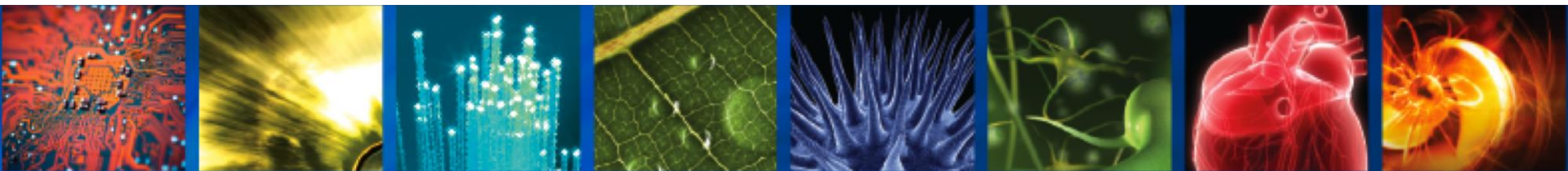


IP Impact: Design Patents

Mike Trenholm

Ali Razai

Terry Tullis



Palo Alto – November 6, 2014

Part I: Design Patent Overview

Apple vs. Samsung



Apple vs. Samsung



What is a Design Patent?

- **35 U.S.C. § 171: An Ornamental Design for an Article of Manufacture**
- For example:
 - Configuration, Shape, Surface Ornamentation
 - Only the Appearance, Not Structural or Utilitarian Features
- Original/Non-obvious

Differences Between Utility and Design Patents

- Patent Term
 - 14 years from Grant of Design Patent
 - HAGUE adoption to 15 years
- No Maintenance Fees
- Single Claim
- No Application Publication
- Foreign Filing within 6 months (vs 12 months for Utility)

Ins and Outs of the Specification

(12) **United States Design Patent** (10) **Patent No.:** **US D617,799 S**
Odhe et al. (45) **Date of Patent:** ** Jun. 15, 2010

(54) **SCANNER**
 (75) Inventors: **Lina Odhe**, Hovås (SE); **Cecilia Stöpp**, Mölndal (SE)
 (73) Assignee: **Nobel Biocare Services AG**, Zurich-Flughafen (CH)
 (**) Term: **14 Years**
 (21) Appl. No.: **29/340,882**
 (22) Filed: **Jul. 27, 2009**

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Primary Examiner—Susan Moon Le
 (74) *Attorney, Agent, or Firm*—Knobbe, Bear, LLP

(30) **Foreign Application Priority Data**
 Jan. 27, 2009 (EM) 001076509
 (51) **LOC (9) CL** **14-02**
 (52) **U.S. CL** **D14/420; D14/453**
 (58) **Field of Classification Search** D14/420, D14/426-430, 453, 346, 341, 347, 412; D13/107, D13/184; 358/473; 235/462.43, 462.45, 235/462.47, 462.48, 462.44, 462.46, 487, 235/472.01, 472.02; 16/110.1, 430, 431; 439/133, 135; 709/219, 201; 710/73; 320/114, 320/115, 123; 361/679; 382/313, 321; 455/575.1, 455/561, 572
 See application file for complete search history.

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 D308,865 S * 6/1990 Weaver et al. D14/429
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 D337,316 S * 7/1993 Ruiten D14/347

(57) **CLAIM**
 The ornamental design for a scanner, herein.

DESCRIPTION
 FIG. 1 is a top, front, and left side perspective of an embodiment of a scanner embodying my new design.
 FIG. 2 is a bottom, rear, and left perspective view of the embodiment of FIG. 1.
 FIG. 3 is a front elevation view of the embodiment of FIG. 1.
 FIG. 4 is a rear elevation view of the embodiment of FIG. 1, the left side being a mirror image.
 FIG. 5 is a right side view of the embodiment of FIG. 1, the left side being a mirror image.
 FIG. 6 is a top plan view of the embodiment of FIG. 1; and, FIG. 7 is a bottom plan view of the embodiment of FIG. 1. Elements shown in broken line are not claimed.

1 Claim, 7 Drawing Sheets

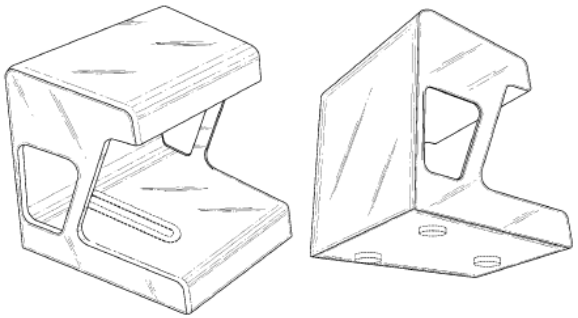
TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Be it known that I have invented a new, original, and ornamental design for a SCANNER, of which the following is a specification, reference being had to the accompanying drawings, forming a part thereof:

FEATURE DESCRIPTION

is a top, front, and left side perspective of an embodiment of a SCANNER new design.

- figure 2 is a bottom, rear, and left perspective view of the embodiment of Figure 1.
 - Figure 3 is a front elevation view of the embodiment of Figure 1.
 - Figure 4 is a rear elevation view of the embodiment of Figure 1.
 - Figure 5 is a right side view of the embodiment of Figure 1, the left side being a mirror image.
 - Figure 6 is a top plan view of the embodiment of Figure 1.
 - Figure 7 is a bottom plan view of the embodiment of Figure 1.
- Shown in phantom lines are feet and a slot which form no part of the claimed design.



