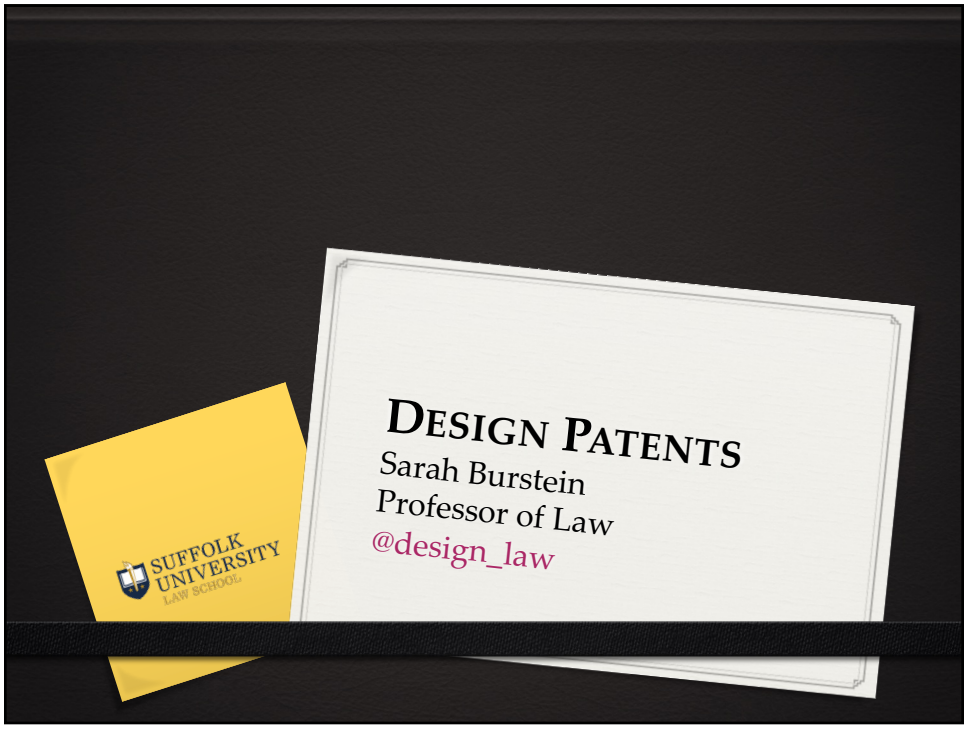


1

The Design IP Landscape

In the United States, at least

2

U.S. Design Protection

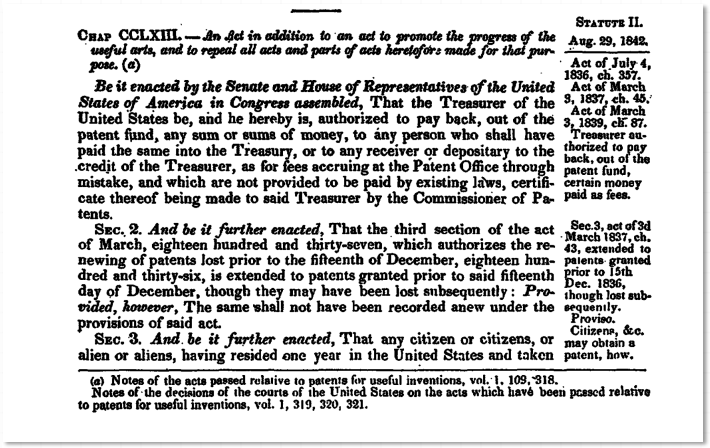
3

The new kids on the block

- Copyright (since mid-20th c.): Protects designs for original pictorial, graphic & sculptural works; audiovisual works
- Trademark (since late 20th c.): Protects product designs if they're nonfunctional & have acquired distinctiveness

4

The original



STATUTE II. Aug. 29, 1842.

CHAP. CCLXIII. — *An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.* (a)

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to said Treasurer by the Commissioner of Patents.

Act of July 4, 1836, ch. 357. Act of March 3, 1837, ch. 45. Act of March 3, 1839, ch. 87. Treasurer authorized to pay back, out of the patent fund, certain money paid as fees.

SEC. 2. *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided, however*, The same shall not have been recorded anew under the provisions of said act.

Sec. 3, act of 3d March 1837, ch. 43, extended to patents granted prior to 15th Dec. 1836, though lost subsequently. Proviso.

