

Practice note: avoid multiple embodiments in design patent applications

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Design patents can be powerful and economical tools for many patent portfolios, often issuing within a year of filing and at a fraction of the cost of traditional utility patents. However, unlike utility patents, which protect the composition, function or structure of an invention, design patents protect only the ornamental design of a useful article. Consequently, while the wording of the claims is of paramount importance for utility applications, drawings dictate what is claimed in design applications and form the heart and soul of an issued design patent.

Because of these differences, common prosecution strategies in one type of application may be detrimental in the other. For example, while it may be beneficial to disclose as many embodiments of an invention as possible in a single utility patent, the same is rarely true for a design application. This principle was made clear in *Pacific Coast Marine Windshields Ltd v Malibu Boats, LLC* – a 2014 Federal Circuit case where the patent owner's cancellation of certain drawings during prosecution stripped almost all economic value from the issued patent.

Considering the growing popularity of design patent applications, *Pacific Coast Marine Windshields* has important implications for IP owners and patent practitioners.

Pacific Coast submitted a design patent application for a boat windshield. The application contained several drawings of windshields with vent holes in different shapes and configurations. The drawings also included embodiments with a hatch in the middle of the windshield and drawings without the associated hatch. During prosecution, the examiner found that the application contained five patentably distinct designs and requested that Pacific Coast elect a single design for the present application. In response, the applicant elected a design with a hatch and four circular vent holes and cancelled all of the other drawings. Pacific Coast failed to file a new application for all but one of the cancelled designs. Soon after the applicant's election, a patent issued for the claimed design.

Malibu Boats sold a windshield that was strikingly similar to Pacific Coast's patented windshield design – the only notable difference was that Malibu Boats' windshield comprised three rectangular holes. Pacific Coast sued Malibu Boats for infringement, but the lower court disposed of the case on summary judgment, finding that Pacific Coast had surrendered its ability to make the infringement claim when it cancelled its alternate designs in response to the examiner's restriction requirement. The Federal Circuit affirmed in part and held that any designs given up during patent prosecution in response to a restriction requirement are dedicated to the public unless the applicant pursues separate applications for the cancelled designs.

Therefore, when Pacific Coast cancelled drawings to fulfill the examiner's restriction requirement but failed to claim the cancelled drawings in separate applications, the cancelled drawings effectively became a blueprint for competitors to circumvent infringement of the patented design.

This case provides relevant and timely precautions for applicants, investors and entities with regard to design patents – namely, as a best practice, applicants should resist the temptation to disclose more than one embodiment in a single design patent application. If disclosure of more than one embodiment in an application is unavoidable, the applicant should attempt voluntarily to cancel drawings directed to alternate embodiments before the examiner can submit a restriction requirement and then file separate applications for the cancelled embodiments.

Proceeding in this manner prevents the generation of an official US Patent and Trademark Office record with regard to the boundaries of the claimed design and could strengthen the value of the issued design patent. If, during prosecution, an applicant is forced to elect a single group from multiple embodiments of the design, the applicant should file divisional applications directed to the unelected designs to avoid the result suffered by Pacific Coast.

Further, investors or entities looking to purchase IP portfolios are strongly encouraged to review the prosecution history of design applications before completing the purchase to ensure that small variants of the patented design have not been dedicated to the public.

Alternatively, competitors looking to enter into a new market may find it valuable to review their competition's



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design patents. Drawings cancelled in response to a restriction requirement and not claimed in separate applications might provide guidance as to how to proceed without infringing the competitor's patented design.

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