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Design Patents: Another Way to Look at Software Protection

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Design Patents: Another Way to Look at Software Protection

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Since the introduction of the smartphone, the mobile application marketplace has been growing exponentially. In June of 2016, there were 2 million mobile applications available for download from the Apple App Store alone, with an average price of $1.00. As a result of this ever-expanding market, software developers have an increased need to protect their intellectual property, particularly their user-interface design. "User interface" refers to the means by which a user and a computer system interact. For example, Microsoft Windows is an operating system that popularized graphical user interfaces (GUIs), a widely used subset of user interfaces that rely on graphical icons and visual indicators. For many, GUIs provide a greater ease of use than other interface designs, such as text-based interfaces.

Yet as the urgency to protect their potentially lucrative IP increases, software developers now are facing additional hurdles in light of the 2014 decision by the United States Supreme Court in *Alice Corporation PTY. LTD. v. CLS Bank International*, which severely limited utility patent protection for software applications. The issue in the case was whether utility patent claims to a computer-implemented, electronic escrow service for facilitating financial transactions covered abstract ideas ineligible for patent protection under 35 U.S.C. Section 101. The Court held the patents invalid because the claims were drawn to an abstract idea, and implementing the method of those claims on a computer was not enough to transform that idea into patentable subject matter.

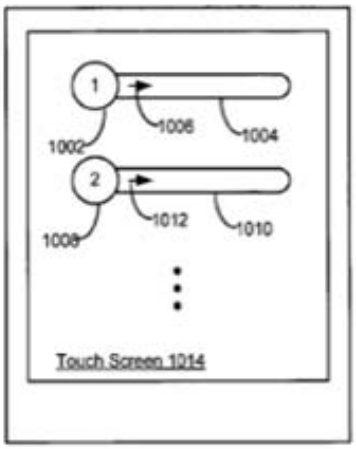
This article will review the history of the applicable case law regarding GUIs and IP protection and offer insights to developers and IP counsel alike on how to best preserve the value of their software-related intellectual property.

Utility Patents and Design Patents

GUI designs have been protectable in the U.S. since at least 1992 by design patents, the lesser-known sister of utility patents. Utility patents protect the way an article "works" and last 20 years from the filing date of a utility patent application. Design patents, on the other hand, protect the way an article "looks" and are valid 15 years from the issue date of a design patent. Both require that the "invention" being protected is novel and not obvious under 35 U.S.C. §102

and 103, respectively. Utility patents cannot protect inventions that are not useful, or which do not satisfy 35 U.S.C. §101. Design patents cannot protect designs that are not ornamental, that is, that are primarily functional.

The two types of intellectual property are not mutually exclusive, and it is common to obtain both utility and design protection for the same GUI "invention." An example is Apple's "slide to unlock" feature of its original iOS, which is protected by both U.S. Patent No. 7,657,849 and U.S. Patent No. D675,639.



Apple's US 7,657,849
Slide-to-Unlock
Utility Patent

Apple's US D675,639
Slide-to-Unlock
Design Patent

Design patents are governed by 35 U.S.C. §171, which provides that: [w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. According to *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980), 35 U.S.C. §171 refers not to the design *of* an article but to the design *for* an article, and is inclusive of ornamental designs of all kinds, including surface ornamentation as well as configuration of goods.

Title search: Design Patents: Another Way to Look at Software Protection

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