



# Design Patents

Industry & Invention

Eric E. Johnson

[ericejohnson.com](http://ericejohnson.com)



Konomark  
Most rights sharable

*Note: I've leaned very heavily on Prof Sarah Burstein's work in putting together the examples and analysis in this slidedeck.*

## Design patent basics

- Term:
  - 14 years from issuance (pre May 13, 2015 applications)
  - 15 years from issuance (post May 12, 2015 applications)
- Design can include configuration/shape of article, surface ornamentation, or a combination of shape and surface ornamentation.

## Design patent basics

- Claimed with a single claim that references the drawings: “The ornamental design for [the article] as shown.”
- Design patent numbers have a “D” prefix.



(12) United States Design Patent (16) Patent No.: US D656,295 S  
 Tokarz (15) Date of Patent: Mar. 20, 2012

(34) HEARTSTONE ENHANCEMENT

(36) Inventor: Bernard Tokarz, Houston, TX (US)

(73) Filing Date: 14 Years

(21) Appl. No.: 28766,774

(22) Filed: Apr. 18, 2010

Related U.S. Application Data

(43) Continuation-in-part of application No. 29722,827,  
 filed on Sep. 2, 2009, now abandoned.

(51) Int. Cl. Class. D06F 01/00

(52) U.S. Cl. Class. 28/280

(56) Field of Classification Search 280/124,  
 271/18, 18, 27, 40, 52/140, 68/242,  
 101/139, 145, 207/98, 111

See application file for complete search history.

References Cited

U.S. PATENT DOCUMENTS

5,161,814 A \* 11/1995 Denzler 42/400

5,107,062 S \* 7/2002 Song 28/280

5,947,082 S \* 1/2000 Song 28/280

2009/01528 A1 \* 7/2009 Song 28/280

FOREIGN PATENT DOCUMENTS

67988 A1 \* 4/2006

\* cited by examiner

Primary Examiner - Michael Poon

(74) Attorney, Agent or Firm - Hines, Hadden, Korman,  
 Blocker, H.K. Law Group

(57) CLAIM

The ornamental design for a headdress enhancement, as  
 shown and described.

DESCRIPTION

FIG. 1 is a front view of an ornamental headdress enhance-  
 ment according to a first embodiment of the present inven-  
 tion.

FIG. 2 is a back view of the headdress enhancement of FIG. 1.

FIG. 3 is a top plan view of the headdress enhancement of FIG. 1.

FIG. 4 is a bottom plan view of the headdress enhancement of FIG. 1.

FIG. 5 is a right side view of the headdress enhancement of FIG. 1.

FIG. 6 is a left side view of the headdress enhancement of FIG. 1.

FIG. 7 is a front view of the headdress enhancement of FIG. 1.

FIG. 8 is a perspective view of the headdress enhancement of FIG. 1.

The reference numerals are for purposes of illustrating various  
 structural features that form or part of the claimed design.

FIG. 1

FIG. 2

FIG. 3

FIG. 4

FIG. 5

FIG. 6

FIG. 7

FIG. 8



U.S. Patent Mar. 20, 2012 Sheet 3 of 3 US D656,295 S

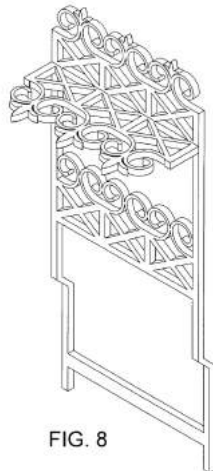


FIG. 8



### **Design patents compared to utility patents**

- Design patent is for an “ornamental design”
- Utility patent is for a “useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”
- Design patents are much, much easier to get.