SEC. 3. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States and taken

Citizens, &c. may obtain a patent, how.

(a) Notes of the acts passed relative to patents for useful inventions, vol. 1, 109, 318.
Notes of the decisions of the courts of the United States on the acts which have been passed relative to patents for useful inventions, vol. 1, 319, 320, 321.

5

	Design patent	Copyright	Trademark
Term	15 years	100+ years	Unlimited
Subject matter	Designs for articles of manufacture	Works of authorship	Shapes & surface designs that primarily indicate source*
Important limits	In theory…	Fair use, various others	First amendment, functionality
Notable Remedies	"Total profits"	Statutory damages	Treble damages, injunctions

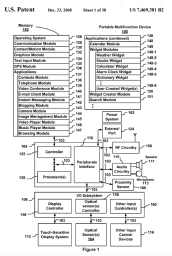
6

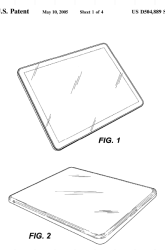
Patents

Utility Patents

Design Patents

Plant Patents





7

Like utility patents

- Granted by the USPTO following substantive examination.
  - Must be novel & nonobvious (different tests)
- Tech background required to prosecute for others.
  - But examiners have art/design backgrounds.
- All appeals go to the Federal Circuit.
- No "use in commerce" requirement for validity or enforcement.

8

Unlike utility patents

- Term = 15 years
  - Begins at the date of issuance
- Can't claim priority to provisional apps.
- No maintenance fees
- Drawings are key
- Only one claim per patent
- Special remedy provision

9

Acquisition

How do you get a design patent?

10

Where?

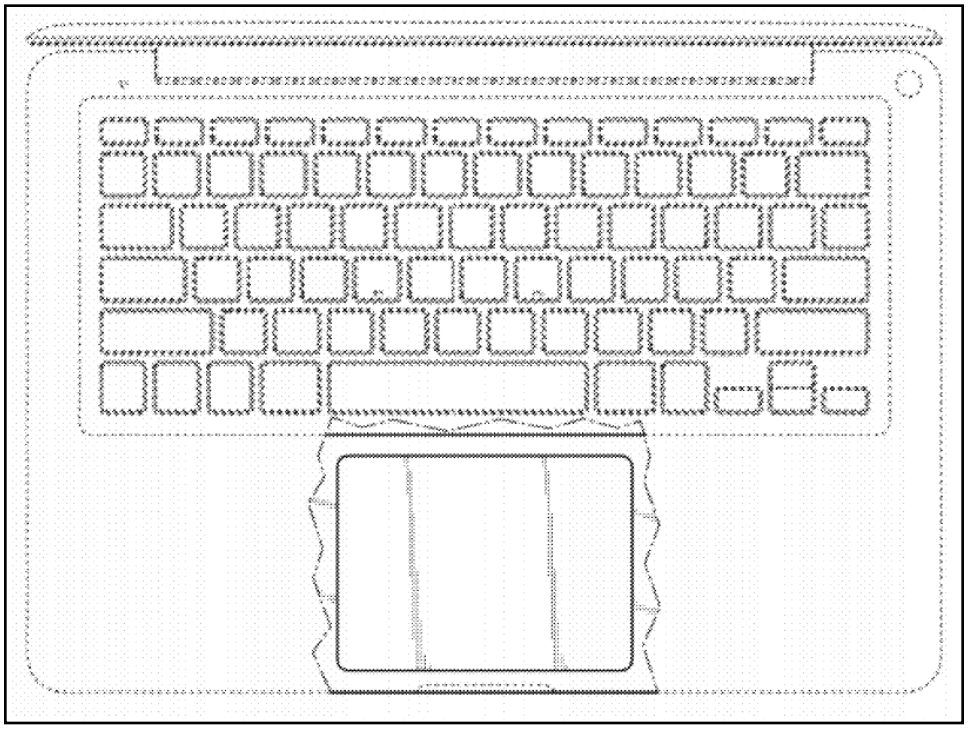
11

How?

