Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

EX PARTE KAREN DONOGHUE
Appeal No. 92-0543
April 2, 1992

***1** Application for Design Patent filed February 10, 1989, Serial No. 07/261281. Icon for an Address List Function or the Like.

Michael H. Shanahan for appellant

Primary Examiner--Susan J. Lucas

Before Manbeck

Commissioner

Comer

Deputy Commissioner

Samuels

Assistant Commissioner

Serota

Chairman

Stahl and Pellman

Examiners-in-Chief

Manbeck

Commissioner

ON BRIEF

This is an appeal from the examiner's decision finally rejecting the sole claim in the application.

The subject matter on appeal is a design for an icon. The sole claim on appeal follows:

The ornamental design for an Icon for an Address List Function or

the Like as shown and described.
The design as shown in the drawing figure is reproduced below:

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

The complete specification, as amended, is reproduced in footnote 1. [FN1]

The sole claim stands rejected as unpatentable under 35 U.S.C. § 171. After careful consideration of appellant's arguments, we affirm the examiner's rejection.

Section 171 provides:

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The examiner concluded that the claimed design was nonstatutory, finding that the design was not an "ornamental design for an article of manufacture...." The thrust of the rejection is that the design as claimed is merely a picture or surface ornamentation per se rather than a design applied to an article. The examiner notes that the specification does not describe, claim or show the claimed designs applied to any article of manufacture.

In response appellant argues that the "article of manufacture is the functionally active area of the computer display screen associated with an address list." See brief, page 7. Appellant also notes that the "two- dimensional surface ornamentation-type design is fully disclosed by a plan view illustration."

The respective positions of the examiner and appellant require us to consider the meaning of "ornamental design for an article of manufacture."

The phrase "design for an article of manufacture" has long appeared in the design statutes. The phrase appears in Revised Statutes § 4929, May 9, 1902, ch. 783, 32 Stat. 209; was reenacted in 35 U.S.C. § 73 (1946) and again reenacted in 35 U.S.C. § 171 (1952). The CCPA construed the phrase in In re Schnell, 46 F.2d 203, 8 USPQ 19 (CCPA 1931). The court noted that the language "new, original and ornamental design for an article of manufacture" encompassed at least three kinds of designs: 1) a design for an ornament, impression, print or picture to be applied to an article of manufacture (surface ornamentation); 2) a design for the shape or configuration of an article of manufacture; and 3) a combination of the first two categories. 46 F.2d at 209, 8 USPQ at 25. With respect to the first category, the Court indicated that the statute required more than a mere picture:

> ***2** We think that Assistant Commissioner Clay was right in saying [in Ex parte Cady, 1916 Dec. Com'r.Pat. 57, 58] that the design must be shown not to be the mere invention of a picture, irrespective of its manner of use, but that the applicant should be required to show by an appropriate drawing the manner of its application.

46 F.2d at 209, 8 USPQ at 26. The Court went on to state:

> [I]t is the application of the design to an article of manufacture that Congress wishes to promote, and an applicant has not reduced his invention to practice and has been of little help to the art if he does

not teach the manner of applying his design.
46 F.2d at 209, 8 USPQ at 26.

The CCPA again interpreted the language in In re Zahn, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). The issue in Zahn was whether or not § 171 permitted claiming a design for a portion of an article of manufacture, a drill tool. The court noted that under § 171 a design must be "embodied" in an article:

> Section 171 authorizes patents on ornamental designs for articles of manufacture. While the design must be embodied in some article, the statute is not limited to designs for complete articles, or "discrete" articles, and certainly not to articles separately sold,.... Here the design is embodied in the shank portion of a drill and a drill is unquestionably an article of manufacture. It is thus applied design as distinguished from abstract design. (Emphasis original.)

617 F.2d at 268, 204 USPQ at 995.

These decisions indicate that a picture standing alone is not protectable by a design patent. The factor which distinguishes statutory design subject matter from mere pictures or surface ornamentation per se (i.e., abstract designs) is the embodiment of the design in an article of manufacture. In order to meet this threshold requirement of an applied design, we conclude that an applicant's specification must expressly state an article of manufacture ornamented by the design.

We find that appellant's claimed design, as disclosed in the application before us, is merely a picture. Appellant's specification does not show or describe the claimed design embodied or applied in any article of manufacture. Only a picture of the icon is shown or described. The claimed subject matter, therefore, does not meet the requirements of 35 U.S.C. § 171.

Appellant asserts that the design is a surface ornamentation-type design for the functionally active area of a computer display screen showing the design. We have no doubt that the claimed design, like all surface ornamentation-type designs, could be used to ornament a wide variety of articles, including computers. [FN2] However, the phrase "design for an article of manufacture" in § 171 requires more than a depiction of the surface ornamentation alone. It requires disclosure of the ornamentation applied to or embodied in some article of manufacture. More than an applicant's generalized intent to ornament some article is required. It is the application of the design to an article which separates mere pictures from a design protectable by a patent. Without explicit disclosure of an article in the specification, the design is not an applied design contemplated for protection under § 171.

