



WELCOME
May 9th 2024

Please send questions to the DesignDay@uspto.gov mailbox.



Opening Remarks

Vaishali Udupa

Commissioner of Patents

Please send questions to the DesignDay@uspto.gov mailbox.





State of the Design Technology Center

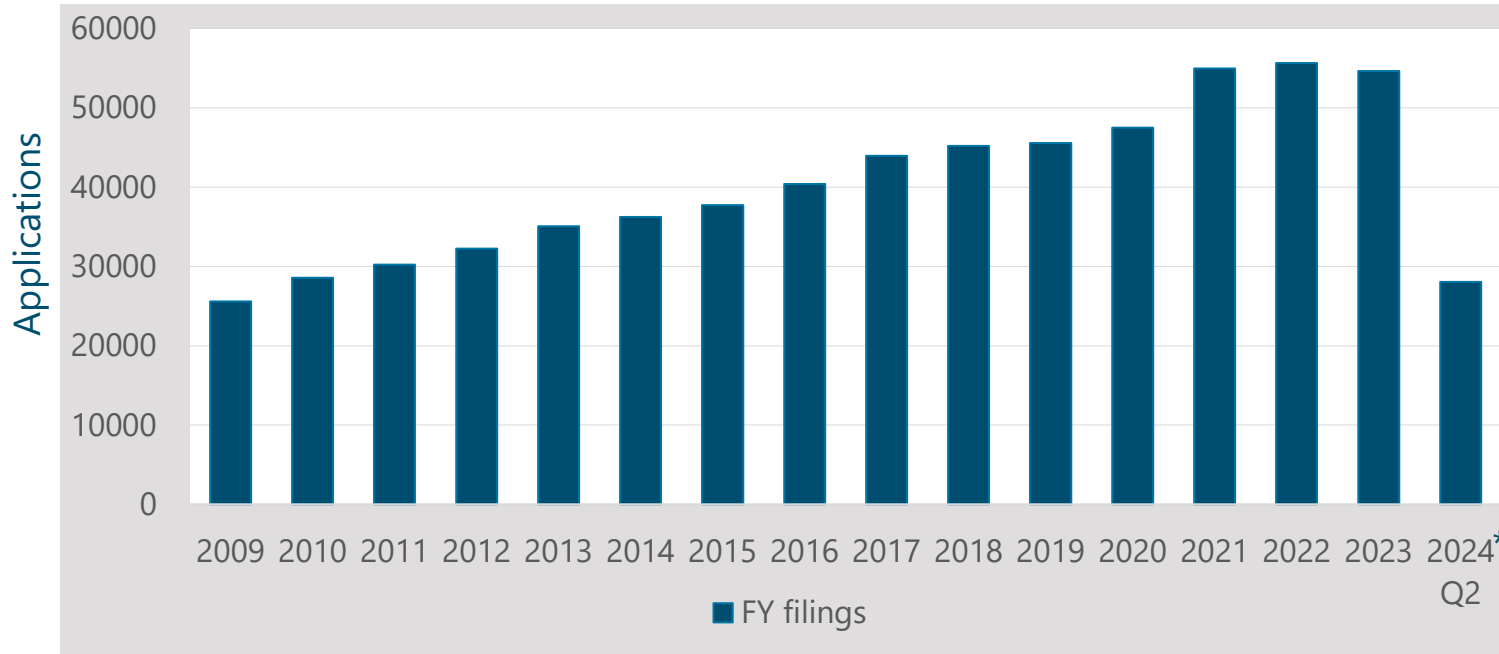
Karen M. Young

Director of Technology Center 2900

Please send questions to the DesignDay@uspto.gov mailbox.



Design filings



**Filings through fiscal year 2024 (FY24) quarter 2 (Q2) – 28,056*

Please send questions to the DesignDay@uspto.gov mailbox.

Design filings by class

CLASS	2020	2021	2022	2023	2024*	CLASS NAME
D14	2909	2852	3649	2636	2759	RECORDING, COMMUNICATION, OR INFORMATION RETRIEVAL EQUIPMENT
D06	1264	1555	1732	1553	1773	FURNISHINGS
D21	1008	1248	1422	1214	1767	GAMES, TOYS, AND SPORTS GOODS
D12	1634	1363	1751	1443	1648	TRANSPORTATION
D02	1158	1219	1259	1169	1543	APPAREL AND HABERDASHERY
D07	1037	1219	1430	1197	1463	EQUIPMENT FOR PREPARING OR SERVING FOOD OR DRINK NOT ELSEWHERE SPECIFIED
D13	1019	1066	1108	1172	1420	EQUIPMENT FOR PRODUCTION, DISTRIBUTION, OR TRANSFORMATION OF ENERGY
D24	1368	1578	1415	1243	1365	MEDICAL AND LABORATORY EQUIPMENT
D26	915	1292	1378	1166	1350	LIGHTING
D08	1063	1026	1137	1074	1271	TOOLS AND HARDWARE
D23	1093	1224	1231	1134	1220	ENVIRONMENTAL HEATING AND COOLING; FLUID HANDLING AND SANITARY EQUIPMENT
D03	726	686	819	662	772	TRAVEL GOODS AND PERSONAL BELONGINGS
D09	904	768	727	684	739	PACKAGES AND CONTAINERS FOR GOODS
D28	406	452	401	405	693	COSMETIC PRODUCTS AND TOILET ARTICLES
D15	593	587	643	580	678	MACHINES NOT ELSEWHERE SPECIFIED
D30	254	338	492	488	667	ANIMAL HUSBANDRY
D11	453	509	492	462	570	JEWELRY, SYMBOLIC INSIGNIA, AND ORNAMENTS
D10	613	585	571	546	552	MEASURING, TESTING, OR SIGNALLING INSTRUMENTS (1) (2)

Design filings by class - continued

CLASS	2020	2021	2022	2023	2024*	CLASS NAME
D16	438	577	482	444	518	PHOTOGRAPHY AND OPTICAL EQUIPMENT
D32	362	242	356	335	481	WASHING, CLEANING, OR DRYING MACHINE
D25	347	306	323	381	381	BUILDING UNITS AND CONSTRUCTION ELEMENTS
D22	246	288	320	276	377	ARMS, PYROTECHNCIS, HUNTING AND FISHING EQUIPMENT
D04	181	184	203	155	257	BRUSHWARE
D27	245	168	246	223	212	TOBACCO AND SMOKERS' SUPPLIES
D34	178	161	170	158	183	MATERIAL OR ARTICLE HANDLING EQUIPMENT
D19	175	194	267	194	169	OFFICE SUPPLIES; ARTISTS` AND TEACHERS` MATERIALS
D99	72	108	104	66	151	MISCELLANEOUS
D29	129	164	127	126	117	EQUIPMENT FOR SAFETY, PROTECTION, AND RESCUE (1)
D18	119	102	109	89	106	PRINTING AND OFFICE MACHINERY
D20	84	105	76	60	70	SALES AND ADVERTISING EQUIPMENT
D01	72	212	61	68	67	EDIBLE PRODUCTS
D17	64	71	64	47	57	MUSICAL INSTRUMENTS
D05	84	45	42	35	22	TEXTILE OR PAPER YARD GOODS; SHEET MATERIAL

* Filings through FY24 Q2

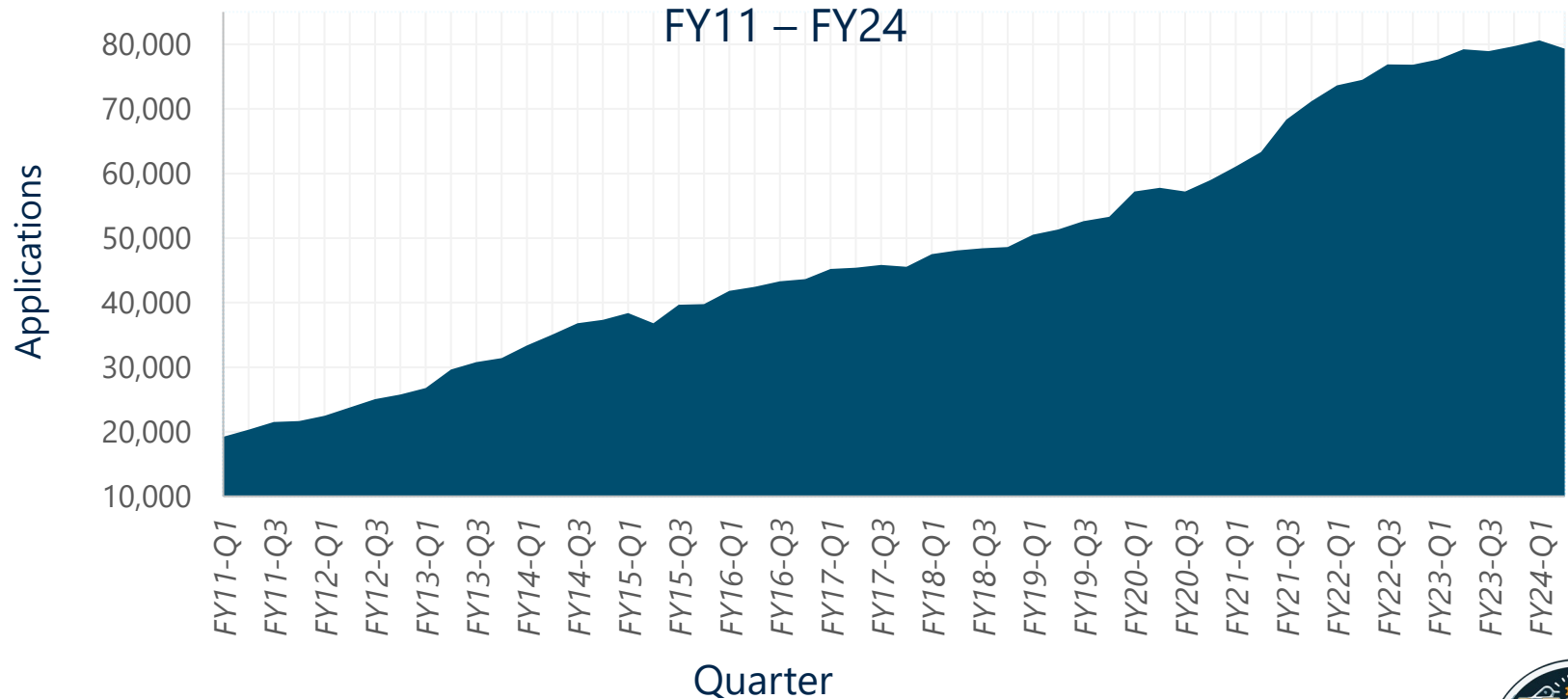
Please send questions to the DesignDay@uspto.gov mailbox.



Intellectual Property Owners Association

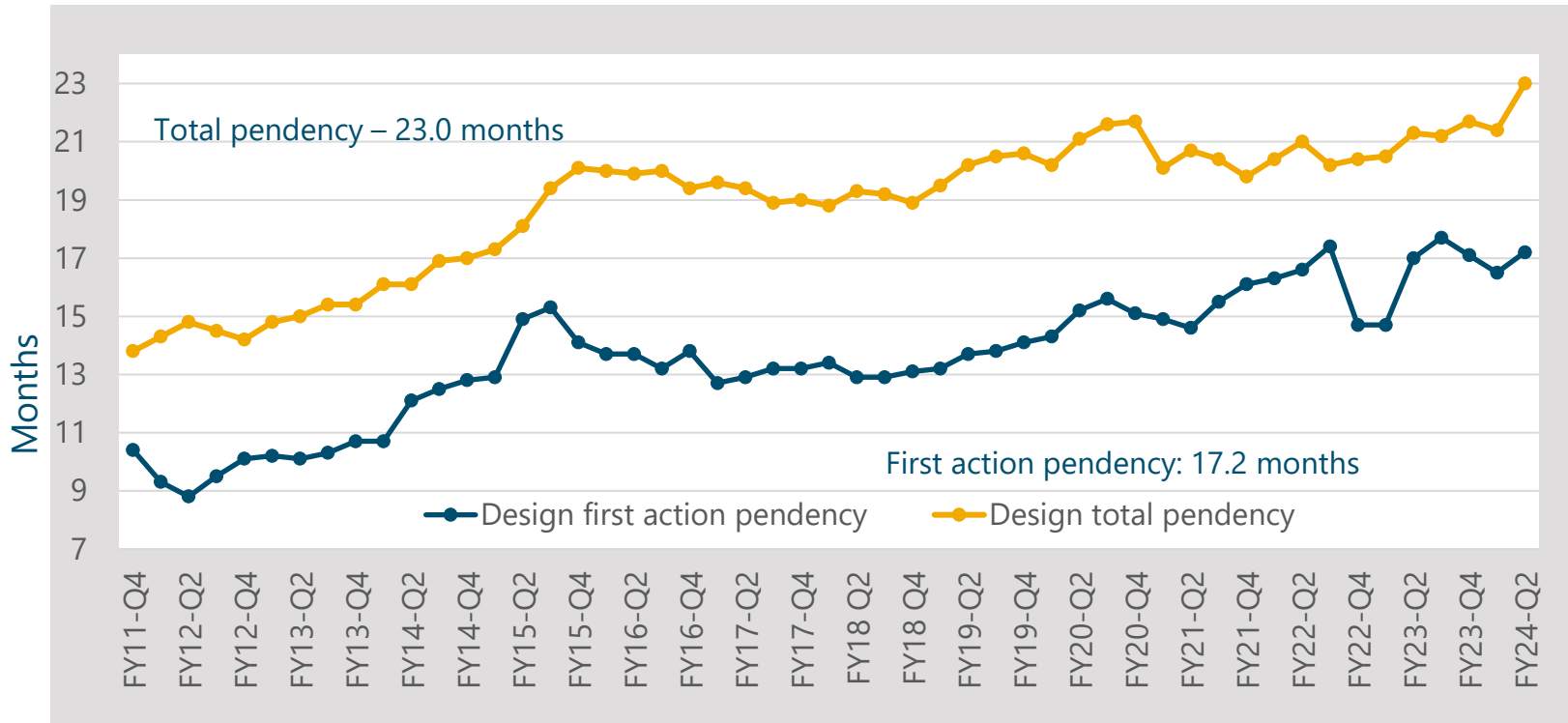


Design unexamined application inventory



Please send questions to the DesignDay@uspto.gov mailbox.

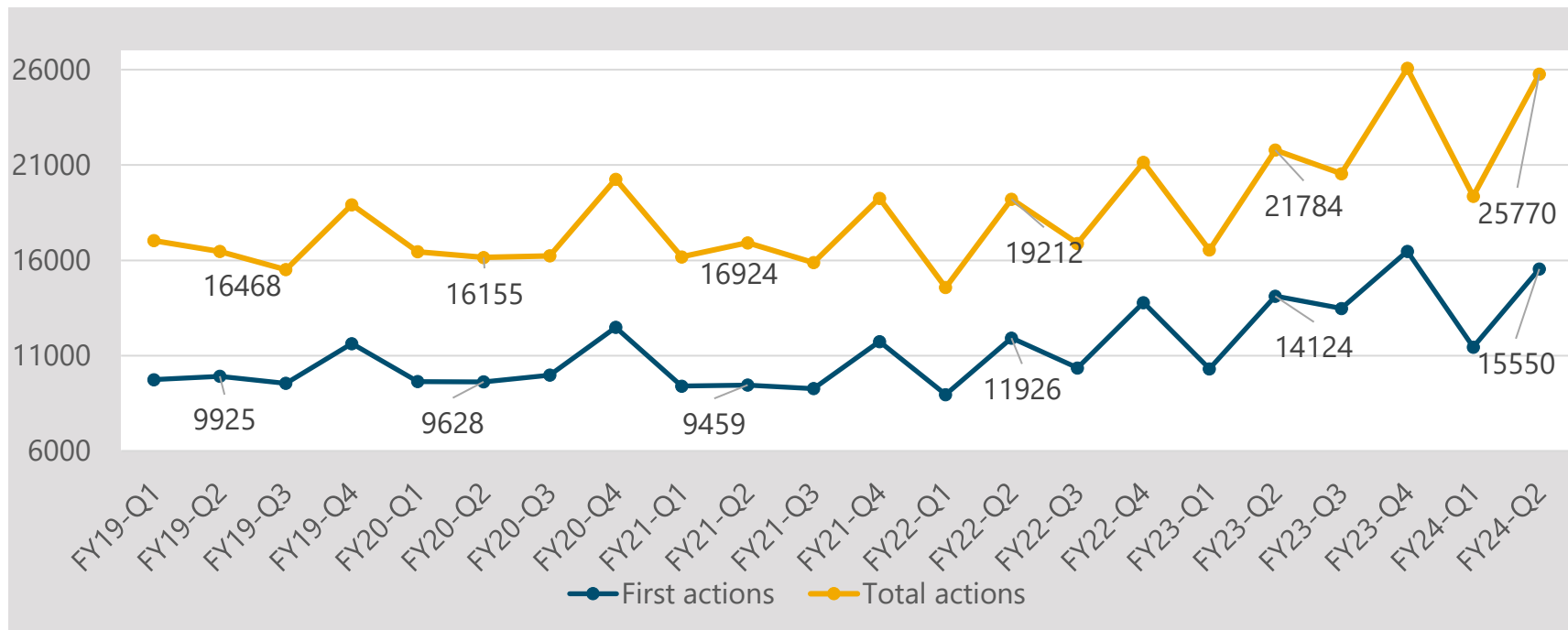
First action and total pendency



First actions – 26,998*
 Total actions – 45,135*
 *cumulative FY 24 totals

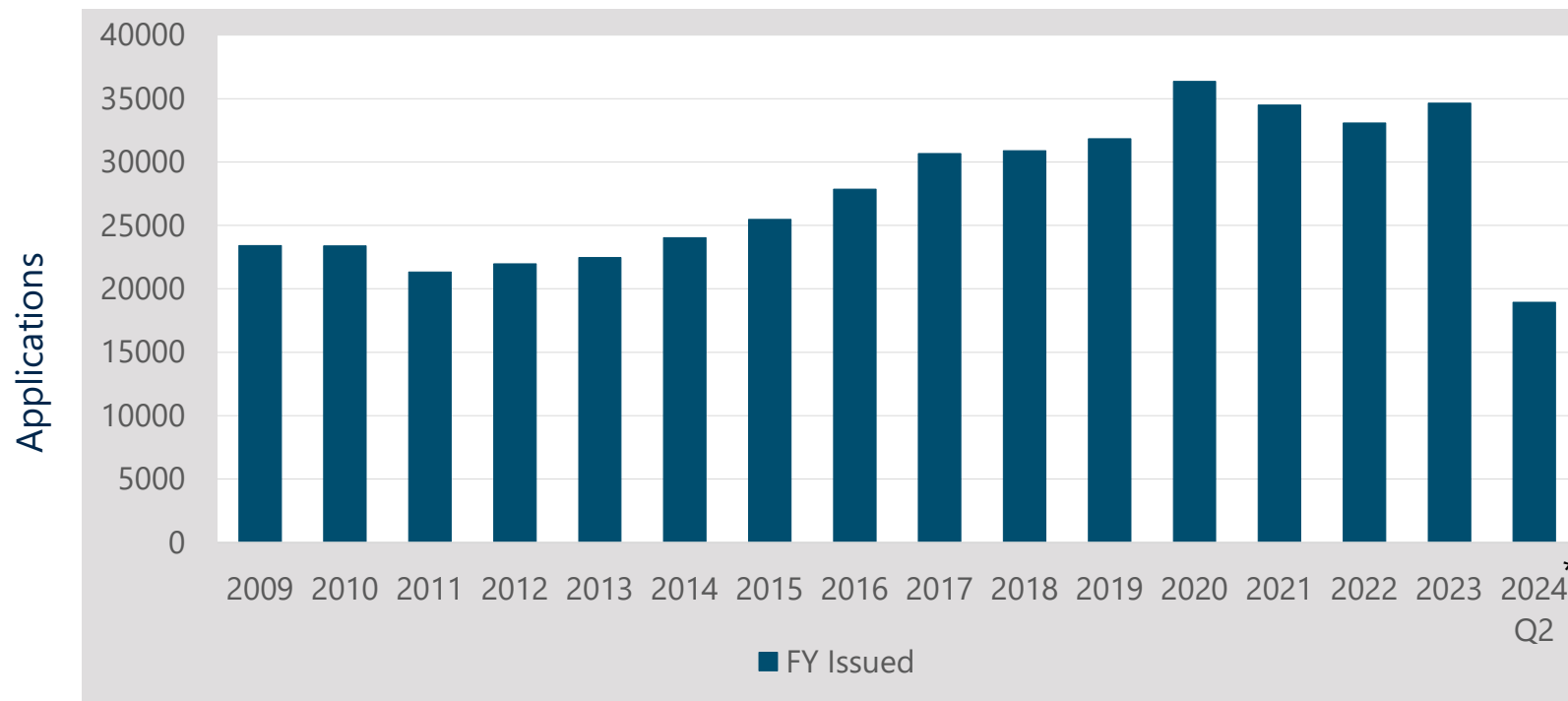


First action and total actions



Please send questions to the DesignDay@uspto.gov mailbox.

Design patents issued



**Through FY24 Q2*

Please send questions to the DesignDay@uspto.gov mailbox.



Intellectual Property Owners Association



Yearly Hague applications

Fiscal year	Number of applications received by USPTO
2024	1,913*
2023	3,197
2022	2,705
2021	2,248
2020	2,988

**Through FY24 Q2*

Please send questions to the DesignDay@uspto.gov mailbox.



FY 2024* first office actions by type

U.S. design applications

<u>Type of action</u>	<u>Percent</u>
1st action rejection	38%
1st action allowance	39%
1st action restriction	8%
1st action Quayle	15%

Hague applications

<u>Type of action</u>	<u>Percent</u>
1st action rejection	41%
1st action allowance	27%
1st action restriction	21%
1st action Quayle	11%

**Through FY24 Q2*

Please send questions to the DesignDay@uspto.gov mailbox.



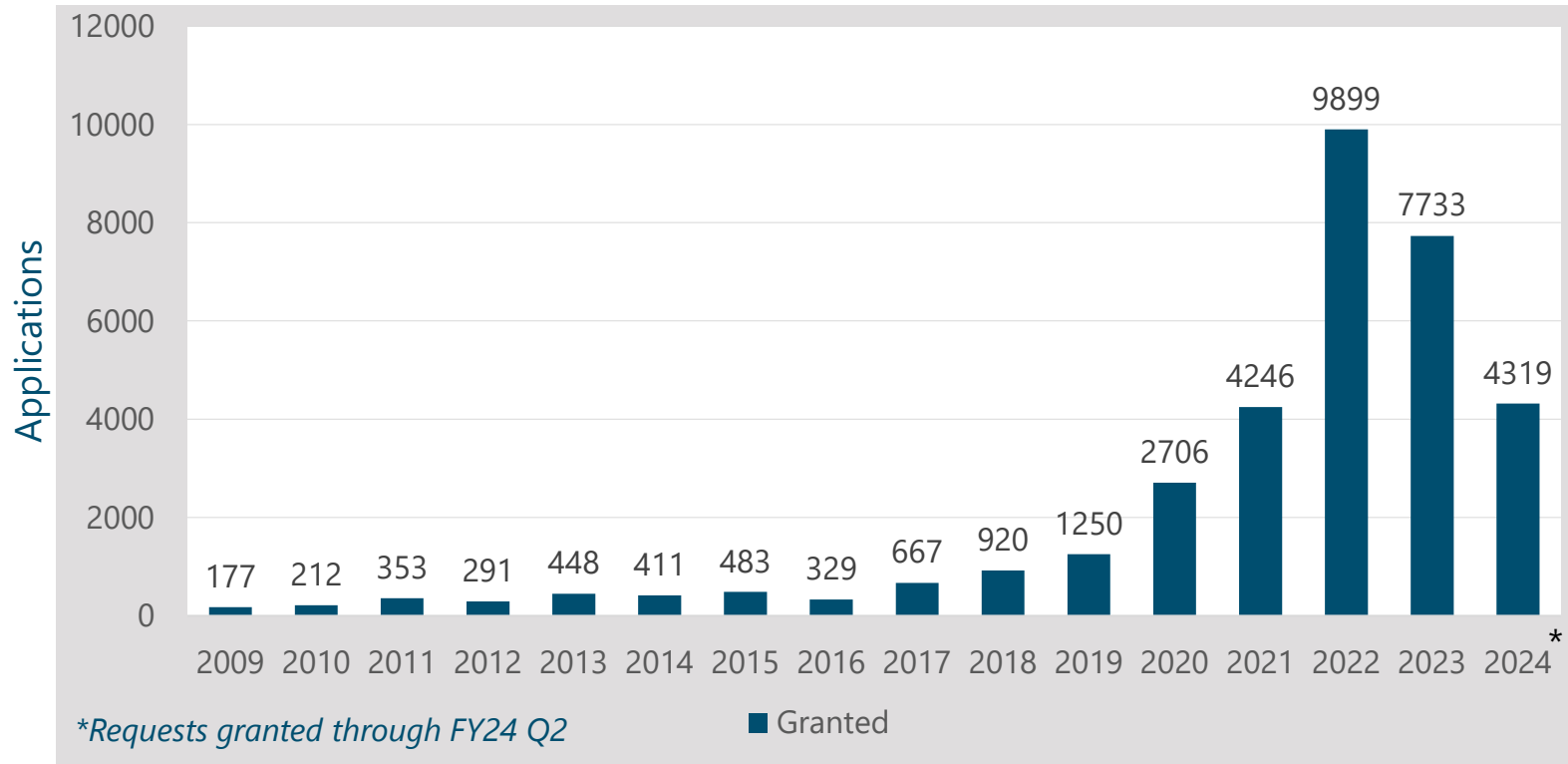
Rocket Docket

- Establishes an expedited procedure for design applications under 37 CFR 1.155, including applications filed via the Hague system
- Examined with priority and undergo expedited processing through the entire course of prosecution in the office

Please send questions to the DesignDay@uspto.gov mailbox.



Rocket Docket requests



Please send questions to the DesignDay@uspto.gov mailbox.



Attribute time

- Attribute time related to Hague and Rocket Docket cases accounts for a significant portion of available examining resources – about 8% of current capacity

FISCAL YEAR	HAGUE HOURS	ROCKET DOCKET HOURS
2021	7437	11271
2022	7359	24516
2023	8613	25689
2024*	4785	12675

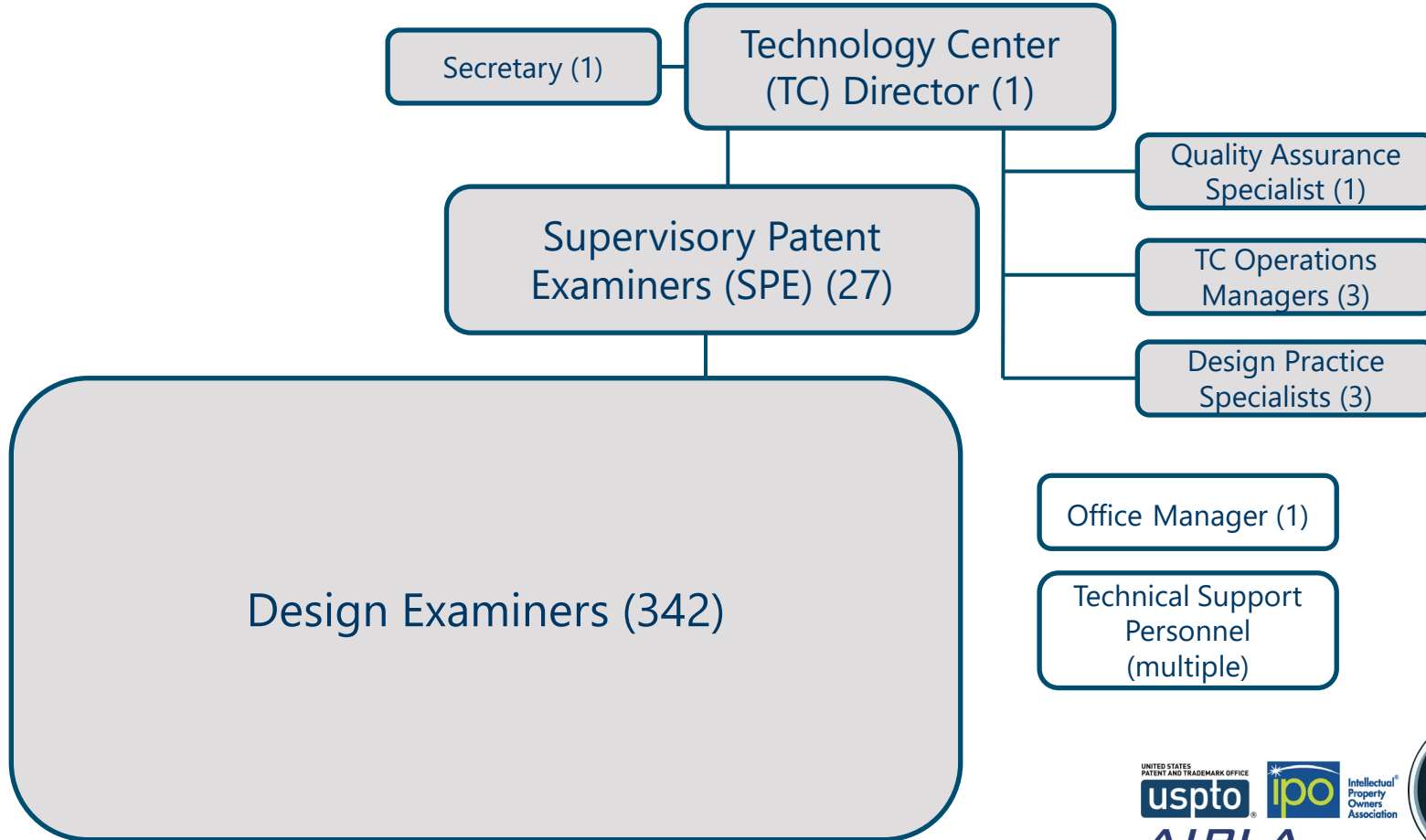
**Attribute hours through FY24 Q2*

Please send questions to the DesignDay@uspto.gov mailbox.



