
Kan Traffix Kops Katch the Karavan Kopy Kats?

or

Beyond Functionality: Design Patents are the Key to Unlocking the Trade Dress/Patent Conundrum

Perry J. Saidman¹

TABLE OF CONTENTS

I. KONFOUNDING KONUNDRUM—AN INTRODUCTION.....	840
II. GOOD GUYS, BAD GUYS—A TRAFFIX JAM	844
III. KOPY KATS V. PROTECTIONISTS—THE TRADE DRESS/PATENT INTER- FACE	
A. <i>Stop! In the Name of the Public—The Supremes</i>	
1. <i>Where Did Our Rights Go?—The Early Supremes</i>	848
2. <i>My World is Preempted Without You—Sears, Compco and Bonito Boats</i>	851
3. <i>Nothing But Heartaches—Doc Functionality Makes House Calls</i>	853
4. <i>ATTENTION Wal-Mart Shoppers</i>	855
B. <i>Three Blind Mice—The CCPA Speaks</i>	
1. <i>Protectionists' Favorite Whine—Mogen David</i>	857
2. <i>Circular Logic—Honeywell</i>	858

¹ Principal, SAIDMAN DesignLaw Group, Silver Spring, MD and Washington, D.C., a law firm that specializes in legal issues involving designs and product configurations. The opinions expressed herein are those of the author only and do not necessarily represent those of the firm or of any client of the firm. The author wishes to thank and acknowledge the contributions of Damon A. Neagle and Kimberly A. Taylor, associates at SAIDMAN DesignLaw Group, who provided invaluable research, writing and editing assistance; Kudos, kids! Copyright © 2000. All rights reserved.

C. <i>Alarmist Rhetoric?—A Day in The Lower Courts</i>	
1. <i>Appellate Splits, anyone?</i>	861
2. <i>Downstairs, The Good Guys Always Win</i>	868
D. <i>Candles in the Protectionists' Wind</i>	870
1. <i>Kennedy for President—the Ferrari dissent</i>	874
2. <i>Cudahy Plugs Leaks—the Kohler dissent</i>	876
3. <i>“Close the Door, Oliver”, Quips Flaum</i>	878
E. <i>Two Faces Have I—The Federal Circuit Speaks</i>	
1. <i>Elmer Sticks Like Krazy</i>	879
2. <i>Kafaesque Karavan</i>	881
IV. DOES DOC FUNCTIONALITY CURE ALL ILLS?.....	884
V. KIBITZING FOR THE KAHUNAS—A PROPOSAL.....	886
I. KONFOUNDING KONUNDRUM—AN INTRODUCTION	

The Karavan, a public bus, is heading for the cliff, chased by wine-inspired winches on boat trailers that have been fueled by overheated thermostats. But lo, just in the nick of time, to avert a potentially perpetual tragedy, a hopeful sign appears, and takes a stand. Try as they might, the strong winds of protectionists cannot knock over this sign, sprung to life (in a duel fashion) by our competition-loving Supreme Court, acting as our Traffix Kops, who may just put the brakes on our runaway Karavan, saving the public, before it's too late.²

This paper discusses one of the most interesting intellectual property conundrums that the U.S. Supreme Court has taken on in quite awhile.

The late, great Saul Lefkowitz, former Chairman of the Trademark Trial and Appeal Board (TTAB), clearly recognized the conundrum almost 40 years ago in the first of three published decisions involving the trademark registrability of the Mogen David wine bottle which, at the time, was the subject of an unexpired design patent. Appearing below in FIG. A is Mogen David's design patent, while in FIG. B is the configuration Mogen David wanted to register as a trademark.

In the first decision, *Mogen David I*,³ the TTAB held that the bottle was not registrable as a trademark on the Principal Register. Chairman Lefkowitz reasoned as follows:

Since the design patent is due to expire in 1964, it is apparent that issuance of a registration on the Principal Register for the same subject matter would be inconsistent

² The meaning of this paragraph, and the cases it obliquely references, will unfold with this paper.

³ In re Mogen David Wine Corp., 134 U.S.P.Q. (BNA) 576 (Trademark Trial & App. Bd. 1962).

April 18, 1950

W. A. NESTER

Des. 158,213

BOTTLE

Filed Jan. 3, 1949

Fig. 1.

Fig. 2.

Fig. 3.

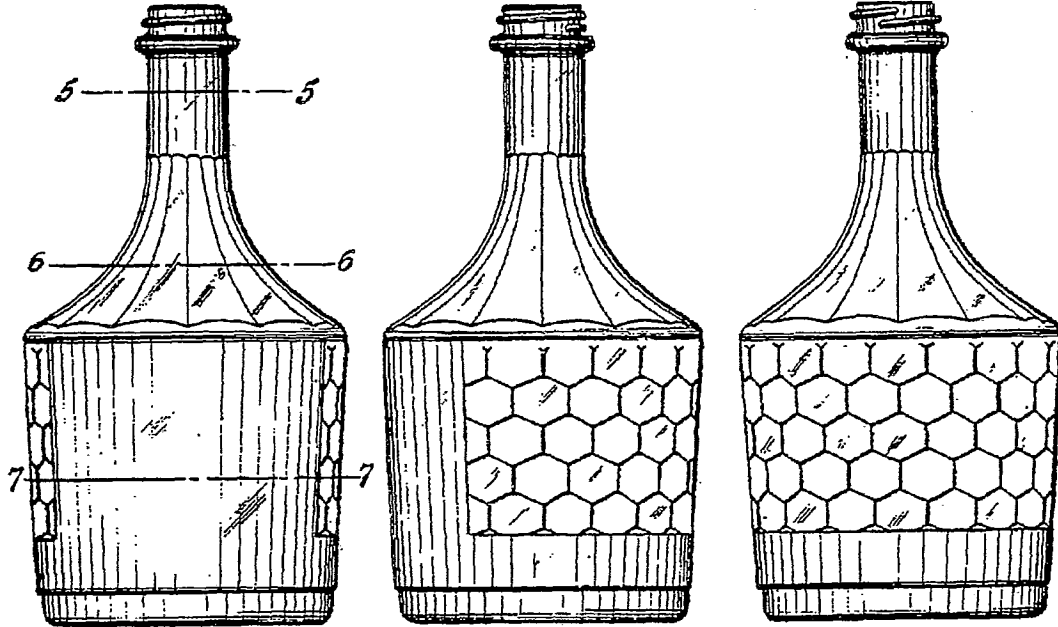


FIG. A

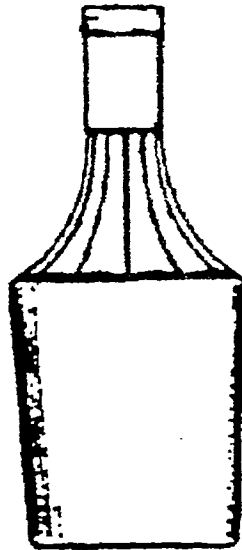


FIG. B

with the rights of others to make fair use of said bottle . . . after expiration of the [design] patent, and that it would serve, in effect, to extend the protection accorded the patented design contrary to the purpose and intent of the patent law. 134 USPQ 576 at 578 (TTAB 1962).

Thus, simply stated, the conundrum is this: how can one obtain exclusive trademark/trade dress rights in a product design that is the subject of an expired patent? Since trademark rights last as long as the owner uses the mark, would this not be tantamount to granting a potentially perpetual monopoly in contravention of the Constitutional clause that restricts the exclusive rights of inventors to "Limited Times"?⁴

Two major public interests behind granting a patent are that: (1) progress is promoted by disclosing the subject matter of the patent to the public immediately upon patent issuance, whereby the public quickly learns of the invention and can build upon that knowledge;⁵ and (2) upon the expiration of the patent, the subject matter is dedicated to the public, free to be made, used or sold by anyone without interference from the former patent owner.⁶

Thus, an important basis for the patent law is the bargain between the inventor and the public, the former getting her limited monopoly, the public getting free use of the invention after the patent expires. Courts have long recognized that patents, trademarks and copyrights are an exception to the overriding public policy favoring open and free competition. Competition unfettered by monopolies is beneficial, since it creates more choices and lower prices for consumers (witness the personal computer industry over the last 10 years).

In contrast to the patent law system, Congress created the Lanham Trademark Act to protect consumers from confusion, not to encourage innovation.⁷ Trade dress law,⁸ a branch of trademark law, protects consumers from confusion as to whose products they are buying since the

4 U.S. CONST. art. I, §8, cl. 8. The "limited times" provision was intended to encourage invention by granting a limited monopoly in time, and thereby promote the progress of useful arts. The limited monopoly includes the right to exclude others from making, using, selling, offering for sale, and importing the invention for 20 years. 35 U.S.C. §271.

5 Aronson v. Quick Point Pencil Co., 440 U.S. 257, 201 U.S.P.Q. (BNA) 1, 4 (1979).

6 See *infra* §III.A.1..

7 Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts, 944 F.2d 1235, 20 U.S.P.Q.2d (BNA) 1001, 1015 (6thth Cir. Tenn. 1991) (Kennedy, J., dissenting).

8 Trade dress constitutes a "symbol" or "device" under §43(a) of the Lanham Act, and while originally included only the packaging of a product, in recent years has been expanded to encompass the design of a product, i.e., the shape or configuration of a product. Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 120 S. Ct. 1339, 1342, 54 U.S.P.Q. 2d (BNA) 1065 (2000).

trade dress (in our case, product configuration), serves to identify the source of the goods.⁹

Saul Lefkowitz in *Mogen David I* recognized that using trademark/trade dress law to claim exclusivity in the subject matter of an expired patent would defeat the purpose behind the limited monopoly in patent law, thereby cheating the public of its bargain made with the inventor. It would be a breach of contract.

In *Mogen David II*¹⁰ and *Mogen David III*¹¹, to be discussed *infra*,¹² the protectionist CCPA lost sight of the Lefkowitz logic from *Mogen David I* and ignored longstanding Supreme Court precedent on the "right to copy"¹³ in deciding that there was no problem in granting trademark protection on a product regardless of whether it was or had been patented. The ill-reasoned *Mogen David II* decision, rendered in 1964, somehow became the underpinning for many later district court and appellate decisions upholding trade dress rights in the subject matter of expired patents, including the CCPA's own *In re Honeywell*¹⁴ case, decided in 1974. Both *Mogen David II* and *Honeywell* were cited to support the even more poorly reasoned *Midwest Industries, Inc. v. Karavan Trailers, Inc.*¹⁵ decision by the Federal Circuit in 1999, which was, in turn, relied upon by the Sixth Circuit in its *Marketing Displays, Inc. v. Traffix Devices, Inc.*¹⁶ ("*Traffix*") decision that the Supreme Court in June, 2000 thankfully agreed to review.

After discussing the *Traffix* case, this paper will review the Supreme Court decisions which make it clear that there is solid, ample precedent for the public's right to copy products in the public domain, which is, at the very least, the subject matter of expired patents. We will review how most of the lower courts, in their protectionist fervor, have handled the public's right to copy, which is essentially to deny that it exists, many relying upon the ill-reasoned *Mogen David II* and *Honeywell*

9 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162, 34 U.S.P.Q.2d (BNA) 1161, 1163 (1995) (citing 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §2.01 (4th ed. 1996).

10 *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 U.S.P.Q. 2d (BNA) 575 (C.C.P.A. 1964).

11 *In re Mogen David Wine Corp.*, 372 F.2d 539, 152 U.S.P.Q. 593 (C.C.P.A. 1967).

12 §III.B.1.

13 §III.A.1., *infra*.

14 *In re Honeywell, Inc.*, 497 F.2d 1344, 181 U.S.P.Q. (BNA) 821 (C.C.P.A. 1974), *cert. denied*, 419 U.S. 1080 (1974).

15 *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 50 U.S.P.Q.2d (BNA) 1672 (Fed. Cir. 1999).

16 *Marketing Displays, Inc., v. Traffix Devices, Inc.*, 43 U.S.P.Q. 2d (BNA) 1865 (E.D. Mich 1999), *rev'd in part and remanded*, 200 F.3d 929, 53 U.S.P.Q.2D (BNA) 1335 (6th Cir. Mich. 1999), *cert. granted*, 120 S. Ct. 2715 (2000).

cases as authority. And we will show how the doctrine of functionality, used by most courts as the touchstone test to resolve the conundrum, fails to do so. Finally, following the Supreme Court's lead in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,¹⁷ we suggest an easier, bright line test to be used in those situations where trade dress is claimed in the subject matter of an expired patent.

II. GOOD GUYS, BAD GUYS—A TRAFFIX JAM

In 1972, Robert Sarkisian, principal of Marketing Displays, Inc. ("MDI"), obtained two utility patents for a unique sign structure which had two springs at the base to allow the sign to flex during windy weather (see FIG. C below).

For many years, MDI successfully asserted these utility patents against the competition. In one case, the infringer had made a sign where the two springs, instead of being on the ends as shown in the patents, were located close together in the middle of the sign, much like the current version of the MDI sign shown below in FIG. D.

United States Patent (15) 3,646,696
Sarkisian (45) Mar. 7, 1972

(54) POSTER DISPLAY DEVICE
(72) Inventor: Robert Sarkisian, 3644 Woodside Park Drive, Oak Park, Mich. 48237
(22) Filed: Sept. 11, 1967
(21) Appl. No.: 675,811

(52) U.S. Cl.: 40/125 H, 40/145 A, 240/100
(51) Int. Cl.: L02M 7/00
(53) Field of Search: 40/125 H, 145 A, 131, 240/100, 244/373, 271/296

(54) Reference Cited

UNITED STATES PATENTS

1,332,105	4/1923	Beck	40/145 A US
1,241,250	4/1923	Thomson	40/125 H
2,165,704	7/1939	Wood	40/145 A
1,200,118	2/1936	Muehler et al.	40/125 H

FOREIGN PATENTS OR APPLICATIONS

339,325	12/1930	Graindhalo	40/125 H
---------	---------	------------	----------

Primary Examiner—Robert W. Mitchell
Assistant Examiner—Richard Carter
Attorney—Wittmann, Holbert & Bellows

5 Claims, 6 Drawing Figures

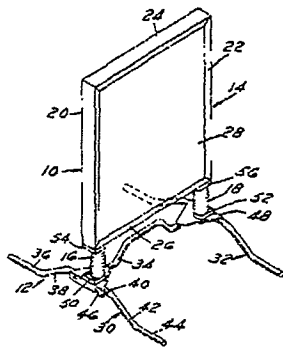


FIG. C

United States Patent (15) 3,662,482
Sarkisian (42) May 16, 1972

(54) POSTER DISPLAY DEVICE 358,624 5/1958 Switzerland 40/145 A
(72) Inventor: Robert Sarkisian, 3644 Woodside Park Drive, Oak Park, Mich. 48237
(22) Filed: July 30, 1970
(21) Appl. No.: 19,213

(52) U.S. Cl.: 40/125 H, 40/145 A
(51) Int. Cl.: L02M 7/22
(53) Field of Search: 40/125 H, 145 A

(54) Reference Cited

UNITED STATES PATENTS

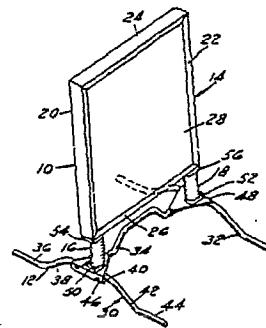
420,250	4/1899	Webb	40/125 H
1,272,843	4/1923	Beck	40/145 A
1,341,200	4/1923	Thomson	40/125 H
2,243,912	6/1941	Logler	40/145 A

FOREIGN PATENTS OR APPLICATIONS

241,196	1/1941	Anonymous	40/145 A
---------	--------	-----------	----------

Primary Examiner—Robert W. Mitchell
Assistant Examiner—Richard Carter
Attorney—Wittmann, Holbert & Bellows

3 Claims, 8 Drawing Figures



¹⁷ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 120 S. Ct. 1339, 54 U.S.P.Q. 2d (BNA) 1065 (2000).



FIG. D

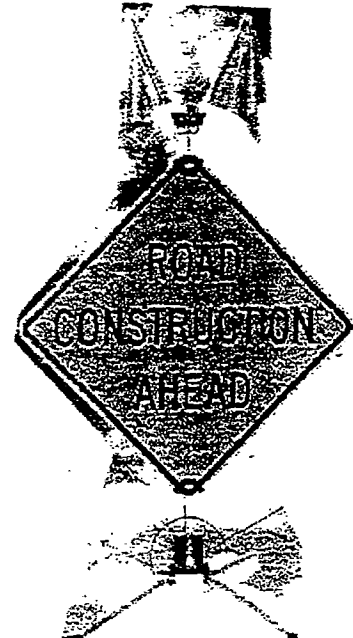


FIG. E

MDI won that patent infringement case, successfully arguing that the two closely-spaced spring structure infringed its utility patent under the doctrine of equivalents.¹⁸ The utility patents expired in 1989.

