It is all around us…
New wave of copying…

U.S. Intellectual Property

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

**Utility Patent**
The way it WORKS....

U.S. Patent No. 7,070,349

**Design Patent**
The way it LOOKS....

U.S. Patent No. D559,842

3 Ways to Protect Appearance

- Design Patent
- Trade Dress
- Copyright
### Each IP Right Has Different Aim
### Striking Different Coverage Balance

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

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

### Each Design IP Right Has Different Aim
### Striking Different Coverage Balance

<table>
<thead>
<tr>
<th>IP Right</th>
<th>Injunctive Relief</th>
<th>Damages</th>
</tr>
</thead>
<tbody>
<tr>
<td>Design Patent</td>
<td>Preliminary Injunction</td>
<td>Reasonable Royalty</td>
</tr>
<tr>
<td></td>
<td>Permanent Injunction</td>
<td>Lost Profits</td>
</tr>
<tr>
<td></td>
<td></td>
<td>Infringer’s Profits</td>
</tr>
<tr>
<td></td>
<td></td>
<td>Statutory Damages</td>
</tr>
<tr>
<td>Copyright</td>
<td>Preliminary Injunction</td>
<td>Lost Profits</td>
</tr>
<tr>
<td></td>
<td>Permanent Injunction</td>
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<td></td>
<td>Permanent Injunction</td>
<td>Infringer’s Profits</td>
</tr>
</tbody>
</table>
U.S. Intellectual Property

1. Patents
   • Utility Patents
   • Design Patents**

2. Trademarks
   • Trade Dress

3. Copyrights

Increasingly A Hot Topic – Public Sector

Government Initiatives
   • 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)
Kappos on Design

“Design: The New Frontier of Intellectual Property”

David Kappos, April 22, 2013

Increasingly A Hot Topic – Academia and Scholarship

- An Investigation of the Processes by Which Product Design and Brand Strength Interact to Determine Initial Affect and Quality Judgments, Journal of Consumer Psychology
- Recent Trends in Community Design: The Eminence of Participation, Design Studies Journal
Increasingly A Hot Topic – Business Sector

Design IP on the rise...

- Applications & Issuance ↑
- Worldwide
  - E.U. ↑
  - Korea ↑
  - China ↑
- Why?
  - Looks Matter – Customers Place Great Emphasis
  - More importance placed on design
  - Insidious reason – Knock-Offs
  - S.Ct. Case Law

U.S. Design Patents Granted

0 5,000 10,000 15,000 20,000 25,000 30,000
Where there is appealing design…
…there is infringement

Blackberry LLC v. Typo Prods. LLC
3:14-cv-23 (N.D. Cal. 2014)
Lululemon v. Calvin Klein
12-cv-001034 (S.D.N.Y. 2013)

Ashley Furniture Inc. v. LG. Interiors Inc. et al
13-cv-001669 (C.D.Cal. 2013)
Nikon v. Sakar Int’l (d/b/a Polaroid)
13-cv-00710 (S.D.N.Y. 2013)

Spanx v. Yummie-Tummie
Gillette Co. v. BK Gifts
13-cv-02241 (N.D. Ohio 2013)

“The Patent Trial of The Century”?

© 2015 Christopher V. Carani
carani@mcandrews-ip.com
Largest Patent Infringement Jury Verdict (Standing)

Verdict: $1,049,343,540.00

Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal 2011)

“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.”

~ Steve Jobs (1955-2011)
January 7, 2007

Set the way back machine…

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.
Apple’s Design Patent Offensive (Filings)

- Apple’s U.S. Design Patent Application Filings

Samsung’s Meteoric Rise

- Global Smartphone Vendor Shipments: Samsung, Apple, Nokia

Source: Strategy Analytics (Oct 2011)
Apple, Inc. v. Samsung Elecs. Co.,
11-cv-1846 (N.D. Cal 2011)

Apple Design Patents-in-Suit

Device Designs

GUI Design
Apple’s Argument in a Nutshell
(Smart Phones)

Road Map

TODAY’S DISCUSSION

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)
Design Patent Infringement

Set the way back machine…
*Gorham v. White (1871)*
U.S. Civil War (1861-65)

The Battle of Fredericksburg of 1862 by N. Currier

The Great Chicago Fire

October 8, 1871

Currier & Ives in 1871
Reconstruction Era (1866-77)

Impressionism (1860’s-1880’s)

Impression, Sunrise by Claude Monet (1871)
Mr. John Gorham
“Purveyor to his Majesty”

Mr. John Gorham
Gorham Manufacturing Co.

