

Overlapping IP Protection, and Focus on Copyright

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Young & Thompson
International Patent & Trademark Law
Founded 1903

Types of Intellectual Property

- Patents
- Industrial Designs/Design Patents
- Trademarks
- Copyrights
- Unfair Competition
- Trade Secrets

Constitutional Foundation

Patent & Copyright clause

"The Congress shall have Power...To promote the progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Rights to their Respective Writings and Discoveries.

-- *Article 1, Section 8, Clause 8*

Basic Goal

Pat. & ©: Protect author/inventor; promote progress

TM: Protect consumers

How to Acquire Rights

- Patents: by Application, Examination and Grant
- Trademarks: by Use in Commerce, then registration
- Copyright: by authorship, then registration
- Trade Secret: by keeping secret

Overlapping IP Protection

■ Patents, Trademarks & Copyrights

- These IP rights are often confused. There are some similarities, but these IP rights are different and serve different purposes.
- But they need not be mutually exclusive. For any one work, more than one form of IP protection may apply, as long as it meets the requirements of the laws that govern that form of protection.

Overlapping IP Protection

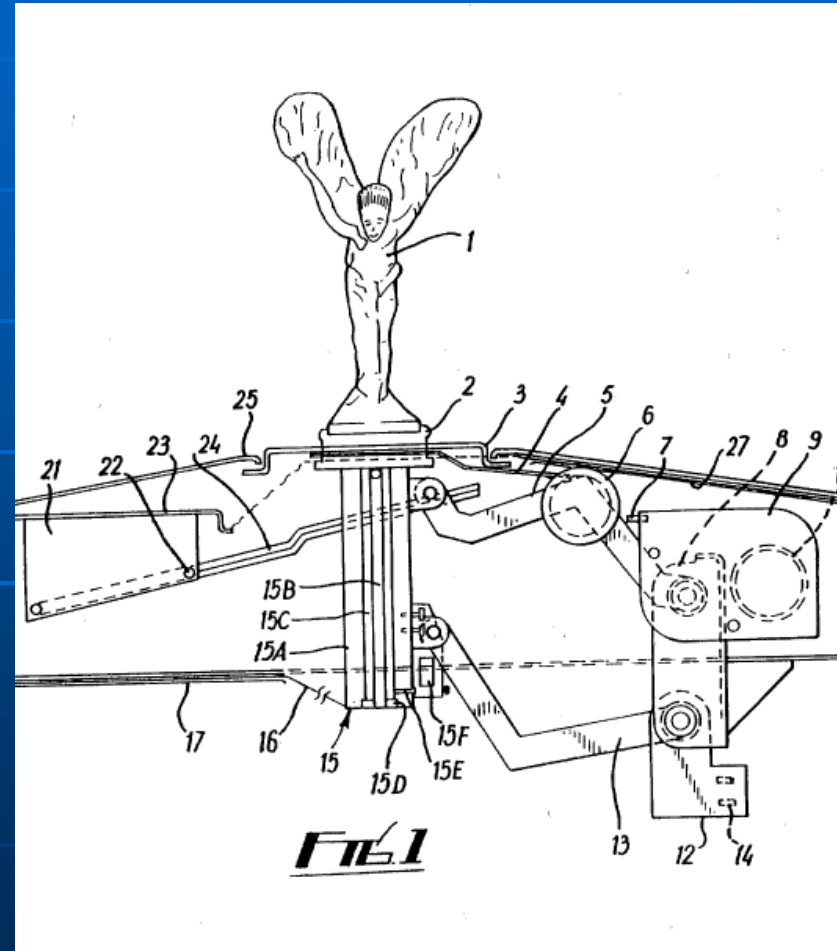
- Depending on the features of the “intellectual property” in question, it may be covered by:
 - Patent protection
 - Design 14 years, or
 - Utility 20 years.
 - Copyright protection:
 - Life + 70, or
 - Works made for hire, 95 or 120.
 - Trademark protection
 - Indefinite

Overlapping IP Protection

- An ornamental design may be protected by **copyright** as a work of art and also may be the subject of a **design patent**.
- Where a **copyrighted** artistic representation identifies a product or service, it also may be the subject of a **trademark**.
- In some instances, an industrial design can span **patent**, **trademark** and **copyright** protection.

