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## The Constitution Commandeth: Thou Shalt Not Protect the Same Subject Matter Under Design Patent and Trade Dress Laws

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**THE  
CONSTITUTION  
COMMANDETH:  
THOU SHALT NOT  
PROTECT THE  
SAME SUBJECT  
MATTER UNDER  
DESIGN PATENT  
AND TRADE  
DRESS LAWS**

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Kenneth B. Germain and Louis H. Sitler  
2022-2023



THE CONSTITUTION COMMANDETH: THOU  
SHALT NOT PROTECT THE SAME SUBJECT  
MATTER UNDER DESIGN PATENT AND TRADE  
DRESS LAWS<sup>1</sup>

By Kenneth B. Germain\* and Louis H. Sitler\*\*

*For many years and still currently, it has been assumed—and even expressly asserted—that it is perfectly permissible to “stack” various legal theories (concurrently or consecutively) to protect nonfunctional “designs” for products. This is despite infrequent but cogent arguments that the available theories, notably design patents and product design trade dress—both of which are based upon federal statutes—are not Constitutionally compatible due to at least the concept of Superfluity. The authors of this article carefully examine the origin, nature, and meaning of these two types of IP protections in the*

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\* Kenneth B. Germain (Of Counsel, Wood, Herron & Evans, LLP). Based in part upon professional lectures given by Mr. Germain including “An Unhurried Look At The Protectability/Preemption Of Trade Dress,” U.S. Patent and Trademark Office’s Annual Trademark Law Update Program (Arlington, Virginia; October 27, 1995); “*Resolved*: That U.S. Trademark Law Sometimes is Trumped By Patent and Copyright Law in Regard to Product Configuration Trade Dress,” International Trademark Association Advanced Symposium: “Evolution and Revolution in Trademark Law” (New York, New York; March 4-5, 1999); “The Interface and Conflict Between Utility Patents, Design Patents and Copyrights, On the One Hand, and Trademark/Trade Dress Rights, on the Other Hand,” Advanced Seminar on Trademark Law sponsored by Practising Law Institute (New York, NY; June 30, 2005); “Hapless Halloween: The Slaying of ‘Son of *TrafFix*’ (aka Considering the Constitutionality of Combining Product Design Trade Dress Protection and Design Patent Protection),” Faculty Colloquium at the University of Dayton School of Law (Dayton, Ohio; October 31, 2012); “Why the Constitution Disallows Dual Protection Under Design Patent and Trade Dress Regimes for the Same Subject Matter,” Wood Herron & Evans LLP (Cincinnati, OH; July 15, 2019); “THE CONSTITUTION COMMANDETH: Thou Shall Not Protect the Same Subject Matter Under Design Patent *and* Trade Dress Laws,” AIPLA Webinar Series, (December 10, 2019); “Does the Constitution Permit Dual Protection Under Design Patent and Trade Dress for the Same Subject Matter?,” Program in Law and Technology Seminar at the University of Dayton (Dayton, OH; June 11, 2021).

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*context of their two Constitutional bases—the Patent/Copyright Clause and the Commerce Clause—and conclude that, indeed, “stacked” protections are not Constitutionally permissible; the authors then recommend a workable solution which they dub, the “Kewanee Kompromise.”*

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**PREFACE** - by Kenneth B. Germain

About a decade ago, my expertise as a potential testimonial expert witness was engaged in connection with *Bobrick Washroom Equip., Inc. v. American Specialties, Inc.*<sup>2</sup> After careful study and analysis, I submitted three Expert Reports, one each regarding (1) Aesthetic Functionality, (2) Likelihood of Confusion, and (3) Unconstitutionality of Trade Dress Protection for Expired Design Patents. My conclusions on these three topics were as follows: (1) The “Convex Arc” design common to all of Plaintiff’s trade dress claims—based in part on “incontestable” trademark registrations—was unprotectable because this design was “functional,” not in a mechanical/useful way, but because it was “aesthetically functional” in that it “serves as an attractive, upscale, design that competitors (including Defendant) should be allowed to approximate—even to ‘copy’—so that commercial buyers will have access to multiple sources of this attractive, upscale design.” (2) Assuming, *arguendo*, that Plaintiff’s design actually was protectable, I concluded that, applying the relevant (*Sleekcraft*) factors—as much as possible based on the then-incomplete factual record—there was no sufficient and satisfactory basis on which to find “likelihood of confusion” actionable under the Lanham Act. (3) Continuing to assume, again *arguendo*, that Plaintiff’s design actually was protectable and also that Plaintiff could establish likelihood of confusion with Defendant’s (very similar) design, I concluded as follows:

The act of acquiring the design patents on the Convex Arc effectively and permanently precluded protection of the covered feature(s) under federal trade dress law (including Lanham Act § 32, for registered marks, and § 43(a), for unregistered marks) and/or under any/all state law doctrines. This results from the preemptive effects of the Patent/Copyright Clause of the U.S. Constitution and the Supremacy Clause of the U.S. Constitution.

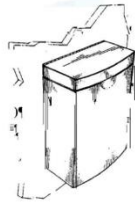
Because (1) and (2) are not relevant to this article, only (3) will be discussed now. As I recall, both parties were major players in the restroom accessory design/manufacturing business, specifically including such devices as stainless-steel paper towel dispensers and sanitary napkins disposal receptacles. Plaintiff (Bobrick) had obtained more than 15 design patents—among them U.S. Des. Pat. No. 332,894 and U.S. Des. Pat. No. 342,175, displayed below next to each respective verbal claim. These two design patents (plus the others for the same design, for similar products) had run their course (then 14 years) and expired.

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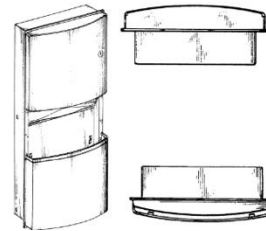
<sup>2</sup> No. CV 10-6938-SVW (PLAx), 2010 U.S. Dist. LEXIS 147813 (C.D. Cal. Dec. 15, 2010).

**Design Patent No. 332,894**

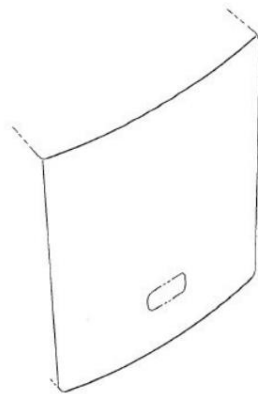
Claim  
 “The ornamental design for a napkin disposal, as shown and described.”

**Design Patent No. 342,175**

Claim  
 The ornamental design for a towel dispenser with waste receptacle, as shown and described.



However, their owner, Bobrick, also obtained a trademark registration, U.S. Trademark Reg. No. 2, 951,014, for this line of products, shown below next to the Identification of Goods:

**U.S. Trademark Reg. No. 2,951,014**

“The mark consists of the shape of the front face of a washroom product, the front face having a convex ‘arc’ shape as viewed from above. The height of the front face is exemplary only and can be taller or shorter depending on the product. . .”

And this registration had, in time, attained “incontestable” status per the Lanham Act.<sup>3</sup> This registration—plus parallel common law principles—provided the basis for the *Bobrick v. ASI* lawsuit. (By the way, Bobrick’s line of “Convex Arc” products was marketed under the word mark CONTURA, whereas, ASI’s very similarly-designed and directly-competing products were marketed as ROVAL).

The case was decided in favor of Defendant (ASI) on a totally separate basis, namely, *utilitarian* functionality.<sup>4</sup> Thus, none of my three raised-and-

<sup>3</sup> § 15, 15 U.S.C. § 1065.

<sup>4</sup> *Cf. Bobrick Washroom Equip., Inc. v. Am. Specialties, Inc.*, No. CV 10-6938 SVW (PLA), 2012 U.S. Dist. LEXIS 111465 (C.D. Cal. Aug. 8, 2012). This opinion contained a



resolved issues was mentioned by the court. Relevant to the current article, my unconstitutionality thesis was not probed at all.

But, query, what would have happened if the court had avoided utilitarian functionality, and then disagreed with my aesthetic functionality and likelihood of confusion conclusions? In that scenario—not one that I’d consider outside the realm of possibility—how would the court have handled my back-up unconstitutionality thesis? Admittedly, the District Court might have elected to elude this last-ditch argument and, even if it “needed” to deal with it, sought every possible way to avoid making groundbreaking law on such an unchartered basis! But that does not resolve an issue that could be critical to another case...

Fast forward about ten years with me now working in tandem with Lou Sitler (one of my former trademark law students and now an associate at the same firm). With the passage of time, surprisingly, the protectionist environment in the IP practice field has not changed at all, as it remains

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comprehensive albeit somewhat unconvincing analysis of the utilitarian functionality defense that actually won the day. Ostensibly following *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), but really relying upon the earlier (and thus somewhat less authoritative) *Disc Golf Ass’n v. Champion Discs, Inc.*, 158 F.3d 1002 (9th Cir. 1998) case, the *Bobrick* court expressly considered four relevant factors (including “alternative designs”). *Bobrick*, 2012 U.S. Dist. LEXIS 111465 at \*18. Notably, the judge stated that a design could be deemed functional as long as “some utilitarian advantage” could be identified. *Id.* at \*19; *see also id.* at \*22. This broad standard gave an immediate benefit to Defendant. Next, the court weighed the effect of a few advertising claims made by Plaintiff early-on; these claims stated that the new “convex arc” design was “stronger and stiffer” and “more impact-resistant” than pre-existing designs. *Id.* at \*21-22; *see also id.* at \*28-29. The judge viewed these bits of advertising copy as proof that Plaintiff had “touted” functional characteristics of its new design. But the judge was unmoved by direct testimony from Plaintiff’s VP of Marketing candidly admitting that Plaintiff really had had no factual basis for these claims and, indeed, removed them from its advertising soon after it learned that they were not validated by testing. *See id.* at \*29-30. Further, the judge discounted expert testimony that any augmentations of strength and/or durability needed to be put into perspective by considering particular angles, etc., of stress. *Id.* at \*22. Not to be overlooked, in a brief Order, the Ninth Circuit affirmed, stating:

The district court . . . properly identified and evaluated the factors enumerated in *Disc Golf Ass’n v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998), and concluded that both *Bobrick*’s registered trademark and alleged unregistered trade dress were functional. These factual findings of functionality were supported by ample evidence, including expert testimony presented by ASI and an advertisement from *Bobrick* documenting the functionality of the product. The district court correctly viewed the *Bobrick* product design as a whole, and did not base its determination merely on the conclusion that the component parts of the *Contura* Series were functional.

*Bobrick Washroom Equip., Inc. v. Am. Specialties, Inc.*, 565 Fed. Appx. 660, 661 (9th Cir. 2014) (citations omitted).

common to stack types of protection for non-functional product features (designs, configurations, color-combinations, etc.). Indeed, it remains common for veteran, high-profile practitioners to openly tout the availability and favorability of using more than one type of IP for the same product design—consecutively and/or concurrently.<sup>5</sup> The written materials for the cited webinar—probably provided to me by one of the authors (two of whom are decades-old friends and respected colleagues of mine)—unabashedly impliedly and sometimes expressly assume that there is absolutely no reason why more than one of these three IP protections cannot be used for the very same “design.” A few specifics:

Mr. Litowitz relies on the age-old success of Coca Cola in first getting a design patent on its classic little-bottle shape, followed by later getting a trademark registration for the same (or highly similar) shape.<sup>6</sup> He also positively references *Lanard Toys, Ltd. v. Dolgencorp LLC*,<sup>7</sup> one of a few modern appellate cases that seems to be comfortable with double protection.<sup>8</sup>

Ms. Jacobs-Meadway, whose slide set is entitled “Copyright Law as an Alternative” (doubtlessly in relation to other protections for non-functional designs), includes phrases such as “Nothing precludes claims for trademark/trade dress,” “Jewelry designs are subject to copyright protection as well as trade dress protection . . .,” and “Furniture designs may be subject to copyright as well as trade dress and design patent rights.”<sup>9</sup>

And it’s not like these commentators are outliers of any type!

It continues to amaze me that so few—maybe none at all—recent cases mention, let alone decide, whether the overall Constitution-based IP scheme prohibits the duplicate (possibly triplicate) protections so blithely recommended by leading lawyers such as Litowitz, Wilkes, and Jacobs-Meadway. And this, despite my numerous public protestations to the contrary for decades!<sup>10</sup>

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<sup>5</sup> See, e.g., Robert Litowitz, Meredith Wilkes & Roberta Jacobs-Meadway, *Trade Dress, Design Patent, and Copyright: Strategies to Maximize Protection, Challenge and Defeat Infringement* Strafford (Nov. 12, 2020) [<https://perma.cc/AR3F-DZ4X>].

<sup>6</sup> *Id.* at slide 14.

<sup>7</sup> 958 F.3d 1337 (Fed. Cir. 2020).

<sup>8</sup> Litowitz, Wilkes & Jacobs-Meadway, *supra* note 5 at slide 45.

<sup>9</sup> *Id.* at slides 71, 78, and 79.

<sup>10</sup> See Germain, *supra* note \*.

The instant article grapples with this conundrum, explicating and examining the caselaw (which largely, but not entirely, supports the views Lou and I now eschew), exploring the carefully calibrated views of academics (largely siding with our views), and practitioners (whose views usually just “assume” overlapping is acceptable). It recommends a resolution (overlap *not* permitted) and a solution (the so-called Kewanee Kompromise); it also posits why the practicing bar has not taken up this defense-oriented challenge in litigation.

## I. INTRODUCTION

The founders of this country, over two hundred years ago, recognized that invention is necessary to make America a strong economic power.<sup>11</sup> Accordingly, the founders granted Congress the power to enact patent and copyright laws pursuant to Article I, Section 8, Clause 8 of the Constitution.<sup>12</sup> From the beginning, the Supreme Court recognized this Clause as creating a right to copy. This Clause, which is often referred to as the “Patent and Copyright Clause,”<sup>13</sup> recites:

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<sup>11</sup> Both Benjamin Franklin and Thomas Jefferson were noted inventors themselves. Jefferson was a moving force behind the Convention’s recognition of the importance of encouraging invention, and was the author of the 1793 Patent Act. *See* *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 7-9 (1966).

<sup>12</sup> *See* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 228-29 (1964).

<sup>13</sup> For purposes of brevity, the Patent and Copyright Clause will be referred to herein as the “Patent Clause.” The authors note that dubbing this clause “the Intellectual Property Clause” (or, for short, “the IP clause”) is misleading. There is *no* doubt that this Clause *only* embraces patents and copyrights; such other types of “intellectual property” as trade secrets and trademarks certainly are *not* included. Thus, other authors who employ “IP Clause” references are misspeaking. *See* Theodore H. Davis Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN L. REV. 595, 605-06 (1996); Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 CALIF. L. REV. 241, 265 (1998). One commentator, Professor Pollack, notes, and the authors agree, that the terms Patent Clause or Intellectual Property Clause “both use[] words not in the text and incorrectly implies the primacy of rights granted patent and copyright holders.” Malla Pollack, *What Is Congress Supposed to Promote?: Defining “Progress” in Article I, Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause*, 80 NEB. L. REV., 755, n.1 (2001). Professor Pollack concludes that the best name for the Clause is the “Progress Clause.” *Id.*

The Congress shall have power . . . To 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>14</sup>

The two phrases in the Progress Clause 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 on the inventions in expired patents and stimulate new invention.<sup>15</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 never returned, the patent monopoly would not be limited in time.<sup>16</sup>

When asked to balance the concerns of patent law against those of unfair competition law with respect to the copying of product designs, the Supreme Court has ruled repeatedly over the years that the right to copy must prevail.<sup>17</sup> The Court established the policies of patent law in a series of decisions analyzing the conflict between the federal patent laws and state laws. In deciding these early cases, the Supreme Court spoke in terms of the public rights guaranteed by the patent laws.<sup>18</sup> These decisions discuss whether the patent laws conflict with and therefore “preempt” state laws under the Supremacy Clause.<sup>19</sup> Specifically, the Court found a public right in the subject matter of expired patents and focused its analyses on whether or not the common law doctrine in question usurped this public right.<sup>20</sup>

<sup>14</sup> U.S. Const. art. I, § 8, cl. 8. (*In re Bergy* points out that this is really two clauses in one: the Copyright Clause and the Patent Clause. See *In re Bergy*, 596 F.2d 952, 958 (C.C.P.A. 1979)).

<sup>15</sup> *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974).

<sup>16</sup> *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.

<sup>17</sup> See *Bonito Boats*, 489 U.S. at 167-68; *Sears*, 376 U.S. at 232-33; *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 235, 238 (1964); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 119-22 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

<sup>18</sup> Otherwise referred to as the right to copy doctrine or the public bargain doctrine. *Id.*

<sup>19</sup> Article VI, Clause 2 of the Constitution, often referred to as the “Supremacy Clause,” provides that

[t]his Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

U.S. Const. art. VI, cl. 2.

<sup>20</sup> Robert G. Bone, *In Trademark Functionality Reexamined*, 7 J. LEG. ANALYSIS 183, 185-86 (2015). Professor Bone introduced and advocated the unusual idea that there is no “right

## II. THE PUBLIC'S RIGHT TO COPY

In as early as 1896, in *Singer Mfg. Co. v. June Mfg. Co.*, the Supreme Court set the foundation for the concept that, in return for granting a patent, the public receives the right to copy the patented invention upon the expiration of the patent term.<sup>21</sup> In this case, the Court permitted copying of SINGER sewing machines' mechanical features after their patents had expired.<sup>22</sup> The Singer company owned a portfolio of utility patents for its SINGER sewing machines, which represented a general product line of sewing machines. The Court recognized that, by having patents and thus a monopoly for the SINGER machine, "none of the machines as a whole were open to public competition."<sup>23</sup> The Court further recognized that this monopoly was only for specific durations, stating, "[w]hen these patents expired every one had an equal right to make and vend such machines."<sup>24</sup> The Court explained: "[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."<sup>25</sup> Thus, in holding that the newcomer

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to copy" per se, but merely a strong pro-copying policy that must be weighed along with other factors:

Section 5 . . . focuses on the right to copy product features not protected by patent or copyright, and argues that this right is in fact no right at all, but rather a policy to be balanced with others in the social welfare calculus. This policy has value because it promotes competition in the product market, facilitates downstream innovation, and channels patentable inventions to the patent system. It follows that the social benefits of allowing free copying of product features should depend on the extent to which copying promotes these three goals, and it also follows that those benefits must be balanced against the costs of denying trademark protection measured in terms of consumer confusion and resulting harm.

*Id.* He explains his thesis in detail, *id.* at 218-21, reaching this conclusion:

[T]he so-called right to copy should not be treated as a utility-constraining right capable of cutting off trademark protection by its own force. It makes sense only as a statement of policy, and as a policy it must be balanced against the Lanham Act's policy of preventing consumer confusion.

*Id.* at 221 (footnote omitted). Aside from running totally counter to the long-held views of the senior author of the current article—to the effect that "the rule" is free and open competition (provided that it is fair), with specific "exceptions" being limited to carefully-drawn and usually narrowly interpreted, mostly legislation-based protections—it is worth noting that an examination of scholarly articles in the roughly five years since publication of the Bone article, *no* adherents to his view have appeared.

<sup>21</sup> *See Singer*, 163 U.S. at 185-86.

<sup>22</sup> *Id.* at 185-202.

<sup>23</sup> *Id.* at 179.

<sup>24</sup> *Id.* at 189.

<sup>25</sup> The Court further explained, with respect to the trademark:

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. . . .

had a right to copy SINGER sewing machines, the Court's attitude towards monopolies created by the "Patent Clause" was that, upon termination of the monopoly, the public has a right to copy that which had been protected by the monopoly (i.e., by the patent), and any means by which this right is disregarded as improper. This holding set the stage for the public bargain doctrine.

Four decades later, the Supreme Court reached a similar conclusion in *Kellogg Co. v. Nat'l Biscuit Co.*<sup>26</sup> Applying the law of unfair competition, the Court held that it was *not* unfair competition for Kellogg Co. to copy National Biscuit Co.'s pillow-shaped shredded wheat biscuit after invalidation of the *design* patent for the biscuit shape and expiration of the utility patents for the machines that make it.<sup>27</sup> More particularly, the Court stated, "a design patent was taken out to cover the pillow-shaped form," and "upon expiration of the patents the form, as well as the name, was dedicated to the public."<sup>28</sup> The *Kellogg* Court reinforced the right to copy precedent of *Singer*, stating:

Where an article may be manufactured by all, a particular manufacturer can no more assert exclusive rights in a form in which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than a particular producer, than it can in the case of a name with similar connections in the public mind.<sup>29</sup>

Again, it remains clear that the Supreme Court interpreted the "Patent Clause" as providing the public with an inherent right to copy that which had been suspended by the patent monopoly, and that any means used by the original patent holder to assert exclusive rights over the product beyond the expiration of the monopoly would be improper. In this regard, the Patent Clause may mandate the public bargain, being the "quid pro quo arrangement," in itself because dedication of patented inventions to the public

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To say otherwise would be to hold that although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly. In other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that at its termination the monopoly should cease, and yet when the end was reached disregard the public dedication and practically perpetuate indefinitely an exclusive right.

*Id.* at 185-86.

<sup>26</sup> 305 U.S. 111 (1938).

<sup>27</sup> *See id.* at 119-22 (Kellogg had made reasonable efforts to distinguish its product by using a different carton, label, company name, and biscuit size).

<sup>28</sup> *Id.* at 119-20.

<sup>29</sup> *Id.* at 120.

domain is an important way that the patent law “promote[s] the progress of . . . useful Arts.”<sup>30</sup>

Perhaps the strongest statement of the public bargain doctrine can be found in the Supreme Court’s decision in *Scott Paper Co. v. Marcalus Mfg. Co.*:

By the force of the patent laws not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby becomes entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. Hence *we have held that the patentee may not exclude the public from participating in that good will or secure, to any extent, a continuation of his monopoly by resorting to the trademark law and registering as a trademark any particular descriptive matter appearing in the specifications, drawings or claims of the expired patent, whether or not such matter describes essential elements of the invention or claims.*<sup>31</sup>

In this case, the defendant was charged with infringing a patent that it had assigned to the plaintiff.<sup>32</sup> The issue was whether the assignor was estopped, by virtue of his assignment of his rights to the patent, from arguing that the expired patent covered his allegedly infringing device.<sup>33</sup> The Court found that the assignor was not estopped, reasoning that application of the doctrine of estoppel under these circumstances would be inconsistent with the public bargain rule that the subject matter of expired patents is dedicated to the public.<sup>34</sup> In so holding, the Court decreed:

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<sup>30</sup> Kevin E. Mohr, *At the Interface of Patent and Trademark Law: Should a Product Configuration Disclosed in a Utility Patent Ever Qualify for Trade Dress Protection*, 19 HASTINGS COMM. & ENT. L.J. 339, 348 (1996), explaining that:

The Patent Clause and statutes passed pursuant to it were intended to create a *bargain* between society and the inventor, a straightforward *quid pro quo* arrangement in which the government would grant to inventors a limited-duration monopoly allowing them to exploit their inventions without fear of competition. In return, the inventor was obliged to disclose to the public precisely how the invention worked, so that others could improve upon it and make further advances in the relevant technology. Thus, the inventor’s disclosure was to be the consideration that would support the government’s grant of patent rights; only if properly disclosed would the invention be available for use, thus allowing society to benefit from its bargain. Further, once the patent term expired, the invention would enter the public domain and become available for the public to use and copy freely.

*Id.*

<sup>31</sup> 326 U.S. 249, 256 (1945) (emphasis added).

<sup>32</sup> *Id.* At 251.

<sup>33</sup> *Id.* At 250.

<sup>34</sup> *Id.* At 257-58.

The public has invested in such free use by the grant of a monopoly to the patentee for a limited time. Hence any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal device employed, runs counter to the policy and purpose of the patent laws.<sup>35</sup>

Thus, once the subject of an expired patent has entered the public domain, the rights in it cannot be subject to private barter, sale, or waiver.<sup>36</sup>

Another indication of the Supreme Court's concern regarding patent-based monopolies was evidenced by *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*.<sup>37</sup> In this case, the Court held that an alleged patent infringer can use *res judicata* and collateral estoppel to foreclose an infringement suit where the patent claim in question had already been declared invalid in an earlier, albeit unrelated lawsuit.<sup>38</sup> In so holding, the Court stated, so long as "a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case," a plea of estoppel may later be raised to defend "a charge of infringement of a patent that has once been declared invalid."<sup>39</sup> Significantly, this defense may be raised by any accused infringer and there is no requirement that the accused infringer be involved in the previous litigation.

As a result of the holding in *Blonder-Tongue*, reinforcing the Court's continuing concern regarding patent-based monopolies,<sup>40</sup> it is apparent that the Court recognized that patent litigation is an important public tool that has

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<sup>35</sup> *Id.* At 256.

<sup>36</sup> The successful Petitioners in *Traffix Devices, Inc. v. Marketing Displays, Inc.* explain this concept in their brief:

Those decisions [*Singer, Kellogg, and Scott Paper*] shaped the common law that Congress sought to codify in the Lanham Act and, in particular, defined the outer limit of that law in the case of patented inventions. In codifying that law, the presumption is that Congress sought to bring the *Singer* rule with it.