Gorham Mfg. Co.’s Cottage Design

Gorham’s Cottage Design
Gorham Mfg. Co.’s Cottage Design

Harper’s New Monthly Magazine:
“The single most successful design of its kind ever achieved...designed in a happy moment...”

U.S. Design Patent No. D1,440
Gorham v. White, 81 U.S. 511 (1871)

White’s Accused Design

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

Gorham’s Patented Design

White’s Accused Design
Gorham v. White, 81 U.S. 511 (1871)

Gorham v. White, 10 F. Cas. 827 (Circuit Ct. S.D. N.Y. 1870)

Gorham’s Patented Design

White’s Accused Design

NO INFRINGEMENT
**Gorham v. White,**
10 F. Cas. 827 (Circuit Ct. S.D. N.Y. 1870)

“The observation [of the **ordinary observer**] is worthless, because it is **casual, heedless** and **unintelligent**…”

“[The] **test** can only be . . . the observation of a **person versed in designs in the particular trade in question**”

**LOWER COURT HOLDING: NO INFRINGEMENT**

---

**Take Away #1**
**Confirms Merit of Design Protection**

“The acts of Congress which authorize the grant of patents for designs were plainly intended to given encouragement to the decorative arts.

* * *

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.”
Take Away #2
Ordinary Observer Test

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.”

Take Away #3
Substantial Identity

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

Hypothetical Prior Art

Gorham’s Patented Design

White’s Accused Design

INFRINGEMENT
Re-Articulation of Infringement Test

In the Eye of an Ordinary Observer:

1. “Is the overall appearance of the patented design
2. substantially the same as
3. the overall appearance of the accused design
4. in view of the prior art?”*


Design Patents Do Not Protect General Ideas or Concepts

Albeit Same Idea, No Design Patent Infringement
Design Patents Do Not Protect General Ideas or Concepts

Patented Design

Accused Design

Albeit Same Idea, No Design Patent Infringement

Query…

“the controlling consideration visual impression upon the eye”
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
<table>
<thead>
<tr>
<th>Design Patents Protect</th>
</tr>
</thead>
<tbody>
<tr>
<td>Overall appearance of an article of manufacture</td>
</tr>
<tr>
<td>• Shape</td>
</tr>
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</table>

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<tbody>
<tr>
<td>Overall appearance of an article of manufacture</td>
</tr>
<tr>
<td>• Shape</td>
</tr>
<tr>
<td>• Surface ornamentation/treatment</td>
</tr>
</tbody>
</table>
### Design Patents Protect

Overall appearance of an article of manufacture

- **Shape**
- **Surface ornamentation/treatment**
- **Color**
- **Combination**
Design Patent Requirements

To qualify for a design patent, the design must be:

- Novel (§ 102)
- Non-obvious (§ 103)
- Ornamental (§ 171)

5 WAYS TO INCREASE SCOPE VALUE OF U.S. DESIGN PATENTS

1. Dotted Lines
2. Indeterminate Break Lines
3. Multiple Embodiments
4. Multiple Applications
5. Continuation Practice
1. Broken Lines ("Dotted Lines")

FUNDAMENTAL RULE

"Solid lines" are part of claim

"Dotted lines" are NOT part of claim.
Dotted Line Practice

Microsoft Webcam, US Patent D647,937

Adding Scope, Adding Value – Dotted Line Practice

Disclaim design of legs
Blackberry LLC v. Typo Prods. LLC
3:14-cv-23 (N.D. Cal. 2014)

D685,775

Seacrest out!

Judge Orrick: P.I. Granted

2. INDETERMINATE
BREAK LINES
SPEC: “The ends of the dental toothpaste strip are shown broken away and indicate an indeterminate length.”
3. MULTIPLE EMBODIMENTS
Adding Scope, Adding Value – Multiple Embodiments

One Application, One Claim – But Two Embodiments

First Embodiment

Second Embodiment

Multiple Embodiments (form-based)

First Embodiment

Third Embodiment

Fifth Embodiment

Second Embodiment

Fourth Embodiment

Sixth Embodiment
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
Apple Inc. v. Samsung Electronics
11-cv-01846 (C.D. Cal)

“One falls, they all fall…”

Pacific Coast Marine v. Malibu
12-CV-0033 (Fed. Cir. 2014)
**Pacific Coast Marine v. Malibu**  
12-CV-0033 (Fed. Cir. 2014)

