



You Secured a Utility Patent; Now What About Your Design?

John W. Boger, Esq.
Heslin Rothenberg Farley & Mesiti P.C.

Many manufacturers forget that design patents can protect their inventions and increase the value of their intellectual property portfolio. Design patents offer a different type of protection vs. a utility patent. Understanding the differences between design and utility patents may be helpful in making the correct decision on what type of intellectual protection is appropriate.

In a nutshell, utility patents protect the way that a device works or is made. Design patents protect the design of an article of manufacture, including how the device looks.

A great example of the power of design patents has been demonstrated between Apple and Samsung in various courts around the world over the past two years. Their epic battle in the U.S. has been a hot topic in the design patent world, because litigation between these two fierce competitors is focused upon four design patents held by Apple. These design patents covered many of the iPhone's critical visual features, such as the home button, rounder corners and tapered edges of the case and the on-screen icons.

Design patents protect only the appearance of an invention. Thus, design patents do not include a written description of what the structure of the device is or how it is made or used. Rather, the design patent usually contains a series of drawings or figures depicting the look of the design with descriptions of each of the views shown in particular figures. For this reason, the cost to prepare a design patent application will run from \$2,000 to \$3,500, much less than a utility patent application, which can be several times that amount.

One can only have a design patent issued if the device is new, original and ornamental in its look. A design patent is easily identifiable by its unique number designation: a "US" followed by a "D" and a six digit number; for example, US D007, 007. An additional nuisance of design patents is that the term of a design patent is shorter than a utility patent, expiring 14 years after the date of issue. Further, if keeping your invention a secret is critical, then you will be happy to know that design patent applications remain confidential and unavailable to the public until the design patent actually issues.

As noted above, a design patent application includes only one claim, referring specifically to the drawings within the application. Therefore, drawings are mandatory for the application to be accepted by the U.S. Patent and Trademark Office (USPTO) and must define the metes and bounds of the single claim as shown in the various views of the drawings.

Depending upon how the drawings are configured, an application may cover only a portion of a device. For example, the design patent is for a shovel; however, the patentee only wants to claim the handle, as opposed to the entire shovel.

The patentee in this case would feature the handle in solid lines and the rest of the shovel would be shown in broken rather than solid lines. When deciding how to create the drawings of your invention, careful consideration should be taken to identify the critical ornamental parts of the device and which aspects of the device you want to protect in the patent application.

Like utility patents, design patents may be infringed by someone who, without authority, makes, uses, offers to sell or sells the claimed invention within the U.S. or who imports or exports the invention from or to the U.S.

Infringement also occurs when someone actively induces the infringement of a patent or contributes to the infringement of a patent. Standards for infringement are equally applicable to design and utility patents, with the exception of remedies for infringement of certain process patents.

For both types of patents, the first step of having a court determine the meaning of the claim is the same. This procedure is typically referred to as "claim construction." In construing a design patent claim, the court will describe the design in words and identify functional versus non-functional features. Only non-functional features will comprise the claimed design.

The next step in determining whether the design patent is infringed is to compare the constructed claims with the accused design. This is accomplished by comparing the patented and accused designs for their *overall* visual similarity in accordance with the "ordinary observer test" to determine if the designs are substantially the same. Designs are substantially the same if the resemblance is such as to deceive an ordinary observer, inducing him to purchase one supposing it to be the other.

Apple and Samsung provide a great example of the power of design patents, as observed in various courts around the world over the past two years.

Differences and similarities are relevant in determining whether an ordinary observer would be deceived into purchasing one design supposing it to be the other. Thus, a plaintiff must be able to prove that the accused design is substantially the same as the claimed patented design in order to show infringement.

An example of a design patent claim and description is set forth in Exhibit 1. This claim is taken from U.S. Design Patent No. D628, 291, which is directed to the Ornamental Design for a Surgical Retractor.

