The Limited Monopoly™

Patenting Computer Generated Icons

by Robert Gunderman, PE and John Hammond, PE

Design Patents- A Refresher[1]

The United States patent laws provide for the granting of a design patent to any person who has invented a new and nonobvious ornamental design for an article of manufacture. A utility patent protects the way an article is used and works, while a design patent protects the way an article looks. The disclosure and description of the invention as described in a design patent application is done primarily by way of drawings, and not words. Thus, the drawings in a design patent are of paramount importance. A design patent application has only one claim that begins with "The ornamental design for a …".

The proceedings relating to granting of design patents are essentially the same as those relating to other patents, with a few differences. To begin, the filing fee for a design patent application is less than the filing fee for a utility patent application. A design patent also has a term of 14 years from grant, whereas a utility patent has a term of 20 years from the date of filing. A design patent also has no maintenance fees, unlike a utility patent that requires payments at 3½, 7½ and 11½ years after issuance.

A Brief History of Patenting Computer Generated Icons

Design patents may be awarded to "Whoever invents any new, original, and ornamental design for an article of manufacture."[2] Over the years, this definition has been molded and shaped by case law. Until the 1990's, an article of manufacture was taken literally to mean by the hands of man from raw materials. With such a definition, computer generated icons were not considered patentable subject matter, and were considered merely pictures. Then in 1995, the United States Patent and Trademark Office stated that "a design for a computer generated icon which is embodied in an article of manufacture is statutory subject matter for a design patent under Section 171."[3]

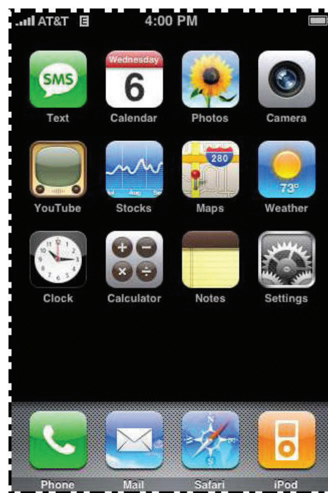

FIG. 1

It is interesting to note that historically, type fonts were eligible subject matter for design patents since they were generated from solid blocks of material (an "article of manufacture") used in printing presses. With the advent of computers, solid printing blocks for type fonts were no longer required; however, they are still eligible for design patent protection[4] since the "article of manufacture" is now considered to be the computer or related equipment. This is essentially the same article of manufacture criterion that is used for computer generated icons.

Statutory Subject Matter - Making the Icon Patent-Eligible

The definition provided by the United States Patent and Trademark Office on October 5, 1995 has made computer generated icons eligible for patent protection, provided that the computer generated icon is depicted in a "computer screen, monitor, other display panel, or a portion thereof."[5] Thus, the drawings must show the computer generated icon displayed on such a suitable "article of manufacture" or the application will be rejected under 35 U.S.C. 171 for failing to comply with the article of manufacture requirement. Good drawings done by a competent draftsperson under the supervision of a patent practitioner that is well versed in design patents can make the difference between an issued and enforceable design patent and a fatal rejection.

The Big Name Filers

Design patents for computer generated icons fall within classes D14/485-495 in the USPTO. Microsoft is the number one holder of design patents for computer generated icons. Apple and Samsung are also big players. There have been major legal battles over design patents, one of the most notable being between Apple and Samsung. One of the patents that Apple sought to enforce against Samsung is United States Design Patent D604,305 entitled "Graphical User Interface For A Display Screen or Portion Thereof". Note the very descriptive title of this design patent indicating that the GUI is for a display screen, ensuring compliance with the article of manufacture requirement of the law (Section 171). Note also in the patent drawing of the Apple GUI (shown nearby), that there is a broken line around the image. This indicates that the broken line representing a display screen forms no part of the claimed design, but is there to comply with Section 171 (the article of manufacture requirement).

Icons That Change Appearance

Computer generated icons that change in appearance during viewing may also be the subject of a design claim. The drawings must depict two or more views where the images are understood as being viewed sequentially, with no ornamental aspects being attributed to the process or period in which one image changes into another. In such an application, 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.

The Strength of Color

The overall appearance and color scheme of Apple's design patent D604,305 was enough to convince the jury that Samsung's GUI and Apple's patented GUI created a likelihood of confusion, yielding $725 Million of the $1 Billion in damages recently awarded to Apple. When applying for a design patent, Apple Inc. petitioned the United States Patent and Trademark Office to accept color drawings. While design patents are still published in black and white, if the USPTO agrees to accept color drawings, they are made of record in the file wrapper. If a fundamental part of a design is the color, it is prudent to petition the USPTO to accept color drawings to ensure the broadest possible protection and interpretation of your design claim. There is a common misconception that changing one small aspect of a design patent is enough to get around it, where in reality infringement of a design patent is determined by the likelihood of confusion between the accused and the patented design. If color is important to the design, it should be included in the design patent application with the appropriate petition.

The Future of Computer Generated Icons and Design Patents

With the continued growth of new computing devices including tablets, smartphones, and other yet to be dreamed of devices, the use of design patents as another facet of an intellectual property portfolio continues to grow. With this growth and the occurrence of large legal battles, the interpretation of the law will continue to evolve, and the requirements for design patents will change accordingly. Consideration of a design patent as part of your developing intellectual property portfolio should be undertaken with a clear understanding of the potential value of design patents, as well as the diligent effort required in pursuing them. A qualified patent practitioner can provide sound advice on both of these aspects.

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1. See also "The Limited Monopoly™" October 2006.
2. 35 U.S.C. §171.
3. 60 Fed. Reg. 52, 170 (Oct. 5, 1995).
4. MPEP 1504.01(a) III.
5. MPEP 1504.01(a) I. B.

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PHOTO CREDIT: Fig. 1, United States Design Patent No. US D604,305 S.