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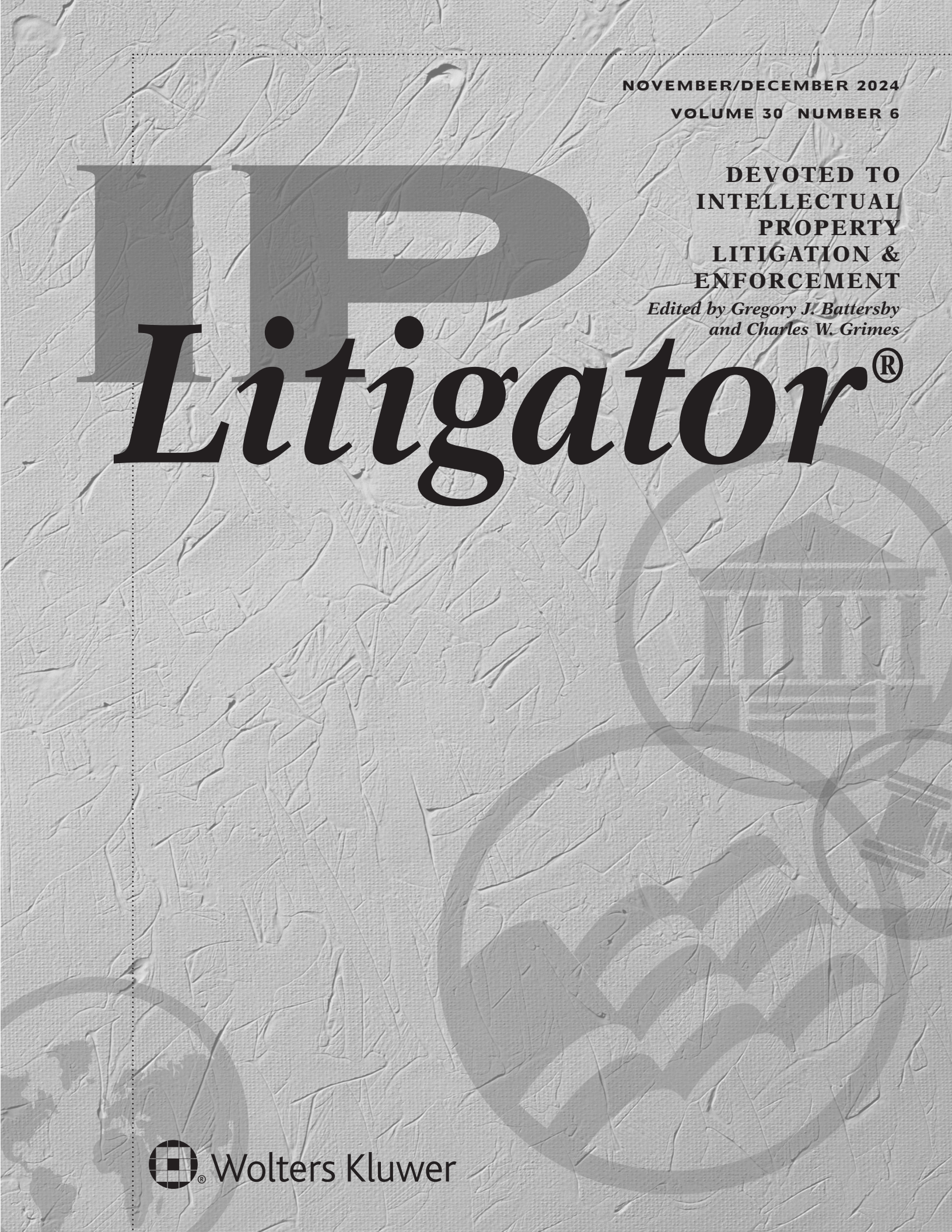


Wolters Kluwer

Form Versus Function: Protecting Product Design Through Design Patents, Trade Dress, and Copyrights

Christopher Scharff

Chris Scharff is a Shareholder at McAndrews who focuses on all areas of intellectual property, particularly patent litigation, post-grant review proceedings, and IP transactional work. Chris's litigation practice includes all areas of discovery, trial, and appeal. Chris regularly represents both plaintiffs and defendants in disputes ranging from small cases to ones involving hundreds of millions of dollars.

