

U.S. Design Patents

Presented at:

Presented by:

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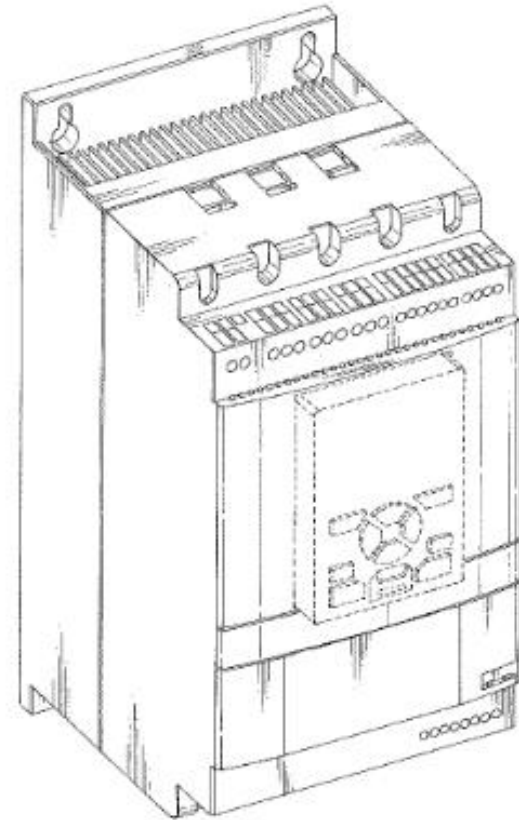
Outline

- Part 1: Legal Aspects of Design Patents
- Part 2: General Use of Design Patents
- Part 3: Replacement Parts
- Part 4: Graphical User Interfaces

Part 1 of 4: Legal Aspects of Design Patents

What is a design patent?

- The right to exclude others from using your design, i.e. same right to exclude competitors as with utility patents
- Covers different aspects than a utility patent - ornamental not functional
- Certain types of commercial products are generally understood to be protectable with a design patent, e.g. tire treads



Pat. No. D733,069
Assignee: ABB Tech. Ltd.
Title: Softstarter

Key Features

- 14 Years of Protection and No Maintenance Fees
- Drawings are filed with only a single claim:
 - “The ornamental design for . . . as shown and described.”
- “Portion claiming” is allowed - inventor does not need to file a design patent on the entire product
- Dashed lines are used to show aspects of the design for illustrative purposes, while not limiting the patent to those features.
- Can obtain design and utility patents on the same product
- Can protect items that are otherwise unpatentable
- Are relatively easier and cheaper to obtain than utility patents
 - The majority of design patents are issued without rejection
 - Average time to issuance is significantly less than with utility patents

Functionality vs. Ornamentality

- Design patents cannot claim functional features, only ornamental features
- An ornamental feature cannot be the result or ‘merely a by-product’ of functional or mechanical considerations
- The design only needs some ornamental appearance, and aspects that serve functions can be covered by a design patent in certain ways
 - The appearance must not be dictated by function
- For example, tire treads are both functional and ornamental, and are generally understood to be patentable



Pat. No. D475,009 is shown on the left, with the actual Bridgestone product on the right.

Enforcement

- The standard for establishing infringement shifted in 2008 with the *Egyptian Goddess* Federal Circuit case:
 - “[T]he “ordinary observer” test should be the sole test for determining whether a design patent has been infringed. Under that test, as this court has sometimes described it, infringement will not be found unless the accused article ‘embod[ies] the patented design or any colorable imitation thereof.’ ”
 - “[W]hether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design”
- This new standard is easier to prove than the old one, and a few very high stakes design patent cases have come out since 2008, including:
 - Crocs v. ITC (2011)
 - Apple v. Samsung (2012)

Remedies

- Essentially the same as utility patents
 - Damages and Injunctions
- There are various methods of calculating damages, including:
 - “Reasonable” royalty - probably higher than what is actually reasonable
 - Lost profits - lost sales, price erosion, future lost profits, damage to reputation
- Limitations on damages
 - No more than 6 years
 - Cannot recover twice

Part 2 of 4: Subject Examples of Design Patents

Dashed Lines

- Dashed lines are used to show referential aspects of the design, but do not limit the scope of the patent
 - E.g. the design patent shown covers both products
- The design shown here, referred to as the “HoneyComb Support System”, is used in a variety of products.

