Design Patent Claim Construction: Written Description, Ornamentality, Functionality and More
Drafting Claims to Withstand Scrutiny and Avoiding Claim Limitation Attack

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DESIGN PATENT CLAIM
CONSTRUCTION

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Design patent claim construction

1. General considerations and history of design claim construction.

2. Ornamentality vs. functionality.

3. Other claim interpretation issues.
Design patent claim construction

1. General considerations and history of design claim construction.
   1. Brief design patent history
   2. What changed and why?
   3. Risks of verbalizing design claim vs. when it is appropriate.

2. Ornamentality vs. functionality.

3. Other claim interpretation issues.
Statutory basis: 35 U.S.C. § 171

• Available for new, original, and ornamental design for an article of manufacture.

• Provisions of title relating to utility patents also apply to patents for designs, except as otherwise provided.

  • (aka except for functionality issue; infringement standard; obviousness analysis; and availability of infringers’ profits).
George Bruce’s Font: D’l

George Bruce — New York.
Silver Patent No. 1, Dated November 9 1842.

I claim a series of Border Pieces of the sign called, in the printed impressions, Double Ries, and numbered 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26.
1995: Markman applies to design patents

- *Immediately* after Markman decision, CAFC confirms it also applies to design patents:

- “Determining whether a design patent claim has been infringed requires, first, **as with utility patents**, that the claim be properly construed to determine its meaning and scope.”
But what does that mean?

How were courts to construe designs into words, and with how much detail?
Well before Markman was Dobson

• Design “better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration.”
  • Dobson v. Dornan, 118 U.S. 10, 14 (1886).

• Dobson not claim construction case.

• But CAFC repeatedly cites Dobson for this proposition.
**Elmer construction – short, high level**

• *Elmer* court – again, right after Markman – kept construction high level.

• Design shown and described is sign that includes, *inter alia*, triangular vertical ribs and an upper protrusion. So claim is limited to that.
  • *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995)
OddzOn – Constructions get longer

• “[A] ball shaped like a football, with a slender, straight tailshaft projecting from the rear of the football. In addition, the [] design has three fins symmetrically arranged around the tailshaft, each of which has a gentle curve up and outward which creates a fin with a larger surface area at the end furthest from the ball. The fins flare outwardly along the entire length of the tailshaft, with the front end of the fin extending slightly up along the side of the football so that the fins seemingly protrude from the inside of the football.”

  • OddzOn Prods. v. Just Toys, 122 F.3d 1396, 1400 (Fed. Cir. 1997)
**Egyptian Goddess – Constructions reach their peak**

- “A hollow tubular frame of generally square cross section, where the square has sides of length S, the frame has a length of approximately 3S, and the frame has a thickness of approximately T=0.1S; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately 1.25T, and the inner corner of the cross section rounded on a 90 degree radius of approximately 0.25T; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.”
Federal Circuit asks for briefing

• Federal Circuit asks for briefing on issue in *Egyptian Goddess* en banc order:

  • “Should claim construction apply to design patents, and, if so, what role should that construction play in the infringement analysis? *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).”
    • November 26, 2007, Order (*Egyptian Goddess, Inc. v. Swisa, Inc.* (Fed. Cir. Case No. 2006-1562)).

• Flood of *amicus* briefs filed on topic.
Egyptian Goddess court on rehearing

• *Markman* applies, but it does not direct a detailed verbal analysis of design patent claims.

• Language reminiscent of *Dobson*:

  • “Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.”
    • *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (*en banc*)
Egyptian Goddess: Risks of claim construction

• Risks of verbal constructions (straight from *Egyptian Goddess*):

  • Undue emphasis on particular features of the design.

  • Finder of fact may focus on each described feature rather than on design as whole.

  • *Egyptian Goddess*, 543 F.3d at 679-80.
Crocs court reiterates risks

• Here is the design (Figure 1, that is):
Crocs court reiterates risks

• And here is the ALJ construction:

  • “[F]ootwear having a foot opening with a strap that may or may not include any patterning, is attached to the body of the footwear by two round connectors, is of uniform width between the two round connectors, has a wrench-head like shape at the point of attachment, and extends to the heel of the shoe; with round holes on the roof of the upper placed in a systematic pattern; with trapezoid-shaped holes evenly spaced around the sidewall of the upper including the front portion; with a relatively flat sole (except for upward curvature in the toe and heel) that may or may not contain tread on the upper and lower portions of the sole, but if tread exists, does not cover the entire sole, and scalloped indentations that extend from the side of the sole in the middle portion that curve toward each other.”

