Computers and the Law

Legal Environment

Randy Canis

CLASS 6

Patent Law pt. 1
Patent Law

- What legal rights are obtained through ownership of a patent?
- What is patentable?
- What qualifications must be met to obtain a patent?
- How can a patent be enforced?

Why Own a Patent?

- Ownership of a patent gives the patent owner the right to exclude others from making, using, offering for sale, selling, or importing into the United States the invention claimed in the patent.
- 35 U.S.C. 154(a)(1), MPEP 301

How Long Does a Patent Last?

General Rule
- 20 years from filing (starting from the date of issuance) 37 U.S.C. 154(a)

Exceptions
- If filed before June 8, 1995, 20 years from date of filing or 17 years from issue, whichever is longest
- Time with a Provisional Application does not count against the term
- Patent Term Adjustment for delays during patent prosecution 37 U.S.C. 154(b), MPEP 2730

Three Types of Patents

- Utility Patent – an invention that is functional and useful
- Design Patent – a new, original, and ornamental design of an article of manufacture
- Plant Patent – protection on a new variety of plant that has been asexually reproduced through grafting, budding or a similar technique

What is the Process for Obtaining a Patent?

- Conceive the invention
- Determine who owns the invention
- Prepare an invention disclosure
- Perform a patentability search
- Prepare and file a nonprovisional patent application
- Prosecute the patent application before the United States Patent and Trademark Office (USPTO)
- Obtain a notice of allowance
- Pay the issuance fee
Pre-Filing

- Conception –[Diligence]->
- Reduction to Practice –[Diligence]->
- Filing of the Application

Conception

- Conception is the mental formulation and disclosure by the inventor of a complete idea for a product or process.
- The idea must be of specific means, not just a desirable end or result. Chisum §10.4
- An inventor must present proof showing possession or knowledge of each feature of the invention to a corroborating witness in sufficient detail to enable one skilled in the art to practice the invention.

Reduction to Practice

- An inventor may reduce an invention to practice either constructively by the filing of a patent application or actually by building and testing a physical embodiment of the invention.
- “[T]he act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the invention.” Yasuko Kawai v. Metlestics, 480 F.2d 880

Patent Prosecution 101

- Patent Prosecution
  - The process by which a patent application runs its course through the patent office that ultimately results in the application being issued as a patent or abandoned.
  - Who are the primary parties?
    - Inventor(s)
    - Applicant
    - Examiner
    - Patent Attorney and Agent
  - What is the difference between the inventor(s) and applicant, and why does it matter?
  - Important Issue – Who does the attorney represent: one or more of the inventors, the applicant, a third party paying the bills, etc?

General Requirements - Patent Eligibility/Utility

Requirement – Patent Eligibility/Utility
- Patent Eligibility - Must be eligible subject matter
- Utility - The invention must have utility.
- 35 USC §101 - “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title”

Patent Eligibility

- Is a particular invention of a kind that the patent laws intended to protect?
- Subject matter open to patenting
  - Are there subject matters that are not open to patenting?
    - Natural Laws
    - Phenomena of Nature
    - Abstract Principles
- Technology = useful arts
- OK: tangible, practical result
- Not OK: speculative and the abstract
In re Bilski (Fed. Cir.)

- Test identified by Federal Circuit In re Bilski
  - “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.”
  - Sole test for determining patent eligibility of a process under 101…

Bilski at the PTO

- In response, Examiners at the PTO required structure in the body method claims, machine readable claims, and system claims
- Guidelines for Patent Examiners were issued on August 24, 2009

In re Bilski at the Supreme Court

1. Whether the Federal Circuit erred by holding that a “process” must be tied to a particular machine or apparatus, or transform a particular article into a different state or thing (“machine-or-transformation” test), to be eligible for patenting under 35 U.S.C. § 101, despite this Court’s precedent declining to limit the broad statutory grant of patent eligibility for “any” new and useful process beyond excluding patents for “laws of nature, physical phenomena, and abstract ideas.”