### **Design patents: Source of law**

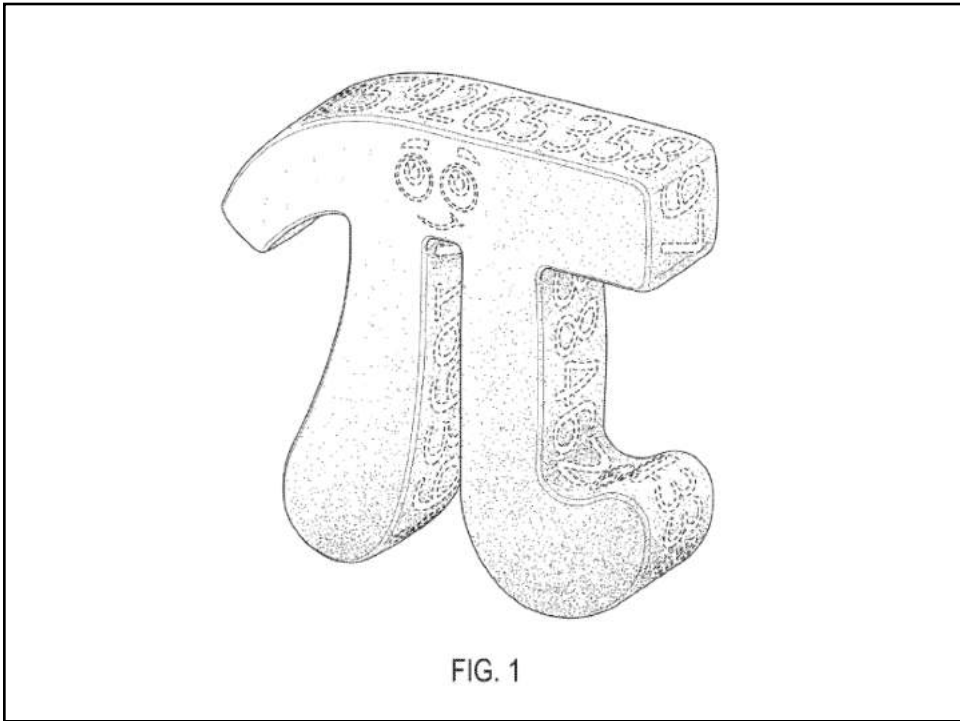
- Like utility patents, design patent are exclusively a creature of federal law.
- 35 U.S.C. § § 171-173, with § § 102, 103, 112, and other sections being applicable as well

## Design patents enabling provision at § 171

- “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. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”

## Design patents requirements

- novelty ← same as for utility patents
- originality
- nonobviousness ← not much of a limit
- ornamental (not dictated by function)
- on a functional article
- enabling disclosure