Drawings

- 7 views

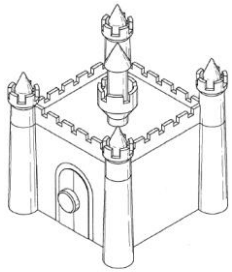


FIG. 1

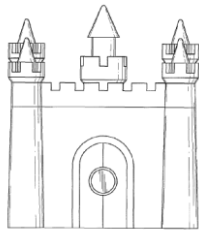


FIG. 2

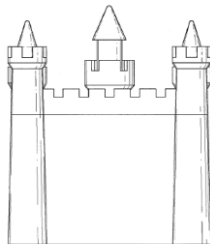


FIG. 3

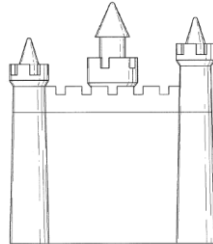


FIG. 4

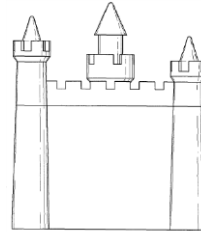


FIG. 5

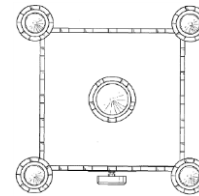


FIG. 6

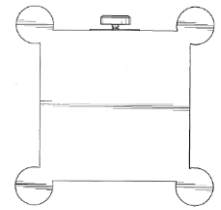


FIG. 7

Perspective

Front

Back

Right

Left

Top

Bottom

Side

Side

Example Subject Matter

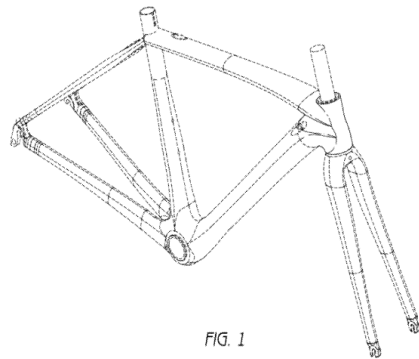
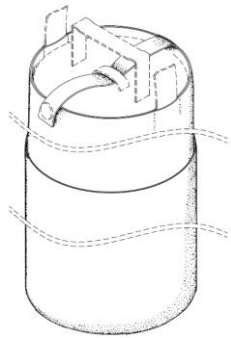


FIG. 1

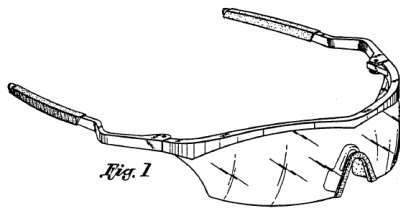
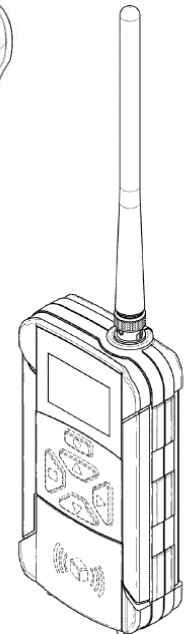
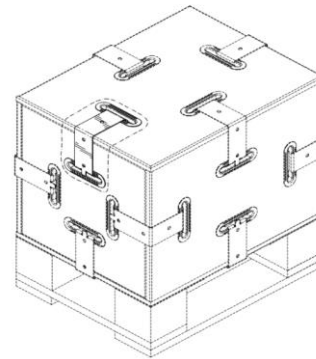
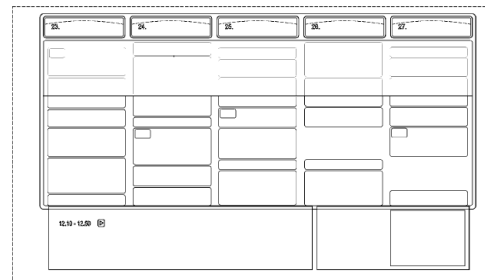
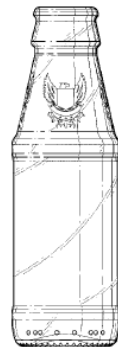


Fig. 1



Benefits & Weaknesses of Design Applications

- **Cost**
 - Relatively inexpensive compared to utility applications
 - No maintenance fees
- **Speed to issuance**
 - 50% issue within 12 months
 - Some as soon as 7 months
 - Expedited as fast as 2-4 months
 - Higher allowance rate than utility applications

Benefits & Weaknesses of Design Applications

- Patent Coverage
 - Deter wholesale copying & knock-offs
 - Overlapping protection with utility patents
- Largest Holders include:
 - Sony, Samsung, Nike, Goodyear, Motorola, P&G, Cannon, Black & Decker, Honda, Kohler

Benefits & Weaknesses of Design Applications

- Litigation
 - Infringement - Ordinary Observer test *Egyptian Goddess* (Fed. Cir. 2008).
 - With knowledge of the prior art
 - No need for written claim construction
 - Obviousness – Ordinary Designer test
 - Invalidity for Functional Limitations
 - Overall appearance “dictated by” utilitarian purpose of the article

Benefits & Weaknesses of Design Applications

- Damages
 - Reasonable Royalty, attorneys fees; or
 - Infringer's profits (35 U.S.C § 289)
 - Can be multiple parties profits
 - Not available to utility patents

Part II: Design Patent Strategies

What your Attorney Needs from You

- **Timing**
 - U.S. v. Foreign
- **Drawings or Actual Device**
- **Knowledge of key features of design**
- **Knowledge of features most likely to be copied/changed**
- **Your Careful Review of Application Prior to Filing**

I have a product, now what?

