



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2023-0047]

Supplemental Guidance for Examination of Design Patent Applications Related to Computer-generated Electronic Images, Including Computer-generated Icons and Graphical User Interfaces

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Examination guidance.

SUMMARY: The United States Patent and Trademark Office (USPTO) is publishing supplemental guidance to be used by USPTO personnel in determining whether a design claim including a computer-generated electronic image is directed to statutory subject matter. This guidance reflects current USPTO practice.

DATES: This supplemental guidance is applicable as of [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, enter docket number PTO-P-2023-0047 on the homepage and click “Search.” The site will provide a search results page listing all documents associated with this docket. Find a reference to this document and click on the “Comment” icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in Adobe® portable document format (PDF) or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Erin Harriman, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727; or Carolyn Kosowski, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7688.

SUPPLEMENTARY INFORMATION: The USPTO has prepared supplemental guidance for use by USPTO personnel in determining whether a design patent claim including a computer-generated electronic image per se or a computer-generated electronic image shown on a display panel (e.g., computer screen, monitor, computer display system, mobile phone screen, virtual reality/augmented reality goggles), or a portion thereof, satisfies the article of manufacture requirement in 35 U.S.C. 171. This guidance supplements the guidance provided in section 1504.01(a), subsection (I) of the Manual of Patent Examining Procedure (MPEP) (9th ed., Rev. 07.2022, February 2023).

This guidance does not constitute substantive rulemaking and therefore does not have the force and effect of law. It has been developed as a matter of internal USPTO management and is not intended to create any right or benefit, substantive or procedural, enforceable by any party against the USPTO. Rejections will continue to be based on the substantive law, and it is these rejections that are appealable. Consequently, any failure by USPTO personnel to follow the guidance is neither appealable nor petitionable.

This guidance is not intended to announce any new USPTO practice or procedure, and is meant to be consistent with current USPTO policy. However, if any earlier guidance from the USPTO, including any section of the current MPEP, is inconsistent with the guidance set forth in this notice, USPTO personnel are to follow this guidance. This guidance will be incorporated into the MPEP in due course.

I. Background

On December 21, 2020, the USPTO published a request for information seeking public input on “whether its interpretation of the article of manufacture requirement in the United States Code should be revised to protect digital designs that encompass new and emerging technologies.” See *The Article of Manufacture Requirement*, 85 FR 83063. A summary of the public comments is available to the public on the USPTO’s website at www.uspto.gov/sites/default/files/documents/USPTO-Articles-of-Manufacture-April2022.pdf.

The USPTO appreciates the feedback the public provided. MPEP section 1504.01(a)(I) offers guidelines for the examination of design patent applications for computer-generated icons (also referred to as “computer icons”) that has also been used during the examination of design patent applications related to graphical user interfaces (GUIs). In response to the feedback received, the USPTO has determined that the public would benefit from further clarifications to MPEP section 1504.01(a)(I). Such clarifications would also advance the mission of the USPTO to issue and maintain robust and reliable patents. For example, the USPTO has determined that the public would benefit from additional clarity that the guidance in MPEP section 1504.01(a)(I) does not permit design patent protection for a mere image on a screen. Thus, the USPTO is issuing this notice to supplement the guidance in MPEP section 1504.01(a)(I). This supplemental guidance does not change the current guidance but provides important clarifications. The USPTO welcomes public feedback on this supplemental guidance. Instructions for submitting feedback are provided in the ADDRESSES section of this notice.

This supplemental guidance will raise awareness regarding how to file for protection for subject matter related to computer-generated electronic images, if appropriate, including the proper claim language and title to use when seeking such

protection. Publishing these guidelines will also promote consistent analysis by USPTO personnel of the article of manufacture requirement in design patent applications and reexamination proceedings and by the Patent Trial and Appeal Board in both ex parte appeals and post-patent issuance proceedings. Thus, this notice supports the USPTO's mission of promoting an efficient, effective, and fair intellectual property ecosystem.

II. General Principles Governing Compliance with the Article of Manufacture Requirement

35 U.S.C. 171 provides that “[w]hoever invents any new, original and ornamental design *for an article of manufacture* may obtain a patent therefor” (emphasis added). The language “new, original and ornamental design for an article of manufacture” set forth in 35 U.S.C. 171 has been interpreted to include at least three kinds of designs: (1) a design for an ornament, impression, print, or picture that is applied to or embodied in an article of manufacture (surface indicia); (2) a design for the shape or configuration of an article of manufacture; and (3) a combination of the first two categories. See *In re Schnell*, 46 F.2d 203, 8 USPQ 19 (CCPA 1931); *Ex parte Donaldson*, 26 USPQ2d 1250 (Bd. Pat. App. & Int. 1992). See also MPEP section 1504.01.

