

Design Patents - USPTO

A design patent protects the way an article looks.

- USPTO defines “design” as ‘*visual ornamental characteristics embodied in, or applied to, an article of manufacture*’. A computer icon is an article of manufacture.
- The subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.

A design patent is NOT:

- a utility patent –no protection for functional features
- a copyright –little protection from derivative works
- a trademark–unavailable for short words & phrases

[Design Patent Application Guide - USPTO](#)



US Patentability Requirements

Article of Manufacture: a design must be embodied into, or applied to, a man-made tangible object.

Novel/Original: an average, or ordinary, observer sees a new design and not an already existing design.

Non-Obvious: At the time of the invention, would a designer of ordinary skill in the field of the invention consider combining the references to arrive at a single piece of art or modifying a single prior art reference.

To be a primary reference, the prior art reference must have basically the same design characteristics (i.e. create the same visual impression) as claimed design.

Ornamentality: a design cannot be dictated primarily by the function of the article.

Example: a key has been held primarily functional because purpose of key blade design was to match the key hole.



Differences from a Utility Patent in US

- Duration: 15 years from issued date
- No Maintenance Fees
- Filing to Issuance: 12-18 month average
- 6 month priority
- Cannot claim priority to a provisional application
- A design patent application can be filed claiming priority to a design or utility application
- No pre-grant publication
- Not included in PCT
- Can file through Hague System (similar to PCT system*)
- Can get a remedy of Total profits in alternative of reasonable royalties



Types of innovation suited for design patents

YES:

- Medical Devices
- Shape = value
- GUI/UX
- Furnishing & household goods
- Fashion & Jewelry
- Textiles
- Market ready products
 - Limited changes needed
 - Product ready for consumption

NO:

- Has functionality/utility
- Design not repeatable (e.g. method of creating design vs design itself)
- No aesthetic appeal



Components of the Application

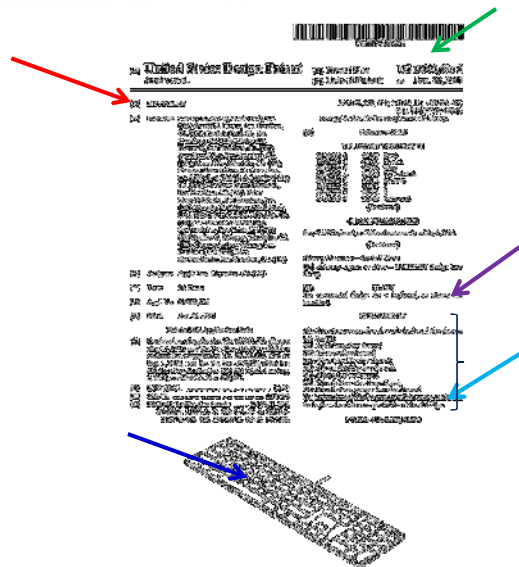
Title

Specification:

- Preamble stating name of application, title of design, brief description of intended use of design
- Brief description of drawings
- Disclaimer

Single Claim

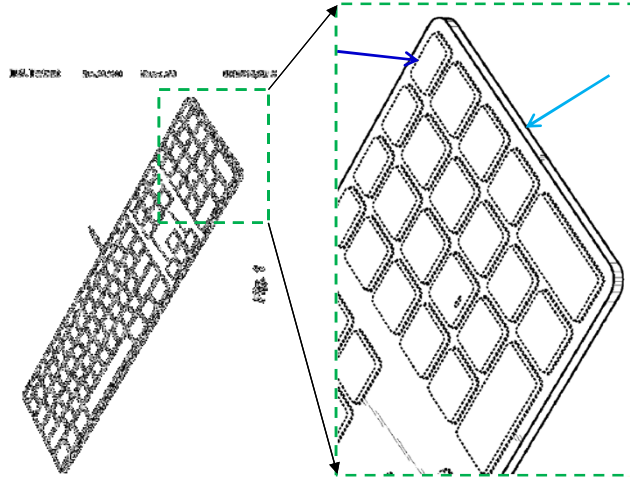
Drawings



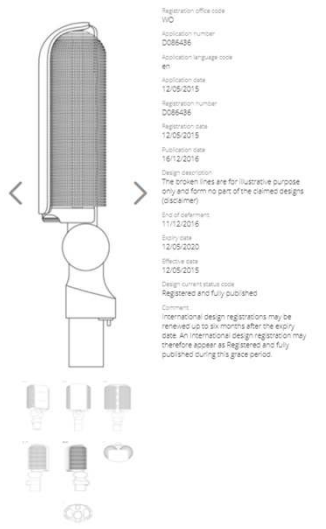
Application Requirements

Drawings

- Most important element – define the scope of the claim
- Need sufficient number of views to disclose the complete appearance of the design claimed
 - Typically: top, bottom, left-side, right-side, front, back, and perspective
- Only **solid lines** are considered part of the claimed design
- **Broken (phantom) lines** can be used to disclose or disclaim the environment related to the claimed design and to define the bounds of the claim



International (I)