***3** Consistent with § 171, PTO regulations expressly require such disclosure. Thus, 37 CFR § 1.153(a) states:

> (a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described....

37 CFR § 1.152 states:

> The design must be represented by a drawing made in conformity with

the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. (Emphasis added.) Appellant's specification does not describe or show the design as surface ornamentation for a computer system. As we stated above, appellant's designs, as shown and described, are merely pictures which have not been applied to any article.

Appellant also urges reversal because PTO has previously issued design patents to purportedly similar subject matter. We recognize that patents have issued directed to designs referred to as icons. [FN3] However, appellant has not cited any authority which holds that the issuance of a patent has any significant precedential value. In evaluating compliance with 35 U.S.C. § 171, each design application must be evaluated on the record developed in the PTO. See, In re Gyurik, 596 F.2d 1012, 1018 n. 15, 201 USPQ 552, 558 n. 15 (CCPA 1979); In re Phillips, 315 F.2d 943, 137 USPQ 369 (CCPA 1963). To the extent any error has been made in the rejection or issuance of claims in a particular application, PTO and its examiners are not bound to repeat that error in subsequent applications. Accord, In re Cooper, 254 F.2d 611, 617, 117 USPQ 396, 401 (CCPA), cert. denied 358 U.S. 840 (1958) (Decision in a trademark application in accordance with law is not governed by possibly erroneous past decisions of the Patent Office); In re Zahn, 617 F.2d at 267, 204 USPQ at 995 ("[W]e are not saying the issuance of one patent is a precedent of much moment.") Compliance with § 171 requires analysis of the statute and interpreting case law. Mere reference to possibly contrary decisions of an examiner in other applications, applications which do not even discuss the issue raised, are not helpful in this analysis.

Appellant asserts that the design depends upon computer hardware and software which forms no part of the invention and need not be disclosed. Appellant relies on In re Hruby, 373 F.2d 997, 153 USPQ 61 (CCPA 1967) to support his position. We do not think Hruby helps appellant under the circumstances of this case. In Hruby the court held that water fountains were configuration of goods- type designs eligible for protection under § 171. 373 F.2d at 1001, 153 USPQ at 65. An illustration of a configuration type-design inherently discloses the article of manufacture defined by the shape of the design. The configuration designs in Hruby were inherently applied designs. The designs here admittedly are surface ornamentation-type designs. E.g., brief, p. 8. As we indicated above in order to bring a surface ornamentation-type design within the scope of the statute, it must be disclosed and shown in the specification applied to some article of manufacture. And 37 CFR § 1.152 requires a complete disclosure of the article in the drawings, not just disclosure of the design. Appellant has failed to make such a disclosure or showing. Accordingly, we affirm the examiner's rejection under 35 U.S.C. § 171.

***4** The examiner's decision rejecting the claim under 35 U.S.C. § 171 is affirmed.

Under 37 CFR § 1.196(b), the following new ground of rejection is

entered against the claim:

The claim is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter appellant regards as her invention. The phrase "or the like" renders the claim indefinite. It is not apparent from the record of this case what articles are "like" an address list function. The specification does not provide any standards for determining the other things which may fall within the scope of the claim. See, Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed.Cir.1984) (when words of degree are used in a claim, the specification must provide some standard for measuring the degree). A clear and definite statement of the article is important so that others may determine if the use of the design would directly infringe under 35 U.S.C. § 271 or infringe only under the additional remedy of 35 U.S.C. § 289.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

With respect to the new rejection under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. § § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed refection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). 37 CFR § 1.136(a)(3).

AFFIRMED 37 CFR § 1.196(b)

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

Douglas B. Comer

Deputy Commissioner

Saul I. Serota

Chairman

Robert F. Stahl

Examiner-in-Chief

Irving R. Pellman

Examiner-in-Chief

FN1. Be it known that I, Karen Donoghue, have invented a new, original and ornamental design for an Icon For An Address List Function Or The Like, of which the following is a specification, reference being had to the following drawing forming a part thereof.

A portion of the disclosure of this patent document contains material to which a claim for copyright is made. The copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but reserves all other copyright rights whatsoever.

The figure is a face view of an icon for an address list function or the like showing my new design.

FN2. The word "icon" does not limit the design to use with a display screen of a computer or any other article of manufacture. Icons are and have been used with a variety of articles.

FN3. The rejection in this case was authorized by Commissioner Quigg.

26 U.S.P.Q.2d 1271

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