

UNITED STATES
PATENT AND TRADEMARK OFFICE



Upcoming Boardside Chats

Month	Topic
April 5, 2018	AIA Motion Practice
June 7, 2018	“Let It Go” Motions to Exclude and Motions to Strike in AIA Administrative Trials, Including Strategies for Handling Demonstrative Exhibits
Oct 4, 2018	Motions to Seal, Protective Orders, and Confidential Information in AIA Trials
Dec 6, 2018	Hearsay & Authentication
Feb 7, 2019	Supplemental Information vs Supplemental Evidence

INTRODUCTION TO DESIGN PATENTS

Jennifer Bisk, Romulo Delmendo, and Daniel Song

February 1, 2018

This presentation is for general information only and is not a complete statement of design patent law.

UNITED STATES
PATENT AND TRADEMARK OFFICE



35 U.S.C. §§ 171-173

35 U.S.C. 171 Patents for designs.

(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.

35 U.S.C. §§ 171-173

35 U.S.C. 172 Right of priority. - six months

35 U.S.C. 173 Term of design patent. - 15 years from the date of grant of applications filed on or after May 13, 2015 and 14 years from the date of grant for applications filed earlier

37 C.F.R. §§ 1.151-1.155

37 C.F.R. § 1.151 Rules applicable.

37 C.F.R. § 1.152 Design drawings.

37 C.F.R. § 1.153 Title, description and claim, oath or declaration.

37 C.F.R. § 1.151 Arrangement of application elements in a design application.

37 C.F.R. § 1.151 Expedited examination of design applications.

US D504,889 "Electronic Device"



US00D504889S

(12) **United States Design Patent** (10) Patent No.: **US D504,889 S**
Andre et al. (45) Date of Patent: **May 10, 2005**

(54) **ELECTRONIC DEVICE**
 (75) Inventors: **Bartley K. Andre**, Menlo Park, CA (US); **Daniel J. Coster**, San Francisco, CA (US); **Daniele De Iullis**, San Francisco, CA (US); **Richard P. Howarth**, San Francisco, CA (US); **Jonathan P. Iye**, San Francisco, CA (US); **Steve Jobs**, Palo Alto, CA (US); **Shin Nishibori**, San Francisco, CA (US); **Duncan Robert Kerr**, San Francisco, CA (US); **Matthew Denn Rohrbach**, San Francisco, CA (US); **Douglas B. Satzger**, Menlo Park, CA (US); **Calvin Q. Seid**, Palo Alto, CA (US); **Christopher J. Stringer**, Portola Valley, CA (US); **Eugene Anthony Whang**, San Francisco, CA (US); **Rico Zörkendörfer**, San Francisco, CA (US)

D396,452 S * 7/1998 Nautki D14/424
 D451,205 S * 12/2001 Ickel et al. D14/341
 D453,533 S * 2/2002 Chen D14/374
 D458,252 S * 6/2002 Palm et al. D14/343

OTHER PUBLICATIONS
 Andre et al., U.S. Appl. No. 29/180,558 entitled "Electronic Device", filed Mar. 17, 2004.
 "HP Compaq Tablet PC (t1100)", downloaded Aug. 27, 2004.
 "Tablet PC V1100", downloaded Aug. 27, 2004.
 "ViewPad 1000", downloaded Aug. 27, 2004.
 * cited by examiner

Primary Examiner—Freda S. Nunn
 (74) *Attorney, Agent, or Firm*—Beyer Weaver & Thomas, LLP

(73) Assignee: **Apple Computer, Inc.**, Cupertino, CA (US)

(***) Term: **14 Years**

(21) Appl. No.: **29/201,636**

(22) Filed: **Mar. 17, 2004**

(51) **LOC (7) CL** **14-02**

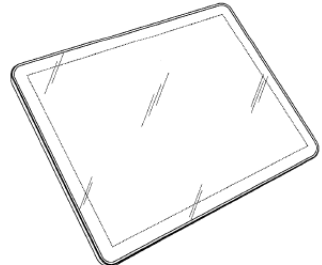
(52) **U.S. CL** **D14/341**

(58) **Field of Search** **D14/341-346, D14/374, 424; D19/26, 59, 60; 345/104, 156, 168, 173; 434/307 R, 308, 309, 317; 178/18.03, 349/12**

(56) **References Cited**

U.S. PATENT DOCUMENTS
 D345,346 S * 3/1994 Alfonso et al. D14/341

1 Claim, 4 Drawing Sheets



U.S. Patent May 10, 2005 Sheet 1 of 4 US D504,889 S

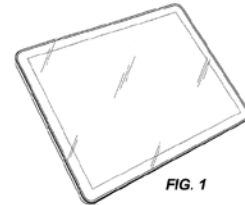


FIG. 1



FIG. 2

U.S. Patent May 10, 2005 Sheet 2 of 4 US D504,889 S

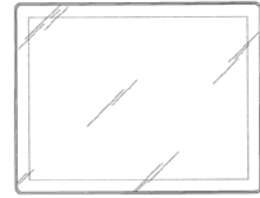


FIG. 3

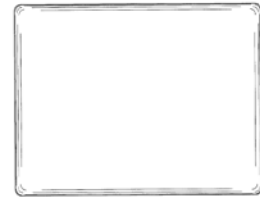


FIG. 4

Claim: We claim the ornamental design for an electronic device in accordance with the present design.

