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Overlapping Intellectual Property Doctrines: Election of Rights versus Selection of Remedies

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OVERLAPPING INTELLECTUAL PROPERTY DOCTRINES: ELECTION OF RIGHTS VERSUS SELECTION OF REMEDIES

Laura A. Heymann*

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ABSTRACT

Overlaps exist across various doctrines in federal intellectual property law. Software can be protected under both copyright law and patent law; logos can be protected under both copyright law and trademark law. Design patents provide a particular opportunity to consider the issue of overlap, as an industrial design that qualifies for design patent protection might also, in particular circumstances, qualify for copyright protection as well as function as protectable trade dress.

When an overlap issue arises—that is, when an intellectual property rights holder asserts rights under more than one doctrine—the question then becomes how courts should respond. One response, of course, is that courts should do nothing, on the theory that the doctrines developed in a way that permit such overlapping rights, and so the courts should continue to enforce them. The opposing response is to argue that overlapping rights make it difficult for intellectual property users to determine the scope of another’s rights, particularly when those rights have different terms or limitations, and so the courts should require intellectual property owners to choose the right they want enforced at the outset.

Neither response is entirely satisfying. Without some signal from Congress that it intended to limit the scope of intellectual property rights when overlaps occur, the imposition of restrictions by the courts simply to achieve predictability for users seems problematic. At the same time, courts should not be blind to the difficulties that doctrinal overlap pose for potential defendants and the temptation it presents to intellectual property owners to push for even stronger protection.

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This Article therefore proposes something of a middle ground. Courts should not require intellectual property owners to elect one form of protection at the outset. But they should be attentive to whether the right asserted in any litigation proceeding aligns with the harm claimed by the plaintiff and, relatedly, should try to devise remedies that address only those harms.

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INTRODUCTION

It is nothing new to note that some aspects of commercial activity can be protected under more than one intellectual property regime. Computer software can be protected under both copyright law (as a “literary work” comprising expressive content) and patent law (as a way of solving a particular inventive problem); some logos or other designs can be protected both under copyright law (as aesthetically appealing creative works of authorship) and under trademark law (as transmitters of meaning that indicate the source of goods or services). Until recently, design patents were the often-ignored child in the intellectual property family, receiving neither newspaper headlines nor widespread scholarly attention. But recent high-profile cases, most prominently the Apple-Samsung dispute, have reawakened practitioners and firms to the strategic advantages of including design patents in an intellectual property portfolio. Design patents present a particular opportunity for overlap, in that an ornamental feature that can be protected by a design patent might also be protected as a form of expression by copyright law and as a source indicator by trademark law (in the form of trade dress).

From an intellectual property owner’s perspective, the overlap between or among regimes is not typically a cause for concern. Seeking protection under more than one regime is a belt-and-suspenders form of enforcement, allowing the intellectual property owner to resort to a second mode of protection should the first fail or expire. But from an intellectual property *user’s* perspective, overlapping protection schemes can make it more difficult for competitors to determine what they can do. Material that is the subject of an expired design patent, which patent law would put in the public domain, may not be free to use without restrictions if courts vindicate continuing trade dress rights in that same material. When this occurs, it is not surprising that an intellectual property user would feel as if the end of the design patent term has little practical effect.

Courts could, of course, choose to do nothing on the grounds that since the doctrines permit an overlap of rights, it would be improper to impose a limitation. This approach, however, is unsatisfying, as it minimizes very real concerns about the proper scope of intellectual property protection. Alternatively, courts could, as some commentators have suggested,¹ require intellectual property owners to elect among doctrines—that is, to choose at the outset which form of protection they will employ or to relinquish rights in one form if another is chosen. Requiring the intellectual property owner to elect among doctrines, however, is difficult to square with the existing federal intellectual property scheme, in which Congress has contemplated that overlapping rights will exist. Moreover, requiring commitment to only one form of protection, whether explicitly or by default, requires careful consideration of the nature of future uses, income streams, and doctrinal contours, all of which may be difficult to predict *ab initio*.

The courts, for their part, have presented what on their face seem to be mixed messages in this regard. Many courts, including the U.S. Supreme Court, have held that there is no reason to limit intellectual property owners to one regime—that simply because something is eligible for copyright protection does not mean that it isn't also eligible for design patent protection. On the other hand, many courts—again, including the U.S. Supreme Court—have rejected attempts by intellectual property owners to assert another form of intellectual property protection once one form is unavailable for particular subject matter.²

This Article, therefore, proposes something of a middle ground. Rather than requiring intellectual property owners to elect among overlapping intellectual property rights on the front end, courts should address the overlap concern by being more attentive to harms and remedies on the back end. In other words, the fact that something qualifies for protection under a particular intellectual property doctrine does not mean that, in any particular case, the IP

1. See, e.g., Margreth Barrett, *Trade Dress Protection for Product Configurations and the Federal Right to Copy*, 20 HASTINGS COMM. & ENT. L.J. 471, 476 (1998) (“Permitting plaintiffs to rely on § 43(a) to prevent the copying of product features creates a distinct tension with Congress’ plan in enacting the patent and copyright laws.”); Mark P. McKenna, *An Alternate Approach to Channeling?*, 51 WM. & MARY L. REV. 873, 891 (2009) (suggesting, although recognizing the difficulties in the proposal, that firms be required “to elect between forms of protection at the product level”—for example, between patent protection for a pharmaceutical and trademark protection for the brand name for the pharmaceutical); Matthew Nimetz, *Design Protection*, 15 COPYRIGHT L. SYMP. (ASCAP) 79, 85-86 n.23 (1967) (describing the “fundamentally sound view that the creator might have an election between the two forms of protection” but noting that “the federal protective scheme never intended double protection; if one desires the long-term protection against plagiarizers one must be willing to give up one’s ‘idea’ to the public; if one wants a total monopoly over any use of the design, one must be satisfied with the terms and conditions of the design patent statute”).

2. See *infra* text accompanying notes 33-128.

owner is entitled to a particular remedy. The appropriateness of a remedy depends on whether it is tailored to the harm incurred. For example, not every injury involving a work subject to a design patent requires an injunction forbidding use altogether; if the real harm results from the representations made in connection with that use, a narrower injunction, viewed through the lens of unfair competition law, might be all that is necessary.

This approach is not an unfamiliar one. In the copyright and patent realms, courts have been willing to term an assertion of rights “misuse” when the underlying harm is unrelated to the core interests of the intellectual property doctrine. And in other areas of the law, such as defamation, courts have refused to allow plaintiffs to avoid restrictions posed by the First Amendment and statutes of limitations simply by renaming their legal claims. In all of these cases, courts have solved the problem of overlapping doctrines by looking beyond the label attached to the claim to inquire more deeply about harms and remedies.

To be clear, by suggesting the same approach in intellectual property cases, I am not suggesting that IP owners who assert overlapping rights are necessarily engaging in malfeasance. If two forms of protection are both available for a single article, it is not automatically unlawful or duplicitous to assert both. At the same time, however, courts should not provide sledgehammer remedies to redress fly-sized harms.

I. OVERLAPS IN INTELLECTUAL PROPERTY LAW

The current condition of overlap in intellectual property law results both from the multifaceted nature of many articles of creation or invention and from an expansion of the various doctrines beyond their more limited origins.

For example, both the subject matter of design patents and the subject matter of copyright law generally concern items with aesthetic appeal for their intended audience and exclude from their scope items that are useful or functional (as does trademark law), leaving protection of useful items to the utility patent regime. Thus, it is possible for a single design to be subject both to the lengthy term of copyright law and to the considerably shorter term of design patent law. Similarly, because both design patent law and trade dress law base their rights on the relevant audience’s appreciation or understanding of the distinctiveness of a particular design, it is possible for a single design both to satisfy the novelty requirement of design patent law and the secondary meaning requirement of trade dress law and thus to be subject both to the limited term of protection of design patent law as well as the potentially unlimited term of protection of trade dress law.

The nature of the overlap has been augmented by an expansion and

morphing of the boundaries of the various doctrines.³ Copyright's early focus on works of fine art (once it moved beyond its original scope of books, maps, and charts) would not initially have posed any risk of doctrinal overlap with design patent law, which was contemplated to extend only to works of industrial design.⁴ As copyright's scope expanded away from fine art toward encompassing works of authorship with potential commercial uses, however, the overlap between copyright's realm and that of design patent increased. The 1909 Copyright Act described the subject matter of copyright as "all the writings of an author," without any specific reference to the fine arts,⁵ and by 1917, the Copyright Office had amended its regulations to allow registration of "artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture," with a further amendment in 1949 to allow registration of "published or unpublished works or artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned."⁶

In the courts, the turning point was *Bleistein v. Donaldson Lithographing Co.*, in which the Court held that copyright protection could not be denied to the artwork featured in a circus advertisement merely because the art was being used toward commercial rather than purely aesthetic ends.⁷ Thus, the scope of copyright no longer turned on whether a work of authorship furthered knowledge or existed in the rarefied air of the fine arts; rather, so long as the work met minimal requirements of creativity and originality, it could be

3. See Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1496 (2004) ("[O]verlapping protection has arisen mostly by accretion, as a result of the expansion of intellectual property rights, rather than by design."); see also *id.* at 1511-12 (discussing overlap of design patent rights with both copyright and trademark).

4. Protection was extended to "painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts" in 1870. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 710 (1983). In the 1909 Copyright Act, protection was afforded to "[w]orks of art; models or designs for works of art," without any reference to the fine arts. Copyright Act of 1909, ch. 320, § 5(g), 35 Stat. 1075, 1077 (repealed 1976); Denicola, *supra*, at 710; see also Gregory R. Mues, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs*, 49 ST. JOHN'S L. REV. 543, 557 (1975) ("At the time the first design patent legislation was enacted, copyright protection was reserved to works of purely intellectual or fine art value. On the other hand, the existing mechanical patent statutes were devoted to the furtherance and protection of industrial advancement. Thus, since the purpose of applied designs was commercial enterprise, it was reasonable that regulation fall under the patent laws." (footnote omitted)).

5. § 4, 35 Stat. at 1076; *Mazer v. Stein*, 347 U.S. 201, 210 (1954).

6. Denicola, *supra* note 4, at 710-11 (quoting 37 C.F.R. § 201.4(7) (1917) and 37 C.F.R. § 202.10(a) (1949)); see also Barton Beebe, *Bleistein*, Copyright Law, and the Problem of Aesthetic Progress 30-35 (unpublished manuscript) (on file with author) (tracing the history of the Copyright Act).

7. 188 U.S. 239, 251-52 (1903).

protected, even if the work was being deployed to overtly commercial ends.⁸ And because copyright infringement now can be shown not merely with near-identical copying but with works that are “substantially similar” to the copyrighted work, it is more difficult to draw clean lines between copyright law and design patent. So while a commentator could write in 1975 that, assuming an antique telephone casing was protected both by design patent and by copyright, “[u]pon the expiration of the design patent, the design would be free for public use,” and that “[t]he remaining copyright would only protect the owner from the slavish copying of his antique casing and any noticeable variation in a similar casing would foreclose a copyright infringement claim,”⁹ such an assertion would be unsupported by modern case law.

