

Design Patents: U.S. and International Protection

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MIND + MUSCLE



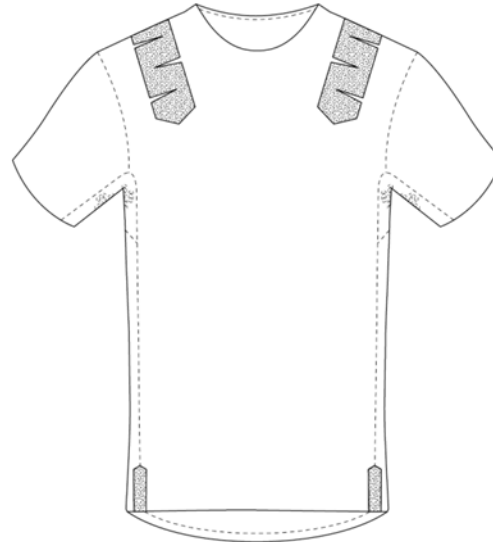
April 27, 2017

Agenda

- Best practices for filing and prosecuting design patent applications before the USPTO
- Responding to 112, 102 and 103 rejections
- Using design patents to protect software and virtual designs
- When and how to file for International design rights, including using the Hague Protocol

What is a Design Patent?

- Protects the ornamental appearance of an article of manufacture, including:
 - The article
 - Surface ornamentation on an article; or
 - Both



D751,271



D752,570

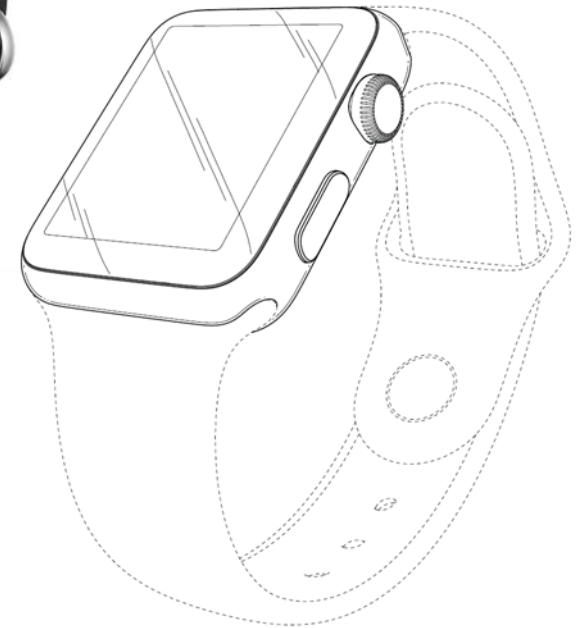
Best Practices For Filing a US Design Patent Application

- **Figures**

- Must be clear
- No required amount of figures or views
- May be line drawings or digital images
- Shading in line drawings is not required, but can be helpful to show contour or transparency/translucency



D759,725

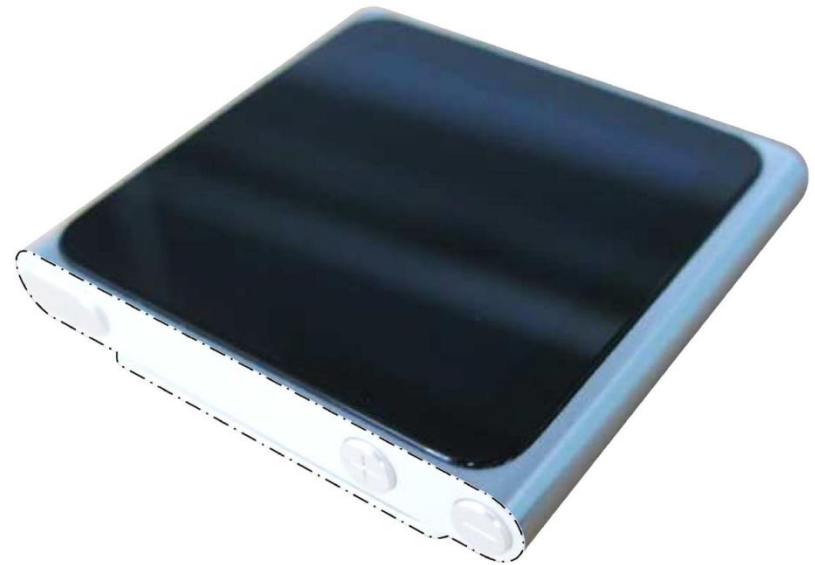


D728,624

Best Practices For Filing a US Design Patent Application (Continued)

