

# Fordham IP Conference 2016

## Trade Dress and Design Patent Protection in the Wake of *Apple v. Samsung*

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April 1, 2016

BRINKS

GILSON

& LIONE

Utility Patent



Evidence That  
Claimed Design  
is Functional

Design Patent



Evidence That  
Claimed Design  
Is Not Functional

# Design Patents

- A design patent is granted only for a design that is primarily “ornamental” and not functional.
- Design patent thus weighs against finding of functionality – consistent with trademark protection.

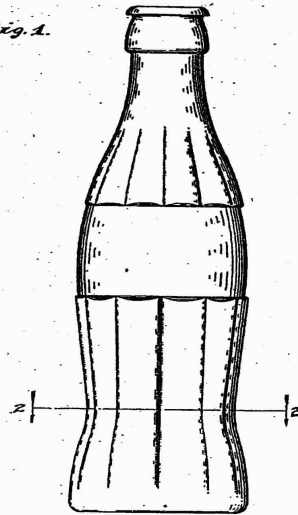
# THE COCA-COLA BOTTLE

Dec. 25, 1923.

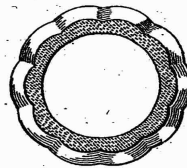
Des. 63,657

C. J. ROOT  
BOTTLE  
Filed Feb. 4, 1922

*Fig. 1.*



*Fig. 2.*



Inventor  
*Chapman J. Root,*

*Arthur M. Hood*  
Attorney

Int. Cl.: 32

Prior U.S. Cl.: 45

United States Patent Office

Reg. No. 1,057,884

Registered Feb. 1, 1977

**TRADEMARK**

Principal Register



The Coca-Cola Company (Delaware corporation)  
310 North Ave. NW.  
Atlanta, Ga. 30313

For: SOFT DRINKS, in CLASS 32 (U.S. CL. 45).  
First use July 8, 1916; in commerce at least as early as  
Sept. 1, 1916.

The mark consists of the three dimensional configura-  
tion of the distinctive bottle as shown.  
Owner of Reg. No. 696,147.

Ser. No. 88,384, filed May 25, 1976.

JOHN C. DEMOS, Examiner

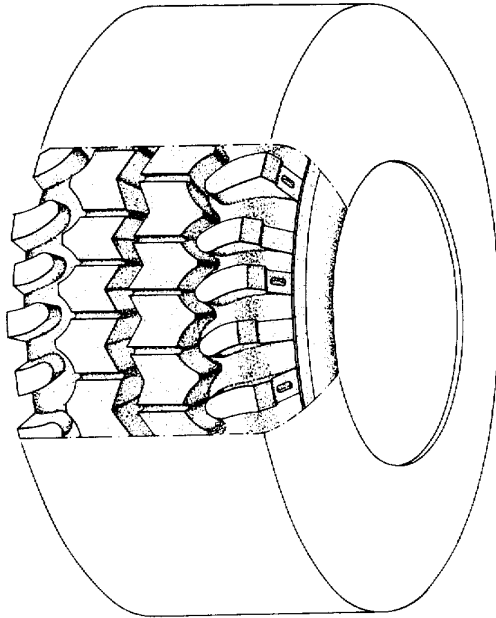
# Advantages of Design Patents

- Rarely, if ever, invalidated as functional
- Owner has a 14-year Government-protected monopoly.
- Owner can develop secondary meaning during the life of the design patent
  - Design patent helps create trademark rights;
  - Trademark rights extend beyond expiration of design patent.

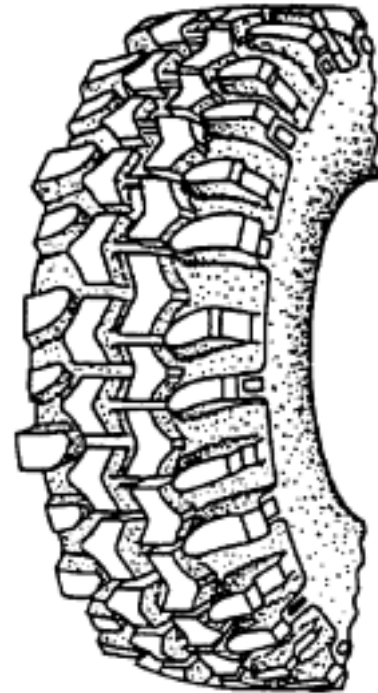
# Limits on Ability of Design Patents to Promote Trademark Rights

- Creates presumption that the claimed design is ornamental and not functional, but this presumption often is rebutted in trademark context
- Design patent, without more, does not show that the claimed design has acquired secondary meaning as a trademark.

