



Design Patents



Patently Strategic | Feb. 26, 2026

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Ice Breaker

Is a tattoo an
ornamental design
or an article of
manufacture?



Copyright by Henry & James and James B. Stewart, Eng., N.Y.

Ice Breaker

Is the Statue of
Liberty's
ornamental
design eligible
for design patent
protection?

Definition of a Design Patent

- **Design Embodied in or applied to an article of manufacture.**
 - Claimed subject matter is the design embodied in or applied to an article of manufacture (or portion thereof) and not the article itself
 - Is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods
- **Visual characteristics.** The design for an article consists of the visual characteristics embodied in or applied to an article.
- **Manifested in appearance.** The subject matter may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.

Features of a Design Patent

- Design patents protect the visual appearance of an article, not its function
- The **drawings** are the claim
- **Solid lines** define the claimed design
- **Dashed lines** show unclaimed subject matter or environment
- Only what is shown in **solid lines** is protected
- **Dashed lines** help focus the claim on specific visual features
- Scope of protection is determined by the overall **visual impression** of the claimed portions

Obviousness for Designs

- Design patent obviousness now follows the same flexible framework as utility patents under *LKQ v. GM*
- The Federal Circuit eliminated the rigid *Rosen-Durling* “primary reference” test
- Courts now apply the *Graham* factors from utility patent law
- Analysis focuses on overall visual impression from the perspective of an ordinary designer using analogous art
- The decision increases flexibility but creates uncertainty around analogous art, motivation to combine, and secondary considerations

Term of Design Patent

- **Applications filed on or after May 13, 2015:** 15-year term from the date of grant
- **Applications filed before May 13, 2015:** 14-year term from the date of grant

Distinction Between Design and Utility Patents



Utility



Design

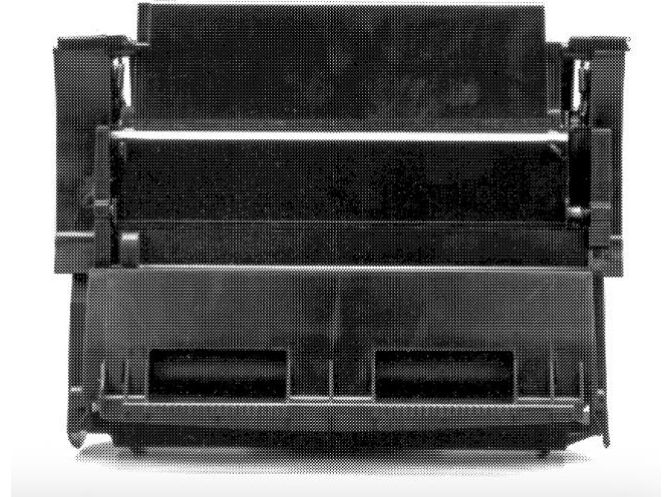
- In general terms, a “utility patent” protects the way an article is used and works ([35 U.S.C. 101](#)), while a “design patent” protects the way an article looks ([35 U.S.C. 171](#)).
- The ornamental appearance for an article includes its shape/configuration or surface ornamentation applied to the article, or both.
- Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance.

POP QUIZ

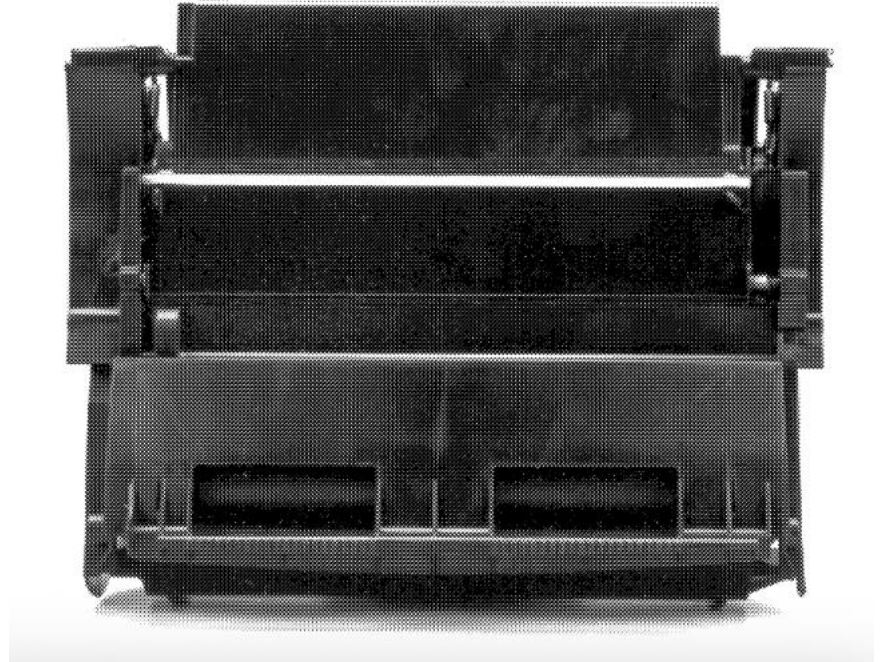
Is a key
eligible for
design
patent
protection?



