

## Protection of Industrial Designs in the United States

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An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or colors. Industrial designs are applied to a wide variety of products of industry and handicraft. To be protected under most national laws, an industrial design must be visually appealing. In other words, an industrial design is primarily of an aesthetic nature, and does not protect any utilitarian features of the article to which it is applied.<sup>2</sup>

In the United States, with a very narrow exception,<sup>3</sup> industrial designs are not protected by one body of intellectual property law. This is not so in other areas of the world, such as in Japan<sup>4</sup> and in the European Union,<sup>5</sup> where industrial designs are the subject of their own *sui generis* protection. Rather, owners of industrial designs wishing to protect them under United States law must resort to a combination of different types of protection: design patents, trade dress, and copyrights. This article shall explore the strategic considerations for protecting industrial designs under these three facets of United States intellectual property law.

### I. U.S. Design Patent Protection for Industrial Articles

Design patents can provide valuable protection, not only for products traditionally protected by trade dress, but also for inventions traditionally protected by utility patents. In many ways, a design patent is a hybrid between a trade dress and a utility patent.<sup>6</sup>

#### a. Requirements for a U.S. Design Patent

There are five main requirements for obtaining a design patent: the subject matter must be an article of manufacture, and must be original, novel, non-obvious, and ornamental.<sup>7</sup>

##### i. Article of Manufacture

The design to be patented must be “for an article of manufacture.” In other words, the patentable design must be embodied into, or applied to, a man-made tangible object. The patentable design cannot be a design or picture standing alone, *i.e.*, in the abstract. Impressions, prints, or pictures applied to an article of manufacture, and the shape or configuration of an article of manufacture satisfy the article of manufacture requirement and are thus patentable as designs. As an interesting example, the court in *In re Hruby* held that a pattern of water for a water fountain was a design for an article of manufacture.<sup>8</sup>

Another interesting example of a patentable article of manufacture is a computer-generated icon shown on a computer screen. The icon itself is not patentable, but when claimed as an icon embodied on a computer screen, monitor, or other display panel, the combination of the icon and the display panel (or portion thereof) is patentable as a design.<sup>9</sup>

Importantly, the U.S. design patent statute does not limit design protection to a whole article of manufacture, but can be for a portion of an article of manufacture. This point was explained in *In re Zahn*, where the court held that the applicant could claim only the design for the shank portion of a drill bit without having to claim the entire drill bit.<sup>10</sup> The possibility to claim only the design for a portion of an article of manufacture can be used to obtain a relatively broad protection.

#### ii. Originality

The originality requirement bars issuance of a design patent for a design derived from any source or person other than the individuals named as inventors. This excludes from patentability any simulation of known objects, persons, or naturally occurring forms. On the other hand, a design can be original even if it is the result of a “reassembling or regrouping of familiar forms and decorations.”<sup>11</sup>

#### iii. Novelty

The standard for evaluating the novelty of a design is the “average observer test.” The overall appearance of the design in the eyes of an average, or ordinary, observer must be different from the appearance of any other single prior design.<sup>12</sup> Therefore, there is a difference between the novelty of a design patent and that of a utility patent. The novelty of a design patent comes from the observed ornamentation of the claimed design, while the novelty of a utility patent comes from the technical characteristics of the claimed invention.

#### iv. Non-Obviousness

The courts have held that the proper standard to evaluate a design’s non-obviousness is whether “a designer of ordinary skill of the articles involved” would have found the design as a whole obvious at the time the design was invented.<sup>13</sup> The non-obviousness analysis for design patents therefore closely parallels the non-obviousness analysis for utility patents. A design is presumed non-obvious unless there is some evidence of suggestion or motivation in the prior art for an ordinary designer to combine known elements in order to arrive at the claimed design.<sup>14</sup>

As with a utility-type non-obviousness analysis, evidence of secondary considerations, such as commercial success, can be presented to support a finding of design non-obviousness. However, “[t]o be of value, evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not to some other factor, such as a better recognized brand name or improved function.”<sup>15</sup>

## v. Ornamentality

Finally, a patentable design must be “ornamental.” The ornamental design, however, need not be artistic nor aesthetically pleasing. To be ornamental, the design must have an overall distinct appearance that is not dictated by the function of the article of manufacture.<sup>16</sup> In other words, the shape or configuration of a functional object is protectable by a design patent if the shape or configuration is not governed solely by the function of the object. The existence of alternative designs often confirms that the design satisfies the ornamental requirement.<sup>17</sup>

Importantly, the visibility of a design when the article of manufacture is in its normal use is not a requirement for design patentability. What is required is that the article’s design be a “matter of concern” because of the nature of its visibility *at some point* between its manufacture or assembly and its ultimate use.<sup>18</sup> For example, the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office has held that shotgun cartridge wads (the tampon portions between the powder and the bullet) were potentially ornamental because there was evidence of record that the wads were sold in clear bags and that their appearance was “a critical factor in the marketplace.”<sup>19</sup>

Photos of the product in trade magazines, catalogues, or on an internet website for sale purposes can help establish that the product’s design was a “matter of concern” at some point during the product’s commercial life.