Sometime later, a competitor Traffix Devices, Inc. ("Traffix") decided to enter this lucrative market with a sign that looked quite similar to MDI's current version (see FIG. E):

Traffix thought this was o.k., since they knew that the patents on the MDI product had expired and were thus in the public domain. MDI's lawyers, ever creative, did not let patent expiration stand in their way. MDI asserted the Lanham Trademark Act's section 43(a) against Traffix, saying, in effect, "The appearance of our dual-spring sign stand is distinctive and non-functional, and thus constitutes protectible trade dress, and you're infringing." Traffix said, "Wait a minute, how can you withdraw something from the public domain by virtue of expired utility patents and assert trademark rights in it?" And that is the precise question that the U.S. Supreme Court is about to decide.¹⁹

¹⁸ *Sarkisian v. Winn-Proof Corp.*, 203 U.S.P.Q. (BNA) 60 (D. Or. 1978), *aff'd in part, rev'd in part*, 686 F.2d 671, 217 U.S.P.Q. (BNA) 702, 710-11 (9th Cir. Or. 1981).

¹⁹ *Marketing Displays, Inc., v. Traffix Devices, Inc.*, 43 U.S.P.Q. 2d (BNA) 1865 (E.D. Mich. 1997), *rev'd in part and remanded*, 200 F.3d 929, 53 U.S.P.Q.2D (BNA) 1335 (6th Cir. Mich. 1999), cert. granted, 120 S. Ct. 2715 (2000).

The Eastern District of Michigan, where the case was first brought in 1997, found that MDI's design was not sufficiently distinctive to serve as a trademark. In addition, MDI failed to meet its burden to prove its trade dress was nonfunctional according to the test set forth by the Supreme Court in *Qualitex Co. v. Jacobson Products Co.*:

'In general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.²⁰

Applying this standard, the court found the existence of two utility patents disclosing the utilitarian advantages of the dual-spring design, and their successful enforcement over the years created a presumption that the design was functional.²¹ The court also considered the absence of equivalent alternative designs and MDI's emphasis on functional features in its advertising as further evidence of functionality.²²

Although the court briefly discussed the public's right to copy the subject matter of expired patents,²³ like many other courts it assumed that the doctrine of functionality adequately guarded against the evil of a perpetual monopoly, and spent most of its opinion analyzing the functionality issue. The court granted summary judgment in favor of Traffix.

MDI appealed. The Sixth Circuit Court of Appeals reversed, holding that summary judgment was inappropriate because MDI had established genuine issues of material fact as to both secondary meaning and functionality.²⁴ On the latter issue, the appeals court rejected the lower court's assertion that the disclosure of a feature in a prior utility patent creates a presumption against trade dress protection for that feature.²⁵ It said that there exists a split in the circuits on this issue, with the Fifth,²⁶ Seventh²⁷ and Federal Circuits²⁸ holding that disclosure in a utility pat-

20 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 U.S.P.Q.2d (BNA) 1161, 1163 (1995).

21 *Marketing Displays, Inc.*, 43 U.S.P.Q. 2d at 1874-75. MDI argued that the '696 and '482 patents were irrelevant to the issue of functionality because they do not disclose the closely-spaced dual-spring configuration of Traffix's stand. The court rejected this argument because MDI had, in prior litigation, successfully argued that stands having a closely-spaced dual spring design infringed claims of the '696 and '482 patents under the doctrine of equivalents. 43 U.S.P.Q. at 1875-76.

22 *Marketing Displays, Inc.*, 43 U.S.P.Q. 2d at 1877.

23 *Marketing Displays, Inc.*, 43 U.S.P.Q.2d at 1874.

24 *Marketing Displays, Inc., v. Traffix Devices, Inc.*, 200 F.3d 929, 53 U.S.P.Q.2d (BNA) 1335, 1345 (6th Cir. Mich. 1999), *cert. granted*, 120 S. Ct. 2715 (2000).

25 *Marketing Displays, Inc., v. Traffix Devices, Inc.*, 53 U.S.P.Q.2d (BNA) at 1342.

26 See *Sunbeam Prods., Inc.*, *infra.* notes 132-137.

27 See *Thomas & Betts II*, *infra.* note 192.

28 See *Midwest Industries Inc.*, *infra.* note 170.

ent does not preclude trade dress protection for a feature and only the Tenth Circuit²⁹ holding to the contrary. Siding with the Fifth, Seventh and Federal Circuits, the Sixth Circuit reasoned that a *per se* rule is unnecessary because Traffix could use a dual-spring design and avoid infringing MDI's trade dress by changing the appearance of its stand in other ways (e.g., by using different leg members or uprights).³⁰

The Sixth Circuit thus took the course many courts have taken, which is that it is o.k. for a plaintiff to appropriate a design that is in the public domain by virtue of an expired patent, as long as a competitor can compete in the same market with a functional product that doesn't look like the plaintiff's.

Traffix argued that it could not use alternate designs since they were also patented. However, to the Sixth Circuit, there was nevertheless something wrong with Traffix, the "bad guys," copying the "good guys" MDI's design and competing with it:

Traffix does not get to copy the trade dress of its competitor whose patent has expired just because other design options are still under patent. Traffix could come up with its own design, or license one of the outstanding patents, or use the dual-spring design in a way that does not infringe MDI's trade dress.³¹

Similar anti-copying, or protectionist, attitudes appear in other court opinions.³² While emotionally appealing, such "good guy/bad buy" pronouncements have no foundation in the law, and appellate courts should be more even-handed in their legal treatment of the "bad guy," even when it might seem unpopular.³³ As further evidence of its protectionist leanings, the Sixth Circuit's opinion tellingly did not even mention the most compelling Supreme Court precedents that rather

29 See *Vornado Air Circulation Sys., Inc.*, *infra*. note 112.

30 *Marketing Displays, Inc.*, 53 U.S.P.Q.2d (BNA) at 1342.

31 *Id.* at 1344.

32 See, e.g., *Landscape Forms Inc. v. Columbia Cascade Co.*, 940 F.Supp. 663, 40 U.S.P.Q.2d (BNA) 1943, 1947 (S.D.N.Y. 1996) ("In sum, Columbia had both the ability and the incentive to come up with its own competitive product, and therefore may not, in the face of its indolence in failing to do so, seek to reap the benefits of Landscape's creative efforts by copying its unique and aesthetically appealing trade dress.") See also *Door-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 39 U.S.P.Q.2d (BNA) 1990, 1996 (7th Cir. Ill. 1996) (wherein the appellate court criticized the district court's decision as being "based on its general notion that '[I]t is inherently unfair for a competitor to enter the market on the back of the originator of a design.' ") See also *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 40 U.S.P.Q.2d (BNA) 1705, 1710 (11th Cir. Fla. 1996) ("We empathize with the reaction of the magistrate judge to the faithless malfeasance of a defendant who copies his employer's unpatented product while purporting to be its agent.")

33 Perhaps akin to taking a First Amendment stand for unpopular speech expression, e.g., a KKK rally.

unequivocally state that the public has a right to copy products in the public domain by virtue of expired patents.³⁴

The Sixth Circuit remanded the case to the lower court for reconsideration of MDI's trade dress and unfair competition claims, and the Supreme Court granted *certiorari* to consider the conundrum issue.

III. KOPY KATS V. PROTECTIONISTS—THE TRADE DRESS/PATENT INTERFACE

This section will review how various courts have handled the conundrum issue, from the very earliest Supreme Court cases through the current Circuit Court and District Court opinions, including a close look at how our specialized patent court—the U.S. Court of Appeals for the Federal Circuit, and its predecessor, the U.S. Court of Customs and Patent Appeals (CCPA), have dealt with it.

A. *Stop! In the Name of the Public—The Supremes*

The U.S. Supreme Court has for over 100 years been almost the lone voice in the wilderness on behalf of the public's right to copy, standing up time after time against the protectionists.

1. *Where Did Our Rights Go?—The Early Supremes*

Two older Supreme Court cases, *Singer*³⁵ and *Kellogg*,³⁶ firmly established that the public has a right to copy the subject matter of expired patents.

Over 100 years ago, the Singer Manufacturing Company sued the June Manufacturing Company alleging, among other claims,³⁷ that June had engaged in unfair competition by selling sewing machines “of the exact size, shape, ornamentation, and general external appearance” as machines sold by Singer.³⁸ June argued that the “size, shape and appearance” of Singer's sewing machines were public property because the features incorporated into June's machines were the subject of nearly 100 patents, all of which had expired long before Singer brought suit.³⁹ The Supreme Court agreed, stating that:

³⁴ See §III.A.1 and III.A.2, *infra*.

³⁵ *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 16 S. Ct. 1002 (1896).

³⁶ *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S. Ct. 109 (1938).

³⁷ Singer also alleged that June engaged in unfair competition by using the “Singer” mark on its sewing machines without any indication that the machine was not manufactured by Singer. The Supreme Court agreed, and reversed the lower court's judgment in favor of June on this issue. *Singer Mfg. Co.*, 163 U.S. at 202–4.

³⁸ *Singer Mfg. Co.*, 163 U.S. at 170.

³⁹ *Singer Mfg. Co.*, 163 U.S. at 170.

[I]t is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent.⁴⁰

Thus, the Supreme Court has clearly recognized the public's "right to copy" the subject matter of expired patents.

Forty years later, the Court affirmed the public's right to copy in a case where the National Biscuit Company ("Nabisco") sued Kellogg alleging in part that Kellogg infringed Nabisco's state trade mark rights by advertising and selling a pillow-shaped wheat biscuit.⁴¹ Nabisco had obtained utility patents⁴² on its famous shredded wheat biscuit [see FIG. F

UNITED STATES PATENT OFFICE.

HENRY D. PERKY, OF DENVER, COLORADO.

BREAD AND METHOD OF PREPARING SAME.

SPECIFICATION forming part of Letters Patent No. 548,086, dated October 15, 1895.

Application filed March 15, 1894. Serial No. 503,777. (No specimens.)

Having described this invention, what I claim, and desire to secure by Letters Patent, is—

1. A food or bread composed of superposed or massed layers or deposits of dry, externally rough, porous, sinuous threads or filaments of cooked whole wheat containing intermixed the bran, starch, and gluten of the entire berry, and which is absolutely free from leavening or raising material, or their products.

FIG. F

⁴⁰ *Id.* at 185.

⁴¹ Kellogg, 305 U.S. at 111. Nabisco also alleged that Kellogg's engaged in unfair competition by using the term "Shredded Wheat" in association with breakfast cereal. The Supreme Court rejected this claim on the ground that the term was generic. *Id.* at 112-113.

⁴² See, e.g., U.S. Pat. No. 548,086 "Bread and Method of Preparing Same", issued October 15, 1895.

below] and machines for making it. Nabisco also had a design patent⁴³ [see FIG. G below] covering the shape of the biscuit.

Following the precedent of *Singer*, the Supreme Court held that Kellogg was free to make and sell pillow-shaped wheat biscuits because the pillow-shaped form was essentially in the public domain. In so holding, the Court per Mr. Justice Brandeis stated:

DESIGN.

**H. D. PERKY.
BISCUIT.**

No. 24,688.

Patented Sept. 17, 1895.

Fig. 1.

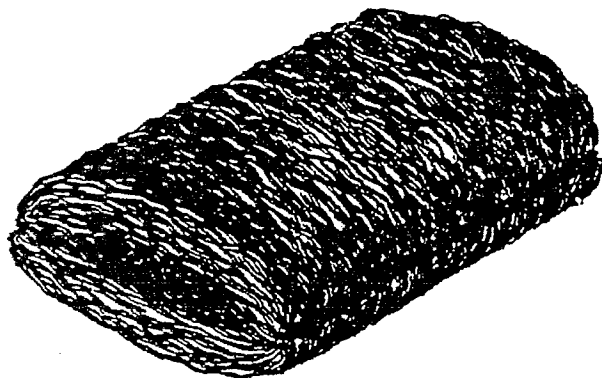


Fig. 2.

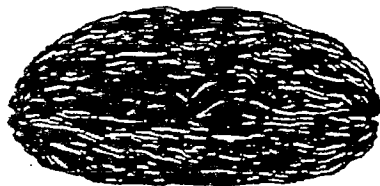


FIG. G

⁴³ See, e.g., U.S. Pat. No. Des. 24,688, issued September 17, 1895.

The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. The patented machines used were designed to produce only the pillow-shaped biscuits. And a design patent was taken out to cover the pillow-shaped form. Hence, upon expiration of the patents the form, as well as the name, was dedicated to the public.⁴⁴

The Court also stated that Kellogg's use of the pillow-shaped form did not amount to unfair competition, despite the fact that Nabisco had developed substantial goodwill in the pillow-shaped form:

Kellogg Company is undoubtedly sharing in the goodwill of the article known as "Shredded Wheat"; and thus is sharing in a market which was created by the skill and judgment of plaintiff's predecessor and has been widely extended by vast expenditures in advertising persistently made. But that is not unfair. Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested."⁴⁵

In support of its conclusion, the Court also noted that the pillow-shaped form was "functional", i.e., that use of alternative shapes would be more costly and of lower quality than the pillow-shaped form.⁴⁶

2. *My World is Preempted Without You—Sears, Compco and Bonito Boats*

Three Supreme Court decisions, *Sears*,⁴⁷ *Compco*⁴⁸ & *Bonito Boats*,⁴⁹ applied the "right to copy" doctrine to invalidate state unfair competition statutes under the Supremacy Clause of the U.S. Constitution on the basis that they conflicted with federal patent law.

An Illinois unfair competition statute was at issue in *Sears Roebuck & Co. v. Stiffel Co.*⁵⁰ and *Compco Corp. v. Day-Brite Lighting, Inc.*⁵¹ In both cases, the plaintiffs had obtained design patents on their products, and in both cases, the design patents were ruled invalid by the district court. The plaintiffs elected to proceed against the defendants under an Illinois unfair competition law. The district courts found the defendants liable under that law merely on the basis of similarity of appearance and

44 Kellogg, 305 U.S. at 119–20.

45 *Id.* at 122.

46 Kellogg, 305 U.S. at 122.

47 *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 140 U.S.P.Q. (BNA) 524 (1964).

48 *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 140 U.S.P.Q. (BNA) 528 (1964).

49 *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 9 U.S.P.Q. 2d (BNA) 1847 (1989).

50 *Sears Roebuck & Co.*, 140 U.S.P.Q. (BNA) 524.

51 *Compco Corp.*, 140 U.S.P.Q. (BNA) 528.

function between the defendants' products and the plaintiffs' products.⁵² In both cases, the Seventh Circuit Court of Appeals affirmed.⁵³

The Supreme Court struck down the Illinois unfair competition law under the Supremacy Clause because it provided "patent-like" rights to products that were unpatentable.⁵⁴ The Court explained that the purpose of the federal patent system is to promote invention by giving the inventor the right, for a limited time, to exclude others from using the invention.⁵⁵ In exchange for this right, upon expiration of the patent, the right to use the invention "passes to the public."⁵⁶ The Court concluded that Illinois' unfair competition law granted plaintiffs the equivalent of a patent monopoly on unpatented products, in direct conflict with the federal patent system.⁵⁷

Similarly, in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,⁵⁸ the Supreme Court addressed a similar issue with respect to a Florida statute that prohibited use of a direct molding process to duplicate a manufactured vessel hull made by another.⁵⁹ In this case, Bonito developed a hull design for a fiberglass recreational boat. Thunder Craft Boats copied the hull design. Bonito sued Thunder Craft alleging violation of Florida's hull design statute.

Thunder Craft moved to dismiss Bonito's claim on the ground that the Florida statute was invalid under the Supreme Court's holdings in *Sears* and *Compco*.⁶⁰ The trial court granted Thunder Craft's motion, a decision that was affirmed by both the Florida Court of Appeals⁶¹ and the Florida Supreme Court.⁶²

The Supreme Court agreed, holding the Florida statute invalid. The Court stated that "for almost 100 years it has been well established that

52 *Sears Roebuck & Co.*, 140 U.S.P.Q. (BNA) at 526, *Compco Corp.*, 140 U.S.P.Q. (BNA) at 529.

53 *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115, 136 U.S.P.Q. (BNA) 292 (7th Cir. Ill. 1963); *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26, 136 U.S.P.Q. (BNA) 17 (7th Cir. Ill. 1962).

54 *Sears Roebuck & Co.*, 140 U.S.P.Q. (BNA) at 528; *Compco Corp.*, 140 U.S.P.Q. (BNA) at 530.