Written Description

35 U.S.C. § 112(a) In General. --The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

***In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013)**

“The test for sufficiency of the written description, ***which is the same for either a design or a utility patent***, has been expressed as ‘whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’”

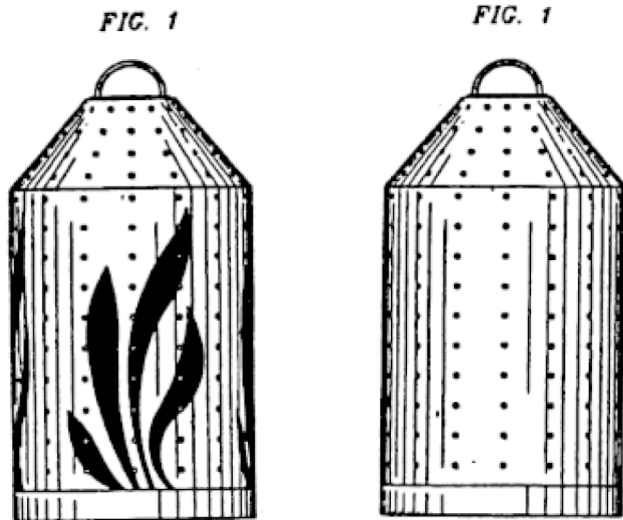
***Racing Strollers, Inc. v. TRI Indus., Inc.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989) (*en banc*)**

- Interlocutory appeal from a district court with the certified question:
 - Whether an application for a design patent filed as a division of an earlier filed application for a utility patent is entitled to the benefit of the earlier filing date of the utility application under 35 U.S.C. § 120 and 35 U.S.C. § 121?
- No categorical answer to this question because it is fact-based
- An ornamental design meets the requirements of Section 112 if the earlier application contains illustrations, whatever form they may take, that depict the ornamental design illustrated and formally claimed in the later application

In re Daniels, 144 F.3d 1452 (Fed. Cir. 1998)

Appeal to Federal Circuit from the Board's decision denying benefit of an earlier filing date.

Claimed Design:
a device for trapping leeches (a "leecher")



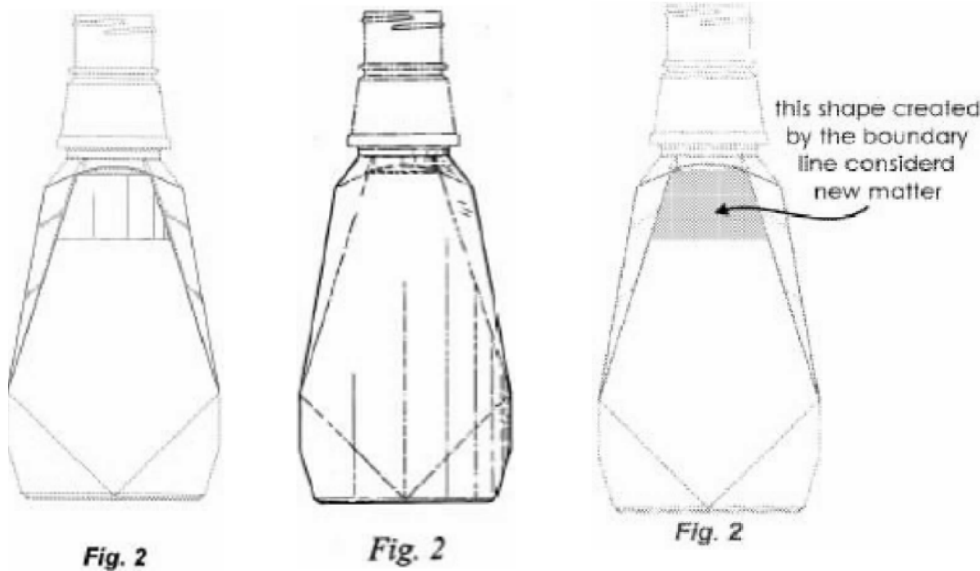
- Reverses Board decision
- “[I]t is apparent that the earlier application contains a description of what is claimed in the later application.”
- “The leaf design is a mere indicium that does not override the underlying design.”

***In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013)**

Appeal to Federal Circuit from the Board's decision denying benefit of an earlier filing date.

Claimed Design:

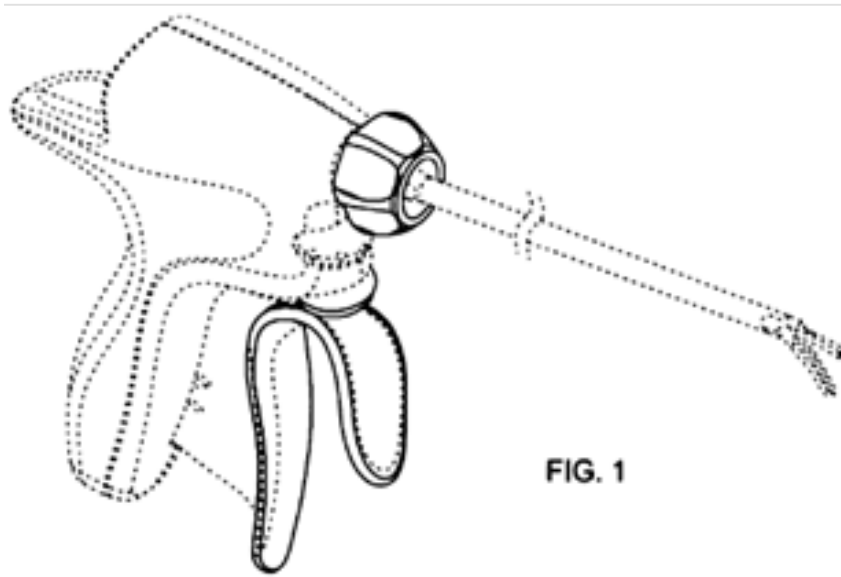
A bottle with boundaries as set forth below:



- Affirms Board decision
- Skilled artisan would not recognize that the trapezoidal top portion of the front panel might be claimed separately from the remainder of that area.

