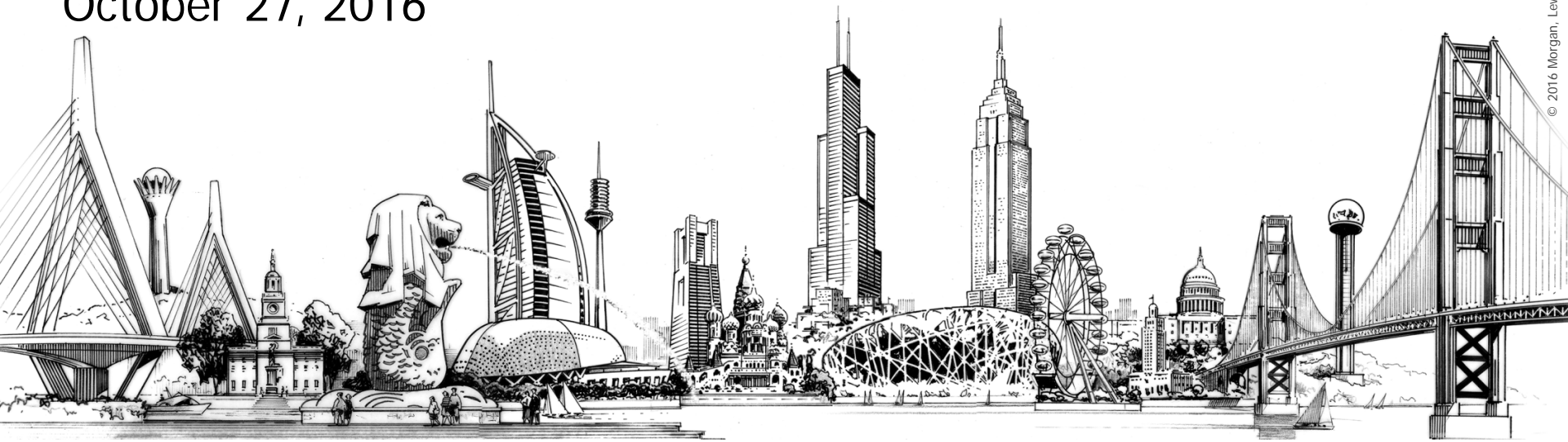


Morgan Lewis

DESIGN PATENTS FOR EXTRAORDINARY OBSERVERS

John L. Hemmer, Douglas J. Crisman,
and Andrew J. Gray IV
October 27, 2016



Topics

- Design Patent Background
- Continuations and Priority
- Prosecution
- Hague Filings
- Infringement Standard
- Damages
- Looking Ahead

Why File For Design Protection?

- Inexpensive
- High likelihood of success
- Quick to grant
- Good marketing tool (“patented design”)
- Uncertainty of infringement
- Difficult to invalidate
- Disgorge all of competitors total profits (for now)

Design Patent Basics

- Protects ornamental aspects of an invention
- Referred to as industrial, community, or registered designs ex-U.S.
- Narrower than utility, similar in ways to trademark, and broader and more powerful than copyright
- Single claim – what you see is what you get
- Term is 15 years from grant (14 yrs for patents filed before 5/13/15)

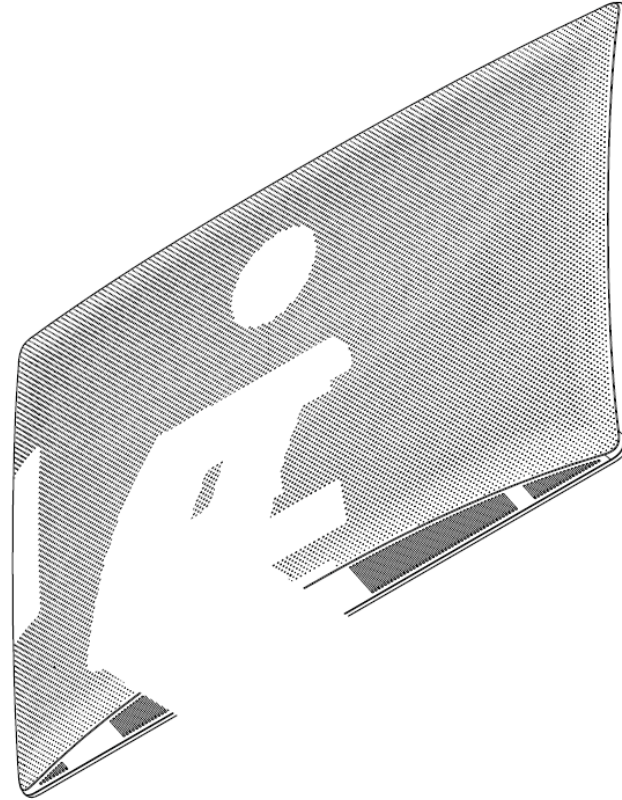
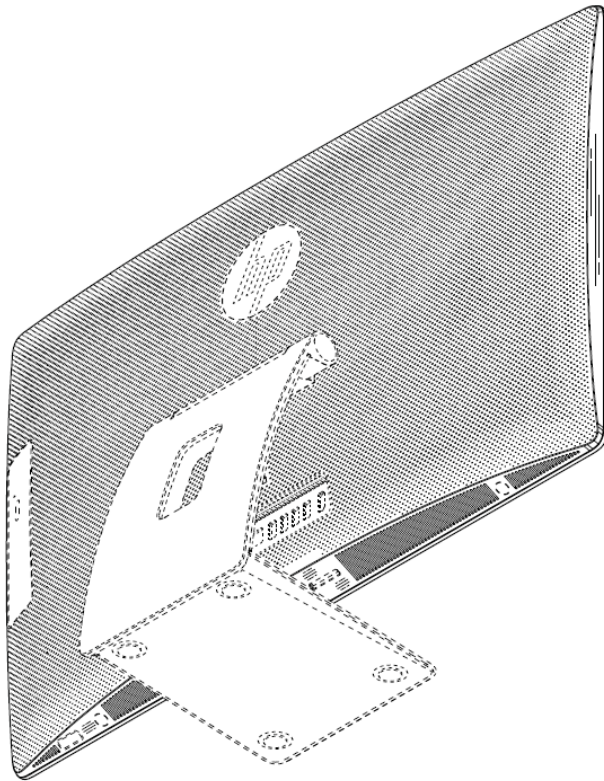
The Drawings

- Shape of an article, surface ornamentation or combination
 - Can also claim motion, color, and/or contrast
- Claimed features are shown in solid lines, shading, and/or stippling
- Unclaimed features may be shown in phantom or boundary lines
- Claimed feature must be visible
- “sufficient number of views to constitute a complete disclosure”
 - 3D articles – typically show 7 views, perspective and 6 sides. Consider including more than one perspective view and enlarged views.
 - 2D articles – 1 view is acceptable
- Consider including an appendix for additional support

Costs

- Draftsman typically charge \$50-\$80 a page
- USPTO filing fees \$380 (small)/\$760 (large)
- No maintenance fees
- Total estimated budget is typically \$3-5K
- Approximately \$2K for each con and foreign counterpart

Filing in China, Korea or Brazil?



