

Knobbe Practice Webinar Series:  
Strategic Considerations in Design  
Patent Filings in the United States

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# Design – Definition 定義

- A design consists of the visual ornamental characteristics:
  - 1) embodied in, or
  - 2) applied to  
an article of manufacture.
- configuration or shape of an article (or a portion of the article),
- surface ornamentation applied to an article, or
- the combination of configuration and surface ornamentation.

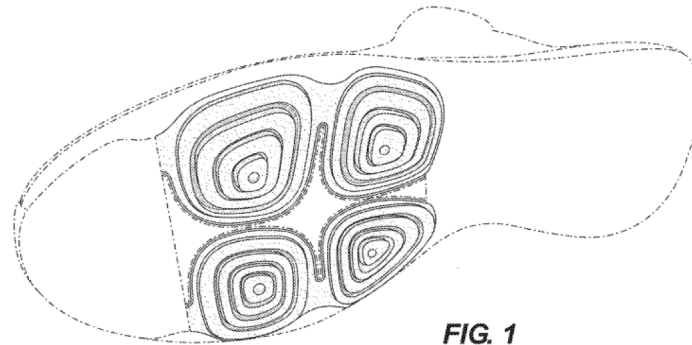


FIG. 1

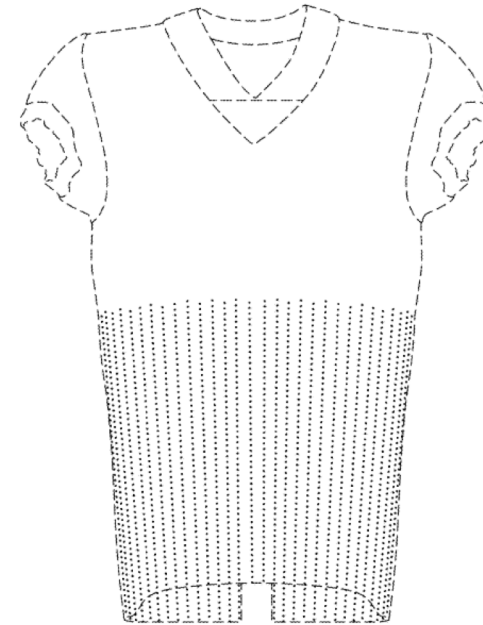


FIG. 2.

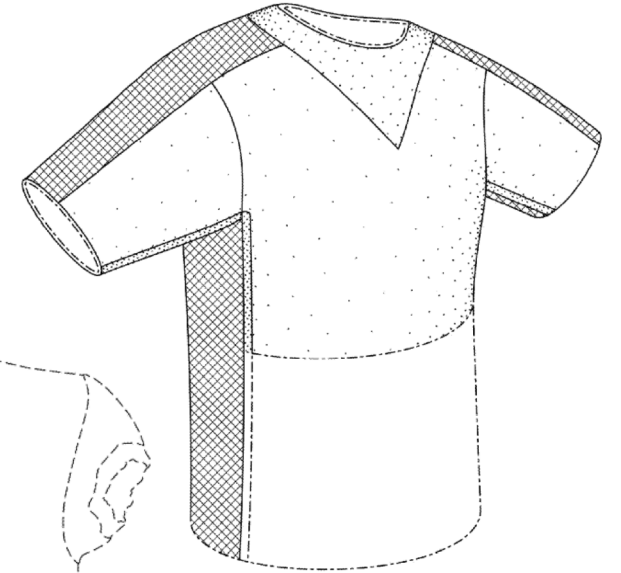
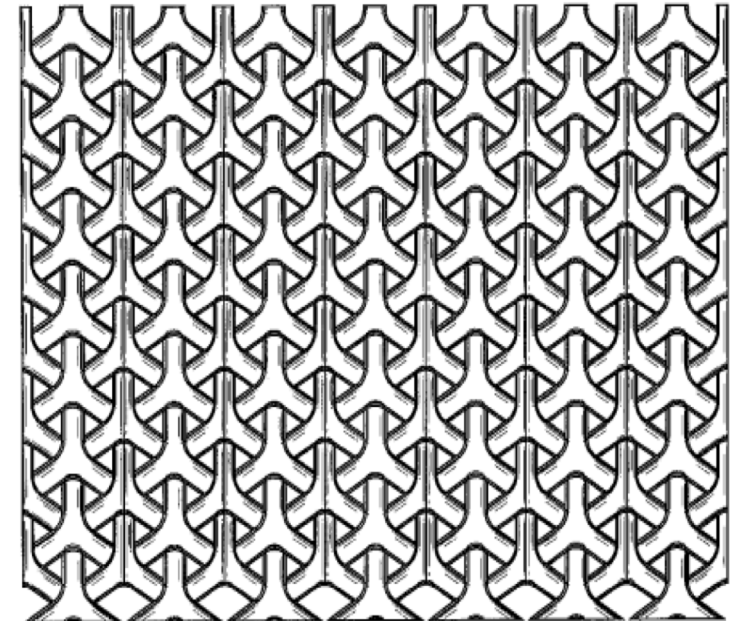


FIG. 1

## Design – Article of Manufacture 製造物品

- Must be embodied in an article of manufacture
  - Can be a portion of an article
  - Can be a material for surface ornamentation
  - Can be a screen for GUI
- No protection of a design in the abstract
  - *Curver Luxembourg* (Fed. Cir. 2019)
    - Title: Pattern for a Chair
    - No chair shown, but court limited scope to a chair



## Design – Specific Statutes and Rules 特別な法及び規則

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- Statutes – 35 U.S.C. § 171-173
  - Utility patent statutes generally apply
  - 6 month foreign priority
  - 15 year term from date of grant
- Rules – 37 C.F.R. § 1.151-1.155
  - Utility patent rules generally apply
  - Sufficient number of views to completely disclose design
  - Expedited Examination
    - Pre-examination search & statement
    - Fee



1. Specification
  2. Drawings
- Specification
    - Preamble
      - name of the applicant
      - title of the design
      - brief description of the nature and intended use of the article in which the design is embodied
    - Cross-reference to related applications (unless included in the application data sheet)
    - Description of the drawing figure(s)
    - Feature description (mirror image, broken line statement, etc.)
    - A single claim

## Design – Elements of the Application – Feature Description 特徴の記載

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- Broken Line Statement –boundary, environment, or disclaimed subject matter
- Mirror Image Statement – right side is mirror image of left side
- Color – shading/stippling/fill represents contrast or specific color
- Length Break – portions between break lines disclaimed
- Creative use to support changes in future continuations
  - Describe specific color options or combinations
  - Describe what features or combination of features may be claimed or disclaimed
- Consider including an Appendix of solid model renders or photographs for support purposes
  - To support additional shading to clarify shape

- Examples

- “Applicant reserves the right to convert individual and various combinations of solid lines to broken lines in one or more continuation applications, since the figures convey that the inventors had possession of the features shown in solid lines, individually and in various combinations, as of the date of filing.”
- “Applicant reserves the right to convert the originally filed color figures to black and white line figures with appropriate shading and contour lines without the black and white line figures being considered new matter.”
- “The shading of the component represents a contrasting color between the shaded and unshaded portions. In the illustrated embodiments, the shading represents the color blue. The shading could represent red, green, or any other color. “

