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RIETI BBL Seminar

U.S. Design Protection for Graphical User Interface

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Agenda

- How GUI became patentable in the U.S.
- How the law has developed
- Current practice and procedures at the USPTO with respect to examination and searching of GUI designs
- Recent U.S. Design Patent litigation involving a GUI design

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Legal Basis for Design Patents

35 U.S.C. § 171 Patents for designs.

- 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.

MPEP § 1502: Definition of a Design

- The subject matter which is claimed in a design patent application is the design embodied in **or applied** to an article of manufacture (or portion thereof) and not the article itself.

Ex parte Cady, 1916 C.D. 62, 232 O.G. 621 (Comm'r Pat. 1916).

- Section 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."

In re Zahn, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

- Thus, the design for an article consists of the visual characteristics embodied in **or applied to** an article.

Surface Ornamentation or Treatment

- The ornamental appearance of a design for an article includes:
  - shape and configuration
  - indicia
  - contrasting color or materials
  - graphic representations, or
  - **other ornamentation applied to the article ("surface treatment")**
- Surface treatment must be applied to or embodied in an article of manufacture.
- Surface treatment, *per se* (i.e., not applied to or embodied in a specific article of manufacture), is not proper subject matter for a design patent.

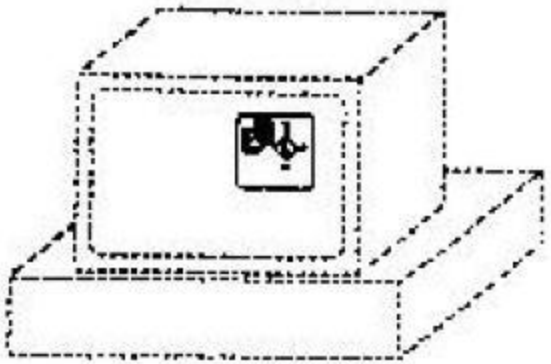
Ex parte Strijland (USPTO BPAI 1992)

- Appeal from Examiner's final rejection of an icon design under 35 U.S.C. § 171
- Basis for the rejection:
  - not an ornamental design for an article of manufacture because it was mere surface ornamentation rather than a design applied to an article of manufacture

FIG. 6

Ex parte Strijland (USPTO BPAI 1992) cont'd

- The Examiner and Board agreed that the design was for a computer display, however, no display was shown or described in the application as filed.
- Board held that had the original application described a display or shown a display the design would be patentable subject matter.



MPEP § 1504.01(a) Computer-Generated Icons (1996 Guidelines)

- To be directed to statutory subject matter, design applications for computer-generated icons must comply with the "article of manufacture" requirement of 35 U.S.C. § 171.
- Because a patentable design is inseparable from the object to which it is applied and cannot exist alone as mere surface ornamentation, an icon **must be embodied on a computer screen, monitor or other display panel or portion thereof**.
- The article of manufacture on which the design is displayed may be shown in broken lines.

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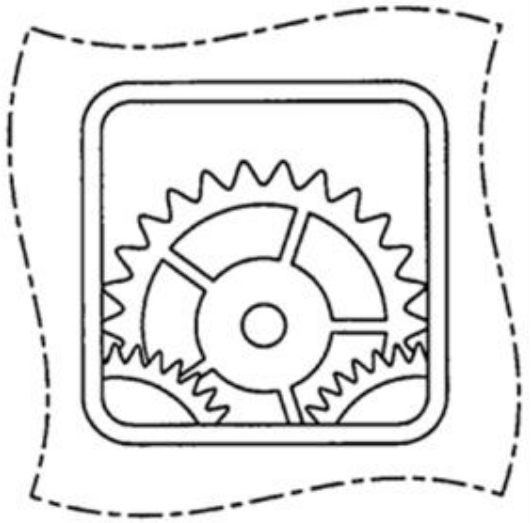
How the Design Law Has Developed Since 1996

- The law has developed very slowly.
- No reported USPTO BPAI decision involving the patentability of GUI designs since 1993.
- Until this year, no reported court decision on validity or infringement of GUI.
- Yet, according to the USPTO, the number of GUI design applications is growing at the fastest rate of any applications.

