

Bird & Bird & Design Writes

December 2015



Welcome to the seventh edition of DesignWrites

At Bird & Bird we're passionate about design. DesignWrites will unravel and explore the seemingly complex world of design protection, offering practical advice by looking at recent design cases, hearing from industry experts and sharing stories from the wider design community.

Get in touch

If you would like advice on how best to protect your designs or take action to stop copycats, please contact Ewan Grist via ewan.grist@twobirds.com

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EU: Yves Saint Laurent successfully defends the validity of its handbag design

On 10 September 2015, the General Court (GC) upheld the validity of a registered Community design (RCD) for a handbag owned by Yves Saint Laurent.



By Ewan Grist

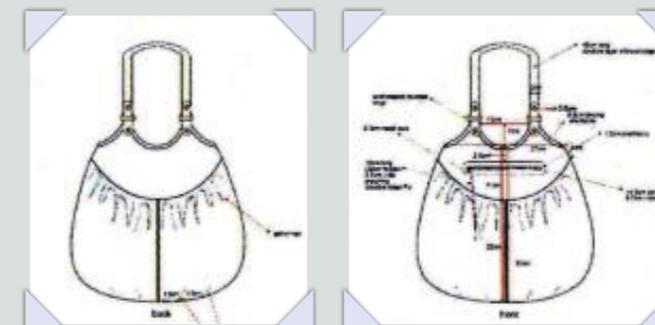
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YSL is the owner of an RCD for a handbag, two representations of which are shown below:



Source: CURIA database

H&M had applied to OHIM to invalidate the RCD on the basis that it lacked the requisite individual character for validity when compared with an earlier handbag design, shown below:



Source: CURIA database

In November 2011, OHIM's Cancellation Division rejected H&M's application, finding that the RCD was valid. H&M appealed but this was dismissed by OHIM's Board of Appeal (BoA) in July 2013, which found that despite a number of similarities, the significant differences with regard to the shape, structure and surface finish of the respective designs were decisive in a different overall impression being created on the informed user. This was despite the BoA finding that the degree of design freedom for handbags was high (the greater the design freedom, typically the greater the differences that will be required to create a different overall impression).

H&M appealed the BoA's decision to the GC. However, the GC found that the BoA had correctly addressed the relevant issues, including assessing both the similarities and differences and their respective impact on the overall impression created, taking into account the high level of design freedom. The GC made clear that the starting point for the assessment of individual character of a design is the perception of the informed user and that design freedom is merely a factor (albeit an important one) to be taken into account so as to moderate that perception. The degree of design freedom is not therefore the starting point for the assessment of individual character per se, but simply something that should be taken into consideration in the assessment. Having found no fault with the BoA's approach, the GC upheld the validity of the RCD.

 **Comment**

This is the latest in a long line of high profile design cases in the fashion industry, again demonstrating the importance that design registrations play in this world.

Determining the degree of design freedom is extremely important (although not necessarily decisive as this case shows) in both invalidity and infringement actions. In both, the question of whether the claimant's design creates the same overall impression on the informed user as the prior art design (in the case of an invalidity action) or the competitor's design (in the case of an infringement action) needs to be answered, taking into account the degree of design freedom. Where design freedom is limited (perhaps due to the need for the product to perform a technical function), only smaller differences will be required for the respective designs to create a different overall impression. Conversely where design freedom is unfettered, larger differences are needed. Design freedom is normally more limited for technical products (e.g. vacuum cleaners) than it is for fashion products, as was the case here where it was held that handbag designers had a high degree of design freedom.

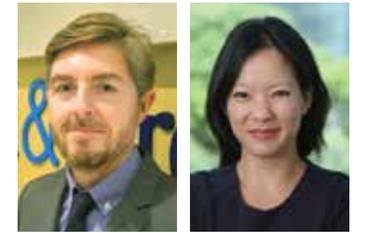
Insofar as the GC's decision confirms that design freedom is simply a factor to be taken into account when comparing the overall impressions created by the respective designs, rather than a separate test, it is uncontroversial. However, as a practical matter, given the importance of the degree of design freedom which exists for a particular product, this issue may need to be addressed in evidence, preferably from a suitably qualified design expert in that field.





China: Partial designs of graphic user interfaces (GUIs) become protectable

A proposed change to Chinese patent law, allowing for the protection of partial designs including graphic user interfaces (GUIs), will be welcome news to the mobile phone and software industries.



By David J. Pountney and Alison Wong

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With the continuing rapid technological development in the mobile phone industry, coupled with intense competition for market share, the protection of GUIs displayed on communication and electronic products as industrial designs has recently become a hot topic in China.

In the European Union, GUIs can potentially be protected design rights and/or copyright respectively. However, in China the protection of GUIs has not been straightforward. It was not possible to protect partial designs as only protection for the overall design of a product was allowed. That meant, for example, that a mobile phone manufacturer could not apply for a design patent to cover just the design of the GUI displayed on a mobile device once powered on.

