



**DESIGN PATENT NEWS**

**USPTO HOLDS INFORMATION-PACKED  
2018 DESIGN DAY CONFERENCE.**

On April 25, 2018, the U.S. Patent and Trademark Office held its annual Design Day Conference in Alexandria, Virginia, during which participants were provided with a variety of information-packed presentations and panel discussions by USPTO officials, design patent practitioners (including NSIP Law's Shabnam Nowrouzi) and members of industry who have benefited from design patents. The conference opened with remarks by the newly-appointed Director of the USPTO, Andrei Iancu, who discussed the importance of design patents, and related an interesting story of how the Statue of Liberty came to be the subject of U.S. Design Patent No. 11,023.

Mr. Ianco was followed by Karen Young, the Director of Technology Center 2900, which is responsible for examining all design patent applications within the USPTO, who presented the annual State of the Design Technology Center report. Ms. Young indicated that for the first time, the USPTO had established a design patent examination operation in one of its regional offices, the Rocky Mountain Regional Office in Denver, Colorado. The Technology Center currently has 183 design patent examiners, which is fewer than the number of Examiners who were working in FY2017. Ms. Young confirmed that the USPTO intended to hire an additional 15 design patent Examiners for FY2018 in order to reduce the design patent application backlog, and continue the trend of increasing the number of Examiners each year.

NSIP Law is a full service intellectual property firm that specializes in the procurement of enforceable IP rights to protect innovations and investments pertaining to patents, trademarks, and copyrights.

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For the first two quarters of FY2018, Ms. Young indicated that TC2900 had received 22,636 new design patent applications, and that they expect to receive around 45,000 total this year. There is currently a backlog of 44,677 unexamined design patent applications, and they expect to issue 44,000 first actions in pending cases. This has resulted in an average pendency of 12.9 months for design patent applications before they receive their first action, and an average of 19.2 months total pendency from filing until issuance. This represents a gradual improvement over past years.

Ms. Young also described TC2900's "Rocket Docket" program whereby they grant expedited consideration to design patent applications. Such expedited consideration is requested by filing a Petition with the UPTO, and paying a fee. According to Ms. Young, design applications are pending for about 2.4 months before they receive their first action, and the total pendency of a design application is about 1/3 the time of a normally prosecuted application.

Ms. Young also reported that substantially fewer design applications have been filed through the Hague Convention procedures which designate the U.S. as a receiving country: 1623 in the current fiscal year, versus 2116 in the prior fiscal year. Of the Hague application filings, only 77% are allowed, versus 86% for U.S. design patent applications originally filed with the USPTO, with 23% of the Hague applications being abandoned, versus 14% for U.S.-origin applications. Ms. Young attributed the drop off in filings and the lower allowance rate to the need for Hague applications to conform to the unique requirements and practices for U.S. design patent applications.

Ms. Young concluded by describing the operational plan for TC2900 in FY2018, which includes hiring, training and deploying additional design patent Examiners, implementing continuous training of Examiners, undertaking a review of the current design application inventory and assessing future staffing needs, improving and modernizing TC2900's information technology capabilities, including the purchase of more powerful laptop computers for Examiners and the implementation of a new computer system that will assist Examiners with writing Office Actions, and which will provide Examiners with enhanced tools for searching for prior art. Finally, resources will be devoted to improving the processing of special cases, including cases undergoing examination through the Rocket Docket, Hague Convention applications, Petitions

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and Appeals.

Ms. Courtney Stopp of the USPTO's Office of Policy and International Affairs provided a summary of the USPTO's design patent initiatives internationally. Ms. Stopp summarized the performance of the Hague Convention procedure for filing design patents in the U.S. She indicated that design patent filings under the Hague procedures initially increased after they were implemented in the U.S. in May 2015 because the U.S., Japan and Korea had joined the Hague Convention at that time. Most Hague Convention filings were utilized by applicants in the European Union, Germany and Japan in order to enter the U.S. system for examination. U.S.-based applicants are not using the Hague procedures very much. Ms. Stopp anticipates that the United Kingdom will join the Hague Convention shortly in order to protect its rights as they leave the EU, to be followed by Canada and Mexico, which should increase the volume of Hague Convention filings which designate the U.S. as a receiving office.

Ms. Stopp indicated that the USPTO is working with the World Intellectual Property Office's (WIPO) DAS process to extend its digital exchange of priority documents to designs. A U.S. design applicant can then request that the patent office where its priority application has been filed to make the application available on the Internet, so that the destination office (*i.e.*, the USPTO) can retrieve it. The USPTO is also working with WIPO's Standing Committee on Designs to draft a design law treaty that will harmonize the requirements for the preparation and filing of formalities documents for design patent applications, including the format of the application itself, rules for determining a filing date and priority date for the application, a uniform grace period before a design application must be filed, and a procedure for requesting a reinstatement of rights when certain deadlines are missed.