  • *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1301 (Fed. Cir. 2010) (quoting Initial Determination on Violation of Section 1337)
Crocs court reiterates risks

• Federal Circuit rejects construction.

• “[S]hows dangers of reliance” on detailed construction, focusing on particular features and leading ALJ and Commission “away from consideration of the design as a whole.”

• “Without a view to the design as a whole, the Commission used minor differences between the patented design and the accused products to prevent a finding of infringement.”
  • Crocs, 598 F.3d at 1303
Crocs side by side comparison
“Words cannot easily describe ornamental designs. A design patent’s claim is thus often better represented by illustrations than a written claim construction.”

- Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1321 (Fed. Cir. 2016)

- BUT court may use claim construction to help guide fact finder through issues that bear on claim scope.

- For example, distinguishing between features of the claimed design that are ornamental and those that are purely functional.
Litigation takeaways

• Design patents claim designs, not designs as converted to list of technical elements that feels like utility patent checklist.

• Construction useful for specific questions bearing on claim scope:
  • Functionality
  • Disclaimed material (e.g., presence of dotted lines)
  • Drawing conventions that may not make sense to fact-finder (e.g., oblique shade lines to represent transparent or shiny surfaces)

• General efforts to translate design into words independent of above goals less likely to be successful, especially with extensive detail. Even if you persuade trial court or ALJ to construe as requested, that victory could be in jeopardy.
Design Patents & Functionality

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Overall Appearance Is What Matters
Not any underlying functional attributes

- Any “Swivel-ability” of Stool Does Not Matter.
- Overall Appearance of Stool Does Matter.
Designs Do Not Protect General Ideas or Concepts

Design Right
Designs Do Not Protect General Ideas or Concepts

Design Right

Accused Design

Albeit Same Idea, No Design Infringement
Two Separate “Functionality” Issues

Issue 1: Statutory Compliance
Is the Design Eligible for Design Protection?
Two Separate “Functionality” Issues

**Issue 1: Statutory Compliance**
Is the Design Eligible for Design Protection?

**Issue 2: Claim Construction**
Are Any Aspects of the Appearance To Be Disregarded?
Issue 1: Statutory Compliance

Is the Overall Design Eligible for Design Protection?
35 U.S.C. § 171, Design Patents
“Whoever invents any new, original and {ornamental} design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”

35 U.S.C. § 101, Utility Patents
“Whoever invents or discovers any new and {useful} process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”
What Qualifies as “Ornamental?”  
35 U.S.C. § 171

Bonito Boats (1989)

“To qualify for protection, a design must present an …appearance that is not dictated by function alone, and must satisfy the other criteria of patentability.”


Operative question: Are there alternative designs?
Fed. Cir.:
“We have often focused … on the availability of alternative designs as an important—if not dispositive—factor in evaluating the legal functionality of a claimed design.”

* * *

“To be considered an alternative, the alternative design must simply provide the same or similar functional capabilities.”

Ethicon v. Covidien
(Fed. Cir. 2015)
Issue 1: Statutory Compliance

Example 1
Issue 1: Statutory Compliance

Example 1

Example 2
Issue 1: Statutory Compliance

Example 1

Example 2

Example 3
**5-Factor Test**

1) Is the design the “best design?”
2) Would alternative designs adversely affect article’s utility?
3) Any concomitant utility patents?
4) Any advertising touting utility of particular features of the design?
5) Any elements in the design or an overall appearance clearly not dictated by function?
D.Ct.: Defendant failed to show by clear and convincing evidence that midsole/periphery is dictated solely by function.
Issue 2: Claim Construction

Are Any Aspects of the Appearance of the Overall Design Disregarded?
Two Separate “Functionality” Issues