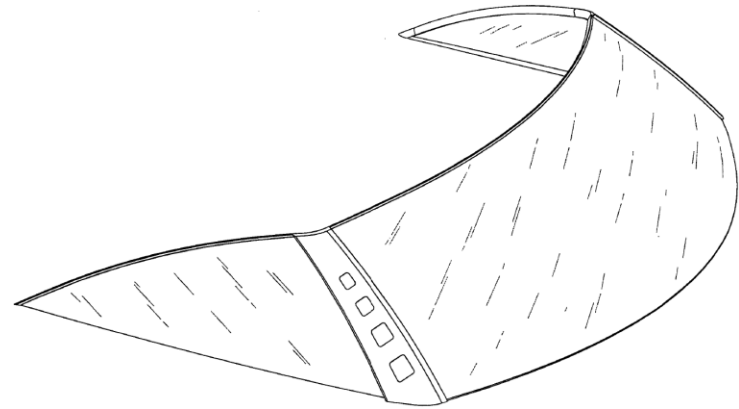
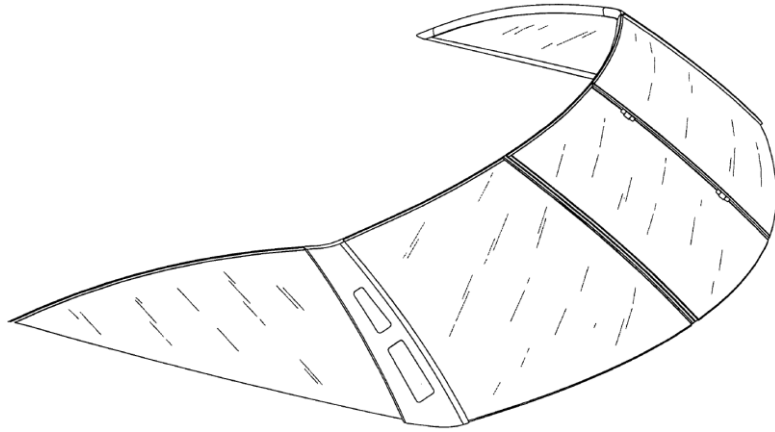
- **Figures**

- May use broken lines or “ghosting” to un-claim parts of the design
- May show alternate positions (e.g., open and closed)
- May claim color or contrast



D739,439

Multiple Embodiments

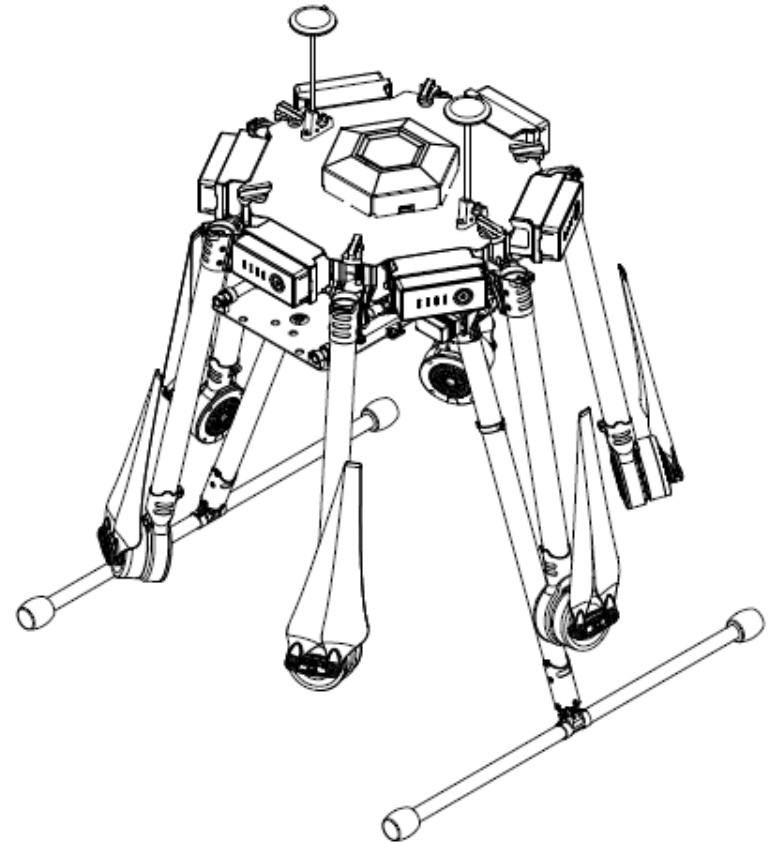
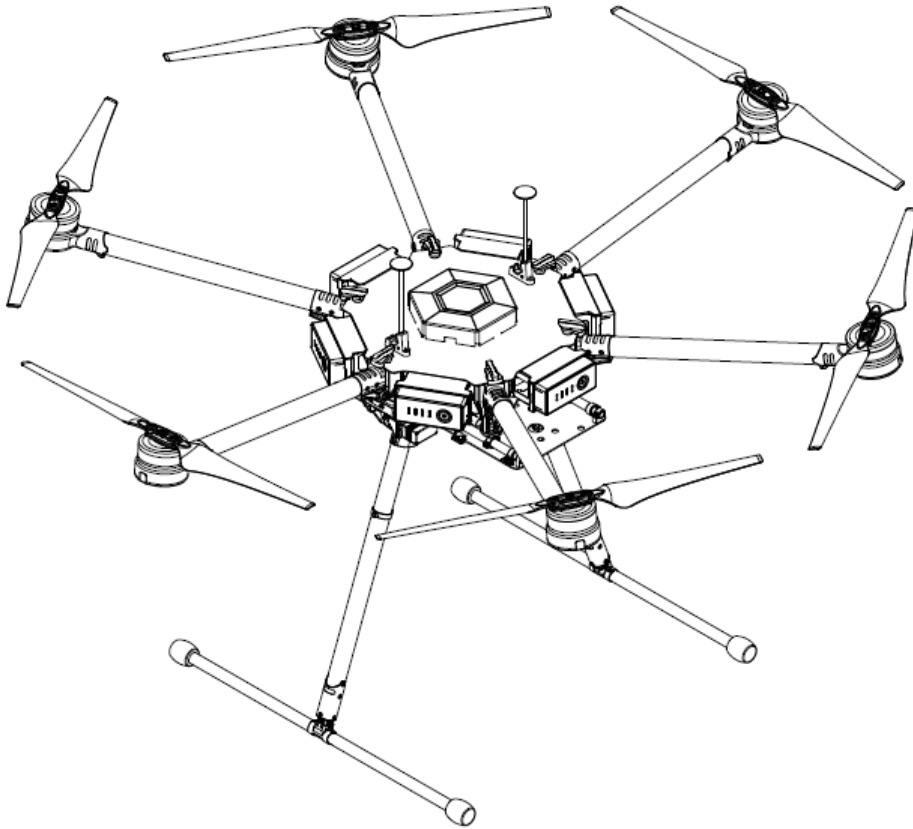


