INTELLECTUAL PROPERTY

DESIGN PATENTS VS. UTILITY PATENTS. WHAT'S THE DIFFERENCE?

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Design patents protect how something looks whereas utility patents protect how something works. Design patents protect ornamental features of an invention, not its function. Utility patents protect the functional features of an invention, not its looks. If you want to protect the functional features of your invention, then apply for a utility patent. If you want to protect the ornamental features of your invention from being copied, then apply for a design patent.

But what does "design" mean? According to the US Patent & Trademark Office, a design consists of the visual ornamental features of an article of manufacture. Since a design is expressed in appearance, the subject matter in a design patent application may relate to the configuration or shape, the surface ornamentation, or to the combination of configuration and surface ornamentation in an invention. A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture.

Sometimes it may be appropriate to apply for both design and utility patents for the same invention to protect both its looks and its function. For example, a design patent for the design of the ornamental base of a desk lamp, and a utility patent for the electrical circuitry in the desk lamp.

While utility and design patents afford legally separate protection, the utility and ornamentality of an invention may not always be easily separable as inventions may possess both functional and ornamental features. A design for an invention that is dictated primarily by the function of the invention does not pass muster for a design patent. There has to be a unique or distinctive shape or appearance to the invention that is not dictated by the function that it performs.

For an invention to be patentable it must be original and new (i.e., novel and non-obvious in view of what exists). The patentability of an invention in a design patent comes from the new ornamental features of the invention, whereas the patentability of an invention in a utility patent comes from the new technical aspects of the invention.

Interestingly, sometimes an invention may be considered patentable in a design patent application because its ornamental features are new, but not patentable in a utility patent application because its functional features are not new (and vice versa). For example, a cup with a three-dimensional floral pattern on its exterior walls may be new in design compared to a regular plain cup, and yet may not be functionally new in utility because its function is same as the regular plain cup, to hold liquids.

There can be only one invention in a patent application. If a design or a utility patent application contains more than one invention, the patent office will require the additional inventions to be canceled or moved to a new (divisional) patent application.

Patents are territorial. A U.S. patent does not protect against copying your invention in another country. Therefore, a patent maybe needed for each country of interest. Finally, to preserve the right to apply for and obtain a patent, an invention must be kept confidential until a patent application for it has been filed. Consult an experienced patent attorney.