3Qs: What the Apple-Samsung ruling means for design patents

September 7 2012, by Lauren Dibble

Susan Barbieri Montgomery, executive professor of law and business, examines the impact of a recent verdict in favor of Apple in a case involving product infringement. Photo by David Leifer.

(Phys.org)—A jury in San Jose, Calif., recently found that Samsung Electronics infringed on Apple's patents, awarding the iPod manufacturer more than $1 billion in damages. We asked Susan Barbieri Montgomery, executive professor of law and business at Northeastern University, to expound on a lesser-known form of intellectual property (IP): design-patent protection. Here, she discusses Apple's design patent on the physical design of the iPad (U.S. Patent No. D618,677) and whether the role of this patent will inspire a surge in applications for U.S. design-patent protection.

What is the difference between a utility patent and a

design patent? What is the scope of design-patent protection?

Utility patents are what most people think of as "patents," covering new and useful devices, processes and materials. Design patents, on the other hand, cover the new, original, ornamental design of an article of manufacture. For a particular device, one or more utility patents may cover the useful, functional features and the method of using the device, while a design patent covers the way it looks. While utility patents often have numerous, lengthy, precisely worded claims, each design patent has a single claim, which is shown in one or more drawings.

In this particular case, Apple accused Samsung of infringing a variety of IP assets: three utility patents and four design patents, as well as registered and unregistered trade dress. In reaching its verdict, the jury was instructed to separately determine whether and which of Apple's IP assets was infringed by each of the numerous smartphones and tablet computers identified in Apple's complaint.

For the design patents, the jury was told it must find infringement if "the overall appearance of an accused Samsung design is substantially the same as the overall appearance of the claimed Apple design patent." The jury's finding that the thin, rectangular, rounded-corners design of various Samsung Galaxy devices infringed the '677 design patent is a stunning example of the potential power and scope of design-patent protection.

How common are design patents? Are they becoming more popular in traditionally technical industries such as that of electronic devices?

Since it "only" covers ornamental design, a design patent has long been

viewed by some as the poor stepsibling of the more-championed utility patent. Investment in design patents, however, has increased significantly over the past 30 years, growing steadily from an annual rate of only 3,942 design patents issued by the U.S. Patent and Trademark Office in 1980 to 21,356 in 2011. The rate of growth has varied by industry, decreasing in some, remaining fairly stable in certain sectors (such as automotive), and enjoying spikes of interest in footwear and other consumer goods sectors. Since the late 1990s, applications submitted by computing, mobile and other electronic-device companies have fueled much of the growth. Electronic device companies now dominate the upper ranks of companies obtaining the most design patents over the years 1987 – 2011, as reported by the U.S. Patent and Trademark Office. Apple is 21st on that list, with a period total of 722 design patents—while Samsung tops the list, with 3,008, having accelerated its annual acquisition rate from a mere four in 1998 to 328 in 2011.

Do actions speak louder than words? Compare Samsung's amassing of this unprecedented design-patent armory to its press release slamming last week's verdict as an "unfortunate" example of design-patent law "manipulated to give one company a monopoly over rectangles with rounded corners."

Will the decision in this case, particularly in regard to Apple's use of a design patent, cause companies to consider including design patents in their IP strategy?

The coverage of last month's more than $1 billion award (which may increase as a results of a finding that Samsung's infringement was willful), coupled with the clamor over Apple having a "monopoly over rectangles with rounded corners," has put design-patent protection in the spotlight. Companies that previously overlooked or discounted design-patent protection as "only" protecting how something looks, are

likely to reconsider and place new value on the role of design-patent protection in their IP asset portfolios and strategies. In addition to the idolization of its design ethos and acumen in the market-transforming wake of the iPad, the success of Apple's comprehensive IP strategy demonstrated by the verdict against Samsung—including the integral role of design patents—is inspiration for others to adopt similar approaches to protect and position their products.

Provided by Northeastern University