

UNITED STATES DESIGN PATENTS

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September 6, 2003

Design protection: U.S. & Europe

- ◆ In U.S., design patent is closest similarity to European design registration
- ◆ Both protect designs
- ◆ Both use drawings or photos
- ◆ Many differences

U.S. Design Patents: Overlap

- ◆ Possible to obtain U.S.:
 - Design patent (ornamental),
 - Utility patent (functional),
 - Trademark with design
 - Copyright AND
 - Trade dress
- ◆ All for same product design

U.S. Design Patents: Costs

- ◆ USPTO Filing Fee
 - \$165 small entity (<500 employees)
 - Or \$330 for large entity
- ◆ USPTO Issue Fee
 - \$235 small entity/\$470 large entity
- ◆ No maintenance fees
- ◆ Attorney fees
 - About \$1,000 minimum to prepare and file
 - About \$500 minimum add'l through issue

U.S. Des Pat: Term & Priority

- ◆ Term: 14 years from issue date
- ◆ PCT not available
- ◆ Foreign priority: 6 months, Paris Convention
- ◆ No priority from provisional
- ◆ No publication



I. SCOPE OF U.S. DESIGN PATENTS

BFFM PATENT LAW FIRM,
CHICAGO, USA

U.S. Designs Are *Patents*

- Search
- Examination
 - Formalities
 - Ornamentality (not primarily functional)
 - Novelty
 - Non-Obviousness (Inventive Step)

U.S. Designs Are *Patents*

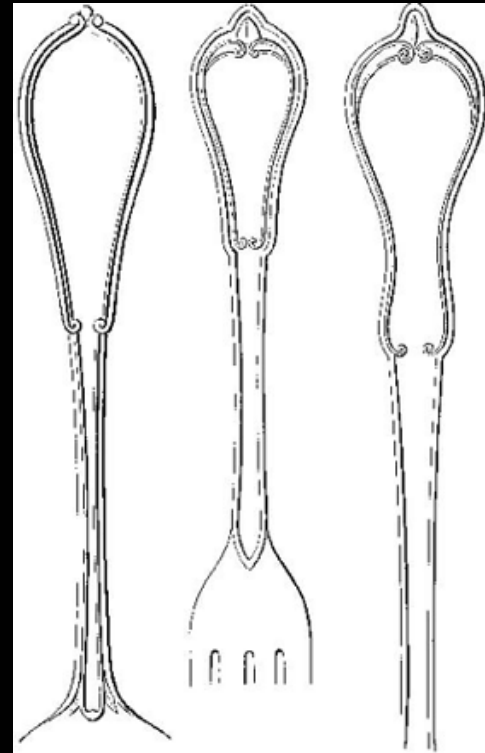
- Drawings Most Important
 - Examination
 - Interpretation
 - Infringement Analysis

Gorham “Ordinary Observer” Test

If in the eye of an
ordinary observer
two designs are
substantially the
same . . .

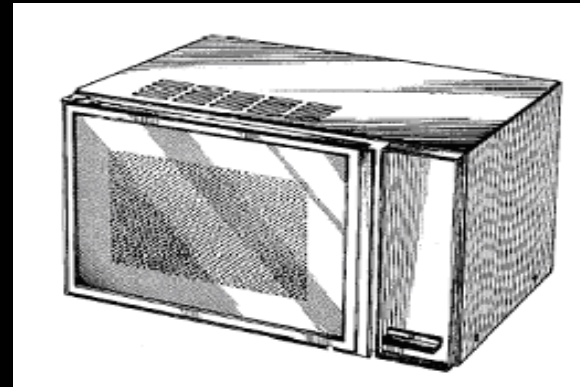
Gorham v. White
(1871)

➔ **Infringement**



Litton Point-of-Novelty Test

- The court must still consider “point of novelty” in determining infringement.
- In a crowded field of art, the court determines a narrow scope of the design.

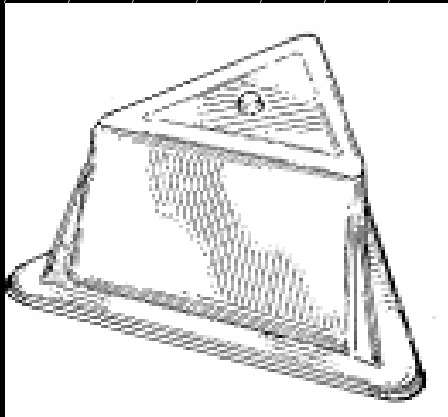


*Litton Systems v.
Whirlpool (1984)*

Markman Verbal Construction

- ◆ *Markman v. Westview Instruments, Inc.* (Fed. Cir. 1995), *aff'irmed*, (U.S. Supreme Court 1996)
- ◆ *Markman* requires the court to construe the claim before applying infringement tests.
- ◆ First applied to utility patents, now applied to design patents.
- ◆ U.S. courts “construe” design drawings in words (limiting).