Ms. Stopp also stated that the USPTO was working with its ID5 partners (Japan, Korea, European Union, and China – with WIPO as an observer) to study and harmonize the protection of graphical user interfaces, computer-generated icons and typefaces through design patents. This will entail a review of examination practices in those countries, and any variations in protections will need to be addressed. A focus will be placed on the linkage between the design and the article of manufacture to which it applies, which can define the strength and scope of protection for GUIs and icons. Protections for advanced modes of presentation or expression of designs through different electronic file formats, such as .mov, 3D CAD, .wav, etc. will be discussed as well.

Ms. Stopp also emphasized the fact that since the United Kingdom is leaving the EU through the BREXIT process, applicants and design patent holders can no longer rely on EU design registrations for protection in the U.K. after December 31, 2020. A separate U.K. design registration must be obtained. The U.K. is working on procedures for allowing registration in the U.K. of pre-existing EU design registrations, so that the transition will be seamless.

Ms. Stopp also discussed legal developments in China and the European Union concerning the protection of designs. The scope of protection of graphical user interfaces in China was decided for the first time in *Qizhi Software v. Jiangmin*, in which a Chinese design patent claiming a computer displaying a GUI design was

sought to be enforced against a software product that generated a nearly identical GUI design. The issue in *Qizhi* was whether the plaintiff could exclude the generic computer design shown in the drawing figures from the scope of coverage of the Chinese design patent, so that they would only be claiming the portion of the design that applies to the GUI. Although this is standard practice among many countries around the world, this issue had not been decided in China. However, the Chinese Court in *Qizhi* diverged from the majority rule among other countries, and held instead that the design patent claim must include the computer with the specific GUI design displayed on it. The Court's decision in *Qizhi* has been criticized for interpreting the GUI design claim very narrowly, so that such design patents have very little value, because computers are not generally sold with the GUI that is part of the design claim already loaded onto them, which is why the Court in *Qizhi* found that Jiangmin's software (which was not paired with any particular computer) did not infringe the design patent claim.

In *Doceram GmbH v. Ceramtec*, the Court of Justice of the European Union was asked to clarify what factors must be considered when determining whether the features of a design should be considered functional, and therefore not protected. Design features that are dictated solely by a technical function are excluded from design protection under Article 8 of the Community Design Regulation (CDR) (2002) because the advance of technology and innovation should not be hampered by granting design protection to features dictated solely by a technical function, and for which utility patent protection would be more appropriate. The parties in *Ceramtec* disputed what the proper standard should be for making this determination, and whether it must be made from the perspective of an "objective observer." The Court ultimately ruled that if the technical function of the design is the only factor which determined those features, then the design would be excluded from registration. However, if other factors were considered, such as the ornamental appearance of the design, then it is not functional for purposes of determining whether it may be protected by a design patent. The Court stated that it is the job of the national courts within the EU to determine whether the characteristics of the product are solely dictated by technical function, while considering "all objective, relevant circumstances", including whether any alternative designs that achieve the same technical function as the product in question exist. The Court further ruled that there is no need to make this determination from the perspective of an "objective observer."

Next, Tomoki Sawai, the Director General for Patent and Design Examination for the Japan Patent Office provided his perspective on the importance of design patents. Mr. Sawai expressed his belief that design is becoming more important to business and commerce, as it evolves from classical designs that include the shape and appearance of products, to virtual designs that are generated by technology, such as GUIs, icons and other computer-generated user experiences. Designs are becoming increasingly important in differentiating products and establishing strong brands. Mr. Sawai cited a study by the Design Management Institute, which found that as the value of a company's design rose, their stock price on the S & P 500 Index rose as well.

For Mr. Sawai, design represents the intersection of invention and insight. Mr. Sawai advocated for experienced designers to be included in the executive control group for businesses and the management group for intellectual property within companies, because they foster enhancement of design thinking, design management (*i.e.* utilization of designs) and a revision of the IP system. Designers help to solve consumer

problems, contribute to the agile development of product prototypes and advocate for improvements to the IP protection system, so that designs generated by new technologies, such as computer-generated user experiences and artificial intelligence are protected.

A panel discussion on best practices for design patent prosecution was presented. This panel included NSIP Law's Shabnam Nowrouzi. The panel discussed issues relating to the title of design patent applications, Hague Convention applications, the use of photographs or graphical renderings as the formal drawing figures in design patent applications, and the use of affidavits under 37 C.F.R. 1.130 in order to disqualify prior art references.

With regard to the title that is given to a particular design, the Examiners on the panel expressed the need to know what the design refers to, and what the Applicant's invention is, so that the design may be properly classified for examination and a search for relevant prior art references may be conducted as part of the examination process. According to the Examiners, design patents provide a limited monopoly in exchange for the public disclosure of the design. An overly broad title would fail the public notice function of the design patent's claim. However, under MPEP 1503.01, it was noted that all that is required is for the title to allow a field of search and classification for the design.

Examiners often object to the title to an application because it is overly broad or too vague for them to understand what the design is, and what type of product it is directed to for classification and search purposes. This often creates a dilemma for a design patent attorney, who must decide how to best address the Examiner's concern and remove the objection, while avoiding making statements or amendments on the record during the prosecution of the design patent application that may be interpreted later as a narrowing of the scope of the design claim, or as a relinquishment of certain portions of the claimed design.

