DESIGN PATENT PRACTICE GUIDE

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Design Patent & Trademark Litigation

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I. Introduction

Design patents are one of the most underutilized tools in intellectual property law — and one of the most powerful. For companies that invest in the look and feel of their products, design patents can mean the difference between owning your market and watching competitors copy it.

This guide is written for business owners, product managers, and in-house legal teams who want a practical understanding of design patents: what they protect, how to get them, and how to use them. It is not a manual for patent practitioners. The goal of this guide is to provide readers with enough knowledge to make smart decisions about IP strategy and to work effectively with outside counsel when the time comes.

This guide covers the full lifecycle of a design patent — from deciding whether to file, through prosecution at the United States Patent and Trademark Office (USPTO), to enforcing your rights in litigation or defending against someone else's claim. It also addresses recent legal developments that have meaningfully changed the design patent landscape, including a landmark 2024 Federal Circuit decision that overhauled the standard for challenging a design patent's validity.

Design patent law is a specialized field, and the details matter. But the fundamentals are accessible — and understanding them will make you a better steward of your company's creative work.

II. What Is a Design Patent?

The Basic Concept

A design patent protects the ornamental or aesthetic appearance of a functional object. In plain terms, it protects the way something *looks*, not the way it *works*.

When a company creates a product with a distinctive visual appearance — a unique shape, a particular surface pattern, a signature silhouette — a design patent gives that company the exclusive right to that visual design as applied to that type of product. If a competitor copies the look of the product, the patent owner has meaningful tools to respond: sending a cease and desist letter to put the infringer on notice, filing takedown requests on e-commerce platforms like Amazon to halt infringing sales, or, when necessary, pursuing litigation in federal court.

Design patents are granted by the USPTO under 35 U.S.C. § 171, which provides patent protection for "any new, original and ornamental design for an article of manufacture." A design patent has a single claim, and that claim is defined almost entirely by the drawings filed with the application — not by written claim language the way a utility patent is.

Design Patents vs. Utility Patents

Most people are more familiar with utility patents, which protect inventions — the functional aspects of a product or process. Design patents and utility patents serve different purposes and follow different rules. The key differences are:

What they protect. A utility patent protects how something works or is used. A design patent protects how something looks. A new type of shoe sole with improved cushioning technology might be protected by a utility patent. The distinctive shape of that same shoe might be protected by a design patent.

How claims work. A utility patent has written claims that define the scope of protection in words. A design patent has a single claim, and the scope of protection is defined by the drawings. This makes the quality of those drawings critically important.

Term. A utility patent has a term of 20 years from the filing date. A design patent issued from an application filed on or after May 13, 2015 has a term of 15 years from the date of grant.

Cost and timeline. Design patents are generally faster and less expensive to obtain than utility patents. The application is simpler, examination tends to move more quickly, and prosecution is typically less involved.

Obviousness standard. Until recently, design patents operated under a different — and more patent-friendly — obviousness standard than utility patents. That changed in 2024 with the Federal Circuit's *LKQ* decision, discussed in Section IX.

A single product can — and often should — be protected by both a design patent and a utility patent if it has both novel functional features and a distinctive appearance.

Design Patents vs. Trade Dress and Copyright

Design patents are not the only form of IP protection available for the appearance of a product. Trade dress (a subset of trademark law) and copyright can also protect visual elements of products, and understanding when each applies is important for building a comprehensive IP strategy.

Trade dress protects the overall commercial image of a product — its look and feel as a source identifier in the marketplace. Unlike a design patent, trade dress protection does not expire as long as the mark remains in use and is not abandoned. However, trade dress must be distinctive and non-functional, and acquiring enforceable rights typically requires either proof that the trade dress has acquired distinctiveness in the marketplace or, in some cases, that it is inherently distinctive. Trade dress protection can overlap significantly with design patent protection, and the two are often asserted together in litigation. For a more detailed discussion of trade dress and trademark protection, see Nowak IP Group's Trademark Practice Guide.

Copyright protects original works of authorship, including artistic and graphic works. It can protect surface ornamentation — a pattern applied to a product, for example — but it does not protect the shape or configuration of a functional article. Copyright protection arises automatically upon creation, requires no registration to exist (though registration is required to sue for infringement in the U.S.), and lasts for the life of the author plus 70 years.

