

DESIGN PATENTS AND GRAPHICAL USER INTERFACES

BY D. PETER HOCHBERG

When most patent lawyers consider design patents, they generally think of the way that an article looks. A design patent is defined by statute as follows:

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

This statutory definition refers to the design for an article. It includes surface ornamentation as an ornamental design, as well as the configuration of goods.

It is the appearance that is the subject of a design patent. A design patent application can relate to the configuration or shape of an article, to the surface ornamentation as applied to the article or to the combination of configuration and surface ornamentation. Manual of Patent Examining Procedure (MPEP) 1502.

When most intellectual property (IP) lawyers think about design patents, they conceive of such items as furniture, footwear designs, glasses, car designs, packaging and innumerable articles of manufacture. However, design patents have taken on a new meaning.

Graphical user interfaces or “GUIs” began in 1979 after Steve Jobs was taken

on a tour of the Palo Alto Research Center (PARC) and its GUIs. Jobs introduced GUIs into Apple’s software for its personal computers. Today, design patents on GUIs are the fastest growing area in design patent applications at the U.S. Patent and Trademark Office (USPTO). The patentability of icons was established in *Ex parte Strijland et al.*, 26 U.S.P.Q. 2d 1259 (USPTO 1992). In that case, the ornamental design for which protection was sought, was as the ornamental design for an information icon for display screen of a programmed computer system.

The patent examiner had rejected this on the grounds that the design was not an “ornamental design for an article of manufacture...” The Patent Trial and Appeal Board (PTAB) ruled that a picture standing alone is not protectable by a design patent,⁷ but gave the inventors an opportunity to amend the application to add dotted lines indicative of the screen.

The USPTO has developed guidelines for the protection of GUIs which set forth in MPEP 1504.01(a) “Computer-Generated Icons.” The USPTO guidelines state that computer-generated icons are “statutory subject matter eligible for design patent protection...if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof...”

These guidelines make it clear that animations can be covered by design patents. The first design patent that covered an item in motion was one directed to a water fountain. In *In re Hruby*, the Court of Customs and Patent Appeals (CCPA) decided in 1967 that water moving in a fountain could be covered by a design patent even though the water was moving. While the fountain was running, the design was in effect, fixed. Design patents cover animations. For example, in U.S. Design Patent No. D457,164, a window on a screen expands from

a small rectangle to an enlarged three sided figure. The simulation of a page turning by screen protected by U.S. Design Patent No. D670,713, as shown below.

Design patents have traditionally been very easy to obtain. The grant rate of design patent applications is about 90%. A design patent application is pending in the USPTO for a relatively short period of time, lasting a little more than a year. Indeed, most design patent applications are never rejected based on prior art. This holds true for GUI patent applications.

D’305 Patent



Samsung



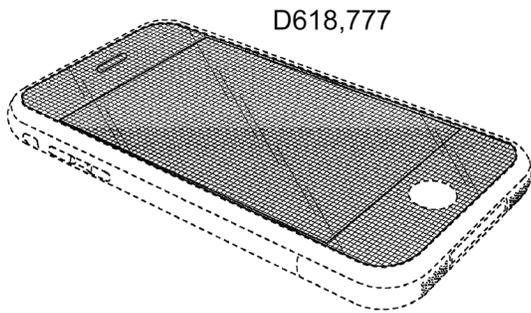


FIG. 1

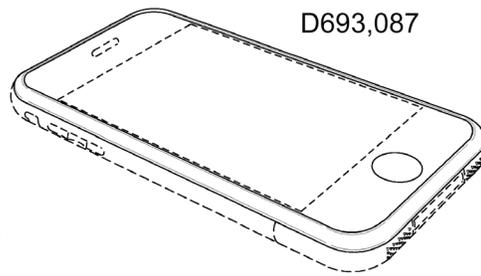


FIG. 1



FIG. 1

In order for a design patent examiner to reject a design patent application, the patent examiner must find prior art which either anticipates the design in the application, meaning that it shows a virtually identical design, or that the design is obvious from the prior art. As was noted in the recent Supreme Court decision in *Apple Inc. v. Samsung Electronics Co., Ltd.* (discussed below), the court said that the examiner must find a single reference that is basically the same as the claimed design.

The test at the USPTO whether a design is obvious it is extremely permissive. The examiner would have to find an earlier design that is almost the same as the design of the design patent application before the examiner can even commence using the analysis.

GUIs have become very significant economically. It is estimated that companies have invested millions of dollars in developing GUIs that are functional and aesthetic. GUIs include screens for smart phones, icons, mobile applications, operating systems, gaming devices, etc.

One of the most publicized cases involving GUIs this *Apple Inc. v. Samsung Electronics Co., Ltd.* Apple had sued Samsung for infringing Apple's U.S. Design Patent No. D604,305, as shown below.

Each of Apple and Samsung had screens for their respective smart phones. The tests which had to be applied to determine whether or not Samsung's screen design infringed that of Apple was whether the ordinary observer would believe that the screen of Samsung is the same as that of Apple. *Gorham Co. v. White*, 81 U.S. (14 Wall) 511,528 (1871) The test was not whether the two screens were identical.

