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Alert | Equine Industry Group

May 2022

Don't Miss the Easy Jumps! Design Patents, An Often-Overlooked Form of IP Protection for the Equine Industry

This GT Alert covers the following:

- Intellectual property protection in the equine industry often includes trademarks, copyrights, and rights of publicity, but design patents can also be a powerful tool.
- Design patents, which protect only the ornamental, non-functional appearance of a manufactured object, can overlap copyright and trademark protection.
- Design patent holders may recover as damages the "total profit" an infringer makes from the infringement, an option not available for utility patents.
- Recent examples of design patents in the equine industry include ornamental designs for: an equine grooming brush, a horseshoe, equine jewelry, and a bridle.

Intellectual property (IP) law allows individuals, in certain circumstances, to protect "creations of the mind," providing the owner with exclusive ownership and the right to monetize in various ways, depending on the type of IP at issue. When considering protection for IP in the equine industry, trademarks, copyrights, and rights of publicity most immediately come to mind. But there is another type of intellectual property protection, often overlooked, that can be a powerful tool – design patents.

In the United States, patents can protect processes, machines, articles of manufacture, and compositions of matter that are new, useful, and non-obvious. There are multiple types of patents in the United States. Utility patents, for example, cover the way something works and constitute most issued patents in the United States. Design patents protect the external appearance of a manufactured object, and can overlap copyright and trademark protection.

Design patent protection in the United States has existed since 1842, and covers "any new, original, and ornamental design," explicitly making ornamentality a subject-matter limitation on the availability of a design patent and defining the scope of design patents based on their visual character. While the Supreme Court has held that a design "must present an aesthetically pleasing appearance that is not dictated by function alone" (see *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989)), given the subjective nature of "aesthetically pleasing" the focus on what constitutes an "ornamental design" is whether the appearance of the article is essential to the function of the article to which the design is applied. If there are multiple ways to achieve the function, the more likely a particular design will be considered ornamental.

Today, 35 U.S.C. § 171 sets out the criteria for obtaining a design patent*, Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009), stating that "[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title." *Id.* (quoting 35 U.S.C. § 171).

Design patents cover only the ornamental, non-functional *appearance* of an object, with drawings of the design essentially constituting the patent's disclosure. They are characterized by a "D" at the beginning of the patent number, and a single claim referring to a drawing or set of drawings.

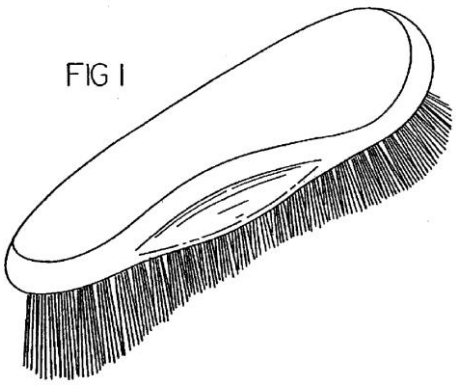
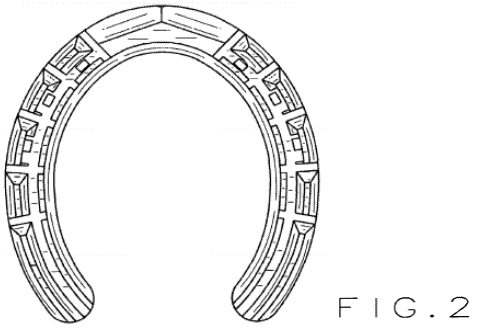
Like other U.S. patents, design patents must satisfy the following requirements:

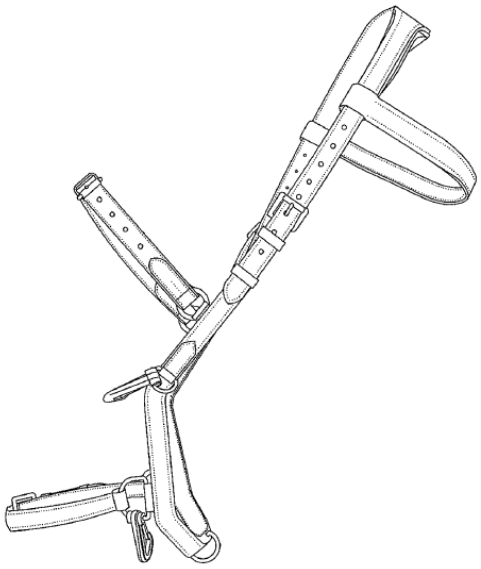
- Under 35 U.S.C. § 112, they must disclose enough information to practice the invention. The disclosure is an important part of patent protection, because regardless of the type of patent, the idea is that the patent office gives you protection (the exclusive right to make, use, sell something) for a limited period of time in exchange for a complete disclosure.
- Under 35 U.S.C. § 102, they must be novel. This means you cannot obtain protection for a design someone has already claimed, or has already been in public use or on sale before you invented it and applied for protection at the patent office.
- Under 35 U.S.C. § 103, they must be non-obvious.
- The design must be ornamental and not merely functional, and devices that are hidden in use are specifically not ornamental.
- 35 U.S.C. § 284 allows patent owners to recover a reasonable royalty or lost profits in cases of infringement and, in cases of willful infringement, they may recover enhanced damages. Design patent holders may elect another remedy: under 35 U.S.C. § 289, they may recover as damages the "total profit" an infringer makes from the infringement, an option not available for utility patents.

While utility patents carry maintenance fees, requiring periodic (and increasing) payments to the Patent Office to keep them in force, design patents do not have maintenance fees. They currently last 15 years from the date on which they are issued.

Design patents also offer the opportunity for international protection, either through the Paris Convention or the Hague System, although foreign jurisdictions have varying requirements that require careful forethought if filing outside the United States is an objective.

Today, utility patents are routinely issued for such items as pet toys, bowls, feeding devices and feeders, carriers, harnesses, brushes, containment and enclosure devices, training devices, animal habitats, pet accessories, bull riding spurs, and livestock marking tools, but design patents also issue to protect the appearance of products in this space. Recent examples include:

Ornamental design for equine grooming brush (D509,658)	
Ornamental design for horseshoe (D922,697)	

Ornamental design for equine jewelry (D665,697)	 FIG.3
Ornamental design for a bridle (D635,724)	 Fig. 4

Design patents can be extremely valuable and may be used in conjunction with copyrights and trademarks to help protect IP in the equine industry. While often overlooked, they are a powerful tool that can help offer protection both in the United States and abroad.

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