A great variety of articles of manufacture, which are typically protected by a utility patent, are also protectable by design patents because their overall appearance is not fully dictated by their utility. In recent years, U.S. patent practitioners have witnessed a sharp increase in the number of design patent applications filed on such functional articles.

### b. How a U.S. Design Patent is Obtained

A U.S. design patent is obtained by filing an application at the U.S. Patent and Trademark Office and paying a filing and examination fee. An examiner examines the application, in particular the clarity and completeness of the drawings, performs a prior art search and decides whether the claimed design is for an article of manufacture, original, novel and non-obvious over the prior art, and ornamental. The prior art used to evaluate the design’s novelty and non-obviousness is defined by 35 U.S.C. § 102, the same statutory provision that defines the prior art in the context of utility patents. A design application may benefit from the priority date of an earlier foreign-filed application under the Paris Convention if the U.S. application is filed within 6 months of the first foreign filed application.<sup>20</sup>

After the examiner allows the application, the applicant pays an issue fee. The design patent is published and granted shortly thereafter. The rights associated with the design patent come into being when granted by the U.S. Patent and Trademark Office.

The average pendency of a design patent application is relatively short. Design patents often issue within nine to twelve months of filing the application, which is significantly shorter than the average pendency of a utility patent application and somewhat faster than most trademark applications. Design patents can therefore provide a relatively quick and effective method of preventing a competitor from infiltrating a market by mimicking the appearance of a successful product.

On average, the U.S. Patent and Trademark Office allows almost 90% of all design applications, compared to approximately 63% of all utility patent applications. The term of the design patent is fourteen years from the issue date,<sup>21</sup> while the term of the utility patent is twenty years from the earliest U.S. filing date of the utility application.<sup>22</sup> In other words, the design patentee is guaranteed a fourteen-year patent term regardless of the duration of the prosecution. No maintenance fees are required.<sup>23</sup>

#### c. Examples of Items Protected by U.S. Design Patents

Examples of design patents for articles of industrial manufacture include bottles from The Coca-Cola Company and PepsiCo, Inc. (U.S. Patent Nos. D468,213, D452,650 and D426,163), a golf club head from Bridgestone Sports (U.S. Patent No. D496,084), an aircraft nose and inlet from Fairchild Industries (U.S. Patent No. D242,994), and an airplane engine nacelle from Boeing (U.S. Patent No. D273,579).

Relatively functional and hidden in use articles that have been granted design patent protection include an engine from Komatsu Zenoah Company (U.S. Patent No. D416,265), a detachable front element for a magnetic tape cassette from BASF (U.S. Patent No. D356,307), a valve body from Honeywell (U.S. Patent No. D433,730), an alternator with rotating air intake screen from an independent inventor (U.S. Patent No. D453,140), a connector for printed circuit boards from Sony Corporation and Solderless Terminal Mfg. (U.S. Patent No. D402,273), a toner bottle from Minolta (U.S. Patent No. D451,949), a magnetic head from Sony Kabushiki Kaisha and Mitsumi Electric Co. (U.S. Patent No. D398,613), a semiconductor device from Kabushiki Kaisha Toshiba (U.S. Patent No. D480,371), a stator of vehicle alternator from Mitsubishi Denki Kabushiki Kaisha (U.S. Patent No. D467,870), and an IC card from Kabushiki Kaisha Toshiba, Fuji Photo Film and Olympus Optical Co. (U.S. Patent No. D479,845).

Finally, computer-generated icons also are protectable via design patents, as illustrated by Wells Fargo, Verizon Laboratories, Microsoft, and Siemens (U.S. Patent Nos. D445,426, D440,228, D487,469, D487,468, D488,482 and D485,846).

#### d. Types of Damages and Injunctive Relief Available

Design patent owners can obtain preliminary injunctions against accused infringers.<sup>24</sup> “Whether a preliminary injunction should issue turns upon four factors: (1) the movant's reasonable likelihood of success on the merits; (2) the irreparable harm the movant will suffer if preliminary relief is not granted; (3) the balance of hardships tipping in its favor; and (4) the adverse impact on the public interest.”<sup>25</sup>

The design patent owner also is entitled to “damages adequate to compensate for the infringement” under 35 U.S.C. § 284. Typically, these compensatory damages correspond to a reasonable royalty, or under certain circumstances, to the patentee’s lost profits. The court can increase the damages owed to the patentee up to three times the amount of the compensatory damages if the defendant infringed the patented design willfully.<sup>26</sup>

Further, the design patent owner has the additional option of demanding the infringer’s “total profits” under 35 U.S.C. § 289, instead of the damages provided by 35 U.S.C. § 284. This option may be advantageous, for example, when the infringer’s total profits are substantially greater than any reasonable royalty and when the patentee does not commercialize its design so that there are no lost profits.

e. General Advantages of U.S. Design Patent Protection for Industrial Articles

i. Ease to Obtain

Unlike trademark rights, design patent rights exist regardless of whether the design was ever sold or exploited commercially by the person asserting the rights. In addition, as noted above, the allowance rate of design applications is relatively high, design patents are granted relatively quickly after filing, and the cost of obtaining protection is relatively low.

