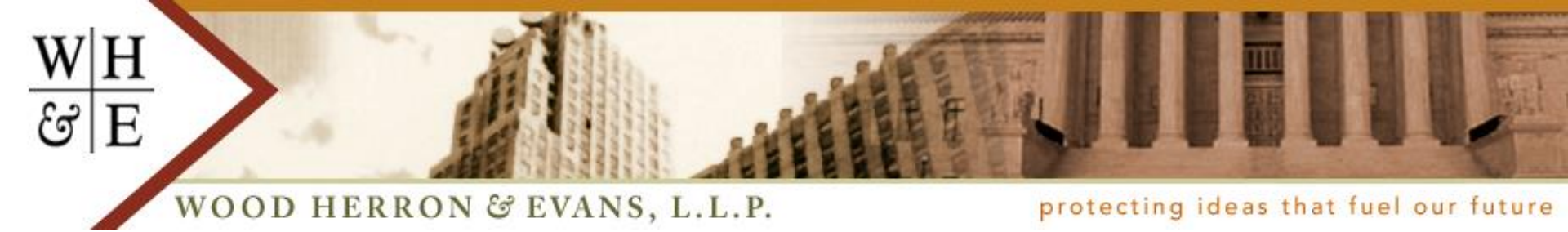

Climbing Onto Multiple Branches of IP Protection (for Product Design Trade Dress) Will Leave You Hanging – Without Constitutional Support!

Prepared for the Fordham Law School 21st Annual Fordham Intellectual Property Law & Policy Conference
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Excerpts from the U.S. Constitution

Article 1, Section 8:

The Congress shall have Power . . .

To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes; . . .

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;

The Basis for a Constitutional Conflict

In the United States, patent and copyright laws are enacted pursuant to the Patent (and Copyright) Clause. However, in light of the expanding reach of the Commerce Clause throughout the 20th century, there is little doubt that the present-day patent and copyright laws could be enacted pursuant to that clause. This signals a potential conflict between the Commerce Clause and the Patent Clause; this is due to the well-recognized fact that the Patent Clause itself places express limitations on congressional power to legislate (most notably, that protection be granted only "for limited times"), whereas the Commerce Clause contains no such intrinsic limitation on the exercise of its power.

TrafFix Devices (U.S. 2001)

The Court uttered these statements affirming the permissibility of "copying" of product design features:

1. **"[I]n many instances there is no protection against copying of goods and products."**

2. **"In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying."**

2. **"[C]opying is not always discouraged or disfavored by the laws which preserve our competitive economy."**

4. **"Allowing competitors to copy will have salutary effects in many instances."**

TrafFix Devices (U.S. 2001)

"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 period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller."

TrafFix Devices (U.S. 2001)

Finally, the Court acknowledged – but postponed for another day/case – this critical constitutional query:

Whether "the Patent Clause … of its own force prohibits the holder of an expired [utility] patent from claiming trade dress protection."

Scope Outlast

Top Wave Portion of Cap
USD612239

Neckband Surface Ornamentation
USD 612,720

Closure Easy Open
Shrink Wrap
Case 11258P

Wave Cap
USD599666

Contoured Cap
Trademark (77685045)

750 ml bottle shape
USD591607

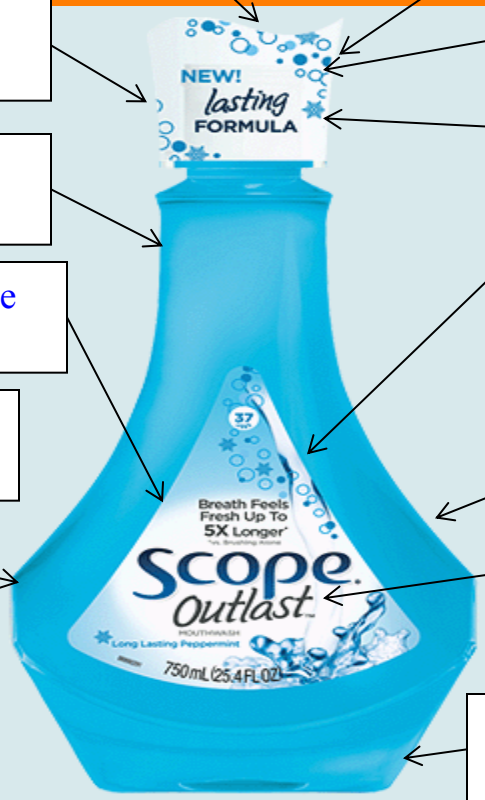
Liquid Splash on Label
D-1416

750 ml Label Shape
D-1459

Contoured Bottle
Trademark (77685052)