Brief for Petitioner at 28, *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 S.Ct. 1255 (2001) (No. 99-1571), 2000 WL 35796342, at 28.

<sup>37</sup> 402 U.S. 313 (1971).

<sup>38</sup> *See id.* at 350.

<sup>39</sup> *Id.* at 333, 350.

<sup>40</sup> *But see infra* note 88 (noting that some patent practitioners and academics do not view a patent as creating a monopoly; rather, they argue that patents merely provide the owner with negative rights). *See e.g.*, Adam Mossoff, *Exclusion and Exclusive Use in Patent Law*, 22 HARV. J.L. & TECH. 321 (2009); *see also What Rights Will a Patent Give to Me?*, RICHARDS PATENT LAW (Oct. 12, 2021) [<https://perma.cc/UKH5-283P>]. However, many sources use the term "monopoly" without reservation. *See e.g.*, Moshe H. Bonder, *Patent & Lanham Acts: Serving Two Legitimate Purposes or Providing an Indefinite Monopoly?*, 15 ALB. L.J. SCI. & TECH. 1 (2004).



the potential to minimize monopolies and open markets, benefitting not just the prevailing party in a given suit, but also benefitting competitors and consumers throughout the economy. Specifically, “[t]his view is deeply intuitive and has been the basis for a number of judicial and legislative enactments to increase the number of patent challenges brought to fruition.”<sup>41</sup> Moreover:

By 1971, the Court had consciously recognized a line of decisions aimed at “encouraging authoritative testing of patent validity,” and, in more recent years, has continued to root decisions in the ‘strong public interest’ found in the adjudication of patent rights. Following this doctrine, a number of courts have refused to enforce—and declared federally preempted—otherwise-valid contracts that might impair a party’s incentives or ability to bring a patent challenge.<sup>42</sup>

Although decided before *Blonder-Tongue*, the case of *Lear v. Adkins*<sup>43</sup> is illustrative in this regard. The issue in front of the Court in *Lear* was whether patent licensees are permitted to challenge the validity of an underlying patent, specifically in a suit for unpaid royalty payments.<sup>44</sup> The Court held that patent licensees are permitted to challenge the validity of the underlying patent.<sup>45</sup> In its opinion the Court explained that, “we granted certiorari in the present case . . . to reconsider the validity of the . . . rule in the light of our recent decisions emphasizing the strong federal policy favoring free competition in ideas which do not merit patent protection.”<sup>46</sup> The Court elucidated its holding by stating, “[t]he national policy expressed in the patent laws, favoring free competition and narrowly limiting

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<sup>41</sup> Stephen Yelderman, *Do Patent Challenges Increase Competition?*, 83 U. CHI. L. REV. 1943, 1946 (2016).

<sup>42</sup> *Id.* (citing *Lear, Inc. v. Adkins*, 395 U.S. 653, 674-75 (1969); *Warner-Jenkinson Co. v. Allied Chem. Corp.*, 567 F.2d 184, 188 (2d Cir. 1977); *Atlas Chem. Indus., Inc. v. Moraine Prods.*, 509 F.2d 1, 6 (6th Cir. 1974); *Panther Pumps & Equip. Co. v. Hydrocraft, Inc.*, 468 F.2d 225, 230-32 (7th Cir. 1972); *Massillon-Cleveland-Akron Sign Co. v. Golden State Advert. Co.*, 444 F.2d 425, 427 (9th Cir. 1971). *See also* *Edward Katzinger Co. v. Chi. Metallic Mfg. Co.*, 329 U.S. 394, 401-02 (1947) (holding that a party is not estopped from challenging a patent’s validity despite a contractual covenant to refrain from doing so); *Beckman Instruments, Inc. v. Tech. Dev. Corp.*, 433 F.2d 55, 62 (7th Cir. 1970), *abrogated by* Act of Aug. 27, 1982, Pub. L. No. 97-247, § 17, 96 Stat. 317, 322 (refusing to enforce an arbitration provision for a patent validity claim)).

<sup>43</sup> 395 U.S. 653 (1969).

<sup>44</sup> *Id.* at 655-56.

<sup>45</sup> *Id.* at 676.

<sup>46</sup> *Id.* at 656 (citing *Sears, Roebuck v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)).

monopoly, cannot be frustrated by private agreements among individuals, with or without the approval of the State.”<sup>47</sup>

### III. FEDERAL PREEMPTION LINE OF CASES

Most of the above-discussed cases set forth a federal policy of freedom to use product features that had been restricted only by the limited monopoly deemed necessary to “promote the progress of science and useful arts.” These policy standpoints further align with the landmark cases of *Sears, Roebuck & Co. v. Stiffel Co.*<sup>48</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>49</sup> wherein the Supreme Court held that certain state unfair competition laws were preempted by federal law. In doing so, the Court confirmed the principle that a state may not prohibit copying something that the federal government had left in the public domain, freely to be copied by all, thereby reaffirming the right to copy doctrine.

In *Sears*, the senior party had obtained design and utility patents on a “pole lamp—a vertical tube having lamp fixtures along the outside, the tube being made so that it will stand upright between the floor and ceiling of a room.”<sup>50</sup> Subsequently, the junior party sold a “pole lamp” virtually identical to the one produced by the senior party, at a substantially lower price.<sup>51</sup> The senior party then brought suit claiming, first, that the junior party had infringed the senior party’s patents and, second, that by selling the pole lamps, Sears had created confusion about the source of the lamps and thus had engaged in unfair competition under Illinois law.<sup>52</sup> Reversing the Seventh Circuit, the Supreme Court held that Illinois’ unfair competition law was incompatible with federal patent law, and therefore unconstitutional.<sup>53</sup> In so holding, the Court explained:

An unpatentable 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. What Sears did was to copy Stiffel’s design and to sell lamps almost identical to those sold by Stiffel. This it had every right to do under the federal patent

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<sup>47</sup> *Id.* at 677.

<sup>48</sup> 376 U.S. 225 (1964).

<sup>49</sup> *Id.* at 234 (1964).

<sup>50</sup> *Id.* at 225-26 (internal quotations omitted).

<sup>51</sup> *Id.* at 226.

<sup>52</sup> *Id.* at 226. The District Court held that the allegedly infringed patents were invalid. *Id.*

<sup>53</sup> *Id.* at 227-28.

laws. . . . Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested. . . .

[W]hile federal law grants only 14 or 17 years' protection to genuine inventions . . . States could allow perpetual protection to articles too lacking in novelty to merit any patent at all under federal constitutional standards. This would be too great an encroachment on the federal patent system to be tolerated.<sup>54</sup>

While the “pole lamp” in *Sears* was found to be an “unpatentable article”<sup>55</sup> (i.e., one not meeting the requirements for patentability), the Court made clear that, for any article deserving and acquiring patent protection, “when the patent expires the monopoly created by it expires, too, and the right to make the article—including the right to make it in precisely the shape it carried when patented—passes to the public.”<sup>56</sup>

The Court further stated that the Supremacy Clause of the United States Constitution prohibits states from “extend[ing] the life of a patent beyond its expiration date or giv[ing] a patent on an article which lacked the level of invention required for federal patents.”<sup>57</sup> The Court found that to do so “would run counter to the policy of Congress of granting patents *only* to true inventions, and then *only* for a limited time.”<sup>58</sup> The Court emphasized that “[j]ust as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws.”<sup>59</sup>

The second case, *Compco*, involved a similar set of facts as in *Sears*. The article at issue in *Compco*, a light reflector, previously had been protected by a design patent held by the senior party.<sup>60</sup> The junior party had been held liable for unfair competition under Illinois law for having copied the light reflector.<sup>61</sup> The Supreme Court took a step further and opined that the unconstitutionality of the state law does not result only from its conflict with

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<sup>54</sup> *Id.* at 231-32 (internal citation omitted).

<sup>55</sup> *Id.* at 231.

<sup>56</sup> *Id.* at 230 (internal citations omitted).

<sup>57</sup> *Id.* at 231.

<sup>58</sup> *Id.* (emphasis added).

<sup>59</sup> *Id.*

<sup>60</sup> *See* 376 U.S. 234 (1964). The District Court held that the design patent was invalid. *Id.* at 235.

<sup>61</sup> *Id.* at 234-35.

federal patent policy by virtue of the Supremacy Clause,<sup>62</sup> but also due to its collision with the limitations set forth in the Patent Clause itself, which provides for time-limited property rights on novel intangible subject matter.<sup>63</sup>

The Supreme Court is not alone in concluding that the time-limited property rights guaranteed by the Patent Clause cannot be overridden by state laws. Scholars also have commented on such conflicts with the absolute time limits for patents as established by Congress and commanded by the Patent Clause.<sup>64</sup> As explained by a noted design patent specialist, Perry Saidman:

[T]he subject matter of an expired patent enters the public domain, and the public has a right to copy it. Any attempt to claim...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.<sup>65</sup>

During the next two decades, the Supreme Court may have seemed to move away from the strict views it had embraced in *Sears* and *Compco*.<sup>66</sup> However, in 1989, the Court returned to the basic rationale of *Sears* and *Compco* in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*<sup>67</sup> In

<sup>62</sup> See *supra* note 6.

<sup>63</sup> *Id.* at 237-38.

<sup>64</sup> See Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond A Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259, 274 (1995), explaining that:

Seemingly, if a separate constitutional phrase (1) includes a limit by negative implication, and (2) this limit has not been interpreted out of the clause, Congress cannot by pass the limit through the Commerce Clause. As discussed immediately below, the "limited times" provision in the Intellectual Property Clause fills these requirements.

See also Anthony E. Dowell, *Trade Dress Protection of Product Designs: Stifling the Progress of Science and the Useful Arts for an Unlimited Time*, 70 NOTRE DAME L. REV. 137, 168 (1994), explaining that:

[T]he Patent Clause limits Congress's power to grant monopolies. Congress may grant monopolies only for a limited time...the right to copy unpatented inventions is rooted in the Patent Clause. Accordingly, the federal trademark and unfair competition law may conflict with not only the coequal patent laws but also the Constitution.

<sup>65</sup> Perry J. Saidman, *Kan Traffix Kops Katch the Karavan Kopy Kats? or Beyond Functionality: Design Patents are the Key to Unlocking the Trade Dress/Patent Conundrum*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 839 (2000).

<sup>66</sup> See *Goldstein v. California*, 412 U.S. 546, 571 (1973) (analyzing the preemptive effects of the federal copyright laws and upholding a state law prohibiting sound recordings); see also *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 491 (1974) (finding no preemption of state trade secret law by patent law).

<sup>67</sup> 489 U.S. 141 (1989).

that case, the Court revisited and reaffirmed the basic principle that “after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law.”<sup>68</sup> The Court again addressed a state’s interference in the field of patent law, and struck down a state statute prohibiting the use of a direct-molding process to closely copy unpatented boat hulls. The Court’s decision is consistent with the *Sears/Compco* doctrine and reaffirmed the public’s right to copy.

In *Bonito Boats*, the senior party developed a hull design for a fiberglass recreational boat which was very favorably received by the boating market.<sup>69</sup> However, that party never filed a patent application to protect its design under federal patent laws. The junior party allegedly used the senior party’s hull, which was publicly available, in a direct molding process to duplicate its design and then sell the duplicates. The senior party sued the junior party pursuant to the state “plug molding” statute which made it “unlawful to use the direct molding process to duplicate for the purpose of sale any manufactured vessel.”<sup>70</sup> The critical issue for the Supreme Court was whether the federal patent statute preempted the state “plug molding” statute.<sup>71</sup>

The Court held that the state statute was preempted, explaining that “the ultimate goal of the patent system is to bring new designs and technologies into the public domain.”<sup>72</sup> Thus, state law protection for techniques and designs that are already disclosed in the marketplace may conflict with the very purpose of patent laws by decreasing the range of ideas and depriving society of “the building blocks of further innovation.”<sup>73</sup> Moreover, “state regulation of intellectual property,” the Court noted, “must yield to the extent that it clashes with the balance struck by Congress in our patent laws.”<sup>74</sup> Once “the public has paid the congressionally mandated price for disclosure” of the invention, “the States may not render the exchange fruitless by offering patent-like protection to the subject matter of the expired patent.”<sup>75</sup> Once the patent monopoly has expired, “the thing formerly covered by the patent

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<sup>68</sup> *Bonito Boats, Inc.*, 489 U.S. at 152 (citing *Kellogg* and *Singer*). The *Bonito Boats* Court added: “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.’” *Id.* at 165.

<sup>69</sup> *Id.* at 144.

<sup>70</sup> *Id.* at 144-45.

<sup>71</sup> *Id.* at 153.

<sup>72</sup> *Id.* at 151.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.* at 152.

<sup>75</sup> *Id.*

becomes public property.”<sup>76</sup> And significantly, if a publicly known design or utilitarian idea is unprotected by a patent, the subject is in the same position as an expired patent.<sup>77</sup> Such protection by the state would seriously interfere with the federal “patent statute’s careful balance between public right and private monopoly to promote certain creative activity.”<sup>78</sup>

The Court observed that trade dress (i.e., product configuration) was a potential type of protection that fell within the subject matter of design patents.<sup>79</sup> While the Court made this connection, it stopped short of saying that the broader doctrine of trademark protection can never be extended to patentable subject matter; it also did not state that full trademark protection should be afforded to patentable subject matter. The Court merely stated that “limited regulations” and/or “some conditions” can be placed on the use of patentable designs “in order to prevent consumer confusion as to source.”<sup>80</sup> Further, the Court explained that “we have consistently reiterated the teaching of *Sears* and *Compro* that ideas once placed before the public without the protection of a valid patent are subject to appropriation *without significant restraint*.”<sup>81</sup>

Indeed, other language in *Bonito Boats* suggests that there are strict and narrow bounds to the restrictions that can be legally placed on the use of patentable subject matter.<sup>82</sup> For example, the Court identified, as a matter of federal policy, a “federal right to ‘copy and use’” the subject matter of an expired patent.<sup>83</sup> Further, the Court indicated that a law that protects an unpatented product from copying undermines the entire patent system:

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<sup>76</sup> *Id.* (internal citation omitted).

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 167.

<sup>79</sup> *Id.* at 154.

<sup>80</sup> *Id.* at 154, 165.

<sup>81</sup> *Id.* at 156 (emphasis added).

<sup>82</sup> As properly presented by the successful Petitioners in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*:

[E]specially when a product is the subject of an expired patent, a legislature may not “prohibit the copying of the *article itself*.” That would result in the sort of perpetual patent monopoly the Framers expressly sought to preclude. In *Bonito Boats*, the Court reaffirmed this principle when it observed that the statute at issue there, “[i]n essence, \*\*\* prohibit[ed] the entire public from engaging in a form of reverse engineering of a product in the public domain.” That result impermissibly “restrict[ed] the public’s ability to exploit” a product configuration within the public domain.

U.S. Pet. Brief, *supra* note 36, at 34-35 (internal citations omitted).

<sup>83</sup> *Bonito Boats, Inc.*, 489 U.S. at 165.

A state law that substantially interferes with the enjoyment of an unpatented utilitarian or design conception which has been freely disclosed by its author to the public at large impermissibly contravenes the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy.<sup>84</sup>

Although this language expressly refers to *state* law, the reasoning of the Court—including the underlying principle that publicly-known ideas “are the tools of creation available to all” would appear to be equally applicable to any *federal* law that “substantially interferes” with the use of a utilitarian or design concept disclosed through a patent.<sup>85</sup> The Court concluded that *Sears* had correctly found “that States may not offer patent-like protection to intellectual creations.”<sup>86</sup> If the states were allowed to create patent-like rights, they would disrupt the balance that Congress had created and adhered to for over 200 years in the field of patent law.

In view of the Supreme Court cases discussed above, it is crystal clear that patents grant *limited* monopolies and the public has a right to copy that can only be *temporarily* denied. In this regard, the Court has consistently concluded that when patent rights end, the public has the right to copy what was previously protected by the patent. To this end, the public, including any competitors, has full right to copy and use, if done without causing undue risk of unfair competition in the form of likely confusion. As discussed below in

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<sup>84</sup> *Id.* at 156-57.

<sup>85</sup> *Id.* at 156. The authors recognize and fully acknowledge that the *Sears* and *Compro* decisions dealt with a state law vs. federal law conflict, and that states could not, because of the Supremacy Clause, create their own patent or patent-like laws. In this regard, this Supremacy Clause line of cases, albeit relevant to the issue, does not dispose of the federal law vs. federal law conflict probed in further detail below in section VII of this paper. Here is a brief and cogent introduction per the Petitioners in *TrafFix*:

Congress is no more free to use trademark law as a means of extending the patent monopoly than are the States. The Lanham Act is a product of Congress’ Commerce Clause authority, not its patent power. While potent, the Commerce Clause does not empower Congress to override the express limits in other parts of the Constitution. *See* U.S. Const. art. I, § 8, cl. 3; *College Sav. Bank v. Florida Prepaid Post-secondary Educ. Expense Bd.*, 119 S. Ct. 2219, 2224 (1999); *see also* *Gibbons v. Ogden*, 22 U.S. (9 Wheat) 1, 196 (1824) (Commerce Clause “power, like all others vested in Congress, is complete in itself, may be exercised to its utmost extent, and acknowledges no limitations, *other than are prescribed in the Constitution.*”) (Marshall, C.J.) (emphasis added); *North American Co. v. SEC*, 327 U.S. 686, 704-05 (1946) (Commerce Clause power “is limited by express provisions in other parts of the Constitution”). Thus, in establishing trade dress protection under Section 43(a) [of the Lanham Act], the Commerce Clause does not empower Congress to establish what are, in essence, patent monopolies of unlimited times.

U.S. Pet. Brief, *supra* note 36 at 35.

<sup>86</sup> *Id.* at 156.

section V of this article, Congress has similarly guarded against the stifling effects of permitting perpetual monopolies.

#### IV. HISTORY AND PURPOSE OF DESIGN PATENTS

The original purpose of patent law was to protect the public from unwarranted monopolies.<sup>87</sup> The framers of the Constitution, knowing the importance of balancing free competition and government-sponsored monopoly, empowered Congress to grant monopolies, but only “[t]o promote the Progress of Science and the useful Arts” and then only for “limited times.”<sup>88</sup> Thus, the Patent Clause is both a power granted to and a limitation on Congress.

Under this framework, the standards of patentability are designed to ensure that society benefits from the grant of a patent. In this regard, Congress may not grant patent rights to inventions or designs that do not meet specific standards of patentability. In order for society to benefit from a design or functional invention, it must be a new, useful, *and* nonobvious innovation.<sup>89</sup> An invention or design that is not new is already in the public domain and not susceptible to private monopoly. The novelty and nonobviousness requirements are necessary, according to Thomas Jefferson, for “drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.”<sup>90</sup>

While design patents and utility patents both find their origins in the “Patent Clause,” *historically*, the “substantive requirements for design

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<sup>87</sup> See *Graham*, 383 U.S. at 7.

<sup>88</sup> U.S. Const. art. I, § 8, cl. 8. The authors note and acknowledge that some patent practitioners and academics do not view a patent as creating a monopoly—a concept that a person can patent an idea and have complete ownership of the idea for a limited time. See *supra* note 40. Rather, patents provide the owner with negative rights. In this regard, a patent provides its owner with the right to prevent others from making, using, selling, or offering for sale, the same invention. With this understanding, many operate under the misconception that getting a patent is equal to owning and controlling the market of its sale. However, without a market and customers, a patent can never create a monopoly. While this view is plausible, with a market and customers, a patent can certainly be used to facilitate a monopoly.

<sup>89</sup> See 35 U.S.C.S. §§ 101-03 (current through Pub. L. No. 117-39, approved August 31, 2021).

<sup>90</sup> *Graham*, 383 U.S. at 1, 9.



patents were separate and distinct from their utility patent counterparts.”<sup>91</sup> In this regard, the early Patent Office commissioners had an enormous impact on the development of the patent law and its practice, especially as it related to design patents.<sup>92</sup> The merger of design and utility patent standards to define the current era of design patent rules began in the Act of 1842.<sup>93</sup> The 1902 Act rang in the era of inventiveness and nonobviousness, which has lasted until the present.<sup>94</sup> In this regard, the novelty and nonobviousness requirements now are applied to both design and utility patent regimes.<sup>95</sup>

The last major revision to the design patent laws occurred as part of the larger Patent Act of 1952.<sup>96</sup> Under that statute, a design patent was granted to “[w]hoever invents any new, original and ornamental design for an article of manufacture.”<sup>97</sup> Additionally, this section incorporated a more restrictive version of the catchall section, which provided: “The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”<sup>98</sup> Most importantly, the 1952 Act also codified the

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<sup>91</sup> See Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531, 538 (2010) (explaining that it “was the compartmentalization of these two regimes that kept the widespread rubric of invention in utility patents from spreading to designs”).

<sup>92</sup> See *id.* at 537.

<sup>93</sup> See *id.* at 539-45.

<sup>94</sup> See *id.* at 589-95.

<sup>95</sup> Compared to utility patents, a determination of whether a design is obvious over the prior art can be challenging. See, e.g., *Campbell Soup Co. v. Gamon Plus, Inc.*, 939 F.3d 1335 (Fed. Cir. 2019) (reversing the Board’s determination of obviousness based on the primary reference, but affirming obviousness based on a secondary reference).

<sup>96</sup> On Sept. 16, 2011, the Leahy-Smith America Invents Act (AIA) was passed by Congress, Pub. L. No. 112-29, 125 Stat. 284 (2011), which made minor revisions to the design patent laws. One notable change to design patents that resulted from the AIA was that the term of a design patent was increased to 15 years (from 14 years).

<sup>97</sup> 35 U.S.C. § 171.

<sup>98</sup> *Id.*

nonobviousness requirement in § 103<sup>99</sup> as a condition to patentability for all patents.<sup>100</sup>

While Congress was working to resolve the confusion surrounding the design patent laws through the legislation discussed above, the PTO and courts continued to struggle with the issue of functionality in design—often referred to as the doctrine of functionality. This doctrine stems from 35 U.S.C. § 171, which requires that, to be patentable as a design, a design *must be* “ornamental.”<sup>101</sup> Thus, the common understanding is that a design which is “functional” cannot be “ornamental.”<sup>102</sup> Judicial in origin, the doctrine of functionality arises in both design patent validity and infringement analyses.<sup>103</sup> Today, design patents are not granted for designs that are

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<sup>99</sup> 35 U.S.C. § 103 states:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

<sup>100</sup> Framed as a condition to patentability by the Patent Act of 1952, rather than the rubric of invention, it is now clear that the nonobviousness requirement applies to both utility and design patents. *See* Du Mont, *supra* note 91, at 535.

<sup>101</sup> As explained by one commentator, “[d]esign patents were a recognition by Congress ‘that the useful arts would be stimulated by that which appeals to the eye, and that protection should be granted to those who create a pleasing design.’” Wayne A. Kalkwarf, *The Commerce Clause Versus the Patent and Copyright Clause: A Battle of Constitutional Proportions*, 54 IDEA 351, 384 (2014) (quoting Mark A. LoBello, *The Dichotomy Between Artistic Expression and Industrial Design: To Protect or Not to Protect*, 13 WHITTIER L. REV. 107, 110 (1992)). Mr. Kalkwarf continued to explain that, “[t]he law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.” *Id.* at 385 (quoting *Gorham Co. v. White*, 81 U.S. 511, 525 (1871)). Again, symbiosis is noted, plus emphasis on the restriction of design patents to tangible products, which contrasts trade dress.

<sup>102</sup> *See* Manual of Patent Examining Procedure § 1504.01(c), U.S. PATENT & TRADEMARK OFFICE (9th ed., rev. Aug. 2017).

<sup>103</sup> *See* Andrew Beckerman-Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 SANTA CLARA COMPUTER & HIGH TECH. L.J. 53, 65 (2015) (citing 35 U.S.C. §171(d) and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989)), explaining that:

A functionality test is not expressly embodied in the statutory requirement for obtaining design patent protection. Nevertheless, a judicially developed functionality test or limitation provides courts with a method of assessing whether the subject matter of a design patent satisfies the ornamental requirement. The Supreme Court stated that “a design must present an aesthetically pleasing appearance that is not dictated by function alone.” The aesthetic appearance necessary to satisfy the ornamental requirement is not limited to designs that have a certain degree of beauty such as might be found in the fine arts. Such a test would

“dictated by function alone.”<sup>104</sup> This doctrine, however, did not fully develop until the patent code began to resemble its modern form.<sup>105</sup>

## V. ANTI-TRUST LEGISLATION

Throughout history, Congressional attitudes towards monopolies, including monopolies created through the patent system, have been skeptical at best.<sup>106</sup> While patent laws are some of the oldest and most fundamental in our country, the Founders understood the threat of monopolies and debated the concepts of patents and monopolies when drafting the Constitution. For example, by the time he drafted the first patent act in 1793, Thomas Jefferson had come to tolerate limited monopolies on inventions as a necessary evil to insure that “ingenuity should receive a liberal encouragement.”<sup>107</sup> In this regard, the Constitution itself directly empowers Congress to pass a patent statute, and it further provides Congress with the authority to create the patent system to thereby minimize the potential for monopolies by limiting the duration of time in which a patent owner can enforce a patent against a competitor.<sup>108</sup> While Congress has always been

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be highly subjective. Consequently it would be difficult to draw a line between what is and is not beautiful or within the category of fine art. To avoid this difficulty, courts have utilized the more objective standard of functionality.

