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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SONOS, INC.

Appeal 2018-003793
Reexamination Control 90/013,497
Patent D559,197 S¹
Technology Center 2900

Before JOHN C. KERINS, BRETT C. MARTIN, and
JENNIFER L. McKEOWN, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of the claim. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellant's claim is directed generally to an "ornamental design for a control strip for electronic appliances." Abstract.

¹ U.S. Patent D559,197 S (hereinafter the '197 patent) was issued on January 8, 2008 to Wai-Loong Lim et al.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sonos, Inc., SonosZonePlayer 100 (ZP100) Product Brochure (Envisioneering Grp. (Jan. 31, 2005)) (hereinafter “SonosZonePlayer ZP100”).

Sonos, Inc., Sonos Controller, It’s like having a giant jukebox of music at your fingertips (<https://web.archive.org/web/20050204004810/http://www.sonos.com/products/controller/>) (last visited Apr. 27, 2015) (hereinafter “Sonos Controller”).

REJECTION

The Examiner made the following rejection:

The claim is rejected under 35 U.S.C. § 102(b) as being anticipated by SonosZonePlayer ZP100 and Sonos Controller. Ans. 11.

ANALYSIS

Although there is a prior art rejection before us, the main issue in this case is that of priority. The Examiner has rejected Appellant’s claim to priority to U.S. Patent D524,251 S (hereinafter “the ’251 patent”), which would otherwise remove the prior art at issue from availability for rejection. Accordingly, because we find the Examiner’s priority analysis to be in error, the priority issue is dispositive of this case.

According to the Examiner, “the ’251 patent is nonenabling and indefinite because the disclosure did not clearly illustrate some aspects essential to the visual appearance of the design as it would appear embodied in a remote control device.” Ans. 4. The Examiner then goes on to point to

several minor differences between the drawings of the two patents. *See* Ans. 5, 9–11. The Examiner then concludes that “[t]he cumulative effect of these differences result[s] in the ’197 Patent being new relative to the design . . . [of] the ’251 patent” and, therefore, denies priority. Ans. 9.

We see two main issues in the Examiner’s priority analysis. First, although the Examiner points to various differences in the two designs and bases the rejection of priority on these differences, the Examiner’s statement of the claim construction, i.e., what constitutes the design, does not actually include any of these differences. The Examiner notes that the “new” design includes different spacing, new features (such as a light between buttons and different contouring of the buttons), etc. and concludes that these differences defeat priority. When analyzing the prior art, we agree with Appellant that the Examiner’s analysis basically includes the following elements:

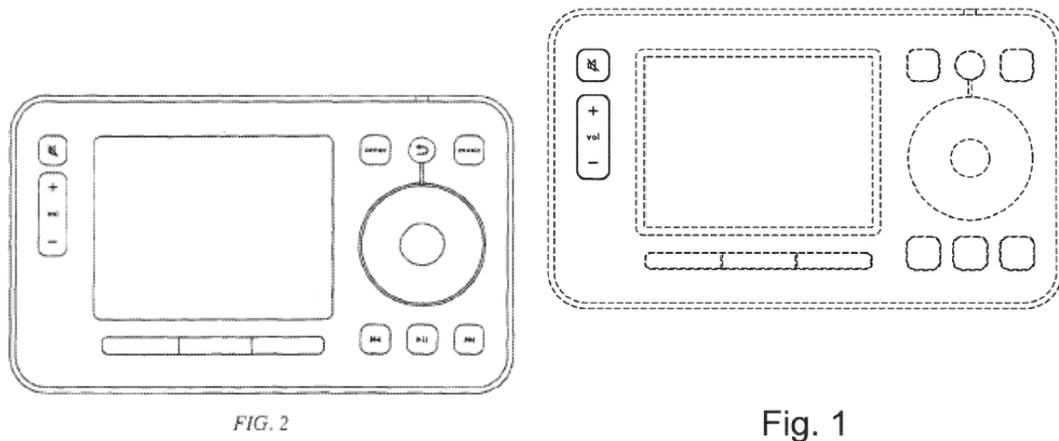
- a vertical arrangement of dual buttons,
- a top squared button,
- a bottom rectangular button,
- distance between the buttons, and
- narrow offsetting between the top and bottom edges of the buttons.

Reply Br. 11. As stated above, none of these claim elements includes the differences that form the basis for the rejection of the priority claim.

The Examiner, thus, appears to use one standard for determining priority while using another to determine anticipation. In fact, the Examiner even admits to using differing claim constructions for anticipation and priority/written description: “priority benefit analysis must be separate and would require a different construction of the claim.” Ans. 28.

Appellant is correct that “when there are multiple embodiments disclosed in a design patent, the claim of the design patent **must** be construed as encompassing the design that is common across the multiple embodiments and cannot be limited to a specific description of any one of the embodiments.” Reply Br. 7 (citing *Trucook, L.L.C. v. Bond/Helman, Inc.*, No. 00 CV 4865, 2001 WL 826864, at *4 (N.D. Ill. July 18, 2001)). See also *Antonious v. Spalding & Evenflo Co., Inc.*, 217 F.3d 849 (Table) (Fed. Cir. 999) (concluding that the drawings disclosed at most different embodiments of one design based on evaluating the overall common appearance that was conveyed by the drawings). The Examiner’s anticipation claim construction appears to properly encompass all of the embodiments disclosed in the ’197 patent, while the priority analysis improperly focuses on the minor differences between the ’197 patent and the ’251 patent.

By focusing on the differences between the two patents for the priority analysis, however, the Examiner has not utilized a claim construction that encompasses the common elements of the design as required by the case law nor would this construction apply to the one design that was conveyed by the drawings. Specifically regarding written description support, it is undeniable that Figure 1 of the ’197 patent is practically identical to Figure 2 of the ’251 patent.



The above figures show a side-by-side comparison of the controllers shown in Figure 2 of the '251 patent and Figure 1 of the '197 patent. The only feature actually relevant to the '197 patent are the two buttons on the left of the controller that are in solid lines (as opposed to dashed lines). While there may be slight differences in the spacing, as pointed out by the Examiner (*see* Ans. 10), the overall visual impression is nearly identical, namely that of a square button with rounded corners situated directly above and aligned with a rectangular button, also with rounded corners. Again, this comports with the Examiner's claim construction when determining anticipation. Additionally, all of the other embodiments of the '197 patent, even with their various modifications, still embody this one common design feature relating to the square and rectangular buttons. One can use the Examiner's own analysis (Ans. 10) of the differences also to show that when properly compared, i.e., not focusing on the differences, all of the disclosed embodiments share this common design feature.

We do not deny that the remaining figures of the '197 patent disclose features not shown in the '251 patent, but we disagree that these differences are sufficient to defeat priority. As noted above, the proper claim

Appeal 2018-003793
Patent D559,197 S
Reexamination Control 90/013,497

construction, both for written description and for anticipation, is one that “encompass[es] the design that is common across the multiple embodiments.” Reply Br. 7. While the other embodiments of the ’197 patent may include other features, the common design elements are essentially embodied in the buttons shown in Figure 1 and are elements that are shared by all of the embodiments disclosed in the ’197 patent.

Accordingly, we conclude that the Examiner improperly focused on the differences between the ’197 and ’251 patents, while not assessing the commonalities between the two as would be proper in a valid claim construction. The Examiner thus erred in finding a lack of written description support and denying priority. As such, we do not sustain the Examiner’s rejection.

DECISION

For the above reasons, we REVERSE the Examiner’s decision to reject the claim.

REVERSED

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Appeal 2018-003793
Patent D559,197 S
Reexamination Control 90/013,497

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