Rolls-Royce “Spirit of Ecstasy”

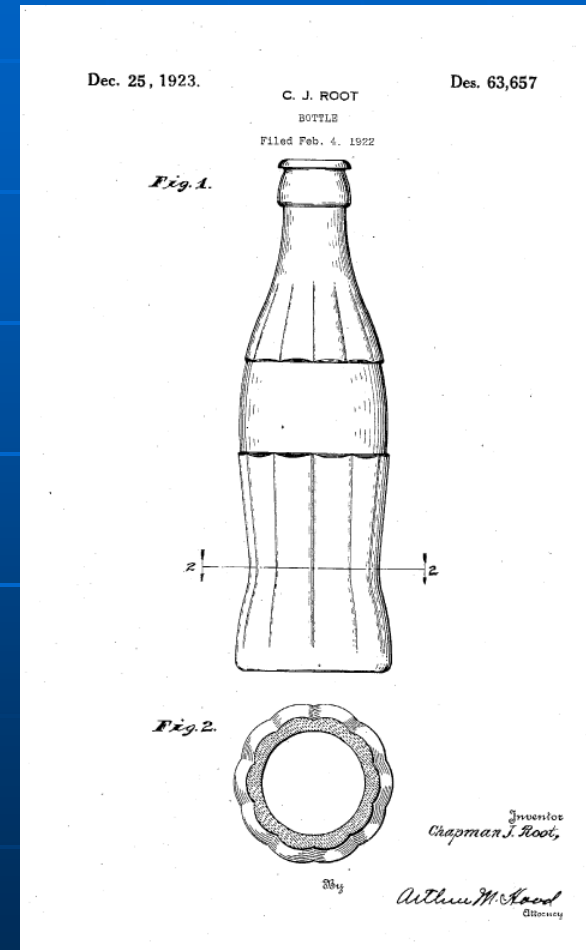
- “The Spirit of Ecstasy” mascot could be protected by various types of intellectual property.
 - Design Patent
 - Trademark
 - Copyright



(WO 9400316 A1)

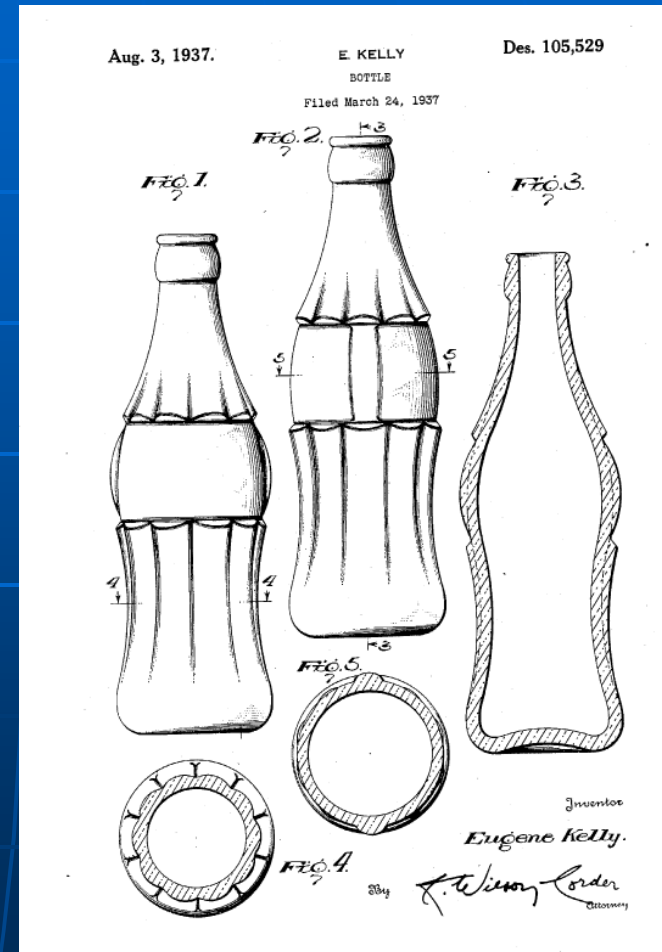
Overlapping IP Protection: The Coca-Cola Contour Bottle

- In 1915, Alexander Samuelson and Earl R. Dean designed the original "hobble skirt" contour bottle.
- The first design patent on the bottle, D63,657, was granted on December 26, 1923, to the bottle manufacturer.



