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100 YEARS

Is it Obvious? Let's Reconsider. Design Patent Obviousness vs. Utility Patents

PRYOR CASHMAN

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Nov. 1st 2023

6-7:30 PM

NYIPLA FASHION LAW COMMITTEE

ATTENDEES WILL EARN UP TO 1.0 CLE CREDIT

New York Intellectual Property Law Association
The Fashion Committee

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IS IT OBVIOUS? LET'S RECONSIDER DESIGN PATENT OBVIOUSNESS VS. UTILITY PATENTS

November 1, 2023

Jeffrey L. Snow

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Introduction to Design Patents

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Design Patent Protection in the United States

Design Patents

- Protect the ornamental appearance of an article
  - Cover non-functional features only, i.e., features not dictated by the use or purpose of the article
- Subject to the Patent Statute, Title 35 of the United States Code
- Design patents are one of several ways to protect designs
  - Trade dress
  - Copyrights

Design Patent Example

Tiffany Ring

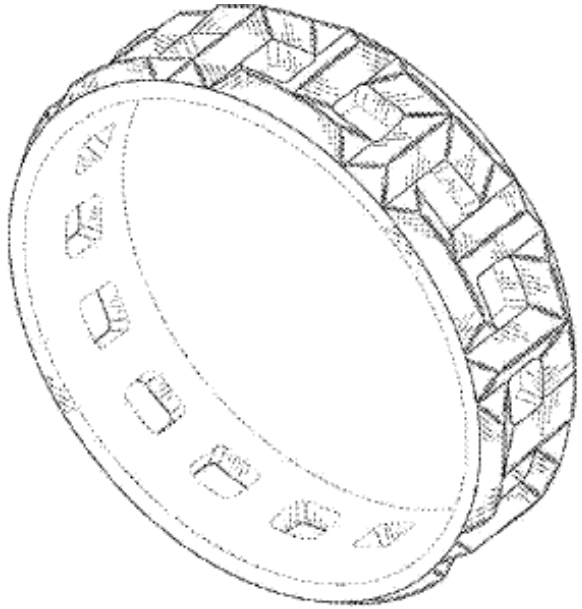
(12) **United States Design Patent**
Zuckerman et al.

(10) **Patent No.:** **US D906,154 S**
(45) **Date of Patent:** ** **Dec. 29, 2020**

(54) **JEWELRY SUCH AS A RING**

(71) Applicant: **Tiffany and Company**, New York, NY (US)

D719,468	S	* 12/2014	Barsic, Jr.	D10/32
D757,591	S	5/2016	Amfitheatrof et al.	
D757,592	S	5/2016	Martensson et al.	
D762,514	S	8/2016	Amfitheatrof et al.	
D778,199	S	2/2017	Amfitheatrof et al.	



