

Design Patent Strategy In View Of Changing Conditions



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Profile Facts - Espresso Maker

- French mid-size company
- R&D staff in France and Australia
- Design made in Australia
- Company makes small domestic appliances
 - Many are retro-style
- Mfr. in France, Czech Republic, and Australia
- Sales to launch in Europe, US, Australia, and NZ
 - Would like to introduce in China

Overview

- What to file
- When to file
- Where to file
- How to file
- *Changing Landscape Situations*

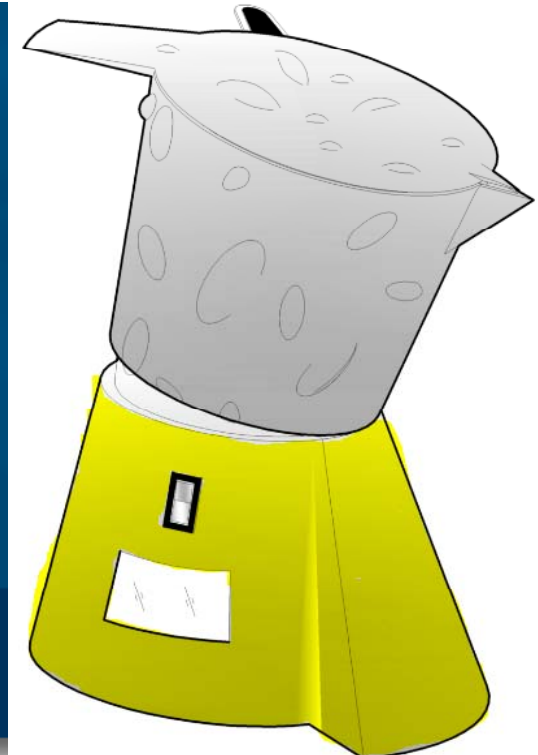
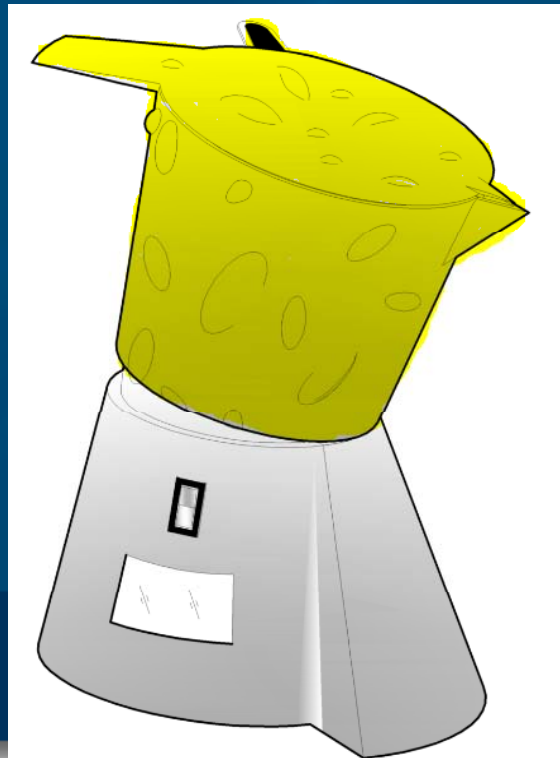
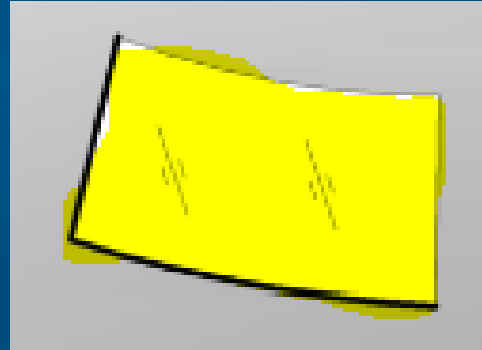
What To File

- Design to overall product
- Designs to relevant portions
 - Know options and be creative
- Use the “*Mad*” test
- Use the “*Serial Killer*” test
- intertwined with budget issues
 - Business decisions



What To File - Design Scopes

- Overall
- Body shape
- Top Portion
 - With & without tilt
 - With & without bubbles
- Base
- Bubbly/Smooth contrast
- Screen designs
- Coffee pod