## Design – Elements of the Application – Drawings 図面

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- Line Drawings
- Black and White Photographs
  - If only practical medium to disclose subject matter
  - limited to article – no background
- Color
  - Drawings or Photographs
  - If necessary as only practical medium to disclose subject matter
  - Requires Petition

## Design – Drawings – Number of Views 視点の数

- Sufficient number of views to completely disclose appearance of design
  - At least One (1) Perspective View
  - Two (2) perspective views can be helpful
    - Can support changes to orthogonal views in case of inconsistency
  - Usually Six (6) Orthogonal Views
- Views not visible in use can be omitted
  - Flat, unornamented bottom surface
- Mirror image side view can be omitted

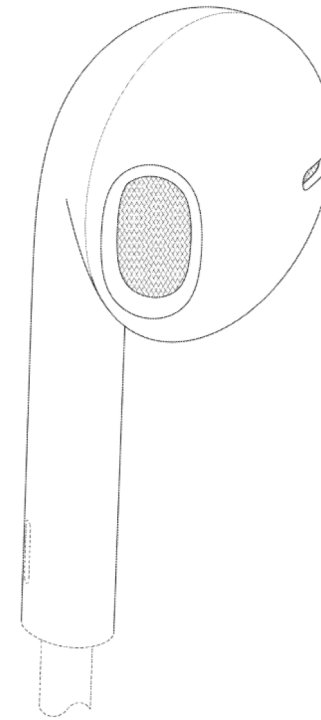


FIG. 1

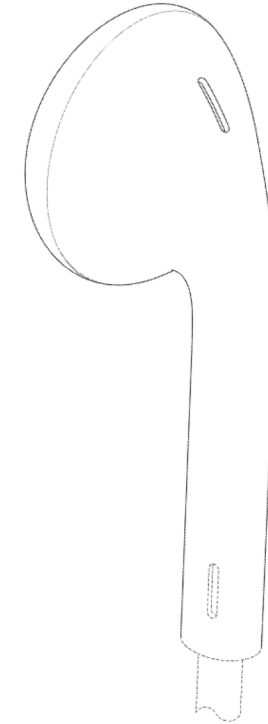


FIG. 2

## Design – Drawings – Shading or Contour Lines 陰影または輪郭線

- To show contour of all surfaces of any three-dimensional aspects of the design
- To distinguish between any open and solid areas of the design
- To represent color or contrast
  - Note: if the shape of the design is not evident from the disclosure as filed, addition of surface shading after filing may be viewed as new matter
  - As noted previously, solid model renders or photographs can support addition of surface shading

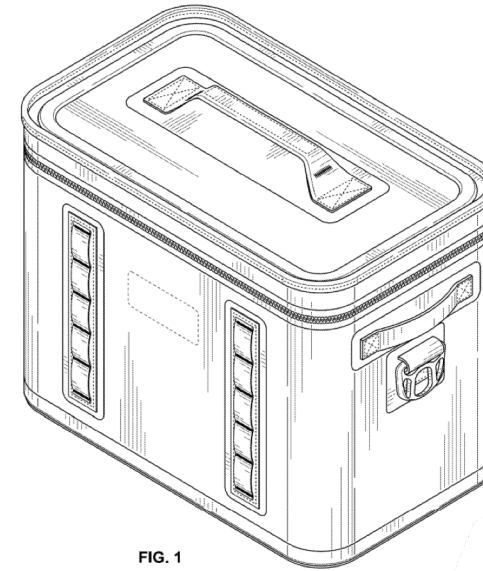


FIG. 1

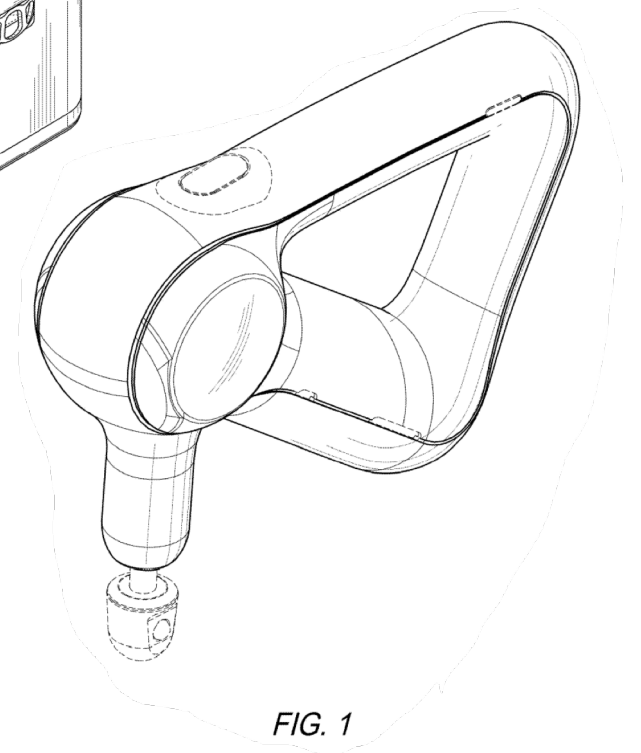
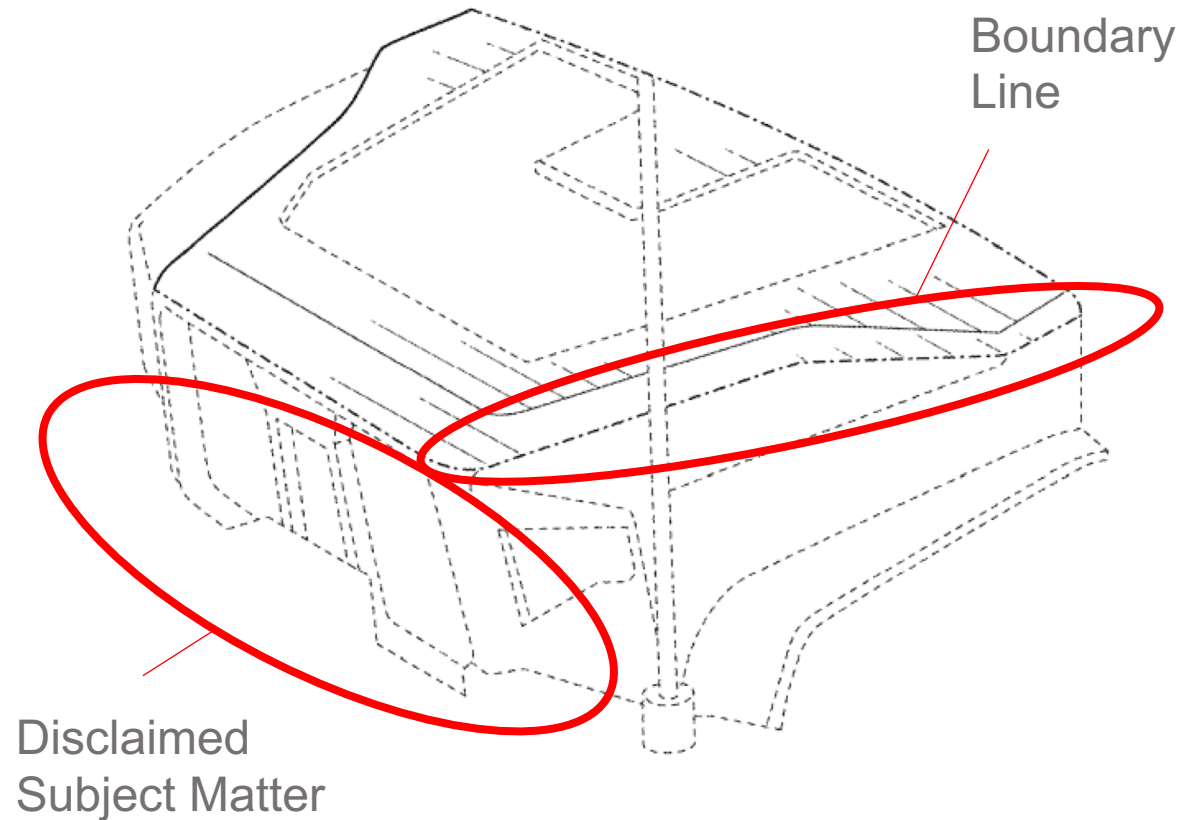