Design patents offer several advantages over both: they provide a clear, defined right with a registration number and a filing date, they protect the overall appearance of the article (not just artistic elements), and they give the patent holder access to powerful damages remedies discussed in Section VII. The tradeoff is that design patents require affirmative prosecution, have a limited term, and must be filed before the expiration of certain statutory deadlines.

What Can a Design Patent Protect?

Design patents cover a wide range of products and industries. Common examples include:

- Consumer products: furniture, footwear, apparel, tools, appliances, packaging
- Automotive parts: vehicle body panels, wheels, interior components
- Medical devices: the shape and appearance of surgical instruments, wearables, diagnostic equipment
- Graphical user interfaces (GUIs): the visual layout of screens, icons, and digital displays
- Industrial and commercial equipment

III. Why Pursue a Design Patent? The Business Case

Stopping Copycats

The most immediate business reason to obtain a design patent is to stop competitors from copying your product's appearance. In many industries — consumer goods, fashion, consumer electronics, automotive aftermarket parts — product designs are routinely copied. A design patent gives you a federally registered right to that design and the ability to go to court to stop infringement and recover damages.

Without IP protection, a company's only recourse when a competitor copies its design may be an unfair competition claim or a trade dress action — both of which are harder to win and require more proof than a straightforward design patent infringement claim.

Brand Protection and Market Differentiation

A distinctive product design is often inseparable from a company's brand. Consumers recognize products by how they look. When competitors copy that look, they free-ride on the brand equity the original designer has built. Design patents protect not just the product, but the visual identity associated with it.

A Uniquely Powerful Damages Remedy

One of the most compelling reasons to pursue design patent protection is the availability of a damages remedy that is not available in most other areas of IP law: the infringer's **total profits**.

Under 35 U.S.C. § 289, a design patent owner can recover the total profit the infringer made from the sale of any article that incorporates the patented design — without any need to apportion those profits to the specific design feature at issue. In a case involving a highly profitable product, this can result in a very large damages award. This remedy was at the center of the landmark *Apple v. Samsung* litigation, in which Apple was awarded over $399 million in total profits from Samsung's sale of infringing smartphones. This remedy is one of the most distinctive and powerful features of design patent law, and it is a significant reason why design patents have grown in importance and value over the past decade.

Speed and Cost

Compared to utility patents, design patents are relatively fast and inexpensive to obtain. The application process is simpler, the prosecution is typically shorter, and application and issue fees are lower (particularly for small and micro entities). For a company looking to build IP protection quickly around a new product launch, a design patent can be filed and potentially issued within a year or two — sometimes faster with expedited examination.

Design Patents as Part of a Broader IP Strategy

Design patents are rarely most effective when used in isolation. The strongest IP programs combine design patents with utility patents, trademarks, trade dress, and copyright to create layered protection around a product or brand. Each form of protection has different strengths, different terms, and different remedies, and a well-designed IP portfolio uses all of them strategically.

For example, a company launching a new consumer product might simultaneously file a utility patent on the functional innovation, a design patent on the product's appearance, and a trademark application on the brand name and logo — while also registering the product's distinctive packaging as trade dress. This kind of comprehensive approach makes it significantly harder for competitors to copy any aspect of the product without exposing themselves to liability.

IV. What Can (and Can't) Be Protected

The Ornamentality Requirement

Design patent protection is available only for the ornamental — meaning decorative or aesthetic — aspects of a product. The design must be primarily ornamental rather than functional. If the appearance of a product is dictated entirely by its function — if it looks the way it does because it has to in order to work — it cannot be protected by a design patent.

This distinction matters in practice. Consider a bicycle helmet: the aerodynamic shape may be functional, but a distinctive surface pattern or decorative fins added to that shape could be ornamental and therefore protectable. Courts look at whether the design serves any ornamental purpose beyond pure function, and whether alternative designs could serve the same function equally well. If multiple design options could achieve the same functional result, the chosen design is more likely to be considered ornamental.