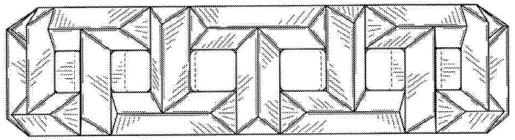


FIG. 2

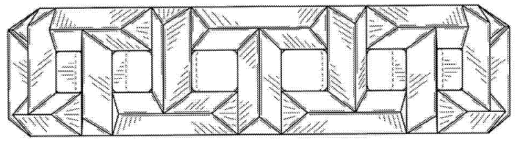


FIG. 3

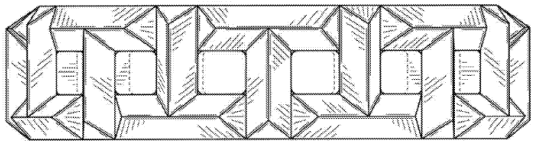


FIG. 4

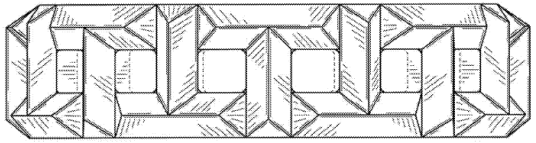


FIG. 5

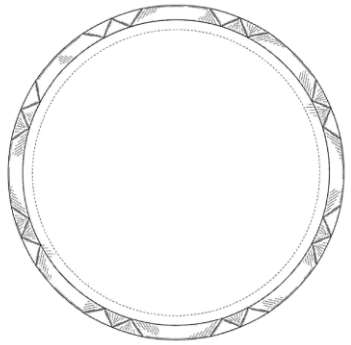


FIG. 6

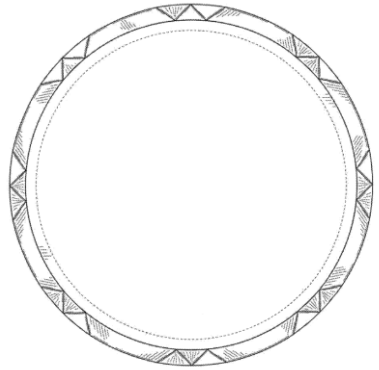


FIG. 7

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Design Patent Example

Balenciaga Shoe

(12) **United States Design Patent**
Gvasalia

(10) **Patent No.:** **US D889,083 S**
(45) **Date of Patent:** ** **Jul. 7, 2020**

(54) **SHOE**

(71) Applicant: **BALENCIAGA**, Paris (FR)

D452,772	S	*	1/2002	Jacobs	D2/925
D582,637	S	*	12/2008	Guers-Neyraud	D2/925
D689,269	S	*	9/2013	LaRusso	D2/939
84	S	*	8/2015	Guers-Nevraud	D2/971

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Design Patent Example

Loewe Handbag

(12) **United States Design Patent**
Marttila

(10) **Patent No.: US D855,315 S**
(45) **Date of Patent: ** Aug. 6, 2019**

(54) **HANDBAG**

(71) Applicant: **LOEWE SA**, Madrid (ES)

49 S * 8/2009 Handley D3/234

Examiner

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Design Patent Example

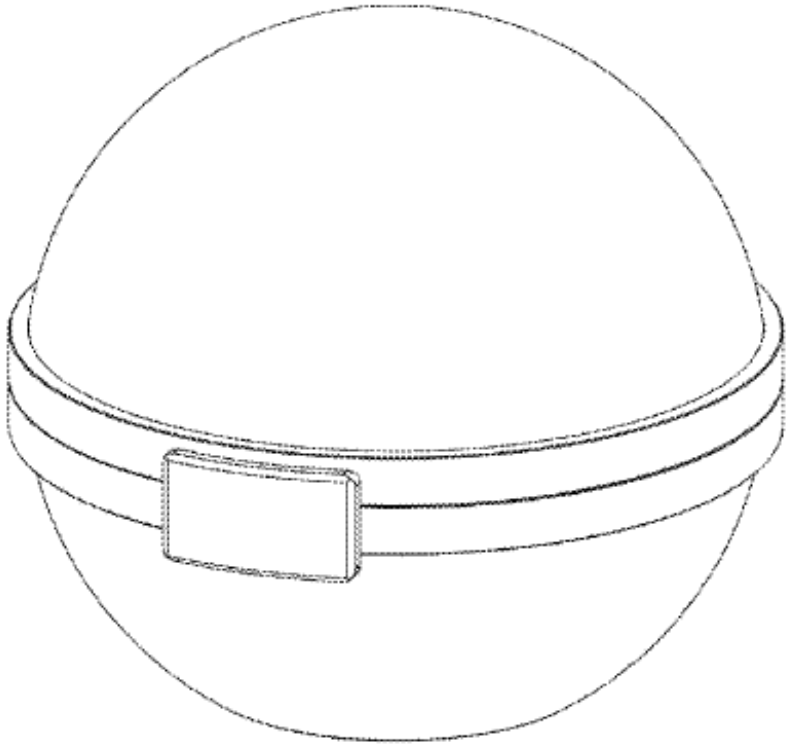
Ring Box

(12) **United States Design Patent**
Shifman

(10) **Patent No.: US D985,385 S**
(45) **Date of Patent: ** *May 9, 2023**

(54) **RING BOX**

D735,414	S	*	7/2015	Schlatter	D9/600
D861,476	S	*	10/2019	Rogers	D9/418



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Design Patent Example

Fabric Pattern

(12) **United States Design Patent**
Romero Femenia

(10) **Patent No.:** **US D472,391 S**
(45) **Date of Patent:** ** **Apr. 1, 2003**