FIG. 1



## Design – Drawings – Broken Lines 破線

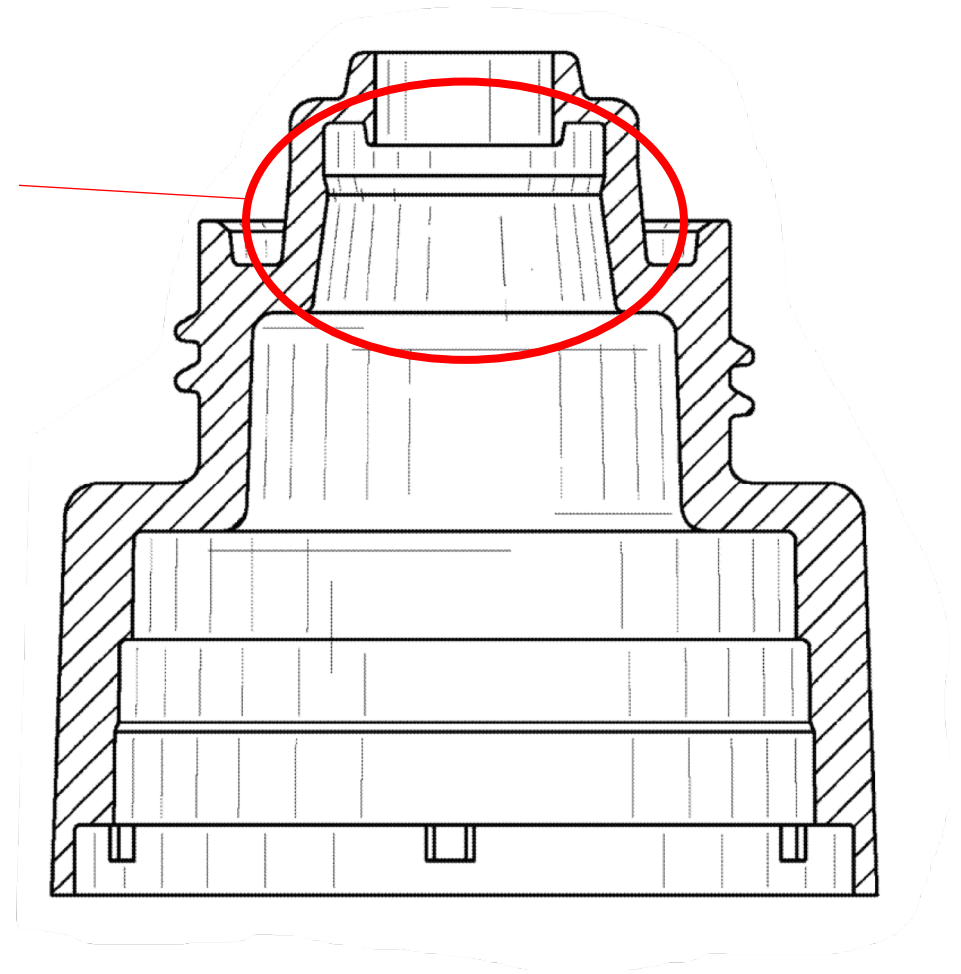
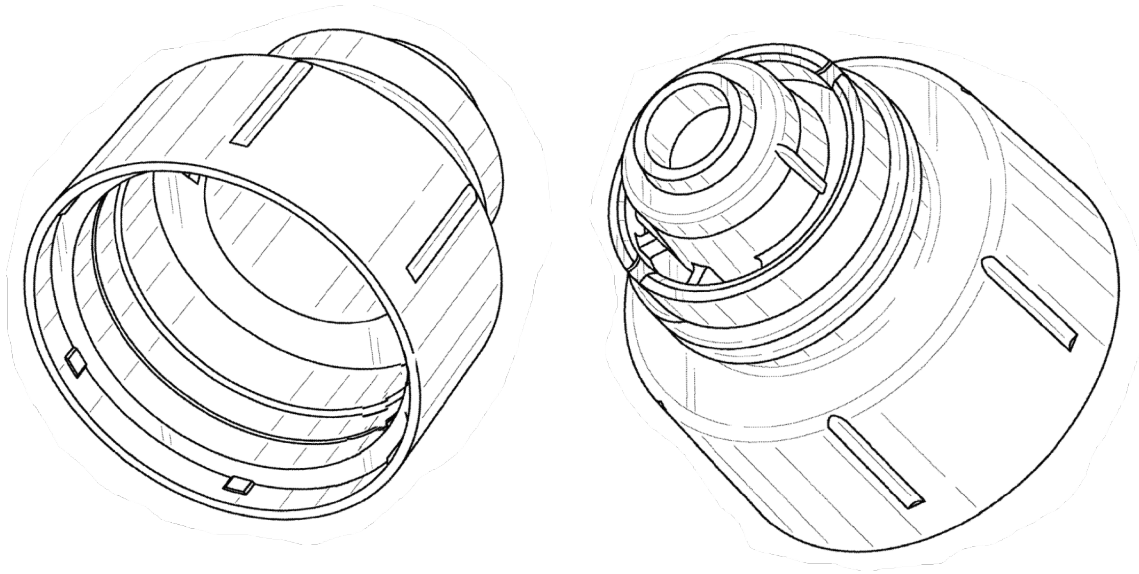
- Used to define scope
  - Disclaim portion of article
  - Designate boundary of claimed subject matter
    - Usually dash-dot