Appendix to the Rescue

Appendix

Attached hereto and submitted herewith as a part of this application are unclaimed Figs. A-P that disclose additional drawings of the computer.

Applicant regards embodiments of their design as including the overall appearance shown in claimed FIGS. 1-8, unclaimed FIGS. A-P, and any and all parts and/or portions thereof.

Upon allowance, this Appendix may be cancelled and need not be printed as part of any patent that may issue, but shall remain part of the file.

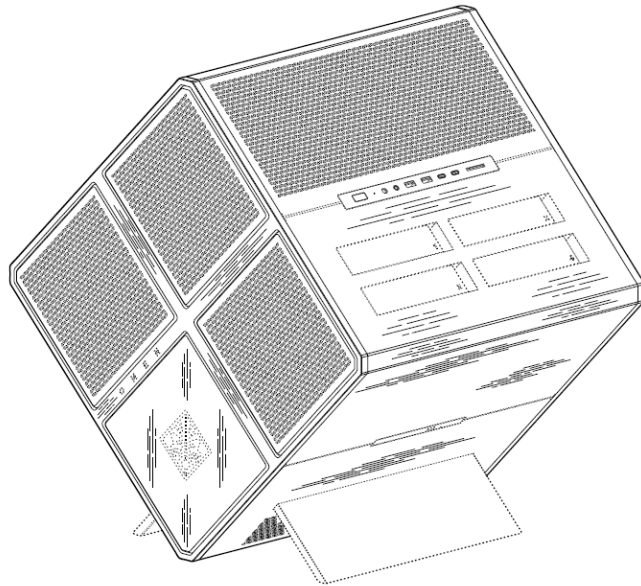


FIG. 1

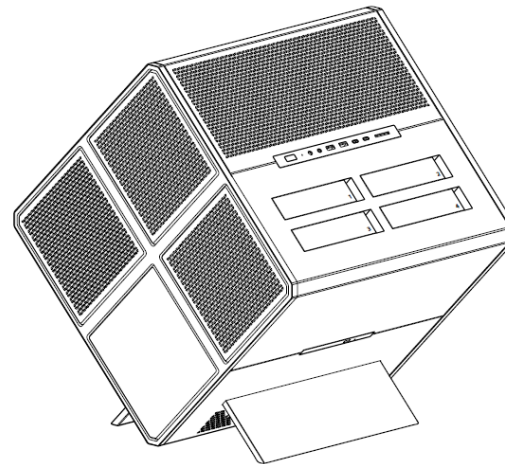


FIG. A

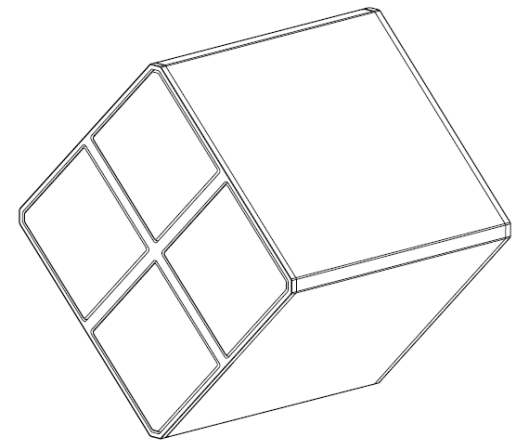


FIG. I

Continuations and Priority

- Grace periods
 - 1 year: U.S., CA and EP
 - 6 months: BR, JP, TW, KR, SA
- Foreign priority filing deadline is 6 months from filing U.S. application
- Cannot claim priority to a provisional but you can claim priority to a utility application – extend patent term!?!
- Note: Since term is calculated from grant, divisionals and cons also extend patent term
- Can file a broader or narrower continuation application. However, see *In re Owens* (“Crest Bottle”)

Written Description

In re Owens (Fed. Cir. 2013)

parent



Fig. 1

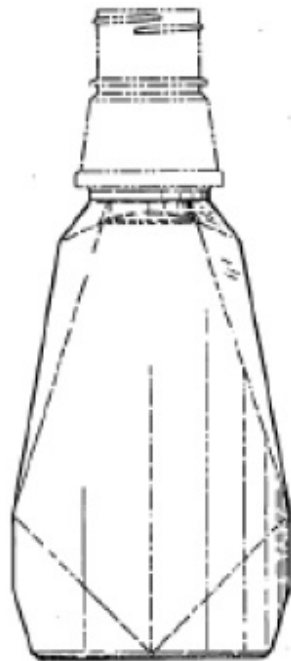


Fig. 2



continuation



Fig. 1

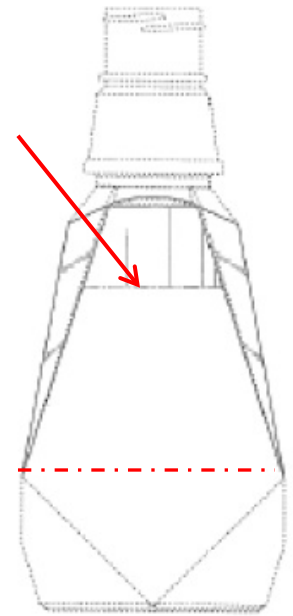
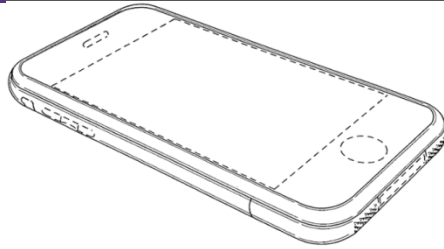
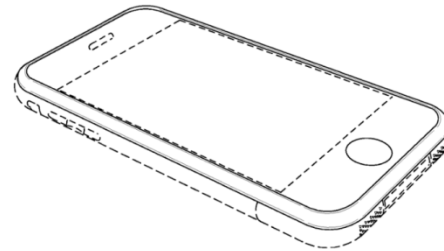