55 *Sears Roebuck & Co.*, 140 U.S.P.Q. (BNA) at 527.

56 *Id.* (citing *Kellogg*, 305 U.S. at 120-22 (1938) and *Singer Mfg. Co.*, 163 U.S. at 185 (1896)).

57 *Sears Roebuck & Co.*, 140 U.S.P.Q. (BNA) at 528.

58 *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 9 U.S.P.Q. 2d (BNA) 1847(1989).

59 *Bonito Boats, Inc.*, 9 U.S.P.Q. 2d (BNA) at 1849 (Fla. Stat. § 559.94(2) (1987) makes "[i]t . . . unlawful for any person to use the direct molding process to duplicate for the purpose of sale any manufactured vessel hull or component part of a vessel made by another without the written permission of that other person." The Statute also prohibits a person from "knowingly sell[ing] a vessel hull or component part of a vessel duplicated in violation of subsection (2).")

60 *Bonito Boats, Inc.*, 9 U.S.P.Q.2d (BNA) at 1850.

61 *Id.*, See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 487 So.2d 395 (Fla. Dist. Ct. App. 5th Dist.1986).

62 *Id.*, See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 515 So.2d 220, 5 U.S.P.Q.2d (BNA) 1124 (Fla.1987).

in the case of an expired patent, the federal patent laws do create a federal right to copy and use.”⁶³ The Court reasoned that an inventor must either choose to use federal protection for product configurations or choose to “dedicate his idea to the public at large.”⁶⁴ The Court held that neither Florida, nor any other State, could create patent-like rights that would bar the copying of design and utilitarian ideas embodied in unpatented products. Thus, the Court followed its previous decisions in *Singer*, *Kellogg*, *Sears*, and *Compco*.

3. *Nothing But Heartaches—Doc Functionality Answers All House Calls*

The Lanham Trademark Act of 1946⁶⁵ contained a new §43(a)—a federal law of unfair competition—that allowed one to bring suit in federal court for infringement of unregistered trademarks.⁶⁶ Section 43(a) became very popular as the basis for suits for trade dress infringement (trade dress being a type of trademark).⁶⁷ Although initially limited to product packaging, trade dress suits under §43(a) have expanded tremendously over the last 30 years to include product configuration trade dress—referred to recently by the Supreme Court as “product design.”⁶⁸

Section 43(a) introduced a new wrinkle into the conflict between trademark/trade dress law and the “right to copy” implicit in federal patent law. The new wrinkle was that the doctrine of federal preemption, dispositive in the *Sears*, *Compco* and *Bonito Boats* cases, simply did not apply to a potential conflict between two federal statutes—the federal patent law⁶⁹ and the federal trademark law.⁷⁰

Thus, recognizing the potential conundrum of extending federal trademark rights under the Lanham Act to patentable or patented products, and realizing that federal preemption did not answer this latest incarnation of the conundrum, courts turned to the doctrine of functionality to deal with it. The underlying purpose of the doctrine of functionality is essentially to prevent use of the trademark law to protect useful product features that Congress has said can only be protected with a utility patent.⁷¹ Courts either reasoned that application of the doctrine of

63 *Id.* at 1857.

64 *Id.* at 1851.

65 15 U.S.C. §1051 et seq.

66 *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA)1081, 1083(1992).

67 *Id.*

68 *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 120 S. Ct. 1339, 54 U.S.P.Q. 2d (BNA) 1065 (2000), discussed *infra* at §III.A.4.

69 35 U.S.C. §100 et seq.

70 15 U.S.C. §1051 et seq.

71 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7:89 (4th ed. 1996).

functionality avoided any conflict with the public's right to copy,⁷² or that application of the doctrine strikes an appropriate balance between public's right to copy and avoiding consumer confusion.⁷³

One of the most widely used definitions of functionality was stated by the Supreme Court in its 1995 decision *Qualitex Co. v. Jacobson Products Co.*:

'In general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.⁷⁴

The CCPA in *In re Morton Norwich Products, Inc.*, 671 F.2d 1332, 1336, 213 USPQ 9 (CCPA 1982) set forth its spin on functionality:

Functionality is determined in light of 'utility,' which is determined in light of 'superiority of design,' and rests upon the foundation 'essential to effective competition.'⁷⁵

In *Morton Norwich*, the court identified the following 4 factors as the evidentiary inquiry when considering whether a design is impermissibly functional:

- (1) whether a utility patent discloses 'the utilitarian advantage' of the design;
- (2) whether advertising refers to the design as utilitarian;
- (3) whether functionally equivalent alternative designs are available to competitors; and
- (4) whether the design is a result of 'a comparatively simple or cheap method of manufacturing.'⁷⁶

While the foregoing fairly states traditional "utilitarian" tests for functionality, it is equally clear that those tests cannot be applied to product features which are non-utilitarian, i.e., the shape or configuration of a product and/or the surface decoration on a product.⁷⁷ Of course, such non-utilitarian features, which the Supreme Court connotes as

⁷² *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 40 U.S.P.Q.2d (BNA) 1705, 1710 (11th Cir. Fla. 1996).

⁷³ *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 228 U.S.P.Q. 145, 146 (7th Cir. Wis. 1985); McCarthy, *supra* note 71, at §7.26; Jay Dratler, *Trademark Protection for Industrial Designs*, 4 University of Illinois Law Review 887, 928, 938 (1988); *Qualitex Co.*, 34 U.S.P.Q.2d (BNA) at 1163; *Bonito Boats, Inc.*, 9 U.S.P.Q.2d (BNA) at 1858.

⁷⁴ *Qualitex Co.*, 35 U.S.P.Q. 2d (BNA) at 1163, *citing* *Inwood Laboratories Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 U.S.P.Q. (BNA) 1 (1982).

⁷⁵ *In re Morton Norwich Products, Inc.*, 671 F.2d 1332, 213 U.S.P.Q. (BNA) 9, 15 (C.C.P.A. 1982).

⁷⁶ *Id.* at 15-16.

⁷⁷ Design patents can protect such non-utilitarian, ornamental features. 35 U.S.C. §171.

“product design” features,⁷⁸ can be as essential to competition (i.e., *de jure* functional) as utilitarian features.⁷⁹ While some courts have adopted the doctrine of “aesthetic functionality”⁸⁰ to reconcile this conflict, more recently “aesthetic functionality” has been criticized because it does not have a specific set of standards and when applied produces inconsistent results in the courts.⁸¹

While the underlying purpose of the traditional utilitarian functionality doctrine is to avoid conflict between trademark law and utility patent law, it is possible that the aesthetic functionality doctrine, were it not so difficult to apply, might offer a solution to the conflict between trademark law and design patent law (which actually only conflict if the design patent has expired).⁸² Would not then the two functionality doctrines, taken together, offer a tempting, complete answer to the conundrum?

Although in its most recent pronouncement on functionality, the Supreme Court appeared to quote the Restatement of Unfair Competition on aesthetic functionality with approval,⁸³ it is hard to imagine a more murky, litigation provoking test to foist on competitors,⁸⁴ and thus the Court should shy away from its resurrection.

4. ATTENTION! Wal-Mart Shoppers

The recently decided case of *Wal-Mart Stores, Inc. v. Samara Bros, Inc.*,⁸⁵ handed down in March, 2000 by the Supreme Court, although not directly on point regarding the trade dress/patent conundrum, nevertheless provides some insight into the Court’s proclivities when it comes to trade dress law for protecting product designs.

At issue in *Wal-Mart* was the proper test for determining when the design of a product, i.e., its trade dress, is “inherently distinctive”. Dis-

⁷⁸ See note 68, *supra*.

⁷⁹ cite Cudahy, J., in Kohler dissent.

⁸⁰ If a design’s ‘aesthetic value’ lies in its ability to confer a significant benefit that cannot practically be duplicated by the use of alternative designs, then the design is ‘functional’. Restatement (Third) of Unfair Competition §17, Comment c, pp. 175–176 (1995). The ‘ultimate test of aesthetic functionality is whether the recognition of trademark rights would significantly hinder competition.’ *Id.* at 176.

⁸¹ Dratler, *supra* note 83 at 511. See also, 2 McCarthy, McCarthy on Trademarks and Unfair Competition §7:80 (4th ed. 1996).

⁸² The only reported decision which appears to use the doctrine of aesthetic functionality to deny trade dress protection to the subject matter of an expired design patent is *Industria Arredamenti Fratelli Saporiti v. Charles Craig, Ltd.*, 725 F.2d 18, 222 U.S.P.Q. (BNA) 754 (2d Cir. N.Y. 1984) wherein Senior Circuit Judge Haynsworth concluded that the trade dress was impermissibly functional in view of the [expired] design patent without ever mentioning the right to copy.

⁸³ *Qualitex*, 34 U.S.P.Q.2d (BNA) at 1165.

⁸⁴ see §III.A.4., *infra*.

⁸⁵ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 U.S.P.Q.2d (BNA) 1065 (2000).

distinctiveness is a prerequisite to being able to assert rights in a trademark. With normal word marks, distinctiveness can be either inherent (e.g., for arbitrary or fanciful marks), which means that the mark is protectible immediately upon adoption and use, or acquired over time (e.g., for descriptive marks), which means that the mark is only protectible after it has acquired sufficient distinctiveness to serve as an indicator of source, also called "secondary meaning".

After the Court's 1992 decision in *Two Pesos, Inc. v. Taco Cabana, Inc.*,⁸⁶ which, in a case involving the décor of a Mexican restaurant, had held that trade dress should be treated like ordinary word trademarks for the purpose of determining when protection attached, the lower courts were struggling to define when the three-dimensional design of a product (also called product configuration trade dress) is inherently distinctive. A split in the circuits developed, some courts adhering to the traditional Abercrombie "spectrum of distinctiveness" formulation,⁸⁷ while others said no, that formulation doesn't work with product design trade dress.⁸⁸ The Court had before it several different proposed tests for inherent distinctiveness, among the most prominent being the so-called Seabrook Foods test⁸⁹ based on a 1977 formulation by the C.C.P.A. that was urged by the respondent Samara Brothers as well as the United States as *amicus curiae*.

The Court surprised many by declining to adopt any test, concluding that product design, like the color at issue in the *Qualitex* case, is incapable of ever being inherently distinctive. Thus, the Court found that in order to protect product design under the federal trade dress laws (Lanham Act, §43(a)), one must always prove that the design has acquired secondary meaning.

What is of interest regarding the conundrum from the *Wal-Mart* case is the Court's clear advocacy of open and free competition unhindered by marginal law suits, and its resulting aversion to adopting anything other than a clear test for inherent distinctiveness of product design. The Court said:

86 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).

87 *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 34 U.S.P.Q.2d (BNA) 1428 (8th Cir. Mo. 1995).

88 Such courts asked "How can one say that the trade dress is suggestive of a product when the trade dress IS the product?" *Duraco Products Inc. v. Joy Plastic Enterprises Ltd.*, 40 F.3d 1431, 32 U.S.P.Q.2d (BNA) 1724 (3d Cir. Pa. 1994).

89 (1) whether it is a "common" basic shape or design, (2) whether it is unique or unusual in a particular field, (3) whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods (4) whether it is capable of creating a commercial impression distinct from the accompanying words. *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 U.S.P.Q. (BNA) 289, 289-90 (C.C.P.A. 1977).

Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness. How easy it is to mount a plausible suit depends, of course, upon the clarity of the test for inherent distinctiveness, and where product design is concerned we have little confidence that a reasonably clear test can be devised.⁹⁰

If the *Wal-Mart* decision serves as any guide, it is hard to imagine the Court in *Traffix* resurrecting the murky aesthetic functionality doctrine⁹¹ as a solution to the failure of the traditional utilitarian functionality doctrine to deal effectively with the conflict between trade dress and expired design patents.⁹² Thus, a solution other than functionality⁹³ must surface in order to adequately resolve the conundrum.⁹⁴

B. *Three Blind Mice—The CCPA Speaks*

Two decisions by the Court of Customs and Patent Appeals (CCPA) form the lynchpin for many later court decisions that find no conflict between trademark/trade dress law and patent law, design patents in particular. Upon close inspection, both cases rest on shaky footings.

1. *Protectionists' Favorite Whine—Mogen David*

You will recall from the Introduction to this paper that Saul Lefkowitz early on recognized the conundrum in *Mogen David*⁹⁵ in rejecting the applicant's initial attempt to register as a trademark the configuration of its wine bottle that was also the subject of an unexpired design patent.⁹⁶ The applicant appealed the Lefkowitz refusal to the CCPA, resulting in *Mogen David II*;⁹⁷ this is the decision many courts rely on in brushing aside expired design patents. The CCPA reversed Lefkowitz, using such logic as this:

[T]rademark rights exist independently from design patent rights under different law and for different reasons. . . . [W]hen the patent monopoly ends, it ends; the trademark rights do not extend it. . . . [W]hat law or what rule in rhyme or reason

⁹⁰ *Wal-Mart*, 54 U.S.P.Q.2d (BNA) at 1069.

⁹¹ See §III.A.3., *supra*.

⁹² “. . . the attempt to characterize product features as ‘essential’ or ‘non-essential’ for competition is perplexing and ultimately vain.”, *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 29 U.S.P.Q.2d (BNA) 1241, 1255 (7th Cir. 1993) (Cudahy, J., dissenting).

⁹³ “The line between nonfunctional and functional is difficult to draw and an obvious source of litigation.”, *Id.*

⁹⁴ See §V., *infra*.

⁹⁵ See note 3, *supra*.

⁹⁶ For a discussion of *Mogen David I*, see §I., *supra*.

⁹⁷ See note 4, *supra*.

would preclude the patent grant or inhibit the concurrent enjoyment of the rights appertaining to both the design patent and the trademark?

The CCPA apparently did not bother to read Supreme Court decisions.⁹⁸

In *Mogen David III*,⁹⁹ the CCPA upheld the Board's refusal to register the wine bottle shape on the ground of insufficient showing of secondary meaning. The court did finally discuss the then recently decided *Sears* and *Compco* cases and distinguished them on the basis that they involved federal preemption of state laws. Incredibly, all three of the *Mogen David* opinions lacked any mention of the Supreme Court cases of *Singer* or *Kellogg* or *Scott Paper*, all of which had a strong right to copy flavor. How the *Mogen David II* case came to be taken so seriously by so many courts in their later decisions is therefore somewhat mystifying.

2. Circular Logic—Honeywell

Several years later, Honeywell sought (and eventually obtained) a trademark registration for a portion of a thermostat, a smooth outer ring and a center disc portion. These features, shown below in FIG. H, were a portion of the subject matter claimed in an expired design patent¹⁰⁰, also shown below as FIG. I.

United States Patent and Trademark Office

Reg. No. 1,622,108
Registered Nov. 13, 1990

HONEYWELL INC. (DELAWARE CORPORATION)
HONEYWELL PLAZA
MINNEAPOLIS, MN 55408

FOR: THERMOSTATS, IN CLASS 9 (U.S. CL. 26).

FIRST USE 0-0-1952; IN COMMERCE 0-0-1952.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE PORTION OF THE MARK COMPRISING A THERMOSTAT DIAL APART FROM THE MARK AS SHOWN.

THE LINING SHOWN ON THE DRAWING IS FOR SHADING PURPOSES ONLY.

THE MARK COMPRISES THE CONFIGURATION OF A THERMOSTAT COVER THAT IS CIRCULAR AND ROUNDED IN SHAPE.

SEC. 2(F).

SER. NO. 73-597,917, FILED 5-9-1986.

NANCY L. HANKIN, EXAMINING ATTORNEY

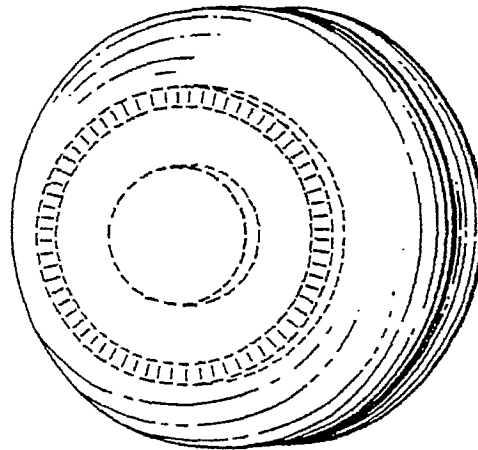


FIG. H

⁹⁸ See §§III.A.1. and III.A.2., supra.

⁹⁹ See notes 10-13, supra.

¹⁰⁰ In re Honeywell, Inc., 497 F.2d 1344, 181 USPQ 821 at 822 (C.C.P.A. 1974), U.S. Pat. No. Des. 176,657, issued January 17, 1956.

