



# **Design and Branding: The Synergy that Boosts Business Value**

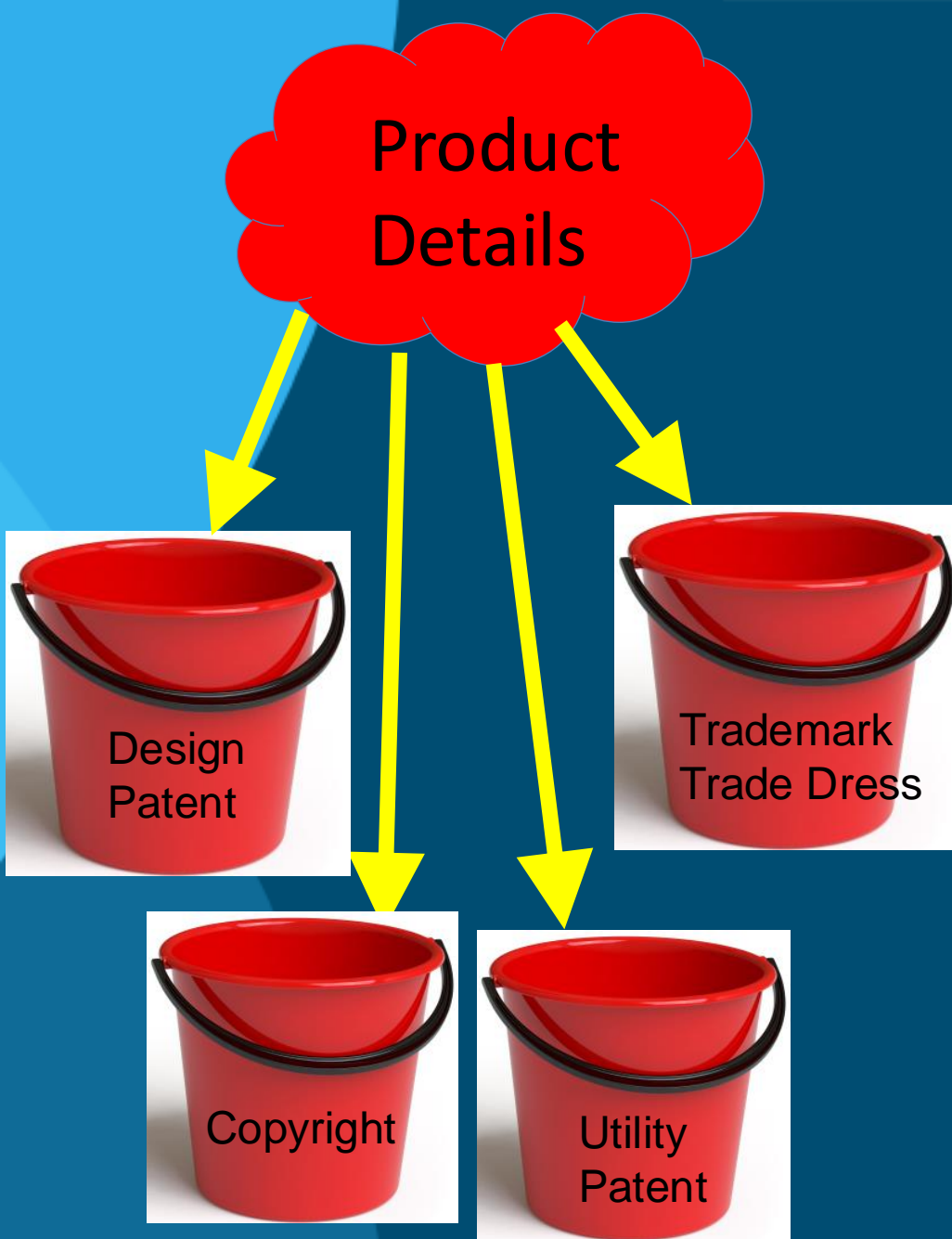
**Robert Katz**

Banner & Witcoff, Ltd.