As discussed in MPEP section 1502, a “[d]esign is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation.” See *Curver Luxembourg, SARL v. Home Expressions, Inc.*, 938 F.3d 1334, 1340, 2019 USPQ2d 341902 (Fed. Cir. 2019) (noting “that long-standing precedent, unchallenged regulation, and agency practice all consistently support the view that design patents are granted only for a design applied to an article of manufacture, and not a design *per se*”). Further, as discussed in MPEP section 1504.01, “a picture standing alone is not patentable under 35 U.S.C. 171. The factor which distinguishes statutory design subject matter from mere picture or ornamentation, *per se* (i.e., abstract design), is the embodiment of the design in an article of manufacture. Consistent with 35 U.S.C. 171, case law and USPTO

practice, the design must be shown as applied to or embodied in an article of manufacture.”

See also *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992).

III. Background Regarding MPEP Section 1504.0(a), Computer-generated Icons

In 1992, the Commissioner of Patents and Trademarks (the agency’s principal at that time) and Deputy Commissioner sitting in an expanded panel of the USPTO Board of Patent Appeals and Interferences reviewed *In re Schnell*, 46 F.2d 203, 8 USPQ 19 (CCPA 1931) and *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980) and determined that “a picture standing alone is not protectable by a design patent,” and “[t]he 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.” *Ex parte Strijland*, 26 USPQ2d at 1262. Applying prevailing case law to a new technology of presenting a picture on a computer screen, the expanded Board panel in *Strijland* explained that: “[i]t 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.” *Strijland*, 26 USPQ2d at 1263. The panel also noted that appellants “provided declaration evidence demonstrating that the icon is an integral part of the operation of a programmed computer” and that “[t]he 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.” *Id.* Thus, the expanded Board panel explained that such an icon, “if properly presented and claimed would have constituted statutory subject matter under 35 U.S.C. 171.” *Id.*

Following the agency's decision in *Ex parte Strijland*, the USPTO issued a notice of hearings and request for public comments. Public Hearings and Request for Comments on Patent Protection for Software-Related Inventions, 58 FR 66347 (December 20, 1993). Among other questions, the USPTO sought public feedback on the language in *Ex parte Strijland*, specifically asking whether "a description in a specification indicating how a displayed image is an 'integral and active component in the operation of a programmed computer displaying the design' provide[s] a workable line between statutory and non-statutory design subject matter." *Id.* at 66352. The notice made clear that images displayed on a computer screen standing alone were treated the same as mere pictures and did not qualify as computer icons, which the agency had defined as integral and active components in the operation of a programmed computer displaying the design. *Id.* Thus, images merely displayed on a computer screen were not considered eligible under 35 U.S.C. 171.

Over the next few years, the USPTO engaged with the public in a process that resulted in the examination guidelines currently in MPEP section 1504.01(a), subsection (I) in which computer icons (as opposed to mere computer-generated images) are considered by the USPTO to comply with the article of manufacture requirement of 35 U.S.C. 171 because they are integral and active components in the operation of a programmed computer displaying the design. These guidelines have also been used in the examination of design patent applications related to GUIs in which GUIs are considered by the USPTO to be integral and active components in the operation of a programmed computer displaying the design. Therefore, if properly presented and claimed, a display panel with a computer icon or a GUI—as an integral and active component in the operation of a programmed computer displaying the design—constitutes statutory subject matter under 35 U.S.C. 171.

IV. Supplemental Guidelines for Examination of Design Patent Applications Related to Computer-generated Electronic Images

In view of the above, the mere display of a computer-generated electronic image that is not a computer icon or a GUI (i.e., that is not an integral and active component in the operation of a computer) shown on a display panel does not constitute statutory subject matter under 35 U.S.C. 171. However, the USPTO considers a computer icon or a GUI shown on a display panel, or a portion thereof, to be more than a mere display of a picture on a screen because a computer icon or a GUI is an integral and active component in the operation of—i.e., embodied in and/or applied to—a programmed computer displaying the computer icon or the GUI. Therefore, a computer icon or a GUI is eligible under 35 U.S.C. 171, if properly presented and claimed (e.g., the drawing(s) fully discloses the design as embodied in the article of manufacture).

Office personnel must consider the complete disclosure when evaluating whether a design claim that includes a computer-generated electronic image complies with the article of manufacture requirement. More specifically, USPTO personnel must read the disclosure to determine what is claimed as the design and whether the design is embodied in an article of manufacture. USPTO personnel must:

a. Review the title and claim language to determine whether the title and claim adequately describe a design for an article of manufacture under 35 U.S.C.

