



The Industrial Revolution Design

September 16, 2015
Washington, Seattle



Christopher V. Carani, Esq.

twitter: <https://twitter.com/ccarani>





It is all around us...

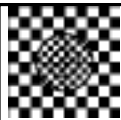
 <small>Telada A317</small>	 <small>Telada C218</small>	 <small>Telada SG4508</small>	 <small>Telada T218</small>	 <small>Telada T687</small>	 <small>Telada T98</small>
 <small>Nokia 7248</small>	 <small>Sony Ericsson K790i</small>	 <small>Motorola R429i V3</small>	 <small>Samsung E500</small>	 <small>Samsung E720</small>	 <small>Samsung C110</small>



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New wave of copying...





U.S. Intellectual Property

1. Patents
 - Utility Patents
 - **Design Patents****
2. Trademarks
 - Trade Dress
3. Copyrights






	<h2>Utility Patent vs. Design Patents</h2>	
	<p align="center"><u>Utility Patent</u></p> <p align="center">The way it WORKS....</p> <div data-bbox="483 653 852 821">  </div> <p align="center">U.S. Patent No. 7,070,349</p>	<p align="center"><u>Design Patent</u></p> <p align="center">The way it LOOKS....</p> <div data-bbox="906 632 1239 831">  </div> <p align="center">U.S. Patent No. D559,842</p>
	<p align="right">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>	

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	<h2>3 Ways to Protect <u>Appearance</u></h2>	
	<div data-bbox="516 1266 1206 1778"> <p align="center">Design Patent</p>  <div data-bbox="690 1413 963 1654">  </div> <div data-bbox="573 1560 1076 1778">   <p align="center">Trade Dress Copyright</p> </div> </div>	
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Each IP Right Has Different Aim Striking Different Coverage Balance

IP Right	Policy	Requirements	Term	Protection
Design Patent		Novel, Non-obvious, Ornamental	14* years (from issuance)	Substantially the Same
Copyright		Expression, Originality, Non-useful	Life of author + 70 yrs	Substantial Similarity + Copying
Trade Dress		Secondary meaning, Non-functional	Potentially Perpetual	Confusion

*When Title I of PLTIA and Hague go into effect
term will be increased to 15 years


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Each Design IP Right Has Different Aim Striking Different Coverage Balance

IP Right	Injunctive Relief	Damages
Design Patent	<ul style="list-style-type: none">-Preliminary Injunction-Permanent Injunction	<ul style="list-style-type: none">- Reasonable Royalty- Lost Profits- Infringer' s Profits- Statutory Damages
Copyright	<ul style="list-style-type: none">-Preliminary Injunction-Permanent Injunction	<ul style="list-style-type: none">- Lost Profits- Infringer' s Profits- Statutory Damages
Trade Dress	<ul style="list-style-type: none">-Preliminary Injunction-Permanent Injunction	<ul style="list-style-type: none">- Lost Profits- Infringer' s Profits

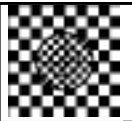


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	<h2>U.S. Intellectual Property</h2>
	<ol style="list-style-type: none"> 1. Patents <ul style="list-style-type: none"> • Utility Patents • Design Patents** 2. Trademarks <ul style="list-style-type: none"> • Trade Dress 3. Copyrights 
<div style="display: flex; justify-content: space-between; align-items: center;"> <div> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div>9</div> </div>	

	<h2>Increasingly A Hot Topic – Public Sector</h2>
	<div style="text-align: center;">  </div> <p><u>Government Initiatives</u></p> <ul style="list-style-type: none"> • Conference on the Global Intellectual Property Marketplace • www.stopfakes.gov • 1-866-999-HALT • Design Piracy Prohibition Act • Anti-Counterfeiting Trade Agreement • Design Day USPTO! • Hague Agreement (Signed into law Dec. 18, 2012)
<div style="display: flex; justify-content: space-between; align-items: center;"> <div> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div>10</div> </div>	



Kappos on Design

"Design: The New Frontier of Intellectual Property"



David Kappos, April 22, 2013



Increasingly A Hot Topic – Academia and Scholarship

- ▶ **Embodied Cognition and *New Product Design*: Changing Product Form to Influence Brand Categorization**, Journal of Product Innovation Management
- ▶ **An Investigation of the Processes by Which *Product Design* and Brand Strength Interact to Determine Initial Affect and Quality Judgments**, Journal of Consumer Psychology
- ▶ **Seeing Things: Consumer Response to the Visual Domain in *Product Design***, Design Studies Journal
- ▶ **Recent Trends in Community *Design*: The Eminence of Participation**, Design Studies Journal




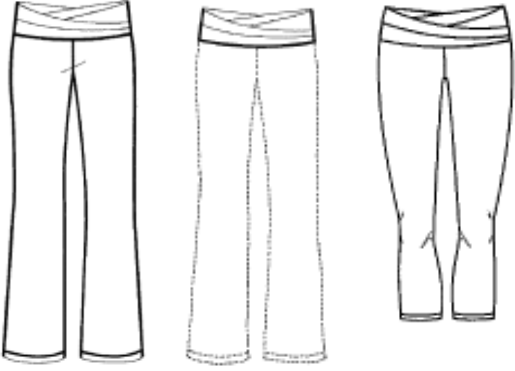

Where there is appealing design... ...there is infringement



Blackberry LLC v. Typo Prods. LLC




3:14-cv-23 (N.D. Cal. 2014)


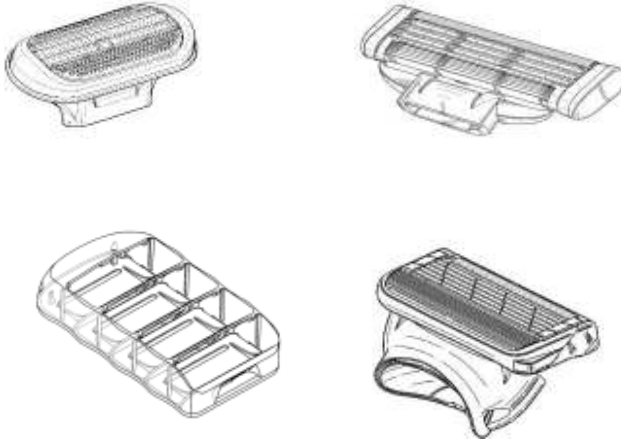






	<p><i>Lululemon v. Calvin Klein</i> 12-cv-001034 (S.D.N.Y. 2013)</p>
	
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	<p><i>Ashley Furniture Inc. v. LG. Interiors Inc. et al</i> 13-cv-001669 (C.D.Cal. 2013)</p>
	<div data-bbox="548 1360 662 1423"> <p>Patented Design</p> </div>  <div data-bbox="548 1602 662 1665"> <p>Accused Design</p> </div> 
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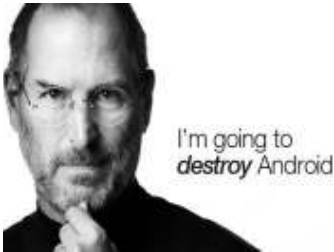

	<p>Nikon v. Sakar Int'l (d/b/a Polaroid) 13-cv-00710 (S.D.N.Y. 2013)</p>
	
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	<p>Spanx v. Yummie-Tummie 13-cv-00710 (N.D. Ga. 2013)</p>
	
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	<h2>Gillette Co. v. BK Gifts</h2> <p>13-cv-02241 (N.D. Ohio 2013)</p>
	
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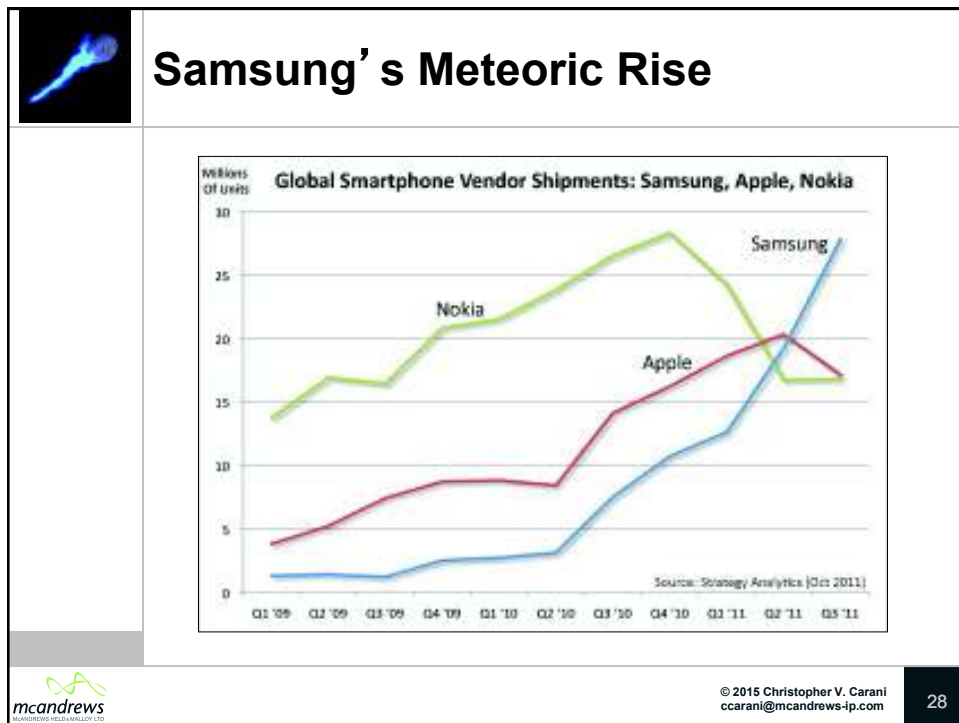
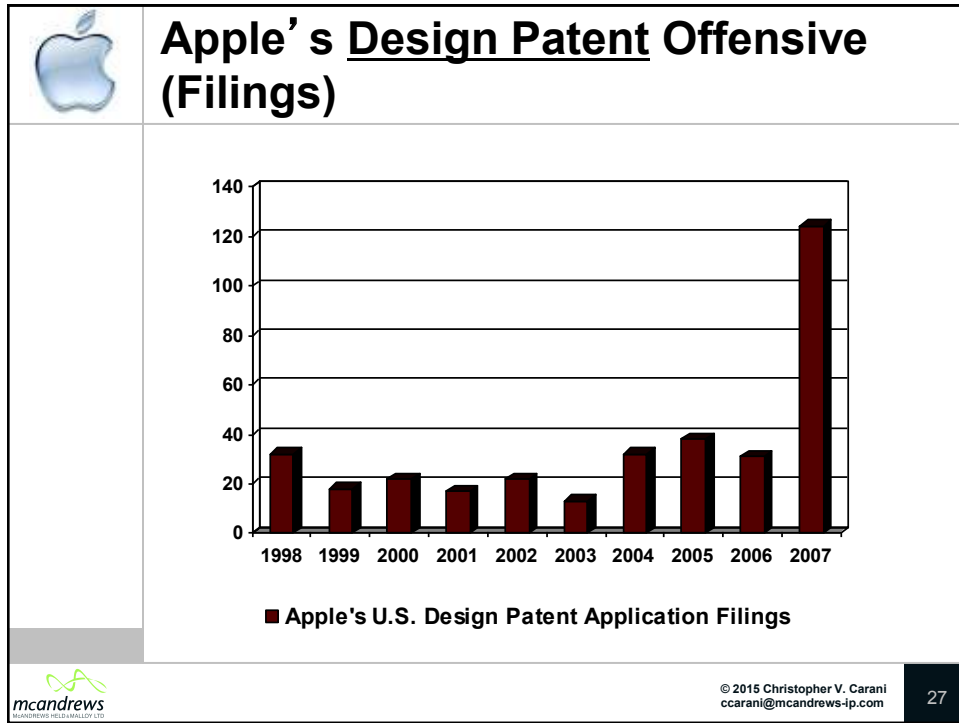
	<h2>“The Patent Trial of The Century”?</h2>
	
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	<h2><u>Largest</u> Patent Infringement Jury Verdict (Standing)</h2>
	<div data-bbox="651 457 1015 747">  </div> <p data-bbox="532 814 1122 867">Verdict: \$1,049,343,540.00</p>
	<div data-bbox="1040 930 1209 961"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1247 936 1271 957"> <p>23</p> </div>

	<h2><i>Apple, Inc. v. Samsung Elecs. Co.,</i></h2> <p>11-cv-1846 (N.D. Cal 2011)</p>
	<p data-bbox="521 1304 1149 1415">“I am going to destroy Android...I'm willing to go thermonuclear war,” and, “I will spend my last dying breath if I need to, and I will spend every penny of Apple’s \$40 billion in the bank, to right this wrong.”</p> <p data-bbox="881 1444 1157 1472">~ Steve Jobs (1955-2011)</p> <div data-bbox="664 1499 995 1749">  </div>
	<div data-bbox="1040 1799 1209 1831"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1247 1806 1271 1827"> <p>24</p> </div>




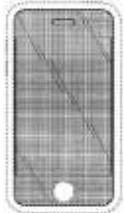



	<p>Set the way back machine... January 7, 2007</p>
	
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	<p>2007 MacWorld Expo Moscone Convention Center San Francisco, California</p>
	
<p>“Today, Apple is going to reinvent the phone, and here it is.... We are calling it iPhone. ... Now, we’ re going to start with a revolutionary user interface....And boy, have we patented it.”</p>	
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 	<p><i>Apple, Inc. v. Samsung Elecs. Co.,</i> 11-cv-1846 (N.D. Cal 2011)</p>
	
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 	<p><i>Apple, Inc. v. Samsung Elecs. Co.,</i> 11-cv-1846 (N.D. Cal 2011)</p>
	<p style="text-align: center;"><u>Apple Design Patents-in-Suit</u></p> <div style="display: flex; justify-content: space-around; align-items: center;">     </div> <div style="display: flex; justify-content: space-around; margin-top: 10px;"> <p><u>Device Designs</u></p> <p><u>GUI Design</u></p> </div>
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	<h2>Apple's Argument in a Nutshell (Smart Phones)</h2>						
	<div style="text-align: center;">    </div> <table border="1" style="width: 100%; text-align: center;"> <tr> <td data-bbox="511 457 743 508"> <p>Samsung Smartphones BEFORE iPhone</p> </td> <td data-bbox="750 457 982 508"> <p>Apple's iPhone (announced Jan. 2007)</p> </td> <td data-bbox="989 457 1221 508"> <p>Samsung Smartphones AFTER iPhone</p> </td> </tr> <tr> <td data-bbox="511 514 743 892">  </td> <td data-bbox="750 514 982 892">  </td> <td data-bbox="989 514 1221 892">  </td> </tr> </table>	<p>Samsung Smartphones BEFORE iPhone</p>	<p>Apple's iPhone (announced Jan. 2007)</p>	<p>Samsung Smartphones AFTER iPhone</p>			
<p>Samsung Smartphones BEFORE iPhone</p>	<p>Apple's iPhone (announced Jan. 2007)</p>	<p>Samsung Smartphones AFTER iPhone</p>					
							
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	<h2>Road Map</h2>
	<p style="text-align: center;"><u>TODAY'S DISCUSSION</u></p> <ol style="list-style-type: none"> 1) Design Patent Enforcement 2) Design Patent Protection 3) Design Patent Damages 4) GUI, Icons and Animations 5) Int'l Filing Considerations 6) Litigation Considerations(Time Permitting)
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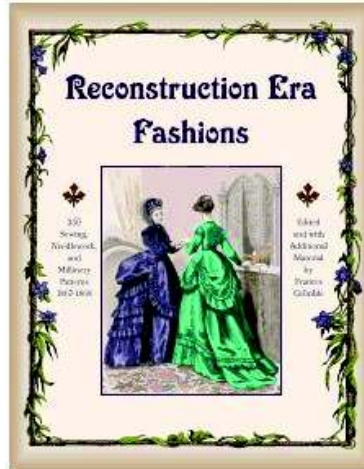
	<div data-bbox="566 470 1175 659" data-label="Image"> </div> <div data-bbox="545 707 1185 770" data-label="Section-Header"> <h2>Design Patent Infringement</h2> </div>
	<div data-bbox="1031 924 1213 959" data-label="Text"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1237 932 1273 957" data-label="Text"> <p>33</p> </div>

	<div data-bbox="475 1140 987 1234" data-label="Section-Header"> <h2>Set the way back machine... <i>Gorham v. White (1871)</i></h2> </div>
	<div data-bbox="615 1335 1026 1688" data-label="Image"> </div>
	<div data-bbox="1031 1793 1213 1829" data-label="Text"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div>

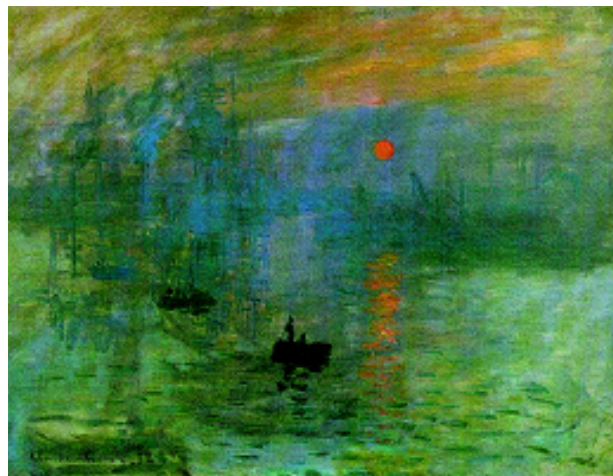
	<h2>U.S. Civil War (1861-65)</h2>
	 <p>The Battle of Fredericksburg of 1862 by N. Currier</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