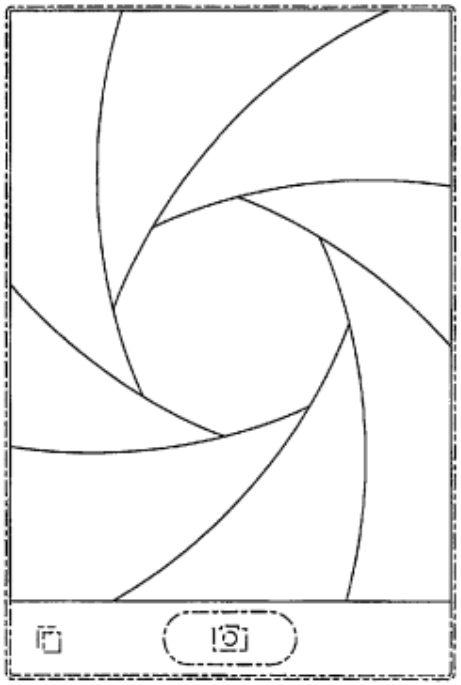
Applications for GUI at the USPTO

- Design must be novel, not obvious and not functional
- Title of the design must include the article
  - A display or portion thereof with icon
- Design drawing must include at least a portion of a display or other article of manufacture



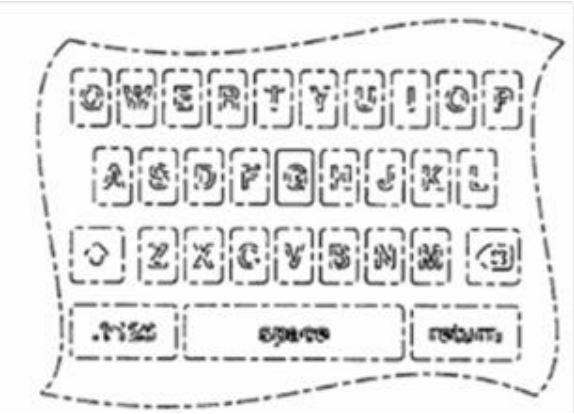
Application for GUI at the USPTO (cont'd)

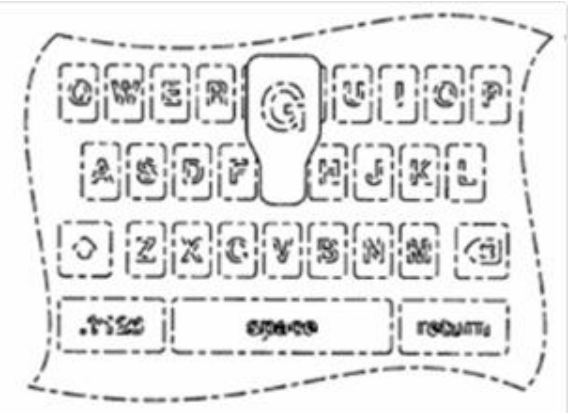
- Design may be presented as a line drawing or digital image in color and/or B & W



Application for GUI at the USPTO (cont'd)

- Design may be shown and claimed as an animation (must show 2 or more views)
- Patentability and infringement is based on all views shown





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Examination at the USPTO

- Any attempt to add language about the article of manufacture in the title or an image of the article in the drawings after an application is filed will be considered “new matter” and will be rejected
- Examiners search prior design and utility patents as well as informal collection of icons and other commercial texts when considering patentability

Recent U.S. Design Patent Litigation Involving a GUI Design

- The number of patent lawsuits filed in United States district courts each year has almost tripled in the last two decades to 3,260 in 2010.
- According to a Stanford University analysis, $20 billion was spent on patent litigation and patent purchases in the smartphone industry in the last two years — an amount equal to eight Mars rover missions.
- Last year, spending by Apple and Google on patent lawsuits exceeded their spending on research and development of new products.

