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Trade Dress and Design Patent Protection

Using Trademarks and Copyrights to Enhance Protection of Product Design and Packaging

WEDNESDAY, AUGUST 22, 2012

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Today's faculty features:

Robert D. Litowitz, Partner, **Finnegan Henderson Farabow Garrett & Dunner**, Washington, D.C.

Douglas (Chip) A. Rettew, Partner, **Finnegan Henderson Farabow Garrett & Dunner**, Washington, D.C.

Stephen L. Peterson, Partner, **Finnegan Henderson Farabow Garrett & Dunner**, Washington, D.C.

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Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Trade Dress and Design Patent Protection Using Trademark and Copyright to Enhance Protection of Product Design and Packaging

August 22, 2012

Presented by Douglas (Chip) A. Rettew, Robert D. Litowitz, and Stephen L. Peterson

Today's Presentation

- Advantages and mechanics of design patent protection
- Advantages and mechanics of trade dress protection
- How design patent protection can coexist with trade dress protection
- How copyright protection comes into play

Design Patent Protection

What Is Patentable

- 35 U.S.C. 171. Patents for Designs
  - Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title
  - The provisions of this title relating to patents for inventions shall apply to patents for designs, **except as otherwise provided**

Requirements for Patentability

- **Novel**—does not already exist
- **Nonobvious**—to a designer of ordinary skill who designs articles of the type involved
- **Original**—not the same as novelty – no derivation
- **Ornamental**—cannot be ENTIRELY functional, very rare

Functionality and Form

- Not completely functional
  - Some significant aspect of the design not dictated by function alone
- Article of manufacture
  - Impression, print, or picture applied to an article of manufacture
  - Not an image
  - Shape or configuration of an article of manufacture

Unique Requirements

- Not offensive to any race, religion, sex, ethnic group, or nationality
- Perceived as an ornamental design
  - If not visible in final intended use, the ornamental design must be a “matter of concern” at some time during its commercial life
  - Examples—hip joint, toner cartridge, internal component that is not sold as a replacement part

Design Patents v. Utility Patents
Unique Characteristics

- The scope of the design patent claim is the drawings, instead of focusing on the description
- Design patent applications are examined for novelty, ornamentality, and nonobviousness—in reality examination focuses primarily on the clarity of the drawings or photographs
- No PCT design patent applications
- No multiple designs

A Design Patent


US00D582133S

(12) **United States Design Patent**
Del Biondi

(10) **Patent No.: US D582,133 S**
(45) **Date of Patent: ** Dec. 9, 2008**

(54) **SHOE**

(75) Inventor: **Alberto Del Biondi**, Padova (IT)

(73) Assignee: **Pirelli & C.S.p.A.**, Milan (IT)

(**) Term: **14 Years**

(21) Appl. No.: **29/290,542**

(22) Filed: **Dec. 14, 2007**

(30) **Foreign Application Priority Data**

Jun. 19, 2007 (EM) 000742721

(51) **LOC (8) Cl.** **02-04**
(52) **U.S. Cl.** **D2/902**; D2/907; D2/960
(58) **Field of Classification Search** ..... D2/902, D2/906–908, 943, 944, 946, 969, 972–974, D2/951, 960, 977; 36/45, 50.1, 77 M, 77 R, 36/83, 88, 113, 114, 126–131
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

D317,974 S * 7/1991 Austin D2/960
D391,068 S * 2/1998 Aveni et al. D2/972
D430,389 S * 9/2000 Del Biondi D2/960
D437,993 S * 2/2001 Hatfield et al. D2/972
D476,473 S * 7/2003 Clegg D2/972
D495,128 S * 8/2004 Avar D2/977
D495,867 S * 9/2004 Avar D2/972
D523,231 S * 6/2006 Petrie D2/972
D557,489 S * 12/2007 Dolan D2/972
D570,585 S * 6/2008 Hatfield D2/969
D574,133 S * 8/2008 Le D2/951

* cited by examiner

Primary Examiner—Dominic Simone
(74) *Attorney, Agent, or Firm*—Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

(57) **CLAIM**

The ornamental design for a shoe, as shown and described.