However, in 2014 the Guidelines for Patent Examination were revised to allow patterns shown in the powered-on state to be protected. But because partial design protection is not allowed, applicants still have to limit the scope of the design to a complete product displaying the GUI shown only in the powered-on state. In practice this requirement significantly reduces the value of protection, as the scope of such a design patent is relatively narrow and the design could potentially be replicated by a competitor by substitution or by using it in another product.

In the near future, following the most recent amendment to Chinese patent law, published in draft form in June 2015 by the State Intellectual Property Office (SIPO), partial designs are set to become fully patentable subject matters.

According to the draft, the definition of ‘design’ is changed to any new design of the shape or pattern of a product as a whole or a ‘portion thereof’. Therefore, once in force it will be possible to protect a GUI or a pattern shown only in the powered-on state, without the limitation of protecting the GUI or pattern as a portion of the complete product. This is a significant development.

In cases of infringement, several enforcement channels are available, including administrative and judicial remedies, and enforcement action by Customs officials. There may, however, be limitations in enforcing design patents if a GUI is used on a different class of goods than for which it was registered. However, in these situations effective protection may be available under copyright law.



UK: Webmarking of product designs to be introduced

The UK Government has announced that it will introduce changes to UK designs legislation to provide registered design owners with the option to mark their products with a website address as a means of providing public notice of their rights.



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As part of the UK Government's design modernisation programme, the Government reviewed how registered design owners can mark their products so that they are able to enforce their rights more easily. Currently, owners of UK registered designs and registered Community designs have an option to mark their products with the word "registered" alongside the relevant registered design number(s) as a means of providing notice to third parties of their protected rights. Such notice ensures that anyone who infringes the design cannot later claim that they were unaware of the protected design, otherwise referred to as "innocent" infringement. In such cases of innocent infringement, the design owner is unable to claim damages, only an account of profits. Therefore, marking a product in this way (which is known as providing "constructive notice") affords protection to owners as they are armed with the means of refuting a defence that any infringement was "innocent". However, this mechanism of marking is burdensome; updating registration details (e.g., when design rights lapse or are revoked) requires re-marking of products which is time-consuming and expensive.

In light of this, the Government proposed changes to the relevant UK registered designs legislation¹ such that registered design owners would have the option to mark their product with the address of a website which links the product with the relevant registered design number(s) as an alternative way of providing constructive notice. This proposal is more attractive than the current scheme since companies are more likely to be able to organise changes to a website rather than to the tooling of a product. In addition, the costs involved in maintaining details of registered designs online are likely to be minimal.

In order to provide third parties with transparency and ease of access to the relevant information, the website should be accessible to the public free of charge. When the user clicks on or enters the marked link, the website should clearly associate the product with the registered design right number(s).

These proposed changes to allow webmarking of registered designs will be complimentary to the changes that have already been introduced for patent marking under the Intellectual Property Act 2014. The Government has taken on board the suggestion that a single website link associated with a product listing details of all the relevant patents and/or registered designs would be of significant value to companies.

As regards unregistered designs, there is no provision under the relevant legislation² that provides for the marking of a product to prevent a third party from establishing a defence of innocent infringement (although it may nonetheless be prudent to do so, where practical, simply to alert would be infringers of the rights that subsist). Accordingly, the UK Government has no plans to introduce the concept of providing constructive notice for this type of unregistered right.

Thus the proposed changes will apply to registered designs only.



¹ The relevant changes will be made to the Registered Designs Act 1949 and will also require minor amendments to the Community Designs Regulations 2005.

² Namely, the Copyright, Designs and Patents Act 1988, Part III.

Community designs: Different scope of prior art for novelty and individual character?

The General Court ('GC') recently gave a controversial judgment in *Group Nivelles v OHIM - Easy Sanitary Solutions B.V.* (13 May 2015, T-15/13) in which the GC surprisingly distinguished between prior art eligible for a novelty attack and prior art eligible for an individual character attack.

The case concerned a Registered Community Design ('RCD') for a specific shower drain registered by Easy Sanitary Solutions B.V. (ESS). The predecessor of Group Nivelles commenced invalidity proceedings on the basis of an earlier catalogue displaying an allegedly similar industrial drainage system, arguing that this destroyed both the novelty and the individual character of the RCD. ESS however, argued that this prior art should not be taken into account as an industrial drain is a product with a different nature than a shower drain and is to be used in a different sector.

The fundamental question addressed in this case was thus whether the nature of the product and the sector in which it is found should be taken into account in assessing the novelty and individual character of a design.

The GC considered that all prior designs, irrespective of the type of product to which they were applied, could be considered for the purposes of assessing novelty, but only prior designs for the same type of product as that of the contested design could be considered for the purposes of assessing individual character.



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Novelty

The court held that a design cannot be considered novel if an identical design has already been made available to the public, even if that earlier design relates to a different product.

In its reasoning the GC referred to Article 7 of the Community Design Regulation ('Regulation'), which provides, in short, that a design is considered to be made available to the public if it was disclosed in any way, except where the disclosure could not reasonably have become known to the circles specialised in the sector concerned in the EU.

