



**U.S. Design Patents –  
Quickest, Easiest, and Cost-Effective**  
presented by Cantor Colburn LLP  
Michael Cantor and Daniel Drexler  
June 17, 2020

# Introduction



Today's presenters from Cantor Colburn:

- **Michael Cantor, Founder and Co-Managing Partner**
- **Daniel Drexler, Partner, Co-Chair of Design Patent Practice Group, Chair of International Patent Group**

# Overview of Today's Webinar

- Introductions
- U.S. Design Patent Basics
- Quickest
- Easiest
- Effective
- Case Examples
  - *Harley vs. Moto Gucci*
  - The Ninja Foodi
  - Samsung Animated Graphic User Interface (GUI)
- Conclusion

# **U.S. Design Patent Law Basics**

# Basic Features of U.S. Design Patents

- Definition: The design for an article consists of the visual characteristics embodied in or applied to an article, and not the article itself.
- The claim of a design patent covers the ornamental features of an article of manufacture.
  - Essentially, what is shown in the drawings and described in the text of the patent.
- Design applications are substantively examined
- Term, 15 years from grant.
- No annuities. No pre-grant publication (except for International Hague applications).
- Six month priority period.

# Basic Features, Cont.

- Patent may cover an entire article or a portion thereof
- Subject matter in design drawings can be disclaimed by illustrating such subject matter in broken lines
- Continuation and divisional applications may be filed to extend design patent coverage, including continuations from utility patent applications as long as the full design is illustrated in the utility case
- Computer icons are protectable, as are graphics, patterns, etc., applied to an article

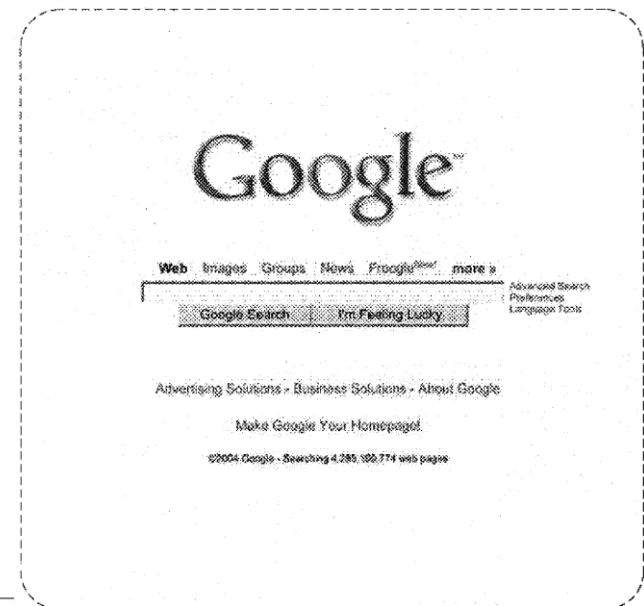
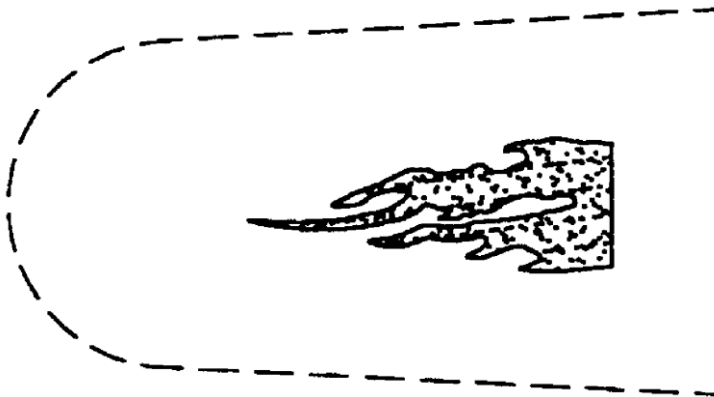


Fig. 1

# Elements of a U.S. Design Patent Application

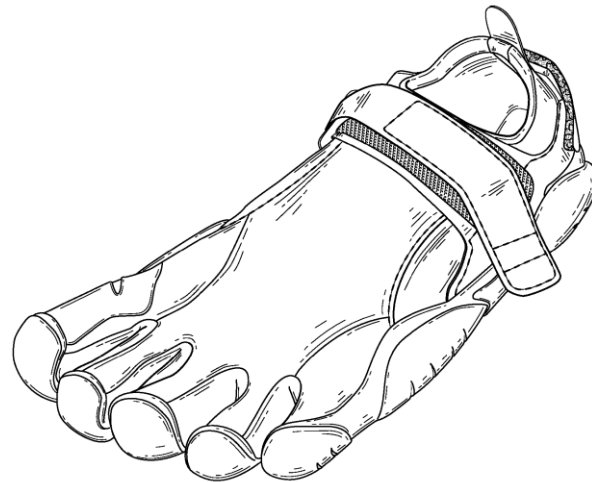
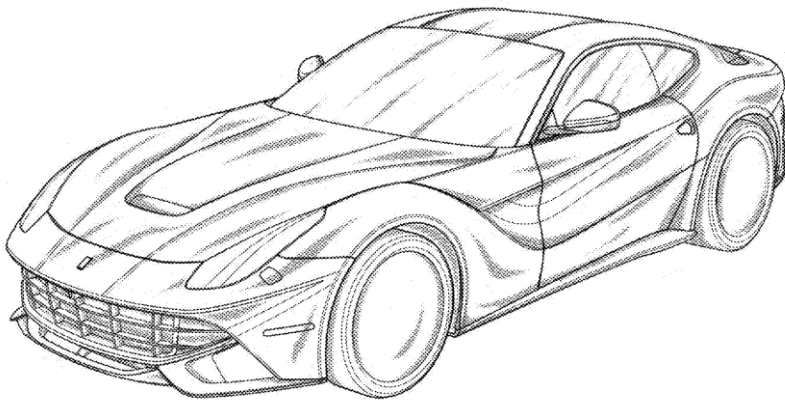
- Specification
  - Formal description of the figures
  - Minimal substantive description
- Drawings
  - Ink line drawings, photographs, computer images
  - Black and white, or color
  - Enough views to sufficiently illustrate the article
- Claim
  - Formalized, “I claim the ornamental design for a \_\_\_\_\_ as shown and described.”

# Requirements for Patentability

- Statutory Authority, 35 U.S.C. 171: “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor...”
- Design applications are examined for:
  - Article of manufacture
  - Ornamentality
  - Novelty
  - Non-Obviousness
  - Written Description & Clarity

# “Article of Manufacture”

- “A[n article of] manufacture is anything made ‘by the hands of man’ from raw materials, whether literally by hand or by machinery or by art.” In re Hruby, 373 F.2d at 1000-01 (CCPA 1967).
- “Article of Manufacture” is construed very broadly.



# “Article of Manufacture”

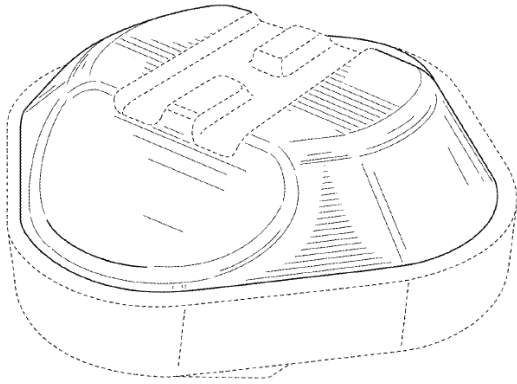


FIG. 1

Halls Cough  
Drop

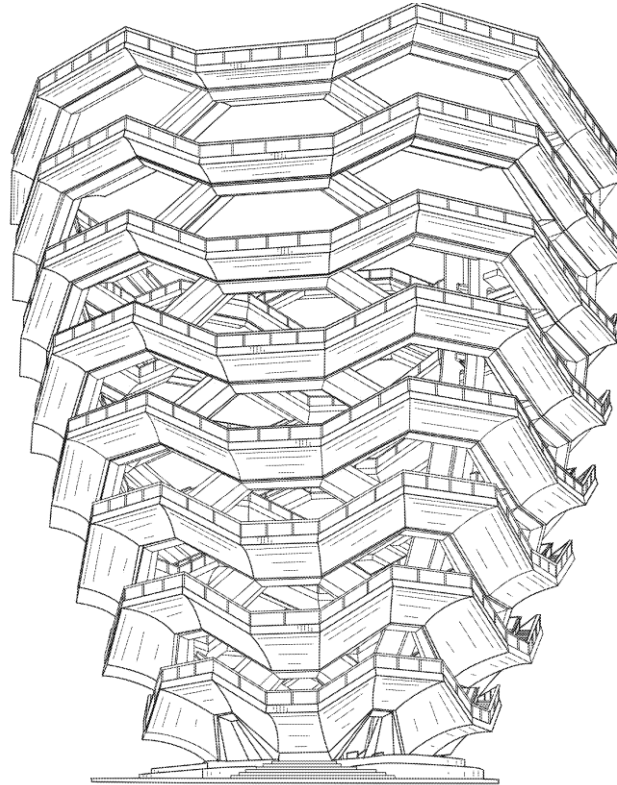


FIG. 1

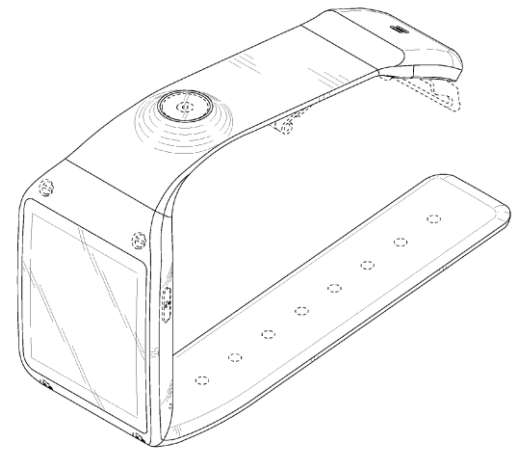


FIG. 1

Samsung Smart  
Watch

The Vessel, Hudson Yards, New York City

# “Ornamentality”

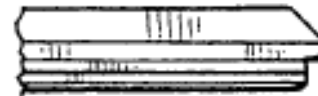
- For an article to be ornamental, its design must not be dictated by its function. *Ethicon v. Covidien*, 796 F.3d 1312 (Fed. Cir., August 7, 2015).
- If another design would allow the article to perform the same or similar functions, then the article is ornamental.

# “Ornamentality”

- The Court in *Ethicon* used a key blade as an example of a non-ornamental article “...the key blade must be designed as shown in order to perform its intended function – to fit into its corresponding lock’s keyway...Any aesthetic appeal of the key blade...is the inevitable result of having a shape that is dictated solely by functional concerns.”



*FIG 1*



*FIG 2*

# “Novelty”

- The novelty standard in design cases is a **likelihood of confusion ordinary observer test**.
- For lack of novelty to be found, the claimed design and the prior art design must be substantially the same. *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308 (Fed. Cir. 2001), citing *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871).
- “Two designs are substantially the same if their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design, supposing it to be the other.” *Door-Master*.

# “Obviousness”

- Test: “...whether the design would have been obvious to a designer of ordinary skill with the claimed type of article.”  
*In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).
- Two-part inquiry to establish obviousness of a design:
  - Identify a single reference that is “basically the same as the claimed design;” and
  - Once the primary reference is found, secondary references may be used “to create a design that has the same overall appearance as the claimed design”

# Written Description and Definiteness

- Definiteness, i.e., clarity
  - The drawings or photos must be clear and complete
  - Formalities in the written text must be adhered to
- Written description, i.e., sufficiency of disclosure
  - The disclosure must reasonably convey to those skilled in the art (i.e., designer of ordinary skill) that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

# Design Patent Infringement

- Infringement of a design patent is found where a person (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied....” 35 U.S.C. § 289
- Similar to utility patents, but the statute expressly includes infringement by equivalents.
- The infringement standard in the US is based upon an “ordinary observer familiar with the prior art”, from *Egyptian Goddess v. Swisa*, (Fed. Cir. 2008).

# Design Patent Infringement

- Test: there is infringement if the accused design could reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs.
- “*Familiar with the prior art*” requires a prior art analysis. Elements in the allegedly infringed patent that distinguish from the prior art are given more weight in comparison to the accused product.

# Quickest

# Pendency Data, U.S. Utility Patents



April 2020



April 2020



April 2020



April 2020

Allowance  
Rate, 67%

# Pendency Data

## U.S. Design Patents



April 2020



April 2020



Cumulative Through  
April FY 2020

Allowance Rate, 85%

**Easiest**

# U.S. Design Patents - Relatively Easy and Inexpensive

- Easy to prepare
  - Drawings and standard written description
  - No extensive detailed description and complex claims required, as in utility patent applications.
- Well prepared drawings submitted with the initial application can often lead to a swift allowance
- Office actions typically concern formalities or drawing issues; substantive prior art rejections are rare
- Lower Cost
  - Design filing fee \$960, and minimal office actions
  - Utility filing fee \$1,720, and virtually guaranteed multiple office actions
  - Expedited examination: design, \$900; utility \$4,000

**Effective**

# U.S. Design Patents - Effective

- Enforced patents found to be infringed
  - Design Patents, 55%
  - Utility Patents, 50%
- Challenged patents found to be valid
  - Design Patents, 80%
  - Utility Patents, 60%
- Rate of IPR institution
  - Design Patents, 40%
  - Utility Patents, 60% - 70% based upon technology

# U.S. Design Patents - Effective

- Grant of preliminary injunctions
  - Design Patents, 40%
  - Utility Patents, 25%
- Grant of temporary restraining order
  - Design Patents, 65%
  - Utility Patents, 35%
- Grant of permanent injunctions
  - Design Patents, 95%
  - Utility Patents, 80%

