

METROPOLIS



Two leading copyright attorneys review some of our favorite products from ICFF, offering designers tips on how best to protect their work.



On the ADVICE of COUNSEL

by
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and
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For many designers, the idea of legally protecting their work is daunting. But it shouldn't be: though knockoffs are shamefully rampant in the furniture industry, the United States Patent and Trademark Office (USPTO) affords a whole host of weapons for legal protection. "The problem we always have is that designers think copyrighting and trademarking is scary," says George Gottlieb, a founding partner at Gottlieb, Rackman & Reisman, a New York firm specializing in intellectual property law. "They don't even want to talk to a lawyer. But we can look at a product and in fifteen or twenty minutes give the designer a pretty good picture of what is protectable."

So how can designers protect themselves? It's not as complicated or even as expensive as one might suppose. "Our policy is not to charge for the initial consultation," Gottlieb says.

"We charge for the trademark or design or utility patents. On the copyright, we tell them, 'We'll do the first one with you, and the rest you should do yourself.'"

We asked Gottlieb and one of his younger partners, Marc Misthal, to walk us through the basics of copyrighting, trademarking, and patenting. We picked five of our favorite products from last spring's International Contemporary Furniture Fair and had the lawyers analyze them as hypothetical case studies. (Their comments were based only on the short descriptions and photos we supplied.) A glossary of legal terms (below) serves as a mini primer; for additional information, designers can request a free copy of the firm's booklet, *An Introduction to Intellectual Property Protection in Fashion*, by calling (212) 684-3900. ■



**GEORGE GOTTLIEB
& MARC MISTHAL**
Gottlieb and Misthal are partners at Gottlieb, Rackman & Reisman, one of the leading intellectual-property law firms in the country.

Glossary of Legal Terms

These are the five basic categories of copyright protection, listed in order from the least expensive and difficult to the most. Note: trade dress does not apply to any of the products we reviewed, but we list it because it's an important legal concept.



COPYRIGHT

Copyright protects the "artistic" aspects of a product but not its functional elements. It can protect, for example, fabric prints, jewelry, some furniture, some product packaging, Web sites, textiles, designs or images on the surface of shoes and other accessories, software, and photographs. It does not protect ideas. Instead, it protects the manner in which an idea is expressed. A valid copyright is good for the life of the creator plus 75 years.



TRADEMARK

Trademarks can include words, slogans, logos, and designs. They enable customers to distinguish between goods or products of different companies in the marketplace. As long as they remain in use, trademarks are good forever.



DESIGN PATENT

Design patents protect the "ornamental" design of any product or component of a product so long as the design satisfies three basic requirements: (1) the design must be "new"; (2) the design must be "nonobvious" compared to prior known designs in the marketplace or in prior patents; and (3) the design must be ornamental and not solely functional. Design patents remain in effect for 14 years.



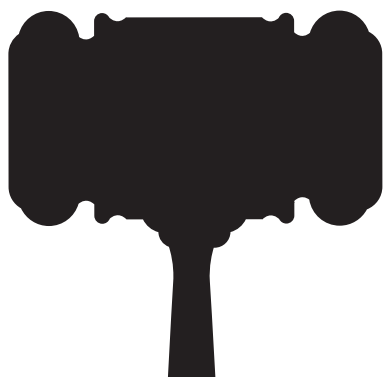
UTILITY PATENT

Utility patents protect the functional or utilitarian aspects of a new product or method that is non-obvious. This patent will protect only the nonobvious differences between the invention and prior inventions. Trivial differences between a new product design and the prior art are not patentable. Chemical processes can also be protected. Utility patents are good for 20 years from the date of filing.



TRADE DRESS

Trade dress is the "look" of an article or its packaging. The blue Tiffany box and Coca-Cola's bottle are notable examples. Trade dress does not protect functional elements. It is the most difficult form of protection to obtain. This is why we didn't address it in relation to the products that follow. If any of those items become well enough known in the future, they might be eligible for trade-dress protection and might even become registered trademarks.





COPYRIGHT

This product is in all likelihood protectable by copyright, since it's in the manner of a modernist sculpture. "It looks like an 'artistic' work, in the legal sense, in that it has form, three-dimensionality, open and closed spaces," Gottlieb explains. It should be registered with the Copyright Office, which can be done directly by the designers without an attorney: www.copyright.gov.



TRADEMARK

The term "Swarm" should be searched for any conflicts, and if there are none, it should be registered as a trademark in the USPTO. "This trademark would only apply for, say, a room divider," Misthal says. "If someone wanted to do Swarm Dog Food, or Swarm Bug Repellent, they could. A great example here is 'Delta.' You have Delta Airlines and Delta Faucets. They coexist because their spheres don't really intersect."



