

## Functional Signs and Decanters of Wine: How Trade Dress Protection Unconstitutionally Extends Expired Design Patents

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# **Functional Signs and Decanters of Wine: How Trade Dress Protection Unconstitutionally Extends Expired Design Patents**

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Tyler Jackson graduated from Marquette University School of Law in 2013. While at Marquette, he focused his studies on intellectual property law, with a specific interest in Constitutional intellectual property law issues. He became interested in design patents when working on a design patent litigation at an internship during law school. Tyler plans to continue to pursue his interest in constitutional intellectual property issues and design patents with an emphasis on the litigation of design patents.



## INTRODUCTION

The ability to protect a design with trade dress that either is also protected by a design patent or was previously protected by a now expired design patent unconstitutionally extends the protection of new, original, and ornamental designs. Even further, the ability to receive indefinite trade dress protection for an unpatented, but patentable, design unconstitutionally allows indefinite protection of patentable subject matter. The right to copy an invention claimed by an expired utility or design patent stems from the language and intent of the Intellectual Property (“IP”) Clause, and there is substantial Supreme Court and other precedent that supports the right to copy doctrine. For the past forty years, however, the right to copy doctrine has all but disappeared from the Supreme Court’s language. In fact, the Federal Circuit has explicitly abandoned the right to copy doctrine.<sup>1</sup> Instead, in the *TrafFix* decision, the Supreme Court has resorted to the functionality doctrine to prevent the term extension of a utility patent through trade dress protection.<sup>2</sup> The lower courts, before and after *TrafFix*, have made the same determination that the functionality doctrine prevents any conflict between trade dress and patent protection.<sup>3</sup>

The functionality doctrine, however, does not address the conflict between design patent and trade dress protection. In fact, the functionality doctrine has inflated the problem since *TrafFix*. *TrafFix* stands for the proposition that a utility patent is presumptive evidence of functionality for a trade dress analysis.<sup>4</sup> Courts have since interpreted this to mean the converse for a design patent; namely, that a design patent is presumptive, but not dispositive, evidence of non-functionality for a trade dress analysis.<sup>5</sup> This is because a design patent would also be invalid if the design was functional and not ornamental.<sup>6</sup> Therefore, it is more likely that a design will receive trade dress protection if that same design is or has been the subject of a design patent.

This Comment will argue that the ability to receive trade dress protection on a design that has been or could be the subject of a design patent is unconstitutional. The first section of this Comment will discuss the overlap

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1. *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1362 (Fed. Cir. 1999); *see generally* *In re Mogen David Wine Corp.*, 372 F.3d 539, 543 n.2 (C.C.P.A. 1967) (Smith, J., concurring).

2. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29–30 (2001).

3. *See e.g.* *Epic Metals Corp. v. Souliere*, 99 F.3d 1034 (11th Cir. 1996); *W.T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985).

4. *TrafFix*, 532 U.S. at 29–30.

5. *See e.g.* *Fuji Kogyo Co., Ltd. v. Pac. Bay Int’l, Inc.*, 461 F.3d 675, 683–684 (6th Cir. 2006); *Secalt S.A. v. Wuxi Shenxi Constr. Mach. Co., Ltd.*, 668 F.3d 677, 685 (9th Cir. 2012); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375 (Fed. Cir. 2012).

6. 35 U.S.C. § 171 (2006); *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002).

between design patent and trade dress protection and how it leads to products receiving protection in both areas. The second section will discuss the right to copy doctrine, its root in the Constitution, and its development through Supreme Court and Federal Circuit precedent. The third section will discuss the *TrafFix* decision and the role it has played in preventing the extension of utility patent terms, but bolstered the extension of design patent terms, through trade dress protection. The fourth section will argue that this unconstitutionally allows for indefinite protection of designs covered by expired or unexpired design patents and products that are unpatented but patentable under design patents. Finally, this Comment will argue that the only solution is to not allow trade dress protection for designs that are patentable as design patents. Some argue that merely forcing a choice between trade dress and design patent protection is sufficient;<sup>7</sup> however, if the subject matter of design patents is properly within the scope of patent protection, then allowing such designs to bypass the constitutional limitations of patent protection by calling them trade dress is still an unconstitutional term for a monopoly on a design.

## I. THE OVERLAP BETWEEN DESIGN PATENT AND TRADE DRESS

Design patent and trade dress protections have significant overlap. While not identical, the subject matter and tests for validity and infringement are very similar. Product configurations often qualify for both or either types of protection, and claims for both are often asserted in the same litigation. However, the overlap is such that the subject matter of expired design patents can be indefinitely protected under trade dress. This Comment will argue that this unconstitutionally extends the protection for new, original, and ornamental designs beyond a limited time and unconstitutional inhibits the right to copy.

### A. *Design Patent Protection*

Design patents protect the “new, original and ornamental design for an article of manufacture.”<sup>8</sup> An ornamental design can be surface ornamentation on an article of manufacture, the configuration of an article of manufacture, or a combination of both.<sup>9</sup> An article of manufacture, unlike the subject of copyright protection, must necessarily serve a utilitarian purpose.<sup>10</sup> Both

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7. Takashi Saito, *Dressing Design Patent: A Proposal for Amending the Design Patent Law in Light of Trade Dress*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 682, 688 (2007); Perry J. Saidman, *Kan TrafFix Kops Katch the Karavan Kopy Kats?*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 839, 888–889 (2000).

8. 35 U.S.C. § 171 (2006).

