

PATENTS AND SUNGLASSES: REMOVING THE GLARE

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When the term patent is used or mentioned, most people think of high-tech advances in electronics, genetics, pharmaceuticals, etc.

If you asked the average person on the street whether patents have any applicability to eyewear, including sunglasses, you would probably get a strange or puzzled look. Perhaps many, even those working in the sunglass industry - retailers, distributors, even manufacturer's - might think patents and sunglasses have little in common. This is simply not correct. A new sunglass product can indeed be the subject of a patent.

UTILITY VERSUS DESIGN

Patent protection is divided into two types: design patents and utility patents. A utility patent, as the patent statute states, protects "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvements thereof." Therefore, if a new style for sunglasses has some type of structural advantage as compared to commercially existing designs, a utility patent may be obtained. A utility patent may be available for a new type of lens, an improved earpiece, or any other novel feature with a utilitarian advantage.

On the other hand, a design patent protects the overall *aesthetic* appearance of the sunglass design, focusing on only how the sunglass piece looks or appears - and not how it is made or how it functions. In order to be design-patentable, the sunglass design must be both new and sufficiently different when compared with prior designs, whether those prior designs were created by the same designer or another designer.

FILING FOR PATENT PROTECTION

In order to obtain either design or utility patent protection, an application must be filed in the United States Patent and Trademark Office. In virtually all situations, a designer should use the services of a patent attorney so that the protection obtained is as broad as possible. The patent attorney's input for preparing all utility patent applications is essential, since this type of application includes a very detailed description of the product design and how it works, operates and is constructed, as well as a series of what is known as "claims," which legally define, in detailed, descriptive terminology, the scope of protection that is being sought.

For both utility and design patent applications, the application should be filed as soon as the product has become known publicly to others. The laws of the United States state that a patent is not available on a product if that product 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.

If either a design or a utility patent application is granted by the Patent Office (located near Washington, D.C. in Arlington, Virginia), then the patent owner will have the right and obligation to mark the patented product with a patent number. Prior to that, and during the entire patent application process, the product can be marked with a "patent pending" notice which indicates to the world that an application is on file and that the owner of the design is taking action towards protecting his idea. This will provide a certain "scare" value and make many competitors think twice about copying any design. The patent application itself remains unavailable to the public until the patent is issued.

WHAT ABOUT INFRINGERS?

If a company unrelated to the patent owner is selling an item of similar design, or with a similar functional element or feature, that item should be immediately evaluated by patent counsel so that a decision can be made whether to assert a formal claim for patent infringement. For design patents, if infringement is found, damages are 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 eyewear field.

One problem with asserting patent rights is that most patents take at least a year from the time of filing to receive approval from the Patent Office. Obviously, the delay

can be a problem if, during this period, a third party begins copying the design or feature for which patent protection was sought. However, in many circumstances, if infringers are advised that a patent will likely issue, many infringers will think twice about continuing production and/or sale of an infringing product.

WHY BOTHER?

With the launch of any new sunglass product line, considerable effort and expenses are obviously incurred. If patent protection is not sought, the new design and/or the improved feature enters into the public domain and is freely available for copying by competitors. Since patents are highly respected by most industries, as well as the courts, it makes sense for the designer or manufacturer of the product to take that extra step, to incur a little bit more initial expense, and file for patent protection (if your attorney thinks such protection is available). Pursuing patent protection not only makes good legal sense, it also makes good business sense.

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For further details about intellectual property matters, request a free copy of Gottlieb, Rackman & Reisman's primer, "What's a Copyright/Trademark/Patent?" by fax at (212) 684-3999

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