



Welcome!

#designlaw2016



Design Patent Damages

#designlaw2016

Our Speakers



Moderator
Robert Katz
Banner & Witcoff



Christopher Burrell
Director &
Senior Counsel
Samsung
Electronics



Mark S. Davies
Partner
Orrick



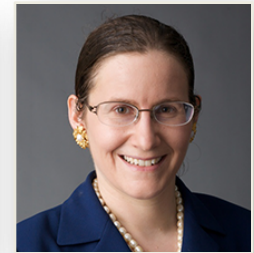
Mark Janis
The Center for
IP Research at
Maurer School
of Law



Jeff Myers
Lead Patent
Counsel
Apple



Brian Racilla
USPTO, Office
of the Solicitor

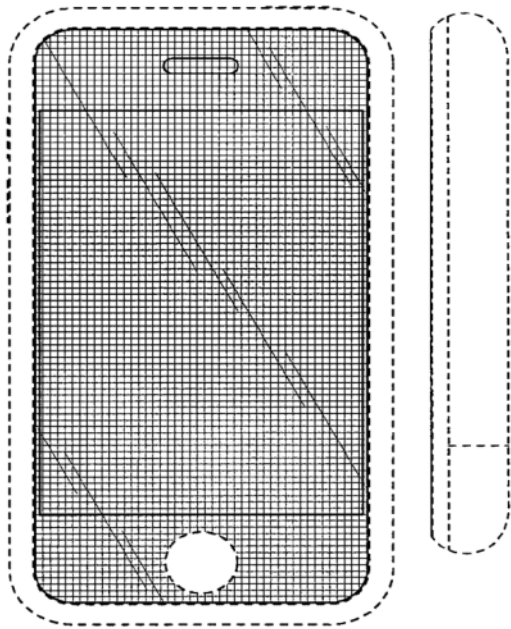


Rebecca Tushnet
Georgetown
Law

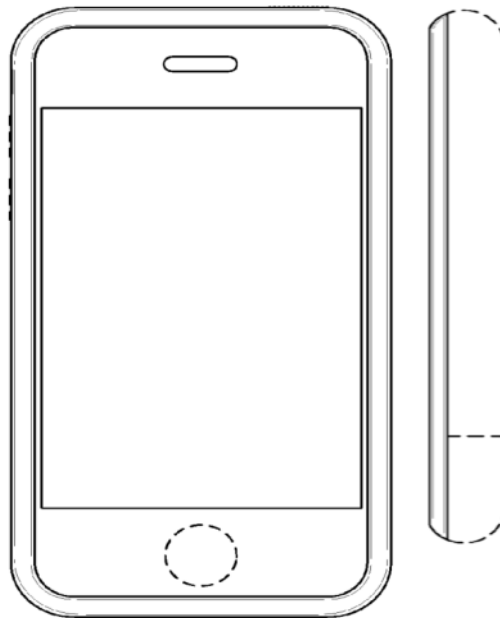


GEORGETOWN LAW

Apple's Smartphone Design Patents Hardware (x2) and GUI



D618,677



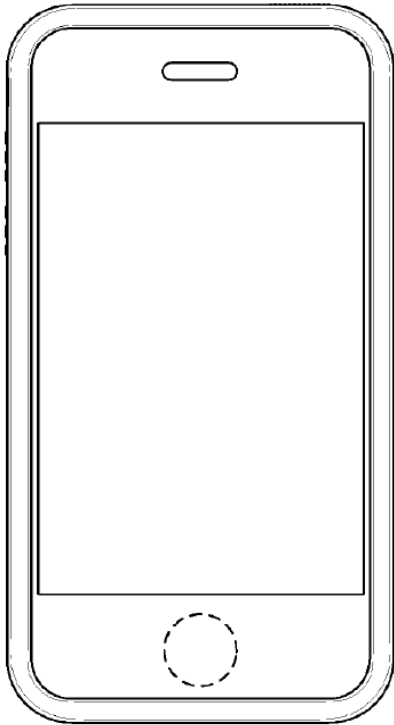