# Case Examples

# Harley-Davidson vs. Moto Guzzi

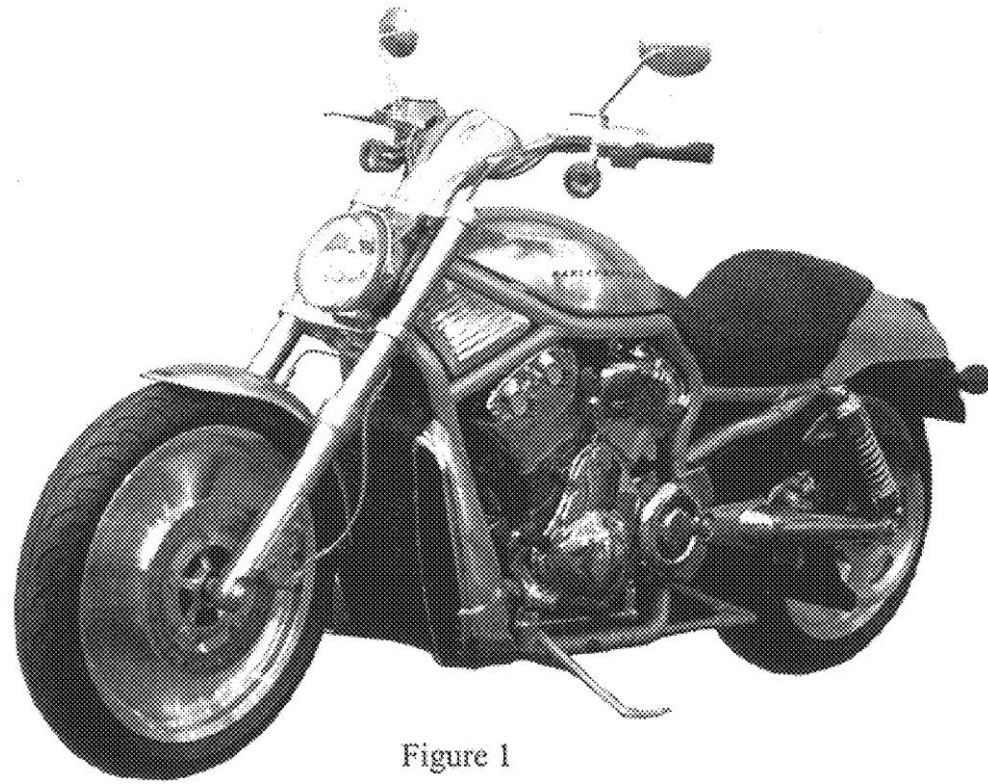


Figure 1

U.S. D462,638

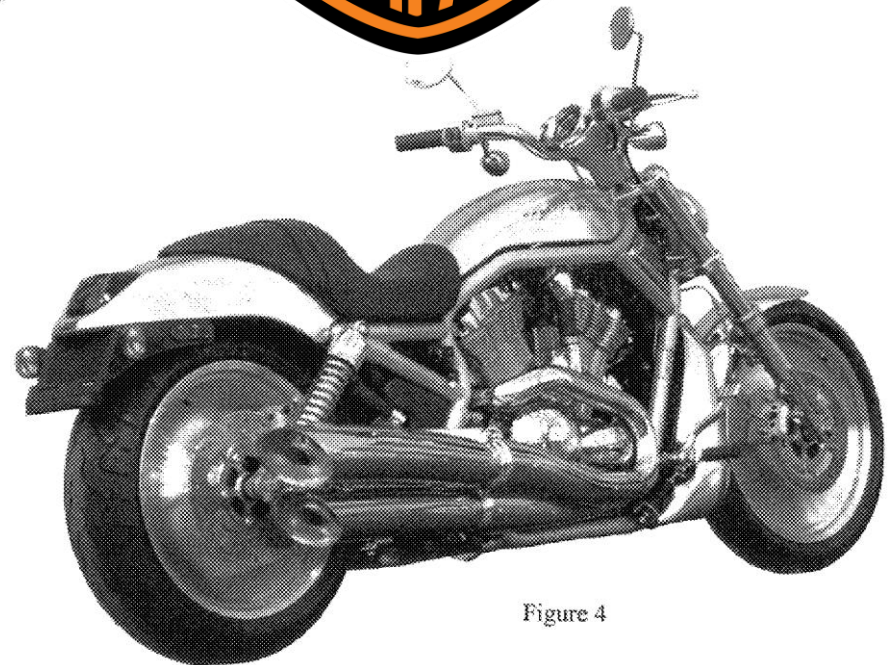


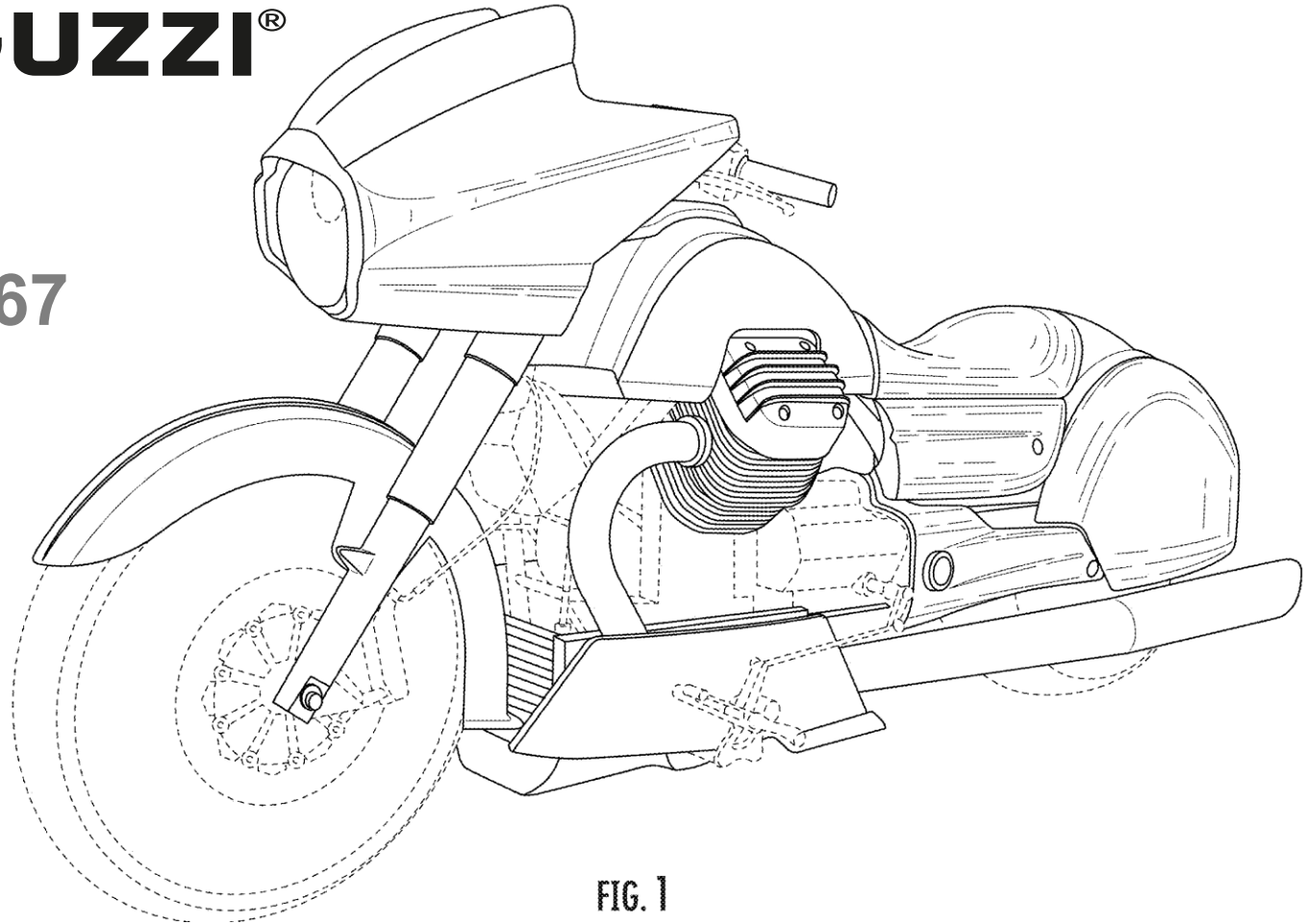
Figure 4

# Harley-Davidson vs. Moto Guzzi



**MOTO GUZZI®**

**U.S. D879,667**



**FIG. 1**

# Ninja Foodi



Pressure Cooker, Air fryer, TenderCrisper™

# Ninja Foodi

- Multi-part combination pressure cooker and fryer with new double lid construction and unique ornamental appearance
- Protected by 5 U.S. design patents and a currently pending application
- Also protected by multiple U.S. utility patents
- Corresponding design applications filed in ten other jurisdictions around the world, including Israel

# Ninja Foodi

- The original U.S. design patent application included 16 embodiments and 116 figures and an appendix with original imagery
  - “Kitchen sink” approach
- Much effort was made before filing to:
  - Determine the various the embodiments
  - Identify the protectable ornamental features
  - Remove/disclaim unnecessary items
  - Prepare appropriate formal design patent drawings
- The result: NO substantive office actions, and patents granted in 18-21 months

# Ninja Foodi, US D883,015

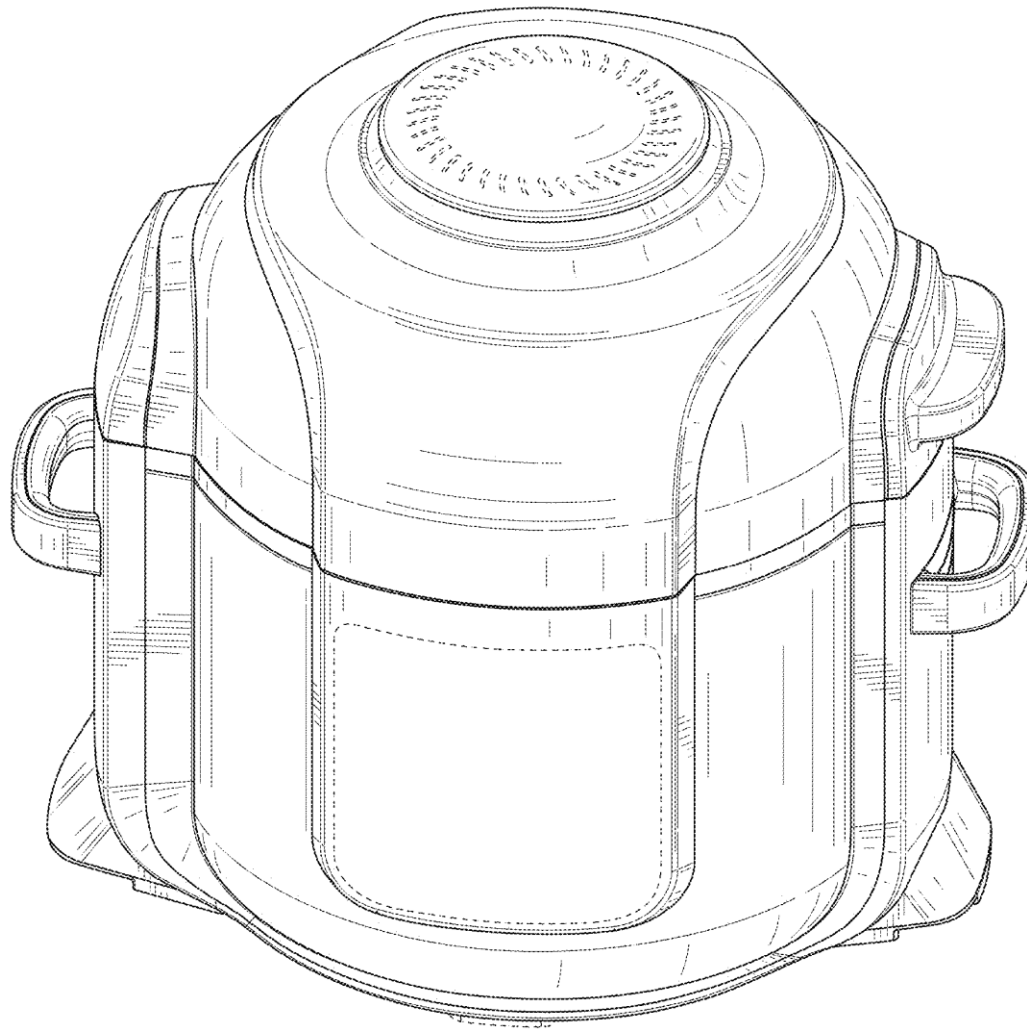


FIG. 1

# Ninja Foodi, US D883,015

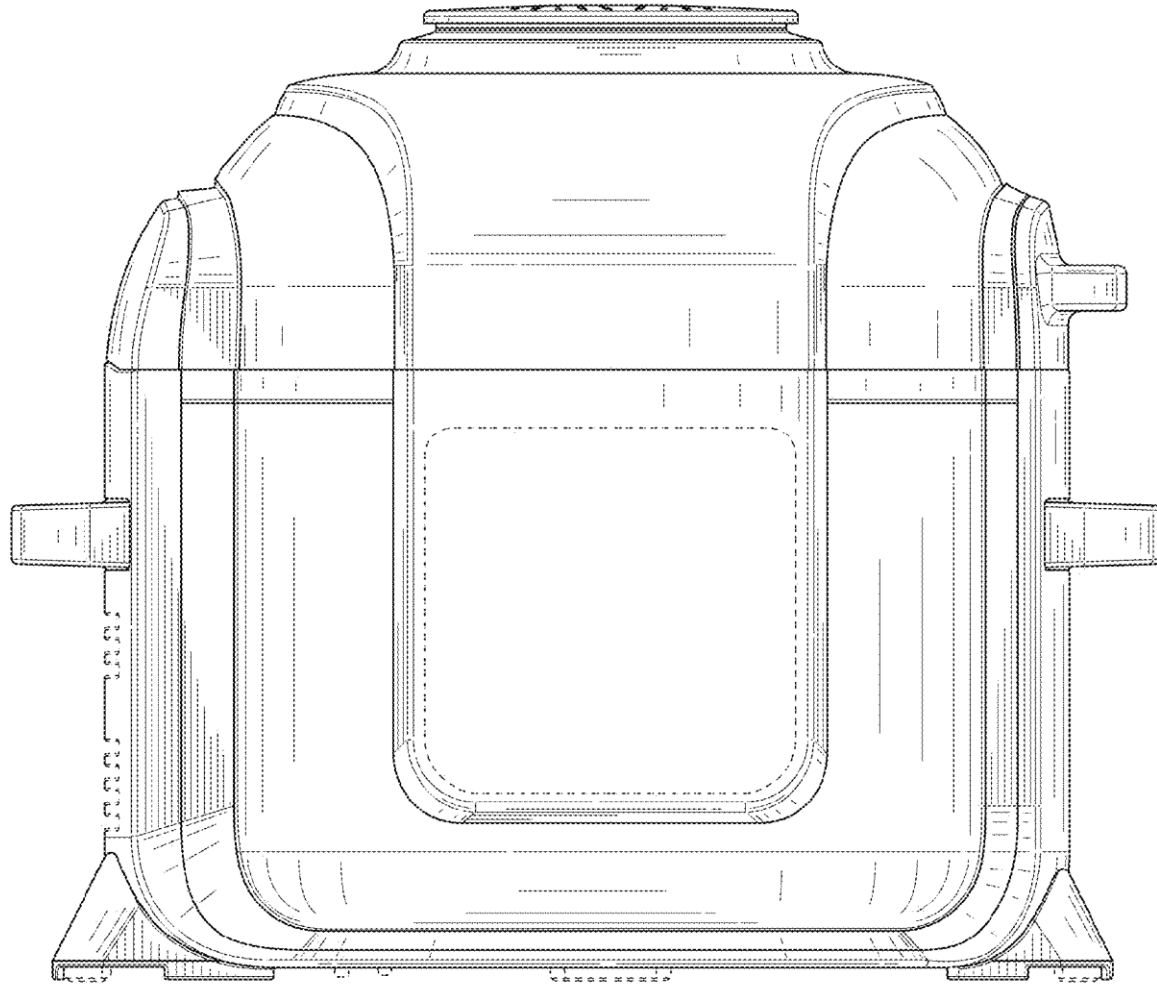
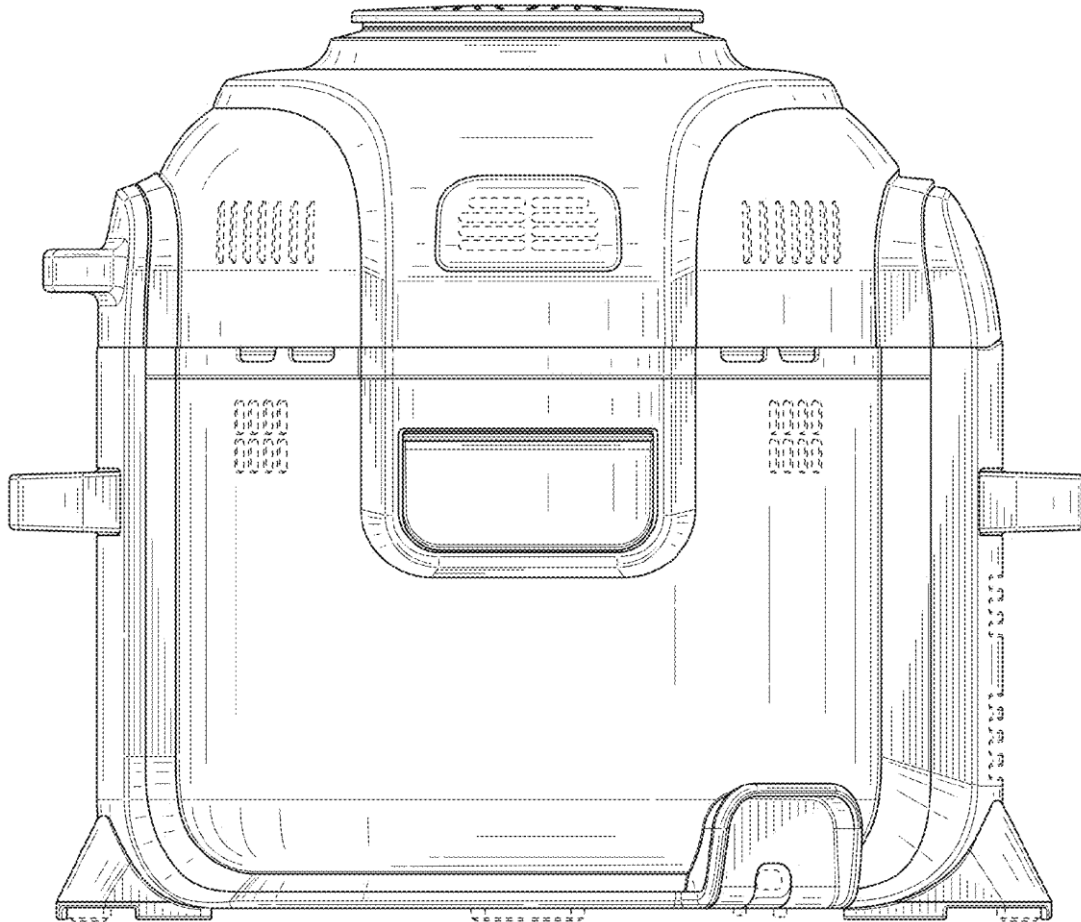


