

AIPLA

American Intellectual Property Law Association

February 4, 2021

Ms. Elizabeth Shaw
Office of Policy and International Affairs (OPIA)
The United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22314
Submitted via www.regulations.gov

Re: Notice Regarding the Article of Manufacture Requirement (December 21, 2020; Docket No. PTO-C-2020-0068)

Dear Ms. Shaw:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to present its views with respect to the U.S. Patent and Trademark Office request for comments regarding the Article of Manufacture Requirement, 85 Fed. Reg. 86073, dated December 21, 2020 (the “Request”), Docket No. PTO-C-2020-0068.

AIPLA is a national bar association of approximately 8,500 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

The Request notes the USPTO considers design for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection under section 171. During the 25 years since the Guidelines for Examination of Design Patent Applications For Computer-Generated Icons were issued in 1996, technology and consumer experience with computer-generated image designs has progressed substantially. Consumers view and otherwise interact with computer-generated images on a daily basis, and the development of display technologies untethers computer-generated images from discrete, tangible display panels. AIPLA applauds the work on this issue in the international context by the USPTO¹ and for considering a practice change to protect such designs in the U.S. The USPTO should seize this moment to make a minor adjustment in examination guidance to encompass computer-generated image designs that are displayed as the result of a programmed computer, but not displayed on a display panel. As explained below, such a change is well rooted in the USPTO's own precedent and is consistent with recent case law addressing the article of manufacture for design patents.

Question 1:

Please identify the types of designs associated with new and emerging technologies that are not currently eligible for design patent protection but that you believe should be eligible. For these types of designs, please explain why these designs should be eligible, how these designs satisfy the requirements of section 171, and how these designs differ from a mere picture or abstract design. In addition, if you believe that these types of designs should be eligible, but a statutory change is necessary, please explain the basis for that view.

Response to Question 1:

The Request itself identifies computer-generated image designs not displayed on a computer screen, monitor, display panel or other traditional display (hereinafter "display panel"), such as a projection, holographic imagery, or virtual/augmented reality designs, which may result from new and emerging technologies, as ineligible for design patent protection. According to the USPTO's current interpretation of jurisprudence, to be statutory subject matter, the following criteria must be met: (1) the computer-generated image design must be embodied in a computer

¹ See, e.g., https://www.wipo.int/edocs/mdocs/geoind/en/sct_is_id_ge_17/sct_is_id_ge_17_inf_3.pdf

screen, monitor, other display panel, or portion thereof; (2) must be more than a picture on a screen; and (3) must be integral to the operation of a computer.

AIPLA respectfully submits that to support innovation and the advancement of technology, the USPTO should amend its examination guidance to encompass computer-generated image designs displayed other than on a display screen. Such designs should likewise be eligible for design patent protection when adequately disclosed as being for use in conjunction with an article of manufacture.

This proposed amendment is consistent with USPTO precedent. *In re Zahn* states “[35 U.S.C.] 171 refers, not to the design *of* an article, but to the design *for* an article. The design is inclusive of ornamental designs of *all* kinds including surface ornamentation as well as configuration of goods.” *Zahn* provides that a claimed design may be embodied in less than the entire article, such that surface ornamentation can be claimed without regard to the appearance of the article.² *Ex parte Strijland* provides that the article in which a design for a computer-generated icon is embodied may be a programmed computer system, and does not require that the article of manufacture be a display panel, but rather understands that an image appearing on a display panel may be integral to the operation of a programmed computer system.³ An article of manufacture is simply a thing made by hand or machine.⁴ A programmed computer displaying a computer-generated image is an article of manufacture. *In re Hruby* held that the display itself—a pattern of water in the *Hruby* case—and by analogy, the computer-generated image display, is the article of manufacture.⁵ Similarly, type fonts are recognized as configurations, not surface ornamentation.⁶

² *Application of Zahn*, 617 F.2d 261 (C.C.P.A. 1980).

³ *Ex parte Strijland*, 26 U.S.P.Q. 2d 1259 (B.P.A.I. 1992).

⁴ *Samsung Electronics Co., v. Apple Inc.*, 137 S. Ct. 429 (2016).

⁵ *In re Hruby*, 373 F.2d 997 (C.C.P.A. 1967) (“[W]hat we see here are fountains, not droplets of water moving in space, any more than we see nuclei and electrons or atoms or molecules in solid objects....We fail to find in the opinion of the board majority any sufficient reason for holding the fountains are not "articles of manufacture.”)

