“Patent, Trademark and Copyright Protection: Should They Overlap?”

Jeff Handelman

Brinks Hofer Gilson & Lione

April 5, 2013

BRINKS HOFER GILSON & LIONE®

usebrinks.com

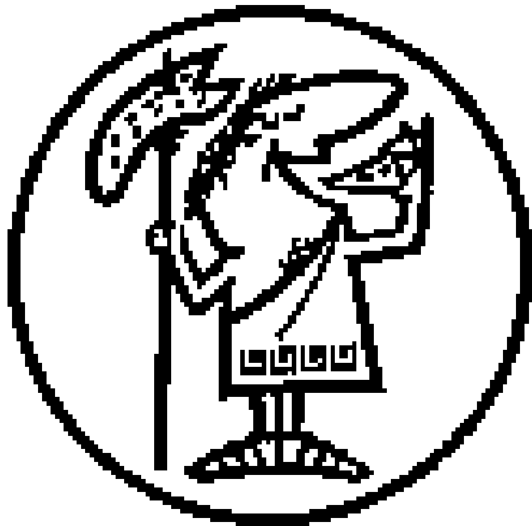
Copyright v. Trademark

- Copyrights cover “original” works of authorship.
- Same design may be protected by copyright law and trademark law.

BRINKS HOFER GILSON & LIONE®
usebrinks.com

Little Caesars' "Roman Man"

Trademark



Copyright

BRINKS
HOFER
GILSON
&LIONE®

usebrinks.com

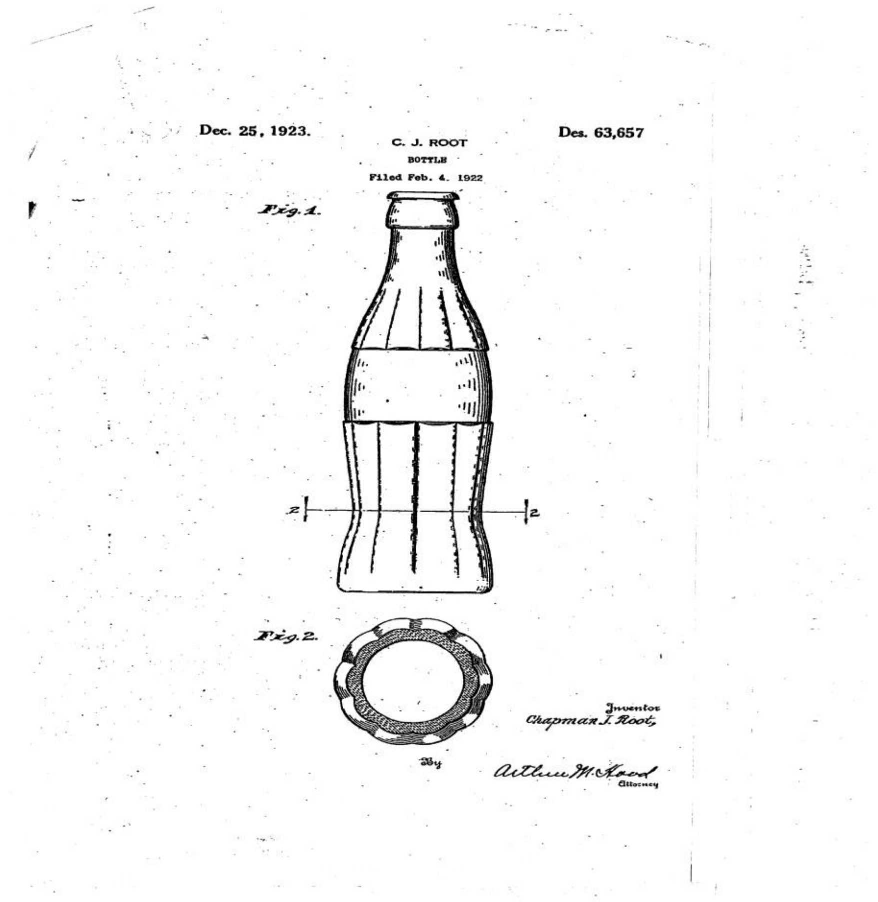
Design Patents

- A design patent is granted only for a design that is primarily “ornamental” and not functional.

- Design patent thus weighs against finding of functionality – consistent with trademark protection.