In re Bilski at the Supreme Court

2. Whether the Federal Circuit’s “machine-or-transformation” test for patent eligibility, which effectively forecloses meaningful patent protection to many business methods, contradicts the clear Congressional intent that patents protect “method[s] of doing or conducting business.” 35 U.S.C. § 273.

In re Bilski – Supreme Court Decision

- Machine-or-transformation test
  - not endorsed as the exclusive test
  - was not intended to be an exhaustive or exclusive test
  - provides “a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101”
  - is not the sole test

In re Bilski – Supreme Court Decision

- Business method patents are not categorically excluded
- At least some business methods may be allowed
- Court gave some deference to enacting of §273 that provided a defense to methods of doing business
  - No suggestion of broad patentability
In re Bilski – Supreme Court Decision

- **Result**
  - Computer software is still patentable
  - Business methods that don’t involve technology have a limited chance of being patentable
  - What about methods for treatment?

Utility

- Should the claimed invention be useful for some practical purposes in and of itself, or should it be superior to known technologies?

Lowell v. Lewis

- “All that the law requires is, that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society.”
- The patent system is not looking for something better, but rather is just looking for something different.

General Requirements - Anticipation

Requirement – Anticipation

- The inventor must have invented something new.
- 35 USC §102(a) – “A person shall be entitled to a patent unless … the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent”

Anticipation

- An invention must be new at conception by an original inventor to be patentable.
- An invention is anticipated if someone else has already invented the invention.

Anticipation

- Inquiry
  - Does a reference qualify as a prior art reference?
  - Does the reference and the claimed invention both disclose the same invention?
- Enablement
  - Does the reference enable those skilled in the art to practice the invention without undue experimentation?
Anticipation

• “If the claimed invention can be found within the ambit of a single prior art reference, then the invention has been anticipated. References may not be combined during this inquiry, nor may elements that are analogous to the disclosure of a reference be considered.”

Filing Date v. Invention Date

• When filed, an invention is deemed “invented” as of the filing date, even though the invention may have (and likely has) been “invented” prior to file.
• During prosecution of the patent application, the Examiner may cite a reference against the applicant that is before the filing date but after the date the invention was invented.
• How can an applicant move the invention date back in time from the filing date to the invention date?

“Swearing Behind” a Reference

• Under rule 131
  – Applicants can declare an invention date prior to the date of a prior art reference.
  – Termed “swearing behind” or “antedating” a prior art reference
  – Can overcome a 102(a) or 102(e) rejection
  – Cannot overcome a 102(b) rejection—why?
• Invention date is revealed on an ad hoc basis

“Know or Used”

• What type of activity constitutes known or used under 102(a)?
  – Informing use?
  – Non-informing use?
  – Secret use?

General Requirements for Patentability

Requirement – Statutory Bar
• 1 year public disclosure bar
• 35 USC §102(b) – “A person shall be entitled to a patent unless … the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States”

Statutory Bars

• Encourages timely filing and disclosure of inventive activity.
• An inventor must file within a year of any public use or offer to sell the invention.
• Anyone, including individuals unknown to the inventor, can defeat the patent by placing the invention in public use or sale.
• The 1-year grace period permits the inventor to weigh the advantages of patent protection, to perfect the invention, and to draft a patent application.
Public Use

“Public use is use by the inventor, or by a person who is not under any limitation, restriction, or obligation of secrecy to the inventor.”

Patents and the Federal Circuit, 7th Edition

Experimental Use

• As a general rule, an experimental use only negates a statutory bar when the inventor was testing claimed features of the invention. 
• Courts view the totality of the circumstances when determining whether an invention was on sale or in public use
• The experimental use exception does not include market testing.

On Sale Test

• “On Sale” Test
  1) The product must be the subject of a commercial offer for sale
  2) The invention must be ready for patenting
     • Proof of reduction to practice before the critical date; or
     • Proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention

“On Sale”

• What about sale of the rights to the patent before the critical date?