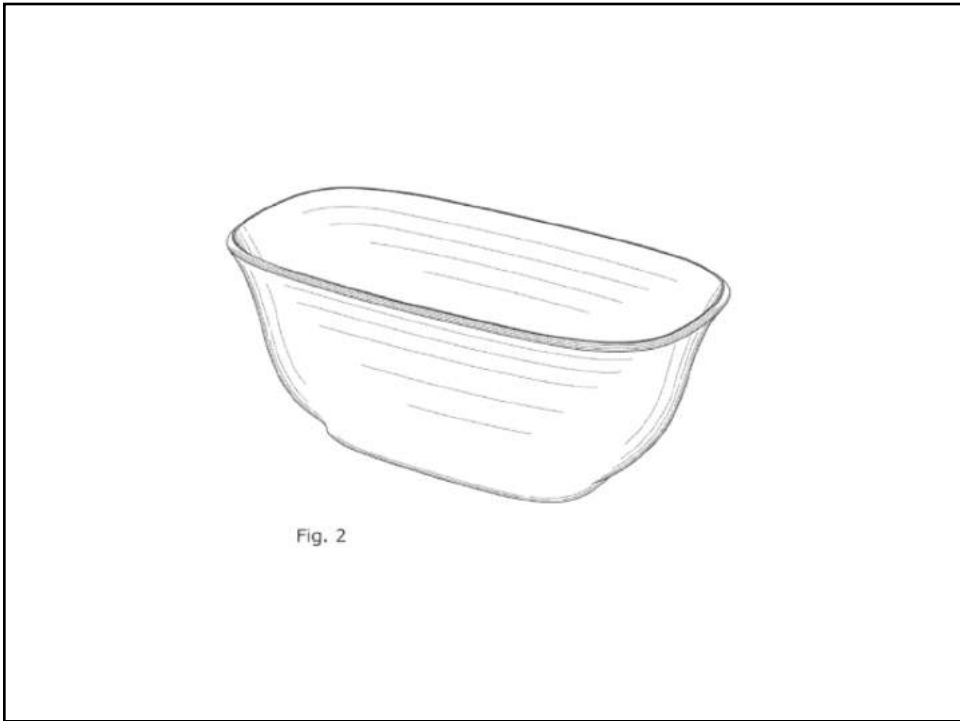


Fig. 2

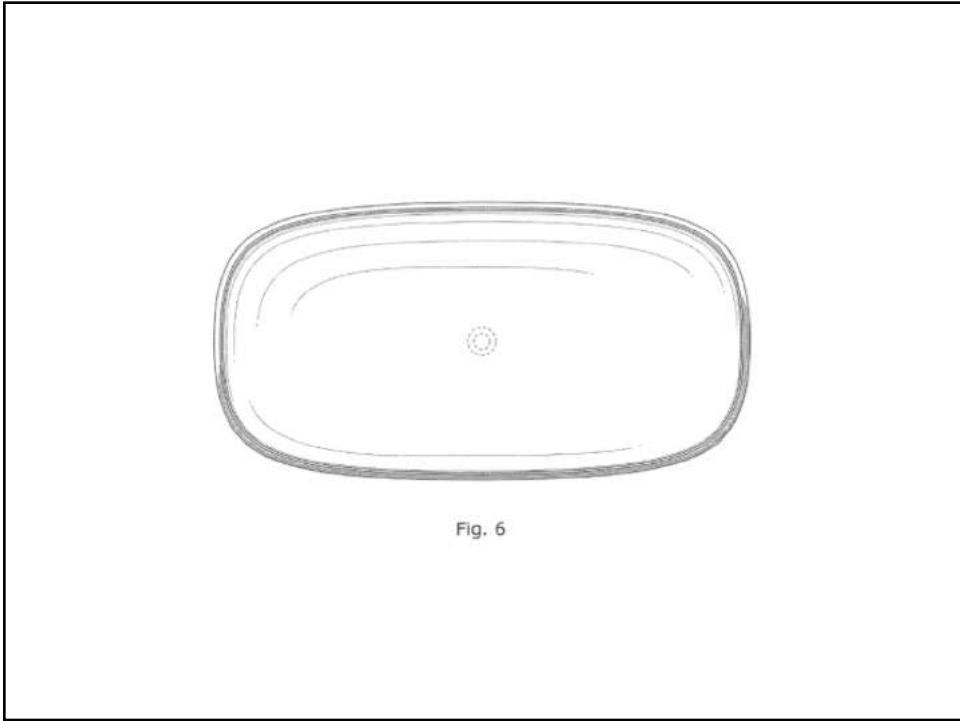


Fig. 6



## Nonobviousness in design patents

"[T]he ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved."

- Titan Tire v. Case New Holland, 566 F.3d 1372  
(Fed. Cir. 2009)

"To answer this question, a court must first determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. That inquiry involves a two-step process."

- MRC Innovations v. Hunter Mfg., 747 F.3d 1326  
(Fed Cir. 2014)

(internal quote and cites omitted)

## Nonobviousness in design patents

### STEP ONE:

"First, the court must identify a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design. The 'basically the same' test requires consideration of the visual impression created by the patented design as a whole. ... [T]he trial court judge may determine almost instinctively whether the two designs create basically the same visual impression, but must communicate the reasoning behind that decision."

- MRC Innovations v. Hunter Mfg., 747 F.3d 1326  
(Fed Cir. 2014)

(internal quote and cites omitted)

## Nonobviousness in design patents

### STEP TWO:

“[O]ther secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. These secondary references must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.”

- MRC Innovations v. Hunter Mfg., 747 F.3d 1326 (Fed Cir. 2014)

(internal quote, brackets and cites omitted)

