

Protecting Product Configurations:

Design Patent Focus

*Dallas Bar Association
Intellectual Property Law Section Meeting
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Setting precedent.

What is a design patent?

- A design patent protects a new, original and ornamental design for an article of manufacture.
- “Ornamental Design” refers to surface decoration and/or product shape or configuration (example shown)
- Term = 14 years from issuance
- A design patent includes:
 - **A SINGLE CLAIM:** “The ornamental design for a _____ as shown and described”; and
 - one or more drawings or photographs.

(12) **United States Design Patent** (10) **Patent No.:** **US D530,004 S**
Curtin (45) **Date of Patent:** **** Oct. 10, 2006**

(54) **CEILING FAN HOUSING**

(75) **Inventor:** **Brett Curtin**, Phoenix, AZ (US)

(73) **Assignee:** **Craftmade International, Inc.**,
Coppell, TX (US)

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

(21) **Appl. No.:** **29/241,934**

(22) **Filed:** **Nov. 2, 2005**

(51) **LOC (8) CL.** **23-04**

(52) **U.S. CL.** **D23/411**

(58) **Field of Classification Search** D23/411,
D23/377, 379, 385; 416/5; 392/364
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

D406,332 S * 3/1999 Liu D23/411
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 D499,479 S * 12/2004 Thomas, Jr. D23/411

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MinkaAire Two Thousand One; The Art of Air Management; Mar. 2002; pp. 14 and 15; Minka Lighting, Inc.; U.S.A.

The Concept II 52" & 44" Fan; MinkaAire; pp. 20 and 21; Minka Lighting, Inc.; U.S.A.

* cited by examiner

Primary Examiner—Lisa Lichtenstein

(74) *Attorney, Agent, or Firm*—Haynes and Boone, LLP

(57) **CLAIM**

The ornamental design for a ceiling fan housing, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of the ceiling fan housing showing my new design;

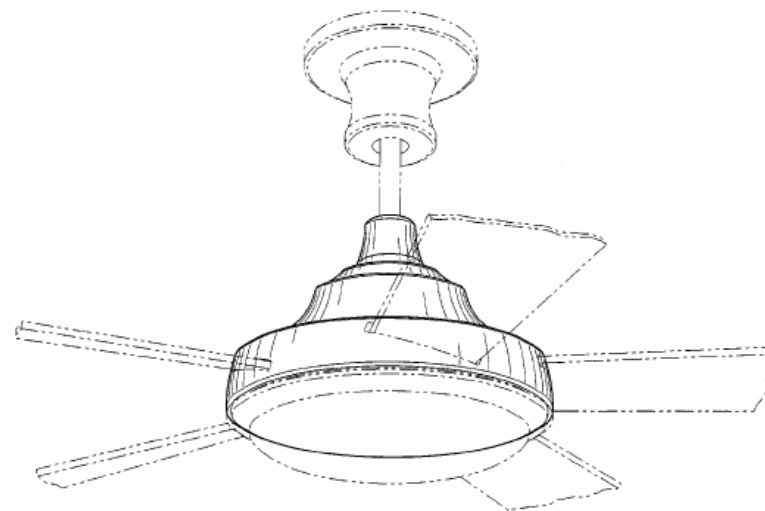
FIG. 2 is a front elevational view thereof, the left side elevational view, the right side elevational view, and the rear elevational view being the same;

FIG. 3 is a top plan view thereof; and,

FIG. 4 is a bottom plan view thereof.

Any broken line illustration of environmental structure in the drawings is not part of the design sought to be patented.

1 Claim, 3 Drawing Sheets



Example of ornamental design including surface decoration...