- Embodiment 1
- Embodiment 2

Restriction Requirement

**Pacific Coast Marine v. Malibu**  
12-CV-0033 (Fed. Cir. 2014)

- elected
- non-elected
Pacific Coast Marine v. Malibu
12-CV-0033 (Fed. Cir. 2014)

NON-INFRINGEMENT

Embodiment 1

Embodiment 2
Pacific Coast Marine v. Malibu
12-CV-0033 (Fed. Cir. 2014)

Embodiment 1

Embodiment 2

surrendered

Non-infringement
4. MULTIPLE APPLICATIONS

Multiple Applications – Maximize Coverage

Des. D647,946
“SUPPORT FOR ELECTRONIC CAMERA”

Des. D647,933
“ELECTRONIC CAMERA”
Multiple Applications – Maximize Coverage

[Diagram of multiple applications]

Multiple Applications – Maximize Coverage

[Diagram of multiple applications]
5. Continuation Practice

Multiple Applications – Maximize Coverage

D548,744  
(whole device)

D562,847  
(no screen, click wheel)

D573,223  
(screen, no click wheel)
Prevalence of Continuations and Divisionals

Last 5 years

- 596 issued U.S. design patents to Apple
- 289 of which are either divisional, continuation or continuation-in-part
- **48%** of its issued U.S. design patents during period are either divisional, continuation or continuation-in-part

Last 5 years

- 1083 issued U.S. design patents to P&G
- 329 of which are either divisional, continuation or continuation-in-part
- **30%** of its issued U.S. design patents during period are either divisional, continuation or continuation-in-part

Daisy Chain Applications
“Forever Young”

- Issuance D548,744
- Filing 05/08/07
- Abandoned
- Filing 08/10/11
- Issuance D650,355

- Issuance D573,606
- Filing 2/13/09
- Issuance D656,159
- Filing 08/24/05
- Issuance D548,744
- Filing 3/23/07

Etc.
GUI, Icons, Animations

Internet of Things
GUI, Icons and Animations
Internet of Things

Side-by-side, ‘305 and Samsung Smart Phones

US D604,305
Samsung GUI
Apple’s Design Patents-in-Suit
Graphic User Interfaces

D613,334  D627,790  D604,305

Samsung GUI

Graphic User Interfaces

D599,372
Nooka Watch Interfaces

D697,074; D697,075
Issued: January 7, 2014
**D698,816**

Filed: May 15, 2013*; Issued: February 4, 2014

*claims priority to D681,663

**D660,864**

**Graphical User Interface**
Dynamic, Black & White
"The appearance of the image transitions sequentially between the images shown in Figs. 1-2. The process or period in which a image transitions to another forms no part of the claimed design"
Color Icon Animation

FIG. 1

Color Icon Animation

FIG. 2
Color Icon Animation

FIG. 3

Color Icon Animation

FIG. 4
Color Icon Animation

FIG. 7

Color Icon Animation

FIG. 8
Color Icon Animation

FIG. 9

Color Icon Animation

FIG. 10
Color Icon Animation

FIG. 11

Color Icon Animation

FIG. 12
Color Icon Animation

FIG. 13

Color Icon Animation

FIG. 14
Color Icon Animation

FIG. 15

Color Icon Animation

FIG. 16
Color Icon Animation

FIG. 17

Color Icon Animation

FIG. 18
Color Icon Animation

FIG. 19

Color Icon Animation

FIG. 20
Color Icon Animation

FIG. 20

Global Design Prosecution Strategy…
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

Novelty Grace Periods

<table>
<thead>
<tr>
<th>Countries/Treaty</th>
<th>Grace Period</th>
</tr>
</thead>
<tbody>
<tr>
<td>Argentina</td>
<td>None</td>
</tr>
<tr>
<td>Australia</td>
<td>None</td>
</tr>
<tr>
<td>Brazil</td>
<td>6 mos.</td>
</tr>
<tr>
<td>Canada</td>
<td>12 mos.</td>
</tr>
<tr>
<td>China</td>
<td>None</td>
</tr>
<tr>
<td>India</td>
<td>None</td>
</tr>
<tr>
<td>Japan</td>
<td>6 mos.</td>
</tr>
<tr>
<td>Kenya</td>
<td>6 mos.</td>
</tr>
<tr>
<td>Korea</td>
<td>6 mos.</td>
</tr>
<tr>
<td>Mexico</td>
<td>12 mos.</td>
</tr>
<tr>
<td>Russia</td>
<td>6 mos.</td>
</tr>
<tr>
<td>South Africa</td>
<td>6 mos.</td>
</tr>
<tr>
<td>Thailand</td>
<td>None</td>
</tr>
<tr>
<td>Turkey</td>
<td>12 mos.</td>
</tr>
<tr>
<td>United States</td>
<td>12 mos.</td>
</tr>
<tr>
<td>European RCD</td>
<td>12 mos.</td>
</tr>
</tbody>
</table>
Hague Agreement

