

The Design of Design Patents

by Michael Hages*

PART 1: WHAT EVERY DESIGNER SHOULD KNOW ABOUT PROTECTING THEIR WORK

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The mere mention of design patents in the title of this article has already gotten most of you thinking about the ongoing trial of Apple against Samsung. Many are waiting to see which side of the dispute I'll favor and some people are ready to unleash their arguments against my position. They'll have to keep waiting, though, because this article isn't about *Apple v. Samsung*...well, as much as any article on design patents right now can manage to not be about *Apple v. Samsung*.

While we wait through what many are characterizing as the "boring" part of the trial, I'd like to take some time to discuss design patents in general. I'm sure that many industrial designers who are following the *Apple v. Samsung* case are wondering how a handful of design patents, the oft-maligned afterthought of the intellectual property (or "IP") world, can make up a significant part of a \$2.5 billion lawsuit. More importantly, designers should be interested to know what the impact of this case will be on design patents and how that will affect their own work.

From a purely legal standpoint, nothing is likely to change because of *Apple v. Samsung*, regardless of the outcome. Any design patent not involved in the trial will be the same on the day after the verdict as it was the day before. The decision in *Apple v. Samsung* is going to be based on how the jury interprets the facts of the case. The only way any law has a chance of being changed is if a decision gets appealed.

The real potential for impact, however lies in the mere fact that the design and business worlds are paying close attention to the design patent side of this case in the first place. Design patents have been around for over 150 years and in that time have only seen limited usage. Sure, many people or corporations have sued in the past to enforce their design rights with some success, but both the number of design patent lawsuits and the number of design patents granted pale in comparison to those of utility patents.

The traditionally meager status of design patents is the reason why many designers are likely surprised by the prominence of design patents in *Apple v. Samsung*. In all real-

* The views expressed herein are solely those of the author and do not necessarily represent the view of his firm or its clients.

ity, practically everyone who has an opinion holds design patents in the lowest esteem of all the different forms of IP protection. You'll find that most people listing the different areas of intellectual property will rattle off copyright, trademark and patent while actually only thinking of utility patents—the more esteemed form of patent protection that is geared toward what an invention is or how it functions.

If asked about protection for the visual aspects of a product's design, that same person might then dismissively mention the existence of a design patent before relaying a common view about them: they're easy to get around, but they're cheap and easy to get. This perspective views design patents, at best, a quick way to get a patent number to slap on a product.

Sept. 20, 1949.

C. EAMES

Des. 155,272

CHAIR

Filed March 27, 1947.

Fig. 4



Inventor

Charles Eames

The negative view of design patents is so widespread that even most designers feel that there is no meaningful way to protect the appearance of a product. The fact is that while many of the innovations that come out of design and design thinking find adequate protection in utility patents, most designers feel that there is no meaningful way to protect the appearance of a product. As a result, designers often feel that a substantial part of their work is left vulnerable to copying. This feeling exists in spite of the fact that an entire section of IP law in the United States has been carved out for the protection of a product's visual design.

Before we get too far in, it is important to understand the different types of IP protection and how they relate to each other. Put as simply as possible, patents protect things and methods for making or using things, trademarks essentially protect brand identity and copyrights protect artistic expression. As mentioned above, patents are further broken down into utility patents and design patents. While methods fit exclusively within the area of utility patents, physical things can find protection on both the utility and design sides.

Essentially, the structure or functional elements of a thing can be protected by utility patents, and the physical appearance can be protected by design patents. If there are any features of a product that straddle the line between being functional or being visual, you can often find a way to get protection from both types of patents. This alone is a major advantage of design patents over trademarks and copyrights, which both specifically exclude coverage for anything functional (the recent grant of trademark protection to Hershey's notable chocolate bar pattern notwithstanding)¹. To get design protection for something that has unique characteristics both visually and functionally, all you have to do is to find a way to present it so that the appearance of what you're protecting is dictated more by aesthetics than by function, if only slightly.

While *Apple v. Samsung* isn't currently rewriting any design patent laws, it's certainly putting design patents in a position that makes them hard to ignore. Apple's focus on its design rights with respect to a product that is also covered by over 200 utility patents (by Apple's own count) is making people realize that, if you're serious about design, you need to seriously consider design patents. The key for designers going forward is going to be knowing what it means to be serious about design patents.

Unfortunately, I can't simply say that the common, dismissive view of design patents is absolutely false and that filing more design patent applications and suing more people for design patent infringement will fix everything. The fact is that not all design patents are created equal, and that it's really easy to end up with a bad one. If you go into the patent process with the view that you're just trying to get a cheap and easy patent, a design patent can fit that bill, but it may prove to be worth about the amount of consideration and time that went into it. Often, this ends up being very little or nothing at all. On the other hand, with the right thought process and a little extra effort, it is actually possible to get valuable coverage from a design patent.

