Getting Creative with Protecting Creativity: Protecting a Consumer Brand with More Than Just Trademarks

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Trademarks are an effective way to protect valuable intellectual property assets and promote a brand—but they are not the only way. Brands are carefully cultivated and enormously valuable, and those seeking to protect them should consider the larger universe of intellectual property protections. In some cases, other forms of intellectual property, like copyrights, trade dress, and patents, both design and utility, may provide better protection for a brand than trademarks alone. And a thoughtful combination of multiple forms of intellectual property protection may ultimately be the best way to preserve and protect growing or established brands.

To be clear, trademarks are a critical part of any brand's toolbox. A federally registered trademark provides protection for a vast array of brand-identifying marks, whether they be a "word, name, symbol, or device, or any combination thereof."[2] A registered trademark grants the trademark owner the exclusive right to use the mark nationwide within specific commercial contexts.[3]

That said, trademarks (like all forms of intellectual property) have limits. Three that may impact brand owners are trademarks' limitation on commercial contexts; their use requirements; and their variance in strength.

Because trademarks are granted only in connection with certain goods and services,[4] brand owners need to carefully consider all the ways they intend to use a trademark. If, when applying for a trademark, the applicant under-designates the commercial contexts in which the trademark will be used, there is a risk of not being able to enforce it in a context actually used.[5] Consider, for example, a company that primarily sells cosmetics products. If that company applies for trademark protection only regarding cosmetics, it will have difficulty enforcing that mark against those who create clothing or other merchandise using the mark.[6] On the other hand, over-designating the commercial contexts in which the mark will be used has its own pitfalls—doing so can lead to the U.S. Patent & Trademark Office rejecting registration of the mark.[7]

Unlike other forms of intellectual property, trademarks must be used to prevent them from being abandoned.[8] If the owner abandons the mark (intentionally or otherwise), others may enter the same marketplace, using the same mark, without being liable for trademark infringement.[9] And trademarks can vary in strength. Arbitrary, "fanciful" trademarks tend to be more distinctive and enforceable in litigation.[10] Marks which are merely descriptive—think "Deep-Dish Pizza"—or generic marks—*e.g.*, "Makeup Store"—tend to be less distinctive and thus less powerful.[11]

While centrally useful to brand cultivation, perception, and protection, some shortcomings in the trademark regime may provide opportunities for other forms of intellectual property to step in.

Brand owners and managers should carefully consider whether their brand could be augmented by the thoughtful use of other forms of intellectual property protection.

Copyrights

Those familiar with trademarks are likely also familiar with copyrights. Used effectively, copyrights and trademarks can work together to promote, protect, and prolong various aspects of a brand. In fact, unlike other forms of intellectual property, copyright protection arises automatically when a work is created in a fixed form.[12] Brands likely have hundreds or even thousands of copyrights. Deciding which is worthy of formal registration takes careful thought and planning.

To receive copyright protection for a work in the United States, the work must be (1) original, (2) creative, and (3) fixed in a tangible medium.[13] Although these three requirements may seem daunting at first glance, in practice, the threshold for copyright eligibility is relatively low. For example, the Supreme Court has held that only a "modicum of creativity" is required for a work to qualify as an original work of authorship.[14]

The scope of copyrightable works is open-ended and flexible. Nearly all works of authorship fixed in a tangible medium qualify as copyrights, so long as a modicum of creativity was required to produce them. Brands should consider whether they have certain advertisements, photos, blogs, or other materials that would benefit from registration. For example, Johnson & Johnson has registered certain songs it used to advertise Band-Aids,[15] and Lancôme has obtained copyright protection for a carton design for a certain perfume.[16]

A copyright grants the owner the exclusive rights: to reproduce the copyrighted work and make copies; to distribute copies of the work; to publicly perform the work; to publicly display the work; to perform sound recordings publicly through digital audio transmission; and to create derivative works based on the copyrighted work.[17] These rights literally last a lifetime—for works created in 1978 or later, the duration of the copyright is the life of the author plus seventy years.[18]

Although a copyright vests as soon as it is created and is fixed in form, there are many benefits to registering a work at the U.S. Copyright Office. For example, a copyright owner must have a registration from the Copyright Office to sue for copyright infringement.[19] And eligibility for statutory damages and attorney's fees is dependent on registration of the copyright prior to infringement, with some exceptions.[20]

Because of the differences in their protections, not everything that can be trademarked can be copyrighted, and not everything that can be copyrighted can be trademarked. But considering the expansive scope of rights granted by a copyright (especially a registered copyright), brands should consider whether certain of their branding tools, like slogans, songs, advertisements, and the like, are ripe for valuable copyright protection.