Design staffing*

*as of May 9, 2024



Examiner experience level

Experience level	Number of examiners
GS-14	112
GS-13	15
GS-12	25
GS-11	56
GS-9	64
GS-7	70

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Now hiring design examiners!

- Total number of design examiners has increased 68% from FY20 to FY24, from 204 to 342

Fiscal year	Examiners hired
2024	29*
2023	58
2022	82
2021	46
2020	38

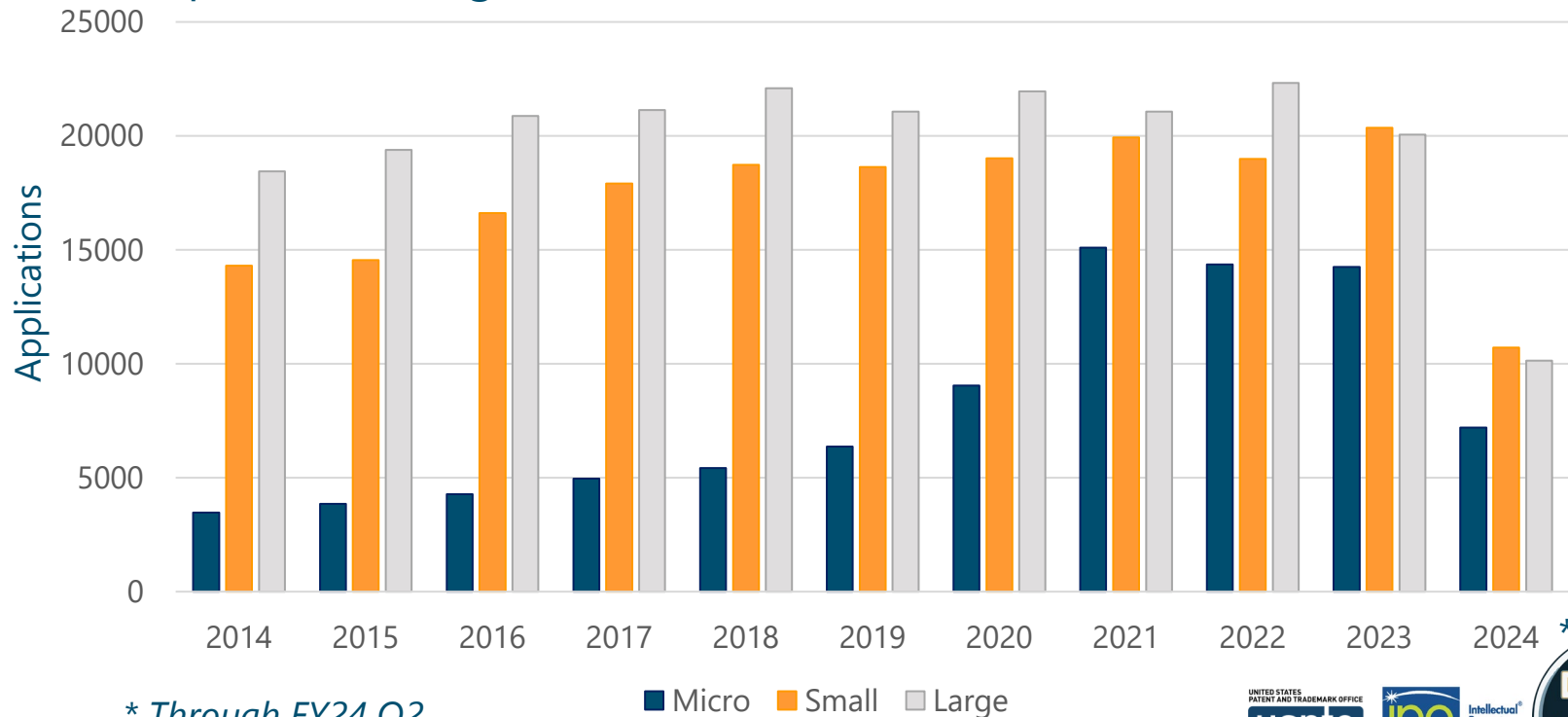
**hirings through FY24 Q2*

Please send questions to the DesignDay@uspto.gov mailbox.



Filings by entity status

- Micro entity status filings has shown a gradual increase over time since its inception, reaching record levels in FY 2021.

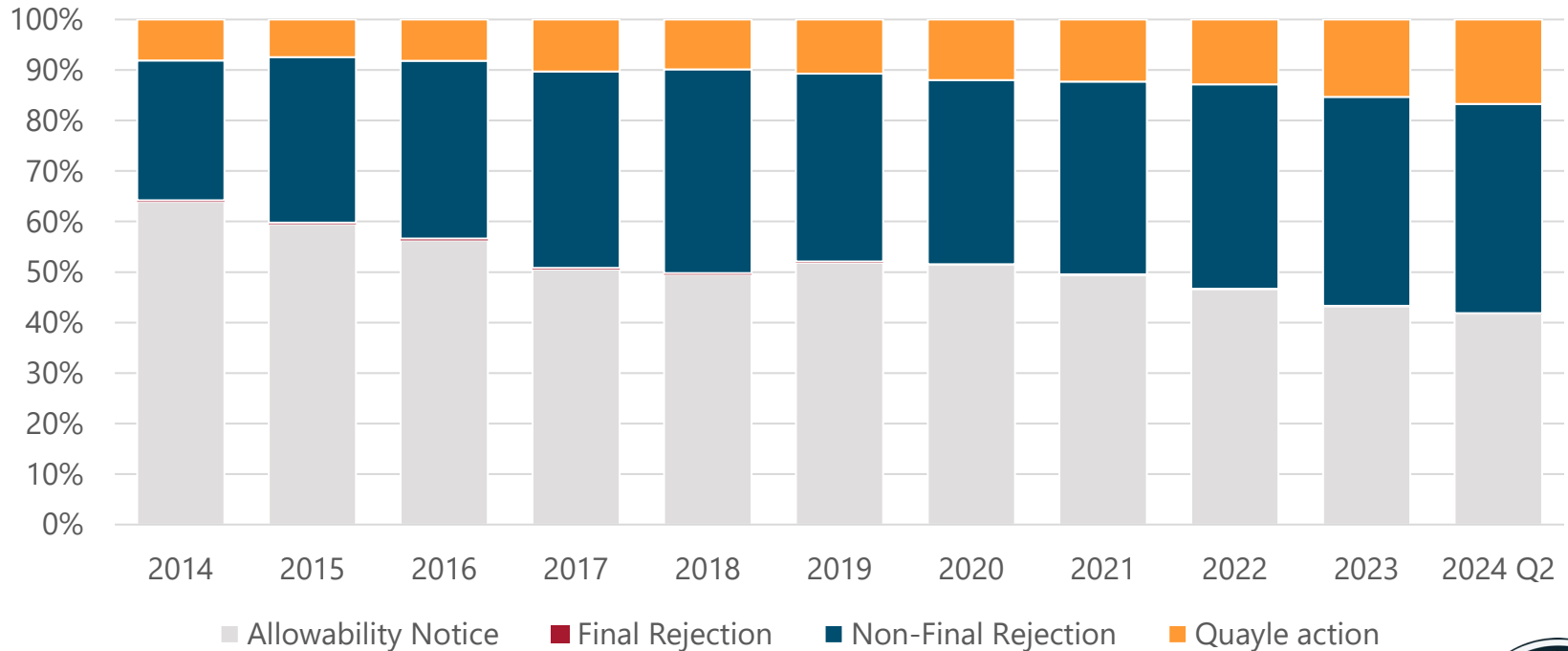


* Through FY24 Q2

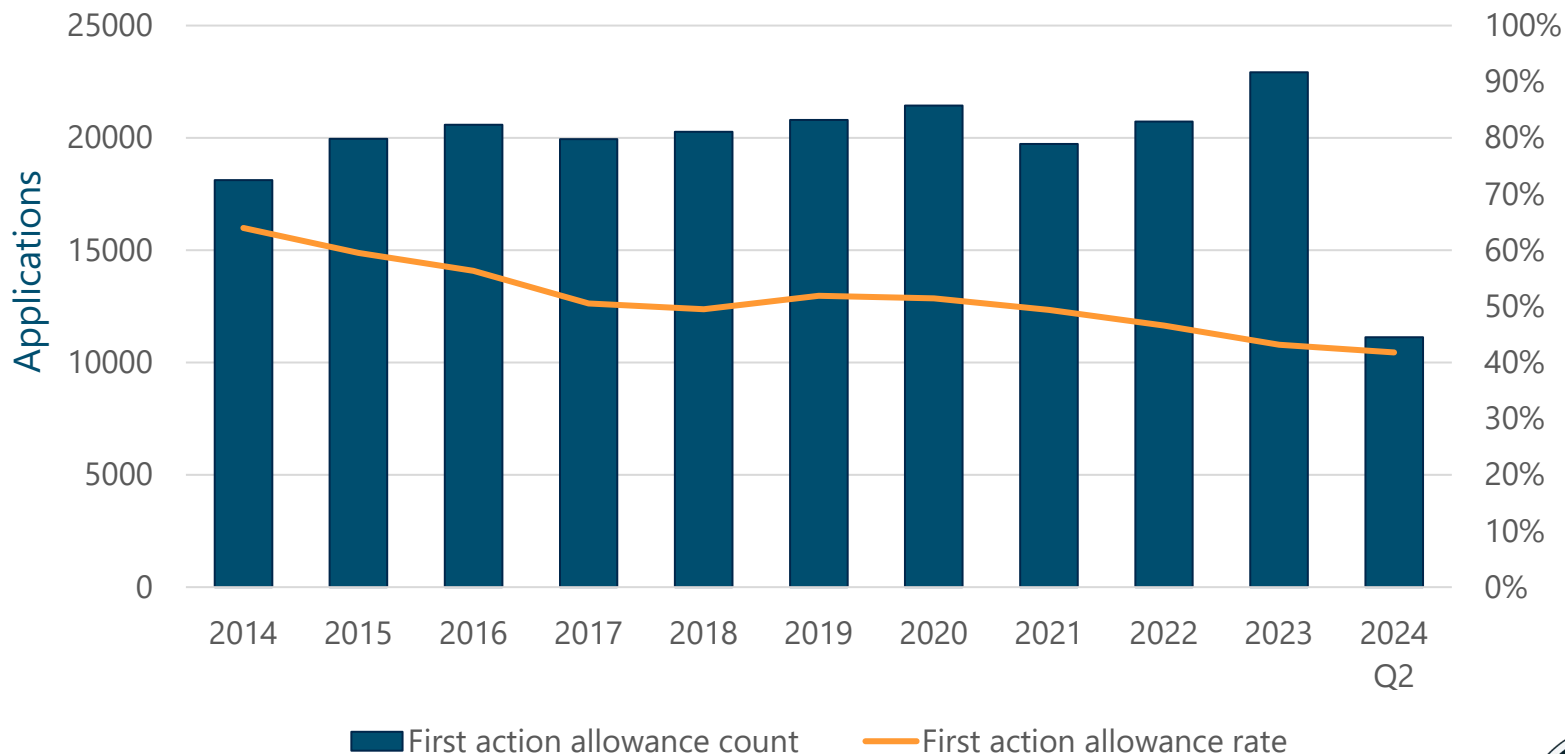
■ Micro ■ Small ■ Large

First actions by action type

% of total



First action allowance rate



One million design patents issued!



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Intellectual Property Owners' Association





New Design Patent Practitioner Bar

Kerith Kanaber

Partner, Registered Patent
Attorney

Dorsey+Whitney LLP



Qualifications

- Applications accepted starting January 2, 2024
- What you need:
 - Category D Degree- Degree from an accredited college or university in: Art teacher education, fine/studio arts, applied arts, graphic design, architecture, product design or industrial design
 - Application and fees
 - Pass the registration exam
 - Pass a moral character evaluation
- What you don't need
 - A JD/law degree



Take-Aways

- Registered to practice before the USPTO in design patent matters only
- Same registration examination
- Practitioners are required to inform the USPTO and clients of their limited representation
- Registration number is a new, separate design patent practitioner series number
- Already admitted to the patent bar? No change needed.
- **Caution:** USPTO Customer Number



**Questions?
Thank you!**

**Kerith Kanaber
Kanaber.Kerith@Dorsey.com**



Searching Designs

George Raynal
Saidman Design Law Group

SEARCHING DESIGNS

Design Day 2024

Searching Designs

- Taking a look at the USPTO's New Search Tools
 - Trademark Search System for Trade Dress
 - Patent Public Search for Design Patents
- Exploring broader landscape of resources to discover design information from the USPTO and INTERNATIONALLY
 - Searching For Issued Design Patents and Registrations
 - Classification
 - Guidelines
 - Gazette or Journal
 - Decisions on Patentability / Registration
 - Decisions on Validity (IPR, PGR, Reexam)
 - Laws and Changes
 - Notices

Other areas for future consideration (not today)

- Trademarks
- Copyright
- District Court Litigation and Appeals
- Customs
 - Recordation
 - ITC 337 Investigations

Searching Designs

Exploring broader landscape of resources to discover design information from the **USPTO** and **INTERNATIONALLY**

Search

Guide

Laws and Changes

Decisions
Patentability
Validity

Gazette / Journal

EXAMPLE: UK →

Searching Designs



United Kingdom

As of January 31, 2020, the UK is no longer a member of the European Union, and design protection in the UK requires a separate, direct filing.

Searching Designs



Search

United Kingdom

Guide



Searching Designs



Design Decisions

United Kingdom

Journal



Searching Designs

Laws and Changes



United Kingdom

A screenshot of the GOV.UK website. The page title is "Registered Designs Act and Rules". The main heading is "Registered Designs Act and Rules". Below the heading, there is a paragraph: "The Registered Designs Act 1949 is the current law for the registration of designs and the protection of registered designs in the UK." There is a search bar with the text "GOV.UK" and a search icon. Below the search bar, there are two sections: "Documents" and "Related content". The "Documents" section contains two items: "Unified consolidated version of the Act" and "Unified consolidated version of the rules". The "Related content" section contains several links: "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group", "Design Law Group".

Searching Designs



United States

- ▶ Taking a look at the USPTO's New Search Tools
 - ▶ Trademark Search for Product Configuration Trade Dress
 - ▶ Choose "Expert"
 - ▶ Search Mark Description for "Configuration"
 - ▶ Select registered, deselect pending and dead
 - ▶ Sort by descending serial number 9-0
 - ▶ Screen for
 - ▶ Logos
 - ▶ Product Packaging
 - ▶ Configurations
 - ▶ Principal Register
 - ▶ Supplemental Register

Searching Designs

uspto Trademark Search

Mark description: configuration
















6,036 results for configuration

Live 6,036
Registered
Pending
Dead
Cancelled
Abandoned

Class filter: Courtroom

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31 32 33 34 35 36 37 38 39 40 41 42 43 44 45 A 000

Sort: Relevance

 Wordmark Status: LIVE REGISTERED Goods & services IC 012: Wheel rims, wheel rims for automobiles, vehicle wheel rims. Class 012 Serial 96080310 Owners Kim David (INDIVIDUAL, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 003: Dishwashing preparations; dishwashing detergents; cleaning... Class 003 Serial 96056601 Owners Beckitt Benelux Finis B.V./BEI SLOTEN VENNOOTSCHAP (B.V.) NETHERLANDS	 Wordmark Status: LIVE REGISTERED Goods & services IC 001: chemical reagents for analytical and diagnostic purposes... Class 001, 009 Serial 96036025 Owners DSM IP Assets B.V./Slooten vennootschap b.v. NETHERLANDS	 Wordmark Status: LIVE REGISTERED Goods & services IC 035: Charitable services, namely, coordination of non-monetary... Class 035, 036 Serial 96083390 Owners KENDRA SCOTT, LLC (LIMITED LIABILITY COMPANY, TENNESSEE, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 041: Educational programs, namely, preschool, excluding... Class 041 Serial 97976653 Owners Cadence Education, LLC (LIMITED LIABILITY COMPANY, DELAWARE, USA)
 Wordmark Status: LIVE REGISTERED Goods & services IC 010: Portable hand-held utensils; Disposable portable hand-held... Class 010 Serial 97917812 Owners Conserve Printing Corporation (CORPORATION, CALIFORNIA, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 021: Insulated and non-insulated steel (stl) containers. Class 021 Serial 97866627 Owners Pacific Market International, LLC (LIMITED LIABILITY COMPANY, WASHINGTON, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 035: Retail bakery shops featuring bakery goods and beverages. Class 035 Serial 97902965 Owners IMAGINATION HOLDING, LLC (LIMITED LIABILITY COMPANY, NEVADA, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 030: Bakery products. Class 030 Serial 97880055 Owners Binus Bakeries USA, Inc. (CORPORATION, DELAWARE, USA)	 Wordmark Status: LIVE REGISTERED Goods & services IC 032: Distilled blue agave liquor. Class 032 Serial 97880910 Owners El Grande, LLC (LIMITED LIABILITY COMPANY, TEXAS, USA)
 Wordmark Status: LIVE REGISTERED Goods & services IC 008: Sound reproducing apparatus; audio speakers; earphones...	 Wordmark Status: LIVE REGISTERED Goods & services IC 030: Cookies, brownies, cakes.	 Wordmark Status: LIVE REGISTERED Goods & services IC 015: Acoustic guitars.	 Wordmark Status: LIVE REGISTERED Goods & services IC 020: Beer, ale and lager; Draft beer.	 Wordmark Status: LIVE REGISTERED Goods & services IC 035: On-line retail store services featuring books... IC 041: Book...

Searching Designs

▶ Taking a look at the USPTO's New Search Tools



▶ Trade Dress Registration

▶ Packaging Configuration

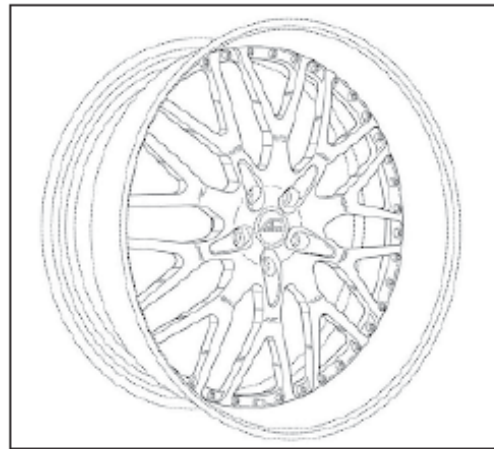
- ▶ Can be inherently distinctive; must be unique for goods if unique for the goods

Searching Designs

▶ Taking a look at the USPTO's New Search Tools



The screenshot shows the USPTO TSDR interface. At the top, there are navigation tabs for Patents, Trademarks, and Learning and Resources. Below that, there's a search bar with a search button. The main content area displays search results for a wheel design. On the left, there's a sidebar with navigation links like 'Mark Information', 'Goods and Services', 'Basic Information (Clear Layer)', etc. The main content area shows details for a specific trademark, including the US Serial Number (0895218), Registration Number (701122), and Application Filing Date (Nov. 11, 2010). There's also a small image of the wheel design in the top right corner of the search results area.



Register: Supplemental

- ▶ Trade Dress Registration
 - ▶ Product Configuration
 - ▶ Non-functional
 - ▶ Acquired distinctiveness

Searching Designs

Decision on Registration

Refusal to register trade dress affirmed by Fourth Circuit

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 23-1150

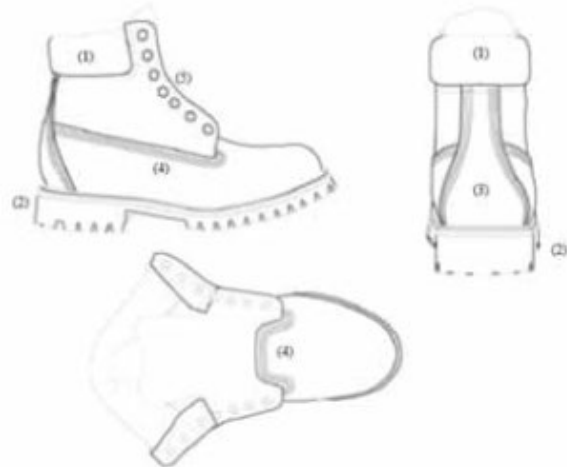
TBL LICENSING, LLC,

Plaintiff - Appellant,

v.

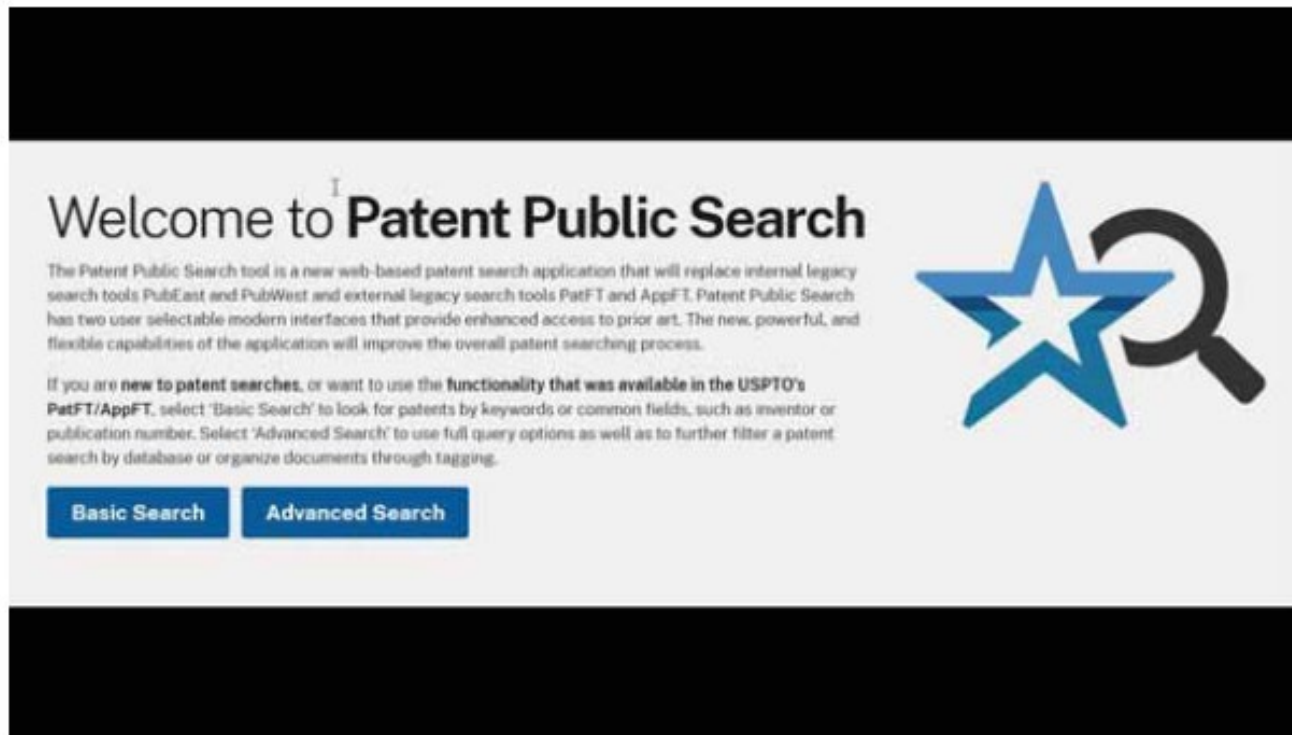
KATHERINE K. VIDAL, in her official capacity as Director of the United States
Patent & Trademark Office; UNITED STATES PATENT & TRADEMARK
OFFICE,

Defendants - Appellees.



Searching Designs

- Taking a look at the USPTO's New Search Tools
 - Patent Public Search for Design Patents




Welcome to ¹Patent Public Search

The Patent Public Search tool is a new web-based patent search application that will replace internal legacy search tools PubEast and PubWest and external legacy search tools PatFT and AppFT. Patent Public Search has two user selectable modern interfaces that provide enhanced access to prior art. The new, powerful, and flexible capabilities of the application will improve the overall patent searching process.

If you are **new to patent searches**, or want to use the **functionality that was available in the USPTO's PatFT/AppFT**, select 'Basic Search' to look for patents by keywords or common fields, such as inventor or publication number. Select 'Advanced Search' to use full query options as well as to further filter a patent search by database or organize documents through tagging.

[Basic Search](#) [Advanced Search](#)



<https://www.youtube.com/watch?v=np8RKbVMSLg>

Searching Designs

USPTO

Patent Public Search

Welcome to Patent Public Search

The Patent Public Search tool is a new web-based patent search application that will replace internal legacy search tools PubEasr and PubWest and external legacy search tools PatFT and AppFT. Patent Public Search has two user-selectable modern interfaces that provide enhanced access to prior art. The new, powerful, and flexible capabilities of the application will improve the overall patent searching process.

If you are new to patent searching, or want to use the functionality that was available in the USPTO's PatFT/AppFT, select "Basic Search" to look for patents by keywords or common fields, such as inventor, publication number. Select "Advanced Search" to use full query options as well as to further refine your search by database or organize documents through tagging.

[Basic Search](#) [Advanced Search](#)

Help
Information and support

FAQs
Access to frequently asked questions

Training materials
Learn about Patent Public Search features and functionalities

Searching Designs

Toggle for images

s.kd.

The screenshot displays a patent search interface. On the left, a search results table lists various patent entries. The top entry is highlighted, corresponding to the detailed view on the right. The detailed view shows the patent's title, document ID, date published, inventor information, application number, date filed, domestic priority data, and current CPC classifications.

Search	Res.	A	T	E	S	A	S	Document ID	Date Published	Family ID	Pages	Title
<input checked="" type="checkbox"/>	1	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23	1000070	9	Noise guard
<input type="checkbox"/>	2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23	1000070	17	Low profile slope
<input type="checkbox"/>	3	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23	1000070	15	Kitchen island
<input type="checkbox"/>	4	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23	1000070	9	Confederately coated container
<input type="checkbox"/>	5	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		7	Tool for clearing an espresso machine drip tray
<input type="checkbox"/>	6	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		10	Television bracket
<input type="checkbox"/>	7	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		8	Shoe heel
<input type="checkbox"/>	8	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		12	Computer unit
<input type="checkbox"/>	9	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		26	Rolling brush for a cleaning robot
<input type="checkbox"/>	10	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		10	Substrate of a modular equipment for distribution
<input type="checkbox"/>	11	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		11	Watch
<input type="checkbox"/>	12	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		8	Pitch mark repair and tee height measurement device
<input type="checkbox"/>	13	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		10	Closure for containers
<input type="checkbox"/>	14	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		8	Television apparatus
<input type="checkbox"/>	15	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		8	Tool
<input type="checkbox"/>	16	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20240423	2024-04-23		4	Search device for a document

Noise Guard
DOCUMENT ID: US 20240423
DATE PUBLISHED: 2024-04-23

INVENTOR INFORMATION

NAME	CITY	STATE	ZIP CODE	COUNTRY
Orrington, E. James L.	Flowermead	IL	N/A	US
Orrington-Moore, Janis	Tempo-Haute	IN	N/A	US
Henny, Sharril Marie	Crystal Lake	IL	N/A	US

APPLICATION NO: 0488888
DATE FILED: 2023-04-05

DOMESTIC PRIORITY (CONTINUITY DATA)
continuation patent doc US 1794233 20221126 PENDING ind-doc US 2009888
continuation patent doc US 1794233 20221126 PENDING ind-doc US 1794233

US CLASS CURRENT
2024-04-23

CPC CURRENT

TYPE	CPC	DATE
CPC	A62B 2308	2013-01-01
CPC	B01D 48/16	2013-01-01
CPC	A61L 5/20	2013-01-01
CPC	A61L 9/04	2013-01-01
CPC	B01D 48/0041	2013-01-01
CPC	B01D 48/0049	2013-01-01
CPC	B01D 53/04	2013-01-01
CPC	B01D 53/0528	2013-01-01
CPC	B01D 48/0028	2013-01-01
CPC	A61L 21/02	2013-01-01
CPC	A62B 9/00	2013-01-01
CPC	A61L 22/012	2013-01-01
CPC	B01D 22/52	2013-01-01
CPC	B01D 22/5791	2013-01-01
CPC	B01D 22/5798	2013-01-01
CPC	N02J 7/6042	2013-01-01
CPC	A61M 2017/0016	2013-01-01
CPC	B01D 20/708	2013-01-01
CPC	H02J 7/0062	2013-01-01
CPC	A61L 22/0815	2013-01-01
CPC	A61L 22/0214	2013-01-01

Description
(1) FIG. 1 is a perspective view of an embodiment of a noise guard.

