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

EX PARTE PAULIEN F. STRIJLAND AND DAVID SCHROIT
Appeal No. 92-0623
April 2, 1992
***1** HEARD: January 31, 1992

Application for Design Patent filed January 26, 1989, Serial No. 07/303608. Information Icon for Display Screen of a Programmed Computer or the Like.

Robert Barr for appellants

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 information icon for the display screen of a programmed computer system. The sole claim on appeal states:

The ornamental design for an information icon for display screen of

a programmed computer system 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
The complete specification, as amended, is reproduced in the footnote. [FN1]

The sole claim stands rejected as unpatentable under 35 U.S.C. § 171. After careful consideration of appellants' 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. Appellants argue 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[s] 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 appellants 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.

Consistent with § 171 and interpreting case law, PTO regulations expressly require that the design must be shown applied to an article. Thus, 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.)

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....

***3** After reviewing the complete record of the prosecution before the examiner, we conclude that appellants have not presented a design for an article of manufacture as required by 35 U.S.C. § 171.

While appellants' specification, claim and title, as amended, expressly state that the claimed design is for the display screen of a programmed computer system, appellants have not shown an applied design. More particularly, they have not shown the design applied to the asserted article as implicitly required by the statute (In re Schnell, 46 F.2d at 209, 8 USPQ at 26; In re Zahn, 617 F.2d at 268, 204 USPQ at 995) and expressly required by 37 CFR § 1.152. The fact that the disclosed designs may be surface ornamentation capable of being

applied to a variety of articles does not eliminate the requirement of showing an applied design. In re Schnell, id. Showing the design applied to an article is a threshold requirement for design protection under 35 U.S.C. § 171.

Under 37 CFR § 1.196(b), the following new grounds of rejection are entered against the claim:

1. The claim is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter appellants regard as their invention. The phrase "or the like" renders the claim indefinite. It is not apparent from the record of this case what articles are "like" a display screen of a programmed computer system. The specification does not provide any standards for determining the other articles 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.

2. The claim on appeal is also rejected under 35 U.S.C. § 112, first paragraph, as being based upon new matter.

The application as originally filed reads as follows:

We, Paulien F. Strijland and David Schroit, have invented a new, original and ornamental design for a[n] INFORMATION ICON 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 information or the like showing our new design in display position;

***4** Fig. 2 is a face view of the icon alone;

Fig. 3 is a face view of an icon for information icon or the like showing a modified form of my (sic) new design;

Figure 4 is a face view of a smaller embodiment of the icon in Fig. 2;

Fig. 5 is a face view of a smaller embodiment of the icon in Fig. 3; and,

Fig. 6 is a face view of the icon in Fig. 2 on an enlarged scale.

The broken line showing of a partial half tone display screen in Fig. 1 is for illustrative purposes only and forms no part of the claimed design.

WE CLAIM:

The ornamental design for an icon for information or the like, as shown and described.

There is no basis in the specification as originally filed for the references in the amendment filed August 29, 1990, to an "information icon for display screen of a programmed computer system." The word "icon" does not limit the design to use with a display screen of a programmed computer or any other article of manufacture. The use of icons on a wide variety of articles is ubiquitous.

Had appellants specification, as originally filed, included the

language added by the above referred to amendment, and included drawings of the type shown in the addendum to this opinion, we would have held that the claimed design is statutory subject matter, and the design would have been patentable in the absence of other grounds for rejection. As permitted by 37 CFR § 1.152, the article may be shown with broken lines. Appellants' Figure 1, which is said to show the design in display position on a screen, is insufficient to constitute a complete disclosure of the appearance of the specified article.

It should be noted, however, we do not think that merely illustrating a picture displayed on the screen of a computer or other display device, such as a television or movie screen, is sufficient, alone, to convert a picture into a design for an article of manufacture. Mere display of a picture on a screen is not significantly different, in our view, from the display of a picture on a piece of paper. Only the medium of display is different. However, appellants have expressly stated in the specification and claim, as amended, that the article of manufacture which embodies or to which the claimed design is applied is a programmed computer system, and they have provided declaration evidence demonstrating that the icon is an integral part of the operation of a programmed computer. The declaration of one of the designers, David Schroit, states:

The design for this Icon for Information or the like is intended to be displayed on the display screen of a running computer system. The user of the system, using a "mouse," places the cursor over this icon, "clicks" a button on the mouse, and presses the 'open' key on the keyboard (or, alternatively, double clicks a mouse button). The action "opens the icon", that is, it opens a window on the display screen revealing information. In the case of this particular icon, opening the icon has the effect of opening a window of an application which connects to a host computer to retrieve and display information intended for executives.

***5** The other designer, Paulien F. Strijland, states:

This ICON FOR INFORMATION OR THE LIKE was created to be displayed on the screen of a computer system. When the icon is "opened", the user can access an executive information system to retrieve data from a remote data base and to represent that data in a graphical format.

The declarations indicate that the intended design is not merely a displayed picture, but an integral and active component in the operation of a programmed computer displaying the design. Therefore, the subject matter, if properly presented and claimed would have constituted statutory subject matter under 35 U.S.C. § 171.