Matching Side Contours of 750 ml Bottle and
Label D-1461

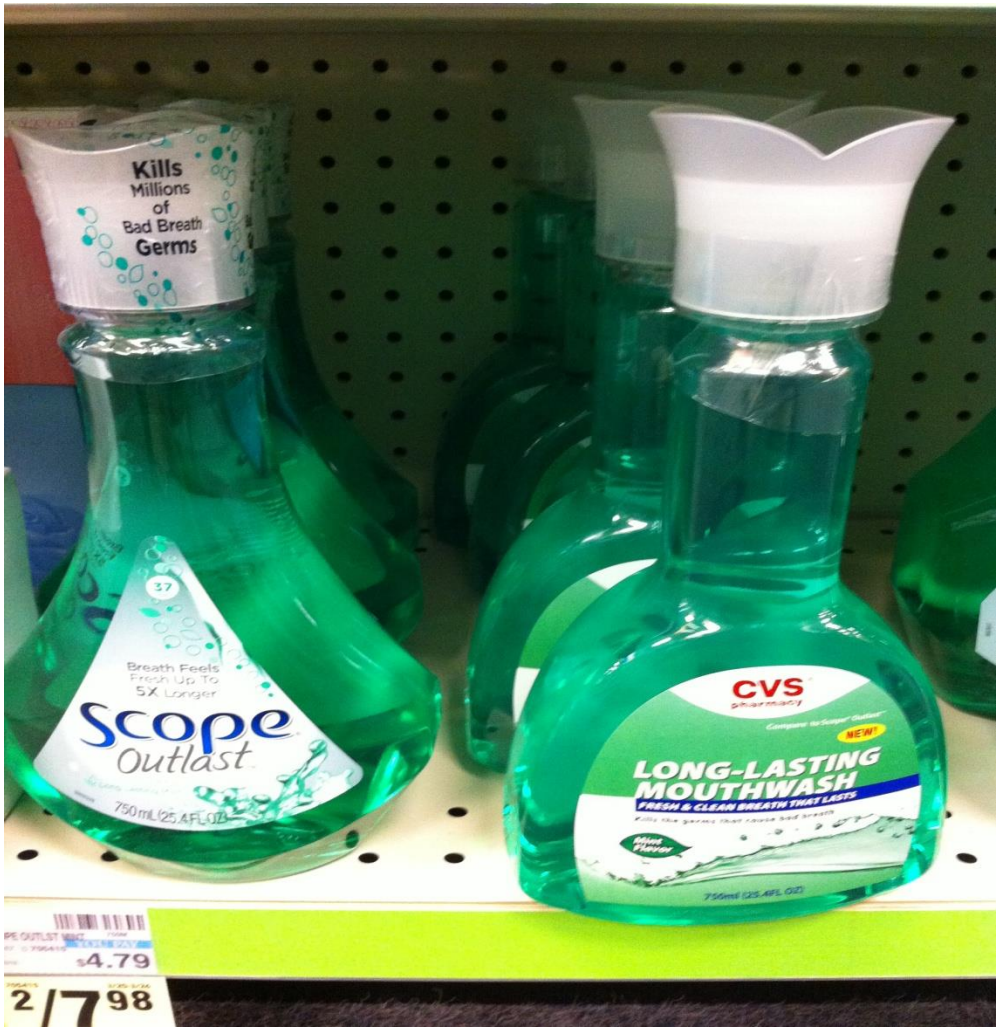
Outlast Word
Trademark (77685057)



