

# Blueprint Against Infringement: Unexpected Help from Design Patents

By George Gottlieb, Esq.

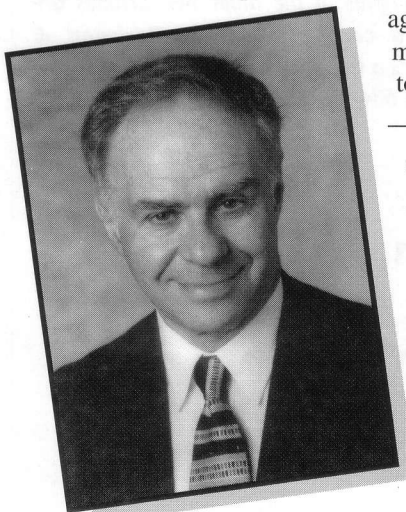
The artistic element of most tableware products is usually best protected by copyright, since copyright protects any original artwork as applied to any media. However, when copyright protection is not available, designers and manufacturers in the tableware industry have often presumed that the application of design patent law in the tableware industry would be inappropriate or ineffective for their designs. They couldn't be more *wrong*. This often overlooked form of intellectual property protection is receiving greater support than ever before from the courts today, and has a commendable track record in litigation against copycat designers.

## What is a Design Patent? Looks are Everything!

A design patent protects the *ornamental design* of an article, focusing only on the look of a product, as opposed to its mechanical function or how the article is manufactured. As an example, the exterior look of a novel teapot could be protected by a design patent, but not its construction.

## Who Owns The Design Patent?

A design patent application can only be filed in the name of the actual artist or designer, who is the *owner* of the design patent. The designer's employer has no right to claim title to patented inventions and designs, except when an employee is hired expressly to produce designs. If ownership rights are an important issue, which they usually are, an agreement can be implemented for the employee to **assign** the rights to the



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patent to the employer. This will permanently vest title to the patent in the employer.

## Preparation of an Effective Design Patent Application

It is essential to carefully prepare the design patent application and a close working relationship with a patent lawyer should be considered a requirement. If design patent applications are treated casually, in a "fill-in-the-blanks" fashion, they are frequently of little real use as a weapon for protection against infringement.

A designer must communicate detailed information about an individual design to the patent attorney, including the background and source data as a means of explaining the design. In addition, the attorney should be informed about possible infringing concepts. For example, if you were your own competitor, could you create an alternative design, one that would be similar but not infringe? This type of detailed discussion will help the attorney understand the essence of the design and prepare an application that will best show the design's essential elements, ensuring a viable instrument of protection that will cover everything the designer had in mind when the design was created.

## Prior Art and Its Role

To be considered worthy of a design patent by the U.S. Patent & Trademark Office ("USPTO"), an ornamental design must pass two tests: it must be both "novel" and "non-obvious" when compared to designs that already exist. These prior designs are known as prior art. Prior art is not restricted to the industry relevant to the designer's work. It is virtually **everything** that existed before the design, from publications to photographs to actual models to other patents.

A design is considered *novel* if it did not exist before. It is not novel if it can be found in exactly the same form in prior art. Further, a design is *non-obvious* only if the difference (or "improvement") between the prior art and the applicant's design would not be apparent or "obvious" to the average designer at the time of design creation.

## File First - Sell or Show Later!

Time is of the essence in the filing of a successful design patent application. The patent laws prohibit the granting of a design patent if, *for more than one year before the application is filed in the Patent Office*, the design has a) been on sale in the United States, b) is the subject of a printed publication anywhere in the world or c) is in public use. Thus, inventors have a one year grace period or "window" to file their design patent application after it has first been shown or sold. To be safe, file early and—if possible—before the design is shown to the trade.

## Disclosure - What It Means and Why You Must

To obtain a truly valid design patent, each design patent application should set forth accurate information, specifications and drawings of the design, often referred to as disclosure material. An experienced patent draftsman, under the guidance of the patent attorney, should be used for the drawings, since the drawings should include views of the design from every angle in order to form a precise picture of the designer's project.

In addition, the design patent laws require that the applicant identify any relevant information that would enhance the Patent Office Examiner's ability to perform a thorough examination of the application and to make a competent decision as to patentability. It is the obligation of the applicant to provide to the patent attorney the date the design went on sale or was described in a prior printed publication or was in public use. In addition, the attorney should be provided with status information, such as whether or not the design has been assigned or licensed, as early as possible.

## The United States Patent & Trademark Office and the Design Patent Application

Applications are filed in the USPTO, located in Washington, D.C. After the application is filed, a Patent Office Examiner will conduct a meticulous review of the application to determine whether it is entitled to design patent protection. Among other things, the patent examiner will do a search of prior art patents and printed publications maintained by the USPTO to ascertain if the design is truly novel and nonobvious.

It can take up to a year or longer before the USPTO officially takes a position as to whether to approve the application. There is an option available, for an additional fee, to speed up the process by filing a petition to make the application special. Even though this may incur additional attorneys' fees, it may be worthwhile to implement this process to protect against copying.

When the initial office action is sent by the USPTO to the patent attorney, the case may be allowed or rejected. If allowed, the applicant has only to pay the issue fee, correct

any informalities that may have been noted by the Examiner and file final formal drawings. If the application is rejected, the patent attorney can contest the rejection. Also, there are other available opportunities to have the decision overturned in appeal processes. These can, obviously, cause the applicant to incur additional legal fees and this decision should be weighed carefully. The patent attorney should be able to assess the fees and the time necessary to pursue the matter, helping the applicant to make a well-informed decision.

## How Long Does It Last?

Design patents last for 14 years from date of issuance, and then they expire; they can not be renewed.

## What Are The Costs Involved?

The design patent filing can range from \$1,200 to \$2,000 including attorney fees, filing fees and charges of the draftsman. However, it is a strong weapon against infringement and, given the price of design and manufacturing costs, may be very worthy of the investment.

## Design Infringement

If an infringer were, for example, to simply add a gold stripe to the plain stem of a sculpted wine glass protected by a design patent, and the design is recognized easily as an imitation with an apparent minimal enhancement, the design is considered a copycat, or an infringement. Thus, minor modifications do not avoid design patent infringement.

If an infringement of a design occurs, the first thing the infringer will try to prove in court is that the design patent is invalid, which can be accomplished by producing examples of prior art to prove that the design is either not novel or is obvious in its similarity to the prior art.

In summary, if copyright protection cannot be obtained, design patent protection is the next best route.

*This is the third in a series of articles relating to intellectual property. Reprinted copies of the other two articles are available, along with a copy of Gottlieb, Rackman & Reisman's primer, "What's a Copyright/ Patent/ Trademark?". Fax your request to (212) 684-3999.*

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