Fig. 2

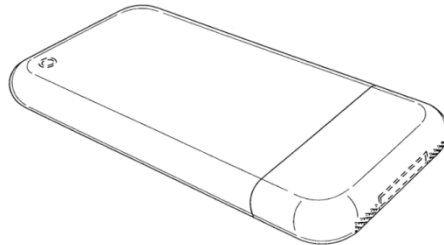
Written Description Going Forward



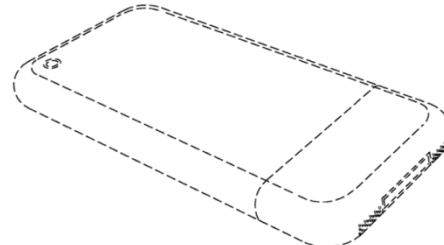
Original Drawing



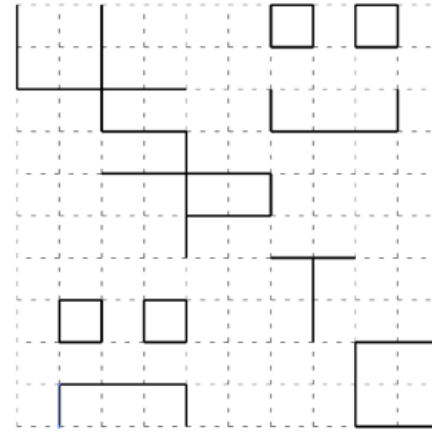
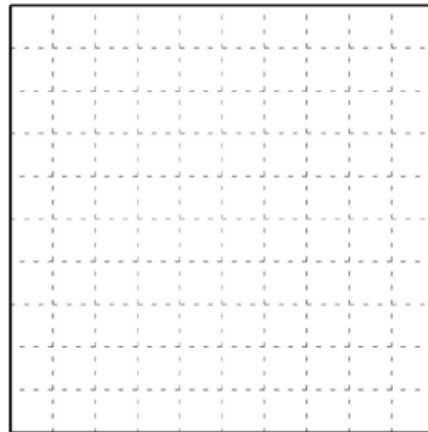
Amended Drawing



Original Drawing



Amended Drawing

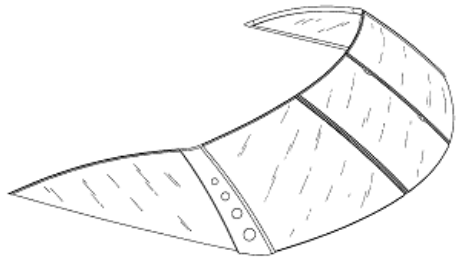


Prosecution

- Rejections based on prior art are very rare (but seem to be increasing)
- Rejections for formalities are common and can be problematic
 - Insist using a draftsman
 - Have the drawings created from a CAD file if possible
 - Use shading to help define surface contour
- Continued Prosecution Applications (CPA) instead of RCEs
- Restriction Requirements are very common. Beware of prosecution history estoppel!

Prosecution History Estoppel

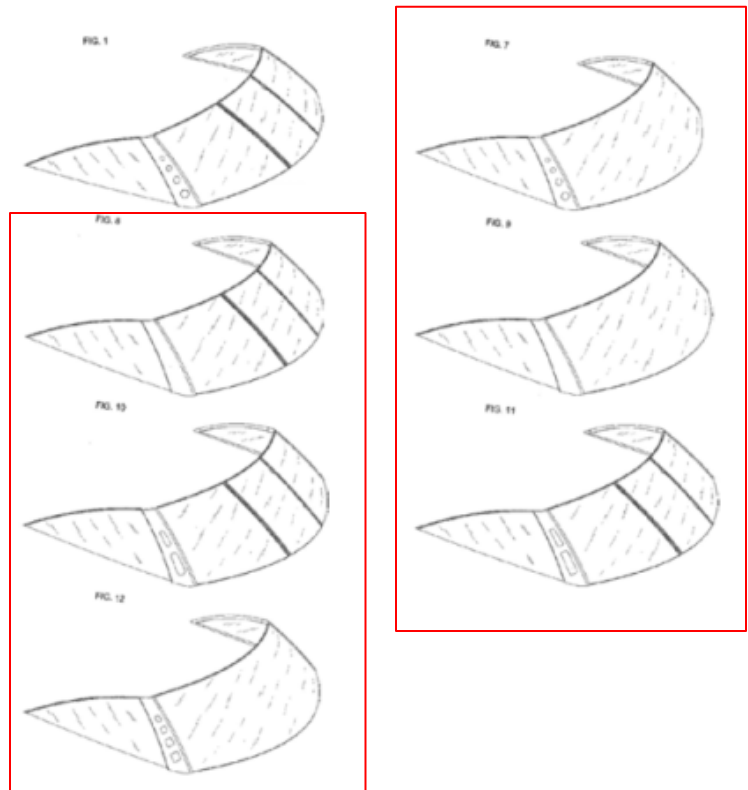
- *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC et al*, No. 2013-1199 (Fed. Cir. 2014)



The '070 Patent



The Accused Malibu Windshield



Hague Agreement

- Similar to PCT system for utility patents
 - Available for U.S. applicants since 5/13/15
 - Most EP countries, Korea, and Japan are members
 - Canada, China, and Russia are expected to join in the near future
- Pros
 - Include up to 100 designs in one application
 - Only one set of drawings needed
 - Publication at 6 months unless deferred which allows for provisional rights (but only for one embodiment)
- Cons
 - In the U.S., prosecution history estoppel issue
 - Appendix not allowed

