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THE FUTURE OF DESIGN PATENT LAW

Proposed Legislation

IPO ANNUAL MEETING

Virtually Anywhere

September 21-24, 2020

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Revisions to Design Patent Laws

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OBJECTIVES:

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6. Clarify permissible amendments to drawings.

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9. Define design patent anticipation under 35 U.S.C. 102 to effectively overturn *International Seaway*.

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8. Address issues pertaining to inventorship, the presence of logos on the infringer's product, and willful infringement.

9. Define design patent anticipation under 35 U.S.C. 102 to effectively overturn *International Seaway*.

10. Require consideration of prior art in determining infringement – eliminate "sufficiently distinct" test.

Calendar No. 262

117TH CONGRESS
2ND SESSION

S. 1

[Report No. 117–001]

Making amendments to 35 U.S.C. 171 et seq. to improve U.S. design patent protection, and for other purposes.

IN THE SENATE OF THE UNITED STATES

JANUARY 21, 2021

Mr. SAIDMAN, from the Committee on the Judiciary, Subcommittee on Intellectual Property, reported the following original bill; which was read twice and placed on the calendar.

A BILL

Making amendments to 35 U.S.C. 171 et seq. to improve U.S. design patent protection, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the following amendments to 35 U.S.C. 171 et seq. are enacted for the purpose of strengthening U.S. design patent laws to protect against unlawful knock-off products, and for other purposes.

SECTION 1. SHORT TITLE.

This Act may be cited as the **"Anti-Knockoff Design Patent Improvement Act of 2021".**

SECTION 2. THE DESIGN PATENT LAWS (35 U.S.C. 171 ET SEQ.) ARE HEREBY AMENDED AS FOLLOWS.

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35 U.S.C. Sec. 171 – Patents for Designs

(a) IN GENERAL.—

(i) Whoever invents any original design may obtain a patent therefor, subject to the conditions and requirements of this title. The scope of protection of a design patent shall not depend upon the product with which the design may be used or to which it may be applied.

(ii) A "design" is the whole or parts of or for a 2- or 3-dimensional product having features of shape, line, contour, color, pattern, texture or ornamentation.

(iii) A design is "original" if it is the result of the designer's creative endeavor, it complies with Secs. 102 and 103 of this Chapter, and has not been copied from another source.

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(iv) The inventor(s) of a design shall be the person(s) who first manifested the design in a tangible medium of expression.

(v) A design may have functional features and still qualify for protection under this Chapter. Design patent protection shall not be available for a design whose overall appearance is dictated solely by functional considerations, i.e., a design for which there are no alternate designs that perform substantially the same function.

(b) APPLICABILITY OF THIS TITLE.—

(i) The provisions of this title relating to patents for inventions shall apply to patents for designs, except when in conflict with provisions of this Section in which case this Section shall apply.

(ii) 35 U.S.C. 101 and 112 shall not apply to design patents.

(iii) To render a design patent anticipated under 35 U.S.C. 102, the prior art reference must be identical in all material respects as the claimed design.

(c) FILING DATE.—

The filing date of an application for patent for design shall be the date on which the specification as prescribed by subsection (d) and the required drawings are filed.

(d) SPECIFICATION OF A DESIGN PATENT. —

A design patent shall contain a specification and drawings, which together shall constitute the disclosure of the design, in such a manner as to enable a designer skilled in the art to which it pertains, or with which it is most nearly connected, to understand the appearance of the design. Compliance with this subsection shall not depend upon the number of drawings that illustrate the design, or the manner in which the drawings are executed.

(e) CLAIMS.—

The specification shall conclude with one or more claims that refer to the drawings, or to portions thereof, in order to claim with particularity the subject matter which the designer or joint designers regard(c) as his/her/their design. The wording of the claim(s) may be in any form. The delineation of the claimed subject matter in the drawing(s) may be made in any manner as long as the appearance of the design is understood by a designer of ordinary skill.

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(f) FORM. —

A claim may be written in independent or dependent form.

(g) DRAWINGS –

(i) The drawings of subsection (d) may be executed in any form that conveys the appearance of what the designer regards as his/her design, including pen and ink drawings, photographs, computer generated images, video clips, or the like.

(ii) Subject to subsection (d), a designer may disclose the design in as many or few drawings as he/she sees fit.

(iii) Drawings may be executed with or without shading.

(iv) After filing of the design patent application, the drawings may be amended to enlarge, reduce, or otherwise amend the scope of the claimed design, including a change in the boundaries of the claimed design, as long as the amended drawings comply with subsection (d).

35 U.S.C. Sec. 289 - Infringement of a design patent

(a) In General -

(i) Whoever during the term of a patent for a design, without license of the owner, makes, uses, sells, offers for sale, or imports any product that is, or bears a design that is, wholly or in part, substantially the same in appearance as the patented design, taking into account the prior art, is an infringer of the patent and shall be liable to the owner to the extent of his total profit on sales of such product, but not less than $10,000, recoverable in any United States district court having jurisdiction of the parties. Total profit may not be apportioned between the infringing product and a component thereof.

(ii) An infringer's brand or logo placed on the infringing product shall not be taken into account in assessing infringement.

(b) EXPENSES -

The total profit of an infringing product defined in subsection (a) shall be calculated by subtracting direct expenses from gross sales of such product. The infringer has the burden of proving the gross sales of the infringing product(s), and of any direct expenses related to same. Indirect expenses, such as rent, salaries, utilities, and the like, that are not directly related to the sales of the infringing product(s), are not direct expenses.

(c) WILLFUL INFRINGEMENT –

When the total profit is not found by a jury, the court shall assess them. In either event the court may increase the total profit up to three times the amount found or assessed upon a finding of willful infringement. Willful infringement shall be presumed when the infringer has copied the patented design. Copying may be shown by direct evidence, or by showing: (i) the infringer had access to the patented design; and (ii) the infringer's design is a mere colorable imitation of the patented design.

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