

Destination IP Virtual Summit

Top Design Practice Tips for Utility-Minded Practitioners



Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

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Panel



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Lea E. Westman is a registered patent attorney at Schwegman Lundberg & Woessner. Her practice includes patent preparation and prosecution, freedom-to-operate analysis, and clearance opinions, primarily in materials science, chemical engineering, and biotechnology.



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Joseph Wang

Joseph J. Wang is a registered patent attorney and principal at Schwegman Lundberg & Woessner. He practices in a variety of technological disciplines, including software, Internet, digital media, and mechanical innovations, as well as industrial designs.



Design Patents

- A design patent protects the appearance of the tangible article.
- Design patents do not cover the article itself, mechanical structure, or any functions of the article.
- Design patent disclosures rely on detailed drawings to convey the appearance of the article, as opposed to a lengthy specification.
- U.S. design patents have stricter requirements than many foreign design registrations.



Design Practice Hazards Due to Utility Mindset

- Overly simplified drawings
- Overly diverse embodiments
- Insufficient views
- Insufficient written description
- Improper descriptive language





Overly Simplified Drawings





Overly Simplified Drawings

Why do so many practitioners go awry?

Utility claims are open-ended:

*An apparatus **comprising**: {stuff}.*

Design claims are not:

*The ornamental design for {an article},
as shown {and described}.*



Overly Simplified Drawings

A **simple** design is not necessarily **broad**.
A **complex** design is not necessarily **narrow**.

From *Egyptian Goddess* (CAFC 2008),
the **scope** of a design claim **depends**
on the **prior art**.

Less detail → different design
More detail → different design

Negative (empty) spaces are part of the design.

Overly Simplified Drawings

From *Egyptian Goddess* (CAFC 2008),
the **scope** of a design claim **depends**
on the **prior art**.



Applicant chooses where to place
bullseye, but prior art determines
number of rings.

Overly Simplified Drawings

Disclaiming or omitting details does not result in claiming a broader or underlying design “concept.”

According to the *Ordinary Observer Test*, a competitor can deviate from the claimed design by adding or removing sufficient details.

Overly Simplified Drawings

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“[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”

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Gorham Co. v. White, 81 U.S. 511, 528 (1871)

This is **not an element-by-element comparison**, like in utility practice.



Overly Diverse Embodiments



Overly Diverse Embodiments

Vulnerable to multi-way restriction

All restricted designs **must** be pursued in respective divisionals, or they will be dedicated to the public.

Cost concerns for client

Potential for the Applicant to “clutter up” their own art



Fig. 1



Fig. 1



Fig. 1

Overly Diverse Embodiments

According to the *Ordinary Observer Test*, designs are distinct if purchasers would not confuse them.

“[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”



Insufficient Views





Insufficient Views

“As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance ... that **nothing** regarding the design sought to be patented **is left to conjecture.**”

MPEP § 1503.02, citing 37 CFR 1.152

This means no mental visualizations or assumptions are permitted.



Insufficient Views

For 3D, minimum of 6 orthogonal views.

Recommend 4-8 additional
perspective views.

