

# U.S. Design Patent Protection



by the Oblon Spivak Industrial Design Practice Group

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# Industrial Design Practice

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- We recently consolidated our design practice to a select group of attorneys
  - Benefits - focuses our expertise, efficient client communication, reduced costs
  - Dedicated page on our [website](#) provides useful information regarding developments in designs



# Who is interested in designs?

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Design patents cover a ***broad range of technology***.

The USPTO's 2010 Design Patents Report lists the companies with the most design patents granted, as follows:

1. Sony	6. Motorola	11. Hon Hai	16. Dart
2. Samsung	7. Procter & Gamble	12. Honda	17. LG
3. Nike	8. Cannon	13. Microsoft	18. Wolverine
4. Matsushita	9. Black & Decker	14. Toshiba	19. Nokia
5. Goodyear	10. Sharp	15. Kohler	20. IBM



# Purpose of Presentation

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- Aim of this presentation is to enhance your understanding of U.S. design patents by explaining
  - advantages of design patents,
  - what is eligible for protection,
  - how the design is patented, and
  - what a design patent covers.



# I. Advantages

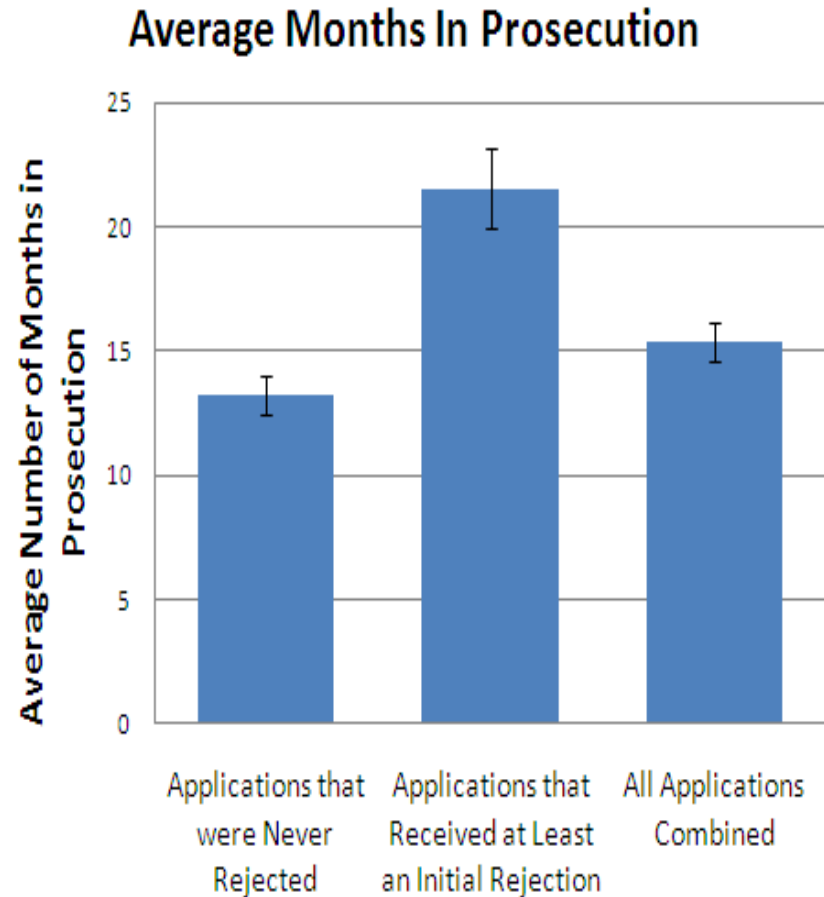
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- This presentation begins by summarizing some of the advantages provided by design patents



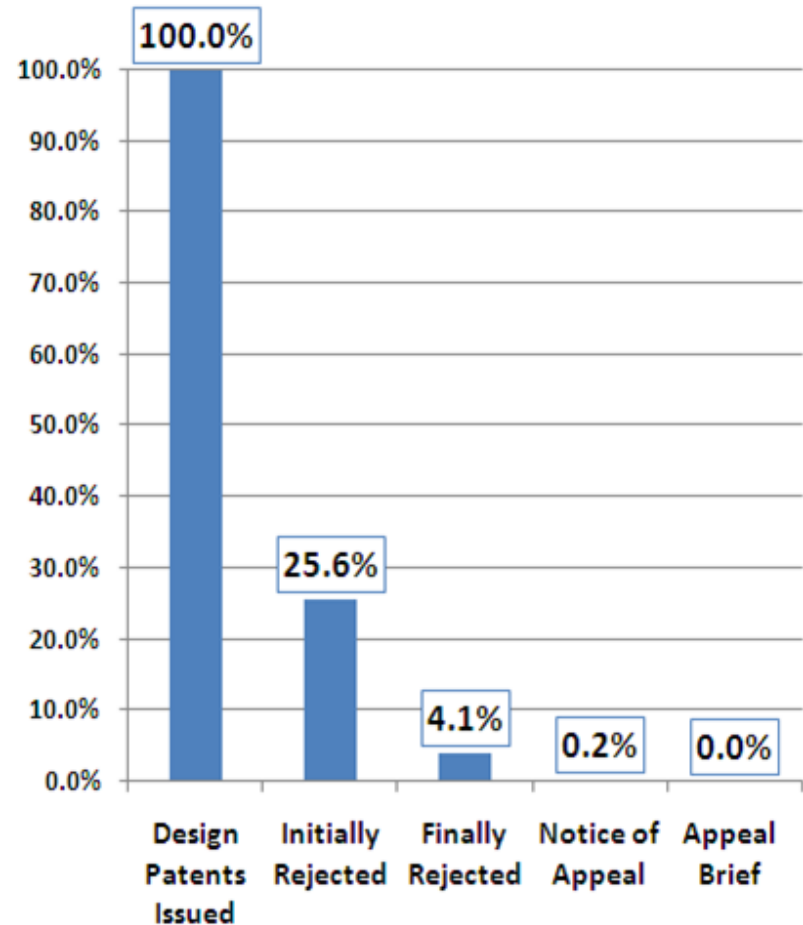
# Advantages in Filing a Design

- Shorter prosecution (typically 1-2 years)
  - Chart from Patently-O blog
- Significantly less expensive
  - Typically, less than half the cost of utility applications
- No maintenance fees



# Advantages in Filing a Design

- Higher allowance rate
  - Chart from Patently-O blog
- Patentee can sue infringer on both utility and design patent
- If utility patent is invalidated, design patent may survive



