DESIGN PATENTS IN THE
UNITED STATES-
PROTECTING
PRODUCT DESIGNS

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Why Get U.S. Design Patents?

- A study showed that in design patent cases litigated over a recent five year period, preliminary injunctions were granted at the rate of 70%.
- Only one out of three design patents was declared invalid.
- Design patents last for 14 years from issuance.
- Design patents do not require the payment of maintenance fees or annuities.
- Design patents can be obtained in as quickly as 3-6 months with advance planning and expedited examination.
If You Forget Everything Else

Six things to remember:
- The priority date for a design patent is six months.
- The design cannot be entirely functional.
- The drawings define the scope of the claim.
- Unnecessary elements in design patent drawings provide unnecessary non-infringement positions.
- Deleting design features in your own patent application can be the introduction of “new matter.”
- Design patents can give your client the time to create Trade Dress rights.

U.S. Patent Laws for Design Patents

- 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
- The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.
U.S. Patent Laws
Where They Are “Otherwise Provided”

  - The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

  - Patents for designs shall be granted for the term of fourteen years from the date of grant.

U.S. Patent Laws —”revised”

- 35 U.S.C. 119 (a) – (d) . . . but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than six months before the date of the actual filing of the application in this country,

- 35 U.S.C. 102(d) the invention was first patented or caused to be patented . . . on an application for patent or inventor's certificate filed more than six months before the filing of the application in the United States,
Requirements for Patentability
New, Original, and Ornamental

- Novel - no anticipation - 35 U.S.C. 102
  - An ordinary observer sees a new design, not an already existing design
  - Same test as infringement - what infringes anticipates
  - In designs - no non analogous art with respect to 102
- Original – not the same as novelty – No derivation
- Ornamental – lack of ornamentality is very rare rejection

Requirements for Patentability
Functionality and Form

- Not completely functional
  - Some significant aspect of the design not dictated by function alone
  - Key blank - held functional because purpose of the design was to match lock
  - Cannot be functional at the point of novelty
- Article of manufacture
  - Impression, print, or picture applied to an article of manufacture
  - A computer icon is an article of manufacture
  - Shape or configuration of an article of manufacture
Requirements for Patentability

Nonobvious

- Non obvious - 35 U.S.C. 103
  - Test - at the time of the invention, would a designer of ordinary skill in the field of the invention consider it non obvious
  - Non analogous art can be asserted under 103
  - The test for non obviousness
    - scope and content of the prior art
    - differences between the prior art and the claim
    - level of ordinary skill in the art
    - objective evidence of non obviousness

Requirements for Patentability

Unique Requirements

- Not offensive to any race, religion, sex, ethnic group, or nationality
- Perceived as an ornamental design
  - If not visible in final intended use, the ornamental design must be a matter of concern at some time during its commercial life
  - Examples - hip joint, toner cartridge, internal component that is not sold as a replacement part
### Design Patents v. Utility Patents

**Unique Characteristics**

- Term measured from date of grant
- No maintenance fees
- No PCT design patent applications
- The scope of the design patent claim is the drawings
- Six month foreign priority and 102(d) time periods
- Design patent applications are examined for novelty, ornamentality, and nonobviousness
- No pre-grant publication
- Compulsory restriction practice

### Design Patent Specification

**The Drawing or Photographs**

- All views (left side, right side, front, back, top and bottom) must be shown and described
- A view should not be shown or described:
  - If the view cannot be seen during ordinary use
- A view may be described and not shown
  - If the view is identical to or a mirror image of another view.
  - If it is described as “plain and unornamented”
- Use complete drawing or photograph
  - Any feature(s) later added must be inherent from what is filed
Design Patent Specification
The Specification - continued

- Unseen views need not be depicted or described - example the bottom of a computer.
- Features can be disclaimed.
- Disclaimer of any of the design depicted in broken lines – “The portion of the truck depicted in the figures in broken lines forms no part of the claimed design.”
- A computer icon, but only as a part of a display screen.

