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New Developments in Design Patents

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The Patent Act allows an inventor to patent any new, useful and nonobvious invention with a utility patent. A design patent is awarded to an inventor for "any new, original and ornamental design for an article of manufacture." Unlike the more familiar *utility* patents, *design* patents thus protect the non-functional, ornamental design of an article of manufacture.

Design patents can be obtained for a wide variety of products, such as electrical circuit packaging, computer components, hand-held blenders and plastic containers. Infringement of a design patent can result in the patent owner being awarded the infringer's profits for the sale of the infringing product, which can result in multi-million dollar awards.

A design patent does not include the detailed written description of a utility patent. Instead, a series of figures is provided, illustrating the design as viewed from the front, back, top, bottom and each side. A design patent has a single claim in the form "the ornamental design for a [name of the article] as shown and described."

In two recent decisions, the United States Court of Appeals for the Federal Circuit addressed the standards of inventorship and infringement applicable to design patents. The first of these decisions, *Hoop v. Hoop*, involved competing design patents for an eagle-shaped motorcycle fairing guard (a structure mounted above the handlebars to reduce wind drag). The defendants conceived of and sketched an eagle-shaped design but hired the plaintiffs to prepare detailed drawings and molds. The plaintiffs made some changes to the design as provided by the defendants. Both parties claimed to be inventors.

The court noted that the standard of inventorship for utility patents also applies to design patents, and emphasized that the patent laws confer inventor status only upon those persons who "conceive" the patented invention. Having conceived the invention, "an inventor may then use the services, ideas, and aid of others in the process of perfecting his invention without losing his right to a patent." Those perfecting the original design become inventors only if their new design is not "substantially similar" to the first and is, therefore, patentably distinct.

Applying these standards, the court concluded that the defendants sought the plaintiffs' assistance

only after conceiving the fairing guard design, and that the plaintiffs' drawings were substantially similar to the design conceived by the defendants. Thus, the defendants were the sole inventors.

The second of the Federal Circuit's recent design patent decisions, Contessa Food Products, Inc. v. Conagra, Inc., involved a design patent for shrimp serving trays. In order to infringe a design patent, the accused product must be substantially the same as the patented design according to two tests: a "point of novelty" test and an "ordinary observer" test.

The point of novelty test considers whether the accused product appropriates the novelty that distinguishes the patented design from the prior art.

Under a 130-year old precedent, the ordinary observer test provides that "in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other." Addressing this standard, the court explained that the "ordinary observer" test requires analysis of the claimed ornamental features of *all figures* of a design patent. Moreover, this analysis must include all ornamental features visible during the *normal use* of the product, beginning upon completion of the product's manufacture and extending until its ultimate destruction or loss, and not just at a point of sale. The case was remanded, with instructions to determine whether the patented design and the accused product were "substantially the same" from the viewpoint of an ordinary observer, considering all ornamental features visible during normal use of the design at issue.

Design patents provide an opportunity to protect the ornamental design of a product, and can be of particular interest where an important aspect of a product is its appearance or where the product is distinctive in appearance. Design and utility patents are not mutually exclusive - a given article of manufacture may qualify for both. And, because a design patent often can be secured more quickly and inexpensively than a utility patent, design patent protection is worth considering for products with short life cycles.

As these cases illustrate, despite their relative simplicity, design patents pose some of the same complicated questions as do utility patents, such as determining who the inventors are and whether a product infringes. More information on design patents is available in the United States Patent and Trademark Office's "Guide to Filing a Design Patent Application."

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