UNITED STATES PATENT AND TRADEMARK OFFICE

WIPO | HAGUE
The International Design System

12



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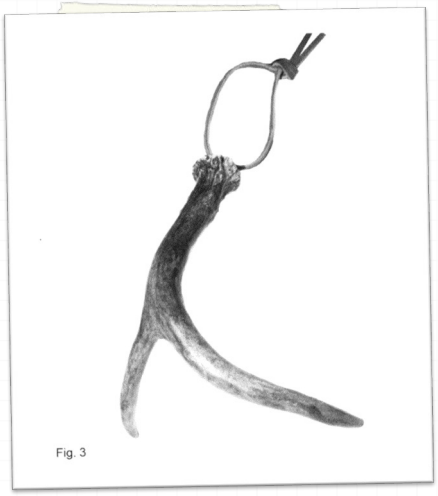
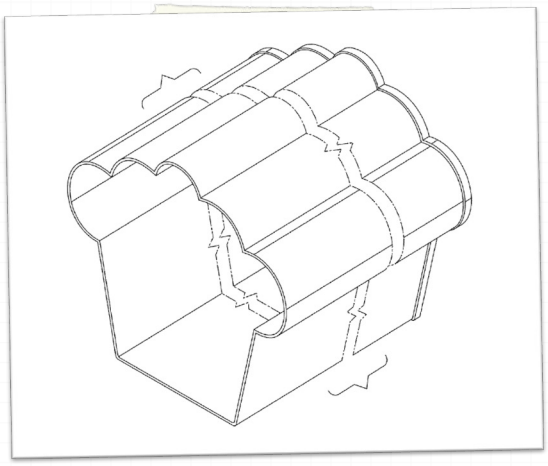


D702,150 – "Ornament"

(filed Mar. 9, 2012)

14



D711,198 – "Fruit Cutter"

(filed June 27, 2012)

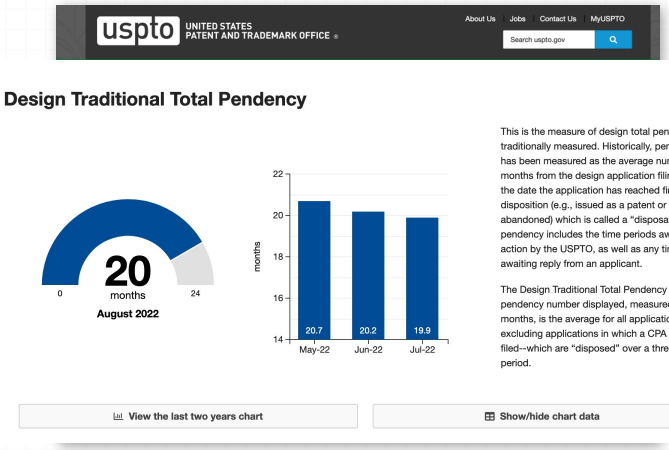
15

D604,305 – "Graphical User Interface for a Display Screen or Portion Thereof"

(filed June 23, 2007)

16

How long?



https://www.uspto.gov/dashboard/patents/design.html

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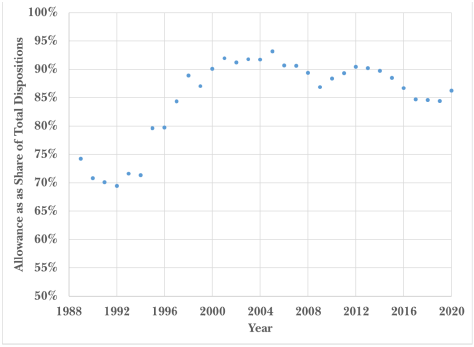
Is it very difficult?

Figure 3: Allowance of Design Applications as a Share of Total Dispositions (1989–2020)



https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

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GENERAL REGISTRATION INFORMATION

I. RECOGNITION OF ATTORNEYS AND AGENTS

The regulations governing the recognition of individuals to practice before the United States Patent and Trademark Office (USPTO or Office) in patent cases are set forth in 37 CFR §§ 11.5 (Register of attorneys and agents in patent matters), 11.6 (Registration of attorneys and agents), 11.7 (Requirements for registration), 11.8 (Oath and registration fee), 11.9 (Limited recognition in patent matters), and 11.16 (Law School Clinic Certification Program).

