

## **Design Patents: An Intellectual Property Sleeper**

*An Effective and Under Exploited Area of Intellectual Property Protection*

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The U.S. patent laws provide for the protection of the ornamental appearance of "articles of manufacture" by way of design patents. Design patents are examined and granted by the U.S. Patent and Trademark Office (PTO), and confer upon the owner the exclusive right to make, use, sell, offer to sell or import into the United States, products covered by the design patent for fourteen years from the grant date. Design patents are distinguished from copyrights and trademarks in that they are of shorter duration, but provide an array of monetary remedies as well as injunctive relief. In addition, design patents offer an infringement determination consisting of a legal test without the need for evidence of confusion or a showing of access or intent.

Design patents are granted for many types of products and can generally be thought of as protection for product or industrial designs. By way of example, industrial design calls to mind the work of Henry Dreyfuss who, as consultant to Bell Telephone Laboratories, designed some familiar products. Among them is the Bell Trimline rotary dial telephone with the streamlined combined handset and dial in one piece with a separate stand. There is much that is functional about that design, but there is also an elegance to the form, an ornamental and aesthetic aspect to it. This is particularly true when the Trimline telephone is compared with the telephones that came before it. It is that ornamental aspect that would be protectable by a design patent.

Other examples of familiar products which have been design patented include a Porsche 911 sports car, a Gibson electric guitar, Lockheed-Martin's unmanned aircraft, and Colgate-Palmolive's liquid detergent bottle. Most people will be able to visualize these products. This is a sign that these designs leave a striking visual impression which contributes to their commercial success.

In short, the appearance of a product is part of the reason people buy it. Products that are strong candidates for design patent protection are ones that answer the question: What do people buy because of how it looks?

### **WHAT IT GETS YOU**

The basics of design patent enforcement are the same as that for utility patents which cover inventions: find an infringer, warn the infringer, try to settle the matter, and take the infringer to federal court if necessary. Infringement entails the unauthorized making, using, selling, offering for sale or importing into the U.S., products covered by the design patent.

A unique aspect of design patent enforcement is that in addition to the traditional remedies of injunction, recovery of lost profits or reasonable royalty, the patent owner can opt to pursue the profits of the infringer. What's more, in recovering the infringer's profits, the patent owner can recover the profits made by every infringer in the chain of commerce. This can mean potentially recovering the profits made by at least three parties: the manufacturer, the distributor, and the retailer/dealer.

While other forms of intellectual property provide some protection for the appearance of a product, an advantage of enforcing design patents is that design patent infringement is determined by applying a legal test. Essentially, the test is a comparison between the patented design and an accused product. If the accused product conveys the same overall visual impression and contains the patented features of the design, in particular, those features which set the patented design apart from what came before, infringement may be found. There is no requirement to demonstrate consumer confusion between the patented design and the accused product, and no requirement to show access to the patented design or

intent to copy. This eliminates the expense of burden of conducting consumer surveys or putting forth evidence of access or intent to copy.

Since the infringement inquiry consists of a comparison of the patented design to the accused product, with no required showing of intent, access or confusion, the issues of infringement and patent validity can often be raised in motions for summary judgment. Aside from being a tactical advantage for the patent owner and a settlement facilitator, this approach can reduce the cost of litigation by resolving these two threshold questions early in discovery and long before trial.

Enforceable design patents have teeth. With a design patent, the owner can recover monetarily, either traditional damages or the profits of the infringer, and obtain an injunction against a competitor to prevent manufacture and sale of infringing products. The ability to stop a competitor is a powerful tool in the marketplace.

## **PRODUCTS TO PROTECT**

Products for which design patent applications are being actively filed include automobile bodies, small appliances, personal implements like toothbrushes, furniture, clothing, shoes, computer equipment, telephones, fax machines, time pieces, toys, food and heavy machinery. What is surprising, however, is the number of companies and industries that should use design patent protection but do not. Many design-driven companies put a lot of creative effort into their products, but are absent from the list of design patent owners available through the U.S. Patent and Trademark Office.

For every furniture, housewares and electronics manufacturer active in the use of design patents, there are many more that create innovative designs and are not active enough. There are entire industries, jewelry for example, in which the amount of creativity outshines the amount of patent protection activity. People often buy jewelry almost solely because of how it looks, and new jewelry designs are continually introduced by a relatively small number of innovators. These new designs appear in less expensive versions made by a cottage industry of copyists much like couture design ideas in apparel eventually appear in ready-to-wear racks of clothing. Strategic design claims to the original products would give the patent owners an effective weapon against copying in any industry. Fourteen years of exclusivity in a design can keep copyists at bay and prevent them from reaping the benefits of the patent owner's investment in the design.

With so much creative effort and investment put into the design of products, it is surprising that a large number of innovative companies do so little patenting to protect their creations.

## **OBTAINING DESIGN PATENT PROTECTION**

Applications for design patents are filed with the U.S. Patent and Trademark Office and undergo an examination which includes completion of certain formalities and a search of prior published designs. Design examiners, who have art or design backgrounds, search prior patents and literature after reviewing the application. Once the examiner concludes that the illustrated design is new, original and ornamental, a design patent is granted. The process from filing to grant varies in time, but generally takes about two to three years.

Since a design patent is not enforceable until it is granted, the procurement process can be expedited in some circumstances. Expedited prosecution is useful for designs with short lived marketability or for industries with known copying activity. The time from filing to grant can be reduced to a matter of six to nine months with appropriate petitions and fees.

One issue to be aware of in design protection is that design claims consist of drawings of a product, and not words. Thus the design claim covers exactly what is illustrated in the context in which it is shown. Design concepts and leitmotifs, which are best communicated narratively, are generally not protectable with a single design patent. For instance, say a grouping of three kitchen canisters of different proportions are

designed with rounded corners, a single design patent could not cover the concept of canisters with rounded corners. Rather, each canister should be illustrated on its own and would properly be the subject of a separate design patent.

The preparation of the drawings is the focal point of the application and attorneys work closely with clients and draftspeople to formulate an appropriate claim. Patent attorneys with significant design experience can help craft a claim as broadly as possible, and disclaim features which are functional or not likely to be copied.

In the global economy, products are marketed around the world, and the intellectual property laws of most countries provide some sort of design protection. For many products, the procurement of design protection should be conducted simultaneously in all of the countries in which the product will be marketed or infringing manufacture likely. Due to international treaties, applicants for U.S. design patents are afforded some benefits when they file for corresponding protection outside of the U.S. Design patent laws are not uniform around the world, however, and can present problems to unwary applicants. The procurement efforts must be coordinated to ensure the broadest protection possible in each country and to avoid taking inconsistent positions regarding the same design.

An important timing issue is that design applications must be filed within one year of first public disclosure, publication or an offer for sale of the product sought to be patented. Failure to file a U.S. application within this grace period results in loss of potential patent rights. Timing is even more critical if the applicant intends to obtain design protection outside of the U.S. Publicly disclosing the design before any applications are filed can result in loss of rights.

Attorneys experienced with design patents can formulate a proper and effective design claim of a scope appropriate for the product and industry. Case law, both as to procurement issues with the PTO and as to enforcement issues in the courts, is evolving. Experience and knowledge of the laws and strategies play a major role in avoiding the pitfalls while obtaining the broadest possible design protection. A strong patent portfolio is the first key to a successful enforcement or licensing program.

Design patents provide effective protection with real enforcement potential for relatively low cost. The advantages are not yet recognized by companies which could add value to their intellectual property portfolio. In protecting creative designs for products, it's high time to rouse the sleeper.

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