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Don't Forget to Protect Your Product Packaging and Product Designs With IP

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Steve Vondran, Esq. (Attorney Steve®) is an intellectual property attorney licensed to practice law in California and Arizona. He specializes in copyright, trademark, trade secret and right of publicity litigation including infringement cases involving software piracy disputes, BitTorrent file-sharing litigation (Strike 3 Holdings), IPTV defense, boxing piracy and any type of dispute involving copyrighted works (ex. jewelry, music, YouTube video and DMCA disputes). We also have a growing practice in the area of fair use opinions.

Since 2004 my firm, Vondran Legal, has been serving clients both small and large in a variety of IP-related legal matters. Our educational YouTube channel (<https://www.youtube.com/user/attorneysteve1>) now has over 40,000 subscribers and growing fast. Unicourt.com has identified Vondran Legal® as the #1 copyright infringement defense firm in the United States, in terms of number of cases, for 2020, 2021 and hoping for the same result for 2022.

Introduction

Your products and product designs are the life blood of your business. However, many companies don't think about protecting their creative product designs, and product packaging with intellectual property registrations. This article highlights some of the major things you should consider as you launch your products into the marketplace, from an intellectual property perspective. Various forms of intellectual property protection are available in the form of copyrights, trademarks, trade dress, and design patents. Let's look at these. This is general legal information only and not legal advice.

Copyright Protection

Copyright law protects *any creative work of authorship fixed in a tangible medium of expression*. This can take many forms when it comes to product packaging and product designs. For example:

- Creative food containers



- Pizza box designs



- Creative product package designs (cereal box art, board games boxes)



- Wine labels



- Jewelry (ex. pendant designs)



Basically, anything that has a minimum level of creativity (uniqueness is not required) and is more than just an assembly of shapes may qualify for copyright protection and allow the rights holder to enjoin any *substantially similar* product that seeks to copy, distribute, and/or reproduce the protected product packaging and allow the rights holder to seek monetary damages for lost profits or statutory damages of up to \$150,000 for willful infringement.

NOTE: Copyright cannot protect functional/utilitarian items (ex. a lamp). The original creative expression (i.e. a creative lamp shade) must be separable from the utility to be copyrightable. If you have something “artsy” about your product, consider copyright protection.



Registration with the United States Copyright Office (USCO) is very inexpensive and generally takes about 6 months, but expedited registration is available, for example, if you need to go to litigation, or to the newly created “copyright small claims board” in Washington D.C.

Miscellaneous Points

How long does copyright protection last? It depends on the authorship, but the life of the author plus 70 years, or 95 to 120 years. This is substantial protection for a long period of time, even after the author of the work is deceased.

Registration of copyright also allows you to sue copyright infringers in federal court and seek actual damages or statutory damages, plus attorney fees.

Other examples of things that can be copyrighted: fabric designs, original design for a shampoo bottle, water bottle, or beer bottle. Maps, architectural designs, diagrams, models, maps, globes, photographs and any art or prints. Creative aspects of clothing can also be protected (ex. cheerleader and sports outfit). Ideas and facts cannot be copyrighted.

Anytime your products, or product packaging is creative consider copyright protection.

Corporate logos: You can also copyright your corporate logo, and product logos or creative characters on your packaging. Also, (see below), your logos and product slogans can be trademark registered.

Trademark Protection

Any logos and slogans used in conjunction with your brand can also be trademarked. Acquiring a trademark provides for nationwide rights (subject to prior uses that may exist). Trademarks are often thought of as (a) traditional trademarks and (b) non-traditional trademarks.

- (a) traditional trademarks (ex. words, phrases, logos, symbols, slogans, that identify the source of the goods) can be trademarked. These can become very valuable corporate assets.



- (b) non-traditional trademarks

Many don't know that other things can be trademarked such as *colors* (Pink Fiberglass), *sounds* (McDonalds “I'm lovin it”) and even *scents* (Strawberry toothbrushes). *Product configurations* that identify the source of goods can also be trademarked. For example (the kiss chocolate candy design represents the Hershey's company as the source of goods):



Any creative feature of your product design that identifies your company as the source of goods can be potentially trademarked giving nationwide rights as long as the mark is being used in commerce. These IP rights can last forever as long as they are used in commerce. Once again, functional aspects are not protected by trademark law. For functional/utilitarian items look to patent protection. In some cases,

an applicant for the product design/packaging trademark may have to prove “secondary meaning” (i.e. that consumers recognize the product configuration as coming from your company). This may take some time to accomplish and you may need to market your product for a few years before applying for the mark.

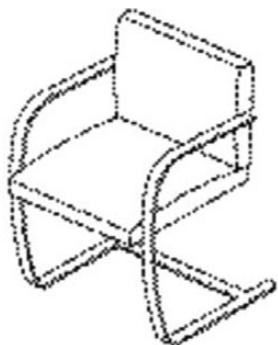
Other product trademark examples:



- Jewelry (David Yerman) product design.

