



# DESIGN MATTERS

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Using Patents, Copyrights and Trade Dress to Maximize  
Protection of Industrial Designs

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**April 24, 2019 In-House Counsel Conference**

# Presenters:

- John Hemmer, Morgan Lewis
- Ken Davis, Morgan Lewis
- Rachel Fertig, Morgan Lewis
- Kate Eary, Gentex Corporation

# Overview

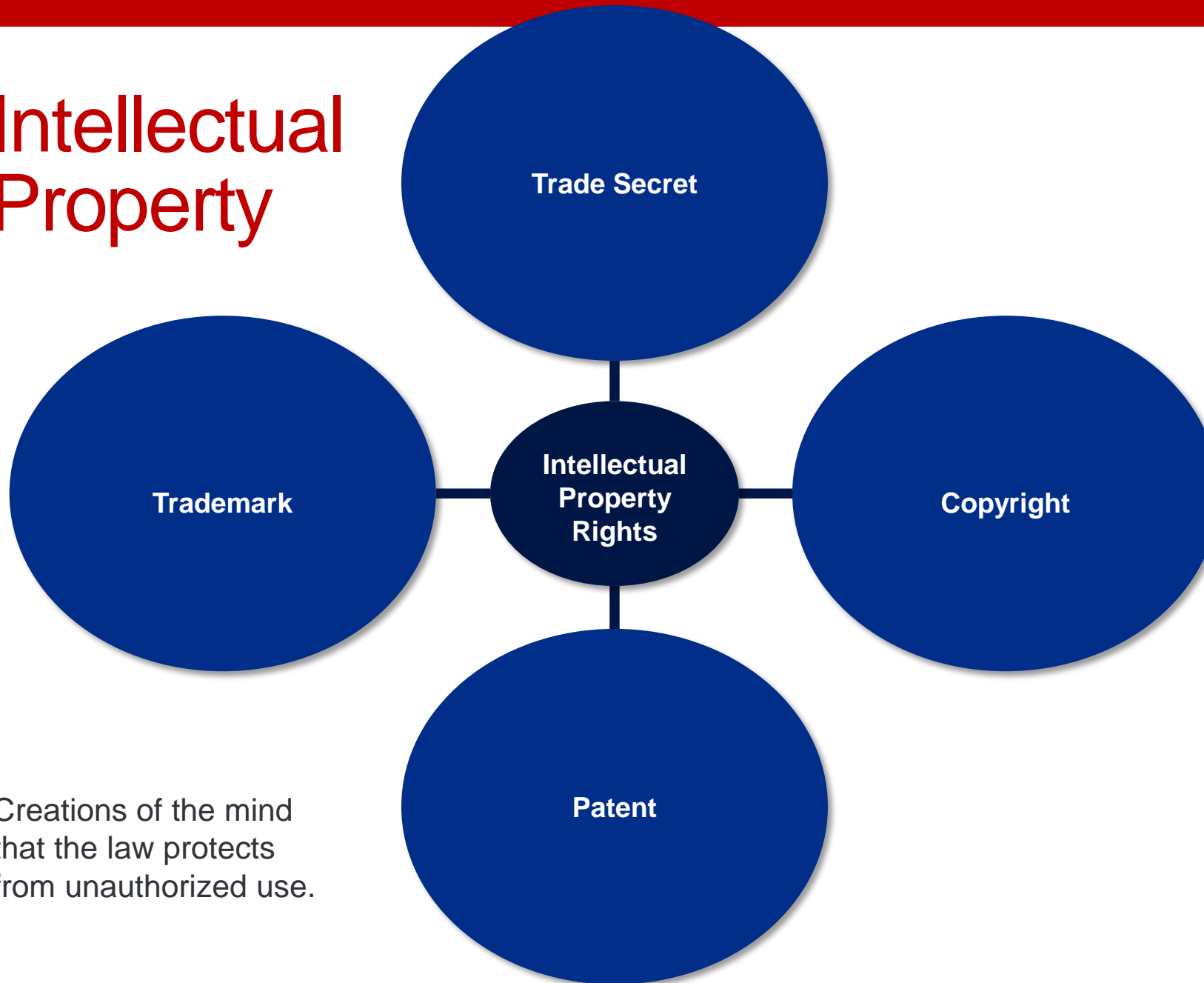
- Industrial design overview
- Intellectual property background
  - Design patents
  - Copyrights
  - Trade dress
- Recent changes in the law
- In-house considerations
- Protecting a hypothetical design

# Industrial design

- Industrial design is the process of applying ornamental design to useful articles of manufacture

