

Insights: Alerts

USPTO Issues Supplemental Guidance on Design Patent Protection for Computer-Generated Electronic Images

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Last month, the United States Patent and Trademark Office published [Supplemental Guidance](#) for the examination of design patent applications related to computer-generated electronic images. The guidance was provided to the patent examination core to assist with determining whether a design patent claiming a computer-generated electronic image satisfies the article of manufacture requirement under 35 U.S.C. 171. As noted by the USPTO, the guidance does not provide any new practice or procedure but reaffirms the longstanding interpretation that computer icons and graphical-user-interfaces (GUIs) shown on a display panel, or a portion thereof, are considered as an “article of manufacture” under 35 U.S.C. 171.

The guidance attempts to make a distinction between images displayed on a panel (e.g., computer screen, monitor, computer display system, mobile phone screen, virtual reality/augmented reality goggles) compared to icons and GUIs displayed on a panel. Notably, the guidance explains that a computer icon or a GUI shown on a display panel is an “integral and active component” in the operation of a panel displaying the computer icon or GUI. In contrast, the guidance notes that mere images displayed on a panel that are not a computer icon or a GUI is not an integral and active component in the operation of a computer and does not constitute statutory subject matter under 35 U.S.C. 171. The guidance reaffirms the current state of the law—an image standing alone or on a computer screen is not protectable by a design patent, and other avenues such as copyrights, may be an appropriate route to protect such designs.

The guidance also provides a few factors for examiners when determining whether a computer-generated image is eligible for design patent protection under 35 U.S.C. 171. These factors include the following when determining eligibility for computer-generated images:

- whether the claim and title for a computer-generated image are directed to an icon or GUI on a display panel (e.g., “computer screen with an icon” was provided as an acceptable title and claim, while an “icon for a computer screen” was provided as an example of an unacceptable title);
- whether the drawings show a display panel, or a portion thereof, in sufficient views to fully disclose the design as embodied in the article and depict a computer icon or a GUI embodied in a display panel; and
- whether the disclosure as a whole is directed to a design that includes a computer-generated electronic image embodied in an article of manufacture.

The guidance comes in response to an increase in design applications for computer-generated electronic images (e.g., icons and GUIs) of a computer program given the difficult patent eligibility hurdles for utility patents for software-based patents. This follows the USPTO's request for comments in 2021 on whether its interpretation of the article of manufacture requirement should be applied to virtual and augmented reality designs. The guidance does not provide further clarity on virtual and augmented reality designs, but instead reiterates existing guidance on traditional icons and graphical user interfaces that are tied to a display. Notably, the supplemental guidance was published a few days after the USPTO announced a separate bar for design patent practitioners.

While the newly issued Supplemental Guidance is more of a “back-to-basics” regarding the article of manufacture requirements for GUI designs, clients seeking to protect software innovations with utility patents would be wise to also consider design patents for the GUIs, to provide an added level of protection for the invention.

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