

Achieving Marketplace Advantage With Targeted Design Rights

by Gina Cornelio, Lee R. Osman, and Kevin Duffy

Aesthetic appeal often drives commercial success. Faced with endless options, consumers often select products based on look and feel. High-performing, defect-free products are table stakes, and utility patents strongly protect such functions and structures. Often overlooked is securing rights to the aesthetic qualities of the product - design patents can cement protection of the very qualities consumers use to select a product in the marketplace.

A design patent can prevent imitators from making, using or selling an ornamental design implemented with an article of manufacture, such as the design of a consumer product, or even a graphical user interface. Absent design protection, the appearance of a product may be vulnerable to unauthorized reproduction, especially with weak or nonexistent utility patent coverage. Competitors may emphasize similar design elements in equivalent offerings, often while skirting utility protection by selling a less functional product. Drawn toward a sleek design, busy consumers may not appreciate the functional difference until well after a purchasing decision.

Avoid consumer temptation by blocking similar appearing products from the marketplace. The design envelope wrapped around a high-performing product merits protection in its own right. Design protection – achieved often at a lower cost, and in less time than utility protection – can provide meaningful commercial advantages that should not be ignored.

An Ounce of Prevention

Design patents protect aesthetics. The industrial design of a new product can be protected, as can the look of its constituent design features. Layering design protection alongside a utility patent establishes complementary coverage, often with only a marginal incremental investment. Or with thin budgets, design patents can provide at least some protection for less cost.

The time and expense of filing a design patent is substantially less than with a utility patent. A design patent does not require a detailed technical description, as a utility

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patent does, which means less attorney time to prepare. Official fees at the U.S. Patent and Trademark Office (USPTO) are less too, sometimes by over 40%.

A streamlined application process focused on the product's visual depiction also reduces application filing lead time. This enhances flexibility in the run up to product launch. Once filed, design application pendency at the USPTO is typically less than the pendency of a utility application by years, and expediting options are available for those who cannot wait.

How Visual Enforcement Strengthens Marketplace Advantage

Design patents are not subordinate to utility patents. Nor are design patents less potent tools for blocking the unscrupulous imitator. Rather, design patents block unauthorized making, using, or selling of the protected claim scope with the enforceable, recognizable authority analogous to utility patents. Such blocking may be done either through causing patent knowledgeable competitors to change their design or through enforcement of those who do not.

To infringe a design patent, an assessment is made as to whether the designs are substantially similar in the eyes of an ordinary observer; a product need not be identical to infringe. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir 2008). The threshold question is often merely: would a consumer mistake or believe the allegedly infringing product as the patented design?

Visual enforcement campaigns can be conducted without a rigorous technical evaluation. Unlike utility patents, where an infringing feature may be buried within the deep inner workings of a product (or code or method of manufacture), a design, is almost readily apparent upon visual inspection. This means that in-house, non-technical team members can cast a wide net and identify more potential infringers faster, including those selling exclusively on social media and online marketplaces. A high return on legal spend can often be realized by blocking more competitors than may be feasible with a utility patent, all based on an efficiently obtained design right.

Enhanced damage awards for design infringement can also increase leverage in commercial negotiations. Not only are the "no less than the reasonable royalty" provisions of 35 U.S.C. § 284 available, design patent infringers may be subject to compensate the rights holder for "total profits" under 35 U.S.C. § 289. The combination of targeting more potential infringers faster, with the additional leverage of enhanced damages, provides synergistic benefits that make design patents a value-add to the bottom line.

How Design Patent Drawings Maximize Protection

Meticulous attention to design application drawings pays off during later enforcement. The scope of coverage is based on the solid line depiction of the ornamental design. Often, it is desirable to disclaim – via dash line – some portion of the ornamental design. The visual assessment for infringement is based on the substantial similarity of the infringing design with the solid line features. The more portions shown in dash line, the

fewer solid portions remain to map onto the infringing product. This can make infringement easier to show, and open avenues to catch more infringers. While breadth is tempered by patentability considerations, threading the needle between broader coverage and validity with proper drawings is just as important a consideration as the written claim scope in utility patents.

Understand consumer motivation. It is never just about how well the product performs. It is how the product makes the consumer feel, which is so often driven by aesthetics. Leveling up patent strategies to reflect this reality protects the hard-fought innovation, creating a consumer feeling unique to the genuine article.