

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES B. WILLIAMS JR., EDWARD P. REGAN JR.,
THOMAS M. SHEEHAN and STEPHEN K. BRIGHT

Appeal No. 98-1691
Application No. 07/715,262¹

ON BRIEF

Before FRANKFORT, KRASS and WEIFFENBACH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING²

¹Application for patent filed June 14, 1991.

²Requests for reconsideration are now designated requests for rehearing.

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Appellants request that we reconsider our decision of July 13, 1998 wherein we affirmed the examiner's decision in rejecting the design claim under 35 U.S.C. 112, first paragraph, as relying on an inadequate written description and under 35 U.S.C. 171 as being directed to nonstatutory subject matter.

Appellants' request alleges three fundamental errors in our decision:

1. The sustaining of a "new matter" rejection for the addition of a broken-line background "computer display" to the drawings, notwithstanding repeated express disclosures of "computer display" in the filed design patent application.

2. The application of a "no intent to claim" doctrine, notwithstanding the legal inapplicability of any such doctrine to original design patent applications.

3. Application of a standard for patentable subject matter and disclosure that is inconsistent with USPTO guidelines for computer display icons and CAFC precedent.

We will respond to appellants' allegations in the order in which they are made:

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1. We find no error in our sustaining of the examiner's rejection under the first paragraph of 35 U.S.C. 112. Appellants argue that there was plenty of support for a "computer display" since the claim and title of the originally filed application stated that the design is for a "computer display." We do not dispute that there was adequate support in the originally filed application for the term "computer display." The problem is that, as explained by the examiner, and adopted by us at pages 5-6 of our decision, the mere mention of a "computer display" by the originally filed application could entail any of a myriad of things such as a 3-D computer display, a photocopier display, a display on an automobile dashboard, an ATM display, different shaped screens, etc. The instant claimed invention, however, is for a design and, as such, is directed to a very specific and particular article of manufacture.

There is no evidence of record that appellants had possession of the particular design, i.e., the edit icon embodied in a computer display in the particular manner shown by the amended drawings, at the time of filing the application.

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It may be true, as appellants point out, that a broken line showing is for illustrative purposes only and forms no part of the claimed invention. However, it would still constitute new matter for the broken line to be added by amendment since, prior to this amendment and at the time of filing the application, the claimed design was for an icon and now, through amendment for which there is no adequate support in the originally filed application, appellants attempt to change the design to one for the icon for use with a particular computer display. Accordingly, we find no error in our finding that there is no adequate support for the subject matter (including the broken line depiction of a computer display) now attempted to be claimed.

2. We did not mean to imply that we were applying an "intent to claim" standard as per reissue issues and we regret any misunderstanding by appellants on this issue. We merely meant to point out, in sustaining the written description rejection, that at the time of filing the application, there was no evidence that appellants were in possession of a computer display having an edit icon for computer display, as is now attempted to be claimed, since no such computer display

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was shown in the drawing of the design constituting the claim. Therefore, it was clear to us then, and it remains clear to us, that there is inadequate support for the broken lines now shown in the drawing and that the examiner's rejection under the first paragraph of 35 U.S.C. 112, based on an inadequate written description, was proper. The provision of the broken lines in the drawing was clearly an afterthought, with no adequate basis within the meaning of 35 U.S.C. 112, first paragraph, conceived in response to the holding in Ex parte Strijland, 26 USPQ2d 1259 (Bd. Pat. App. & Interferences 1992).

3. With regard to the statutory subject matter question, contrary to appellants' contention, our decision is not inconsistent with the USPTO guidelines³ or CAFC precedent.

Because we have held the inclusion of the broken lines in the drawing to be improper under 35 U.S.C. 112, first paragraph, the design claim is clearly drawn to an icon, per

³We note that the USPTO guidelines do not have the force of law and, to whatever extent our decision may be inconsistent with those guidelines, the guidelines must fall until or unless our decision is overturned by a higher authority.

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se. As such, Strijland is controlling and the claim is held to be directed to nonstatutory subject matter under 35 U.S.C. 171. Appellants have convinced us of no error in our reasoning, set forth at pages 7-8 of our decision, with regard to the instant claim constituting nonstatutory subject matter.

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We have granted appellants' request with regard to reconsidering our decision but we deny the request with respect to making any changes therein.

DENIED

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