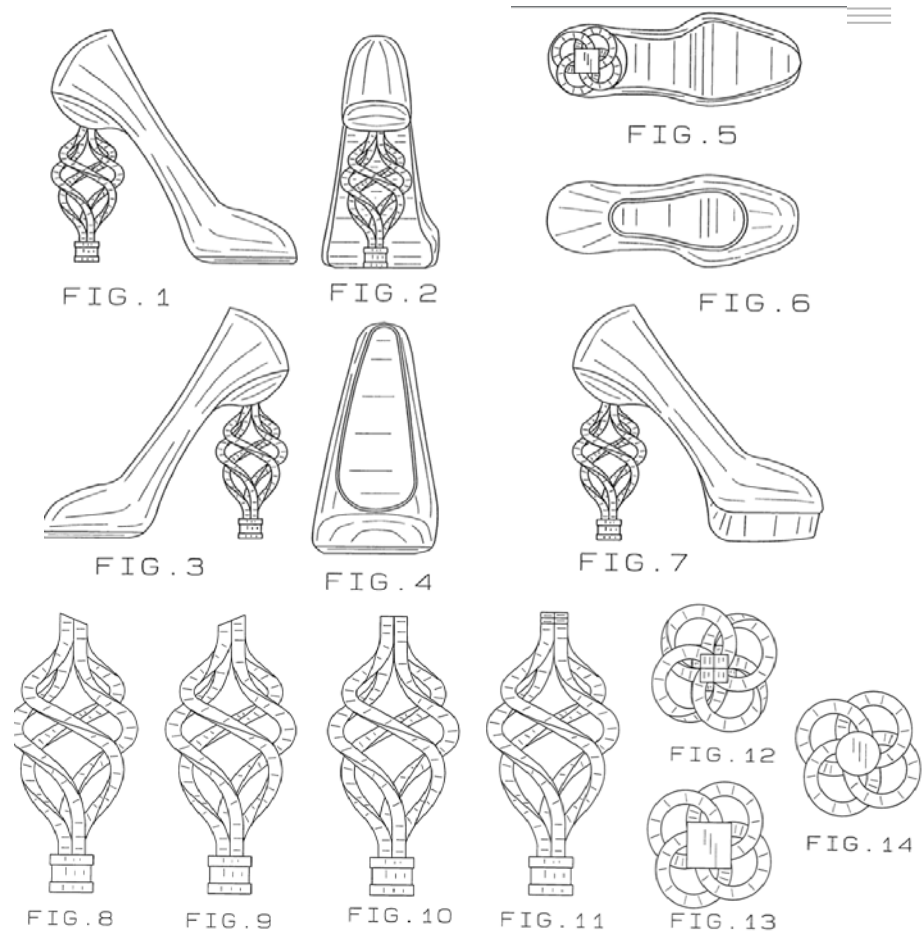
Each embodiment needs its own
complete set of 12-14 views.

For 2D, front view usually sufficient, but
consider enlarged views.

Remember to show the article!
No disembodied designs.

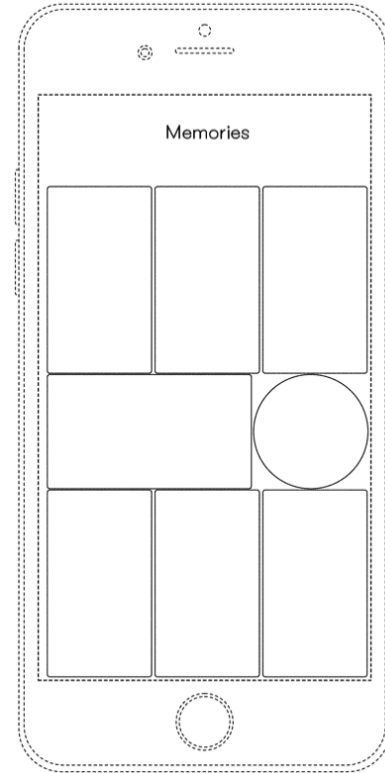
Insufficient Views

Example: Spiral Heeled Shoe
USD730634S1



Insufficient Views

Example: Display screen or
portion thereof having a
graphical user interface
USD831691S1





