



# Basics of Design Patents

Thursday, March 23, 2023

**FISH.**

# Meet The Speakers

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**Joseph Herriges**  
Principal



**Grace Kim**  
Principal

# Overview

- **Housekeeping**
  - CLE
    - Send NY/NJ CLE forms to [MCLEteam@fr.com](mailto:MCLEteam@fr.com)
  - Questions
  - Materials
    - <http://www.fr.com/insights/webinars>

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## WEBINAR

Complimentary CLE

### Not Just Non-Competes: How Proposed Non-Compete Bans Could Affect NDAs, Trade Secrets, and More

Wednesday, March 29, 2023 | 1:30 - 2:30 p.m. ET

In February, the Workforce Mobility Act was reintroduced in the U.S. Congress with bipartisan support, which would limit the use of non-compete clauses in employment contracts. This proposed legislation comes on the heels of a proposed rule by the Federal Trade Commission that would classify non-compete agreements as unfair methods of competition, as well as raise scrutiny on other types of agreements the FTC asserts could function as de facto non-compete agreements, including non-disclosure agreements. Given that NDAs are a common first line of defense in many trade secret protection strategies, these proposals could have implications beyond non-compete clauses for trade secret holders.

On Wednesday, March 29, please join Senior Principal [DJ Healey](#) for a discussion of the proposed legislation and rule.

REGISTER

PRESENTED BY:



[DJ Healey](#)  
Senior Principal

# Agenda

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- **What Is a Design Patent?**
- **Utility vs. Design (Litigation)**
- **Utility vs. Design (Prosecution)**



# **What is A Design Patent?**

# Starting With the Statute

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## **(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.

35 U.S.C. § 171

# Fashion Over Function

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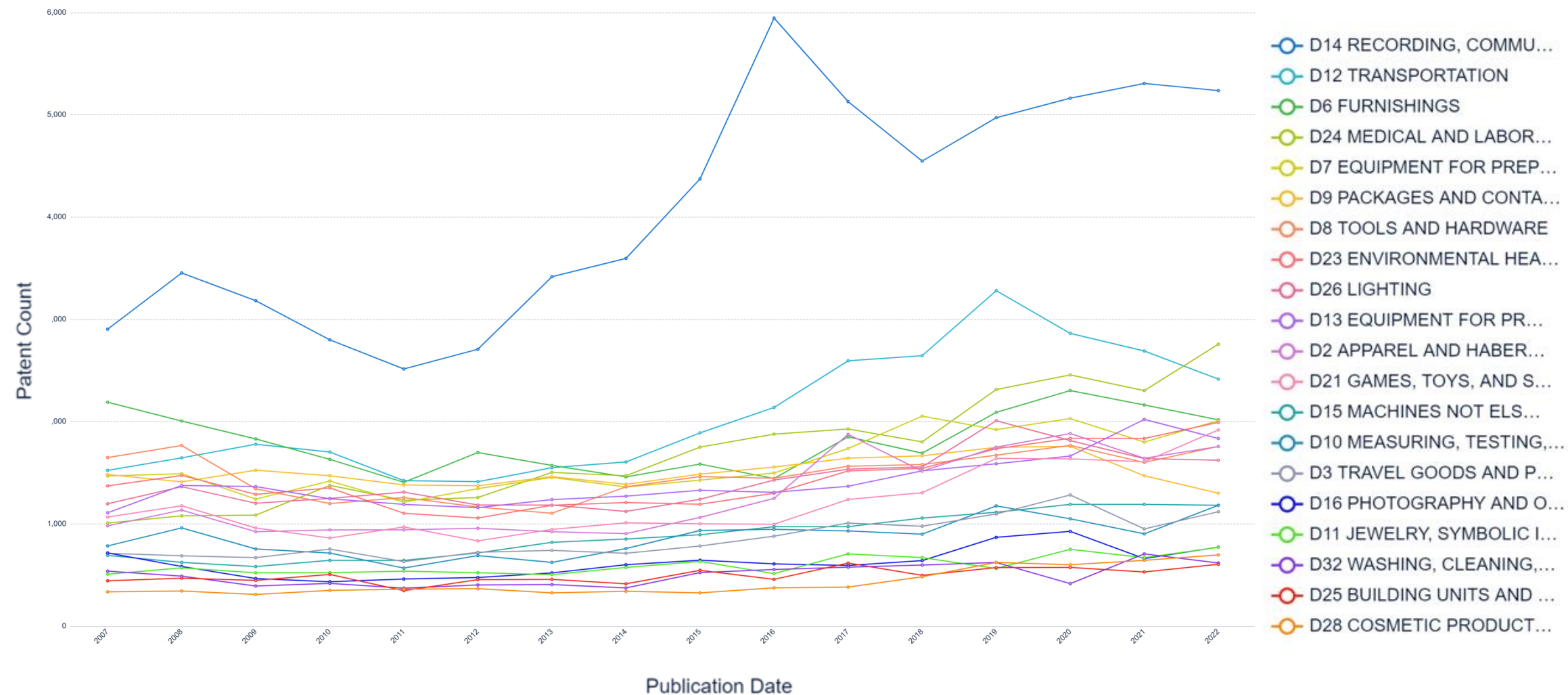


“In general terms, a ‘utility patent’ protects the way an article is used and works, while a ‘design patent’ protects the way an article looks.”  
MPEP1502.01.

“Articles of manufacture necessarily serve a utilitarian purpose, ***but design patents are directed to ornamental designs of such articles.***” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.* 796 F.3d 1312 (Fed. Cir. 2015)



# Design Patents Across Industries

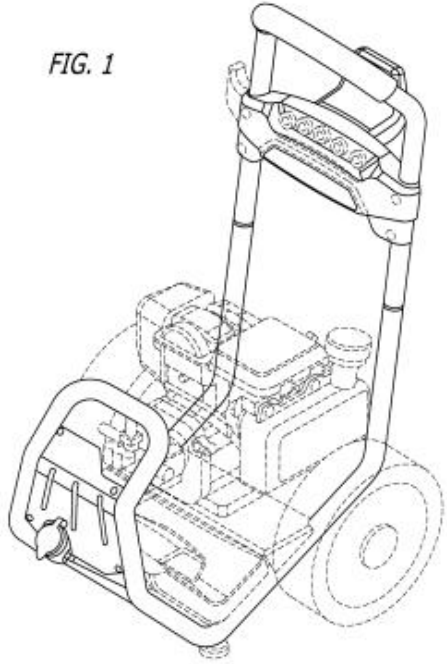




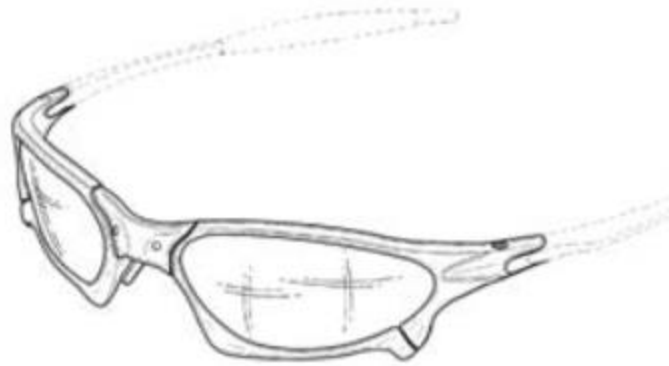
# Design Patents Across Industries—Consumer Goods

