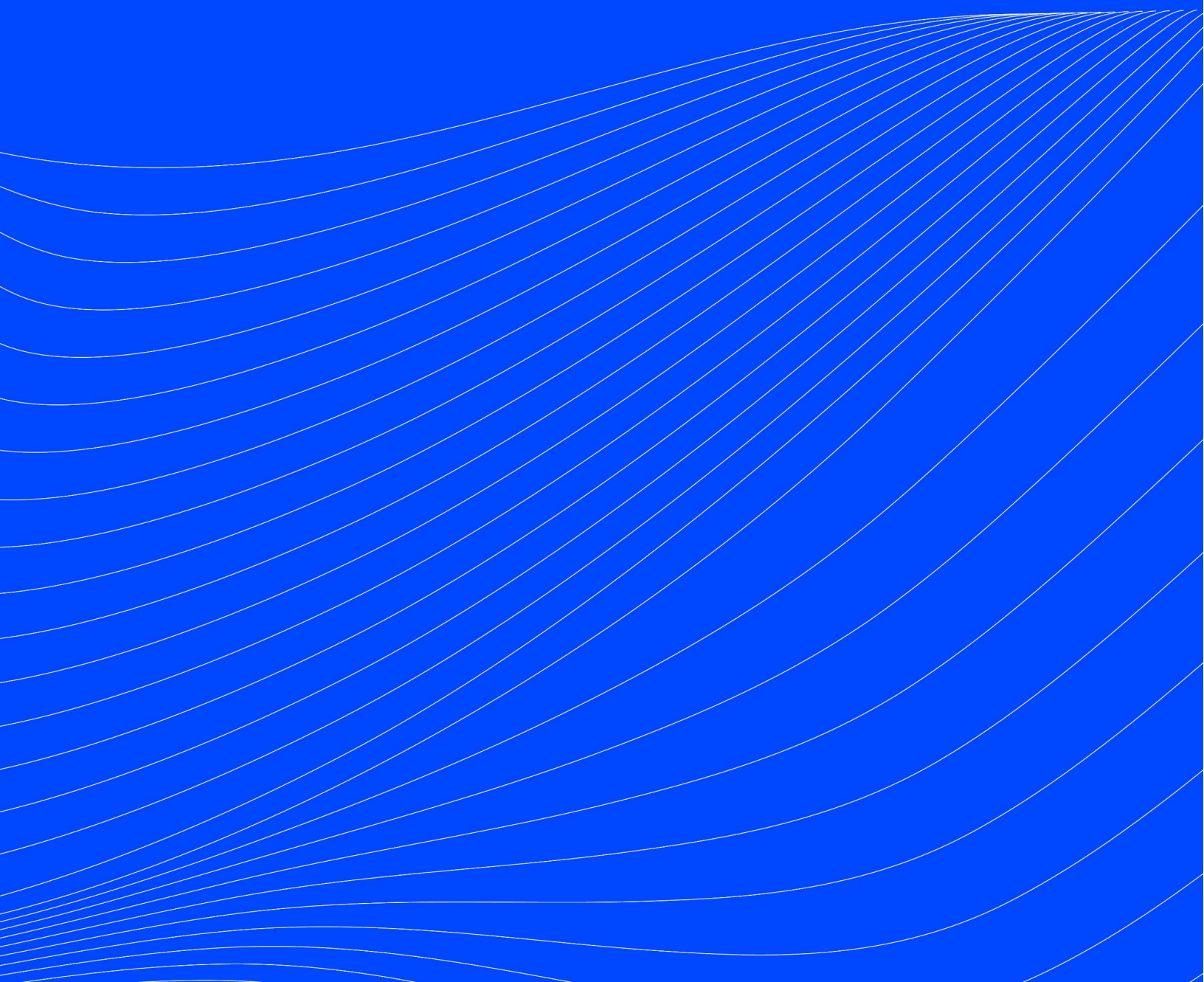


HUSCH BLACKWELL

Beyond Utility

How to Protect Corporate Value with Design Patents

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Beyond Utility: How to Protect Corporate Value with Design Patents¹

Utility patent protection is typically the first thing that comes to mind for protecting a product; however, such protection may not be available when the product has been on the market a long time or is dominated by non-functional aspects. For example, consumable wear products, like seals and valves, often enjoy high margins but have simple designs that are susceptible to copycats. Their profitability justifies aggressive efforts to put in place IP protections, but traditional utility patents might fall short.

