
2021 Design Patents Year in Review

ANALYSIS AND TRENDS

An Introduction from the Editor

This year, we will mark the 10-year anniversary of the first jury verdict in the landmark IP litigation between Apple and Samsung, which resulted in the jury awarding more than \$1B to Apple. More than \$500M of that award was attributed to a finding that Samsung infringed three of Apple's design patents for the iPhone® smartphone. Since that time, interest in design patent protection has continued to grow by all measures. As interest has grown, so have the number of filings for design rights globally and so have developments in the law both through court decisions and legislation.

Once considered the intellectual property option you were left with if you were unable to obtain utility patent protection, more and more companies are seeking design patent protection in addition to, and in some cases in lieu of, utility patents. And why not? They can be less costly and time consuming to obtain and to litigate than utility patents. They can also be easier for a court, and in particular, a jury to understand. If infringement is found, the patent holder can be awarded the total profit made by the infringer from the sale of the infringing article — a remedy not available for utility patent infringement. It is no surprise then that design patents are being used more frequently to protect designs for just about anything, from breakfast pastry to running shoes.

In this inaugural issue of "The Year in Review," we will highlight some of the important legal decisions in 2021 involving design patents at the US Court of Appeals for the Federal Circuit, the US International Trade Commission, US District Courts and the US Patent and Trademark Office Patent Trial and Appeal Board. We will also provide an update on some of the recent legislative changes that are taking place globally with respect to design protection and enforcement.

The information provided in this review is the result of a collaborative process. Thank you to co-authors—Daniel Gajewski, Deirdre Wells, and Ivy Estoesta, as well as Patrick Murray who contributed important data and statistics for this review.

We appreciate your interest in this report, and we encourage you to see our firm's other recently released publications "2021 PTAB Year in Review: Analysis & Trends" and "Federal Circuit Appeals from the PTAB and ITC: Summaries of Key 2021 Decisions," which are available at sternekessler.com or by request. Please reach out to us if you have questions about this report, wish to discuss the future of design protection, and/or if you would like hard copies of any of our 2021 "year in review" reports.



Tracy-Gene G. Durkin
Chair, Mechanical & Design Practice Group

Table of Contents

Editor and Author Biographies 1

Patent Trial and Appeal Board: Design Patents Continue to Escape Challenges 2

US District Courts: No Slowdown in Filings 3

US Court of Appeals for the Federal Circuit: Seismic Shifts in §102 and §103 7

US International Trade Commission: Design Patents Outperform on Obtaining GEOs 10

International Design Law Continues to Evolve 11

Editor and Author Biographies

Editor



Tracy-Gene G. Durkin is the practice leader of Sterne Kessler’s Mechanical & Design Practice Group and a member of the Trademark & Brand Protection Practice, and she has a well-earned reputation for excellence in design patent law. With more than thirty years of experience obtaining and enforcing intellectual property rights, Tracy is sought out by leading consumer product companies, and by colleagues around the world for her deep understanding of utility and design patents, trademarks, and copyrights. She is known for crafting and delivering unique IP protection strategies, designed to meet clients’ needs. Currently, Tracy serves as the Vice Chair of both the U.S. Patent and Trademark Office’s Public Patent Advisory Committee and the International Trademark Association’s Designs Committee.

Authors



Deirdre M. Wells is a director in Sterne Kessler’s Trial & Appellate Practice Group. She focuses her practice on litigation before federal district courts, the U.S. International Trade Commission, and the U.S. Court of Appeals for the Federal Circuit. She has represented clients in a variety of fields, including consumer products, food and beverage manufacturing equipment, pharmaceuticals, medical devices, data storage devices, internet search technology, wireless broadband technology, electrical connectors, telephone systems, and radio frequency identification technology. Deirdre has represented clients in patent, trademark, trade dress, and false advertising litigation, litigated post-grant review proceedings before the United States Patent Trial and Appeal Board, and formulated inter partes reexamination requests. Deirdre also has experience analyzing intellectual property portfolios and assignments



Daniel A. Gajewski is a director in Sterne Kessler’s Mechanical & Design Practice Group. With over 10 years of experience helping clients achieve strategic utility and design patent protection and navigate the IP landscape for their products, he specializes in developing a full product-based patent protection strategy, including working with inventors to zero in on a new product’s innovative features, whether they be structural, aesthetic, or both. Dan also specializes in protecting mechanical technologies and product designs with work spanning a variety of technologies, including a particular focus on consumer products, packaging, and retail. Dan is currently Vice Chair of the Intellectual Property Owners Association Industrial Design committee.



