

Design Patents

Design Patents — Protecting Products and Defining Brands

For forward-thinking companies, design patents are no longer an afterthought. The high-profile *Apple v. Samsung* litigation demonstrated the value of non-functional, ornamental elements in defining a brand, separating products from the competition, and preserving market share. With remedies for design patent infringement often exceeding those available for utility patents, protecting design features against piracy or illegal use is a wise investment.

A record of success and service

Marshall, Gerstein & Borun LLP has a well-earned reputation for prosecuting business-critical design and utility patents, and managing high-value IP portfolios for clients worldwide. *Managing Intellectual Property* recently named Marshall Gerstein “Patent Prosecution Midwest Firm of the Year.” *Chambers USA*, *U.S. News & World Report*, and *Leading Lawyers Network Magazine* also recognized our Firm and individual lawyers for their excellent legal counsel and client service.

World-class IP team with global reach

With the passage of the American Invents Act, the U.S. implementation of The Hague Agreement Concerning the International Registration of Industrial Designs, and other patent-related developments worldwide, a global design patent strategy is more essential than ever. As industry thought leaders, we have spoken on emerging design patent issues at seminars and conferences held in numerous countries; as client advocates, we have provided coordinated representation in design patent prosecution matters and post-grant proceedings. We also maintain an extensive network of attorneys outside the United States with whom we work daily on patent and design matters, enabling us to resolve problems and pursue opportunities almost everywhere our clients do business or face competition.

Managing the interplay between design patent, copyright and trademark protection

We are deeply attuned to the complex interplay between patents, copyrights, trademarks, and other IP protection as it relates to product design. We consider all available options for our clients’ industrial designs and customize our legal advice accordingly. Our design patent team includes professionals with backgrounds in mechanical and electrical engineering, as well as trademarks, transactions, IP litigation, enabling us to provide a fresh interdisciplinary perspective to an area of law at the intersection of branding and technology.

Dispute resolution that creates business results

When allegations of patent infringement or other IP-related disputes arise, our experienced litigators take immediate, effective action to protect our clients’ interests, whether as plaintiffs or defendants. We tailor our strategies to meet a client’s overall objectives, keeping in mind that the best solution—whether negotiating a settlement or arguing a case in the PTAB or federal court—is that which enables our clients to focus on the business at hand.

Scientific experience, technology-based solutions

More than 90 percent of our patent prosecution lawyers, patent agents, and technical specialists have advanced scientific training and are admitted to practice before the U.S. Patent and Trademark Office

(USPTO). Many of our lawyers obtained Ph.D. degrees before beginning their legal careers. Our in-house docketing department is staffed with skilled professionals who monitor and manage high-volume patent portfolios at every step. We integrate the latest available technology to efficiently maintain and enhance our management of matters entrusted to us by our clients. We represent clients in a broad range of industry sectors, including consumer products, packaging, construction, graphic user interfaces, and medical devices, and whose products include:

- Amplifiers
- Dental instruments
- Furniture
- Hardware
- Jewelry
- Label printers
- Smartphone cases
- Tactile sidewalk tile
- Vacuum cleaners

Representative clients

- Armpocket Enterprises
- Clear Lam Packaging
- Google
- Hu-Friedy Manufacturing Co.
- J.C. Bamford Excavators Limited
- Kenall Manufacturing
- Newell Rubbermaid
- Penford Products Co.
- Shop-Vac Corp.

Representative matters

- **Developing and Managing an Extensive, Multinational Design Patent Portfolio**
We have advised a global, market-leading manufacturer of high-quality vacuum cleaners and accessories on a broad range of IP protection strategies, including negotiating licensing agreements and other contracts, and providing effective litigation services when competitors have copied its products. To date, we have assisted the company with nearly 1,000 design patents or registrations around the world, including more than 150 U.S. design patents.