

Intellectual Property Protection for the Apparel Industry

by Hani Z. Sayed and Susan Barricella, Rutan & Tucker, LLP

U.S. intellectual property laws afford various types of protection for certain aspects of the apparel industry, some obvious, some not so obvious. Understanding the different areas of intellectual property law is vital to pursuing the most effective protection and enforcement options. The three areas of intellectual property law are patent and trademark, rights to which may be registered with the U.S. Patent and Trademark Office ("USPTO"), and copyright, rights to which may be registered with the U.S. Copyright Office. Registration is not necessarily required to obtain intellectual property rights. Trademark and copyright law recognize common law rights.

Design Patent Protection

As far as apparel is concerned, the most relevant form of patent protection in the U.S. is for new, original, and ornamental design for an article of manufacture, which is referred to as a design patent. U.S. design patents protect ornamental characteristics of a particular article, such as an article of clothing. Since a design is manifested in the appearance of a particular article, the subject matter of the design patent may relate to the configuration, the particular article itself and/or the combination of both the configuration and the article itself. Design patent protection is only available for new and non-obvious ornamental design which can include ornamental impressions, prints, or pictures that are applied to or embodied in the arti-

cle. Design patent protection may be granted to non-functional aspects of clothing including different designs on apparel, bags, footwear and other accessories to protect the unique designs and configurations of that clothing. For example, the United States Marine Corps owns design patents for the unique camouflage designs on their combat uniforms. Another advantage in filing of a design patent, is the ability to utilize the terms "patent pending" or "issued patent," where appropriate.

U.S. trademark law affords a trademark owner with exclusive rights to a word, name, symbol, device, texture, shape, color, 3-dimensional object, sound, scent or color that is used in trade with particular goods (or services) to indicate the source of the goods. Trademarks must identify a single source of the relevant goods. Most people are familiar with trademarks as store names, brand names, logos and even product model names. Scents and colors may be afforded protection in connection with goods if, like other trademarks, they are source-identifying and also do not serve a functional purpose. The distinctive blue color used by Tiffany and Company is familiar to most people (U.S. Registration No. 2184128). A peppermint scent used in connection with office supplies such as file folders is a registered trademark (U.S. Registration No. 3140700).

Trade Dress

Some types of trademarks are more accurately categorized as trade dress. Trade dress may refer to the total image and overall appearance of a business or product, or a particular feature such as size, shape, color combinations, texture, graphics, or even particular sales techniques. As applied to the apparel industry, trade dress protection should be considered for a distinctive look and feel of a retail store, packaging, point of sale display, or a particular nonfunctional feature of an item of apparel, all of which have been afforded protection as trade dress in certain circumstances. For instance the design on the sole of a shoe (U.S. Registration No. 3258103), a blue line located on the toe of a sock (U.S. Registration No. 3428543), the shape and location of a label on the outside of a garment (U.S. Registration No. 3589099), or the stitching on the back pockets of a pair of jeans (U.S. Registration No. 3551980) are all registered with the USPTO.

As mentioned above, subject matter that qualifies for trade dress protection must be non-functional. Functionality is determined primarily by whether affording one party exclusive rights would put competitors at a significant disadvantage, unrelated to reputation. In addition, in order for any trademark or trade dress to warrant protection under the law, it must be either inherently distinctive, meaning that it is so arbitrary as to be source-identifying from its inception, or have acquired distinctiveness through a significant period of continuous and exclusive use in connection with the subject goods.

As useful articles, garments are generally not afforded copyright protection. Fashion designs manifested in garments are afforded protection under U.S. copyright law if, and only to the extent that, a design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. Generally speaking, copyright law protects original works of authorship, namely, the expression of ideas, and provides owners of such works with certain exclusive rights. Works subject to copyright protection include those such as literary, musical, dramatic, motion picture and architectural works. As mentioned above, some aspects of copyright law are relevant to the apparel industry, namely, the protection of pictorial, graphic and sculptural works. Drawings of designs are protectable, but such protection does not extend to the actual garment. However, elements that are conceptually separable from the utility of a design are protectable. Examples of such separable elements are belt buckles, appliques, embellishments, lace patterns, and fabric designs, meaning the actual color and print of fabric.

While any one area of intellectual property law may be inadequate to fully protect all facets of apparel, and some facets are simply not protectable, the most effective protection is obtained from combining the rights available under each area of intellectual property law. Outside of the intellectual property realm, there are additional laws to protect rights that are associated with the apparel industry, including laws prohibiting passing off or unfair competition, and misappropriation.

PROTECT YOUR INTELLECTSM

GROW | MANAGE | PROTECT

Luce Forward's Technology Law Group (TLG) offers much more than traditional patent attorneys. We help our clients identify and build their intellectual property, then protect it in the U.S. and across the globe.

We are experienced at working with clients at any level, from managing a mature IP portfolio to outlining a framework. We grow valuable IP portfolios based on good business and IP metrics. And we do this knowing that value in a malleable concept depending on whether the goal is fund raising, patent enforcement or defense against competitors.

LUCE FORWARD

WWW.LUCE.COM

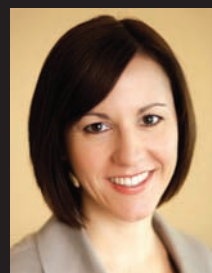
2050 MAIN STREET • SUITE 600 • IRVINE, CA 92614 • 949.732.3700

SAN DIEGO • SAN FRANCISCO • LOS ANGELES • ORANGE COUNTY • CARMEL VALLEY / DEL MAR • RANCHO SANTA FE



Hani Z. Sayed

Hani Z. Sayed is a partner in the Intellectual Property section of Rutan & Tucker, LLP, where his practice emphasizes intellectual property prosecution and litigation, with particular emphasis on patent, trademark and copyright prosecution. Mr. Sayed has extensive experience in IP licensing, development and due diligence along with analysis and opinion work and can be reached at hsayed@rutan.com.



Susan Barricella

Susan Barricella is a partner with Rutan & Tucker specializing in intellectual property and her clients range from individuals and privately held businesses to publicly traded companies. The industries in which her clients do business include technology, e-commerce, textiles, apparel, sporting equipment, real estate, food service, food and beverage, gaming, advertising, retail, art, construction, telecommunications, and home décor and can be reached at sbarricella@rutan.com.