

United States

Lewis Roca Rothgerber Christie LLP

How to determine the best form of protection for a product's appearance

Trade dress may be the go-to choice for protecting a product's appearance or configuration, but other IP rights have plenty to offer

When a company wants to protect the appearance or configuration of a product, trade dress IP protection immediately comes to mind. Although this is sensible, other types of protection – namely, copyright and design patents – can each provide their own unique advantages and should be considered as well.

Trade dress: perpetual protection

Trade dress rights provide protection for a product's appearance and configuration when those attributes have come to identify its source. What is more, the range of attributes that such rights cover is extremely broad. Colour, sound and even smell can all be protected as a trade dress. However, these rights are difficult to obtain and provide limited remedies for enforcement. In the case of product configurations (ie, the shape or design of the product, rather than its packaging or layout), trade dress is not considered to be inherently distinctive; thus, it can only be registered upon proof of secondary meaning (ie, that the relevant public has come to associate that shape, colour, sound or smell as originating from a single source only). Red-soled shoes are made by only Louboutin. Green-gold dry-cleaning press pads are made by only Qualitex. Moreover, common law trade dress rights can be enforced only upon a showing of secondary meaning. Unlike other forms of product protection, trade dress considers the product's appearance or configuration as a whole, meaning that a smaller sub-set of the presentation may not be protectable as trade dress.

The most frequent outcome of trade dress litigation is injunctive relief. Unlike patents and copyrights, some US courts hold that the irreparable harm required as a prerequisite for an injunction is automatically found upon a finding of

trademark infringement. This is because it is difficult to quantify the damage that can be inflicted on a business's reputation as a result of such infringement. Moreover, trademark law has a consumer protection component to it, and US courts are often concerned about consumers not receiving the products or services that they expected. Although monetary damage awards in trade dress litigations are rare, that might change in light of the Supreme Court's recent decision in *Romag Fasteners Inc v Fossil Inc* (18-1233 (23 April 2020)), which held that a finding of wilful infringement was not a prerequisite to an award of an infringer's profits. This decision overturned the prevailing case law in a number of jurisdictions, including the Second, Eighth, Ninth, Tenth and District of Columbia Circuits.

Awards of attorneys' fees are even rarer. Under the Lanham Act, awards of attorneys' fees are limited to "exceptional" cases only. However, if the infringing use of the trade dress rises to the level of a 'counterfeit' and the plaintiff's trade dress was registered before the alleged infringement, the plaintiff may potentially receive treble damages or up to \$2 million in statutory damages. Still, not every infringement is a counterfeit. A 'counterfeit mark' is defined by statute as "a non-genuine mark identical to or substantially indistinguishable from a mark that is in use and registered on the USPTO's principal register for the same goods and services".

Another benefit of trade dress rights that all other forms of IP rights lack is the potentially infinite duration of protection. Trade dress rights last as long as the trade dress is not abandoned or does not become generic. Trade dress registrations can be registered with US Customs.

Copyrights: not just for books and music

If an aspect of the appearance of an object is separable from its utilitarian purpose (eg, a figure of a dancer that is used as the base of a lamp), it can be protected under copyright law. This comes with a number of advantages. First, a copyright is not something that rights holders have to apply for in order to obtain. Copyright protection vests as soon as a work is embodied in a tangible medium of expression. That said, a copyright owner that wishes to file suit for copyright infringement must file for a copyright registration and obtain a decision regarding the registration from the Copyright Office before filing suit against an alleged infringer. However, the Copyright Office does not need to grant the registration before the plaintiff files suit. If the office rejects the registration, the plaintiff bears the burden of proving that the work is copyrightable and owned by the plaintiff during the course of the litigation.

Remedies for copyright infringement are also powerful. If the copyright owner obtained registration for the disputed product before the alleged infringement

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Design patents are generally much easier to prosecute than utility patents



occurred, it might be entitled to an award of attorneys' fees and up to \$150,000 per copyrighted work that has been infringed. Copyright owners can also register their copyright with US Customs. This allows customs agents to seize infringing goods as they are being imported into the United States.

Until recently, copyright law was used only for product configuration protection in extreme cases, such as the aforementioned dancer lamp. However, the Supreme Court's recent decision in *Star Athletica v Varsity Brands* (137 S.Ct 1002 (2017)) has broadened copyright protection for works of art that are incorporated as a feature into a useful article. Such a feature is eligible for copyright protection if it:

- can be perceived as a 2D work of art, separable from the useful article; and
- 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.

Now, following *Star Athletica*, patterns beyond simple stripes have been registered at the Copyright Office. Even stitching and colour pattern combinations on shoes such as the Yeezy Boost 350 and Yeezy Boost 350 V.2 have been granted registration. The copyrightable combinations, as described by the office, consisted of "irregular black lines of various lengths and shapes on a grey fabric with a black semi-circle in the arch and an orange dotted stripe on an off-white heel loop" in the case of the original and "several grey lines in a wave pattern with a thick orange stripe on the outsole that fades toward the heel" with an inner orange layer that adds "intermittent orange coloring" in the case of version two.

The duration of copyright protection lasts for the lifetime of the author plus 70 years or, in the case of a corporate author, 120 years.

Design patents

Design patents are one of the more obscure forms of protection available for products, but arguably one of the most powerful.

Design patents protect the ornamental features of a product and can protect a



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much smaller sub-set of a product, which might not be otherwise copyrightable or protectable as trade dress, absent extraordinary evidence of secondary meaning. As an example, design patent protection has been obtained for a single, small, pill-shaped divot in the side of a vehicle wheel – which is not something that would likely be copyrightable or protectable as trade dress. In the same way, a design patent could be used to protect the pattern of a wheel tread.

Design patents are generally much easier to prosecute than utility patents and are far less expensive. They lack a substantive specification, other than drawings, and contain a single claim: "The ornamental design for [a widget], as shown and described."

Design patents last 15 years from the date of issuance and – unlike trademarks and utility patents – require no maintenance fees. Savvy rights holders will use this 15-year exclusivity period to establish the required secondary meaning for trade dress rights once the design patent has expired. This allows some form of protection to continue indefinitely.

Damages awards are much easier to obtain for design patents. Once infringement

has been found, the design patent owner can choose to recover the infringer's profits, which can be substantial. In the recent billion-dollar *Apple v Samsung* litigation, most of the damages award was for the infringement of Apple's design patents. As with copyrights and trade dress rights, the design patent owner may also obtain equitable relief in the form of an injunction. On the horizon is a new bi-partisan bill that would allow design patent owners to register their patents with US Customs, just like a trade dress or copyright registration.

What is best for me?

The obvious question of "What is best for me?" depends on the product appearance or configuration that needs protection. If it is the overall aspect of the product, then a combination of copyright, trade dress and design patent will provide maximum protection. If it is a small feature of the product, a design patent could be the only way to go. Alternatively, if it is a characteristic of the product such as its colour, smell or sound, then trade dress is likely the only option. Regardless of what you want to protect, using all available tools at your disposal is critical to protecting your rights. **WTR**