Overlapping IP Protection: The Coca-Cola Contour Bottle

- The Coca-Cola Company received a second design patent for the contour bottle on March 24, 1937, preventing imitation of the bottle for another 14 years.



Overlapping IP Protection: The Coca-Cola Contour Bottle

- The bottle became so well known that it became synonymous with the Coca-Cola product.
- The Coca-Cola Company sought and obtained a federal trademark registration for its contour bottle on April 12, 1960, enabling the company to safeguard the bottle design **indefinitely**.

■ Grinding Disk



PATENT SPECIFICATION

(11)

1 357 483

1 357 483

- (21) Application No. 32972/72 (22) Filed 14 July 1972
 (31) Convention Application No. 69509 (32) Filed 27 July 1971 in (19)
 (33) Italy (IT)
 (44) Complete Specification published 19 June 1974
 (51) International Classification B24D 13/14
 (52) Index at acceptance B3D 2G3D
 (72) Inventor RICCARDO ZANE



(54) A DISCOIDAL FLEXIBLE ABRASIVE MEMBER

(71) I, RICCARDO ZANE, an Italian Citizen, of 22 Viale Elvezia, Milan, Italy, do hereby declare the invention, for which I pray that a patent may be granted to me, and the method by which it is to be performed, to be particularly described in and by the following statement:—
 This invention relates to a discoidal flexible abrasive member for use in carrying out abrasion operations in various industrial fields and particularly in the following:

be provided on the abrasive disc made of fibre. In most cases, the abrasive disc and the bearing disc, which together form the complete abrasive member, are completely separated from each other and are mounted together on the spindle of the machine, the abrasive disc constituting a replaceable tool, whereas the bearing disc constitutes an attachment of the machine. This

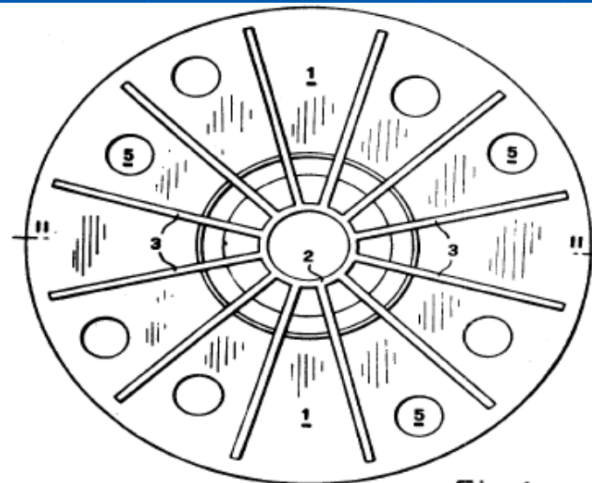


Fig. 1

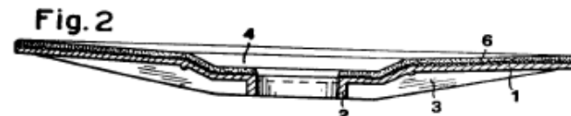


Fig. 2



Fig. 3

Int. Cls.: 7 and 17

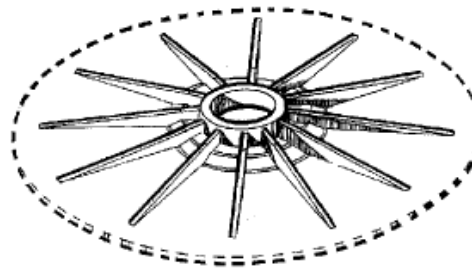
Prior U.S. Cls.: 1, 5, 12, 13, 19, 21, 23, 31, 34, 35 and 50

Reg. No. 3,047,342

United States Patent and Trademark Office

Registered Jan. 24, 2006

**TRADEMARK
PRINCIPAL REGISTER**



ZEC S.P.A. (ITALY JOINT STOCK COMPANY)
VIA DEI LAVORATORI 1-3
CINISELLO BALSAMO (PROVINCE OF MILANO),
ITALY

FOR: ABRASIVE DISKS FOR USE ON GRINDING
MACHINES, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34
AND 35).

