

# A global guide to design protection

*Managing IP* magazine asked correspondents in six jurisdictions to provide the information you need to protect your design rights

## United States

### 1. Protection

The primary form of protection for designs of most articles of manufacture in the US is a design patent. An applicant files design patent applications with the USPTO. Applications may be filed by suitable post, by hand delivery, or electronically via a web interface. The USPTO does not have a registration process but substantively examines the design patent applications. Supplemental protection akin to a registration process is available for boat hull and semiconductor designs based on copyright law.

Other than copyright, there is no specific protection against copying of unregistered designs. However, designs that have acquired distinctiveness may be entitled to trade mark/trade dress protection.

US design patents have a term of fourteen 14 years measured from the date of issuance of the design patent. No annuities or renewal payments are required during the term of protection.

US design patents cover ornamental appearances for articles of manufacture, not the underlying articles of manufacture. Nonetheless, each design patent/applicant includes a title. To be granted and to uphold a validity challenge, the design needs to be novel and non-obvious with respect to the prior art. To meet the novelty requirement, the design needs to be new in view of all prior art regardless of whether the prior art design is intended for a different type of article. To meet the non-obviousness requirement, the prior art should be directed to the same or an analogous type of article.

The statute merely requires the design be directed to an article of manufacture. This requirement has been broadly interpreted. By judicial interpretation, it also covers portions of articles of manufacture. Icons and graphical user interfaces cannot be protected as artwork in isolation, but can be protected as surface ornamentation for display screens. In one case, the appearance of fixed path formations of water in a water fountain was protected under the design laws. Packaging can be protected too as long as the package is an article of manufacture. Many industries such as the consumer electronics industry, the automotive industry, the furniture industry, and the toy industry and many other industries rely heavily on the design patent system.

### 2. Examination criteria

The USPTO substantively examines design patent applications for (a) drawing disclosure sufficiency and (b) for novelty and non-obviousness in view of the prior art. The design examiner of the USPTO ensures that the design disclosure be enabled and definite from the view point of one of ordinary skill in the art. Rejections by the USPTO are common if the drawings are inconsistent or unclear or if the scope of the design is ambiguous. Amendments may be done after filing but no new matter may be added to the design that one of ordinary skill in the art would not recognize would be present in the originally filed application.

As part of the examiner's examination of the design claim for

novelty and non-obviousness, the examiner will undertake a search of the prior art. For a proper anticipation rejection, a single reference must show the same design. Extremely minor variances between the applicant's design and the prior art are not usually enough to overcome an anticipation rejection.

Obviousness in a design patent analysis is similar in concept to obviousness in a utility patent analysis. It takes into account: (a) the scope and content of the prior art, (b) the differences between the prior art and the claim, (c) the level of ordinary skill in the art, and (d) secondary considerations (such as commercial success and copying). Against these factual determinations, the ultimate test is whether the claimed design would have been obvious to a designer with ordinary skill in the art of designing articles of the type claimed.

### 3. Court decisions

The most important design patent decision in the last 20 years was rendered in September 2008 in *Egyptian Goddess v Swisa* by the Court of Appeals for the Federal Circuit, *en banc*.

Since 1984, a design patentee had to prove that two distinct tests were satisfied in order to establish infringement. The first test, commonly referred to as the ordinary observer test or the Gorham test, weighs whether the two designs at issue are substantially the same to the extent that an ordinary observer is induced to purchase the accused one supposing it to be the other one. Second, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art. This test was commonly referred to as the "point of novelty" test. In many situations, the test was difficult to apply and was cited by many as evidence of a weakened design patent system in the US as many similar articles escaped infringement because of the presence of this test. The full panel of justices in *Egyptian Goddess* held that the point of novelty test should no longer be used in the analysis for determining design patent infringement. In support of its decision, the Federal Circuit noted that the point of novelty test as a separate requirement is inconsistent with the ordinary observer test laid down in *Gorham*, is not mandated precedent, and is not needed to protect against unduly broad assertions of design patent rights. The Federal Circuit also indicated that it is permissible under the Gorham test to compare the patented design and the accused design in the context of similar designs found in the prior art.

*Egyptian Goddess* was also important with respect to the issue of design patent claim construction. Previous Federal Circuit decisions required a verbalization of the design patent drawings as part of the infringement analysis. In *Egyptian Goddess*, the Federal Circuit noted the difficulties in trying to describe a design patent claim in words, and indicated that the preferable course ordinarily should be for a district court not to attempt to construe a design patent by providing a detailed verbal description of the claimed design. However, the ultimate decision on whether to perform such a verbalization was left to the discretion of the trial judges.

### 4. Improvements

In my personal opinion, there are some areas of design law that can be better clarified. Additionally, some of the design patent laws were construed primarily as an extension of the utility patent laws, and some of the laws can be made to better reflect the essences of designs.



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