May patent multiple embodiments together if they are not “patentably distinct”

Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC

(Fed. Cir. 2014)

Alternate Positions



Best Practices (Continued)

- **Title**

- Should use the name generally known and used by the public
 - Bottle
 - Watch
 - Mobile Communication Device
- Title is not used to determine the scope of the patent, however the title is repeated in the claim, which is used to determine scope
- Locarno class not used; U.S. classification does not affect claim scope

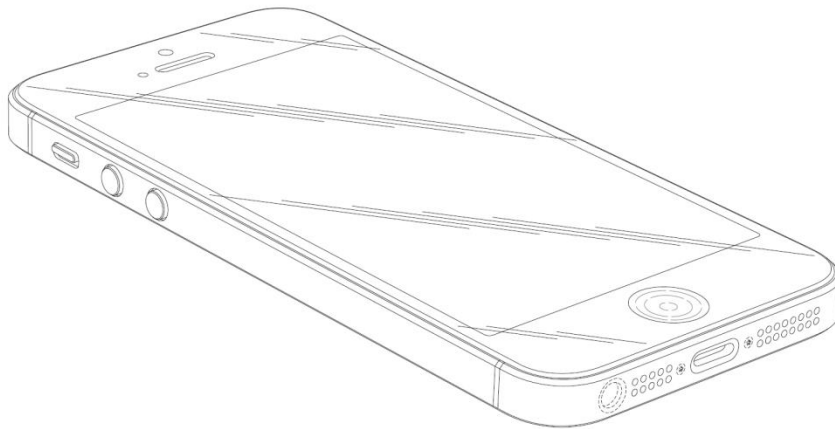
Best Practices (Continued)

- **Written description**

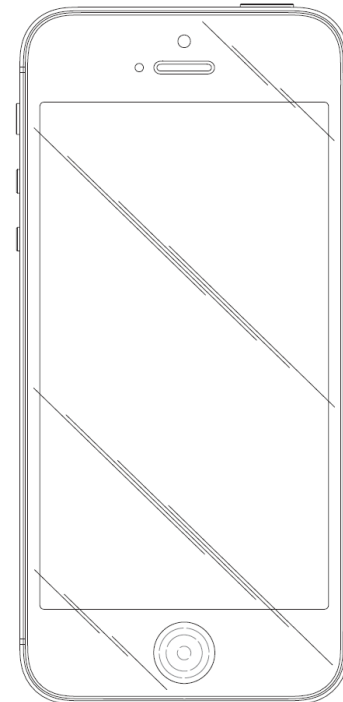
- Figure descriptions

- The type of figure (e.g. plan view, perspective view)
- Broken lines (e.g. environment or unclaimed parts of the design)
- Shading (e.g. transparency)
- Color

- Claim



D684,571



Best Practices (Continued)

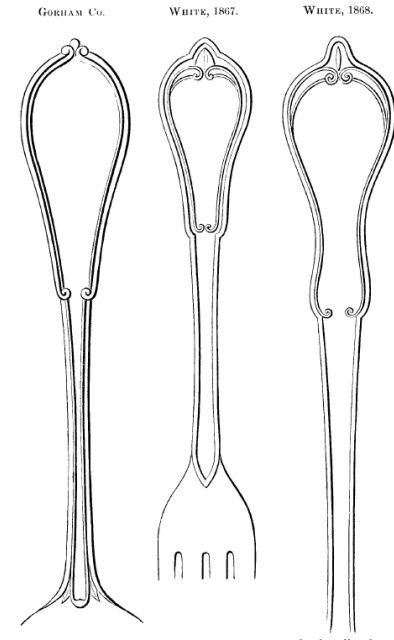
- **Applicant**
 - May be assignee or inventor(s)
- **Creators/inventors**
 - Must be identified and must sign an oath/declaration
- **Priority**
 - May be claimed in the US to an application filed in a home country within in **6 months** from the home country filing date
 - Best practice is to file the **exact same** priority application in the US and make any desired drawing changes by preliminary amendment after filing to avoid loss of priority claim
 - Priority application must be prepared to satisfy **later desired countries** requirements

