GUI
(Graphical User Interface)
and Icon
Examination Practice

Cathron Brooks
Supervisory Patent Examiner
United States Patent and Trademark Office
The Statute:


Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
The provisions of this title relating to patents for inventions shall apply to patents for design, except as otherwise provided.
3 Types of Eligible Subject Matter in Design Patents

- Configuration of an article of manufacture
- Configuration of an article of manufacture and surface ornamentation for an article of manufacture
- Surface ornamentation for an article of manufacture
How It All Began

- In mid-1980s Xerox Corp began applying for design patents on icons related to software.
- This led to increased public debate and interest on whether GUIs and icons could and should be properly protected under design patents.
- Culminates in two BPAI Cases
  - *Ex parte Strijland*
  - *Ex parte Donaldson*
• Are GUIs/icons properly considered “designs for articles of manufacture”? YES – if properly presented and claimed.

• The structure or form of the article of manufacture does not have to be claimed in the patent, but it must be disclosed.
Where We Are Now

• Subject matter for designs is “any new, original and ornamental design for an article of manufacture.” 35 U.S.C. 171

• Article of manufacture: a computer
  “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.”  Ex Parte Strijland

• GUIs/icons are proper subject matter for protection under U.S. law.

• Consistent with the constitutional purpose of promoting progress and innovation.
Computer generated icons are similar to two dimensional printed material in that they must be shown as being part of a three dimensional article of manufacture.
If an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the “article of manufacture” requirement of 35 U.S.C. 171.
The title, which is part of the claim, is IMPORTANT

Acceptable titles for GUIs and icons under 35 U.S.C. 171:

“computer screen with icon”

“display panel with graphical user interface”

“portion of a display with icon”

Unacceptable titles for GUIs and icons under 35 U.S.C. 171:

“icon”

“computer icon”

“icon for a display screen”
Icon Examples

D577,035

D649,975

D635,582

D654,926

Design Day 2013

United States Patent and Trademark Office
Graphical User Interfaces Examples
Transitional (Changeable) Computer Generated Icons

Computer generated icons that include images that change in appearance during viewing may be the subject of a design claim. Such a claim may be shown in two or more views.

The images are understood as viewed sequentially, no ornamental aspects are attributed to the process or period in which one image changes into another. A descriptive statement must be included in the specification describing the transitional nature of the design and making it clear that the scope of the claim does not include anything that is not shown.
Transitional (Changeable) Computer Generated Icons

The appearance of the transitional image sequentially transitions between the images shown in FIGS. 1-9. The process or period in which one image transitions to another forms no part of the claimed design.

D565,584
Designs relating to GUIs and Icons are growing faster than any other type of designs.
The Examination Process

• 11 Primary Examiners currently examine GUIs and Icon applications.

• They work as a team on this specific area of examination, with a lead SPE, and our Design Practice Specialist.

• Each examiner has an approximate average of at least 100 GUI and Icon applications on their docket.

• They search U.S. Patents (design and utility), foreign patents, and numerous non-patent literature resources.
The Examination Process

- The Manual of Patent Examining Procedure has a section that pertains to GUI and Icon Examination....MPEP 1504.01(a)

- Regular GUI/Icon examination meetings are held to ensure consistency and to develop practice.

- Typical rejections are based on 35 USC 171, 103, and 112, 1\textsuperscript{st} paragraph for new matter.
THANK YOU!

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