

DESIGN PATENT LEGAL UPDATE



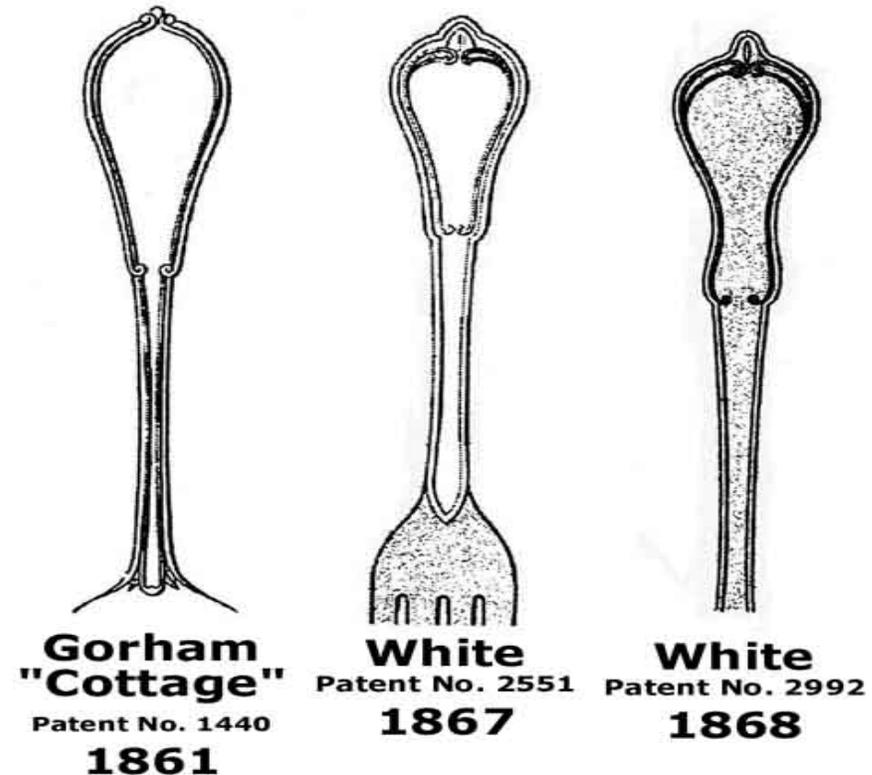
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IP Litigation & Post-Grant Proceedings
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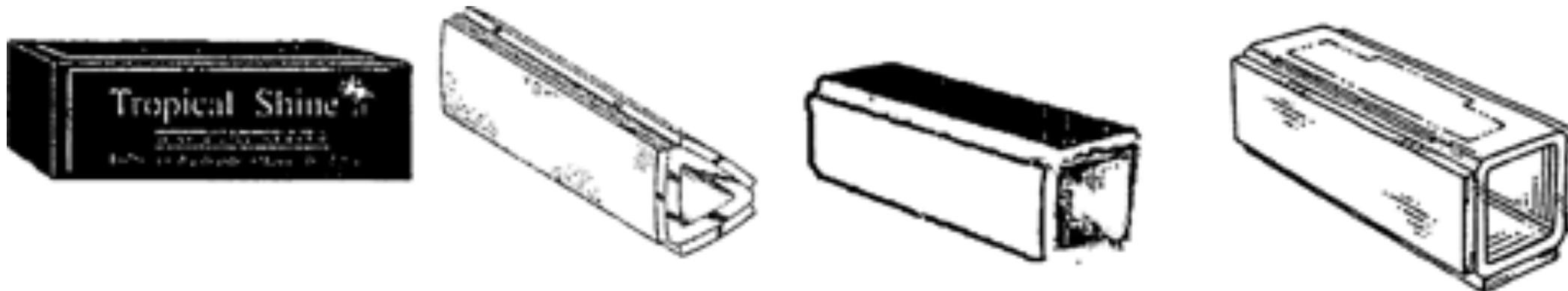
Gorham Mfg. v. White, 81 U.S. 511, 528 (1871)

- “That if, in the eye of an ordinary observer, giving such attention as a purchase 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**, the first one patented is infringed by the other.”



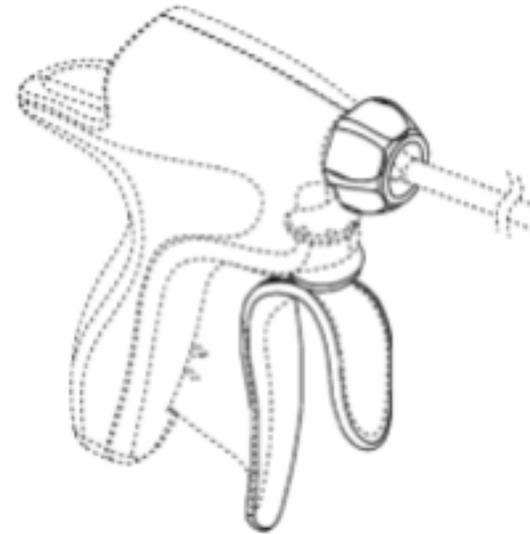
Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 676 (Fed. Cir. 2008)(*en banc*)

- The ordinary observer as being “deemed to view the difference between the patented design and the accused product in the context of the prior art.” The Federal Circuit ***tuned the ordinary observer test towards novelty*** because: “[w]hen the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art.”



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

- “Where the claimed and accused designs are ‘sufficiently distinct’ and **‘plainly dissimilar,’** the patentee fails to meet its burden of proving infringement as a matter of law. If the claimed and accused designs are not plainly dissimilar, the inquiry may benefit from comparing the claimed and accused designs with prior art to identify differences that are not noticeable in the abstract but would be significant to the hypothetical ordinary observer familiar with the prior art.”



D'804 patent, Fig. 1



Covidien's accused product

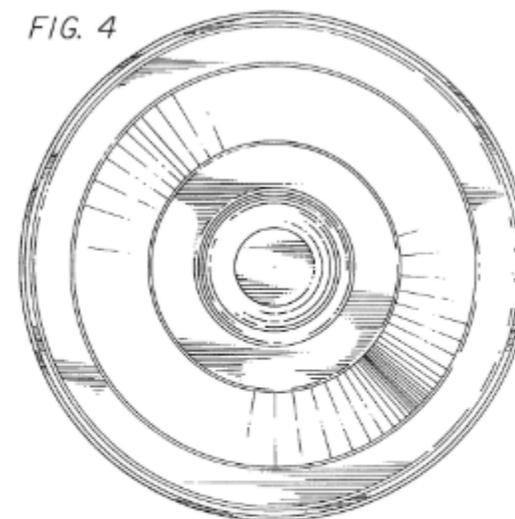
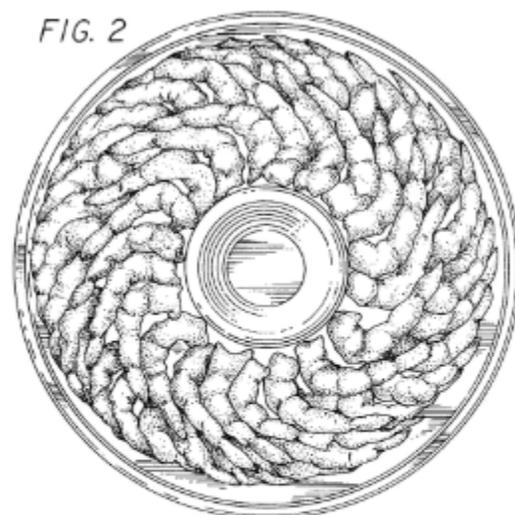
Crocs, Inc. v. I.T.C., 598 F.3d 1294, 1303 (Fed. Cir. 2010)

- The ordinary observer test applies to the patented design in its entirety, as it is claimed. See *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992). “[M]inor differences between a patented design and an accused article’s design cannot, and shall not, prevent a finding of infringement.” *Payless Shoesource*, 998 F.2d at 991 (quoting *Litton Sys., Inc. v. Whirlpool*, 728 F.2d 1423, 1444 (Fed. Cir. 1984)).

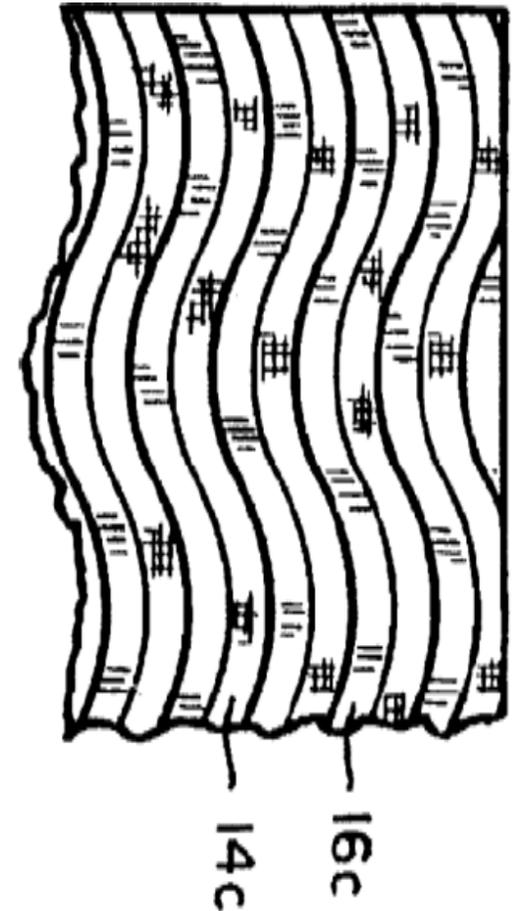
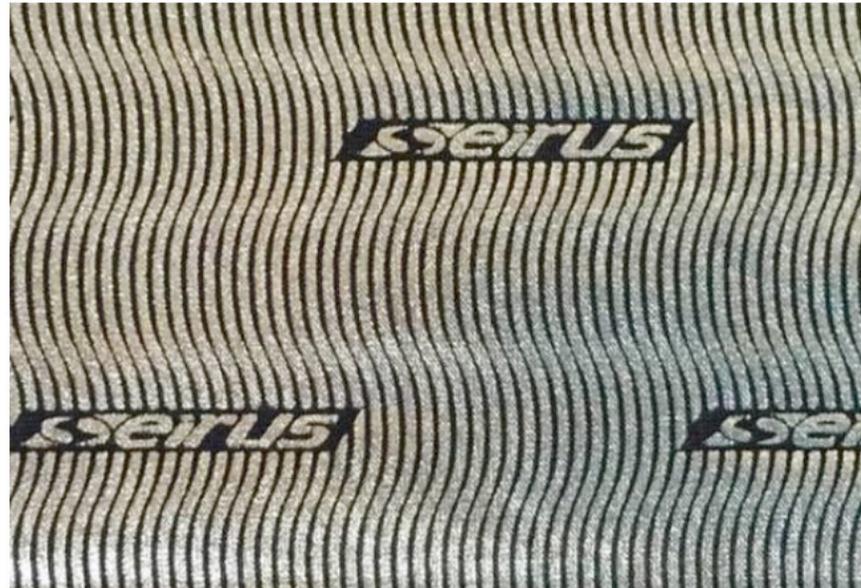
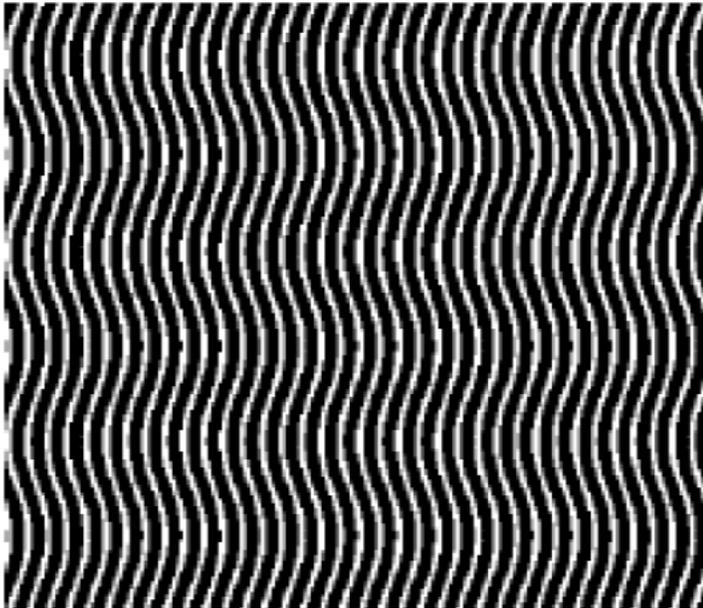


Contessa Food Products, Inc. v. Conagra, Inc., 282 F.3d 1370 (Fed. Cir. 2002)

- All views of the accused device “must be compared with the patented design as a whole . . . To determine infringement.”



Some Examples:



Patent No.:

US D657,093 S

(57)

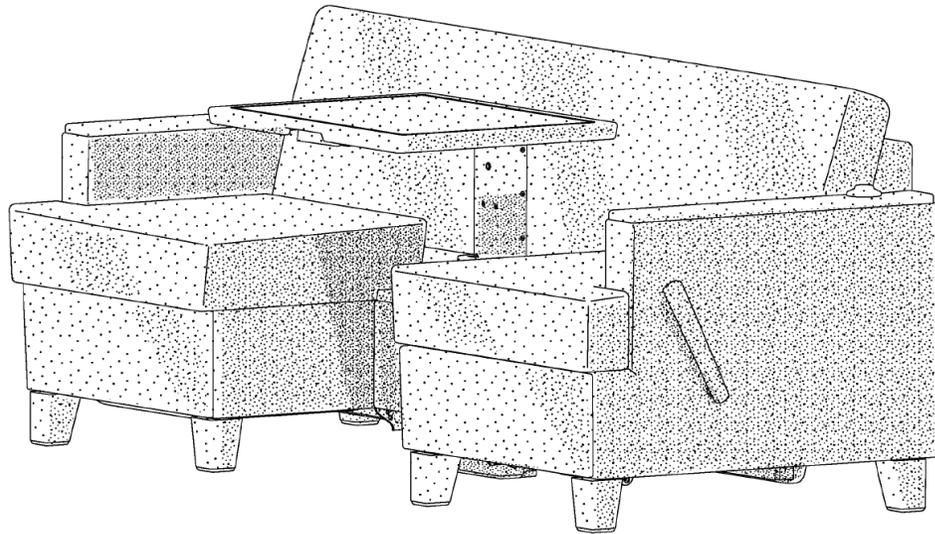
CLAIM

The ornamental design of a heat reflective material, as shown and described.

Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc., 3:15-cv-00064 (D. Or. 2016)

Columbia Sportswear North Am., Inc. v. Seirus Innovative Accessories, Inc., 3:17-cv-01781 (S.D. Cal. 2018)

Some Examples:

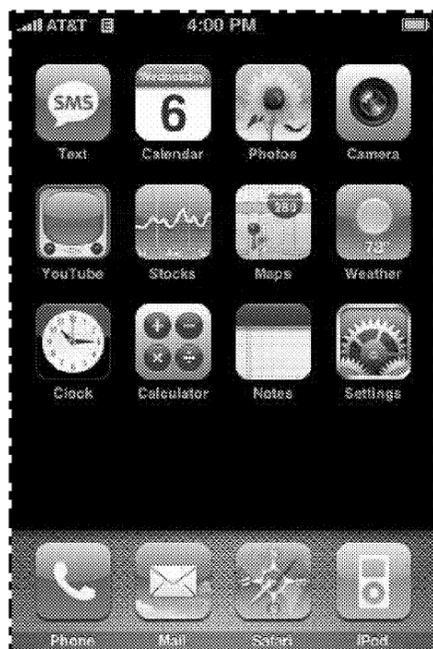


Patent No.: **US D716,576 S**



In re Certain Convertible Sofas and Components Thereof, 337-TA-1122 (ITC 2018)

Some Examples:



(57)

CLAIM

The ornamental design for a graphical user interface for a display screen or portion thereof, as shown and described.

DESCRIPTION

The patent file contains at least one drawing executed in color. Copies of this patent with a color drawing will be provided by the Office upon request and payment of the necessary fee.

Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429 (2016)

DESIGN PATENTS ARE BEST WHEN THERE IS A DESIRE TO COPY

New Products

Replacement Parts

Trade Indicators

New Products

- Pioneering Designs



Replacement Parts

FIG. 1

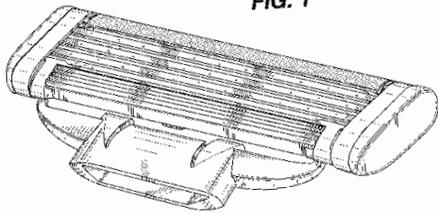


FIG. 1

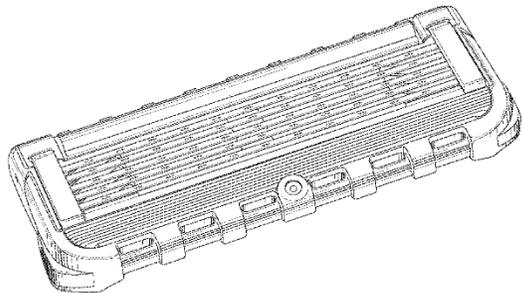
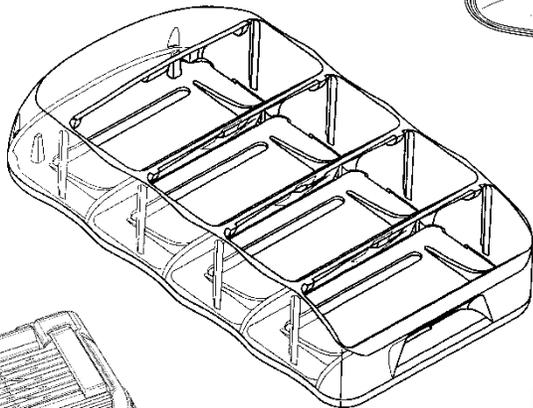
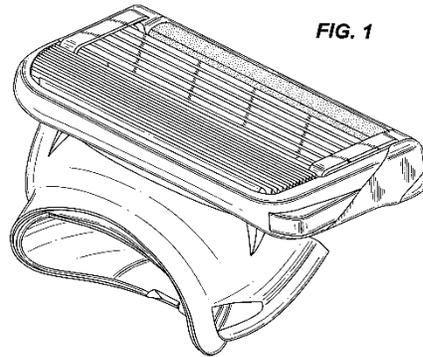
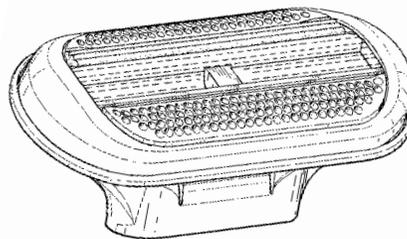


FIG. 1



Gillette

Gillette Company v. BK Gifts, No. 13-cv-02241 (N.D. Ohio 2013)

D'422751; D'575454; D'531518;

D'415315; D'430023; D'440874

Permanent injunction → settlement

Gillette Co. v. Juba Razors, No. 14-cv-418 (S.D. Ohio 2014)

D'422751; D'531518; D'533684;

D'604904

Settlement

Gillette Co. v. Generic Shavers, No. 14-cv-419 (S.D. Ohio 2014)

Settlement

Trade Indicators

USD555333



Figure 3

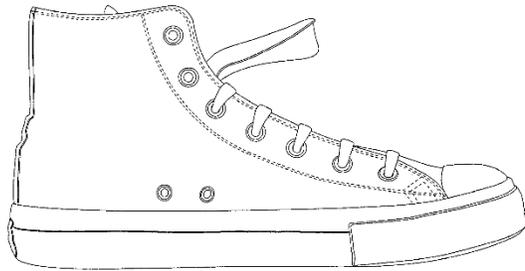
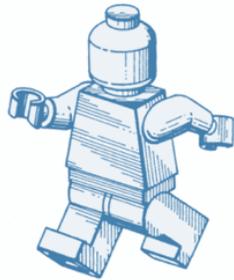


Figure 4

U.S. Patent Dec. 18, 1979 Des. 253,711



USD434136

FIG. 1



FIG. 2



U.S. Patent Sep. 1, 2009 US D599,372 S



USD790336

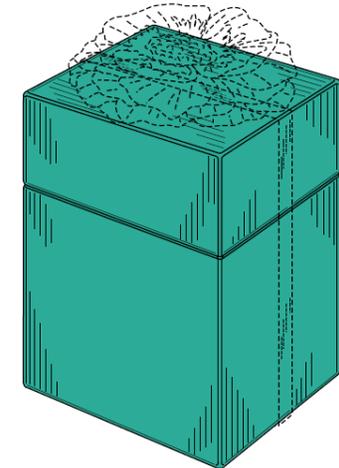
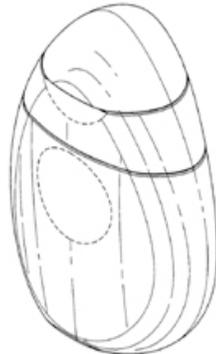


FIG. 1

USD48160

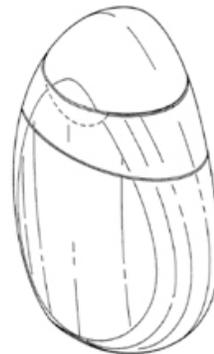


FIG. 1



U.S. D638,714

FIG. 1



U.S. D638,715

FIG. 1



U.S. D650,686

DESIGN PATENTS ARE BEST WHEN THERE IS A DESIRE TO COPY

New Products

Replacement Parts

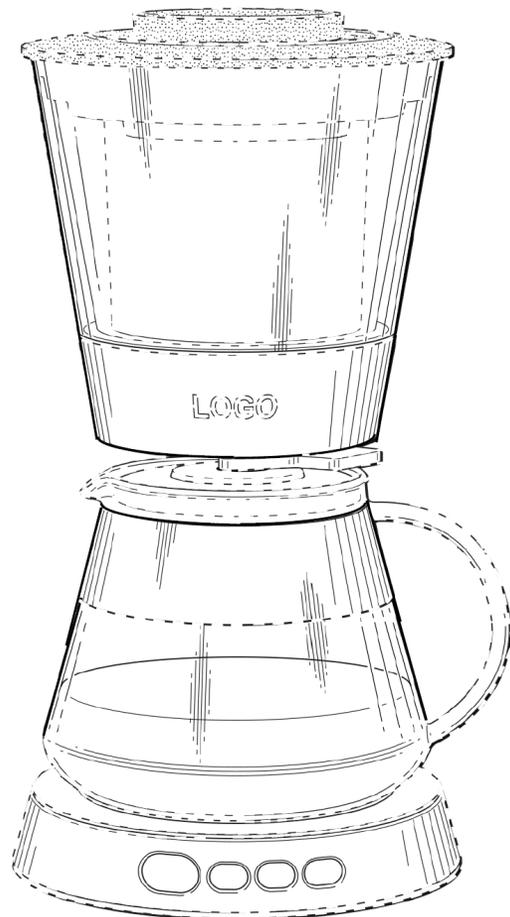
Trade Indicators

Effective Design Patent Enforcement Techniques

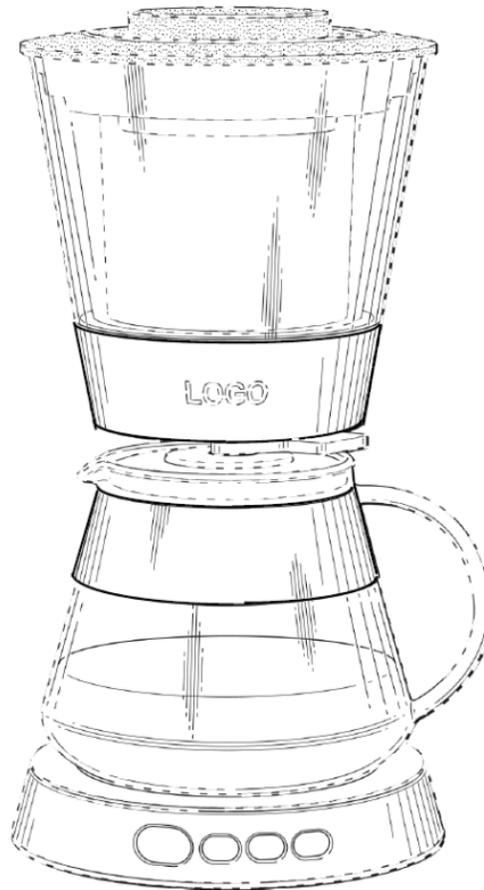


- **NEW PRODUCTS**
- **Key to Effective Coverage**
 - Partial Claiming
 - Multiple Applications
 - Multiple Embodiments*

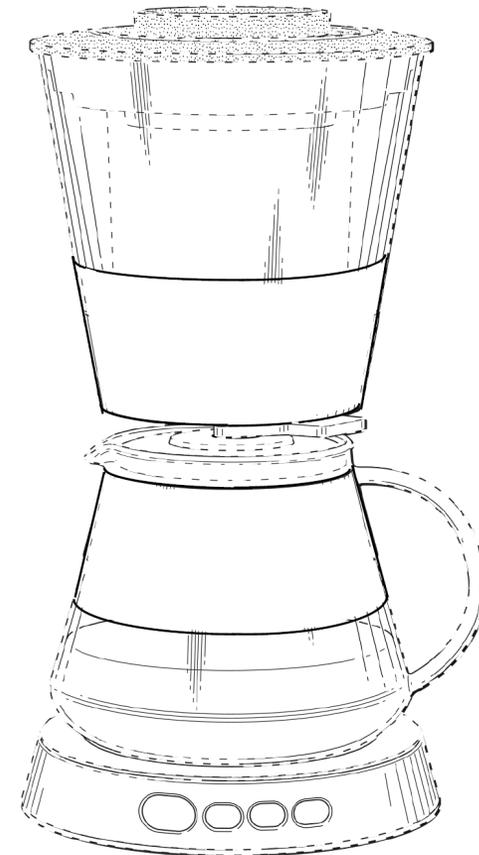
BK BREWER - Partial Claiming



Shape



Metallic or solid ring

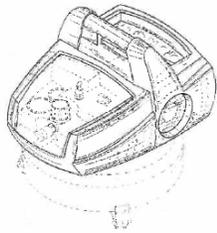


Alt. Embodiment

Partial Designs

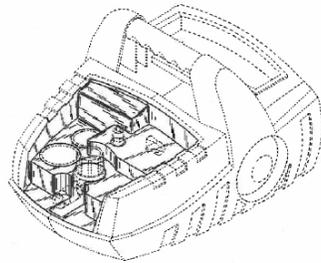
- Avoid Adding Unnecessary Limitations
 - Only features necessary to overcome prior art
 - Separating design concepts

