



PANITCH TRAINING ACADEMY

Insights From Leaders In IP Law

Training Academy Session #16

IP 101 & Design Patents

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April 11, 2023

Session Overview

1. What is IP Protection?
2. Types of IP protection – Trademarks Overview
3. Types of IP protection – Copyrights Overview
4. Types of IP protection – Trade Secrets Overview
5. Types of IP protection – Patents
6. Design Patents

What is IP protection?

- Intellectual property law protects **creations of the mind**:
 - inventions; literary and artistic works; designs; and symbols, names, and images used in commerce
- Intellectual property rights are granted by national governments for a specified time:
 - Trademark – forever while used in commerce
 - Copyright – life of author + 70 yrs or ...
 - Trade Secret – while maintained in secrecy
 - Patent – 20 yrs from filing date

What is IP protection?

- IP rights are **exclusionary**
 - Gov't grants **right to holder to stop others from doing certain things**
 - Does **not** give the holder the right to commercial use
- Patent Example (\$1B): Apple v Samsung Patent War
 - US Patent D593,087 and US Patent No. D604,305

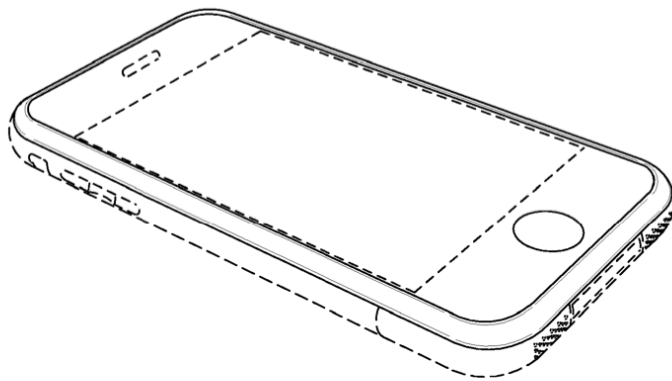
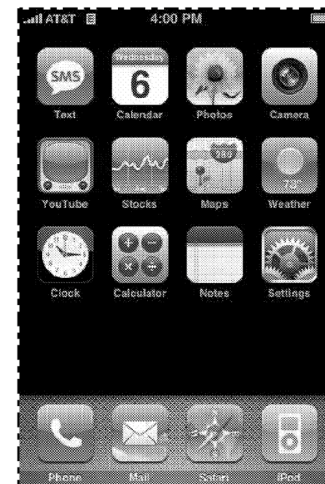


FIG. 1



Types of IP Protection - Trademarks

- A Trademark is a **Source Identifier**
 - Distinguishes the sources of goods and services
 - Part of the law of unfair competition
- Duration of Protection
 - Rights endure indefinitely provided use, renewal and mark is not abandoned
- Registration
 - Registration is not mandatory, but gives mark owner additional rights (™ & ®)

Types of IP Protection - Trademarks

- World's Most Valuable Trademarks 2020, per Forbes:

1. Apple - \$240B
2. Google - \$208B
3. Microsoft - \$163B
4. Amazon - \$135B
5. Facebook - \$70B
6. Coca Cola - \$64B
7. Walt Disney - \$61B
8. Samsung - \$50B
9. Louis Vuitton - \$47B
10. McDonalds - \$46B
22. SAP - \$28.6B
38. MasterCard - \$17.3B
69. Red Bull - \$11.1B
92. Lego - \$8.6B



SAMSUNG



Types of IP Protection - Copyright

- Copyright is directed to **Original Works of Authorship**
 - Fixed in any Tangible Medium of Expression
 - Must be original
 - Protects expression - Not ideas
- Works of Authorship
 - Books, movies, songs, websites, computer programs, technique guides, drawings, etc.
- Copyright does **not** protect an idea, procedure, process, system, method of operation, concept, principle, or discovery

Types of IP Protection – Trade Secret

- **Secret, commercially valuable** information known only to a **limited group of persons**, and subject to **reasonable steps taken** by the rightful holder of the information **to keep it secret**
 - May be protected by confidentiality and/or non-compete agreements
- *Note:* If competitors can reverse engineer the invention based on your product, then better to pursue patent protection

