

Designs 2018 A Global Guide

United States

Banner & Witcoff, Ltd

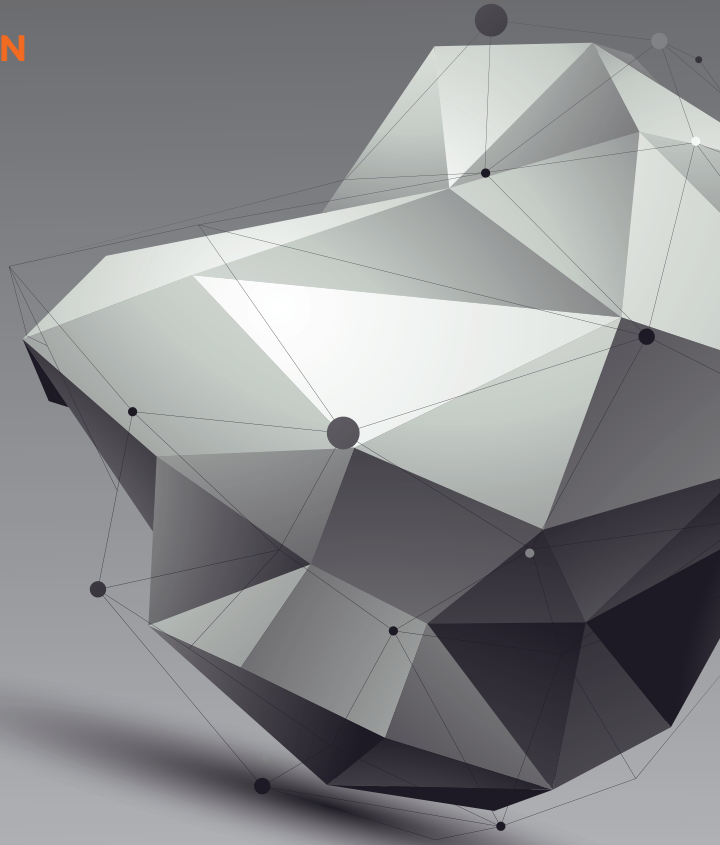
Robert S Katz and Alisa S Abbott



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Our clients are
DESIGN DRIVEN
and so are we.

We seek and secure
GLOBAL PROTECTION
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Authors

Robert S Katz and **Alisa S Abbott**

Legal framework

The legal system in the United States provides several venues for securing the protection of a design. The appearance of a product can potentially be protected by the following types of IP right:

- design patents;
- copyrights;
- trade dress; and
- utility patents.

Each form of intellectual property has its own requirements for protection, test for infringement and statutes governing remedies. The specific type or types of IP right used to protect a design will typically be fact specific. In many instances, designs may be protected by more than one form of IP right. In some cases, a product's design could be covered by all four methods of protection. When seeking IP protection for any design, an analysis of the advantages and disadvantages of each form of protection should be considered. For example, acquiring utility patent rights in conventional manners can affect the ability to procure other IP rights.

Although copyrights and trademarks are popular forms of intellectual property covering aesthetics, design patents are generally the intellectual property form of choice in most situations. According to US Patent and Trademark Office (USPTO) statistics, in 2016 the number of design patents issued increased by 11% over the prior year and the annual number of design patent grants has steadily increased over the past 40 years.

Unregistered designs

Design patents

Under the US patent law statute, no protection is presently available for unregistered designs. All design patent-related rights must be procured by the timely filing of a design patent application at the USPTO and the subsequent grant of a design patent by the USPTO.

Copyright

Assuming the underlying work is protectable, copyrights are created when the design is fixed in a tangible medium of expression. For works created after January 1 1978, copyrights generally provide protection for a

term of 70 years after the death of the author. If a work is created by multiple authors, the term lasts for 70 years after the last surviving author's death. For works made for hire, the term is the shorter of either 95 years from first publication or 120 years from creation.

Copyrights may provide protection for certain elements of a design. A feature that is part of a useful article is protectable by the copyright regime when:

- it can be perceived as a two or three-dimensional work of art separate from the useful article; and
- it would qualify as a protectable pictorial, graphic or sculptural work – either on its own or fixed in some other tangible medium of expression – if it were imagined separately from the useful article into which it is incorporated.

Trade dress

Once consumers identify trademarks – including trade dress – as source identifiers, common law rights attach and can be relied on to protect the trademark where use has occurred. Due to the additional benefits afforded to federally registered trademarks, including nationwide rights and presumptions of validity, applying for a federal trademark registration is often recommended. Trademark rights protect against a likelihood of consumer confusion in the marketplace.

Trade dress includes product configuration and product packaging trademarks. Unlike other types of trademark – including product packaging trademarks, which can be inherently distinctive – product configuration trademarks are never seen as inherently distinctive and therefore it can be harder to prove that they are protectable and registrable. For a product configuration trademark to be protectable, it must:

- serve as a source identifier;
- have acquired distinctiveness (also referred to as 'secondary meaning'); and
- not be *de jure* functional.