## Design – Drawings – Sectional Views 断面図

- Usually to disclose internal features

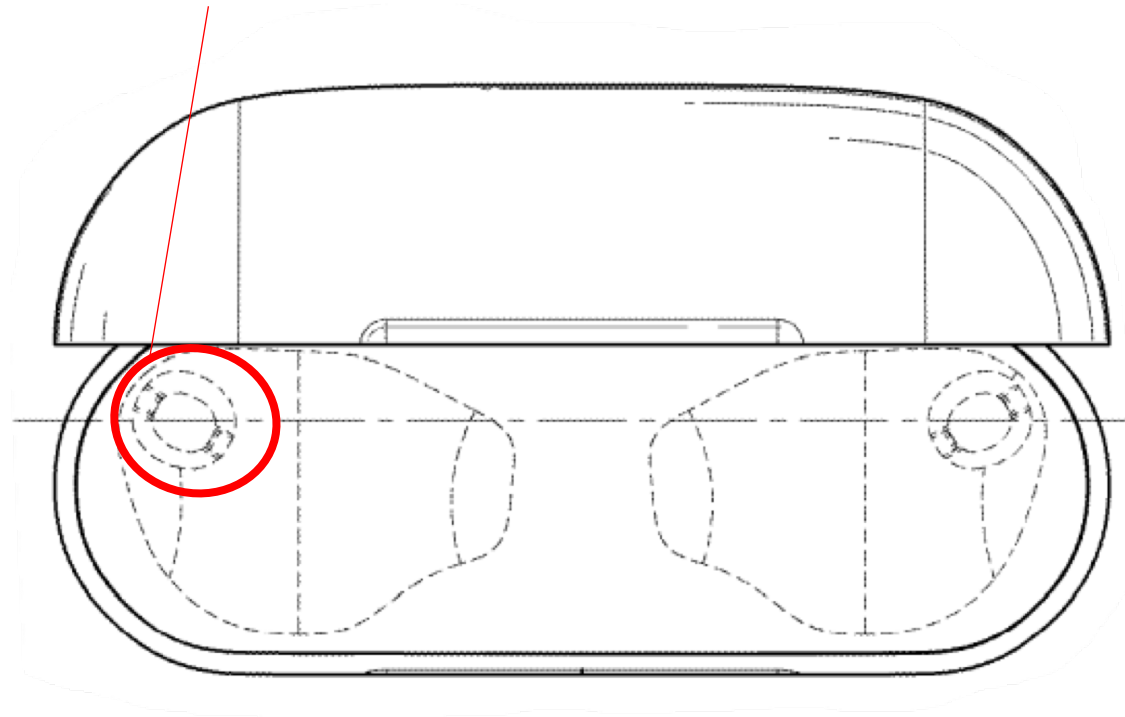
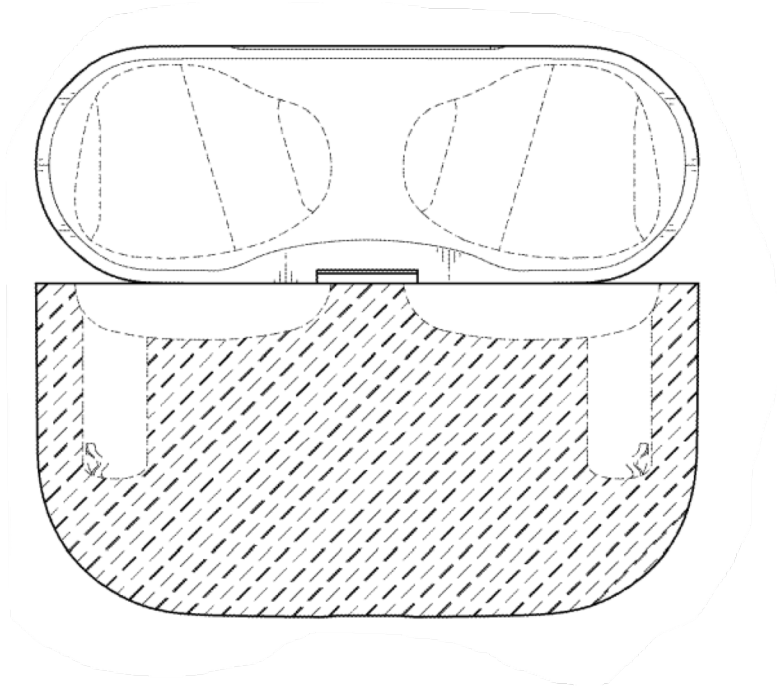
Clarifies shape of portion not visible in other views



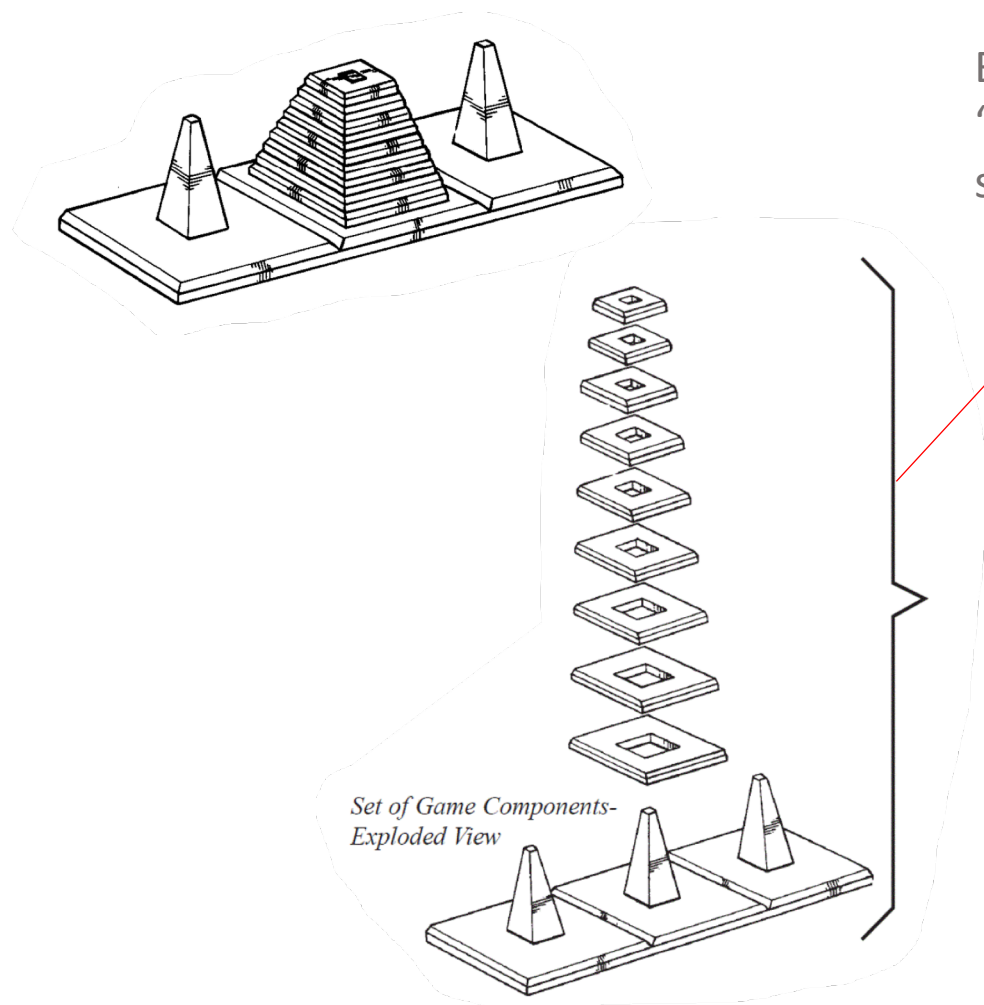
## Design – Drawings – Internal Structures 内部構造

