



US copyright protection for logos, packaging and products

Lisa Pearson, Andrew Pequignot, and Ashford Tucker of Kilpatrick Stockton LLP look at how brand owners can protect what they hold dear.

Brand owners take note, the United States Copyright Act can enhance your ability to protect your logos, packaging, and product designs. A copyright registration, when available, is far easier and less expensive to obtain than a registered trademark or patent.

Copyright protection remains in force far longer than a patent and, unlike a trademark, requires neither use in commerce of the protected work nor periodic maintenance to sustain it. Copyright infringement is often easier to prove than trademark or patent infringement, and the remedies available under the Copyright Act, including statutory damages and attorney fee awards (without any showing that the case was "exceptional"), expand the scope of relief that may otherwise be available. What's more, the US Supreme Court is poised to decide whether a copyright registration can help brand owners keep grey market goods manufactured abroad out of the US in situations where trademark law offers no protection.¹

For all of these reasons, brand owners should routinely consider whether their logos, packaging, and product designs contain copyrightable elements. If so, they can secure substantial benefits by

registering their copyrights with the United States Copyright Office at relatively little expense.

Comparison of US copyright, trademark, and patent regimes

Smart companies will take a look at their logos and products from all angles in order to formulate an appropriate strategy for maximising their intellectual property protection.

The elements of a given commercial product and its packaging may qualify for protection under US copyright, trademark and patent law, all at the same time. For example, a company launching a revolutionary new toothpaste might be able to protect the product formulation by securing a utility patent; an ornamental, non-functional cap on the product's tube through a design patent, copyright or trademark; other source identifiers (such as brand and product names and logos, and the non-functional trade dress of the product configuration and packaging) through trademark or copyright law; and other ornamental elements through copyright law.

In our experience, companies rarely take advantage of copyright law in this context. They should.

Potentially copyrightable elements of logos, product packaging and products

US copyright law protects original works of authorship, including literary, pictorial, graphic and sculptural works. Among the elements of product and packaging design that may qualify for copyright protection are: (a) logos, (b) the artwork and text on labels, hangtags and packaging, (c) warnings and instructions, and (d) ornamental product design. We provide examples of each below.

Logos

US copyright protection is available for logo artwork that contains sufficient originality and expressive elements, known as "authorship". The threshold for originality is low; only a "minimal degree of creativity" is required². [W]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring" do not meet this standard³. Nevertheless, an original arrangement of these non-protectible components may well be entitled to copyright protection.

For example, in *Jada Toys v Matte*⁴ the Court of Appeals for the Ninth Circuit recognised the copyrightability of Mattel's HOT WHEELS logo in a trademark and copyright infringement case involving Jada's HOT RIGZ logo. Both logos are depicted in Figure 1 below.



Figure 1

Analysing Mattel's Hot Wheels logo, the court stated that "the combination of the words used, the stylisation of the flame graphic, and the colors chosen, suggest that elements of the flame logo are protectable for the purposes of a copyright infringement action."⁵ Thus, while the idea of using a flame in a logo and the phrase "Hot Wheels" would not qualify, the combination of features in this HOT WHEELS logo was sufficiently original and creative to merit copyright protection.

In *Bouchat v Baltimore Ravens*⁶ the Fourth Circuit heard an appeal in an infringement action brought by amateur artist Frederick Bouchat against the National Football League's Baltimore Ravens based on Bouchat's assertion that the Ravens copied his drawing and used it as their team logo, both shown in Figure 2.



Figure 2

The court ultimately held that the public domain elements present in the Bouchat's drawing – the letter B, a cross, and a shield – were "selected, coordinated, and arranged in such a way as to render the work original" and thus ultimately copyrightable⁷. Ultimately, Bouchat won a jury verdict on the issue of copyright infringement, which the Fourth Circuit affirmed.