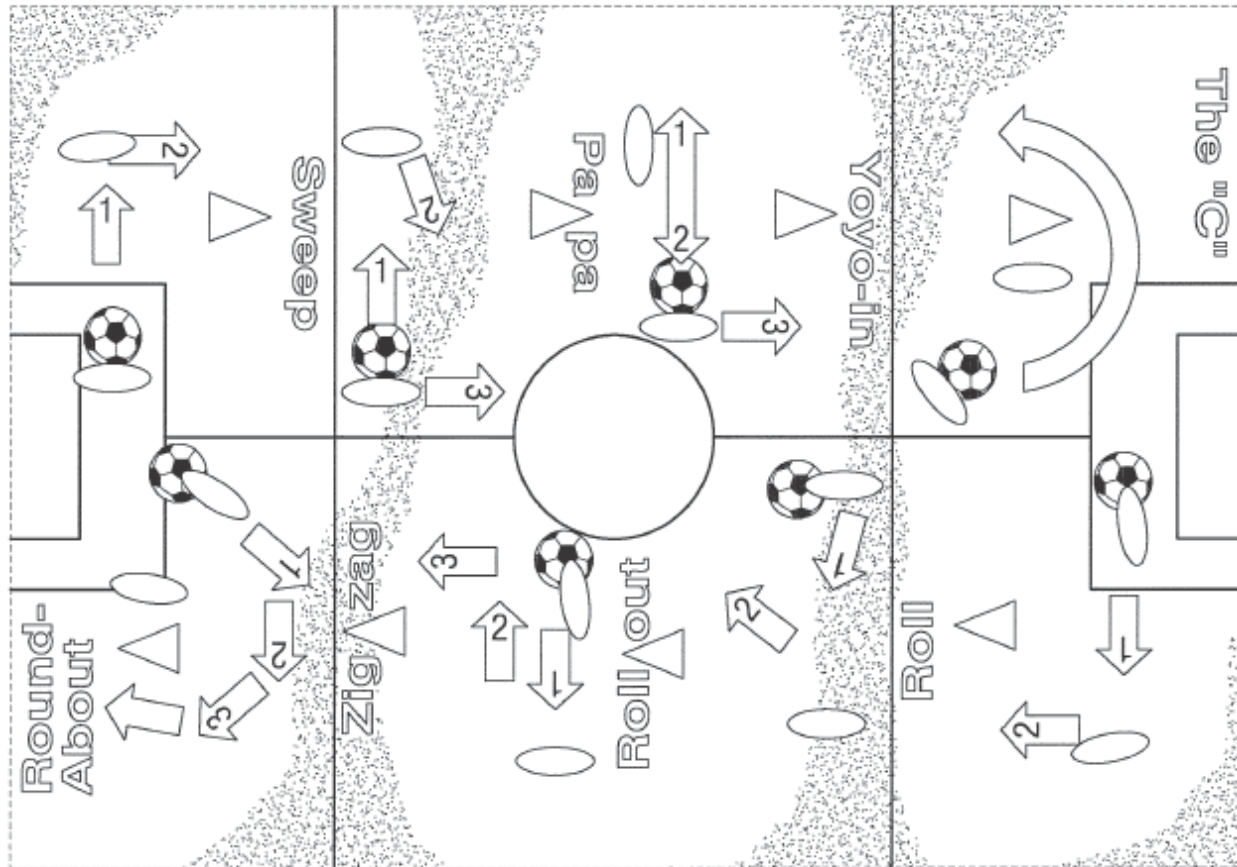
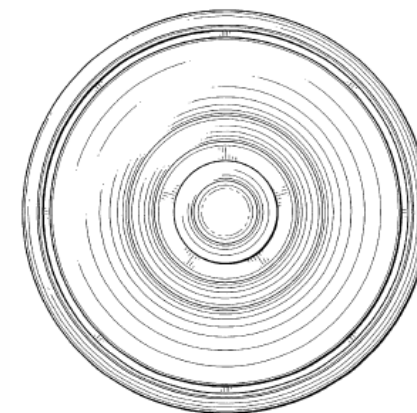
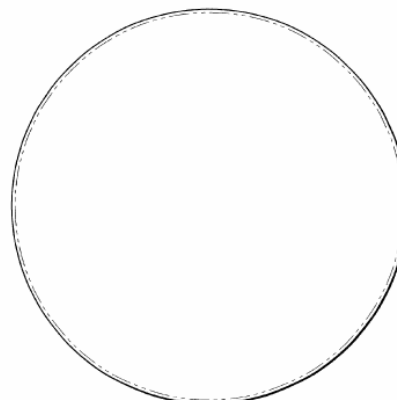
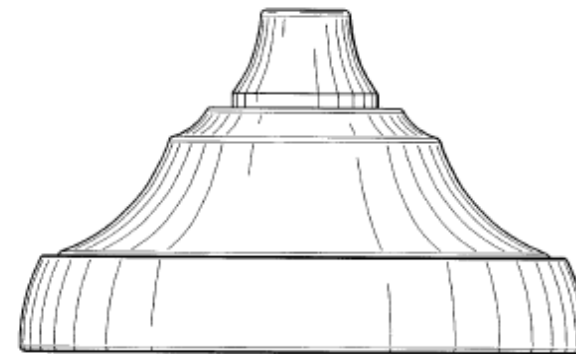
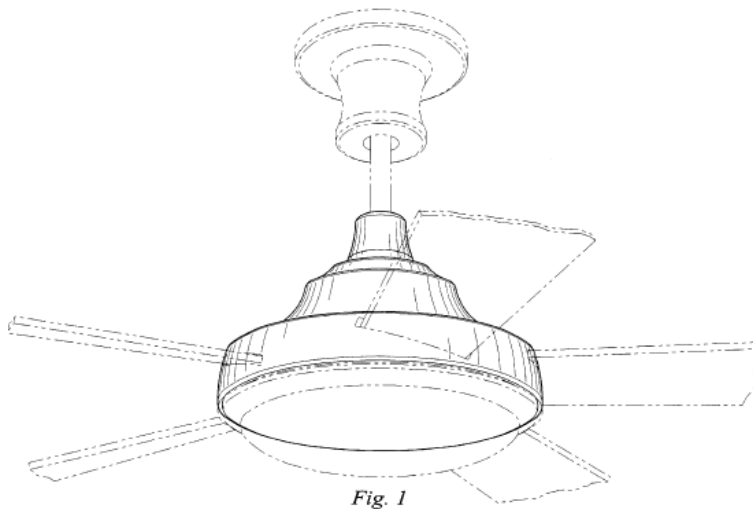


Fig. 2

- To meet the requirements of 35 U.S.C. §112, the drawings or photographs must include a sufficient number of views to constitute a complete disclosure of the appearance of the design claimed.

For example:



Things to consider when analyzing/ preparing design patents/applications...

- The SINGLE CLAIM ***is*** the set of drawings! Protection is sometimes broadened by drawing in **dark** lines only the novel ornamental feature(s) of the article of manufacture.

