



Session 1: Designs - Recent developments and strategies

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Patent & Trade Mark Attorneys

UK and European Design Law Updates
Chris Cottingham

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Contents

- UK and EU Overview
- UK Updates:
 - GUI practice notes
 - Consultation
 - Case Law
- EU Updates:
 - Phase 1 (in force)
 - Phase 2 (almost in force)
 - Later National Law

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UK and EU Overview

- For Registered Designs, both have:
 - Up to 25 years of protection, on payment of renewals every 5 years.
 - Requirements of novelty and individual character.
 - Multiple design applications where it's cost-effective to file multiple designs in a single multiple design application.
 - No search or substantive examination.
 - Fast registration (days to weeks).
 - 12 month grace period.
 - Functional exclusion (interpreted narrowly)
 - Must-match and must-fit exclusion.

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UK Updates

- GUI/Animated Design Practice Notes - April 2026 DPN 01/26
 - Must be clear that the overall impression would be for a single unitary design.
 - Provides several worked examples of what is and is not possible.
 - A journey to arrive at these.
 - Can use description and written disclaimer to help, even post-filing, but beware later-filed UK priority-claiming designs.
 - Makes clear that all stages of an animated design should be their own representation.
 - Beware risk of re-dating where design modified. Best to ensure design is clear as-filed.

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UK Updates

- UK Design Consultation
 - Closed in November 2025 – still waiting on response from UK Government. Keeps being delayed in view of UK political uncertainty.
 - Main areas:
 - Search and Examination policies and bad faith.
 - Deferred publication.
 - GUI and animated designs.
 - Computer-generated designs.
 - Simplification of unregistered designs (three rights).
 - Criminal sanctions for infringement.
 - Lowering complexity and cost for pursuing registered design right infringement cases before IPEC Small Claims Track.
 - Any changes likely some time away.

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UK Updates

- Case Law
 - One example: Unregistered design.
 - Headlines: UK unregistered designs provide typically 10 years of protection against copying of designs. No registration required, and proprietor can choose which scope(s) to assert.
 - Generally very powerful against close third party designs where copying can be proven.
 - J. MAC SAFETY SYSTEMS LIMITED v Q DECK SAFETY SYSTEMS LIMITED.
 - Earlier product is Macdeck. Later product is Q Deck.

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UK Updates

- Q Deck on left (blue), Macdeck on right (orange)



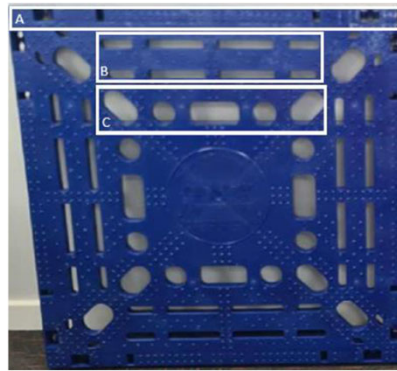
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UK Updates

- Can cherry-pick scope. A found to infringe.



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EU Updates

- Phase 1 – already in force from 1 May 2025
 - (registered) Community design -> (registered) EU Design.
 - Bring in © (“D-in-a-circle”) to give notice of design right protection.
 - Expanded definition of “Product”.
 - “Must match” parts used solely to restore original appearance excluded from protection.
 - Expanded infringing acts to cover downloading CAD files or 3D printing.
 - No unity of class in multiple design applications.
 - Deferred publication. Must actively withdraw to prevent publication.
 - Fees must be paid to secure filing date.

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EU Updates

- Phase 2 – imminent (from 1 July 2026)
 - Seven view limit increased to ten (not unlimited).
 - New formats for representations, including video (MP4) and CAD (OBJ and STL) files.
 - Product indications must use Locarno.
 - Corrections of minor defects.
 - Renewal fee tweaks to timing and significant increase to amounts.
 - Invalidity applications must include reasoned statement and evidence.