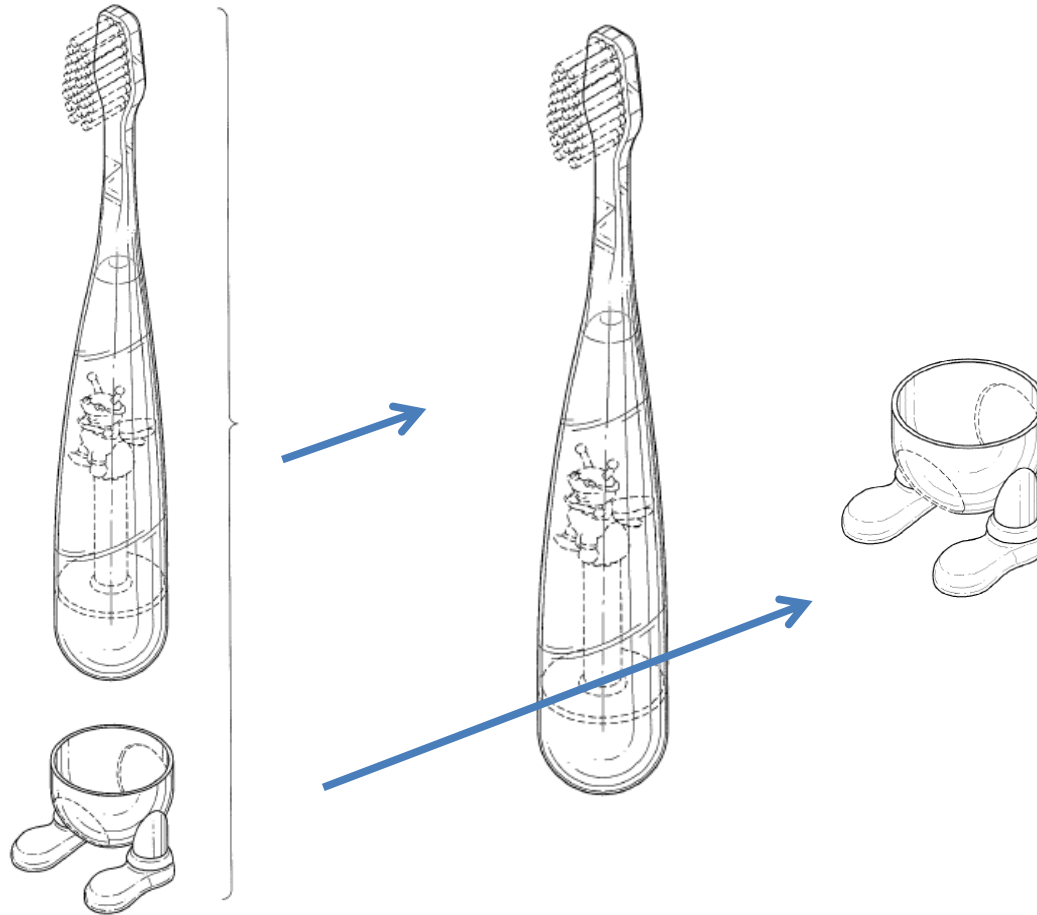


I have a product, now what?

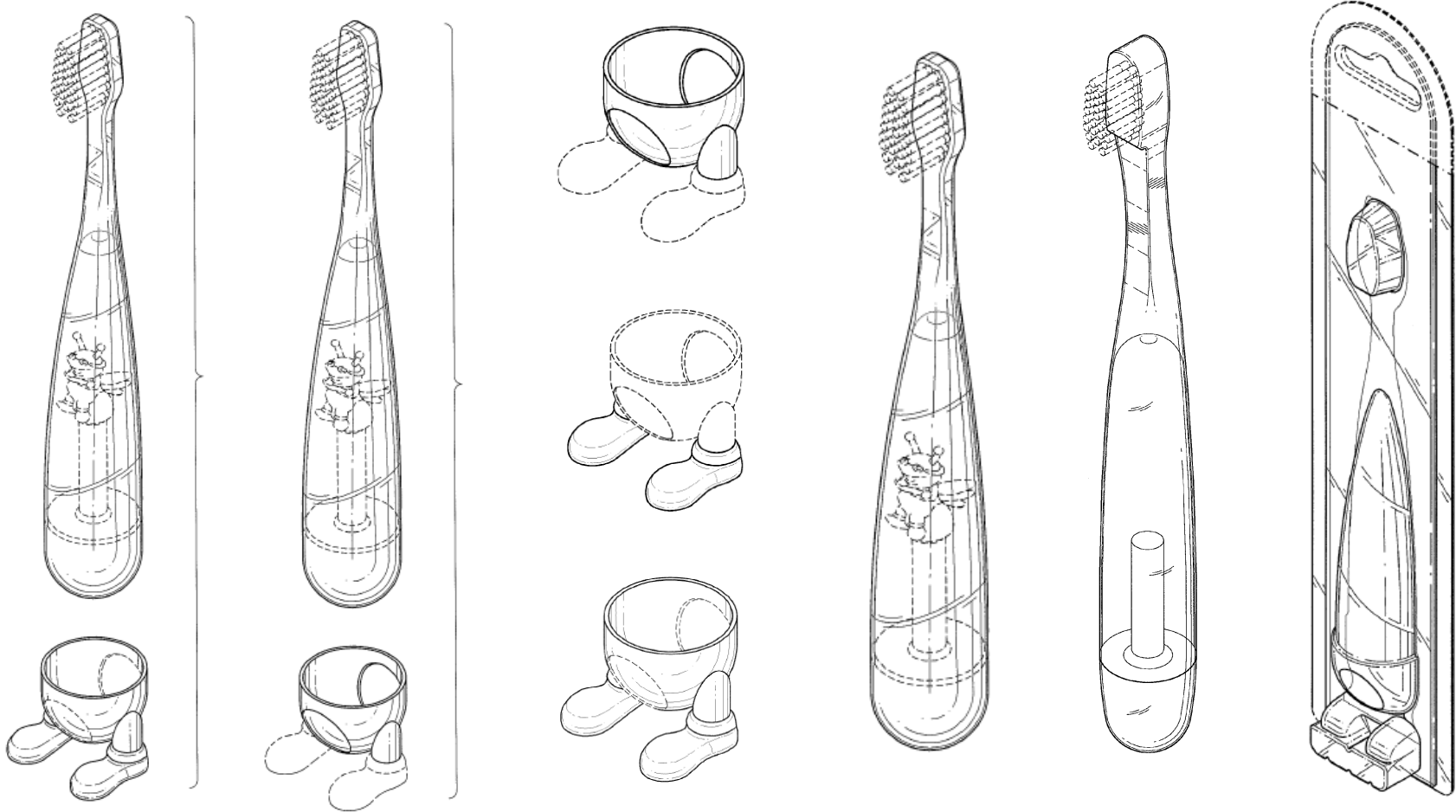
- Evaluate all areas of IP
 - Utility Patent
 - Trademark
 - Trade Secret
 - Copyright
 - Design Patent