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 appellants 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 appellants elect 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 appellants elect 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

Irving R. Pellman

Examiner-in-Chief

CONCURRING OPINION

Robert F. Stahl

Examiner-in-Chief

I concur with my colleagues assigned to decide this appeal that a design per se is not patentable under 35 USC 171, that the claim is indefinite under 35 USC 112, second paragraph and is replete with new matter under 35 USC 112, first paragraph. The new rejections of the claim under these statutory provisions in this decision is appropriate.

***6** I, like my colleagues, conclude that the claim, including the phrase "or the like," is both 1) indefinite under 35 USC 112, second paragraph, and 2) not in the format specifically required by 37 CFR 1.153 [FN2]. I, therefore, concur in the rejection of this claim under 37 CFR 1.196(b) by the majority. For the purpose of this separate opinion, like the majority, I interpret the claim subject matter as though the phrase "or the like" were not in the claim. Compare Ex parte Sussman, 8 USPQ2d 1444 (BPAI).

The Claim Interpretation

For the purpose of evaluating the appealed § 171 rejection the decision must include an interpretation of the claim as amended. It is the majority's position, as I understand it, that the claim includes the icon embodied in the article of manufacture, i.e., "[a] programmed computer system, comprising a processor, a display device and a program exciting on the processor," and that a drawing showing this article of manufacture coupled with the appealed claim language would have made the icon design patentable under the provisions of § 171.

Initially, I disagree that the claim on appeal has all the structure of the article of manufacture that the majority says that it does, nor do I find that the appellants have stated that the claim includes this definition of the article of manufacture. Secondly, I can not see how illustrating more elements in the drawing, as suggested by the majority, changes the issue that has been presented to us in the rejection under § 171 in this appeal. The majority states that an image projected on a screen is not patentable under § 171, and I agree, but merely adding figures to the drawing can not change the determination in my view.

The many utility aspects of the icon on the display screen urged by the appellants in the brief are all utility considerations that are totally irrelevant to the ornamental appearance of the design and need not be illustrated as they form no part of the ornamental design as filed or as the claim has been amended. Accordingly, I would affirm the § 171 rejection on the basis set forth by the majority and not back off with the added figures to the drawing. The majority's extremely narrow interpretation of this claim is unfairly limiting the scope and content of the claim, in my view, and is inconsistent with 35 USC 112, second paragraph.

If the phrase "for an information icon", included in the language of the claim, is used to introduce a further utility aspect to the design or the article on which the design is displayed it has no bearing whatsoever on the patentability of the design. In reGlavas, 230 F.2d 447, 109 USPQ 50 (CCPA 1956); In re Finch, 535 F.2d 70, 190 USPQ 64 (CCPA 1976). In Glavas the court stated that:

***7** It is true that the use to which an article is to be put has no bearing on the patentability as a design and that if the prior art discloses any article of substantially the same appearance as that of the applicant, it is immaterial what the use of such article is. [citations omitted]

In Finch the court clearly stated that:

The "utility requirement" of 35 USC 101 is not applicable to design inventions.... The criteria in 35 USC 171 for design are that the invention be "new," "original," and "ornamental." We cannot assume that Congress did a useless thing in deleting "useful" when it legislated with respect to designs.... Hence, the criteria of 35 USC 101 are "otherwise provided" in 35 USC 171 and the second paragraph of the latter cannot serve to permit the reading therein of the "useful" criteria of 35 USC 101.

§ 171 Consideration

The primary issue in this appeal is whether the ornamental design of an icon, shown and described, for display on a display screen of a programmed computer system, is appropriate subject matter for patenting under 35 USC 171. This issue, in its broadest sense, is a legal issue of long standing with which the USPTO and the courts have wrestled with throughout the twentieth century and even earlier than that. The design name "icon" (as applied to a computer screen) and the place that the icon design is displayed "a display screen of a programmed computer" have been added to the equation, but the legal issue of whether the screen is ornamented by the icon design and whether the design for the article of manufacture falls within 35 USC § 171 involve broad issues that has been with us for a very long time.

The claim, properly interpreted in my view, is a design per se and is unpatentable under § 171 for the reasons generally expressed by the majority. If we assume that the appellants' design is new and ornamental as required by § 171, and there is no evidence in any prior art of record that would indicate the contrary, the application design meets the first part of the statute. If a computer screen is an article of manufacture, and it certainly is, the second part of the statute appears to be met if one agrees that the designed icon is "for" the ornamentation of the screen. It is my conclusion that the computer screen just like the articles of manufacture, such as a sheet of paper, an artist's canvas and a movie screen, are all articles of manufacture that are not normally ornamented by a design being placed thereon or more properly stated, in my opinion, displayed thereon. The computer display screen of the present claim is merely a different medium (article of manufacture) from a piece of paper, an artist's canvas or a movie screen for such design display and the computer screen. One must, to appreciate this distinction, understand the significant difference between the phrases a design displayed on and a design applied to an article of manufacture. Accordingly, in the case before us, since the computer display screen is only a medium for the display of the designed icon, the claim under review is merely directed to the designed icon and not an icon that is "applied to" [In re Schnell, supra] or "embodied in," [In re Zahn, supra] the article of manufacture as required by the decisions of our review courts. Where the article of manufacture functions as a mere display for a design of an icon and the article of manufacture is not ornamented by the displayed design; the claim is merely directed to the design per se and is not a design that is encompassed by 35 USC § 171.

