



November 14, 2024

Honorable Kathi Vidal
Undersecretary of Commerce for Intellectual Property
Director, U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Submitted via: <https://www.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 (Fed. Reg. Notice 2023-25473; Doc. No. PTO-P-2023-0047)

Dear Director Vidal:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces (GUI), published on November 17, 2023, in the *Federal Register*, Vol. 88, No. 221 (the “Guidance”).¹

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Below please find, for your consideration, IPO’s comments in response to the Guidance.

¹ 88 Fed. Reg. 80,277 (proposed Nov. 17, 2023).

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I. Background

In a *Federal Register* notice published in 2020, the Office recognized that it needed to update its practices at the time to better protect “certain new and emerging technologies, such as projections, holographic imagery, or virtual/augmented reality[, which] do not require a physical display screen or other tangible article to be viewable,” and sought comments from the public.² Around the same time, the then-Director of the USPTO indicated that “new computing and optical capabilities are enabling digital products to move from conventional electronic screens, to projections, holograms, and other innovative displays” and that the U.S. needed “to consider a new, modern approach that takes into account the realities of current and future technology trends.”³

The USPTO’s 2020 Request for Information also acknowledged that “[o]ther jurisdictions have updated their laws and practices to accommodate design protection for new technologies.” It cited a 2020 survey by the World Intellectual Property Organization (WIPO) that showed “[t]he majority of responding jurisdictions *do not require a link between a GUI/icon design and an article as a prerequisite for registration*. This is mainly because of *the nature of new technological designs*, which may be used in different articles/environments.”⁴ More than three years later, additional jurisdictions have adapted their practices to protect cutting-edge digital designs not tied to traditional display screens.⁵

II. IPO Suggests that the Guidance Be Supplemented to Address Cutting-Edge Designs of Interest to Stakeholders

IPO suggests that a practice change be made in the U.S. for user interface designs that would recognize that these designs transcend the traditional display screen. Such a change would promote and protect innovation. It would also be consistent with practices being implemented

² The Article of Manufacture Requirement, 85 Fed. Reg. 83,063, 83,064 (proposed Dec. 21, 2020).

³ Andrei Iancu, Dir., U.S. Pat. & Trademark Off., Remarks at the Design Law Symposium (Dec. 10, 2020), *in Remarks by Director Iancu at the Design Law 2020 Symposium*, U.S. PAT. & TRADEMARK OFF. (Dec. 11, 2020), <https://www.uspto.gov/about-us/news-updates/remarks-director-iancu-design-law-2020-symposium>.

⁴ The Article of Manufacture Requirement, 85 Fed. Reg. at 83,065 (emphasis added) (quoting World Intellectual Property Organization [WIPO] Standing Comm. on the L. of Trademarks, Indus. Designs and Geographical Indications on Analysis of the Returns to the Second Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs, WIPO Doc. SCT/43/2, at 37 (2020), https://www.wipo.int/edocs/mdocs/sct/en/sct_43/sct_43_2.pdf).

⁵ For instance, 36 of 50 countries responded “no” when asked by WIPO whether their jurisdiction required “a link between a GUI/icon design and an article . . . as a prerequisite for registration.” World Intellectual Property Organization [WIPO] Standing Comm. on the L. of Trademarks, Indus. Designs and Geographical Indications on Compilation of the Returns of the Second Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs, WIPO Doc. SCT/41/2 rev. 2, at 5–8 (2021), https://www.wipo.int/edocs/mdocs/sct/en/sct_41/sct_41_2_rev_2.pdf. In one example, Singapore’s 2020 update to its Registered Designs Act provides for the protection of designs with respect to “non-physical products,” which it states: “(a) means any thing that — (i) does not have a physical form; (ii) is produced by the projection of a design on a surface or into a medium (including air); and (iii) has an intrinsic utilitarian function that is not merely to portray the appearance of the thing or to convey information.” Registered Designs Act 2000 (2020 Rev Ed) Part I, s 2 (Sing.).

globally — and could help ensure that the U.S. innovation ecosystem related to user interface designs is not at a disadvantage when compared to the systems of other countries.

More specifically, IPO believes that the current Guidance does not explain the standards or practices that the USPTO applies to digital user interface designs that have advanced beyond their display on a typical computer monitor or display screen (such as interface designs that are viewed through augmented or virtual reality headsets, or holographic or projected designs). Rather, the Guidance outlines examples of examination of user interface designs that have been routinely patented since the original USPTO GUI Guidelines were published in 1996.

