



October 25, 2024

Katherine Vidal
Under Secretary of Commerce for Intellectual Property
Director of the U.S. Patent and Trademark Office
Madison West Building
600 Dulany Street
Alexandria, Virginia 22313
Via email: kathi.vidal@uspto.gov

Re: Article 3 of the Basic Proposal For The Design Law Treaty (DLT), as it relates to US obligations to disclose federal funding and rights in inventions.

Dear Director Katherine Vidal,

I am writing to register a specific concern about the World Intellectual Property Organization (WIPO) Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT), to be held in Riyadh from November 11 to 22, 2024. This concern relates to Article 3 of the May 10, 2024 version of the "Basic Proposal For The Design Law Treaty" (DLT), identified by WIPO as DLT/DC/3. https://www.wipo.int/edocs/mdocs/sct/en/dlt_dc/dlt_dc_3.pdf

Article 3 of the proposed treaty is, as I understand the text, a closed list of information that a member state can require in an application for a design patent. I believe this follows the approach of the WIPO Trademark Law Treaty, which is also a closed list, but not the Patent Law Treaty, which is an open list.

Upon reviewing Article 3 of the draft treaty, and the related regulations to the treaty, it seems to be inconsistent with US law, as regards the US requirement that applicants disclose federal funding of inventions.

The Bayh-Dole Act, when enacted in 1980, applied to funding agreements involving "any person, small business firm, or nonprofit organization that is a party to a funding agreement," and through President Reagan its provisions were subsequently extended to firms of any size.

The relevant provision is 35 U.S.C. § 202(c)(6), which reads as follows:

35 U.S.C. §202. Disposition of rights

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

...

(6) An obligation on the part of the contractor, in the event a United States patent application is filed by or on its behalf or by any assignee of the contractor, to include within the specification of such application and any patent issuing thereon, a statement specifying that the invention was made with Government support and that the Government has certain rights in the invention.

It is our understanding that the provisions of the Bayh-Dole Act apply to design patents.

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

...

The regulation for arrangement of application elements in a design application is **37 CFR § 1.154**, and it includes in (b)(3), a requirement for a “Statement regarding federally sponsored research or development.”

We have reviewed a number of USPTO granted design patents and found many instances of disclosures of federal funding, several of which are listed in the Annex attached to this letter.

When the U.S. government funds research and development that results in patented inventions, including for designs, it generally retains a worldwide royalty-free license, by or for the U.S. government, as well as the march-in right under 35 U.S.C. § 203, which can be described as a right that can be extended to benefit the public more broadly.

As you are aware, there has been considerable interest in design patents in recent years, and they are often used to seek injunctions and damages from firms offering products (or parts for those products) that infringe the designs, even in minor ways.

As illustrated in the Annex, the designs for which the federal government has rights are very diverse, including fields as diverse as solar panels, diagnostic devices, and drone batteries.

The United States could fix this problem by adding a category in Article 3 of the treaty to include disclosures of government funding, or far better, by clarifying that the treaty does not impose a

closed list of items that can be included in an application. Going forward, it can be quite difficult to anticipate how design patents will be used in the future, what their role will be with artificial intelligence changing the pace and nature of patent filings, uses and litigation, or other public policy issues that may arise.

KEI is also concerned with other elements of the draft treaty, including the provisions that seek to limit disclosures of licenses or economic terms in licenses (a topic relevant to the US disclosures of federal rights), and this will be addressed in a different letter.

KEI would appreciate the opportunity to discuss our concerns with your staff prior to the Diplomatic Conference in November.

Sincerely,



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ANNEX: Examples of US Design Patents with Government Funding and Rights Disclosed

Patent Number	Title	Funding Disclosure
USD1032623S1	Display screen with animated graphical user interface	This invention was made with U.S. Government support under Agreement No. W912CG20C0013, awarded by Defense Advanced Research Projects Agency. The Government has certain rights in the invention.
USD1031034S1	Inferior turbinate elevator	This invention was made with government support under grant number 5R25EB021894 awarded by The National Institutes of Health. The government has certain rights in the invention.
USD1022185S1	Medicament infusion pump device	This invention was made with U.S. Government support under Contract No. DK120234, awarded by the National Institutes of Health. The Government has certain rights in the invention.
USD993443S1	Microfluidic glass chip interface bracket	Microfluidic glass chip interface bracket