Searching Designs

The image shows a computer screen displaying the USPTO Patent Public Search interface. The browser address bar shows <https://pubs.uspto.gov/publicsearch/>.

Search Results

Result	Doc. No.	Date	Class	Document ID	Date Patent	Family ID	Pages	Title
1	US 01324232 S	2024-04-23	53000075	0	2024-04-23	53000075	6	New guard
2	US 01324232 S	2024-04-23	53000075	17	2024-04-23	53000075	17	Low profile sleeve
3	US 01323695 S	2024-04-23	53000075	15	2024-04-23	53000075	15	Kitchen utensil
4	US 01323694 S	2024-04-23	53000075	5	2024-04-23	53000075	5	Confectionary-coated container
5	US 01324475 S	2024-04-23		7	2024-04-23		7	Tool for cleaning an espresso machine drip tray
6	US 01322980 S	2024-04-23		10	2024-04-23		10	Television receiver
7	US 01322936 S	2024-04-23		8	2024-04-23		8	Shoe heel
8	US 01324058 S	2024-04-23		12	2024-04-23		12	Computer unit
9	US 01324489 S	2024-04-23		26	2024-04-23		26	Rolling brush for a cleaning robot
10	US 01323691 S	2024-04-23		10	2024-04-23		10	Boxtype of a medical equipment for distribution
11	US 01322793 S	2024-04-23		11	2024-04-23		11	Watch
12	US 01324244 S	2024-04-23		6	2024-04-23		6	Pitch-mark repairer and toe height measurement de
13	US 01323752 S	2024-04-23		10	2024-04-23		10	Closure for containers
14	US 01323891 S	2024-04-23		6	2024-04-23		6	Television apparatus
15	US 01324250 S	2024-04-23		6	2024-04-23		6	Tool
16	US 01324250 S	2024-04-23		6	2024-04-23		6	Tool

Document Viewer: United States Design Patent

United States Design Patent Patent No.: **US D1,824,333 S**
Orrington, II et al. Date of Patent: **Apr. 23, 2024**

Applicant: **Jason C. Orrington II et al.**, Chicago, IL, US

Inventor: **Jason C. Orrington II, Christopher D. Orrington, III, Jacob A. Orrington-Waters, Terry Orrington, IV, David A. Orrington, Mark Orrington**, Chicago, IL, US

Pub. No.: **2024/009,889**

Pub. Date: **Apr. 9, 2024**

Class. Int. Cl.: **H01L 25/00**

Abstract: **Embodiments of a new guard for a new guard, and a comparison of applications No. 17,000,000 and No. 1,300,000.**

References Cited

U.S. PATENT DOCUMENTS

2024/009,889 A1	2024/009,889 A1
2024/009,889 A1	2024/009,889 A1
2024/009,889 A1	2024/009,889 A1
2024/009,889 A1	2024/009,889 A1
2024/009,889 A1	2024/009,889 A1

Claims

The ornamental design for a new guard as shown and described.

Drawings

FIG. 1 is a perspective view of an ornamental design for a new guard.

FIG. 2 is an alternative perspective view of the new guard of FIG. 1.

FIG. 3 is a front elevation view of the new guard of FIG. 1.

FIG. 4 is a top elevation view of the new guard of FIG. 1.

FIG. 5 is a right side elevation view of the new guard of FIG. 1.

FIG. 6 is a left side elevation view of the new guard of FIG. 1.

FIG. 7 is a top plan view of the new guard of FIG. 1, and

FIG. 8 is a front elevation view of the new guard of FIG. 1, in the alternate top feature form for the purpose of illustrating portion of the new guard that has not yet been described.




FIG. 1 and FIG. 2 are perspective views of the new guard.

Searchable Indexes

The screenshot shows the USPTO Patent Public Search interface. On the left is a navigation menu with links for Training materials, References, Searchable indexes, Inventions, Reference material, Case records, and a link to compare Full-Text (PubMED) and Patent Public Search. The main content area is titled 'References' and 'Searchable Indexes'. It contains a paragraph explaining that the following table lists searchable indexes supported by Patent Public Search for the U.S. Patents Full-Text Database, with the INDEX column providing the search index abbreviation for use in the Freedom command line. Below this is a note that range searching can be done on indexes that have indexed numerical data, with an example: `gdt=20080101-20090101`. The table below lists 13 indexes with their descriptive names, formats, comments, and availability in USPAT, PUBM, and USOFC databases.

References

Searchable Indexes

The following table contains the searchable indexes supported by Patent Public Search for the U.S. Patents Full-Text Database. The INDEX column contains the searchable index abbreviation to use in the Freedom command line.

Range searching can be done on indexes that have indexed numerical data.

An example: `gdt=20080101-20090101`

INDEX	Descriptive name	Format	Comment	USPAT	PUBM	USOFC
AACI	Applicant City	pho:delphia.AACI		X	X	X
AACD	Applicant Country	US.AACD	Two letter country code	X	X	X
AAD	Applicant Date	pho:delphia.AAD	Composite field searches Applicant name, city, state and country	X	X	X
AADP	Applicant Period	research.AADP		X	X	X
AANM	Applicant Name	gs.AANM		X	X	X
AAST	Applicant State	PA.AAST	Two letter state code	X	X	X
AB	Abstract	method.AB		X	X	
ABO	Equivalent Abstract Text Abstract	synthesis.ABO	ABO returns same result as plus AB for FIT database	X		
ABPN	Abstract	synthesis.ABPN	ABPN returns same result as plus AB for FIT, USPAT databases	X		X
ABME	Abstract	synthesis.ABME	ABME returns same result as plus AB for FIT and USPAT databases	X		X
ABPW	Abstract	synthesis.ABPW	ABPW returns same result as plus AB for FIT and USPAT databases	X		X

Searching Designs

Common Searchable Indices

s.kd.

s.at.

__.in.

__.as.

__.aanm.

__.py.

Design Patents

Inventor Name

Assignee

Applicant

Year

__.atty.

fr.prc.

__.art.

__.ti.

D__ / __.ccls.

Firm

Foreign Priority

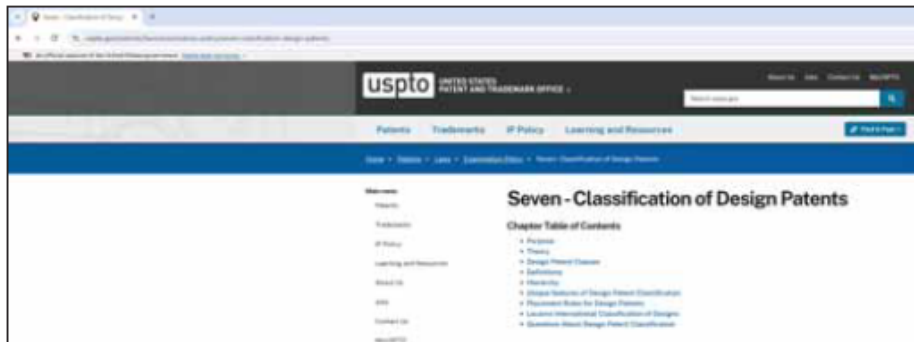
Art Unit

Title

USPC Design Classification

Searching Designs

Design Patent Classification



- ▶ Function or Intended Use
- ▶ Further classified by
 - ▶ Specific functional feature
 - ▶ Distinctive ornamental appearance or form

A. Purpose

The Design classification schedule of the USPC system provides a structured organization for the body of U.S. Design patents. Since the claim of a Design Patent is directed to "an ornamental design" for "an article of manufacture" [35 USC 171], the Design classification schedule promotes efficient access to industrial designs that have been granted patent rights.

B. Theory

Classification of design patents is based on the concept of function or intended use of the industrial design disclosed and claimed in the Design patent. Industrial designs that have the same function are generally collected in the same Design class, even though individual designs may be used in different environments.

For example, patented designs for seating are classified in class D6, Furnishings, even though these designs may be used in the home, workplace, vehicles, etc. Industrial designs of the same function are further classified by specific functional feature, distinctive ornamental appearance, or form.

Searching Designs

Article of Manufacture

35 U.S.C. 171

(a) In General.—

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.

(b) Applicability of This Title.—

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) Filing Date.—

The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

M.P.E.P. 1502

Definition of a Design

The subject matter of a design patent application may relate to:

- (a) the configuration or shape of an article;
- (b) the surface ornamentation applied to an article; or
- (c) the combination of configuration and surface ornamentation

Searching Designs

Article of Manufacture

Samsung v. Apple - 2016

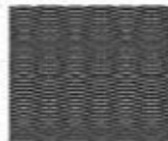
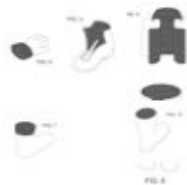
Damages

Curver Luxembourg v. Home Expressions - 2019



Infringement

Columbia v. Seirus - 2023



Comparison Prior Art

In re SurgiSil - 2021



Anticipation

Searching Designs



No. _____

In the
Supreme Court of the United States

SEIRUS INNOVATIVE ACCESSORIES, INC.,
Petitioner,
v.
COLUMBIA SPORTSWEAR NORTH AMERICA,
INC.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

JOHN W. THORNBURGH
Counsel of Record
CHRISTOPHER S. MARCHESE
SETH M. SPROUL
FISH & RICHARDSON P.C.
12860 EL CAMINO REAL, SUITE 400
(858) 678-5070
thornburgh@fr.com

Counsel for Petitioner

March 21, 2024

QUESTIONS PRESENTED

The questions presented are:

- (1) Whether function must be disregarded in defining the scope of comparison prior art relevant to design patent infringement; and
- (2) Whether comparison prior art can be considered in evaluating design patent infringement even if it is not the exact "same article" and thus could not anticipate for purposes of determining validity.

Searching Designs

Training Materials



United States

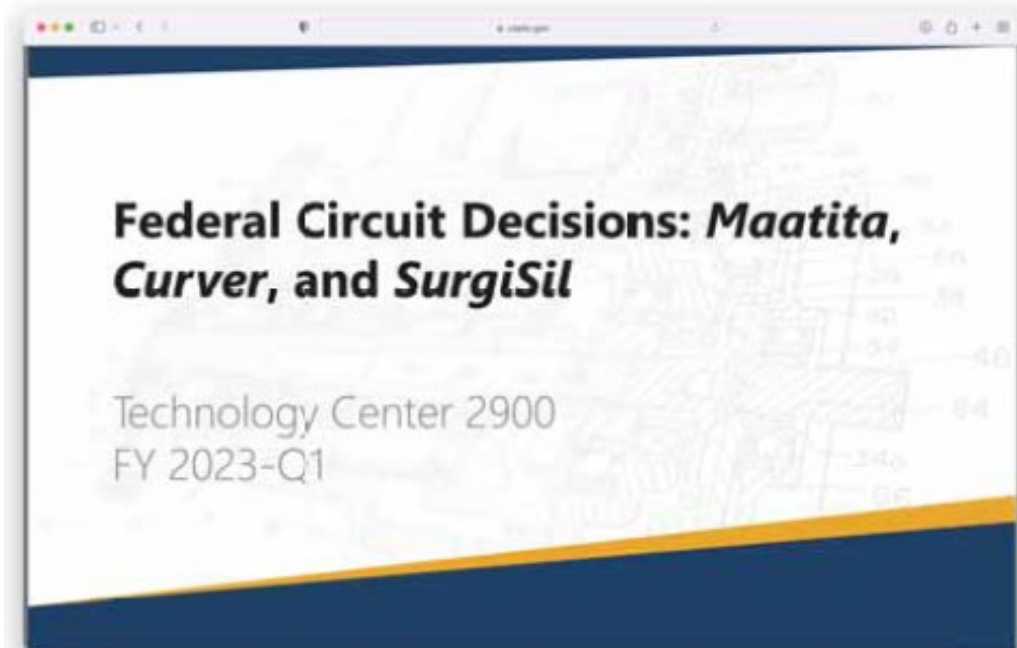
A screenshot of the United States Patent and Trademark Office (USPTO) website. The browser address bar shows the URL "www.uspto.gov". The page title is "Design patent examiner materials and resources". The main content area includes a sub-header "Design examiner training materials" followed by a list of resources such as "Responding to legal arguments", "Part I: Understanding Case Law and the Federal Court System (Computer Based Training) (FY 2018)", "Part II: How to Evaluate and Analyze Legal Arguments Based on Case Law (FY 2018)", "Part II Legal Analysis Writing Workshop: Design Examples - Book Workshop", "Part II Legal Analysis Writing Workshop: Design Examples - Book Workshop", "Part II Legal Analysis Writing Workshop: Design Examples - Answer Key", "Federal Court Decisions: Waiver, Curver and Rongel (FY 2023-Q3)", "Drawing Objections (FY 2023-Q3)", and "Examination of Hague Applications (FY 2023-Q4)". There is also a section for "Other materials" including "Industrial Design Policy" and "Using Patent Policy Search Addressed to Search Designers (YouTube)".

Searching Designs

Training Materials



United States

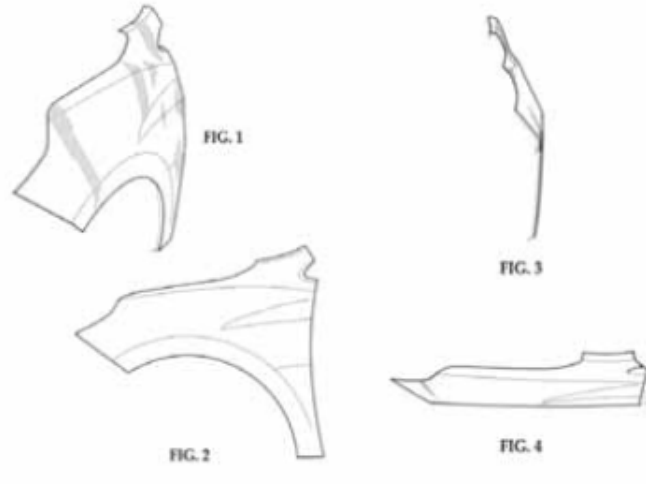


- ▶ Qualifying Prior Art for Anticipation
- ▶ Appear Substantially Similar
- ▶ Reasonably Related to the same Article

Searching Designs

LKQ v. GM

Obviousness



Hupp v. Siroflex

122 F.3d 1456, 1462 (Fed. Cir. 1997)

The scope of the prior art is not the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of article sufficiently similar that a person of ordinary skill would look to such articles for their designs."

(finding ceramic floor tile molds were not appropriate prior art for a mold for a concrete walkway)

Searching Designs



United States

Guide



Dashboard



Policy



Searching Designs

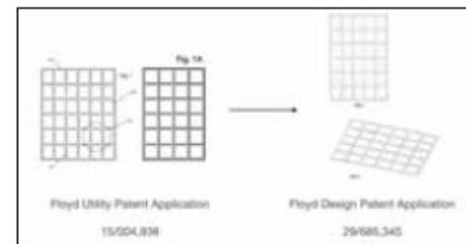
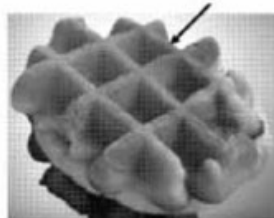
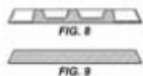
Decisions - Registration

In re Samuels

22-1121

Nonprecedential Opinion, March 6, 2024
(Taranto, Chen and Stoll)

Waffle Having a Waffle Pattern Side and a Smooth Side



www.altdesignpatent.com

Searching Designs

Gazette / Journal



Decisions - Validity

United States

The screenshot shows the USPTO website's 'Official Gazette for Patents' page. At the top, there is a search bar and navigation links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. Below the navigation, there is a yellow information box with several bullet points regarding the Patent Public Search and the 'Full Text' feature. The main heading is 'Official Gazette for Patents', followed by a paragraph explaining the purpose of the gazette. Below this, there is a table with columns for 'Date', 'Week', and 'Number'. The table lists several dates from April 2014 to March 2015, with corresponding week and number values.

Date	Week	Number
April 29, 2014	17	521-4
April 15, 2014	16	521-3
April 08, 2014	15	521-2
April 01, 2014	14	521-1
March 18, 2014	13	520-4
March 11, 2014	12	520-3

▶ Notices

▶ Reexamination

▶ IPR & PGR

Searching Designs

Decisions - Validity

Challenging Designs

IPR & PGR

38% institution

*72% invalidation at trial
(21 unpatentable out of 29 final
decisions)*

www.designpatentvalidity.com

Searching Designs

Decisions - Validity

Challenging Designs

Reexamination

91% ordered

44% invalidation

(58 cancelled out of 132 ordered)

www.designpatentvalidity.com

Searching Designs

Gazette / Journal



United States

uspto

Home Grants Priority Help

Class Selection Panel

D1	100	01022500
	107	01022501
		01022502
		01022503
		01022504
		01022505
D2	109	01022506
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		01022508
		01022509
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	407	01022511
	706	01022512
		01022513
	717	01022514
	714	01022515
	740	01022516
	742	01022517
		01022518
	804	01022519
	840	01022520
	876	01022521
	887	01022522
	902	01022523
	912	01022524
	914	01022525
		01022526
		01022527
		01022528
		01022529
	947	01022530
		01022531

FIG. 1

FIG. 2

The illustrated design for a container is shown in perspective view.

► Browse Granted Patents

Searching Designs

Gazette / Journal



United States

The screenshot shows the USPTO website interface. On the left, there is a sidebar with the USPTO logo and a list of design numbers under the heading "Designs". The main content area displays search results for a specific design, including a thumbnail image of a mobile phone and a "VIEW" button. The search results also include the design number "U.S. DESIGN 2018-01-01" and a "VIEW" button. The design number "2018-01-01" is highlighted in blue. Below the design number, there is a "VIEW" button. The design number "2018-01-01" is also listed in the sidebar. The design number "2018-01-01" is also listed in the sidebar. The design number "2018-01-01" is also listed in the sidebar. The design number "2018-01-01" is also listed in the sidebar.

uspto

Designs

Home Contact Privacy Help

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01024119
01024120
01024121

U.S. DESIGN 2018-01-01

VIEW

The intended design for a display screen or portion thereof with graphical user interface, as shown and described.

Searching Designs

Laws and Changes



United States

The screenshot shows the Federal Register website interface. At the top, it displays the logo and name "FEDERAL REGISTER" with the tagline "The Daily Journal of the United States Government". The date "Monday, April 1st" is shown. Below the header, there are several navigation and information boxes: "Current Issue" (21 documents from 12 agencies, 280 pages), "Public Inspection" (12 documents from 10 agencies), "Special Filing" (3 notices, 4 proposed rules, 3 rules), and "Regular Filing" (194 documents from 48 agencies, 66 notices, 4 proposed rules, 3 rules). A search bar is present with the text "Search Federal Register Documents". Below the search bar, there are sections for "POPULAR DOCUMENTS" and "PRESIDENTIAL DOCUMENTS". The "POPULAR DOCUMENTS" section lists items like "White Emissions Charge for Petroleum and Natural Gas Systems" and "Advanced Infrared Imaging Technology". The "PRESIDENTIAL DOCUMENTS" section lists "Executive Order 14131" regarding "Transparency and Recovery, Women's Health" and "Notice" regarding "Continuation of the National Emergency with Respect to Significant Medical Care Provider Shortages".

The screenshot shows the Regulations.gov website interface. At the top, it displays the logo and name "Regulations.gov" with the tagline "Your voice matters". A search bar is present with the text "Search for documents and documents in agency process". Below the search bar, there are several sections: "What's New on Regulations.gov" (New features include the ability to download Agency Ruled, and Public Submission Document metadata in bulk), "A What's Trending" (listing trending documents like "Peru's Inland Navigation Review Decision" and "Acquisition Regulation: Pay Equity and Transparency in Federal Contracting"), and "Explore" (listing documents like "Comments Due Soon" and "Posted Recently").



Thank You!

George Raynal

George.Raynal@designlawgroup.com

Saidman Design Law Group

A POINT OF VIEW
LIKE NO OTHER

BRIDGING OOHEY-GUI WATERS

Navigating Graphical Interface Design Patents

Design Day 2024: May 9th, 2024



WOMBLE
BOND
DICKINSON

BACKGROUND OF PROTECTING GUIS

35 U.S.C. § 171

- “[w]henever invents any new, original and ornamental design **for an article of manufacture** may obtain a patent therefor”
 - Three types of Designs:
 - A design for an ornament, impression, print, or picture that is applied to or embodied in an article of manufacture;
 - A design for the shape or configuration of an article of manufacture; and
 - A combination of the previous two

Ex parte Strijland, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992)

- Confirmed 35 U.S.C. § 171 must be shown as applied to or embodied in an article of manufacture
 - Mere Display of a Picture on a Screen is not patentable
 - The picture must be “an integral and active component in the operation of the programmed computer displaying the design.”
- Led to Rulemaking which USPTO became previous MPEP § 1504.01(a)(1)
 - If Properly presented and claimed, a display panel with a computer icon or GUI – as an integral and active component in the operation of a programmed computer displaying the design – constitutes statutory subject matter under 35 U.S.C. § 171.

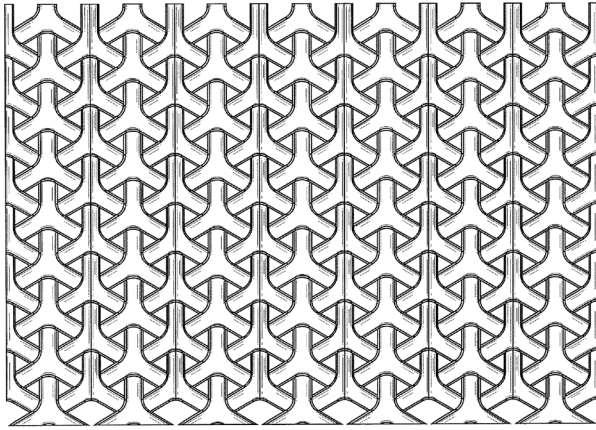


FIG. 1



CONFIRMED IN *CURVER*

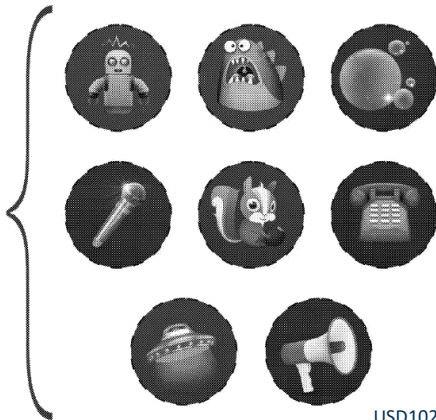
Curver Luxembourg v. Home Expressions Inc. 938 F.3d 1334 (Fed. Cir. 2019)

- As discussed in MPEP section 1502, a “[d]esign is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation.”

NEW GUIDELINES

Guidance

- The USPTO considers a Computer Icon or a GUI shown on a display panel, *or portion thereof*, is more than a mere display of a picture on a screen because a computer icon or a GUI is ***an integral and active component*** in the operation of . . . a programmed computer displaying the computer icon or the GUI.
- Personnel must Review the Title and Claim Language to determine whether the title and claim adequately describe a design for an article of manufacture.



USD1024131

Display Screen or Portion Thereof with Set of Icons - Apple

Points for Examiners to Consider

- A claim to the image per se, to a display panel (or a portion thereof) with the image, or to the image for display on a display panel, will not satisfy the article of manufacture requirement
 - A computer-generated electronic image shown on a display panel that is not a computer icon or a GUI is a mere illustration of a picture displayed electronically.
- The title and the claim must be for an article of manufacture, for example, a “display panel with computer icon.”
 - The USPTO considers computer icons or GUIs to be two-dimensional images which standing alone are surface ornamentation
- A claim and title directed to a display screen with an icon or a GUI adequately describes a design for an article of manufacture.
 - When a design claim is to a display panel with a computer-generated image, the USPTO considers the term “icon” or “GUI” in the title and the claim to be indicating that the image on the display panel is not merely a displayed picture, but an integral and active component in the operation of a programmed computer displaying the image.

NEW GUIDELINES (TITLE EXAMPLES)

DO NOT Adequately Describe Design

- Fail to Designate a Particular Article
 - display screen with virtual image
 - virtual image for display on computer screen
 - computer icon
 - icon for computer screen

DO Adequately Describe Design

- Designate a Particular Article
 - computer screen with an icon
 - display panel with GUI
 - display screen or portion thereof with icon
 - portion of a computer screen with an icon
 - portion of a display panel with an icon
 - portion of a monitor displayed with an icon



USD1024113

Display Screen or Portion Thereof with Graphical User Interface - IGT

NEW GUIDELINES (PROSECUTION EXAMPLE 1)

Title: Computer display screen with icon

- Description
 - The figure is a front view of a computer display screen with icon, showing the new design.
 - The broken lines showing a portion of the computer display screen form no part of the claimed design.
- Claim
 - The ornamental design for computer display screen with icon as shown and described.



Office Position

- Allowed
 - A computer icon or a GUI on a display panel to be an integral and active component in the operation of a programmed computer displaying the design and more than a displayed picture.
 - The application fully discloses the design as embodied in an article of manufacture, as the drawing depicts the design embodied in a computer screen in broken lines.

NEW GUIDELINES (PROSECUTION EXAMPLE 2)

Title: Animated Icon

- Description
 - Figure 1 is a front view showing a first image in a sequence for an animated icon showing a new design.
 - Figure 2 is a second image thereof. The appearance of the animated image sequentially transitions between the images shown in Figs. 1–2.
 - The process or period on which one image transitions to another image forms no part of the claimed design. The broken lines showing a portion of a computer display screen form no part of the claimed design.
- Claim
 - The ornamental design for an animated icon as shown and described.



FIG. 1

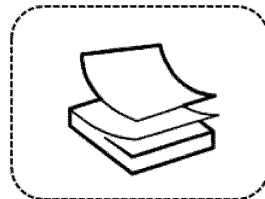


FIG. 2

Office Position

- Objected for failing to designate a particular article of manufacture
- Fixable
 - The application fully discloses the design as embodied in an article of manufacture, as the drawing depicts the design embodied in a computer display screen in broken lines and the description describes a portion of a computer display screen.

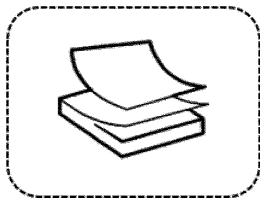
Response to Office Action

- Title: Computer display screen with an animated icon
- Claim: The ornamental design for a computer display screen with an animated icon as shown and described.

NEW GUIDELINES (PROSECUTION EXAMPLE 3)

Title: Virtual paper stack

- Description
 - The figure is a front view of a computer display screen with a virtual paper stack showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.
- Claim
 - The ornamental design for a virtual paper stack as shown and described.



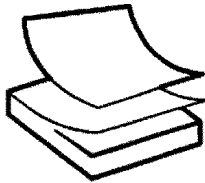
Office Position

- Rejected under 35 U.S.C. 171.
- Object to Title and Claim for failing to designate a particular article of manufacture
- **Not Fixable**
 - The original disclosure does not provide support for amendments to support a computer icon or a display.

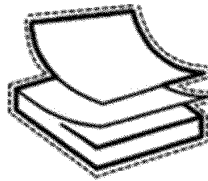
NEW GUIDELINES (PROSECUTION EXAMPLE 4)

Title: Paper stack icon for use on a mobile device screen

- Description
 - The figure is a front view of a paper stack icon showing the new design.
- Claim
 - The ornamental design for a paper stack icon for use on a mobile device screen as shown and described.



As filed



Amended

Office Position

- Does not comply with 35 U.S.C. 171 for failing to depict an article of manufacture in solid or broken lines.
- Title and claim objected to
- Fixable
 - Amendments to title, claim, description, and drawings required.

Response to Office Action

- Title: Mobile device screen with a paper stack icon for use on a mobile device screen
- Description: The figure is a front view of a mobile device with a virtual paper stack icon showing the new design. The broken lines showing a portion of the mobile device screen form no part of the claimed design.
- Claim: The ornamental design for a mobile device screen with a paper stack icon for use on a mobile device screen as shown and described.

NEW GUIDELINES (PROSECUTION EXAMPLE 5)

Title: Paper stack icon for use on a mobile device screen

- Description
 - The figure is a front view of a computer display screen with icon, showing the new design. The broken lines showing a portion of the computer display screen form no part of the claimed design.
- Claim
 - The ornamental design for an icon for computer display screen as shown and described.



Office Position

- Title and claim objected to for failing to designate a particular article of manufacture
- Complies with 35 U.S.C. 171
- Fixable
 - Amendments to title, claim, description, and drawings required.

Response to Office Action

- Title: Computer display screen with icon for ~~computer display screen~~
- Claim: The ornamental design for a computer display screen with an icon for computer display ~~screen~~ as shown and described.

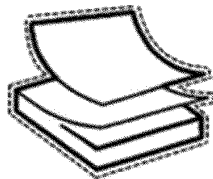
PRACTICE POINTS

- Title

- Claim article of manufacture with the claimed object or icon.
- “Display Screen or portion thereof with . . .
“
- Make sure not to claim an Icon alone
- Make sure not to claim a virtual image alone

- Figures

- Show a dashed line for the article of manufacture possibly adopt drawing as shown in Example 4.