D593,087



D604,305

Bezel and Front Face Design Patent

'087 Design Patent



Samsung Model - Galaxy S and Infuse

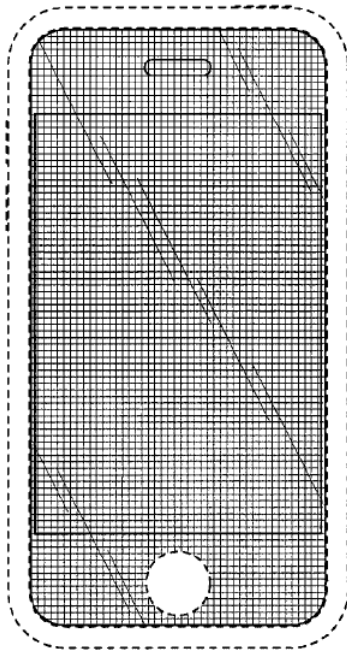


3 - YES

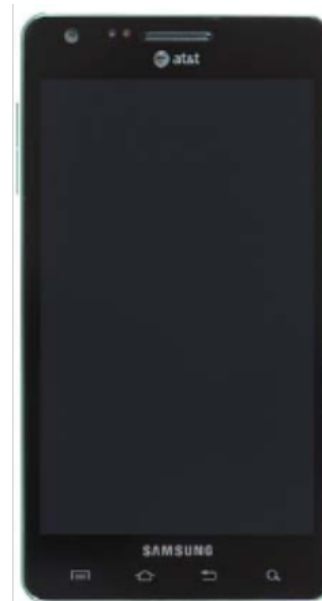
4 - NO

Black Front Face '677 Design Patent

Apple '677 Design Patent



Samsung Models



Samsung
Models
13 - Yes
1 - No

Apple's Screen Design Patent

'305 Design Patent



Accused Samsung GUI



Samsung
Models
14 – Yes
0 - No

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.

Two Accused Phones (Burrell)

Plaintiff's Exhibit No. 7.15

Galaxy Ace



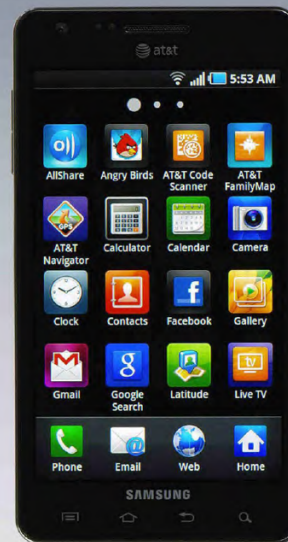
Case: 14-1335 Document: 139-5 Page: 478 Filed: 09/15/2014

