DESIGN PROTECTION UNDER PATENT, TRADEMARK AND COPYRIGHT LAW*

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***** There have been changes in the law since 1994 and some particulars herein (such as the terms of protection) are no longer current; however, the general information remains valid.

Patents, trademarks and copyrights afford inventors, trademark owners and authors, respectively, protection for their technological and creative assets. To protect a unique design for use as, with or on a product, it may be appropriate to obtain each of, or some combination of, a design patent, federal trademark registration or copyright registration.

Scope and Duration

A design patent will be granted to anyone who invents any new, original and ornamental design for an article of manufacture.[1] The term of a design patent is fourteen years.[2]

A trademark includes any word, name, symbol or device, or any combination thereof, used in interstate commerce by a person to identify and distinguish his or her goods, including a unique product, and to indicate the source of the goods.[3] A trademark endures as long as it is continually used and statutory and trademark law requirements are met.

Copyright protection exists in original works of authorship fixed in any tangible medium of expression from which they can be perceived, reproduced or otherwise communicated. The works of authorship pertinent to this discussion are pictorial, graphic and sculptural works[4]. The term of a copyright is for the life of the author plus fifty years for individual works[5] and seventy-five years from the date of publication or 100 years from the date of creation of the work (whichever expires first) for anonymous works, pseudonymous works or works made for hire.[6]

Generally, it has been held that patent, trademark and copyright law are separate and independent forms of protection. Therefore, the presence or absence of one form of protection for a design does not preclude protection under another, and the expiration of the term of one form of protection does not end the term of another.

Patent Versus Trademark

Design patent law protects new and original ornamental designs for articles of manufacture against the infringing appearance of another article and allows the patent holder to exclude others from making, using or selling the article during the term of the patent.[7]

Trademark law protects identifying symbols for products and is intended to prevent the likelihood of consumer confusion, mistake and deception as to the source of the product. For a product design to be registered as a trademark, the product design must be arbitrary or inherently distinctive, or shown to have become distinctive through the acquisition of secondary meaning.[8] In addition to a design patent, a trademark registration is also appropriate for a product design that serves to identify and distinguish the source of the product.

Assuming there is no statutory bar with regard to public disclosure,[9] a prior trademark or copyright registration will not bar a design patent if the requirements for each form of protection are met. The converse is true with regard to trademarks, but not with regard to copyrights, as discussed below.

Patent Versus Copyright

Copyright law gives the author of an original work the right to prevent others from copying, in any medium, his or he copyrighted work.[10] A copyright protects the copyrighted work only from copying by others and not from use by others.

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Currently, the law provides that either a copyright registration or a design patent may be obtained for a design, provided it meets the requirements of the particular area of law. At best, both a copyright and a design patent may be obtained if the copyright registration is obtained prior to the design patent. An issued design patent bars a registration for a copyright claim to the design, even though the potential availability of protection under the design patent law will not affect the registrability of a pictorial graphic or sculptural work.[11]

Copyright Versus Trademark

To be registered as a copyright, a design must contain the requisite amount of creativity and originality to be protected under copyright law. A design is no less copyrightable because it is used as a trademark.

There is nothing in copyright or trademark law that bars this situation, nor does there appear to be any aspect of the law which would dictate that a copyright registration would bar a trademark registration or vice versa. As long as a design has copyrightable subject matter, it may be registered as both a trademark and a copyright.

Expiration of the term of the copyright for a design will not bar a claim for trademark protection of the design, provided the design is in use as a trademark. Furthermore, it has been held that trademark protection beyond the copyright expiration does not extend the copyright.[12]

Conclusion

If a design meets the requirements of and, thus, may be protected by a combination of a design patent, federal trademark registration or copyright registration, each form of protection that applies to the design should be pursued. During the application and registration process, the pitfalls of acquiring a copyright registration prior to a design patent and disclosing the design to the public with a trademark or copyright registration that may render the design ineligible for a design patent should be avoided. With this strategy, the design protection acquired may outlive the design.

NOTES

1. 35 U.S.C. § 171 (1991).
2. 35 U.S.C. § 173.
3. 15 U.S.C. §1127.
4. 17 U.S.C. § 102(a).
5. 17 U.S.C. § 302(a).
6. 17 U.S.C. § 302(c); 17 U.S.C. § 101 (a work made for hire is a work prepared within the scope of employment, or specially ordered or commissioned and which is expressly agreed to be a work made for hire).
7. 35 U.S.C. § 271(a).
8. Secondary meaning is consumer association of the particular product design with a particular source.
9. 35 U.S.C. § 102(b).
10. 17 U.S.C. § 106.
11. 37 C.F.R. § 202.10(a).
12. *Tempo Communications, Inc. v. Colombian Art Works, Inc.*, 223 U.S.P.Q. 721 (N.D.Ill. 1983.