FICPI SEMINAR SERIES

New developments for IP practitioners

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FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION VON PATENTANWÄLTEN

FICPI

ACTING FOR THE IP PROFESSION WORLD WIDE

Introduction of FICPI CET (Work & Study Group)

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Session 1: Virtual Designs

Moderator

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Robert was President of FICPI-UK from 2011 to 2015 and is currently Vice-President of FICPI's Work and Study Commission (CET) in which capacities he has met with the European Commission, EPO, EUIPO, WIPO and other patent offices.

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Coleen is the President of FICPI's (International Federation of Intellectual Property Attorneys/Fédération Internationale des Conseils en Propriété Intellectuelle) Study and Work Commission (CET). She is also currently the President of FICPI Canada. Coleen is an INTA member and is the Vice -Chair of the Intellectual Property Institute of Canada's (IPIC) Trademark Committee. She is a member of the Canadian Bar Association and the Law Society of Ontario as well.

Background

- Virtual Reality (VR) and Augmented Reality (AR) are two areas where technology is advancing rapidly
- Numerous creative “virtual designs” have been created in these areas
- These “virtual designs” and supporting technology can be used for work and/or entertainment purposes

Background

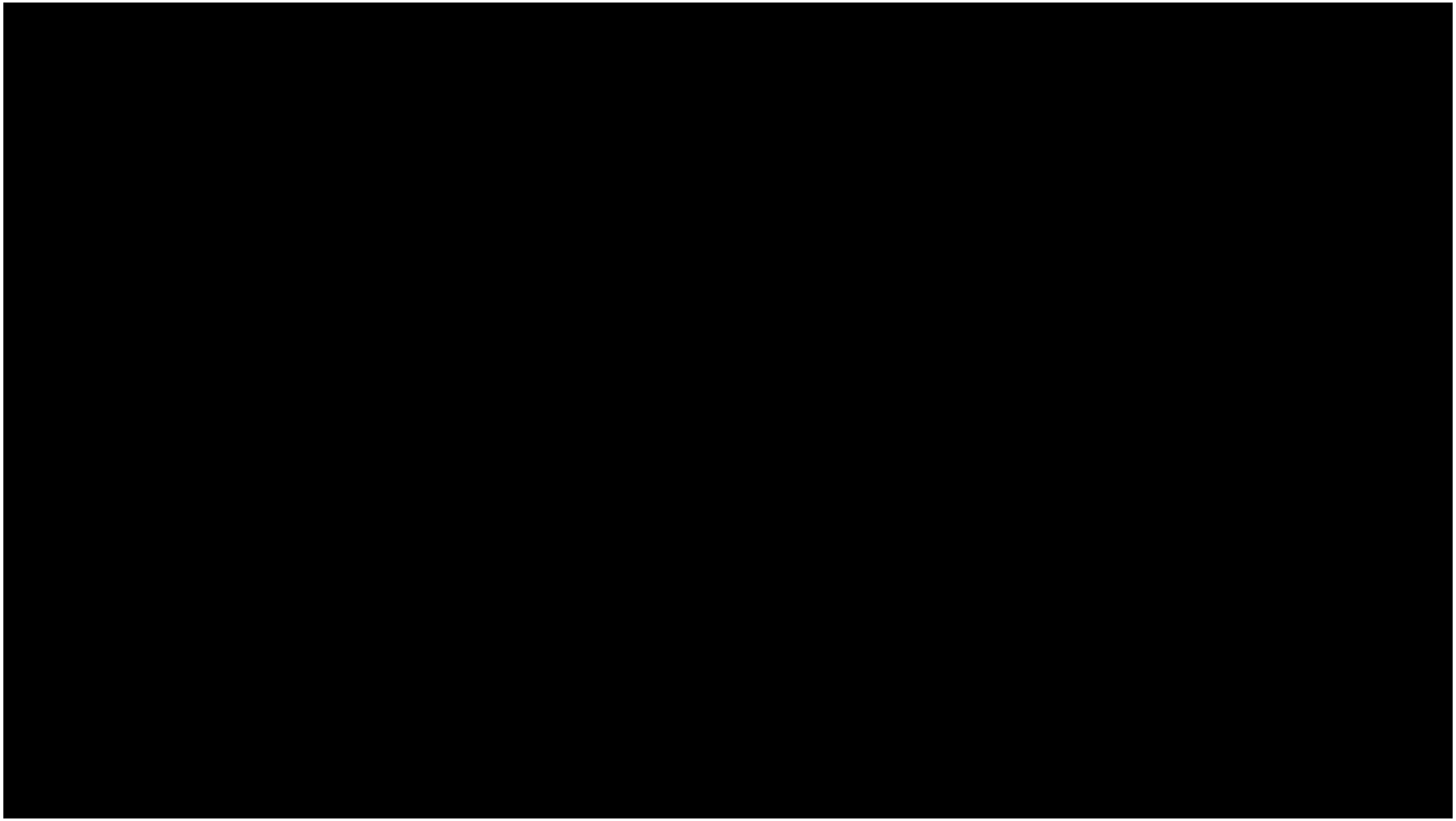
- Virtual Reality (VR) is an old technology dating back to 1960
- NASA amongst earliest developers
- First commercial tools 1980s
- Augmented reality has become commercial with the advance in technology of mobile phones
- Such “virtual designs” and supporting technology can be used for work and/or entertainment purposes