9. *Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1871); *In re Blum*, 374 F.2d 904, 907 n.1 (C.C.P.A. 1967).

10. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F. 2d 1117, 1123 (Fed. Cir. 1993).

design and utility patents may be obtained on an article “if invention resides both in its utility and ornamental appearance.”<sup>11</sup> However, like trade dress, articles of manufacture that are functional cannot receive design patent protection.

An article of manufacture is functional, according to design patent parlance, if it is dictated by the use or purpose of the article.<sup>12</sup> To determine whether a design is dictated by its use, the Court must ask whether the claimed design is “the only possible form of the article that could perform its function.”<sup>13</sup> If “there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.”<sup>14</sup> Put another way, “if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.”<sup>15</sup> Although certain features of an article of manufacture can be functional,

a distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Were that not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture, . . . or to obtain both design and utility patents on the same article[.]<sup>16</sup>

The Federal Circuit has similarly stated “that the design of a particular article is related to the article’s use may not defeat patentability.”<sup>17</sup> The ultimate question is “whether functional considerations demand only this particular design or whether other designs could be used.”<sup>18</sup>

The court in *Richardson I* went on to list the following additional considerations for analyzing whether a design is primarily ornamental:

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11. Manual of Patent Examining Procedures (“MPEP”), § 1502.01, “Distinction Between Design and Utility Patents [R-2]” (8th ed., Aug. 2011).

12. *Rosco, Inc. v. Mirror Lite Co.*, 304 F. 3d 1373, 1378 (Fed. Cir. 2002).

13. *Id.*

14. *Id.*; *L.A. Gear*, 988 F.2d at 1123 (citing *Avia Grp. Int’l, Inc. v. L.A. Gear California*, 853 F.2d 1557, 1563 (Fed. Cir. 1988)); *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046, 1049 (D. Ariz. 2009) (“*Richardson I*”), *aff’d* 597 F.3d 1288, 1298 (Fed. Cir. 2010) (“*Richardson II*”).

15. *Rosco*, 304 F.3d at 1378.

16. *Avia*, 853 F.2d at 1563 (citing *Pacific Furniture Mfg. Co. v. Preview Furniture Corp.*, 800 F.2d 1111 (Fed. Cir. 1986) (design patent for chairs)); *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 938–39 (Fed. Cir. 1983); *In re Dubois & Will*, 262 F.2d 88, 90 (Fed. Cir. 1958).

17. *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997).

18. *Id.*

- (1) whether the protected design represents the best design;
- (2) whether alternative designs would adversely affect the utility of the specified article;
- (3) whether there are any concomitant utility patents;
- (4) whether the advertising touts particular features of the design as having specific utility; and
- (5) whether there are any elements in the design or an overall appearance clearly not dictated by function.<sup>19</sup>

The test for infringement of a design patent is the ordinary observer test. The Supreme Court declared the test as follows:

if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.<sup>20</sup>

### *B. Trade Dress Protection*

Trade dress protects “the total image and overall appearance of a product or business as reflected in such features as size, shape, color or color combinations, design of a label, texture, graphics or sales techniques.”<sup>21</sup> Generally, trade dress protection includes the packaging or design of a product.<sup>22</sup> To qualify for protection, the design of the product must be distinctive.<sup>23</sup> The distinctiveness of a design for a product (trade dress) can be established “only upon a showing of secondary meaning.”<sup>24</sup>

The doctrine of secondary meaning for trade dress asks whether the design of a product “has come through use to be uniquely associated with a specific source.”<sup>25</sup> The Supreme Court stated that “[t]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”<sup>26</sup> Secondary meaning has no counter-part in design patent law.

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19. *Richardson I*, 610 F. Supp. 2d at 1049–50.

20. *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871).

21. Joel W. Reese, *Defining the Elements of Trade Dress Infringement under Section 43(a) of the Lanham Act*, 2 TEX. INTELL. PROP. L.J. 103, 104 (1993–94).

22. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000).

23. 15 U.S.C. § 1052 (2006).

24. *Wal-Mart*, 529 U.S. at 216.

25. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 n.4 (1992).

26. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982).

Like design patents, the design of a product is entitled to trade dress protection only if it is nonfunctional.<sup>27</sup> Functionality in trade dress parlance, like in design patent parlance, has a specific meaning that does not necessarily comport with the ordinary, every-day meaning of the term. Similar to design patent functionality, a design is not functional under trade dress law merely because it serves a function.<sup>28</sup> Rather, unlike design patent law, the focus of trade dress functionality is competition, and a design is functional if “free competition would be unduly hindered by according the design trademark protection.”<sup>29</sup> Put another way, a design is functional if “the feature is one that competitors would find necessary to incorporate into their product in order to be able to compete effectively.”<sup>30</sup> According to the Supreme Court, the relevant inquiry is whether the design “is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>31</sup> The Supreme Court expanded upon this meaning by observing that a functional feature is one the exclusive use of which would be competitors at a significant non-reputation-related disadvantage.<sup>32</sup> While the functionality doctrines in trade dress and design patent law are substantially similar, the purpose of each is different and thus results in a slightly different doctrine; the primary purpose of trade dress functionality is competition,<sup>33</sup> and the primary purpose of design patent functionality is to promote the decorative arts.<sup>34</sup>

Furthermore, the doctrine of aesthetic functionality is one that exists in trade dress law and not design patent. Because the functionality doctrine in trade dress focuses on competition, trade dress law has a doctrine of aesthetic functionality that denies trade dress protection for purely ornamental features that are essential to competition.<sup>35</sup> Specifically, the court in *Wallace* held that “where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection.”<sup>36</sup> This doctrine creates the potential for a design that is functional under trade dress law but ornamental under design patent law.

