# AN INTRODUCTION TO THE DESIGN *BEHIND* DESIGN PATENTS

*This is the first installment of an ongoing series on how the design patent system can benefit from an increased understanding of the industrial design field and how designers analyze and discuss design.*

The drawings of a design patent application are not merely illustrations of a mechanical invention. Design patent drawings are actually claims to an invention that is strictly visual in nature.[1] Of course, it is probably easy to view these statements as representing common knowledge held by practically everyone involved with intellectual property law. It may be true that most can easily draw a general, academic distinction between utility and design patents, namely that utility patents protect how things work and design patents protect how things look. In practice, however, we do a poor job at best of putting this distinction into practice. The problem is not in our ability to distinguish appearance from function, but rather to talk about the attributes of what a design patent depicts.

For at least the past five years design patents have been a significant topic in IP circles. In discussing design patents, we've covered how we should measure infringement[2] and whose mind we step into when analyzing obviousness.[3] We have also debated what makes a design patent obvious,[4] what's reasonably foreseeable to a designer,[5] and most recently, how much damage is caused by design patent infringement.[6] We've heard from those who appear to view design as subordinate to technology,[7] those who promote design as being crucial for humanizing and selling technological innovations,[8] and those who seem bothered by even having to discuss design.[9]

In all this discussion there is a lot of discourse about what design patent claims mean. While some of that discourse has included limited discussion about what it means to be a designer and what designers contribute,[10] there has been virtually no discussion about how the inventions protected by design patents are developed in the first place. Even further, there has been almost no endeavor to determine the appropriate language for discussing the subjects of design patents or how one design compares against another.

Instead, many try their best to turn our discussion away from the designs. On one hand, it is true that the Federal Circuit's guidance in Egyptian Goddess to refrain from verbal claim construction of otherwise clear design patent drawings makes sense.[11] The goal of limiting such claim construction is to keep from tying design patent infringement to fulfilling an arbitrary verbal description of a design that is already right in front of us. This reasoning should not be used as an excuse to refrain from verbally discussing designs at all.[12] It seems that part of the reason why many look for such an excuse is because putting aspects of a design into words is difficult and concrete guidance for doing so has been lacking.

One might counter that our "ordinary observer" standard for assessing design patent infringement requires us to disregard the minute concerns of enigmatic designers, which are too frivolous to actually affect the impression that an ordinary observer would have.[13] By taking a

closer look at designers and the field of industrial design, it can be seen that designers, while obsessing over details that consumers may not consciously notice, are ultimately concerned with influencing the impression that users and purchasers have of a product. There are frameworks for discussing design broadly within the field of industrial design and ways to filter out and ascertain how design elements and design choices affect consumer choices and perception.

When dealing with utility patent obviousness, which involves a *person of ordinary skill in the art* standard, the discussion is not limited to the level of a predetermined person of ordinary skill in the art. Rather, two different devices, for example, are compared according to whatever applicable scientific principles are needed, regardless of the level of skill required. We then look to see if our theoretical person of ordinary skill in the art would have found the claimed invention obvious in light of those differences.[14]

The approach should be similar on the design side. Our actual assessments of infringement, anticipation, obviousness, and even limited aspects of claim construction should be made by using applicable principles of visual design to intelligently discuss the designs involved. This discussion can then be filtered through the applicable point of view as part of a final assessment. Our habit of not proceeding in this manner makes assessments of infringement, anticipation, and obviousness excessively difficult and unpredictable.[15] It also has negative impacts on the judicial record and impedes our design patent jurisprudence.

Outside of claim construction and issues of infringement, the test for design patent obviousness specifically requires an evaluation at the level of a designer of ordinary skill in the art.[16] Having studied industrial design in a program that emphasizes development not only of skill in three-dimensional design and visual analysis but also in verbally communicating aspects of the design process and visual analysis, I've observed that so far we've fallen short of evaluating designs as a skilled designer would, with or without further evaluation of the impression on an ordinary observer.

Patents have their own appellate district in part to provide a judiciary that is familiar with how to incorporate scientific theory and discussions of technology into legal evaluations. Further, it seems generally accepted that part of the reason why the USPTO requires patent practitioners to have a science or technical background is so that our patent dialogue can be conducted at an appropriately-educated level. This requirement also helps increase the likelihood that inventors who seek legal help and counseling end up in capable hands.

I am by no means saying that there should be separate standards for licensing design patent practitioners (although it might be a good idea to allow those with design backgrounds a limited admission to the patent bar to file and prosecute design applications). Similarly, I am not trying to imply that scientists or engineers are incapable of understanding the finer points of visual design. My point is that, just as patent practitioners strive to educate themselves on the technical fundamentals behind the utility patents that they write, litigate, or opine on, they should

acquire a basic understanding of the theories and fundamentals of visual design as a part of practicing design patent law.