Design Patent



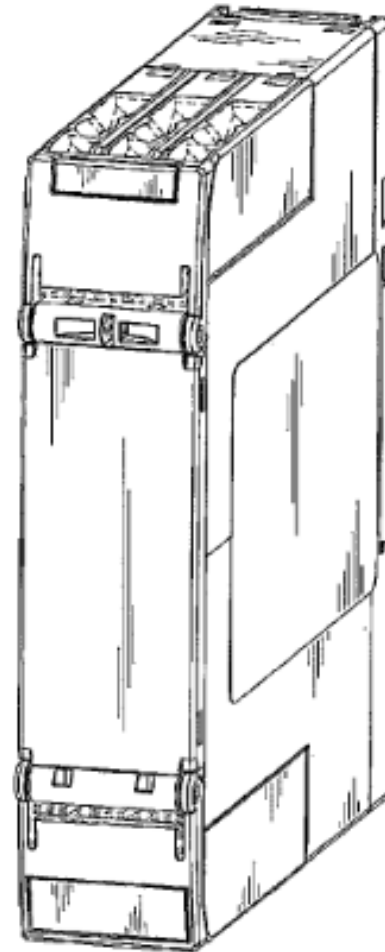
Covered Products



Pat. No. D723,261
Issued: March 3, 2015

Narrow Scope Without Dashed Lines

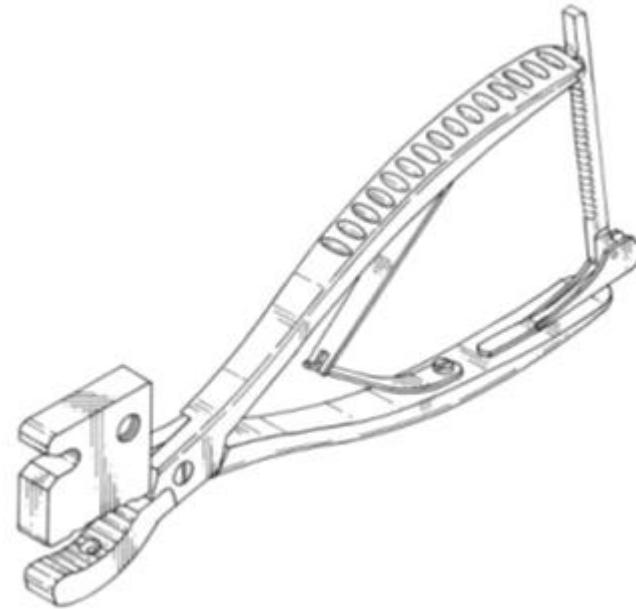
- Siemens' design patent on a safety relay is shown on the right
- All details shown in the product can potentially be limiting since they are not shown in dashed lines



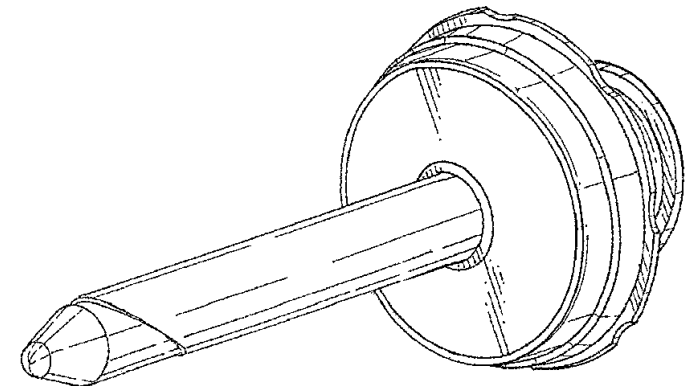
Pat. No. D738,828
Issued: 9/15/2015

Prevent Exact Copies

- Design Patents can be useful to prevent exact copies
- There is value in preventing exact copies of your product because this is otherwise not actionable in the U.S.
- The two surgical hand instruments shown on the right are examples of instruments that might not have been patentable if they were filed as utility applications, but were successfully protected with design patents