Virtual Reality

- “a three-dimensional, computer generated, environment which can be explored and interacted with”
- VR immerses individuals in a completely artificial, digitally-generated environment
- VR headsets or glasses are the most common method

Image by contributor Rido

Virtual Reality Demo



Virtual Reality

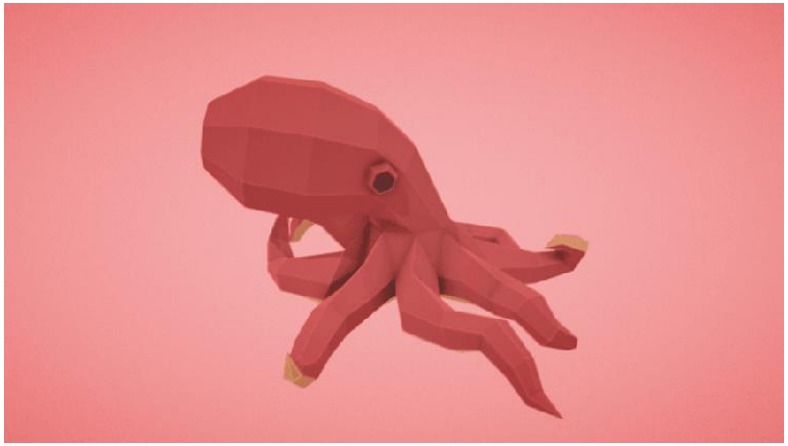
- Varjos HMD used together with Lockhead Martin's Prepar3D™ simulation software enables pilots to train in human-eye resolution VR

- Stamford's Virtual Reality operating theatre combines MRI/CT Scans with VR system to allow surgeons to practice before actual surgery

Virtual Reality

- Prado Museum website gives immersive experience of navigating the museum's galleries