Conditions for Patentability

- **Novelty (102)**
 - No prior design that is identical or substantially similar
- **Non-obviousness (103)**
 - One of ordinary skill in the art would not consider the design to be obvious based on prior art design(s)
- **Ornamentality (171)**
 - Design cannot be dictated purely by functional considerations
 - Alternative designs are an indication that a design is not purely functional
- **Written description (112)**
 - Full, clear and concise to enable one to make and use the design

The Test for Design Patent Infringement

“[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 v. White
(U.S. Supreme Court 1871)

Patentability – Novelty

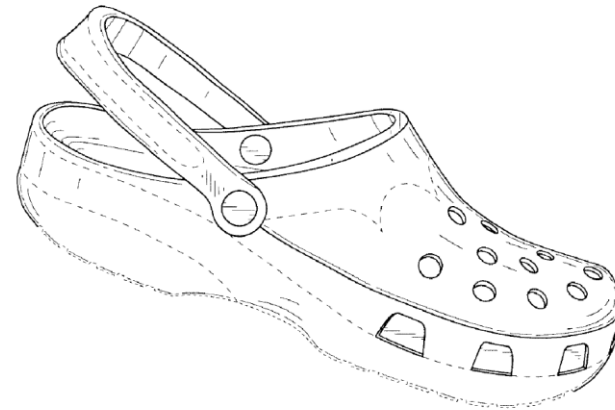
D529,263

Intl. Seaway design



D517,789

Prior art design



"[t]hat which infringes, if later,
would anticipate, if earlier."

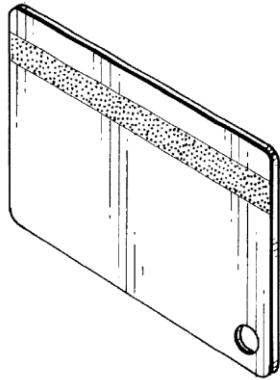
Are the designs **substantially
the same?**

*International Seaway Trading
Corporation v. Walgreens Corporation
et al.*

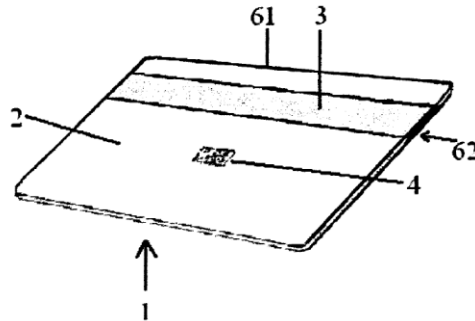
Fed. Cir. 2009

Patentability – Obviousness

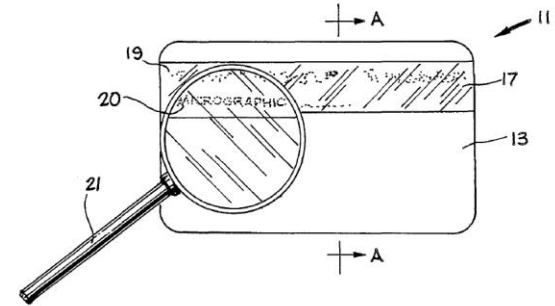
D467,247 Vanguard
design



6,196,594
Prior art design



4,711,996
Prior art design



Primary reference must have “**basically the same appearance**” including any significant visual features of the claimed design

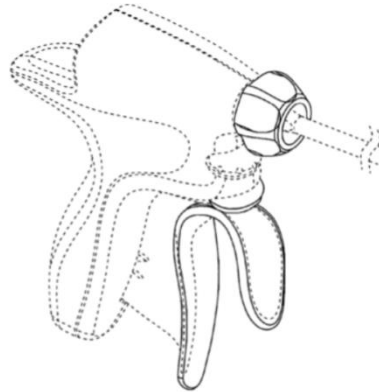
Vanguard Identification Systems, Inc. v. Bank of America Corp.

BPAI 2010

Patentability – Ornamentality

D661,804

Ethicon design



Covidien product



A design that is essential to its use cannot be the subject of a design patent. A design is essential to its use when it is "dictated by" the use or purpose of the article. **Do alternative designs exist?**

Ethicon Endo-Surgery, Inc. v. Covidien, Inc.

Fed. Cir. 2015

Patentability – Written Description

29/219,709

Original application

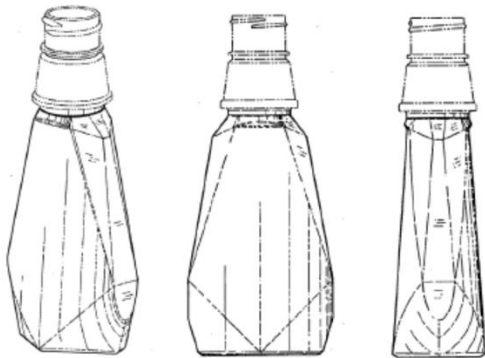


Fig. 1

Fig. 2

Fig. 3

29/253,172

Continuation application

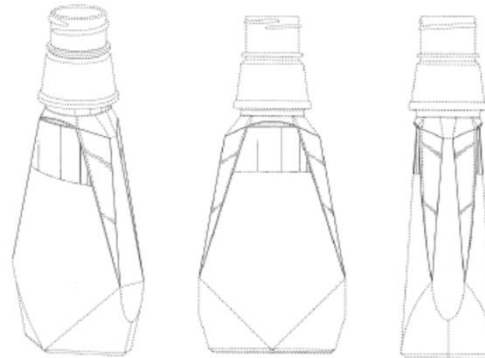


Fig. 1

Fig. 2

Fig. 3

29/253,172

Examiner annotation

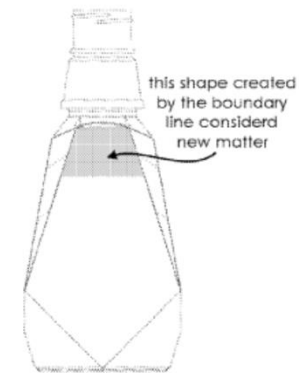


Fig. 2

“the question for written description purposes [in this case] is **whether a skilled artisan would recognize** upon reading the parent’s disclosure that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.”