Pat. No. D592,747
Issued: 5/19/2009



Pat. No. D740,420
Issued: 10/6/2015

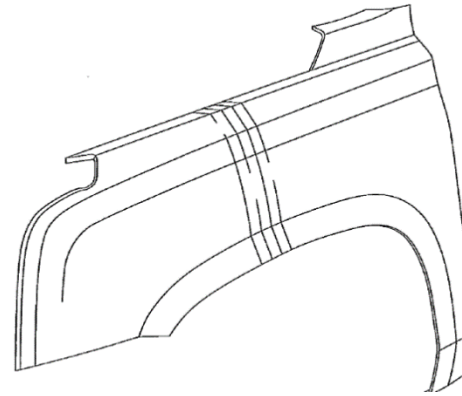
Part 3 of 4: Replacement Parts

Replacement Parts

- Replacement parts are any component of a product that typically has a shorter lifetime than the product itself, including things that:
 - Are frequently damaged, e.g. car fenders
 - Are quickly worn out, e.g. razor blades
 - Are quickly depleted or consumed, e.g. printer cartridges
 - Are frequently lost, e.g. toy parts
- Advances in 3-D printing has increased the importance of design patents on these types of items
 - Design patents maintain your exclusive right to sell replacement parts in the after market
 - Designing the product strategically to retain control over replacement parts is an essential IP strategy

Car Parts

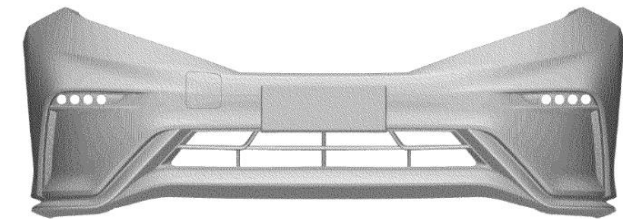
- Original Equipment Manufacturers, or OEMs, price things as high as 50 percent more for a Nissan Altima front bumper cover, or 41 percent on a front air dam for a Dodge Pickup
- On the right are examples of design patents owned by Nissan:
 - Fender (top left)
 - Headlamp (top right)
 - Front Bumper (middle right)
 - Dashboard (bottom left)



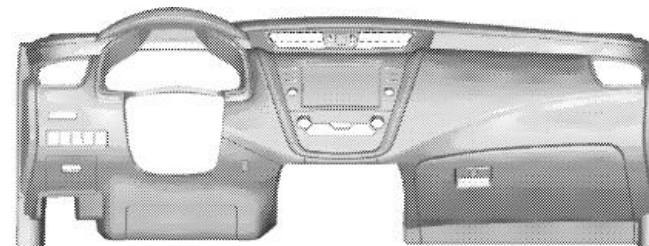
Pat. No. D718,688



Pat. No. D709,631



Pat. No. D740,729



Pat. No. D737,186

Razor Blades

- Gillette protected its Fusion[®] razor with multiple design patents, including those protecting the whole razor, the razor handle, and the replacement cartridge
- This strategy was very profitable
 - A typical razor costs close to \$8, while a 4-pack of razors is \$18 (\$200+/year in razors)
- Gillette enforced their patents in May 2014 against companies allegedly selling compatible replacement Fusion cartridges on the Internet



