

Automotive Design Patents: Best Protection Strategies

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The U.S. is the world's second-largest market for vehicle sales and production. To stay competitive in this multibillion-dollar industry, automotive manufacturers must strategically obtain valid and enforceable design patents against other infringing car manufacturers and companies that create toys and replicas of their big-ticket investments. To accomplish this, car manufacturers often claim various articles of manufacture, using combinations of the terms “replica,” “toy,” “model,” as well as “vehicle.”¹ Other times, these same companies use only the term “vehicle.”² Not surprisingly, the PTO tends to examine these claims differently, depending on the specific language submitted. As one might expect, some design patents that claim to be both a “vehicle” and a “toy” are examined using art from both the vehicle category (D12) and the toy category (D21)³. However, other claims that include “toy” or “replica,” which do not cite any art from the “toy” category, only list the “vehicle” category (D12) as the field of search⁴. As a result, some patents claiming multiple articles of manufacture are only being examined as if they claimed one, giving these manufacturers all the benefits of two or more articles, with none of the additional burden of prosecuting them.

Based on current case law — which narrows design patent infringement to only the claimed article of manufacture — it seems that car manufacturers that cite several article groups at once optimize their design patent claims, while those that only claim a “vehicle” forfeit their ability to bring suit against toy manufacturers that replicate their designs. However, it is also possible that many of these design patents may be invalid since an examination of all of the article groups may uncover damaging prior art. That said, as long as the patent office continues to allow such claims, there seems to be a strong advantage to continuing to claim multiple articles of manufacture.

Lastly, clients wishing to protect their design from uses in models, replicas, and toys via claiming multiple articles of manufacture should do so cautiously. As long as the examiners allow it, this practice brings clear benefits in enforcement. A word of warning though. Since restriction requirements governing multiple patent claims fall under the discretion of the patent examiners, applicants should be careful not to claim too much up front. If an applicant tries to claim a large group of articles or otherwise seems to overplay its hand, an examiner can restrict the article of manufacture and force the applicant to narrow the claim, which may result in applying prosecution history estoppel and imposing litigation consequences if applicable.

For more information, please contact Kilpatrick Townsend Intellectual Property Partner and Co-Chair of the multidiscipline Retail & Consumer Group **Babak Kusha** at 415.273.7512 | bkusha@kilpatricktownsend.com.

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¹See e.g., U.S. Patent Des. 468,238 (Porsche 911), U.S. Patent Des. 759,543 (BMW X4).

²See e.g., U.S. Patent Des. 445,725 (BMW 3-Series).

³See, e.g., U.S. Patent Des. 449,254 (A toy vehicle (U.S. Patent Des. 366,295) was cited as art for the Porsche GT design patent).

⁴See, e.g., U.S. Patent Des. 473,165 (Rolls-Royce).

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