

Time to Rethink Design Patents and Retool with the Hague System

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Why Should Design Patents Be Part of an IP Strategy?

- ❖ Protect the ornamental aspects of industrial designs
- ❖ Some products are not suitable for utility patents
- ❖ Other products benefit from the added protection of their design
- ❖ Designs sometimes are the easiest things for potential competitors to copy
- ❖ Design patents are less expensive than utility patents and are granted more quickly
- ❖ Now viewed as more powerful enforcement tools

US Law of Design Patents

◆ 35 USC 171 – Patents for designs

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.

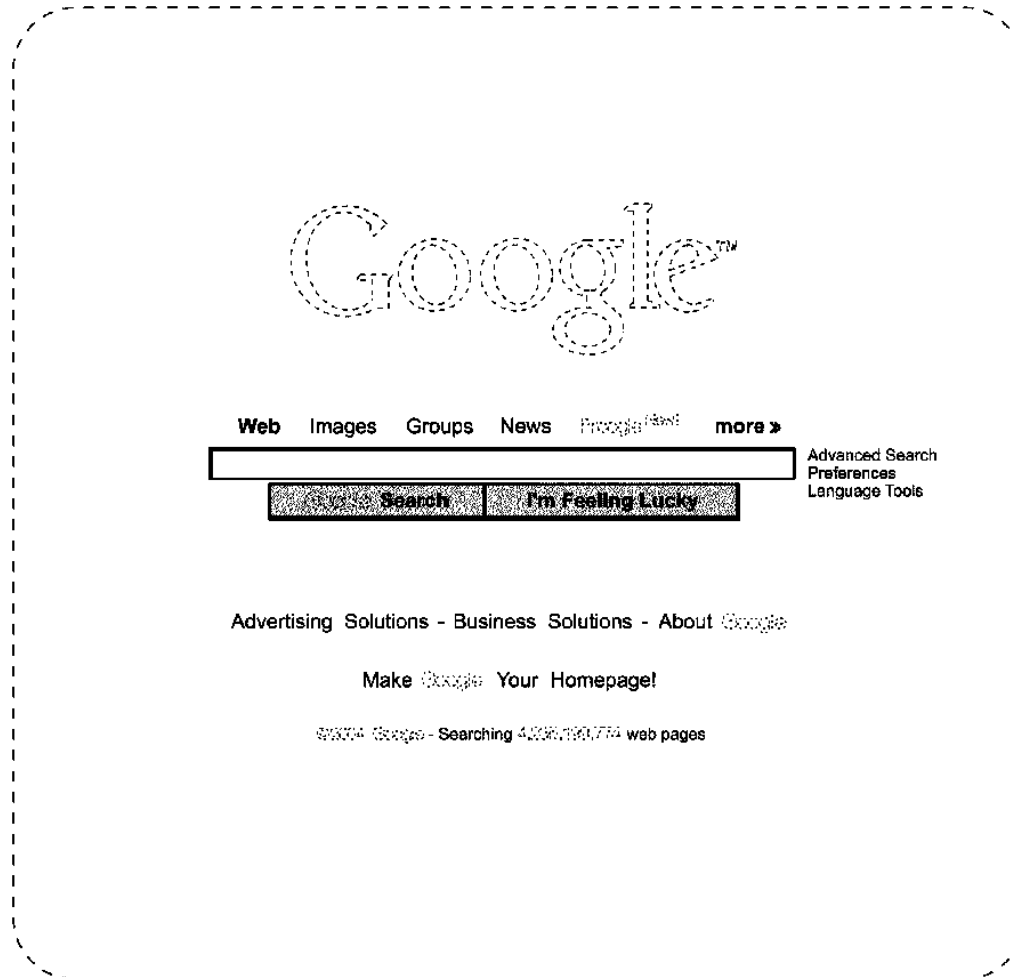
(emphasis added)

Common Subjects of Design Patents

- ◆ Electronics
- ◆ Shoes
- ◆ Containers
- ◆ Furniture and home decorations
- ◆ Appliances
- ◆ Web pages and graphical user interfaces
- ◆ Food
- ◆ Tires
- ◆ Cars

Search of USPTO.gov patent database

US Design Patent D599,372



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US Design Patent 2,415,012

Jan. 28, 1947.