How is a key similar to a toner cartridge?



Is the toner
cartridge
design patent
likely to
withstand
litigation?



**Lexmark
International,
Inc. v. Static
Control
Components,
Inc.**

- Remanufactured toner cartridge industry introduction
- who is Lexmark
 - who is static control
 - Design–Patent Invalidity
 - Design patents are issued to whoever “**invents any new, original and ornamental design for an article of manufacture.**” 35 U.S.C. § 171
 - To be patentable a design must be **new, original, ornamental and nonobvious**
 - The design of the Lexmark cartridges were **functional** and not ornamental
 - design/use=**no**
 - not observed =**no**
 - **hip implants**

Appearance is not a matter of concern to the end-user even if visible in an ad.

POP QUIZ:
Duplex
horizontal
receptacle
**Design or
Utility?**

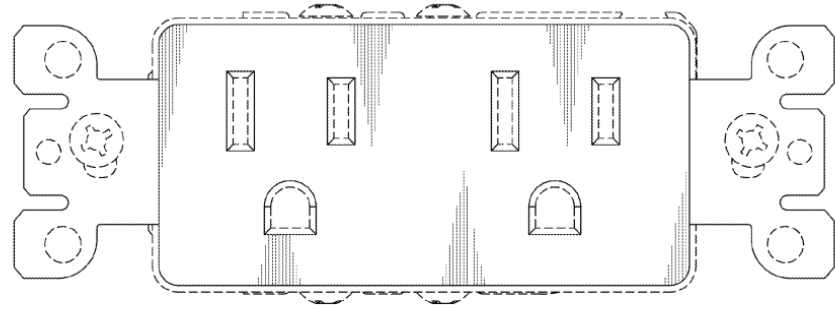


FIG. 2

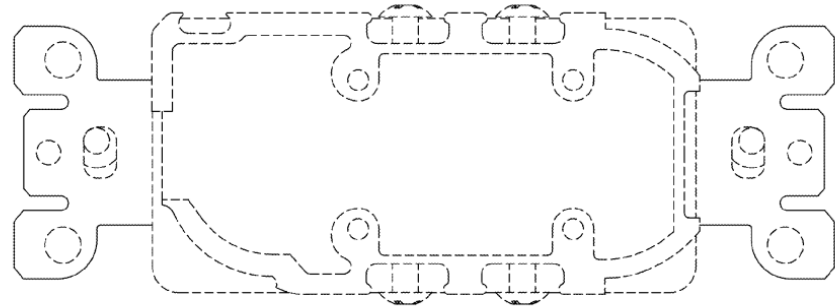


FIG. 3

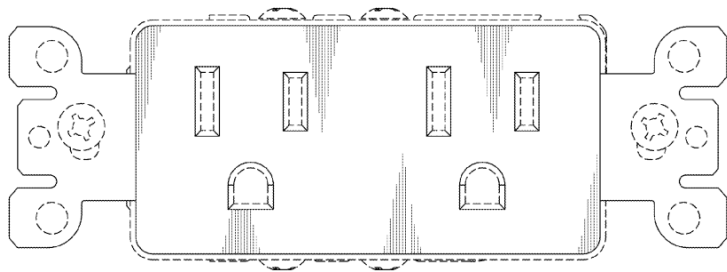


