

P[®]ROTE[©]TING YOUR JEWEL[®]RY DESIGN

by Jeffrey M. Kaden

Copying is widespread in the jewelry field, just as it is in much of American industry. This article illustrates the basic ways to protect the intellectual property of the jewelry designer: copyrights, patents and trademarks. Each mode of protection has certain strengths and weaknesses. For designs that are of most importance, the designer should consider proceeding with one method or more.

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Copyright is a type of protection that is afforded to designers of "original works of authorship." Under the Copyright Laws of the United States, the designer (or an individual or company to whom the designer has transferred the rights) is the only entity that may lawfully reproduce the copyrighted work, and/or display in public those derivation works which were based on the original copyrighted work.

Copyright protection is available for those jewelry designs which are sufficiently creative and artistic. The design must be original as to the author. An example of a copyrightable jewelry design is the well known A. Jaffe/Sandberg & Sikorski ring design shown here.

Although copyright rights



are established as soon as the jewelry design has been created, it is desirable to promptly register the design with the Copyright Office. Prompt filing establishes a public record of the claim to copyright protection, establishes a presumption that the copyright is valid, and enables the designer to claim certain

damages if and when a claim for copyright violation is made against an adverse party.

Most jewelry designers can easily file their own applications. Also the cost of filing a copyright application is only \$20. About three months after filing, the Copyright Office will usually return a copyright registration to the person or entity that has filed an application.

If the owner of the copyrighted jewelry design becomes aware that someone is copying it, an action may be brought in Federal Court against the alleged violator. The legal test for whether there is a copyright violation comprises (a) whether the alleged violator had "access" to the jewelry design, and (b) whether the alleged infringing design is "substantially similar" to the copyrighted design. As to the former, access is usually presumed if the designer's piece is being offered for sale in the marketplace.

Currently, copyright protection lasts for the life of the designer plus 50 years. If the work is made by an employee, and thus owned by an employer, it lasts for 75 years from the date it was first made available to the

public, or 100 years from the year of creation, whichever expires first.

Copyright protection for a jewelry design is a very powerful tool. However, every jewelry design may not be subject to copyright protection and, further, copyright only protects against the act of "copying."

PATENT PROTECTION

Patent protection is divided into two types: design patents and utility patents. Utility patents cannot usually be used to protect a jewelry design unless the design includes some type of mechanical improvement.

A design patent protects the overall aesthetic appearance of the jewelry design and is only concerned with how the jewelry piece looks or appears (just like a copyright) - not how it is made or how it functions. Most jewelry designs will fall into this category as long as the design is new and sufficiently different as compared to all prior designs, whether by the designer of the piece at issue or third parties.

In order to obtain design patent protection, an application must be filed in the United States Patent and Trademark Office. This usually requires

the use of a patent attorney, since an application for design protection is somewhat complicated.

A design application should be filed as soon as the design has become "known" publicly to others. Under the Patent Laws, a design patent is not available if the design has been on sale in the United States or is the subject of a printed publication anywhere in the world, more than one year before the application is filed in the Patent Office.

The cost to file a design application is far greater than that of a copyright application. The government filing fee alone is approximately \$300 for large companies, and \$150 for small companies or individuals. In addition, there are the charges of the jewelry designer's attorney, as well as the charges for preparing design patent drawings (which usually have to be prepared by a specialized patent draftsman who is familiar with patent regulations for design drawings).

A good example of a patented jewelry design is the very famous "Quadrillion" Heart Pendant of Ambar Diamonds, which is depicted below.



This design would not have been protectable under copyright laws.

The Copyright Office would not consider it sufficiently artistic or creative to warrant copyright protection.

If one finds that a third party is selling jewelry items with a similar design, the designer or owner of the patent should contact an experienced patent attorney and decide whether to make a claim for patent infringement. Damages for design patent infringement are similar to damages in a copyright action, which typically comprise the profits of the infringer and its customers.

One problem with asserting design patent rights is that it usually takes at least a year from the time of filing to receive a design patent from the Patent Office. This can be a problem if a third party is violating the jewelry design during the time the design application is pending. Also, design patents only have a term of 14 years from the date of issuance, much shorter than the life of a copyright.

TRADEMARKING

While a trademark is normally thought of as a word, phrase or symbol which identifies a product or service of a company, a trademark may also be obtained for a product design such as jewelry. Trademark rights in a product design, however, can only be acquired if the design is inherently distinctive or if "secondary meaning" of that design is established in the marketplace. Secondary meaning means that the consuming public recognizes the design as being more than simply ornamental, but also as a source identifier of the product.

A well known trademark in jewelry design is the "Kiss" of Paloma Picasso, left, which, after being used since 1984, was registered as a trademark in 1993.



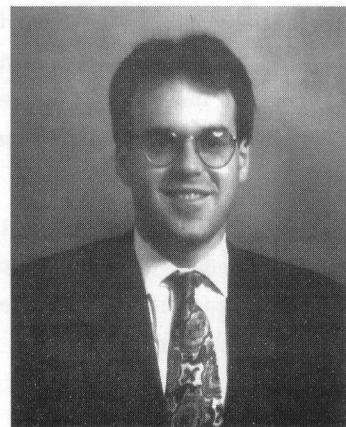
Obtaining a trademark registration for a jewelry design is often very difficult. In order to establish "secondary meaning" in the marketplace, it is usually necessary to submit substantial evidence to the Trademark Office, such as advertising expenditures and sales information, as well as written statements from those in the trade that they understand the jewelry design to be a source indicator.

Examination of a trademark application typically takes less than a year. However, if the Trademark office is not

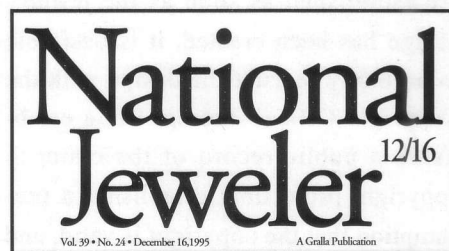
convinced that the jewelry design functions as a trademark, it may take much longer, and further evidence of "secondary meaning" may be requested.

Once a trademark application is approved by the Trademark office, it is first published and then, if not opposed, will issue as a trademark registration. A trademark registration is valid for 10 years. It may be renewed for additional 10 year terms indefinitely, provided that the trademarked jewelry design continues to be used as described in the registration.

Although having a federal trademark registration is important, it does not preclude a jewelry designer or owner from enforcing trademark rights in a jewelry product design against a third party. Common law rights in a design can be asserted in those geographic areas of the United States where the design has been used and has been proven to be recognized as a source indicator.



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