Ivy Clarice Estoesta is a director in Sterne Kessler’s Mechanical & Design Practice Group and Trademark & Brand Protection Practice. She counsels a wide variety of clients on the strategic procurement and enforcement of IP rights in the U.S. and globally, with a focus on design patents, trademarks, and copyrights. Ivy has niche expertise in U.S. and foreign design rights related to graphical user interface (GUI), augmented reality (AR), and virtual reality (VR) designs, and is the firm’s go-to resource for copyright matters, particularly for visual works, including digital art/NFTs. Ivy currently serves on the International Trademark Association Designs Committee and the Complementary Forms of Design Protection Subcommittee of the American Intellectual Property Law Association Industrial Designs Committee.

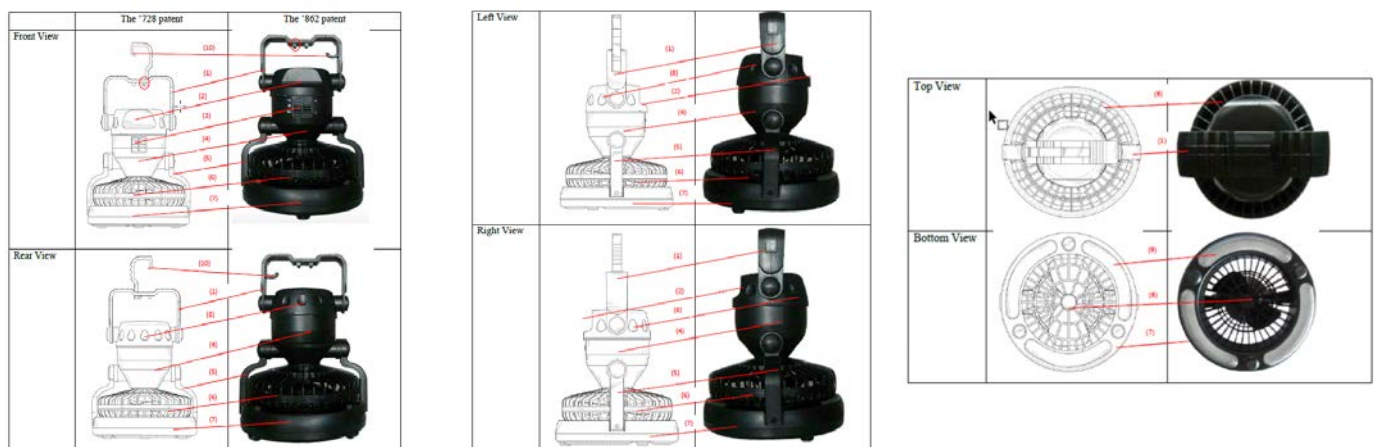
Patent Trial and Appeal Board: Design Patents Continue to Escape Challenges

BY IVY CLARICE ESTOESTA

Continuing the trend that we analyzed in May 2020, petitions to the US Patent and Trademark Office Patent Trial and Appeals Board (PTAB) requesting *inter partes* review or post-grant review for design patents maintained an institution rate well below 50% in 2020. Specifically, the design patent institution rate reached only 27%. This is based on a total of 18 institution decisions (5 granted, 13 denied), each involving grounds of prior art.

In 2021, the design patent institution rate reached 50%. This may be attributed to the relatively few—only two—PTAB decisions involving design patents issued in 2021: *Cellpak Inc. v. Mambate USA Inc.* and *Sattler Tech Corporation v. Lyu*. In *Cellpak*, institution was granted in part on grounds of anticipation. IPR2021-00007, Paper 7 (PTAB Apr. 21, 2021). Based on the evidentiary record, which notably did not include a Patentee’s Preliminary Response, the PTAB determined that there is a “substantial similarity in the overall appearance” of challenged patent D846,728 S ('728) and the asserted prior art, Chinese Design Patent No. CN 302112862 S ('862). *Id.* at 10. Comparisons of the two designs are shown below.

As a whole, however, the institution rate for petitions filed against design patents is well below 50%—specifically, 38%. This is based on a total of 66 institution decisions (25 granted, 41 denied). While the design patent institution rate reflects that it is often difficult for petitioners to present a sufficient case that the challenged design patent is unpatentable based on prior art, petitioners that succeeded in getting *inter partes* review or post-grant review instituted are successful in invalidating the challenged design patent in 64% of the cases. Of the 25 instituted cases, 16 found the challenged patent to be unpatentable based on prior art. A more detailed analysis of those cases show that in more than half, grounds based on anticipation were successfully asserted. Specifically, of the 16 patents invalidated, 7 were invalidated on grounds based on anticipation.



