

The Overlap of Intellectual Properties in Product Design

By Tiffany Fidler and Michael Turner

Significant resources are invested to bring a product or service to market. A multi-layered intellectual property strategy can protect the assets obtained during development. Utility patent protection is available for inventions that are useful, novel, and nonobvious.¹ Other layers of U.S. intellectual property are available for product designs such as design patents, trade dress, and copyrights; these intellectual properties may exist simultaneously to provide overlapping rights.

Design patent protection is available for a new, original, and ornamental design for an article of manufacture.² An article of manufacture includes a product sold to a consumer or a component of that product. Design patents are often used to protect the overall ornamental appearance of the product, its specific design features, or replacement parts. Design patent protection is also available for surface textures, materials, graphical user interfaces (GUIs), and typeface. Examples of well-known products with associated design patent protection include the Coca-Cola bottle, Crocs footwear, and the Apple iPhone. Design patents expire 15 years after issuance.³





Trade dress protects the commercial look and feel of a product, its packaging, or a service to identify and distinguish its source.⁴ However, obtaining trade dress protection via common law or registration requires the product to be used in commerce, often for a considerable time period. Furthermore, trade dress protection includes a requirement for secondary meaning, which is an indication that a mark or dress “has come through use to be uniquely associated with a specific source” and “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”⁵ Secondary meaning is obtained with time and distinctiveness.⁶ Trade dress protection can extend indefinitely if use of the product design is continuous.⁷

Copyright protection is available for product designs that include creative and original expression⁸ and includes both common law protections and registration of the work at the U.S. Copyright Office. Unlike design patents and trade dress, copyright is limited to works with artistic elements separable from the article’s utilitarian function; therefore, copyright protection is not always available for product designs.⁹ For example, in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, lines, chevrons, and colorful shapes appearing on the surface of cheerleading uniforms were eligible for copyright protection as they “(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article.”¹⁰

Copyright protection lasts 70 years after the death of the author, and for a work for hire, the protection lasts the shorter of 120 years from creation and 95 years from publication.¹¹ Copyright protection extends much longer than design patents, but not indefinitely as does trade dress.

Enforceable trade dress rights are unavailable to new products launching in the marketplace. Design patents and copyrights can be obtained to bridge the gap until trade dress protection is available. A planned, strategic use of design patents, copyrights, and trade dress to protect the visual appearance of the product offers various forms of intellectual property protection to consider when structuring an intellectual property portfolio.

A U.S. design patent application must be filed in the U.S. Patent and Trademark Office (USPTO) within one year of the first public disclosure or offer for sale of the product.¹² To preserve foreign filing rights, however, a patent application is often filed prior to the first public disclosure. In contrast, trade dress requires use in commerce in order to obtain common law rights or registration, and protection is sought after the product has been publicly disclosed and is on sale. A copyright can be registered any time during the period of protection.¹³

A design patent application includes figures to claim the protected subject matter¹⁴ and define the scope of the patent. Once a design patent application is filed with the USPTO, new

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matter cannot be added to the application and, therefore, the application cannot be amended to add design changes or new design concepts.¹⁵

Design patent applications are submitted to the USPTO, which assigns them to an examiner to determine novelty and nonobviousness.¹⁶ A design patent provides protection for the ornamental aspects of the product which include an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia) and/or a design for the shape or configuration of an article of manufacture.¹⁷ Design patent protection does not extend to aspects of the product that lack ornamentality or are dictated by function.¹⁸

Design patents are lower in cost to obtain than utility patents, have high average allowance rates, typically issue within two years from filing, and do not require maintenance fees.¹⁹ A new product can therefore be labeled and marketed as patent pending at launch to deter competitors and indicate a new and inventive product as a marketing tool. However, the design patent must be granted in order to enforce it.²⁰

While trade dress rights may be acquired via common law over time, trade dress registration may be sought with the USPTO via an application for a product that:

- is used in commerce at the time of filing;
- identifies the source of goods;
- is non-functional; and
- is distinctive, e.g., has acquired secondary meaning.²¹

If the product has been on the market for a short time, typically less than five years, the examiner may require a showing of distinctiveness or secondary meaning. Secondary meaning may be acquired with use over time and other factors such as sales, advertising, intentional copying by others, or unsolicited media coverage; association of trade dress with the product by customers (e.g., via consumer surveys) may be required.²² Design patent exclusivity may be leveraged to establish secondary meaning for trade dress registration.