Types of IP Protection – Patent

- Patents are Territorial
 - E.g.: United States, Europe, Canada, Japan, ...
 - International (PCT) – more efficient vehicle to seek patent protection in a large number of countries by initially filing a single “international” application rather than filing separate national or regional patent applications
 - *Note:* Rules are also territorial
- A patent is a contract between the inventor and the issuing country/region under which, **in exchange for disclosing the details of the *invention*, the inventor is given the exclusive *right to prevent others* from making, using or selling the *invention* without permission**

Types of IP Protection – Patent

- Distinct types of Patents:
 - Utility Patent: The “traditional” type of patent used to protect most types of inventions – apparatus, chemical composition, methods, software, etc.
 - Design Patent: Protect the ornamental appearance embodied in or applied to an article
 - Plant Patent: Asexually reproduced (i.e., by means other than seeds) plants
- U.S. Patent Term
 - Utility/Plant: 20 years from date of filing
 - Design: 15 years from date of grant

Types of IP Protection – Patent

- U.S. is a First-Inventor-to-File System
 - Everything is date-based
- Types of U.S. Utility Patent Applications
 - Provisional Application
 - Not Examined
 - Not Published
 - Essentially a one-year place holder, and enables subsequent safe disclosure of invention
 - Non-Provisional Application (traditional patent application)
 - Examined
 - Published after 18 months
 - Claims required (section that defines the owner's rights)

Types of IP Protection – Patent

- How do you obtain a patent?
 - File an application with sufficient disclosure to teach one having ordinary skill in the art to make and use the invention
 - Invention must be disclosed in such "full, clear, concise and exact terms" so as to enable a person of ordinary skill in the art to make and use the invention (once the patent is expired) without undue experimentation
 - Application is like an owner's manual for the invention
 - Demonstrate that the invention is new over what was already publicly known
 - New = Novel and Not Obvious

Types of IP Protection – Patent

- Novelty
 - Generally straightforward (a “yes or no” test)
 - Was the apparatus, product or method “patented, described in a [single] printed publication, or in public use, on sale, or otherwise **available to the public before the effective filing date**” of the patent application?
 - *Note:* Be careful not to publish or disclose to a member of the public (in print, electronically, through a presentation, verbally, or otherwise) inventive subject matter prior to the filing of a patent application
 - The entirety of the invention is already in the public domain

Types of IP Protection – Patent

- Obviousness
 - Generally subjective determination based upon what would have been obvious to a person of ordinary skill in the art at the time the invention was made
 - “The art” – encompasses the general field of endeavor or field reasonably pertinent to the particular problem the invention is directed to
 - Level of “ordinary skill” of “a person [practicing that] art”?
 - The knowledge of the known relevant art up to the application date
 - Persons of scientific competence in the field(s) in which they work (Ex: Examiner may consider his/her knowledge as the level of “ordinary skill”)

Types of IP Protection – Patent

- The scope of a patent is defined by a section entitled “claims”
 - Non-Provisional utility patent applications must include at least one claim (typically include about 20 in the U.S. - max number of claims without incurring additional fees)

- Sample Utility Application Claim:
1 claim:



1. A stool comprising:

- a) a seat; and
- b) three legs depending downwardly from the seat.

2. The stool of claim 1, further comprising rubber feet at the bottom of each of the legs

Types of IP Protection – Patent

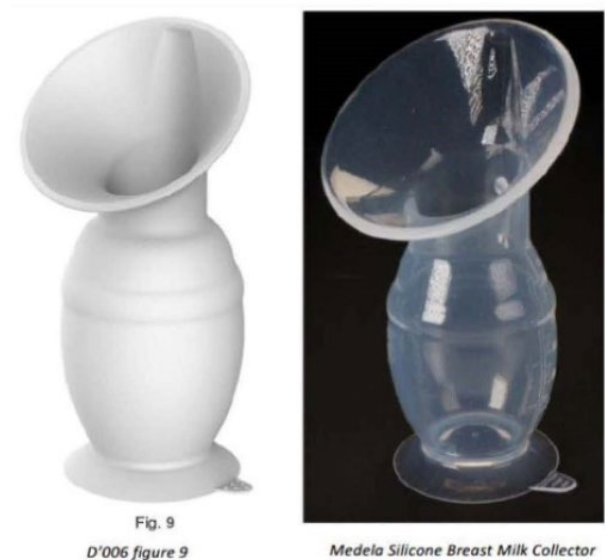
- Why Obtain Patents?
 - Exclusivity/Monopoly – Prevent Others
 - Generation of income - royalties or damages (lost profits)
 - Cross-licensing to obtain use of rights of others
 - Defensive patents
 - Attract funding and investment
- Patent Marking
 - Infringer needs to have notice of your patent in order to be liable for damages
 - Patent Marking provides constructive notice
 - Marking on the product/packaging
 - Virtual marking – url on the product/packaging that when accessed provides the patent nos.