FIG. 2

# Ninja Foodi, US D883,015



**FIG. 3**

# Ninja Foodi, US D883,015

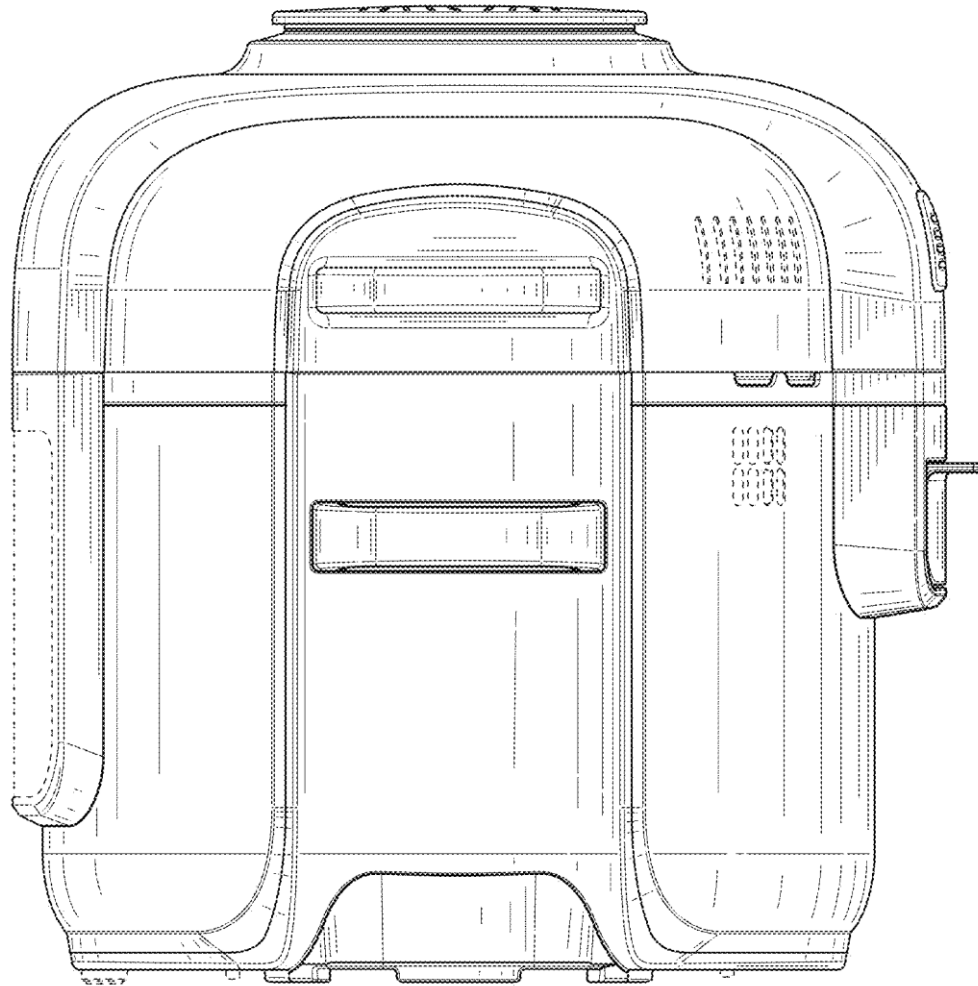


FIG. 4

# Ninja Foodi, US D883,015

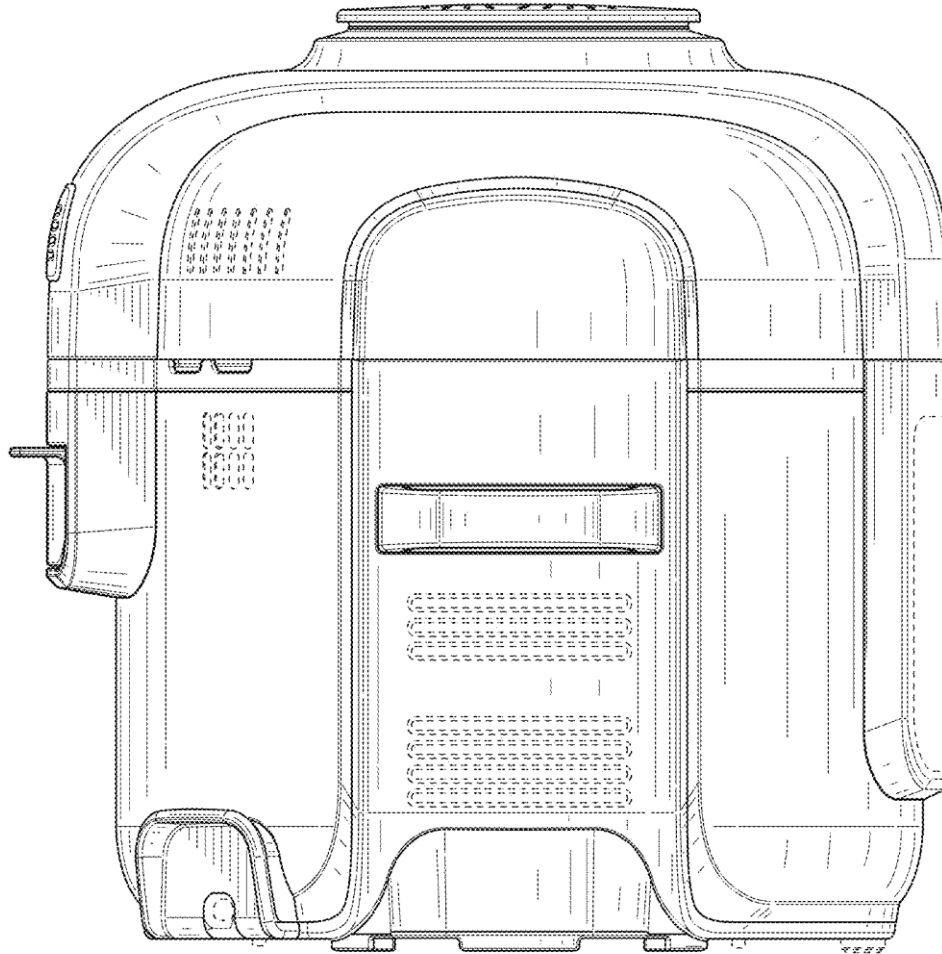


FIG. 5

# Ninja Foodi, US D883,015

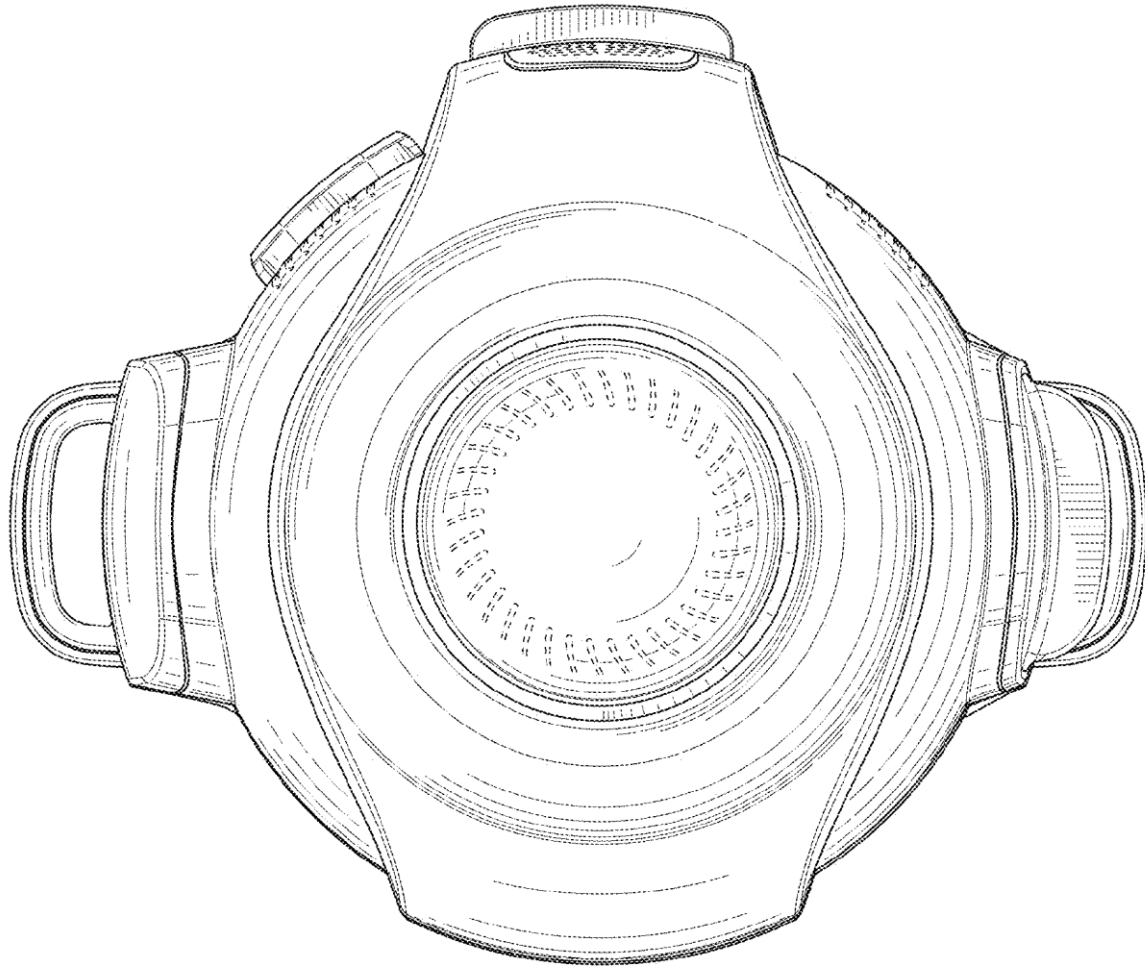


FIG. 6

