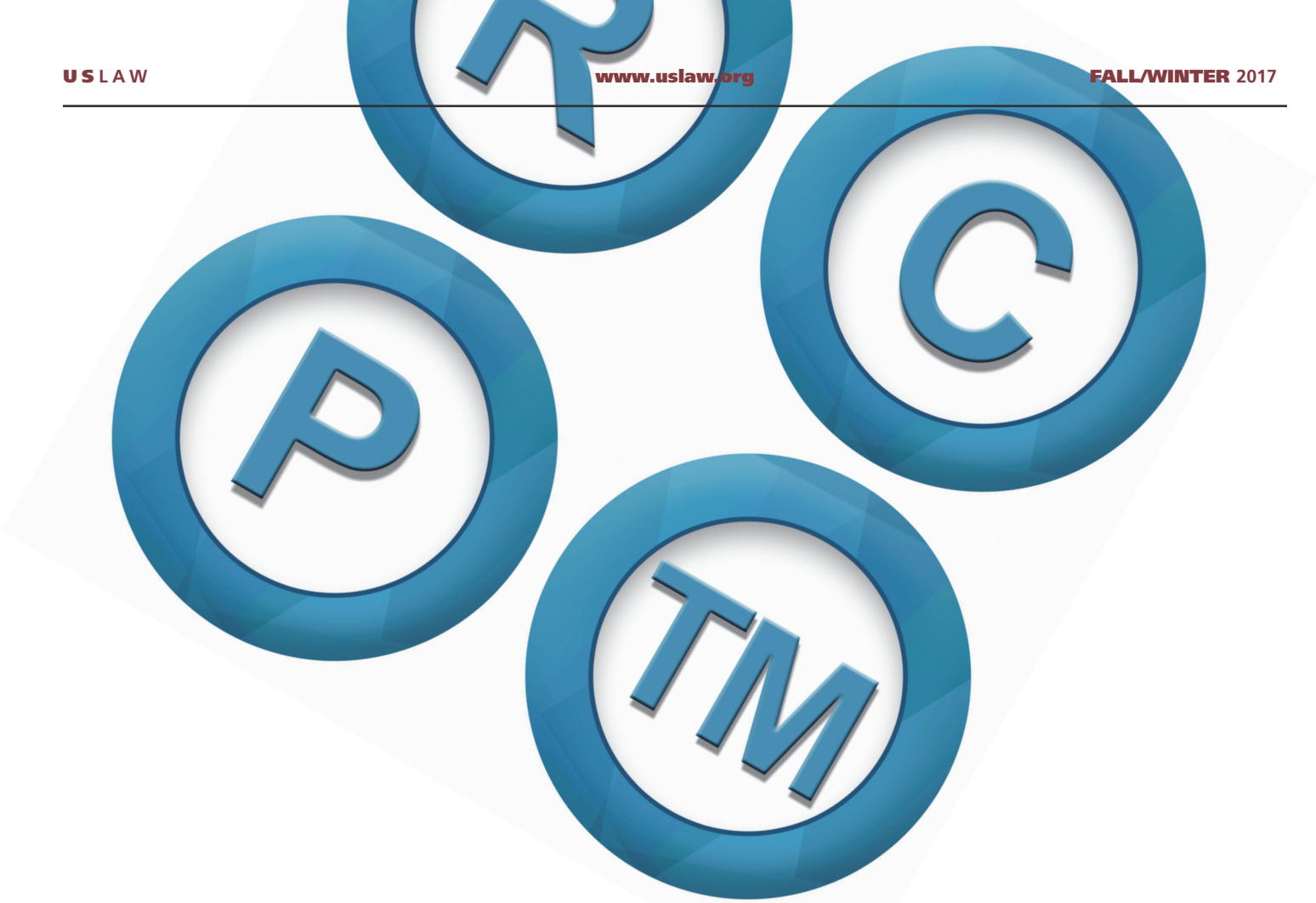


# COPYRIGHTS, TRADEMARKS AND PATENTS...OH MY!

## WHAT IS THE ROAD BEST TRAVELLED FOR PRODUCT DESIGN PROTECTION?

**Elisabeth Townsend Bridge** SmithAmundsen

Owners of industrial and product designs have various legal alternatives when it comes to protecting their intellectual property rights in product design. It is helpful for the savvy business owner and his/her legal counsel to be familiar with: (1) the alternatives available; (2) the protections afforded by each option; and (3) the requirements for, and benefits of, seeking protection under each alternative. With this knowledge, the design owner will be able to navigate the best path (or paths) to maintain and protect his/her design innovations from competitors and unauthorized use.

### ALTERNATIVE LEGAL OPTIONS FOR PROTECTION OF PRODUCT DESIGN

In the United States, legal options for protecting product design include alternatives available under design patent, trademark and copyright laws. Each avenue protects different rights and mandates different requirements. Consequently, each option should be considered carefully, in light of the nature of the design and the business objectives. In any particular situation, one or more options could be pursued, depending on the nature of the design and what the owner is seeking to protect. This article explores the possible options available to the business owner and facts to consider when evaluating the best approach to achieve the business objective of protecting a valuable product design from competitive use and unauthorized exploitation by others.