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Patenting Part of an Article
The Use of Broken Lines

- Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design.
- This CANNOT be done in the Peoples Republic of China! – AND you cannot amend to delete the broken lines or make them solid without losing priority.
Fig. 1 shows a portion of an electronic display with our design for an icon.
Color as an Element of the Design
Color drawings or photographs limit the design

Only red infringes – but what color of red?

But what is the scope?

Only a design of a color that would be confused with this particular blue would be covered.
Color as an Element of the Design
“Lined for Color”

Fig. 1

Fig. 1 is a plan view of our new design, lined for the color blue.
This covers all colors of blue.

Design Patent Drawings

Show (claim) the basic design, not the embodiment!
Design Patent Infringement
Confusion of the Ordinary Observer

- To an ordinary observer, giving the attention of a purchaser, the patented and accused designs are substantially the same such as to deceive such a purchaser, in light of the prior art.


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Design Patent Infringement
In light of the prior art

- When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.
Design Patent Infringement
Confusion of the Ordinary Observer

- An ordinary observer is "a purchaser of things of similar design or one interested in the subject" who, "though not an expert, has reasonable familiarity with such objects, and is capable of forming a reasonable judgment . . . as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it."

Proving Infringement
Confusion

- Compare overall appearance of patented design to accused design
  - Patented design, not patent owner's product
- Judges or jury decides based on their subjective judgment, or
- Survey evidence
  - Best method - but expensive
  - Requires testimony of survey taker
  - Takes the decision from the jury or judge
Design Patent Infringement
The Omission of a Depicted Element

- When the alleged infringing product does not include a feature depicted in the design patent drawing a court may find that there is no infringement. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1990)
- Analogous to the “all elements” rule in utility patents

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From the patent being asserted in the *Elmer* case - note the triangular vertical ribs on each end of the front panel, and the “button-like” protrusion on the top.
The accused product in the Elmer case - note the lack of triangular vertical ribs on each end of the front panel, and the lack of a “button-like” upper protrusion on the top.

Design Patent Infringement
Damages

- **35 U.S.C. 284. Damages**
  - Same damages as for utility patent
  - Injunction, money damages, attorney's fees
  - Reasonable royalty, price erosion, incremental profit

  - Infringer's total profit for sale of an article including the design
  - Not less than $250
  - Cannot recover profit twice – in other words you can’t get 284 and 289 damages, and you can’t multiply 289 damages
Practice Tips:
Broaden the Scope of Protection

- Claim the invention, not the embodiment
- File several applications
  - Each having a different scope
  - Each showing a distinct embodiment
  - Divide the design into smaller parts
- Amend, continue, and reissue
  - Delete superfluous detail from drawing
  - Deleting features may be considered “new matter”

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Patenting Product Designs: The Basics

- Claim a portion of the entire product
  - Remainder or environment in broken lines
- Design cannot be entirely functional
  - Or (entirely) functional at the point of novelty
  - There must be some aesthetic component to the design
- Claim the design, not the embodiment
  - Or claim each in separate applications

Patenting Product Designs: Overview

- Try to claim the interface with surrounding structure
  - If it fits, it infringes – very hard to do without being functional
- When the design patent expires you may have created trade dress rights that are perpetual
  - The product becomes synonymous with a particular manufacturer as the source
Compare Trade Dress Protection
Product and Container Shapes

- Federal Lanham Act 43(a)
- Traditional trade mark rules apply
  - Source identification and distinction
  - Shape not dictated by function
  - Infringement by likelihood of confusion
- Does not require non-obvious design
- Protection not limited to a set time
- Federal registration also available
- Examples: lifesavers candy, Ferrari Daytona Spyder car, teddy bear toy

Trade Dress Protection
Product Shapes

The Ferrari Daytona was found to have Trade Dress rights preventing the sale of “kit” car replicas
Trade Dress Protection
Product and Container Shapes

The most famous product design having perpetual Trade Dress protection -

Patenting Product Designs:
Conclusion

DESIGN PATENTS – an inexpensive way to:

- Control the product configuration
- Control the sale of replacement parts
- Create a barrier to market entry by a competitor
- Create the possibility of creating perpetual Trade Dress rights that can protect the product configuration forever