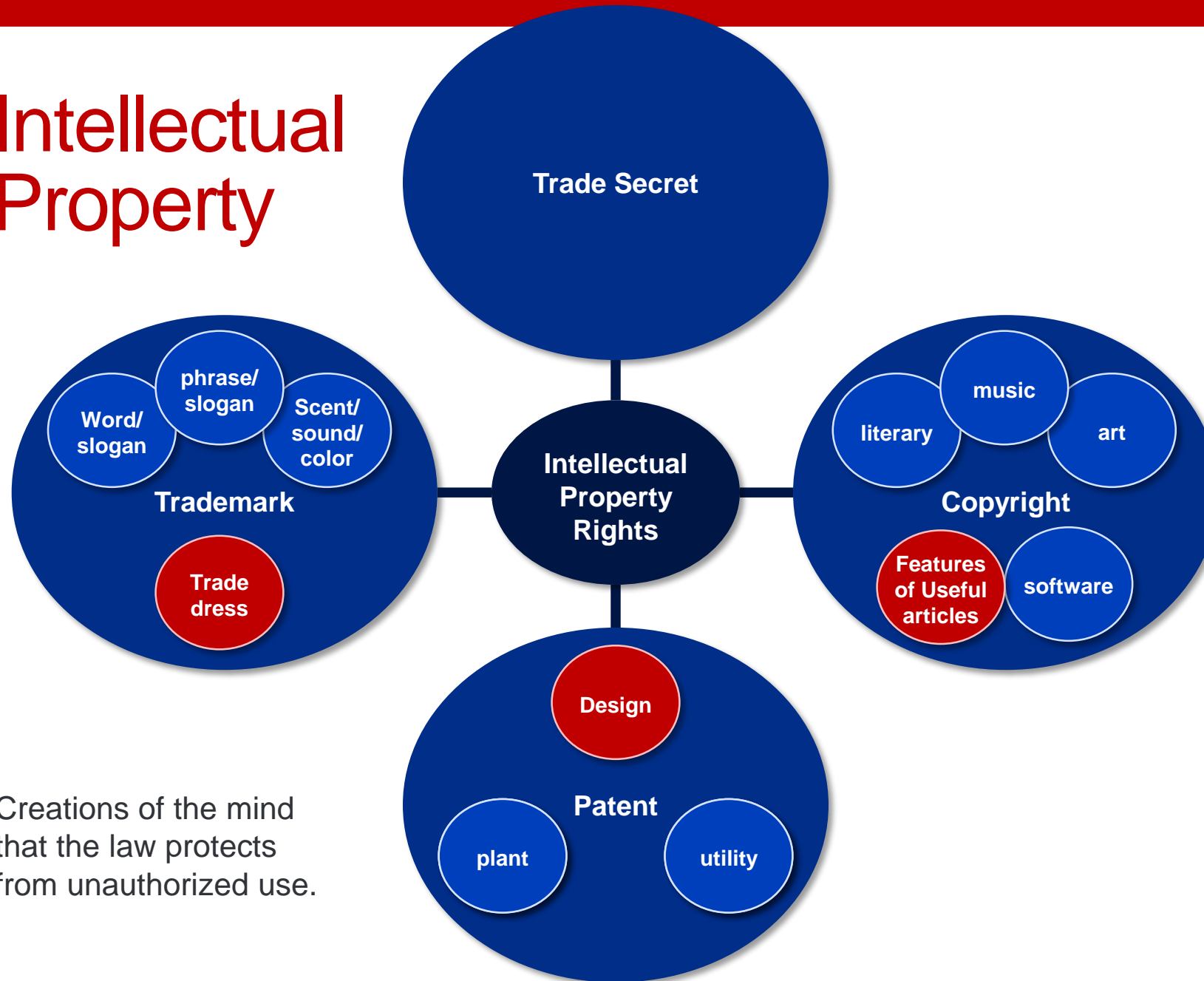


# Intellectual Property



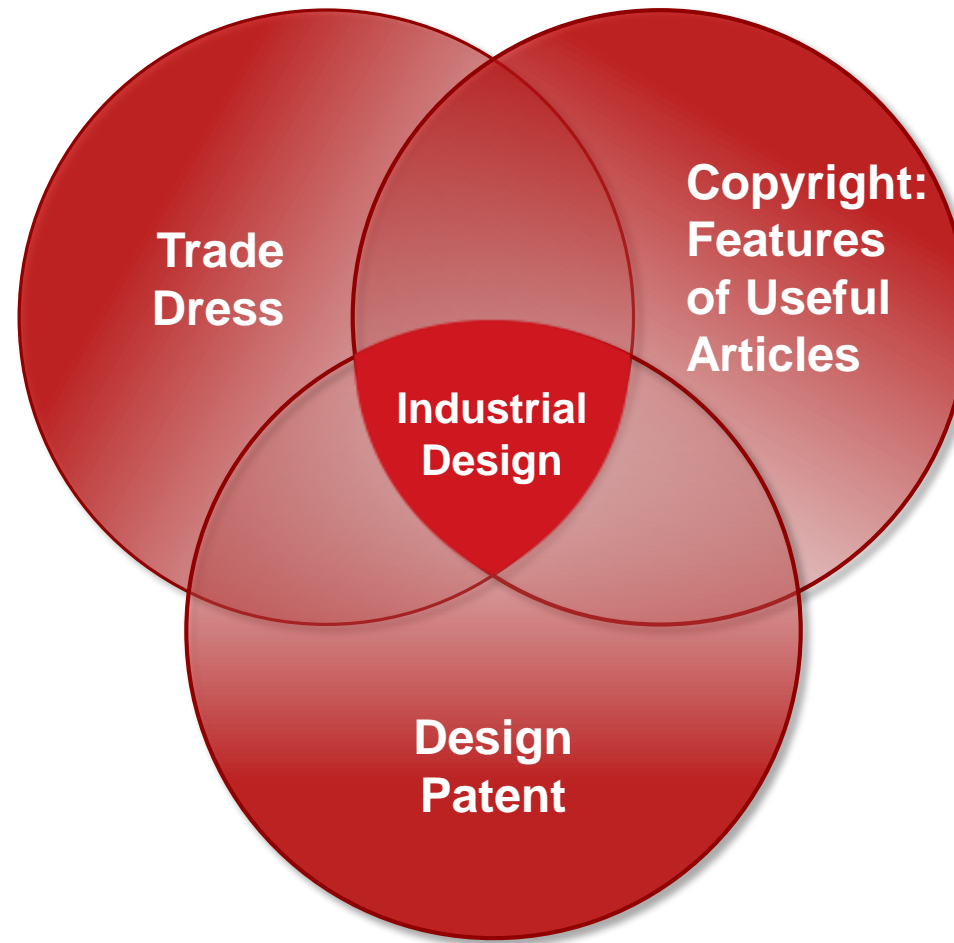
- Creations of the mind that the law protects from unauthorized use.

