown on a computer display*. We conclude that it does.

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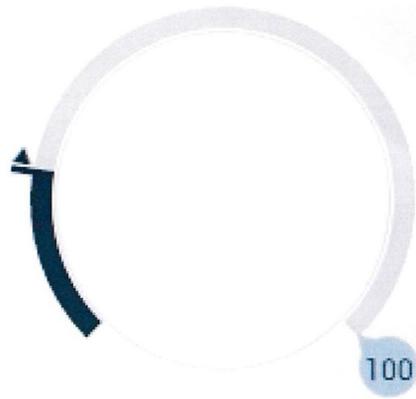
<sup>4</sup> The Reply Brief does not include page numbers. Our citations treat the cover page as page 1, and the concluding page bearing the electronic signature of Appellant’s representative as page 7.

The test for whether the written description requirement of § 112 is satisfied may be expressed in various ways, such as whether the application's original disclosure "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). An applicant need not "describe exactly the subject matter claimed," but "the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed." *Id.* (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)).

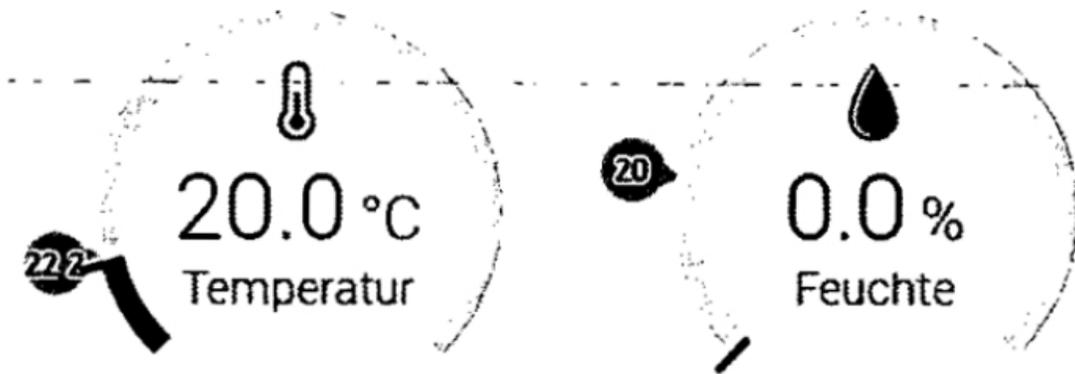
Here, the Examiner errs in requiring Appellant to describe exactly the subject matter claimed, instead of ascertaining whether the original Specification clearly allows a designer of ordinary skill in the art to recognize that Appellant invented what is claimed. *See Daniels*, 144 F.3d at 1456. In our view, the combination of the Original Figures taken as a whole would lead a designer of ordinary skill in the art to recognize that Appellant invented displaying the icons of Figures 1.1–1.7 and 2.1–2.7 on a computer display. This is demonstrated by the original Specification's description of Figures 1.1–1.7 and 2.1–2.7 as showing an "icon," and of Figures 5.0 and 7.0 as showing a "graphical user interface," which a designer of ordinary skill in the art would equate with the interface of a computer display. *See Spec.* 1–2. We reproduce here the icons shown in Original Figures 1.2 and 2.2, and an excerpt of two icons included in the graphical user interface shown in Original Figure 5.0:



**Original Fig. 1.2**



**Original Fig. 2.2**



**Original Fig. 5.0 (excerpt)**

Based on the similarity of the icons shown in these figures, a designer of ordinary skill in the art would recognize that Appellant had possession of placing the icons of Original Figures 1.1–1.7 and 2.1–2.7 on a computer display such as shown in Original Figure 5.0.

Original Figures 3.1–3.7 and 4.1–4.7 bolster this determination. These figures, like Original Figures 1.1–1.7 and 2.1–2.7, are described simply as “Animated icons.” Spec. 1. But these figures add the temperature and humidity indicia within the center portion of the icon, as is shown in the two icons of Original Figure 5.0, and seen above. This, again, demonstrates the close association in the original Specification between the four animated

icons shown in Original Figures 1.1–4.7 and the computer display shown in Original Figures 5.0–7.0.

