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How to Defend Claim Of Infringement On A Design Patent

[Kristie Prinz](#)

Q. I am a partner in a new jewelry company. Following the recent publication of a review of our jewelry in a newspaper, I received correspondence from another jeweler who accused us of infringing a design patent on one of the pieces of our jewelry. We dispute her claim--we had never heard of her before she contacted us. While our bracelets do look similar, they are constructed differently. I just don't understand how she would have been able to obtain a patent on such a common and simple jewelry design. What should we do?

-- *Gillers***A.**

Your question is a bit outside the scope of my practice, but it raises some interesting issues, which I wanted to address in this column to the extent possible.

While copyright law is perhaps most often relied upon to protect works such as jewelry, a design patent can in some cases be obtained to protect a jewelry design as well. In contrast to utility patents which protect the way an invention is used and works, design patents protect the way an article looks, particularly new, original, and ornamental designs.

Assuming this third party jeweler who has accused you of infringing does in fact have a design patent on the bracelet, then she may have a valid claim of infringement against you. However, this is not necessarily the case.

Indeed, the possibility exists that the patent is invalid. In order for a patent to be valid, all of the following elements must be met:

1. there must be inventorship;
2. the design must be novel;
3. the design must be nonobvious; and
4. the patented features must be ornamental.

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It is very possible that her patent fails to meet one or more of these conditions.

The possibility also exists that the patent may have been allowed to lapse, whether by expiration or by the nonpayment of maintenance fees.

Finally, the possibility exists that this third party will be unable to prove that you infringed her patent. The two-step test to determine if a design patent has been infringed is as follows:

1. An "ordinary observer" comparing the two products might be deceived into thinking that the two products were substantially the same, and
2. The accused design actually incorporates the "points of novelty" that distinguish the patented design from the prior art.

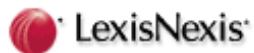
A court will not find that infringement took place unless both of these tests are satisfied.

Based on the facts you have provided, it is unclear as to where, if at all, there might be a flaw in the third party's case against you.

My advice would be to take this threat seriously, and to go ahead and immediately consult with an intellectual property attorney in your jurisdiction who specializes in the area of patent litigation, preferably who has some background in patent prosecution as well. This attorney should be in position to study both the jewelry and the patent in question and to advise you as to whether or not this third party patent is in fact valid and whether you may actually be infringing it. Once you are armed with this information, the attorney should also be able to provide you with some definitive recommendations as to how you should best proceed.

-- *Kristie Prinz*

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