# Advantages in Filing a Design

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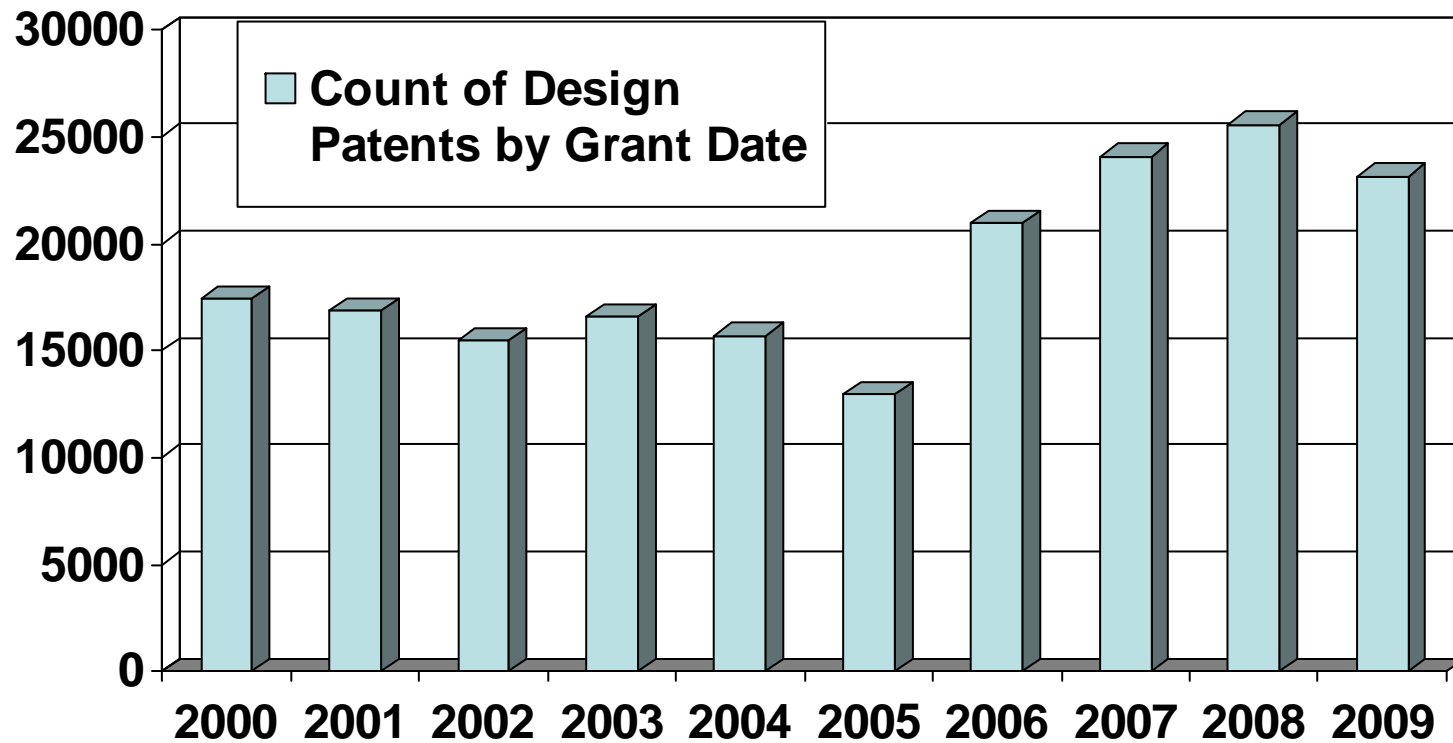
- Damages
  - Recovery of total profits available to design patentee
    - Not available for utility patent
    - Can be easier to prove
    - Cannot treble total profits
    - Cannot double recover by also getting lost profits or reasonable royalties





# U.S. Design Patents Granted

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## II. Design Application Protection

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- The second part of this presentation explains what subject matter is eligible for design patent protection in the U.S., provides some examples, and discusses additional differences from utility applications



# Review of Design Patents

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- 35 U.S.C. §171 - Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title



# Requirements

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- Thus, the requirements for design patentability are:
  1. Article of Manufacture
  2. Originality
  3. Novelty
  4. Non-Obviousness
  5. Ornamentality



# 1. Article of Manufacture

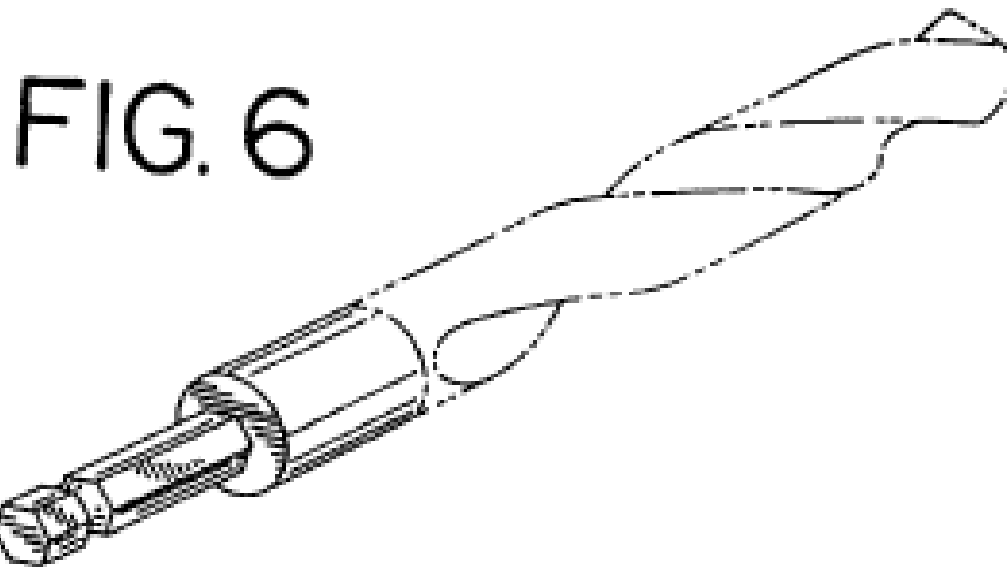
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- A tangible object made by man
  - Design must be embodied into, or applied to, a man-made tangible object
  - Cannot be a design or picture standing alone, i.e., in the abstract
  - Examples: pattern of water for a water fountain, computer screen icon

