

Design Patents - What Game Developers Should Know

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By Eric Magleby, Forrest A. Jones, and Anthony D. Del Monaco

Intellectual property is critical to the gaming industry. With the push towards digital distribution, more so than ever a video game is at its heart a collection of intellectual property rights. Whether you work for a pillar of the industry or are just starting out as an independent game developer, everyone should have a basic understanding of what these rights are, and how they can impact your business.

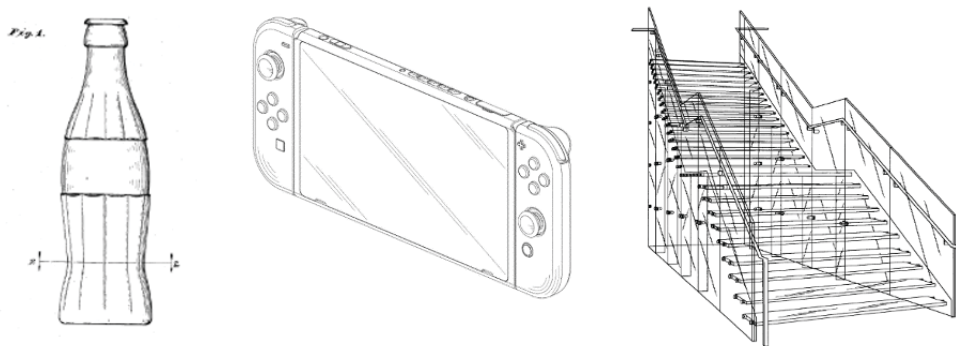
In the first of a series of papers exploring the basics of intellectual property law¹ and its application to the gaming industry, we discuss one of the less well-known types of intellectual property rights: Design Patents.

What Are Design Patents?

A patent is a constitutionally protected monopoly. As an incentive to spur innovation, the United States Patent and Trademark Office (USPTO) grants you a legal document establishing your right to exclusively control the use of an idea for a limited time. Although the public loses the opportunity to use your idea without permission in the short term, in the long-term, your industry and society as a whole benefit from the accumulated knowledge and an increased pace of innovation.

When most people think of patents, they picture a utility patent, which protects new and useful inventions (and will be the subject of another paper in this series). Design patents are different. As you might expect from the name, they protect new designs. While utility patents protect the way an invention works, or how it is used or made, design patents protect how something looks.

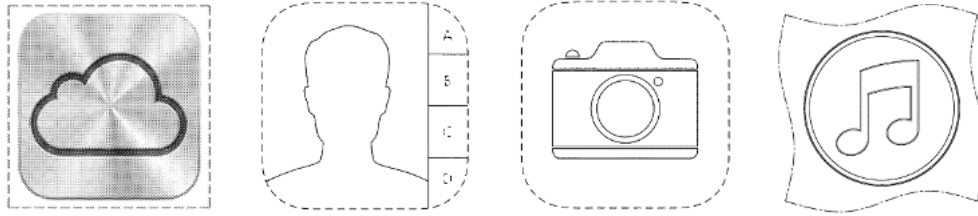
Whereas a utility patent includes lengthy descriptions of an invention in what is known as a “specification,” a design patent focuses on images. Many companies in a variety of industries use design patents to protect the look of their products, devices, and even the appearance of their facilities.



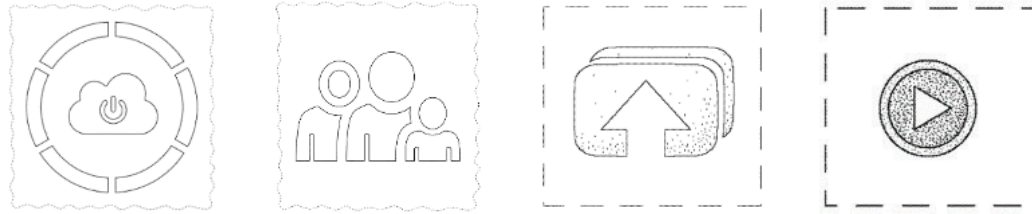
Design patents from left to right: Coca-Cola's bottle (D63,657), Nintendo's Switch console (D819,696), and Apple's staircase (D478,999)

Since 1992, the USPTO has issued many design patents for what it calls “computer-generated icons,” more commonly known as user interfaces or icons. Examples of these types of designs include application icons used to represent a mobile game on a phone home screen. In addition, companies obtain design patents to protect icons and portions of user interfaces displayed with their software. The USPTO has granted about 14,500 design patents classified as computer-generated icons, with about half of those granted within the past five years.