The *Baltimore Ravens* case is a cautionary tale about the importance of timely registration. Unfortunately for Bouchat, because he had not timely registered the copyright in his drawing, he could not sue for statutory damages. Based upon the Baltimore Ravens' proof that its profits were not attributable to its infringement of the drawing, a jury awarded Bouchat nothing and the Fourth Circuit affirmed⁸.

It is not always easy to predict where the copyright office and the courts will draw the line between copyrightable and

uncopyrightable expression. For example, both Coach and Louis Vuitton use monograms as design elements on their handbags. In *Coach v Peters*⁹ after the copyright office refused to register Coach's "signature CC" design (Figure 3), Coach brought an action in federal court against the copyright office to compel registration of the designs. The court upheld the copyright office's finding that the mere arrangement of the letter "C" did not contain sufficient amount of original and creative authorship to be copyrightable.



Figure 3

By contrast, however, Louis Vuitton owns copyright registrations for its Multicolore Monograms shown in Figure 4 and has brought suit in federal court on multiple occasions to enforce its rights¹⁰.

In short, logos featuring artwork or graphic design components may well be copyrightable¹¹. Because so many trademarks incorporate such components, brand owners and their counsel are well advised to consider the

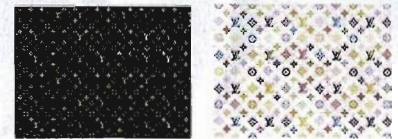


Figure 4

availability of copyright registration as a complement to trademark registration when seeking to maximise protection of their logos.

Copyrightable packaging, hangtags, and labels

Original logos, artwork, or photographs on product packaging labels, with or without the surrounding text, may well be protected by copyright. In some cases, the textual material may be protected by copyright as well.

In *Parfums Givenchy v C & C Beauty Sales*¹² the court observed "[i]t is well established that an artistic packaging design ... is entitled to copyright protection," and held that the packaging design for GIVENCHY AMARIGE perfume (Figure 5) was entitled to copyright protection.



Figure 5

The package design need not be a thing of artistic beauty to qualify for copyright protection, as shown by the decidedly non-luxury good shown in Figures 6 through 8 below:



Figure 6¹³



Figure 7¹⁴



Figure 8¹⁵

The same rules apply to labels and hangtags. In *Derek Andrew v Poof Apparel Corp*¹⁶ for example, a court issuing a default judgement recognised the copyrightability of a clothing designer's copyrighted Twisted Heart (Figure 9) hangtag, and held that a competitor infringed on the label.

In short, copyright may protect both the pictorial and textual components of the so-called "trade dress" of a product.



Figure 9

Warnings and instructions

Copyright protection also extends to certain warnings and instructions appearing on package inserts and other product packaging.

For example, in *Innovation Ventures, LLC v N2G Distributing*¹⁷ the court held that the following medical caution label on 5-Hour Energy drink was protectible under US copyright law:

Contains about as much caffeine as a cup of coffee. Limit caffeine products to avoid nervousness, sleeplessness, and occasionally rapid heartbeat. You may experience a Niacin Flush (hot feeling, skin redness) that lasts a few minutes. This is caused by Niacin (Vitamin B3) increasing blood flow near the skin¹⁸.

The court explained:

[E]ach manufacturer [of an energy drink] has chosen different language and word order to emphasise or de-emphasise various aspects of the medical warning. In other words, the medical caution statement is a narrative. Because the medical caution statements appearing on the energy shots have appreciable differences, and stylistic flourishes may be inserted in the statement, the medical caution label has the minimum level of originality necessary to warrant copyright protection as a matter of law¹⁹.

The following instructions for hair products were held copyrightable in *Sebastian International v Consumer Contact*²⁰:

Hair stays wet-looking as long as you like. Brushes out to full-bodied dry look. WET 4 is one step-four choice (finishing) in Sebastian's four step program for a healthy scalp and head of hair. WET is not oily, won't flake and keeps hair wet-looking for hours, allowing you to sculpture, contour, wave or curl. It stays looking wet until it's brushed out. When brushed, hair looks and feels thicker, extra full. Try brushing partly, leaving some parts wet for a different look²¹.

