

Patent, Trademark & Licensing Practice Group 2014 Annual Report

Design Patents

WHAT PATENTEES CAN EXPECT IN 2014

Are you thinking of launching a new product in 2014? If so, then you might consider protecting your intellectual property in that product using a design patent.

What is a design patent?

A design patent is a form of intellectual property (“IP”) protection that has been around since 1842, but is experiencing a renaissance. Design patents, as you might imagine, protect what an article looks like, and not what an article does. Design patents protect any new, original and ornamental design for an article of manufacture. An article of manufacture can include tangible goods as well as “virtual” designs such as an icon or a graphical user interface (“GUI”).

Design patents are increasing in relevance every year. In fact, it would be hard to find someone who has not heard of the cell phone wars (e.g., Apple v. Samsung) where huge verdicts were awarded for design patent infringement. Not only is design protection appropriate for artists and entrepreneurs, but large multinational corporations as well. In fact, the top 50 filers of design patents are consumer products companies like Proctor and Gamble.

How do design patents fit into a thorough IP strategy?

A design patent is one of several ways that you can protect your IP and market advantage. The various forms of intellectual property (e.g. patent, trademark, copyright, etc.) overlap and it is this layering of the various forms of IP that can provide you with excellent IP coverage for your artwork, your products, your web presence, and the like. A design patent complements other forms of intellectual property such as a copyright (which protects artistic expression), a utility patent (which protects how something works or what an article does) and a trademark (which identifies the source of a good and/or service for the consuming public).

Some examples of overlapping protection include a recent federal court case involving the Bat Mobile. There, the court found that the design for the Bat

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Mobile was covered by a design patent, and following the expiration of that design patent the Bat Mobile remained covered by copyright. Likewise, the shape of the iconic Coke bottle has been protected by design patents, copyright and trademarks. For other products, a utility patent could be used to protect how your product works or what it does, and the various other forms of IP protection could be used to protect the distinctive aesthetic aspects of that same product. It may even be the aesthetic aspects that set your product apart from other products in the marketplace and provide you with a competitive advantage.

How do I get a design patent?

To obtain a design patent, you need to file an application with the United States Patent and Trademark Office (“U.S.P.T.O.”). A design patent can protect the shape of an article, the surface treatment of an article, or both. As such, not only are tangible goods covered under design patents, but “virtual” designs, such as would be found displayed on your phone or computer, are also covered.

A design patent has a single claim, which refers to “the ornamental design for an article of manufacture as shown and described.” Generally, the remainder of the application consists of a series of drawings describing the aesthetic elements you wish to protect. It is very important to consult with a patent attorney with some experience with design patent protection because the drawings define the scope of protection. For example, the use of a dotted line indicates areas or elements that are not claimed, while solid lines indicate the claimed (and therefore enforceable) subject matter. There are expansive guidelines regarding cross-hatching, shading, and the like. It is also important to make sure that the drawings “fully describe” the invention (i.e. there are adequate views of the article).

A design patent can be a very cost effective way to protect a product, and a design patent can be obtained relatively quickly as compared to a utility patent. If you choose to pay an additional fee, you can have your design patent examined via the “rocket docket” and have it issued, on average, in less than one year. Depending on the size of your company, you may also be entitled to discounted fees before the U.S.P.T.O.

Once you receive a design patent for your product, you can exclude others from making, using, or selling any product that infringes that design for 15 years from the date of issue. During that time, you do not need to pay any maintenance fees as you would with a utility patent.

As of this writing, the U.S. is in the final stages of joining the Hague Agreement, which aims to streamline international design protection. This will facilitate the protection of your design around the world. If you are interested in international design protection, it is critical to engage a skilled patent attorney in order to navigate the various drawing requirements around the world. Additionally, an international industrial design application can cover up to 100 designs within

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the same Locarno class; although on average, most have less than 5 designs per application.

Lastly, there are important disclosure requirements with utility and design patents. One must be careful not to “disclose” the subject matter of a patent application before filing for patent protection or risk losing the ability to protect that invention in the U.S. and around the world. Disclosure can come in the form of public display, an offer for sale, etc. It is advisable to consult with counsel early so that you can make a conscious decision whether or not to protect your design with a design patent or otherwise. While there is some grace period in the U.S., this can be a false sense of security since most of the rest of the world is an “absolute novelty” jurisdiction and any disclosure can “donate the design/invention to the public.”

Summary

Design patents are a great tool in your IP protection toolbox, both in the U.S. and around the world. Design patents dovetail nicely with the other forms of IP protection to create a comprehensive IP strategy. This layering of protection can provide you with excellent coverage for a wide variety of goods, both tangible and “virtual.”

We can help!

Devine Millimet has experience in procuring intellectual property rights, including design patents, and regularly presents seminars on the subject. If you would like to discuss any matters relating to Intellectual Property Protection, then please feel free to contact us for a consultation.

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