ii. Presumption of Validity

Design patents are presumed to be valid.<sup>27</sup> A patented design, therefore, is presumed to be for an article of manufacture, original, novel, non-obvious, and ornamental. The accused infringer bears the burden of proving by clear and convincing evidence that the design patent is somehow invalid.<sup>28</sup>

iii. Relatively broad Protection Available

The field of design patent includes a number of unique nuances that one must consider in order to take full advantage of design patent protection. The most important consideration is that the drawings of a design application define the scope of protection. Great care thus should be taken in preparing the drawings when filing the application. Every line and every surface shading used in the initially filed drawings should be deliberate, with all extraneous and non-essential lines being removed or depicted only in broken lines, or “phantom lines,” prior to filing of the design patent application. By only depicting in solid lines the feature or combination of features that are essential to the ornamental novelty of the product, a relatively broad protection of the design can be secured.

In addition, design accused of infringement need not be identical to the drawings of the design patent in order to infringe the patented design. Design patent owners have some flexibility when proving that the accused device infringes their patented designs. The first test for design patent infringement is the “ordinary observer” test: “If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, – if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other, – the one first patented is infringed by the other.”<sup>29</sup> Under this test, “infringement can be found for designs that are not identical to the patented design, such designs must be equivalent in their ornamental, not functional, aspects.”<sup>30</sup> In proving infringement, however, the design patent owner must also satisfy the “point of novelty” test, which “requires proof that the accused design appropriates the novelty which distinguishes the patented design from the prior art.”<sup>31</sup>

#### f. General Disadvantages of U.S. Design Patent Protection for Industrial Articles

As noted above, the term of the design patent is fourteen years from the issue date, which can be shorter than the twenty years from filing available for utility patents, and much shorter than the trade dress and copyright protection, as discussed below.

Certain applicants do not fully appreciate the importance of preparing the drawings for a design application, often filing overly-detailed drawings and thus limiting the scope of protection. Drawings should be carefully prepared and revised by an experienced practitioner before filing, in collaboration with the applicant who can identify the commercially important features to be covered and those that should not limit the scope of protection. Therefore, solid design patent protection can require time and effort from the applicant.

As noted above, a design patent application may benefit from the priority date of a earlier foreign-filed application under the Paris Convention. However, unlike utility patent applications, which can be filed within 12 months of the first foreign filed application, the U.S. design patent application must be filed within 6 months of the first foreign filed application.<sup>32</sup> Foreign design patent applicants must therefore decide whether an extension to the U.S. is justified sooner than foreign utility patent applicants.

## II. U.S. Trade Dress Protection

Another way to seek protection in the United States for an industrial design is by means of trade dress. “The ‘trade dress’ of a product is essentially its total image and overall appearance. (citation omitted). It ‘involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.’”<sup>33</sup>

#### a. Requirements for U.S. Trade Dress Protection

Trade dress is protected under U.S. trademark law if it is distinctive, not functional, and the use of the same or similar trade dress by a competitor would cause a likelihood of confusion.<sup>34</sup> Using the same standards of distinctiveness as for word marks, trade dress generally is considered distinctive if it is inherently so by its very appearance, or if it has come to be distinctive through use.<sup>35</sup>

#### i. Acquired Distinctiveness

However, unlike word marks or product packaging, where the claimed trade dress is the design or configuration of the product itself (which is most akin to an industrial design), such trade dress will never be considered inherently distinctive. Product design or configuration trade dress must acquire distinctiveness through use in the marketplace in order for protection to be obtained.<sup>36</sup> Acquired distinctiveness is otherwise known as secondary meaning.<sup>37</sup> Secondary meaning can be shown by direct means, such as from consumer testimony or consumer surveys; or by indirect means, such as by exclusivity, length and manner of use, advertising and sales numbers, and unsolicited media attention.<sup>38</sup>

#### ii. Non-functionality

Product design features that are claimed as trade dress also must not be functional.<sup>39</sup> A product feature is considered utilitarian functional if it is “essential to the use or the purpose of the article” or “affects [its] cost or quality.”<sup>40</sup> Additionally, a product feature is considered aesthetically functional if its “‘aesthetic value’ lies in its ability to ‘confer a significant benefit that cannot practically be duplicated by the use of alternative designs’....”<sup>41</sup> Where the validity of the trade dress of a product feature is disputed as being utilitarian functional, the trade dress owner cannot defend its validity by asserting that the feature is not necessary for effective competition because equally feasible alternative designs are available. However, if the validity of the trade dress of the product feature is disputed as being aesthetically functional, the trade dress owner may defend its validity by asserting that equally feasible alternative designs are available.<sup>42</sup>

If a utility patent has been issued for the product feature that is claimed as trade dress, this is strong evidence that the claimed feature is utilitarian functional – unless the trade dress owner carries the heavy burden of showing that the claimed feature is merely an ornamental, incidental or arbitrary aspect of the overall item.<sup>43</sup> On the other hand, issuance of a design patent, which is directed to the ornamental appearance of an article of manufacture,<sup>44</sup> does not render functional the claimed feature that also may be asserted as trade dress.<sup>45</sup>