US District Courts: No Slowdown in Filings

BY DEIRDRE M. WELLS

Since 2010—with the exception of outlier year 2016 (with 310 new filings!)—the number of cases filed annually in US district courts asserting US design patents has remained fairly steady: between 236 (in 2019) and 293 (in 2017). A range of only 57 cases separates the busiest and slowest filing years. 2021 was no different with 254 new design patent cases filed.

In terms of decisions, 2021 saw over 70 US district court decisions, across a wide range of venues, involving US design patents. We summarize below two of the most noteworthy decisions – *Junker v. Medical Components, Inc.* and *Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd.*

The decision in *Junker* followed a bench trial, and the decision in *Golden Eye* followed summary judgment briefing. Each of these decisions are currently on appeal at the US Court of Appeals for the Federal Circuit. We expect both appellate decisions to be contenders for our firm's Federal Circuit review report next year. Predicting what will happen on appeal can be difficult, but we would not be surprised if at least aspects of the decisions are reversed or remanded. As noted below, the functionality part of the *Golden Eye* decision seems particularly vulnerable to remand. These are certainly cases to watch to see whether the Federal Circuit affirms, reverses, or remands.

In addition to the *Junker* and *Golden Eye* decisions, other 2021 district court decisions of note include:

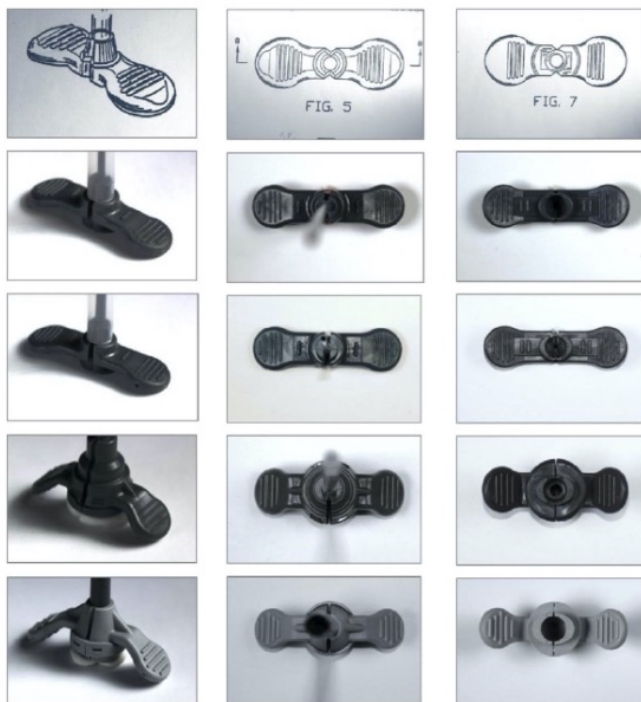
- *Volkswagen Group of America, Inc. v. Andy Varona*, No. 19-24838-CIV-GOODMAN (S.D. Fl. Jan. 25, 2021 and May 18, 2021): Granting Volkswagen's motion for summary judgment that Andy Varona's wheel sets infringed Volkswagen's design patent D721,028 and, following a bench trial on damages, awarding Volkswagen damages under 35 U.S.C. § 285 and § 289 for Andy Varona's full profits, as well as Volkswagen's reasonable attorneys' fees and costs for willful infringement.
- *Delta T, LLC v. Dan's Fan City, Inc., et. al.*, No. 8:19-cv-1731-VMC-SPF (M.D. Fl. May 10, 2021): Magistrate judge recommended (1) granting Dan's Fan City, Inc.'s motion for summary judgment as to non-infringement for one of Delta T's design patents (D614,757); (2) granting Dan's Fan City's motion for summary judgment as to willful infringement of the same patent; (3) denying both parties' remaining summary judgment motions as to Delta T's two other design patents (D770,027 and D808,004).
- *Raffel Systems, LLC v. Man Wah Holdings Ltd, Inc.*, No. 18-CV-1765 (E.D. Wis. Nov. 5, 2021): Granting Man Wah's motion for summary judgment that its cup holder products do not infringe Raffel Systems' design patent D643,252.

US District Courts: No Slowdown in Filings

continued

Junker v. Medical Components, Inc., **No. 13-4606 (E.D. Pa. Jan. 14, 2021)**

Junker alleged that four of Medical Components, Inc. and Martech Medical Products, Inc.'s ("Medical Components") products infringe design patent D450,839, which is directed to the handle design of a medical device used to insert a catheter into a patient's vein (referred to as an introducer sheath). Medical Components, in turn, alleged that the patent was both invalid due to incorrect or incomplete inventorship, anticipation, obviousness, and a primarily functional design and unenforceable due to inequitable conduct. The patent had previously been litigated against different defendants and found infringed and not invalid—a decision that was upheld by the Federal Circuit on appeal. The patent was also the subject of a reexamination proceeding at the PTO, which also upheld its validity.