Design patents saw a similar expansion. Congress originally enacted design patent law in response to a belief that the design of industrial articles, in addition to their functional aspects, should be encouraged and protected from commercial copying. Such protection had been available in France and England in the 1700s, and it was the perceived comparative disadvantage of the United States in this regard that Commission of Patents Henry Ellsworth highlighted in his 1841 report to Congress, noting, “Competition among manufacturers for the latest patterns prompts to the highest effort to secure improvements, and calls out the inventive genius of our citizens.”¹⁰ Congress responded by enacting the first law in the U.S. to protect industrial design.¹¹ As was said of a 1902 amendment, the law was intended to provide protection for “objects of new and artistic quality pertaining . . . to commerce,” as opposed to the “objects of art” protected by copyright law and the “mechanical constructions possessing utility of mechanical function” protected by utility patents.¹²

The precise assumptions underlying the enactment are unclear. Presumably, there is something of the incentive theory that is the dominant justification in the U.S. for patent law and copyright law: that authors and inventors will be disinclined to bring their works and inventions forth if second comers can easily copy their works and then sell them in the market for the marginal cost of copying (i.e., without the need to recoup the costs of

8. Mues, *supra* note 4, at 561 (“[*Bleistein*’s] judicial inroad of the copyright into the commercial sphere, previously occupied solely by the design patent, provided a significant step forward in the ultimate realization of dual coverage.”); *see also* Beebe, *supra* note 6, at 38-43 (discussing *Bleistein*’s principle of aesthetic neutrality).

9. *See* Mues, *supra* note 4, at 567 (discussing *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733 (S.D.N.Y. 1966)).

10. HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 27-74, at 2 (2d Sess. 1841), *quoted in* Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. OFF. SOC’Y 380, 380 (1948).

11. *See* Design Patent Act of 1842, ch. 263, § 3, 5 Stat. 543, 543-44.

12. S. REP. NO. 57-1139, at 3 (1902) (statement of Commissioner of Patents Frederick Innes Allen), *quoted in* Hudson, *supra* note 10, at 390-91.

development or invention). On this theory, design patents are ultimately justified as benefiting the public, which enjoys an increase in the aesthetically pleasing character of industrial goods that would not otherwise exist. There is also probably something of a fairness or other moral concern regarding copying the work of others without having engaged in the toil of authorship or invention. Here, the benefit of the law is contemplated for the designer, not the public: prohibiting misappropriation and unlawful free riding, as well as a valorization of industrial design as a cousin to fine art and mechanical inventions. Thus, as one commentator wrote:

The articles themselves may have been of common usage and knowledge, *e.g.*, spoons or forks, and therefore not worthy of a mechanical patent, which at one time was the sole protection available. Yet, the manufacturer of these implements may have used his inventive genius in designing their shape, configuration, or ornamentation so as to present an attractive article for sale. Nevertheless, since the designer of these ornate utensils was without statutory protection, his design could be freely copied by others less talented. The designer was thereby deprived of the fruits of his labor.¹³

Despite the initial goal of providing protection only for aesthetically appealing articles of manufacture, later court decisions resulted in a more expansive scope of design patent law. The Court of Customs and Patent Appeals, in its 1930 decision in *In re Koehring*, reversed a decision by the Commissioner of Patents denying a design patent for a concrete mixer truck body and frame.¹⁴ While the Commissioner, and the dissent, believed that such items were not contemplated to be the subject of design patents (as opposed to objects with more understandable aesthetic appeal), the majority held that “the beauty and ornamentation requisite in design patents is not confined to such as may be found in the ‘esthetic or fine arts.’”¹⁵ Thus, by the mid-twentieth century, it was established that both copyright protection and design patent protection extended to works with uses in the commercial realm with some degree of aesthetic appeal, regardless of whether that appeal could be said to be refined.

The expansion of trademark law’s protection to encompass product design trade dress (as opposed to merely product packaging), as well as the expansion of liability to include not only uses of the plaintiff’s mark that diverted consumers from the plaintiff to the defendant but also uses that suggested a

13. Mues, *supra* note 4, at 555-56 (footnote omitted); *see also* Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169, 172 (2012) (“The decorative arts differ from the fine arts primarily in the constraints imposed upon the designer’s creative expression.”).

14. 37 F.2d 421, 421, 424 (C.C.P.A. 1930).

15. *Id.* at 422 (noting that Congress, in enacting design patent law, “expressed a desire to promote more beauty, grace, and ornamentation in things used, observed, and enjoyed by our people,” and “had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices which have a tendency to depress rather than excite the esthetic sense”).

sponsorship or authorization relationship also contributed to the overlap between trademark law and design patents.¹⁶ As with the copyright/design interface, the trademark/design overlap emanated from broad statutory language (here, in the Lanham Act) that courts took at face value. The language of the Lanham Act, the Court declared in *Qualitex Co. v. Jacobson Products Co.*, “says that trademarks ‘include any word, name, symbol, or device, or any combination thereof.’ Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”¹⁷ Given this broad reading, there is nothing in the Lanham Act itself that prevents extension of trademark protection to product configurations as a category, save for the exclusion of functional subject matter, which is left to the realm of utility patents.¹⁸ Thus, similarly to the commentator discussed above, where a commentator in 1967 could plausibly write that the trademark and design patent overlap was in one respect narrow because, even when a design patent on a decanter expired, trademark law would not prevent its use “in contexts other than the sale of liquor,”¹⁹ federal trademark law has since moved far from that limited scope.

Thus, on a broad view, the various intellectual property regimes present significant areas of overlap. But when we look at the particular interests at the core of each doctrine, differences do emerge. For example, although both copyright law and design patent law concern aesthetics, and are both constitutionally concerned with promoting “progress,” the two regimes have different views of when progress has been achieved. Because copyright law has no novelty requirement, unlike design patent law, it is difficult to say that it has any real concern with *advancement* in aesthetics. As Barton Beebe has noted, copyright law’s theory is that the more works that are encouraged, the more likely it is that we will end up with something worthwhile.²⁰ Design patent law,

16. J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6, 125 (1989) (“[T]he federal appellate courts generally have expanded the protection of product configurations as ‘appearance trade dress’ under section 43(a) of the Lanham Act, with the result that its anticompetitive thrust may actually exceed that of state unfair competition laws prior to the *Sears-Compco* decisions of 1964.”).

17. 514 U.S. 159, 162 (1995) (quoting 15 U.S.C. § 1127 (1994)).

18. See 15 U.S.C. § 1052(e)(5) (2011) (providing basis for refusal of registration for a mark that “comprises any matter that, as a whole, is functional”); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28-29 (2001) (noting that although “[i]t is well established that trade dress can be protected under federal law,” trade dress protection “may not be claimed for product features that are functional”).

19. Nimetz, *supra* note 1, at 90.

20. Beebe, *supra* note 6, at 47 (“[H]ow can copyright law claim to promote progress, aesthetic or otherwise, when it has no progress-based standard for copyrightability? . . . More copyright protection will generate more expression, goes the argument, and some of this expression, we trust, will promote aesthetic progress, be that progress in the form of more pleasingly diverse expression, more pleasingly beautiful expression, or simply more pleasing

by contrast, is focused on encouraging advances in design. By requiring novelty, it is concerned with progress in a more linear sense: the development of the practice of design over time.²¹

Neither design patent nor trade dress rights, to take another overlap, exist without some engagement with an audience: the examiner at the Patent and Trademark Office who deems the design novel or the relevant group of consumers who recognize the trade dress as distinctive. However, unlike design patents, trademark law is not concerned with the aesthetic reaction to a design but rather with the denotative meaning attached to that design. Trademark law does not reward aesthetic appeal or any conception of whether the development of the trademark promotes any sort of progress in the useful arts; a trademark is simply a sign that substitutes for a larger collection of information about the source of a particular good or service.

All three regimes overlap in the sense that audience or consumer reaction is the touchstone for infringement. But audience reaction presents more of an overlap concern at the copyright/design patent interface than it does at the other two interfaces.²² Infringement of a design patent “requires that the designs have the same general visual appearance, such that it is likely that the purchaser would be deceived into confusing the design of the accused article with the patent design.”²³ For both copyright infringement and design patent infringement, then, the test is whether the ordinary observer would find the plaintiff’s work or invention and the defendant’s work or invention the same, taking into account the unprotectable elements of the subject matter.²⁴ Because

expression.”).

21. *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (“The dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents”); Mues, *supra* note 4, at 572 (“[T]he aspects protected by the copyright and design patent are distinct. For the copyright, it is original pure art divorced from any utilitarian embodiment, while for the design patent, it is inventive artistic ornamentation applied to commercial endeavor.”).

22. I have already considered the copyright/trademark overlap in Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 90-93 (2007).

23. *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998).

24. *Compare Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1872) (design patents) (“We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”), and *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) (design patents) (holding that the test for design patent infringement is whether the ordinary observer would find the two designs to be substantially the same, in light of the prior art), with *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 179 (9th Cir. 2013) (copyright) (“We have explained that two works are substantially similar [for purposes of a copyright infringement analysis] if [the] ‘ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.’” (quoting *Concrete Mach. Co. v.*

both regimes are directed, at least in the United States, toward protection of the IP owner's economic interests, the similarity test is meant to determine whether the defendant's work or invention serves as a substitute in the market for the plaintiff's.²⁵ This makes sense in both regimes because the appeal of the subject matter to the audience's aesthetic perception is what defines the nature of the subject matter and, presumably, motivates its creation. This analysis does not, of itself, concern itself with the consumer's understanding as to the source of the goods. That is, one commits copyright or design patent infringement simply by copying the protected subject matter, regardless of whether that subject matter is recognizable to consumers as the work of the rights holder or whether it is presented as the work of the copier.²⁶

In a trademark infringement case, consumer reaction and similarity are also the touchstones, although the ultimate inquiry is different. Here, the question is whether the plaintiff's good or service and the defendant's good or service are presented as deriving from the same source or are otherwise related when they in fact are not. Contrary to copyright law and design patent law, which prohibit unauthorized similarity between two sets of goods, trademark law prohibits false declarations of similarity between two sets of goods, as expressed through the use of the trademark. Indeed, if the two sets of goods are in fact the same—the defendant is using the Louis Vuitton trademark to sell a genuine Louis Vuitton handbag, for example—there should be no trademark infringement at all.

Thus, it is not necessarily the case that something protected by a design patent will also function as a source indicator and thus be potentially protectable as trade dress, although it is more likely that this will occur with design patents as compared with utility patents. There are many patented inventions installed internally in the typical computer or television, but because none of them are visible to the consumer, their appearance is unlikely to be used as a way of conveying information about the source of the good. Design patents, however, present a greater possibility of overlap because the heart of a

Classic Lawn Ornaments, Inc., 843 F.2d 600, 607 (1st Cir. 1988)).

25. See, e.g., *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1296 (Fed. Cir. 2010) (describing the similarity in a patent infringement case as “market confusion”).