- Alternative to Cross-Section is to Disclaim Internal Structure

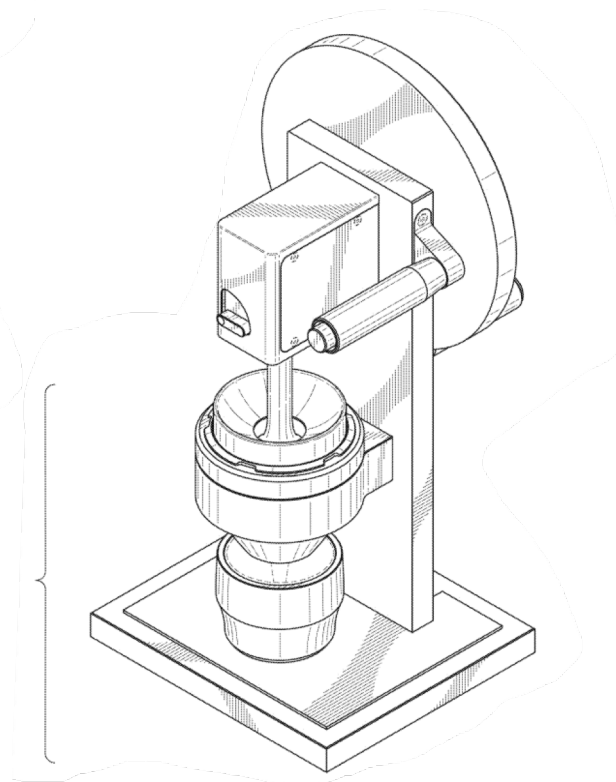
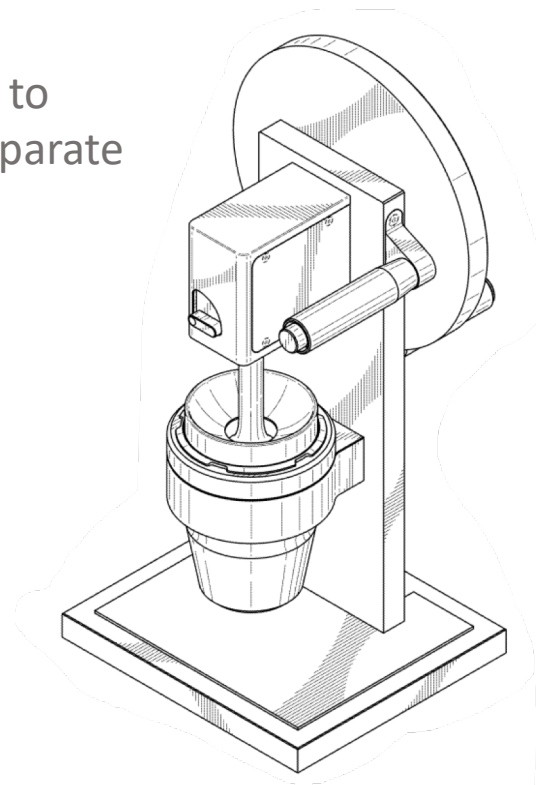
Disclaim internal portion not visible in regular views – if cross-section view is not provided



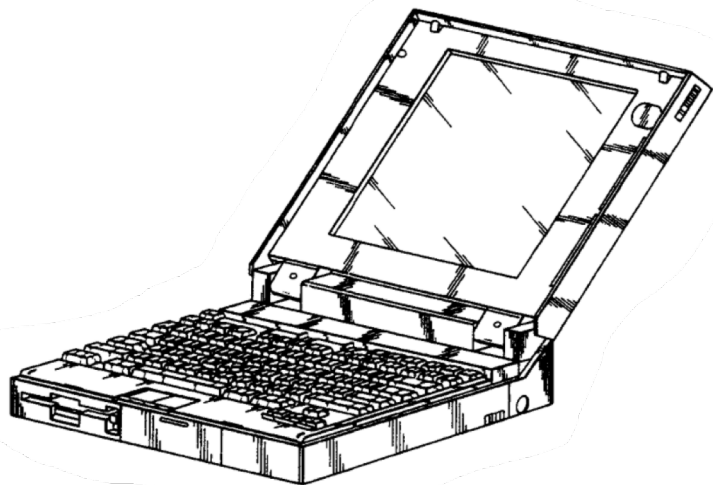
# Design – Drawings – Exploded View 展開図



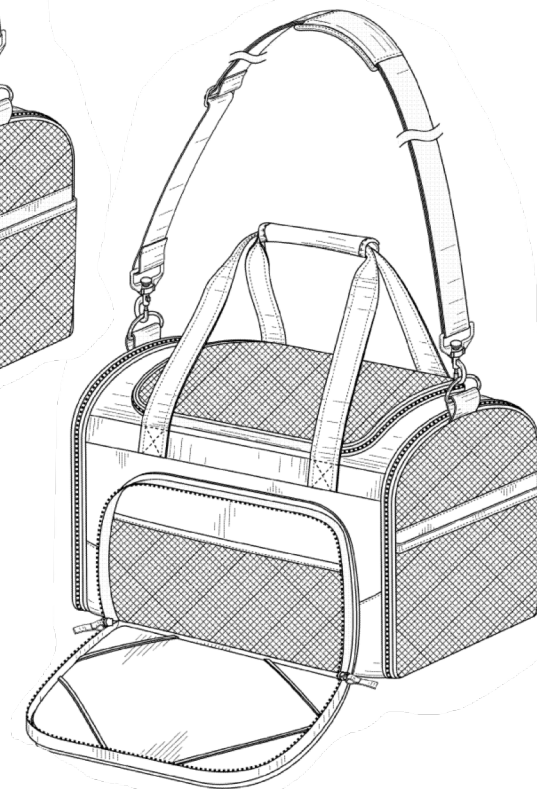
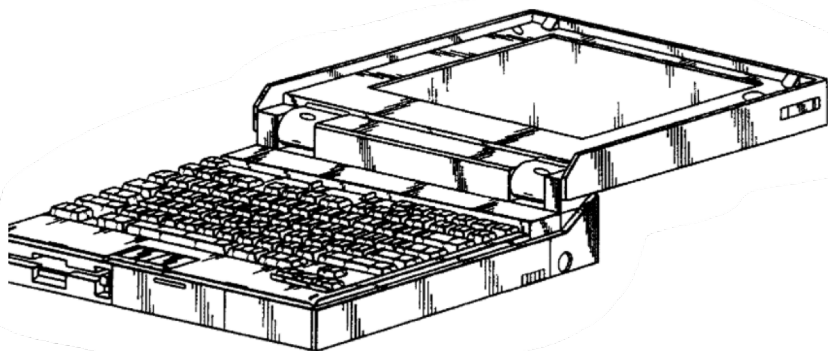
Bracket used to  
“connect” separate  
structures