- The top row shows (from left to right) Figures 1, 5, and 7 in the patent.
- The second row shows pictures of the first accused product.
- The third row shows pictures of the second accused product.
- The fourth row shows pictures of the third accused product.
- The fifth and final row shows pictures of the fourth accused product.

Following a bench trial, the district court judge found infringement, that invalidity and inequitable conduct had not been shown, and awarded damages. The court credited Junker's expert over Medical Components' expert, who the court noted had never opined on a design patent before. The court concluded that the ordinary observer would not focus on the differences identified between the patented design and the accused products—including the shape and curvature of the ears as well as the numbers of ribs on the proximal and distal surfaces of the ears—when making a purchasing decision.

Quoting Junker's expert, the court stated that to "the ordinary observer, who is usually a nurse or the supporting staff at a hospital, the minor differences between the Accused Products and the claimed design would 'just not [be] important enough.'" Rather, according to the court, "[a] purchasing agent gathers a bunch of people around to give quotes on things at a sales point, and it goes through the system with nobody ever really looking at it very much to see what it is." The decision reinforces the significance of the identification of the ordinary observer and the time and attention that ordinary observer is likely to give to purchasing decisions.

Golden Eye Media USA, Inc. v. Trolley ***Bags UK Ltd, No. 3:18-cv-02109-*** ***BEN-LL (S.D. Cal. Mar. 12, 2021)***

Golden Eye Media USA, Inc. brought a declaratory judgment action that it did not infringe Trolley Bags UK Ltd. and Berghoff International, Inc.'s ("Trolley Bags") design patent D779,828 and that the patent is invalid, along with other non-patent claims. Golden Eye then moved for summary judgment arguing, in regards to the patent claims, that there was no infringement because its product design is plainly dissimilar from the patented design and that the patent is invalid as functional, obvious, and indefinite.

US District Courts: No Slowdown in Filings

continued

The Court granted Golden Eye's motion for summary judgment concluding (1) the patent is invalid as (a) functional and (b) obvious (although denying the motion as to indefiniteness) and (2) even if the patent is valid, Golden Eye did not infringe. Figures 1 and 4 of the patent, showing the claimed design, are reproduced below for reference.

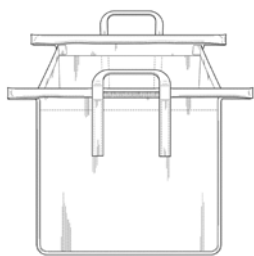


FIG 1

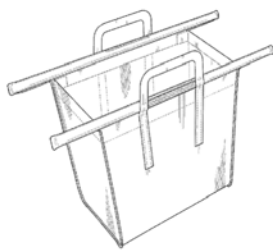
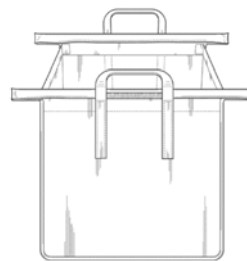


FIG 4

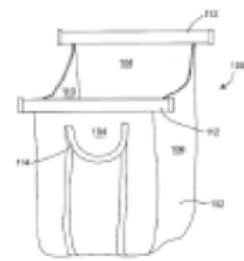
Regarding functionality, the court concluded that (1) the patented design represents the best design; (2) alternative designs would adversely affect the utility of the product; (3) there are concomitant utility patents; (4) the patentee's advertisements tout particular features of the design as having specific utility; and (5) the color and logo of the product appear to be the only elements in the design or overall appearance clearly not dictated by function. The court stated that these factors weigh in favor of a conclusion that the patentee's product is dictated by function, concluding that the size, handles, poles, and mesh in particular "all appear to serve primarily functional rather than ornamental purposes."

Regarding obviousness, the court found that the Doyle prior art reference "creates basically the same visual impression" as the patent such that the Doyle prior art reference qualifies as a primary reference.

The court noted that the Doyle prior art reference is a patent that, like the patent at issue, is owned by Trolley Bags, but said neither party addressed this issue in the summary judgment briefing. Figure 1 from the Doyle prior art reference is reproduced below on the right beside Figure 1 of the patent. The Court found that a designer of ordinary skill in the art would have thought to combine the numerous prior art that highly resembles the patent to create the product claimed in the patent and, therefore, that the patent is invalid as obvious.



