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# U.S. Design Patents: Protecting New Fashion Designs Through U.S. Design Patent Rights

## Protections available

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Many fashion creations can, however, benefit from protections offered by design patents. A design patent is often easier to obtain than a trademark registration for trade dress. Given that there is no requirement to show consumer recognition of the design or configuration as a source indicator, design patents are also potentially available for a wider range of product designs and configurations, even those not yet launched in the marketplace. However, a design patent application must be timely filed or the applicant risks losing these rights.

We have filed many design patent applications covering fashion articles. Examples include the following shoe designs:



– And the following handbag designs:



Our filings also include numerous watch and jewelry items, which also lend themselves well to design patent protections:



### **Pendency Time for Design Patent Applications**

Pendency time for design patent applications from filing to examination will tend to be much longer than trademark applications due to backlog at the United States Patent and Trademark Office (“USPTO”). However, design patent applications can be expedited by filing brief petitions requesting such. The applicant must submit the results of a recent and thorough USPTO design patent search, and pay a further USPTO fee. Upon acceptance of the petition and all required submissions, the time to examination and first action can be cut substantially.

### **Requirements of Design Patent Applications**

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The contents of a design patent application also differ substantially from trademark applications. A trademark application usually shows only one view of the design or configuration, while most design patent applications include multiple views of the design—usually between six and seven figures (or more)—to satisfy the requirement for a complete and clear disclosure of the design. As the USPTO is typically very strict in evaluating illustrations in a design patent application, examiners prefer to see the design illustrated with pen and ink drawings prepared by a draftsman. Photographic drawings can be submitted, but these will be rejected if they are unclear or show obscured views or background material. Photographic illustrations of the design may also include many insignificant details that narrow the claim scope. Because the design claimed is strictly construed from the application illustrations, including too much detail can make it easier for an infringer to design around a resulting patent.

There can be significant differences between US design patents and design registrations obtained in other countries. For instance, unlike with registered Community designs in Europe, the USPTO is usually restricted to one embodiment of the design. Thus, variations of a single design often must be excluded, unless these exhibit only very minor differences. Where multiple designs or design embodiments appear in an application, the USPTO will usually require the owner to restrict the application to one design or design embodiment; non-elected designs must then be pursued in separately-filed divisional applications. Those familiar with continuation and divisional application practice in U.S. utility patent applications will note that analogous procedures apply also in design patent practice.

Unless an application is filed in the U.S. through the Hague International Design system, design patent applications are not published before issuance and are typically not available to the public until such time as a patent issues. In addition to confidentiality of applications, much of the same statutory provisions governing patentability in utility patent contexts also apply to designs. These include Section 112 of the Patent Act governing adequacy and definiteness in how the design is disclosed, as well as novelty and obviousness under Sections 102 and 103 and their prior art definitions. However, in practice, these statutory provisions can be applied quite differently to design patents.

Given novelty requirements, patent laws everywhere tend to encourage prompt filing of applications after public use, publication, or disclosure of the design. Failure to file within the prescribed time period can result in a loss of rights. The United States is no different in this regard, and although the law here

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allow for a one year “grace period” to file after the first offer for sale or public disclosure, it can be difficult to precisely measure this time period, and intervening applications from third parties may still bar patenting. These considerations make it important to file applications as soon as possible.

### **The Choice: Design Patent, Trademark Registration, or Both?**

Assuming that a given design is not eligible for copyright protection, and the time period to obtain a patent has not expired, right holders may feel that they must choose whether to pursue protection under the trademark or design patent laws. But, generally speaking, despite general references in some cases to a freedom to copy formerly patented material (such as in the “shredded wheat” case, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) where in a case involving an expired utility patent, the Court commented that the right to make a patented article passes to the public), there are no specific policy or legal prohibitions against obtaining both a trademark registration and a design patent for the same product design. Trademark protections can also be sought and maintained even after a design patent expires.

Design patents and trademark registrations covering the same design can co-exist because they each have different purposes. Design patents protect an inventor who creates an ornamental design, for a limited time. The trademark laws protect a trademark owner and the public from confusion, mistake and deception, so long as the design in question is not functional and is shown to have become recognized as a trademark. These purposes do not conflict or negate the respective eligibility of the design to be patented or to be registered as a trademark.