Trade Dress

Three-dimensional products and designs may be particularly well-protected by trade dress, a subset of trademark law. U.S. trademark law allows for registration of recognized product configurations and product packaging that easily identify the brand to the public.[21] Traditional trade dress typically encompasses labels, wrapping, containers, and any other materials used in product packaging.[22] In other words, a brand can use trade dress to protect any form of packaging that consumers have come to associate with that brand.

Trade dress has been used to protect, for example, the design of a magazine cover,[23] the appearance and décor of a chain of Mexican-style restaurants,[24] and a method of displaying wine bottles in a wine shop.[25] Although it remains unclear, courts appear to be willing to accept that a website's overall "look and feel" can similarly qualify for trade secret protection.[26]

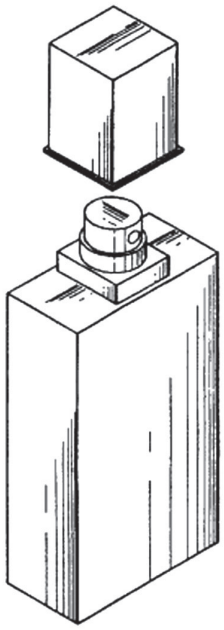
Trade dress can be a powerful form of protection: once registered, trade dress protection, like trademarks, can be unlimited in time.[27] Trade dress can also exist simultaneously with other forms of intellectual property protection, providing a useful complement that can extend past the termination or expiration of other protection.[28]

But obtaining that protection is not easy. Unlike trademarks, trade dress is not registrable immediately upon adoption.[29] Instead, a brand must show that its trade dress is capable of acting as a distinctive source identifier, that is, that consumers immediately associate that trade dress with the brand.[30] For many brands, however, the effort to obtain trade dress protection may pay off in the end by protecting distinctive product designs for as long as they remain in use.

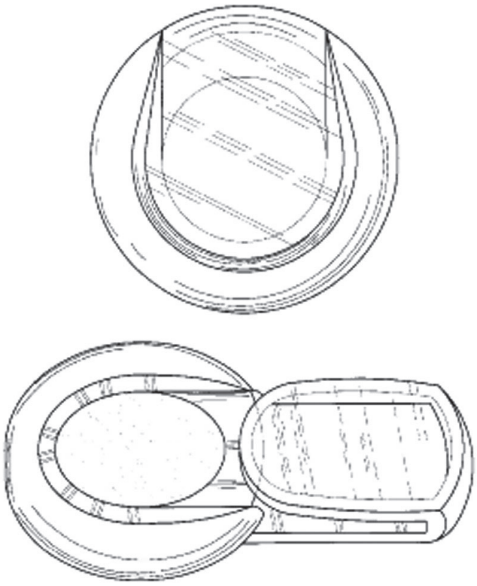
Design Patents

As a complement to trade dress, brands should consider whether design patent protection may work best for them. When thinking about patents, many people may think only of utility patents. But, assuming the design is not functional, U.S. patent law also allows for the protection of "any new, original and ornamental design for an article of manufacture."[31] Design patents protect the visual appearance of the ornamental design,[32] which could include, for example, the shape of a bottle or the outline of packaging.

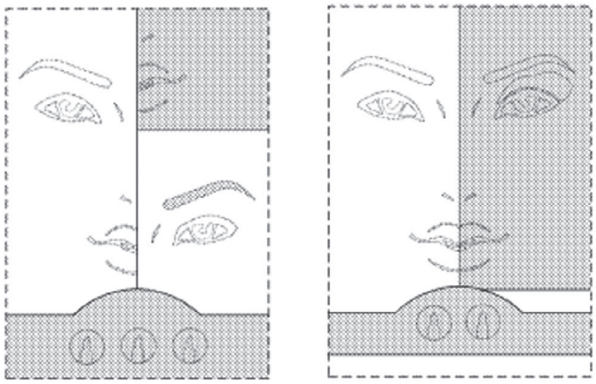
For example, Dolce & Gabbana obtained a design patent for the shape of a perfume bottle:[33]



And Lancôme obtained a design patent for the shape of a cosmetics case:[34]