Patent FIG 1

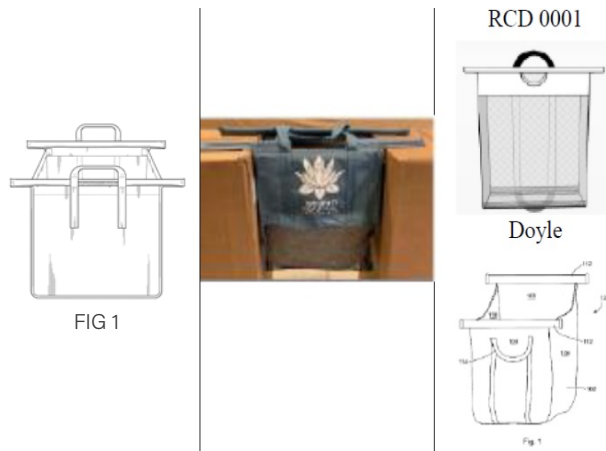


Doyle FIG 1

Finally, regarding infringement, the court stated that while, in the absence of prior art, the patented design and Golden Eye's product appear substantially similar, after considering the prior art, summary judgment of non-infringement is warranted. The court concluded that the features that distinguish Golden Eye's product from the patent—including a mesh translucent feature, an additional carrying handle, and detailed handle stitching extending down the vertical length of the bag—are present in the prior art (in particular the Doyle prior art reference and a second reference referred to as RCD 0001). Side-by-side images of Figure 1 from the patent (on the left), Golden Eye's product (in the center), and the prior art (on the right) are reproduced below for reference.

US District Courts: No Slowdown in Filings

continued



Additionally the court found that any features Golden Eye copied from the patentee's design were functional and not protectable.

As noted above, predicting what will happen on appeal can be difficult, but we would not be surprised if at least the functionality part of the decision is remanded on appeal, because the Court's analysis appears to conflate the article itself *having* a function (which is permissible, and is in fact a prerequisite of design patentability) with its overall design being *dictated* by the article's function. This appears to be out of step with Federal Circuit case law, such as *High Point Design LLC v. Buyers Direct, Inc.*, 730 F. 3d 1301 (Fed. Cir. 2013).

“The group of patent lawyers at Sterne Kessler is wonderfully cohesive: members support and learn from each other, so their advice contains the distilled essence of the firm’s incredible institutional knowledge. This encompasses all technical and scientific disciplines and everything you could possibly do with a patent – from filing to licensing and enforcing or defending it in court.”

- Intellectual Asset Management “IAM Patent 1000 2021”

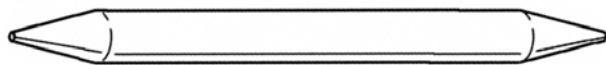
US Court of Appeals for the Federal Circuit: Seismic Shifts in §102 and §103

BY DEIRDRE M. WELLS

In 2021, the US Court of Appeals for the Federal Circuit issued four opinions regarding US design patents—two precedential opinions and two unprecedential opinions. Both precedential opinions, *In re SurgiSil* and *Campbell Soup Company v. Gamon Plus, Inc.*, involved appeals that originated from the U.S. Patent and Trademark Office Patent Trial and Appeal Board (PTAB). Both resulted in the Federal Circuit reversing the appeals with precedential opinions.

In re SurgiSil

SurgiSil filed for a design patent on the ornamental design for a lip implant. The sole figure in SurgiSil's application is shown in the top image below. The patent examiner rejected the patent application under 35 U.S.C. § 102 over the Blick prior art catalog (shown in the bottom of the illustration below) that discloses a similarly shaped art tool for smoothing and blending large areas of pastel or charcoal.



SurgiSil appealed the rejection to the PTAB, who affirmed the examiner's rejection. The PTAB found that the differences in shape between the claimed design and Blick are minor. The PTAB rejected SurgiSil's argument that Blick could not anticipate because it disclosed a "very different" article of manufacture than the claimed lip implant. The PTAB stated that for the purposes of determining the scope of the claim, "it is appropriate to ignore the identification of the article of manufacture in the claim language."

SurgiSil appealed the PTAB's affirmance to the Federal Circuit, which reversed. The Federal Circuit held that the PTAB's predicate decision that the article of manufacture identified in the claim is not limiting was an erroneous legal conclusion. The Federal Circuit stated that, "[a] design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract."

Thus, the Federal Circuit reversed the PTAB's finding that Blick, which the parties did not dispute discloses an art tool rather than a lip implant. anticipates a claim directed to a lip implant.

As a result of this decision, design patent applicants would be well served to carefully consider the title of their design. While a narrow title may avoid prior art, a more focused title may avoid an otherwise infringing design falling outside the scope of the patent.

Campbell Soup Company v. Gamon Plus, Inc.