# Intellectual Property



- Creations of the mind that the law protects from unauthorized use.

# Intellectual Property



# Design patents

- Protects ornamental features of a useful article
- Referred to as industrial, community, or registered designs outside the U.S.
- Protection rights are defined by the drawings
- Registration is required
- Foreign priority filing deadline is 6 months from first filing
- Domestic priority can be claimed in the U.S. to utility applications but not provisional applications
- Average time to registration is 1-2 years
- Term – 15 years from grant (14 years for patents filed before 5/13/15)
- Ownership – resides with the inventor unless contracted to otherwise
- Infringement standard is Ordinary Observer test
- Injunctions/damages



# Copyrights

- Protection for any original work of authorship fixed in any tangible medium of expression (e.g., writing, website, photograph, recording, painting, sculpture)
- Can use © at any time
- Registration is helpful for enforcement purposes/required for litigation
- Does not protect against independent creation
- Average time to registration is a few months to less than 1 year with appeal
- Term – life of the author plus 70 years, works made for hire are protected for the shorter of 95 years from the date of first publication, or 120 years from the date of creation
- Ownership – generally, the author is the creator of the work and owns the copyright except for “works made for hire”
- Infringement standard is substantial similarity
- Injunctions/damages

# Trade dress

- Protection for design that helps to identify the source of a good
- Protects supplier and consumer
- Registration helpful for enforcement purposes but not required
- For registration purposes, secondary meaning is usually established by evidence of 5 years of substantially exclusive use
- Average time to registration is 1-2 years
- Term – can last forever
- Ownership – in name of applicant
- Infringement standard is likelihood of confusion
- Injunctions/damages

# Recent developments

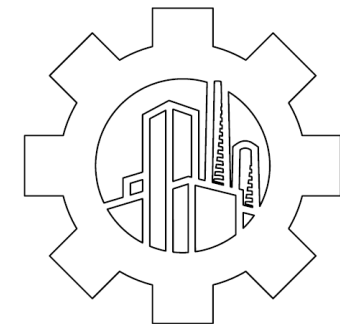
- Design patents
  - Functionality
  - Prosecution history estoppel
  - Written description
  - Partial designs
- Copyrights
  - *Star Athletica* and protection for useful articles
  - Registration for enforcement
  - Updated registration practices and regulations

# In-house considerations

- IP strategy
- Internal engagement
- Timing for filing
- Internal tracking
- Ownership
- Authorship/inventorship
- Support for infringement notices
- U.S. Customs and Border Protection
- Marking
- Freedom to operate

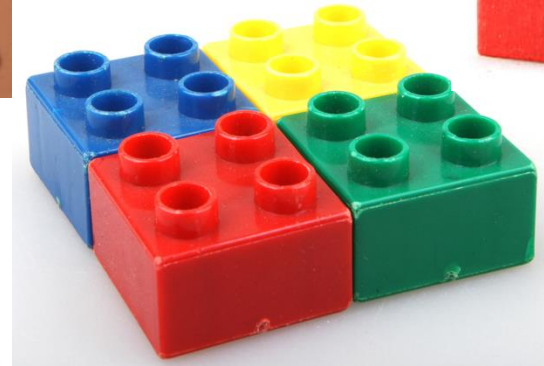
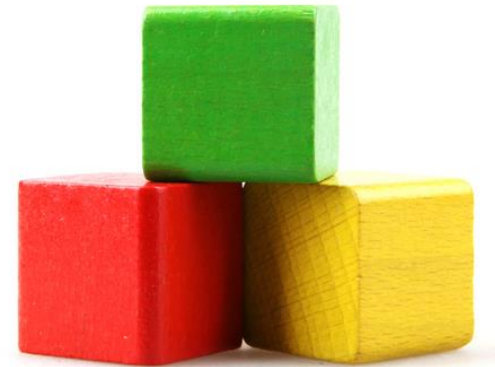
# Hypothetical case study

