

21st Fordham Conference on IP Law and Policy

Design Protection in the United States

John Richards

Ladas & Parry LLP

E-mail: iferraro@ladas.com
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Steve Jobs in 2003

- People think it's this veneer — that the designers are handed this box and told, 'Make it look good!' That's not what we think design is. It's not just what it looks like and feels like. Design is how it works.
- No wonder Apple is so enthused about design patents!

Design at the Intersection of IP Rights

- Different countries have different approaches:
- In some copyright type approach – France; UK and EU unregistered design rights;
- Others unfair competition (Germany) or marketing rights to prevent slavish copying (Scandinavia).

Limitations of copyright in US

- 17 USC 101 provides that:
- the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and **only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article**

What about Trademark Protection for a design?

The mark must be “used in commerce” or the subject of a person’s bona fide intention to use in commerce.’ With the exception of trademarks based on issued foreign trademarks, registration is permitted only for the goods on which the mark is used.

- Trademark protection for product shapes or trade dress is possible in certain instances. However, in the seminal case **Wal-Mart Stores Inc. v. Samara Brothers Inc.**, the Supreme Court narrowed protection to those instances where the trade dress had acquired secondary meaning through use and this was considered “distinctive”. Design, is not inherently distinctive almost invariably, not intended to identify the source but to render the product itself more useful or appealing.

So we come to Design Patents

- Design patents are not subject to these limitations, and indeed it is not uncommon for companies to obtain design patents first and then once distinctiveness has been acquired by use seek trademark protection for the same design.
- US – mainly a patent type approach with trademark overtones

35 USC 171

- 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.
- The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Design patent protection is subject to most of the requirements of ordinary (utility) patents The exceptions are

- The term of protection is 14 years from the grant of the patent;
- There is no publication of the application eighteen months from filing;
- The convention priority term is six months;
- There are no maintenance fees to be paid on design patents.
- Additionally the design must be original and ornamental as well as being new and non-obvious

Design patents require a claim

- 37 CFR 1.53 requires a claim.
- The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

“for”

- The use of the word “for” rather than “of” in an article is important because it means that it is not necessary to claim the entire article. A design “for” an article may apply to only parts of the article.
- This is typically achieved by showing unclaimed parts of the article in broken lines in the drawings.

“Ornamental”

Case law has established two requirements:

- What it looks like matters at sometime during the existence of the article *In re Webb* – hip joint;
- The shape should not be dictated by the function the article is to perform – if there are other ways of performing the function, this argues for the design being ornamental of *LA Gear, Inc. v. Thom McAn Shoe Company*-collection of functional features on a shoe does not mean design of shoe dictated by function.

Gorham v. White

- Test for infringement of design patents is:
- If, in the eye of the 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", then there is infringement

Contessa Food Products Inc. v. Conagra Inc

- One must compare the entire design shown in the patent claim and not just those parts that are “ornamental” when deciding infringement.
- The back of shrimp display was different

Contessa Food Products Inc v. Congara Inc – no infringement

US000404612S

United States Patent [19] [11] **Patent Number: Des. 404,612**
 [45] **Date of Patent: Jan. 26, 1999**

SHRIMP TRAY WITH SHRIMP
 Inventor: **John Z. Blazevich**, P.O. Box 1950, San Pedro, Calif. 90753-1950
 Attorney: **14 Years**
 U.S. Pat. No.: **84,491**
 Date of Issue: **Mar. 3, 1998**

Related U.S. Application Data
 Division of Ser. No. 09,832, Sep. 18, 1996.
 Int. Cl. Class. **D7-01**
 U.S. Class. **D7-008; D7-057; D7-054; D7-053**
 Field of Search **D7-053, 335, 305, D7-043, 545, 546, 548, 549, 550, 552, 557, 206, 376, 220, 505, 23.2, 555**

References Cited
 U.S. PATENT DOCUMENTS
 02 5,917 Fisher D7-046
 06 3,938 Smith D7-087
 06 4,954 Renschal et al. D7-030
 58 11,098 Matus D7-508
 59 11,988 Ames D7-533 X

OTHER PUBLICATIONS
 Lady Susan, Harper's Bazaar, Nov. 1947, p.147.
 Primary Examiner—M. N. Pendzisi
 Attorney Agent or Firm—Frosty Schroeder & Poplewski

CLAIM
 [57] I claim the ornamental design for a serving tray with shrimp, as shown and described.

