

DESIGN PATENT PERSPECTIVE: Ten Tips for Strengthening Design Patent Protection



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Those who believe design patents can provide only a second-class form of weak protection may need to reconsider. In June 2012, District Judge Lucy H. Koh issued a design patent preliminary injunction order in *Apple v. Samsung*¹ that blocks Samsung, at least temporarily, from selling in the U.S. popular tablet computers that look like Apple's iPads. In July 2012, two more preliminary injunction orders based on design patents were granted in *Cornucopia Products v. Dyson*² (bladeless fan design) and *Hutzler v. Bradshaw*³ (onion and garlic holders). At the time of this writing, *Apple v. Samsung* is in its third week of trial and Apple is requesting two billion dollars in design patent infringement damages alone.⁴ Regardless of the ultimate case outcome, Apple has shown that a design patent can be a potent weapon of intellectual property enforcement efforts.

In past columns we discussed the legal aspects of various claiming strategies for obtaining broader design patent protection. Now let's consider some additional practical tips to further strengthen the enforcement and protective power of a design patent.

Design with a design patent in mind

- Before putting pen to paper or mouse to pad, first consider the general principles and parameters of design patent law. A design patent does not protect function or the general concept of a design. Rather, it protects only the ornamental appearance of a design. This presents one of the greatest challenges of design patent prosecution: how to prevent competitors from doing too much "concept copying" when protection is limited to the design as shown and designs deceptively similar under the ordinary observer test.

One approach you may consider is to step into the shoes of a competitor and attempt your own design around. Analyze your design and determine what dominant visual features distinguish it from the prior art and establish its own visual brand identity in the marketplace. It might be uniquely shaped corners or a clever combination of other design features. Now see if you can produce a similar visual impression with another design that changes one or more visually significant design features. For example, if your design has four uniquely rounded corners on a casing, could a competitor copy three and change the fourth to a squared off corner? If your design has three uniquely raised pads on a hollow nail buffer square in cross section and rectangular in length, could a competitor simply add a fourth identical pad? In that event, a competitor might be able to copy your unique design concepts enough to trade off of your design in the marketplace but be able to escape infringement under the ordinary observer test.

If you are able to create such design arounds, then you should consider applying for additional patents to strengthen protection. These additional applications can show the entire alternative designs, or

perhaps more effectively, show the visually significant features in solid lines and the remainder of the design in broken lines. In the examples above, multiple applications could be filed that showed (1) one, two, and three rounded casing corners in solid lines and the remainder in broken lines and (2) nail buffers with one, two, and four raised pads in solid lines and the remainder in broken lines. If patents were granted on these applications (which would of course depend on the prior art), then a competitor would have a much more difficult time avoiding infringement.

Have you done an effective prior art search? One is not required before submitting a design patent application, but it certainly can help to strengthen protection. A search can determine if there are any potential primary and secondary references that may cause trouble with validity. If you know about them before filing, you can make any needed design modifications. Further, since post-*Egyptian Goddess*⁵ infringement comparisons are conducted in light of the prior art, you can get a sense of how discriminative the objective ordinary observer will be and make modifications to the design if necessary to increase the zone of protection. A typical barrier to comprehensive prior art searches is the expense, but additional free resources are continually becoming available.⁶ And the money spent for a fee-based search usually will reward you many times over.

Remember the importance of getting the design patent drawings correct before you file your application. Although solid lines may be converted to broken lines and vice versa, substantive changes made to the drawings after filing likely will be met with a new matter rejection.⁷ If the drawings must be changed, you likely will lose your original filing date, which may make your design application susceptible to additional invalidating prior art.

Keep the concept of functionality in mind when designing. Entire patented designs are rarely invalidated as being dictated by function, but individual design features will be "factored out" of the infringement analysis if they are considered functional.⁸ Is there an alternative way to design a feature that will perform the same function? If not, then be prepared for an accused infringer to claim the feature is functional and consider a redesign if possible.