In re Timothy S. Owens et al.

Fed. Cir. 2013

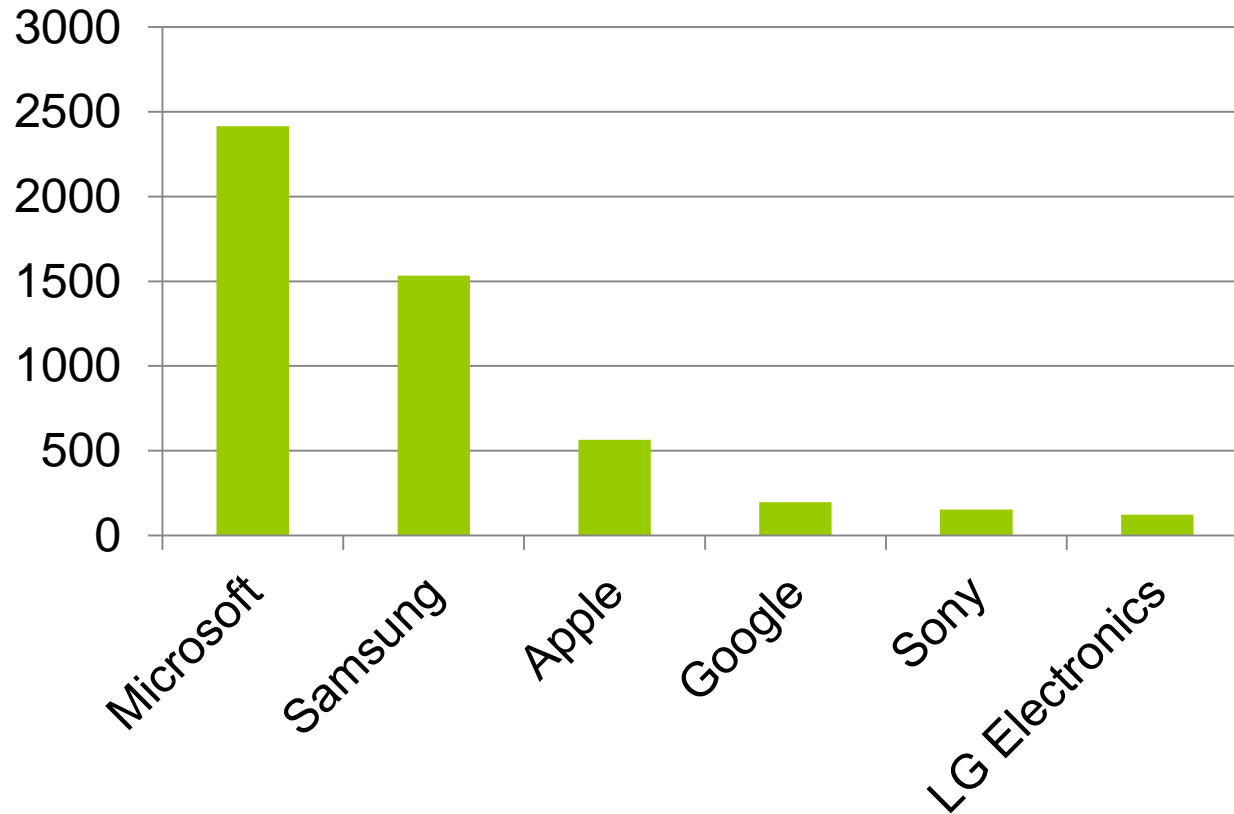
Current Trends in Design Patents

- User Interface is Booming
- As of June 2016
 - Android and iPhone users were able to choose between more than **2 million apps**
- How can software developers protect the intellectual property in these lucrative and growing products in light of **Alice Corp. v. CLS Bank International?**
- How can companies protect their 3D products in a **virtual world?**

GUI Design Applications are Booming in the U.S.

- Design patents fastest growing IP asset to protect Icons and GUI
- Make up nearly 6% of all U.S. design patents issued to date
- Fastest growing area in the Design Group at the United States Patent & Trademark Office (from 1 – 20+ patent examiners in less than 10 years)

US: Top GUI Design Patent Holders



Who Else is filing in the U.S.?

