

**DESIGN PATENT LAW AND PROSECUTION**  
FALL 2007

Instructors:

James D. Hamilton Tel: (703) 412-6220 [E-Mail: jhamilton@oblon.com](mailto:jhamilton@oblon.com)

Steven P. Weihrouch Tel: (703) 413-3000 [E-Mail: sweihrouch@oblon.com](mailto:sweihrouch@oblon.com)

Class Hours: 8:00 – 8:50 PM Mondays

Classroom: 224

Required Textbook: Cases and Materials on Patent Law by Frances & Collins  
(Sixth Edition - West Group)

Recommended Textbooks: Manual of Patent Examining Procedure (MPEP) –  
Chapter 1500 (Design Patents);

Chapter 1500 of the MPEP is available on-line at:  
<http://www.uspto.gov/web/offices/pac/mpep/documents/1500.htm>

---

**ASSIGNMENTS:**

Weeks 1 – 2 (Weeks of August 27 and September 10, 2007)

Discussion Topics: (1) Introduction; (2) Statutory Subject Matter; (3) Actual Reduction of Practice; (4) Specification (5) Novelty; (6) Non-Obviousness; (7) Public Use; and (8) MPEP assigned reading.

Reading Assignment: Textbook: pgs. 769-788; 37 C.F.R. §171-173 and MPEP pgs. 1500-1 to 1500-11- Statutes and Rules Applicable; Definition of Design; and Elements of a Design Application and the decisions listed below:

*Application of Hruby*, 54 CCPA1196, 373 F.2d 997, 153 USPQ 61 (Fed. Cir. 1967).

*Fitzgerald v. Arbib*, 268 F.2d 763, 122 ISPQ 530 (Fed. Cir. 1959).

*Ex parte Reiner*, 142 USPQ 283 (Bd. of Pat. App. & Inter. 1964).

*Application of Bartlett et al.*, 49 CCPA 969, 300 F.2d 942, 133 USPQ 204 (CCPA 1962).

*Sidewinder Marine, Inc. v. Starbuck-Kustom Boats and Products, Inc.*, 597 F.2d 201, 202 USPQ 356 (10th Cir. 1979).

*In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

*In re Mann*, 861 F.2d 581, 8 USPQ2d 2030 (Fed. Cir. 1988).

*In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

*In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998).

Class Handouts: None

Weeks 3 -5 (Weeks of September 17, 24 and October 1, 2007):

Discussion Topics: (1) Examination of Design Applications; (2) Statutory Subject Matter for Designs; (3) Computer-Generated Icons; (4) Design Comprising Multiple Articles or Multiple Parts Embodied in a Single Article; (5) Lack of Ornamentality; (6) Novelty; and (7) Non-Obviousness.

Reading Assignment: MPEP pgs. 1500-11 to 1500-35 and the decisions listed below as referenced in the MPEP:

*Ex parte Donaldson*, 26 USPQ2d 1250 (Bd. Pat. App. & Int. 1992).

*Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992).

*In re Oeticker*, 997 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

*Ex parte Gibson*, 20 USPQ 249 (Bd. App. 1933).

*L.A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 25 USPQ2d 1913 (Fed. Cir. 1993).

*Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988).

*In re Webb*, 916 F.2d 1553, 16 USPQ2d 1433, (Fed. Cir. 1990).

*In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964).

*In re Bartlett*, 300 F.2d 942, 133 USPQ 204 (CCPA 1962).

*Hupp v. Siroflex of America*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

*In re Nalbandian*, 661 F.2d, 1214, 211 USPQ 782, (CCPA 1981).

*In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956).

*Seiko Epson v. Nu-Kote International Inc.*, 190 F.3d 1360, 52 USPQ2d 1011 (Fed. Cir. 1999)

Class Handouts: None

Weeks 6 – 7 (Weeks of October 9 and 15 (Monday, October 8 (Columbus Day)) class to be held on October 9, 2007):

Discussion Topics: (1) Considerations under 35 U.S.C. §112; (2) Restriction; (3) Traversal of Restriction Requirement

Reading Assignment: MPEP pgs. 1500-35 to 1500-49 and the decisions listed below referenced in the MPEP:

*Ex parte Kohler*, 1905 C.D. 192, 116 O.G. 1185 (Comm'r Pat. 1905).