<sup>104</sup> See Du Mont, *supra* note 91, at 538 n.38, stating:

Today, *de facto* functionality simply means that the design performs a function. Alternatively, *de jure* functionality is a legal conclusion that the article’s design is “dictated by function alone,” and it is therefore ineligible for a design patent. (internal citations omitted). When speaking of *de jure* functionality . . . the article’s design was dictated solely by its function or by function alone. However, it is also commonly articulated as requiring the design to be primarily non-functional. See, e.g., *Rosco, v. Mirror Lite. Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002); *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1567 (Fed. Cir. 1996). While the Federal Circuit seems to use these terms synonymously (i.e., primarily and solely functional), its locution could lead to different holdings. *Id.*

<sup>105</sup> In 2011, Congress signed into law the Leahy-Smith America Invents Act (Pub. L. No. 112-29, 125 Stat. 284 (2011)), which made significant changes to the patent system, including: Patentable Subject Matter, changing to a First-Inventor-to-File Priority System, Prior User Rights, Assignee Filing, Post-Grant Review Proceedings, Public Participation in USPTO Procedures, USPTO Fees, Patent Marking, and Best Mode. See Congressional Research Service Report, R42014 [<https://perma.cc/7FRV-8U8V>].

<sup>106</sup> See e.g., Michael R. Mattioli, *The Impact of Open Source on Pre-Invention Assignment Contracts*, 9 U. PA. J. LAB. & EMP. L. 207, 227 (2006).

<sup>107</sup> *Id.* (quoting a Letter from Thomas Jefferson to Oliver Evans (May 2, 1807), in 11 *The Writings of Thomas Jefferson* 202 (Andrew A. Lipscomb ed., Memorial ed. 1904)).

<sup>108</sup> See U.S. Const. art I, § 8, cl. 8 (“The Congress shall have power . . . to 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[.]”).

skeptical towards monopolies, Congress didn't act on this concern until after the Supreme Court's holding in *Pope Mfg. Co. v. Gormully & Jeffery Mfg. Co.*<sup>109</sup> In this case, the Court reprimanded litigants who had obtained patents "principally to forestall competition, rather than to obtain the just rewards of an inventor."<sup>110</sup> Witnessing this and the potential for negative effects on free trade and commerce, Congress enacted the Sherman Act in 1890, which prohibited restraints of trade and attempts to monopolize any part of interstate commerce.<sup>111</sup>

However, around the beginning of the 20<sup>th</sup> century, through certain decisions<sup>112</sup> Congress was again alerted to abuses of the patent laws by patent holders seeking to overextend the reaches of their patent-granted monopolies. In response, Congress passed the Clayton Act in 1914; this Act, *inter alia*, prohibited the sale of patented goods on the condition that the purchaser not use a competitor's products if doing so substantially decreased competition.<sup>113</sup>

In addition to the Clayton Act, in 1914 the Federal Trade Commission ("FTC") was created by the Federal Trade Commission Act ("FTCA").<sup>114</sup> The FTC's mission is to "protect consumers and promote competition."<sup>115</sup> Congress passed the FTCA "in response to widespread concern about the

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<sup>109</sup> 144 U.S. 254 (1892).

<sup>110</sup> *Id.* at 260.

<sup>111</sup> See ch. 646, 26 Stat. 209 (1890). The court in *Ohio v. Am. Express Co.*, 138 S. Ct. 2274 (2018), explained that:

[s]ection 1 of the Sherman Act prohibits "[e]very contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several States." 15 U.S.C. §1. This Court has long recognized that, "[i]n view of the common law and the law in this country" when the Sherman Act was passed, the phrase "restraint of trade" is best read to mean "undue restraint." *Standard Oil Co. of N.J. v. United States*, 221 U.S. 1, 59-60, 31 S. Ct. 502, 55 L. Ed. 619 (1911). This Court's precedents have thus understood §1 "to outlaw only *unreasonable* restraints." *State Oil Co. v. Khan*, 522 U.S. 3, 10, 118 S. Ct. 275, 139 L. Ed. 2d 199 (1997).

138 S. Ct. at 2283.

<sup>112</sup> *E.g.*, *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 F. 288, 296 (6th Cir. 1896) (holding that if the plaintiff obtained a monopoly on its unpatented fasteners via a patent, "the monopoly in the unpatented staple results as an incident from the monopoly in the use of complainant's invention, and is therefore a legitimate result of the patentee's control over the use of his invention by others."); *Henry v. A. B. Dick Co.*, 224 U.S. 1 (1912) (holding that a patentee could achieve a monopolist's profits either by selling machines at a higher price or by extending his monopoly to appurtenant products).

<sup>113</sup> See Ch. 323, 38 Stat. 730 (1914) (codified as amended at 15 U.S.C. §§ 12-27 (1994)).

<sup>114</sup> Chapter 311 of the 63rd Congress, 38 Stat. 717 (1914).

<sup>115</sup> See *Our History*, FEDERAL TRADE COMMISSION, <https://www.ftc.gov/about-ftc/our-history> (last visited Oct. 7, 2021) [<https://perma.cc/K9EP-VGDQ>].

growth and behavior of monopolies and cartels.”<sup>116</sup> The original FTCA protected the marketplace by prohibiting “unfair methods of competition.”<sup>117</sup> In 1938, Congress amended the FTCA to further prohibit “unfair or deceptive acts or practices.”<sup>118</sup> With that amendment, the consumer, along with business competitors, became a concern of the FTC. In this regard, when the FTC determines that a company has violated the prohibitions against “unfair methods of competition” or “unfair or deceptive acts or practices,” it “shall issue . . . an order requiring such person, partnership, or corporation to cease and desist from using such method of competition or such act or practice.”<sup>119</sup> Following this amendment, and generally from the 1930s through the present, antitrust law has viewed patents as “problematic monopolies that should be curbed to the greatest extent possible.”<sup>120</sup>

Although Congress struck a balance with patent holders in the 1952 Patent Act, the tensions between Congress and patent holders largely remained. These tensions again came to a head in the latter half of the 20<sup>th</sup> century and early part of the 21<sup>st</sup> century, beginning with the joint Justice Department (DOJ) and FTC IP-Antitrust Guidelines of 1995.<sup>121</sup> These guidelines provide that in most cases patent licensing agreements are to be evaluated by weighing the pro-competitive and anticompetitive effects of each agreement.<sup>122</sup> Thus, Congress’s attitude towards monopolies over the years remains clear: while IP laws justifiably grant exclusive rights or monopoly privileges to creators or inventors, the privileges are ultimately beholden to public interests. Therefore, Congress has consistently seen the need to limit the scope of monopolies to protect the interests of the public.

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<sup>116</sup> See Peter C. Ward, *Restitution for Consumers Under the Federal Trade Commission Act: Good Intentions or Congressional Intentions?*, 41 AM. U.L. REV. 1139, 1141 (1992).

<sup>117</sup> Federal Trade Commission Act, ch. 311, § 5(a), 38 Stat. 717, 719 (1914) (current through Pub. L. No. 116-91, approved December 19, 2019).

<sup>118</sup> Wheeler-Lea Act of 1938, ch. 49, Pub. L. No. 75-447, § 3, 52 Stat. 111, 111 (1938) (amending Federal Trade Commission Act, ch. 311, 38 Stat. 717 (1914)) (“Unfair methods of competition in or affecting commerce, and unfair deceptive acts or practices in or affecting commerce are hereby declared unlawful.”).

<sup>119</sup> 15 U.S.C. § 45 (current through Pub. L. No. 116-91, approved December 19, 2019).

<sup>120</sup> Alden F. Abbott, *The evolving IP-antitrust interface in the USA - the recent gradual weakening of patent rights*, J. ANTITRUST ENFORCEMENT 2(2), 363, (2014).

<sup>121</sup> US Department of Justice and US Federal Trade Commission, Antitrust Guidelines for the Licensing of Intellectual Property (1995 Guidelines).

<sup>122</sup> See *id.*

## VI. TRADEMARKS/TRADE DRESS

Trade dress is an extension of trademark law, having a judicial origin that can be traced back through the history of trademark law and tort common law.<sup>123</sup> Unlike patent law, trademark law is *not* rooted in the notion of stimulating innovation. Like misappropriation, it is grounded in the law of unfair competition and misrepresentation/deceit, where one merchant's actions threaten to deceive the customers of another into mistaking the true source of the junior merchant's goods or services.<sup>124</sup> In this regard, trademarks and trade dress are source identifiers. Defined generally, trade dress is the overall image or appearance used to identify the source of a product or service to purchasers.<sup>125</sup> Although historically trade dress has been less recognized than traditional trademarks and service marks *per se*, trade dress serves the same function of identifying the origin of its owners' goods and services and distinguishing these goods and services from those of others.<sup>126</sup> To qualify as trade dress for purposes of protection under Section 32 or Section 43(a) of the Lanham Act, a product must be (1) a distinctive indicator of origin *and* (2) nonfunctional.<sup>127</sup>

At the outset, the goal of trade dress protection was to prevent obvious acts of piracy where one manufacturer would "dress" its product like that of another manufacturer (e.g., copy a competitor's label), attempting to deceive consumers into mistakenly purchasing goods from a different maker.<sup>128</sup> However, by the late nineteenth century, courts began to recognize that it was necessary to protect against not only the approximation of a brand label, but also the mimicking of product packaging and unique product designs.<sup>129</sup> In light of this increasing need to prevent close copying and piracy, state law principles for protection began to evolve. In this regard, most early trade dress cases during the late nineteenth and early twentieth centuries addressed

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<sup>123</sup> See Kenneth B. Germain, *Unfair Trade Practices Under Section 43(a) of the Lanham Act: You've Come a Long Way, Baby—Too Far, Maybe?*, 49 IND. L.J. 84, 85-87 (1973).

<sup>124</sup> See *id.* at 97.

<sup>125</sup> See *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 209-10, 120 S. Ct. 1339, 1342-43 (2000); see also *Two Pesos*, 505 U.S. at 764 (1992) (describing trade dress of a product as "essentially its total image and overall appearance").

<sup>126</sup> See *Wal-Mart Stores*, 529 U.S. at 209-10.

<sup>127</sup> See *id.*

<sup>128</sup> See Stephen F. Mohr et al., *U.S. Trade Dress Law, Exploring the Boundaries* (Int'l Trademark Ass'n eds., 1997).

<sup>129</sup> See *id.*

only the protectability of wholly nonutilitarian label designs.<sup>130</sup> For example, one early court recognized the availability of relief on a showing that “the defendant fraudulently, deceitfully, and with the intent to injure [the plaintiff’s] business . . . simulated [the plaintiff’s] wrappers, and thus deceived the public into buying large quantities of the spurious [product] as the genuine.”<sup>131</sup> Similarly, another very early court concluded that equity would enjoin use of the elements making up packaging “when all, or a number of them, are combined . . . and so arranged and exhibited that when they strike the eye of the intending purchaser, possessed of ordinary intelligence and judgment, the false impression is likely to be produced that the goods of the plaintiffs are offered.”<sup>132</sup> To this end, a defendant becomes liable when its use of a mark creates “a likelihood of confusion” about whether the plaintiff is affiliated or associated with the defendant, or whether the plaintiff originated, sponsored, or approved of the defendant’s goods.<sup>133</sup> The early emphasis on fraudulent conduct was modified; modernly, it matters not whether the defendant created or threatened confusion intentionally or accidentally.<sup>134</sup>

Federal statutory protection for trade dress emerged in 1946 in the guise of Section 43(a) of the Lanham Act.<sup>135</sup> However, when enacted, the Lanham Act was not the expansive statute it is today, and it has a long history of

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<sup>130</sup> See, e.g., *Isador Straus v. Notaseme Hosiery Co.*, 240 U.S. 179, 180 (1916) (use of nonfunctional design held confusingly similar to federally registered mark).

<sup>131</sup> *M. A. Thedford Med. Co. v. Curry*, 96 Ga. 89, 93, 22 S.E. 661, 663 (1895).

<sup>132</sup> *Fisher v. Blank*, 33 N.E. 1040, 1041 (N.Y. 1893).

<sup>133</sup> See 15 U.S.C. § 1114(1)(a) (imposing trademark liability when defendant uses a registered mark “likely to cause confusion”); see also, regarding unregistered marks, 15 U.S.C. § 1125(a) (2020).

<sup>134</sup> J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS § 23:106 (4th ed. 2005) (“The modern rule at common law is that the issue of infringement of any kind of trade symbol . . . is determined solely by the likelihood of confusion test.”); *id.* at § 23:107 (noting that intent to deceive is not an element of the federal cause of action for trademark; trademark is a “no-fault” tort).

<sup>135</sup> See Davis Jr. *supra* note 13, at 605-06 explaining how “courts hearing unfair competition and trade dress cases did not create a separate body of federal law, but instead relied equally upon state and federal precedents.” Further explaining that,

[a]s late as the Trademark Act of 1905 . . . the federal cause of action for infringement extended only to marks registered with the Commissioner of Patents . . . the Trademark Act of 1920 recognized for the first time a cause of action against the infringement of unregistered “designations of origin” (rather than merely of word marks), it nevertheless offered little guidance on the subject of what might qualify for protection.

*Id.* (footnotes omitted).

evolution.<sup>136</sup> The Lanham Act has become the main vehicle for protecting trade dress protection today.<sup>137</sup> Various amendments to the Lanham Act confirmed that protection had become available not only for registered trademarks, but also for unregistered trademarks and trade dress of various types.<sup>138</sup>

While trade dress has a long history of clashing with utility patents, the focus of the instant article is on the ornamental and nonfunctional aspects of design patents and trade dress. To this end, some argue that the protections offered by design patents and trade dress serve unique and separate functions, for both the public and the owner of the intellectual property.<sup>139</sup> However, in

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<sup>136</sup> See Germain, *supra* note 123, at 109-12, explaining how “[e]arly interpretations of § 43(a) were [quite] conservative. They either restricted § 43(a) to actions for passing-off or confined its effect to ‘include only such false descriptions or representations as are of substantially the same economic nature as those which involve infringement or other improper use of trademarks,’” and further explaining how the law evolved through court decisions which “sounded the death knell for the single-source rule, and signaled the birth of a new federal law of unfair competition.” (internal citations omitted).

<sup>137</sup> The Lanham Act has its basis in the Commerce Clause, U.S. Const. art. I, §8, cl. 3, which grants Congress the authority to regulate “commerce”—widely defined—which includes trademark, trade name, and trade dress. As explained by Pollack, *supra* note 64, at 298-99:

The idea of using the Commerce Clause to expand Congressional power over intellectual property is not new. The [Supreme] Court alludes to this power as early as the Trade-Mark Cases in 1879. Congress eventually followed the Court’s suggestion by linking the Lanham Act, the federal trademark statute, to “all commerce which may lawfully be regulated by Congress.” Perhaps in an excess of caution, Congress has rested several pieces of intellectual property legislation, at least in part, on the Commerce Clause. None of these, however, suggest Congress believes that by legislating under the Commerce Clause, it can by pass the “limited times” provision of the Intellectual Property Clause. No court has yet ruled on the constitutionality of federal intellectual property legislation under the Commerce Clause. While several authors have argued the constitutionality or constitutional basis of Congressional action in this field under the Commerce Clause, no one has raised any argument undermining the Intellectual Property Clause time limit requirement.

<sup>138</sup> See Bonder *supra* note 40, at 12-13 (2004) (citations omitted), explaining that:

Section 43(a) of the Lanham Act was amended November 16, 1989 to provide for a cause of action to four categories of statements: (1) “any word, term, name, symbol, or device, or any combination thereof;” (2) “any false designation of origin;” (3) a “false or misleading description of fact;” and (4) a “false or misleading representation of fact.” The amended version of section 43(a) added causes of action for false and misleading trademarks and false advertising. This section also provides protection for trade dress infringement. In summary, a successful claim for trade dress infringement under 43(a) requires the plaintiff to establish three elements: (1) that the trade dress has the requisite distinctiveness and, if necessary, secondary meaning; (2) that it is nonfunctional; and (3) that the defendant has created a likelihood of confusion among the public as to the source of the product.

<sup>139</sup> See *id.* at 8; see also Ronald J. Horta, *Without Secondary Meaning, Do Product Design Trade Dress Protections Function as Infinite Patents?*, 27 SUFFOLK U. L. REV. 113, 128 (1993) (explaining that “[t]he stated purposes of design patents and trade dress are very different and no overlap exists between the two. No authority states that patented



practice, the line is very blurred. Essentially, both design patents and trade dress protection give the owner the right to prohibit another party from intruding upon its legal rights and to prevent them from using its design. As discussed above, design patents only cover ornamental designs embodied in “articles of manufacture” and, by definition, the ornamentation embodied in useful objects.<sup>140</sup> In comparison, trademark law, including the Lanham Act, is not designed to encourage creativity and invention; rather, it aims to prevent consumer confusion regarding the source of products and prevents free riding on the good will that trademark owners have built. Thus, trade dress is premised upon a distinctive, non-functional identification of the source of a product. However, the effect on competition is the same for design patent or trade dress infringement: both provide an owner with a cause of action to prohibit another from using its design, but for very different purposes (i.e., ornamental re useful object vs. “source”). The net result of trade dress protection is virtually infinite protection for designs—extending any patent rights and monopoly well beyond the statutory period expressly required by the Patent Clause of the Constitution. Accordingly, the extension of design patent protection through trade dress protection may interfere with the right to copy guaranteed by the Constitution, which includes designs that are unpatented but would otherwise qualify for design patent protection.<sup>141</sup> Extending such rights threatens to leave the language of the Patent Clause without effect.<sup>142</sup> This is contrary to the purpose of the Constitution and violates critical canons of constitutional construction.

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designs indicate the source of a product and no authority holds that trade dress protections are rewards for innovation.”).

<sup>140</sup> Useful articles are those which have “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.” 17 U.S.C. § 101 (Definitions).

<sup>141</sup> Trade dress protection for such designs ignores the one-year statutory bar under 35 U.S.C. § 102(b).

<sup>142</sup> As propounded by the successful Petitioners in *TrafFix*:

Nor is there any indication that in establishing national trademark protection, Congress sought to disrupt the “carefully crafted bargain” underlying the patent system . . . . Extending federal trade dress protection to product configurations that are the subject of expired patents would deprive the public of the benefit of its bargain and effectively repeal that venerable federal right.

U.S. Pet. Brief, *supra* note 36, at 28.

## VII. THE CONSTITUTIONAL CONFLICT

For protection of product designs, trade dress and design patents have significant overlap, not only with respect to the subject matter, but also regarding the tests for validity and infringement. Some argue that design patents and trade dress protection are intended to serve unique and separate functions, for both the public and the owner, and the existence of design patent rights is independent of the ownership of trademark rights.<sup>143</sup> However, the Federal Circuit, in *Apple Inc. v. Samsung Elecs. Co.*,<sup>144</sup> pointed out that Ninth Circuit law acknowledges significant differences between the policies and purposes of trademark/trade dress law, on the one hand, and patent and copyright laws, on the other hand, stating:

The protection for source identification . . . must be balanced against “a fundamental right to compete through imitation of a competitor’s product . . . .” This “right can only be temporarily denied by the patent or copyright laws.” In contrast, trademark law allows for a perpetual monopoly and its use in the protection of “physical details and design of a product” must be limited to those that are “nonfunctional.”<sup>145</sup>

In closing this discussion, the court paused to clarify what it had *not* considered:

Because we conclude that the jury’s findings of nonfunctionality of the asserted trade dresses were not supported by substantial evidence, *we do not reach [Defendant’s] arguments on the fame and likely dilution of the asserted trade dresses, the Patent Clause of the Constitution, or the dilution damages.*<sup>146</sup>

At least one commentator has come to a similar conclusion regarding the differences in trademark/trade dress law and design patent law as a result of

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<sup>143</sup> See David S. Welkowitz, *Trade Dress and Patent – The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 306 (1999), explaining that:

It is not the function of trademark to protect designers against copying per se. Properly understood, the function of trademark law is to protect the reputation of the mark owner and to provide accurate information to potential purchasers. It is not to give exclusive property rights in an object to its maker. This is the difference between a true intellectual property right (which gives exclusionary rights to the owner) and protection against unfair competition (which seeks to make sure that the competitive market operates properly).

<sup>144</sup> 786 F.3d 983 (Fed. Cir. 2015) (reversed and remanded by *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429 (2016) on grounds unrelated to the Federal Circuit’s statement regarding trade dress). The Court reversed the Federal Circuit, stating that, “[t]he Federal Circuit’s narrower reading of ‘article of manufacture’ cannot be squared with the text of § 289.” *Id.* at 435-36.

<sup>145</sup> *Id.* at 991 (internal citations omitted) (emphasis added).

<sup>146</sup> *Id.* at 996 (emphasis added).

the policies underlying each type of protection, concluding that, “[i]t is evident that limited trade dress protection can be provided for expired patent features without violating patent law principles or undermining trade dress law objectives.”<sup>147</sup> In formulating these assertions, the commentator focused on the underlying policies of the Patent and Lanham Acts, claiming that each serves a distinctly different purposes and, as a result, no conflict exists.<sup>148</sup> However, the authors of the instant article now assert that the underlying policies, albeit arguably different, cannot save trade dress protection that has been acquired for a product configuration previously protected by an expired design patent from violating the “Limited Times” provision of the Patent Clause.

For some, this policy argument is rooted in the Tenth Circuit’s holding in *Vornado Air Circulation Sys. v. Duracraft Corp.*,<sup>149</sup> where the court opined that, where patent law and trade dress law intersect, the policies of both federal statutes must be balanced “in a way that preserves the purposes of both and fosters harmony between them.”<sup>150</sup> Twenty odd years later, the Seventh Circuit came to a similar conclusion in *Arlington Specialties, Inc. v. Urban Aid, Inc.*,<sup>151</sup> stating:

Because trademark protection for trade dress has no time limit, giving one competitor a perpetual and exclusive right to a useful product feature would result in a perpetual competitive advantage. “The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its [limited] period of exclusivity.”<sup>152</sup>

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<sup>147</sup> Michael S. Perez, *Reconciling the Patent Act and the Lanham Act: Should Product Configurations Be Entitled to Trade Dress Protection After the Expiration of a Utility or Design Patent?*, 4 TEX. INTELL. PROP. L.J. 383, 413 (1996). But note that this view was expressed before the modern era of *Wal-Mart* (U.S. 2000), and that it totally failed to consider any possible constitutional conflict.

<sup>148</sup> *See id.* at 403 (explaining that the purpose of the Patent Act is, “primarily to stimulate further invention and to permit the public to practice the invention once the patent expires,” compared to the primary purpose of the Lanham Act, which is “to prevent consumer confusion in the marketplace due to false or misleading marks.”) (internal citations omitted).

<sup>149</sup> 58 F.3d 1498, 1500 (10th Cir. 1995).

<sup>150</sup> *Id.* at 1507.

<sup>151</sup> 847 F.3d 415 (7th Cir. 2017).

<sup>152</sup> *Id.* at 418 (quoting *TrafFix*, 532 U.S., at 34). In affirming the District Court, the Seventh Circuit’s opinion was full of philosophical explanations such as these:

This feature of trademark law presents both an opportunity for producers and a potential threat to consumers. Other forms of federal intellectual property — patents and copyrights — come with time limits, after which competitors and the public are free to copy the protected item. Trademark protection does not expire, though, as long as the protected mark is being used in commerce to designate the origin of a product.

However, and like the holding in *Vornado Air*, such arguments fail to address the constitutional conflict of allowing trade dress protection for expired patent features as a result of patent law's specific statutory scheme rooted in the Constitution. In particular, keep in mind that the Patent Clause of the Constitution mandates that Congress grant monopolies only for *limited times* to inventions or designs that meet specific standards of patentability.<sup>153</sup> As explained by Professor Malla Pollack, “[t]he [Patent/Copyright] Clause of the Constitution, even read with the Commerce Clause, prevents Congress from giving authors or inventors exclusive rights unbounded by premeasured time limitations.”<sup>154</sup>

Moreover, the views set forth above by commentators, such as Mr. Perez, were made pre-2000, before the modern era of *Wal-Mart Stores v. Samara Bros.*<sup>155</sup>, *TraFFix Devices, Inc. v. Marketing Displays, Inc.*<sup>156</sup>, and *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>157</sup> In summary, as discussed in further detail below, these modern-era cases represent a paradigm shift in the Supreme Court's treatment of trademarks as a species of intellectual property. As explained by Professor David Welkowitz, these cases suggest:

First . . . that *WalMart* was the beginning of a paradigm shift in trademark law. Second, some of the lower courts have not fully implemented this new paradigm, perhaps in part because they do not recognize it, perhaps in part out of habit, or perhaps in part because they are accustomed to developing trademark law on their own, with the Supreme Court operating largely in the background. Third, the new paradigm could lead to a reexamination of recent extensions of trademark law that tend to treat trademark less like unfair competition and more like property.<sup>158</sup>

*Wal-Mart* addresses one of the latest developments in trademark law, namely, the use of the design of a product itself as a trademark. Then, in *Dastar*, the Court made statements to the effect that federal law recognizes a right to copy. For example, the Court declared broadly that the “right to copy . . . passes to the public” upon expiration of a patent.<sup>159</sup> Following this, the

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*Id.*

<sup>153</sup> See *supra* note 2 and accompanying text.