FIG. 2

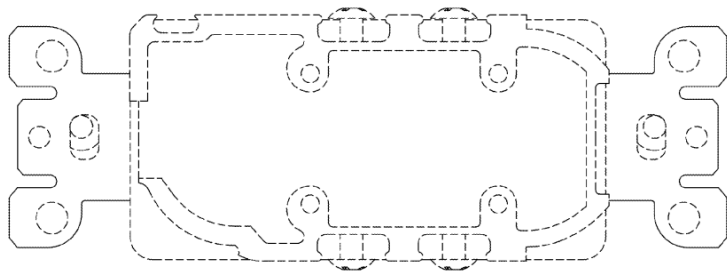


FIG. 3

Duplex horizontal receptacle
Design USD914608S1: First Office Action

The broken line statement is insufficient because it does not accurately describe the purpose of the broken lines illustrated in the drawing. In the drawings the broken lines show unclaimed portions of the article and therefore should not be described as environment. (MPEP§1503.02, subsection III) For accuracy and clarity of disclosure, the broken line statement should be amended to read as:

--In the drawings, the broken lines are for the purpose of illustrating portions of the Duplex Horizontal Receptacle that form no part of the claimed design.--

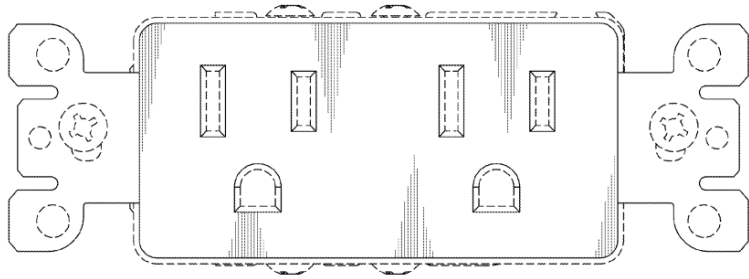
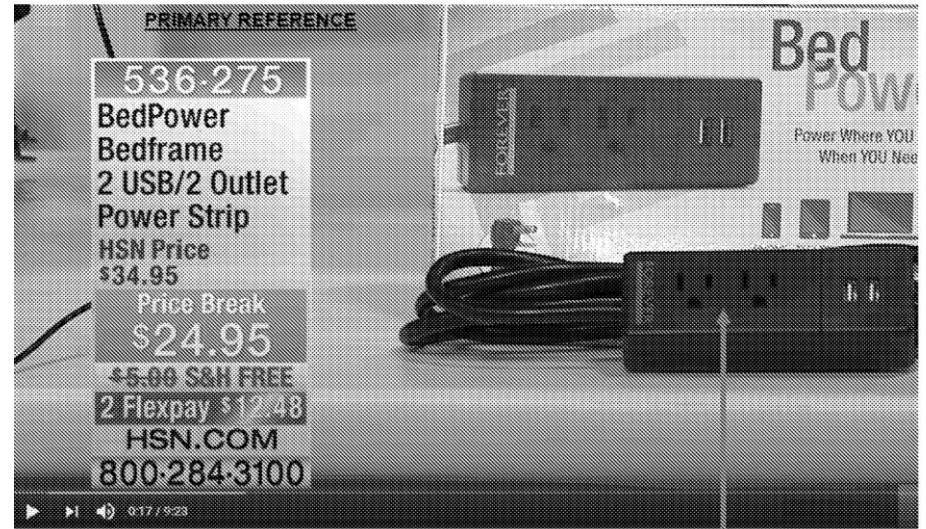
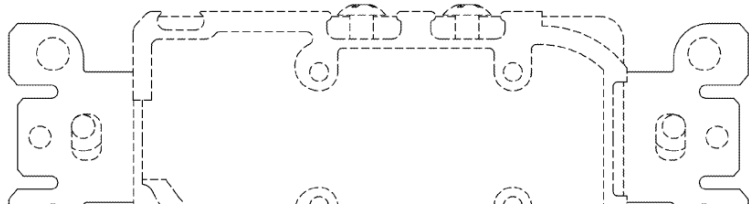


FIG. 2



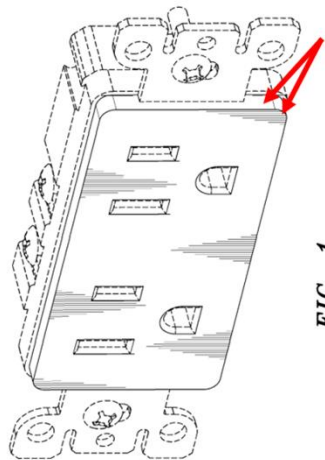
BedPower Bedframe 2 USB/2 Outlet Power Strip
2 views · May 12, 2017