The Article of Manufacture Requirement

A design patent must be applied to an article of manufacture — a physical product or a digital product displayed on a screen. Pure abstract designs or patterns standing alone, without application to a specific product, are not protectable by design patent. The claim always refers to the design as embodied in or applied to a particular article — a chair, a bottle, a smartphone icon, a vehicle grille.

This requirement also defines the scope of protection. A design patent on a chair protects the ornamental design of that chair. It does not automatically protect the same design applied to a table or a lamp. This is why companies with valuable designs often file multiple design patents covering the same

design applied to different articles of manufacture.

What Qualifies

Design patents can protect a wide range of ornamental designs, including the overall shape or configuration of a product, surface ornamentation applied to a product, and combinations of shape and ornamentation. Some of the most actively litigated and commercially valuable categories include:

Product shapes and configurations — the three-dimensional form of a product, such as the distinctive contour of a beverage bottle or the shape of a handheld device.

Surface ornamentation — patterns, graphics, or decorative elements applied to the surface of a product, such as a textile pattern or a decorative trim design.

Graphical user interfaces — the visual layout and appearance of digital screens, icons, and user interface elements. GUI design patents have grown significantly in importance as software and digital products have become central to commerce.

Packaging — the design of containers, boxes, and packaging materials, which can be commercially valuable both as product protection and as brand identity.

What Does Not Qualify

Several categories of designs cannot be protected by design patent:

Purely functional designs — if the appearance of a design is entirely dictated by its function and there are no alternative designs that could serve the same function, the design is not ornamental and is not protectable.

Designs that are not new — a design that is identical or substantially similar to a prior design in the public domain or previously patented cannot receive design patent protection.

Designs that are obvious variations — even if a design is technically new, it cannot be patented if it would have been obvious to a designer of ordinary skill to create it based on existing designs. The 2024 LKQ decision, discussed in Section IX, significantly changed how this standard is applied.

Immoral or offensive designs — the USPTO will not grant a design patent for designs that are deemed scandalous or immoral.

V. The Application Process

Overview

Obtaining a design patent requires filing an application with the USPTO and successfully navigating the examination process. While design patent prosecution is generally simpler and faster than utility patent prosecution, it requires careful attention to a set of rules and requirements that are unique to design applications.

The Role of Drawings — Everything Depends on Them

In a design patent application, the drawings are the claim. Unlike a utility patent, which uses written claim language to define the scope of protection, a design patent has a single claim that simply states: “The ornamental design for [the article] as shown and described.” The drawings do all the work.

This makes the quality and completeness of the drawings critically important. The application must include views from every angle necessary to fully disclose the design — typically a front, back, left side, right side, top, and bottom view, plus a perspective view. If depth, proportion, or any visual feature of the design matters, it must be shown. Examiners can reject applications for inadequate drawing disclosure, and courts have invalidated patents for the same reason.

One important drafting tool is the use of broken lines. Elements of the design shown in broken lines are not part of the claimed design — they are included only to show context or environment. This allows applicants to claim only the most distinctive portions of a design while disclaiming standard or functional elements. Strategic use of broken lines can both broaden and narrow the scope of protection, and the decision of what to claim in solid lines versus broken lines is one of the most important strategic choices in preparing a design patent application.

The Single Claim

Every design patent has exactly one claim. It always takes the same form: “The ornamental design for [article of manufacture], as shown and described.” The scope of that claim — what it covers and what it doesn’t — is determined almost entirely by the drawings. This simplicity is deceptive. Because the drawings define the claim, even small variations in how the drawings are prepared can significantly affect the scope of protection the patent ultimately provides.

Provisional Applications

Unlike utility patents, design patents cannot claim the benefit of a provisional application. There is no design patent provisional. This means the clock starts running from the moment a product design is disclosed or offered for sale. In the United States, an applicant has one year from the first public

disclosure or commercial use of a design to file a design patent application. Miss that deadline and the right to obtain a U.S. design patent is lost. For foreign filings, the deadlines are even tighter — most countries require filing before any public disclosure.

Timeline and Costs

Design patent applications are generally faster and less expensive to obtain than utility patents. A typical U.S. design patent application can be prepared and filed for a fraction of the cost of a utility patent application, and examination tends to move relatively quickly. Total government fees are modest, particularly for small and micro entities who qualify for reduced fees. Once allowed, a design patent issues with a term of 15 years from the date of grant — no maintenance fees are required.

