

DESIGN PATENT PERSPECTIVE: Why Get A Design Patent?



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Design patents have a mixed reputation. Most are relatively easy to obtain and easy to design around, which gives them a reputation for being a limited form of protection. But design patent law is more complex than often thought, and for that reason, design patents may be the most misunderstood, underutilized, and under-claimed form of intellectual property. For those who understand the potential of design patents and who prosecute carefully to achieve the scope of protection desired, design patents can add significant value to an intellectual property portfolio.

For ease of discussion, let's divide the potential usefulness of design patents into four categories: (1) Patent Pending; (2) Patented; (3) Protection of Overall Design and Substantially Similar Designs; and (4) Protection of Individual Design Features.¹ These categories proceed from the simplest

and cheapest to the most complex and potentially expensive. Let's review the benefits, and for the more complex categories, explore some techniques for best achieving those beneficial results.

1. Patent Pending – A design patent application typically is less expensive to file than a utility patent application, both in terms of filing fees and attorney fees.² And a design patent application will not expire at the end of one year like a provisional patent application. So the first good reason you might consider getting a design patent is for the relatively inexpensive benefit of achieving a “patent pending” status.

The phrase “patent pending” can be marked on a product after a design patent application covering all or part of the product design is filed with the United States Patent and Trademark Office (USPTO). The phrase has no legal effect, but places the public on notice that a patent has been applied for.

Marking a product with “patent pending” has at least two practical benefits. First, it may have a chilling effect on competition. Potential competitors placed on notice that a product may receive future patent protection may be reluctant to invest resources in a product that may infringe. Second, it may provide a marketing advantage. Consumers may perceive “patent pending” products as being more “cutting edge” and unique, and therefore more valuable.

2. Patented – A second reason to get a design patent is that your design usually will receive a patent faster³ and with less expense⁴ than if you pursued just utility patent protection. After a patent is granted, the chill on competition and marketing advantages usually will increase. Most importantly, patent rights will exist that can be enforced through an application for injunctive relief and a suit for damages.

In the typical design “knock off” situation, favorable injunctive relief is available and likely if no substantial issues are raised with regard to patent validity. Claim construction issues, if any, usually are less complex than with utility patents, and this simplifies the injunctive process.

When a design patent is issued, lost profit and reasonable royalty damages are available under section 284.⁵ Further,

under section 289⁶ (entitled “Additional remedy for infringement of design patent”), a design patent infringer can be liable “to the extent of his total profit.” This is a valuable additional remedy, particularly if lost profits are not available because the patented design is not being sold, or if another *Panduit*⁷ factor cannot be satisfied.

Another substantial benefit of a design patent is that, unlike a utility patent, no maintenance fees are required over the fourteen-year life of a design patent.

3. Protect Overall Design and Substantially Similar Designs – Design patents can have only a single claim,⁸ and a common use of a design patent is to protect a single design and substantially similar designs. The actual scope of patent protection is determined by the ordinary observer test and will depend on how close the patented design is to the prior art and how crowded the field of prior art is.⁹

When a patent application contains a single ornamental design and there are no prior art references that anticipate or render the design obvious, a design patent likely will be granted.¹⁰ Unfortunately, a single design claimed only with solid lines is rather easy to design around. A competitor may copy much of the accused design, but change one or two significant design features. When the design is viewed as a whole and compared with the entire accused design, as it must be, infringement often may not exist under the ordinary observer test. A potential solution to this problem is to claim individual design features, a technique discussed in detail below.

When a design patentee discovers within two years of issuance that a design patent has been claimed too narrowly, one solution is to file for a broadening reissue patent. Broadening reissue patents are granted only if an error without any deceptive intention is made in a patent.¹¹ The “error” can be that the original patent failed to include “a design for a patentably distinct segregable part of the design claimed” or “a patentably distinct subcombination of the claimed design.”¹² A limitation of a broadening reissue patent is that absolute and equitable intervening rights may exist for those who are already manufacturing, selling, using, or importing into the U.S. a product that does not infringe the original patent but that may infringe the reissue patent.¹³

In addition to the standard benefit of preventing others from copying your design, an additional reason to get a design patent is to establish “secondary meaning” for trademark and trade dress rights. Trademark secondary meaning occurs when consumers associate a descriptive trademark with a particular producer or source rather than with the product itself.¹⁴ One of the challenges of trademark law is that protection for descriptive terms and shapes of articles of manufacture cannot be obtained until after secondary meaning is established. But before secondary meaning is established and a trademark is obtained, trademark law cannot provide protection, which leaves others free to use the descriptive mark or shape, which in turn prevents secondary meaning from being established.

