

# **Understanding Design Patents Why Every Manufacturer Should Consider Using Them**

© 2009 Don V. Kelly

## **I. What are Design Patents?**

Design patents only protect the ornamental design of the article. They cannot be used to protect how an article functions. Typically a business applies for a design patent to cover a product that functions just like competitor's products. However, by imbuing that product with a new and original design, the business can make its product more distinctive and protect that distinction. A design patent lasts 14 years from the date the patent issues.

## **II. Differences Between Utility Patents and Design Patents.**

You may be surprised to learn that design patents and utility patents are not exclusive of each other. Thus, just because an item is covered by a design patent does not mean that it also cannot be covered by a utility patent. This is because every tangible article has both utility and ornamental characteristics. Accordingly, a new article may receive both utility and design patent coverage if both its usefulness and ornamental appearance are new and original. There are, however, important differences in how the law treats utility patents and design patents. Some of the more important differences are highlighted below.

(A) Term: A utility patent can have a term of 20 years measured from the U.S. filing date. A design patent has a term of 14 years measured from the date of grant.

(B) Maintenance Fees: In order to enjoy the full 20-year term for a utility patent, maintenance fees must be paid at 3-1/2, 7-112 and 11-112 years during the life of the patent. Design patents do not require maintenance fees.

(C) Publication: An application to obtain a utility patent will normally be published by the patent office. An application for a design patent is not published.

(D) Claims: A utility has specific claims, sometimes hundreds of them. A design patent can have only one generic claim directed to the shown ornamental design.

## **III. Format of a Design Patent**

Set out below is a sample design patent. It shows the format and simplicity of the patent.

[54] DOUBLE LUMEN CATHETER

[76] Inventor: Sakharan D. Mahurkar, 1925 W. Harrison St., Chicago, Ill. 60612

[\*\*] Term: 14 Years

[21] Appl. No.: 317,232

[22] Filed: Nov. 2, 1981

[51] Int. Cl. D24-02  
 [52] U.S. Cl. D24/56, 604/44  
 [58] Field of Search 604/43-45; D24/56, 51

[56] References Cited  
 U.S. PATENT DOCUMENTS

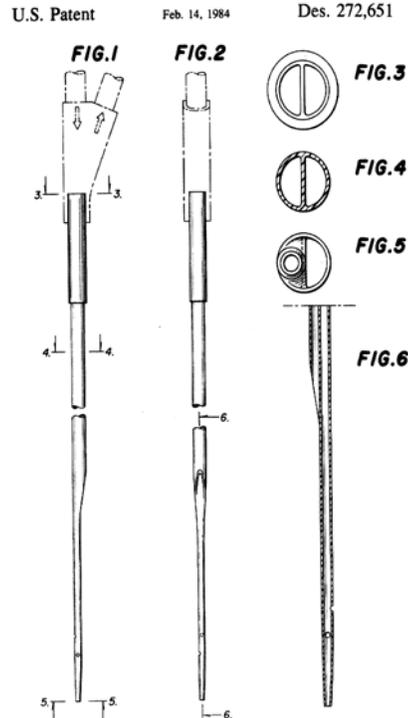
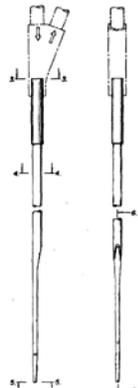
D. 256,617	8/1980	Clemens	D604/43	X
4,099,328	7/1978	Sorenson et al.	604/44	
4,134,822	1/1979	Mahurkar	24/56, 52	
4,146,884	3/1979	Tenstaegen et al.	604/44	
4,270,533	7/1981	Bogus et al.	604/44	

OTHER PUBLICATIONS  
 Journal of American Medical Association, Feb. 21, 1959, 138/836, Double Lumen Catheter.  
 Primary Examiner—Bernard Anther  
 Attorney, Agent, or Firm—Ehrlich & Lee and Brown, H.E. Dübmar, Scotland, Strassman & Levy

[57] CLAIM  
 The ornamental design for a double lumen catheter, as shown and described.

DESCRIPTION

FIG. 1 is a side elevational view of a double lumen catheter showing my new design.  
 FIG. 2 is a rear elevational view of the catheter illustrated in FIG. 1;  
 FIG. 3 is an end view of the solid line portion of the catheter illustrated in FIG. 1 as seen along line 3—3 thereof;  
 FIG. 4 is a sectional view of the catheter illustrated in FIG. 1 as taken along line 4—4 thereof;  
 FIG. 5 is an end view partly in section of the catheter illustrated in FIG. 1 as seen along line 5—5 thereof; and  
 FIG. 6 is a sectional view of the bottom portion of the catheter illustrated in FIG. 2 as taken along line 6—6 thereof.



#### IV. Assessing Infringement of Design Patents

Assessing infringement of a design patent is a very difficult process. The starting point for any discussion of the law of design patents is an old decision by the Supreme Court, *Gorham Co. v. White*, 14 Wall. 511, 81 U.S. 511 (1871). That case involved a design patent for the handles of table spoons and forks. In its analysis of claim infringement, the Court stated that the test of identity of design "must be sameness of appearance, and mere difference of lines in the drawing or sketch . . . or slight variances in configuration . . . will not destroy the substantial identity." *Id.* at 526-27. Identity of appearance, the Court explained, or sameness of effect upon the eye, is the main test of substantial identity of design; the two need not be the same "to the eye of an expert," because if that were the test, "[t]here never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them." *Id.* at 527.

The Gorham Court then set forth the test that has been cited in many subsequent cases: "[I]f, 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, the first one patented is infringed by the other." 81 U.S. at 528. The Court concluded that whenever an accused product is the same in general appearance and effect as a patented product, even though there may be differences in the products, if the two products are so much alike that even persons in the trade would be in danger of being deceived, infringement results. *Id.* at 531. This standard has come to be known as the "ordinary observer" test.

The Federal Circuit Court of Appeals recently confirmed that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed.<sup>1</sup> Under that test, infringement will not be found unless the accused article "embod[ies] the patented design or any colorable imitation thereof."

Importantly, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will require a comparison of the claimed and accused designs with the prior art. Thus, the differences between the claimed design and prior art designs are relevant. Where there are many examples of similar prior art designs, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art. Infringement will therefore boil down to this question: Is the design of the accused product closer to the prior art or closer to that of the patented design?

Note also that if the accused infringer elects to rely on the comparison to prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer.

Don V. Kelly  
Evans & Dixon, LLC  
Suite 2500  
211 N. Broadway  
St. Louis, MO 63102  
dkelly@evans-dixon.com

---

<sup>1</sup> *Egyptian Goddess v. Swisa*, 543 F.3d 665, Fed. Cir. (2008)