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Row 3: EXAMINER PRATT, DEANNA L
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIELLE GIZA¹

Appeal 2018-004712
Application 29/461,783
Technology Center 2900

Before JENNIFER S. BISK, JILL D. HILL, and GEORGE R. HOSKINS,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting the single design claim pending in this appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellant identifies Applicant S. C. Johnson & Son, Inc. as the real party in interest. Appeal Br. 2.

BACKGROUND

Appellant's invention relates to a display screen portion with an icon, or a package portion with surface ornamentation. Spec. 2. The claim on appeal is "[t]he ornamental design for an icon for a display screen or packaging with surface ornamentation, as shown and described." *Id.* at 3.

REJECTIONS

The claim stands rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement. Final Act. 2.

OPINION

The Examiner determines that the claim is not enabled, "because the claim identifies that the claimed design is embodied in 'Packaging', yet . . . the claimed design is not shown applied to packaging." Final Act. 3. According to the Examiner, "[w]hile a computer-generated icon design may be properly illustrated as embodied in a 'portion' of [a display screen], the same practice does not extend to art areas outside of computer-generated icon art." *Id.*

The Examiner reasons that "[d]esign claims are for the design applied to or embodied in an article of manufacture, not the design standing alone." *Id.* at 4. The Examiner contends that a design applied to a portion of an article defined within broken lines, rather than to the entire article, "is not applied in a meaningful way that enables a person to make or use the claimed design." *Id.* According to the Examiner, the MPEP requires that a design "be applied to or embodied in a specific article of manufacture" (Final Act. 8 (referring to MPEP §1504.01 (citing 35 USC §171))), not a "portion" of an article of manufacture.

Appellant argues that, even though the closed broken line area surrounding the claimed design is a “portion” of packaging, precedent establishes that the claim is enabled. Appeal Br. 7. For support, Appellant cites *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871), wherein the claimed design was a utensil handle, and only the handle (i.e., a portion of the article to which the design is applied) was depicted in the Figures. *Id.* at 7 (citing *Gorham*, 81 U.S. at 512). We agree with Appellant that illustrating a portion of an article of manufacture can enable a claim to a design therefor, and that *Gorham* is an example of such an illustrated portion. While *Gorham* illustrated a much greater portion of the article of manufacture, ruling out a far greater number of options for the completed shape of article and not effectively reducing the design to the equivalent of mere surface treatment, the Examiner has not persuaded us that Appellant erred simply by illustrating only a portion of the article of manufacture in this instance.

The Examiner then argues that the claim is directed to “packaging,” rather than a “packaging portion.” Ans. 8. The Examiner determines that, even if a claim can be enabled by illustrating a portion of an article of manufacture, as in *Gorham*, the claimed design here is not enabled because the claim recites an entire article of packaging rather than a portion of packaging. Ans. 4.

The Examiner has not persuaded us that Appellant must recite a “portion of” packaging for the claim to be enabled. MPEP § 1503.01(I) specifically states that “[t]he title may be directed to the entire article embodying the design while the claimed design shown in full lines in the drawings may be directed to only a portion of the article.”

Regarding illustrating only a portion of the claimed article of manufacture, the Examiner argues that, although MPEP §1504.01(a) permits computer icons being depicted on a portion of a computer screen, monitor, or display panel, and MPEP § 1503.02(IV) states that the guidelines for disclosing computer icons “apply equally to all types of surface treatment,” the claimed design cannot be enabled by illustrating only a portion of packaging. *Id.* at 5. The Examiner contends that the guidance set forth in MPEP § 1504.01(a) is limited to computer icons, and MPEP § 1503.02(IV) should *not* be construed to mean that MPEP § 1504.01(a) “applies verbatim to surface treatment designs.” *Id.* at 6. The Examiner argues that “the clear meaning” of MPEP § 1503.02(IV) is that “the principles set forth in those guidelines apply within the context of the art to which they are being applied,” and “[w]hether a claimed design is enabled by being disclosed on merely a portion of an article of manufacture is an instance where this context is key.” *Id.*

The Examiner’s argument regarding “context” is not persuasive. It is unclear to us what “[t]he guidelines that apply for disclosing computer-generated icons apply equally to all types of surface treatment” (MPEP § 1503.02(IV)) could mean/encompass, other than that surface treatment can be depicted on less than an entire article of manufacture. While MPEP § 1504.01(a) may not apply verbatim to surface treatment designs, it also does not apply solely to computer icons. MPEP § 1503.02(IV) intends for some of the guidelines for disclosing computer icons to apply to surface treatment. It is not clear to us that displaying a portion of the underlying article of manufacture is not one of those “guidelines.”