[rkatz@bannerwitcoff.com](mailto:rkatz@bannerwitcoff.com)



- Brands are formed by many aspects
- As IP attorneys, we impact only a few
- Primary goals
  - Maximize IP protection to maximize potential exclusivity
  - Advise the company to aid in this goal
  - Enforce to establish the marketplace exclusivity

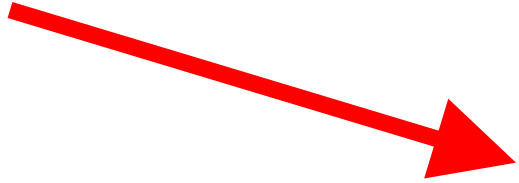


- FOR PRODUCT APPEARANCES
- Completely analyze and determine the applicability of each primary form of IP
- Design patents will be front line
- Take steps to support trademark rights
- Do not overlook potential copyright protection
- Do not overlook potential utility patent protection but know risks

# Design Patent Tips

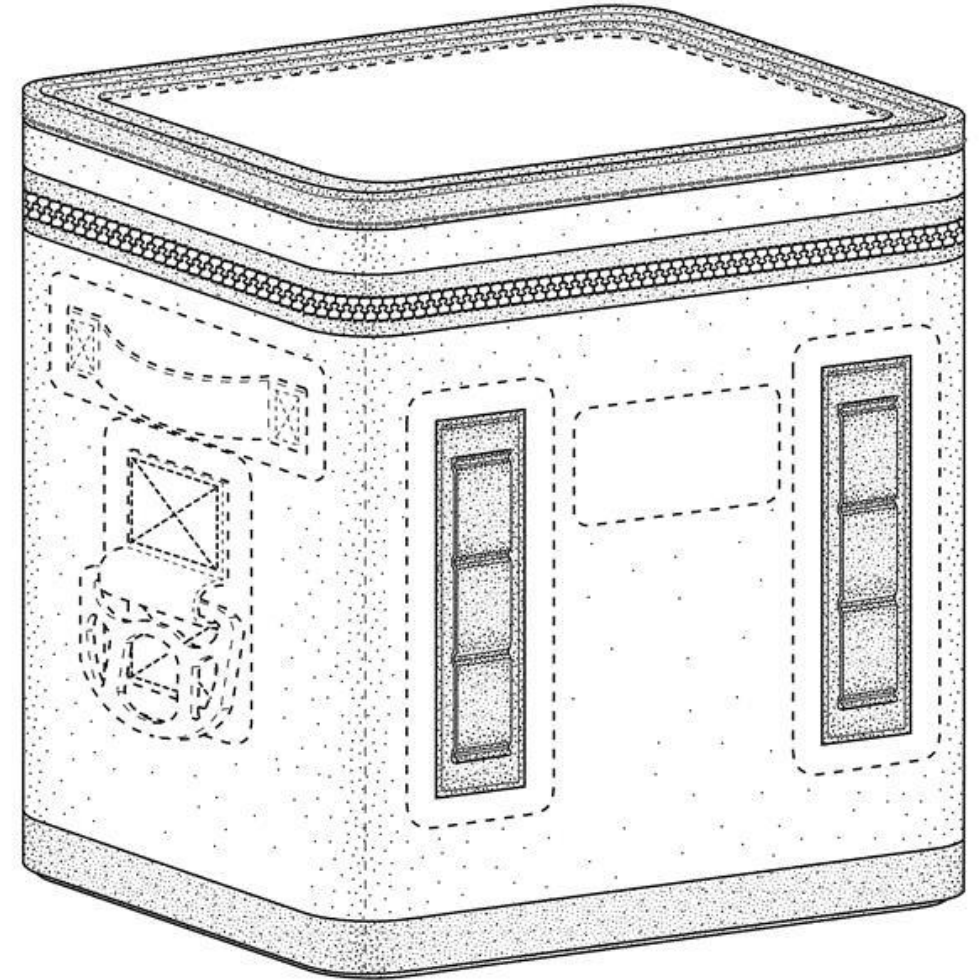
- Be a know-it-all – U.S. is especially unique
  - Get the basics right – pitfalls exist
  - Special statement can work with the drawings
  - Can use symbols in figures
  - Appendix
  - Next level protection
    - Be as creative as the designers
    - Portion practice and cutting edge