<sup>154</sup> Pollack, *supra* note 64, at 260.

<sup>155</sup> 529 U.S. 205, 210 (2000).

<sup>156</sup> 532 U.S. 23 (2001).

<sup>157</sup> 539 U.S. 23 (2003).

<sup>158</sup> David Welkowitz, *The Supreme Court and Trademark law in the New Millennium*, 30 WM. MITCHELL L. REV. 1659, 1687 (2004).

<sup>159</sup> 539 U.S. at 33.

Court quoted a passage from *TrafFix*, cautioning against the “‘misuse or overextension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”<sup>160</sup> The Court returned to *The Trade-Mark Cases* to note that “[f]ederal trademark law ‘has no necessary relation to invention or discovery,’” thus, accentuating the separation of trademark from other intellectual property.<sup>161</sup>

However, in practice, the line is blurred, and there is no statutory guidance or specific provision to make it clear whether a design should be protected as either a design patent or trade dress, *or both*.<sup>162</sup> Professor David Welkowitz has explained the practical overlap between design patent protection and trade dress protection:

[E]ven a cursory examination of the elements of trade dress infringement for product configurations and the elements of design patent infringement reveals marked similarities. These similarities suggest that current trade dress law has crossed over the line separating patent protection from trade dress protection. The task here is to cut through the rhetoric of what the laws are supposed to protect and to focus on what they actually protect. A closer examination reveals a true similarity in the actual operation of these two sets of laws. This invites further suspicion that trademark has intruded improperly into patent law.<sup>163</sup>

Welkowitz goes on to conclude that:

[T]he facets of trademark law touted as distinguishing the two—the requirements of distinctiveness, likelihood of confusion, and non-functionality—in the end do not do enough to preclude courts from enjoining the simple act of copying another’s non-patented design (or a design whose patent has expired). Second, the elements of infringement under both design patent and trade dress law look for similar things, and ask similar questions. This further indicates a confluence, rather than a separation, of the two forms of protection.<sup>164</sup>

Furthermore, courts often have struggled when attempting to harmonize trade dress and design patent protection for product design. In this regard, it has been common practice for courts to assert that design patents and trademarks protect different things and, as such, there is little likelihood of

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<sup>160</sup> *Id.* at 34 (citing to *TrafFix*, 532 U.S. at 29).

<sup>161</sup> *Id.*

<sup>162</sup> This is unlike the functionality doctrine that rejects trade dress protection for functional designs and steers such designs toward utility patents. See 1 JEROME GILSON & ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 2A.10 (2019).

<sup>163</sup> Welkowitz, *supra* note 143, at 343.

<sup>164</sup> *Id.* at 357.

interference with each other's core values.<sup>165</sup> As discussed above—and unsatisfactorily—these discussions seldom go beyond this conclusory assertion, which is inappropriate.<sup>166</sup> For example, in *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int'l, Inc.*,<sup>167</sup> the majority<sup>168</sup> emphatically expressed its policy orientation, namely to “reaffirm that trademark law is designed to promote brand recognition, not to insulate product manufacturers from lawful competition.”<sup>169</sup> In so doing, the majority stated:

A manufacturer who desires protection against copying must satisfy the requirements of protectability under the copyright or patent regimes and must also submit itself to the limited time periods of protection afforded under those regimes. Those requirements and their attendant restrictions incentivize valuable artistic and scientific creations while ensuring that the social costs of monopoly are contained within reasonable bounds.<sup>170</sup>

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<sup>165</sup> See e.g., *In Re Mogen David Wine Corp.*, 328 F.2d 925, 929 (C.C.P.A. 1964); *Zip Dee, Inc. v. Domestic Corp.*, 931 F. Supp. 602, 606 (N.D. Ill. 1996); *Herman Miller, Inc. v. A. Studio S.R.L.*, No. 1:04-CV-781, 2006 U.S. Dist. LEXIS 59210, at \*49-50 (W.D. Mich. Aug. 22, 2006); *In re Yardley*, 493 F.2d 1389, 1394 (C.C.P.A. 1974); *Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts*, 944 F.2d 1235, 1240 (2d Cir. 1991); *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638-39 (7th Cir. 1993); *Mech. Plastics Corp. v. Titan Techs., Inc.*, 823 F.Supp. 1137 (S.D.N.Y. 1993); *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 903 F.Supp. 1457, 1461 (D. Kan. 1995); *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F.Supp. 955, 959 (S.D.N.Y. 1995); *Topps Co. v. Gerrit J. Verburg Co.*, 1996 U.S. Dist. LEXIS 18556 (S.D.N.Y. Dec. 12, 1996); *Ashley Furniture Indus. v. Sangiacomo N.A.*, 187 F.3d 363, 376-77 (4th Cir. 1999).

<sup>166</sup> As explained by Moshe Bonder:

Trade dress law is not intended to provide exclusive property rights, nor should it be used in this manner. In recognizing the differences between the two acts courts have consistently identified three principles in developing a workable distinction. “First, courts have asserted that [the acts aim to] protect different [items] and therefore there is little likelihood of interference with each other's core values. Unfortunately, [this argument] seldom goes much beyond the assertion.” Second, courts without exception have held that when a feature is functional it is not entitled to trade dress protection; this requirement is a distinguishing element not required in patent law. Third, where courts have asserted a requirement to establish confusion in maintaining a trade dress action, it has resulted in an important separation from the requirements of design patent infringement.

Bonder, *supra* note 40, at 23-24.

<sup>167</sup> 730 F.3d 494 (6th Cir. 2013).

<sup>168</sup> *Id.* at 521 (Judge Helene N. White dissented, arguing that the majority's articulation of the key issue presented framed the issue on appeal “in a manner that assumes the very issues to be considered—whether the trade dress is functional and whether there is a reasonable likelihood of confusion—without any acknowledgement that reasonable inferences to the contrary not only exist but were accepted by a jury and the district court”).

<sup>169</sup> *Id.* at 500.

<sup>170</sup> *Id.* at 512.

The majority starkly contrasted the property-based protections derived from the Patent Clause from the deceit-based protection based on unfair competition principles:

The clear import of the twin principles that copying in the absence of copyright or patent protection often serves useful purposes, and that the concern of trademark law is not about copying per se but about copying that engenders consumer confusion, is that the appropriate “intent” to focus on is not the intent to *copy* but rather the intent to *deceive* or *confuse*.<sup>171</sup>

For purposes of validity, design patents protect the “new, original and ornamental design for an article of manufacture.”<sup>172</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>173</sup> An article of manufacture, unlike the subject of copyright protection, must necessarily serve a utilitarian purpose.<sup>174</sup> The test for infringement of a design patent is the ordinary observer test, which the Supreme Court historically described as follows:

[I]f, 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>175</sup>

Prior to *Egyptian Goddess v. Swisa*,<sup>176</sup> the test for design patent infringement was a two-part inquiry. However, the ruling in *Egyptian Goddess* removed the second, more difficult, requirement that the design

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<sup>171</sup> *Id.* at 514.

<sup>172</sup> 35 U.S.C.S. § 171(a) (current through Pub. L. No. 117-39, approved August 31, 2021) (For a design to be patentable, this section requires that a design be “original”); M.P.E.P. § 1504(d) (“a design which simulates an existing object or person is not original as required by the statute”); *Id.* (“a design for an article which simulates a well known or naturally occurring object or person should be rejected under 35 U.S.C. 171 as nonstatutory subject matter in that the claimed design lacks originality”) (For example, the CCPA in *In re Smith*, 25 U.S.P.Q. 359, 360 (C.C.P.A. 1935), stated that “to take a natural form, in a natural pose, . . . does not constitute invention,” when affirming the rejection of a claim to a baby doll).

<sup>173</sup> See *Gorham Co. v. White*, 81 U.S. 511, 525 (1871); *In re Blum*, 374 F.2d 904, 907 (C.C.P.A. 1967).

<sup>174</sup> See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F. 2d 1117, 1123 (Fed. Cir. 1993).

<sup>175</sup> See *Gorham Mfg. Co.*, 81 U.S. at 528 (emphasis added); see also *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 683 (Fed. Cir. 2008) (reaffirming the use of the ordinary observer test as the standard for design patent infringement).

<sup>176</sup> 543 F.3d 665, 671 (Fed. Cir. 2008).

meet a “point of novelty” test.<sup>177</sup> As a result of the point-of-novelty test being removed, the ordinary-observer test became the sole test for infringement.<sup>178</sup> Under the ordinary observer test, the factfinder need only determine that the ordinary observer is *likely to be deceived*<sup>179</sup> into buying one product thinking it to be another for a finding of infringement.<sup>180</sup> The Federal Circuit, in *Apple Inc. v. Samsung Elecs. Co.*,<sup>181</sup> clarified the deception consideration for the ordinary observer test; the court explained that *actual deception* is not a requirement for a finding of design patent infringement, and that the ordinary observer test set forth in *Gorham Co.* only requires a finding that an “ordinary purchaser would be likely to mistake the [accused] designs for the [patented design].”<sup>182</sup> However, in a subsequent case, *Lanard Toys, Ltd. v. Dolgencorp LLC*,<sup>183</sup> the Federal Circuit deemphasized focus on consumer deception and clarified that the ordinary observer test should consider element-by-element distinctions between the patented design and the prior art, and between the patented design and the accused product.<sup>184</sup> In any event, some argue that “[u]sing consumer deception as the lynchpin to the finding of [design patent] infringement unmoors the infringement analysis from protecting the innovative aspects of designs and instead hinges protections on the consumer

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<sup>177</sup> *Id.* at 668.

<sup>178</sup> *Id.*

<sup>179</sup> *Id.* at 670-71 The authors note that “likelihood,” not actual deception (whether intentional or not), is a common characteristic of trademarks and, more particularly, trade dress. Contrast this with design patents, in which *actual* deception is not a relevant consideration for infringement).

<sup>180</sup> See *Apple, Inc. v. Samsung Elec. Co., Ltd.*, 786 F.3d 983, 999-1000 (Fed. Cir. 2015) (holding that Apple was not required to show that any Apple customers were *actually* deceived into buying a Samsung phone thinking that it was an Apple phone, but that the phones were so substantially similar that it was *likely* that the ordinary observer would be deceived). See *supra* note 144, *rev’d*, *Samsung Elecs. Co. v. Apple, Inc.*, 137 S. Ct. 429 (2016) (reversed and remanded on other grounds).

<sup>181</sup> 786 F.3d 983 (Fed. Cir. 2015), *rev’d*, *Samsung Elecs. Co.*, 137 S. Ct. at 435-36 (on grounds unrelated to the court’s statement regarding actual deception and the ordinary observer test).

<sup>182</sup> *Id.* at 1000 (citing *Gorham*, 81 U.S. at 530).

<sup>183</sup> 958 F.3d 1337 (Fed. Cir. 2020).

<sup>184</sup> See *id.* at 1343. The court further explained that:

[T]he district court struck the correct balance of considering the ornamental aspects of the design while remaining focused on how an ordinary observer would view the overall design. See *Richardson*, 597 F.3d at 1295 (“[The court] recited the significant differences between the ornamental features of the two designs but, in determining infringement, it mainly focused on whether an ordinary observer would be deceived into thinking that any of the [accused] designs were the same as [the] patented design”).

*Id.* at 1344.



of the product.”<sup>185</sup> Indeed, protection through the lens of the consumer is more consistent with the goal of trademark law than design patent law.<sup>186</sup> Moreover, by focusing the infringement analysis on the consumer, courts have interwoven the trademark objectives into the design patent infringement test.<sup>187</sup> Tying the infringement analysis to deception of the ordinary consumer pushes design patents into the waters of trade dress protections, resulting in increased overlap between the two means for protecting product designs.

As discussed above, 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>188</sup> Generally, trade dress protection includes the packaging or design of a product. At least formally, trade dress protection for product designs follows the structure of other trademark and trade dress analyses, as set forth by the Supreme Court in *Wal-Mart*.<sup>189</sup> First, the design must be a “distinctive” source identifier<sup>190</sup>, which can be demonstrated in either of two ways: by showing that the design is “inherently distinctive” or by showing that the design has “acquired distinctiveness” (a.k.a “secondary meaning”).<sup>191</sup> If the design is distinctive, a plaintiff must show that there is a likelihood of confusion (of goods, source, sponsorship or approval) between its trade dress and the trade dress of another, and that the design is nonfunctional.<sup>192</sup> However, it is important to note that the issue of when trade dress can be considered inherently distinctive, and when it requires secondary meaning, has been addressed in *Wal-Mart*.<sup>193</sup> The Court determined that when a trade dress is found in the packaging of a product the trade dress might be inherently distinctive, but when the trade dress in question is of the product design or configuration itself, secondary meaning is required.<sup>194</sup>

In view of *Egyptian Goddess*, the tests for trademark infringement and design patent infringement both appear to involve questions of consumer

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<sup>185</sup> Carl J. Hall, *A Patently Offensive Test: Proposing Changes to the Test for Design Patent Infringement*, 53 VAL. U.L. REV. 297, 328 (2018).

<sup>186</sup> *Id.*

<sup>187</sup> *Id.*

<sup>188</sup> 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 (1994).

<sup>189</sup> 529 U.S. 205, 210 (2000).

<sup>190</sup> *Id.*

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> *Id.* at 216.

<sup>194</sup> *See id.*

perception.<sup>195</sup> To this end, trade dress is infringed if a similar design is “likely to cause confusion, or to cause mistake, or to deceive.”<sup>196</sup> The primary, and often exclusive, test for determining likelihood of confusion is the similarity of the designs. Although packaged slightly differently, when viewed from the perspective of a lay juror, the determination of the likelihood of consumer confusion for both design patent infringement and trade dress infringement is essentially one in the same. Thus, under both design patent and trademark law, a firm may prevent competitors from using designs that are likely to cause confusion and/or deception.

The infringement tests are not the only area of overlap between design patent and trade dress protections for product design: the subject matter is equally comparable.<sup>197</sup> The most obvious similarity between design patent law and trade dress law is that both are aimed at protecting non-functional features. Additionally, similarities also exist in the requirements for qualifying for protection under both doctrines. The distinctiveness requirement for trade dress and the nonobviousness and novelty requirements for design patents are akin in that both measure the amount of singularity the claimant needs to attain protection. Therefore, it is evident that both the Lanham Act and the Patent Act actually provide similar protection for similar subject matter. As a result, trade dress protection of product designs has the potential for undermining the goals of the Patent Act by extending a patentee’s monopoly on a particular design beyond the absolute time limits established by Congress and commanded by the Patent Clause. One commentator points out some salient similarities and dissimilarities between trade dress and design patents, stating:

Because the trade dress and design patent protection are arguably nearly identical following *Egyptian Goddess*, allowing the overlap of protection would essentially create an extended right. This rights overlap is particularly

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<sup>195</sup> See Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845 (2003) (stating that both “trademark and design patent infringement focus on the commercial impact of the competing works”).

<sup>196</sup> Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2020). Also, §32 regarding registered marks.

<sup>197</sup> In this regard, section 43(a) of the Lanham Act significantly broadened the availability of trademark-type protection for product designs beyond protection for designs actually registered and thus protectable under 32(1). This also complicated the *Compco* phrase “or other federal statutory protection”. See generally Germain, *supra* note 123. Whereas *Compco* (and *Sears*) both applied to federal law versus state law conflicts, resolvable via the Supremacy Clause, once trade dress became federalized, via registration or even section 43(a) of the Lanham Act, the conflict became federal law versus federal law, and there the Supremacy Clause is no help at all. Thus enters the concept of Superfluity, as will be explained in further detail below.

troublesome because together they cancel out each other's limitations. Trade dress protection for product design requires that secondary meaning be established before the protection attaches, a burden much lessened by the immediate protection a design patent grants. Design patents allow immediate protection, but they are limited because they only last for a short period of time. However, trade dress protection could extend the same right indefinitely.<sup>198</sup>

The question is not simply whether the limits of the Patent Clause apply to federal patent laws, but whether those limits impact any laws that may grant patent-like protection under the guise of another federal legislative scheme. As discussed above, it is well recognized that protection for product design trade dress has the potential to overlap with design patent protection.<sup>199</sup> Both intellectual property systems are eligible to provide some form of protection to the configuration of a particular product. Unlike patent protection (which will at some point expire, thus comporting with the Patent Clause requirement that protections exist only “for limited times”), federal trade dress protection (provided pursuant to the Commerce Clause) is potentially limitless: it remains effective for as long as the trade dress continues to serve as an indication of source.<sup>200</sup>

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<sup>198</sup> Ellie B. Adkins, *Unchecked Monopolies: The Questionable Constitutionality of Design Patent and Product Design Trade Dress Overlap in Light of Egyptian Goddess, Inc. v. Swisa, Inc.*, 4 INTELL. PROP. BRIEF 57, 67 (2013).

<sup>199</sup> See e.g., *Jenny Yoo Collection, Inc. v. David's Bridal, Inc.*, No. 1:16—cv—02647 (S.D.N.Y. filed Apr. 8, 2016) (alleging both trade dress and design patent infringement in designs of convertible bridesmaid's dresses); *Deckers Outdoor Corp. v. J.C. Penney Co. Inc.*, 45 F. Supp. 3d 1181 (C.D. Cal. 2014); *Puma SE v. Forever 21, Inc.*, No. CV17-2523 PSG Ex, 2017 U.S. Dist. LEXIS 211140 (C.D. Cal. June 29, 2017) (alleging trade dress and design patent infringement in a line of designer footwear). Courts have explicitly endorsed these overlapping claims. See *Kohler*, 12 F.3d at 638 (“[A] product's different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.”).

<sup>200</sup> As explained by the Petitioners in *Traffix*,

The consequences of this phenomenon [the notion of federal trade dress protection in a product's configuration] are far-reaching, and bring federal trademark law into direct conflict with patent law and the policies underlying that law. Quite unlike product packaging, labeling, or even ornamental design, there are typically only a finite number of configurations or shapes that a product may take. That is especially true in the case of a utility patented invention, made to perform a particular use or function. At the same time, cloaking product configurations with federal trade dress protection does not simply give the producer a tool to strengthen source identification of its product, but the perpetual right to use that configuration for as long as the producer likes, effectively - and indefinitely - taking the configuration out of the public domain. In the case of a patented invention, this result directly interferes with the constitutionally grounded and time-honored right of the public to copy and use the subject of expired patents. And, as explained next, there is no reason to conclude that Congress intended Section 43(a), or any other provision of the Lanham Act, to achieve that result.

U.S. Pet. Brief, *supra* note 36 at 27.

Thus, herein lies the Constitutional conflict: trade dress protection of product designs, federalized<sup>201</sup> through section 43(a) of the Lanham Act which was enacted under the broad constitutional power grant of the Commerce Clause,<sup>202</sup> conflicts with the Patent Clause by offering potentially unlimited, patent-like protection to designs that never met or do not meet the criteria for patentability (e.g., the invention must at least be novel, useful, and nonobvious), thereby evading the “Limited Times” provision of the Patent Clause.<sup>203</sup> As explained by one commentator in discussing the eligibility for trade dress protection *after* design patents expire, “we have no means to

<sup>201</sup> As explained by Dowell, *supra* note 64 at 168-69:

Federal trademark law is no different from state trademark law. The standards for federal and state trade dress infringement claims are the same. The Lanham Act merely federalizes the common law of trademarks and unfair competition. As applied to product designs, section 43(a) of the Lanham Act prohibits “any false designation of origin” that is “likely to cause confusion, or to cause mistake, or to deceive.” Courts have read into this general prohibition all of the technical requirements for trademark protection of a product design. The doctrines of secondary meaning/inherent distinctiveness, functionality, and the multifactor confusion test are entirely judge-made and a product of the common law. Because federal and state trademark law are the same, any conflict between federal patent law and state trademark law must also exist between federal patent law and federal trademark law.

<sup>202</sup> U.S. Const. art. I, § 8, cl. 3, known as the Commerce Clause, states that the United States Congress shall have power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.”

<sup>203</sup> About 15 years ago, Professor Welkowitz, in an insightful article, *The Supreme Court and Trademark Law in the New Millennium*, 30 WM. MITCHELL L. REV. 1659 (2004), saw this latest conflict in the context of copyright law. In his view, *Wal-Mart*, *TraFFix*, and *Dastar* all “resisted uses of trademark law that prevent copying of public domain materials.” *Id.* at 1687. Specifically:

[In *Dastar*], the Court again asserted that the Lanham Act’s foundations “were not designed to protect originality or creativity.” In what must be termed a rather ironic use of a recent case, it concluded: “To hold otherwise would be akin to finding that [section] 43(a) created a species of perpetual patent and copyright, which Congress may not do.” Citing *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003) . . . for the limiting proposition in *Dastar* demonstrates just how far removed the Court wants trademark law to be from traditional intellectual property.

*Id.* (quoting *Dastar*) (citations omitted) (emphasis added). He soon expanded by writing:

The primary message seems to be that the post-Lanham Act expansion of trademark law into something akin to traditional intellectual property law deeply concerns the Court. Admittedly, the justices may have different reasons for their concerns . . . . Several of the Justices may be concerned that Congress is beginning to reach the boundaries of its enumerated powers. Although the Commerce Clause gives Congress broad power to regulate, the existence of a specific power to regulate intellectual property, a power that allows rights only for “limited times” and that impliedly contains other limitations, may be viewed as an implicit limit on Congress’s power to expand the scope of trademark rights, especially where those rights would rival the limited intellectual property rights provided in the Patent and Copyright Clause.

*Id.* at 1689 (citing *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991)) (other citations omitted). And finally, he opined that “the Court may be signaling that there are limits to Congress’s power to regulate these areas under the Commerce Clause, as opposed to the Patent and Copyright Clause.” *Id.* at 1700.

reconcile the issue,” therefore, “we have to directly confront the issue between the right of the public to copy and trade dress protection.”<sup>204</sup>

*TrafFix*<sup>205</sup> provided the Supreme Court with an opportunity to address the potential conflict between “unlimited” trade dress protection and the limits provided by the Patent Clause. Although the Court resolved the dispute before it on the basis of the doctrine of functionality, it went out of its way to highlight the underlying and still unresolved constitutional issue.<sup>206</sup>

[Defendant] and some of its amici argue that the Patent Clause of the Constitution of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection. We need not resolve this question. If, despite the rule that functional features may not be the subject of trade dress protection, a case arises in which trade dress becomes the practical equivalent of an expired utility patent, that will be time enough to consider the matter.<sup>207</sup>

As the Court was able to resolve the issue without reaching the constitutional question, it prudently declined to reach that question.

The *TrafFix* opinion signaled a first step toward considering the conflict between the Patent Clause and trade dress protection provided pursuant to the Commerce Clause.

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<sup>204</sup> 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, 686 (2007). In a recent opinion, the Third Circuit explained:

By contrast, trademark law protects not inventions or designs per se, but branding. A trademark is a “word, name, symbol, or device . . . used by a person[] . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. §1127. Trademark law can protect a product’s “trade dress[,] [which] is the overall look of a product or business.” *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 308 (3d Cir. 2014). That includes not only a product’s packaging but also its design, such as its size, shape, and color. *Id.*; *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000).

*Ezaki Glico Kabushiki Kaisha v. Lotte Int’l Am. Corp.*, 986 F.3d 250, 255-56 (3d Cir. 2021).

<sup>205</sup> 532 U.S. 23 (2001).

<sup>206</sup> Functionality, including aesthetic functionality, is a purely judge-made doctrine designed to reconcile the tension between the patent and trademark laws. See Christopher J. Kellner, *Rethinking the Procedural Treatment of Functionality: Confronting the Inseparability of Useful, Aesthetically Pleasing, and Source-identifying Features of Product Designs*, 46 EMORY L.J. 913 (1997). The doctrine of functionality was eventually codified in the Lanham Act, 15 U.S.C. § 1115 (Section 33(b)(8) of the Lanham Act). However, some view the term “aesthetic functionality” as oxymoronic, a view that the authors disagree with. See MCCARTHY, *supra* note 134, § 7:81, at 7-298 (“Aesthetic functionality is an oxymoron. Ornamental aesthetic designs are the antithesis of utilitarian designs.”).

<sup>207</sup> It is notable that the granted writ of certiorari included “the issue whether the existence of an expired utility patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design. *TrafFix*, 532 U.S. at 28.

But the case's focus on utility patents and the doctrine of functionality resolved the controversy, providing little guidance on how to handle the question of whether the non-functional features claimed in an expired *design* patent could thereafter be protected as trade dress, thereby arguably extending the design patent from a type of protection offered "for limited times" to one of potentially limitless duration.<sup>208</sup>

Notably, the issue presented to the Supreme Court in *TrafFix* did not develop overnight. Leading up to the *TrafFix* decision, a number of lower courts had been faced with the issue, each concluding that the same feature *can* simultaneously or sequentially be protected under some combination of the patent and trademark laws, upholding an anti-copying protectionist status quo.<sup>209</sup> In the discussion below, we will review how most of the lower courts, with their protectionist attitudes, improperly restricted the public's right to copy. Notably, these decisions have essentially denied that such a right exists, with discussions that seldom go beyond a conclusory assertion that the same feature *can* simultaneously or sequentially be protected through a combination of patent and trademark laws.