26. Nevertheless, the Supreme Court has described design patent infringement in terms that sound very much like trademark infringement. In *Gorham*, the Court wrote:

It is persons of [ordinary intelligence] who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the ‘cottage’ design, and, therefore, are the production of the holders of the *Gorham*, *Thurber*, and *Dexter* patent, when in fact they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.

Id. at 528. It would seem that the deception of the consumer should not matter at all to design patents, as the patent would be equally infringed if the consumer were fully aware that the manufacturer of the second item was not the plaintiff.

design patent is something that is visible and appreciated by the consumer. To the extent the subject of a design patent has value because of its ornamentation, it may also serve as a source indicator in that it simultaneously indicates to the consumer who is responsible for the pleasing design.

The fact that design patents and trade dress are directed at different types of consumer reaction does not mean that the two are less likely to be asserted concurrently or sequentially than design patent and copyright. Indeed, as a practical matter, the assertion of concurrent or sequential design patent protection and trade dress protection is more likely to arise than the similar assertion of design patent and copyright. As Sarah Burstein has written, if the design at issue is solely an applied design (in other words, essentially sits on top of and is conceptually separable from the underlying product), it is likely to be protectable by copyright law as well as by a design patent.²⁷ Given the longer term and cheaper cost of acquisition of copyright protection, as well as the fact that copyrighted matter is protected from the time of fixation, rather than only after examination, an IP owner could reasonably choose not to undergo the expense of design patent acquisition if it could achieve protection via copyright law.²⁸ By contrast, because trade dress protection for product design attaches only once the trade dress has acquired secondary meaning in the marketplace, a process that could take a year or more, an IP owner might be more motivated to seek a design patent at the outset of the design's release to the market, particularly when (as is reportedly the case at present) the time span for design patent acquisition is on the order of months.²⁹

27. Burstein, *supra* note 13, at 174 n.25 (“[I]t is difficult to imagine a situation in which a rational designer would incur the cost of obtaining a design patent for a design directed solely to surface ornamentation.”); *see also* Viva R. Moffat, *The Copyright/Patent Boundary*, 48 U. RICH. L. REV. (forthcoming Jan. 2014) (manuscript at 1), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2273840 (arguing for bright-line rule that industrial design should not be protected at all by copyright law because “if there is uncertainty, industrial designers are likely to pursue copyright protection rather than patent”).

28. Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 894-95 (writing in 1988 that “[f]or most designs, standard of invention is too high, the time required to obtain [design patent] protection too long, and the expense and bother of doing so too great in view of the probable returns”). As with other rapidly developing copyrightable subject matter, such as software, it is unclear how often copyright protection can be usefully invoked after the first few years of protection.

29. *Design Patents Are Still Relatively Quick*, PATENTLY-O, (Jan. 20, 2013, 6:29 AM), <http://www.patentlyo.com/patent/2013/01/design-patents-are-still-relatively-quick.html> (“[T]he bulk of design patents are issued within 12-months of the filing date and only a handful take more than three years to issue. . . . [M]ost design patents are issued without substantive rejection or amendment.”).

II. ENFORCING OVERLAPPING IP RIGHTS

The availability of more than one form of intellectual property protection for a single subject matter might be beneficial for an intellectual property owner but it poses some difficulty for those who are concerned about liability for unauthorized use. An entity that copies another's design, for example, cannot be confident that it is on safe ground if it ensures that it satisfies copyright law's fair use defense if the article is also protected by design patent law, which contains no fair use defense. If the design also functions as a company logo, further complications are raised given that fair use under the Lanham Act exists only in a limited number of narrow (and contested) statutory provisions, supplemented by vague First Amendment-related doctrines that have developed in the courts.³⁰

The different terms for each regime also raise concerns about use of the subject matter once the protections of a particular regime expire. For example, the design patent term in the United States is currently fourteen years.³¹ Once that term expires, design patent doctrine presumes that anyone is free to make the design that was the subject matter of the design patent. If that design is also protected by trade dress, however, and the design is still in use by the entity claiming trademark rights in it, the use of the design by a competitor might be alleged to be trade dress infringement.

It is for these reasons that some commentators have suggested that intellectual property owners be required to elect among regimes at the outset or, relatedly, to be held to the requirements of the regime whose protections expire first.³² In the case of a design patent, where either copyright law or trademark law would also apply, those rights would expire at the same time as the expiration of the design patent rights, as the design patent carries the shortest term. This proposal presents several complications. First, a doctrine of election is unlikely to be implemented by the same judicial system that participated in the expansion of intellectual property regimes discussed above. Additionally, a rule that held that intellectual property protections in overlap situations last only as long as the shortest term suffers from a similar lack of grounding in the doctrine and does nothing to solve the overlap problem during that term.

30. See generally William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008); William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267 (2010).

31. 35 U.S.C. § 173 (2011) ("Patents for designs shall be granted for the term of fourteen years from the date of grant."). But see Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, § 102(7), 126 Stat. 1527, 1532 (amending 35 U.S.C. § 173 "by striking 'fourteen years' and inserting '15 years'").

32. See *supra* note 1. Relatedly, several commentators have suggested amending the law so as to eliminate the overlap, such as eliminating copyright protection for "works of artistic craftsmanship." See, e.g., Ralph S. Brown, *Copyright-Like Protection for Designs*, 19 U. BALT. L. REV. 308, 321 (1989).

Moreover, it is unlikely that supporters of such a proposal would require a company that abandoned commercial use of a novel design to give up its design patent rights because it could no longer assert trade dress rights.

In order to explain why a remedies-focused approach is the preferred solution, I begin with an overview of judicial reactions to overlapping intellectual property regimes. As the next Subparts will show, courts take different views on the appropriateness of the overlap, depending on whether the issue is the existence of the right in the first instance or the assertion of the right in a later infringement suit.

A. *Establishing Overlapping Rights*

Earlier decisions held that the owner of subject matter that could qualify either for a design patent or for copyright protection must elect one regime at the time of registration. In each of these cases, the overlap question arose either as the result of an attempt to register rights when one set of rights had already been registered or as the result of an attempt to challenge the acquisition of rights as improper given the subject matter.

In *Louis De Jonge & Co. v. Breuker & Kessler Co.*, a 1910 circuit court case, the defendant attempted to defend against copyright infringement of the plaintiff's painting of holly, mistletoe, and spruce arranged in a square by arguing that the painting was created and intended for use on wrapping paper and so should have been limited to protection under design patent law.³³ The court rejected this argument, noting that, post-*Bleistein*, the design qualified for copyright protection and so "could not be definitely assigned for the present purpose either to the fine or to the useful arts, until the author or the owner decided under which statute he would protect his property."³⁴ But, the court cautioned, "it could not enter both," since "[t]he method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision."³⁵ The question of election, however, was not directly presented in the case (and so the court's comments were dicta), as the case involved only "whether a painting possessing artistic merit, but suitable also for use as a design, may at the owner's election be protected either by copyright or by patent."³⁶

In re Blood, a 1927 appellate case, held similarly, as it affirmed the Patent Office's refusal of a design patent registration for the shape of a ticket in light

33. 182 F. 150, 151 (C.C.E.D. Pa. 1910).

34. *Id.* at 151.

35. *Id.* at 152.

36. *Id.* at 153.

of the applicant's existing trademark registration of the same design, with text, as a label for its goods.³⁷ "The design is not entitled to double registration, once as a label design, and again as a design for a hosiery ticket," held the court.³⁸

Such a course would result for all practical purposes in an extension of the design monopoly. The applicant was entitled to apply for a patent for the design as a hosiery label, or he might complete the label, and register the design, so completed, as a label. He could not do both. He elected to pursue the latter course, and has obtained the protection thereby assured to him, and he is bound by that election.³⁹

By the mid-twentieth century, however, the view of the courts on concurrent rights changed. In *Mazer v. Stein*, a 1954 Supreme Court opinion, the plaintiff had secured a copyright in statuettes that it intended to mass produce as lamp bases.⁴⁰ The defendants, who had copied the statuettes without authorization for their own lamps, defended against a copyright infringement suit, as the defendant did in *De Jonge*, by alleging that the plaintiff's "publication as a lamp and registration as a statue to gain a monopoly in manufacture" constituted a misuse of copyright law and that the plaintiff should instead be limited to a design patent.⁴¹ The Court, having held that the statuettes were copyrightable,⁴² declined to assess whether the statuettes could also be protected by a design patent. But even if they could, the Court held, this did not render the plaintiff's use of copyright law illegitimate: "[T]he patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold."⁴³ The Court further held that this principle applied whether the copyright registration took place before or after the work was embodied in the useful article; such registration did not, the Court asserted, constitute copyright misuse.⁴⁴

Because the *Mazer* Court did not have to decide whether the statuettes were also protected by design patent, it did not reach the question of overlapping regimes. Subsequent cases in the lower courts, however, rejected the argument that an intellectual property owner, having availed itself of one regime, should be barred from acquiring rights under another regime.

37. 23 F.2d 772, 772 (D.C. Cir. 1927).

38. *Id.*

39. *Id.*

40. 347 U.S. 201, 202 (1954).

41. *Id.* at 206; *see also id.* at 216 ("Petitioner urges that overlapping of patent and copyright legislation so as to give an author or inventor a choice between patents and copyrights should not be permitted.")

42. *Id.* at 213-14. Justice Douglas, in his concurrence, questioned whether this was an appropriate conclusion. *See id.* at 219-21 (Douglas, J., concurring).

43. *Id.* at 217 (majority opinion).

44. *Id.* at 218-19.

In *In re Application of Mogen David Wine Corp.*, a 1964 Court of Customs and Patent Appeals case, the Trademark Trial and Appeal Board (TTAB) had refused to grant Mogen David Wine Corporation a trademark registration on the Principal Register for a wine decanter, as the plaintiff was already the owner (by assignment) of a design patent for the same decanter.⁴⁵ In its 1959 decision in *In re The Pepsi-Cola Co.*, the TTAB had held that the existence of a design patent for a spirally-fluted bottle for carbonated beverages did not preclude the registration of the bottle on the Supplemental Register.⁴⁶ Congress, the TTAB held, clearly contemplated the use of the Supplemental Register to receive trademark protection in foreign countries, even during the term of a design patent.⁴⁷ Reconciling its decision in the *Pepsi-Cola* case, the TTAB had held in *Mogen David Wine* that because registration on the Supplemental Register afforded the owner no presumptions of exclusive use, there was no risk of extending the monopoly enjoyed under the design patent.⁴⁸ Registration on the Principal Register, by contrast, would “be inimical to the rights of others conditioned under the patent grant to make fair use of the subject matter after expiration of the patent.”⁴⁹ But the CCPA rejected this argument on appeal:

[T]rademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not ‘extend’ the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it. 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 held under the patent law. Conversely, trademarks conceivably could end through non use during the life of a patent. We doubt it would be argued that the patent rights should also expire so as not to “extend” them.⁵⁰

In *In re Yardley*,⁵¹ a 1974 case from the Court of Customs and Patent Appeals, the court once again addressed the doctrinal overlap question, this time as to design patent and copyright. The applicant sought a design patent for

45. 328 F.2d 925, 926 (C.C.P.A. 1964).

46. 120 U.S.P.Q. (BNA) 468 (T.T.A.B. 1959).