The USPTO Director is given statutory authority to require a showing by patent practitioners that they are "possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the [USPTO]." 35 U.S.C. § 2(b)(2)(D). The primary responsibility for protection of the public from unqualified practitioners before the USPTO rests with the Director of the USPTO.

https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf

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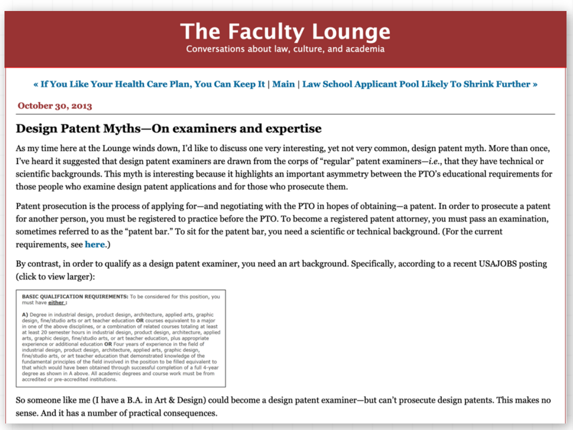
Does that make sense?



The Faculty Lounge
Conversations about law, culture, and academia

« If You Like Your Health Care Plan, You Can Keep It | Main | Law School Applicant Pool Likely To Shrink Further »

October 30, 2013

Design Patent Myths—On examiners and expertise

As my time here at the Lounge winds down, I'd like to discuss one very interesting, yet not very common, design patent myth. More than once, I've heard it suggested that design patent examiners are drawn from the corps of "regular" patent examiners—*i.e.*, that they have technical or scientific backgrounds. This myth is interesting because it highlights an important asymmetry between the PTO's educational requirements for those people who examine design patent applications and for those who prosecute them.

Patent prosecution is the process of applying for—and negotiating with the PTO in hopes of obtaining—a patent. In order to prosecute a patent for another person, you must be registered to practice before the PTO. To become a registered patent attorney, you must pass an examination, sometimes referred to as the "patent bar." To sit for the patent bar, you need a scientific or technical background. (For the current requirements, see here.)

By contrast, in order to qualify as a design patent examiner, you need an art background. Specifically, according to a recent USAJOBS posting (click to view larger):

BASIC QUALIFICATION REQUIREMENTS: To be considered for this position, you must have **either**:

A) Degree in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts or art teacher education **OR** courses equivalent to a major in one of the above disciplines, or a combination of related courses totaling at least at least 20 semester hours in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education, plus appropriate experience or additional education **OR** Four years of experience in the field of industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education that demonstrated knowledge of the fundamental principles of the field involved in the position to be filled equivalent to that which would have been obtained through successful completion of a full 4-year degree as shown in A above. All academic degrees and course work must be from accredited or pre-accredited institutions.

So someone like me (I have a B.A. in Art & Design) could become a design patent examiner—but can't prosecute design patents. This makes no sense. And it has a number of practical consequences.

https://www.thefacultylounge.org/2013/10/design-patent-examiners.html

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Is a change coming?

https://www.federalregister.gov/documents/2022/10/18/2022-22569/expanding-admission-criteria-for-registration-to-practice-in-patent-cases-before-the-united-states

21

Requirements

What kinds of designs are patentable?

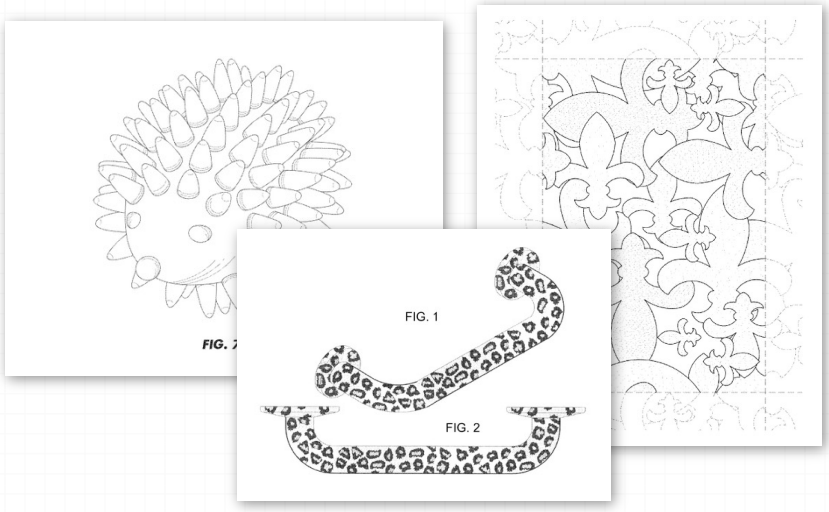
22

35 U.S.C. § 171(a)

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.