# 1. Article of Manufacture

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- Design can cover only a part of an article
  - Example: shank portion of a drill bit



## 2. Originality

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- Must be original; cannot be derived from another
- Thus, cannot patent any simulation of known objects, persons, or naturally occurring forms

# 3. Novelty

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- Must be "new" and satisfy the novelty and statutory bar provisions of 35 U.S.C. 102
  - 102(d) - 6 months to claim foreign priority
- Ordinary observer test: the overall appearance of the design in the eyes of an ordinary observer must not be substantially similar to the appearance of any other single prior art design





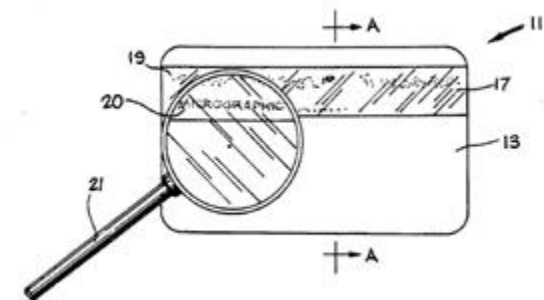
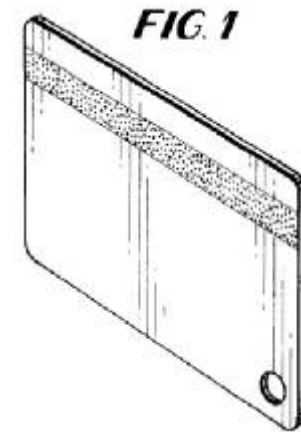
## 4. Non-Obviousness

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- A design patent may not be obtained for a novel design if the differences between the claimed design and the prior art are such that the claimed design as a whole would have been **obvious to an ordinary designer** of article of the type presented

# Obviousness for design patents

- Obviousness rejection of the '247 design patent (upper right) overturned by BPAI
- Prior art (lower right) did not have any apertures – secondary reference with apertures was relied on
- To be a primary reference, prior art must have basically the same design characteristics (i.e. create the same visual impression) as claimed design



# 5. Ornamentality

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- An ornamental feature is one which was created for the purpose of ornamenting (i.e. to enhance the appearance)
- Feature cannot be the result or merely a byproduct of function or mechanical considerations
- Often strongly related to the function of an article, but cannot be dictated by function alone



# 5. Ornamentality

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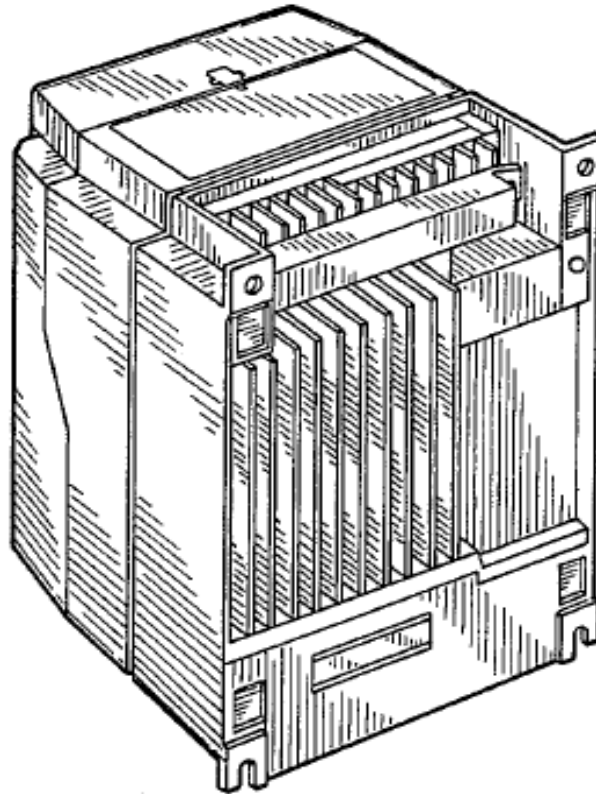
- Object can be hidden in use, but must be visible at some point between manufacture or assembly and ultimate use