DESCRIPTION

FIG. **1** is a top view of a shoe of my design;

FIG. **2** is a right side view thereof;

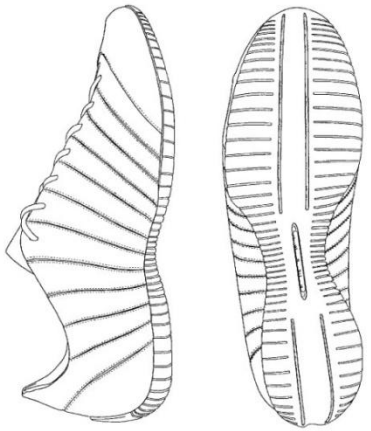
FIG. **3** is a left side view thereof;

FIG. **4** is a bottom view thereof; and,

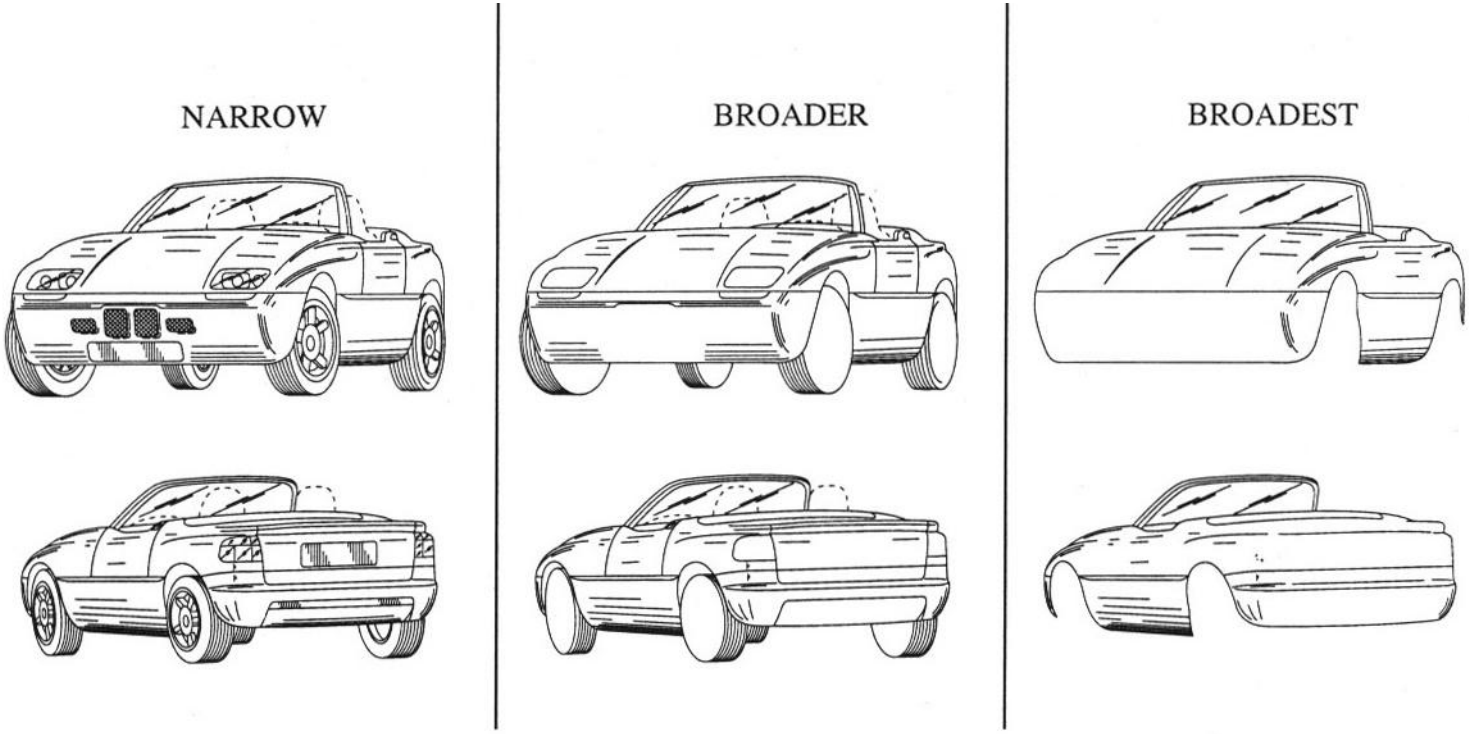
FIG. **5** is a rear view thereof.

My design includes a mirror image of the embodiment depicted.

1 Claim, 5 Drawing Sheets



Drawings Define the Scope of Patent



Why Get U.S. Design Patents?

