

Before the
United States Patent and Trademark Office
Alexandria, VA

In re

Request for Information on the Article of
Manufacture Requirement

Docket No. PTO-C-2020-0068

**COMMENTS OF
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

The Computer & Communications Industry (CCIA)¹ submits the following comments in response to the U.S. Patent and Trademark Office’s December 21, 2020, Request for Information.² CCIA is an international, not-for-profit trade association representing a broad cross section of communications and technology firms. For nearly fifty years, CCIA has promoted open markets, open systems, and open networks. CCIA members employ more than 1.6 million workers, invest more than \$100 billion in research and development, and contribute trillions of dollars in productivity to the global economy. CCIA members are also active participants in the patent system, holding approximately 5% of all active U.S. patents. CCIA’s comments reflect CCIA members’ experiences with design patents.

The design patent system provides potentially valuable protection for new and ornamental designs for articles of manufacture. But the designs described in the Request are not designs for an article of manufacture. As the USPTO acknowledges, these designs “are not applied to or embodied in a physical product but can perform a utilitarian function.”³ CCIA takes no position on whether protection should be extended to the type of design described in the Request. However, the present design patent statute does not permit the USPTO to protect such designs. Rather than designs for an article of manufacture, such designs are better understood as designs *per se*. Providing protection to a design which is not applied to any article of manufacture, much less a particular article of manufacture, contradicts the plain language of the statute and exceeds the USPTO’s authority. This error in part stems from the description by the USPTO of design patents as covering designs “embodied in an article of manufacture” when the statute extends only to designs as applied to or giving form to an article of manufacture.⁴ Finally, other areas of intellectual property law may already provide adequate protection for such designs, removing any urgent need to permit additional protection via design patent.

Given the lack of any statutory authority to protect these types of designs, the USPTO should refrain from issuing such patents unless the statutory text is changed.

¹ A list of CCIA members is available online at <http://www.ccianet.org/about/members>.

² The Article of Manufacture Requirement, 85 Fed. Reg. 83063 (Dec. 21, 2020) (hereinafter “Request”).

³ Request at 83065.

⁴ *Gorham Co. v. White*, 81 U.S. 511, 525 (1871).

I. The Design Patent Statute Does Not Permit Extension of Protection to Designs That Are Not Applied to an Article of Manufacture

35 U.S.C. § 171 authorizes design patent protection for “new, original and ornamental design[s] for an article of manufacture.” This statutory text is further informed by 35 U.S.C. § 289’s statement that design patent infringement includes the act of “appl[ying] the patented design ... to any article of manufacture” and “sell[ing] or expos[ing] for sale any article of manufacture to which such design or colorable imitation has been applied.” These two pieces of statutory text set forth two requirements: (1) the design must be for a tangible article and (2) the design must be applied to that article of manufacture, not merely a design standing alone.

A. Design for a Tangible Article

When 35 U.S.C. § 289 was adopted, the phrase “article of manufacture” meant “a tangible item made by humans—other than a machine or composition of matter—that had a unitary structure and was complete in itself for use or for sale.”⁵ This phrase was also recently interpreted by the Supreme Court in *Apple v. Samsung*, where it noted that an article “is just ‘a particular thing’” and a manufacture is “‘the conversion of raw materials by the hand, or by machinery, into articles suitable for the use of man’ and ‘the articles so made.’”⁶ Using these definitions, the Supreme Court defined an article of manufacture as “a thing made by hand or machine.”⁷ The USPTO’s reviewing appellate court, the Federal Circuit, has also interpreted the term “article” in a related statute to mean a “material thing.”⁸

Given this, the phrase “article of manufacture” is best understood in much the same way as its original meaning—a tangible item made by humans. Any design eligible for protection must then be a design for a tangible item made by humans.

There is an additional concern for projected displays and displays which, as the Request describes, “do not require a physical display screen or other tangible article to be viewable.”⁹ In *in re Nuijten*, the Federal Circuit held that “[a] transitory, propagating signal like Nuijten’s is not a ‘process, machine, manufacture, or composition of matter.’”¹⁰ And a predecessor court rejected the idea that there is any distinction between a manufacture and an article of manufacture.¹¹ Thus a transitory, propagating signal is not properly an article of manufacture. Projected images are composed of light, a form of transitory propagating electromagnetic signal. Designs for such projected displays are therefore designs for propagating signals, not designs for an article of manufacture, and not a proper subject for design patent protection.

B. Design Applied to an Article of Manufacture

However, the article is not itself the invention. Instead, “the thing invented or produced, for which a patent is given, is *that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form.*”¹² While the

⁵ Burstein, *The Article of Manufacture in 1887*, 32 BERKELEY TECH. L.J. 1, 5 (2017).

⁶ *Samsung v. Apple*, 137 S. Ct. 429, 434-35 (2016).

⁷ *Id.*

⁸ See *ClearCorrect Operating v. Int’l Trade Comm’n*, 810 F.3d 1283, 1291-92 (2015).

⁹ Request at 83064.

