



## Design Patent Protection for Computer Generated Icons and Graphical User Interfaces

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Recent patent cases have made it more difficult to obtain utility patent protection for some of the functional aspects of computer software. One way to, at least partially, overcome this is to consider design patent protection for computer generated icons and certain aspects of the graphical user interface (GUI) elements of a computer program. Strategic use of design patents can be an important part of an overall patent strategy. It should be noted, however, that design patents are not meant as a replacement for utility patents, but rather, as a supplement to them.

At a high level, a “utility patent” protects the way an article works and is used (35 U.S.C. 101). In contrast, a “design patent” protects the way an article looks (35 U.S.C. 171). Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance.

Utility patents cover inventions containing a “new and useful process, machine, manufacture, or composition of matter, or a new and useful improvement thereof.” They can protect both the *functional* aspects of a GUI and the user interactions with the GUI.

Design patents cover the “new, original, and ornamental design embodied in or applied to an article of manufacture.” They cover novel, non-obvious, and non-functional designs. A design patent protects *only* the appearance of the article – not its structural or utilitarian features. Design patents can be obtained for computer generated icons, including GUIs and GUI elements. This is particularly important because a sequence of computer generated icons—including images that change in appearance during viewing—may be the subject of a design patent claim. This enables coverage, for example, for dynamic icons, a sequence of screen displays and more.

See Attachment A for examples of well-known design patents for GUIs, GUI elements and GUI sequences.

## Cost

Design patents are often cheaper to obtain than utility patents. Unlike utility patents, which require lengthy and costly detailed written descriptions of the invention, most of the labor costs for preparing a design patent application are attributed to attorney strategy and drawing preparation. Additionally, patent prosecution costs are typically lower for design patent applications than for utility patent applications because the patent examiner rejections are often less complicated to overcome.

## Are Design Patents Valuable?

They can be.

In one of the more high profile cases, Apple won a \$533 million dollar jury verdict in 2018 for infringement of design patents on iPhone and iPad designs. While this outcome is not typical, it demonstrates that design patents have teeth.

With utility patent infringement, damages are typically measured by a reasonable royalty or the patent owner's lost profits. With design patents, damages can extend to recovery of the total profits made by the infringer. 35 U.S.C. § 289. This can lead to significant damage awards.

An important decision on the scope of design patents was rendered in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc). This decision makes it more difficult to "design around" a design patent by changing trivial aspects of the claimed design. As a result, to avoid infringement, the differences between the accused product and the claimed design must be *more* than insignificant.

## How to Consider Potential Design Patents

The best way to consider which aspects of your GUIs may be eligible for design patents is to assess any unique display aspects of your software. This can include:

- the overall layout of a UI
- one or more portions of a UI
- individual icons or display elements
- animated display elements
- sequences of UIs

In each case, the potentially protectable feature(s) must be: (1) new, (2) non-obvious, and (3) non-functional. To be new, it must be something that is original. The test for non-obviousness is more legally complex and it is best to discuss with your patent attorney. Lastly, to be non-functional the design must cover the way the display looks, not what it does (i.e., the functionality). However, this does not mean you cannot obtain a design patent for the ornamental aspects of something with a unique function. Often, we obtain a design patent for the way something looks and a utility patent for the way it functions.

When communicating these potential ideas to your patent attorney, it is often helpful to provide copies of the UIs and a bullet point summary of the individual screens, elements or sequences you believe might be eligible for design patent protection.

The following is a comparison of some characteristics of utility and design patents:

	Utility Patents	Design Patents
Scope	New and useful process, machine, manufacture, or composition of matter, or a new and useful improvement thereof	New, original, and ornamental design embodied in or applied to an article of manufacture
Term	20 years from the earliest claimed U.S. filing date	15 years from the date the patent is granted
Maintenance Fees	Maintenance fees are due 3.5, 7.5 and 11.5 years after issuance	No maintenance fees
Foreign Priority	One year from first filing to claim foreign priority	6 months to claim priority
Claiming benefit of a provisional application	Yes	No
Published Prior to Issuance	Published within 18 months of earliest filing unless non-publication requested	Not published prior to issuance

## Conclusion

Where available, utility patents remain valuable. Strategically considered design patents are also a valuable component of an overall IP strategy. When assessing the patentable features of your software, design patents should not be overlooked.

**For further details on design patents, please contact:**



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## Attachment A

### Examples of GUI-based Design Patents

The following are examples of well-known design patents for GUI-related designs.

#### Apple D675,639 - slide to unlock feature

[patents.google.com/patent/USD675639S1/en](https://patents.google.com/patent/USD675639S1/en)



FIG. 2

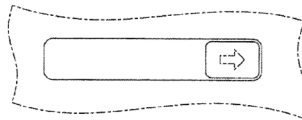


FIG. 4

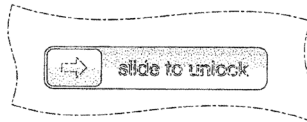


FIG. 5

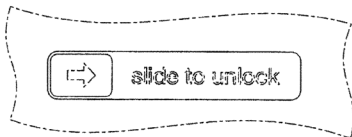


FIG. 3

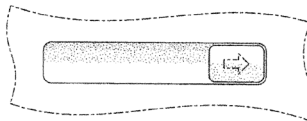


FIG. 6

#### Samsung D701,228- layout for video chat

(Note sequence of images for how screen layout changes)

[patents.google.com/patent/USD701228](https://patents.google.com/patent/USD701228)

FIG. 1

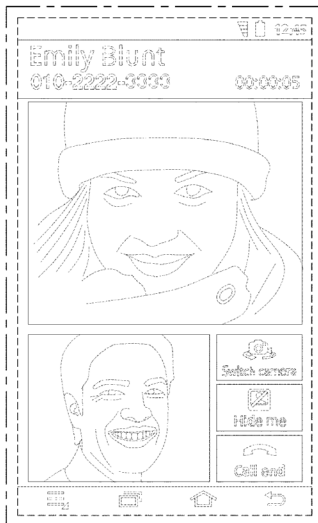


FIG. 2

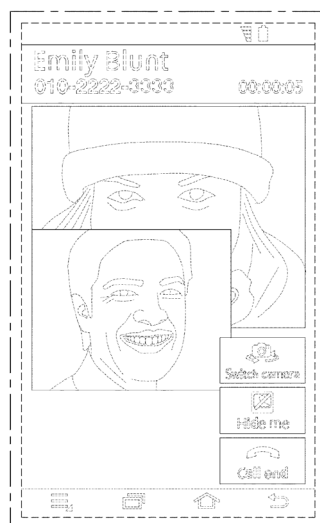


FIG. 3