¹ Please note that this series of papers focuses on the intellectual property laws of United States. Other countries often have their own versions of these intellectual property rights, though the rules can be, and are usually, different. You should consider the laws of any country in which you plan to make, use, or sell your game when considering intellectual property protection. Further, for those located outside of the United States, if you plan on selling games within the United States, you should still become familiar with its intellectual property laws and seek out protection where appropriate. Foreign entities may obtain intellectual property protection in the United States.



Apple's design-patented icons from left to right: iCloud (D67,266), Contacts (D730,841), Camera (D726,765), and iTunes (D668,263).



Other design-patented icons owned by Microsoft and Google from left to right: D708,221, D746,867, D708,194, and D706,791

The icons and user interfaces do not necessarily need to be static. In fact, the USPTO provides guidance for patenting animated icons. Companies recognize that animations are distinctive to the look and feel of their software and worthy of protection.



Microsoft's animated user icon design-patent. D669,499.

How Can Design Patents Help My Company?

Design patents give you exclusive rights to stop others from making, using, or selling a product that uses the same or substantially the same design as in the design patent. This makes design patents a powerful line of defense against counterfeiters and copiers.

Despite spending significant time and money on game aesthetics, in-game icons, user interfaces, and animations, design patent grants in the gaming space are surprisingly low. This is likely because many are unaware that design patents are available and are more familiar with the long and more expensive process of obtaining a utility patent. However, obtaining a design patent is often faster and more cost effective. (In a future paper, we will discuss more economical approaches to obtain utility patents.)

Partly because they are less known, developers overlook the benefits of owning design patents. For example, in a crowded gaming marketplace, a successful game will spawn imitators seeking to copy the design aesthetics of the game, attempting to either replicate some of its success, or confuse patrons into thinking that their game originates from the same developer. Patenting eligible design features protects your success and maintains your visual distinction from copycats. This protection is important, particularly if you plan to support the game through updates for many years, or if you plan to release a sequel which may use the same design elements.

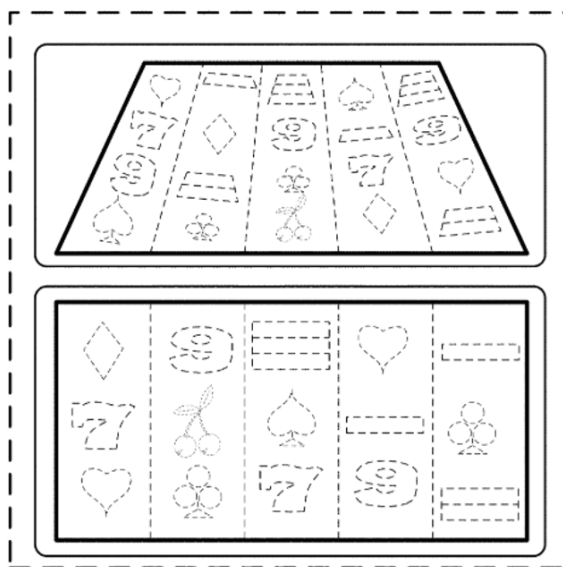
In addition, the actual process of obtaining a design patent itself can be useful. To obtain a design patent, the USPTO will search for and identify similar existing designs. This process provides a better idea of what designs others apply for, and helps you craft a more unique (and thus, recognizable) design. This knowledge reduces the risk of unforeseen legal expenses down the road in case your design resembles too closely another company's design. It also helps developers understand where they should focus their products to optimize protection with investment in development. And, once you establish your IP, you obtain peace of mind that future development on a related product may also be protected.