***8** The majority of this panel and the appellants appear to agree (brief page 8) that a design displayed on a piece of paper does not ornament the piece of paper and would not be proper subject matter for a design patent under § 171 [FN3]. It is assumed that the appellants would, along the same legal lines of argument, agree that a new and ornamental design, painted or otherwise displayed on a canvass or projected on a movie screen would likewise lack ornamentation of the canvas or movie screen. The arguments of the appellants in the brief that urge a distinction between that which the appellants agree is not covered under § 171 and the claim of the present design invention is not understood at all. Particular note in this regard is made of the appellants' statement in the brief that the computer display screen is

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'useful article' i.e., an article having an intrinsic utilitarian function other than the display of the picture, ... [so that] the picture may serve as surface ornamentation for the article.

While I have to agree that a computer screen has a utilitarian function and that the electron illumination of the phosphor coating of a cathode ray tube displays the design on a computer screen, to say that one has ornamented the screen surface thereby in the United States design patenting sense of that phrase, is believed to be in error. To the contrary, one does not want to ornament the computer display screen surface or a portion of the screen, other than for temporary display purposes, so as not to preclude other icon designs from being placed on the screen and without the images being superimposed.

In the cases cited above and in the majority opinion none has ever sanctioned the patentability of designs per se, and that is just what the claimed icon design of the present application is. Contrary to the appellants' arguments one does not purchase [FN4] a computer display screen or a total computer system because it has an icon design thereon, in fact, the computer display screen, like the piece of paper, the artist's canvass and the movie screen are normally blank and totally without ornamentation. [FN5]

In the absence of mental telepathy, one who invents a new and ornamental design in one's mind may not be able to readily explain to others what that design is and may therefore desire to place the design on some display medium so that others may understand and appreciate the design. That is just what Raphael and Michelangelo did when they painted their new and ornamental designs or other art work on their blank canvasses and what they would do, using a paint computer program on a display screen of a computer, if they were alive today. In a similar argument the designers of the art work for the Walt Disney movie, Bambie, merely placed their new and unobvious designs on blank sheets of paper or cardboard so that one could appreciate the art forms 1) on the sheets of paper, 2) on the frames of the movie film or 3) projected icon images of a movie film onto a theater projection screen, but one would not say that there was ornamentation of the paper, the film or the theater screen upon which the art form was originally drawn or thereafter displayed. In a similar manner there is no ornamentation of the computer display screen in this case.

***9** I clearly distinguish wallpaper, wrapping paper and stationery that have been subject matter of design patents for many years. In each of these cases it was the clear intention to incorporate the design into the paper products not for the mere display of the design, which they clearly do, but for the purpose of truly ornamenting the paper upon which the design is placed. The paper so ornamented is what is sold and the design thereon is what assists in the sale of the article of manufacture (paper) in question. compare In re Hruby, supra.

I, accordingly, would make no suggestion for allowability, regardless how tentative, on the subject matter of the claim in this case.

ADDENDUM

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

FN1. We, Paulien F. Strijland and David Schroit, have invented a new, original and ornamental design for a[n] Information Icon for Display Screen of a Programmed Computer System 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 information icon for display screen of a programmed computer system or the like showing our new design in display position;

Fig. 2 is a face view of the icon alone;

Fig. 3 is a face view of an information icon for display screen of a programmed computer system or the like showing a modified form of my new design;

Figure 4 is a face view of a smaller embodiment of the icon in Fig. 2;

Fig. 5 is a face view of a smaller embodiment of the icon in Fig. 3; and,

Fig. 6 is a face view of the icon in Fig. 2 on an enlarged scale.

The broken line showing of a partial half tone display screen in Fig. 1 is for illustrative purposes only and forms no part of the claimed design.

FN2. 37 CFR 1.153 states in part

The claim shall be in formal terms to an ornamental design for the article (specifying name) as shown, or as shown and described.

FN3. I believe that at the hearing that Counsel came to this conclusion after having read the decision William Whyte 1871 CD 304 (Decisions of the Commissioner 1869-71).

FN4. In re Hruby, supra, 374 F.2d 908; 153 USPQ 181 (CCPA, 1967) at 64.

Fountains are what the appellant (or someone connected with him) sells.... There is no doubt in our minds that prospective buyers of these fountains would select them for the decoration of buildings or grounds according to the specific, reproducible designs [of the fountain], intending to use them as permanent decoration.

FN5. I exclude surface ornamentation of these display mediums here, because certain stationery, artist's canvass and movie screen are provided with unique ornamentation that is purposeful, aids in the sale of the medium and is properly considered ornamented under § 171.

26 U.S.P.Q.2d 1259

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