IP by Design: Protecting Unique Products Using Trade Dress, Patent, and Copyright Law

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Overview

• Housekeeping
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  • Questions
  • Materials post-webinar
• Next webinar – August 6th
Agenda

• Design Protection
• Trade Dress
• Copyright
• Protecting a Unique Product – A fictional tale of Purrfect Watches, LLC’s MEOWTIME cat face watch and accompanying app
Design Protection

<table>
<thead>
<tr>
<th>Utility Patent</th>
<th>Design Patent</th>
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<tbody>
<tr>
<td>• Protects the way an article <em>works</em></td>
<td>• Protects the way an article <em>looks</em></td>
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<td>• Invention must be articulated in words</td>
<td>• Generally less expensive and quicker to issue</td>
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<td>• Longer term</td>
<td>• Examples of protectable designs:</td>
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<td>• Maintenance fees</td>
<td>• Overall appearance</td>
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<td>• Ornamentation</td>
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<td>• Packaging, Patterns</td>
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<td>• Fonts, Icons</td>
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Design Patent – Scope of Protection

• Claim scope determined primarily by drawings, not words
• Increase claim scope by
  • Illustrating non-essential features in dashed lines
  • Including multiple embodiments with common design features
  • Clarifying language in specification
Design Protection: EU v. US

**Conceptual Difference**
- EU – Protect the specific design
- US – Protect the idea behind the design

**Procedural Difference**
- EU – Registration without substantive examination
- US – Issued patent after substantive examination
Design Prosecution in the EU

- Design registrations at EU level
  - Registered Community designs („RCDs“)
  - Office for Harmonisation in the Internal Market („OHIM“)
  - Cover all 28 EU member states
  - Fast, inexpensive, efficient, up to 25 years

- Design registrations at national level
  - National patent and trademark offices
  - Cover single EU member state only
  - Less fast, less efficient

- International design registrations designating EU, EU member state
In US:

- Most cases seek injunction, not license - but settle quickly
- Two requirements for infringement:
  - Ordinary Observer Test – designs ‘substantially the same’ so as to deceive an observer into purchasing one supposing it to be the other
  - Point of Novelty Test – accused design must ‘appropriate the novelty which distinguishes it from the prior art’
- By statute – damages shall be no less than an infringer’s gross profit
- Tried to a jury; potentially greater admissibility of ‘bad acts’

In EU:

- Validity of registrations presumed, but tested in court
- Scope extends to products with same overall impression
Design Patent – Recent Developments

In US:

• Increased focus on protecting displayed designs
• Tougher standards on amending claim scope after filing
• Option for filing international application under Hague Convention coming soon

In EU:

• Prosecution: Minefield applications
• Litigation: EU wide proceedings
  • Jurisdiction
  • Applicable law
Trade Dress
What is Trade Dress?

• Involves the total image of a product and may include features such as size, shape, color or color combinations, texture, or graphics

• Generally two types:
  • Product packaging/labeling
  • Product design (overall configuration/appearance of a product)

• Special rules for “trade dress”
  • Must be “non-functional” (e.g. not essential to the use or purpose of the article or does not affect the cost of quality of the article; no competitive advantage to design).
  • Product packaging may be inherently distinctive, so secondary meaning not necessarily required. Product design/configuration cannot be inherently distinctive. Secondary meaning always required.
What is Copyright?

• Copyright protects “*original works of authorship*”
  • *Examples*: books and other written works like marketing and advertising material, website content, user manuals, and computer programs; graphical works including designs, logos (only sometimes), and fabric patterns; photographs; music; etc.,

• Facts and ideas are not protected by copyright
• Functional material is not protected by copyright
  • Clothing designs (but not fabric patterns) are typically considered functional and not protected
• Computer programs - program logic, algorithms, methods, & concepts are not protected, but code and certain visual aspects of screen displays are protected
Copyright Ownership

• Copyright protection *arises automatically* from the moment a work is first “fixed in a tangible medium of expression” (*i.e.* no longer just in the author’s head).
• The *author* — not necessarily the hiring party — owns the copyright in the work
• Exception to the above: a work-made-for-hire
• The author has rights even without registration (but registration provides additional benefits)
Protecting a Unique Product
A Fictional Scenario
Overlapping Protection

- Design Protection
- Copyright
- Trade Dress
Protecting a Unique Product
Protecting a Unique Product

Copyrightable Artwork
Protecting a Unique Product

Design Patent – overall design

FIG. 1

FIG. 6

FIG. 7

FIG. 2

FIG. 3

FIG. 4

FIG. 5
Protecting a Unique Product

Design Patent – broadened scope

FIG. 1
Protecting a Unique Product

Trade Dress

MeowTime Sells One Million

MeowTime, LLC reported that they have sold over 1,000,000 Purfect watches in the United States and Europe. The

MeowTime
By PURRfect Watches

"The cat-face watch-face!"
Protecting a Unique Display

App Icon for the MeowTime app
Protecting a Unique Display

User Interface for the MeowTime App

• Trade Dress
• Copyright
• Design Patent
Protecting a Unique Display

Design Patent – Animation

FIG. 1

FIG. 2

FIG. 3

FIG. 4

FIG. 5

FIG. 6
Considerations

- New and creative elements of products, apps and websites are protectable by design patent, trade dress and copyright, with each form of protection providing different advantages.
- Think about how your company’s products are protected by multiple types of IP.
- **Trade Dress**: think about source identifying attributes and proper advertising techniques
- **Copyright**: think about federal registration and ensuring ownership by the company when independent contractors work on projects
- **Design Patent**: think about protecting non-functional design elements that will likely carry over across multiple versions
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Please send your NY CLE forms or questions about the webinar to Ellen at makarevich@fr.com.

A replay of the webinar will be available for viewing at www.fr.com
Thank you!