Ethicon Endo-Surgery, Inc., v. Covidien, Inc., 796 F.3d 1312 (Fed. Cir. 2015)

Design claim – ornamental design of an ultrasonic surgical device



- U-shaped trigger
- Rounded and fluted torque knob above and forward of the trigger
- Rounded activation button positioned directly above the trigger

***Ethicon Endo-Surgery, Inc., v. Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015)**

- District Court held that claim was invalid as being drawn to a design dictated by function
- If a particular design is essential to the use of an article (or “dictated by” the use), it cannot be the subject of a design patent
- Design patents that are primarily functional are invalid
- “Primarily functional” – “[t]he function of the article itself must not be confused with ‘functionality’ of the design of the article”
- Contrast *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996)—design patent to blade of a key was invalid as functional

***Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (2009)**

- Appeal from district court finding anticipation of lightweight clogs under 35 U.S.C. § 102
- Sole test for anticipation is the “Ordinary Observer Test”:
 - Two designs are substantially the same if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.
Gorham Company v. White, 81 US 511 (1871)
 - 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.
Richardson v. Stanley Works, 597 F.3d 1295 (Fed. Cir. 2010)

Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233 (2009)

- Exterior design has slight variations on the number and position of the circular holes on the top of the shoe. Not enough to preclude a finding of anticipation because “they do not change the overall visual impression of the shoe.”
- Insole design is “distinctly different” for the two designs. Challenged patent has a dimpling pattern that includes multiple short rows of dimples. The prior art design contains a long U-shaped dimpling pattern.

Figure 6 in the '789 Patent

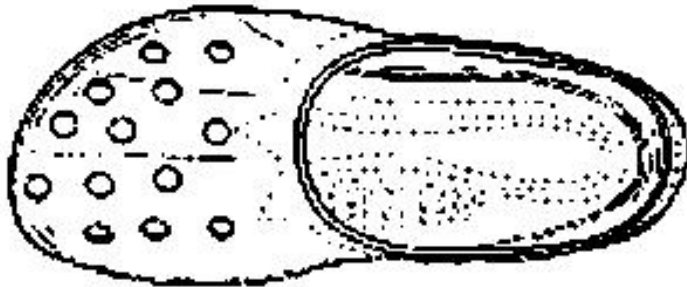


Figure 6 in the '263 Patent



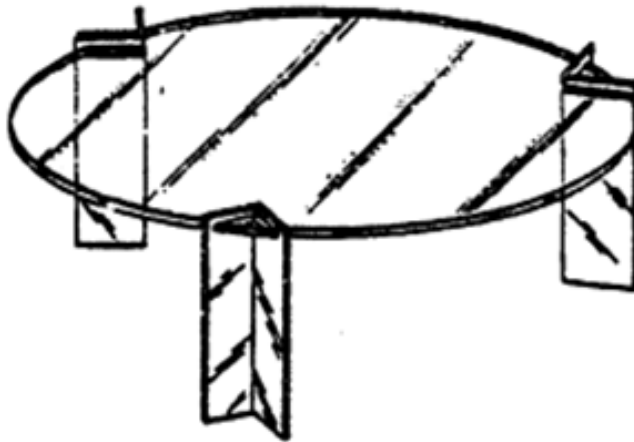
***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

Appeal to CCPA from the Board's decision affirming the Examiner's Rejection.

Claimed Design:

Low table (coffee table) of a contemporary styling as shown in

FIG. 1



- circular transparent top supported by means of slots cut into three V- or L-shaped legs
- legs are of reflective material (e.g., stainless steel)

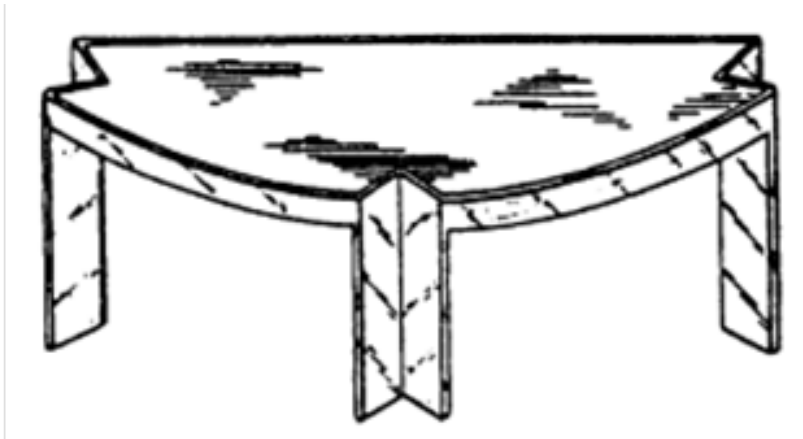
***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

Claim rejected as obvious over combination of 4 references:

- *Rosen* design patent for a desk (“basic reference”)
- *Klein* design patent for a display stand
- *Hysten* design patent for a table
- *Mudde* design patent for a table

***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

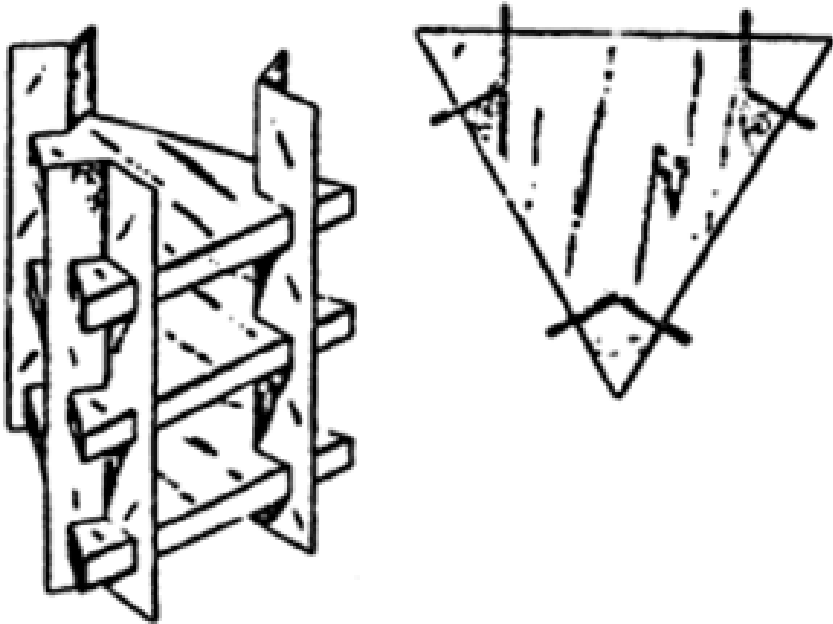
Rosen basic reference:



