

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. HERCEG, JAMES B. WILLIAMS, JR.,
EUGENE L. SMITH, and JOSEPH L. FILION

Appeal No. 98-1693
Application D-07/343,182¹

ON BRIEF

Before FRANKFORT, KRASS, and WEIFFENBACH, Administrative
Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 24, 1989.
According to appellants, the application is a continuation-in-
part of Application 07/164,365, filed March 4, 1988, now
Patent No. 5,079,723.

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This is a decision on appeal from the final rejection of the

only claim pending:

-- The ornamental design for the touch video graphic icon for copy trim function as shown. --

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 April 26, 1993) of a rectangular screen in broken lines around the previously depicted icon constitutes new matter as there is inadequate support for a video touch 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

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We affirm.

The controlling case for the issue presented under § 171 is Ex parte Strijland, 26 USPQ2d 1259 (Bd. Pat. App. & Interferences 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, at 26 USPQ2d 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

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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subject matter, and the design would have been patentable in the absence of other grounds of rejection.

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 Off. Gaz. Pat. & Trademark Off. 60 (April 16, 1996) and incorporated into the Manual of Patent Examining Procedures (MPEP) § 1504.01 (6th ed., rev. 3, July 1997).

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 the touch video graphic icon for copy trim function as shown" as being directed to nonstatutory subject matter under 35 U.S.C. § 171.

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 description of the drawings and, most importantly,

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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, at least inferentially, a "touch video screen" and a touch video icon cannot exist without a touch video screen. Therefore, contend appellants, there is adequate support in the original disclosure for that which is now claimed.

We agree with the examiner [answer-page 5] that the mere mention of a "touch video" 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 curved screen, etc." Thus, there is no support for an icon

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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 touch video graphic icon for copy trim function embodied in a touch video 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.

Particularly with regard to the Herceg declaration, we agree with the examiner that there is no dispute that the icon which is the subject of the claimed design is for use on a computer-related display or touch video display. We also agree with declarant that touch video screens are well known. The question before us, however, is whether there was adequate support in the original disclosure for that which is now claimed, i.e., the icon originally shown in the drawings surrounded by a broken line purporting to depict a touch video screen. We find nothing in the declaration that convinces us

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that there was, indeed, adequate support for that which is now claimed.

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 touch video screen having a touch video graphic icon for copy trim function, but, rather, appellants were interested only in obtaining protection for the design of the icon, itself. It was clearly the icon, itself, for use with or on a video touch screen, which was of interest. The video touch screen 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 video touch screen as an article of manufacture. We find that there clearly was no disclosure in the specification, as originally filed, for the now claimed design (as depicted in the amended drawings) for a touch video graphic icon for copy trim function incorporated into a video touch screen as an article of manufacture. Moreover, we note that the design

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claim before us in this appeal is directed to "The ornamental design for the touch video graphic icon for copy trim function as shown" (emphasis added) and not to any article of manufacture embodying that icon. In addition, the title and description in appellants' specification have not been amended to clarify that the claimed design is embodied in an article of manufacture. Note, particularly, 37 CFR § 1.153 and the requirement therein that the title of the design "must designate the particular article" and the further requirement that the claim "shall be in formal terms to the ornamental design for the article . . . as shown, or as shown and described" (emphasis added).

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.

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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 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 video touch screen, 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

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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 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)	
)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
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