Design Patents

- Available for new and original **aesthetic or ornamental appearance** of an article of manufacture, not function
- Generally same patentability requirements as utility patent
- May be narrower scope of protection
 - Change in appearance while performing the same function results in avoidance of the design patent scope
- Scope of a patent is defined by the **drawings**
 - Sufficient view(s) to enable the aspect of the ornamental appearance for which protection is sought
 - **Can be directed to parts or portions of an article**
 - Typical view types: perspective, top, bottom, left side, right side, front, rear

Design Patents

- Drawings are Key
 - Line drawings most common (see next slides)
 - Computer-Generated images accepted
 - Think Green v. Medela AG (re: D808,006) - Court found that using computer-generated images indicated surface material choice. The patent was interpreted as claiming only an opaque object and could not cover a translucent object!
 - Photographs accepted



Design Patents

United States Patent [19] [11] Patent Number: **Des. 318,309**
D'Andrade [45] Date of Patent: **Jul. 16, 1991**

[54] **TOY WATER GUN WITH TANK** D. 303,820 10/1989 Wong D21/147
1,273,553 9/1966 Doyle 446/473

[76] Inventor: Bruce M. D'Andrade, 3 Ten Eyck
Rd., Whitehouse Station, N.J. 08889
Primary Examiner—Charles A. Rademaker
Attorney, Agent, or Firm—Kenneth P. Glynn; Eric A.
LaMorte

[**] Term: 14 Years [57] **CLAIM**

[21] Appl. No.: 530,980 [57] The ornamental design for a toy water gun with tank, as
shown.

[22] Filed: May 31, 1990

[52] U.S. Cl. D21/147

[58] Field of Search: 446/473, 180, 181;
42/24, 58; D21/145-147, 59; D23/225

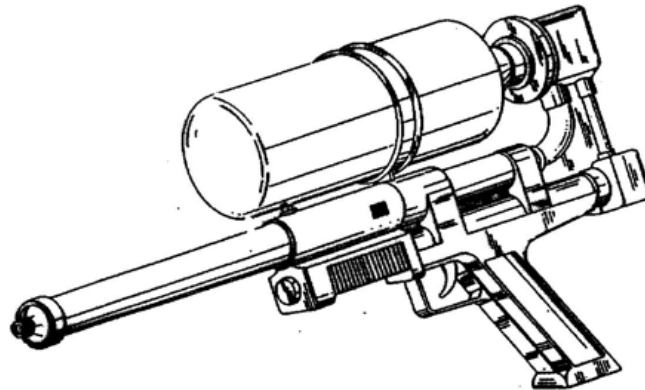
[56] **References Cited**

U.S. PATENT DOCUMENTS

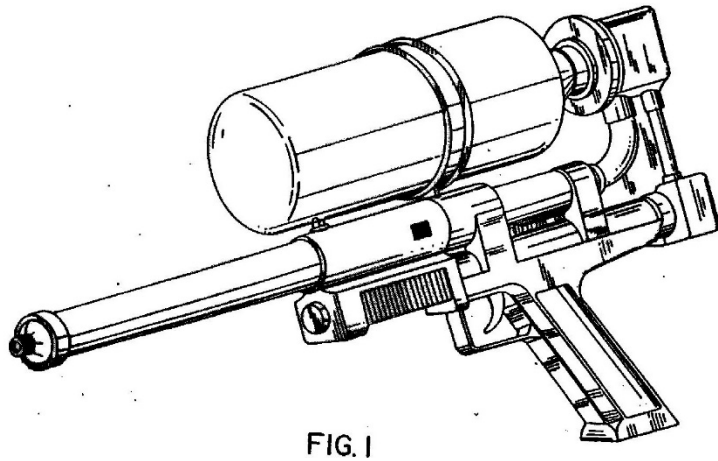
D. 78,206 4/1929 Hermann D23/225
D. 191,686 10/1961 Johnson et al. D21/147
D. 280,473 1/1965 Sawyer D23/225
D. 287,748 9/1986 Marino D21/147

