

6 KEY TAKEAWAYS

Must-Knows in Design Patents for Patent Professionals and In-House Counsel

[Kilpatrick Townsend](#) Partners [Babak Kusha](#) and [Justin Eureka](#) recently presented “**Must-Knows in Design Patents for Patent Professionals and In-House Counsel**” at the firm’s [Kilpatrick Townsend Intellectual Property Seminar \(KTIPS\)](#). KTIPS is an intensive, two-day patent strategy and protection seminar designed to provide insightful and in-depth training related to current developments in patent law, and how those impact patent procurement and enforcement strategies.

Below are key takeaways from their presentation:

1

Domestic US Designs:

- Adjust the number of figures (e.g., perspective view) to aptly capture complex contours of a design being claimed – especially when you know you will be filing your design in a jurisdiction that does not allow shading (e.g., China).
- Weigh the pros/cons of filing multiple embodiments carefully – more embodiments may cover more scope but run a higher risk of drawing a restriction requirement, which may necessitate subsequent DIV applications.
- Avoid using photographs for a design patent – they are fraught with many pitfalls. If necessary for a last minute filing, file another application with properly formatted drawings as soon as possible. Though you may lose foreign priority, many foreign jurisdictions have a “grace” period, which leaves foreign filing options open in most of the major countries/regions even after a public disclosure.
- Go BIG with GUIs – there is a lot of white space out there and very broad GUI designs can be captured. Use dashed lines liberally.
- GUIs with highly data driven visualizations (e.g., stylistic graphs, charts, etc.) can be patented! What may seem like a narrow patent with unique, data-specific visualizations have two advantages – (1) they can be easier to get to allowance; and (2) allegedly infringing products can likely be loaded with data to create the same data-specific visualizations.
- Front load filings with formatting to accommodate all target jurisdictions – this will ensure a 1-to-1 match for later foreign filed applications for a clean priority chain. You can subsequently and immediately file a preliminary amendment to pare down the set of figures to only those needed for US prosecution. This should be done immediately to avoid examination and complex restriction requirements.

China Designs:

- China design patent term has increased from 10 years to 15 years from the date of filing.
- Protection for partial designs is now allowed! Dashed lines can now be used.
- NOTE: as of July 2022, no guidance has been provided to Chinese examiners on how to examine partial designs, so some push back and rejections may still occur during the transition.
- Chinese-filed designs can now claim domestic priority to earlier filed Chinese designs. This is akin to a CON application in the US, with a six-month, post-filing window.

2

3

Design Patent Considerations:

- IP creators should consider design patents as a way of extending their utility patent’s exclusive rights.
- IP creators should consider design patents as a way of extending their brand protection.
- Compared with Trade Dress: A design patent is not intended to identify source of goods.
- An applicant can secure design patent protection even if the design does not mean anything yet in the minds of your potential customer.
- An applicant can receive trade dress protection even if the design is not new.
- For certain types of products, such as product configurations and packaging, parallel track protection is recommended, to secure a combination of design patents, trade dress and copyrights.

Design Patent Advantages:

- Design patent protection offers advantages of lower cost and speed (no need to develop secondary meaning). However, to be entitled to design protection, the design must be new.
- Design patents promote the opportunity to develop distinctiveness / secondary meaning.
- Design patents do offer advantages for securing protection as compared to trademarks.
- Enforcement advantages as compared to trademarks or copyrights.

Enforcement Options – Short of Filing a Complaint:

- Platform–specific options (e.g., Amazon Procedure(s)).
- Platform-specific process, can involve various levels of analysis/evaluations/ outcome/appeals.
 - ◊ Typical to obtain less than consistent results
 - ◊ Eventually may have to: write letter to the infringer; also consider other supply chain actors
- Mapping and monitoring of IP rights for unauthorized copies.

Elements of a Good Notice Letter:

- Recipient: confirm who, where and how, email, mail, UPS, etc.
- Introduction: let them know who you are: attorneys representing _____.
- What the issue is: our client makes _____.
- Be specific with the notice: identify the product, the knock-off and the Patent No.
- Begin with assumption of positive intent.
- Be specific with the demands, be reasonable, be rational. e.g.:
 - ◊ Cease and desist from any and all infringing activity.
 - ◊ Identify the source of infringing products so that our client can address the issue with the supplier.
 - ◊ Dispose of related molds and any stock; and send evidence, such as pictures, of the disposal.
 - ◊ Within 15 business days, ship to _____ all stock of the products within your control and our client shall destroy all such stock.

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