Patent Number	Title	Funding Disclosure
USD989342S1	Microfluidic polymer chip interface bracket	The invention was made with government support under Contract No. DE-AC05- 00OR22725 awarded by the U.S. Department of Energy. The government has certain rights in the invention.
USD973969S1	Helmet face shield	The invention described herein may be manufactured and used by or for the Government of the United States of America for governmental purposes without the payment of any royalties thereon or therefor.
USD971964S1	Display screen with an animated graphical user interface	This invention was made with government support under contract FA8649-19-9-9004 awarded by the United States Air Force. The government has certain rights in the invention.
USD971963S1	Display screen with an animated graphical user interface	This invention was made with government support under contract FA8649-19-9-9004 awarded by the United States Air Force. The government has certain rights in the invention.
USD961746S1	Lightweight portable heating device	This invention was made with government support under W911QY-18-9-0017 awarded by U.S. Department of the Army. The government has certain rights in the invention.
USD952553S1	Drone battery pack	The invention was made with Government support under Agreement No. W15QKN-19-9-0044 awarded by USACC-NJ. The Government has certain rights in the invention.
USD950061S1	Multi detector radiological source jig	The invention was made with government support under Contract No. DE-AC05-00OR22725 awarded by the U.S. Department of Energy. The government has certain rights in the invention.
USD946745S1	Filtered face mask	The invention described herein may be manufactured and used by or for the Government of the United States of America for governmental purposes without the payment of any royalties thereon or therefor.
USD946743S1	Filtered face mask respirator with cap	The invention described herein may be manufactured and use by or for the Government of the United States of America for governmental purposes without the payment of any royalties thereon or therefor.
USD945413S1	Device for training and instruction	This invention was made with government support under Contract No. W15QKN1930003 awarded by the U.S. Army Contracting Command. The government has certain rights in the invention
USD929431S1	Display screen or portion thereof with animated graphical user interface	This invention was made with government support under Contract No. W56HZV-07-C-0256 awarded by the United States Army. The United States Government has certain rights in the inventions.

Patent Number	Title	Funding Disclosure
USD928903S1	Muzzle brake	The invention described herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD928804S1	Display panel of a programmed computer system with a graphical user interface	This invention was made with government support under Award No. 1738479 awarded by National Science Foundation's Division of Industrial Innovation and Partnerships (IIP). The government has certain rights in the invention.
USD928803S1	Display panel of a programmed computer system with a graphical user interface	This invention was made with government support under Award No. 1738479 awarded by National Science Foundation's Division of Industrial Innovation and Partnerships (IIP). The government has certain rights in the invention.
USD928177S1	Display panel of a programmed computer system with a graphical user interface	The invention was made with government support under Award No. 1738479 awarded by National Science Foundation's Division of Industrial Innovation and Partnerships (IIP). The government has certain rights in the invention.
USD928069S1	Marine vehicle with top lens	The invention described herein may be manufactured and used by or for the Government of the United States of America for governmental purposes without the payment of any royalties thereon or therefor.
USD926662S1	Marine vehicle with lens	The invention described herein may be manufactured and used by or for the Government of the United States of America for governmental purposes without the payment of any royalties thereon or therefor.
USD914589S1	Solar panel	This invention was made with government support under DE-EE0007190 awarded by The U.S. Department of Energy. The government has certain rights in the invention.
USD912270S1	Sample holder	This invention was made with government support under grant number CA206937 awarded by the National Institutes of Health. The government has certain rights in the invention.
USD898859S1	Semiautonomous weapon mount	This invention was made with Government support under Contract No. W15QKN-14-9-1001, awarded by U.S. Department of Defense. The Government has certain rights in this invention.
USD892721S1	Tire	This invention was made with Government support under DE-EE0007761 awarded by DOE. The Government has certain rights in this invention.
USD891335S1	Windshield for a truck vehicle	This invention was made with U.S. Government support under DE-EE0003303 awarded by The U.S. Department of Energy. The

