

# International Comparative Legal Guides



Practical cross-border insights into designs law

## Designs 2023

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant Design authority in your jurisdiction?

The relevant authority for granting a U.S. design patent is the U.S. Patent and Trademark Office (“USPTO”).

### 1.2 What is the relevant Design legislation in your jurisdiction?

The principal legislation governing design patents is Title 35 of the U.S. code, in particular 35 U.S.C. § 171 *et seq.*

## 2 Application for a Design

### 2.1 What can be registered as a Design?

Design patents are used to protect the ornamental appearance of a vast range of different articles, including electronic devices, medical devices, graphical user interfaces (“GUIs”), automobiles, furniture and fabric designs. A design patent may be directed to the shape, surface indicia or surface ornamentation (including colour), or a combination thereof for an article of manufacture.

### 2.2 What cannot be registered as a Design?

A design must meet several requirements to be eligible for design patent protection. As required by statute, the design must be original, novel, non-obvious and ornamental. Design patent protection does not extend to the underlying function of an article of manufacture. To be novel, a design must not already exist. For example, the design must not be identical in all material respects to a prior design, regardless of the field of the prior design. To be non-obvious, a design must not be an obvious variation over prior designs, where such prior designs must first be analogous art (i.e., references from a relevant field of art that a designer would consult in designing the new design) and include a primary *Rosen* reference (i.e., a reference that is “basically the same” as the claimed design, which may then be modified in

light of other prior art references). Finally, to be ornamental, a design’s overall appearance must not be dictated solely by function (noting that “functionality” has different meanings, standards, and underlying policies in each of the different areas of design protection (design patent, copyright, trade dress)).

### 2.3 What information is needed to register a Design?

A design patent application must include: (1) the preamble, stating the name of the applicant, the title of the design, and (optionally) a brief description of the nature and intended use of the article in which the design is embodied; (2) cross-reference to related applications (if applicable); (3) a statement regarding federally sponsored research or development (if applicable); (4) a description of the figure(s) of the drawings; (5) a single claim (in the form: “the ornamental design for a [title], as shown and described”); (6) drawings or photographs; and (7) an executed oath or declaration from the inventor(s).

### 2.4 What is the general procedure for Design registration?

Applicants file their application with the USPTO. The USPTO will then examine the applications, generally in order of their actual filing date, noting that it is possible to request expedited examination by paying an additional USPTO fee and satisfying additional procedural requirements, including performing and submitting the results of a prior art search. The examination process includes a review of the application’s adherence to technical and substantive requirements. This review includes examining the completeness of the drawings and disclosure, and comparing the claimed subject matter to the “prior art”. “Prior art” consists of any publicly available disclosures, including issued patents and published patent applications. Bases for rejection include: incomplete disclosure; lack of novelty; obviousness; and lack of ornamentality. After review, the examiner will either allow the application or send an office action to the applicant describing any technical deficiencies (objections) and substantive deficiencies (rejections) affecting patentability. The office action may further include the examiner’s recommendations for amendments to the application to put it in form for allowance. If the claimed subject matter is found to be patentable,

upon payment of an issue fee the USPTO will issue a design patent. If the applicant fails to pay the issue fee, the application will be abandoned. At any time prior to issuance, the applicant can pursue continuation applications based on the initial parent application directed to different claim scopes. As long as the continuation application is sufficiently disclosed and described in the parent application, the later continuation application will be entitled to the priority date of the parent application.

#### 2.5 How is a Design adequately represented?

A claimed design must be sufficiently shown and described in the figure(s) accompanying the design patent application in compliance with 35 U.S.C. § 112. At least one figure is required in the drawings. There is no maximum amount of figures that may be submitted. Solid lines are used to illustrate the claimed design. Broken lines can be used to illustrate parts of the article that do not form any part of the claimed design. Where the design is directed to a GUI, the article of manufacture (typically a display screen) must be shown, but may be shown in broken lines so that it is not part of the claimed design.

#### 2.6 Are Designs registered for specific goods or products?

Even though design patents are not registered for specific goods or products, design patents must designate an article of manufacture (which may be an end product or a component thereof), and the chosen title may affect the claim scope under certain circumstances.

#### 2.7 Is there a “grace period” in your jurisdiction, and if so, how long is it?

The U.S. patent statutes provide an applicant a one-year grace period from the applicant’s first public disclosure of its design in which to file a design patent application. The one-year grace period is tracked from the design patent application’s earliest effective filing date, which may track to a foreign filing.