- Desk design showed semi-circular top supported by V-shaped legs

In re Rosen, 673 F.2d 388 (CCPA 1982)

Klein:



- *Klein* cited to show that in the furniture art, thin V-shaped leg members having a slot cut therein to receive a flat top were well-known

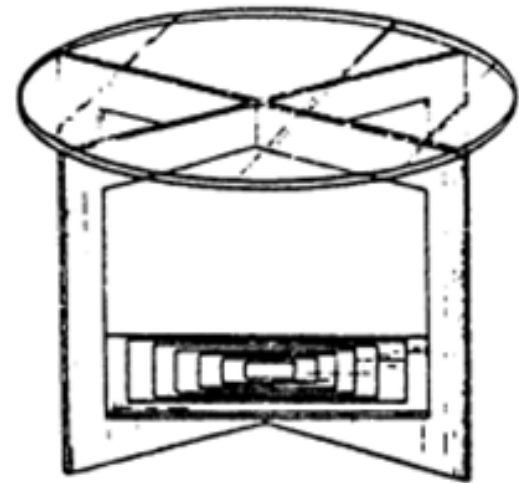
***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

Mudde & Hysten (cited to show circular glass table tops and/or round tables were well known; Mudde also cited to show three equally-spaced legs)

MUDDE



HYSTEN



***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

Examiner's Position (*id.* at 390):

- Obvious to “join the Rosen legs to the circular top of Hysten by use of a slot as taught by (Klein)”
- “little more than a regrouping of expedients already in use in the same class to which the *claimed article* pertains” (emphasis added)

Board's Decision (*id.*):

- “essential core of appellant's design” – a round glass top table with three V-shaped notched legs which receive and support the top
- “one of ordinary skill in the art would . . . readily observe that three equally spaced slotted V-shaped legs may be used to support a table top or shelf which is inserted in the slots of the legs”
- “To make such a shelf or top circular and of glass instead of opaque and triangular shaped would also appear to us to have been obvious to such a person armed with the disclosures of the applied prior art patents”

***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

Appellant's Position on Appeal to CCPA (*id.* at 390):

- No reference shows a product with the same overall appearance
- Primary reference is a desk design, not a table design
- PTO improperly combined various features from all the references in light of Appellant's disclosure, not because of suggestions in the prior art
- Board wrongly emphasized construction (means of support) rather than appearance or design

***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

CCPA – Reverses Board's Decision:

- Must consider the overall appearance as a whole of the design
- Ordinary designer standard rather than ordinary intelligent man standard (*id.* at 390)
- Designs of contemporary furniture other than coffee tables would reasonably fall within scope of the knowledge of designer of ordinary skill, such as the Rosen desk, Hysten table, and Mudde table having 3 equally spaced legs
- Only Klein's display stand design is questionable
- Obviousness rejection need not be based on single reference (*id.* at 390-91)
- Long-standing test for combining: Whether the references are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other (*In re Glavas*, 230 F.2d 447, 450 (CCPA 1956)) (*id.* at 391)

In re Rosen, 673 F.2d 388 (CCPA 1982)

CCPA (cont'd):

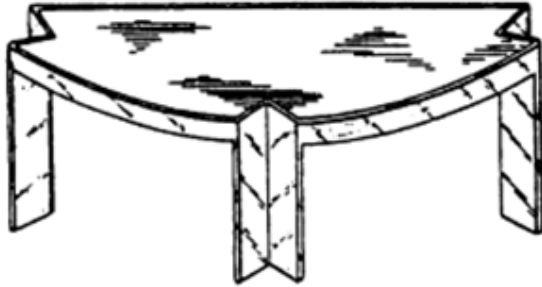
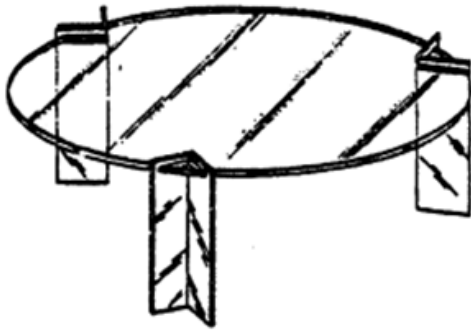


FIG. 1



- There must be a reference, a **something in existence**, the **design characteristics of which are basically the same as the claimed design** in order to support a holding of obviousness (*id.* at 391)
- if Rosen (top) modified only to extent it becomes a table, still would not have appellant's design (bottom) because table top would be notched and surrounded by a substantial apron integral with legs; thus, cannot stand alone as reference
- ordinary designer would find them significantly different in concept because Rosen does not give the same visual impression of lightness and suspension in space but rather concept of confinement of space, resulting in a different overall appearance and aesthetic appeal

***In re Rosen*, 673 F.2d 388 (CCPA 1982)**

CCPA (cont'd):

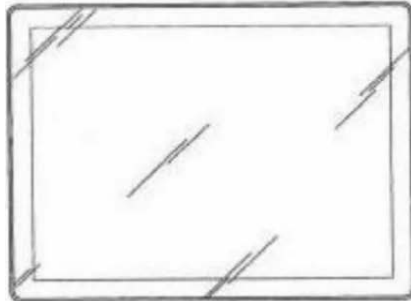
- Thus, no need to reach question whether modifications of *Rosen* desk would have been suggested
- Modifications of Rosen to achieve Appellant's design would destroy fundamental characteristics of Rosen design
- Board's reliance on construction appropriate for utility patent and ignores need for an **adequate starting point – a basic reference which embodies similar design concepts**

Apple, Inc. v. Samsung Electronics Co., Ltd., 678 F.3d 1314 (Fed. Cir. 2012)

Patent No. US D504,889 - "Electronic Device"

Appeal to CAFC from district court's denial of a preliminary injunction.

