

Design patents: An important tool in your intellectual property portfolio

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Design patents are an important tool that companies should utilize when protecting their products. Design patents, as set forth in 35 U.S.C. § 171, protect ornamental aspects of an article of manufacture, which is in contrast to utility patents.

Whereas utility patents protect functional aspects of an invention, design patents focus on the aesthetics of an article, such as the article's shape, configuration, and surface ornamentation. Design patents therefore ensure that the unique visual characteristics of an article can be legally protected.

Although ornamentality of a design application must be primarily ornamental (not primarily functional), articles of manufacture can include both functional and ornamental aspects. The distinction between design and utility patent protection is important as together they can provide a holistic approach to protecting products.

Design patents further complement other forms of intellectual property in addition to utility patents, such as trade dress (which protects the source-identifying appearances of the article).¹ Accordingly, combining design patent protection with other forms of IP can create robust protection that secures both functional and aesthetic elements of a product, thereby enhancing its market value and competitive edge.

Another advantage of design patents is that they can typically be obtained faster, easier, and cheaper than utility patents. Furthermore, design patents can lead to significant damages when competitors are found to infringe.

By understanding and leveraging different IP protections, companies can develop a comprehensive strategy to protect their innovations and maintain their unique market position. This article provides an overview of the value that design patents can provide, as well as an introduction to design patents, and considerations that inventors should keep in mind when pursuing design patents.

Design patents provide value

Design patents hold significant value within an intellectual property portfolio. One of the most notable examples was when Apple sued Samsung alleging certain Samsung cell phones infringed Apple's patents. While the jury found infringement of both utility and design patents, the jury awarded over \$533 million in damages for the

infringement of three design patents, but just over \$5 million in damages for infringement of two utility patents.²

This case underscores the substantial financial impact that design patents can have when successfully obtained and enforced. Indeed, the ability to secure such high damages highlights the importance of protecting the ornamental aspects of products through design patents.

Moreover, design patents can typically be obtained more efficiently than utility patents. The allowance rate for design patents is significantly higher than the allowance rate for utility patents, which means that applicants have a better chance of securing protection for their designs.³ Additionally, the process of obtaining a design patent is generally faster.⁴ This expedited process can be crucial for business looking to bring new products to market swiftly.

Filing fees and attorney fees associated with design patents are generally lower than those for utility patents.

Like utility patents, once the application is filed, products can be marked with "patent pending," and after issuance, products can be marked the patent number. Such marking can serve as a deterrent to potential infringers.

Cost is another critical factor that adds to the value of design patents. Filing fees and attorney fees associated with design patents are generally lower than those for utility patents, making design patents a more cost-effective option for many inventors (<https://bit.ly/4ggSU4c>).

Acquiring design patents

Like utility patent applications, design patent applications are filed with the United States Patent and Trademark Office and reviewed by an examiner to ensure that the disclosure is clear and enabling (35 U.S.C. § 112) and that the claimed design is novel and nonobvious (35 U.S.C. §§ 102 and 103).

An application for a design patent includes several elements, including a title, a description, a single claim, and figures. The title

provides a brief identification of the article, the description typically describes the views in the figures, and the claim clarifies that it is the ornamental design of the article identified in the title and shown in the figures that is protected.

The figures of a design application are the most critical component, as they provide the visual disclosure of the claim and establish the boundaries of the design patent's protection.

The figures must be clear and complete, and include a sufficient number of views to ensure that all aspects of the design are accurately depicted. As such, design applications typically include more views, as compared to a corresponding utility patent, in order to provide a complete disclosure of the appearance of the design.

A similar design can infringe a competitor's design patent even if an applied logo does not infringe the competitor's trademark.

For example, design applications typically include front, rear, top, bottom, left, right, and perspective views. Design applications can be filed as a continuation off of either design applications or utility applications. Accordingly, where applicants may consider filing a design application as a continuation of a utility application, drafters of the original utility application should consider including all views that may be necessary for a design application.

Within the figures, broken lines can be used to disclose environmental features and depict unclaimed portions of the design. While surface shading is not required, it can be helpful or necessary to show the contours of surfaces.