DESCRIPTION

FIG. 1 is a perspective of a toy water gun with tank showing my new design;
FIG. 2 is a front elevational view thereof;
FIG. 3 is a rear elevational view thereof;
FIG. 4 is a left side elevational view thereof;
FIG. 5 is a right side elevational view thereof;
FIG. 6 is a top plan view thereof; and
FIG. 7 is a bottom plan view thereof.

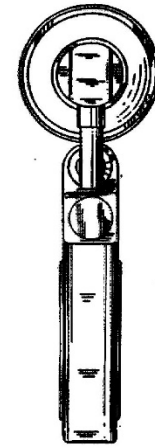
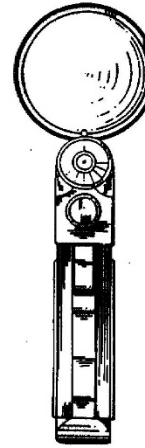


Design Patents



U.S. Patent
July 16, 1991
Sheet 1 of 5
D-s. 318,309

U.S. Patent July 16, 1991 Sheet 2 of 5 Des. 318,309



Design Patents

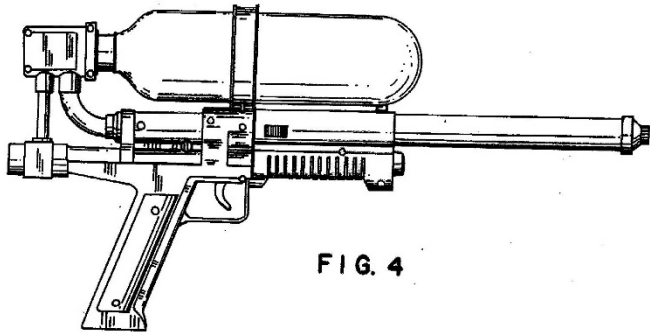


FIG. 4

U.S. Patent July 16, 1991 Sheet 3 of 5 Des. 318,309

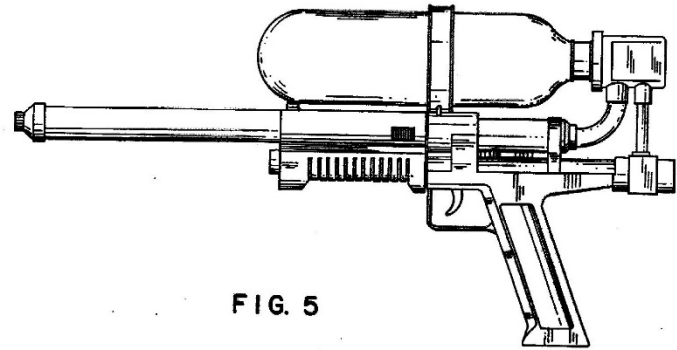


FIG. 5

U.S. Patent July 16, 1991 Sheet 4 of 5 Des. 318,309

Design Patents

U.S. Patent July 16, 1991 Sheet 5 of 5 Des. 318,309

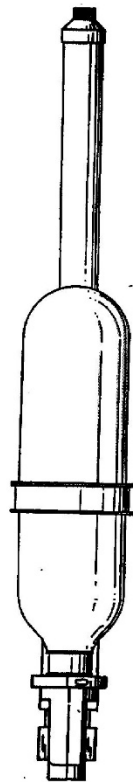


FIG. 6

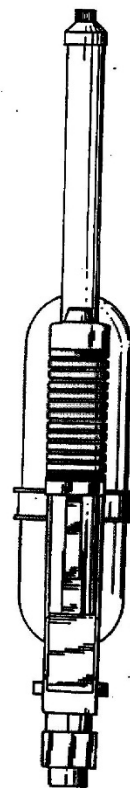
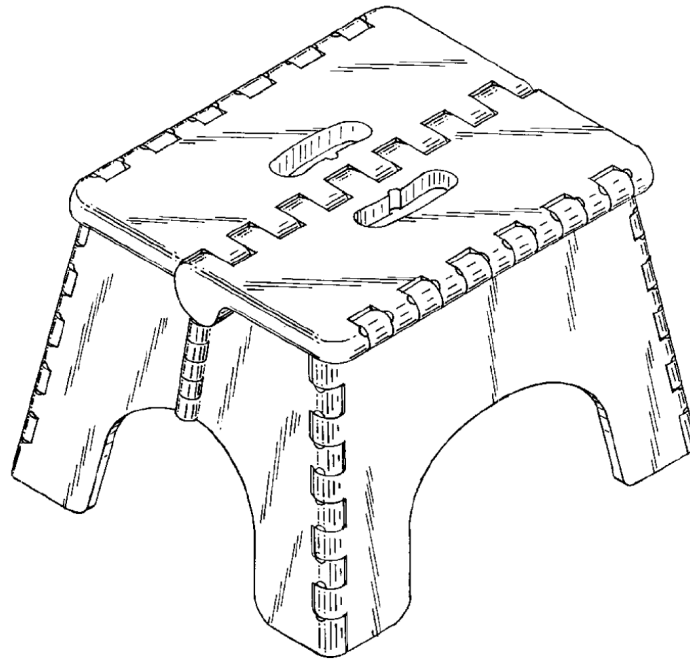


FIG. 7

Design Patents

- Design Patents **cover appearance, not underlying functional attributes**



- E.g.: Any “swivel-ability” of the stool does not matter
 - Only the overall appearance matters

Design Patents

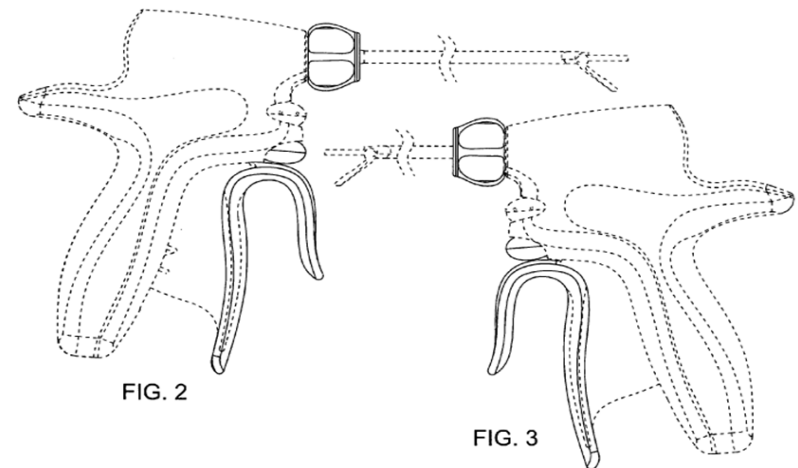
- Design Patents **cover appearance, not ideas or concepts**



- E.g., Same general idea/concept between patent design (left) and accused design (right), but no design patent infringement

Design Patents

- Design Patent Application Examination
 - Examiners typically focus on sufficiency of the drawings and inconsistencies or ambiguities between the different drawing views
 - Prior Art Rejections
 - Novelty
 - Obviousness
- In U.S. design patent applications, dotted lines are for environmental purposes only and don't form part of the claim
 - Rules are different in different territories



Design Patents

- Novelty
 - Applies equally between utility and design patents
- Obviousness
 - Whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved – two step test
 - “primary reference” that is “something in existence, the design characteristics of which are basically the same as the claimed design.”
 - 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.”

Design Patents

- Applicant is entitled to claim the subject matter which Applicant regards as the invention/design
 - When visible portions of the article embodying the design are not shown, it is because they form no part of the claim to be protected
 - Limited/Single View Designs are gaining popularity

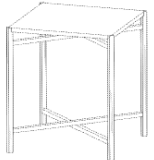
(12) **United States Design Patent** (10) **Patent No.:** **US D693,161 S**
Polidoros (45) **Date of Patent:** ** *Nov. 12, 2013