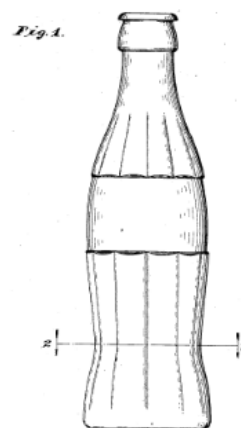
Design patent, trade dress (a form of trademark protection), and copyright protection can all be used to protect non-functional aspects of a product's design. Each offers varying protection under federal law, including the right to stop infringing activity as well as recover monetary damages. While there are pros and cons to each, they can be used together to build a strong web of protection that can last indefinitely, especially when utility patents are of limited use.

DESIGN PATENTS

A design patent protects any new, original, and ornamental design. It allows its owner to prevent another from making, using, or selling a covered product for a period of 15 years. One drawback is that patent protection is unobtainable one year after any public disclosure of the design, including an offer for sale. Because protection is limited to aesthetic features, a design patent can be invalidated if the design is dictated by its function. For example, it would be difficult to obtain a design patent for the shape of a wrench since the handle and head are primarily determined by the need to effectively grip and turn bolts of different sizes.

A good example of a design patent is the iconic shape of the Coca-Cola bottle, which issued in 1923 as design patent [D63,657](#).

Titled “Design For A Bottle,” it covers Coca-Cola’s ubiquitous contoured shape. Another example is Apple’s design patent on the shape of a smartphone, which issued in 2010 as design patent [D618,677](#). While a simple design—essentially a rectangular brick with rounded corners—this design patent proved valuable in the *Apple v. Samsung* patent wars.



¹ “Beyond Utility” was authored by [Stephen F.W. Ball, Jr.](#), a partner in Husch Blackwell’s Technology, Manufacturing & Transportation industry group and a member of the firm’s Intellectual Property practice team. He routinely represents U.S. and international clients in intellectual property litigation and portfolio development and advises on a wide variety of issues related to all types of intellectual property.

Infringement of a design patent is determined by a test of “substantial similarity” and so an accused product does not have to be an exact copy to infringe. In fact, courts have applied an “ordinary observer” test, considering whether the accused product “embodies” the appearance of the patented design. Design patents are relatively easy to obtain and offer broad protection. In fact, the allowance rate for design patents filed with the USPTO is approximately 82%, [according to U.S. Patent & Trademark Office statistics](#).

TRADE DRESS

The distinctive appearance of a product can also be protected as “trade dress” when it acts as an indicator of source. The design must be recognizable such that a consumer appreciates that it serves as short-hand indicator of the origin of products or services, i.e., is a trademark. Unlike a design patent, a trademark has the potential for unlimited duration. But just like design patents, trade dress protection extends only to non-functional aspects. To be non-functional, a design element should not affect product cost, quality, or a manufacturer’s ability to compete in a non-reputational way.

Coca-Cola again provides a good example, having obtained trade dress [Reg. No. 696147](#) in 1960 for the “distinctively shaped contour, or confirmation, and design of the bottle as shown”.

Another example is Tiffany’s protection of its robin’s-egg blue color on its boxes, which registered in 2000 as [Reg. No. 2359351](#). Color is regularly used as an indicator source, as in the pink insulation of Owens Corning or Home Depot’s orange.