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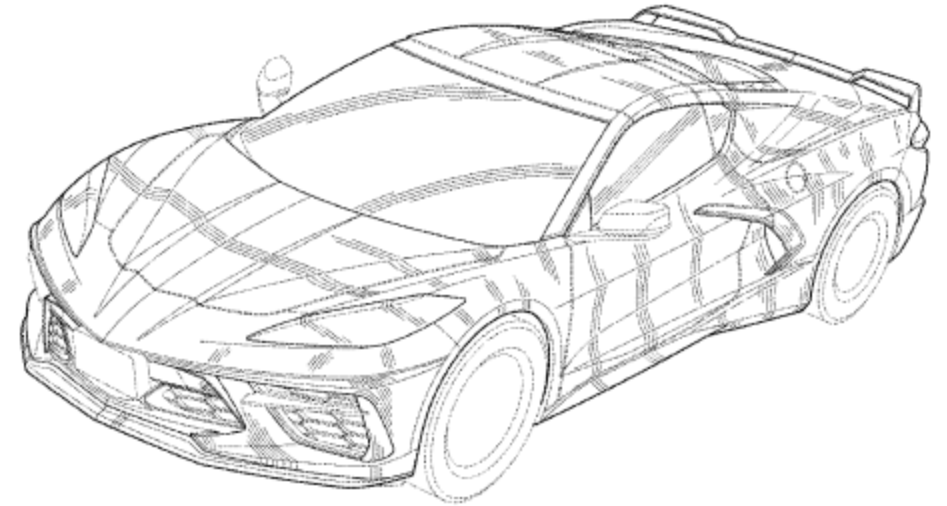
FIG. 1



D733,373



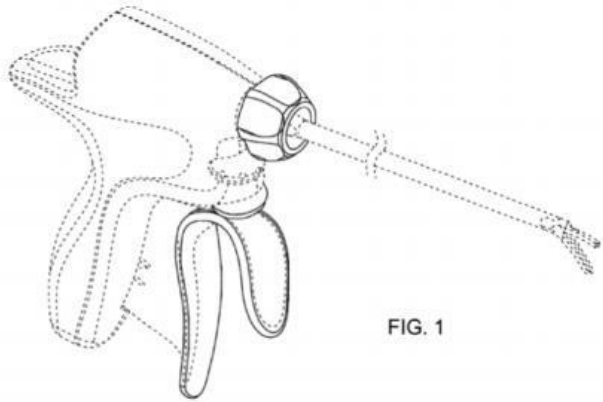
D470166



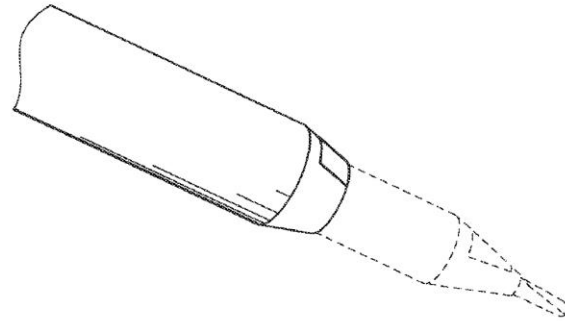
D863,104

# Design Patents Across Industries--Medical

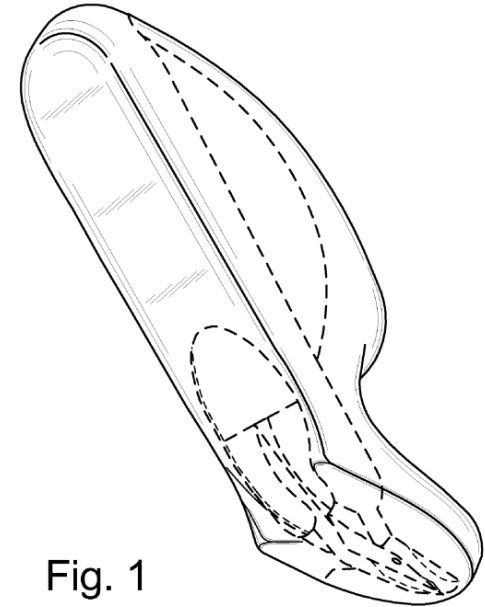
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D661,804



D652,922



D576,279

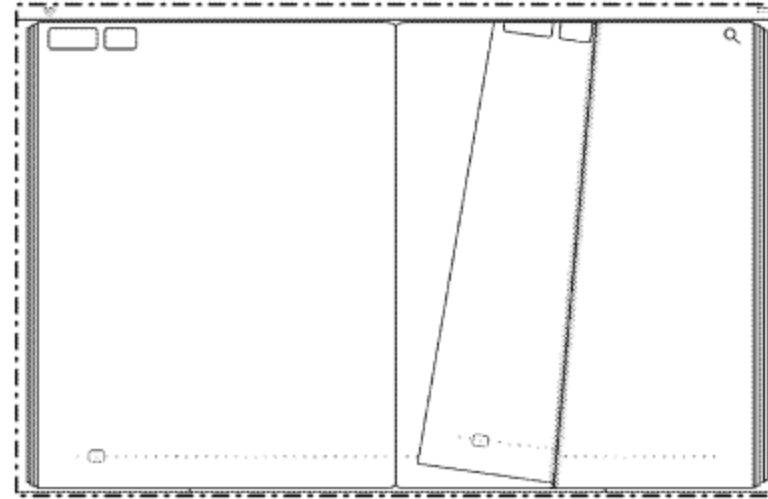
# Design Patents Across Industries—Tech/GUI

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FIG. 2

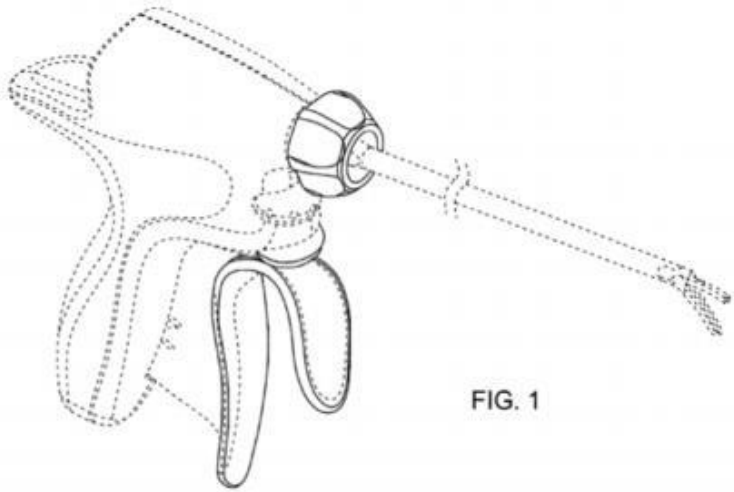
D687047



D669906

# Functional And Ornamental?

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- A design may contain both functional and ornamental elements.
- The scope of a design patent must be limited to the ornamental aspects of the design.
- The shape and ornamentation of functional features are protected to the extent they contribute to the overall ornamentation of the design.
- Courts will often focus on the availability of alternative designs to accomplish the same alleged functionality.
- Other factors include whether the protected design represents the best design; whether alternative designs would adversely affect utility; whether there are related utility patents; whether advertising touts particular features of the design as having utility; whether there are any elements in the design clearly not dictated by function.