15

A24705

Plaintiff's Exhibit No. 7.45

Infuse 4G



Case: 14-1335 Document: 139-5 Page: 508 Filed: 09/15/2014

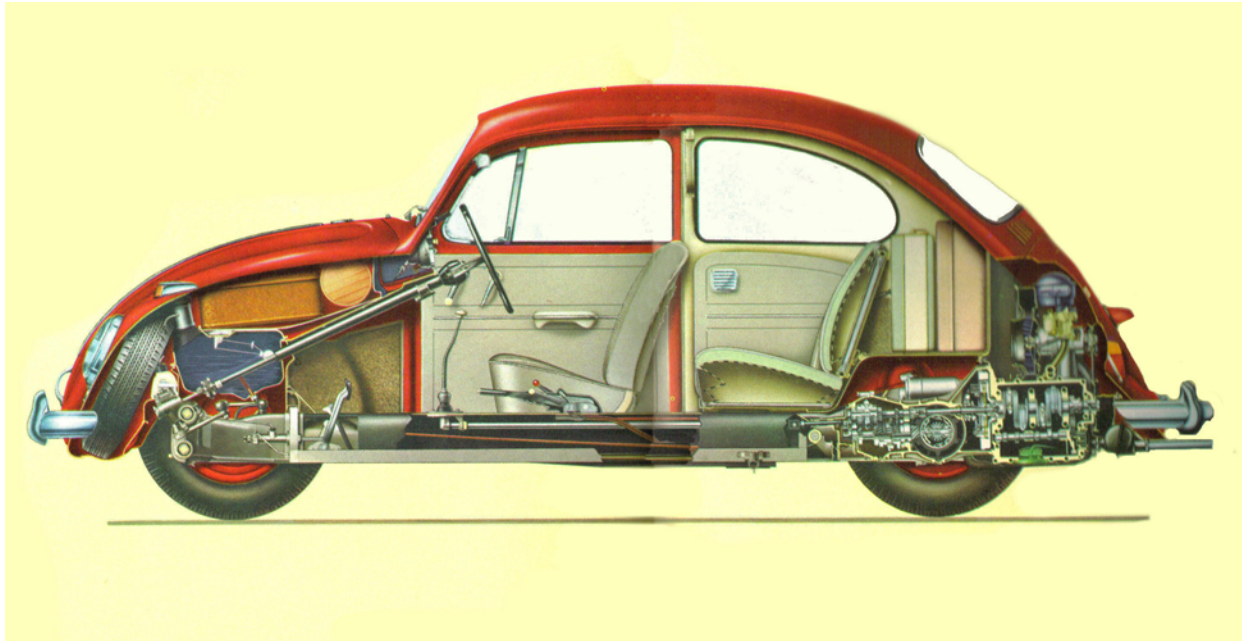
45

A24735

: Design Patent Damages (Myers)



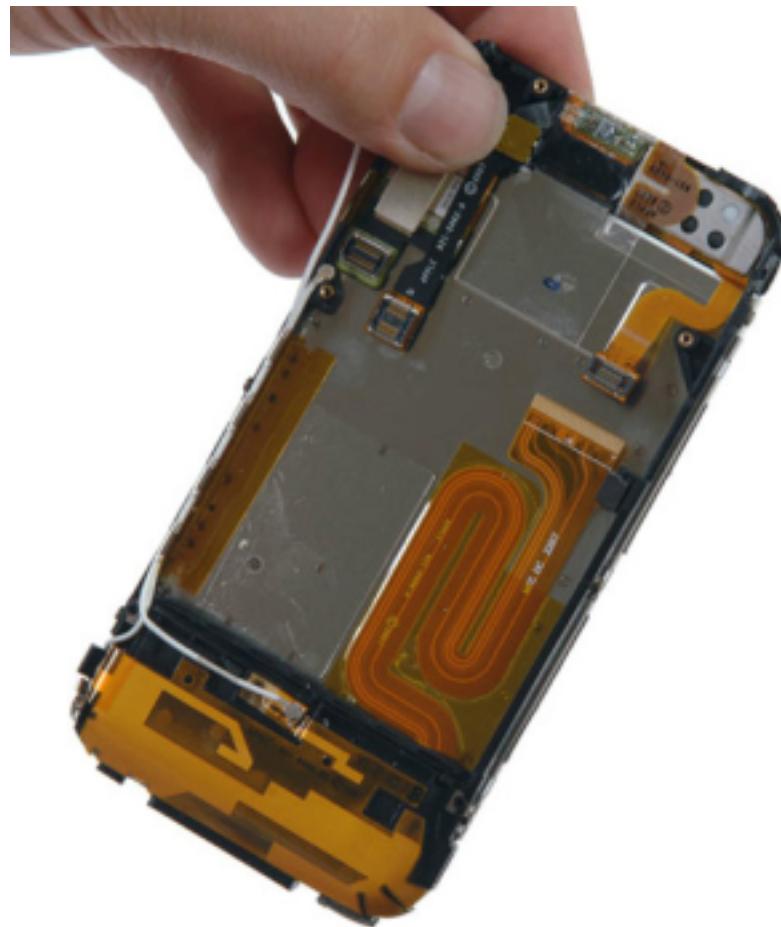
Design Patent Damages



Design Patent Damages



Design Patent Damages



Design Patent Damages

- The text of S.289 is crystal clear ... a design patent infringer is liable to the patent owner “to the extent of” the infringer’s “total profit.”
- Congress had good reason to create the total profit remedy, because design is inextricably bound with overall product value and it is exceptionally difficult to prove the extent to which a design influences a consumer’s decision to buy a product.

Design Patent Damages

- Creating a standard that makes counterfeiting and piracy more likely raises significant economic concerns.
- Increased cost of enforcing design rights will undoubtedly discourage companies from seeking design rights, leading to less incentive for design innovation and greater copying.
- If there are reasons to revisit the policy choice made in S.289, Congress is the place.

U.S. Amicus Brief (Racilla)

Identification of relevant article of manufacture:

- *Objective*: identify the article that most fairly embodies infringer's appropriation of patentee's innovation
- *Relevant factors*:
 - (1) Scope of design patent claim;
 - (2) Prominence of design in product as a whole;
 - (3) Conceptually distinct innovations in product; &
 - (4) Physical relationship of design and product.