The court reasoned that the "language is more than simply a list of ingredients, directions, or a catchy phrase" and "[n]o one can seriously dispute that if plaintiff were to discover that a competitor's package utilised the exact language as above with the exception of the product's name, plaintiff would be entitled to protection." While commenting that "this text tries the limits of the modicum of creativity necessary for a work to be copyrightable,"²² the court ultimately held that "taken as a whole [the set of instructions] comes within the purview of the Copyright Act."

Because generic drug manufacturers and others seeking to exploit market trends frequently take shortcuts in getting their products to market, a brand owner with the foresight to secure copyright registrations for its packaging and inserts may have additional ammunition against unfair competition.

Copyrightable product designs

Copyright law does not protect functional aspects of objects, an area of protection explicitly reserved for patent law. But the Copyright Act does grant protection to certain ornamental elements of useful articles, and in so doing expands copyright's zone of protection into the realm of product design.

Consumer products with an intrinsic utilitarian function receive unique treatment under US copyright law. Such works are protectible "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article"²³. So, for example, in the

leading case of *Mazer v Stein*,²⁴ the US Supreme Court held that a statue portraying a dancer is copyrightable even when it has been included as the base of a lamp, which is utilitarian.

There are reams of legal literature on this topic, but one prominent commentator succinctly summarises the test as follows:

The inquiry . . . is simply whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article. If they are, they are not capable of existing independently of those aspects. If the pictorial, graphic, or sculptural features are not dictated by the form or function of the utilitarian aspects of the useful article, they can be said to be capable of existing independently of those aspects and hence are protectible.²⁵



Figure 10

Despite the apparent simplicity of this summation, the courts often struggle with the "conceptual separability" rule, applying a variety of slightly differing, nuanced tests. Therefore, in presenting the

following examples of copyrightable product designs, we note that there is also a robust line of cases deeming various product designs uncopyrightable due to a lack of separability between their respective functional and expressive aspects.

In the leading case *Kieselstein-Cord v Accessories by Pearl*²⁶ fashion designer Barry Kieselstein-Cord sued to stop an accessories company from making inexpensive knockoffs of his original Vaquero and Winchester belt buckles, the latter of which is shown in Figure 10.

Reversing the lower court's summary judgment ruling that the buckles were not copyrightable, the Second Circuit granted copyright protection to the buckles because "[t]he primary ornamental aspect of the Vaquero and Winchester buckles is conceptually separable from their subsidiary utilitarian function²⁷." The court explained that the focus of inquiry should be on "whether . . . there is a physically or conceptually separable artistic sculpture or carving capable of existing independently as a work of art²⁸."

In *Pivot Point International v Charlene Products*²⁹ the court considered the copyrightability of "Mara," a mannequin with a face evoking the "hungry look" of fashion models (Figure 11).

The court performed a thorough analysis of the various tests courts apply to determine the existence of conceptual separability, which it synthesised as follows:

Conceptual separability exists . . . when the artistic aspects of an article can be conceptualised as existing independently of their utilitarian function. This independence is necessarily informed by whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences. If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is as much the result of utilitarian pressures as aesthetic choices, the useful and aesthetic elements are not conceptually separable³⁰.

Focusing on the fact that Mara's designer took no functional considerations into account in creating the mannequin, the court held that Mara "therefore meets the requirements for conceptual separability and is subject to copyright protection³¹."



Figure 11

In *Universal Furniture International v Collezione Europa USA*³² a case litigated by the authors' firm, the Fourth Circuit found copyrightable a variety of ornamental features of traditional furniture designs, including Universal's English Manor Collection (Figure 12).



Figure 12

The court affirmed the district court's holding that "the shape of the furniture cannot be the subject of a copyright, no matter how aesthetically pleasing it may be, but the decorative elements that are separable from the furniture can be."³³ "Focusing on the fact that the furniture's designer completed all of the functional aspects of the furniture's design prior to adding ornamentation, the court affirmed the copyrightability of "superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle"³⁴. "This does not bode well for designers who subscribe to Mies van der Rohe's "Less is More" dictat, but should bring joy to the hearts of those who prefer rococo ornamentation.