- ***Which is the broader claim for a ceiling fan blade iron?***

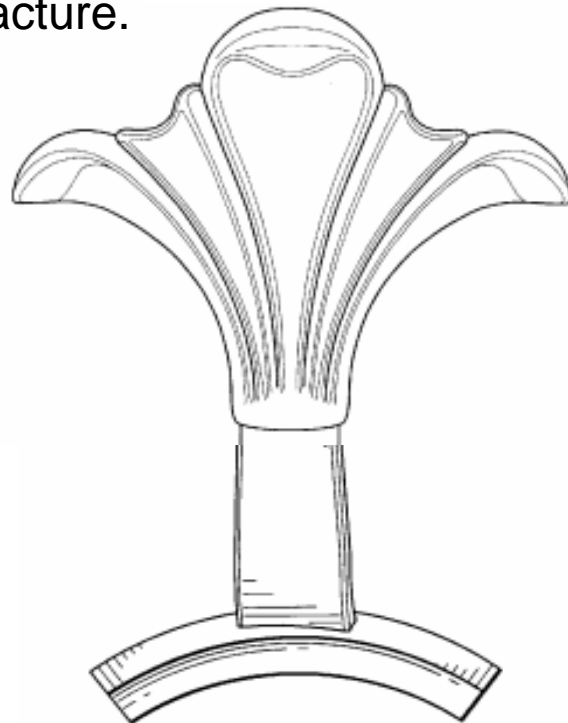


Fig. 7

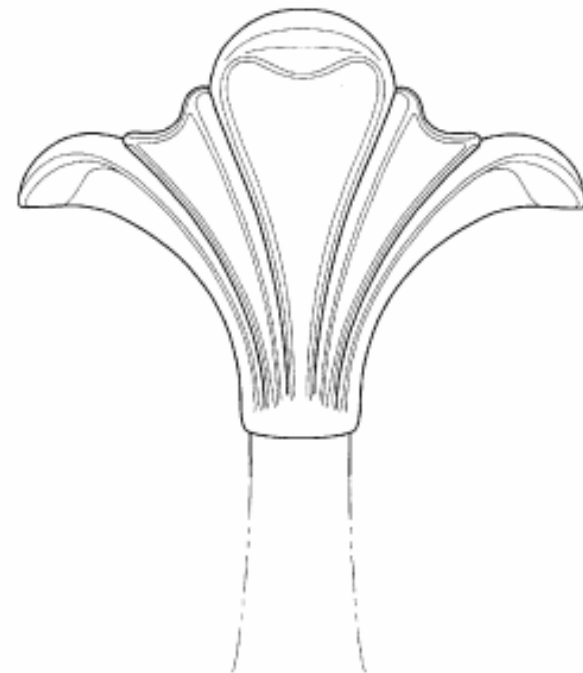
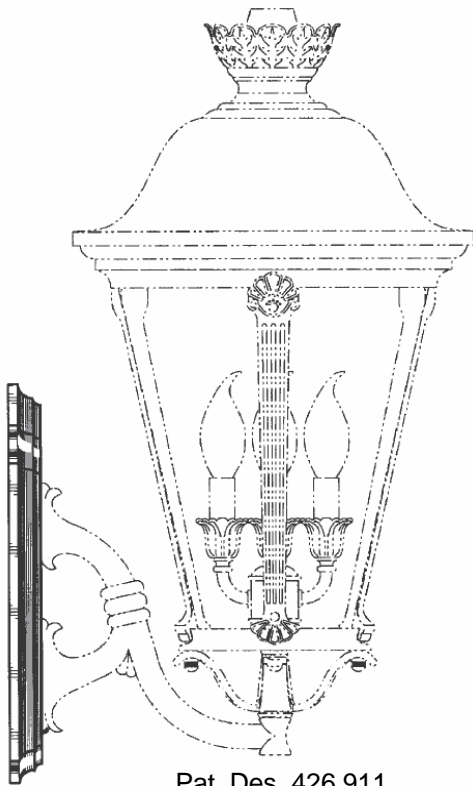


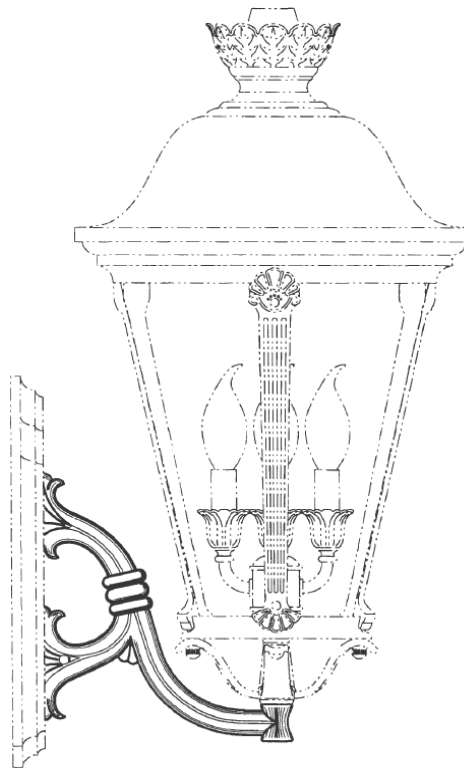
Fig. 4

More things to consider when analyzing/ preparing design patents/applications...

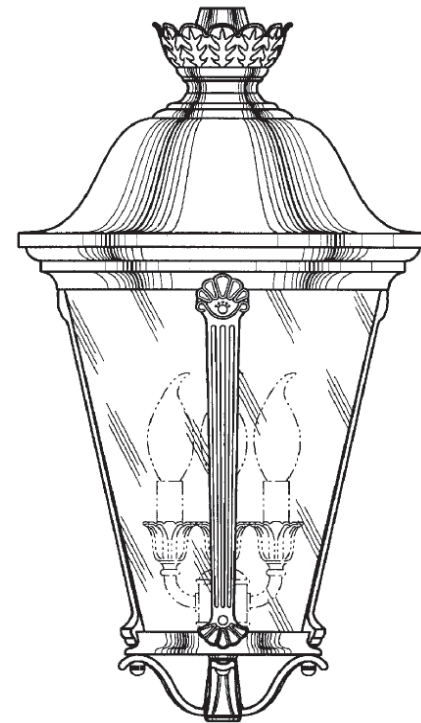
- **Separate applications for different ornamental features are sometimes filed.**
- **For example:**



Pat. Des. 426,911



Pat. Des. 434,873



Pat. Des. 428,662

Even more things to consider when analyzing/ preparing design patents/applications...

- When the broad claim focuses on the novel ornamental feature(s), environmental structure is illustrated in broken lines.
- Text similar to the following is also included at the end of the Description:

“Any broken line illustration of environmental structure in the drawings is not part of the design sought to be patented.” or “The broken lines in the drawings form no part of the claimed design.”