Example – Phantom lines and shading

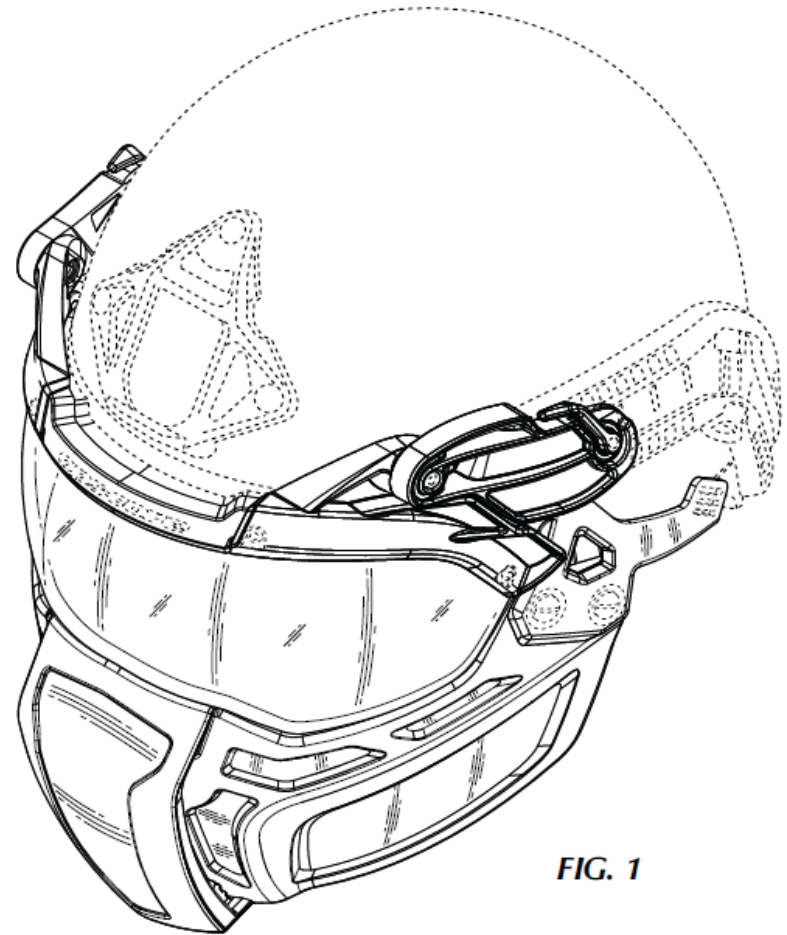
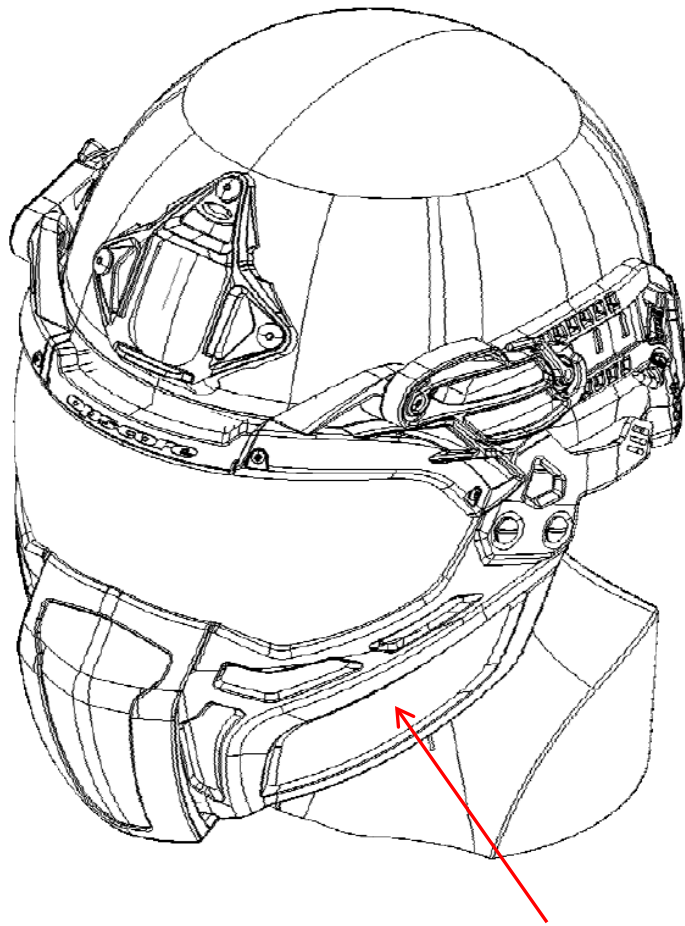
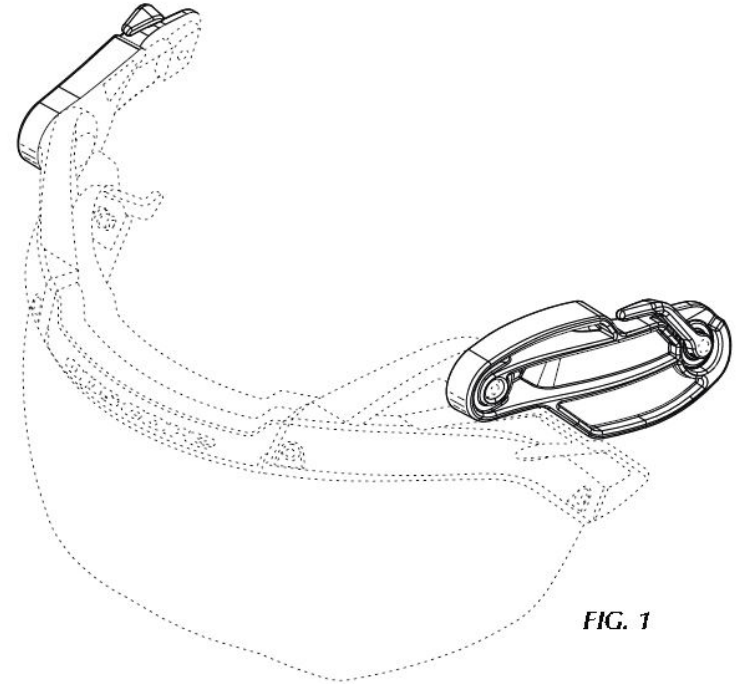
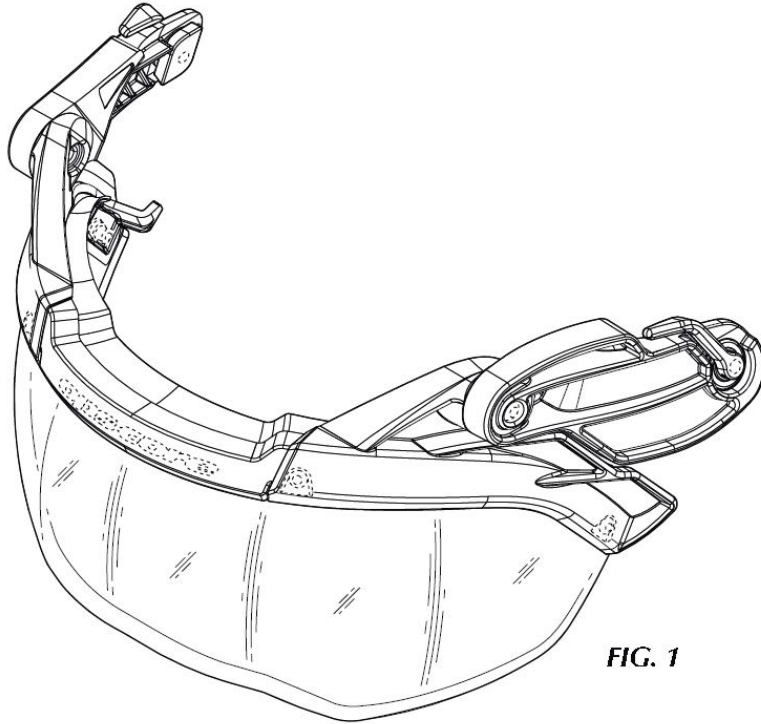
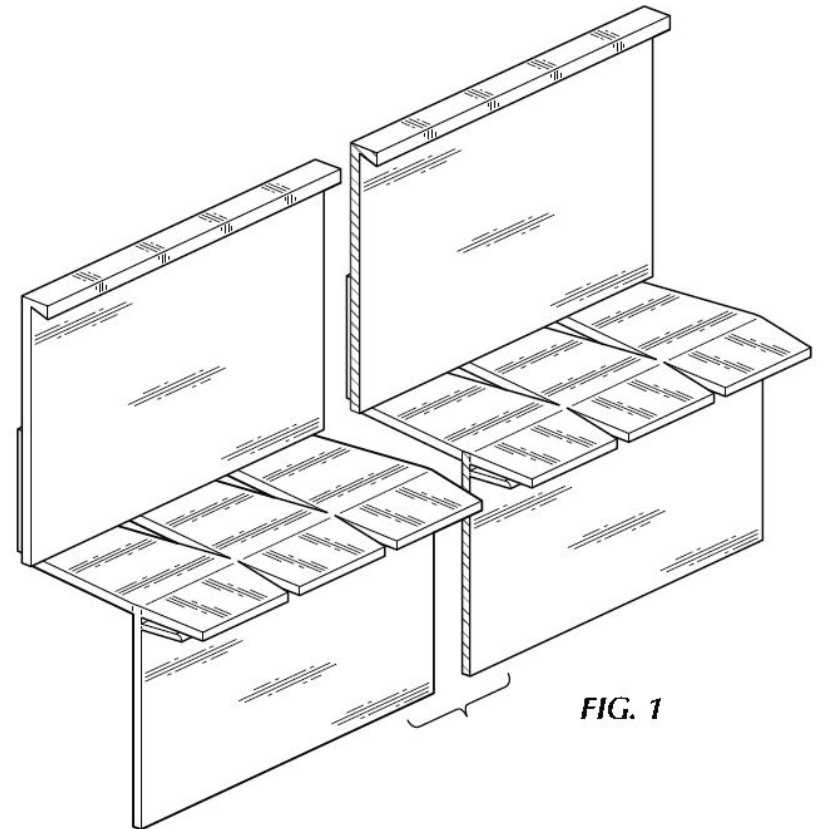