## Design – Drawings – Alternative Positions 代替位置

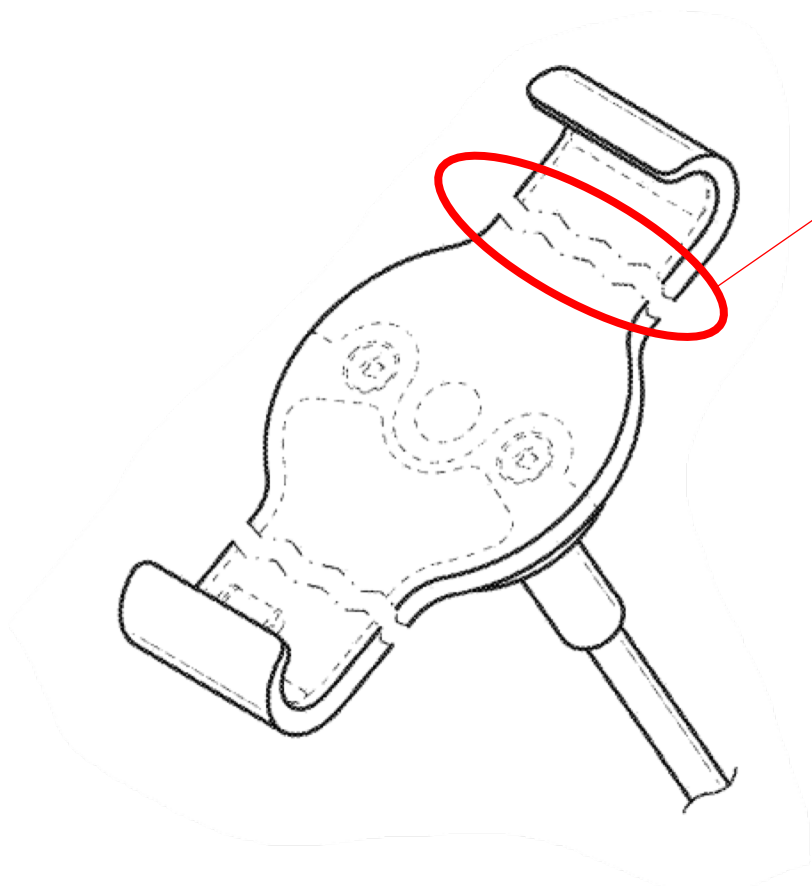


Shown in separate  
figures

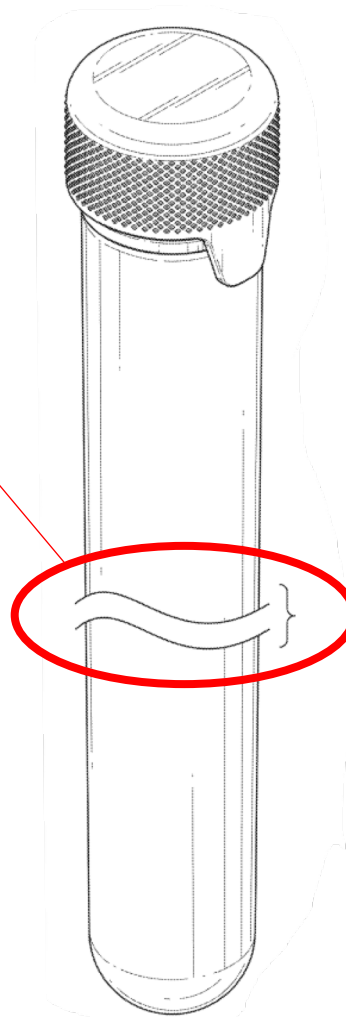




## Design – Drawings – Length Break 長さの切れ目



To show  
indeterminate  
length





- Can be used to pursue broader/different scope.
- Solid lines can generally be converted to broken line to disclaim originally-claimed subject matter.
- Attempting to convert original broken line to solid line can be problematic (e.g., is shape of broken line structure clear without shading/contour lines?).



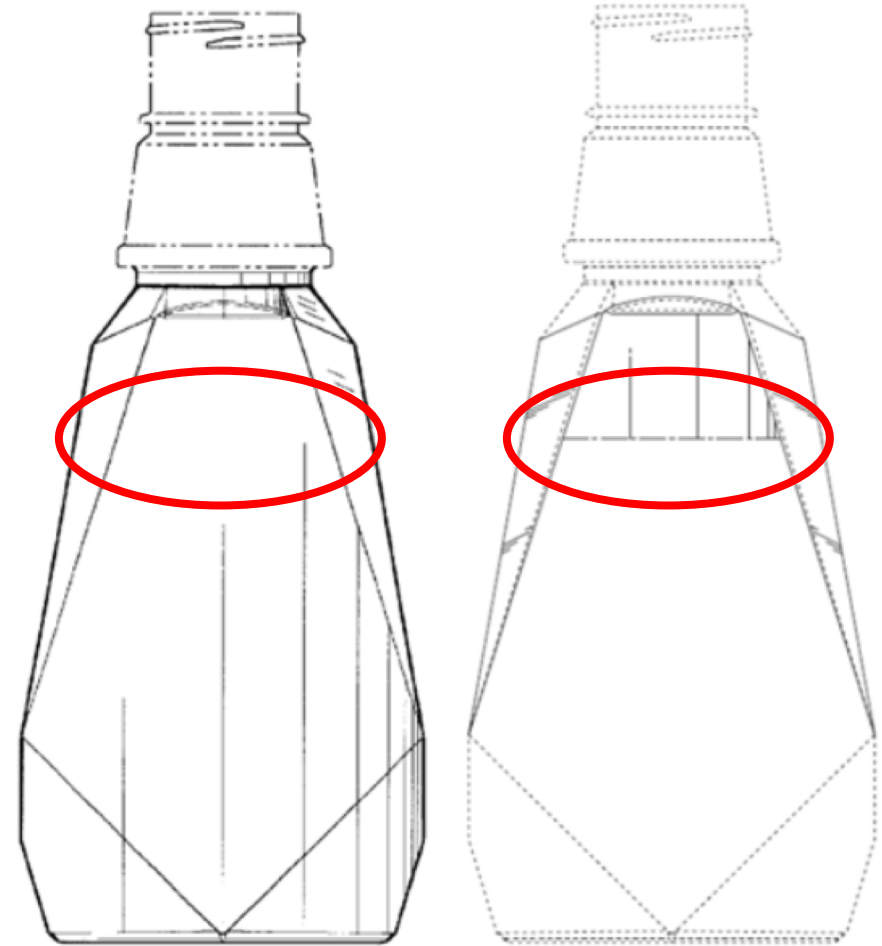
FIG. 6



FIG. 6

# Design – Continuation Applications

- Boundary lines must be supported by the original application
- Existing boundary lines can be used
- Boundary lines cannot be introduced
  - Unless it is clear the boundary of the claimed design is a straight broken line connecting the ends of existing lines