Figures can be amended during prosecution (and in continuation applications), but "new matter" cannot be added. For instance, converting lines between solid and broken lines does not add new matter, and therefore provides an opportunity to broaden or narrow claims during prosecution or through continuation applications. However, modifying the design or changing surface appearance will typically constitute new matter.

New obviousness test for designs

A new test for determining obviousness was recently established in *LKQ Corp. v. GM Global Tech Operations*.⁵ In that case, the Federal Circuit, sitting *en banc*, found that the previous obviousness test for design patents, called the *Rosen-Durling* test, was overly rigid and that the test for obviousness for design patents should mirror the test for utility patents.

The *Rosen-Durling* test required that obviousness be based on a primary references that was "basically the same" as the design in question, and that any secondary references are "'so related' to the primary reference that features in one would suggest application of those features to the other."⁶

In place of the *Rosen-Durling* test, the Federal Circuit found that the *Graham* factors, the factors used for utility applications, should be applied to design patents.⁷ The *Graham* analysis requires the fact finder to (1) determine the scope of the prior art; (2) determine the differences between the prior art and the design claim at issue; (3) determine the level of ordinary skill in the art; and (4) evaluate the obviousness or nonobviousness of the design.⁸

Like utility patents, an assessment of secondary consideration as indicia of obviousness should also be considered.⁹ The change appears to make it easier to identify and combine references to establish obviousness of designs. However, it will be interesting to see how patent examiners and courts apply the new test.

Infringement of a design patent

Courts use the Ordinary Observer Test to determine if a design patent is infringed.¹⁰ The test asks if an ordinary observer would be misled or deceived in such a manner as to induce him or her to purchase the accused product believing it to be the patented design.¹¹

The ordinary observer is a person who is the ordinary purchaser of the article, and is presumed to be familiar with the prior art.¹² When the claimed design is similar to prior art references, small differences between the accused design and the claimed design will assume more importance.¹³

Notably, ornamental logos can be one of the potential differences, however, a potential infringer cannot escape liability by copying a design but labeling with its own name.¹⁴ Accordingly, a similar design can infringe a competitor's design patent even if an applied logo does not infringe the competitor's trademark.¹⁵

Conclusion

Design patents compliment other forms of IP by offering unique protection for ornamental aspects of products. They can typically be less expensive and faster to obtain than utility patents, yet design patents can lead to substantial damages in cases of infringement.

By securing a design patent, companies can prevent competitors from copying the aesthetic features that distinguish their products in the marketplace. Accordingly, design patents are a key component of a complete IP portfolio, and inventors and practitioners should be sure to keep design patents in mind when consider their IP strategy.

Notes

¹ Also compare the protection provided by design patents with copyright (which protects original, creative works), trademark (which protects source-identifying elements, such as logos), and trade secret (which protects valuable confidential information).

² *Apple Inc. v. Samsung Electronics co. Ltd.*, No. 11-cv-01846-LHK, *verdict returned* (N.D. Cal. May 24, 2018).

³ Design applications have an 82.1% allowance rate at the USPTO, compared to a 60.4% allowance rate for non-design applications. <https://bit.ly/42s6DBZ>; <https://bit.ly/4aBzGFb>.

⁴ The average total pendency (i.e., the time from filing to final disposition) of a design application is 22.7 months, while the average pendency of a utility application is 30.1 months, and stretches to 42.7 months for utility applications with at least one request for continued examination. *Id.*

⁵ 102 F.4th 1280 (Fed. Cir. 2024).

⁶ *Id.* at 1287.

⁷ *Id.* at 1298-1300

⁸ *Id.*

⁹ *Id.*

¹⁰ *Gorham Co. v. White*, 81 U.S. 511 (1871).

¹¹ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)).

¹² *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113, 1116 (Fed. Cir. 1998).

¹³ *Egyptian Goddess, Inc.*, 543 F.3d at 678-79.

¹⁴ *Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1131 (Fed Cir. 2019) (quoting *Gorham*, 81 U.S. at 530).

¹⁵ See e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993).

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