Design Patents: The Basics

September 12, 2012
US: Design v. Utility

**Utility Patent**
- Protects any new and useful process, machine, *article of manufacture*, or composition of matter.
- Protects *functional characteristics*

**Design Patent**
- Protects a new, original, and ornamental design for an article of manufacture.
- Protects *appearance*
- Generally less expensive and quicker to issue
Examples of Protectable Designs

- Overall product designs
- Partial designs / ornamentation
- Packaging
- Patterns
- Fonts
- Icons
US Design

Conceptual:
Protect the idea behind the design

Procedural:
Issued patent after substantive examination
Why pursue a US design patent?

- Low cost
- Reduced time to issue
- Increased damages
  - No less than profit from infringement
- Product marking
- Non-publication
US Basics

- Application is examined
  - Formalities
  - Novelty and Obviousness
- Scope of single claim determined by drawings
- Not published until issue
- Patent presumed valid
- 14 year term from issuance
- No annuities
Claiming Priority in US

- Can claim priority to an application filed in:
  - foreign country, which affords similar privileges; or
  - a WTO member country
- Must file US application within 6 months
- Recognized priority claims based on applications filed under certain agreements. For example:
  - Hague Agreement
  - Uniform Benelux Act
  - European Community Design
Common Mistakes:

- Some applicants ignore/unaware of statutory bar from early foreign registration
- Most applications are of unnecessarily limited scope
- Some applications contain fatal flaws according to US practice
- Substantial improvements are to be had with little extra expense
If the 6M Priority Window is Missed

- US application will be barred if the foreign registration is before the US filing date
- Not recoverable

![Diagram showing the timeline and conditions for barred vs. OK scenarios.]

35 U.S.C. § 102(d)
Drawing Sufficiency

- Risk: invalid filing
  - Not correctable except by disclaimer
- The shape/contour of every feature must be clearly determinable from drawings
- Critical that nothing is “left to conjecture”
- No limit to number of drawings
Drawing Sufficiency

Top

Bottom

Left

Right

Front

Back
Drawing Sufficiency

Top

Bottom

Left

Right

Front

Back
Surface Contour and Shading

- May be necessary to show character and contour
- Lack of shading may render design non-enabled and indefinite
  - subsequent addition could be deemed “new matter”
Line Drawings

Line types

- Solid
  - To indicate critical/necessary features
  - Determine scope of protection
- Dashed
  - To indicate environment and unclaimed features
  - Not to indicate hidden features
Amending line type

– Line type can be changed during prosecution
  • Within reason
  • Amended figures must be clear

– Changes scope of protection, but does not change configuration
Other Figure Types

◊ Photographs: allowed if
  – The design is not capable of being illustrated in ink; or
  – The design is shown more clearly in a photograph (e.g., photographs of ornamental effects)
    • Practical experience: photographs rarely refused if clear

◊ Color
  – Photographs or line drawings
  – Allowed with petition explaining why necessary
  – Color will be considered an integral part of the claimed design
Maximizing Scope of US Design Protection

- Include multiple embodiments
  - Protect the idea in its various expressions
  - May have to argue against restriction
- "Dis-claim" environmental features
  - Show non-critical features only in dashed line
- Limit drawings to design elements
  - Remove technical details before filing
- Avoid photographs
Scope Example: Multiple Embodiments

FIG. 1

FIG. 2

FIG. 3

FIG. 4
Scope Example: Multiple Embodiments

FIG. 5

FIG. 6

FIG. 7
Scope Example:
Amend to “Dis-Claim”

Acceptable
Scope Example:
Amend to “Dis-Claim”

Not Acceptable
Patentability

Novelty

▪ **Average Observer Test:** Will the average observer take the new design for a different design, and not a modified, already-existing design?

Obviousness

▪ **Graham** factual inquiries
▪ All claim limitations (design features) must be taught or suggested by the prior art
▪ Standard → whether the new design would have been obvious to a designer of ordinary skill
New developments in the field of graphical user interfaces (GUIs)

- Smartphones
- Tablet PCs
- Apps
- PC software
Is design protection available for GUls?

“Article of manufacture” requirement

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent

Is a GUI an “article of manufacture“?  
1504.01(a) Manual Of Patent Examining Procedure  
The USPTO considers designs for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection… Thus, if an application claims a computer-generated icon shown on a computer screen… or a portion thereof, the claim complies with the “article of manufacture” requirement…
How do I fulfil the “article of manufacture” requirement?

How is “embodiment in article of manufacture” shown?

1504.01(a) Manual Of Patent Examining Procedure

*If the drawing does not depict a computer-generated icon embodied in a computer screen… or a portion thereof, in either solid or broken lines, reject the claimed design… for failing to comply with the article of manufacture requirement.*

= That’s why there is the broken line!
On-screen keyboard
On-screen keyboard
Slide to unlock
Slide to unlock
Speech bubble tweets

Kluy kujhiua giudg ih hiohoh

Ndeyb ege kluy wg iuy iu - L ajjuwu diiuigki ujjighiuouho guyuigo - pjjphig
Speech bubble tweets

Prswge Trafgwns – od rhbs ejkw .com – she n mojd hwjh

Ndeyb ege kluy wg iuy lu – L ajujwu dliuigkl ujighiuouho guyuigoo - pjpphig
Speech bubble tweets

Jgety hwoui   t k ikjjo kpou

Kusif Hliuolkiou -- ygd gfrtw  uy iy ty o ci ouip wiou wgiguyi l po p phg

Hgr wiuo Lujpj poopip jhoi jhgy g vggx xsuojn kdhje bjytrf ho hoho kojj lihu pidu hvgwyg fgd liu oui poi.
Dfwh wuy auouil pasupuil ly looah hh loiaupp upapupupj wuy auouil pasupuil ly looah hh loiaupp

Prswge Trafgwns – od rhbs ejkw .com – she n mojd hwjh

Kluy  kujhiua giudg ih hihooh

Ndbyb ege kluy wg iuy iu  – L ajujwu dliuigkl ujighiuouho guyuigoo - pjpphig
Cover Flow
Cover Flow
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Cover Flow
Cover Flow
Cover Flow
Takeaways

- Make sure drawings are sufficient
- Limit drawings to design elements (remove technical details before filing)
- Disclaim environmental features (show non-critical features only in dashed line)
- Avoid marks, photographs
- Most US design patents are of unnecessarily limited scope:
  - Substantial improvements possible with little extra expense
- Design patents can add significant value to an IP portfolio:
  - Damages, marking
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