BEST PRACTICES IN SEARCHING DESIGNS

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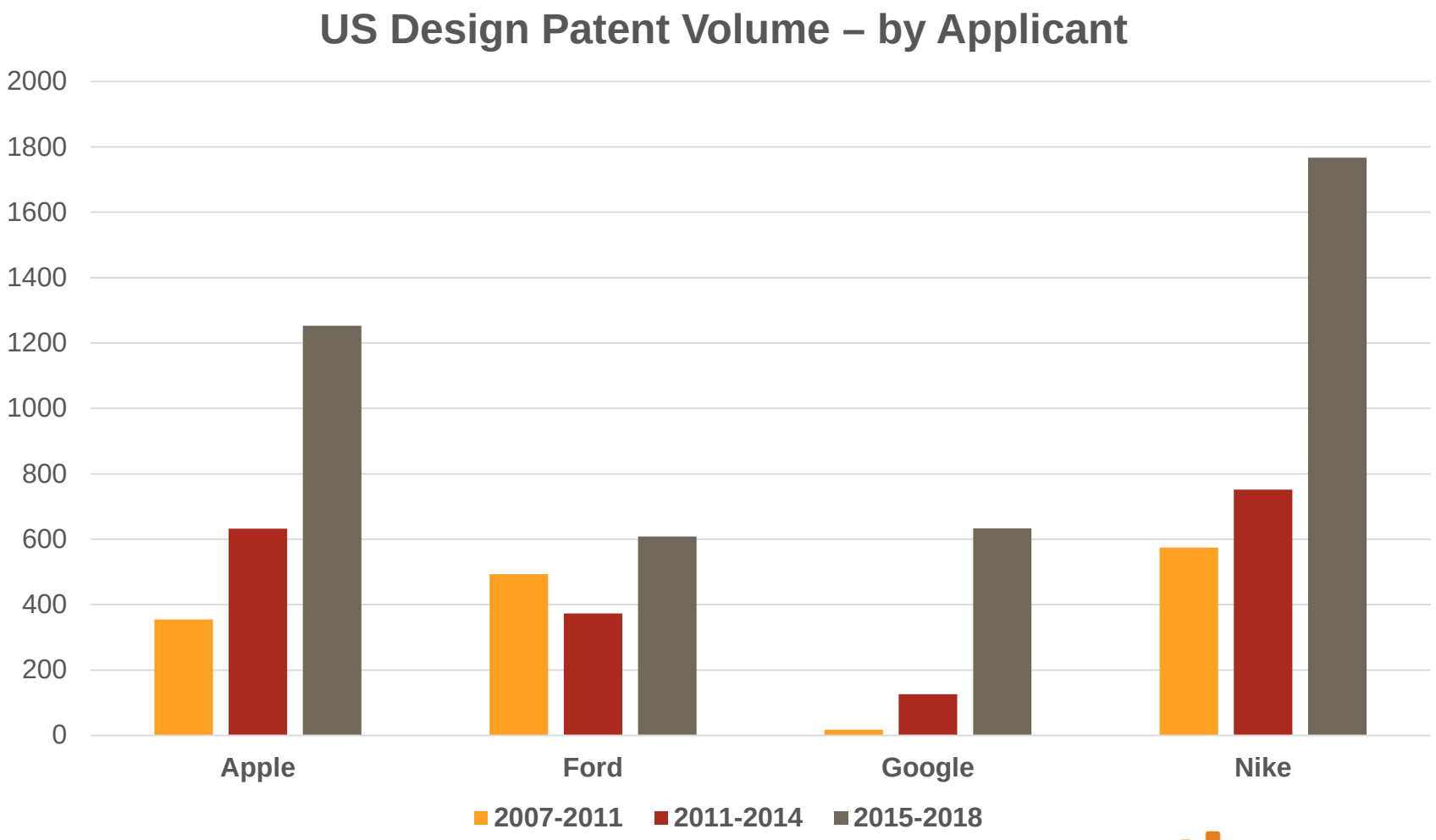
Patent Searcher and Managing Director
DeMarco Intellectual Property, LLC

DEMARCOIP

Designs: Who Cares?



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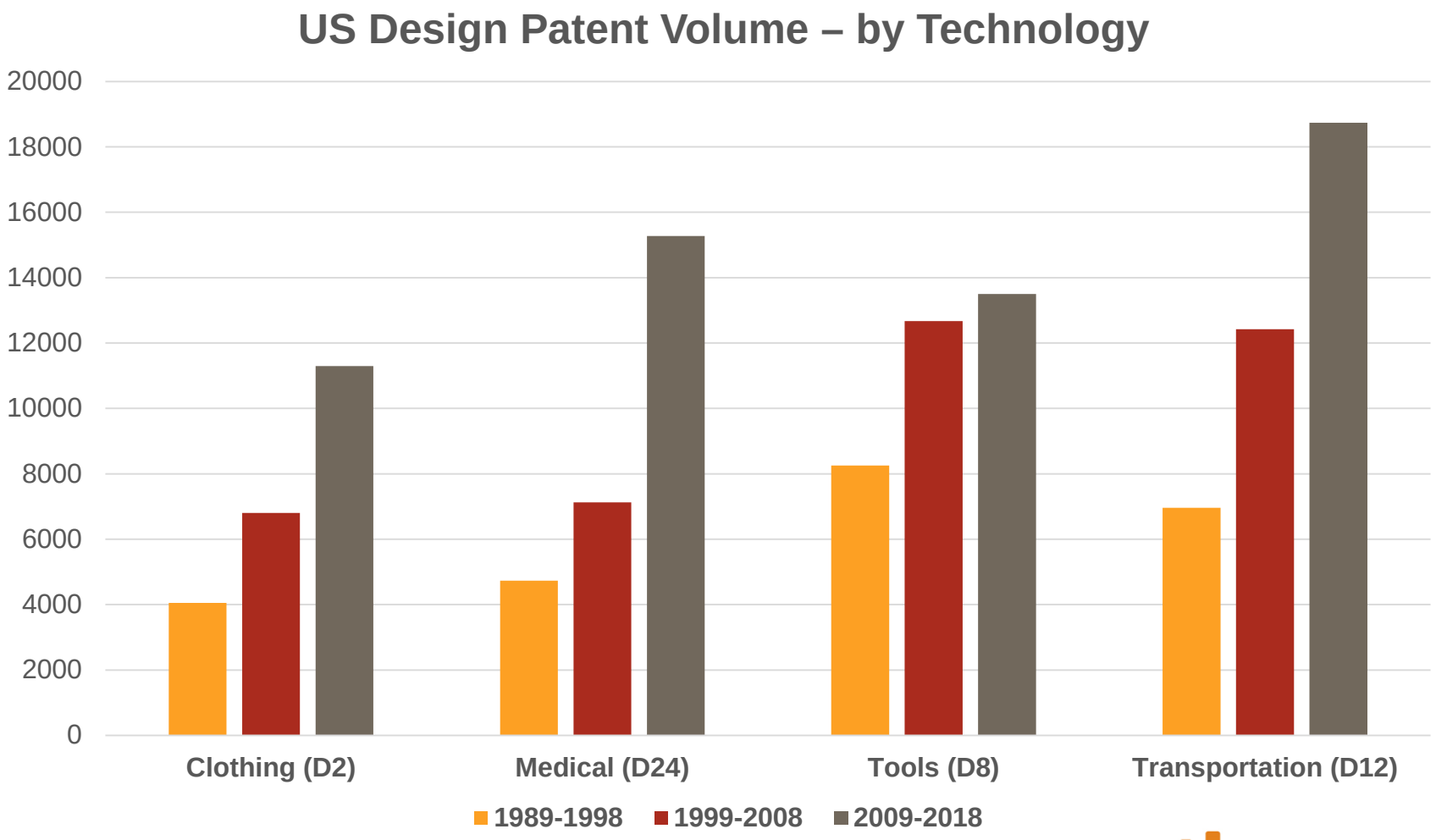
Designs: Who Cares?