⁶ *Adobe Systems, Inc. v. Southern Software, Inc.*, 45 U.S.P.Q. 2d 1827 (N.D. Cal. Feb. 2, 1998). See also *Microsoft Corp. v. Corel Corp.*, 5:15-cv-05836 (N.D. Cal. Feb. 13, 2018) Stating “Software is a ‘thing made by hand or machine’ and thus can be an ‘article of manufacture’” (quoting *Samsung v. Apple*), the district court recognized sales of defendant’s software program containing the infringing graphical user interface designs as the relevant

In most design patents issued for a display screen, or portion thereof, with a graphical user interface or an icon, the display panel is illustrated in the drawing as but a single peripheral broken line described as forming no part of the claimed design.⁷ The Federal Circuit in 2019 held in *Curver Luxembourg v. Home Expressions* that when the article of manufacture is not identified in the drawings, it is determined by the language of the title and claim.⁸ Moreover, in addressing public comments in 1996 and implementing the original guidelines for Examination of Design Patent Applications For Computer-Generated Icons, the USPTO took the position that the dependence of a computer-generated icon on a CPU for its existence is not a reason for requiring depiction of a CPU.⁹

Thus, when the display of a computer-generated image design is not dependent on a display panel, the USPTO should not require illustration of the article of manufacture associated with the display.

The USPTO has already recognized the need and logic to eliminate a requirement to illustrate a technologically obsolete article of manufacture for type faces as computer-generated image designs. M.P.E.P. Section 1504.01(a)(III), Treatment of Type Fonts, explains:

“Traditionally, type fonts have been generated by solid blocks from which each letter or symbol was produced. Consequently, the USPTO has historically granted design patents drawn to type fonts. USPTO personnel should not reject

article of manufacture for the purpose of determining damages for design patent infringement under 35 U.S.C. §289.

⁷ See Jason J. Dumont and Mark D. Janis, *Virtual Designs*, 17 *Stan. Tech. L. Rev* 107 (2013) (“The representation of a computer display is now typically rendered as a stylized square or rectangle in broken lines; it conveys no information other than the fact that the virtual design is indeed applied to an article of manufacture.”). In the Patent Gazette of January 26, 2021, all 22 patents issued for such subject matter illustrate the display screen as a broken line, available at <http://patentsgazette.uspto.gov/week04/OG/Designs.html>.

⁸ *Curver Luxembourg, SARL v. Home Expressions, Inc.*, 938 F.3d 1334, 1337 (Fed. Cir. 2019) (“... we hold that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.”)

⁹ *Guidelines for Examination of Design Patent Applications For Computer Generated Icons*, 61 Fed. Reg. 55 (March 20, 1996). At that time the USPTO maintained that depiction of an article of manufacture is necessary to ensure that any design patent covers more than mere abstract, two-dimensional, surface ornamentation, however, as explained herein, 25 years later, as technology advances past the display screen, disclosure that a design is applied to an article of manufacture can be satisfied by identification of an article of manufacture associated with the display of the image as an integral component in the operation of a programmed computer, not illustration of the article itself, which may form no part of the claimed design.

claims for type fonts under 35 U.S.C. 171 for failure to comply with the “article of manufacture” requirement on the basis that more modern methods of typesetting, including computer-generation, do not require solid printing blocks.”

Likewise, with computer-generated image display technology advancing beyond display panels, the USPTO should not require illustration of a display panel in order to disclose computer-generated images as design patent eligible.

Question 2:

If the projection, holographic imagery, or virtual/augmented reality is not displayed on a computer screen, monitor, or other display panel but is integral to the operation of a device (e.g., a virtual keyboard that provides input to a computer), is this sufficient to render the design eligible under section 171 in view of the current jurisprudence? If so, please explain how the article of manufacture requirement is satisfied and how these designs differ from a mere picture or abstract design. If you believe that these designs do not meet the requirements of section 171, please explain the basis for that view.

Response to Question 2:

AIPLA respectfully submits that a computer-generated image design, although displayed on other than on a display panel, that otherwise meets the remaining requirements for design patent protection should be patentable. Provided it is more than a picture on a screen and is integral to the operation of an article of manufacture, it should be eligible for design patent protection. The application should identify the article in conjunction with the display.

Pursuant to *Strijland*, as is a computer-generated image design displayed on a display screen, a computer-generated image design, displayed other than on a display screen, should be eligible for design patent protection. It should be disclosed as being more than a picture standing alone and as being for an article of manufacture in conjunction with which the computer-generated image design is displayed.

Under *Strijland*, design patent eligibility for computer-generated images does not turn on the display screen as the article of manufacture. In *Strijland*, the Board observed: “[w]e do not think

that merely illustrating a picture displayed on the screen of a computer or other display device, such as a television or movie screen, is sufficient, alone, to convert a picture into a design for an article of manufacture.” Rather, pursuant to *Strijland*, eligibility was based on the design being integral to the operation of a programmed computer, which is supported by the designs being displayed on a display.

When a computer-generated image design is displayed on a screen, the two are accepted together as an article of manufacture that is more than a mere picture on a screen. Similarly, when a portion of a screen displays a graphical user interface or icon, the two are accepted together as an article of manufacture that is more than a mere picture on a screen. This is because the display is integral to the operation of the computer or a computer application.