# Example Design Patents – User Interfaces ユーザーインターフェース

- Each embodiment is a “snapshot” of current state of UI
- Can be filed as screen capture or wireframe

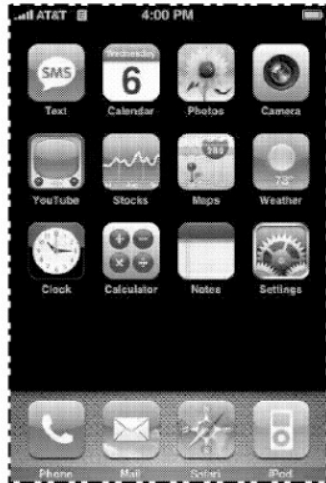


FIG. 1

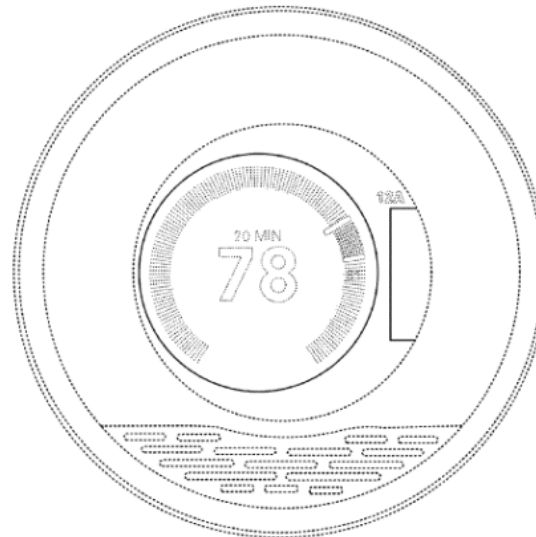


FIG. 5



FIG. 1

# Design Patent Examples – Icons and Typefaces アイコンとタイプフェイス

- Type fonts can be protected
- Typeface can be protected
- Individual icons can be protected – multiple embodiments depending on the device