### WHAT EACH LEGAL OPTION PROTECTS

*Design Patent* – Under 35 *United States Code* §171, whoever "invents any new, original and ornamental design for an article of manufacture" may obtain a design patent

for the design. Note that such designs, in order to qualify for design patent protection, must be novel, meaning they have not been sold or publicly displayed at any time prior to one year before the filing date of the design patent application with the U.S. Patent and Trademark Office. The design must also be "original," meaning it must be distinct from designs already available in the marketplace, whether patented or not. Furthermore, the design must be "ornamental," meaning it cannot be comprised of merely functional features and elements.

"Functionality" falls in the realm of utility patents – not design patents. Obtaining a design patent on the design of a useful article grants the patent holder the right to exclude others from using the design for 15 years from the date the design patent is granted.

*Trademark* – Under 15 *United States Code* §1052, the features of product design may be registered as a trademark under certain conditions. The design must be distinctive in appearance and, as with all marks, must act as an indicator of quality or source to the purchaser of the goods associated with the design. Trademarks can be protected in the United States under the common law but these protections are reinforced and enhanced through registration of the design as a mark with the U.S. Patent and Trademark Office. Rights in trademarks are based upon first use. In other words, the first user of a particular mark has the right to prevent others from using a mark that is so similar to the mark in sound, appearance, meaning and/or use as to be likely to create a likelihood of public confusion with the first user's mark. With trademarks, you are protecting the "good will" identified with the mark.

*Copyright* – Under 17 *United States Code* §102, "original works of authorship fixed in any tangible medium of expression" can be protected by copyright. Copyright is a statutory right that arises when a work of original authorship is "fixed" in a tangible medium of expression. For example, when a drawing is first created, generally the artist (or his employer) would own copyright in the work. Works may be registered with the U.S. Copyright Office and actually need to be registered (or at least an application must be filed) prior to the owner's filing of a lawsuit for infringement of the work. Copyright protects against the unauthorized copying of an original work of authorship and includes pictorial, graphic and sculptural works, as well as literary works, architectural works, software and music. Here, the right protected is the right to control the copying and distribution of the work and the making of derivative works from the work. Copyright does not protect underlying ideas in a work or preclude others from making any similar, but independently created, original works.

## REQUIREMENTS FOR AND BENEFITS OF SEEKING PROTECTION UNDER EACH OPTION

*Design Patent* – To obtain a design patent, the design must be a "new, original and ornamental" design. If the design is quite new – if it has not been out in the public for a year or more, design patent may be an option. This option affords a limited window of protection within the patent term. Once the term is ended, the patent cannot be extended or enforced. Design patents are fairly inexpensive when compared, for example, with utility patents, but they are viewed as fairly narrow in scope. One downside to pursuing design patent protection is that the patent is issued for only 15 years from the grant date. It can also take some time for them to issue (generally 18 months to a few years) so this option would not be appropriate if the design or product bearing the design is only going to be marketed for a very brief time.

*Trademark* – Trademarks can generally be obtained on product design only if the product design has acquired distinctiveness through use in commerce. This would generally mean that the design has been used for several (usually more than five) years, with substantial sales and distribution of product bearing the design. The aspects of the design claimed to be part of the mark should be nonfunctional features of the design. If they are functional, they cannot be protected as part of a trademark. A great benefit of this avenue of protection is that trademark rights do not have a finite time limit and can be protected against infringing users for so long as the mark is used in commerce. The "likelihood of public confusion" standard for trademark infringement is often viewed as broader in scope than design patent protection, which can be an added benefit to seeking trademark protection.

*Copyright* – Copyrights protect the manner of expression, not the underlying ideas or utility of the work. Consequently, copyright does not give any exclusive right to the information conveyed. As stated in 17 *United States Code* §102(b), "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." Basically, the design of a useful article is considered a pictorial, graphic, or sculptural work, only if and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article bearing the design. So, in order to qualify for copyright protection, the product design has to contain some element that can be identified as separable from the utilitarian aspects of the product.

In the recent U.S. Supreme Court case of *Star Athletica v. Varsity Brands*, 136 S.Ct. 1823 (U.S. 2016), the Court found that the decorative elements of cheerleader uniforms could be protected by copyright on the basis that the design elements can be separately identifiable from the useful article. This and other recent cases have broadened the possibilities of copyright protection for product design. Copyrights have the advantage over design patents of longer terms, typically, the life of the author plus 70 years.

## CONCLUSION

When reviewing how best to protect a company's product designs, be aware that several alternatives may be available. These can be examined and pursued individually or it may be possible to pursue all three over time depending upon the primary objectives of the business. For example, design patent protection could be pursued before or in conjunction with a new product launch where the product has a unique and nonfunctional "look." Depending upon the nature of the design, you may also consider protecting the design, or elements of the design, through copyright registration. Then, perhaps five years or so after the product has been on the market, particularly if the design is one that the company views as a design that it is going to continue to market for some time, it would be worthwhile to consider protecting the design as a trademark, which would help prevent competitors from using similar designs on competitive or closely related products after the design patent protection ends and so long as the design continues to be used by the business on its products.

*Elisabeth Townsend Bridge has more than 35 years of experience advising clients on protecting their intellectual property rights, including patents, copyrights and trademarks both in the United States and around the world. She enforces clients' rights in their marks against infringing users and negotiates resolutions when possible of infringement concerns. Lisa is co-chair of SmithAmundsen's Intellectual Property Practice Group. She can be reached at ebridge@salawus.com.*