Third Party Activities

• What are the implications of someone other than the inventor putting the invention into the public use or on sale before the critical date?
• 3 categories:
  – Uses which themselves inform others about the invention
  – Uses which by their nature do not inform others about the invention
  – Secret uses

Knowledge of Publications

• “… a [patent reference] on display for public view in remote cities in a far-away land may create a burden of discovery for one without the time, desire, or resources to journey there in person or by agent to observe that which is registered and protected under [foreign] law. Such a burden, however is by law imposed upon the hypothetical person of ordinary skill in the art who is charged with knowledge of all the contents of the relevant prior art.”
• Does actual knowledge matter?
In re Hall

• "[P]ublic accessibility" has been called the touchstone in determining whether a reference constitutes a "printed publication" bar under 35 U.S.C. §102(b) ... The proponent of the publication bar must show that prior to the critical date the reference was sufficiently accessible ... so that such a one by examining the reference could make the claimed invention without further research or experimentation.

Other Sources of Art

• 102(g) – Requirement – Who is the First Inventor?
  – Patent Interference
  – Proceeding determines who was the first true inventor when two pending applications or a pending application and an issued patent are on the same invention

• 102(e)
  – Published patent applications "count" as of their date of filing and not their date of publication

General Requirements - Nonobviousness

Requirement – Nonobviousness

• The new combination of elements must not be obvious to one of skill in the art at the time of the invention.
• 35 U.S.C. §103(a) "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. ...

Nonobviousness

"[A]n invention must also sufficiently advance the useful arts in order to warrant the award of an exclusive right. ... In terms of obviousness, the new combination does not warrant a patent if, from the vantage point of one of ordinary skill in the art at the time of the invention, this new combination would have been obvious."

KSR v. Teleflex – Supreme Court

• Supreme Ct
  – Rejects rigid approach; expansive and flexible approach
  – "[T]he Court has held that a patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men."
  – "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

KSR v. Teleflex – Supreme Court

• "[I]dentify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."
KSR v. Teleflex – Supreme Court

- Obviousness situations reviewing past case law
  - Combining two preexisting elements where no new synergy was created
  - Arrangement of old elements to perform the same function they had been known to perform
- “[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”

Analogous Arts

- For purposes of §103, the technology must be:
  - Available under §102, and
  - Be from an analogous art

Analogous Arts

- “Two criteria have evolved for determining whether prior art is analogous:
  - (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and
  - (2) if the reference is not within the field of the inventor’s endeavor, whether the reference is still reasonable pertinent to the particular problem with which the inventor is involved.”
  - In re Clay

General Requirements for Patentability

Requirement – True Inventor

- Applicant(s) must be the true inventor(s)
- 35 USC §102(f) – “A person shall be entitled to a patent unless … he did not himself invent the subject matter sought to be patented”

The Patent Specification

- What must the specification describe?

§112 - Specification

¶1 - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
Patent Specification Requirements

35 U.S.C. §112 requires that the Specification of a patent application must contain:
(A) A written description of the invention;
(B) The manner and process of making and using the invention (the enablement requirement); and
(C) The best mode contemplated by the inventor of carrying out the invention.
M.P.E.P. 2161

Enablement Requirement

• The specification must teach someone of skill in the art (1) how to make and (2) how to use the invention without undue experimentation.
• MPEP 2164

Enablement

• Enablement = how to make and use the invention
• §112 ¶1 ... ‘requires both that the applicant disclose ‘how to make’ and ‘how to use’ the claimed invention, as well as that the specification must include a ‘written description’ of the invention.
• “As the essential bargain for the exclusive right of the patent, the patentee must teach the public how the invention works: the patent instrument itself must ‘enable’ other skilled artisans to practice the disclosed technology.”
• Purpose = ensure adequate disclosure

Written Description

• “112, ¶1 ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims.” Union Oil Co. of Calif. v. Atlantic Richfield Co., 208 F.3d 989 (Fed. Cir. 2000)
• “When new claims are added after the original filing date—either in their entirety or through alterations to earlier claims—the ‘written description’ test requires that the augmented material must find a basis somewhere in the original application as filed.