Copyright law and functional products are not a match made in heaven. The existing state of the law clearly favours ornate rather than minimal designs and those who subscribe to the "form follows function" school of design will probably have to look to patent law to try to protect their designs. Nevertheless, for many products, copyright may protect certain key features against copyists.

Summary

Companies should routinely take stock of the expressive elements in their logos, packaging, and product designs to assess whether any of those elements are copyrightable under US law. When working with independent contractors on potentially copyrightable materials, companies should also be sure to obtain all necessary rights in the creations. While registration is not necessary to obtain copyright protection, the evidentiary presumptions and access to statutory remedies and attorneys' fees provided by timely registration are frequently worth the modest investment. A registered copyright can be a powerful weapon in negotiating with or litigating against those who copy logos, packaging and product designs, supplementing other forms of intellectual property protection.

Footnotes

1. *Omega S.A. v Costco Wholesale Corp.*, 541 F.3d 982 (9th Cir. 2008), cert. granted, 130 S.Ct. 2089 (2010). In *Omega*, the Ninth Circuit held that copyrighted goods manufactured and sold overseas, and then imported into the United States without the authorisation of the copyright owner, infringed the owner's rights under the Copyright Act. By contrast, as a general rule, US trademark law only prevents the sale of parallel imports that are "materially different" from the products authorised for sale under the mark in the US.
2. *Feist Publ'ns, Inc v Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).
3. 37 C.F.R. § 202.1.
4. 518 F.3d 628, 636 n.6 (9th Cir. 2008).
5. *Id.*
6. 241 F.3d 350 (4th Cir. 2001).
7. *Id.* at 356.
8. *Bouchat v. Balt. Ravens Football Club Inc*, 346 F.3d 514 (4th Cir. 2003).
9. 386 F. Supp. 2d 495, 499 (S.D.N.Y. 2005).
10. See eg., *Louis Vuitton Malletier, S.A. v Mido Trading, Inc*, CV 08-04405 DDP (C.D. Cal. April 22, 2010); *Louis Vuitton Malletier, S.A. v Akanoc Solutions, Inc*, 2009 WL 1636914 (N.D. Cal. June 10, 2009).
11. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[G][2] (2010).

12. 832 F. Supp. 1378, 1391 (C.D. Cal. 1993).
13. *C.B. Fleet Co. v Unico Holdings, Inc*, 510 F. Supp. 2d 1078, 1081 (S.D. Fla. 2007).
14. *Royal Source, Inc v New Tradition Pipe Co.*, 140 F. Supp. 2d 915, 916 (N.D. Ill. 2001).
15. *X-IT Prods., LLC v Walter Kidde Portable Equip. Inc*, 155 F. Supp. 2d 577, 610 (E.d. Va. 2001).
16. 2006 WL 3791371 (W.D. Wash. Dec. 22, 2006), rev'd on issue of statutory damages, 528 F.3d 696 (9th Cir. 2008).
17. 635 F. Supp. 2d 632 (E.D. Mich. 2008).
18. *Id.* at 638.
19. *Id.* at 640.
20. 664 F. Supp. 909 (D.N.J. 1987), rev'd on other grounds, 847 F.2d 1093 (3d Cir. 1988).
21. *Id.* at 913.
22. *Id.*
23. 17 U.S.C. § 101.
24. 347 U.S. 201, 205 (1954).
25. 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:146 (2010).
26. 632 F.2d 989 (2d Cir. 1980).
27. *Id.* at 993.
28. *Id.* at 994.
29. 372 F.3d 913 (7th Cir. 2004).
30. *Id.* at 931 (quotations and citations omitted).
31. *Id.* at 932.
32. 2010 WL 3278404 (4th Cir. Aug. 20, 2010) (per curiam).
33. *Id.* at *10-11.
34. *Id.* at *11.

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