# Design Patent Examples



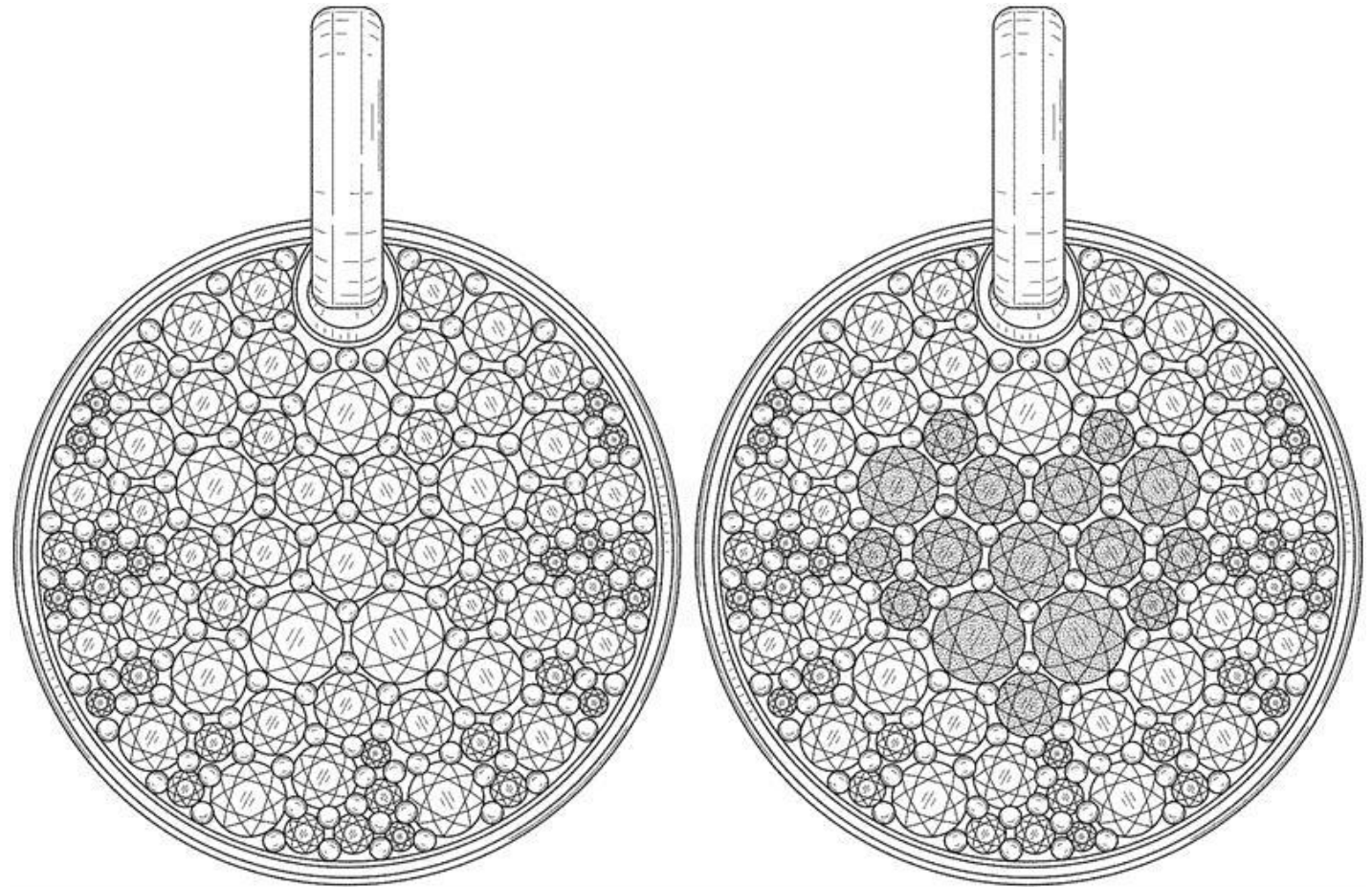
# Design Patent Examples

- The contrast in shading represents a contrast in appearance only and does not represent any particular color, material, texture or finish.
- The unshaded regions within or adjacent to the shaded area form no part of the claimed design.



# Design Patent Examples

- The stippling shown on the stone region in FIG. 8 represents a contrast of appearance with respect to remaining stones and the change of state is affected when the pendant is exposed to **ultraviolet** light.



# Design Patent Examples

- Shoe midsole with translucent rainbow color appearance.
- From the rear to the front of the shoe, the color symbols represent the colors on the respective translucent panels as follows: red, orange, yellow, green, blue, and violet