## Nonobviousness in design patents

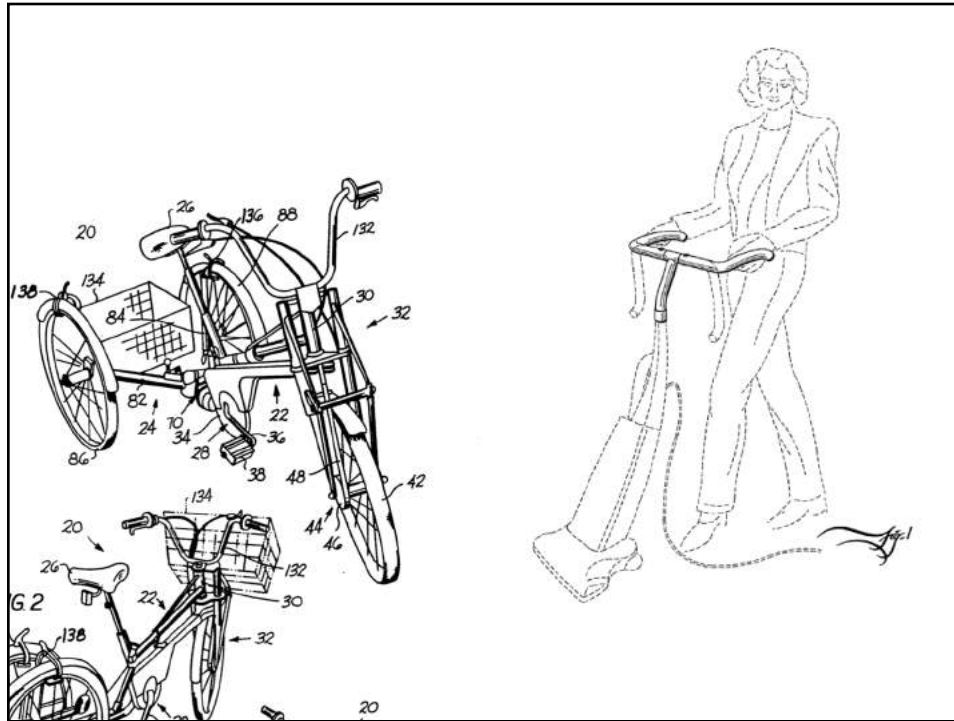
### STEP TWO:

“[O]ther secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. These secondary references must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.”

- MRC Innovations v. Hunter Mfg., 747 F.3d 1326 (Fed Cir. 2014)

“The Federal Circuit hasn’t actually reached the second step of this test in a while. That’s because it has been requiring a very high degree of similarity for primary references. . . . For a while there, it looked like it was becoming practically impossible to invalidate any design patents under § 103. Now we at least know that it’s still possible. But we don’t have much guidance as to when it’s possible.” Sarah Burstein, 2014

(internal quote, brackets and cites omitted)



(12) **United States Design Patent** (10) **Patent No.:** **US D634,488 S**  
**Cohen** (45) **Date of Patent:** **\*\* Mar. 15, 2011**

(54) **FOOTBALL JERSEY FOR A DOG**

(75) Inventor: **Mark Cohen**, Mason, OH (US)

(73) Assignee: **MRC Innovations**, Mason, OH (US)

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/369,427**

(22) Filed: **Sep. 8, 2010**

(51) **LOC (9) CL** ..... **30-01**

(52) **U.S. CL** ..... **D30/145**

(58) **Field of Classification Search** ..... D30/145,  
D30/144, 151-154; 119/678, 850, 673, 702,  
119/712, 792-798, 758, 760, 769, 770, 784,  
119/815, 818, 856, 863, 864, 905, 907, 802,  
119/857, 865, 725, 771; 52/3; 54/79.4, 79.1,  
54/80.1, 79.2; D3/271.2, 217, 327; 150/154;  
36/111; 604/293; 602/79, 61

See application file for complete search history.

(56) **References Cited**

**U.S. PATENT DOCUMENTS**

1,437,255 A	*	11/1922	Mallinson	54/79.2
1,595,834 A	*	8/1926	Griffiths	54/79.1
2,103,109 A	*	12/1937	De Mar	54/79.1
2,273,706 A	*	2/1942	Hafner	54/79.1
2,400,781 A	*	5/1946	Priour	54/79.1
2,417,803 A	*	3/1947	De Mar	54/79.1
3,141,443 A	*	7/1964	Iluey	119/854
D228,926 S	*	10/1973	Bennett	D30/145
3,792,687 A	*	2/1974	Ehrman	119/868
4,095,562 A	*	6/1978	Graham	119/868
4,290,386 A	*	9/1981	Eiriksson	119/868