	<h2>The Great Chicago Fire</h2> <p>October 8, 1871</p>
	 <p>Currier & Ives in 1871</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



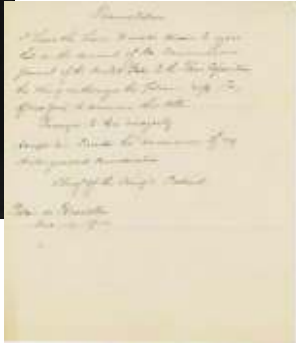

Reconstruction Era (1866-77)








Impressionism (1860's-1880's)


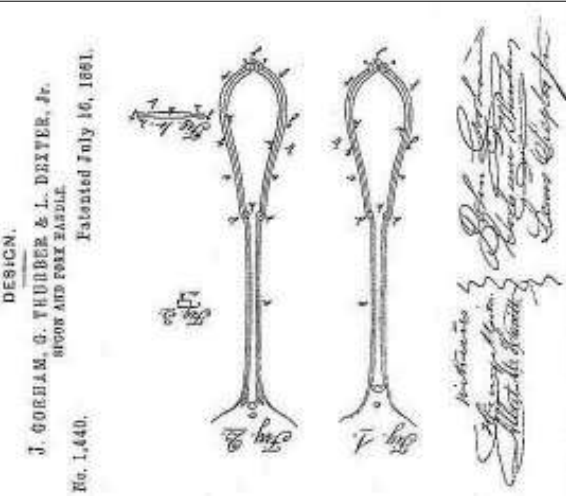






Impression, Sunrise by Claude Monet (1871)





	<h2>Mr. John Gorham “Purveyor to his Majesty”</h2>
	
<p>Mr. John Gorham Gorham Manufacturing Co.</p>	
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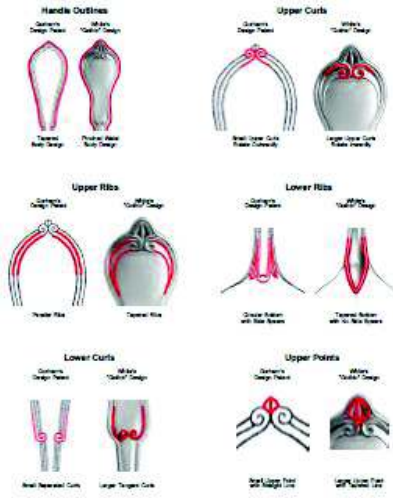
<h2>Gorham Mfg. Co.'s Cottage Design</h2>

<p>Gorham's Cottage Design</p>

<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>




	<h2 style="text-align: center;">Gorham Mfg. Co.'s Cottage Design</h2>
	<div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p style="text-align: center;">Gorham's Cottage Design</p> <p><u>Harper's New Monthly Magazine:</u> "The single most successful design of its kind ever achieved...designed in a happy moment..."</p>
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>





	<h2 style="text-align: center;">U.S. Design Patent No. D1,440</h2>
	
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



	<p><i>Gorham v. White</i>, 81 U.S. 511 (1871)</p>
	<div data-bbox="771 409 917 829">  </div> <div data-bbox="755 829 933 903"> <p>White's Accused Design</p> </div>
	<div data-bbox="1039 924 1209 955"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 924 1274 955"> <p>43</p> </div>



	<p><i>Gorham v. White</i>, 81 U.S. 511 (1871)</p>
	<div data-bbox="673 1281 755 1690">  </div> <div data-bbox="625 1701 812 1774"> <p>Gorham's Patented Design</p> </div> <div data-bbox="901 1270 1047 1701">  </div> <div data-bbox="885 1701 1063 1774"> <p>White's Accused Design</p> </div>
	<div data-bbox="1039 1795 1209 1827"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 1795 1274 1827"> <p>44</p> </div>



	<p>Gorham v. White, 81 U.S. 511 (1871)</p>
	<div data-bbox="633 409 1023 903">  </div> <div data-bbox="1039 924 1266 955"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div>




	<p>Gorham v. White, 10 F. Cas. 827 (Circuit Ct. S.D. N.Y. 1870)</p>
	<div data-bbox="641 1270 1079 1690">  <div data-bbox="641 1627 828 1690"> <p>Gorham's Patented Design</p> </div> <div data-bbox="893 1627 1079 1690"> <p>White's Accused Design</p> </div> </div> <div data-bbox="722 1722 982 1764"> <p><u>NO INFRINGEMENT</u></p> </div> <div data-bbox="1039 1795 1266 1837"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div>

	<p>Gorham v. White, 10 F. Cas. 827 (Circuit Ct. S.D. N.Y. 1870)</p>
	<p>  “The observation [of the ordinary observer] is worthless, because it is casual, heedless and unintelligent...” </p>
	<p> “[The] test can only be . . . the observation of a person versed in designs in the particular trade in question” </p>
<p>LOWER COURT HOLDING: NO INFRINGEMENT</p>	
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	<p>Take Away #1 Confirms Merit of Design Protection</p>
	<p> “The acts of Congress which authorize the grant of patents for designs were plainly intended to given encouragement to the decorative arts.” </p>
<p style="text-align: center;">* * *</p>	
<p>The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.”</p>	
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	<h2>Take Away #2 Ordinary Observer Test</h2>
	<p>If... “in the eye of an ordinary observer, giving such attention as a purchaser 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.”</p>
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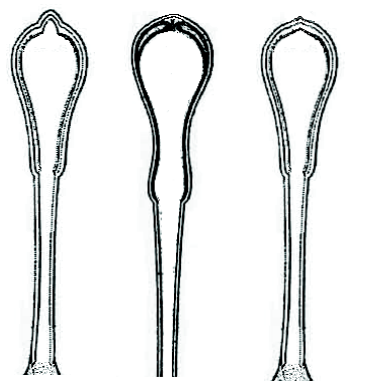

	<h2>Take Away #3 Substantial Identity</h2>
	<p>If... “in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”</p>
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	<p><i>Gorham v. White</i>, 81 U.S. 511 (1871)</p>
	<div data-bbox="868 409 1218 850">  <p>Gorham's Patented Design White's Accused Design</p> </div>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



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	<p><i>Gorham v. White</i>, 81 U.S. 511 (1871)</p>
	<div data-bbox="527 1270 1218 1722">  <p>Prior Art Gorham's Patented Design White's Accused Design</p> </div>
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	<p>Gorham v. White, 81 U.S. 511 (1871)</p>	
	 <p>Hypothetical Prior Art</p>	 <p>Gorham's Patented Design White's Accused Design</p>
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	<p>Gorham v. White, 81 U.S. 511 (1871)</p>	
	 <p>Prior Art</p>	 <p>Gorham's Patented Design White's Accused Design</p> <p><u>INFRINGEMENT</u></p>
<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>		<p>54</p>




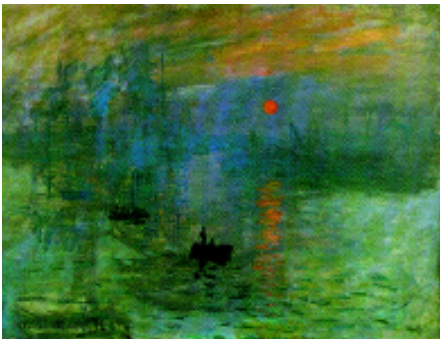
	<h2>Re-Articulation of Infringement Test</h2>
	<p>In the Eye of an Ordinary Observer:</p> <ol style="list-style-type: none"> 1. "Is the <u>overall appearance of the patented design</u> 2. substantially the same as 3. the <u>overall appearance of the accused design</u> 4. in view of the prior art?"*
	<p style="text-align: right;">*<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> (2008)</p> <p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

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	<h2>Design Patents Do Not Protect General Ideas or Concepts</h2>				
	<table border="0" style="width: 100%;"> <tr> <td style="text-align: center; width: 50%;"> <p><u>Patented Design</u></p>  </td> <td style="text-align: center; width: 50%;"> <p><u>Accused Design</u></p>  </td> </tr> <tr> <td colspan="2" style="text-align: center;"> <p><u>Albeit Same Idea, No Design Patent Infringement</u></p> </td> </tr> </table>	<p><u>Patented Design</u></p> 	<p><u>Accused Design</u></p> 	<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>	
<p><u>Patented Design</u></p> 	<p><u>Accused Design</u></p> 				
<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>					
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>				

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	<h2>Design Patents Do Not Protect General Ideas or Concepts</h2>	
	<p><u>Patented Design</u></p>	<p><u>Accused Design</u></p>
		
<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>		
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	<h2>Query...</h2>	
		
	<p>“the controlling consideration visual <u>impression</u> upon the eye”</p>	
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Design Patent Prosecution







U.S. Design Patents: Hard Facts






- Only one claim per design patent
- Duration: 15 years* from issuance
- No maintenance fees
- Filing to issuance 9-12 month avg.
- Continuation practice available






	<h2>Design Patents Protect</h2>
	<p>Overall appearance of an article of manufacture</p> <ul style="list-style-type: none">  • Shape
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	<h2>Design Patents Protect</h2>
	<p>Overall appearance of an article of manufacture</p> <ul style="list-style-type: none">  • Shape  • Surface ornamentation/treatment
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	<h2>Design Patents Protect</h2>
	<p>Overall appearance of an article of manufacture</p> <ul style="list-style-type: none">  • Shape  • Surface ornamentation/treatment  • Color
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	<h2>Design Patents Protect</h2>
	<p>Overall appearance of an article of manufacture</p> <ul style="list-style-type: none">  • Shape  • Surface ornamentation/treatment  • Color • Combination
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	<h2>Design Patent Requirements</h2>
	<p>To qualify for a design patent, the design must be:</p> <ul style="list-style-type: none"> • Novel (§ 102) • Non-obvious (§ 103) • Ornamental (§ 171)
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	<h2>5 WAYS TO INCREASE SCOPE VALUE OF U.S. DESIGN PATENTS</h2>
	<ol style="list-style-type: none"> 1.Dotted Lines 2.Indeterminate Break Lines 3.Multiple Embodiments 4.Multiple Applications 5.Continuation Practice
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	<h1>1. Broken Lines (“Dotted Lines”)</h1>
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	<h2>FUNDAMENTAL RULE</h2>
	<p>“Solid lines” are part of claim</p> <hr/> <p>“Dotted lines” are <u>NOT</u> part of claim.</p> <p>.....</p>
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Dotted Line Practice

**DISCLAIM
HARDWARE**

Microsoft Webcam, US Patent D647,937

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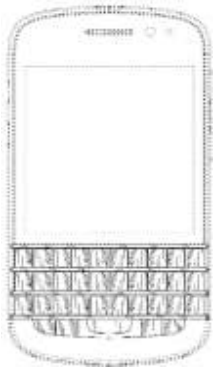


Adding Scope, Adding Value – Dotted Line Practice


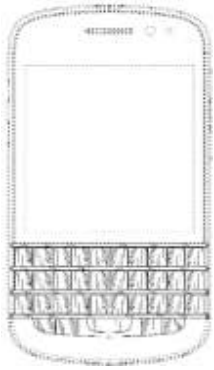


**Disclaim
design of
legs**



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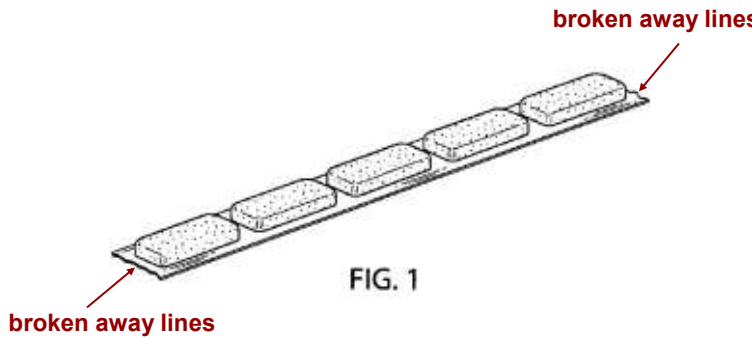

70

 <p>BlackBerry</p>	<p><i>Blackberry LLC v. Typo Prods. LLC</i> 3:14-cv-23 (N.D. Cal. 2014)</p>
	<div style="display: flex; justify-content: space-around; align-items: center;">   </div>
 <p><small>mcandrews BLACKBERRY HELD MALLOY LTD.</small></p>	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


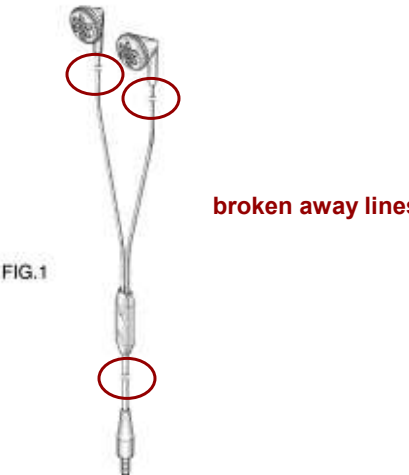

 <p>BlackBerry</p>	<p><i>Blackberry LLC v. Typo Prods. LLC</i> 3:14-cv-23 (N.D. Cal. 2014)</p>
	<div style="display: flex; justify-content: space-around; align-items: center;">   </div> <div style="display: flex; justify-content: space-around; margin-top: 10px;"> <p>D685,775</p> <p>Accused Product</p> </div>
 <p><small>mcandrews BLACKBERRY HELD MALLOY LTD.</small></p>	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

 <p>BlackBerry</p>	<p>Blackberry LLC v. Typo Prods. LLC 3:14-cv-23 (N.D. Cal. 2014)</p>
	<div style="display: flex; justify-content: space-around; align-items: center;"> <div style="text-align: center;">  <p>D685,775</p> </div> <div style="text-align: center;">  <p>Accused Product</p> </div> </div> <div style="text-align: right; margin-top: 10px;">  <p>Seacrest out!</p> </div> <p style="color: red; text-align: center; margin-top: 10px;">Judge Orrick: P.I. Granted</p>
 <p>mcandrews</p>	<p style="font-size: small;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


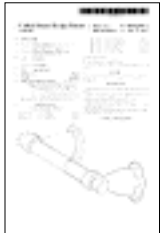
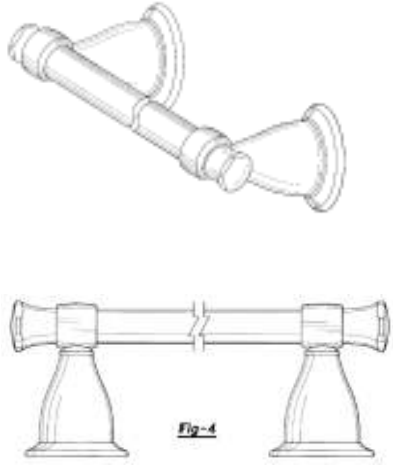

	
	<h2 style="text-align: center;">2. INDETERMINATE BREAK LINES</h2>
 <p>mcandrews</p>	<div style="display: flex; justify-content: space-between;"> <p style="font-size: small;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p>74</p> </div>

	<h2>Indeterminate Length</h2> <h3>Ends Broken away</h3>
 <p>FIG. 1</p> <p>SPEC: "The ends of the dental toothpaste strip are shown <u>broken away and indicate an indeterminate length.</u>"</p>	
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	<h2>Indeterminate Length</h2> <h3>Interior Broken Away</h3>
 <p>FIG. 1</p> <p>broken away lines</p>	
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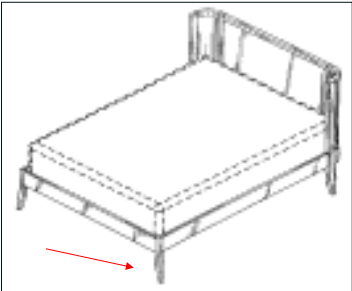
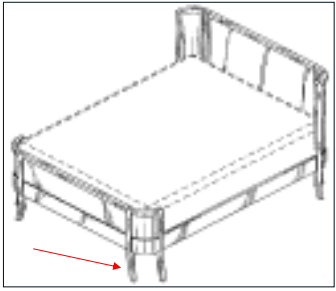

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	<h2>Adding Scope, Adding Value – Indeterminate Length</h2>
	
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	<h2>3. MULTIPLE EMBODIMENTS</h2>
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	<h2>Adding Scope, Adding Value – Multiple Embodiments</h2>
	<p>One Application, One Claim – But Two Embodiments</p> <div style="display: flex; justify-content: space-around; align-items: flex-end;"> <div style="text-align: center;">  <p>First Embodiment</p> </div> <div style="text-align: center;">  <p>Second Embodiment</p> </div> </div>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p style="text-align: right;">79</p>