At first sight this article would seem to indicate that the sector is relevant for assessing novelty. The GC however, concluded that the concept of the sector concerned is not limited to the sector in which the product is found. The GC held that Article 7 was merely intended to prevent prior art from outside the EU being misused if the prior art could not reasonably have become known to specialised circles within the EU. It was not intended to exclude prior art from a different sector within the EU.

Individual Character

Conversely, the GC held that the sector could be relevant for the assessment of individual character.

Again focusing on the text of the Regulation, the GC reasoned that individual character is a concept that has to be assessed based on the general impression a design produces on the informed user. Case law further defines the idea of the informed user as a person who will use the product according to its purpose and who will know the different designs available in the sector concerned.

The preamble of the Regulation also notes that the informed user will look at a design in consideration of the existing design corpus, meaning the designs already available on the market. The informed user will therefore take into account the nature of the product in which the design is incorporated, and in particular the industrial sector to which the product belongs. The identification of the specific product in which the design is incorporated, and the sector concerned will therefore be relevant for the assessment of individual character by the informed user. It may be that the informed user will also have knowledge of the design corpus of products from other sectors, but this cannot be assumed.

Comment

With this judgment, the GC appears to have created a somewhat artificial division between the prior art that will be permissible for the assessment of novelty and the prior art that will be permissible for the assessment of individual character.

This may have serious implications for design filing strategies and appears to make the product description (i.e. Locarno classification) of an RCD all the more important, since this will influence which prior art is permissible for an individual character attack. An earlier design from a different sector will only be considered if it is shown that the design would have come to the attention of the informed user.

The GC's decision is currently being appealed to the CJEU.



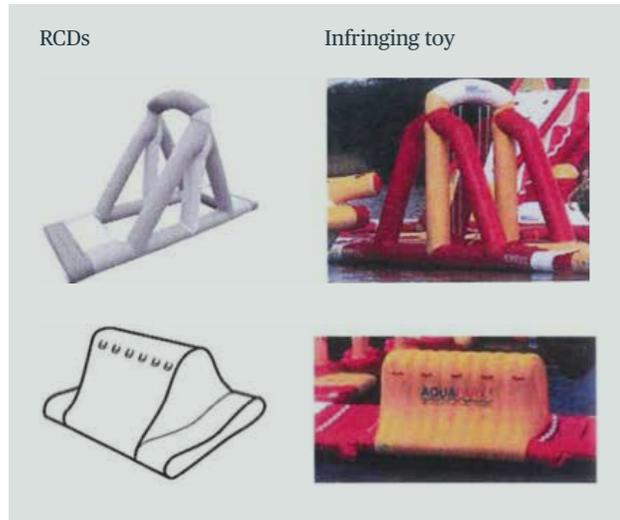
The Netherlands: Community designs, colourful even in black-and-white

In this case between Wibit-Sports GMBH and Aquaparx c.s., the District Court in The Hague followed the General Court's earlier ruling (Case T-68/10 *Sphere Time v OHIM*) that a registered Community design ('RCD') registered in black-and-white protects the owner against use of that design in any colour.



By Lara van Huizen

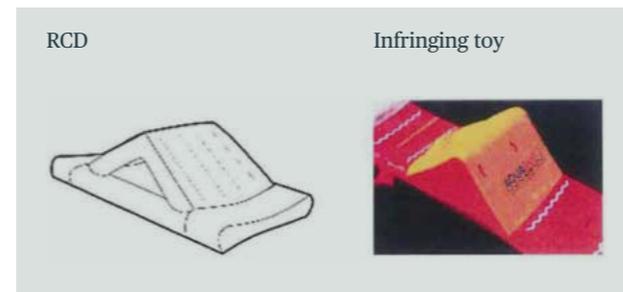
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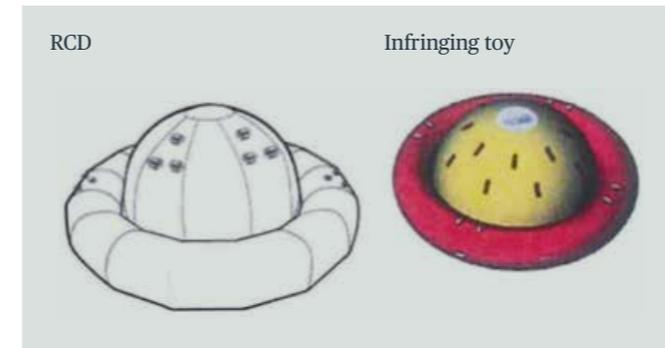
Source: IE-Forum

Wibit-Sports, a company that produces inflatable water sports products, is the owner of various RCDs. The subject of the case was whether the use of various inflatable water toys by Aquaparx infringed the designs or copyrights of Wibit-Sports, or alternatively, constituted slavish imitation.

Aquaparx claimed that the RCDs asserted by Wibit-Sports were invalid due to lack of novelty and individual character. However, Aquaparx's defence deflated when the Court ruled that the prior designs presented by Aquaparx created a different overall impression on the informed user. The argument that the designs of the water toys were solely dictated by technical function - namely to keep them afloat - was also rejected by the court. As a result, the validity of Wibit-Sports' RCDs was upheld.



