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February 4, 2021

Drew Hirshfeld

Performing the functions and duties of the Under Secretary of Commerce for  
Intellectual Property and Director of the USPTO  
P.O. Box 1450  
Alexandria VA 22313-1450

VIA ELECTRONIC SUBMISSION through the Federal eRulemaking Portal @  
www.regulations.gov

**Re: Docket No. PTO-C-2020-0068**

Dear Director Hirshfeld:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments published on December 21, 2020 in the Federal Register / Vol. 85, No. 245 (the "Notice") concerning whether the United States Patent and Trademark Office (USPTO) should revise its interpretation of the article of manufacture requirement in the United States Code to protect digital designs that encompass new and emerging technologies.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO's mission is to promote high quality and enforceable intellectual property rights and predictable legal systems for all industries and technologies. Our vision is that this will result in the global acceleration of innovation, creativity, and investment necessary to improve lives.

Below please find, for your consideration, IPO's comments in response to topics for public comment that were identified in the Notice.

**Item 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.*

Graphical interfaces or portions of graphical interfaces generated by a computer and visually presented by means other than on a computer screen, monitor or other display panel, such as through projection, augmented reality (AR), or virtual reality (AR), should be eligible for design patent protection. A graphical user interface (GUI) is one example of a graphical interface. Other examples of a graphical interface could include a three-dimensional image of a vehicle part (e.g., hood, fender, engine component) presented in a projection, VR or AR environment that facilitates interaction of a user with the image to understand assembling, operating, servicing, and/or repairing the vehicle part. As another example, an image of a shoe may be put on virtually (e.g., by a user or a user's avatar) to facilitate an underlying function (e.g., fit test, comfort test, assessing as-worn appearance, and the like).

We believe these designs satisfy the requirements of section 171 and differ from a mere picture or abstract design because they are designs *for* articles of manufacture, despite not being presented on a display. As explained in the Notice, the Supreme Court in *Samsung Electronics Co. v. Apple Inc.* concluded that an “article of manufacture” is “simply a thing made by hand or machine.”<sup>1</sup> Projected, holographic, AR, or VR images are a “thing” made by a machine (*i.e.*, a computer).

Further, implicit characteristics of interfaces differ from those of mere pictures, such as having some underlying function related to the operations of a machine or computer, facilitating interaction with the computer, and/or graphically presenting computer output(s). A GUI presented by means other than on a display panel should be eligible as it is merely one species of the broader GUI genus. Clear precedent already supports the eligibility of GUIs for design patent protection and how GUIs satisfy the requirements of 35 U.S.C. § 171. By its very nature, any GUI, regardless of how it is presented, is more than a mere picture.

Furthermore, the potentially ephemeral or non-static physical nature of these graphical interfaces does not disqualify them as designs for articles of manufacture, as precedent exists for the protection of other transient designs, such as the water display presented by a water fountain.<sup>2</sup> In *In re Hruby*, the court found that the portion of a water fountain which is composed entirely of water qualifies as an article of manufacture. Similar to the water-only portion of a fountain, which is controlled by the fountain components, graphical interfaces projected onto a surface or into a fluid medium may be controlled by a computer, such that both are things made by a machine.

We do not believe a statutory change is necessary; rather, this change could be implemented by a change in USPTO policy to no longer require a graphical interface to be shown on a computer screen, monitor, other display panel, or a portion thereof.

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<sup>1</sup> *Samsung Electronics Co. v. Apple Inc.*, 137 S. Ct. 429 (2016).

<sup>2</sup> *In re Hruby*, 373 F.2d 997, 998 (C.C.P.A. 1967).

Protection for type fonts serves as precedent for this change. Technology advanced and type fonts transitioned from physical wood blocks to computers. As a result, the USPTO recognized that physical printing blocks did not need to be depicted to protect type fonts. Likewise, technology has advanced and graphical interfaces no longer need a display screen to be presented. Accordingly, the USPTO can change its policy by recognizing that a display screen does not need to be depicted to protect graphical interface designs in U.S. design patent applications.

