

## Protecting Jewelry Designs: Patents or Copyrights?

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Any new jewelry product can be the subject of patent protection, which is divided into two types: design patents and utility patents. The patent statute states that a utility patent protects "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvements thereof." Thus, if a new functional design is created—for example, a clip-on earring—which has a structural advantage compared with existing designs, a utility patent may be obtained.

A design patent protects the overall aesthetic appearance of a design, focusing only on how the piece looks. Jewelry designs that are innovative in appearance can be protected by a design patent if the design is both new and sufficiently different in appearance compared with prior designs, whether those prior designs were created by the same or another designer.

**Filing for patent protection.** To obtain utility or design patent protection, an application must be filed in the U.S. Patent and Trademark Office. In virtually all situations, a designer should use the services of a patent attorney to ensure the broadest protection. A patent attorney's input is essential, especially when preparing a utility patent application, which includes a detailed description of the product's design and how it works, operates, and is constructed. It also includes a series of "claims," which legally define the scope of protection being sought.

Patent applications should be filed as soon as a product has been shown or has become known publicly to others. A patent is not available on a product that has been offered for sale in the United States or is the subject matter of a printed publication anywhere in the world more than one year before the application is to be filed in the Patent Office.

If the Patent Office grants a patent application, the patent owner will have both the right and the obligation to mark the patented product with a patent number. This can be placed directly on the jewelry product or on its packaging or labeling, and it may be used in the product's advertising.

Prior to patent issuance, and preferably during the entire patent appli-

cation process, the product should be marked with a "patent pending" notice, which indicates that an application is on file and that the owner of the design is taking action to protect his idea. This provides some commercial scare value and makes many competitors think twice about copying any "patent pending" design.

**Design patent vs. copyright.** The look of new jewelry designs also may be protected by copyright so long as the design is sufficiently creative and artistic. Copyrights in a jewelry design are established as soon as the design has been created and can be protected by promptly registering it with the U.S. Copyright Office. Prompt filing establishes a public record of the claim to copyright protection, establishes a presumption that the copyright is valid and enforceable, and enables the designer to claim certain damages if a claim for a copyright violation is made against an infringing party.

Most jewelry designers can easily file their own copyright applications, and the cost is only \$30. About three months after filing, the Copyright Office will usually return a copyright registration to the person or entity that filed the application.

Not every jewelry design is eligible for copyright protection. That's when design patent protection becomes important: As long as the design is new and sufficiently different in appearance from all prior designs, whether or not it is sufficiently "creative" to be protected by copyright, design patent protection is available. An intellectual property patent attorney can advise you about which form of protection to seek.

**What about infringers?** If a company unrelated to the patent or copyright owner is selling an item of similar design or with a similar functional element or feature, that item should be immediately evaluated by counsel so that a decision can be made whether to assert a formal claim for patent or copyright infringement. For design patents and copyrights, if infringement is found, damages are normally based on the profits of the infringer and its customers. For utility patents, damages are based either on the lost profits of the patent owner or a reasonable royalty rate in the applicable field.

One problem with asserting patent rights is that, for most patents, it takes at least a year from the time of filing to receive formal approval from the Patent Office. This delay can severely affect enforcement of one's proprietary rights. Copyright rights, on the other hand, are acquired at the moment of creation of the jewelry design and can be asserted immediately.

**Why bother?** Without copyright protection, a new design or improved features may automatically enter the public domain and be freely available for copying by competitors. Patents and copyrights are not only highly respected by most companies in the jewelry business but also recognized by the courts. For further information on copyrights and all other intellectual property matters, please visit [www.grr.com](http://www.grr.com), call (212) 684-3900, or e-mail [jkaden@grr.com](mailto:jkaden@grr.com). A copy of our firm's primer "What's a Copyright/Trademark/Patent?" is also available upon request. ♦

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