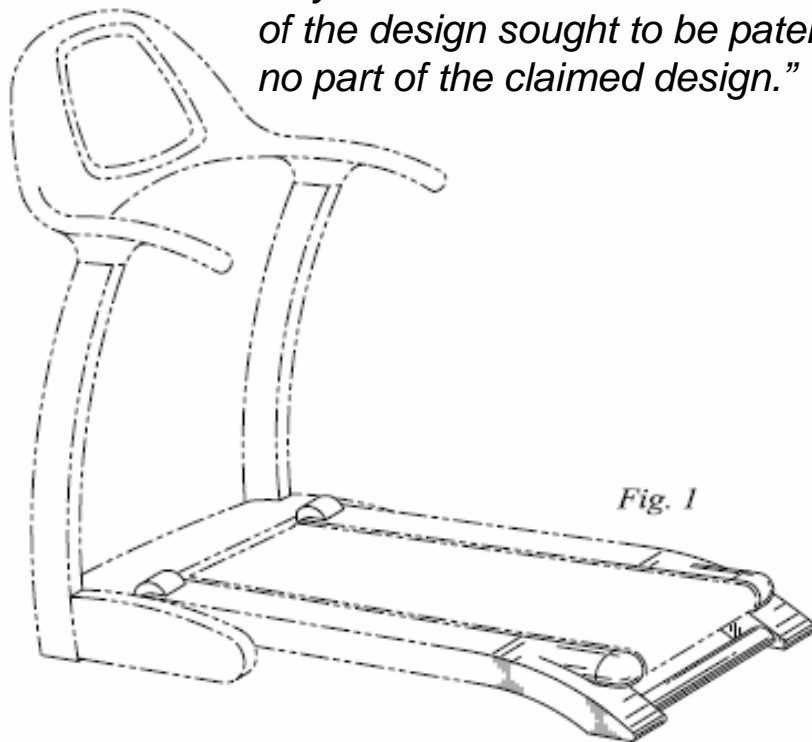


Fig. 2



Fig. 4

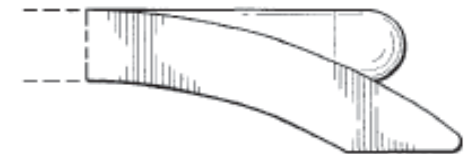
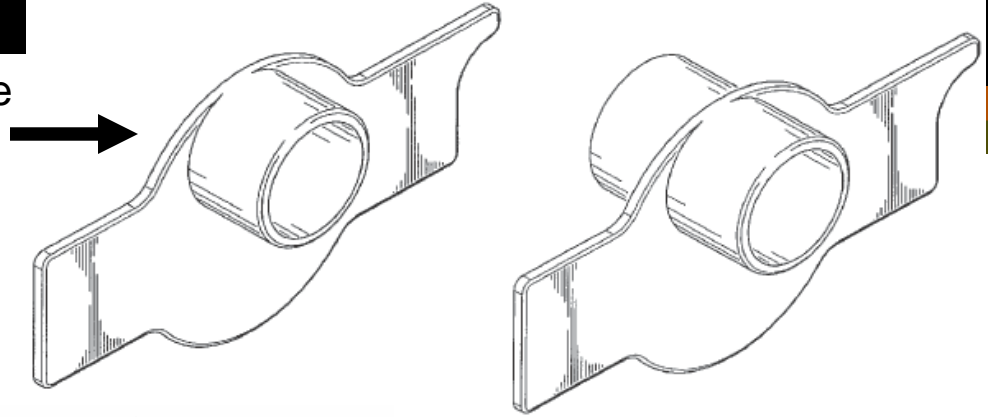


Fig. 3

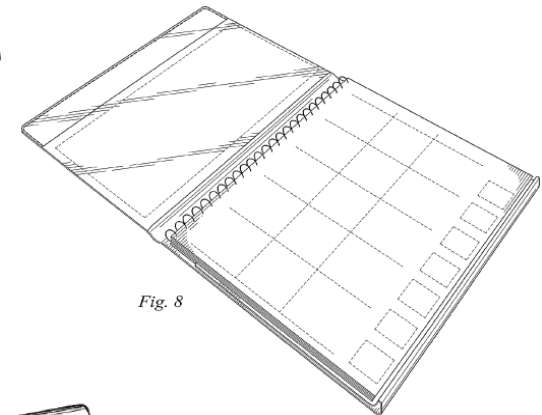
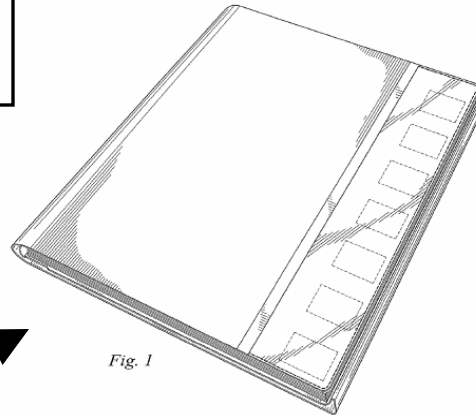
Even even more things to consider when analyzing/preparing design patents/applications...

- Multiple embodiments of a design can be included in an application—but there's only a single claim!! If one embodiment is unpatentable, then the single claim may be properly rejected or found to be invalid.

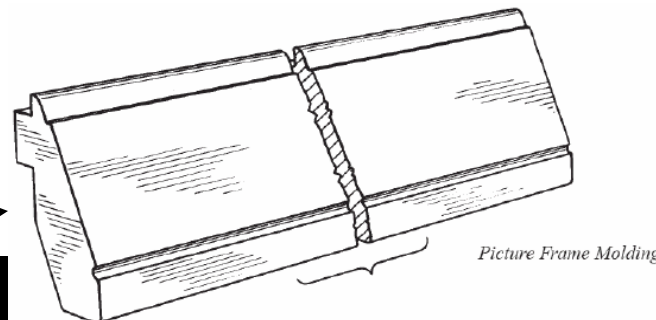


- A design patent application can claim priority to a utility application.

- Movable parts are sometimes depicted in multiple positions using separate figures (your claim is no longer limited to a single position).