(12) United States Design Patent		(10) Patent No.:	US D475,721 S
Harper et al.		(45) Date of Patent:	Jun. 10, 2003
(54) COMPRESSOR SHROUD	(73) Attorney, Agent, or Firm—Inventor(s)	(57) CLAIM	
(75) Inventors: Douglas R. Harper, Harrison, OH (US); James Louis Tobergis, Batavia, OH (US); Tony Michael Gaertl, Union, KY (US); Min-Hsiang Wang, Taipei (TW); Joseph Robert Stephens, Middletown, OH (US)		We claim the ornamental design for a compressor shroud, as shown and described.	
(77) Assignor: Campbell Hausfeld/Scott Fetzer Company, Harrison, OH (US)		DESCRIPTION	
(**) Term: 14 Years		FIG. 1 is a perspective view of a compressor shroud comprising a first embodiment of the ornamental design of the present invention, the view indicating recesses with broken lines.	
(21) Appl. No.: 29126415		FIG. 2 is a side view of the compressor shroud of FIG. 1.	
(22) Filed: Feb. 27, 2002		FIG. 3 is an opposite side view of the compressor shroud of FIG. 1.	
(51) LOC (7) CL: D159		FIG. 4 is a front view of the compressor shroud of FIG. 1.	
(52) U.S. CL: D157-9; A17414;		FIG. 5 is a rear view of the compressor shroud of FIG. 1.	
(53) Field of Search: 417419, 234, 220, 221, 410-411, 265, 266, D26, 39, 248045, 475		FIG. 6 is a top view of the compressor shroud of FIG. 1.	
		FIG. 7 is a bottom view of the compressor shroud of FIG. 1.	
		FIG. 8 is a perspective view of a compressor shroud comprising a second embodiment of the ornamental design of the present invention, indicating areas of the recesses with solid lines.	
		FIG. 9 is a side view of the compressor shroud of FIG. 8.	
		FIG. 10 is an opposite side view of the compressor shroud of FIG. 8.	
		FIG. 11 is a front view of the compressor shroud of FIG. 8.	
		FIG. 12 is a rear view of the compressor shroud of FIG. 8.	
		FIG. 13 is a top view of the compressor shroud of FIG. 8.	
		FIG. 14 is a bottom view of the compressor shroud of FIG. 8.	
		The broken line showings in FIGS. 1-14 are for illustrative purposes only and form no part of the claimed design.	
		1 Claim, 6 Drawing Sheets	
		Primary Examiner—Ralf Seifert	

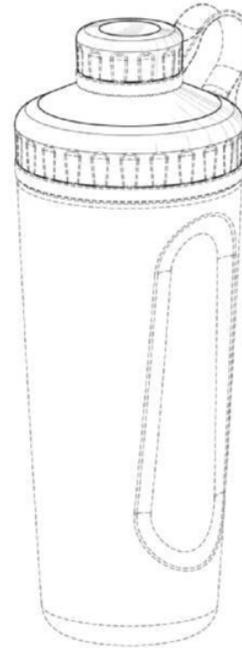


Housing

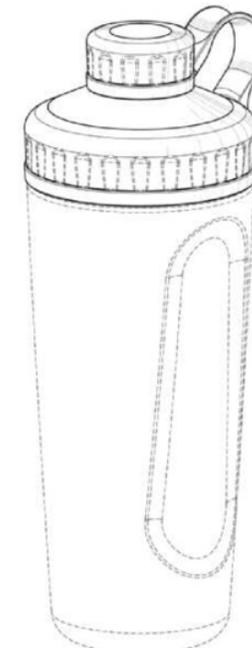
(12) United States Design Patent		(10) Patent No.:	US D489,736 S
Harper et al.		(45) Date of Patent:	May 11, 2004
(54) CONTROL PANEL FOR A COMPRESSOR	(73) Attorney, Agent, or Firm—Inventor(s)	(57) CLAIM	
(75) Inventors: Douglas R. Harper, Harrison, OH (US); James Louis Tobergis, Batavia, OH (US); Tony Michael Gaertl, Union, KY (US); Joseph Robert Stephens, Middletown, OH (US)		We claim the ornamental design for a control panel, as shown and described.	
(77) Assignor: Campbell Hausfeld/Scott Fetzer Company, Harrison, OH (US)		DESCRIPTION	
(**) Term: 14 Years		FIG. 1 is a perspective view of a compressor that includes a control panel but without the ornamental design of the present invention.	
(21) Appl. No.: 29177114		FIG. 2 is a perspective view of the control panel of FIG. 1.	
(22) Filed: Mar. 4, 2003		FIG. 3 is a top view of the control panel of FIG. 1.	
		FIG. 4 is a front view of the control panel of FIG. 1.	
		The broken line showings in FIGS. 1-4 are for illustrative purposes only and form no part of the claimed design.	
		1 Claim, 3 Drawing Sheets	
		Primary Examiner—Ralf Seifert	



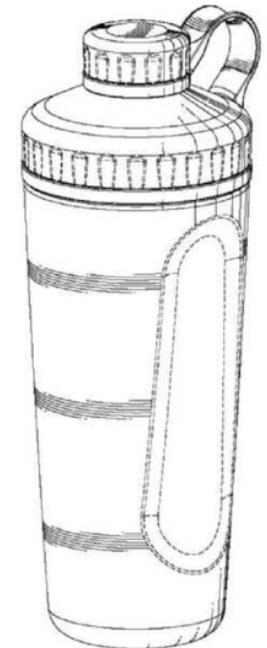
Instrument Panel



Lid



Lid +
connecting
mechanism



Lid +
connecting
mechanism +
bottle

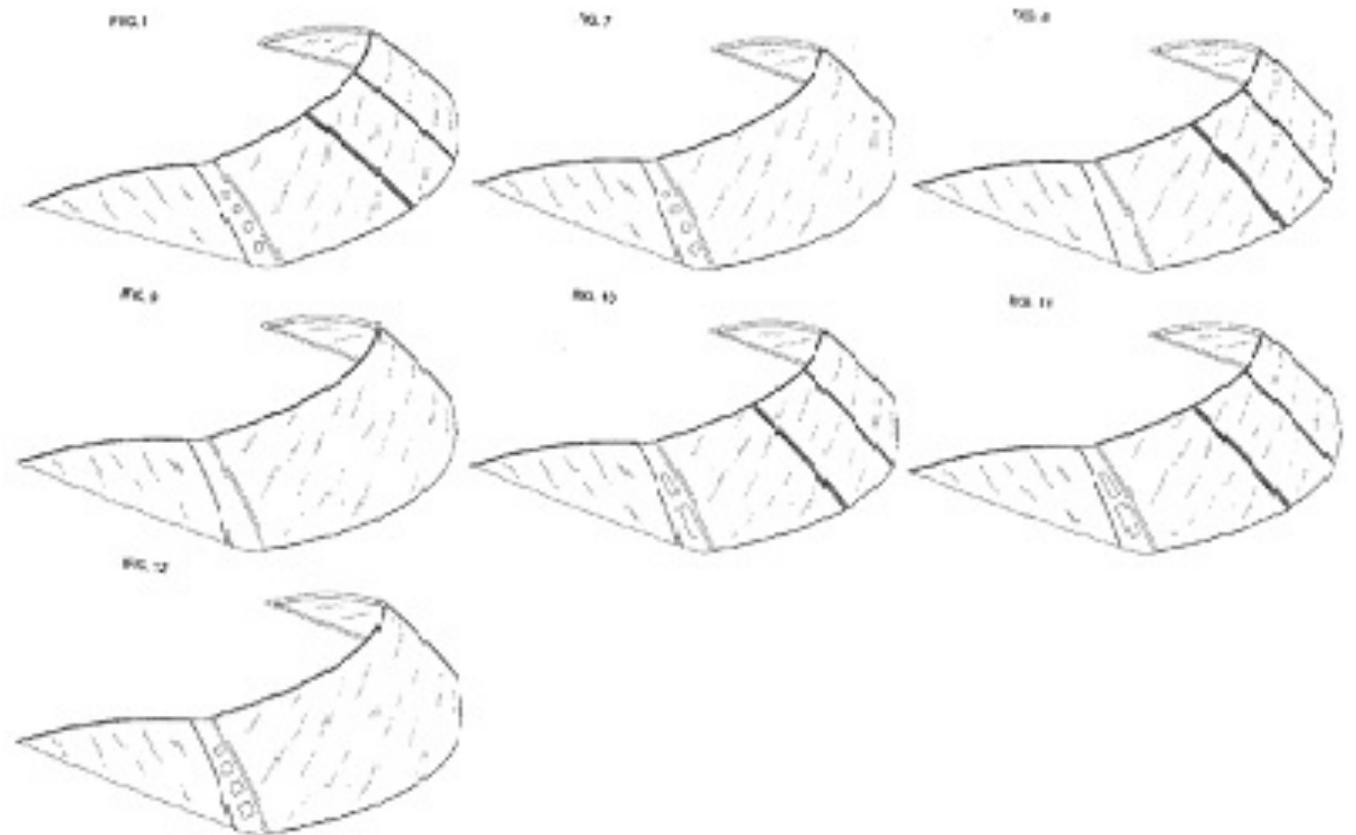
Drafting Design Patents with Scope

Multiple Embodiments

If too broad risk **prosecution estoppel**

Five distinct groups of designs:

- 1) Four circular holes and a hatch (figure 1)
- 2) Four circular or square holes and no hatch (figures 7 & 12)
- 3) No holes and a hatch (figure 8)
- 4) No holes and no hatch (figure 9)
- 5) Two oval or rectangular holes and a hatch (figures 10 & 11).

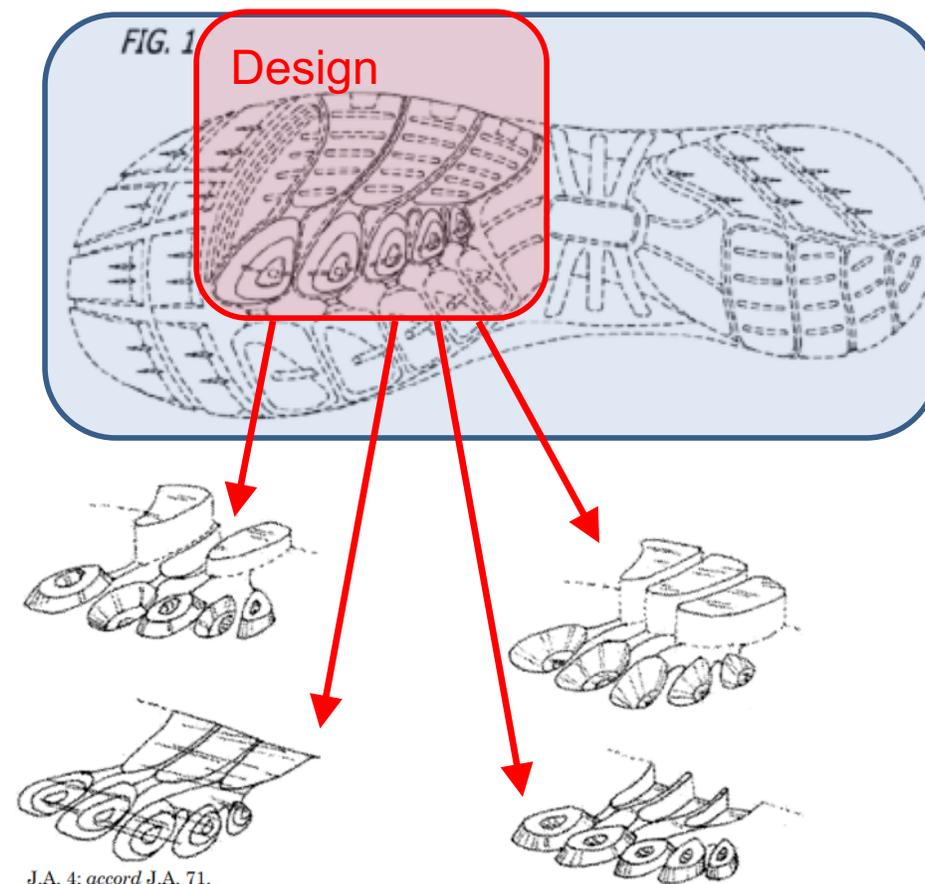


By removing broad claim language referring to alternate configurations and cancelling the individual figures showing the unelected embodiments, the applicant narrowed the scope of his original application, and surrendered subject matter.