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27. *Two Pesos*, 505 U.S. at 775.

28. *Vaughan Mfg. Co. v. Brikam Int’l, Inc.*, 814 F.2d 346, 349 (7th Cir. 1987).

29. *Two Pesos*, 505 U.S. at 775.

30. *Vaughan*, 814 F.2d at 349.

31. *Inwood*, 456 U.S. at 850 n.10.

32. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32–33 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995)).

33. *Two Pesos*, 505 U.S. at 775.

34. *Avia Grp. Int’l, Inc. v. L.A. Gear California*, 853 F.2d 1557, 1563 (Fed. Cir. 1988).

35. *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80–81 (2d Cir. 1990).

36. *Id.* at 81.

Design patents and trade dress protect very similar subject matter. Both protect the overall configuration of products, and both are limited by a similar functionality doctrine. Often times, the manufacturer of a product will attempt to receive both types of protection on the same product, even if the courts inevitably strike down the overlapping protection.<sup>37</sup> This Comment will argue that this type of sequential protection between design patent and trade dress destroys the right to copy doctrine that was once a critical doctrine in patent jurisprudence. The right to copy is functionally destroyed by the ability to protect a design previously covered by a design patent through trade dress because the design previously covered by the design patent will potentially never enter the public domain. The next section of this Comment will discuss the development of the right to copy doctrine and its relation to design patent and trade dress protection.

## II. THE RIGHT TO COPY SAGA

Two phrases in the Constitution create the right to copy. Article I, Section 8, Clause 8 of the Constitution, which is often referred to as the Copyright and Patent Clause,<sup>38</sup> provides:

[The Congress shall have the power] [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries[.]<sup>39</sup>

The two phrases from here that create the right to copy are “to promote the progress” and “for limited times.” The right to copy promotes progress by allowing the public to build upon the inventions in expired patents and stimulate new innovation.<sup>40</sup> It is self-evident why the right to copy follows from the constitutional mandate that patent rights be for limited times; if the right to copy

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37. See, e.g., *Wilcox & Gibbs Sewing-Machine Co. v. The Gibbens Frame*, 17 F. 623, 625 (C.C.S.D.N.Y. 1883); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119–20 (1938); *In re Mogen David Wine Corp.*, 372 F.3d 539, 542 (C.C.P.A. 1967); *In re Honeywell, Inc.*, 497 F.2d 1344, 1345 (C.C.P.A. 1974).

38. See, e.g., *Golan v. Holder*, 132 S. Ct. 873, 878 (2012).

39. U.S. CONST. art. I, § 8, cl. 8. (Scholars have pointed out that this is really two clauses in one: the Copyright Clause and the Patent Clause. *In re Bergy*, 596 F.2d 952, 958 (C.C.P.A. 1979). The Copyright Clause is to promote the Progress of Science, by securing for limited Times to Authors the exclusive Right to their respective Writings. *Id.* The Patent Clause is to promote the Progress of useful Arts, by securing for limited Times to Inventors the exclusive Right to their respective Discoveries. *Id.*)

40. *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480–81 (1974).

never actualized, the patent monopoly would not be limited in time.<sup>41</sup>

A. *The Supreme Court Creates a New Hope for the Right to Copy*

Almost one hundred and twenty years ago, the Supreme Court declared that the expiration of a patent dedicates the subject of that patent to the public domain.<sup>42</sup> Not only did the Supreme Court believe this to be true, it believed it to be “self evident.”<sup>43</sup> This dedication to the public domain is a result of the bargain that the patent owner makes when applying for and receiving the benefits of the patent monopoly.<sup>44</sup> Nearly forty years later, the Supreme Court again declared that the dedication to the public of the invention within an expired patent naturally follows from the expiration of the patent.<sup>45</sup> But the Supreme Court did not stop there. The Supreme Court went on to declare that, along with the dedication of the invention within the expired patent, an expired patent necessarily dedicates “the generic designation of the thing which has arisen during the monopoly” to the public.<sup>46</sup> Secondary meaning was irrelevant because the only reason the owner of the expired patent had acquired secondary meaning was through the monopoly on the product it had from the patent.<sup>47</sup>

For another fifty years, the Supreme Court used its precedent in *Singer* and *Kellogg* to reinforce the right to copy doctrine.<sup>48</sup> While the Supreme Court used the Supremacy Clause in both of these cases to preempt state unfair competition laws that extended expired patent rights,<sup>49</sup> the analysis of the right to copy doctrine is clear: when a patent expires, the monopoly created by it expires, and the right to make the article passes to the public.<sup>50</sup>

B. *The CCPA Strikes Back at the Right to Copy*

A shift was put into motion with a Trademark Trial and Appeals Board (TTAB) decision that affirmed the refusal of the registration for trade dress

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41. Saidman, *supra* note 7, at 887; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989); *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 255 (1945); *August Tech. Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1288 (Fed. Cir. 2011); *Kewanee Oil*, 416 U.S. at 480–81.

42. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

43. *Id.*

44. *Id.*

45. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938).

46. *Id.*

47. *Id.* at 118.

48. *See, e.g.*, *Sears, Roebuck & Co., v. Stiffel Co.*, 376 U.S. 225, 229–30 (1964); *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 164–65 (1989).