Therefore, the design patent attorneys on the panel advocated for the Examiners to first make informal inquiries to the applicant's attorney to discuss what the design is, and what types or categories of products it is directed to, so that a proper classification and search can be made without the need to make formal statements and amendments on the record. If a formal objection to the title is entered by the Examiner in an Office Action, the attorneys recommended that the applicant contact the Examiner to discuss how the objection can be overcome, such as by providing a description of the product that the design is directed to, or how the applicant intends for the design to be used. If the objection is directed to the lack of specificity of the title, an explanation should be given to the Examiner concerning why the current title is sufficiently specific to allow the Examiner to conduct a proper examination of the design claim. If that discussion is not successful, then the attorneys suggested that alternative titles should be discussed with the examiner which clarify what the design is, but yet are sufficiently broad to avoid a narrowing of the scope of the design claim in the future.

In order to avoid objections to the title, the attorneys suggested that descriptions of the design may be included in the specification of the U.S. design patent application that are taken from the English translation of a foreign priority document (if any). Alternatively, a further description of what the design is may be provided in a preamble to the design claim, or it may be included (along with photographs of the product that the design

represents) in a design patent appendix that does not form a part of the design application. These disclosures may provide the Examiner with the information that he or she needs to understand the design, and undertake a proper examination without creating a record as part of the design patent application that may be used to narrow the interpretation and scope of coverage of the design patent in the future.

With respect to design patent applications filed under the Hague Convention, the panel noted that applicants commit several common errors relating to U.S. design patent practices that delay or derail the prosecution of such applications. Applicants do not adhere to the Hague drawing figure numbering conventions (*i.e.*, FIG. 1.1, 1.2, 2.1, 2.2, etc.) when they are making elections among embodiments, and making amendments to the design claim in response to Office Actions. When divisional design applications are filed, applicants neglect to convert the drawing figure numbering convention from the Hague style to standard U.S. style (*i.e.*, FIG. 1, FIG. 2, etc.), as required by the U.S. patent rules. Many applications fail to provide any descriptions for the drawing figures at all, or they include lengthy descriptions of the subject matter set forth in the drawings, both of which fail to conform to U.S. design patent practices. Other errors involve drawing figures which lack surface shading, errors in converting photographic drawings to black & white line drawings which may violate the written description requirement of U.S. patent law. Several of these errors may prevent the application from moving forward. It was recommended that applicants consult with U.S. patent counsel to ensure that their Hague Convention application complies with U.S. design patent law and practices before filing the application.

With respect to photographic drawings, Shabnam Nowrouzi of NSIP Law offered several insightful practical suggestions for ensuring that such drawings are accepted by the Examiner. Photographic and graphical drawings are acceptable as formal drawings in the U.S., especially if they are the best way to capture the full scope of the design that is being claimed, and to clearly show the details of the design features. They are particularly useful for designs that have transparent features where the ability to see both sides of the design is important. Even when photographic drawings are used as the formal drawings, it was recommended that standard black & white line drawings representing all views of the design be included in the appendix, so that there is an original disclosure of what the design looks like when it is drawn using black lines, in case there is a need to convert the photographs to black line drawings during prosecution. Conversely, it was recommended that if black & white line drawings were used as the formal drawings, photographs of the product embodying the design in all relevant views be included in an Appendix in order to ensure that the disclosure of the features of the design is complete and clear to the Examiner.

It was acknowledged that amendments to photographic drawings may be difficult, and they present a risk of deviating from the original disclosure and improperly introducing new matter. Therefore, in certain cases, objections to or rejections of photographic drawings by the Examiner may be difficult to overcome. Even so, particular features of the design shown in the photographs may be excluded from the design claim, such as by showing them to be lighter and more opaque in tone than the portions of the photograph that represent the claimed features, which gives the unclaimed features a “washed out” appearance, in contrast to the sharp image of the claimed features.

With respect to affidavits filed under Rule 1.130, according to the America Invents Act, applicants for U.S. design patents have a one-year grace period from when the design is first disclosed to the public before they are required to file an application claiming it without losing their patent rights. Under certain circumstances, if the Examiner cites the applicant's own design as a prior art reference that was made public during that one-year grace period, the applicant may request that the reference be disqualified by filing a Rule 1.130 affidavit. That affidavit is usually signed by the inventor(s) of the design that is the subject of the application. The inventors are required to explain in as much detail as possible that the design shown in the reference is a design that they created, and that the design was turned over to the applicant as part of their employment by the applicant. The affidavit must contain sufficient information to prove that the design shown in the reference was not made "by another," that is, by someone other than the inventors. The inventors must also explain in as much detail as possible the circumstances under which the applicant disclosed that design to the public after receiving it from the inventors. If the design shown in the reference was republished by a third-party, it is not necessary to obtain an affidavit from that third party which explains how they obtained the reference or images of the reference directly or indirectly from the inventor(s). It is sufficient to provide an explanation of how the applicant obtained the design from the inventors and published it. An affidavit that contains this information is usually sufficient to disqualify the cited reference.