# Tire Tread Design Example

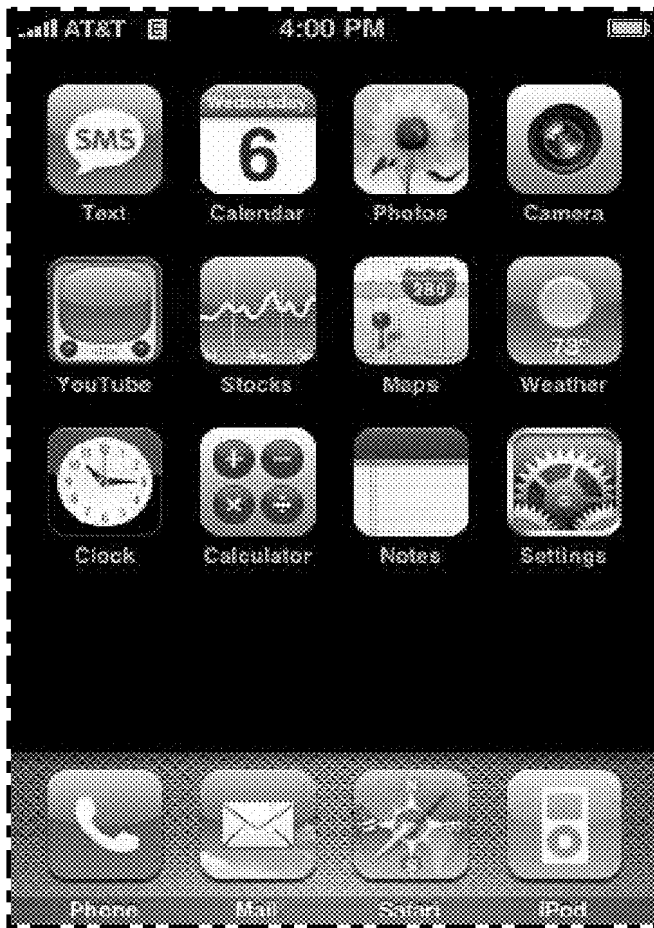


U.S. Design Patent  
No. 261,257  
(expired in 1995)



U.S. Trademark  
Serial No. 74/279,000  
(filed in 1992)





Apple Inc.,  
Design Patent D604,305



Apple Inc.,  
Trademark Reg. No.  
3,470,983

# Apple v. Samsung

- Federal Circuit found the trade dress invalid as functional.
- However, the court found the design patents valid and infringed.

# Design Patent Validity

Samsung	Apple
<ul style="list-style-type: none"><li>• No justification for interpreting functionality differently for design patents and trade dress</li></ul>	<ul style="list-style-type: none"><li>• The overall design is not “dictated by function.”</li></ul>
<ul style="list-style-type: none"><li>• If the trade dress is functional, the design patents covering the same designs should likewise be functional</li></ul>	<ul style="list-style-type: none"><li>• Alternative designs are available</li></ul>

# Design Patent Infringement

Samsung	Apple
<ul style="list-style-type: none"><li>In comparing the designs, functional elements should be excluded. Only ornamental features should be compared.</li></ul>	<ul style="list-style-type: none"><li>One must evaluate the similarities in the overall designs, not the similarities of ornamental features in isolation.</li></ul>
<p>Samsung's cert petition (denied):</p> <p>“Where a design patent includes unprotected non-ornamental features, should a district court be required to limit that patent to its protected ornamental scope?”</p>	

# Design Patent Damages

Utility Patents	Design Patents
<p data-bbox="320 439 664 486">35 U.S.C. § 284</p> <ul data-bbox="146 501 716 604" style="list-style-type: none"><li data-bbox="146 501 716 548">•The patentee's lost profits</li><li data-bbox="146 558 600 604">•A reasonable royalty</li></ul>	<p data-bbox="1128 439 1472 486">35 U.S.C. § 289</p> <ul data-bbox="967 501 1750 832" style="list-style-type: none"><li data-bbox="967 501 1750 604">•Additional remedy for design patent infringement</li><li data-bbox="967 614 1750 832">•Infringer shall be liable to the owner to the extent of his <b><u>total profit</u></b> (not just the profit attributable to the infringing designs).</li></ul>
<p data-bbox="146 915 871 962">Samsung's cert petition (granted):</p> <p data-bbox="146 1033 923 1305">“Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?”</p>	<ul data-bbox="967 915 1750 1076" style="list-style-type: none"><li data-bbox="967 915 1750 1076">• Federal Circuit finds the statute unambiguous. Go to Congress to change the law, not the courts</li></ul>

## Concerns Urged on Supreme Court:

Decision will lead to:

- An increase in design patent lawsuits;  
and
- Windfalls to design patent owners