# **Differences Between Design and Utility Patents (Litigation)**

# Design and Utility: Two sides of the same coin?

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- "Thus it was that the patentability of designs to be came to be subject to the new § 103 which was written with an eye to the kinds of inventions encompassed by § 101 with no thought at all of how it might affect designs." *Nalbandian*, 661 F.2d 1214, 1219 (CCPA 1981) (Rich, J., concurring).
- "In the design patent context, however, the judge's explanation of the decision is more complicated because it involves an additional level of abstraction not required when comprehending the matter claimed in a utility patent....Given the lack of a visual language, the trial court must first translate these visual descriptions into words--i.e., into a common medium of communication." *Durling v. Spectrum*, 101 F.3d 100, 103 (Fed. Cir. 1996).
- "Obviousness of utility patents requires considerations such as unexpected properties, utility, and function. Design patents, on the other hand, relate to considerations such as the overall appearance, visual impressions, artistry, and style of ornamental subject matter. Ornament is in the eyes of the beholder. Functional utility is objective. *LKQ v. GM*, Case No. 21-2348 (Fed. Cir. 2023 (Lourie, J. Concurring)).

# Claim Construction

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V.



"[D]esign patents 'typically are claimed as shown in drawings' . . . For that reason, this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design as is typically done in the case of utility patents." *Egyptian Goddess, Inc. V. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008).



# The Ordinary Observer

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Stock Image of "Average Guy"

- Perspective from which anticipation and infringement are analyzed
- The ordinary observer is not an expert, but can be a sophisticated commercial buyer.
- Cases with multiple purchasers
- Component cases

# Infringement + Anticipation

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- Analyzed from the perspective of an ordinary observer
- Key is deception: "if, 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 . . . purchase [of] one supposing it to be the other, the first one patented is infringed by the other." *Egyptian Goddess*
- For infringement, the analysis should take account of the scope of the prior art because "the attention of the ordinary observer 'will be drawn to those aspects of the claimed design that differ from the prior art.'" *Lanard Toys; Egyptian Goddess*

# Obviousness: The Ordinary Designer

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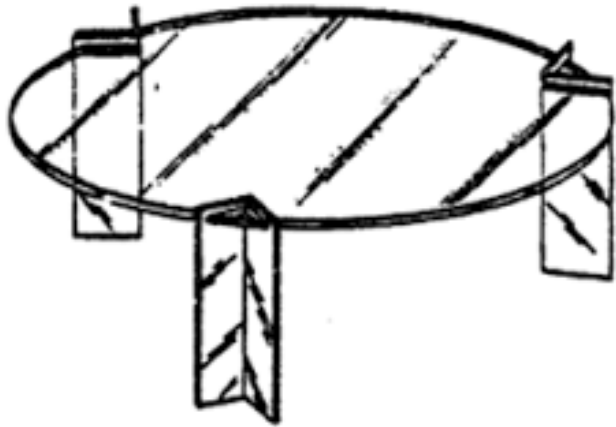


- Perspective from which obviousness is analyzed.
- Like a skilled artisan in the utility context, the level of skill will be fact dependent and differ based on field.
- Ultimate inquiry is whether the design would have been obvious to a skilled designer.

# Obviousness: The *Rosen* Reference

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FIG. 1



- First step in the obviousness analysis
- A *Rosen* reference is a "primary reference" a "something in existence" that is "basically the same" as the claimed design.
- Cases like *Durling* and *Jennings* have suggested the *Rosen* requirement serves to anchor the inquiry on the overall appearance of the design, rather than allowing hindsight-based reconstructions.

# Combining References

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**If a *Rosen* reference exists**, secondary references may be used to modify the primary reference if they are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other."

*MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014)

# Damages

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Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied ***shall be liable to the owner to the extent of his total profit***, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 USC § 289



# **Differences Between Design and Utility Patents (Prosecution)**



# Why should you obtain design patents?

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- Cost effective for protecting commercial embodiments
- Can provide a complementary form of patent protection



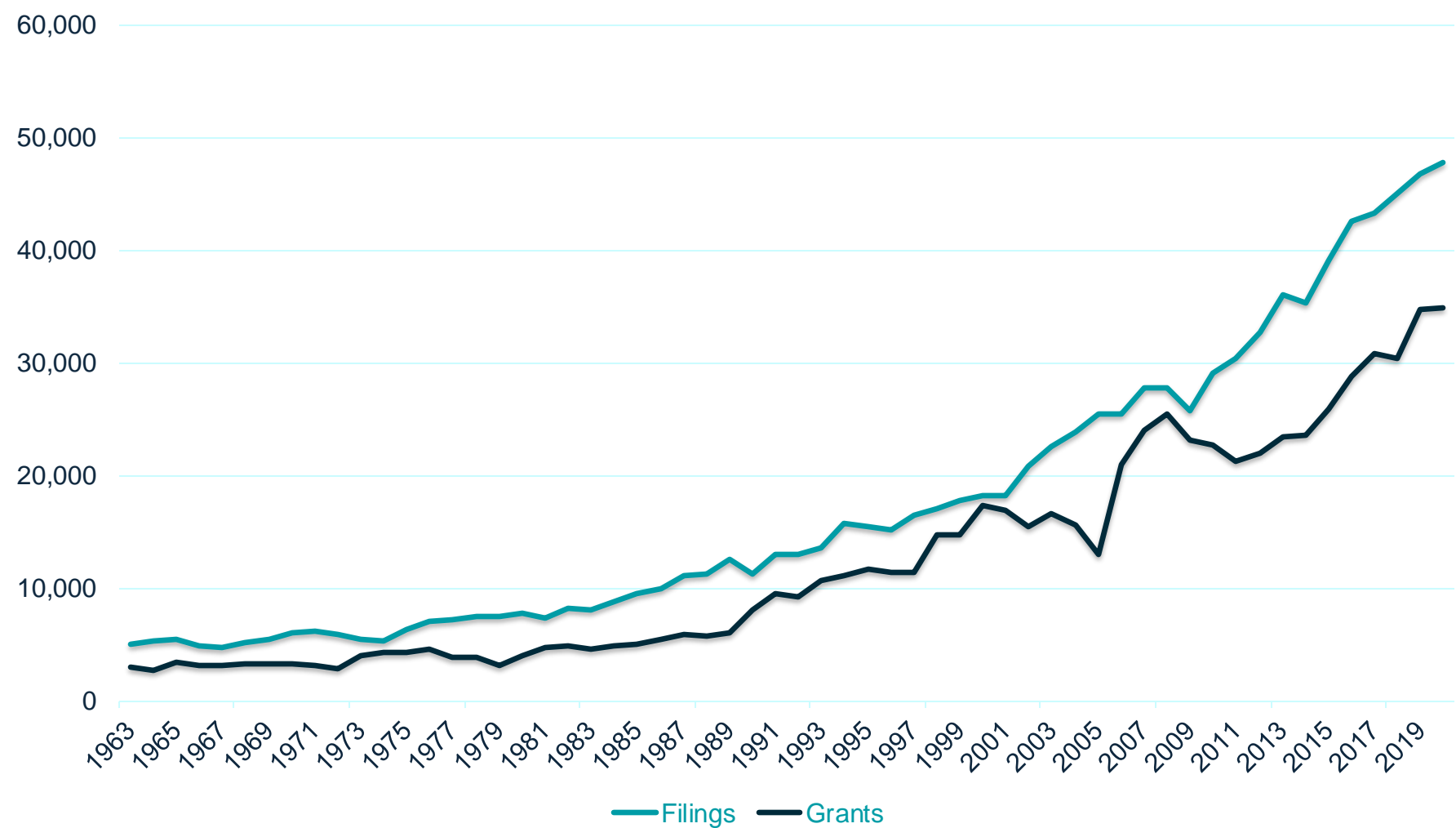
## Bloomberg Law

Nov. 16, 2020, 8:02 AM

### Companies Turn to Design Patents to Fight Overseas Knockoffs

Oakley Inc., Fitness Anywhere LLC and other companies are leaning into design patents to fight knockoff products coming across the U.S. border.