#### b. Examples of Registered Trade Dress for Articles of Manufacture

Examples of registered trade dress for articles of industrial manufacture include the Tree Design for Car-Freshner Corporation’s air fresheners (Trademark Registration

No. 719,498), the shape and configuration of the Weber grill (U.S. Trademark Registration Nos. 1,481,521 and 1,478,530), the shape and configuration of a Bose Wave Radio (Trademark Registration No. 2,299,158), and shape and configuration of a Coleman lantern (U.S. Trademark Registration No. 2,434,491).

c. Types of Damages and Injunctive Relief Available

If a violation of the owner's trade dress rights is found in a civil action for infringement, the owner may seek an injunction preventing further infringement<sup>46</sup> and an order calling for the destruction of the infringing merchandise.<sup>47</sup> The owner also may seek an award, in the appropriate circumstances (*e.g.*, a case of willful infringement), of damages, such as plaintiff's costs for corrective advertising, defendant's profits, treble damages, and attorneys' fees.<sup>48</sup>

d. Advantages of Obtaining Registered Trade Dress Protection

There are several advantages to obtaining a federal U.S. trademark registration for the claimed trade dress of an industrial design. Issuance of a trademark registration on the Principal Register creates a presumption that the mark (here, trade dress) is valid, owned by the registrant, and may be exclusively used by the registrant in commerce for the products specified in the registration certificate.<sup>49</sup>

Once the trade dress registration on the Principal Register is five years old, it is no longer subject to attack on the basis that it is merely descriptive and therefore not distinctive.<sup>50</sup> Additionally, in an infringement action, the owner of registered trade dress is not required to affirmatively prove as part of its case-in-chief that its trade dress is non-functional.<sup>51</sup> It is the challenger that has the burden of showing that the owner's trade dress is functional. Further, if the Principal Register trademark registration is recorded with the U.S. Department of Homeland Security, Customs and Border Protection, infringing items may be barred from importation.<sup>52</sup>

In the event of infringement, the owner can bring a civil action even if the trade dress is not registered with the U.S. Patent and Trademark Office.<sup>53</sup> However, the owner will not have the benefit of the presumptions afforded by a federal registration on the Principal Register. The plaintiff will have the burden of proving ownership, distinctiveness, and non-functionality in addition to likelihood of confusion. This is why obtaining a trade dress registration on the Principal Register is so important. In the authors' experience, it can take as long as eighteen months or more to obtain a trade dress registration.

e. General Advantages of Trade Dress Protection for Industrial Designs

One of the chief advantages of using U.S. trade dress laws to protect an industrial design is the potentially infinite lifespan of protection. So long as the owner uses its trade dress as a designator of the source of the product – that is, as a trademark – the owner can continue to assert its rights indefinitely. Additionally, the owner can modify



its trade dress rights, and thus the nature of its protection, over time as market circumstances warrant.

#### f. General Disadvantages of Trade Dress Protection for Industrial Designs

If it meets the requirements stated above, trade dress may be claimed for an industrial design the moment it acquires distinctiveness through use in the marketplace. When the item has acquired sufficient distinctiveness cannot always be ascertained with certainty. A reasonable portion of the purchasing public will have to associate the design with its manufacturer or seller, not the article itself that embodies the design.

Another disadvantage of using U.S. trade dress laws to protect an industrial design is the fragile nature of the protection afforded. If the owner ceases to use the industrial design as a trademark (*i.e.*, as an indicator of the source of the product), or if the design falls into common use by others, the owner's rights may be deemed abandoned.<sup>54</sup> This means that the industrial design must be used in advertising with a commercially reasonable degree of frequency as an indicator of being associated with a particular manufacturer or seller. The item embodying the design also must continue to be available for commercial sale.

Moreover, the owner cannot tout the utilitarian or aesthetic superiority of the item in its advertising.<sup>55</sup> The owner also will be obligated to bring infringement actions against third parties that use the trade dress without permission, or risk losing its rights.

### III. U.S. Copyright Protection

Yet a third way to seek protection in the U.S. for an industrial design is by copyright as pictorial, graphic, or sculptural work. "Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression, ... from which they can be perceived, reproduced, or otherwise communicated .... Works of authorship include ... pictorial, graphic, and sculptural works."<sup>56</sup>

#### a. Requirements for U.S. Copyright Protection

Under the U.S. Copyright Act, "pictorial, graphic, and sculptural works" include:

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, ... technical drawings, diagrams, and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article ... shall be considered a pictorial, graphic, or sculptural work 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.<sup>57</sup>

The Copyright Act further defines a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article’.”<sup>58</sup> Useful articles may not be the subject of copyright protection.