#### 2.8 What territories (including dependents, colonies, etc.) are or can be covered by a Design in your jurisdiction?

The following territories are governed by U.S. design patent law: the 48 states in the continental United States; Alaska; American Samoa; Guam; Hawaii; the Northern Mariana Islands; Puerto Rico; and the U.S. Virgin Islands. Thus, an issued design patent is enforceable in each of these territories.

#### 2.9 Who can own a Design in your jurisdiction?

Any natural or legal jurisdictional person or persons may own a design patent. The inventor(s) of a novel, original, non-obvious, and ornamental design first own(s) that design. As such, any rights will initially vest with the inventor(s). The inventor(s) may freely assign his, her, or their rights to the design. All assignments or transfers must be in writing and contain all the essential terms under U.S. contract law. In certain situations, the inventor(s) may be obligated to assign their designs *ab initio*, such as through an employment contract. Many companies will also

require an explicit assignment from each inventor for each design application filed. Rights in a design patent may be owned jointly or may be assigned to a single entity. While not mandatory, patent owners should record their assignments with the USPTO.

#### 2.10 How long on average does registration take?

As of August 2022, the USPTO reports average total pendency of 19.9 months, which is less than one month shorter than the average pendency a year ago. Note that pendency tends to vary between art areas.

#### 2.11 What is the average cost of obtaining a Design in your jurisdiction?

The average cost from filing to issuance is about \$5,000–\$8,000, but much depends on whether the USPTO issues any office actions, and the content of such office actions.

#### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There is only one route to obtaining a design patent in the United States – by filing a design patent application with the USPTO.

#### 2.13 Is a Power of Attorney needed?

Generally, a Power of Attorney is not required, and a patent practitioner may act in a representative capacity for a client by signing a paper (including an office action response). The patent practitioner’s signature represents to the USPTO that the patent practitioner is authorised to represent the patent applicant. However, a Power of Attorney is required for certain actions, including to make telephonic elections in response to a restriction requirement, to file a terminal disclaimer, or to approve the examiner’s amendments. While not mandatory, a Power of Attorney is recommended.

#### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation of the Power of Attorney is required. The Power of Attorney must be signed by someone who is authorised to act on behalf of the assignee-applicant (i.e., a person with a title that carries apparent authority, or a person who includes a statement of authorisation to act).

#### 2.15 How is priority claimed?

An applicant may claim priority to a pending design patent or non-provisional utility patent application by filing a continuation, divisional, or continuation-in-part application. An applicant may not claim priority to a provisional utility patent application. In addition, an applicant may claim foreign priority up to six months after the first filing in any country subscribing to the Paris Convention. While an applicant may also claim foreign priority to a pending foreign utility patent application, the window remains at six months.

### 2.16 Can you defer publication of Design applications in your jurisdiction? If so, for how long?

There is no formal process or procedure for deferring publication. However, design patent applications are not published by the USPTO prior to issuance and thus a design application and its prosecution history will not be publicly available until the design patent is issued. Thus, an applicant maintains control over whether its design is ultimately published.

## 3 Grounds for Refusal

### 3.1 What are the grounds for refusal of registration?

A pending design patent application may be attacked on several different grounds. During prosecution, a USPTO examiner may reject a design patent application as failing to meet one of the statutory requirements of patentability. These requirements include: novelty (§ 102); non-obviousness (§ 103); originality (35 U.S.C. § 171); ornamentality (§ 171); written description compliance (§ 112); definiteness (§ 112); and enablement (§ 112).

### 3.2 What are the ways to overcome a grounds objection?

An applicant may overcome an objection or rejection by successfully persuading the USPTO that the objection or rejection is unfounded or by amending the drawings, description, or claim to overcome the objection or rejection.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant may file an appeal with the Patent Trial and Appeal Board (“PTAB”) after having been given a final rejection or after the claim has been rejected twice. If the applicant is dissatisfied with the outcome before the PTAB, he or she may (1) have remedy by civil action against the Director of the USPTO in the U.S. District Court of the Eastern District of Virginia, or (2) appeal the PTAB’s decision to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”).

### 3.4 What is the route of appeal?

Under 35 U.S.C. § 134, an applicant or patent owner with any claims that have been rejected twice, may appeal the decision to the PTAB after paying the necessary fees and filing a notice of appeal. Within two months of filing the notice of appeal, and prior to a three-month shortened statutory period for reply set in the Office Action from which the appeal was taken, an appeal brief must be filed. The examiner then responds with an examiner’s answer. Within two months, the appellant may file a single reply brief. If the examiner’s answer contains a new ground for rejection, the appellant must file a reply brief in order to maintain the appeal or reopen prosecution. The appellant may request an oral hearing. The Board will then provide a decision. The appellant may file a request for rehearing within two months from the date of the original decision.