Source: IE-Forum



Source: IE-Forum

Furthermore, the District Court ruled that almost all of Aquaparx water toys infringed the RCDs of Wibit-Sports. Some examples are depicted throughout this article with the RCDs on the left and the infringing water toys on the right in each case.

Aquaparx's argument that the alleged infringing products created a different overall impression due to the actual products of Wibit-Sports using different colour combinations failed because when assessing design infringement, only the RCD alone should be compared with the alleged infringing product. Aquaparx's defence that it used distinctive colours for its water toys which differed from the colourless RCDs was also rejected by the court, which made clear that a colourless RCD protects that design in all colours.

Comment

This marks a significant difference between Community trade marks and RCDs. Even though the common belief was that the scope of protection of black-and-white trade marks would extend to all colours and colour combinations, OHIM has made clear that it applies a "what you see is what you get" approach which means that the protection afforded to the trade mark is as it is registered. Trade marks filed in black-and-white are generally only protected as such and the scope of protection does not extend to all colours.



Q&A with leading British designer, Trunki

Trunki is a British company which has designed a range of innovative kids travel accessories. Trunki was founded by Rob Law MBE in 1997 after winning a university design competition. Since then, Trunki has gone on to collect a host of product and design awards, including several from Design Week, Mother and Baby, D & AD, Right Start, Practical Parenting and Nick Jr. Trunki currently sell their products in 97 countries worldwide and remain at the cutting edge of British design.



Image of 'Terrance' kindly provided by Trunki

Rob: How would you describe Trunki's signature style and/or specific approach to its product design work?

Simply understanding we have 2 customers; the parent and child who have separate needs. The parent is looking for functionality and utility which saves them time and solves their concerns when traveling with kids alongside an education angle to help their child's development. The child is simply looking for a personality they can make friends with or in our case fall in love with. Usability needs to be 100% intuitive. This leads to all our products having innovative features.

The Trunki brand is bright with our products sharing our 10 signature colours of the trunki rainbow. Our signature semi circular saddle shape is incorporated to the form of several products. Circles play a key part of our design language as the wheel represents the essence of mobility.

Rob: What is your favourite design object or product [could be one of Trunki's products or something else entirely] and why?

Probably my office chair, the Herman Miller Aeron chair. It has to be a product I get the most use out of but hardly know its there. The ground breaking design is around 20 years old but brought a revolutionary use of materials, ergonomics and longevity. And it still looks cool in our funky office!

Rob: Which trends do you think have or are having an influence on design in the UK today?

I tend not to look at trends as they are short term. Every project needs a fresh approach and to be seen through a consumer's eyes.

Rob: What are the biggest challenges that Trunki, as a product designer, is currently facing??

Other than IP infringements, there is huge pressure to make products electronic; adding technology to solve problems. We strive to find solutions using classic product design and stay focused on our core skill set of making fantastic products in plastic and fabrics. Apps can offer simple solutions to problems but consumers love hard tangible objects they can interact with and form a relationship with. After all, we still love the tactility of paper.

Laura: Some people say "imitation is the highest form of flattery". What are your views?

Nothing hits home the uniqueness and success of your idea more than being copied; seeing the success of Trunki has inspired others to jump on the bandwagon, or should that be ride-on! However, for the designer and entrepreneur, seeing your precious idea being ripped off is heart-breaking, especially when it took so much hard work and overcoming of obstacles to bring the product to market in the first place. For the small company, when your business is your livelihood, not only is it the principle of stealing ideas that hurts; it's the impact on your margin, and that of your retailers and distributors, that is so detrimental. Trunki will always be the original and best but that doesn't stop the copycats treading on our toes trying to make our concept their own. Far from flattering; in this regard imitation is potentially catastrophic.

Laura: How do you deal with the challenges posed by copycats?

For a small company, the number one consideration always has to be cost. Protecting your brand doesn't come cheap so, as well as Intellectual Property protection in the form of trade marks, patents and design registration, Trunki are as creative with our IP as our products!

We operate a several-pronged approach to battling the copycats. Online Brand Protection provides global marketplace monitoring and outreach for excellent return on investment, whilst our loyal distributors keep their eyes and ears open to any copies spotted in bricks and mortar retailers. A specialist IP firm provides a direct approach to tackling prolific copies in areas of high brand presence and distribution, giving best return on investment, whilst an in house cease & desist strategy for less crucial territories provides an opportunity to achieve the desired result for a fraction of the cost.

And, of course, our constant innovation means the copycats are only ever playing catch up!

Laura: Where would you like to see improvements in the law/court system to better protect your business?

It is imperative we see a more transparent approach to intellectual property to give UK designers the confidence to innovate. It seems crazy that the UK Government are claiming to support UK business growth on the one hand whilst maintaining a confusing judicial approach to IP on the other. Design law absolutely needs to be clarified and simplified, not just in the UK but EU wide, so that Designers can rest assured their ideas are fully protected and taken seriously.