- Article3 Bike Helmet

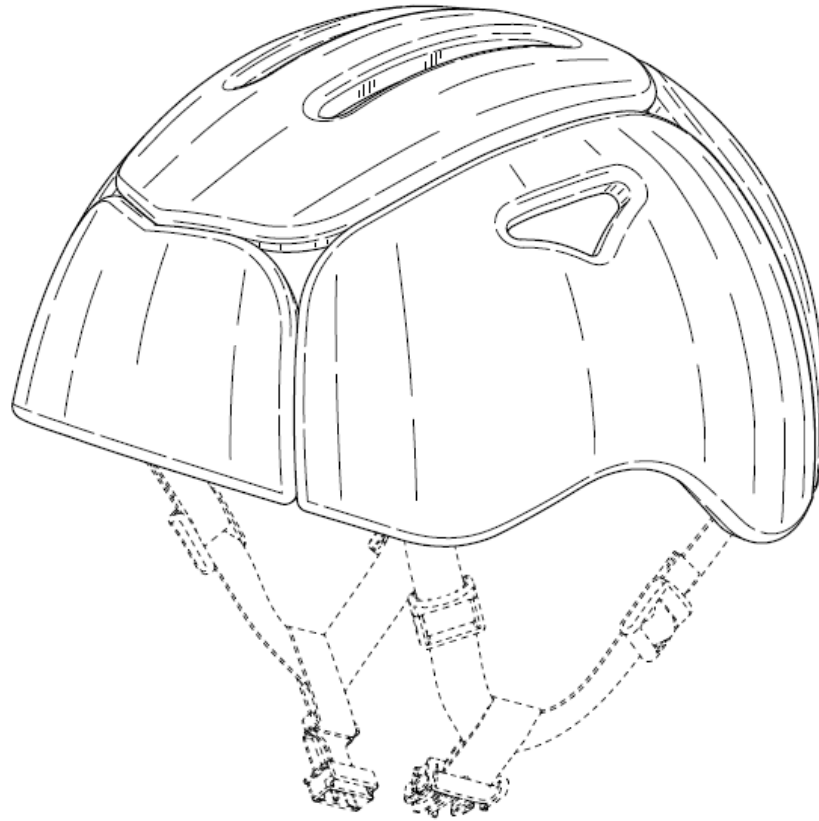


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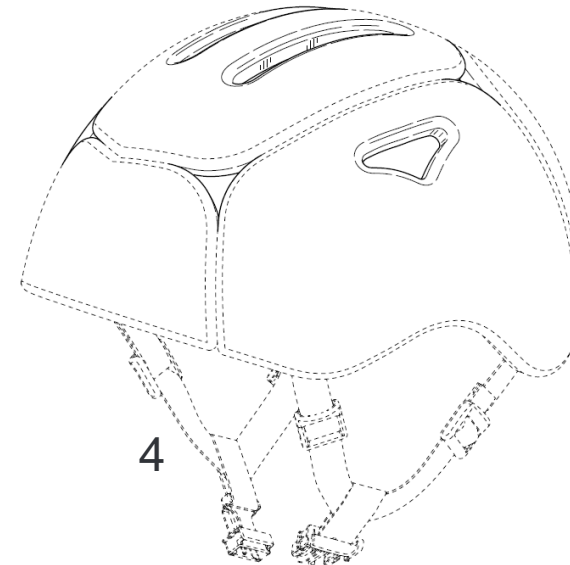
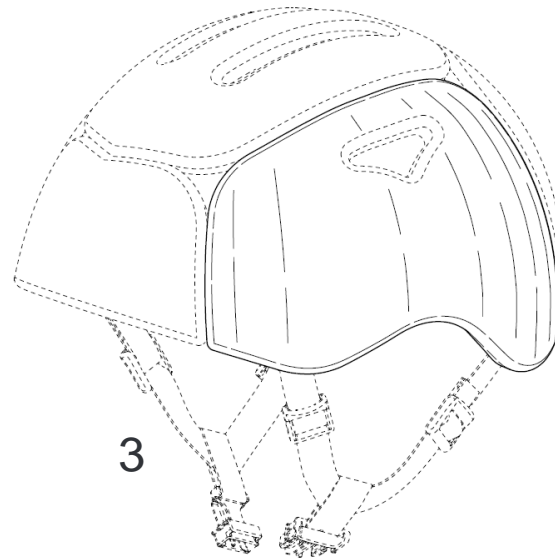
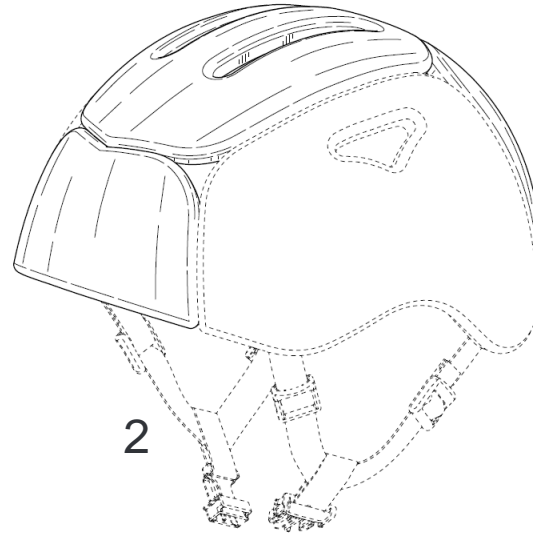
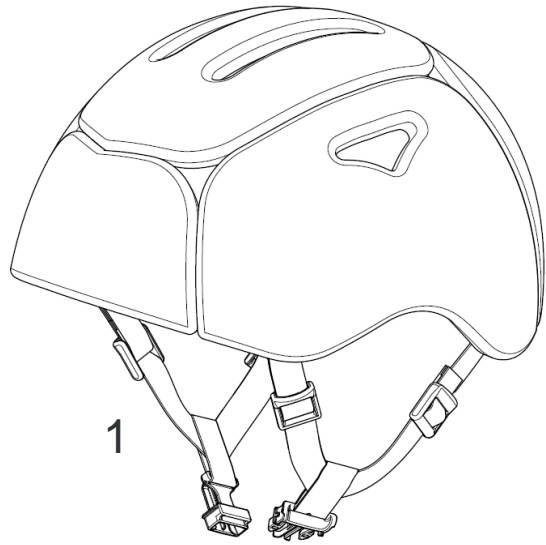
# Article3 Helmet Inspiration Board