Apple brought a design patent infringement suit against Samsung on April 15, 2011 for the alleged infringement of three of Apple's design patents that were used on smart phones and tablets. *Apple Inc.*

v. Samsung Electronics Co., Ltd., 909 F. Supp. 2d 1147 (N.D. Cal. 2012). A tremendous amount was at stake with respect to the meaning of the 1887 statute, 35 U.S.C. § 289 that enables the owners of design patents to recover from the infringers total profit from an article of manufacture that contains the infringing design. One of the questions faced was whether the "article of manufacture" is the entire smart phone or only the screen to which the design patents relate.

Apple amended its complaint to accuse Samsung of infringing three of its design patents, including U.S. Design Patent Nos. D618,677; D593,087 and D604,305.

Apple had sought the total profits made by Samsung for its sale of the infringing smart phones whereas Samsung stated that it should only be required to pay damages for the design portion of the smart phones. At the district court level, a first jury found that Samsung had infringed all three of the above-mentioned Apple design patents. The jury had awarded Apple total profits that Samsung had received from its sale of the infringing smart phone spirit. After further court proceedings,

Apple was awarded \$929 million. Samsung filed a notice of appeal.

The United States Court of Appeals for Federal Circuit (CAFC) affirmed that the finding of the jury that Samsung had infringed Apple's design patents. 786 F. 3d 93, 1002 (Fed. Cir. 2015), and affirmed the district court's award of damages.

The U.S. Supreme Court granted a writ of certiorari petitioned by Samsung. Justice Sotomayor delivered the Court's opinion on December 6, 2016 stating:

Section 289 of the Patent Act provides a damages remedy specific to design patent infringement. A person who manufactures or sells "any article of manufacture to which [a patented] design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit."

The only question we resolved today is whether, in the case of a multi-component product, the relevant "article of manufacture" must always be the end product sold to the consumer or whether it can also be a component of that product.

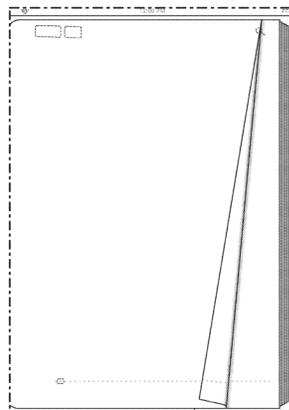


FIG. 1

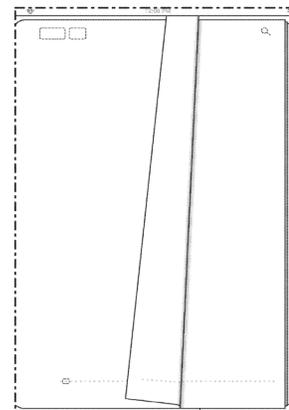


FIG. 2

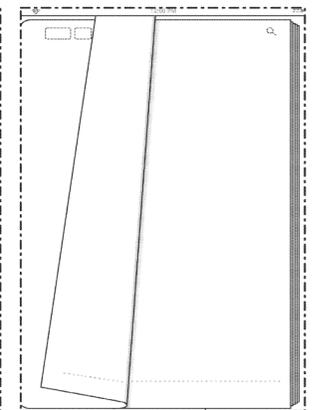


FIG. 3

... the term “article of manufacture” is broad enough to embrace both a product sold to a consumer and a component of that product, whether sold separately or not. Thus, reading “article of manufacture” in §289 to cover only an end product sold to a consumer gives too narrow a meaning to the phrase.

Apple Inc. v. Samsung Electronics Co., Ltd. clearly shows an advantage of protecting GUIs with design patents, and the damages that can be awarded for the infringement of such patents. Copyright law is usually insufficient since it requires that a design be copied in order to violate the copyright protection. The problem between trade dress protection and design patent protection is that design patent protection is more clearly defined than is trade dress protection. There have also been suggestions that trademark law would be appropriate, but this would require that the GUIs

indicate the source of the GUI, which could be difficult to establish.

Design patent protection seems to be the preferred way to protect GUIs. For one thing, a design patent is statutorily presumed valid, and the infringer would have to prove that the design patent is invalid. As indicated in *Apple Inc. v. Samsung Electronics Co., Ltd.*, damages could be very high under design patent law since it is the infringer’s profits that are at stake. The term of design patents is presently fifteen years from the date of grant, but GUIs in almost every instance do not last for fifteen years so this should not be a problem. As opposed to trademarks, a design patent owner would not have to use expensive surveys to establish either infringement or damages.

There are numerous other issues which remain with respect to GUIs which have not been

discussed, or had not been discussed in detail. Nevertheless, this is an important and developing area, and the law will have to develop as rapidly as the technical advances are being made in order to provide fair and protective laws with respect to the owners of GUIs and those attempting to produce new GUIs.



Peter has prepared many U.S. patents and countless corresponding foreign patents. He has appeared in federal courts across the U.S., and in the U.S. Patent and Trademark Office. He has further negotiated and prepared many patent, trademark and trade secret licenses and other agreements. He has been a CMBA member since 2015. He can be reached at (216) 928-2903 or dphochberg@walterhave.com.