D504,889



1994 Fidler



***Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d
1314 (Fed. Cir. 2012)**

“We hold that the district court erred in finding that the Fidler tablet created the same visual impression as the D’889 patent. A side-by-side comparison of the two designs shows substantial differences in the overall visual appearance between the patented design and the Fidler reference.”

Id. at 1330-31.

***Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314 (Fed. Cir. 2012)**

- Fidler is not symmetrical: the bottom edge is wider than the others.
- Fidler frame surrounding the screen contrasts sharply with the screen.
- Fidler screen appears to sink into the frame, creating a “picture frame” effect and breaks the continuity between the frame and the screen.
- In D’889 design, transparent glass-like front surface covers essentially the entire front face without any breaks or interruptions.
- D’889 design creates the visual impression of an unbroken slab of glass extending from edge to edge on the front side of the tablet.
- Fidler contains no thin bezel surrounding the edge of the front side.
- In Fidler, one corner of the frame contains multiple perforations.
- Fidler sides are neither smooth nor symmetrical
- Fidler has two card-like projections extending out from its top edge and an indentation in one of its sides.
- Fidler’s back also conveys a different visual impression than D’889 design.

Id. at 1330-31.

***Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314 (Fed. Cir. 2012)**

Secondary reference TC1000



“[T]he teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one [design] would suggest the application of those features to the other.’ ” *In re Borden*, 90 F.3d at 1575, quoting *In re Glavas*, 43 CCPA 797, 230 F.2d 447, 450 (1956).
Id. at 1331.

Even if Fidler was a proper Rosen reference, TC1000 “could not bridge the gap between Fidler and the D’889 design.” *Id.*

***Apple, Inc. v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314 (Fed. Cir. 2012)**

The TC1000 is so different in visual appearance from the Fidler reference that it does not qualify as a comparison reference under that standard. *See In re Rosen*, 673 F.2d at 391 (rejecting the primary reference where “modifications of [it] necessary to achieve [the patented] design would destroy the fundamental characteristics” of that reference).

Id.

Differences in TC1000:

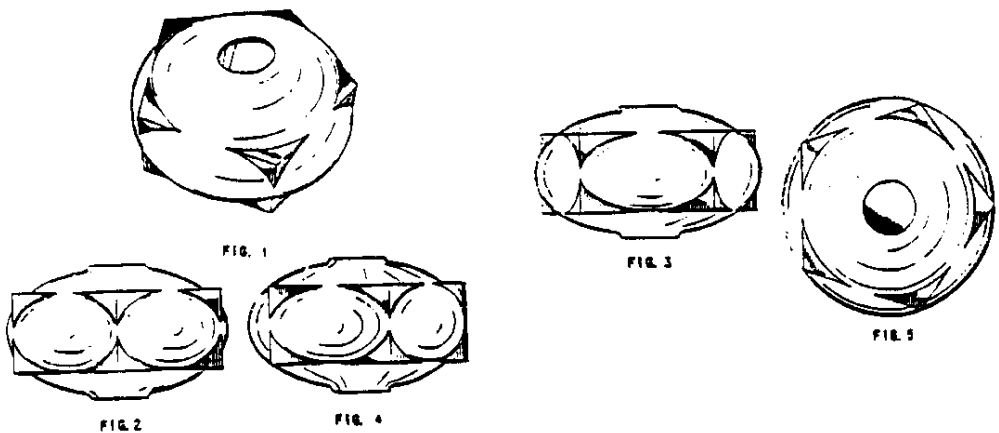
- TC1000 has a flat glass front but “the screen area is surrounded by a gray area that frames the screen.”
- “the perimeter of the TC1000 is encircled by a wide rounded-over metallic rim.”
- “the screen area contains indicator lights in several places, unlike the minimalist design claimed in the D’889 patent.”

Id. at 1331.

In re Harvey, 12 F.3d 1061 (Fed. Cir. 1993)

Appeal from the Board's affirmance of the Examiner's rejections.
Two ornamental vase designs.

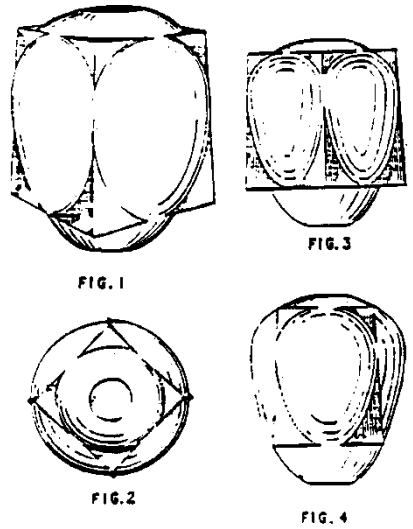
'904 Harvey Application



“intersection of an ‘oblate ellipsoid with a pentagonal cylinder’”

Id. at 1062.

'906 Harvey Application



“egg-shaped revolved hyperboloid with a truncated pyramid (also referred to as a square frustrum)”

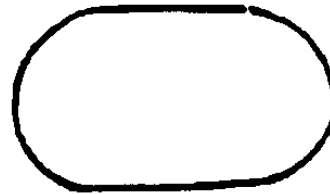
In re Harvey, 12 F.3d 1061 (Fed. Cir. 1993)

Board affirmed rejection based on Harvey Design as the basic reference, in combination with Carder designs.

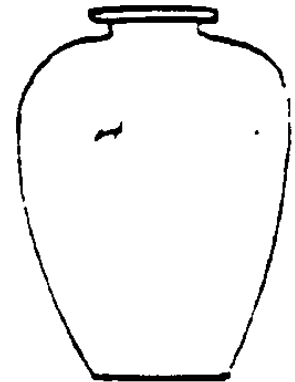
Prior Art Harvey Design



Carder 1982 Design (cross section)



Carder 2794 Design



***In re Harvey*, 12 F.3d 1061 (Fed. Cir. 1993)**

Board found Harvey is “an intersection of two solids,” that substitution of solids was “a routine matter,” and visual impact of the differences is “minimal.”