DESCRIPTION
 FIG. 1 is a top perspective view of a serving tray with shrimp showing my new design.
 FIG. 2 is a top plan view thereof;
 FIG. 3 is a side elevational view thereof;
 FIG. 4 is a bottom plan view thereof; and
 FIG. 5 is a sectional view taken along line 5-5 of FIG. 3.

1 Claim, 3 Drawing Sheets

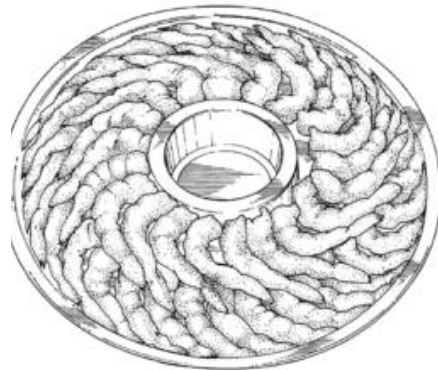


FIG. 4

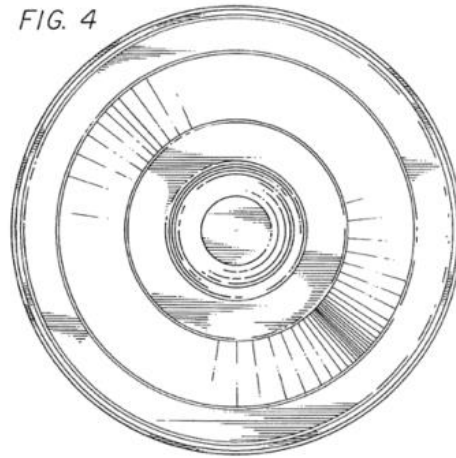
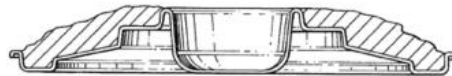


FIG. 5



Led to realization that proper use of broken lines for the back would have given a different result

- One must compare the ornamental features of the patented design, as shown in all the drawings, to the features of the alleged infringing product visible at any time during normal use of the product and assess if the resemblance at such point is such as to deceive... an ordinary observer, giving such attention as a purchaser usually gives "inducing him to purchase one supposing it to be the other." ... [T]he "ordinary observer" analysis is not limited to those features visible at the point of sale, but instead must encompass all ornamental features visible at any time during normal use of the product.

Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co

- The purchaser in question is the purchaser of the allegedly infringing product.
- The design patent was for a “tire” and did not specify the type of vehicle on which it was to be used. The alleged infringement was a truck tire.
- Held the “ordinary observer” was a purchaser of truck tires rather than car tires and so the relevant similarities and differences to be considered were those occurring in truck tires

Egyptian Goddess v. Swisa

- In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving ... the designs are ... “substantially the same” to the ordinary observer In other instances ... resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from comparison of the claimed and accused design with the prior art ... Where there are many examples of similar prior art designs, ... differences ... that might not be noticeable in the abstract can become significant.

Crocs Inc. v. International Trade Commission,

- Combinations of old features can still produce “an overall appearance deceptively similar to the accused design”. The court noted “if the claimed design and the accused designs were arrayed in matching colors and mixed up randomly, this court is not confident that an ordinary observer could properly restore them to their original order without very careful and prolonged effort”.

Richardson v. Stanley Works Inc

- If an overall impression of similarity exists but this is due to necessary functional features, infringement is unlikely to be found.

