## Patent and Trademark Office RIN 0651-XX04

[Docket No. 950921236-5236-01]

## Interim Guidelines for Examination of **Design Patent Applications for Computer-Generated Icons**

**AGENCY:** Patent and Trademark Office, Commerce.

**ACTION:** Notice and request for public comments.

**SUMMARY:** The Patent and Trademark Office (PTO) requests comments from any interested member of the public on interim guidelines that will be used by PTO personnel in their review of design patent applications for computergenerated icons. Because these guidelines govern internal practices, they are exempt from notice and comment rulemaking under 5 U.S.C. 553(b)(A).

DATES: October 5, 1995.

Written comments on the interim guidelines will be accepted by the PTO until November 6, 1995

Written comments will be available for public inspection on November 20, 1995, in Room 8D19 of Crystal Plaza 3, 2021 Jefferson Davis Highway, Arlington, Virginia. In addition, comments provided in machinereadable format will be available through anonymous file transfer protocol (ftp) via the Internet (address: comments.uspto.gov) and through the World Wide Web (address: www.uspto.gov).

ADDRESSES: Written comments should be addressed to the Assistant Commissioner for Patents, Washington, DC 20231, marked to the attention of John Kittle, Director, Group 1100/2900, Crystal Plaza 3, 8D19. Comments may also be submitted by telefax at (703) 305–3600 or by electronic mail through the INTERNET to "icon-pat@uspto.gov."

FOR FURTHER INFORMATION CONTACT: John Kittle by telephone at (703) 308-1495 or by mail to his attention addressed to the Assistant Commissioner for Patents, Group 1100/ 2900, Washington, DC 20231.

SUPPLEMENTARY INFORMATION: Written comments should include the following information:

-Names and affiliation of the individual responding;

-An indication of whether the comments offered represent views of the respondent's organization or are the respondent's personal views; and

If applicable, information on the respondent's organization, including the type of organization and general areas of interest.

Parties presenting written comments are requested, where possible, to provide their comments in machinereadable format. Such submissions may be provided by electronic mail messages sent over the Internet, or on a 3.5" floppy disk formatted for use in either a Macintosh or MS-DOS based computer. Machine-readable submissions should be provided as unformatted text (e.g., ASCII or plain text).

Dated: September 29, 1995. Lawrence J. Goffney, Jr.,

Acting Assistant Secretary of Commerce and Acting Commissioner of Patents and Trademarks.

I. Interim Guidelines for Examination of Design Patent Applications for **Computer-Generated Icons** 

The following guidelines have been primarily developed to assist PTO personnel in determining whether design patent applications for computergenerated icons comply with the article of manufacture" requirement of 35 U.S.C. 171.1

A. General Principle Governing Compliance with the "Article of Manufacture" Requirement

A design for a computer-generated icon<sup>2</sup> which is embodied in an article of manufacture is statutory subject matter for a design patent under Section 171. Thus, if an application claims a computer-generated icon embodied in a computer screen, monitor, other display panel, or a portion thereof,<sup>3</sup> that is drawn in solid lines,4 the claim complies with the "article of manufacture" requirement of Section 171.

B. Procedures for Evaluating Whether Design Patent Applications Drawn to Computer-Generated Icons Comply With the "Article of Manufacture" Requirement

PTO personnel shall adhere to the following procedures when reviewing design patent applications drawn to computer-generated icons for compliance with the "article of manufacture" requirement of Section 171.

- 1. Read the entire disclosure to determine what the applicant claims as the design,<sup>5</sup> and to determine whether the design is embodied in an article of manufacture. 37 CFR 1.71 and 1.152-54.
- a. Review the drawing to determine whether a computer screen, monitor, other display panel, or portion thereof, is depicted in solid lines. 37 CFR 1.152.
- b. Review the title to determine whether it clearly describes the claimed subject matter.6 37 CFR 1.153.

c. Review the specification to determine whether a characteristic feature statement is present. 37 CFR 1.71. If a characteristics feature statement is present, determine whether it describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof.<sup>7</sup>

2. If the drawing does not depict a computer-generated icon embodied in a computer screen, monitor, or a portion thereof, in solid lines, reject the claimed design under Section 171 and 35 U.S.C. 112, second paragraph, for failing to: (i) comply with the article of manufacture requirement; and (ii) particularly point out and distinctly claim the subject matter which the applicant regards as the invention.8

a. If the disclosure as a whole does not suggest or describe 9 the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof, indicate that: (i) the claim is defective under Sections 171 and 112, second paragraph; and (ii) amendments to the written description, drawings and/or claim attempting to overcome the rejections will be rejected under 35 U.S.C. 112, first paragraph, for lack of written description and changes to the written description and drawings will be disapproved under 35 U.S.C. 132 as constituting new matter.

b. if the disclosure as a whole suggests or describes the claimed subject matter as a computer-generated icon embodied in a computer screen, monitor, other display panel, or portion thereof, indicate that the drawing may be amended to overcome the rejections under Section 171 and 112, second paragraph. Suggest amendments which would bring the claim into compliance with Section 171 and 112, second paragraph.

- 3. Indicate all objections to the disclosure for failure to comply with the formal requirements of the Rules of Practice in Patent Case. 37 CFR 1.71, 1.181–85, and 1.152–154. Suggest amendments which would bring the disclosure into compliance with the formal requirements of the Rules of Practice in Patent Cases.
  - 4. Upon response by applicant:
- a. Review applicant's arguments and any amendments;
- b. Approve entry of any amendments which have support in the original disclosure:
- c. Review all arguments and evidence of record to determine whether the drawing, title, and specification clearly disclose a computer-generated icon embodied in a computer screen,