



The Role of Design Patents: Protecting Toys and Games

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Often times when people think of patents, they think of what are known as “utility” patents. Utility patents protect the functional aspects on an invention, for example, how a device works, or the specific combination and configuration of components that make up the device. However, there is also another category of patents, which are known as “design” patents. Design patents protect the ornamental appearance of an invention. This article discusses the important role that design patents play in the toy and game industry.

Design patents protect the unique ornamental appearance of a product

Many new products in the toy and game industry are updated versions or variations of pre-existing toys and games. This can make it difficult or impossible to obtain utility patent protection on the product. However, design patents may still be available to protect the unique ornamental appearance of an otherwise conventional product.

For example, with board games, a design patent may be used to protect the unique appearance of game pieces, spinners, timers, and in some cases, the playing board. For toys, a design patent may be available to protect, for example, the ornamental appearance of an action figure or toy car. In these cases, design patent protection can be particularly valuable in fighting counterfeiters and knock-offs, especially where the main selling factor of the product is its unique appearance or theme.

Design patents are relatively quick, easy, and inexpensive to obtain

The time from filing a design patent application to its issuance by the U.S. Patent and Trademark Office is

relatively short as compared to utility patents.

According to a recent study, over 50% of design patents issue within one year of filing, and approximately 90% of design patents issue within two years of filing.¹ In comparison, utility patents have an average pendency of over 2.5 years.² The short pendency of design patents is a big advantage in the toy and game industry, where products tend to have a short life cycle.

In addition, most design patent applications are subject to few, if any, rejections during examination at the U.S. Patent and Trademark Office. In fact, over 80% of design patent applications are allowed without any rejections.³ This is in contrast to utility patent applications, which receive on average 2.4 Office Actions prior to issuance as a patent.

Furthermore, design patents are much more affordable than utility patents. For starters, the U.S. Patent and Trademark Office filing fees for a design patent application are \$460 for a large entity, and \$230 for a small entity, whereas the filing fees for a utility patent application are \$1030 and \$515, for large and small entities, respectively. More significantly, the attorney fees and draftsperson fees for preparing and filing a design patent application are usually a small fraction of the fees for utility applications. Coupled with less fees for responding to rejections from the U.S. Patent and Trademark Office, and lower official fees, the cost of obtaining a design patent can be less than a third of that for a utility patent. The relatively inexpensive nature of design patents makes them a good strategy for small to mid-size companies that don't have the budget to obtain utility patents on all of their products.

Design patents can supplement other forms of intellectual property

¹ See Posting of Crouch, Dennis D. to Patently-O Blog, *Design Patents and the Fashion Industry*, <http://www.patentlyo.com/patent/2010/12/design-patents-and-the-fashion-industry.html> (Dec. 6, 2010).

² See December 2010 Patents Data, at a Glance, published online by U.S. Patent and Trademark Office at <http://www.uspto.gov/dashboards/patents/main.dashxml> (Feb. 7, 2011 at 3:00 PM E.S.T.).

³ See Crouch, Dennis D., *A Trademark Justification for Design Patent Rights*, *Harvard Journal of Law and Technology*, Vol. 24 (Aug. 10, 2010).

Design patents can also be used in tandem with other forms of intellectual property. For example, design patents can serve as a pre-cursor and/or compliment to trade dress protection. In order to register trade dress for the appearance of a product, the appearance must be distinctive in the eye of the consumer. This usually requires that the product be on the market for a significant amount of time.

The exclusive right to the product's appearance provided by a design patent may allow the product's appearance to raise to the level of distinctiveness required for trade dress registration. Once registered, trade dress protection can last the lifetime of the product, whereas design patents have a limited term of fourteen years from issuance.

For products meriting utility patent protection, design patents may also be used in conjunction with utility patents to protect both the ornamental and functional aspects of the product. Copyrights may also be used to protect various aspects of toys and games.

Conclusion

For the reasons discussed above, toy and game innovators should consider design patents as an important part of their intellectual property strategy. As a word of caution, the United States patent laws require that design patents (like utility patents) be filed within one year of certain public disclosures of the invention, otherwise, the inventor is barred from obtaining patent rights on the disclosed invention. In addition, many foreign countries require that the patent application be filed prior to any public disclosure, or else patent rights in those foreign countries will be barred. Thus, care should be taken to file design patents and utility patents alike prior to disclosure of the new product outside of your company.

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