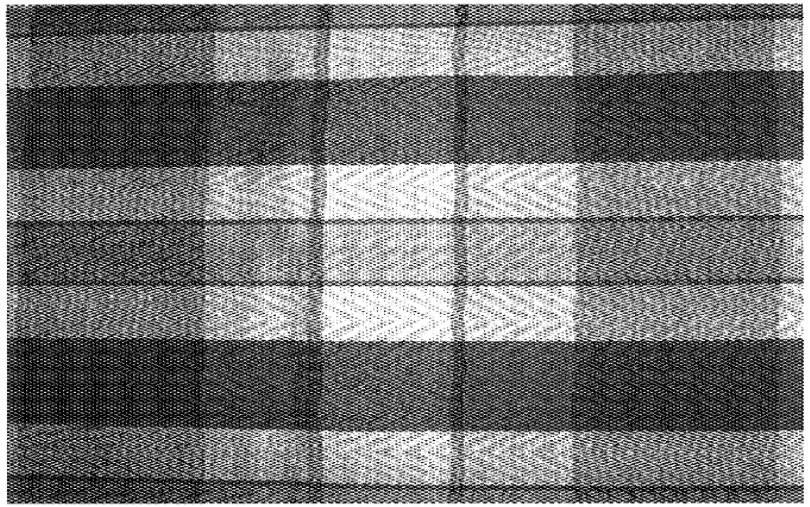
(54) **PLAID FABRIC DESIGN**

(75) Inventor: **Manuel Romero Femenia**, Paterna (ES)

(73) Assignee: **Manuel Romero, S.A.** (ES)

D128,213	S	*	7/1941	McLaughlin	D5/46
D128,405	S	*	7/1941	Salsky	D5/46
D130,796	S	*	12/1941	Fenner	D5/46
D229,987	S	*	1/1974	O'Brien	D5/46
D294,663	S	*	3/1988	Greene	D5/46
D361,670	S	*	8/1995	McMillan	D5/46

OTHER PUBLICATIONS



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Design Patent Example

Dior Sunglasses

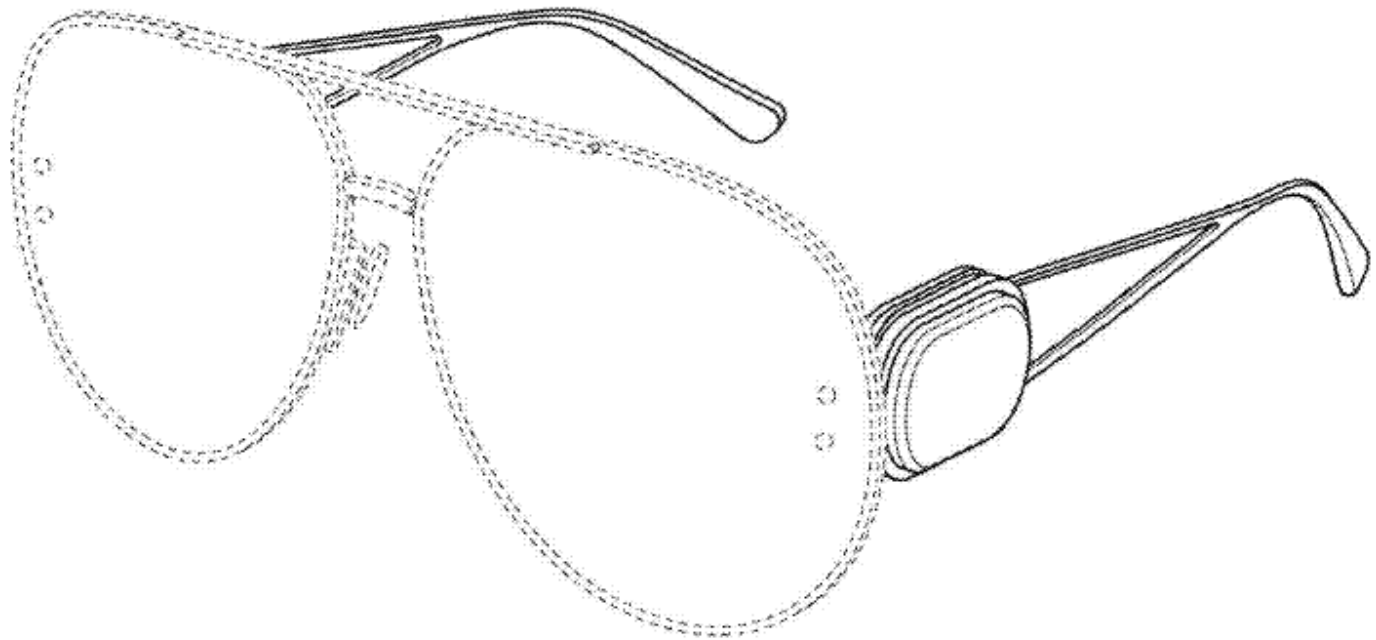
(12) **United States Design Patent**
Jamin