U.S. D534,313



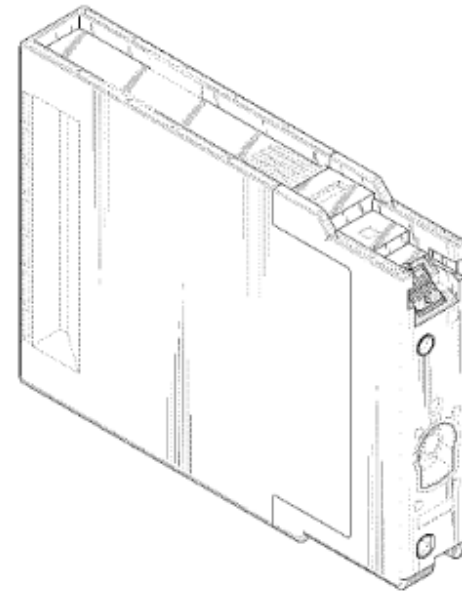
U.S. D534,686



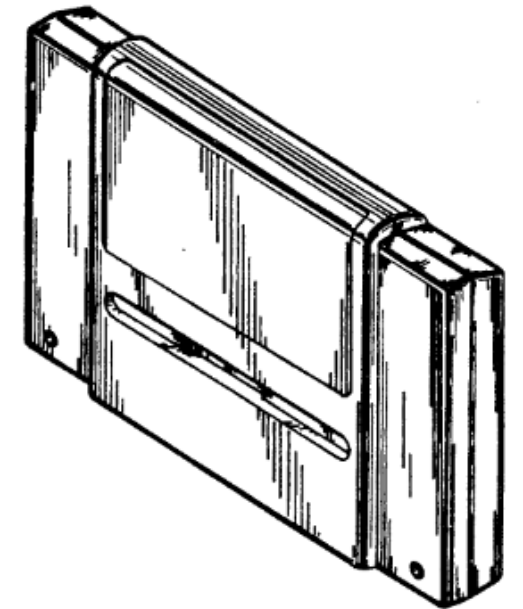
U.S. D533,684

Ink and Game Cartridges

- Printer companies use a creative strategy incorporating design patents to maintain the exclusive right to sell cartridges for their printing/copying machines, and thus control pricing to keep profits high
- The Epson design patent (left image) covers the shape or exterior of the cartridge, but it allows Epson to control the sale of what's inside the cartridge, i.e. the ink
- In 1994, Nintendo used a similar strategy to protect the shape of their game cartridges (right image), allowing them to license access to the console



Pat. No. D712,466
Issued: 9/2/2014



Pat. No. D344,504
Issued: 2/22/1994

Part 4 of 4: Graphical User Interfaces

Graphical User Interfaces

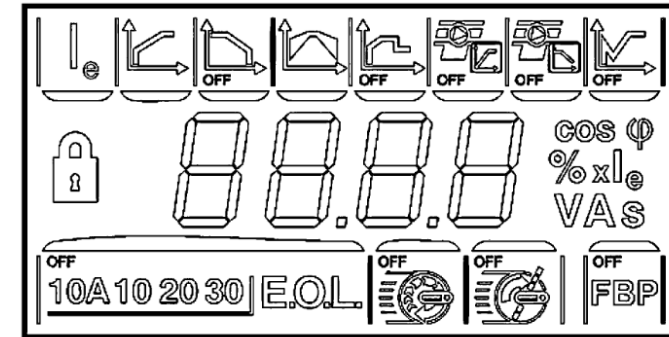
- Design patents have been used to protect Graphical User Interfaces, or GUIs
- GUIs are used in branding, and are a major part of the look and feel of the product
- GUIs drive product sales
- A consistent look and feel to a product is a major part of customer loyalty

Graphical User Interfaces (cont.)