One solution to this problem is to obtain a design patent to prevent competitors from copying the design until secondary meaning is established. This was the approach pursued by Apple with their iPod design. Apple first obtained design patents on the iPod design to prevent copying.¹⁵ Then once secondary meaning was established, Apple applied for a trademark on the three dimensional shape of the iPod design, which was granted.¹⁶

4. Protect Individual Design Features – Perhaps the best reason to get a design patent is to protect individual design features. Protection of individual design features is probably the most effective way to protect the “visual brand” of a product. For example, assume your product is the first of its type to use a particular shape (i.e., rounded, squared, hollow, arched, etc.) for a major design component or set of components. Consumers may begin to recognize this unique shape as part of your brand identity. Then assume a competitor (i) uses the same shape for the same component, but changes the shape of other components, or (ii) uses the same shape for a portion, but not all, of the same component. The competitor likely will have intruded upon your visual brand identity and created some confusion in the marketplace, but may have done so in a way that avoids design patent infringement. A solution to this problem is to use advanced design patent prosecution techniques to protect the individual design features of your product. These techniques include portion claiming, broken line claiming, indeterminate break lines, multiple embodiments, multiple patents, continuation practice, and combinations of all these techniques.¹⁷

Portion claiming is the practice of claiming just a portion of the design embodied in or applied to an article of manufacture. Although portion claiming now is an accepted practice in design patent prosecution, that was not always the case. The first sentence of 35 U.S.C. § 171 states “[w]hoever 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). Historically, it was believed that the claim must be for the design embodied in or applied to an entire article of manufacture. This changed in 1980 when the United States Court of Customs and Patent Appeals (CCPA) decided *In re Zahn*,¹⁸ a case involving a masonry drill bit. In *In re Zahn*, the court made clear that an applicant could claim just a portion of the article of manufacture (in this case the shank portion of the drill bit) and that portion claiming did not violate either 35 U.S.C. § 171 or 35 U.S.C. § 112 (description and enablement).

The applicant in *In re Zahn* claimed just the shank portion of the drill bit by placing the twist-drill portion of the drill bit in broken lines. However, portion claiming also may be accomplished, in appropriate circumstances, by simply illustrating the portion of the design to be claimed. This was the method used by the patentee in *Gorham v. White*,¹⁹ where the silverware handle was illustrated with the spoon bowl and fork tines omitted. Portion claiming by complete omission also is supported by MPEP section 1504.04, which states in relevant part “when visible portions of the article embodying the design are not shown, it is because they form no part of the claim to be protected” and “[i]t is *prima facie* evidence that the scope of the claimed design is limited to those surfaces ‘as shown’ in the application drawing(s) in the absence of any additional written disclosure.”

Broken Line Claiming - Current 37 CFR § 1.152 states in relevant part “[b]roken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials.” Current MPEP § 1503.02 Part III entitled “Broken Lines” states “[t]he two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim.” With regard to disclosing the environment, the MPEP states “[s]tructure that is not part of the claimed design, but is considered

necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines” and “[t]his includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design.”²⁰ The MPEP further states “[u]nclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”²¹

Note that the MPEP states that broken lines may represent any portion of an article in which the design is embodied or applied to. Therefore, not only may surrounding environment be represented by broken lines, but any feature of the article of manufacture may be represented by broken lines as well.

Strategic use of environmental broken line claiming can avoid new matter rejections when filing an amended claim. 35 U.S.C. § 132 states “[n]o amendment shall introduce new matter into the disclosure of the invention.” This means that every amendment must have antecedent basis in the original disclosure. If an amendment adds new matter to the claim, then the claim would be rejected under 35 U.S.C. § 112, first paragraph. The MPEP states [a] change in the configuration of the claimed design is considered a departure from the original disclosure and introduces prohibited new matter [citing] (37 CFR 1.121(f)). See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).²² However, the MPEP also states “an amendment that changes the scope of a design by either reducing certain portions of the drawing to broken lines or converting broken line structure to solid lines is not a change in configuration as defined by the court in *Salmon*.”²³ “The reason for this is because applicant was in possession of everything disclosed in the drawing at the time the application was filed and the mere reduction of certain portions to broken lines or conversion of broken line structure to solid lines is not a departure from the original disclosure.”²⁴

Can you add a broken line boundary to a drawing in a continuing application and claim priority to a parent application that contains the drawing without the broken line boundary? This issue currently is before the Federal Circuit.²⁵

Indeterminate break lines may be used when an applicant does not want to claim the precise dimensions of a design. An example of how to use indeterminate break lines is set forth in *A Guide To Filing A*

Design Patent Application (Guide) available on the USPTO website.²⁶ Note that break lines are not mentioned in the statutes, regulations, or MPEP, but are mentioned in the *Guide* and the case law.²⁷ According to the *Guide*, the drawing should use a separation and bracket to indicate that the precise dimension of the design is not claimed. Note also that the break will retain the characteristics of the surrounding structure. For example, when straight lines contain indeterminate break lines, the break portion will be interpreted as being straight as well.²⁸

