



**OMNICA**  
CORPORATION

Product Development

*Engaging Views and OMNInews*

DESIGN AND ENGINEERING NEWSLETTER

## **Bolster Your IP Portfolio with Design Patents.**



There are three basic types of patents, utility, design and plant patents. Of the trio, utility patents have long been considered the most sought-after form of intellectual property protection in the medical device

community. Companies can prevent others from making, using, selling or importing into the United States any product that is functionally protected by the venerable legal instrument.

Until recently the most undervalued and least recognized of the three types was the design patent. It suffered a historically negative view mostly because it was perceived as trifling when compared to the all-powerful utility patent.

Perceptions changed in 2011 when Apple sued Samsung for billions because of patent infringement. To almost everyone's amazement, drawings defining four (4) design patents were the basis of the lawsuit, not the devices themselves. Apple was eventually awarded \$1B, and now everyone is aware of this impressive and under-utilized type of IP protection.

### **A remarkable way to preserve valuable IP**

Design patents are intellectual property protection based on ornamental configuration, surface decoration or both. An example is a distinctive design aspect like rounded corners. The claimed details of the patent are described with line drawings, not photographs. The drawings typically depict seven different views with feature descriptions shown as solid lines.

To qualify for a design patent the subject must be original and not obvious – it must display ingenuity and cannot be already known or viewed as a predictable extension of prior art by a person with ordinary skill in the field. It must be aesthetically unique, and the design

must be repeatable. For example, a unique method for applying a decorative paint coating or effect cannot be protected by a design patent. Most importantly, a design patent is obtained for protecting the way a product looks, not the way it functions.

### **Potent features in a simple package**

The design patent protects the owner by preventing others from making, importing, using, or selling a product that looks similar. For a low nominal cost, design patents can be extremely valuable, much less complicated, and easier to defend than trade secrets, copyright, trademarks, or utility patents. The entire disclosure can be a single page. Ironically this simplicity exposes the only downside. Protection is limited to ornamentation that only covers key features or specific attributes defined in the patent, not the function of the product.

Laws broadening the afforded protection have become stricter, and since 2008 the courts have placed a greater emphasis on the overall infringing design rather than the small details in isolation. If an ordinary observer (the general public) who is familiar with other similar patented designs believes the article in question substantially resembles the patented product, infringement can be more easily proved. This was a key point in the Apple vs Samsung case when, according to Apple, Best Buy told Samsung that customers were returning their tablets because they later realized what they had purchased wasn't an iPad.

**The laws are stacked heavily in favor of the plaintiff. Trial costs are much less, and easier to litigate than trademark, copyright, and utility patents.**



**OMNICA**  
CORPORATION

Product Development

*Engaging Views and OMNInews*

DESIGN AND ENGINEERING NEWSLETTER

In the U.S., design patent litigation is based on the legal standard of observations of "ordinary people" who are asked to decide if the offending product looks like, but not necessarily identical to, the object in question. Jury observations are non-technical, and the jurors don't need special skills other than common sense to reach a decision.

There are no professional advisors, no technical disclosures, and no requirement to decipher confusing concepts from expert witnesses. In this simplified process, cases are based on pictures, not function. Affirmative answers to questions such as, "Does it look like the other product or would the ordinary observer be confused?" can support a claim.

- **Damages are based on reasonable royalties or loss of profits**

Profits rewards are not available to utility patent holders whose cases are usually based on royalty infringement only.

- **Design patents don't ask for a monopoly**

Plaintiffs ask infringers to "change the design" not "stop producing the product", avoiding the tangle of monopoly litigation seen in utility patent cases that can limit or derail the overall protection effort.

- **Cases don't always go to trial**

Infringement is typically easy to determine, even without a jury. In design patent cases where there is a clear-cut case of infringement, the defendant usually settles, since the odds at trial are poor.

**A relatively inexpensive, easily available, but unexploited resource.**

Design patent owners have the right to use the terms, "patent issued" and "patent pending", to notify potential infringers that they may be liable for damages and injunction if their protected device is copied. Coverage can be wide-ranging to include medical device interfaces, packaging, contrast and color, a unique page-turn animation, or any key design feature.

Products by consumer goods manufacturers that may not have a patentable utility or function can be safe-guarded from knock-offs and wholesale copying on appearance alone. An important characteristic is that no disclosures are necessary for defense, unlike utility patents when litigation can reveal trade secrets or proprietary information.

Utility patents will always be stronger, broader, and far more desirable, but design patents have their place as a strategic layer of protection for a medical device IP portfolio. They have a high allowance rate, are relatively easy defend, and protection can be obtained on the basis of a single claim.

Applications are issued quickly, usually within 12 months, and they can cost as little as \$2000 (utility patents are five to ten times that price) for a small entity. No actual product needs to be for sale or sold to obtain a design patent which will remain in force for 14 years (soon to be 15) and there are no maintenance fees.

Ron Sully is Omnicor's Director of Marketing  
He can be reached at: [materialize@omnicor.com](mailto:materialize@omnicor.com)