# Article3 Helmet Design Patent

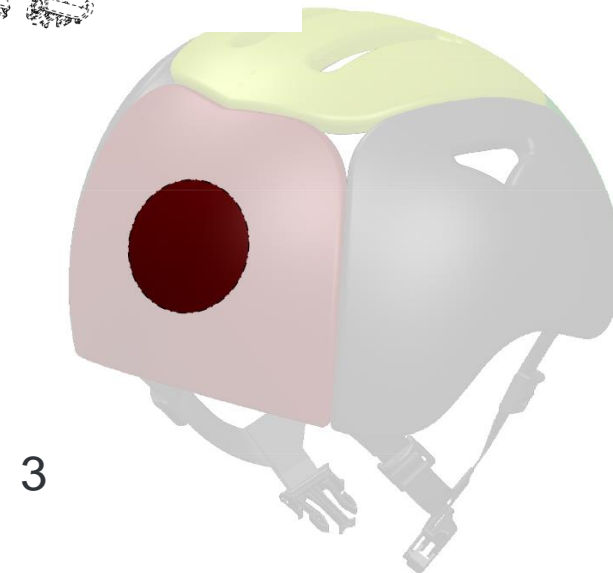
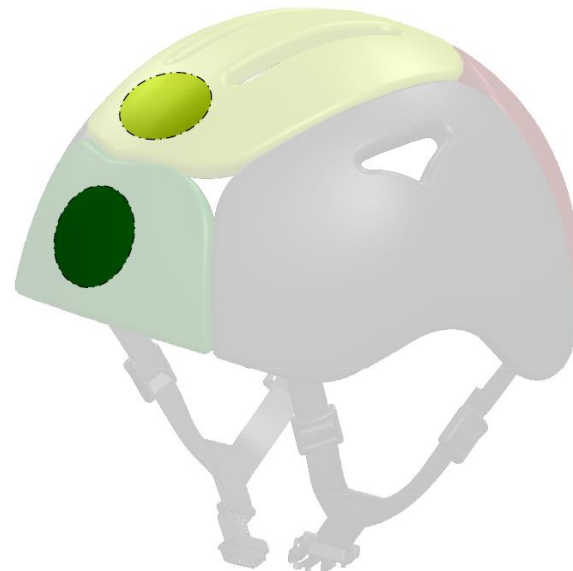
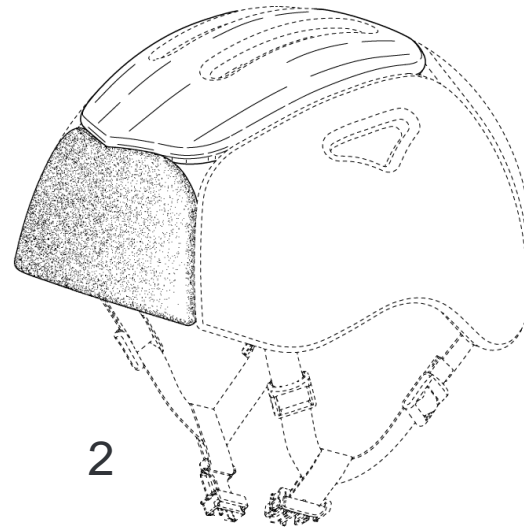
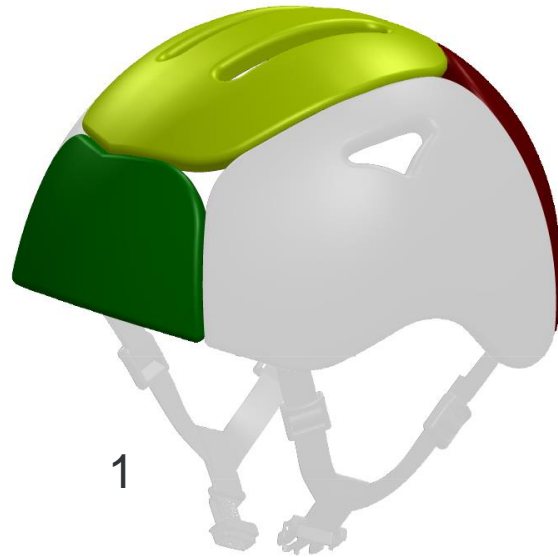