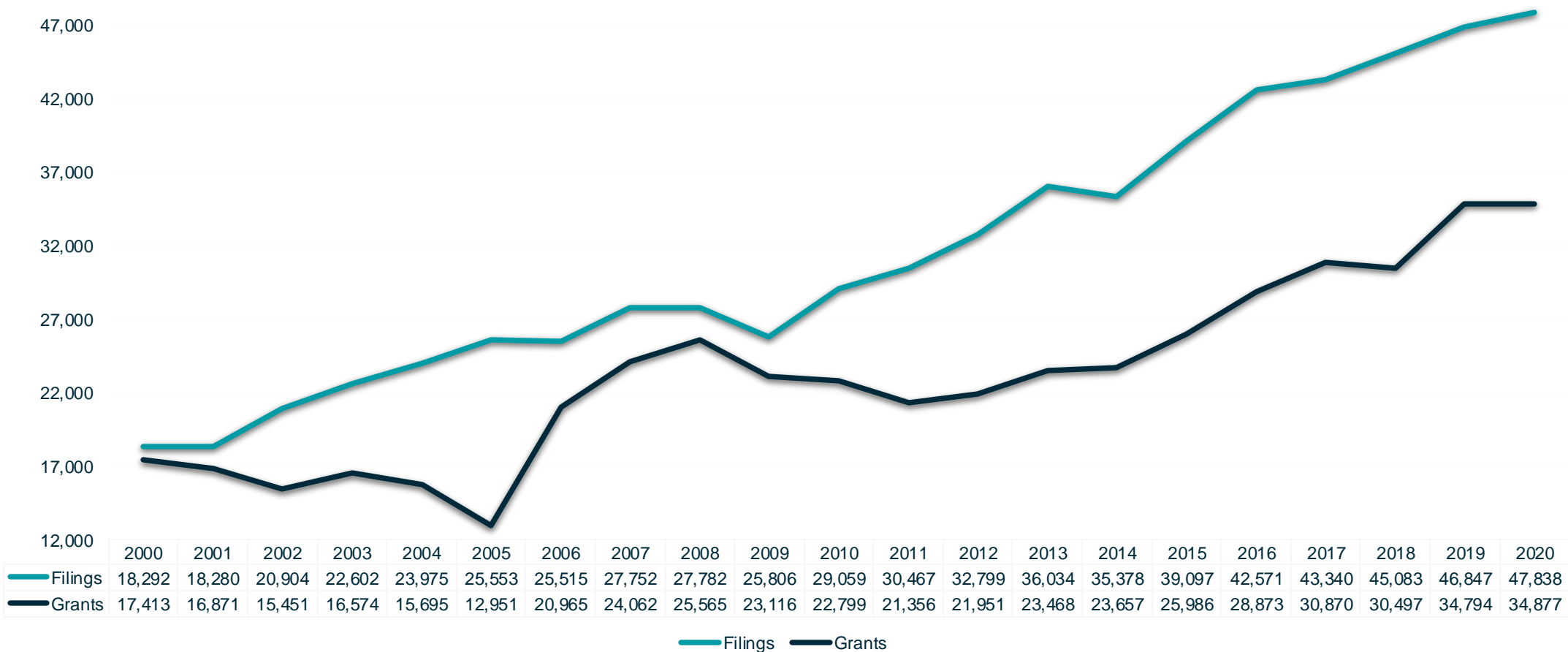
# Historical Trends



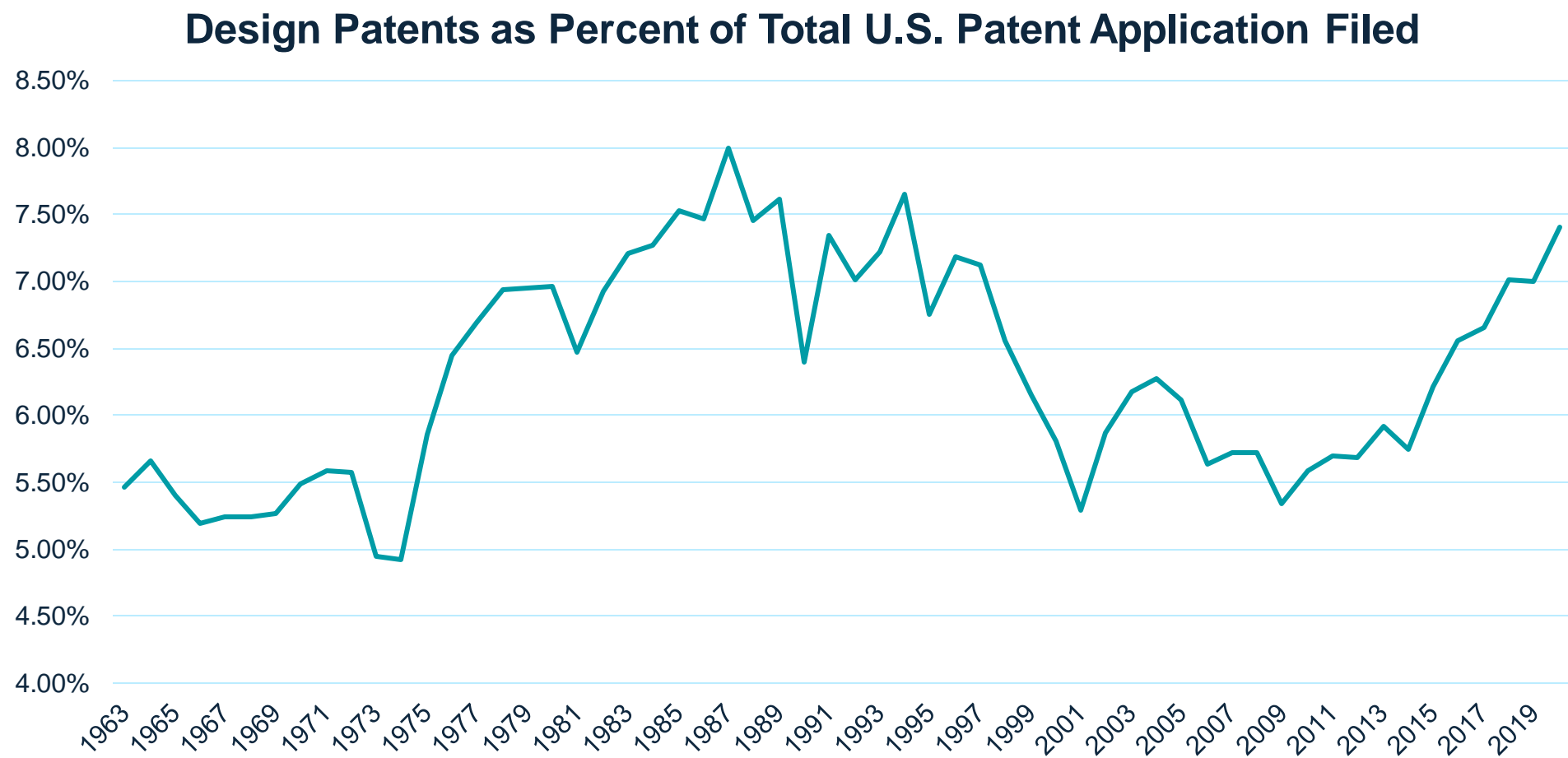
Source: USPTO

# More Recent Trends

## Past 20 years



# Compared to Utility Patents?



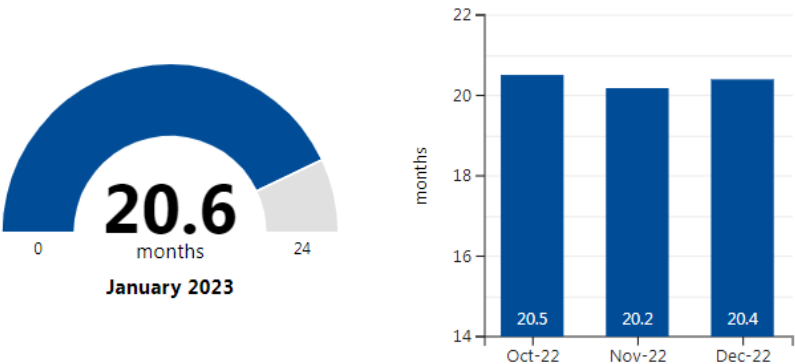
Source: USPTO

# USPTO Statistics

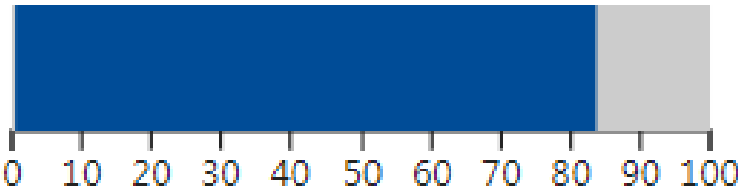
Design Examiners on Staff



Design Traditional Total Pendency



## Design Allowance Rate



Design allowance rate = 83.1 %

Cumulative for fiscal year 2023

Source: USPTO

# Timing Considerations

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## Patent term and related factors:

	Design Patent	Utility Patent
Patent Term Period	15 years	20 years
Term starts from...	Grant date	Filing date
Can you file a provisional application?	No	Yes, w/ 12-month provisional period
If prosecution time frame is...	1-2 years	2-5 years
Then enforcement period is...	15 years	15-18 years