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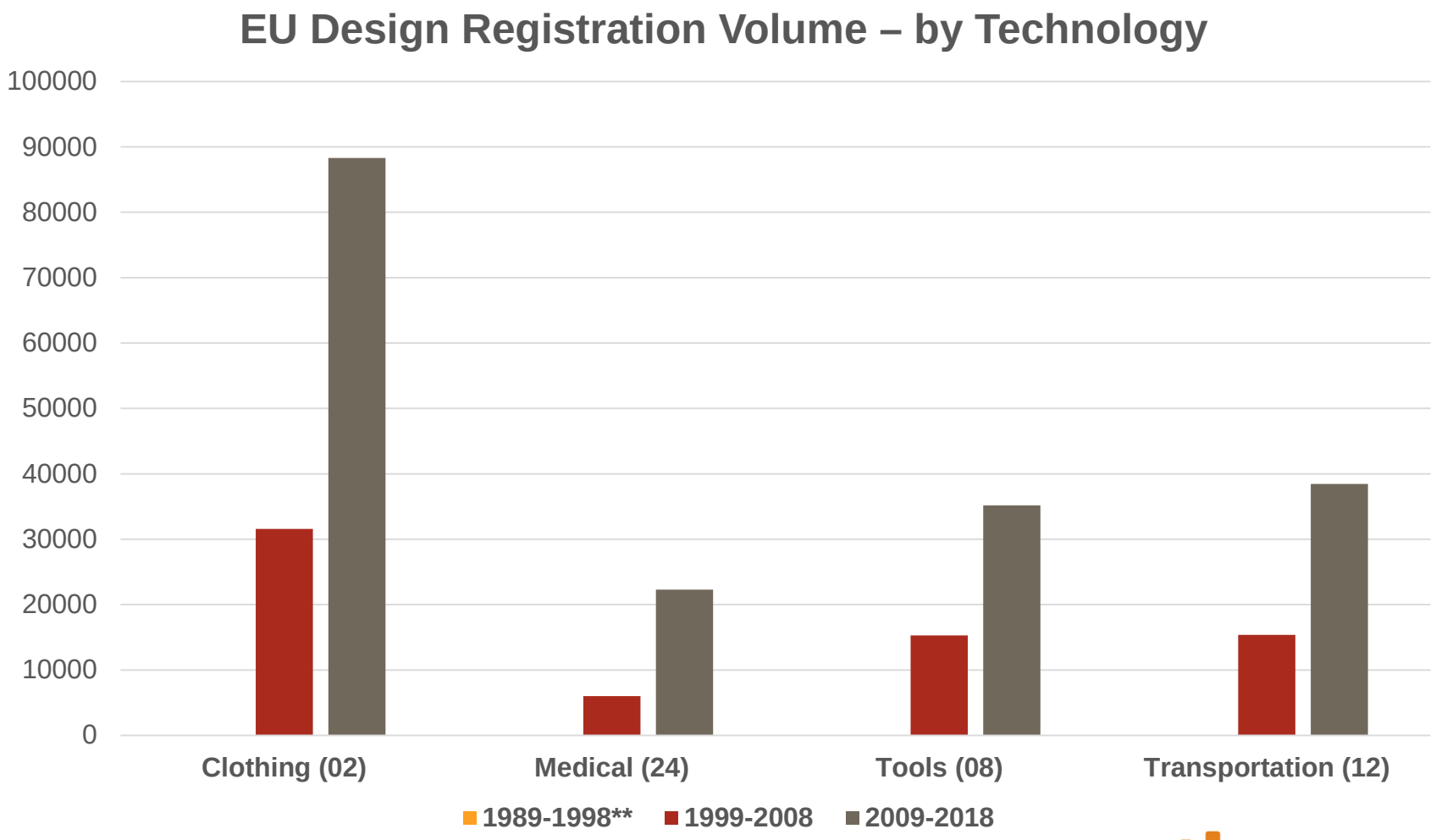
Designs: Who Cares?



** Fake news alert. Designs in the EU did not start till 2002 or 2003…

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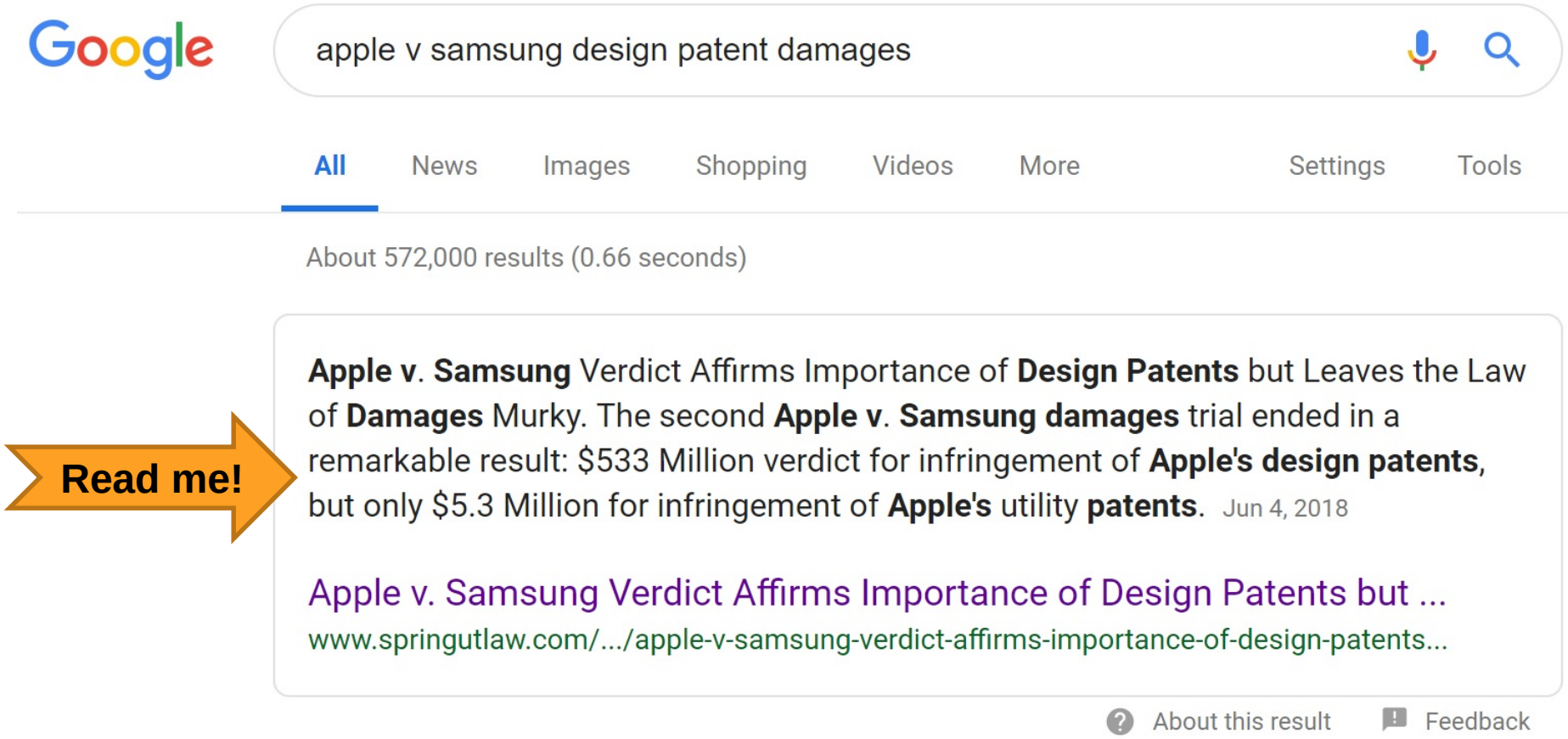
Designs: Who Cares?



Read me!

Hopefully I have your attention now. ☺

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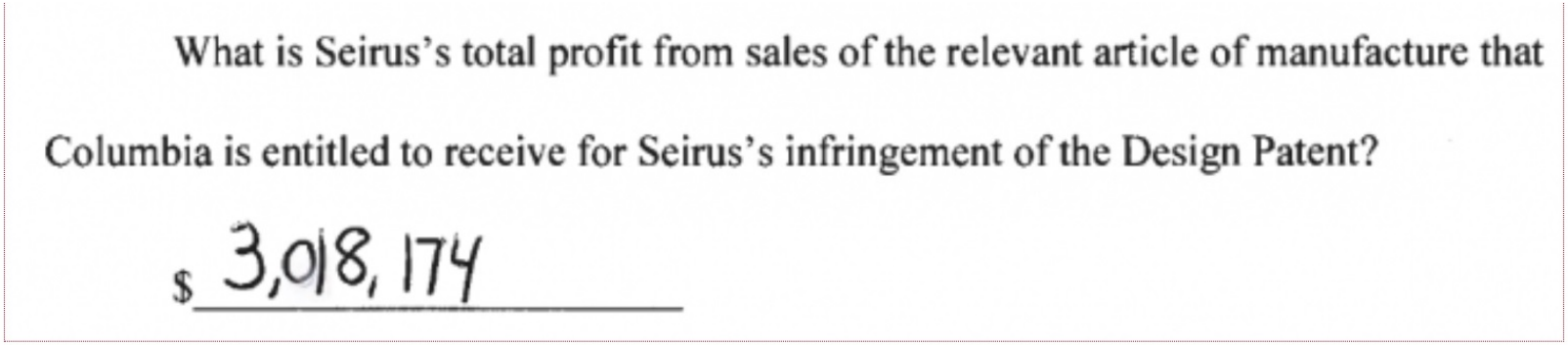
Designs: Who Cares?

- First post Apple v. Samsung Supreme Court case
- Columbia Sportwear v. Seirus Innovative Accessories



What is Seirus's total profit from sales of the relevant article of manufacture that Columbia is entitled to receive for Seirus's infringement of the Design Patent?

$ 3,018,174

The design patent damages verdict here is important for Columbia because the jury found the parallel asserted utility patent claims invalid as both obvious and anticipated. [ColumbiaSportsVerdict]

Screenshot from www.PatentlyO.com – Oct. 3, 2017

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Example #1: Please search for the following Design in the United States

- A pharmaceutical tablet

Fig.1

Fig.2

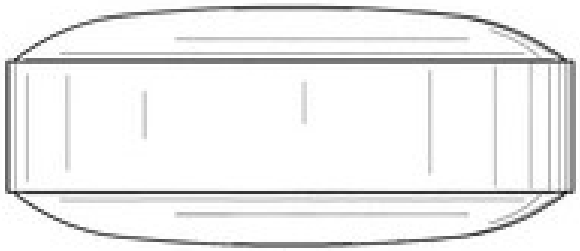

Fig.3

Search Strategy – US Designs

- Just like any “regular” search of US Utility Patents:

- Text based searching
  - Inventor or Applicant / Assignees
  - Very limited verbiage (Titles), use kind code (S) to limit to designs

- Citation based searching
  - Leverage the work of others!

- Classification based searching
  - US Patent Classifications: Not abandoned in 2015! **- USPTO.gov**

Search Strategy – US Designs

- Text based searching (limited to Design art)
  - capsule or dose or pill
  - (medic+ or pharma+) and tablet
  - “APR”
  - Celgene (Owner field)
- Citation based searching
  - Forward and Backward of anything interesting
- Classification based searching
  - Where does the art we have found live? US Classes D01 and D24
- Circle back (Adapt and Iterate)

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Search Strategy – Bring The Noise!

