

Cheap, Powerful Patent Protection: What You Need To Know About Design Patents

By Courtland C. Merrill and Michael B. Lasky

Remember the *Apple v. Samsung* patent case, where Apple won \$1 billion? That was largely a *design* patent case.

Patents have two flavors: utility (how things work) and design (how things look). If you are overlooking design patents, you are missing one of the most cost effective patent tools. And if you don't think your business qualifies for a design patent because you don't do technology, maybe you should rethink it.

In *Apple v. Samsung*, Apple successfully showed that Samsung copied the clean shape and sleek look of Apple's smartphone. Samsung argued that something as simple as the shape of the iPhone cannot be protected by a design patent. Samsung was wrong. Design patents protect the ornamental appearance of an article of manufacturer, in short, the way a product looks, not how it functions. Like a utility patent, patentable designs must be new and non-obvious. Design patents also cannot cover purely functional features. Design patents are easy and cheap to get and are granted relatively quickly by the patent office.

What types of products can be protected by design patents? Virtually any new and non-obvious product design, including two-dimensional designs such as screen icons, game boards, and even brands on packaging. Design patent protection is particularly useful for protecting products where visual appearance is, or can become, an important factor in purchasers' decisions to select the product.

Design patents are, in many ways, similar to trademarks but are easier to obtain because trademarks have long waiting periods to achieve trademark status. And, unlike a trademark, there is no requirement that the owner of a design patent show that the design is distinctive in the marketplace, or indicates the source of the product covered by the design.

Companies with strong design patent portfolios have historically been manufacturers of consumer products that are functionally indistinguishable from competitors: Reebok and Nike (shoes), Oakley (sunglasses), Goodyear and Michelin (tires), Kohler (plumbing), Colgate-Palmolive and Proctor &

Gamble (health and cleaning), and Apple, Nokia, and Motorola (mobile phones). Google has a design patent on the visual appearance of the user interface for its search engine. See D599,372. The Statue of Liberty is the subject of a design patent.

Even if isolated elements of a design are functional, that does not make the design as a whole primarily functional. For example, the body of an automobile could be protected by a design patent on the visual appearance while a utility patent covers functional aspects of the design that provide for better aerodynamics. An example of a purely functional shape might be a piece of military hardware, e.g., a fighter jet; the visual appearance of the jet is dictated by function even though the design could be described as visually appealing. Yet, certain portions of the shape of a mostly functional product may be aesthetic and not functional but are likely to be copied by competitors because the buying public "expects" to see such a shape. That is what happened in *Apple v. Samsung*. The brick shape of iPhone became the industry standard for smartphones. Thereafter, consumers demanded rectangular smartphones like iPhone. Samsung felt compelled to copy it.

Design patents also have advantages when they need to be enforced against infringers in court. Until recently, courts required design patent holders show that an accused infringer misappropriated the design's "points of novelty"—the aspects of the design that distinguished it from prior designs. The Federal Circuit's decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) did away with the points of novelty requirement. The Federal Circuit confirmed that the correct standard for proving infringement is the "ordinary observer test": "[I]f in the eye of an *ordinary observer*, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." This change has made it very hard to be a defendant in a design patent case because the courts no longer allow the jury to "pick apart" the design and focus on only one element.

The ordinary observer test is similar to the standard for proving copyright and trademark infringement (substantial similarity), but unlike copyright infringement there is no need to prove copying. And, unlike a trademark, a design patent requires no evidence of secondary meaning, or consumer connection to the design, to prove infringement. Juries and judges are considered "ordinary observers" and can determine infringement themselves by comparing the patented design with the infringer's accused product. Therefore, expert testimony may not be needed.

Design patents do not require extensive claim construction proceedings like utility patents, further saving the plaintiff legal expense. Another advantage to design patents is in the remedy provided upon a showing of infringement. An infringer's profits may be recovered for infringement, in addition to the availability of a reasonable royalty, lost profits, and potentially attorneys' fees and treble damages allowed for infringement of a utility patent. The ability to recover an infringer's profits is not allowed for infringement of a utility patent.



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