



LANDO &
ANASTASI

IP ESSENTIALS

A Toolkit for Entrepreneurs,
Innovators, and Business Owners

DESIGN PATENTS



DESIGN PATENTS

Design patents protect the ornamental aspects of products such as medical devices, board games, graphical user interfaces, vehicles, consumer products, and other things.

Q *What types of ornamental features are protectable by a design patent?*

A Design patents can be used to protect consumer-facing ornamental features of various items, such as consumer products, sporting goods, apparel, medical devices, automobiles and replacement parts, architecture, to name just a few. Two-dimensional designs, such as graphical user interfaces (both static and dynamic), game boards, and icons, are also protectible with design patents.

Q *What are the requirements for patentability for design patents?*

A To obtain design patent protection, a design must be novel, non-obvious and ornamental. In the United States a design patent application can be filed up to twelve months after the first disclosure of the design, but some other jurisdictions around the world are not as lenient.

Q *Can more than one embodiment of a design be included in a single application?*

A Yes. However, a patent examiner is likely to limit the number of designs that are examined. In such instances, the applicant should be prepared to file divisional applications to the remaining designs.

Q **How many views of the design are required for each embodiment?**

A Many design patent applications are filed with what are commonly referred to as the *seven standard views* (front, rear, top, bottom, left, right, and perspective views) for each embodiment. However, in some instances, it is possible to include more or fewer views in the application, as long as they clearly show the appearance of the embodiment.

Q **How should I prepare the figures for a design patent application?**

A It is best to work with an experienced illustrator when preparing the figures for a design patent application. An illustrator can prepare formal line drawings based on prototypes, computer-aided design (CAD) files, photographs, or other images. Line drawings are most commonly used, but are not required in a design patent application. For example, a design patent application can be filed with photographs or shaded images rendered from a CAD file. This is not recommended, however, because the original filed drawings limit the scope of the patent.

Q **What amount of written description of the design is required?**

A Design patent applications include a single claim and are much shorter in length than utility applications. A design patent application generally includes a title, a very short description of the figures, and any additional description of the ornamental design to add clarity to the appearance in the drawings. A short statement may be included to describe lines that depict surface shading, color, texture, or patterns.

The title is important and may determine the scope of products that are covered by the design patent.

Q **How broadly can I claim the design?**

A In the U.S., design patents can claim a design in its entirety or a portion thereof. In addition, in line drawings, solid lines are used to represent the claimed portion of the design, and dashed lines (or broken lines) are used to represent unclaimed portions of the design.

Q **Is international protection available?**

A Design patent applications may be filed abroad and claim priority to an earlier filed design patent application if filed within six months of the U.S. filing date. An international design patent filing regime (the Hague Convention) allows for a single international application (a Hague application) to enter designated member countries.

Q **What is the term of a design patent?**

A *In the U.S., design patents have a term of fifteen years from the date of issue. There is no requirement to pay periodic maintenance fees during the fifteen-year term.*

Q *Can a design patent application claim priority to a pending utility patent application?*

A Yes, depending on the drawings that were filed in a pending utility patent application, a design patent application can be filed based on those drawings and claim priority to the pending utility patent application. Such a design patent application would be entitled to the benefit of the filing date of the utility patent application. Any subsequently issued design patent would still have a term of fifteen years from its issue date. Design patents cannot claim priority to a provisional utility patent application.

Q *How does a design patent differ from a utility patent?*

A Generally, a design patent protects the ornamental appearance of a product. In a patent portfolio, design patents can be used to complement utility patents, which generally protect the structure, function, method of manufacture, or use of the product. Design patents generally issue sooner than utility patents, taking an average of about fifteen months from filing to issue.

Q *Can an ornamental design be protected simultaneously by design patent, trade dress, and copyright?*

A Generally, yes, though each route has its own requirements and might be suitable for different aspects of a given ornamental design. Design patents may serve as precursors towards trade dress rights where the ornamental design is non-functional.

Q *If someone infringes my design patent, what damages are available?*

A In addition to conventional remedies such as obtaining injunctive relief, and as an alternative to collecting a reasonable royalty, a design patent owner may collect the total profits of the sales by the infringer. However, depending on the scope of the design patent, the damages may be limited to a component of a product rather than the entire product.

This IP Essentials Topic is one of a series:

*IP Essentials Toolkit for Entrepreneurs,
Innovators, and Business Owners*

The information provided on this document does not, and is not intended to, constitute legal advice; instead, all information, content, and materials are for general informational purposes only. Readers should contact an attorney to obtain legal advice with respect to any particular legal matter.



LANDO &
ANASTASI

60 State Street, 23rd Floor
Boston, MA 02109

lalaw.com | 617.395.7000