Please be warned: Applicants should not wait to submit a design patent application. The USPTO will reject applications for designs disclosed to the public by the applicant more than one year before submission. Waiting also allows competitors time to file their own applications, which may end up being granted priority. To ensure applications are filed in a timely manner, applicants should consider their patenting opportunities early, as designs are developed.

What Is the Process for Obtaining a Design Patent?

To receive a design patent, an applicant must submit their application to the USPTO and engage in a back-and-forth examination (or prosecution) process (both terms are used) with a patent examiner. Throughout this process, a patent examiner scrutinizes an application and compares it with any products or documents already known or published ("prior art"). Usually this involves an examiner rejecting an application for not meeting legal requirements and the applicant sending amendments and/or arguments in response. When the applicant satisfies the examiner that an application is acceptable, the examiner allows the application to issue into a granted patent.

For design patents, the examination process usually lasts about two years and tends to focus on drawings using solid and broken lines. Solid lines denote design elements within the drawing that are claimed and protected under the issued design patent. Broken lines refer to other features of the design, such as the environment or other features that do not make up part of the claimed design but provide context or a boundary to the claimed part of the design. Together, the solid and broken lines should provide enough clarity and disclosure that a patent examiner understands the design as a whole. The examiner will compare these drawings to previous designs, to decide whether a design is new and not an obvious variant of prior art. An applicant may need to amend drawings, for example by changing broken lines into solid lines to show an examiner that the claimed design qualifies for patenting over prior art.



Line drawing from U.S. Design Patent No. D793,409, *Gaming apparatus having display screen or portion thereof with graphical user interface*

How Are Design Patents Enforced?

A design patent expires 15 years from the date the USPTO grants the patent. During that time, you, as the owner, have the exclusive right to use the design. During the life of the patent, if someone else uses the design without your permission, you may initiate a lawsuit in federal court against the infringer, usually for financial compensation or an injunction. The court's attention in a design patent infringement lawsuit focuses on the line drawings of the granted patent, and a product copying the solid lines can be the basis for infringement. The amount of compensation varies based on the circumstances of a case, but can be substantial. In 2018, a Jury awarded Apple over \$500 million in damages for Samsung's infringement of its iPhone design patents. With an injunction, a court may decide an infringer is not allowed to take a particular action that would result in future infringement.

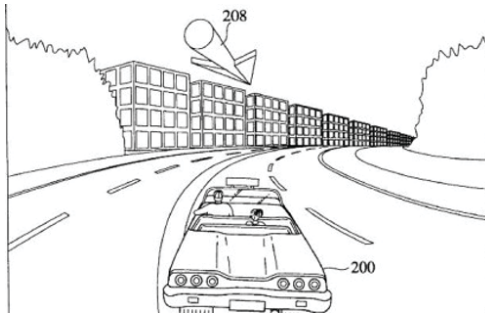
Patent owners, however, do not enforce most design patents in court. Instead, they frequently leverage the patents to negotiate settlements with competitors, or force competitors to change their designs through sternly-worded letters. Often, patent owners seek to stop infringing designs as early as possible or leverage a licensing agreement for royalties before a lawsuit becomes necessary. They do this by marking products with design patent numbers (or "patent pending" if the patent is not issued yet) and sending letters to infringing

competitors informing them of their patent rights. Putting competitors on notice not only encourages early compliance but has the potential to increase damages in a lawsuit if a competitor chooses to infringe anyway.

In fact, a design patent owner does not always need to take affirmative enforcement actions for the design patent to be useful. All issued design patents are registered with the USPTO and searchable. If the design patent exists, a competitor applying for a design patent will need to avoid those designs, as they are prior art for any future designs.

How Can My Company Look for Design Patenting Opportunities?

In evaluating how design patents may be useful, developers should look at what is innovative and exciting about their products, both from a developer and end-user perspective. Notwithstanding whether or not an underlying process or software in a product can be protected with a utility patent, there are often graphics or animations related to the process that are eligible for design patent protection.



Drawing from U.S. Patent No. 6,200,138.