47. *Id.*

48. *Mogen David Wine*, 328 F.2d at 927.

49. *Id.*

50. *Id.* at 930; *see also id.* at 928 (“As a manufacturer, one may make any unpatented article, but as a vendor, he may be restricted in the interest of fair competition.” (quoting 1 HARRY D. NIMS, THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS 390 (4th ed. 1947) (internal quotation marks omitted))).

51. 493 F.2d 1389 (C.C.P.A. 1974). Commentators have identified *Yardley* as the case in which courts broke with a prior history of requiring election. *See, e.g.*, Mues, *supra* note 4, at 543.

the ornamental design for a watch face (featuring a caricature of Spiro Agnew in which the arms and hands served as the hands of the watch). The examiner rejected the claim both on obviousness grounds and on estoppel grounds, given three existing copyright registrations for the same design, and that rejection was affirmed by the Patent Office Board of Appeals.⁵² On appeal, the court held that the existing copyright registrations should not themselves be a bar to obtaining design patent protection. First, the court noted, Congress must have intended there to be an overlap between statutory subject matter in copyright and statutory subject matter in design patent because the statutory provisions as to eligible subject matter facially admitted of such overlap.⁵³ Second, the court concluded, requiring election between the two doctrines would therefore be “in direct conflict with the clear intent of Congress manifested in the two statutory provisions,”⁵⁴ because Congress did not indicate a need to elect between the two doctrines in cases of overlapping eligibility.⁵⁵

Such cases led the Seventh Circuit in its 1993 opinion in *Kohler Co. v. Moen, Inc.*, to conclude that courts had generally 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.”⁵⁶ The case involved claims to both trade dress rights and design patent rights over faucet and faucet handle designs. Kohler, the defendant, contended that trade dress rights in product configurations were impermissible because intellectual property rights in industrial design should be the sole domain of design patents; to accord trade dress rights in configurations, Kohler argued, would impermissibly extend the patent term.⁵⁷ The Seventh Circuit rejected that argument, noting that because “[t]rademark protection is dependent only on public reaction to the trademark in the marketplace rather than solely on the similarity of the configurations,” the two regimes were conceptually and legally distinct.⁵⁸ Put otherwise, “[a] design patent gives the patentee a virtually absolute monopoly in the design, while a trademark allows competitive uses of a protected design so long as such uses do not create consumer confusion.”⁵⁹ The court held that Kohler was “free to copy Moen’s design so long as it

52. *Id.* at 1390-92.

53. *Id.* at 1394.

54. *Id.*

55. By 1995, the Copyright Office had also come around to the idea that there was “no longer any legal justification” for refusing copyright registration to elements of pictorial, graphic, and sculptural works for which a design patent had been issued. *See Registrability of Pictorial, Graphic, or Sculptural Works Where a Design Patent Has Been Issued*, 60 Fed. Reg. 15605 (Copyright Office Mar. 24, 1995) (amending 37 C.F.R. § 202.10).

56. 12 F.3d 632, 638 (7th Cir. 1993).

57. *Id.* at 637.

58. *Id.*

59. *Id.* at 638 n.8.

insures that the public is not thereby deceived or confused into believing that its copy is a Moen faucet.”⁶⁰ Notably, as it was reacting only to the argument that acquisition of overlapping rights was impermissible, the court did not need to reach the question of enforcement—in other words, whether the mere copying of Moen’s faucet would be sufficient grounds for concluding that the public would be “confused into believing that [Kohler’s] copy is a Moen faucet.”⁶¹ (I address this question later.)⁶²

Finally, although it was not the focus of the opinion, the Supreme Court lent its voice in 2000 to the chorus of courts finding no doctrinal issue with simultaneous intellectual property rights. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the plaintiff had claimed that the design of its children’s dresses was protectable trade dress and that Wal-Mart had engaged in trademark infringement by commissioning a manufacturer to produce dresses featuring a similar design.⁶³ The question in the case was whether the design of a product could be deemed inherently distinctive (and thus protectable as a mark *ab initio*) or whether the plaintiff should have to show that the design functioned as a source indicator by providing proof of acquired meaning. In holding that product design could not be inherently distinctive, and that proof that the design had acquired a source-identifying meaning was required,⁶⁴ the Court specifically highlighted the ability of the designer to turn to other intellectual property regimes for protection before acquired meaning could be developed:

Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit, and given the unlikelihood of inherently source-identifying design, the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle. That is especially so since the producer can ordinarily obtain protection for a design that is inherently source identifying (if any such exists), but that does not yet have secondary meaning, by securing a design patent or a copyright for the design—as, indeed, respondent did for certain elements of the designs in this case. The availability of these other protections greatly reduces any harm to the producer that might ensue from our conclusion that a product design cannot be protected under § 43(a) without a showing of secondary meaning.⁶⁵

60. *Id.* at 640 n.10; *see also* *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 960 (S.D.N.Y. 1995) (quoting and construing *Kohler*, 12 F.2d at 638, 640 n.10).

61. *Kohler*, 12 F.2d at 640 n.10; *cf.* Mark P. McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 844 (2011) (calling the court’s assertion that Kohler was free to copy Moen’s design “remarkably disingenuous, for the effect of trade dress protection was to deny Kohler the ability to copy Moen’s design for the purpose of competing with Moen in the market for faucets”).

62. *See infra* notes 157-160 and accompanying text.

63. 529 U.S. 205, 207-08 (2000).

64. *See id.* at 216.

65. *Id.* at 214. *But see* *Nimetz*, *supra* note 1, at 90 (“[T]he statutory monopoly granted by the [design] patent is intended to give the producer time to recover his development costs; it is not intended to supply a period in which to develop consumer association of the design

The Court thus contemplated that an IP owner might successfully, and properly, invoke all three regimes for an inherently distinctive design: copyright or design patent at the outset of the design's use, and trademark law once the design had spent enough time in the marketplace to acquire meaning as a source identifier.

B. *Enforcing Overlapping Rights*

Taken together, the cases discussed in the previous section establish the view of the federal courts that there is no threshold restriction on acquiring overlapping intellectual property rights for the same subject matter, provided that the requirements of each regime are met. These cases do not, however, dictate to what extent a particular intellectual property right will be enforced in any particular case, an issue that obviously cannot be resolved without taking the interests of the putative defendant into account.

One of these interests is the ability to use the subject matter of the intellectual property right once the term of protection has ended. In patent and copyright law cases, this interest is often expressed in the contractual terms of a *quid pro quo*: that implicit in the grant of the limited monopoly is a return promise to dedicate the subject matter of the grant to the public domain after the expiration of the term. The argument is made most strongly in patent cases. As the Supreme Court stated in *Grant v. Raymond* in 1832:

[I]t cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received: if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it during that time the public faith is pledged.⁶⁶

with the producer so that it will qualify as a trademark.”).

66. 31 U.S. (6 Pet.) 218, 241-42 (1832). The Court continued the contract analogy later in the opinion, in which it considered whether an error in the patent could be corrected and the patent reissued for the remainder of the existing term, or whether the error rendered the patent invalid:

The communication of the discovery to the public has been made in pursuance of law, with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to

Likewise, the Court stated in *Scott Paper Co. v. Marcalus Manufacturing Co., Inc.*, in 1945 that “the means adopted by Congress of promoting the progress of science and the arts is the limited grant of the patent monopoly in return for the full disclosure of the patented invention and its dedication to the public on the expiration of the patent.”⁶⁷

There are, of course, two ways this “bargain” can be characterized.⁶⁸ On one view, the bargain is simply a grant of a number of years of protection in exchange for the disclosure of the invention to the U.S. Patent and Trademark Office (and thus, upon publication, to the world). When the disclosure has occurred and the years have run, each party has fulfilled its obligations under the agreement. On another view, however, the patentee’s consideration is two-fold: in exchange for the limited monopoly, the patentee must not only disclose the invention to the public but also agree to forego any other legal rights that might attach to the invention as against the public after the expiration of the term. The latter view thus works as a doctrine of election of sorts, in that it tells the patentee that if it elects to participate in the patent system, it is giving up the right to assert other intellectual property rights as against the public after the patent term expires; it has, put differently, given the public an unfettered “right to copy” the subject matter of the patent.⁶⁹

Two related aspects of this argument merit closer consideration. First, we might query whether the quid pro quo argument has the same force in the

appropriate the discovery without paying the stipulated consideration. *Id.* at 244; *see also* *Bauer & Cie v. O’Donnell*, 229 U.S. 1, 10 (1913) (patent law “was passed for the purpose of encouraging useful invention and promoting new and useful improvements by the protection and stimulation thereby given to inventive genius, and was intended to secure to the public, after the lapse of the exclusive privileges granted, the benefit of such inventions and improvements”).

67. 326 U.S. 249, 255 (1945); *see also id.* at 256 (“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.”).

68. Graeme B. Dinwoodie, *The Story of Kellogg Co. v. National Biscuit Co.: Breakfast with Brandeis*, in *INTELLECTUAL PROPERTY STORIES* 220, 247 n.92 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006) (discussing various theories as to the “terms and conditions of the bargain”).

69. *Cf.* *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) (“The right to copy is even more robust when the copied product was previously patented but the patent has expired. In that case, the original producer has reaped his reward of a 17-year monopoly and the public has already ‘paid the congressionally mandated price for disclosure.’” (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989))).

courts as applied to copyright and design patents, both of which also involve limited monopolies for a set term. In its 2003 opinion in *Eldred v. Ashcroft*, the Court agreed to “demur” to the description of the Copyright Clause as empowering Congress to enact a bargain through copyright legislation.⁷⁰ But the Court’s view of that bargain in *Eldred* entailed the claim that that past authors would benefit from any extensions of copyright granted to future authors; it did not strongly support the view that the “copyright bargain” was between authors and the public. To the contrary, the Court noted that “our references to a *quid pro quo* typically appear in the patent context,” in which disclosure of the invention is the *quo* exchanged for the *quid* of patent protection.⁷¹ By contrast, the Court suggested, because no disclosure is required as a condition of securing copyright, the case for any *quid pro quo* in the copyright context is weaker. Copyright law may be justified by the ultimate goal of disseminating works of authorship to the public, but since the move in the 1976 Copyright Act from publication to fixation as the triggering event for protection, the diary tucked away in a desk drawer receives just as much protection as the best-selling novel. Thus, there is now nothing beyond creation that the author need do in order to receive copyright protection, and so whatever agreement exists cannot truly be characterized as “If you create for the public’s benefit, we will give you these rights.” Rather, the agreement is in the nature of a reward: “Whenever you create in a particular way, you will get these rights.”

As with copyright, design patents are offered as incentive for creation, not disclosure or publication. Unlike with utility patents, the public does not need the patentee to explain how the invention works; the subject matter of a design patent is apparent to all who view the article. The goal of the design patent scheme, therefore, is to generate creative activity for the ultimate aesthetic benefit of the public, and the right is in the nature of a reward for so doing, although examination narrows the class of creators who may benefit.⁷²

Nevertheless, in a 1947 opinion, the Second Circuit took the view that the end of the design patent term worked a dedication of the design to the public domain.⁷³ The plaintiff had brought suit against the defendant, alleging that the defendant’s sale of cologne in a particular bottle constituted unfair competition based on the plaintiff’s common law trademark rights in the shape of the bottle (what we would now term trade dress); the plaintiff had also held two design patents for the bottle shape that had since expired.⁷⁴ The Second Circuit

70. 537 U.S. 186, 214 (2003).

