The copyright laws are designed to protect original works of authorship. Copyright finds its natural application with works of fine art such as literature, film, music, painting, and sculpture. However, original authorship is not confined to the fine arts. Copyright law is also applied in the business world in connection with software, advertising, packaging graphics, catalogs, and operating manuals.

Design patents are intended to protect new and ornamental articles of manufacture. Design patent protection finds ready application to a wide range of manufactured articles including shaped bottles, cell phones and other electronic devices, cast metal or molded plastic items, textured carpets, automobile parts, and the entire universe of manufactured goods having new shapes or ornamentation.

A significant overlap exists in the items that can be covered by copyright and design patents. Many manufactured items that could be covered by design patents may also be covered by copyright as sculptural works. Broadly construed, these items could include dolls and a variety of toys, furniture, and any number of manufactured items possessing more than entirely utilitarian design. Copyright cannot be used to protect strictly utilitarian product designs because copyright is not applicable to “useful articles,” in the absence of some separable expressive elements.

While in some countries it is necessary to select either design patent or copyright protection, in the United States it is possible to obtain both copyright and design patent protection for appropriate items. Such items must possess the new and ornamental character required by design patents as well as the conceptually separate pictorial, graphic, or sculptural features required by copyright law. However, in many instances, products are brought to market prior to filing for design patent protection. If no design patent application is filed within one year of the public offering or sale of the products, it is too late to seek any type of design patent protection due to the statutory bar of 35 U.S.C. § 102. This statutory bar, and the 14 year life of design patent protection contrast with the typical 75 to 90 year protection available under the copyright laws. As a liberal filing requirement and result, in cases arise where copyright is the preferred avenue for pursuing unauthorized imitations of products.

A necessary predicate to bringing a copyright infringement lawsuit is to secure, or at least file for, a copyright registration. If the application for copyright registration has been filed before the unauthorized imitation occurs, the remedies available are enhanced. However, even a late-filed copyright application may entitle the copyright owner to meaningful compensation.

The importance of appropriately filing and prosecuting copyright applications is demonstrated in the lawsuit of Aqua Creations USA, Inc. v. Hilton Worldwide, Inc. Aqua Creations presented lighting design concepts to Hilton Hotels in 2007 for use in connection with Hilton’s San Diego Convention Center Hotel. Hilton balked at the million dollar proposal for Aqua Creations’ Sunsa Pendant Design fixtures, but ultimately installed lighting was strikingly similar to sketches in the Aqua Creations proposal. In 2009, Aqua Creations filed a copyright application to register the Sunsa Pendant Design as a “Sculpture/3D Art Work and Architectural Work.” However, the application was rejected by the Copyright Office as being directed to a useful article. The trial judge followed the lead of the Copyright Office and also rejected Aqua Creations’ copyright infringement lawsuit under the useful article doctrine, leaving Aqua Creations with no remedy. It is difficult to second guess the Copyright Office’s decision on the Aqua Creations copyright filings without more intimate knowledge of the dates, design and creation of the Sunsa Pendant lighting, however, in many instances, the arrangement and somewhat unique lighting appearance created by the striated and saucer-shaped shades of the Sunsa Pendant would be considered a conceptually separate graphic or sculptural feature that could be protected. Aqua Creations has filed an appeal and this result could change.

Copyright was slightly more successfully employed in the lawsuit of Baby Buddies, Inc. v. Toys “R” Us, Inc. In this case, Baby Buddies had been selling pacifier holders with a decorative bear that could be clipped to an infant’s garment since the late 1980s. In about 1997, Toys “R” Us began carrying the Baby...
Buddies' pacifier holder and the product sold well. Baby Buddies sold more than a million pacifier holder units, and approximately half of those sales came through Toys “R” Us stores. To obtain a lower price, Toys “R” Us had a consultant design a similar, new, pacifier holder that Toy’s “R” Us had manufactured for its stores, and then began phasing out the Baby Buddies holder, discontinuing it entirely in 2003. Baby Buddies sued Toys “R” Us for copyright infringement. The courts determined that the ribbon tether, clip and snap components of the pacifier holder were utilitarian and unprotectable as useful articles.

However, the plastic teddy bear and ribbon bow were found to be physically separable and therefore eligible for copyright protection. Although Baby Buddies was successful in securing a right of protection against copying, the courts determined that in fact no copying of protected expression had occurred. After reviewing the analysis presented by Toys “R” Us' teddy bear experts, the judge determined that there were almost no similarities between the two teddy bear designs beyond the general ideas of including the requisite ears, eyes, nose, mouth, arms, and legs; a ribbon bow; and a pastel based color scheme. Since copyright does not protect ideas, but instead protects the particular expression or authorship, it was held that there was no copying of protected expression and Baby Buddies’ claim was dismissed.

A different result was reached in the case of Universal Furniture International, Inc. v. Collezione Europa USA, Inc. In this case, Universal Furniture believed that its Grand Inheritance collection and its English Manor collection were copied by Collezione. Universal had secured copyright registrations prior to the copying by Collezione, and even amended those registrations to place them in the best possible form for enforcement. Collezione defended against the copyright infringement claim by asserting that the furniture was nothing more than a collection of useful articles. The Magistrate Judge who first considered the matter agreed with Collezione’s useful article argument and recommended dismissing the copyright infringement claims. Upon review, however, the District Court Judge disagreed, and found the ornamental features of the furniture conceptually separable and copied by Collezione. Ultimately, Universal obtained a judgment in excess of $11 million dollars for the infringement.

A second furniture case, illustrating an absence of conceptually separable expression, is that of Design Furnishings, Inc. v. Zen Path, LLC. In this case, Zen Path had a wicker furniture collection that was designed in the United States, but manufactured by an independent Chinese supplier. Design Furnishings was able to identify the Chinese manufacturer who proved willing to sell the Zen Path designed furniture to Design Furnishings as well. When Design Furnishings began listing these wicker designs on eBay, Zen Path sent take down notices under eBay's VErified Rights Owner program, causing eBay to cancel Design Furnishings, auction listings and interfering with Design Furnishings’ ability to sell the products. Design Furnishings sued to halt the take down notices and Zen Path sued for copyright infringement based upon its pending copyright applications. At a preliminary stage in the litigation, the Copyright Office refused to register the Zen Path designs and the judge enjoined Zen Path from sending additional take down notices to interfere with Design Furnishings’ sales. Although Design Furnishings was selling exact copies, the relatively plain geometric wicker pieces could hardly be deemed to have conceptually separate pictorial, graphic, or sculptural features for protection by copyright.

These cases show that copyright can provide a viable alternative to design patent protection. Certainly the lower cost of copyright registration relative to design patent protection is attractive. However, the failure to present and prosecute copyright applications in the most advantageous manner may result in rejections by the Copyright Office that could prejudice a later infringement lawsuit. In addition, copyright protection is subject to the useful article defense, and limited to the only original elements of authorship. Accordingly, design patent protection should not be foregone in cases of significant product design value.

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