

Edwards Wildman Palmer LLP

One size doesn't fit all

Design patents, trade dress and copyrights each have different requirements, resulting in the need for a multi-faceted approach

Designs and trade dress are protectable in the United States to varying degrees under patent, trademark and copyright regimes. The requirements and costs for obtaining protection vary considerably and IP rights holders are best served by considering each type of protection during the development, roll-out and sales phases of a product's lifecycle.

Design patents

Although securing design patent rights requires more upfront work than obtaining trademark or copyright rights, once applied for, design patent rights provide a potent defence to the copying of an ornamental design.

Design patents protect "new, original and ornamental" aspects of an article for manufacture and can cover either the overall appearance of the article or certain design elements. Design patents protect only non-functional aspects of an article. Functional elements are generally those that are essential to the use or purpose of the article.

A design patent grants the owner the right to exclude others from manufacturing, using, selling or importing an article that embodies the protected design. In 2008 the US Court of Appeals for the Federal Circuit, the court with exclusive appellate jurisdiction over patent cases, decided *Egyptian Goddess v Swisa* and established a modified 'ordinary observer' test as the sole test for design patent infringement. Under the new test the court essentially asks: "Would a person who buys and uses this design, and who is familiar with this type of design, confuse the accused design with the patented design?" Theoretically, minor differences between the patented and accused designs would not bar a finding of infringement under this standard if the patented design departed significantly from previous designs. However, if the patented design is very similar to previous designs,

minor differences (depending on their visual significance) may prevent a finding of infringement. To determine what does not qualify as ornamental, a typical test asks whether the design's appearance is primarily dictated by function/considerations.

The modified ordinary observer test reduces the burden of patent holders to prove design patent infringement, simplifying the path for effective enforcement of design patents. Yet subsequent decisions suggest that the ordinary observer test may still be a difficult one that depends on how great the differences between designs must be to satisfy the courts.

Designers must consider the effect of prior art when considering design patent protection. Prior art includes similar designs already in the public domain or subject to another's design patent, either of which could result in the denial of patent protection. If a patented design merely brings together old or common design elements without arranging them in an innovative way, it is likely that a third party could also combine these elements without infringing the patent.

The ability to stop a third party from infringing the design patent is entirely dependent on a designer's forethought in patenting it, because infringement or copying cannot be stopped until after the patent has been examined, allowed and granted. That can take from six months to two years from the filing date of a design patent application. The grant of a design patent can be expedited and, with planning, one can issue in as little as three months. An issued design patent allows the owner to assert design rights for 14 years after it is granted. Once the patent is granted, no fees are needed to keep it in force.

Potential recoveries in infringement lawsuits include the recovery of lost profits,

the infringer's total profits from the sale of the product embodying the infringing design or a reasonable royalty. With this last avenue of recovery, enhanced damages are available permitting trebled damages, although such awards are rare. Trebled damages may be awarded where an infringer acted in wanton disregard of the designer's patent rights or, alternatively, did not have reasonable belief that he could use the design. This is termed 'wilful infringement'.

Trademarks and trade dress

A particular aspect of a product design, or even the configuration of the product itself, may be protected as a trademark or as trade dress (the distinctions between the two concepts having largely disappeared under US law). Although trademarks and trade dress can require more expense to establish than design patent rights, protection can last for as long as a product is sold. For example, the Coca-Cola bottle, the Maker's Mark dripping red wax seal and the Walther PPK handgun (used by James Bond in the 007 movie franchise) continue to enjoy trademark protection long after any design patents would have expired.

Since virtually all products perform some utilitarian function, courts and the US Patent and Trademark Office (USPTO) do not presume that product designs function as trademarks. Instead, protection is available only for designs that acquire secondary meaning, which develops over time as consumers come to view the design not merely as an aesthetic feature, but also as an indication that the product comes from a single source. While such an association may develop over time as a result of substantial sales and public recognition, the designer can be proactive in engendering secondary meaning by highlighting the source-indicating function in marketing and 'look-

for advertising, and carefully reviewing utility patent filings and other materials to ensure that utilitarian benefits are not ascribed to design features.

Product configurations often face a difficult road before the USPTO's Trademark Trial and Appeal Board. Three recent successes in registering the Walther PPK handgun configuration, the Baldwin key head shape and the Cartier watch design illustrate the significant investment in sales, advertising, surveys and declarations that is often required to establish secondary meaning.

Product packaging is subject to an easier standard for establishing distinctiveness. Unlike product designs, which always require proof of secondary meaning in order to establish distinctiveness, some product packaging is inherently distinctive. While some courts attempt to determine whether the product packaging in question fits within the "arbitrary", "suggestive" and "descriptive" categories traditionally used for word marks, the Court of Appeals for the Federal Circuit and the USPTO apply the *Seabrook* test, which considers whether it:

- is a common basic shape or design;
- is unique or unusual in the particular field;
- is a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; and
- is capable of creating a commercial impression distinct from the accompanying words.

Copyrights

US copyright law protects "original works of authorship fixed in any tangible medium of expression, now known or later developed". In order to be 'original', the work must both be an independent creation (meaning the work is the original work of the designer) and possess creativity. The level of creativity required for copyright is very low, having been described as "modest", "minimal" and "very slight". Despite this low threshold, standard or stock designs common to the relevant industry may not be protectable because they are neither independently created nor sufficiently creative. However, an original combination of such stock and/or public domain designs may be protected as a compilation. A compilation copyright protects the original selection and arrangement of the elements contained in the work, but not the individual elements themselves.

An original design must also possess "conceptual separability" in order to be protected by copyright. That is, the design



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must be able to be identified separately from, and capable of existing independently of, the utilitarian (functional) aspects of the product. To put it another way, does the design reflect the designer's artistic judgement exercised independently of functional influences? This concept is often the most significant issue in copyright infringement actions involving designs. If design and utility are inseparable, copyright protection is unavailable.

Recent court decisions have shifted the focus of analysis from the originality of the design to its utility. Under such analysis, designers have been required to show two separate stages of designs – for example, first shaping the product and then adorning it with ornamental designs. This evolving standard for evaluating copyright protection in product designs places a premium on keeping records of the design process that separately document work on the utilitarian aspects of the product from work on the ornamental/artistic embellishments.

The law of copyright registration in the United States is often misunderstood, even though the sections of US copyright law concerning registration have remained relatively stable for the past two decades. Although registration is no longer required in order to preserve copyright, it is required in order to bring a suit for infringement and make statutory damages available for infringement, thereby avoiding the need to prove actual damages. Additionally, registration before the infringing act(s) enables the plaintiff to recover costs and attorneys' fees.

Conclusion

Design patents, trade dress and copyrights each have different requirements and scopes of protection. Accordingly, savvy IP rights holders do not rely on a single form of protection, but instead utilise a variety of intellectual property to protect the design and trade dress of a product – for example, utilising design patent and copyright to protect a product's design until the design develops sufficient secondary meaning to support trademark protection. [WTR](#)