BRINKS
HOFER
GILSON
& LIONE®
usebrinks.com

THE COCA-COLA BOTTLE



BRINKS HOFER GILSON & LIONE

usebrinks.com

Int. Cl.: 32

Prior U.S. Cl.: 45

Reg. No. 1,057,884

United States Patent Office

Registered Feb. 1, 1977

TRADEMARK

Principal Register

The Coca-Cola Company (Delaware corporation)
310 North Ave. NW.
Atlanta, Ga. 30313

For: SOFT DRINKS, in CLASS 32 (U.S. CL. 45).
First use July 8, 1916; in commerce at least as early as Sept. 1, 1916.
The mark consists of the three dimensional configuration of the distinctive bottle as shown.
Owner of Reg. No. 696,147.

Ser. No. 88,384, filed May 25, 1976.

JOHN C. DEMOS, Examiner

BRINKS HOFER GILSON & LIONE®
usebrinks.com

Constitutional Issue

- The Patent Clause grants inventors rights “for *limited* Times.”
- Once patent expires, all are free to use the subject of the expired patent.
- Using trademark law to extend patent term would violate “limited Times” provision of Patent Clause.

BRINKS HOFER GILSON & LIONE®
usebrinks.com

Constitutional Argument Has Not Gained Widespread Acceptance

- Congress has enacted two federal statutes – patent and trademark – that work separately.
- If design has *secondary meaning* and is not *functional*, it can be protected as a trademark.
- Trademark rights do not “extend” the patent monopoly.
- Trademark rights exist independently of patent rights – under different law for different reasons.

BRINKS
HOFER
GILSON
& LIONE®
usebrinks.com

No Harm Caused by Recognizing Trademark Rights After Expiration of Design Patent

- Competition not hampered.
  - COCA-COLA bottle design is nonfunctional – no competitive need.
- Prevents consumer confusion.
  - COCA-COLA bottle design has secondary meaning.
- Protects investment of trademark owner.
  - Only reason to copy COCA-COLA bottle design – to trade on goodwill.

Utility Patents

- Utility patent covers “useful” designs.
- Under *Traffix*, a utility patent is “strong evidence” that the features claimed in the patent are functional.

BRINKS HOFER GILSON & LIONE®
usebrinks.com

Functionality Toilet Paper Case

- Georgia-Pacific owned incontestable trademark registrations for its Quilted Northern designs.
- Sued Kimberly-Clark for trademark infringement.
- Georgia-Pacific also owned several utility patents covering the same designs.

BRINKS
HOFER
GILSON
&LIONE®
usebrinks.com

Functionality

To Illustrate, the design illustrated in Figure 1 of Georgia-Pacific's U.S. Utility Patent Nos. 5,620,776 ('776 Patent) and 5,573,830 ('830 Patent) is the same design depicted in its U.S. Trademark Registration No. 1,979,345 ('345 Registration):

Figure 1 '776 and '830 Patents	'345 Registration

BRINKS HOFER GILSON & LIONE®
usebrinks.com

Functionality

- The specifications in the utility patents stated that the designs provide several utilitarian advantages for toilet paper:
  - Increased bulk
  - Improved softness
  - Better roll structure

BRINKS
HOFER
GILSON
&LIONE®
usebrinks.com

Functionality

- U.S. Court of Appeals for the Seventh Circuit held that the designs are functional.
- Therefore, no trademark protection.

BRINKS
HOFER
GILSON
& LIONE®
usebrinks.com

Functionality

- Court did not hold that patent law preempted trademark law as a constitutional matter.
- Rather, the claims and specifications contained in the utility patents established that the Quilted designs were *functional* and therefore ineligible for trademark protection.
- Can't tell Patent Examiner one thing and Trademark Examiner the opposite.

Recap

With effective lawyering, one can combine the different branches of IP protection:

- Use trademark, copyright and design patent laws to complement each other.
- In drafting claims of utility patent, exclude design features for which trademark protection will be sought.
- Make it clear that the design feature is not “a useful part of the invention.”

BRINKS HOFER GILSON & LIONE®
usebrinks.com

“Learn Debate Have Fun”

Hugh’s Motto

BRINKS
HOFER
GILSON
& LIONE®
usebrinks.com

NBC Tower - Suite 3600 | 455 N. Cityfront Plaza Drive | Chicago, IL 60611-5599 | Telephone 312.321.4200 | Fax 312.321.4299