



NEW YORK STATE BAR ASSOCIATION  
**INTERNATIONAL SECTION**

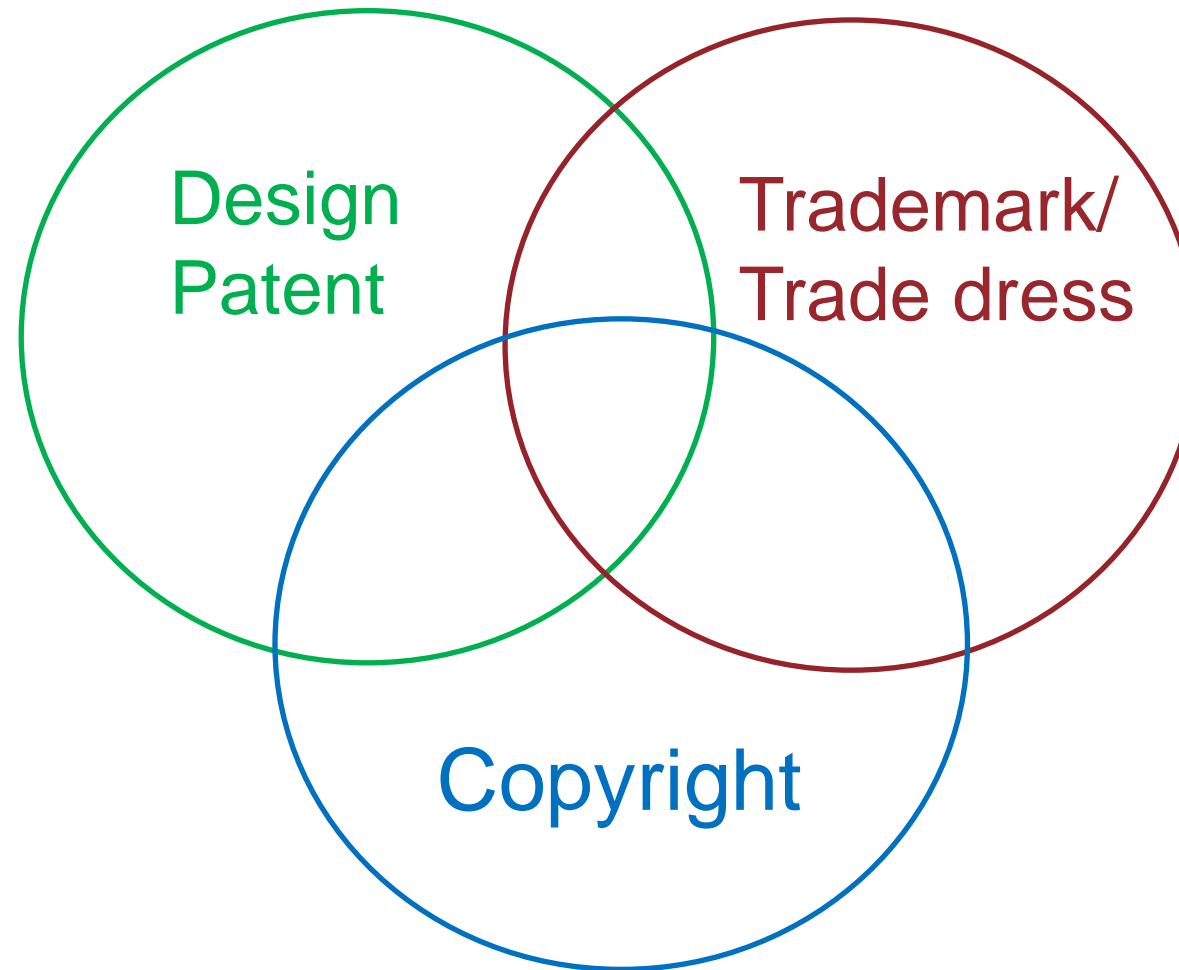
**BakerHostetler**

Cross Border Protection of Designs  
The U.S. Perspective

November 8, 2019  
Tokyo, Japan

# Overlapping Protection

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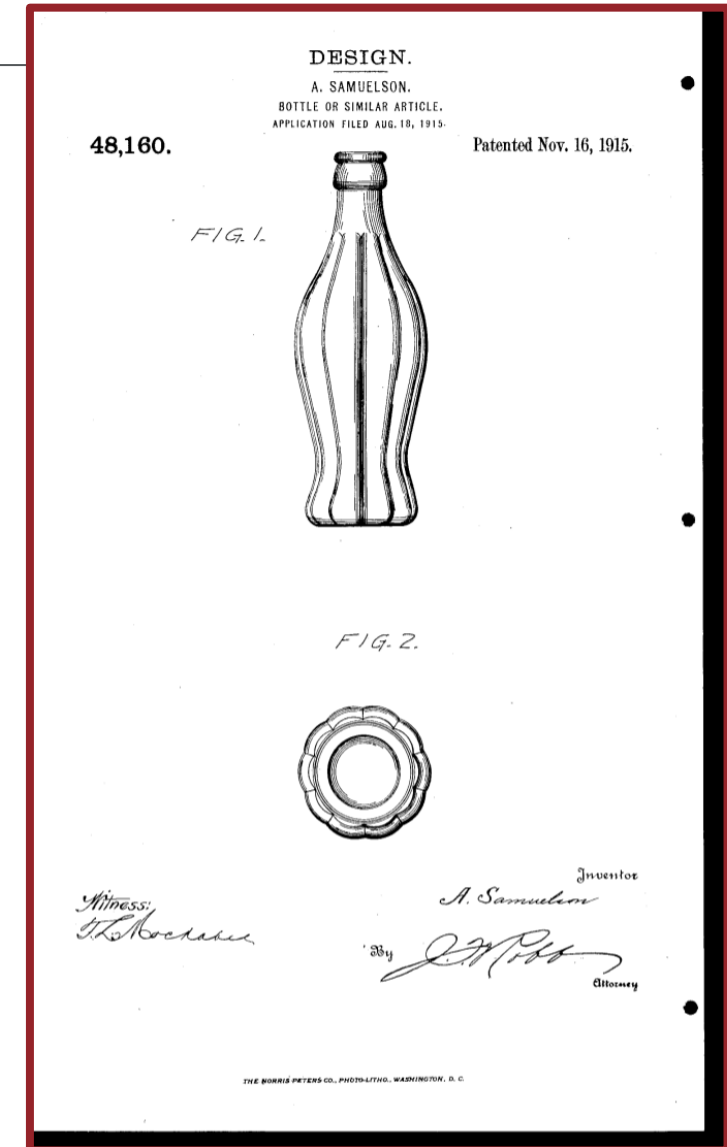


