IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: NICOLETTI=4

In re Application of:	)	Art Unit: 2913
	)	
Giuseppe NICOLETTI	)	Examiner: G. Watson
	)	
Appln. No.: 29/143,682	)	Washington, D.C.
	)	
Date Filed: June 19, 2001	)	Confirmation No. 2883
	)	
For: SOFA	)	June 24, 2002

REPLY: AMENDMENT AND REMARKS

Honorable Commissioner for Patents
Washington, D.C. 20231

Sir:

Replying to the Official Action of March 26, 2002, please amend as follows:

IN THE SPECIFICATION

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached version is captioned "Version with Markings to Show Changes Made".

Amend the Fig. 1 description to read as follows:

Fig. 1 is a front elevational view of a SEAT showing my new design in the form of a sofa;

Amend the Fig. 3 description to read as follows:

Fig. 3 is a right elevational view, the left side being a mirror image thereof;

Delete the paragraph following the Fig. 4 description and prior to the claim, without prejudice.

THE DRAWING

New formal drawings are submitted herewith, for which approval and entry are respectfully requested.

REMARKS

The Office Action of March 26, 2002, Paper No. 2, has been carefully reviewed. Applicant notes that no prior art has been applied against applicant's claim, and therefore the PTO considers applicant's design to define novel and unobvious subject matter under §§102 and 103. Applicant respectfully requests favorable consideration and formal allowance.

The PTO has rejected applicant's claim under the first and second paragraphs of §112. This rejection is respectfully traversed.

As understood, the reason for this rejection is the presence of the special description paragraph immediately preceding the claim, and the Fig. 1 description which includes

a broken line statement (whereas the drawing appears to contain no broken lines). By the amendment presented above, the Fig. 1 description has been corrected to remove the erroneous broken line statement. In addition, the criticized special description paragraph has been deleted, without prejudice.

Nevertheless, the deletion of the special description paragraph is not to be taken as any acquiescence by applicant of the position of the PTO that such paragraph is in some way improper or a broadening of the claimed invention beyond what is permitted by the law. Thus, applicant maintains his position that the claimed design is not limited to the exact details shown in the drawing, and is intended to cover equivalent and colorable imitations thereof, consistent with the law, and therefore the claimed design may be practiced otherwise than as specifically shown in the drawing and described in the specification. A case more recent than the case cited by the PTO, which confirms that a design is not limited to exactly what is disclosed, is *In re Daniels*, 46 USPQ2d 1788 (Fed. Cir. 1998). The court reversed the earlier decision of the BPAI and disagreed with the Board's statement "that a design is 'a unitary thing', and thus that when the design is changed it becomes a different design, ...".

Also see *Motorola v. Qualcomm,* 45 USPQ2d 1558, 1562-63, citing *Litton v. Whirlpool,* 221 USPQ 97 (Fed. Cir. 1984) to the effect that "minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement."

In addition to the cases cited above, a leading case is *Henry Hangar v. Sel-O-Rak Corp.,* 123 USPQ 3, 6, 7 (CA 5 1959), citing and relying on *Gorham v. White,* 81 US 511:

> The defendants placed great stress on the differences between the rack which was patented and the rack of the defendants ... . But do these and other differences change the effect of the design and the peculiar and distinctive appearance? These are the essentials of a design patent and are entitled to the patent law's protection.

In affirming the infringement ruling of the lower court in spite of the differences between the defendant's rack and the rack illustrated in the design patent in suit, the court stated:

> And it is the overall appearances that will control and not the minutia of differences.

That is the law, notwithstanding the contrary rules (or belief) of the PTO.

Not only is applicant's position in this regard supported by the case law, but it is also supported by the statute itself, noting 35 U.S.C. 289 which explicitly extends coverage of a design patent to "colorable imitations thereof".

For the PTO to say (or imply) that a design patent covers only what is precisely illustrated is therefore absolutely wrong and contrary to a long established line of legal precedent, and applicant cannot and does not accept the PTO's position in this regard.

Accordingly, applicant's cancellation of the criticized paragraph does not mean that applicant agrees that cancellation of certain text from the present application is proper or that the claim is more limited after such cancellation than it was before. Applicant makes no concession regarding the scope of the claim or that such cancellation has any effect on the scope of the claim, and applicant respectfully reiterates for the record that the present design is not limited to the exact details shown in the drawing, and is intended to cover equivalents and colorable imitations thereof.

The drawings have been objected to on the basis of poor quality and inconsistent views. Filed herewith replacement formal drawings, which applicant requests the examiner to approve and enter. The following corrections have been provided in the new formal drawings:

Figure 1 now shows a single seam line on the left backrest and on the seat cushion;

In figure 2 the seam lines have been corrected and the double seam lines on the backrest have been cancelled; the shading also was corrected and applied to the drawings in a uniform manner;

In figure 3 the seam lines have been appropriately shown;

In figure 4 the seam lines on the backrest pillow have been shown.

To summarize, the drawing figures are believed to be fully consistent, to be of improved quality, and to contain improved shading. Applicant again respectfully requests approval and entry of the new formal drawing attached herewith.

The applicant also notes the third paragraph on page 5 of the Office Action, and again notes in connection therewith that the PTO has initially concluded that the claimed design is patentable over any known prior art.

In this regard, the documents cited of interest but not relied upon have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently pertinent to warrant their application against applicant's claimed design.

As applicant believes that all issues have been resolved, applicant respectfully requests favorable consideration, entry of the attached drawings and allowance.

Respectfully submitted,

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Version with Markings to Show Changes Made

Fig. 1 is a front elevational view of a ~~seat~~ SEAT showing my new design in the form of a sofa ~~with the broken lines showing for illustrative purposes only and forming no part of the claimed design~~;

Fig. 3 is a right elevational view, the ~~lrft~~ left side being a mirror image thereof;

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