

Q&A: IP expert Mauricio Uribe on strategic uses of design patents

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Thomson Reuters interviewed a top intellectual property attorney from IP and technology law firm Knobbe Martens to provide some insight into the growing practice of IP protection through design patents.

On Oct. 18, the U.S. Patent and Trademark Office announced that, “in recognition of the growing importance of design protection amid new and emerging technologies,” it is considering a design patent bar, separate from the utility patent bar that currently applies to those who practice matters before the PTO.

PTO Director Kathi Vidal spearheaded this design patent initiative. And the agency is currently seeking public comments on whether this design patent practitioner bar would benefit the public and what those potential benefits might look like.

The following discussion illuminates the issues that the public might need to know to provide constructive comments and prepare for this new program at the agency.

Thomson Reuters: Generally speaking, how do design patents differ from utility patents? For instance, what are some of the products that can qualify for design patent protection?

Mauricio Uribe: Utility patent protection provides exclusionary rights for implementation of ideas directed to functional aspects/improvements, often based on subject matter related to making something better, faster, cheaper, more efficient, etc. This is the most commonly known and understood of the patent rights. Design patent protection and its associated exclusionary rights can apply to a variety of technologies and implementations, most notably mechanical devices, consumer goods and computer interfaces.

TR: How can a design patent provide protection that differs from the protection that copyright law can provide? Can design patents, for example, protect an NFT in a way that copyright law cannot?

MU: A design patent protects an ornamental design for a useful article of manufacture. A copyright generally protects any original work of authorship that has been fixed in a tangible medium of expression. Copyright law is likely the only intellectual property right for protecting physical works of art, musical compositions, publications, etc. There is some overlap in terms of subject matter that may be protectable under both copyright registrations and design patents, such as some software user interfaces or

ornamental aspects of physical items. For the ornamental aspects of physical items, protection under copyright law may be more limited than design patents based on a two-part test to determine whether a useful article is protectable as with a copyright. The first question is whether the design for which the author seeks copyright protection is a “design of a useful article.” The second question is whether the design of the useful article “incorporates pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the [useful] article.” *Varsity Brands Inc. v. Star Athletica LLC*, 799 F.3d 468, 481 (6th Cir. 2015).

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There are some specific statutes and regulations that attempt to expressly include or exclude subject matter. For examples, U.S. copyright law expressly does not allow for protection typefaces (37 CFR 202.1). Typefaces are protectable subject matter for design patents. In contrast, the Semiconductor Chip Protection Act is administered through the Copyright Office for purposes of protecting the topography of integrated circuits.

Additional differences come in the standard for enforcement (e.g., proving infringement). To prove copyright infringement, the plaintiff must show (1) that the defendant had access to the copyright owner’s work and (2) that the defendant’s work is substantially similar to protected aspects of the protected work. To provide design patent infringement, the plaintiff must prove that an ordinary observer wouldn’t be able to tell the difference between a patented object’s design and an accused object’s design when both designs are side by side. One potential key difference is that access or knowledge of the patented design is not necessary to establish infringement of a design patent.

To date, copyright and trademark law have been the primary sources of intellectual protection mechanisms for NFTs. We are not aware of any specific application of design patent protection to NFTs, although it would not be impossible.

TR: What are some of the ways design patent protection can make a company's patent portfolio more attractive or more productive?

MU: Design patents are best understood as an enforcement tool against counterfeit or knockoff goods provided by entities that are knowingly and intentionally trying to benefit from a protected (or protectable) design (e.g. bad actors). In some industries, enforcement of design patents, via litigation or other enforcement mechanism, against such bad actors may be a high value add to a company's portfolio. Less commonly known or appreciated is the additional value that design patents provide against entities that respect third-party IP and will attempt to avoid infringement or otherwise take active steps to design around a protected design. In this aspect, there is an additional value to the design patent owner, namely, in the business costs incurred by competitors to respect design patent rights.

TR: How do the qualifications of those who practice patent law before the PTO differ from the qualifications that a design patent bar might require?