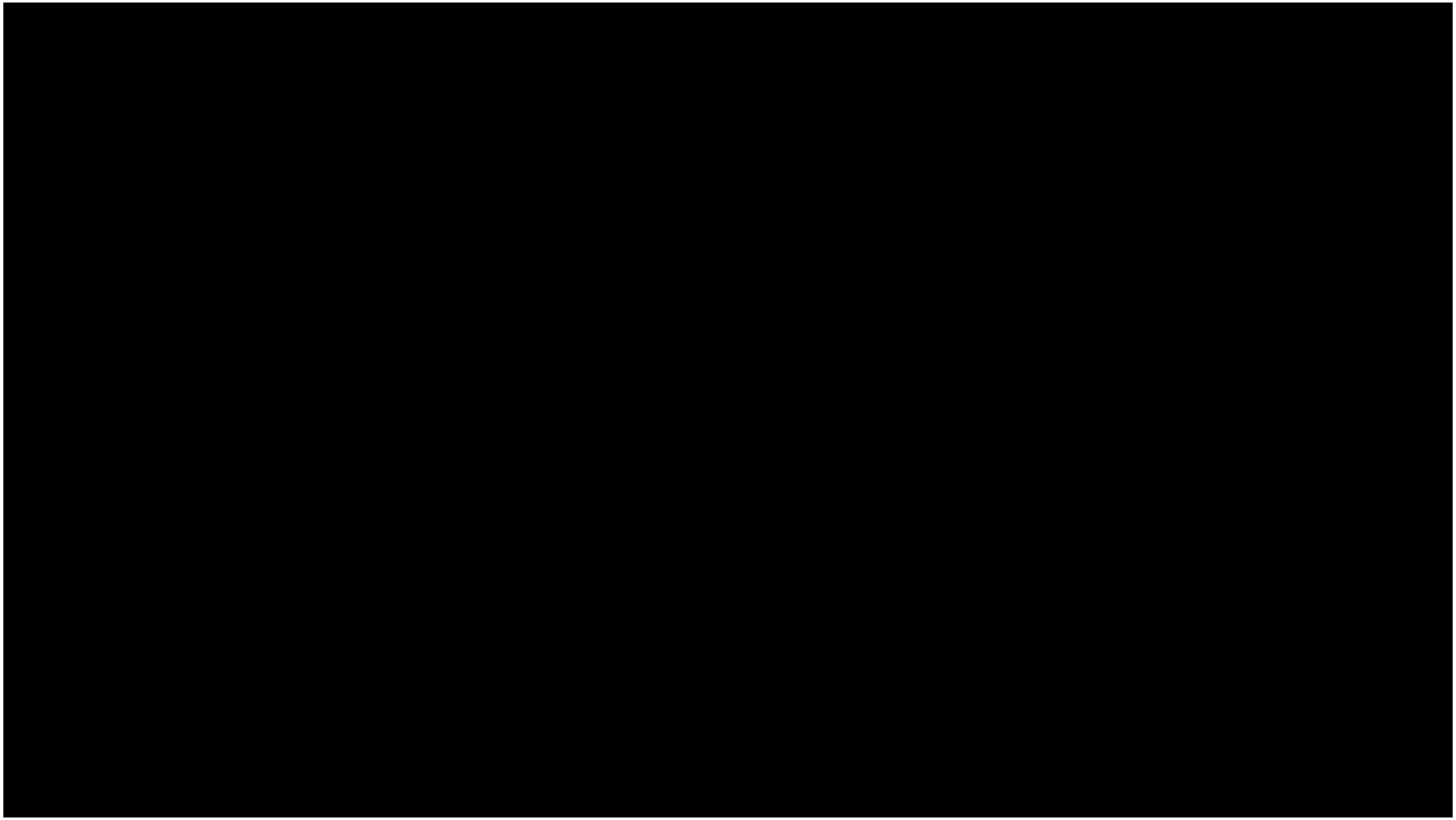
- Poly is Google's recent experiment with creating a digital library of 3D objects



Augmented Reality

- “an interactive experience of a real-world environment whereby the objects that reside in the real-world are *augmented* by computer-generated perceptual information”
- AR overlays digital objects onto the real-world environment
- Mobile phones are the most common method

