



DESIGN PATENTS

Invent Vermont
March 13, 2008

Larry Meier
Jim Ferguson

Design Patents

- What is a design patent?
 - Standards for patentability
- Examples
- Some basic differences with utility patents
 - Term & Prosecution
 - Cost & Damages
- Overlap with Copyright and Trademark/Trade Dress
- Related Statutes

What is a design patent?

History of design patents

- First design patent statute enacted in 1842
- Early versions of statute referred to “useful” designs
- In 1902, this was replaced with the word “ornamental”
- 1952 Patent Act: 35 U.S.C. §171
- 1982 Patent Fee Act: abolished choice of issue period for design patents

What is a design patent?

Purpose

“... encouragement to the decorative arts”

Compare this with the U.S. Constitution Patent Clause (Article I Section 8 Clause 8)

“to promote the progress of science and the useful arts”

“Design”

“In a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and not the article itself.

USPTO MPEP §1502

Requirements

- Novelty
- Reduction to practice
- Nonobviousness
- Ornamental
- Not dictated by functional considerations – no utility requirement

Novelty

- All of the 35 USC §102 novelty and statutory bars for obtaining a utility patent apply to design patents
 - E.g. on sale, public use
- “Ordinary observer” novelty standard requires a degree of difference noticeable to the ordinary observer
- Experimental use exception to public use bar... theoretically applies, but be careful!

Reduction to Practice

- Actual reduction to practice
 - 3-D designs are not reduced to practice by production of 2D drawings, but require production of the article embodying the design (*Fitzgerald v. Arbib*, 268 F.2d 763, 1959)

Nonobviousness

- Comparable requirement to utility patents
- Difficult to apply in designs because of inherently subjective nature of the inquiry – USPTO doesn't dig deep
- Graham v John Deere test
 - Ascertain scope and content of prior art
 - Differences between prior art and claim at issue
 - Level of ordinary skill in the art
- Secondary indicators
 - Commercial success
 - Long-felt need
 - Failure of others

Ornamental

Ornamentation cannot be hidden during use.

(e.g. ornamentation of septic tank)

C&M Fiberglass Septic Tanks Inc. v. T&N Fiberglass Mfg. Co., 214
USPQ 159 (D. S.C. 1981)

Can not be a “mere byproduct” of functional or mechanical
considerations.

(e.g. blank key blade)

Best Lock Corp. v. Ilco Unican Corp., 896 F.Supp 836,
(S.D. Ind. 1995)



Example

Zippo™ Lighter

(12) **United States Design Patent** (10) Patent No.: **US D506,572 S**
Tufts, Jr. et al. (45) Date of Patent: **Jun. 21, 2005**

(54) **SOLE PATTERN FOR LIGHTER** 3,854,002 A * 001998 Frankel 431,053
 4,351,308 A * 91082 Ojima et al. 431,077
 1,429,371 S * 8/2000 Maata D270141

(75) Inventors: **Lindsay Tufts, Jr.**, Eschel, OH (US);
Craig Saunders, Rocky River, OH
 (US)

* cited by examiner

(73) Assignee: **Zipps Manufacturing Company**,
 Bedford, PA (US)

Primary Examiner—Jennifer Rivard
 (74) Attorney Agent, or Firm—Fugate & Benson LLP

(**) Term: 14 Years

(57) **CLAIM**

(21) Appl. No.: 29/2004817

We claim the ornamental design for a hole pattern for lighter,
 as shown and described.

(22) Filed: Mar. 4, 2004

DESCRIPTION

(51) **LOC (8) CL.** 27-05

(52) **U.S. CL.** D27/141

(58) **Field of Search** D27/141-181;
 431/126, 129, 153, 283, 284, 285, 273,
 276-277

FIG. 1 is a perspective view of a hole pattern for lighter,
 FIG. 2 is an enlarged view thereof,
 FIG. 3 is a front elevation view of FIG. 1; and,
 FIG. 4 is a rear elevation view of FIG. 1.