Drafting Design Patents with Scope

- Multiple Embodiments

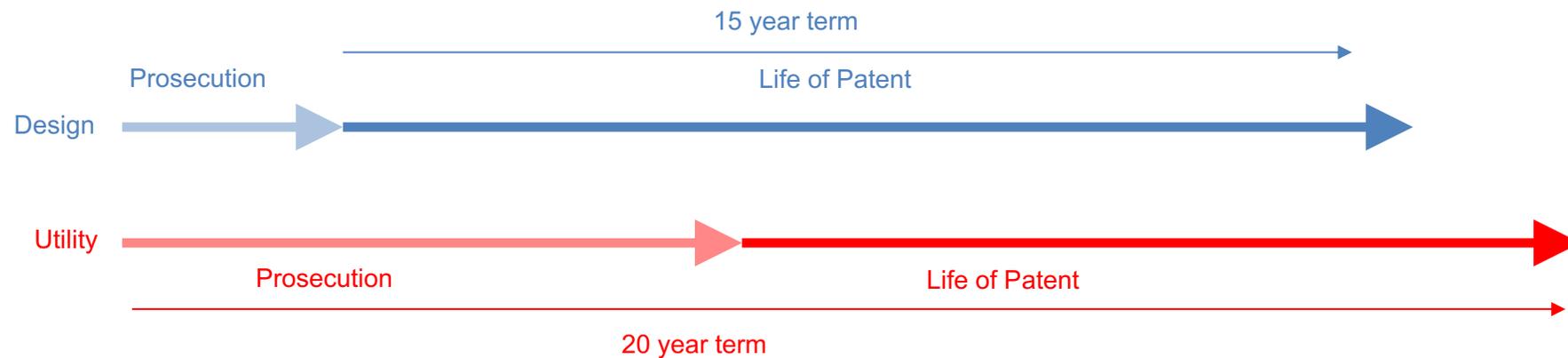
- “A visual disclosure may be inadequate—and its associated claim indefinite—if it includes multiple, internally inconsistent drawings.” – *In re Maatita*, 900 F.3d at 1375
 - Errors and inconsistencies that do not preclude the overall understanding of the design as whole – *Id.* at 1375-76
- “[I]nherently three-dimensional” articles that cannot be adequately disclosed with a single planar-view drawing may require multiple drawings to satisfy the description requirement – *In re Maatita*, 900 F.3d at 1378
- “So long as the scope of the invention is clear with reasonable certainty to an ordinary observer, **a design patent can disclose multiple embodiments within its single claim** and can use multiple drawings to do so.” – *In re Maatita*, 900 F.3d at 1377



Examiner Developed Embodiments

Drafting Design Patents with Scope

- Life of Design Patent
 - 15 years from date of issue
 - No Maintenance Fees
- Utility Patent
 - Life of patent varies because based on date of filing
 - 20 years from date of filing
 - Maintenance Fees Due at 3.5, 7.5, and 11.5



Drafting Design Patents with Scope

(12) **United States Design Patent**
Maglica

(10) **Patent No.:** US D530,439 S
(45) **Date of Patent:** ** Oct. 17, 2006

(54) **FLASHLIGHT**
(75) Inventor: **Anthony Maglica**, Anaheim, CA (US)
(73) Assignee: **Mag Instrument, Inc.**, Ontario, CA (US)
(**) Term: **14 Years**

1,768,554 A	1/1930	Freitag
1,758,835 A	5/1930	Hime
1,769,436 A	7/1930	Koretzky
1,895,913 A	1/1933	Buchholz
1,905,787 A	4/1933	Barber
2,016,819 A	10/1935	Meginniss 240/10.66
2,051,889 A	8/1936	Nygard 240/10.6
2,097,222 A	10/1937	Tompkins et al. 340/10.66

(Continued)

(21) Appl. No.: **09/385,129**

(22) Filed: **Aug. 27, 1999**

FOREIGN PATENT DOCUMENTS

AU	114558	1/1942
AU	138873	10/1950
DE	2408928	of 1976
FR	1430456	of 1966
FR	2378882	of 1976
GB	292836	of 1928
GB	411218	of 1934
GB	549104	of 1942
GB	752619	of 1956
GB	812980	of 1959
GB	884212	of 1961
GB	2091863	of 1982

OTHER PUBLICATIONS

P. 243 of Japanese Patent Gazette Feb. 16, 1982—Utility Model 42071.

(Continued)

Primary Examiner—Alan P. Douglas
(74) *Attorney, Agent, or Firm*—Jones Day

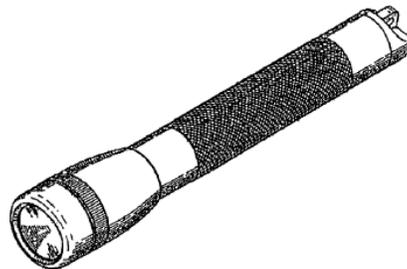
(57) **CLAIM**

The ornamental design for a flashlight, as shown and described.

DESCRIPTION

FIG. 1 is a front perspective view of a flashlight showing my new design;
FIG. 2 is a side elevational view thereof; and,
FIG. 3 is a front elevational view thereof.

1 Claim, 1 Drawing Sheet



(10) **Patent No.:** **US D530,439 S**
(45) **Date of Patent:** **** Oct. 17, 2006**

(22) **Filed:** **Aug. 27, 1999**

(63) Continuation of application No. 07/410,965, filed on Sep. 22, 1989, now abandoned, which is a division of application No. 07/356,361, filed on May 23, 1989, now Pat. No. 4,942,505, which is a continuation of application No. 07/222,378, filed on Jul. 19, 1988, now Pat. No. 4,899,265, which is a continuation of application No. 07/034,918, filed on Apr. 6, 1987, now abandoned, which is a continuation of application No. 06/828,729, filed on Feb. 11, 1986, now Pat. No. 4,658,336, which is a continuation of application No. 06/648,032, filed on Sep. 6, 1984, now Pat. No. 4,577,263.

Drafting Design Patents with Scope

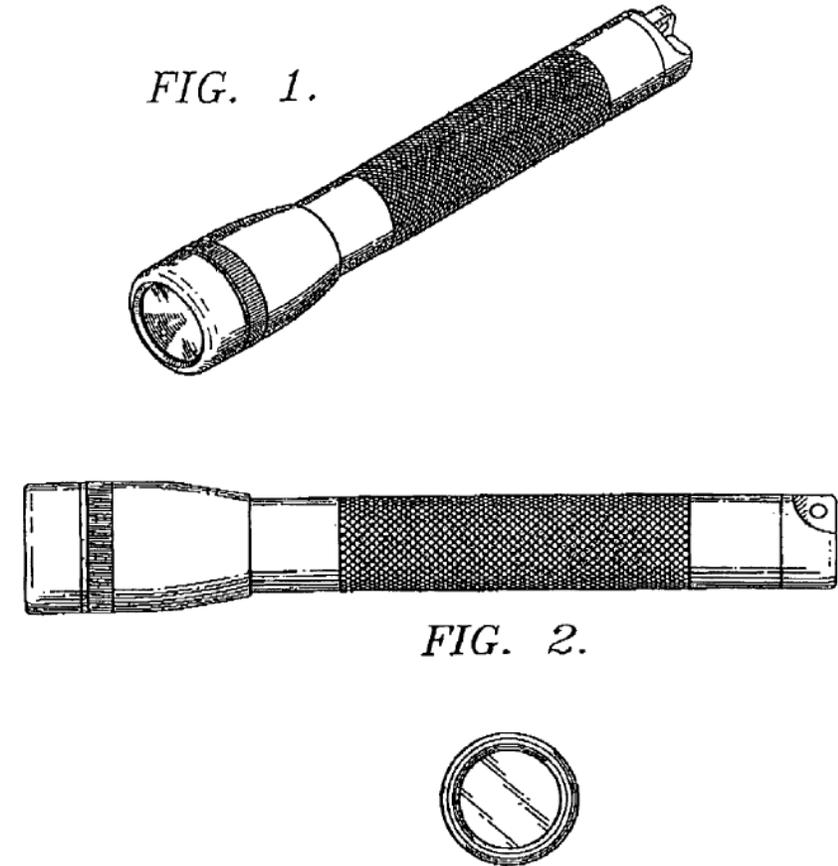
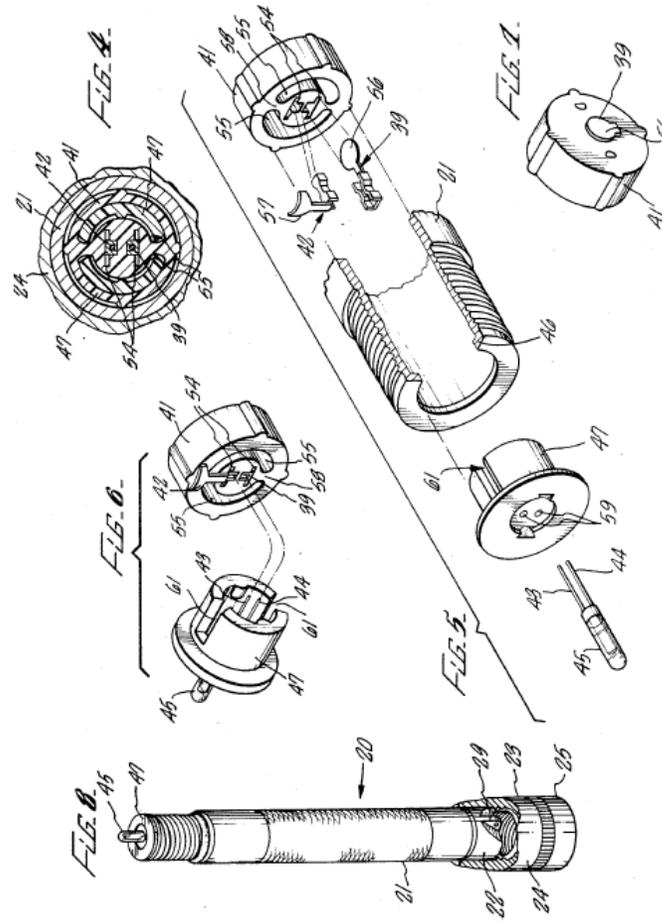
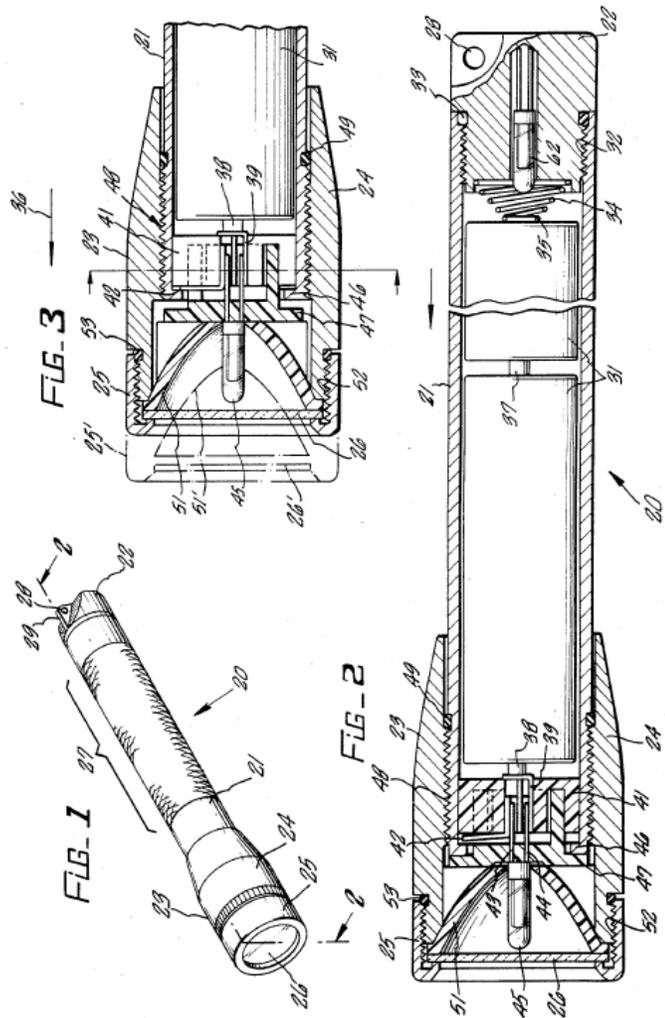
U.S. Patent Mar. 18, 1986 Sheet 1 of 2 4,577,263

U.S. Patent Mar. 18, 1986 Sheet 2 of 2 4,577,263

U.S. Patent

Oct. 17, 2006

US D530,439 S



Claiming Benefit and Priority

- Non-provisional utility
 - Where the conditions of 120 are met, a design application may claim benefit of the filing date of an earlier filed U.S. Non-Provisional or PCT application under 35 U.S.C. 120. *Racing Strollers Inc. v. TRI Industries Inc.*, 878 F.2d 1418, 11 USPQ2d 1300 (Fed. Cir. 1989).
- International Design Applications
 - Priority may be claimed under 35 U.S.C. § 386(a) within 6 months of filing if application designates at least one country other than the U.S.
 - Like a PCT application, benefit may also be claimed under 35 U.S.C. § 120 if international application designates the U.S.
- Provisional applications
 - No priority granted from provisional applications for design applications – [35 USC §172](#)
- Foreign applications
 - “[t]he right of priority [provided under 35 U.S.C. 119(a)-(d)] shall be six months in the case of designs” – [35 USC §172](#)

Drafting Design Patents with Scope – Foreign Markets

Global lack of uniformity

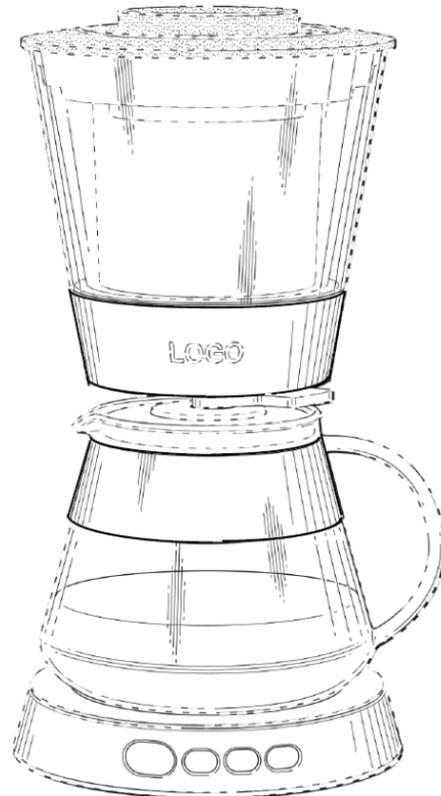
United States	Canada	Japan	China	Taiwan
<p><u>Specification</u></p> <ul style="list-style-type: none"> Brief description – 37 CFR 1.154 <ul style="list-style-type: none"> In practice may be limited to title <p><u>Drawings</u></p> <ul style="list-style-type: none"> Only 1 view required Allows dashed and shading lines <p><u>Claiming</u></p> <ul style="list-style-type: none"> Permits partial designs (claiming portion of product) <p><u>Grace Period</u></p> <ul style="list-style-type: none"> 12 months 	<p><u>Specification</u></p> <ul style="list-style-type: none"> Diligent description of all aspects of intended use 	<p><u>Specification</u></p> <ul style="list-style-type: none"> Diligent description of all aspects of intended use <p><u>Drawings</u></p> <ul style="list-style-type: none"> 6 orthogonal views required <ul style="list-style-type: none"> Allows extrapolating drawings from US patent Recently permits dashed and shading lines <p><u>Grace Period</u></p> <ul style="list-style-type: none"> 12 months 	<p><u>Drawings</u></p> <ul style="list-style-type: none"> 6 orthogonal views required No dashed or shading lines <p><u>Claiming</u></p> <ul style="list-style-type: none"> Must claim and show entire product 	<p><u>Drawings</u></p> <ul style="list-style-type: none"> Permits dashed lines or does not permit shading lines <p><u>Grace Period</u></p> <ul style="list-style-type: none"> 6 months