Written Description Violations

• Broad Claims
  • Claims cannot cover inventions never contemplated or disclosed by the inventor
• Narrow Claims
  • Each limitation must be supported by written description
• Addition of New Matter
  • To obtain benefit of earlier-filed application, claims of a continuation (or CIP) must be supported by original specification

Best Mode

• The specification shall set forth the best mode contemplated by the inventor of carrying out his/her invention.
• Is this an objective or subjective standard?
Best Mode

- The best mode of carrying out the invention must be disclosed.
- The test for a best mode violation is a two prong inquiry.
- PRONG 1 (Subjective) – Did the inventor possess a best mode for practicing the invention?
- PRONG 2 (Objective) – Does the written description disclose the best mode so that a person skilled in the art could practice it?
- MPEP 2165

Best Mode Violation?

What May Establish Subjective Evidence of Concealment?
- Inventor testimony
- Inventor’s lab notebook
- Inventor’s contemporaneous articles, notes, speeches, etc.
- Other corporate disclosures cannot impute knowledge to inventor (Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043 (Fed. Cir. 1995)
- Commercial embodiment is not necessarily the best mode. (Zygo Corp. v. Wyko Corp., 79 F.3d 1563 (Fed. Cir. 1996)

Claims

- What are the claims?

Claims

- Claims define “the invention” described in a patent or patent application
- Example:
A method of electronically distributing a class via distance education comprising:
initiating a class session for a plurality of students on a server;
receiving a plurality of signin requests for the class session, a particular signing request of the plurality of signing requests associated with a particular student of the plurality of students and received from a particular computing device associated with the particular user; and
broadcasting video for the class session from the server to a plurality of computing devices, the plurality of computing devices including the particular computing device.

§112 – Statutory Basis

[2] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
§112 – Statutory Basis

[4] Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

[5] A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

§112 – Statutory Basis

[6] An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Elemental Claim Structure

Three basic parts of a claim:
1) A preamble
2) A transition phrase
3) A body

The Preamble

• “Immediately stated at the beginning of the claim is the object of the sentence, e.g., ‘A method of making coffee …’ The introduction (‘preamble’) may or may not constitute a limitation to the scope of the claim.”
  “… a preamble is a limitation if it gives ‘meaning to the claim’ …”

Catalina Marketing International v. CoolSavings.com, Inc.

"In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim. … Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’"
The Transition

- A claim normally has one or more elements or steps which follow the introductory object and any function prepositional statement. Joining these elements is a transition phrase which [ ] tells the reader that the claim is "open" or "closed" to additional elements.

The Open Transition

"The Open Transition ('comprising'): The use of the term 'comprising' captures technologies with all the elements described in the body of the claim; whether the technology has additional elements is irrelevant. Thus, if a claim recites elements ‘A’ and ‘B’, a device with ‘A’, ‘B’ and others is an infringement."

The Open Transition

An apparatus comprising:
A;
B; and
C  
- Does:
  - A, B, & C infringe?
  - B, C, & D infringe?
  - A’, B, & C infringe?
  - A, B, C, & D infringe?

The Closed Transition

"The Closed Transition ('consisting of'): In contrast, a claim which employs the term 'consisting of' is 'closed' to additional ingredients. Infringement can occur only when the accused technology has exactly the same elements recited in the claim-no more or no less."

The Closed Transition

A method consisting of:
A;
B; and
C  
- Does:
  - A, B, & C infringe?
  - B, C, & D infringe?
  - A’, B, & C infringe?
  - A, B, C, & D infringe?

The Hybrid Transition

"The Hybrid Transition ('consisting essentially of'): … This terminology renders the claim "open" to include additional elements that do not materially affect the basic and novel characteristics of the claimed combination."
The Hybrid Transition
A composition of matter consisting essentially of:
A; B; and C
• Does:
  – A, B, & C infringe?
  – B, C, & D infringe?
  – A’, B, & C infringe?
  – A, B, C, & D infringe?

The Body
Relation of Elements
• “The body of the claim provides the elements of the invention, as well as how these elements cooperate either structurally or functionally.”
• “The drafter should also indicate how [each] element interacts with the [other elements] to form an operative technology …”

The Body
Element Introduction
• “Elements of an invention are ordinarily introduced with indefinite article, such as ‘a’ or ‘an,’ as well as terms such as ‘one,’ ‘several,’ or ‘a plurality of.’ When that element is noted later in the claim, claims drafters ordinarily employ the definite article ‘the’ or the term ‘said.’”
• “If an element appearing for the first time is accompanied by ‘the’ or ‘said,’ then it will ordinarily be rejected by an examiner as lacking so-called ‘antecedent basis.’”