The problem is that the cheap and easy approach to design patents is so pervasive that it weighs down the entire design patent system. The result is that each of the components of this view have been almost accepted as fact. However, the thinking that design patents are easy to avoid, that they're cheap and that their only redeeming quality is that they're easy to get, are really misconceptions about design patents that arose over time from lack of understanding of or appreciation for design itself. As you can see, this problem is bigger than three individual design patents and can't be fixed by one simple trial, but designers can use the opportunity presented by the current attention to design patents as a way to take steps to erase these misconceptions.

To understand how to get valuable design patents we need to understand why so

many bad design patents have been filed and have been issued in the past. This involves exploring each misconception about design patents to see that they are not indicative of inherent limitations of design patents in general. Of course, simply knowing that good design patents are a possibility is only one step to actually getting one yourself. Fortunately, there are a few simple things that designers can do themselves to ensure that the design patents they get or that cover their designs are worth the effort and expense.

Misconception 1: Design Patents Are Easy to Get Around

Everything starts with the idea that design patents are inherently narrow in scope and that any design patent can be avoided or "designed around" by simply making some minor change to the original design. Historically, it's true that most of the people who have tried to sue someone for infringement of a design patent have found that their patents can't protect against much more than blatant copies. We can see that this isn't always the case though, by the simple fact that Apple's case against Samsung has made it this far. The reason why people have such a hard time covering other products with their design patents, however, is really a problem with how those specific patents are put together and not because of some built-in limitation of design patents in general.

To explain how it's possible to get decent, or "broad," protection from design patents it's helpful to look at the different ways in which both designers and patent lawyers approach creating applications for utility patents and design patents. I'm sure that a good number of industrial designers reading this article have been through or at least looked into the ins-and-outs of the patent process. Those who have experience specifically on the utility side should appreciate a patent lawyer's ability to take a two-page description of a device and a few low-quality images and turn them into a comprehensive treatise of a patent application complete with an abundance of drawings and a written description exploring every possible permutation of the device, along with the requisite number of "whereats" and "thereofs" that are the hallmarks of any professionally-drafted utility application.

When a patent lawyer works with an inventor on a utility patent, the point of turning a two-page disclosure into a more lengthy patent application isn't just to allow the patent lawyer to bill hours. It's done to increase the overall value of the patent by boiling down the inventor's description to isolate the essence of an invention and then making sure that the invention is protected in every reasonable context across all reasonably-possible variations. This helps establish a basis for broad utility patent protection.

Another important step in the utility patent assembly process is to identify when a single product or idea actually contains multiple inventions that are related but can actually stand on their own for purposes of a patent application. For example, if you were to come up with a new design for a desk lamp with a unique arm structure and a specific way of arranging the LEDs that you use for a light source, you would want to characterize the arm as its own invention, apart from the LED array, and vice versa. That way, someone wouldn't necessarily have to copy your entire lamp to infringe on your patent rights, but

would only have to copy one of your inventions. The way that individual inventions are separated and characterized, as well as the context in which they're presented, is called "claiming" an invention.

This process of appropriately claiming an invention as your own is critical to building value into a patent application and any patent that is ultimately awarded based on that application. In a utility patent, the invention is claimed in a series of numbered paragraphs at the end of the application's text. These paragraphs are appropriately referred to as the claims of the application and are barely decipherable by anyone other than a patent lawyer.

A set of utility claims will include one or more independent claims, which when well-written, will attempt to put the invention, or inventions, in as broad of terms as possible. Determining how broad claims can be often involves making the claims just narrow enough to exclude any known "prior art," or other patents or products that existed before the claimed product or method. The claims also have to be for something tangible, that is they can't be for an abstract idea or concept.

The claims can also include several dependent claims that respectively refer back to an independent claim and add further detail or context to the independent claim. These can act as a kind of backup position for use during litigation or the Patent Office's examination of the application. Dependent claims can also be used simply to increase the total number of claims to a more intimidating quantity, if you think that's necessary.

A utility patent's claims can be difficult to understand and are also difficult to write, but they are really the essence of a utility patent. When a patent lawyer prepares an application for a utility patent, they spend a great deal of time and even use a little creativity drafting the claims. It really is an art form of its own particular kind and an essential one at that. During a patent lawsuit it's the claims that are argued over and the claims that are ultimately infringed or not by the accused product or process.

The remaining text of the application is a lengthy written description that can refer to a set of technical drawings included with the application. The point of this description is to provide support for the claims by fully describing the invention in a way that a person with general knowledge of the technical area could re-create the invention. The theory behind this is that when a patent expires, the public should be able to re-create the invention for its own use based on the disclosure.

A design patent by contrast has little writing at all. A design patent relies on sets of drawing figures that illustrate the design itself and act as both the description and claims of the patent. The only writing in a design patent is usually a short description of what type of product the covered design is for and a listing of the views shown by the figures. There are no artfully-written claim paragraphs and there is no lengthy written description where the lawyer can elaborate on all the different variations of the invention that they can imagine. For all practical purposes there are only the figures in a design patent. These drawings represent both the disclosure that the patent contributes to the world and the claims that the patent holder can assert against someone else. The design, in essence,

speaks for itself.