D674,382	<h2>Multiple Embodiments (form-based)</h2>
	<div style="display: grid; grid-template-columns: repeat(3, 1fr); gap: 10px;"> <div style="text-align: center;">  <p>Fig. 1</p> <p>First Embodiment</p> </div> <div style="text-align: center;">  <p>Fig. 3</p> <p>Third Embodiment</p> </div> <div style="text-align: center;">  <p>Fig. 5</p> <p>Fifth Embodiment</p> </div> <div style="text-align: center;">  <p>Fig. 2</p> <p>Second Embodiment</p> </div> <div style="text-align: center;">  <p>Fig. 4</p> <p>Fourth Embodiment</p> </div> <div style="text-align: center;">  <p>Fig. 6</p> <p>Sixth Embodiment</p> </div> </div>
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Apple Inc. v. Samsung Electronics

11-cv-01846 (C.D. Cal)

US D593,087




Embodiment	Speaker	Screen Border	Home Button
1	Unclaimed	Unclaimed	Claimed
2	Unclaimed	Claimed	Unclaimed
3	Claimed	Unclaimed	Unclaimed
4	Unclaimed	Claimed	Claimed
5	Claimed	Unclaimed	Claimed
6	Claimed	Claimed	Unclaimed




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Prevalence of Multiple Embodiments

Last 5 years




596 issued U.S. design patents to Apple

161 of which have at least two or more embodiments

27% of issued U.S. design patents have at least two or more embodiments


Last 5 years



1083 issued U.S. design patents to P&G









271 of which have at least two or more embodiments





25% of its issued U.S. design patents have at least two or more embodiments



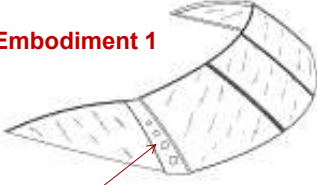
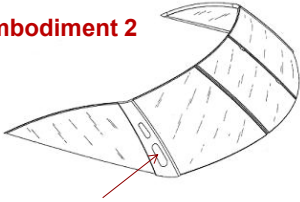



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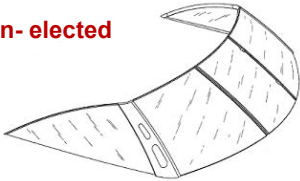

82

 	<p>Apple Inc. v. Samsung Electronics 11-cv-01846 (C.D. Cal)</p>
<div style="text-align: center;">  JP 1009317 (1996) </div> <div style="text-align: center;">  JP 1241383 (2004) </div> <div style="text-align: center;">  JP 1241638 (2005) </div> <div style="text-align: center;">  Apple D'087 Embodiment 2 </div> <div style="text-align: center; margin-top: 20px;">  <p>"One falls, they all fall..."</p> </div>	
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

	<p>Pacific Coast Marine v. Malibu 12-CV-0033 (Fed. Cir. 2014)</p>
<div style="text-align: center; margin-bottom: 50px;"> <p>Embodiment 1</p>  </div> <div style="text-align: center;"> <p>Embodiment 2</p>  </div>	
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
	<p>Embodiment 1</p>  <p>Embodiment 2</p>  <p>Restriction Requirement</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

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	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
	<p>elected</p>  <p>non- elected</p> 
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



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	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
<p>elected</p>	<p>non- elected</p> <p>The Accused Malibu Windshield</p> <p>NON-INFRINGEMENT</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p>87</p>

	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
<p>Embodiment 1 Embodiment 2</p>	
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p>88</p>

	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
<div style="display: flex; justify-content: space-around; margin-bottom: 10px;"> Embodiment 1 Embodiment 2 </div>	
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 89 </div>

	<p><i>Pacific Coast Marine v. Malibu</i> 12-CV-0033 (Fed. Cir. 2014)</p>
<div style="display: flex; justify-content: space-around; margin-bottom: 10px;"> Embodiment 1 Embodiment 2 </div>	
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 90 </div>

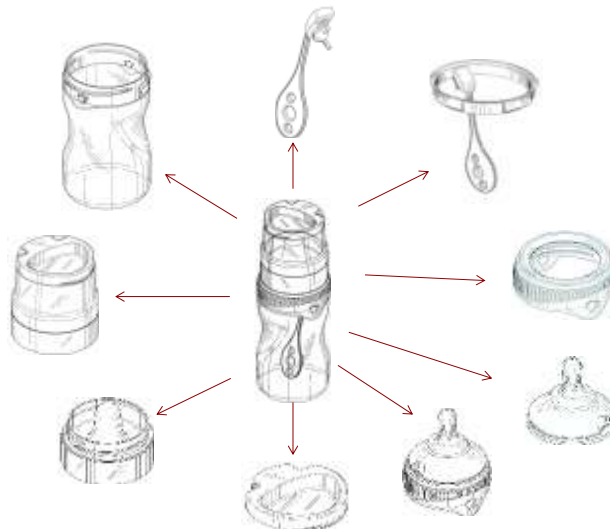
	
	<h2 style="text-align: center;">4. MULTIPLE APPLICATIONS</h2>
	<div style="display: flex; justify-content: space-between; align-items: center;"> <div data-bbox="1036 926 1209 961"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 934 1268 957" style="background-color: black; color: white; padding: 2px 5px;">91</div> </div>



	<h2 style="text-align: center;">Multiple Applications – Maximize Coverage</h2>
	<div style="display: flex; flex-direction: column; align-items: center;"> <div style="display: flex; align-items: center; margin-bottom: 20px;">  <div style="margin-left: 10px;"> <p>Des. D647,946 “SUPPORT FOR ELECTRONIC CAMERA”</p> </div>  </div> <div style="display: flex; align-items: center;">  <div style="margin-left: 10px;"> <p>Des. D647,933 “ELECTRONIC CAMERA”</p> </div>  </div> </div>
	<div style="display: flex; justify-content: space-between; align-items: center;"> <div data-bbox="1036 1795 1209 1831"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 1803 1268 1827" style="background-color: black; color: white; padding: 2px 5px;">92</div> </div>



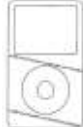

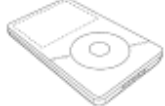






Multiple Applications – Maximize Coverage

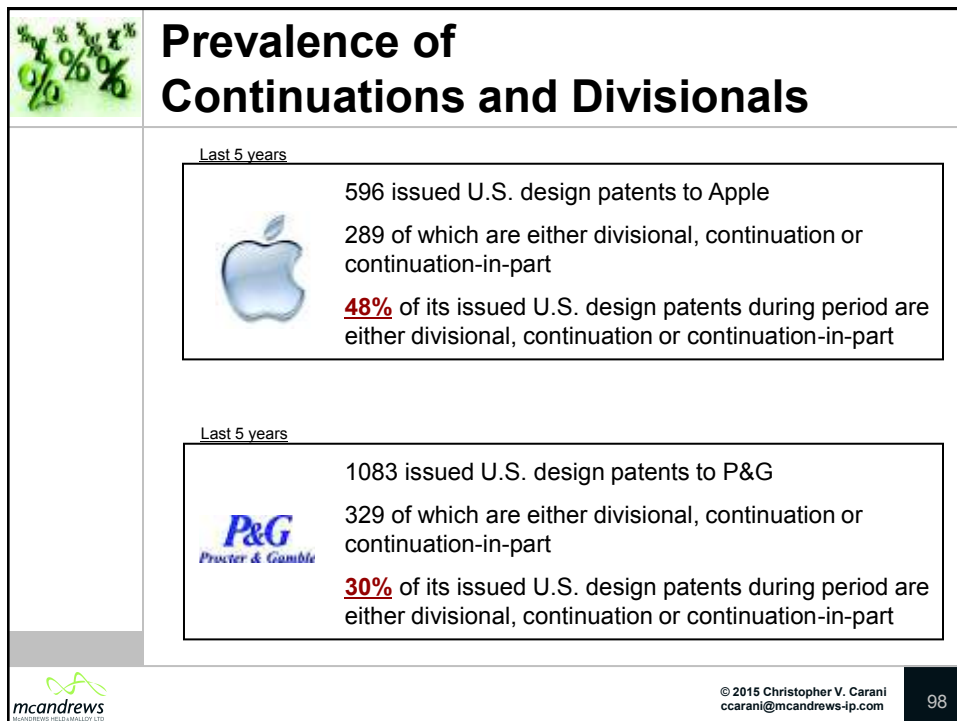
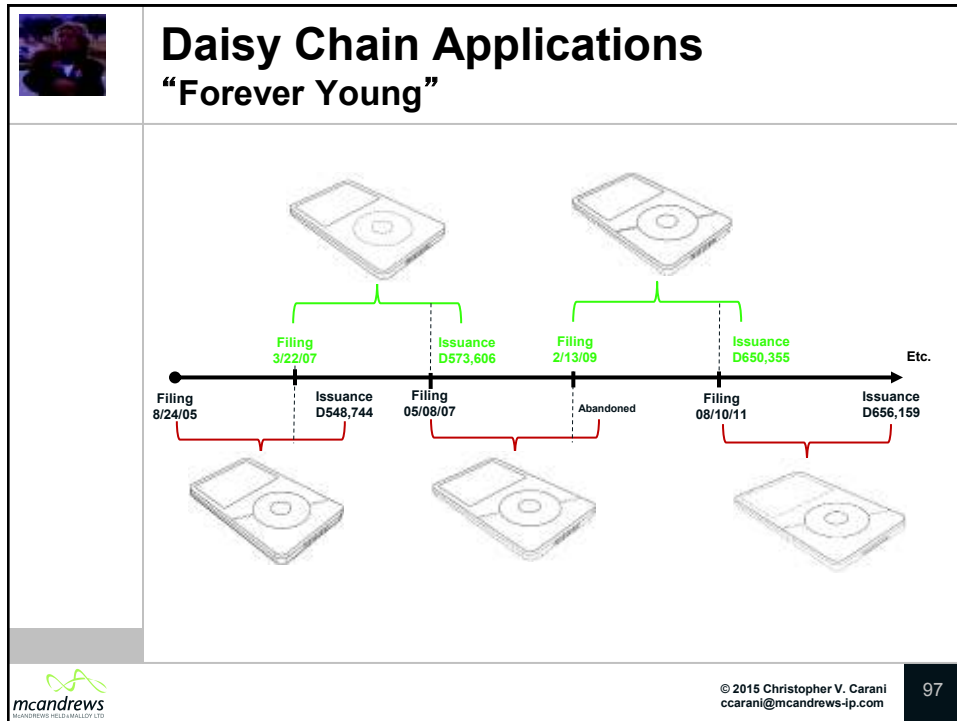


Multiple Applications – Maximize Coverage



	
	<h2 style="text-align: center;">5. Continuation Practice</h2>
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 95 </div>

	<h2 style="text-align: center;">Multiple Applications – Maximize Coverage</h2>
	<div style="display: flex; flex-direction: column; gap: 10px;"> <div> <p>D548,744 (entire device)</p> <div style="display: flex; justify-content: space-around; align-items: center;">  <div style="display: flex; flex-direction: column; gap: 5px;">   </div> </div> </div> <div> <p>D562,847 (no screen, click wheel)</p> <div style="display: flex; justify-content: space-around; align-items: center;">  <div style="display: flex; flex-direction: column; gap: 5px;">   </div> </div> </div> <div> <p>D573,223 (screen, no click wheel)</p> <div style="display: flex; justify-content: space-around; align-items: center;">  <div style="display: flex; flex-direction: column; gap: 5px;">   </div> </div> </div> </div>
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 96 </div>












GUI, Icons, Animations



Internet of Things



	<h2>GUI, Icons and Animations</h2> <h3>Internet of Things</h3>
	<div data-bbox="483 384 794 699">  </div> <div data-bbox="842 384 1247 688">  </div> <div data-bbox="714 709 1019 877">  </div> <div data-bbox="1039 930 1209 959"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div>

	<h2>Side-by-side, '305 and Samsung Smart Phones</h2>
	<div data-bbox="573 1295 722 1325"> <p>US D604,305</p> </div> <div data-bbox="560 1350 760 1644">  </div> <div data-bbox="914 1295 1068 1325"> <p>Samsung GUI</p> </div> <div data-bbox="906 1350 1081 1644">  </div> <div data-bbox="1039 1799 1209 1829"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1239 1806 1271 1829"> <p>102</p> </div>


	<h2>Apple's Design Patents-in-Suit Graphic User Interfaces</h2>		
<p>D613,334</p>	<p>D627,790</p>	<p>D604,305</p>	<p>Samsung GUI</p>
			<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

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	<h2>Graphic User Interfaces</h2>
	<p>D599,372</p>


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Windows 8 Home Screen





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D698,359, Figure 1 (Black & White)

Filed: September 12, 2011; Issued: January 28, 2014

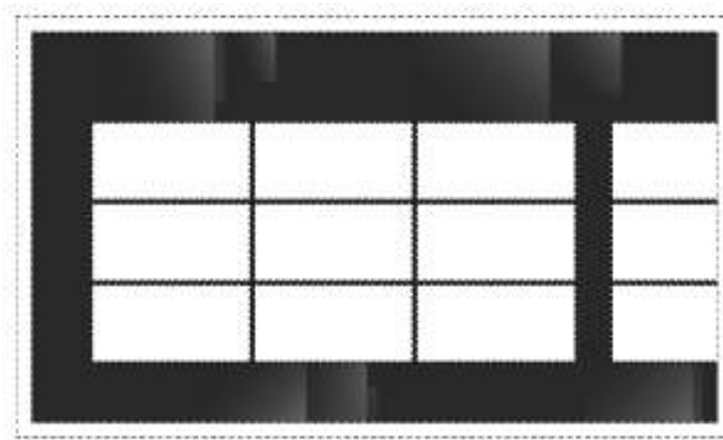




FIG. 1

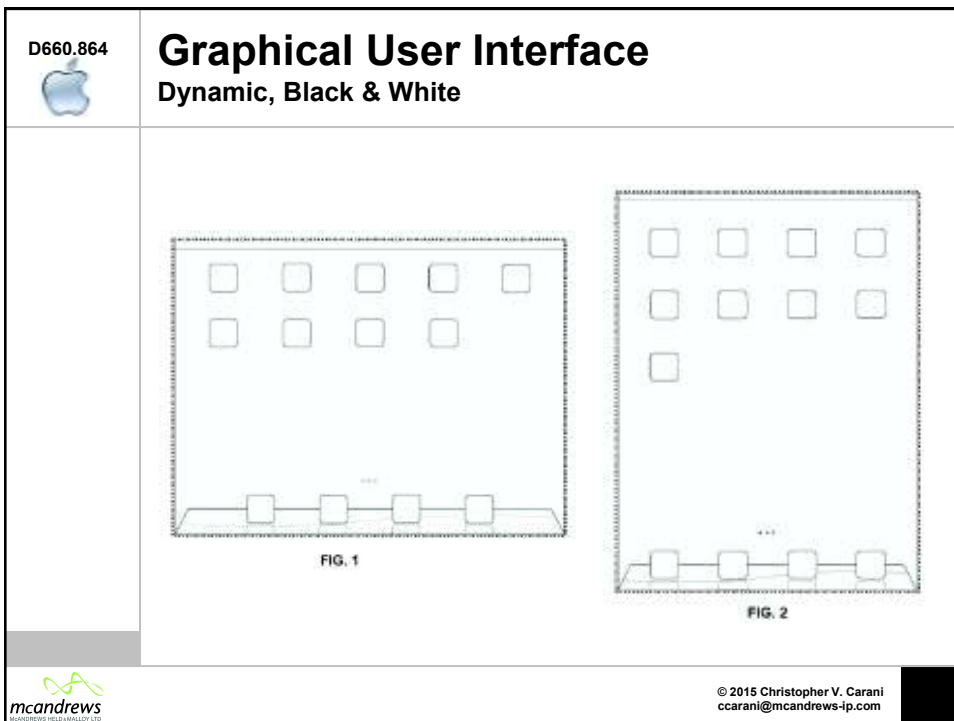
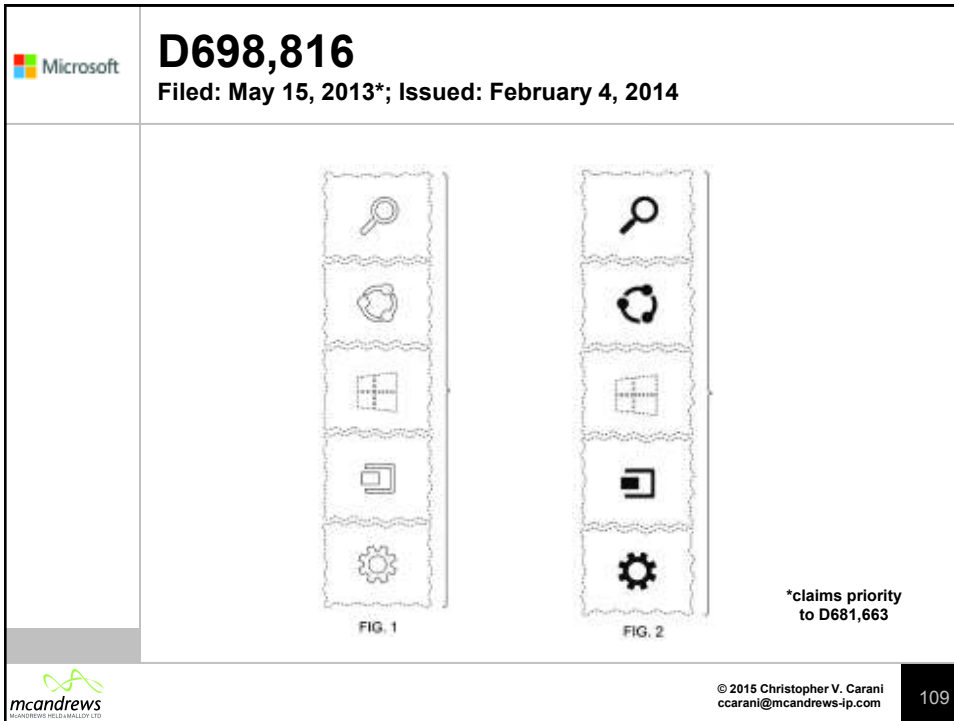