# Timing Considerations

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## Timing related factors:

	Design Patent	Utility Patent
Can you file a provisional application?	No	Yes – the provisional period is 12 years
Foreign filing (conversion) deadline	<u>6</u> months	12 months



# Best prosecution practices – When to File?

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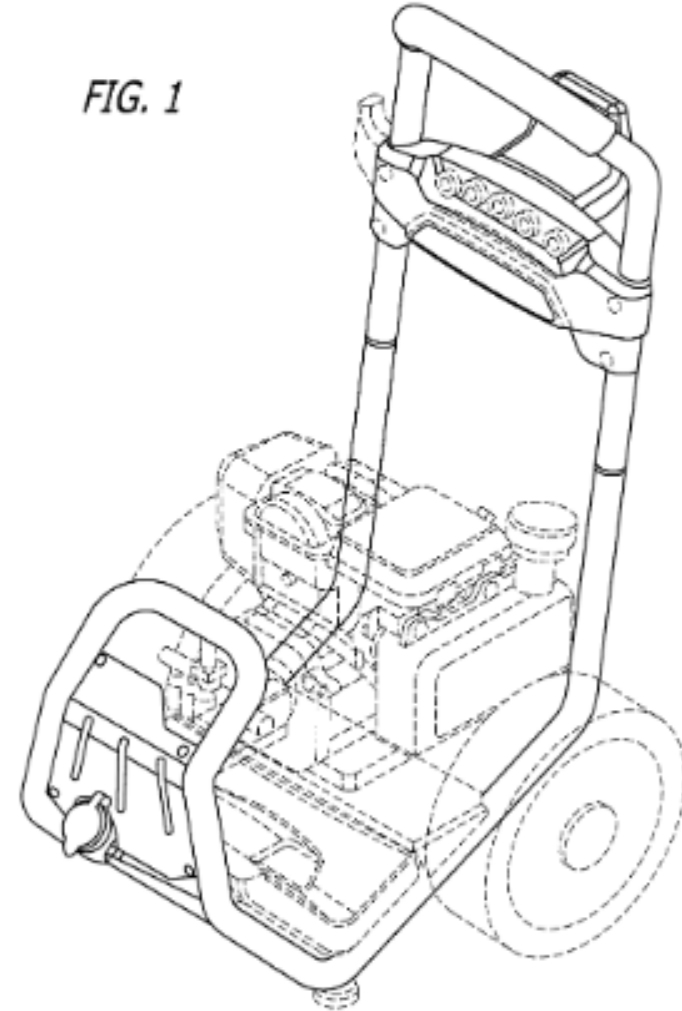
- **Determine whether your design is ready for patenting**
  - File on the design once the design is final or very close to final.
  - Changes in layout or positioning of certain components may not be protected by an earlier filing.



# Design Patent Prosecution – Options

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- **Design options to consider**
  - **Black & White** / Color
  - **Line drawings** / CAD models / photographs
  - Full article / portions of an article
  - Denote the nature or environmental use of the claimed design
  - Surface shading