49. *Sears*, 376 U.S. at 230–31; *Bonito*, 489 U.S. at 167–68.

50. *Sears*, 376 U.S. at 230.

protection of a wine decanter, which was also protected by a design patent.<sup>51</sup> Specifically, in *Mogen*, the TTAB refused the registration on the principal register.<sup>52</sup> The TTAB reasoned that trade dress protection for the decanter would be inconsistent with the purpose and intent of patent law because it would interfere with the right of others to make fair use of the design when the design patent expired.<sup>53</sup> The TTAB also reasoned that the use of the patented design did not constitute use as a trademark because the design was used exclusively only because the owner of the design patent had a monopoly on the use of the design.<sup>54</sup> After the affirmation of the rejection from the TTAB, the applicant appealed the decision to the Court of Customs and Patent Appeals (CCPA).<sup>55</sup>

The CCPA reversed the TTAB, allowing the registration of the design of the wine decanter on the principal register.<sup>56</sup> The court took a hyper-technical reading of the design patent and trade dress statutes, giving little consideration to the actual impact of its decision or Supreme Court precedent. The court concluded that trademark rights on a design covered by a design patent do not extend the patent monopoly beyond the expiration of the patent.<sup>57</sup> The court asserted that “[t]he termination of either has no *legal effect* on the continuance of the other” because the expiration of the patent merely ends the “patentee’s right to exclude held under the patent law.”<sup>58</sup> The court also stated that it knows of no provision of patent law that guarantees a right to copy the subject matter of an expired patent.<sup>59</sup>

This hyper-technical reading of the statutes ignores the purpose and intent of patent law, Supreme Court precedent, and the ways laws interact in practice. While it may be true that there is no statute that expressly creates the right to copy, as explained above, the right to copy is inherent in the Constitution and intent of patent law, and it is supported by substantial Supreme Court precedent that is completely ignored by the CCPA. Moreover, many patent law doctrines are not expressly stated in statutes but are judicially created or interpreted from the language and purpose of the statutes (e.g. doctrine of equivalents;<sup>60</sup> double-

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51. In re Mogen David Wine, Corp., 134 U.S.P.Q. 576 (P.O. T.App.Bd. 1962)

52. *Id.* at 578.

53. *Id.*

54. *Id.*

55. In re Mogen David Wine Corp., 328 F.2d 925 (C.C.P.A. 1964).

56. *Id.* at 932.

57. *Id.* at 930.

58. *Id.* (emphasis added).

59. *Id.*

60. See, e.g., Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605, 608 (1950).

patenting<sup>61</sup>). Therefore, it is not sufficient for the CCPA to simply say that they know of no law about the right to copy. Furthermore, the fact that patent law and trademark law have no statutorily defined legal effects on each other does not mean that the application of the two has no legal consequences for each other. In fact, courts have long held that patent law and trademark law interact, and one can implicate the ability to get another or the scope of another.<sup>62</sup>

About ten years after *Mogen*, the CCPA again heard a case about the right to copy and basically ignored the Supreme Court precedent on it. In *In re Honeywell*, the CCPA followed its previous decision in *Mogen*, while attempting to distinguish it from the Supreme Court precedent on the right to copy.<sup>63</sup> However, the CCPA conflates the functionality doctrine with the right to copy doctrine. Because of this, the CCPA ends up ignoring the right to copy doctrine because the design patents do not evince that a product configuration is functional and therefore not protectable with trade dress. The CCPA seems to be arguing, in essence, that because design patents do not evince functionality, the subject matter does not pass to the public upon expiration like the subject matter of a utility patent.

The first argument that the CCPA makes in *Honeywell* is that the Supreme Court's precedent was concerned with trade dress protection for expired utility patents, whereas *Mogen* was concerned with trade dress protection for expired design patents and so was the case at hand. The CCPA seems to think that it was the functionality of the utility patents that caused the Supreme Court to create the right to copy doctrine. However, this reading of the Supreme Court's precedent in *Singer* and *Kellogg* is severely misguided. The Supreme Court made it abundantly clear in *Singer* that upon "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*."<sup>64</sup> The discussion of the right to copy doctrine in *Singer* does not even mention the functional nature of the expired patent. The dedication to the public is clear, unqualified, and completely irrespective of functionality. The doctrine as stated applies with equal force to design patents.

Furthermore, while the court in *Honeywell* is correct that the Supreme Court in *Kellogg* considered more than the design patent when ruling that there is a

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61. See, e.g., *In re Thorington*, 418 F.2d 528, 536 (C.C.P.A. 1969).

62. *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827, 833 (3d Cir. 1916) (ruling that a utility patent is evidence of a trademark's structural value); *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199–1200 (C.C.P.A. 1969) (holding that a utility patent uncontrovertibly established that a trademark is primarily functional); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340–41 (C.C.P.A. 1982).

63. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A. 1974).

64. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896) (emphasis added).

right to copy,<sup>65</sup> it was incorrect to assume that the lack of the other factors destroyed the right to copy. Again, the Supreme Court's language in *Kellogg* is clear. In fact, *Kellogg* quotes the language of *Singer*.<sup>66</sup> The court in *Honeywell* seems to imply that the most important factor was the fact that the patented machines could produce only the shredded wheat design also protected by the expired design patents.<sup>67</sup> However, there is no reason to believe that this factor is any more dispositive than the expired design patent factor; especially given that a theoretical machine that made shredded wheat with a shape different from the one covered by the design patent would likely infringe under the doctrine of equivalents.<sup>68</sup> There is nothing in the Supreme Court's decision to give the impression that it "relied heavily upon" this factor, as the court in *Honeywell* stated.<sup>69</sup>

The CCPA's attempt to differentiate between expired design and utility patents is illogical. As explained above, the CCPA in *Mogen* seems to have thought that the expired utility patent created the right to copy that prevented trade dress protection because of functionality. However, the subject matter of design patents is substantially closer to that of trade dress than the subject matter of utility patents is.<sup>70</sup> Therefore, if anything, an expired design patent should prevent trade dress protection more than an expired utility patent because the trade dress protection is more likely to extend a monopoly on the same subject matter.

The CCPA also asserted that the right of consumers to not be confused is more important than the right of the public to copy expired design patents.<sup>71</sup> However, this again ignores Supreme Court precedent. Had the Supreme Court believed this was true, the Supreme Court would have not held as they did in *Singer* and *Kellogg*. As explained above, in both *Singer* and *Kellogg*, the Supreme Court held that the right to copy prevented the product from being registered under trade dress law.<sup>72</sup> If the Supreme Court agreed with the rationale in *Honeywell*, the Supreme Court would have held in *Singer* and *Kellogg* that the right to not be confused trumped the right to copy. Clearly, this is not the case.

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65. See *Honeywell*, 497 F.2d. at 1348–49; *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119–20 (1938).

66. *Kellogg*, 305 U.S. at 120.

67. *Honeywell*, 497 F.2d at 1349.

68. See generally *Graver Tank & Mfg. Co., v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

69. *Honeywell*, 497 F.2d at 1349.

70. MPEP § 1512.11 (8th ed., Aug. 2011).

71. *Honeywell*, 497 F.2d at 1348.

72. See generally *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 112 (1938).

Finally, the flaws with the *Honeywell* decision are exacerbated by the fact that it was the CCPA that was ignoring, narrowing, and redefining Supreme Court precedent. The CCPA was in no position to ignore and question the Supreme Court like it did. Supreme Court precedent was binding on the CCPA, and the CCPA was obligated to apply Supreme Court precedent.<sup>73</sup> The CCPA should have given more deference to the clear and unambiguous language of the Supreme Court decisions.

### C. *The Return of the Right to Copy?*

The Tenth Circuit attempted to revitalize the right to copy doctrine by conducting possibly the most thorough analysis of relevant legal principles.<sup>74</sup> In *Vornado*, the Tenth Circuit was resolving whether a product configuration is entitled to trade dress protection when it was a significant inventive component of a utility patent.<sup>75</sup> In doing so, the Tenth Circuit: (1) analyzed Supreme Court precedent, including *Singer* and *Kellogg*, instead of ignoring it like the CCPA; (2) discussed the inability of the functionality doctrine to resolve this issue; and (3) weighed the competing purposes of patent and trademark law.

The Tenth Circuit's analysis of the Supreme Court precedent was similar to the discussion above. The conclusion was that the language of the Supreme Court precedent is clear and unambiguous. The expiration of a patent, utility or design, dedicates the invention to the public and creates a public right to copy that invention.<sup>76</sup> The right to copy does not depend on the functionality doctrine or whether the interfering statute was state or federal.<sup>77</sup> The right to copy exists upon the expiration of a patent, and the consumer's right to not be confused, whether from state or federal unfair competition laws, does not trump the right to copy.<sup>78</sup>

The functionality doctrine is inadequate because the availability of alternatives.<sup>79</sup> The availability of functionally equivalent alternatives to a product configuration that is the subject of an expired utility patent will remove the presumption of functionality with respect to the product configuration's ability to receive trade dress protection.<sup>80</sup> However, as demonstrated by *Vornado*, it is possible for a product configuration to "simultaneously be

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73. *Brenner v. Manson*, 383 U.S. 519, 527 (1966); *Flavor Corp. of Am. v. Kemin Indust., Inc.*, 493 F.2d 275, 280 (8th Cir. 1974) (citing 28 U.S.C. § 1256 (1948)).

74. *See Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995).

75. *Id.* at 1499.

76. *Id.* at 1504–05.

77. *Id.* at 1506.

78. *Id.* at 1504–05.

79. *Id.* at 1506–07.

80. *Id.* at 1507.

patentably useful, novel, and nonobvious and also nonfunctional, in trade dress parlance.”<sup>81</sup> Therefore, products covered by expired utility patents that have functionally equivalent alternatives can potentially be protected by trade dress protection after the expiration of the utility patent. This overlap is amplified when the expired patent is a design patent. An expired design patent creates a presumption that the design is primarily ornamental (i.e. valid) and not functional.<sup>82</sup> Therefore, products covered by expired design patents are more likely to qualify for indefinite trade dress protection.