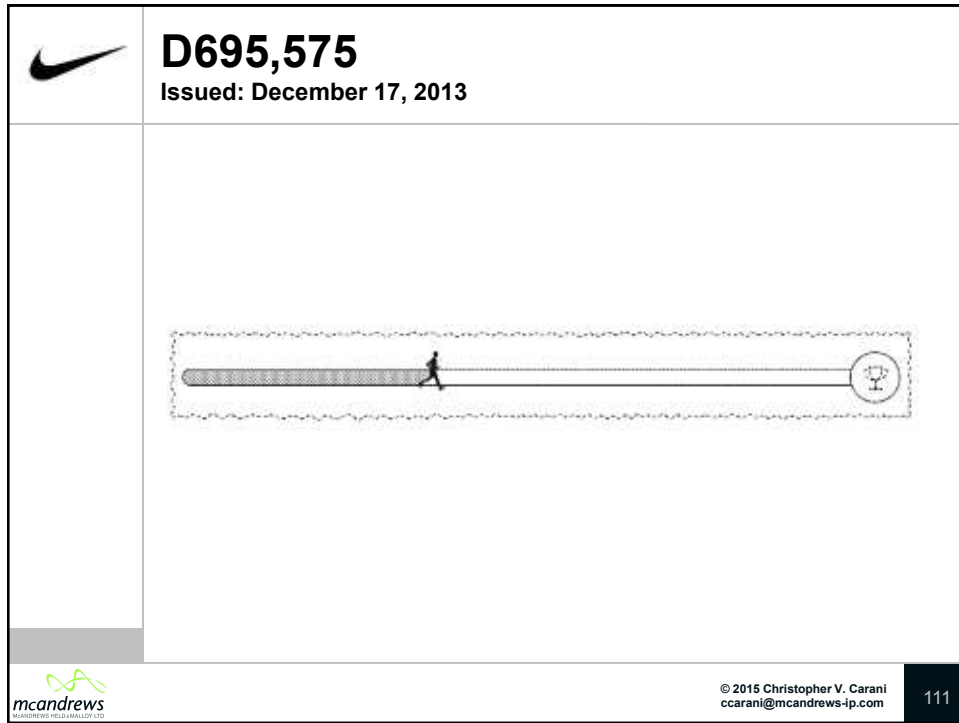
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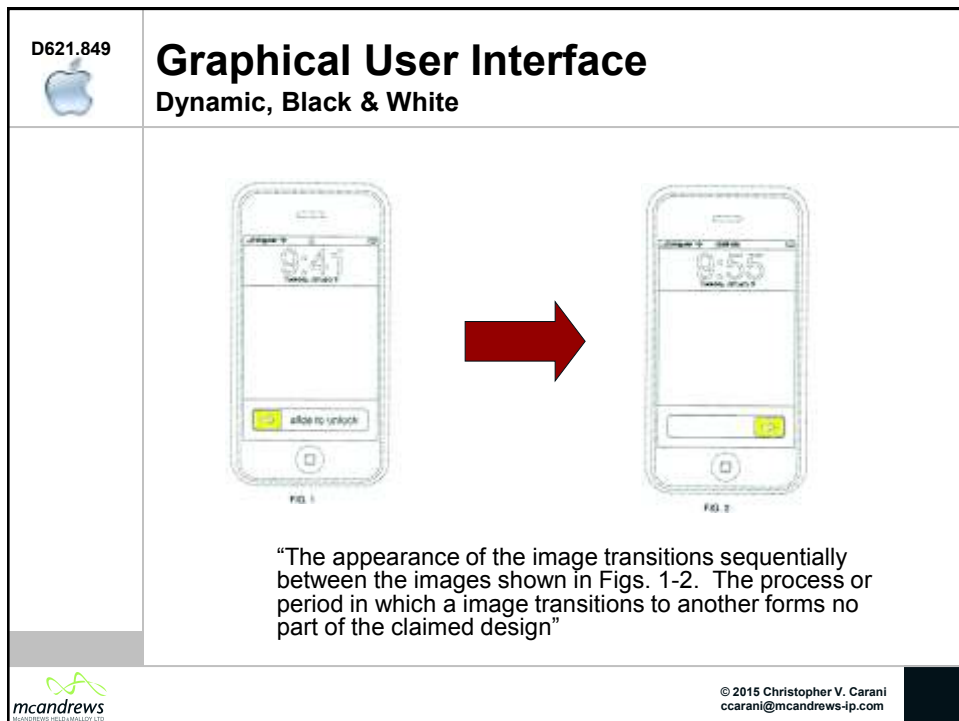
<p>NOOKA®</p>	<h2>Nooka Watch Interfaces</h2>
	<div data-bbox="574 468 1143 766" data-label="Image"> </div> <div data-bbox="1031 924 1209 955" data-label="Text"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1234 924 1274 955" data-label="Text"> <p>107</p> </div>

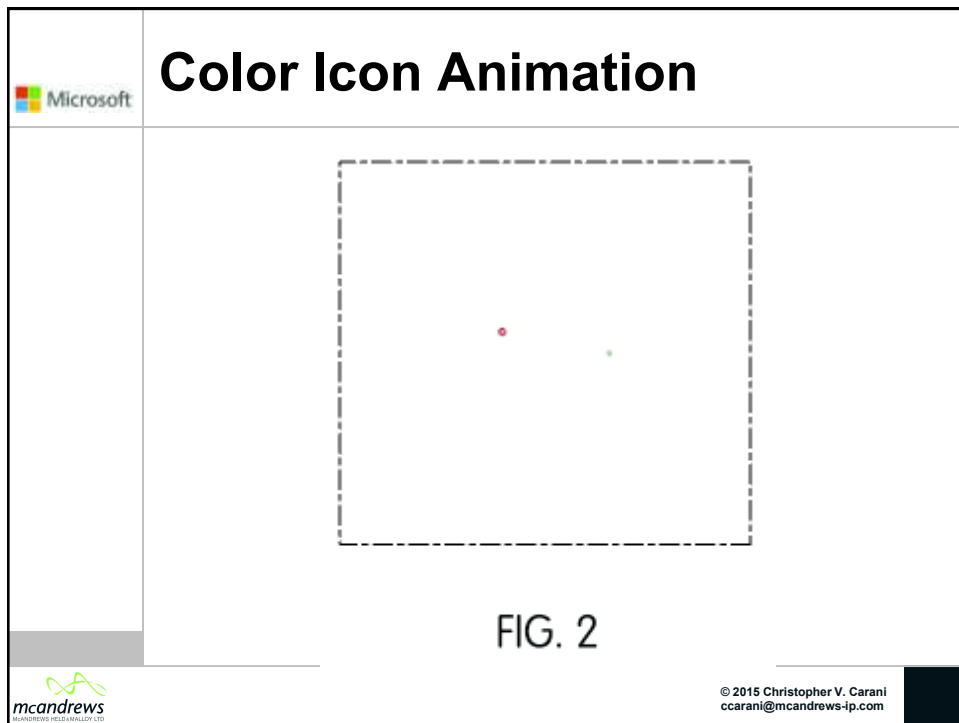
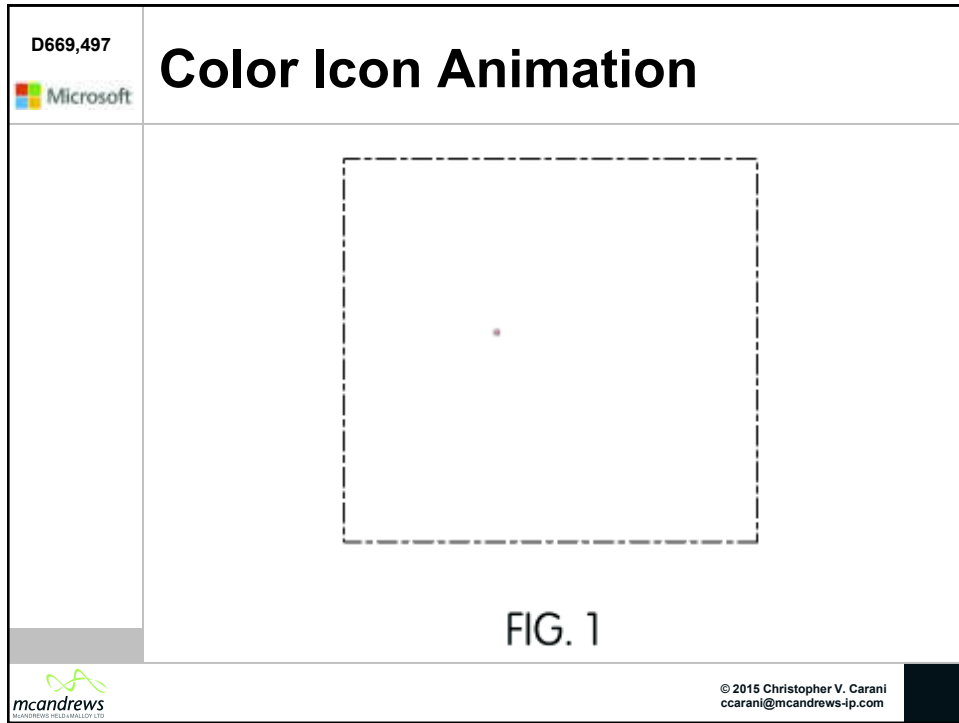
<p>NOOKA®</p>	<h2>D697,074; D697,075</h2> <p>Issued: January 7, 2014</p>
	<div data-bbox="542 1310 812 1696" data-label="Image"> </div> <div data-bbox="617 1705 732 1736" data-label="Caption"> <p>D697,074</p> </div> <div data-bbox="894 1310 1162 1696" data-label="Image"> </div> <div data-bbox="971 1705 1088 1736" data-label="Caption"> <p>D697,075</p> </div> <div data-bbox="1031 1795 1209 1827" data-label="Text"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1234 1795 1274 1827" data-label="Text"> <p>108</p> </div>

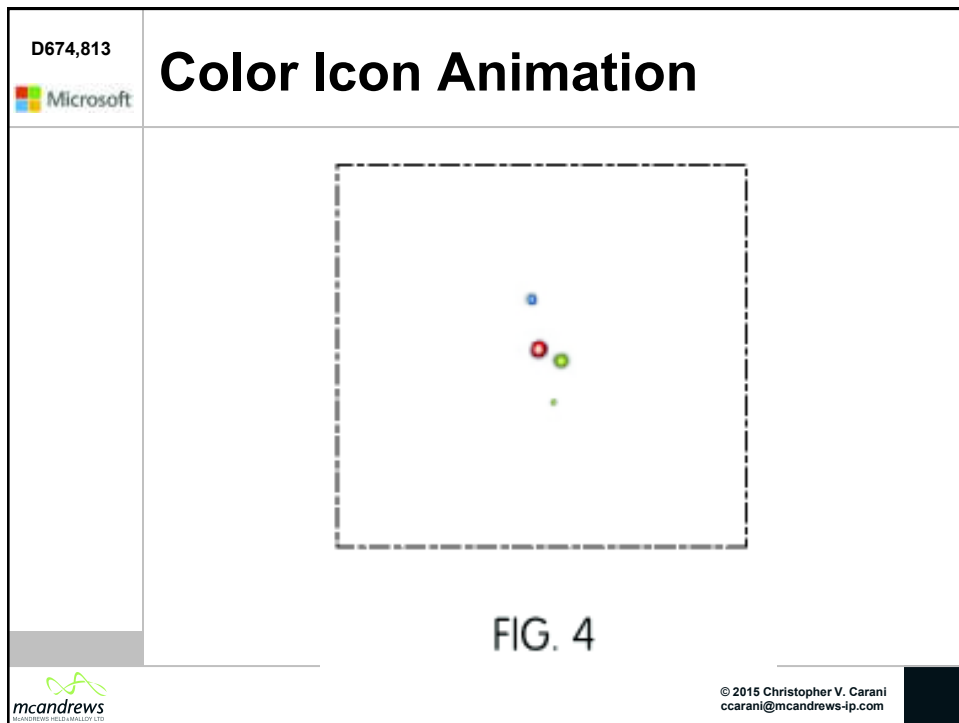
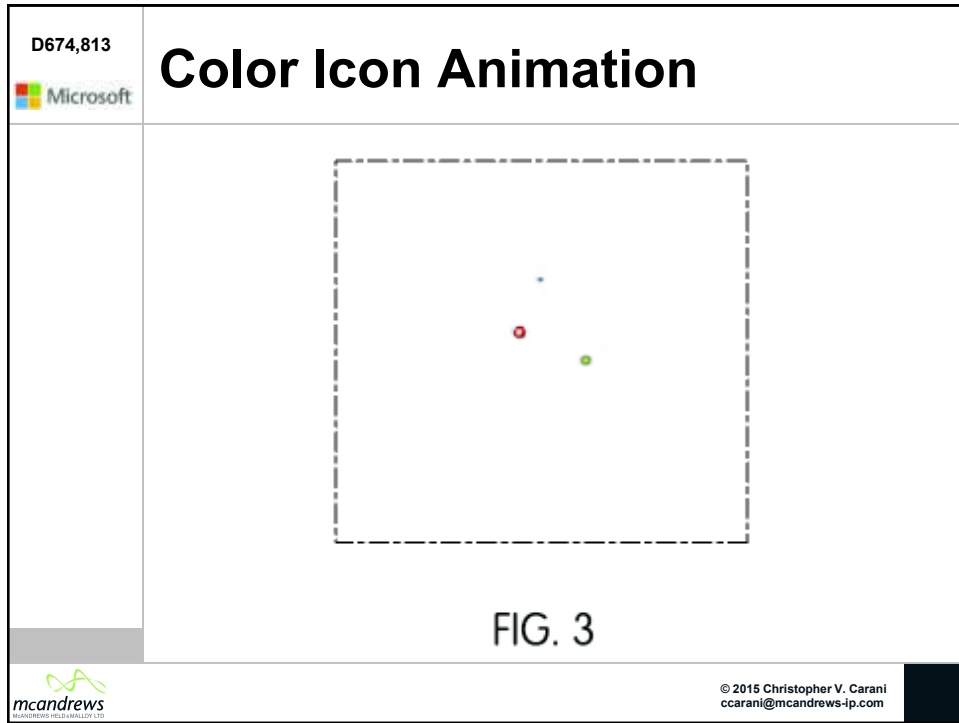










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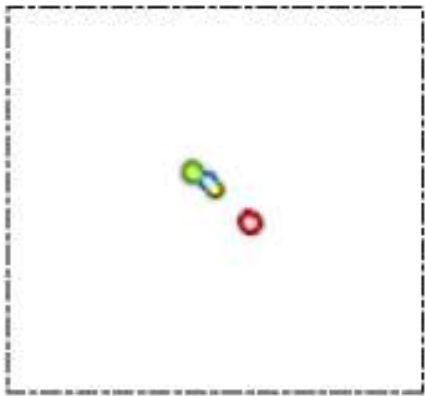









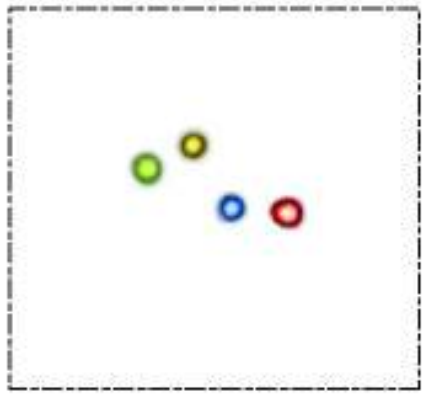

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 5</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


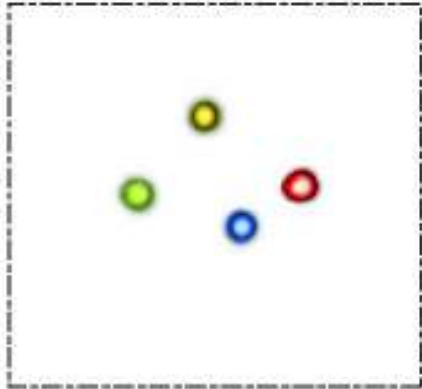

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 6</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