### VIII. 20<sup>TH</sup> CENTURY APPROACH LEADING UP TO *TRAFFIX*

As evidenced by the *Singer*, *Sears*, *Compco*, and *Bonito-Boats* decisions, for over 100 years the Supreme Court has been defending the public's right to copy, standing up time and again against protectionists.<sup>210</sup> It's quite clear that protectionism is proliferating in the niche practice of intellectual property. Clients pay lawyers *to protect* their intellectual property, which is often the foundation of their business, so, naturally, lawyers are going to "zealously" pursue every available option to protect their clients' interests. Patent law is designed to encourage innovation and the dissemination of knowledge.<sup>211</sup> The reasonable underlying belief is that a societally optimal level of innovation requires some degree of invention protection to

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<sup>208</sup> See generally Clifford W. Browning, *TrafFix Revisited: Exposing the Design Flaw in the Functionality Doctrine*, 94 TRADEMARK REP. 1059, 1059 (2004); see also Karl Horlander, *The U.S. Constitutional Limits of Product Configuration Trade Dress Rights*, 97 TRADEMARK REP. 752, 753-56 (2007).

<sup>209</sup> See generally Saidman, *supra* note 65, at 839 (discussing how anti-copying, or protectionist, attitudes appear in these and other court opinions leading up to the *TrafFix* decision).

<sup>210</sup> See section II of this Article.

<sup>211</sup> See *Graham*, 383 U.S. at 7-9 (1966).

incentivize creation and knowledge dissemination.<sup>212</sup> However, granting that some level of protection is necessary, overprotection imposes clear losses on consumers and competitors. Protectionist attitudes and judicial status quo have led to the acceptance of a conflict-containing dual protection strategy for product designs.<sup>213</sup>

As noted above, a number of lower courts have concluded that the same feature *can* simultaneously or sequentially be protected under some combination of design patent and trademark laws.<sup>214</sup> This, indeed, is the traditional view, as expressed in a number of cases. In this regard, two decisions by the former Court of Customs and Patent Appeals (CCPA)<sup>215</sup> form the cornerstone for many later court decisions that find no conflict between trademark law and patent law and, more particularly, condone the use of trade dress and design patent for dual protection of a product's configuration.

In the first case, *In re Mogen David Wine Corp.*,<sup>216</sup> the CCPA allowed trademark registration of a product configuration (a wine bottle design)

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<sup>212</sup> As explained by James Madison, because an invention is the fruit of individual labor, the individual should reap the reward. Also, society benefited by rewarding the inventor. Through the reward of a government-sponsored monopoly, invention and public disclosure are encouraged. "The right to useful inventions . . . belong[s] to the inventors. The public good fully coincides . . . with the claims of individuals." THE FEDERALIST No. 43, at 309 (James Madison) (B. Wright ed., 1961).

<sup>213</sup> One commentator referred to section 43(a) as "the most protectionist design law of them all." See Melissa R. Gleiberman, *From Fast Cars to Fast Food: Overbroad Protection of Product Trade Dress Under Section 43(a) of the Lanham Act*, 45 STAN. L. REV. 2037 (1993) (citing J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6, 87 (1989)).

<sup>214</sup> See e.g., *In re Mogen David Wine Corp.*, 328 F.2d at 930; *In re Yardley*, 493 F.2d at 1394; *Ferrari S.P.A. Esercizio Frabrice Automobili E Corse*, 944 F.2d at 1240; *Kohler Co.*, 12 F.3d at 638-39; *Mechanical Plastics Corp. v. Titan Techs., Inc.*, 823 F. Supp. 1137, 1142 (S.D.N.Y. 1993) (holding, "a product's different aspects can be protected simultaneously by more than one of the statutory means for the protection of intellectual property."); *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 903 F. Supp. 1457, 1460-61 (D. Kan. 1995) (while the court showed concern about acquisition of secondary meaning during the design patent period, the court denied summary judgment for the defendant, emphasizing that no court had refused dual protection.); *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 959-60 (S.D.N.Y. 1995) (holding that there is no conflict between design patent and trade dress protection because the protections serve different purposes, and further stating that this view is consistent with other cases.); *Topps Co. v. Gerrit J. Verburg Co.*, 1996 U.S. Dist. LEXIS 18556 (S.D.N.Y. 1996); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998).

<sup>215</sup> These two decisions are *In re Mogen David Wine Corp.*, 328 F.2d 925, (C.C.P.A. 1964) and *In re Honeywell, Inc.*, 497 F.2d 1344 (C.C.P.A. 1974).

<sup>216</sup> 328 F.2d 925.

notwithstanding the fact that the configuration was the subject of an expired design patent. In so holding, the court totally and blithely ignored the established doctrine of patent law that indubitably provides others with a right to copy the subject matter of an expired patent.<sup>217</sup> Clearly, the absence of any discussion of this “right to copy” recognized by the Supreme Court illustrates the narrow focus of the analysis in *Mogen David*. As noted by one commentator:

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 [CCPA] case came to be taken so seriously by so many courts in their later decisions is therefore somewhat mystifying.<sup>218</sup>

In the second case, *In re Honeywell, Inc.*,<sup>219</sup> which was decided several years after *Mogen David*, the CCPA permitted trademark registration for certain features of a thermostat that were previously claimed in an expired design patent. In so holding, the CCPA stated, “this court decided [in *Mogen David I*] 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.”<sup>220</sup> Neither *Mogen David* nor *Honeywell* mentions any possible constitutional conflict. Most later court decisions addressing the issue of trade dress protection for the subject matter of expired design patents have followed the incomplete *Mogen David/Honeywell* rationale.<sup>221</sup>

One appellate case that deserves attention is *Ferrari S.P.A. Esercizio Fabrice Automobili E Corse v. Roberts*,<sup>222</sup> which demonstrates how a

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<sup>217</sup> See, e.g., *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (explaining that the right to make an article as it was made during the life of a patent “passed to the public upon the expiration of the patent”).

<sup>218</sup> Saidman, *supra* note 65, at 839.

<sup>219</sup> 497 F.2d 1344 (CCPA 1974).

<sup>220</sup> *Id.* at 1348.

<sup>221</sup> For example, in *In re Yardley*, 493 F.2d 1389 (C.C.P.A. 1974), a case involving copyrights, the CCPA held that an overlap in protection was available under the proposition that different IP rights have different purposes, and if a work has many parts it may be appropriate to protect different parts with different regimes.

<sup>222</sup> 944 F.2d 1235 (6th Cir. 1991).



misfocused and overbroad reading of § 43(a) can undermine the integrity of the patent system. The majority in *Ferrari* determined that the exterior shapes and features of two FERRARI (plaintiff) automobiles had acquired secondary meaning and were nonfunctional.<sup>223</sup> The court further held that the plaintiff had proven likelihood of confusion between its cars and the defendant's automobiles.<sup>224</sup> Although the exterior designs of plaintiff's automobiles were potentially patentable, the plaintiff never sought a design patent for either design. Instead, the plaintiff relied on trade dress protection under the Lanham Act which, from the viewpoint of the plaintiff, is far superior because of its potentially infinite duration. In so holding, the majority specifically noted that “[c]ourts have consistently rejected [the] argument that the availability of design patent protection precludes applicability of the Lanham Act for products whose trade dress have acquired strong secondary meaning.”<sup>225</sup> The majority further held that this broad protection did not conflict with federal patent law for two reasons: first, because federal trademark law and federal patent law address different interests and objectives; and second, because *Compro* and *Sears* “involved only the preemption of state unfair competition law by federal patent law, not the scope of federal trademark or unfair competition law.”<sup>226</sup>

In dissent, Judge Kennedy explained that “while the purposes of the Lanham Act and federal patent laws are not identical,” there is nonetheless “some overlap and congruity of purpose among these laws. Both the Lanham Act and federal patent laws affect commercial activity, particularly in the area of design patents.”<sup>227</sup> Undeniably, the *Sears-Compro-Bonito Boats* line of decisions explicitly recognized that federal patent laws and unfair competition laws are interrelated.<sup>228</sup> In Judge Kennedy's view, “the rationale applied in this trilogy of cases . . . applies with equal force to federal trademark laws.”<sup>229</sup> Thus, Judge Kennedy concluded that:

[T]he criteria used by the majority to determine the availability and scope of protection by the Lanham Act for unpatented designs . . . enlarge the Lanham Act's scope of protection beyond its statutory language and congressional intent, and result in an injunction that runs afoul of the Supreme Court's holdings in *Sears*, *Compro* and *Bonito Boats*. Congress intended that the rights

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<sup>223</sup> *Id.* at 1246-47.

<sup>224</sup> *Id.* at 1244.

<sup>225</sup> *Id.* at 1240.

<sup>226</sup> *Id.* at 1241.

<sup>227</sup> *Id.* at 1253 (Kennedy, J., dissenting).

<sup>228</sup> *Id.*

<sup>229</sup> *Id.*

in a design should expire with their design patent. The effect of the majority's holding is to give Ferrari the equivalent of a design patent in perpetuity.<sup>230</sup>

Another noteworthy appellate case is *Kohler Co. v. Moen Inc.*<sup>231</sup> There, the Seventh Circuit decided 2-1, over a thought-provoking constitution-based dissent by Judge Cudahy, that “courts have consistently held that a product’s different qualities can be protected simultaneously, or successively, by more than one statutory means for protection of intellectual property.”<sup>232</sup> The majority opinion utterly fails to directly address the concept of the constitutional right to copy. Instead, it attempts to sweep Judge Cudahy’s concerns aside with two arguments, neither of which is particularly convincing. The first is that trade dress protection is not the equivalent of design patent protection.<sup>233</sup> The majority bases this argument on the fact that the two forms of protection serve different purposes, have different criteria (pointing again to the fact that trademark infringement requires proof of likelihood of confusion), and represent distinct bodies of law.<sup>234</sup> Because of these differences, the majority explains its belief that product design trade dress does not provide patent-like protection for designs:

While a patent creates a type of monopoly pricing power by giving the patentee the exclusive right to make and sell the innovation, a trademark gives the owner only the right to preclude others from using the mark when such use is likely to cause confusion or to deceive.<sup>235</sup>

Although this argument has some superficial appeal, it glosses over the practical effect of providing trade dress protection to product designs: when the design of the product is protected against imitation by others, this protection is virtually the same as that stemming from a design patent. Thus, the product design trade dress does provide “patent-like” protection.<sup>236</sup> Judge

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<sup>230</sup> *Id.* This position aligns with the extreme position taken by one particular author and with which the current authors disagree. See *infra* notes 408-09.

<sup>231</sup> 12 F.3d 632 (7th Cir. 1993).

<sup>232</sup> *Id.* at 638-39.

<sup>233</sup> *Id.* at 637.

<sup>234</sup> See *id.* at 637-38.

<sup>235</sup> *Id.* at 637.

<sup>236</sup> At best, the practical effects of the “additional elements” of secondary meaning and likelihood of confusion seem to be that product design trade dress protection extends only to a portion of the universe of product designs that may be covered by design patents. With respect to those designs it does cover (regardless of whether they were covered by a design patent or even whether they would meet the standards for such protection), product design trade dress protection does provide “patent-like” protection—given that the product design is the mark, there is no way to use the product design without infringing the mark, effectively granting the manufacturer a monopoly in the product design.

Cudahy effectively refutes the majority's reliance on the differences between the two forms of protection as sufficient to obviate any conflict:

It is also incorrect or irrelevant to say that there is no conflict between configuration trademarks and the design patent law, because in a trademark case a plaintiff must also prove secondary meaning and likelihood of confusion. Likelihood of confusion only relates to whether there has been an infringement, not whether a product configuration is entitled to protection in the first place. In fact, *Compco* explicitly rejected likelihood of confusion and secondary meaning as sufficient reasons to grant a monopoly:

A State of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer's reputation for quality and integrity, deceive the public by palming off their copies as the original. *That an article copied from an unpatented article could be made in some other way, that the design is "nonfunctional" and not essential to the use of either article, that the configuration of the article copied may have a "secondary meaning" which identifies the maker to the trade, or that there may be "confusion" among purchasers as to which article is which or as to who is the maker, may be relevant evidence in applying a State's law requiring such precautions as labeling; however, and regardless of the copier's motives, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling.*<sup>237</sup>

The majority's second argument challenges Judge Cudahy's reliance on a number of Supreme Court decisions—including *Sears*, *Compco*, and *Bonito Boats*—as misplaced, because those decisions involved questions of potential conflicts between state and federal law, and were based on the Supremacy Clause.<sup>238</sup> The majority stated that the preemption principles espoused in those cases are inapplicable where a claim under *federal* trademark law is involved, relying in part on the language in *Compco* that referred to the availability of "other federal statutory protection."<sup>239</sup> Further, the majority

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<sup>237</sup> *Id.* at 649 (Cudahy, J., dissenting) (quoting *Compco*, 376 U.S. at 238) (emphasis supplied by Judge Cudahy).

<sup>238</sup> *See id.* at 639. The majority's reading of *Compco* as a Supremacy Clause case appears to be in error, as *Compco*'s holding was grounded in the Patent Clause. *See Davis Jr., supra* note 13, at 610-12 (noting that the *Compco* decision makes "no reference whatsoever" to the Supremacy Clause, and that it "instead expressly rested the outcome on the Supremacy Clause's far more obscure cousin, the [Patent] Clause").

<sup>239</sup> *See id.* at 639-40.

noted that language in *Bonito Boats* even allows for state protection of trade dress without conflict with the federal patent scheme.<sup>240</sup>

Judge Cudahy's dissent contains a compelling rebuttal to each of these points. With respect to the fact that at least some of the cited decisions involved questions of state law, and therefore were concerned with the application of the Supremacy Clause, he stated that compartmentalizing these decisions fails to face the reality that the Lanham Act is effectively nothing more than the federalization of the common law of trademarks and unfair competition.<sup>241</sup> Judge Cudahy further states:

[T]he conflict that the Court found between state law and federal patent law as a prerequisite to preemption in *Sears, Compco* and *Bonito Boats* is exactly the same conflict as would develop between federal patent law and federal trademark law if a design patent could be made perpetual by trademarking the design. As a matter of commercial reality, therefore, the relation of patent law to state unfair competition law is exactly the same as its relation to federal trademark law.<sup>242</sup>

Judge Cudahy also did not see the *Compco* reference to the availability of "other federal statutory protection" for designs as precluding the possibility of a conflict between design patent protection and product design trade dress protection. He argued that the phrase

does not create an exception to the *constitutional* policy consistently pronounced in *Compco*, *Sears* and the cases we have discussed. Although the use of the phrase recognizes the possibility of further congressional action, it does not preclude conflicts between such statutes and the constitution.<sup>243</sup>

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<sup>240</sup> See *id.* at 641 (quoting language from *Bonito Boats* that references permissible limited regulations on the use of product designs to prevent consumer confusion).

<sup>241</sup> See *id.* at 646-47 (Cudahy, J., dissenting). Judge Cudahy is not alone in this assertion:

[C]ritics contend that trade dress laws should still be preempted because these laws are "merely federalized" state common law for trademarks and unfair competition. One of the most compelling arguments for the impermissibility of the interaction between the two acts is the extension of "patent-like" protection after the expiration of a utility or design patent by the use of trade dress law. Further, the two acts allow a product design to obtain indefinite trade dress protection without secondary meaning, resulting in a lack of assurance of the trade dress as a source indicator and circumvention of patent law.

Bonder, *supra* note 40 at 23 (footnotes omitted).

<sup>242</sup> *Id.* at 647.

<sup>243</sup> *Id.* at 646 n.2 (Cudahy, J., dissenting) (emphasis in original). Although Judge Cudahy recognizes that the phrase "other federal statutory protection" is often used to justify application of the Lanham Act to product designs, he does not state one other potential explanation for this phrase—namely, that the phrase may refer to *copyright* protection for product designs. Indeed, interpreting the phrase as a reference to the federal copyright statute

Judge Cudahy also noted that the Supreme Court's reaffirmation of the principles of *Sears* and *Compco* in *Bonito Boats* does not include "any such blanket reference to a federal exemption."<sup>244</sup>

Finally, with respect to the language in *Bonito Boats* that allegedly authorizes state regulation of product designs and other trade dress, Judge Cudahy recognized that the Supreme Court had stated that, although states can pass laws intended to prevent consumer confusion, states' authority to do so is limited:

[T]he majority opinion here seems to read into *Bonito Boats*' careful discussion of permissible state laws an exemption for any state or federal law dealing with trademarks or trade dress. But the Court only acknowledged that states could continue to enact unfair competition laws so long as, and to the extent that, they did not conflict with the federal policy embodied in *Sears/Compco*.<sup>245</sup>

Such limited regulations might include, as suggested by *Sears*, a requirement for *labeling* of the products to prevent consumer confusion.<sup>246</sup>

In concluding his analysis, Judge Cudahy again "grounded" his position on constitutional concerns:

If the issue before us is a conflict between a well-defined statutory scheme (the design patent laws) enacted under a specific and limited constitutional directive (the Patent Clause) and a judicial doctrine (protection of product configurations as trademarks) only remotely incident to a general statutory

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creates a certain internal harmony within the context in which it appears. The court in *Compco* begins by stating that the federal policy embodied in the Patent Clause permits free copying of "whatever the federal patent and copyright laws leave in the public domain." 376 U.S. at 237. It concludes with the thought that "if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will." *Id.* at 238. Simple parallel construction leads to the conclusion that the second statement also refers to copyright. This conclusion is somewhat reinforced when one considers that intervening discussion identifies no other federal statutory protection that might be implicated, and in fact gives short shrift to the lower court's finding that the product design "had, like a trademark, acquired a 'secondary meaning.'" *Id.* Indeed, an interpretation that can be drawn from this language is that evidence of secondary meaning (or evidence that the design would be entitled to trademark protection) is not sufficient to overcome the federal right to copy.

<sup>244</sup> *Id.*

<sup>245</sup> *Id.*

<sup>246</sup> *See* 376 U.S. at 232.

scheme (the Lanham Act), the specific, constitutionally-mandated provisions should control.<sup>247</sup>

As was the case with the constitutional right to copy issue, the majority failed to address this issue in its opinion.<sup>248</sup>

A third appellate case that deserves attention is *Ashley Furniture*,<sup>249</sup> in which the Fourth Circuit similarly determined that, “traditional trade dress protection for product configuration will not undermine either utility or design patent law.”<sup>250</sup> In that case, the plaintiff alleged that the defendant had

<sup>247</sup> *Kohler*, 12 F.3d at 651 (Cudahy, J., dissenting).

<sup>248</sup> Commentators have applauded Judge Cudahy’s *Kohler* dissent. See, e.g., Katherine J. Strandburg, *Rounding the Corner on Trade Dress*, 29 YALE J. ON REG. 387, 378-88 (2012), explaining that, “Judge Cudahy penned a well-known dissent [in *Kohler*], later described by commentators as ‘spirited,’ ‘elegant,’ and ‘forceful.’” (internal citations omitted). Further explaining how “recent Supreme Court cases suggest that Judge Cudahy got it right.” See also Margreth Barrett, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering Traffix on the Way to Sears*, 61 WASH. & LEE L. REV. 79, 145 n.287 (2004) (in his “now famous dissent,” Judge Cudahy correctly declared that utility patents and design patents required the same treatment regarding functionality); David W. Opderbeck, *An Economic Perspective on Product Configuration Trade Dress*, 24 SETON HALL LEGIS. J. 327, 347-48 (2000), explaining that:

Judge Cudahy’s dissent in *Kohler* elegantly illustrates the dichotomy of views concerning trade dress protection for product configurations . . . . According to Judge Cudahy, a central theme of Supreme Court patent jurisprudence is the public’s right to copy a non-patented design. In contrast to the majority’s exegesis of *Compco*, Judge Cudahy’s dissent emphasized the Supreme Court’s discussion of the Constitutional mandate that whatever is unprotected by patent and copyright may be freely copied. According to Judge Cudahy, this policy was reinforced in *Bonito Boats*, where the Court recognized that for nearly a century, patent has incorporated a public right to copy and use an article after the patent protection has been exhausted. Judge Cudahy was not concerned that the *Sears-Compco* cases dealt with preemption of state unfair competition law. Because the Lanham Act federalized state unfair competition law, there is a conflict between “a federal statutory scheme rooted in the Constitution and a federal codification of the common law.” Under these circumstances, *the explicit constitutionally-proscribed requirement should control*.

*Id.* (emphasis added). Opderbeck further explains:

Judge Cudahy did not accept the standard response that the functionality doctrine resolves this conflict. He likened a truly “functional” product feature to one that could be protected by a utility patent. An ornamental feature, however, might be protected by a design patent, not a utility patent. Since design patents may protect ornamental designs regardless of whether they are “essential for competition,” a product configuration that was the subject of an expired design patent may nevertheless be protected from copying under the Lanham Act. In Judge Cudahy’s view, this would permit a producer to obtain a monopoly on an essentially generic form outside the patent laws’ boundaries. Judge Cudahy therefore would not have extended trade dress protection to product configurations.

*Id.* at 348.

<sup>249</sup> 187 F.3d 363 (4th Cir. 1999). In this regard, another appellate case worth noting is *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998).

<sup>250</sup> 187 F.3d at 376.

copied one of the plaintiff's designs for a bedroom suite, in violation of federal trade dress law.<sup>251</sup> In passing, the majority confronted the notion that one "justification for heightening trade dress requirements in product configuration cases is the perceived need to protect the boundaries between trade dress, copyright, and patent law."<sup>252</sup> In rejecting this notion, the court downplayed any potential conflict between the two forms of protection, stating, "the trade dress rule that functional aspects of a product, although patentable, are not protectable as trade dress directly eliminates any conflict between patents for useful items and trade dress protection for product configuration."<sup>253</sup>

Critically, the majority opinions in these aforementioned decisions fail to contain *any* significant analysis of the potential *constitutional* conflict between design patent protection and protection of product design trade dress. The *Mogen David* opinion only contains one reference to Article I, Section 8, of the Constitution, and that is found in a quotation from another case, which the court summarily dismissed, stating, "[we]...see no reason to consider appellant's patents except to the extent they may contain evidence of the functionality of the outline shape sought to be registered as a trademark."<sup>254</sup> The court's simplistic mantra was merely that trademark rights exist independently of design patent rights, "under different law and for different reasons."<sup>255</sup> Finally, in many of these cases, courts have referenced the doctrine of functionality as the safeguard that precludes a conflict between patent and trade dress protection.<sup>256</sup> However, the traditional functionality doctrine serves only to obviate a conflict with *utilitarian* features contained in a *utility* patent; it does nothing to resolve any

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<sup>251</sup> *Id.* at 366.

<sup>252</sup> *Id.* at 376.

<sup>253</sup> *Id.* The court further reasons:

[P]ermitt[ing] such trade dress protection would not impermissibly give the trade dress plaintiff a perpetual design patent . . . Trade dress rights do, of course, persist indefinitely, while design patents provide only 14 years of protection. But the trade dress plaintiff must establish likelihood of customer confusion in order to be protected at all "which the design patent owner need not do; there is therefore no necessary inconsistency between the two modes of protection." Moreover, "compared to patent protection, trademark protection is relatively weak because it precludes competitors only from using marks that are likely to confuse or deceive the public." It should also be noted that trade dress rights, although of indefinite duration, are not necessarily perpetual. Such rights terminate if the trade dress is abandoned, or if the trade dress becomes generic through public usage . . . A current design patent, by contrast, would continue to provide protection regardless of such eventualities.

*Id.* (internal citations omitted).

<sup>254</sup> *See* 328 F.2d at 931.

<sup>255</sup> *Id.* at 930.

<sup>256</sup> *See* *W.T. Rogers Co. v. Keene*, 778 F.2d 334 (7th Cir. 1985).

potential conflicts between trade dress protection for ornamental product designs and design patent protection. Judge Posner—as early as 1995—expressly noted the limitations of the functionality doctrine when he wrote: “[P]rovided 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.”<sup>257</sup>

In summary, the most well-developed constitutional discussion of this issue comes in the *Kohler* decision—however, the substance is found in the dissenting opinion by Judge Cudahy, not in the majority opinion that held there was no conflict.<sup>258</sup> Judge Cudahy found that allowing trade dress protection for product designs conflicts with the “right to copy” inherent in the Patent Clause and recognized by the Supreme Court for more than a hundred years.<sup>259</sup> He concluded that, at a fundamental level, protecting product design as trade dress is an unconstitutional violation of the Patent Clause.<sup>260</sup>

To reach this conclusion, Judge Cudahy referenced a number of older Supreme Court cases, including *Scott Paper*, *Kellogg*, and *Singer*. The heart of his constitutional objection, however, appears to be rooted in this language from the *Compco* decision:

To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent . . . laws leave in the public domain. Here [Plaintiff’s] fixture has been held not to be entitled to a design or mechanical patent. Under the federal patent laws it is, therefore, in the public domain and can be copied in every detail by whoever pleases. It is true that the trial court found that the configuration of [Plaintiff’s] fixture identified [Plaintiff] to the trade because the arrangement of the ribbing had, like a trademark, acquired a “secondary meaning” by which that particular design was associated with [Plaintiff]. But if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will.<sup>261</sup>

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<sup>257</sup> *Id.* at 337 (emphasis added).