(10) **Patent No.:** **US D996,509 S**
(45) **Date of Patent:** ** **Aug. 22, 2023**

(54) **SUNGLASSES**

(71) Applicant: **CHRISTIAN DIOR COUTURE**, Paris (FR)

D636,811	S	*	4/2011	Gonzalez	D16/335
D852,264	S	*	6/2019	Jamin	D16/326
D921,099	S	*	6/2021	Jamin	D16/326
D921,746	S	*	6/2021	Jamin	D16/326



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Design Patent Example

Shoe Feature

(12) **United States Design Patent**
Bethke

(10) **Patent No.:** **US D847,484 S**
(45) **Date of Patent:** ** **May 7, 2019**

(54) **DECORATIVE FEATURES FOR A SHOE**

(71) Applicant: **Elan Polo, Inc.**, St. Louis, MO (US)

4,638,579	A	1/1987	Gamm
4,697,363	A	10/1987	Gamm
D296,610	S	7/1988	Brown et al.
D299,182	S	1/1989	Brown

Design Patents As Patents

Comparing Design and Utility Patents

- Same validity and litigation challenges as utility patents
- Examination in the USPTO under §§ 102, 103 and 112 (including post-grant proceedings)
- Same inventorship/assignment considerations
- Finite term: 15 years from issuance (compare to term for utility patents)
- Statutory period: 6 years (no laches)

Benefits of Treating Designs As Patents

- Scrutiny under the Patent Statute
  - Infringement, validity, and enforceability
  - Numerous defenses (including inequitable conduct)
  - *Markman* claim construction proceedings
- Federal court jurisdiction
  - Limited venue
- Strong remedies
  - Damages as reasonable royalty, lost profits, or infringer's total profits
  - Injunctive relief
  - Attorney's fees in exceptional cases

Design Patents As Patents

Drawbacks to Treating Designs As Patents

- Delay in issuance
- Comprehensive USPTO review and associated costs
- Defenses and other limiting rules
    - Limited term
    - Marking requirement

Comparison with Foreign Design Registration Schemes

Treatment of Designs in Foreign Jurisdictions

- Usually registrations (similar to trademarks), not patents
- Faster issuance
- Less scrutiny prior to issuance (but more scrutiny on enforcement)
- Often less receptive to broad coverage such as use of broken lines

UK & EU Design Protection

Two forms of design protection – registered & unregistered

Both are fundamentally the same & protect the look of a product

UK & EU Registered

- Both registered systems are near identical
- Protects the appearance of products including lines, contours, ornamentation, colours, shape, texture and materials
- For a design to be valid there are 3 essentially elements:
  - Novelty
  - Individual character
  - Appearance not be dictated by technical function
- Last for up to 25 years, renewable every 5 years

UK & EU Unregistered

- Arise automatically upon release to the public
- Protect novel features which determine the appearance of products
- UK UDR lasts for 10 years after first being put onto the market
- EU UDR lasts 3 years from the product first being put onto the market (also still covered in the UK following Brexit)
- A complex intertwining system
- Similarity based on overall impression
- Copying, conscious or unconscious

- The existence of unregistered design protection was very much driven by the fashion industry – in the UK as far back as 1787 design protection started, primarily for the designing & printing of linen, in 1839 extended to resemble protection available today in ornamentation, shape and configuration
- In the EU it was drive by the fashion houses, the short time frame of EU UDR reflects the short life of fashion lines & seasons