The Body
Element Introduction Example
• An apparatus comprising:
  a first module to receive a video signal from a source;
  a second module to access the video signal from the first module and encode transitioning data into one or more frames of the video signal; and
  a third module to broadcast the video to the plurality of display devices.
• What’s wrong with this claim?

Dependent Claims
• “Section 112, paragraphs 3-5 allow the use of so-called ‘dependent’ patent claims. The statute mandates that dependent claims recite an earlier claim and provide additional limitations.”
• “a patentee is free to be his or her own lexicographer…”

Dependent Claim Examples
• The method of claim 5, further comprising: selecting a personal digital assistant (PDA) as the hand-held device.
• The apparatus of claim 3, wherein the processor is further configured to receive the video signal from a signal source.
• The system of claim 1, further comprising: an output device for providing at least one of an audio signal or a video signal to a hand-held device.
Means-Plus-Function Format

• Claiming an element in its functional terms
• Used with a combination of elements
• Means for performing a specified function
• Does not recite the structure, material or acts disclosed in the specification
• Used where the description of the structure or acts might be difficult to articulate in a claim

"It requires the applicant to describe in the patent specification the various structures that the inventor expects to perform the specified function. The statute then expressly confines coverage of the functional claim language to 'corresponding structure, material, or acts described in the specification and equivalents thereof."

Design Patents

Statutory Basis for Design Patents

• “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

• “The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”

35 U.S.C. 171

M.P.E.P. Design Definition

• “In a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and not the article itself. …” [35 U.S.C.] 171 refers, not to the design of an article, but to the design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” …

• The design for an article consists of the visual characteristics embodied in or applied to an article.

M.P.E.P. Design Definition

• “Since a design is manifested in appearance, 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.

• “Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.”

• MPEP 1502 – Definition of Design
Improper Subject Matter for Design Patents

• “A design for an article of manufacture that is dictated primarily by the function of the article lacks ornamentality and is not proper statutory subject matter under 35 U.S.C. 171. Specifically, if at the time the design was created, there was no unique or distinctive shape or appearance to the article not dictated by the function that it performs, the design lacks ornamentality and is not proper subject matter. In addition, 35 U.S.C. 171 requires that a design to be patentable must be ‘original.’”

• “Clearly a design that simulates a well-known or naturally occurring object or person is not original as required by the statute. Furthermore, subject matter that could be considered offensive to any race, religion, sex, ethnic group, or nationality is not proper subject matter for a design patent application (35 U.S.C. 171 and 37 CFR § 1.3).”

• From USPTO’s Design Patent Application Guide

Ornamental

• “An ornamental feature or design has been defined as one which was “created for the purpose of ornamenting” and cannot be the result or “merely a by-product” of functional or mechanical considerations. … It is clear that the ornamentality of the article must be the result of a conscious act by the inventor, as 35 U.S.C. 171 requires that a patent for a design be given only to “whoever invents any new, original, and ornamental design for an article of manufacture.” Therefore, for a design to be ornamental within the requirements of 35 U.S.C. 171, it must be “created for the purpose of ornamenting.” …”

Types of Design Patent Protection Available

1) Configuration of an article of manufacturer
   – Design of a scissors, a computer speaker, a bottle
2) Surface ornamentation for an article of manufacturer
   – Design included on surface of bottle
3) Configuration and surface ornamentation

Right of Priority

• Priority cannot be claimed to a provisional patent application
• Priority can be claimed under the Paris Convention if filed within 6 months of patent application filing 37 U.S.C. 172

Title of the Application

• A design patent title must state the article of manufacture to which the design applies
• The title can also state the environment in which the article is used
Example Titles
• GUI
  – Computer screen with icon
  – Display panel with graphical user interface
  – Portion of a display with icon
• Shoe
• Wine glass
• Bag for food packaging