***Item 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.*

As explained under the comments responding to Item 1, graphical interfaces inherently differ from “a mere picture” by being designs for articles of manufacture and also due to implicit characteristics of a graphical interface. While being “integral to the operation of a device” may be sufficient to render a graphical interface eligible under Section 171, it is too high a bar to be a requirement for eligibility under Section 171, and graphical interfaces with a lesser or different relationship to an underlying device should also be eligible for design protection.<sup>3</sup>

***Item 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.*

As with Item 2, while graphical interfaces that are inherently “interactive with a user or a device” may be sufficient to render a graphical interface eligible under Section 171, this is also too high a bar to be a requirement for eligibility under Section 171. Interactivity with a user alone should not be a requirement for eligibility under Section 171.

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<sup>3</sup> The “integral to the operation of a device” criterion stems from *Ex parte Strijland*, 26 U.S.P.Q.2d 1259 (B.P.A.I. 1992), which is non-precedential and was decided almost 30 years ago—well before GUI diverse functionalities within computers had progressed to today’s more advanced state.

**Item 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 in response to the previous Items, this type of design may be eligible under Section 171, if it is a “graphical interface,” which as explained above is a design for an article of manufacture and is implicitly more than a mere picture. As such, this type of design may still be eligible under Section 171 even if the graphical interface is not integral to the operation of a device or interactive with a user or device. However, an image that is a “mere picture” should not be eligible for design patent protection under Section 171.

**Item 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.*

We support a change in interpretation of the article of manufacture requirement in 35 U.S.C. § 171, specifically to reflect that design patent rights are *for* the design and not for the underlying article. While the design must still be “for” an article of manufacture, this should not be a singular restriction limiting the design to only a single article of manufacture. That is, we believe that for eligibility the design must be for at least one article of manufacture. However, the design may also be applicable to any of multiple articles of manufacture that may—but need not—be enumerated in the design patent application.

In our experience, the USPTO has permitted designs for more than one article of manufacture.<sup>4</sup> But recently, outside of certain types of designs (like those for motor vehicles), some examiners are more and more often issuing rejections (e.g., under Sections 171 and/or 112) requiring selection of a particular or singular “class” of article (e.g., as a title/claim changes or statement of use) and not permitting identification of multiple articles or classes, or not permitting a title (and corresponding claim) that the examiner considers could encompass multiple articles or classes. We are not aware of case law supporting this position or a rationale supporting this significant policy change. Under this restrictive practice, applicants

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<sup>4</sup> See e.g., U.S. Patent D908,539, titled “Motor Vehicle, Toy Vehicle replica and/or other replica”; D868,386, titled “Textured Glove and/or glove former”; D857,809, titled “Robot and/or Toy Robot and/or Mobile Phone”; D828,455, titled “Flying Vehicle and/or Toy Replica Thereof”; D787,759, titled “Washer and/or drying machine”; D518,757, titled “Motor vehicle and/or toy replica thereof.”

would be required to apply for multiple design patents to recite different articles, and this seems contrary to past USPTO practice. An applicant should be the master of their claim and limiting the claim to only one article or class is not required by Sections 171 or 112.

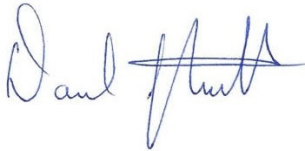
Further, the concept of “classes” is foreign to design patents. Focusing on classes may be appropriate in a trademark context, since it may go to the judicially recognized factor of the relatedness of goods or services, but there is no equivalent analysis in the design patent context. To the contrary, the design is the focus when comparing a design patent claim to an accused product, not the class of goods.

*Item 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.*

None.

We again thank the U.S. Patent and Trademark Office for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,

A handwritten signature in blue ink that reads "Daniel J. Staudt". The signature is written in a cursive style with a large initial "D" and a long horizontal stroke at the end.

Daniel J. Staudt  
President