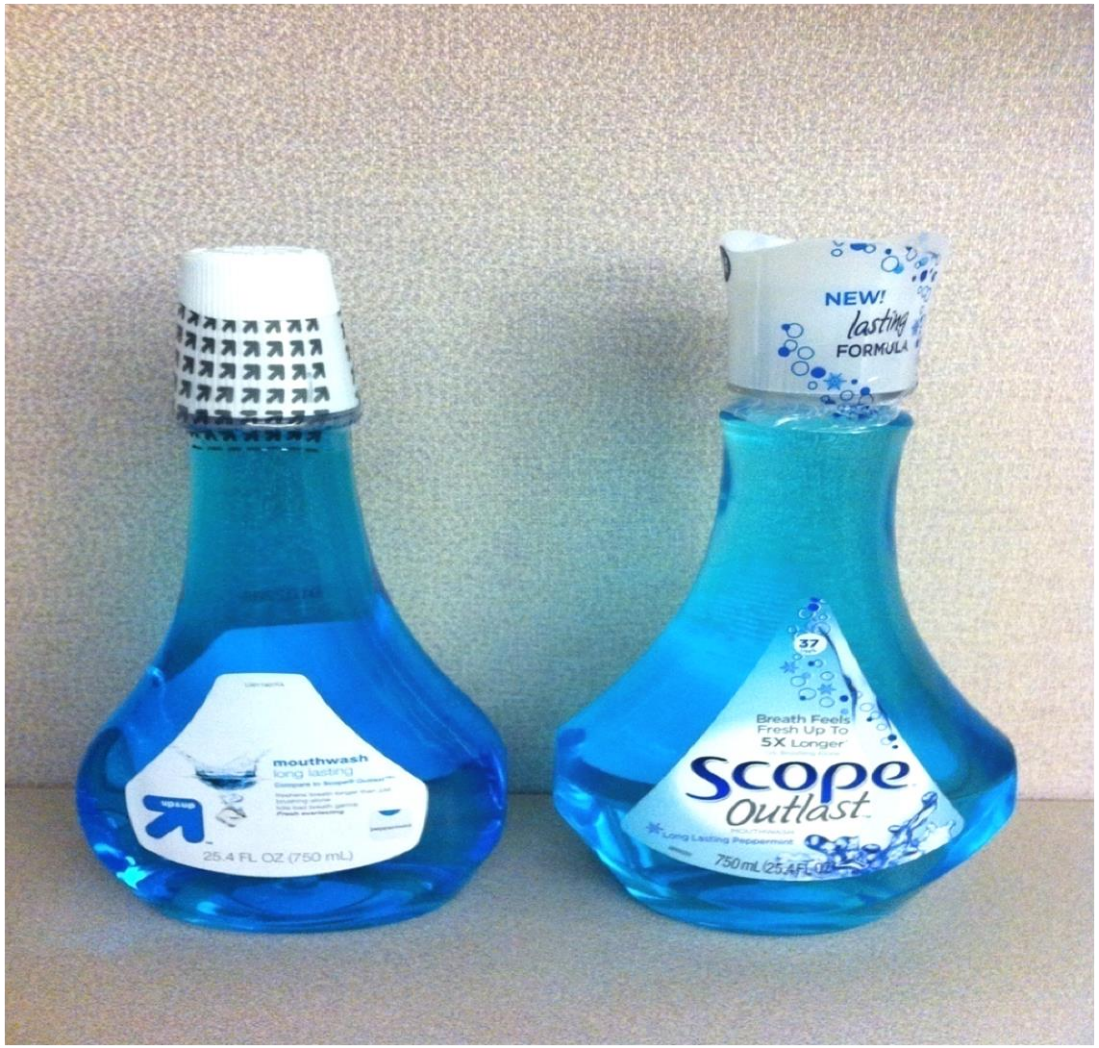
Matching Bottom Contours of 750 ml Bottle
and Label D-1461

Others- Not Shown
Flat top cap: D-1316
Genie Cap: USD 600,121
1250 ml bottle shape: USD 591,608
1250 ml Label shape: USD 609,751
U.S. Copyright Registrations