A few years back, I wrote a series of articles[17] for the notable design site Core77.com that promoted the potential of design patents and encouraged designers to confidently pursue them. In these articles, I wrote at length about the structure of design patents and their place in the IP system as a whole and explained how designers can actively participate in the design patent process to help acquire patents that are enforceable and valuable. The key to obtaining design patents of this caliber, I argued, was taking a strategic approach that includes building the claims around the significant visual aspects of the subject designs.[18]

The motivation behind "The Design of Design Patents" series was twofold. Primarily, the articles looked to give designers hope that the patent system can in fact provide adequate protection for product appearance, and that consideration of the principles of visual design have a place in design patent strategy. Beyond that, I wanted to give designers a framework that could help them not only work to promote the significance of good design patent protection but also guide the design patent process in the right direction.

The protection framework I presented to designers was based off of the idea that designers seeking to protect their inventive visual designs can improve the quality of their design patent applications by learning enough about design patent law to be able to contribute to an analysis of what they should really be trying to protect.[19] In fact, I actually told designers that they may have to have a greater understanding of design patent fundamentals than they would on the utility patent side. I explained that the benefit of knowing enough about design patents to participate in the development of a claim strategy was that it can help designers to close the knowledge gap between a designer, who understands the design inside and out, and a patent lawyer, who may have a thorough understanding of the applicable laws, but may lack the sensitivity or background necessary to decipher the significant aspects of a design.

So while it was necessary to give designers an explanation of the design patent system, patent practitioners need to expand their understanding of the field of design. That is, a patent attorney or agent working on a design patent application needs to understand the design *behind* design patents. At a basic level, this includes knowing how to analyze and discuss a design intelligently and according to established principles of visual design as well as having a basic understanding of what the job of a designer entails. Understanding design means being able to effectively communicate with clients or inventors who themselves "speak design" or who are trained designers. This is similar to the need to understand the basics of a given field of engineering, for example, when discussing an invention for a more traditional utility patent.

An elevated level of design discussion on the part of practitioners will then work its way into and benefit the patent system overall. I believe our design patent jurisprudence has been approaching a workable scheme that promotes innovation in the visual product design space, but the courts, including the Federal Circuit, seem to be having trouble finding a correct and predictable way to apply and balance their mostly well-founded tests and factors. In particular, recent case law does not appear to be gaining any ground on reaching clear determinations of

what infringes a design claim or what renders a design claim obvious.[20] Notably, decisions involving these requirements and tests lack a correct consideration of what visual design, what it involves, and its guiding principles. By more intelligently discussing the designs involved in design patent cases and by thoroughly understanding what visual design involves, we can come closer to zeroing in on clear design patent jurisprudence.

For those who may ask why these considerations are suddenly of such importance when the design patent system existed without them for so long, there's one simple answer: for the first 120 years or so, the design patent system really did nothing but exist. Design patents were not heavily utilized and were never really viewed as a primary course of IP protection. The pre-*Egyptian Goddess* points of novelty approach[21] to deciding design patent infringement was so far removed from an informed view on how designs are created and perceived that there was no room for actually discussing Design in a design patent context. Similarly, pre-*In re Zahn*, [22] it wasn't necessary to discuss the finer points of a design prior to filing a design patent, because there was no real strategy to develop as far as a design claim went.

As we saw from the design claim approach taken by Apple in its patents asserted against Samsung,[23] and the wave of increased, strategically-minded applications that followed, there is now an allowance and plenty of room for strategy in current design claims. As many post-Apple decisions[24] and Patent Office actions have shown, however, what we need now is a framework for that strategy and way to decode and apply the design claims that result from it. This series of articles intends to show that this general framework already exists, and that it can, with a little effort, be imported it into design patent practice and jurisprudence. The result of this effort can not only help to make better sense of design patents and their place in the overall patent scheme, but can also help us develop more focused strategies for claiming designs in the first place.

Future articles will provide additional explanation of why the use of a framework for discussing visual design is needed and why it will be beneficial. Beyond that, I plan to show how thoughtful consideration of how designers work and how they're guided by visual design principles can help improve individual practice and client service, as well as patent policy and jurisprudence. Design patents are making significant strides in their ability to adequately protect an increasingly important aspect of innovation. The patent system and its practitioners need to make sure that the way we discuss and consider visual design will ensure that this trend continues. It only follows that this means working to truly understanding the design behind design patents.

**BIO**

Michael Hages is an intellectual property attorney with Price Heneveld, LLP in Grand Rapids, Michigan. He offers clients a comprehensive range of intellectual property services based on his extensive knowledge of patent and trademark law, including implementing design and utility patent strategies, drafting and prosecuting patent applications, providing written and oral opinions to clients regarding freedom-to operate, non-infringement, and invalidity. With his specialized understanding of design prosecution, Mike advises clients on design patent law and the effective use of design patent filings in advanced protection strategies.

While practicing intellectual property law after receiving his J.D. from the University of Dayton, Mike studied product design at the professional and graduate levels, including at Pratt Institute in Brooklyn, NY. His design education, combined with his undergraduate degree in mechanical engineering from the University of Michigan has helped him develop an understanding of numerous aspects of product design, including visual and interaction design, design research, and strategic development.