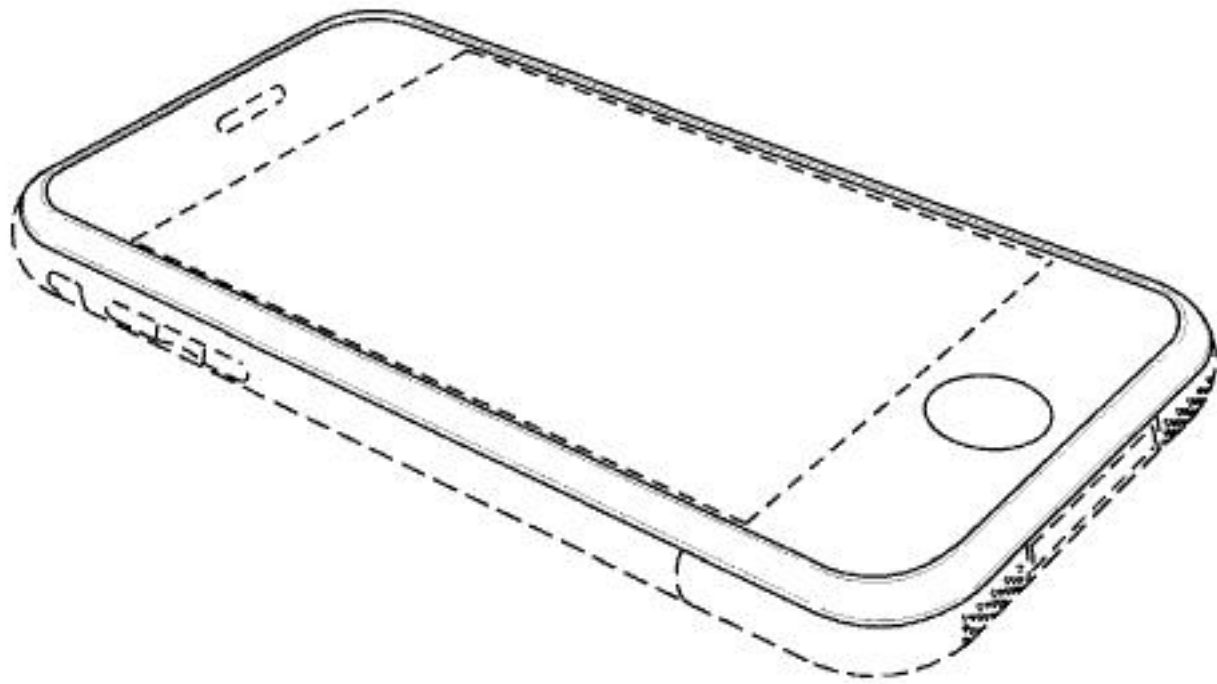
Apple v. Samsung

Jury verdict DC Northern California

- D593,087, D618,677 found valid and infringed
- Both patents claim a minimalist design for a rectangular smartphone consisting of a large rectangular display occupying most of the phone's front face. The corners of the phone are rounded. the design contains no ornamentation.

- The D'087 patent claims a bezel surrounding the perimeter of the phone's front face and extending from the front of the phone partway down the phone's side.
- The D'677 patent does not claim a bezel but instead shows a black, highly polished, reflective surface over the entire front face of the phone.

