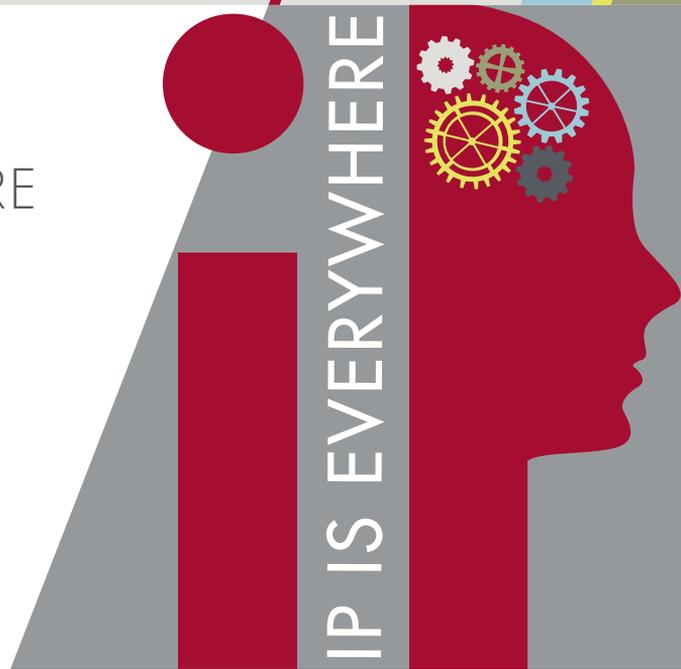


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United States

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Legal framework

The United States offers protection for designs in a formal application procedure resulting in a design patent. Design patents protect the non-functional ornamental features of articles of manufacture.

Title 35 of the US Code (35 USC) comprises the laws relating to patents, including design patents. The rules implementing these laws are found in Title 37 of the Code of Federal Regulations (37 CFR).

The permissible subject matter of design patents is defined in 35 USC §171, which states 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”.

Transnational design protection will be facilitated by the Patent Law Treaties Implementation Act 2012 implementing the Hague Agreement Concerning International Registration of Industrial Designs, to which the United States is a party. The act added Chapter 38, International Design Applications, to the patent law (found at 35 USC §381 to

§390). The act will not take effect until the treaty “enters into force with respect to the United States”, which will happen when the United States submits its instrument of ratification. This will occur only after the US Patent and Trademark Office (USPTO) has established the rules to be codified in the Code of Federal Regulations. Until the act is in force, foreign applicants must comply with the existing design patent law.

The US design patent system is a substantive examination system. It requires that certain substantive criteria be met before a design patent can be issued. This is in contrast to most other jurisdictions, which have limited or no examination before registration.

Other IP laws relating to copyright, trade dress and trademarks can be used to enhance design protection in some circumstances.

Unregistered designs

Unlike other jurisdictions, at present the United States does not protect unregistered designs through design patent law. However, unregistered designs are protected by other



State trademark law can protect unregistered designs where a design is used or sold not in interstate commerce, but only in commerce within a single state

rights, such as trade dress, copyright and unfair competition.

Where federal trade dress law is relied on, the design must:

- be used or sold in interstate commerce;
- be distinctive of the source of the goods (either inherently or by having obtained secondary meaning); and
- be non-functional.

State trademark law can protect unregistered designs where a design is used or sold not in interstate commerce, but only in commerce within a single state.

Copyright laws afford protection for unregistered designs as soon as the design is fixed in a tangible medium, provided that the design is an original work and not dictated by function. However, in order to sue on an unregistered copyright in federal court, the copyright must first be registered.

Registered designs

Statutory protection of designs requires a formal application procedure through the USPTO. The inventor of a design or its assignee can apply for a design patent.

As presented above, 35 USC §171(a) states that any new, original and ornamental design for an article of manufacture may be patented, subject to the “requirements of this title”. These requirements are the same as those that apply to utility patents.

The application must be submitted with a specification that meets the content requirements of 35 USC §112; otherwise, a filing date will not be granted. This requires suitable drawings, a specification “that

contain[s] a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same”. A single claim must also be included in the specification.

The claimed design must be original (eg, not merely a simulation of well-known or naturally occurring things or people) and not dictated solely by function. In addition, the design must not have been disclosed before to the public (with certain one-year exceptions for disclosures by the inventors) as required by 35 USC §102. The design must further not be obvious to one having ordinary skill in the art as specified by 35 USC §103.

Only if the application and the design claimed meet these formal and substantive requirements of Title 35 will a design patent be granted.

The term of a design patent is 14 years from the date of grant as codified in 35 USC §173. This term will change to 15 years from the date of grant when the Hague Implementation Act comes into force.

The total official fee for filing a design patent application is \$760. There is an additional design application size fee of \$400 for every 50 pages over 100 pages, which is rarely incurred. If the application is granted and passed to issuance, a design issue fee of \$560 becomes due.

The government fees are reduced to 50% if the applicant qualifies as a ‘small entity’ under US law, or to 75% if the applicant qualifies as a ‘micro entity’ under US law.

There are no maintenance fees or other post-issuance fees for US design patents.

Design patents applications are not published until issued.

Procedures

In order to obtain a filing date, an applicant for a design patent must submit at least one drawing and a written description containing a single claim.