# Exemplary Design Patents

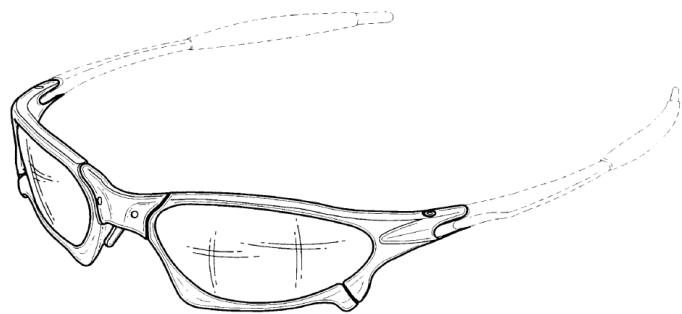


FIG. 1



FIG. 2

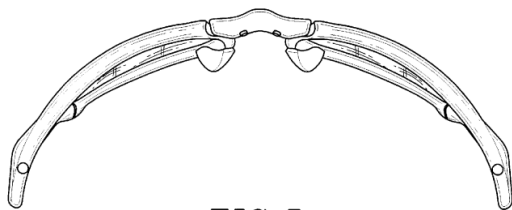


FIG. 5



FIG. 3

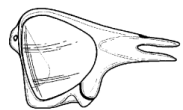


FIG. 4

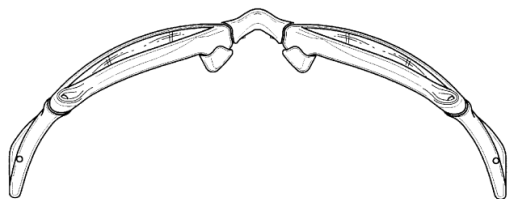


FIG. 6

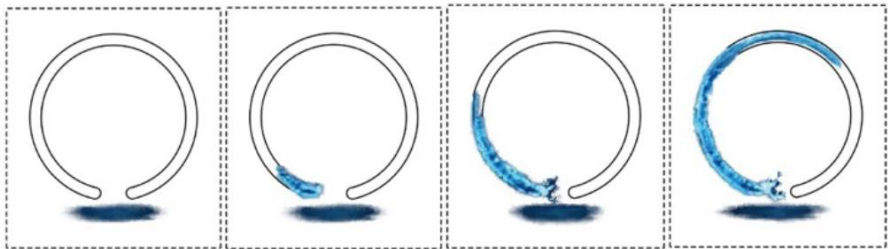


FIG. 1

FIG. 2

FIG. 3

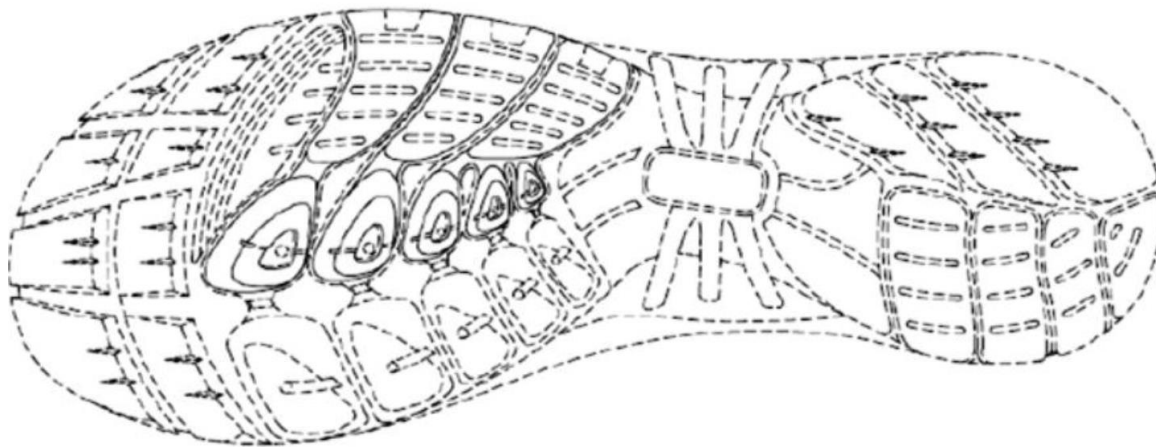
FIG. 4

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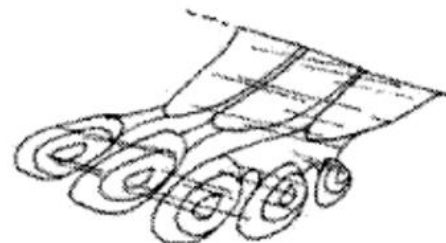
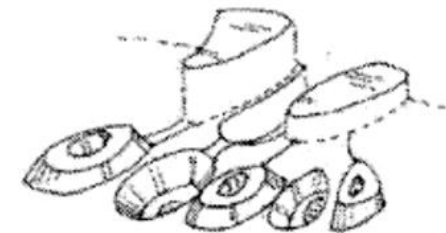
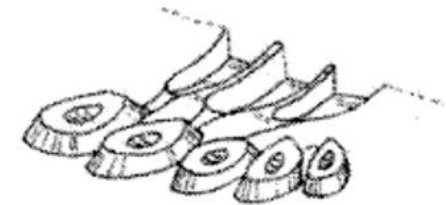
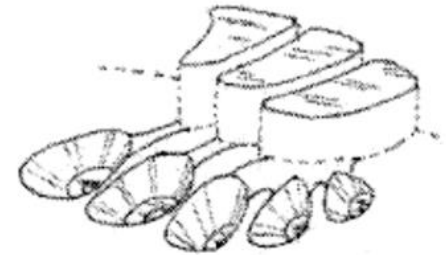
# Design Patent Prosecution - Views

- **Number of views?**
  - More views (6-7) can be advantageous to avoid §112 issues and prepare for foreign filings.
  - Fewer views (< 6) may provide broader infringement coverage. See *In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018).

FIG. 1



*In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018).

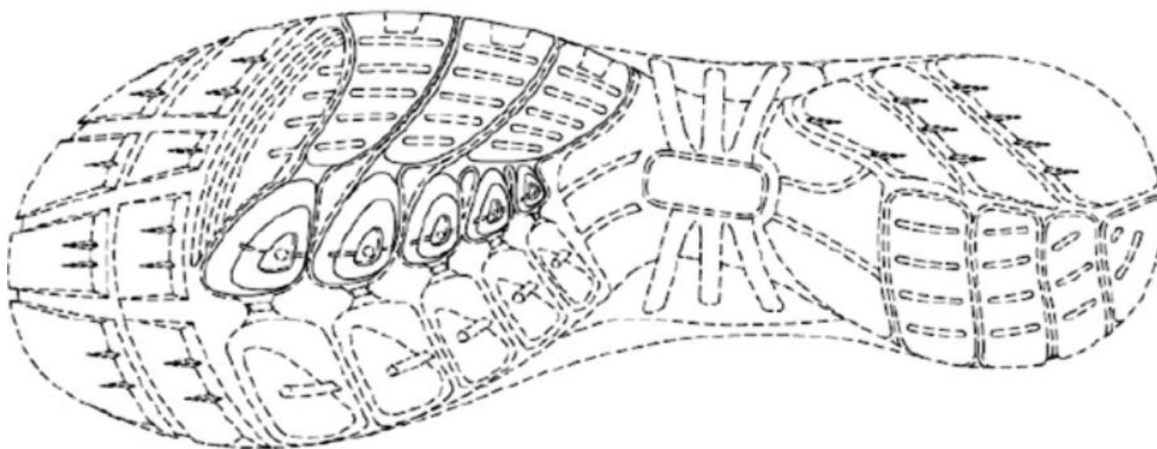


J.A. 4; accord J.A. 71.

# Design Patent Prosecution - Views

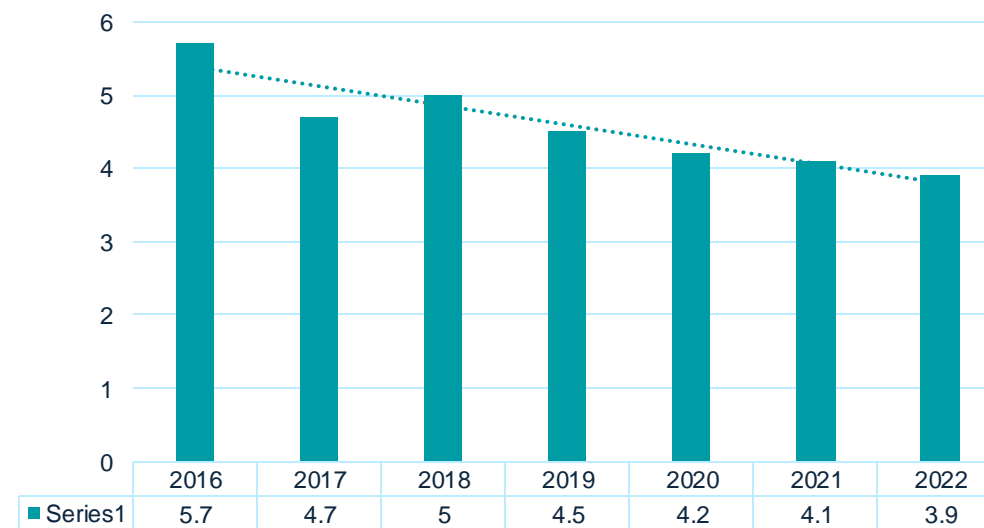
- Number of views?
  - **Practice Tip:** File both broad embodiments (e.g., fewer figures) and narrow embodiments (e.g., more figures).