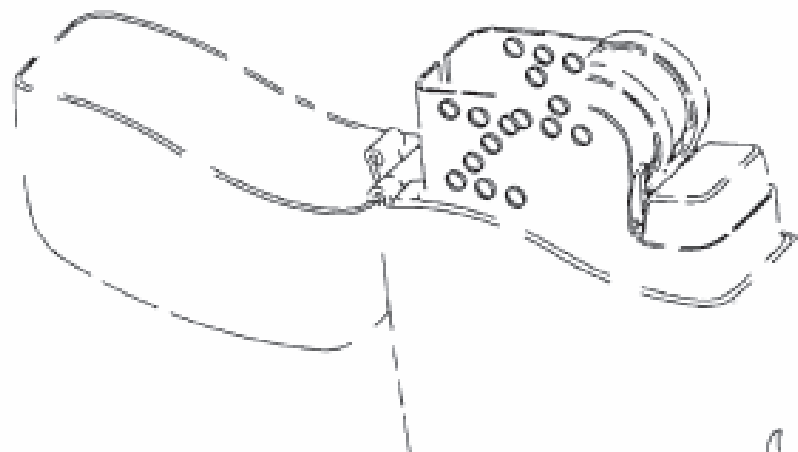
The broken line disclosure of a lighter is shown for illustrative purposes only and forms no part of the claimed design.

(50) **References Cited**

U.S. PATENT DOCUMENTS

2,847,843 A * 8/1958 Greenbaum et al. 431,078

1 Claim, 4 Drawing Sheets



Statute vs. Regulation

- 35 USC §171 “ornamental”
- 37 CFR §1502 “visual characteristics”

It is an unanswered question how a court might treat the patentability of a design that involves texture, smell, or sound