Rob Law (CEO) and Laura Breen (Head of Legal)

Magmatic Ltd T/A Trunki

EU: General Court (GC) finds storm umbrella design to be valid

By overturning the decision of the Board of Appeal ('BoA') in *Senz Technologies BV v OHIM and Implivia BV*, the GC continues a recent tendency to accept a low threshold for individual character.



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In response to an invalidity action brought before OHIM by Implava, first the Examining Division and later the Board of Appeal (BoA) invalidated the RCDs belonging to Senz Technologies ("Senz") for asymmetric umbrellas designed to better withstand stormy weather, as shown below:



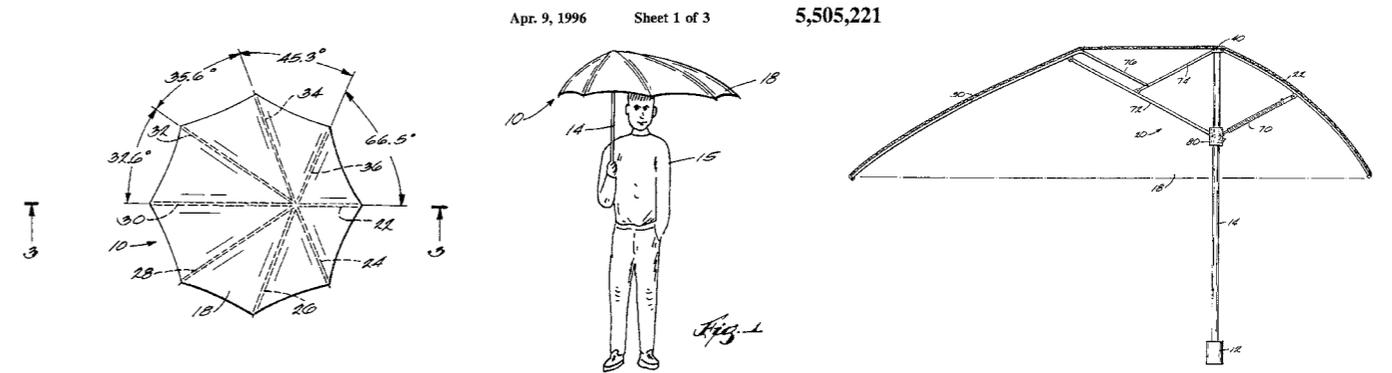
Source: Community design register, OHIM database

In their view, these designs lacked individual character over an older U.S. utility patent application published on the U.S. patent register, some images of which are shown on page 15. Senz challenged the invalidity finding before the GC and questioned whether a U.S. patent publication could constitute relevant "prior art" in the sense of Article 7(1) CDR. Senz contended that U.S. patent publications would not be known in the specialised design circles in the EU, especially considering that no corresponding product had been marketed in the EU. This approach failed. The GC held that

Senz failed to adduce the evidence necessary to substantiate such an allegation.

Senz also argued that the BoA erroneously found a lack of individual character, because its designs would produce a different overall impression on the informed user. The GC agreed. Even though there were important similarities between the respective designs, the GC noted:

- (i) the parties agreed there were technical requirements for a storm umbrella which limited design freedom. Given the limited designer freedom in relation to the shape and depth of the canopy, the ribs and the eye savers, the GC found that even minor differences between the respective shapes could suffice to produce a different overall impression on the informed user;
- (ii) the informed user would pay particular attention when considering the design; and
- (iii) although the respective designs had the same characterising asymmetrical appearance, certain other features could nonetheless substantially influence the overall impression created by the designs. The originality/innovative nature of the aforementioned features would not be such as to eliminate the informed user's attention to other distinguishing features, such as difference in canopy shape.



Source: United States Patent and Trademark Office

Comment

This decision is interesting as it confirms that there is a high burden to exclude prior art on the basis that it would not be known in the relevant sector in the EU. Only prior art which could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned operating within the EU would be excluded.

This exception is to be interpreted strictly. The example traditionally given is that of an earlier design disclosed in a remote country of the world or a design that existed in the distant past but which has completely vanished from collective memory. Senz however failed to prove that U.S. patent publications would not be known to the relevant circles in the EU. In fact, the GC found that, considering the technical nature of the product at hand, designers of wind resistant umbrellas would even be expected to consult the relevant (patent) registries, including the U.S. registry. Patents can disclose the appearance of a product and can thus be relevant as sources of earlier disclosure. So, even though the circle of relevant persons is limited to those operating within the EU, their knowledge is not subject to any territorial limitation as, for obvious reasons, they do

not operate in a closed off environment. This interpretation is in line with earlier decisions¹ and underlines the potential importance of carrying out extensive prior art searches in order to be confident in the validity of a Community design.

With respect to the determination of individual character, it is remarkable that, even though the GC confirmed the findings of the BoA in many aspects, ultimately it overturned its decision and confirmed the validity of the contested design. Important to this decision seems to be the GC's finding that, even though the overall shape of the older asymmetrical storm umbrella was revolutionary in its kind, informed users would still be able to perceive other (possibly minor) features distinguishing a younger umbrella design. That is especially true if the design at hand is largely determined by its technical requirements.