For applicants who need protection quickly, the USPTO offers an accelerated examination program for design applications that can significantly shorten the time to issuance.

International Protection — The Hague Agreement

For companies that need design protection in multiple countries, the Hague Agreement Concerning the International Registration of Industrial Designs provides an efficient mechanism for filing a single international application that can designate protection in over 90 countries. Rather than filing separate applications in each country, an applicant can file one international application through the World Intellectual Property Organization (WIPO) and designate the countries where protection is sought. This can significantly reduce the cost and complexity of building a global design patent portfolio.

VI. Ownership, Assignment, and Licensing

Who Owns a Design Patent

As with other patents, a design patent is initially owned by the inventor — the person who created the ornamental design. In an employment context, ownership typically transfers to the employer through an employment agreement that includes an IP assignment clause, or through operation of law if the employee created the design within the scope of employment. Companies that work with independent contractors or outside designers should be especially careful: absent a written assignment, an independent contractor who creates a design may own the resulting design patent rights, not the company that commissioned the work. Written IP assignment agreements should be in place before any design work begins.

Assigning Design Patent Rights

Design patent rights can be assigned — transferred — to another party. Assignments must be in writing to be enforceable and should be recorded with the USPTO. Recorded assignments are publicly visible in the USPTO's assignment database, which is an important consideration for companies that prefer to keep ownership structures confidential. Some companies use holding entities or subsidiaries to own IP assets, which can provide both liability protection and strategic flexibility.

Licensing

A design patent owner can license the right to use the patented design to others, either on an exclusive or non-exclusive basis. Licensing can be a significant source of revenue, particularly for companies with strong design portfolios that extend beyond their own product lines. License agreements should clearly define the scope of the license — what products, territories, and time periods are covered — as well as royalty terms, quality control provisions, and what happens in the event of infringement by third parties.

VII. Enforcing Your Design Patent

What Constitutes Infringement

A design patent is infringed when someone makes, uses, sells, offers for sale, or imports into the United States a product that incorporates a design that is substantially the same as the patented design — without authorization. The legal standard for infringement is the "ordinary observer" test: would an ordinary observer, giving such attention as a purchaser usually gives, mistake the accused design for the patented design? If the overall visual impression of the two designs is substantially the same in the eyes of an ordinary observer familiar with the prior art, infringement is established.

This test has important practical implications. Minor differences between the patented design and the accused product do not necessarily avoid infringement. On the other hand, the comparison is made in the context of the prior art — if the patented design is very similar to existing prior art designs, the scope of protection is narrower and differences between the patented and accused designs may be more significant.

The Role of Prosecution History

What happens during prosecution of a design patent application can affect the scope of enforceable rights after the patent issues. If an applicant distinguishes the claimed design from prior art during prosecution — by amending drawings or making arguments to the examiner — those distinctions may limit the scope of the patent in subsequent litigation. This is known as prosecution history estoppel, and it is an increasingly important consideration in design patent enforcement. Recent Federal Circuit decisions have reinforced that applicants who make arguments or amendments to overcome prior art references during prosecution may surrender claim scope related to those distinctions. This is one reason why careful, strategic prosecution is important from the outset.

Enforcement Options

When a design patent owner discovers potential infringement, litigation is rarely the first step. The enforcement toolkit includes several options:

Cease and desist letters are typically the first move — a formal letter notifying the infringer of the patent, identifying the allegedly infringing product, and demanding that the infringer stop. A well-crafted cease and desist letter can resolve many disputes without litigation.

Platform enforcement is increasingly important for design patent owners. Major e-commerce platforms including Amazon, Alibaba, and others have intellectual property complaint programs that allow patent owners to report infringing listings and request their removal. Platform enforcement can be fast and effective — particularly against overseas manufacturers selling directly to U.S. consumers — and does not require filing a lawsuit.

Customs enforcement through U.S. Customs and Border Protection (CBP) allows design patent owners to record their patents and request that CBP block importation of infringing products at the border.

Litigation in federal court remains available when other measures fail or when the infringement is serious enough to warrant it. Design patent cases are heard in U.S. district courts, with appeals going to the U.S. Court of Appeals for the Federal Circuit.