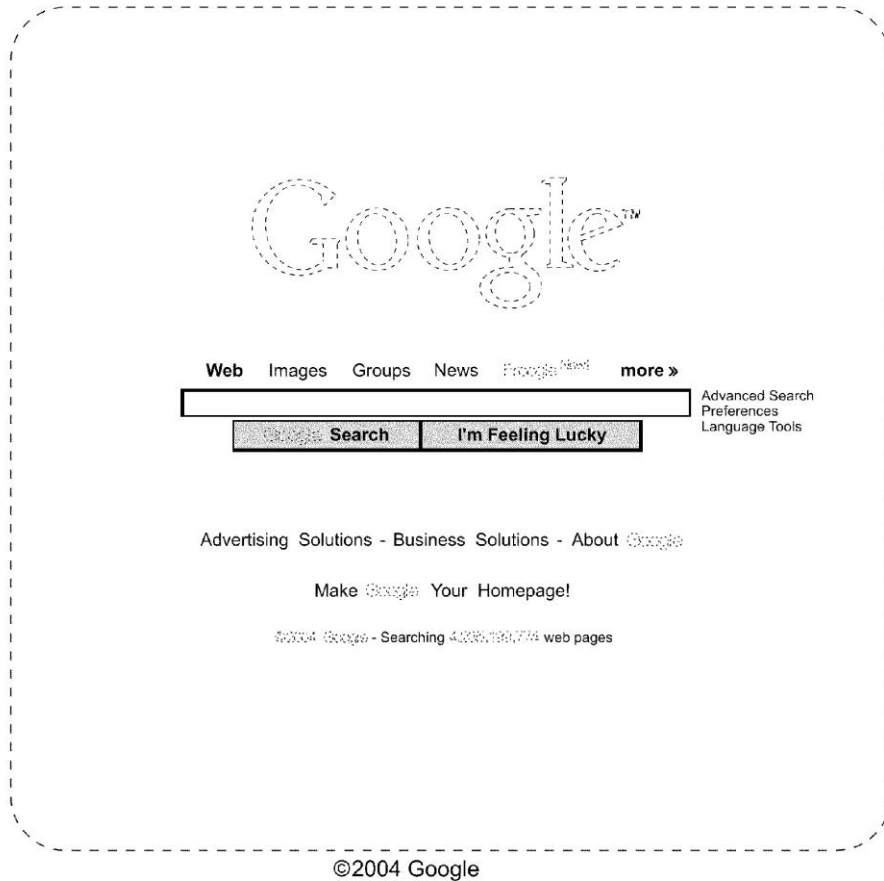
Design Patent Strategy



Design Patent Strategy

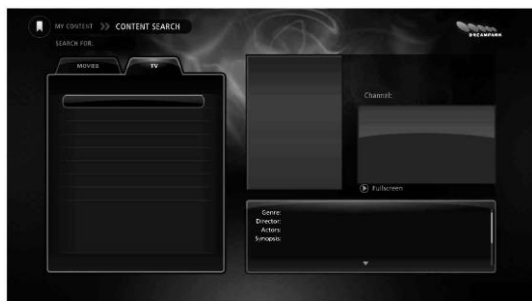


Webpage - D599,372

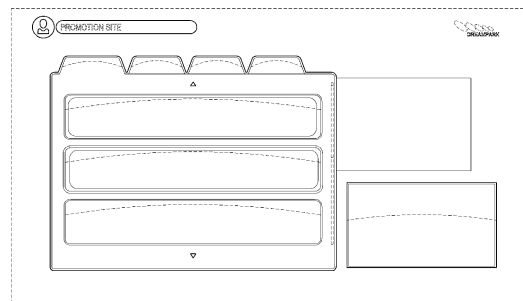
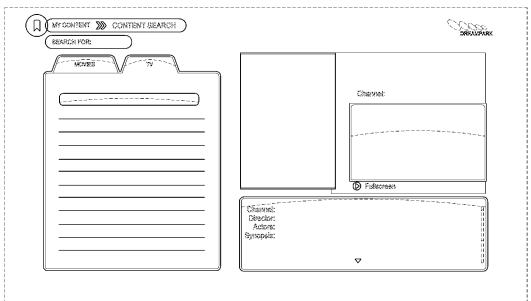
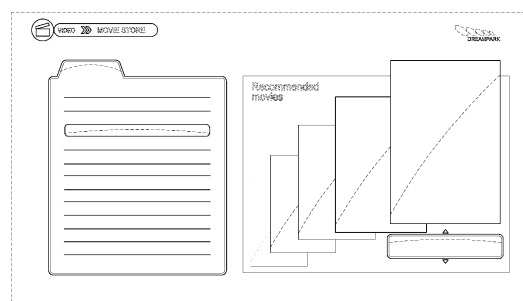
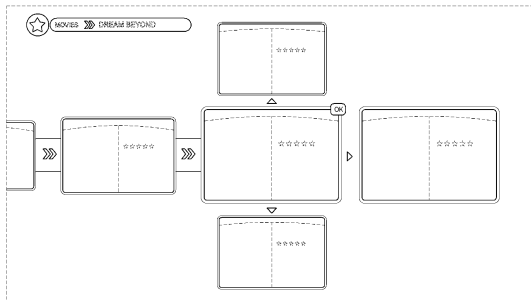
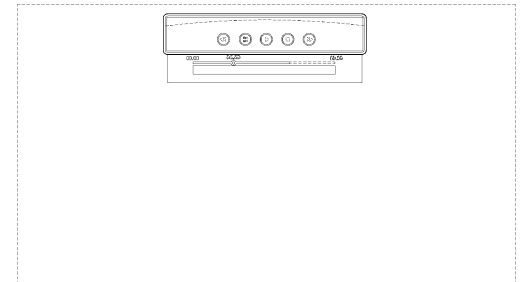
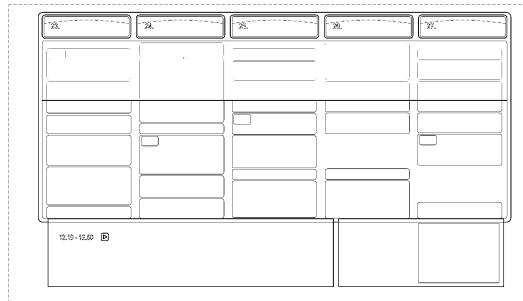
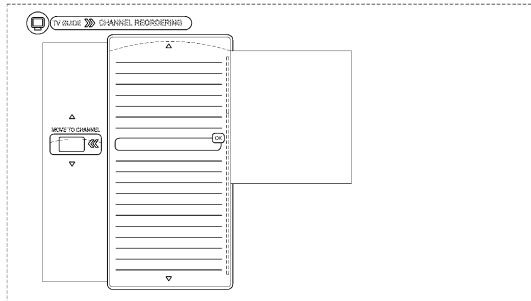


The single view is a front view of a graphical user interface for a display screen of a communications terminal.