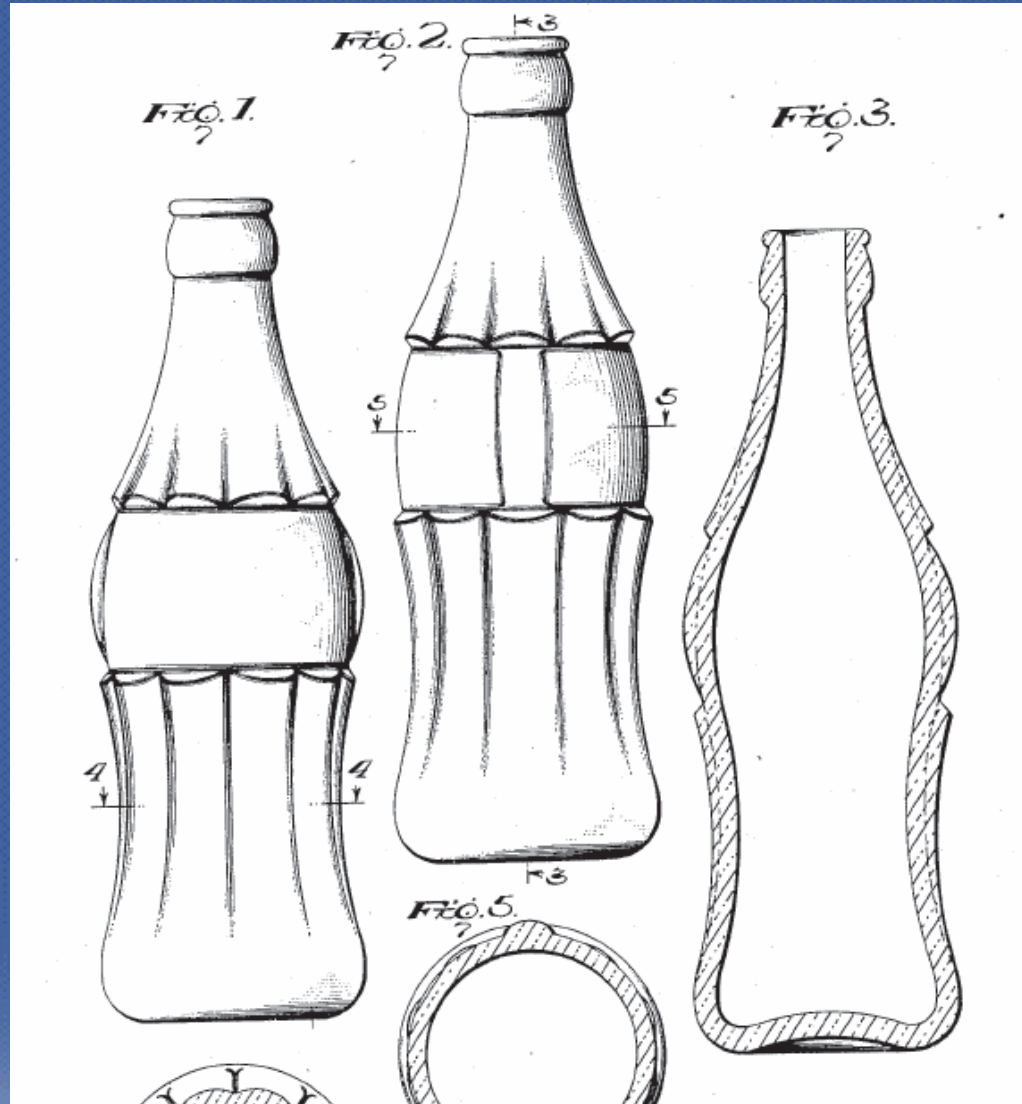
Patentable Subject Matter

- USPTO refused to allow design patents on computer icon designs, in a series of cases that traces its roots to a 1916 case (*in re Cady*) involving the design of “Peter Rabbit” to be applied to a variety of articles.
- Finally, in 1996, the USPTO adopted guidelines that allowed computer icons to be recognized as “articles of manufacture” as embodied on a “computer screen, monitor, or other display panel”.



Some Examples

Examples



United States Patent Office

Des. 187,345
Patented Mar. 1, 1960

187,345

BOTTLE OR SIMILAR ARTICLE

Brooks D. Fuerst, Sylvania, Ohio, assignor to The Squirt Company, Sherman Oaks, Calif., a corporation of California

Application February 24, 1958, Serial No. 49,761

Term of patent 14 years

(Cl. D58-8)



Fig. 1



Fig. 2

United States Patent [19]

Kornick et al.

US00D356501S

[11] **Patent Number: Des. 356,501**

[45] **Date of Patent: ** Mar. 21, 1995**

[54] **CAN BODY**

[75] **Inventors: Joseph M. Kornick; Tirso Olivares,**
both of Chicago, Ill.

[73] **Assignee: The Coca-Cola Company, Atlanta,**
Ga.

[**] **Term: 14 Years**

[21] **Appl. No.: 888,574**

[22] **Filed: May 26, 1992**

[52] **U.S. Cl. D9/518**

[58] **Field of Search D9/518, 506, 500, 503,**
D9/504, 438, 552, 565, 556; 215/1 R, 1 C;
220/906, 907

[56] **References Cited**

U.S. PATENT DOCUMENTS

D. 63,657 12/1923 Root D9/538
D. 105,529 8/1937 Kelly D9/539
D. 224,641 8/1972 Mascia et al. .

D. 227,874 7/1973 Stanley et al. .
D. 289,736 5/1987 Bowers, Jr. .
D. 310,025 8/1990 Foley .
D. 318,225 7/1991 Cassai et al. D9/518
D. 320,153 9/1991 Cassai et al. D9/518
D. 327,218 6/1992 Nickerson D9/518
D. 329,593 9/1992 Otsuka D9/518
3,871,541 3/1975 Adomaitis 215/1 C

Primary Examiner—B. J. Bullock
Assistant Examiner—Cheri Cohen
Attorney, Agent, or Firm—Lynne R. O'Brien

[57] **CLAIM**

The ornamental design for a can body, as shown.