D593,087



D593087 – valid and infringed

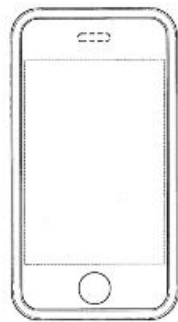


FIG. 3



FIG. 4



FIG. 7

FIG. 8

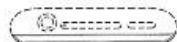
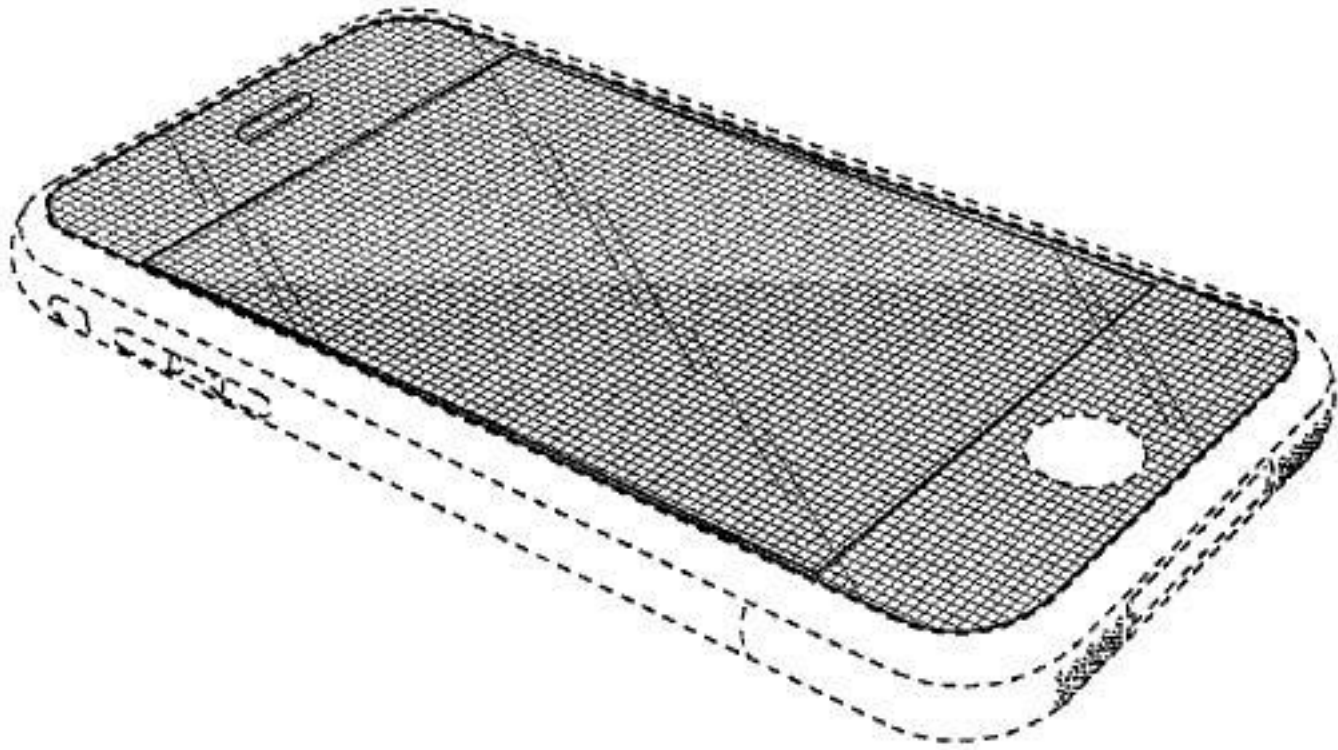


FIG. 5



FIG. 6

D618677



US 618677 Fig 2

Patent Images

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U.S. Patent

July 29, 2003

Sheet 1 of 2

US D618,677 S

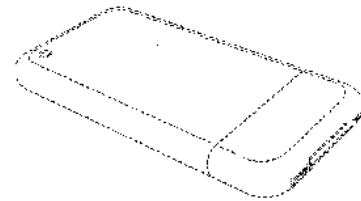


FIG. 2

- Figure 2 shows the back of the phone depicted entirely in broken lines

D 604305

- Arrangement of icons on a screen, the shape of the screen being disclaimed by use of broken lines.
- Claim:
- The ornamental design for a graphical user interface or portion thereof as shown and described