FIG. 1

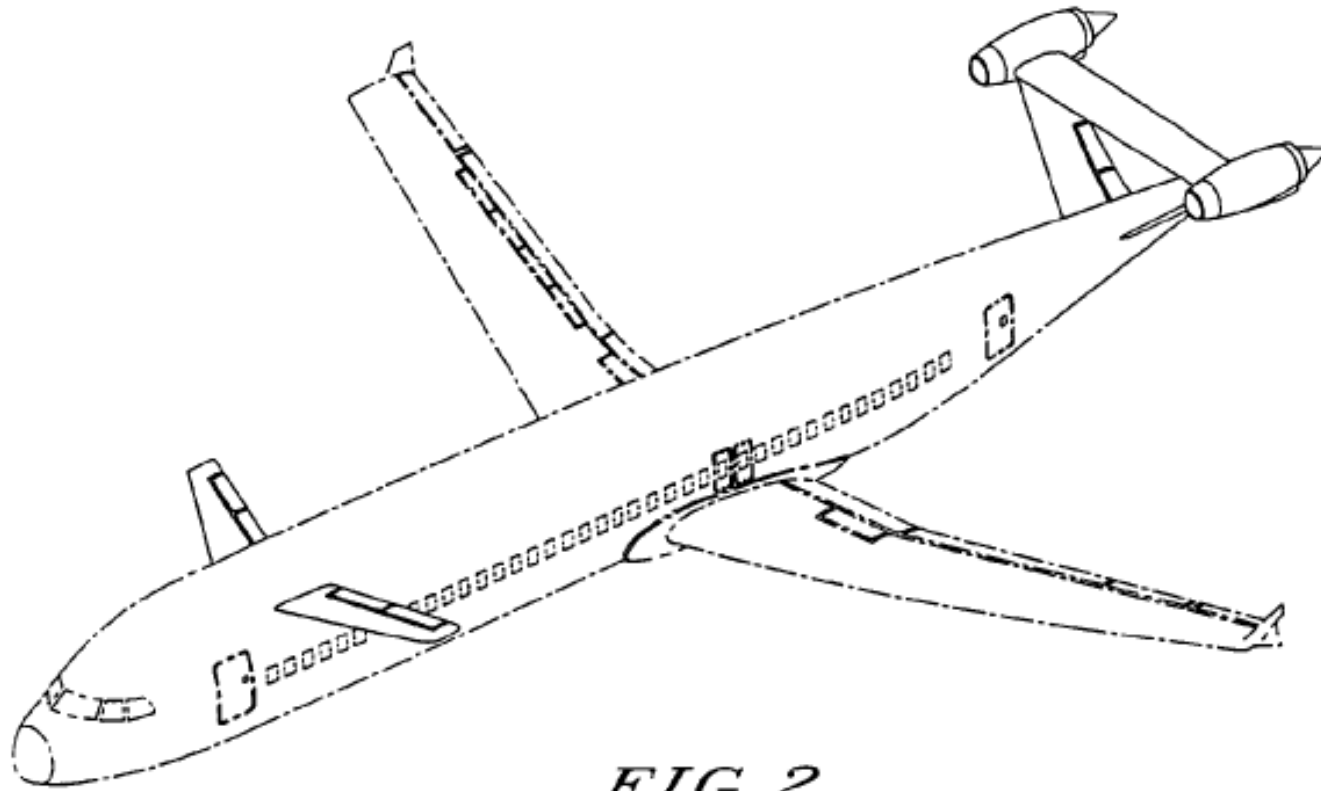
# Example: Power Supply – U.S. D298,824

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# Example: Plane – U.S. D566,031

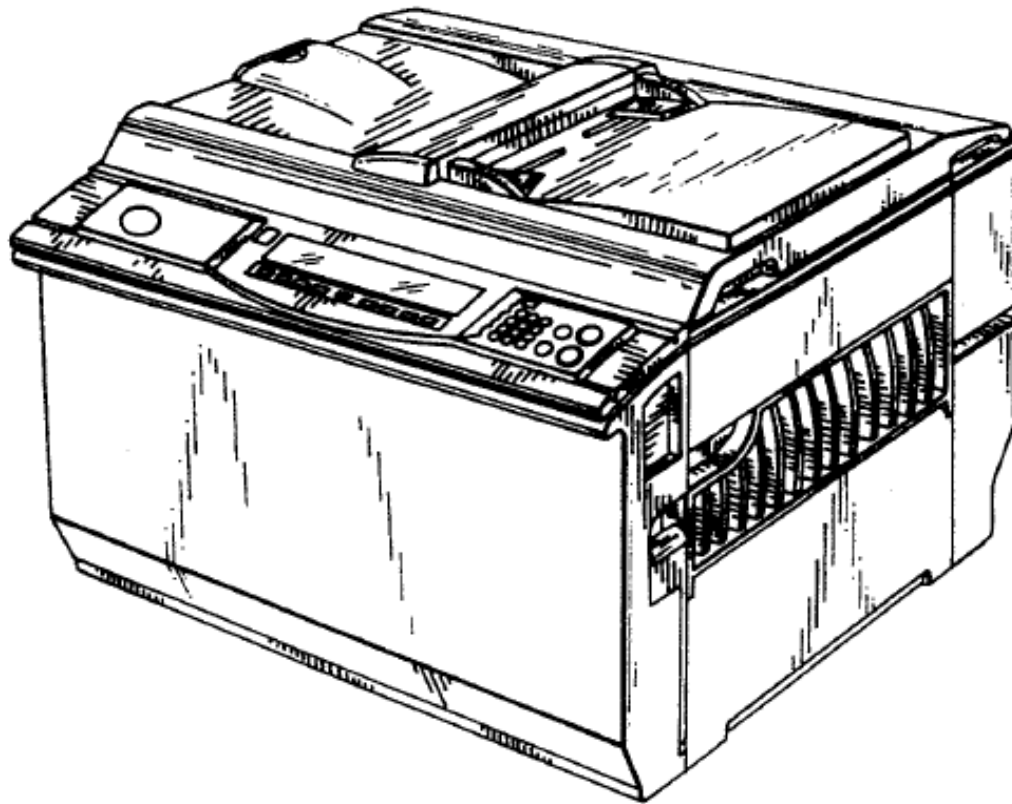
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*FIG. 2*

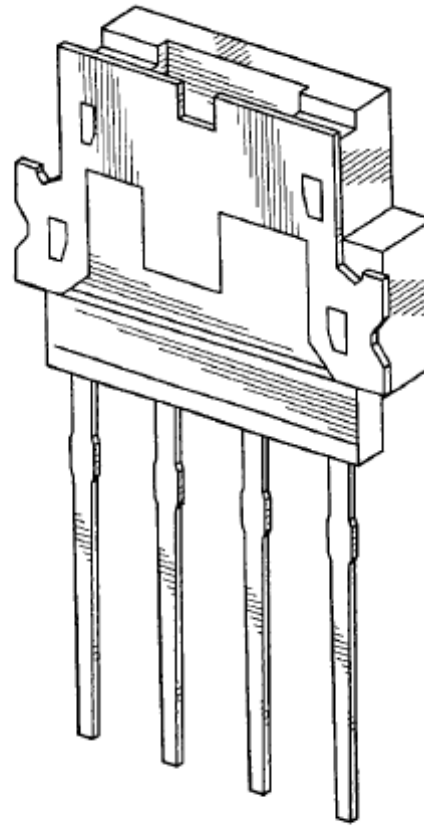
# Example: Printer - U.S. D350,978

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# Example: Semiconductor – U.S. D489,695

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*FIG. 1*



# Differences from Utility Patents

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- Not included in the PCT
- 14-year term from date of issue
- No maintenance fees required
- 6-month right of priority
- Cannot file an RCE, file a CPA instead
- Cannot claim priority to a provisional application



# III. The Design Application

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- The third part of this presentation discusses the application process before the United States Patent and Trademark Office

# Examination

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- Full examination on the merits
  - Not a registration system
- Many USPTO fees for design applications are reduced compared with utility
- Prosecution typically much quicker than utility applications
  - Avg. of 9 months to first action
  - Avg. of 15 months from filing to issue



# Elements of a Design Application

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- Specification
  - Preamble stating name of applicant, title of design, and brief description of nature and intended use of design
  - Brief description of drawings
- Single claim
  - Example: We claim: the new, original, and ornamental design for a [Title], as shown and described.