United States Patent Office

Des. 176,657
Patented Jan. 17, 1956

176,657

CONTROL INSTRUMENT

Henry Dreyfuss, South Pasadena, Calif., assignor to Minneapolis-Honeywell Regulator Company, Minneapolis, Minn., a corporation of Delaware

Application June 1, 1953, Serial No. 25,258

Term of patent 14 years

(Cl. D52-7)

FIG. 1

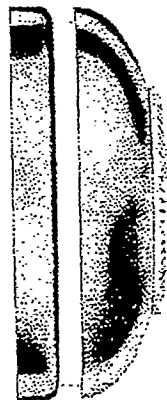
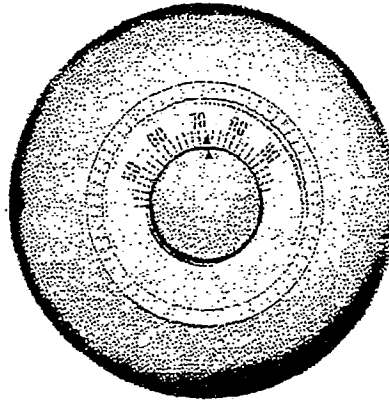


FIG. 2

FIG. 3

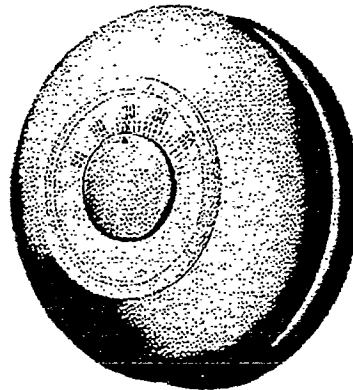


Figure 1 is a front elevation of a control instrument embodying my new design;

Figure 2 is a side elevation of the device shown in Figure 1; and

Figure 3 is a front perspective view of the device shown in Figure 1.

I claim:

The ornamental design for a control instrument, substantially as shown.

References Cited in the file of this patent

UNITED STATES PATENTS

D. 136,850	Dreyfuss	Dec. 14, 1943
2,394,920	Kronmiller	Feb. 12, 1946

FIG. I

Initially, the trademark examiner refused registration on the ground that the thermostat configuration was "incapable of functioning as a trademark . . . since the outer ring and center disc were merely functional in nature and dictated by the configuration of the thermostat itself."¹⁰¹ The examiner also mentioned that the existence of an expired design patent covering the shape weighed against registrability.¹⁰² The TTAB affirmed solely on the ground that disclosure of the subject matter in an expired design patent precluded registration of that subject matter.¹⁰³ The TTAB, taking its cue from Saul Lefkowitz in *Mogen David I*, reasoned that allowing registration would be inconsistent with the public's right to copy the subject matter of the expired design patent.¹⁰⁴ Honeywell appealed to the CCPA.

On appeal, the PTO Solicitor's Office finally argued the *Singer* and *Kellogg* line of cases holding the subject matter of an expired patent is dedicated to the public, and thus tried to cure the glaring deficiency of the *Mogen David* decisions. But the CCPA stuck to its guns, relying incredibly on the deficient *Mogen David II* decision as precedent for ignoring the expired design patent in *Honeywell*.¹⁰⁵

[W]e believe that the *Kellogg*, *Singer* and *Scott Paper* decisions cannot be properly construed to be applicable to the situation of *Mogen David*. . .¹⁰⁶

The CCPA had two rationales for arriving at this conclusion. First, the court drew a line somehow between product configurations that were the subject matter of expired utility patents, and those that were the subject matter of expired design patents, saying *Singer* and *Kellogg* had everything to do with the former and nothing to do with the latter. Aside from being factually inaccurate,¹⁰⁷ if a patentee has enjoyed the monopoly on a product for a limited period of 14 years with a design patent, is the design any less dedicated to the public than the subject matter of an expired utility patent? Incredibly, the court asserted that the public's right to copy the subject matter of expired design patents was distinguishable

101 *Honeywell*, 181 U.S.P.Q. at 822.

102 *Id.* at 822.

103 *Id.* at 822-23.

104 *Id.*

105 The court paid lip service to its earlier decisions in *Best Lock*, *Shenango*, *Shakespeare* and *Deister*, in which it held that trademark protection is not available functional subject matter disclosed in a utility patent, in view of the "overriding public policy of preventing their monopolization, of preserving the public right to copy."

106 *Honeywell*, 181 U.S.P.Q. at 826.

107 National Biscuit had an expired design patent on its pillow-shaped biscuit, see §III.A.1., *supra*.

from that of utility patents because, by definition, the subject matter of a design patent must be non-functional.¹⁰⁸

The court's second rationale was this:

[T]his court decided [in *Mogen David*] that the public interest—protection from confusion, mistake, and deception in the purchase of goods and services—must prevail over any alleged extension of design patent rights, when a trademark is non-functional and does in fact serve as a means to distinguish the goods of the trademark owner from those of others.¹⁰⁹

In other words, the CCPA believed that the right to copy was simply not as important as the public interest protection from confusion, mistake and deception in the purchase of goods. As we have seen, that is simply not how the Supreme Court has balanced those two interests in past decisions.¹¹⁰

Most later court decisions addressing the issue of trademark or trade dress protection for the subject matter of expired design patents have followed the *Mogen David/Honeywell* rationale.¹¹¹

C. Alarmist Rhetoric?—A Day in the Lower Courts

We will now examine how the lower federal courts, including the appellate Circuit Courts and the trial level District Courts, have dealt with the conundrum in the wake of *Mogen David* and *Honeywell*.

1. Appellate Splits, Anyone?

Three decisions typify the split in logic among appellate courts.

The *Vornado* court has gone farther than any other in advocating that the policies underlying the patent laws, i.e., the public's right to copy public domain subject matter, trumps policy considerations underlying trademark/trade dress laws.

¹⁰⁸ *Honeywell*, 181 U.S.P.Q. at 824. Much like the subject matter *Honeywell* sought to register, the CCPA's logic here appears to be circular.

¹⁰⁹ *Honeywell*, 181 U.S.P.Q. at 825.

¹¹⁰ See §§III.A.1. and III.A.2., *supra*. In agreement is the well reasoned dissent by Judge Cudahy in *Kohler v. Moen*: "In adopting the position that the configuration or design of products themselves may be the subject of federal trademark protection, the Federal Circuit and the courts that have followed it seem to have taken lightly the emphasis placed on the *right to copy* by decisions of the Supreme Court not only recently but stretching back for a century. To ignore the right to copy principle is to permit perpetual monopolies on particular product designs and to inhibit product development. . . . Whatever new law has been developed in the lower courts to authorize the use of product configuration trademarks as a substitute for design patents is without sanction from the Supreme Court." *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 29 U.S.P.Q.2d (BNA) 1241, 1251 (7th Cir. 1993) (Cudahy, J. dissenting).

¹¹¹ See §III.C.2., *infra*.

Vornado had a utility patent [FIG. J] that disclosed and claimed a spiral fan grill.¹¹² After the issuance of Vornado's patent, Duracraft designed and began to market fans having a spiral grill [FIG. K] that was very similar to Vornado's, but was specifically designed to avoid Vornado's utility patent.¹¹³

United States Patent [19] [11] E **Patent Number: Re. 34,551**
Coup et al. [45] Reissued **Date of Patent: Feb. 22, 1994**

[54] DUCTED FAN

[75] Inventors: Michael C. Coup; Gary P. Israel, both of Wichita; Glen W. Ediger, Newton; Donald J. Moore, Wichita, all of Kans.

[73] Assignee: Vornado Air Circulation Systems, Inc., Wichita, Kans.

[21] Appl. No.: 886,230

[22] Filed: May 21, 1992

1. A ducted fan comprising:
 - a base member with a motor and bladed impeller attached to the base;
 - a funnel-shaped duct with its large end facing upstream concentrically positioned upstream of the blades and around the motor and connected thereto;
 - an outer cowling concentrically positioned, connected to the funnel-shaped duct through a series of radial ribs;
 - an inner cowling positioned inside the outer cowling and attached thereto, the inner cowling being circular in lateral cross section and tapered longitudinally in shape from its larger diameter intake end to its lesser diameter discharge end;
 - a circular grill having an outer radius attached to the discharge end of the inner cowling, the grill including a center hub and a series of arcuate shaped ribs extending outwardly from the hub to said outer radius, each rib having a constant curvature radius and each rib being equally spaced from each other around the hub, the maximum lateral spacing between the ribs is inboard from said outer radius; and
 - a support means pivotally attached to said motor and base member.

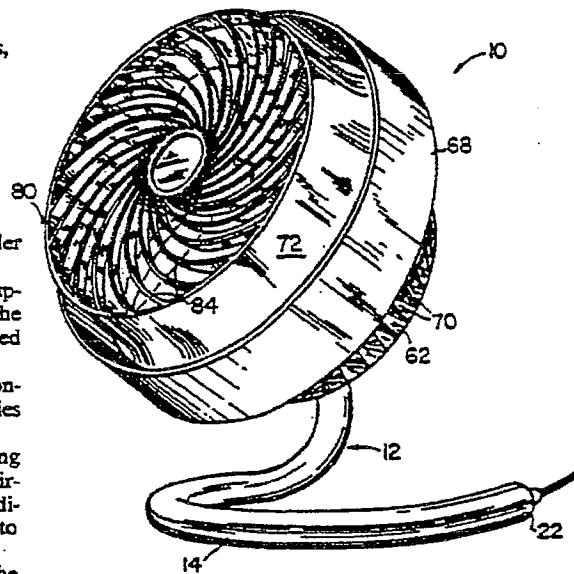


FIG 3

FIG. J

¹¹² Vornado Air Circulation Systems, Inc. v. Duracraft Corporation, 58 F.3d 1498, 1500, 35 U.S.P.Q.2d (BNA) 1332, 1333-34 (10th Cir. Kan. 1995). Vornado was not the first to invent a spiral fan grill. Thus, the claims specified that the point of maximum lateral spacing between the curved vanes of the grill was located inboard from the grill's outer radius, so that it was at the point of maximum power of the impeller blades. *Id.*

¹¹³ *Vornado*, 35 U.S.P.Q.2d (BNA) at 1333-34.

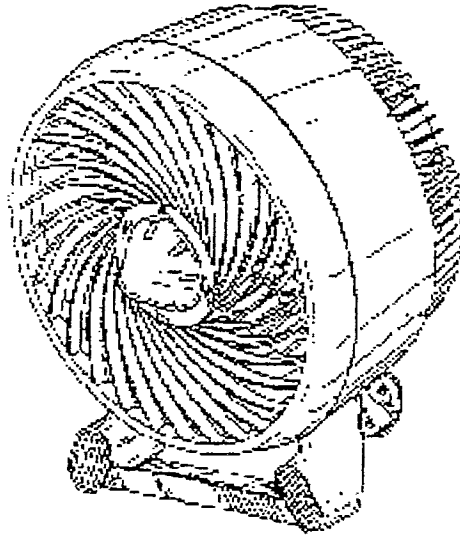


FIG. K

Vornado sued Duracraft under §43 of the Lanham Act, alleging trade dress infringement. The district court ruled in favor of Vornado, holding that Vornado's spiral grill design was non-functional and that such protection was not incompatible with patent law.¹¹⁴

The Tenth Circuit Court of Appeals reversed, holding that "where a product configuration is a significant inventive component of an invention covered by a utility patent, so that without it the invention cannot fairly be said to be the same invention, patent policy dictates that it enter the public domain when the utility patent expires. . . . To ensure that result, it cannot receive trade dress protection under section 43(a) [of the Lanham Act]."¹¹⁵ The court reasoned that, although no controlling precedent exists on the conflict between federal patent law and federal trademark law, the Supreme Court has repeatedly held that the concerns of unfair competition law must yield to the public's right to copy.¹¹⁶

The court engaged in a thorough analysis of the policies behind patent law and trademark law and reached its conclusion by carefully balancing the competing concerns.¹¹⁷ The court held that allowing trade dress protection for the subject matter of expired utility patents would prevent the subject matter from entering the public domain, a result contrary to the fundamental purpose of patent law.¹¹⁸ In contrast, the court

¹¹⁴ *Id.* at 1334.

¹¹⁵ *Id.* at 1342.

¹¹⁶ *Id.* at 1337.

¹¹⁷ *Vornado*, 35 U.S.P.Q.2d (BNA) at 1339-42.

¹¹⁸ *Id.* at 1340.

noted that the Lanham Act was enacted to protect traditional word and picture marks and was not expanded to cover product configurations until fifteen to twenty years after its enactment.¹¹⁹ The court therefore reasoned that consumer confusion that may arise from the similarity of product configurations is, at most, a “peripheral concern” of the Lanham Act.¹²⁰ Thus, the court concluded that patent law should take precedent.¹²¹

Thomas & Betts Corp. (“T&B”) obtained two utility patents on a two-piece cable tie in 1965.¹²² [see FIGS. L and M below] T&B’s two patents disclosed a cable tie having an oval head, a metal barb, and a transverse slot.¹²³ The head portion of the cable tie was claimed, but its oval shape was not.¹²⁴

T&B marketed a cable tie [FIG. N] which was substantially identical to that disclosed in its patents. Both patents expired in 1982.¹²⁵

In about 1994, Panduit began to sell a cable tie substantially similar in appearance to T&B’s cable tie.¹²⁶ T&B promptly sued Panduit in the Northern District of Illinois, alleging, among other claims, trade dress infringement under §43(a) of the Lanham Act. The district court granted summary judgment in favor of Panduit, holding that “the subject matter of an expired utility patent which is disclosed as the ‘best mode’ in the patent cannot be the subject matter of trademark protection . . .”.¹²⁷

The Seventh Circuit reversed, holding that the functionality doctrine is a sufficient safeguard against the “impermissible extension” of the patent monopoly by a trademark.¹²⁸ In reaching this conclusion, the court asserted that Supreme Court precedent does not establish an “absolute” right to copy.¹²⁹ The court reasoned that the functionality doctrine protects the public’s right to use a product configuration for its “functional purpose”, subject to any exclusive rights afforded for a limited time by the patent laws.¹³⁰

119 *Id.* at 1340–41, citing *Two Pesos*, 112 S.Ct. at 2762–2763 (Stevens, J., concurring) and McCarthy, *supra*, §§1.09(3), 7.31, 27.03(1)(b).

120 *Id.* at 1341.

121 *Id.* at 1341–42.

122 *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 46 U.S.P.Q.2d (BNA) 1026, 1028–29 (7th Cir. Ill. 1998).

123 *Thomas & Betts*, 46 U.S.P.Q.2d (BNA) at 1029.

124 *Id.*

125 *Id.*

126 *Id.*

127 *Thomas & Betts*, 46 U.S.P.Q.2d (BNA) at 1029, quoting *Thomas & Betts Corp. v. Panduit Corp.*, 935 F. Supp. 1399, 1409, 46 U.S.P.Q.2d (BNA) 1010, 1017 (N.D. Ill. 1996).

128 *Thomas & Betts*, 46 U.S.P.Q.2d (BNA) at 1033–34.

129 *Id.* at 1032–33.

130 *Id.* at 1033.

June 1, 1965

D. P. SCHWESTER ETAL

3,186,047

SELF CLINCHING BUNDLING STRAP

Filed Aug. 14, 1962

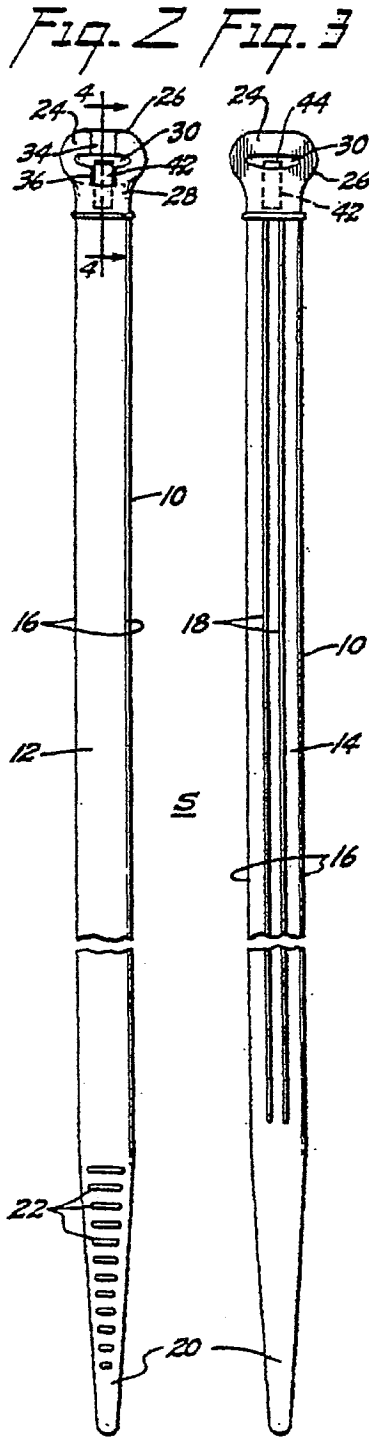


FIG. L

July 29, 1969

R. MARIANI

3,457,598

SELF-CLINCHING BUNDLING STRAP

Filed Aug. 9, 1968

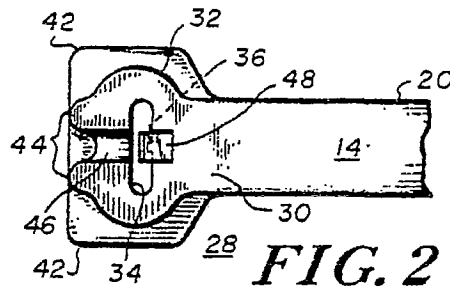


FIG. M

Notably, the court of appeals stated that the *T&B* case was distinguishable from the Tenth Circuit's decision in *Vornado* because the shape of the cable tie head at issue was not claimed in T&B's patents.¹³¹ Such a statement suggests that the court may have reached the opposite conclusion had the subject matter of the alleged trade dress been within the scope of T&B's patent claims.