71. *Id.* at 216.

72. *See Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1872) (“It is the appearance itself . . . no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.”).

73. *See Lucien Lelong, Inc. v. Lander Co., Inc.*, 164 F.2d 395 (2d Cir. 1947).

74. *Id.* at 396.

rejected the claim on the grounds that the plaintiff had shown neither secondary meaning nor confusion, but it went on to discuss approvingly the district court's view that the plaintiff should not be allowed to assert trademark rights at all in light of the expired patent:

A patent is the grant of a temporary monopoly to the patentee; at its expiration all are free to use the invention. During the life of the patent a purchaser will naturally associate the produce with the producer, since the patent prevents others from producing. But such association does not furnish justification for an extension of such protection unlimited in time. . . . What cases there are clearly indicate that the expiration of a design patent effects a dedication of that design to the public.⁷⁵

The court went on to distinguish material in the public domain that had never been patented, noting: "If in return for the statutory monopoly for a term the patentee is held thereafter to dedicate his invention to the public, it would naturally follow that where he has never had this monopoly he has nothing to give up."⁷⁶ This is therefore a strong version of the quid pro quo argument: If the plaintiff has taken advantage of the patent system, it agrees to cede trade dress rights; if it chooses to market the product without seeking a patent, it cedes the patent rights but not trade dress rights.

But thirty years later, this view appeared to have changed. In *In re Yardley*, discussed earlier,⁷⁷ the Court of Claims and Patent Appeals rejected the quid pro quo argument as a basis for denying concurrent design patent and copyright protection. "[T]he mere fact that the copyright will persist beyond the term of any design patent which may be granted," the court held, "does not provide a sound basis for rejecting appellant's design patent application."⁷⁸ Indeed, the court rejected the analogy to contract (through the use of the concept "failure of consideration"), noting that a patent should be governed by property principles, not by contract principles.⁷⁹ The court took a similar view in its decision in *In re Honeywell, Inc.*⁸⁰ the same year. In that case, Honeywell had appealed from the decision of the TTAB refusing registration of its thermostat configuration on the grounds that the configuration had been the subject matter of an expired design patent. The CCPA reversed, noting the "clear distinction between the underlying bases of the federal trademark and design patent laws":

[T]he 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

75. *Id.* at 397-98 (citation omitted).

76. *Id.* at 398.

77. See *supra* notes 51-55 and accompanying text.

78. *In re Yardley*, 493 F.2d 1389, 1395 (C.C.P.A. 1974).

79. *Id.*

80. 497 F.2d 1344 (C.C.P.A. 1974).

of others.⁸¹

This perspective highlights the second aspect of the “right to copy”/quid pro quo argument that merits further analysis. Even if we view patent law or copyright law as embodying a contractual agreement that once the term expires, the subject matter of the copyright or patent is dedicated to the public, we should be clear about what we mean by “subject matter.” The right to copy or use the inventive aspect of an article covered by a design patent or the creative aspect of a work of authorship covered by copyright does not necessarily entail a right to be free from trademark and unfair competition law’s requirement to avoid consumer confusion. The right to copy a pharmaceutical no longer under patent, for example, does not give the copier the right to label the drug in whatever manner it desires; likewise, the right to copy a painting no longer under copyright does not give the copier the right to unfettered access via breaking into a museum after hours to set up her easel. Indeed, this is the lesson with respect to unfair competition law specifically in a line of cases from the Court, all of which permit the competitor to copy the subject matter of an expired patent but impose an affirmative obligation on the competitor’s part to label its goods or otherwise make clear to consumers the source of manufacture.

In *Singer Manufacturing Co. v. June Manufacturing Co.*, an 1896 case, the Supreme Court was faced with a number of sewing machines manufactured by the Singer Manufacturing Company on which the patent had expired.⁸² The defendant had manufactured virtually identical machines for sale and, in so doing, had not only called them “Singer” machines but had also copied certain of the labeling that the Singer company had used. The Court held, first, that the expiration of the patent meant that the defendant, like any member of the public, had the “right to make the thing formerly covered by the patent,” as it is “upon this condition that the patent is granted.”⁸³ Second, the Court held that this grant to the public included not only the form of the object but also the generic name of the object, even if that name had been developed or invented by the former patent holder or was the surname of the patentee. “To say otherwise,” said the Court, “would be to hold that although the public had

81. *Id.* at 1348. On remand, the TTAB held that the feature that Honeywell attempted to register was de jure functional; the Court of Claims and Patent Appeals affirmed that finding. *In re Honeywell, Inc.*, 532 F.2d 180, 181 (C.C.P.A. 1976); *see also* *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 605 (S.D.N.Y. 1996) (Sotomayor, J.) (“When a design patent expires, the design becomes copyable. It may not, however, be copied in such a way that customers are deceived about what they are buying.”), *overruled on other grounds by* *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.2d 373, 378 n.3 (2d Cir. 1997). Notably, *Krueger* was decided before the Supreme Court’s decision in *Wal-Mart Stores, Inc. v. Samara Bros, Inc.*, 529 U.S. 205 (2000), that product design could not be inherently distinctive trade dress.

82. 163 U.S. 169, 169 (1896).

83. *Id.* at 185.

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.”⁸⁴ However, the Court also held that the same public interest that supported the dedication of the formerly patented object to the public also supported the principle that such use carried a duty to take such precautions “as will protect the property of others and prevent injury to the public interest.”⁸⁵ Thus, where the generic name also served as a trademark in some instances, the failure to clearly indicate the source of manufacture would be an improper act that would both harm the goodwill of the mark holder and risk deceiving the public. “[T]o compel,” the Court wrote, “the one who uses the name after the expiration of the patent, to indicate that the articles are made by himself, in no way impairs the right of use, but simply regulates and prevents wrong to individuals and injury to the public.”⁸⁶

In the case at hand, the Court held that while the defendant’s advertisements made clear that the machines it sold were from the June Manufacturing Company, the machines themselves did not contain sufficient notice of their source, both via acts of omission and via acts of commission. For example, the Court noted that an oval plate on the machines contained the words “Improved Singer” but did not contain anything to indicate that the machines were made by the defendant. Similarly, the Court highlighted that a marking on the legs of the stand contained the word “Singer” in bold with “I.S.” above and “J. Mfg. Co.” in small letters. “The similarity between the letter J. and the letter S., the failure to state in full the name of the manufacturer, the general resemblance to the device of the Singer Company, the place where it was put, which had no necessary connection with the structure or working capacity of the machines, and the prominence of the casting of the word ‘Singer’ in comparison with the other mark,” the Court noted, “bring out in the plainest way the purpose of suppressing knowledge of the actual manufacturer, and suggesting that it was made by the Singer

84. *Id.*

85. *Id.* at 186.

86. *Id.* at 187; *see also id.* at 199-200 (“[W]here, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. Where another avails himself of this public dedication to make the machine and use the generic designation, he can do so in all forms, with the fullest liberty, by affixing such name to the machines, by referring to it in advertisements and by other means, subject, however, to the condition that the name must be so used as not to deprive others of their rights or to deceive the public, and, therefore, that the name must be accompanied with such indications that the thing manufactured is the work of the one making it, as will unmistakably inform the public of that fact.”).

Company.”⁸⁷ Thus, concluded the Court, because the defendant had the right to use the word “Singer,” “it is plain that the infringement only resulted from the failure to plainly state along with the use of that word the source of manufacture.”⁸⁸ The Court reversed and remanded, with directions to enter an injunction enjoining the defendant from using the word Singer “without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished from the sewing machines made by the Singer Manufacturing Company.”⁸⁹

In a companion case decided the same day,⁹⁰ the Court held that although the defendant was legally permitted to sell the sewing machines at issue and to use the name Singer in doing so, he could not engage in other activity that would likely deceive consumers into believing that the machines were made by the Singer Manufacturing Company, such as including a brass plate with the lettering “New York S.M. Mfg. Co.” that resembled Singer’s own brass plates.⁹¹ The Court thus reversed the order of the lower court in the defendant’s favor and remanded with directions to enter judgment in favor of Singer, enjoining the defendant from

marking upon sewing machines made or sold by him, or upon any plate or device connected therewith or attached thereto, the word ‘Singer,’ or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and not the manufacture of the Singer Manufacturing Company.⁹²

In both *Singer* cases, then, the Court suggested that even though the defendants were availing themselves of the right to use what had then become a generic term—a word that, essentially, the defendants had a “right to copy”—they could not do so without taking additional steps to minimize consumer confusion in the marketplace.

One might argue that the *Singer* cases do not truly implicate any limitations on the “right to copy,” since the apparent consumer confusion emanated only from the use of the word “Singer” and not from the shape of the formerly patented machines. But *Kellogg Co. v. National Biscuit Co.*,⁹³ in which the Court considered an unfair competition suit brought by National Biscuit

87. *Id.* at 201.

88. *Id.* at 204.

89. *Id.*

90. *Singer Mfg. Co. v. Bent*, 163 U.S. 205 (1896).

91. *Id.* at 206 (“It is plain that the position and size as well as the inscription found on these devices were calculated to deceive by creating the impression, on one not familiar with all the details of the marks of the Singer Manufacturing Company, that they were the marks of that company.”).

92. *Id.* at 207.

93. 305 U.S. 111 (1938).

Company against Kellogg Company over Kellogg's sale of shredded wheat breakfast cereal in the form of a pillow-shaped biscuit, provides more context in this regard. The process of manufacturing shredded wheat had previously been protected by a utility patent and the pillow shape by a design patent; the utility patent had expired and the design patent was declared invalid one year before its expiration.⁹⁴ Accordingly, Kellogg argued that it had the right not only to manufacture cereal in a pillow-shaped form but also to call it "shredded wheat," the term that National Biscuit Company had been using. National Biscuit Company did not deny that Kellogg had the right to use the formerly patented process but alleged that both the pillow-shaped form and the term "shredded wheat" continued to have trademark significance and that Kellogg's use constituted passing off.⁹⁵ The Court, citing *Singer v. June*, held that when the patent expired on the process of making shredded wheat, the generic designation of the patented product also passed to the public.⁹⁶ Nevertheless, the Court continued, the fact that some residual association between the term and the plaintiff might exist—what we today would call de facto secondary meaning—entitled the plaintiff to demand that the defendant "use reasonable care to inform the public of the source of its product."⁹⁷ This would have been true even if Kellogg had not used the term "shredded wheat" but had availed itself only of the right to copy the biscuit shape: "Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff."⁹⁸ And this the Court held that Kellogg had done: Given that virtually all of Kellogg's shredded wheat was sold to consumer in cartons, which were clearly marked with the Kellogg name, Kellogg had indeed taken reasonable care to prevent consumer confusion, even if some small degree of confusion might remain.⁹⁹

What are now known as the *Sears/Compco* cases make the point even more starkly: Even when patent law grants the right to copy an article, a court may require additional labeling, disclaimers, or other statements pursuant to unfair competition law to mitigate consumer confusion. In *Sears, Roebuck & Co. v. Stiffel Co.*, decided in 1964, Stiffel brought suit against Sears for infringement of Stiffel's utility and design patents on a pole lamp and for state unfair competition, on the grounds that by selling a substantially identical lamp, Sears had confused consumers as to the source of the lamp.¹⁰⁰ The district court held the patent invalid for lack of invention, a ruling that was not challenged on

94. *Id.* at 119 n.4.