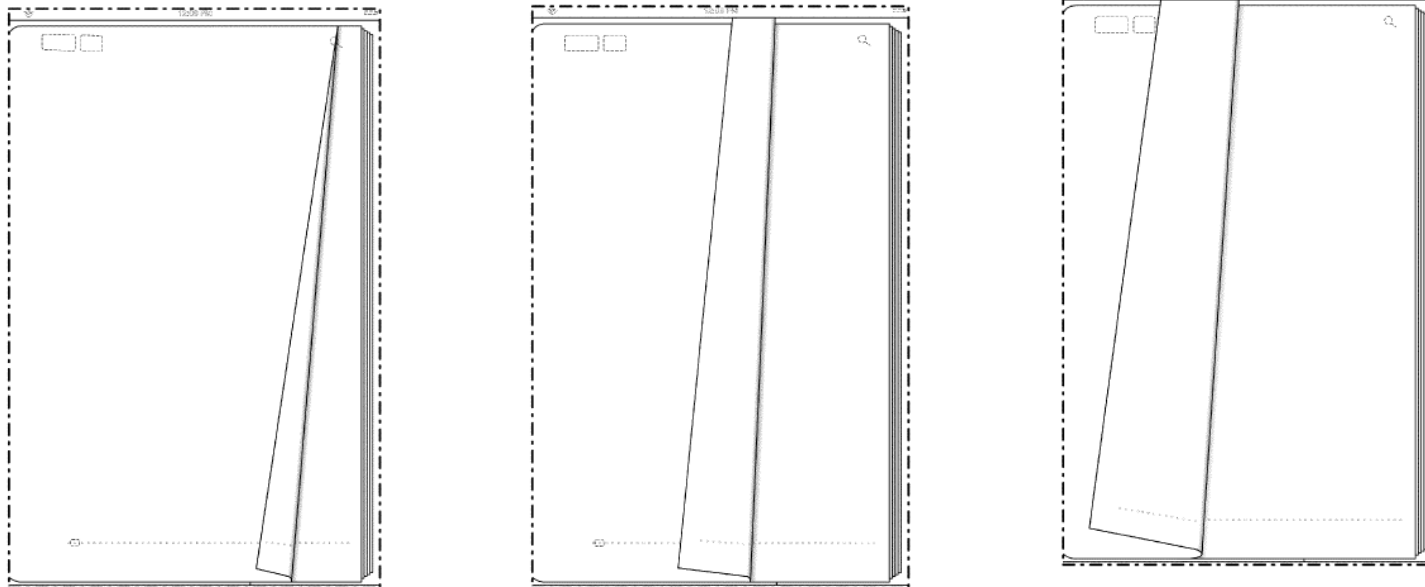
Webpage



Webpage



Moving Image – D670,713



The appearance of the animated images sequentially transitions between the images shown in FIGS. 1-3. The process or period in which one image transitions to another forms no part of the claimed design.

Contrast & Color - D652,165

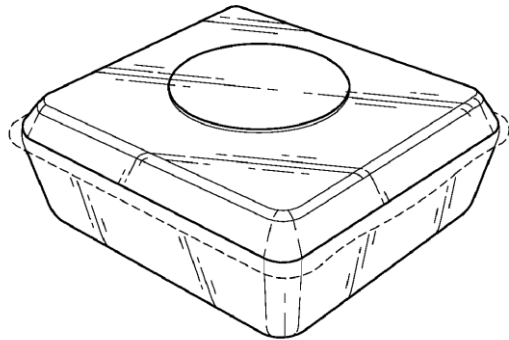


FIG. 1

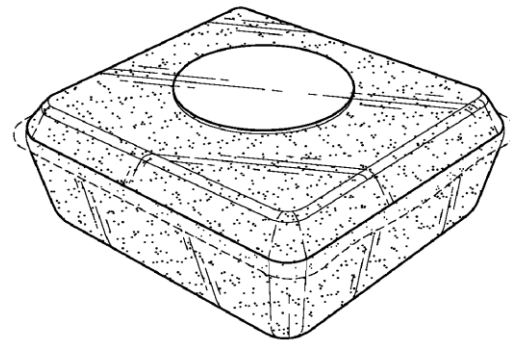


FIG. 6

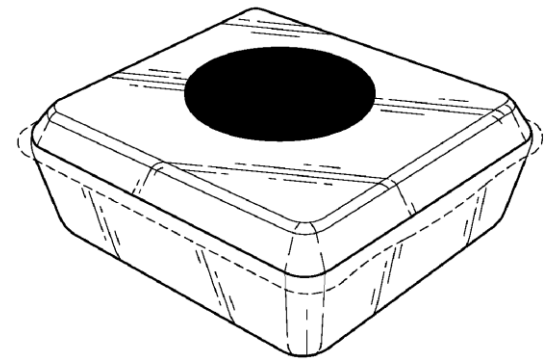


FIG. 11

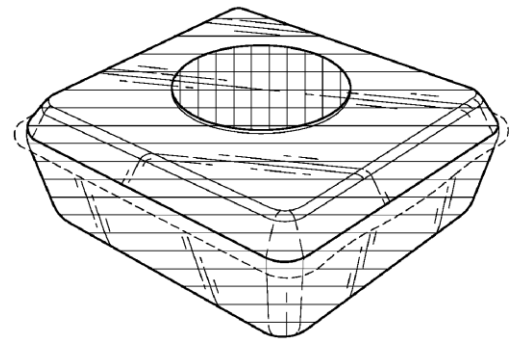
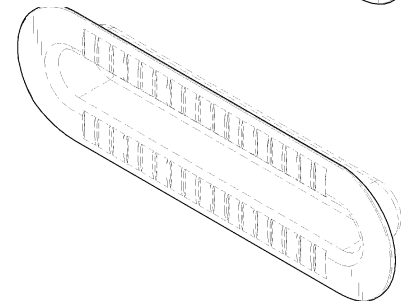
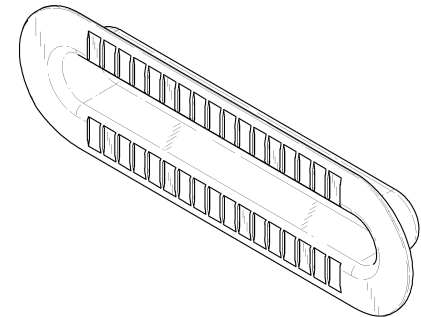
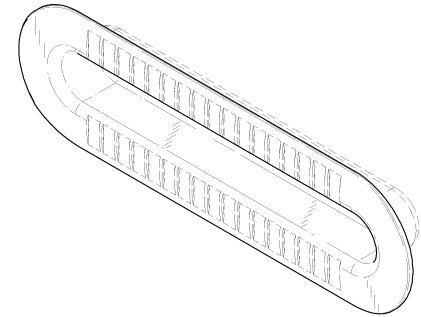
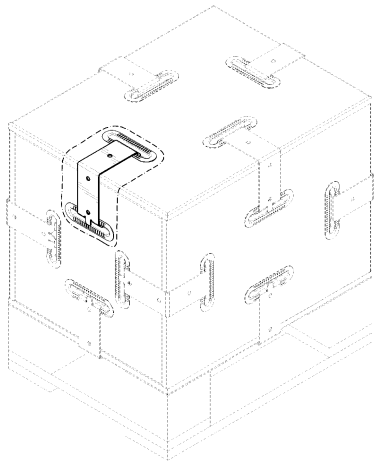
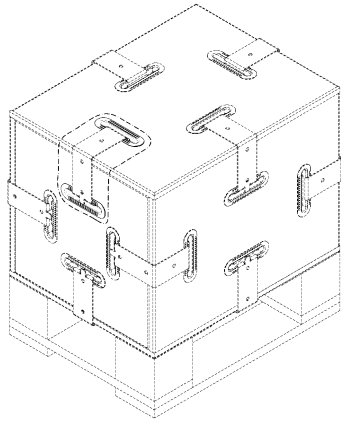