# Elements of a Design Application

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- Drawings
  - Most important element
    - Filing incorrect drawings can cause serious problems during prosecution
    - We highly recommend letting our skilled draftsmen prepare the drawings for filing
  - Need sufficient number of views to disclose the complete appearance of the design claimed
    - Typically: top, bottom, left side, right side, front, back, and perspective



# Elements of a Design Application

U.S. Patent Dec. 17, 2002 Sheet 1 of 3

US D467,389 U.S. Patent Dec. 17, 2002 Sheet 2 of 3

US D467,389 S

U.S. Patent Dec. 17, 2002 Sheet 3 of 3

US D467,389 S

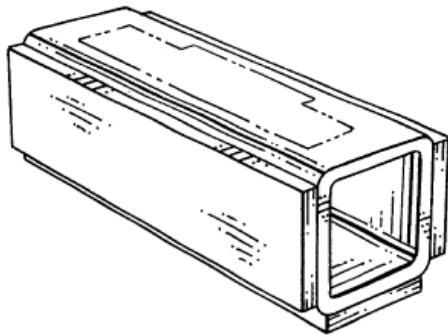


FIG. 1

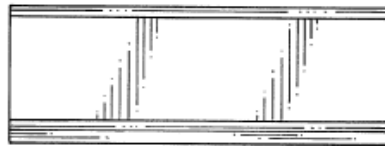


FIG. 2



FIG. 3



FIG. 6

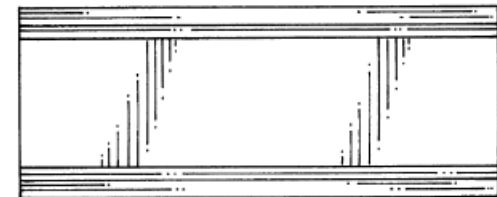


FIG. 7

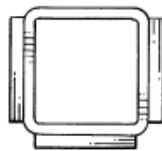


FIG. 4



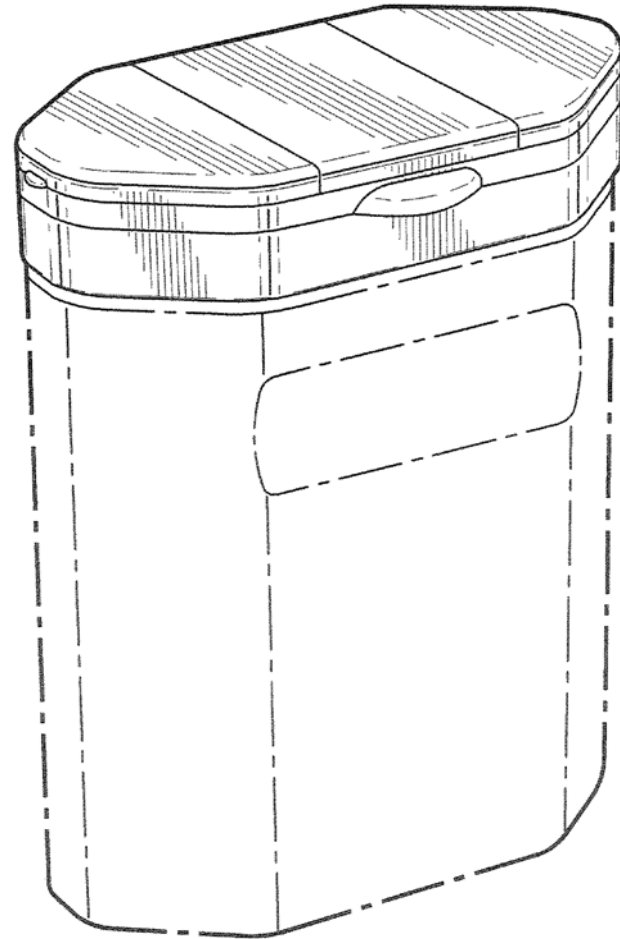
FIG. 5



# Elements of a Design Application

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- Drawings
  - Surface shading may be required to show 3-dimensional aspects of the design
  - Broken (phantom) lines are used to disclose the environment related to the claimed design and to define the bounds of the claim



# Elements of a Design Application

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- Drawings
  - Surface treatment can be shown in solid or broken lines
  - Photographs and color drawings can be submitted with a petition explaining why the color drawings or photographs are necessary



# Elements of a Design Application

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- Preliminary Remarks – can file a document with the application explaining what the claimed design is for (i.e. what it is and/or how it works)
  - Purpose is to help the Examiner understand what is shown in the drawings in an effort to avoid 112 rejections

# Child Design Applications

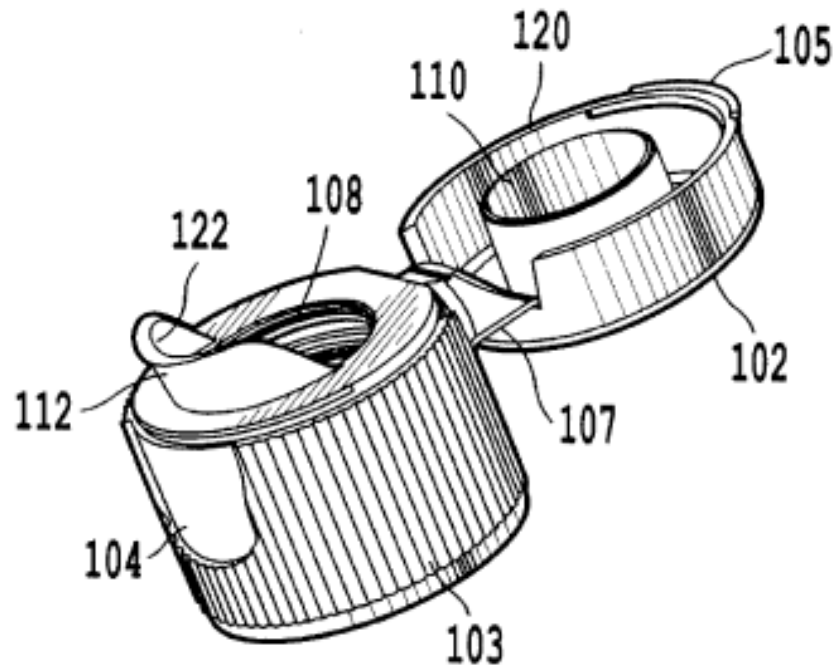
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- A design application can be filed claiming priority to a design or utility application
  - Remember, only a 6-month right of priority under 35 U.S.C. 119(a)-(d)
  - Can disclaim views not supported by the drawings of the utility application

# Design Continuation Example

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- Non-drip pour spout
  - Utility application filed 11/20/2007

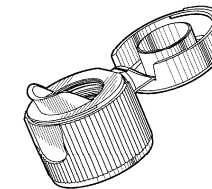


# Design Continuation Example

- Design divisional application filed 10 months later (9/10/2008) using drawings from utility application
- Design patent issued in less than 1 year (8/25/2009)
  - Before utility application received 1<sup>st</sup> Office Action