**Issue 1: Statutory Compliance**
Is the Design Eligible for Design Protection?

**Issue 2: Claim Construction**
Are Any Aspects of Appearance To Be Disregarded?
**Elmer v. ICC Fabricating, Inc.,**
67 F. 3d 1571 (Fed. Cir. 1995)(J.Lourie)

**Holding:** “Support ribs” and “protrusion” are functional, but part of the Claimed Design. Their inclusion in solid lines in claimed design limits scope of protection.
But see, *Oddzon Prods., Inc. v. Just Toys, Inc.* 122 F. 3d 1396 (Fed. Cir. 1997) (J. Lourie)

Holding: Tail and fins are “dictated solely by function” and are thus **not part of claimed design.**
“Richardson's multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose.”
“Divide and Conquer”?  

Claim Construction  

“Discount,” “Ignore,” “Factor out,” these features
“Divide and Conquer”?
“Divide and Conquer”?  

1. hammer-head  
2. jaw  
3. handle  
4. crow-bar
Claim Construction = Claim Destruction
Apple Design Patent

rounded corners

rectangular shape

Apple, Inc. v. Samsung Elecs. Co.,
786 F.3d 983 (Fed. Cir., May 18, 2015)(J.Prost)
Apple, Inc. v. Samsung Elecs. Co.,
786 F.3d 983 (Fed. Cir., May 18, 2015)(J.Prost)

Fed. Cir.: “Richardson did not establish a rule to eliminate entire structural elements from the claim scope as Samsung argues.”

Apple Design Patent
Apple Court: “The claim construction included the ornamental aspects of the components:

‘(i) the standard shape of the hammer-head,
(ii) the diamond-shaped flare of the crow bar and the top of the jaw,
(iii) the rounded neck,
(iv) the orientation of the crow bar relative to the head of the tool, and
(v) the plain, undecorated handle.””
Ethicon v. Covidien,
796 F.3d 1312 (Fed. Cir., Aug. 7, 2015)(J.Chen)
Ethicon v. Covidien,
796 F.3d 1312 (Fed. Cir., Aug. 7, 2015)(J.Chen)

Fed.Cir.: “We agree that the trigger, torque knob, and activation button elements of the underlying article have functional aspects. **But the district court's construction of the Design Patents to have no scope whatsoever fails to account for the particular ornamentation of the claimed design and departs from our established legal framework for interpreting design patent claims.”**
Sport Dimension v. Coleman Co.,
820 F.3d 1316 (Fed. Cir. April 19, 2016)(J.Stoll)
FED CIR: “The district court eliminated the armbands and side torso tapering from the claim entirely, so its construction runs contrary to our law.”
Claim Construction: The ornamental design for an apparatus for holding and heating a hot pot, excluding the functional aspects of
  1. the frustoconical bowl and the prongs around the rim, and
  2. openings to allow airflow.
Junker v. Med. Components,

D.Ct.:
“Is the ‘hub’ purely functional, and thus non-protectable?”

“District courts must be careful not to eliminate whole aspects of a claimed design…” (citing Sport Dimension)
Scope of Protection
Overall Appearance as Depicted in Drawings

Applicant’s Design Choices and Selection:

- Specific Key Handle
- Specific Key Blade
- Aspect Ratio
- Orientation
- Positioning

MORE
“A design patent only protects the:

(1) novel, and

(2) ornamental

features of the patented design.”

overall appearance of the design as depicted in the drawings; it does not protect functional qualities or general design concepts.”
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Christopher V. Carani, Esq. is a partner and shareholder at the intellectual property law firm of McAndrews, Held & Malloy, Ltd. based in Chicago, Illinois. He is a leading voice in the field of design law. Chris counsels clients on a wide range of strategic design protection and enforcement issues, both in the U.S. and abroad. He is often called upon to render infringement, validity and design-around opinions and serve as a legal consultant/expert in design law cases.

Chris is the current chair of AIPPI Committee on Designs. He is immediate past chair of the American Bar Association’s Design Rights Committee, and is the past chair of the American Intellectual Property Law Association (AIPLA) Committee on Industrial Designs. In the landmark design patent case Egyptian Goddess v. Swisa, he authored amicus briefs on behalf of the AIPLA at both the petition and en banc stages. In 2009 and 2011-12, he was an invited speaker at the United States Patent & Trademark Office’s (“USPTO”) Design Day.