Provisional Rights
35 U.S.C. § 154(d)(3)

avg. = 12-14 months

IMPUNITY

Filing
Issuance

EXPOSURE

OLD
Provisional Rights
35 U.S.C. § 154(d)(3)

 avg. = 1 month*

reasonable
royalty

EXPOSURE

Filing    Publication    Issuance

NEW

* with request for expedited publication

Design Patent
Claim Construction

Eye Test: What do you see?
Eye of an Ordinary Observer

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

Basic Layout of a Design Patent

- Title
- Claim
- Specification
The figures are the claim. “Property Line”

Lines of delineation

solid line (claimed)

dashed line (unclaimed)
Dotted Line Practice

Disclaim design of legs

Blackberry LLC v. Typo Prods. LLC

HOLDING: Preliminary Injunction Granted

Patented Design

Accused Design

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 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 area 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.

Fig. 1, Perspective View

Fig. 7, Bottom View

Blue prints or worse…
Clarifying or Conflating?

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

Fig. 1, Perspective View

Fig. 7, Bottom View

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”
**General Rule:**

Verbalizations Should Not Be Attempted

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

**Claim Construction:**

"In light of the Federal Circuit's decision in *Egyptian Goddess*, it is unnecessary to construe the Patent No. 513,715 (the "715 Patent") by providing a detailed verbal description of the claimed design. Rather, the Court will rely upon the illustrations set out in the '715 Patent, as they better represent the claimed design."

**Claim Construction:**

“Accordingly, the Court declines to draft a verbal description of the claimed design and elects to rely upon the ‘954 patent and its illustrations.”

![Fig. 1](image)

---


**Claim Construction:**

“In accordance with *Egyptian Goddess*, 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.”

![Fig. 2](image)
**OddzOn Prods. v. Just Toys,** 122 F.3d 1396, 1405 (Fed. Cir. 1997) (J. Lourie)

“A design patent **only protects** the:

1. novel, and
2. ornamental **features** of the patented design.”

---

**Novelty can Reside in Combination of OLD features**

Proper Statement of Law

“A design patent only protects the:

(1) novel, and—

(2) ornamental—

features of the patented design.”

overall appearance of the design as depicted in the drawings; it does not protect functional qualities or general design concepts.”

Design Patent Defenses

• Anticipation
• Obviousness
• Indefiniteness
• Prosecution History Estoppel
• Lack of Ornamentality ("Functionality")
Design Anticipation “Standard 1”

*Hupp v. Siroflex, 122 F. 3d 1456, 1461 (Fed. Cir. 1997)*

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.**”

Design Anticipation “Standard 2”

*Int’l Seaway v. Walgreens, 589 F.3d 1233, 1240 (Fed. Cir. 2009):*

“[T]he same test must be used for both infringement and anticipation…” (citing *Peters v. Active Mfg.*)

* * *

Thus, “the ordinary observer test is the sole test for design patent invalidity under § 102.”*

*No mention of *Hupp* anticipation standard or prior Federal Circuit precedent*
Discord on Anticipation Standard

Standard 1: “Identical in Material Respects”

= 

Standard 2: “Substantially the Same”?

“Substantial Similarity” vs. “Identical in All Material Respects”

<table>
<thead>
<tr>
<th>Prior Art Design</th>
<th>Patented Design</th>
</tr>
</thead>
<tbody>
<tr>
<td>![Prior Art Design Image]</td>
<td>![Patented Design Image]</td>
</tr>
</tbody>
</table>
In re Rosen
673 F.2d 388 (C.C.P.A. 1982)

Design Patent Obviousness
“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.”