What most patent lawyers and designers alike tend to not realize or appreciate is that the general approach to claiming an invention in a utility patent application can also be used in design patents. Of course, the language used to implement the claim strategy and the overall context of the claims are vastly different. In a utility patent the claims are written to describe the technical characteristics of a product, but in a design patent the claims are literally drawn to illustrate a product's visual characteristics. Regardless of the language used, just as in utility patent claims, the claim of a design patent can be tailored to include the essential elements of a design while leaving out what's unimportant. In addition, just as in a utility patent, a design patent (or a number of related design patents) can claim the important and inventive aspects of a design separately.

March 6, 1934.

R. LOEWY

Des. 91,675

PENCIL SHARPENER

Filed May 29, 1933

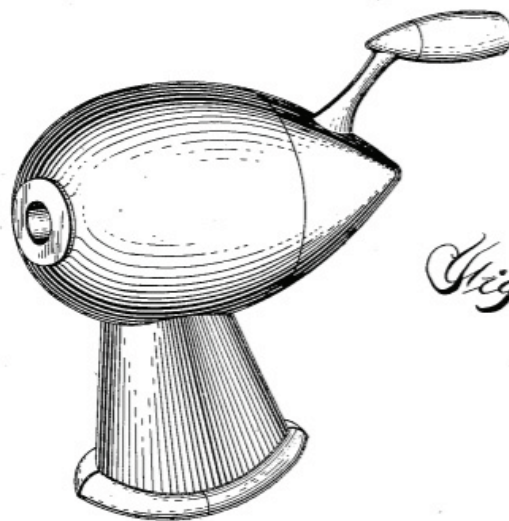


Fig. 1.

Inventor
Raymond Loewy

The idea that a design can be partially claimed isn't new. Almost any patent lawyer will know that features can be shown in a design but excluded from what's claimed by simply putting those features in dashed lines. The greatest problem, however, is that most patent lawyers can't think of a product's design any more deeply than simply as a collection of a product's features or parts. Because of this thinking, design patents that claim less than a product's entire design often focus on the "front half" of a product or the overall shape without the buttons or the screen, for example. Any designer knows that a design is much more than its features and their respective locations. Fortunately, the design patent rules that allow for selective claiming aren't as limited as many patent lawyers' knowledge of design. While there may be instances where it is necessary to claim the design of different parts of the product, it can be even more beneficial to try to independently protect the

various aspects of the design that arise from the actual visual design considerations.

A good way to illustrate this idea is with respect to the design of a car. Of course, cars usually have their own unique overall designs, but you can also think about the headlights or the grille as having patentable designs themselves. Even the way these and other features are put together and made cohesive can involve a multitude of different considerations that are based on relationships between the features themselves and how they shape the overall design. Developing and refining these relationships is really the essence of visual design, and any of these relationships that can be shown in a drawing and that result in something that is actually new or unique can be claimed in a design patent.

Continuing with the car example, you can take a unique design for a car's headlight and further break it down based on its own features and their influences. Likely, a portion of the shape was influenced by the shape of the hood, another area by the shape of the fender bulge, and another part by the shape of the grille. This thought process can continue down to excessively minute details, and it's probably unreasonable to try to patent the result of every design consideration or all of the different elements of a design. Approaching the design patent process with this type of thinking, however, can help in developing a design patent strategy that's aimed at protecting the important aspects of a design rather than simply the prominent parts of a product. Even more important, it can lead to patents that capture the aspects of an overall design that are likely to catch the attention of a copyist or get stuck in someone else's head and eventually wind up in their own designs.

In reality, very few of the design patents in existence actually began with this type of thought or strategy. While thinking critically about a design can help to get a design patent or a set of design patents that will prove difficult to avoid, it's not a requirement. The Patent Office doesn't evaluate a patent, design or utility, for how well it actually protects an invention. A patent examiner won't tell you if your patent is any good or not. The Patent Office is really just a gatekeeper to make sure your application meets their statutory requirements and that you're not trying to claim something that has already been patented or that would be obvious in view of other patents, or what's called "prior art."

In fact, it often takes years for representatives of companies that produce and sell products covered by design patents to realize that their patents aren't any good. That usually doesn't happen until they compare their patents to knock-offs or the suspiciously similar products of their competitors. It's at that point that they realize their patents left room for the copyist to make minor changes to avoid their patents, or that their patents allowed competitors to pick and choose a few notable characteristics to borrow. By then it's too late to change the way a patent claims a design so the only option is to blame the patent system for not providing enough protection.

It's important for designers to seriously consider obtaining design patents to protect their work. Even if visual design isn't your only contribution to a product and even if that product is the subject of utility patent applications, design patents can be critical to protecting what is often the first thing people use to distinguish a product. Sometimes it might even be necessary to argue for the decision-makers, if that's not your role, to ag-

gressively pursue design patents that revolve around a thorough strategy because you'll be fighting against this and the other prevailing myths about design patents. Although the ideas that design patents are cheap and only useful as an easy way to get some kind of patent partly flow from the false idea that design patents are inherently limited, they also have their own origins based on unique misconceptions that are worth exploring, which I'll do in the next parts of this article.

