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# IP INSIGHTS

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## *Product design*

### Protect the design of valuable intellectual property

By Lydie Arthos Hudson and David R. J. Stiennon

The distinctive design of a product provides a powerful competitive advantage.

The squat orange bottle of Tide screams for attention from the grocery market shelf, while the blue and white boxes of other laundry detergents stand by complacently. Design can sell everything from kitchen faucets and lawn ornaments to restaurants and jewelry.

The first step to securing a competitive advantage is the creation of a design that catches and keeps the buyers' eye. The second step is the selection of the appropriate legal means to establish exclusive rights to the design. The second step is just as necessary as the first to maintain a competitive advantage. Only legal protection will preclude copycats from eroding an exclusive position in the marketplace.

A design can be protected under copyright, patent or trademark law. The appropriate kind of legal protection is determined by the kind of design and the owner's goals. Therefore, it may be prudent to consult with a lawyer to devise the best strategy.

General considerations include:

■ **Copyrights.** A copyright protects the artistic design of a useful article. Jewelry, designs printed on clothes, and a ceramic dog in the "show" position all fall into this category. Copyright protection is available only if the design can be separately identified from, and is capable of existing independently of, the useful article. For example, with a pitcher in the shape of a cow, the particular shape of the cow

can be copyrighted, but not the functional elements of the pitcher's spout or handle. Some intellectual effort to create the design is also required. The advantage of copyright protection is the duration of the copyright term—in general the life of the author plus 50 years—and the nominal cost of filing for copyright registration.

■ **Patents.** A product with a new appearance may be protected for 14 years by a design patent. Design patent protection can also be obtained for specific parts of a product, such as the sole of a running shoe. Although some ornamental products may be covered by copyright, a design patent can cover products that are not copied from, or identical to, a patent owner's product. In this regard, design patents differ from trademarks. Trademark registration requires that the design not be confusingly similar to an existing product. However, to qualify for a design patent, the design need only be new and nonobvious. In addition, while a trademark application may be filed at any time (even decades after the introduction of the product), a design patent application must be filed within one year of the product's first offer for sale or public disclosure. Obtaining a design patent will generally cost several thousand dollars, although the cost may be comparable to or less than that of obtaining a product configuration trademark. Sometimes, the appearance of a product can be protected with a utility patent. For example, the new and useful shape of a pour spout for a laundry detergent bottle; the economical shape

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of a paperboard package; or the easy-to-open features of a thermoformed clamshell package. Utility patents offer protection for up to 20 years from the filing date, and can prevent competitors from introducing products or packaging with similar functions but different appearances.

- **Trademarks.** A trademark functions as the return address on an envelope. It indicates where the goods came from. The distinctive shape of a product may be trademarked. For instance, the shape of Hershey's Kisses® chocolate candy is a registered trademark. No one else can use this shape for chocolate candy morsels as long as Hershey is using it. The right established through use alone is referred to as a "common-law trademark." The U.S. Supreme Court recently ruled that in order to prevent others from infringing on a common-law trademark in a product design, it must be shown that consumers perceive the design as "your return address." The shape of the Hershey's Kisses candies makes it clear that the Hershey's Food Corporation made it. However, this is a difficult standard of proof to meet. Copyright and patent protection may be better options. A right in a trademark may also be formalized by registering the

trademark through the U.S. Patent and Trademark Office. The cost of registering a trademark is considerably less than that of filing for a patent. In addition, the term of a trademark is perpetual—it lasts as long as the owner is using it. However, some commentators believe that the U.S. Supreme Court decision referenced above may now require proof of consumer identification with a product design before permitting registration of the design with the U.S. Patent and Trademark Office.

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