

Protecting Fashion with Design Rights in the United States and European Union

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Intellectual property (IP) rights are ubiquitous, encountered in all walks of life and industry. In the fashion industry, design rights are an often overlooked source of protection for creativity. This article provides a comparison of the U.S. design patent process with the EU's registered Community design system, highlighting differences and analyzing implications to the fashion industry.

U.S. Design Patents

A design patent is available to “[w]hoever invents any *new, original* and *ornamental* design for an *article of manufacture*.” ¹ The invention must also overcome the *nonobvious* inquiry laid out in 35 U.S.C. § 103. In sum, there are five substantive requirements for U.S. design patents: the design must be (1) new, (2) original, (3) ornamental, (4) nonobvious, and (5) for an article of manufacture. If these elements can be met, there are certain procedures that applicants must also follow to apply for a design patent with the U.S. Patent and Trademark Office (USPTO). Obtaining a design patent gives its owner the right to exclude others from making, using, selling, or importing the article embodying the patented design for 15 years. ²

Substantive Requirements

New. The design must be new, commonly described as “novel.” The standard for novelty is the “average observer test.” ³ In the eyes of an average observer, the overall appearance of the design must be different from the appearance of any other single prior design. ⁴ For example,

a design sufficiently new to obtain design patent protection would be a watch face devoid of all hour indices except for a dot at the twelve o'clock position.

Original. Originality bars patents for designs derived from any source or person other than the named inventors. Any simulation of known objects, persons, or naturally occurring forms will not pass. Nevertheless, a design can be original even if it is the result of a “reassembling or regrouping of familiar forms and decorations.” (5)

Ornamental. This requirement is a murky, hotly debated topic. Early 20th century courts held that “ornamentality” requires the design to be aesthetically pleasing, attractive, the product of an artistic conception, “embellished or adorned, or distinguished by its grace or symmetry of form.”

(6) Since that time, U.S. jurisprudence has broadened that definition: today, “[t]o qualify for protection, a design must [simply] present an aesthetically pleasing appearance that is not dictated by function alone.” (7) The design cannot be essential to the use of the article. Perhaps the best way to put it is this: A blue teapot does not have to be blue to brew, boil, or pour; but it looks nice. To continue the watch analogy, the patent could not claim the function of the dot at the twelve o'clock position, but only the dot itself and its appeal to the eyes.

Nonobvious. The relevant standard for nonobviousness is whether a designer of ordinary skill of the articles involved would have found the design to be obvious at the time of invention. (8) This may involve two routes of inquiry: (1) pointing to “something in existence, the design characteristics of which are basically the same as the claimed design,” will render a design obvious; (9) or (2) if no comparable article existed at the time of invention, showing that the claimed design is an obvious combination of previously known elements, which requires a finding of “some teaching or suggestion whereby it would have been obvious to a designer of ordinary skill to make the particular selection and combination,” will render a design obvious. (10) For example, when comparing two loafers and even setting aside any similarities as to the overall shape and design, a pair of shoes made of calf hair as opposed to knitted material is not considered obvious.

Secondary considerations, such as commercial success, may rebut obviousness. However, “evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not to some other factor, such as a better recognized brand name or improved function.” (11) An invention’s commercial success may demonstrate significant qualitative differences over the prior art. If the claimed invention had been obvious to one of ordinary skill in the art, there is a presumption that someone else would have brought it to the market sooner.