International Trade Commission (ITC) proceedings offer another litigation venue for design patent owners facing import-based infringement. The ITC can issue exclusion orders that block infringing products from entering the United States entirely — a powerful remedy that can be faster to obtain than a district court injunction.

Available Remedies

Design patent owners who prevail in litigation are entitled to several remedies. Injunctive relief — a court order requiring the infringer to stop — is often the most important remedy, as it removes the infringing product from the market. Monetary damages are also available, including the infringer's total profits under 35 U.S.C. § 289, compensatory damages, and in cases of willful infringement, enhanced damages of up to three times the compensatory amount. Attorney's fees may also be awarded in exceptional cases.

The total profits remedy deserves special emphasis. As discussed in Section III, this remedy allows a design patent owner to recover all of the infringer's profits from sales of the infringing article — without apportionment. In cases involving popular consumer products, this can result in very substantial damages awards.

VIII. Defending Against Design Patent Claims

Overview

Companies that receive a design patent infringement claim — whether through a cease and desist letter, a platform takedown notice, or a lawsuit — have several tools available to challenge the claim or limit its scope.

Non-Infringement

The first and most straightforward defense is that the accused product simply does not infringe the patent. Under the ordinary observer test, if the overall visual impression of the accused design is sufficiently different from the patented design, there is no infringement. A defendant can also argue that differences between the accused design and the patented design are significant in light of the prior art, particularly where the patented design occupies a crowded field of similar prior designs.

Invalidity

A design patent can be challenged on grounds that it should never have been granted in the first place. Common invalidity arguments include:

Prior art — the patented design was anticipated by an earlier design that was publicly known or used before the patent's filing date.

Obviousness — even if the design was not directly anticipated, it was an obvious variation of prior designs. The LKQ decision discussed in Section IX significantly changed the obviousness standard for design patents, potentially making it somewhat easier to mount an obviousness challenge.

Functionality — if the claimed design is primarily functional rather than ornamental, the patent is invalid.

Failure to meet statutory requirements — if the design patent does not meet the basic requirements of 35 U.S.C. § 171.

Inter Partes Review at the USPTO

Inter partes review (IPR) is a procedure before the Patent Trial and Appeal Board (PTAB) at the USPTO that allows third parties to challenge the validity of an issued patent based on prior art. While IPR has historically been used far more often against utility patents than design patents, it is available for design patents and can be a cost-effective alternative to validity challenges in district court litigation. That said, design patents have shown remarkable durability at the PTAB — invalidity rates for design patents in post-grant proceedings are substantially lower than for utility patents.

Design-Arounds

A design-around — modifying the accused product's appearance to avoid the scope of the patented design — is often the most practical solution when a valid design patent covers a product a company wants to sell. A well-executed design-around can allow a company to continue selling a product while eliminating the infringement risk. The viability of a design-around depends on the scope of the patent and how much design freedom exists in the relevant product category.

IX. Recent Developments You Should Know About

The LKQ Decision — A New Obviousness Standard (2024)

The most significant development in design patent law in decades came in May 2024, when the U.S. Court of Appeals for the Federal Circuit issued its en banc decision in *LKQ Corporation v. GM Global Technology Operations LLC*. The court overruled its prior Rosen-Durling test for design patent obviousness — a standard that had been in place for over forty years — and replaced it with a more flexible approach aligned with the Supreme Court's KSR decision governing utility patent obviousness.

Under the old Rosen-Durling framework, an obviousness challenge to a design patent required identifying a single "primary reference" whose overall visual impression was basically the same as the claimed design, before any secondary references could even be considered. This was a demanding threshold that made design patents difficult to challenge on obviousness grounds.

Under the new LKQ standard, the analysis is more flexible. While a primary reference is still required, the overall visual similarity threshold has been relaxed, and the inquiry is more holistic — asking whether a designer of ordinary skill in the art would have been motivated to modify the primary reference in view of secondary references to arrive at the claimed design. The USPTO has issued guidance implementing this new standard for pending design patent applications.