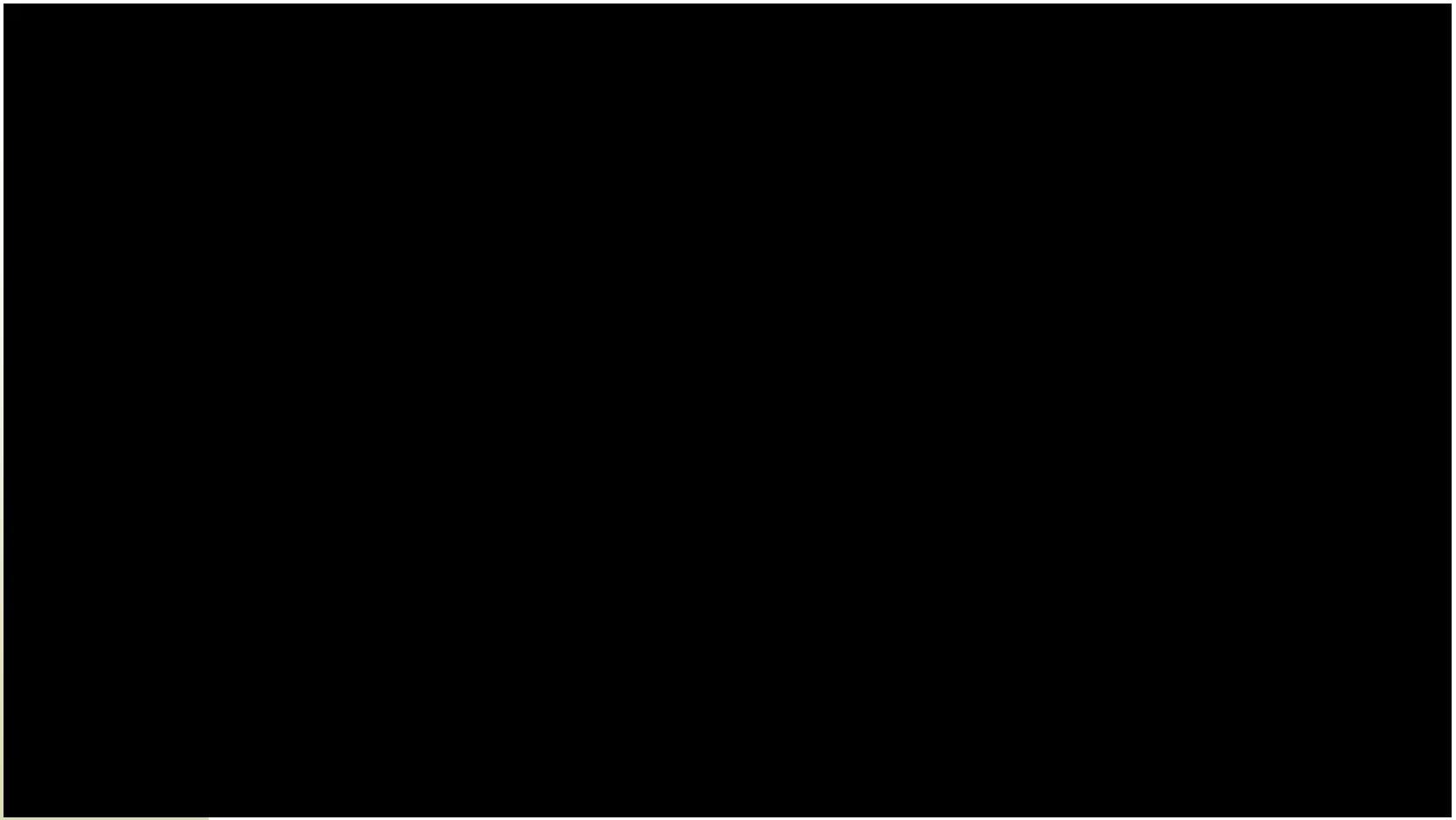
TM & Design Patents


Kills
Millions
of
Bad Breath
Germs
Breath Feels
Fresh Up To
5X Longer
Scope
Outlast
CVS
LONG-LASTING
MOUTHWASH
$4.79
2/7.98

Slide 8


mouthwash
long lasting
25.4 FL OZ (750 mL)
NEW!
lasting
FORMULA
37
Breath Feels
Fresh Up To
5X Longer
Scope
Outlast
Long Lasting Peppermint
750 mL (25.4 FL OZ)

Slide 9



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Patent Act of 1952, as amended in 2011, 36 U.S.C. § 1 seq.

§ 101. Inventions Patentable

Whoever invents or discovers any new and **useful** process, machine, manufacture, or composition of matter, or any new and **useful** improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 171. Patents for Designs

Whoever invents any new, original and **ornamental** design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

20th Century Practical Perspectives

Although the Supreme Court has left the issue somewhat murky, a number of lower courts have concluded that the same feature *can* simultaneously or sequentially be protected under some combination of the copyright, patent and trademark laws. **This, indeed, is the traditional view, as expressed in a number of cases.** Some of these cases were decided *prior* to the Supreme Court decisions in *Wal-Mart, TrafFix,* and *Dastar:*

1. *In re Mogen David Wine Corp.,* 328 F.2d 925, 930 (C.C.P.A. 1964) (allowing registration of a trade dress claim in a product configuration notwithstanding the fact that the configuration was the subject of an existing design patent);

2. *In re Yardley,* 493 F.2d 1389, 1394 (C.C.P.A. 1974) (finding an overlap in protection available under copyright and design patent law);

[3-5: omitted]

21st Century Practical Perspectives

Moreover, some other cases were decided after *Wal-Mart, TrafFix,* and *Dastar:*

6. *RDF Media Ltd. v. Fox Broadcasting Co.,* 372 F. Supp. 2d 556, 564 (C.D. Cal. 2005) (stating that "trademark and copyright protection may coexist");
7. *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.");
8. *Sleep Science Partners v. Lieberman,* 2010 U.S. Dist. LEXIS 45385 at *11 (N.D. Cal., May 10, 2010) (same);
9. *Oldcastle Precast, Inc. v. Granite Precasting & Concrete, Inc.,* 2010 U.S. Dist. LEXIS 53775 at *8 (W.D. Wash., June 1, 2010) (same).

One (Dissenting) Judge's *Atypical* View

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 scheme (the Lanham act), the specific, constitutionally-mandated provisions should control.

Kohler Co. v. Moen Inc., 12 F.3d 632, 651 (7th Cir. 1993) (Cudahy, J., dissenting).

Scholarly Analysis of the Constitutional Conflict (re Patent)

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. 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.**

David S. Welkowitz, *Trade Dress and Patent — The Dilemma of Confusion,* 30 RUTGERS L. J. 289, 343 (1999).