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EU Updates

- Later national law
 - Many countries within EU have their own registered and unregistered design laws, and these are different to the EU equivalents.
 - Harmonisation of design laws around EU.
 - Repair clause brought in across EU.
 - Also invalidity proceedings and design registration processes.

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Canadian Industrial Designs

Recent Developments and Strategies

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Canadian Industrial Designs

- Overview
- Advanced Examination
- Care With Divisionals
- Telephone Amendments
- Miscellaneous Updates



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Canadian Industrial Designs: Overview

- **Term:** greater of 15y from filing / 10y from registration
- **Design must be novel:**
 - meaning: not the same and *not substantially similar* to prior art ("originality");
 - from perspective of *informed consumer* (i.e. not side-by-side).
- **Design features not solely dictated by utilitarian function**
- **Single class per application** (classification system based on Locarno)
- **Colour; computer icons; computer animation** are acceptable subject-matter
- **12-month disclosure grace period**
- **Single maintenance fee:** due at 5 years post-registration
- **No unregistered design protection** available in Canada
- **2024-2025:** ~9800 applications filed
- **2024-2025:** average time filing→allowance: 13.6 months
- **2024-2025:** largest filer in Canada is USA at ~4300 apps, then China at ~1500, then Canada at ~900. UK filed ~400

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Canadian Industrial Designs: Advanced Examination

- Available upon request for a fee (currently, \$760 CAD)
- Recommend request on filing
- Reduce initial examination report timing from ~ 10-11 months down to ~ 6-7 months
- Earliest CIPO can conduct prior art search is 6 months after filing, due to possibility of competing applications having earlier priority date
- Recommend: for fastest prior art search possible (i.e. as soon as 6 months after filing), where there is a priority claim ensure verified priority documents in English/French are submitted to CIPO
 - Certified copy of priority document; or
 - WIPO DAS (Digital Access Service) information for priority document.

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Canadian Industrial Designs: Care With Divisionals

- Each application must be limited to a single design
- Divisionals may be filed:
 - Up to 2y from the earliest original Canadian application;
 - Timing exception: can file divisional up to 6mo after the day of an amendment responding to an Examiner's Report that raised a lack of unity rejection;
 - But: can file a divisional only while original application is pending.
- Divisionals can be directed to previously-unclaimed subject-matter
- Important: registrable applications proceed directly to registration without a notice of allowance
- Anecdotal, we are hearing of cases where registration has actually occurred on the exact same day as the filing of a response, leading to questions as to whether a divisional filed simultaneously with the response has been filed while original application is pending
- Recommend: if divisional being contemplated, file response in original application with a request for delay of registration (including fee), and file divisional ASAP.

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Canadian Industrial Designs: Telephone Amendments

- **As of March 12, 2026, a “telephone amendment” practice has been implemented**
- **Can address certain deficiencies verbally**
 - Statement includes extraneous or duplicate information;
 - Obvious typographical errors in Statement;
 - Obvious errors in numbering of figures;
 - Use of registered trademark requiring indication of same.
- **Examiner initiated: Examiner will call or leave message to request specific amendment(s)**
- **Applicant has 5 business days to provide verbal instructions to amend; otherwise, an Examination Report is sent**
- **Most amendments can still only be made in writing. Examples:**
 - Using the term “embodiment” instead of “variant” or “invention” instead of “design”;
 - Issues with the name of the finished article;
 - Inconsistencies in written material, or as between written material and reproductions.