IPO is concerned that the Guidance continues to suggest that showing a physical display screen is a prerequisite for eligibility of a GUI or icon, *i.e.*, that a GUI or computer-generated icon must be displayed directly on a physical computer screen, monitor, or other display panel, or portion thereof to be eligible for U.S. design patent protection. While it is not necessary to include an entire computer or computer display screen in a design patent drawing, some portion of it must be shown, even if it is simply a broken line surrounding the claimed user interface, as in the example below:⁶



However, computers and user interface designs are rarely designed together and technology has evolved such that computer display screens are not necessary to view a computer-generated user interface design. For this reason, IPO suggests that the USPTO should eliminate the requirement to show the article of manufacture—the computer—in the drawings to satisfy 35 U.S.C. § 171.

The USPTO made a similar change nearly thirty years ago when it eliminated the requirement to show the article of manufacture—a type block—for typeface designs.⁷ No statutory change was necessary to effect this change in practice; the USPTO simply eliminated the requirement to show the article of manufacture to satisfy 35 U.S.C. § 171. An example of a figure from a typeface design patent is shown below:⁸

⁶ 88 Fed. Reg. 80,277 (proposed Nov. 17, 2023), *Example 1* (illustration) at 80,280.

⁷ U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1504.01(A)(III) (6th ed., rev. 2 1996).

⁸ Typeface or Type Font, U.S. Design Patent No. D1,028,074 fig.1A (issued May 21, 2024).

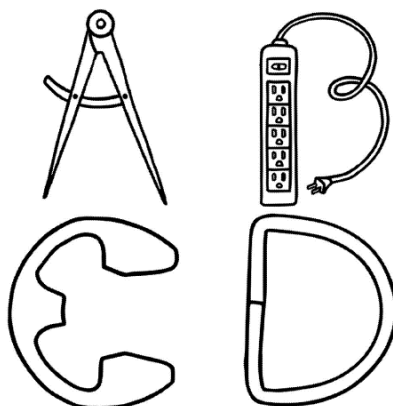


FIG. 1A

A similar practice change could be made for user interface designs. It would recognize the reality that technology has evolved to the point where user interface designs transcend the traditional display screen, and thereby promote and protect innovation in user interface designs.

III. The USPTO Has the Legal Basis To Protect Digital User Interface Designs Separate From A Display Screen.

In response to its 2020 Request for Information, the USPTO received ample comments outlining strong legal and policy rationales for protecting digital user interface designs not displayed on a traditional display screen. IPO's own comments provided straightforward support for doing so, citing analogous Federal Circuit case law and the USPTO's own longstanding practice in analogous contexts.⁹

IPO notes that, in *In re Hruby*, the Court of Customs and Patent Appeals found that the transient shape of water expressed from a water fountain qualified for design patent protection as an article of manufacture.¹⁰ Applying this holding to user interface designs, a graphical interface projected onto a surface or into a fluid medium, or otherwise disassociated from a traditional display screen, qualifies for protection as well.

The USPTO itself has long supported design protection for type fonts, independent of any particular display screen, page, or other medium. In fact, the USPTO explicitly *prohibits* examiners from rejecting "claims for type fonts ... for failure to comply with the 'article of manufacture' requirement."¹¹ The Office could just as easily protect user interface designs uncoupled from traditional display screens. This would help ensure that user interface designs are sufficiently protected in order to encourage innovation.

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⁹ Intell. Prop. Owners Ass'n, Comment Letter on The Article of Manufacture Requirement (Feb. 4, 2021), <https://ipo.org/wp-content/uploads/2021/02/IPO-Comments-Designs.pdf>.

¹⁰ 373 F.2d 997, 998 (C.C.P.A. 1967).

¹¹ U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1504.01(a)(III) (9th ed., rev. 5 2023).

Accordingly, IPO encourages the USPTO to issue new guidelines that will eliminate the requirement to show a display screen, and explain the standards and practices the Office will apply to digital user interface designs that have advanced beyond a typical display screen, such as augmented, virtual reality, holographic, or projected designs. IPO suggests the Office add a section to the Manual of Patent Examining Procedure (MPEP) that applies the same treatment to GUIs as the USPTO currently applies to type fonts, as shown below (with differences annotated relative to the MPEP's current type font guidelines):

III. TREATMENT OF ~~TYPE FONTS~~ DIGITAL USER INTERFACE DESIGNS

Traditionally, ~~type fonts~~ digital user interfaces have been generated by computer display screens ~~solid blocks from which each letter or symbol was produced~~. Consequently, the USPTO has historically granted design patents drawn to digital user interface designs ~~type fonts~~. USPTO personnel should not reject claims for digital user interface designs ~~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 in or on mediums other than a display screen, do not require a display screen ~~solid printing blocks~~.

IPO thanks the USPTO for its attention to IPO's comments submitted herein. It welcomes further dialogue and opportunity to provide additional comments.

Sincerely,



Krish Gupta
President