Mike has written previously on the usefulness of design patents for designers in *The Design of Design Patents* (published by Core77.com in August, 2012) and was an invited panelist, speaking on caselaw developments related to design patent examination and prosecution, for the USPTO Design Day, Examiner's Afternoon in April of 2014.

**ENDNOTES**

[1] 35 U.S.C. § 171; Gorham Co. v. White, 81 U.S. (14 Wall.) 511,525 (1872).
[2] *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (holding that that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed).
[3] *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1313 (Fed. Cir. 2013) (finding that the use of an "ordinary observer" standard to assess the potential obviousness of a design patent runs contrary to the precedent of this court and our predecessor court, under which the obviousness of a design patent must, instead, be assessed from the viewpoint of an ordinary designer), *citing Apple, Inc. v. Samsung Electronics Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012).
[4] *See, e.g., MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1335 (Fed. Cir. 2014) *cert. denied,* 14-5, 2014 WL 3055381 (U.S. Oct. 6, 2014) (on numerous occasions we have invalidated design patents despite the inclusion of ornamental features that were entirely absent from prior art designs).
[5] *Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications,* 79 Fed. Reg. 25, Docket No. PTO–P–2014–0002 (2014); Richard Stockton, *The Written Description Requirement in US Design Patent Prosecution: Background and Recent Developments,* available at <http://bannerwitcoff.com/_docs/library/articles/R.%20Stockton.Written%20Description%20Recent%20Developments%20and%20Summary.pdf> (March 12, 2014).
[6] *Apple Inc., v. Samsung Electronics Co., Ltd.*, Case: 14-1335 (Fed. Cir. 20__).
[7] Brief of 27 Law Professors as Amici Curiae, *Apple*, Case: 14-1335 at 10 (claiming that "it is more plausible that a function feature in a utility patent drives demand than a patented design does").
[8] Brief of 54 Distinguished Industrial Design Professionals as Amici Curiae, *Id.*; Brief of 26 Design Educators as Amici Curiae, *Apple*, Case: 14-1335 at 14 (countering that "'[t]he visual appearance of products is a critical determinant of consumer response and product success'"), citing Nathan Crilly et al., *Seeing Things: Consumer Response to the Visual Domain in Product Design*, 25 Design Studies 547, 547 (2004).
[9] *See, e.g., High Point Design LLC v. Buyer's Direct, Inc.*, 2012 WL 1820565 (S.D.N.Y. May 15, 2012) rev'd in part, vacated in part sub nom. *High Point Design*, 730 F.3d 1301 (finding that all major characteristics of the claimed slipper are functional).
[10] Brief of Industrial Design Professionals, *Apple*, Case: 14-1335.
[11] Egyptian Goddess, 543 F.3d at 679.
[12] *High Point*, 730 F.3d at 1314 (finding that the district court's single-sentence description of the patented design's visual impression represented "too high a level of abstraction" by failing to focus "on the distinctive visual appearances of the reference and the claimed design) citing *Apple, Inc. v. Samsung Electronics Co.*, 678 F.3d 1314, 1331–32 (Fed. Cir. 2012).
[13] The district court in *High* Point, for example disregarded expert testimony on the issue of obviousness that "[a]s the Supreme Court stated more than one hundred years ago, "To constitute infringement of a patent for a design, it is not essential that the appearance should be the same in the eye of the expert. 2012 WL 1820565 at *5, citing Gorham Co. v. White, 81 U.S. 511, 527 (1871). It is worth noting that the

court was assessing obviousness under the improper standard of an ordinary observer. *See High Point*, 730 F.3d at 1313.

[14] *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)

[15] The issue of design patent obviousness, in particular has been characterized as "impossible." *See In re Nalbandian*, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring) cited in Sara Burstein, *Visual Invention*, 16 Lewis & Clark L. Rev. 169, 170 (2012).

[16] *High Point Design*, 730 F.3d at 1313.

[17] Michael Hages, *The Design of Design Patents,* available at <http://s3files.core77.com/blog/images/2012/09/Design_of_Design_patents.pdf> (August 20, 2012).

[18] I*d,*. at p. 6.

[19] *Id.*, at p. 16.

[20] *See, e.g.,MRC Innovations, LLP*, 747 F.3d 1326. The shortcomings of the guidance handed down in MRC are discussed at Sara Burstein, *Design patent nonobviousness jurisprudence — going to the dogs?*, available at <http://patentlyo.com/patent/2014/04/design-nonobviousness-jurisprudence.html> (April 3, 2014).

[21] *See, e.g., Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998) abrogated by *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

[22] *In re Zahn*, 617 F.2d 261, 267 (C.C.P.A. 1980) (holding that a design for an article of manufacture may be embodied in less than all of an article of manufacture).

[23] Mark Nowotarski, The Power of Portfolio: Strong Design Patents III, available at <http://www.ipwatchdog.com/2013/08/23/the-power-of-portfolio-strong-design-patents/id=44774/> (August 23, 2013).

[24] See nn. 3 and 4, supra.