(12) <b>United States Design Patent</b>		(10) <b>Patent No.:</b> US D598,752 S
Wilson et al.		(45) <b>Date of Patent:</b> ** Aug. 25, 2009
<b>(54) NON-DRIP SPOUT</b>		
(75) Inventors: <b>Tracie Lynn Clemons Wilson</b> , Westminster, MD (US); <b>Steven Gift</b> , Litzitz, PA (US)		
(73) Assignee: <b>McCormick &amp; Company, Incorporated</b> , Sparks, MD (US)		
(**) Term: <b>14 Years</b>		
(21) Appl. No.: <b>29/324,285</b>		
(22) Filed: <b>Sep. 10, 2008</b>		
<b>Related U.S. Application Data</b>		
(62) Division of application No. 11/943,256, filed on Nov. 20, 2007.		
(51) <b>LOC (9) CL.</b> ..... <b>09-07</b>		
(52) <b>U.S. CL.</b> ..... <b>D9/449; D9/454; D9/453</b>		
(58) <b>Field of Classification Search</b> ..... D9/453, D9/450, 449, 446, 438, 447, 222/571, 567, 222/566, 545, 544, 484, 481.5, 480, 556, 222/569, 546; 220/810, 215/556, 235; D2/8/82 See application file for complete search history.		
(56) <b>References Cited</b>		
U.S. PATENT DOCUMENTS		
1,648,512 A	* 11/1927	Stock ..... 222/566
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D476,892 S	* 7/2003	Martin et al.
D508,402 S	* 8/2003	Hierzer et al. .... D9/449
D508,853 S	* 8/2003	Ziegenhorn et al. .... D9/449
D530,202 S	* 10/2006	Herald et al.
D576,877 S	* 9/2008	Alcamo et al. .... D9/449
2004/0026465 A1	* 2/2004	Klopfner
2005/0145655 A1	* 7/2005	Giblin et al.
2007/0095864 A1*	* 5/2007	Vangost et al. .... 222/556
<b>OTHER PUBLICATIONS</b>		
U.S. Appl. No. 29/250,547, filed Nov. 20, 2006, Wilson.		
U.S. Appl. No. 29/322,200, filed Jul. 30, 2008, Wilson.		
U.S. Appl. No. 29/322,205, filed Jul. 30, 2008, Wilson.		
U.S. Appl. No. 28/322,206, filed Jul. 30, 2008, Wilson.		
U.S. Appl. No. 29/322,212, filed Jul. 30, 2008, Wilson.		
U.S. Appl. No. 29/322,215, filed Jul. 30, 2008, Wilson.		
U.S. Appl. No. 29/324,285, filed Sep. 10, 2008, Wilson et al.		
* cited by examiner		
<i>Primary Examiner</i> —Susan Bennett Hattan		
<i>(74) Attorney, Agent, or Firm</i> —Oblon, Spivak, McClelland, Maier & Neustadt, P.C.		
<b>(57) CLAIM</b>		
The ornamental design for a non-drip spout, as shown and described.		
<b>DESCRIPTION</b>		
FIG. 1 is a top, front, and right side perspective view of a non-drip spout;		
FIG. 2 is a front elevational view thereof;		
FIG. 3 is a left side elevational view thereof, the right side elevational view being a mirror image of the side view shown;		
FIG. 4 is a top plan view thereof;		
FIG. 5 is a rear elevational view thereof; and,		
FIG. 6 is a bottom plan view thereof.		
<b>1 Claim, 3 Drawing Sheets</b>		



# Design Continuation Example

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- Utility app drawings do not have to show every side for support of the design application if the sides are the same
  - If the sides are not the same, can likely disclaim the views that are not shown
- Can phantom line features you do not wish to claim
- Can file additional divisional/continuation apps with broader claims



# IV. What is Covered

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- The fourth part of this presentation discusses the scope of protection provided by a design patent

# Ordinary Observer Test

- [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

– Gorham Mfg. Co. v. White, 81 U.S. 511, 528 (1872).



Patented Design



White, 1867 accused design



White, 1868 accused design

# Ordinary Observer Test

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- Focused on the overall appearance of the accused and patented designs
- Not necessary that every aspect of the designs be identical
- Ordinary observer is the average purchaser for the item



# Egyptian Goddess

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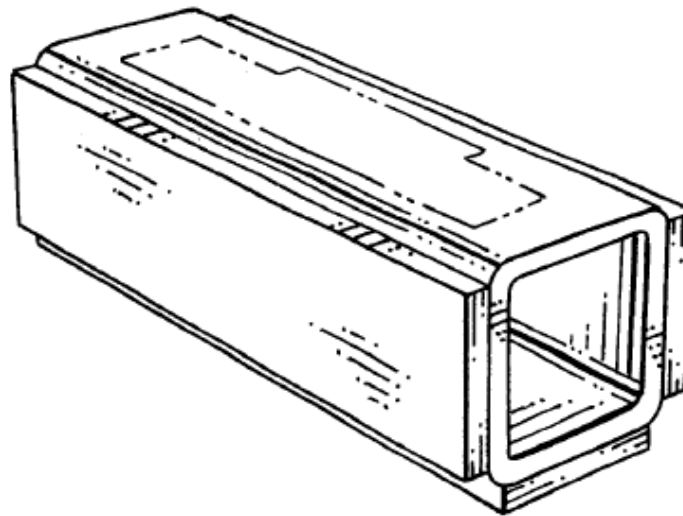
- Design patent case taken *en banc* by the U.S. Court of Appeals for the Federal Circuit in 2008
- Clarified the correct standard for determining infringement of a design patent is ordinary observer test
  - Eliminated point of novelty test
- Discussed claim construction of a design patent claim



# U.S. Design Patent No. 467,389

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- Nail Buffer by Egyptian Goddess, Inc.
- Buffer surface on 3 of 4 sides



# Accused Product

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- Nail Buffer by Swisa, Inc.
- Buffer surface on all 4 sides



# Issues for Rehearing En Banc

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- Whether the point of novelty test should continue to be used as a test for infringement of a design patent?
- Should the district courts perform formal claim construction in design patent cases?