Campbell Soup petitioned for *inter partes* review (IPR) of Gamon's design patents D612,646 and D621,645 for gravity feed dispenser displays. The PTAB instituted the IPR and determined that Campbell Soup did not establish unpatentability because it had not set forth a proper primary reference. Campbell Soup appealed, and the Federal Circuit vacated and remanded the case to the PTAB. On remand, the PTAB again determined that Campbell Soup did not establish unpatentability. The PTAB found that the prior art has the same overall visual appearance as the claimed designs, but that it is outweighed by objective indicia of nonobviousness. In particular, the PTAB credited the commercial success, praise, and copying of the claimed commercial embodiment. The PTAB found both a presumption of nexus and a nexus-in-fact between the claimed designs and the patentee's evidence of commercial success and praise.

US Court of Appeals for the Federal Circuit: Seismic Shifts in §102 and §103

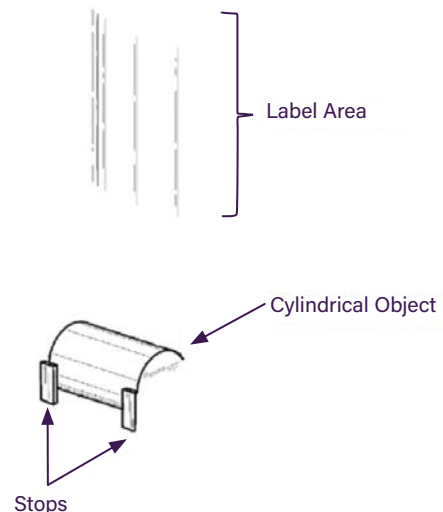
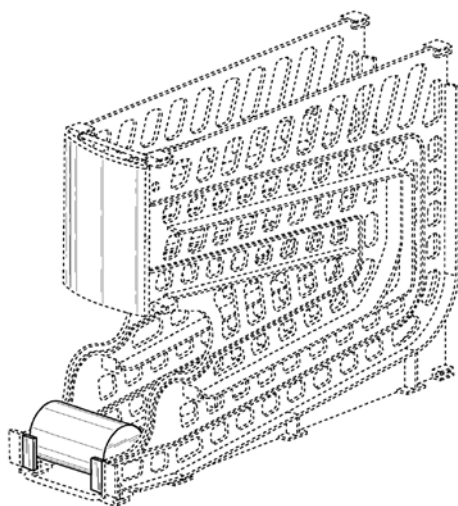
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Campbell Soup appealed the final written decision to the Federal Circuit, which reversed. The Federal Circuit found that substantial evidence did not support either the PTAB's presumption of nexus or the PTAB's finding of nexus.

Regarding a presumption of nexus, the Federal Circuit explained that the presumption only applies if the product alleged to be a commercial embodiment of the claims is coextensive with the claimed invention. The Federal Circuit stated that the coextensive analysis is not limited to whether unclaimed features are *ornamentally* insignificant but considers whether there are *functionally* significant unclaimed product features (even if they are not ornamentally significant). Here, given the limited aspects of the products covered by the design patent claims, the Federal Circuit found that the commercial product includes significant unclaimed functional elements. In such cases, the presumption does not apply. Thus, the Federal Circuit held that substantial evidence did not support the PTAB's presumption of nexus. Presented on the left below is the sole figure of D612,646. On the right is an annotated image removing the unclaimed aspects and leaving only the claimed design.

Turning next to nexus-in-fact, the Federal Circuit stated that absent a presumption of nexus, nexus can also be shown if the objective indicia are the direct result of unique characteristics of the claimed invention (rather than a feature that was known in the prior art). The Federal Circuit stated that the PTAB only found four features that distinguished the claimed designs from the prior art. The Federal Circuit held that, in order to establish nexus, the patentee would have needed to present evidence that the objective indicia derived from those four "unique characteristics." The Federal Circuit found that the patentee failed to do so, presenting instead evidence linking the objective indicia to aspects of the commercial product that were already present in the prior art. Thus, as with the presumption, the Federal Circuit held that substantial evidence did not support the PTAB's finding of nexus-in-fact.

This decision highlights that reliance on objective indicia of nonobvious can be especially challenging for design patents that claim only a small portion of a product. The less that is claimed, the more limited the opportunity may be to show a nexus to the unique characteristics of the claims. Design owners that may rely on objective indicia should take care that the claimed aspects of a product's design are those that contribute to the objective indicia for which they have strong evidence.



Looking further ahead in 2022, there are approximately a dozen appeals pending at the Federal Circuit involving US design patents. Two particular cases to watch are: *Junker v. Medical Components, Inc.* out of the Eastern District of Pennsylvania (2:13-cv-4606) and *Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd* out of the Southern District of California (3:18-cv-2109). We explore the issues to be addressed in those cases in our US District Courts: No Slowdown in Filings on page 3.