(54) **TABLE BASE**
 (71) Applicant: **IHS Global Design Pty. Ltd.**, Rosville (AU)
 (72) Inventor: **Nicholas Polidoros**, Micham (AU)
 (73) Assignee: **IHS Global Design Pty. Ltd.** (AU)
 (*) **Notice:** This patent is subject to a terminal disclaimer.
 (**) **Term:** 14 Years

Foreign Application Priority Data
 (21) Appl. No.: **29461,203**
 (22) Filed: **Jul. 19, 2013**

Related U.S. Application Data
 (63) Continuation of application No. 294457,257, filed on Jun. 7, 2013, which is a continuation of application No. 29424,878, filed on Jun. 16, 2012, which is a continuation of application No. 12377,096, filed on Feb. 10, 2009, now abandoned.
 (51) **LOC (9) CL:** 06-06
 (52) **U.S. CL:** D6/708
 (58) **Field of Classification Search**
 USPC 136/800-809, 495-499, 420-431, 691-8, D6692.6, 709, 106/153.1, 155, 156, 108/157.1, 161, 115, 157.6, 157.17, 106/157.18, 118, 119, 166, 248/188, 188.1, 248/188.7, 188.8
 See application file for complete search history.

References Cited
U.S. PATENT DOCUMENTS
 587,219 A 7/1897 Mass
 135,045 S 9/1901 Stackley
 1,039,004 A 12/1933 Koyama
 1,963,594 A 6/1934 Schwabe



1 Claim, 1 Drawing Sheet

(12) **United States Design Patent** (10) **Patent No.:** **US D716,670 S**
Ghiemini (45) **Date of Patent:** ** Nov. 4, 2014

(54) **WRISTWATCH**
 (75) Inventor: **Gabriele Ghiemini**, Lugano (CH)
 (73) Assignee: **Tendence SA**, Lugano (CH)
 (**) **Term:** 14 Years
 (21) Appl. No.: **29400,836**
 (22) Filed: **Sep. 3, 2011**

Foreign Application Priority Data
 Mar. 15, 2011 (WC) DM/075 506
 (51) **LOC (10) CL:** 16-02
 (52) **U.S. CL:** D10/32
 (58) **Field of Classification Search**
 USPC 136/820-829, 830-839, 368/276, 281, 282, D11/5
 See application file for complete search history.

References Cited
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 D67,508 S 4/1954 Horvath D10/32
 D195,421 S 6/1963 Hoegeman D10/39
 2,475,062 A 11/1969 Ward 368/39
 5,061,023 A 8/1975 Foltshuber 368/281
 D2,862,525 S 1/1996 Szalk D10/126
 D2,460,408 S 7/1976 Szalk D10/126
 D295,328 S 5/1998 Szalk D10/32
 D348,403 S 7/1994 Sener D10/32

CLAIM
 The ornamental design for a wristwatch, as shown and described.
DESCRIPTION
 The sole view is a front and right side perspective view of a wristwatch showing my new design.
1 Claim, 1 Drawing Sheet



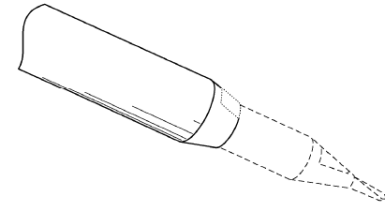
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(12) **United States Design Patent** (10) **Patent No.:** **US D666,293 S**
Miles et al. (45) **Date of Patent:** ** *Aug. 28, 2012

(54) **DILATOR**
 (75) Inventors: **Patrick Miles**, San Diego, CA (US); **Scott Martinelli**, Mountain Top, PA (US); **Eric Finley**, Poway, CA (US)
 (73) Assignee: **NuVasive, Inc.**, San Diego, CA (US)
 (*) **Notice:** This patent is subject to a terminal disclaimer.
 (**) **Term:** 14 Years
 (21) Appl. No.: **29411,651**
 (22) Filed: **Jan. 24, 2012**

Related U.S. Application Data
 (63) Continuation of application No. 29360,369, filed on Apr. 23, 2010, now Pat. No. Des. 652,922, which is a continuation of application No. 12,428,081, filed on Apr. 22, 2009, now Pat. No. 7,935,051, which is a continuation of application No. 10,608,362, filed on Jun. 26, 2005, now Pat. No. 7,282,658.
 (51) **LOC (9) CL:** 24-02
 (52) **U.S. CL:** D24/35
 (58) **Field of Classification Search**
 USPC 136/130, 133, 140, 147, 149; 600/200, 600/202, 184, 220, 227, 201, 203, 210, 218; 606/191-200, 201, 202
 See application file for complete search history.