Additional Design Day panels included members of industry who provided insight into how they have benefitted from the use of design patents. Representatives from Microsoft, Scientific Games, Kallista Faucets, Kohler, Newell Brands, and Caterpillar recommended that governments adopt a strong design patenting system in order to protect their companies' investments in innovating their products. They believe that design patents are important because the aesthetic appearance of a product initially draws a consumer's interest to it. Design creates an emotional connection between the viewer and the product which has the purpose of creating a sale. Good designs matter, because they improve the visibility and attractiveness of products. Designs may also improve ergonomics and comfort when using the products, and may make the products more understandable and useable to the consumer. Designs may also be used to appeal to a particular demographic, and may assist consumers to visualize and memorize a company's brand.

For software-based inventions, the panelists agreed that under the current state of the U.S. patent law, obtaining design patents for the ornamental appearance of GUIs and use experiences may be easier than protecting the functionality of the software itself by using utility patents, as many current software inventions have been made ineligible for utility patent protection under recent U.S. Supreme Court decisions. Protecting GUIs, user experiences, fonts and icons is important because they are used to quickly and easily display productivity tools to the user. Design patents therefore protect against competitors who use the distinctive features of hardware and software products in their own products without making the initial investment to create them.

Industry panelists also discussed trends for enforcing design patents against infringements that occur on the internet. Most such infringements occur on Amazon, Taobao or Alibaba or similar internet-based sale platform. Other panelists described how their products were reverse engineered and sold by small "mom and pop" manufacturers. The products that are most frequently "knocked off" by such internet sales include apparel and accessories, consumer electronics, pharmaceuticals, handbags and wallets, footwear and optical.

The panelists noted that infringers have become more technologically savvy, more brazen and savvier about intellectual property rights – and how to avoid them. The tactics that they employ to discover potential infringements have evolved as well. In the past, the panelists would go to large “big box” retailers to see copies of their products on the shelf. Now, they conduct internet searches to discover infringements, and attend trade shows where infringers will openly display their products. The panelists also observed that many online sale platforms are not aggressive about stopping infringements, which makes enforcement difficult, as infringers may sell counterfeit products under many different names on several different platforms. The online platforms are often slow in taking down postings of infringing products, and trade shows require a court order before they will exclude an exhibiter for patent infringement, because those entities benefit from the infringer’s use of their services. The panelists have also found that such infringements of design patents are increasingly financed and conducted by organized criminal enterprises that are also involved in human trafficking, money laundering and international terrorism. Therefore, the infringers are difficult to track and stop, and even if they are stopped, they reappear under a new business name and continue to sell the counterfeit products. As a result, the panelists advocated for a change in U.S. patent law in order to provide them with stronger tools with which to combat these infringements.

A discussion of recent developments in U.S. design patent law was also presented. In the year since the last USPTO Design Day conference there have been relatively few developments in design patent law. There were no significant decisions of the U.S. Supreme Court or the U.S. Court of Appeals for the Federal Circuit that significantly affected design patent law, and only a handful of decisions of the U.S. District Courts were entered. Two of the most noteworthy District Court decisions are discussed in the other two articles that are included in this newsletter.

Finally, an analysis of *Inter-Partes* Review (IPR) and Post-Grant Review (PGR) proceedings that are conducted before the USPTO’s Patent Trial and Appeal Board (“PTAB”) was undertaken. Since 2015 there have been 109 decisions of the PTAB that involved design patents, 10% of which involved anticipation of the design claim by prior art references under 35 U.S.C. 102; 75% involved the alleged invalidity of the design claim for obviousness in view of the prior art under 35 U.S.C. 103; 10% involved defects in the written description of the design, or its lack of enablement or indefiniteness under 35 U.S.C. 112 and 12% involved issues of lack of ornamentality or protectable design subject matter under 35 U.S.C. 171.

Of the design patent IPRs that were filed, 43% were instituted by the PTAB, while 57% were denied institution, because they failed to raise an issue regarding patentability that had a reasonable probability of succeeding. When an IPR is not instituted, the design patent survives intact. Once an IPR is instituted, however, 71% of the design patent claims at issue were found to be unpatentable. With respect to PGRs, only three (3) were granted institution, one (1) was denied institution and one (1) case settled.