We are also watching the appeal of *Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.* (SDCA 3:17-cv-1781), a case familiar to the Federal Circuit. For a review of the prior appeal, you can review a summary of the case at sterneckessler.com by entering the following text into the search box: "IP Hot Topic: Does Adding a Logo to a Copycat Product Qualify as a Successful Design Around?"

Appeals Involving Design Patents Pending at the US Court of Appeals for the Federal Circuit

| Originating Case Number | Case Caption |
|-------------------------|--|
| EDPA-2-13-cv-04606 | Junker v. Medical Components, Inc. |
| SDNY-1-21-cv-02169 | Sure Fit Home Products, LLC v. Maytex Mills, Inc |
| SDCA-3-18-cv-02109 | Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd |
| SDOH-1-12-cv-00501 | Red Carpet Studios v. Midwest Trading Group, Inc. |
| SDCA-3-17-cv-01781 | Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc. |
| WDWI-3-18-cv-00330 | Static Media LLC v. Leader Accessories LLC |
| DNJ-1-13-cv-01758 | Blue Gentian, LLC v. Tristar Products, Inc. |
| NDIL-1-20-cv-04806 | ABC Corporation I v. Partnership and Unincorporated Associations |
| SDNY-1-20-cv-04891 | Hudson Furniture, Inc. v. Mizrahi |
| IPR2020-00534 | LKQ Corporation v. GM Global Technology Operations LLC |
| PGR2020-00055 | LKQ Corporation v. GM Global Technology Operations LLC |
| 29/577,270 | In re: Samuels |
| 90/013,952 | In re: Zahner Design Group, Ltd. |

As of December 31, 2021

US International Trade Commission: Design Patents Outperform on Obtaining GEOs

BY IVY CLARICE ESTOESTA

In May 2020, we reported in an article published by *Law360*, “design patents outperform utility patents when it comes to injunctive relief.” The same is true when it comes to a rare form of injunctive relief—a general exclusion order (GEO)—issued in Section 337 investigations by the US International Trade Commission (ITC).

The ITC may issue injunctive relief in the form of a cease and desist order (CDO), a limited exclusion order (LEO), or a general exclusion order (GEO).

- A CDO prevents a named respondent in an investigation from, for example, continuing to sell infringing products already in the US.
- A LEO bans named respondents in an investigation from importing infringing products into the US.
- A GEO bans the importation of all infringing products into the US, regardless of its source—including ones that were not party to an ITC investigation.

Because of its sweeping scope, a GEO is the least commonly issued of the three, available only where “necessary to prevent circumvention of an exclusion order limited to products of named persons,” or “there

is a pattern of violation ... and it is difficult to identify the source of infringing products.” 19 USC 1337 (d). And because ITC investigations target completion within 16 months of being instituted, a GEO can be a swift, powerful tool in stopping and deterring the importation of infringing products into the US.

Take for example a recently terminated investigation, *Certain Vacuum Insulated Flasks and Components Thereof* (Inv. No. 337-TA-1216). That investigation resulted in a final determination issuing a GEO relating to three design patents for flask caps (US Design Patent Nos. D806,468; D786,012; and D799,320) owned by Hydro Flask Steel Technology, LLC d/b/a Hydro Flask and Helen of Troy Limited, in about 17 months after the investigation’s institution. Another recent investigation, *Certain Electric Shavers and Components and Accessories Thereof* (Inv. No. 337-TA-4230), appears to be heading in the same direction, receiving an initial determination issuing a GEO relating to one utility patent and one design patent (US Patent Nos. 8,726,528 and D672,504) for electric head shavers, only a little over a year after the investigation’s institution.

Section 337 investigations that terminated in 2015 or later

| | No Design Patents | Had Design Patents | Total |
|---------------|-------------------|--------------------|-------|
| No GEO issued | 256 | 14 | 270 |
| GEO issued | 18 | 6 | 24 |
| Total | 274 | 20 | 294 |

A survey of the Section 337 investigations that terminated in 2015 or later show that the rate of getting a GEO issued is more than four times greater for investigations involving design patents than those asserting just utility patents.

Design patent holders considering filing a Section 337 investigation should keep in mind that such investigations, unlike a district court patent litigation, have a “domestic industry” requirement. One aspect of this requirement is that every element of at least one claim in the asserted patent exists in an actual product.

Because design patents may include only one claim, it can be more challenging for design patents to satisfy this requirement. However, in cases where the patentee has protected its commercial embodiment with a design patent, satisfying the domestic industry prong is more likely.

