

# An Introduction to Intellectual Property For Industrial Design Professionals

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## **Introduction**

Intellectual property (“IP”) is an area of law dealing with legal issues relating to the products of human ingenuity and creativity. This memorandum is intended to provide a general overview of three areas of IP law that commonly arise in the industrial design process: patent law, copyright law, and trademark law. A complete treatment of any one of these areas is beyond the scope of this document.

It should be noted that, generally, IP protection is country-specific. In other words, obtaining IP protection in one country does not provide protection in any other country. *This document discusses IP in the context of U.S. law. The IP laws of other countries differ significantly.*

## **Patents**

A U.S. patent gives its owner the right to stop others from using the invention claimed in the patent in the U.S. for a limited period of time.<sup>1</sup> Unless the invention is assigned to another, the owner of an invention is the inventor. An inventor is anyone who makes a substantial conceptual contribution to the invention.<sup>2</sup>

There are many requirements that must be met to obtain a patent. One such requirement is that the invention must be “new,” meaning that it must not be anticipated by or an “obvious” modification of any previous invention (a.k.a. “prior art”). Another very important requirement to remember is that a patent application must be filed for an invention within one year of the first commercialization or public disclosure of the invention. Selling or offering to sell the invention are examples of commercialization. Showing the invention in an industry publication is an example of a public disclosure. Any patent rights in the invention are gone forever if an application is not filed within this one-year grace period. In addition, most countries other than the U.S. do not have this grace period, meaning that an application must be filed before commercialization or public

disclosure.

A U.S. patent is obtained by filing an application with the United States Patent and Trademark Office (“USPTO”) and obtaining approval from a USPTO Examiner, which takes place through an examination process. No patent rights arise until and unless the application issues as a patent.

There are several types of patents, each of which protect different things: utility patents, design patents, and plant patents.<sup>3</sup> Plant patents are not discussed in detail here because they do not often arise in the context of industrial design. As will be explained below, utility and design patents protect different aspects of an invention, but it is often possible to protect a single invention with both utility and design patents.

## ***Utility Patents***

In general, a utility patent protects the functional aspects of an invention and/or the process by which it is made. The scope of protection of a utility patent is defined by one or more written “claims” that appear at the end of the patent. Accordingly, the claims must be carefully crafted to recite what is “new” about invention in the broadest possible terms, while distinguishing over what is shown in the prior art.

The costs associated with preparing and filing a non-provisional patent application are substantial. For example, a utility patent application for a mechanical invention of minimal complexity typically costs about \$5,000-\$7,000 to prepare and file. There are substantial additional costs associated with prosecution of the application in the USPTO and keeping an issued utility patent in force. In situations where such costs are prohibitively high, there are some less-costly alternatives that can temporarily preserve patent rights and provide an inventor with additional time to determine the commercial viability of the invention. An experienced patent attorney can help guide inventors through this process.

*This document is intended to provide general information and is not legal advice. For additional information or fact-specific questions, please consult an intellectual property attorney.*

## ***Design Patents***

In general, a design patent protects the aesthetic (“ornamental”) aspects of an invention. In a design patent application, the claim is defined by line drawings or photographs that are filed with the application. Like the written claims of utility patent applications, the drawings or photographs of a design patent application must be carefully crafted to define what is “new” about the invention in the broadest possible terms, while distinguishing over what is shown in the prior art.

A design patent is, generally, less expensive to obtain than a utility patent. A typical design patent application costs about \$1,000-\$2,000 to prepare and file. The costs associated with prosecution of a design patent application are often less than \$1,000, but can be higher if substantive examination is necessary.

Each design patent can only have one claim (utility patents can have many claims). Therefore, it is common for the owners of a design to seek several design patents to protect different aesthetic features of a single design.

## **Copyright**

Copyright rights attach to any “original work of authorship” and enable the owner of the copyrighted work to prevent others from copying, publicly displaying, making “derivative” works or unfairly using the work. Common examples of potentially copyrightable works include websites, drawings, photographs, books, architecture, movies, music, computer software, etc. Copyright protection can be available for the appearance of “useful articles,” such as consumer products, if there are aspects of its appearance that are “separable” from functional considerations.

Copyright law protects the work itself, not the ideas, facts, etc. contained in the work. For example, consider a book describing an idea for a better mouse trap. Copyright law could protect against unauthorized reproduction of the book itself, but could not prevent anyone from making and selling the mouse trap described in the book. Only a patent can protect the underlying ideas expressed in a copyrighted work.

Authorship and ownership issues in copyright can be complicated. In some cases, the person(s) who create a work are the authors of that work and are also the owners, unless ownership is assigned to another. However, an

employer is considered the author/owner of works created by employees in the ordinary course of their employment.

Copyright rights attach to a work automatically. However, there are advantages associated with obtaining a Copyright Registration from the U.S. Copyright Office that make registration desirable. For example, obtaining a registration is usually a prerequisite to filing a lawsuit in U.S. federal court for copyright infringement. In addition, the costs associated with obtaining a Copyright Registration are usually quite low.

## **Trademark**

Since trademark issues arise less commonly during the industrial design process than patent and copyright issues, only a brief introduction is included here. A trademark is anything, e.g., a word, a phrase, a logo, a sound, etc., that is used to distinguish the goods or services of one person or entity from those of another. Although, trademark rights arise automatically through use of a trademark, obtaining a trademark registration is often desirable.

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<sup>1</sup> The term varies depending up which type of patent is involved. For instance, a utility patent based on an application filed after June 7, 1995 has a term of 20 years from its filing date, while a design patent has a term of 14 years from its issue date.

<sup>2</sup> It is not uncommon for an industrial designer working on a new design to incorrectly assume that he or she is not an “inventor” for the purposes of a patent application, especially when working in cooperation with an engineer.

<sup>3</sup> The USPTO’s website, [www.uspto.gov](http://www.uspto.gov), has a searchable database of issued patents and published patent applications and is a good place to familiarize yourself with the format and style of U.S. patents.

### *About the author:*



Damon A. Neagle is an intellectual property attorney and founder of Design IP, a law firm dedicated to intellectual property protection for industrial designs.



5100 W. Tilghman St.  
Suite 205  
Allentown, PA 18104  
(610) 395-4900  
[damonneagle@designip.com](mailto:damonneagle@designip.com)