2017 BedPower Bedframe Outlet Strip

**Duplex horizontal receptacle
Design USD914608S1: First Office Action
Claim Rejection – 35 USC 103**

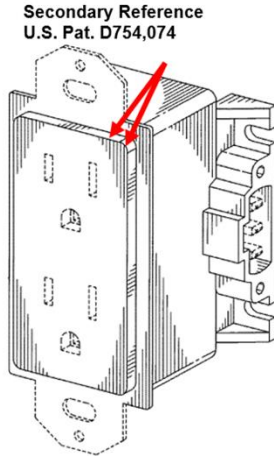
The claim is rejected under 35 U.S.C. § 103(a) as being unpatentable over the BedPower Bedframe Outlet Strip (2017); in view of U.S. Patent D754,074 (DeCosta, 2016).

“Although the invention may not be identically disclosed or described as set forth 35 U.S.C. 102, the invention is not patentable...This modification of the primary reference in light of the secondary reference is proper because **the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other.**”



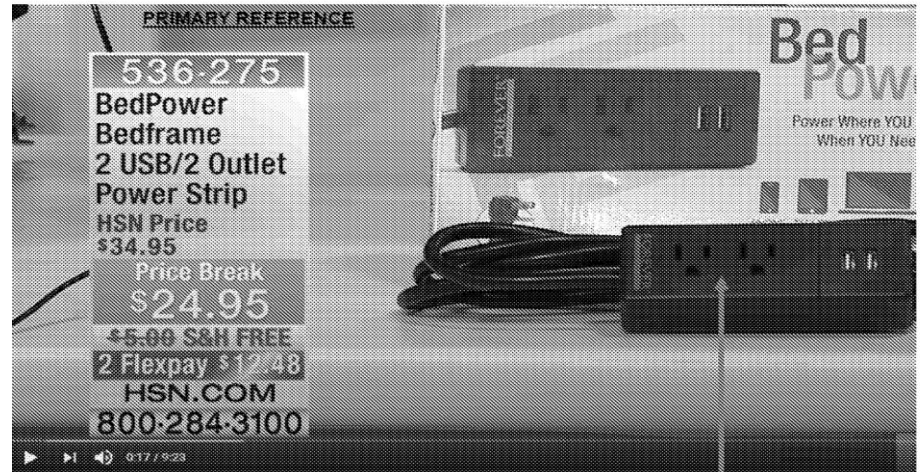
29/736,512

FIG. 1



Secondary Reference
U.S. Pat. D754,074

FIG. 1



BedPower Bedframe 2 USB/2 Outlet Power Strip

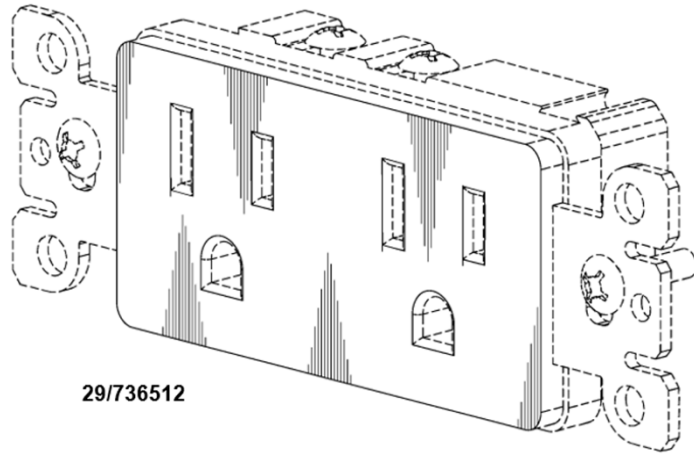
2 views · May 12, 2017

2017 BedPower Bedframe
Outlet Strip

**Duplex horizontal receptacle
Design USD914608S1: First Office Action
Claim Rejection – 35 USC 103**

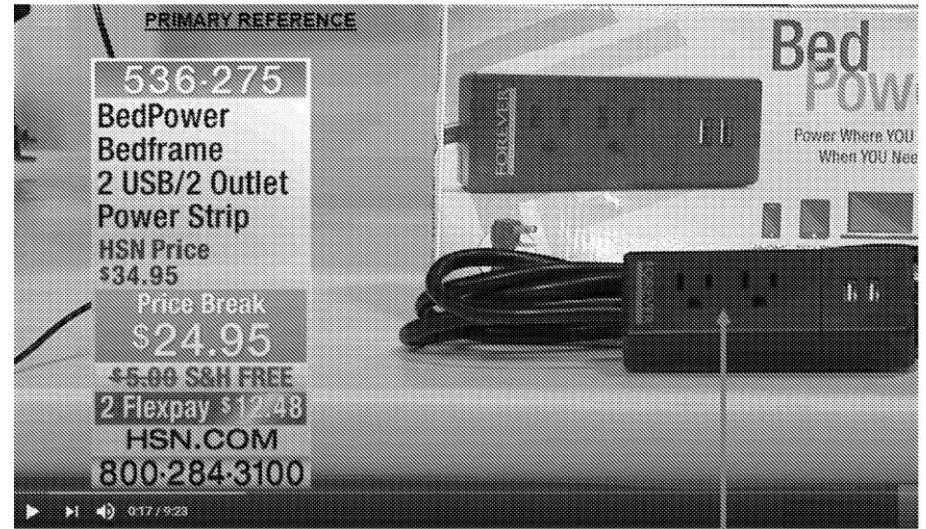
RULE 132 DECLARATION

As Mr. O'Connell remarks, the esthetic appearance of **a power plug looks at a distance somewhat like a human face**, with the longer rectangular neutral slot and the shorter rectangular live slot representing eyes, and the earth slot representing a human mouth. ...However, when mounted horizontally, the standard (DeCosta D754,054) configuration looks unnatural, because the two "faces" are now mounted on their sides with respect to the force of gravity. **This looks somewhat unnatural or "uncanny (e.g., strangely familiar unsettling, eerie)**. By contrast, applicant's design enables the wall outlet to be mounted horizontally without looking "unnatural." Thus, when mounted horizontally, the two "faces" appear in a more natural orientation with respect to the force of gravity.