Id. at 1062-63.

The court stated:

“the Harvey prior art vase is not ‘basically the same’ as the claimed designs. Because major modifications would be required to make Harvey's prior art vase look like the claimed designs, it cannot qualify as a basic design.”

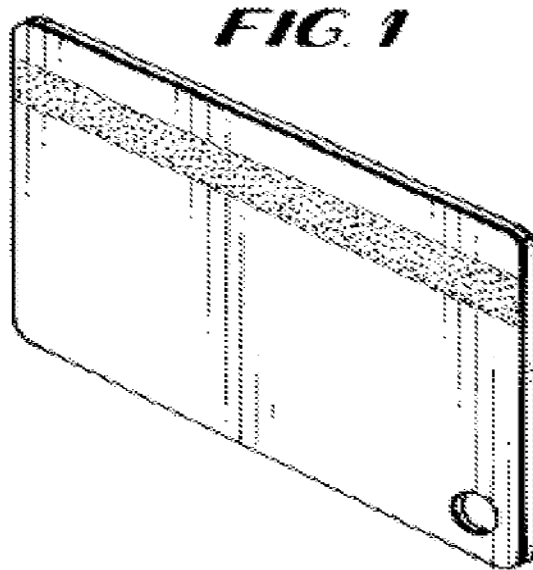
Id. at 1063.

“Like the examiner, the Board improperly mixed principles of obviousness for utility patents with those for ornamental design patents. . . . we hold that the Board erred in misapplying the obviousness standard because it admittedly relied upon the prior art Harvey vase as a ‘design concept’ rather than for its specific design characteristics.”

Id. at 1064 (internal citations omitted).

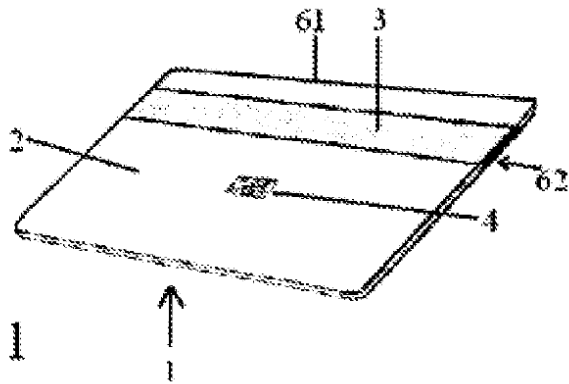
Vanguard Identification Sys. v. Kappos and Bank of America, Appeal 2009-002973 (BPAI 2009), aff'd R. 36 (Fed. Cir. 2011)

Inter partes reexamination of Patent No. US D467,247 S - "Data Card"

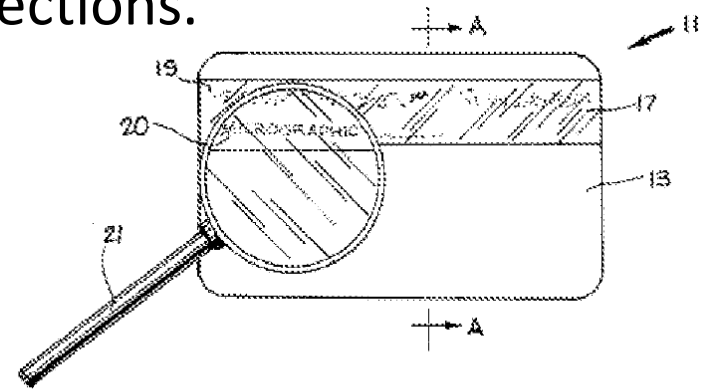


***Vanguard Identification Sys. v. Kappos and Bank of America*, Appeal 2009-002973 (BPAI 2009), aff'd R. 36 (Fed. Cir. 2011)**

Examiner adopted Requester's proposed rejections.



Keller in view of one of several other references



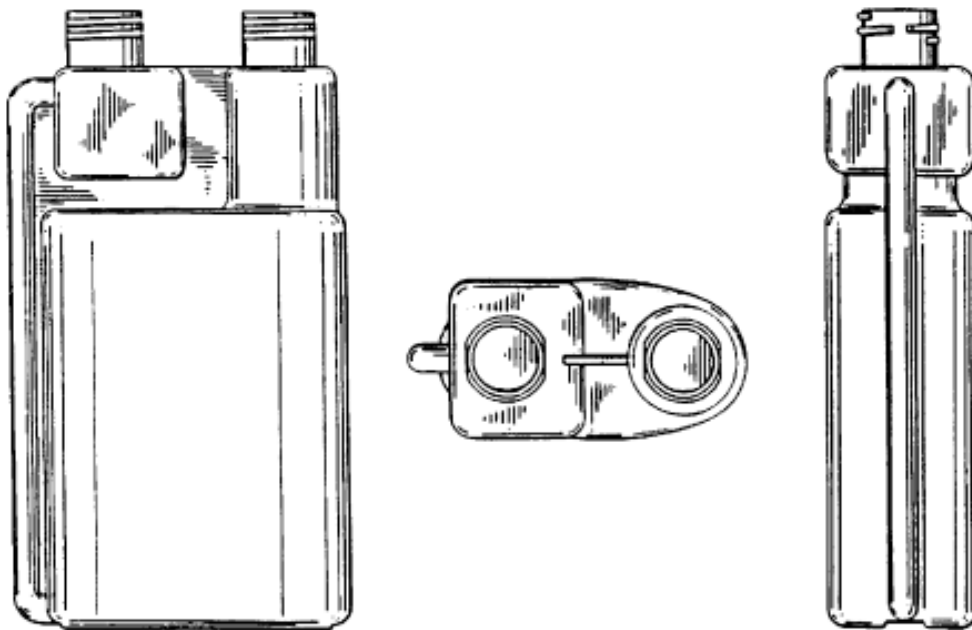
Drexler in view of one of two other references

Patent Owner appealed to the Board.
The Board reversed the Examiner's rejection.

