

5 KEY TAKEAWAYS

Design Patents for Patent Professionals

Kilpatrick Townsend's [Babak Kusha](#) recently spoke at the [Federal Bar Association's IP Law Fall Conference 2022](#) on the topic of "**Design Patents for Patent Professionals.**" Mr. Kusha discussed recent developments in design patents; indispensable enhancements to utility patents, brands, and trademark portfolios and effective enforcement strategies short of filing a complaint.

Key takeaways from the presentation include:

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Overview of US. Design Patents

- IP creators should consider design patents as a way of extending their utility patent's exclusive rights.
- IP creators should consider design patents as a way of extending their brand protection.
- Compared with trade dress: A design patent is not intended to identify source of goods.
- An applicant can secure design patent protection even if the design does not mean anything yet in the minds of your potential customer.
- An applicant can get trade dress protection even if the design is not new.
- For certain types of products, such as product configurations and packaging, parallel track protection is recommended to secure a combination of design patents, trade dress and copyrights.
- Design patent protection offers advantages of lower cost and speed (no need to develop secondary meaning). However, to be entitled to design protection, the design must be new.
- Design patents promote the opportunity to develop distinctiveness/secondary meaning.
- Design patents do offer advantages for securing protection as compared to trademarks.
- There are advantages for enforcement as compared to trademarks or copyrights.

Enforcement Options – Short of Filing a Complaint

- Platform-specific options (e.g., ecommerce site)
- Platform-specific process can involve various levels of analysis/evaluations/outcome/appeals:
 - ◊ Typical to obtain less than consistent results; and
 - ◊ Eventually may have to write letter to the infringer and also consider other supply chain actors.
- Mapping and monitoring of IP rights for unauthorized copies.

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Elements of a Good Notice Letter

- Recipient: confirm who, where and how, email, mail, UPS, etc.
- Introduction: let them know who you are: attorneys representing _____
- What the issue is: our client makes _____
- Be specific with the notice: identify the product, the knock-off and the Patent No.
- Begin with assumption of positive intent.
- Be specific with the demands, be reasonable, be rational. e.g.:
 - ◊ Cease and desist from any and all infringing activity.
 - ◊ Promptly cease and desist from advertising for the infringing product and remove all advertisements relating to the same.
 - ◊ Identify the source of infringing products so that our client can address the issue with the supplier.
 - ◊ Identify the distributors of the infringing products so that our client can address the issue with the distributors.
 - ◊ Identify the end-users of the infringing products so that our client can address the issue with them.
 - ◊ Dispose of related molds and any stock; and send evidence, such as pictures, of the disposal.
 - ◊ Within 15 business days, ship to _____ all stock of the products and molds therefore within your control and our client shall destroy all such stock. All the stock shall be sent to _____ at the following address:
- Follow-up mapping and monitoring of IP rights for unauthorized copies.

Tips for Domestic US Designs

- Increase the number of figures (e.g., perspective view) to aptly capture complex contours of a design being claimed – especially important when your design will be filed in a jurisdiction that does not allow shading (China).
- Weigh the pros/cons of multiple embodiments carefully – more embodiments may cover more scope, but with the increased risk of a restriction requirement, which may warrant multiple DIV applications.
- Avoid using photographs for a design patent – they are fraught with many pitfalls.
- Many foreign jurisdictions now allow a “grace” period, which leaves foreign filing options open in most of the major countries/regions.
- Go BIG with GUIs – there is a lot of white space out there and very broad GUI designs can be captured.
- GUIs with highly data driven visualizations (e.g., stylistic graphs, charts, etc.) can be patented! What may seem like a narrow patent with unique, data-specific visualizations have two advantages:
 - ◇ It is easier to get to allowance; and
 - ◇ Allegedly infringing products can likely be loaded with data to create the same data-specific visualizations.
- Front load filings with formatting to accommodate all target jurisdictions – this will ensure a 1-to-1 comparison between figures for a clean priority chain. You can file a preliminary amendment afterward to pare down to figures formatted for US prosecution. This should be done immediately to avoid examination and complex restriction requirements.

Updates on China Design Patents

- CN designs have increased from 10 to 15-year patent term.
- Protection for partial designs now allowed! Dashed lines can now be used.
- CAVEAT – as of July 2022, no guidance has been provided to CN examiners on how to examine partial designs, so some push back and rejections may still occur during the transition.
- CN-filed designs can now claim domestic priority to earlier filed CN designs. This is akin to a CON application in the US, with a six-month post filing window.

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