Exhibit 1: Example of a Design Patent Claim

(57)	CLAIM
	The ornamental design for a surgical retractor, as shown and described.
	DESCRIPTION
	FIG.1 is a perspective view of a surgical retractor comprising the new design;
	FIG. 2 is a left side elevational view of the design of FIG. 1, where the right side elevational view is a mirror image thereof;
	FIG. 3 is a top plan view of the design of FIG. 1;
	FIG. 4 is a bottom plain view of the design of FIG. 1;
	FIG. 5 is a front elevational view of the design of FIG. 1; and,
	FIG. 6 is a rear elevational view of the design of FIG. 1.
	The broken lines immediately adjacent the claimed areas represent the bounds of the claimed design while all other broken lines are directed to environment and are for illustrative purposes only; the broken lines form no part of the claimed design.

Exhibit 2 on page 48 is an image of a claimed design and shows certain portions of the retractor in dotted lines, which do not form any part of the claimed retractor design. When determining whether there is infringement of this claimed design, the drawing (such as Exhibit 2) will be compared to the allegedly infringing retractor design. In making this comparison, the features shown in dotted lines are not compared to any corresponding features within the allegedly infringing retractor design because these aspects of the design are not being claimed and represent the bounds of the claimed design. For another retractor design to infringe on this design patent claim, it must contain substantially the same overall appearance in accordance with the ordinary observer test.

The remedies for infringement of design and utility patents are very different in some aspects. For both design and utility patent infringement, a patentee can recover damages adequate to compensate for the infringement. Such damages can be in no event less than a reasonable royalty for the use

Medical Device Quality Management Program

The Medical Device Quality Management (MDQM) program exists to train and develop individuals who are currently employed in or wish to enter the medical device industry or related industries. The five courses in this program can be applied to a certificate, bachelor's degree or master's degree, depending on the student's academic background and educational goals. The MDQM program focuses on the critical elements in quality management, including quality systems, post-market surveillance, design control and assurance, manufacturing quality and supply chain management and statistical processes that ensure excellence at key stages of the medical device life cycle.

Grace College is adjacent to Warsaw, Indiana – the Orthopaedic Capital of the World® – and is proud to partner with OrthoWorx to offer three industry-focused Medical Device Quality Management programs: Certificate in MDQM, Bachelor of Science in MDQM and Master of Science in MDQM.

Instructors are Experts within the Industry

Instructors manage real-life medical device quality issues and processes. They are selected not only for their education and expertise, but just as importantly, their exceptional teaching abilities.

Certificate in MDQM

The MDQM certificate program consists of five courses offered in a convenient one-night-a week format at Grace College. All courses are five weeks and the in-depth curriculum is built around materials endorsed by the American Society for Quality (ASQ). The entire MDQM Certificate Program runs from January through July on consecutive Monday evenings. No previous college experience is required for admission.

Bachelor of Science in Quality Management

With your associate's degree completed, or the equivalent of sixty credit hours under your belt, you are well on your way to earning your bachelor's degree. The Quality Management bachelor's program consists of approximately fifteen, three-credit courses offered in a convenient one-night-a week format or two-Saturdays per month. Weeknight courses are five weeks long. Enrollment is September and January and total time for degree completion is 16-18 months.

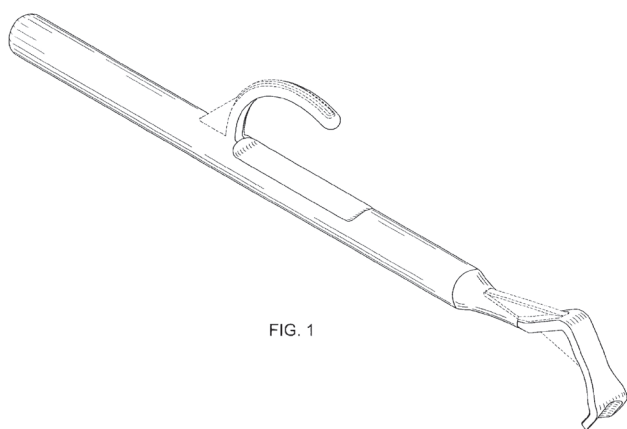
Master of Science in MDQM

With this unique master's degree, you will learn from industry professionals who bring not only academic excellence to the classroom, but also their real-world experience.

The MDQM Master's Program consists of twelve courses offered in a convenient one-night-a week or weekend format at Grace College. All courses are either four or five weeks long and combine outstanding lectures, activities, and online resources. Distance learning is also available through lecture capture and video conferencing technology. The in-depth curriculum is built around materials endorsed by industry bodies such as the Food and Drug Law Institute (FDLI), the Food and Drug Administration (FDA), The Regulatory Affairs Professional Society (RAPS), and the American Society for Quality (ASQ).

