

# Protection of Furniture Designs

by George Gottlieb

Protecting a furniture design means survival for a company because design copying and infringement are almost epidemic in the furniture industry. Many cases appear on the rosters of our court system, but these are just the tip of the iceberg since only a small percentage of disputes ever reach the courts.

One of the most publicized cases in recent years was that of Donghia Furniture Company, manufacturer of the well known Ghost chair. Last November, a ruling by a judge of the Southern U.S. District court in New York upheld the patent and trade dress infringement claims raised on behalf of Donghia against Furniture Masters. The defendant was deemed liable for damages and had to further send the plaintiff illustrations of its new designs.

## Protection Options

Protection from copycats is readily available and backed up by the full force of the United States through its courts and its intellectual property laws. There are three main vehicles for protection under these laws: copyrights, patents and trademarks.

Copyright is the simplest protection of all to obtain, and is one of the most powerful of the three laws.

All original works of authorship can be covered copyright. A copyright recognizes the owner of a design as the only entity that may lawfully reproduce and/or publicly display the copyrighted work or those works derived from the original copyrighted work.

Not all furniture designs are sufficiently creative and artistic to qualify for copyright protection. For example, if the uniqueness of a chair is only its polka-dot fabric, or the originality of a table is based on its hexagon shape, copyright protection would not be merited. However, if an unusual shape or form is used that is original to the designer, there may be sufficient artistic uniqueness to earn the protection of a copyright.

Copyright is established as soon as a design has been created; you don't have to register for a copyright to protect it. However, it is extremely

desirable to do so. Prompt filing in the United States Copyright Office establishes on a public record a presumption that the copyright is valid, and enables the designer to claim certain damages if a claim for copyright violations is made against an adverse party.

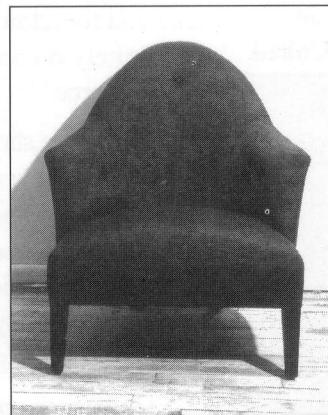
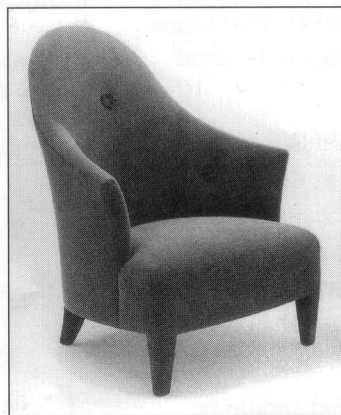
## Filing for Copyright

The filing process is relatively simple. Designers can usually file their own applications for about \$20. The Copyright Office usually will approve the copyright application and return the registration to the applicant about three months after filing.

The legal test for verifying whether there has been a copyright violation is two-fold: a) Did the alleged violator have access to the design? (This is usually presumed if the designer's work is being offered for sale in the marketplace); and (b)

Is the alleged infringing design substantially similar to the copyrighted design? If a design's owner believes that someone is copying the design, action may be brought in Federal Court against the infringer, and measures to stop the infringement can be in place quickly.

Copyright protection is available for the life of the designer plus 50 years.



"The Donghia Furniture Company, manufacturer of the Ghost chair, won a widely publicized patent and trade dress infringement case against Furniture Masters, which produced the infringement version on the right."

If, however, an employee made the design, the design is owned by his employer. In that case, copyright protection would expire at the lesser of 75 years from the date the design was first made available to the public, or 100 years from the year of creation.

If a particular design is not adequately artistic or original to merit copyright protection, protection may be possible under the patent laws of the United States. Patent protection is classified into two categories: design patents and utility patents.

Patent applications cost substantially more than copyright applications. In addition to government filing fees and attorneys fees, there usually are charges for a patent draftsman to prepare drawings which will be in compliance with U.S. Patent Office regulations.

## Patent Protection

Utility patents can be used to protect a unique mechanical function, or a distinct improvement on a previously known mechanical function. A Design patent protects the general ornamental image of a design, and isn't concerned with how the invention is constructed or how the design itself functions. If a design presents an overall appearance that can be classified as new and unobvious (sufficiently different) when compared to all prior designs, then the idea will qualify for protection by design patent.

To obtain patent protection, an application must be filed in the United



"The design of the Tizio lamp was deemed a source identifier, and therefore was granted trademark protection."

States Patent and Trademark Office. It's essential that a patent application is filed promptly once the design has become known publicly to others. Due to the inherent legal complexity and the highly technical nature of a patent application, the services of an experienced patent attorney are essential.

Trademarks can offer solid protection when a name, symbol or phrase is used to authenticate exclusivity in the marketplace, but trademarks may also be obtained for a product design. If the design is inherently distinctive, or if recognition by the consuming public of the trademark as a source identifier (secondary meaning) has been established in the marketplace, trademark rights can be acquired. Authentication of a trademark as having secondary meaning is often difficult to accomplish, and substantial evidence is required. In the case of the Tizio lamp, such a secondary meaning was established and the lamp has become a world famous trademark.

An application to register a trademark is usually handled by a qualified trademark attorney. The examination by the Trademark Office routinely takes less than a year. When a trademark has been officially approved, it's first published and, if unopposed, becomes a registered trademark. The lifetime of a trademark registration is 10 years, but it may be renewed for additional 10 year terms indefinitely if continues to be used in commerce.

If it can be shown that the trademark continues to be used as described in the registration and is being promoted in the marketplace, it can protect you against third parties who use a design that is confusingly similar to the trademarked design.

Trademark counsel should be consulted as to whether legal action should commence, since an action for

trademark infringement can enable the design owner to obtain injunctive relief and monetary compensation for damages. However, a strategic evaluation must be made as to whether there is confusing similarity of a competitor's design.

## What's Best?

What is the best choice for protection, and is it really of any value? If its applicable, copyright affords the best form of protection for a furniture design; it offers longevity, is acquired inexpensively and by simple methods, and is easily enforced.

If a product design isn't protectable by copyright, then the best option would be design patent protection, since no evidence of the design being a source identifier is necessary. The design only has to be new and unobvious. Utility patent protection, if appropriate, would also offer substantial design protection, but of course, would be the most expensive route. A trademark registration is best suited to protect names and logos.

The introduction of any new design involves time, effort and money. All such concepts and innovations, unless protected by copyright, patent or trademark law, will become part of the public domain and, as such, fair game to competitors. If the furniture design is worthy and important commercially, it should be legally protected.

*George Gottlieb is a founding partner of the New York law firm of Gottlieb, Rackman & Reisman, P.C., which specializes in copyright, patent, trademark, and trade dress law.*

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