The Examiner further contends that “[t]he *Strijland* decision that allows [icon] designs to be enabled by a showing of a ‘portion’ of an article sets forth an understanding of the statutory requirements of computer generated icon designs that . . . does not extend to the packaging art, surface treatment art, or any other art.” Final Act. 8. This contention is not persuasive because it (1) is not supported by *Ex parte Strijland*, 26 USPQ2d 1259 (BPAI 1992), and (2) appears to be contradicted by MPEP § 1503.02(IV), which states that the guidelines for disclosing computer icons “apply equally to all types of surface treatment.”

Appellant argues that the disclosure depicts “the claimed design on at least one type of packaging, i.e., the packaging represented by the closed broken line that completely surrounds the design.” Appeal Br. 4 (citing Figs. 1–3). The Examiner disagrees, arguing that for the claimed design to be enabled, “the disclosure needs to be clear how the design is applied to a *complete* article.” Final Act. 7–8 (emphasis added) (citing *Ex parte Salisbury*, 38 USPQ 149, 1938 C.D. 6 (Comm'r Pat. 1938); *Ex parte Sweeney*, 123 USPQ 506 (BPAI 1959); and *Ex parte France*, 132 USPQ 211 (BPAI 1961)).

Appellant replies that the regulation forming the basis for the decisions in *Salisbury*, *Sweeney*, and *France* was revised in 1997. Reply Br. 3. Rather than requiring a more specific number and type of views in design patent applications, the regulation was amended to “instead require ‘a sufficient number of views to constitute a complete disclosure of the appearance of the design.’” *Id.* (citing 37 C.F.R. § 1.152 (Oct. 10, 1997)); Appeal Br. 6–7 (citing *Changes to Patent Practice and Procedure*, 62 Fed. Reg. 53,132, 53,164 (Oct. 10, 1997)).

We agree with Appellant that the regulation forming the basis for the decisions in *Salsbury*, *Sweeney*, and *France* was revised in 1997, such that the Examiner’s reliance on those cases to support a requirement to depict a complete article is improper.

Appellant makes various arguments about similar designs that have been issued as design patents. Appeal Br. 4–6; Reply Br. 3–5. We agree with the Examiner that “such evidence is anecdotal at best” because, “[a]bsent proof of a consistent practice in the Patent and Trademark Office, the decision to issue individual design patents is of limited precedential value.” Ans. 4 (citing *Ex parte Donoghue*, 26 USPQ2d 1271, 1273 (BPAI 1992)).

The Examiner and Appellant contend that *In re Schnell*, 46 F.2d 203 (CCPA 1931) is relevant to the outcome of this decision, but disagree on how *Schnell* affects the outcome. Final Act. 4–5; Appeal Br. 6–7; Ans. 4–7, 9–10; Reply Br. 2. What we find informative in *Schnell* is its discussion of *Ex Parte Fulda*, 194 OG 549, which explains that a design can consist of (1) the configuration of an article of manufacture, (2) ornamentation imposed on the article manufacture “without reference to its general form,” or (3) both the configuration and ornamentation. *See Schnell*, 46 F.2d at 206 (discussing *Fulda*), 209. *Fulda* held that, where the design is for the configuration of an article of manufacture, the article of manufacture “must necessarily be disclosed in the application;” but, where the design is solely for ornamentation imposed on the article of manufacture, there is no requirement that the design be applied to “some particular definite article of manufacture.” *Id.* at 206–07. Appellant’s design appears to be of the latter type —solely for ornamentation imposed on the article of manufacture (i.e.,

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a display or a package) so that, in accordance with *Fulda* and as discussed in *Schnell*, there is no requirement that the design be applied to “some particular definite article of manufacture.” In other words, the precise configuration of the package need not be fully disclosed.

For these reasons, we do not sustain the Examiner’s rejection.

DECISION

We REVERSE the rejection of the claim under 35 U.S.C. § 112(a).

REVERSED