In the case of *Ex Parte* Reexaminations of issued design patents by the USPTO, 54 requests have been made to reexamine issued design patents based on the prior art under Sections 102 and 103, 51 of which were made by a third-party requester and only three (3) were requested by the patent owner. In 93% of the cases reexamination was ordered, and of the cases where reexamination was conducted, 87% resulted in the design claim being confirmed without any change. Based on these statistics, it appears that an accused infringer of



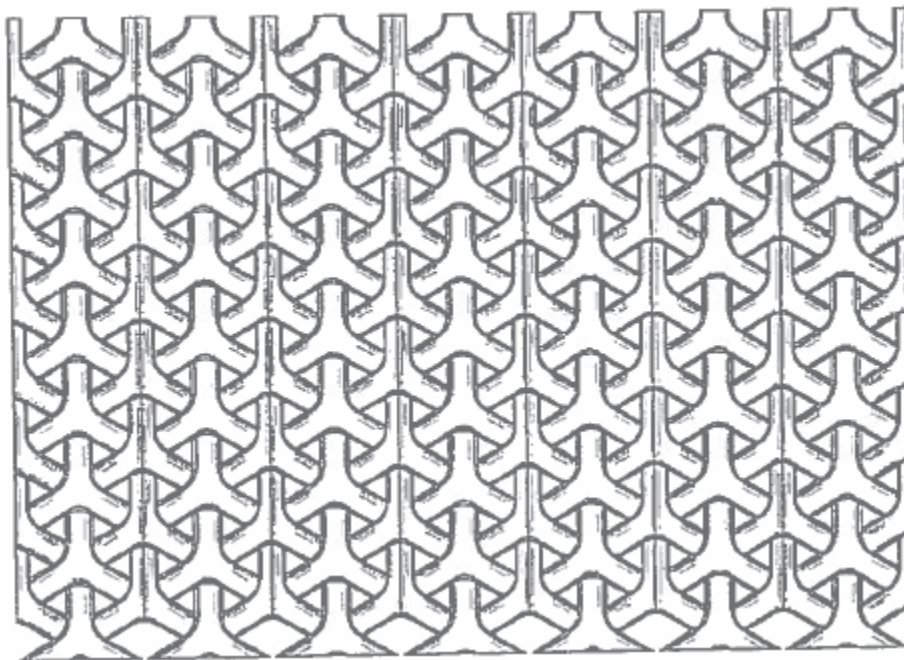
a design patent would have a relatively high probability of succeeding with an IPR if it is granted, but would have a lower probability of succeeding with a challenge to the design patent through the PGR and reexamination processes.

Overall, 2018 Design Day was viewed as a success by the participants and attendees.

## A CAREFUL CHOICE OF TITLE IS VITAL TO U.S. DESIGN PATENTS

Most applicants for U.S. Design patents focus their attention on producing high-quality drawing figures which clearly and accurately display the design that they claim as their invention, along with drafting a specification which describes the features of the design that is shown in those drawings. While that is undoubtedly very important, the selection of an appropriate title to the design application is often considered an afterthought. However, a recent case decided by the U.S. District Court for the District of New Jersey has focused renewed attention on the importance of the design patent's title, and has reinforced its role in defining the scope of coverage of the design rights that are conveyed by a design patent.

In *Curver Luxembourg, SARL v. Home Expressions, Inc.*, Civ. No. 2:17-cv-4079-KM-JBC (Slip Op.)(D.NJ 2018), the District Court granted defendant Home Expressions' motion to dismiss the action for design patent infringement that had been brought by plaintiff Curver Luxembourg, based on the title to Curver's U.S. design patent. The Court did so at a very early stage of the case, shortly after Curver's complaint had been filed. Curver had sued Home Expressions for infringement of its U.S. Design Patent No. D677,946 ("the '946 Patent"), based on Home Expressions' manufacture and sale of baskets that incorporated the '946 Patent's design. The pattern design that is claimed by the '946 Patent took the form of overlapping "Y" shapes, as shown in Figure 1:



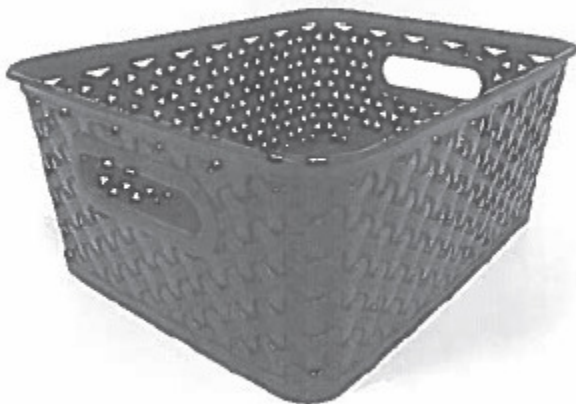
The '946 Patent's is titled "Pattern for a Chair." However, that was not its original title. Curver's original U.S. design patent application was entitled "Furniture Part," and "Furniture (Part of)." The design claim

identified the design as “Rattan Design for Furniture Part.” During prosecution of this application before the U.S. Patent and Trademark Office, the Examiner objected to the title because it was not specific enough in its description of the article of manufacture to which the claimed design pertained. Under the U.S. Patent Rules, the title of a design must designate the particular article which is the subject of the design. According to the USPTO’s Manual of Patent Examining Procedure, the title of the design must identify the article in which the design is embodied by the name generally known and used by the public.

The Examiner considered the title to have been stated inconsistently throughout the application and design claim, and that the use of “Part” or “Part of” in the original title did not refer to an article of manufacture, and was too vague. Therefore, the Examiner suggested that the application be titled “Pattern for a Chair,” although a chair was not shown anywhere in the drawing figures. The applicant agreed to change the title of the application to “Pattern for a Chair” as the Examiner had suggested in order to obtain the allowance of the case.