DESCRIPTION

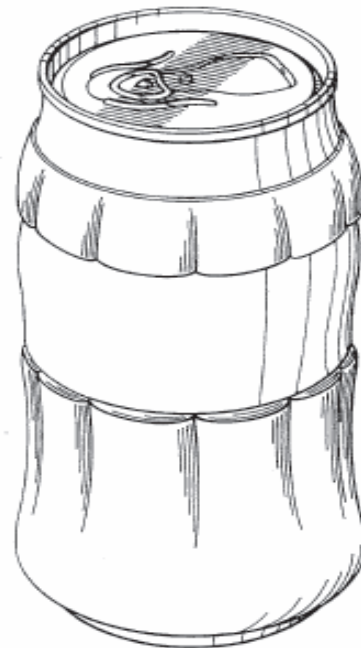
FIG. 1 is a perspective view of a can body showing our new design;

FIG. 2 is a front elevational view thereof;

FIG. 3 is a side elevational view thereof;

FIG. 4 is a bottom plan view thereof; and,

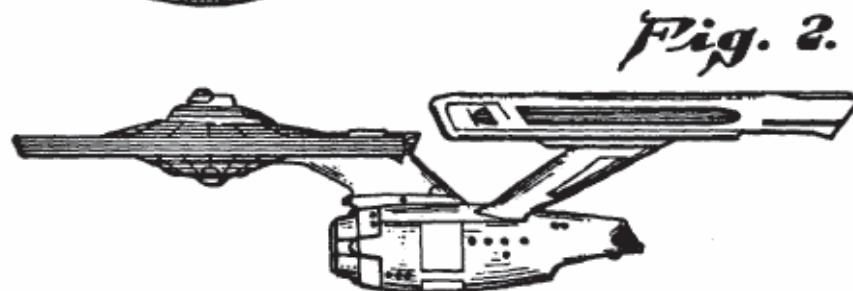
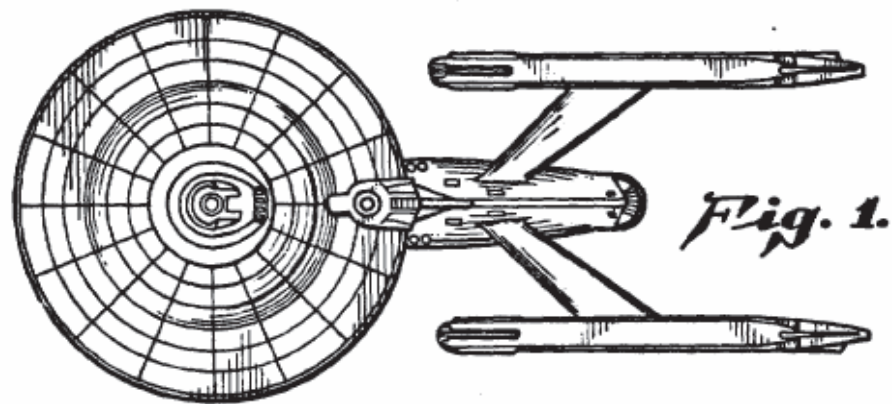
FIG. 5 is a top plan view thereof.