BK BREWER – Protecting Foreign Interest

US - Partial



Shape



Metallic or solid ring



Coffee Pot

China - Full



**May delete with
preliminary amendment
to avoid risk of
restriction requirement**

Drafting Design Patents with Scope – Foreign Markets

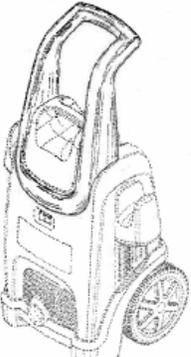
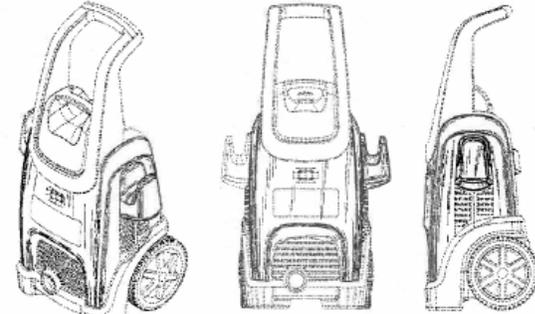
Example

- US: partial designs
- China: entire product

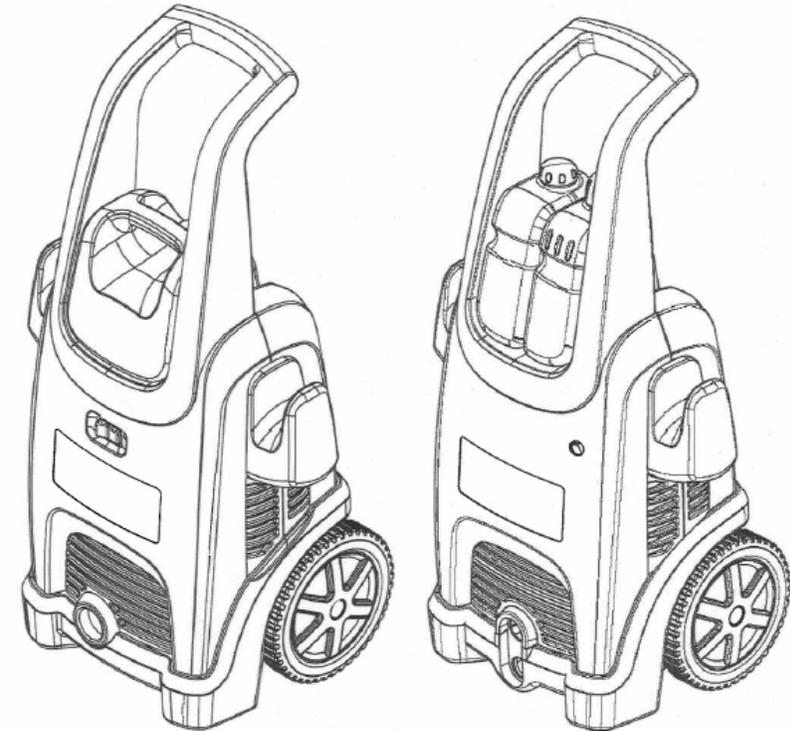
U.S.

Claims only the handle

Claims only a section of the housing

<p>(12) United States Design Patent (10) Patent No.: US D521,694 S Ricker et al. (45) Date of Patent: May 23, 2006</p> <p>(54) PRESSURE WASHER D489,599 S * 4/2004 Cattaneo D02/12 D489,600 S * 5/2004 Cattaneo D02/12 D490,196 S * 5/2004 Cattaneo D02/12 D490,048 S * 6/2004 Cattaneo D02/12 D490,903 S * 9/2004 Chen D02/16 D490,767 S * 9/2004 Chen D02/16 2005-0189437 A1 * 9/2005 Alexander et al. 256-332</p> <p>* cited by examiner</p> <p>(73) Assignee: Campbell Hausfeld/Scott Fetzer Company, Harrisburg, OH (US) Primary Examiner—Louis S. Zarfas Assistant Examiner—Kathleen Sims (74) Attorney, Agent, or Firm—Stroger Day</p> <p>(**) Term: 14 Years</p> <p>(21) Appl. No.: 29233,413</p> <p>(22) Filed: Jul. 1, 2005</p> <p>(51) LOC (09) Cl. 15-05 (52) U.S. Cl. D02/15</p> <p>(58) Field of Classification Search D02/1, D02/15, 16, 21, 22, 25, 31, 15347, 320, 15321, 3, 323, 352, 405; 134/200; 239/146-9; D157; D34/24, 27, 25, 26, D3/276, 279 See application file for complete search history.</p> <p>(56) References Cited U.S. PATENT DOCUMENTS D381,779 S * 7/1997 Pritchett et al. D02/21 D481,838 S * 11/2003 Renner D02/15</p> <p>1 Claim, 5 Drawing Sheets</p> 	<p>(12) United States Design Patent (10) Patent No.: US D520,687 S Ricker et al. (45) Date of Patent: May 9, 2006</p> <p>(54) PRESSURE WASHER D489,196 S * 5/2004 Lutzbell D02/15 D490,848 S * 6/2004 Cattaneo D02/15 D496,303 S * 9/2004 Chen D02/16 D496,767 S * 9/2004 Chen D02/16 2005-0189437 A1 * 9/2005 Alexander et al. 239-332</p> <p>OTHER PUBLICATIONS U.S. Appl. No. 29212,652, filed Sep. 3, 2004, (15 pages) * cited by examiner</p> <p>(73) Assignee: Campbell Hausfeld/Scott Fetzer Company, Harrisburg, OH (US) Primary Examiner—Louis S. Zarfas Assistant Examiner—Kathleen Sims (74) Attorney, Agent, or Firm—Stroger Day</p> <p>(**) Term: 14 Years</p> <p>(21) Appl. No.: 29233,377</p> <p>(22) Filed: Jul. 1, 2005</p> <p>(51) LOC (09) Cl. 15-05 (52) U.S. Cl. D02/15</p> <p>(58) Field of Classification Search D02/1, D02/15, 16, 21, 22, 25, 31; 15345, 350, 15321, 3, 323, 352, 405; 134/200, 239/146-9; D157; D34/24, 27, 25, 26 See application file for complete search history.</p> <p>(56) References Cited U.S. PATENT DOCUMENTS D381,779 S * 7/1997 Pritchett et al. D02/21 D481,838 S * 11/2003 Renner D02/15 D489,596 S * 4/2004 Cattaneo D02/15 D489,494 S * 5/2004 Cattaneo D02/15</p> <p>1 Claim, 5 Drawing Sheets</p> 
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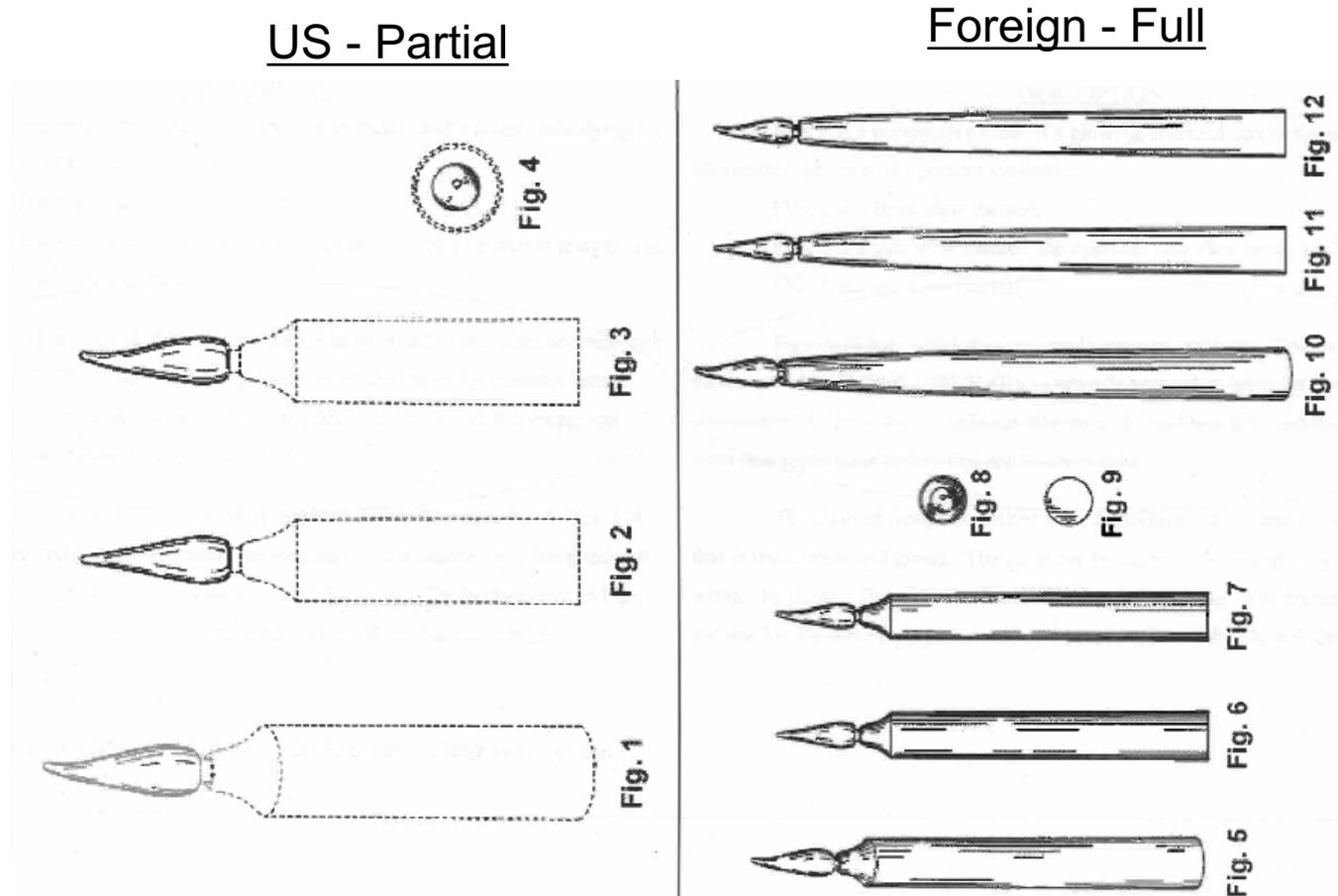
1st appl'n claims 1st Product CHINESE 2nd appl'n claims 2nd Product



How do you file a patent in the US without forfeiting foreign markets?

Drafting Design Patents with Scope – Foreign Markets

- Option 1: multiple applications
 - Avoids restriction requirements
 - May limit invention in unintended ways
 - Expensive up-front cost
- Option 2: preliminary amendment
 - File all embodiments necessary for foreign priority and continuations
 - Avoid restriction requirement



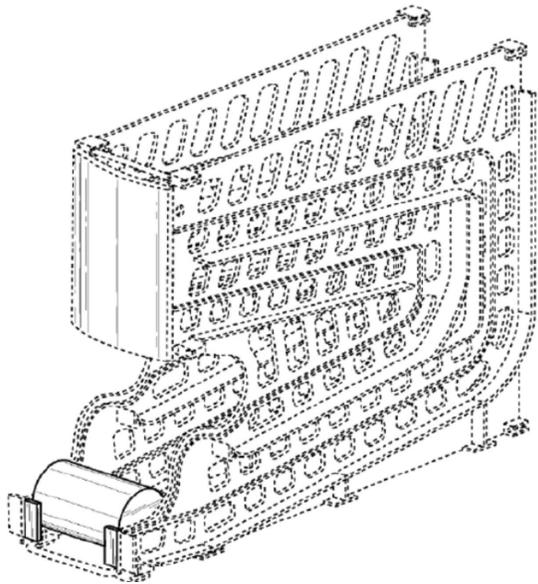
- FIGS. 5-12 are views similar to FIGS 1-4, but with all features drawn in solid lines. The scope of the claimed design of this application is defined by FIGS 1-4, and not by FIGS. 5-12. However, FIGS 5-12 are included in this application as originally filed to provide antecedent basis for possible future amendments to FIGS. 1-4 in accordance with paragraph (A) of MPEP 1503.01 (II). Applicants intend to delete FIGS. 5-12 and this paragraph from this application before this application issues.

