INTA Comments on the USPTO's Interpretation of the *Article of Manufacture* Requirement in the United States Code

The International Trademark Association (INTA) appreciates the opportunity to contribute to the United States Patent and Trademark Office's (USPTO) public consultation on whether its interpretation of the article of manufacture requirement in the United States Code should be revised to protect digital designs that encompass new and emerging technologies.

Below are INTA's comments on each of the topics for public comment. We hope that you find these useful and remain at your disposal should you have any questions or wish to discuss our input in further detail.

Topics for Public Comment

The public is invited to submit comments on any topics related to 35 U.S.C. 171 that they deem relevant. The USPTO is particularly interested in receiving views and comments on the questions presented below. The tenor and substance of the questions should not be taken as an indication that the USPTO is predisposed to any particular views, positions, or actions. The USPTO also invites the public to share their views and insights on other aspects of section 171 that are not addressed in the questions.

To be eligible for patent protection, a design must comply with the "article of manufacture" requirement of section 171. The USPTO has interpreted the jurisprudence to require that designs for computer-generated icons meet the following criteria: (1) They must be embodied in a computer screen, monitor, other display panel, or portion thereof; (2) They must be more than a mere picture on a screen; and (3) They must be integral to the operation of the computer displaying the design. Some stakeholders have expressed that they are unable to obtain design protection for certain new and emerging technologies (*e.g.,* projections, holographic imagery, and virtual/augmented reality) because they do not meet the current criteria.

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.**

INTA is not aware of any types of designs associated with new and emerging technologies that are not currently eligible for design patent protection. To the extent that the USPTO might be considering treating any projected, holographic, and/or virtual/augmented-reality designs (collectively "PHVAR" designs) as ineligible subject matter, INTA opposes this conclusion for the reasons set forth below.

To the extent that a PHVAR design represents an interface or other means of operating a computer or other electronic device (*see Ex parte Strijland*, 26 U.S.P.Q.2d 1259, *4-5 (B.P.A.I.

1992), these designs are patent eligible since they are embodied in an article of manufacture in a similar manner to how designs for graphical user interfaces (GUIs) are embodied in display screens of electronic devices. Especially in the case where a PHVAR design is described as relating to an interface for an article of manufacture (e.g., in the title or claim), the Applicant will have established that the claimed design is not a design per se but a design for an article of manufacture.

INTA does not believe that a statutory change should be necessary to render PHVAR designs patent-eligible under 35 USC 171, but it may be advisable for the USPTO to issue examination guidelines or revise the MPEP to provide examples or otherwise clarify how PHVAR design may be patent eligible. Regarding the eligibility of projected two- or three-dimensional designs, INTA suggests that the USPTO should rely on the holding of *In re Hruby* as its guiding precedent instead of Strijland (*see* MPEP Sec. 1504.01(a)). The *Hruby* court held that the design of water as emitted from a fountain was patent eligible, reasoning that "We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design 'for an article of manufacture." *In re Hruby*, 373 F.2d 997, 1001, 153 USPQ 61, 66 (CCPA 1967).

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.

Yes, for the reasons set forth above, although a design being "integral to the operation of a device" should not be a requirement for patent eligibility. PHVAR designs are "embodied" in electronic devices in the same manner as are GUI designs, in that any PHVAR design is made "concrete and perceptible" or "given a concrete form" by the article of manufacture (e.g., electronic device that generates the PHVAR design). See https://www.merriam-webster.com/dictionary/embody; https://www.dictionary.com/browse/embody?s=t.

PHVAR designs are qualitatively different from "mere picture[s] or abstract designs" (i.e., designs per se) in that they are integral to the operation of a computer or other electronic device.

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 or abstract design. If you believe that these designs do not meet the requirements of section 171, please explain the basis for that view.

Yes, although a design being "interactive with a user or device" should not be a requirement for patent eligibility (*see In re Hruby*).

Two- and three-dimensional projected designs—whether projected directly toward a user's retina, onto a vapor or diffused particles, or onto an environmental surface—may be perceived

and interacted with by users in any number of ways (e.g., motion- or voice-operated controls, in addition to traditional touch or point-and-click means), although the manner of interactivity with a design that is embodied in an article of manufacture should not matter in the eligibility analysis.

PHVAR designs are qualitatively different from "mere picture[s] or abstract designs" (i.e., designs per se) in that they are made perceptible by a device (article of manufacture), and in this sense "embodied" therein.

4. If the projection, holographic imagery, or image appearing through 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 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 or abstract design. If you believe that these designs do not meet the requirements of section 171, please explain the basis for that view.

As noted above, a design being "integral to the operation of a device" or "interactive with a user or device" should not be a requirement for patent eligibility for a PHVAR design, and **the only requirement for eligibility should be that the PHVAR design is embodied in (i.e., applied to or made perceptible by) an eligible article of manufacture**.

INTA wishes also to bring the USPTO's attention to its treatment of digital typesets and fonts, which are patent eligible as two-dimensional designs per se (*see* MPEP 1504.01(a)).

5. Do you support a change in 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.

No change in interpretation of the "article of manufacture" requirement of 35 USC 171 is necessary to impart patent eligibility on PHVAR designs.

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.

Under its Model Design Law Guidelines and Guidelines for Examination of Industrial Designs, INTA considers that design protection of GUIs, icons, fonts and animations should be available and recommends that these be capable of registration in and of themselves without requiring them to be placed on a physical article. These Guidelines should be read in conjunction with and extended to the above comments relating to PHVAR designs.

INTA believes that a link between a GUI/PHVAR design and an article of manufacture should not be required in order to allow creative designs to be adequately protected, regardless of the article which generates the design. Indeed, technology is developing very fast and it is not always possible to foresee where a design can or will be displayed, as this may not be known when creating the design. Moreover, the effort of creating a design (innovation effort) should be protected independently of where it will be used, i.e., the scope of protection should not be

linked to a particular product. Finally, it should be noted that a PHVAR design can be shown by different users in different devices. Therefore, creators should be able to obtain protection for the design independently of the device used to make it perceptible.

In practice, the transferability of GUIs, PHVAR designs, icons, and fonts across technology means that it is essential—if protection for these categories of designs is to be meaningful and robust—that their protectability NOT be dependent on the product that incorporates them. INTA's view is that applicants are best positioned to determine how to disclose an innovative design for the purposes of applying for its protection. INTA therefore advocates that the designer be given the choice as to how best to represent the design. If the designer wishes to apply to register the design in relation to a specific product, they should be able to do so. If the designer wishes to register the design per se, they should be able to do so.

About INTA

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network.

Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Brussels, Santiago, Shanghai, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit inta.org.