The Importance of Design Patents

12/7/2011 William P. Dani

The law provides many different ways to obtain legal protection for intellectual property, including, most notably, patents, trademarks and copyrights. The most common mechanism for protecting an invention is a patent. Although most people are generally familiar with patents, many do not understand that there are three different types of patents available under U.S. law—utility patents, design patents and plant patents. Understanding when to use each of these options is an important part of developing a cost-effective intellectual property strategy.

Design patents – granted on the ornamental design of an item such as a chair, shoe, packaging or piece of jewelry -- are underutilized, says Warner Norcross & Judd patent attorney Bill Dani.

There are many industries where design patent protection is an ideal way to protect your intellectual property. “The design of a product is often what you really want to protect because it’s what people see; it’s what draws them to your product,” says Dani, who has filed hundreds of design patents for his clients in the footwear, packaging and furniture industries alone.

Design patents can prevent your competitors from using your designs. In addition, they can trigger significant settlement payments for the owner of the design and successfully prevent future knock-offs.

It is often a good strategy to focus a design patent application on the unique features of a product. If a chair has a unique arm rest, for example, or the sole of a shoe curves in an unusual way, it may make sense to file a design application on just that feature. A design patent directed only to that feature will often provide better protection because infringement can be found without considering similarity in the rest of the product.

Dani often advises his clients to file separate patent applications for different aspects of a product. In some cases, a product may embody a variety of unique aspects that could be separately used by a competitor. For example, in the footwear industry, it is not uncommon for one company to copy either the sole or the upper of a shoe. Separate design applications directed to the upper and the sole improve your chances of stopping a competitor that has duplicated one, but not the other.

In addition, filing a design patent application costs about one-quarter the price of filing a utility patent application. The cost of prosecuting design patent applications is also typically lower than for utility patent applications. The Patent Office usually takes less time to pick up a design application for

review. Design patent applications are typically not rejected if you know what you are doing. Dani says.

As a result, design patents are granted much more quickly than utility patents – often in about 9 to 18 months, as opposed to an average of two and one-half to three years for utility patents in some technology areas. “And they can remain in your portfolio for 14 years without additional cost because you don’t have to pay regular maintenance fees.” Dani adds.

Design patents can be very effective in infringement litigation. When a competitor directly copies a product, it is easy for a jury to compare the images and find infringement. It does not require a deep knowledge of technical issues. Utility patents, on the other hand, often involve complicated technology, which can be difficult for a jury to comprehend.

It is common for a party accused of infringement to challenge the validity of a patent. Often this is done by attempting to prove that someone else developed the invention before the patent owner. Given the amount of arbitrary detail that is included in many design patents, it is often difficult to prove that a patented design was previously developed by someone else. “The percentage of design patents that are invalidated is extremely low.” Dani says.