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VIA ELECTRONIC SUBMISSION
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A law firm that concentrates on legal issues involving designs, product configurations and related intellectual property

Andrew Hirshfeld
Commissioner for Patents,
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual and
Director of the United States Patent and Trademark Office
Mail Stop OPIA
Attn: Elizabeth Shaw; Courtney Stopp
P.O. Box 1450
Alexandria, VA 22314

Re: Request for Information: Patent Eligibility Jurisprudence Study
Docket No. PTO–P–2021–0032; Fed. Reg. Vol. 86, No. 129 (Jul. 9, 2021)
Docket No. PTO–P–2021–0034; Fed. Reg. Vol. 86, No. 169 (Sep. 3, 2021)

Dear Commissioner Hirshfeld,

I am pleased to have this opportunity to submit comments in response to the above-referenced notices on behalf of Saidman DesignLaw Group, LLC, a law firm which has focused on design protection for over 30 years. Our clients range from Fortune 500 companies to individual designers, innovating across a wide range of products and services. We have helped applicants protect thousands of designs through design patents in the U.S. and foreign design patents and registrations in jurisdictions around the world, many directed to graphical user interfaces.

These comments are responsive to the Notices' call for public comment on the technological area of graphical user interfaces.

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Current USPTO guidelines consider computer-generated images to be subject matter eligible for design patent protection under 35 U.S.C. §171 when the computer-generated image is a graphical user interface or icon which is integral to the operation of a programmed computer and is shown on a computer screen, monitor or other display panel.[1]

Display technologies are advancing quickly, mainstreaming projected, augmented and virtual reality and immersive displays of computer-generated images without a traditional screen, leaving the USTPO's screen requirement outdated and unduly limiting.[2] Moreover, the Board decision on which the Guidelines are based acknowledges that appearing on a screen is not what makes computer-generated designs eligible.[3]

The USPTO issued a Comment Request regarding the Article of Manufacture Requirement (Docket No. PTO–C–2020–0068; Fed. Reg. Vol. 85, No. 245 (Dec. 21, 2020) addressing this issue. Of 19 comments received, 13 comments

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[1] *Guidelines for Examination of Design Patent Applications For Computer-Generated Icons* (hereinafter "Guidelines")(Docket No. 950921236-6049-03; Fed. Reg. Vol. 61, No. 55 (Mar. 20, 1996); See M.P.E.P. 1504.01(a).

[2] Although these technologies might utilize a screen, panel or lens in displaying a computer-generated image, explicitly requiring the image to be shown on a screen is not necessarily consistent with how the user experiences the displayed design, not on a traditional screen.

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

favor protecting computer-generated image designs without limitation to a display screen.[4]

The display screen requirement was apparently adopted as a proxy to convey that the computer-generated image is displayed integral to the operation of a programmed computer, the computer being the relevant article of manufacture for eligibility purposes under 35 U.S.C. 171, not the display screen. When a programmed computer no longer displays the computer-generated image on a display screen, the display screen is not a useful proxy, and should not be required. The USPTO previously jettisoned the outdated physical article for digital type designs and should do so now for graphical user interfaces and icons, eliminating the screen requirement.[5]

The USPTO should also eliminate the screen requirement to keep pace with IP protection in other leading jurisdictions which have recently updated their laws to protect computer-generated designs beyond screens.

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[4] The following 13 of 19 comments received are believed to support protecting computer-generated image designs independent of a display screen: AIPLA; IPO; INTA; FICPI; Volvo; Apple; Perry Saidman; Banner Witcoff; Sterne Kessler; Saidman DesignLaw Group; IP Horrigan; Dunstan Barnes; and Naor Amir.

[5] See M.P.E.P. Section 1504.01(a)(III), Treatment of Type Fonts, which 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."

In Europe, computer-generated images may be registered in Locarno Class 32 for "graphic symbols and logos, surface patterns, ornamentation" without limitation to a screen.[6] Singapore has protected computer-generated image designs not displayed on screen since June 20, 2018.[7] Japan provides a path to register computer-generated image designs not displayed on screen as of May 17, 2019.[8] Korea amended its Design Protection Act to cover computer-generated image designs not displayed on screen effective October 21, 2021.[9]

We encourage the USPTO to join these thought leaders and make a small but meaningful practice change, well within its authority and precedent, to enable protection of graphical user interface and icon designs into the future by eliminating the screen requirement for design patent eligibility.

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[6] The Locarno Classification is an international classification used for the purposes of the registration of industrial designs. See https://www.wipo.int/classifications/locarno/locpub/en/fr/?class_number=32&explanatory_notes=show&id_numbers=show&lang=en&menulang=en&mode=loc&notion=&version=20210101 (last accessed October 15, 2021).

[7] See https://www.ipos.gov.sg/docs/default-source/resources-library/design/practice-directions/2018/practice-direction-no-4-of-2018---registration-of-graphical-user-interfaces-(guis).pdf (last accessed October 15, 2021).

[8] See https://www.jpo.go.jp/e/system/laws/rule/hokaisei/tokkyohoutou_kaiei_20190517.html (last accessed October 15, 2021).

[9] See https://www.ip.kimchang.com/en/insights/detail.kc?sch_section=4&idx=23415 (last accessed October 15, 2021).

Thank you for your consideration.

Sincerely,

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