- Integral and Active Component in the operation of a programmed computer displaying the design
- Describe and show article of manufacture
 - Does not need to be claimed
 - Show design in its environment

EXAMPLES OF RECENTLY ISSUED PATENTS

Coinbase - D1,020,795
 Display screen with icon group and display screen with icon set

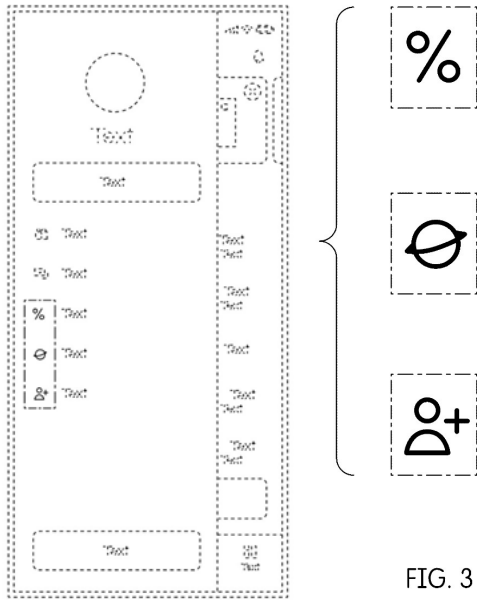


FIG. 1

FIG. 3

S&P Global - USD1,009,077
 Display screen with a transitional graphical user interface



FIG. 1

S&P Global - USD1,008,285
 Display screen with a transitional graphical user interface

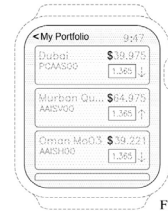


FIG. 2

Apple - USD1,009,932
 Display screen or portion thereof with animated icon



FIG. 1

FIG. 2

FIG. 3

Apple - USD882,599
 Display screen or portion thereof with icon

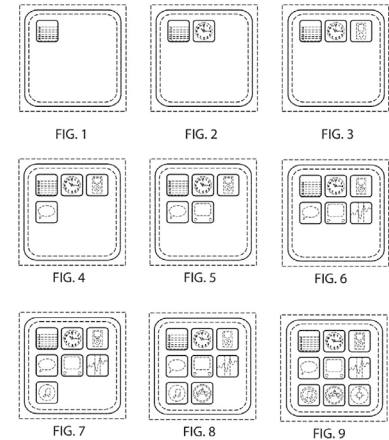


FIG. 1

FIG. 2

FIG. 3

FIG. 4

FIG. 5

FIG. 6

FIG. 7

FIG. 8

FIG. 9



Cory Schug

Partner

e: cory.schug@wbd-us.com t: 336.574.8051



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Information contained in this document is intended to provide general information about significant legal developments and should not be construed as legal advice on any specific facts and circumstances, nor should they be construed as advertisements for legal services.





The Fire Race: Sprinting to Market with LavaBox Portable Campfire

Joshua Thurmond
Chief Eruption Officer
LavaBox Portable Campfire



The

Design Law Treaty

**Continued Steps Toward
Worldwide Harmonized
Industrial Design Protection**

David R. Gerk

Principal Counsel and
Director for Patent Policy,
Office of Policy and Inter-
national Affairs, USPTO



Rich Stockton

Shareholder
Banner & Witcoff, Ltd.
(Chicago)



Summary

- What is the DLT?
- DLT Highlights
- What the DLT Is Not

What is the Design Law Treaty?

What is the DLT?

**The DLT is an
agreement between
nations to harmonize
industrial design
protection procedures**

What is the DLT's Goal?

“The future treaty aims to streamline the global system for protecting industrial designs, making it **easier, faster** and **more affordable** for designers to protect their work in home markets as well as overseas.”

Source: WIPO DLT home page (emphasis added)

DLT Anatomy

- 32 Articles
(WIPO Assembly amends)
 - 21 substantive
 - 11 procedural
- 21 Rules
(DLT Assembly amends)



DLT Origins

- 20+ years negotiations
- Design equivalent of earlier patent and trademark protection procedure treaties
- Similar framework



2000



1994



2006

DLT: Upcoming Negotiations

2024 Riyadh

Diplomatic Conference

on

Design Law

November 11-22, 2024

DLT: Your Comments Requested!

- USPTO seeks comments
 - Design Prosecution Experiences Abroad
 - DLT Articles/Rules Text
 - DLT Additions/Subtractions
 - Any Other Relevant Insight
- Due June 25, 2024



Design Law Treaty

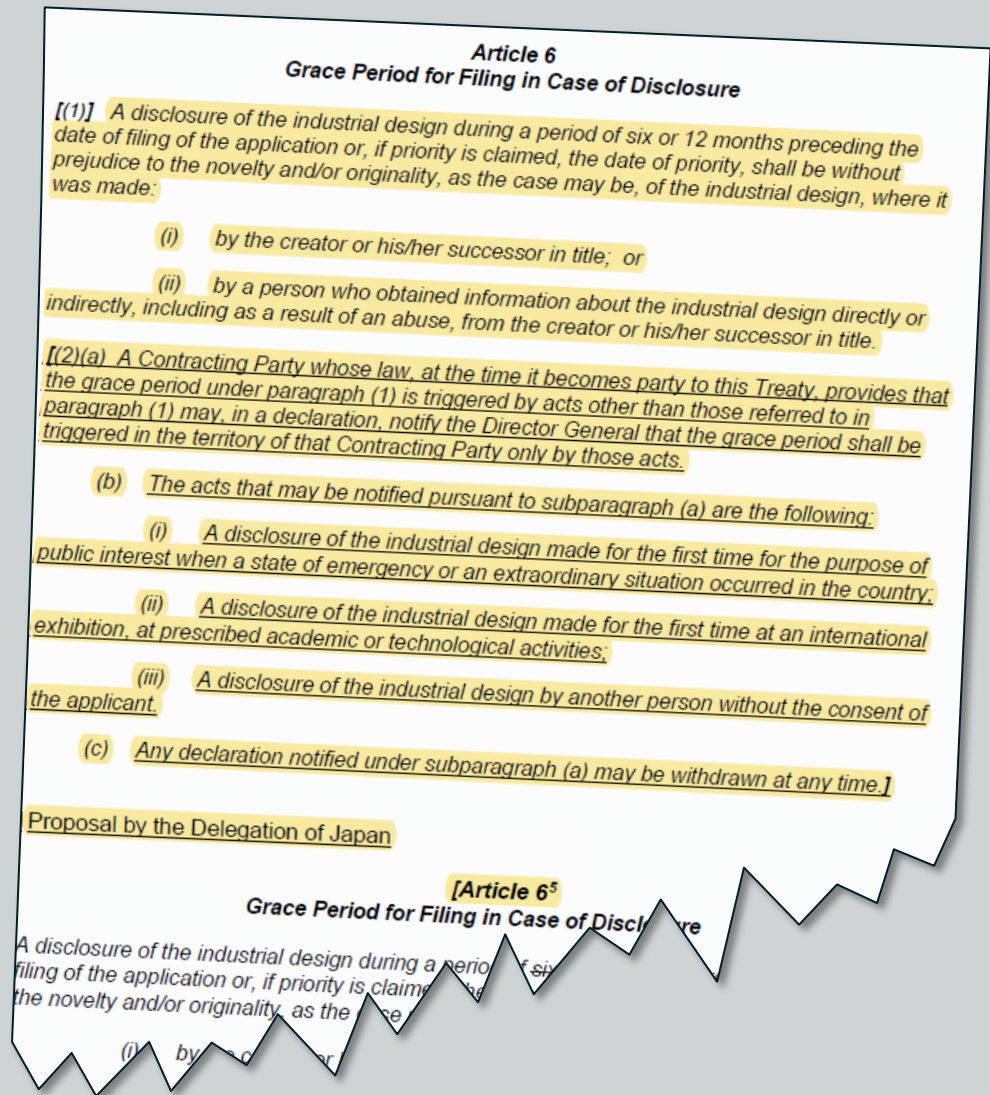
Highlights

DLT Highlights: Issues Summary

- Applicable Applications
- Maximum Requirements
- Grace Period
- Term
- Electronic Means

How to Read the “Official” DLT Text

- Likely
Consensus
- Divergent
- Proposed



A2(1): Applicable Applications

(1) Applications

This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party and to divisional applications thereof.

A6(1): Grace Period

Article 6(1)

A disclosure of the industrial design during a period of six or 12 months preceding the date of filing of the application or, if priority is claimed, the date of priority, shall be without prejudice to the novelty and/or originality, as the case may be, of the industrial design, where it was made:

(i) by the creator or his/her successor in title; or

(ii) by a person who obtained information about the industrial design directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.

A6(2): Declaration re Grace Period

2(a) A Contracting Party whose law, at the time it becomes party to this Treaty, provides that the grace period under paragraph (1) is triggered by acts other than those referred to in paragraph (1) may, in a declaration, notify the Director General that the grace period shall be triggered in the territory of that Contracting Party only by those acts.

(b) The acts that may be notified pursuant to subparagraph (a) are the following:

(i) A disclosure of the industrial design made for the first time for the purpose of public interest when a state of emergency or an extraordinary situation occurred in the country;

(ii) A disclosure of the industrial design made for the first time at an international exhibition, at prescribed academic or technological activities;

(iii) A disclosure of the industrial design by another person without the consent of the applicant.

(c) Any declaration notified under subparagraph (a) may be withdrawn at any time.

A6: Grace Period Triggering Disclosures

Triggering Disclosure

Comment

<ul style="list-style-type: none">• By/through creator	Current A6(1)
<ul style="list-style-type: none">• Emergency in public interest• International exhibition, at “prescribed ... activities”• Unauthorized	Current A6(2), By declaration may limit “ONLY” to these disclosures
<ul style="list-style-type: none">• By creator at “exhibition notified” per national law• Through creator w/o consent	India proposal, supported by China, Nepal, Niger

A6: Minimum Grace Period Length

Length

Support Indicated By

<p>12 months</p>	<p>United States, Australia, Canada, France, Japan, Korea, Moldova, Switzerland, Ukraine, United Kingdom</p>
<p>6 months</p>	<p>Brazil, China, Ghana (on behalf of Africa Group), India, Iran, Nepal, Niger, Russia</p>

A9(1): Publication

(1) Maintaining the Industrial Design Unpublished

A Contracting Party shall allow the industrial design to be maintained unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations.

A12(2): Failure to Timely Act

(2) [Continued Processing]

Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office, and that Contracting Party does not provide for the extension of a time limit under paragraph (1)(ii), the Contracting Party ~~shall~~may provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if:

A17-18: License Recording

Non-recordal “shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.”

“A Contracting Party ~~may not~~may require [recordal] as a condition for” (a) a licensee to join infringement proceedings or (b) “to obtain, by way of such proceedings, damages”

Where required, failure to indicate that the industrial design is used under a license “shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.

A9bis (proposed): Minimum Term

Proposed Article 9bis

By

Comment

<p>Minimum term “of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration.”</p>	<p>US </p>	<p>Hague A17(3)(a): 15 years from int’l registration</p>
<p>Minimum term either “Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.”</p>	<p>NG </p>	<p>TRIPS A26(3): “The duration of protection available shall amount to at least 10 years.”</p>

A14bis (proposed): Priority Document Exchange

Proposed Article 14bis

By

Comment

“A Contracting Party shall provide for electronic exchange of priority documents for applications.”

US



A9ter (proposed): Electronic Filing and Searching

Proposed Article 9ter

By

“A Contracting Party shall provide ... a system for electronic application”

US



“A Contracting Party shall provide ... a publicly available electronic information system, which must include an online database of registered industrial designs”

A9quater (proposed): Electronic Filing and Searching

Proposed Article 9quater (redlined to A9ter)

By

“A Contracting Party ~~shall~~may provide a system for electronic application”

NG



“Contracting Parties shall not be required to provide ... a publicly available electronic information system, ~~which must~~ includenor an online database of registered industrial designs”

**What the
Design Law Treaty
is Not**

What's Missing in the DLT?

- Missing from Matters *in* the DLT
 - Substantive Harmonization
 - Additional Procedural Harmonization
- Missing Matters *Altogether*
 - Unity
 - Continuation Practice
 - Sufficiency of Disclosure

A1bis(1): DLT Does Not Require Substantive Harmonization

The DLT does not “limit the freedom of a Contracting Party to prescribe such requirements of the **applicable substantive law** relating to industrial designs as it desires.”

DLT Novelty-Related Harmonization

TRIPS A25(1)

DLT


“Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features.”

???

DLT Novelty-Related Harmonization?

- Maybe...
 - Term
 - Triggering Disclosures
- Maybe Not...
 - Declarations
 - Additive Grace Period
 - Substance...

DM/1/II (E)



ANNEX II

Supporting Document(s) Concerning a Declaration to the Exception to Lack of Novelty under Section 408(c)(ii) of the Administrative Instructions

IMPORTANT

1. This Annex can be used to submit documents in support of a declaration concerning exception to lack of novelty to the **China National Intellectual Property Administration (CNIPA)**, the **Japan Patent Office (JPO)** and/or the **Korean Intellectual Property Office (KIPO)** (refer to form DM/1, item 15). The submitted document(s) will be transmitted by WIPO to the Office(s) concerned.
2. This Annex must be submitted with form DM/1 at the time of filing.
3. Submit only one Annex II per declaration to the exception to lack of novelty, regardless of how many Contracting Parties you have designated.
4. Please note that a declaration concerning exception to lack of novelty might affect the applicant's rights in other jurisdictions. It is the responsibility of the applicant to ensure that their rights are preserved.
5. For detailed information on the procedure when designating Japan, please visit the [JPO website](#).
6. Please number your pages.

For use by the applicant

This Annex concerns the international application number _____

Reference: _____

Substance: Toward Novel Novelty: *Curver Luxembourg v. Home Expressions*

938 F.3d 1334 (Fed. Cir. 2019)

“...[W]e hold that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.”



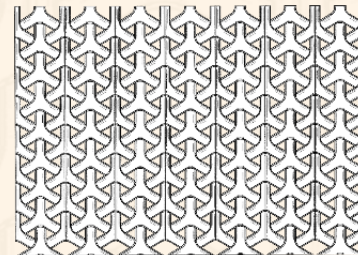
Judge Chen



Judge Hughes



Judge Stoll



D677946

Pattern for a Chair



**Accused
Product**

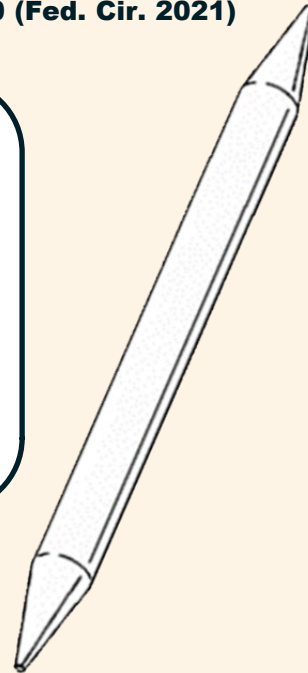
Substance: Arriving at Novel Novelty: *In re SurgiSil* 14 F.4th 1380 (Fed. Cir. 2021)

“A design claim is limited to the article of manufacture identified in the claim”

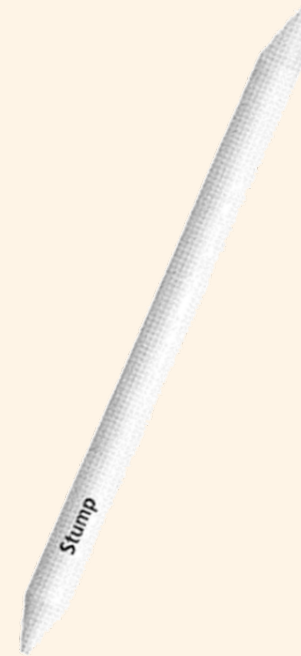


Judge Moore

Thus, lip
implant not
anticipated
by art tool



29/491550
“Lip Implant”



Prior Art
Art Tool

102 REVERSED

DLT Functionality Harmonization?

TRIPS A25(1)

DLT

“Members may provide that [industrial design] protection shall not extend to designs dictated essentially by technical or functional considerations.”

(none)

DLT Exceptions Harmonization?

TRIPS A26(2)

DLT

“Members may provide **limited exceptions** to the protection of industrial designs, provided that such exceptions do not **unreasonably conflict** with the normal exploitation of protected industrial designs and do not **unreasonably prejudice** the legitimate interests of the owner of the protected design, taking account of the **legitimate interests** of third parties.”

(none)



Thank you

David R. Gerk

Principal Counsel and
Director for Patent Policy,
Office of Policy and Inter-
national Affairs, USPTO



Rich Stockton

Shareholder
Banner & Witcoff, Ltd.
(Chicago)



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Best Practices for using the Hague System: The International Solution for Design Protection

Quan-Ling (Quan) Sim
Head, Operations Service (Hague)
The Hague Registry
Brands and Designs Sector

Thursday, May 9, 2024

Overview

- Introduction
- Statistics
- Recent and Future Developments
- eHague Filing
- DAS
- Practice Tips
- Hague is the future

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WIPO FOR OFFICIAL USE ONLY





Introduction

WIPO | HAGUE
The International
Design System

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Hague System

- A unique business solution
 - Protection in all designated CPs
 - 79 Contracting Parties, protection in 96 countries (as of April 2024)
 - Recent accessions: Mauritius (May 6, 2023), Brazil (August 1, 2023)
 - Upcoming accessions: India and Saudi Arabia
- Protect up to 100 designs in one application
- Secure and manage design rights in multiple jurisdictions through just one application
- The payment of a single set of fees, in one currency and with one Office

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Statistics



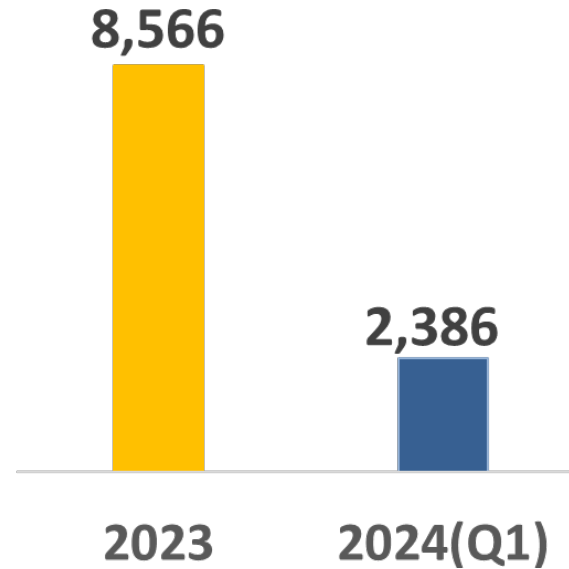
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Statistics

- Total applications received



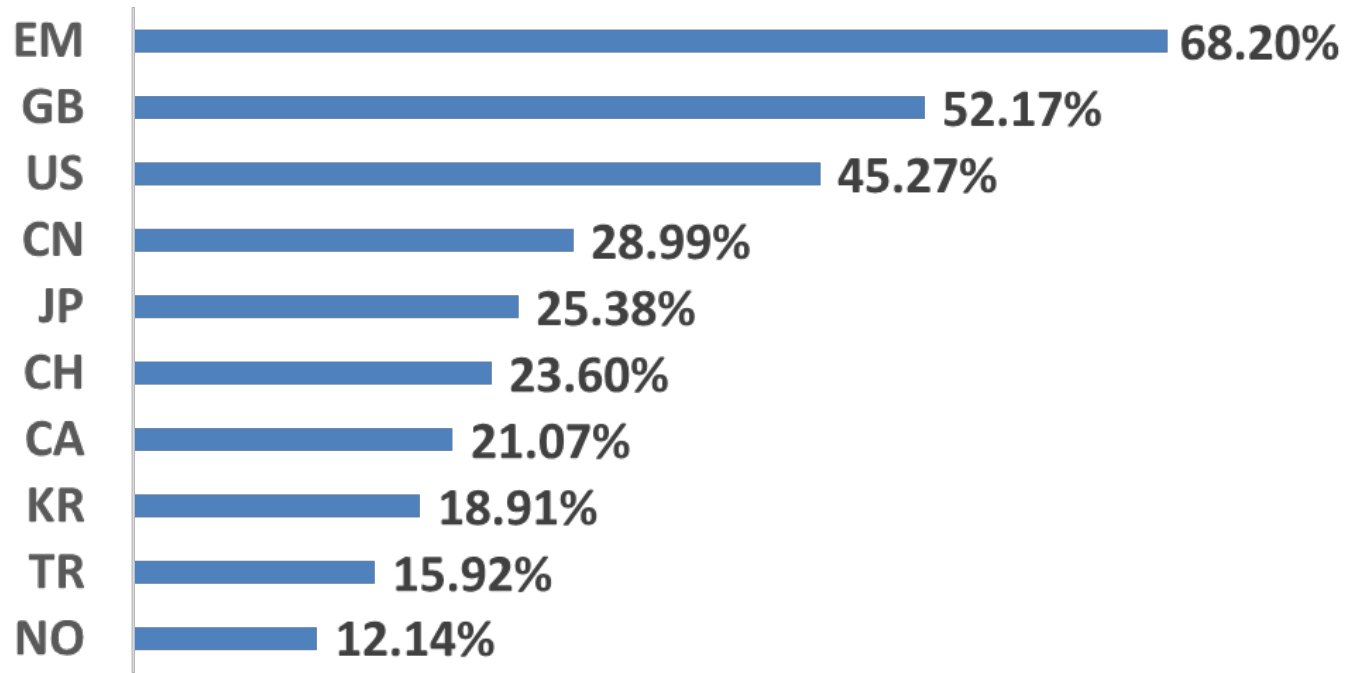
- Latest forecast for 2024 (April 2024 estimates)
 - 9000+ applications (9080): 6% increase
 - ~9000 registrations (8760): 4.7% increase

Please send questions to the DesignDay@uspto.gov mailbox.



Statistics

- 2023 Top 10 designations



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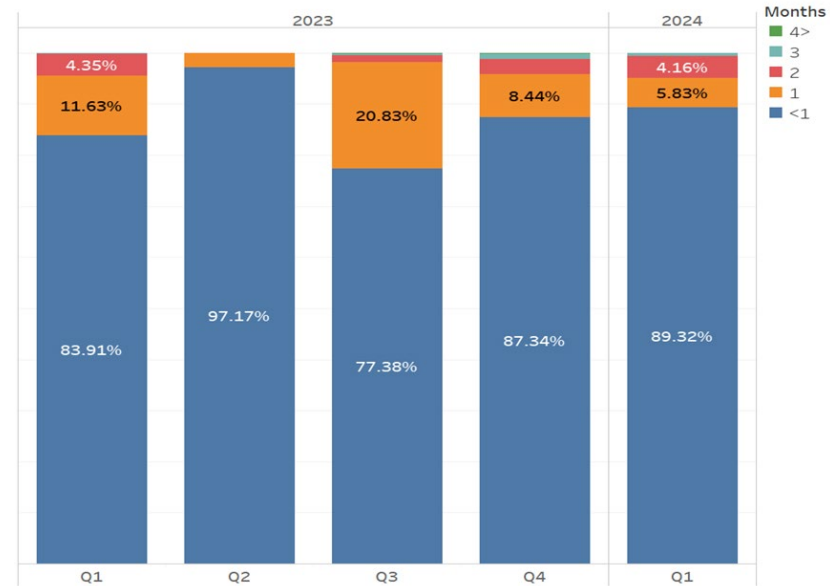
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Statistics

- Percentage distribution of regular application processing time

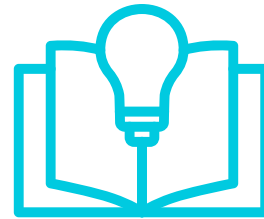
"Regular application": applications that have not received an irregularity letter due to reasons such as insufficient payment, claim adjustments and so on



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Developments



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Developments since 2023

- Representative change publication (April 2023)
- Strong authentication (June 2023)
- eHague portfolio management (December 2023)
- Extra design fee increase from 17 CHF to 50 CHF (January 2024)
- Design specific descriptions (January 2024)
- New payment methods
 - Digital Wallet (Apple, Google, etc.)
 - Sofort / Klarna



Future Developments

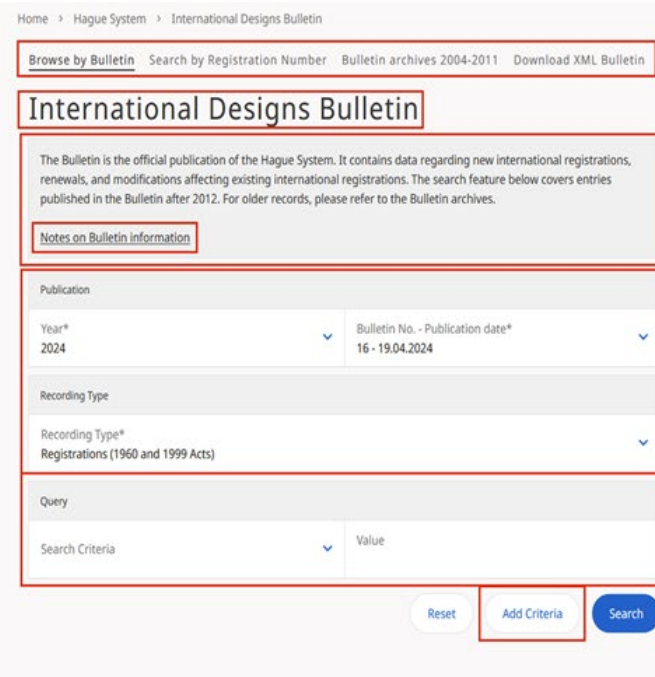
- DAS code validation integrated in eHague Filing
- Improvements in eHague portfolio management
- Detailed application status updates in eHague
- Vector drawings
- [New bulletin layout \(already in production\)](#)
- Alipay as a new payment method
- [Hague Working Group updates](#)

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New bulletin layout

- Presentation and user experience improvements



Home > Hague System > International Designs Bulletin

[Browse by Bulletin](#) [Search by Registration Number](#) [Bulletin archives 2004-2011](#) [Download XML Bulletin](#)

International Designs Bulletin

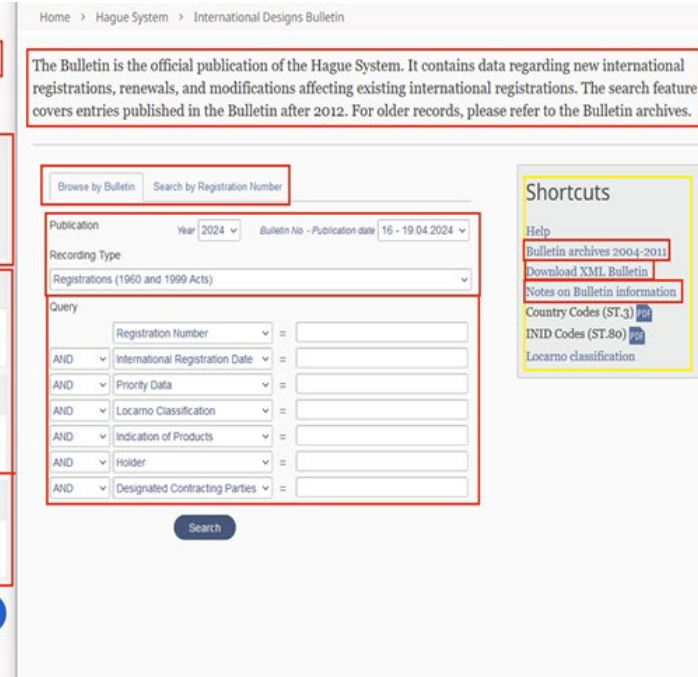
The Bulletin is the official publication of the Hague System. It contains data regarding new international registrations, renewals, and modifications affecting existing international registrations. The search feature below covers entries published in the Bulletin after 2012. For older records, please refer to the Bulletin archives.

[Notes on Bulletin information](#)

Publication	
Year*	Bulletin No. - Publication date*
2024	16 - 19.04.2024
Recording Type	
Recording Type*	
Registrations (1960 and 1999 Acts)	
Query	
Search Criteria	Value

[Reset](#) [Add Criteria](#) [Search](#)

New



Home > Hague System > International Designs Bulletin

The Bulletin is the official publication of the Hague System. It contains data regarding new international registrations, renewals, and modifications affecting existing international registrations. The search feature covers entries published in the Bulletin after 2012. For older records, please refer to the Bulletin archives.

[Browse by Bulletin](#) [Search by Registration Number](#)

Publication	Year	Bulletin No. - Publication date
	2024	16 - 19.04.2024
Recording Type		
Registrations (1960 and 1999 Acts)		
Query		
AND	Registration Number	
AND	International Registration Date	
AND	Priority Data	
AND	Locarno Classification	
AND	Indication of Products	
AND	Holder	
AND	Designated Contracting Parties	

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[Country Codes \(ST.3\)](#)

[INID Codes \(ST.80\)](#)

[Locarno classification](#)

Current

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Hague Working Group

- HWG 12 (December 4-6, 2023)
 - Proposals to the Hague Assembly (in July 2024) to:
 - Freeze the application of the 1960 Act to simplify the Hague System
 - Proposed date of effect of January 1, 2025
 - Resulting adjustments of the Regulations and the Administrative Instructions
 - Amend Rule 14 of the Regulations to introduce an extension of a time limit to correct an irregularity of an international application
 - Proposed extension period of 2 months
 - Ongoing discussions on:
 - Possible introduction of new Hague System languages
 - Possible enhancement of the Hague System's financial sustainability
- HWG 13 (October 21-23, 2024)



eHague Filing



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eHague Filing

- What is eHague Filing?
A gateway that allows you to digitally and securely file your international design applications and renew your registrations.
- Why is eHague Filing?
 - Efficient
 - Economical
 - Centralized
 - Global

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eHague Filing

Home > Hague System > eHague > Application

FILING

New Filed application[s] Draft[s] [108] My Workbench

Application language*

The application language determines notably the language of the registration certificate.