FIG. 1

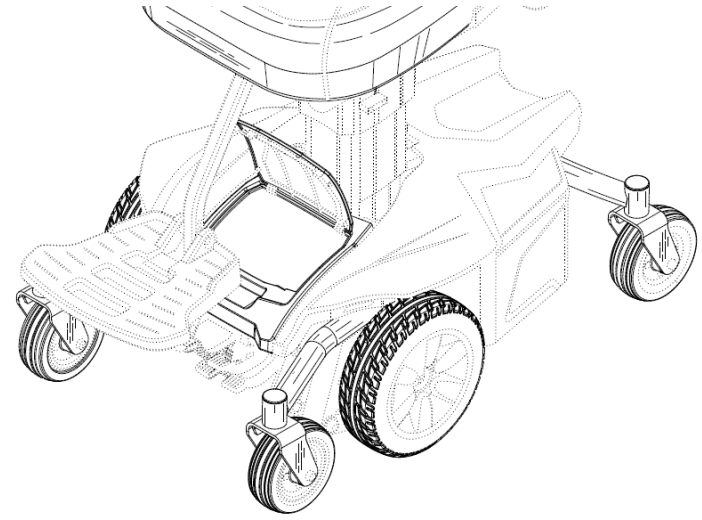
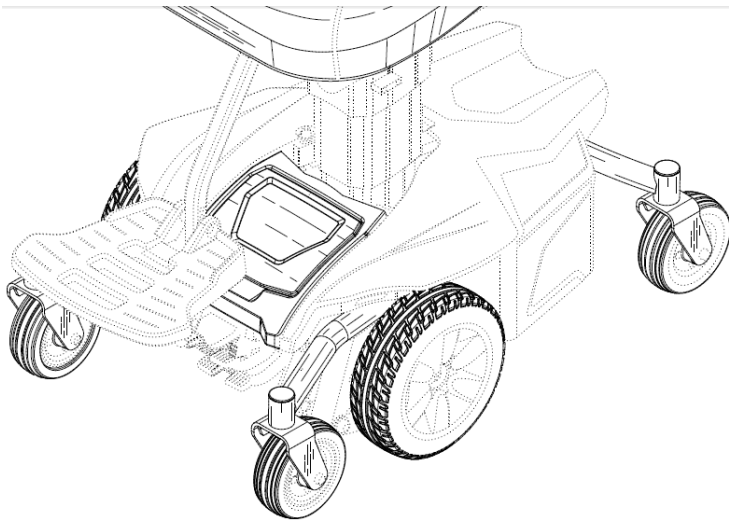
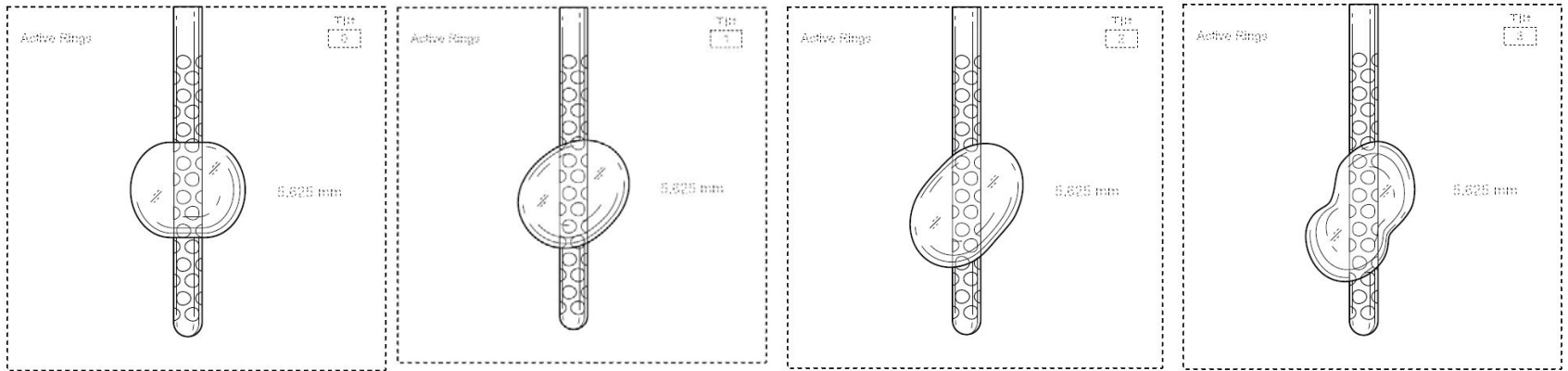
Example – Broadening Continuation