This decision seems to - rather generously - allow competitors to build further on what could be a revolutionary basic design. The GC confirms earlier decisions² setting a relatively low threshold for a finding of individual character and hence validity of Community designs.

¹ *H. Gautzsch Großhandel v Münchener Boulevard Möbel Joseph Duna*, Case C-479/12, CJEU 13 February 2014.

² *Argo Development and Manufacturing v. OHIM*, Case T-41/14, ECFI 28 January 2015.



U.S. Focus: On the design protection in the United States

Over the past decade, businesses and consumers in the U.S. have embraced design in all forms. The appearance of a well designed product might reflect and evoke innovation, identity, quality and care, and in these ways good design translates to market advantage. Intellectual property rights exist in product and software designs and are important assets for design innovators and entrepreneurs as well as market leaders.



By George Raynal (Partner)
Saidman Design Law Group LLC, U.S.

In the U.S., although a design might be amenable to copyright and trade dress protection, both have limitations, and product designs will generally find more effective protection in the form of a U.S. design patent.

Design patents protect designs of many types and forms - physical and digital; two-dimensional and three-dimensional. In its Examination Manual, the U.S. Patent and Trademark Office (USPTO) states that the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation (Manual of Patent Examining Procedure (M.P.E.P.)).

A survey of recently issued design patents reveals designs for furniture and housewares, consumer products and packaging, surface patterns, athletic apparel and sporting equipment, electronics, automobiles and other vehicles, manufacturing and industrial equipment and many other types of designs. Wherever there are consumer and technology trends, design patents are important - expect to see an influx of design patents issued for wearable and rideable devices, robotics and drones, and fashion and luxury goods, in addition to the already constant stream of design patents issued for Graphical User Interfaces ('GUI's), which protect the appearance of software, apps and icons.

In addition to the increasing importance of design generally, over the past 4 years, high-profile litigation between Apple and Samsung has pushed design patents into the spotlight.

Once obscure, securing and enforcing of design patents now garners more attention, and rightfully so when the stakes are so high - the statutory provision for design patent damages calls for total profits from sale of the infringing article of manufacture, with no apportionment, (see 35 U.S.C. Sec. 289). This is meaningful protection to designers and entrepreneurs building businesses around their work, to prevent would-be infringers from free-riding on their designs.

In *Apple v. Samsung*, on appeal to the U.S. Court of Appeals for the Federal Circuit (the 'Federal Circuit') Samsung argued that damages should have been limited to the profit attributable to the infringement, but the court declined to adopt a causation rule or limit profit to the infringing portion because the language of the statute is clear in setting liability for total profit of any article to which the patented design is applied (786 F.3d 983, 1002).

In Europe, designs are well protected under the OHIM's Community Design system that protects both registered ('RCD's) and unregistered designs. The U.S. design patent system shares some similarities with RCDs but also has unique requirements and features to consider.

Design Protection in the U.S. compared to Europe
In Europe, designs are well protected under the OHIM's Community Design system that protects both registered ('RCD's) and unregistered designs. The U.S. design patent system shares some similarities with RCDs but also has unique requirements and features to consider.

Both systems grant protection on a first-to-file basis, so designers are encouraged to file early and before public disclosure. Although both systems have exceptions which allow filing after public disclosure, the exceptions should not be relied on unless truly necessary, as filing after public disclosure might result in third party intervening rights and might preclude filing in other countries which more strictly require filing before public disclosure.

The European RCD and U.S. design patent systems both allow line drawings and digital images (photos and computer graphics) to illustrate the design for which protection is sought, and both allow the use of broken lines to identify aspects which form no part of the protected design.

The European RCD and U.S. design patent systems also both allow multiple designs to be filed in a single application.

However the systems diverge in that RCD applications are not examined for validity before registration, whereas U.S. design patent applications are substantively examined to ensure that the statutory criteria for protection are met before a patent is issued. Accordingly, the time between filing and having an enforceable right is much longer for a U.S. design patent than for an RCD; however U.S. design patents have a presumption of validity which requires clear and convincing evidence to overcome.

To qualify for U.S. design patent protection, a design for an article of manufacture must be new, original and ornamental. (See 35 U.S.C. 171.)

"New" is unpacked as novel (in accordance with 35 U.S.C. 102) and non-obvious (in accordance with 35 U.S.C. 103).

A design is novel if no single prior art reference discloses a design that is identical in all material respects. Recently, the Federal Circuit equated "identical in all material respects" to "substantially the same" which is the test for design patent infringement. This is generally unfavourable for design protection, making it easier for a design patent to be denied or invalidated, and is not in line with design patent case law and is likely to be challenged in court.