- As with all searching in the Engineering / Figure based realms, a high noise level is expected and required.
- Going through 3,000; 10,000; or even 50,0000 Designs is not unusual and is often required to provide a desired level of thoroughness.
- Noise is easily ignored with a simple click of the “next” button. Searching and Analysis should be separated via the standard “bucketing methodology”.

US Patent Classification

Click to go deeper

Go		D01	Edible products
Go		D02	Apparel and haberdashery
Go		D03	Travel goods and personal belongings
Go		D04	Brushware
Go		D05	Textile or paper yard goods; sheet material
Go		D06	Furnishings
Go		D07	Equipment for preparing or serving food or drink not elsewhere specified
Go		D08	Tools and hardware
Go		D09	Packages and containers for goods
Go		D10	Measuring, testing, or signalling instruments
Go		D11	Jewelry, symbolic insignia, and ornaments
Go		D12	Transportation
Go		D13	Equipment for production, distribution, or transformation of energy
Go		D14	Recording, communication, or information retrieval equipment
Go		D15	Machines not elsewhere specified
Go		D16	Photography and optical equipment
Go		D17	Musical instruments
Go		D18	Printing and office machinery

Class D01 EDIBLE PRODUCTS

Click here for a printable version of this file

Turn Outline ON

100	MINERAL BLOCK
101	DISTINCT COMPOSITE INGREDIENTS
102	· With inedible holder
103	·· Plural holder
104	·· Simulative
105	·· Holder, per se
106	SIMULATIVE
107	· Animate
108	·· Humanoid
109	··· Head or other appendage
110	·· Quadruped
111	·· Marine life
112	·· Heart shaped
113	· Vehicle or component thereof
114	· Alpha or numeric
115	· Plant life
116	ICE CREAM CONE OR CUP
117	· Square or rectangular orifice
118	· Circular orifice
119	· Provision for juxtaposed scoops
120	WITH ENCLOSED OPENINGS
121	SCORED FOR PORTION CONTROL
122	WITH VISIBLE CONCAVITY FOR FOOD
123	· Scoop or dip type
124	· With circular orifice
125	CONVOLUTED EXTERIOR
126	PASTA
127	CANDY
128	CRACKER OR COOKIE
129	BREAD OR CAKE TYPE
130	SUBSTANTIALLY CIRCULAR IN PLAN
199	MISCELLANEOUS

US Patent Classification

Click to go deeper

Go	D19	Office supplies; artists and teachers materials
Go	D20	Sales and advertising equipment
Go	D21	Games, toys, and sports goods
Go	D22	Arms, pyrotechnics, hunting and fishing equipment
Go	D23	Environmental heating and cooling; fluid handling and sanitary equipment
Go	D24	Medical and laboratory equipment
Go	D25	Building units and construction elements
Go	D26	Lighting
	Class Number and Title	
Go	D27	Tobacco and smokers' supplies
Go	D28	Cosmetic products and toilet articles
Go	D29	Equipment for safety, protection, and rescue
Go	D30	Animal husbandry
Go	D32	Washing, cleaning, or drying machine
Go	D34	Material or article handling equipment
Go	D99	Miscellaneous

Now we're cooking with gas!

Class D24 MEDICAL AND LABORATORY EQUIPMENT

Click here for a printable version of this file

Turn Outline ON

100
101
102
103
104
105
106
107
108
109
110
110.1
110.2
110.3
110.4
110.5
110.6
111
112
113
114
115

PHARMACEUTICAL PRODUCT

- Tablet or caplet (1)
  - Simulative (2)
  - Scored for dosage control
- Capsule

PROPHYLACTIC ARTICLE

- Ear plug or nose clip

EQUIPMENT FOR DIAGNOSIS, ANALYSIS, OR TREATMENT

- Article for the introduction, removal or collection of fluids (e.g., infusion,
  - Lacteal extractor
  - Respirator, vaporizer, or inhalation tube (4)
    - Mask
      - Including eye shield (5)
      - Helmet type
      - Including provision for tube
    - Inhalation tube or mouthpiece type (6)
      - Regulator or valve
  - Infusion or irrigation pump (e.g., dental irrigation unit, powered douche ur
  - Conduit or nozzle (e.g., syringe, cannula, catheter, etc.) (8)
    - Hand actuated flow control (e.g., lever, button, etc.)
      - Rectilinear arrangement of actuator and plunger (i.e., straight-line syring
      - Resilient (e.g., squeeze bulb, bellows, etc.) (9)

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Example #2: Please search for the following Design in Europe

- A pharmaceutical tablet

Fig.1

Fig.2

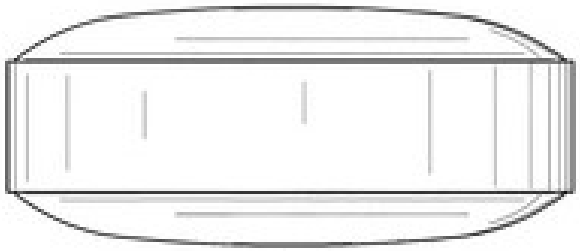

Fig.3

Search Strategy – European Designs

- Just like any “regular” search of European Patents, you absolutely must push back and clarify!
- What countries are we actually searching? **NEVER EVER SAY YES TO “ALL OF THEM”.**
- Theoretically we now have “families” of Design Registrations in Europe, but the reality is the opposite.
- The vast majority of Designs are registered individually in specific countries and via both the EU and WIPO.

Search Strategy – European Designs

- Text based searching (use multiple languages)
  - capsule or dose or pill
  - (medic+ or pharma+) and tablet
  - “APR”
  - Celgene (Owner field)
- Citation based searching – NOT AVAILABLE!!!
- Classification based searching
  - Where does the art we have found live? Locarno Class 28, but not in Class 24 as expected – **WIPO.int**
- Circle back (Adapt and Iterate)

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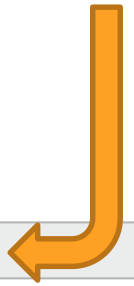
Locarno Design Classification

Um, where are the indents?



Class 24

Medical and laboratory equipment

Note(s)

The term "medical equipment" covers also surgical, dental and veterinary equipment.

24-01	APPARATUS AND EQUIPMENT FOR DOCTORS, HOSPITALS AND LABORATORIES
24-02	MEDICAL INSTRUMENTS, INSTRUMENTS AND TOOLS FOR LABORATORY USE **Note(s)** Including only hand-operated instruments.
24-03	PROSTHETIC ARTICLES
24-04	MATERIALS FOR DRESSING WOUNDS, NURSING AND MEDICAL CARE **Note(s)** Including absorbent dressings.
24-99	MISCELLANEOUS

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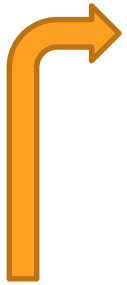
Fake Subclasses - These do not exist!



Not in the treaty, so no mandate to use them.

☹

Medical and laboratory equipment

Note(s)

The term "medical equipment" covers also surgical, dental and veterinary equipment.

24-01	APPARATUS AND EQUIPMENT FOR DOCTORS, HOSPITALS AND LABORATORIES
103790	**Anaesthetic** apparatus
103819	**Anaesthetic** masks
103824	**Apparatus** for thermotherapy
103827	**Apparatus** and installations for medical or laboratory diagnosis
104903	**Artificial** lung ventilation apparatus
103792	**Audiometers**
103793	**Autoclaves** [medicine]
103789	**Blood** testing apparatus
103825	**Blood** transfusion and sampling apparatus
104906	**Blood** glucose meters
103826	**Chromatographs**
103798	**Compression** diaphragms [Roentgen apparatus]
104904	**Defibrillators**
103797	**Dental** appliances [fixed]

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Locarno Design Classification

Class 28

Pharmaceutical and cosmetic products, toilet articles and apparatus

+ 28-01 PHARMACEUTICAL PRODUCTS

Note(s)

a. Including for animals.

b. Including chemicals in cachet, capsule, lozenge, pill and tablet forms, also for plants.

c. Not including materials for dressing wounds and nursing (Cl. 24-04).

+ 28-02 COSMETIC PRODUCTS

Note(s)

Including for animals.

+ 28-03 TOILET ARTICLES AND BEAUTY PARLOR EQUIPMENT

Note(s)

a. Including razors, apparatus and appliances for massaging, hair removing or hair dressing.

b. Not including toilet and make-up brushes (Cl. 04-02), or articles and equipment for animals (Cl. 30-99).

+ 28-04 WIGS AND FALSE BEAUTY ARTICLES

− 28-05 AIR FRESHENERS

104370 **Air** fresheners [other than apparatus]

− 28-99 MISCELLANEOUS

Home for our pills and tablets!

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How hard is European Design Searching?

Imagine life before the European Patent Office and PCT filings, but with clients expecting modern efficiency and speed.

Search history

Search Step	Result(s)	Query
6	1602	1 OR 2 OR 3 OR 4 OR 5
5	67	(28-01)/CL AND (WO/CCDB)
4	502	(28-01)/CL AND (EU/CCDB)
3	467	(28-01)/CL AND (GB/CCDB)
2	160	(28-01)/CL AND (FR/CCDB)
1	406	(28-01)/CL AND (DE/CCDB)

The mental anguish is not the volume, but in seeing the exact same filings in multiple jurisdictions and never having a means to create or filter by “families”.