# Ninja Foodi, US D883,015

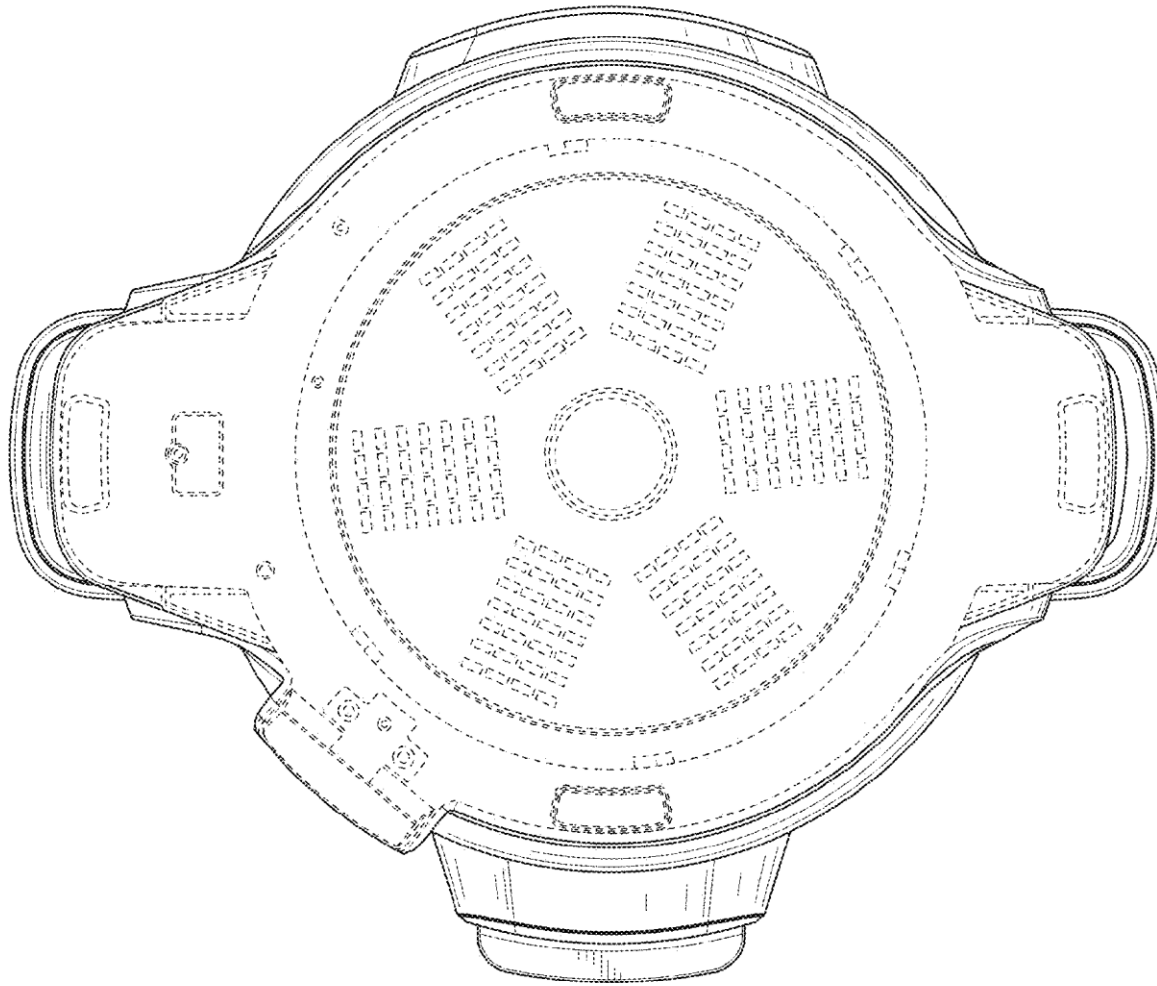


FIG. 7

# Ninja Foodi, US D883,016

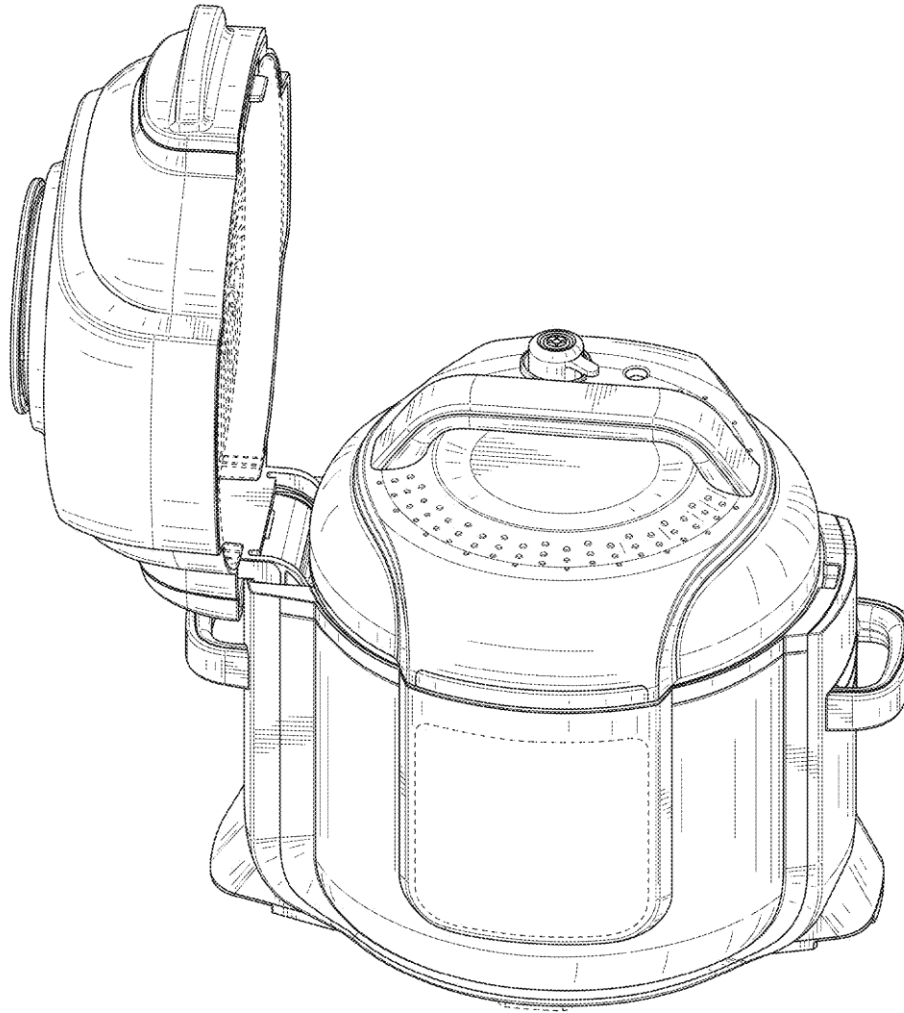


FIG. 1

# Ninja Foodi, US D883,016

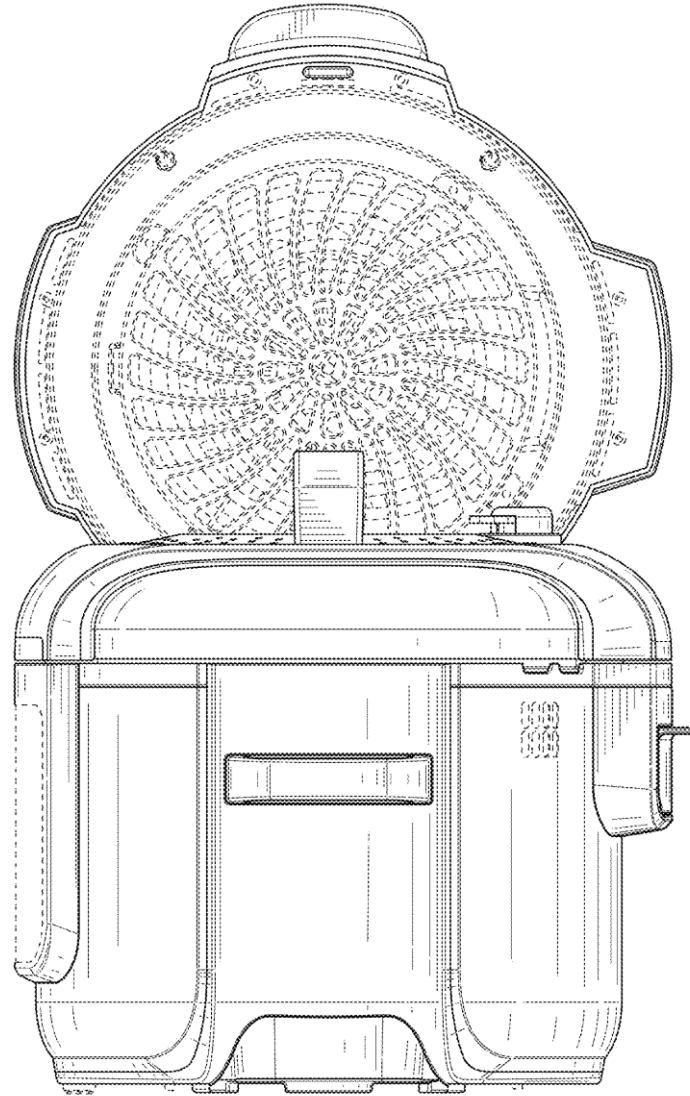


FIG. 4

# Ninja Foodi, US D883,016

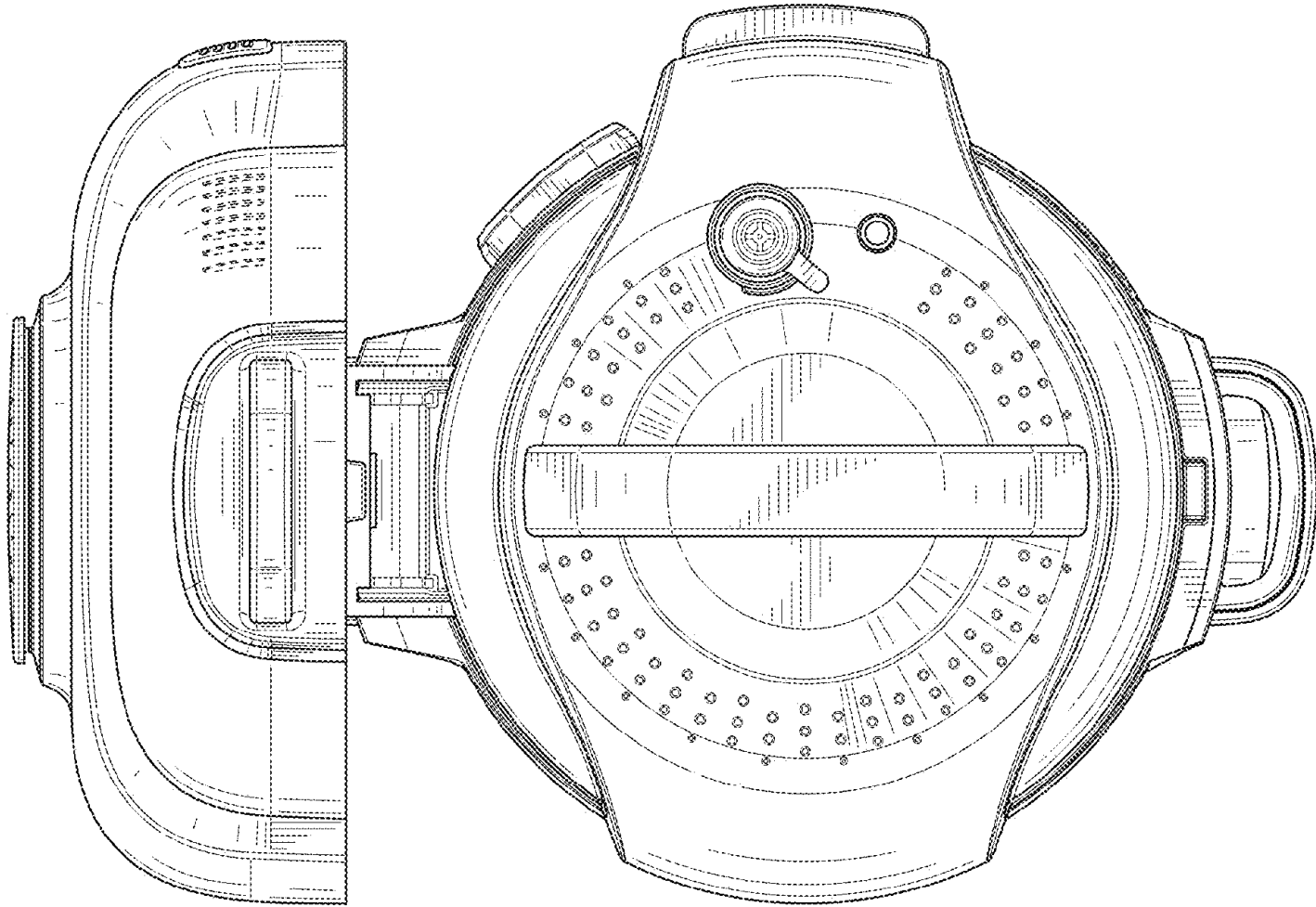
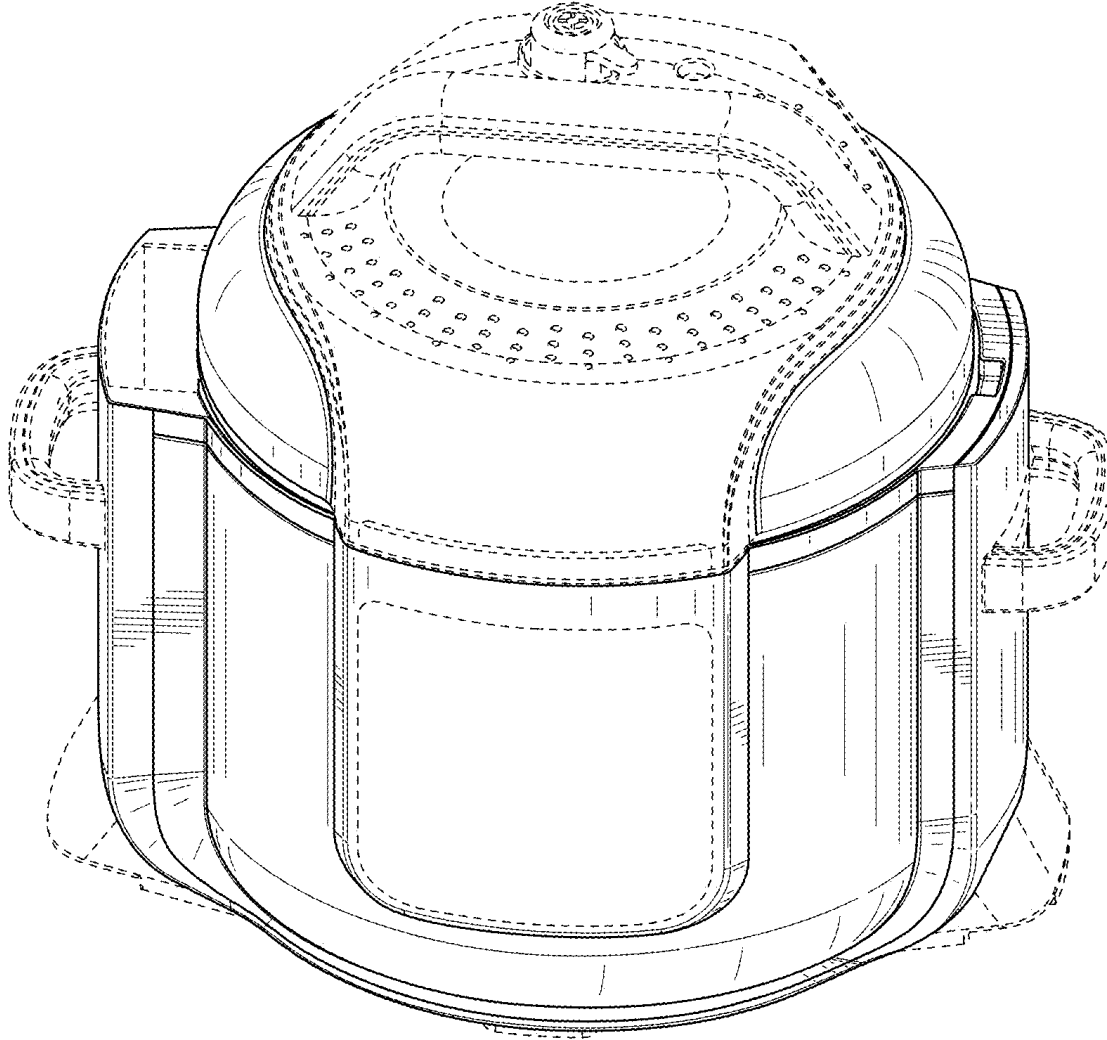