Have you made sure that your design can be built as drawn? Your design may

look impressive on paper, but after the manufacturer takes a look, they may tell you certain features will need to be changed to make the manufacturing process achievable or more practical. If you have already filed for a design patent and cannot reapply with modified drawings due to prior art or other problems, then your patented design will look different from your product. The ordinary observer test requires the accused product to be compared to the patented design and not to the commercial embodiment, if different.⁹ If the changes are significant, you may have unwittingly shown your competitor an easy way to avoid infringement of the patented design. So try to get the manufacturer to confirm the design can be built as drawn before the patent application is filed.

Strike a proper balance between claiming too much and claiming too little – Many designs are claimed by illustrating the entire drawing in solid lines and by including lots of detail. This technique often helps distinguish prior art and also renders a design patent more resistant to invalidity attacks. But as mentioned above, pure solid line drawing and added detail make the patent easier to design around.

By contrast, many other designs are claimed with portion claiming techniques such as broken line claiming, illustrating only a portion of the article of manufacture, and by eliminating detail. A patent on a portion may be more difficult to obtain due to increased vulnerability to the prior art. But portion claiming also can significantly strengthen design patent protection since design portions typically are harder to design around.

The outside parameters of portion claiming usually are limited only by what the prior art will permit and what your prosecution budget will allow in terms of multiple patent applications. But the ultimate decision on how much or how little to claim will depend on many factors and your unique circumstances. Are you operating in a litigious industry and are you planning on litigating, licensing, or just using the patent for marketing? Do you plan on rolling out staged improvements over time where earlier designs will become obsolete (and you will file additional patent applications on the improvements), or is this a one-time proposition? Are there currently any products on the market that likely will infringe? Are you planning on manufacturing and selling, and what is your anticipated profit

margin and amount that can be devoted to additional prosecution and enforcement efforts? Consideration of these factors and circumstances will help determine the proper claiming approach. Finally, portion claiming can have a significant impact on your ability to obtain a preliminary injunction and to recover damages under 35 U.S.C. § 284. These topics are discussed in more detail below.

Consider filing a continuation application – Those with larger prosecution budgets can file multiple patent applications right from the start. Applicants with more modest budgets still can obtain the benefit of multiple applications and patents by filing continuation applications. A good time to consider a continuation application is after notice of allowance but before the issue fee is paid. If competitors are copying portions of your design, consider filing a continuation with a portion claim by converting non-copied features of the previously claimed design to broken lines.

Remember that design patent prosecution may be continued with a continuation application, divisional application,¹⁰ and with a continuing prosecution application.¹¹ Design patent prosecution may not be continued with a continuation in part application¹² or a request for continued examination.¹³ An added benefit of keeping an application active through continuation practice is that the design can be modified through solid/broken line conversions to capture or block competitor's design around attempts.

Consider filing for a broadening reissue – Another way to strengthen your ability to protect against competitor design around attempts is to file for a broadening reissue patent. Such an application can be filed up to two years after the patent issued. Broadening reissue patents are granted only if an error without any deceptive intention is made in a patent.¹⁴ 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."¹⁵ Remember 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.¹⁶

Be proactive on functionality – The standard for determining whether a design or design feature is ornamental or functional remains unsettled.¹⁷ However, several recent cases have used a list of factors that expands upon the strict "dictated by function" standard.¹⁸ When these factors are used in the analysis, a design patentee's actions regarding advertising, statements in related utility patents, and additional inventing can have a significant influence on the functionality determination. For example, if beneficial function of the design is advertised, consider identifying the specific feature that performs the beneficial function and do not attribute the benefit to the design as a whole. If functionality is found, such an approach could help preserve the validity of the patent and limit the functionality finding to the "factoring out" of a design feature in the infringement analysis.¹⁹

If related utility patents are being prosecuted, be mindful that functionality statements in the specification will be reviewed and considered. A utility patent specification might be a good place to explain that alternate designs do exist that can perform the same function. Finally, after the design is claimed, consider continuing to work on improving the design with alternative features that function as well or better or that can be manufactured at the same or less cost. Proof of such alternative designs can be highly persuasive evidence that the original design or design features are not functional.²⁰