(12) To rely on commercial success as evidence of nonobviousness, the patent owner must show

a connection (often referred to as a nexus) between the commercial success and the novel aspects of the claimed invention. (13)

Article of manufacture. An article of manufacture is a tangible object made by humans. The design must be inherent in, or applied to, a human-made, tangible object. A design or picture alone is not enough. However, computer-generated icons, such as full-screen displays, are two-dimensional images that are considered surface ornamentation and comply with the article of manufacture requirement. (14) Impressions, prints, or pictures applied to an article of manufacture and alterations to the shape or configuration of an article of manufacture satisfy the requirement. Notably, design protection is not limited to a whole article of manufacture—a design patent may claim only a portion of an article of manufacture. (15)

U.S. Examination Process

Inventors have only 12 months from the first time they introduce their design to the public to file for an application for a design patent. After 12 months, the design will enter the prior art, and it will no longer be considered new, original, or nonobvious for U.S. patenting purposes. (16)

Interestingly, design patent applications can only encompass one claim, while utility patent applications can typically include several claims. The examination process for new design patent applications currently takes between one and three years. Should the patent issue, the patent protection will last for 15 years from the filing date. (17)

During the examination process, a USPTO patent examiner evaluates each invention against the five substantive criteria. Provided the applicant filed within 12 months of public disclosure, the examiner will review the application to ensure it has the following: (1) a preamble, (2) cross-reference to any related applications, (3) a statement regarding federally sponsored research or development, (4) a description of the figure of the drawing, (5) a feature description, (6) a single claim, (7) drawings or photographs, and (8) an executed oath or declaration. (18) If the examiner believes the application falls short of the requirements, the examiner will respond to the applicant with a list of rejections in what is considered a nonfinal office action. The applicant will have the chance to respond to the office action. They can make amendments to their patent or assert arguments explaining why the rejections from the patent office are invalid. If the examiner is satisfied, the design patent will be issued. If the examiner still believes that the application is not ready for issuance, they will issue a final office action rejecting the application. The applicant can appeal this final rejection to the Patent Trial and Appeal Board (PTAB). (19)

There are no maintenance fees associated with a design patent, but applicants are required to pay a filing fee based on the size of their operation. As of the date of this article, the USPTO fees would

be \$1,020 for large entities, \$408 for small entities, and \$204 for micro entities. (20)

European Union Community Designs

In the EU, designs are defined as “[t]he appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.” (21) There are two types of designs: unregistered Community designs (UCDs) and registered Community designs (RCDs). As the name denotes, UCDs do not require an application process. (22) Designs gain UCD classification after being “published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned.” (23) UCDs are protected against intentional copying for three years. (24) The period cannot be extended, and the designation offers no other protection. (25)

On the other hand, RCDs are registered with the EU Intellectual Property Office (EUIPO) and offer protection more akin to U.S. design patents. RCDs must be new and possess individual character. (26) Additionally, RCDs will offer protection against designs developed in good faith, whereas UCDs only offer protection for intentional copies. (27)

For both design classifications, the owner of the design is protected against the manufacture, sale, marketing, and import/export of any product incorporating the design, or to which the design is applied.

Substantive Requirements

Novelty. This requirement is akin to the originality requirement for U.S. design patents. If a design is not identical to publicly available work at the date of filing or disclosure, it is novel. (28) Differences in immaterial details will not satisfy the novelty requirement. (29)

Individual character. Individual character is like the novelty requirement for U.S. design patents, with one difference: the inquiry looks through the lens of an “informed user” rather than an “ordinary observer.” If the “overall impression it produces on the informed user is different from that produced by any other design which has been made available to the public before,” there is individual character. (30) The individual character depends on overall impression, and certain features, including those that are not visible or have a technical function, will be disregarded for the individual character analysis. (31)

EU Process for Registered Community Designs

Like the U.S. process, applicants have one year from public disclosure to file for an RCD. ³² The EUIPO, unlike the USPTO, does not substantively evaluate applications. The three requirements laid out will be assessed only in an infringement suit or upon the filing of a third-party request for review at the EUIPO. ³³ The EUIPO checks that an application correctly identifies the owner and includes an acceptable design representation, product indication (selected from a list of design categories), and fee payment. ³⁴ For online filings, the registration process will be complete “within a couple of days.” ³⁵ RCDs are valid for five years and may be renewed up to 25 years in five-year increments. The filing fee is 350 euros, but one application may contain multiple designs. ³⁶