Concluding that the functionality doctrine does not eliminate the overlap between patent and trademark law, the Tenth Circuit in *Vornado* discussed the competing goals of the bodies of law.<sup>83</sup> The three main purposes of patent law are (1) to foster and reward invention, (2) to promote the disclosure of inventions to stimulate further innovation, and (3) to add inventions to the public domain to be freely used after the expiration of patents.<sup>84</sup> The court noted here that the purposes of patent law are in stark contrast to the purposes served by the functionality doctrine; specifically, the functionality doctrine serves the purpose of ensuring that there are sufficient product configurations in the public domain to foster competition, and patent law is not concerned with competition.<sup>85</sup> Rather, “patents operate by temporarily reducing competition . . . to give the public the benefits of technological progress.”<sup>86</sup> The court also points out that trade dress protection directly interferes with the right to use inventions previously covered by now-expired utility patents.<sup>87</sup>

The core purpose of trademark law, and trade dress protection for product configurations, is to avoid consumer confusion as to the source of products.<sup>88</sup> However, the Tenth Circuit notes that it cannot be assumed that Congress “intended to be as expansive in its protection of product configurations as in its protection of traditional word or picture trademarks.”<sup>89</sup> The broad interpretation of product configuration trade dress protection under Section 43(a) of the Lanham Act is judicially created.<sup>90</sup> The court also notes that confusion based on product configuration is caused, in part, by the fact that

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81. *Id.* at 1506.

82. 35 U.S.C. § 171 (2006); *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002).

83. *Vornado*, 58 F.3d at 1507.

84. *Id.*

85. *Id.*

86. *Id.* at 1507–08.

87. *Id.* at 1508.

88. *Id.*

89. *Id.*

90. *Id.* at 1508–09.

consumers can rely on the product configuration as a source identifier, which is a result of trade dress protection in product configuration.<sup>91</sup> Consequently, if the source of a product could not have exclusive use of a product configuration, competitors would use the same or similar product configurations and consumers would learn to not rely on the product configuration as a source identifier.<sup>92</sup> After its discussion of the purpose of product configuration trade dress law, the Tenth Circuit concludes “that protecting against that degree of consumer confusion that may arise from the copying of configurations that are significant parts of patented inventions is, at best, a peripheral concern of section 43(a) of the Lanham Act.”<sup>93</sup>

Thus, the court held that

where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention, . . . so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional.<sup>94</sup>

In reaching this holding, the court discusses the competing interests of competitors using the product configuration. Specifically, the court notes that if it is true that a competitor does not need to use a product configuration to compete effectively in the market, it is even more true that the original user of the product configuration does not need to use the product configuration to identify its products.<sup>95</sup> The court stated that “[i]t would defy logic to assume that there are not almost always many more ways to identify a product than there are ways to make it.”<sup>96</sup>

While the Tenth Circuit does not specifically address design patents in *Vornado*, it stated that it need not “take a position on whether utility patents should be viewed differently than design patents[.]”<sup>97</sup> It makes sense to treat design patents and utility patents nearly identically, if not identically, because both stem from the same constitutional authority. In fact, it makes more sense to prevent the protection under trade dress of a configuration that was the subject of a design patent because, as explained above, design patent and trade dress protection on the same product are more likely to cover the same features.

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91. *Id.* at 1509.

92. *Id.*

93. *Id.*

94. *Id.* at 1510 (internal citation omitted).

95. *Id.* at 1509–10.

96. *Id.* at 1510.

97. *Id.* at 1503 n.11.

The same policy that the Tenth Circuit upheld in *Vornado*, and that was part of the Supreme Court jurisprudence from *Singer* until *Mogen*, should be readopted regarding patents generally, and design patents specifically. It should be self-evident that the constitutional declaration that patent law should promote the progress of science and the useful arts should trump the right of consumers to be protected from the potential confusion caused by competitors using similar trade dress; this is especially so given that, as explained in *Vornado*, confusion can be avoided by other forms of trademark protection such as branding and labeling. While many courts and others argue that trade dress does not extend a design patent monopoly because the two areas of law serve different purposes,<sup>98</sup> this argument is naïve; the fact that the laws are intended to serve a different purpose does not preclude the ability of the laws to overlap, and it does not preclude the ability of one body of law to interfere with the purpose of the other body of law. As explained above, even though trade dress and design patent laws serve different purposes, the two bodies of law have significant overlap. The fact that products can potentially receive both design patent and trade dress protection should be sufficient to rebut such a fleeting dismissal of the issue. It is not enough to simply assert that the two areas of law serve different purposes and not examine the consequences that the areas of law have for each other.

As explained above, the right to copy is a constitutionally created doctrine within patent law that the courts have been ignoring for over forty years. In function, design patents are not limited in time and do not promote the progress of the useful arts because it is possible to protect the design of a product indefinitely through design patent protection and subsequent trade dress protection. The next section of this Comment will discuss how the *TrafFix* decision, in an attempt to prevent the extension of utility patent protection through trade dress protection, actually re-entrenched the extension of design patent protection through trade dress protection.

### III. TRAFFIX DID NOT DO ENOUGH TO SAVE RIGHT TO COPY, BUT THERE IS HOPE

The Supreme Court in *TrafFix* had the opportunity to revisit and potentially reassert the right to copy doctrine in patent law. In front of the Court was a claim for trade dress infringement based on a copied dual-spring design that was the subject of an expired utility patent.<sup>99</sup> The Court explicitly avoided the

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98. See, e.g., *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 958–961 (S.D.N.Y. 1995); *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 604–05 (S.D.N.Y. 1996); *Topps Co., Inc. v. Gerrit J. Verburg Co.*, 1996 U.S. Dist. LEXIS 18556 (S.D.N.Y. 1996).

99. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 25–26 (2001).

right to copy issue when it declared that it need not resolve the question of whether the Patent Clause of the Constitution, of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection.<sup>100</sup> However, the Court specifically notes that the time to consider the matter will be a case “in which trade dress becomes the practical equivalent of an expired utility patent[.]”<sup>101</sup> The Court did not address whether a case in which trade dress becomes the practical equivalent of an expired design patent would be a time to consider the matter.