Designs can be claimed with indeterminate length



Design Patent Infringement

– **Determining whether a design patent is infringed requires:**

- construction of the patent claim, and
- comparison of the construed claim to the accused product.

– **Construction of the Patent Claim**

- The scope of the claimed design encompasses its visual appearance as a whole and in particular the visual impression it creates.
- A patented design is defined by the drawings in the patent, not just by one feature of the claimed design.
- Federal Circuit has now encouraged district courts to refrain from attempting to provide a detailed verbal description of a claimed design during construction, indicating that a reliance on the illustrations in the design patent is the preferred course (verbal description is not error).
- The drawings are very important!!!

Ye Olde Test

(but somewhat still relevant)

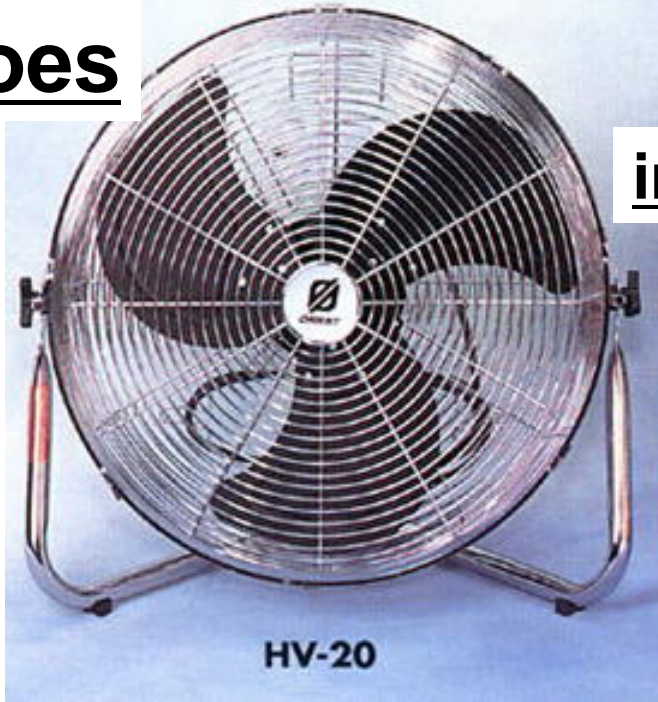
- **Before Sept. 22, 2008**, two tests had to be satisfied to successfully establish a claim for design patent infringement:
 - **Ordinary Observer Test**
 - To support a finding of infringement of a design patent, a patent holder was required to show that the patented design and the allegedly infringing product are, as a whole, substantially the same;

AND

- **Point of Novelty Test**
 - To support a finding of infringement of a design patent, a patent holder was **ALSO** required to show that the allegedly infringing product uses the novel elements shown in the patent.

Ye Olde Design Patent Infringement Example

Does



infringe

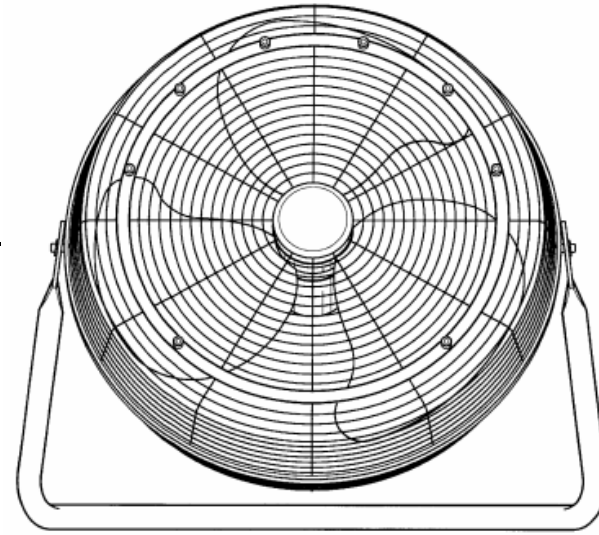


Fig. 1

??

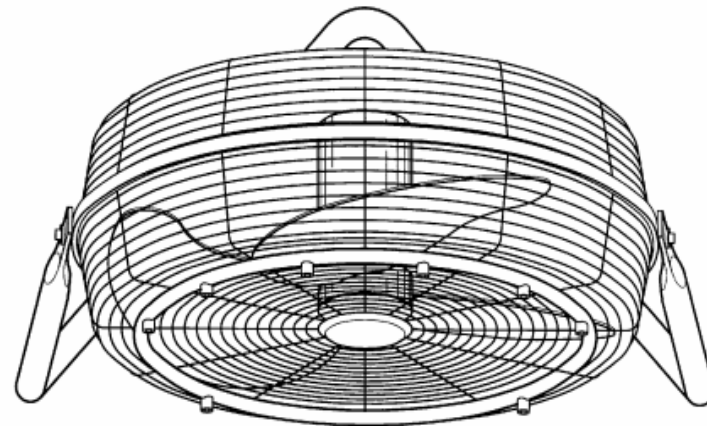


Fig. 5

Ye Olde Example Cont'd

Ordinary Observer Test ?? Point of Novelty Test (compare design patent with prior art) ??