We disagree with the Examiner’s conclusion that Appellant’s election of the icons shown in Original Figures 1.1–1.7 and 2.1–2.7, in response to a restriction requirement, renders the other Original Figures legally irrelevant to the written description inquiry. *See* Ans. 6–7, 11, 13–1. MPEP § 1504.05(II)(A), cited by the Examiner here, does not support the Examiner’s conclusion. It addresses whether different embodiments of a design patent application “involve *a single inventive concept* according to the nonstatutory double patenting practice for designs.” MPEP § 1504.05 (introductory ¶ 2) (emphasis added). That is, the MPEP addresses whether *what the applicant has invented* may be covered by a single design patent, or must be restricted out to be covered by multiple design patents. *Id.* § 1504.05(II)(A).

We acknowledge the MPEP indicates that “[i]f the disclosure of any embodiment relies on the disclosure of another embodiment for completeness to satisfy” the written description requirement of 35 U.S.C. § 112(a), then “the differences between the embodiments must be identified either in the figure descriptions or by way of a descriptive statement in the specification of the application as filed.” MPEP § 1504.05(II)(A). Further: “[I]n the absence of such a statement in the specification of an application as filed, the disclosure of one embodiment will normally not be permitted to provide antecedent basis for any written or visual amendment to the disclosure of other embodiments.” *Id.*

In the present case, however, the original Specification identified differences between different embodiments. A first embodiment is the animated icon of Original Figures 1.1–1.7 shown on a computer display.

*See* Spec. 1; Original Figures 1.1–1.7, 5.0, and 7.0. A second embodiment is the animated icon of Original Figures 2.1–2.7 shown on a computer display. *See* Spec. 1; Original Figures 2.1–2.7, 5.0, and 7.0. A third embodiment is the graphical user interface of Original Figure 5.0, which includes the two icons excerpted above as well as several additional elements, on a computer display. *See* Spec. 1; Original Figure 5.0.

Finally, we agree with the Examiner’s finding that “[t]he term ‘icon’ does not inherently identify a graphic symbol on a computer screen.”

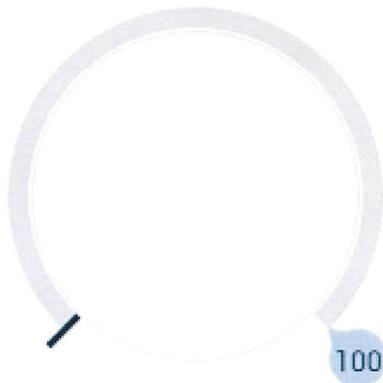
Ans. 10–11 (emphasis added) (citing Merriam-Webster’s 5th definition of “icon” as meaning “a pictorial representation: IMAGE”). Nonetheless, it is also true that the 1st definition of “icon” in Merriam-Webster is “a graphic symbol on a computer display screen that represents an app, an object (such as a file), or a function (such as the command to save).” *See* <https://www.merriam-webster.com/dictionary/icon> (accessed Mar. 10, 2021) (made of record with this decision). Appellant’s original Specification demonstrates possession of this specific kind of icon via the graphical user interface shown in Original Figure 5.0, as discussed above. Thus, whether disclosure of an “animated icon” in isolation from other disclosure(s) demonstrates possession of the icon displayed specifically on a computer display, to the exclusion of a flipbook or a paper manual (*see* Ans. 11), is not an issue presented here.

For the foregoing reasons, we do not sustain the rejection for lack of written description with regard to displaying the animated icon on a computer display.

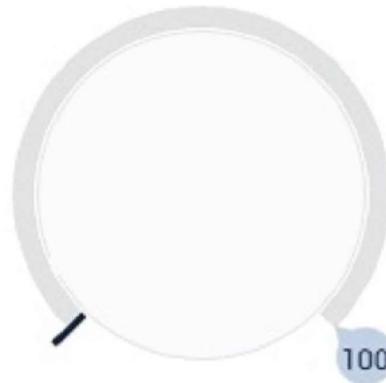
2. *Line Character and Quality of the Icon*

As a separate basis for rejecting Appellant’s amended claim for lack of written description, the Examiner determines “the icons themselves” in the Replacement Figures “do not meet written description because the solid line claimed subject matter cannot change in character” from the Original Figures. Advisory Act. (Oct. 19, 2018), 2. The Examiner determines: “No ‘improvement’ of line quality in the claimed solid lines is possible without failing the written description requirement,” and “the line quality on the replacement drawings must match exactly the line quality on the original drawings.” *Id.*