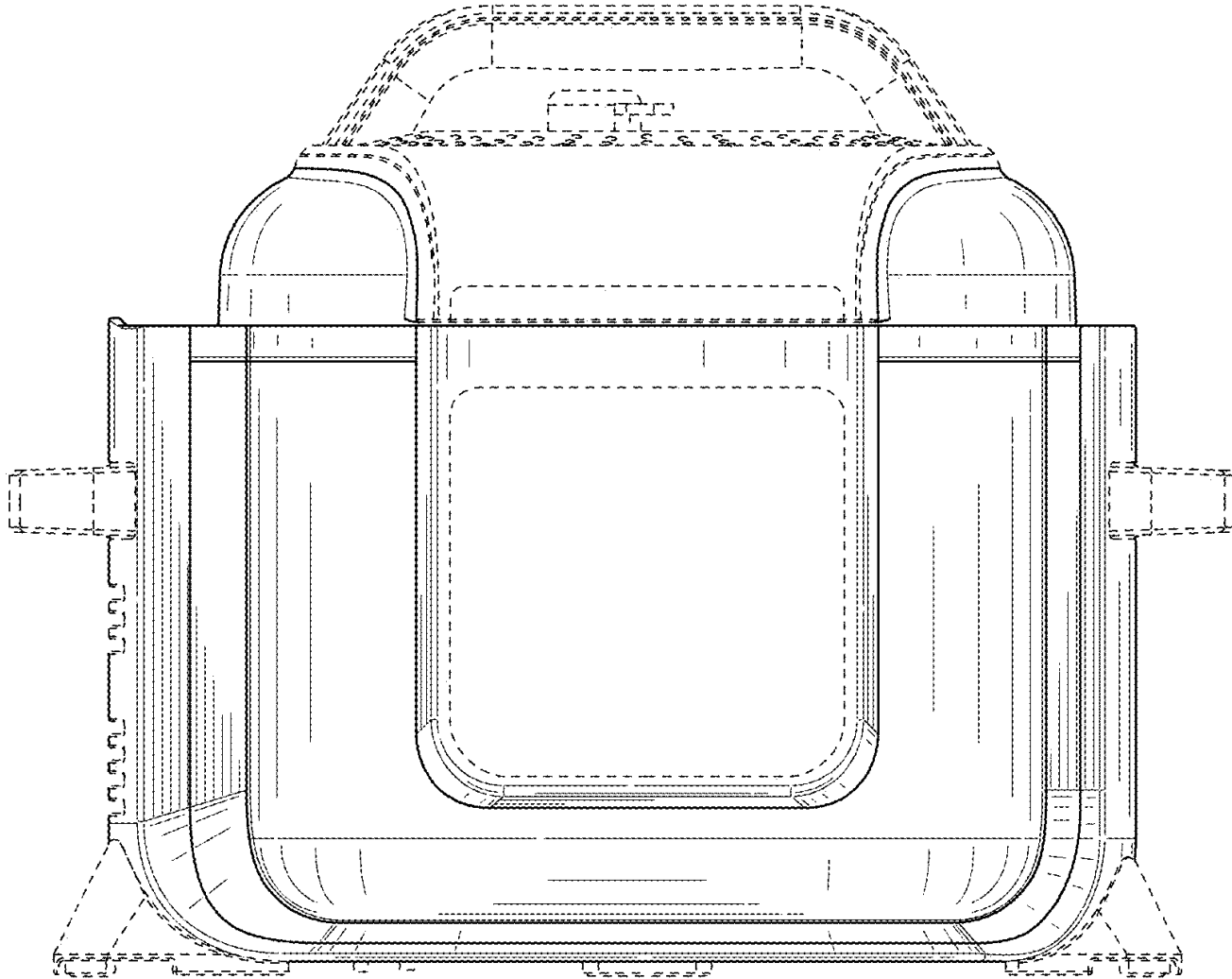
FIG. 6

# Ninja Foodi, US D874,211



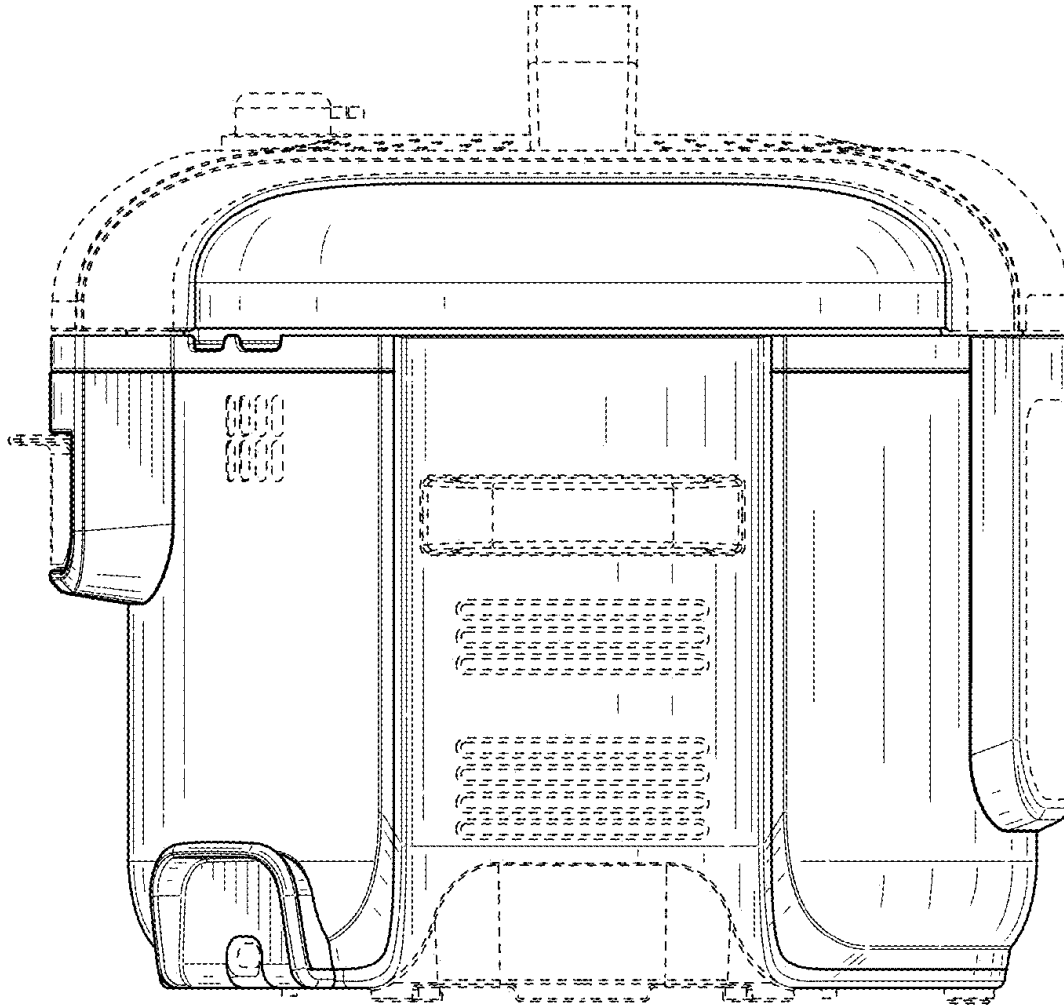
**FIG. 1**

# Ninia Foodi. US D874.211



**FIG. 2**

# Ninja Foodi, US D874,211



**FIG. 5**

# Ninja Foodi, US D883,017

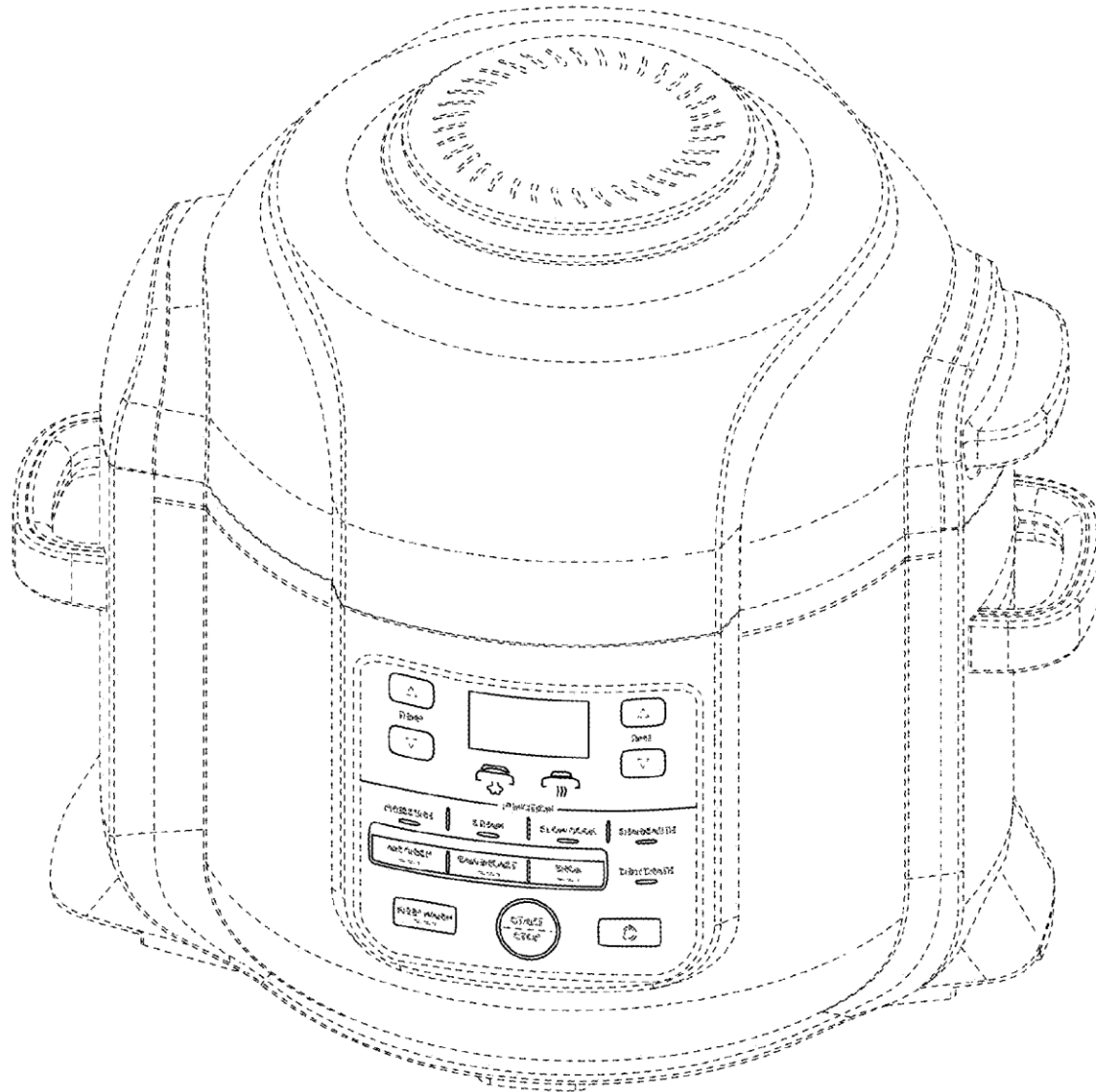


FIG. 1

# Ninja Foodi, US D883,017

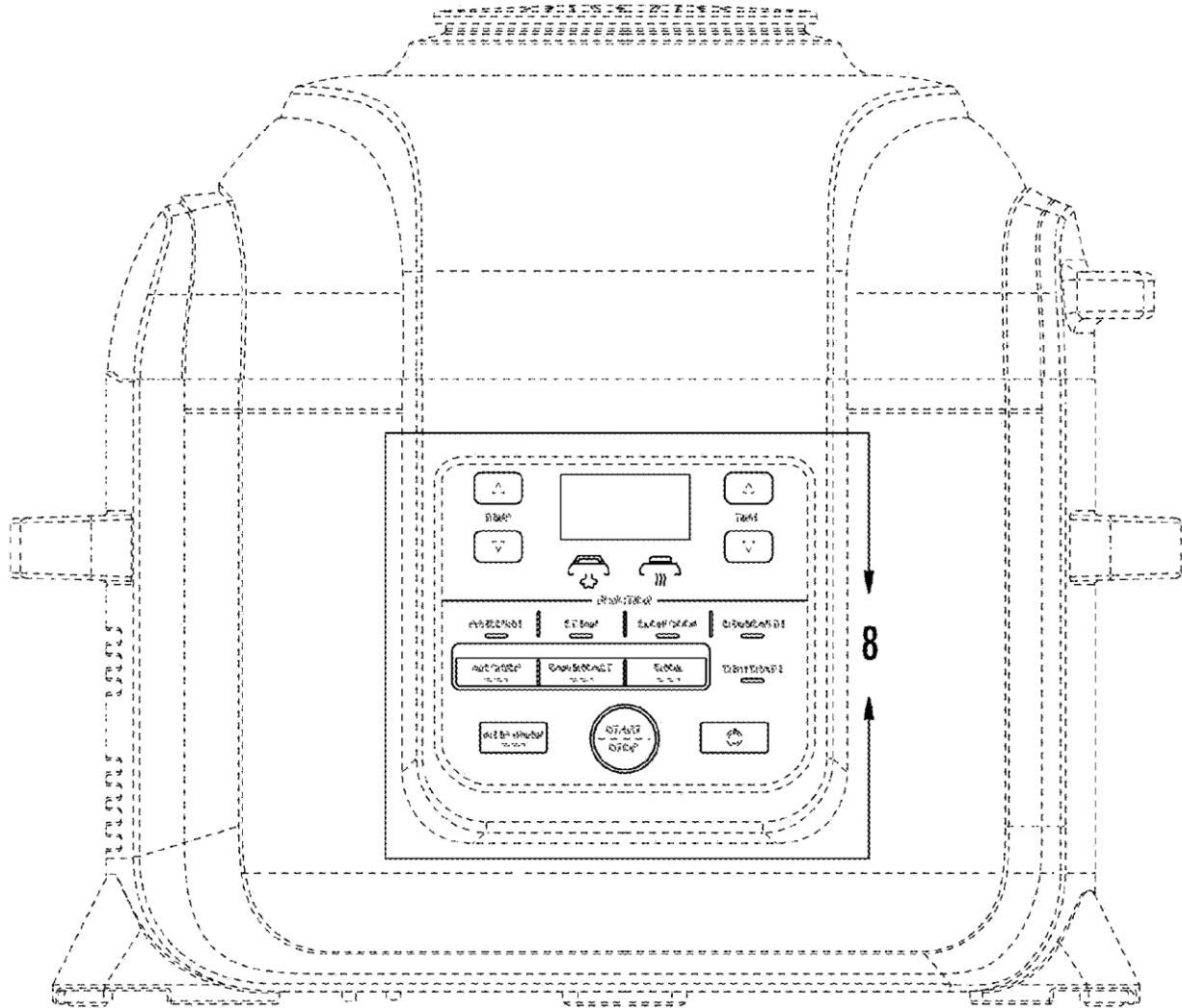
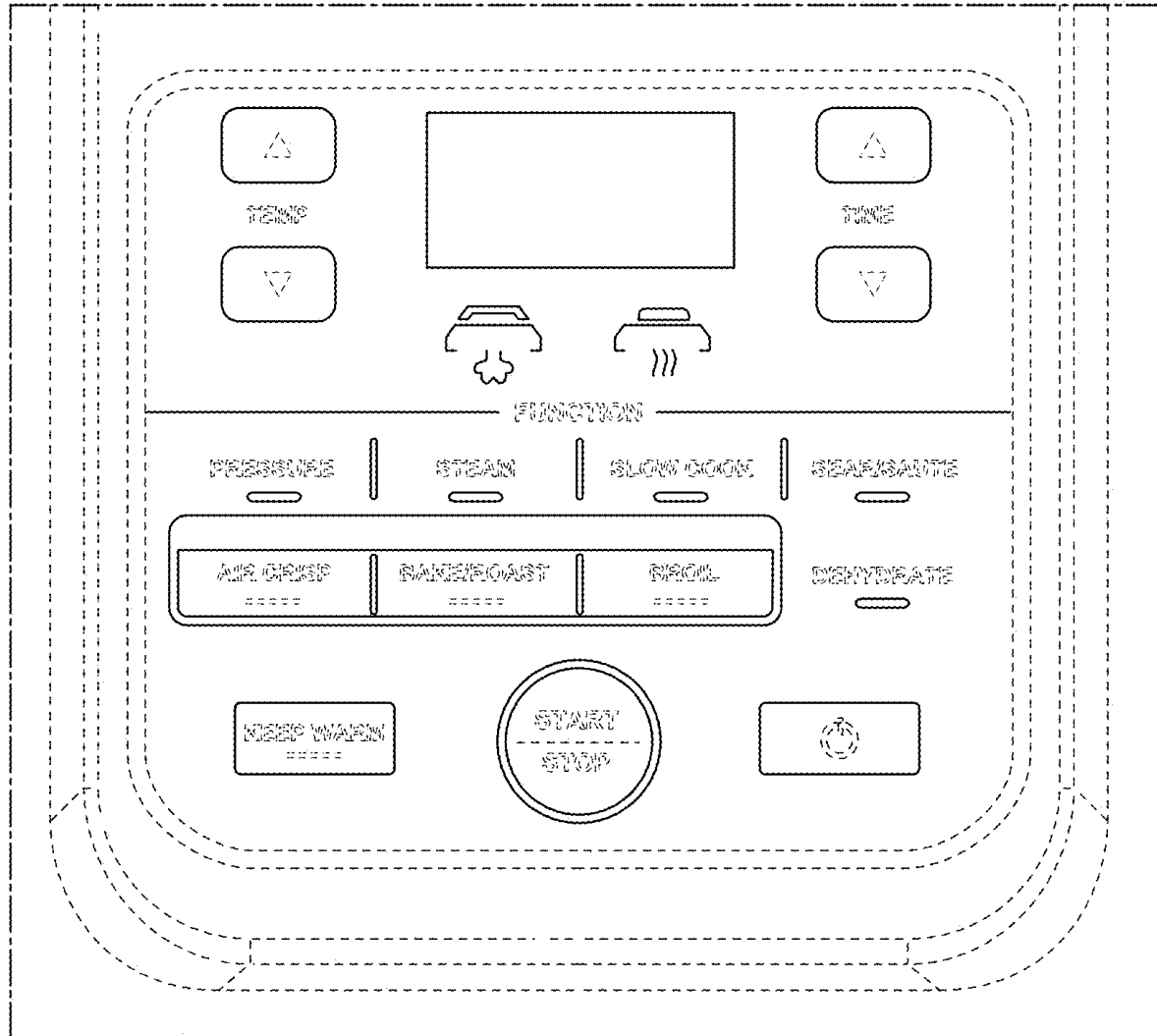