Sunbeam sued West Bend under §43(a) of the Lanham Act, alleging that West Bend's marketing of a stand mixer infringed Sunbeam's trade dress rights in its American Classic Mixmaster.¹³² Sunbeam identified six "key design features" of the Mixmaster that, when taken in combination, comprise its trade dress.¹³³

The district court granted a preliminary injunction prohibiting West Bend from marketing any products embodying the alleged trade dress of the Mixmaster.¹³⁴ In reaching its decision, the district court employed conventional functionality analysis and determined that the Mixmaster product configuration was non-functional.¹³⁵ The court reasoned that, although the configuration of the Mixmaster was comprised of many functional features that were the subject of expired utility patents, the particular combination of features chosen for the Mixmaster was non-

¹³¹ *Id.* at 1034. The district court had concluded that the oval shape was claimed in T&B's patents. The court of appeals reversed this determination after performing a Markman analysis of the scope of T&B's claims. *Thomas & Betts*, 46 U.S.P.Q.2d (BNA) at 1035-36.

¹³² *Sunbeam Products Inc. v. West Bend Co.*, 123 F.3d 246, 39 U.S.P.Q.2d (BNA) 1545, 1546 (S.D. Miss. 1997).

¹³³ *Sunbeam*, 39 U.S.P.Q.2d (BNA) at 1555.

¹³⁴ *Id.* at 1555-56.

¹³⁵ *Id.* at 1550.

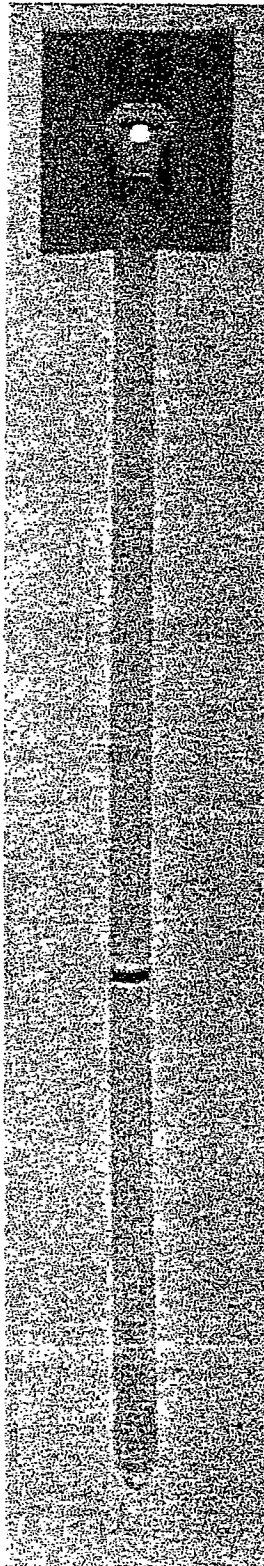


FIG. N

functional.¹³⁶ The court held that the existence of a utility patent on a functional feature of a particular product is “not dispositive of whether to not the overall shape of the product is functional,”¹³⁷ and noted that there was “ample evidence” of the existence of alternative designs.

In affirming the lower court’s decision, the Court of Appeals for the Fifth Circuit dismissed West Bend’s “alarmist rhetoric” that the preliminary injunction was contrary to the public interest because it would amount to a “permanent patent” on the key design features of the mixer.¹³⁸ The circuit court asserted that trade dress protection for the “overall appearance” of the Mixmaster does not create a conflict between trademark law and patent law because such trade dress only prohibits competitors from copying the combination of features, not each individual feature.¹³⁹

2. *Downstairs, the Good Guys Always Win*

The District Courts uniformly follow the *Mogen David/Honeywell* line of cases.¹⁴⁰

In 1996, the Southern District of New York decided *Krueger International, Inc. v. Nightingale Inc.*, which involved protection of a stacking chair design.¹⁴¹ The plaintiff alleged that the defendant had infringed on its trade dress rights under §43(a).

Krueger had obtained a design patent in 1978 covering the very same chair that it was now asserting against Nightingale. [FIG. P shows the defendant’s chair under plaintiff’s expired design patent].

The judge did not see a problem in a design owner asserting trade dress rights in a product that was the subject of an expired design patent. For this she relied heavily upon the old CCPA *Mogen David II* case.

The court stated that “because a design patent is granted only for nonfunctional design, it can serve as evidence that a plaintiff’s trade dress is not functional.”¹⁴² As had many other courts, Judge Sotomayor used the traditional functionality test as a gatekeeper for deciding whether a product qualifies for trade dress protection.

¹³⁶ *Id.*

¹³⁷ *Sunbeam*, 39 U.S.P.Q.2d (BNA) at 1550, citing *Doglee, Inc. v. Doskocil Mfg. Co., Inc.*, 893 F.Supp. 911 (C.D. Cal. 1995).

¹³⁸ *Sunbeam Products Inc. v. West Bend Co.*, 123 F.3d 246, 44 U.S.P.Q.2d 1161, 1171 (5th Cir. 1997).

¹³⁹ *Sunbeam*, 44 U.S.P.Q.2d at 1168, fn. 19.

¹⁴⁰ See, e.g., *Hubbell Inc. v. Pass & Seymour Inc.*, 883 F.Supp. 595, 35 U.S.P.Q.2d 1760 (S.D.N.Y. 1995).

¹⁴¹ *Krueger International Inc. v. Nightingale Inc.*, 915 F.Supp. 595, 40 U.S.P.Q.2d 1334 (S.D.N.Y. 1996).

¹⁴² *Krueger*, 40 U.S.P.Q.2d (BNA) at 1342.

United States Patent [19]

[11] Des. 246,813

Tolleson

[45] ** Jan. 3, 1978



Fig. 1

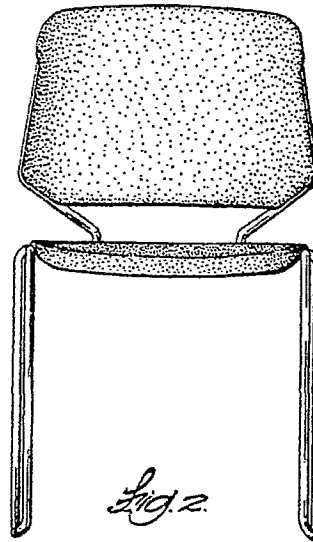


Fig. 2

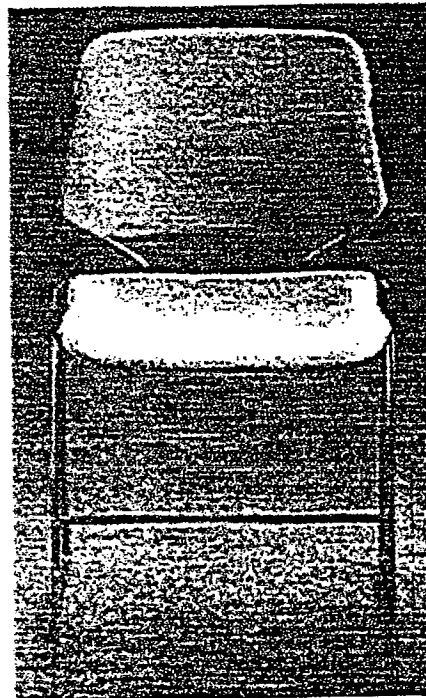
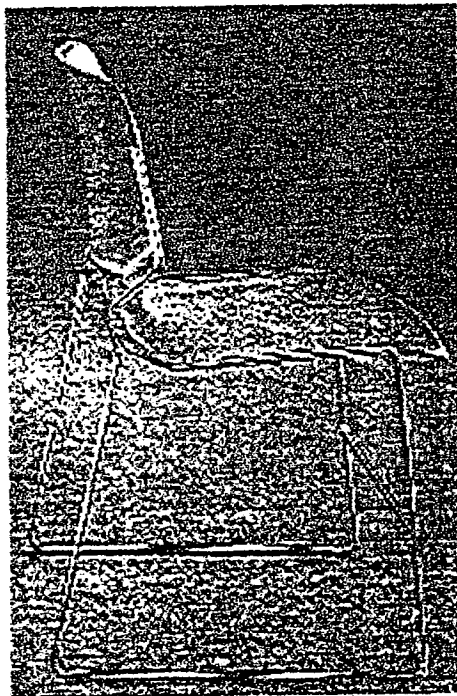


FIG. P

In *Topps Co. v. Gerrit J. Verburg Co.*,¹⁴³ Topps had obtained a design patent on a diamond-shaped lollipop on a plastic ring called the Ring Pop. [see FIG. Q below]. The design patent expired in 1990.

Two years later, Verburg began selling a similar diamond lollipop [see FIG. R], whereupon Topps applied for and obtained a federal trademark registration for the same configuration [see FIG. S].

The court allowed Topps to assert its trade dress rights, embodied by the federal registration, against Verburg. The court saw “no inherent conflict” between trademark rights and patent law.¹⁴⁴ The court explained that “a product can be both patentable and protected by trademark rights as long as the particular design protected does not have a utilitarian function.”¹⁴⁵ The court quite reasonably relied on the PTO’s issuance of a federal trademark registration as evidence of the proposition that the existence of an expired design patent does not preclude trademark rights, even registration of a trademark.¹⁴⁶ The court issued a preliminary injunction restraining Verburg from producing the diamond lollipop ring.

In the same year, in *Northwestern v. Gabriel*,¹⁴⁷ the plaintiff got a trademark registration on an almost identical product design that was the subject of a 30 year old design patent [see FIG. T].

The district court in Chicago dismissed defendant’s argument that “the plaintiff cannot resurrect and create a monopoly through trademark law in subject matter which already has passed to the public upon expiration of its design patent.”¹⁴⁸ The court relied on the 1993 *Kohler* case,¹⁴⁹ and also cited, of course, the *Mogen David II* case.¹⁵⁰

D. *Candles in the Protectionists’ Wind*

Some courts have stood up, against what must feel like the overwhelming weight of authority, for the proposition that there is a definite, or at least potential, conflict between trademark/trade dress rights and patented subject matter. The only majority opinions to do so are *Vornado*, discussed *supra*, *Elmer*, discussed *infra*, and *Dorr-Oliver*, dis-

¹⁴³ 41 U.S.P.Q.2d (BNA) 1412 (S.D.N.Y. 1996).

¹⁴⁴ *Topps*, 41 U.S.P.Q.2d (BNA) at 1420.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* The court also incorrectly cited footnote 3 in *In re Morton Norwich Products, Inc.*, 671 F.2d 1332, 213 U.S.P.Q. (BNA) 9 (CCPA 1982) (*see note 45, infra.*) for that same proposition.

¹⁴⁷ 1996 U.S. Dist. LEXIS 6137 (N.D.Ill. 1996).

¹⁴⁸ *Northwestern*, 1996 U.S. Dist. LEXIS at *10.

¹⁴⁹ *Id.* at *12.

¹⁵⁰ *Id.* at *13.

United States Patent [19]

[11] **Des. 242,646**

Shorin et al.

[45] ** **Dec. 7, 1976**

- [54] **COMBINED CANDY AND RING**
- [75] Inventors: Arthur T. Shorin, New York, N.Y.;
Stan Hart, Beverly Hills, Calif.
- [73] Assignee: Topps Chewing Gum, Incorporated,
Brooklyn, N.Y.
- [**] Term: **14 Years**
- [21] Appl. No.: **613,045**
- [22] Filed: **Sept. 12, 1975**
- [51] Int. Cl. **D11-01; D1-99**
- [52] U.S. Cl. **D11/2**
- [58] Field of Search **D45/1 R, 4 A-4 E,**
D45/10 A-10 C; D1/15, 22; 63/1 R, 2,
15-15.8

- D. 229,522 12/1973 Parker
- D. 232,965 9/1974 Atwell

OTHER PUBLICATIONS

A Man's World Gallery of Gifts, Mar. 6, 1972, p. 39—Topaz Ring Left Center.

Primary Examiner—Joel Stearman
Assistant Examiner—Louis S. Zarfes
Attorney, Agent, or Firm—Mark T. Basseches

CLAIM

[57] The ornamental design for a combined candy and ring, substantially as shown.

DESCRIPTION

FIG. 1 is a side elevational view of a combined candy and ring showing our new design;
FIG. 2 is an end elevational view thereof;
FIG. 3 is a top plan view thereof;
FIG. 4 is a bottom plan view thereof.

- [56] **References Cited**
- U.S. PATENT DOCUMENTS**
- 902,109 10/1908 Powell
- D. 142,234 8/1945 Sudbrink

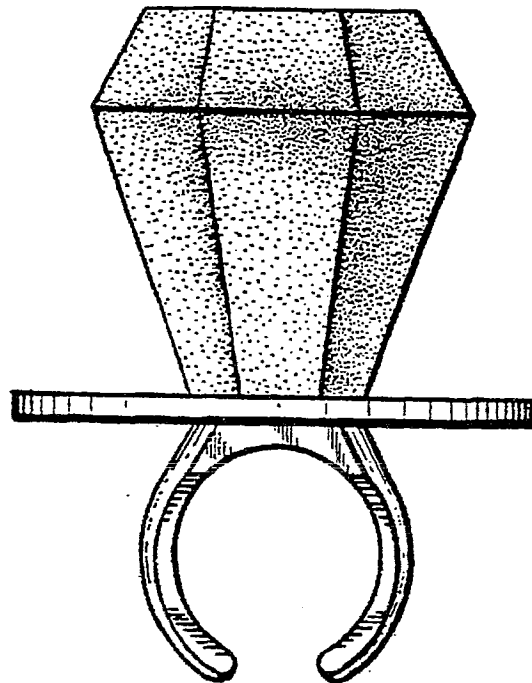


FIG. Q

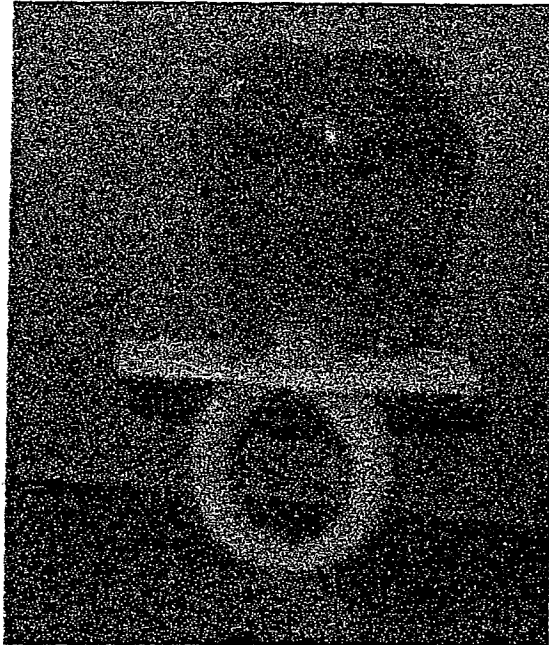


FIG. R

United States Patent and Trademark Office **Reg. No. 1,846,873**
Registered July 26, 1994

**TRADEMARK
PRINCIPAL REGISTER**

TOPPS COMPANY, INC., THE (DELAWARE
CORPORATION)
254 36TH STREET
BROOKLYN, NY 11232

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).
FIRST USE 2-26-1975; IN COMMERCE
3-4-1975.

THE MARK CONSISTS OF A CANDY POR-
TION IN THE CONFIGURATION OF A JEWEL
MOUNTED ON A STYLIZED RING.