¹⁰ *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

¹¹ *In re Hadden*, 20 F.2d 275, 276 (D.C. Cir. 1927).

¹² *Gorham Co. v. White*, 81 U.S. 511, 525 (1871) (emphasis added).

phrase “embodied in an article of manufacture” has been used to describe the subject matter of a design patent, that phrase reverses the necessary relationship.¹³ To support design patent protection, the design must give form to the article of manufacture itself, not simply be created by the article of manufacture.¹⁴

The types of designs discussed in the Request appear to be designs created by the article of manufacture which produces them, rather than giving form to the producing article. A projected display does not give form to the projector but instead creates a display on whatever article of manufacture the user aims the projector at. The design is not defined by the producing article and does not give form to it, but rather is defined by a display surface separate from the producing article. Such a relationship is not a design “which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied,” as the design patent statute requires.¹⁵

Accordingly, permitting patents on the types of designs described in the Request would violate the two primary statutory constraints on design patents.

II. Permitting Design Patent Protection of the Types of Designs Described in the Request Would Amount to Permitting Designs *Per Se*

Beyond being a design for application to an article of manufacture, design patents must be designs for a *particular* article of manufacture. A failure to limit a design to a particular article creates an impermissible patent on a design *per se*.¹⁶ Such design patents have repeatedly been held to be impermissible.¹⁷

For the types of displays discussed in the Request which project onto a surface, the article to which the design is applied (e.g., via projection) is inchoate when the device is manufactured and could be any surface on any manufactured or non-manufactured item. Permitting a design patent on any projection that intersects with any surface, no matter what that surface is, is precisely permitting a patent on a design *per se*. (And as noted *supra*, designs for projection without any tangible item involved are not eligible subject matter for design protection, being transitory signals.)

Permitting a company to patent a design no matter what it is applied to—up to and including the bare air—makes a nullity of the statutory requirement that the design be for an article of manufacture and the Federal Circuit’s admonition that it be for a particular article of manufacture. To do so would effectively read out the “article of manufacture” requirement, the kind of “rewriting” of a statute that exceeds an agency’s authority to interpret its statute.¹⁸

¹³ MPEP § 1502.

¹⁴ *Cf. in re Hruby*, 373 F.2d 997 (C.C.P.A. 1967) (permitting patenting of an ornamental fountain on the basis that the water of the fountain was the relevant article of manufacture).

¹⁵ *Gorham*, 81 U.S. at 525.

¹⁶ *Curver Luxembourg v. Home Expressions*, 938 F.3d 1334, 1339 (Fed. Cir. 2019).

¹⁷ *Id.*

¹⁸ *Utility Air Regulatory Group v. EPA*, 134 S. Ct. 2427, 2445 (2014).

III. Other Areas of Intellectual Property Provide Sufficient Protection for Aesthetic Elements of Useful Articles That Do Not Qualify for Design Patent Protection

There does not appear to be an imminent need for such protection. Congress has already provided protection for aesthetic elements, such as user interface designs, that fall outside the scope of design patents, via copyright and trade dress law. That doctrine can extend to aesthetic elements of useful articles.¹⁹ Graphical user interface (GUI) elements are understood to be protected by copyright where required to protect expressive interests, such as design elements, and may also be protected by trade dress in appropriate situations.²⁰ Accordingly, protection for the designs at issue in the Request may already exist via other areas of intellectual property law.

Further, extending protection in this way has serious potential for negative effects. As one commentator notes, if design patent protection could cover animations projected from a projector system, it would be possible to obtain a design patent on a copyrighted film and use that design patent to defeat critical aspects of copyright such as fair use.²¹ Such ephemeral images and animations—such as some of the augmented reality and virtual reality interface designs described in the Request—are difficult, if not impossible, to meaningfully distinguish from a movie projected by a projector, and protection thereof runs the risk of extending to all forms of projected audiovisual works.²² The USPTO should not take it upon itself to create a regime that could violate the First Amendment safety valves copyright law provides and such an action would be constitutionally questionable, at best.²³

Given the potential availability of appropriate copyright protection and the potential pitfalls of extending design patent protection to cover these types of displays, the USPTO should wait for Congress to determine whether to address the issue via legislation.

IV. Conclusion

The USPTO lacks any authority under the design patent statute to permit patenting of the types of designs described in the Request, and adequate protection appears to exist through other forms of intellectual property. The USPTO should not and cannot extend design patent protection beyond its current scope. If needed, that responsibility lies with Congress.

¹⁹ See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

²⁰ See, e.g., Stigler, *Ooey GUI: The Messy Protection of Graphical User Interfaces*, 12 NW. J. OF TECH. AND INTELL. PROP. 215 (2014).

²¹ See Risch, *Functionality and GUI Design Patents*, 17 STANFORD TECH. L. REV. 53, 68 (2013).

²² *Id.*

²³ See, e.g., *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000); Schulman, *Fair Use and the Revision of the Copyright Act*, 53 IOWA L. REV. 832, 833 (1967).

Respectfully submitted,

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