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

EX PARTE SHUICHI TAYAMA
Appeal No. 92-0624
April 2, 1992
***1** HEARD: January 31, 1992

Application for Design Patent filed December 30, 1988, Serial No. 07/291985. Icon for Set Up Operation

Gregory J. Maier et al. 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

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 A SET UP OPERATION, as shown and described.
The design as shown in the drawing figures is reproduced below: [FN1]

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The complete specification, as amended, is reproduced in a footnote. [FN2]

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 argument, 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...." 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. The examiner notes that the specification does not describe, claim or show the claimed design applied to any article of manufacture. Appellant, on the other hand, argues that

> the article of manufacture is a computer having a display screen.

As can thus be appreciated, the design should be considered to be surface ornamentation upon a computer system, with the computer system being an article of manufacture.

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 ntoed 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 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 or describe the claimed 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. [FN3]

Appellant asserts that the design "should be considered to be surface ornamentation upon a computer system, with the computer system being an article of manufacture." 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. [FN4] 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 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 or shown 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.

Referring to 37 CFR § 1.152, appellant argues that no further illustration or disclosure is necessary because only the design of an icon is being claimed. However, applicant ignores the express language of the rule that requires complete disclosure of the appearance of the article not just the design. The rule also permits the depiction of unclaimed environmental features with broken lines. Appellant could have easily complied with § 1.153 by showing a complete article with broken lines.

Appellant also appears to argue that further disclosure of an article of manufacture is not necessary because this is a design rather than a utility application. As indicated above, we view § 171 as requiring, at a minimum, express disclosure of an article to be ornamented by the design. In any event, 37 CFR § 1.152 expressly requires disclosure of a complete article. To the extent appellant implies that there is a lesser legal standard for the disclosure in design applications than for utility applications, we cannot agree. Appellant's assertion is directly contrary to the second paragraph of § 171 which states:

> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Thus, for example, design applications must meet the requirements of 35 U.S.C. § 112, first paragraph. While this ordinarily requires little if any detailed description, some design applications may require a disclosure as detailed as that in a complex utility application. There is no "per se" rule with respect to the extent of the disclosure necessary in a design application. The adequacy of the disclosure must be determined on a case-by-case basis.

***4** Appellant asserts that affirmance of the rejection would be inconsistent with case law holding that it is permissible to obtain design protection for a portion of an article. We recognize that the Zahn case held that § 171 is not limited to designs for complete articles. We do not think the holding in Zahn helps appellant under the facts of this case. The design in Zahn was for a portion of a drill tool. Not only did Zahn expressly claim a design for a drill tool, the drawings showed the design applied to a complete drill bit. Zahn's Figure 1 is reproduced below:

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Thus, Zahn's design was clearly disclosed and shown embodied in an article. Unlike the facts in Zahn, appellant has not disclosed, claimed or shown the design as part of a computer or any other article of manufacture.

Appellant also asserted at oral argument that the claimed designs are indistinguishable from type or character fonts as far as § 171 is concerned. Moreover, appellant asserted that affirmance of the rejection will bring into question the validity of numerous design patents directed to type fonts. We disagree. The phrase "type font" may

be properly interpreted as referring to letter blocks or pieces used in a conventional printing press. The blocks or pieces constitute an article or articles of manufacture. Unlike the designs here, which are stated to be surface ornamentation, type font designs are reasonably interpreted to be the shape or configuration of the letter blocks. The fact that the meaning of "type font" may have expanded in usage to include letters or numbers appearing on paper or on a computer screen does not invalidate the long-standing interpretation of type font designs as configuration-type designs for pieces or blocks of type.

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. [FN5] 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. We fully agree with appellant's statement in the supplemental reply brief that "the issue of design patentability should most certainly be decided based upon legal precedent and principles...."

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

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

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. We note that the examiner did not require restriction between the designs as shown in Figures 1, 2 and 3. The designs shown in the figures, while sharing common features, appear to be directed to three patentably distinct designs. Requiring restriction, when appropriate, is particularly important in design cases because of the single claim requirement. The presence of patentably distinct designs raises a question asto whether or not the claim encompasses subject matter in addition to what is shown in the drawings. In view of our affirmance, we will not enter a new ground of rejection under 35 U.S.C. § 112, second paragraph, but rather call it to the examiner's attention in the event of further prosecution in this case or any continuing case.

FN2. Be it known that I, Shuichi TAYAMA, have invented a new, original and ornamental design for AN ICON FOR SET UP OPERATION of which the following is a specification, reference being had to the accompanying drawings forming a part hereof and in which:

Fig. 1 is a face view of an icon for set up operation showing my new design;

Fig. 2 is a face view of a second embodiment of my new design;

Fig. 3 is a face view of a fourth embodiment of my new design;

Fig. 5 is a face view of a fifth embodiment of my new design;

Fig. 6 is a face view of a sixth embodiment of my new design;

Fig. 7 is a face view of a seventh embodiment of my new design;

Fig. 8 is a face view of a eighth embodiment of my new design;

Fig. 9 is a face view of a ninth embodiment of my new design.

(It is noted that the specification does not contain any description of Fig. 4.)

FN3. We also note that the design is said to be "for an icon for a set up operation." It is not clear to us what appellant means by "set up operation." The phrase is not defined or explained in the specification. At best the phrase appears to refer to a process rather than an article of manufacture. Design patents, however, are limited by the statute to articles of manufacture.

FN4. 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.

FN5. The rejection in this case was authorized by Commissioner Quigg.

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