Comparison of the EU and U.S. Patent Frameworks

Scope of Coverage

The EU registration system has fewer requirements that must be met to obtain a valid design patent. The absence of the nonobviousness and ornamentality inquiries broadens the scope of what may be covered by an RCD. The remaining RCD factors—novelty, product, and individual character—closely mirror the other three factors for U.S. patent designs—originality, articles of manufacture, and novelty. Because nonobviousness and ornamentality have historically been the most burdensome and dynamic doctrines in U.S. design patents, the legal metes and bounds of what justly qualifies as an RCD are less fuzzy than that of U.S. design patents.

The nonobviousness doctrine is particularly detrimental to innovation in the fashion industry. Asking whether an article of fashion would have been obvious to a person skilled in the art is an inappropriate standard for an industry with quick turnover and discretely evolving trends. In a phenomenon called “flocking,” fashion designs often share trend elements while still representing an artist’s individual perspective. ³⁷ While fashion designers solely responsible for ushering in a unique trend should be rewarded with design patent rights for their innovative efforts, the nonobviousness doctrine suppresses the IP rights of other artists who afterward draw inspiration and impart their own character on the mainstream. Daniel H. Brean calls this the “cyclical nature of obviousness.” ³⁸ Brean recognized that the grant rate for design patents over time takes on a cyclical pattern, where the “patent grant rate peaks about once each decade, followed by a clear decline.” ³⁹ He theorized that “[t]he peaks of the graph might represent a flourish of great designing ingenuity, while the subsequent declines indicate the rejection of designs being held to the standards set by the previous extraordinary designers.” ⁴⁰ The cyclical pattern signals the purpose of U.S. patent law, where truly innovative inventors are rewarded two decades of legal monopoly over their invention. However, in the fashion industry, especially with the recent

emergence of fast fashion, hardly any innovation is relevant in the long term. Additionally, in general matters of artistic expression, disruptive innovation may be just as economically successful as a talented creator putting their own spin on an emerging trend. Yet only the former is regularly granted protection.

Speed and Efficiency

Speed is important in the fashion industry. No substantive review means faster approval times. It is also efficient to forgo the substantive review to expedite the process, particularly in the fashion industry. Very few RCDs go to court. In the U.S., the vast majority of patent designs will never be the subject of a dispute. In this light, it is less efficient to pay for evaluation on the front end only to never need it. The EU system saves money and time during the application process by saving review for the courts. In addition, allowing multiple designs in a single application reduces costs and speeds up the process.

Level of Protection

“In both the U.S. and the EU, designers may prevent others from making, using, offering for sale, and importing their designs.” ⁴¹ However, the EU system lays out some exceptions that are similar to the fair use doctrine in copyright. As discussed above, the EU categorization of RCDs and UCDs allows for a differentiation in terms of burden of proof to show the intent behind the manufacture or commercialization of an infringing design. Specifically, the EU “allows for limited use and exploitation of a design by a third party who has in good faith made or used a protected design, or at least ‘made serious and effective preparations to that end,’ even for commercial purposes, as long as it was not ‘copied’ from the other’s design.” ⁴² This exception is available in cases of potential infringement of UCDs to the design’s prior users, which, similarly to U.S. trademark law, allows “prior users to continue using their unregistered trade dress to the extent that they had been using it in good faith.” ⁴³

Conclusion

Although the U.S. offers a more rigorous examination process for its design patents, the EU process is much better suited for the quickly evolving fashion world. While the system in the U.S. places the burden of a thorough examination on the administrative body that grants the registration, in the EU this burden is shifted to third parties and courts—because a substantive examination will only take place as a result of an adversarial proceeding. In a way, this saves the system the cost (both in terms of finances and time) of a lengthy examination, but at the same

time it has the disadvantage of creating a register that may include designs that technically do not meet the substantive requirements for registration.