Thus, an industrial article of manufacture properly may be the subject of copyright protection in the U.S. to the extent that (i) it possesses the “basic requirements of originality and creativity,” and (ii) there is “a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art.”<sup>59</sup> Copyright protection will not be extended to “aesthetic elements [that are] ... inextricably interwoven with the utilitarian aspect of the article.”<sup>60</sup> It is for this reason that the owner should give considerable thought before seeking utility patent protection for an article of industrial manufacture that may be subject to copyright protection. Otherwise, the advantages of copyright may be sacrificed.

Stated another way, the copyrightability of an article of industrial design “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations. ... [I]f [the] design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, “where [the] design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists” and the article may be subject to copyright protection.<sup>61</sup>

#### b. Examples of Copyright Protection Sought for Articles of Manufacture

Applying the doctrine of “conceptual separability,” statuettes used as table lamp bases were given copyright protection.<sup>62</sup> Protection was given, notwithstanding that designs indistinguishable from the plaintiff’s statuettes were the subjects of design patents.<sup>63</sup> Sculptured designs cast in precious metals and incorporated into belt buckles,<sup>64</sup> the design of a bareheaded female human head with no makeup or hair,<sup>65</sup> and taxidermy mannequins for mounting animal skins,<sup>66</sup> also were given copyright protection under this test.

On the other hand, sculptures modified into bicycle racks were denied copyright protection under the conceptual separability test.<sup>67</sup> So too were human torso mannequins denied protection under this test for copyrightability.<sup>68</sup>

#### c. Types of Damages and Injunctive Relief Available

If a violation of the owner’s copyright is found in a civil action for infringement, the owner may seek an injunction preventing further infringement<sup>69</sup> and an order calling for the destruction of the infringing merchandise.<sup>70</sup> The owner also may seek an award of actual or statutory damages.<sup>71</sup> The successful copyright plaintiff also is entitled to an award of attorneys’ fees as the prevailing party.<sup>72</sup> Further, if the copyright registration

certificate is recorded with the U.S. Department of Homeland Security, Customs and Border Protection, infringing items may be barred from importation.<sup>73</sup>

#### d. Advantages of Obtaining Registered Copyright Protection

There are several advantages to obtaining a federal United States registration certificate for the claimed copyrightable work incorporated within an industrial design. Issuance of the registration certificate from the Register of Copyrights at the Library of Congress creates a presumption that the design is valid as a copyrightable work and owned by entity named in the certificate.<sup>74</sup>

Additionally, with respect to United States works,<sup>75</sup> a civil action for infringement may not be instituted until the work is registered.<sup>76</sup> Additionally, with certain limited exceptions, statutory damages and attorneys' fees are not available for infringements occurring before the design is registered with the Register of Copyrights.<sup>77</sup>

#### e. General Advantages of Copyright Protection for Industrial Designs

As discussed above, rights in a design patent for an industrial design come into being when granted by the U.S. Patent and Trademark Office. Trade dress rights arise in an industrial design when the design incorporated into a product has acquired distinctiveness through use in the marketplace. Recognition of trade dress rights, with certain accompanying procedural benefits, also can be incorporated into a federal registration on the Principal Register issued from the U.S. Patent and Trademark Office. Copyright protection, on the other hand, exists from the moment of the item's creation – fixed in a tangible medium of expression.<sup>78</sup>

Compared with the cost and time of obtaining a design patent or trade dress registration, it is relatively inexpensive and quick to obtain a copyright registration certificate. The duration of copyright protection is far greater than that afforded by a design patent, yet far less than the potentially infinite duration of trade dress rights.

If the work is created by a sole author, copyright protection lasts for a term consisting of the life of the author plus 70 years.<sup>79</sup> If multiple authors create a joint work, copyright protection lasts for a term consisting of the life of the last surviving author plus 70 years.<sup>80</sup> Copyright protection for anonymous works, pseudonymous works, and works made for hire endure for a period of 95 years from the year of the item's first publication or a term of 120 years from its first creation, whichever expires first.<sup>81</sup>

#### f. General Disadvantages of Copyright Protection for Industrial Designs

The above discussion regarding the requirements for U.S. copyright protection for industrial designs shows that obtaining such protection is rather difficult. Many products of industry and handicraft will not meet the conceptual or physical separability tests for copyright protection. If a particular industrial design is dictated by utilitarian and functional considerations, copyright protection simply will not be available. It is only

when the item is the product of artistic creativity, free from the dictates of utility or functionality, that copyright protection will be available.

Moreover, the copyright protection for industrial designs as “pictorial, graphic and sculptural works” is quite narrow. The copyright owner may not assert its rights to preclude others from using equivalent designs in articles of manufacture. The owner may only prevent use of copies of its specific copyrightable works as such or as incorporated into some other manufactured item.<sup>82</sup>

#### IV. Strategic Considerations

##### a. Double Patent Protection

In many circumstances it is advantageous to file for utility patent protection on the functional aspects of an invention, and design patent protection on the ornamental aspects of the invention. A patentee who holds a design patent and a utility patent can sue an infringer on the basis of both patents. Because the basic requirements for obtaining design patents are slightly different from those for obtaining utility patents, one patent may be invalidated during litigation, while the other may be held valid. Similarly, one patent may be infringed, while the other may not. Therefore, obtaining a design patent and a utility patent increases the odds that the patentee prevails in litigation on at least one patent. However, as discussed above, the filing for or issuance of a utility patent can compromise the ability to seek trade dress and/or copyright protection for an article of industrial design.