Instead of considering the right to copy, the Court made its determination based on functionality. Specifically, the Court held that an expired utility patent covering the design claimed to be covered by trade dress adds great weight to the statutory presumption that the design is functional and not protectable by trade dress.<sup>102</sup> The Court performed a thorough analysis of the convoluted trade dress functionality doctrine and concluded that *TrafFix* failed to carry its burden of demonstrating that the trade dress design was non-functional.<sup>103</sup>

Panduit wrote a Brief Amicus Curia in *TrafFix* urging the Court to reaffirm and follow its holding in *Singer* “and enunciate a bright-line rule that bars trade dress protection for ‘the thing formerly covered by the patent’ because, upon expiration of the patent, the right to make that thing ‘becomes public property.’”<sup>104</sup> Panduit was, at the time it authored the Brief Amicus Curia, a defendant in a similarly situated case.<sup>105</sup> Panduit was accused of infringing a product configuration trade dress covering the subject of an expired utility patent.<sup>106</sup> Panduit argued that the right to copy is founded in the Constitution, affirmed in *Singer*, and acts as an absolute bar to trade dress protection for products covered by expired utility patents.<sup>107</sup> Panduit also discusses the relevant case law that is discussed above.<sup>108</sup> The Court declined to rule on the issue presented by Panduit’s Brief, but the Court did explicitly address it.<sup>109</sup>

While the Court in *TrafFix* did not particularly hinder the right to copy doctrine with regards to utility patent protection, it caused more problems for the right to copy doctrine with regards to design patent protection. Courts since

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100. *Id.* at 35.

101. *Id.*

102. *Id.* at 29–30.

103. *Id.* at 32–35.

104. Brief Amicus Curiae of Panduit Corp. in Support of Petitioner at 2; *TrafFix Devices, Inc. v. Marketing Displays*, 532 U.S. 23 (2001) (No. 99-1571), 1999 U.S. Briefs 1571, at 2.

105. *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998).

106. *Id.* at 282.

107. Brief Amicus Curia of Panduit, *supra* note 104, at 3–10.

108. *Id.*

109. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35 (2001).

*TrafFix* have applied the discussion regarding the presumption of functionality from expired utility patents to create a presumption of non-functionality from expired design patents.<sup>110</sup> Even the United States addressed the consequences for design patents in its Brief Amicus Curia.<sup>111</sup> The United States specifically notes that “functionality analysis might not fully reconcile the scope of trade dress protection with patent-law right-to-copy principles . . . because the subject matter of design patents is, by definition, ornamental and non-functional.”<sup>112</sup> Because the subject of design patents is ornamental and non-functional, like product configuration trade dress, the functionality doctrine will not prevent the unwarranted extension of design patent protection through trade dress protection. Therefore, the discussion of the presumption of functionality because of an expired utility patent caused courts to interpret it as a presumption of non-functionality for expired design patents.

While the Court refused to address the issue in *TrafFix* with respect to utility patents and failed to address the issue with respect to design patents, its statement that the right to copy doctrine will need to be addressed when the functionality doctrine is not sufficient gives hope that the Court could reaffirm its ruling from *Singer*. Hopefully, the Court’s failure to state that it will need to address the matter in a case in which trade dress becomes the practical equivalent of an expired design patent was a simple omission and not an indication of the Court’s stance on the issue. If it is a simple omission, it is likely that the Court will at least consider the issue if such a case arises, and hopefully it will reaffirm the right to copy from *Singer*. Either way, it is clear that the Supreme Court’s reliance on the functionality doctrine will not be sufficient to prevent the unconstitutional extension of design patent protection through trade dress protection.

#### IV. TRADE DRESS UNCONSTITUTIONALLY EXTENDS DESIGN PATENTS

The extension of design patent protection through trade dress protection unconstitutionally interferes with the right to copy guaranteed by the Constitution. Furthermore, the right to copy should apply to designs that are unpatented but would otherwise qualify for design patent protection (ignoring the one-year statutory bar under 35 U.S.C. § 102(b)). Otherwise, the language of the Patent Clause in the Constitution is without effect. This is contrary to the purpose of the Constitution and violates canons of constitutional

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110. See, e.g., *Fuji Kogyo Co., Ltd. v. Pac. Bay Int’l, Inc.*, 461 F.3d 675, 683–684 (6th Cir. 2006); *Secalt S.A. v. Wuxi Shenxi Constr. Mach. Co., Ltd.*, 668 F.3d 677, 685 (9th Cir. 2012); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375 (Fed. Cir. 2012).

111. Brief for the United States as Amicus Curiae Supporting Petitioner, *TrafFix Devices, Inc. v. Marketing Displays Inc.*, 532 U.S. 23 (2001) (No. 99-1571), 1999 U.S. Briefs 1571 at 18–19.

112. *Id.* at 19 n.6 (internal citation omitted).

construction.

When a design patent expires, the new, original, and ornamental design previously covered by the design patent should be dedicated to the public. Trade dress protection on the subject matter of an expired design patent allows the owner of a design patent to protect the design indefinitely. This prevents the use of the subject of the expired design patent in any way that could conceivably be construed as infringing the trade dress. While it may not prevent all use of the design because the design could be used in a way that was not confusing and therefore not violative of trade dress protection, as explained above, the right to copy should be the right to copy the invention in all respects, not just in the respects that could not be construed as being confusing. Furthermore, the chilling effect that the trade dress protection would have and the ability of the owner to bully accused infringers expands the functional scope of the trade dress protection beyond products that actually infringe;<sup>113</sup> holders of the trade dress could assert in a Cease and Desist Letter or even a Complaint that a certain product infringes their trade dress, even when it is clear that it does not, to bully the accused infringer into ceasing.