5,226,386 A	*	7/1993	Thoma	119/869
5,234,421 A	*	8/1993	Lowman	604/385.09
5,359,963 A	*	11/1994	Jesse et al.	119/850
D363,572 S	*	10/1995	Obenchain	D30/145
D368,338 S	*	3/1996	Levengood	D30/144
5,537,954 A	*	7/1996	Beeghly et al.	119/850
5,555,847 A	*	9/1996	Kelly	119/850
5,632,235 A	*	5/1997	Larsen et al.	119/856
5,662,640 A	*	9/1997	Daniels	604/392
D406,410 S	*	3/1999	Pasqua	D30/144
5,887,772 A	*	3/1999	Dooley	224/191
5,941,199 A	*	8/1999	Tamura	119/850
5,954,015 A	*	9/1999	Ohta	119/850
6,024,055 A	*	2/2000	Jesse et al.	119/850
D427,734 S	*	7/2000	Balzarini	D30/145
D429,390 S	*	8/2000	Grady et al.	D30/152
D429,391 S	*	8/2000	Grady et al.	D30/152

(Continued)

Primary Examiner — Susan Moon Lee

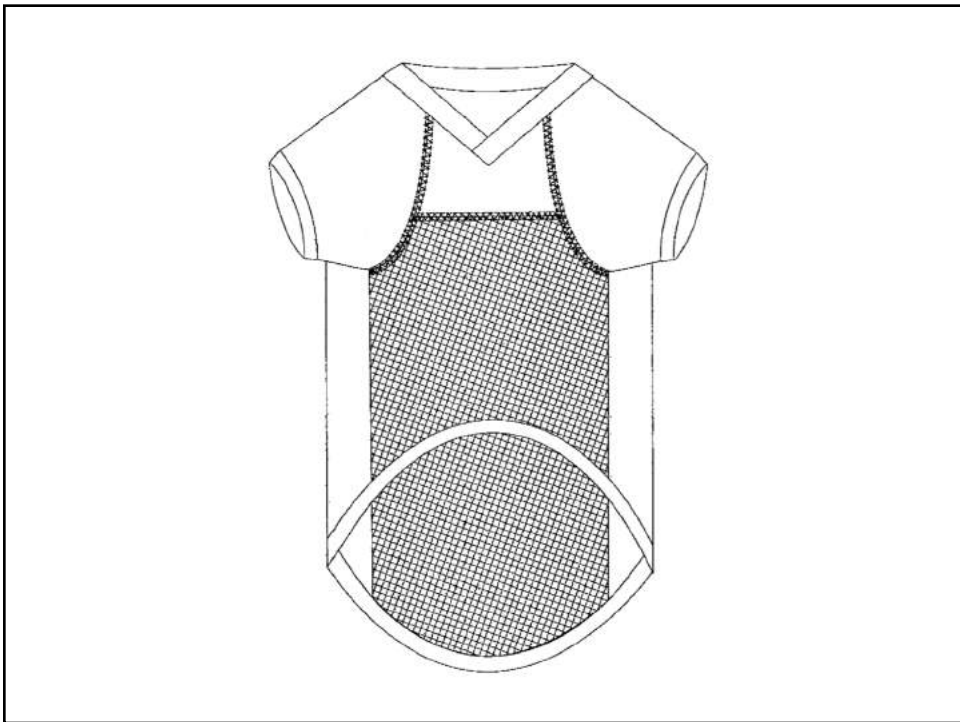
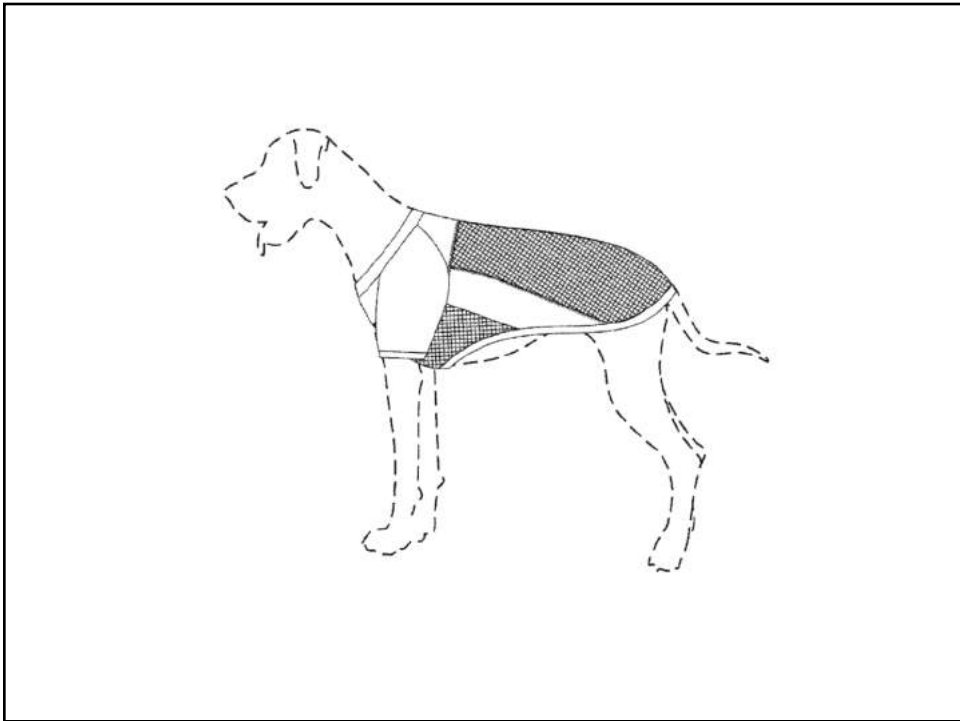
(74) Attorney, Agent, or Firm — Rankin Hill & Clark LLP