PART 2: THE PRICE OF PROTECTION

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In the first part of this article, we introduced the idea that valuable design patents are something that designers can, and should, work to obtain. We also explored the misconception that design patents are inherently narrow or easy to get around and discovered exactly where the holes in such a belief lie. In this article, we'll look at how the cost of design patents affects how people perceive their value and what the actual cost of a good design patent strategy should be.

Misconception 2: Design patents are cheap (and why it's a good thing that this is wrong)

Anyone who has participated on both the design and utility side of the patent application process can see a difference in how the applications get written and assembled. Both the amount of information exchanged and the time taken for preparing a utility patent are much greater than when dealing with a design patent application. Of course, this time is ultimately reflected in the cost of the application, which in the case of a utility, is typically expected to be in the range of \$8,000 to \$12,000. That, however, is for a single application that may only cover limited aspects of a product. Simply comparing this to the cost for a design application, which can be between \$2,000-3,000, shows a notable difference in the expected amount of time usually spent on these two types of applications.

Adequately covering a new and innovative product on the utility side, however, can often involve multiple applications, adding up to sometimes more than \$50,000 for a single product (and that's just to file the applications). Most of the time, when working on the design side, only a single application is filed. The Patent Office might require an applicant to split up the application into separate applications that cover what they determine to be different designs, even if only slightly different. Such a requirement only incrementally increases the cost, which ultimately pales in comparison to the total on the utility side.

This vast difference in cost certainly makes design patents look cheap. Simply because there isn't much actual legal writing involved, design patents shouldn't cost as much as utility patents. But, they shouldn't be viewed as cheap. There are probably a lot of designers who wouldn't view \$3,000 as cheap, but the overall notion, especially from the perspective of someone paying \$50,000 to begin the utility patent process, is that

design patents comparatively lack value. It's also worth mentioning that there can also be a significant additional cost in actually getting a utility patent through the Patent Office. The cost of so-called patent prosecution can add another \$10,000 to \$20,000 to the cost of a utility application itself (it can be more in extreme cases) and is also less expensive when dealing with design patents.

As explained above, simply filing a single design patent application is most often not good enough. Any patent strategy should include an application that accurately and almost completely illustrates the actual product. This is done to ensure that you can at least get one, albeit narrow, patent for the product because filing too broadly can lead to a rejection by the patent office that can't be overcome. Also, while there's always a chance that the patent office could miss something that someone else could use later to invalidate any patent that you get, more narrowly written patent claims are typically less susceptible to this type of attack.

To get really good protection, however, it may be necessary to file two, three or even four additional applications that cover different aspects of the overall design or include different combinations of design features. These applications will generally be more broad in that they include fewer additional features that another product may need to have in order to infringe, even though they appear more specific in nature. Because they're more broad, these applications are more susceptible, at least in theory, to patent office rejections and any issued patent is also more vulnerable to attack with respect to validity. Multiple applications of varying breadth are, thus, often needed to increase the likelihood that something is allowed, is relatively strong, and might be infringed.

This type of layered coverage is also more intimidating to those who would either copy or selectively borrow from a design. A copyist might think twice about potentially infringing multiple patents. Further, someone who thought that they changed just enough of your design might be surprised to find that the one element of your design that they just had to keep was all that you claimed in one patent. In such a case, that copyist would be forced to adjust their design to be ever farther away from yours.

So yes, the cost of all this strategic filing can start to add up. While in most cases it will still remain lower than the total cost of a good utility patent program, it will probably leave the realm of what most people consider a cheap price. There are steps that can be taken to reduce costs or at least defer some costs, including filing a narrow application first and then later filing more broad applications as "continuations" of the original, but any effective strategy should cost some decent money. While that can be a hard pill to swallow, it's certainly better than taking the cheap route and later finding out that you got very little meaningful protection. In many circumstances, in particular when the actual design is of some importance, it's necessary to implement an actual strategy in filing design patents because doing so can actually make your protection valuable.

It's worth noting that you can get a cheap utility patent as well. There are plenty of lawyers and firms out there that will write a specific application with little thought or detail while claiming a device or method in an overly narrow manner. These claims usually describe all aspects of a product with little thought to what is the actual invention, or if

there are multiple inventions, that they're lumping together into a single claim. Fittingly, the result of this approach is called a picture claim because in doing so, the lawyer drafts a verbal picture of the device. It should follow that if it's accepted as a bad idea to rely on a verbal picture of a product for utility protection, we shouldn't want to simply file a complete, fully detailed, picture of a design and expect to be adequately protected.

It's accepted that an increased cost in utility patents is sometimes necessary to increase value and give a shot at good protection for the function and guts of a product. That doesn't mean that we should start to blindly pump more money into design patent filings, expecting that by simply increasing cost, value will follow. It does mean that, if you have a design that is the result of endless exploration, adjustment, refinement or frustration, you shouldn't be happy with how cheap your design patent was. If anything, when you put in a lot of work into an innovative design that you're proud of, you should be skeptical of a design patent strategy that doesn't seem to reflect any of that.