Obviousness

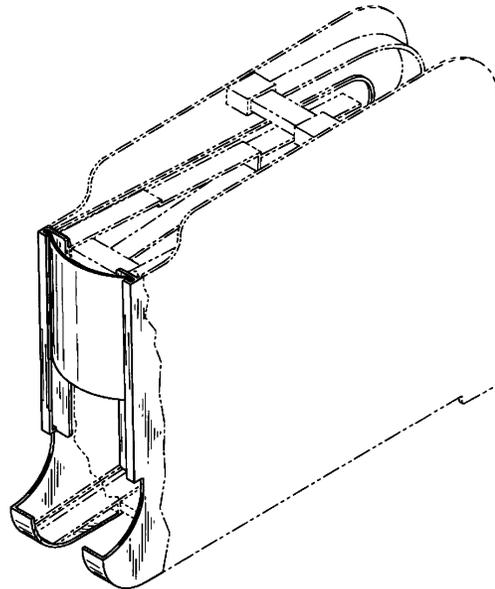
- “To determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design,” ***the fact finder must first “find a single reference***, a something in existence, the design characteristics of which are basically the same as the claimed design.” *Campbell Soup Co.*, at *2 (quoting *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012))
- To identify a primary reference, one must: “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘***basically the same***’ visual impression.” ***If a primary reference exists, related secondary references may be used to modify it.*** *Campbell Soup Co.*, at *2 (Fed. Cir. 2019) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996))

Obviousness

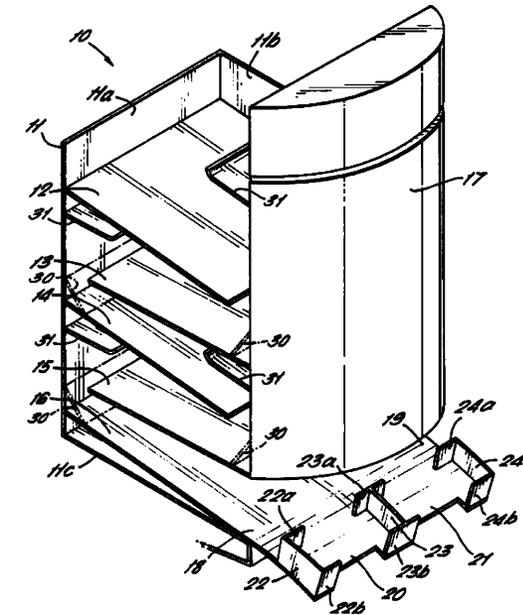
“In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been **obvious to a designer of ordinary skill who designs articles of the type involved.**” [Campbell Soup Co. v. Gamon Plus, 2019 WL 4678100, at *2 \(Fed. Cir. 2019\)](#)



'646 Patent



Linz reference



Samways reference

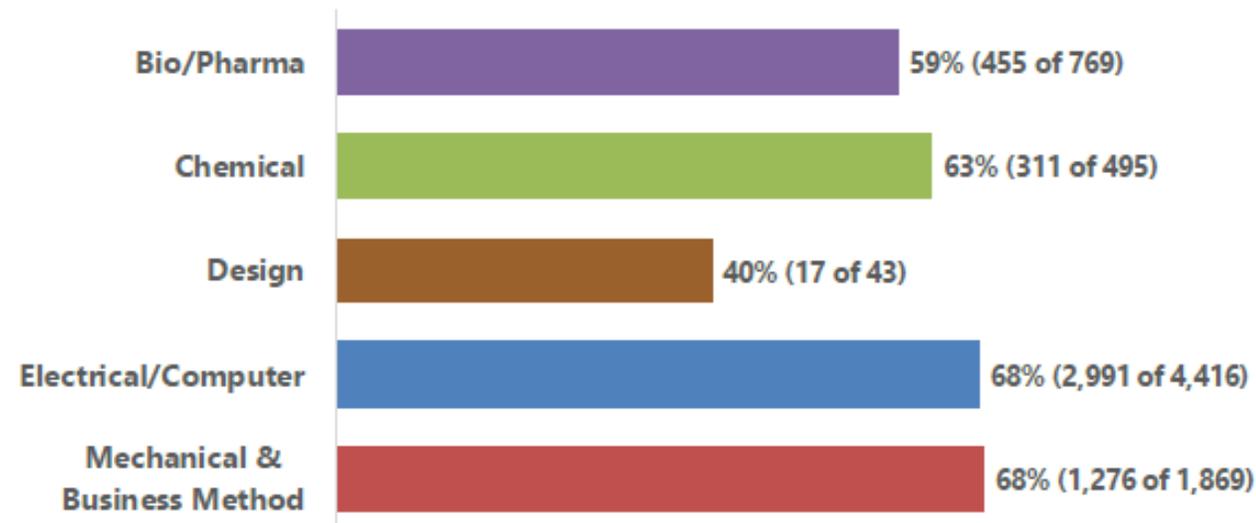
Obviousness

- **The Board** found that *Linz* was **not a proper primary reference**. Specifically, it found that “Linz **does not disclose any object**, including the size, shape, and placement of the object in its display area” and “fails to disclose a cylindrical object below the label area in a similar spatial relationship to the claimed design.”
 - [W]e reverse the Board’s factual finding that Linz is not a proper primary reference for **lack of substantial evidence** support. *Campbell Soup Co., at *2*
- **The Board** further found that *Samways* was **not a proper primary reference**. Specifically, it found that “**significant modifications would first need to be made** to Samways’ design, such as combining two distinct embodiments of the utility patent,” which is “not a design in existence.”
 - Accepting the Board’s description of the claimed designs as correct, **substantial evidence supports the Board’s** finding that Samways is not a proper primary reference. *Campbell Soup Co., at *3*

IPRs – Institution Phase

- IPRs are less likely to be instituted for design patents
 - Instituted 40% of the time -- compared to over 66% for other patents

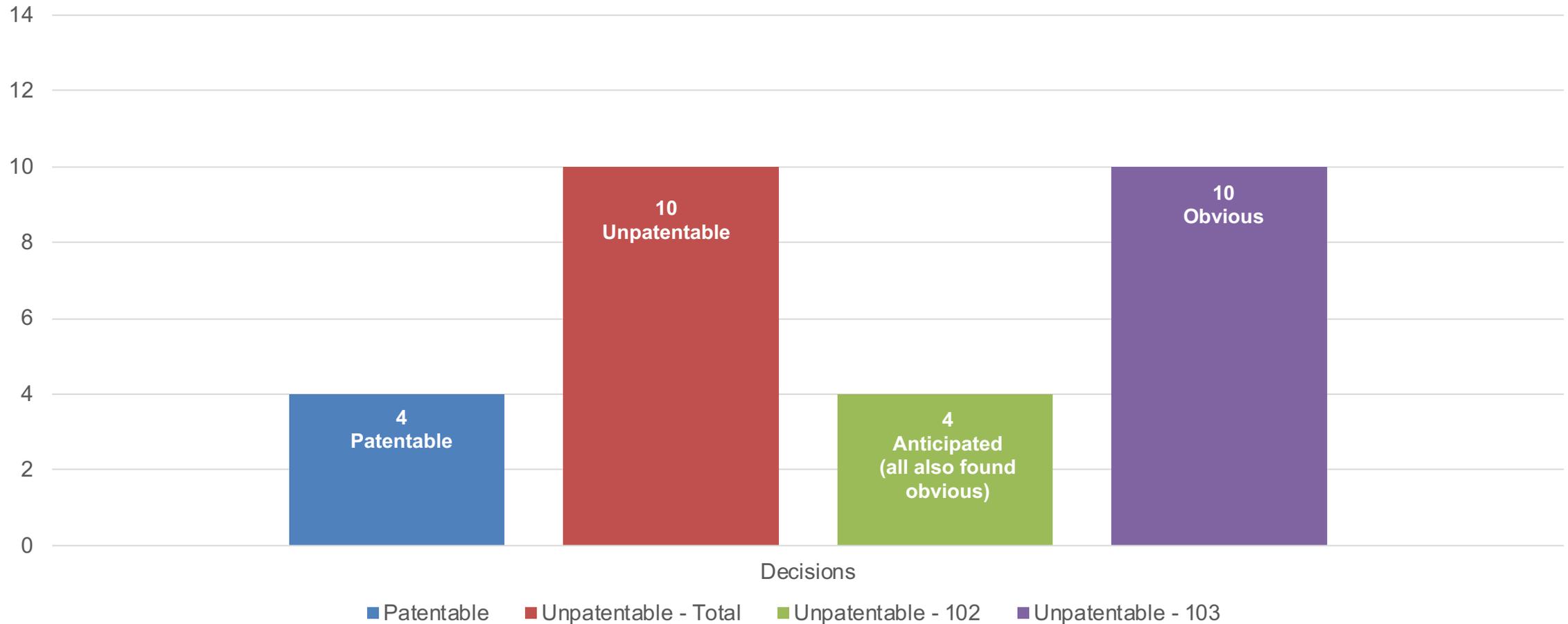
Institution Rates by Technology (All Time: Sept. 16, 2012 to Feb. 28, 2019)



https://www.uspto.gov/sites/default/files/documents/trial_statistics_2019_february.pdf

IPR – Decision Phase

IPR Results

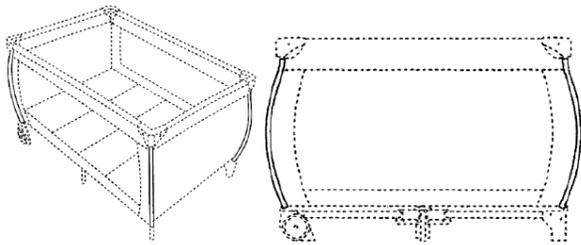


*Based on search using USPTO database at <https://developer.uspto.gov/ptab-web/#/search/proceedings>

1-8-14 to 10-23-18

Example: IPR2016-00816

We are persuaded that Petitioner has demonstrated by a preponderance of the evidence that the claim of the '970 patent and the claim of the '231 patent both are unpatentable under 35 U.S.C. § 103(a) as obvious over Chen '393.



Design
('970 Patent)

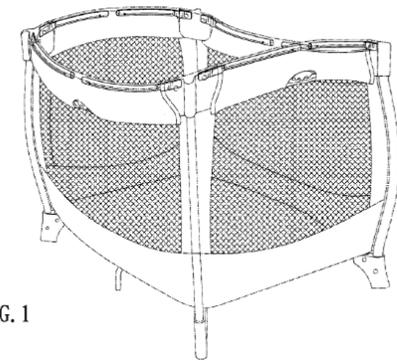
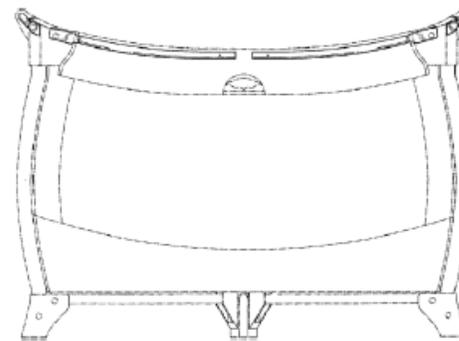
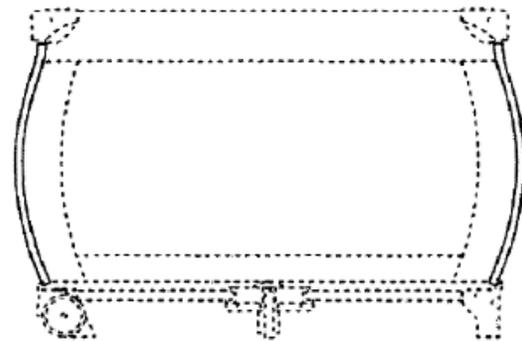


FIG. 1

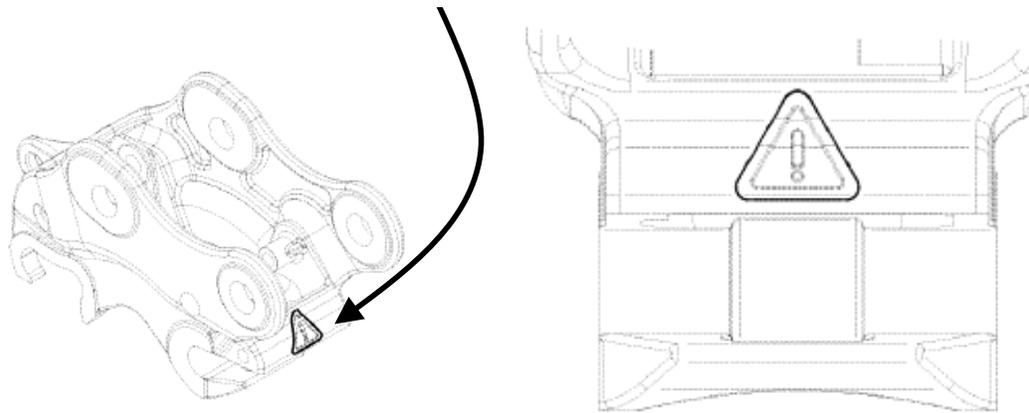
Prior Art
(Chen '393)

Design features: (1) Curved legs that bow outward (2) No fabric covering exposed legs (3) Outward flaring at top of the legs

Example: IPR2015-00416

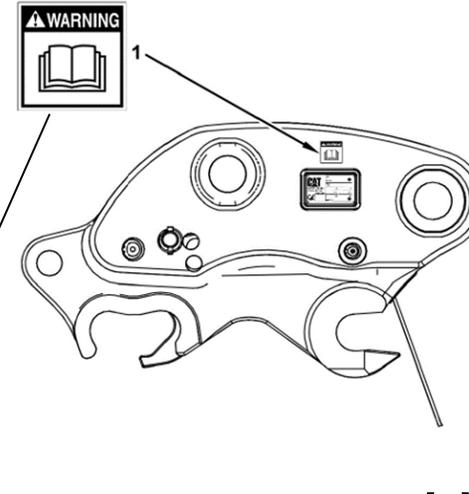
Design ('982 Patent)

Figure 3	Construction
 <p>FIG. 3</p>	<p>The ornamental design of the operator visible warning symbol, as illustrated in Figures 1–7, except that the broken lines form no part of the claimed design, and the ornamental design includes an equilateral triangle with rounded corners and a horizontal base that is shaped as if projected onto a laterally extruded “S”-shaped surface, as shown in the solid lines in Figs. 1–7 of the '982 patent.</p>