U.S. Amicus Brief

The parties' burdens:

- Patentee bears ultimate burden of proving the infringement and the amount of infringer's total profit.
- Infringer bears burden of producing evidence that the relevant article of manufacture is some portion of the entire product as sold.

BRIEF OF AMICI CURIAE 113 DISTINGUISHED INDUSTRIAL DESIGN PROFESSIONALS AND EDUCATORS

Davies

Dieter Rams
Former Head of Design and Executive
Director, BRAUN

Alexander Wang
Creative Director, Chairman & CEO,
Alexander Wang

Del Coates
Former Design Strategy Consultant, Nissan
Motor Co.

Sir Terence Conran
Conran Holdings
Former Provost, Royal College of Art

Nicolas Ghesquiere
Artistic Director, Women Ready To Wear,
Louis Vuitton

Lord Norman Foster
Founder & Chairman, Foster + Partners

Calvin Klein
Founder & Designer, Calvin Klein Studio

Raymond Riley, IDSA
Executive Creative Director, Microsoft



• Apple-side amicus briefs (Janis)

- **6 industry (+2)**

- App Assoc; Bison Designs; Crocs; Nordock; Roger Cleveland Golf; Tiffany (+ BSA; Nike)

- **2 bar orgs**

- AIPLA; Boston

- **1 designers (+1)**

- design professionals/educators (+ IDSA)

- **1 academic**

- ip professors

Apple-side amicus themes

- plain meaning
- deterrence
- troll concerns are unfounded
- design patents are important
 - brand identity; small business; fashion

: IP professors' brief (Apple-side)

1. background principle for interpreting § 289:
design patent system is eclectic
2. text, purpose, history of § 289 are clear
 - “total” profits
 - “any” article of manufacture
3. legislative policy arguments are for the legislature

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.

Beetle (1)



- Design patent directed to the entire car exterior
- What is the article of manufacture? How do you prove?
- If less than entire article as sold, how do you calculate profits?

Land Rover Range Rover Evoque

<http://driving.ca/lexus/auto-news/entertainment/top-10-chinese-rip-off-cars-vs-their-original-designs>



Landwind E32

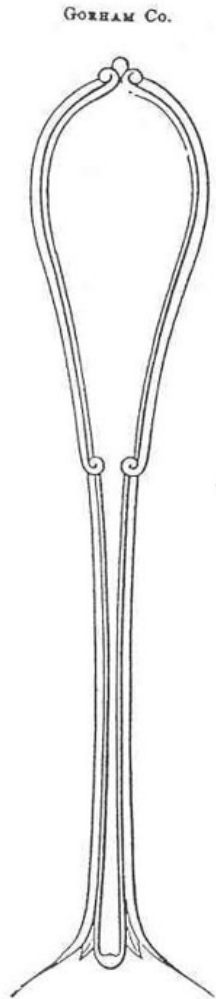
<http://www.autoblog.com/2014/04/29/china-copies-range-rover-evoque-landwind-e32/>



Compare



Gorham Flatware



- Entire flatware is not claimed
- Could cover spoons, forks, etc
- What is the article of manufacture? How do you prove it? What is relevant?
- If less than entire article as sold, how do you calculate profits?