R. T. JAMES
TOY AND PROCESS OF USE
Filed Aug. 21, 1946

2,415,012

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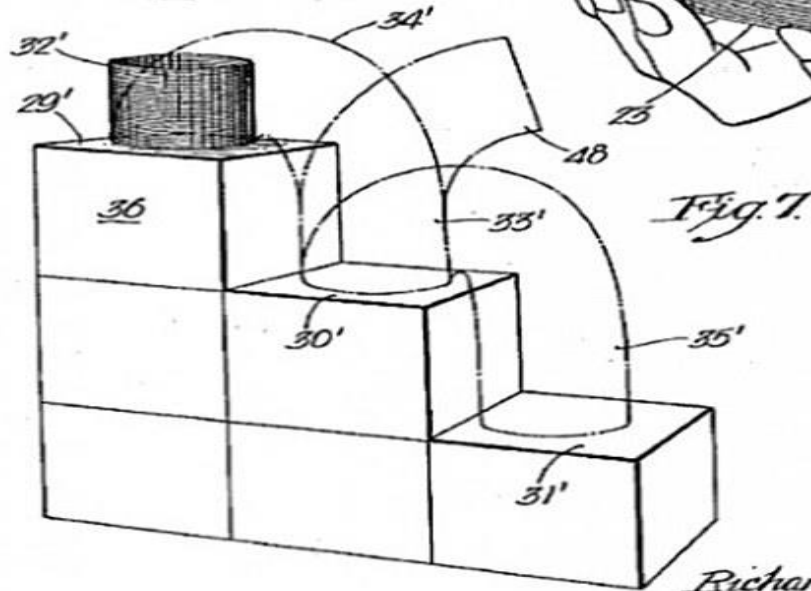
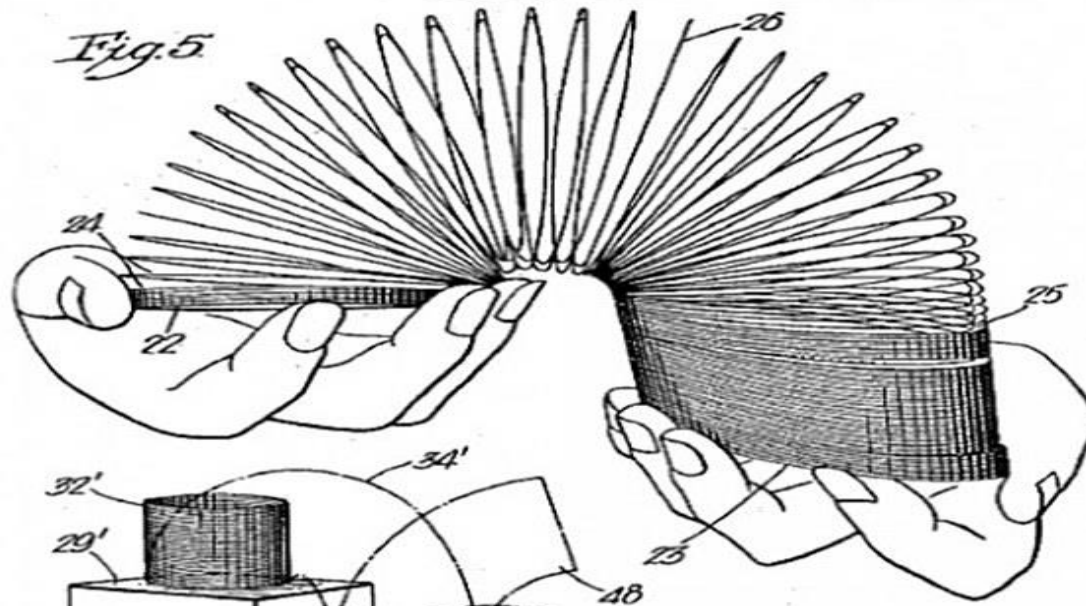
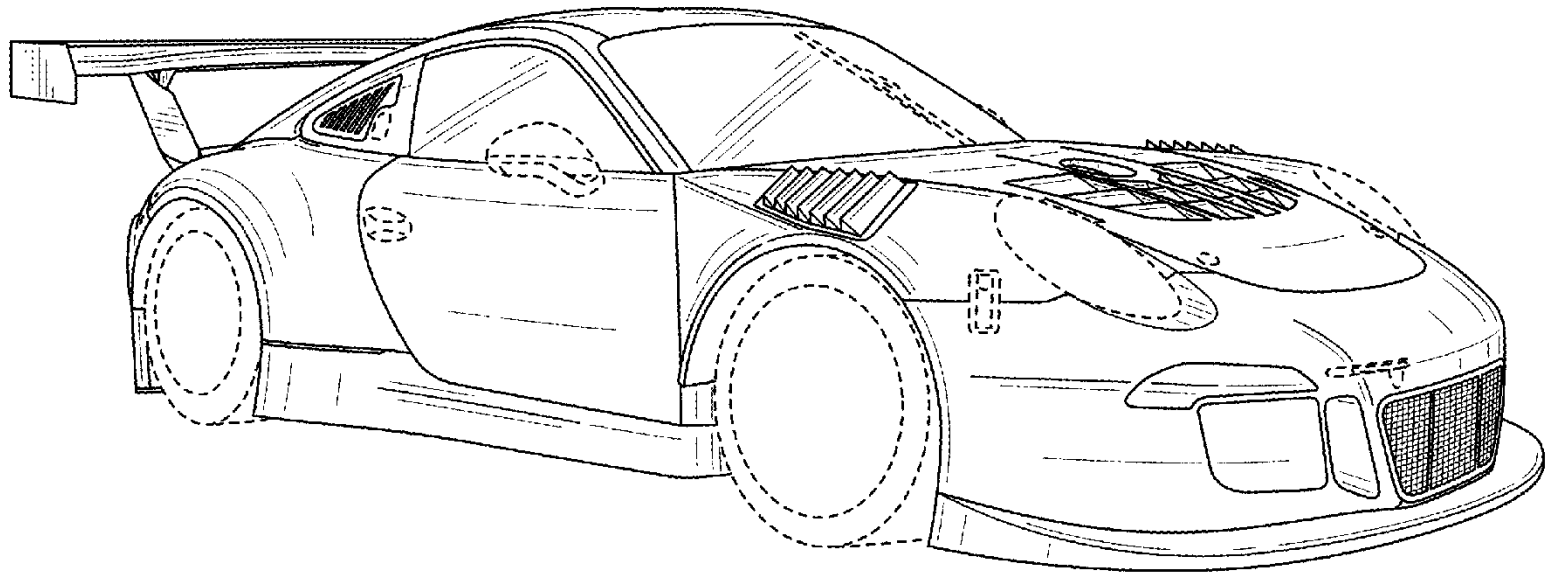