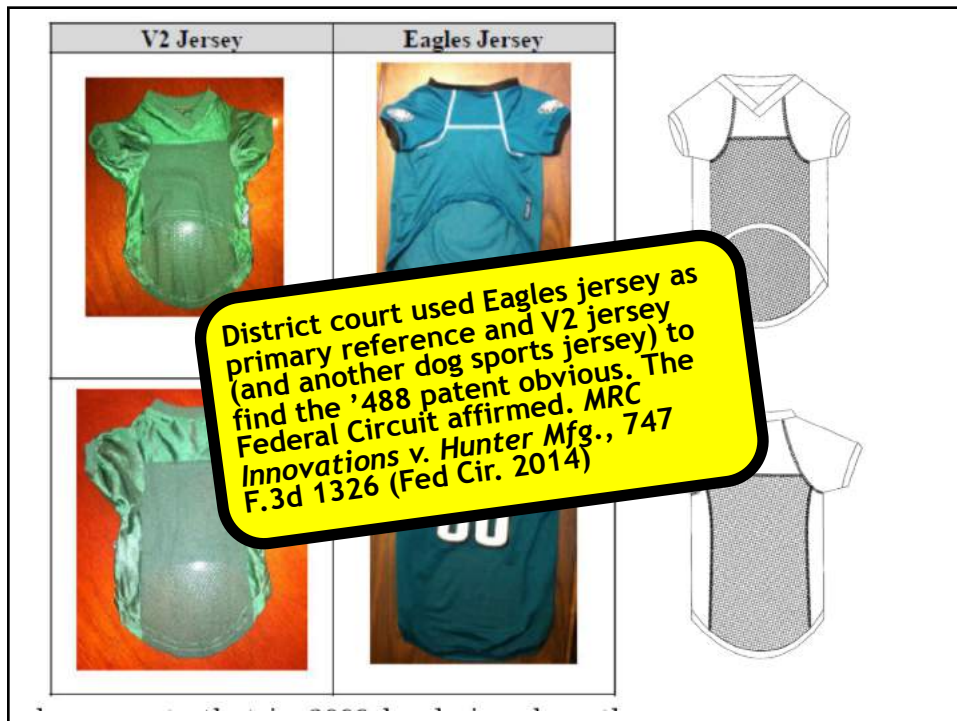
(57) **CLAIM**

I claim the ornamental design for a football jersey for a dog, as shown and described.