U.S. Patent

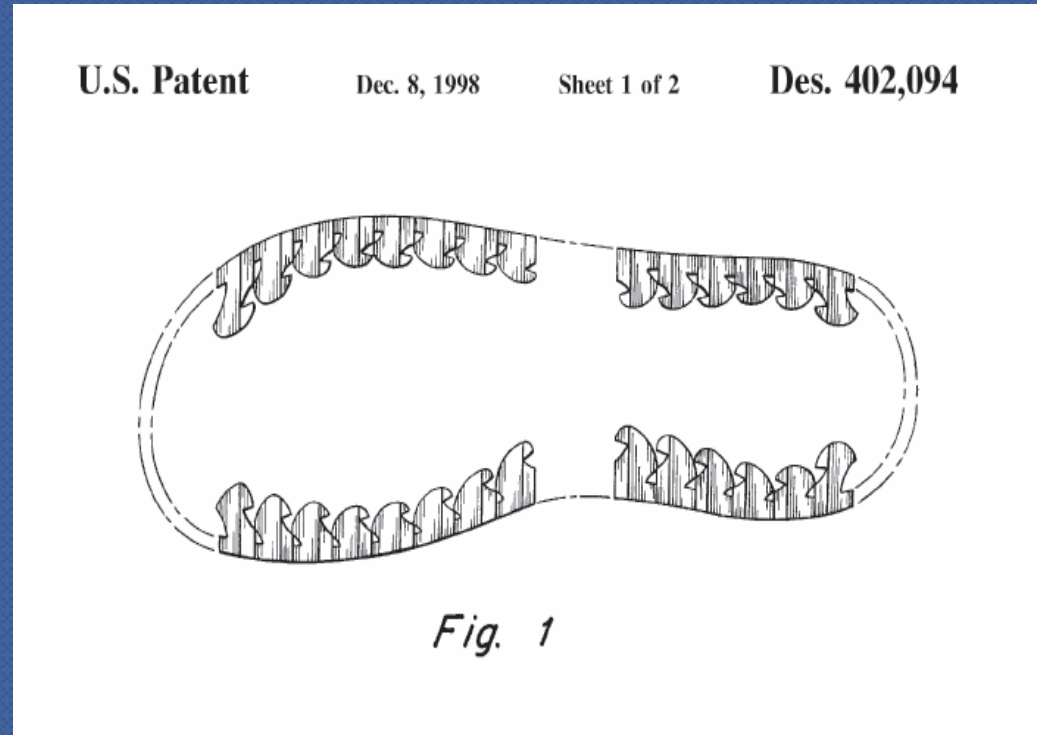
Sep. 15, 1981

Des. 260,789



Some Vermont Designs

- D402094 Portion of a snowboard boot sole (The Burton Corp., Burlington VT 1998)

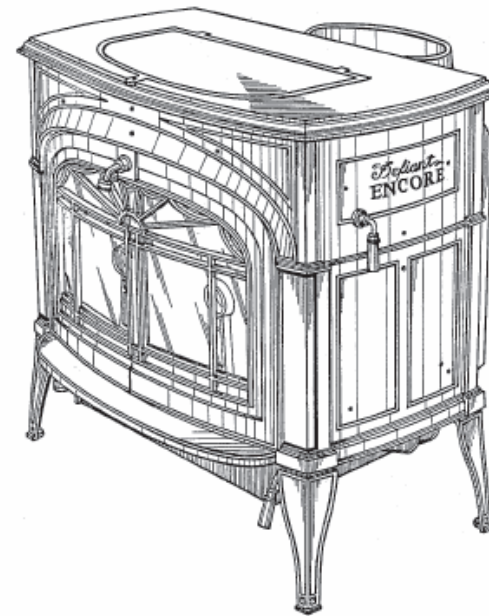


Some Vermont Designs

- D300354 Wood and coal burning stove (Vermont Castings, Randolph VT 1989)

U.S. Patent Mar. 21, 1989 Sheet 1 of 4 D300,354

Fig.1



Vermont Design Patent

- D410999 cast iron stove (Hearthstone Holdings, Morrisville VT 1999)

US00D410999S

United States Patent [19] [11] **Patent Number: Des. 410,999**
Henninge [45] **Date of Patent: ** Jun. 15, 1999**

[54] **CAST IRON STOVE**
[75] Inventor: **Paul Henninge**, Burlington, Vt.
[73] Assignee: **NHC, Inc.**, Morrisville, Vt.
[**] Term: **14 Years**

[21] Appl. No.: **29/092,129**
[22] Filed: **Aug. 12, 1998**

[51] **LOC (6) CL** **23-03**
[52] **U.S. CL** **D23/342; D23/343**
[58] **Field of Search** **D23/342-345, D23/350; 126/500, 4, 67, 190**