<sup>258</sup> The majority summarily disposed of *Kohler*’s constitutional arguments, holding that, “[i]n sum, courts have consistently held that a product’s different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.” *Kohler*, 12 F.3d at 638.

<sup>259</sup> *See id.* at 644 (Cudahy, J., dissenting).

<sup>260</sup> *See id.*

<sup>261</sup> 12 F.3d at 646 (Cudahy, J., dissenting) (emphasis in the original) (quoting *Compco*, 376 U.S. at 237-38).



He viewed the Supreme Court's later *Bonito Boats* decision as reaffirming this principle.<sup>262</sup> The clear focus of Judge Cudahy's concern is the right to copy or freedom to copy a product design that is *not* protected by patent (or copyright):

What is at stake here is the right to copy the thing itself—that is, to copy its configuration or design. The configuration or design of a product is as generic as the name of the product. As the Supreme Court cases demonstrate, the constitutional right to copy after a patent expires or in the absence of a patent is the reciprocal of the constitutional right to prohibit copying for a limited term under the Patent Clause. To ignore this principle is to permit perpetual monopolies on product ideas or particular product designs and to inhibit product development.<sup>263</sup>

#### IX. THE SUPREME COURT'S 21ST CENTURY TREATMENT OF THE ISSUE

In *Wal-Mart Stores, Inc.*, decided in 2000, the Court determined that in a civil action under § 43(a) of the Lanham Act for infringement of unregistered trade dress, product configuration trade dress will be deemed distinctive, and therefore protectible, *only* upon a showing of secondary meaning.<sup>264</sup> In *Wal-Mart*, the plaintiff designed and sold children's clothes, which the defendant copied with only minor changes.<sup>265</sup> The issue for the Court to decide can be summarized as, under what circumstances is a senior product's design distinctive, and therefore protectible, in an action for infringement of unregistered trade dress?<sup>266</sup> In answering that question, the Court held that, "in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning."<sup>267</sup> In so holding, the Court was forced to confront its previous holding in *Two Pesos, Inc. v. Taco Cabana, Inc.*,<sup>268</sup> which had been decided only eight years prior.<sup>269</sup> The holding in *Two Pesos* amalgamated the two types of trade dress,

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<sup>262</sup> *See id.*

<sup>263</sup> *Id.* at 647 (Cudahy, J., dissenting).

<sup>264</sup> *See Wal-Mart Stores, Inc.*, 529 U.S. at 216.

<sup>265</sup> *Id.* at 207.

<sup>266</sup> *Id.*

<sup>267</sup> *Id.* at 216.

<sup>268</sup> 505 U.S. 763 (1992).

<sup>269</sup> The respondent in *Wal-Mart* asserted that the Court's decision in *Two Pesos* forecloses a conclusion that product-design trade dress can never be inherently distinctive. *Wal-Mart Stores, Inc.*, 529 U.S. at 214. In response, the Court explained:

package and design, saying they were to be treated the same.<sup>270</sup> The Court in *Wal-Mart* judicially side-stepped<sup>271</sup> its previous holding in *Two Pesos* by attempting to carefully differentiate the two types of trade dress and then treat them separately and significantly differently. In any event, the practical effect of *Wal-Mart* created a catch-22 for practitioners, as succinctly summarized by one commentator:

[W]hat will a [product owner] do if it believes that its device has source-identifying product configuration trade dress but it does not wish to risk losing that source-identifying significance in a race to secondary meaning in the market with potential competitors?<sup>272</sup>

This commentator answered this question by explaining, simply:

The [product owner] will elect to file a design patent application that claims the nonfunctional, ornamental features of the product configuration trade dress of the device. The [product owner] will then have the 14-year term of the design patent within which to claim exclusive rights to use the product configuration trade dress in the market, thereby preventing any competitors from entering the race to secondary meaning using the patent laws as an enforcement sword.<sup>273</sup>

One year after the *Wal-Mart* decision, the Court in *TrafFix* signaled a first step toward considering the conflict between the Patent Clause and trade dress protection provided pursuant to the Commerce Clause. In *TrafFix*, the Court was presented with a claim for trade dress infringement based on a copied design that had been the subject of an expired utility patent.<sup>274</sup> Instead of considering the right to copy, the Court based its holding on

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In that case, we held that the trade dress of a chain of Mexican restaurants, which the plaintiff described as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals,” 505 U.S., at 765 (internal quotation marks and citation omitted), could be protected under § 43(a) without a showing of secondary meaning, see *id.*, at 776. *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, see, e.g., *id.* at 773, but it does not establish that *product-design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product *design*. It was either product packaging—which, as we have discussed, normally *is* taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.

*Id.* at 214-15.

<sup>270</sup> See *Two Pesos*, 505 U.S. at 775-76.

<sup>271</sup> It is the opinion of the authors that the Court silently overruled *Two-Pesos* through its opinion in *Wal-Mart*.

<sup>272</sup> Browning, *supra* note 208 at 1059.

<sup>273</sup> *Id.*

<sup>274</sup> See 532 U.S. 23, 25-26.

functionality.<sup>275</sup> 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>276</sup> However, its final paragraph came as close as the Supreme Court has come in recent times to confronting directly the issue of a potential conflict between the limited times protection available for patents and the potentially unlimited protection available for product design trade dress. The Court opted not to decide the patent-related trade dress issue and, instead, based its decision on the functionality doctrine, which originally had been fashioned entirely by lower courts, which only years later was codified in the U.S. Trademark (Lanham) Act.<sup>277</sup> Significantly, the *TrafFix* decision provided little or no guidance on how to handle the question of whether features claimed in an expired *design* patent could thereafter be protected as trade dress, thereby arguably extending the design patent from a type of protection offered for limited times to one of potentially limitless duration. Although the Court disposed of the issue on the basis of the doctrine of functionality, it went out of its way to highlight:

[Defendant] and some of its amici argue that the Patent Clause of the Constitution of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection. We need not resolve this question. If, despite the rule that functional features may not be the subject of trade dress protection, a case arises in which trade dress becomes the practical equivalent of an expired utility patent, that will be time enough to consider the matter.<sup>278</sup>

This statement provides no definitive answer to the underlying constitutional issue; rather, the Court is simply noting that the issue is one that likely will need to be confronted in the future.<sup>279</sup>

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<sup>275</sup> *Id.* at 32.

<sup>276</sup> *Id.* at 29-30.

<sup>277</sup> See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (citing *In re Mogen David Wine Corp.*, 328 F.2d 925, 932 (C.C.P.A. 1964)). The court in *Mogen David* noted: “We 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 under the patent law.” 328 F.2d at 930. See also Lanham Act, §33(b)(8), 15 U.S.C.A. §1052(e)(5) (2021).

<sup>278</sup> *Id.* at 35. It is notable that the granted writ of certiorari included “the issue whether the existence of an expired *utility* patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design.” *TrafFix*, 532 U.S. at 28 (emphasis added). As such, the entire Supreme Court orientation concerned utility patents, not design patents.

<sup>279</sup> *Id.* at 35.

In 2003, in the wake of the *Wal-Mart* and *TrafFix* decisions, the Supreme Court chose to decide *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>280</sup> This case involved the unique circumstance of copying and distributing, totally without attribution, expired copyrighted content, and queried whether § 43(a) of the Lanham Act prevents such use of this work.<sup>281</sup>

In reversing the Ninth Circuit and holding for the Defendant, the Court decided that “origin” (in the phrase “false designation of origin” in Section 43(a)) does not include the creator of the copied underlying work.<sup>282</sup> The Court refused to read “43(a) . . . as creating a cause of action for, in effect, plagiarism—the use of otherwise unprotected works and inventions without attribution . . . .”<sup>283</sup> Implicit in the Court’s ruling was a questioning, if not a stoppage, of the historical judicial expansion of § 43(a). The Court emphasized that “§43(a) ‘does not have boundless application as a remedy for unfair trade practices.’”<sup>284</sup> Although the framed issue, and its analysis, looks like a strict and technical matter of defining the word “origin” in the “false designation of origin” phrase, the opinion contained a sweeping and important statement about the nature of trademark protection and its relationship to broad copyright (and patent) policy:

In sum, reading the phrase “origin of goods” in the Lanham Act in accordance with the Act’s common-law foundations (which were not designed to protect originality or creativity), and in light of the copyright and patent laws (which were), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods . . . . *To hold otherwise would be akin to finding that 43(a) created a species of perpetual patent and copyright, which Congress may not do.*<sup>285</sup>

As explained by one commentator, through this decision the Court appears to have been backtracking to “build on its earlier struggles with issues of federal preemption in an attempt to both limit and redefine the role of trademark protection and to create brighter lines of demarcation between trademark and other aspects of intellectual property law.”<sup>286</sup> It should be

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<sup>280</sup> 539 U.S. 23 (2003).

<sup>281</sup> *Id.* at 25.

<sup>282</sup> *See* 539 U.S. at 36.

<sup>283</sup> *Id.*

<sup>284</sup> *Id.* at 29.

<sup>285</sup> *Id.* at 37 (emphasis added).

<sup>286</sup> Sheldon W. Halpern, *A High Likelihood of Confusion: Wal-Mart, TrafFix, Moseley, and Dastar – The Supreme Court’s New Trademark Jurisprudence*, 61 N.Y.U. ANN. SURV. AM. L. 237, 259 (2005).

noted that in 2004—shortly after the Supreme Court’s decisions in *Wal-Mart*,<sup>287</sup> *TrafFix*,<sup>288</sup> *Moseley v. V Secret Catalogue*,<sup>289</sup> and *Dastar*<sup>290</sup>—Professor Welkowitz analyzed the Court’s sea-changed attitudes toward the relationship between trademark law, on the one hand, and patent and copyright laws, on the other hand. He cogently explained:

The Supreme Court’s four trademark opinions this millennium have three critical factors in common: . . . (iii) all four decisions took a narrow view of the protective umbrella afforded by the trademark laws. The clarity of these results is striking—obviously, the Court is sending a message. One part of the message is clear: the Court is unhappy with the expansive view of trademark protection put forth by many lower courts. This unhappiness appears to stem from the Court’s conviction that trademark law remains an offshoot of unfair competition rather than a subset of intellectual property law.<sup>291</sup>

[T]he Court’s trademark case in 2000—*Wal-Mart*—represents a fairly clear break from the bulk of the Court’s late twentieth century trademark jurisprudence. It also marks a clear beginning of a jurisprudence that harkens back to the late nineteenth and early twentieth centuries and its discomfort with the treatment of trademarks as a species of intellectual property.<sup>292</sup>

As if to make clear that trademark law is different from copyright and patent, the Court noted that those doctrines would permit protection for many product designs, and ameliorate the consequences of its decision. In other words, the message to trademark owners is, if you want intellectual property protection, use “real” intellectual property doctrines, not trademark law.<sup>293</sup>

And finally, “Ordinary trademark law is grounded in unfair competition and consumer protection, not intellectual property.”<sup>294</sup>

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<sup>287</sup> 529 U.S. 205, 210 (2000).

<sup>288</sup> 532 U.S. 23 (2001).

<sup>289</sup> 537 U.S. 418 (2003). *Moseley* is a leading authority on trademark dilution which, unlike traditional trademark infringement claims, does not require any showing of likelihood of confusion. According to Welkowitz, “like *Wal-Mart* and *TrafFix*, *Moseley* presented the Court with an issue of the extent of trademark protection in a new and different form from that found in traditional cases.” Welkowitz, *supra* note 158 at 1681-82. Welkowitz further explained, “[t]he Court again emphasized the consumer protection and unfair competition roots of trademark law and took a narrow view of trademark protection, the scope of which is more akin to a property right than to consumer protection.” *Id.* at 1684.

<sup>290</sup> 539 U.S. 23 (2003).

<sup>291</sup> Welkowitz, *supra* note 158 at 1660.

<sup>292</sup> *Id.* at 1676 (footnotes omitted).

<sup>293</sup> *Id.* at 1678-79.

<sup>294</sup> *Id.* at 1683.

In *Wal-Mart*, the Supreme Court significantly curtailed use of the Lanham Act to prevent product design approximations.<sup>295</sup> The Court's opinion in *TrafFix* substantially furthers that undertaking. Whereas the Court explicitly avoided the right to copy issue, the Court clarified 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>296</sup>

That said, years earlier, the Court arguably had acknowledged that both types of protection may be available for the same design (whether simultaneously or sequentially) without conflict.<sup>297</sup> In *Bonito Boats*, for example, the Court stopped short of holding that its prior *Sears* and *Compco* decisions precluded any state regulation of items that fall within the broad scope of patentable subject matter, noting that the *Sears* decision expressly left open the possibility that trademark and other unfair competition laws can be used to protect trade dress—identified as "potentially the subject matter of design patents"—so as to prevent purchasers from being misled as to the source of goods.<sup>298</sup> But this was oblique. Although the *Wal-Mart* Court noted that a manufacturer could obtain protection for a product design that had not yet obtained secondary meaning by securing a design patent or copyright, the Court fell short of saying that the two types of protection could coexist without conflict.<sup>299</sup> Indeed, that Court further failed to make mention of patent law's specific statutory scheme rooted in the Constitution and the Constitutional conflict that would result from allowing dual protection for product design.<sup>300</sup>

The language in *Bonito Boats* and *Wal-Mart* hardly seems to close the door on the matter, at least not in the eyes of the Supreme Court. Certainly, the Court's concluding paragraph in *TrafFix*—written twelve years after *Bonito Boats* and one year after *Wal-Mart*—provides strong evidence that the Court considered the issue unresolved.

The simple fact is that, although the language in these cases points to the *possibility* of overlapping protection, it stops far short of holding that both types of protection actually are available. Careful reading of the opinions raises questions about the intended scope of the relevant statements. First,

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<sup>295</sup> See 529 U.S. at 213.

<sup>296</sup> *Id.* at 35.

<sup>297</sup> See *Bonito Boats*, 489 U.S. 141 (1989).

<sup>298</sup> See 489 U.S. at 154.

<sup>299</sup> See 529 U.S. 205, 214 (2000).

<sup>300</sup> See *id.*

there is some question as to whether the language in *Bonito Boats* applies to matter for which a patent actually has been obtained. To use the words of the Court, the language of *Sears* that authorizes states to place some conditions on the use of trade dress gives rise to “an implicit recognition that all state regulation of potentially patentable but unpatented subject matter is not *ipso facto* pre-empted by the federal patent laws.”<sup>301</sup> The reference to “unpatented subject matter” may imply that no such conditions can be placed on patentable subject matter for which a patent was, in fact, not obtained.

More importantly, just as *Bonito Boats* stopped short of saying that trademark protection never can be extended to patentable subject matter, that case also does not state that full trademark protection should be afforded to patentable subject matter. The Court merely stated that “limited regulations” and/or “some conditions” can be placed on the use of patentable designs “in order to prevent consumer confusion as to source.”<sup>302</sup> Further, the Court explained that “we have consistently reiterated the teaching of *Sears* and *Compco* that ideas once placed before the public without the protection of a valid patent are subject to appropriation *without significant restraint*.”<sup>303</sup> Phrases such as “limited regulations” and “without significant restraint” do not appear to equate with full trademark protection. More suitable as a “limited regulation” is the example given by the Court in *Sears*, namely, that manufacturers be required to label their products to prevent consumer confusion.<sup>304</sup>

Indeed, other language in *Bonito Boats* suggests that there are strict and narrow bounds to the restrictions that can be placed legally on the use of patentable subject matter. For example, the Court identified, as a matter of federal policy, a “federal right to ‘copy and use’” the subject matter of an expired patent.<sup>305</sup> Further, the Court indicated that a law that protects a formerly-patented product from copying undermines the entire patent system:

A state law that substantially interferes with the enjoyment of an unpatented utilitarian or design conception which has been freely disclosed by its author

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<sup>301</sup> 489 U.S. at 154 (emphasis added).

<sup>302</sup> 489 U.S. at 154, 165.

<sup>303</sup> *Id.* at 156 (emphasis added).

<sup>304</sup> *See Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 232 (1964).

<sup>305</sup> *See* 489 U.S. at 165.

to the public at large impermissibly contravenes the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy.<sup>306</sup>

Although this language expressly refers to *state* law, the reasoning of the Court—including the underlying principle that publicly-known ideas “are the tools of creation available to all” —would appear to be equally applicable to any federal law that “substantially interferes” with the use of a utilitarian or design concept disclosed through a patent.<sup>307</sup>

Finally, it should be noted that in discussing trademarks and trade dress, the *Bonito Boats* Court spoke in terms of “trademarks, labels, or distinctive trade dress in the packaging of goods.”<sup>308</sup> Not mentioned is product design trade dress. Although protection for product design was not unheard of in 1989, it apparently did not gain real momentum until the 1990’s.<sup>309</sup> Hence, there is some question as to whether the statements in *Bonito Boats* would apply equally to product design trade dress claims.<sup>310</sup>

The discussion in *Wal-Mart* regarding the possibility of obtaining a design patent also falls short of saying that the two types of protection can coexist without conflict. There the Court did not expressly rule that both could simultaneously coexist for the same feature<sup>311</sup>—it merely noted that the availability of other protections, such as design patent protection, reduces the harm that might result from the imposition of a requirement that a party only can claim trademark rights in a product design once secondary meaning has

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<sup>306</sup> *Id.* at 156-57.

<sup>307</sup> See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 379 (2d Cir. 1997) (noting that “the Lanham Act must be construed in the light of a strong federal policy in favor of vigorously competitive markets,” and finding *Sears* and *Compco* relevant even if their preemption analysis does not strictly apply to the Lanham Act).

<sup>308</sup> 489 U.S. at 154.

<sup>309</sup> See generally *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 209-10 (2000) (explaining that “in recent years [the concept of trade dress] has been expanded by many courts of appeals to encompass the design of a product”).

<sup>310</sup> *Cf. id.* at 212-15 (providing reasons for treating product design trade dress differently from product packaging trade dress). Indeed, the Court in *Wal-Mart* clearly differentiated between these two types of trade dress, concluding that one (product packaging) can be inherently distinctive whereas the other (product design) cannot, and the default is product design (to protect copying). See *id.* at 215. Compare this restrictive approach of *Wal-Mart* with *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), which was much more expansive.

<sup>311</sup> In fairness, however, the Court did state, without any words of disapproval, that the plaintiff had obtained design patent protection covering “certain elements” of its claimed trade dress. See 529 U.S. at 214.



been established.<sup>312</sup> As discussed above, earlier Supreme Court decisions arguably could be said to have provided a clear answer on this subject, at least in cases where an expired patent is involved.<sup>313</sup> However, while *Singer*, *Kellogg*, and *Scott Paper* all appear to foreclose the possibility of using other forms of protection for patentable subject matter—or at least for subject matter that actually had been protected by a patent—more recent decisions are less clear on the subject. *Sears/Compco*, *Bonito Boats*, and *TrafFix* all presented the Court with the opportunity to build upon the foundation laid by these earlier cases and simply hold that federal patent protection is the only available protection for patentable subject matter. None of these decisions reached that holding, however. Instead, in each instance, the Court applied a non-constitutional rationale and relied upon a different basis to resolve the case before it.

#### X. 21<sup>ST</sup> CENTURY APPROACH OF THE LOWER COURTS

It should be noted that a number of lower court cases following the *Wal-Mart*, *TrafFix*, and *Dastar* decisions have concluded that the same feature *can* simultaneously or sequentially be protected under some combination of the patent and trademark and/or copyright laws.<sup>314</sup> This, indeed, is, and continues to be, the traditional, protectionist view. Notably, although most of the 21<sup>st</sup> Century decisions are district court cases—which only perfunctorily espouse this position—there are new appellate cases that totally blithely assume that trade dress and patent (and/or copyright) claims can coexist.<sup>315</sup>

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<sup>312</sup> See *id.* at 214.

<sup>313</sup> See *supra*, section I.

<sup>314</sup> See *RDF Media Ltd. v. Fox Broad. Co.*, 372 F. Supp. 2d 556, 564 (C.D. Cal. 2005) (stating that “trademark and copyright protection may coexist”); *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1244 (W.D. Wash. 2007) (“Parallel claims under the Copyright Act and Lanham Act, however, are not per se impermissible.”); *Sleep Sci. Partners v. Lieberman*, 2010 U.S. Dist. LEXIS 45385 at \*11 (N.D. Cal., May 10, 2010) (same); *Oldcastle Precast, Inc. v. Granite Precasting & Concrete, Inc.*, 2010 U.S. Dist. LEXIS 53775 at \*8 (W.D. Wash., June 1, 2010) (same); *Solo Cup Operating Corp. v. Lollicup USA, Inc.*, 2017 U.S. Dist. LEXIS 132193 (N.D. Ill. 2017) (constitutional question raised and noted, but then summarily set aside, as avoided by non-functionality).

<sup>315</sup> See, e.g., *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337 (Fed. Cir. 2020); *Craft Smith, LLC v. EC Design, LLC*, 969 F.3d 1092 (10th Cir. 2020).

In a recent opinion, *Lanard Toys Ltd. v. Dolgencorp LLC*,<sup>316</sup> the Federal Circuit affirmed the lower court’s summary judgment holding in favor of the defendant on the plaintiff’s claims for design patent infringement, copyright infringement, trade dress infringement, and unfair competition. The plaintiff made a “Chalk Pencil” and filed suit against the defendant, a competitor, for selling a similar looking product to the plaintiff’s former distributor and retailer. The court viewed each issue in the case as a separate matter warranting a separate analysis, and disposed of each issue individually. In so doing, the court carelessly and casually assumed that the overlap of each cause of action (e.g., trade dress infringement and design patent infringement) was noncontroversial. There was no mention of any possible conflict—constitutional or otherwise.<sup>317</sup>

Another “traditional” appellate case is *Fuji Kogyo Co., Ltd. v. Pac. Bay Int’l, Inc.*<sup>318</sup> In this case, the plaintiff, creator of particular product designs, acquired four utility patents, seven design patents and three trademark registrations. Plaintiff first protected its product design by design patents,<sup>319</sup> but as they began to expire, plaintiff sought to register its product designs as trademarks. Three of these were registered eventually.<sup>320</sup> Later, the Sixth Circuit affirmed the district court’s cancellation of these registrations on the basis of functionality.<sup>321</sup> In its opinion, the appellate court observed that the plaintiff was attempting to extend its patent monopoly through trademark law by obtaining trademark protection for the same configuration that had been protected under its now-expired utility patents.<sup>322</sup> Significantly, the court noted in passing that “[t]he existence of [a] design patent does not preclude the same product from protection as a trademark under the Lanham Act either simultaneously or successively.”<sup>323</sup>

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<sup>316</sup> 958 F.3d 1337, 1339 (Fed. Cir. 2020).

<sup>317</sup> In an analogous case—involving the interface between copyright and trade dress instead of the design patent and trade dress interface—the Tenth Circuit analyzed both copyright infringement and trade dress infringement for the same product without any mention of possible conflict, constitutional or otherwise, between the two types of protection. *See Craft Smith*, 969 F.3d 1092.

<sup>318</sup> 461 F.3d 675 (6th Cir. 2006).

<sup>319</sup> *Id.* at 679.

<sup>320</sup> *Id.*

<sup>321</sup> *Id.* at 690.

<sup>322</sup> *See id.* at 689.

<sup>323</sup> *Id.* at 683 (citing *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 638 (7th Cir. 1993) (noting that a trademark owner has an indefinite term of protection and must also prove secondary meaning and likelihood of confusion in an infringement suit, which the owner of a design patent need not do)). However, in making this assertion, the *Fuji* court totally ignored

However, in *Groeneveld*, decided by the same court a few years later, the Sixth Circuit rejected this view, took a policy-based approach, and stated, “trademark law is designed to promote brand recognition, not to insulate product manufacturers from lawful competition.”<sup>324</sup> Indeed, the *Groeneveld* court starkly contrasted the property-based protections derived from the Patent Clause from the deceit-based protection based on unfair competition principles, stating:

The clear import of the twin principles that copying in the absence of copyright or patent protection often serves useful purposes, and that the concern of trademark law is not about copying per se but about copying that engenders consumer confusion, is that the appropriate “intent” to focus on is not the intent to *copy* but rather the intent to *deceive* or *confuse*.<sup>325</sup>

Other courts have rejected this majority view. For example, the Seventh Circuit, in *Jay Franco & Sons, Inc. v. Franek*,<sup>326</sup> noted that, “many cases say that fashionable designs can be freely copied unless protected by patent law,”<sup>327</sup> and, in holding for the defendant, proclaimed:

Franek chose to pursue a trademark, not a design patent, to protect the stylish circularity of his beach towel. Cf. *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 647 (7th Cir. 1993) (Cudahy, J., dissenting) . . . . He must live with that choice. We

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Cudahy’s dissent in *Kohler*. Separately, the court added that “[a] design patent, counter to a utility patent, is presumptive evidence of nonfunctionality.” *Fuji Kogyo Co., Ltd. v. Pac. Bay Int’l, Inc.*, 461 F.3d 675, 683. The court mainly focused on functionality of the product designs resulting from the expired utility patents and advertisement materials. *Id.* at 684-90. In this regard, it seems that the court could not find an appropriate test to analyze “non-functionality” due to conflicting presumptions. *Id.* at 684. If there had been an apt test for “non-functionality,” the court would have been better equipped to analyze the non-functionality issues resulting from the expired design patents.