- 1st Approach: Protect the Layout
 - Location of each element
- For example, you can patent the location of the tool bars relative to the applications
 - Design applications can be filed in color
- ABB's design patent on a Motor Starter Display is shown the right



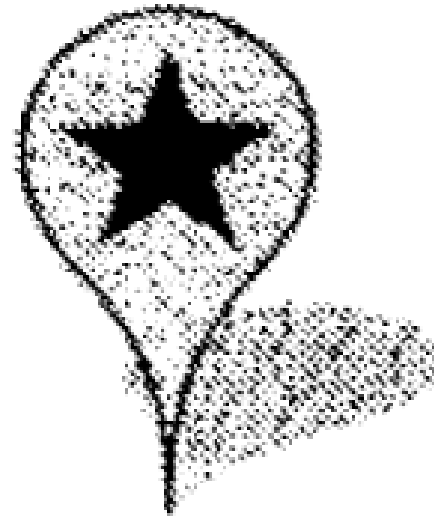
Pat. No. D604305
Assignee: Apple



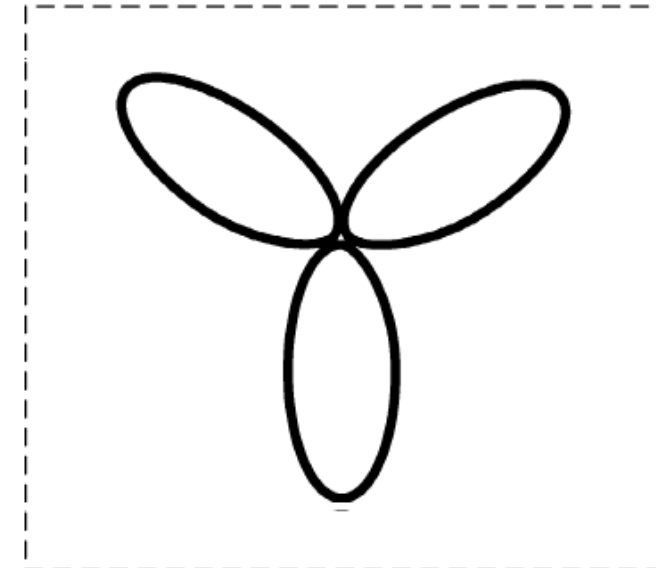
Pat. No. D604305
Assignee: ABB

Graphical User Interfaces (cont.)

- 2nd Approach: Patent the Icons
- Icons are key visual representations of your company/brand
- Well-known symbols such as Google's "pin", shown here, become associated with your company and brand
- The ABB symbol shown on the right is from a design patent still pending
- Can file for a trademark on the symbols as well
 - This allows long-term protection
 - Especially useful once symbol is associated with the brand



Pat. No. D645,052
Assignee: Google



App. No. 29/487,196 (pending)
Assignee: ABB

Graphical User Interfaces (cont.)

- A third approach is to patent the actual movement of elements in your GUI
- Here is how Apple did it in their “Cover Flow” design patent, D624,932, pertaining to the movement of album covers across the screen:

