Top Design Practice Tips for Utility-Minded Practitioners
Before We Get Started...

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Questions
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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
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 $\rightarrow$ different design
More detail $\rightarrow$ 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

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

“[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.”
Overly Simplified Drawings

“If, 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.”

*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
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.

Design Day 2013
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

“Bottle,” USD330859S, O P I Products Inc
Thank you for your interest.

Questions?
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