Markman Verbal Construction



Elmer
Patented
Design



Accused
Design

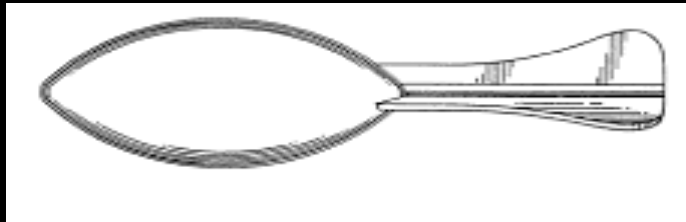
The court construed the claim and limited it “to a vehicle sign having ... triangular vertical ribs and an upper protrusion.”

Elmer v. ICC Fabricating (1995)

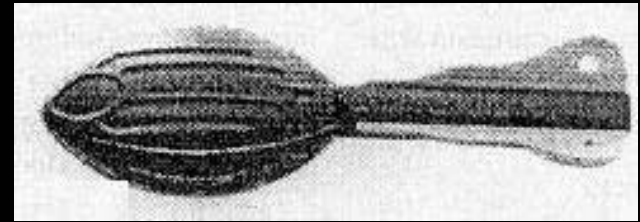


**No
Infringement**

Markman Verbal Construction



OddzOn Design



Accused Design

The court construed the claim as follows: “[A] ball shaped like a football, with a slender, straight tailshaft projecting from the rear of the football. In addition, the ... [p]atent design has three fins symmetrically arranged around the tailshaft, each of which has a gentle curve up and outward which creates a fin with a larger surface area at the end furthest from the ball. The fins flare outwardly along the entire length of the tailshaft, with the front end of the fin extending slightly up along the side of the football so that the fins seemingly protrude from the inside of the football.”

*OddzOn Products v.
Just Toys (1997)*



**No
Infringement**

A Call for Return to *Gorham v. White*

- *Markman* “verbal construction” should not apply to design patents
- Nothing in *Markman* to suggest the Supreme Court intended to overrule “ordinary observer” test of *Gorham v. White*
- U.S. Supreme Court needs to decide this issue

The background is a black grid with yellow decorative elements. A horizontal line crosses the top of the grid, and a vertical line crosses the left side. Two overlapping yellow circles are positioned at the intersection of these lines. Another horizontal line is located near the bottom of the grid, and a vertical line is on the right side, with a yellow circle at their intersection.

II. PARTS OF U.S. DESIGN PATENTS

BFFM PATENT LAW FIRM,
CHICAGO, USA

PREAMBLE

Preamble includes:

- Name of applicant
- Title
- Brief description of nature and intended use of article

FIGURE DESCRIPTIONS

Figure descriptions must describe views clearly and accurately.

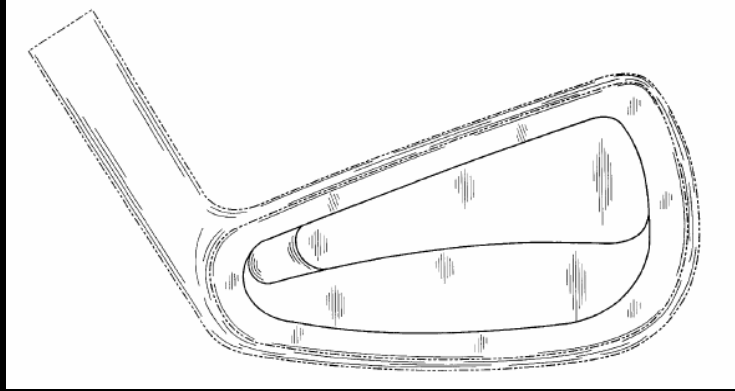
CLAIM

- Design patent application may include only single claim
- Claim is the drawing
- Multiple embodiments allowed

DRAWING DISCLOSURE

- Drawings versus Photographs
 - Drawings preferred
 - Black and white preferred
 - Color is limiting

Drawings vs. Photographs



U.S. Patent
D475427



U.S. Patent
D469834

Drawings or photographs permitted; drawings preferred.