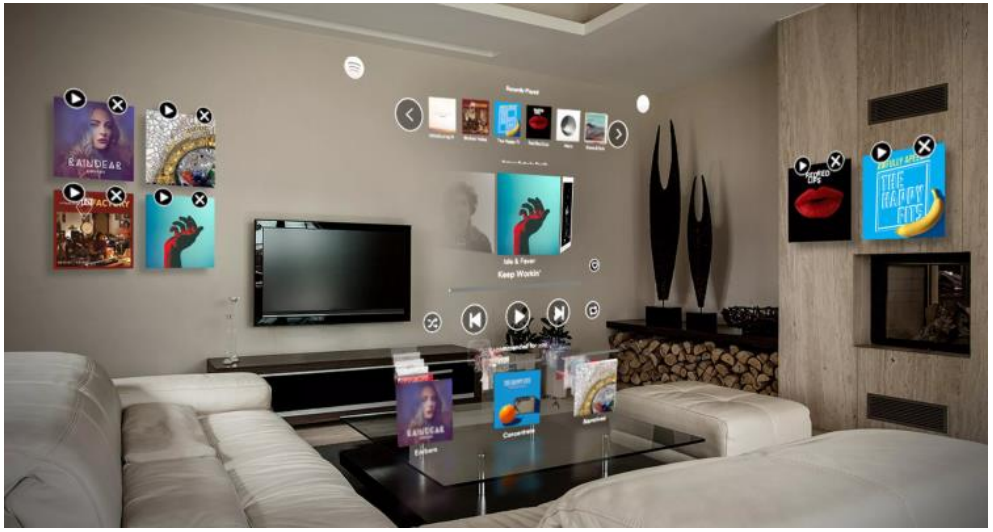
Augmented Reality Demo



Augmented Reality

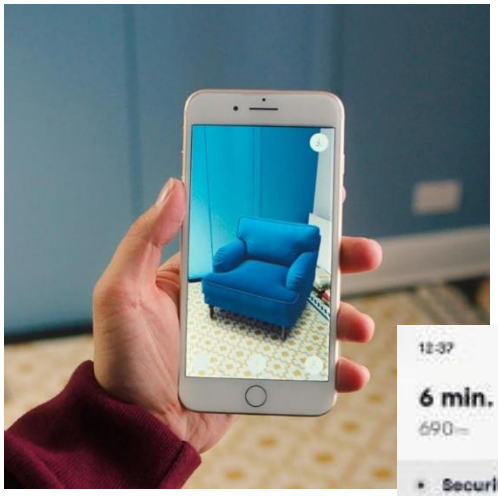
- Pokémon GO
  - Starbucks became Poké Stops or gyms merging real and virtual worlds
  - Frappicino integration
  - Not on menu, tap on Starbucks in game
- Magic Leap + Spotify

allows you to hang your album covers



Augmented Reality

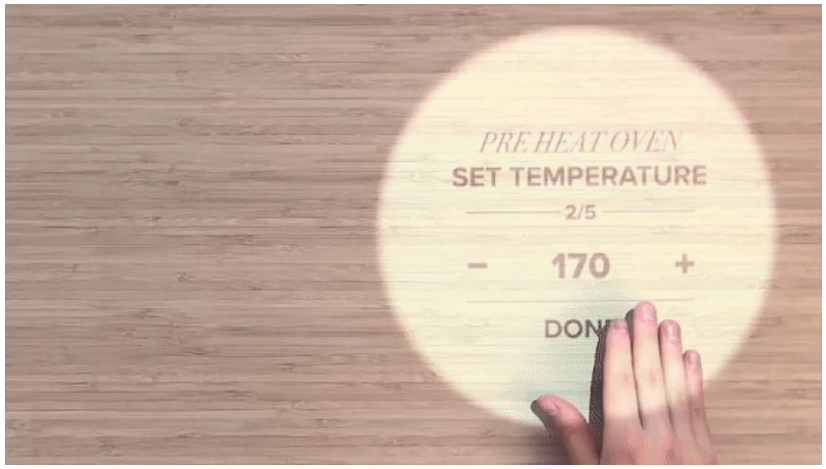
- Ikea Place app allows customers to preview more than 2,000 products