New application
 New application using data from a filed application
 New application from a draft

Warning

It is a requirement under the law of the United States of America that, for designs created in the United States of America, the applicant first obtains a license from the United States Patent and Trademark Office [USPTO] before filing outside of the United States of America.

It is a requirement under the law of the Russian Federation that designs created in the Russian Federation by Russian legal entities or nationals are subject to a security clearance procedure by the Federal Service for Intellectual Property [ROSPATENT] to ensure that the designs do not contain state secrets.

Confirm

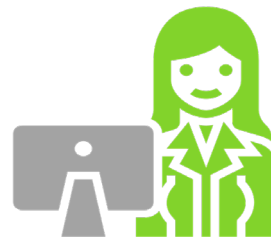
Intuitive – integrates mandatory requirements.
Automatic fee calculation.
Provides helpful hints.
Leads you to **important** and **relevant** information.

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DAS



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DAS (Digital Access Service)

- What is DAS?
Digital access service is an **electronic** system that enables applicants and offices to meet the requirements of the Paris Convention for certification in an electronic environment.
- Why choose DAS?
 - Easy
 - Secure
 - Quick
 - Inexpensive

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DAS (Digital Access Service)

- DAS Applicant Portal

Home > DAS > Applicant Portal

Workbench Notifications

Items: 20 Filter Priority Documents: All in Workbench

2 record(s) found matching the filter criteria

<input type="checkbox"/>	IP Right	Priority Number	Filing date ↕	Access Code	Date of Availability ↕	Last Accessed ↕	Tracked By	Comments
<input type="checkbox"/>	Design	IB 970123456	2014-12-15	1CSA	2024-04-19 ↕			<input checked="" type="checkbox"/>
<input type="checkbox"/>	Design	IB WIPO123456	2014-01-19	SFOF	2024-04-19 ↕			<input checked="" type="checkbox"/>

- DAS Login Page

<https://www3.wipo.int/dasapplicant/en/pages/workbench/applicant.xhtml>



You need a WIPO Account to use DAS



Use an existing WIPO account or create a new

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DAS (Digital Access Service)

- Retrieving application documents digitally via DAS



Digital Access Service
(DAS)



To:

Email address

CERTIFICATE OF AVAILABILITY OF A CERTIFIED INDUSTRIAL DESIGN DOCUMENT IN A DIGITAL LIBRARY

The International Bureau certifies that a copy of the Industrial design application indicated below has been available to the WIPO Digital Access Service since the date of availability indicated, and that the industrial design application has been available to the Indicated Office(s) as of the date specified following the relevant Office code:

Document details: Country/Office: **IB**

Filing date: **19 Jan 2014 (19.01.2014)**

Application number: **WIPO123456**

Date of availability of document: **19 Apr 2024 (19.04.2024)**

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Date of issue of this certificate: **23 Apr 2024 (23.04.2024)**

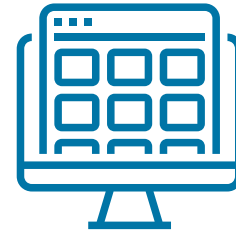
34, chemin des Colombettes
1211 Geneva 20, Switzerland
www.wipo.int

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Practice Tips



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Practice Tips (1)

- File directly using eHague-Filing
- Send correspondence electronically using Contact Hague (do not send paper to the International Bureau)

- Hague guidance on reproductions

https://www.wipo.int/export/sites/www/hague/en/docs/guidance_reproductions.pdf

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Practice Tips (2)

- Product indication (avoid punctuation such as brackets, sufficiently precise for classification)
- Description requirements, e.g. CN
- Pay attention to application number formats when using DAS, especially the suffix, e.g. D for JPO, -NNNN for EUIPO (according to the number of designs you apply for)

JP Design JP YYYY-NNNNNN D JP-2010-001234 **D**

EM Design EM NNNNNNNNNN-NNNN EM 000232323-**0001**

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Contact Hague

- Assisting you throughout the lifecycle of your international design applications and registrations



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Hague Customer Service

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We are there to help with all your questions!

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Thank you

Quan-Ling Sim

Head

Operations Service (Hague)

The Hague Registry

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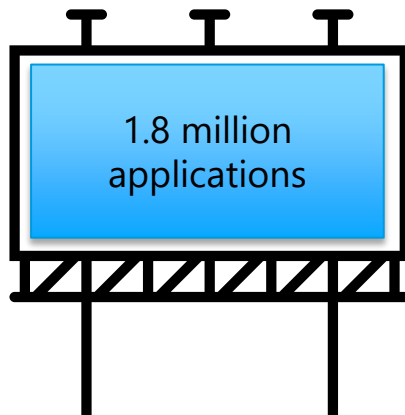


Design protection in Europe: Overview of the Main Changes in Legislation

Alexandra Mayr

Team Leader International Cooperation Service

European Union Intellectual Property Office (EUIPO)





EUIPO

European Union Design

- EU Design Regulation - EUDR
- EU Design Implementing Regulation - EUDIR
- EU Design Delegated Regulation - EUDDR

Member States National Designs

- Design Directive

Phases of the Reform – Amending Regulation and secondary legislation

I

Enters into force on the 20th day following publication in the OJEU but the amendments actually apply from the first day of the month following **4 months after the date of entry into force**

II

AR articles that need to be developed by secondary legislation + secondary legislation (Implementing and Delegated Regulations) apply from the first day of the month following **18 months after the date of entry into force of the AR**



Overview of the main changes

- Terminology and structural changes
- Modernized definitions and design representation regime
- Clarified object and scope of a design right
- Simplified and streamlined procedures
- New fee regime to make EU designs more affordable for SMEs and individual designers



Terminology changes

- Community - European Union (the 'Union')
- Community Design Regulation - European Union Design Regulation ('EUDR')
- RCD - REUD
- UCD - UEUD
- CDR - EUDR (+EUDDR)
- CDIR-EUDIR
- CD court-EUD court



[Church of the Light / Tadao Ando Architect](#)

New Designs

Do products really have no influence on the design protection?

- Partial designs
- Visibility requirement
- Single application for virtual and physical product
- Product indications



RCD 5282019-0019, 10-01 Digital clocks

New Designs

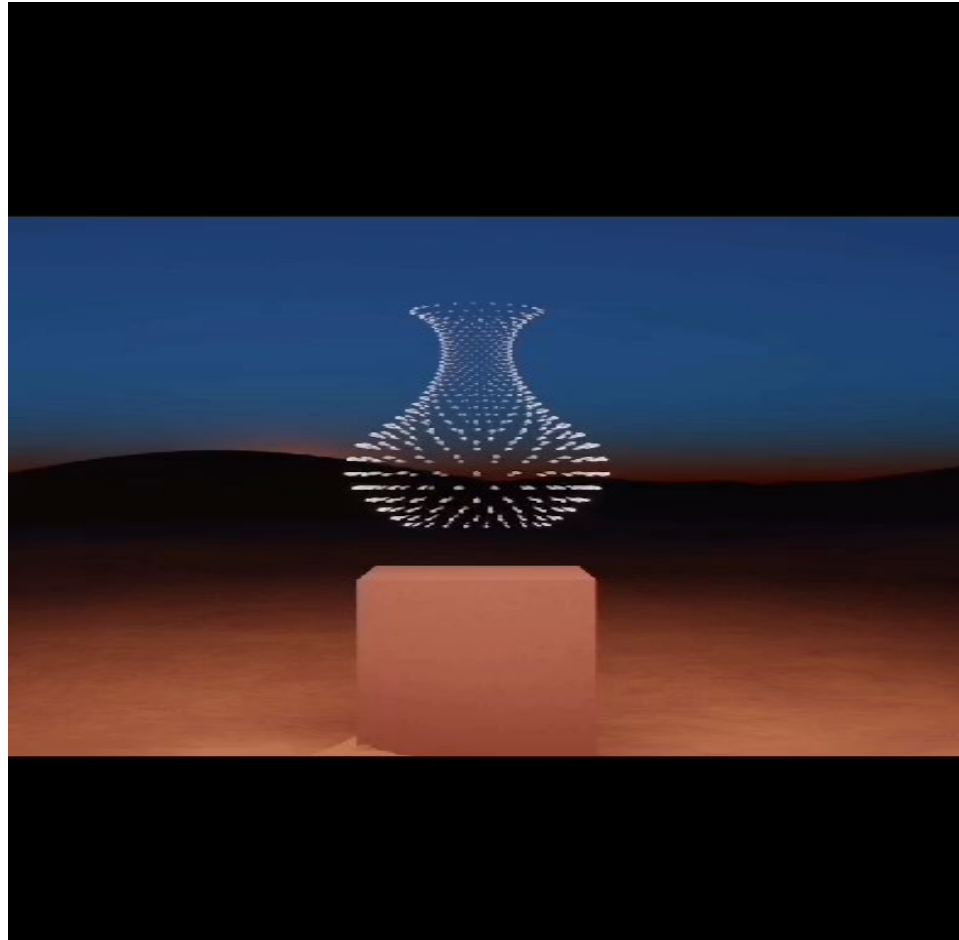
Do they protect spaces?

- ‘Get-ups’
- Physical and virtual spaces
- Interiors and exteriors



RCD 015006467-0001, Class: 32.02 – Get-up

Living Vase by
Hunn Wai and
Francesca
Lanzavecchia
as presented
for Vogue
Singapore





'Article 3

Definitions

For the purposes of this Regulation, the following definitions apply:

- (1) 'design' means the appearance of the whole or a part of a product resulting from the features, in particular, the lines, contours, colours, shape, texture, materials of the product itself and/or its decoration, including the movement, transition or any other sort of animation of those features.
- (2) 'product' means any industrial or handcraft item other than computer programs, regardless of whether it is embodied in a physical object or materialises in a non-physical form, including:
 - (a) packaging, sets of articles, spatial arrangement of items intended to form, an interior or exterior environment, and parts intended to be assembled into a complex product;
 - (b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces;



'Article 18a

Object of protection

Protection shall be conferred for those features of the appearance of a registered EU design which are shown visibly in the application for registration.;



Clarity is the only 'filing date' design representation requirement in Design Regulation and Design Directive

Future challenge:
*** the definition of clarity

a *sufficiently clear* representation of the design | , permitting | the subject matter for which protection is sought to be *determined*.

New fee regime

Single application fee

Fee payment to obtain a filing date

Multiple registrations:

- Unity of class requirement abolished
- fee brackets abolished
- cap of 50 designs added

Fees reduced:

- Invalidity to 320 EUR
- Appeal to 720 EUR

Fees deleted:

- transfer
- inspection fee

IR renewal increased to 62 EUR

New fees:

- continuation of proceedings
- alteration

	Current fees	New fees
Application fee (incl. publication)	350	350
Fee for each design from the 2 nd to the 10 th	175	125
Fee for each design from the 11 th design onwards	80	125
Renewals		
1 st	90	150
2 nd	120	250
3 rd	150	400
4 th	180	700



Clarified object and scope of a design right

Scope of exclusive right

- Acts enabling copies to be made using 3D Printing technologies
- Seizure of counterfeit goods in transit

Limitations of the effects of a design include

- Referential use
- Acts for purpose of comment, critique and parody



Clarified object and scope of a design right

Spare parts protection regime harmonized





Simplified and streamlined procedures

Easier filing and communication

- Unity of class requirement abolished
- Article 6ter of Paris convention – new ground prohibiting registration
- Changes to deferment and renewal regimes
- Amendment and alteration regime



Simplified and streamlined procedures

Easier filing and communication

- Simplified design invalidity procedures, i.e. to allow 'fast-track invalidation'
- E-COM sole means of communication with the Office
- Partial invalidity abolished
- Possibility of proof of use

Registration symbol

The holder of a registered EU design may inform the public that the design is registered by displaying on the product in which the design is incorporated or to which it is applied the letter D enclosed within a circle. Such design notice may be accompanied by the registration number of the design or hyperlinked to the entry of the design in the Register.';





Challenges ahead

- EU harmonization of laws and practices
- International harmonization of laws and practice Design awareness raising
- Designs in the future



Thank you

For more details we invite you to watch:

TUESDAY WEBINARS LIVE

EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

EU design legislative reform

Tuesday 16 April 2024
10:00 to 11:30 (CEST)

Speaker:
Gailé SAKALAITÉ - Legal Department, EUIPO

Please send questions to the DesignDay@uspto.gov mailbox



Updates on Design Patents in China 2024

Toby Mak, Patent Attorney
Tee & Howe IP Attorneys

Please send questions to the DesignDay@uspto.gov mailbox.



Fireside Chat with PTAB Administrative Patent Judges

Tracey Durkin

Sterne, Kessler, Goldstein & Fox PLLC

Hon. Robert Kinder

PTAB USPTO

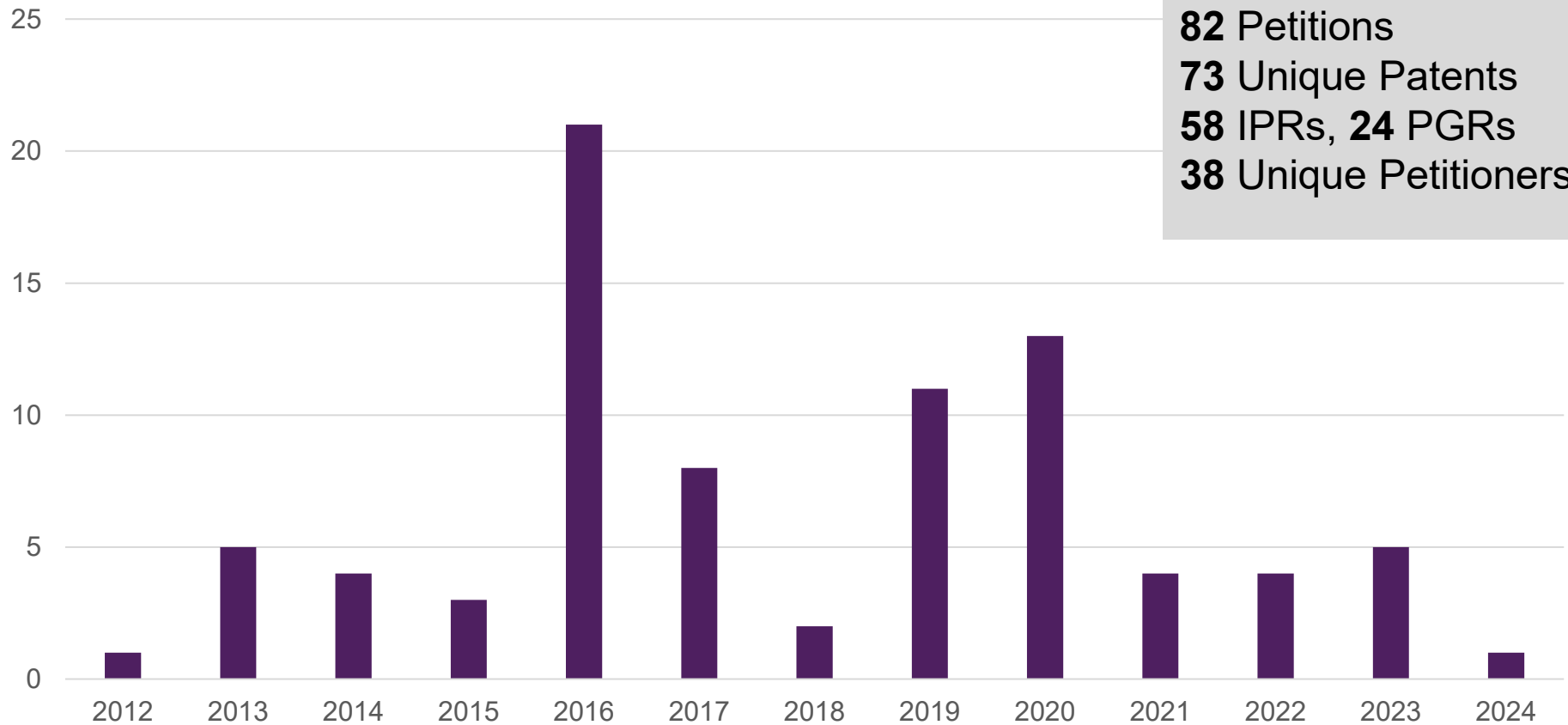
Hon. Rae Lynn Guest

PTAB USPTO

Please send questions to the DesignDay@uspto.gov mailbox.



PTAB Petitions Against Design Patents



Design Patents at the PTAB

Top Petitioners

Petitioner	Proceedings
LKQ Corp./Keystone Automotive	20
Skechers USA	15
Trinity Manufacturing	4
Campbell Soup Co.	4
Masimo Corp.	4
Graco Children's Products	3
Sensio Inc. d/b/a Made by Gather	3
Sattler Tech Corp. d/b/a Wali Electric	2
Man Wah Holdings	2
Early Warning Services	2
Ideavillage Products Corp.	2
Dorman Products	2
Johns Manville Corp.	2
Samsung Electronics	2

Design Patents at the PTAB

Top Patent Owners

Patent Owner	Proceedings
GM	20
Nike	15
Apple	4
Gamon Intl.	4
Kolcraft	3
Select Brands	3
PACCAR	2
Knauf Insulation	2
Raffel Systems	2
Koninklijke Philips	2
Wepay Global Payments	2

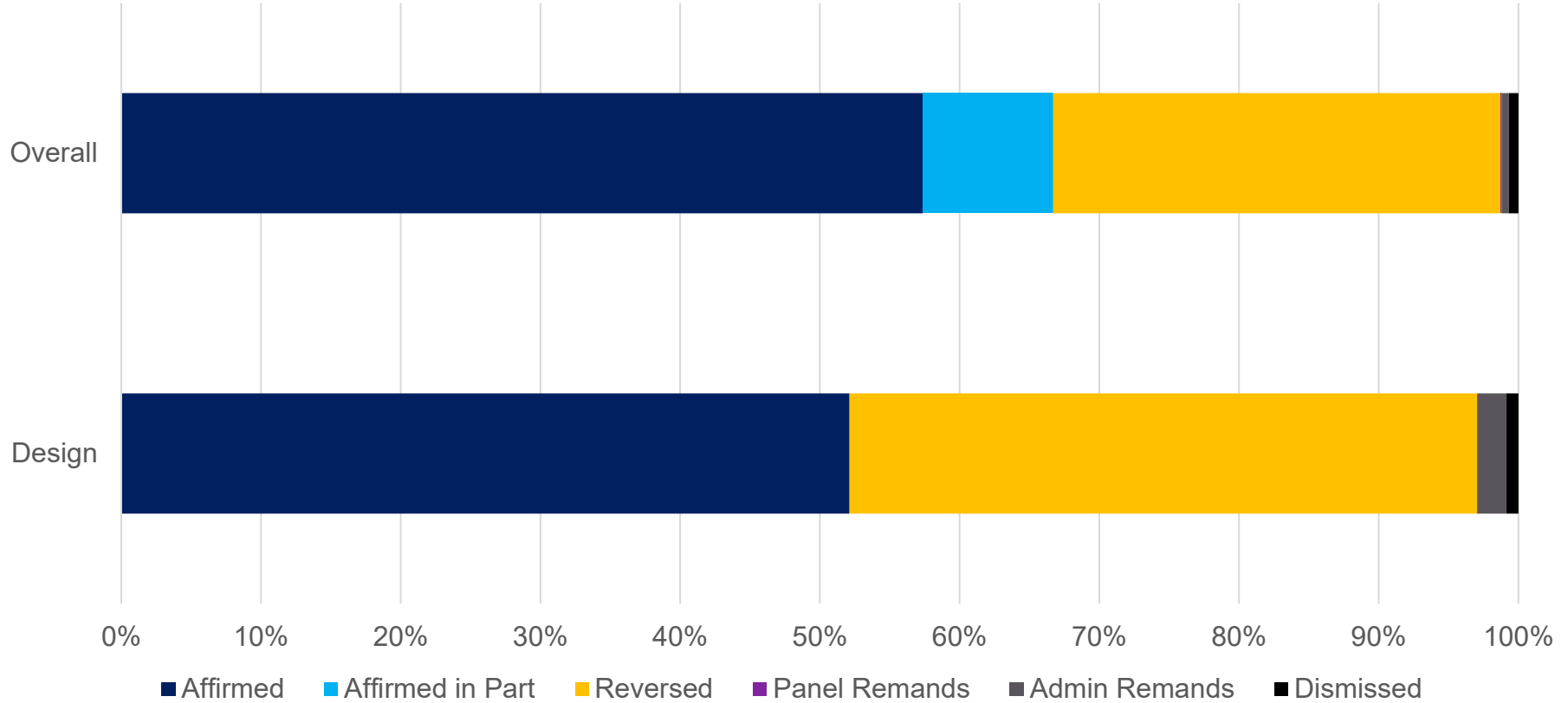
IPR/PGR Claim Outcomes

Design Patents

- The institution rate for design patent IPRs/PGRs is only **38%** (30/78), slightly higher for IPRs, slightly lower for PGRs
- At final written decision, 17 design patent claims have been cancelled, and 9 have been ruled not unpatentable, a 65% claim cancellation rate overall, with similar cancellation rates for both IPRs and PGRs

Ex Parte Appeal Outcomes

FY2020-24



Takeaways

- When challenged at the PTAB, design patents have been more likely to stand up to Board scrutiny at both institution and final written decision when compared to
- Design patent PTAB challenges have been rare. The LKQ/GM series of proceedings accounts for nearly one-quarter of all design patent PTAB challenges (20/82).
- Though ex parte appeals of design applications are also relatively rare, the reversal rate in design applications is higher than the PTAB baseline for the last several years (45% vs. 32%).

Fireside Chat with PTAB Administrative Patent Judges

Tracey Durkin

Sterne, Kessler, Goldstein & Fox PLLC

Hon. Robert Kinder

PTAB USPTO

Hon. Rae Lynn Guest

PTAB USPTO

Please send questions to the DesignDay@uspto.gov mailbox.



Report from the Front Lines



Alaina Pak

Design Day 2024

Federal
Circuit
2023

Columbia Sportswear North America, Inc.

v.

Seirus Innovative Accessories, Inc.

LKQ Corporation

v.

GM Global Technology Operations LLC

Columbia Sportswear North America, Inc.

v.

Seirus Innovative Accessories, Inc.

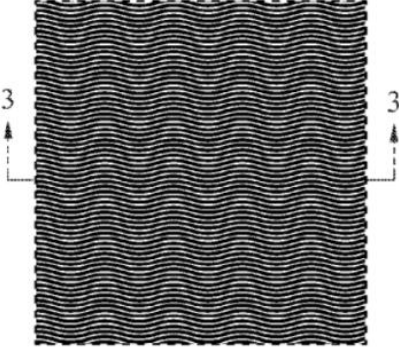
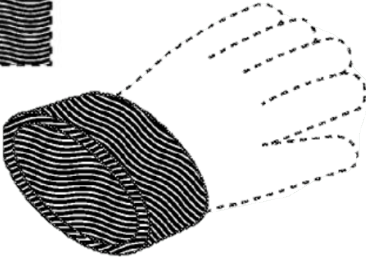



Columbia Sportswear North America, Inc.

v.

Seirus Innovative Accessories, Inc.

- Found that the scope of comparison prior art should be limited to the identified article of manufacture
- Reiterated that ornamental logos may be considered

Columbia Sportswear in District Court

Columbia's U.S. Pat. No. D657,093	Seirus's HEATWAVE Products
<p data-bbox="297 314 877 422">(57) CLAIM The ornamental design of a heat reflective material, as shown and described.</p>  <p data-bbox="336 828 459 864">FIG. 1</p>  <p data-bbox="788 980 929 1016">FIG. 8</p>	  

Columbia Sportswear in District Court

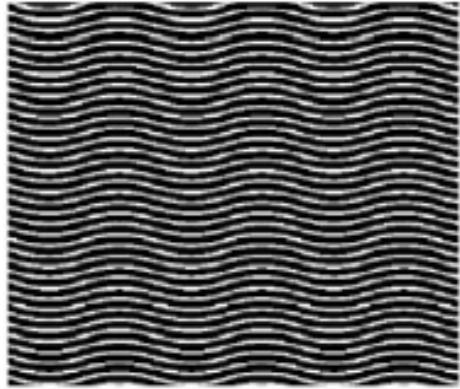
- Ordinary Observer Test for Design Patent Infringement
 - “[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same...”
 - Egyptian Goddess Test
 - **Comparison Prior Art vs. Accused Design vs. Patented Design**
 - The “ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art,” and “when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer”

Columbia Sportswear in District Court

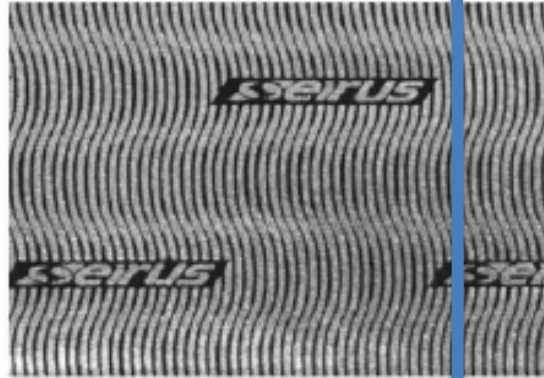
- Comparison Prior Art

Seirus Offered	District Court
<div style="border: 2px solid black; padding: 5px; text-align: center;"> <p>2,539,890</p> <p>METHOD OF PROVIDING PLASTIC SHEETS WITH INLAID STRIPES</p> <p>Howard F. Boorn, Tenafly, N. J., assignor to</p> </div>	<p>Products are “far afield” from Columbia’s Asserted Patent’s <i>heat reflective material</i> → not relevant comparison prior art</p>
<div style="border: 2px solid black; padding: 5px; text-align: center;"> <p>Patented Nov. 18. 1924. 1,515,792</p> <p>UNITED STATES PATENT OFFICE.</p> <p>ROLAND B. RESPESS, OF NEW YORK, N. Y., ASSIGNOR, BY MESNE ASSIGNMENTS, TO RESPRO INC., OF CRANSTON, RHODE ISLAND, A CORPORATION OF RHODE ISLAND.</p> <p>UNWOVEN FABRIC AND PROCESS FOR MAKING THE SAME.</p> </div>	
<div style="border: 2px solid black; padding: 5px;"> <p>United States Patent [19] [11] Patent Number: 5,626,949</p> <p>Blauer et al. [45] Date of Patent: *May 6, 1997</p> <hr/> <p>[54] BREATHABLE SHELL FOR OUTERWEAR 3,703,730 11/1972 Miller 2/272 <small>3,794,548 2/1974 Wirth et al. 161/89</small></p> </div>	<p>→ comparison prior art</p>

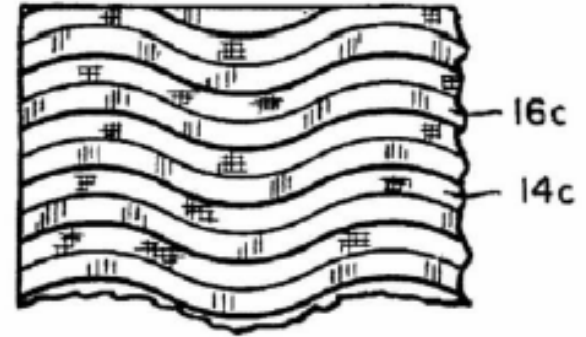
Columbia Sportswear in District Court



Columbia's D'093 patent



Seirus's HeatWave

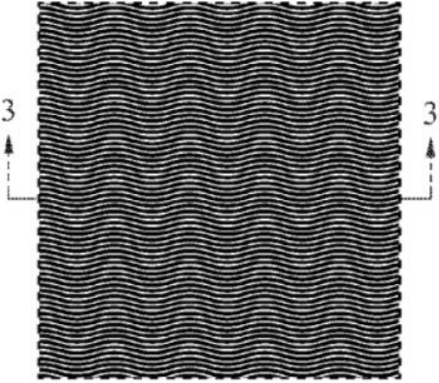



United States Patent ^[19]
Blauer et al.

[54] BREATHABLE SHELL FOR OUTERWEAR

Columbia Sportswear in District Court

Logos throughout make the design different enough

Columbia's U.S. Pat. No. D657,093	Seirus's HEATWAVE Products
 <p data-bbox="490 960 625 1004">FIG. 1</p>	

Columbia Sportswear in District Court



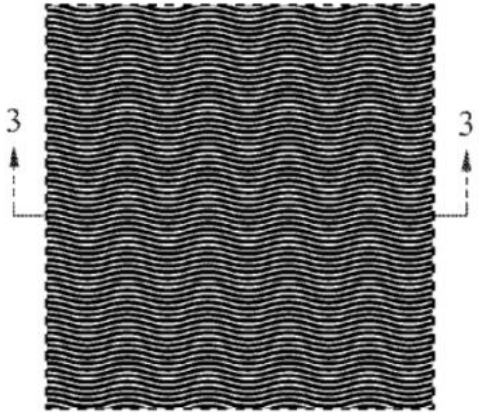

Patented shoe design



Accused shoe (mark in red)

**Precedent:
disregard logos
in infringement
analysis**



Columbia's U.S. Pat. No. D657,093	Seirus's HEATWAVE Products
 <p>FIG. 1</p>	

Columbia Sportswear in District Court

- Summary judgment of infringement
 - Declined to consider 2 of 3 of Seirus's comparison prior art references
 - Declined to consider logo in infringement analysis
- Jury awarded Columbia \$3M+
- Seirus appealed

“Columbia I” (Fed. Cir. 2019)

- *District Court: Summary judgment of infringement*
 - *Declined to consider 2 of 3 of Seirus’s comparison prior art references*
 - *Declined to consider effect of logo in infringement analysis*
- **Columbia I: Vacated and Remanded**
 - Jury, not district court, should have compared *Comparison Prior Art vs. Accused Design vs. Patented Design*
 - Logo placement and appearance may be considered. But a “would-be infringer should not escape liability for design patent infringement if a design is copied but labeled with its name”

On remand, the jury found no infringement. Columbia appealed.