95. *Id.* at 116.

96. *Id.* at 117.

97. *Id.* at 118-19 ("The only obligation resting upon Kellogg Company was to identify its own product lest it be mistaken for that of the plaintiff.").

98. *Id.* at 120.

99. *Id.* at 120-22.

100. 376 U.S. 225, 225-26 (1964).

appeal, so the question was whether the sale of an object substantially similar to an unpatented item could be the basis of an unfair competition claim.¹⁰¹ In holding that it could not, the Court was concerned with using state unfair competition law as an end-run around the federal patent laws. Federal patent law, the Court held, embodies a congressional policy of “granting patents only to true inventions, and then only for a limited time,” after which the “right to make the article—including the right to make it in precisely the shape it carried when patented—passes to the public.”¹⁰² Thus, a suit based on nothing more than the identical appearance of the two lamps was an impermissible patent suit, not an unfair competition suit, but a state “may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source [of the goods].”¹⁰³ *Compco Corp. v. Day-Brite Lighting, Inc.*, was decided the same day to the same effect.¹⁰⁴

Two related aspects of the Court’s opinions in *Sears/Compco* are worth highlighting. First, the Court was careful to note the different purposes and goals of the different intellectual property regimes: patent law governs the right to make the patented article, while unfair competition law governs source identification. Second, the Court was sensitive to the attempt to circumvent the boundaries of one intellectual property regime by denominating the claim as something else. The state claim at issue, although characterized as an unfair competition claim, was in reality an attempt to prevent the copying of the lamp, full stop, and thus was really a patent-like claim.

Both of these aspects were present in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,¹⁰⁵ decided in 1989. In that case, the Court considered the validity of a Florida statute enacted in 1983 that made it unlawful to “use the direct molding process to duplicate for the purpose of sale any manufactured vessel hull or component part of a vessel made by another without the written permission of that other person.”¹⁰⁶ The plaintiff company, which had marketed a successful hull design for over seven years without patent protection, filed suit under the statute in 1984, alleging that the defendant had unlawfully duplicated its hull design. The defendant argued that the statute was invalid under the Supremacy Clause of the U.S. Constitution because it conflicted with federal patent law, in that it provided patent-like protection to

101. *Id.*

102. *Id.* at 230-31.

103. *Id.* at 232.

104. 376 U.S. 234, 238-39 (1964) (“And of course a State cannot hold a copier accountable in damages for failure to label or otherwise to identify his goods unless his failure is in violation of valid state statutory or decisional law requiring the copier to label or take other precautions to prevent confusion of customers as to the source of the goods.”).

105. 489 U.S. 141 (1989).

106. *Id.* at 144-45 (internal quotation mark omitted).

an article that, because it had already been marketed to the public without protection, was in the public domain and so was free to be copied.¹⁰⁷ The Supreme Court agreed, holding that “state regulation of intellectual property must yield to the extent that it clashes with the balance struck by Congress in our patent laws.”¹⁰⁸ Since federal law mandates that the subject matter of an expired patent (or subject matter that was never patented) be free to copy, Florida’s statute to the contrary was preempted.¹⁰⁹

The Court’s holding relied on three intellectual steps. First, the Court’s characterization of federal law depended on a quid pro quo argument. The limited term of the patent is offered in exchange for disclosure of the invention to the public; thus, there is no agreement, and federal patent law does not prevent copying, where the subject matter has already been disclosed to the market or the patent term has expired.¹¹⁰ Second, state law interferes with this determination when it provides patent-like protection to unprotectable subject matter, even if the statute is in name an unfair competition law.¹¹¹ The Florida statute, for example, was not limited to instances of consumer confusion or passing off; it was “aimed directly at preventing the exploitation of the design and utilitarian conceptions embodied in the product itself” in order to induce improvement in boat hull designs.¹¹² And finally, as in the cases already discussed, the Court noted that the states were free to offer limited protection—such as protection against consumer confusion as to source—that did not interfere with the federal patent scheme.¹¹³

The case law just recounted holds that the “right to copy” afforded by patent law and copyright is just that: a right to copy the subject matter that was formerly the subject of patent or copyright protection, but not a freedom from additional requirements necessary to remedy unfair competition violations. Two more recent cases, however—*TraFFix Devices, Inc. v. Marketing Displays*,

107. *Id.*

108. *Id.* at 152.

109. *Id.*

110. *See id.* at 150-51 (“The federal patent system . . . embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.”); *id.* at 156 (“[W]e 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.”).

111. *Id.* at 157 (“It is readily apparent that the Florida statute does not operate to prohibit ‘unfair competition’ in the usual sense that the term is understood.”).

112. *Id.* at 158; *see also id.* at 160 (“In essence, the Florida law prohibits the entire public from engaging in a form of reverse engineering of a product in the public domain. This is clearly one of the rights vested in the federal patent holder, but has never been a part of state protection under the law of unfair competition or trade secrets.”).

113. *See id.* at 166-67 (noting that the very existence of section 43 of the Lanham Act, 15 U.S.C. § 1125(a), indicates Congress’s recognition that unfair competition law and patent law can coexist).

Inc.,¹¹⁴ and *Dastar Corp. v. Twentieth Century Fox Film Corp.*¹¹⁵—must be distinguished. Like the earlier cases, *TrafFix* involved an unfair competition suit against a competitor who copied the subject matter of an expired patent (a dual-spring stand for outdoor road signs).¹¹⁶ The Court likewise ruled in favor of the defendant, but beyond noting that the defendant was not required to hide from public view the technology it copied,¹¹⁷ the Court did not consider any affirmative obligation on the defendant's part to dispel consumer confusion. This omission, however, was not surprising, since the focus in *TrafFix* was on evidentiary, not doctrinal matters. As the case involved the “well-established rule that trade dress protection may not be claimed for product features that are functional,”¹¹⁸ the question before the Court was whether the plaintiff had satisfied its burden to show that the dual-spring mechanism for which it claimed trade dress protection was not functional. Indeed, the Court specifically declined to accept suggestions from *TrafFix* and two of its supporting amici that the Court rest its holding on the patent bargain's “right to copy” that provided the foundation for the Court's holding in *Singer v. June*.¹¹⁹

Dastar, by contrast, did specifically invoke the quid pro quo of *Sears* and *Kellogg*. At issue in the case was a television series that was no longer under copyright and thus was free for all to copy. The plaintiff alleged that the defendant's marketing of the series on videotape under its own name constituted unfair competition (in the form of reverse passing off).¹²⁰ Recalling the line of cases just discussed, the Court held, not surprisingly, that the defendant was free to copy the formerly protected work.¹²¹ But it also added, contrary to those cases, that the defendant had no obligation to engage in labeling that would lessen consumer confusion as to the source of manufacture, assuming that the source for a communicative good is the author of the work. Indeed, the Court held, to require any such labeling would “create a species of mutant copyright law that limits the public's ‘federal right to ‘copy and to use’ expired copyrights.”¹²²

114. 532 U.S. 23 (2001).

115. 539 U.S. 23 (2003).

116. 532 U.S. at 25-26.

117. *Id.* at 34.

118. *Id.* at 29.

119. *Id.* at 35 (“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.”).

120. *Dastar*, 539 U.S. at 26-27.

121. *Id.* at 33-34, 38.

122. *Id.* at 34 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)); see also *id.* at 33 (“The right to copy, and to copy without attribution, once a copyright has expired, like ‘the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public.”) (alteration in original) (quoting *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225,

Contrary to the cases just discussed, *Dastar* involved a communicative or intellectual product rather than a physical one; as a result, it presents complicated and different questions of copying and production.¹²³ As noted, however, each of the previous cases held that mandating limited relief under the Lanham Act would *not* interfere with the right to copy formerly protected material; indeed, *Kellogg* characterized reasonable efforts to eliminate consumer confusion under those circumstances as an obligation.¹²⁴ But because of the particular facts of *Dastar*, its posture as a reverse passing off case, and the sweeping nature of its holding, the Court had no need to inquire into the effect on consumers of the defendant's existing labeling.¹²⁵ Thus, despite *Dastar*'s broad characterization of the case law on which it relied, its holding should be seen as dependent on the particular circumstances in that case and not as a complete repudiation of the precedent holding that the right to copy does not absolve one of the obligation to minimize consumer confusion.¹²⁶

What is important to recognize about *TrafFix* and *Dastar*, however, is the likely reason that the Court in those cases suggested (if only by omission in *TrafFix*) that the defendant had no obligation even to consider unfair competition principles. In both cases, the plaintiff was characterized as a bad

230 (1964))).

123. In other words, although the defendant in *Kellogg* was permitted, once the patent no longer pertained, to do what patent law formerly prohibited—making and selling the article without prior authorization—unfair competition law might still have required some labeling as to the fact that it was the defendant, and not the plaintiff, that was doing it. *See Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 120 (1938). Analogously, the defendant in *Dastar* was permitted, once the copyright expired, to do what copyright law formerly prohibited: making decisions about how the work would be used and distributed (questions of fair use and other defenses aside). Similarly, then, unfair competition law might still have required the defendant to engage in labeling to inform consumers that it, and not the plaintiff, was responsible for those decisions. The fact that *Dastar* was a reverse passing-off case, and not a traditional passing-off case, complicates the analogy.

124. *See Kellogg*, 305 U.S. at 120; *see also, e.g.*, *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) (Ginsburg, J.) (holding that where the defendant uses the same generic term as the plaintiff, “the subsequent competitor cannot be prevented from using the generic term to denote itself or its product, but it may be enjoined from passing itself or its product off as the first organization or its product. Thus, a court may require the competitor to take whatever steps are necessary to distinguish itself or its product from the first organization or its product,” and proceeding to cite cases).

125. Part of the difficulty is that the previous cases concerned claims of passing off, where the defendant's obligation could consist merely of affirmatively identifying itself as the manufacturer of the goods. The *Dastar* Court's concern in the reverse passing off case at issue there was that it would be difficult to determine what an appropriate disclosure should look like. The Court resolved these practical difficulties by interpreting “origin of goods” in section 43(a) to refer to the physical good (the videotape), not the communicative content it contained, thus rendering *Dastar*'s representation of source not misleading. 539 U.S. at 35-37.