A design patent claim may have multiple embodiments if they involve a single inventive concept (are patentably indistinct) under obviousness-type double patenting practice for designs.²⁹ If multiple embodiments do not involve a single inventive concept, they cannot be included in the same design patent claim and the examiner will issue a restriction requirement. Note that multiple embodiments in a design patent claim carry an increased risk of invalidity because if one embodiment is considered invalid as anticipated or obvious in light of the prior art, then all the other embodiments will be invalid as well.³⁰

Multiple Patents - Since multiple claims currently are prohibited in design patents, patentably distinct designs eventually must be placed in separate applications and must issue as separate design patents. One technique is to include all designs in a single initial application and then file divisional applications on the separate inventive concepts as the examiner issues restriction requirements. This technique has the advantage of saving money on the initial filing fee. It is important to note that if a restriction requirement is issued on a claimed design and the design is not pursued in a divisional application, the design will be dedicated to the public.³¹ Another technique that may be used is to file separate applications on separate inventive concepts that are patentably distinct. This technique carries a greater initial expense. Further, note that when this technique is used, there is a possibility that a double patenting rejection will arise.³²

Continuation Practice - In design patent practice, the prosecution may be continued with a continuing application, which may be a continuation application or a divisional application.³³ Prosecution also may be continued with a continuing prosecution application.³⁴ Prosecution of a design patent application may not be continued

with a continuation in part application³⁵ or a request for continued examination.³⁶ The continuation strategies include keeping an application active so solid lines can be converted to broken lines and vice versa to broaden and narrow the scope of the patent as necessary in response to market and competitor developments.

Claiming Strategies - A primary goal of patent claim drafting is to obtain the broadest possible claim that will survive a prior art invalidity challenge. Drafting such a patent claim requires knowledge of all relevant prior art and the ability to predict how an examiner, judge and jury will apply the prior art. Perfect knowledge of the prior art is rare - and perfect predictions rarer still - so drafting strategies must be pursued to retain patent protection when additional prior art is uncovered during prosecution and litigation.³⁷

In utility patent practice, a common strategy is to draft a broad independent claim, and then to draft narrower dependent claims that may survive attack if the broader claim is invalidated by newly discovered prior art. This strategy is possible in utility patent practice because under 35 U.S.C. § 112 a patent specification may include one or more claims that may be written in independent or dependent form. The situation is different in design patent prosecution because a design patent is limited to a single claim.³⁸ This limitation makes it much more challenging to draft a broad design patent that can anticipate and survive a prior art attack.

It is generally believed that omitting detail in design patent drawings may broaden design patent claim scope. The theory behind this approach is that a detailed drawing is easier to design around because it offers more features that can be omitted or changed to avoid infringement. When just the primary novel features of the design are claimed and these features substantially exist in the accused design, then an argument for infringement can be made.

This approach has advantages, but it has disadvantages as well. Just as deleting or modifying design elements can help avoid infringement of a more detailed drawing, adding design features can help avoid infringement of a less detailed drawing as well.³⁹ One way to avoid this predicament is to place broken lines on the borders of the section portions of the design where the detail was omitted. When this is done, the additional detail in the accused design becomes irrelevant as long as the solid line

portions of the design exist in the accused design.

But then an additional problem may arise. Although placing section portions of the claimed design in broken lines may help capture more accused designs as infringements, it also makes the claimed design more susceptible to a prior art invalidity challenge. This is because the detail in the prior art that exists in the broken line section portions of the design no longer will be relevant to the comparison. As long as the prior art contains the solid line portions of the claimed design, it can act as a potentially anticipating reference or, in an obviousness analysis, a primary prior art reference. In short, increasing the breath of the claim for infringement purposes also will increase the breath of the claim for invalidity purposes.

A potential solution for this problem is to add drawings that contain the additional or alternate detail in broken lines. Then, if prior art is encountered that may pose a problem, the detail in broken lines may be converted to solid lines to distinguish the prior art. As long as there is antecedent basis for the solid lines in the broken lines, a “new matter” rejection can be avoided.

Selection of what sections should be placed in broken line borders and what design detail should be drawn in broken lines should be a matter of informed judgment. Decisions should be made only after thoroughly understanding the nature of the design and its proposed commercial embodiments, reviewing and analyzing the prior art, and carefully considering the direction of potential future design around attempts and infringements.

Why should you get a design patent? There are many good reasons as discussed above. And when a design patent’s potential is fully understood and realized through effective claiming and prosecution strategies, a design patent can become a powerful additional right to complement other forms of intellectual property protection.