A U.S. design patent provides the right to exclude others from making, using, selling, or importing the patented good into the U.S. for 15 years.²³ Trade dress has an unlimited term of protection as long as the good or product remains in use in commerce. Design patents, therefore, provide a strong form of protection for a product and bridge a gap between product launch and availability of trade dress rights. Statutory damages for infringement of a design patent are total profits on the article of manufacture in the design patent and, as recently seen in *Apple Inc. v. Samsung Electronics Co., Ltd.*, can amount to massive monetary awards.²⁴

Design patents, trade dress, and copyrights may each be valuable in anti-counterfeit, take-down notifications to resellers. Enforcement of a design patent against an accused product occurs in federal court. Both common-law and registered trade dress rights may be enforced; however, trade dress registration carries a presumption of validity in court. Venues for trade dress enforcement can be more complicated based on



the common-law aspect of trade dress and, therefore, forum-shopping strategies may be employed.

When determining how best to protect a product or good, product timelines should be considered. Design patents have timing requirements for filing an application based on public disclosure or sale of the product. Design patents may therefore be used to provide protection against infringement in the interim period starting when a product is launched until trade dress rights are available. For a product still in development, a protection strategy may include filing for a design patent prior to the release and planning for trade dress registration at a later date based on the product's success and its continued sale. An application for trade dress registration may be docketed for five years after the product is launched.

Strategic, coordinated plans should be developed for products that have both design features for which design patent and trade dress protection is sought, and utility or functional features for which utility patent protection is sought. For example, as trade dress has a non-functional requirement, utility patents directed to the same product features as trade dress rights may act as a bar against trade dress protection.²⁵ On the other hand, a design patent may provide interim protection for the product's ornamental appearance until trade dress registration may be sought and may be useful in obtaining the trade dress registration. ■



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ENDNOTES

- 35 USC 101, *et seq.*
- 35 USC 171.
- 35 USC 173.
- 15 USC 1125(a) and 15 USC 1127; *Two Pesos, Inc v Taco Cabana, Inc*, 505 US 763, 770; 112 S Ct 2753; 120 L Ed 2d 615 (1992).
- Two Pesos*, 505 US at 769 and *Inwood Laboratories, Inc v Ives Laboratories, Inc*, 456 US 844, 851, n 11; 102 S Ct 2182; 72 L Ed 2d 606 (1982).
- Two Pesos*, 505 US at 769.
- 15 USC 1058, 1059.
- 17 USC 102.
- 17 USC 101, definition of "pictorial, graphic, and sculptural works."
- Star Athletica, LLC v Varsity Brands, Inc*, 137 S Ct 1002, 1007; 580 US ___; 197 L Ed 2d 354 (2017).
- 17 USC 302(a) and (c).
- 35 USC 102(b)(1).
- 17 USC 408.
- 37 CFR 1.152 and 37 CFR 1.153.
- 35 USC 132.
- 35 USC 171, 35 USC 102, and 35 USC 103.
- § 1504.01 "Statutory Subject Matter for Designs" in *Manual of Patent Examining Procedure*, US Patent and Trademark Office (June 2020), citing *In re Schnell*, 46 F2d 203; 8 USPQ 19 (January 12, 1931), and *Ex parte Janaia Donaldson*, 26 USPQ 2d 1250 (BPAI, April 2, 1992), available at <<https://www.uspto.gov/web/offices/pac/mpep/mpep-1500.pdf>> [<https://perma.cc/FUD2-Y6K5>] [site accessed July 28, 2021].
- In re Albert A Carletti*, 328 F2d 1020, 140 USPQ 653, 654 (CCPA 1964); and *L A Gear Inc v Thom McAn Shoe Co*, 988 F2d 1117, 1123, 25 USPQ 2d 1913, 1917 (Fed. Cir. 1993).
- 35 USC 41(b)(3).
- 35 USC 271.
- 15 USC 1052.
- Converse, Inc v Int'l Trade Comm*, 909 F3d 1110; 128 USPQ 2d 1538 (CA Fed Cir, 2018).
- 35 USC 271.
- 35 USC 289 and *Apple, Inc v Samsung Electronics Co*, 786 F3d 983; 114 USPQ 2d 1953 (CA Fed Cir, 2015), reversed and remanded *Samsung Electronics Co v Apple Inc*, 137 S Ct 429, 436; 196 L Ed 2d 363 (2016).
- Traffix Devices, Inc v Marketing Displays, Inc*, 532 US 23, 34; 121 S Ct 1255; 149 L Ed 2d 164 (2001).