

## The Article of Manufacture Requirement under 35 USC 371: USPTO seeks insights in response to technology advances

By: Reid Huefner | February 10, 2021

The United States Patent and Trademark Office (PTO) recently sought public input into the proper interpretation the article of manufacture requirement (AoM) for design patents under 35 U.S.C. 171 (including, specifically, whether it should protect digital designs that encompass new and emerging technologies, such as projected, holographic, virtual -reality and other graphical user interface (together, “GUI”) designs). In response, the PTO received 19 comment submissions. The comments came from companies (3: LKQ<sup>1</sup>, Volvo, and Apple); attorney organizations (4: IPO, AIPLA, INTA, and FICPI); tech-industry associations (3: CCIA, EFF, and Engine); law firms and attorneys (6); law professor groups (2); and an individual inventor (1). All comments are available at <https://beta.regulations.gov/document/PTO-C-2020-0068-0001/comment>.

Although most of the comments focused on the narrow issue of how AoM should be interpreted in light of existing and new GUI technologies, three of the comments took a broader view and addressed AoM more generally. Two comments (one submitted by six renowned design law professors, one by LKQ Corp.) advocated for a reinvigorated AoM. Both comments advocating for a return of the AoM to its historically significant role pointed to *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980), as the event that started the PTO down the improper path of granting patents on design “fragments” and designs associated with an incomplete article of manufacture. Both comments advocated that AoM is important and should be interpreted in a way that does not allow for “untethered” designs. The other broad comment (by a patent attorney) advocated for the complete removal of AoM as a condition for design patent eligibility.

The other 16 comments, which focused on the application of AoM to digital images and GUIs, included four comments that generally took the position that digital imagery, such as GUIs, should not be patentable. The majority, however, took the position that the PTO should recognize GUIs as patentable design patent subject matter. A high-level summary of the various positions taken is as follows:

| <b><i>Anti-Patentability Comments (4)</i></b> | <b><i>Impermissible per se design patent</i></b> | <b><i>No Article of Manuf (Not Tangible)</i></b> | <b><i>No Article of Manufacture (No “Fixation”)</i></b> | <b><i>Other IP rights (CR/TM) are available</i></b> | <b><i>Beyond PTO’s Authority to Decide Issue</i></b> |
|---|--|--|---|---|--|
| <b>Computer and Comms Industry Assn</b>       | X  | X  |   | X   |  |
| <b>Engine (a tech advocacy non-profit)</b>    | X  |  |   |   | X  |
| <b>Electronic Frontier Foundation (EFF)</b>   |  | X  | X   |   | X  |
| <b>Berkley Profs. Stallman and Urban</b>      | X  |  |   | X   | X  |

<sup>1</sup> LKQ Corporation’s comment was filed by Irwin IP LLC, on LKQ’s behalf.

| <i>Pro-Patentability Comments (12)</i> | Design is “for” an Article, not “on” | GUIs are more than a mere photo | Only need article disclosed in Title/Spec | Like font/typeface design | Like the <i>Hruby</i> fountain design | Harmonize PTO with international law | Article should not be required for GUIs |
|--|--------------------------------------|---------------------------------|---|---------------------------|---------------------------------------|--------------------------------------|---|
| <b>Volvo</b>                           | X                                    |                                 |   |                           |                                       | X                                    |   |
| <b>Apple</b>                           |                                      | X                               | X   | X                         |                                       |                                      |   |
| <b>IPO</b>                             | X                                    | X                               |   | X                         |                                       |                                      |   |
| <b>AIPLA</b>                           | X                                    | X                               | X   | X                         | X                                     | X                                    |   |
| <b>INTA</b>                            |                                      | X                               |   | X                         | X                                     | X                                    | X                                       |
| <b>FICPI</b>                           |                                      | X                               |   |                           |                                       | X                                    |   |
| <b>Sterne Kessler</b>                  | X                                    |                                 | X   | X                         |                                       | X                                    | X                                       |
| <b>Banner Witcoff</b>                  |                                      |                                 |   | X                         |                                       |                                      |   |
| <b>Saidman Design</b>                  |                                      | X                               | X   |                           |                                       |                                      |   |
| <b>Kenaga (atty)</b>                   | X                                    |                                 |   | X                         | X                                     |                                      |   |
| <b>Barnes (atty)</b>                   |                                      |                                 |   | X                         |                                       |                                      |   |
| <b>Naor Amir (Inventor)</b>            |                                      |                                 |   |                           |                                       |                                      |   |

As these nineteen comments show, despite the article of manufacture requirement having been in existence for well over a century, because of the issuance of *In re Zahn* and the PTO’s subsequent interpretation thereof, as well as technological developments in the digital space, there continues to be significant divergence amongst design patent practitioners regarding how the article of manufacture requirement should be interpreted and how restrictive its role is and should be in determining what designs are patentable.