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Canadian Industrial Designs: Miscellaneous Updates

- **As of June 2024: buildings and structures, including those constructed on site, are now considered acceptable “finished articles” for design applications**
- **As of August 2024: Notice of Possible Refusal replaced with Final Examination Report, responses to which are heard by a Subject Matter Expert, and no longer by the Patent Appeal Board**
- **As of November 2025: mere incorporation, into a design, of an 11-point maple leaf (an official Canadian symbol) is no longer sufficient for a design to be regarded as unregistrable as contrary to public morality or order. License from government for use of maple leaf may still be required** 🍁🍁

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Thank you



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FICPI – ABC – Design Law Update 2026

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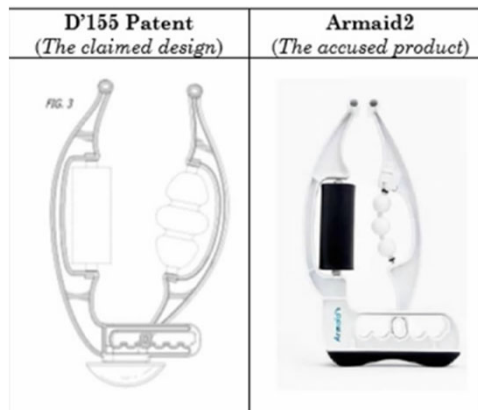
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Design Patent Updates

1. Range of Motion
2. USPTO GUI Guidelines

Range of Motion Products v. Armaid Company

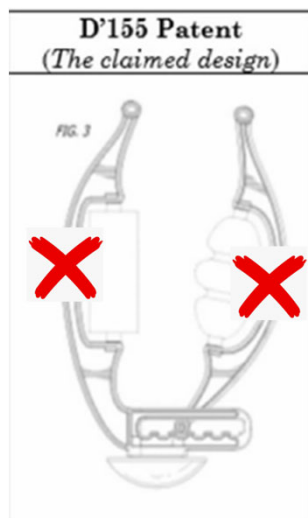
Range of Motion Products LLC v. Armaid Company Inc., Case: 23-2427 (Fed. Cir. 2026)



- Upheld a claim interpretation that improperly dissected a design and excised features based on functionality (and used a wrong test to get there) &
- Affirmed summary judgment of non-infringement. Applied the ordinary observer test in a manner that focused on whether differences could be spotted rather than whether they were substantially similar to an ordinary observer
- Amicus Brief filed to support rehearing/rehearing *en banc* by
 - IDSA*
 - AIPLA
 - Institute for Design Science and Public Policy
 - Oake Law Office
 - Perry Saidman

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Range of Motion Products v. Armaid Company – Claim Construction



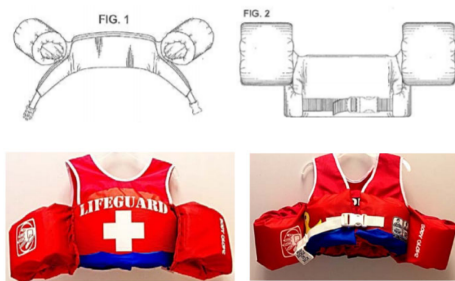
- District Court performed a functional vs. ornamental analysis
- Evident that many, but not all, of the design features in the D'155 patent—which the Rolflex embodied—are driven by function
- It excluded left and right arm bands side torso tapering as functional and not ornamental
- Approached it from a trademark angle re definitions
- On appeal, CAFC approved and noted that a functional vs. ornamental analysis should be done to enable the fact finder to factor out the functional aspects of the design” when applying the ordinary observer test (citing *Richardson*)
- But the CAFC forgot it put Richardson to bed with Sport Dimension and Ethicon

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SPORT DIMENSION, INC. v. THE COLEMAN COMPANY, INC. 942 F.3d 1119 (Fed. Cir. 2019)

US Design Pat. D623,714
"Personal Flotation Device"



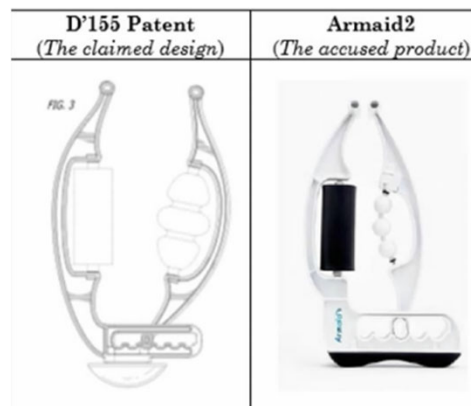
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- On Claim construction, the District Court excluded left and right arm bands side torso tapering as functional and not ornamental
- ***In no case did we entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose***
- The Fed. Cir. rebuked the mistake often made by lower courts that just because an element performs a function, it is impermissibly "functional" within the meaning of the law and should be disregarded.

