UT LAW CLE THE UNIVERSITY OF TEXAS SCHOOL OF LAW

Presented:
9th Annual Advanced Patent Law Institute

January 23-24, 2014
United States Patent and Trademark Office, Alexandria, VA

The New Landscape for Design Patents

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The New Landscape for Design Patents

Design patents have been squarely in the spotlight since August 2012 when a California jury awarded Apple more than $1 billion dollars for patent infringement by Samsung, with reportedly more than $700M of that attributable to the infringement of three design patents. Since then, companies who were marginally obtaining design patents as part of their IP portfolio, or were not obtaining them at all, are now taking a closer look at these potential IP powerhouses.

In addition to the Apple/Samsung case, there have been several Federal Circuit cases that have redefined some of the basic principles of design patent law involving the issues of written description, obviousness, and functionality. New post grant proceedings at the United States Patent & Trademark Office are also helping to shape a new landscape for design patents.

The issue of written description in design patents is one that not many practitioners have spent much time pondering. Applicants typically file their design patent applications with line drawings depicting their design and, if during prosecution of that application or of a continuation of that application they elect to claim more or less of that design, they simply change a solid line to a broken line, or change a broken line to a solid line. At least that was the case until the Federal Circuit decision in *In re Owens*.

In 2006, Timothy S. Owens *et al*. filed United States Design Patent Application No. 29/253,172 (the '172 application), claiming priority to an application filed in 2004. The 2004 priority application became United States Design Patent No. D531,515, entitled "Bottle." Drawings from that patent are depicted below.

Fig. 1

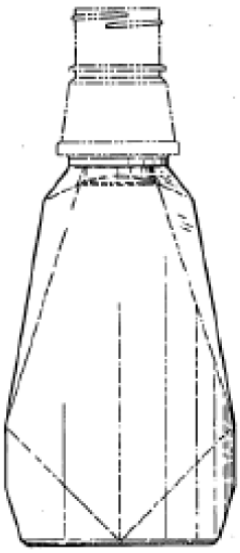

Fig. 2

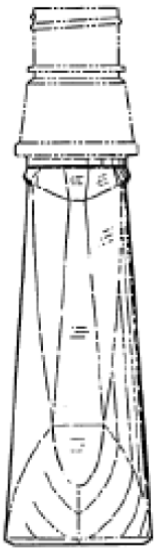

Fig. 3

Without priority to the 2004 application, the '172 application was unpatentable due to the sale of bottles embodying the claimed design after the 2004 application was filed. During prosecution of the '172 application, the examiner rejected the priority claim and the '172 application.

The '172 application claimed less than all of the design elements claimed in the 2004 application, including an "upper portion of the bottle's pentagonal center panel." A dot-dashed broken line was used to indicate an unclaimed boundary of the claimed design.

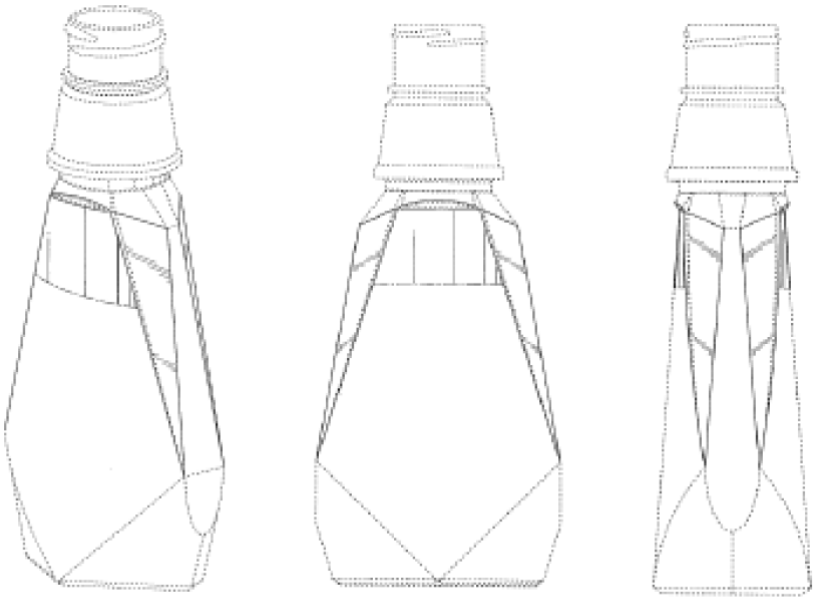

Fig. 1 Fig. 2 Fig. 3

According to the examiner, this newly added dot-dashed broken line invalidated the priority claim because the broken line "defin[ed] an entirely new 'trapezoidal'-shaped surface that was considered new matter" and lacked written description. Applicants appealed the rejection to the Board of Patent Appeals and Interferences, and upon the Board's affirmance in December 2011, they appealed to the Federal Circuit. In its March 26, 2013 opinion, the Federal Circuit affirmed the Board's decision.

The main purpose of the written description requirement is to ensure that those skilled in the art will recognize, based on the disclosure, that the inventor possessed the claimed subject matter as of its earliest filing date. In design patent applications, the written description requirement is primarily based on the drawings, rather than on any actual written description. Appellants argued that no new shape was claimed in the '172 application because the "new" broken line that formed one boundary of the trapezoidal shape was unclaimed, and therefore, did not add anything new to the disclosure. In addition, Appellants asserted that because the entire portion claimed in the '172 application was clearly visible in the 2004 application, skilled artisans would recognize that the inventor possessed the claimed subject matter now claimed, thus satisfying the written

Title search: The New Landscape for Design Patents

First appeared as part of the conference materials for the
9th Annual Advanced Patent Law Institute session
"The New Landscape for Design Patents"