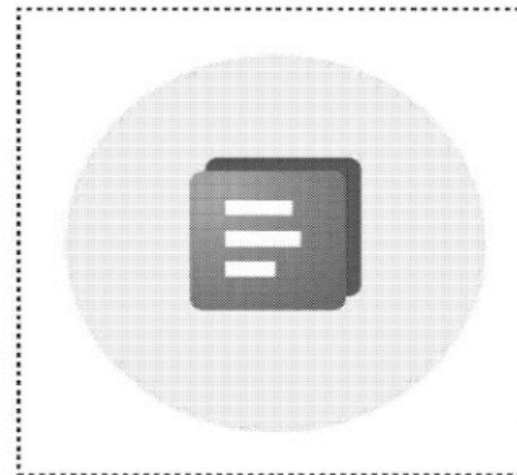


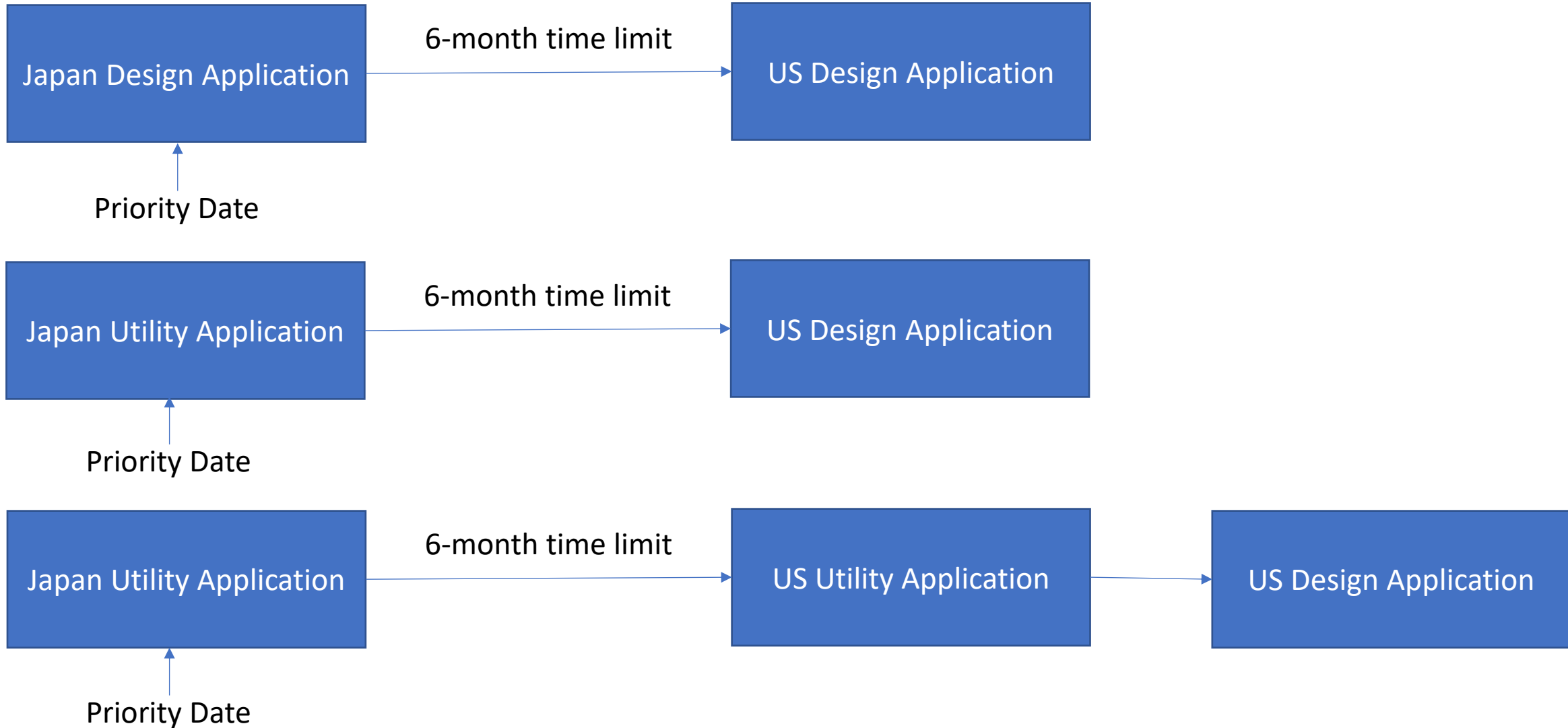
Fig. 2

U.S. Patent Mar. 5, 2013 Sheet 2 of 7 US D677,326 S

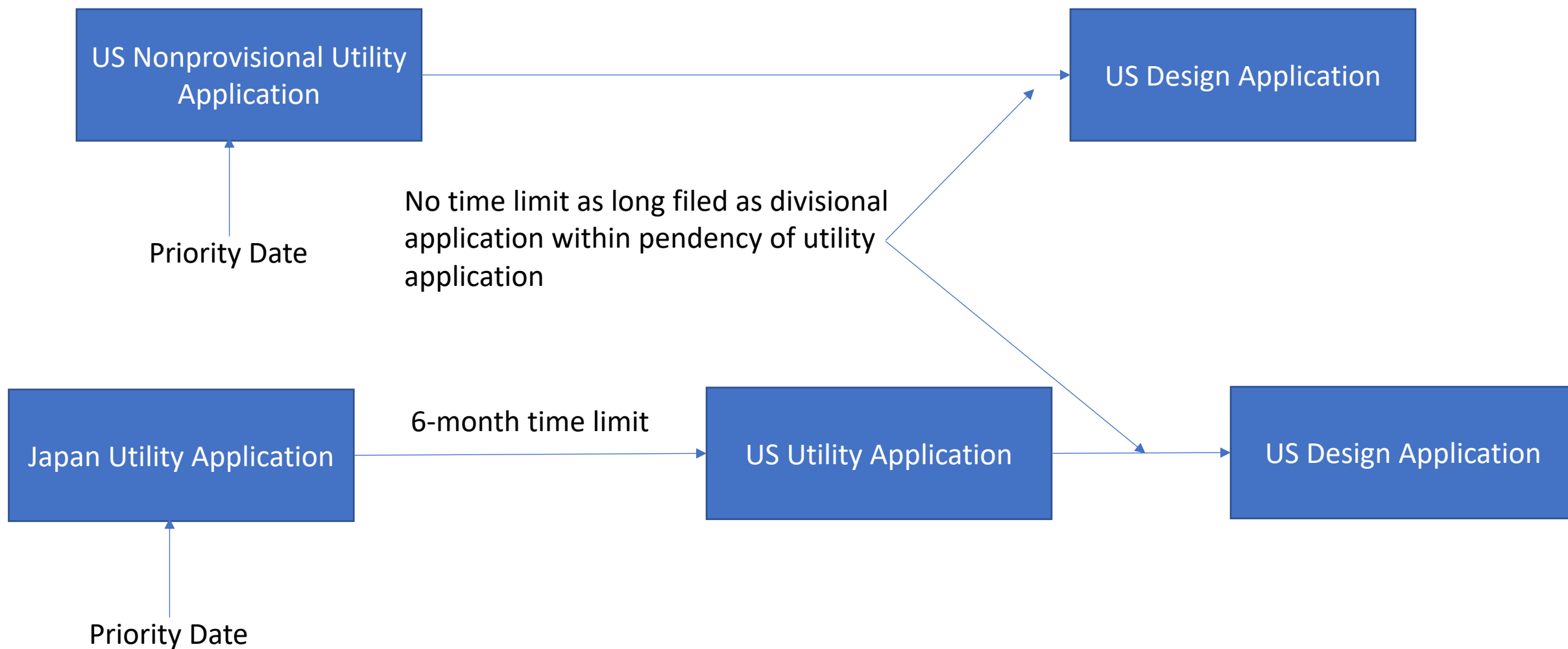


FIGURE 2

# Priority Claim Scenarios for US Design Applications 優先権主張のシナリオ

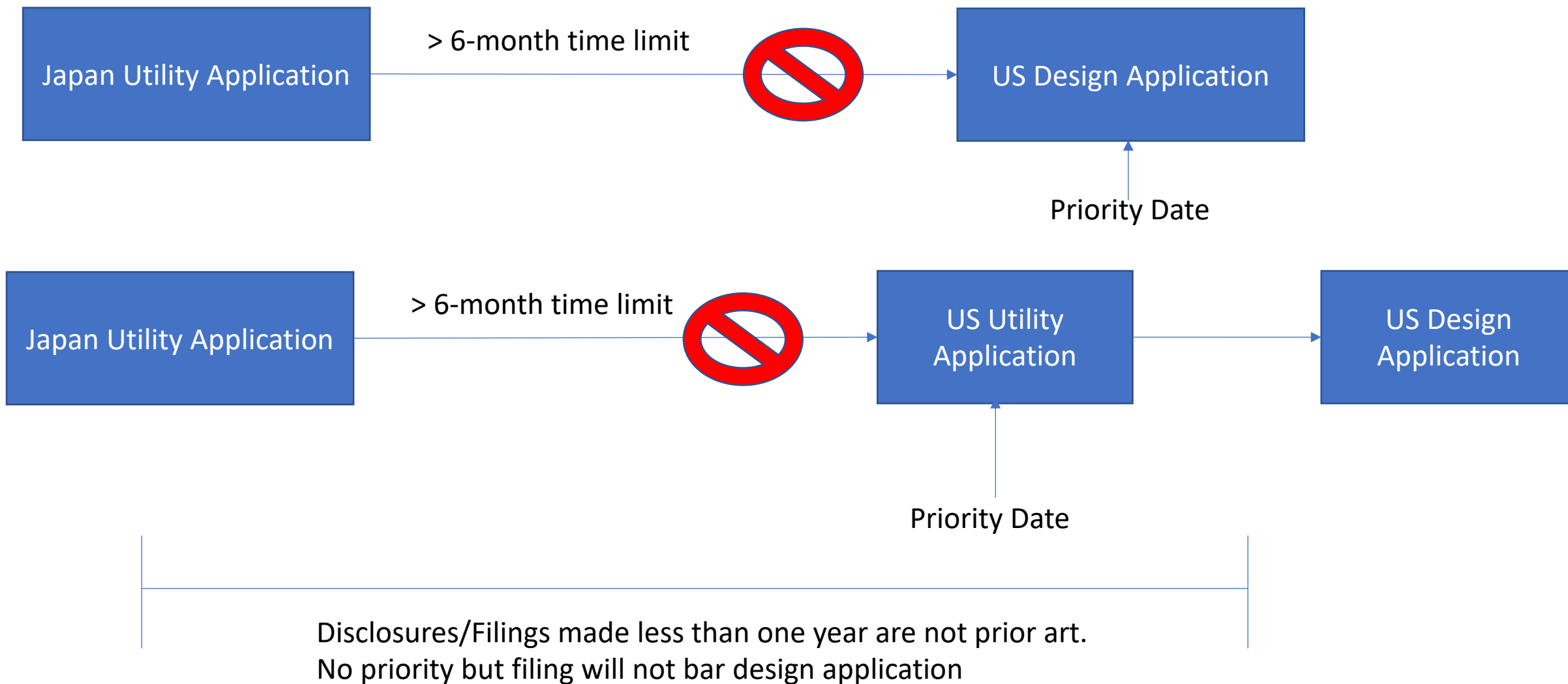


# Priority Claim Scenarios for US Design Applications 優先権主張のシナリオ





# Priority Claim Scenarios for US Design Applications 優先権主張のシナリオ



The left side of the slide features a solid blue background. Overlaid on this are several horizontal bars of varying lengths and colors, including shades of light blue, yellow, dark teal, light blue, white, olive green, dark teal, purple, and grey, creating a layered, abstract effect.

Knobbe Martens

THANK YOU