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155316	7590	09/17/2019	EXAMINER	
S.C. JOHNSON & SON, INC./Quarles & Brady LLP			PRATT, DEANNA L	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DANIELLE GIZA<sup>1</sup>

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Appeal 2019-001900  
Application 29/461,780  
Technology Center 2900

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Before WILLIAM A. CAPP, JILL D. HILL, and JEREMY M. PLENZLER,  
*Administrative Patent Judges.*

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals 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.

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<sup>1</sup> The briefing identifies Applicant S.C. Johnson & Son, Inc. as the real party in interest. Appeal Br. 2.

## BACKGROUND

Appellant's invention relates to a computer icon. The claim on appeal is "[t]he ornamental design for a display screen portion with icon, as shown and described."

## REJECTIONS

The claim stands rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 2.

## OPINION

The Examiner finds that "a design that does not include the top portion of the large chevron feature, now shown in broken lines in every embodiment of the claimed design, was not originally described." Final Act. 2.

Appellant argues that the test for sufficiency of written description is whether the application disclosure reasonably conveys to a skilled designer that the inventor had possession of the claimed invention at the time of filing. Appeal Br. 6 (citing *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998)(internal citations omitted). Appellant also notes that MPEP § 1504.04(I)(B) specifically addresses the issue in this appeal, stating that "applicant was in possession of everything disclosed in the drawing at the time the application was filed and the mere reduction of certain portions to broken lines or conversion of broken line structure to solid lines is not a departure from the original disclosure." Appeal Br. 5. According to Appellant, the inventor was, thus, in possession of the pending claim scope.

The Examiner responds that MPEP § 1504.04(I)(B) in a "Ninth Edition . . . published in January 2018 but indicated as being revised

effective August 2017, [removed] of this pivotal passage.” *Id.* The Examiner further responds that Appellant misconstrued this statement in MPEP § 1504.04(I)(B) as “carte blanche to convert broken line subject matter to solid line and vice versa without running afoul of §112(a).”

Ans. 3, 4. According to the Examiner, MPEP § 1504.04(I)(B) did not state that any amendment reducing solid lines to broken lines, or vice versa, is an acceptable amendment. *Id.* Further, the Examiner contends that the claim was not rejected because Appellant converted solid lines to broken lines, or vice versa. *Id.* Rather, the claim was rejected “because the design now claimed was not described in the original disclosure.” *Id.* The Examiner further explains her position regarding lack of written description in detail. Ans. 4–14.

Appellant acknowledges that MPEP § 1504.04(I)(B) was amended “to separate the discussions of new matter and written description,” but maintains that the Examiner’s view of the written description requirement is “overly restrictive.” Reply Br. 2. We agree. Appellant’s amendment of the upper lines of each larger chevron from solid to broken does not alter the nature of the claimed design, and the newly-claimed arrangement of broken and solid lines (i.e., the exact current breadth of the claim) need not have been specifically depicted in the original drawings to satisfy the written description requirement. This is not a situation, as in *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), where a new boundary is defined in an amendment. Nor is this a situation, as depicted in footnote 3 of Appellant’s Reply Brief, where an arrangement was “disclosed but not described.” Appellant has converted an entire existing length of certain solid lines to dashed lines in a

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manner that is both disclosed and described, and without defining any new boundaries. For this reason, we do not sustain the claim rejection.

**DECISION**

We REVERSE the rejection of the claim under 35 U.S.C. § 112(a).

**REVERSED**