D604,305

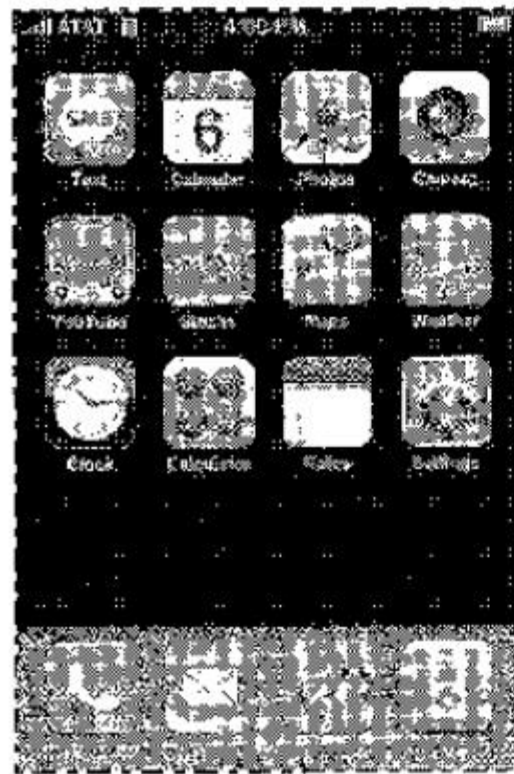


FIG. 1

Animated Icons and Interfaces

- MPEP 1504.01(a) IV. The practice is to show different depictions of the icon and include in the description an explanation that the image changes. The MPEP gives a number of possible examples, one of which is as follows:
- “The appearance of the transitional image sequentially transitions between the images shown in Figs. 1-8. The process or period in which one image transitions to another image forms no part of the claimed design;”

D637,606 (HTC)

- FIG. 1 is a front view of a transitional graphic user interface for a display screen showing our new design;
- FIG. 2 is a front view of the second image thereof;
- ...
The broken line showings of the display screen, patterns, and characters are for illustrative purposes only and form no part of the claimed design. The appearance of the ***transitional image*** sequentially transitions between the images shown in FIGS. 1-5. The process or period in which one image transitions to another image forms no part of the claimed design.