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Request #3: Please search for the following Design in China

- Packaging (a box of candy)

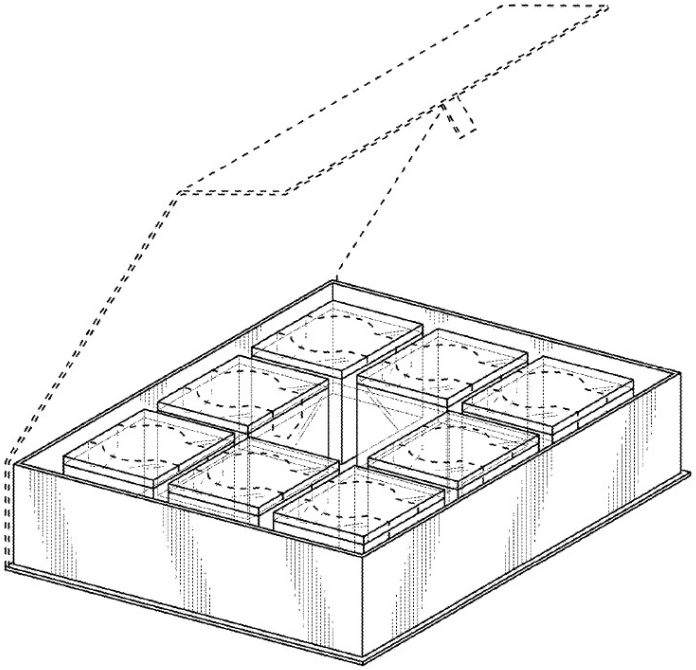


FIG. 2

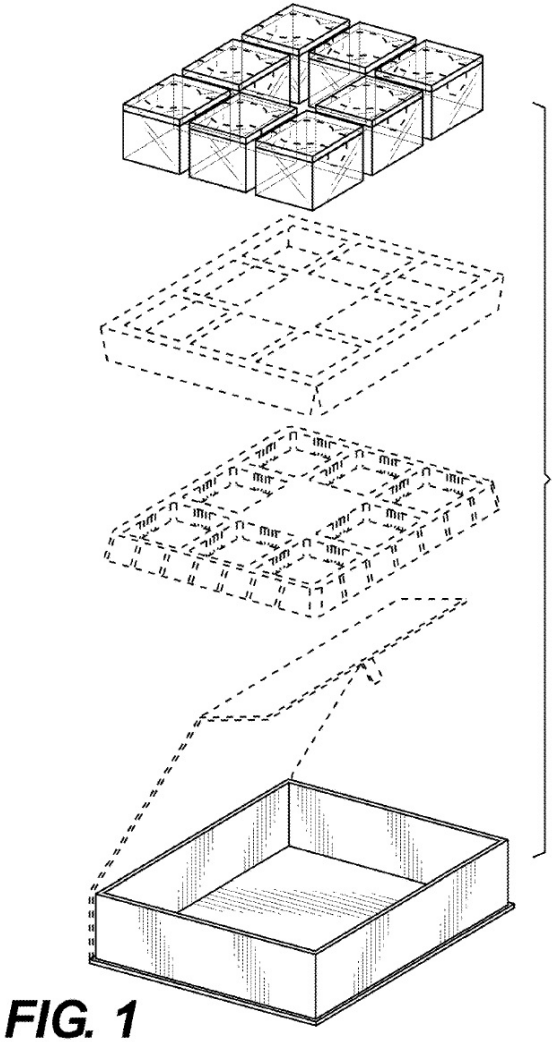


FIG. 1

Search Strategy – Chinese Designs

- As with their Patent publications, China is a bit of a disaster. However, it is the “next big thing” and our employers / clients want us searching in China…
- Text searching using Chinese characters. Translations are less than ideal.
- Owner searching using Chinese characters because, you guessed it, translations are questionable.
- You are stuck with Locarno just like with European Designs.

Locarno Design Classification

Class 9

Packages and containers for the transport or handling of goods

09-01 BOTTLES, FLASKS, POTS, CARBOYS, DEMIJOHNS, AND CONTAINERS WITH DYNAMIC DISPENSING MEANS

Note(s)

a. "Pots" means those serving as containers.

b. Not including pots regarded as crockery (Cl. 07-01), or flower pots (Cl. 11-02).

09-02 STORAGE CANS, DRUMS AND CASKS

09-03 BOXES, CASES, CONTAINERS, (PRESERVE) TINS OR CANS

Note(s)

Including freight containers.

09-04 HAMPERS, CRATES AND BASKETS

09-05 BAGS, SACHETS, TUBES AND CAPSULES

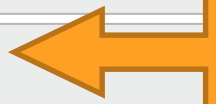
Note(s)

a. Including plastic bags or sachets, with or without handle or means of closing.

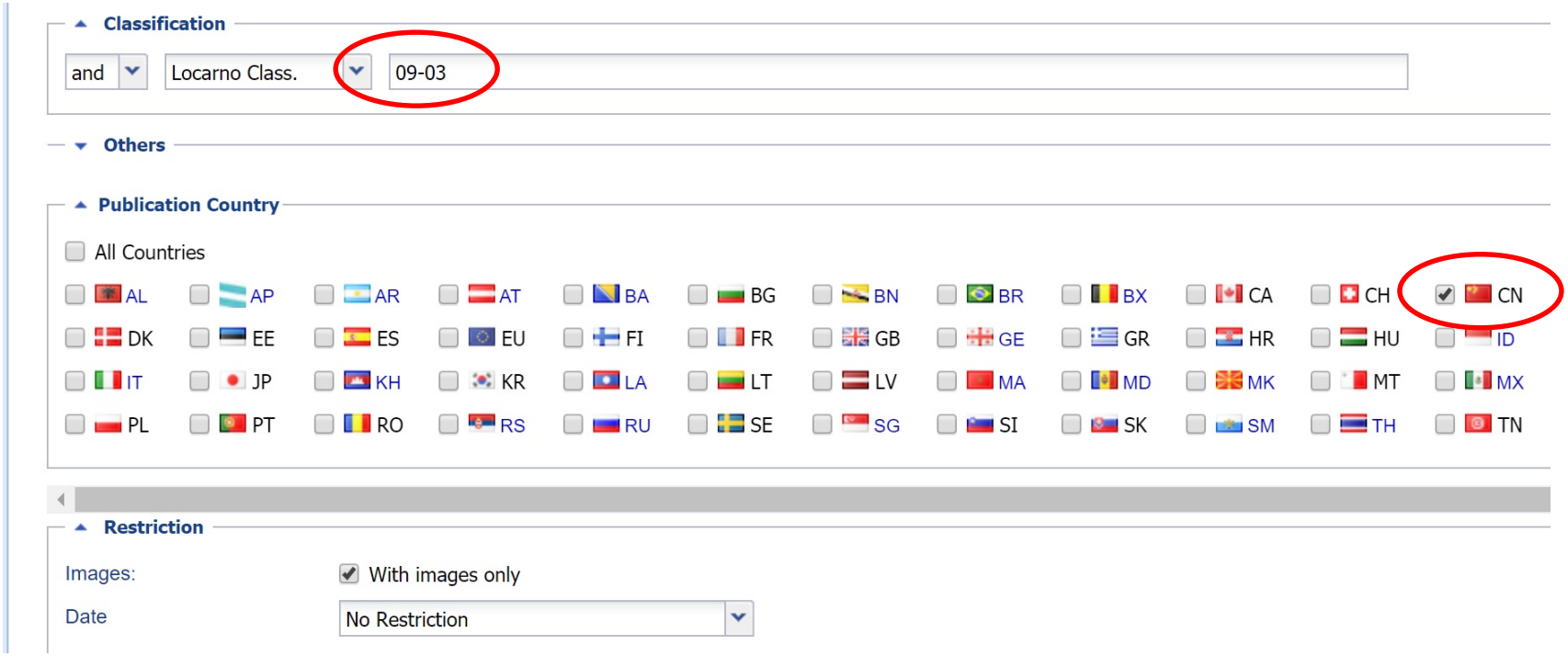
b. "Capsules" means those used for packaging.

09-06 ROPES AND HOOPING MATERIALS

09-07 CLOSING MEANS AND ATTACHMENTS



It's not hard to figure out where to search: 09-03.



Actually doing the search is the problem…

Search history

Search Step	Result(s)	Query
1	282028	(09-03)/CL AND (CN/CCDB) AND DRAW=YES

At ~1,000 images per hour, let's see, that's um, uh, nope, not happening.

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Request #4: Please search for the following Design in Japan

- Packaging (box of candy)