DRAWING DISCLOSURE

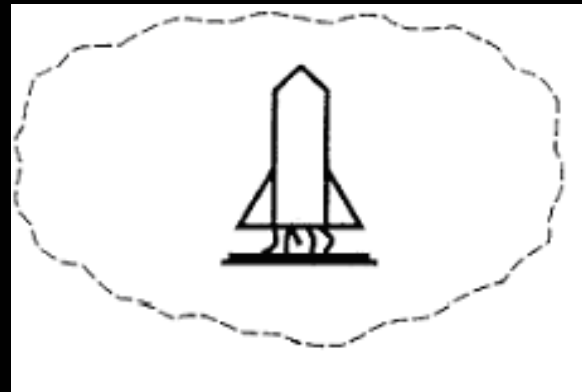
- **Views**
 - **Must adequately disclose the design**
 - **Usually 6 orthogonal views**
Front, rear, 2 sides, top, bottom
 - **Plus perspective view**

DRAWING DISCLOSURE

- **Views**

Single view for flat articles, such as computer icons

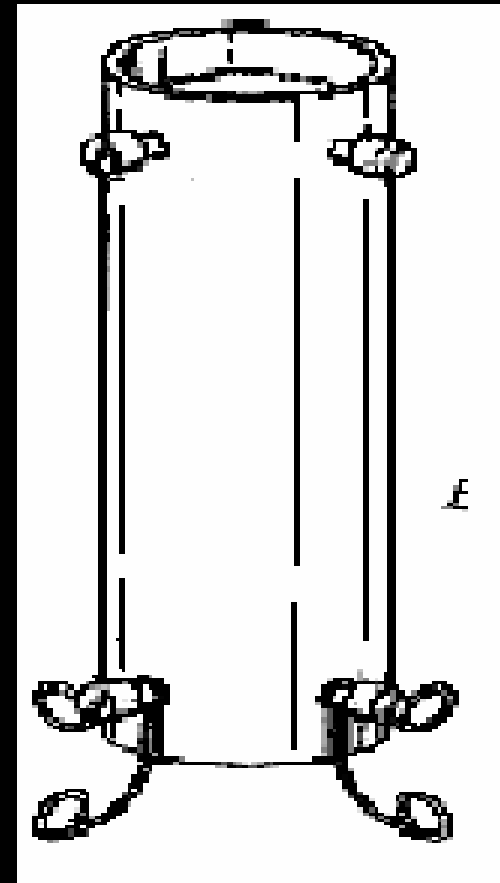
D468750



DRAWING DISCLOSURE

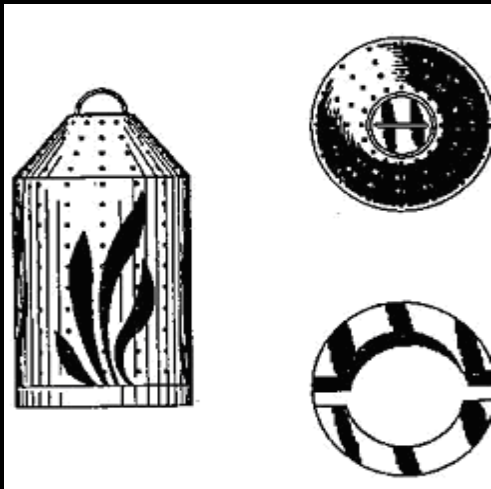
- Surface Shading

Straight line surface shading
from D400989

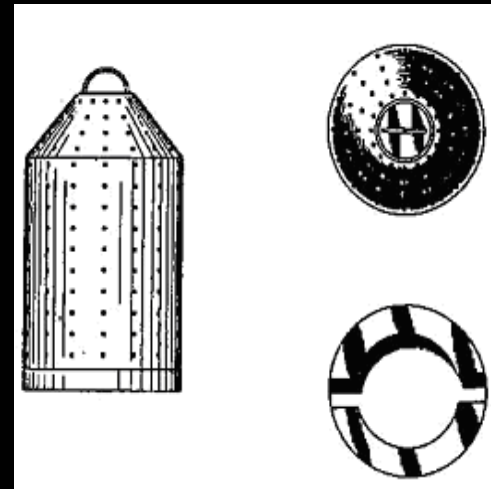


DRAWING DISCLOSURE

- Removal of surface treatment may be permitted



Original Leecher design



Continuation Leecher design

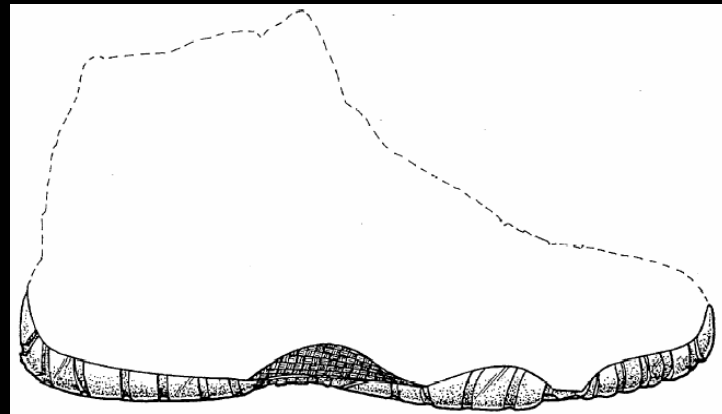
DRAWING DISCLOSURE

- Removal of drawing lines usually not permitted (new matter)
- Change broken lines to solid lines and vice versa usually permitted

DRAWING DISCLOSURE

- **Broken Lines**
 - Understood to be for illustrative purposes only
 - Increases scope of design

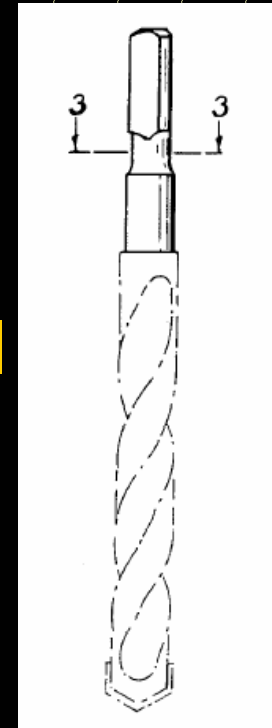
Outsole design,
D378871



DRAWING DISCLOSURE

