Equine Industry Shouldn't Overlook Design Patent Protection

By **James DeCarlo and Vanessa Palacio** (May 25, 2022)

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Intellectual property 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 and comprising just a small fraction of equine IP patents, that can be a powerful tool — design patents.

At the recent 15th Annual Design Day, U.S. Patent and Trademark Office Director Kathi Vidal explained that overall, design patent applications surged to a record 54,200 last year, demonstrating how valuable design patents are to economic growth, job creation and the health of local communities.

And with China's entry into the Hague System on May 5, securing international design protection in one of the world's largest and most dynamic markets — with more than 50% of the global design registration volume every year — will now be quicker and easier.

But while there have been over 200,000 applications for utility patents related to the equine industry, fewer than 5,000 design patent applications have been submitted in this space to date.

In the U.S., patents can protect processes, machines, articles of manufacture and compositions of matter that are new, useful and nonobvious.

There are multiple types of patents in the U.S. Utility patents, for example, cover the way something works and constitute most issued patents in the U.S.

Design patents protect the external appearance of a manufactured object, and can overlap copyright and trademark protection.

Design patent protection in the U.S. 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.

The U.S. Supreme Court has held — in the 1989 Bonito Boats Inc. v. Thunder Craft Boats Inc. decision — that a design "must present an aesthetically pleasing appearance that is not dictated by function alone."

However, given the subjective nature of the term "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.

Title 35 of the U.S. Code, Section 171 sets out the criteria for obtaining a design patent 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."[1]

Design patents cover only the ornamental, nonfunctional appearance of an object, with drawings of the design essentially constituting the patent's disclosure. They are characterized by the letter 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 Title 35 of the U.S. Code, Section 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 and sell something — for a limited period of time in exchange for a complete disclosure.

- Under Section 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 Section, 103, they must be nonobvious.

- The design must be ornamental and not merely functional, and devices that are hidden in use are specifically not ornamental.

- Section 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 Section 289, they may recover as damages the total profit an infringer makes from the infringement, an option not available for utility patents.

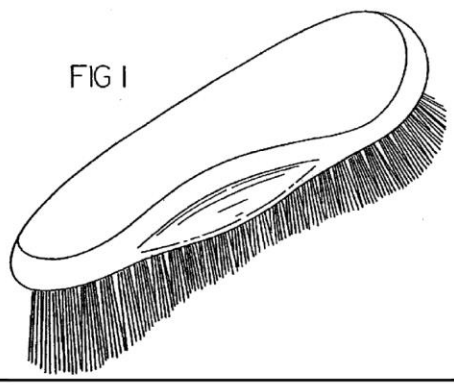
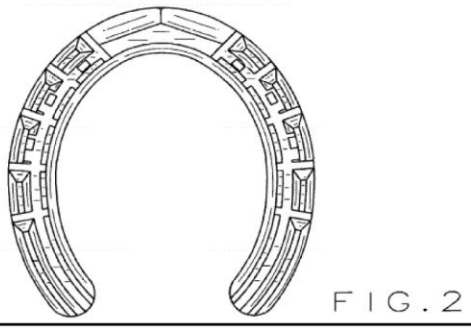
While utility patents carry maintenance fees, requiring periodic — and increasing — payments to the patent office to keep them in force, design patents do not have maintenance fees. They currently last 15 years from the date on which they are issued.

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 U.S. 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)	

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 U.S. and abroad.

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[1] Title 35 of the U.S. Code, Section 171, (as quoted in Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233 2009 U.S. App. LEXIS 27648 ** | 93 U.S.P.Q.2D (BNA) 1001.)