The practical implications of LKQ are still being worked out in the courts and at the USPTO. In the near term, it is expected to make some design patents somewhat more vulnerable to obviousness challenges, and to affect prosecution strategy for new applications. However, early post-LKQ litigation data suggests that design patents continue to be highly durable in practice.

The New Design Patent Bar (2024)

In January 2024, the USPTO established a new design patent bar — a separate registration pathway allowing individuals with backgrounds in industrial design, architecture, and related fields (but without traditional scientific or engineering degrees) to qualify to represent applicants before the USPTO specifically in design patent matters. Previously, practitioners needed to pass the general patent bar examination, which required a science or engineering background, to represent clients in any USPTO patent proceeding.

The new design patent bar reflects recognition that design patent practice requires a different set of technical skills than utility patent practice — specifically, expertise in visual design and aesthetics rather than engineering. The long-term impact of this change on the practice remains to be seen, but it has the potential to expand the pool of qualified design patent practitioners and bring practitioners with deeper design backgrounds into the field.

Rising Design Patent Filings and Litigation

Design patent filings and litigation have both been trending upward. Design patent case filings in U.S. district courts increased from approximately 320 in 2015 to 465 in 2024, even as overall patent litigation declined. At the same time, the USPTO set new records for design patent issuances in 2024. Graphical user interfaces, automotive parts, and consumer products continue to be among the most active categories.

Importantly, design patents have shown remarkable strength in litigation. Recent data suggests that design patents are invalidated at the district court level at a rate of less than half a percent — far below the invalidity rate for utility patents. This durability makes design patents an increasingly attractive component of a comprehensive IP strategy.

X. Practical Takeaways: Working with Design Patent Counsel

When to Call a Design Patent Attorney

The best time to consult a design patent attorney is before a new product launches — not after. Once a product has been publicly disclosed or offered for sale, the clock is running on the one-year U.S. filing deadline, and in most foreign markets the deadline is even shorter. Early consultation allows counsel to evaluate the design for protectability, identify the most commercially valuable aspects of the design to protect, develop a filing strategy, and coordinate design patent filings with other IP protection such as utility patents and trademark applications.

Design patent counsel should also be consulted before entering a new market where competitors hold design patents, before making significant investments in product design or tooling, when a competitor's product appears to copy your design, or when a cease and desist letter or infringement claim arrives.

What to Bring to the First Meeting

A productive first meeting with design patent counsel goes more smoothly when the client brings clear images or renderings of the product design from multiple angles, information about the product's development timeline and any public disclosures or sales to date, knowledge of any prior art or similar products already in the market, and a general sense of the commercial importance of the design and the markets where protection is desired.

How to Think About Design Patent Strategy

The most effective design patent strategies are built around business objectives, not just legal checklists. Some useful questions to consider include: Which aspects of this product's appearance are most distinctive and commercially valuable? Which competitors are most likely to copy this design, and in which markets? Is this design important enough to the business to warrant international protection? Are there related designs — variations, follow-on products — that should also be protected? How does design patent protection fit into the overall IP strategy alongside utility patents, trademarks, and trade dress?

A well-designed IP program treats design patents not as isolated filings but as part of a coordinated strategy to protect the full commercial value of a product.

Questions to Ask Your Outside Counsel

When evaluating design patent counsel, consider asking: How much of your practice is devoted to design patents specifically? Have you handled design patent litigation, or only prosecution? What is your approach to drawing preparation, and do you work with professional patent illustrators? How do you think about claim scope and the use of broken lines? Are you familiar with international design protection through the Hague Agreement? How will you keep me informed about developments — such as the LKQ decision — that affect my existing portfolio?

XI. About Nowak IP Group

Nowak IP Group is a boutique intellectual property law firm focused on design and trademark litigation and enforcement. The firm was founded on the belief that sophisticated IP representation should not be limited to large corporate clients — that product designers, brand owners, and growing companies deserve the same quality of counsel as Fortune 500 companies, delivered with the attention and responsiveness that only a boutique practice can provide.

The firm’s practice encompasses design patent litigation and enforcement, trademark and trade dress protection and enforcement, and related IP counseling. With deep experience in both the enforcement of design rights, Nowak IP Group is positioned to help clients enforce their IP portfolios.

For more information or to schedule a consultation, visit **nowakipgroup.com** or contact the firm directly.