171. USPTO personnel must also consider the following and, where appropriate, make the noted objections and rejections.

1. A computer-generated electronic image shown on a display panel that is not a computer icon or a GUI (i.e., that is not an integral and active component in the operation of a computer) is a mere illustration of a picture displayed electronically. Therefore, a claim to the image per se, to a display panel (or a portion thereof) with the

image, or to the image for display on a display panel, will not satisfy the article of manufacture requirement, and such a claim should be rejected under 35 U.S.C. 171 for failing to comply with the article of manufacture requirement.

2. The USPTO considers computer icons or GUIs to be two-dimensional images which standing alone are surface ornamentation (i.e., an ornament, impression, print, or picture). See MPEP section 1504.01(a)(I). Therefore, the title and the claim should not be for a computer icon or a GUI alone, but must be for an article of manufacture, for example, a “display panel with computer icon.”

3. When a design claim is to a display panel with a computer-generated image, the USPTO considers the term “icon” or “GUI” in the title and the claim to be indicating that the image on the display panel is not merely a displayed picture, but an integral and active component in the operation of a programmed computer displaying the image. See *Ex parte Strijland*, 26 USPQ2d at 1263. Therefore, a claim and title directed to a display screen with an icon or a GUI adequately describes a design for an article of manufacture under 35 U.S.C. 171. (Note that though the underlying article of manufacture for an icon or a GUI has functional properties, the design of the icon or the GUI itself is not functional, and thus this subsection is not in tension with, nor does it contradict, the functionality doctrine, which requires that design patent protection extend only to the “ornamental design” of an article of manufacture. See 35 U.S.C. 171(a); MPEP section 1504.01(c), subsection (I)).

4. The following are examples of claim language and titles that *DO NOT* adequately describe a design for an article of manufacture under 35 U.S.C. 171: “display screen with virtual image,” “virtual image for display on computer screen,” “computer icon,” and “icon for computer screen.” This list of examples is not exhaustive. These types of claims and titles should be objected to under 37 CFR 1.153(a) for failing to designate a particular article of manufacture, and the objection should be maintained until the title and the claim language are appropriately amended. See MPEP section 707.07(e). Note that a determination must be made as to whether a rejection under 35 U.S.C. 171 is appropriate (e.g., the application fails to provide support for an icon or a GUI). See paragraph (i) above; see also section (b) and example 3 below.

5. The following are examples of claim language and titles that *DO* adequately describe a design for an article of manufacture under 35 U.S.C. 171: “computer screen with an icon,” “display panel with GUI,” “display screen or portion thereof with icon,” “portion of a computer screen with an icon,” “portion of a display panel with an icon,” and “portion of a monitor displayed with an icon.” This list of examples is not exhaustive.

b. Review the drawing to determine whether a display panel, or a portion thereof, is shown in sufficient views to fully disclose the design as embodied in the article. See Changes to Patent Practice and Procedure, 62 FR 53132, 53164 (October 10, 1997). USPTO personnel must also consider the following and, where appropriate, make the noted rejections.

1. If the drawing does not depict a computer icon or a GUI embodied in a display panel, or a portion thereof, in either solid or broken lines, USPTO personnel must reject the claimed design under 35 U.S.C. 171 for failing to comply with the article of manufacture requirement. See MPEP section 1504(a), subsection (I)(B).

i. If the disclosure as a whole does not suggest or describe the claimed subject matter as a computer icon or a GUI embodied in a display panel, or a portion thereof, USPTO personnel must indicate that:

A. The claim is fatally defective under 35 U.S.C. 171;

and

B. Amendments to the written description, drawings, and/or claim attempting to overcome a non-final rejection will ordinarily be entered; however, any new matter will be required to be canceled from the written description, drawings, and/or claims. If new matter is added, the claim should be rejected under 35 U.S.C. 112(a).

ii. If the disclosure as a whole suggests or describes the claimed subject matter as a computer icon or a GUI embodied in a display panel, or a portion thereof, USPTO personnel must indicate that the drawing may be amended to overcome the rejection under 35 U.S.C. 171. USPTO personnel must also suggest amendments that would bring the claim into compliance with 35 U.S.C. 171.

Example 1



Title: Computer display screen with icon

Description: The figure is a front view of a computer display screen with icon, showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.

Claim: The ornamental design for computer display screen with icon as shown and described.

As presented, the claimed design in this example complies with 35 U.S.C. 171 because:

- (1) the USPTO considers a computer icon or a GUI on a display panel to be an integral and active component in the operation of a programmed computer displaying the design and more than a displayed picture; and
- (2) the application fully discloses the design as embodied in an article of manufacture, as the drawing depicts the design embodied in a computer screen in broken lines.