If you actually make an investment in developing a product's design, you should expect that it will cost real money, in the long run, to protect. I'd recommend a benchmark of a cost distribution between design and utility protection that is equal to the distribution of cost on the development side. That is, if your development cost for the visual aspects of a product were equal to the functional, then spending on protection should be about equal. Of course, there are some aspects of development that are a mix of visual and functional design, but both design and utility patents allow for a little overlap between areas. This gives a little wiggle room in budgeting and overall development of a strategy on which a good IP lawyer can give guidance. It might be a tough pill to swallow, but if you find yourself talking about a real strategy and a real budget with an IP lawyer, even if the result is to scale back things to save money, you're much more likely to get your money's worth in protection.

PART 3: MORE THAN JUST A PATENT NUMBER

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Now that we've seen how a valuable design patent strategy can begin to take shape, we'll step back a little and look at how even a known positive aspect of design patents ended up being misused to their detriment. This can also give us a clue as to where to start to turn things around and rehabilitate the reputation of design patents.

Misconception 3: Design patents are, at best, just an easy way to get a patent number on a product.

In all the ways that common misconceptions about design patents are wrong, the notion that they're easy to get is actually correct. That is, compared to utility patents, they're relatively easy to get. The patent process itself is confounding, difficult and full of seem-

ingly inane rules no matter which side you're on. However, once a utility patent is filed, it often faces an uphill battle to actually be allowed by the United States Patent Office. For one, the waiting list for utility patents to be examined is between about two and three years. Once examination starts, the back-and-forth arguing with the patent office over whether or not a patent is actually deserved can take at least another year and can be endlessly frustrating.

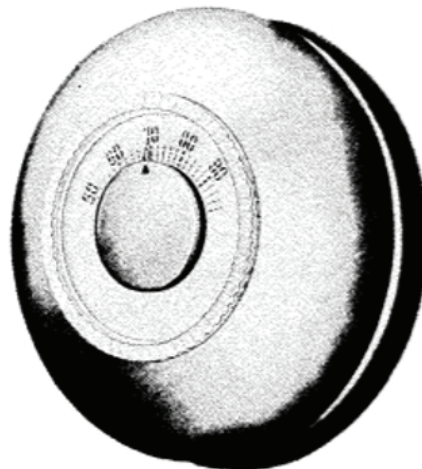
Design patents, on the other hand, only sit for about six months to a year before being examined. Even better, many design patents are immediately allowed or only face formal objections, rather than more difficult substantive rejections, that are almost automatic for utility applications. Even taking a more strategic approach to design patent filing may not have a significant impact on examination times because the sheer volume of design patent applications filed is so much lower than with respect to utility patents.

United States Patent Office

Des. 176,657
Patented Jan. 17, 1956

176,657
CONTROL INSTRUMENT

FIG. 3



Henry Dreyfuss, South Pasadena, Calif., assignor to Minneapolis-Honeywell Regulator Company, Minneapolis, Minn., a corporation of Delaware

Application June 1, 1953, Serial No. 25,258

Term of patent 14 years

Many people who are otherwise unconcerned with the visual aspects of a product seek to use the ease of getting a design patent to their advantage. Their goal is to quickly get a design patent, even a cheap one, to be able to honestly mark a product as “patented” or to have some minimal level of protection while they wait for their utility patents to issue. When people take this approach, they really don't care what they end up with; they just want it to be cheap and quick. This is a big part of the reason why so many bad design patents exist.

The problem that stems from all the bad design patents out there is that, eventually, people do decide to try and enforce some of them. The courts have always seemed to struggle not only in trying to make sense of visual design but also simply trying to find a way to keep design patents, including bad ones, afloat. More often than not though, actually winning a design patent lawsuit proves exceedingly difficult. This phenomenon fed back into the perception that design patents themselves are inherently weak, causing that myth to become widespread.

The perception of design patents was on a downward spiral for some time, during which repeated half-hearted attempts at design protection were followed by repeated unsuccessful but costly attempts at design patent enforcement. It got so bad that even in cases where those involved felt that the product's design really did matter, the motivation behind any accompanying design patents was simply the thought that "well, this does have a design so we might as well file a design patent."

In spite of all this, the Federal Circuit recently opened the door somewhat for design patents. In what would seem like a very innocuous case involving a design patent for fingernail buffers, the Court removed a critical aspect of the law of design patent enforcement that was partly what made winning a design patent lawsuit so difficult. In the absence of the requirement that design patent plaintiffs spell out the "points of novelty" of their design before it's compared against the alleged infringing product,² design patent enforcement may now prove easier. In one example, the footwear maker Crocs was successful in a lawsuit against some knock-offs that actually had some noticeable differences from the patented design (this should also ease any concerns that a design has to be universally lauded to deserve design patent protection).³

Even outside the courtroom, people may be paying more attention to existing design patents when developing new products. Notably, while Apple and Samsung are still locked in litigation over the design of Samsung's Galaxy II phone and Galaxy Tab, Samsung openly admitted that a goal of the design of its successor Galaxy Nexus phone was to be different enough from Apple to avoid even a hint of future design patent issues.⁴

Despite these positive signs, it's still difficult for design patent filings to gain significant momentum. People seem to still view design patents as an afterthought or can't seem to find a way to confidently develop meaningful design patent applications. Part of the reason behind this is that the people who make decisions on what to seek protection for and how that protection is sought simply lack the sensitivity to or training in design necessary to think critically about a design and a related patent application.

