January 2005 | Vol. IV - No. 1

Three Things You Should Know to Protect Your Toy Designs

By Marc S. Cooperman and Robert S. Katz
January 2005

So, you've come up with the next best toy design since the Yo-Yo. Hello tropical adventures! But wait: The idea is so good that it's bound to spawn similar designs from other well financed, but less clever, competitors. What can you do to protect your design?

1. Choose the Right "Intellectual Property" to Protect Your Toy

Your idea is your "intellectual property" – a fancy phrase that is used to describe several types of legal protection. Depending on how clever your design is, you may be able to obtain one or more types of intellectual property protection for your toy.

Generally speaking, patents offer the broadest form of protection but are the most difficult to obtain. *Utility patents*, as the name suggests, will protect the "useful" aspects of your toy – for example, how it is constructed, or how it functions. *Design patents* protect the aesthetic aspects of your toy – essentially, how it looks. **LeapFrog's** well known learning systems are protected under many utility and design patents that shield not only the look of the systems, but features such as the interaction of the letters and cards, and the internal electronics.

Copyrights protect creative expression such as paintings, photographs, sculpture, and literary works. Various creative aspects of toys, games, dolls, and more may be copyrighted. Examples include the designs of game boards, dolls' faces, or the appearance of characters in a video game.

A *trademark* protects the name of the toy you have chosen in order to distinguish it from the toys of your competitors. The name of an entire line of toys may be trademarked, like GROOVY GIRLS®. So, too, can the individual toys within a line be trademarked, like PIKACHU® or CHARIZARD™. Slogans used to market your toys, such as GOTTA CATCH ´EM ALL!®, can also be trademarked. Under certain circumstances, trademarks can also apply to the appearance of a toy or its packaging.

2. Keep in Mind the Toy's Shelf Life When Seeking Protection

The toy industry is cyclical. You may introduce your toy in February at Toy Fair. Or you may wait to launch it during the holiday season. In either case, you may have a short window of opportunity to reap your rewards and keep your competitors at bay – particularly if the design can easily be copied and may soon become the latest fad.

Unfortunately, the Patent and Trademark Office and the Copyright Office – both parts of our Federal government bureaucracy – don't care about your marketing plans. The average time to convince the Patent Office to grant a design patent is about one and a half years. You should expect about twice that amount of time to get a utility patent. The Copyright Office will typically register your copyright about six months after you file the application. And trademarks are usually registered in about a year.

But don't despair. With the guidance of your intellectual property lawyer, and some creativity, you can accelerate the process – sometimes to a significant degree. The Copyright Office provides for expedited handling that can reduce the time to obtain a registration to a few weeks. Taking advantage of the new "provisional" patent rights can secure early publication of your patent application. When combined with strategic filing in some foreign countries, you can potentially attain provisional patent rights in the United States in one to two months. Knowledge of the workings of the Patent Office, combined with some determination and charisma, can result in design patents being issued in less than six months. The Patent and Trademark Office is encouraging the electronic filing of trademark applications by acting on them quickly, in comparison to their paper counterparts stacking up on trademark attorneys' desks.

3. Consider Protecting Portions of Your Toy with Design Patents

It is common for competitors to copy or simulate aesthetic portions of a toy design and not necessarily the appearance of the entire product. A series of well planned design patents are the perfect tool to protect the entire design and different portions of the design.

You can shape and determine the scope of the toy design to be protected in the United States. This is most commonly achieved by depicting the desired region of the toy to be protected with solid lines and depicting the remainder of the product in dashed lines. The region in dashed line is considered to be shown for illustrative purposes only.

In addition to this practice, called "disclaiming," the design patent can also be strategically sculpted by omitting certain aspects of the toy design. While this is routinely done to exclude graphics, its can also be used to exclude potential changes in the shape of the toy. Strategically applying these practices, the product developer can protect multiple aspects of the toy that he or she does not want to see appropriated in a competitor's product.

An example of this is shown in the design patents directed to the Intelli-Table® interactive child development toy. The toy includes an aesthetically pleasing stand having a bowl and three legs. A removable saucer with a handle sits in a recess in the top of the

stand. The saucer includes a central region with a configuration of lights that can be illuminated.

Four separate design patents (D449,657, D449,353, D449,352, and D449,351) were obtained for this toy, each directed to different aspects of the IntelliTable® toy. As shown below, one design patent is directed to the entire toy. Another is directed to the stand. Another is directed to a portion of the saucer. Yet another is directed to the light pattern in the center of the saucer.

Strategies are somewhat similar in obtaining design patent protection in Europe and Japan. However, some countries, such as China and Taiwan do not permit disclaiming of toy features. Others permit protection of portions in selected circumstances. Strategy in those countries is more directed to protecting parts of the unassembled final toy that may be sold independently. These points are just the tip of the iceberg. It's obviously important to work with intellectual property counsel who know the in's and out's of protecting your toy design in the United States and any other country your marketing plan may extend to. Taking a strategic approach to protecting your toy design early on will pay dividends down the road, and ease your mind as you sip your drink on that tropical beach.

Writer's Bio: Marc S. Cooperman is a partner in the Chicago office of the law firm Banner & Witcoff, where he focuses on intellectual property litigation.
Robert S. Katz is a partner in Banner & Witcoff´s Washington, D.C. office, where he focuses on design protection.

Reader's Comments

by **Marc Cooperman, Esq. & Robert S. Katz, Esq.** on January 19, 2005

We would like to invite you to submit questions or concerns you have regarding protecting the intellectual property of toys. Each week, either Marc Cooperman or Rob Katz will choose a question to answer in TD Monthly.

---

by **Dave Diguy, Orlando, FL.** on January 20, 2005

How does patent protection work in China? Considering my patent application was filed in the US, what should I know as I begin selling a toy in China?

---

by **Marc Cooperman & Rob Katz** on February 4, 2005

Dave, Like the U.S., China has utility patent, design patent, copyright, and trademark laws that can provide the owner with a right to exclude others. You may thus want to consider obtaining protection in China. It is commonplace for U.S. patent attorneys to work with Chinese ***ociates to coordinate patent and trademark filings. If your U.S. patent application is a utility patent application, and it was filed less than 1 year ago, there is an international treaty that permits you to file a utility patent application in China and claim priority to obtain the effective filing date of the U.S. application. For design applications, there is a 6 month priority deadline. Additionally, for the U.S., China, or any other market where you plan on having substantial business activities, you may want to consider obtaining a clearance opinion to minimize the likelihood that you may be encroaching on the intellectual property rights of another.