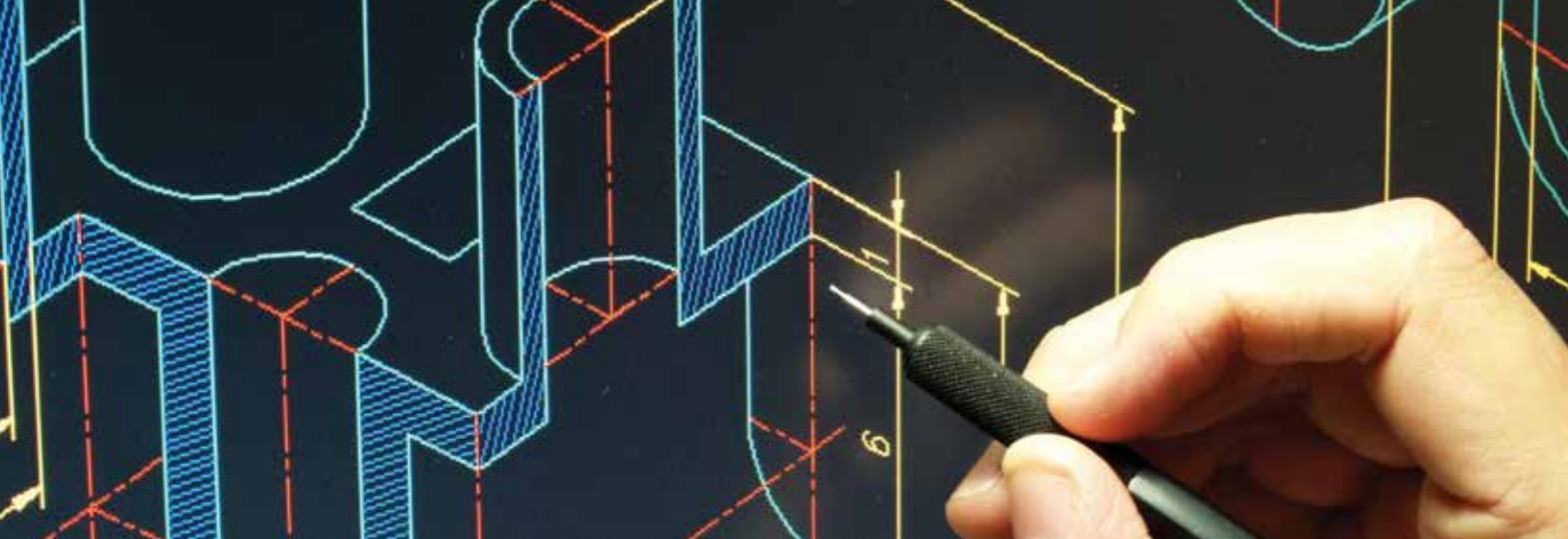
A correlation between validity and the test for infringement of a design patent, is perhaps more reasonably drawn to the test for obviousness, which as a first step requires a primary reference which presents 'basically the same' overall appearance as the claimed design. 'Basically the same' and 'Substantially the same' each seems to allow leeway, whereas novelty is traditionally applied more stringently. Once a primary reference is found, one or more secondary references may be relied on to modify the primary reference to create a design that has the same overall visual appearance as the claimed or patented design, provided that the primary and secondary references are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. Obviousness is determined from the perspective of a designer of ordinary skill who designs the articles of the type involved, whereas infringement is determined from the viewpoint of an ordinary observer. This is another distinction between U.S. design patents and RCDs, the latter being judged for both validity and infringement from the perspective of an informed user

The requirement of originality in U.S. design patents generally excludes protection for a design derived from any source or person other than the named inventor (designer), including, e.g., a design which simulates an existing, well-known or naturally occurring thing.

A design is sufficiently 'ornamental' if its overall appearance is not dictated by function, which is nearly always the case for any given product. Whether a design is ornamental is infrequently an issue during examination of a design patent application but has frequently been misapprehended as an issue during infringement analysis.

Presenting ideas to satisfy USPTO standards

Additionally, to qualify for design patent protection, a design must be illustrated in a manner that satisfies 35 U.S.C. 112, to provide a clear understanding of what the design looks like.



Practically speaking, to satisfy USPTO standards the design should be illustrated such that the overall shape and contour of the claimed design are clearly understood. Frequently, a design will be illustrated in 6 directional views (front, back, top, bottom, left, right) and one or more perspective views, which can generally be helpful to understand the design. There are no strict requirements for which views must be submitted; an applicant should submit views which are believed to adequately illustrate what the designer regards as his/her design. For example, an applicant might wish to provide additional isometric or perspective views, enlargements, or cross-sections, or omit views which would not show any part of the claimed design, such as the underside of an automobile. Surface shading on line drawings can be helpful in satisfying USPTO standards, but is not necessarily required provided that shape and contour can be understood without it. Surface shading might also be employed to illustrate an aspect of the design to be claimed, such as finish, contrast, colour, texture, material, translucency or transparency and illumination.

Additionally, an application may include views which are subsequently cancelled and are not printed in the patent but remain part of the application disclosure. In this manner, an applicant may disclose illustrations which support amendment to the drawings, to satisfy USPTO standards or to adjust claim scope as desired, and illustrations which may be claimed in continuing applications.