Curver sold baskets which incorporated the overlapping “Y” design that was claimed in the ‘946 Patent. Curver argued that the storage baskets sold by Home Expressions were allegedly identical to the baskets sold by Curver, and that those accused baskets contained “each element of the claimed design in the ‘946 Patent.” Figure 2 below shows an example of the Curver basket, while Figure 3 shows examples of the Home Expressions basket.

**Figure 2**



**Figure 3**



In deciding Home Expressions’ motion to dismiss Curver’s lawsuit, the District Court noted that patent protection is available for a “new, original and ornamental design for an article of manufacture,” and that a patentable design “gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form.” A design patent is infringed if an ordinary observer would determine that the allegedly infringing patent and the design of the allegedly infringing article are substantially the same. The District Court noted further that infringement “is not found unless the accused article embodies the patented design or any colorable imitation of it.”

When applying the '946 Patent to the accused infringing Home Expressions baskets, the District Court was required to interpret what the design claim covered, in order to determine the scope of the property right that were given by the design patent. In arriving at its interpretation of the design claim of the '946 Patent, the District Court focused on what happened during its prosecution before the U.S. Patent and Trademark Office, in particular the Applicant's amendment of the title in order to overcome the Examiner's objection. In doing so, the Court applied the legal doctrine of *prosecution history estoppel*, which holds that if an applicant gave up design subject matter during prosecution of the design patent application in order to obtain its allowance by the Examiner, then the applicant cannot recapture that relinquished subject matter later when it goes to enforce the design patent in federal court.

In this case, the District Court noted that although the design claim is primarily defined by the images of the claimed design that are shown in the drawing figures, the title of a design patent can help to define the scope of the design patent's protections. In this case, the District Court found that the title of the design patent was relevant because it was explicitly and intentionally narrowed to one single article of manufacture, *i.e.* a "chair," from the original description of the design as the general category of "furniture part." Each drawing figure in the published patent was described in the specification as a "design for a pattern for a chair," based on the amendments that the Applicant had made. The District Court therefore ruled that Curver surrendered a broader design claim for an ornamental pattern "for furniture," and accepted a narrowed design patent for an ornamental pattern "for a chair." According to the District Court, this was exactly the sort of design claim surrender that results in prosecution history estoppel. This was particularly true, because Curver amended the title to its design in order to overcome the Examiner's objection and obtain the issuance of its design patent.

The District Court then applied this interpretation of the '946 Patent to find that Home Expressions' baskets could not infringe, even though they used an identical overlapping "Y" pattern. Because Curver was found to have surrendered coverage for its design claim for anything that was not a chair, Home Expressions could not infringe because its basket was not a chair. The District Court also found that Home Expressions' basket was not even within the scope of the '946 Patent as it was originally filed with the USPTO, because a basket could not reasonably be considered an item of "furniture." As the District Court acknowledged, the scope of coverage of a design patent is limited to the "article of manufacture" or product that is listed in the title to the patent. Therefore, a design patent that protects a pattern for a chair or furniture does not protect the same pattern on a basket. As a result, the District Court dismissed the case.

The District Court's decision in *Home Expressions* highlights the potential risks in selecting a title for a design patent application, and the consequences of changing the title during prosecution in order to overcome an objection by the Examiner. However, there are several practical actions that an applicant may take in order to minimize or avoid the adverse outcome that befell Curver Luxemburg in that case:

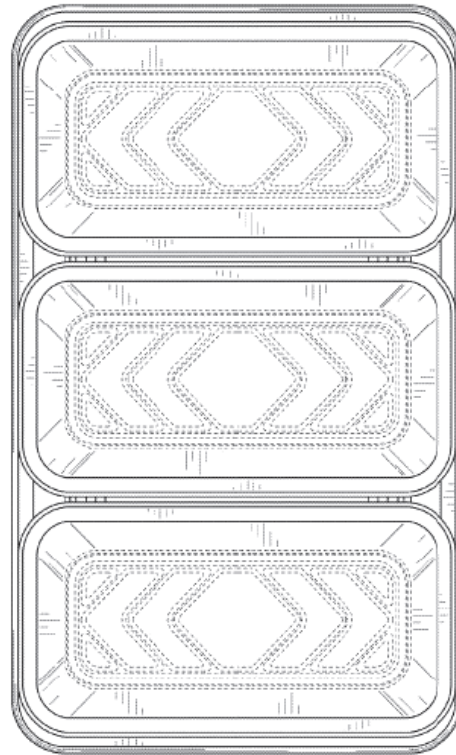
- Select a title which describes the type of product that is shown in the drawing figures to which the claimed design applies, even if that is a broad category, such as "furniture" or "electronic device." In *Home Expressions*, the drawing figures of the '946 Patent did not show a chair, or any other particular type of furniture, only the pattern itself. Therefore, there was really no foundation for the Examiner

to have required the application to be limited to a chair, and the Applicant should have requested that the Examiner accept “Pattern for Furniture” as the amended title. That may not have allowed them to apply the design claim for a basket, but it would have been much broader than “Pattern for a Chair.”

