

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

The USPTO issued supplemental guidance in the Federal Register on November 17, 2023. *See Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces*, 88 FR 80277 (November 17, 2023). Examples 2, 4 and 5 in Section (V) of the supplemental guidance published in the Federal Register did not reproduce certain formatting (i.e., underlining and strikethrough) in the text that is necessary to understand the examples. *See Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces*, 89 FR 5506 (January 29, 2024). The following examples contain the proper formatting.

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

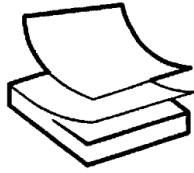
Description: The figure is a front view of a computer display screen with a virtual paper stack showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.

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 a mobile device~~ screen.

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 screen with a 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.