If the appellant is dissatisfied and decides to commence a civil action against the Director of the USPTO, the Appellant must

commence the action within a time decided by the Director. The time may not be less than 60 days. Alternatively, the appellant may appeal to the Federal Circuit.

## 4 Opposition

### 4.1 Can a Design application be opposed, and if so, on what grounds?

A pending design patent application cannot be opposed. Even though there is no formal procedure for opposing a pending design (or utility) patent application, a third party may submit published patent applications, patents or other printed publications for the USPTO to consider during prosecution of a particular application. See 35 U.S.C. § 122(e); 37 C.F.R. 1.290; Manual for Patent Examining Procedure 1134. However, seeing that design patent applications are not open to the public, and thus the nature of the pending design is unknown, the procedure is rarely used with design patent applications.

### 4.2 Who can oppose the registration of a Design in your jurisdiction?

This is not applicable in the United States.

### 4.3 What is the procedure for opposition?

This is not applicable in the United States.

## 5 Registration

### 5.1 What happens when a Design is granted registration?

When a design patent application issues as a design patent, the USPTO publishes the design patent and mails a hard copy of the design patent certificate to the owner.

### 5.2 From which date following application do an applicant’s Design rights commence?

Design patent rights commence on the date of issuance.

### 5.3 What is the term of a registered Design right?

Granted U.S. design patents have a term of 15 years from date of issuance. (Note: design patents issuing from applications filed before May 13, 2015 have a 14-year term from date of issuance.)

### 5.4 How is a Design renewed?

A design patent cannot be renewed in the United States; the term is fixed at 15 years.

## 6 Registrable Transactions

### 6.1 Can an individual register the assignment of a Design?

Yes. The assignment document can, and should, be recorded with the USPTO.



## 6.2 Are there different types of assignment?

While assignments may take different formats and convey different rights, all assignments or transfers must be in writing and contain all the essential terms under U.S. contract law.

## 6.3 Can an individual register the licensing of a Design?

A design patent licence may be recorded with the USPTO. However, registration is not required.

## 6.4 Are there different types of licence?

There are various types of licences. For example, a licence may be exclusive or non-exclusive, royalty-based or royalty-free, and renewable or non-renewable.

## 6.5 Are there any laws that limit the terms upon which parties may agree a licence?

Outside of typical contracting laws in the United States, there are no design patent-specific licensing limitation laws.

## 6.6 Can Designs be the subject of a compulsory licence (or licences of right), and if so, in what circumstances does this arise and how are the terms settled?

The U.S. patent code does not include a general compulsory licensing provision.

## 6.7 Can a Design licensee sue for infringement?

An exclusive licensee can sue for infringement, as long as the exclusive licensee can show that it possesses all substantial rights in the design patent. A non-exclusive licensee may only sue as a co-plaintiff with the patentee.

## 6.8 Are quality control clauses necessary in a licence?

No. Quality control clauses, while needed in trademark licensing, are not required for design patent licensing.

## 6.9 Can an individual register a security interest under a Design?

A security interest under a design patent can be recorded with the USPTO. The security interest should also be registered with the Secretary of State in the state where the debtor is located.

## 6.10 Are there different types of security interest?

There are different ways in which a security interest can be created. Generally, security interests serve as a means for providing security or collateral for some type of loan or other debt. A security interest may cover all rights or only a partial interest in a design patent.

## 7 Invalidity

### 7.1 What are the grounds for invalidity of a Design?

Unless specified otherwise for a particular invalidation procedure, a design patent's validity may be attacked on the same grounds that a pending design patent application may be attacked. See question 3.1 above.

### 7.2 What is the procedure for invalidation of a Design?

There are two main options for a third party to invalidate a design patent: (1) through a post-grant allowance process before the PTAB; or (2) through litigation in a U.S. district court. There are three post-grant allowance processes available: post-grant review ("PGR"); *inter partes* review ("IPR"); and *ex parte* re-examination.