Multiple Designs

Filing multiple designs in a single application presents a great opportunity for economy and flexibility, and warrants careful consideration of both how to illustrate the designs and manage the examination of related designs.

Although it is permissible to file an application with more than one design, showing varying scope or designs that are alternatives or variants, a design patent will issue with only one claim. During prosecution an examiner must determine whether the designs claimed in the same application are “basically the same” (i.e., obvious in view of each other) in which case they can remain in the same application and issue in one patent, or patentably distinct (i.e., non-obvious in view of each other) in which case the examiner will issue an office action requiring the applicant to elect one embodiment for prosecution and cancel the others, which may be the subject of divisional applications.

A determination that two designs appear basically the same such that a design patent issues including both, provides a good basis for an argument that an infringer’s product which might differ in an equivalent manner is nevertheless substantially the same, and infringing.



On the other hand, if two designs with minor differences are deemed not basically the same, during enforcement an accused infringer might argue that the differences between the two designs are equivalent to or greater than the differences between the asserted patent and the accused design, and therefore the accused design does not infringe.

This has occurred in litigation context and on this basis found that the accused design did not infringe. In a similar situation, the Federal Circuit has recently confirmed that prosecution history estoppel applies to design patents and may bar a claim for infringement when the applicant surrenders an embodiment in response to a restriction requirement and the accused design is within the scope of surrender.

In view of this risk, an Applicant might wish to file multiple designs in separate applications or manage the prosecution of a multiple design application in order to preclude an Examiner from taking an unfavourable position about their similarity or lack thereof which might later influence an infringement analysis.

Conclusion

The U.S. design patent system is flexible and dynamic and designers and businesses are keen to take advantage of the protection it affords. In the manners reviewed above and others, the U.S. design patent system affords opportunities for a portfolio of design rights to be built around products and product ecosystems which can be important business assets.

About the author

George Raynal is a partner at Saidman DesignLaw Group, LLC, where his practice covers all aspects of design law, with a particular focus on U.S. and international design patent/registration prosecution and enforcement. George helps individual designers, small businesses and major domestic and foreign companies, such as electronics, consumer product and heavy equipment manufacturers, obtain meaningful design protection and enforce their rights against knock-offs.

UK: Repeal of Amendment to Increase Length of Copyright Protection of Industrially Manufactured Articles

The UK government has revoked the Commencement Order (Enterprise and Regulatory Reform Act 2013) that would have repealed section 52 of the Copyright, Designs and Patents Act 1988 in 2020.

Section 52 currently limits copyright protection for artistic works which have been industrially manufactured: where more than 50 copies of any such artistic works have been made by or with the licence of the copyright owner, the period of copyright protection is limited to 25 years. If repealed, the default term for copyright protection would apply: 70 years from the death of the creator. Hence the repeal, when it happens, will very significantly extend the duration of copyright protection for industrially manufactured artistic works, such as some furniture.

The repeal of Section 52 was brought in by section 74 of the Enterprise and Regulatory Reform Act 2013, which remains in force. However, there is now no set date for when Section 52 will be repealed. The government has said that it revoked the Commencement Order following a claim for judicial review challenging its compatibility with EU law and that it has launched a fresh consultation on transitional arrangements, including the date for implementing the repeal of section 52.



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Upcoming industry events and awards

Denim: Fashion's Frontier.

24 November 2015 - 1 May 2016
The Museum of FIT, New York

An exhibition exploring the history and cultural significance of one of the world's best loved fabrics: denim.

<https://www.notjustalabel.com/event/denim-fashions-frontier>

2016 International Conference on Design Principles and Practices

25-26 February 2016
Rio de Janeiro, Brazil

A cross-disciplinary conference including workshops and presentations on themes including Design in Society and Visual Design.

<http://lanyrd.com/2016/designpp/>

The International Interiors Show

18-24 January 2016
IMM Cologne, Germany

National and International exhibitors present intelligent room solutions and interactive interior design products at this bi-annual event.

<http://www.imm-cologne.com/imm/index-2.php>

German Design Award. Excellent Product Design

12-16 February 2016
Frankfurt, Germany

Presented by the German Design Council at Ambiente, the contenders for this popular award are designers of series-made products who have already received a design award. Extra prizes go for exceptional communication design and for outstanding personalities.

<http://ambiente.messefrankfurt.com/frankfurt/en/aussteller/events/german-design-award.html?nc>

INNO Design Tech Expo

3-5 December 2015
Hong Kong Convention & Exhibition Centre

This highly attended Hong-Kong based expo provides a platform for designers to meet, share and grow ideas.

<http://www.eventseye.com/fairs/f-inno-design-tech-expo-14314-1.html>

International Design Conference on Sustainability with focus on Water

4-5 December 2015
VMCC, IIT Bombay, Mumbai, India

A conference designed to create awareness and reveal a fresh perspective from leading thinkers in the field of design and sustainability.

<http://www.cumulusmumbai2015.org/conference.html>

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