# Design patent claiming strategy





# Design patents and color



# Article3 Helmet Copyrights

Separable Features of Useful Article:

- 2-Dimensional Artwork
  - Graphic designs
  - Photographs
  - Patterns
- 3-Dimensional Artwork
  - Carvings
  - Sculptures



\*Useful Article as such is NOT protectable\*

# Article3 Helmet Copyrights

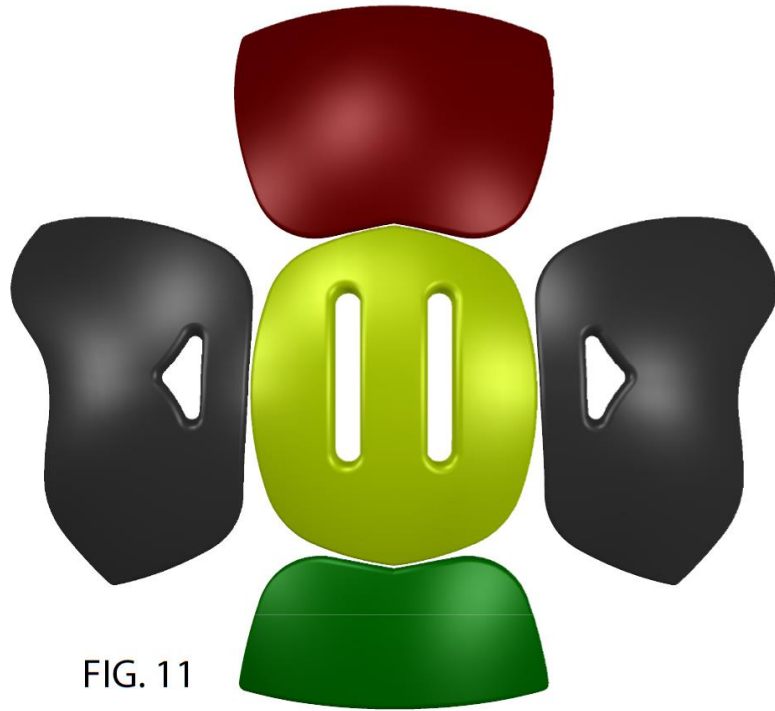
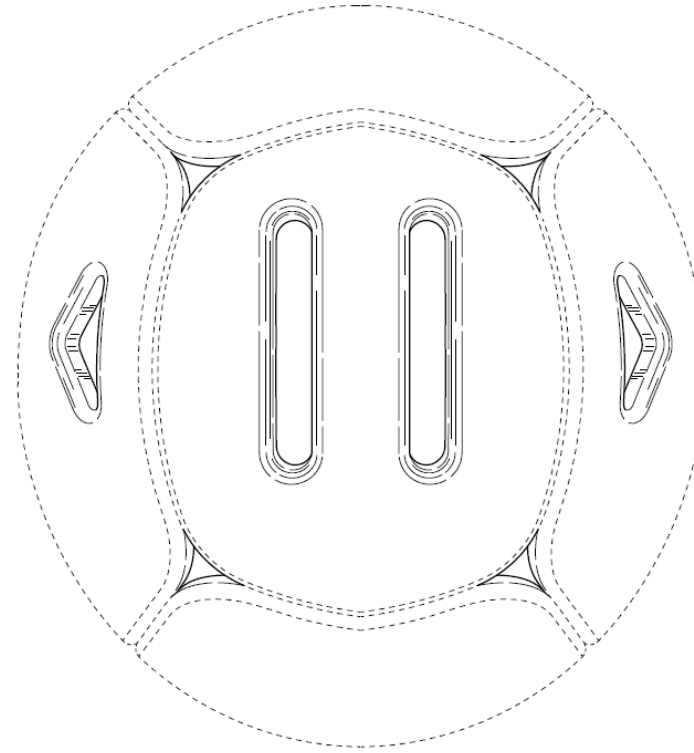


