

4 KEY TAKEAWAYS

Anti-Counterfeiting: Enforcing Design Patents at the Border

[Kilpatrick Townsend](#) partner [Rob Potter](#) was recently a speaker at the [Intellectual Property Owners Association 2021 Annual Meeting](#). Mr. Potter participated in a panel discussion addressing “Anti-Counterfeiting: Enforcing Design Patents at the Border.” In numerous countries, customs and border officials stop imports of products (and in some cases exports) that infringe industrial design rights. This can prevent knockoffs from having the opportunity to confuse consumers, damage a brand, or pose safety concerns.

Four key takeaways from the panel discussion, include:

1

In the United States, Customs agents are authorized by statute to seize imported goods that infringe a registered U.S. copyright or trademark, but *not* a registered U.S. design patent. This leaves the U.S. as an outlier compared to jurisdictions—like the EU, Japan, Korea, and China—that do enforce registered design rights at the border.

2

Instead, U.S. Customs agents may seize goods that infringe product design only if that design is registered as trade dress (a form of trademark) with the Patent and Trademark Office. Registering product-design trade dress in the U.S. can be a lengthy and expensive process that requires a showing of “secondary meaning,” which may take several years to demonstrate, while registering the same design as a design patent can be done immediately and without any such showing.

3

This creates a loophole, allowing for goods that infringe a registered design patent to be lawfully imported for at least several years, unless and until the IP owner also succeeds in registering that design as trade dress.

4

The proposed Counterfeit Goods Seizure Act of 2019 (S.2987) would close this loophole by expressly adding “design patents” to the relevant Customs statute, 19 U.S.C. § 1595a(c)(2)(C), making U.S. border enforcement consistent with the numerous other global jurisdictions that already enforce registered design rights.

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