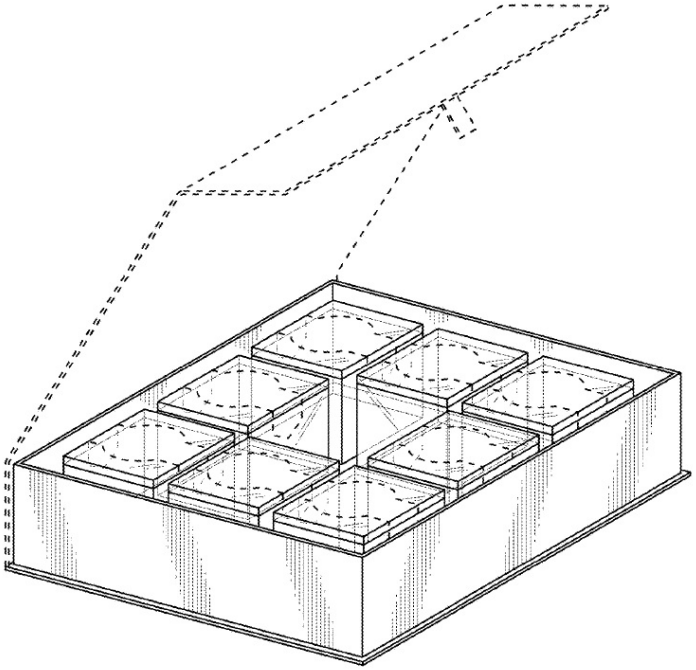


FIG. 2

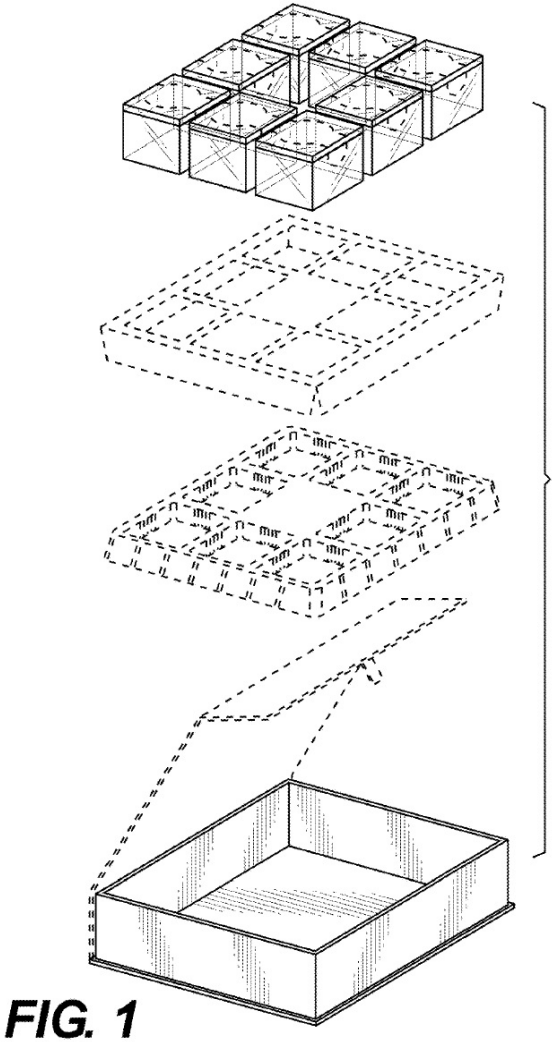


FIG. 1

Search Strategy – Japanese Designs

- Good news! **Japan** is one of the few countries with a robust and useful National Design Classification system.

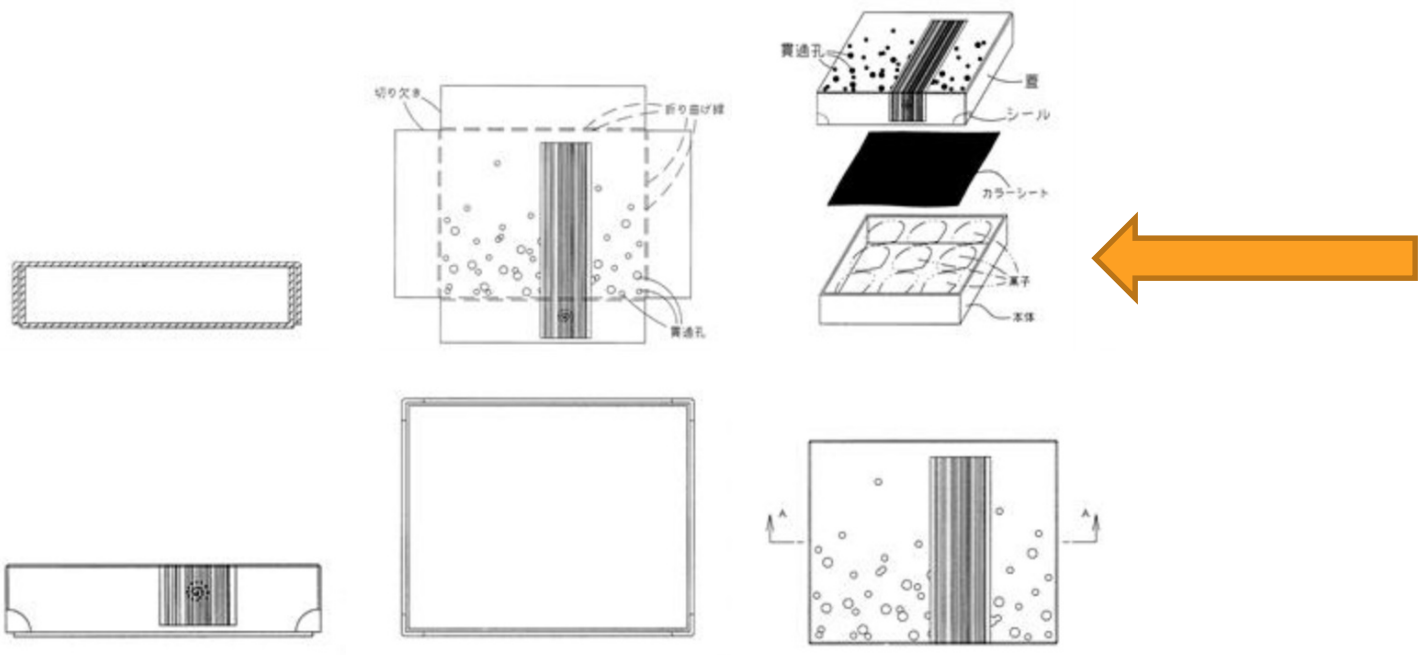
- Others include **Canada**, the **US**, **KR***, and **Great Britain****.
  - (* Korea uses what appears to be a version of the Japanese system.)
  - (** The GB system is recently abandoned, but is still useable.)

- Japan also has a good online Design Search Tool: **J-PlatPat**
  - (However, the Japanese and English versions vary. And their internal system has different results than the external public systems.)

- “Finding” oriented queries can locate low-lying-fruit and lead to the proper classification areas.

Search Step	Result(s)	Query
3	4003	(F4-711)/CLN AND (JP/CCDB)
2	17	(CANDY)/TI AND (09-01)/CL AND (JP/CCDB)
1	25272	(09-01)/CL AND (JP/CCDB)

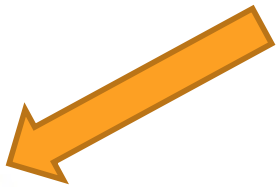
Reg. owner in original language	株式会社叶匠寿庵,
App. number	D2005-11444
App. date	2005-04-18
Pub. date	2006-05-29
Locarno	09-01, 09-02, 09-03, 09-04, 09-05, 28-01



Registration date	2006-04-07
Number of industrial designs	1
National class	F4-711
Main class	F4-711
Sub class	F4-711
Designation in English	Box of candy for the

Japanese Classification for Industrial Designs (2005)

F4—70	**Containers or the like**	Containers, Bottles for Packing, Cans for Packing, Boxes for Packing, Baskets for Packing, Squeezing Tubes for Packing, Ample for Packing, Containers of Revolving and Popping-Up Type, Containers with A Spray
F4—710	**Containers**	Containers, Bottles for Packing, Cans for Packing, Boxes for Packing, Baskets for Packing
F4—710A	with Patterns	
F4—710BA	Opening	*1 @1
F4—710BB	with Cover	*1 @1
F4—710BBA	with Cover (Hinge Type)	*1 @1
F4—710BBB	with Cover (Separable Type)	*1 @1
F4—710BBC	with Cover (Sliding Type)	*1 @1
F4—710C	with Knob	
F4—710D	with Window Section	
F4—710E	Assemble T+D386ype	
F4—710F	with Winding Tightener	
F4—710G	Oblong Type	
F4—711	**Containers (Rectangular Solid)**	Containers, Bottles for Packing, Cans for Packing, Boxes for Packing



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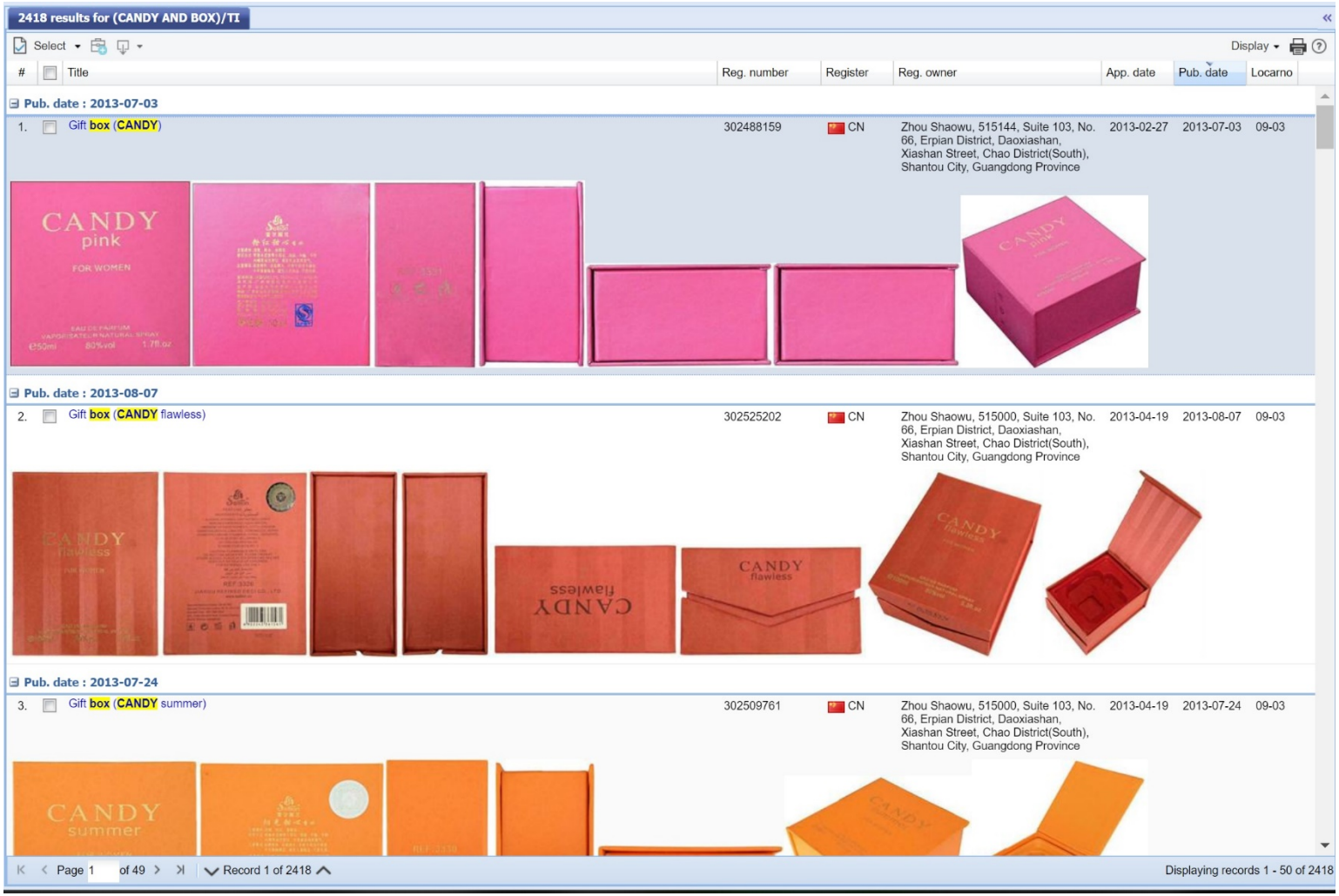
Tools and Databases