Degrees of Identity

“Basically the same”
(Obviousness)

“Substantially the same”
(Infringement)

“Identical in All Material respects”
(Anticipation)
In re Rosen
673 F.2d 388 (CCPA 1982)

Prior Art

Design Patent

Reference 1
Reference 2
Reference 3

Reference 1
Reference 2
Obviousness Framework:
**In re Rosen and the “Primary Reference” Requirement**

<table>
<thead>
<tr>
<th>Prior Art References</th>
<th>Claimed Design</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.png" alt="Prior Art 1" /></td>
<td><img src="image2.png" alt="Claimed Design 1" /></td>
</tr>
<tr>
<td><img src="image3.png" alt="Prior Art 2" /></td>
<td><img src="image4.png" alt="Claimed Design 2" /></td>
</tr>
<tr>
<td><img src="image5.png" alt="Prior Art 3" /></td>
<td><img src="image6.png" alt="Claimed Design 3" /></td>
</tr>
</tbody>
</table>

Is there a primary reference that is “basically the same”??

**ANSWER: NO**

---

**In re Rosen Reference?**

**Durling v. Spectrum Furniture (Fed. Cir. 1996):**

<table>
<thead>
<tr>
<th>Claimed Design</th>
<th>Prior Art</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image7.png" alt="Claimed Design 4" /></td>
<td><img src="image8.png" alt="Prior Art 5" /></td>
</tr>
</tbody>
</table>

Is prior art reference “basically the same”?

**ANSWER: NO**
In re Rosen Reference?

In re Vanguard (BPAI 2010):

Prior Art

Claimed Design

Is a single prior art reference "basically the same"?

ANSWER: NO

Apple Inc. v. Samsung Electronics
678 F.3d 1314, 1330 (Fed. Cir. 2012)

Prior Art Combination


US D504,889

Is there a primary reference?

ANSWER: NO
**In re Rosen Reference?**


<table>
<thead>
<tr>
<th>Prior Art</th>
<th>Claimed Design</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.png" alt="Prior Art Image" /></td>
<td><img src="image2.png" alt="Claimed Design Image" /></td>
</tr>
</tbody>
</table>

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

**ANSWER: YES**

---

**MRC Innovations, Inc. v. Hunter Mfg., LLP,**


<table>
<thead>
<tr>
<th>Prior Art</th>
<th>Patent</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image3.png" alt="Prior Art Image" /></td>
<td><img src="image4.png" alt="Patent Image" /></td>
</tr>
</tbody>
</table>

**Differences**
- V-Neck
- Mesh
- Surge Stitching (back)
Is a single prior art reference “basically the same”?

**ANSWER: YES**

---

**An Approach to Obviousness**

Focus on **delta** between prior art and patented design

Is the **difference** obvious to **DOSITA**?
**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
**MRC Innovations, Inc. v. Hunter Mfg., LLP,**

<table>
<thead>
<tr>
<th>Prior Art</th>
<th>Patent</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1" alt="Primary Prior Art" /></td>
<td><img src="image2" alt="Primary Patent" /></td>
</tr>
<tr>
<td><img src="image3" alt="Secondary Prior Art" /></td>
<td><img src="image4" alt="Secondary Patent" /></td>
</tr>
</tbody>
</table>

**FED.CIR.: OBVIOUS**

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**An Approach to Obviousness**
Focus on **delta** between prior art and patented design

![Diagram of prior art and patent with delta](image5)

**primary reference**

**secondary reference**
An Approach to Obviousness
Focus on delta between prior art and patented design

Is the difference obvious to DOSITA?

prior art

primary reference

secondary reference

patent

“Ordinary Designer” or “Ordinary Observer”

Would the design have been “obvious to a designer of ordinary skill who designs articles of the type involved”?

_Durling v. Spectrum Furniture_ (Fed. Cir. 1996)

“Obviousness … requires courts to consider the perspective of the ordinary observer.”

_Int’l Seaway v. Walgreens Corp._ (Fed. Cir. 2009)

“Obviousness is assessed from the vantage point of an ordinary designer in the art…”

_High Point Design v. Buyers Direct_ (Fed. Cir. 2013)
Indefiniteness
35 U.S.C § 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
"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."

"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."
"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."

---

"Due to drawing inconsistencies, summary judgment of INVALIDITY is GRANTED."

**PATENT INVALID**
Indefiniteness (35 U.S.C § 112)
Design Patent Functionality

Design Patent Functionality: A Sensible Solution,
Christopher V. Carani, ABA’s Landslide®,

Design Patents

FAQ: Is it functional?
Design Patents

FAQ: Is it functional?
A: Yes. But so what?!