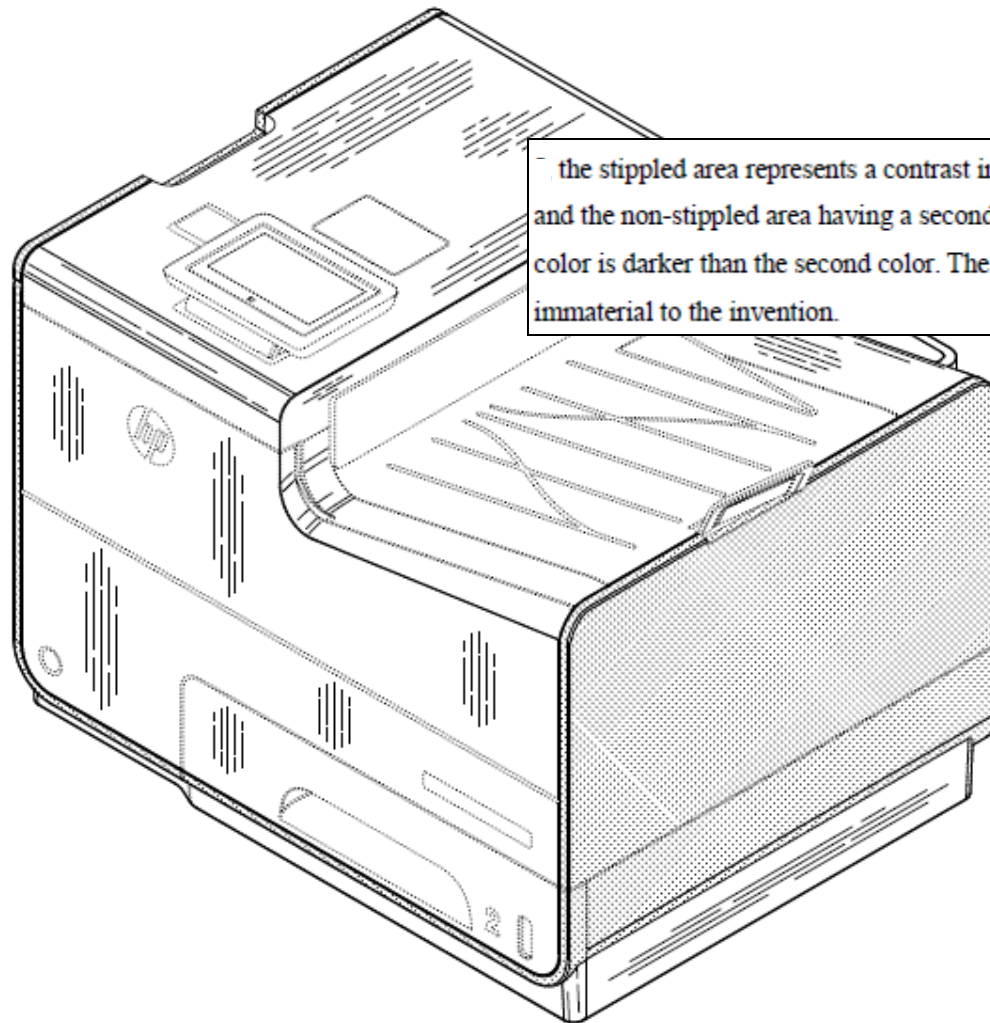
Example - Disclaim length



Example – Claiming movement



Example – Claiming contrasting color


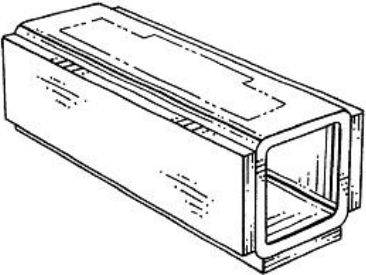



the stippled area represents a contrast in color between the stippled area having a first color and the non-stippled area having a second color which is different from the first color. The first color is darker than the second color. The precise colors of the first and second colors are immaterial to the invention.

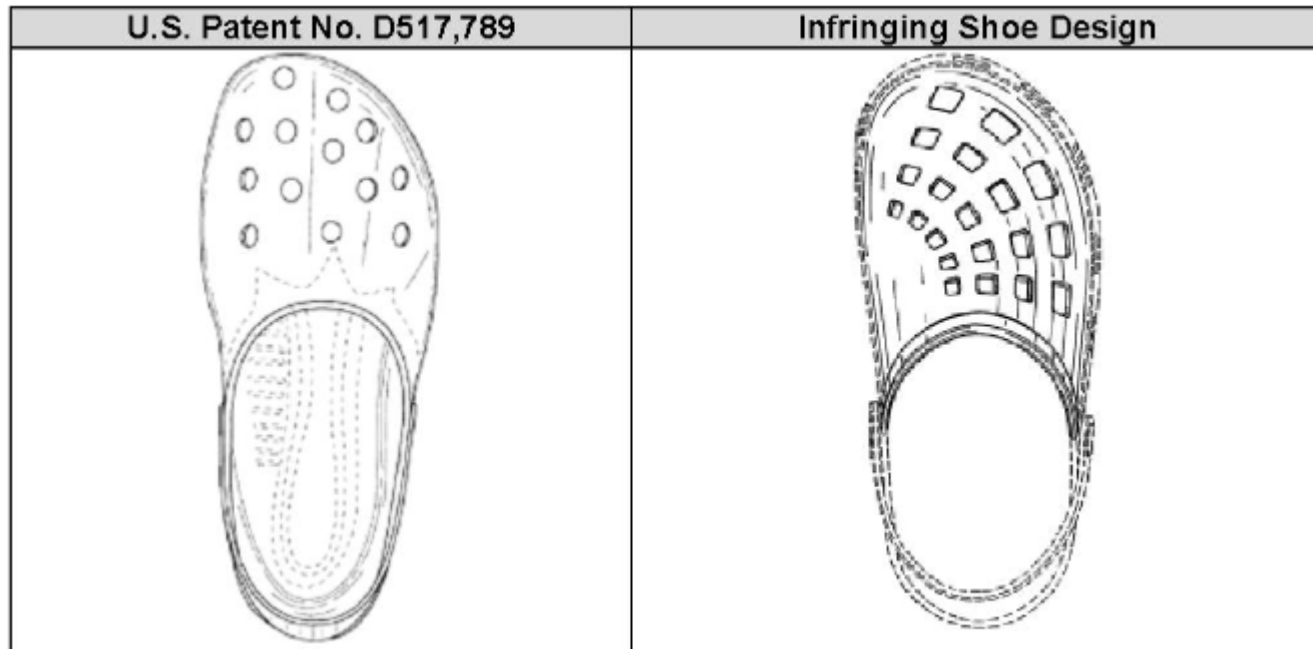
Infringement

- Likelihood of confusion: A design patent is infringed if an **ordinary observer** would think that the accused design is **substantially the same** as the patented design when the two designs are compared in the **context of the prior art**
- This test focuses on the overall appearance of the design and not individual elements.

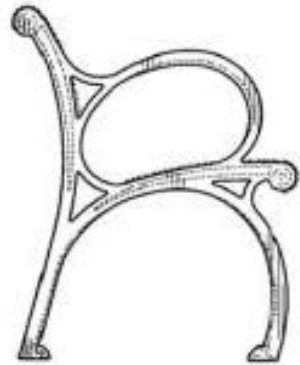
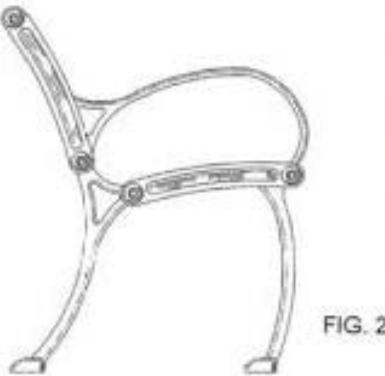

Infringement Examples

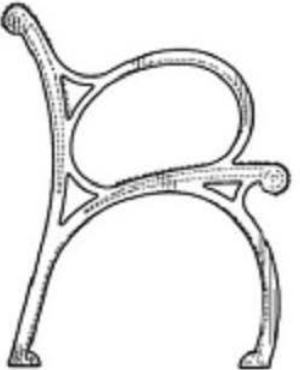


Prior Art	U.S. Patent No. D467,389	Non-Infringing Fingernail Buffer Design
 <p>The 'Prior Art' column shows two examples of fingernail buffers. The top one is a white, rectangular buffer with a small handle on the right side. The bottom one is a grey, rectangular buffer with the text 'Tropical Shine' and '100% C-1000 Buffer' printed on it.</p>	 <p>The 'U.S. Patent No. D467,389' column shows a technical drawing of a fingernail buffer. It is a rectangular, white buffer with a handle on the right side, similar in design to the prior art examples.</p>	 <p>The 'Non-Infringing Fingernail Buffer Design' column shows a photograph of a fingernail buffer. It is a rectangular, blue and white buffer with the text 'SUNNY SENSATION' printed on it.</p>