SER. NO. 74-332,122, FILED 11-18-1992.

KENNETH D. BATTLE, EXAMINING ATTOR-
NEY

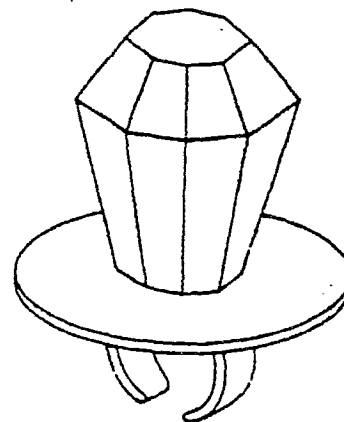


FIG. S

United States Patent Office

Des. 186,466
Patented Oct. 27, 1959

186,466

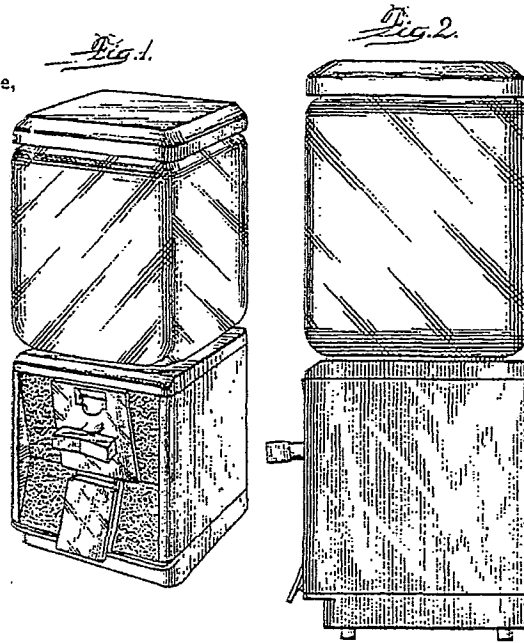
VENDING MACHINE

Waldo E. Bolen, Jr., Morris, Ill., and Lee A. Roehike,
Fridley, Minn.

Application June 15, 1959, Serial No. 56,333

Term of patent 3½ years

(Cl. D52—3)



United States Patent and Trademark Office

Reg. No. 1,456,248
Registered Sep. 8, 1987

NORTHWESTERN CORPORATION (ILLINOIS CORPORATION)
P.O. BOX 490
MORRIS, IL 60450

TRADEMARK PRINCIPAL REGISTER

FOR: COIN OPERATED VENDING MACHINES, IN CLASS 9 (U.S. CL. 23).
FIRST USE 0-0-1959; IN COMMERCE 0-0-1959.

THE LINING IN THE DRAWING REPRESENTS A FEATURE OF THE MARK AND DOES NOT INDICATE COLOR. THE AREAS DEPICTED IN DOTTED LINES ARE INCLUDED TO SHOW POSITION IN RELATION TO THE MARK.

THE MARK CONSISTS OF THE CONFIGURATION OF A COIN OPERATED VENDING MACHINE HAVING A FOUR-SIDED GLOBE, RECTANGULAR CASE AND INVERTED FRONT PANEL.
SEC. 2(F).

SER. NO. 614,453, FILED 2-13-1986.

MICHELE L. MCSHANE, EXAMINING ATTORNEY

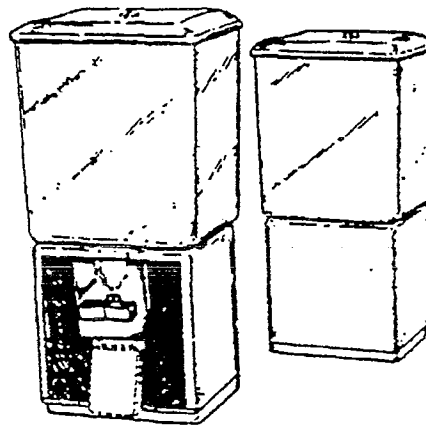


FIG. T

cussed in this section. There were, in addition, however, two early voices of dissent, one from the oft-cited *Ferrari*¹⁵¹ decision from the Sixth Circuit, and the other from the equally famous *Kohler*¹⁵² decision from the Seventh Circuit, both of which are also discussed in this section.

1. *Kennedy for President—the Ferrari case*

Ferrari probably represents the high water mark of section 43(a) for product configurations. The majority, per Judge Ryan, managed to uphold section 43(a) rights in a car body design that had been on the market for many years without any showing of actual confusion, and in the absence of any likelihood of confusion at the point of sale. In fact, it was admitted that there was no such confusion. There was no question but that Ferrari, although it had never obtained any design patents, established secondary meaning in its Daytona Spyder and Testarossa vehicle designs. And there was also no question that the defendant Roberts' car body was identical to Ferrari's. FIG. U shows the Ferrari Daytona Spyder on top and the Robert's car on the bottom, while FIG. V shows the Ferrari Testarossa on top and Robert's car on the bottom.

The Sixth Circuit rejected Roberts' contentions that §43(a) of the Lanham Act protected Ferrari's design only if Ferrari had pursued a design patent. Noticeably absent from the majority opinion is any mention of the right to copy doctrine or the *Singer* or *Kellogg* cases, Judge Ryan choosing instead to follow the shaky logic of *Mogen David II* that trademark and patent laws have different purposes and therefore can co-exist. The court stated it was legally permissible to create a trademark monopoly on a patentable product as long as the product had acquired secondary meaning.

The well-reasoned dissent in *Ferrari* by Judge Kennedy argued that a design could not have both trade dress and design patent protection.¹⁵³ Judge Kennedy accused the majority of providing Ferrari with absolute protection in perpetuity against the copying of its unpatented design. He concluded that the majority's opinion ran afoul of the previous Supreme Court decisions in *Bonito Boats*, *Sears*, and *Compco*.¹⁵⁴

In addition, Judge Kennedy properly observed that § 43(a) is *not* a design protection law. It is a law that protects against consumer confusion. He pointed out that in the case of expensive sports cars, we are

151 *Ferrari s/p.a. v. Roberts*, 944 F.2d 1235, 20 U.S.P.Q.2d (BNA) 405 (6th Cir. 1991).

152 *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 29 U.S.P.Q.2d (BNA) 1241 (7th Cir. 1993).

153 *Ferrari*, 20 U.S.P.Q.2d (BNA) at 1012.

154 *Id.* at 1013.

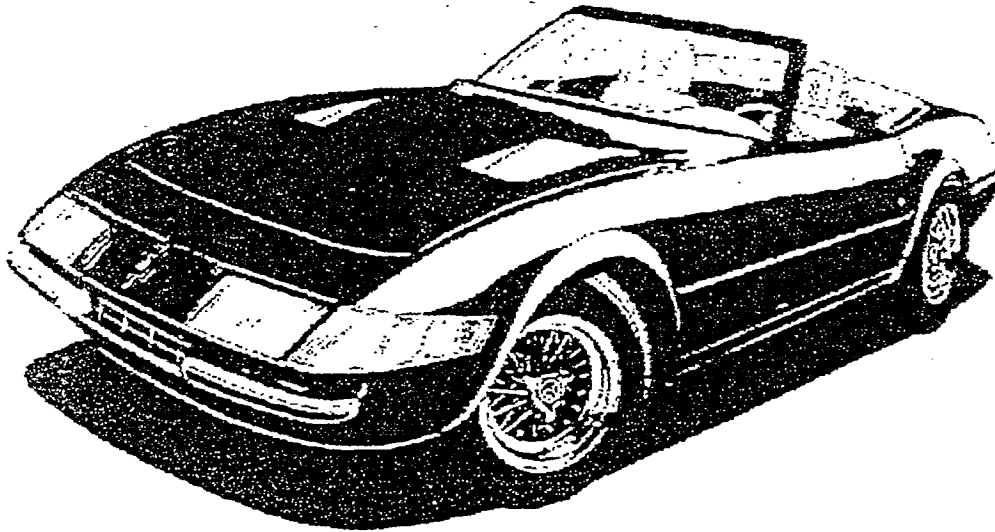
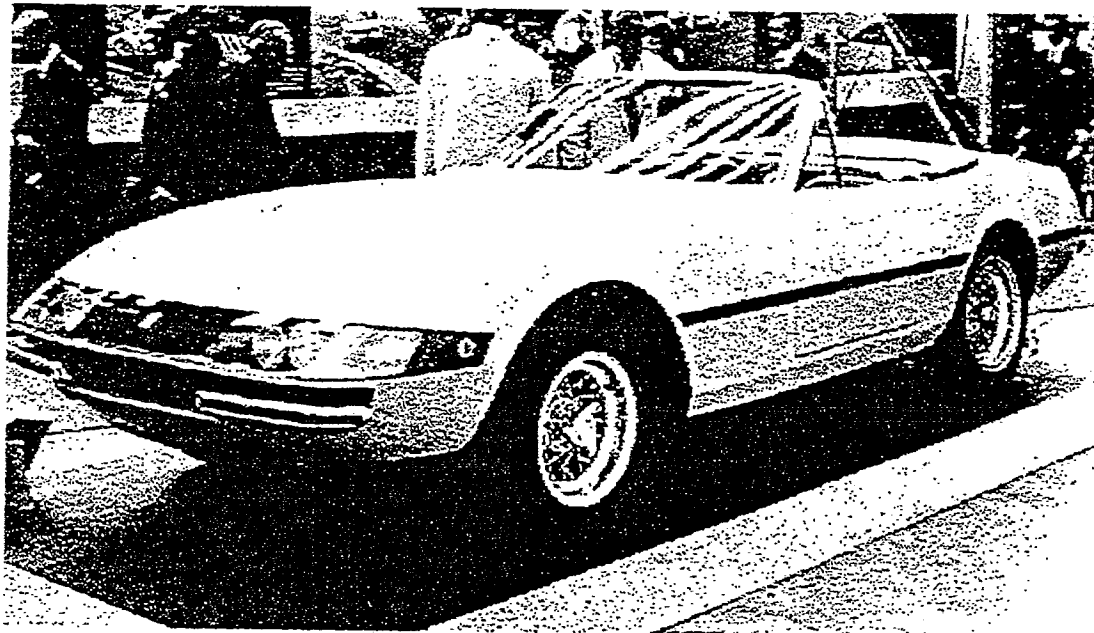


FIG. U

speaking of very sophisticated consumers. How can anyone suppose that such a consumer can see Roberts' ad in a kit catalog, and pay \$10,000 for his knock-off plastic fiberglass body that has a Pontiac Fiero engine in it, and think that it's a \$250,000 Ferrari? It indeed defies imagination to suggest that such a consumer was confused in the slightest as to the source or origin of the goods being purchased. He opined that the proper remedy for any post-sale confusion was proper labeling, not prohibiting copying altogether.

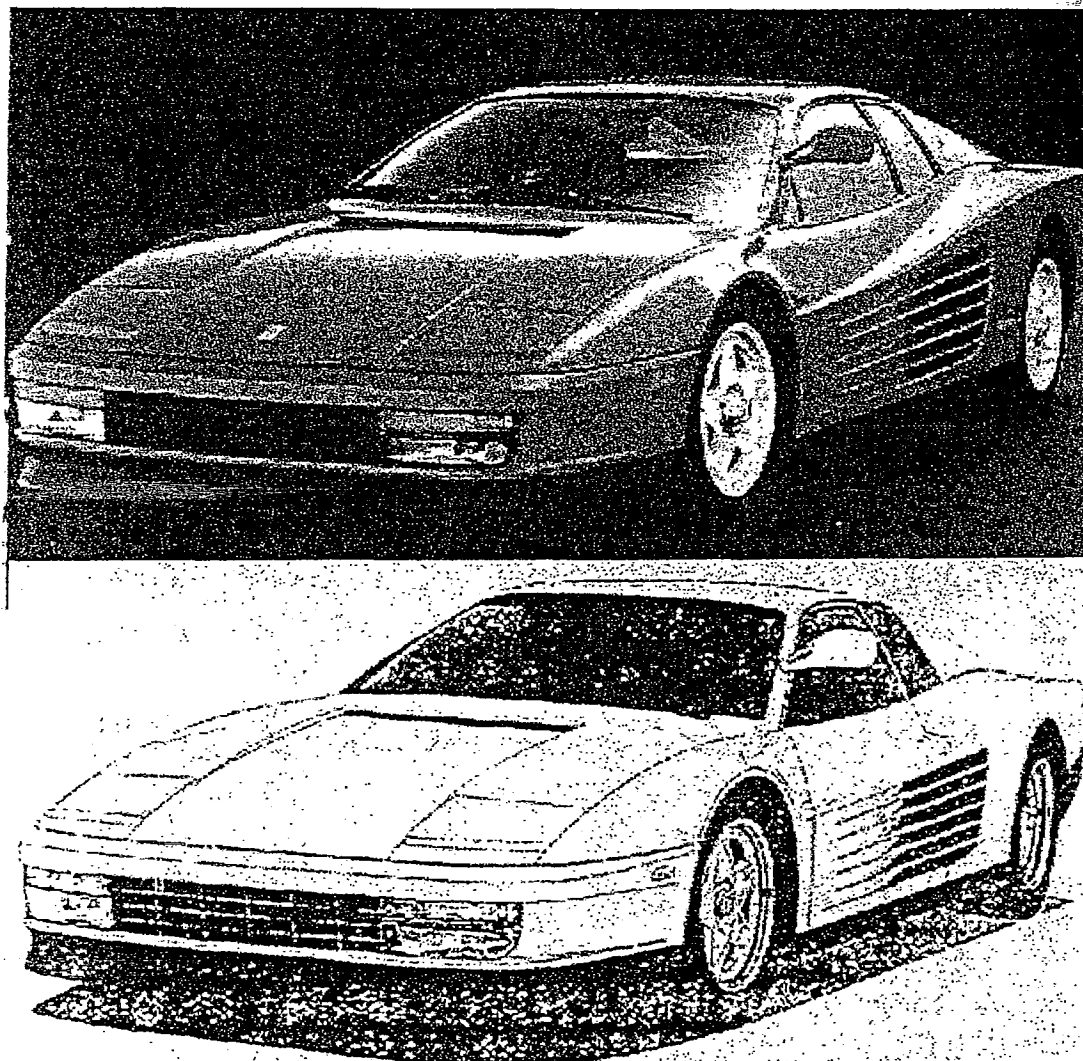


FIG. V

2. Cudahy Plugs Leaks—the Kohler dissent

In *Kohler Co. v. Moen Inc.*, Kohler opposed Moen's application to register its faucet configuration as a trademark with the Patent and Trademark Office on the fundamental ground that product shapes were not registrable as trademarks.¹⁵⁵ Kohler argued that granting trademark protection to product configurations conflicted with federal patent law because it impermissibly provided a perpetual design patent and was anticompetitive.¹⁵⁶

¹⁵⁵ *Kohler Co. v. Moen Inc.*, 29 U.S.P.Q.2d (BNA) at 1241.

¹⁵⁶ *Id.* at 1250.

The court followed the reasoning in *Mogen David II* holding that the product configuration of a faucet was entitled to trademark protection and was not precluded by federal patent law.¹⁵⁷ The court declined to overrule the doctrine of functionality as a criterion for evaluating the issue.¹⁵⁸ The court concluded that granting trademark protection to a non-generic, nonfunctional product did not stifle competition because competitors are free to make faucets and faucet handles that look differently.

The dissent by Judge Cudahy, in perhaps the most articulate appellate discussion in favor of the right to copy, argued that the majority disregarded the Supreme Court's holdings in *Singer*, *Kellogg*, *Bonito Boats*, *Sears*, and *Compco*—all supporting the position that the right to copy is tantamount and essential to the successful operation of a free economy. He said “to ignore this principle is to permit perpetual monopolies on product ideas or particular product design and to inhibit product development.”¹⁵⁹

Judge Cudahy also took issue with other courts for using the functionality doctrine to resolve the conflict between trademark law and design patent law,¹⁶⁰ finding that “there is no basis for treating the subject matter of design and utility patents differently: if functional matter not protected by a utility patent is available for all to copy, then it follows that ornamental or aesthetic designs not protected by design patents are also free for everyone to copy.”¹⁶¹

Judge Cudahy also pointed out that the “functional/nonfunctional dichotomy” was created by the judiciary and had no basis in utility patent law.¹⁶² He argued that patent law policy should not be trumped by trademark policy because the Supreme Court explicitly had rejected the argument that the likelihood of confusion and secondary meaning were sufficient reasons to grant a perpetual monopoly to an inventor,¹⁶³ and that trademark protection on expired patents directly conflicts with public policy favoring competition over monopolies.¹⁶⁴

The (Supreme) Court has spoken repeatedly to disfavor the use of unfair competition law to avoid the ‘limited times’ provision of the Patent Clause. The Court has emphasized the importance of the right to copy as an aspect of the Patent Clause.