The fact is that many of the people pulling the trigger on a design application don't know good design, don't think good design is important and most often don't even have a good design. This should not come as a surprise to industrial designers, because this mirrors the perception that designers have of the business world at large. The fact that there are thousands of poorly designed products in the world should make it understandable why so many dubious design patents exist as well.

The other part of the reason for why people have such a hard time developing good

design patent strategies is that those who are used to the utility patent process aren't accustomed to having to think too critically about their patents. The utility application process is often relatively easy for a client because the subjects of utility applications generally involve the inner-workings or the physical and mechanical aspects of a product, which are squarely within a patent lawyer's likely area of expertise. This means that all of the important things that go into drafting a utility patent are often taken for granted by an inventor or client because they are based almost solely on the work of the IP lawyer.

You see, to be able to file a patent with the Patent Office for someone else, one must be registered with the USPTO. This requires taking and passing a test that covers all the rules of patentability and various patent office procedures. But to even be eligible to take the test, that person must have a technical or science background. This requirement applies to filing both utility and design applications. There is no separate or corresponding requirement that a patent attorney who files a design patent have any experience or understanding whatsoever with respect to any principles of design, and the vast majority don't. This means that most of the time a lawyer working on a patent for a designed product will have an engineering degree, often in mechanical engineering.

I'm not bringing this up to equate an industrial designer's potential interaction with a patent lawyer with the sometimes strained relationships between designers and engineers. Nor am I trying to suggest that patent lawyers in general are unable to handle design patents. My point is that the relationship between a designer and a patent lawyer might need to be adjusted when design patents are involved. Designers might need to be wary of patent lawyers who seem immediately dismissive of design patents in general and should look for a lawyer that at least seems willing and able to work with them in actually understanding the ins and outs of a design. This can even include giving a reasoned opinion that in a particular case, a design patent is not worth pursuing.

In most cases, however, the principles of three-dimensional visual design are completely foreign to patent attorneys. Beyond that, design sensitivity is not even a skill that most patent attorneys know exists. Given this lack of understanding or appreciation, it's not hard to see why design applications don't get the same treatment as utility patents. Most often no one takes the time to appropriately consider a design before filing a design patent application. But somebody needs to identify and isolate the important and innovative features or characteristics of an overall design and to think about how to place them in the right context with the correct amount of breadth and layering of coverage. The result of a failure to do so may result in a low-cost, low value application that I discussed above.

A designer shouldn't expect to simply give a lawyer some pictures of a product or even renderings or CAD screenshots, and have that lawyer break down a design to determine, for example, how the relationships between surfaces are important to a design. If you first take the time to actually tell them that's what's important, however, a patent lawyer should know how to focus a design patent application on those important things. They can also have a discussion with you about whether that simple relationship is enough for a patent or if other considerations need to be woven in. The point is that designers should

enter into the design patent process with the knowledge that they can protect parts of a design, not just the whole, and an idea about where their protection should be focused.

From this we can see what each person brings to the table in an ideal setting. The designer should take the time to communicate to the patent lawyer what's important and what's not and how it can be broken up to separately claim important parts of the design. The lawyer should take all this in and develop a strategy to best protect the designer's work within the framework of the patent laws and Patent Office rules as well as the client's budget. This type of a relationship can help to ensure that design protection, whatever the final cost, leaves the inventor with not just a patent number or two, but actual valuable patent protection.

PART 4: PRACTICAL ADVICE FOR DESIGNERS

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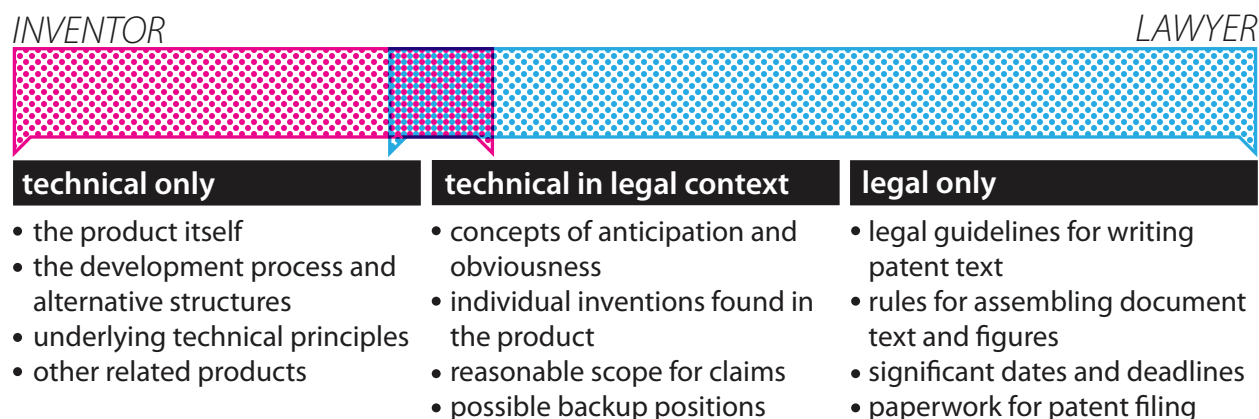
Our articles so far have laid the foundation to repair the broken image of design patents. While this can help you argue for the resources to seek design patent protection, we also need to learn what to do to make sure that the design patents you seek end up meeting the expectations that you set for them.