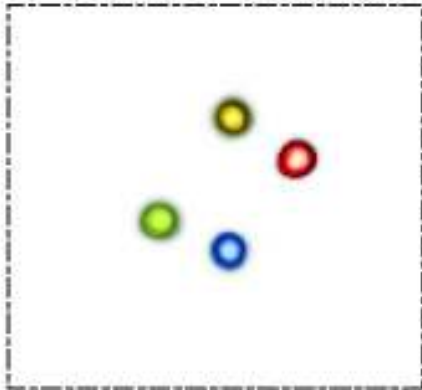

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 7</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

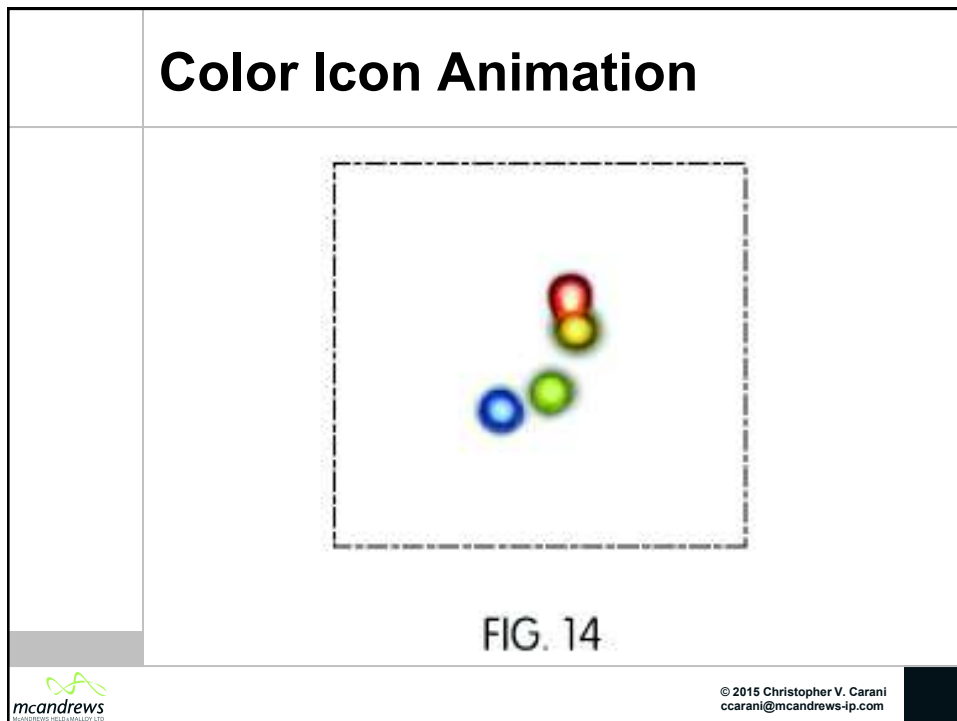
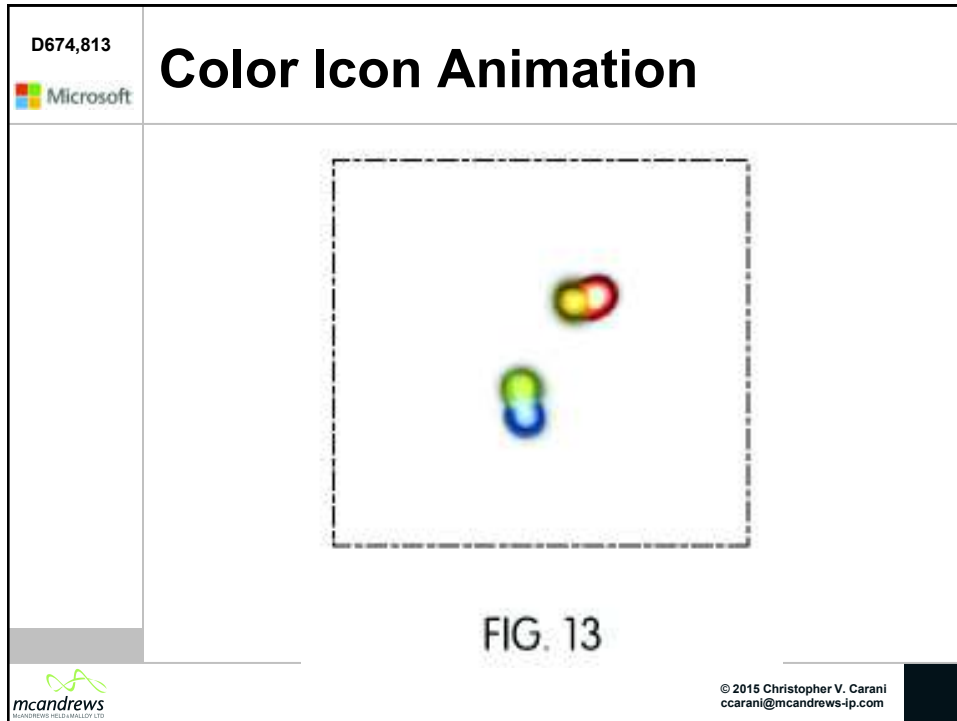
<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 8</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


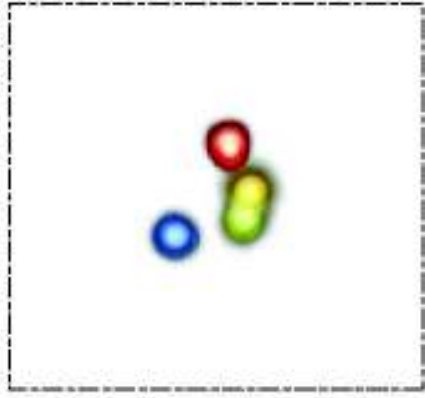

<p>D674,813</p> <p> Microsoft</p>	<h2>Color Icon Animation</h2>
	 <p>FIG. 9</p> <p> mcandrews REGISTERED PATENT ATTORNEYS</p> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>




<p>D674,813</p> <p> Microsoft</p>	<h2>Color Icon Animation</h2>
	 <p>FIG. 10</p> <p> mcandrews REGISTERED PATENT ATTORNEYS</p> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


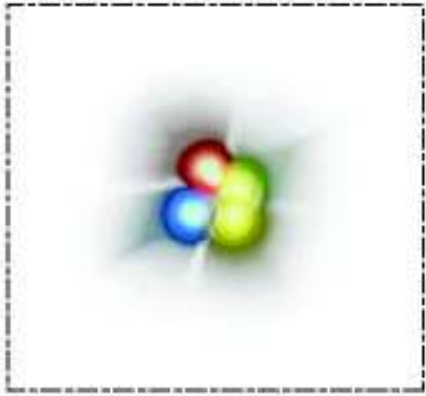

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 11</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>




<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	 <p>FIG. 12</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

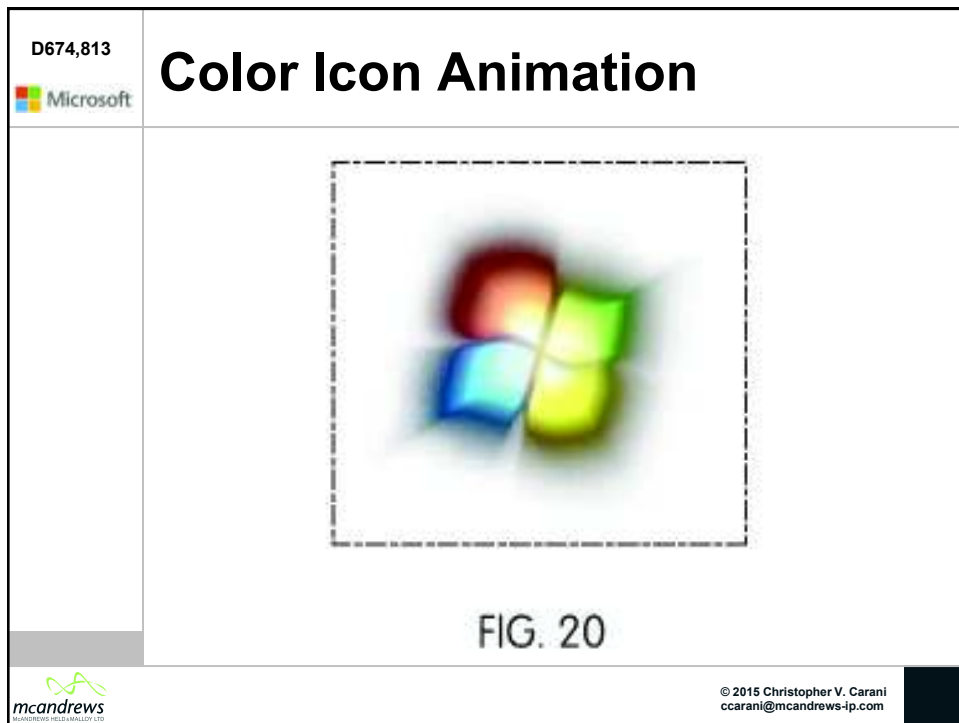
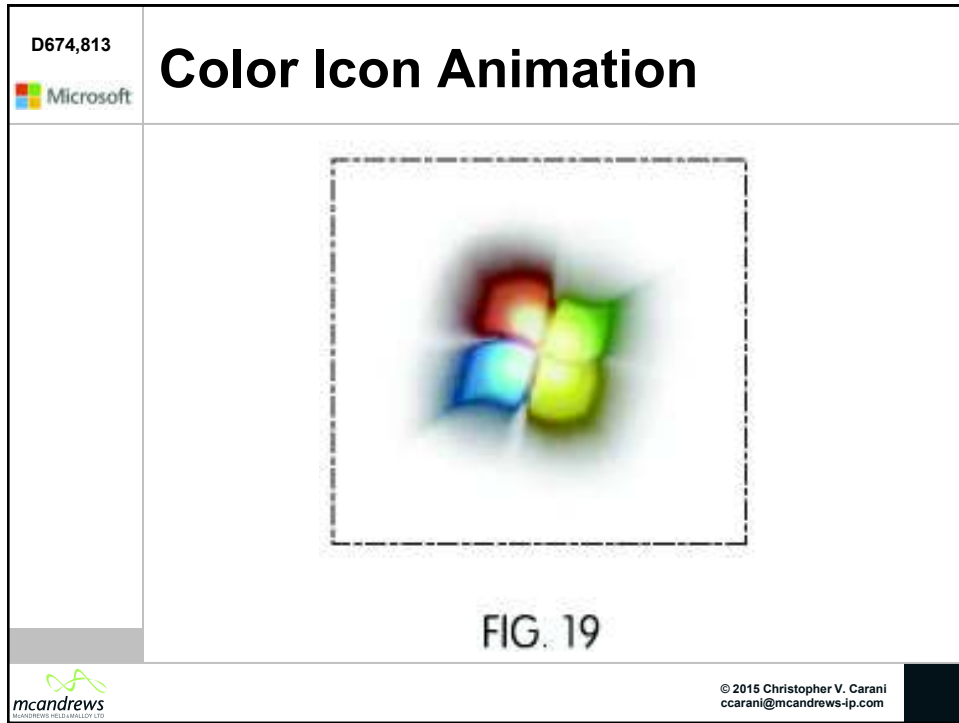





<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	<div data-bbox="651 405 1073 800">  </div> <p data-bbox="803 856 927 905">FIG. 15</p>
	<p data-bbox="1040 930 1211 961">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


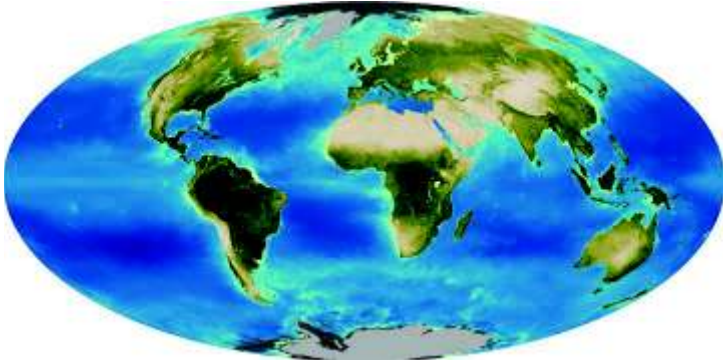

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	<div data-bbox="651 1274 1073 1669">  </div> <p data-bbox="803 1726 927 1774">FIG. 16</p>
	<p data-bbox="1040 1799 1211 1831">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	<div data-bbox="652 405 1075 798">  </div> <p data-bbox="808 856 928 907">FIG. 17</p>
	<p data-bbox="1042 928 1214 961">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

<p>D674,813</p> 	<h1>Color Icon Animation</h1>
	<div data-bbox="652 1274 1075 1667">  </div> <p data-bbox="808 1726 928 1776">FIG. 18</p>
	<p data-bbox="1042 1797 1214 1831">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



<p>D674,813</p> 	<h2>Color Icon Animation</h2>
	 <p>FIG. 20</p>
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	<h2>Global Design Prosecution Strategy...</h2>
	
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A Global Design Prosecution Strategy...


Key: "Think Ahead"

- No "Design PCT"
- Differing drawing requirements
- Paris Convention Priority must be filed within **6 mos.**
- Novelty grace periods

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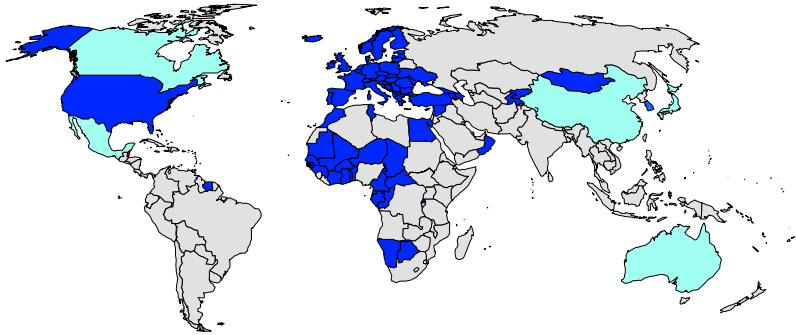

Novelty Grace Periods


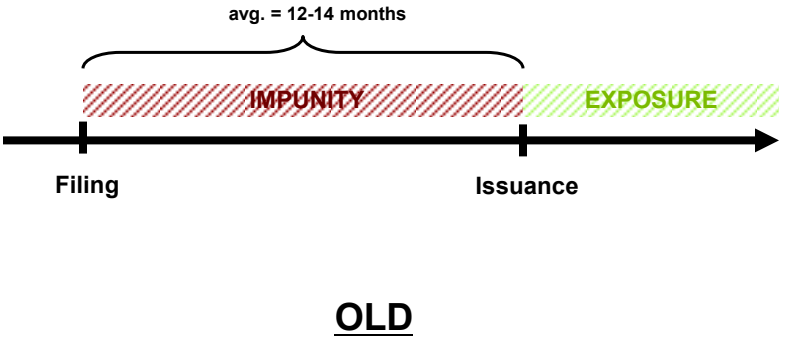

Countries/Treaty	Grace Period
Argentina	None
Australia	None
Brazil	6 mos.
Canada	12 mos.
China	None
India	None
Japan	6 mos.
Kenya	6 mos.
Korea	6 mos.
Mexico	12 mos.
Russia	6 mos.
South Africa	6 mos.
Thailand	None
Turkey	12 mos.
United States	12 mos.
European RCD	12 mos.