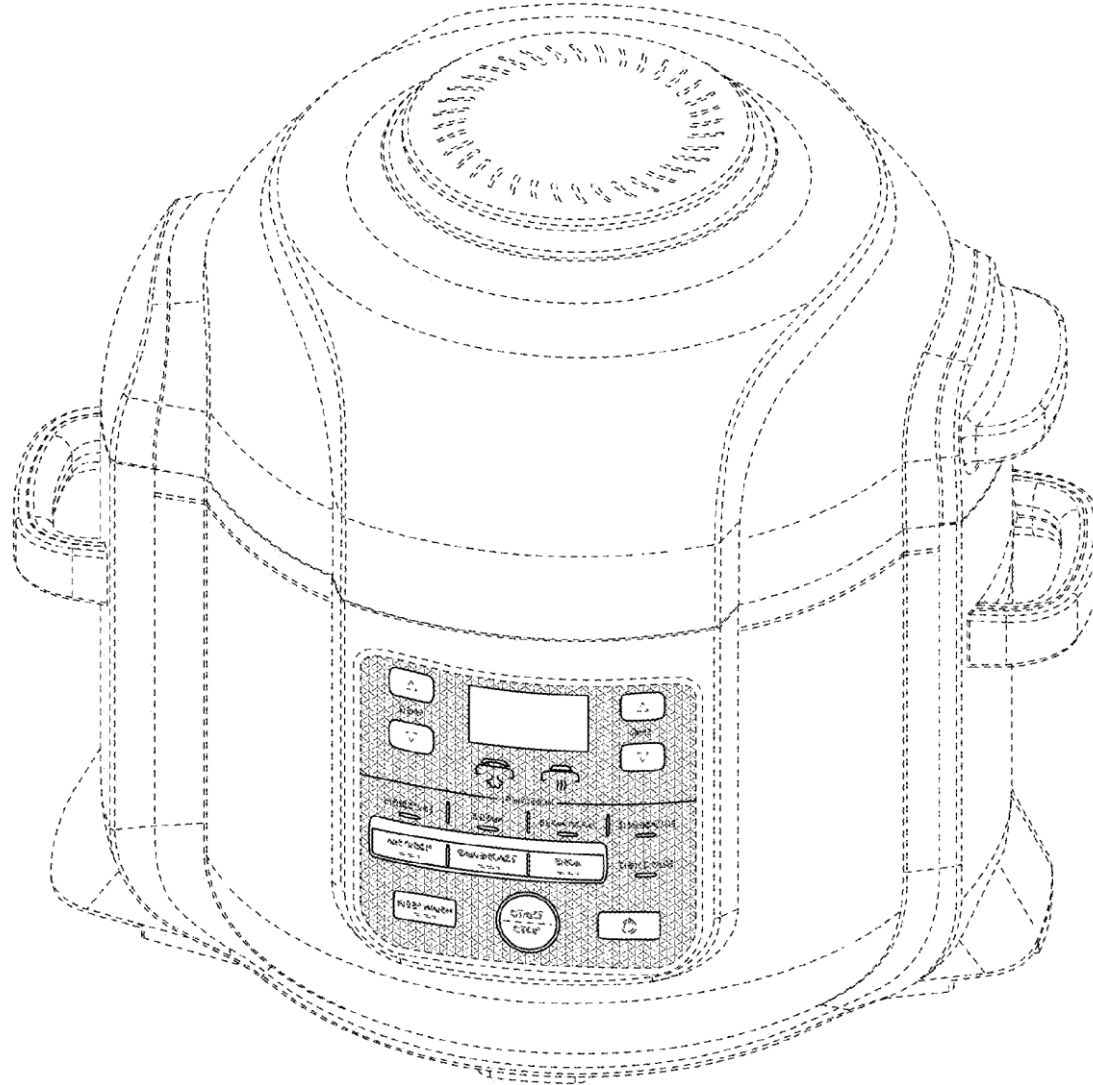
FIG. 2

# Ninia Foodi. US D883.017



**FIG. 8**

# Ninia Foodi. US D883.017



**FIG. 9**

# Ninja Foodi, US D883,017

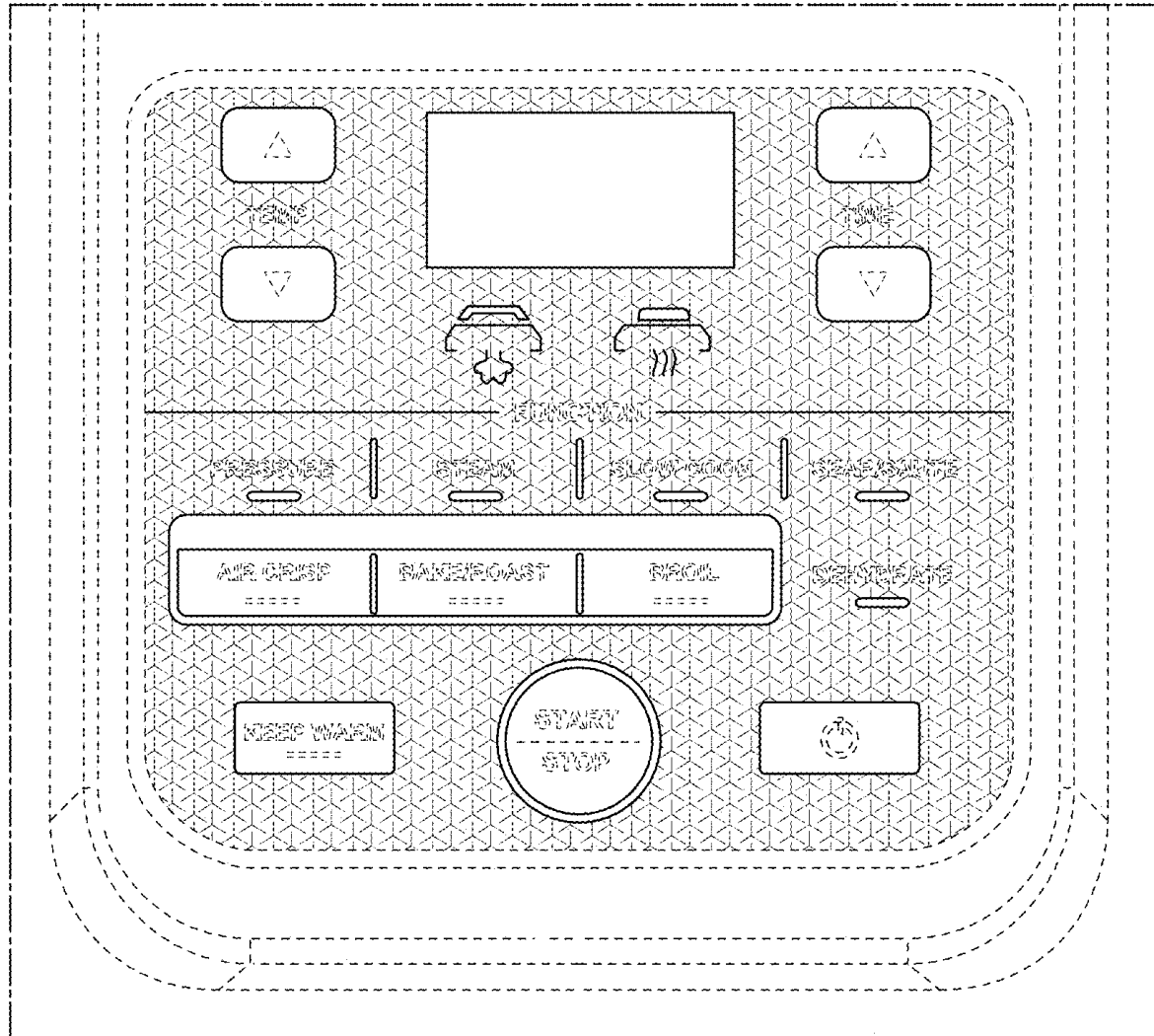
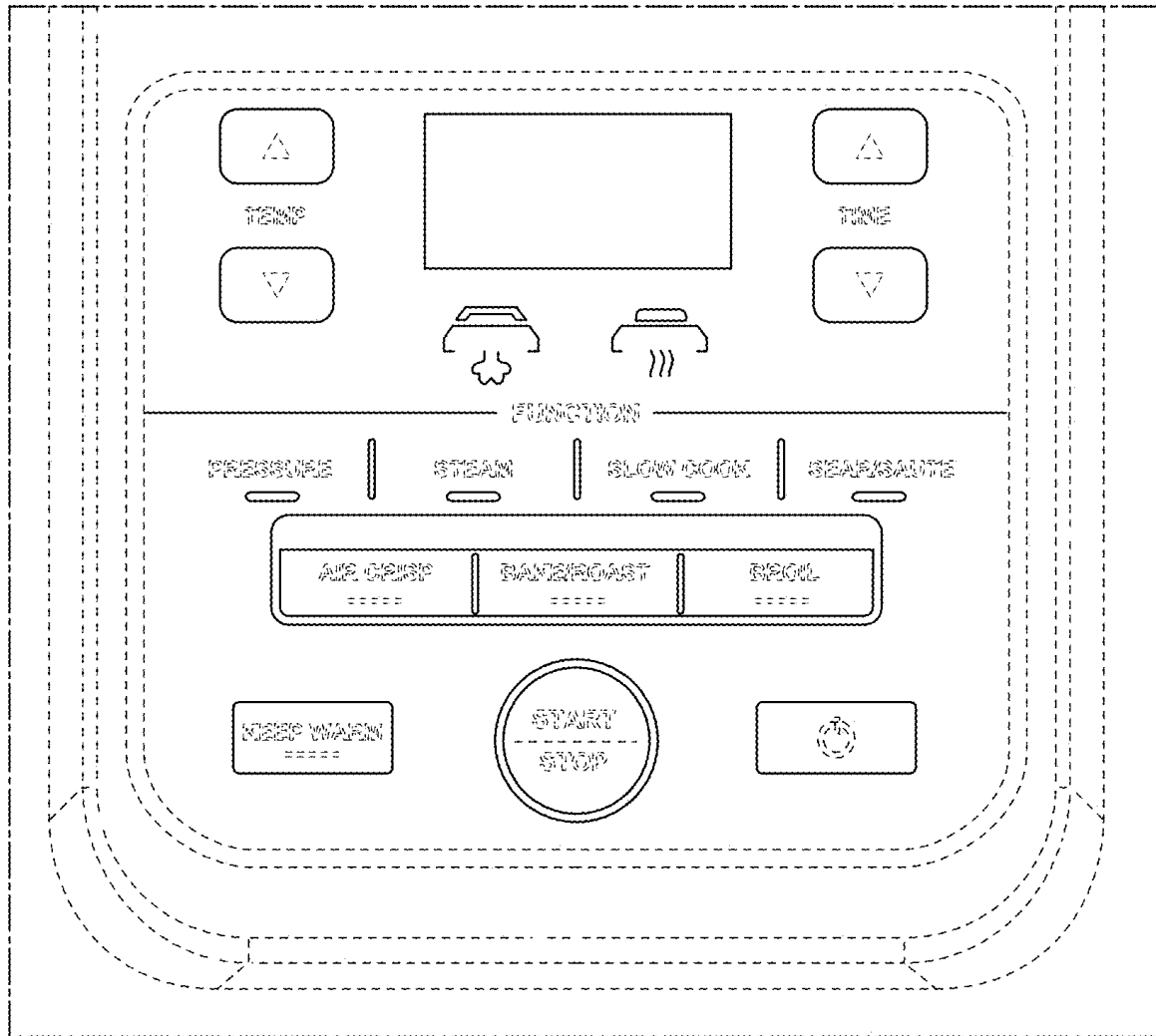