23

"Design for an article of manufacture"



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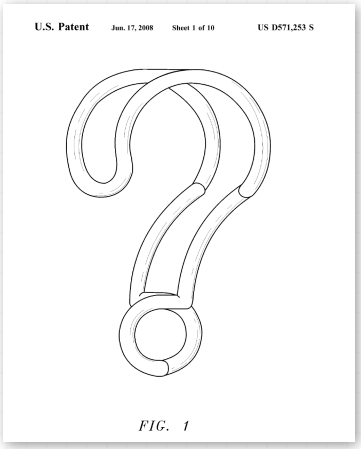
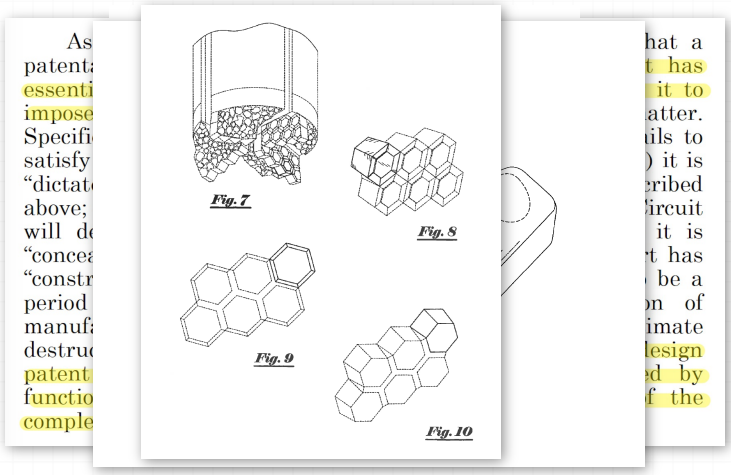
"New" & "Original"



25

"Ornamental"



https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2710661

26

35 U.S.C. § 102(a)(1)

Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention . . . .

27

Int'l Seaway Trading v. Walgreens (Fed. Cir. 2009)

"In light of Supreme Court precedent and our precedent holding that the same tests must be applied to infringement and anticipation … we now conclude that **the ordinary observer test must logically be the sole test for anticipation** as well."

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35 U.S.C. § 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

29

Durling v. Spectrum Furniture (Fed. Cir. 1996)

1. First, "one must find a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design.' *In re Rosen*."
2. "[O]ther references may be used to modify it" only 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'"

30

Are these high bars?

"For the period of 2008 to 2020, district courts making validity determinations about design patents **upheld them 88.4% of the time**—and only 11.6% of these determinations resulted in a patent being invalidated."

- Burstein & Vishnubhakat (2022)

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

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Enforcement

When, where, and how?

32

35 U.S.C. § 173

Patents for designs shall be granted for the term of 15 years from the date of grant.

33

Egyptian Goddess
(Fed. Cir. 2008) (en banc)

Infringement occurs when "an **ordinary observer**, taking into account the prior art, would believe the accused design to ***be the same*** as the patented design."

34

Goddess: Some caveats

- The factfinder must compare the patented design *as a whole* to the accused design
- While the court sometimes uses the phrases "substantially the same" or "substantially similar," this is not the same "substantial similarity that we talk about in copyright
  - The standards may have been more alike in the past, but they are *very* different today

35

The two-part *Goddess* test

1. "In some instances, the claimed design and the accused design will be ***sufficiently distinct*** that it will be clear … that the patentee has not met its burden of proving the two designs would appear 'substantially the same' to the ordinary observer …."
2. "[W]hen the claimed and accused designs are ***not plainly dissimilar***, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art …."

36

The role of the prior art

Important: The prior art can be used *only* to narrow the presumptive scope of a design patent, *not* to expand it.

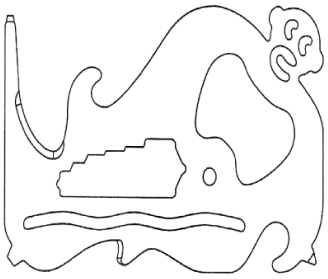
Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1337 (Fed. Cir. 2015).