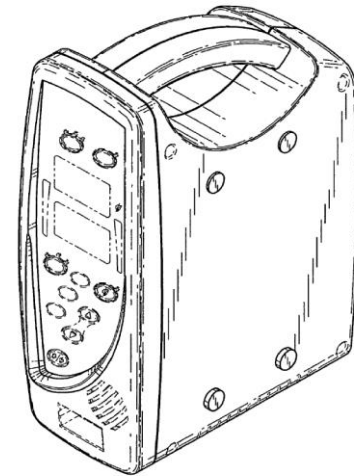
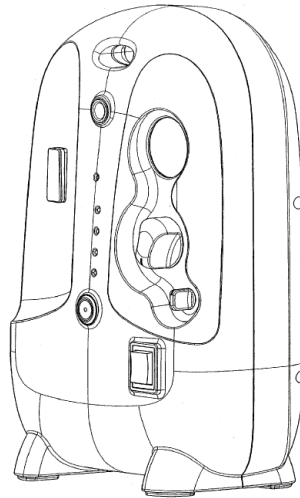
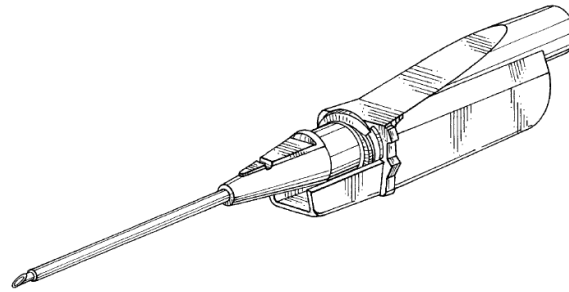
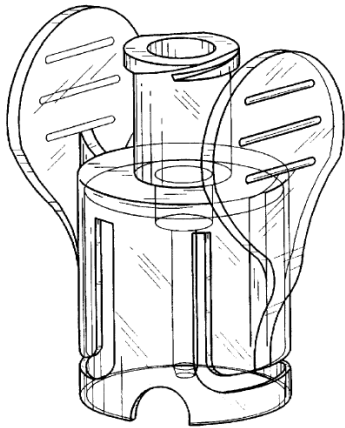
FIG. 16

FIG. 6 is a front, right side, and top side perspective view of an embodiment of a capsule containing washing products showing a circular insert of a first color and washing powder of a second color of the present design;

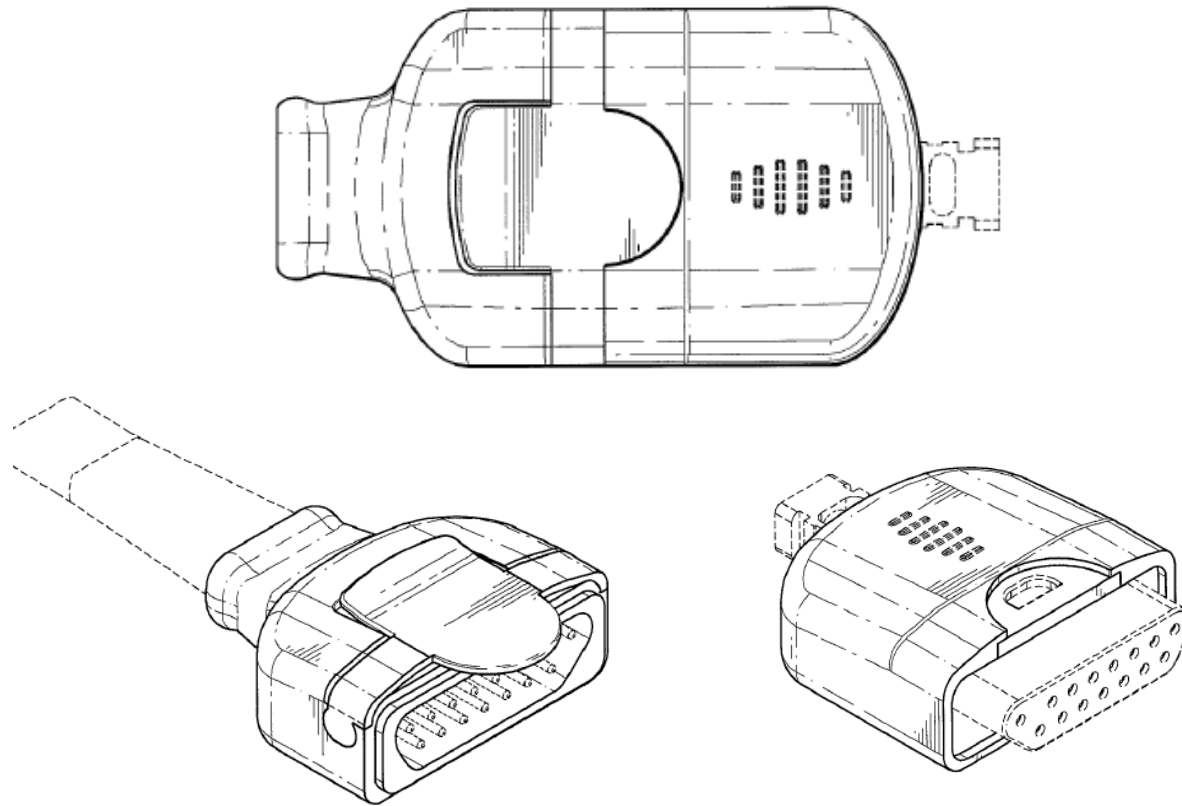
Overall Design & Parts



Medical Devices



Medical Devices



Part III: Design Patent Litigation

Types of Patents

- Patent: **prevent others** from making, using or selling invention.
 - Utility Patent
 - Design Patent

The Infusion Pump



The Accused Device



The Patented Product

Utility Patent Claim

1. A compact portable apparatus for dispensing a liquid under pressure at a substantially constant flow rate over a period of time comprising:
 - an elongated generally cylindrical support member;
 - elongated elastic sleeve means mounted and sealingly secured at fixed spaced longitudinal positions on said support member for defining a substantially zero non-pressurized volume pressure reservoir for holding a liquid in a pressurized state for dispensing therefrom;
 - housing means comprising collapsible non-stretchable housing means for containing said support member and said pressure reservoir for enabling said pressure reservoir to expand naturally and for confining said reservoir to fill concentrically about said support member;
 - inlet means for introducing a liquid into said elastic pressure reservoir; and
 - outlet means for dispensing liquid from said pressure reservoir to a selected site.