“Functionality” Boogie Man
"Functionality" Boogie Man

BUST THE MYTH.
35 U.S.C. § 171

35 U.S.C. § 171, Design Patents
“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.”

35 U.S.C. § 171 (Design Patents)
35 U.S.C. § 101 (Utility Patents)

35 U.S.C. § 171, Design Patents
“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.”

35 U.S.C. § 101, Utility Patents
“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.”
Two Separate “Functionality” Issues

**Issue 1: Statutory Compliance**
“Functionality” of Overall Claimed Design

**Issue 2: Claim Construction**
“Functionality” of Aspects of the Overall Claimed Design

**Issue 1: Statutory Compliance**
35 U.S.C § 171
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.”


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. Ilco Unican Corp. (Fed.Cir. 1997)
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.”
Richardson v. Stanley Works, Inc.,
597 F.3d 1288 (Fed. Cir. 2010)

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

High Point Design LLC v. Buyers Direct, Inc.,
730 F.3d 1301 (Fed. 2014)

Question: Is Appearance of Overall Claimed Design Dictated by Function Alone? **No.**
Design is “ORNAMENTAL.”
**Issue 2: Claim Construction**

“Functional Aspects”
Issue 2: Claim Construction - Functionality

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

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) \(\text{en banc}\)

Design Patent Claim Construction
“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 rounded cutout appears 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.”
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”

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

General rule:
• Overall Appearance
• No verbalization of the drawings
• Drawings speak for themselves
**Lee v. Dayton-Hudson Corp.**
838 F.2d 1186 (Fed. Cir. 1988).

Court: “Design patents do not and cannot include claims to the structural or **functional aspects** of the article.”

“Functional aspects” refers to functional attributes, purposes or characteristic, **not visual features**, elements or portions of the overall claimed design.

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**Elmer v. ICC Fabricating, Inc.,**
67 F. 3d 1571 (Fed. Cir. 1995)

**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**.
**But see, Oddzon Prods., Inc., v. Just Toys, Inc.**
122 F. 3d 1396 (Fed. Cir. 1997) (J. Lourie)

**Holding:** Tail and fins are functional aspects of the design and are thus **not part of claimed design.**

---

**OddzOn Prods. v. Just Toys,**
122 F.3d 1396, 1405 (Fed. Cir. 1997) (J. Lourie)

“A design patent **only protects** the:

1. novel, and
2. ornamental **features** of the patented design.”
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
“Divide and Conquer”?

Claim Construction

“Discount,” “Ignore,” “Factor out,” these features

hammer-head

jaw

crow-bar

handle
“Divide and Conquer”? 

1 hammer-head
2 jaw
3 handle
4 crow-bar

“Divide and Conquer”? 

1 hammer-head
2 jaw
3 handle
4 crow-bar
“Divide and Conquer”?  

1. hammer-head  
2. jaw  
3. handle  
4. crow-bar

Claim Construction = Claim Destruction
Examples of Claim Construction- “Functionality” (Issue 2)

Great Neck Saw Mfg. v. Star Asia U.S.A. LLC,

COURT: “Given its functional nature […], the blade lock means is not entitled to design protection.”
**Safco Prods Co. v. Welcom Prods.**  
08-4918 (D. Minn. July 1, 2011) (Claim Construction Order)

"The figures of the '708 patent disclose, based on this Court's independent assessment, several ornamental features of the pushcart, from top to bottom are:

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."

**SFD Enters. v. CVS Pharm., Inc.**  

**COURT:** "The ‘flex-grip’ consisting of three frown shaped lines could have been designed in an infinite number of ways and still would have served the same purpose.”

**Flex-grip is part of claimed design.**
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.
Good design = seamless integration of form and function

Michael Graves tea kettle for Alessi (1985)
**Gorham v. White, 81 U.S. 511 (1871)**

- Gorham’s Patented Design
- White’s Accused Design

**Design Patents Do Not Protect General Ideas or Concepts**

- Patented Design
- Accused Design

Albeit Same Idea, No Design Patent Infringement
Design Patents Do Not Protect General Ideas or Concepts

Patented Design

Accused Design

Albeit Same Idea, No Design Patent Infringement

Claim Construction Functionality

Bottom line: Courts should not endeavor to parse out a design into functional/ornamental elements.

1. Fails to look at overall design
2. Unworkable
3. Undermines Presumption of Validity
4. Back-door watered down validity attack
5. Question of fact
Clear Statement of Law
Clear Jury Instruction

“A design patent only protects the:

(1) novel, and—

(2) ornamental—

features of the patented design.”

overall appearance of the design as depicted in the drawings; it does not protect functional qualities or general design concepts.”

THANK YOU
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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