MU: Under the current U.S. Patent Office rules, an "applicant applying for the examination must demonstrate to the Director of the Office of Enrollment and Discipline (OED) that he or she possesses the scientific and technical training necessary to provide valuable service to patent applicants." Each applicant bears the burden of showing the requisite scientific and technical training through submission of undergraduate and graduate transcripts of sufficient degrees or coursework in a defined set of subjects/degree programs. Any individual that has not completed the eligible coursework (or is otherwise unable to provide proof), is not eligible to sit for the patent bar examination. According to the Patent Office, "[t]he requirement for lab-based core science courses is meant to ensure familiarity with the processes involved in conducting valid experiments, the scientific method, and proper analysis of scientific data." This serves the over-arching goal of the requirements, which are intended "to ensure fairness in the application process while also ensuring that patent practitioners who represent inventors are qualified, understand the technology, and are able to communicate effectively with inventors regarding the technical features of the invention."

Under its current implementation, the patent bar exam covers the laws, rules and procedures dictated by the Manual of Patent Examination Procedure (MPEP) in two sessions covering 50 multiple-choice questions. The questions on the patent bar examination apply to all technology backgrounds and do not expressly test for detailed technical knowledge (although the questions may include some technical descriptions). Accordingly, the technical qualification portion most likely relates to the practice of Patent Law after passing the patent bar examination rather than being able to successfully complete and pass the patent bar examination.

Unlike utility patents, it is not likely that completion of a lab-based core science course curriculum would be required to be represent

and communicate effectively with inventors for design patents. As referenced above, in some circumstances, subject matter protectable under design patent law may also be protectable under copyright law, which does not have any type of bar examination. Specific Patent Office rules and regulations for the preparation and prosecution of design patents is covered under Chapter 21 of the MPEP. However, additional rules and regulations set forth other chapters of the MPEP are also applicable to design patents. Accordingly, it would seem that general knowledge of the MPEP may still remain as a minimal qualification for an applicant.

TR: Why did Director Vidal choose to introduce the concept of a design patent bar at this time? Is this part of some larger initiative? And why have past directors never thought to introduce the idea?

MU: The Patent Office has continuously reviewed and revised the lab-based core science courses that qualify for eligibility for the patent bar examination. Over the past 25 years of my career, the number of degree programs and coursework that qualified for patent bar eligibility has expanded and has allowed for a larger number of potential applicants to sit for the patent bar.

Consideration of a separate design patent bar has been discussed previously and is not necessarily a new concept introduced under the term of Director Vidal. I and others in the IP bar are thankful for Director Vidal's leadership to prioritize and evangelize this initiative since her tenure began in April 2022, and we hope that this program will result in a positive change for the intellectual property community. Additionally, we have also noticed a greater emphasis/change in recent months on calls for tangible actions with regard to diversity, inclusion and equitable programming that increases the likelihood that a separate design patent bar program will be implemented and supported.

TR: What are some of the challenges to getting a design patent bar off the ground?

MU: The biggest key in moving forward with a design patent bar will be the support and commitment of this initiative from the U.S. Patent Office. The Patent Office will ultimately be responsible for the logistics of defining the program, setting forth the examination requirements and executing the examination. Given the likely positive impact on underrepresented affinity groups, the IP community should fully embrace any programming provided by the Patent Office.

TR: Any final predictions of what the IP landscape will look like if a design patent bar does take shape?

MU: I don't envision that implementation of a separate design patent bar or changes to patent bar eligibility will necessarily result in an increased number of design patent filings. However, with an increase in the number of practitioners that may be able to file and prosecute design patents, it will be easier for practitioners or teams of practitioners to integrate design patent protection with other types of protection strategies. More importantly, we will hopefully see a much more diverse and inclusive IP community.

About the author



Mauricio Uribe is the chair of the software/IT and electrical practice groups at **Knobbe Martens**. For 25 years, he has assisted clients in various transactional matters, with a focus on patent prosecution. He has also engaged in numerous licensing strategy and license negotiations for various clients. He also provides counsel on patentability, due diligence and comprehensive intellectual property programs including litigation and complex, global patent and technology licensing. He can be reached at mauricio.uribe@knobbe.com.

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