“Columbia II” (Fed. Cir. 2023)

- The scope of **comparison prior art** is limited to the article of manufacture identified in the claim

(57)

CLAIM

The ornamental design of a heat reflective material, as shown and described.

- *“prior-art designs will help in that comparison only to the extent that they too are applied to that article of manufacture”*
- *“This standard is already in the system.”*
- *“easy to articulate and provides clear boundaries”*

“Columbia II” (Fed. Cir. 2023)

- “*This standard is already in the system.*”
 - *In re SurgiSil*: To be **anticipatory**, the **prior art** must be applied to the article of manufacture identified in the claim.
 - *Curver*: To be **infringing**, the **accused designs** must be applied to the article of manufacture identified in the claim.
 - Now... *Columbia II*: To be **comparison prior art**, the **prior art** must be applied to the article of manufacture identified in the claim.

“Columbia II” (Fed. Cir. 2023)

- **Logos**

- Court did not instruct jury regarding the distinction between trademark law and design patent law
- “In design-patent-infringement cases involving logos, we appreciate the potential for a jury to be led astray and mistakenly conflate the significance of a logo’s source-identifying function with whatever impact it might have on a comparison of the designs. But district courts are in the best position to decide whether and when to provide clarification in the course of conducting a trial.”

Columbia Sportswear North America, Inc.

v.

Seirus Innovative Accessories, Inc.

- Found that the scope of comparison prior art should be limited to the identified article of manufacture
- Reinforced that ornamental logos should be considered

LKQ Corporation

v.

***GM Global Technology Operations
LLC***

LKQ Corporation

v.

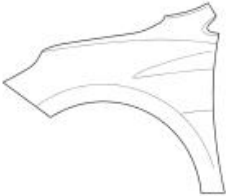


***GM Global Technology Operations
LLC***

- Issue: standard for obviousness analysis for design patents
- En Banc hearing on Feb. 5, 2024; decision pending
 - The last en banc opinion in a design patent case was in 2008 (*Egyptian Goddess*)

LKQ at the PTAB

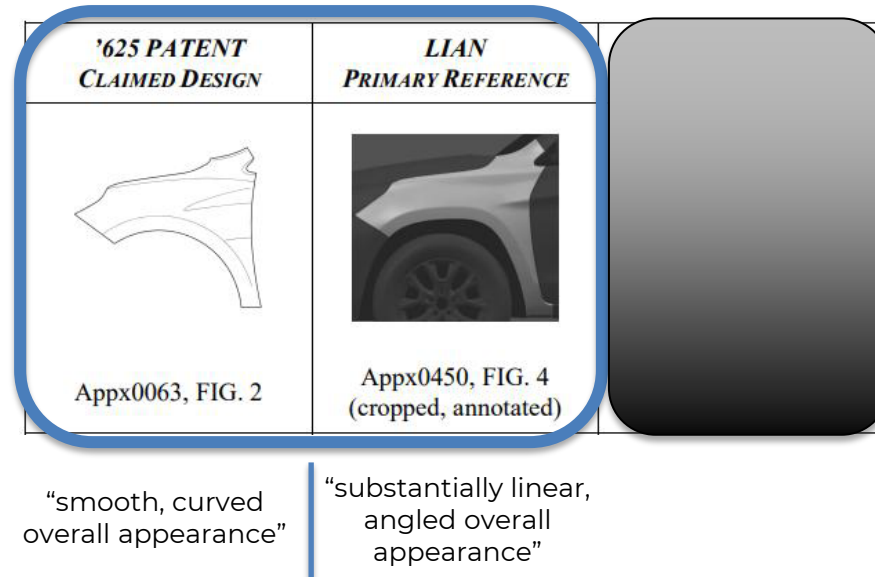
- LKQ was a licensed part vendor for GM until failed license renewal negotiations
 - → unlicensed parts allegedly infringed GM's design patents
- LKQ petitioned for IPR to invalidate GM's D797,625 Patent

- IPR instituted

<i>'625 PATENT CLAIMED DESIGN</i>	<i>LIAN PRIMARY REFERENCE</i>	<i>TUCSON SECONDARY REFERENCE</i>
 <p data-bbox="794 1004 1020 1033">Appx0063, FIG. 2</p>	 <p data-bbox="1128 988 1373 1052">Appx0450, FIG. 4 (cropped, annotated)</p>	 <p data-bbox="1470 988 1707 1052">Appx0464 (cropped, rotated)</p>

LKQ at the PTAB

- Ordinary observer: retail consumers and commercial replacement part buyers who purchase replacement fenders
- **No anticipation** because of key differences between claimed design and primary reference



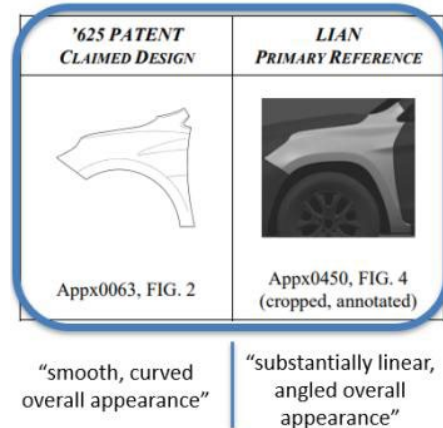
LKQ at the PTAB

- Obviousness standard: *Rosen* and *Durling*
 - **Step 1:** Does a primary (“Rosen”) reference exist with characteristics “basically the same” as the claimed design?
 - **Step 2:** If so, would an ordinary designer have modified the primary reference to create a design with the same overall visual appearance as the claimed design?

LKQ at the PTAB

- **No obviousness**

- **Step 1:** Does a primary (“Rosen”) reference exist with characteristics “basically the same” as the claimed design?



- ~~**Step 2:** If so, would an ordinary designer have modified the primary reference to create a design with the same overall visual appearance as the claimed design?~~

LKQ at the PTAB

- LKQ did not show that GM's patent was anticipated or obvious
- PTAB ruled in GM's favor

**→ LKQ
appealed.**

LKQ at the Federal Circuit (2023)

- LKQ argued that the *KSR* obviousness standard for utility patents, (rather than the *Rosen and Durling* test) should apply to design patents.

<i>Rosen and Durling</i>	<i>KSR</i>
<p>Step 1: Does a primary (“Rosen”) reference exist with characteristics “basically the same” as the claimed design?</p> <p>Step 2: If so, would an ordinary designer have modified the primary reference to create a design with the same overall visual appearance as the claimed design?</p>	<p><i>KSR</i> mandated flexibility in the:</p> <p>scope of the prior art (prior art need not address the specific problem the inventors contemplated)</p> <p>motivation to modify the prior art (can apply common sense)</p>

LKQ at the Federal Circuit (2023)

- **Affirmed.**
 - “[I]t is not clear the Supreme Court has overruled *Rosen* or *Durling*. The panel is therefore bound to apply existing law to this appeal.”

→ **LKQ filed a petition for rehearing en banc.**

LKQ at the Federal Circuit (En Banc, 2024) - TBD

- What obviousness standard should apply to design patents?
 - *Rosen and Durling*?
 - *KSR*?
 - Something else?

LKQ at the Federal Circuit (En Banc, 2024) - TBD

- Arguments re **Rosen and Durling** standard

<u>For Rosen and Durling</u>	<u>Against Rosen and Durling</u>
No invalidating designs based on “FrankenArt”	Inconsistent with <i>KSR</i>
Step 1 does allow some flexibility <i>(Does a primary reference exist with characteristics “basically the same” as the claimed design?)</i>	Too strict
Settled law and continued predictability	Too advantageous to large companies like GM “Subsequent designers are forced to transact around commonplace designs that have secured a patent and consumers face higher prices.”

LKQ at the Federal Circuit (En Banc, 2024) - TBD

- Arguments re **KSR** approach

<u>For</u> KSR approach	<u>Against</u> KSR approach
Establishes consistency with Supreme Court decision	No meritorious grounds to overturn existing standard
<i>Graham</i> and <i>KSR</i> should and can be applied in both utility and design cases	<i>KSR</i> may not carry over well to designs
	Uncertainty and confusion; weakened design system

LKQ at the Federal Circuit (En Banc, 2024) - TBD

- Options
 - Keep *Rosen* and *Durling*
 - Modify *Rosen* and *Durling*
 - Overrule *Rosen* and *Durling*
 - Create new test
 - Something else?
- If LKQ succeeds
 - Long-standing two-step standard dropped → flexible standard
 - Design patents easier to invalidate → increased focus on invalidity challenges



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71 SOUTH WACKER DRIVE / SUITE 3600
CHICAGO IL 60606-7407

WASHINGTON DC

1100 13TH STREET NW / SUITE 1200
WASHINGTON DC 20005-4051

BOSTON

28 STATE STREET / SUITE 1800
BOSTON MA 02109-1705

PORTLAND

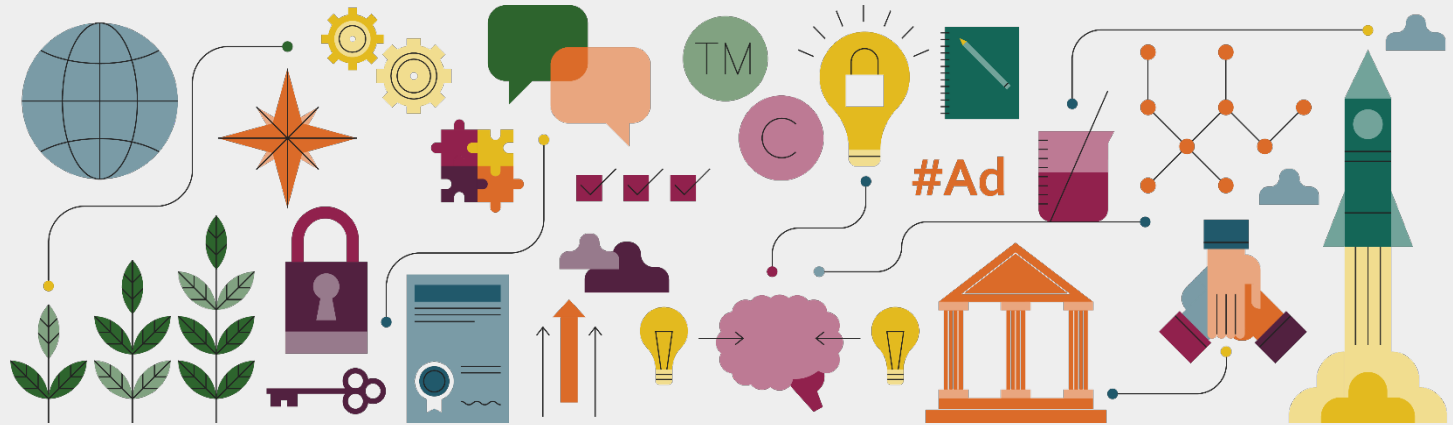
ONE WORLD TRADE CENTER
121 SOUTHWEST SALMON STREET / 11TH FLOOR
PORTLAND OR 97204

FINNEGAN

Design Patents at the PTAB 2023-2024

May 9, 2024

Kelly S. Horn
Associate



Agenda



Hangzhou v. EP Family (IPR2023-00658)

Institution Granted

Masimo v. Apple (IPR2023-00774)

Institution Denial

Masimo v. Apple (IPR2023-00831)

Institution Denial

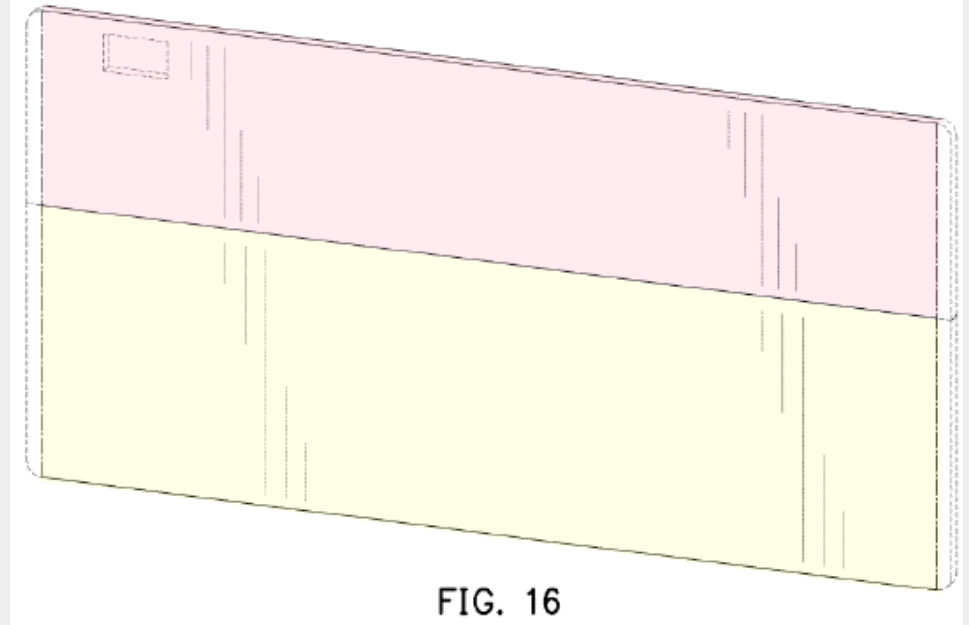
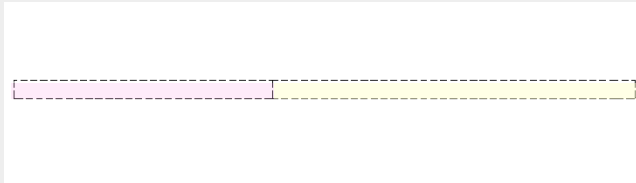
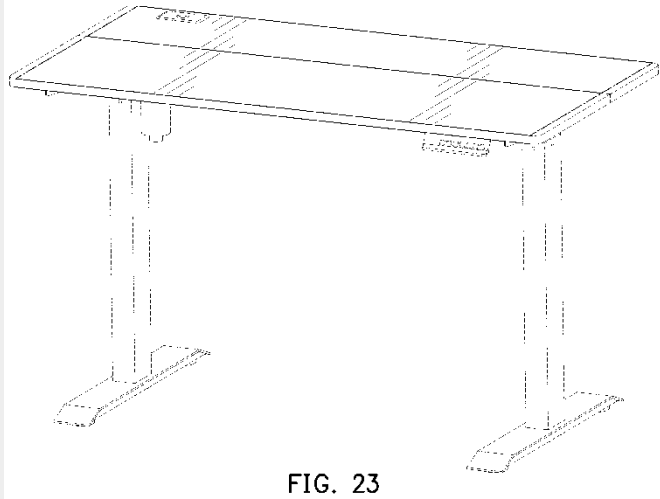
Hangzhou v. EP Family

IPR2023-00658, Institution Decision (Paper 8, Sept. 1, 2023)

- U.S. Patent No. D934,012
 - “ornamental design for a table top”
- Asserted Unpatentability Grounds:

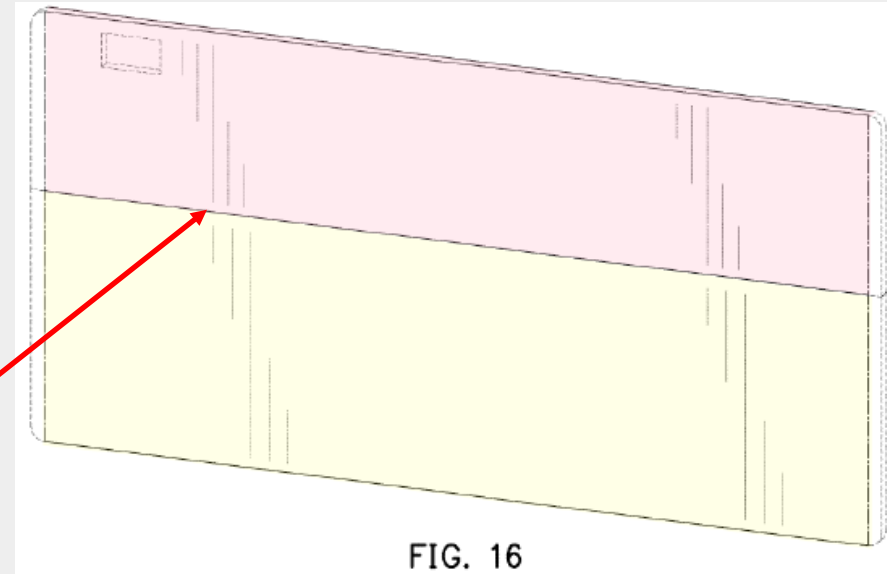
Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1	102 ³	Morgan ⁴
2	1	103	Morgan
3	1	103	Galant, ⁵ Morgan
4	1	102	Bordonabe ⁶
5	1	103	Bordonabe
6	1	103	Galant, Bordonabe
7	1	102	Iannaccone ⁷
8	1	103	Iannaccone
9	1	103	Galant, Iannaccone

'012 Patent – Claim Construction (Formal)

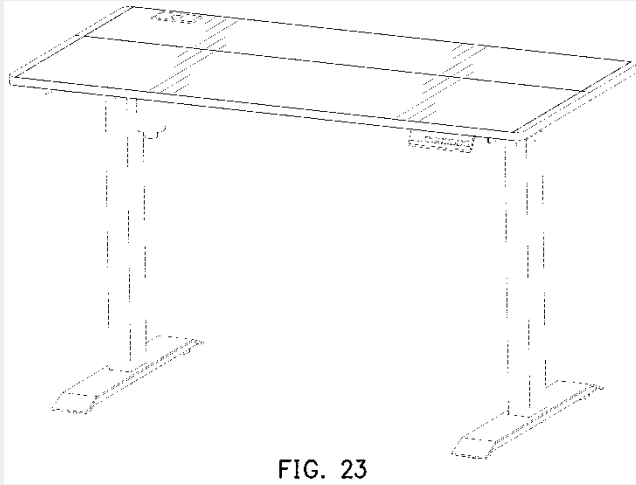


'012 Patent – Claim Construction (Informal)

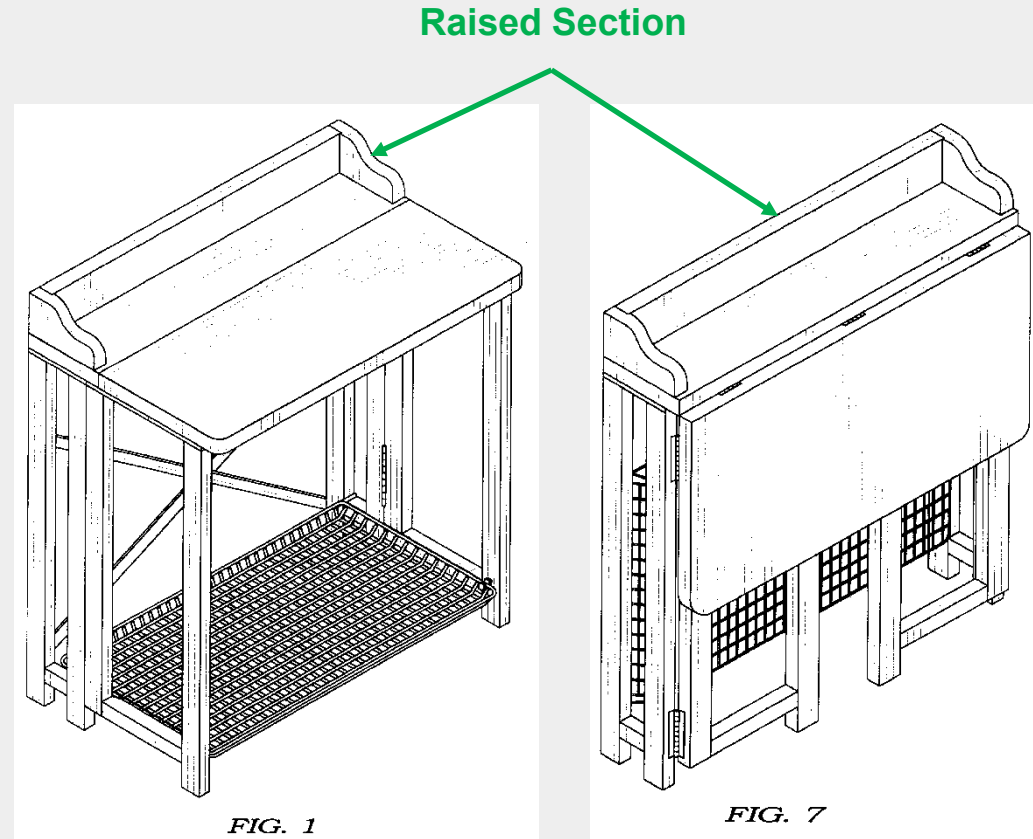
- Two rectangular portions of matching thickness and equal length
- One rectangular portion is wider than the other
 - Narrower portion is slightly more than $\frac{1}{2}$ width of wider portion
- Portions are joined together along a matching long edge forming a visible seam extending the length of the table top and being off-center due to relative widths of the portions



Hangzhou: Comparison

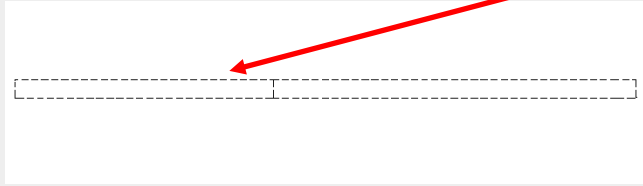


'012 Patent

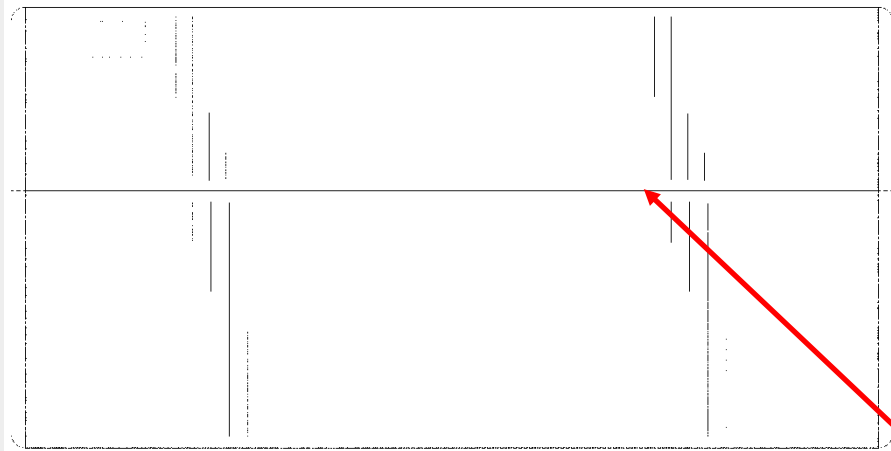
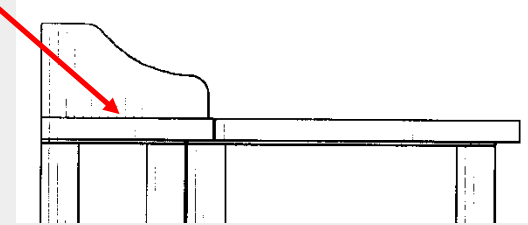


Proposed Reference

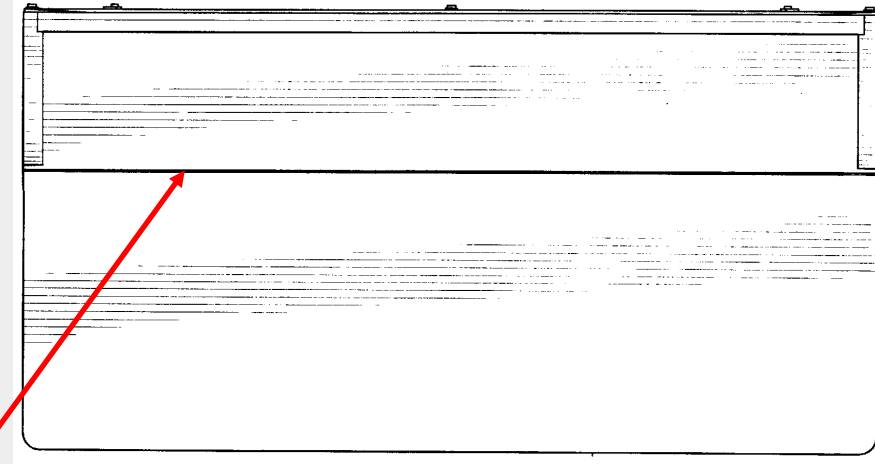
Hangzhou: Comparison



slightly more
than half width
of wider portion



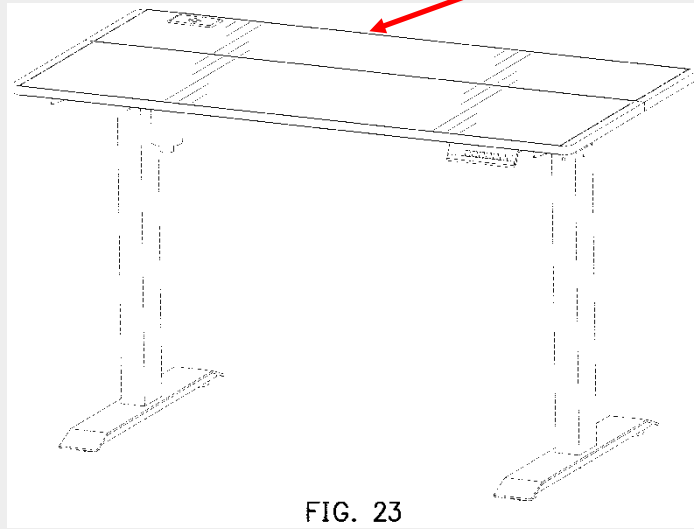
'012 Patent



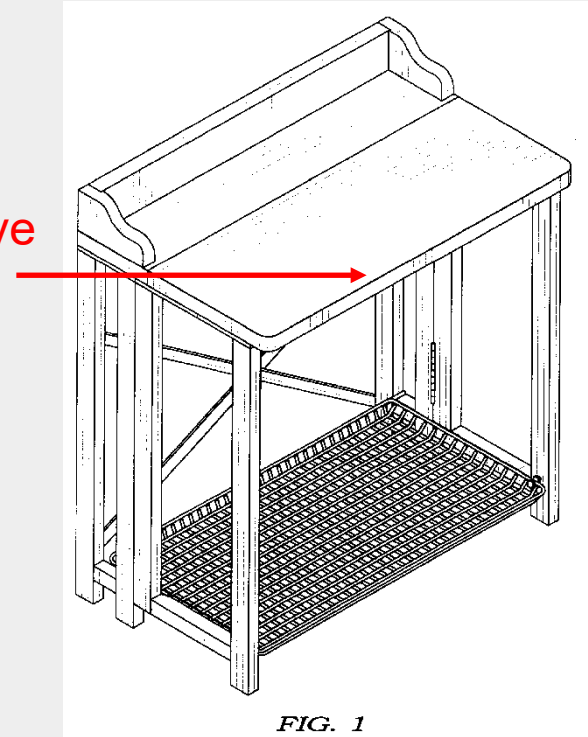
Proposed Reference

off-center seam

Hangzhou: Differences



'012 Patent



Proposed Reference

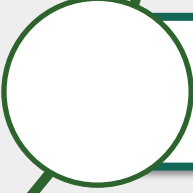
Agenda



Hangzhou v. EP Family (IPR2023-00658)



Masimo v. Apple (IPR2023-00774)



Masimo v. Apple (IPR2023-00831)