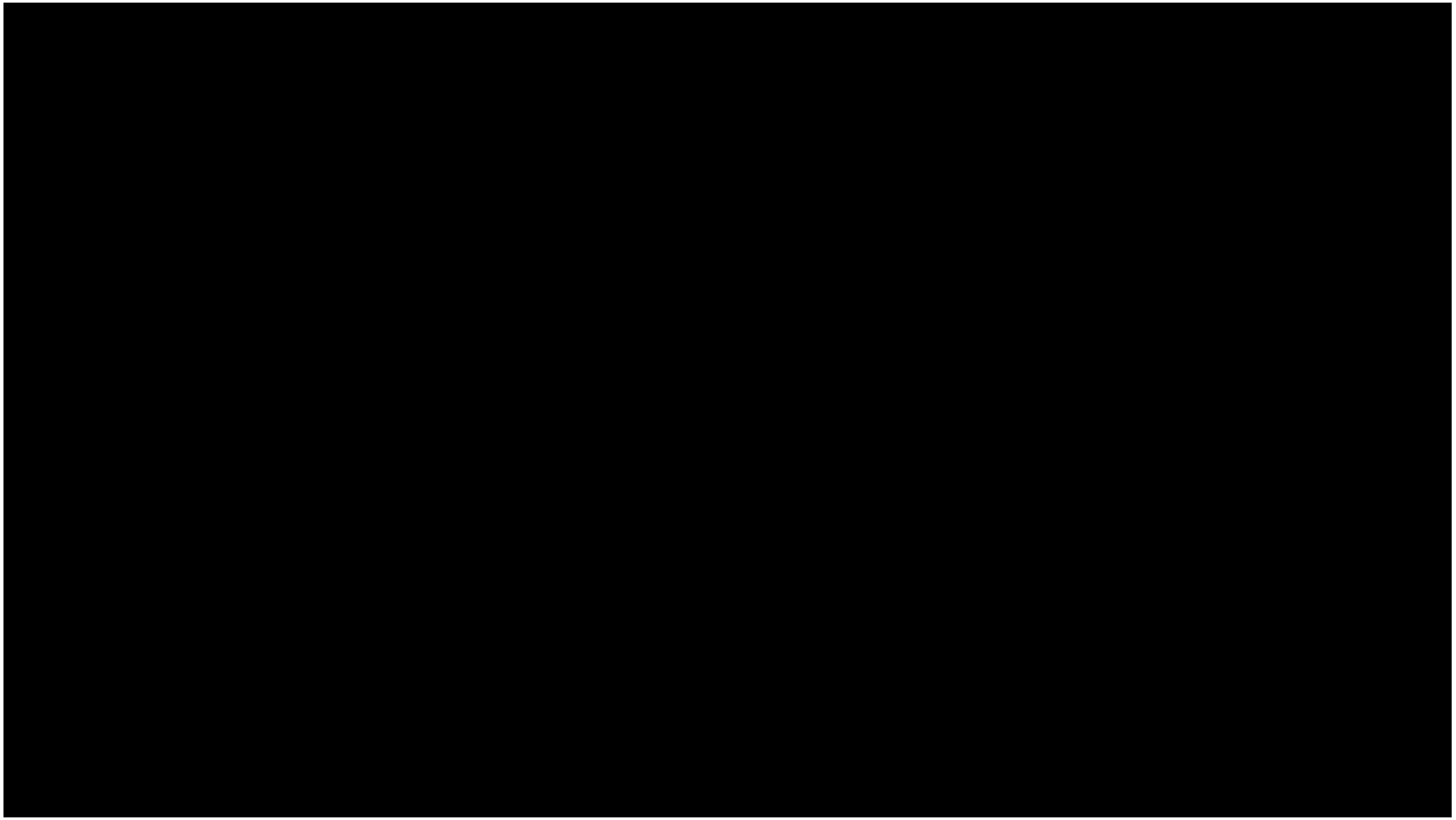
- Platform helps travellers to quickly pinpoint their route through airports

Projected Designs

- “a design is projected onto a supporting surface, possibly for interaction”
- Can either be smart or dumb, depending on the application
- Requires projection lamp

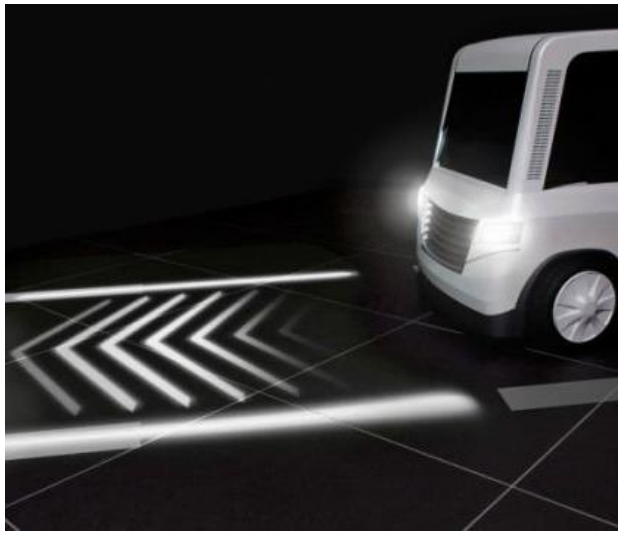


Projected Design demo



Projected Designs

- Mitsubishi have developed a indicator system that projects the path of the car onto the road



- A number of projected keyboards are now available (see here)

How can these be protected?

- Design laws can be broadly classified as:
  - Requiring the design to be applied to a product/article of manufacture
  - Not requiring this, by virtue of allowing protection of icons or defining product broadly to include ‘graphic symbols’
- The first category make it difficult to protect ‘non-applied’ designs
- The second category seems to make protection possible (but not clear)

How can these be protected?