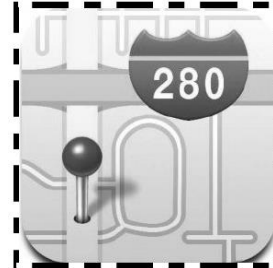


USPTO GUI Design Guidelines

- To be directed to statutory subject matter, design applications for computer-generated icons **must comply with the “article of manufacture” requirement** of 35 U.S.C. §171
- Because a patentable design is inseparable from the object to which it is applied and cannot exist alone as mere surface ornamentation, an icon **must be embodied on a computer screen, monitor or other display panel or portion thereof**
- The article of manufacture on which the design is displayed **may be shown in broken lines**

MPEP §1504.01(a) Computer-Generated Icons (1996 Guidelines)

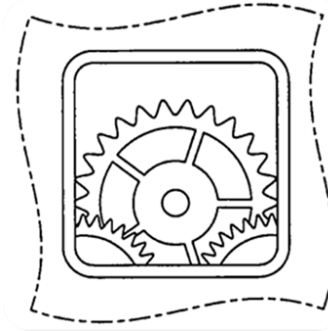
Icons



D649,558



D648,737



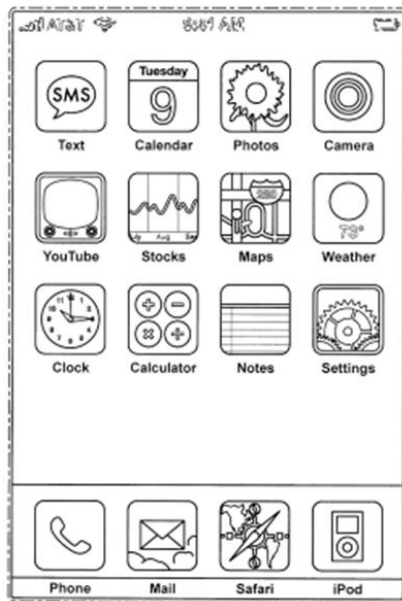
D643,852

Color v. Gray Scale v. Line Drawing

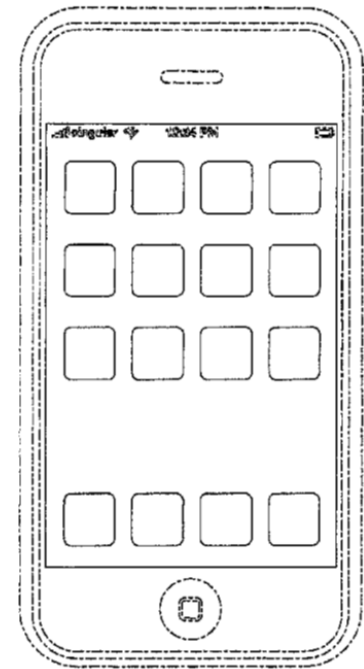
Screen Layout



D604,305



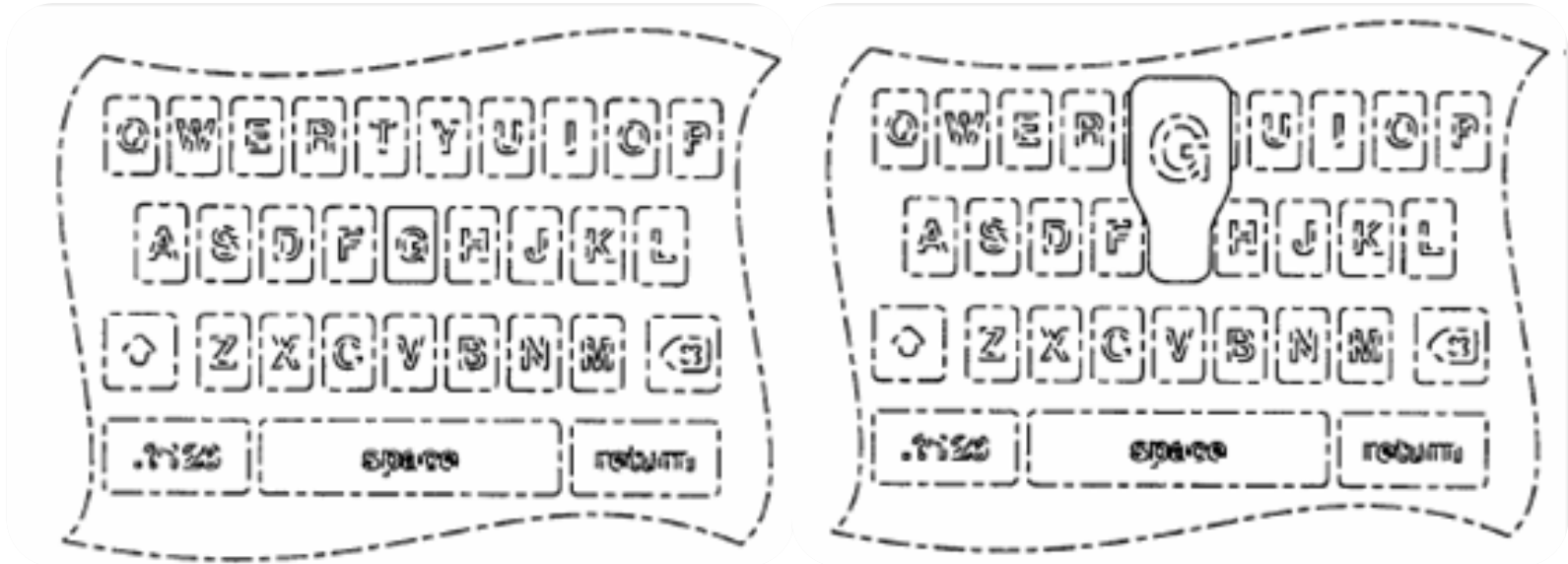
D644,239



D627,790

Same display claimed three different ways

