AIPLA
American Intellectual Property Law Association

November 18, 2024

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Via Online Submission: Regulations.gov

Re: Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces (November 17, 2023, and January 29, 2024; Docket No. PTO-P-20230-0047)

Dear Director Vidal:

The American Intellectual Property Law Association ("AIPLA") appreciates the opportunity to offer the following response to the Notices on November 17, 2023, and January 29, 2024, on Guidance: Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces ("January 29 Notice").

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 7,000 members including professionals 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 that the United State Patent and Trademark Office ("USPTO" or "Office") 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 28 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. The development of display technologies untethers computer-generated images from discrete, tangible display panels. In addition, new technologies are emerging in which Icons and other Graphical User Interfaces are being developed that do not include tangible displays, e.g., projection, holographic imagery, or virtual/augmented reality designs. AIPLA believes that this is an opportunity for the USPTO to make a minor adjustment in examination guidance, like it has done before when facing the outdated article for type fonts, 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.

Currently, designs associated with new and emerging technologies that are not displayed on a tangible display are not eligible for design protection. Such designs are ineligible for design patent protection because they do not satisfy the first criterion of the USPTO's current interpretation of jurisprudence: (1) the computer-generated image design must be embodied in a computer 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. These should likewise be eligible for design patent protection when adequately disclosed as being for an article of manufacture.

Such an amendment would be consistent with the law and USPTO's own 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, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods." Section 171 also 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. *Ex parte Strijland* provides that the article in which a design for a computer-generated icon is embodied may be a programmed computer system. *Ex parte*

Strijland does not require that the article of manufacture be a display panel. Rather, an image appearing on a display panel may be integral to the operation of a programmed computer system. It does not suggest that other types of displays cannot be part of a programmed computer system. An article of manufacture is simply a thing made by hand or machine, which certainly describes a programmed computer which displays a computer-generated image. *In re Hruby* indicates that the display itself, in that case a pattern of water, and by analogy, the computer-generated image display, is the article of manufacture. Similarly, type fonts (which are by analogy the display) are recognized as configurations, not surface ornamentation.

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 in the specification as forming no part of the claimed design. The Federal Circuit 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. Moreover, upon implementing the original guidelines for Examination of Design Patent Applications For Computer-Generated Icons, addressing public comments in 1996, the USPTO took the position that the dependence of a computer-generated icon on a Central Processing Unit ("CPU") for its existence is not a reason for requiring depiction of a CPU.

Thus, when the display of a computer-generated image design is not dependent on a physical display panel, the USPTO should not require illustration of the article of manufacture associated with the display, even if only in broken lines. This is an antiquated practice which has outlived its initial purpose and should be updated to meet the technological advancements and realities of the day.

Indeed, 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 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 physical display panel (even if only in broken lines) in order to disclose a computer-generated image as design patent eligible.

Moreover, AIPLA respectfully submits that a computer-generated image design that is not displayed on a display panel but is nevertheless understood to be more than a picture on a screen by being integral to the operation of a programmed computer should be eligible for design patent protection. This could be supported by identifying, instead of the display panel, another article associated with the programmed computer, or the programmed computer itself, and indicating that the image is a graphical user interface or icon.

Pursuant to *Strijland*, just like computer generated image designs displayed on a display screen, a computer-generated image design displayed other than on a display screen should be accepted as eligible for design patent protection when it is disclosed as being more than a picture standing alone. This could be supported by being for an article of manufacture associated with display of the computer-generated image design.

Under *Strijland*, design patent eligibility for computer generated images does not turn on the display screen as the article of manufacture. In that case, the Board stated: "It should be noted, however, we 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 understanding the designs as an integral part of the operation of a programmed computer, which is supported by them being on a display screen.

Currently, when a computer-generated image design is identified as being for a display screen or portion thereof with graphical user interface or icon, the article of a display screen and the description of the computer-generated image design as a graphical user interface or icon together are accepted as indicating that the disclosed design is applied to an article and therefore more than a mere picture on a screen. This is based on a general premise that a graphical user interface or icon, particularly when it appears on a display panel associated with a computer, is understood to be integral to the operation of the computer or a computer application.

However, the key to eligibility under *Strijland* is not the display screen itself; rather the display screen is an article that helps but is not dispositive to identify a computer-generated image as being integral to the operation of a computer or a computer application.

A display screen is not the only permissible article of manufacture and is not the only article of manufacture that can help associate the claimed computer-generated image design as being 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.

Further, AIPLA respectfully submits that when a computer-generated image design is displayed other than on a display panel, it may nevertheless be eligible if it is disclosed as being for an article associated with a programmed computer and as interactive with a user or device. These are sufficient indications that the computer-generated image design is integral in the operation of a computer. Disclosure as interactive with a user or device should be presumed if the design is for a graphical user interface or icon, and 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* as more than a mere picture by being integral to the operation of a programmed computer. It is the appearance, not utility, that is claimed in a design patent.

The Office's implementation of the Board's eligibility 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 a type of article of manufacture; however it is the appearance of a design, not its utility, that is the proper subject matter of a design patent. *In re Zahn* states, "[35 U.S.C.] 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" and that 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, for an article such as a label or packaging.

Additionally, it is noted that in Europe, computer-generated image designs are protected per se in Locarno Class 32 (Graphic symbols and logos, surface patterns, and ornamentation) without reference to a specific article of manufacture and without a requirement of being interactive or integral to the operation of a programmed computer. Other significant IP Offices, such as Singapore, Japan, Korea, and China, are moving away from claiming an article of manufacture associated with a graphical user interface or icon.

As explained above, AIPLA does not believe an amendment to 35 U.S.C. 171 is required to change the interpretation of the USPTO guidelines for eligibility of computer-generated image designs to accept another article of manufacture associated with the underlying programmed computer instead of requiring that the image appear on a display screen.

AIPLA appreciates this opportunity to provide comments to the current Guidance and encourages the USPTO to make an adjustment to current examination practice to extend protection to computer-generated image designs displayed by emerging technologies. Such adjustments include removing the requirement that drawings of a claimed icon or graphical user interface design be embodied in a display screen, and we are grateful for the examples in the supplemental guidance that the Office considered inadequate. We ask that the Office also include additional examples that would not meet 37 CFR 1.153(a).

Thank you in advance for considering these views.

Sincerely,

Kimberly Van Voorhis
President
American Intellectual Property Law Association