One strategy for filing for design and utility patent protection is to first file a utility patent application and, once the utility patent application is in condition for allowance, file a divisional design patent application based on, and claiming priority to, the original utility patent application. In order to effectively follow this strategy, the original utility patent application must be prepared and filed with drawings that are of design application quality, and a brief description of the ornamental aspects of the invention should be included in the specification.

In certain circumstances, the applicant may wish to file a divisional design patent application earlier than mentioned above, or may wish to file the design patent application simultaneously with the filing of the utility patent application. Such a situation may arise if the applicant is aware of a competitor producing a product that falls within the scope of the patent protection being sought by the design patent. In this situation, it may be advantageous to file the design patent application as soon as possible so that the design patent will issue quickly, and can then be used to prevent the competitor from continuing to produce the product. One should keep in mind, however, that under this strategy the design patent may issue first so that the claims of the utility application might be susceptible to a double patenting rejection.<sup>83</sup> If a terminal disclaimer is filed to overcome this rejection, the term of the utility patent will be limited to the term of the design patent, which is fourteen years from issue of the design patent.<sup>84</sup>

## b. Choosing Among Intellectual Property Regimes

As stated above, with exceptions that may be applicable on a case-by-case basis, one who seeks trade dress or copyright protection in the United States for an article of industrial design largely has decided to forego utility patent protection. On this assumption, the industrial design owner has a choice of three different regimes of intellectual property protection: design patent, trade dress and copyright. These forms of protection, under certain situations, can be sought separately or in combination.

Each of the design patent, trade dress and copyright protection regimes in the U.S. provides for injunctive and monetary relief for acts of infringement, and possibly an award of attorneys' fees if the circumstances warrant it. The choice of the type of protection to be pursued depends largely upon whether the industrial design in question qualifies for protection under each regime. Competitive needs and marketplace realities also may determine the type of protection that can and should be pursued.

An industrial design must meet the requirements of being an article of manufacture, originality, novelty, non-obviousness and ornamentality for design patent protection to be considered. If these requisites are met, a design patent can be acquired in a relatively short period of time. Once issued, the patent is presumed valid and potentially can provide broad protection against infringement. However, the 14 year life span of a design patent is relatively short.

An industrial design must meet the requirements of distinctiveness and non-functionality for trade dress protection to be considered. Common law rights in the U.S. can be acquired in a relatively short period of time through trademark use (as a designation of source). Registered rights, however, take somewhat longer to obtain than for a U.S. design patent.

Even once acquired, trade dress rights are fragile and can be lost. If the owner abandons use of the industrial design as a trademark, publicly touts the utilitarian aspects of the design, or allows the design to fall into common use by others, trade dress rights therein can be sacrificed. On the other hand, if the owner is vigilant in protecting its industrial design as a trademark asset, the owner can possess and claim trade dress rights indefinitely.

An industrial design must meet the requirements of originality and conceptual and/or physical separability for copyright protection to be considered. U.S. copyright law provides protection from the moment of the article's creation. However, a copyright registration for a United States work is mandatory in order for the owner to enforce its rights in court. Copyright registration for foreign and domestic works also is highly recommended if the owner wishes to obtain the advantages of statutory damages and attorneys' fees provided under the Copyright Act. The procedures for obtaining a copyright registration are relatively quick, simple, and inexpensive.

The procedural steps for registered copyright protection are rather simple. However, the conceptual and/or physical separability tests make it difficult to obtain copyright protection for an article of manufacture that does not incorporate a separate “work” of artistic expression. Once obtained, copyright rights are not easily lost, and they remain subsisting for a much longer statutory period than design patents. Yet copyright rights do not last for a potentially indefinite duration as with trade dress.

Ultimately, the choice of intellectual property protection for an industrial design comes down to (i) whether the particular design meets the requisites of protection under a particular regime, (ii) the immediacy of the need for protection, and (iii) the duration of desired protection based upon the anticipated marketable life of the product.

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<sup>2</sup>This definition of an industrial design was taken from the web site of the World Intellectual Property Organization (“WIPO”) at the URL [http://www.wipo.int/about-ip/en/industrial\\_designs.html](http://www.wipo.int/about-ip/en/industrial_designs.html).

<sup>3</sup> The Vessel Hull Design Protection Act (“VHDPA”), 17 U.S.C. §§ 1301-1332, provides copyright-like protection for the designs of vessel hulls, including plugs or molds.

<sup>4</sup> See Article I of Law No. 125 of April 13, 1959, as amended by Law No. 220 of December 22, 1999.

<sup>5</sup> See Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, Council Regulation (EC) No. 6/2001 of 12 December 2001 on Community Designs and Commission Regulation (EC) No. 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No. 6/2002 on Community Designs.