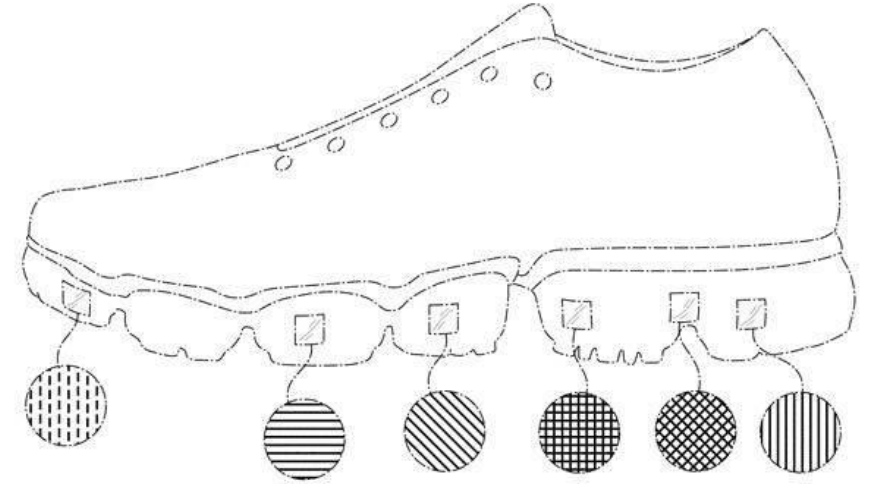


FIG. 1



# Trademark - Product Configurations

- Extends term
- Requirements drive strategies
  - 1) Serve as a trademark
  - 2) Acquired distinctiveness/secondary meaning
    - \*\* use design patents to help establish
  - 3) Non-functional
    - \*\* tougher test than for design patents

Cartier Tank Watch Design

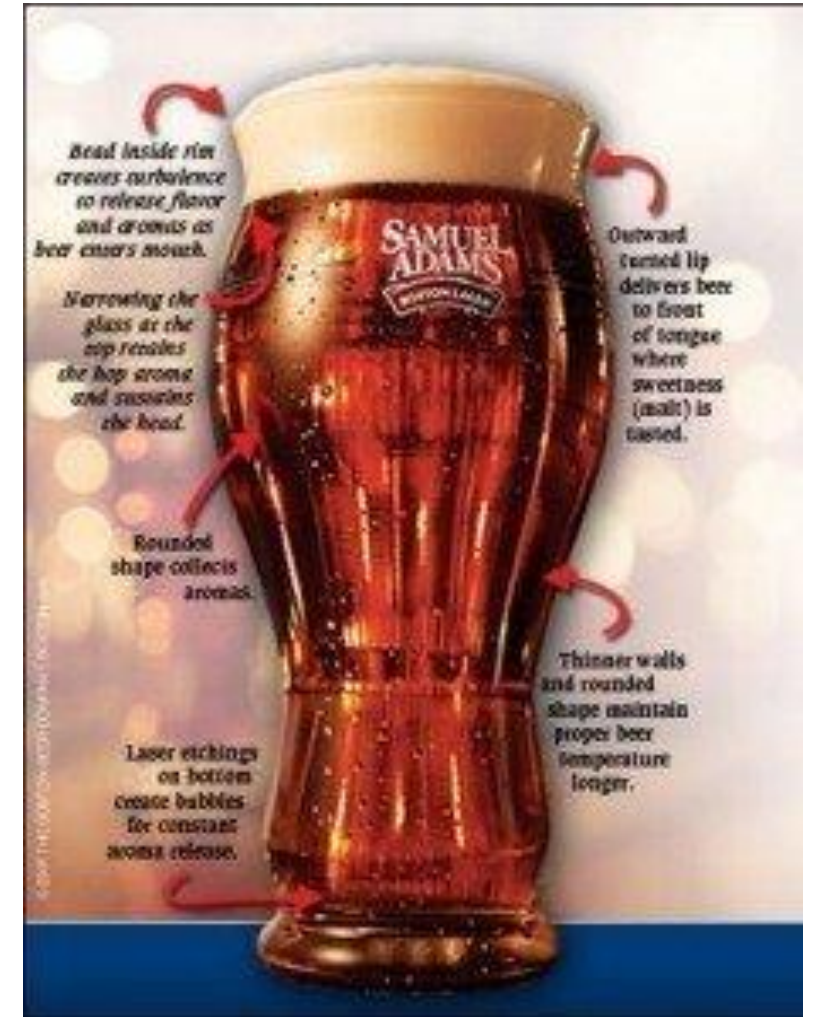


*Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d 217 (S.D.N.Y. 2004)



# Trademark/Trade Dress Tips

- Advertising can impact
- Acquired distinctiveness
  - Use “look for” advertising when possible
  - Feature the appearances often in the advertisement
- Non-functionality
  - Resist touting functional improvement



# Trademark/Trade Dress Tips

- If you can categorize as “trade dress” (as compared to product configuration trademark), you do not need to prove acquired distinctiveness if you can prove it is inherently distinctive
  - But still has to be non-functional



# Copyright Tips

- Is the work part of a useful article?
  - If not, then OK.
  - Still may be OK.
- Pictorial, graphic, and sculptural features/works are protectible if they can be imagined separately from the utilitarian aspects of the article.



