

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD P. REGAN JR. and STEPHEN K. BRIGHT

Appeal No. 98-1689
Application No. 07/715,259¹

ON BRIEF

Before FRANKFORT, KRASS and WEIFFENBACH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of the only claim pending:

The ornamental design for A COMPUTER DISPLAY as shown and described.

¹Application for patent filed June 14, 1991.

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The claim was amended to read as such in an amendment filed December 19, 1996 (Paper No. 10). As originally filed, the claim read as follows:

The ornamental design for a PAGE RETRIEVAL ICON FOR A COMPUTER DISPLAY OR THE LIKE as shown and described.

There are no references relied on by the examiner.

The sole claim on appeal stands rejected under 35 U.S.C. 112, first paragraph, as relying on an inadequate written description, the examiner contending that the proposed drawing amendment (filed May 24, 1993) of a rectangular display screen in broken lines around the previously depicted icon constitutes new matter as there is inadequate support for a computer display screen in the application as originally filed.

The claim stands further rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter regarding design claims.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We affirm.

The controlling case for the issue presented under § 171 is Ex parte Strijland, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992) wherein it was held that icons, of the type of interest herein, per se, are not protectable by design patent because 37 CFR 1.152 and 1.153(a), consistent with 35 U.S.C. 171, require that the design must be applied to an article of manufacture since the "factor which distinguishes statutory design subject matter from mere picture or surface ornamentation per se (i.e., abstract designs) is the embodiment of the design in an article of manufacture."

Strijland, 26 USPQ2d 1259, 1262.

The majority in Strijland went further and, in dicta, stated, 26 USPQ2d at 1263,

Had appellants' specification, as originally filed, included the language added by the above referred to amendments, and included drawings of the type shown in the addendum to this opinion² 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 of rejection.

²Those drawings depict the icon on a display screen of a computer, the computer processor and the video monitor having the display screen being all in dotted lines.

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While not having the force of law, this dicta was the subject of the Guidelines for Examination of Design Patent Applications for Computer-Generated Icons (Guidelines), 1185 O.G. 60 (April 16, 1996) and incorporated into MPEP 1504.01.

Since an icon, per se, as depicted in the instant case, as originally filed, is a mere picture, not part of any embodiment of an article of manufacture, the examiner quite properly, and in accordance with Strijland and the Guidelines, rejected the design claim for "The ornamental design for a PAGE RETRIEVAL ICON FOR A COMPUTER DISPLAY OR THE LIKE as shown and described" as being directed to nonstatutory subject matter under 35 U.S.C. 171.³

Unfortunately for appellants, Strijland was decided after the filing of this application. So, in a valiant effort to comply with Strijland and the Guidelines, appellants amended the claim to read, "The ornamental design for A COMPUTER DISPLAY as shown and described." Further, appellants amended

³This claim would also be properly rejectable under 35 U.S.C. 112, second paragraph, for the reasons set forth in Strijland, at 26 USPQ2d 1262 regarding the language "OR THE LIKE." The examiner withdrew this rejection in light of appellants' amendment of December 19, 1996.

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the description of the drawings and entered a disclaimer into the specification regarding broken line illustrations in the drawings. Most importantly, appellants amended the drawings to show broken lines around the original depiction of the icon.

The examiner contends that such amendments constitute new matter and that there is no support in the original disclosure for that which is now claimed, within the meaning of the written description requirement of 35 U.S.C. 112, first paragraph.

Appellants contend that there is adequate support since the original disclosure specified that the Page Retrieval Icon is "for a computer display" and that the original disclosure of a "computer display" should constitute adequate support for that which is now claimed.

We agree with the examiner [answer-page 5] that the mere mention of a "computer display" could "mean a multiplicity of visual representations--a three dimensional computer monitor, a display on a photocopier, a display on a dashboard of an automobile, a display on an automatic teller machine, a narrow display screen, a large display screen, a circular screen, a

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curved screen, etc." Thus, there is no support for an icon embodied in the article of manufacture now attempted to be shown by appellants with broken lines. There is no evidence that appellants had possession of the particular design, i.e., the page retrieval icon embodied in a screen in the particular manner shown by the amended drawings, at the time of filing the application. For the reasons given by the examiner at pages 4-11 of the answer, which we adopt as our own, we will sustain the rejection of the design claim under 35 U.S.C. 112, first paragraph.

As an additional reason for sustaining this rejection, we note that the evidence indicates that at the time of filing the original application, appellants had no intention of disclosing or claiming a computer display with a page retrieval icon, but, rather, appellants were interested only in obtaining protection for the design of the icon, itself. We note the title of the application, "Page Retrieval Icon *For* a Computer Display" [emphasis ours]. Thus, the display, itself, and/or the icon's relationship with such display appears to have been of no interest to appellants. It was clearly the icon, itself, for use with or on a computer

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display, which was of interest. The original claim, too, was for a "PAGE RETRIEVAL ICON" which was only "FOR" a computer display. Thus, again, the display was never intended, in the original disclosure, to form any part of the invention. The originally disclosed and claimed design was clearly for the icon, per se, and not for any embodiment of that icon in a display as an article of manufacture. We find that there clearly was no disclosure in the specification, as originally filed, for the now claimed design for a computer display.

Because we sustain the examiner's rejection of the claim under 35 U.S.C. 112, first paragraph, the broken lines around the icon in the drawings do constitute new matter and are not permissible. Accordingly, with the original drawings then before us, the design claim is clearly drawn to an icon, per se and such a claim, under Strijland, is directed to nonstatutory subject matter under 35 U.S.C. 171. Accordingly, we also sustain the rejection of the claim under 35 U.S.C. 171.

Moreover, we note that the panel in Strijland indicated that the claimed design therein would have been deemed to constitute statutory subject matter had the icon been embodied

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in the display of a computer, showing the computer and the video monitor (having the display with the icon shown thereon) in broken lines. While this was mere dicta, and we are not bound thereby, we would note that whereas the suggested embodiment therein was at least directed to a computer system, showing the computer processor and the video monitor in broken line, wherein the icon was clearly shown on the display of a computer, this is a far cry from appellants' attempted amendment, placing a mere broken line rectangle around the icon, wherein the rectangle, albeit said to represent a computer display, may, in reality, represent almost anything, including, for example, a sheet of paper on which the icon is placed. Quite clearly, a sheet of paper having the icon imprinted thereon would not constitute patentable subject matter under 35 U.S.C. 171. A simple, broken, rectangular line placed around an icon, in our view, does not constitute an embodiment of the icon design in an article of manufacture. In this regard, we direct attention to Strijland, at 26 USPQ2d 1263, wherein that panel of the Board indicated that:

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

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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.

Note, also, the special concurrence by Examiner-in-Chief Stahl, at 12 USPQ2d 1264-1266.

We have sustained both the rejection under 35 U.S.C. 112, first paragraph, and the rejection under 35 U.S.C. 171.

Accordingly, the examiner's decision is affirmed.

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

AFFIRMED

	CHARLES E. FRANKFORT)	
	Administrative Patent Judge))	
)	
)	
	ERROL A. KRASS)	BOARD OF
PATENT	Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
	CAMERON WEIFFENBACH)	
	Administrative Patent Judge))	

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Ronald Zibelli
Xerox Corporation
Xerox Square 020
Rochester, NY 14644