# Design Patents – Requirements

A design patent can be obtained for any design that is:

- New;
- Non-obvious;
- Original;
- Ornamental; and
- Directed to an article of manufacture

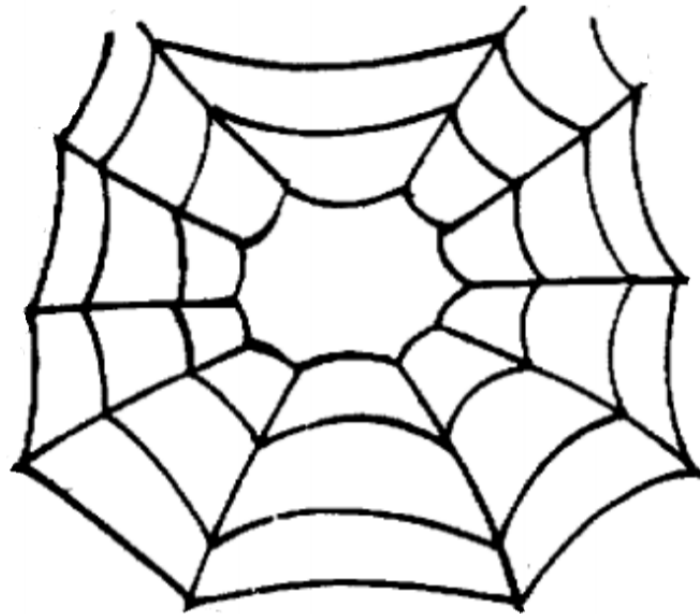
*Source: 35 U.S.C. § 171 “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.*



# Design Patents – Article of Manufacture

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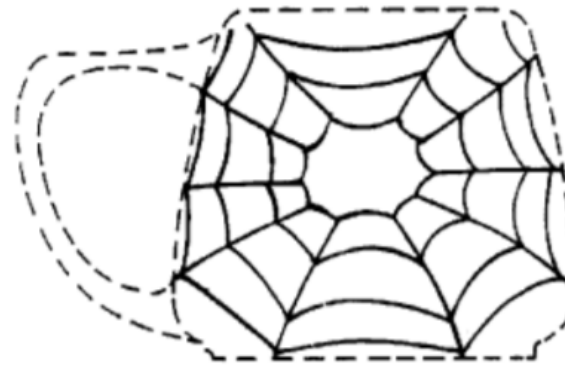
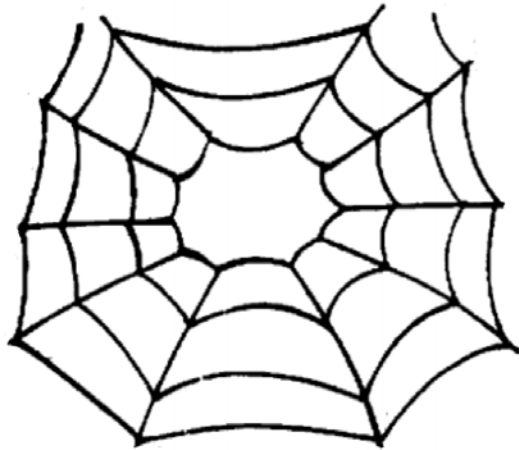
The Design Must be for an “article”



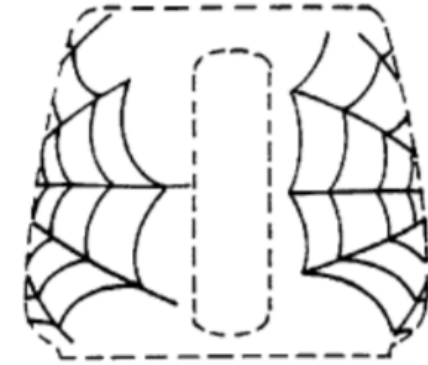
A disembodied design is not acceptable.

# Design Patents – Article of Manufacture

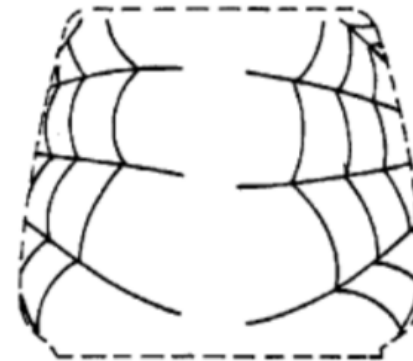
The Design Must be for an “article”