FIG. 16

# Ninja Foodi, US D883,017



**FIG. 24**

# Ninja Foodi, US D883,017

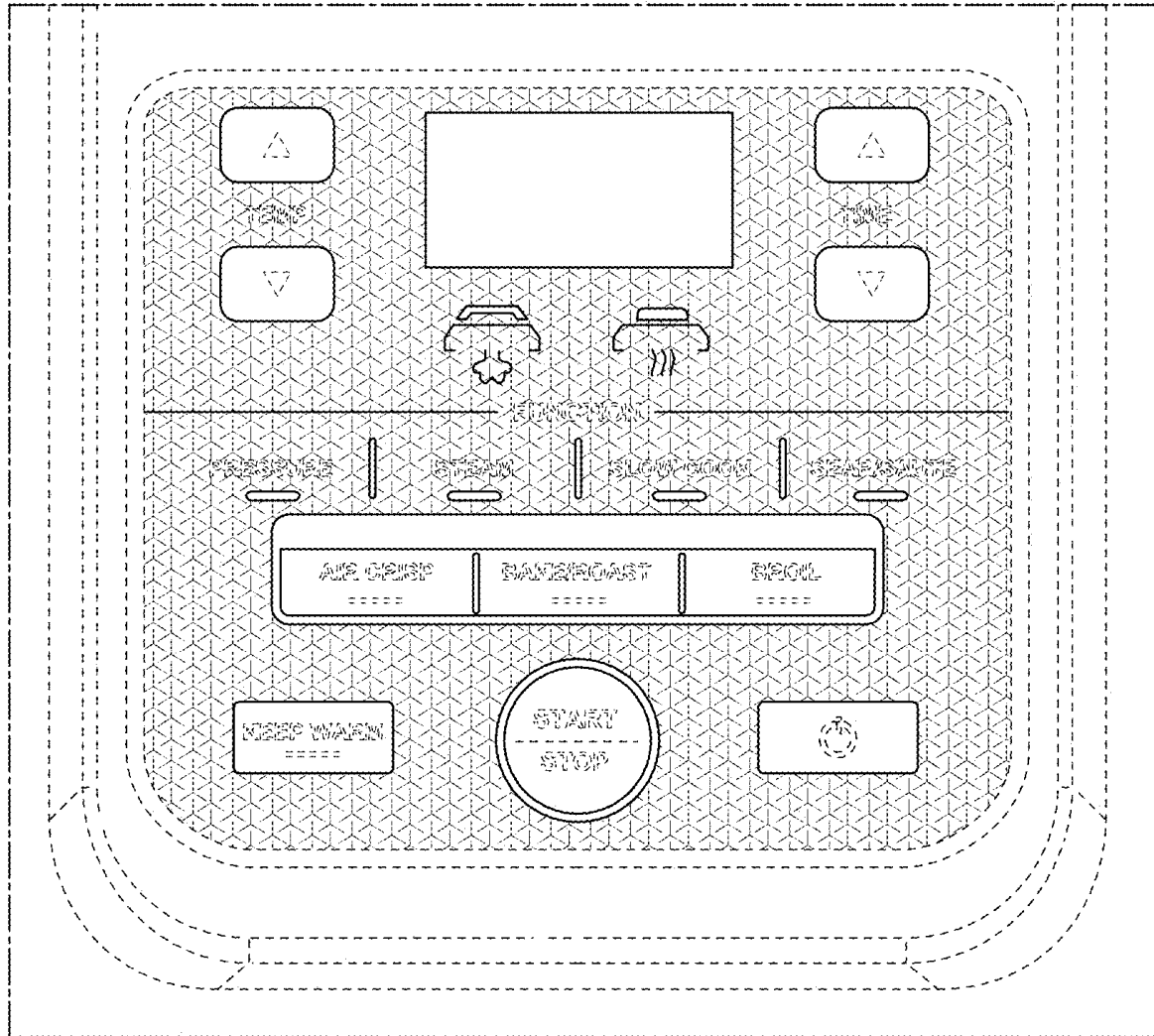


FIG. 32

# Ninja Foodi, US D876,160

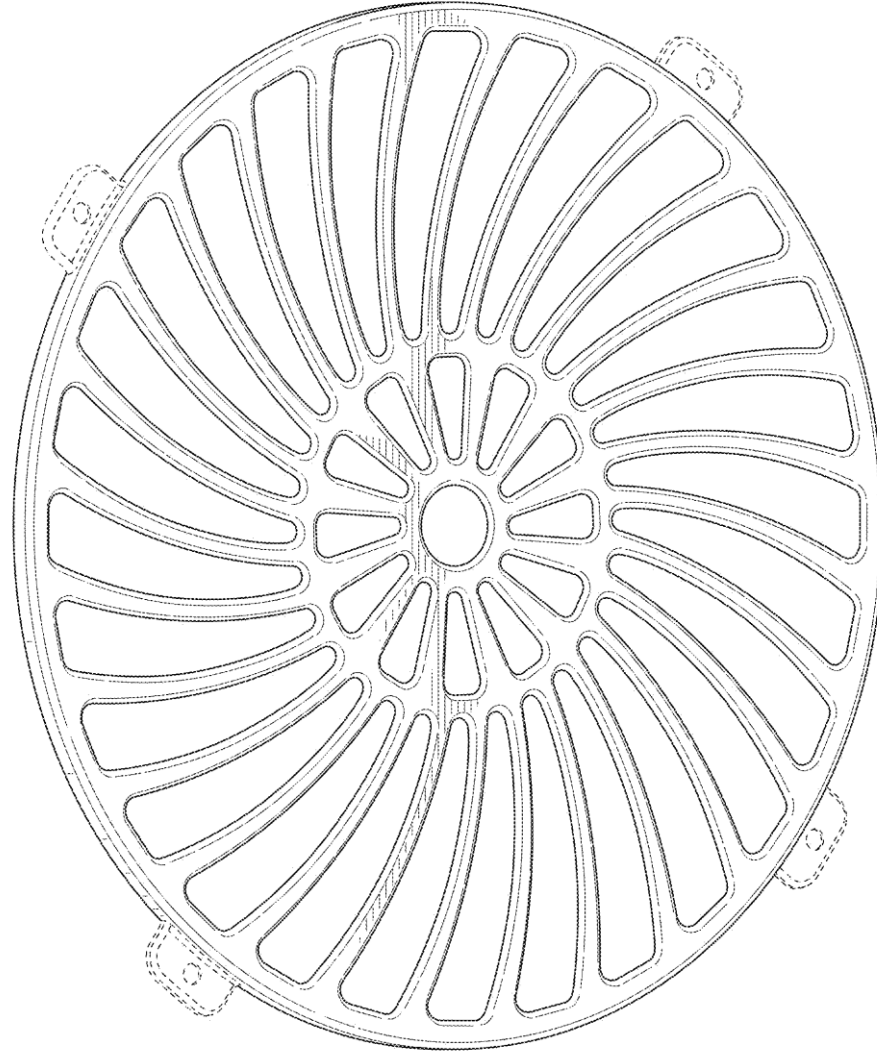


FIG. 1

# Ninja Foodi, US D876,160

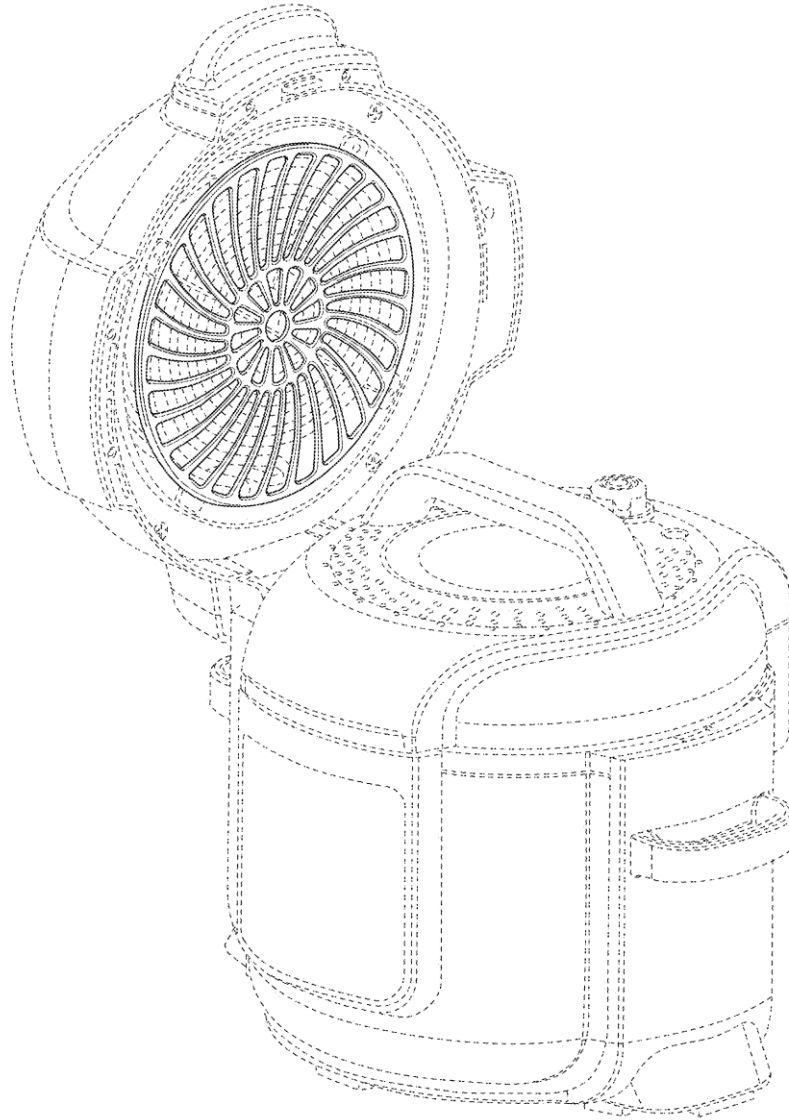


FIG. 8

# Ninja Foodi. US D876.160

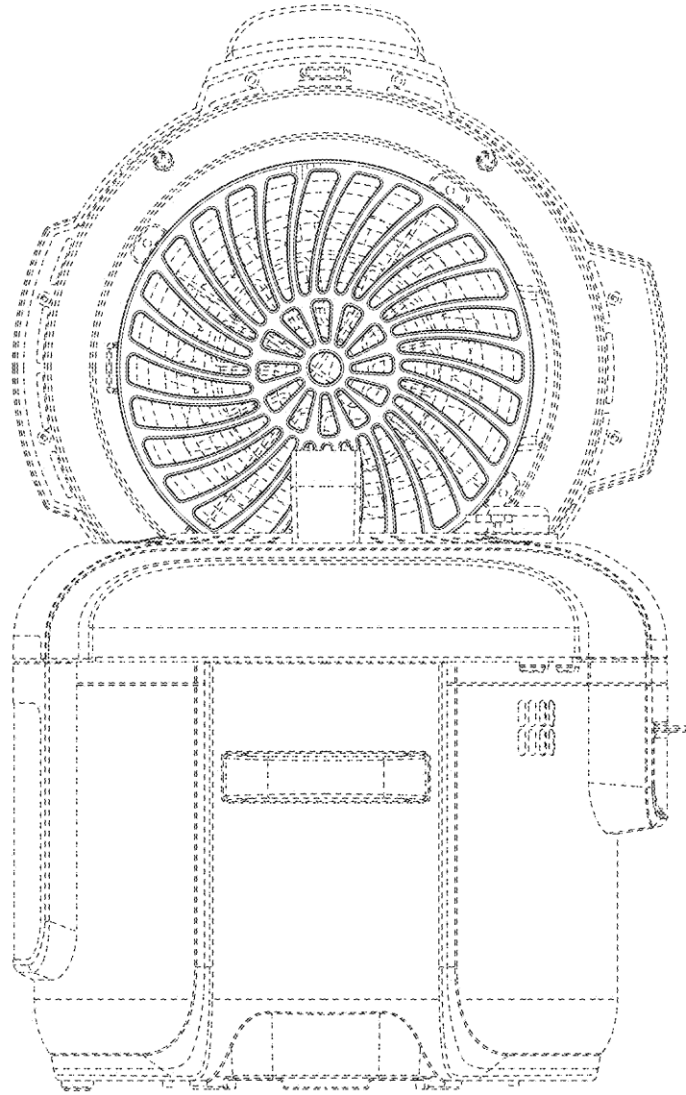


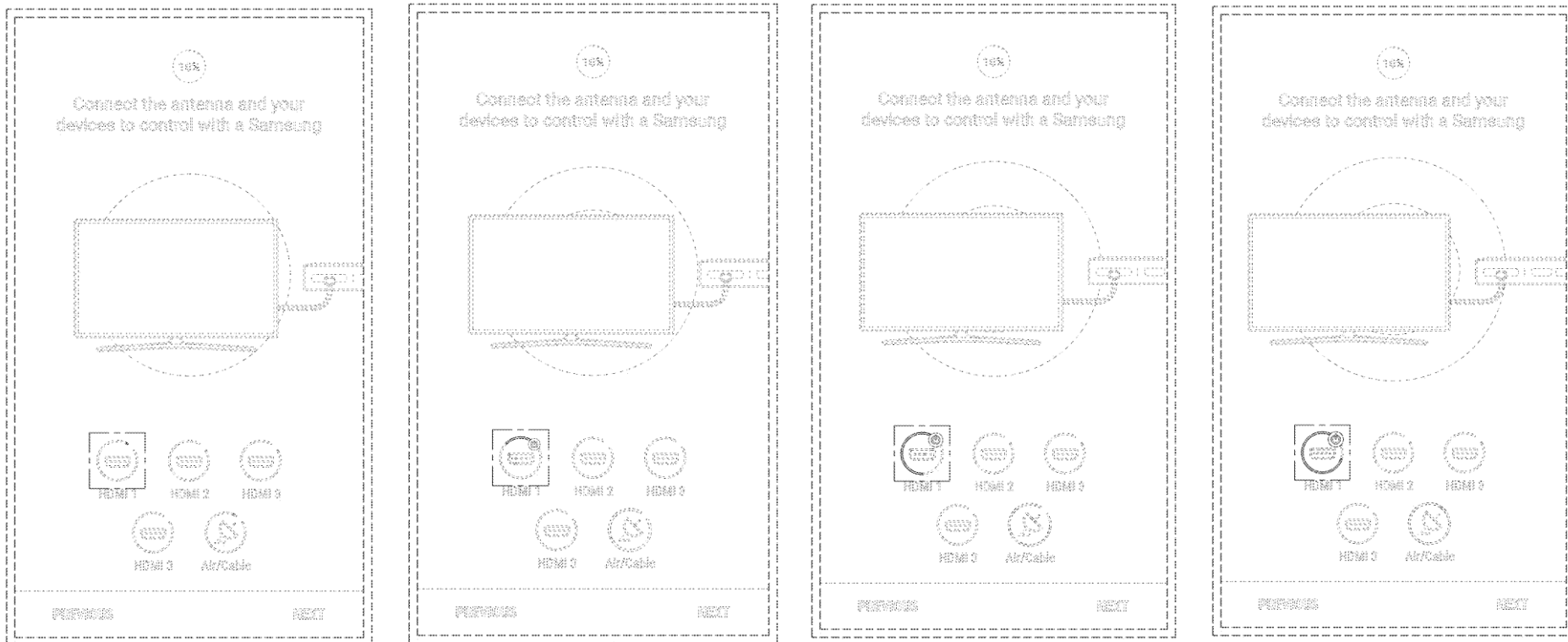
FIG. 11

# Ninja Foodi

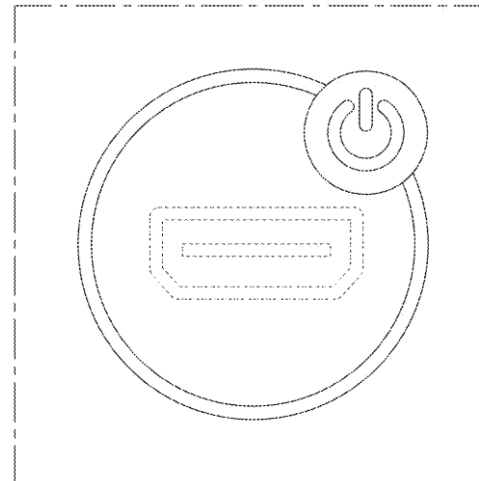
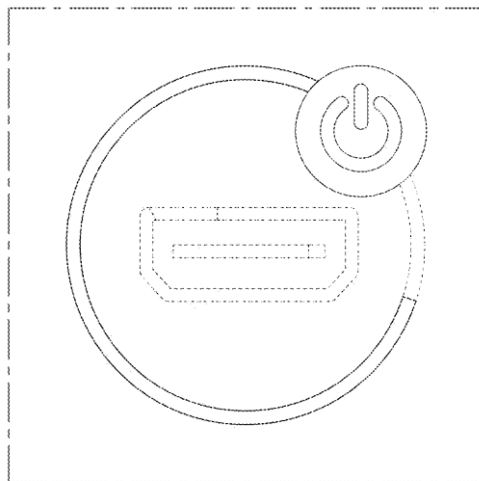
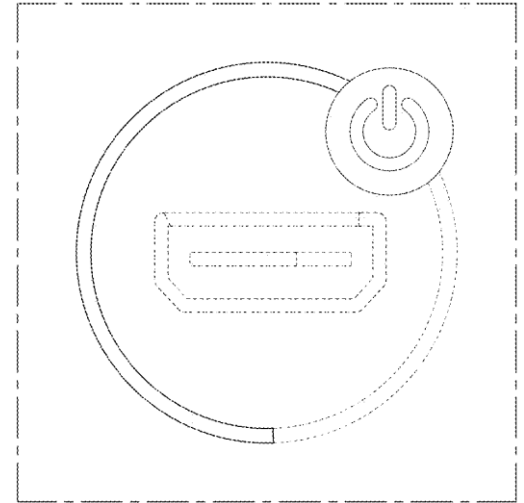
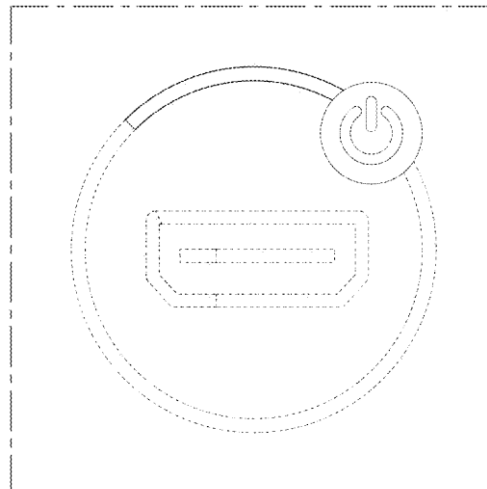
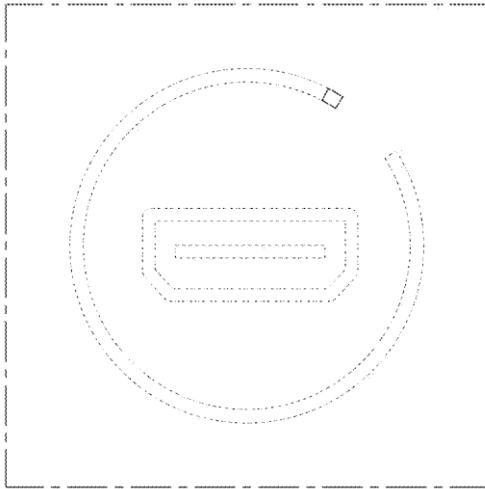


