

6 REASONS TO CONSIDER DESIGN PATENT PROTECTION

1. To protect your investment. A product's design can critically impact market acceptance and success. While the product may include innovative technical features that are covered by a utility patent, its eye-catching appearance, such as the look and feel of the product, may warrant design patent protection. In some cases, such as when the technical features are old, utility protection may not be available. However, if you recast an old product in a new design, it may be protectable by a design patent. For example, toothbrushes have been around for years, but if you redesign even just a portion of a toothbrush, you may be able to protect the toothbrush with a design patent.

2. To prevent knockoffs. A competitor or knockoff artist may want to sell an item that looks just like your company's product, taking advantage of the technology, customer service, or branding that distinguishes your product in the marketplace. Particularly for over-the-counter consumable products, such as pens for example, a customer may not take the time to discern the genuine product from an imitator's product and may mistakenly purchase the wrong one. If the confusingly similar product does not incorporate a technical innovation covered by one of your company's utility patents, then there may be no utility patent infringement. However, there may still be design patent infringement.

3. For faster patent protection. Design patents tend to be issued more quickly than utility patents. While it is common to wait two years or more before the U. S. Patent and Trademark Office (USPTO) reviews your utility application, design application examination timelines are typically shorter, with design patents generally being first reviewed within a year. In fact, some patents are even issued within a year. As such, filing a design patent may be beneficial if you have a product quickly entering the marketplace.

4. To save money. A design patent typically costs much less to prepare and prosecute at the USPTO than a utility patent. First, unlike utility patents, which include a long and detailed description and many claims, design patent protection consists primarily of figures showing various views of the product. An illustrator, known as a patent draftsman, prepares the figures, and minimal time is required from an attorney to review the figures and complete the application. In contrast, the utility application generally requires more time and expense to prepare. Once design and utility applications are filed at the USPTO, examiners will review the applications. Frequently, an examiner grants the design patent after the first review of the application, whereas utility applications are typically reviewed by the examiner several times before reaching a favorable outcome.

5. For special remedies. Remedies for design patent infringement are stronger than those offered for utility patent infringement. For example, a prevailing design patent plaintiff can recover all of an infringer's profits for selling the offending design. A utility patent owner, in contrast, typically recovers only a reasonable royalty for infringement or, in certain circumstances, its own lost profits. A utility patent owner is not permitted to recover the profits of the infringer. As a result, in instances of an alleged design patent infringement, the threat of losing all profits may motivate the infringer to seek a quick settlement.

6. For advantages over trade dress rights. Some may wonder whether design patent protection is overkill if a company intends to rely on trade dress rights, which also protect the look and feel of a product or its packaging. To recover for trade dress infringement of a product's design, however, one must first establish that the trade dress has obtained "secondary meaning" or "acquired distinctiveness" in the marketplace. In other words, one must show that the public has come to



associate the product design's trade dress with a particular producer of the goods. Although trade dress protection is valuable, it typically takes at least several years and considerable advertising and marketing expenditures before the requisite secondary meaning or acquired distinctiveness can be established. Consequently, during at least the first few years after a product launch, if not longer, no trade dress rights are available to stop copycat products. On the other hand, a design patent is typically granted long before this evidentiary hurdle can be met, enabling the design patent owner to deal immediately with infringers.