FIG. 11



# Article3 Helmet Copyrights

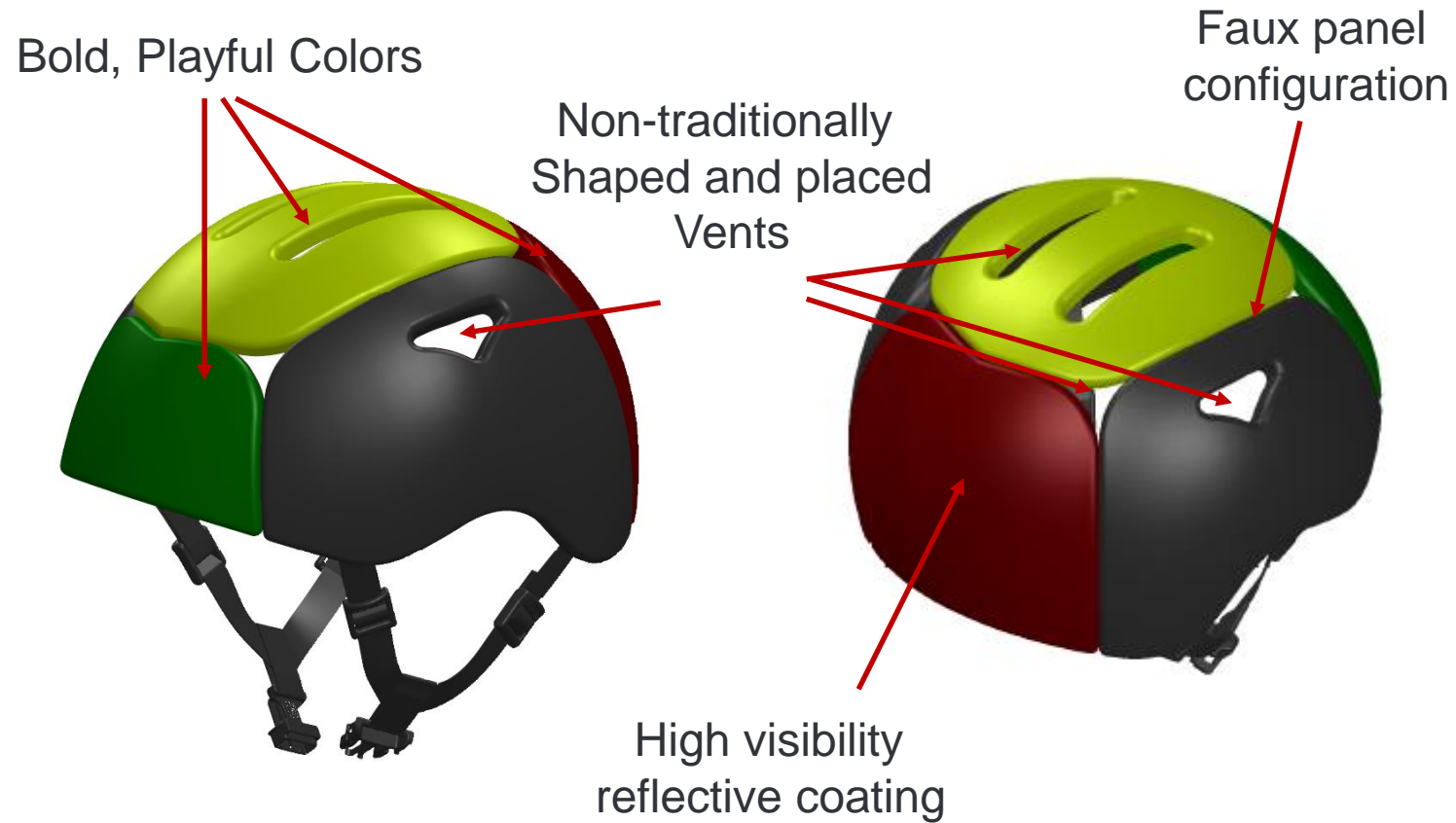
- Originality threshold is “extremely low”

BUT

- Minimalist design is difficult to register because copyright does not protect:
  - Standard shapes
  - Familiar symbols
  - Font
  - Single color