The Bed Extender

U.S. Patent Dec. 23, 1997 Sheet 1 of 4 5,700,047

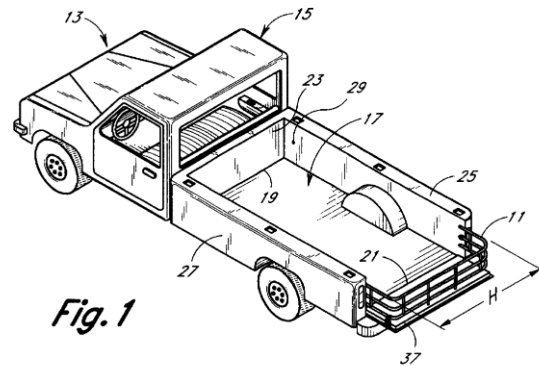


Fig. 1

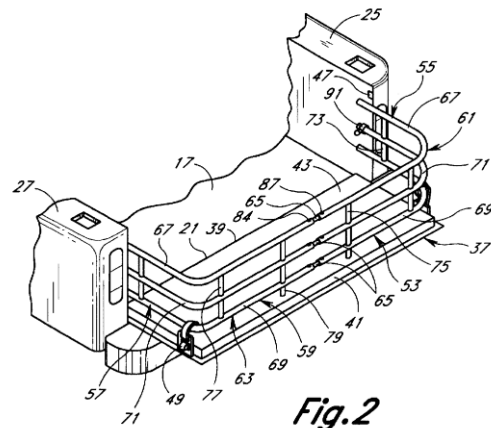


Fig. 2

Competitor's Product



Utility Patent Claim

20. A truck bed extender for use with a vehicle having an open storage bed having a rear end, a first upstanding side panel to one side of said bed, a second upstanding side panel to an opposite side of said bed and a tailgate, a first mounting station fixed with respect to said first upstanding panel defining a first station surface, a second mounting station fixed with respect to said second upstanding panel defining a second station surface, said apparatus comprising:

a first side wall;

a second side wall;

a connecting wall extending between said first side wall and said second side wall, said first side wall, said second side wall and said connecting wall cooperating to form a generally U-shaped frame;

a first mount secured to said first side wall comprising a first interlocking member defining a first pivot surface; and

a second mount secured to said second side wall comprising a second interlocking member defining a second pivot surface, said first station surface and said first pivot surface, and said second station surface and said second pivot surface cooperating to secure said apparatus to said vehicle so that said apparatus is rotatable about an axis between a first position wherein said connecting wall is in an upright position over said tailgate rearward of said rear end of said bed and a second position wherein said connecting wall is in an upright position spaced forward from said rear end of said bed, and wherein one of said first station surface and said first pivot surface defines a first opening through which the other of said first station surface and said first pivot surface can be manually withdrawn to disengage said extender from said first panel and one of said second station surface and said second pivot surface defines a second opening through which the other of said second station surface and said second pivot surface can be manually withdrawn to disengage said extender from said second panel, wherein said tailgate defines a latch to secure said tailgate to one of said first upstanding side and said second upstanding side, said truck bed extender further comprising at least one buckle secured to one of said walls, sized and shaped to be releasably captured by said latch of said tailgate.

Design Patent



US00D417859S

United States Patent [19]
Leitner et al.

[11] **Patent Number: Des. 417,859**
 [45] **Date of Patent: ** Dec. 21, 1999**

[54] **VEHICLE CARGO BED EXTENDER**
 [75] Inventors: **Horst Leitner**, Laguna Beach;
Jonathan E. Weisel, Norco, both of
 Calif.
 [73] Assignee: **American Moto Products, Inc.**,
 Laguna Hills, Calif.
 [**] Term: **14 Years**
 [21] Appl. No.: **29/083,594**
 [22] Filed: **Feb. 12, 1998**

4,419,794 12/1983 Horton, Jr. et al. .
 4,470,716 9/1984 Welch .
 4,472,639 9/1984 Bianchi .
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Primary Examiner—Doris V. Coles
Assistant Examiner—Stacia Sinuk
Attorney, Agent, or Firm—Knobbe, Martens, Olson & Bear,
 LLP

Related U.S. Application Data

[63] Continuation of application No. 08/924,230, Sep. 5, 1997,
 which is a continuation of application No. 08/651,921, May
 21, 1996, Pat. No. 5,700,047.

[51] **LOC (6) Cl.** **12-16**
 [52] **U.S. Cl.** **D12/414**
 [58] **Field of Search** D12/400, 401,
 D12/406, 412, 414, 98; 296/26-27, 37.6,
 50, 56, 57.1; 224/402-404, 492, 496, 314,
 493, 505-506, 572

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 D. 365,323 12/1995 Nagierkowski et al. D12/414
 1,242,035 10/1917 Pierson et al. .
 1,266,521 5/1918 Norquist .
 1,272,620 7/1918 Carlson .
 1,289,997 12/1918 Wyeth .
 1,655,777 1/1928 Weidland .
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 2,626,179 1/1953 Gonzalez .
 2,730,414 10/1955 Hart .
 2,795,863 6/1957 Turner .
 3,902,599 9/1975 Stromberg .
 4,023,850 5/1977 Tillery .
 4,136,905 1/1979 Morgan .

CLAIM

[57] The ornamental design for a vehicle cargo bed extender, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of vehicle cargo bed extender illustrating our new design. The vehicle is shown in phantom for illustration purposes only and forms no part of the claimed design.

FIG. 2 is an enlarged top plan view of the extender of FIG. 1.