In addition, the title and claim comply with 37 CFR 1.153(a) because the title and claim adequately designate a particular article of manufacture (i.e., the computer display screen).

Example 2



FIG. 1



FIG. 2

Title: Animated Icon

Description: Figure 1 is a front view showing a first image in a sequence for an animated icon showing a new design. Figure 2 is a second image thereof. The appearance of the animated image sequentially transitions between the images shown in Figs. 1-2. The process or period in which one image transitions to another image forms no part of the claimed design. The broken lines showing a portion of a computer display screen form no part of the claimed design.

Claim: The ornamental design for an animated icon as shown and described.

As presented, the title and claim should be objected to under 37 CFR 1.153(a) for failing to designate a particular article of manufacture. However, as presented, the claimed design in this example does comply with 35 U.S.C. 171 because:

- (1) the USPTO considers a computer icon or a GUI on a display panel to be an integral and active component in the operation of a programmed computer displaying the design and more than a displayed picture; and
- (2) the application fully discloses the design as embodied in an article of manufacture, as the drawing depicts the design embodied in a computer display screen in broken lines and the description (i.e., the broken line statement) describes a portion of a computer display screen.

To address the objections to the title and claim, the application could be amended as follows:

Title: Computer display screen with Aanimated icon

Claim: The ornamental design for a computer display screen with an animated icon as shown and described.

The objections should be maintained until the title and the claim are appropriately amended.

Example 3



Title: Virtual paper stack

Description: The figure is a front view of a computer display screen with a virtual paper stack showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.

Claim: The ornamental design for a virtual paper stack as shown and described.

As presented, the claimed design in this example does not comply with 35 U.S.C. 171. The image is merely a picture displayed on a computer display screen. Because the original disclosure does not provide support for amending the claim to include a computer icon, the claim is fatally defective under 35 U.S.C. 171 and should be rejected under 35 U.S.C. 171, as set forth in MPEP section 1504.01(a), subsection (I)(B). In addition, the title and claim should be objected to under 37 CFR 1.153(a) for failing to designate a particular article of manufacture.

Example 4



Title: Paper stack icon for use on a mobile device screen.

Description: The figure is a front view of a paper stack icon showing the new design.

Claim: The ornamental design for a paper stack icon for use on a mobile device screen as shown and described.

As presented, the claimed design in this example would not comply with 35 U.S.C. 171 because the drawing does not depict an article of manufacture (e.g., a display panel) in either solid or broken lines. Therefore, the claim should be rejected under 35 U.S.C. 171, as set forth in MPEP section 1504.01(a), subsection (I)(B). In addition, the title and claim should be objected to under 37 CFR 1.153(a) for failing to designate a particular article of manufacture. Specifically, the language “for use on a mobile device screen” does not adequately designate a particular article of manufacture. However, because the original disclosure provides support for a mobile device screen, the application could be amended as follows:

Title: Mobile device screen with a paper Paper stack icon ~~for use on mobile device.~~

Claim: The ornamental design for a mobile device screen with a paper stack icon ~~for use on a mobile device~~ as shown and described.

Description: The figure is a front view of a mobile device with a ~~virtual~~ paper stack icon showing the new design. The broken lines showing a portion of the mobile device screen form no part of the claimed design.

Note that a replacement figure showing the portion of a mobile device screen in either solid or broken lines must not introduce new matter. The replacement figure shown

represents a best practice for applicants as it is the most likely amendment to be supported by the original disclosure.

Replacement Figure:



Example 5



Title: Icon for computer display screen

Description: The figure is a front view of a computer display screen with icon, showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.

Claim: The ornamental design for an icon for computer display screen as shown and described.

As presented, the title and claim should be objected to under 37 CFR 1.153(a) for failing to designate a particular article of manufacture. In particular, the language “for computer display screen” does not adequately designate a particular article of manufacture.

However, as presented, the claimed design in this example complies with 35 U.S.C. 171 because:

(1) the USPTO considers a computer icon or a GUI on a display panel to be an integral and active component in the operation of a programmed computer displaying the design and more than a displayed picture; and

(2) the application fully discloses the design as embodied in an article of manufacture, as the description and drawing depict the design embodied in a computer display screen in broken lines and the description (i.e., the broken line statement) describes a portion of a computer display screen.

To address the objections to the title and claim, the application could be amended as follows:

Title: ~~Icon for computer~~ Computer display screen with icon

Claim: The ornamental design for ~~an icon for~~ a computer display screen with icon as shown and described.

Katherine Kelly Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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