In addition to features of physical objects, design patents may be granted on features of user interfaces, for example, ornamental features of a brand's phone app or website.[35] These design patents can even include animations, indicated in the design patent by figures showing a sequence of images that comprise the animation.[36] For example, Benefit Cosmetics obtained a design patent on an animated graphical user interface:[37]



Design patents provide a particularly useful range of protection, because they do not require that the infringing product be identical to the patented one; rather, design patents provide protection against infringement where the accused article or design is "substantially the same" as the patented design from the perspective of an ordinary observer.[38] And design patents can provide this protection relatively quickly—prosecution of design patents typically takes under two years.[39] Once obtained, a design patent is enforceable for fifteen years.[40]

Brand owners and managers should consider which designs differentiate their brand among competitors. Obtaining design patent protection over those designs could, in some circumstances, be quicker and less expensive than other forms of intellectual property, and could provide enforceable protection (via infringement litigation) for fifteen years.

Utility Patents

Those familiar with managing a brand's perception may think that utility patents are largely irrelevant (apart, perhaps, from touting one's patents in advertising). While other forms of intellectual property may more easily protect key design features of a brand, utility patents may provide an excellent form of protection for certain unique functional features.

A utility patent protects the functional aspects of any novel, non-obvious process, machine, manufacture, or composition of matter, or any new and useful improvement of any of these.[41] A granted patent provides its assignee with essentially a monopoly over the claimed matter, preventing any other entity from importing, making, selling, or inducing others to import, make, or sell the patented product.[42] Thus, for at least 20 years after the application was filed, the patent owner can prevent competitors from profiting from the patented invention through litigation, licensing, or both.[43]

Utility patents are limited to functional features, but brand owners may have more of these worthy of protection than they know. For example, utility patents can cover manufacturing processes for packaging or products;[44] the makeup of cosmetics or other consumer goods;[45] or improvements to packaging, like making plastics lighter and cheaper.[46] In the cosmetics world, utility patents have recently had an impact. Olaplex (formerly Liqwd, Inc.) sued L'Oréal in 2017 for patent infringement, alleging that L'Oréal's hair conditioning products infringed on Olaplex's patents.[47] The case has lasted many years and has seen multiple appeals to the Federal Circuit[48]—indicating the importance of the patents at issue to both parties.

Utility patents may thus provide valuable protection for a brand's most profitable inventions, like methods of manufacturing products or the composition of those products. Brands should consider what unique functional inventions they have created, and whether utility patents may provide the best form of protection for those inventions.

Conclusion

Trademarks are a valuable way to protect a brand's assets. But trademarks are not the only way. In many circumstances, additional forms of intellectual property can complement trademarks to provide more fulsome protection of all a brand's important features that identify it to consumers, from inventions to designs. Brands should carefully consider whether to pursue multiple forms of intellectual property protection, including copyrights, trade dress, and design and utility patents, to ensure their brand remains recognizable, strong, and protected.