Infringement Examples



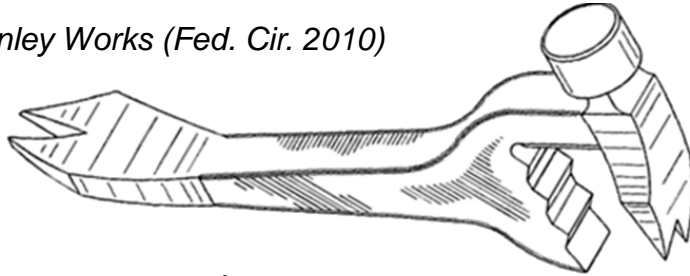
Infringement Examples

Prior Art	U.S. Patent No. D523,623	Infringing Bench End Design
	 <p data-bbox="1031 705 1097 733">FIG. 2</p>	

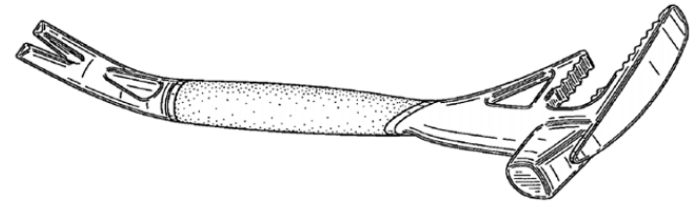
Prior Art	U.S. Patent No. D523,623	Non-Infringing Bench End Design
		

Functionality

Richardson v. Stanley Works (Fed. Cir. 2010)



'167 Patent FIG. 1



Accused Stanley "FUBAR" Tool

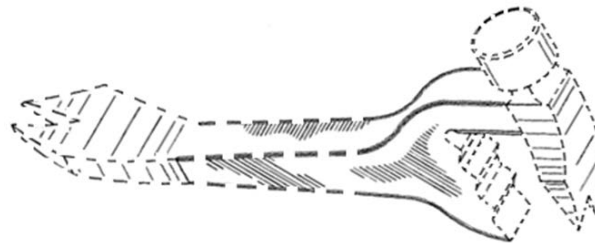
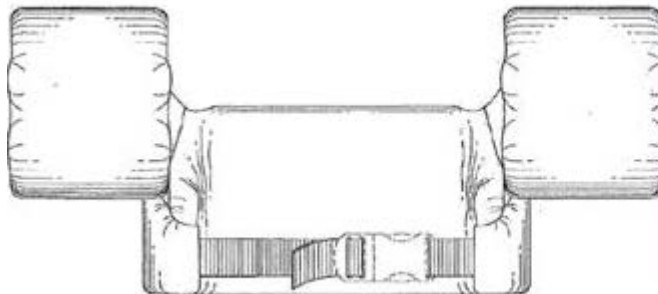


Fig. 1 of the '167 Patent as construed

Sport Dimension v. Coleman (Fed. Cir. 2016)

FIG. 2



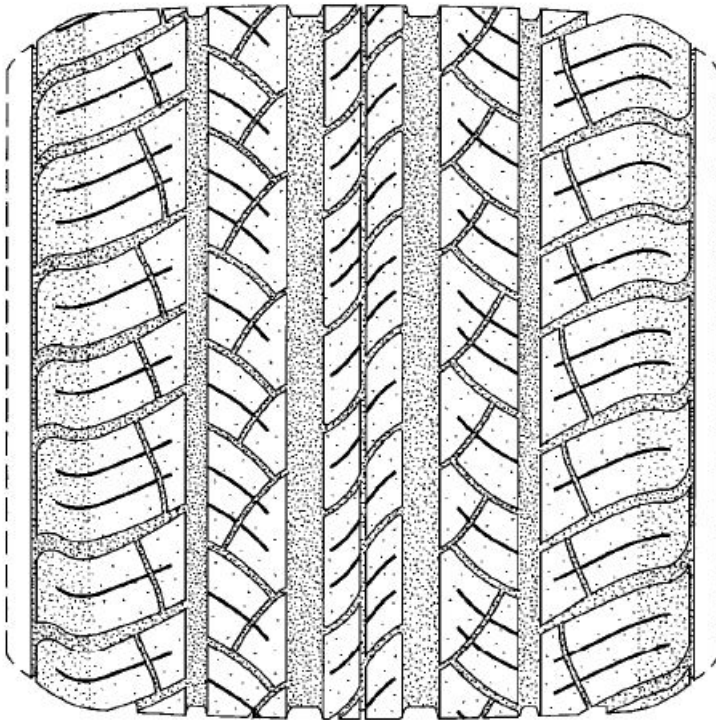
Patent No. D623,714 Fig. 2



Accused Device

Functionality; use of Stippling

Michelin North America Inc v. Atturo Tire (D.S.C. 2016)



Going too "broad"

Weber-Stephen Products LLC v. Sears Holdings Corp (N.D.I.L. 2015)

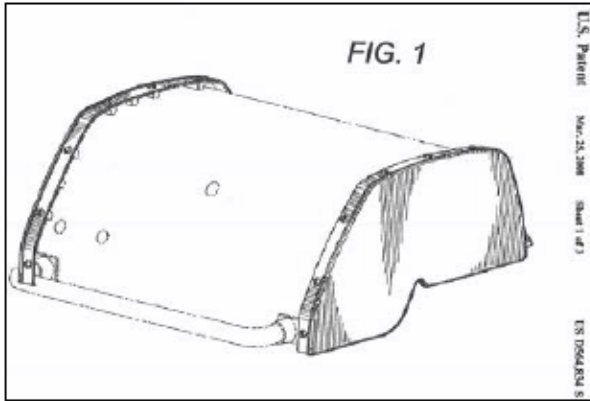
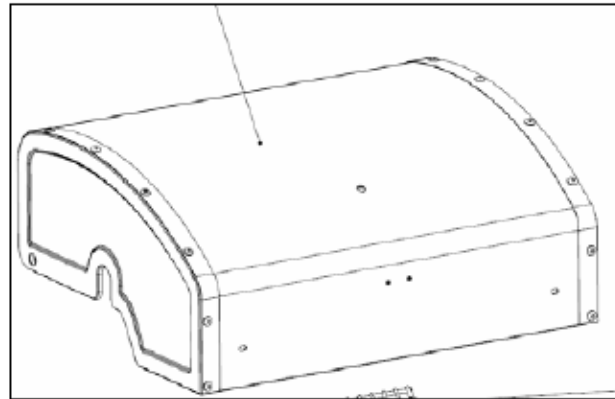


Figure 1 of '834 Patent



Kenmore Elite Stainless and Espresso Grills

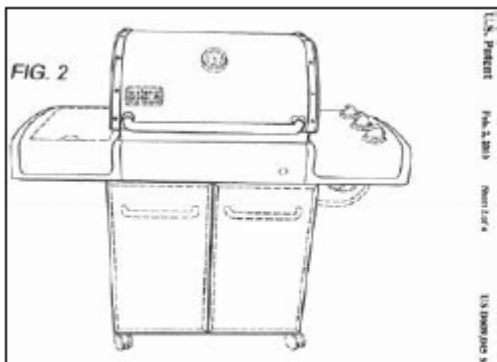


Figure 2 of '045 Patent



Kenmore Elite Stainless and Espresso Grills



Post Grant Challenges

- Only 8 design patent IPRs were filed in the last few years, only a few have been instituted and only one was successful.
- This may be because it is very difficult to find invalidating prior art and the stronger arguments are typically 112 or noninfringement.