# Ordinary Observer Test

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- Only test for design patent infringement
- However, when the claimed and accused designs are not plainly dissimilar, the ordinary observer test should include a comparison of the claimed and accused designs with the prior art
  - Implies that the ordinary observer is someone familiar with the prior art



# Ordinary Observer Test

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- Points of novelty are no longer separately analyzed, but are instead used to attach importance to the differences between the overall appearance of the claimed design and the prior art

# Claim Construction

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- Design patents typically are claimed as shown in the drawings
- Preferable for district court not to construe a design patent claim by providing a detailed verbal description of the claimed design
  - Absent prejudice, not a reversible error

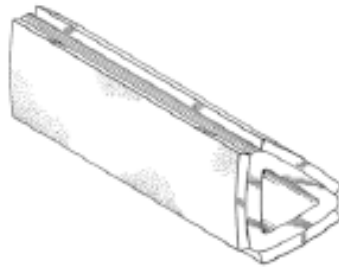
# Analysis

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- Reviewed claimed design, accused design, and 2 closest prior art designs



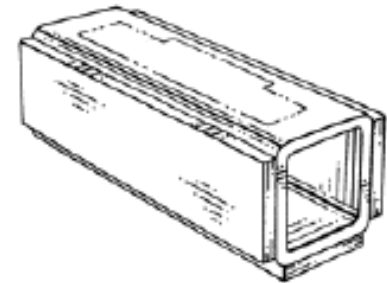
Prior Art



Prior Art



Accused infringer



Patented Design



# Analysis

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- Court affirmed SJ of noninfringement
- Focused on effects of difference between number of buffing surfaces on design as a whole, instead of as an individual feature
  - Egyptian Goddess' expert did not explain why an ordinary observer would regard the accused design as being closer to the claimed design than the prior art

# Test for Infringement

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- Ordinary observer test is the single test to prove design patent infringement
  - Appears to strengthen design patents by removing 1 test
- Although point of novelty is not an independent test, must still compare patented and accused designs in view of the prior art
  - Patented and accused design are not compared in a vacuum
- Law is still developing post Egyptian Goddess



# *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 93 USPQ 2d 1001 (Fed. Cir. 2009)

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- Extends ordinary observer test of infringement from *Egyptian Goddess* to invalidity due to anticipation
- Consider design as a whole – compare overall visual impression

Figure 1 in the '769 Patent

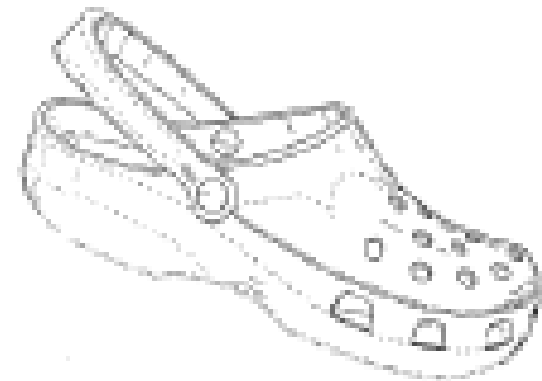


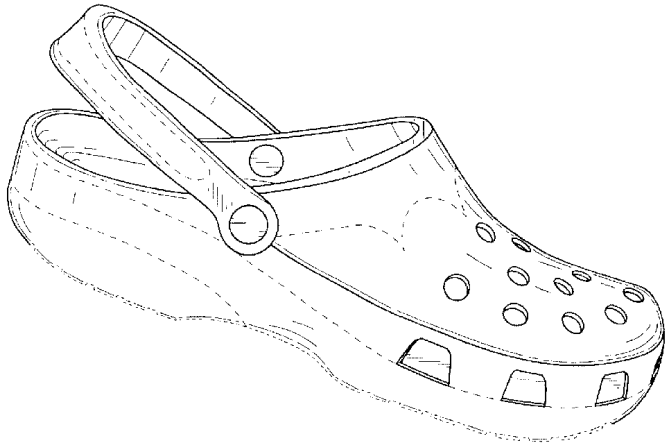
Figure 2 in the '263 Patent



# *Crocs, Inc. v. ITC*

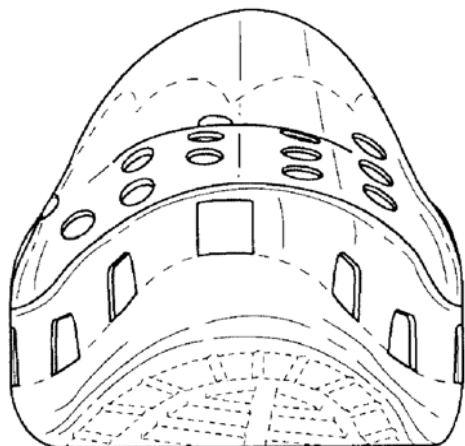
## *93 USPQ2d 1777 (Fed. Cir. 2010)*

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- ITC provided detailed verbal claim construction and found no-infringement
- CAFC cautions against reliance on detailed verbal claim construction of design patent
- Relying on “design as a whole,” CAFC finds infringement by 5 different respondents

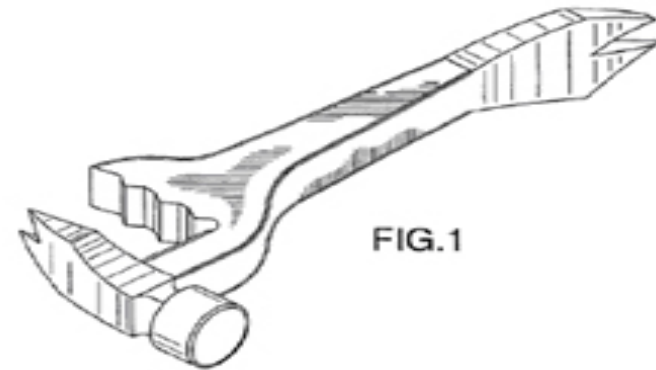
# *Crocs, Inc. v. ITC*



- ITC - technical prong of domestic industry lacking b/c Crocs does not practice patent
- CAFC – apply same test as for infringement, Crocs does practice patent, domestic industry present

# Richardson v. Stanley Works, 597 F.3d 1288 (Fed. Cir. 2010)

- Patented design is combination of a hammer, crowbar, jaw, and handle
- “Infringement will be found only when an ordinary observer, familiar with the prior art designs and ignoring the functional elements of the products, would be deceived into believing that the accused product is the same as the patented design.”
- Court: several of Stanley’s elements – tapered hammer-head, streamlined crowbar, triangular neck and smoothly contoured handle – distinguished it from Richardson’s product.