¹⁵⁷ *Id.* at 1251.

¹⁵⁸ *Id.* at 1244–48.

¹⁵⁹ *Kohler Co. v. Moen Inc.*, 29 U.S.P.Q.2d (BNA) at 1254.

¹⁶⁰ *Id.* at 1254–55.

¹⁶¹ *Id.*

¹⁶² *Id.* at 1255.

¹⁶³ *Id.* citing *Compco*, *infra.*, 376 US at 238.

¹⁶⁴ *Kohler*, 29 U.S.P.Q. 2d (BNA) at 1257.

The right to copy is constitutionally protected and is absolutely essential to the successful long-term operation of a free and competitive economy.¹⁶⁵

3. “Close the Door, Oliver”, *Quips Flaum*

For many years, Dorr-Oliver, Inc. had been the sole supplier (to a mere dozen purchasers) of clamshell-style starch washers, large machines used in the corn wet milling industry to separate corn starch from protein using centrifugal force. Dorr-Oliver had obtained several utility patents on its clamshell washer, all of which had expired by the time Fluid-Quip, Inc. (at the request of several Dorr-Oliver customers) began supplying clamshell washers that, at the customers’ request, were interchangeable (for maintenance reasons) with the original Dorr-Oliver clamshells. Obviously, the two companies’ machines were very similar.

Dorr-Oliver brought suit against Fluid-Quip for trade dress infringement under §43(a) of the Lanham Act, and the district court, after a bench trial, ruled in favor of Dorr-Oliver and issued an injunction against Fluid-Quip,¹⁶⁶ who appealed.

The Seventh Circuit, per Judge Flaum, reversed¹⁶⁷ on the ground that there was no possibility that any of the 12 customers of these clamshell machines,¹⁶⁸ all of whom already owned Dorr-Oliver clamshells, will be confused by Fluid-Quip’s introduction of a competitive line of clamshells.¹⁶⁹

While the court could have stopped there, it did not. It went on to criticize the district court’s statement that “[I]t is inherently unfair for a competitor to enter the market on the back of the originator of a design”, citing to *Sears* for the proposition that “[a]n unpatented article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so”, limited only by an obligation to avoid consumer confusion, which can generally be done “when the manufacturer’s name is clearly displayed on the product”.¹⁷⁰

¹⁶⁵ *Id.*

¹⁶⁶ *Dorr-Oliver Inc. v. Fluid-Quip, Inc. et al.*, 894 F.Supp. 1190 (N.D.Ill., 1995), *rev’d*, 94 F.3d 376, 39 U.S.P.Q.2d (BNA) 1990 (7th Cir. 1996).

¹⁶⁷ *Dorr-Oliver*, 39 U.S.P.Q.2d (BNA) at 1995.

¹⁶⁸ The court noted that “The market for clamshell starch washers is very limited. In the United States, there are only twelve purchasers of clamshells for twenty-seven corn wet milling plants.” *Dorr-Oliver*, 39 U.S.P.Q.2d at 1991.

¹⁶⁹ *Id.* at 1995.

¹⁷⁰ *Id.* at 1996, citing the seminal decision in *Versa Products Co., Inc. v. Bifold Co. Ltd.*, 50 F.3d 189, 33 U.S.P.Q.2d 1801 (3d Cir. 1995) which had reformulated for §43(a) product configuration cases the ten Scott Paper factors used in the Third Circuit for determining likelihood of confusion, among them defendant’s intent in adopting the configuration; the court held that that factor was not an appropriate consideration due to competitors’ right to copy unpatented product designs.

While giving lip service to the 7th Circuit's *Kohler* decision, the court appeared to distinguish the present case by virtue of Dorr-Oliver's expired patents:¹⁷¹

. . . Dorr-Oliver reaped the rewards of its patents on the clamshell for seventeen years, after which time the product passed into the public domain. Fluid-Quip then entered the clamshell market with a product virtually identical in appearance and represented itself to potential customers as a competitor of Dorr-Oliver. This is certainly competition, but the similarity of the two clamshells, standing alone, does not make it unfair. . . . The district court's analysis simply neglected to account for the delicate interplay of the patent and trademark laws in the context of product configurations.¹⁷²

E. *Two Faces Have I—The Federal Circuit Speaks*

The Federal Circuit, our specialty patent court, has spoken on the conundrum with two separate and distinct voices, in the 1995 decision *Elmer v. ICC Fabricating, Inc.*¹⁷³ where the court demonstrated a keen ability to recognize and deal with the conundrum, and the 1999 case of *Midwest Industries, Inc. v. Karavan Trailers, Inc.*,¹⁷⁴ where it demonstrated just the opposite.

1. *Elmer Sticks Like Crazy*

Elmer sued ICC for infringing its rights in a vehicle-mounted advertising sign that was covered by Elmer's utility patent [FIG. W].

Elmer defined its trade dress as:

a rigid, two-sided aerodynamic sign body with a clear plastic window mounting member, and with the two sides extending generally vertically and generally parallel with the direction of the vehicle travel when mounted upon a vehicle side window.¹⁷⁵

The trial court, after a jury verdict in favor of Elmer's §43(a) trade dress claim, granted an injunction prohibiting ICC from using trade dress falling within Elmer's above-noted definition. The Federal Circuit, after reviewing the evidence of functionality, reversed, finding that there was no evidence by which the jury could find the alleged trade dress to be nonfunctional. Although the court could have stopped there, it went on to recognize and discuss the conundrum:

171 Moen had obtained no patents on its faucet design that was litigated in the *Kohler* case.

172 *Dorr-Oliver*, 39 U.S.P.Q.2d (BNA) at 1996.

173 67 F.3d 1571, 36 U.S.P.Q.2d (BNA) 1417 (Fed. Cir. 1995).

174 175 F.3d 1356, 50 U.S.P.Q.2d 1672 (Fed. Cir. 1999).

175 *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1422 (Fed. Cir. 1995).

United States Patent [19]

[11] Patent Number: 5,084,994

Elmer

[45] Date of Patent: Feb. 4, 1992

[54] ADJUSTABLE VEHICLE-MOUNTED
ADVERTISING SIGNS AND METHOD[76] Inventor: William A. Elmer, 1010 Temple
Grove Ct., Winter Park, Fla. 32789

[21] Appl. No.: 546,714

[22] Filed: Jul. 2, 1990

1. Apparatus for displaying an advertisement above the roof of a vehicle, comprising:
 a vehicle having a wide window which extends generally vertically and approximately parallel to the direction of vehicle travel;
 an aerodynamic member having a leading edge, a trailing edge and side surfaces between the edges, the member having a longitudinal dimension between the edges and lateral dimensions between the side surfaces, the longitudinal dimension being substantially greater than the lateral dimensions;
 means including an upstanding race means for releasably attaching the aerodynamic member to the vehicle window with the side surfaces extending generally vertically, the attaching means including a window mount having a portion dimensioned to pass across the top and engage the vehicle window;
 the upstanding brace means rigidly joined with the window mounted at spaced points and joined with the aerodynamic member at spaced point, so as to prevent rotation of the aerodynamic member and maintain the longitudinal dimension extending in a direction generally parallel with the direction of vehicle travel; and wherein
 at least one of the side surfaces defines an area to which an advertising medium can be affixed.

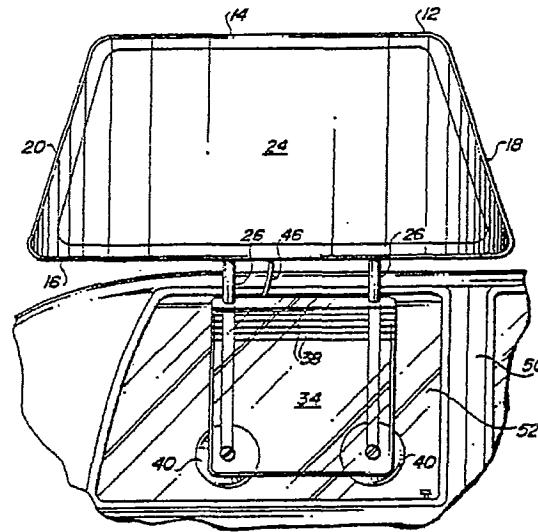


FIG. W

Moreover, patent law, not trade dress law, is the principal means for providing exclusive rights in useful product features.¹⁷⁶

After citing to *Qualitex* for the danger in extending trade dress rights to unpatented or unpatentable features, the court then admonished the lower court:

The injunction, in effect, broadens claim 1 of the '994 patent¹⁷⁷ by protecting products lacking some of the limitations of the claim. [Elmer] cannot, however, bypass the statutory requirements of the patent laws and obtain broadened patent protection under the guise of trade dress law. Furthermore, once the '994 patent expires, the public will be entitled to practice the invention claimed in the patent. [citing *Bonito Boats* and *Kellogg*]. Enforcing a "trade dress" right defined, as it was here, to be essentially coextensive with, and in fact broader than, claim 1 of the

¹⁷⁶ *Id.* at 1423.

¹⁷⁷ See FIG. W, *supra*.

'994 patent would frustrate that right because trade dress protection may last indefinitely and thus competitors could not effectively "copy and use" the invention after the patent expires.¹⁷⁸

The Federal Circuit, however, found nothing wrong with carving out one particular species (corresponding to the narrowly defined trade dress) from the genus of an expired patent claim, as long as competitors were allowed to compete with products that didn't look like Elmer's:

If the asserted trade dress had been narrowly defined to cover only one of the many product configurations within the scope of the claim, one might have a different case. In such case, upon expiration of the '994 patent competitors would be free to practice the '994 invention; they could sell "aerodynamic" vehicle-mounted signs. They simply could not choose a product configuration that would be confusingly similar to the trade dress of HTH's product. Here, however, the "trade dress" was broadly defined to be essentially coextensive with, and in fact broader than, the patent claim, and enforcing such a trade dress would effectively extend the life of the patent.¹⁷⁹

Two things are noted: (1) the court's suggested solution, that Elmer more particularly define its trade dress to encompass a narrow species, still would have the effect of extending the life of the utility patent on that particular species;¹⁸⁰ and (2) this decision comes closest to the 10th Circuit's far-reaching *Vornado* decision; both courts recognized and analyzed a potential problem between alleged trade dress rights and the claim of an unexpired utility patent. It is especially noteworthy in view of the Federal Circuit's total rejection of *Vornado* in the *Karavan* case decided 4 years later.¹⁸¹

2. *Kafkaesque Karavan*

One of the cases relied upon by the Sixth Circuit in *Traffix* was the 1999 *Karavan* decision from the Federal Circuit which took the same "doc functionality cures all ills" approach as had many other courts in resolving the conundrum.

The 10th Circuit's *Vornado* holding was followed by the district court in *Karavan* that dismissed Midwest's Lanham Act §43(a) trade dress claim on a curved winch post as barred by Federal patent law since

¹⁷⁸ *Elmer*, 36 U.S.P.Q.2d (BNA) at 1423.

¹⁷⁹ *Id.*

¹⁸⁰ Such a narrowed species could very well be the subject matter of one of the patent's dependent claims.

¹⁸¹ See §III.E.2., *infra*. Interestingly, the *Elmer* case, involving both Lanham Act and state unfair competition claims (the latter being a very minor portion of the decision), was cited in *Karavan* only in support of federal preemption of state unfair competition claims.

the alleged trade dress [FIG. X] was a 'significant inventive aspect of the claims' of Midwest's unexpired utility patent [FIG. Y] (5,518,261). Granting trade dress protection, the theory went, would improperly extend Midwest's utility patent rights, per *Vornado*.

The Federal Circuit reversed.¹⁸² The court reviewed its case law, including its CCPA precedent, and concluded essentially that the doctrine of functionality provided all the protection the public needs against the undue extension of patent rights via trade dress laws, and remanded the case to the district court with instructions to conduct a functionality analysis.

In a poorly reasoned opinion, the Federal Circuit in *Karavan* contended that the availability of trade dress protection "does not depend upon whether a patent has been obtained for the product or feature in question."¹⁸³ Criticizing *Vornado*, the Federal Circuit stated that the Tenth Circuit "stands alone" in its analysis that trade dress protection for patented product configurations is unavailable.¹⁸⁴ The court reinforced its protectionist reputation by elevating the CCPA's 1961 *Deister*¹⁸⁵ case as a seminal case. Deister had said:

[W]e are not seriously concerned with whether he who claims trademark rights of unlimited duration now has or did have patent protection, or what that protection was.¹⁸⁶

Deister had ignored the Supreme Court precedent of *Singer* and *Kellogg* which state that it actually *does* matter. The Federal Circuit

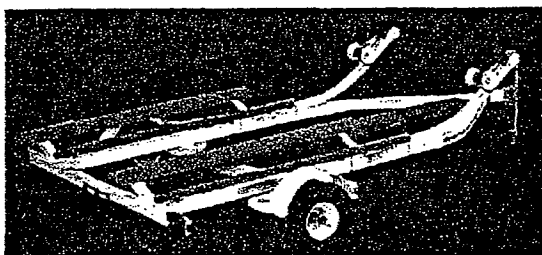


FIG. X

¹⁸² In an *in banc* portion of its opinion, unrelated to the merits of the trade dress issue, the Federal Circuit held that it would apply Federal Circuit law in determining whether patent law conflicts with other federal statutes or preempts state law causes of action. *Midwest Industries, Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 50 U.S.P.Q.2d (BNA) 1672 (Fed. Cir. 1999).

¹⁸³ *Midwest*, 50 U.S.P.Q.2d (BNA) at 1677.

¹⁸⁴ *Id.* But cf. *Elmer*, discussed in §III.E.1., *supra*.

¹⁸⁵ *Midwest*, 50 U.S.P.Q.2d (BNA) at 1677.

¹⁸⁶ *In re Deister Concentrator Co.*, 289 F.2d 496, 501, 129 U.S.P.Q. 314, 319 (C.C.P.A. 1961).

United States Patent [19]

[11] Patent Number: 5,518,261

Godbersen

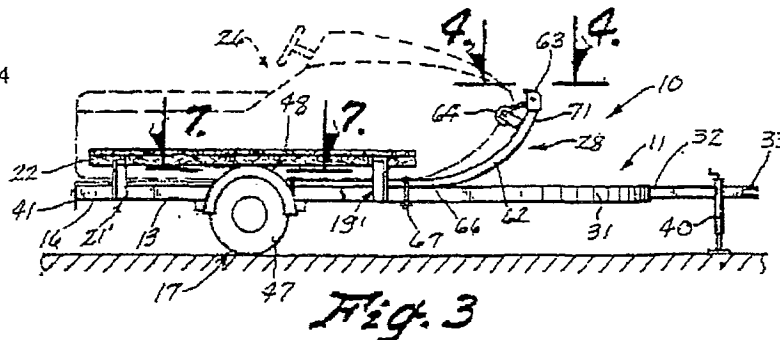
[45] Date of Patent: May 21, 1996

[54] PERSONAL WATERCRAFT TRAILER

[76] Inventor: Byron L. Godbersen, Lake Lalune
Estates, Ida Grove, Iowa 51445

[21] Appl. No.: 337,312

[22] Filed: Nov. 10, 1994



10. The personal watercraft trailer of claim 7, with each said elongated element said one end substantially straight for mating engagement with a contiguous frame member portion, and with said free end curved forwardly and upwardly away from said one end, said element disposed normally in a vertical plane.

FIG. Y

neatly disposed of this Supreme Court precedent first by saying it came from “older decisions”, and then by saying that those cases “have not been read expansively”.¹⁸⁷

Finally, in an effort to counterbalance the weight of the Supreme Court’s right to copy authority, the Federal Circuit in *Karavan* quoted with approval the following language from the old CCPA *Mogen David II* case:

[W]e know of no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of any expired patent. Patent expiration is nothing more than the cessation of the patentee’s right to exclude others held under the patent law.¹⁸⁸

¹⁸⁷ It appears that those cases were not read at all during the time that §43(a) has been expanding over the last 30 years to include product configurations. See Kohler, 29 U.S.P.Q.2d (BNA) 1241, 1252 (7th Cir. 1993) (Cudahy, J., dissenting).

¹⁸⁸ *Midwest*, 50 U.S.P.Q.2d (BNA) at 1677, citing *In re Mogen David Wine Corp.*, 328 F.2d 925, 930, 140 U.S.P.Q. (BNA) 575, 579 (C.C.P.A. 1964).