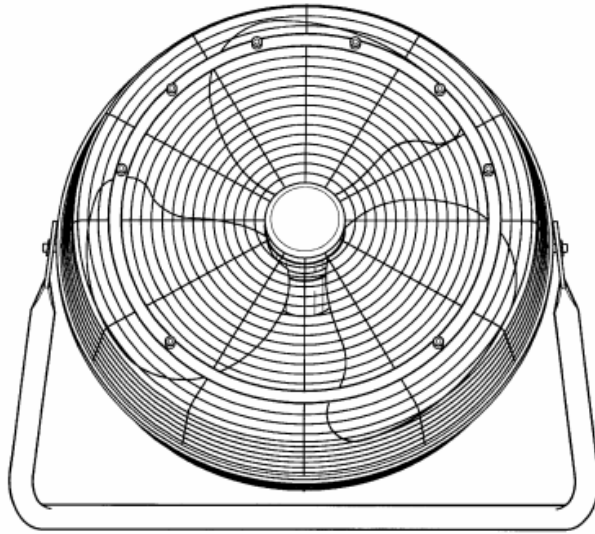


Fig. 1

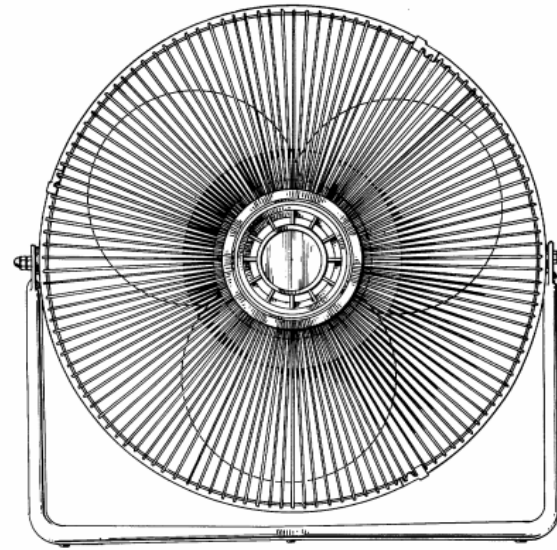


FIG. 1

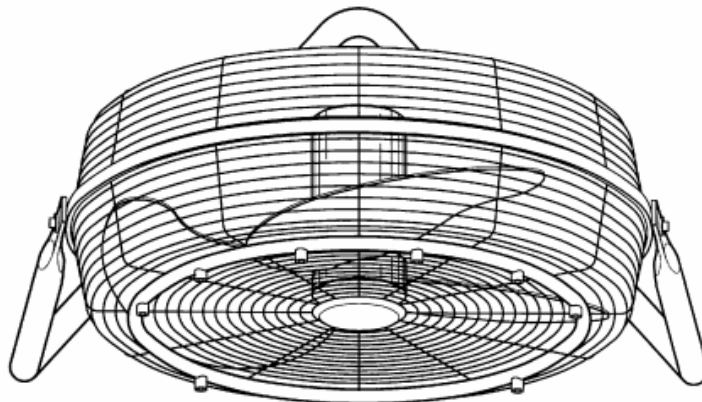


Fig. 5

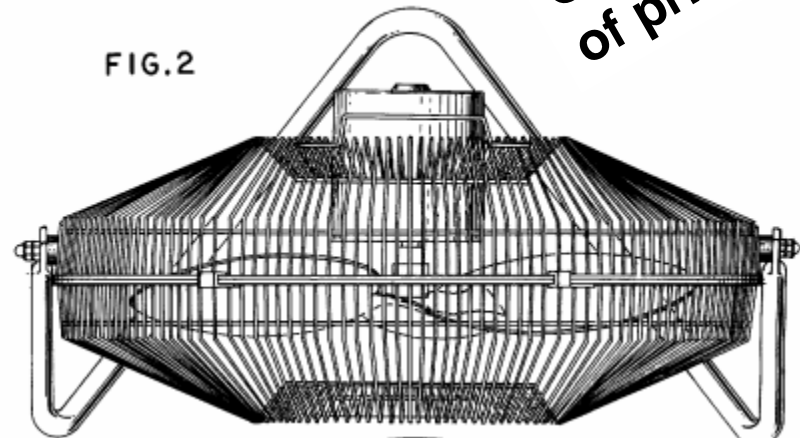


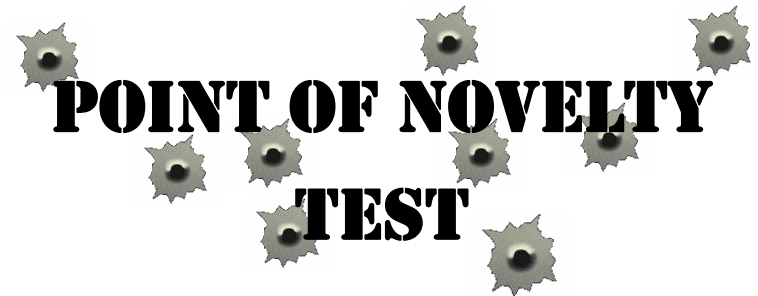
FIG. 2

One example of prior art

The NEW Regime

*Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. Sept. 22, 2008)*

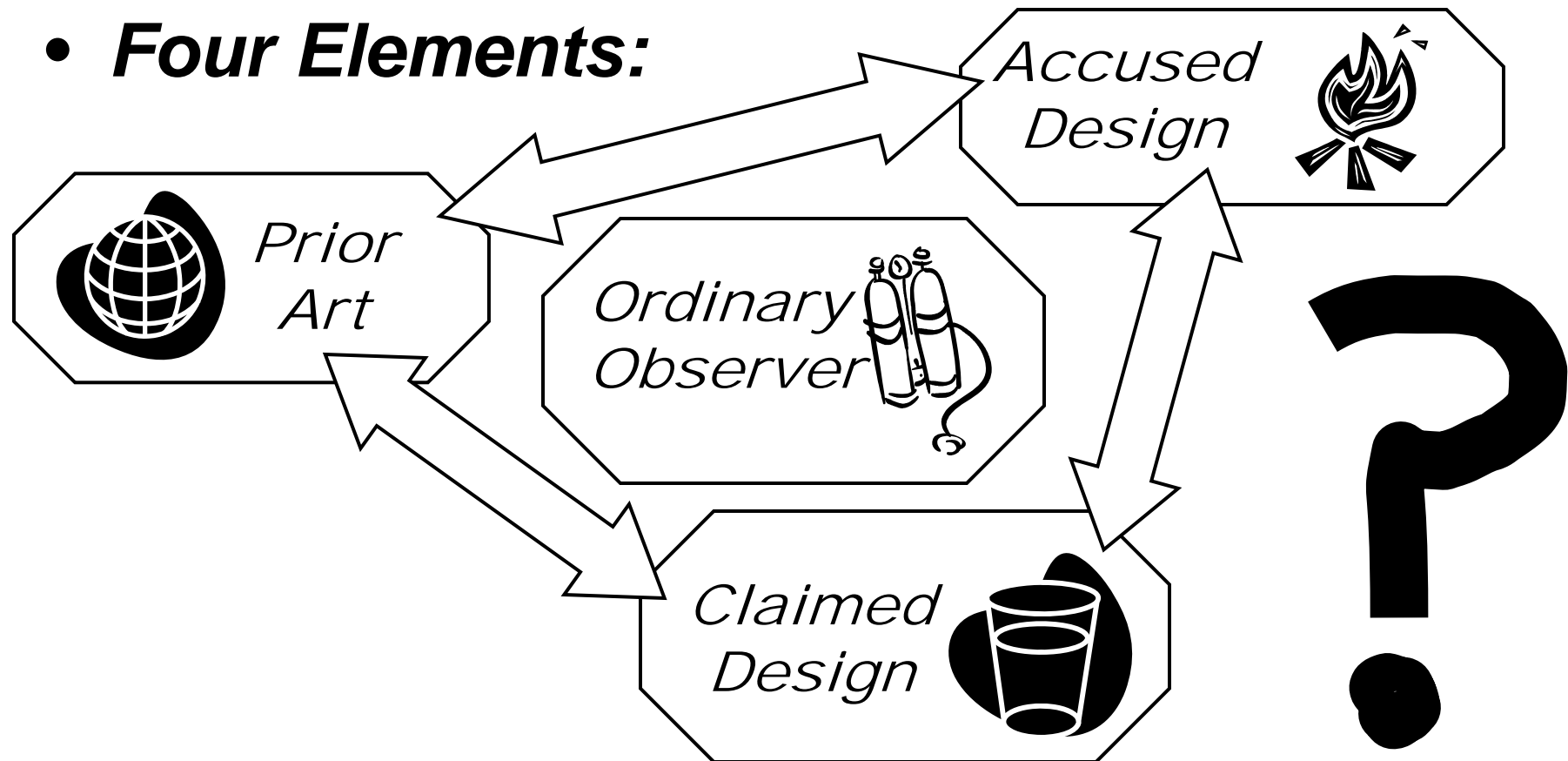
- In *Egyptian Goddess*, the Federal Circuit rejected the point of novelty test, holding that the ordinary observer test should be the **sole test** for determining whether a design patent has been infringed.
- Further, the Federal Circuit **refined** the ordinary observer test:
 - The ordinary observer test is no longer limited to a comparison of the claimed and accused designs, as it typically was rightly or wrongly.
 - Instead, in instances where the claimed and accused designs are not plainly dissimilar, **a comparison of the claimed and accused designs with the prior art is now required under the ordinary observer test** (point of novelty test now somehow embedded in ordinary observer test???)
 - The burden of introducing comparison prior art is imposed on the accused infringer, and the hypothetical ordinary observer is tasked with making the comparison of the claimed and accused designs with the prior art.



