

Three Reasons to File a Design Patent with your Utility Patent

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When filing a utility patent that includes design elements, the patentee is often faced with the question “should I also file a design patent?” The patentee may answer with “there is no need to file the design patent since the design elements are covered by the utility patent.” However, a recent case in the United States District Court for the Southern District of California, Columbia Sportswear v. Seirus Innovative Accessories, illustrates that filing a design application along with a utility patent can have some very powerful and lucrative benefits.

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Columbia Sportswear owned three patents directed towards heat reflective lining of outdoor equipment. The three patents are U.S. Patent No. 8,453,270, U.S. Patent No. 8,424,119, and U.S. Design Patent No. D657,093. The reflective lining was used in Columbia Sportswear’s Omni-heat products. In January 2015, Columbia Sportswear sued Seirus Innovative Accessories, alleging that Seirus’ HeatWave gear infringed the three patents.

During litigation, Columbia Sportswear filed a summary judgment motion arguing that Seirus infringed the three patents as a matter of law. The court dismissed Columbia Sportswear’s motion regarding Seirus’ infringement of Columbia Sportswear’s two utility patents. However, the court held that Seirus infringed Columbia Sportswear’s design patent. In particular, the court held that the designs of Columbia Sportswear’s design patent and the lining of the HeatWave gear were “strikingly similar” and, as such, met the requirement for infringement of a design patent. This leads to the first reason to file a design patent along with a utility patent: design and utility patents have different

standards for infringement. For example, the owner of a design patent needs to demonstrate that an ordinary observer would find the two designs to be substantially the same to prove infringement while the owner of a utility patent needs to demonstrate literal infringement or infringement under the doctrine of equivalents. The different standards for infringement mean, in some circumstances (as was the case for Columbia Sportswear), it can be easier or more straightforward to demonstrate infringement of a design patent than a utility patent.

Before the case went to trial, Columbia Sportswear dropped U.S. Patent No. 8,424,119 from the suit. After trial, a jury found that Columbia Sportswear's remaining utility patent was obvious in view of the prior art. This leads to the second reason to file a design patent along with utility patent: design patents and utility patents have different standards of obviousness. As such, as was the case with Columbia Sportswear's patents, a factfinder can find that the utility patent is invalid while the design patent is valid.

The jury also found that Columbia Sportswear was entitled to all of Seirus' total sales for the infringing products, about \$3.4 million. This leads to the third reason to file a design patent along with a utility patent: damages for infringing a design patent are different (e.g., can be greater) than a utility patent. *Columbia Sportswear v. Seirus* is the first court case to determine damages after the U.S. Supreme Court's decision in *Apple v. Samsung*. 580 U.S. ____ (2016). However, as shown in this case, damages for infringement of a design patent *can* result in the patent owner receiving all of the total sales of the infringing product instead of just a reasonable royalty or lost profits as in the case of utility patents. Note that the damage analysis for design patents is fluid and therefore may change.

In sum, it can be beneficial to file a design patent along with a utility patent because (1) it can be easier and/or more straightforward to demonstrate infringement of a design patent compared with a utility patent; (2) the design patent can be valid even though the utility patent is invalid; and (3) damages for infringing a design patent *can* be all of the total sales of the infringing product.