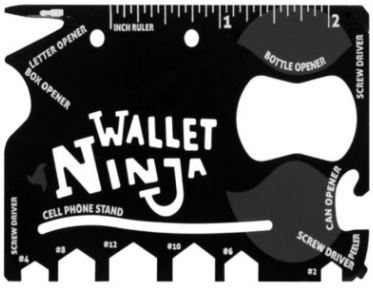
37

An example

38

Caffeinate Labs v. Vante
(D. Mass. Dec. 7, 2016)





39

Wallace v. IdeaVillage Prods.
(Fed. Cir. 2016) (nonprecedential)

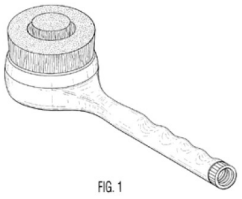
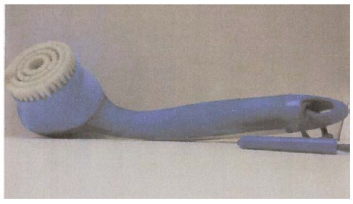


FIG. 1



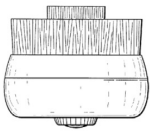


FIG. 2

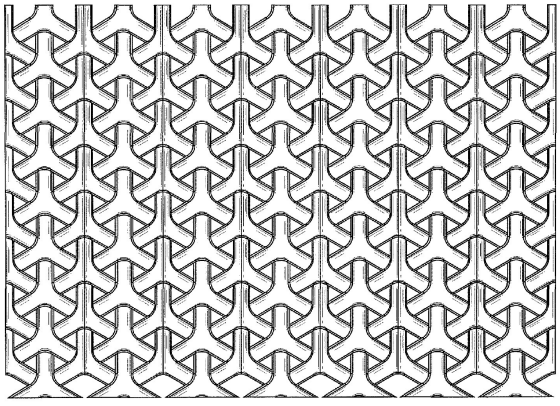
40

Performance Designed Prods. v. Mad Catz
(S.D. Cal. 2016)

PDP Patented Design	Mad Catz Product
 FIG. 2	

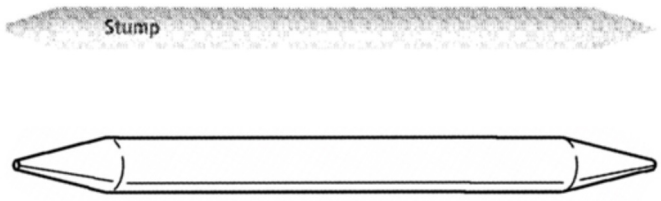
41

Curver Luxembourg
(Fed. Cir. 2019)



42

In re SurgiSil
(Fed. Cir. 2021)



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Litigation results

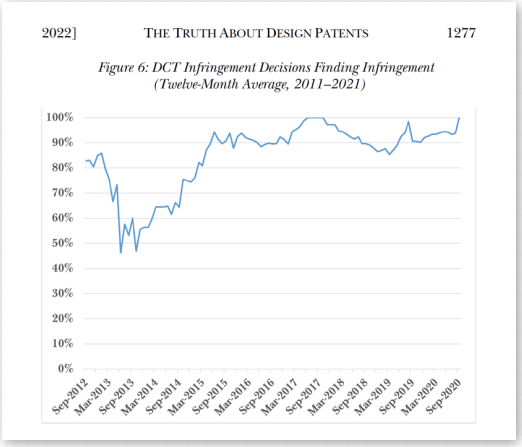
2022] THE TRUTH ABOUT DESIGN PATENTS 1277

Figure 6: DCT Infringement Decisions Finding Infringement (Twelve-Month Average, 2011–2021)

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

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35 U.S.C. § 271(a)

Except as otherwise provided in this title, whoever without authority **makes**, **uses**, **offers to sell**, or **sells** any patented invention, within the United States or **imports** into the United States any patented invention during the term of the patent therefor, infringes the patent.

45

Other remedies

- Injunctions (if "in accordance with the principles of equity");
- Damages ("not less than a reasonable royalty");
- Exclusion orders (USITC)
- No CBP enforcement (yet?) https://patentlyo.com/patent/2020/01/against-design-seizure.html

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35 U.S.C. § 289

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 . . . .

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Some caveats

- A patentee cannot recover both § 284 damages and § 289 damages for the same act of infringement.
- Section 289 damages *cannot* be trebled.
- Section 289 damages are not available for acts of utility patent infringement

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Questions?

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LAW SCHOOL

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@design_law@mastodon.social

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