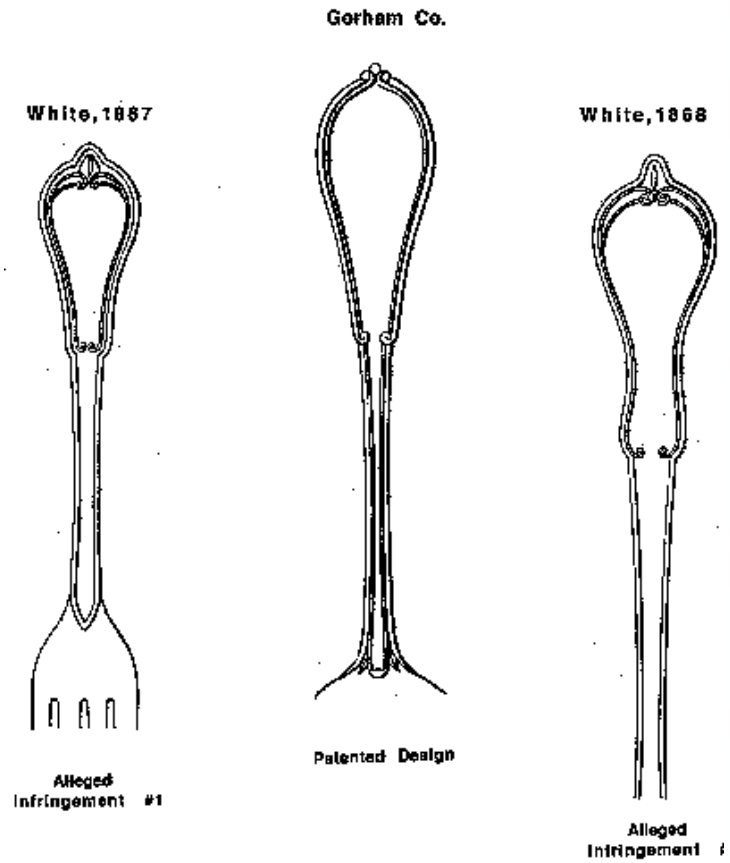
The New York Times, Oct 7, 2012

Test for Utility
Patent Infringement

- Utility patent
  - Literal infringement: every feature of the patent claim is in the accused product
  - Equivalent infringement: each feature is not literally the same, but the feature's function is equivalent
    - Example – claim calls for a screw connecting two parts together and the accused infringer uses a bolt to do the same thing

Test for Design Patent Infringement *Gorham v. White* (US Sup. Ct. 1871)

- Does the accused design have *substantially* the same overall ornamental appearance as the patented design in the eyes of the ordinary observer?
- Literal and equivalent infringement merged into a single test



Example of Design Patent Infringement

"And we have in the accused sole the whole general appearance, which is almost a direct copy of the patented sole."

Avia 750W

Jox Everflex

Avia Group Int'l v. L.A. Gear, 853 F.2d 1557, 1563 (Fed. Cir. 1988)

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Apple Inc. and Samsung Electronics

USA, AU, JP, KR, FR, UK, IT, DE and NE

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Some of the IP Rights Asserted in the U.S.

Apple

Apple's Utility Patents
U.S. Patent No. 7,812,828
U.S. Patent No. 6,493,002
U.S. Patent No. 7,469,381
U.S. Patent No. 7,844,915
U.S. Patent No. 7,853,891
U.S. Patent No. 7,663,607
U.S. Patent No. 7,864,163
U.S. Patent No. 7,920,129

Apple's Design Patents
D627,790
D617,334
D604,305
D593,087
D618,677
D622,270
D504,889

Trade Dress Registrations
U.S. Registration No. 3,470,983
U.S. Registration No. 3,457,218
U.S. Registration No. 3,475,327

Trade Dress Applications
U.S. Appl. Serial No. 77/921,838
U.S. Appl. Serial No. 77/921,829
U.S. Appl. Serial No. 77/921,869
U.S. Appl. Serial No. 85/299,118

Apple's Trademarks
U.S. Registration No. 3,886,196
U.S. Registration No. 3,889,642
U.S. Registration No. 3,886,200
U.S. Registration No. 3,889,685
U.S. Registration No. 3,886,169
U.S. Registration No. 3,886,197

iTunes Trademarks
U.S. Registration No. 2,935,038
U.S. Application Serial No. 85/041,463

Samsung

Samsung's Utility Patents
U.S. Patent No. 6,928,604
U.S. Patent No. 7,050,410
U.S. Patent No. 7,069,055
U.S. Patent No. 7,079,871
U.S. Patent No. 7,200,792
U.S. Patent No. 7,362,867
U.S. Patent No. 7,386,001
U.S. Patent No. 7,447,516
U.S. Patent No. 7,456,893
U.S. Patent No. 7,577,460
U.S. Patent No. 7,675,941
U.S. Patent No. 7,698,711

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Apple's Design Patent D604,395

D604,305

Galaxy S i9000

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The Future of GUI Design Rights

- Pros
  - More emphasis on unique design creation to avoid claims of patent infringement
  - Sharper focus on design protection to ensnare would be copiers
  - Greater respect for design rights
  - Countries expanding their design rights protection and including more products in their design patent portfolio
  - Better developed case law due to increased patent litigation will enable patent attorneys to counsel client's better

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The Future of GUI Design Rights

- Cons
  - More designs patented that should not be, such as purely functional designs
  - More emphasis on clearing new designs before bringing them to market, increasing cost
  - Inexperienced patent practitioners filing design applications who are unfamiliar with best practices
  - Increase in design patent filings slows down processing

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Thank You

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