The key to eligibility under *Strijland*, however, is not the display screen itself; rather, the display screen is an article of manufacture which helps, but is not dispositive, in identifying a computer-generated image as being integral to the operation of a computer or a computer application.

A display screen, however, is not the only permissible statutory article of manufacture. It is not the only article of manufacture that can establish that the claimed computer-generated image design is integral to the operation of a programmed computer. When the computer-generated image design is not dependent on a display screen to be visible, another article of manufacture associated with the underlying programmed computer, such as the computer processor, should be sufficient as the article of manufacture.

Question 3:

If the projection, holographic imagery, or virtual/augmented reality is not displayed on a computer screen, monitor, or other display panel but is interactive with a user or device (e.g., a hologram moves according to a person’s movement), is this sufficient to render a design eligible under section 171 in view of the current jurisprudence? If so, please explain how the article of manufacture requirement is satisfied and how these designs differ from a mere picture of abstract design.

Response to Question 3:

AIPLA respectfully submits that when a computer-generated image design is displayed—other than on a display panel—it may nevertheless be design patent eligible. It needs to be for an article associated with a programmed computer and interactive with a user or device. These are sufficient conditions that the computer-generated image design is integral in the operation of a computer. If the design is for a graphical user interface or icon, the disclosure should be presumed to be interactive with a user or device. Interactivity should not be a separate requirement for eligibility. Disclosure of interactivity may be instructive as to whether a computer-generated image design is eligible under *Strijland* (e.g., as being more than a mere picture by being integral to the operation of a programmed computer), but it is the appearance, not utility, that is claimed in a design patent.

Question 4:

If the projection, holographic imagery, or virtual/augmented reality is not displayed on a computer screen, monitor, or other display panel but is projected onto a surface or into a medium (including air) and is not otherwise integral to the operation of a device or interactive with a user or device (e.g., is a static image), is this sufficient to render the design eligible under section 171 in view of the current jurisprudence? If so, please explain how the article of manufacture requirement is satisfied and how these designs differ from a mere picture or abstract design. If you believe that these designs do not meet the requirements of section 171, please explain the basis for that view.

Response to Question 4:

Current eligibility based on the USPTO's implementation of Board analysis in *Strijland* is based on the computer-generated design image disclosed as integral to the operation of a programmed computer. This operation characterizes the design as being applied to one type of article of manufacture. Yet, it is the appearance of the design, not its utility, that is proper subject matter of a design patent. *In re Zahn*, discussed above observed that “[35 U.S.C.] Section 171 refers, not to the design *of* an article, but to the design *for* an article and is inclusive of ornamental designs of *all* kinds including surface ornamentation as well as configuration of goods.” A claimed design may be embodied in less than the entire article. Moreover, interactivity or being

integral to the operation of a computer or computer application is not an eligibility requirement for other surface ornamentation designs. For example, articles such as a label or packaging are not required to be interactive. Further, in Europe, computer-generated image designs are protected *per se* in Locarno Class 32 (Graphic symbols and logos, surface patterns, and ornamentation). This is without reference to a specific article of manufacture and without being required to be interactive or integral to the operation of a programmed computer. Other significant IP Offices, such as Singapore, Japan, and China, are also moving away from claiming the article of manufacture associated with a graphical user interface or icon.

Question 5:

Do you support a change in the interpretation of the article of manufacture requirement in 35 U.S.C. 171? If so, please explain the changes you propose and your reasons for those proposed changes. If not, please explain why you do not support a change in interpretation.

Response to Question 5:

As explained above, AIPLA supports a change in the interpretation of the guidelines for eligibility of computer-generated image designs to accept other articles of manufacture associated with the underlying programmed computer instead of requiring that the image appear on a display screen.

Question 6:

Please provide any additional comments you may have in relation to section 171, interpretation or application of section 171, or industrial design rights in digital and new and emerging technologies.

Response to Question 6:

AIPLA has no additional comments about the article of manufacture requirement at this time. In summary, AIPLA respectfully submits that, to support innovation and the advancement of technology, the USPTO should amend its examination guidance to encompass computer-generated image designs displayed other than on a display screen. These designs should likewise be eligible for design patent protection when disclosed as being more than a mere

picture on a screen by being integral to the operation of a computer or a computer application, by being for an article of manufacture associated with the display of the image and being for a graphical user interface or icon.

AIPLA appreciates the initiative of the USPTO in issuing the Request and encourages the USPTO to take this opportunity to make a well-cabined adjustment to current examination practice to extend for protection of computer-generated image designs displayed by emerging technologies.

Sincerely,

A handwritten signature in cursive script, appearing to read "Joseph R. Re".

Joseph R. Re

President

American Intellectual Property Law Association