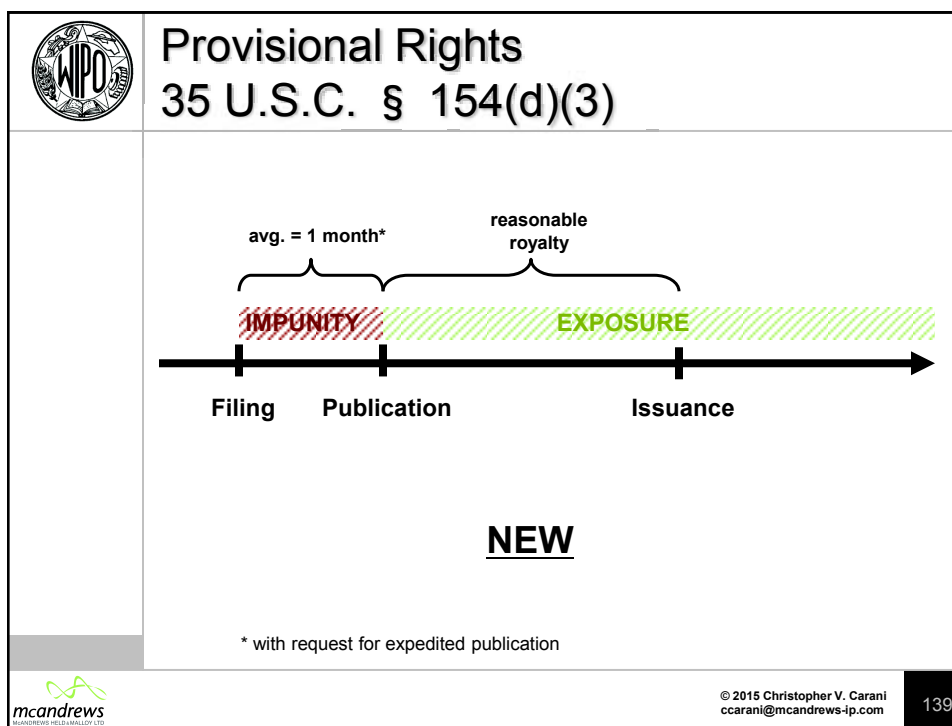
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	<h2>Hague Agreement</h2>
	
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	<h2>Provisional Rights</h2> <h3>35 U.S.C. § 154(d)(3)</h3>
 <p style="text-align: center;"><u>OLD</u></p>	
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	<h2>Design Patent Claim Construction</h2>  <p>Eye Test: What do you see?</p>
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Eye of an Ordinary Observer

Gorham v. White, 81 U.S. 511 (1871)

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Basic Layout of a Design Patent



- Title
- Claim
- Specification

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	<p>The <u>figures</u> are the claim. “Property Line”</p>
	<div style="display: flex; flex-wrap: wrap; justify-content: space-around;"> <div style="text-align: center;">FIG. 1 </div> <div style="text-align: center;">FIG. 2 </div> <div style="text-align: center;">FIG. 3 </div> <div style="text-align: center;">FIG. 4 </div> <div style="text-align: center;">FIG. 5 </div> <div style="text-align: center;">FIG. 6 </div> </div> <div style="display: flex; justify-content: space-between; align-items: center; margin-top: 10px;"> <div data-bbox="1044 926 1209 957"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 926 1273 957" style="background-color: black; color: white; padding: 2px 5px;">143</div> </div>

	<p>Lines of delineation</p>
	<div style="text-align: center; margin-top: 40px;"> <p><u>solid line (claimed)</u></p> <hr style="border: 1px solid black; width: 300px; margin: 10px auto;"/> <p><u>dashed line (unclaimed)</u></p> <hr style="border-top: 1px dashed black; width: 300px; margin: 10px auto;"/> </div> <div style="display: flex; justify-content: space-between; align-items: center; margin-top: 10px;"> <div data-bbox="1044 1793 1209 1824"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 1793 1273 1824" style="background-color: black; color: white; padding: 2px 5px;">144</div> </div>

Dotted Line Practice

Disclaim
design of
legs

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Blackberry LLC v. Typo Prods. LLC

3:14-cv-23 (N.D. Cal. 2014)

D685,775

Accused Product

**HOLDING: Preliminary
Injunction Granted**

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Minka Lighting, Inc. v. Craftmade Int'l, Inc., No. 3-00-CV-0888-G, 2002 U.S. Dist. LEXIS 8693 (N.D. Tex. May 15, 2002) (aff'd)

Patented Design



Accused Design



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Blue prints or worse...

Minka Lighting, Inc. v. Craftmade Int'l, Inc., No. 3-00-CV-0888-G, 2002 U.S. Dist. LEXIS 8693 (N.D. Tex. May 15, 2002) (aff'd)



Fig. 1, Perspective View



Fig. 7, Bottom View

The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion. When viewed from below, the fin-shaped arms of the central bracket [sweep] outward from the central opening in a clockwise direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding arc is in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade. When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed "running" star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade.



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Clarifying or Conflating?



Fig. 1, Perspective View



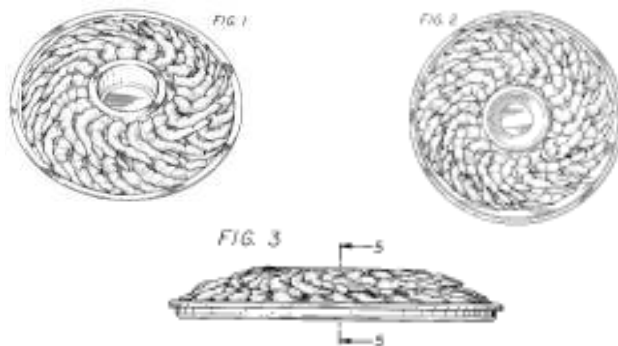
Fig. 7, Bottom View

- “fin-shaped”
- “sweeps”
- “partial sphere”
- “running pointed star”
- “generally football shaped”
- “sharply angle rounded corner”



Simply Claim Construction




Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1377 (Fed. Cir. 2002)




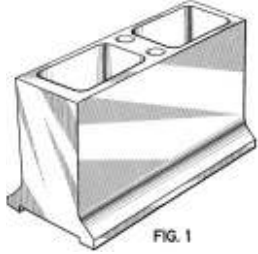

Claim Construction:
“design as shown in Figures 1-3”




	<p><i>Egyptian Goddess, Inc. v. Swisa, Inc.,</i> 543 F.3d 665 (Fed. Cir. 2008) (en banc)</p>
<div data-bbox="701 394 954 646" data-label="Image">  </div> <p style="text-align: center;"><u>General Rule:</u></p> <p style="text-align: center;">Verbalizations Should <u>Not</u> Be Attempted</p>	
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>



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	<p><i>Arc'Teryx Equip., Inc. v. Westcomb Inc.,</i> 2008 U.S. Dist. LEXIS 90228 (D. Utah Nov. 3, 2009)</p>
<p>Claim Construction:</p> <p>“In light of the Federal Circuit’s decision in <i>Egyptian Goddess</i>, it is <u>unnecessary</u> to construe the <i>Patent No. 513,715 (the “715 Patent”)</i> by providing a detailed verbal description of the claimed design. <u>Rather, the Court will rely upon the illustrations set out in the ‘715 Patent, as they better represent the claimed design.</u>”</p> <div data-bbox="727 1507 977 1759" data-label="Image">  </div>	
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

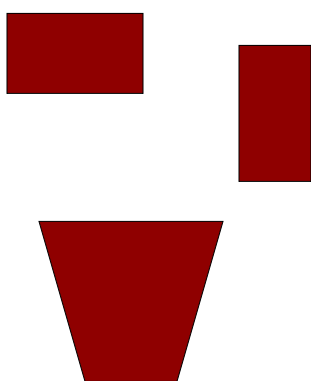
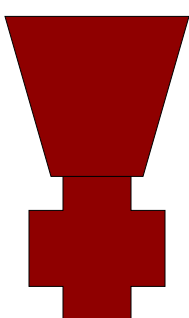

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	<p><i>Mondo Polymers v. Monroeville Indus. Inc.,</i> 2009 U.S. Dist. LEXIS 9948 (S.D. Ohio Jan. 30, 2009)</p>
	<p>Claim Construction:</p> <p>“Accordingly, the Court <u>declines</u> to draft a verbal description of the claimed design and <u>elects to rely upon the ‘954 patent and its illustrations.’</u>”</p> <div data-bbox="711 619 966 871" data-label="Image">  <p>FIG. 1</p> </div>
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	<p><i>Dexas Int’l, Ltd v. Office Max Inc.,</i> 2009 U.S. Dist. LEXIS 6642 (E.D. Tex. Jan. 30, 2009)</p>
	<p>Claim Construction:</p> <p>“In accordance with <i>Egyptian Goddess</i>, the Court finds that the claimed designs are better represented by the seven illustrations contained in each patent they could be by a verbal description.”</p> <div data-bbox="678 1480 1047 1743" data-label="Image">  </div>
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	<p><i>OddzOn Prods. v. Just Toys,</i> 122 F.3d 1396, 1405 (Fed. Cir. 1997) (J. Lourie)</p>
	<p>“A design patent <u>only protects</u> the:</p> <p>(1) novel, and</p> <p>(2) ornamental</p> <p><u>features</u> of the patented design.”</p>
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	<p>Novelty can Reside in Combination of OLD features*</p>	
	<p><u>Old Prior Art Elements</u></p> 	<p><u>New Design</u></p>  <p><i>*Egyptian Goddess, Inc. v. Swisa, Inc. (2008)</i></p>
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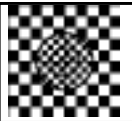

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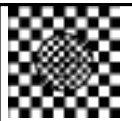

	<h2>Proper Statement of Law</h2>
	<p>“A design patent only protects the:</p> <p>(1) novel, and</p> <p>(2) ornamental</p> <p>features of the patented design.”</p> <p><u>overall appearance of the design as depicted in the drawings; it does not protect functional qualities or general design concepts.”</u></p>
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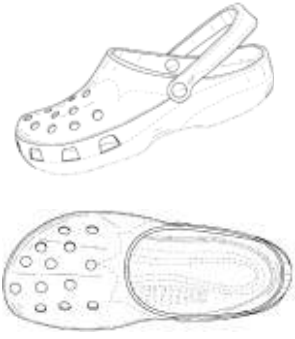


	<h2>Design Patent Defenses</h2>
	<ul style="list-style-type: none"> • Anticipation • Obviousness • Indefiniteness • Prosecution History Estoppel • Lack of Ornamentality (“Functionality”)
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	<h2>Design Anticipation “Standard 1”</h2> <p><i>Hupp v. Siroflex</i>, 122 F. 3d 1456, 1461 (Fed. Cir. 1997)</p>
	<p>To anticipate, a single prior art reference “must show the same subject matter as that of the patent, and must be identical in all material respects.”</p>
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	<h2>Design Anticipation “Standard 2”</h2> <p><i>Int’l Seaway v. Walgreens</i>, 589 F.3d 1233, 1240 (Fed. Cir. 2009):</p>
	<p>“[T]he same test must be used for both infringement and anticipation...” (citing <i>Peters v. Active Mfg.</i>)</p> <p style="text-align: center;">* * *</p> <p>Thus, “the ordinary observer test is the sole test for design patent invalidity under § 102.”*</p> <p style="text-align: right;">*No mention of <i>Hupp</i> anticipation standard or prior Federal Circuit precedent</p>
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	<h2>Discord on Anticipation Standard</h2>
	<p>Standard 1: “Identical in Material Respects”</p> <p style="text-align: center;">=</p> <p>Standard 2: “Substantially the Same”?</p>
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	<h2>“Substantial Similarity” vs. “Identical in All Material Respects”</h2>	
	<p style="text-align: center;"><u>Prior Art Design</u></p> 	<p style="text-align: center;"><u>Patented Design</u></p> 
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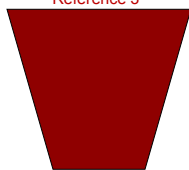
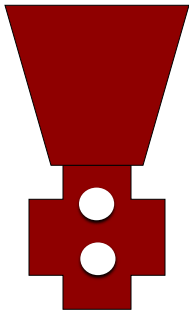
	<h2><i>In re Rosen</i></h2> <p>673 F.2d 388 (C.C.P.A. 1982)</p>
<h3><u>Design Patent Obviousness</u></h3> <p>“there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness.”</p>	
	
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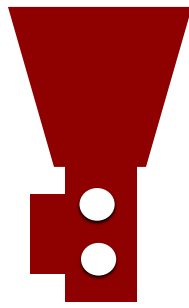
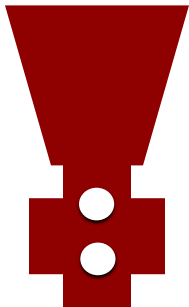
163



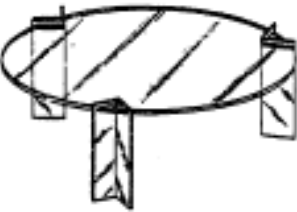

<h2>Degrees of Identity</h2>
<p>“Basically the same” (Obviousness)</p> <p>“Substantially the same” (Infringement)</p> <p>“Identical in All Material respects” (Anticipation)</p>







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	<p><i>In re Rosen</i> 673 F.2d 388 (CCPA 1982)</p>	
	<p><u>Prior Art</u></p> <div style="display: flex; flex-direction: column; align-items: center;"> <div style="display: flex; justify-content: space-around; width: 100%;"> <div style="text-align: center;"> <p>Reference 1</p>  </div> <div style="text-align: center;"> <p>Reference 2</p>  </div> </div> <div style="text-align: center; margin-top: 20px;"> <p>Reference 3</p>  </div> </div>	<p><u>Design Patent</u></p> 
<div style="display: flex; justify-content: space-between;"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p>165</p> </div>		

	<p><i>In re Rosen</i> 673 F.2d 388 (CCPA 1982)</p>	
	<p><u>Prior Art</u></p> 	<p><u>Design Patent</u></p> 
<div style="display: flex; justify-content: space-between;"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> <p>166</p> </div>		

	Obviousness Framework: In re Rosen and the “Primary Reference” Requirement	
	<p><u>Prior Art References</u></p> 	<p><u>Claimed Design</u></p>  <p>Is there a primary reference that is “basically the same”??</p> <p>ANSWER: NO</p>
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	<i>In re Rosen Reference?</i>	
	<p><i>Durling v. Spectrum Furniture (Fed. Cir. 1996):</i></p> <div style="display: flex; justify-content: space-around; align-items: flex-start;"> <div style="text-align: center;"> <p>Claimed Design</p>  </div> <div style="text-align: center;"> <p>Prior Art</p>  </div> <div style="text-align: right;"> <p>Is prior art reference “basically the same”?</p> <p>ANSWER: NO</p> </div> </div>	
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	<h2 style="text-align: center;">In re Rosen Reference?</h2>	
<p><i>In re Vanguard</i> (BPAI 2010):</p>		
<p style="text-align: center;"><u>Prior Art</u></p> <p style="text-align: center;"><u>Fig. 1</u></p>	<p style="text-align: center;"><u>Claimed Design</u></p> <p style="text-align: center;"><u>FIG. 1</u></p> <p>Is a single prior art reference “basically the same”?</p> <p style="color: red; text-align: center;">ANSWER: NO</p>	
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	<h2 style="text-align: center;">Apple Inc. v. Samsung Electronics</h2> <p style="text-align: center;">678 F.3d 1314, 1330 (Fed. Cir. 2012)</p>	
<p style="text-align: center;"><u>Prior Art Combination</u></p> <p style="color: red; text-align: center;">Primary Reference: Fidler (2004)</p> <p style="color: red; text-align: center;">Secondary Reference: HP TC1000 (2004)</p>	<p style="text-align: center;"><u>US D504,889</u></p> <p>Is there a primary reference?</p> <p style="color: red; text-align: center;">ANSWER: NO</p>	
	<p style="text-align: right;">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>	

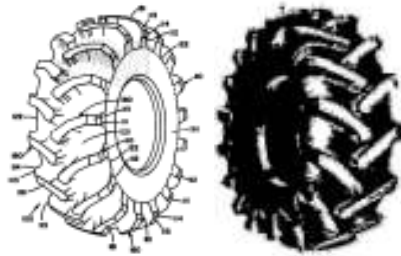
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In re Rosen Reference?

Titan Tire v. Case New Holland (Fed. Cir. 2009):

Prior Art



Claimed Design



Is a single prior art reference
“basically the same”?

ANSWER: YES



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MRC Innovations, Inc. v. Hunter Mfg., LLP, 2014 U.S. App. LEXIS 6074 (Fed. Cir. Apr. 2, 2014)

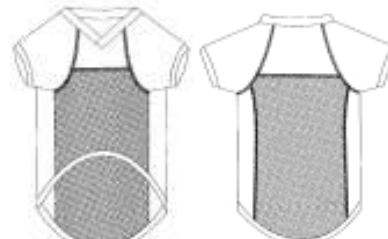
Prior Art



front

back

Patent



front

back



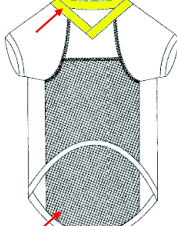
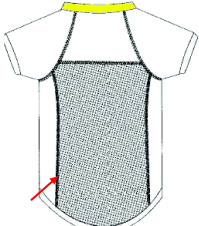
Differences

- V-Neck
- Mesh
- Surge Stitching (back)




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	<p><i>MRC Innovations, Inc. v. Hunter Mfg., LLP</i> 2014 U.S. App. LEXIS 6074 (Fed. Cir. Apr. 2, 2014)</p>
<p style="text-align: center;">Prior Art</p> <div style="display: flex; justify-content: space-around;">   </div> <div style="display: flex; justify-content: space-around;"> <p>front</p> <p>back</p> </div>	<p style="text-align: center;">Patent</p> <div style="display: flex; justify-content: space-around;">   </div> <div style="display: flex; justify-content: space-around;"> <p>front</p> <p>back</p> </div>
<p>Is a single prior art reference “basically the same”?</p> <p style="color: green; text-align: center;">ANSWER: YES</p>	
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	<p>An Approach to Obviousness Focus on <u>delta</u> between prior art and patented design</p>
<div style="text-align: center;"> <p>Is the <i>difference</i> obvious to DOSITA?</p>  </div>	
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Obviousness Framework: Combining References

“The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are **so related** that the appearance of certain ornamental features in one would **suggest the application** of those features to the other.”

In re Glavas (C.C.P.A. 1956)

Rejecting the combination where “modifications of primary reference necessary to achieve [the patented] design would **destroy the fundamental characteristics**” of the primary reference.”