A strategic design patent for a graphic linked to innovative game mechanics can be almost as powerful as patenting the mechanic itself, but with a decreased investment of time and money. Consider, for example, a drawing found in U.S. Patent No. 6,200,138 above, which was also the subject of a mid 2000s lawsuit between the makers of Crazy Taxi and The Simpsons: Road Rage. The USPTO considered the arrow (labeled 208) used to help players navigate a driving game a patentable invention. The arrow's shape, placement, or animation, however, may have also been eligible for design patent protection. This alternative would have broadened the patent owner's scope of protection by preventing competitors from using different underlying processes to produce a similar arrow, making the game feature more distinctive in the market.

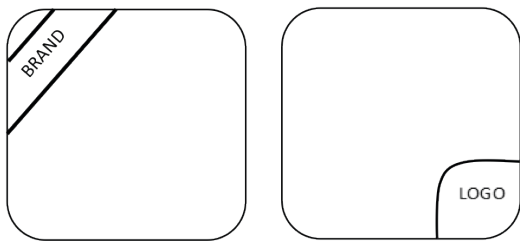
Developers should consider what icons, animations, or portions of a UI are likely to be reused in future titles or within a franchise. Are there icons or animations that players associate with a product? Are there unique on-screen heads-up-display (HUD) or other graphics that makes the game more immersive? If developers protect these design elements early on, they may maintain the benefit of an IP investment over the 15-year life of a design patent. In addition to protecting a current product, this protection may provide for future development.



Example of in-game HUD designs potentially eligible for design patent protection.

Developers who feel they have missed patenting opportunities in the past can also look to how they improve design elements. Improvements implemented in new products or sequels can be considered new and non-obvious over prior designs. In protecting iterations of a design, developers may protect design assets as they evolve, building a portfolio of design patents that work together to broaden and lengthen IP protection.

In a broader context, developers should also consider design elements used across products as candidates for design patenting. Although using logos and branding to mark products is the territory of trademark protection (the topic of another forthcoming white paper), companies can also potentially obtain a design patent on an icon or animation incorporating a logo. This approach leads to broader and more efficient protection against competitors or copycats. Obtaining a design patent on a branding design can also be cost-efficient because it protects a future game regardless of whether the new game shares a design language with previous products.



Generic examples of branding and logo icons that may be design-patent eligible under USPTO requirements.

Finally, developers should consider consulting patent attorneys who understand the legal requirements for obtaining a design patent. In addition to helping developers understand what designs may or may not qualify for patent protection, a good patent attorney will help developers recognize patenting opportunities early in development, providing protection with optimal timing while also satisfying developers’ business objectives.

Related Professionals



Anthony Del Monaco’s practice involves all facets of intellectual property law in a wide spectrum of technologies. He focuses on patent litigation, primarily before U.S. district courts and the U.S. International Trade Commission (ITC), and arbitrations. His practice also includes inter partes reviews (IPRs), opinions of counsel, patent and trademark portfolio development, and complex licensing issues.

Anthony D. Del Monaco, Partner
Washington, DC
+1 202 408 4023
anthony.delmonaco@finnegan.com



Forrest Jones focuses on patent litigation, including at the ITC, as well as IPR proceedings before the Patent Trial and Appeal Board (PTAB) and appeals before the U.S. Court of Appeals for the Federal Circuit. He has technical and legal experience in various areas of electrical and computer engineering, including computer software, signal processing, wireless networking, power electronics, power generation, and consumer electronics such as televisions, laptop computers, smartphones, and gaming systems and technologies.

Forrest A. Jones, Associate
Washington, DC
+1 202 408 4019
forrest.jones@finnegan.com



Eric Magleby focuses on patent prosecution and client counseling in the automotive, robotics, and consumer products industries. Eric’s prosecution experience covers numerous products in a variety of fields, including the automotive, consumer products, manufacturing, medical device, robotics, and sports and recreation industries. He advises clients through various stages of patent application prosecution, including drafting, responding to office actions, and examiner interviews. He also advises clients in infringement and invalidity claims.

Eric Magleby, Associate
Washington, DC
+1 202 408 4365
eric.magleby@finnegan.com