A big part of the reason for requiring patent lawyers to have a science or technical background is to put a lawyer and inventor-client on the same page from the beginning of the patent drafting process. As illustrated in the graphic below, the knowledge involved in putting together a patent application has three components. First, someone needs to have deep knowledge of the product itself including how it works, how it was designed and what's unique about it. Clear on the other side of things, there needs to be deep knowledge of patent law, including all of the patent office rules, the legal limits of what you can claim and how and all of the various legal traps that one can fall into when writing a patent application.

Somewhere in the middle, though, there's a section of knowledge that requires viewing the product itself from a legal perspective. This involves all of the considerations discussed in the other parts of this article, including what to claim as individual inventions, what is the broadest coverage that you should seek and what backup positions should be included. On top of that, it also involves how to describe a product within the context of all the legal rules and requirements to achieve the type of coverage desired.

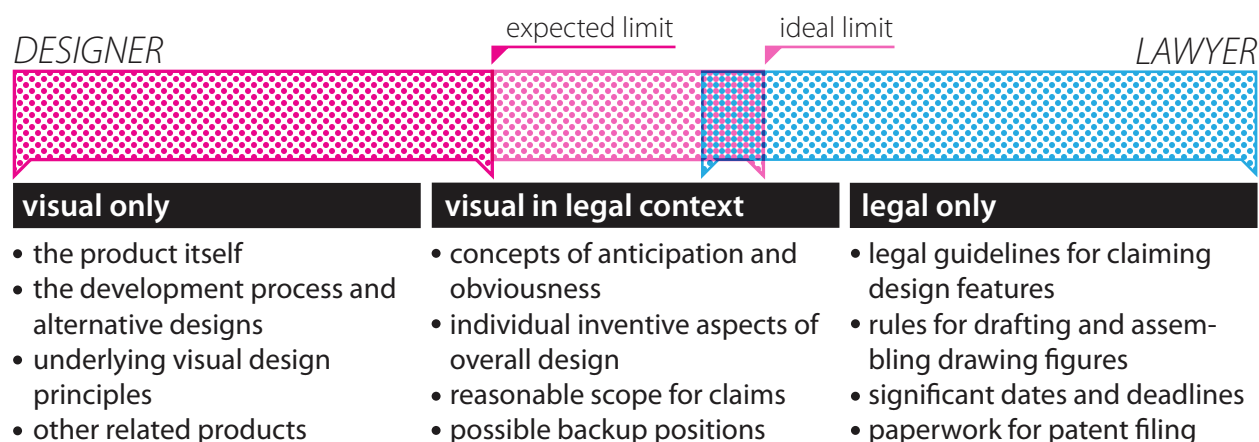
When a lawyer's technical background aligns with the area of the product being patented, the lawyer can handle the bulk of the middle section, as illustrated in the graphic below. The lawyer can generally describe the requirements for a patent including the theories of novelty and obviousness to help the client understand what the lawyer is doing. These bits of patent law knowledge can also help the client make decisions that balance potential coverage with real-world considerations such as cost and timing.

UTILITY PATENT KNOWLEDGE BASE: CONTRIBUTION BETWEEN INVENTOR AND LAWYER



On the other hand, when dealing with design patents, there will likely be much less of a knowledge overlap between designer and lawyer. As illustrated below, there are many instances where there is no overlap at all or even a substantial gap in knowledge that really prevents the lawyer and designer from getting on the same page and developing a good working relationship. This, in turn, can prevent the lawyer from knowing what really needs protection within an overall scheme and can also prevent the designer from fully appreciating that something could be done.

DESIGN PATENT KNOWLEDGE BASE: CONTRIBUTION BETWEEN DESIGNER AND LAWYER



All of this can really make it seem like an uphill battle for designers seeking a comfortable level of design protection. Do they first have to educate a lawyer on the finer points of design to close the knowledge gap? Do they, instead, have to first learn all there is to know about patents and patent strategy before discussing things with a lawyer? In a perfect world, yes, both sides could do a little extra work to close this gap, but as a more practical solution, I've developed a short list of questions that designers can ask themselves as a beginning to the design patent process. These questions are aimed to help designers start to bend their thinking toward the patent side of things. They can help designers put things

in terms that a lawyer can use and understand.