For more information, email deckerap@grace.edu or visit grace.edu/mdqm.

Exhibit 2: Image of the Claimed Design Described in Exhibit 1



made of the invention by the infringer. A reasonable royalty is the minimum limit of recovery. There is an additional remedy for infringement of design patents: the infringer's profits. In design patent infringement actions, the patent owner has the option to recover either its lost profits *or* the infringer's profits. A design patentee cannot recover both, nor a combination of both. Actual damages, including a reasonable royalty and an infringer's profits, are alternative recoveries for damages for the same infringing product.

If a design patent owner ultimately decides to pursue an infringer's profits, it will be entitled to an infringer's profits for any product that infringes the design. The amount is calculated using the infringer's sales and deducting costs including, but not limited to, importation costs, manufacturing costs, promotional costs, sales representatives' commissions and the like. The burden of establishing the nature and amount of deductions from the sales price to arrive at profit is on the infringer. The patentee need only prove the infringer's gross sales.

In the case of Apple and Samsung, the jury from the first trial found that Samsung had infringed Apple's two design patents (and three utility patents) and awarded Apple over \$1 billion in damages. This sum was later reduced by the court for technical reasons on the part of the jury, and a retrial on the damages was ordered. This litigation continues today, with neither party showing signs of letting up.

Design patents are not just a creation of U.S. patent law, as most countries offer some form of protection for ornamental designs. In 2001, the EU adopted the Community Design Regulation that created protection for the registered Community Design (RCD). The RCD provides to the owner an exclusive right for the outward appearance of the whole product or part of the product that results from the lines, colors, shape, contours, textures, materials or ornamentation exhibited by the product. What cannot be protected by an RCD is the idea of the product or the technology aspects of the product. In addition, any components of the product that are not visible are excluded from protections.

An application for an RCD is filed with the Office for Harmonization in the Internal Markets (OHIM), and once the design is registered, it is valid in all EU member countries. In order to be granted Community design protection, the product or design must be "new," which means no identical design is available to the public. With regards to the newness or novelty element, a 12-month grace period does exist whereby the owner of the design/product can disclose the design without jeopardizing the required novelty status for filing the RCD application. The second required standard is that the design needs to possess "individual character." Essentially, to be registered, the design needs to be recognized as being different from any existing design. The RCD has an initial term of five years from the date of filing and can then be renewed with the OHIM in five year increments up to a maximum aggregate term of 25 years.

Having an RCD confers on the owner the exclusive right to use it in the EU and prevent any third parties from using it unless consent has been granted. More specifically, the level of exclusive protection provided by having an RCD also includes the ability to protect against deliberate copying and independent development of any similar design. Further, the rights given to the owner of an RCD include the prohibition of a third party from making, offering for sale, marketing, exporting or using of a product in which the RCD is incorporated or to which it may be applied for these purposes. The owner of the RCD may enforce their right by bringing an infringement action in the Community Design court as well as file a request with customs authorities in the particular country to retain suspected counterfeit goods under their control.

The RCD offers many benefits when in place. Therefore, if your company is contemplating or actually selling products in Europe, it should strongly consider supplementing design protection strategy by filing for an RCD.

In conclusion, it is recommended that if your product contains some ornamental features, then filing a design patent may be appropriate, be it in the U.S. or EU. It should be understood that the design patent only covers the overall ornamental look of the product. Further, if granted, the design patent may be enforced against any infringer who makes an article of manufacture that looks substantially the same as your product. The additional measure of damages (i.e., infringer's profits) may often be a reason alone to obtain a design patent on a product.

This article was written for informational and educational purposes and should not be interpreted as legal advice. Please contact your local patent attorney or the author if you should have specific questions regarding filing a design patent application.

John W. Boger is Chairman of Heslin Rothenberg Farley & Mesiti P.C.'s Medical Products and Technology Practice Group. Before attending law school, Mr. Boger worked for eight years with a large orthopaedic device manufacturer in product development and marketing. He can be reached at jwb@hrfmlaw.com.

Heslin Rothenberg Farley & Mesiti P.C.
www.hrfmlaw.com