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# Why it's time for designs

**Registered designs can protect your brand's x-factor and as a result are a powerful arrow in the IP quiver, writes Kristin Geboers of the trademark business of Thomson Reuters**

Patents, trademarks and copyrights are pretty straightforward creatures. They protect unique inventions, words, symbols and works so no one else can copy the expression of your idea. Sure, there are nuances: a patent's originality can be challenged; trademarks may only cover certain classes of goods in certain regions of the world. But, for the most part, the rules of the game are well-established and the filing process is universally understood.

This is not the case with the nonconformist cousin of the patent and the trademark, the industrial design right. Industrial designs can span different IP disciplines. In the European Union, designs are protected by the registered Community design (or RCD), whereas the US currently issues both design patents and trademark registrations for designs elements. These hybrid IP rights protect the ornamental design of an object. That can be the shape, material and look of a soda bottle; the unique appearance of a medical device; or — as one recent high-profile case showed us — the *Apple-ness* or not of a tablet computer.

Maury Tepper, a partner with Tepper & Eyster, PLLC, an IP specialist law firm based in North Carolina, explained: "These days, there has been a lot of attention to design and human factors engineering in consumer products. One need look no further than Apple. They've had huge success because everything they put out looks like a work of art. They manage to articulate a design approach where anyone can look at the product and say: *that's an Apple product*. A good IP protection strategy should seek to protect that intangible design differentiator."

In fact, in the landmark battle between Apple and Samsung, the design patents Apple had on its iPhone were central to their victory before the California jury.

But this value comes at a price. Because design patents cover an inherently intangible set of criteria, they can be enormously challenging to search in the clearance process and subject to wide interpretation

when it comes time to enforce.

David Stone is a UK-based partner with Simmons & Simmons and author of the book *European Union Design Law: A Practitioner's Guide*. He also represented Samsung in England and Wales in the recent *Apple v Samsung* case. He explained: "Designs are an enormously powerful arrow in the quiver of IP protection, but, traditionally, clearance specific to designs has been slow, inaccurate and expensive, primarily because the rights have not been properly databased by search organisations."

What Mr Stone has touched upon is one of the central challenges confronting legal teams as they seek to secure design protection. How can you properly ensure that no other companies have registered a similar design when the words used to describe designs are so subjective?

Mr Stone recommended that time spent in the clearance process is time well spent: "More sophisticated companies recognise that there are lots of variables to consider when clearing new products: not only the brand, but also the shape, colours and materials of the product and its packaging. Many of these will spill over between trademark law and design laws. For example, a bottle shape can be registered as a 3-D trademark and as a design; the clearance process needs to take all of these variables into account."

When juggling all of these variables, the challenge of weeding out false-positives and ensuring that every stone is turned at the clearance phase can mean the difference between a solid clearance strategy and a missed opportunity. It is essential that this process includes accurate search codes, comprehensive design database work and expertise in the sometimes ethereal world of design differentiation.

One unique aspect to design patents is that they cover the appearance of a product, rather than a specific function.

Mr Tepper explained: "Functionality is always a concern in the US. We don't want to allow the design protection to bleed over into areas that should be covered by utility patents. One of the challenges for attorneys is making that determination and trying to get your clients to think about this *in* the design process. If you design a product to be perfectly efficient, you build lots of

functional components that might not be able to be used as a design differentiator."

Fact is, this is one of the few cases in life, let alone IP law, where form can't follow function. Sometimes companies need to add something new, a distinctive look or curve that is not functional, but rather part of the brand's X-factor to meet the necessary criteria for a design patent.

Therefore, when registering the design, it can often be more effective to focus on a specific design attribute of the product, rather than the whole thing. Mr Stone added: "In Europe, you can register the design of part of a product. Let's say for example that the handle of a knife is a particularly striking design. You can register the design for just the handle, rather than the whole knife. This approach can often be more valuable than trying to register the whole product because it is less likely that functional aspects of the product will interfere with the design focus."

Despite the challenges of securing design protection in the US and Europe, the field is growing rapidly. Over 700,000 applications for industrial designs are now filed around the world each year and, according to WIPO data, design registrations filed and issued through its Hague System for the International Registration of Industrial Designs increased 6.6 percent in 2011.

The Hague System, was introduced to provide a mechanism for registering an industrial design in several countries by means of a single application filed in one language with one set of fees. By making it easier to file, the system has led to an increase in industrial design filings around the world. In December 2012, the US signed onto the Hague System, which is expected to significantly increase global filing.

As more parties begin diving into the space, the challenges — and opportunities — are sure to mount. For the attorneys, designers and IP search professionals who will lead this charge, the single most important ingredient will be easy access to complete, accurate information.

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