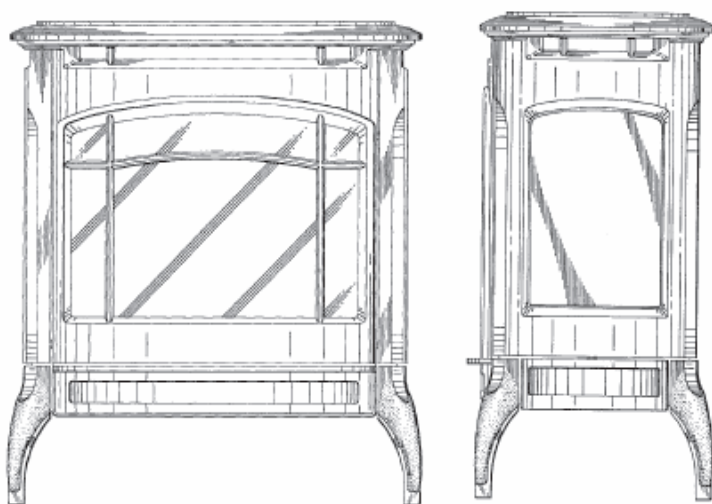
[56] **References Cited**
U.S. PATENT DOCUMENTS
D. 392,376 3/1998 Greene D23/343

Primary Examiner—Lisa Lichtenstein
Attorney, Agent, or Firm—Downs Rachlin & Martin PLLC

[57] **CLAIM**
The ornamental design for a cast iron stove, as shown and described.

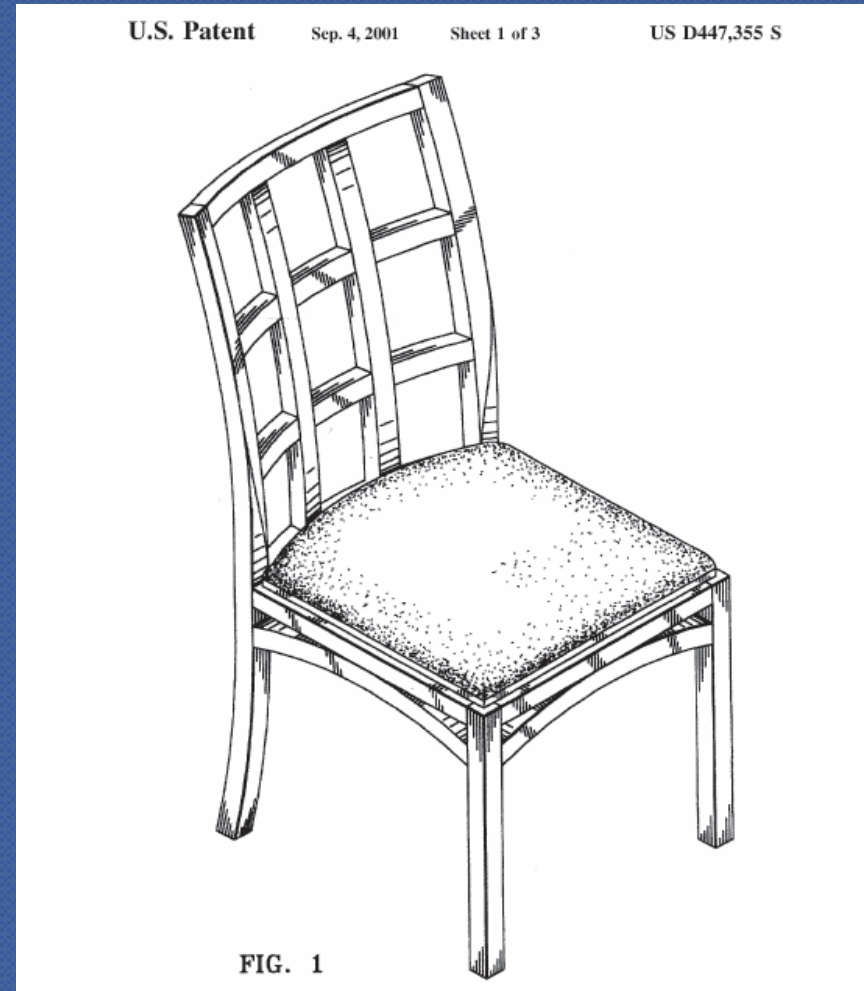
DESCRIPTION
FIG. 1 is a front elevation view of the cast iron stove design of the present invention;
FIG. 2 is a side elevation view of the design shown in FIG. 1, the opposite side being a mirror image of that shown;
FIG. 3 is an enlarged partial view of the region of the design shown in FIG. 2 identified by dotted line 3;
FIG. 4 is a top view of the design shown in FIG. 1; and,
FIG. 5 is a rear elevation view of the design shown in FIG. 1.
The bottom of the design is not being claimed.