PRADA

CHANEL

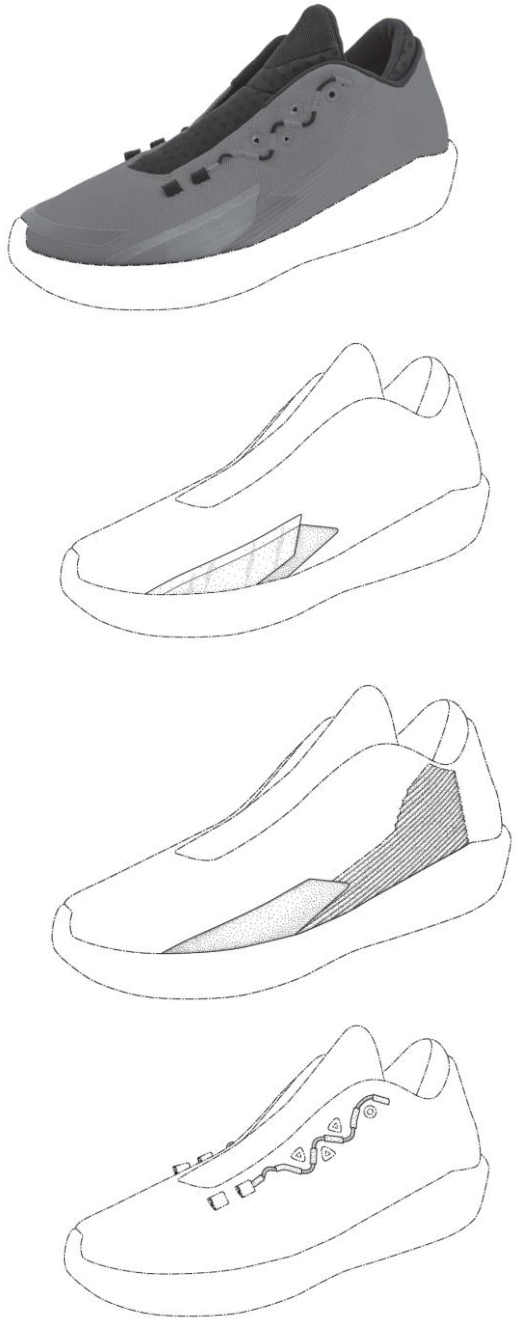
GIVENCHY

HERMÈS
PARIS

- Relatively easy & cheap to obtain in the UK & EU - is no detailed assessment of the validity tested when enforce
- What images are used to protect the design can be crucial to the scope of protection available

A representation from Magmatic Ltd's Trunki RCD

A Kiddee Case sold by PMS International



- Easy to allege infringement, but can be hard to enforce.
- Burden to prove existence
- Protection duration
- Uncertainty of scope and novelty, investigation into this can be complex

Historical Legal Considerations

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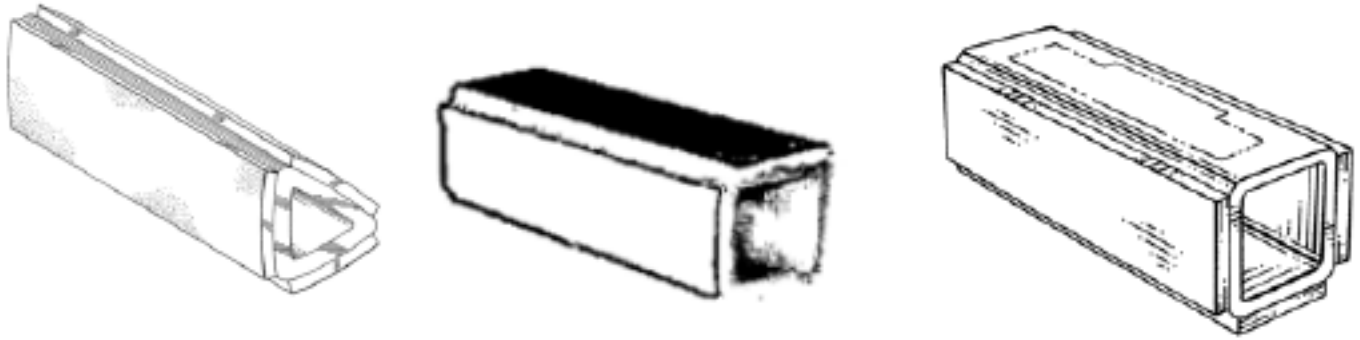
U.S. Design Patent Law

