

THE DESIGN PATENT FOR THE WORLD



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What opportunities are available to creators and owners of new, original, ornamental designs for obtaining meaningful worldwide protection for their intellectual property? That question has always been on the minds of those who have created ornamental or aesthetic aspects of articles where their function meets form. In some countries, industrial designs may be protected under copyright law.

Considerable attention is being paid to design patents as a result of the much-publicised patent fight between Apple and Samsung in the US District Court for the Northern District of California. On May 18, the US Court of Appeals for the Federal Circuit essentially ‘cut the baby in half’ by removing \$380 million from Apple’s \$930 million district court victory.

A 2012 jury verdict of more than \$1 billion had already been reduced by Judge Lucy Koh, who had invalidated \$450 million of the verdict and ordered a retrial on portions of the case. The federal circuit remanded the case to what will be a new California jury that will be charged with recalculating the favourable Apple verdict. The magnitude of these numbers has captured the attention of many.

But what does this have to do with the question raised above? A great deal, it turns out. The federal circuit, often referred to as the US ‘patent court’, which hears all appeals from district court patent decisions, expressly upheld damages relating to Samsung’s violation of Apple’s registered design patents. The federal circuit’s affirmation of the importance and value of design patent protection is reverberating throughout the IP legal community.

My column in the *January/February* issue of *WIPIR* examined what I referred to as the “underappreciated design patent” as a highly potent IP weapon. The *Apple v Samsung* decision reinforces this view.

I am happy to report here that a significant and positive change in the international law governing design patents has occurred. On May 13, the newly ratified Hague Agreement came into effect. The agreement gives owners of US design patent applications the ability to file an international design application, which will enjoy many of the benefits, such as foreign priority, currently enjoyed by owners of utility patent applications filed under the Patent Cooperation Treaty (PCT). The agreement incorporates a December 18, 2012 Patent Law Treaties Implementation Act which, in turn, implements the 1999 Geneva Act of the agreement.

Lawyer Bryan Walker, in his article “The International Design Patent Application”, published in the June 9, 2015 issue of *The Legal Intelligencer*, provides a wonderful exploration of differences between the three main types of patent applications available in the US. He identifies the common utility patent application, which focuses on “functional aspects of an invention, specifically ‘any new and useful process, machine, manufacture,

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or composition of matter, or any new and useful improvement thereof’, under 35 USC section 101”.

Walker then identifies the design patent application, “... which protects ‘any new, original and ornamental design for an article of manufacture’, under 35 USC section 171”. Finally, he identifies the relatively rare plant patent application, which focuses upon “... any distinct and new variety of plant” under 35 USC section 161. Walker recognises the benefits available under the Hague Agreement.

Filing under the agreement neither replaces nor is a substitute for filing under the PCT, despite their similarities. As Walker observes: “A patent applicant seeking both international utility and design patent protection on an invention would need to file separate PCT and Hague Agreement international patent applications.”

However, the agreement provides applicants with considerable cost-shift savings of the type enjoyed by PCT applicants, and international design patent applications will enjoy publication by the World Intellectual Property Organization.

The Hague Agreement, as an international registration system, provides creative people and owners of industrial designs with new international design patent rights, the importance of which should not be minimised. As IP owners better come to appreciate the significant power and value of design patents, they will take the necessary steps to protect these rights, whether they be in electronic equipment, furniture, bicycles, cosmetics or parts of the fashion industry.

Furthermore, investors will increasingly appreciate companies with US and international design patent rights, which may significantly increase company valuations. ■

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