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No Utility Patent? Try An Integrated IP Strategy: Part 2

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Law360, New York (January 6, 2015, 2:34 PM ET) -- This is the second installment in a series of three articles describing how, by integrating the use of design patent, trademark and copyright protection, a manufacturer can create robust intellectual property protection for a product, even when utility patent protection is unavailable. The first installment described how a manufacturer can integrate the various types of intellectual property to protect a product and provided a real-world example of how that integrated protection can be used to very effectively police the marketplace.

This installment discusses how to combine copyright protection and design patent protection to effectively and cheaply create a foundation of protection for a new product. The final installment will describe how this foundation can then be used as a foundation for strong trade dress and non-traditional trademark protection.

Copyright

Copyright protection can provide the strongest protection of all of the types of IP. If previously registered with the U.S. Copyright Office, the copyright owner under the copyright statute can obtain attorneys' fees and statutory damages for any infringement. This statutory award effectively shifts the majority of the risk onto the infringing party and also relieves the copyright owner of the requirement to prove damages.

Copyright protection, however, is limited to artistic works and has not traditionally been used to cover consumer products. This limitation is often referred to as the "useful article" doctrine to copyright, and refers to a history of cases in which the courts have hesitated to provide copyright protection to physical articles. In this line of cases, for a work to be protectable under copyright the artwork has to be "separable" and independently protectable from the useful article to which it is attached. Even so, in the following sections we describe how forethought and thoughtful design can be used to satisfy the requirements of the useful article doctrine and lay the necessary basis for copyright protection.

Design Patent

Design patents protect ornamental features on articles of manufacture. Thus, design patents are similar, in a way to copyright, in that design patents protect the "look" of an object not the object's function or, even, the object itself. Relative to utility patents, design

patent protection is quick and cheap to obtain and, with the United States' recent adoption of the Hague System for International Registration of Industrial Designs, design patents may become even easier to obtain.

Design patents are also relatively simple to enforce, with the current legal standard being the "ordinary observer test" which asks whether the accused product appears "substantially the same" as the patented design from the point of view of an ordinary observer, taking into account the prior art if there is any. However, the strength of a design patent is also its limitation: A design patent protects only the ornamental or aesthetic features of an article of manufacture.

Design patents have recently received more attention from the manufacturing world, especially with respect to consumer-facing products in which manufacturers are trying hard to differentiate themselves from their competitors and competitors' products. For an example of how important design patents can be in protecting a product, one need look no further than Apple Inc. v. Samsung Electronics Co. Ltd., (Fed. Cir., Nov. 18, 2013) in which Apple sued Samsung for infringement of three utility patents and four design patents.

Protect a new product by intentionally integrating a unique visual element into the product at the design stage
Often, creating a visually unique impression for a product is part of the design mandate. But even when this isn't the case, many products can be created so as to deliberately integrate artistic works or ornamental design elements into the product. Once this is done, obtaining copyright and design patent protection is a simple matter.

One way to incorporate a distinct visual element into a new product is to deliberately add an artistic work to what would otherwise be a plain product. As described above, for a work to be protectable under copyright the artwork has to be "separable" and independently protectable from the useful article to which it is attached.

For example, wallpaper and fabric upon which a copyrighted design has been added is protectable by virtue of the artwork being protectable. Similarly, a lamp shade with a base in the form of a copyrighted statue is protectable by virtue of the sculpture being protectable. These cases show that copyright protection can easily be incorporated into a product by commissioning the creation of new artwork from an artist to the manufacturer's specification and integrating it into the final product. For a physical product, the artist can be asked to create a three-dimensional sculpture to replace some or all of an otherwise simple design element (e.g., replacing a rectangular housing or portion thereof with a housing of a whimsical or abstract shape). If a three-dimensional sculpture is not possible, then a two-dimensional artwork can be created and applied on some of the exterior surfaces of the product.

Even without commissioning new works of art, often ornamental design elements can be added to the shape of a product specifically to make the look of the final product unique and to support at least a design patent application. Such elements include uniquely rounded, curled or beveled edges, artistic transitions from one surface to another and whimsical surface textures.

An added benefit of this approach is that the artwork or added design element can serve simultaneously as the grounds for a copyright registration, a design patent application and a basis for a later claim of trade dress and trademark (as will be discussed in the next installment of this series). When following this approach, make sure that the proper assignments of rights are obtained at the outset. This involves both determining who the proper authors and inventors are, and making sure the proper chain of title is clear. Another good practice is to register both the artwork alone and the artwork on the final product with the copyright office.

Note that, if the product is created without the overall strategy in mind, often it is not possible to perfect copyright or design patent rights after the fact (even if it would have been protectable). For example, the original Crocs' ornamental shoe design may have been protectable under copyright or design patent as incorporating some artistic or ornamental elements and most certainly could have been easily modified during the design stage to include such elements. However, the original manufacturer chose to rely on its utility patent protection of the specialized rubber compound and eschew design patent and copyright protection. Thus, when knock-offs of inferior materials were flooding the market to take advantage of the initial popularity of the Crocs shoe as a fashion statement, Crocs did not have the tools needed to police the inferior lookalikes, which did not infringe the utility patent. The dates for filing design patents had long since passed, and copyright protection, as an afterthought, could not be perfected.

What Do You Get for All This Trouble?

First, you have a product that presents a unique consumer impression, instantly differentiating it in the eyes of the consumer. While not intellectual property per se, from a marketing point of view, significant value has already been achieved. Copyrighting the artistic elements incorporated into the product gives the manufacturer a strong enforcement tool against both counterfeiters and lazy producers of knockoffs. Armed with the threat of statutory damages and attorneys' fees afforded by the Copyright Act, the manufacturer should be able to get nearly instant satisfaction from infringers that are not judgment proof.

By including claims of design patent infringement, any arguments by the accused infringer that the product is not copyrightable under the useful article doctrine are mooted. This argument is irrelevant to a determination of design patent infringement. As both copyright registrations and design patents are relatively quick to obtain, so enforcement is possible essentially upon release of the product.

As you can see, an integrated IP strategy that incorporates design patent and copyright protection from the early stages of development can result in very strong protection for a product. The final installment in this series will go into detail about how to use the foundation created by the design patent and copyright protection to support trademark and, particularly, trade dress protection.

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