Fig. 7
INVENTOR,
Richard T. James
BY
Wm. H. Anderson
Attorneys

US Design Patent D753023



D753023 assigned to Porsche Aktiengesellschaft

US Design Patent D735,980



D735,980, assigned to Crocs, Inc.

US Design Patent D749291



D749291 assigned to Frito Lay

Increasing Numbers of US Design Patents Granted

◆ 2005 – 12,951

◆ 2010 – 22,799

◆ 2015 – 25,986

◆ Compare US utility patents 2015 - 298,407

Total number of design applications filed under Hague System to date (since May 13, 2015) – approx. 1000

The Trend Is Up for Design Patents – What is Going On?

- ❖ *Apple v. Samsung* (\$1 billion verdict in 2013 involving design patents on smartphones and tablets)
- ❖ ITC exclusion order in *Matter of Certain Foam Footwear* (2011 Crocs knockoff)
- ❖ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (standard for determining infringement of design patents)

The Trend Is Up for Design Patents – What is Going On?

- ❖ Value of design in competitive global marketplace of e-commerce and omnichannel marketing
- ❖ Graphical and animated user interfaces are patentable
- ❖ Faster, cheaper avenue for protecting IP

But it only takes one!



US Design Patent D604,305

Top Country Origins for US Design Patents Granted in 2015

1. United States(14,335)
2. South Korea (2238)
3. Japan (318)
4. Germany (1040)
5. PR China (881)
6. Taiwan (877)
7. United Kingdom (702)
8. Canada (673)
9. Italy (425)
10. France (420)

USPTO Design Patent Report (March 2016)

Top Organizations Granted US Design Patents in 2015

1. Samsung Electronics (1,428)
2. LG Electronics Inc. (455)
3. Microsoft Corporation (318)
4. Apple, Inc. (189)
5. Nike, Inc. (171)
6. Honda Motor Co., Inc. (100)
7. 3M Innovative Properties Company (89)
8. Proctor & Gamble Company (85)
9. Target Brands (84)
10. Bayerische Motoren Werke AG (78)

USPTO Design Patent Report (March 2016)

What Would It Take to Implement The Hague System Into a Design Patent Program?

- ❖ Learn to navigate new, simple filing site and filing steps
- ❖ Think big! Include up to 100 different designs (provided they are in the same class)
- ❖ Ensure your drawings meet the drawing requirements of all designated countries
- ❖ Chose filing directly with WIPO or indirectly with USPTO
- ❖ Think globally! Select up to 65 countries, consider enforcement forums and procedures, likely market for product, cost of prosecution, etc.

What Would It Take to Implement The Hague System Into a Design Patent Program?

- ❖ Be prepared to file divisional applications in the US, where a design patent must be directed to a single invention
- ❖ Still need to file separately in non-member countries (e.g., China, Canada, Australia, Brazil)
- ❖ Still need to prosecute in all individual countries and likely need to have local counsel in those jurisdiction that have substantive examination

How Are Design Patents Enforced Under the Hague System?

Up to local law. In the United States, under US law:

“If, in the eye of the 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 and sufficient to induce him to purchase one supposing it to be the other – the one first patented is infringed by the other.

Gorham Mfg. Co. v. White, 81 U.S. 511, 528 (1871)

Proving Infringement – Ordinary Observer Test

[I]n accordance with *Gorham* and subsequent decisions, we hold that the “ordinary observer” test should be the sole test for determining whether a design patent has been infringed. Under that test, as this court has sometimes described it infringement will not be found unless the accused article “embod[ies] the patented design or any colorable imitation thereof.”

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008)

Design Patent Enforcement

- ◆ District court infringement actions
- ◆ ITC proceedings
- ◆ USPTO PTAB post grant challenges – *Inter Partes* Reviews and Post Grant Reviews
- ◆ Detailed, verbal claim construction is not required
- ◆ Damages for infringer's total profits on sales of articles bearing the infringing design

Thank you

Questions?

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