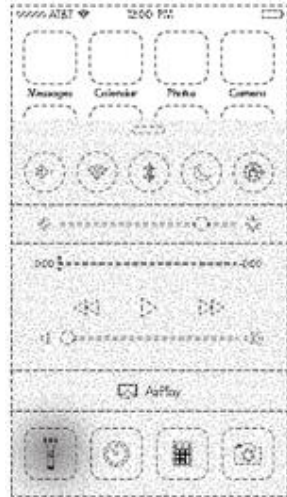
Animations



D621,848

A series of images conveying an animated design

Visual Effects



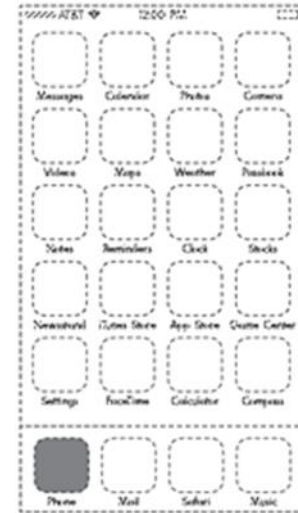
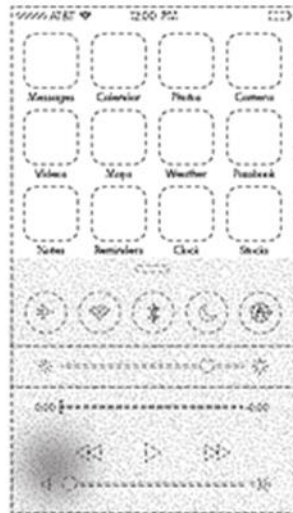
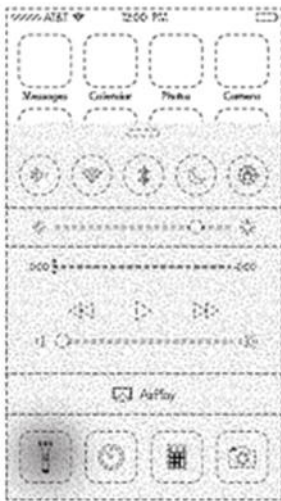
D750,637

Figure 1 is a front view of a display screen or portion thereof with animated graphical user interface showing a first image in the sequence showing our new design.

The solid gray shading indicates a portion of unclaimed user-defined content.

The stippling portrays the illusion of translucent portions of the graphical user interface through which portions of the unclaimed user-defined content are partially visible.

Visual Effects (Continued)



Transitions



FIG. 1

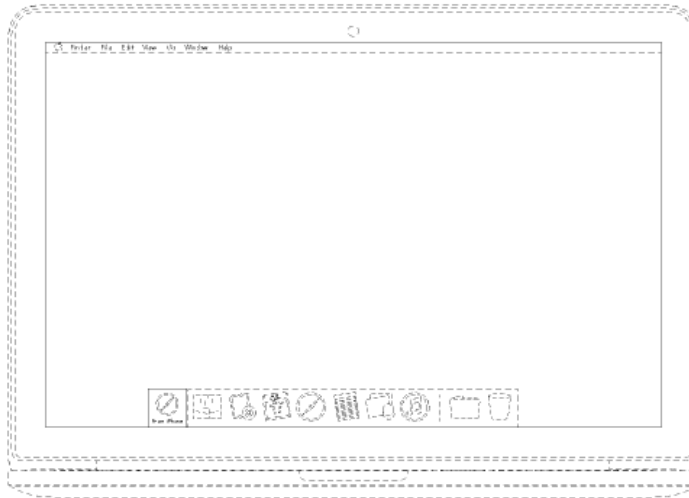


FIG. 2

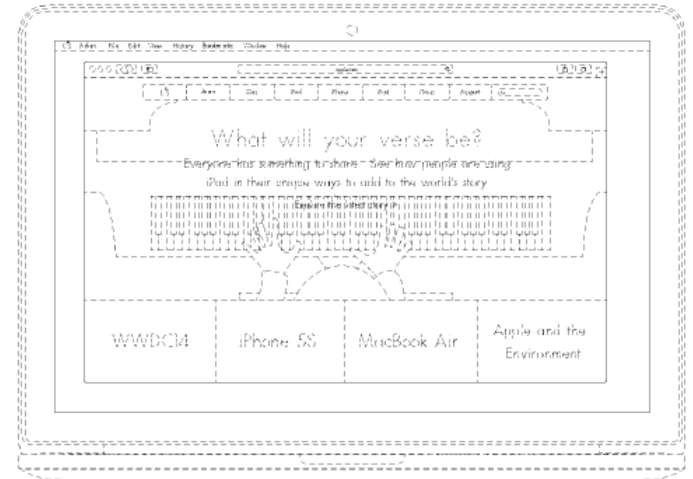


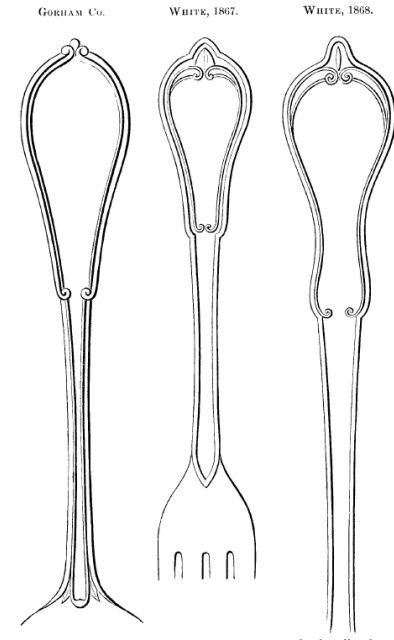
FIG. 3

D769,893

Claim: The ornamental design for a pair of display screens with animated graphical user interface