### 7.3 Who can commence invalidation proceedings?

A PGR may be filed by any person who is not the patent owner and who has not filed a civil action challenging the patent's validity. Such a person must file the PGR within nine months of the issue date. An IPR may be filed by any person who is not the patent owner, has not previously filed a civil action challenging the validity of a claim of the patent, and has not been served with a complaint alleging infringement of the patent more than one year prior (there is an exception for joinder). An *ex parte* re-examination may be filed by anyone at any time during the period of enforceability of a design patent, where the requester is able to establish a substantial new question of patentability. A declaratory judgment action to contest validity of a design patent may be filed in district court by any party for whom an actual case or controversy exists regarding the design patent.

### 7.4 What grounds of defence can be raised to an invalidation action?

In defence to an invalidation action, a patentee may argue that the challenger has not shown that the design patent is not ornamental, novel, original, non-obvious, supported by the written description, sufficiently definite, and sufficiently enabling to allow one of ordinary skill in the art to make and use the claimed design, as needed.

### 7.5 What is the route of appeal from a decision of invalidity?

A party may appeal the PTAB's or district court's decision regarding invalidity to the Federal Circuit, and ultimately to the U.S. Supreme Court.

## 8 Design Enforcement

### 8.1 How and before what tribunals can a Design be enforced against an infringer?

A design patent can be enforced before a district court and before the International Trade Commission ("ITC"). Currently, design patents cannot be enforced directly through customs. Customs is only available for designs if a court or the ITC have issued an order. Notably, money damage awards are not available via the ITC.

## 8.2 Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

In a district court proceeding, validity and infringement are typically heard in the same proceeding. During a post-grant proceeding, only validity is at issue.

## 8.3 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial stages in a civil action for design patent enforcement include: the filing of a complaint; the filing of an answer, affirmative defences, counterclaims and preliminary motions (if applicable); the exchange of initial disclosures; the service of written discovery requests for facts, documents and things; the taking of oral and written depositions; the summary judgment; and other pre-trial motions. The time between commencement and trial depends on the court docket, time required for discovery, motions, and other unforeseen hurdles (such as a global pandemic). Claim construction is also another potential pre-trial stage of a case. However, unlike cases regarding utility patents, the district court will rarely conduct a claim construction hearing in a design patent case, as the patent figures are said to speak for themselves. A typical design patent infringement case takes approximately 30–36 months to reach final judgment in district court.

## 8.4 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case?

Yes, both preliminary and final injunctions are available. Prior to granting preliminary injunctions, courts look at a number of factors, including: (1) the plaintiff's likelihood of prevailing on the merits; (2) a showing of irreparable injury to the plaintiff if relief is not granted; (3) the threatened injury to the movant is demonstrated to outweigh whatever damage the proposed injunction may cause the opposing party; and (4) the balancing of equities. Prior to granting final injunctions, courts look at a number of factors including: (1) whether the plaintiff has suffered an irreparable injury; (2) whether remedies available at law, such as monetary damages, are inadequate to compensate for the injury; (3) whether the remedy in equity is warranted upon consideration of the balance of hardships between the plaintiff and defendant; and (4) whether the permanent injunction being sought would hurt public interest.

## 8.5 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary, and if so, how?

Broad discovery is available in the United States. A party may serve requests for production of documents and things, interrogatories, requests for admissions, and deposition notices on another party. A court may compel a party to respond to these types of discovery requests if the party fails to do so voluntarily or adequately. A court may impose fines or sanctions if a party fails to comply with discovery orders.

## 8.6 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In a district court, evidence may be presented in writing or orally. Generally, at a trial, witnesses are required to testify orally and

in person. In some situations, a court may allow portions of a witness's deposition transcript to be read aloud. Witnesses are generally cross-examined by opposing counsel.

## 8.7 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Infringement proceedings can be stayed pending an IPR before the PTAB or pending an action before the ITC. The decision of whether to stay is largely at the discretion of the presiding judge.

## 8.8 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

A typical design patent infringement case takes approximately 30–36 months to reach a final judgment in district court. ITC investigations typically reach final determination in under 15 months from institution.

Thus, patent-based ITC investigations tend to be shorter than district court patent litigation. In fact, the statutory language of § 337 requires that they conclude “at the earliest practicable time”. The ITC and sometimes the Federal Circuit affirm PTAB invalidity decisions before modifying its orders.

While district courts are routinely stayed pending resolution of an IPR, ITCs are seldom stayed pending the resolution of an IPR.

ITC investigations involve unfair practices in import trade – thus, where there is no import involved, ITC is not available.

IPRs typically take 18 months from filing to completion (excluding appeals to the Federal Circuit).

## 8.9 Who is permitted to represent parties to a Design dispute in court?

A competent attorney admitted to practise before the district court in which the suit is brought may represent a party to a design dispute. For example, for district court cases, if the attorney is not admitted to practise in that particular jurisdiction, he or she may engage another attorney admitted in that jurisdiction, and request *pro hac vice* admission.