- The 800 pound gorilla is the Questel Orbit Design Finder.
- Presented to us at the PIUG Annual Conference in 2009 and currently the single best system available.
- Good data coverage with deep historical files and regular updates from most economically relevant countries.
- It has a fantastic multiple image viewing system with the ability to use a keyboard to “flip” through the art.
- Translations of all non-English details are included.

Questel Orbit Design Finder



Questel Orbit Design Finder – But…

- Only one major technical update in 10 years: the addition of an addressable search history and saved searches.
- No citation data for US Design Patents, even though this exists in the parallel Patent search engine. They do have all the old US Design Patents unlike many other systems!
- No linking to source documents.
- No uploading of documents or exporting in a useful format.

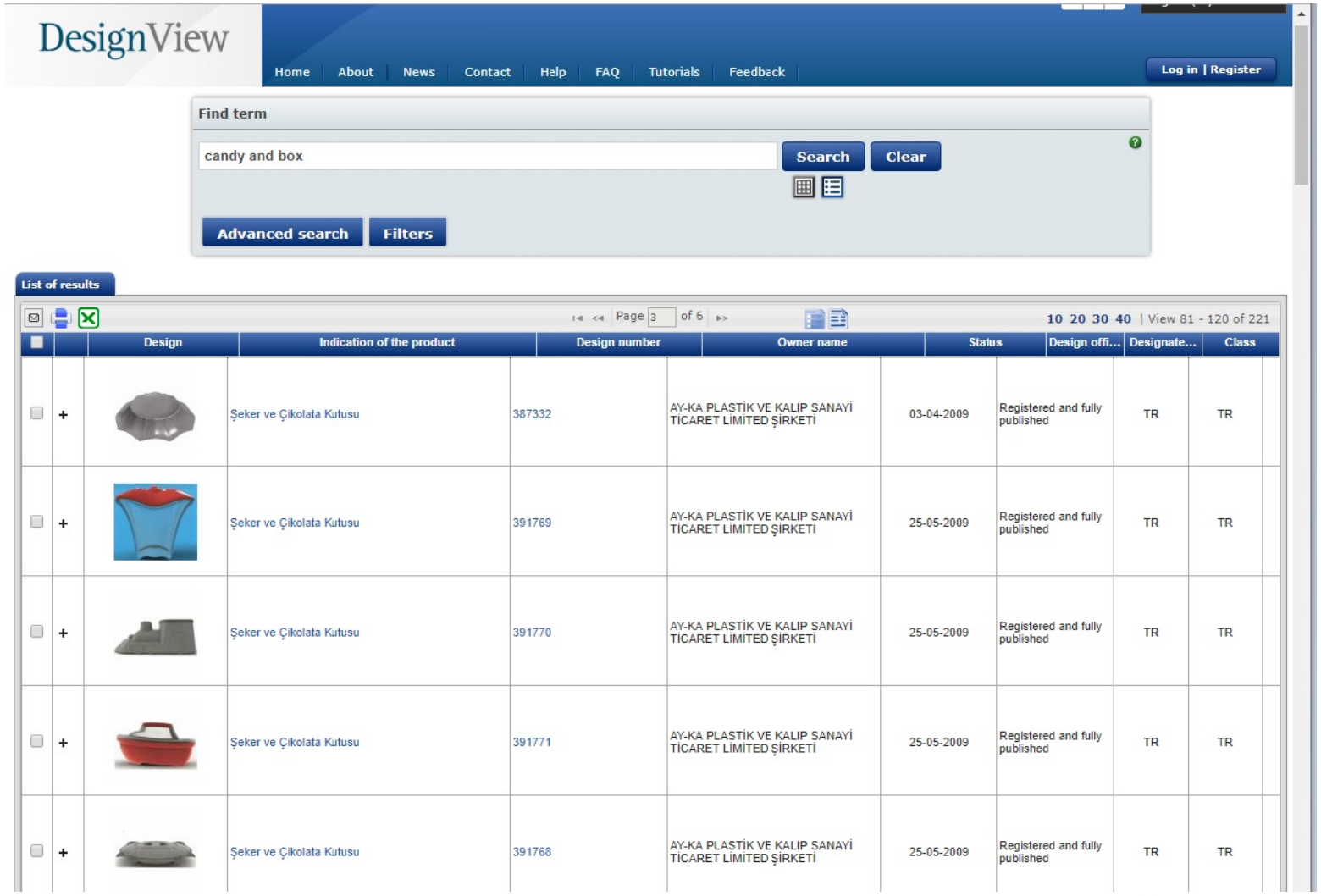
EUIPO – Design View

- Relatively new system and it is **FREE**.

- Governmental host, so generally less of a security risk than “free” third party commercial tools.
- Also has a deep historical file for many countries, but has gaps in coverage. (No pre-1976 US art.)
- Country coverage is different than Orbit coverage.
- No addressable search history or US citation data.
- Does link to the source documents (National Registers)!
- Only displays a single “representative image”.
- Has a parallel “automated image system”: **eSearch plus**
  - (for searching EU registrations only).

DEMARCOIP

EUIPO – Design View



Design	Indication of the product	Design number	Owner name	Status	Design offi...	Designate...	Class
	Şeker ve Çikolata Kutusu	387332	AY-KA PLASTİK VE KALIP SANAYİ TİCARET LİMİTED ŞİRKETİ	03-04-2009	Registered and fully published	TR	TR
	Şeker ve Çikolata Kutusu	391769	AY-KA PLASTİK VE KALIP SANAYİ TİCARET LİMİTED ŞİRKETİ	25-05-2009	Registered and fully published	TR	TR
	Şeker ve Çikolata Kutusu	391770	AY-KA PLASTİK VE KALIP SANAYİ TİCARET LİMİTED ŞİRKETİ	25-05-2009	Registered and fully published	TR	TR
	Şeker ve Çikolata Kutusu	391771	AY-KA PLASTİK VE KALIP SANAYİ TİCARET LİMİTED ŞİRKETİ	25-05-2009	Registered and fully published	TR	TR
	Şeker ve Çikolata Kutusu	391768	AY-KA PLASTİK VE KALIP SANAYİ TİCARET LİMİTED ŞİRKETİ	25-05-2009	Registered and fully published	TR	TR