Richardson's patented design

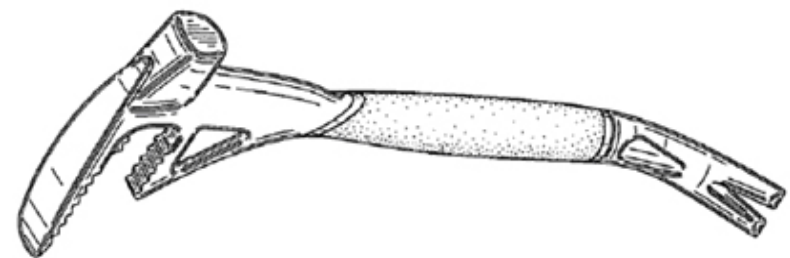


Figure 1  
Stanley's accused design

# Design Patents and the International Trade Commission

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- ITC conducts investigations into alleged infringement of IP rights and other unfair competition in import trade
- For more information regarding the ITC, please see Oblon Spivak's ITC blog
  - [www.itcblog.com](http://www.itcblog.com)



# Design Patents and the International Trade Commission

- Ford Motor Co. successfully sued on 7 design patents to obtain an exclusion order blocking importation of generic (non-OEM) replacement parts for its F-150 pick-up truck

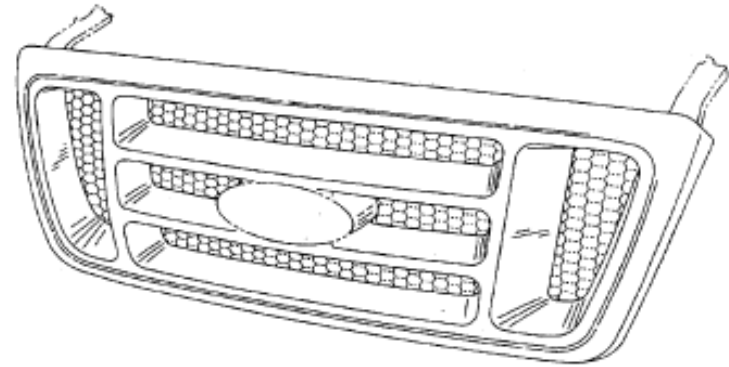


FIG. 1

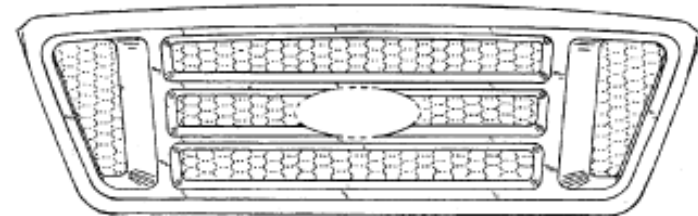


FIG. 2



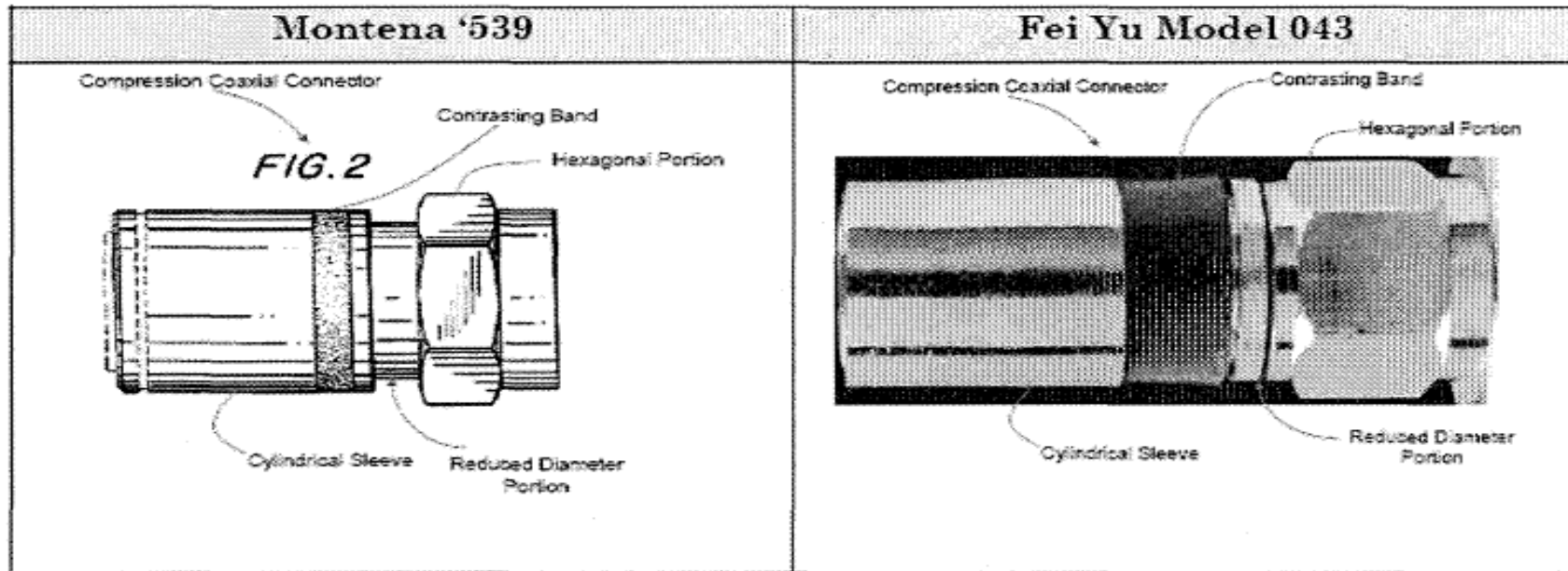
# Design Patents and the International Trade Commission

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- Ford filed another complaint in 2008 seeking to block importation of non-OEM replacement parts for the 2005 Mustang using design patents
- Ford recently settled both litigations
  - At least 1 defendant will pay Ford royalties for each part sold by the defendant



# Design Patents and the International Trade Commission



- Co-axial cable found to infringe U.S. design patents
- Exclusion order granted to patentee (upheld for U.S. D519,076)

# Conclusion

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- Design patents provide a high speed, low cost, high allowance ***addition*** to traditional utility patent protection
- Law on design patents is constantly changing – future decisions could further strengthen protection provided by design patents

For more information about design patents, please contact Philippe Signore at [psignore@oblon.com](mailto:psignore@oblon.com)