1 Claim, 4 Drawing Sheets



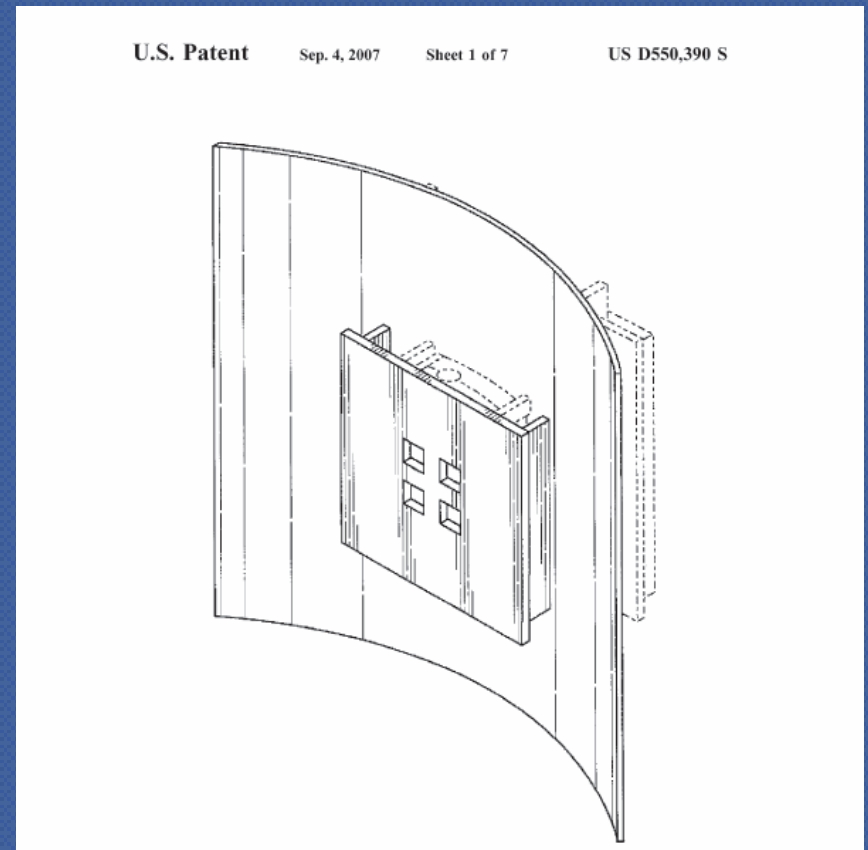
Some Vermont Designs

- D447355 Chair (T. Copeland & Sons, Bradford VT 2001)



Some Vermont Designs

- D550390 Wall sconce
(Hubbardton Forge,
Castleton VT 2007)



Some basic differences with utility patents

- Regulatory/Procedural -

Simplified patent application: only a single claim which refers to the accompanying drawing(s).

Term of patent protection is 14 years from date of issue.

Restriction practice is mandatory.

Not covered under PCT (international applications).

Only 6 months under foreign priority, instead of 1 year.

Some basic differences with utility patents - Regulatory/Procedural -

- Design patents may NOT claim benefit of provisional applications
- Request for Continued Examination (RCE) not available for design applications.
- Continued Patent Application (CPA) is only available for design applications.
- Design applications are not subject to publication requirement.

