





**interactive dialogue**  
**The Ins and Outs of Design Patents**  
April 20, 2016  
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**The Ins and Outs of Design Patents**



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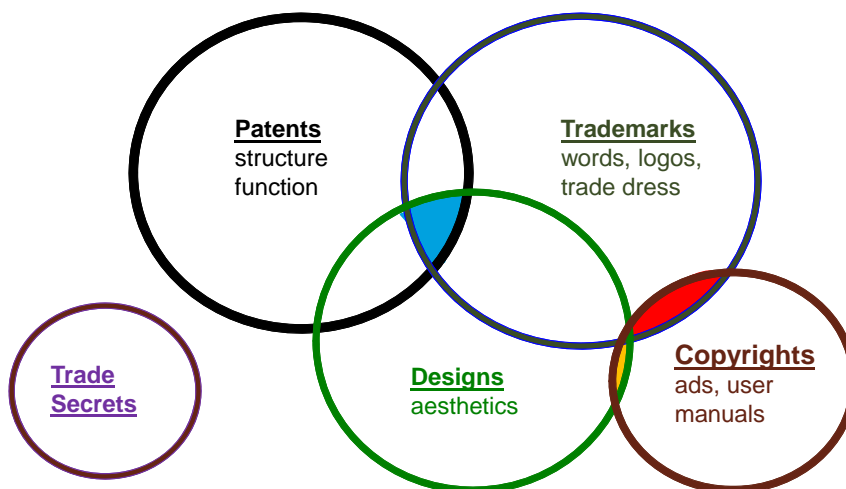


## Why Pick This Topic?

- Conventionally design patents were filed only by “consumer product” innovators with articles of manufacture
- Since *Alice Corp. v. CLS Bank International* software has become much more difficult to protect using utility patents
- Design patents are the fastest growing IP asset used to protect icons and graphical user interfaces



## Intellectual Property Arsenal



## Utility Patents vs. Design Patents

### Utility Patents

- Protect Structure/Function (“works”)
- 20 years
- 3 to 4 years to issue
- More expensive to obtain and enforce
- Flexible scope

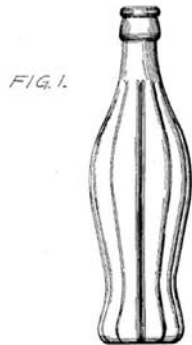
### Design Patents

- Protect Aesthetics (“looks”)
- 15 years
- 1 to 2 years to issue
- Less expensive to obtain and enforce
- Narrower scope



## Conventional Design Examples

Protects “Looks”