Demonstrate irreparable harm and a nexus for preliminary injunctive relief – A preliminary injunction is an effective tool for immediately shutting down your competitor's infringing activities. But to obtain such an injunction, you must show among other things that you will suffer irreparable harm if the injunction is not granted and that there is a connection, or nexus, between the infringer's activities and the irreparable harm.²¹ Such a nexus can be established by showing that the product's design caused demand for the product.²²

Establishing such a nexus can be challenging. Indeed, the difficulty of establishing the general connection between product design and product demand was the reason Congress passed 35 U.S.C. 289 (providing the right to collect the infringer's profits without an apportionment requirement).²³ Remember that the more you portion claim,

the more difficult it may be to establish a nexus because the design patent will not be the same as the entire article of manufacture.²⁴

Additionally, the law in this area is underdeveloped. A more mature area of patent law that may be helpful for analogous reference is that governing the establishment of a nexus for the secondary consideration of commercial success. Of particular help may be the procedural framework requiring the patentee to make only a prima facie showing that design drove demand, after which the burden of coming forward with contrary evidence shifts to the accused infringer.²⁵ Cases also exist that explain how to raise an inference of nexus when the patented feature is only a portion of the article sold.²⁶

Make alternative arguments and preserve error

— A number of important legal principles in design patent law remain unsettled, such as the standard for proving obviousness,²⁷ the standard for proving functionality,²⁸ and whether the ordinary observer test should be conducted as a side by side comparison.²⁹ When briefing these issues, it may be tempting to argue only the approach that best supports your client's position. But consider offering argument and evidence on all alternative standards. This approach likely will be more persuasive to a court and may help uphold on appeal a favorable result regardless of how the law develops. And if you suffer an unfavorable result, then your argument and evidence on the alternative standard should be preserved for appeal.

Carefully consider your damage theories

— Design patent damages can include lost profits or a reasonable royalty under 35 U.S.C. § 284, or the infringer's profits under 35 U.S.C. § 289. Each damage approach has advantages and disadvantages and the damage theory you pursue should depend on the unique circumstances of the case. Do you have a case of willful infringement? Enhanced damages are available under § 284, but not under § 289.³⁰ Is the patented design only a portion of the product sold or might you have trouble proving that product demand and sales were driven entirely by product design? If so, then consider pursuing damages based on the infringer's profits because there is no apportionment requirement under § 289.³¹ Rather, damages will be based on the profit made on the entire product sold and can also include profits of each entity in the distribution chain. Is

the accused infringer using the product as a loss leader or otherwise making very little profit on sales? Then your own lost profits or a reasonable royalty under § 284 likely will be preferable.

Use experts — In the past some courts dismissed expert testimony based on a view that design patents were simple and the court and jury could easily serve as ordinary observers.³² But recent case law suggests that judicial acceptance and reliance on expert testimony in design patent cases is on the rise.³⁴ Potential areas for experts are infringement under the ordinary observer test and scope of the prior art, anticipation and obviousness, functionality, inventorship, inequitable conduct, indefiniteness, drafting conventions, and damages. The use of qualified experts can greatly strengthen your case, and those who do not use experts do so at their potential peril.³⁵

Keep up closely with the law

— Following *Egyptian Goddess* and the demise of the “point of novelty” test, design patent law is going through an exciting period of rapid development. Litigants and courts are developing and refining approaches and methods to both enforce design patents and to defend against infringement allegations. Design patent law is an area ripe for creativity, and those who wish to obtain the strongest form of protection are wise to carefully monitor the latest developments in the case law and literature.

ENDNOTES

1. 2012 U.S. Dist. LEXIS 88436 (N.D. Cal. June 26, 2012).
2. 2012 U.S. Dist. LEXIS 104750 (D. Ariz. July 27, 2012).
3. 2012 U.S. Dist. LEXIS 103864 (S.D.N.Y. July 24, 2012).
4. See Lisa Shuchman, *Apple-Samsung Case Shows How Far U.S. Design Patents Have Come*, Corporate Counsel, law.com (August 1, 2012) (“2 billion of the \$2.5 billion damages award Apple is seeking come from its design patents; the other \$500 million is attributable to Apple's utility patents.”).
5. 543 F.3d 665 (Fed. Cir. 2008) (en banc).
6. For example, Google Patents has recently added a prior art search button and made EU patents available, fully searchable, and automatically translated.
7. See 35 U.S.C. § 132; 37 CFR 1.121.
8. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010).
9. See *Sun Hill Indus. v. Easter Unlimited*, 48 F.3d 1193, 1196 (Fed. Cir. 1995) (“It is legal error to base an infringement finding on features of the commercial embodiment not claimed in the patent.”).
10. 37 C.F.R. § 1.53(d).