<p>Registration office code: WIPO</p> <p>Application number: 0086436</p> <p>Application language code: en</p> <p>Application date: 12/05/2015</p> <p>Registration number: 0086436</p> <p>Registration date: 12/05/2015</p> <p>Publication date: 16/12/2016</p> <p>Design description: The broken lines are for illustrative purpose only and form no part of the claimed design (disclaimed)</p> <p>End of deferral: 11/12/2016</p> <p>Entry date: 12/05/2020</p> <p>Effective date: 12/05/2015</p> <p>Design status code: Registered and fully published</p> <p>Comments: International design registrations may be renewed up to six months after the expiry date. An international design registration may therefore expire as registered and fully published during this grace period.</p>	<p>Dates</p> <p>Application date: 12/05/2015</p> <p>Registration date: 12/05/2015</p> <p>Publication date: 16/12/2016</p> <p>Show more</p>
<p>Design office</p> <p>WIPO</p>	<p>Office of origin</p> <p>Registration office code: WIPO</p> <p>Last office data code: 24/09/2020</p> <p>Number of designs: 239962</p>
<p>Owner</p> <p>Applicant name: SAMSUNG ELECTRONICS CO., LTD.</p> <p>Applicant nationality code: KR</p> <p>Address: KR, 129 Samsung-ro, Yeongtong-gu, Suwon-si, Gyeonggi-do 448-742</p> <p>Country code: KR</p>	<p>Representative</p> <p>Applicant name: PARK, ByungSeok</p> <p>Address: KR</p> <p>Chop, Kim & Partners Intellectual Property, s.a. firm</p>

- Some differences from the US
 - Terminology
 - Duration
 - Translation
 - Maintenance fees
 - Multiple designs
 - Claim/written description
 - Publication **OR** Registration ± (substantive) Examination
 - Registered **OR** unregistered
 - Copyright/Designs overlap
- Hague System v. Paris Convention



International (II)



Design 201915127

Representations

Statement of newness and distinctiveness

Distinctiveness and newness reside in the central piercing nose, slight backward-facing leading cutting edges and horizontal wings marked A, B and C, respectively, in the drawings.

Summary

Product name	Targeted tillage system	Max registration period end	05 Sep 2029
Status	Certified	Currently registered until	05 Sep 2024
Priority date	5 Sep 2019	Certified	07 Feb 2020
Classification	15-03A (i)	Registered	22 Oct 2019
		Filed	05 Sep 2019

Ownership

Current owner: UNIVERSITY OF WESTERN AUSTRALIA

Designer: Andrew Guzzoni, Carlo Paresini, Michael Walsh



CERTIFICATE OF REGISTRATION DESIGN

Design number: 201915127

The Registrar of Designs has registered the design represented on this certificate and certifies that the following particulars have been entered in the Register of Designs:

Name and address of owner(s): UNIVERSITY OF WESTERN AUSTRALIA of 35 Stirling Highway M450 Office of Research Enterprise Crawley WA 6009 Australia

Product to which the design is registered: Targeted tillage system

Name of designer(s): Andrew Guzzoni, Carlo Paresini and Michael Walsh

Date of filing: 5 September 2019

Date of registration: 22 October 2019

Terms of initial registration: Five years commencing on 5 September 2019

Statement of newness and distinctiveness: Distinctiveness and newness reside in the central piercing nose, slight backward-facing leading cutting edges and horizontal wings marked A, B and C, respectively, in the drawings.

NOTE: This Design Registration cannot be enforced unless and until it has been examined by the Registrar of Designs and a Certificate of Examination has been issued. See sections 7(3)(i) and 7(3)(j) of the Designs Act 2005, set out on the reverse of this document.

Dated this 22nd day of October 2019
Registrar of Designs



CERTIFICATE OF EXAMINATION DESIGN

Design number: 201915127

Registrar of Designs certifies that examination has been completed for the registered Design No. 201915127.

Name and address of owner(s): UNIVERSITY OF WESTERN AUSTRALIA of 35 Stirling Highway M450 Office of Research Enterprise Crawley WA 6009 Australia

Product to which the design relates to: Targeted tillage system

Name of designer(s): Andrew Guzzoni, Carlo Paresini and Michael Walsh

Date of certification: 7 February 2020

Dated this 7th of February 2020
Registrar of Designs

[Industrial Designs - WIPO](#)

Combining IP – “Layer Up”

Strengthen portfolio by combining different types of IP

- Design and Utility Patents
- Design and Copyright
- Design and Trademark
- Combinations of all of these



Design Patents in Action

Stories from the trenches



Litigation of Design Patents

Proving infringement
“Ordinary Observer” test

Ford Auto Parts
[Case Example](#)
went to SCOTUS, denied last term

Jury Awards Apple \$539 Million in Samsung Patent Case



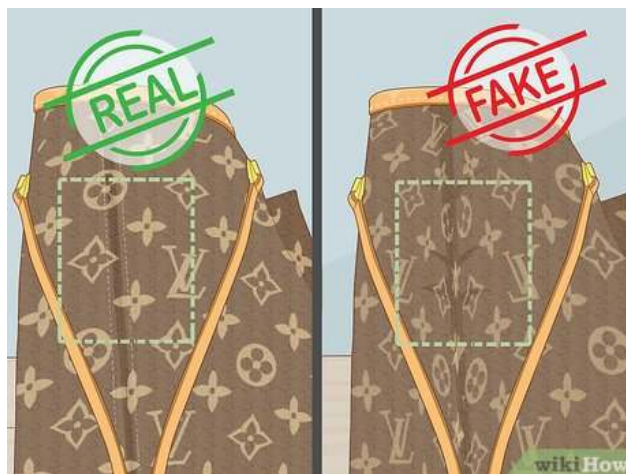
Samsung previously paid Apple \$399 million for smartphone patent infringement. A federal jury's verdict in California on Thursday would require an additional payment of nearly \$140 million. Jung Yeon-Je/Agence France-Presse — Getty Images

<https://www.nytimes.com/2018/05/24/business/apple-samsung-patent-trial.html>



Recent/potential legislation/laws impacting design patents

Case Law examples



Other AUTM Business

EDI Diversity Survey – Closes October 31st, 2020

Board of Director Election – Through October 15th, 2020



Panelists



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