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

EX PARTE JANAIA DONALDSON
Appeal No. 92-0546
April 2, 1992

***1** Application for Design Patent filed July 27, 1989, Serial No. 07/224649. Icon for Softkey Display Screen or the Like.

Robert Barr 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 states:

The ornamental design for a softkey display or the like, as shown

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

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

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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 presented in the briefs and at oral hearing, we affirm the examiner's rejection.

Section 171 of Title 35 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...." While the examiner set forth her reasoning in great detail, the thrust of her position is that the design, as claimed, is merely a picture or surface ornamentation per se rather than a design applied to an article. [FN2] The examiner notes that the specification does not describe, claim or show the claimed design applied to any article of manufacture. Appellant argues that the

> claimed invention is an ornamental design for the display screen of a programmed computer system. A programmed computer system, comprising a processor, a display device and a program executing on the processor is an article of manufacture. The claimed design is surface ornamentation for a particular region of the display screen, and thus qualifies as statutory subject matter.

The examiner responded stating:

> The fact that a programmed computer system running the necessary software may be an article of manufacture, does not help appellant here. No programmed computer system is either depicted or described. Section 1.152 [of 37 CFR] is explicit in requiring that the article of manufacture be shown in the drawings.

The respective positions of the examiner and appellant require us to consider the meaning of "ornamental design for an article of manufacture" as used in § 171.

The phrase "design for an article of manufacture" has long appeared in the design statutes. The language 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 26. With respect to the first category the court indicated the design 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 phrase 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 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 disclose some 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, describe or claim the design embodied in any article of manufacture. Only pictures of the icon are shown or described. The claimed subject matter, therefore, does not meet the requirements of 35 U.S.C. § 171.

Appellant asserts that the design should be considered surface ornamentation upon the display screen of a computer system. 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. 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 an 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 express disclosure of an article, 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 has not described, shown or claimed the design as surface ornamentation for acomputer system. 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. As we stated above, appellant's design, as shown and described, is merely a picture which has not been disclosed applied to any article.

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 icons are "like" a softkey display. The specification does not provide any standards for determining the other icons which would 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.

***4** 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. I, Janaia M. Donaldson, have invented a new, original and ornamental design for a ICON FOR SOFTKEY DISPLAY OR THE LIKE of which the following is a specification, reference being had to the accompanying drawings forming a part hereof.

Fig. 1 is a face view of an icon for a softkey display or the like showing my new design in display mode;

Fig. 2 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 3 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 4 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 5 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 6 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 7 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 8 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 9 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 10 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 11 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 12 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 13 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 14 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 15 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 16 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 17 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 18 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 19 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode;

Fig. 20 is a face view of an icon for a softkey display or the like showing a modified form of my new design in display mode.

FN2. The question of whether this design is "ornamental", as required by the statute, should be considered in any future prosecution of the present subject matter.

26 U.S.P.Q.2d 1250

END OF DOCUMENT