Design Patents

When you think of patents and what they protect, you typically think of patents for apparatuses, products, or methods of doing something. Those types of patents are known as utility patents. For example, in a previous IP Corner article (Jan./Feb. 2009 HTP), we explained that a utility patent could cover a new alloy composition, a new machine for treating an alloy, a new alloy product, or a new method for processing an alloy. There are, however, two other “types” of patents: design patents and plant patents. This article explains what a design patent is, how to obtain one, and how it differs from a utility patent.

A design patent is intended to protect “any new, original and ornamental design for an article of manufacture” [35 U.S.C. § 171]. Put another way, a design patent is intended to protect the surface ornamentation or configuration of an object, or a combination of both. The claims of a patent define the scope of protection. Because a design patent concerns the visual aspects of an article, the invention is claimed using a collection of figures to illustrate the surface ornamentation and/or configuration of the article. In contrast, a utility patent claims an invention using only words to describe functional aspects.

Design patents are frequently employed to protect the ornamental appearance of consumer products such as shoes, golf clubs, and even media devices such as the iPod®. A company will seek design patent protection on a consumer product when the ornamental appearance of that product provides a commercial advantage over competitive products. In some instances, the ornamental appearance of a product may have as much value, if not more, than functional aspects of a product. In some instances, where there is value in both the function and the appearance of a product, the product may be protected separately by both a utility patent and a design patent.

By way of example, the appearance of a sneaker is frequently the subject of a design patent. Generally, the functional aspects of a sneaker are well known, but the overall appearance may have many different styles and may be the only feature that distinguishes that sneaker from a competitor’s sneaker. In view of this, a manufacturer will often invest heavily in design patents to protect the appearance of its sneakers. Nike, for instance, owns over 350 design patents covering various visual aspects of its sneakers, including the shoe upper and the shoe sole (e.g., Figs. 1 and 2).

Golf club heads, e.g., drivers, irons, and putters are another consumer product frequently protected by design patents (Fig. 3).

One of the most popular of all consumer products,
the iPod®, is covered by various design patents depending on the model, such as classic, nano, etc. (Fig. 4).

The basic components of a design patent are found on its front page (Fig. 5), including a single claim and a description of the figures. The single claim typically reads “the ornamental design for a ___ as shown and described.” The accompanying figures “show and describe” the ornamental design of the object. Because the intent is to protect the ornamental appearance of the object, a design patent typically includes a sufficient number of figures (typically 6 or more) to show all sides of the object. Because the figures define the scope of protection afforded by a design patent, they should be prepared with great care and with attention to how each detail is illustrated. The inclusion of unnecessary detail may limit the scope of the design patent and make it easier for a competitor to design around. Conversely, if too little detail is included, the Examiner at the U.S. Patent and Trademark Office (USPTO) may consider the ornamental design too broad in view of prior art and reject the application.

The cost for a design patent is substantially less than the cost of an average utility patent. For example, a design patent is less expensive to prepare because the application consists mainly of figures and minimal text. In contrast, a utility patent requires preparation of not only figures, but also a detailed written description of the invention, and a set of written claims. In addition, the filing fees and prosecution costs are less for a design patent application relative to a utility patent application. Finally, an issued design patent is not subject to payment of periodic maintenance fees, whereas periodic maintenance fees must be paid after a utility patent issues to keep it enforceable through its full term. The maintenance fees for a utility patent can be up to $7,500.

The term of a design patent is 14 years from the date it issues, whereas the term of a utility patent is 20 years from the date the application is filed. However, a patent cannot be enforced until the patent issues. Thus, no matter how long it takes to obtain a design patent from the USPTO, the term and the period of enforceability will still be 14 years from the issue date. In contrast, it takes 4 years for a utility patent to
grant, the utility patent will be enforceable only for the 16 years after it issues. Despite the lower cost for obtaining a design patent, the number of design patents issued on an annual basis is much lower than utility patents. In 2008, the USPTO granted 157,772 utility patents but only 25,565 design patents, or less than 14% of all patents issued. However, the percentage of design patents issued last year is considerably higher than the percentage of design patents issued in 1963, the first year the USPTO began to compile statistics for issued patents. In 1963, design patents accounted for only about 6% of all patents issued that year.

Early on, companies and individual inventors were reluctant to seek design patent protection because of the perceived difficulty in enforcing a design patent against an alleged infringer. Since the 1871 U.S. Supreme Court landmark decision on design patent infringement, the courts have struggled to define the scope of a design patent and to determine whether the appearance of an accused product is within its scope. In September 2008, the U.S. Court of Appeals for the Federal Circuit, the primary appeal court that interprets patent law, rendered a decision in a design patent infringement case that many believe breathed new life into the vitality of the design patent. See Egyptian Goddess v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008). The Federal Circuit followed the 1871 Supreme Court’s analysis, requiring that to prove infringement, the patent owner must show that an “ordinary observer” would be deceived into believing the accused product was the patented product when giving it the normal amount of attention under the circumstances. Expanding on the analysis, the Federal Circuit also requires a comparison of the claimed design, the accused design, and the prior art.

Generally, the Federal Circuit’s decision in Egyptian Goddess has been heralded as increasing the value of design patents. Given the relatively low cost of obtaining and maintaining a design patent coupled with the increased guidance in enforeability provided by the Federal Circuit in Egyptian Goddess, design patents offer another form of intellectual property protection that companies and individuals should consider when seeking to bolster their position in the marketplace.