In re Rosen (C.C.P.A. 1982)



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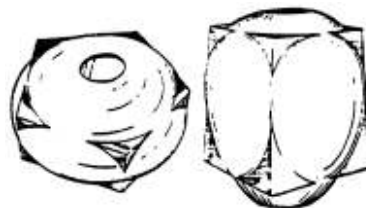
De Minimis Modification

In re Harvey (Fed. Cir. 1993)

“[I]f prior art designs are to be modified in **more than one respect** to render a claimed design obvious, then **those modifications must be ‘de minimis’** in nature and unrelated to the overall aesthetic appearance of the design.”



Prior Art



Claimed Designs



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	<p>MRC Innovations, Inc. v. Hunter Mfg., LLP, 2014 U.S. App. LEXIS 6074 (Fed. Cir. Apr. 2, 2014)</p>		
PRIMARY	<u>Prior Art</u>		<u>Patent</u>
			<div style="display: flex; justify-content: space-around;"> front back </div>
SECONDARY			
<p>FED.CIR.: OBVIOUS</p>			

An Approach to Obviousness

Focus on delta between prior art and patented design



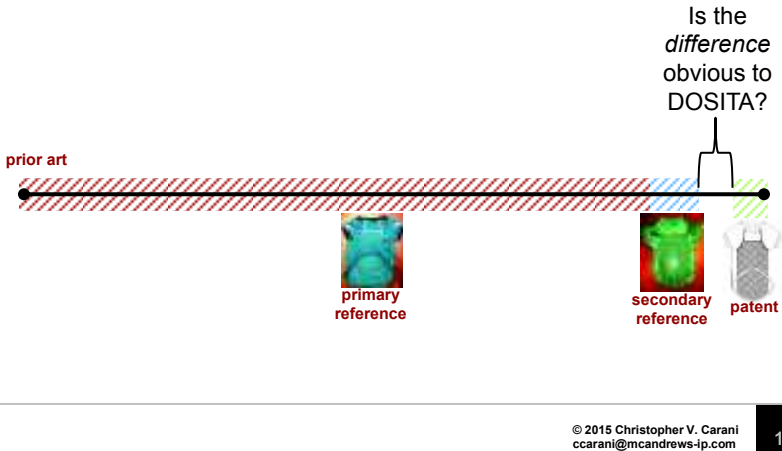

prior art




primary reference

secondary reference patent

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	<h2>An Approach to Obviousness</h2> <p>Focus on <u>delta</u> between prior art and patented design</p>
	 <p>Is the difference obvious to DOSITA?</p> <p>prior art</p> <p>primary reference</p> <p>secondary reference</p> <p>patent</p>
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	<h2>“Ordinary Designer” or “Ordinary Observer”</h2>
	<p>Would the design have been “obvious to a designer of ordinary skill who designs articles of the type involved”?</p> <p><i>Durling v. Spectrum Furniture</i> (Fed. Cir. 1996)</p> <p>“Obviousness ... requires courts to consider the perspective of the ordinary observer.”</p> <p><i>Int'l Seaway v. Walgreens Corp.</i> (Fed. Cir. 2009)</p> <p>“Obviousness is assessed from the vantage point of an ordinary designer in the art...”</p> <p><i>High Point Design v. Buyers Direct</i> (Fed. Cir. 2013)</p>
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Indefiniteness

35 U.S.C § 112



Patent Invalidity under 35 USC § 112

“The necessity for good drawings in a design patent application can not be overemphasized. As the drawing constitutes the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness, that **nothing regarding the design is left to conjecture. An insufficient drawing may be fatal to validity** (35 U.S.C. § 112, first paragraph).”

Manual of Patent Examining Procedures (“MPEP”) § 1503.02



Seed Lighting v. Home Depot ,

2005 U.S. Dist. LEXIS 44741 (N.D. Cal. 2005)



FIG. 1

D407,519



FIG. 2

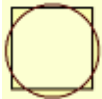


FIG. 3

"The base of the Subject Lamp is depicted as a thin, flat, disk-like plate in Figure 1 and as a raised, domed shape in Figures 2 and 3."



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Seed Lighting v. Home Depot ,

2005 U.S. Dist. LEXIS 44741 (N.D. Cal. 2005)



FIG. 1




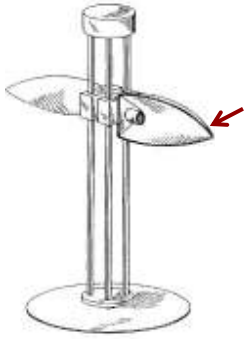
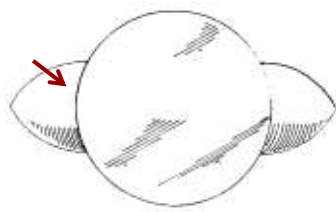

FIG. 4




"The disk at the top of the vertical rods of the Subject Lamp is shown in **Figure 1** as having the same outer dimension as the square formed by the "sliders" that move the shades up and down and in **Figure 4** as being small enough to fit within the square formed by those sliders."



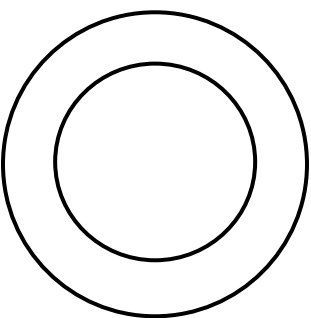




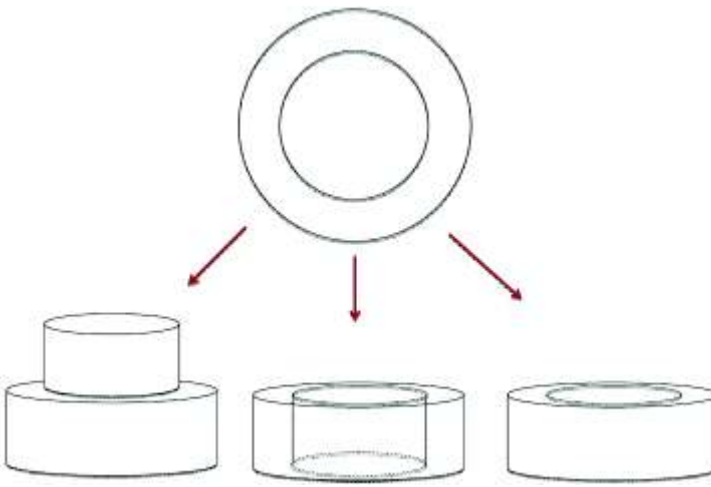
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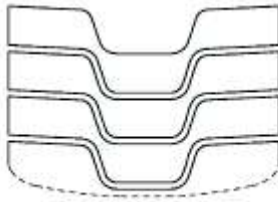
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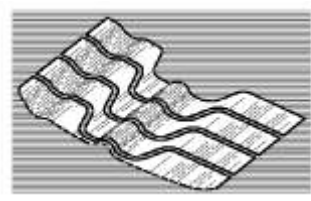
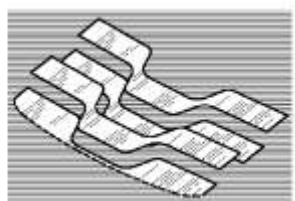
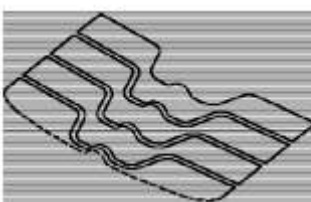
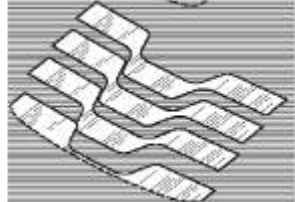
	<p>Seed Lighting v. Home Depot , 2005 U.S. Dist. LEXIS 44741 (N.D. Cal. 2005)</p>
	<div style="display: flex; justify-content: space-around; align-items: center;"> <div style="text-align: center;">  <p>FIG. 8</p> </div> <div style="text-align: center;">  <p>FIG. 5 (bottom plan view)</p> </div> </div> <p>“The underside of the Subject Lamp is depicted in Figure 8 as having a specific edge and wall thickness around the perimeter of the shade and in Figure 5 as consisting of a solid surface with no edge or wall thickness.”</p> <div style="display: flex; justify-content: space-between; align-items: center; margin-top: 10px;"> <div data-bbox="328 913 467 970">  </div> <div data-bbox="1031 924 1209 961"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1226 924 1279 961" style="background-color: black; color: white; padding: 2px 5px;">185</div> </div>




	<p>Seed Lighting v. Home Depot , 2005 U.S. Dist. LEXIS 44741 (N.D. Cal. 2005)</p>
	<p>“Due to drawing inconsistencies, summary judgment of INVALIDITY is GRANTED.”</p> <p style="text-align: center; font-size: 1.2em;"><u>PATENT INVALID</u></p> <div style="text-align: center; margin-top: 20px;">  </div> <div style="display: flex; justify-content: space-between; align-items: center; margin-top: 10px;"> <div data-bbox="328 1780 467 1837">  </div> <div data-bbox="1031 1791 1209 1829"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1226 1791 1279 1829" style="background-color: black; color: white; padding: 2px 5px;">186</div> </div>



	Indefiniteness (35 U.S.C § 112)
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	Indefiniteness (35 U.S.C § 112)
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	<h2>Indefiniteness (35 U.S.C § 112)</h2>
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<div data-bbox="1039 924 1209 955"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 934 1274 955"> <p>189</p> </div>	

	<h2>Indefiniteness (35 U.S.C § 112)</h2>
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<div data-bbox="1039 1795 1209 1827"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1242 1806 1274 1827"> <p>190</p> </div>	

	
	<h1 style="text-align: center;">Design Patent Functionality</h1> <div style="display: flex; justify-content: space-around; align-items: center; margin-top: 100px;">  <div style="text-align: center;"> <p><i>Design Patent Functionality: A Sensible Solution,</i> Christopher V. Carani, ABA's <i>Landslide</i>®, Nov/Dec 2014, Vol. 7, No. 2.</p> </div> </div>
	<div style="display: flex; justify-content: space-between; align-items: center;"> <div> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div style="background-color: black; color: white; padding: 2px 10px; font-weight: bold;">191</div> </div>

	<h2 style="text-align: center;">Design Patents</h2>
	<div style="text-align: center; margin-top: 100px;">  </div> <h2 style="text-align: center; margin-top: 20px;">FAQ: Is it functional?</h2>
	<div style="display: flex; justify-content: space-between; align-items: center;"> <div> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div style="background-color: black; color: white; padding: 2px 10px; font-weight: bold;">192</div> </div>

Design Patents



FAQ: Is it functional?

A: Yes. But so what?!



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“Functionality” Boogie Man



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“Functionality” Boogie Man



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“Functionality” Boogie Man







BUST THE MYTH.


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	<h2>35 U.S.C. § 171</h2>
	<p><u>35 U.S.C. § 171, Design Patents</u> “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.”</p>
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	<h2>35 U.S.C. § 171(Design Patents) 35 U.S.C. § 101 (Utility Patents)</h2>
	<p><u>35 U.S.C. § 171, Design Patents</u> “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.”</p> <p><u>35 U.S.C. § 101, Utility Patents</u> “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”</p>
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2	Two Separate “Functionality” Issues
	<p><u>Issue 1: Statutory Compliance</u> “Functionality” of Overall Claimed Design</p> <p><u>Issue 2: Claim Construction</u> “Functionality” of Aspects of the Overall Claimed Design</p>
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	<p>Issue 1: Statutory Compliance 35 U.S.C § 171</p>
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What Qualifies as “Ornamental?” 35 U.S.C. § 171

Bonito Boats (1989)

“To qualify for protection, a design must present an ...**appearance that is not dictated by function alone**, and must satisfy the other criteria of patentability.”

See 35 U.S.C. § 171.

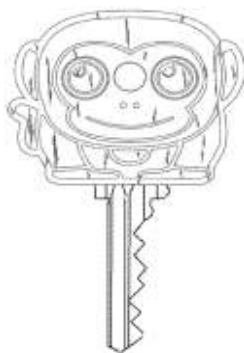


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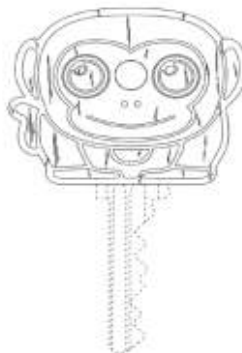
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Issue 1: Statutory Compliance

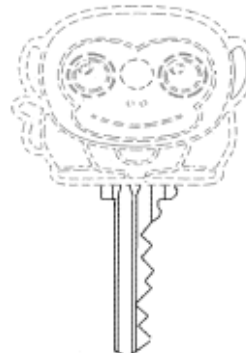
Example 1



Example 2



Example 3



Validity Question: Is Appearance of Overall Claimed Design Dictated by Function Alone?

Best Lock Corp. v. Ico Unican Corp. (Fed.Cir. 1997)



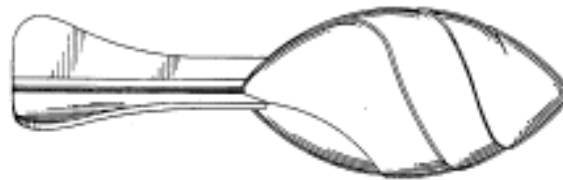
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Examples of Statutory-Functionality (Issue 1)







Oddzon Prods., Inc., v. Just Toys, Inc. 122 F. 3d 1396 (Fed. Cir. 1997)






Question: Is Appearance of Overall Claimed Design Dictated by Function Alone? **No.**


Design is "ORNAMENTAL."

	<p><i>Richardson v. Stanley Works, Inc.,</i> 597 F.3d 1288 (Fed. Cir. 2010)</p>
	<div data-bbox="609 520 1079 703" data-label="Image"> </div> <p>Question: Is Appearance of <u>Overall Claimed Design</u> Dictated by Function Alone? No.</p> <p>Design is "ORNAMENTAL."</p>
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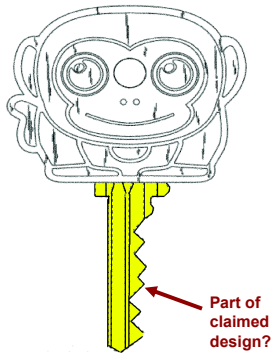

	<p><i>High Point Design LLC v. Buyers Direct, Inc.,</i> 730 F.3d 1301 (Fed. 2014)</p>
	<div data-bbox="678 1318 1096 1612" data-label="Image"> </div> <p>Question: Is Appearance of <u>Overall Claimed Design</u> Dictated by Function Alone? No.</p> <p>Design is "ORNAMENTAL."</p>
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	<p><i>Rip-It Holdings v Wilson Hunt Int'l</i>, 2012 U.S. Dist. LEXIS 4490 (M.D. Fla. January 13, 2012)</p>
	<p><u>U.S. Design Patent D603,102</u></p>  <p>COURT: Overall Design Dictated by Function; INVALID</p>
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	<p>Issue 2: Claim Construction “Functional Aspects”</p>
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	<h2>Issue 2: Claim Construction - Functionality</h2>
	<p><u>Patented Design</u></p>  <p><i>Richardson v. Stanley Works, Inc.</i>, (Fed. Cir. 2010)</p>
	<p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>


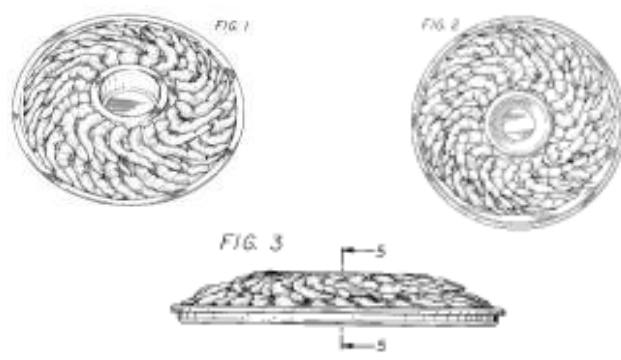
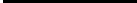
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	<h2><i>Egyptian Goddess, Inc. v. Swisa, Inc.</i>,</h2> <p>543 F.3d 665 (Fed. Cir. 2008) (<i>en banc</i>)</p>
	 <h2>Design Patent Claim Construction</h2>
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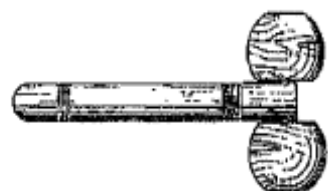
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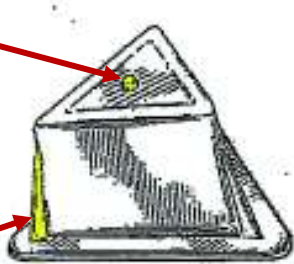



	<h2 style="text-align: center;">Blue prints or worse...</h2> <p style="text-align: center;"><i>Minka Lighting, Inc. v. Craftmade Int'l, Inc., No. 3:00-CV-0888-G, 2002 U.S. Dist. LEXIS 8693 (N.D. Tex. May 15, 2002) (aff'd)</i></p>	
	<div style="text-align: center;">  <p>Fig. 1, Perspective View</p>  <p>Fig. 7, Bottom View</p> </div>	<p>"The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion. When viewed from below, the fin-shaped arms of the central bracket [sweep] outward from the central opening in a clockwise direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding are in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade. When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed "running" star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade."</p>
<div style="display: flex; justify-content: space-between; align-items: center;"> <div data-bbox="337 909 467 963">  </div> <div data-bbox="1040 926 1208 955"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com </div> <div data-bbox="1240 932 1274 953" style="background-color: black; color: white; padding: 2px 5px;">211</div> </div>		