***In re Borden*, 90 F.3d 1570 (Fed. Cir. 1996)**

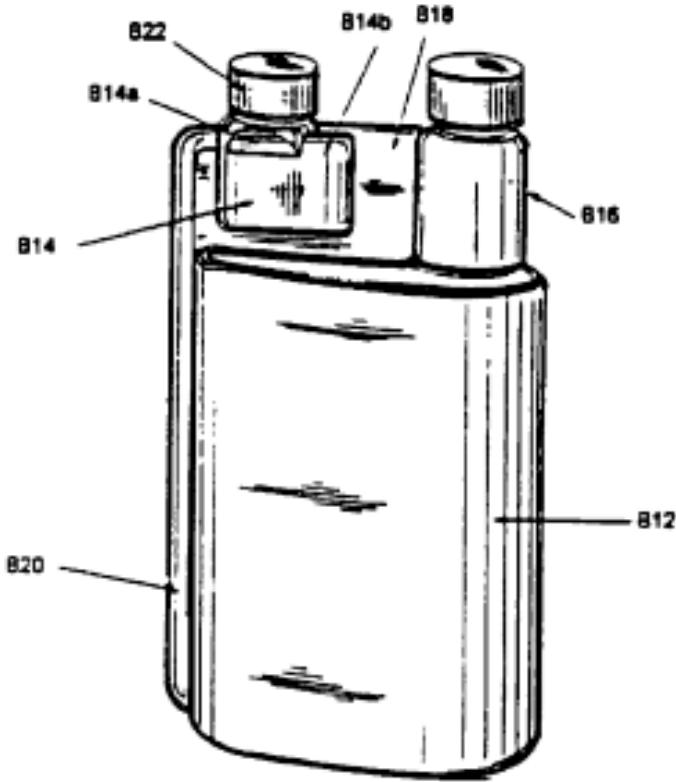
Appeal to the CAFC from the Board's decision affirming Examiner's obviousness rejection.

Application for a "Twin Neck Dispensing Container"



In re Borden, 90 F.3d 1570 (Fed. Cir. 1996)

Basic reference-Bettix



Bettix

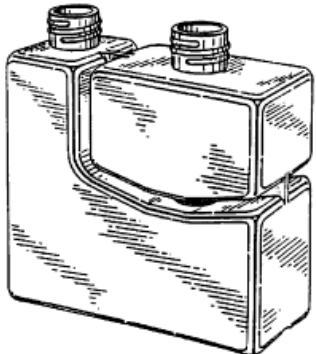
The differences between the Bettix container and the claimed design reside solely in the shape of the small chamber. First, the small chamber of the Bettix container flares outward near its top surface, whereas the small chamber of the claimed design has straight sides. Second, the small chamber of the Bettix container is rectangular and is narrower than the main chamber, while the small chamber in Borden's claimed design is cubical and is as wide as the main chamber at its widest point.

Id. at 1574.

In re Borden, 90 F.3d 1570 (Fed. Cir. 1996)



Freshn Ice Tea



Costa

Examiner found Freshn Ice Tea “has a cubical small chamber with straight sides, rather than the flared sides” of Bettix, and Costa has a small chamber that is “as wide as the main chamber at its widest point.”

Id. at 1574.

CAFC: “the secondary references would have suggested to a designer of ordinary skill in the art that the small chamber of the Bettix container could be modified by making its sides straight and making it as wide as the main chamber at its widest point.”

Id. at 1575.

***In re Borden*, 90 F.3d 1570 (Fed. Cir. 1996)**

The secondary references were thus properly found to be so closely related to the basic design reference “that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *In re Glavas*, 230 F.2d at 450, 109 USPQ at 52; *see In re Carter*, 673 F.2d 1378, 1380, 213 USPQ 625 (CCPA 1982) (secondary reference “so closely related that the adoption of features therein for modification of the [claimed] design would be readily suggested”).

Id.

Ex parte Hardy and R. Neal Post, Appeal No. 2005-1424 (BPAI 2005), aff'd R36 (Fed. Cir. 2006)

Appeal to the CAFC from the Board's decision affirming Examiner's obviousness rejection.

Application for a mesh storage basket.

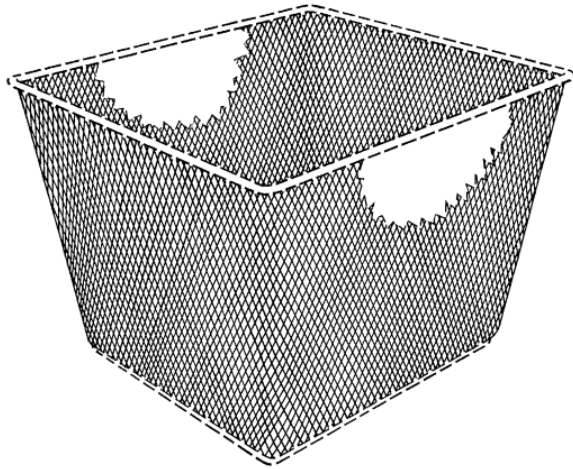


FIG.1

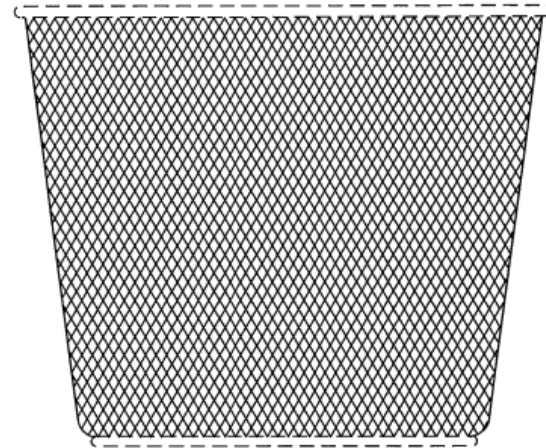


FIG.2

Ex parte Hardy and R. Neal Post, Appeal No. 2005-1424 (BPAI 2005), aff'd R36 (Fed. Cir. 2006)