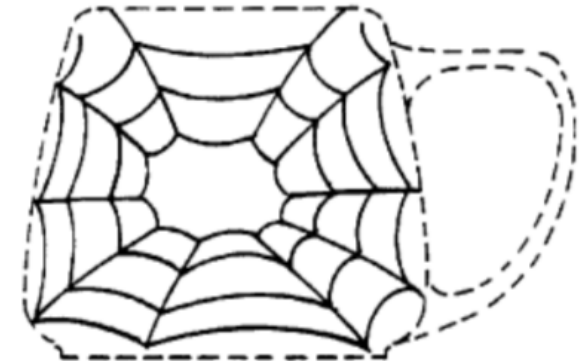
*FIG. 1*



*FIG. 2*

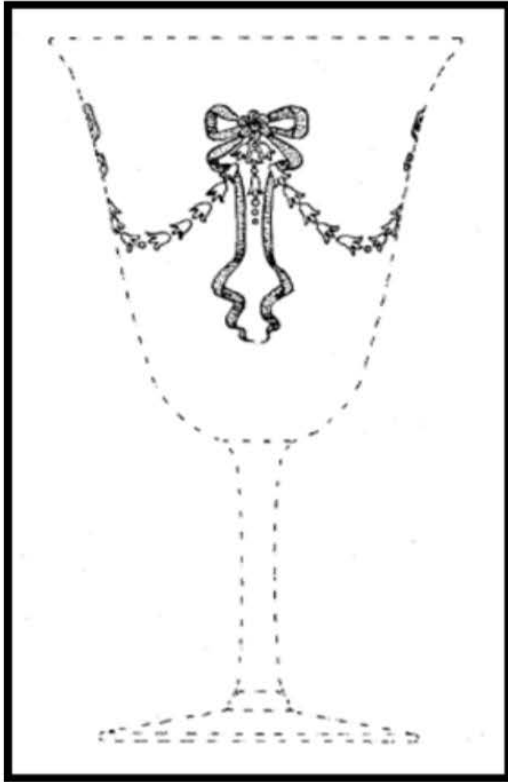


*FIG. 3*

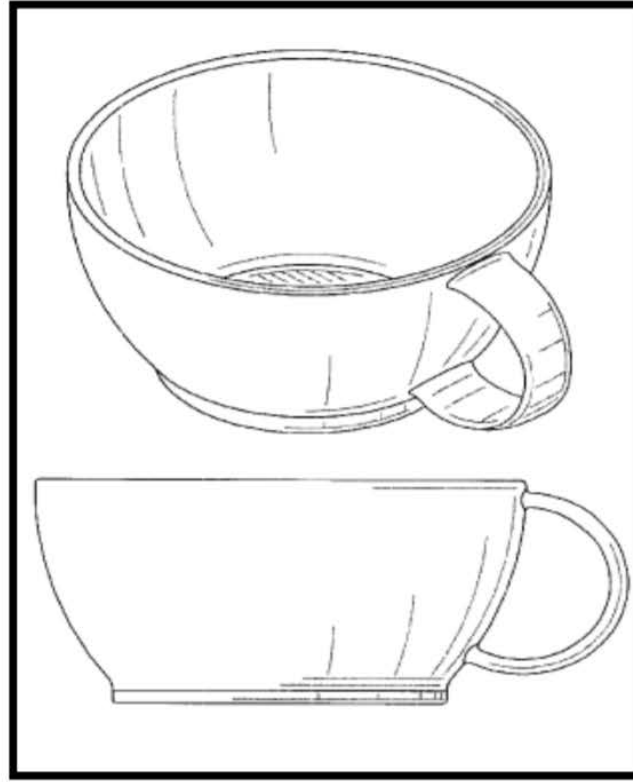


*FIG. 4*

# Design Patents - Scope of Protection



Surface  
Ornamentation  
Applied to an Article



Configuration  
for an Article



Configuration and  
Surface ornamentation  
for an article

# Design Patents – Scope of Protection

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- Only one claim per application
- That claim protects the overall visual appearance of the design “described” in the drawings
- Term: 14 years from grant, if granted prior to 13 May 2015; 15 years from grant, if granted after that date.
- Foreign Priority Benefit: 6 months

# Design Patent Application (37 CFR 1.154)

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(a) The elements of the design application, if applicable, should appear in the following order:

- (1) Design application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet
- (4) Specification.
- (5) Drawings or photographs.
- (6) The inventor's oath or declaration

(b) The specification should include the following sections in order:

- (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Description of the figure or figures of the drawing.
- (5) Feature description.
- (6) A single claim.



# Design Patents Application - Claim

A Design Patent may cover less than the entire design.

(12) **United States Design Patent**  
Stiles

(10) Patent No.: **US D730,634 S**  
(45) Date of Patent: **Jun. 2, 2015**

(54) **SPIRALED HEEL SHOE**

(71) Applicant: **Lozell Stiles, Florissant, MO (US)**

(72) Inventor: **Lozell Stiles, Florissant, MO (US)**

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/442,170**

(22) Filed: **Dec. 26, 2012**

(51) LOC (10) CL: **02-04**

(52) U.S. CL: **D2/939; D2/965**

(58) Field of Classification Search  
USPC: D2/939; D2/965

See application file for complete search history.


(56) **References Cited**  
U.S. PATENT DOCUMENTS

2,126,669 A	* 8/1938	Ryberg	36/34 R
D129,576 S	* 9/1941	Ausubel	D2/966
2,284,326 A	* 5/1942	Korda	36/34 R
2,284,327 A	* 5/1942	Korda	36/34 R
2,284,328 A	* 5/1942	Korda	36/34 R
D163,010 S	* 4/1951	Wiseman	D2/940
D166,867 S	* 5/1952	Ferragamo	D2/966
D170,015 S	* 7/1953	Ferragamo	D2/939
D186,842 S	* 12/1959	Mehr	D2/966
D192,409 S	* 3/1962	Joiner	D2/965
D195,715 S	* 7/1963	Schell	D2/966
D205,882 S	* 10/1966	Post	D2/939

**DESCRIPTION**

FIG. 1 provides a left side view of the spiraled heel shoe of this invention;  
FIG. 2 is a rear view;  
FIG. 3 is a right side view;  
FIG. 4 is a front view;  
FIG. 5 is a bottom view;  
FIG. 6 is a top plan view;  
FIG. 7 is a left side view of a modified spiraled heel shoe;  
FIG. 8 is a left side view of the spiraled heel;  
FIG. 9 is a right side view;  
FIG. 10 is a rear view;  
FIG. 11 is a front view;  
FIG. 12 is a top plan view;  
FIG. 13 is a bottom view of the spiraled heel of this invention;  
FIG. 14 is a bottom view of a modified spiraled heel shoe;  
and,  
FIG. 14 is a bottom view of a modified spiraled heel shoe.