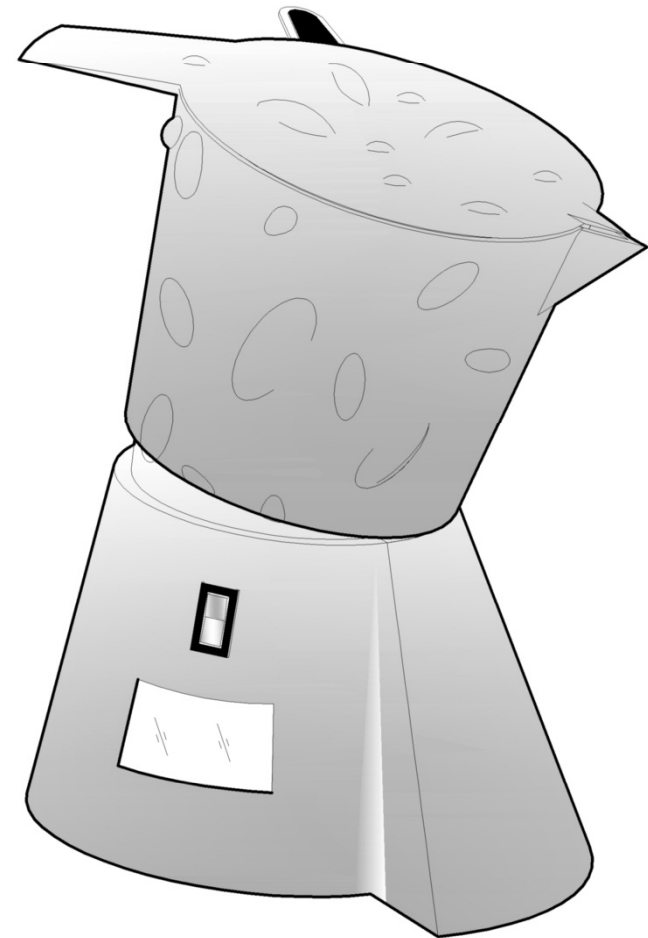
When and Where To File

- WHERE

- Protect your planned markets
 - US, OHIM, AU, NZ
- Where you manufacture (AU, OHIM)
- China (CN)
- Belief in the product
- Bang for the buck
- Use the “Mad Test” again

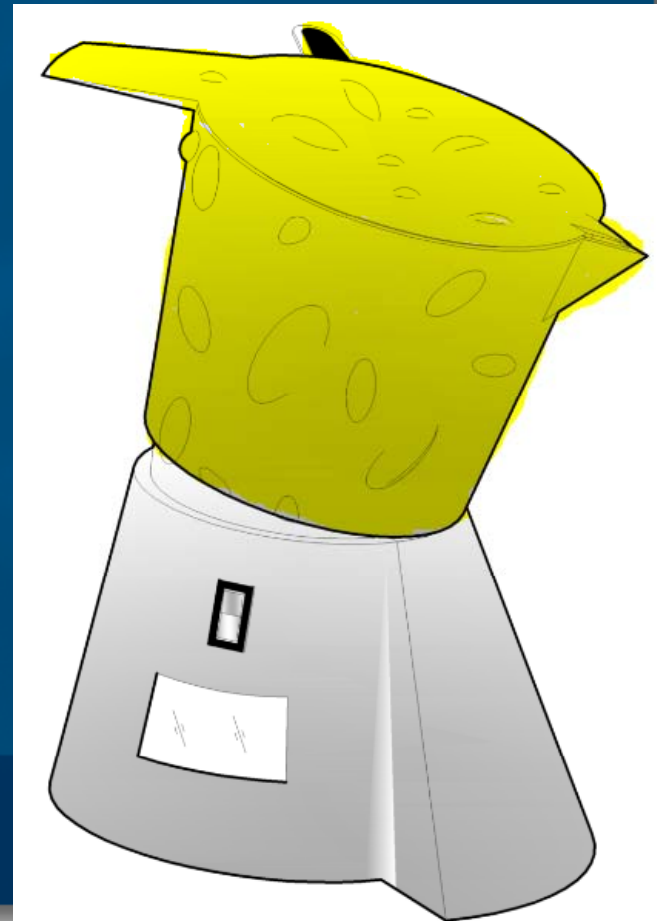
- WHEN

- Design is fixed
- Public disclosure considerations



How To File

- Prepare to minimize objections
- Drawings, drawings, drawings
 - clarity & consistency
 - surface shading where applicable
- Prepare for litigation
 - Prevent attacks
- Have a plan if possible
 - Priority related issues
 - Support related issues



Potential Changing Conditions

- Product Related
- Company Related
- Country System Related
- Competitor Related
- Prior Art Related

Product Related Changing Conditions

- Life of product
- Future models
 - Variant/future models
 - future models
- Marketing materials
 - Functionality-related
 - Focus on product
- Grace period check
- TIP: ask and advise
- TIP: generic scopes



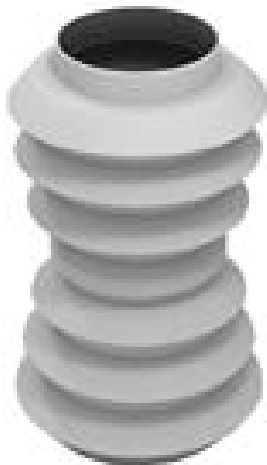
Company Related Changing Conditions

- Where company does business
- Importance of design to business
 - breakthrough product?
- Business partners
 - Do my partners plan to expand?
 - New business partners?
- TIP: ask and advise



Example

- BBC's Dragon's Den
- designer/manufacturer is based in the UK
- bottles can now be purchased in AU and other countries
- Initial search revealed covered in OHIM only



Country System Related Changing Conditions

- Changes in design laws
 - Statutory
 - Case law
- Changes in design practice rules
- Most countries moving towards being more permissive and more flexible
- Examples: (1) Screen designs and (2) Taiwan
- PRACTICE TIPS: be ahead of curve and on top of game

Competitor Related Changing Conditions

- Infringement is found
- Preserve rights in countries where possible
 - Keep case pending and spawn off or amend as needed
- In countries with longer pendency, consider multiple embodiments to evaluate choices
- Supplement filings if within grace period

Prior Art Related Changing Conditions

- Later-located design close in some respects
- Grace period check to supplement rights
- TIP: know the art where possible
- TIP: more claim scopes provide more insurance



Final Thoughts

- Design protection cannot be an afterthought
- Learn and evaluate:
 - details of product,
 - its place in the company,
 - the company's operations, and
 - How infringers work in that industry
- Drawings should be well prepared
- Explain options and impact of business decisions
- Be aware and plan for changing conditions
 - Minimized if negative AND
 - Taken advantage of if possible

Thank You

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