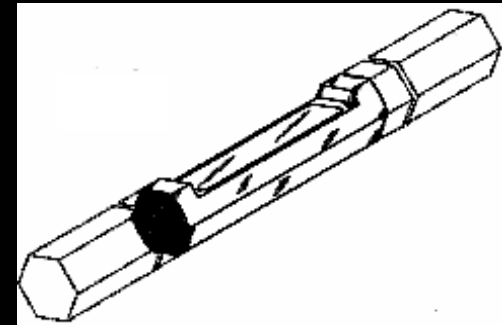
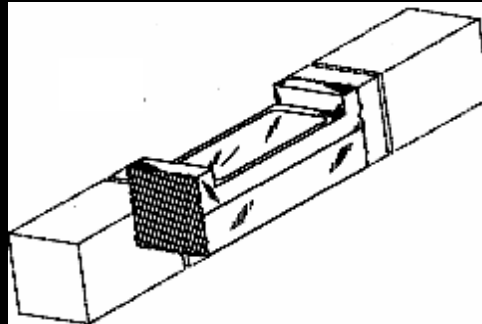
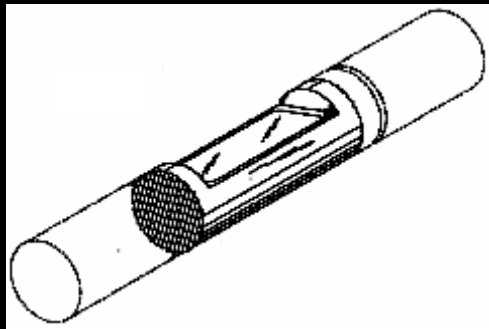
- Broken Lines
 - Identify claimed and unclaimed portions, show parts immaterial to scope of the design
 - Increase scope of design

In re Zahn



DRAWING DISCLOSURE

- Broken lines and/or multiple embodiments
- Broadens scope of design



Circle, square and hexagonal geometry for game housing
U.S. Patent D374252, prepared by Richard P. Beem

Inadequate Disclosure

Rejections

- Common in U.S. design patent practice
- Difficult to remedy (new matter)

Preferred Solution

- Instruct U.S. patent attorney to prepare drawings that comply with disclosure rules
- Saves time & money in long run & strengthens U.S. design patent

CONCLUSIONS

- U.S. designs are patents
- Subject to search and examination
- Drawings important
- Details are limiting & will be construed in words (*Markman*)
- Difficult to correct drawings after filing
- Consider preparing new drawings for filing in U.S. design patent application