The design of a successful product—its look and feel—is often the result of a process that is every bit as intensive as the technical development of the product. A good design may be one that is aesthetically pleasing, or which evokes emotions or a sense of fun. It may be one that spotlights the quality or craftsmanship of a product. It will likely take into account cost or practical considerations, including the functionality of the product. And ideally, it will set the product apart from the competition and become synonymous with your company—an indicator that this product came from Company X. Protecting a product's design, therefore, can often be just as important as protecting the technical innovations embodied in the product. Just as important is knowing which type of legal protections to pursue for your product's design.

At the most basic level, legal protections for product design range across a spectrum depending on the degree to which the design is influenced or dictated by functional considerations. At one end of the spectrum, a design may be protectable by design patents—even if the design is for a utilitarian article that performs a function—so long as the design is not *dictated* by function. At the other end of the spectrum, a design may be protectable by copyrights—but only with respect to features that essentially exist *only* to look at. And in between, a product's design may be protectible by trade dress—but not if the design is "functional" in the sense of being essential to the use or purpose of the article or if it affects the cost or quality of the article.

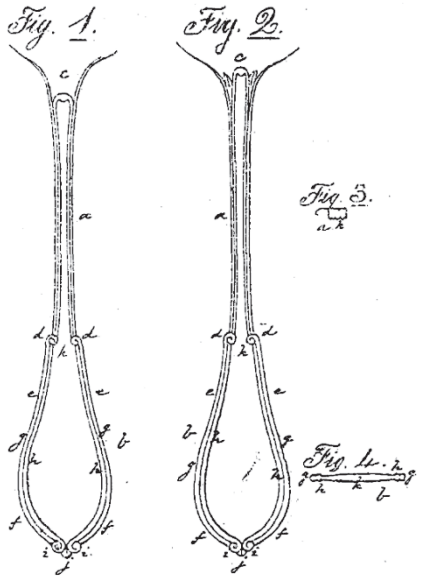
Design Patents

The most common type of protection for product design—but also the type with the shortest term—is design patent protection. A design patent may be obtained for any "new, original and ornamental design for an article of manufacture." 35 U.S.C. § 171. Design patents must be applied for with the U.S. Patent and Trademark Office, and there are no rights in an unregistered design (unlike copyrights or trade dress). Design patents are effective for 15 years from the date they are granted.

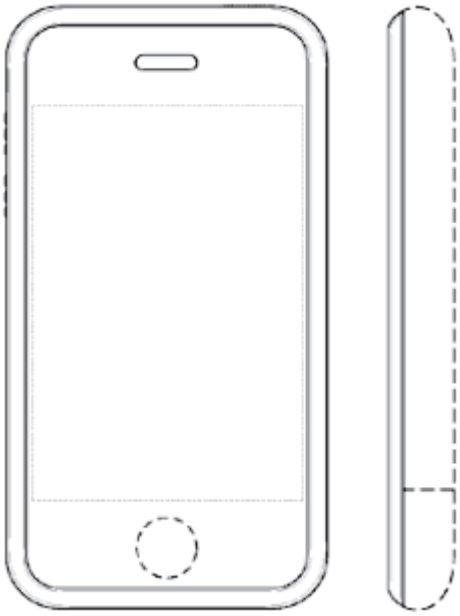
One of the primary advantages of a design patent is that they can protect useful articles that perform a function. For example, famous cases of design patent range from an 1871 Supreme Court decision (*Gorham v. White*) involving the design for a spoon and fork handle, to the *Apple v. Samsung* "patent wars" from about 10 years ago that involved the basic design of the then-existing version of the iPhone. Both of these designs (shown on the next page) were to functional articles.

Under design patent law, however, a design patent is only invalid for functionality if the overall claimed design is "dictated by function." If, for example, a designer would have had other design options available to him or her, that tends to support that the design was not dictated by its function. While a design patent applicant must also show that the claimed design is novel and non-obvious over prior designs, this low bar for functionality in a design patent makes it particularly suitable for protecting product designs. In addition, to show infringement of a design patent, the design patent and accused product are just visually compared to ask whether an "ordinary observer" would find the two designs to be substantially similar. The remedies for design patent infringement include injunctions and monetary damages, which can comprise the infringers total profits under 35 U.S.C. § 289.