**1 Claim, 4 Drawing Sheets**



(57) **CLAIM**  
The ornamental design for the spiraled heel shoe, as shown and described.



# Design Patent Application - Description

(12) **United States Design Patent**  
**Stiles**

(10) **Patent No.:** US D730,634 S  
 (45) **Date of Patent:** \*\* Jun. 2, 2015

(54) **SPIRALED HEEL SHOE**

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 (52) **U.S. CL** .....  
 USPC ..... **D2/939; D2/965**

(58) **Field of Classification Search**  
 USPC ..... D2/896, 916-918, 925-942, 946,  
 D2/964-967, 969, 971; 36/1, 7.5-783, 8.1,  
 36/11.5, 45-58, 104, 108, 34 R-34 B;  
 D8/378  
 See application file for complete search history.

(56) **References Cited**  
 U.S. PATENT DOCUMENTS

2,126,669 A *	8/1938	Ryberg	36/34 R
D129,576 S *	9/1941	Annabell	D2/966
2,284,326 A *	5/1942	Konda	36/34 A
2,284,327 A *	5/1942	Konda	36/34 R
2,284,328 A *	5/1942	Konda	36/34 R
D163,010 S *	4/1951	Wiseman	D2/940
D166,867 S *	5/1952	Perugia	D2/966
D170,015 S *	7/1953	Ferragamo	D2/939
D186,842 S *	12/1959	Mehr	D2/966
D192,409 S *	3/1962	Joiner	D2/965
D195,715 S *	7/1963	Schell	D2/966
D205,882 S *	10/1966	Post	D2/939

D395,227 S \* 6/1998 Smiley et al. .... D8/378  
 D415,675 S \* 10/1999 Hannerstig et al. .... D8/378  
 D468,625 S \* 1/2003 Schorling ..... D8/378  
 D501,074 S \* 1/2005 Kelsey ..... D2/971  
 D538,026 S \* 3/2007 Choi ..... D2/971  
 D582,637 S \* 12/2008 Guers-Neyraud ..... D2/925

\* cited by examiner


Primary Examiner — Dominic Simone  
 (74) Attorney, Agent, or Firm — Paul M Denk

(57) **CLAIM**  
 The ornamental design for the spiraled heel shoe, as shown and described.

**DESCRIPTION**

FIG. 1 provides a left side view of the spiraled heel shoe of this invention;  
 FIG. 2 is a rear view;  
 FIG. 3 is a right side view;  
 FIG. 4 is a front view;  
 FIG. 5 is a bottom view;  
 FIG. 6 is a top plan view;  
 FIG. 7 is a left side view of a modified spiraled heel shoe;  
 FIG. 8 is a left side view of the spiraled heel;  
 FIG. 9 is a right side view;  
 FIG. 10 is a rear view;  
 FIG. 11 is a front view;  
 FIG. 12 is a top plan view;  
 FIG. 13 is a bottom view of the spiraled heel of this invention; and,  
 FIG. 14 is a bottom view of a modified spiraled heel shoe.

