



# THINK FORWARD

## Design Patents – Fundamental Additions to Cannabis Intellectual Property Portfolios

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With the start of a new year and a new decade, Illinois became the 11th state to legalize recreational marijuana use—with many more states likely to follow suit. As a result of this recent legalization, cannabis companies operating in Illinois will be seeking protection for their technologies and brands. However, because cannabis is still considered an illegal substance at the federal level, the cannabis industry continues to face unique challenges in protecting intellectual property.

Many companies in the cannabis space turn to utility patents, trade secrets, trademarks, and copyrights to protect their technologies and brands. Yet, one form of protection—design patents—remains largely unused. Indeed, a recent search revealed the U.S. Patent and Trademark Office (“USPTO”) has issued only 14 expressly cannabis-related design patents. Nevertheless, design patents may be a potentially powerful source of intellectual property protection that cannabis companies should consider.

### **Design Patents**

Design patents protect the novel, non-functional, ornamental aspects of a product; in other words, design patents cover the unique way a product looks rather than the product’s function. If a product has a new and unique design (i.e. unique twists, grooves, ridges, etc.) that is not dictated by function, then design patents may be a viable option for protection that can complement functional features protectable by utility patents. When applicable, design patents provide a number of critical benefits, for instance:

- Design patents provide 15 years of protection. The term for a U.S. design patent is 15 years from issuance (35 U.S.C. § 173). This 15-year term allows the owner to build a strong reputation with its design, which may ultimately lead to a protectable trade dress in the future. The 15-year term also means that, regardless of how long the application process takes, the applicant will have rights to the design for 15 years after the design patent has been *granted*. This is an advantage over utility patents, which provide 20 years of protection from the date the application is *filed*, which diminishes the applicant’s time for exclusive control if the application process takes many years. Additionally, continuation practice allows for protection of related but patentably distinct designs, which can be an important part of a long-term business strategy for building a unique product design portfolio.
- Design patents provide strong exclusive rights. Design patents prevent others from using the design during the life of the patent. This provides the owner of the design patent 15 years to *exclusively* use the design. Design patents also provide protection at the federal level and are not in tension with federal controlled substance laws. This means that, even though certain states have not legalized marijuana usage, design patents will be protected and enforced federally. And, an infringer of a

patented design can be compelled to disgorge all of its profits upon successful enforcement of the design patent(s) (35 U.S.C. § 289).

- Design patents are inexpensive to maintain. No maintenance fees are due on design patents, making them less expensive to maintain than utility patents, which require maintenance fees at three different points during the patents' lives.
- Design patents involve a less expensive application process. Because a design patent consists of only a single claim, the upfront costs of preparing the application are typically lower than those for preparing a utility patent application. Moreover, design patent applications historically have a higher allowance rate than utility patent applications, often helping applicants avoid an ongoing battle with the USPTO. Design patents are also examined more quickly on average than utility patents, typically resulting in examination and allowance within 12–18 months.
- Design patents can provide a head start on trademark/trade dress protection. A well-policed design patent can help establish the exclusivity of product configurations and/or packaging that may become recognized as source-identifiers and therefore subject to common law trademark/trade dress protection, as well as potentially registrable rights.

### **Takeaways**

Cannabis companies that manufacture ancillary products should consider obtaining design patents. Design patents can be used to protect the unique shape of vaporizers, pipes, bongs, tinctures, containers, and products that include novel designs featuring cannabis leaves or thematically similar design elements, whether or not any of those products are used with or for cannabis. Design patents are also optimal for replacement parts where owners expect the replacement part to mirror the original.