DESIGN PATENT

If for any reason copyright protection is not granted, a design-patent application could be filed on this product.



UTILITY PATENT

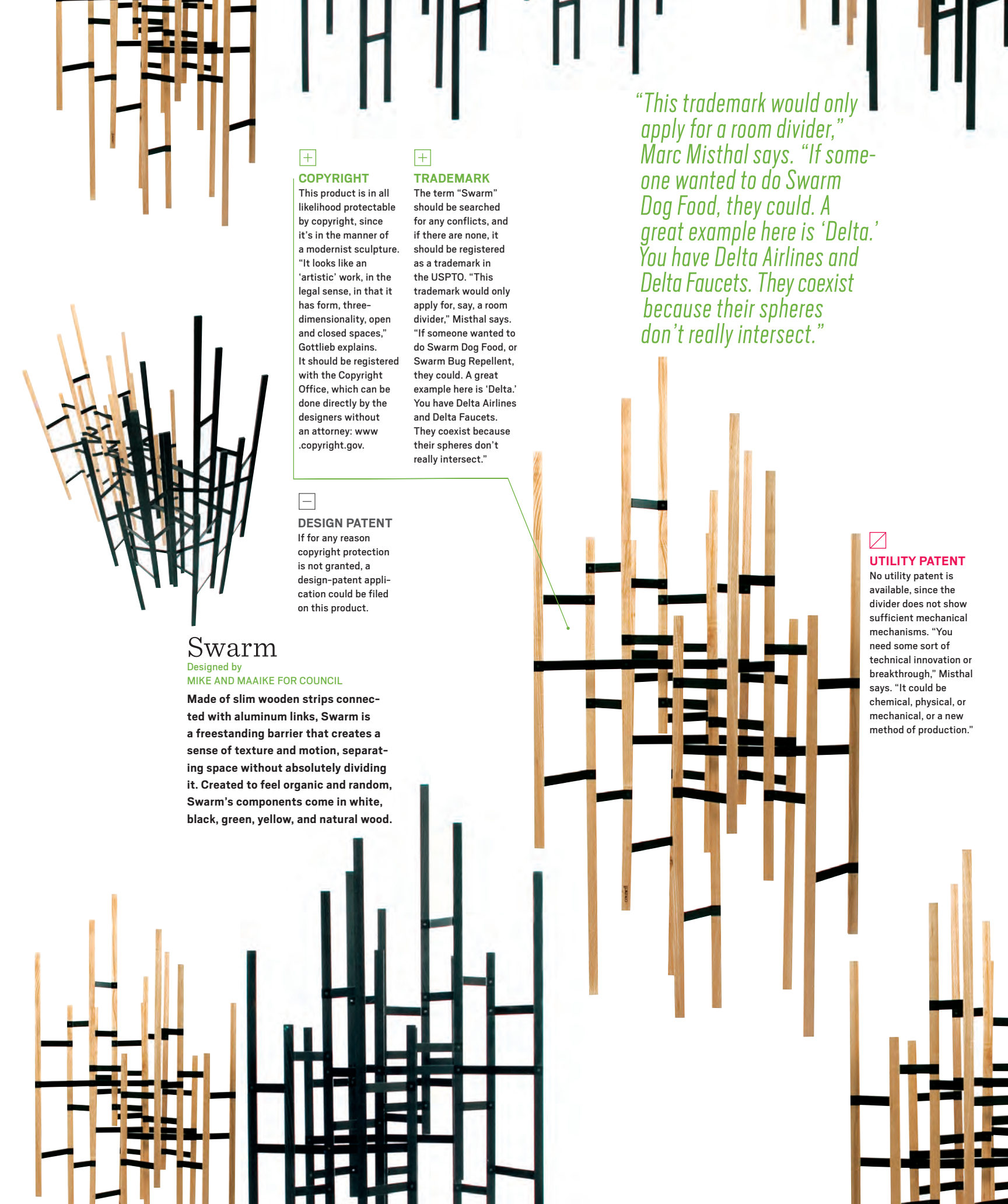
No utility patent is available, since the divider does not show sufficient mechanical mechanisms. "You need some sort of technical innovation or breakthrough," Misthal says. "It could be chemical, physical, or mechanical, or a new method of production."