<sup>6</sup> On the one hand, Title 35 of the United States Code includes the U.S. design patent statute, as well as the U.S. utility patent statute. Many statutory requirements, which relate to utility patents, also apply to design patents. On the other hand, the subject matter covered by design patents and trade dress protection greatly overlap.

<sup>7</sup> 35 U.S.C. § 171. The first part of section 171 imposes four requirements for design patentability: novelty, originality, ornamentality, and the subject matter must be an article of manufacture. The second part of section 171 implies that other requirements, which relate to utility patents, also apply. In particular, a design must be non-obvious.

<sup>8</sup> *In re Hruby*, 373 F.2d 997, 153 USPQ 61 (CCPA 1967).

<sup>9</sup> See *Ex parte Strijland*, 26 USPQ2d 1259 (Bd. Pat. App. & Int. 1992); see also MPEP § 1504.01(a) “Computer-Generated Icons.”

<sup>10</sup> *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

<sup>11</sup> *American Fabrics Co. v. Richmond Lace Works*, 24 F.2d 365, 367 (2nd Cir. 1928).

<sup>12</sup> See *In re Bartlett*, 300 F.2d 942, 944, 133 USPQ 204 (CCPA 1962) (“The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design”).

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<sup>13</sup> See e.g., *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981); and *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982).

<sup>14</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124, 25 USPQ2d 1913, 1917 (Fed. Cir. 1997).

<sup>15</sup> *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443, 221 USPQ 97, 109 (Fed. Cir. 1984). See also *Avia Group Int'l Inc. v. L.A. Gear Cal. Inc.*, 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988) (“commercial success is relevant only if a nexus is proven between the success of the patented product and the merits of the claimed invention”).

<sup>16</sup> See e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 9 USPQ2d 1847, 1851 (1989); *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460, 43 USPQ2d 1887 (Fed. Cir. 1997) (“As explained in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148, 9 U.S.P.Q.2D (BNA) 1847, 1851, 103 L. Ed. 2d 118, 109 S. Ct. 971 (1989) (“to qualify for design patent protection, a design must have an ornamental appearance that is not dictated by function alone.”)

<sup>17</sup> *L.A. Gear v. Thom McAn*, 988 F.2d at 1123, 25 USPQ2d at 1917 (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose”). See also *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566, 40 USPQ2d 1048, 1049-50 (Fed. Cir. 1996) (“if the design claimed in a design patent is dictated solely by the function of the article of manufacture, the patent is invalid because the design is not ornamental. . . . A design is not dictated solely by its function when alternative designs for the article of manufacture are available”).

<sup>18</sup> *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990).

<sup>19</sup> *Ex Parte Cole* 18 USPQ2D 1175 (BPAI 1990).

<sup>20</sup> 35 U.S.C. §§ 172 and 119.

<sup>21</sup> 35 U.S.C. § 173.

<sup>22</sup> 35 U.S.C. § 154(a)(2).

<sup>23</sup> 35 U.S.C. § 41(b).

<sup>24</sup> See 35 U.S.C. § 283. See e.g., *National Presto Indus. v. Dazey*, 18 USPQ2d 1113 (N.D.Ill. 1990) (In this case, National Presto Industries, a manufacturer of household appliances, successfully stopped giant retailer Wal-Mart from selling, just prior to the peak in the selling season, the “Quick Fry” electric deep fryer manufactured by Dazey Corporation and allegedly infringing Presto's design patent U.S. D246,686). See also *Saidman*, “Design Patents - the Whipping Boy Bites Back”, JPTOS, Vol. 73, no. 11, 859, 866 November 1991 (reporting a survey of all reported decisions involving design patents in motions for preliminary injunctions showing that between 1986 and 1990 design patent owners were successful 70% of the time in having the court grant a preliminary injunction against the accused infringer).

<sup>25</sup> *Reebok International LTD. v. J. Baker, Inc.*, 32 F.3d 1552, 1555, 31 USPQ2d 1781 (Fed. Cir. 1994).

<sup>26</sup> See 35 U.S.C. § 284, second paragraph.

<sup>27</sup> 35 U.S.C. § 282 (“A patent shall be presumed valid”).

<sup>28</sup> See e.g., *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378, 64 USPQ2d 1676 (Fed. Cir. 2002) (“Invalidity of a design patent claim must be established by clear and convincing evidence”).

<sup>29</sup> *Gorham Co. v. White*, 81 U.S. (14 Wall) 511, 528 (1871).