# Article3 Helmet Trade Dress



# IP Infringement?

Mimic Helmet



# Copyright and trade dress infringement

Article3 Helmet



Mimic Helmet

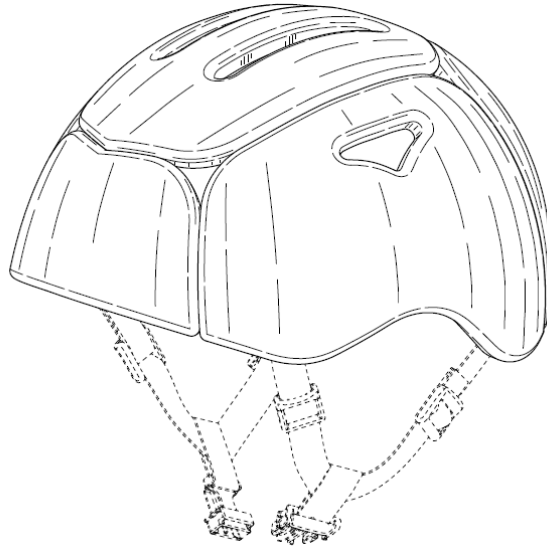


# Design patent infringement - scenario 1

Prior Art



Our claim



Mimic Helmet



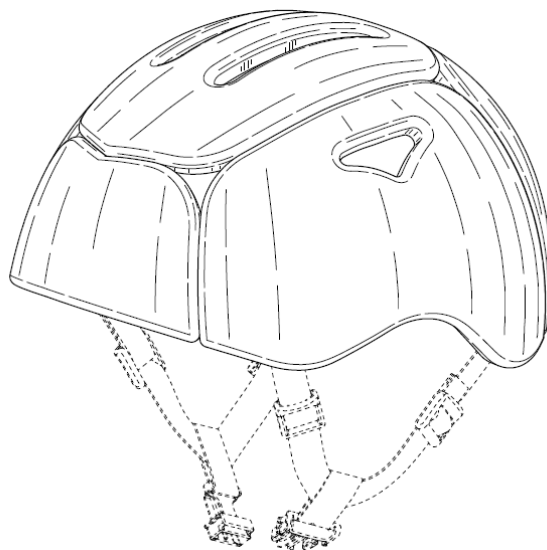


# Design patent infringement - scenario 2

Prior Art



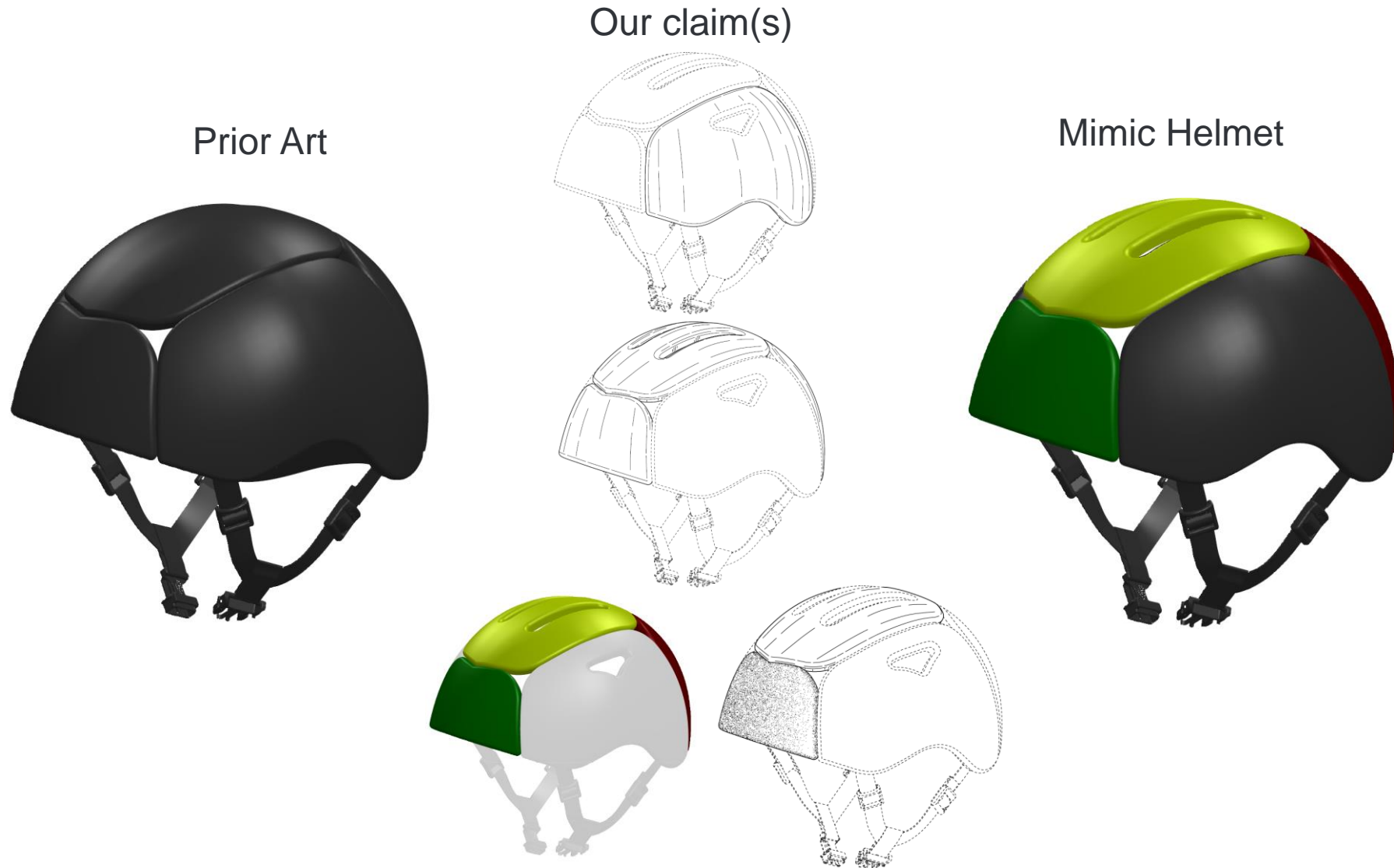
Our claim



Mimic Helmet



# Design patent infringement - scenario 3



Questions?

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