If trademark protection for trade dress is desired, steps should be taken from the outset to make the trademark protectable, including identifying non-functional aspects

in the product design or product packaging and ensuring that non-functional trademark features are not advertised as functional.

Registered designs

Design patents

Design patents are governed by the US patent law statute. As set forth in 35 USC § 171, design patents provide protection for the ornamental design of an article of manufacture. A design patent gives the owner exclusive rights to make, use, sell, offer for sale and import the design in the United States. A design patent protects only the visual design aspects of a product, not its underlying functionality. As an example, designs can protect various products ranging from consumer electronics devices to apparel, fashion accessories to automobiles and manufacturing parts to product packaging. Design patents can also be used to protect on-screen graphical images and animations (ie, graphical user interfaces). Essentially, design patents may be used to protect the designs of almost any type of article of manufacture, provided that all statutory provisions are met. As noted above, it is the IP right of choice for most industrial designs.

Each design patent in the United States has a single claim. The scope of the claim focuses primarily on the design depicted in the figures and is generally complemented by a short written description explaining features or aspects of the drawings. The drawings may be line drawings, photographs or computer-rendered images.

Designs can also be directed to individual portions or features of a product. Accordingly, much of the strategy to protect designs in the United States has developed around a creative use of portion practice. This is commonly done by depicting the portion of the design for which protection is sought in solid lines and rendering the remaining subject matter in dashed lines. There are many reasons to consider in detail which portions – if any – should be disclaimed, and the benefits of using an experienced practitioner in this regard should not be underestimated.

Design patent grants emanating from applications filed in the United States on or after May 13 2015 enjoy a term of 15 years from the date of grant. Design patent grants

emanating from applications filed in the United States before this date have a 14-year term. The United States does not require any renewal or maintenance fees for design patents to remain in force through their terms.

Copyright

No registration is required to be entitled to rights under copyright law. Nonetheless, filing a copyright application with the US Copyright Office is a prerequisite for bringing a lawsuit to enforce the copyright. There are also important advantages of timely registration, including the entitlement of certain evidentiary presumptions and the ability to seek statutory damages and attorneys' fees.

Trade dress

Trade dress trademarks may be federally registered at the USPTO. The available bases under which a federal trademark application may be filed are:

- actual use of the mark in commerce;
- intent to use;
- a foreign application;
- a foreign registration; and
- the Madrid Protocol.

The Madrid Protocol allows for extended protection in the United States through the applicant's country of original filing. As product configuration trademarks need acquired distinctiveness to be registered on the Principal Register, they should be filed only if the trademark is already in use in the United States.

Registration on the Principal Register gives the owner many important benefits, including:

- legal presumptions of ownership and validity;
- US registration as a basis to obtain registrations in foreign countries;
- the ability to register the mark with the US Customs and Border Protection to limit importation of infringing foreign goods;
- the right to use the registered trademark symbol '®';
- a bar to registration of confusingly similar marks; and
- constructive notice to the public of the registrant's claim of ownership of the mark.

Utility patents

Utility patents can sometimes be used to protect the appearance of an article. In many cases, the scope of the right can be broader with a utility patent than with other rights. The scope is defined by written claims at the end of the application, and these written claims can be drafted to cover a wider variety of appearances than just those shown in the drawings. It is generally much more difficult to obtain a utility patent directed to the appearance of an article than to a design patent. In most of these utility patent grants, there is a non-obvious benefit associated with the appearance of the product.

Procedures

Design patents

Design patents are obtained by filing a design patent application with the USPTO. Applications are reviewed by a patent examiner to ensure that the design claim meets all statutory provisions. The examiner also searches prior art to determine whether the design is novel and non-obvious.

The examiner reviews the drawings and written specification to confirm that the claimed design is clear, consistent and enabled. Along this line, the USPTO expects that the design be disclosed with a greater level of detail and clarity as compared to most countries. Objections and rejections are not uncommon, especially when the applicant is unfamiliar with typical US drawing conventions. Line shading or stipple shading is commonly used in the United States to aid in showing the contours of various surfaces of the design.

If the examiner issues a rejection or objection, the applicant has the opportunity to respond. The response often requires an amendment. When making an amendment, however, the introduction of new matter is prohibited.

Each design patent is entitled to only one design claim. Thus, if multiple distinct patentable embodiments are presented, the examiner will issue a restriction requirement and the applicant will need to choose one design invention to pursue. Divisional applications may be filed to protect non-elected design embodiments at any time while the application remains pending.

The United States also has a duty of disclosure that requires the inventor, the applicant and those involved in the design patent prosecution to submit to the USPTO prior art references that may be material to the examination of the design claim. This duty extends until the design patent is granted.

A US design patent application can be initiated through the Hague Agreement for Industrial Designs by filing a Hague application and designating the United States; however, given the nuances associated with

prosecuting a design patent application in the United States, consultation with an experienced US design patent practitioner is strongly recommended. For example, while collective design applications are permitted in Hague filings, the USPTO will commonly issue restriction requirements.