Prior Art

Coupler Manual



Int'l Standard



W001
General warning sign

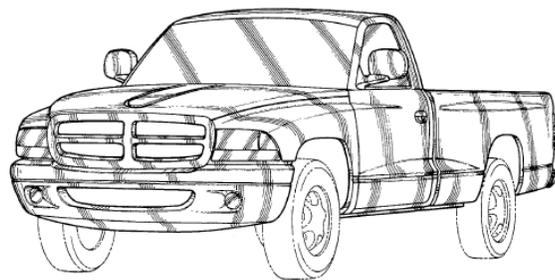
Hub coupler



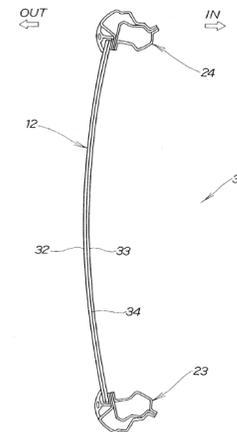
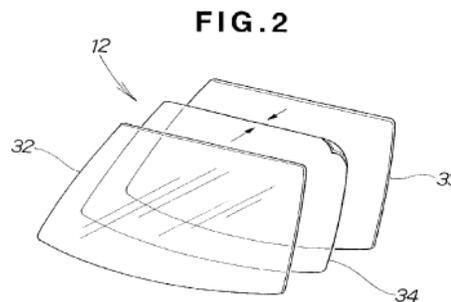
“[T]he Coupler Manual is a suitable primary reference because the Coupler Manual warning symbol gives the same overall impression when compared to the claimed warning symbol design as a whole . . . minor differences in the designs are little, if any, significance to the ordinary observer

Obviousness

- Modifications are **not de minimis if they relate to the over all aesthetic appearance** of the design of a base reference – *In re Carter*, 673 F.3d 1378, 1380 (CCPA 1982)
- When more than *de minimis* modifications are required to make a prior art design look like a claimed design, the prior art design does not qualify as a basic reference – *In re Harvey*, 12 F.3d 1061, 165 (Fed. Cir. 1993)



Prior Art
USD373,979



Prior Art
US2003227109

Design '526 Patent



Figure 2



Figure 5

DESIGN PATENTS ARE BEST WHEN THERE IS A DESIRE TO COPY

New Products

Replacement Parts

Trade Indicators

Effective Design Patent Enforcement Techniques



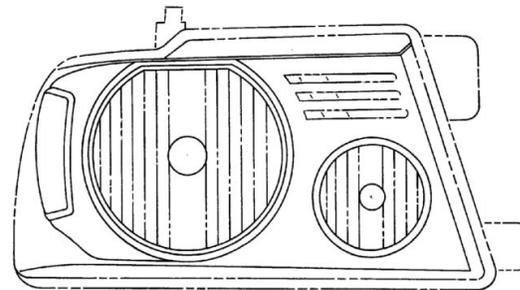
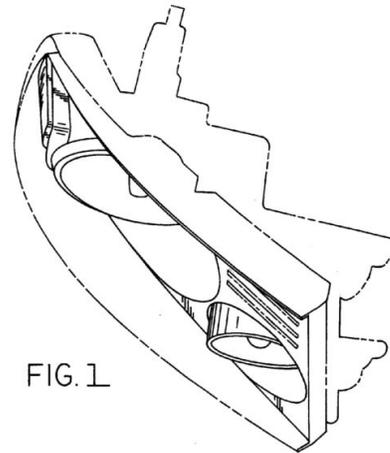
REPLACEMENT PARTS

Key to Effective Coverage

- Partial Claiming
- Multiple Applications
- Multiple Embodiments
- Focus on “design[s] to match other parts of a whole” for “the aesthetic appeal”

Automotive Body Parts Association v. Ford Global Technologies, LLC, 930 F.3d 1314 (Fed. Cir. 2019)

- Replacement Parts
- Copying
- **Functionality**
- Exhaustion



Functionality Doctrine – Judicially Created Exception

- Design Patent
 - “new, original and ornamental design[s] for an article of manufacture”
- **Really a Lack of Ornamentality**
 - FUNCTIONALITY
 - “A design or shape that is entirely functional, ***without ornamental or decorative aspect***, does not meet the statutory criteria of a design patent.” *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997).
 - HIDDEN FROM VIEW
 - Where items hidden from view, “appearance cannot be a matter of concern.” *In re Stevens*, 173 F.2d 1015, 1015 (CCPA 1949).
 - “It seems naïve in the extreme to believe that anyone would try to ‘ornament’ the rubber gasket on the underside of the bung cap for a gasoline drum.” *In re Carletti*, 328 F.2d 1020 (CCPA 1964).

Functionality Doctrine – Judicially Created Exception

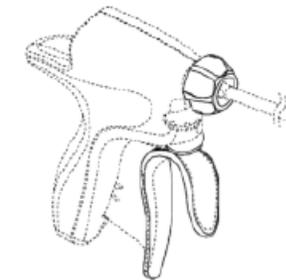
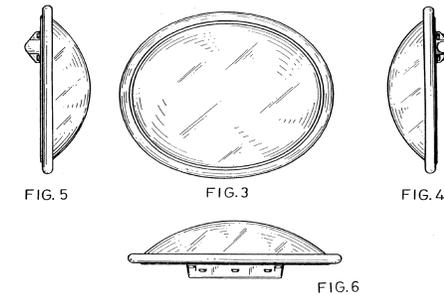
- Functionality Standard – Design Patents

- "[T]he design must not be governed solely by function, *i.e.*, that this is not the **only possible form of the article** that could perform its function." *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373 (Fed. Cir. 2002)

- "We have often focused, however, on the **availability of alternative designs** as an important—if not dispositive—factor in evaluating legal functionality." – *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015)

- "[E]stablished law bars design patents on **primarily functional** designs for lack of ornamentality"

Auto. Body Parts Ass'n v. Ford Global Techs., LLC, 930 F.3d 1314, 1316 (Fed. Cir. 2019) [hereinafter *ABPA*]



D'804 patent, Fig. 1



Covidien's accused product

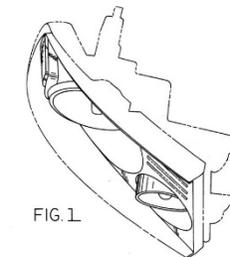


FIG. 1

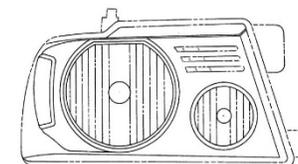


FIG. 2

Automotive Body Parts Association v. Ford Global Technologies, LLC, 930 F.3d 1314 (Fed. Cir. 2019)

- Functionality
 - “We hold that, even in this context of a **consumer preference** for a particular design **to match** other parts of a whole, the aesthetic appeal of a design to consumers is inadequate to render that design functional.”

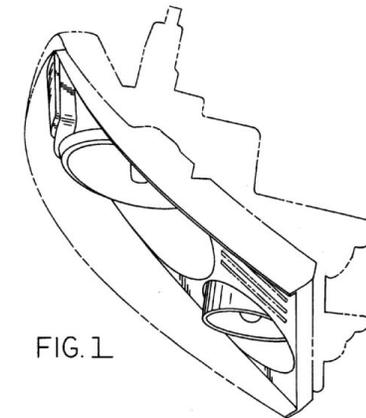


FIG. 1

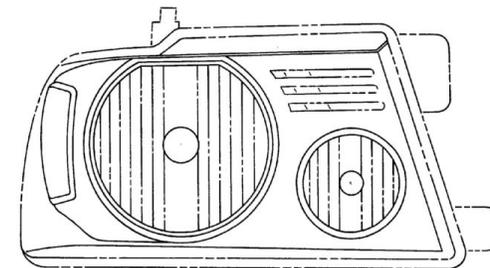


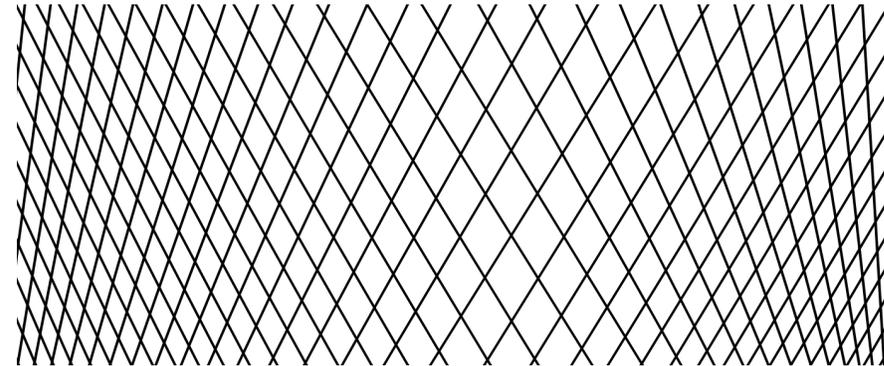
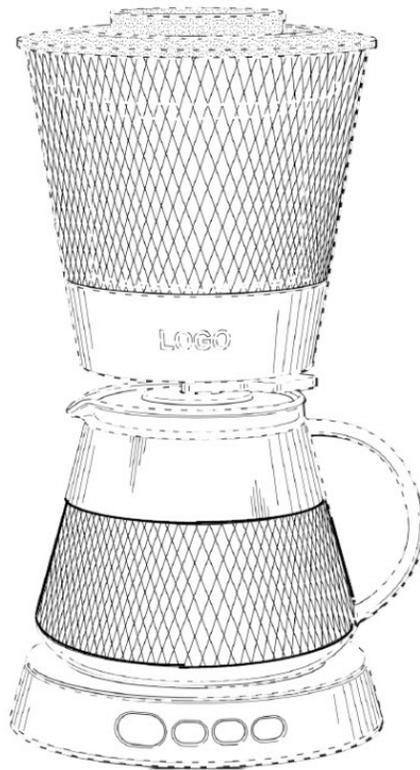
FIG. 2

Replacement Parts – Coordinating Design Elements



Replacement Parts – Surface Texture

- BK Coffee Brewer



Surface Texture Design

Replacement Parts – Patterns

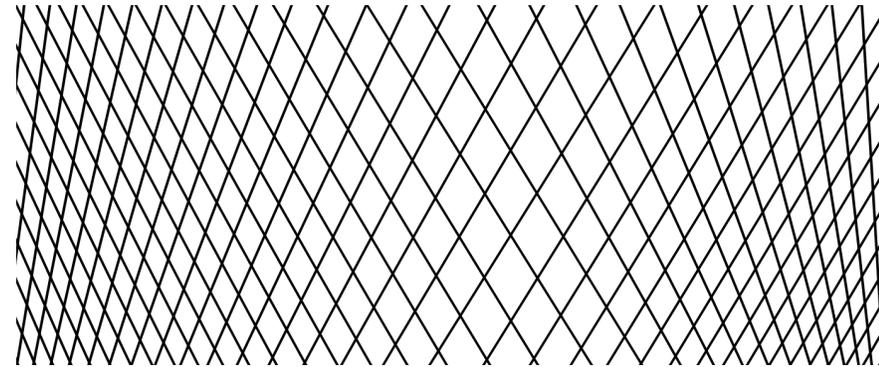
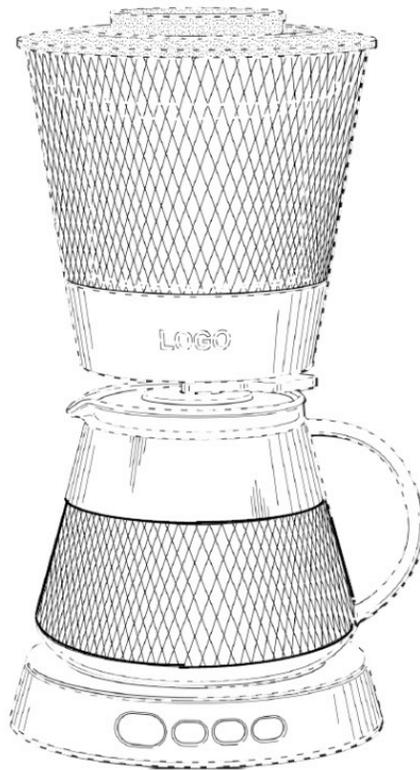
- Design patents are **limited to “article[s] of manufacture”**
 - *Apple v. Samsung*: “Broad enough to embrace both a product sold to a consumer and a component of the product, whether sold separately or not” 137 S. Ct. at 436 (2015)
- *Curver Luxembourg, SARL v. Home Expressions Inc.* (Fed. Cir. 2019)
 - Title define article of manufacture and may be limiting
 - TITLE: “Pattern for a Chair”



- Similar design on basket was non-infringing

Replacement Parts – Surface Texture

- BK Coffee Brewer



Surface Texture Design

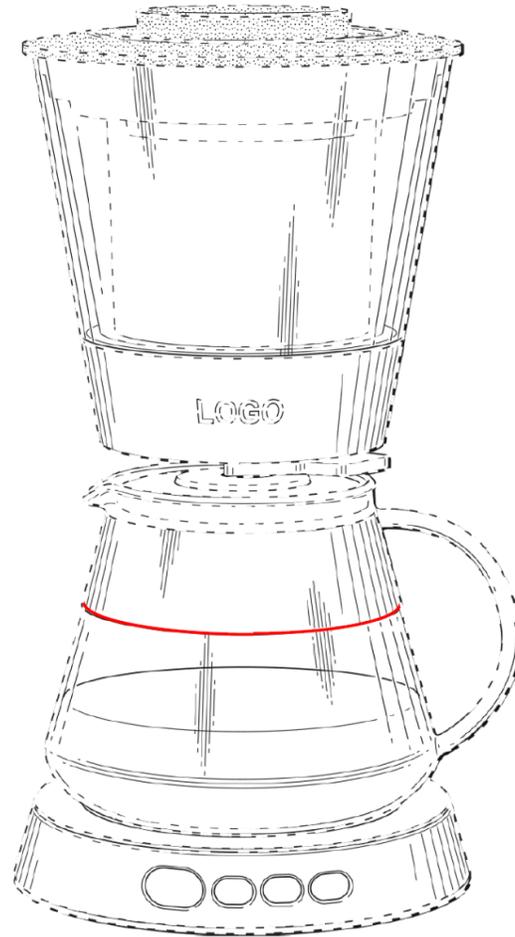
Other Potential Claims

The ornamental design of a surface pattern for a pot, as shown and described.

