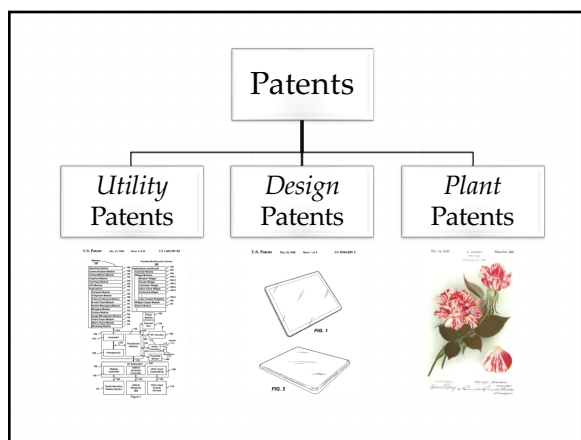




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2

Like utility patents

- ◇ Granted by the USPTO following substantive examination.
 - ◆ Must be novel & nonobvious (different tests)
- ◇ Patent bar required to prosecute for others.*
 - ◆ But examiners have art/design backgrounds.
- ◇ All appeals go to the Federal Circuit.
- ◇ No “use in commerce” requirement for validity or enforcement.

3

Unlike utility patents

- ◇ Term = 14-15 years
 - ◆ Begins at the date of issuance
- ◇ Can’t claim priority to provisional apps.
- ◇ No maintenance fees
- ◇ Drawings are key
- ◇ Only one claim per patent
- ◇ Special remedy provision

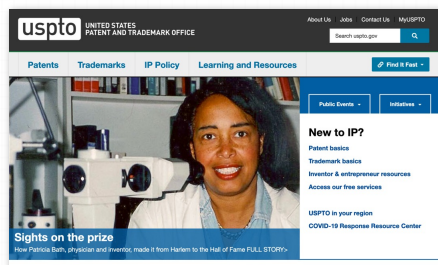
4

Acquisition

How do you get a design patent?

5

Where?

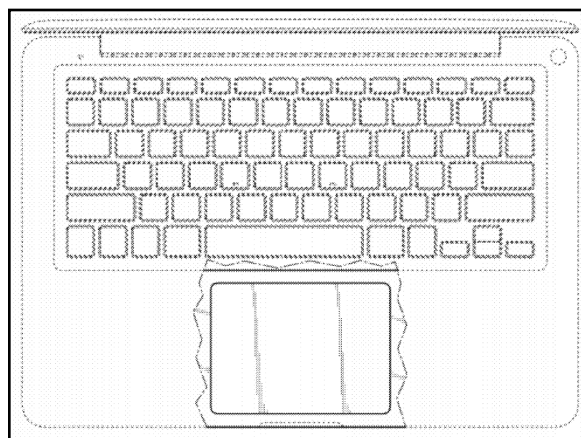


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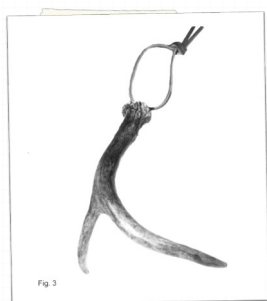
How?



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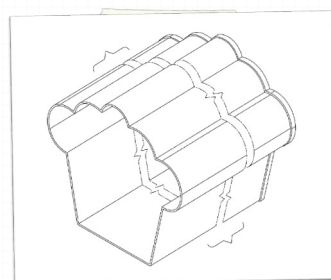


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D702,150 – “Ornament”
(filed Mar. 9, 2012)

9



D711,198 – “Fruit Cutter”
(filed June 27, 2012)

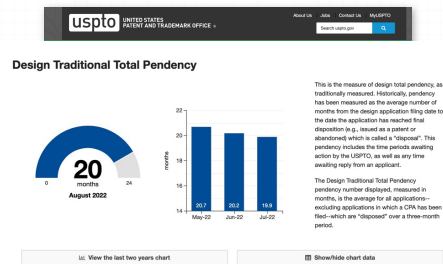
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D604,305 – “Graphical User Interface for a Display Screen or Portion Thereof”
(filed June 23, 2007)

11

How long?