- Most frequent jurisdictions where patent protection for VR is sought:
  - US (by a wide margin)
  - EU, also Korea
- Huge increase in VR/AR applications in last 5 years
  - 2013 ~10,000
  - 2018 > 30,000
- **Microsoft, Intel, Sony**, Samsung, Google, IBM, Canon, Qualcomm
- USPTO continues to grant design patents for 3D virtual works
- Federal Circuit has signaled that the contrary view

Design Patents US - Basics

- "Design for an article of manufacture"
  - 35U.S.C. §171(a)
  - *In Re Zahn* 617 F.2d 261, 268 (CCPA 1980) said the word "therefore" in the phrase "may obtain a patent therefore" refers back to design not article of manufacture
- Design patents protect aesthetic appearance
  - MPEP§ 1502.01
- Solid lines = actual ornamental aspects, dashed lines show environment that is not part of claim
- Need to be
  - Novel
  - Not obvious
  - Ornamental
  - Article of manufacture

Requirements for US Protection

- §171 designs analogous to § 101 for utility
- No requirement to be useful but a requirement to be novel and original
- Ornamentation requirement
  - "a design must present an aesthetically pleasing appearance that is not dictated by function alone"

    Bonito Boats Inc. v. Thunder Craft Boats, Inc. 489 US 141 (1989)
- Article of Manufacture is the issue for AR/VR

US Article of Manufacture

- In re Hruby 373 F.2d 997 (C.C.P.A 1967) Court interpreted the scope of “article of manufacture” to include the ornamental display of a fountain after the Examiner and Board rejected
- Rejected notion that something made of “fleeting” or “ephemeral” particles could not be protected
- Water particles were like molecules
- in all articles
- Rejected finding that water sprays
- Could not be articles of manufacture
- Because they did not “exist of themselves”

Early Analogies

- Icons and computer generated graphics were the first modern day test of Hrudy principles
- USPTO granted design patents to Xerox for extremely simple icon designs in early 80's
- Feedback generally positive but then USPTO began rejecting
- Xerox challenged refusal of "a design for a[n] Information Icon for Display Screen of a Programmed Computer System
    - Ex parte Strijland No 92-0623 26 USPQ 2d (BNA)

Early Analogies - Icons

- Xerox argued the computer as the article of manufacture
- Examiner rejected because applicant did not include a depiction or description of the computer in the application.
- Board said merely presenting a picture on a computer display does not constitute a protectable design
- Next effort by applicants was to reference Hruby and argue dependency, ephemeral nature and permanence did not preclude protection as a design
- Board rejected on basis icon was surface ornamentation (not “applied” like fountain) and ornamentation must be applied to article of manufacture
- USPTO then changed tack again and started accepting icons for protection publishing interim guidelines and examining

Early Analogies - Icons

- USPTO required solid lines around icon to represent the computer display thereby meeting AoM requirement
- 1996 Finalized Practice allowed solid or dashed
- Federal Circuit has not heard a case on scope of protection for icons

?

Analogies - Utility Patents

- Subject matter construed “manufacture” broadly by SCC in *Chakrabarty*
  - 447 U.S 303 (1980)
- But more narrowly in *Nuitjen*
  - Watermarked signal not “a manufacture” (dissent included issue of contradictory approach for these cases)
    - 500 F. 3d 1346 Fed. Cir. 2007
- Court dealt with *Hrudy* as a precedent by limiting findings to §101 not §171

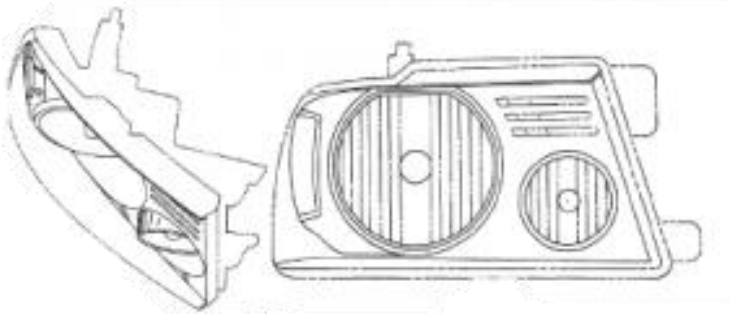
Utility Patents - Article

- ClearCorrect
  - involved jurisdiction of U.S. International Trade Commission
  - Considered meaning of “article” to see if ITC had jurisdiction
  - Three dimensional digital models of teeth aligners
  - Clear Correct took scan, sent 3-D models to Pakistan where incremental positioning scheme was developed and 3-D models sent back where printed and used on teeth
  - Unfair acts involving the importation of “articles” was question before ITC.
  - ITC found digital data was “article”