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 972,983 A 10/1910 Arthur
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 4,543,374 A 10/1985 Jacobson



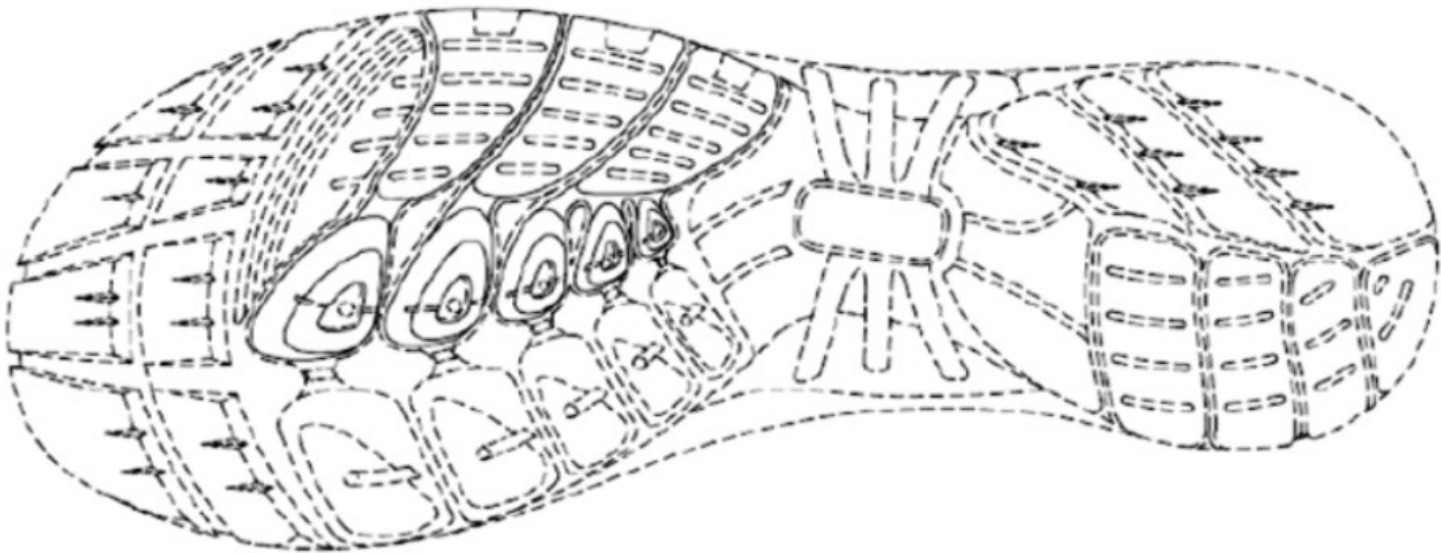
1 Claim, 1 Drawing Sheet

Design Patents

- Single View Designs
 - Recent Case *In re Maatita* (Fed. Cir. 2018)
 - Examiner rejected the claim as indefinite because the application used a single plan view drawing to disclose a three-dimensional design for a shoe bottom, and not a two-dimensional object.
 - CAFC stated that “Maatita’s two-dimensional drawing clearly demonstrates the perspective from which the shoe bottom should be viewed. A potential infringer is not left in doubt as to how to determine infringement.” Therefore, “[b]ecause a designer of ordinary skill in the art, judging Maatita’s design as would an ordinary observer, could make comparisons for infringement purposes based on the provided, two-dimensional depiction, Maatita’s claim meets the enablement and definiteness requirements of § 112.”

Design Patents

FIG. 1



SOLE DRAWING FIGURE – PLAN VIEW

Design Patents

- Enforcement
 - Infringement Standard - The ordinary observer test is the sole test for determining whether a design patent has been infringed.
 - Test: If, in the eye of an ordinary observer, given 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 Co. v. White, 81 U.S. 511, 528 (1871).
 - Must meet the resemblance criteria for all of the drawings
 - **The fewer the drawings, the better!**

Speakers



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