29/736512

FIG. 1



BedPower Bedframe 2 USB/2 Outlet Power Strip

2 views · May 12, 2017

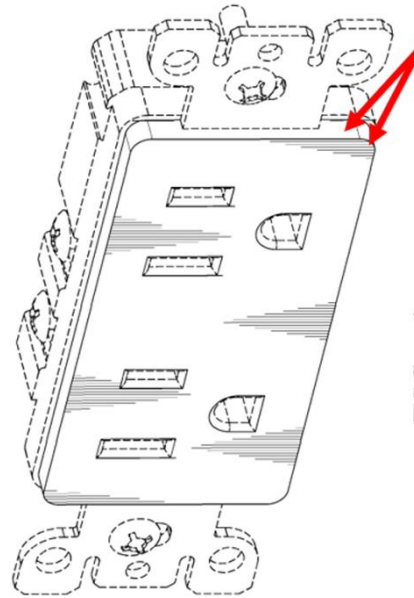
2017 BedPower Bedframe Outlet Strip

Duplex horizontal receptacle
Design USD914608S1: Second Office Action
Claim Rejection – 35 USC 103

Attorney's arguments, (see pages 2 through 19 filed 10/5/2020), have been fully considered but they are not found to be persuasive.

Duplex horizontal receptacle
Design USD914608S1: First Office Action
Claim Rejection – 35 USC 103

“Page 15 of the arguments contains an exhaustive and extraordinarily detailed description of the claim. However, the exact appearance of the claim is a rounded corner rectangle with two vertically and horizontally centered type-b ports. On page 19 of the arguments, applicant provides a Rule 132 Declaration from Michael C. O’Connell attesting to the novelty of the claimed design because the esthetic appearance of the plug “at a distance [looks] somewhat like a human face”. Again, the Examiner respectfully disagrees with an argument of novelty based on the “somewhat” appearance of the article. At best this argument is subjective because in this case what may “somewhat” appear to one may not be clearly shown or understood by others. Hence, the suggested appearance of a human face is ambiguous. In accordance with 35 USC 112, the claimed design must be described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact three dimensional appearance cannot be subjective or ambiguous.”