126. For a thoughtful consideration of *Dastar*'s implications at the copyright/trademark interface, see Mark P. McKenna, *Dastar's Next Stand*, 19 J. INTELL. PROP. L. 357 (2012).

actor, attempting to use unfair competition law to achieve a patent- or copyright-related goal that was unavailable under those doctrines. In arguing as counsel for *Traffix* at the Court, now-Justice Roberts framed the issue in the case as follows:

But then MDI's patents expired, as under the Constitution all patents eventually must. Sometime thereafter, Traffix Devices, the petitioner, copied MDI's stand, added some improvements of its own, and marketed a competing version. No longer armed with its patents, MDI tried a new tack to exclude competition. It claimed that the configuration of its stand, the same dual-spring design that it had touted as patent-protected during the term of the patents, was protected as trade dress and could not be copied.¹²⁷

Similarly, Twentieth-Century Fox, the plaintiff in *Dastar*, was almost certainly trying to make up for the failure to renew the copyright in the work at issue, which failure had allowed the work to fall into the public domain in the first place. Indeed, the Second Circuit has read *Traffix* and *Dastar* in precisely this way, noting that these cases suggest the general principle "that intellectual property owners should not be permitted to recategorize one form of intellectual property as another, thereby extending the duration of protection beyond that which Congress deemed appropriate for their actual creative efforts"¹²⁸

Thus, we see in the Court's jurisprudence two related principles. First, there is no general bar to asserting one category of intellectual property claims even when another category would permit the defendant's activity. The fact that patent law would permit the defendant to copy the subject matter at issue does not mean that the defendant might not also be required, in appropriate circumstances, to label the article so as to make its source clear. (We must obviously count *Dastar* as an exception to this principle at the copyright/trademark interface, despite its inconsistency with precedent.) Second, courts are (and, I will argue, should be) attentive to instances in which the assertion of a claim is remote from the interest at the heart of the doctrine at issue. Where the courts sense that plaintiffs are attempting an end-run around the limitations of a particular legal doctrine, they often prevent those plaintiffs from continuing to assert their claims. I discuss this phenomenon—which is typically termed "misuse" in the intellectual property realm—in the next Subpart.

127. Transcript of Oral Argument at 3-4, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001), (No. 99-1571), available at http://www.supremecourt.gov/oral_arguments/argument_transcripts/99-1571.pdf.

128. *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 n.2 (2d Cir. 2005); see also *IQ Group, Ltd. v. Wiesner Publ'g, LLC*, 409 F. Supp. 2d 587, 592-93 (D.N.J. 2006) (rejecting interpretation of 17 U.S.C. § 1202(c)'s reference to "copyright management information" to include company logo on the grounds that plaintiff "should not be permitted to recategorize its mark so as to invoke copyright protection").

C. *Overlapping Rights and Remedies*¹²⁹

Originally existing as an equitable doctrine only in patent law, the viability of the misuse doctrine in copyright law has since been well established, albeit not in every federal circuit.¹³⁰ In both intellectual property areas, the doctrine derives from the “unclean hands” principle used as an equitable backstop in many areas of law. The justification is, generally, that a plaintiff who has taken the benefit of the public grant provided by copyright and/or patent law should not be allowed to enforce the limited monopoly in court when, as against the defendant in the case or as against other entities, it has overreached in exercising those rights.¹³¹

The case typically identified as the landmark patent misuse doctrine is *Morton Salt Co. v. G.S. Suppiger Co.*,¹³² in which the Court held that the holder of a patent on a salt-depositing machine could not assert its patent against an alleged infringer where the patent holder had required licensees to

129. The following three paragraphs are largely taken from Heymann, *supra* note 22, at 90-93.

130. The doctrine has been recognized by courts in almost every circuit (some expressly, some more hypothetically). *See, e.g.*, *Chamberlain Grp., Inc. v. Skylink Techs., Inc.*, 381 F.3d 1178, 1201 (Fed. Cir. 2004); *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 204-06 (3d Cir. 2003); *Assessment Techs. of Wis., LLC v. WIREdata, Inc.*, 350 F.3d 640, 647 (7th Cir. 2003); *Alcatel USA, Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 793 (5th Cir. 1999); *Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*, 121 F.3d 516, 520 (9th Cir. 1997); *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 973-77 (4th Cir. 1990); *United Tel. Co. of Mo. v. Johnson Publ'g Co.*, 855 F.2d 604, 610-12 (8th Cir. 1988); *Shady Records, Inc. v. Source Enters., Inc.*, No. 03 CIV 9944 (GEL), 2004 U.S. Dist. LEXIS 26143, at *50 (S.D.N.Y. Jan. 3, 2005); *Ass'n of Am. Med. Colls. v. Princeton Review, Inc.*, 332 F. Supp. 2d 11, 17-20 (D.D.C. 2004); *In re Indep. Serv. Orgs. Antitrust Litig.*, 114 F. Supp. 2d 1070, 1113-14 (D. Kan. 2000).

The First, Sixth, and Eleventh Circuits remain more equivocal. *See Garcia-Goyco v. Law Envtl. Consultants, Inc.*, 428 F.3d 14, 21 n.7 (1st Cir. 2005) (“This court has not yet recognized misuse of a copyright as a defense to infringement.”); *Telecom Tech. Servs. v. Rolm Co.*, 388 F.3d 820, 831 (11th Cir. 2004) (avoiding decision as to whether to recognize a copyright misuse defense); *Microsoft Corp. v. Compusource Distribs., Inc.*, 115 F. Supp. 2d 800, 810 (E.D. Mich. 2000) (finding that defendants had failed to raise a material issue of fact with respect to copyright misuse).

131. *See, e.g.*, Brett M. Frischmann & Daniel Moylan, *The Evolving Doctrine of Copyright Misuse*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 269, 269 (Peter Yu ed., 2007); Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095, 1113 (2003); Ralph D. Clifford, *Simultaneous Copyright and Trade Secret Claims: Can the Copyright Misuse Defense Prevent Constitutional Doublethink?*, 104 DICK. L. REV. 247, 287 (2000); Lydia Pallas Loren, *Slaying the Leather-Winged Demons in the Night: Reforming Copyright Owner Contracting with Clickwrap Misuse*, 30 OHIO N.U. L. REV. 495, 514 (2004); Note, *Clarifying the Copyright Misuse Defense: The Role of Antitrust Standards and First Amendment Values*, 104 HARV. L. REV. 1289, 1304-07 (1991); Kathryn Judge, Note, *Rethinking Copyright Misuse*, 57 STAN. L. REV. 901, 904 (2004); David Scher, Note, *The Viability of the Copyright Misuse Defense*, 20 FORDHAM URB. L.J. 89, 101 (1993).

132. 314 U.S. 488 (1942).

use its machine only in conjunction with the patent holder's (unpatented) salt tablets.¹³³ Equitable considerations should bar the patent infringement suit, the Court held, because the patent monopoly is granted as a "special privilege" that includes as an unstated term the obligation to assert that privilege only in a manner consistent with public policy—specifically, the exclusion from the patent grant of anything not included with the patented invention.¹³⁴ Thus, a patentee that uses its monopoly in the patented article to acquire a monopoly in an unpatented article should be forbidden from enforcing its patent at all until the misuse ends.

Courts have on occasion deployed the misuse doctrine to prevent copyright owners from asserting copyright in ways that seem far removed from the economic interests traditionally seen to be at the core of copyright law, even when antitrust interests are not at stake, as they were in *Morton Salt*.¹³⁵ For example, in *Omega S.A. v. Costco Wholesale Corp.*, a 2011 decision, the plaintiff luxury watchmaker engraved a small design on the reverse side of its watches in order to be able to assert that the unauthorized importation of those watches by a discount store constituted copyright infringement.¹³⁶ The court granted summary judgment on the infringement claim to the defendant, holding that Omega misused its copyright in the design in order to control the importation of the watches.¹³⁷

We might also characterize as motivated by misuse-like considerations the instances in which courts push back against perceived end-runs around doctrinal limitations. One example from outside the intellectual property realm is *Hustler Magazine v. Falwell*.¹³⁸ The Reverend Jerry Falwell, a nationally known minister who often commented on public issues, brought suit against Hustler Magazine and its publisher, Larry Flynt. The suit was over a parody advertisement on the inside front cover of the November 1983 issue of the

133. *Id.* at 492.

134. *Id.*

135. See, e.g., *Assessment Techs. of Wis., LLC*, 350 F.3d at 647 (contending that the doctrine is appropriate where a plaintiff uses a copyright infringement suit to obtain property protection (for example, in data) "that copyright law clearly does not confer"); *Video Pipeline*, 342 F.3d at 205-06 (asserting that the doctrine is potentially appropriate where the copyright holder uses an infringement suit "to restrict expression that is critical of it") (dicta); Frischmann & Moylan, *supra* note 131, at 274 (noting that courts have used the copyright misuse doctrine "to reinforce subject matter limitations and channeling doctrines that maintain boundaries"); Robert P. Merges, *The End of Friction? Property Rights and Contract in the "Newtonian" World of On-Line Commerce*, 12 BERKELEY TECH. L.J. 115, 124 (1997). Relatedly, Dan Burk articulates an additional function for misuse: "preserving the courts from the reputational damage of enforcing legal claims that might be technically legitimate but which would lead to socially perverse outcomes." Burk, *supra* note 131, at 1133.

136. No. CV 04-05443 TJH, 2011 U.S. Dist. LEXIS 155893, at *1-3 (E.D. Cal. 2011).

137. *Id.* at *4.

138. 485 U.S. 46 (1988).

magazine. Based on ads for Campari Liqueur that featured celebrities talking about their “first time” (the meaning was the first time they had tried Campari, although the double entendre was surely obvious), the parody ad had Falwell stating that his “first time” was “during a drunken incestuous rendezvous with his mother in an outhouse.”¹³⁹ In his complaint, Falwell alleged that the ad constituted an invasion of privacy, libel, and an intentional infliction of emotional distress. The district court directed a verdict in Hustler’s favor on the privacy claim, and the jury found for the magazine on the defamation claim, concluding that the ad could not reasonably be understood to state actual facts; the jury found for Falwell on the emotional distress claim.¹⁴⁰ The issue before the Court, then, was whether the First Amendment limitations applicable to the defamation claim after *Times v. Sullivan*,¹⁴¹ based on Falwell’s position as a public figure, would apply equally to the emotional distress claim based on the same material. In holding that such limitations did apply, the Court focused on the public interest in engaging in debate about public affairs and the “breathing room” necessary to afford free debate that motivated the rule in *Times v. Sullivan*, an interest that would be thwarted if public figures could evade First Amendment limitations by changing the name of their claim.¹⁴²

Another example is *Brown & Williamson Tobacco Co. v. Jacobson*, in which the Seventh Circuit, having reversed the dismissal of the plaintiff corporation’s count alleging defamation based on a television broadcast, affirmed the dismissal of the count alleging wrongful interference with business relations based on the same broadcast.¹⁴³ The court noted that “[a]ny libel of corporation can be made to resemble in a general way this archetypal wrongful-interference case,” in that the allegation would be that the defamation caused customers to stop doing business with it.¹⁴⁴ But the court saw such allegations as an attempt to evade the limitations attendant to defamation doctrine, noting in particular that it was evident that the plaintiff did not believe that the broadcaster had any intent other than to increase viewership and so could not truly articulate the kind of harm that underlies a wrongful interference claim.¹⁴⁵

One final example (perhaps not coincidentally, also from the Seventh

139. *Id.* at 48.