ENDNOTES

1. A potential fifth benefit is protection of function. Although a design patent cannot be granted on a design dictated by function, claiming techniques may exist that will effectively protect function. This will be discussed in a future article.
2. The current patent fee schedule can be obtained from the USPTO website at uspto.gov. At time of writing, the basic filing, search, and examination fees for a design patent application total \$530 (\$265 small entity). The basic filing, search, and

- examination fees for a utility patent application total \$1,250 (\$625 small entity).
3. In 2011, the average patent pendency time for a design patent was approximately 15 months. For a utility patent, it was 33.7 months. See Average Patent Pendency Time at <http://uspatentstatistics.com/averagependenciesstechcenter.html>.
 4. At time of writing, the design patent issue fee is \$990.00 (\$495 small entity) and the utility patent issue fee is \$1,740 (\$870 small entity).
 5. 35 U.S.C. § 284, which states in relevant part “[u]pon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs fixed by the court.”
 6. 35 U.S.C. § 289.
 7. See *Panduit Corp. v. Stalin Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156 (6th Cir. 1978) (“To obtain as damages the profits on sales he would have made absent the infringement, i.e., the sales made by the infringer, a patent owner must prove: (1) demand for the patented product, (2) absence of acceptable noninfringing substitutes, (3) his manufacturing and marketing capability to exploit the demand, and (4) the amount of the profit he would have made.”). The Federal Circuit has adopted the Sixth Circuit’s “*Panduit* factors” as an acceptable, but non-exclusive, method of determining lost profits. See *Kearns v. Chrysler Corp.*, 32 F.3d 1541 (Fed. Cir. 1994); *Bic Leisure Prods., Inc. v. Windsurfing Int’l Corp.*, 1 F.3d 1214, 1218 (Fed. Cir. 1993).
 8. 37 CFR § 1.153 (More than one claim is neither required nor permitted.”).
 9. See *Egyptian Goddess v. Swisa*, 543 F.3d 665, 678 (Fed. Cir 2008) (en banc).
 10. 35 U.S.C. § 171 states “[w]hoever 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” and “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”
 11. 35 U.S.C. § 251.
 12. MPEP § 1457.
 13. See 35 U.S.C. § 252.
 14. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11, (1982).
 15. See, e.g., D634,297 and D644,264.
 16. See David Orozco and James Conley, *Shape of Things to Come*, available at <http://online.wsj.com/article/SB121018802603674487.html>.
 17. Additional strategies involve use of descriptive language, optional preambles, and careful drafting of the title, but these strategies are not discussed in this article.
 18. 617 F.2d 261 (CCPA 1980).
 19. 81 U.S. 511 (1871).
 20. *Id.*
 21. *Id.*
 22. MPEP § 1504.04 entitled “New Matter.”
 23. *Id.*
 24. *Id.*
 25. See *In re Owens*, Federal Circuit No. 2012-1261 (Serial No. 29/253,172) (Appeal filed by Perry J. Saidman of SAIDMAN DesignLaw Group, LLC and David M. Weirich of The Procter & Gamble Company).
 26. See www.uspto.gov.
 27. See, e.g., *Alan Tracy, Inc. v. Trans Globe Imports*, 1995 U.S. App. LEXIS 14253, 8-9 (Fed. Cir. June 2, 1995).
 28. *Id.*
 29. See *In re Rubinfeld*, 270 F.2d 391 (CCPA 1959).
 30. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965).
 31. See *Victus, Ltd. V. Collezione Europa U.S.A.*, 1998 U.S. Dist. LEXIS 14230 (M.D.N.C. Aug. 3, 1998) (prosecution history estoppel applied when patent application for table design contained both wooden and glass tops, and following a restriction requirement, the glass top table design was abandoned).
 32. See generally MPEP § 804.
 33. 37 C.F.R. § 1.53(d).
 34. *Id.*
 35. See MPEP § 1504.20 (“[A] design application filed as a ‘continuation-in-part’ that changes the shape or configuration of a design disclosed in an earlier application is not entitled to the benefit of the filing date of the earlier application. See *In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983)”).
 36. See 37 CFR § 1.114(e)(4).
 37. For other informative articles on claiming strategies for design patents see Karl G. Hanson, *Intellectual Property Strategies for Protecting the Looks of A New Product*, 81 J. Pat. & Trademark Off. Soc’y 887 (December 1999), and James D. Hamilton and Christopher D. Ward, *Strategy for Obtaining Broad Design Patent Protection*, (July 2000) (available at <http://www.oblon.com/publications/strategy-obtaining-broad-design-patent-protection>). Another excellent general resource on this topic is Robert S. Katz, *Writing Patents for Litigation and Licensing*, Chapter 10, Design Patents (BNA 2008 with 2011 Cumulative Supplement).
 38. 37 CFR § 1.153 states in relevant part that with regard to design patents “[m]ore than one claim is neither required nor permitted.”
 39. See, e.g., *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 2011 U.S. Dist. LEXIS 112846 (D. Md. Sept. 30, 2011).