Some basic differences with utility patents - Costs -

- Design Application Filing fee: \$210 (small entity \$105)
- Utility Application Filing fee: \$810 (small entity \$405)
- Design Application Search Fee: \$100 (small entity \$50)
- Utility Application Search Fee: \$510 (small entity \$255)
- Design Examination Fee: \$130 (small entity \$65)
- Utility Examination Fee: \$210 (small entity \$105)
- Design Patent Issue fee: \$820 (small entity \$410)
- Utility Patent Issue fee: \$1440 (small entity \$720)

- Design Patent: No maintenance fees.
- Utility Patent: (1) 3 years and 6 months after grant, \$900; (2) 7 years and 6 months after grant, \$2,300; (3) 11 years and 6 months after grant, \$3,800.



Litigation

Patent Infringement

Standards for Infringement of Design Patent

- Two prong test (*Gorham Mfg Co. v. White*, 81 U.S. 511 (1871).)
 - Substantial similarity to the patented design in the “eye of the ordinary observer”.
 - Infringing design appropriates or takes the point of novelty that allowed the patented design to be patented.

Points of Novelty Test

- Federal Circuit is rehearing en banc *Egyptian Goddess v. Swisa* in 2008
 - Should “points of novelty” be a test for infringement of a design patent?
 - If so, what would it look like?
 - Should claim construction apply to design patents, and if so, what role does it play in infringement analysis?

Design Patent Litigation

- In past 20 years USPTO has issued approximately 268,000 Design Patents.*
- Approximately 1% have been involved in litigation.
- Most commonly litigated designs involves
 - Shoes (7%)
 - Lamps (5%)
 - Chairs & tables
 - Eyeglasses
 - Golf equipment

* September 2007 figure

Damages Calculations...

- Generally, 35 USC §284 authorizes damages “adequate to compensate for the infringement, but in no case less than a reasonable royalty for use of the invention”. Court may increase the damages up to three times the amount assessed.
- In exceptional cases, court may award attorney fees to prevailing party.
- In addition, 35 USC §289 authorizes recovery of infringers’ total profit for infringement of Design Patent.

Overlap with Copyright and Trademark/Trade Dress

- Copyright can protect a category of pictorial, graphic, or sculptural work. (17 U.S.C. §102)
- Design must have “original” specific feature, and exist separate and distinct from the functional aspects. (“artistic separability”)
- Trademark: Avoid confusion of consumers as to the source of a good by non-functional indicator, e.g. logos, graphics, distinctive shapes.
- Trade dress: overall appearance of design -nonfunctional and inherently distinctive / having “secondary meaning”.

Overlap and the Doctrine of Election

- USPTO Patent Office will not force an election between a copyright and a design patent.

(MPEP §1512)

- Copyright Office regulations prohibit registration of a copyright claim in a patented design or in drawings of a patent application after the patent has issued.

(37 CFR §201.10)

Sui Generis U.S. Statutes

Specialized Law

- Semiconductor Chip Act (1984)

Intended to protect chip layer designs.

Protection was immediate when chip placed in market.

No initial application for protection had to be made, but file within 2 years of first market use to obtain protection for 10 year term.

Administered by Copyright Office.

- Vessel Hull Design Protection Act (VHDP Act)(1998)

Purpose was to protect vessel designs when molding technology made it easy for competitors to quickly copy boat structure

Similar 2 year registration window to obtain 10 years of protection.

Obtaining a Design Patent ended VHDP protection.

In the news ...

U.S. House of Representatives Sub-Committee on Courts, Internet and Intellectual Property held hearings in February on special provisions for unique industries

- Automobile manufacturers and replacement parts importers (In re Certain Automotive Parts, 2007 WL 2021234 (ITC 2007) and Ford v. ITC, 07-1357 in which a decision is expected summer 2008.)
- Design Piracy Prohibition Act (2007 S. 1957) Fashion design. Artwork on clothing is copyrightable, but garment designs are too “utilitarian”. 3 years protection/3 month window.

Advantages of Design Patents

- Faster prosecution than utility patents
- Less expensive to obtain than utility patents
- US Customs will prevent importation of infringing goods with an Exclusion Order from the ITC
- Infringement Damages – disgorgement of infringer profits



Thank you