# Transitional GUIs – U.S. D870,772

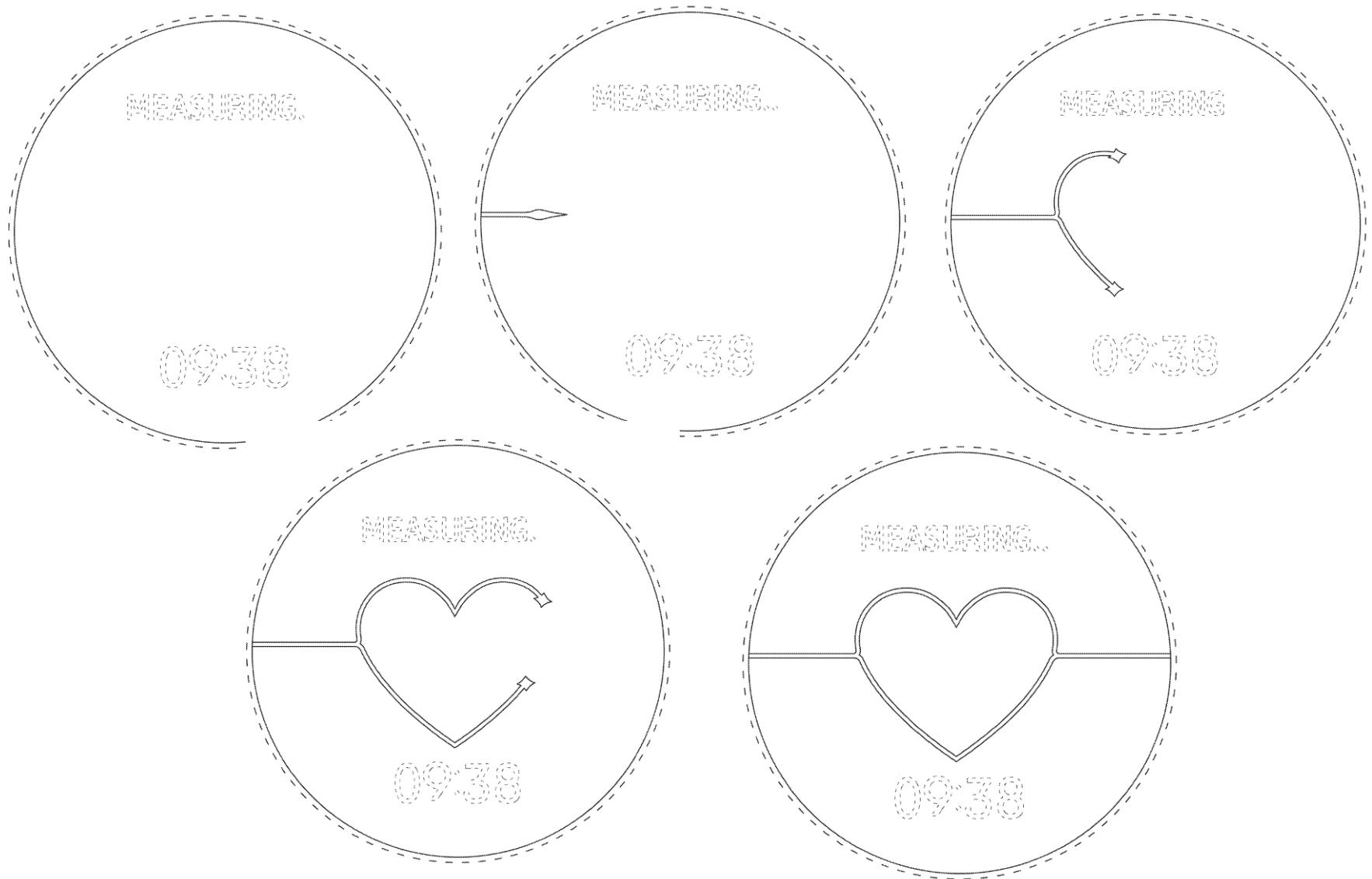
“The outer perimeter illustrated by a pair of dashed broken lines represents display screens or portions thereof and forms no part of the claimed design. The remaining dashed broken lines illustrating portions of the graphical user interface form no part of the claimed design. The dot-dashed broken lines define the boundary of the claimed design and form no part of the claimed design. The appearance of the transitional graphical user interface sequentially transitions between the images shown in FIGS. 1-5 or FIGS. 6-10. The process or period in which one image transitions to another forms no part of the claimed design. We claim: The ornamental design for a DISPLAY SCREEN OR PORTION THEREOF WITH TRANSITIONAL GRAPHICAL USER INTERFACE, as shown and described.



# Transitional GUIs – U.S. D870,772



# Transitional GUIs – U.S. D786,925



# Conclusion

- Quickest
  - Reduced pendency times
  - Few office actions (typically)
  - Higher rates of allowance
- Easiest
  - Drawings are of most importance
  - Limited written description
  - Where prior art issues arise, analysis is based upon visual impressions, not exhaustive textual review and interpretation
- Effective
  - Higher rates of success in enforcement, validity, and injunctive relief

# Cantor Colburn

# Representative Clients

- IBM
- Samsung
- Teva Pharmaceuticals
- Raytheon Technologies corporation (including Collins Aerospace and Pratt & Whitney)
- Otis Elevator
- Carrier
- General Motors
- Ferrari
- Siemens
- Georgia-Pacific
- Dow Chemical Company
- Baker Hughes
- Fox Corporation
- Hulu
- NBCUniversal
- Major League Baseball
- Mondelez
- Medtronic
- SharkNinja
- Osram Sylvania
- Serta Simmons Bedding
- National Institutes of Health (NIH)
- MIT, Johns Hopkins, Wisconsin Alumni Research Foundation (WARF), UConn, UMass, Brandeis, University of California

# Cantor Colburn Philosophy

To partner with our clients and provide them with quality, timely, cost-effective legal services, so that they can maximize the full value of their intellectual property assets.

# Full-Service IP Boutique, Practice Areas:

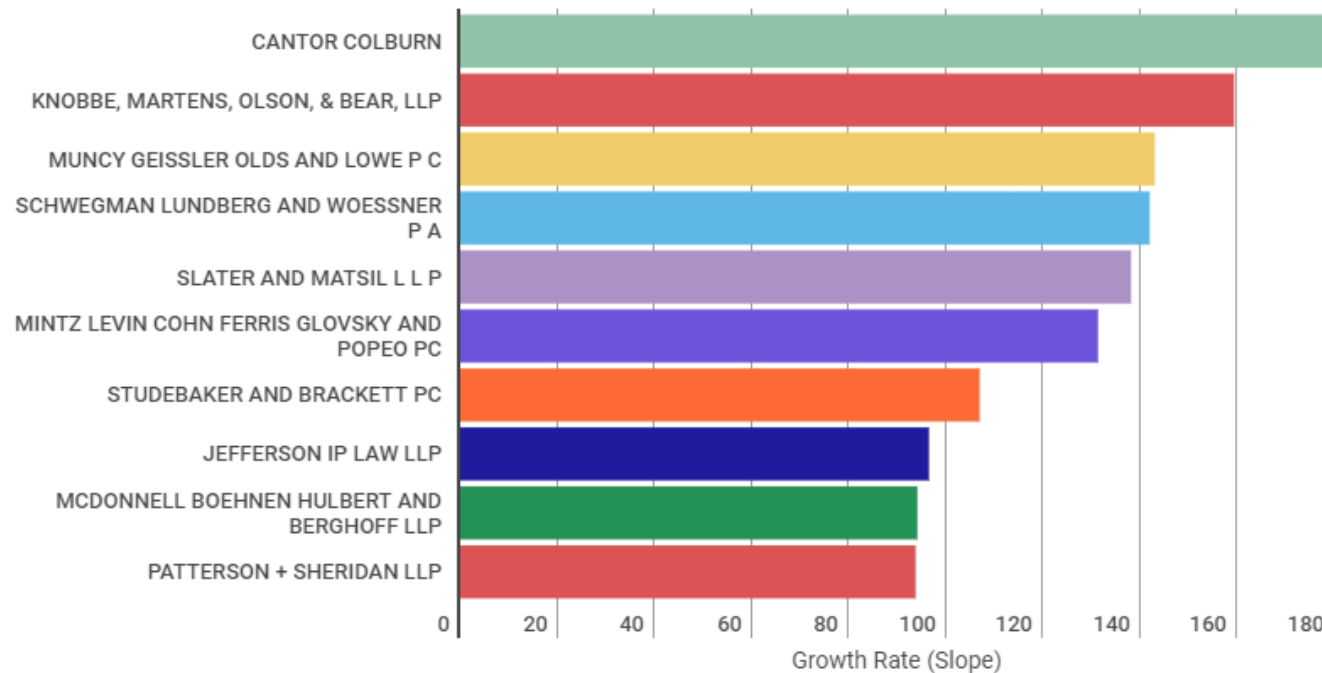
- Strategic Worldwide Patent and Trademark Portfolio Development and Management
- Filing and Prosecution
- Oppositions and Cancellations
- Due Diligence
- Opinions
- Transactional/Licensing
- Portfolio Mapping
- Audits
- Litigation

# Our Offices



And Seoul, South Korea

# Fastest Growing U.S. Patent Firm



According to patent analytics firm Juristat, from its 2018 blog post, “The 10 Fastest Growing Patent Law Firms,” over the last ten years, Cantor Colburn is the fastest growing patent firm out of more than 700 U.S. law firms.

# #3 U.S. Utility Patent Firm

Cantor Colburn is #3 for U.S. utility patents, as analyzed by respected patent blogger Ant-like Persistence, “2019 Utility Patent Toteboard,” February 2020.

Each firm was asked to report *only* US utility patents for which that firm is listed on the front page of the granted patent. The firms listed below, between them, accounted for about fourteen percent of all of the granted US utility patents in 2019.

Ranking	patents	Firm	web site
1	6088	Oblon McLelland	<a href="http://www.oblon.com">www.oblon.com</a>
2	4581	Sughrue	<a href="http://www.sughrue.com">www.sughrue.com</a>
3	4418	Cantor Colburn LLP	<a href="http://www.cantorcolburn.com">www.cantorcolburn.com</a>
4	3855	Birch, Stewart, Kolasch & Birch, LLP	<a href="http://www.bskb.com">www.bskb.com</a>
5	3394	Harness Dickey	<a href="http://www.hdp.com">www.hdp.com</a>
6	1982	Muncy, Geissler, Olds & Lowe, P.C.	<a href="http://www.mg-ip.com">www.mg-ip.com</a>
7	1947	Finnegan Henderson	<a href="http://www.finnegan.com">www.finnegan.com</a>
8	1526	Brinks Gilson & Lione	<a href="http://www.brinksgilson.com">www.brinksgilson.com</a>
9	1524	Banner Witcoff	<a href="http://www.bannerwitcoff.com">www.bannerwitcoff.com</a>
10	1476	Leydig, Voit & Mayer, Ltd.	<a href="http://leydig.com">leydig.com</a>

# #6 U.S. Design Patent Firm

Cantor Colburn is #6 for U.S. design patents, as analyzed by respected patent blogger Ant-like Persistence, “2019 Design Patent Toteboard,” February 2020.

Each firm was asked to report *only* US design patents for which that firm is listed on the front page of the granted patent. The firms listed below, between them, accounted for about twenty percent of all of the granted US design patents in 2019.

1	Banner Witcoff	<a href="http://www.bannerwitcoff.com">www.bannerwitcoff.com</a>	846
2	Birch, Stewart, Kolasch & Birch, LLP	<a href="http://www.bskb.com">www.bskb.com</a>	715
3	Sterne Kessler	<a href="http://www.sternekeessler.com">www.sternekeessler.com</a>	513
4	Wood Herron & Evans LLP	<a href="http://www.whe-law.com">www.whe-law.com</a>	388
5	Muncy, Geissler, Olds & Lowe, P.C.	<a href="http://www.mg-ip.com">www.mg-ip.com</a>	366
6	Cantor Colburn LLP	<a href="http://www.cantorcolburn.com">www.cantorcolburn.com</a>	327
7	McAndrews, Held & Malloy, Ltd.	<a href="http://www.mcandrews-ip.com">www.mcandrews-ip.com</a>	262
8	Sughrue	<a href="http://www.sughrue.com">www.sughrue.com</a>	240
9	NSIP Law	<a href="http://www.nsiplaw.com">www.nsiplaw.com</a>	234
10	Saidman DesignLaw Group	<a href="http://www.designlawgroup.com">www.designlawgroup.com</a>	234

# #11 U.S. Trademark Firm

Cantor Colburn is #11 for U.S. trademark registrations, as analyzed by respected patent blogger Ant-like Persistence, February 2020.

## 2019 US Trademark Registration Toteboard

It is my honor to post the fifth annual US Trademark Registration Toteboard.

The USPTO issued about 312105 US trademark registrations in 2019. The goal of this toteboard, brought to you by the *Ant-Like Persistence* blog, is to list the firms that helped clients to obtain these registrations. It ranks the firms according to the number of US trademark registrations obtained in 2019. Each firm was invited in early 2020 to submit a simple online questionnaire. The closing date for the questionnaires was January 31, 2020.

Ranking	number	Firm	web site
1	1605	Muncy, Geissler, Olds & Lowe, P.C.	<a href="http://www.mg-ip.com">www.mg-ip.com</a>
2	1230	Fross Zelnick Lehrman & Zissu	<a href="http://frosszelnick.com">frosszelnick.com</a>
3	915	Dunlap Bennett & Ludwig	<a href="http://www.dblawyers.com">www.dblawyers.com</a>
4	855	Barnes & Thornburg LLP	<a href="http://www.btlaw.com">www.btlaw.com</a>
5	850	Venable LLP	<a href="http://www.venable.com">www.venable.com</a>
6	811	Ladas & Parry LLP	<a href="http://www.ladas.com">www.ladas.com</a>
7	730	Fox Rothschild LLP	<a href="http://www.foxrothschild.com">www.foxrothschild.com</a>
8	484	Abelman Frayne & Schwab	<a href="http://lawabel.com">lawabel.com</a>
9	470	Hovey Williams, LLP	<a href="http://www.hoveywilliams.com">www.hoveywilliams.com</a>
10	467	Wood Herron & Evans LLP	<a href="http://www.whe-law.com">www.whe-law.com</a>
11	443	Cantor Colburn LLP	<a href="http://www.cantorcolburn.com">www.cantorcolburn.com</a>

# More Firm Rankings

Established in 1965 and through a series of name changes became Cantor Colburn LLP in 1999.

- **One of the largest IP law firms in the United States**
- #1 for growth among U.S. patents firms over 12 years, *Juristat*, 2018
- #3 in the U.S for utility patents, *Ant-like Persistence*, 2020
- #6 in the U.S. for issued design patents, *Ant-like Persistence*, 2020
- #11 in the U.S. for trademark registrations, *Ant-like Persistence*, 2020
- #6 Most Active Law Firm in High-Tech, *Patexia*, 2019
- #8 Most Active Law Firm Overall, *Patexia*, 2019
- Top Patent Firm by Tech Center, 2019
- Nationally Ranked for Patent Litigation, *Corporate Counsel*
- Top Tier U.S. law firms for patent prosecution, *Legal 500 USA*
- *US News and World Report's* Best Law Firm, 2017-2019
- *US News and World Report's* Best Lawyers, 2016-2019
- IP Stars, *Managing IP*, 2013-2019
- #1 Law Firm for Overcoming *Mayo/Myriad* Rejections, *Juristat*, 2017
- Top 100 Law Firms for Minority Attorneys, *Law360*

# Thank you for your time



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