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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIKE MOHAGEG, TIMOTHY DUNN,
and DAVID KAMHOLZ

Appeal 2019-001776
Application 29/522,397
Technology Center 2900

Before JOHN C. KERINS, JILL D. HILL, and LISA M. GUIJT,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Mike Mohageg et al. (“Appellants”) appeal under 35 U.S.C. § 134 from the Examiner’s decision rejecting the single design claim pending in this appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a display screen with a graphical user interface. The claim on appeal is "the ornamental design for the DISPLAY SCREEN OR PORTION THEREOF WITH GRAPHICAL USER INTERFACE."

REJECTIONS

The claim stands rejected under 35 U.S.C. § 103 as unpatentable over YOUTUBE, *Facebook Side Menu Demo*, https://www.youtube.com/watch?v=WFBjaw1V_EM ("Almog"), WIKIMEDIA COMMONS, https://commons.wikimedia.org/wiki/File:Oracle_logo.svg ("the Oracle logo"), and USPTO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4801:ih4j0u.3.1> ("Oracle Trademark 3192864").
Final Act. 2.

OPINION

The Examiner finds that Almog has design characteristics that are basically the same as the claimed design "showing a first view with a three-bar icon in the upper left corner and text at the bottom of the design," which the Examiner appears to compare with Appellants' Figures 1 and 3, and "a second view with a horizontal line at right, a three-bar icon in the upper right corner, and text at the bottom of the design," which the Examiner appears to compare with Appellants' Figures 2 and 4–8. Final Act. 2. The Examiner provides the following Almog screen shots for comparison with Appellants' Figures 1 and 3:



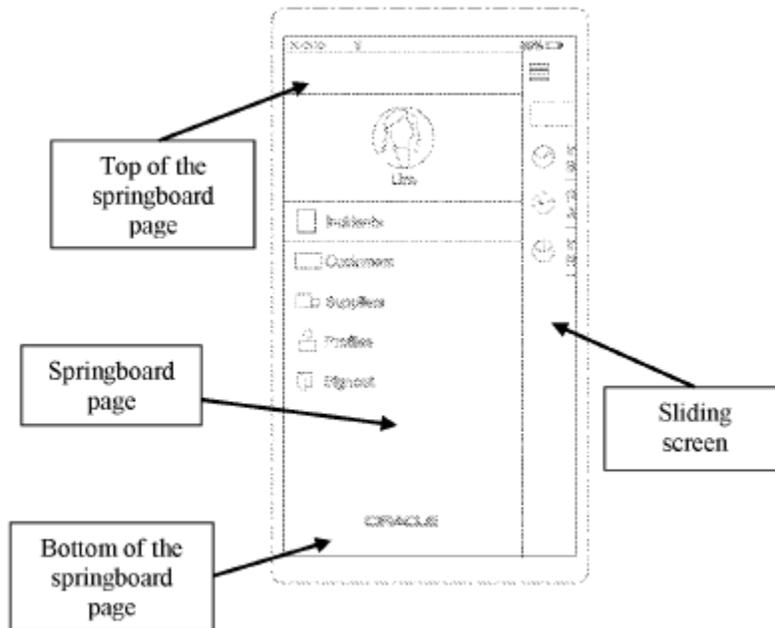
Facebook Side Menu Demo by Shai Almog

Id. at 3.

The Examiner finds that the claimed design differs from Almog “in that the text at the bottom is centered and in some embodiments this text is surrounded by a common geometric shape outline.” *Id.* at 3. The Examiner finds, however, that “Wikimedia Commons Oracle Corporation [(i.e., the Oracle logo)] logo teaches the use of the trademark shown in the claimed design” and “trademark 3192864 [(i.e., Oracle Trademark 3192864)] teaches the Oracle trademark within a common geometric shape outline.” *Id.* at 4. The Examiner concludes that it would have been obvious to modify Almog’s design “by replacing the text with the Oracle trademark and outlining it with a common geometric shape as taught by the Oracle Corporation Logo and the Oracle Trademark.” *Id.* The Examiner further concludes that “[t]he difference of shifting to the right and centering a single word of text is not significant enough to warrant a patent for the overall appearance of the claimed design over the prior art.” *Id.* at 5 (citing *In re Lapworth*, 451 F.2d 1094 (CCPA 1971); *In re Lamb*, 286 F.2d 610 (CCPA 1961)). According to

the Examiner, “modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the others.” *Id.*

Appellants argue that Almog “illustrates the logo at the top of the sliding screen as opposed to at the bottom of the springboard screen, as shown in Appellant[s]’ claimed design.” Appeal Br. 5 (emphasis omitted). The “sliding” window/screen and “springboard” page/screen are identified below in Appellants’ annotated version of their Figure 2.



Id. at 4.

Appellants further argue that Almog’s Facebook logo is provided at a top portion of the sliding window, rather than at a bottom portion of the springboard page as claimed. *Id.* at 5. Appellants continue that “even if Almog was modified to replace its ‘Facebook’ logo with the Oracle Logo and Oracle Trademark 3192864, . . . the combination will result in the

[Oracle] logo [being] displayed at the top of the sliding screen as opposed to at the bottom of the springboard screen, as claimed.” *Id.* (emphasis omitted). Appellants contend that “the positioning of the logo (both in terms of whether it is displayed on top or at the bottom of the display, and whether it is displayed on the springboard or sliding screen) is essential as it affects the general design of the user interface.” *Id.*

The Examiner responds that the claimed design shows a single word of text at the bottom of Figure 2, and “Almog also shows a single word of text at the bottom of the second view” as shown above. Ans. 7. According to the Examiner, Almog has design characteristics that are “basically the same as the claimed design,” because Almog’s single word of text is “comparable with the logo in the claimed design since the logo is comprised of a single word of text in a similar position.” *Id.* at 8 (citing *In re Rosen*, 673 F.2d 388, 390 (CCPA 1982)).