Fendi Bag

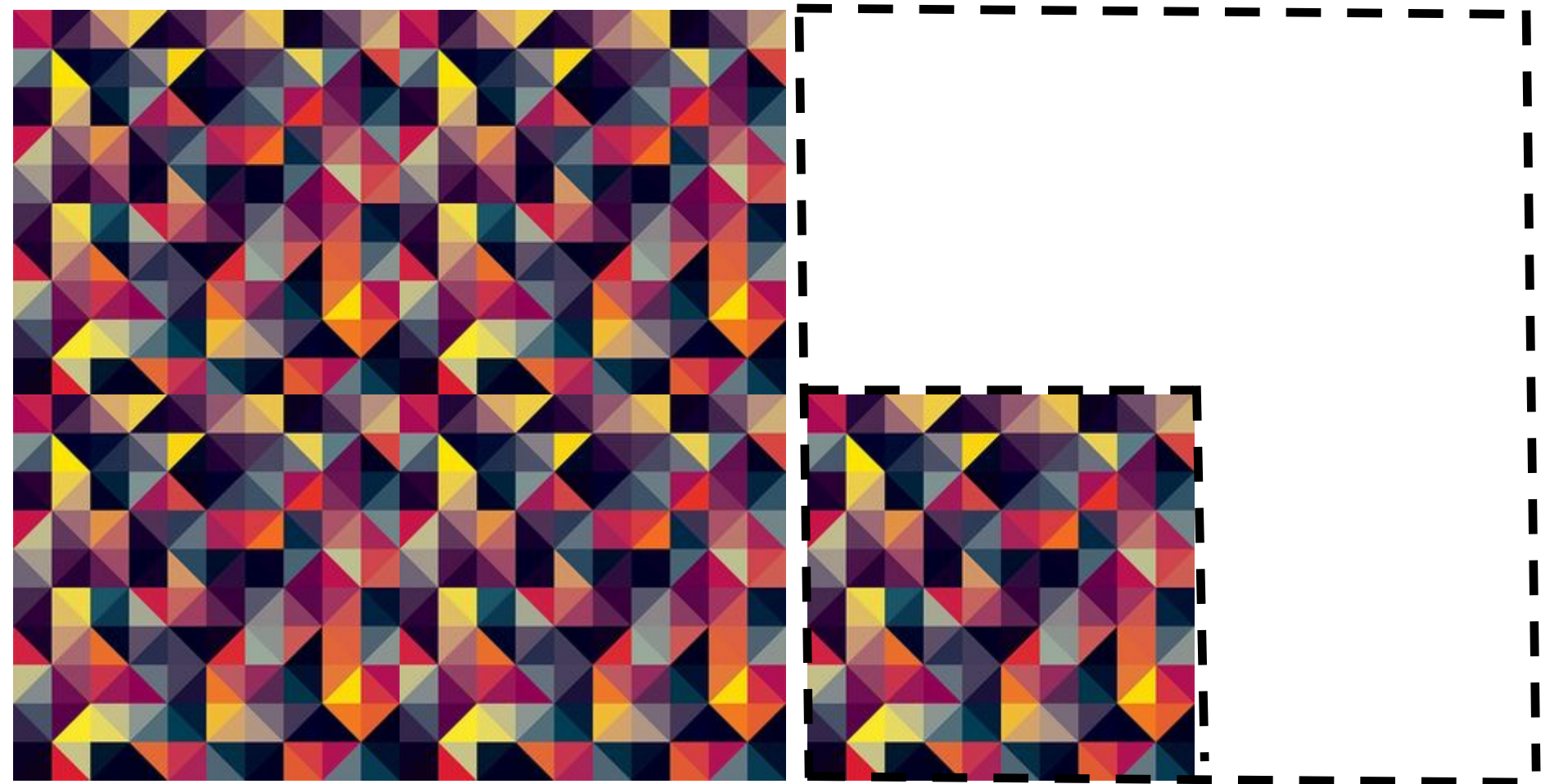


- Patentee Sells for \$38,000
- Accused infringer sells for \$400 with everything but the trademark
- Design Patent claims entire external appearance
- There are internal compartments and zippers
- What is the article of manufacture? How do you prove?
- If less than entire article as sold, how do you calculate profits?

Carpet Design Part 1

Patentee's Carpet As Sold

Design Patent Claim



Carpet Design Part 2

Design Patent Claim

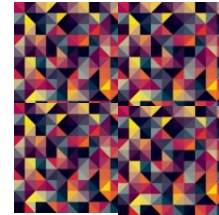


Infringement Variants

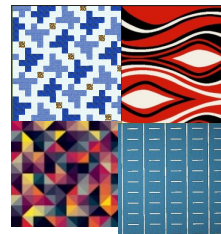
1 – Infringing AofM Exactly Same As Claim



2 – Infringing AofM Exactly Same as Patentee's



3 – Infringing AofM In One Quadrant



Beetle (2)



- Patented design is to a cup holder
- Cup holder replacements units are sold by patentee but not by the infringer
- What is the article of manufacture? How do you prove?
- If less than entire article as sold, how do you calculate profits?
- Might a *de minimis* exception make sense?

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.



Thank You!
Break
Kelly Lounge, First Floor

#designlaw2016



The Current State of the Law under 35 U.S.C. §102, 103 and 112

#designlaw2016



Lunch in Kelly Lounge: First Floor

1:15 p.m. Keynote Presentation

#designlaw2016



International Design Excellence Awards

#designlaw2016