The right to use a design should also apply to designs that are unpatented but otherwise patentable under 35 U.S.C. § 171 as a design patent. While the rule in *Sears* was based on the Supremacy Clause of the Constitution,<sup>114</sup> the logic still applies. In *Sears*, the Supreme Court held that a state may not protect a patentable but unpatented product though an alternative form of monopoly protection.<sup>115</sup> The Court reasoned that “the patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition.”<sup>116</sup> The Court held that a state cannot extend the life of a patent, give a patent on an article which did not qualify for federal patent protection, or give protection of a kind that clashes with the objectives of the federal patent laws.<sup>117</sup> While the Supremacy Clause cannot be used to invalidate federal laws,<sup>118</sup> the Constitution binds federal courts and Congress.<sup>119</sup> Therefore, the creation of trade dress law through legislation and common law must comport with the Constitution, including the Patent Clause. While the trade dress law is derived from traditional trademark law and

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113. Joe Wilcox, *Apple is a Patent Bully*, BETANEWS (Aug. 4, 2011), <http://betanews.com/2011/08/04/apple-is-a-patent-bully/>.

114. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230–31 (1964).

115. *Id.* at 231.

116. *Id.* at 230–31.

117. *Id.* at 231.

118. *See* U.S. CONST., art. VI, cl. 2.

119. *See, e.g., Carter v. Carter Coal Co.*, 298 U.S. 238, 291 (1936); *Cook v. Moffat & Curtis* 46 U.S. 295, 308 (1847); *Dixon v. State*, 224 Ind. 327, 341 (1946).

trademark law is derived from the Commerce Clause of the Constitution, trade dress law is substantially more attenuated from the explicit purpose of the Constitution than the right to copy expired patents. Clear and direct language supports the right to copy expired patents, but trade dress protection is based on an expansion of trademark law which is based on an expansion of Congress's power to regulate commerce among the several states.<sup>120</sup> Therefore, the right to copy should trump trade dress protection, especially given that the confusion that is arguably avoided by trade dress protection can be avoided by traditional trademark protection.<sup>121</sup>

If the public does not have the right to copy expired patents, including design patents, specific phrases from the Constitution would be left without effect. Specifically, the phrases “[t]o promote the Progress of Science and useful Arts” and “for limited Times” would functionally be without effect. With respect to design patents, allowing trade dress protection for expired design patents would give “for limited Times” no effect because, once the limited design patent monopoly expired, it would functionally be indefinitely extended by trade dress protection. As explained above, trade dress can cover nearly identical, if not identical, subject matter as design patents, and the same products are often covered by both. Therefore, the subject matter of a design patent can be protected forever after the design patent expires. Furthermore, allowing trade dress protection for expired design patents would give “[t]o promote the Progress of Science and useful Arts” no effect because, as explained above, this language is meant to allow free use of inventions once the limited monopoly of the patent expires. The purpose is provide the public with the ability to take inventions in the public domain to improve them and develop new inventions. The ability to protect inventions in the public domain with trade dress prevents the public from using and improving upon the public domain.

Interpreting the Constitution to give no effect to words is in direct contradiction with canons of constitutional interpretation.<sup>122</sup> The Supreme Court in *Marbury v. Madison* declared that “[i]t cannot be presumed that any clause in the constitution is intended to be without effect; and therefore such a construction is inadmissible, unless the words require it.”<sup>123</sup> Therefore, trade dress protection cannot be interpreted in a way that gives no effect to the language of the Constitution.

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120. See U.S. CONST., art. I, § 8, cl. 3; 15 U.S.C. § 1125 (2006).

121. *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1509–10 (10th Cir. 1995).

122. *Marbury v. Madison*, 5 U.S. 137, 174 (1803); *Noel Canning v. Nat'l Labor Relations Bd.*, 705 F.3d 490, 507 (D.C. Cir. 2013).

123. *Marbury*, 5 U.S. at 174.

## CONCLUSION

The Supreme Court has all but ignored the right to copy for the past forty or so years. The Constitution and early Supreme Court jurisprudence articulated the right to copy as an absolute right of the public to use, in all respects, the subject matter of expired patents, both design and utility. This right to copy barred the use of trade dress protection to extend expired patents. Since, courts have ignored this precedent and adopted a new jurisprudence that patent and trademark law serve different purposes, but the courts do not go beyond this bare assertion. The courts have failed to actually discuss the interaction of the two bodies of law to explain how the apparently different purposes mean the two do not interfere with each other in any way. This is likely because such an analysis would be impossible since it is clear that the two bodies of law do interfere with each other. In fact, design patent litigation often includes claims for trade dress infringement as well. This fact alone is reason to require courts to do more of an analysis than just assert that the laws serve different purposes. The Supreme Court should grant a writ of certiorari to a case that involves trade dress protection of an expired design patent, or rehear a case that involves the same, and it should reaffirm the bright-line rule from *Singer*. Only then will the Constitutional command that patent law promotes the progress of science and the useful arts through monopolies limited in time be realized, at least in this respect.

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