Copyright

Unlike design patents, copyright applications are not compared to previously disclosed material during their examination. Instead,



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Robert S Katz is a principal shareholder in the Washington DC office of Banner & Witcoff. He has helped to procure more than 6,000 design patents in the United States and more than 18,000 design patents/registrations outside the country. He is a former US Patent and Trademark Office utility patent examiner and has a mechanical engineering degree from Carnegie Mellon University and a JD from George Washington University School of Law. He is currently a professor of design law at George Washington University School of Law and formerly taught at Georgetown University Law School. At the International Federation of Intellectual Property Attorneys, he serves as treasurer of the US section and is former chairman of the industrial design section. He currently serves as chair of the designs committee of the International Trademark Association.



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Alisa S Abbott is an associate in the Washington DC office of Banner & Witcoff. She represents clients in all facets of design patent procurement, prosecution and IP counselling. Her practice includes evaluating and securing design patent protection for a broad range of sophisticated technologies, including portable and wearable electronic devices, home appliances and construction materials. She graduated from the University of Virginia with a bachelor of arts degree, double-majoring in American studies and religious studies. She earned her JD from Washington and Lee University School of Law.

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the US Copyright Office assesses whether the statutory requirements for proper subject matter are satisfied.

Trade dress

Like design patents, trademarks are examined at the USPTO. A trademark examining attorney analyses each application to ensure that the statutory requirements are met and that it is unlikely to cause confusion with existing trademarks. Proof may be required to show that the trade dress is distinctive or non-functional.

On registration, additional fees and submissions are required to maintain trademark registration and protection. Between the fifth and sixth year following registration, the registrant must file a declaration of use including a fee and proof of use in the United States. To keep the registration alive, the registrant must again file a declaration of use every successive 10 years.

Utility patents

Similar to a design patent application, a utility patent application must be filed with the USPTO to start the prosecution process. The patent examiner will review the claims for novelty, non-obviousness and other statutory provisions. It is not uncommon for applications to be initially rejected. If the application is allowed and the issue fee is paid, the term of the utility patent will normally be 20 years from the date of filing. After a utility patent grants, maintenance fees are due at 3.5, 7.5 and 11.5 years from grant to keep the utility patent in force.

Enforcement

Design patents

The grant of a design patent entitles the owner to exclusive rights to that design, such that the owner may bring suit against an infringer. In order to assess whether a design patent has been infringed, the scope of protection available to the allegedly infringed design must be properly determined. For design patents, the scope of protection does not include the functionality underlying the overall design and does not extend to a general design concept. The drawing figures and the specification determine the scope of the claimed design. The drawing figures provide a visual, while the specification discloses any additional descriptive information that may assist in describing the images provided. The test for design patent infringement, known as the ‘ordinary observer’ test, assesses whether the accused design and the patented design are substantially the same in the eyes of an ordinary observer.

The design patentee has the burden to prove infringement, which need be proven only by a preponderance of the evidence. To invalidate a design patent, the accused infringer has the burden of proof, which must be shown by clear and convincing evidence.

Copyright

Copyright infringement occurs when a protected copyright is reproduced, distributed, publicly displayed or copied in a derivative fashion without permission from

the original copyright owner. To determine whether a copyright has been reproduced without authorisation, US courts refer to the 'substantial similarity' standard. An infringing work can still be substantially similar to the original copyright even if some features are slightly changed or altered. Depending on the form of the copyrighted work and method of infringement, various tests are employed to evaluate whether the substantial similarity standard has been satisfied.

Trade dress

Once a plaintiff has proven ownership of its asserted trademark, courts use the likelihood of confusion test to determine whether the owner's trademark has been infringed. Infringement occurs when a junior user's use of a trademark is similar enough to the senior user's use of its trademark that it causes a likelihood of consumer confusion as to the source or quality of the goods or services.

The USPTO balances the *DuPont* factors laid out by the Federal Circuit when determining a likelihood of confusion. These factors include an evaluation of the similarity or dissimilarity of various aspects of the marks (eg, the goods or services being sold, the visual appearance and the commercial impression), the sophistication of consumers, the strength or fame of the senior mark, any actual confusion and the risk of potential confusion.

Ownership changes and rights transfers

Design patents

In the absence of a legal obligation, rights to a design patent belong to the inventor. The rights can be assigned or transferred. Recordation of assignment rights with the USPTO is recommended, as it can provide evidentiary benefits.

Copyright

Unless there is a work-for-hire agreement, the rights to a copyright will initially belong to the author of the work. These rights can also be assigned or transferred.

Trade dress

Like all trademarks, trade dress rights belong to the user. Trade dress rights may be assigned, but in order for the rights to remain valid, use of the trade dress must continue. Further, the goodwill in a trademark cannot be separated from the trademark itself. Therefore, an assignment should always assign both the trademark rights and related goodwill for the assignment to be effective. Recordation of assignment rights with the USPTO is highly recommended.

Related rights

Generally, the rights as enumerated above provide the applicable set of enforceable rights related to design protection; however, under certain circumstances, other statutory rights may apply. For example, counterfeiting is found under other statutory provisions. **WTR**



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