<sup>324</sup> See *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 500 (6th Cir. 2013).

<sup>325</sup> *Id.* at 514.

<sup>326</sup> 615 F.3d 855 (7th Cir. 2010).

<sup>327</sup> *Id.* at 860 (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S. Ct. 971, 103 L. Ed. 2d 118 (1989); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S. Ct. 784, 11 L. Ed. 2d 661, 1964 Dec. Comm’r Pat. 425 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S. Ct. 779, 11 L. Ed. 2d 669, 1964 Dec. Comm’r Pat. 421 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S. Ct. 109, 83 L. Ed. 73, 1939 Dec. Comm’r Pat. 850 (1938); *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 16 S. Ct. 1002, 41 L. Ed. 118, 1896 Dec. Comm’r Pat. 687 (1896)).

cannot permit him to keep the indefinite competitive advantage in producing beach towels this trademark creates.<sup>328</sup>

To this end, the courts that have held that multiple types of intellectual property protection can be combined generally note that trademark protection is concerned with interests materially different from patent or copyright protection, and they note that proof of trademark infringement involves considerations (such as proof of likelihood of confusion) that are not required in copyright or patent cases.<sup>329</sup> However, the appropriateness and ability of these additional considerations to avoid a conflict is seriously subject to question.

#### XI. WHAT DO ACADEMICS THINK?

The three most recent—all post-2003—and most focused and in-depth scholarly treatments of the constitutional conflict are articles published by Professor Aaron Perzanowski,<sup>330</sup> Professor Jeanne Fromer<sup>331</sup> and longtime former Permanent Sixth Circuit Legal Advisor Wayne Kalkwarf, in 2008, 2012, and 2014, respectively. Each of these articles deserves detailed explication. First, Perzanowski.

According to Perzanowski, the simple fact is that the Constitution provides two separate and distinct grants of authority that give rise to the *possibility* of at least two types of simultaneous or sequential intellectual property protection being available for the same product design feature. A non-utilitarian product design may be protectable under design patent law under the grant of authority in the Patent Clause (and possibly under copyright law). And, it arguably also may be protectable under trademark law as product design trade dress under the general authority of the Commerce Clause.<sup>332</sup> It has been noted that the Commerce Clause power, as

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<sup>328</sup> 615 F.3d at 861. There was no mention of any possible conflict—constitutional or otherwise.

<sup>329</sup> See, e.g., *supra* note 165 and accompanying text.

<sup>330</sup> Aaron K. Perzanowski, *The Penumbra Public Domain: Constitutional Limits on Quasi-Copyright Legislation*, 10 U. PA. J. CONST. L. 1081 (2008).

<sup>331</sup> Jeanne C. Fromer, *The Intellectual Property Clause's External Limitations*, 61 DUKE L.J. 1329 (2012).

<sup>332</sup> This is the position taken by the courts in cases such as *Ashley Furniture Indus. v. Sangiacomo N.A.*, 187 F.3d 363 (4th Cir. 1999); *Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts*, 944 F.2d 1235 (6th Cir. 1991); and *In re Mogen David Wine*

it is understood today, would enable Congress to enact a variety of laws that have traditionally been enacted pursuant to other grants of power.<sup>333</sup> But does Perzanowski endorse such duplicative protection as constitutionally acceptable? He explains that commentators have identified two theories that inform our ability to identify whether a conflict exists between two different constitutional provisions:

First, because the legislative powers enumerated in the Constitution are cumulative, “what cannot be done under one of them may very well be doable under another.” Second, and equally true, Congress may not circumvent the limits imposed by one provision of the Constitution simply by acting under another grant of authority.<sup>334</sup>

At first glance, these two principles appear to be at odds. One places limits on Congress’ power, while the other denies those limits. The conflict only exists when each is considered separately. However, read carefully and in conjunction with one another, the two merge to provide the basic principle for Constitutional analysis. As explained by Perzanowski:

In isolation, neither fully accounts for the complex interactions between the provisions of [the Constitution], but taken together, they explain that Congress is free to legislate under any sufficient constitutional grant, so long as it does not contravene applicable limitations elsewhere in the Constitution.<sup>335</sup>

He does note, however, that “determining whether a limit constrains other grants of authority is not always an easy task.”<sup>336</sup> As explained by

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Corp., 328 F.2d 925 (C.C.P.A. 1964) (all holding that both patent protection and trade dress protection can coexist for the same product features).

<sup>333</sup> *But see* United States v. Lopez, 514 U.S. 549, 588 (1995) (Thomas, J., concurring) (explaining that the broad reach of the modern Commerce Clause power could easily encroach on other specific grants of constitutional power).

<sup>334</sup> Perzanowski, *supra* note 330, at 1088 (citations omitted); *see also* Andrew M. Hetherington, *Constitutional Purpose and Inter-clause Conflict: The Constraints Imposed on Congress by the Copyright Clause*, 9 MICH. TELECOMM. TECH. L. REV. 457, 459-60 (2003) (noting that “the prevailing view among legal academics is . . . that Congress may not ignore the restrictions on its power contained in one clause merely by legislating under another clause,” but also recognizing that some courts have concluded that “as a general matter, the fact that legislation reaches beyond the limits of one grant of legislative power has no bearing on whether it can be sustained under another” (internal quotation marks omitted)).

<sup>335</sup> Perzanowski, *supra* note 330, at 1088.

<sup>336</sup> Perzanowski admits his article is aimed at “the copyright power of Clause 8, but the general principles and some of the limits addressed are equally applicable to the patent power.” *Id.* at 1082, n.4. Although the focus of the present article is on (design) patents, it

Malla Pollack, “[t]he constitutional phrase ‘limited times’ should be interpreted to mean that Congress’ exclusive grants to authors and inventors must be temporally finite.”<sup>337</sup> Thus, “although Congress has passed intellectual property statutes by relying on the Commerce Clause, none of these statutes attempts to bypass the ‘limited times’ provision.”<sup>338</sup> Pollack concluded by stating that, “[no commentator] has suggested a theory that allows Congress to bypass the ‘limited times’ provision.”<sup>339</sup>

The basic principle espoused here—that a conflict exists where legislation clashes with the objectives or the limitations imposed by other applicable law—is essentially the same principle that underlies Supremacy Clause jurisprudence. Under the Supremacy Clause, if a particular state law stands as an obstacle to the accomplishment of the “full purposes and objectives” of federal law, the two are in conflict, and the state law is preempted.<sup>340</sup> Analogously, in cases of potential inter-Clause conflict, if a particular law enacted pursuant to one grant of authority stands as an obstacle to the accomplishment of the “purposes and objectives” of another grant, the two are in conflict.<sup>341</sup> The only practical difference between cases involving the Supremacy Clause and cases involving inter-Clause conflicts is the difficulty in determining which law prevails. In Supremacy Clause cases, a clear hierarchy exists and informs that, in cases of a conflict between federal and state laws, federal law prevails.<sup>342</sup> No such hierarchy exists in terms of the various Clauses of Section 8 of Article I of the Constitution. Each Clause stands alongside the other as a separate and alternative grant of congressional power.<sup>343</sup>

Although the Supreme Court cases on inter-Clause conflicts do not reveal a consistent approach, Perzanowski views these cases as demonstrating “a general receptiveness to the notion that the limits of one enumerated power may, under appropriate circumstances, restrain Congress

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is understood that the principles discussed herein also applies to copyrights, since they both come from the Patent and Copyright Clause.

<sup>337</sup> Pollack, *supra* note 64, at 287.

<sup>338</sup> *Id.* at 288, apparently intending “intellectual property” to refer to “patent and copyright”—incorrectly, as explained *supra* note 13.

<sup>339</sup> *Id.* at 289.

<sup>340</sup> *See, e.g.,* *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479-80 (1974).

<sup>341</sup> *See* Hetherington, *supra* note 333, at 500.

<sup>342</sup> *See, e.g.,* *Sears, Roebuck & Co. v. Stiffel Co.* 376 U.S. 225, 229 (1964).

<sup>343</sup> *See* *United States v. Moghadam*, 175 F.3d 1269, 1277 (11th Cir. 1999).

from acting under an alternative source of authority.”<sup>344</sup> As explained by Perzanowski:

The rule against superfluity must be applied any time the Commerce Clause would provide Congress with authority denied by other enumerated powers.... Where Congress uses the Commerce Clause to eliminate or ignore a limit within another enumerated power, that limit must be applied externally, and the commerce power must yield.<sup>345</sup>

To this end, patent protection arguably is within the reach of the expansive Commerce Power.<sup>346</sup> Hence, in order to avoid rendering the Patent Clause superfluous, the limitations of the Patent Clause must apply to exercises of the Commerce Clause power that concern patentable subject matter.<sup>347</sup>

Now, turning to Fromer. At the beginning of her lengthy and multifaceted constitutional examination—most of the details of which are well beyond the scope of the current article—and shortly after dissing the terms “Intellectual Property Clause” and “IP Clause” as “inaccurate in at least two ways,”<sup>348</sup> she set forth the nature of her inquiry and examination, coupled with her detailed conclusion, in these terms:

This Article relies on the text, structure, and history of the IP Clause, as well as subsequent governmental activity, Supreme Court doctrine, and policy, to show that the IP Clause operates to forbid Congress from using its other powers “To promote the Progress of Science and useful Arts” through laws that reach beyond the scope of the IP Clause’s prescription to “secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” This evidence shows that if Congress seeks, via legislation, to promote the progress of science and useful arts, the only way it can do so is by enacting laws that secure to authors and inventors exclusive rights in their writings and discoveries for limited times . . . .

If the structural purpose of a law is to promote the progress of science and useful arts, the law may use only the means specified in the IP Clause to pursue

<sup>344</sup> Perzanowski, *supra* note 330, at 1089.

<sup>345</sup> *Id.* at 1102-03.

<sup>346</sup> See, e.g., Robert P. Merges & Glenn H. Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45, 63-64 (2000).

<sup>347</sup> See Perzanowski, *supra* note 330, at 1102 (stating that “a Commerce Clause unrestrained by external limits would empower Congress to enact legislation that disregards the limits of [the Patent Clause] — durational or otherwise,” and that such an interpretation would not only render the Patent Clause redundant, it would strip the Clause of all meaning).

<sup>348</sup> Fromer, *supra* note 331, at 1331, n.1. To conform with common practice, she proceeds to use “IP Clause.”

that purpose. This understanding of external limitations imposed by the IP Clause yields varying collisions with other constitutional provisions, primarily the Commerce . . . powers. To evaluate laws that have multiple constitutional purposes, a presumption ought to exist against the constitutionality of laws that promote the IP Clause's ends but subvert its means, a presumption that may be overcome only by clear and convincing evidence that Congress intentionally chose to supersede the IP Clause's means because of paramount, legitimate interests pursuant to its other more permissive powers. This presumption ought to be extremely difficult to overcome when a law's means interfere with the IP Clause's means instead of merely diverging from the means included in the IP Clause . . . .<sup>349</sup>

Accordingly, Fromer specifically and carefully took issue with the views of another professor, Thomas Nachbar, who had claimed that the Patent Clause does not place limits on other constitutional powers.<sup>350</sup> She persuasively touted the superiority of the sequentially-stated views of Professors Rochelle Dreyfuss and Malla Pollack, who had concluded: "Restrictions on constitutional grants of legislative power, such as the Copyright Clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority,"<sup>351</sup> and

[a]ccepting that Congress may not do an end run around a limitation in one clause of the Constitution by invoking a more general clause, Congress may not grant (at least some types of) exclusive rights to something close to, but not quite, the writings of authors or the discoveries of inventors.<sup>352</sup>

Fromer further explained:

[The Patent] Clause is structured differently from the other Article I, Section 8 powers. It is the only clause that specifies the means for carrying out the allotted power: "by securing for limited Times to Authors and Inventors the

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<sup>349</sup> *Id.* at 1413-14.

<sup>350</sup> *Id.* at 1334 (citing Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004)); see Fromer, *supra* note 331, at 1334, n.12 (citing two articles by Edward Walterscheid).

<sup>351</sup> *Id.* at 1335, n.15 (citing Rochelle Cooper Dreyfuss, *A Wiseguy's Approach to Information Products: Muscling Copyright and Patent into a Unitary Theory of Intellectual Property*, 1992 SUP. CT. REV. 195, 230 ("Restrictions on constitutional grants of legislative power, such as the Copyright Clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority."); Malla Pollack, *The Right To Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47, 60 (1999).

<sup>352</sup> Fromer, *supra* note 331, at 1335 (citing Pollack, *supra* note 351, at 60).



exclusive Right to their respective Writings and Discoveries.” The natural reading of this clause, given its unique structure, is that Congress has the power to promote the progress of science and useful arts using solely the specified means.<sup>353</sup>

She continued to pound this point, relying upon early comments by Framers such as James Madison and some 21st Century scholars.<sup>354</sup> Then she concluded:

This discussion would seem strongly to establish the IP Clause’s internal limits, but what of the ability of Congress to invoke its other powers to use alternative means, including the rejected means? The same history seems strongly to support the inference that the Framers intended Congress to possess no means to promote the progress of science and useful arts other than those adopted in the IP Clause. And even stronger evidence, taken from the earliest congressional activity, encourages the drawing of this inference.<sup>355</sup>

Later on, Fromer invoked the classic *Trade-Mark Cases* opinion, proceeding to connect that 1879 case to the 2003 *Dastar* case:

The Court indicated that the IP Clause designates the means that Congress may use – “by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries” - to promote the progress of science and useful arts. The Court observed that “the ordinary trade-mark has no necessary relation to invention or discovery” and that a trademark should not be understood as a “writing[.]” within the bounds of the IP Clause.<sup>356</sup>

And this, in turn, led her to reach this conclusion:

This reasoning constructs a channeling mechanism of sorts: laws concerned with the promotion of the progress of science and useful arts ought to be channeled into the purview of the IP Clause and must comply with its limiting means, and those that are not must be channeled elsewhere, into the purview

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<sup>353</sup> *Id.* at 1339-40 (footnotes omitted).

<sup>354</sup> *See id.* at 1341 nn.41-43.

<sup>355</sup> *Id.* at 1352.

<sup>356</sup> *Id.* at 1360. In footnote 134, Fromer further explains:

The Supreme Court subsequently made a similar point in interpreting the phrase “origin of goods” in the Lanham Act, ch. 540, 60 Stat. 427 (1946) (codified as amended in 15 U.S.C. §§1051-1127 (2006)), the federal implementation of the trademark laws. The Court concluded in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), that the rights conferred by the Lanham Act belong to “the producer of the tangible goods that are offered for sale” rather than “the author of any idea, concept, or communication embodied in those goods.” *Id.* at 37. The Court rejected the latter, broader possible interpretation because it would “create a species of perpetual patent and copyright, which Congress may not do.” *Id.*

*Id.* at 1360-61.

of another enumerated power. In the Trade-Mark Cases, the Court was called upon to deal with the latter situation. It has not, however, been called upon to address directly the former situation.<sup>357</sup>

Regarding the apparently analogous treatment of the Bankruptcy Clause as superseding the Commerce Clause in the Supreme Court's 1982 *Ry. Labor Executives' Ass'n v. Gibbons* case,<sup>358</sup> Fromer proffered:

Although Professor Nachbar suggests that *Gibbons* was incorrectly decided or should not be broadly applied to other Article I, Section 8 powers, the Court's reasoning applies even more strongly to the IP Clause. The historical and other evidence that the IP Clause should limit Congress's other enumerated powers is more robust than any evidence of the negative implications one might draw from the uniformity requirement of the Bankruptcy Clause. As such, the structural reasoning that the Court employed in the bankruptcy context ought to apply even more readily to the IP Clause to forbid Congress from evading the limited means allowed for promoting the progress of science and useful arts by invoking another enumerated power.<sup>359</sup>

After discussing the consonance of the utilitarian nature of the Patent Clause's orientation with everything else she had discussed, Fromer expounded:

The dominant policy underlying the protection of intellectual property in the United States is utilitarian and is grounded in the IP Clause. This utilitarian policy supplements the evidence discussed in the previous Sections to support the idea that the IP Clause externally limits Congress's ability to use means other than those specified in the IP Clause to promote the progress of science and useful arts.<sup>360</sup>

Although late in her comprehensive article Fromer emphatically stated "The collision between the Commerce and IP Clauses is direct,"<sup>361</sup> surprisingly, the remainder of her article fails to even mention the intersection of design patents and trade dress. Happily, another recent commentator did focus on this matter—just two years later on.

Mr. Kalkwarf frontally-faced many relevant issues, and in doing so made this salient statement:

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<sup>357</sup> *Id.* at 1361 (footnote omitted).

<sup>358</sup> 455 U.S. 457 (1982).

<sup>359</sup> Fromer, *supra* note 331, at 1365 (footnotes omitted).

<sup>360</sup> *Id.* at 1366 (footnotes omitted).

<sup>361</sup> *Id.* at 1380.

The Patent/Copyright Clause authorizes patents for a limited time. Patents may not be for perpetuity. Federal trademarks, as a creation of the Commerce Clause, do not possess this constitutional restriction. The limiting requirements of the Patent/Copyright Clause, as previously examined, may not be trumped by the general provisions of the Commerce Clause. Prior Supreme Court precedent and the rule against superfluity both dictate that the specific time restriction of the Patent/Copyright Clause must control any conflict between the two clauses. Any laws passed under the Commerce Clause—in this case trademarks—must not conflict with the limiting restrictions of the Patent/Copyright Clause, for to do otherwise would render the Patent/Copyright Clause void.<sup>362</sup>

His article also stated:

The ebb and flow of Supreme Court jurisprudence . . . establishes that the Commerce Clause does not provide Congress absolute monarchical authority. Rather, for Congress to properly exercise its Commerce Clause power, the legislation must positively regulate this country's commerce. Further, the very language of the Commerce Clause, along with other constitutional clauses, places affirmative limitations and restrictions upon Congress' power.<sup>363</sup>

He further stated:

Because each clause has specific duties, functions, and restrictions, in the constitutional conflict between the Commerce and Patent/Copyright Clauses, the rules of statutory construction and Supreme Court precedent establish that the gluttony of commerce may not ravish the delicate morsel of patents and copyrights.<sup>364</sup>

He concisely asked and answered this pivotal question: “may the Commerce Clause, with its broad authority to regulate activity that would logically include patents and copyrights, override the restrictions imposed by the Patent/Copyright Clause? The answer must be no.”<sup>365</sup> He explained that the central theory underlying this view is the rule against superfluity, which essentially holds that a narrative should not be interpreted so as to render portions of its text superfluous or meaningless.<sup>366</sup> The rule, often relied upon

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<sup>362</sup> Kalkwarf, *supra* note 101, at 423-24. Mr. Kalkwarf, a former graduate student in one of the senior author's “Intro to IP” law courses, provides the most recent and comprehensive analysis of the current conflict concern. His article, oft-referenced herein, provides considerable support for the authors' present thesis.

<sup>363</sup> *Id.* at 367 (footnotes omitted).

<sup>364</sup> *Id.* at 412-13.

<sup>365</sup> *Id.* at 410.

<sup>366</sup> In one sense, since the modern, expansive interpretation of the Commerce Clause could be interpreted to give Congress the power to enact most, if not all, of the laws authorized by

when interpreting statutes and contracts, should apply with equal force in the context of resolving inter-Clause Constitutional conflicts.<sup>367</sup>

Under this approach, the commerce power is free to regulate activities that substantially affect interstate commerce so long as it does not strip the limits found in other enumerated powers of their meaning. If legislation justified under the commerce power would effectively eliminate text found elsewhere in the Constitution, the Commerce Clause must yield to those external limits.<sup>368</sup>

The Supreme Court expressly relied upon the rule against superfluity in *Railway Labor Executives' Assn. v. Gibbons*,<sup>369</sup> in which it found that a law passed—ostensibly under the authority of the Commerce Clause—to protect the interests of former employees of a railroad company to be unconstitutional, on the ground that it contravened the uniformity requirement of the Bankruptcy Clause. According to the Court, “hold[ing] that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause . . . would eradicate from the Constitution a

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other Article I, Section 8 clauses, this interpretation renders all of those clauses superfluous. Justice Thomas recognized this possible view in *United States v. Lopez*, 514 U.S. 549, 588-89 (1995) (Thomas, J., concurring). However, the rule against superfluity does not preclude the possibility that Congress’s enumerated powers may be coextensive. That is, the rule does not apply where one clause provides an alternative source of authority for an otherwise permissible law. Only when one clause is used to circumvent—and therefore render meaningless—a limitation contained in another clause does the rule kick in.

<sup>367</sup> Professor William Patry has discussed this same concept in terms of respecting the overall structure of the Constitution, stating “constitutional limitations placed on Congress by a specific clause . . . serve, in at least some circumstances, to bar Congress from circumventing their application by legislating under a different clause.” William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 376 (1999). He posited that a statute that attempted to avoid the specific limitations of a constitutional grant would be struck down as unconstitutional:

The rationale for the invalidation of such a statute would be structural: the Constitution sets forth a scheme of limited powers that are intended to further specific constitutional objectives.

When Congress legislates in a manner that interferes with those objectives, it impairs the constitutional scheme regardless of what power Congress legislates under.

*Id.* Professor Patry’s views are informed by the writings of Professor Laurence Tribe, who argued that both text and structure must be considered in a constitutional analysis, as “[o]nly as an interconnected whole do [the] provisions [of the Constitution] meaningfully constitute a frame of government.” *Id.* at 374 (quoting Laurence Tribe, *Taking Text Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 HARV. L. REV. 1221, 1235-36 (1995)).

<sup>368</sup> *Id.* at 1099-1100.

<sup>369</sup> 455 U.S. 457 (1982).

limitation on the power of Congress.”<sup>370</sup> Mr. Kalkwarf analogized the *Railway* case to the current constitutional issue:

The Commerce Clause allows for the regulation of activities affecting interstate commerce, which concededly involves patents and copyrights. However, *the Patent/Copyright Clause serves as a security wall, a force field as it were, to prohibit the Commerce Clause from encroaching upon the limiting requirements applicable specifically to patents and copyrights.* Thus, just as Congress could not use the Commerce Clause to violate the limiting terms of the Bankruptcy Clause, so too is Congress prohibited from using the Commerce Clause to nullify the restrictions that exist in the Patent/Copyright Clause.<sup>371</sup>

In another analogous case, *RadLAX Gateway Hotel, LLC v. Amalgamated Bank*,<sup>372</sup> the Supreme Court concluded that, “[a] well established canon of statutory interpretation succinctly captures the problem: ‘[I]t is a commonplace of statutory construction that the specific governs the general.’”<sup>373</sup> Although the Supreme Court set forth this principle in the context of the Bankruptcy Code, this principle is equally applicable to the issue at hand. In the same context, the Court further concluded that, “[t]he general/specific canon is perhaps most frequently applied to statutes in which a general permission or prohibition is contradicted by a specific prohibition or permission. To eliminate the contradiction, the specific provision is construed as an exception to the general one.”<sup>374</sup>

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<sup>370</sup> *Id.* at 469. Similarly, in *Perry v. United States*, 294 U.S. 330 (1935), the Supreme Court has at least implicitly recognized the possibility that the limits of one enumerated power can constrain another. In that case, legislation enacted pursuant to the power to regulate the value of money was held to be unconstitutional as it violated an inherent limitation on the power to borrow money on the credit of the United States. *See id.* at 347.

<sup>371</sup> Kalkwarf, *supra* note 101, at 411 (emphasis added). A similar view can be found in the *Head Money Cases*, 112 U.S. 580 (1884), where the court began by considering whether the legislation was an exercise of the commerce power or the taxation power. Finding that the real purpose behind the statute was to regulate foreign commerce, the Court concluded that the law was not bound by the limits of the Tax Clause. However, even though the Court concluded that the law was not enacted pursuant to the Tax Clause, it nevertheless examined the challenged law in light of those limits, and concluded that it did comport with them. The Court’s consideration of the question of whether a law enacted under the Commerce Clause violated the Tax Clause’s requirement for uniformity strongly suggests that it recognized that the limits of one Clause could restrict Congress’s power under another. *Id.* at 595-96.

<sup>372</sup> 566 U.S. 639 (2012).

<sup>373</sup> *Id.* at 645 (citing *Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 384 (1992)).