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- <sup>30</sup> See *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988).
- <sup>31</sup> *Unique Functional Products, Inc. v. Mastercraft Boat Co.*, 82 Fed. Appx. 683, 687 (Fed. Cir. 2003).
- <sup>32</sup> 35 U.S.C. §§ 172 and 119.
- <sup>33</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n. 1 (1992).
- <sup>34</sup> *Two Pesos*, 505 U.S. at 768.
- <sup>35</sup> *Two Pesos*, 505 U.S. at 774. The definition of “trademark” under the U.S. Trademark Act is quite broad, and includes “any word, name, symbol, or device, or any combination thereof.” 15 U.S.C. § 1127.
- <sup>36</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215 (2000).
- <sup>37</sup> *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11 (“Secondary meaning” is acquired when “in the minds of the public, the primary significance of a product feature ... is to identify the source of the product rather than the product itself.”).
- <sup>38</sup> *Thompson Med. Co., Inc. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985).
- <sup>39</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164-165 (1995).
- <sup>40</sup> *Inwood Laboratories*, 456 U.S. 844, 850 n. 10.
- <sup>41</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. at 170.
- <sup>42</sup> *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001).
- <sup>43</sup> *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. at 29-30.
- <sup>44</sup> See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).
- <sup>45</sup> *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (CCPA 1964); *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (CCPA 1974).
- <sup>46</sup> 15 U.S.C. § 1116(a).
- <sup>47</sup> 15 U.S.C. § 1118.
- <sup>48</sup> 15 U.S.C. § 1117.
- <sup>49</sup> 15 U.S.C. §§ 1057(b), 1115(a). A mark capable of distinguishing the owner’s products but not registrable on the Principal Register are afforded registration on a separate Supplemental Register. Marks registered on the Supplemental Register are not afforded the numerous presumptions of validity, ownership and other benefits afforded marks registered on the Principal Register. 15 U.S.C. §§ 1094.
- <sup>50</sup> 15 U.S.C. §§ 1064(1), 1065 1115(b). However, the validity of trade dress or its registration may be challenged at any time on grounds that it has become generic. 15 U.S.C. §§ 1064(3), 1065.
- <sup>51</sup> 15 U.S.C. § 1125(a)(3). However, the validity of trade dress or its registration may be challenged at any time on grounds that it is functional. 15 U.S.C. §§ 1064(3), 1065, 1115(b)(8).
- <sup>52</sup> 15 U.S.C § 1124; 15 U.S.C. § 1526.



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- <sup>53</sup> 15 U.S.C. § 1125(a).
- <sup>54</sup> 15 U.S.C. § 1127 (Trade dress is considered abandoned when the owner ceases its use as a trademark with an intent not to resume use. Three years of non-use is *prima facie* evidence of abandonment. A mark also may be deemed abandoned when, through action or inaction on the owner's part, it no longer is an indicator of a single source of the associated item).
- <sup>55</sup> *In re Morton-Norwich*, 671 F.2d 1332, 1341 (CCPA 1982)
- <sup>56</sup> 17 U.S.C. § 102(a).
- <sup>57</sup> 17 U.S.C. § 101 (definition of “pictorial, graphic, and sculptural works”).
- <sup>58</sup> 17 U.S.C. § 101 (definition of “useful article”).
- <sup>59</sup> *Barry Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980).
- <sup>60</sup> *Carol Barnhart Inc. v. Economy Cover Corp.*, 594 F. Supp. 364, 370 (E.D.N.Y. 1984), *aff'd*, 773 F.2d 411 (2d Cir. 1985).
- <sup>61</sup> *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987), *citing*, Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 741-742 (1983).
- <sup>62</sup> *Mazer v. Stein*, 347 U.S. 201, 214 (1954).
- <sup>63</sup> *Mazer*, 347 U.S. at 216-217.
- <sup>64</sup> *Barry Kieselstein-Cord*, 632 F.2d at 990.
- <sup>65</sup> *Pivot Point Int'l Inc. v. Charlene Prods. Inc.*, 372 F.3d 913, 931 (7<sup>th</sup> Cir. 2004).
- <sup>66</sup> *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488, 494-495 (4<sup>th</sup> Cir. 1996); *Hart v. Dan Chase Taxidermy Supply Co., Inc.*, 86 F.3d 320, 323 (2d Cir. 1996).
- <sup>67</sup> *Brandir International*, 834 F.2d at 1147-1148.
- <sup>68</sup> *Carol Barnhart*, 594 F. Supp. at 371.
- <sup>69</sup> 17 U.S.C. § 502.
- <sup>70</sup> 17 U.S.C. § 503.
- <sup>71</sup> 17 U.S.C. § 504.
- <sup>72</sup> 17 U.S.C. § 505.
- <sup>73</sup> 17 U.S.C. §§ 602, 603; 19 C.F.R. § 133.31 (2003).
- <sup>74</sup> 17 U.S.C. § 410(c).
- <sup>75</sup> *See* 17 U.S.C. § 101 (definition of “United States work”).
- <sup>76</sup> 17 U.S.C. § 411(a).

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<sup>77</sup> 17 U.S.C. § 412.

<sup>78</sup> 17 U.S.C. § 302(a); see also 17 U.S.C. § 101 (definitions of “created” and “fixed”).

<sup>79</sup> 17 U.S.C. § 302(a).

<sup>80</sup> 17 U.S.C. § 302(b).

<sup>81</sup> 17 U.S.C. § 302(c).

<sup>82</sup> *Mazer*, 347 U.S. at 218.

<sup>83</sup> *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), abrogated on other grounds by *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000), (“The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. ... In these cases, a ‘two-way’ test is applicable. ... Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that ‘the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa.’”)

<sup>84</sup> 35 U.S.C. § 173.