11. *Id.*
12. 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)”).
13. See 37 CFR § 1.114(e)(4).
14. 35 U.S.C. § 251.
15. MPEP § 1457.
16. See 35 U.S.C. § 252.
17. See Robert G. Oake, Jr., *Design Patent Perspective: Understanding Functionality in Design Patent Law – Part 2*, Intellectual Property Today (December 2011).
18. See, e.g., *Luv N' Care, Ltd. v. Regent Baby Prods. Corp.*, 2012 U.S. Dist. LEXIS 107085 (S.D.N.Y. July 31, 2012).
19. *Id.*
20. *Id.*
21. See *Inter v. Natural Res. Defense Council*, 555 U.S. 7, 20 (2008); *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1375 (Fed. Cir. 2009); *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1323 (Fed. Cir. 2012).
22. See *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1323 (Fed. Cir. 2012).
23. See *Nike Inc. v. Wal-Mart Stores*, 138 F.3d 1437, 1441 (Fed. Cir. 1998).
24. See *Apple, Inc. v. Samsung Elecs. Co.*, 2011 U.S. Dist. LEXIS 139049 (N.D. Cal. Dec. 2, 2011) (Court stated “evidence regarding consumer choice is even more ambiguous in light of the fact that Apple's patents do not claim the entire article of manufacture.”).
25. See, e.g., *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387 (Fed. Cir. 1988).
26. See, e.g., *Hughes Tool Co. v. Dresser Industries, Inc.*, 816 F.2d 1549, 1556 (Fed. Cir. 1987); *Railroad Dynamics, Inc. v. A. Stucki Co.*, 579 F. Supp. 353, 367 (E.D. Pa. 1983).
27. Compare *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009) with *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314 (Fed. Cir. 2012).
28. See Robert G. Oake, Jr., *Design Patent Perspective: Understanding Functionality in Design Patent Law – Part 2*, Intellectual Property Today (December 2011).
29. See *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, 2012 U.S. Dist. LEXIS 103864 (S.D.N.Y. July 24, 2012).
30. See *Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 824 (Fed. Cir. 1992).
31. See *Untermeyer v. Freund*, 58 F. 205, 212 (2d Cir. 1893); *Bergstrom v. Sears, Roebuck & Co.*, 496 F. Supp. 476, 496 (D. Minn. 1980).
32. *Id.*
33. See, e.g., *Bush Industries, Inc. v. O'Sullivan Industries, Inc.*, 772 F. Supp. 1442, 1450 (D. Del. 1991) (“expert testimony is unnecessary under the ordinary observer prong of the infringement test.”); *Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.*, 444 F.2d 295, 297-298 (9th Cir. Cal. 1970) (“There is no such need for expert testimony in litigation involving a design patent of this type where no special technological problems are

presented and the legal issues ... are particularly adapted to summary disposition.”).

34. See, e.g., *Luv N' Care, Ltd. v. Regent Baby Prods. Corp.*, 2012 U.S. Dist. LEXIS 107085 (S.D.N.Y. July 31, 2012); *Apple, Inc. v. Samsung Elecs. Co.*, 2012 U.S. Dist. LEXIS 90877 (N.D. Cal. June 29, 2012).
35. See, e.g., *Cornucopia Prods., LLC v. Dyson, Inc.*, 2012 U.S. Dist. LEXIS 104750 (D. Ariz. July 27, 2012) (Court entered preliminary injunction for Dyson based on favorable rulings on likely infringement and functionality and noted that “Cornucopia offered no witnesses at the hearing.”).