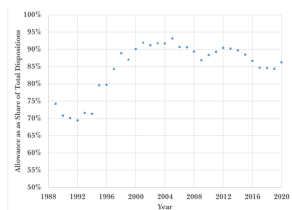
<https://www.uspto.gov/dashboard/patents/design.html>

12

Is it very difficult?

2022] THE TRUTH ABOUT DESIGN PATENTS 1267

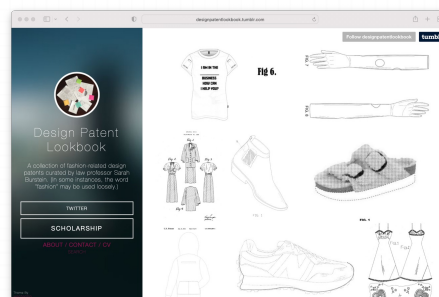
Figure 3: Allowance of Design Applications as a Share of Total Dispositions (1989–2020)



https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

13

Even for fashion?



<https://designpatentlookbook.tumblr.com>

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GENERAL REGISTRATION INFORMATION

I. RECOGNITION OF ATTORNEYS AND AGENTS

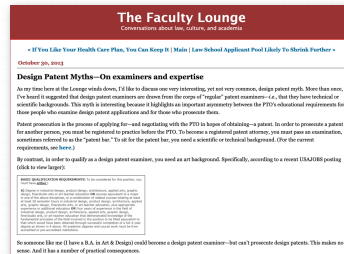
The regulations governing the recognition of individuals to practice before the United States Patent and Trademark Office (USPTO or Office) in patent cases are set forth in 37 CFR §§ 11.5 (Register of attorneys and agents in patent matters), 11.6 (Registration of attorneys and agents), 11.7 (Requirements for registration), 11.8 (Oath and registration fee), 11.9 (Limited recognition in patent matters), and 11.16 (Law School Clinic Certification Program).

The USPTO Director is given statutory authority to require a showing by patent practitioners that they are "possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the [USPTO]." 35 U.S.C. § 2(b)(2)(D). The primary responsibility for protection of the public from unqualified practitioners before the USPTO rests with the Director of the USPTO.

<https://www.uspto.gov/sites/default/files/documents/OED-GRB.pdf>

15

Does that make sense?



<https://www.thefacultyloounge.org/2013/10/design-patent-examiners.html>

16

Is a change coming?

Director Vidal said the USPTO is "considering the creation of a design patent bar that wouldn't feature [an] engineering- and science-heavy background ... along with rethinking what types of backgrounds are actually needed to provide 'competent representation' at the PTAB."

Law360 (Sept. 19, 2022),
<https://www.law360.com/ip/articles/1506849>

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Requirements

What kinds of designs are patentable?

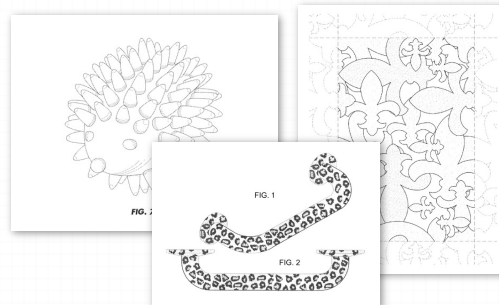
18

35 U.S.C. § 171(a)

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.

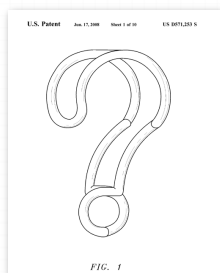
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“Design for an article of manufacture”



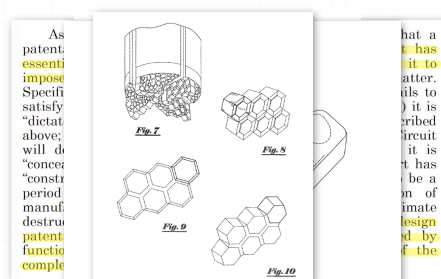
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“New” & “Original”



21

“Ornamental”



22

35 U.S.C. § 102(a)(1)

Novelty; Prior Art. — A person shall be entitled to a patent unless —

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention

23

35 U.S.C. § 103

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

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Are these high bars?