For patent office proceedings, such as IPRs, only members of the USPTO patent bar are permitted to appear.

## 8.10 After what period is a claim for Design infringement time-barred?

Under 35 U.S.C. § 286, a patentee may not recover damages for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action, except as otherwise provided by law.

## 8.11 Are there criminal liabilities for Design infringement?

There are no criminal liabilities for design patent infringement in the United States.

### 8.12 If so, who can pursue a criminal prosecution?

This is not applicable in the United States.

### 8.13 What, if any, are the provisions for unauthorised threats of Design infringement?

There is no specific provision to deal with unauthorised threats of design patent infringement. If the court ultimately decides that a claim of design patent infringement was asserted in bad faith, a court may award attorneys' fees to the party against whom the claim was filed. If baseless threats of design patent infringement are made to customers of the accused party, such baseless communication can subject the asserting party to tort liability, including actions for interference with prospective or actual customer relations.

## 9 Defences to Infringement

### 9.1 What grounds of defence can be raised by way of non-infringement to a claim of Design infringement? For example, are there "must match" and/or "must fit" defences or equivalent available in the jurisdiction?

Courts use the "ordinary observer" test to ask whether "in the eye of an ordinary observer, two designs are substantially the same" in view of the prior art. If so, there is design patent infringement. An alleged infringer may argue that the allegedly infringing design is not substantially the same in the eyes of an ordinary observer. There are no "must fit" or "must match" exceptions to infringement in the United States.

### 9.2 What grounds of defence can be raised in addition to non-infringement?

An accused infringer may raise patent invalidity as a defence to patent infringement, as discussed above.

### 9.3 How does your jurisdiction deal with Design protection for spare parts?

There are no prohibitions on design patent protection for spare parts. Over the years, the spare parts industry has lobbied for such prohibitions without success, including aftermarket-centred PARTS Bills.

## 10 Relief

### 10.1 What remedies are available for Design infringement?

A court may grant injunctive and monetary relief. Two mutually exclusive avenues of monetary recovery exist for design patent infringement. Under § 284, a patentee may recover typical patent infringement damages, including reasonable royalties and lost profits. Alternatively, under § 289, a design patentee may elect to recover a disgorgement of the "total profit" of the accused infringer's sales of an infringing product. § 289 damages are a remedy available to design patentees that are not available to utility patentees.

### 10.2 Are damages or an account of profits assessed with the issues of infringement/validity or separately?

Even though, in district court, damages are normally assessed along with infringement and validity, district courts have the discretion to bifurcate the damages assessment.

### 10.3 On what basis are damages or an account of profits assessed?

See question 10.1 above.

### 10.4 Are punitive damages available?

A party may receive a trebling of damages for wilful infringement under § 284. Under § 289, damages may not be trebled for wilful infringement. While attorneys' fees are generally not available, in "exceptional" cases as a punitive measure, a court may grant them.

### 10.5 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

While court costs may be awarded to the prevailing party in a civil action, "court costs" are not the same as "attorneys' fees", which are typically not awarded to the prevailing party. Court costs include filing fees, fees for recorded transcripts for use in a case, fees and disbursements for printing and witnesses, and fees for court-appointed experts and interpreters. Attorneys' fees may be awarded to the prevailing party in "exceptional" cases.

## 11 Appeal

### 11.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The Federal Circuit has exclusive jurisdiction to hear an appeal for any civil action relating to patents, including design patents. Parties may appeal decisions from the Federal Circuit by filing a petition for *writ of certiorari* with the Supreme Court, which has broad discretion to grant or deny such petitions.

### 11.2 In what circumstances can new evidence be added at the appeal stage?

Generally, appeals are considered on the record of the lower court and new evidence will not be considered.

## 12 Border Control Measures

### 12.1 Is there a mechanism for seizing or preventing the importation of infringing articles and, if so, how quickly are such measures resolved?

Unlike registered trademarks and copyrights, design patents can only be enforced at customs with a court order.

The Counterfeit Goods Seizure Act of 2019 was introduced in the U.S. Senate in December 2019 to empower U.S. Customs and Border Protection to enforce U.S. design patents at the U.S. border. The law is not yet in force and has not yet been reintroduced in the 117<sup>th</sup> Congress, which began on January 3, 2021.