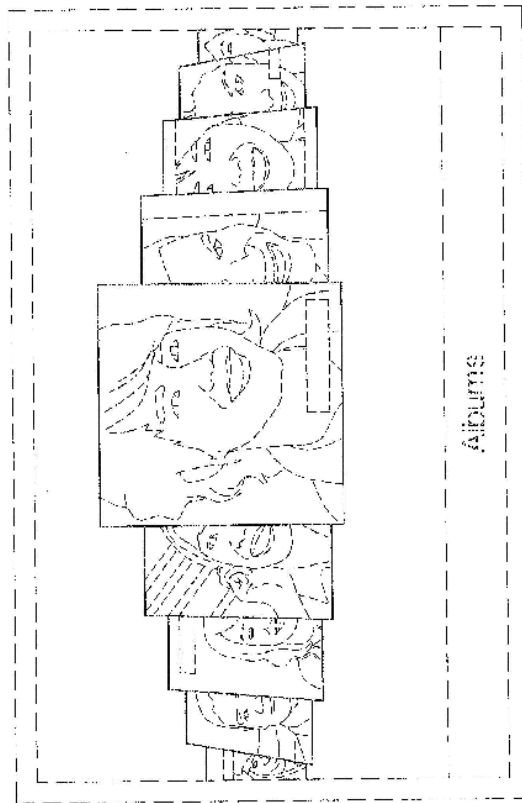


FIG. 1

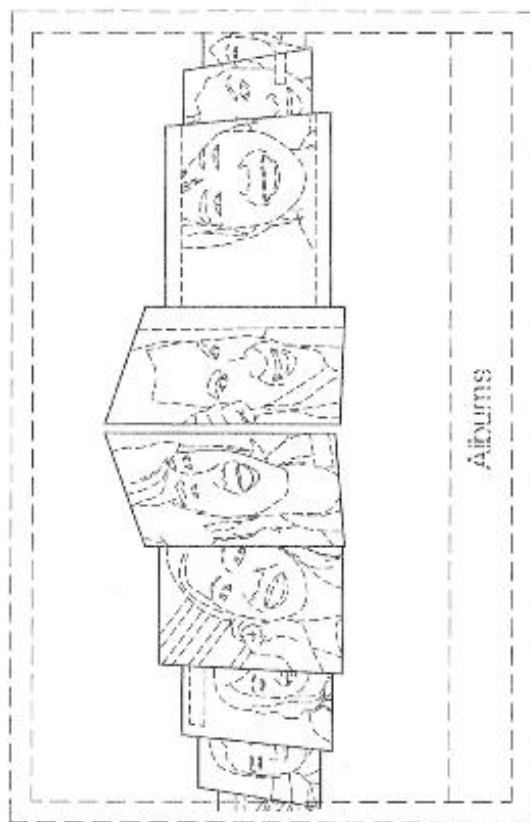


FIG. 3

The Title is Important

- Since protection is given to what is claimed and the name of the article is what is set out in the claim, care should be taken over the title.
- Most smart phones now call themselves “electronic devices” for this reason.

D614,077 – The Gomboc (self-righting shape)

- **Granted Claim:** The ornamental design for package, jewelry item, teaching aid, game piece or promotional item, as shown and described.
- The application was filed as simply being an “artifact” – but included a description of possible uses in the specification. The PTO refused “artifact” but allowed the above.

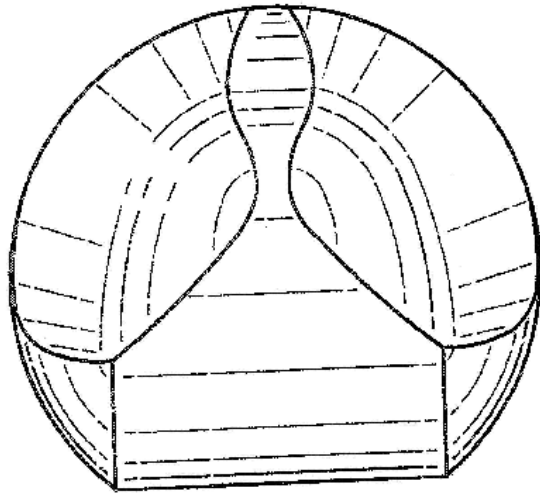


FIG. 1

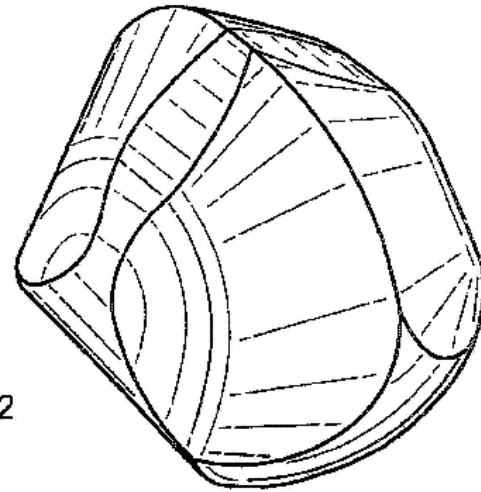


FIG. 2

Obtaining Breadth in Design Patents

Three ways

- Use of broken lines
- Use of multiple embodiments and resisting restriction requirement
- Choice of Title

Risk: broad claims open one to attack by more prior art.

- Citing of prior art is rare but can occur when there are multiple embodiments or broken lines.
- A claim covering multiple embodiments covers not only those embodiments themselves but also that which is common to the those embodiments and so exposes the claim to anticipation by anything else possessing those common features.

- A drawing with broken lines covers other designs that share the features shown in solid lines but not necessarily those shown in broken lines.
- Always a judgment call to be taken in the light of the known prior art whether to use broken lines or to include multiple embodiments in an individual design patent application.

Risk of Peanut Butter and Jelly Patent Syndrome

- There is always a risk that if design patents come to be used to cover insignificant features, they will come to be seen in the same light as US 6,004,956 ridicule of which by the Wall Street Journal and elsewhere was a triggering event on the road to KSR.

Thank You!

Feel Free to direct any questions you may have to:

Presenter: John Richards

✉ iferraro@ladas.com

☎ +1.212.708.1800

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