- **What individual features of your design would you be upset to find in another product?**
- **What about those features is unique or how are they used in a unique way in the context of your overall design?**
- **What are the considerations that lead to the ultimate design of those features? Do the features serve a purpose (such as causing eye movement or establishing dominance) or are they somehow related to other features of the overall design?**
- **What would a copyist likely change about the design to try and avoid a basic design patent while making a knock-off the design?**

Continuing to keep these questions in mind throughout the application process can help designers ensure that they're moving in the right direction toward getting meaningful and valuable design patents. The first two questions will help to determine the features that are to be the focus of the design protection strategy by isolating the features that are both important and are likely to meet the requirements of novelty and nonobviousness. The third question can give insight into how to set up the drawings to put the claimed design in the proper context. This thinking can help ensure that the inventive portions of the design are communicated well enough for others, like a patent office examiner or a would-be copier, to understand.

With the fourth question, we're taking a slightly different angle. By thinking about how someone else would try to change "just enough" of your design to try and avoid infringement, you can get some insight into the less important features that can be left unclaimed in portions of an overall strategy. It's not always easy, however, to simply exclude features entirely, especially if those same features pop up in your answers to the third question. In those circumstances, it can be worthwhile to consider essentially designing your own knock-offs and then filing on those designs.

In many instances, the design development process will have already given you some close, but not quite right, alternatives in the form of earlier iterations of the final design or other design directions that you explored. Unlike trademarks, there is no requirement that a design be applied to a product that is actually sold. Accordingly, filing design applications on reasonable alternatives can be a good way to give a little competitive distance. A similar strategy is often implemented in drafting utility application claims, but people don't often think this way on the design side.

Of course, not every project includes an IP budget that can cover the extensive strategies that can arise from thinking in the context of these questions. Even still, these questions can make sure that trimming coverage to reduce cost won't eliminate coverage of the most important things. As I mentioned above, there are also ways to defer some costs and filing decisions until a later date by piggy-backing broader design claims off of an initial application. That initial application has to include all the information needed for any

subsequent applications so it's important to be in the right frame of mind, regardless of how comprehensive your budget at that time allows.

It can be difficult to anticipate how successful a design is going to be and how much protection you'll actually need, and no one wants to end up a few thousand extra dollars in the hole for design patents covering an unsuccessful design. While that is certainly a risk, it can be even worse to skimp on coverage or to ignore it altogether at an early stage and then end up with a successful design with a lot of imitations from competitors and little to no recourse. Designers, corporate counsel and patent attorneys have been unwittingly doing this for years and the result has been disastrous for individual design patents and the overall reputation of the design patent system.

Throughout this article, we've included images from old, expired design patents covering some of the most significant products of industrial design in the last century. The illustrations depict brilliant, significant works in the field of design. The patents themselves, however, represent a far too narrow approach to protecting designs. These designers and their lawyers get a pass because the entire patent system was notably different back when these patents, even the one for the original Mac, were filed. The modern approach to design patent coverage, even before *Apple v. Samsung*, allows us to do much more with our design claims than what we see in these patents. Now, with the increased attention to design patents as a real form of protection it's critical to use the kind of strategy explained in these articles.

Valuable design patents are available, but designers need to be active in the process. Fortunately, this doesn't have to mean learning all the intricate Patent Office rules or reading court decisions involving design patents. Designers need to simply devote a little effort and take a few extra steps to make sure that their design patents reflect what makes a design worth implementing in the first place. In the short term, the effects of this can be seen in the small scale, giving the designers who follow these guidelines the kind of protection they would expect from the cost of patents. Of course, the cumulative effect of putting a significant number of good design patents into the system can only benefit the field of industrial design as a whole, strengthening the viewpoint that designs are assets and investments to be protected.

LINKS

¹ http://www.core77.com/blog/business/for_one_company_product_shape_trade-mark_protection_victory_is_sweet_22929.asp

² http://scholar.google.com/scholar_case?case=15514217710328300214&hl=en&as_sdt=2&as_vis=1&oi=scholar

³ <http://www.patentlyo.com/patent/2010/03/crocs-inc-v-us-international-trade-commission-itc-fed-cir-2010-in-the-matter-of-certain-foam-footware-in-2006-t.html>

⁴<http://www.fastcodesign.com/1665235/how-samsung-designed-its-new-galaxy-nexus-to-skirt-apples-ip>

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ABOUT MICHAEL HAGES

Michael Hages is an intellectual property attorney with the firm Lerner, David, Littenberg, Krumholz and Mentlik, LLP.* He studied industrial design at Pratt Institute in Brooklyn, NY, and has a degree in Mechanical Engineering from The University of Michigan and a J.D. from the University of Dayton. He has seen first hand that the work of industrial designers can produce incredibly nuanced legal issues but suffers because too many lawyers don't even know what industrial design is.

Michael has experience guiding clients through complicated IP issues relating to design and utility patents in areas including consumer electronics, transportation technology, medical devices, footwear, and apparel. He is working to bridge the gap between law and design through education, by working directly with designers, and by developing ways to use patent law to better serve the field of design.

* The views expressed herein are solely those of the author and do not necessarily represent the view of his firm or its clients.