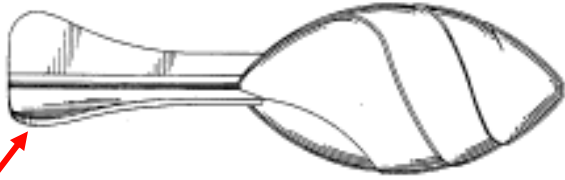


	<h2 style="text-align: center;">Clarifying or Conflating?</h2>	
	<div style="text-align: center;">  <p>Fig. 1, Perspective View</p>  <p>Fig. 7, Bottom View</p> </div>	<ul style="list-style-type: none"> • "fin-shaped" • "sweeps" • "partial sphere" • "running pointed star" • "generally football shaped" • "sharply angle rounded corner"
<div style="display: flex; justify-content: space-between; align-items: center;"> <div data-bbox="337 1780 467 1837">  </div> <div data-bbox="1040 1797 1208 1827"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com </div> <div data-bbox="1240 1803 1274 1824" style="background-color: black; color: white; padding: 2px 5px;">212</div> </div>		

	<h2>Simply Claim Construction</h2> <p>Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1377 (Fed. Cir. 2002)</p>
	<div data-bbox="519 378 1136 735">  </div> <p>Claim Construction: “design as shown in Figures 1-3”</p>
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	<h2><i>Egyptian Goddess, Inc. v. Swisa, Inc.,</i></h2> <p>543 F.3d 665 (Fed. Cir. 2008) (<i>en banc</i>)</p>
	<div data-bbox="714 1260 925 1491">  </div> <p>General rule:</p> <ul style="list-style-type: none"> • Overall Appearance • No verbalization of the drawings • Drawings speak for themselves
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	<h2 style="text-align: center;">Lee v. Dayton-Hudson Corp.</h2> <p style="text-align: center;">838 F.2d 1186 (Fed. Cir. 1988).</p>
	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;"> <p><u>Patented Design</u></p>  </div> <div style="text-align: center;"> <p><u>Accused Design</u></p>  </div> </div> <p style="text-align: center;">Court: “Design patents do not and cannot include claims to the structural or functional aspects of the article.”</p> <p style="text-align: center;">“Functional aspects” refers to functional <i>attributes, purposes or characteristic</i>, not visual features, elements or portions of the overall claimed design.</p> <div style="display: flex; justify-content: space-between; align-items: center;"> <div data-bbox="1031 924 1209 955"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1234 924 1266 966" style="text-align: center;"> <p>21 5</p> </div> </div>

	<h2 style="text-align: center;">Elmer v. ICC Fabricating, Inc.,</h2> <p style="text-align: center;">67 F. 3d 1571 (Fed. Cir. 1995)</p>
	<div style="text-align: center;">  </div> <div style="display: flex; justify-content: space-around; margin-top: 10px;"> <div style="text-align: center;"> <p>“protrusion”</p>  </div> <div style="text-align: center;"> <p>“support ribs”</p>  </div> </div> <div style="margin-top: 20px;">  <p>Holding: Regardless of whether features such as “support ribs” and “protrusion” are functional, the elements are depicted in solid lines and thus part of the claimed design.</p> </div> <div style="display: flex; justify-content: space-between; align-items: center; margin-top: 10px;"> <div data-bbox="1031 1795 1209 1827"> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p> </div> <div data-bbox="1234 1795 1266 1837" style="text-align: center;"> <p>216</p> </div> </div>

	<p><i>But see, Oddzon Prods., Inc., v. Just Toys, Inc.</i> 122 F. 3d 1396 (Fed. Cir. 1997) (J. Lourie)</p>
	<div data-bbox="673 420 1234 598">  </div> <div data-bbox="495 693 690 745"> <p>Tail and fins</p> </div> <div data-bbox="730 745 787 808">  </div> <div data-bbox="820 745 1209 840"> <p>Holding: Tail and fins are functional aspects of the design and are thus <u>not part of claimed design</u>.</p> </div>
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	<p><i>OddzOn Prods. v. Just Toys,</i> 122 F.3d 1396, 1405 (Fed. Cir. 1997) (J. Lourie)</p>
<p>WRONG!</p>	<p>“A design patent <u>only protects</u> the: (1) novel, and (2) ornamental <u>features</u> of the patented design.”</p>
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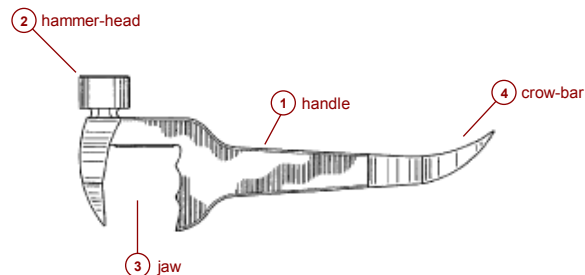
Richardson v. Stanley Works, Inc.,
597 F.3d 1288 (Fed. Cir. 2010)






Richardson v. Stanley Works, Inc.,
597 F.3d 1288 (Fed. Cir. 2010)


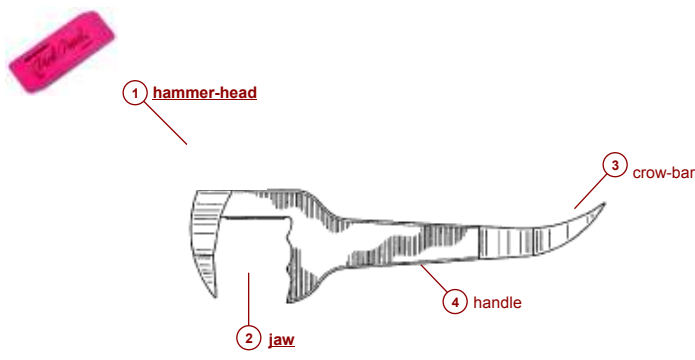

Claim Construction (Matter of Law)


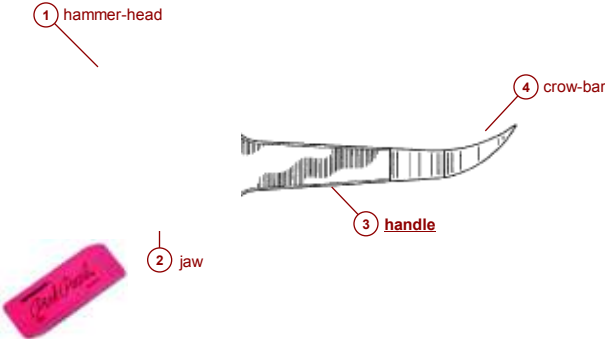

“Richardson's multi-function tool comprises several **elements** that are **driven purely by utility**. As the district court noted, **elements** such as the **handle**, the **hammer-head**, the **jaw**, and the **crowbar** are dictated by their functional purpose.”


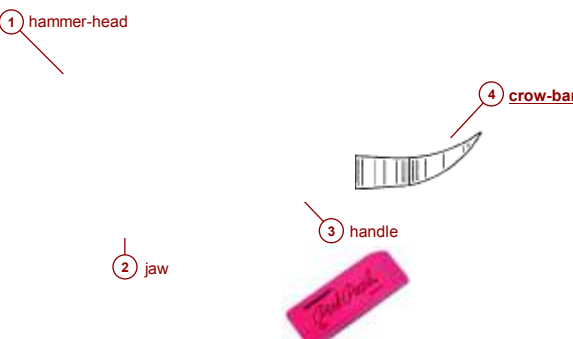




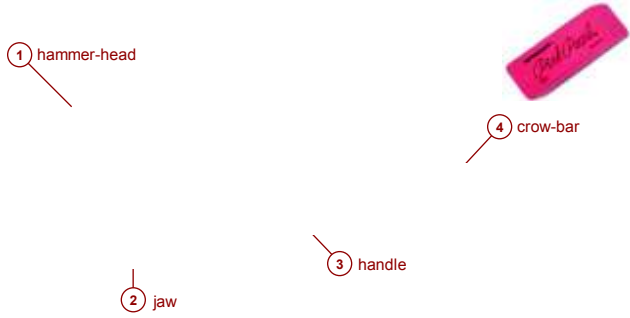

*citing *Egyptian Goddess*




	<h2 style="text-align: center;">“Divide and Conquer”?</h2>
	<p style="text-align: center;"><u>Claim Construction</u></p> <p style="text-align: center;">“Discount,” “Ignore,” “Factor out,” these features</p> <div style="text-align: center;">  </div>
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 221 </div>

	<h2 style="text-align: center;">“Divide and Conquer”?</h2>
	<div style="text-align: center;">  </div>
	<div style="display: flex; justify-content: space-between;"> © 2015 Christopher V. Carani ccarani@mcandrews-ip.com 222 </div>

	<h2>"Divide and Conquer"?</h2>
	 <p>1 hammer-head</p> <p>2 jaw</p> <p>3 handle</p> <p>4 crow-bar</p>
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	<h2>"Divide and Conquer"?</h2>
	 <p>1 hammer-head</p> <p>2 jaw</p> <p>3 handle</p> <p>4 crow-bar</p>
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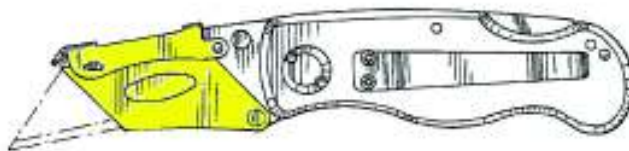
	<h2>"Divide and Conquer"?</h2>
	 <p>1 hammer-head</p> <p>2 jaw</p> <p>3 handle</p> <p>4 crow-bar</p>
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	<h2><u>Claim Construction = Claim Destruction</u></h2>
	
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Examples of Claim Construction- “Functionality” (Issue 2)





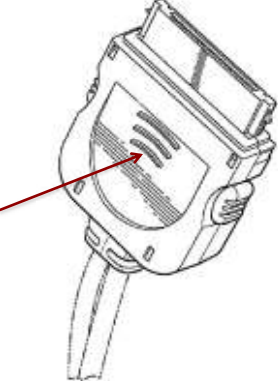

Great Neck Saw Mfg. v. Star Asia U.S.A. LLC,
727 F.Supp 2d 1038 (W.D. Wash. July 23, 2010)



COURT: “Given its functional nature [...], **the blade lock means** is not entitled to design protection.”

	<p>Safco Prods Co. v. Welcom Prods. 08-4918 (D. Minn. July 1, 2011) (Claim Construction Order)</p>
	<p>“The figures of the '708 patent disclose, <u>based on this Court's independent assessment</u>, several <u>ornamental features</u> of the pushcart, from top to bottom <u>are</u>:</p> <ol style="list-style-type: none"> (1) the dual scalloped handles, with the curved dual scalloped shape of the lower handle mirroring the curved scallop shape of the upper handle; (2) the textured appearance of the center portion of the top scalloped handle; (3) a crossbar with a rearward bowing configuration with tapering ends by the vertical uprights of the pushcart; (4) a bottom brace featuring visually prominent exposed fasteners with corresponding recesses for the rear ends of the fasteners, "S" shaped sloped shoulders, and a horizontal lower region curved upward at the ends to form an elliptical aperture; and (5) a particular pattern of openings in the toe plate.” <div data-bbox="1068 415 1240 835">  <p>FIG. 1</p> </div>
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	<p>SFD Enters. v. CVS Pharm., Inc. 2012 U.S. Dist. LEXIS 38814 (E.D. Mich. March 22, 2012)</p>
	<p>COURT: “The ‘<u>flex-grip</u>’ consisting of three frown shaped lines <u>could have been designed in an infinite number of ways and still would have served the same purpose.</u>”</p> <p><u>Flex-grip is part of claimed design.</u></p> <div data-bbox="980 1289 1256 1667">  </div>
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B&R Plastics v. Kikkerland

Several Examples of Alternate Ornamental Hinge Designs

- Alternate Ornamental Hinge Design 1: "Square Latch"
- Alternate Ornamental Hinge Design 2: "Square Latch" with Ribs
- Alternate Ornamental Hinge Design 3: "Square Cross" Compartment
- Alternate Ornamental Hinge Design 4: "Ribs" Operating Compartment
- Alternate Ornamental Hinge Design 5: "Channelled Latch" with Surface Texture

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Good Sportsman Marketing LLC v. Li & Fung Ltd., 2010 U.S. Dist. LEXIS 65458 (E.D. Tex. June 29, 2010)

"Defendant identifies four primary components of the claimed design:

- 1) the clip;
- 2) the head lamp, containing the light and battery;
- 3) the on-off switch on the headlamp; and
- 4) the flexible wire.

Defendant argues each component is **primarily functional** and contends they should be wholly **factored out** of the claim."

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Good Sportsman Marketing LLC v. Li & Fung Ltd.,
2010 U.S. Dist. LEXIS 65458 (E.D. Tex. June 29, 2010)





- Components are not purely functional.
- Configuration is not purely functional.







**Good design =
seamless integration of form and function**











Michael Graves tea kettle for Alessi (1985)

	<p>Gorham v. White, 81 U.S. 511 (1871)</p>	
	 <p>Gorham's Patented Design</p>	 <p>White's Accused Design</p>
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	<p>Design Patents Do Not Protect General Ideas or Concepts</p>	
	<p><u>Patented Design</u></p> 	<p><u>Accused Design</u></p> 
	<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>	
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	<h2>Design Patents Do Not Protect General Ideas or Concepts</h2>						
	<table border="0"> <tr> <td data-bbox="592 430 787 457"><u>Patented Design</u></td> <td data-bbox="974 430 1185 457"><u>Accused Design</u></td> </tr> <tr> <td data-bbox="511 525 868 661">  </td> <td data-bbox="909 535 1258 661">  </td> </tr> <tr> <td colspan="2" data-bbox="544 787 1177 829"> <p><u>Albeit Same Idea, No Design Patent Infringement</u></p> </td> </tr> </table> <p data-bbox="1039 924 1209 955">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>	<u>Patented Design</u>	<u>Accused Design</u>			<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>	
<u>Patented Design</u>	<u>Accused Design</u>						
							
<p><u>Albeit Same Idea, No Design Patent Infringement</u></p>							

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	<h2>Claim Construction Functionality</h2>
	<p>Bottom line: Courts should <u>not</u> endeavor to parse out a design into functional/ornamental elements.</p> <ol style="list-style-type: none"> 1. Fails to look at <u>overall design</u> 2. Unworkable 3. Undermines Presumption of Validity 4. Back-door watered down validity attack 5. Question of fact <p data-bbox="1039 1795 1209 1827">© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

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	<h2>Clear Statement of Law Clear Jury Instruction</h2>
	<p>“A design patent only protects the:</p> <p>(1) novel, and</p> <p>(2) ornamental</p> <p>features of the patented design.”</p> <p><u>overall appearance of the design as depicted in the drawings; it does not protect functional qualities or general design concepts.”</u></p> <p>© 2015 Christopher V. Carani ccarani@mcandrews-ip.com</p>

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	<h2>THANK YOU</h2>
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Thank You!



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Christopher V. Carani, Esq. is a partner and shareholder at the intellectual property law firm of McAndrews, Held & Malloy, Ltd. based in Chicago, Illinois. He is a leading voice in the field of design law. Chris counsels clients on a wide range of strategic design protection and enforcement issues, both in the U.S. and abroad. He is often called upon to render infringement, validity and design-around opinions and serve as a legal consultant/expert in design law cases.

Chris is the current chair of AIPPI Committee on Designs. He is immediate past chair of the American Bar Association's Design Rights Committee, and is the past chair of the American Intellectual Property Law Association (AIPLA) Committee on Industrial Designs. In the landmark design patent case *Egyptian Goddess v. Swisa*, he authored *amicus* briefs on behalf of the AIPLA at both the petition and *en banc* stages. In 2009 and 2011-12, he was an invited speaker at the United States Patent & Trademark Office's ("USPTO") Design Day.

Prior to joining McAndrews, Chris served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Chris was conferred his Juris Doctorate from The Law School at The University of Chicago. He also holds a Bachelor of Science in Engineering from Marquette University. He is licensed to practice before the U.S. Supreme Court, the U.S. Federal Circuit Court of Appeals and other U.S. District Courts. He is a registered patent attorney licensed to practice before the USPTO.

He is on the faculty of Northwestern University School of Law as an Adjunct Professor teaching IP Law.

He has published and lectured extensively on design law and is a frequent contributor to CNN on intellectual property law issues. He is also often called upon to provide comment to other media outlets, including New York Times, Wall Street Journal, NPR, PBS TV, CNBC TV, BBC, Bloomberg TV, Reuters, InformationWeek, Fast Company, ComputerWorld, PCWorld, Washington Post, L.A. Times, Chicago Tribune, Forbes, Fortune, and FoxBusiness TV. Away from the law, Chris is a studied jazz musician playing upright bass on the Chicago jazz circuit.



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