Egyptian Goddess v. Swisa (Fed. Cir. 2008) (en banc)

- The Federal Circuit addressed and *changed* the prevailing test for design patent *infringement*



- Prior test for design patent infringement had two prongs: (1) simple ordinary observer test and (2) point of novelty test

Egyptian Goddess v. Swisa (Fed. Cir. 2008) (en banc)

- Federal Circuit crafted a modified ordinary observer test as the sole test for design patent infringement
- Infringement is determined if the patented and accused designs appear substantially the same by applying the ordinary observer test through the eyes of an observer familiar with the prior art
- The accused infringer has the burden of production as to any comparison prior art

Invalidity As Anticipated Under 35 U.S.C. § 102

- From the perspective of an ordinary observer, the patented design, when considered as a whole, and the prior art design are substantially the same, i.e., identical in all material aspects
- Linked to the standard for determining design patent infringement

Invalidity As Obvious Under 35 U.S.C. § 103

- Current *Rosen-Durling* test has two parts:
- (1) find a single, primary reference ("something in existence") with design characteristics that are **basically the same** as the claimed design
- (2) apply secondary references to modify the primary reference that are "**so related** to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other"
- Obviousness test applied from the viewpoint of a designer of ordinary skill in the art ("ordinary designer") for combining references

KSR Int'l v. Teleflex (Supreme Court 2007)

- Section 103 provides that a patent is obvious if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains
- *KSR* abrogated the prior, rigid teaching-suggestion-method test in favor of a more flexible approach under which, in light of the evidence, a person having ordinary skill in the art would have found the claimed design obvious

En Banc Federal Circuit: LKQ Corp. v. GM Global Tech.

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Rehearing En Banc: LKQ Corp. v. GM Global Tech.

LKQ Corp. v. GM Global Tech.

- Appeal to the Federal Circuit from the Patent Trial and Appeal Board considering invalidity issues of anticipation and obvious in post-grant proceedings (i.e., IPR and PGR) of GM's issued design patents
- Design patents relate to a vehicle front fender and a vehicle front skid bar

Rehearing En Banc: LKQ Corp. v. GM Global Tech.

Issues Addressed by Initial Federal Circuit Panel

- Anticipation, including determining who is the ordinary observer
- Obviousness, including whether *KSR* implicitly overruled the *Rosen-Durling* test

Rehearing En Banc: LKQ Corp. v. GM Global Tech.

Questions for Briefing in *En Banc* Rehearing Order

- List of questions
- Two key questions:
- "If the court were to eliminate or modify the *Rosen-Durling* test, **what should the test be for evaluating design patent obviousness** challenges?"
- "[W]hat **differences, if any, between design patents and utility patents are relevant to the obviousness inquiry**, and what role should these differences play in the test for obviousness of design patents?"

Rehearing En Banc: LKQ Corp. v. GM Global Tech.

Benefits of Current *Rosen-Durling* Test

- Settled law—predictability based on past use of the test
- Flexibility ("basically the same", "so related")
- Recognizing differences between design patents and utility patents
- Because of the differences in the subject matter of and prior art for design patents, finding validity based on non-obviousness would be expected more often than for utility patents

Rehearing En Banc: LKQ Corp. v. GM Global Tech.

Criticisms of *Rosen-Durling* Test

- Rigid approach ("basically the same", "so related")
- Not stated with the flexibility of *KSR*
- U.S. design patents are patents
- Results in few obviousness determinations
- Overly strengthens design patents over utility patents

Rehearing En Banc: LKQ Corp. v. GM Global Tech.

Connections Between Design Patents and Utility Patents

- Should design patents and utility patents be treated the same for all purposes? Have the courts traditionally treated them the same?
- Should design patents be scrutinized more strictly because, in comparison with utility patents, they receive less examination review, are rarely rejected under prior art, and can have very broad scope?
- What would a modified test for obviousness for design patents in light of *KSR* actually be and how would it be applied?

Conclusions

Discussion

- Potential outcomes of Federal Circuit rehearing *en banc*
- Considerations for the fashion industry
    - Design patents may become easier to invalidate
    - Stricter scrutiny of U.S. design patents

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