Endnotes

1. 35 U.S.C. § 171 (emphasis added).
2. *Id.* § 173.
3. See *In re Bartlett*, 300 F.2d 942 (C.C.P.A. 1962).
4. *Id.*
5. *Am. Fabrics Co. v. Richmond Lace Works*, 24 F.2d 365, 367 (2d Cir. 1928).
6. *In re Stimpson*, 24 F.2d 1012, 1012 (D.C. Cir. 1928).
7. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989).
8. See, e.g., *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981); *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982).
9. *Rosen*, 673 F.2d at 391.
10. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).
11. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1443 (Fed. Cir. 1984).
12. *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1376 (Fed. Cir. 2005).
13. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006).
14. See, e.g., *The Article of Manufacture Requirement*, 85 Fed. Reg. 83,063 (Dec. 21, 2020), <https://www.federalregister.gov/documents/2020/12/21/2020-28110/the-article-of-manufacture-requirement>.
15. See *In re Zham*, 617 F.2d 261, 267 (C.C.P.A. 1980) (reasoning that 35 U.S.C. § 171 applies to designs “for” articles of manufacture and not “of” articles of manufacture).
16. *Design Patent Cost: Everything You Need to Know*, UPCOUNSEL, <https://www.upcounsel.com/design-patent-cost> (last updated June 26, 2020).
17. *Design Patent Application Guide*, USPTO, <https://www.uspto.gov/patents/basics/apply/design-patent> (last updated Apr. 28, 2023).
18. *Id.*
19. *Id.*

20. *USPTO Fee Schedule*, USPTO, <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule> (last updated Jan. 17, 2024).
21. *Design Definition*, EUIPO, <https://euipo.europa.eu/ohimportal/en/web/guest/design-definition> (last visited Jan. 28, 2024).
22. *Designs in the European Union*, EUIPO, <https://euipo.europa.eu/ohimportal/en/web/guest/designs-in-the-european-union> (last visited Jan. 28, 2024).
23. Council Regulation 6/2002, art. 11, 2002 O.J. (L 3) 1, 5 (EC), <https://ipright.eu/design-regulation/en/Article-11>.
24. *Designs in the European Union*, *supra* note 22.
25. *Id.*
26. *Design Representation*, EUIPO, <https://www.euipo.europa.eu/en/designs/before-applying/design-representation> (last visited Jan. 28, 2024).
27. *Designs in the European Union*, *supra* note 22.
28. Mathias Kleespies & Leyre Barragán, *Design Rights: European Union*, WORLD TRADEMARK REV. (Jan. 7, 2019), <https://www.worldtrademarkreview.com/global-guide/designs/2019/article/design-rights-european-union>.
29. *Id.*
30. *Id.*
31. *Id.*
32. Francesca M. Witzburg, *Fashion Forward: Fashion Innovation in the Era of Disruption*, 39 CARDOZO ARTS & ENT. L.J. 705, 717 (2021).
33. *Disputes*, EUIPO, <https://euipo.europa.eu/ohimportal/en/disputes> (last visited Jan. 28, 2024).
34. *What Happens During the Examination of Your Design(s)?*, EUIPO, <https://www.euipo.europa.eu/en/designs/after-applying/examination> (last visited Jan. 28, 2024).
35. *Registration Process*, EUIPO, <https://euipo.europa.eu/ohimportal/en/rcd-registration-process> (last visited Jan. 28, 2024).
36. *Fees and Payments*, EUIPO, <https://www.euipo.europa.eu/en/designs/before-applying/fees-payments> (last visited Jan. 28, 2024).
37. Witzburg, *supra* note 32, at 725.

38. Daniel H. Brean, *Enough Is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTELL. PROP. L.J. 325, 376 (2008).

39. *Id.*

40. *Id.* at 376–77.

41. *Id.* at 373.

42. *Id.* at 373–74.

43. *Id.* at 374.

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