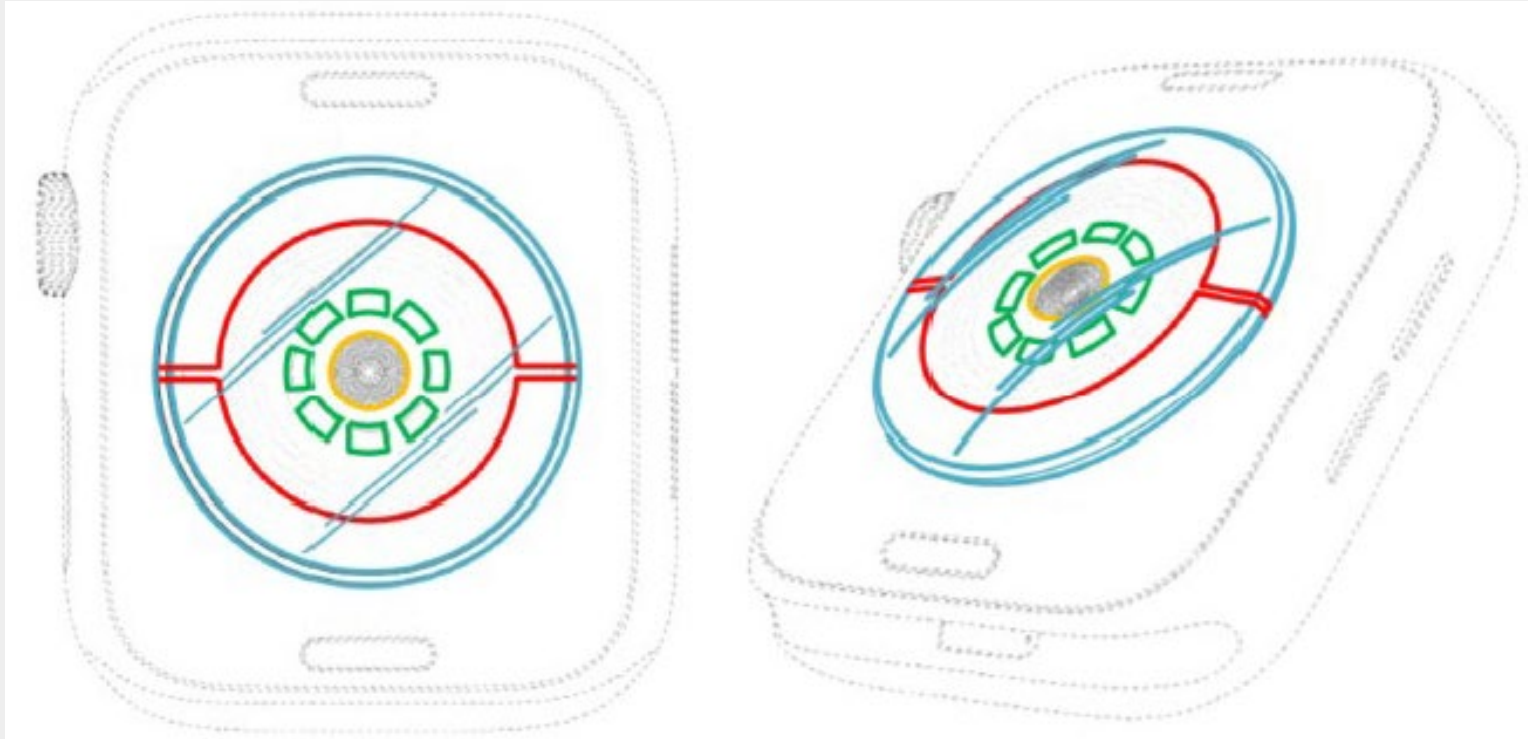
Masimo v. Apple

IPR2023-00774, Institution Denial (Paper 9, Sept. 27, 2023)

- U.S. Patent No. D883,279
 - “ornamental design for an electronic device”
- Asserted Unpatentability Grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1	103 ³	Paulke, Mendelson, Bushnell, Chung
1	103	Yuen, Mendelson, Bushnell, Chung
1	103	Fong, Mendelson, Bushnell, Chung

'279 Patent – Claim Construction



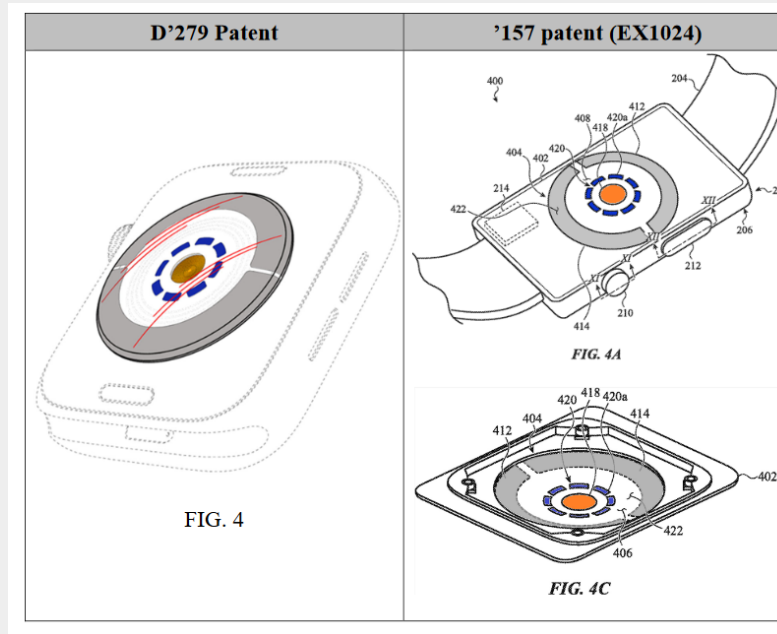
'279 Patent – Functional Elements

Petitioner: '279 patent includes functional design elements that should be factored out of the claim's scope



'279 Patent – Functional Elements

Petitioner: '279 patent includes functional design elements that should be factored out of the claim's scope



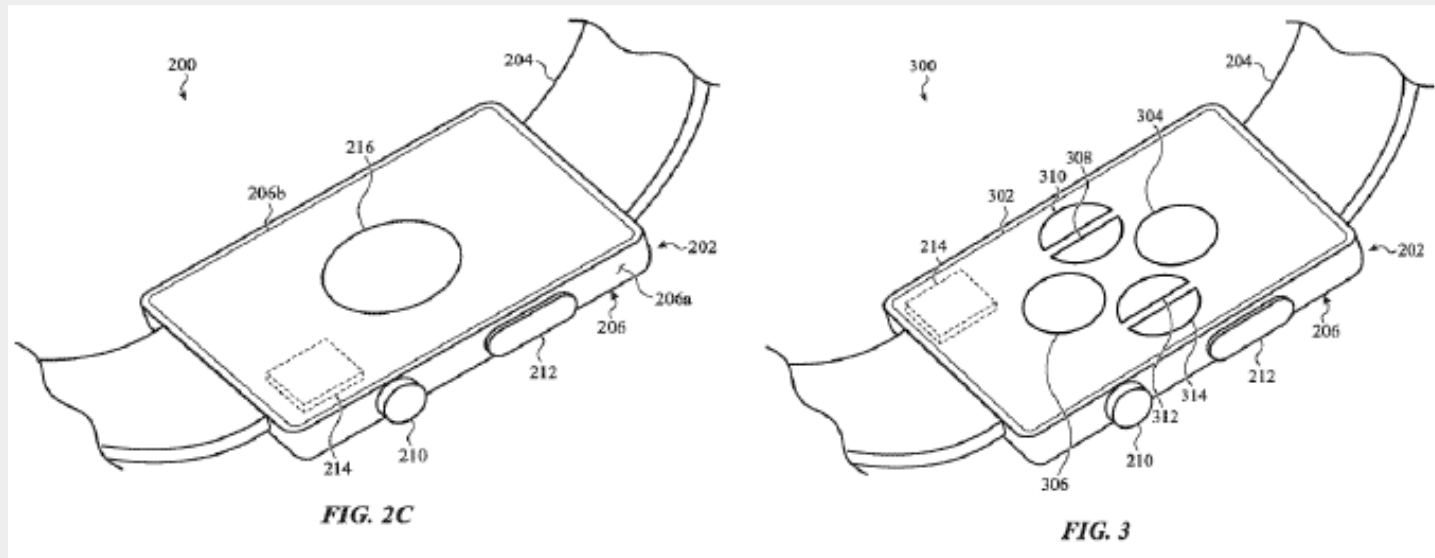
'279 Patent – Functional Elements

Board: Even if some individual elements have functional purpose, piecemeal exclusion proposed by Petitioner does not adequately account for “overall appearance” of design

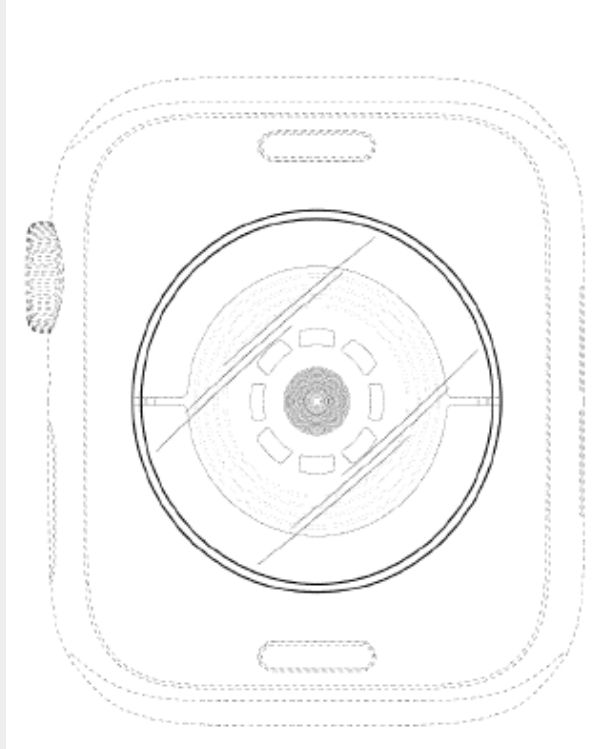


'279 Patent – Functional Elements

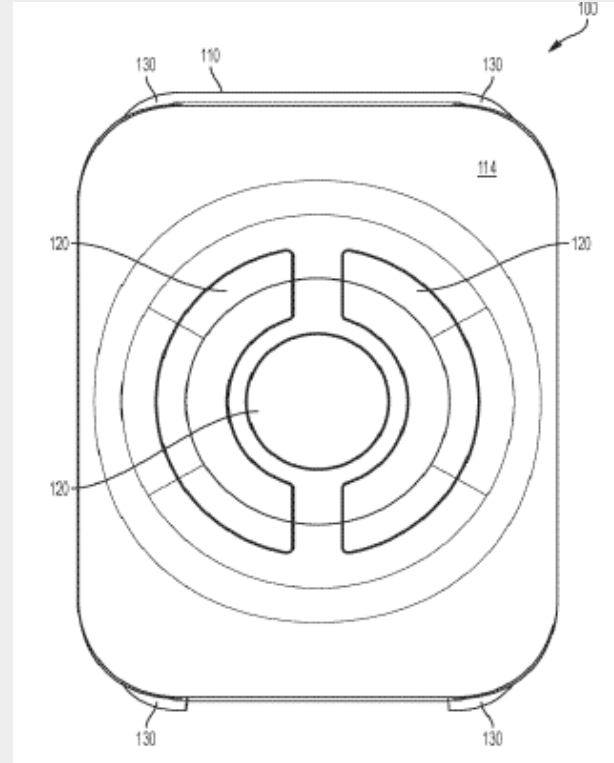
Board: Even if some individual elements have functional purpose, piecemeal exclusion proposed by Petitioner does not adequately account for “overall appearance” of design



Masimo – Unsuitable Primary References

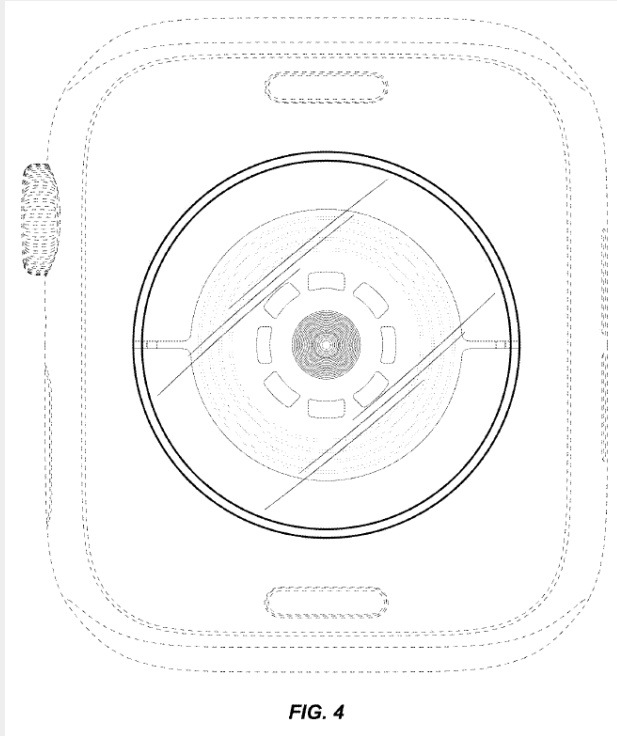


'279 Patent

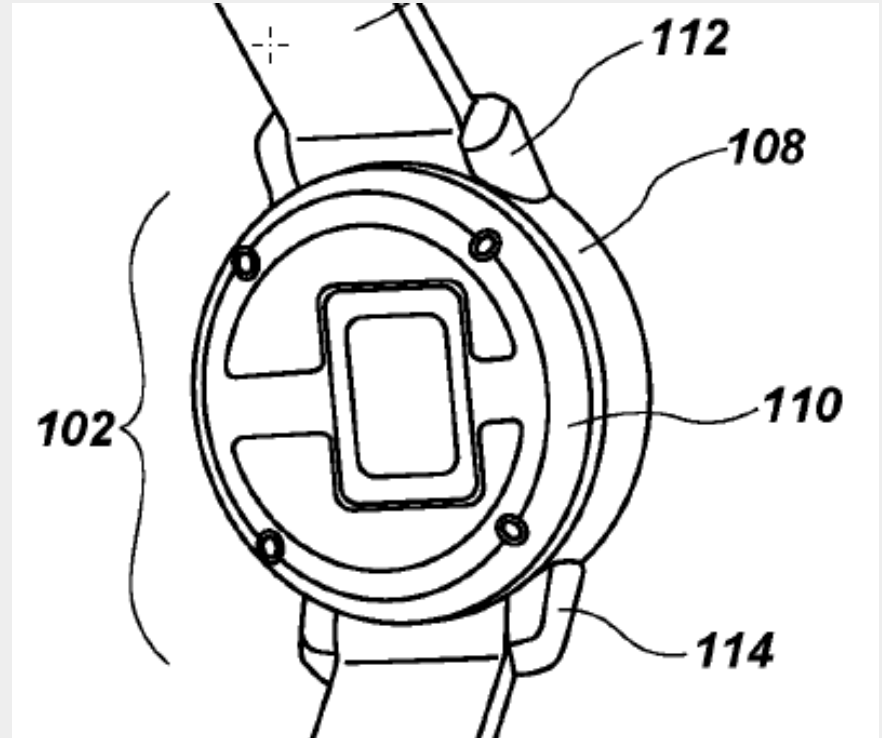


Proposed Reference

Masimo – Unsuitable Primary References



'279 Patent



Proposed Reference


Agenda



Hangzhou v. EP Family (IPR2023-00658)



Masimo v. Apple (IPR2023-00774)



Masimo v. Apple (IPR2023-00831)

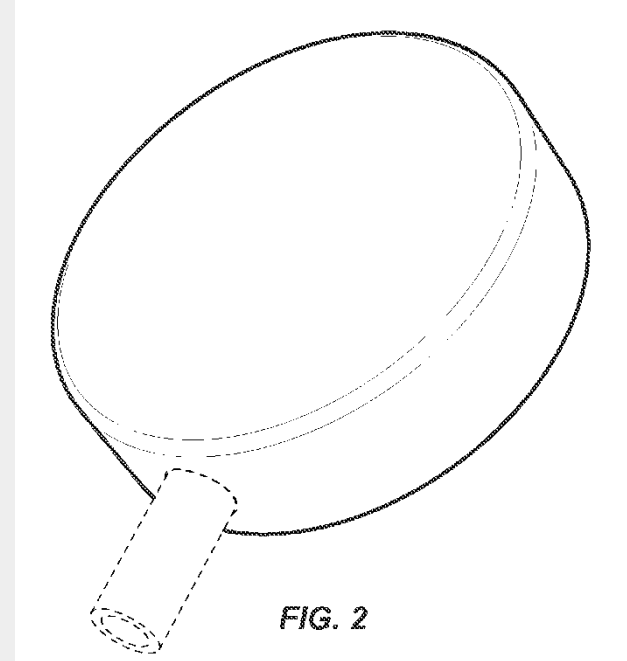
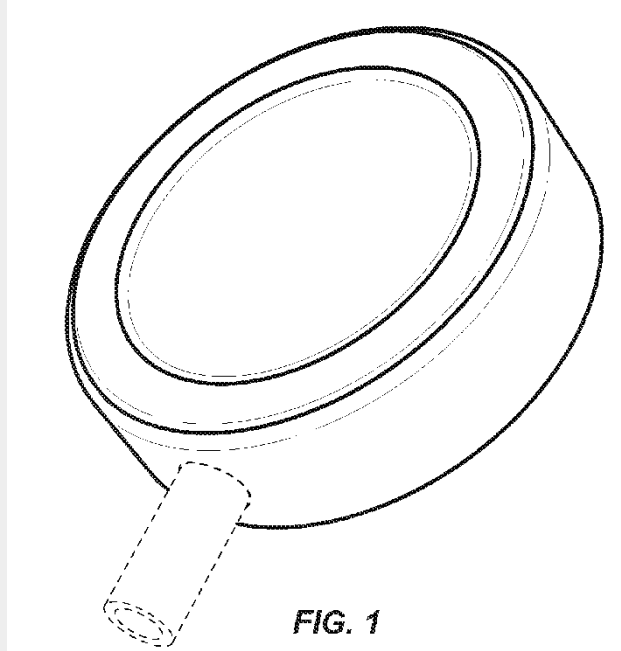
Masimo v. Apple

IPR2023-00831, Institution Denial (Paper 9, Nov. 21, 2023)

- U.S. Patent No. D735,131
 - “ornamental design for a charger”
- Asserted Unpatentability Grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1	103 ²	Lee ³
2	1	103	Lee, Chiang ⁴
3	1	103	CN-470 ⁵
4	1	103	CN-470, Chiang
5	1	103	Murray ⁶

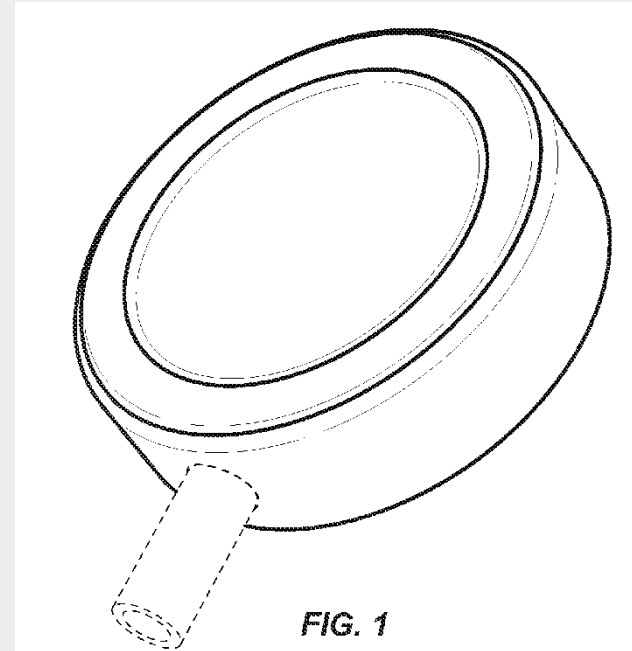
'131 Patent – Claim Construction



'131 Patent – Claim Construction

Overall appearance of a compact ice hockey puck

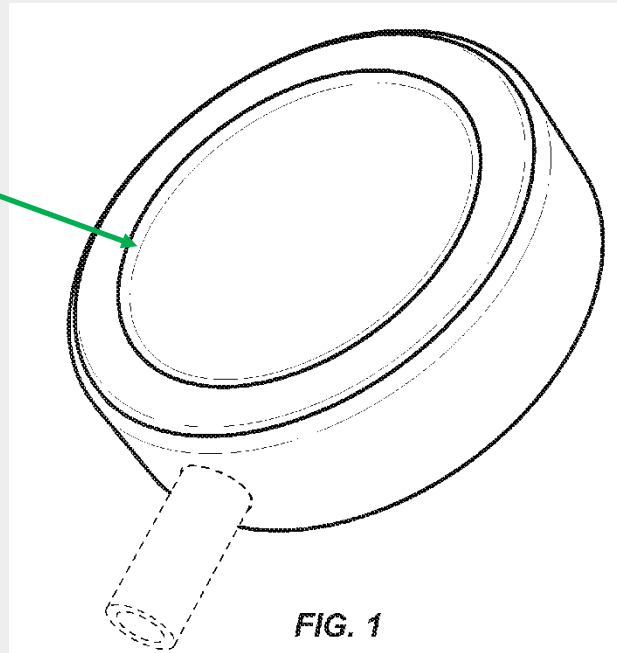
- overall cylindrical shape
- top face with prominent circular recess inset relative to a flat ring having distinct proportional width relative to circular recess
- overall cylindrical shape has distinct ratio of width (i.e., diameter) to height to evoke appearance of compact ice hockey puck
- non-orthogonal transitional edges (i.e., curved or beveled) between sidewall and top/bottom surfaces
- featureless flat bottom surface and sidewall



'131 Patent – Claim Construction

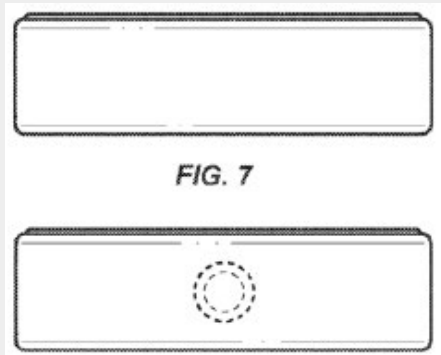
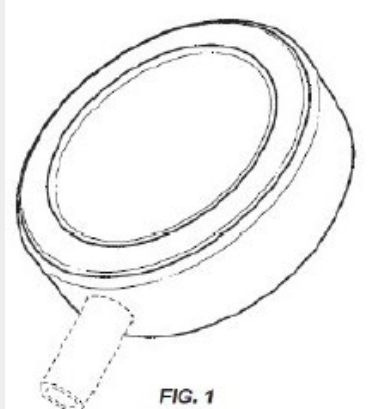
Board: “We cannot discern from the figures that the circular recess as illustrated in the Figures is concave.”

circular line shows recess or depression



Specification: “[t]he shade lines in the Figures show contour and not surface ornamentation.”

Masimo – Unsuitable Primary Reference



'131 Patent

Proposed Reference

FINNEGAN

Questions?

Our Disclaimer

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Report from the Front Lines: Federal District Court

Jeff Merrill
Patent Attorney
Booth Udall Fuller, PLC



BOOTH UDALL FULLER

INTELLECTUAL PROPERTY LAW

Recent Design Law Cases



- ⦿ Shibumi Shade, Inc. v. Beach Shade LLC (E.D. North Carolina) (December 29, 2023)
- ⦿ Jacki Easlick, LLC v. CJ Emerald (W.D. Pennsylvania) (January 26, 2024)
- ⦿ North Star Tech. Int'l Ltd. v. Latham Pool Prods. (E.D. Tennessee) (June 6, 2023)
- ⦿ Range of Motion Prods. v. The Armaid Co. (D. Maine) (August 28, 2023)

Shibumi Shade, Inc. v. Beach Shade LLC



- ④ Eastern District of North Carolina, December 29, 2023
- ④ Shibumi Shade asserted U.S. design patents D989,350 and D990,605 against Beach Shade.
- ④ Shibumi Shade moved for a preliminary injunction, and thus had to show that it was likely to succeed on the merits.

Shibumi Shade, Inc. v. Beach Shade LLC



☞ Shading System:

The '350 Patent

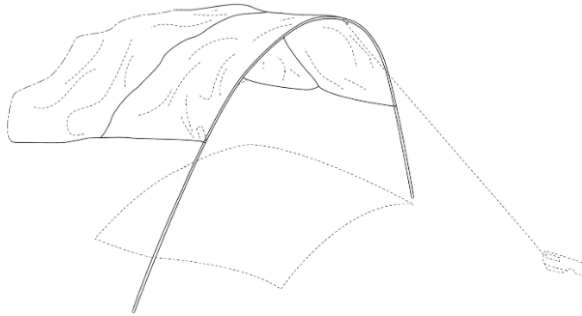


FIG. 1

The '605 Patent

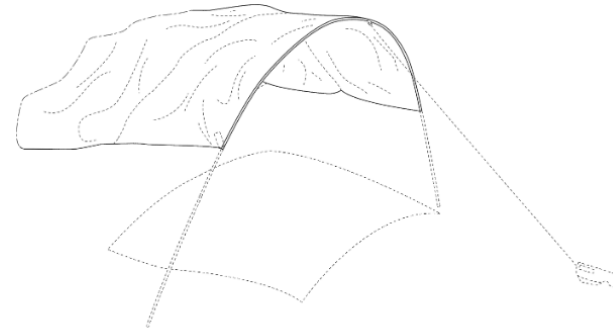


FIG. 1

Shibumi Shade – Claim Construction



- In the '350 patent, Shibumi Shade claimed “a canopy divided visually into two sections” and “the full arch.”
- In the '605 patent, Shibumi Shade claimed “a two-toned or solid free-flowing rectangular canopy attached on one side to an arch.”

Shibumi Shade – Functionality



- ④ “Any shading system must have, at least, a covering and a supporting structure. It is not necessary, however, for the covering or even the supporting structure to take any particular shape.”
- ④ “Where all functions of the claimed design could be performed by elements different from those described in the ’350 and ’605 design patents, there are no elements ‘driven purely by utility.’”

Shibumi Shade – Infringement



- ⦿ “In determining whether an accused product infringes a patented design,” the court asks whether “an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.”

Shibumi Shade, Inc. v. Beach Shade LLC



Shibumi Shade



Beach Shade



Shibumi Shade, Inc. v. Beach Shade LLC



Shibumi Shade



Beach Shade



Shibumi Shade – Infringement

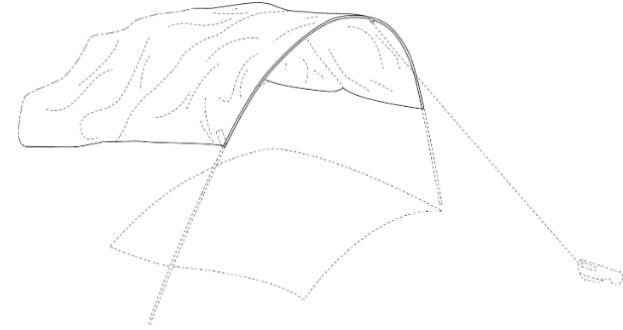


- ④ “For purposes of the ordinary observer, however, the accused product’s canopy is rectangular in shape, because the triangular cutouts are so small, and the rest of the canopy so large, that the cutouts evade notice by the casual observer.”
- ④ “When flying on the beach or depicted in marketing materials, as pictured below, the canopy appears rectangular to the ordinary consumer.”

Shibumi Shade – Infringement



- “Thus, the ordinary observer, viewing the accused product as a whole, likely would be deceived into believing that the accused product is the same as the patented design.”



Shibumi Shade – Key Takeaways



- ④ When preparing a design patent application, think about what the ordinary observer will see instead of focusing on the details of the design.
- ④ As a plaintiff, having multiple, related design patents of varying scope makes it easier for the court to adopt your position of infringement.

Jacki Easlick, LLC v. CJ Emerald



- ⦿ Western District of Pennsylvania, January 26, 2024
- ⦿ Jacki Easlick, LLC asserted U.S. design patent D695,526 against CJ Emerald and moved for a preliminary injunction.

Jacki Easlick, LLC v. CJ Emerald



© D695,526 – Handbag Hanger Hook

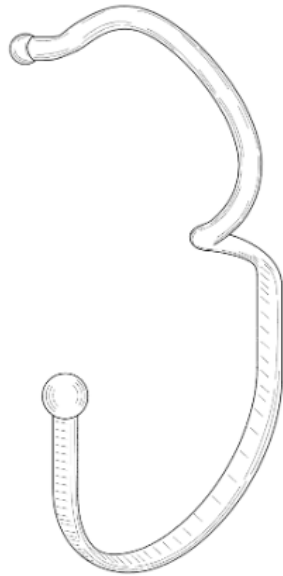


FIG. 1

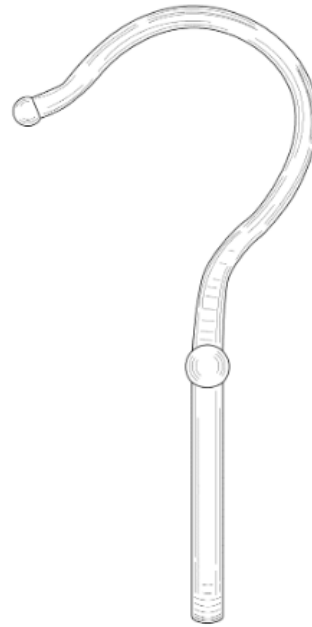


FIG. 2

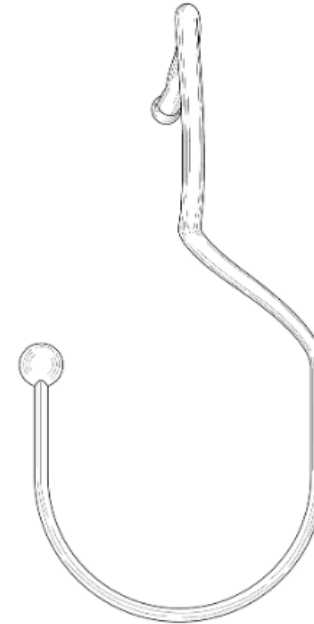


FIG. 4

Jacki Easlick – Functionality



- ④ “The functional purpose of the Tote Hanger is for consumers to hang and organize their handbags on closet rods. . . . Anyone seeking to design a handbag hanger hook will incorporate a top hook to attach to a rod-type structure that will support the weight of a handbag. The same is true of the bottom hook, which is needed to hold the handbag in place.”