Basic reference Hardy (US D419,302)

FIG. 1

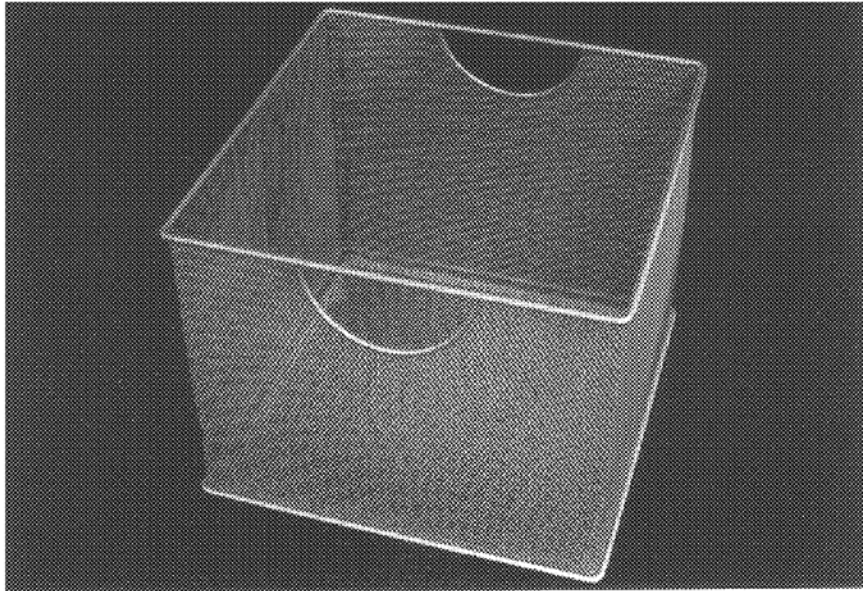
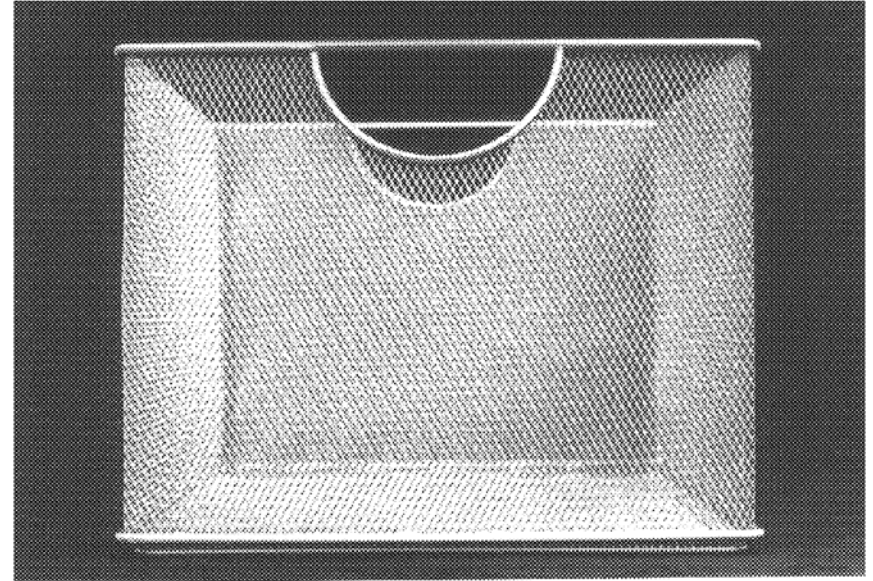
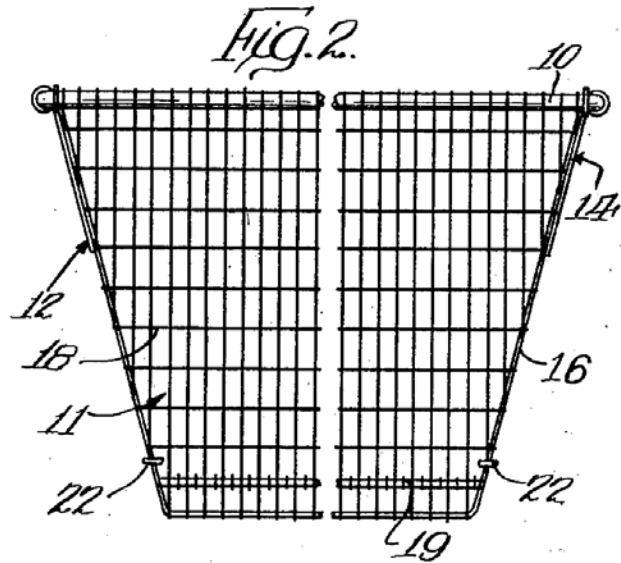


FIG. 2



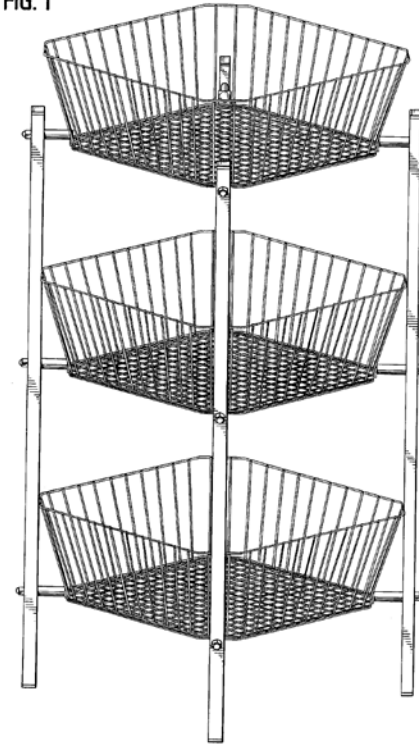
Ex parte Hardy and R. Neal Post, Appeal No. 2005-1424 (BPAI 2005), aff'd R36 (Fed. Cir. 2006)

Obvious in view of either:



Pope

FIG. 1



Glassenberg

Questions?

Thank You