**1 Claim, 4 Drawing Sheets**

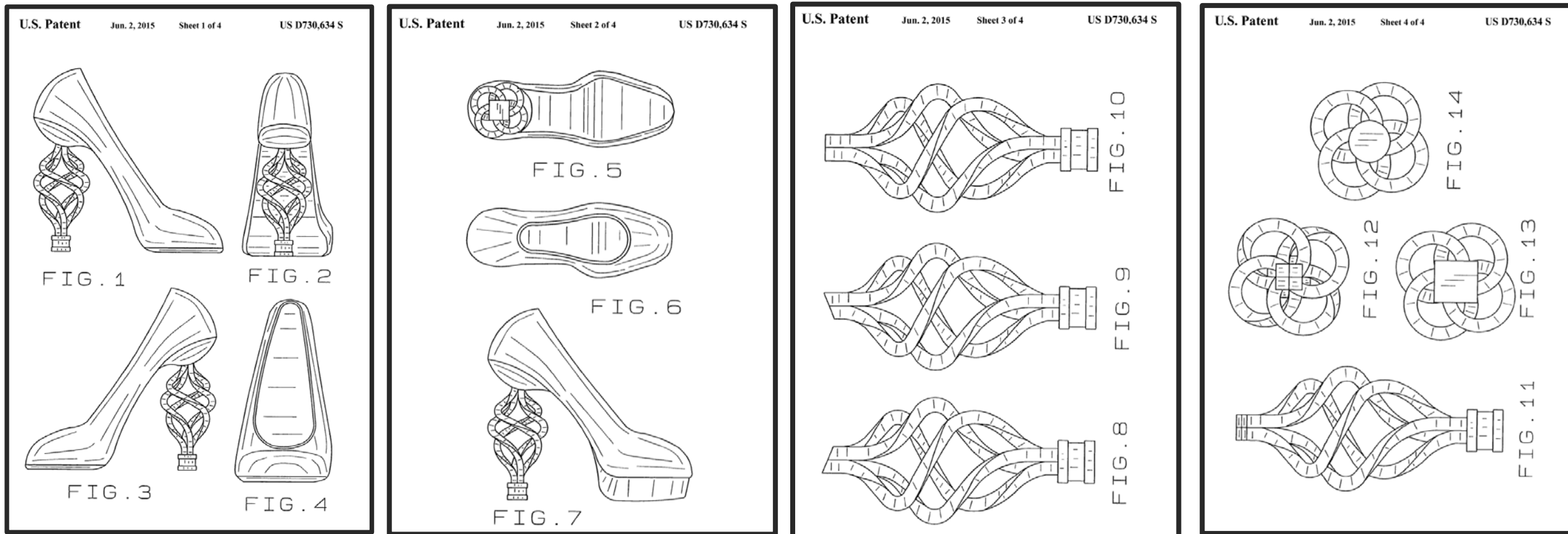


## DESCRIPTION

FIG. 1 provides a left side view of the spiraled heel shoe of this invention;  
 FIG. 2 is a rear view;  
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 FIG. 5 is a bottom view;  
 FIG. 6 is a top plan view;  
 FIG. 7 is a left side view of a modified spiraled heel shoe;  
 FIG. 8 is a left side view of the spiraled heel;  
 FIG. 9 is a right side view;  
 FIG. 10 is a rear view;  
 FIG. 11 is a front view;  
 FIG. 12 is a top plan view;  
 FIG. 13 is a bottom view of the spiraled heel of this invention;  
 and,  
 FIG. 14 is a bottom view of a modified spiraled heel shoe.

**1 Claim, 4 Drawing Sheets**

# Design Patent Application - Drawings



(note - Portions shown separately do not get separate protection)

# Design Patent Application - Practice Notes

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- The drawings should show all parts of the design claimed
- Perspective is helpful
- Show parts not claimed with broken lines

# Design Patent Application – Another Example

(12) **United States Design Patent**  
Kahan et al.

(10) Patent No.: **US D733,373 S**  
(45) Date of Patent: **\*\* Jun. 30, 2015**

(54) **PRESSURE WASHER**

(71) Applicant: **POWERPLAY CORPORATION**,  
Mississauga, Ontario (CA)

(72) Inventors: **Stewart Kahan**, Pointe-Claire (CA);  
**Patrice Guillemain**, Outremont (CA)

(73) Assignee: **POWERPLAY CORPORATION**,  
Mississauga, Ontario (CA)

(\*\*) Term: **14 Years**

(21) Appl. No.: **29/477,423**

(22) Filed: **Dec. 20, 2013**

(30) **Foreign Application Priority Data**  
Nov. 27, 2013 (CA) ..... 154144

(51) **LOC (10) CL** ..... **15-05**

(52) **U.S. CL** ..... **D32/16**  
USPC

(58) **Field of Classification Search**  
USPC ..... D32/16, 15, 25, 17, 18, 19, 21, 31,  
D32/49, 1; 280/47, 26, 651; D34/24, 12, 26;  
239/146; D23/225, 223, 226; 15/302,  
15/320-322; D15/7, 9; 417/360, 364;  
206/562

See application file for complete search history.

(56) **References Cited**  
**U.S. PATENT DOCUMENTS**  
D208,398 S \* 8/1967 Otto et al. .... D32/16  
D233,545 S \* 11/1974 Johns ..... D32/16  
D375,590 S \* 11/1996 Steinhart et al. .... D32/15  
6,116,623 A \* 9/2000 Salvucci ..... 280/47, 26  
D441,935 S \* 5/2001 Cook ..... D34/24  
D444,279 S \* 6/2001 Kristiansen et al. .... D34/12  
D451,257 S \* 11/2001 Moritsch ..... D34/24  
D499,848 S \* 12/2004 Leasure ..... D32/15  
D532,942 S \* 11/2006 Busschaert ..... D32/15

D580,518 S \* 11/2008 Johnson et al. .... D23/225  
D580,610 S \* 11/2008 Hawkins ..... D32/25  
D581,123 S \* 11/2008 Henderson ..... D34/12  
D590,110 S \* 4/2009 Hawkins ..... D32/25  
D596,817 S \* 7/2009 Glass et al. .... D32/25  
D616,065 S \* 5/2010 Gundersen et al. .... D23/225  
D622,471 S \* 8/2010 Hernandez ..... D34/12  
D633,263 S \* 2/2011 Fay ..... D32/15

(Continued)

**FOREIGN PATENT DOCUMENTS**  
CA 116868 \* 7/2006

**OTHER PUBLICATIONS**  
Portsmouth Paint & Wallpaper Equipment Listing Tri-Rent-All,  
Announced Nov. 15, 2011, [Site Visited Dec. 17, 2014] <http://www.trirentall.net/PortsmouthPages/PortsmouthPaint.html>.\*