Analogies – “Articles”

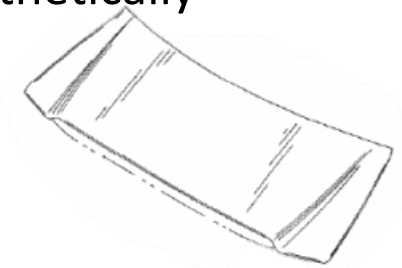
- Fed Cir. Reversed saying “articles” extends only to “material things” and does not extend to 3-D digital models
- Dissent held:
  - findings conflicts with SCC rulings, Fed. Cir. etc.
  - Law had to evolve for digital age
  - Meant to apply to all patented technologies including digital
  - Rejected tangible limitation on articles

Utility vs. Design Patent?



- Same rules apply to design patents as utility patents look to utility patent law not trade dress
- Design Patent law prohibits protection for primarily functional designs
  - if feature essential to use can't be protected*
- ABPA argued that protection should be prohibited because the design was aesthetically functional
- Court aesthetic appeal is not functional
- *Automotive Body Parts Ass'n v. Ford Global Techs., LLC*, Case No. 2018-1613 (Fed. Cir. July 23, 2019). Spare parts for hoods and headlights
- ABPA argued there is a functional benefit to designs that are aesthetically compatible with [consumer's] vehicles

**L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)



How can these be protected?

- Singapore is leading the way by broadening registrable designs to include “features of design applied to a non-physical product”
  - Defined to include virtual or projected designs
- Japan has recently expanded the definition of designs to include digital images (not necessarily recorded on articles, but displayed outside an article) (projected designs)

How can these be protected?

- The ID5 has studied “protection of new technological designs”

In particular, considering changes to products and services and the new uses of industrial designs brought about by the Fourth Industrial Revolution, the Partners intend to enhance their efforts to effectively protect industrial designs, noting user interest and input.

– ID5 Joint Statement, November 2018

How can these be protected?

- EU defines a design as:
  - the appearance of the whole or a part of a **product** resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation
- And product as:
  - any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, **graphic symbols** and typographic typefaces, but excluding computer programs;

How can these be protected?

- Falls into the second category, i.e. not clear
- Possible to protect graphic symbols, but does this include “3-dimensional symbols”
- Lots of GUIs registered:
- Hard to find any virtual/ augmented reality designs

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How about elsewhere?

FICPI's study

- A study of this topic was carried out within the Design Group to which every member responded (representing 23 jurisdictions)

- This lead to a Resolution which was submitted to and approved by FICPI's Executive Committee in March 2019

FICPI's Resolution

- **Noting** the well-established value of Industrial Design in both domestic and global markets, and the increasing commercial importance of Virtual Designs, such as projected designs and designs in virtual and augmented realities,

- **Recognising** that significant investment goes into creating such designs,

FICPI's Resolution

- **Further recognising** some jurisdictions require that a design be embodied in or applied to an article of manufacture for registration and/or enforcement in a way that means Virtual Designs are not registerable and/or not enforceable,

FICPI's Resolution

- **Also recognising** some jurisdictions already allow the registration and enforcement of Virtual Designs without such a requirement,

- **Believing** that the definition of an Industrial Design should not be overly restrictive and should reflect advances in technology and commerce,

FICPI's Resolution

- **Urges** jurisdictions to allow for the registration and enforcement of Virtual Designs.

What next?

- This resolution is being used in submissions and in our meetings with IP Offices
- For example, we included this in our submission to the EU Commission for their review of EU Design Law and mentioned in our meeting with DG Grow last Monday
- On the agenda for meetings with other IP offices next week

Other IP?

- Trademark – use in commerce?
  - Pokemon Starbucks
  - Buying clothing/accessories in VR world?
  - City of Heroes case
  - Court rejected Marvel's claim that NCSoft's providing tools to design Wolverine, Spiderman or Captain America costumes was not infringement bc no use in commerce.
- Distinctiveness
- Deceptiveness
- Tarnishing dilution? Like product placement?
- Damages? Superimposition of AR on real buildings in Pokémon Go but what is the damage.
- Like 3-D printing licensing might be a way to ensure owners have measure of control

Other IP?

Audience tes

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