Mark Drawing Code	(2) DESIGN ONLY
Design Search Code	14.01.03 - Cables, electrical, With electric plugs; Cords, electrical (with plugs); Electrical wire/cables, With plug; Plugs, electrical
Serial Number	86064049

- Chair design that identifies source of goods



BOTTOM LINE: If your product design is unique to your company the design can potentially be trademarked giving you rights to enjoin any company selling a confusingly similar design. Again, proof of “secondary meaning” (significant sales, press recognition, etc.) may be required to show the product design is inherently distinctive, and thus, protectible.

Trade Dress Protection for Distinctive Designs (like a trademark)

Non-functional and inherently distinctive Trade dress is an often-unknown form of IP protection. Like seeking a trademark for your company logos, slogans, and other “source-identifiers” trade dress protection can potentially last forever. Trade dress protects the look and feel of product packaging that has “secondary meaning” to consumers and prohibits competing product packaging that presents a “likelihood of consumer confusion.” Trade dress must be “distinctive,” (more than just “original” like copyrights, and more than “new, useful and non-obvious” like patents) which means that consumers must be able to readily identify your product package as coming from just one source or just one *business* that manufactures the good or service. The standard for infringement is “substantial similarity.”

Some types of things that might be available for trade dress protection include:

- KFC chicken buckets and color schemes (ex. The KFC restaurant red/white color scheme)



- Textures (ex. Coco Cola bottle with its ribs and curves)



- Box & Packaging Designs (ex. Kleenex, Band-Aid, Oreo cookies, Godiva chocolate box)

Jack Daniels bottle design:



Word Mark	JACK DANIEL JACK DANIEL
Goods and Services	IC 033. US 047 049. G & S: Alcoholic beverages, namely, distilled spirits. FIRST USE: 20110630. FIRST USE IN COMMERCE: 20110630
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	19.09.03 - Bottles, jars or flasks with straight, vertical sides; Flasks with straight or vertical sides; Jars with straight or vertical sides
Serial Number	85018906
Published for Opposition	November 2, 2010
Registration Number	4106178

Design Patents (Protects the Invention of an Ornamental Design for a Product)

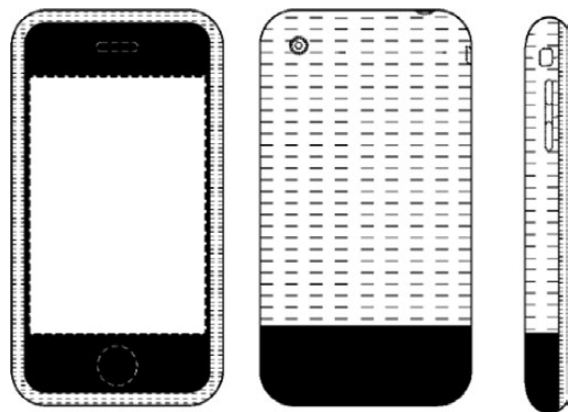
Non-functional/non-utility product packaging can also be subject of a design patent if it is deemed **“new, useful, and non-obvious.”** These must be approved by the USPTO (United States Patent and Trademark Office). Design patents last 15 years. After that, other competitors can make, use or sell similar designs. In other words, this is a “limited monopoly” of fifteen years.

There are also timing limitations. A company only has up to one year to seek a patent design after the

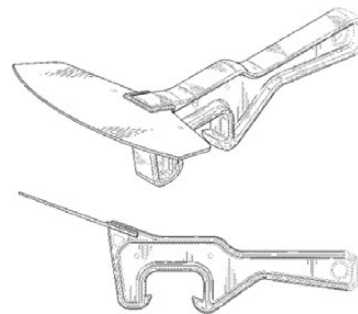
design is released to the public. If it doesn't, then they will be unable to claim design patent rights in that design. The test for infringement of design patent is similar to copyright law, where a *substantially similar* design may be the subject of legal action.

Sample Product/Packaging Designs That Have Applied for, and Received “Design Patent” Protection from the United States Patent and Trademark Office

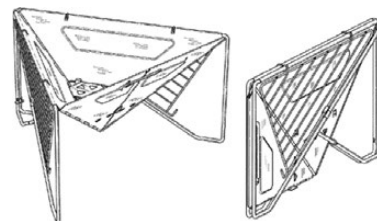
- Electronic device design



- Combination tool design



- Folding stove



- Animal toys



- Brush Design



Bottom line: If you have any ornamental features to your product, and those are new, useful, and non-obvious, you may be able to obtain a limited 15-year

monopoly to prevent others from making, using or selling similar designs that may confuse the “ordinary observer.” Penalties and damages are also possible against infringers.

You can expect design patents to take over 20 months to procure, so proper planning is important.

Conclusion

These are just a few examples to be thinking about when you are creating and launching a product and it contains creative packaging or creative and unique product designs. There are various forms of intellectual property available to consider with a qualified IP law firm.

Remember, when you go on Shark Tank to pitch your product and the “sharks” or investors ask “is there anything proprietary here,” it is nice to say “yes, sharks, we have a design patent, copyrights, trademarks, and trade dress protection.”

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