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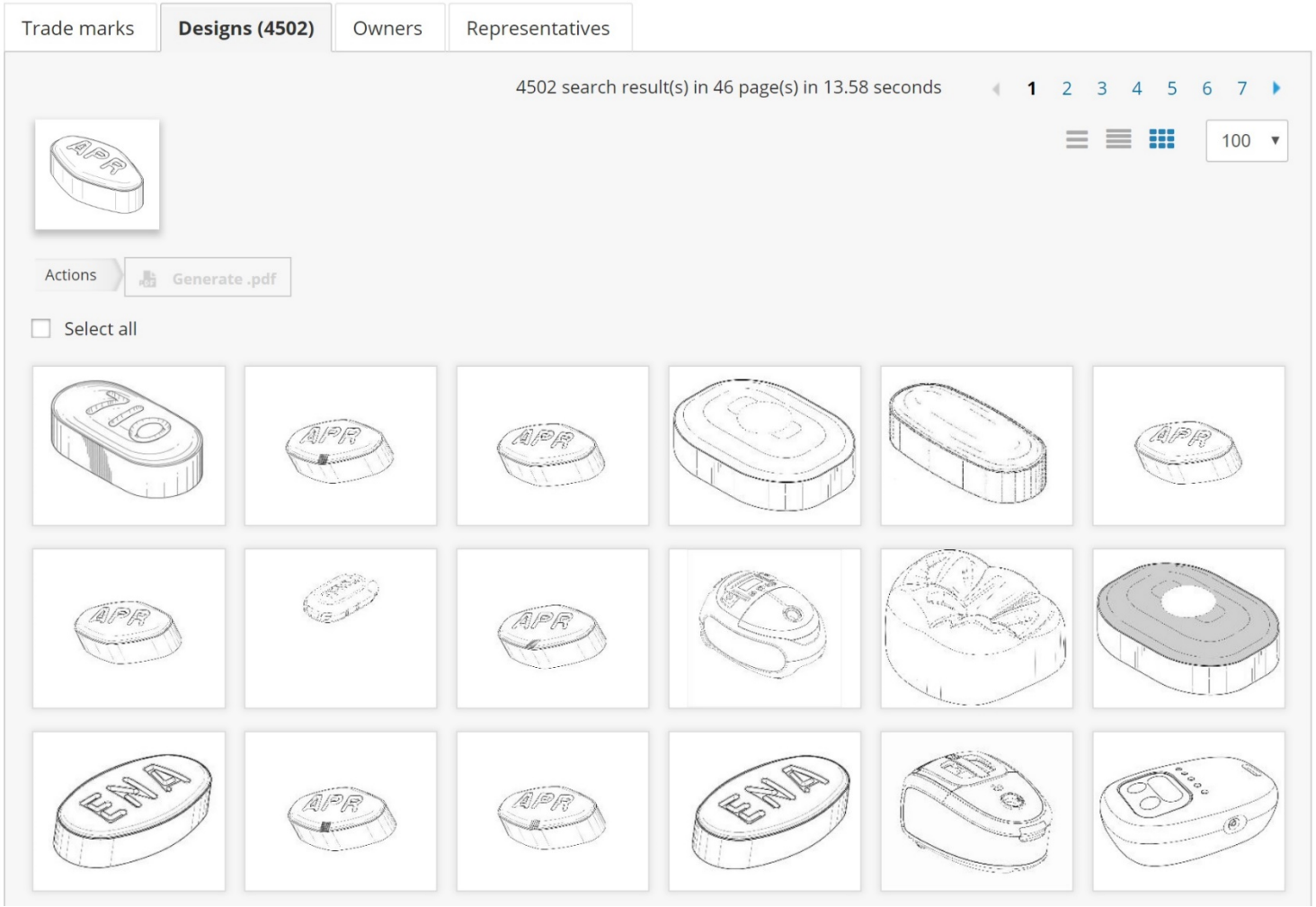
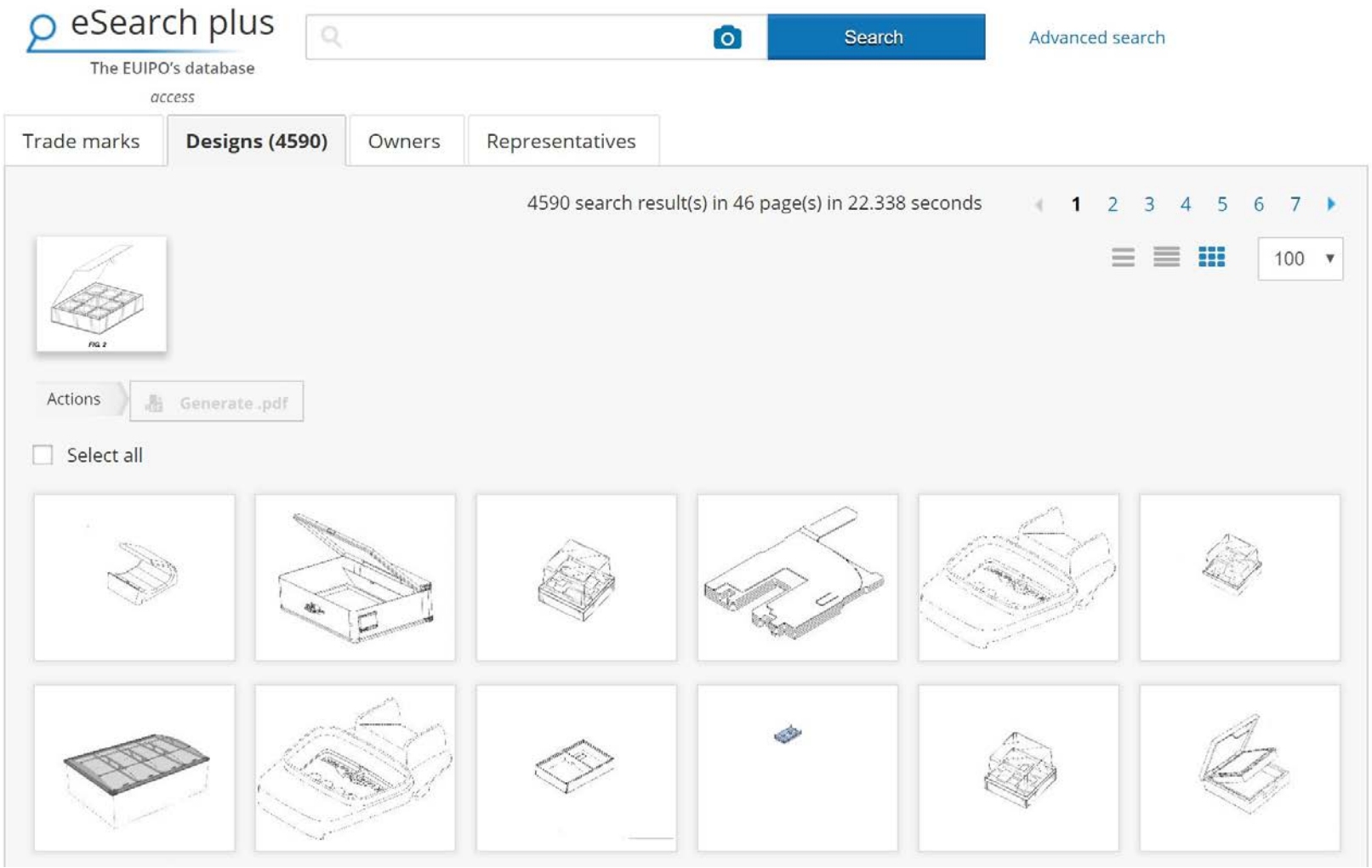
EUIPO