140. *Id.* at 48-49.

141. The Court had held in *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964), that in order for a public figure to recover for the harm caused by a defamatory falsehood, he or she had to show that the statement was made “with knowledge that it was false or with reckless disregard of whether it was false or not.” *Id.* at 280.

142. *Falwell*, 485 U.S. at 53-56.

143. *Brown & Williamson Tobacco Co. v. Jacobson*, 713 F.2d 262, 273-74 (7th Cir. 1983).

144. *Id.* at 273.

145. *Id.* at 273-74.

Circuit) is *J.H. Desnick, M.D. v. American Broadcasting Companies, Inc.*¹⁴⁶ *Desnick* involved an ophthalmic clinic and two of its doctors who brought suit against a television network and others over an undercover report that claimed that the clinic performed unnecessary cataract surgery on its patients. The plaintiffs brought suit primarily for defamation, based on the content of the broadcast, and for trespass, on the grounds that the plaintiffs would never have granted permission to the undercover reporters (who were posing as patients) had their true motives been known.¹⁴⁷ After holding that the lower court improperly dismissed the defamation claim,¹⁴⁸ the Seventh Circuit held that, by contrast, the trespass claim was properly dismissed. The harm allegedly suffered by the plaintiffs—a reputational harm based on the accusations in the broadcast—was a defamation-type harm. That harm might have been facilitated by the entry onto the plaintiff’s property, but the plaintiffs were not truly complaining about an injury to the inviolability of their land ownership.¹⁴⁹ (We can assume that the plaintiffs would not have complained if the television broadcast had been favorable, even though such a broadcast would have resulted from the same unauthorized entrance onto the plaintiffs’ property.)¹⁵⁰ Put otherwise, in the Seventh Circuit’s words, “[t]here was no invasion in the present case of any of the specific interests that the tort of trespass seeks to protect.”¹⁵¹ The upshot of these cases, then, is not a conclusion that the plaintiff has no emotional distress, interference with business relations, or trespass rights to assert whatsoever; rather, it is a determination that the nature of the harm asserted in the cases at hand did not align with those interests.¹⁵²

146. 44 F.3d 1345 (7th Cir. 1995). Perhaps also not coincidentally, both the *Brown & Williamson* opinion and the *Desnick* opinion were authored by Judge Posner.

147. *Id.* at 1347-49.

148. *See id.* at 1351.

149. *Id.* at 1352-53.

150. As Saul Levmore points out, a positive story was not likely one that the network would have had an interest in broadcasting. Saul Levmore, *Judging Deception*, 74 U. CHI. L. REV. 1779, 1786 (2007).

151. *J.H. Desnick*, 44 F.3d at 1352. *Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505 (4th Cir. 1999), yielded a different result but that result is reconcilable. *Food Lion* also involved undercover reporting by a news organization; the plaintiff also brought a claim for trespass, among other things. The Fourth Circuit affirmed the jury’s finding of trespass (and award of \$1.00 in nominal damages) based on the fact that the reporters, who had posed as employees, breached their duty of loyalty by secretly taping in nonpublic areas. *Id.* at 518. Although the cases are not cleanly distinguishable, it is easier to conclude that the plaintiff’s objection was to the presence of reporters in nonpublic areas, not simply the nature of what was said about the reporters’ observations afterwards. Additionally, the court made clear that the plaintiff could not, under *Hustler v. Falwell*, collect defamation-type damages under the state law claims without the application of First Amendment principles. *Id.* at 523.

152. *See J.H. Desnick*, 44 F.3d at 1355 (investigative newsgathering “is entitled to all the safeguards with which the Supreme Court has surrounded liability for defamation. And it is entitled to them regardless of the name of the tort . . .”); *see also Berghoff v. R.J. Frisby Mfg. Co.*, 720 F. Supp. 649, 656 (N.D. Ill. 1989) (“[T]he fact that similar damages are

This case law suggests that one solution to the overlap problem in intellectual property law, including overlaps involving design patents, is not to require the rights holder to elect one form of protection at the outset but rather to encourage courts to be attentive to end-runs by calibrating remedies to the nature of the harm incurred.¹⁵³ How then might courts go about determining whether the plaintiff is engaging in an end-run? The cases offer some suggestions. First, courts might attempt to divine the nature of the harm that the plaintiff seeks to remedy, in part by considering the course of conduct or litigation history. The *Omega* case is one such example, in which the court's consideration of Omega's course of conduct led it to the conclusion that Omega had brought an impermissible trademark infringement suit dressed in copyright infringement clothing.¹⁵⁴ Second, courts might look at the relationship between the right asserted and the remedy sought. For example, if the plaintiff is bringing suit for infringement of trade dress where a design patent exists or has expired, a court should assess the viability of limited injunctive relief, such as a disclaimer or label, before considering broader, patent-like remedies, such as an injunction against distribution.¹⁵⁵

As an example, consider the dispute in *Kohler Co. v. Moen, Inc.*, mentioned earlier.¹⁵⁶ Kohler and Moen are competitors in the field of faucets and faucet handles. Moen successfully obtained trade dress registration for the shape of some of its faucets, based on what the court characterized as

recoverable for different torts indicates that the nature of the injury, not the types of damages recoverable, determines the cause of action and, consequently, the appropriate statute of limitations." (footnote omitted); *Aequitron Med., Inc. v. CBS, Inc.*, 964 F. Supp. 704, 710 (S.D.N.Y. 1997) (tortious interference with prospective business relationship claim); *Evans v. Phila. Newspapers, Inc.*, 601 A.2d 330, 333 (Pa. Super. 1991) ("[W]here the underlying wrong which the complaint alleges is defamation by publication of a libelous report, and the claim of injury set out in each count springs from the act of publication, the Appellants should not be able to circumvent the statute of limitations by merely terming the claim tortious interference when in essence it is one of defamation, subject to a one year limitation of action. In such a situation, we will look to the gravamen of the action, not to the label applied to it by plaintiffs.")

153. Cf. David S. Welkowitz, *Trade Dress and Patent—The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 306 (1999) ("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.").

154. See *Omega S.A. v. Costco Wholesale Corp.*, No. CV 04-05443 TJH, 2011 U.S. Dist. LEXIS 155893, at *1 (E.D. Cal. 2011) ("[A]fter [dealers authorized by Omega] in the United States complained to Omega about Costco's sale of Omega watches at discounted prices, Omega's legal department suggested that Omega use a copyrighted design to control the importation and distribution of its watches into the United States.").

155. Dratler, *supra* note 28, at 935 n.237 ("The point is that protection under trademark principles does not remove an industrial design or product configuration from the public domain but merely proscribes those methods of copying it that unfairly usurp the originator's goodwill.").

156. See *infra* notes 56-61 and accompanying text.

“substantial evidence” that purchasers recognized the faucets as Moen faucets due to their distinctive shape alone, without any additional markings.¹⁵⁷ Kohler challenged the registration on the grounds, *inter alia*, that a product shape should not be able to be registered as trade dress under the Lanham Act because the potentially unlimited term of trade dress protection would directly conflict with the limited term awarded to configurations under design patent law, which was, in Kohler’s view, the proper protective regime in this case. The Seventh Circuit rejected this argument, holding that design patent law and trademark law were directed toward different ends and required different evidence in order to take advantage of the rights provided. Accordingly, the court concluded, “Kohler is free to copy Moen’s design so long as it insures that the public is not thereby deceived or confused into believing that its copy is a Moen faucet.”¹⁵⁸

Assume, then, that Moen had obtained a design patent for the ornamental aspects of its faucet; assume further that the patent had expired, and that Kohler then wanted to copy the design. One pragmatic objection to the court’s statement would be that Moen would likely argue that the mere copying of the design is likely to confuse consumers into believing that the Kohler faucet is a Moen faucet, given the distinctiveness that the Moen faucet acquired during the design patent term. Moreover, the argument would continue, the fact that the Kohler faucet would be sold in packaging clearly indicating the source of the faucet would not be sufficient to remedy any post-sale confusion arising once the faucets were installed. (Indeed, the post-sale confusion doctrine complicates things considerably, and courts would be well advised to reconsider its scope, if not its viability.)¹⁵⁹ Here, therefore, is where it would be incumbent on courts to calibrate remedies particularly carefully. Kohler would be free, upon the expiration of the design patent, to copy the formerly patented design, and any request by Moen for an injunction to cease sales of the design should be denied. But *Kellogg* and similar cases suggest that Kohler has an affirmative obligation to take reasonable steps to minimize confusion. If a likelihood of confusion is shown, Kohler need not, after *TrafFix*, change or conceal the design in some way, but perhaps it might be directed to add a small marking directly to the faucet that indicates that the faucet is a Kohler faucet and not a Moen faucet. This seems to be an appropriate way to balance Kohler’s right to compete in the

157. *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 633 (7th Cir. 1993).

158. *Id.* at 640 n.10.

159. Dratler, *supra* note 28, at 970 (“Taken together, the trends toward increasing recognition of post-sale confusion and greater emphasis on confusion as to sponsorship or affiliation may make it more difficult to frame and enforce commercially effective, and not merely token, disclaimers of affiliation when a copyist borrows an innovator’s design features.”); Welkowitz, *supra* note 153, at 329 (“Post-sale confusion stretches trademark law beyond consumer protection to openly protecting designs from the act of copying, *i.e.*, as ordinary intellectual property, rather than unfair competition.”).

market for attractive faucet designs with the consumer's interest in having accurate information as to the manufacturer of such designs.¹⁶⁰

To be sure, there are administrative costs involved in such an approach. It would be faster and less expensive to require intellectual property owners to elect only one form of protection at the front end. But implementing such a proposal would require a major overhaul of U.S. intellectual property law. Being more attentive to the relationship among rights, harms, and remedies is something that courts are well equipped and—as the cases above suggest—even inclined to do. It reminds us that adjudication is, at its core, about providing appropriate remedies for legally cognizable harm. In order to accomplish that goal effectively, courts should not consider themselves to be limited by the labels plaintiffs apply to their claims. Rather, courts should consider the underlying nature of the harm asserted; only then can they identify the remedy best designed to ameliorate that harm.

CONCLUSION

Courts and commentators are not wrong to focus attention on doctrinal overlaps in intellectual property law. While it is true that such overlaps seem to be the result of congressional intention (at least implicitly), such that eliminating such overlaps as a structural matter would be inadvisable, the adjudication of overlaps in any particular case is the natural role of the courts. By ensuring that the gravamen of a claim, and not its label, is what drives any potential remedy, the effect of these overlaps in practice can be mitigated.

As design patents continue to play more of a role in intellectual property law, the overlap question is likely to arise more frequently, particularly given that design patents feature the shortest (stated) term of all intellectual property doctrines. It may well be then, that it will be a design patent case that focuses our attention on the core goals of the various intellectual property doctrines and helps to highlight the challenges that come with ever-expanding doctrinal boundaries.

160. I recognize, of course, that the details matter here. It would not be appropriate, for example, for a court to require a marking of a size or in a location that would frustrate Kohler's ability to benefit from the attractiveness of the design.