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Range of Motion Products v. Armaid Company - Infringement

- ***District Court***
- **The D'155 patent and the Armaid2 share a "broad design concept" and "at a conceptual level they look quite similar.**
- **But most of the similarities are likenesses of functional features. These functional features are not protected by the D'155 patent and, therefore, do not bear on the ordinary-observer test.**
- **Looking at the overall visual impression created by the D'155 patent and the Armaid2, I conclude that they are not substantially similar, and are, in fact, plainly dissimilar.**

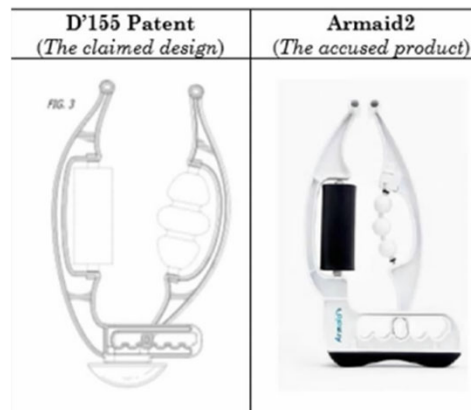


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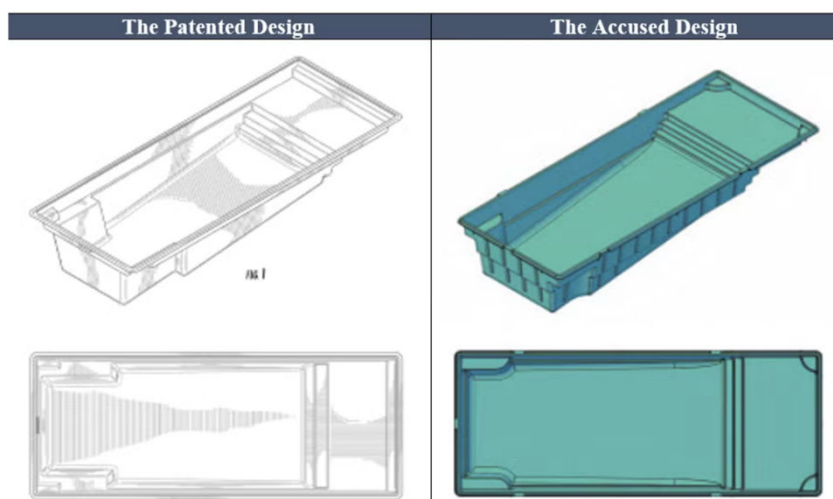
Range of Motion Products v. Armaid Company - Infringement

- Federal Circuit affirmed
- Because we agree that the district court did not reversibly err in reaching its plainly dissimilar conclusion, it did not need to reach the three-way comparison step of the infringement analysis.
- Nonetheless, even if it needed to reach the three-way comparison step, we agree with the district court that a comparison of the D'155 patent and the Armaid2 designs with the Armaid1 design in the prior art further supports the conclusion that no reasonable jury could find that the designs at issue are substantially similar.