## 13 Other Related Rights

### 13.1 To what extent are unregistered Design rights enforceable in your jurisdiction?

Unlike other jurisdictions, such as the European Union, the United States does not provide protection for unregistered (i.e., unpatented) designs. Copyright and trade dress, where applicable, may be used to protect the appearance of products and product packaging.

### 13.2 What is the term of unregistered Design rights enforceable in your jurisdiction?

This is not applicable in the United States.

### 13.3 What, if any, are the key differences between unregistered and registered Design rights in your jurisdiction?

This is not applicable in the United States.

### 13.4 If unregistered Design protection is available in your jurisdiction, is protection cumulative or mutually exclusive?

This is not applicable in the United States.

### 13.5 Is copyright available to protect industrial Designs?

Although useful articles are not usually protectable by copyright, a design may be protected by copyright where, and to the extent, there is copyrightable subject matter that is separable from the underlying useful article.

## 14 Current Developments

### 14.1 What have been the significant developments in relation to Designs in the last year?

On May 5, 2022, China officially joined the Hague System. Applicants filing international design applications via Hague may now designate China. In the United States, applicants continue to apply for design patents and design patent holders continue to enforce their existing rights. A recent batch of district court cases has seen a patentee assert its design patent directed to an animated GUI against different accused infringers, which may lead to more opinions on infringement or non-infringement of GUI design patents.

### 14.2 Please list three important judgments in the Designs sphere that have been issued within the last 18 months.

In *Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.*, a district court initially granted summary judgment of infringement of a design patent directed to a heat reflective material. On appeal, the Federal Circuit held that the lower court erred in granting summary judgment because the lower court failed to consider the effect of the infringer's logo in its infringement analysis and because the lower court resolved a

series of disputed fact issues that the Federal Circuit believed should have been tried to a jury. In August 2021, on remand, a jury now found that Seirus's products did not infringe Columbia's design patent. In September 2021, Columbia filed a notice of appeal to the Federal Circuit. The case is currently awaiting oral argument and a decision should then be forthcoming.

In *Campbell Soup Co. v. Gamon Plus, Inc.*, the PTAB initially held that a pair of design patents were patentable. The Board found that a prior art reference could not be a proper primary reference for assessing obviousness where the prior art reference lacked a claimed cylindrical object (a soup can). On appeal, the Federal Circuit reversed and remanded, holding that the prior art reference was a primary reference despite not showing a cylindrical object. On remand, the PTAB again found that the claimed design was patentable over the prior art, now relying on numerous secondary considerations to show that the claimed designs were not obvious over the prior art. In August 2021, the Federal Circuit once again reversed the Board, holding that there was insufficient evidence of a nexus between the claimed design and the secondary considerations of obviousness. In February 2022, the U.S. Supreme Court denied Gamon's petition for writ of certiorari.

In *In re Surgisil, L.L.P.*, the Federal Circuit held that, in considering anticipation, a design claim is limited to the article of manufacture identified in the claim. (In the United States, the article of manufacture to which the claimed design is applied is noted in the claim and the title.) The *Surgisil* court held, as a matter of law, the scope of a design right is not anticipated by prior art from a different article of manufacture, no matter how similar in appearance the prior art may be. Specifically, since the article of manufacturer identified in the claim was a "lip implant", the alleged prior art reference, which was directed to an art stump tool, could not anticipate as a matter of law and despite being effectively identical in appearance. This decision is consistent with the Federal Circuit's earlier decision in *Curver Luxembourg, SARL v. Home Expressions Inc.*, where the Federal Circuit held in the context of infringement that the article of manufacture identified in the claim limits the scope of a design patent. Specifically, and as a matter of law, a design patent claim that identifies a "chair" as its article of manufacture cannot be infringed by a "basket", no matter how similar in appearance the accused basket may be.

### 14.3 Are there any significant developments expected in the next year?

Movement is expected within the next year or so towards adoption of a Design Law Treaty ("DLT"), which aims to help designers obtain easier, faster and cheaper protection for their designs. The World Intellectual Property Organization ("WIPO") recently decided that there must be a diplomatic conference regarding a DLT no later than 2024. This could lead to agreement and adoption of a DLT.

### 14.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

With more and more interest in e-commerce during the global pandemic, design rights continue to gain popularity. The visual impression of goods sold online is important in an e-commerce platform where the customer's purchasing decision is heavily influenced by the appearance of the product. E-commerce platforms like Amazon should implement new procedures and mechanisms to weed out design patent infringement in their marketplace, including introducing a design patent equivalent to the Utility Patent Neutral Evaluation Process ("UPNEP").



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