Patent Number	Title	Funding Disclosure
		U.S. Government has certain rights in this invention.
USD888269S1	Capillary blood collector device	This invention was made with government support under contract number HDTRA1-17-C-0011 awarded by the Defense Threat Reduction Agency and grant number W81XWH-17-1-0694 awarded by the U.S. Army Medical Research Acquisition Activity. The government has certain rights in the invention.
USD888267S1	Diagnostic instrument	This invention was made with government support under contract number HDTRA1-17-C-0011 awarded by the Defense Threat Reduction Agency and grant number W81XWH-17-1-0694 awarded by the U.S. Army Medical Research Acquisition Activity. The government has certain rights in the invention.
USD882503S1	Tire	This invention was made with Government support under DE-EE0007761 awarded by DOE. The Government has certain rights in this invention.
USD881202S1	Display screen with graphical user interface for negative pressure unit	This invention was made with government support under Contract FA8650-13-2-6372 awarded by the Department of the Air Force. The government has certain rights in the invention.
USD879544S1	Multipurpose solar drying tray assembly	This invention was made with government support under Contract No. AID-OAA-L-14-00003 awarded by the U.S. Agency for International Development. The government has certain rights in the invention.
USD877889S1	Negative pressure unit	This invention was made with government support under Contract FA8650-13-12-6372 awarded by the Department of the Air Force. The government has certain rights in the invention.
USD872842S1	Filter support	The invention described may be manufactured and used by or for the United States Government for government purposes without payment of any royalties.
USD860368S1	Muzzle brake	The invention described herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD860046S1	Gunner protection turret enclosure for multiple weapons integration	The invention described herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD859197S1	Marine sensor platform	This invention was made with government support under grant no. DE-AR0000514 awarded by the U.S. Department of Energy (ARPA-E). The government may have certain rights in the invention.

Patent Number	Title	Funding Disclosure
USD853939S1	Aerial vehicle	This invention was made with government support under grant no. DTOS59-06-G-00047 awarded by the Department of Transportation. The government has certain rights in the invention.
USD849597S1	Gunner protection turret enclosure with adjustable forward gun shield and vehicle adapter plate	The invention described herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD822036S1	Display screen or portion thereof with graphical user interface	This invention was made with government support under HD051495 awarded by the National Institutes of Health. The government has certain rights in the invention.
USD821319S1	Rotor for a wave energy converter	This invention was made with government support under 1263196 awarded by the National Science Foundation. The government has certain rights in the invention.
USD815235S1	Magazine loader assembly	The invention described herein may be manufactured, used, and licensed by or for the U.S. Government for US. Government purposes.
USD814672S1	Headlight for a truck vehicle	This invention was made with U.S. Government support under DE-EE0003303 awarded by The U.S. Department of Energy. The U.S. Government has certain rights in this invention.
USD805503S1	Antenna Radome	This invention was made with Government support under contract No. 14-G-1169 awarded by the Department of Defense. The government has certain rights in this invention.
USD804479S1	Card reader enclosure	This invention was made with government support under N00019-15-C-0091 awarded by United States Navy. The government has certain rights in the invention.
USD804478S1	Card reader enclosure	This invention was made with government support under N00019-15-C-0091 awarded by United States Navy. The government has certain rights in the invention.
USD802680S1	Game tile	This invention was made with Government support under Award No. 1346821 awarded by the Small Business Innovation Research (SBIR) Program of the National Science Foundation (NSF). The Government has certain rights in the invention.
USD786722S1	Explosive detection package	The inventions described herein may be manufactured and used by or for the United States Government for government purposes without payment of any royalties.
USD786131S1	Vehicle gunner	The inventions described herein may be manufactured and used by