Design patent law has recently undergone several significant changes that have somewhat eroded the strength of design patents and put their value in flux. For example, in



(Gorham v. White design patent)



(Apple v. Samsung design patent)

the original *Apple v. Samsung* decision, the jury awarded the total profits from Samsung's phone for infringement of Apple's design patents, which resulted in an award of over $1 billion dollars. This judgment was ultimately appealed to the Supreme Court. In 2016, the Supreme Court narrowed the law on damages for design patents, finding that the damages for the infringing "article of manufacture" could be on less than the entire product sold to customers, including a sub-component that is separately the subject of the asserted design patent. Then, in 2024, the U.S. Court of Appeals for the Federal Circuit overhauled the test for determining whether a design patent is invalid as obvious over prior designs. In *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024), the Court abandoned the long-standing test for determining whether a design patent is obvious, instead adopting a new, more flexible test that most commentators believe is easier for patent challengers to satisfy—that is, easier to invalidate design patents.

That said, an issued design patent is entitled to a presumption of validity and is still one of the most powerful tools for protecting a product design against copying by competitors.

Trade Dress

A much harder to obtain—but much longer lasting—type of protection for product designs is trade dress protection. Trade dress protects the visual appearance of a product that serves to identify the source of goods or services. Unlike design patents, which expire 15 years after issuance, trade dress protection can last forever so long as the design is being used in commerce. Moreover, while a trade dress can be registered with the U.S. Patent and Trademark Office, it need not be. Instead, a company can wait to see if its product design is successful and becomes distinctive and then rely on rights to its unregistered trade dress to take action against copiers. Benefits of registering a trade dress include a presumption of validity (including a presumption that the trade dress is not functional), nationwide notice, and incontestable status after five years.

In order to be protectable as a trade dress, the design must not comprise any matter that, as a whole, is functional. For purposes of trade dress, a feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. Put another way, a trade dress is functional if the product works better/cheaper/etc. due to the design. For example, in the same *Apple v. Samsung* dispute where Apple prevailed in showing design patent infringement, the U.S. Court of Appeals for the Federal Circuit found that Apple did *not* have protectable trade dress in the designs for its iPhones because the design contributed to making it easy to use. At the same time, to be protectable under trade dress law, a design does not need to be of a non-functional item. For example, in *Leapers, Inc. v. SMTS, LLC*, 879 F.3d 731,

733 (6th Cir. 2018), the parties disputed whether a design to the unique "knurling" pattern of a rifle scope could qualify as a protectable trademark or whether it was functional. The Court held that because the variety of patterns that could be applied were effectively unlimited and the knurling was purely ornamental (even though the rifle scope and knobs themselves were functional), the design was not excluded from protection as being functional.

Functionality, however, is not the only requirement for protecting a design as a trade dress. In order to qualify as protectable trade dress, the Supreme Court decided in 2000 in *Wal-Mart Stores, Inc. v. Samara Bros*., 529 U.S. 205, 210-11 (2000) that the design must also be "distinctive," either inherently (due to an unusual or memorable nature that serves primarily to designate the origin of the product) or by acquiring secondary meaning (i.e., that consumers associate the look and appearance of the design as serving to identify the seller). It is usually this requirement that is the most difficult to establish. Effectively, to protect a design under trademark law, the design must be immediately identifiable as relating to a given product name.

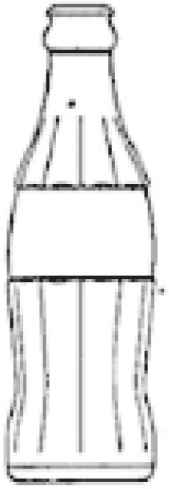
Examples of registered trade dress include the distinctive shape of the Coca-Cola bottle, the shape of Lego figures, and the fish shape of Goldfish crackers (shown below).