This, of course, is surprisingly reminiscent of the Federal Circuit's similar assertion in the *Interpart* plug-molding case¹⁸⁹ which was subsequently roundly criticized by the Supreme Court in *Bonito Boats*.¹⁹⁰

IV. DOES DOC FUNCTIONALITY CURE ALL ILLS?

Simply stated, the doctrine of functionality¹⁹¹ falls short in answering the question of whether granting trade dress rights in the subject matter of an expired patent unduly extends the exclusive rights (i.e., the conundrum), for two reasons: one, the doctrine of functionality fails to distinguish between unexpired and expired utility patents; and two, it cannot be applied in any reasonably objective manner to design patents.

First, the doctrine of functionality fails to distinguish between subject matter claimed in unexpired utility patents (which the public does not have a right to copy) and subject matter claimed in expired utility patents (which the public clearly has a right to copy.)¹⁹² In virtually every case, the courts have applied the doctrine without regard to whether the utility patent is unexpired or expired. In those cases in which the patent has expired, e.g., in *Thomas & Betts*,¹⁹³ courts typically refer to, and may even discuss in detail, the right to copy doctrine, but have generally relied instead upon the doctrine of functionality to resolve the conundrum of whether it is permissible to grant trademark rights in the subject matter of the patent. Save for the Supreme Court cases discussed *supra*,¹⁹⁴ no reported decision has held that the subject matter of an expired patent is in the public domain and thus is incapable, for that reason alone, of qualifying for trademark protection.¹⁹⁵

In those cases in which the patent has not expired, courts generally apply the same sort of functionality analysis, except that courts are even

189 *Interpart Corp. v. Imos Italia, Vitaloni, s.p.a.*, 777 F.2d 678, 228 U.S.P.Q. (BNA) 124 (Fed. Cir. 1985).

190 The Supreme Court in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S.Ct. 971, 9 U.S.P.Q.2d 1847 (1989) stated: "[W]e are somewhat troubled by the Interpart court's . . . proposition that the patent laws say 'nothing about the right to copy of the right to use' . . . For almost 100 years it has been well established that in the case of an expired patent, the federal patent laws do create a federal right to 'copy and to use'. Sears and Compco extended that rule to potentially patentable ideas which are fully exposed to the public. The Interpart court's assertion to the contrary is puzzling and flies in the face of the same court's decisions applying the teaching of Sears and Compco in other contexts. [citations omitted]. 489 U.S. at 164.

191 See §III.A.3., *supra*.

192 See *Singer, Kellogg, Sears, Compco*, and *Bonito*, *supra*.

193 *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 46 U.S.P.Q.2d (BNA) 1026 (7th Cir. 1998).

194 See, *supra*, §§III.A.1. and III.A.2.

195 The *Dorr-Oliver* case, §III.D.3., *supra*, came close, but grounded its reversal on there being no possibility of a likelihood of confusion.

less likely to examine the right to copy doctrine since, after all, the right to copy only kicks in upon patent expiration.¹⁹⁶

There is nothing in the doctrine of functionality itself which distinguishes between unexpired and expired utility patents. The first *Morton Norwich* evidentiary factor¹⁹⁷ requires the *disclosure* of the utility patent to be reviewed for evidence of utilitarian advantages. Disclosures of patents do not change when the patent expires; they either disclose or do not disclose utilitarian advantages. Moreover, the doctrine of functionality focuses on the more general and usually expansive disclosure of the utility patent rather than what is technically claimed as the invention.

Thus, since the doctrine of functionality does not itself distinguish between unexpired and expired patents, it cannot answer the question of whether the public's right to copy expired patent subject matter should prevail over the public's right not to be confused as to the source or origin of the goods.

The second reason that doc functionality does not cure all ills is that the doctrine cannot be applied in any reasoned or objective manner to the subject matter of design patents.¹⁹⁸

The traditional doctrine of functionality prevents trademark/trade dress law from being improperly used to monopolize utilitarian features disclosed in utility patents.¹⁹⁹ This it does very well.²⁰⁰ One of the reasons it does this well, perhaps, is because objective evidence can be evaluated.²⁰¹

However, the traditional functionality doctrine cannot be used with design patents. This is because, as pointed out by many courts, the subject matter of design patents is, by definition, non-functional. The patent

196 Two notable exceptions are the *Vornado* case, discussed in §III.C.1., *supra*, and the *Elmer* case, discussed in §III.E.1., *supra*.

197 See §III.A.3., *supra*.

198 Circuit Judge Posner: "And provided that a defense of functionality is recognized, there is no conflict with federal patent law, save possibly with 35 U.S.C. §171, which allows a 14-year patent to be granted for a nonfunctional ornamental design—a design patent." *W.T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 228 U.S.P.Q. (BNA) 145 (7th Cir. 1985). Judge Posner's reconciliation of the conflict—that the trademark owner in an infringement suit must also prove secondary meaning and likelihood of confusion "which the owner of a design patent need not do" ignores the requirements for a design patent that the claimed design must be novel and nonobvious over the prior art, and that the design patent owner must prove that the accused design is substantially the same overall and has appropriated the point of novelty of the patented design in order to prevail in an infringement suit.

199 Or for that matter, disclosed anywhere in the literature, or anywhere on the planet Earth.

200 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 115 S.Ct. 1300, 1304, 35 U.S.P.Q. 2d 1161, 1165 (1995) ("And, the federal courts have demonstrated that they can apply this doctrine in a careful and reasoned manner, with sensitivity to the effect on competition.").

201 *In re Morton Norwich Products, Inc.*, 671 F.2d 1332, 1336, 213 U.S.P.Q. (BNA) 9 (C.C.P.A. 1982), see §III.A.3., *supra*.

statute in 35 U.S.C. §171 requires design patents to be issued only for “ornamental” designs, which has been interpreted to include product shape and/or surface decoration. The flip side of ornamentality is functionality, and many courts have held that a design patent cannot be granted if the design is primarily functional rather than primarily ornamental,²⁰² or if function dictates the design.²⁰³

Thus, there is no immediate conflict raised by granting trade dress protection on the subject matter of an unexpired design patent.²⁰⁴ The conundrum rears its ugly head only when the design patent expires 14 years from the date of patent issuance. As pointed out by Judge Cudahy in his cogent *Kohler* dissent, why should the public be free to copy the subject matter of expired utility patents but not be free to copy the subject matter of expired design patents?²⁰⁵

Thus, the Supreme Court in *TrafFix* should not follow the lead of earlier lower court decisions that have simply applied the functionality doctrine, since whatever test is adopted should take into account both design patents and utility patents. Since design patents and utility patents stem from the same Constitutional provision,²⁰⁶ and the same body of statutory and case law applies to both types of patents,²⁰⁷ whatever ruling the Court makes with respect to expired utility patents should also hold for expired design patents.

V. KIBITZING FOR THE KAHUNAS—A PROPOSAL

In the *TrafFix* case, the Supreme Court must first decide whether the right to copy doctrine is still viable. If it is, and it certainly should be, the Supreme Court must then decide how to test whether the subject matter of an expired patent is being improperly appropriated as alleged trade dress, and the test must take into account both expired utility patents and expired design patents.

If the Court decides that the traditional utilitarian doctrine of functionality satisfactorily ensures that the alleged trade dress does not improperly cover the subject matter of an expired utility patent, it may then decide to resurrect the doctrine of aesthetic functionality to ensure that

²⁰² *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 231 U.S.P.Q. 774 (Fed. Cir. 1986).

²⁰³ *Bonito Boats*, 489 U.S. at 148 (“To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone. . .”).

²⁰⁴ provided the design patent is not invalid on grounds of functionality.

²⁰⁵ *Kohler*, 29 U.S.P.Q.2d (BNA) at 1255.

²⁰⁶ See note 6, *supra*.

²⁰⁷ The provisions of this title relating to patents for inventions [i.e., utility patents] shall apply to patents for designs. . .” 35 U.S.C. §171.

the alleged trade dress does not improperly cover the subject matter of an expired design patent.

While the Court touched on the aesthetic functionality test in *Qualitex*, its decision in *Wal-Mart* strongly suggests that it would not endorse the nonobjective doctrine of aesthetic functionality for this purpose.²⁰⁸ *Wal-Mart* indicates that the Court is unwilling to adopt a test that is vague, unpopular and strongly criticized and, as a result, will foment uncertainty and litigation rather than foster competition.

Thus, the Court should clearly state that the use of the doctrine of functionality alone is not a solution to the conundrum.

Instead, the Court should reaffirm the doctrines of the *Singer*, *Kellogg* and *Sears/Compco* line of cases that the subject matter of an expired patent enters the public domain, and the public has a right to copy it. Any attempt to claim trade dress protection in the same subject matter is void as against public policy. This respects the bargain between the inventor, beneficiary of a 14 or 20 year monopoly on the design or invention, and the public. When the patent monopoly is over, it's over, and no other law, state or federal, can be used to extract that subject matter from the public domain. This rule would be independent of the doctrine of functionality, and should be applied regardless of the distinctiveness of the alleged trade dress or of the likelihood of confusion.²⁰⁹

If someone claims trade dress rights in subject matter disclosed in an expired patent, the court must examine the claims of the expired patent to determine their meaning and scope. This is an exercise that district courts have become accustomed to in patent infringement suits in what has become known as a "Markman determination" after the Supreme Court case *Markman v. Westview Instruments, Inc.*²¹⁰ This case held that, prior to the fact-finder determining the issue of infringement, the court must determine the meaning and scope of the patent claims as a matter of law.²¹¹ Determining the meaning and scope of the claims in an expired patent will define what is actually in the public domain.²¹²

208 See §III.A.4., *supra*.

209 Proper labeling can avoid most confusion between similar product configurations. See, e.g., *Kohler Co. v. Moen Inc.*, 29 U.S.P.Q.2d (BNA) at 1248, fn. 10 ("Kohler is free to copy Moen's design so long as it insures that the public is not thereby deceived or confused into believing that its copy is a Moen faucet.")

210 517 U.S. 370, 16 S.Ct. 1384, 38 U.S.P.Q.2d (BNA) 1461 (1996).

211 *Markman*, 38 U.S.P.Q.2d (BNA) at 1470-71.

212 It is likely that the Federal Circuit would become the final arbiter of such "meaning and scope" claim determinations in view of its decision in *Midwest Industries v. Karavan*, *supra*, that it will apply Federal Circuit law in determining whether patent law conflicts with the Lanham Act. see footnote 185-91, *supra*.

Since it is only the claimed subject matter in which the patent owner had exclusive rights during the life of the patent, it is that same claimed subject matter that enters the public domain upon patent expiration.²¹³

After the court determines the meaning and scope of the expired patent claims, it must then determine whether the alleged trade dress falls within that meaning and scope. If it does, then trade dress protection under §43(a) is precluded. If it does not, then the right to copy defense is defeated, and the trade dress owner can make its case for distinctiveness, nonfunctionality, and likelihood of confusion.

Three courts have come close to this type of utility patent claim language analysis. The Seventh Circuit in *Thomas and Betts*,²¹⁴ although it ultimately used the doctrine of functionality to determine whether trade dress protection attached, did so only after finding that the oval shape of the head had not been claimed in the expired patent.²¹⁵ The Tenth Circuit in *Vornado*,²¹⁶ although adopting a *per se* rule that prohibited trade dress protection for "a significant inventive component" of the unexpired utility patent, did examine the patent claims to determine that the spiral shaped vanes were in fact part of the claim language.²¹⁷ And finally, in *Elmer*,²¹⁸ the Federal Circuit, accustomed to claim language and Markman determinations, found that the alleged trade dress was broader than claim 1 of the plaintiff's unexpired utility patent and thus vacated the lower court's injunction as overly broad in that it potentially extended the patent monopoly in perpetuity.²¹⁹

Such a rule is clear and predictable, at least as much as a traditional Markman determination is in a patent infringement suit. It will presumably end the now-common practice of obtaining a trademark registration after a utility patent expires,²²⁰ or the even more prevalent practice of piggy backing an expired design patent with a trademark registration on the same design.²²¹

It may cause product owners to think seriously about the respective advantages and disadvantages before choosing patent law or trademark

213 Although a discussion of everything that's in the public domain is beyond the scope of this paper, one can safely say that it at least includes the subject matter covered by the claims of an expired patent.

214 138 F.3d 277, 46 U.S.P.Q.2d (BNA) 1026, 1028-29 (7th Cir. Ill. 1998).

215 See note 131, *supra*.

216 58 F.3d 1498, 1500, 35 U.S.P.Q.2d (BNA) 1332, 1333-34 (10th Cir. Kan. 1995).

217 See notes 112-121, *supra*.

218 See note 176, *supra*.

219 See FIG. W, *supra*.

220 See, e.g., U.S. Trademark Reg. No. 1,632,262, issued Jan. 22, 1991, covering the product configuration of the Tizio™ lamp which had been covered by U.S. Pat. No. 3,790,773, a utility patent that expired, curiously, on Feb. 5, 1991, two weeks after the mark was registered.

221 See the examples in §§III.B.2. and III.C.2., *supra*.

law to protect their product. That is, product owners may need to decide ahead of time whether to pursue the limited time protection of the patent law or the potentially unlimited time protection of the trademark/trade dress laws, along with other pros and cons of the two types of legal protection.

While the Supreme Court in *TrafFix* only agreed to review the issue of whether trade dress protection was available under §43(a) of the Lanham Act for the subject matter of expired patents, it may also wish to consider how its ruling will affect the question of whether trade dress protection is available for the subject matter of unexpired patents, unpatented but patentable product features, and unpatented but unpatentable product features.²²² If the Court generalizes its holding to include such cases, future potential disputes will be minimized.

A few courts have already recognized the potential conflict between claiming trade dress rights in the subject matter of unexpired utility and design patents,²²³ since, by definition, the patents will expire on a date certain when the claimed subject matter will enter the public domain. The courts that have dealt with that issue have either adopted a *per se* rule against trade dress protection (*Vornado*), or have required the definition of the protected trade dress to be narrow enough that competitors will still be able to compete in the functional aspects of the claimed invention after the patent expires (*Elmer*). While the *Vornado* court would deny trade dress protection before the patent expires, presumably the *Elmer* court would allow it if the trade dress was narrowly defined. In both cases, trademark protection, if drawn to the same subject matter that is within the scope of the patent claim(s), should end when the patent expires and the subject matter enters the public domain.

For unpatented but patentable features, a rule allowing trademark/trade dress protection would not contradict the *Singer* and *Kellogg* rule since there is no unexpired patent at issue. Purists, however, would assert an exception for those product features deemed to be in the public domain, and an argument might also be made that obtaining perpetual monopoly rights via the trademark laws on patentable but unpatented product features still violates the "limited times" clause of the Constitution.

Similarly, with unpatented but unpatentable product features, the *Singer* and *Kellogg* rule would not prevent a product owner from obtaining trade dress protection if the unpatentable product feature meets the

²²² See Dratler at 521–555.

²²³ See *Vornado*, *Elmer*, and *Mogen David I*, *supra*.

other requirements of §43(a), if the subject matter is not deemed to otherwise be in the public domain, and the potentially perpetual protection would not be violative of the "limited times" clause.

There may over time emerge an election doctrine that says that once a product owner has obtained a patent, she has elected that form of limited monopoly and cannot assert trade dress rights in the same subject matter, ever. Conversely, although far less likely,²²⁴ once trade dress rights were asserted, one could be precluded from obtaining patent protection on the same subject matter.

In summary, one should not be able to assert §43(a) trade dress rights, or obtain a federal trademark registration, on the subject matter covered by an expired patent (both design and utility). If a patent has not expired, the Court must decide whether to preclude trade dress protection altogether because the patent will expire someday (*Elmer, Vornado*) or to allow trade dress protection but only until the patent expires. If no patent has been obtained, but the subject matter is patentable, the Court again must decide whether the policies underlying the patent laws, and the opportunity that the inventor/designer had to take advantage of them, should weigh against granting trade dress protection. Finally, if no patent has been obtained because the subject matter is not patentable, will the Court inquire as to the public domain status of the subject matter in deciding whether to allow trade dress rights to exist?

Some might restate the overriding question in terms of the public domain: can one extract designs/inventions from the public domain and claim potentially perpetual monopoly rights in them through the trademark/trade dress laws? If not, the inquiry would focus on defining exactly what is and is not in the "public domain" (it at least comprises the subject matter of expired patents). There is little doubt that the *Sears* and *Compco* Courts would answer the question in the negative; for the current Court, it is not as clear, nor is it clear as to whether they would even open that particular Pandora's Box (except with great care).

²²⁴ Since trade dress rights in designs are only available after a showing of secondary meaning (*Wal-Mart, supra*), and since a patent must be applied for within one year of the first offer for sale, 35 U.S.C. §102, it is far less likely for one to assert trade dress rights in a newly introduced product prior to applying for and obtaining a patent.