1. The authors are attorneys at the intellectual property firm of Finnegan, Henderson, Farabow, Garrett & Dunner LLP. This article is for informational purposes, is not intended to constitute legal advice, and may be considered advertising under applicable state laws. This article is only the opinion of the authors and is not attributable to Finnegan, Henderson, Farabow, Garrett & Dunner LLP, or the firm's clients.
2. 15 U.S.C. § 1125(a)(1).
3. *Id.* § 1114 *et seq.*
4. *Id.* §§ 1051(a)(2) and (b)(2); *see also* TMEP § 1402.01 ("A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce…To 'specify' means to name in an explicit manner.")
5. *See, e.g.*, *Lockheed Martin Corp. v. Network Sols., Inc.*, 985 F. Supp. 949, 964 (C.D. Cal. 1997) ("[T]rademark law permits multiple parties to use and register the same mark for different classes of goods and services.").
6. *See, e.g.*, *id.* at 964–66 (finding that a Internet domain name registration company did not infringe an aerospace company's trademark, even though the domain name registration company registered marks identical to the plaintiff's, in part because the parties operated in different industries).
7. *See, e.g.*, *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q. 2d 1883, 1891–92 (T.T.A.B. 2008).
8. 15 U.S.C. § 1127 ("A mark shall be deemed to be 'abandoned' if" "its use has been discontinued with intent not to resume such use," which "may be inferred from circumstances," including "[n]onuse for 3 consecutive years").
9. *Id.*; *see also* Laurence Hefter & Danny Awdeh, "Resurrecting Abandoned Trademarks – A Question of Perception," World Trademark Review (Feb./Mar. 2011) (discussing that abandoned trademarks "creat[e] an opportunity for those seeking to reanimate abandoned marks and use them for commercial gain").
10. *See, e.g.*, *Macy's Inc. v. Strategic Marks, LLC*, No. 11-cv-06198-EMC, 2016 U.S. Dist. LEXIS 11676, at *3–4 (N.D. Cal. Feb. 1, 2016) (finding, after determining that the subject marks were arbitrary terms with no other perceived significance, that the defendant had infringed the marks).
11. 15 U.S.C. § 1052(e)(1) (registration is precluded for marks which are merely descriptive); *In re Chamber of Commerce of the U.S.A.*, 675 F.3d 1297 (Fed. Cir. 2012) (a mark is merely descriptive "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods and services with which it is used").
12. 17 U.S.C. § 102.
13. 17 U.S.C. §§ 101–02.
14. *Feist Publications v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).
15. *See, e.g.*, Copyright Reg. Nos. PA0001626267, PA0001614491, PA0001614487, and PA0001626266.
16. *See, e.g.*, Copyright Reg. No. VAu000099406.
17. 17 U.S.C. § 106.
18. 17 U.S.C. § 302. For anonymous work, pseudonymous work, or work made for hire after January 1st, 1978, the duration of the copyright is ninety-five years from the year of first publication or 120 years from the year of creation, whichever expires first. *Id.* Works created prior to 1978 have different expiration dates. *See* 17 U.S.C. § 101 *et seq.*
19. 17 U.S.C. § 410(c).
20. 17 U.S.C. § 412.
21. 15 U.S.C. § 1125 (identifying as eligible for protection any "container for goods").
22. *See* "Designs: A Global Guide 2014," World Trademark Review, at 142 (2014).
23. *Reader's Digest Ass'n v. Conservative Digest*, 821 F.2d 800 (D.C. Cir. 1987).
24. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).
25. *Best Cellars Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 3d 431 (S.D.N.Y. 2000).
26. *See, e.g.*, *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240 (W.D. Wash. 2007).
27. 15 U.S.C. § 1051 *et seq.*
28. *See* Elizabeth Ferrill and Sydney English, "Yin and Yang: Design Patents and Trade Dress Rights," BNA's Patent, Trademark & Copyright J. (July 27, 2015).

29. "Designs: A Global Guide 2014," *supra* n.12, at 141.
30. *See Two Pesos*, 505 U.S. 763; Michael Best & Friedrich, "Entrepreneur's Guide to Intellectual Property – Blog Series: Protecting Your Products and Packaging with Trade Dress," The National L. Rev. (June 10, 2012).
31. 35 U.S.C. § 171.
32. *Id.*; *see also* Elizabeth Ferrill & Nicholas Doyle, "Design Patents: An Underutilized Tool for Protecting Sporting Goods," Sports Litigation Alert (May 22, 2020).
33. U.S. Design Patent No. D485,165.
34. U.S. Design Patent No. D525,748.
35. *See, e.g.*, Elizabeth Ferrill, "Swipe to Patent: Design Patents in the Age of User Interfaces," TechCrunch (Aug. 4, 2015) ("[T]he fastest growing segment of design patent filings is in the [user experience and user-interface design] space.").
36. *Id.*
37. U.S. Design Patent No. D808,407.
38. *See, e.g.*, *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008).
39. *See* "Design Patents: An Underutilized Tool for Protecting Sporting Goods," n.12, *supra*.
40. 35 U.S.C. § 173.
41. 35 U.S.C. §§ 101–03.
42. 35 U.S.C. § 271.
43. 35 U.S.C. § 154.
44. *E.g.*, U.S. Patent No. 7,740,923 ("Method and apparatus for producing a package or for packaging a food insert"), assigned to Intercontinental Great Brands LLC.
45. *E.g.*, U.S. Patent No. 8,080,238 ("Oil-based cosmetic composition"), assigned to Shiseido Co. Ltd.
46. *E.g.*, U.S. Patent No. 10,214,311 ("Lightweight plastic container and preform"), assigned to Plastipak Packaging Inc.
47. *See Olaplex, Inc. v. L'Oréal, Inc.*, No. 17-14-SLR, 2017 U.S. Dist. LEXIS 104123, at *1–2 (D. Del. July 6, 2017).
48. Most recently, the Federal Circuit issued a decision on appeal on May 6, 2021. *Olaplex, Inc. v. L'Oréal USA, Inc.*, No. 20-1382 (Fed. Cir. May 6, 2021).