Trademark infringement is determined by the “likelihood of confusion” test, which can be broader than design patent protection since a potential consumer quickly scanning store shelves for a product may find two designs “confusingly similar” while an ordinary observer may not find them “substantially similar.” Trademark protection can be obtained at any time, although it must be in continual use in commerce or it may be considered abandoned. Product design is not considered to be inherently distinctive and so must acquire “secondary meaning,” or proof that the design has become distinctive in the eyes of consumers. Five years of exclusive and continuous use of a mark in commerce can be used as evidence of secondary meaning, so it can take time to acquire trade dress protection.

COPYRIGHTS

Finally, copyright protection extends to “original works of authorship fixed in any tangible medium of expression.” Under the Copyright Act, “pictorial, graphic and sculptural works” are specifically

included, providing an inexpensive form of intellectual property protection for product design. As the name implies, it protects against copying, even when the copying is subconscious. Copyright protection typically has a duration of the author's life plus 70 years.

To prove infringement, a copyright owner must show that the infringer not only had access to the copyrighted material, but also that the infringing work incorporates the material. This puts the burden on the copyright owner since any evidence of access is likely in the defendant's possession. As a consequence, independent creation is often successfully used as a defense. However, copyright protection is very easy to obtain, essentially consisting of filling out a government form and paying the \$65 filing fee.

Like trademark protection, a copyright registration can be sought at any time. Copyright protection is also limited to aesthetic features, so the artistic expression must have no substantial practical utility, such as a statue, or be separable from the useful article, such as a picture on a coffee mug. Courts have held that artistic features can be "conceptually," even if not "physically," separable from utilitarian features. As a result, items such as designs for jewelry, fabrics, dinnerware patterns, dolls, Christmas decorations, coin banks, and jewelry boxes have all been found copyrightable.

STRATEGY FOR STRONG PROTECTION

Each form of intellectual property has advantages and disadvantages. While design patents are relatively easy to obtain, they have a limited duration and must be filed within a year of any public disclosure. Trademarks are perhaps the broadest form of protection with a liberal infringement test and potential for unlimited duration but are more difficult to obtain without evidence of "secondary meaning." Copyrights, meanwhile, are inexpensive and easy to get, but require actual copying to enforce.

	Duration	Infringement Test	Rights	Damages
Design Patent	15 years	Substantial similarity to an ordinary observer	Prevent others from making, using, offering for sale, selling, and importing	Lost profits, reasonable royalty, or infringer's profits
Trade Dress	Unlimited	Likelihood of confusion	Prevent others from using a confusingly similar design in commerce	Lost profits, reasonable royalty, infringer's profits, or actual commercial damages
Copyright	Life of author plus 70 years	Access and copying	Prevent others from copying, displaying, selling, or creating derivative works	Actual damages and infringer's profits, or statutory damages

The three forms can be used in combination for best effect. First, file an application for a design patent. This simply requires black and white drawings showing the design. At the same time, file a copyright application because it is inexpensive and simple, and can use the same drawings. Once the product begins to be used in commerce, file a trade dress application. The trade dress application will most likely be rejected for lacking distinctiveness, in which case the applicant will generally have the opportunity to move it to the supplemental trademark register. After five years, the applicant can file again on the primary register, citing the registration on the supplement register as evidence of five years exclusive use.

In this way, design patent and copyright protection help provide a valuable period of exclusivity during which one may achieve the secondary meaning needed for trade dress protection. As the limited duration of a design patent nears expiration, one shifts reliance to the potentially unlimited duration afforded under trademark law. Moreover, trademark rights can become more valuable with age due to growing consumer recognition, whereas the value of a design patent may decrease as expiration approaches.

CONCLUSION

Given the resources that go into designing and marketing a product, it is important to seek IP protection and prevent others from unjustly piggybacking off that investment. This is particularly so for high-margin consumable wear products, which may not be well suited to utility patent protection. Product designs can and should be protected by using different forms of intellectual property to the fullest extent possible.