The ornamental design of a surface pattern for a kitchen appliance, as shown and described.

The ornamental design of a surface pattern for a pot, container, or appliance or the like, as shown and described. (MPEP1504.04.)

Replacement Parts – Coordinating Design Elements



Color



Color – How to Claim

- Color photographs can be included to claim color as an aspect of a design

FIG. 2



(57)

CLAIM

The ornamental design for a fluorescent yellow colored plastic net structure, as shown and described.

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

FIG. 1 is an enlarged fragmented front view of a fluorescent yellow colored plastic net structure showing my new design in a flat configuration; and,

FIG. 2 is a perspective view of the fluorescent yellow colored plastic net structure of FIG. 1 in a rolled-up configuration.

Color, namely fluorescent yellow color, is a feature of the design as noted in the informal drawings comprising the color photographs that were submitted with the application.

United States Design Patent (10) Patent No.: US D732,189 S
Colciago (45) Date of Patent: ** Jun. 16, 2015

(54) FLUORESCENTYELLOW COLORED PLASTIC NET STRUCTURE 2,690,769 A * 10/1954 Brown 138/125
2,885,749 A * 5/1959 Jurek 411/466
3,051,987 A * 9/1962 Mercer 264/103
3,744,529 A * 7/1973 Jorka et al. 138/125
D356,644 S * 3/1995 Henderson D25/48.8
D574,157 S * 8/2008 Batchelor D5/1
D634,201 S * 9/2010 Hendricks D25/100
(72) Inventor: Jessica Colciago, Baltimore, MD (US) 2001/0052595 A1* 12/2001 Hulet 258/11
2004/0135134 A1* 7/2004 Rice 256/32
2007/0235151 A1* 10/2007 Stull 160/351
(73) Assignee: TENAX CORPORATION, Baltimore, MD (US) * cited by examiner

(**) Term: 14 Years Primary Examiner – Doris Clark
(74) Attorney, Agent or Firm: Cliff P.C.

(21) Appl. No.: 29/449,091 (57) CLAIM
(22) Filed: Mar. 15, 2013 The ornamental design for a fluorescent yellow colored plastic net structure, as shown and described.

(51) LOC (10) CL 25-02 DESCRIPTION
(52) U.S. CL.

USPC D25/48.8
(58) Field of Classification Search The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.
USPC D51, 2, 3, 54; 256/5, 11, 45, DIG. 4, 256/32; 52/342, 344, 388, 408, 457, 635, 652, 653, 654, 655, 656, 657, 658, 659, 660, 670, 671, 672, 673, 674, 675, 676, 677, 678, 679, 680, 681, 682, 683, 684, 685, 686, 687, 688, 689, 690, 691, 692, 693, 694, 695, 696, 697, 698, 699, 700, 701, 702, 703, 704, 705, 706, 707, 708, 709, 710, 711, 712, 713, 714, 715, 716, 717, 718, 719, 720, 721, 722, 723, 724, 725, 726, 727, 728, 729, 730, 731, 732, 733, 734, 735, 736, 737, 738, 739, 740, 741, 742, 743, 744, 745, 746, 747, 748, 749, 750, 751, 752, 753, 754, 755, 756, 757, 758, 759, 760, 761, 762, 763, 764, 765, 766, 767, 768, 769, 770, 771, 772, 773, 774, 775, 776, 777, 778, 779, 780, 781, 782, 783, 784, 785, 786, 787, 788, 789, 790, 791, 792, 793, 794, 795, 796, 797, 798, 799, 800, 801, 802, 803, 804, 805, 806, 807, 808, 809, 810, 811, 812, 813, 814, 815, 816, 817, 818, 819, 820, 821, 822, 823, 824, 825, 826, 827, 828, 829, 830, 831, 832, 833, 834, 835, 836, 837, 838, 839, 840, 841, 842, 843, 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Color - How to Claim

• Color range in description

- RGB color ID
- RAL color ID
- Pantone PMS color ID

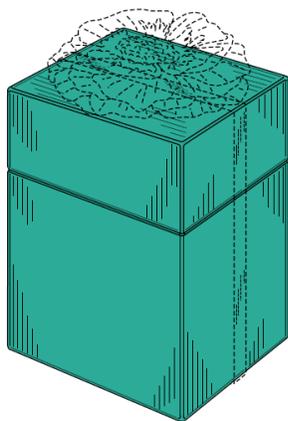


FIG. 1

The surface treatment shown in FIG. 1-FIG. 28 forms no part of the claimed design, the measurement device of the claimed design may have any surface treatment.

The light gray portions shown in FIG. 29-FIG. 37 have RGB values of R=198, G=198, B=198.

The white portions shown in FIG. 29-FIG. 37 have RGB values of R=230, G=230, B=230.

The dark gray portions shown in FIG. 29-FIG. 37 have RGB values of R=056, G=085, B=168.

References to “side”, “top”, “front”, “rear” and “bottom” in the figure descriptions are not meant to require certain in-use orientation; a measurement device according to the claimed design may be used in any orientation.

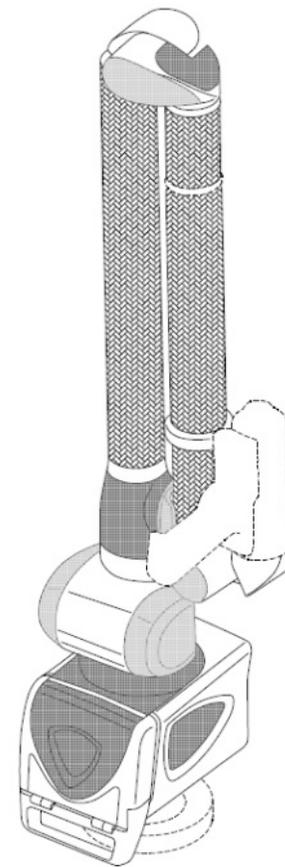


FIG. 36

“We consider color to be ornamentation that may play a role in the patentability of the claimed design” – *Johns Manville Corp. v. Knauf Insulation, Inc.*, 2017 Pat. App. LEXIS 3419, at *28 (USPTO BPAI 2017)

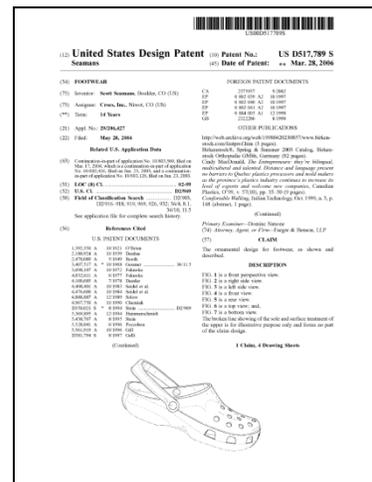
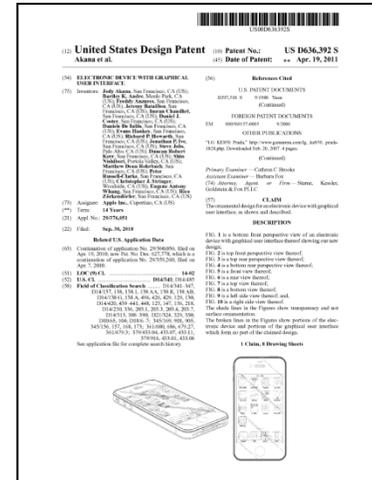
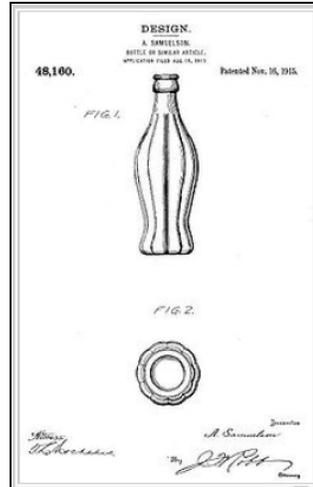
DESIGN PATENTS ARE BEST WHEN THERE IS A DESIRE TO COPY

New Products

Replacement Parts

Trade Indicators

A Design Patent and Trade Dress Can Protect the Same Thing



Complimenting Trademark with Design Patents

- Trademark Protection

- “[A]ny word, name, symbol, *or device*, or any combination thereof” used to distinguish goods from those manufactured or sold by others – [15 USC § 1127](#)
- “‘Trade dress’ refers to **‘the image and overall appearance of a product.’** It embodies ‘that arrangement of identifying characteristics or decorations connected with a product, whether by packaging or otherwise, [that] makes the source of the product distinguishable from another...’”

Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc., 280 F.3d 619, 629 (6th Cir. 2002) quoting *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1238-39 (6th Cir. 1992)

- Design Patent Protection

- “[A]ny new, original, and **ornamental design for an article of manufacture** may obtain a patent thereof, subject to the conditions and requirements of this title.” – [35 USC § 171](#)

Color

- Design Patent

- “As a preliminary matter, we note that this court has determined that color may play a role in the patentability of a claimed design” – [In re Haruna, 249 F.3d 1327, 1336 \(Fed. Cir. 2001\)](#)

- Trade Dress

- “In *Qualitex*, the Supreme Court permitted a party to trademark a particular color only after explaining that protection might not be available if the ‘color serve[d] a significant non-trademark function.’” – [ABPA, 930 F.3d at 1320](#)



Comparison

TRADE DRESS

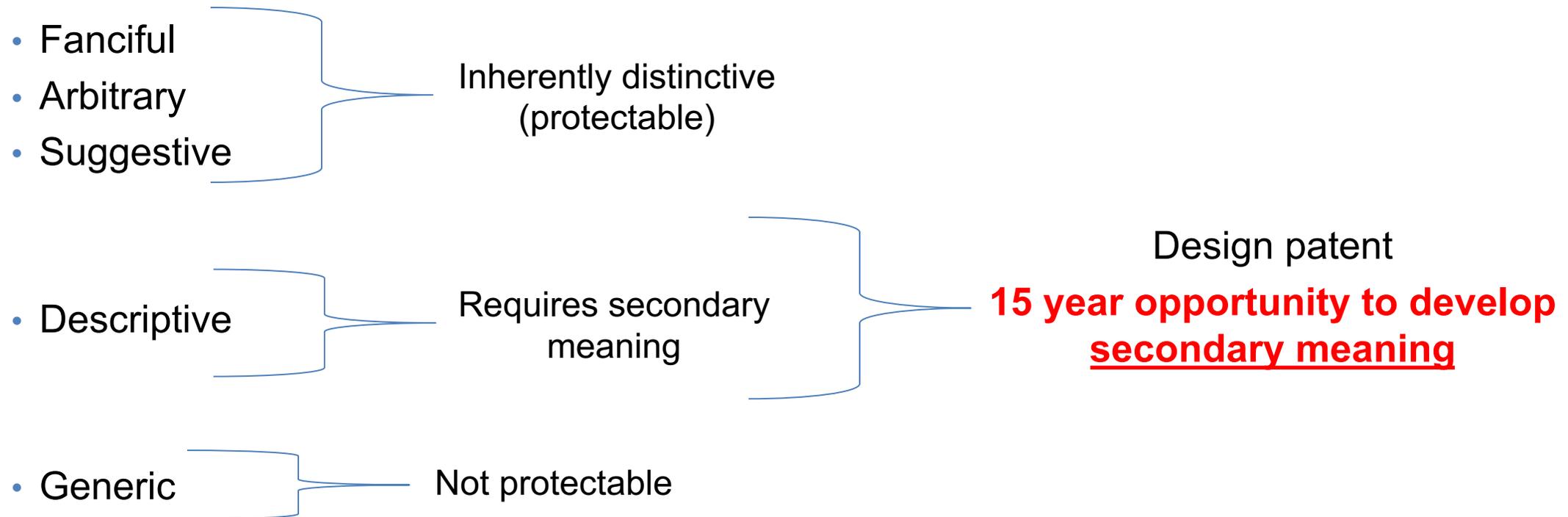
- Functionality →
 - Question of fact
 - Plaintiff's burden to prove a negative ("non-functionality")
 - Standard: essential to use or affects cost or quality
 - Aesthetic appeal is relevant
- Monopoly over symbols that distinguish a firm's goods and identify their source →
- Unlimited period of time →
- Infringement: likelihood of confusion in the marketplace →
- Appealed to regional circuit courts →

DESIGN PATENT

- Functionality
 - Question of fact as to whole & question of law as to features
 - Defendants' burden to prove functional
 - Standard: primarily non-functional or alternatives
 - Aesthetic appeal is irrelevant
- Exclusive rights to a particular aesthetic or design
- Limited period of time (15 years from date of issuance)
- Infringement: whether ordinary observer familiar with prior art would be deceived
- Appealed to Federal Circuit

- Trademarks and design patents serve different purposes and have different governing law – [ABPA](#), 930 F.3d at 1320

Complimenting Trade Dress with Design Patents



Christian Louboutin S.A. v. Yves St. Laurent Am. Holding, Inc., 709 F.3d 140 (2d Cir. 2013)



Complimenting Trade Dress with Design Patents



QUESTIONS?