FIG. 1



*In re Maatita*, 900 F.3d 1369 (Fed. Cir. 2018).

Total Figures per Patent By Issue Year



Source: USPTO  
Date: Jan. 2023

# Design Patent Prosecution – Embodiments

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- **Single v. Multiple Embodiments in a Single Application?**
  - **Advantages of filing multiple embodiments:**
    - If you get a restriction requirement, then you can pursue divisional applications with the benefit of safe harbor rules.
    - If restriction requirement is not issued, several design embodiments obtained with fewer filing/examination fees.
    - However, beware of including too many alternative embodiments. See e.g., *Pac. Coast Marine Windshields Ltd. V. Malibu Boats, LLC*, 739 F.3d 694, 698 (Fed. Cir. 2014).
  - **Disadvantages of filing multiple embodiments:**
    - Increased upfront drawing fees.
    - Can delay timing for patent issuance
- **May use an appendix:**
  - Can include additional drawings with different titles, descriptors, images, and views of the design to provided added support for present or future claimed designs.

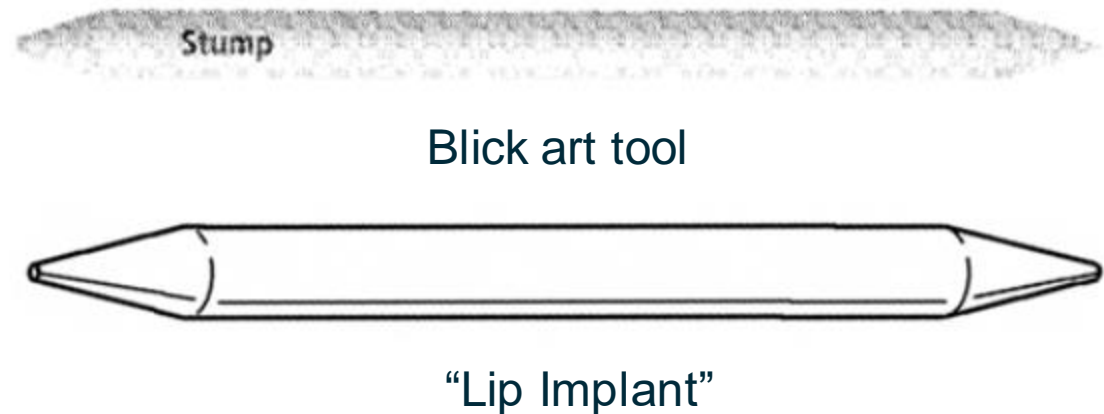


# Design Patent Prosecution - Title

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- **The Title Matters!**

- The title is limiting in design patents.
- **Practice Tip**: Carefully consider the prior art and potential enforcement when deciding on the right title for your design.

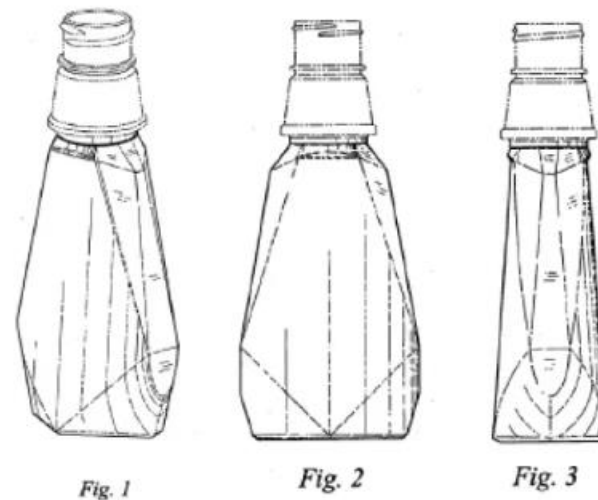


*In re SurgiSil, L.L.P.*, No. 2020-1940, 2021 WL 4515275 (Fed Cir. 2021)

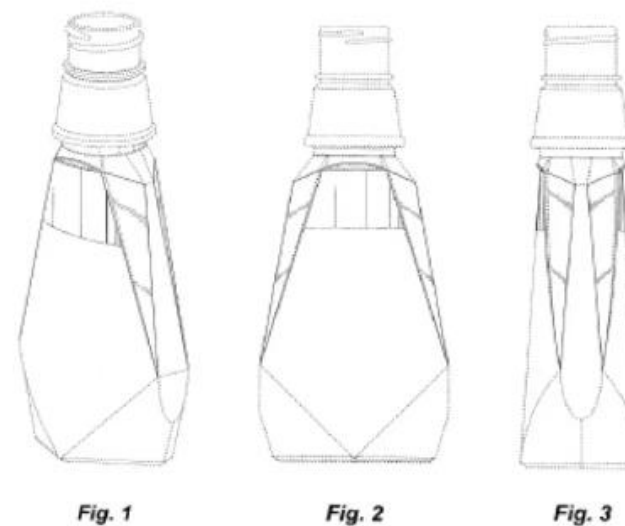


# Design Patent Prosecution – Line Amendments

- **Can prosecution amendments result in a new matter rejection?**
  - Usually not when you change a solid line to a dashed line. See e.g., *In re Daniels*, 144 F.3d 1452 (Fed. Cir. 1998).
  - Yes, when you introduce a new line, e.g., a solid or dashed line. See e.g., *In re Owens*, Appeal No. 2012-1261 (Fed. Cir. 2013).
  - **Practice Tips:**
    - When considering which lines you want to claim (solid lines) and not claim (dashed lines), keep in mind that you may switch from solid to dashed lines during prosecution, but other line changes may be subject to §112 issues.
    - Consider adding text in the description section to describe alternative design options and/or mitigate written description issues.