The Test for Design Patent Infringement

“[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 v. White
(U.S. Supreme Court 1871)

Recent Case - Infringement

D604,305
Apple design



Galaxy S
Samsung design



Apple Inc. v. Samsung Electronics Co. Ltd.
N.D. California, San Jose Division, August 24, 2012

Who Can File a Hague Application and Where?

- Any national or person who has a domicile, habitual residence, or a real and effective industrial or commercial establishment in a Hague member country (all applicants must be eligible, creators do not)
- Currently 65 members including:

USA

Norway

Belgium

Japan

Singapore

Switzerland

South Korea

Turkey

EU

http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=9

2016 General Hague Statistics

- 18,716 designs applied for (16,435 in 2015)
- 13.9% growth (13.8% in 2015)
- Top 5 Locarno classes:
 1. Furnishings (5)
 2. Recording and communication equipment (1)
 3. Means of transportation (3)
 4. Clocks and watches (2)
 5. Packages and containers (4)

Who is Using the System?

- Top 10 Applicants in 2016:
 1. Fonkel Meublemarketing (3)
 2. Samsung (1)
 3. LG Electronics
 4. Swatch (2)
 5. P & G (5)
 6. Volkswagen (4)
 7. Renault
 8. Microsoft
 9. Wenko-Wenselaar
 10. Kronoplus

- Thun (6), Gillette (7), Thomas Sabo (jewelry) (8), Legero Schonfabrik (shoes) (9), Cartier Creation Studio (10)

What Countries Are They Designating?

- Top 10 Designated Countries in 2016:
 1. Germany (1)
 2. Switzerland (2)
 3. Republic of Korea (4)
 4. USA (6)
 5. Netherlands (7)
 6. France (3)
 7. Italy (5)
 8. Japan (9)
 9. Turkey
 10. Sweden

- Austria (8), Liechtenstein (10)

Benefits of the Hague System

- More **simplified** process for obtaining foreign design protection
- Savings of time and money
 - Use of foreign counsel may be reduced
 - Ability to include **up to 100 designs in the same Locarno class** can save costs
- Publishing of International Registration grants **provisional rights**
- Can **delay publication** in some countries (not in the US – adopted the 6 month publication default)
- **Foreign filing license** not needed if IDA is filled indirectly through the USPTO, but is needed if filed directly with WIPO

Limitations of Hague System

- Limited membership
 - Many important jurisdictions are not yet part of the system: China, Canada, Mexico, Australia
- U.S. practitioners must prepare filings with knowledge of **idiosyncrasies** of systems in member countries
 - Number and type of **drawing figures and written description** requirements vary widely among jurisdictions (shading, broken lines, explanation of design)
 - **Loss of novelty** provisions may not be available in all jurisdictions (are available in Japan and Korea and may be claimed after filing)
 - May not be able to **amend application** in all jurisdictions after filing

Limitations of Hague System (Continued)

- Filings through the USPTO require **local agent**:
 - if not included with application as filed (Information disclosure statements, certified copies, inventor declarations and assignments)
 - Replies to Restriction Requirements and Office Actions
- U.S. allows only **1 design per patent** (restricted designs may be filed in another IDA claiming priority to a parent IDA, or in a domestic divisional application)
- Replies to **WIPO notices** must be filed with WIPO, not USPTO
- No centralized system for filing of certified copies of **priority documents**
- Currency fluctuations of the **Swiss Franc**, but can avoid by paying WIPO directly for all but USPTO exclusive fees (e.g. transmittal fee)

Things to Consider

- US Filing date will be lost for failure to pay \$120 transmittal fee to the USPTO for indirect filing
- Failure of the USPTO to transmit the IDA will result in abandonment
- Notice of Refusal (OA) will be transmitted to WIPO who will mail to Applicant's representative (can get notice by e-office action program)
- WIPO's per figure/word fee structure
 - <http://www.wipo.int/hague/en/fees/calculator.jsp>
- Can't file a CPA of an IDA, can file a Con
- Publication opens file history of the IDA to the public through Public Pair (including any domestic benefit application)
- Include a brief description of the design if desirable for the US particularly if the design has claimed and un-claim parts

More Things to Consider

- Grace periods and Paris Convention due dates are unaffected
- Rocket Docket petitions are available for IDAs after publication, therefore USPTO recommends waiting to file
- No US maintenance fees, but WIPO or other countries may require them
- USPTO recommends using the WIPO inventor declaration if designating the U.S. rather than the USPTO form
- Hague registrations only assignable to entities entitled to file an IDA

Questions?

Thank you!