If the owner of the alleged trade dress is successful in satisfying all of these requirements, trade dress is a particularly powerful tool. Again, trade dress protection survives indefinitely. Yet it offers many of the same protections as design patents. Namely, the test for infringement is somewhat similar, requiring a showing that a consumer would likely be confused as to the source of goods when comparing an accused design to the trade dress. And similar remedies are available, including injunctions and damages that can include a defendant's profits. Additionally, unlike a design patent that can be challenged as invalid in view of prior designs, a trade dress cannot be challenged on the basis of prior trademarks after it has been registered for five years (it can only be challenged on other bases such as functionality).

Copyright

Lastly, certain features of a product—especially if the product is primarily decorative or has separable decorative features—can be protected by copyright law. Copyright law protects original works of authorship. This can include objects such as sculptures, jewelry, carvings on the back of chairs or picture frames, and the like. Copyright protection for works created after January 1, 1978, lasts for the life of the author plus 70 years. For copyright protection, however, the non-functionality requirement is quite strict. Copyright protection is not available for a useful article except to the extent that the article has features that are separable from, and capable of existing independently of, the utilitarian aspects of the article. Put another way, copyright protection is not available for an object, or features of the object, unless they only serve to portray their own appearance (effectively, that their only purpose is to look at them). There is a minor exception for works of "artistic craftsmanship" that serve primarily to portray an appearance but have incidental usefulness, such as a paperweight or bookend.

One example of the tension between form and function in a copyright was litigated before the Supreme Court in *Star Athletica, LLC v. Varsity Brands, Inc*., 580 U.S. 405



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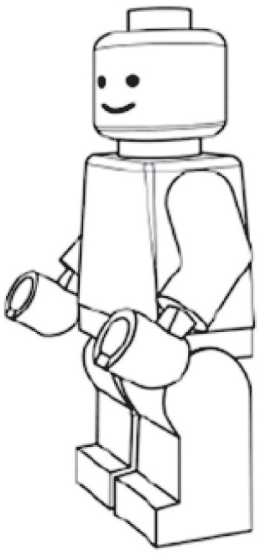

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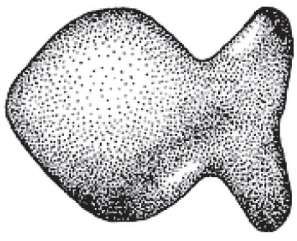


(Reg. No. 1,640,569)

(2017). That case involved an asserted copyright to cheerleader uniforms, such as shown below.

(Cheerleader design at issue in *Star Athletica*)

In *Star Athletica*, the Supreme Court held that while the cheerleader uniform itself could not be copyrighted because it was functional (it served as clothing), any designs affixed to the uniforms that are separable and capable of existing independently could (if sufficiently creative) qualify for copyright protection. For example, a piece of artwork, photograph, or drawing on a T-shirt could be copyrighted because the medium on which the artwork, photograph, or drawing exists has no bearing on its design—the art could just as easily exist on another medium.

For copyright protection, therefore, the functionality question effectively boils down to whether the article has any useful purpose, and if it does, whether there are any features (such as decoration affixed to the article) that can be separated from it. For example, a carving on the back of a chair or a floral relief design on a plate could be protected by copyright, but the design of the chair or the plate itself could not.

In addition, to assert copyright protection, several other requirements must be met. For example, before a copyright owner can file a lawsuit based on a U.S. copyright, the owner must register the copyright in the U.S. Copyright Office. While the Copyright Office does not examine copyrights to the same degree that patents are examined in the U.S. Patent Office, it can reject a copyright application that seeks to register a useful article. Additionally, copyright infringement requires a showing of copying, typically by proving that the defendant had access to the copyrighted work plus substantial similarity between the alleged copyright and the accused work.

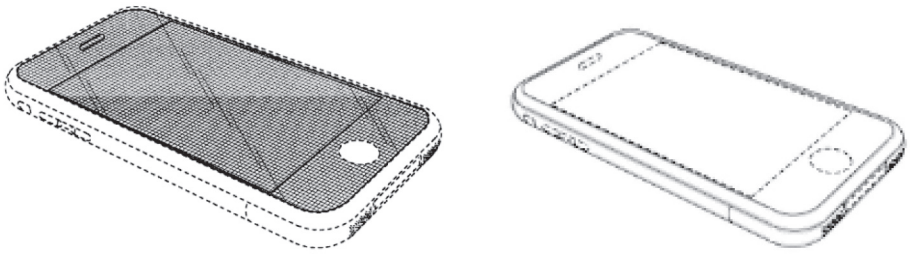
As a result, copyright protection may be the most difficult to establish for a product design. But if the product design includes significant decorative features, it may be worth protecting those decorative features themselves.