"For the period of 2008 to 2020, district courts making validity determinations about design patents **upheld them 88.4% of the time**—and only 11.6% of these determinations resulted in a patent being invalidated."

- Burstein & Vishnubhakat (2022)

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

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Why?



26

Int'l Seaway Trading v. Walgreens (Fed. Cir. 2009)

"In light of Supreme Court precedent and our precedent holding that the same tests must be applied to infringement and anticipation, and our holding in *Egyptian Goddess* that the ordinary observer test is the sole test for infringement, we now conclude that **the ordinary observer test must logically be the sole test for anticipation** as well."

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

1. First, "one must find a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design.' *In re Rosen*."
2. "[O]ther references may be used to modify it" only if they are "so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other"

28

Enforcement

When, where, and how?

29

35 U.S.C. § 173

Patents for designs shall be granted for the term of 15 years from the date of grant.

30

U.S. Const. am. VII

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

31

Egyptian Goddess (Fed. Cir. 2008) (en banc)

Infringement occurs when “an **ordinary observer**, taking into account the prior art, would believe the accused design to *be the same* as the patented design.”

32

Egyptian Goddess (Fed. Cir. 2008) (en banc) (cont'd)

- ◇ “In some instances, the claimed design and the accused design will be *sufficiently distinct* that it will be clear ... that the patentee has not met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer”
- ◇ “[W]hen the claimed and accused designs are *not plainly dissimilar*, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art”

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An example



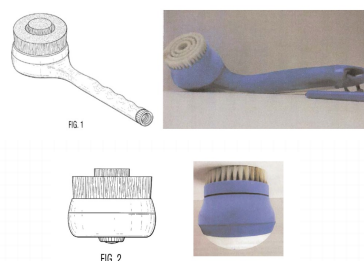
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Caffeinate Labs v. Vante (D. Mass. Dec. 7, 2016)



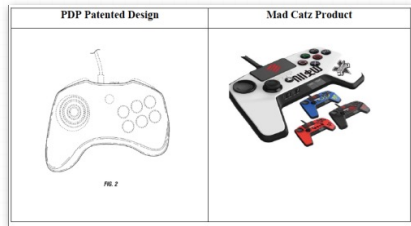
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Wallace v. IdeaVillage Prods. (Fed. Cir. 2016) (nonprecedential)



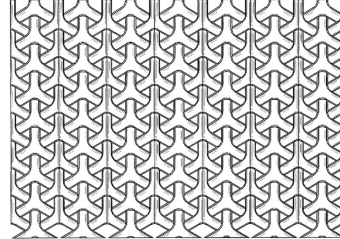
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Performance Designed Prods. v. Mad Catz
(S.D. Cal. 2016)



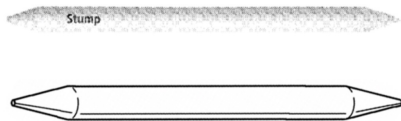
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Curver Luxembourg
(Fed. Cir. 2019)



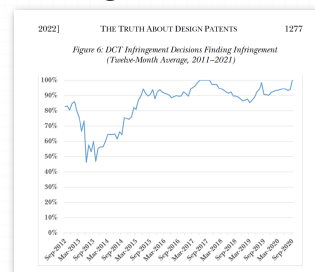
38

In re SurgiSil
(Fed. Cir. 2021)



39

Litigation results



https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4001099

40

35 U.S.C. § 289

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied **shall be liable to the owner to the extent of his total profit, but not less than \$250**

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Other remedies

- ◇ Injunctions (if “in accordance with the principles of equity”);
- ◇ Damages (“not less than a reasonable royalty”);
- ◇ Exclusion orders (USITC)
- ◇ No CBP enforcement (yet?)
<https://patentlyo.com/patent/2020/01/against-design-seizure.html>

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Thank you



SUFFOLK UNIVERSITY
LAW SCHOOL

Sarah Burstein
Professor of Law,
Co-Director, Suffolk IP Law Center
[@design_law](https://twitter.com/design_law)