Automated system allows uploading of your image

EUIPO – eSearch plus



EUIPO – eSearch plus

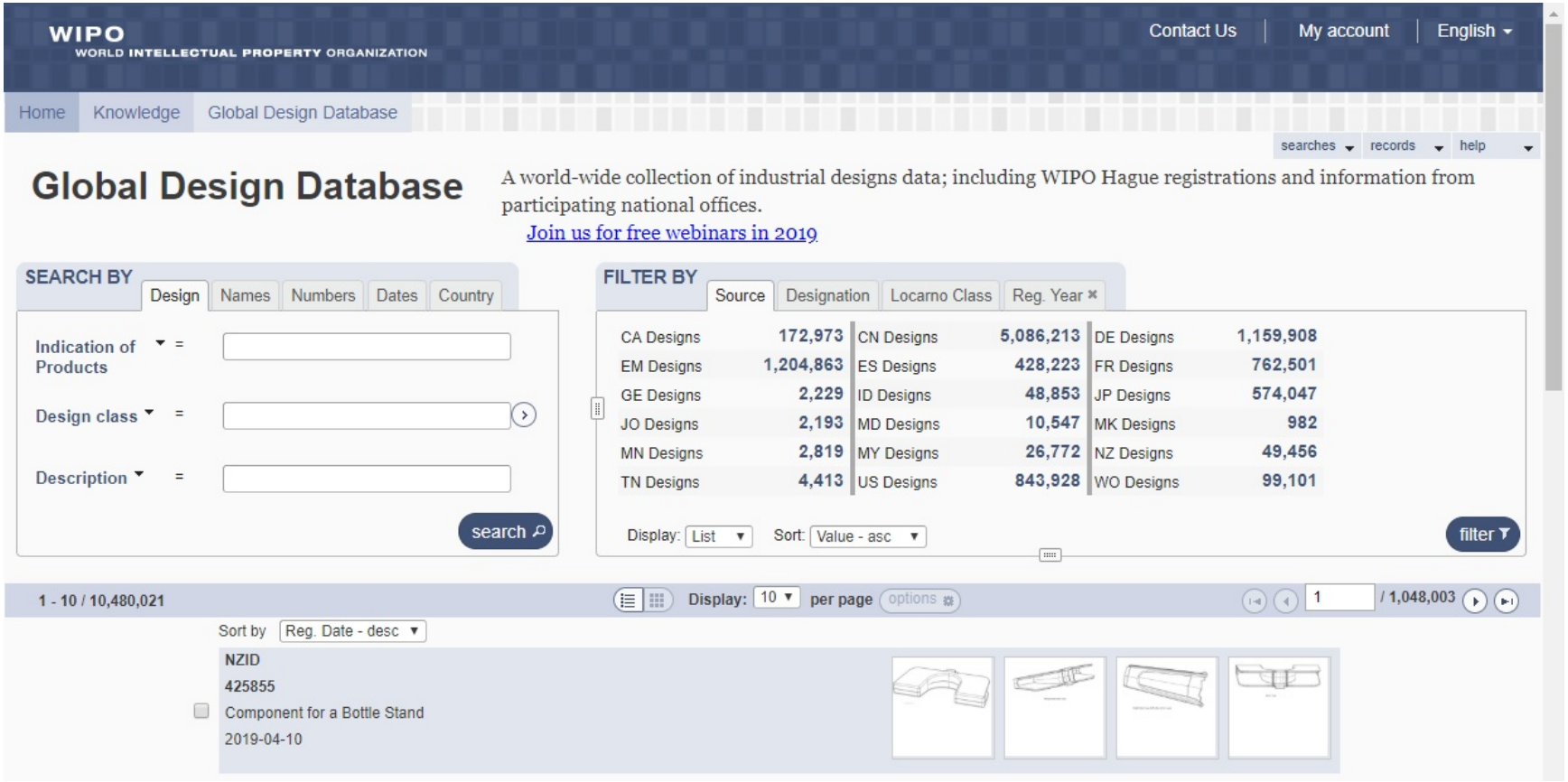


WIPO - Global Design Database

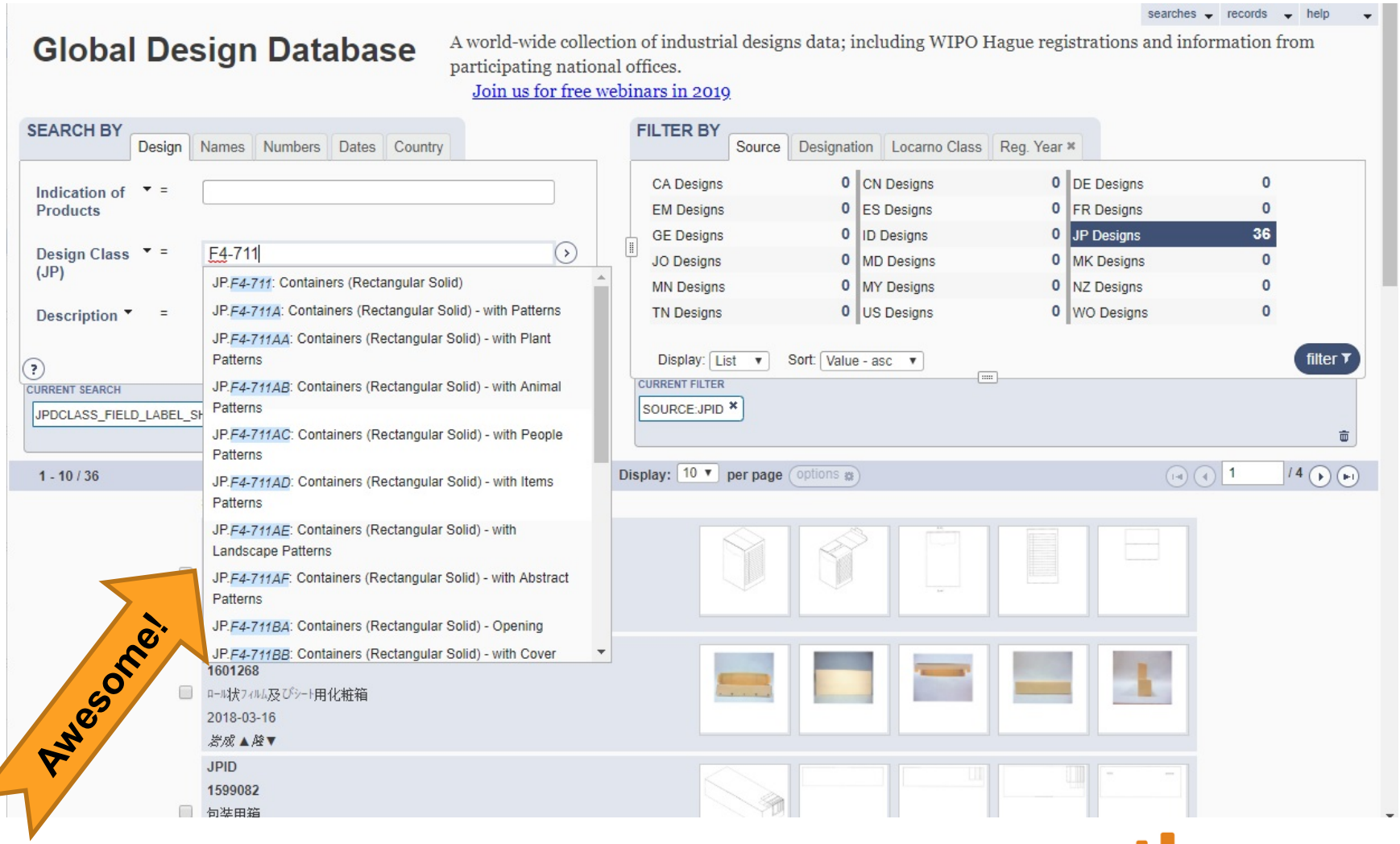
- Another relatively new system and it is also **FREE**.

- Again, a governmental host, so generally less of a security risk than “free” third party commercial tools.
- Less overall coverage than EUIPO, but has some different countries!
- Allows searching by National Classifications (CA, JP, US).
- No addressable search history or US citation data.
- Displays up to five thumbnails for each Design.
- Includes automatic language translation!

WIPO - Global Design Database

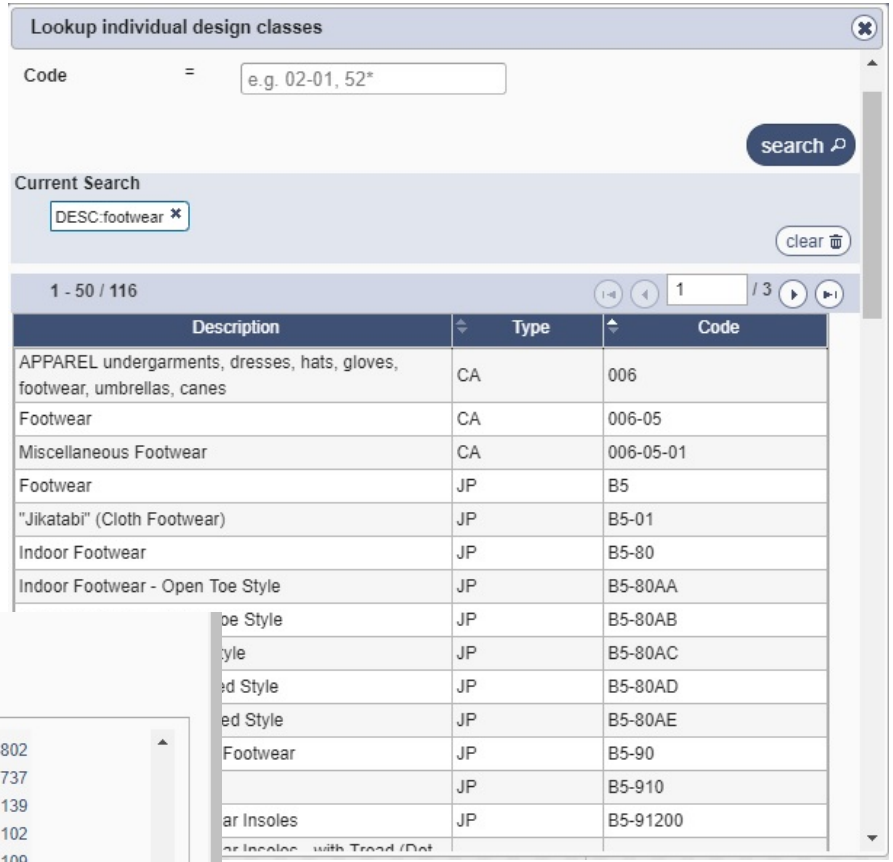


WIPO - Global Design Database

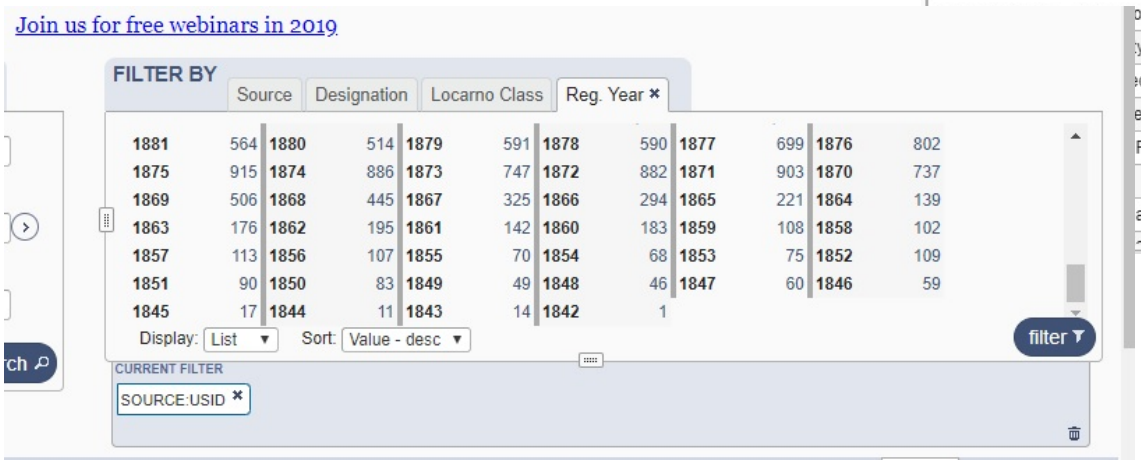


WIPO - Global Design Database

- Has a searchable index for the CA, JP, and US National Classification Schemes



- And has the old US art



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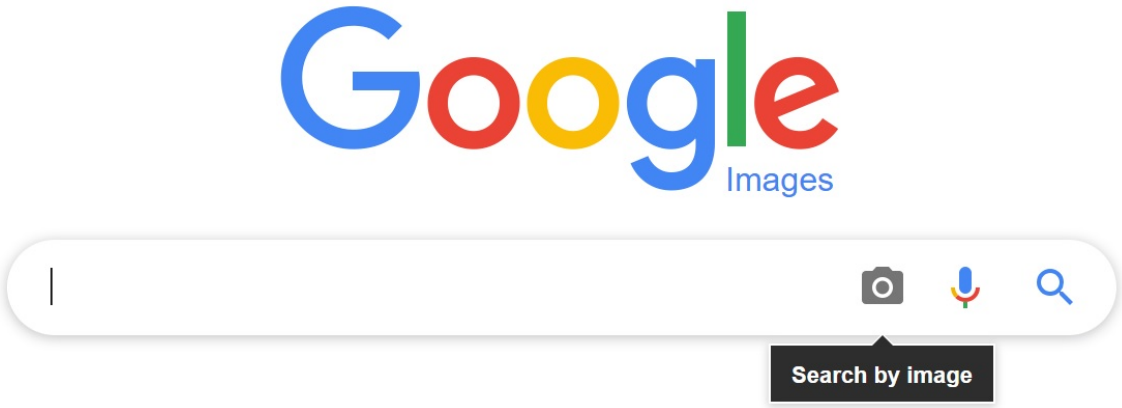
The Missing Link

- How do we search the “internet” for a Design?
- You can upload your potentially proprietary image into Google…



- And you can try sites like Etsy and Pinterest using text.
- But honestly, it’s a long shot.

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THANK YOU!
ANY QUESTIONS?

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