International Design Law Continues to Evolve

BY DANIEL A. GAJEWSKI

Like 2020 before it, 2021 has been a year of change for global design protection. Countries like Korea continue to update their rules to deal with the realities of modern, virtual design. China enacted a big modernization to its design laws, bringing them more in line with international norms. Australia is beginning to implement changes based on a long-running review of its design laws. And the European Union is in the midst of a period of public consultation and review aimed at modernizing the legal framework for its design protection. Meanwhile, the Hague International Design System continues to add contracting parties, and the Eurasian Design System came online.

There is a lot to keep up with in the world of design law. This summary will highlight some of the more significant developments of 2021 and point out some areas to watch in 2022 and beyond.

Korea

Korea continued a trend of countries modernizing to better protect digital image designs like graphical user interfaces, virtual reality, and augmented reality designs. An amendment to Korea's Design Protection Act that went into effect in October 2021 allows these so-called "image" designs to be protected even if they are not displayed on a screen of an item. These image designs must be more than inert images though—an eligible image design must be used for the operation of a device or exhibit a function.

This is a welcome update that recognizes and adapts Korea's law to the realities of current technology and how people increasingly interact with modern design. It brings Korea in line with a growing international consensus that does the same. Korea joins a number of other countries that have recently made similar changes to their design laws to protect image designs independent of a physical article, including Japan, China, and Singapore. The US also appears to be in the early stages of considering similar modernization.

The world is paying close attention to design law in recent years, with countries taking positive action to catch up to each other in the quality and consistency of their design practices. The scope of industrial design is continuing to expand into new areas. The activity in 2021 is a good signal that design law may be able to keep up.

China

A revision to China's patent laws came into force in June 2021, with big changes for its design protection. China now joins the vast majority of countries in allowing partial-design claiming—the practice of claiming only a portion of an entire article, usually by showing the unclaimed portion in broken lines. Not only will this change protect designs for portions of physical devices, but it should also allow digital image designs to be protected independently, no longer tied to a specific device.

Allowing partial-design claiming in China is a long-awaited change, and helped pave the way for China to join the Hague International Design System, since allowing partial-design claiming is a precondition to do so. China's update also extended design patent term from 10 years to 15 years (also a precondition for joining the Hague system). China joined the Hague system on February 5, 2022 (effective May 5, 2022).

The biggest question moving forward in 2022 is *how* China's new law will be implemented. Draft examination guidelines were released in August 2021, and China took comments from the public on them, but so far the guidelines have not been finalized. And it appears that until they are, China is not examining applications that include partial-design claims, leading

International Design Law Continues to Evolve

continued

to some significant delays. Look to 2022 to hopefully get this moving with finalized examination guidelines.

Graphical user interface (GUI) designs may get a further boost in 2022 thanks to a recent decision by the Shanghai IP Court which, for the first time, found infringement of a GUI design based primarily on the software itself, not the mobile device on which it was displayed. Combined with the ability to claim partial designs, this de-coupling of a GUI design from the appearance of its displaying article shows a positive trend for GUI protection in China.

Australia

In September 2021, Australia amended its Designs Act based on a comprehensive review that began in 2012. Starting on March 10, 2022, Australia will have a 12-month grace period to file a design application. Although design grace period provisions and details vary among different jurisdictions, with this change Australia will join the majority of jurisdictions in at least *having* a design grace period. In general this grace period will apply to both authorized and unauthorized disclosures of the claimed design.

The amendment also simplifies the publication and registration process. Designs will no longer publish before registration, and making the request for registration can be deferred for six months after filing. This appears to effectively create a six-month window in which a filed design application can remain confidential, which is a welcome simplification for applicants.

Although IP Australia's public consultation showed strong support from the public for allowing partial designs to be protected (like China just did), the 2021 Design Act does not change the law in this respect. IP Australia plans to continue considering this issue and will take feedback on it via its policy register at any time: <https://www.ipaustralia.gov.au/policy-register/allow-partial-product-registration-designs>.

Hague International Design System

The Hague System continues to grow. It now includes 77 members. Jamaica and Belarus both acceded in 2021, and China in February 2022.

Eurasian Design System

The Eurasian Patent Organization's (EAPO) Eurasian design patent system was implemented in June 2021, after years of planning. Similar to an EU Registered Community Design, an EAPO registration is valid across several member states, which for now includes Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, and Russia.

European Union

The EU is in the midst of a review and update to its rules on design protection. A public consultation period was completed in July 2021. The EU's initiative aims to improve consistency and accessibility, and to modernize its design framework for the digital age. The review also considers whether to scale back design protection for spare parts. European Commission adoption is planned for the second quarter of 2022.

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