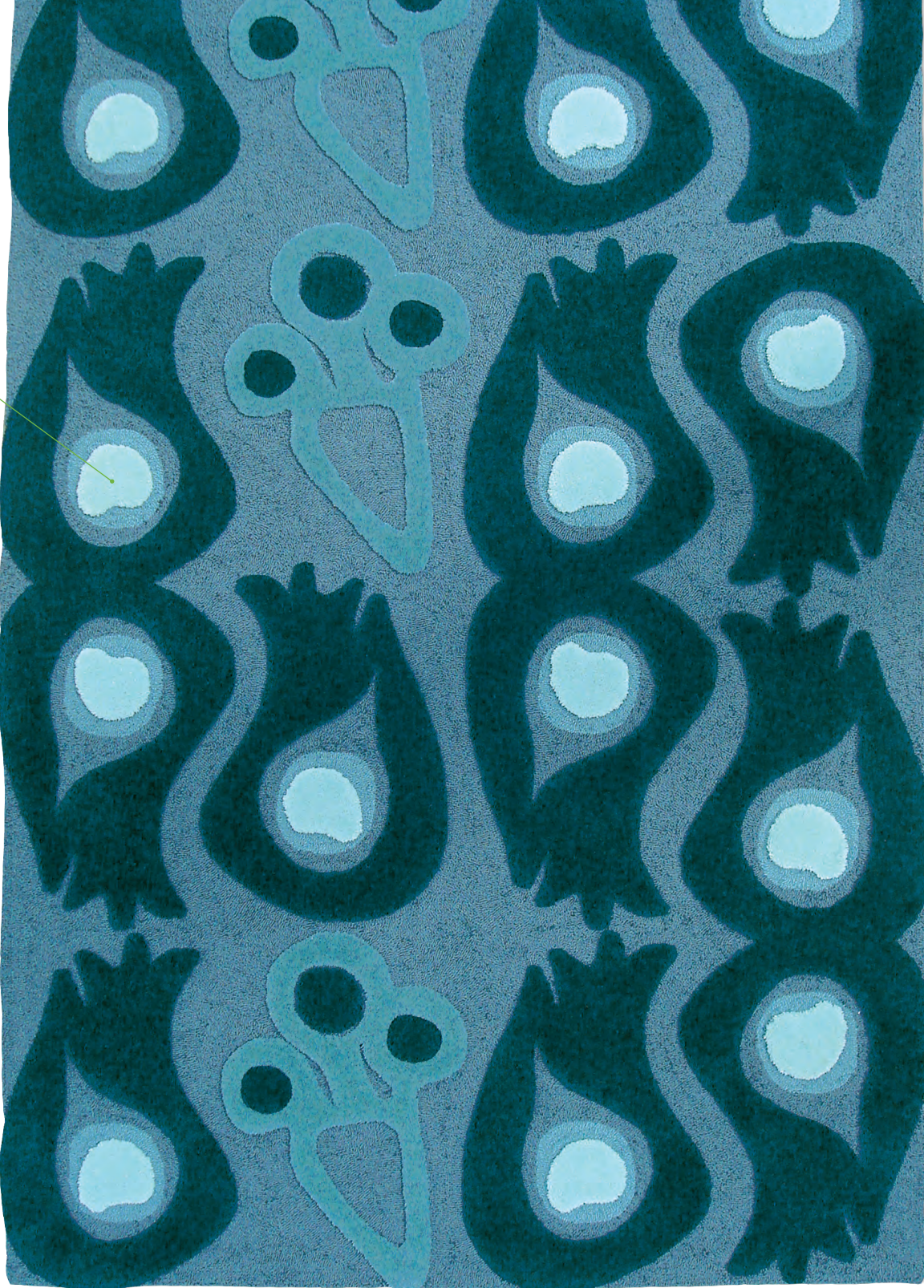
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Swarm

Designed by
MIKE AND MAAIKE FOR COUNCIL

Made of slim wooden strips connected with aluminum links, Swarm is a freestanding barrier that creates a sense of texture and motion, separating space without absolutely dividing it. Created to feel organic and random, Swarm's components come in white, black, green, yellow, and natural wood.





COPYRIGHT

Copyright is available for the design shown on the rug and is probably the best way to protect it, because there are sufficient “artistic” elements here that would make it copyrightable. “This is one person’s interpretation of a peacock, and that’s protectable,” Misthal says. “They couldn’t prevent someone from doing another type of peacock, but they could prevent someone from copying theirs.”



DESIGN PATENT

A design-patent application probably could be filed for this product, but copyright would afford better protection because it has a longer duration and is less expensive to obtain. “There is a \$35 government fee to file,” Misthal says. “Copyright is pretty simple to get. It takes about three to six months if you do it electronically and is very effective protection.”



TRADEMARK

The name “Peacock” should be searched to make sure that there are no conflicts, and if the search is clear, a trademark application should be filed. “To obtain a trademark registration takes on average about a year to a year and a half from the time you file in the USPTO office,” Misthal says, “but before that you have common-law usage rights.”



UTILITY PATENT

Unless the rug is made from a novel fabric or with a unique weaving technique, no utility patent is available here. “A utility patent can take a few years—about one and a half to three years on average, at a minimum—to obtain,” Misthal says. “It’s a very slow process compared to copyright and trademark.”

Peacock Rug

Designed by
BALANCED DESIGN

This machine-tufted area rug debuted at ICFF and was made in Alabama of 100 percent New Zealand wool. It has a cut-and-loop pattern, allowing for height changes, and the size and color can be customized.

Copyright is available for the design and is the best way to protect it. “This is one person’s interpretation of a peacock, and that’s protectable,” Misthal says.



COPYRIGHT

Protection is generally not available for most furniture, since the Copyright Office does not consider chairs to have "artistic" merit in the legal sense of the word. Chairs are thought of as utilitarian and therefore not subject to copyright protection. "This is not a judgment call by the Copyright Office on the value of the chair," Gottlieb says. "It's the legal rules under which they operate. On the other hand, if you had a printed design on the back of the chair, that design is copyrightable. But it's the print design, not the chair."



TRADEMARK

The term "Barrington" should be searched to make sure there are no conflicts, and if there are none, the term should be registered as a trademark in the USPTO.



Barrington Chair

Designed by
STUDIO DUNN

This chair, made of American hardwoods such as walnut, cherry, or maple, combines traditional and contemporary manufacturing methods and has a bentwood backrest to ensure comfort and good posture.

"There's a huge examining corps at the United States Patent and Trademark Office, and a little subgroup does design," Gottlieb says.



DESIGN PATENT

This product is eligible for design patent protection as long as the design is "new" and "nonobvious" in the eyes of the examiner at the USPTO. "There's a huge examining corps at the USPTO, and a little subgroup does design," Gottlieb says. "Another group does, say, carburetors; another does chemicals."



UTILITY PATENT

A utility patent is not available here, as there are no mechanical features. "If the chair had an innovative joint, say, or a unique method of construction, you could get a utility patent on those aspects," Gottlieb says.

Ikebana

Designed by
PETER STATHIS

The Ikebana flat-panel LED light draws its inspiration from the traditional Japanese art form of flower arranging. It uses proprietary radial flat-panel LED technology and has a light head that can be adjusted a full 360° as well as variable height control.



COPYRIGHT

Copyright is probably obtainable, due to the flower portion of the lamp. "The reason we say 'probably' is, although it's 'artistic,' it's kind of simple," Gottlieb says. "You can't claim copyright for circles or squares or geometric forms, because they're going to say, 'It's old and not original.'" Misthal adds, "But the floral design here at the top and the design at the base are probably enough to get it through."



TRADEMARK

Trademark is probably available for this product. "Ikebana means 'floral arrangement' in Japanese," Gottlieb says. "We got Akari—'light' in Japanese—approved as a trademark for Noguchi. So I think this one is registerable."



DESIGN PATENT

If no copyright is available, the product can be protected by a design patent, as long as the application is filed within one year of any trade or public showing.



UTILITY PATENT

This could be examined in connection with the LED technology and the way the lamp arm connects with the vertical strut. "However, if they bought the technology from someone else, they couldn't get a utility patent on it, but the originator might be able to patent it," Gottlieb says.

"Ikebana means 'floral arrangement' in Japanese," Gottlieb says. "We got Akari—'light' in Japanese—approved as a trademark for Noguchi. So I think this is registerable."

“Design and utility patents must—capital M-U-S-T—be filed within one year of any trade or public showing,” Gottlieb says. “This is a crucial rule for all design and utility patents.”



COPYRIGHT

Protection is not available for this product, since the overall design is primarily ornamental and functional. The design does not contain any “artistic” expression that could be protected by copyright.



UTILITY PATENT

Not available here, since the product does not appear to have a novel lighting or support system. “Now, if the chemical make-up of the finish or the method of application was unique, those could be protected by utility patents,” Misthal says.



DESIGN PATENT

This is the best type of protection for this product, since the design appears to be both new and nonobvious. “Design and utility patents must—capital M-U-S-T—be filed within one year of any trade or public showing,” Gottlieb says. “This is a crucial rule for all design and utility patents.”

F/K/A Table Lamp

Designed by
JONAH TAKAGI

The F/K/A derives some of its form from the repurposed saucepan that originally served as the shade. The theme of versatility continues with tripod legs that accommodate uneven surfaces. The diffuser produces a soft glow, while the pull cord adds a hint of nostalgia.



TRADEMARK

Only the product name, F/K/A, could be protected as a trademark. The name should be cleared through a search and, if available, registered in the USPTO.