# Copyright Example

- The designs are copyrightable because the decorative black trim and T-shape are physically separable and demonstrable as works of art.”

Triangl's "Poppy – Blue Crush" Bikini



# Copyright Example

- The Works contain a sufficient amount of original and creative two- and three-dimensional authorship for registration based on the low standard for copyrightability

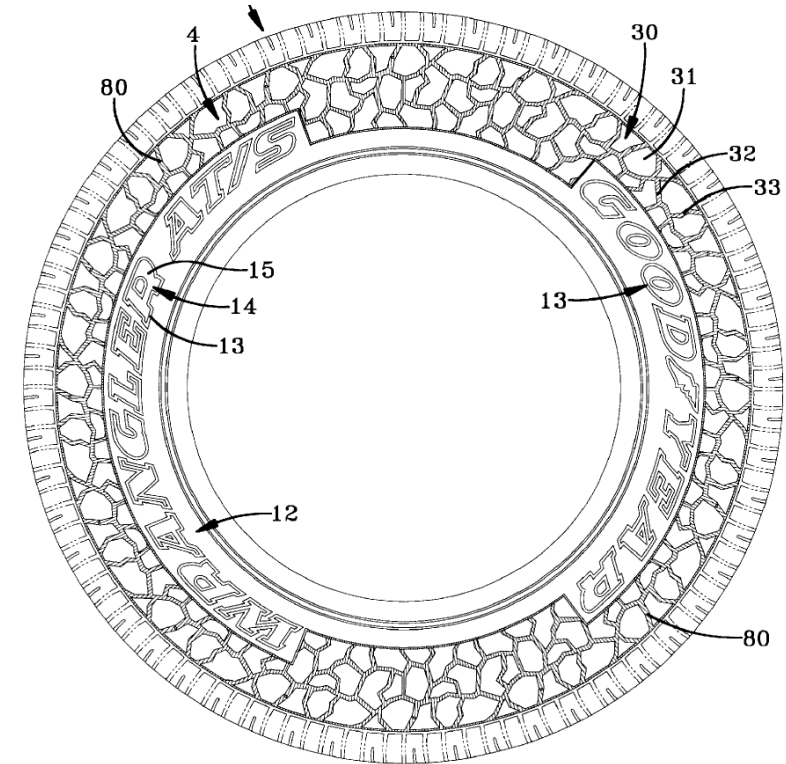


# Utility Patent Tips

- Can protect the appearance of the product in a way to protect alternative appearances (i.e., an appearance concept).
  - Works at odds with trademark rights
  - TIP: avoid depicting commercial embodiment
  - TIP: Consider this from the outset and have an IP plan

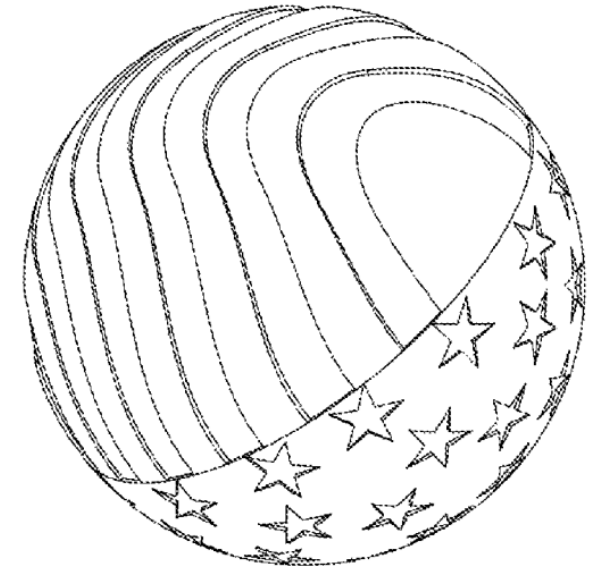
# Utility Patent Examples

- A tire comprising a first background pattern formed by linear ridges interrupted by smooth surface patterns creating an irregular mosaic pattern on the annular exterior surface of the sidewall.



# Utility Patent Examples

- A golf ball ... having the following properties:
  - ... first hemisphere comprises at least 40 dimples having a stellated polygon plan shape and does not include any grooves, and
  - ... second hemisphere comprises at least 5 grooves and does not include any dimples having a stellated polygon plan shape.



# All User Experiences should be Analyzed

- Graphical user interfaces
- Icons
- Fonts

# Takeaways

- Know all the nuances and strategies for each form of IP
- Know how they work together and conflict
- Exploit design protection to the fullest permitted
- Advise to maximize ability to successfully obtain trademark/trade dress rights
- Enforce

# Questions?



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