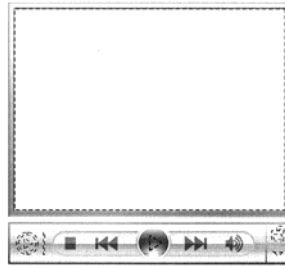


# Icons and Graphical User Interfaces

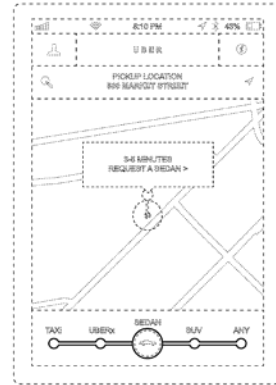
US D668,263 S



US D523,869 S



US D738,901 S



US D723,053 S

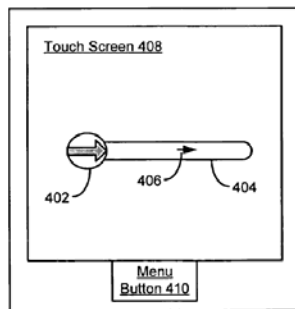


# Designs and Utilities Can Cover the Same Product

## Apple iPhone - Slide to Unlock

Utility - U.S. Patent No. 7,657,849

Design - U.S. No. D675,639

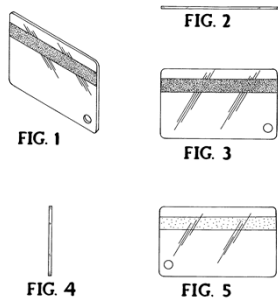


# Designs, Copyrights, and Trademarks Can Cover the Same Product

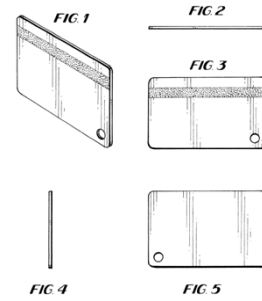
(12) **United States Design Patent** (10) Patent No.: **US D599,372 S**  
Pelczarski et al. (45) Date of Patent: **•• Sep. 1, 2009**



# Incremental Design Improvements – Patentable!



**Claimed Design**



**Prior Art**



## Benefits of Design Patents Over Utility Patents

- **Less expensive to prepare and file**
- **Examined and issued faster - providing enforceable protection sooner**
  - Key for innovations with short lifespan
- **Less expensive to file in foreign jurisdictions**
  - Minimal (or no) translation costs – no lengthy application
  - Many jurisdictions merely “register” designs (i.e., no prosecution costs)
  - Many jurisdictions allow multiple designs in one application - reduced annuities
- **Novelty/Non-Obviousness based on aesthetics rather than function**



## Requirements for Design Application

- **Unlike provisional applications, designs require a finalized (or mostly) finalized product**
  - No “provisional” design applications
  - Legal claim is the drawing themselves, so want to accurately illustrate the product
- **Public Disclosure still an issue**
  - But, some foreign jurisdictions have grace periods for design disclosures that do not have grace periods for utilities (e.g., EPO)
    - 6 month foreign priority claim
    - 6 month grace period for public disclosure (outside of U.S.)
- **Consider broadening claim scope by “dashing” non-essential features**
  - Tip: File with multiple embodiments having different elements dashed to ensure support for all potential combinations
- **Good drawings are ESSENTIAL, work with experienced draftsman**
  - Standard 7 views required for 3D objects
- **There are exacting requirements to get the application correct and with desired coverage scope**



## Enforcement of Design Patents

- **Ordinary Observer Test** – The two designs are “substantially the same” in light of the prior art

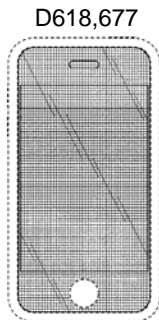


Arc'Teryx's Claimed Design    Westcomb Outerwear's Jacket



## Apple v. Samsung – Design Infringement

- **3 design patents and 2 utility patents infringed**
- **Apple ultimately awarded \$548 million after appeal to Federal Circuit**
  - \$400 million based on 100% of profits from phones infringing the design patents



## Damages for Design Infringement

- **Supreme Court hearing Samsung v. Apple case on damages**
  - **Two Questions Presented to the Supreme Court:**
    - Where a design patent includes unprotected non-ornamental features, should a district court be required to limit that patent to its protected ornamental scope?
    - 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?
  - **Samsung's view:** Damages should be limited to value of design aspects
  - **Apple's view:** Plain language of statute does not require apportionment. Utility patent infringement statute has been modified to include apportionment, design statute has not.
- **For more info see:** <http://thetmca.com/the-supreme-court-emerges-from-its-carbon-freeze-on-design-patents/>



## Who Wants Credit?

Complete the sign in sheet included in the reminder email (sent yesterday) and return to [hubble.michelle@dorsey.com](mailto:hubble.michelle@dorsey.com).

We will send CLE Certificates and a copy of these materials to those who return the form.





## How Do I Learn More?

### **interactive dialogue**

#### **Efficient Resolution of Patent Disputes**

*Presented by:*

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Patent

**Case Collard**  
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IP Litigation

**Wednesday, July 13, 2016**  
**9:00 – 10:00 am (Pacific Time)**