Patent Number	Title	Funding Disclosure
	protection turret	or for the United States Government for government purposes without payment of any royalties.
USD776003S1	Light tactical vehicle hull	The invention described here may be made, used and licensed by and for the U.S. government for governmental purposes without paying royalty to us.
USD773681S1	Infant warming pad	The invention described and claimed herein was made in part utilizing funds supplied by the U.S. Department of Energy under Contract No. DE-AC02-05CH11231. The government has certain rights in this invention.
USD772344S1	Game tile	This invention was made with Government support under Award No. 1346821 awarded by the Small Business Innovation Research (SBIR) Program of the National Science Foundation (NSF). The Government has certain rights in the invention.
USD759803S1	Adjustable headpiece with anatomical markers	This invention was made with government support under 5R44NS080632 awarded by the National Institute of Neurological Disorders and Stroke (NINDS) of the National Institute of Health (NIH). The government has certain rights in the invention.
USD754871S1	Microscope slide-in chamber	This invention was made with government support under Contract No. DE-AC05-00OR22725 awarded by the U.S. Department of Energy. The government has certain rights in the invention.
USD754276S1	Ammunition rack	The invention described here may be made, used and licensed by and for the U.S. Government for U.S. Governmental purposes
USD753662S1	Universal serial bus (USB) plug system	This invention was supported by the National Institute of Health, Grant No. R121-CA-120128, and the National Science Foundation, Grant No. BES-03-48204. The United States Government has certain rights in the invention.
USD751947S1	Vehicle mounted gunner protective enclosure	The invention described and claimed herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD743169S1	Container with offset handle	The invention described and claimed herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD738416S1	Spotting telescope alignment lock	The invention described here may be made, used and licensed by and for the U.S. Government for U.S. Governmental purposes.
USD734482S1	Microfluidic analysis cartridge	The present invention was supported in part by grant number IIP-1058590 from the National Science Foundation. The U.S. Government has certain rights in the invention.
USD730216S1	Portable analytical instrument	This invention was made with government support under Contract Number N00174-13-C-0032, Contract Name: Naval Explosive Ordnance Disposal Technology Division (NAVEODTECHDIV), task

Patent Number	Title	Funding Disclosure
		Order TI 69. The government has certain rights in this invention.
USD729293S1	Three-dimensional display device	This invention was made with government support under Contract No. DE-AC05-00OR22725 awarded by the U.S. Department of Energy. The government has certain rights in the invention.
USD728400S1	Portable analytical instrument	This invention was made with government support under Contract Number N00174-13- C-0032, Contract Name: Naval Explosive Ordnance Disposal Technology Division (NAVEODTECHDIV), task Order TI 69. The government has certain rights in this invention.
USD697529S1	Portion of a display screen with an icon	Application Ser. No. 709,080 (now U.S. Pat. No. 3,433,705) was filed, prosecuted, issued and assigned to the U.S. Government by the Applicant/Inventor's Representative in this case for the benefit of the Government, and under federally sponsored research as a Registered patent attorney under Registration No. 19,240
USD693897S1	Small arms transmitter mounting bracket for a multiple integrated laser engagement system	The invention described and claimed herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD683464S1	Leg brace	This invention was made with government support under Grant No. R44-HD055019 awarded by the National Institute of Health. The government has certain rights in the invention.
USD680403S1	Handle for a tool	This invention was made with government support under Award No. 2009-33610-19668 awarded by the National Institute of Food & Agriculture. The government has certain rights in the invention.
USD677418S1	Ceiling mounted luminaire	This invention was made with U.S. Government support under DOE Cooperative Agreement No. DE-EE0003241, awarded by the U.S. Department of Energy. The U.S. Government may have certain rights in this invention.
USD672518S1	Bore swabbing tool	The invention described and claimed herein may be manufactured, used and licensed by or for the U.S. Government for U.S. Government purposes.
USD669171S1	Tongue retractor	This invention was made with government support under Grant No. W81XWH-06-10019 awarded by the Department of Defense. The federal government has certain rights in the invention.
USD664414S1	Force arm cutting and prying blade	This invention was made with government support under contract. The government has certain rights in the invention.
USD664170S1	Cleaning plate for inducing	This invention was made with Government support under DE-EE0003331 awarded by DOE. The Government has certain

Patent Number	Title	Funding Disclosure
	turbulent flow of a processing chamber cleaning glass	rights in this invention.
USD663026S1	Visualization instrument	This invention was made with government support under Award W81XWH-06-1-0019 awarded by the U.S. Army. The government has certain rights in the invention
USD659220S1	Rail sight mount	The invention described and claimed herein may be manufactured, used and licensed by or for the U.S. Government for U.S. Government purposes.
USD657499S1	Earplug	This invention was made with Government support under SBIR contract N68335-09-C-0003, awarded by the US Navy. The government has certain rights in the invention.
USD655273S1	Earcup for a headset	This invention was made with Government support under SBIR contract N68335-09-C-0003, awarded by the US Navy. The government has certain rights in the invention.
USD650319S1	Apparatus for mechanically guiding a water vehicle that is being released or retrieved	The present invention was made with Government support under STTR Program Contract No. N07-037 awarded by the United States Navy. The Government has certain rights in the invention.
USD649924S1	Buoyancy engine module for an unmanned underwater vehicle	The present invention was made with Government support under Contract Nos. STTR N08-T016 and N00014-09-C-0527 awarded by the United States Navy. The Government has certain rights in the invention.
USD638946S1	Prostate mechanical imaging probe	This invention was made with government support under SBIR grant R44CA082620 awarded by National Cancer Institute, National Institutes of Health. The government has certain rights in the invention.
USD638088S1	Adaptor for rifle fired bullet trap grenades	The invention described and claimed herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD631310S1	Multifunction tool	The invention described here may be made, used and licensed by and for the U.S. Government for governmental purposes without paying royalty to us.
USD626118S1	Bidirectional tilt antenna mount	The invention described here may be made, used and licensed by and for the U.S. Government for governmental purposes without paying royalty to me.
USD624150S1	Artillery	The invention described and claimed herein may be manufactured,