THE MARK CONSISTS OF A REAR FACE OF A
ROUND ABRASIVE DISK OR PLATE WITH A
CENTRAL PROTRUSION AND RADIAL RIBS.
THE SUBSTITUTE DRAWING SHOWS THE REAR
FACE OF THE ROUND ABRASIVE DISK OR PLATE
IN PERSPECTIVE, WITH BROKEN LINES SHOW-
ING THE NON-CLAIMED PORTION OF THE CON-
FIGURATION.

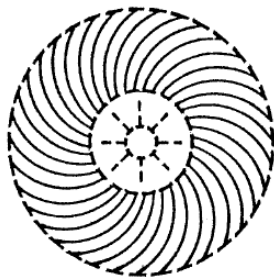
1101 U.S. Cl. 23

United States Patent and Trademark Office

Reg. No. 1,691,166

Registered June 9, 1992

**TRADEMARK
PRINCIPAL REGISTER**



ZEC S.P.A. (ITALY JOINT STOCK COMPANY)
VIA DEI LAVORATORI 1-3
CINISELLO BALSAMO (MILANO), ITALY

FOR: ABRASIVE DISCS, IN CLASS 7 (U.S.
CL. 23).

PRIORITY CLAIMED UNDER SEC. 44(D) ON

THE MARK IS COM
DESIGN OF APPLIC/
TURES SHOWN IN 1
COMPRISE PART OF
SEC. 2(F).

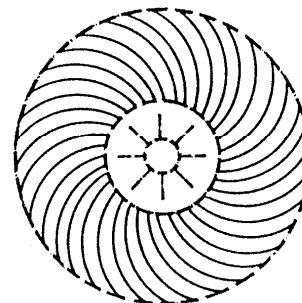
1101 U.S. Cls. 7 and 23

United States Patent and Trademark Office

Reg. No. 1,717,483

Registered Sep. 22, 1992

**TRADEMARK
PRINCIPAL REGISTER**



ZEC S.P.A. (ITALY JOINT STOCK COMPANY)
VIA DEI LAVORATORI 1-3
CINISELLO BALSAMO (MILANO), ITALY

FOR: ABRASIVE DISCS, IN CLASS 7 (U.S.
CLS. 4 AND 23).

FIRST USE: 8-3-1989 IN COMMERCE

THE LINING IN THE DRAWING IS AN IN-
TEGRAL FEATURE OF THE GOODS, AND
DOES NOT REPRESENT COLOR.

THE MARK IS COMPRISED OF THE SPIRAL
DESIGN OF APPLICANT'S GOODS. THE FEA-
TURES SHOWN IN DOTTED LINES DO NOT
COMPRISE PART OF THE MARK.

US Navy

- owns multiple registered trademarks for “camouflage” fabric designs issued uniforms, Christmas stockings, plush toys, coasters, cups, mugs, and foam drink holders
- owns design patents on camouflage fabric designs
- owns any copyright for fabric designs

United States of America

United States Patent and Trademark Office



Reg. No. 4,254,165
Registered Dec. 4, 2012
Int. Cl.: 25

TRADEMARK
PRINCIPAL REGISTER

NAVY EXCHANGE SERVICE COMMAND ("NEXCOM"), A NONAPPROPRIATED FUND
INSTRUMENTALITY UNDER THE DEPARTMENT OF NAVY (UNITED STATES AGENCY
OF THE UNITED STATES GOVERNMENT)
3280 VIRGINIA BEACH BLVD.
VIRGINIA BEACH, VA 23452

FOR: UNIFORMS, CAPS, BLOUSES, TROUSERS, PARKAS, ALL SOLD TO AUTHORIZED
PATRONS OF THE MILITARY EXCHANGES PURSUANT TO ARMED SERVICES EX-
CHANGE REGULATIONS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 12-15-2008; IN COMMERCE 12-15-2008.

THE MARK CONSISTS OF IRREGULAR BLOCK-SHAPED PIXELS THAT CONSIST OF A
FOUR-COLOR PATTERN OF BLACK, DECK GREY, LIGHT GREY AND NAVY BLUE, THE
PATTERN BEING APPLIED TO ALL OR PART OF THE SURFACE OF THE GOODS.