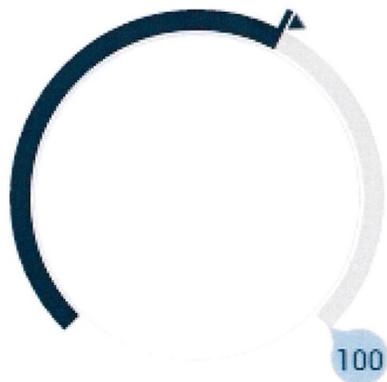
We reproduce here the icon of two of Appellant’s Original Figures on the left, and excerpts of the corresponding Replacement Figures on the right, for a representative comparison between the Original and Replacement Figures:



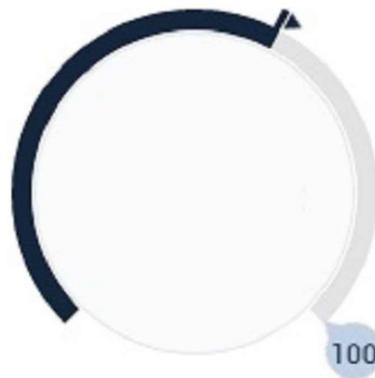
**Original Fig. 2.1**



**Replacement Fig. 2.1 (excerpt)**



**Original Fig. 2.4**



**Replacement Fig. 2.4 (excerpt)**

Original Figure 2.1 and Replacement Figure 2.1 both show the animated icon at the beginning point of the animation, and Original Figure 2.4 and Replacement Figure 2.4 both show the animated icon at a mid-way point of the animation. We are unable to discern a material difference in the line character or line quality between these figures such that the Original Figures do not demonstrate possession of the animated icon as shown in the Replacement Figures. We, therefore, do not sustain this aspect of the written description rejection.

### *B. Indefiniteness*

The Examiner rejected Appellant's amended claim under 35 U.S.C. § 112(b) as indefinite. Final Act. 9. The Examiner determined Appellant's amended claim is indefinite because the Replacement Figures "include . . . broken lines that are not described in the specification, and the scope of the claimed design cannot be determined." *Id.* The Examiner advised Appellant that this rejection may be overcome by inserting a statement in the Specification to the effect that the broken lines depict portions of the article or environmental structure that form no part of the claimed design, if that is Appellant's actual intent. *Id.*

In response, Appellant first submitted an after-final amendment, seeking to follow the Examiner's advice for overcoming the indefiniteness rejection, and also to make other changes in the application. *See* Response to Final Office Action (Aug. 13, 2018). The Examiner refused to enter these amendments, on the basis that “[t]hey raise the issue of new matter.” Advisory Action (Sept. 5, 2018), Box 3b, and Continuation Sheet. The Examiner additionally stated “[t]he portion of [Appellant's after-final amendment] dealing with 35 USC § 112(b), if presented in an amendment that could be entered, would overcome the 35 USC § 112(b) rejection.” *Id.*

Now on appeal to the Board, Appellant “submit[s] that no new matter has been added, no additional corrective action is required, and that [the after-final] amendments should be entered.” Appeal Br. 8–9. The Appeal Brief does not otherwise address the indefiniteness rejection. *See id.*

The Examiner's Answer reiterates the positions articulated above. *See* Ans. 17–18. The Reply Brief does not address the indefiniteness rejection.

Upon review of the foregoing, we discern no error in the Examiner's indefiniteness rejection. Appellant does not attempt to articulate any such error. *See, e.g.,* Appeal Br. 8–9. We agree with the Examiner's determination that Appellant's amended claim, as shown in the Replacement Figures, is indefinite. In particular, the Examiner refused to enter Appellant's after-final amendment. In the application as presented on appeal, it is not sufficiently clear: (1) whether or not the broken lines in the Replacement Figures are part of the claimed design; and (2) what the broken lines represent, regardless of whether they are part of the claimed design.

Thus, we sustain the indefiniteness rejection.

### CONCLUSION

We reverse the written description rejection, and we affirm the indefiniteness rejection, as set forth in this table:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1	112(a)	Written Description		1
1	112(b)	Indefiniteness	1	
<b>Overall Outcome</b>			1	

### TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED