

INSIGHT®

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This newsletter is provided with our compliments. Its purpose is to inform our readers of developments within the firm and in the legal field of intellectual property law. We invite your comments, questions, and opinions.

Securing Valuable Design Protection for Consumer Products

by Joshua L. Cohen



The following article is an excerpt from an article first published in the Corporate Counsel Supplement of *The Legal Intelligencer* and *The Pennsylvania Law Weekly* on

December 2, 2002.

Mammoth resources are required to launch new consumer products. Engineering efforts produce a consumer product that performs while industrial designers add consumer appeal to the product and marketing campaigns bring the resulting product to the attention of consumers. The commercial success (or failure) of such

consumer products therefore depends not only on the way they function but also on their form and aesthetic appeal.

Strong intellectual property protection for consumer products can prove to be a valuable and long-lasting asset. Caution is required, however, in reconciling the tension between the process of consumer product design, during which form and function are blended, and the various modes of intellectual property protection, which tend to pit form against function. To enhance and extend design protection, intellectual property strategy,

design management, and marketing management must be coordinated from the outset.

The Design Process

Industrial designers enjoy friendly debate over the notion that form follows function. It is seen by some as an admonition that designers must first consider how a product works and then consider its appearance. Others view "form follows function" as a law of nature—a pleasing appearance will naturally follow if a product is designed to function well.

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Harrie Samaras, Former Corporate Counsel, Joins RatnerPrestia



Harrie Samaras, most recently Vice President Intellectual Property, Legal at Elan Drug Delivery, Inc. and formerly Director of Intellectual Property Litigation with MCI WorldCom, Inc., has joined RatnerPrestia. Harrie will use her litigation experience and her corporate perspective to assist corporations in resolving IP disputes by litigation, or preferentially by alternatives to litigation. In the latter role, she will head the Firm's new Alternative Dispute Resolution Group, which will include ADR-specific client counseling, objective liability assessment and avoidance, and applying IP-specific

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Coordinating Enhanced IP

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There is no debate, however, that virtually all consumer products are characterized by features that perform a function and by features that provide a pleasing form. Ideally, consumers should not be able to easily discern where form begins and function ends.

This seamless blend of form and function is often reflected in product promotions. Cadillac advertises its Escalade as "*The Fusion of Design & Technology*." David Yurman calls his designer watches "*A Fusion of Art and Science*." Even the toilets of Toto Ltd. are advertised as "*Performing Art*."

Design Protection

While industrial designers blend form into function, the legal modes available for protecting consumer products erect a barrier between the two. On one hand, a product's function, as embodied in its useful features, can be protected for a limited period of time by obtaining a utility patent. On the other hand, protection is also available under our intellectual property laws for the ornamental features of a product's form (i.e., the three-dimensional contours and shapes that define a product's configuration and overall appearance but that are not critical to its function). Specifically, design patents are often used to protect, also for a limited time, a product's ornamental configuration.

Non-functional features also include those elements of a product's form by which consumers can identify the source of the consumer product. Such non-functional features may thus serve as trademarks, to the same extent as words and logos, or as protectable trade dress. With respect to product configurations in particular, trademark and trade dress protections are available for any non-functional element of a product's configuration that has acquired a "secondary meaning" in that its primary significance is to identify the source of the product as opposed to the product itself in the minds of the consuming public. Unlike utility and design patents, however, trademarks and trade dress do not expire so long as they continue to identify a product's source.

Non-functional elements of a

consumer product's configuration can enjoy dual or overlapping protection through design patents and potentially long-lasting trademark and trade dress protections. Trademark protection is not precluded for product configurations that were once protected by a design patent even after the design patent expires. For example, Honeywell International Inc. still enjoys trademark protection for the configuration of its dome-shaped thermostat cover despite the fact that the design patent for that thermostat cover expired long ago in 1970.

Utility patents are therefore available to protect those features that are deemed functional. Design patents, trademarks, and trade dress, however, are reserved for those non-functional features that make up a product's form.

An Integrated Approach to Design Protection

Coordinated efforts to protect the fruits of costly product development can give rise to valuable rights that may otherwise be compromised or lost. An integrated campaign to enhance and extend intellectual property protection for consumer products should involve at least:

- Coordinating the efforts of design management, intellectual property counsel, and marketing leadership with respect to the launch of a consumer product and the procurement of intellectual property protection for that product.
- Guiding designers to affirmatively introduce features into the configuration of the consumer product that can give rise to future trademark and trade dress protection.
- Segregating those features of the consumer product that are primarily functional from those that are primarily ornamental.
- Taking a consistent position in marketing programs throughout the life of the consumer product with respect to which features are primarily functional and which are primarily ornamental.
- Avoiding the attribution, by intellectual property counsel and marketing management, of functions to features that are primarily ornamental or capable of source identification.
- Establishing a clearinghouse for the review of designs proposed for

Speaker's Forum



• Kevin Casey was invited to speak before the Chester County Freelancer's Association on Trademark and Copyright Legal Principles. Kevin is an Adjunct Professor at the Temple University Law School and speaks regularly to groups on intellectual property matters. He also has authored numerous papers on the subject of intellectual property, as well as on the subject of Alternate Dispute Resolution (ADR).



• RatnerPrestia shareholders, Benjamin Leace and Kevin Casey, teamed up to present a discussion on intellectual property aspects of technology transfer agreements to Saul Ewing's Business Practice Group on April 8, 2003. Saul Ewing is a large general law firm. Issues presented included IP audits and due diligence prior to an agreement, sublicensing rights, ownership of improvements, indemnification and antitrust issues, to name just a few. Such considerations are important because many times specific IP laws trump contractual obligations which might on their face seem acceptable and legal. ■

a consumer product, the marketing materials proposed to promote the consumer product, and the utility and design patent applications proposed to protect that product.

Management should be actively involved in coordinating these efforts. Assuming that an integrated program is established, companies can continue to promote their consumer products as "*A Fusion of Art & Science*" yet preserve the distinction between form and function that is necessary to secure valuable intellectual property rights. ■

35 U.S.C. §102(e)

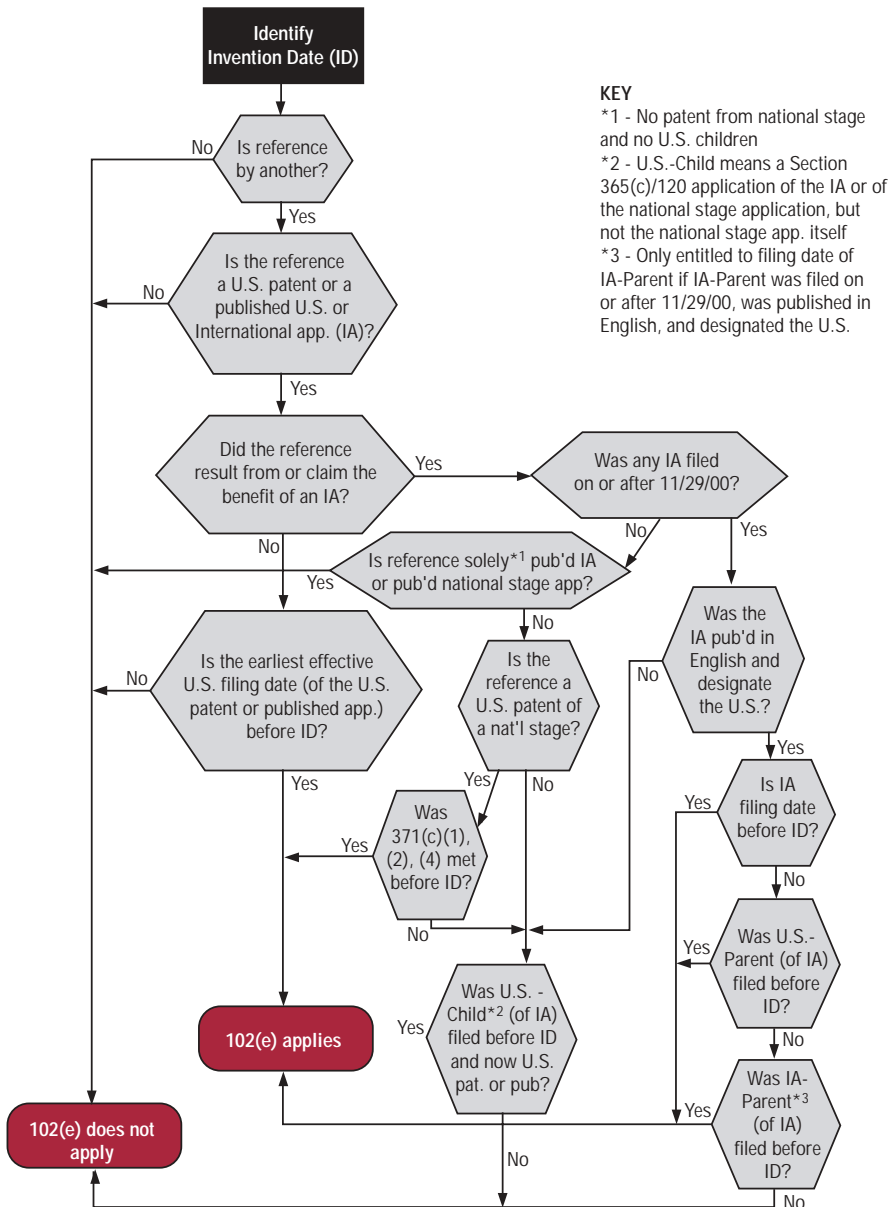
An important provision of U.S. patent law was recently changed by the American Inventors Protection Act of 1999 and the Intellectual Property and High Technology Technical Amendments Act of 2002. This provision, 35 U.S.C. § 102(e), formerly permitted only U.S. patents to be applied as references, effective as of their filing date in the U. S., against a co-pending patent application. With some exceptions, the new law provides that published U.S. patent applications and published international applications, in addition to U.

S. patents, are eligible as prior art references under Section 102(e). Moreover, references under Section 102(e) are now effective as prior art references as of the earlier of the U. S. filing date or, if published in English, their international filing date.

The possible scenarios for this procedure are shown graphically in the accompanying flow chart. Although the flowchart definitely falls into the “do not use this at home” category, a broad view of the flowchart reveals some interesting generalities. The first decision block, posing the question “Is the reference by another?” shows that both the new and old law require that the reference must have a different inventive entity than the subject application for Section 102(e) to apply. The very next decision block reveals that, if the reference is something other than the three types listed, then Section 102(e) also does not apply. Such references not applicable under Section 102(e) include, for example, a Canadian patent, a Japanese published patent application, or an article from a journal. The flowchart also reveals the significance of whether the reference is based on an international application and, if so, the filing date of that international application.

In several scenarios, the flowchart prompts the reader to consider whether a related U.S application or previously filed international application satisfies the provisions of Section 102(e) even if the subject reference does not (see the lower right portion of the flowchart). The final test of determining whether Section 102(e) applies is whether the “102(e) date” of the reference is before the invention date of the subject application. The invention date is, at least in the first instance, the priority date of the subject application.

It is important to remember, however, that when seeking to invalidate a patent, other provisions of 35 U.S.C. § 102 might be more useful in using an earlier effective date for certain subject matter. In addition, it should be noted that a fairly recent amendment to the law on obviousness (35 U.S.C. § 103(c)) prohibits an examiner from using a reference which only qualifies as prior art under three subsections of Section 102 (including Section 102(e)), so long as the reference was commonly assigned, or subject to an obligation to assign, to the same owner as the subject application.





Every year, RP sponsors the Philadelphia Bar Association Charity Run which benefits the American Diabetes Association and the Support Center for Child Advocates. Last year, we took first in the male competition. The winning team members were: Kevin Casey, Ken Nigon, Chris Lewis and Kevin Goldstein this year. ■

Design Registrations in Europe Change

Effective April, 2003, only one application needs to be filed in order to protect designs across Europe. Somewhat analogous to the Community Trademark system, the Registered Community Design system offers protection of designs throughout the European Union (EU) for both two-dimensional and three-dimensional designs. Unlike the design patent system of the United States, protection of designs under the Community Design system is not limited to just aesthetic designs. Duration of the registration can extend up to 25 years, and remedies under the

system include injunctive relief across the EU with a single action.

RatnerPrestia has long helped its clients obtain effective IP protection in Europe, and having established many European associates over the years, we are easily able to help you determine, and obtain, appropriate protection for your designs in Europe, and throughout the world. In addition to harmonizing Europe's IP laws, this new system provides your company with a new option for protection of your valuable designs. ■

Shahri Nagshineh, founder and president of ESC Inc. was given the "Entrepreneurial Achievement Award" by Ben Franklin Technology Partners during the recent ixchange 2003 Innovation Awards program at Zoellner Arts Center on the Lehigh University Campus. ESC Inc. is a client of the firm. To date, the firm has obtained two patents for ESC Inc. relating to cleaning compositions for cleaning microelectronic substrates for

post-CMP or via formation cleaning. The award is presented to "The person or company that best exemplifies quintessential entrepreneurial spirit or a combination of ingenuity, hard work, and innovation that has resulted in the creation of a successful and growing business venture." RatnerPrestia offers its congratulations to ESC, and is pleased to have played a role in moving ESC into its prominent position.

Announcing

- Jacques L. Etkowicz has been elected as a Shareholder of the Firm. Before starting as a law clerk with RatnerPrestia, Jacques worked for the United States Navy, first as a Research Laboratory Design Supervisor for Advanced Airborne Communications Systems, and then as a Team Leader for Presidential Helicopter Programs. He is a member of the American Bar Association, the Federal Circuit Bar Association, the Pennsylvania Bar Association, the Philadelphia Bar Association and the Chester County Bar Association. He is also a member of the American Intellectual Property Law Association, Electronics and Computer Law Committee, the Philadelphia Intellectual Property Law Association, Computer Law Committee, The Benjamin Franklin American Inn of Court, and the Institute of Electrical and Electronics Engineers.

- Stephen J. Weed has joined the firm as an Associate. Formerly with Synnestvedt & Lechner LLP, Stephen specializes in intellectual property matters that relate to electrical, electro-mechanical, and computer science arts. His areas of expertise include analog and digital circuits, telecommunications, and computer software. He will be resident in the Valley Forge office. Stephen holds an undergraduate degree in electrical engineering from Iowa State University, and earned his law degree from Wayne State University Law School. While attending law school, he was employed as a Lead Analyst for Electronic Data Systems in Southfield, Michigan. He is admitted to practice in the United States Patent & Trademark Office, and is admitted in Michigan and Pennsylvania. He is also the Chairman of the Malvern Borough Planning Commission and belongs to the Philadelphia Volunteer Lawyers for the Arts.

- Basil S. Krikelis has re-joined RatnerPrestia as an Associate in the Wilmington office. Mr. Krikelis will practice in all areas of intellectual property, including corporate transactional matters. Previously,

as an associate of the firm, Basil represented DCV Inc., a DuPont spinoff, which he then joined as Chief Patent Counsel. In 2001, he moved with the management of DCV to form a new life sciences company, Arkion Life Sciences LLC, which he served as Chief Patent Counsel. In that capacity, he supervised a patent portfolio of over 600 U.S. and foreign patents and applications. Before entering the legal profession, Basil was a scientist with DuPont and DuPont-Merck Pharmaceutical Company. He is admitted to practice in Illinois, the U. S. Patent Office and he is a member of the American Intellectual Property Law Association and the American Bar Association. He received his J.D. from John Marshall Law School and his B.S. in Biology/Genetics from Purdue University.

- RatnerPrestia Shareholder Benjamin E. Leace was one of the lecturers at the International Trademark Association's Philadelphia seminar entitled, "Trademarks 101: Fundamentals." This one-day program was offered in various cities throughout the U. S. on October 21 by INTA.

- Kevin R. Casey chaired The Federal Circuit Bar Association's Fifth Bench and Bar Conference this year. Kevin led the Program Committee in arranging a comprehensive program that included the Chief Judge and nine Federal Circuit judges, as well as judges from other federal courts, and officials of several government agencies.

- Bruce Monroe's article, "Patents, Trademarks & Roses," was published in the American Rose Annual which is published by the American Rose Society.

- Ken Nigon published an article, "The New Written Description Requirement" in The U. S. Patent and Trademark Office Journal. Portions of the article, which discussed how the written description requirement is being used to construe patent claims, appeared in the previous issue of Insight. ■

Samaras Joins RatnerPrestia

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expertise to the role of ADR neutral.

Prior to joining MCI, Harrie was in private practice with firms in California and Virginia where she counseled clients in protecting and enforcing their IP rights and represented clients in a wide range of litigation matters. In corporate practice, Harrie built and managed in-house IP practices, developed IP asset management strategies and IP policies, prepared and negotiated agreements and counseled clients in all areas of IP. She has also been a counselor and advocate on behalf of clients in ADR processes and she has served as a neutral in such processes.

Harrie's experience also includes working on staff at the United States Court of Appeals for the Federal Circuit as the Deputy Senior Technical Assistant to the Court and as law clerk to then

Chief Judge Helen W. Nies. She began her IP career as a Patent Examiner in the biomedical arts at the U. S. Patent and Trademark Office.

Harrie holds a Masters of Law degree in Patent and Trade Regulation Law from The George Washington University National Law Center, and a Juris Doctor degree from The University of Baltimore School of Law. She also holds Masters and Bachelor of Science Degrees from the University of Maryland in the life sciences.

Harrie has been active in a number of professional associations including the American Intellectual Property Law Association, in which she is a former Treasurer and member of the Board of Directors. She has also chaired the Association's Finance Committee and its committees on Membership, Professional Responsibility,

Communications Law and IP Law Associations, and served on the Association's Public Appointments and Nominations Committees.

In announcing Harrie's new association with RatnerPrestia, the firm's Management Committee Chair, Paul Prestia, made it clear that Harrie has been enthusiastically accepted into the firm because her commitment to assisting clients in resolving disputes promptly and cost-effectively was entirely in keeping with the firm's long-standing objective of helping clients develop, protect, manage and profitably exploit their IP positions in a business-like way. As he summed it up, "With Harrie's professional stature and her personal qualities, she will be a great asset to anyone trying to navigate their way through the increasingly more complicated world of intellectual property." ■

RatnerPrestia specializes in patent, trademark, and copyright matters and realizes an obligation to keep its clients, and others, informed in those areas. The articles in this newsletter are intended to provide only a brief, general overview of each subject and are not necessarily the opinion of this firm. Nothing herein should be construed as legal advice. RatnerPrestia recommends that readers seek specific information and/or legal advice on particular matters of concern.

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VALLEY FORGE
Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482
Ph (610) 407 0700
fx (610) 407 0701

WILMINGTON
Suite 1100, Nemours Building
1007 Orange Street
P.O. Box 1596
Wilmington, DE 19899
Ph (302) 778 2500
fx (302) 778 2600

ALLENTOWN
Suite 265
Commerce Corporate Center
5100 Tilghman Street
Allentown, PA 18104
Ph (610) 530 8100
fx (610) 530 8200

Email: insight@ratnerprestia.com • www.ratnerprestia.com