- Be careful to refer to the claimed design using the same descriptive title throughout the specification of the design patent applications. Any inconsistency, such as that found in the original specification of the ‘946 Patent discussed in *Home Expressions*, will be a red flag to a design patent Examiner, and may trigger an objection to the title and a requirement that the title be changed, to the detriment of the applicant.
- If the Examiner objects to the title and proposes a very narrow title directed to a specific product, conduct an interview with the Examiner to discuss broader alternative titles that may address the Examiner’s concerns, but which do not unduly narrow the scope of coverage of the design claim.
- If a broad category title is selected, consider including additional drawing figures which show the claimed design as it may be applied to different types of products within that category, where the example products are shown in broken lines to indicate that they are unclaimed. This may make it difficult for the Examiner to object to a broad title.
- If the Examiner objects to an overly broad title on grounds that the title is not specific enough to provide an understanding of the product that the design is directed to, what the design is used for, or is too vague to allow them to conduct a proper prior art search as part of the application examination, then contact the Examiner by telephone to provide a description of what the product is and how it is used. This may satisfy the Examiner’s concerns while avoiding the need to amend the title and surrender coverage for the design patent.

## **TEXAS DISTRICT COURT TACKLES DESIGN PATENT CLAIM CONSTRUCTION**

In *HFA, Inc. v. Trinidad/Benham Corp.*, Civil Action No. 6:17-cv-00343-RWS, the U.S. District Court for the Eastern District of Texas, Tyler Division, undertook a comprehensive analysis of the current law of design patent claim construction, and applied that law to construe the single claim of a U.S. design patent. Plaintiff HFA, Inc. had filed suit against Trinidad/Benham for infringing its U.S. Design Patent No. D713,196 (“the ‘196 Patent”) for “Nested Pans.” The claimed design for the nested pans is shown, for example in Figure 6:



Under U.S. patent law, a design patent is generally treated very differently from a utility patent. However, with respect to claim construction, both types of patents require a District Court to conduct claim construction proceedings before applying the patent claim(s) to the accused infringing product. A design patent generally protects the novel, non-functional aspects of a claimed ornamental design. The drawing figures of a design patent provide most of the disclosure of the claimed design, with the description of the design, if any, that is provided in the written specification providing the remainder. The drawings and the specification set forth the limits of the design claim, particularly between the features of the design that are claimed, and those that are unclaimed.

Although Federal District Courts in the U.S. have a duty to conduct claim construction proceedings in design patent cases, no particular format is proscribed by law, although such Courts have generally issued detailed verbal descriptions of the claimed design. However, the difficulty involved in describing a design in words has been acknowledged by the U.S. Court of Appeals for the Federal Circuit, which along with the U.S. Supreme Court determines the legal standards that will be applied by the District Courts to design patent cases. Consequently, the Federal Circuit has cautioned that there is a “risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”

However, the Federal Circuit has noted that a District Court can usefully guide a jury to the correct decision in a design patent infringement case by defining the scope of protection that is provided by the claimed design, such as by 1) describing the role that the broken lines shown in the drawings play in identifying features of the design that are not claimed; 2) assessing and describing the effect that arguments and amendments made during the course of prosecuting the design patent application may have on the scope of property rights that

are conveyed by the design patent; and 3) distinguishing between those features of the design claim which are ornamental (and therefore protected by the design patent) and those features which are purely functional (which are not protected).

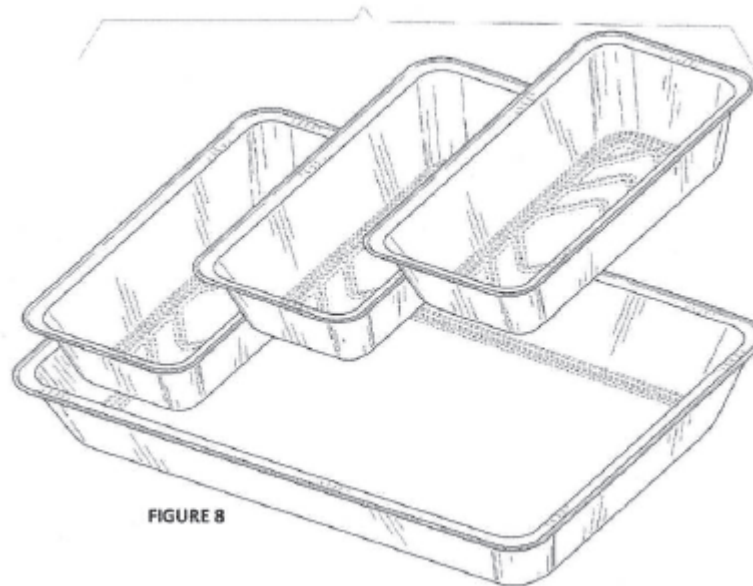
As the District Court in *HFA* acknowledged, in order to properly construe a design patent's claim, the focus should be placed on determining the overall ornamental impression created by the design, rather than the broader general design concept that the claimed design utilizes. When making this determination, purely functional aspects of the design cannot be claimed. However, features and elements of a design routinely perform a function which aids in the beneficial use of the design. With respect to those features and elements, the mere fact that they perform a function does not in itself disqualify them from design patent protection. They can still be claimed when they serve a primarily ornamental purpose, such as when there are several ornamental designs that could have been used to perform the same underlying function.