(12) **United States Design Patent**
Dugas et al.

(10) **Patent No.:**

US D491,372 S

(45) **Date of Patent:**

**** Jun. 15, 2004**

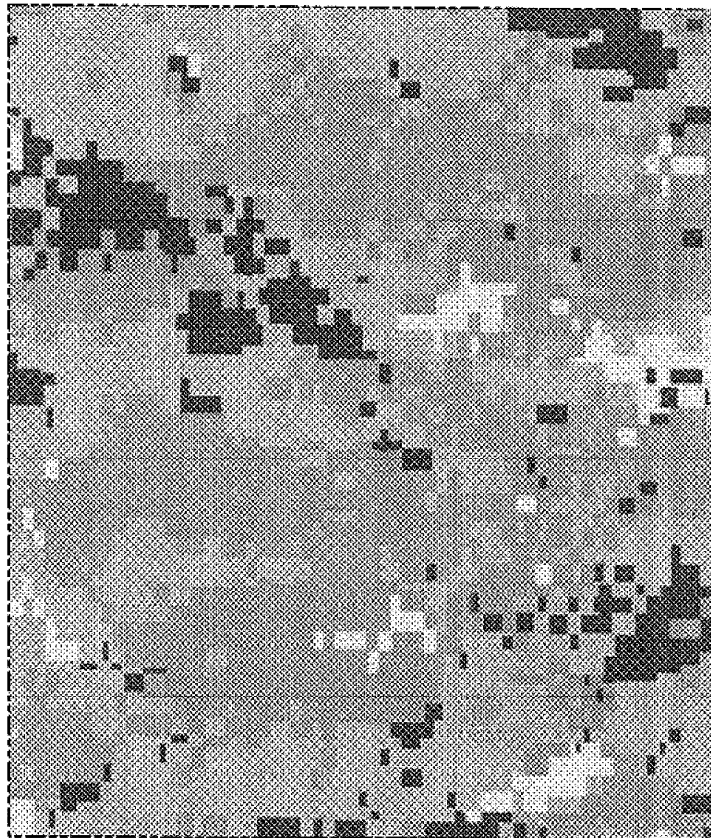


FIG. 3

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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

STAR FABRICS, INC., a California
Corporation,

Plaintiff,

v.

SEARS HOLDINGS CORPORATION, an
Illinois Corporation; SEARS, ROEBUCK &
COMPANY, a Delaware Corporation;
SAKUTORI DESIGNS, LLC, a Hawaiian
Limited Liability Company; FRENCH
CONNECTION GROUP, INC., a New York
Corporation; PACIFIC ALLIANCE USA,
INC., a New York Corporation; and DOES 1
through 10,

Defendants.

Case No.:

**PLAINTIFF'S COMPLAINT FOR
COPYRIGHT INFRINGEMENT**

Jury Trial Demanded

2 including but not limited to garments sold by SEARS under SKU 727883229471 and
3 bearing the label “UK Style by French Connection” and RN 123475, which indicates
4 that the garments were manufactured by or for PACIFIC. An image of Subject
5 Design C and an exemplar of Subject Product C are set forth hereinbelow:

6 **Subject Design C**



Subject Product C



18 **CLAIMS OF COPYRIGHT INFRINGEMENT**

19 24. Plaintiff is informed and believes and thereon alleges that Defendants, and
20 each of them, had access to Subject Designs A, B, and/or C (collectively, “Subject
21 Designs”), including, without limitation, through (a) access to Plaintiff’s showroom
22 and/or design library; (b) access to illegally distributed copies of Subject Designs by
23 third-party vendors and/or DOE Defendants, including without limitation

Forms of Intellectual Protection

■ Trademarks

- Trademark protection is afforded to words or designs that are used to distinguish the source of the goods or services from the goods or services of others.
- A trademark gives the owner the right to prevent others from using a confusing, similar mark.
- Trademark rights may continue indefinitely.
 - Zombie trademarks?

Purpose of Trademarks

- Quality assurance in an urban (anonymous) exchange
- This indirectly encourages expenditures to increase the quality of the TM owner's goods



Guiding Principle of Trademark

CONSUMER PERCEPTION

as a test of

- Infringement
- Validity