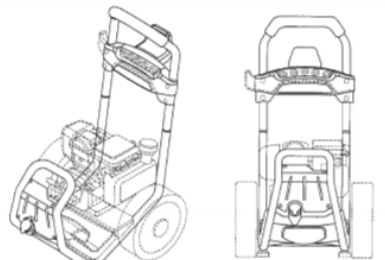
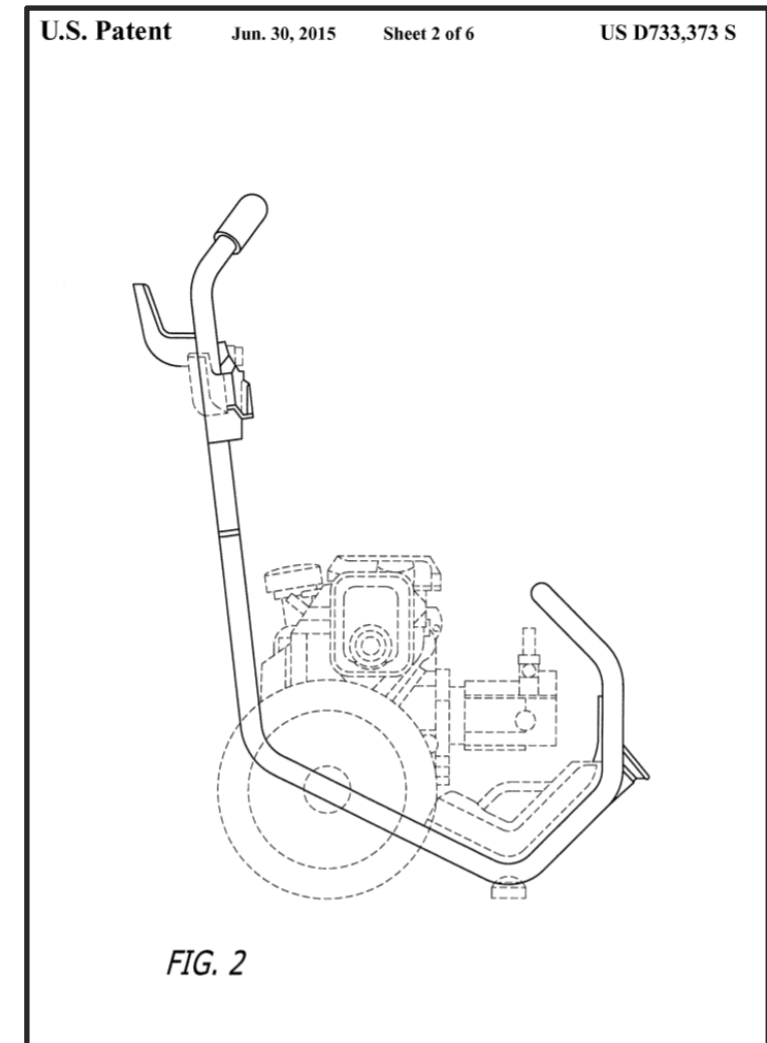
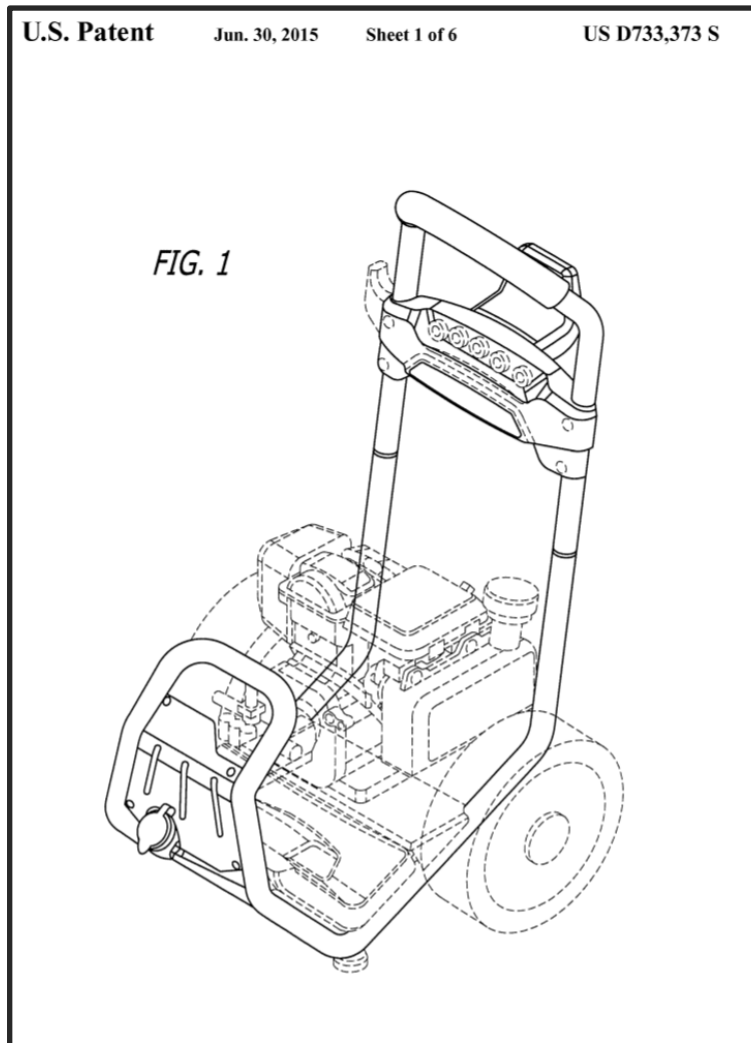
(Continued)

**Primary Examiner** — Eric Goodman  
**Assistant Examiner** — Lugman McNeil  
(74) **Attorney, Agent, or Firm** — Blakely Sokoloff Taylor & Zafman

(57) **CLAIM**  
The ornamental design for a pressure washer, as shown and described.

**DESCRIPTION**  
FIG. 1 is a perspective front, top and first side view illustrating the new design.  
FIG. 2 is a second side elevational view thereof.  
FIG. 3 is front elevation view thereof.  
FIG. 4 is a first side elevation view thereof.  
FIG. 5 is a rear elevation view thereof; and,  
FIG. 6 is a top plan view thereof.  
The broken line showing of details in FIGS. 1 to 6 is included for the purpose of showing environmental portions of the design. No claim is made to the portions shown in broken line.