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North Star Technology v. Latham Pool Products (Fed. Cir. 2025)



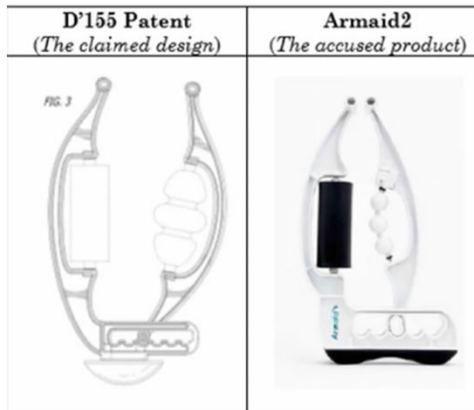
armed. Huh?



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Range of Motion Products LLC v. Armaid Company Inc., Case: 23-2427 (Fed. Cir. 2026)



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- *Moore Dissent*
- **There's a problem: a real-world difference between the paradigm shift from "substantially similar" to "plainly dissimilar/sufficiently distinct."** The former causes the fact finder to focus on the similarity of the overall designs whereas the latter forces the fact finder to focus on the differences
- It is hard to imagine, looking at the two overall designs, that no reasonable purchaser of handheld massagers could ever find that the overall designs were substantially similar.
- I think we ought to correct our error in *Egyptian Goddess* and reaffirm that the substantially similar test, announced by the Supreme Court in *Gorham*, is "the sole test."

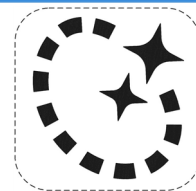
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New USPTO GUI Guidelines

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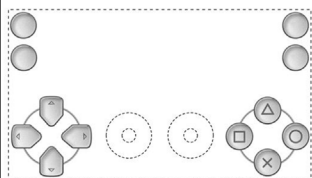
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Former USPTO Guidelines



Limited Applicant's ability to flexibly claim

- Had to show on a display screen AND
- Something (1) with a Something (2)
 - **Display screen**
 - **Display panel**
 - **Computer screen**
 - **(or portion thereof)**
- **Icon**
- **Graphical User Interface**
- **integral and active component in the operation of a computer**
- **Mere display of a picture on a screen will not be accepted**



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New USPTO Guidelines (March 2026)

- **More flexibility in claiming**
 - Removes the requirement that the drawing show the display screen
 - where both the title and claim properly identify an article of manufacture;
 - Clarifies that a design of a computer-generated interface or icon for a computer, computer display, or computer system is OK
 - more than a mere transient or disembodied picture or three-dimensional image;
 - Clarifies that claim and title language that indicates that an icon or interface is "for" a computer, computer system, or computer display panel is permissible under 35 U.S.C. 171.
- **Modern interfaces expressly recognized**
 - Projected designs, VR, and AR
- **Mere display of a picture on a display screen will still not be accepted**

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New USPTO Guidelines – Acceptable Titles

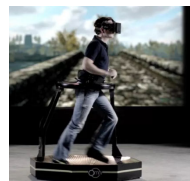
- **Previously Acceptable**
 - computer screen with an icon,
 - display panel with GUI
 - display screen or portion thereof with icon
 - portion of a computer screen with an icon
 - portion of a display panel with an icon
 - portion of a monitor displayed with an icon
- **Now Also Acceptable**
 - icon for display screen
 - GUI for display panel
 - computer icon
 - projected interface for a computer
 - virtual reality interface for a computer
 - augmented reality interface for a computer



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New USPTO Guidelines – New Types

- **Additional types of patent eligible designs in light of continued modernization of technology.**
- **Permitted if:**
 - The appearance of the interface or icon is separate from the computer, computer display, or computer system that generates it, and
 - The interface or icon is more than a transient or disembodied picture or 3D image.
- **Emerging designs types**
 - Virtual Reality
 - Augmented Reality
 - Projected designs



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Parting Thoughts

- **USPTO New Guidelines are an excellent step**
 - More flexibility in claiming approaches
 - More flexibility in disclosure approaches
 - Expressly permits some new emerging interface designs
- **Still need to properly analyze the interfaces**
- **Still need to diligently follow formal and informal USPTO practices**
- **Include extra details in application when in doubt**



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Questions?



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