The written description in a design application is normally brief and includes a specific title, a preamble, a reference to each figure and the claim at the end. The drawings form the substance of the specification and little, if any substance is included in the written description. 37 CFR §1.153 states that “no description, other than a reference to the drawing, is ordinarily required”. It is possible, but unusual, to add a description of features not shown in the drawings.

The single claim is commonly limited to a recitation claiming the article shown in the drawings. It is thus the drawings themselves that define the limitations of the claimed design. The claim should identify the same article as the title.

In order to control the breadth of the claim, when drafting a design patent application the drawings can include solid

lines and phantom (broken) lines. The solid lines define the features that are specifically claimed, whereas the phantom lines are for context. The USPTO will evaluate the patentability of the features of the design shown in solid lines in the drawings. The written description must dictate that the portions not shown in solid lines are not part of the claimed design.

A declaration by the inventor in compliance with 35 USC §115 must be submitted at some point during the pendency of the application (ideally with the initial filing, to avoid late fees).

For applications originating in foreign jurisdictions, in order to obtain the benefit of the previously filed foreign design application, an applicant must file a US design application claiming the benefit from the foreign convention application within six months of the first foreign filing. At present, applications claiming foreign priority must still meet the substantive and formal requirements described above.

After filing of a suitable application, substantive examination of a design patent application will normally occur within one or two years.

Multiple inventive embodiments can be included in a single design application, but the USPTO will require restriction to a single patentable embodiment. Each patentably distinct embodiment must be pursued in a separate divisional application. It appears that this will still be the case even after the act implementing the Hague Agreement becomes effective.

Once filed, the USPTO performs a search to find relevant prior art. The design is then evaluated against the prior art for novelty and non-obviousness. The USPTO can issue an office action rejecting the application if relevant suitable prior art is found.

Prior art rejections are not common in design applications, but they do occur. If an amendment to the claim scope is needed, the rules allow for phantom lines to be converted to solid lines and vice versa, to vary the scope of the claim.

If all rejections are overcome, a notice of allowance will issue requesting payment of issue fees.



Multiple inventive embodiments can be included in a single design application, but the USPTO will require restriction to a single patentable embodiment

Derivative applications (eg, divisional applications and continuation applications) can be filed at any time during pendency (until abandonment or issuance) in order to pursue other embodiments or other aspects of the design.

Enforcement

A design patent is enforced against an accused product in federal court. 35 USC §289 defines at least some acts of infringement.

A design patent is infringed if a person “(1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied”. The provisions of 35 USC §271 that define utility patent infringement also apply to design patents.

The test used to determine infringement is a judicially created test referred to as the ‘ordinary observer’ test – if an ordinary observer familiar with the prior art designs would be deceived into believing that the accused product is the same as the patented design, the accused product is infringing. This is similar to the likelihood of confusion analysis for trademark infringement, except that design distinctiveness is not a prerequisite for infringement of a design patent.

Remedies for infringement include equitable remedies (eg, injunctive relief) and legal remedies (eg, monetary damages). 35 USC §289 states that an infringer “shall be liable to the owner to the extent of his total profit, but not less than \$250”.

In the alternative, remedies afforded under 35 USC §284 (eg, lost profits) may be obtained. Where wilful infringement can be proved, treble damages may be awarded and can exceed the value realised under 35 USC §289.

35 USC §287 states that “no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice”.

Therefore, products sold must be marked as patented in order to give notice to infringers, or the infringer must have been actually notified in order to recover any damages.

Injunctive relief requires a showing of irreparable harm to the patent holder if the defendant is to be enjoined from continuing infringement.

Litigation for design patent infringement can extend for months, and even years, in the US federal court system.

Ownership changes and rights transfers

Design patents can be assigned and licensed.

The USPTO has an assignment recordation database which records assignments of ownership. 35 USC §289 states that “[a]n interest that constitutes an assignment, grant or conveyance shall be void as against any



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subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage". It is advisable to record assignments, liens or other conveyances to avoid subsequent title issues.

Related rights

Trade dress and copyright are related to design patents, but are different.

Trade dress law requires that the design to be used or sold in interstate commerce be distinctive as to the source of the goods. To qualify for trade dress protection, the claimed trade dress must also be non-functional. The non-functional standard for trade dress law is slightly different from that for design patents, in that the trade dress article must not be "primarily functional". This is a stricter standard than the 'dictated by function' standard for determining functionality of design patents. The term of trade dress protection is potentially unlimited.

Infringement analysis requires a showing of traditional trademark infringement, such as a likelihood of confusion as to source between the trade dress and the accused dress.

Copyright laws also protect designs, but the similarities between copyright and design

patents are limited. A copyrighted design must be original and non-functional such that the creative design must be separable from functional aspects of the object. Copyright has a registration process, but does not undergo substantive examination against the prior art. The term of a copyright is the life of the author plus 70 years or, if a work is made for hire, 95 years from the date of publication or 120 years from the date of creation, whichever is first. In addition, copyright has statutory damages that a plaintiff can pursue, unlike design patents.

Trade dress, copyright and design patent rights are not mutually exclusive. It is advisable to pursue as many paths for non-functional designs as possible to maximise protection in the United States. **WTR**

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