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Are Design Patents Worth Getting?

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Most of us love to travel. The thrill of seeing new and interesting places, experiencing different cultures, seeing unique architecture and living among the local population in a different environment can really change your sense of the world. However, for as much as many of us love to travel, most of us still prefer the comfort and convenience that we are used to having. That is why it can be very comforting to see familiar products and names when we visit a foreign country.

For me, that comfort is Diet Coke. To see that signature Coke shaped bottle gives a kind of familiarity that only home can provide. The Coca-Cola® bottle, which known to most of us as "the Coke bottle" was created by the Coca-Cola® Company almost a hundred years ago. Coca-Cola® held a competition to decide the future of its bottle design that would help it designate their products by that distinctive design alone. Coca-Cola® wanted us to instantly know from the design shape that the product we were holding was Coca-Cola®. It seems to have worked.

Coke obtained a design patent on their contour shaped bottle in 1915 and has been using a similar design ever since.

Design patents are a type of protection in the U.S. for new, original and ornamental designs for an article of manufacture. U.S. design patents protect ornamental characteristics of a particular article, such as the Coke bottle. Since a design is manifested in the appearance of a particular article, the subject matter of the design patent may relate to the configuration, the particular article itself and/or the combination of both.

Design patent protection is only available for new and non-obvious ornamental designs which can include ornamental impressions, prints or pictures that are applied to or embodied in the article. Design patent protection may be granted to non-functional aspects of devices to protect unique configurations and design elements that would otherwise not be protectable by a design patent. Another advantage to filing a design patent is the ability for a business to utilize the terms "patent pending" or "issued patent," where appropriate.

Design patents cover essentially what the name suggests, namely how the object looks. Unlike utility patents, design patents do not cover any functional aspect of a design element. On the contrary, functional aspects are not covered by design patents. Design patents are unique in that they give an inventor a patent on only the new nonfunctional appearance of their invention. Therefore, design patents only cover the aesthetic appearance of an invention, and not how the invention is made or the materials used to make it.

Design patents specifically protect the appearance of an invention. The United States Patent Office will only issue a design patent when they believe the design is novel and unique. Additionally, the Patent Office will want to ensure that the design is not an obvious deviation from known or existing designs. After the Patent Office has determined that a product or device ornamentation is unique and novel, a design patent may be issued by the United States Patent Office. Design patents last for fourteen years from the date it issues.

However, an issue that is often overlooked by many inventors and businesses alike is the ability to apply for a trademark for a particular design that may also be covered by a design patent. Trademark law provides a trademark owner with exclusive rights to a word, name, symbol, device, shape or three-dimensional object that is used in trade with particular goods to indicate the source of the goods. Trademarks can be used to protect a distinctive design, product packaging or product. Trademark protection may be ideal when patent protection is not available or to protect a distinctive design packaging or product for a longer period of time. Trademark rights last as long they are being used.

Some types of trademarks are more accurately categorized as trade dress. Trade dress may refer to the total image and overall appearance of a business packaging or product, or a particular feature such as size, shape, color combinations, texture, graphics, or even particular sales techniques. For example, because the design patent for the now famous Coke bottle expired long ago, the Coke bottle is now protected via trade dress protection. In this fashion, Coke can continue to utilize the unique design while still having protection for it.

The next logical question is: "how can I tell if I am infringing someone's design patents?" Often a search is performed to determine if other similar designs exist that look similar to your designs. Even then, it can be very difficult to determine if you are infringing on someone's design patents, as many patents and products look similar to one another.

The Supreme Court explained in *Gorham v. White* that design patent infringement was determined through the eyes of an "ordinary observer." Later, the Supreme Court introduced the idea that designs should be compared against each other in light of prior design patents that existed. However, the court began altering the "ordinary observer" test and in *Litton Systems, Inc. v. Whirlpool Corp.*, the court enumerated that the ordinary observer test was not enough. "For a design patent to be infringed…no matter how similar two items look," "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." "That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art."

Eventually, the Federal courts developed a new principle to evaluate design patent infringement. This was called the "point of novelty" test. Essentially, the "point of novelty" test required the comparison between the novel portions of your design patent as compared with all the prior design patents that came before you. Although the "point of novelty" test provided a general guideline to determine infringement existed, it was rather difficult to implement because showing a particular "point of novelty" became more difficult to point out to a court of law.

Ultimately, the courts abandoned the "point of novelty" test in *Egyptian Goddess v. Swisa* and essentially came back to the "ordinary observer" test. Unfortunately, the *Egyptian Goddess* case did not provide us an understanding of how courts will now analyze the ordinary observer test with the abandonment of the "points of novelty" approach that was previously utilized to determine design patent infringement.

What *Egyptian Goddess* does do is establish a new and exciting foundation to determine whether a particular design patent is infringed by another's design. This new test is widely believed to make design patents more valuable because it will be easier to prove infringement. In today's continually changing world where design and aesthetics can make or break your product, the ability to obtain design patent protection and to be able to enforce those design patents is more important than ever.

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