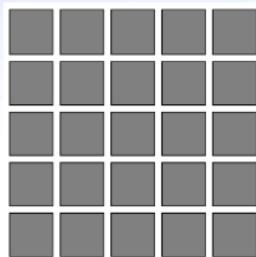
Insufficient Written Description



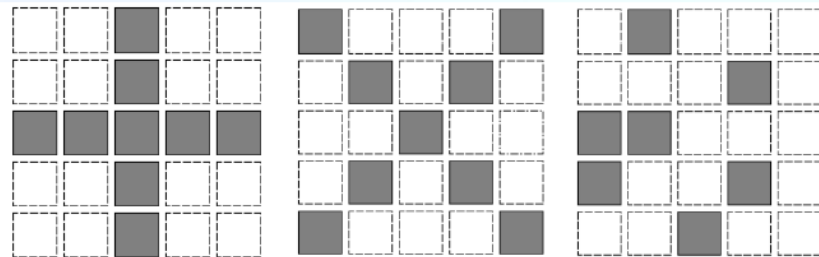


Designs in the New Digital Age

Disclosed but not described



Original Drawing



Amendments that are enabled in the original drawing but not described.





Insufficient Written Description

Appendices of unclaimed subject matter

Encouraged by some examiners and practitioners

For supporting downstream amendments

Arguably separate designs defined but unclaimed

Arguably published with granted design



Improper Descriptive Language





Improper Descriptive Language

Embodiments **not shown** in drawings
(unless reserving for amendment,
but might fail §112)

Disclaimer of solid-line portion
(unless reserving for amendment,
but might fail §112)

Function of article

Anything unrelated to ornamental design



Improper Descriptive Language

“Word pictures” as supplement or substitute for drawings

Attempts to encompass non-shown features into the claim

Language attempting to reserve potential amendments



Why Design Patents?



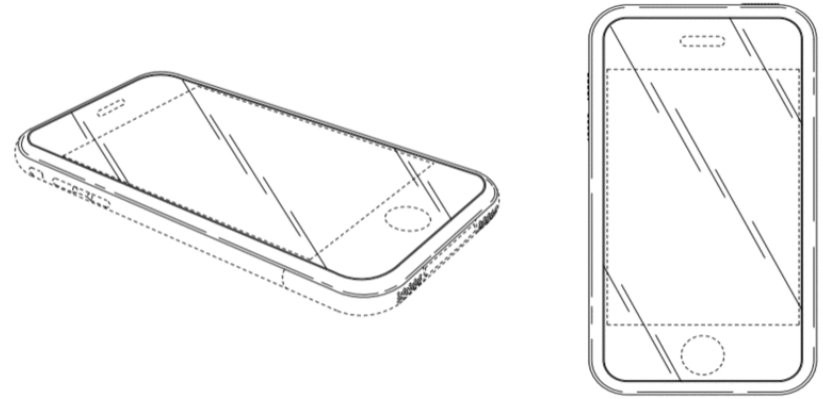


Why Design Patents?

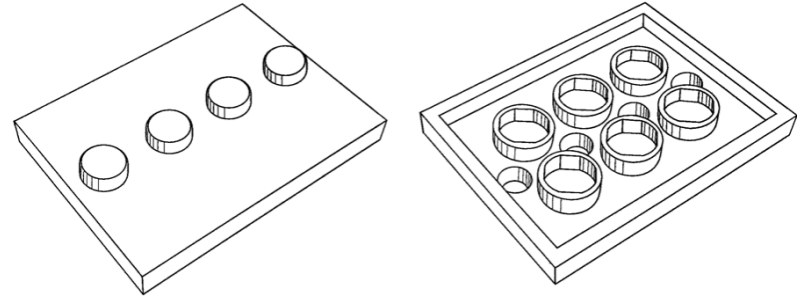
Can aesthetically cover a distinctive design.

Different tool in your IP toolbox, can complement utility patents, trademarks, and copyrights.

Recognizable Design Patents



“Electronic Device,” USD672769S1,
Apple Inc.



“Toy Construction Set Element,”
USD652087S1, Lego AS

Recognizable Design Patents



FIG. 1

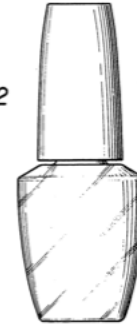


FIG. 3



FIG. 4

FIG. 2



“Bottle,” USD330859S,
O P I Products Inc



Thank you for your interest.

Questions?



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