In *HFA*, the parties disputed the meaning of the design claim: "[t]he ornamental design for a nested pans, as shown and described." As the owner of the '196 Patent, HFA, argued that no construction of the design claim was necessary, since the ornamental design for the nested pans is clearly shown in the solid black full lines in the drawings which represent the claimed features and surfaces. By doing so, HFA was advocating for a broad interpretation of the '196 Patent so that it would readily apply to Trinidad/Benham's nesting pans.

By contrast, Trinidad/Benham contended that the design claim should be interpreted narrowly, so that "the pans have smooth sides and end walls" which did not cover its accused infringing pans. Trinidad/Benham also argued that since the design claim of the '196 Patent must be limited to its novel, non-functional ornamental aspects, the smaller 1/3-sized nested pans which fit within the larger pan must be excluded from the design claim because they are primarily functional, and not ornamental. Trinidad/Benham pointed to the fact that HFA has a utility patent application which covers this same nested pan design, which describes the 1/3-sized nested pans in a functional manner because they create stability and reduce accidents by the consumer. The prior art described this as a functional issue because smaller loaf pans that are placed in the bottom of a full-sized pan tended to wobble, so that more spills and injuries resulted. Trinidad/Benham also argued that the patented nested pans described in the '196 Patent are functional because HFA's advertising materials are sold under the trademark "TRU-FIT," which implies that their tight fit increases their rigidity, and hence their safety and functionality. Therefore, Trinidad/Benham argued that the District Court should construe the '196 Patent to *exclude* the shape, size and configuration of the nested pans from the design claim because they are purely functional aspects of the design.

The District Court addressed the parties' arguments by determining what aspects of the patented nested pans are functional, so that they should be excluded from the scope of the design claim. According to the Federal Circuit, when determining whether a design claim is dictated by function, the Court must consider several factors including: 1) whether the protected design represents the best design; 2) whether alternative designs would adversely affect the utility of the specified article; 3) whether there are any related utility patents; 4) whether the advertising emphasizes particular features of the design as having specific utility; and 5) whether there are any elements in the design or an overall appearance that is clearly not dictated by function.

Applying these factors to the facts of the '196 Patent, the District Court in *HFA* found that the nested pans are both functional and ornamental. The Court noted that the design claim includes the ornamental design for nested pans, as shown and described, and that the drawings figures of the '196 Patent do not depict the function of the pans, although certain drawings show the shape and size of the pans to demonstrate how they nest.



However, the District Court relied on the description of those nesting pans in the utility patent application to find that they serve a functional purpose. The utility patent described the shape and size of the nested pans as being important to their function of avoiding spills and injuries, including the height of the side walls, the inside angles of the pans and the dimensions of the short sizes of the pan. These features were also emphasized in the prosecution history of the utility patent application. The use of the “TRU-FIT” trademark by HFA further confirmed the importance of the size, shape and dimensions of the nested pans.

Although the District Court found that the nested pans serve a functional purpose, that fact did not require their exclusion from the design claim entirely, since they were also ornamental in nature. The District Court criticized Trinidad/Benham’s proposed claim interpretation because it would have eliminated the 1/3 sized smaller pans from the design claim. Instead, the District Court determined that the 1/3 nested pans should be limited to their ornamental aspects, as shown in the figures of the '196 Patent. The District Court noted that the '196 Patent does not cover the entirety of all types of nested pans, or even 1/3-sized nested pans, but is narrowly limited to the ornamental configuration of the pans as drawn in the figures, and does not include any functional aspects of the pans, as the court had described them. As a result, the District Court construed “the ornamental design for a nested pans, as shown and described” as “the ornamental design for a nested pans, as shown and described in Figures 1 to 14, excluding the elements shown in broken lines.”

In doing so, the District Court in *HFA* construed the design claim in a manner that is typical for design patent cases. Although the District Court acknowledged that some of the features of the nested pans have a functional purpose, they were not the only way to accomplish those functions. Therefore, the District Court

did not completely exclude those functional features from the design claim entirely, but instead limited them to the ornamental appearance that they are shown to have in the drawings. As a result, the District Court confirmed that the '196 Patent has little scope beyond the exact appearance of the nested pans that are shown in the drawings.

Consequently, parties that are accused of infringing a U.S. design patent would do well to find evidence that the features of the design that is claimed have substantial functional purposes. If they can do so successfully, they will likely be able to convince a District Court to narrow the scope of the design patent's claim so that it is restricted to the exact ornamental appearance of the design that is shown in the patent's drawing figures. Patent owners can defend against this argument by demonstrating that the features of their claimed design may perform the same functions, even if they had different designs.

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