**DESCRIPTION**

FIG. 1 is a side view of a football jersey for a dog shown in use;  
FIG. 2 is a front elevational view of the football jersey shown in FIG. 1;  
FIG. 3 is a right side elevational view of the football jersey shown in FIG. 1, the left side of the football jersey being a mirror image thereof; and,  
FIG. 4 is a top plan view of the football jersey shown in FIG. 1.

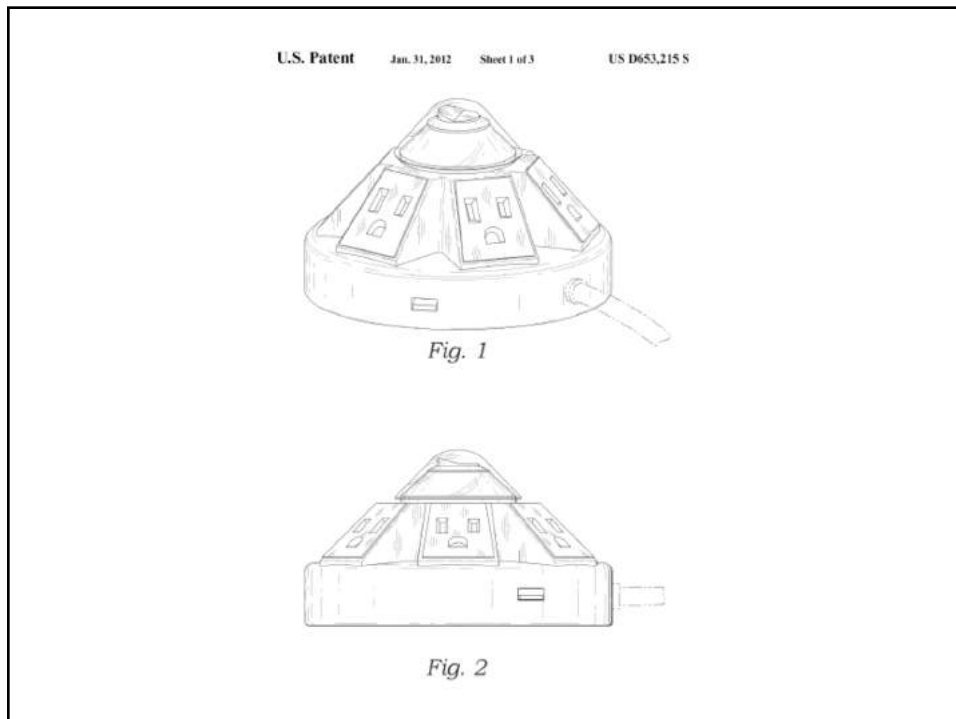




## Design patents - claims and infringement

- Design patent claims are essentially the drawings.
- Infringement involves comparing the accused article to the drawings using the standard of an “ordinary observer” who has access to the prior art.
- “[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”

- Gorham Mfg. Co. v. White, 81 U.S. 511 (1871); see also Advantek Mktg. v. Shanghai Walk-Long Tools, 898 F.3d 1210 (Fed. Cir. 2018) (quoting)





Before 2012, many considered design patents “worthless.”

Then ...





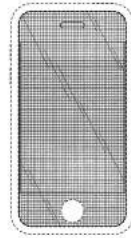


FIG. 3



FIG. 4



FIG. 7

FIG. 8



FIG. 5



FIG. 6

<p><b>'D677 Patent</b></p> 	
<p><b>'D790 Patent</b></p>  <p>FIGURE</p>	
<p><b>'D016 Patent</b></p> 	



### some practice ...

Oren, an industrial designer, has created a new desk lamp. It does not work differently than other desk lamps, but it's very exotic and cool looking. What can Oren likely obtain?

- (A) a utility patent, but not a design patent
- (B) a design patent, but not a utility patent
- (C) both a design patent and a utility patent
- (D) neither a design patent nor a utility patent
- (E) a mask work registration, but not a patent

some practice ...

Oren, an industrial designer, has created a new desk lamp. It does not work differently than other desk lamps, but it's very exotic and cool looking. What can Oren likely obtain?

- (A) a utility patent, but not a design patent
- ➡ (B) a design patent, but not a utility patent
- (C) both a design patent and a utility patent
- (D) neither a design patent nor a utility patent
- (E) a mask work registration, but not a patent