

Sheldon Mak Rose Anderson

DESIGN PATENTS: PROTECTING AGAINST KNOCK-OFFS

by
Sheldon Mak Rose & Anderson

Design Patents can provide a potent weapon against knock-offs. A knock-off is a term used to describe a product, usually a consumer product, which is a clear copy of a successful and popular product. It is a product which is usually made inexpensively, often because of the ability to simply reverse engineer the product, or in extreme situations, make a mold from the original and produce copies from the mold. Often the products are manufactured inexpensively in foreign countries.

Different Techniques for Product Protection

The spectrum of protection available for new products includes utility patents, design patents, copyrights and trademarks. Whereas utility patents are generally directed to the functional aspects of the product, design patents are directed to the ornamental features.

While copyright protection can be available, difficulties often arise in meeting the requirements of the copyright statutes, for their to be copyright protection in a useful article it is necessary that sculptured or pictorial features of the article be separable and independent of the utilitarian aspects of the articles.

Trade dress protection can also be available. This is a form of trademark protection available principally for the non-functional features of an article. This form of protection usually requires proof of secondary meaning. A product configuration has secondary meaning when its appearance serves as a source of identification, i.e. The Traditional Coca-Cola bottle. Secondary meaning takes time to develop, and often a new product cannot achieve this before the knock-offs arrive on the scene.

Rarely is the product a counterfeit since the copier does indicate a different source from the original product.

Design Patents

Apart from the utility patent remedies, and possible copyright remedies and trade dress remedies, the product designer can turn to design patents. Design patents in the U.S. in many respects are similar to industrial designs internationally.

Resort to design patents is increasingly being found to give effective protection against knock-offs of the product. In the consumer products field, an inventor can be placed in a position to act quickly and decisively to protect a new product.

Design patents have traditionally been considered as narrow in scope. It is now however being realized that design patents have a unique value which is particularly valuable for consumer products. Recently several cases relating to the shape and appearance of the upper and outsole of tennis shoe footwear have illustrated the effectiveness of design patents. These are the two decisions of *L.A. Gear v. Thom McAnn Shoe Co.*, 12 U.S.P.Q. 2d 1001 (S.D. N.Y., 1989) and *Avia Group v. L.A. Gear*, 853 F.2d 1557, 7 U.S.P.Q. 2d 1548 (fed. Cir. 1988). Design patents for the distinctive shoe upper and the distinctive outside design were effectively enforced against infringing knock-off products.

Obtaining the Design Patent

Design patents are decidedly less expensive to procure than equivalent utility patents. Although U.S. design patents usually take about 2 to 3 years to prosecute, this time period can be significantly reduced to between about 6 months and 1 year. This is achieved by the filing of a petition to expedite in the Patent Office. Many

consumer products have a life span of only 2 to 5 years and by the expediting the examination process, the inventor is quickly put in a strong position to enforce the design patent rights at relatively little cost.

Commercial Effectiveness

Consumer product marketing analysis shows that copyists usually try to capitalize on the product precisely as initially developed. This is often achieved by carbon copying or reverse engineering the successful product.

By obtaining a design patent in a short time frame, the designer is in a strong position against the defendant just when the infringing knock off items enter the marketplace. Between the time of the introduction of a consumer product and its full absorption into the marketplace, there may be a 6 month to 1 year time lag. This is the same time frame needed to obtain an expedited design patent. The patentee is thus often in possession of enforceable rights precisely at the time when the copyist has the fullest inventory of infringing or knock-off product.

Effective Judicial Enforcement of Designs

Since the creation of the Federal Circuit in 1982, many of the tenets of patent law which were previously pro-infringer have now switched strongly in favor of the patentee. Although much of the judicial law has developed around utility patents, design patent protection can capitalize on this judicial change.

As such, the courts are coming to the aid of design patent holders. Preliminary injunctive relief is increasingly available for design patent infringement. Since the prerequisites for a preliminary injunction are often easily met, judges do not have difficulty in granting relief. For instance, after patent grant by the Patent Office, there is the presumption of validity of the design patent that needs to be overcome by "clear and convincing" evidence. Also when there is a knock off item there is a clear infringement. This essentially is sufficient to establish the basis for relief. It does not take much for a judge to compare a design patent document and drawing with an infringing item and reach a conclusion without expert technical evidence. For these same reasons summary judgment is also easier to obtain than in utility patent suits.

Superimposed on these benefits is the potential risk that a defendant may be liable for attorney's fees and treble damages. This can arise for willful infringement. Also, a design patent holder can recover the infringer's total profit in addition to the patentee's damages. There is thus a significant disincentive to infringe design patents.

Design Patents in the Future

Inventors and creators will likely increasingly use this technique to bolster their intellectual property protection. Automobile manufacturers such as those from Japan, are now regularly protecting the ornamental features of their automobile designs by this technique. This will require auto repair shops to purchase replacement bumpers and the like only from the manufacturer.

Increasing use of design patents is likely in future years. In the continuing drive to strengthen intellectual property rights there will be much development in this niche of intellectual property. The trade atmosphere in the U.S. is concerned with and sensitive to foreign competition, and this additional technique to protect rights will increasingly be used in the courts. Also, the U.S. Patent Office is now bolstering its staff in the design patent sections. This will speed up the issuance of design patents.

Additionally - Designs of Useful Articles

Efforts also continue in various lobbying groups to enhance the protection of industrial designs by new statutory provisions. The efforts are directed to protecting articles which have an intrinsic utilitarian function, namely to those articles that do not merely portray a novel appearance. Like other countries limitations may be carved out to protect different groups such as spare parts for automobiles. Non-obviousness will not be a requirement. The protection will likely be in the nature of a ten-year copyright-like grant to original industrial designs.

This protection will be in addition to design patent protection. A bill for this purpose was put before the United States Congress on October 19, 1989 which has broad sponsorship and an indication of support from the Bush Administration.

100 E. Corson Street, Third Floor
Pasadena, California 91103-3842
626-796-4000
626-795-6321 fax