Choosing Type of Protection and Protection of IP Via Multiple Methods

In some limited cases, the design of a product may be appropriate to protect under multiple intellectual property types, i.e., as a design patent, trade dress, and copyright. For example, while the functionality requirement of trade dress protection is more stringent than that of design patents, if a design can pass the requirements for both, it can be protected under both.

Similarly, both the Patent Office and the Copyright Office recognize that an ornamental design can, in some instances, be protected by both a copyright and a design patent. For example, the Manual of Patent Examining Procedure itself recognizes that "[t]here is an area of overlap between copyright and design patent statutes where the author/inventor can secure both a copyright and a design patent. Thus an ornamental design can be copyrighted as a work of art and may also be subject matter of a design patent." MPEP § 1512, *citing In re Mogen David Wine Corp*., 328 F.2d 925 (C.C.P.A. 1964). In fact, a copyright notice can be included in a design patent. *See id.* And the Copyright Office similarly recognizes that a copyright in a pictorial, graphic, or sculptural work can be in some instances copyrighted despite the existence of a prior design patent. *See Registrability of Pictorial, Graphic, or Sculptural Works Where a Design Patent Has Been Issued*, 60 Fed. Reg. 15605-01, 15605 (March 24, 1995). But notably, the Supreme Court has held that the existence of a prior *utility* patent on a product feature is strong evidence that the feature is functional (and therefore not protectable under trade dress or copyright). *See Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 29 (U.S. 2001) ("A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional.")

Some well-known registered trade dress examples that overlap with issued design patents include the Apple iPhone®, the Dustbuster® vacuum cleaner, the glass Coca Cola® bottle, and the Moen® Legend faucet design. The design patent and registered trademark for one of the iPhone designs is shown on the next page.



Apple iPhone (U.S. D618,677 and U.S. Trademark Serial No. 77303256).

Similarly, some examples of litigated copyrights that were also protected by trade dress include the 1966 Batmobile (s*ee DC Comics v. Towle*, 802 F.3d 1012, 1077 fn. 9 (9th Cir. 2015), and slot machine key rings (*see* SHC Holdings, LLC v. JP Denison, LLC, 2020 U.S. Dist. LEXIS 47391 (D. Nev. March 19, 2020).)

In deciding whether to pursue multiple avenues of protection, some of the considerations include the following:

- What is the expected lifetime for the design? A design patent is valid for 15 years from the date of issuance, which may be sufficient for most designs (for example, most consumer electronics are obsolete or fall out of fashion well before that time expires). Trade dress, meanwhile, can last for as long as the trade dress is being used as an indicator of source, making it particularly appropriate for "iconic" designs that are expected to last the test of time (for example, the Coca Cola® or Jack Daniels® bottles).
- What is the risk that the design will be copied? If the industry is one where "look alike" products are prolific (e.g., counterfeit goods or imitators trying to latch onto a trendy or fashionable product), then seeking multiple avenues of protection may be worthwhile.
- What is the cost the company is willing to expend in obtaining and enforcing the rights? Trade dress infringement can (unless the item is a very close copy) be complex and require survey evidence to show a likelihood of confusion compared to a patent case. Moreover, design patents require a formal examination process that can take 1-2 years to navigate, a trademark registration for a mark involving potentially functional features may take years of prosecution, while copyright applications are comparatively less expensive, with an average processing time of 1.9 months, and slightly longer if correspondence is required.

Conclusion

While many lay people have a vague idea that it is unlawful to "copy" the design of a product (e.g., imitation design handbags or shoes), there are in fact several different ways to protect a product's design, each with their own advantages and disadvantages. Depending on the nature of a product's design, including whether it is more functional or more decorative, a product design may be most appropriately protected by design patents, trade dress, or copyright law.