How then shall we analyze?

"A comparison of the claimed and accused designs with the prior art is now required under the ordinary observer test"

- **Four Elements:**



A Super-Rough Comparison Attempt

If you're accused of design patent infringement, you want the prior art design(s) to be closer to the claimed design than your accused design



Claimed Design



Prior Art Design(s)



Accused Design



However, if you're asserting design patent infringement, you want the accused design to be closer to your claimed design than the prior art design(s)



Claimed Design



Accused Design



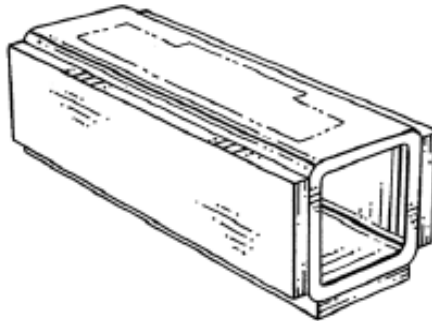
Prior Art Design(s)



The Super-Rough Comparison Attempt applied to Egyptian Goddess

If you're asserting design patent infringement, you want the accused design to be closer to the claimed design than the prior art design(s)

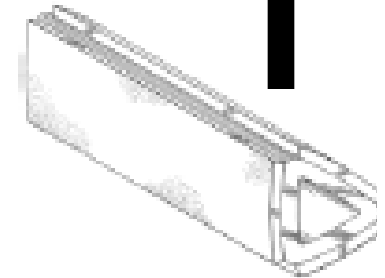
 **Claimed Design**



 **Accused Design**



 **Prior Art Designs**

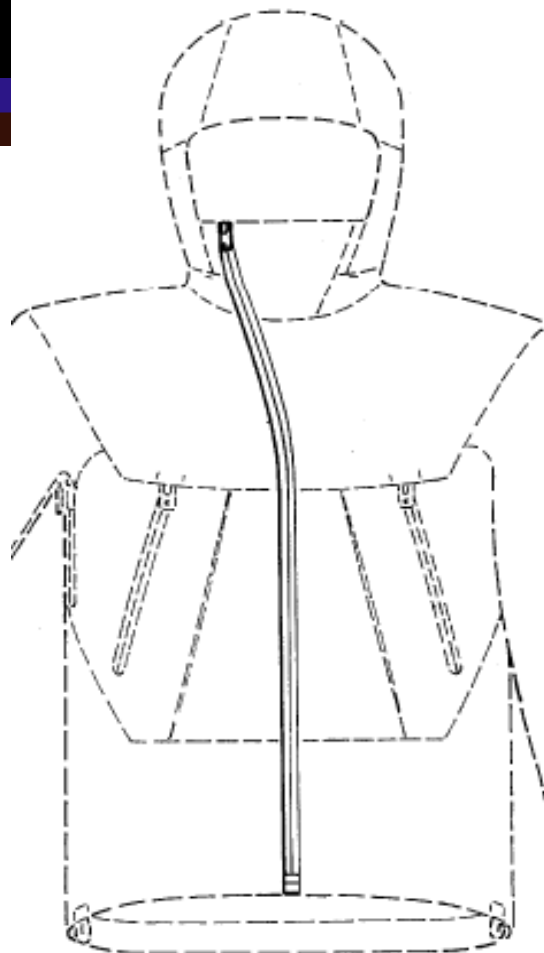


But the patentee still lost in *Egyptian Goddess*; accused design did not infringe claimed design.