Prior to joining McAndrews, Chris served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Chris was conferred his Juris Doctorate from The Law School at The University of Chicago. He also holds a Bachelor of Science in Engineering from Marquette University. He is licensed to practice before the U.S. Supreme Court, the U.S. Federal Circuit Court of Appeals and other U.S. District Courts. He is a registered patent attorney licensed to practice before the USPTO.

He is on the faculty of Northwestern University School of Law as an Adjunct Professor teaching IP Law. He has published and lectured extensively on design law and is a frequent contributor to CNN on intellectual property law issues. He is also often called upon to provide comment to other media outlets, including New York Times, Wall Street Journal, NPR, PBS TV, CNBC TV, BBC, Bloomberg TV, Reuters, InformationWeek, Fast Company, ComputerWorld, PCWorld, Washington Post, L.A. Times, Chicago Tribune, Forbes, Fortune, and FoxBusiness TV. Away from the law, Chris is a studied jazz musician playing upright bass on the Chicago jazz circuit.

Design Rights: Functionality & Scope of Protection
Claim Construction (drawings) and Written Description Requirement For Design Patents

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Claim Interpretation
– Drawings and Other Issues

• *Egyptian Goddess*: trial court can usefully guide the finder of fact by addressing a number of (other) issues that bear on the scope of the claim
  - particular conventions in design patent drafting, such as the role of broken lines;
  - assessing and describing the effect of any representations that may have been made in the course of the prosecution history; and
  - distinguishing between those features of the claimed design that are ornamental and those that are purely functional
Claim Interpretation – Drawings

- Drafting symbols -- established and creative conventions and symbols
  - Broken lines
  - Surface shading (line or stippling)
  - Transparency/translucency/reflective
  - Shading for color
  - Illumination
  - Others
- Many times recited in specification but sometimes just established convention
Claim Interpretation – Broken lines

• Broken lines are well established to mean portions that are disclaimed
• Such is typically recited in the special statement section
Claim Interpretation – Shading

- Surface shading used on the majority of design patents in the U.S.
- Lines/dots applied to drawing to help show the surface shape
The D’889 Patent claims the ornamental design of an electronic device as shown in Figures 1-9. The broken lines depicting the human figure in Figure 9 do not form a part of the claimed design. The other broken lines in the other figures are part of the claimed design. The D’889 also includes oblique line shading on several of the figures. The oblique line shading in Figures 1-3 and Figure 9 depicts a transparent, translucent, or highly polished or reflective surface from the top perspective view of the claimed design, the top view of the claimed design, and the bottom perspective view of the claimed design.
Claim Interpretation – Illumination

• Claim can include portions that are illuminated
• Different ways to show this – usually recited in the special statement section
Written Description – What’s The Issue

Section 120 and 112 have requirements tied into the following two circumstances:

1. Can you amend the scope of a claim in a pending design application? and

2. If you file a continuation design patent application with a claim scope that differs from what was claimed in the parent, are you entitled to priority?
Why an Applicant may want to do this?

Some examples:

1. To strengthen design protection on existing protection

2. To provide meaningful protection on later-created products sharing common DNA

3. Procure rights to stop a 3rd party knockoff
In Order to Do This….

- Pending application AND
- No new matter/Comply with the written description requirement

- What do we have?
  - Racing Strollers (en banc)
  - Salmon
  - Daniels
  - Owens
  - USPTO carve out
Racing Strollers

- Applicant filed a continuation design patent application and needed priority to a utility patent application to avoid an on-sale bar
- Disclaimed wheels (added disclaimed spokes)
- Note some other changes (see e.g., seam in seat)
Racing Strollers

- Rejected; Board affirmed; CAFC reversed (En Banc)
- As a practical matter, meeting the … requirements of Section 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application.
- The test should generally focus on whether the later filed design has been disclosed.
- The test for sufficiency in disclosure is whether the disclosure reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter at the time of filing
In re Salmon