FIG. 3 is an enlarged front elevational view of the extender of FIG. 1;

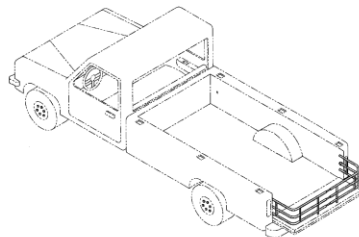
FIG. 4 is an enlarged right elevational view of the extender of FIG. 1. The left elevational view is a mirror image of the right elevational view;

FIG. 5 is an enlarged rear elevational view of the extender of FIG. 1; and,

FIG. 6 is an enlarged bottom plan view of the extender of FIG. 1.

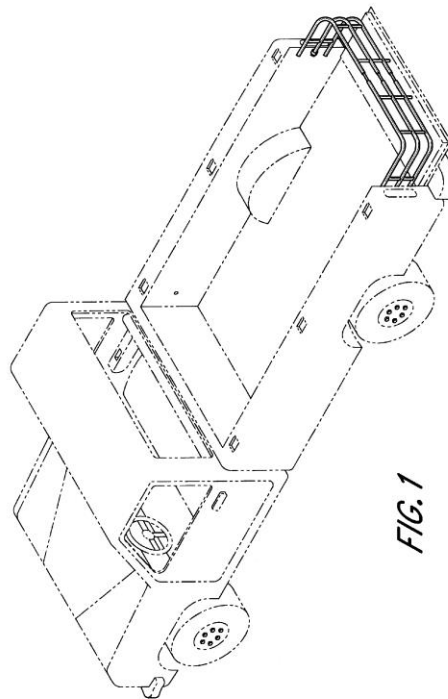
The broken line showing of environment in FIGS. 2-6 is for illustrative purposes only and forms no part of the claimed design.

1 Claim, 3 Drawing Sheets



Design Patent Claim

U.S. Patent Dec. 21, 1999 Sheet 1 of 3 Des. 417,859



Ordinary Observer Test

“If in the eye of an ordinary observer, given such attention as a purchaser usually gives, two designs are substantially the same . . . the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.”

Utility Patent Infringement



20. A truck bed extender for use with a vehicle having an open storage bed having a rear end, a first upstanding side panel to one side of said bed, a second upstanding side panel to an opposite side of said bed and a tailgate, a first mounting station fixed with respect to said first upstanding panel defining a first station surface, a second mounting station fixed with respect to said second upstanding panel defining a second station surface, said apparatus comprising:

a first side wall;

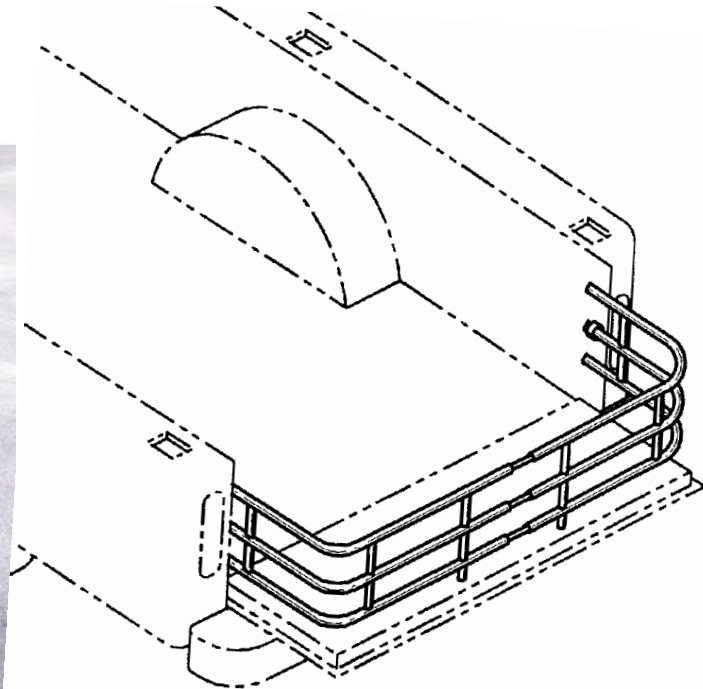
a second side wall;

a connecting wall extending between said first side wall and said second side wall, said first side wall, said second side wall and said connecting wall cooperating to form a generally U-shaped frame;

a first mount secured to said first side wall comprising a first interlocking member defining a first pivot surface; and

a second mount secured to said second side wall comprising a second interlocking member defining a second pivot surface, said first station surface and said first pivot surface, and said second station surface and said second pivot surface cooperating to secure said apparatus to said vehicle so that said apparatus is rotatable about an axis between a first position wherein said connecting wall is in an upright position over said tailgate rearward of said rear end of said bed and a second position wherein said connecting wall is in an upright position spaced forward from said rear end of said bed, and wherein one of said first station surface and said first pivot surface defines a first opening through which the other of said first station surface and said first pivot surface can be manually withdrawn to disengage said extender from said first panel and one of said second station surface and said second pivot surface defines a second opening through which the other of said second station surface and said second pivot surface can be manually withdrawn to disengage said extender from said second panel, wherein said tailgate defines a latch to secure said tailgate to one of said first upstanding side and said second upstanding side, said truck bed extender further comprising at least one buckle secured to one of said walls, sized and shaped to be releasably captured by said latch of said tailgate.

Design Patent Infringement



Comparison

Utility Patent

- Expensive to get
- Claim Construction
- Complicated Local Patent Rules
- Summary Judgment
- Difficult to Prove Damages

Design Patent

- Cheap to get
- Often No Claim Construction
- Usually No Local Patent Rules
- Summary Judgment More Difficult
- Disgorgement of Profits—even if you're an NPE
- Easier to design around

Damages for Patent Infringement

- **Lost profits**
- **Disgorgement of profits (only design patents)**
- **Reasonable royalty**
- **Treble Damages**

Damages for Patent Infringement

35 U.S.C. § 284

damages adequate to compensate for the infringement, but in no event less than a ***reasonable royalty*** for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

... the court ***may increase the damages up to three times*** the amount found or assessed

Additional Remedy Available for Design Patent Infringement

35 U.S.C. § 289

... shall be liable to the owner to the extent of his ***total profit***, but not less than \$250

Disgorgement of total profits under Section 289 cannot be trebled

Attorneys' Fees For Patent Infringement

35 U.S.C. § 285

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Oakley Example



Accused Product



U.S. Pat. No. D564,571

Thank You!

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Orange County



San Diego



San Francisco



Silicon Valley



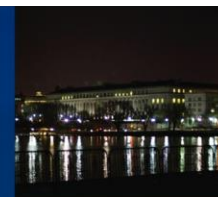
Los Angeles



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