The court seemed to rely heavily on the experts' declarations characterizing the claimed, accused and prior art designs.

The Super-Rough Comparison Attempt applied to Arc'teryx Equipment, Inc. v. Westcomb Outerwear, Inc. (D. Utah Nov. 4, 2008)

2008 WL 4838141



**Claimed
Design**

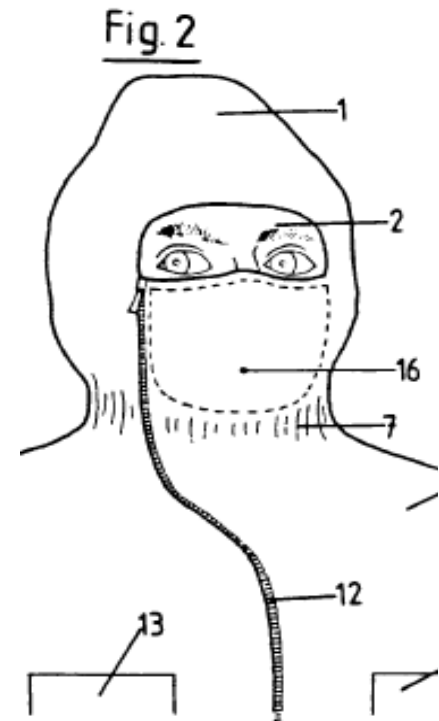
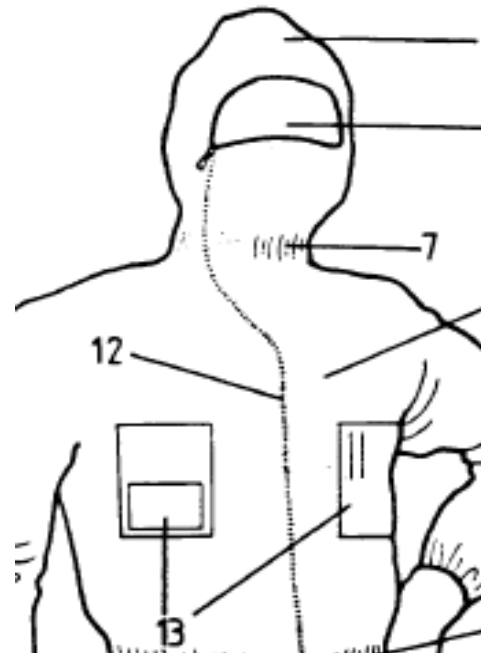


**Accused
Design**

The Super-Rough Comparison Attempt applied to Westcomb Cont'd



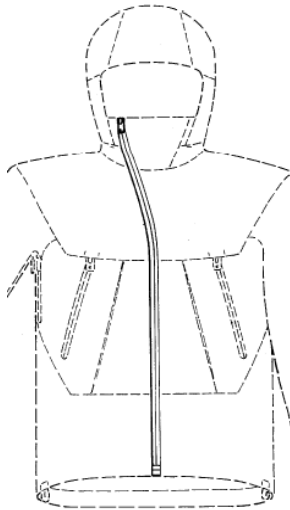
Prior Art



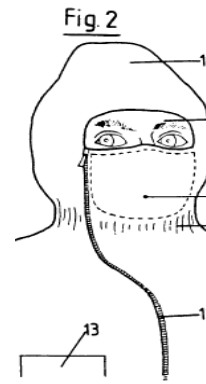
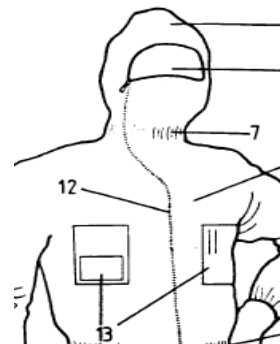
*The Super-Rough Comparison Attempt applied to Westcomb Cont'd
Patentee lost in Westcomb; accused design did not infringe claimed design.*



**Claimed
Design**



**Prior Art
Designs**



**Accused
Design**



“The 715 Patent is much closer to the Lowe Alpine Black Ice Jacket in that they both contain one straight and one diagonal section. Defendant's Mirage Jacket, on the other hand, is similar to the DE 356 Patent in that both designs contain a straight section, curving into a diagonal section, which curves into a second straight section.”

Open Issues

- the mechanics of **the comparison** of the claimed and accused designs with the prior art
- specifics as to **the patentee's burden** to demonstrate infringement by a preponderance of the evidence, especially since the burden to introduce comparison prior art is now imposed on the accused infringer
- **who exactly is the ordinary observer** making the comparison of the claimed and accused designs with the prior art, or at least what does the ordinary observer know, particularly in light of:
 - characterization of the ordinary observer as a person “conversant with the prior art” or possibly a “purchaser familiar with the prior art,” and
 - the court’s seeming reliance on expert testimony in *Egyptian Goddess*
- ***it appears as if the rejection of the point of novelty test should be, on the whole, beneficial to design patent hold-ers, rather than design patent design around-ers; however, patentees are 0 for 2 so far!!!***
- ***the Federal Circuit: “[W]e leave it to future cases to further develop the application of this standard.”***

*Thank you!!!!
Your patience is noted.*



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