*In re Salmon*, 705 F.2d 1579, 217 USPQ 981 (Fed. Cir. 1983).

*In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998).

*In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981).

*In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

*Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965).

*In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

*In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

*Keystone Retaining Wall Systems, Inc. v. Westrock Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993).

*Bloomcraft of Pittsburgh v. Ladd*, 144 USPQ 562 (D.D.C. 1965).

Class Handouts: None

Weeks 8 – 9 (Weeks of October 22 and 29, 2007):

Discussion Topics: (1) Double Patenting; (2) Priority Under 35 U.S.C. §119(a)-(d); (3) Benefit Under 35 U.S.C. §120 (3) Expedited Examination; (4) Allowance and Term of Design Patent; (5) Reissue of a Design Patent; (6) Reexamination; (7) Protest; (8) Relationship Between Design Patent, Copyright and Trademark.

Reading Assignment: MPEP pgs. 1500-50 to 1500-62 and the decisions listed below referenced in the MPEP:

*Anchor Hocking Corp. v. Eyelet Specialty Co.*, 377 F. Supp 98, 183 USPQ 87 (D. Del. 1974).

*In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963).

*In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 614 (Fed. Cir. 1999).

*In re Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

*In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995).

*In re Yardley*, 493 F.2d 1389, 181 USPQ 331 (CCPA 1974).

*In re Mogen David Wine Corp.*, 328 F.2d 925, 140 USPQ 575 (CCPA 1964).

Class Handouts: None

Weeks 10 -11 (Weeks of November 5 and 12, 2007):

Discussion Topics: Design Patent Litigation - Claim Interpretation

Reading Assignment:

*Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417 (Fed. Cir. 1995).

*OddzOn Products v. Just Toys*, 122 F.3d 1396 (Fed. Cir. 1997).

*Contessa Food Products v. Conagra*, 282 F.3d 1370 (Fed. Cir. 2002).

Class Handouts: None

Weeks 12 – 13 (Weeks of November 19 and 26, 2007):

Discussion Topics: Design Patent Litigation - Infringement, Point of Novelty and Ordinary Observer Requirements, Willful Infringement

Reading Assignment:

*Gorham v. White*, 81 U.S. 511 (1872).

*OddzOn Products v. Just Toys*, 122 F.3d 1396 (Fed. Cir. 1997).

*Unidynamics Corp. v. Automated Products International, Ltd.*, 157 F.3d 1311 (Fed. Cir. 1998).

*L.A. Gear, Inc. v. Tom McCan Shoe Co.*, 988 F.2d 1117 (Fed Cir. 1993).

*Contessa Food Products v. Conagra*, 282 F.3d 1370 (Fed. Cir. 2002).

*Hup v. Sirof ex of America*, 122 F.3d 1456 (Fed. Cir. 1997).

*Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571.

*Litton Systems Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

*Lawman Armor v. Winner International*, (3 decisions) 77 USPQ2d 2017; 79 USPQ2d 1380; 79 USPQ2d 1382 (Fed. Cir. 2006).

Class Handouts: None

Week 14 (December 3, 2007):

Discussion Topics: Design Patent Litigation - Damages, Invalidity

Reading Assignment:

35 U.S.C. § 284

35 U.S.C. § 289

*Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121 (Fed. Cir. 1992).

*Catalina Lighting Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 63 USPQ2d 1545 (Fed. Cir. 2002).

*Nike Inc. v. Wal-Mart Stores*, 46 USPQ2d 1001 (Fed. Cir. 1998).

*Junker v. Eddings*, 73 USPQ2d 1850 (Fed. Cir. 2005).

*Rosco Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 64 USPQ2d 1676 (Fed. Cir. 2002).

*Aero Products v. Intex Recreation*, 80 USPQ2d 1481 (Fed. Cir. 2006).

*The Read Corp. v. Portec*, 970 F.2d 816, 23 USPQ2d 1426 (Fed. Cir. 1992).

*PHG Technologies v. St. John Cos.*, 81 USPQ2d 1088 (Fed. Cir. 2006).

*KRS v. Teleflex*, 127 S.Ct. 1727 (2007).

Class Handouts: None

Final Exam – December 17, 2007 (6:00 PM)

I:\ATTY\SPW\MISC\GMU\SYLLABUS FOR 2007 FALL CLASS\_SPW (2).DOC