Written Description
• A design patent is not required to have a written description, but may include one to clarify the invention
• For example
  – “A descriptive statement should be included in the specification making it clear that the claim is directed to the collective appearance of the articles shown.”
  – M.P.E.P. 1504(b)

Design Patent Claim
• Design patents have a single claim which is not numbered
• The claim must be directed to a single design concept
• Must begin with a phrase that designates an article of manufacture to which the claim applies

Design Patent Drawings
• “The drawing disclosure is the most important element of the application. Every design patent application must include either a drawing or a black and white photograph of the claimed design. As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be clear and complete, that nothing regarding the design sought to be patented is left to conjecture. The design drawing or photograph must comply with the disclosure requirements of 35 U.S.C. 112, first paragraph. To meet the requirements of 35 U.S.C. 112, the drawings or photographs must include a sufficient number of views to constitute a complete disclosure of the appearance of the design claimed.”

Design Patent Drawings
• “Drawings are normally required to be in black ink on white paper. Black and white photographs, in lieu of drawings, are permitted subject to the requirements of 37 CFR §1.84(b)(1) and §1.152. …”
• “The Office will accept color drawings or photographs in design patent applications only after the granting of a petition filed under 37 CFR §1.84(a)(2), explaining why the color drawings or photographs are necessary.”
• From USPTO’s Design Patent Application Guide

Lines
• Limiting elements are shown in solid lines
• Non-limiting elements that are used to provide context for the design are shown in broken lines
• You can specify the effect of the broken lines in the description
Term and Maintenance Fees

- With the passage of the Patent Law Treaties Implementation Act of 2012, the term for design patents was extended to 15 years from issue.
- No maintenance fees are due with design patents.

Publication

- Design patent applications are not published under U.S. law.
- However, the design patent applications will be published prior to issuance under international filings made with the Hague Convention.

Obviousness for Design Patents

- Analysis begins with a primary reference that is "basically the same as" the claimed design.
- Secondary references are combined if obvious to a designer of ordinary skill.
- The resulting combination is compared against the claims from the perspective of an ordinary observer.

Ordinary Observer Infringement Test

- "[I]f, in the eye of an ordinary observer, giving 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 (1871).

112 Support

- Continuation applications, or prosecution of original applications, may put articles in broken lines to indicate that these elements are not part of the claim (and thus broader).
- Issue – Does the description clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed?

Ordinary Observer Infringement Test

- "On the basis of the foregoing analysis, we hold that the 'point of novelty' test should no longer be used in the analysis of a claim of design patent infringement. Because we reject the 'point of novelty' test, we also do not adopt the 'non-trivial advance' test, which is a refinement of the 'point of novelty' test. Instead, in accordance with Gorham and subsequent decisions, we hold that the 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed. Under that test, as this court has sometimes described it, infringement will not be found unless the accused article 'embod[i]es the patented design or any colorable imitation thereof.'"
Acts of Infringement of Design Patents

Whoever during the term of a patent for a design, without license of the owner,
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 shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 U.S.C. 289

Protection of GUI

• GUIs may be protected as design patents so long as properly presented and claimed.
• Icons must be shown as part of a three-dimensional article of manufacture (e.g., a computer display)
• The structure of form of the article of manufacture (i.e., a computer) does not have to be claimed, but must be disclosed
• Thus, the claim should be directed to a computer screen, monitor, display plan, or a portion thereof to comply with 35 U.S.C. 171

Transitional Computer Generated Icons

• Design patent protection is not limited to protecting an icon in a static state
• Images that change in appearance during viewing may be the subject of a design claim

GUI Patent Drawings

• Line drawings and digital images are acceptable
• Color and grayscale are allowed to be presented in the same GUI application, but line drawings and digital images are not
• More than one drawing can be used to show animation

Damages Options

• Owners of design patents can claim damages under the standard patent damages available to utility patents, as well as special damages available under 35 U.S.C. 289 for design patents
Patent Searching

- Patent Searching
  - Google search
  - Classification based search at USPTO
  - Assignee search at USPTO
- Assignment search