Changed shape of seat entirely from square to circular
In re Daniels

- Applicant filed leecher design with leaf ornamentation. Filed a continuation to protect without ornamentation (priority needed)
- Holes were added (not specifically disclosed) and surface ornamentation removed
In re Daniels

• Rejected; Board affirmed; CAFC reversed
• The test for sufficiency in disclosure is whether the disclosure *reasonably conveys* to those skilled in the art that the inventor had possession of the claimed subject matter at the time of filing
• *Impliesly,* the written description requirement can still be met even if the design later claimed is not exactly present in the original filed drawings but one of ordinary skill would recognize that the inventor had possession of it.
In re Owens

- Applicant needed priority to avoid an on-sale bar
- Priority NOT granted
- (disclaimed) boundary line did not have support in original
USPTO The Carve Out – Part 1 (preview)

• Where lines exist, USPTO is “carving out” situations where a design applicant cannot protect his (supported) design:
  – USPTO wants on *random* combination of elements that seemingly create a “new” design
  – relying on utility patent “written description” law for precedent

• CAFC has never found that the written description requirement was not met where the later filed design *was disclosed* in the originally filed application

• Prior to USPTO guidelines
  – Applying some standard
  – Interim observations
  – More stringent with GUIs
The Carve Out – Part 2 (New Guidelines)

- New guidelines regarding the “overview”
- In the vast majority of such situations, the examiner will be able to determine based on a review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application.
- As a practical matter, meeting the [written description] requirement of Sec. 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein later claims to discrete portions will most likely be OK in almost all circumstances.
The Carve Out – Part 3 (New Guidelines)

- New guidelines regarding the “carve out”
- In limited situations, however, the examiner will not be able to conclude based on a simple review of the drawings that the inventor had possession of the later-claimed design at the time of filing the original/earlier application.
- That is, even though elements of the later-claimed design may be individually visible in the original/earlier disclosure (whether shown in solid or broken lines), additional consideration is required by the examiner to determine whether the later-claimed design was reasonably conveyed to the ordinary skilled designer and therefore, supported by the original/earlier disclosure.
The Carve Out – Part 4 (New Guidelines)

• New guidelines regarding the “carve out”
• The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date
• If the examiner determines that the later-claimed design was not reasonably conveyed to an ordinary designer by the original/earlier disclosure, the examiner should reject the claim for lack of written description (or when evaluating a priority or benefit claim, the application would not be entitled to the earlier date)
The Carve Out – Part 5 (likely process)

• If a rejection, the examiner must set forth detailed findings to establish a prima facie case

• Applicant can present arguments and/or evidence in rebuttal

• The Examiner would reassess as with any other rejection
The Carve Out – Part 6 (Prediction)

– No real guidance

– Later claims to portions that are visually associated with one another will most likely be OK

– Later claims to portions that are functionally associated with one another will most likely be OK

– HOWEVER: situations where the later-filed claim seems to be made up of a hodgepodge of unrelated elements to form a new design, will likely be rejected
DAVID’S BRIDAL, INC., v. JENNY YOO COLLECTION, INC.,

Patent Owner
Case PGR2016-00041
Patent D744723
USPTO Board of Appeals
Restriction Requirement

- Embodiment 1: short dress FIGS 1-4 (and 6-11)
- Embodiment 2: long dress FIG. 5 (exmr said may not be enabled)
- Applicant elected Short dress embodiment
- Filed divisional to cover long dress
- Added supplemental figures similar to short dress but if it has been longer
- The divisional granted as U.S. Pat. No. D744723
- David’s Bridal challenged the patent (if it was not entitled to original filing date, it would be invalid on its own art – like in Daniels, Owens, etc)
Analysis

• “The test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed, but whether there is support anywhere in the drawings for the necessary or desirable figure corrections.”
• a skilled artisan would recognize that the inventor had possession of the longer length dress and panels shown
• The figures appear to be simply the natural result of lengthening the bottom portion of the shorter dress and convertible panels, as shown in Figure 5 illustration of the longer dress.
• The drawings are sufficiently consistent that, on this record, we are persuaded that the inventor had possession of the features shown in drawings Figures 2, 3, and 4 of the ’723 patent at the time of filing of the ’548 application.