According to the Examiner, the designation of sliding and springboard screens, and their functioning, “is not supported in the original disclosure, which consists of a very broad claim with two views showing a start point and end point,” and “nothing in between these two views is claimed,” such that “there is no evidence from the claim that the second image could not be reached in any number of ways including by scrolling down.” Ans. 8. The Examiner contends that, “[i]n examining changeable computer-generated icons, ‘the images are understood as viewed sequentially, no ornamental aspects are attributed to the process or period in which one image changes into another.’” *Id.* at 9–10 (citing MPEP § 1504.01(a), subsection IV). “[I]t is the opinion of the [E]xaminer that the two designs present a patentably indistinct visual appearance from the claim,” and “[t]he difference of

shifting the interface to the right and centering a single word of text is not significant enough to warrant a patent for the overall appearance of the claimed design over the prior art.” *Id.* at 10.

Appellants have the better argument. A design must be compared with something in existence, i.e., a prior art reference having design characteristics that are basically the same as the claimed design. *See Rosen*, 673 F.2d at 391. In considering whether the Examiner has established prima facie obviousness, we first consider whether *Almog* is a proper *Rosen* reference, i.e., whether it has design characteristics that are basically the same as the claimed design. Relevant to this inquiry, Figure 4 of the claimed design is reproduced below on the left, with a corresponding Examiner-provided screen shot of *Almog* on the right.

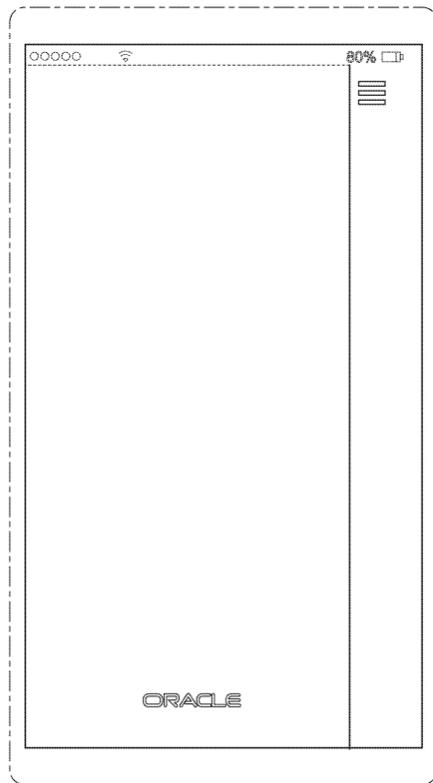
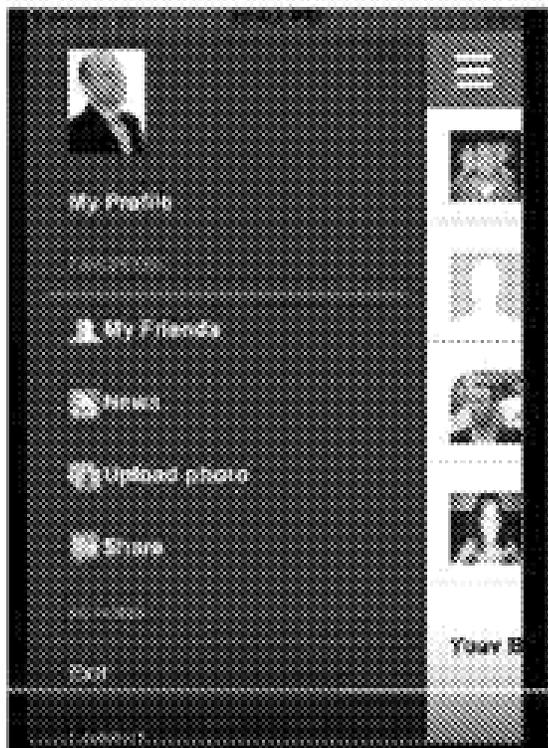


FIG. 4



Appellants' design shown in Figure 4 has four basic claimed elements (1) an outer rectangular border, (2) a vertical line extending along the right side of the rectangular border, along substantially the entire vertical distance of the rectangular border, (3) three horizontally-extending rectangles at a top right corner of the rectangular border, between the border wall and the vertical line, and (4) lettering comprising the Oracle trademark at a bottom of the rectangular border, substantially centered between a left wall of the rectangular border and the vertical line. The above screen shot of Almog includes each of the first three basic claimed elements enumerated above, but not the fourth, which is consistent with the Examiner's findings (Final Act. 2–3). While the Almog screen shot includes some text, none of Almog's text has a similar position, font, size, or overall appearance as the claimed design. We, therefore, determine that Almog's text does not establish the same overall visual appearance of its screen shot and Figure 4 of the claimed design. We disagree with the Examiner's assertion that “[t]he difference of shifting the interface to the right and centering a single word of text is not significant enough to warrant a patent for the overall appearance of the claimed design over the prior art” (Ans. 10). The position, font, size, and overall appearance of the Oracle logo, and its effect on the overall appearance of the claimed design are significant, particularly given Almog's largest font appearing at a top of its screen. We are not persuaded that the Examiner has established that Almog is a proper *Rosen* reference. Lacking a proper *Rosen* reference, prima facie obviousness has not been established. For this reason, we do not sustain the pending obviousness rejection.

Appeal 2019-001776
Application 29/522,397

DECISION

We REVERSE the rejection of the claim under 35 U.S.C. § 103.

REVERSED