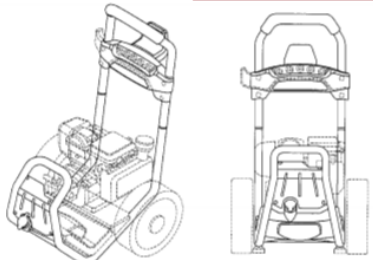
**1 Claim, 6 Drawing Sheets**



# Design Patent Application – Another Example

(12) <b>United States Design Patent</b>		(10) <b>Patent No.:</b>	<b>US D733,373 S</b>
<b>Kahan et al.</b>		(45) <b>Date of Patent:</b>	<b>** Jun. 30, 2015</b>
(54) <b>PRESSURE WASHER</b>		D580,518 S * 11/2008 Johnson et al. .... D23/225	
(71) Applicant: <b>POWERPLAY CORPORATION,</b>		D580,610 S * 11/2008 Hawkins ..... D32/25	
Mississauga, Ontario (CA)		D581,123 S * 11/2008 Henderson ..... D34/12	
(72) Inventors: <b>Stewart Kahan, Pointe-Claire (CA);</b>		D590,110 S * 4/2009 Hawkins ..... D32/25	
<b>Patrice Guillemin, Outremont (CA)</b>		D596,817 S * 7/2009 Glass et al. .... D32/25	
(73) Assignee: <b>POWERPLAY CORPORATION,</b>		D616,065 S * 5/2010 Gundersen et al. .... D23/225	
Mississauga, Ontario (CA)		D622,471 S * 8/2010 Hernandez ..... D34/12	
(**) Term: <b>14 Years</b>		D633,263 S * 2/2011 Fay ..... D32/15	
(21) Appl. No.: <b>29/477,423</b>		(Continued)	
(22) Filed: <b>Dec. 20, 2013</b>		FOREIGN PATENT DOCUMENTS	
(30) <b>Foreign Application Priority Data</b>		CA 116868 * 7/2006	
Nov. 27, 2013 (CA) ..... 154144		OTHER PUBLICATIONS	
(51) <b>LOC (10) CL</b> ..... <b>15-05</b>		Portsmouth Paint & Wallpaper Equipment Listing Tri-Rent-All,	
(52) <b>U.S. CL</b> ..... <b>D32/16</b>		Announced Nov. 15, 2011, [Site Visited Dec. 17, 2014] <a href="http://www.trirentall.net/PortsmouthPages/PortsmouthPaint.html">http://www.trirentall.net/PortsmouthPages/PortsmouthPaint.html</a> *	
(58) <b>Field of Classification Search</b>		(Continued)	
USPC ..... D32/16, 15, 25, 17, 18, 19, 21, 31,		Primary Examiner — Eric Goodman	
D32/49.1; 280/47.26, 651; D34/24, 12, 26;		Assistant Examiner — Luqman McNeil	
239/146; D23/225, 223, 226; 15/302,		(74) Attorney, Agent, or Firm — Blakely Sokoloff Taylor & Zafman	
15/320–322; D15/7, 9; 417/360, 364;			
206/562			
See application file for complete search history.			
(56) <b>References Cited</b>		(57) <b>CLAIM</b>	
U.S. PATENT DOCUMENTS		The ornamental design for a pressure washer, as shown and described.	
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6,116,623 A * 9/2000 Salvucci ..... 280/47.26			
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D499,848 S * 12/2004 Leasure ..... D32/15			
D532,942 S * 11/2006 Busschaert ..... D32/15			
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(57) **CLAIM**

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**DESCRIPTION**

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The broken line showing of details in FIGS. 1 to 6 is included for the purpose of showing environmental portions of the design. No claim is made to the portions shown in broken line.

**1 Claim, 6 Drawing Sheets**

Well defined claim

Description of each drawing

Environment Explained

# What's so great about design patents?

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- Inexpensive to prepare and prosecute
- No maintenance fees
- Quick to issue (can be expedited)
- Bright-line enforcement against knock-offs
- Powerful remedies
- But:

*Thin scope*

*Uncertain validity issues*

# Patent Infringement Remedy Ranking

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Injunctions (eBay / ITC)

Disgorged Profits (Design Only)

Lost Profits (Panduit Test)

Reasonable Royalty (Floor)



# Statute

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## **35 U.S.C. § 289. Additional remedy for infringement of design patent**

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.

# Trade Dress

The definition of trade dress is broad, extending to “the total image of a product,” and it “may include features such as size, shape, color or color combinations, texture, graphics or even particular sales techniques.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992)



# Trade Dress

Must demonstrate that the trade dress has obtained “secondary meaning” to be protectable when applied to product design/configuration. *Wal-Mart v. Samara Bros.*, 529 U.S. 205 (2000)



Samara Bros



Walmart

# Trade Dress: Prohibition Against Functionality

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- “[A] product feature is functional, and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32, (2001).

# Trade Dress: Prohibition Against Functionality

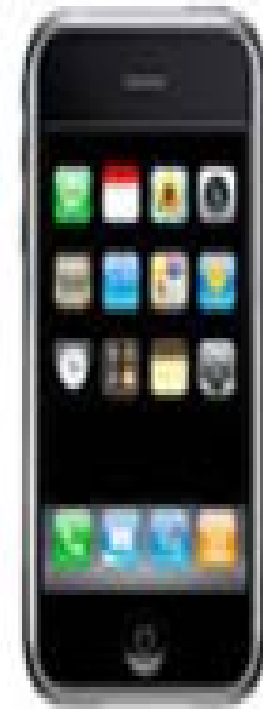
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- In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."
- "A product feature need only have some utilitarian advantage to be considered functional."
- A trade dress, taken as a whole, is functional if it is "in its particular shape because it works better in this shape."

*Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 991  
(Fed. Cir. 2015)

# Trade Dress: Prohibition Against Functionality

- Trade dress was not protectable because it was functional:
- Claimed details such as "the seventh icon depicts a map with yellow and orange roads, a pin with a red head, and a red-and-blue road sign with the numeral '280' in white" are functional. See *id.*
- Apple's user interface expert testified on how icon designs promote usability. "[T]he whole point of an icon on a smartphone is to communicate to the consumer using that product, that if they hit that icon, certain functionality will occur on the phone."



U.S. Reg. 3,470,983

# Trade Dress Infringement Claims

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- Validity
- Priority of use
- Likelihood of confusion
  - Strength of the trade dress.
  - Similarity of the trade dress.
  - Similarity of the products.
  - Likelihood that the owner will bridge the gap.
  - The infringer's intent user's intent in adopting the mark.
  - Evidence of actual confusion.
  - Sophistication of purchases.
  - Quality of the junior user's products.



# Other Trade Dress Considerations

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- Circuit split on availability of infringer's profits absent willful or bad faith conduct
- Defendant has ability to allocate damages (i.e. can show that profits not attributable to infringement), though burden on infringer
- Trade dress can be registered with customs
- Trade dress can be renewed every 10 years in perpetuity as long as its in use.



# Useful Article Copyright

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- Copyright extends to “pictorial, graphic or sculptural works” (“PGS”) 17 U.S.C. § 102(a)(5)
- Included in PGS definition– “Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned” 17 U.S.C. § 101.

# Useful Article Copyright

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- “[T]he design of a useful article, as defined in this section, shall be considered a [PGS] work only if, and only to the extent that, such design incorporates [PGS] features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”
- “A ‘useful’ article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally part of a useful article is considered a ‘useful article.’”
- 17 USC 101

# Useful Article Copyright

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- Infringement is lower standard, requiring a showing of access and substantial similarity to an ordinary observer;
- Infringer profits available regardless of intent, only a “causal” connection required;
- Copyright owner’s lost profits allowed, as long as not duplicative;
- Statutory damages and attorney fees available
- Registration with customs available.

# Useful Article Copyright

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- Virtually NO comparison to prior art
- Creativity required is minimal
- Something like comparison to prior art occurs through the *scenes a faire* doctrine, but not nearly as rigorous
- No use requirement

# Star Athletica Case



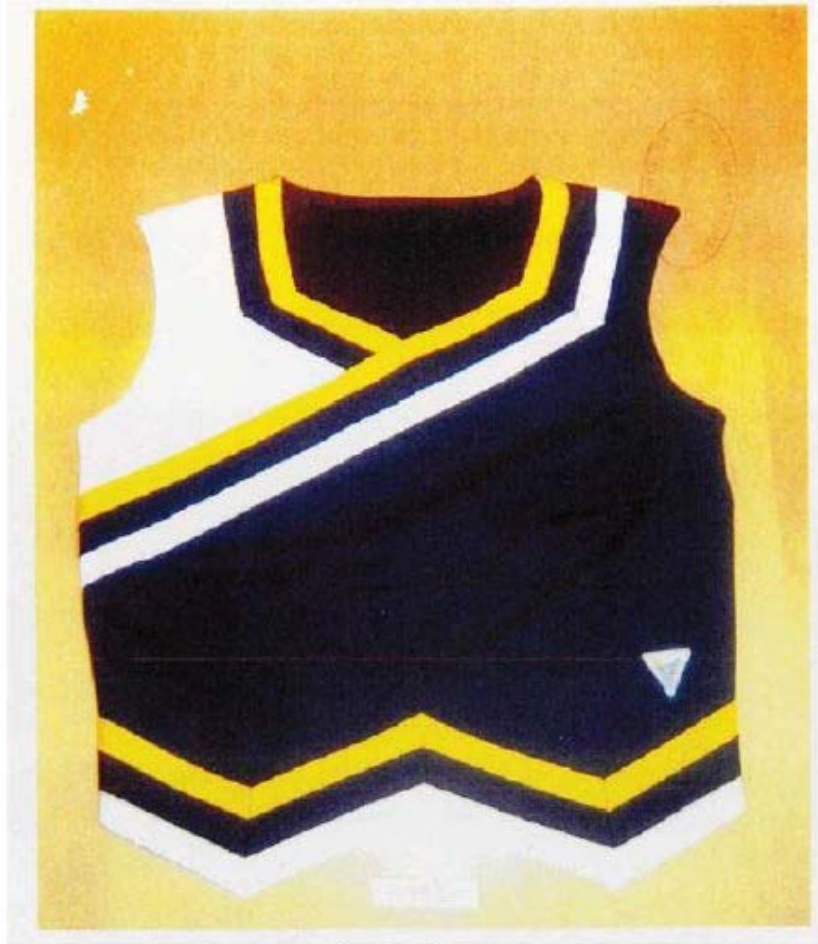
078

Design 078  
Registration No. VA 1-417-427



Design 0815  
Registration No. VA 1-675-905

# Star Athletica Case



Design 299B  
Registration No. VA 1-319-226



Design 299A  
Registration No. VA 1-319-228

# Comparison

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	Functionality	Cover Overall Product Configuration	Limited by Prior Art?	Term
Design Patent	Some Functionality is ok, so long as design is not dictated solely by functionality.	Yes	Yes	15 years
Trade Dress	Feature cannot serve as trademark if it is essential to use or purpose or effects cost or quality	Yes	Compares against senior user	Renewable every 10 years in perpetuity
Copyright	Feature must be physically or conceptually separable from function.	No	Only if common	Life of the author plus 70; 90 years from publication for works for hire

# Comparison (continued)

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	<b>Register with customs?</b>	<b>Is Registration Necessary?</b>	<b>Infringer's profits available</b>
Design Patent	No	Yes	Yes
Trade Dress	Yes	No	Only on showing of willfulness
Copyright	Yes	Only to bring a claim	Yes



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