In contrast, utility patents cover novel features of how a product functions. Thus, the existence of a utility patent that covers a certain design is evidence that the design is functional, and thus ineligible for trademark or trade dress protections. In fact, the existence of a design patent can be evidence that a design is non-functional. So, while the existence of a design patent cannot establish that the design has achieved distinctiveness as a trademark, it is not evidence that the design is ineligible to be protected or registered as a trademark.

Given this, a potential strategy for effective design protection can involve filing a design patent application in the United States early, preferably in advance of any public disclosure or publication (or with a priority claim that pre-dates such disclosures). Once a design patent issues, and the product design is on the market, right holders can continue to develop their trademark and trade dress rights,

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and eventually seek trademark registrations. Of course, much depends on whether the design is registrable, and whether there is adequate evidence of acquired distinctiveness (for instance, significant sales and advertising expenditures attributable to the design, advertising that features and tout the design specifically, coverage of the design in the media, and consumer correspondence or even design awards that reflect recognition of the design).

Thus, right holders can obtain and use design patents to protect their designs as they develop trademark significance over time. They could eventually then file trademark applications that have reasonable chances of achieving registration. In the meantime, right holders can consider adding claims based on common law trademark rights to any enforcement action based on the design patent.

### **Crafting and Enforcing the Design Patent Claim**

A design patent can often allow an applicant to broaden the scope of protections, insofar as it is permitted by the scope of similar prior art designs. For instance, lining in the application drawings can conform the claim to cover smaller features of a larger product. Solid lining is used to delineate the elements of the article being claimed. Broken lines are used for other features of an article that the applicant wishes to exclude from the claim.

To illustrate, in the case of *Lululemon Athletica Canada, Ltd v Calvin Klein, Inc* (Civil Action No 1:12-cv-01034-UNA, in the U.S. District Court for the District of Delaware), Lululemon asserted multiple patents for yoga pants with a particular waistband design. One patent asserted (D645,644) uses solid lines to show and claim the waistband as well as the pant legs.



Through the issuance of a later-filed continuation application based on the original application that matured into the D645,644 patent, Lululemon obtained a broader claim to the waistband alone in its asserted D661,872 patent. This patent illustrates the same design as the earlier one, but illustrates the pant legs in broken lines (and adds a statement indicating that these features are not part of the design claim).



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The D661,872 patent could then ostensibly be applied to other clothing articles with a similar waistband, regardless of the lengths or dimensions of the article below the waistband.

However, this broadening strategy also carries potential risks. Given the expanded claim, a prior art clothing design with the same waistband (for instance, on a pair of shorts), could threaten the validity of the D661,872 patent claim. The presence of prior art designs will therefore limit how far a design claim can be broadened and yet remain enforceable.

By using a similar broadening strategy, two or more patents can cover the same product design and vary the scope of coverage. This flexibility distinguishes design patents from most trademark registrations that cover product designs or configurations. Trademark applications in the U.S. can also utilize broken lines to exclude features of a product as not part of the trademark. However, a trademark registration must cover the actual trademark or trade dress that consumers recognize as distinctive and source indicating. Therefore, while it is theoretically possible to use broken lines to create different protective scopes for product designs and configurations in a succession of trademark applications, showing evidence of acquired distinctiveness that highlights only a specific portion of a product can be very difficult. Conversely, the USPTO may reject evidence directed to the entire article.

## **Conclusion**

Determining the best available protection will depend on specific circumstances, including the nature of the designs to be protected, the timing of their use and launch, and the types of infringement right holders expect to encounter. We routinely assist clients in strategizing and selecting the best forms of product design protections. We recognize that the best forms of IP rights often overlap and strengthen protections. Design patent and trademark rights can be very effective when used in tandem, as their protections are complementary and not mutually exclusive. As brand identity and design often coalesce in the same article, these forms of protections should be seen as cooperating to maintain the integrity and reach of rights holders' iconic products and designs.

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## **Primary Contacts**

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