

# The Limited Monopoly

## “All That Glitters” - Protecting Ornamental Appearance With A Design Patent

### Definition of a Design Patent

The United States patent laws provide for the granting of a design patent to any person who has invented a new and nonobvious ornamental design for an article of manufacture. It is important to note that a design patent protects the ornamental appearance of an article, and not its structural or utilitarian features. The disclosure and description of the invention as described in a design patent application is done primarily by way of drawings, and not words. A design patent application has only one claim that begins with “The ornamental design for a ....” Knowledge of the specialized nature of design patents should be another tool that every inventor is aware of, and should be used carefully and with a complete understanding of its limitations and intended purpose.

### The Differences Between a Design Patent and a Utility Patent

In general, a utility patent protects the way an article is used and works,<sup>1</sup> while a design patent protects the way an article looks.<sup>2</sup> Both

design and utility patents may be obtained if invention resides in both an article’s utility and ornamental appearance. The proceedings relating to granting of design patents are essentially the same as those relating

to other patents, with a few differences. To begin, the filing

fee for a design patent application is less than the filing fee for a utility patent application. A design patent also has a term of 14 years from grant, whereas a utility patent has a term of 20 years from the date of filing. A design patent also has no maintenance fees, unlike a utility patent that requires

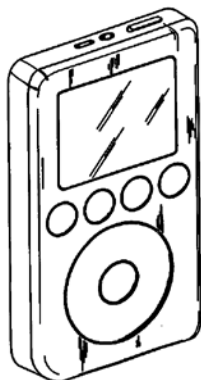


FIG. 1

*“Apple Computer knew this well when they filed a design patent application on April 25, 2003, just three days before introducing the new iPod.”*

payments at 3 ½, 7 ½ and 11 ½ years after issuance. The drawings for a design patent application are very important, as they define the scope of patent protection. And, unlike utility patent application drawings, no reference characters or callouts are allowed. There are also differences related to foreign filing and claims of priority that are beyond the scope of this article, but can become important in specific situations.

### Improper Subject Matter for a Design Patent

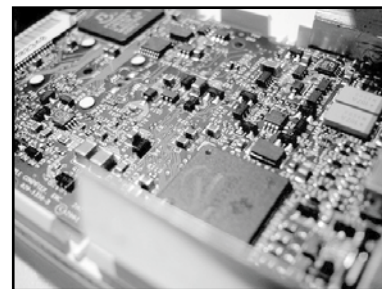
A design for an article of manufacture that is dictated primarily by the function of the article, where there is no unique or distinctive shape or appearance to the article not dictated by the function it performs, is considered improper subject matter for a design patent application because the design lacks ornamentality. Also, the design must be “original.”<sup>3</sup> A design that simulates a naturally occurring object or a well known person, for example, is not original. The design also must not be considered offensive to any race, religion, sex, ethnic group, or nationality.<sup>4</sup>

### Why Apply For a Design Patent?

When a unique, distinctive or easily recognizable appearance is considered important to a product’s success, a design patent can be a worthwhile investment. Also, with today’s “global economy,” product knockoffs are unfortunately commonplace. Many businesses rely on the distinctive appearance of their products for consumer recognition. A design patent can protect that unique appearance from knockoffs. Patent applications are commonly filed early in the product lifecycle, where a design patent application serves to protect unique ornamental attributes. Timing is often important in design patent application filings. A design patent application is often filed just before a product is taken to market. Filing for a design patent application too early creates problems when the often inevitable design changes occur. Apple Computer knew this well when they filed a design patent application on April 25, 2003, just three days

before introducing the new iPod.

A quick search of the patent literature will reveal that Apple has a series of design patents for iPod designs. Common among the various design embodiments is the round Click Wheel consisting of concentric circles. They all have it- the 1G from 2001, the 2G from 2002, the 3G from 2003, the 4G from 2004, the Mini, the Shuffle, the Photo, the Nano, and the Video. It is the external shape and design of the iPod that serves as an important source of brand identity and product differentiation. The internal components of the iPod, interestingly enough, are not by Apple at all. They are components manufactured by Cypress Semiconductor, Sony, Texas Instruments, PortalPlayer, Samsung, Toshiba, Synaptics, and others. So is it the technology or a brilliant design that has made the iPod what it is today? A look



iPod up close

at the iPod design patents may provide some insight, and of course (as with any patent), great reading (or, in the case of design patents, great “viewing”).

1. 35 U.S.C. 101
2. 35 U.S.C. 171
3. 35 U.S.C. 171
4. 35 U.S.C. 171 and 37 CFR 1.3

Authors Robert D. Gunderman P.E. (Patent Technologies, LLC [www.patenttechnologies.com](http://www.patenttechnologies.com)) and John M. Hammond P.E. (Patent Innovations, LLC [www.patent-innovations.com](http://www.patent-innovations.com)) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at [www.patenteducation.com](http://www.patenteducation.com).

Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.