29/736,512

FIG. 1

Secondary Reference
U.S. Pat. D754,074

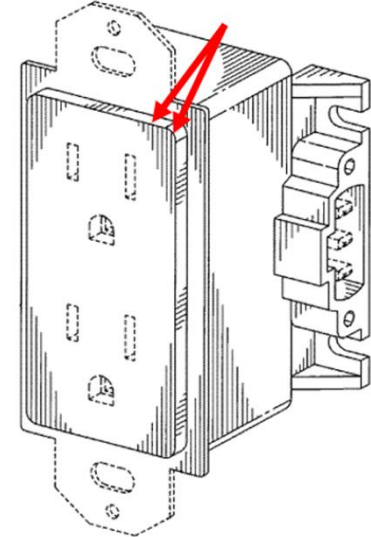


FIG. 1

Duplex horizontal receptacle
Design USD914608S1: After Final Response

The helpful comments and suggestions by examiner Shields, in the December 16, 2020 telephonic interview between examiner Shields and attorney Zweig, are gratefully appreciated. It appeared as if the present amendments had advanced prosecution.

Specifically, in addition to the limitations pertaining to the thickness of the front plate, applicant has additionally added limitations pertaining to the thickness of the opposing brackets. These amendments were as per examiner's suggestions in the previous October 5, 2020 interview, as documented by examiner in the October 9, 2020 interview summary.

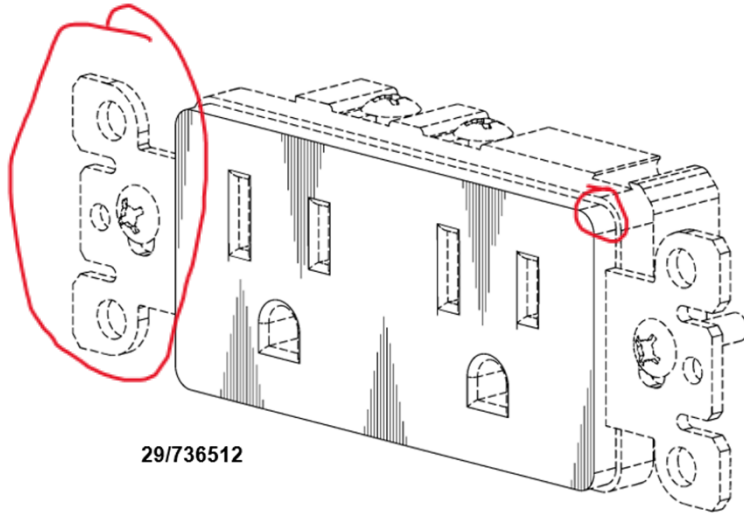
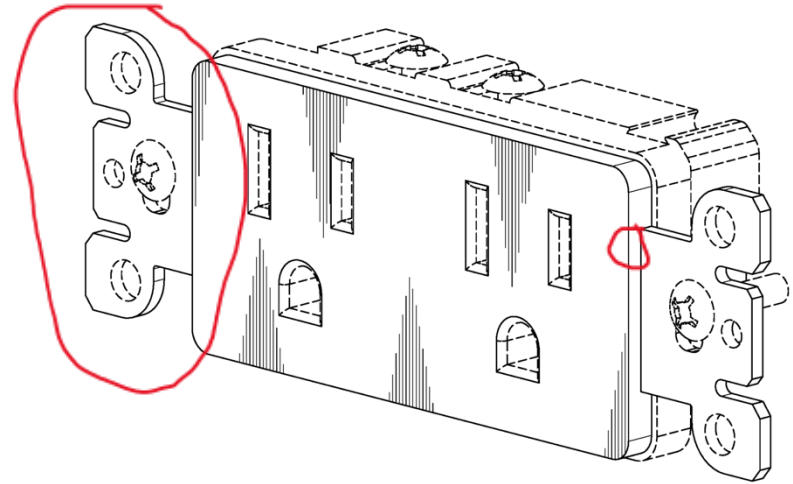


FIG. 1

Applicant's original disclosure was too broad



Applicant's Replacement sheets narrowed the claim scope

Cozy Comfort obtained U.S. Design Patent No. D859,788 (the '788 patent) for an “ENLARGED OVER-GARMENT WITH AN ELEVATED MARSUPIAL POCKET”. The following figures are representative:



FIG 1



FIG 10

Key Takeaways

- Design patents must cover ornamental NOT functional features
- Patent scope can be narrowed from dashed lines to solid lines.
- U.S. design patent applicants should be cautious about the arguments made during the examination phase to secure the application's allowance.