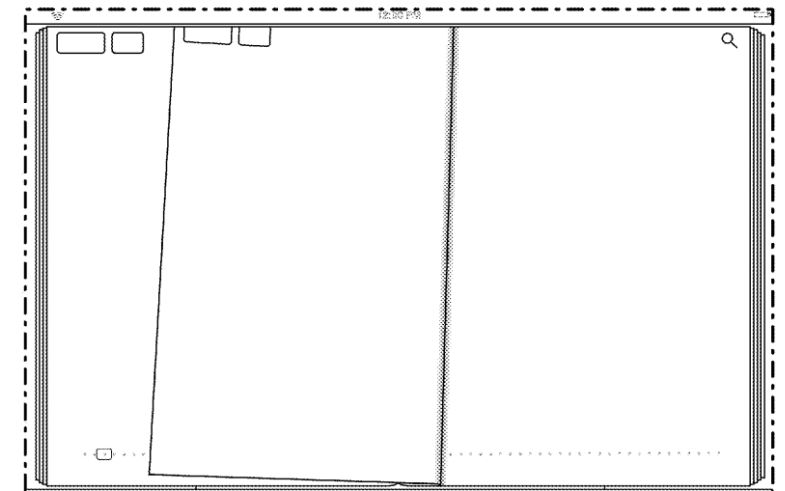
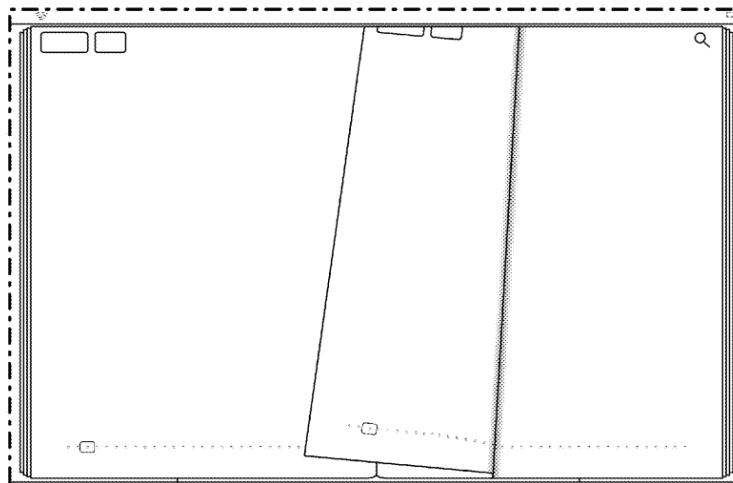
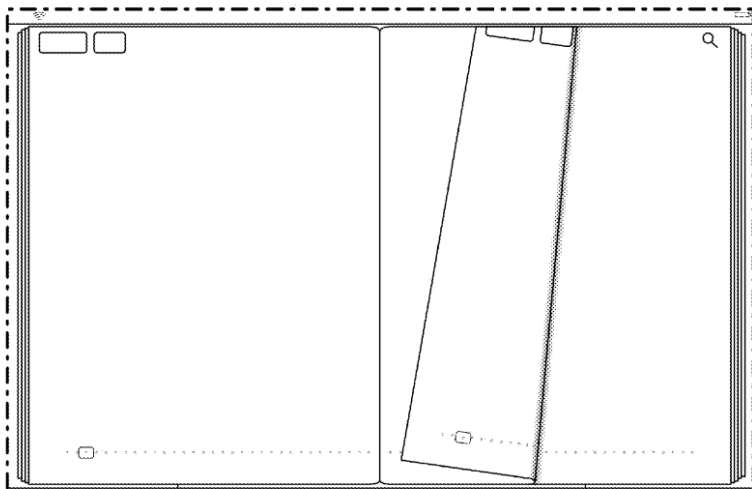
'709 Application



'172 Application

# Prosecution practice points – GUI Design Patents

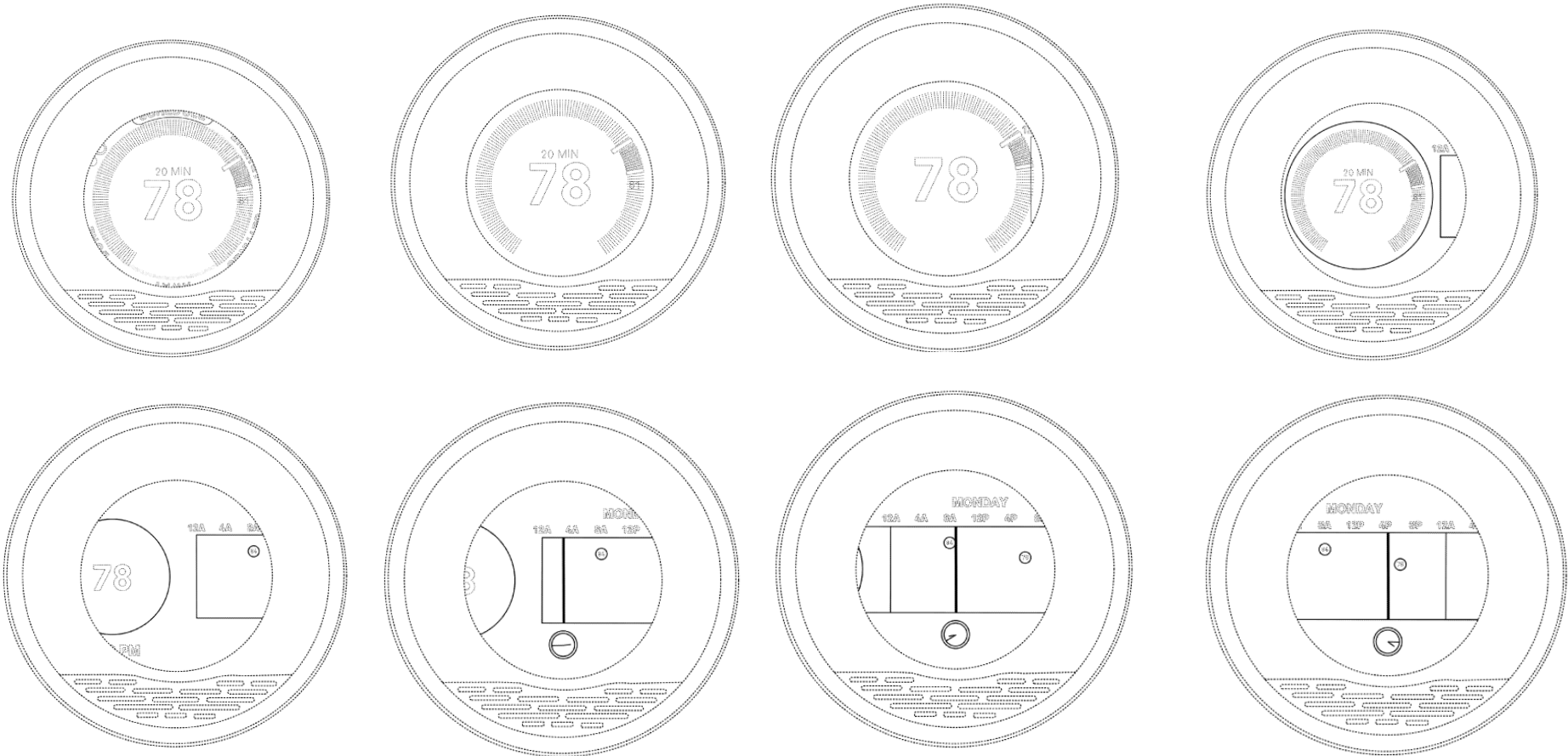
- For graphical user interface (GUI) design patents:
  - Static vs. animated GUI
  - **Practice Tips:**
    - Satisfy the “article of manufacture” requirement by putting a display screen (rectangular box) in dashed lines around what you want to claim.
    - Describe the GUI as a “display screen or portion thereof with graphical user interface.”
    - For animated GUIs, describe the sequence for animation GUI design patents, e.g., “The appearance of the animated images sequentially transitions between the images shown in FIGS. 1-3. The process or period in which one image transitions to another forms no part of the claimed design.”



D669906

# Best prosecution practices for design applications

- **Consider number of views to show in an animated GUI design patent.**
  - A GUI design patent with nine views:



D687047

# Best prosecution practices – Summary

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- **Summary Points:**

- File both utility and design patents to obtain complementary IP coverage, but consider the interplay between functional parts/elements described in your utility patent and those being claimed in your design patent.
- Carefully consider the right title for your design as it will impact both the prior art (patentability) and infringement (enforcement).
- Keep in mind that you may switch from claimed features (solid lines) and unclaimed features (dashed lines) during prosecution, but other changes may be subject to §112 issues. Also, consider adding text descriptions to describe your design.
- Consider strategically filing multiple embodiments in a single application. You can also submit appendices drawings to provide added written support for design applications.

# Thank You!



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**FISH.**