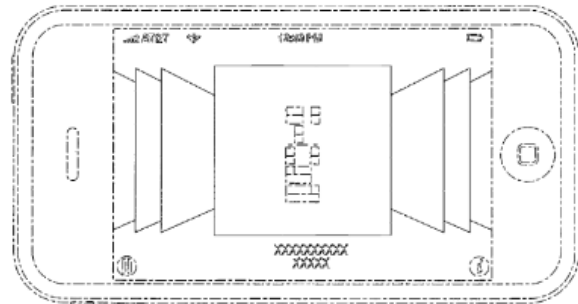


FIG. 1

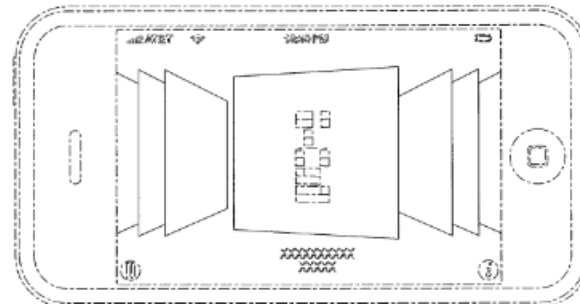


FIG. 2

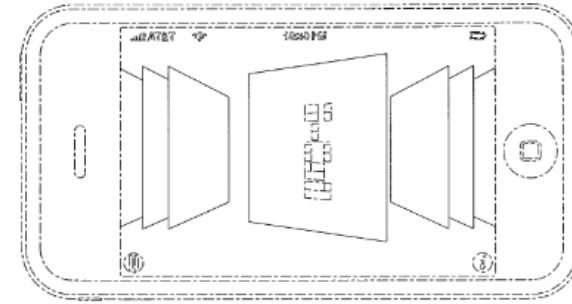


FIG. 3

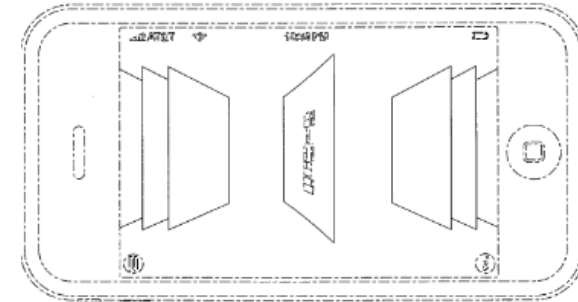


FIG. 4

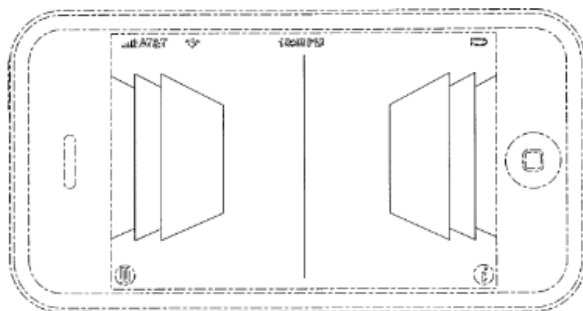


FIG. 5

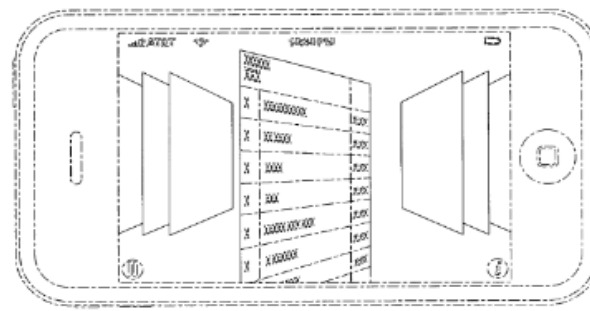


FIG. 6

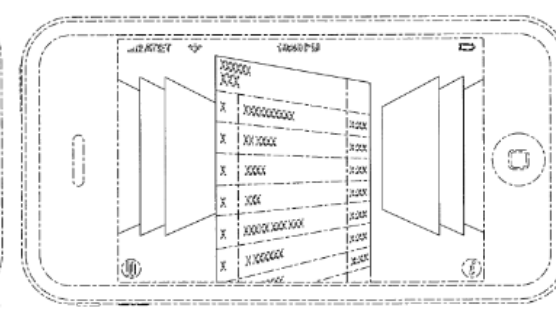


FIG. 7

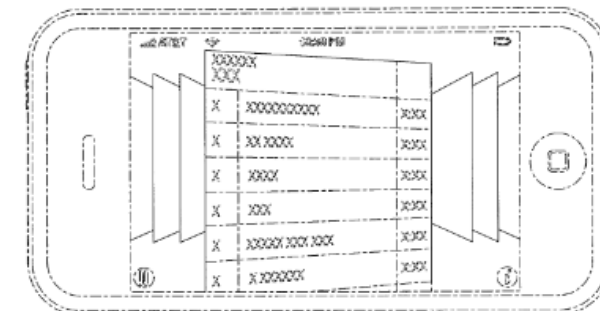


FIG. 8

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