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In re Application of :
Ishak et al. :
Application No. 18/582,570 : **DECISION ON PETITION**
Filed: 20 Feb 2024 :
For: ARTIFICIAL INTELLIGENCE :
INTEGRATED INTO A CHAT SYSTEM :

This is a decision in response to the renewed petition, filed on August 14, 2024, which is being treated as a petition filed under 37 CFR 1.181, requesting that the Director exercise supervisory authority and overturn the decision of June 14, 2024, by the Director of Technology Center 2100 (Technology Center Director), which denied petitioner's request to accept color drawings.

The petition under 37 CFR 1.181 to overturn the Technology Center Director's decision of June 14, 2024, and accept color drawings is **DENIED**.

RELEVANT BACKGROUND

The instant application was filed on February 20, 2024.

A petition under 37 CFR 1.84(a)(2) to accept color drawings was filed on February 20, 2024.

A decision by the Technology Center Quality Assurance Specialist was issued on March 13, 2024, dismissing the petition of February 20, 2024.

A renewed petition was filed on May 13, 2024, requesting reconsideration of the decision issued on March 13, 2024.

A decision by the Technology Center Director was issued on June 14, 2024, which denied the renewed petition of May 13, 2024.

The instant petition, filed on August 14, 2024, and being treated as a petition under 37 CFR 1.181, requests reconsideration of the Technology Center Director's decision of June 14, 2024.

STATUTES AND REGULATIONS

35 U.S.C. § 2(b)(2) provides that the Office:

* * * * *

may establish regulations, not inconsistent with law, which—A) shall govern the conduct of proceedings in the Office;

* * * * *

35 U.S.C. § 113 provides that:

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.84(a) provides that:

Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color.* Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:(i) The fee set forth in §1.17(h);

(ii) One (1) set of color drawings if submitted via the Office electronic filing system or three (3) sets of color drawings if not submitted via the Office electronic filing system; and

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

37 CFR 1.181(a) provides that:

Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
- (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

OPINION

The instant application is a utility patent application and is directed to subject matter that relates to artificial intelligence integrated into a chat system. In the supplemental drawings filed on February 20, 2024, Figures 2A-11D and 13A-16G¹ are submitted in color and depict user interfaces of the chat system.

Color drawings and color photographs are generally not accepted by the Office in utility applications and will only be accepted if a petition filed under 37 CFR 1.84(a)(2) or (b)(2) is granted. *See Manual of Patent Examining Procedure (MPEP) § 608.02 VIII.*

37 CFR 1.84(a)(2) provides, in part: “[o]n rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application.” Accordingly, the applicant has the burden of establishing that color drawings are the only practical medium by which to disclose the subject matter sought to be patented.

Petitioner has provided various arguments as to why the color drawings should be accepted. In the original petition filed on February 20, 2024, petitioner stated that “the subject matter could not be adequately represented by black and white images.” In the renewed petition filed on May 13, 2024, petitioner stated that the “blurring aspect” depicted in Figures 13A-13B is extremely difficult to demonstrate in simple line drawings, and further, that line drawings would not show the difference between an avatar and a user as depicted in Figures 3C-11B. In the instant petition, petitioner argues that some of the drawings use color to provide features of the user interface that include a complexity that is difficult to demonstrate in line drawings. In particular, petitioner states that the matching colors in Figure 14G show an association between a service provider and

¹ Although the decision of June 14, 2024, identifies the set of color drawings as those of Figures 2A-16G, a review of the record shows that only Figures 2A-11D and 13A-16G were filed in color.

the messages from that particular service provider, and that Figures 16C-16F use different colors to distinguish between user messages and AI-generated responses.

Petitioner's arguments have been considered but are not persuasive. Petitioner has not provided a sufficient explanation as to why color drawings are necessary as *the only practical medium* to disclose the subject matter sought to be patented in the instant application. While petitioner has described various purposes and benefits for using color drawings to depict features of the user interfaces, petitioner has not provided an explanation as to why color drawings are the only practical medium to disclose the subject matter sought to be patented. In response to petitioner's arguments, it is noted that grayscale or gradient/fill effects may be used rather than color to illustrate the various elements of the user interface. This is evident from the pre-grant publication of the instant application, U.S. Pat. Publ'n No. 2024/0283759, which effectively demonstrates the features petitioner has pointed out in grayscale drawings, without resorting to the use of color. Although petitioner indicates reasons as to why color drawings are preferred over black and white drawings, it is not apparent from the drawings nor petitioner's arguments as to why black and white or grayscale drawings do not adequately disclose the subject matter sought to be patented. In this instance, color drawings are not necessary as the only practical medium by which to disclose the subject matter sought to be patented.

DECISION

For the previously stated reasons, petitioner has not sufficiently demonstrated that color drawings are necessary as the only practical medium by which to disclose in the instant application the subject matter to be patented, or otherwise shown error in the Technology Center Director's decision to deny petitioner's request to accept color drawings in the instant application. Accordingly, the instant petition is **DENIED**.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). *See* MPEP § 1002.02.

Consequently, the specification of the instant application should be amended to remove any reference indicating that the drawings are in color.

/Charles Kim/
Deputy Commissioner for
Patents