<sup>374</sup> *Id.*

## XII. WHAT DO PRACTITIONERS THINK?

Aside from the published comments proffered by Mr. Saidman,<sup>375</sup> who bridges the academic/practical gap, very few established practitioners have expressed their views on the instant issue in published formats. Notably, two practitioners from a well-known all-IP firm provided a detailed written analysis in connection with a major professional meeting just five years ago.<sup>376</sup> While the authors correctly noted that *TrafFix* “did not discuss the effect of an expired *design patent* on trade dress protection,” they also commented – not so surely “correctly” in the current authors’ opinion—that “*TrafFix* does not appear to have any effect on the prior case law relating to trademark protection for a design that was protected by a *design patent*.”<sup>377</sup> They went on to cite positively *E-Z Bowz, LLC v. Prof'l Prod. Research Co.*,<sup>378</sup> which, in denying summary judgment for defendant on plaintiff’s trade dress claims, considered the interaction of such claims with coextensive design patent protections. The authors then commented as follows:

In reaching its conclusion, the *E-Z Bowz* court specifically discussed the effect of the existence of a design patent on a trade dress claim after the *TrafFix* case and found that . . . a design patent not preclude trademark protection in the same design . . . .

However, the authors did not mention that *E-Z Bowz* made no reference whatsoever to the Constitution. But to be fair to the authors, in the conclusion to their article—a section perhaps pregnantly entitled “Still Not Settled Precedent”—they candidly admitted the uncertainty still remaining, in these particular terms:

But what about when the design patents . . . expire? Can the trademark protection live on in perpetuity in its own right (assuming the trademark continues to be used in commerce)? Although the law appears to be well settled with respect to the availability of trademark protection despite the existence of an expired design patent, the Supreme court has still not expressly spoken to the issue and therefore, not all courts, nor the Trademark Trial and Appeal Board, may be of one mind. Thus, we may still have to wait for the Supreme Court to address the issue in order to know definitely if design patent

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<sup>375</sup> Saidman, *supra* note 65.

<sup>376</sup> T. Durkin and J. Shirk, *Design Patents and Trade Dress Protection: Are the Two Mutually Exclusive?*, IPO Annual Meeting (Sept. 2016).

<sup>377</sup> *Id.* at 9 (emphasis in the original).

<sup>378</sup> 2003 U.S. Dist. LEXIS 15364 (S.D.N.Y. 2003).

and trade dress protection can peacefully coexist and extend one beyond the other.<sup>379</sup>

And in a final paragraph, they saliently said: “Until [the Supreme Court speaks], intellectual property law practitioners should consider both design patents and trade dress protection for the unique, non-functional aspects of [their] client’s product configuration and packaging.”<sup>380</sup>

The upshot of these views is that until the Supreme Court frontally faces and decides this issue, practitioners should continue to do what they have been doing (often without any forethought or reservations whatsoever) for years, namely obtaining both types of protection (simultaneously or sequentially). As a “practical” matter, this may be sound advice.<sup>381</sup>

### XIII. WHY DON’T JUDGES AND ATTORNEYS ACKNOWLEDGE AND EMBRACE THE CONFLICT?

As is typical, “proving” a negative or the absence of something is difficult, maybe impossible. Surmising suppositions may be the best that can be done sensibly. Thus, when attempting to ascertain why judges and/or practitioners don’t “get” a particular legal theory or concept—or don’t even seem to realize that such a theory or concept is lurking in the vicinity of the issue(s) actually being considered—the challenge is substantial.

It’s easier to contemplate *why* judges might not “see” or deal with a non-obvious issue: it’s not their jobs to probe below the surface of the issues actually presented to them by counsel. And, not being IP-educated/oriented, judges may assume or easily be persuaded into believing that various types of IP (e.g., design patents and trademarks/trade dress), which emanate from

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<sup>379</sup> Durkin, *supra* note 376, at 20.

<sup>380</sup> *Id.*

<sup>381</sup> Ms. Durkin was in attendance when the senior author of the current article professed the authors’ views about the unconstitutionality of double coverage in an AIPLA-sponsored debate with an established patent practitioner from another all-IP firm about two years ago. *See* Kenneth Germain, “Why the Constitution Disallows Dual Protection Under Design Patent and Trade Dress Regimes for the Same Subject Matter” AIPLA Design Rights Boot Camp (August 6, 2019). The debate opponent was Mr. Richard Stockton, of Chicago’s Banner Witcoff firm. These same people re-debated about a year later. *See* Kenneth Germain, “THE CONSTITUTION COMMANDETH: Thou Shall Not Protect the Same Subject Matter Under Design Patent *and* Trade Dress Laws”, AIPLA Webinar Series (December 10, 2019).

different statutes derived from different constitutional provisions, are so different and separate that it would be normal for them to coexist comfortably. Indeed, even when judges sense an underlying issue potentially of consequence to deciding a litigated case, they may prefer to refrain from being proactive as a matter of discrete jurisprudence. This is especially likely when the underlying issue involves the Constitution; after all, there is a generally recognized principle that the Constitution only should be interpreted and applied when all non-constitutional grounds for decision have been considered without resolving the case.<sup>382</sup> And we, the authors of this article, take no exception to this approach.

Perhaps this reluctance to parse the Constitution sometimes leads judges to pursue—and find—ways to decide cases on grounds that are somewhat questionable. A case in point is *Bobrick v. ASI*, discussed in the Preface to this article. In that case, in the authors’ studied opinion—after consulting with a bevy of patent lawyers all of whom were engineers before they were lawyers—there was very doubtful reason for finding for Defendant ASI (the close copyist, if you will) on the basis of *utilitarian* functionality.<sup>383</sup> This is because the “convex arc” design in issue really did not provide a mechanical or economical advantage to any maker of the various stainless steel restroom accessories initially covered by Plaintiff’s design patents and later covered by its trademark registrations. For example, the load-bearing benefits of an arc are best realized when a weight is placed on the apex of the arc (i.e., the highest point along the curved portion). But here the convex arc was not load-bearing; rather, it merely served as a decorative front for the washroom products. Nevertheless, utilitarian functionality was the judge’s stated basis for Defendant’s victory. *Aesthetic* functionality—also alleged in the case—based on the marketplace advantage of the innovative, *attractive* contour of Plaintiff’s devices’ front panels, would have been a much sounder rationale for rejecting Plaintiff’s claims. But that doctrine was less well-settled and probably less familiar to the judge. A victory for Defendant of course could have been based on the absence of likelihood of confusion, especially considering the environment of large, expensive commercial contracts involved. In truth, only if the judge had rejected utilitarian (and aesthetic) functionality, and then proceeded to find the existence of likelihood of confusion, would Plaintiff have been in position to prevail, and only in that

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<sup>382</sup> See e.g., *Hagans v. Lavine*, 415 U.S. 528, 547 (1974) (explaining that a “court should not decide federal constitutional questions where a dispositive nonconstitutional ground is available”).

<sup>383</sup> *Bobrick*, 2012 U.S. Dist. LEXIS 111465 (C.D. Cal. Aug. 8, 2012), *aff’d in part* 585 F. App’x 660 (9th Cir. 2014).



scenario would Defendant's last-ditch defense—unconstitutionality—have ascended to a must-decide level. Seen this way, the judge's recourse to utilitarian functionality is understandable (even if not correct).

The bigger question is why practitioners—specifically those representing defendants who would stand to benefit from the additional defense of alleged unconstitutionality—apparently almost never have raised let alone pressed this defense. Certainly, this defense would be last-ditch for the reasons outlined above. Nevertheless, in recent decades there must have been some cases in addition to *Bobrick* in which such a defense could have been asserted—and even considered and cautiously ruled upon by some judges. But no such cases have been found: only a few perfunctory rulings.<sup>384</sup> So, the “blame” falls on the lawyers who represented relevant defendants. Here's our hypothesis: lawyers generally, but particularly those practicing IP law (including patent law and trademark law) are protection-oriented. That is, their education, training, and mindset regarding IP issues tends to be “how can we best protect our clients' IP assets from being infringed by their competitors?” IP lawyers sometimes represent defendants, but they would be inclined to rely upon the more usual grounds for defense, and, furthermore, consideration of the Constitution would not likely be on their radar screens. Even if they conjured this up, they might be uncomfortable in raising a theory that could be inconsistent with the pro-protection preferences of many of their and/or their firms' clients. And such a defense would be seen as high-cost and low-success. So, why shoot the golden goose?

#### XIV. RESOLVING THE CONFLICT: THE “KEWANEE KOMPROMISE”\*\*\*

Despite significant but superficial recognition among lower courts of the simultaneous or sequential availability of multiple types of intellectual property protection for the same nonfunctional product feature, the question remains unresolved as to whether a conflict exists between providing trade dress protection for a product design and the constitutional limits on patent protection under the Patent Clause. The Supreme Court's treatment of the interaction between patent and trademark law is a key reason why this issue

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<sup>384</sup> See *supra* note 314.

\*\*\*Kredit is given to Perry Saidman for his clever K-containing title, *Kan TrafFix Kops Katch the Karavan Kopy Kats*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 839 (2000).

remains unresolved, as is the fact that the precise issue has not been presented to the Court as yet. The lack of any in-depth constitutional analysis of the potential conflict by any of the lower courts that have addressed the issue constitutes another reason why the issue remains unresolved.

Although not expressly identified as such, concerns with superfluity might have been in the mind of the *TrafFix* Court. As discussed above, the Court took the extra step of noting the lingering constitutional issue involved with providing trade dress protection for previously-patented useful subject matter.<sup>385</sup> The Court's obvious concern was with a situation in which trade dress protection would be used to provide "the practical equivalent" of patent protection.<sup>386</sup> The intuitive, albeit unstated, basis for this concern was that providing patent-like protection for the previously-patented subject matter through trade dress laws could render the Patent Clause—and its limits—superfluous and therefore meaningless. This implicit basis is also reflected in the Court's opinion in *Kewanee Oil Co. v. Bicron Corp.*,<sup>387</sup> in this cautionary statement noting that a constitutional conflict would arise if a particular law provided a viable means to protect inventions that was more attractive than patent law:

If a State, through a system of protection, were to cause a substantial risk that holders of patentable inventions would not seek patents, but rather would rely on the state [trade secret] protection, we would be compelled to hold that such a system could not constitutionally continue to exist.<sup>388</sup>

As suggested herein, extending trade dress protection to the subject matter of an expired design patent effectively provides "the practical equivalent" of patent protection for the subject matter of the expired design patent.<sup>389</sup>

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<sup>385</sup> See *supra* note 207.

<sup>386</sup> *TrafFix*, 532 U.S. at 35.

<sup>387</sup> 416 U.S. 470 (1974). The Court further explained that

[t]rade secret law and patent law have co-existed in this country for over one hundred years . . . . Congress, by its silence over these many years, has seen the wisdom of allowing the States to enforce trade secret protection. Until Congress takes affirmative action to the contrary, States should be free to grant protection to trade secrets.

*Id.* at 493.

<sup>388</sup> *Id.* at 484. The authors recognize that the *Kewanee Oil* decision dealt with a conflict between state trade secret law and federal patent law. Although relevant to the issue, the Supremacy Clause line of cases does not directly dispose of the federal law vs. federal law conflict presented herein.

<sup>389</sup> This is a result of the unique nature of product design trade dress. With most trademarks and even product packaging trade dress, the mark is distinct from the goods offered under the mark. However, with product design trade dress, the mark *is* the product and the product

The concern with superfluity comes into sharpest focus in situations where the holder of a design patent seeks to claim trade dress protection for the patented design. Because the protections are largely equivalent, at least as a practical matter, and because trade dress protection is not constrained by the “for limited times” limitation of patent protection, patent holders would naturally view trade dress protection as an attractive supplement to patent protection. This attractiveness lies at the heart of the problem. Any interpretation or implementation of the trade dress laws that provides such limitless patent-like protection has the effect of rendering the Patent Clause meaningless. Such a result would necessarily be unconstitutional.

Granting trade dress protection for a product design that previously was the subject of a design patent plainly conflicts with the purposes of the Patent Clause. The Supreme Court has emphasized, time and again, that a central tenet underlying the patent system is that matter which falls into the public domain must remain free for all to use.<sup>390</sup> Indeed, the language of and limitations contained in the Patent Clause suggests that its purpose is to protect and expand the public domain.<sup>391</sup> Hence, the Patent Clause envisions a system where a product design is protected for a limited time, after which it is injected into the public domain for all to use, free from restraint.<sup>392</sup> Granting trade dress protection for the product design effectively removes it from the public domain. The conflict is obvious.

Of course, it is not merely the conflict with the purpose of the Patent Clause that gives rise to unconstitutionality. It is the conflict combined with the fact that product design trade dress can render the limitations of the Patent Clause meaningless. A clear and significant limitation of the Patent Clause is that any monopoly granted must be limited in time. Product design trade dress protection, like all trademark protection, potentially can last forever. Given that product design trade dress protection provides design patent-like

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*is* the mark. Protecting the mark means preventing others from using the same product design, therefore effectively removing the design of the product from the public domain for as long as the mark remains viable. As noted by one commentator:

When a court is presented with a trade dress infringement for an existing or expired design patent, it faces a perplexing obstacle. If the court grants an injunction for that which was claimed in a design patent, i.e. the design, it would effectively be extending the term of the patent beyond its statutory life . . . .

Bonder, *supra* note 40, at 26. Mr. Bonder goes on to explain that such an extension of the patent is “a result that should not occur.” *Id.* at 26-27.

<sup>390</sup> See *Bonito Boats*, 489 U.S. at 156; *Kewanee Oil*, 416 U.S. at 481; *Scott Paper*, 326 U.S. at 256.

<sup>391</sup> See Perzanowski, *supra* note 330, at 1123-24.

<sup>392</sup> Cf. generally *Dastar Corp.*, 539 U.S. at 23.

protection, it essentially can be used to perpetuate a monopoly unrestrained by the “for limited times” limitation of the Patent Clause, thereby rendering that limitation (if not the entire Patent Clause) meaningless.

However, years ago the Supreme Court resolved a somewhat similar overlap that existed between patent and trade secret law in a federal v. state context. The resolution was simple: inventors of a novel technology may choose between utility patent protection that provides them with exclusive rights for a limited term in return for disclosing the technology, and trade secret protection that provides potentially perpetual rights—as long as the technology remains secret. In 1974, in *Kewanee Oil*, the Supreme Court held that state trade secret protection was not in conflict with, and therefore not pre-empted by, federal patent protection.<sup>393</sup> In reaching this conclusion, the Court considered whether state trade secret protection conflicted with any of three identified policies of federal patent law, looking particularly at whether the state law clashed with the objectives of the federal law.<sup>394</sup> The Court concluded that the patent law policy of encouraging innovation is not disturbed by the existence of trade secret protection, which also encourages innovation.<sup>395</sup> The Court also concluded, following a considered analysis, that trade secret law does not conflict with the patent policy of disclosure.<sup>396</sup> In addition, the Court concluded that the policy of ensuring that matter in the public domain remains free for all to use is not disturbed because trade secrets, by their very nature, must be kept confidential and therefore have never been placed in the public domain.<sup>397</sup>

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<sup>393</sup> 416 U.S. 470 (1974).

<sup>394</sup> *See id.* at 480. As this case involved the interplay between federal and state law, the Court’s conflict analysis was conducted in line with its Supremacy Clause jurisprudence. *See id.* at 479.

<sup>395</sup> *See id.* at 484.

<sup>396</sup> *See id.* at 491. In conducting this analysis, the Court considered the potential for conflict between the two protection schemes with respect to three different categories of trade secrets: those believed by the owner to constitute a validly patentable invention; those known to their owners to be ineligible for patent protection, and those whose valid patentability is considered dubious. *See id.* at 484. After considering each of these types of trade secrets from a pragmatic point of view, the Court concluded that the potential for trade secret protection to clash genuinely with the disclosure policy of patent protection was, at best, remote, and that denying trade secret protection would have deleterious effects on society. *See id.* at 485-91.

<sup>397</sup> *See id.* at 484.

The Court's analysis in *Kewanee Oil* is a purposive analysis.<sup>398</sup> It looks to the purpose that each law is intended to serve and considers whether the implementation of the purpose of the state law conflicts with the purpose underlying the federal law. Ultimately, the Court found that the purposes are not in conflict, but are complementary in that each encourages innovation. As further support for its finding that the two purposes are in accord, the Court noted that the protections afforded by trade secret law serve to encourage innovation largely in areas that would not otherwise be amenable to patent protection, or for which patent protection is questionable.<sup>399</sup>

However, that purposive analysis is conducted with a pragmatic mindset. In finding that no significant conflict exists between the purposes of patent law and trade secret law, the Court was plainly mindful of the comparatively weaker protection afforded by trade secret law.<sup>400</sup> Trade secret protection, as the Court noted, is vulnerable to invalidation through third party independent creation or discovery or through reverse engineering, as well as through theft or misappropriation in a manner not easily susceptible of proof.<sup>401</sup> Because of these vulnerabilities, trade secret law was viewed more as a supplement to, and not a replacement for, patent protection, serving to provide protection and encourage innovation in those instances where patent protection would not be available. The language of the Court strongly suggests that were the situation otherwise—that is, were trade secret protection to be structured in such a way as to become an attractive alternative to patent protection—the conflict analysis would have come out differently:

If a State, through a system of protection, were to cause a substantial risk that holders of patentable inventions would not seek patents, but rather would rely on the state [trade secret] protection, we would be compelled to hold that such a system could not constitutionally continue to exist.<sup>402</sup>

Although not expressly stated as such by the Court, the decision in *Kewanee Oil* forces inventors to make a choice regarding the type of protection they wish for their inventions. They can elect to pursue patent

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<sup>398</sup> A purposive analysis dictates that a court interpreting a statute should attribute a purpose to the statute, and then interpret the language to carry out the established purpose. See Michael Livingston, *Practical Reason, "Purposivism," and the Interpretation of Tax Statutes*, 51 TAX L. REV. 677, 680-81 (1996).

<sup>399</sup> See *Kewanee Oil*, 416 U.S. at 493 (explaining that "[t]rade secret law encourages the development and exploitation of those items of lesser or different invention than might be accorded protection under the patent laws").

<sup>400</sup> See *id.* at 489-90.

<sup>401</sup> See *id.* at 490.

<sup>402</sup> *Id.* at 489.

protection, *or* they can opt for trade secret protection. By the very nature of these types of protection, however, they cannot have both.<sup>403</sup> Patents are predicated on disclosure of the invention to public knowledge, whereas trade secrets must be kept out of public knowledge or they cease to exist as secrets. Hence, an inventor must make a clear choice early in the life of an invention which type of protection will best protect his interests. Some commentators have indicated that forcing a similar choice between design patent protection and product design trade dress protection could avoid any conflict between the Patent Clause and trade dress law.<sup>404</sup>

The choice between protection by design patent *or* protection by trade dress may be analogous to the choice between protection by utility patent *or* trade secret. In this regard, the relationship between design patent and trade dress is similar to the relationship between utility patent and trade secret. For example, once the developer of a product design chooses trade dress to protect its design, it cannot seek design patent protection because the product design is necessarily used in public.<sup>405</sup> However, because trade dress law cannot protect product design before acquiring secondary meaning, per *Wal-Mart*, there is a risk that competitors will copy the design early on. Alternatively, the developer of a product design could choose patent protection before publicly disclosing the design. The scope of protection offered through design patent is generally broader than that of trade dress.<sup>406</sup> Comparatively speaking, because utility patent and trade secret are alternative means to protect technologies, so too should design patent and trade dress be alternative means to protect product design. In this manner,

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<sup>403</sup> See, e.g., Bone *supra* note 13, at 265 n.105 (identifying the two types of protection as mutually exclusive).

<sup>404</sup> See, e.g., Horlander, *supra* note 208, at 757. “Inventors should be required to elect between (1) the time-limited statutory monopoly of a patent, or (2) the rigors of the marketplace race to obtain acquired distinctiveness (secondary meaning) in a product configuration trade dress and the ultimate reward of a potentially limitless time period of product configuration trade dress protection.” *Id.* Browning suggests that a trade dress claim involving a product design that was the subject of an expired design patent would fail “because upon the expiration of the producer’s design patent, which the producer *elected* to secure, the federal patent laws gave rise to a federal right to ‘copy and to use’ the claimed ornamental features of the device.” Browning, *supra* note 208, at 1064. (emphasis in original).

<sup>405</sup> The primary law controlling statutory bars is 35 U.S.C. § 102(b), stating

[a] person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

<sup>406</sup> *Kohler Co.*, 12 F.3d at 637 (“Compared to patent protection, trademark protection is relatively weak because it precludes competitors only from using marks that are likely to confuse or deceive the public.”).

the creator of a product design should be limited to *only one* means of protection. Accordingly, applying the same principles in the relationship between utility patent and trade secret, the creators of product designs could not invoke trade dress protection once they choose design patent protection, or vice versa. Thus, by analogy to the Kewanee Kompromise, the constitutional conflict is defused. A recent article reached the same conclusion:

Thus, an analysis of the laws involving design patents and trademarks establish[es] that the holder of a design must be an adult and make a choice. The owner cannot have both a design patent and a trademark for the same design. It is constitutionally prohibited by the Patent/Copyright Clause. The owner of the design must decide whether an exclusive monopoly over the design for fourteen years with the design belonging to the public after the expiration of the monopoly would be better than using the design as a trademark and possessing the design forever, possibly developing the trademark into the owner's most valuable commodity. The one thing the owner may never have is both a design patent and a trademark for the same design.<sup>407</sup>

Another author also took on the issue frontally, concluding, after careful analysis, that design patents and trade dress on the same design *cannot* constitutionally coexist.<sup>408</sup> So said he:

The extension of design patent protection though [sic] trade dress protection unconstitutionally interferes with the right to copy guaranteed by the Constitution . . . . While the rule in *Sears* was based on the Supremacy Clause of the Constitution, the logic still applies . . . . 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.” . . . While the Supremacy Clause cannot be used to invalidate federal laws, the Constitution binds federal courts and Congress. Therefore, the creation of trade dress law through legislation and common law must comport with the Constitution, including the Patent Clause.<sup>409</sup>

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<sup>407</sup> Kalkwarf, *supra* note 101, at 425-26 (emphasis added).

<sup>408</sup> See Tyler Jackson, *Functional Signs and Decanters of Wine: How Trade Dress Protection Unconstitutionally Extends Expired Design Patents*, 18 MARQ. INTELL. PROP. L. REV. 431, 450-51 (2014).

<sup>409</sup> *Id.* at 450-51 (internal citations omitted). He took the preemption principle a significant step further, and beyond the scope of the Kewanee Kompromise, stating, “[t]he 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.” *Id.* Thus, in his view, design patent *availability* would preclude trade dress protection. The current authors do not subscribe to this radical view.

Yet another commentator proposed amending design patent statutory law to include a short period in which design patent owners are required to convert to trade dress protection.<sup>410</sup> He further explained:

With regard to trade dress protection after a design patent expires when the design patent owners did not switch the design patent to trade dress... no one can invoke trade dress protection for the design disclosed in expired patents. Because the design patent owners chose the protection by design patent although they had a chance to choose the protection by trade dress, they accepted the risk that their product design might not be protected even if it acquired secondary meaning later. They should assume the risk because they decided not to pursue trade dress protection initially. In addition, exclusion of trade dress protection after design patents expire may practically impose little problems on the industrial design world since the life of industrial design may not be so long as the life of design patents.<sup>411</sup>

## XV. CONCLUSION

The American pro-competition, anti-protectionist environment—as evidenced by the general nature of “unfair competition” laws and also by statutory enactments such as Sherman, Clayton, and the FTC Act—has been confirmed many times and for many years by Supreme Court precedents consistently taking “right to copy” positions that are intended to leave in the public domain everything that cannot justifiably be singled out for protection, or where prior protections have expired.

In a few contexts other than the current one, the Constitution has been construed so that its arguably inconsistent provisions can coexist harmoniously. Principles of sound constitutional (and analogous statutory)

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<sup>410</sup> Saito explained these proposed amendments to the design patent laws as follows:

Creators of novel product design may seek design patent protection regardless of actual use of the design. If the requirements for design patent are met, the design patent is granted. Next, within a limited time, i.e. a statutory period, the design patent owners may choose between keeping design patent protection without change or switching subsequently to trade dress protection . . . . If they decide to switch to trade dress protection from design patent protection, they would file a trade dress application with the United States Patent and Trademark Office (USPTO) within the statutory period. When the application is registered, the design patent will expire. If the USPTO finally rejects the application, the design patent remains valid.

Saito, *supra* note 204, at 690. Saito further explained how this would be a proper approach to protect product design that is inherently distinctive or has acquired secondary meaning, without betraying public expectation for practicing the subject matter in expiring design patents. *Id.*

<sup>411</sup> *Id.* at 691.



interpretation have been applied so as to provide preference and deference—with regard to specific requirements and restrictions viewed in contradistinction to amorphous general authorizations. Accordingly, the specific has prevailed over the general, and nothing has been rendered superfluous and void. In the current context, then, the Patent Clause, with its specific, express requirements and restrictions, should prevail over inconsistent applications of the Commerce Clause, with its judicially-expanded, general and loose scope.

When the two Clauses overlap in such a way that one might “overrule” the other, the specific must not be defeated by the general. In such a situation, the authors of this article propose that the owner of the relevant IP—specifically the owner of a design that is amenable to protection both under Design Patent law and under Trademark/Trade Dress law—be legally required to choose one of these modes, foregoing the other completely. This is what the authors have dubbed the “Kewanee Kompromise.”

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