

IP Frontiers: Design patents should be in every portfolio



By **KRISTIAN ZIEGLER, ESQ.**

A patent confers the right to exclude others from making, using, offering for sale or selling an invention, as recited in the claims of the patent, within the jurisdiction or from importing the invention into the jurisdiction in which the patent is obtained.

When most people think of patent protection, they typically think of the most common type of patent — a utility patent. A utility patent protects the functional advantages of a particular machine, article of manufacture, composition or process. Utility patents are focused to the components or features of an item, or the way an item is used or works, without regard for how the item looks. Utility patents thereby provide broad relatively coverage.

A design patent, which is the lesser-known and relatively narrower cousin of the utility patent, is quick, easy and inexpensive to obtain (as compared to a utility patent). A design patent covers the appearance of an object. To quote the United States Patent & Trademark Office, a design patent covers “the visual ornamental characteristics embodied in, or applied to, an article of manufacture.” A design patent protects only the ornamental appearance of an article, not the article itself or the way it functions — a design patent does not protect functional features. A design that is dictated primarily by the function of the article lacks the legally required “ornamentality” for a design patent, and is therefore not patentable.

Utility patents have a 20-year term from their earliest priority filing date, while design patents are afforded a 15-year term from issuance (the 1995 Uruguay Round Agreements Act extended the design patent term from a 14-year term). Applications for utility patents are typically published promptly after the expiration of 18 months from the earliest filing date from which benefit is sought, but only issued design patents are published (they are kept confidential until allowance and issuance).

Due to the perceived lower value of design patents, fewer design patents than utility patent applications are filed annually. Since the first design

patent was issued to George Bruce for a typeface in 1842, only about 900,000 design patents have been granted in the U.S., compared with more than 10.5 million utility patents.

However, the sways of design patent case law over the past 15 years have afforded design patents, and their respective owners, more protection. These shifts in case law have elevated the value of design patents such that they should be a component of every IP portfolio.

For example, in the 2008 *Egyptian Goddess v. Swisa* case, the Federal Circuit ruled that so long as two designs are “substantially similar” in overall appearance to an ordinary observer in light of the subject designs and the prior art, minor differences are irrelevant and the product infringes the patent. The test for determining whether an infringement has occurred requires the courts to consider the accused product and the patented design and whether the two look substantially similar. More specifically, infringement occurs if an ordinary consumer would mistake the accused product for the patented design in the context of the relevant prior art. Under this rule, an “ordinary consumer” is an individual who is aware of the relevant prior art, rather than a wholly uninformed person. Although design patents do not protect the functional aspects of a design, a design patent claim may involve both functional and nonfunctional elements. Provided that the primary design or appearance is not dictated by its functional aspects, the design claim is valid even if certain claimed elements have functional purposes.

Following the legal trends, the number of design patent application filings has steadily risen since the global economy recovered from the 2008 financial crisis. In fact, design patent applications have constituted a greater proportion of the total patent number of application filings during this time period, especially after the 2016 US Supreme Court decision in *Apple v. Samsung*, where design patents played a big role. The second *Apple v. Samsung* damages trial ended in staggering damages: a \$533 million verdict for infringement of Apple’s design patents, but only a \$5.3 million verdict for infringement of Apple’s utility patents.

Design patent owners can obtain the same remedies as for utility patents — damages, attorney’s fees, and injunctive relief. But the Patent Act provides for an additional remedy specifically

for design patents — an award of an infringing defendant’s profits from sales of an “article of manufacture” that bears the design protected by the design patent (35 U.S.C. § 289).

There are subtle, but important, distinctions between design patents and other non-patent forms of intellectual property protection that may protect the look of an item. While both design patents and copyrights cover aesthetic features, copyrights generally cover expressive works like paintings and sculptures. Copyrights can extend to utilitarian articles, but only to the extent the aesthetic features exist independently from the item. Some ornamental items may be protected by trademark or trade dress. To infringe a trademark or trade dress, an infringing item, which constitutes the trademark itself, must be likely to cause confusion relative to the origin of the item to the public. This analysis takes into account the similarity of items actually sold, as well as other factors, such as which consumers buy the products, the cost of the products and the channels of trade. Trademark/trade dress protection is also available without formal registration. It is thereby possible to obtain overlapping coverage from copyrights, trademarks/trade dress, design patents and utility patents for the same product.

I encourage every brand owner to consider the value of incorporating design patents into their IP portfolio — especially those who offer products with a specific appearance and/or distinct aesthetic features. Design patent protection can extend well beyond the traditional end-consumer product markets often envisioned. It is also common to obtain design patents for product variants, components and portions thereof. Multiple design patents can provide a valuable means of recovery in litigation, and filing and claiming strategies can provide significant breadth and varying scope to strongly enforce a claimed design.

Kristian E. Ziegler is an associate with the law firm of Heslin Rothenberg Farley & Mesiti P.C. specializing in patent preparation and prosecution. He has experience in developing and managing patent portfolios for businesses ranging in size from solo inventors to large corporations. Kris can be reached at (518) 452-5600 or at Kristian.Ziegler@hrfmlaw.com.