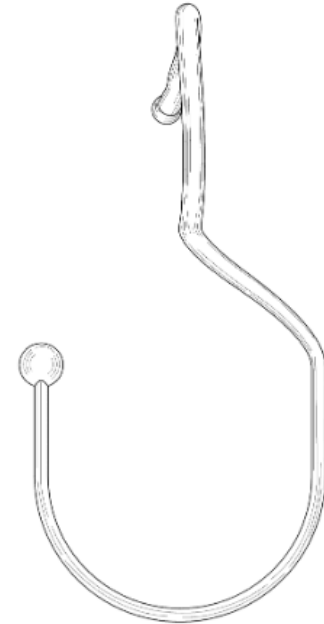


FIG. 4

Jacki Easlick – Functionality



- ④ “Additionally, the functional purpose of the Tote Hanger dictates the vertical configuration of the top and bottom hooks due to the necessity of having to place the hook that attaches to a rod-type structure above the bottom hook that holds the handbag.”

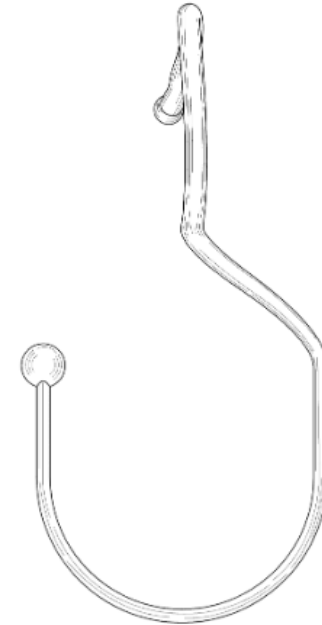


FIG. 4

Jacki Easlick – Functionality



- “The Design Patent, however, still protects the ornamental features of the Tote Hanger’s top and bottom hooks, which include, among other non-functional features, the shape of the hooks, the flare out of the top hook’s tip, the 90-degree offset of the top and bottom hooks, and the spheres on the end of each hook.”

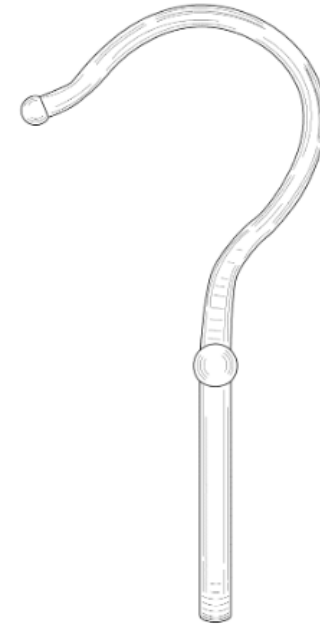
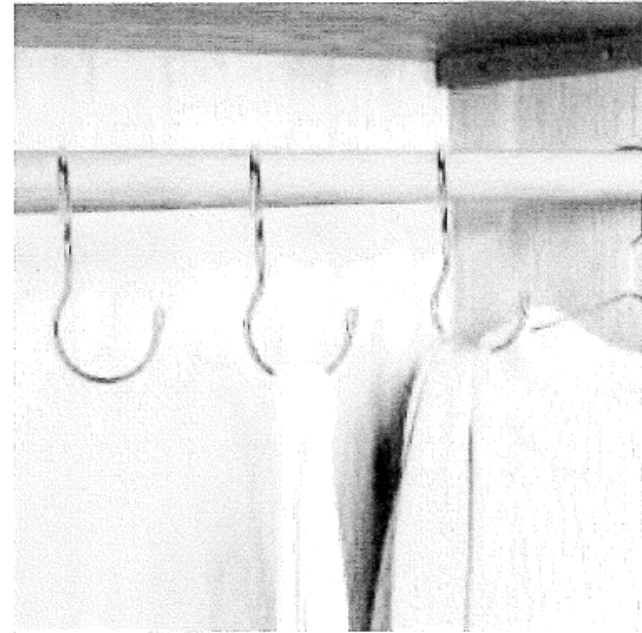
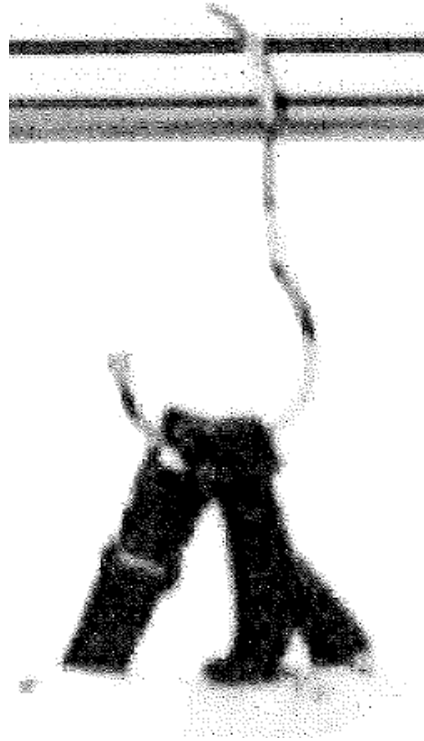


FIG. 2

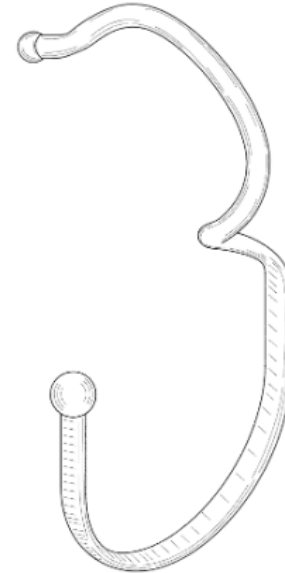
Jacki Easlick – Infringement



Jacki Easlick – Infringement



- ⦿ Differences between the designs include:
 - ⦿ “the contrasting corkscrew-like center” of the claimed design
 - ⦿ Shape of the bottom hook
 - ⦿ Shape of the finished ends



Jacki Easlick – Take Aways



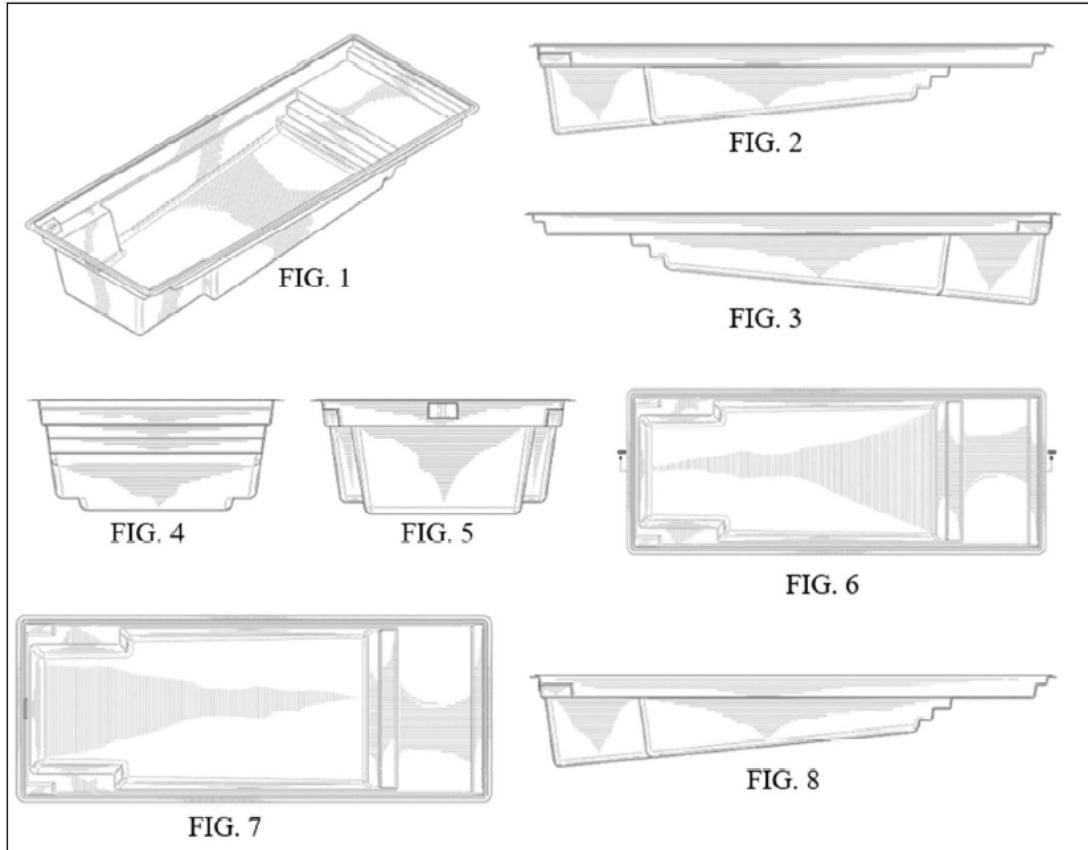
- Be proactive about defining the utilitarian elements of your design to avoid damaging constructions.
- Make sure that the patent drawings do not give an inaccurate visual impression of the design.
- Taking time to think of design-arounds and filing for design patents on these design-arounds pays off in the long run.

N. Star Tech. Int'l Ltd. v. Latham Pool Prods.

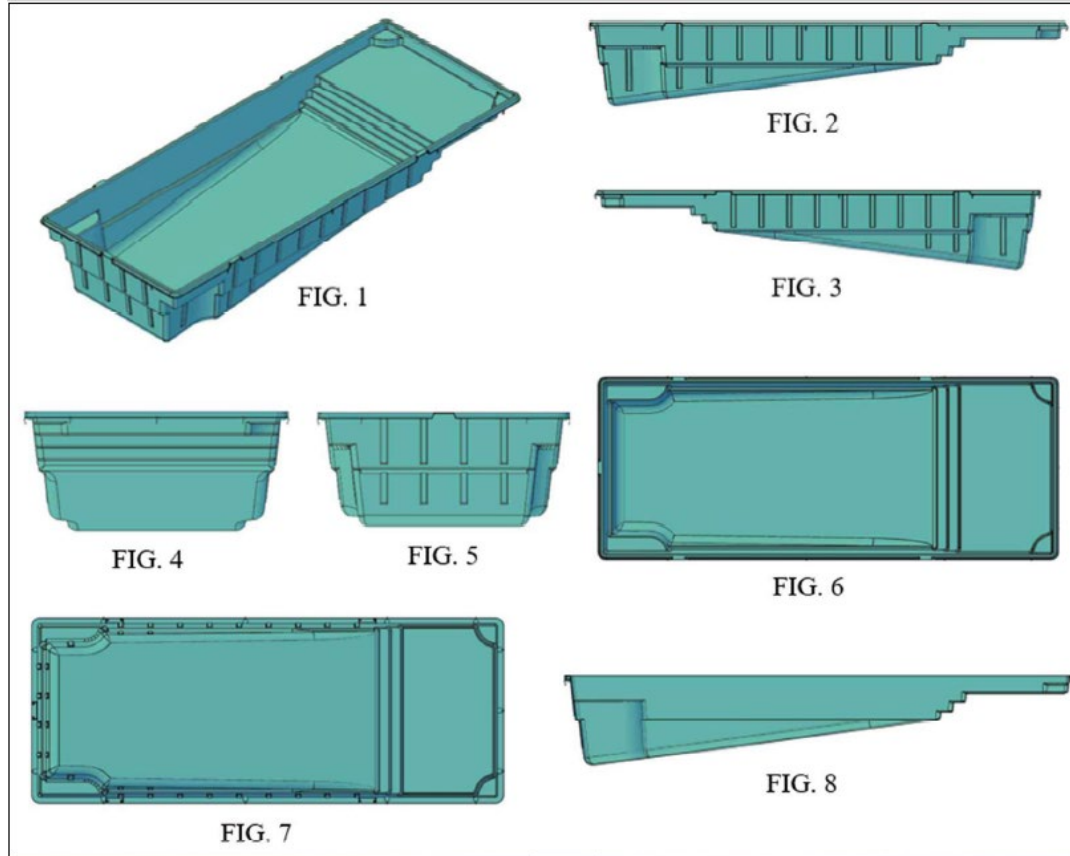


- ④ Eastern District of Tennessee, June 6, 2023
- ④ North Star Technology International Limited asserted U.S. design patent D791,966 against Latham Pool Products.
- ④ Latham Pool Products moved for summary judgment of noninfringement.

N. Star Tech. Int'l Ltd. v. Latham Pool Prods.



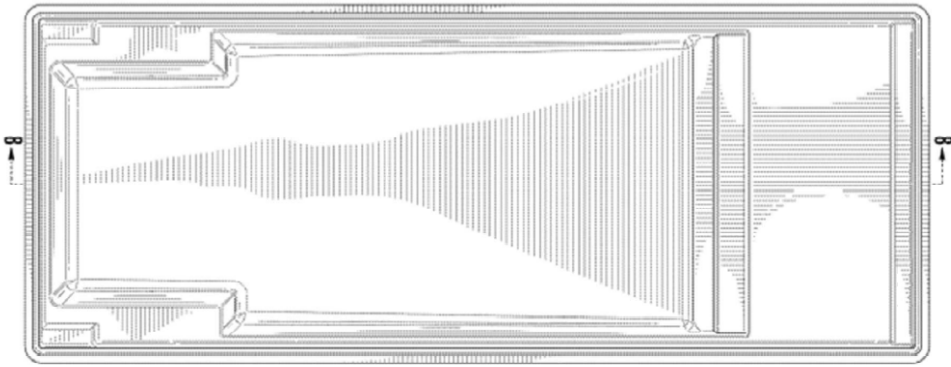
N. Star Tech. Int'l Ltd. v. Latham Pool Prods.



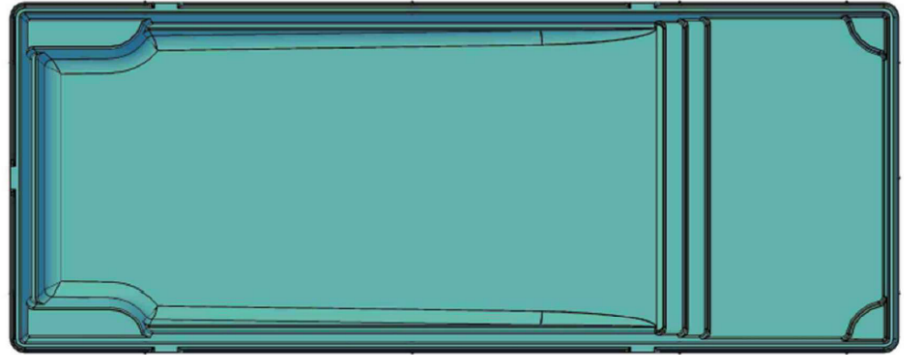
N. Star Tech. – Infringement



D'966 Patent [Doc. 11-1 at 8]

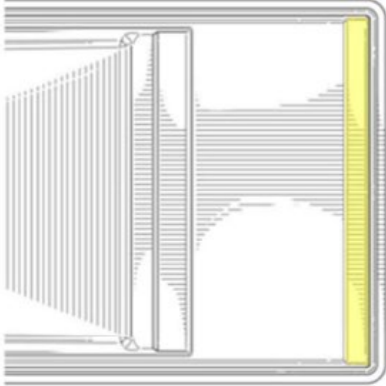

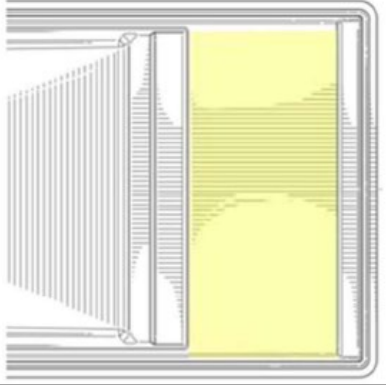
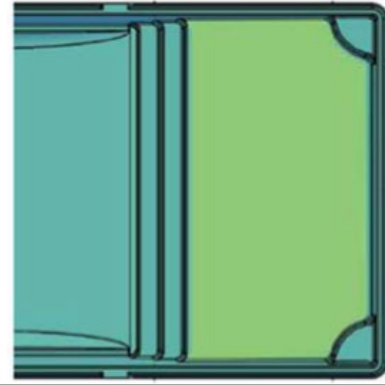


Corinthian 16 [Doc. 67-9 at 6]



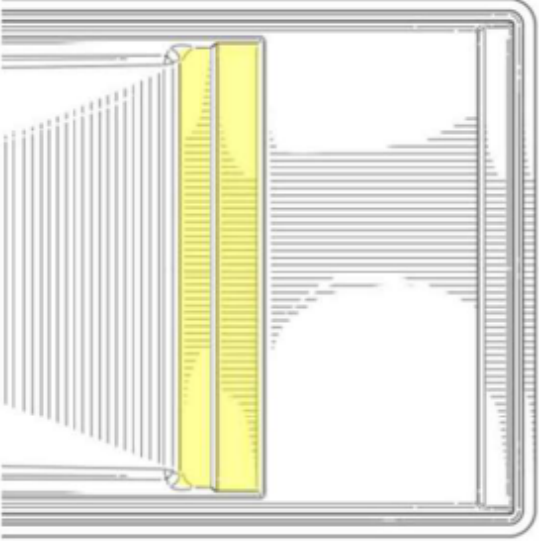
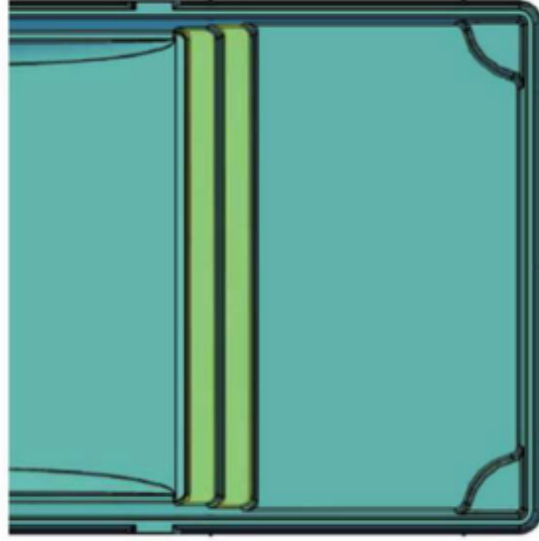
N. Star Tech. – Infringement



D'966 Patent	Corinthian 16 [Doc. 66 at 16]
 A technical cross-sectional drawing of a window blind. The left side shows the slat mechanism with multiple slats. The right side shows a vertical support structure. A yellow vertical bar is highlighted on the right edge of the support structure.	 A photograph of a window blind. The main body is teal. The right edge features a yellow vertical bar, matching the highlight in the patent diagram.
 A technical cross-sectional drawing of a window blind, similar to the top-left diagram. The right side of the support structure is highlighted in yellow, showing a curved shape.	 A photograph of a window blind, similar to the top-right diagram. The right side of the support structure is highlighted in green, showing a curved shape.

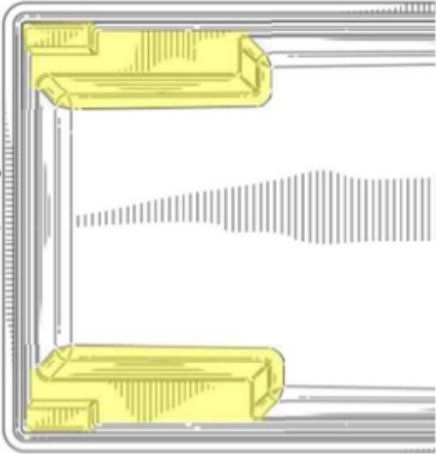
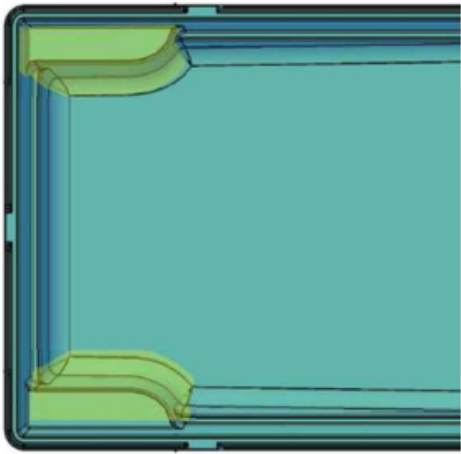
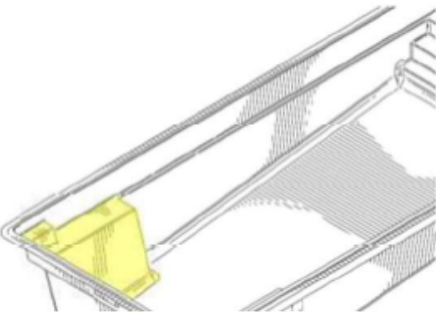
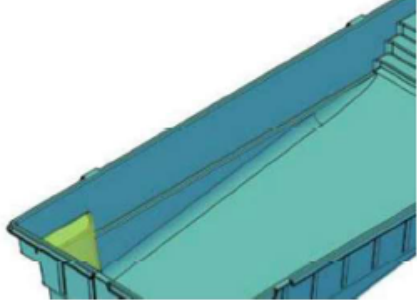
N. Star Tech. – Infringement



D'966 Patent	Corinthian 16 [Doc. 66 at 17]
 A technical diagram showing a cross-section of a window blind. A central vertical slat is highlighted in yellow. The slat is flanked by horizontal vanes that are shown in a perspective view, receding into the distance. The entire assembly is housed within a rectangular frame.	 A technical diagram showing a cross-section of a window blind. The central vertical slat is highlighted in green. The slat is flanked by horizontal vanes that are shown in a perspective view, receding into the distance. The entire assembly is housed within a rectangular frame.


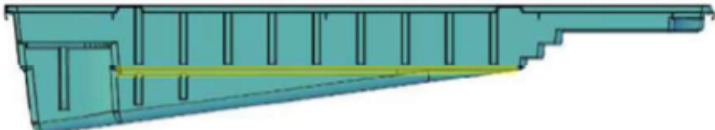
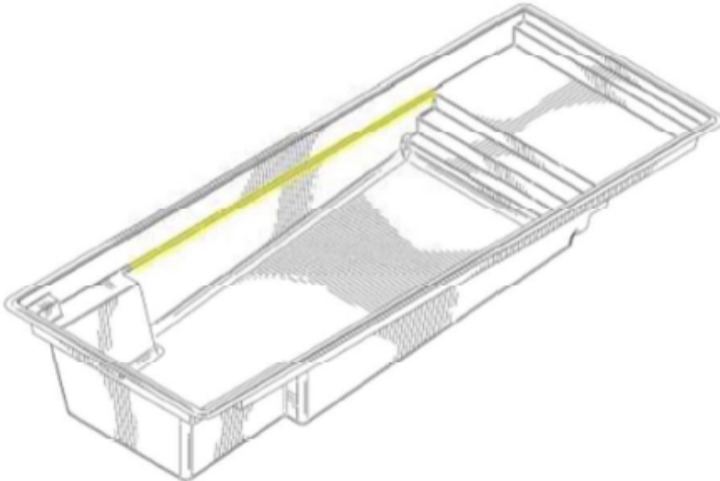
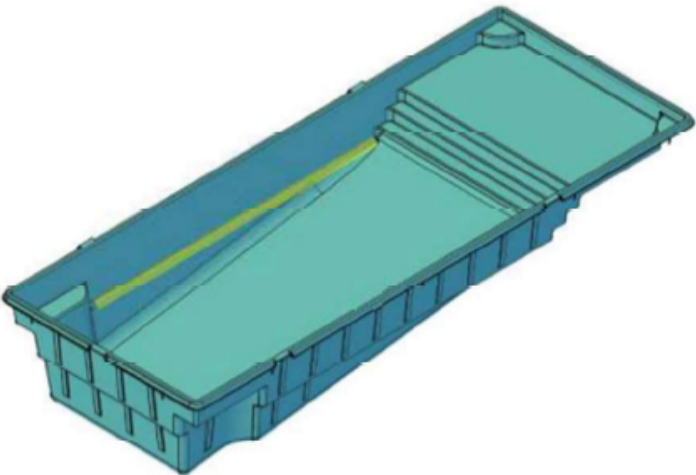
N. Star Tech. – Infringement



D'966 Patent	Corinthian 16 [Doc. 66 at 18-19]
 A technical drawing showing a top-down view of a rectangular frame with two yellow components attached to the top and bottom edges. The components have a complex, multi-faceted shape with a central protrusion and a recessed area. A series of vertical lines radiate from the center of the frame towards the components.	 A 3D perspective view of a rectangular frame with two light blue components attached to the top and bottom edges. The components have a curved, rounded shape with a central protrusion and a recessed area, matching the design of the yellow components in the patent drawing.
 A technical drawing showing a bottom-up view of the rectangular frame with the yellow components. The components are shown in a perspective view, highlighting their three-dimensional structure and how they fit into the frame.	 A 3D perspective view of the rectangular frame with the light blue components, showing the bottom-up view. The components are shown in a perspective view, highlighting their three-dimensional structure and how they fit into the frame.

N. Star Tech. – Infringement



D'966 Patent	Corinthian 16 [Doc. 66 at 20]
 A technical cross-section drawing of a rectangular tray. A yellow horizontal line highlights a specific structural feature on the top surface of the tray.	 A technical cross-section drawing of a rectangular tray, colored in teal. A yellow horizontal line highlights a structural feature on the top surface, which appears to be a variation of the feature shown in the D'966 Patent drawing.
 A 3D perspective drawing of the tray from the D'966 Patent, shown in a wireframe style. A yellow line highlights the same structural feature on the top surface.	 A 3D perspective drawing of the tray from Corinthian 16, colored in teal. A yellow line highlights the same structural feature on the top surface.

N. Star Tech. Int'l Ltd. v. Latham Pool Prods.



- ⦿ “As the drawings show, prominent ornamental elements of the two designs differ significantly, creating an overall ‘plainly dissimilar’ appearance.”
- ⦿ “No ‘ordinary observer’—a homeowner considering purchasing a swimming pool for their home—would mistake the angular D’966 Patent design with the curved Corinthian 16 design.”
- ⦿ Summary judgment granted to the defendant.

N. Star Tech. – Key Take Aways



- ④ Finding the right prior art can be the key to defending against a claim of infringement.
- ④ Being aware of competitor designs and including specific differences in your design can help defend against future claims of infringement.

Range of Motion Prods. v. The Armaid Co.






- ⦿ District of Maine, August 28, 2023
- ⦿ Range of Motion Products asserted U.S. design patent D802,155 against The Armaid Company.
- ⦿ Armaid moved for summary judgment of noninfringement.

Range of Motion Prods. v. The Armaid Co.



Body Massaging Apparatus

D'155 Patent <i>(The claimed design)</i>	Armaid2 <i>(The accused product)</i>	Armaid1 <i>(The prior art)</i>
		

Range of Motion – Functionality

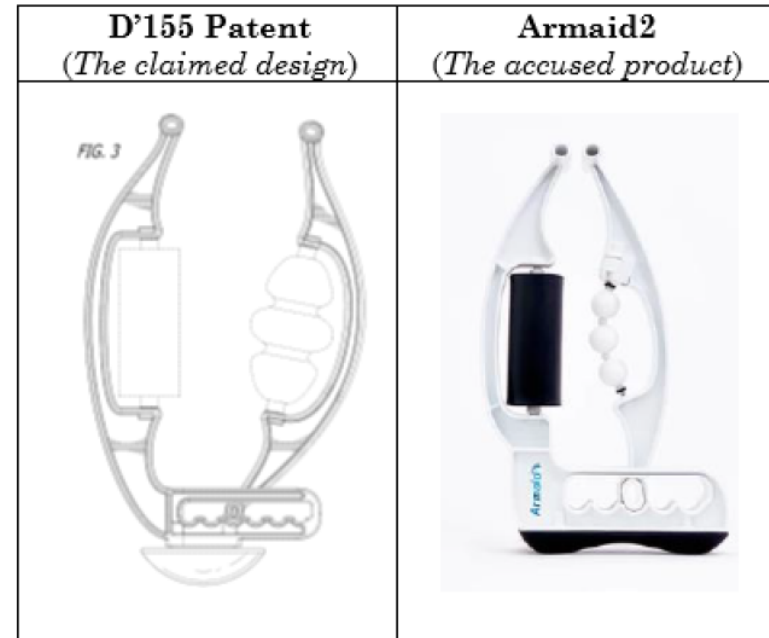


- ④ Many of the design features in the claimed design are driven by function:
- ④ The claimed features are described in a utility patent.
- ④ The inventor described the changes made from the prior art to the claimed design as being functional.
- ④ Marketing material touted the features of the claimed design as being functional.

Range of Motion – Infringement



- ⦿ “[T]he rub for ROM is that most of the Armaid2’s similarities to the D’155 patent are likenesses to the latter’s functional features.”
- ⦿ The designs are plainly dissimilar.



Range of Motion – Key Take Aways



- ④ Be aware of how the features of the claimed design are marketed and discussed.
- ④ Present alternative designs that can achieve the same function.

Questions?



BOOTH UDALL FULLER

INTELLECTUAL PROPERTY LAW