Patent Number	Title	Funding Disclosure
	projectile extractor	used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD620067S1	Firearm buttstock	The invention described herein may be made or used by or for the U.S. Government for U.S. Government purposes.
USD619044S1	Gunner enclosure with overhead cover	The invention described and claimed herein may be manufactured, used, and licensed by or for the U.S. Government for U.S. Government purposes.
USD612045S1	Colonoscope handgrip assembly with force and torque monitor	This invention was made with government support under SBIR grant R44DK068936 awarded by the National Institute of Diabetes and Digestive and Kidney Diseases, National Institutes of Health. The government has certain rights in the invention.
USD611461S1	Antenna mount actuator adapter	The invention described here may be made, used and licensed by and for the U.S. Government for governmental purposes without paying royalty to us.
USD609801S1	Calibration chamber for prostate mechanical imaging probe	This invention was made with government support under SBIR grant R44CA082620 awarded by National Cancer Institute, National Institutes of Health. The government has certain rights in the invention.
USD609770S1	Rail mounting apparatus	The invention described and claimed herein may be manufactured, used and licensed by or for the U.S. Government for U.S. Government purposes.
USD607565S1	Visor for a visual prosthesis	This invention was made with government support under grant No. R24EY12893-01 awarded by the National Institutes of Health. The government has certain rights in the invention.
USD606910S1	Prone cart	This invention was made with the support of the Department of Veterans Affairs, Government of the United States under a merit review grant to the Milwaukee and Tampa Veterans Affairs Medical Centers. The Government retains certain rights in the invention.
USD604531S1	Coin display and business-card holder	The ornamental design described herein may be manufactured and used by or for the Government of the United States for all governmental purposes without the payment of any royalty.
USD600440S1	Traveling case	This invention was made with government support under grant No. R24EY12893-01 awarded by the National Institutes of Health. The government has certain rights in the invention.
USD599313S1	Video processing unit for a visual prosthetic apparatus	This invention was made with government support under grant No. R24EY12893-01 awarded by the National Institutes of Health. The government has certain rights in the invention.

Patent Number	Title	Funding Disclosure
USD590767S1	Portable fuel cell system with removable power adaptor	This invention was made with Government support under Contract No. H94003-07-C-0711 awarded by the Defense Microelectronics Activity. The Government has certain rights in the invention.
USD588856S1	Bicyclist's water bottle with bottom drinking valve	The invention described herein may be manufactured and used by or for the Government of the United States of America for governmental purposes without the payment of any royalty thereon.
USD581988S1	Hand-held device	The invention was made with government support under government contract DAAH01-01-C-R003 awarded by DARPA via Army Aviation & Missile Command, Redstone Arsenal. The United States Government has certain rights in the invention.
USD575381S1	Condenser shroud for DC cooler	This invention was made with Government support under contract DE-FC26- 04NT42106, awarded by the United State Department of Energy. The Government may have certain rights in this invention.
USD568437S1	Firearm mount bracket	The invention described here may be made, used and licensed by and for the U.S. Government for governmental purposes without paying royalty to us.
USD565082S1	Visor for a visual prosthetic apparatus	This invention was made with government support under grant No. R24EY12893-01 awarded by the National Institutes of Health. The government has certain rights in the invention.
USD545721S1	Robot	The invention described herein may be manufactured and used by or for the government of the United States of America for governmental purposes without the payment of any royalties thereon or therefore.