Damages

- 35 U.S.C. 284 – reasonable royalty; or
- 35 U.S.C. 289 – total profits:
 - 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.
- *Apple v. Samsung*
 - Samsung: Statute is unclear. Profit should be limited to patented design.
 - Apple: Plain meaning and congressional intent is clear.

Malibu's Argument in support of Samsung

- \$100,000 boat, \$500 windshield

If this infringes



You get total profits for this

3D Printing and Models

- Bmw v. Turbosquid



Biography



John L. Hemmer

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John L. Hemmer is a patent lawyer who focuses on implementing intellectual property (IP) programs for clients involving mechanical and life science technologies. Clients turn to John for counsel on patent portfolio management, patent strategy, product clearance, patentability analyses, and patent challenges including reexaminations and inter partes reviews. John also provides support for patent litigation, prepares and negotiates technology agreements, and works with clients on venture capital financing, merger and acquisition agreements, initial public offerings, and IP due diligence.

Biography



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Douglas J. Crisman brings the perspective of a software designer and intellectual property (IP) director for a leading computer hardware company to his patent law practice, which includes patent preparation, licensing, and prelitigation opinions, as well as IP transactions, due diligence, and counseling. He routinely works with standards-setting bodies and consortia on IP issues, and provides advice on strategic IP management and open source legal issues ranging from software development to code review and licensing.

Biography



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T +1.650.843.7575

andrew.gray@morganlewis.com

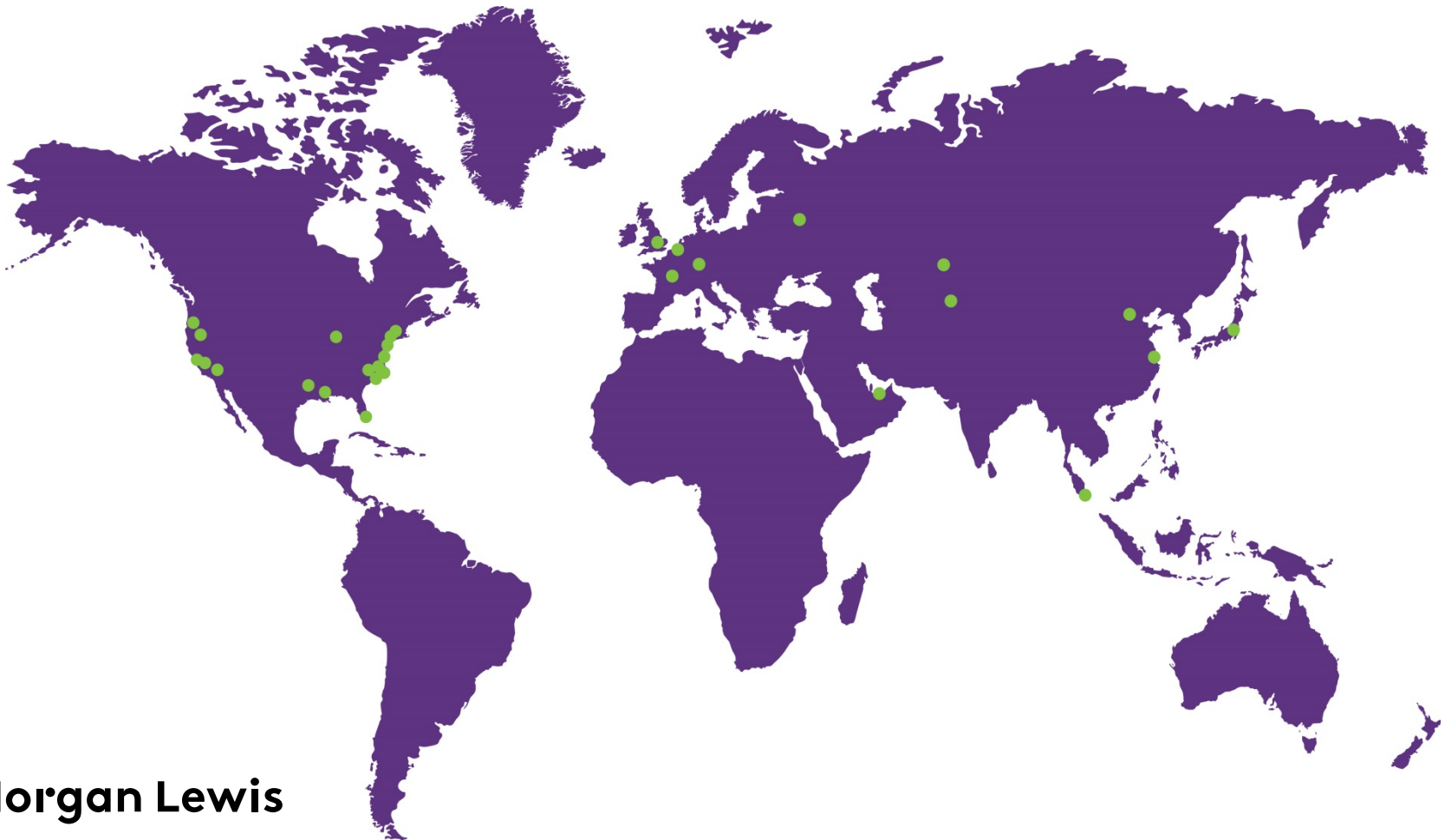
Andrew J. Gray IV concentrates his practice on intellectual property (IP) litigation and prosecution and on strategic IP counseling. Andrew advises both established companies and start-ups on computer and Internet law issues, financing and transactional matters that involve technology firms, and the sale and licensing of technology. He represents clients in patent, trademark, copyright, and trade secret cases before state and federal trial and appellate courts throughout the United States, and before the US International Trade Commission.

Our Global Reach

Africa
Asia Pacific
Europe
Latin America
Middle East
North America

Our Locations

Almaty	Dallas	Los Angeles	Philadelphia	Silicon Valley
Astana	Dubai	Miami	Pittsburgh	Singapore
Beijing	Frankfurt	Moscow	Princeton	Tokyo
Boston	Hartford	New York	San Francisco	Washington, DC
Brussels	Houston	Orange County	Santa Monica	Wilmington
Chicago	London	Paris	Shanghai	



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