- A study showed that in design patent cases litigated over a recent five year period, preliminary injunctions were granted at the rate of 70%—pre eBay
- Only one out of three design patents was declared invalid
- Design patents are inexpensive, with no post-grant fees
- Design patents can be obtained in as quickly as 3-6 months with advance planning and expedited examination
- Design patents last for 14 years from issuance

Patenting Product Designs

DESIGN PATENT—an inexpensive way to

- Control the product configuration
- Control the sale of replacement parts
- Create a barrier to market entry by a competitor
- Create the possibility of creating perpetual trade dress rights that can protect the product configuration forever

Costs and Timing

- For a normal, one embodiment design, with no significant legal issues
  - Cost: $2,000 to file, $4,000 to grant
  - Timing: One to two years
- For an expedited application, again one embodiment design, with no significant legal issues
  - Cost: $4,000 to file (includes $800 petition fee, petition, and the cost of a patent search)
  - Timing: Three to six months

Important Issues

- Four things to remember
  1. The patented design cannot be entirely functional
  2. The drawings define the scope of the claim
  3. Unnecessary elements in design patent drawings provide unnecessary non-infringement positions
  4. Design patents can give your client the time to create trade dress rights

Infringement of a Design Patent

- Whether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design? *Egyptian Goddess, Inc. v. Swisa, Inc*., 543 F.3d 665 (Fed. Cir. 2008) (modifying *Gorham v. White*, 81 U.S. 511 (1871)).

Infringement of a Design Patent

- *Crocs, Inc. v. Int'l Trade Comm'n* (Fed. Cir. 2010)
  - Federal Circuit emphasized reliance on patent design figures, instead of verbal claim construction in finding infringement. Courts must do a side-by-side comparison of the accused design with the patent figures.

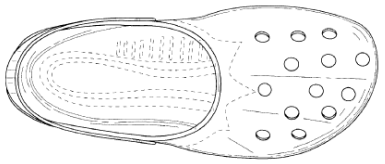


FIG.6

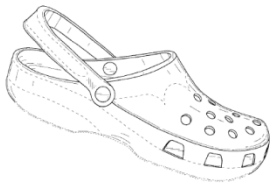


FIG.1

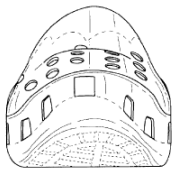


FIG.4

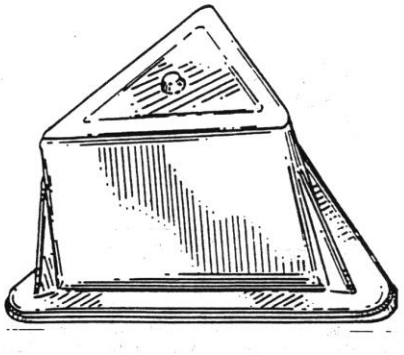
  - "[M]inor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement." Instead, ordinary observer must compare overall impression or effects of the designs

Design Patent Infringement

- The omission of a depicted element
  - When the alleged infringing product does not include a feature depicted in the design patent drawing a court may find that there is no infringement. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995)
  - Analogous to the “all elements” rule in utility patents

Design Patent Infringement

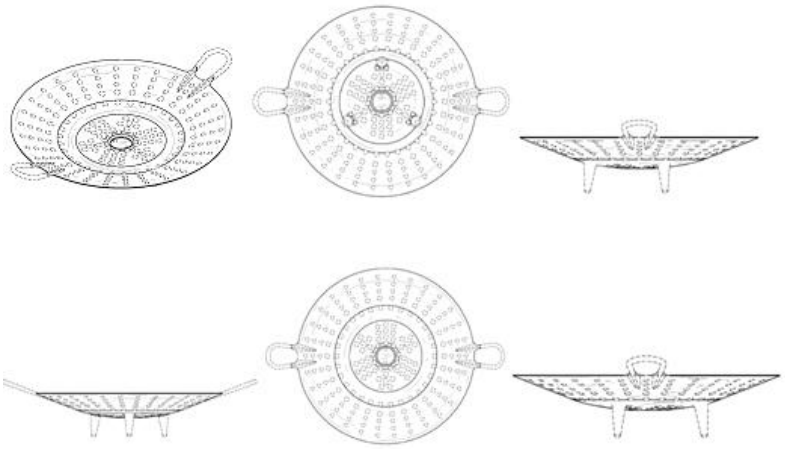
- The omission of a depicted element
  - "If…the vertical ribs and upper protrusion were functional, not ornamental, features, [patentee] could have omitted these features from its patent application drawings. [Patentee] did not do so, however, and thus effectively limited the scope of the patent claim by including those features in it." *Elmer v. ICC Fabricating, Inc.,* 67 F.3d 1571, 1577 (Fed. Cir. 1995)



Design Patent Infringement

- Application of the Egyptian Goddess Ordinary Observer Test

Chef'n Patent D556,503



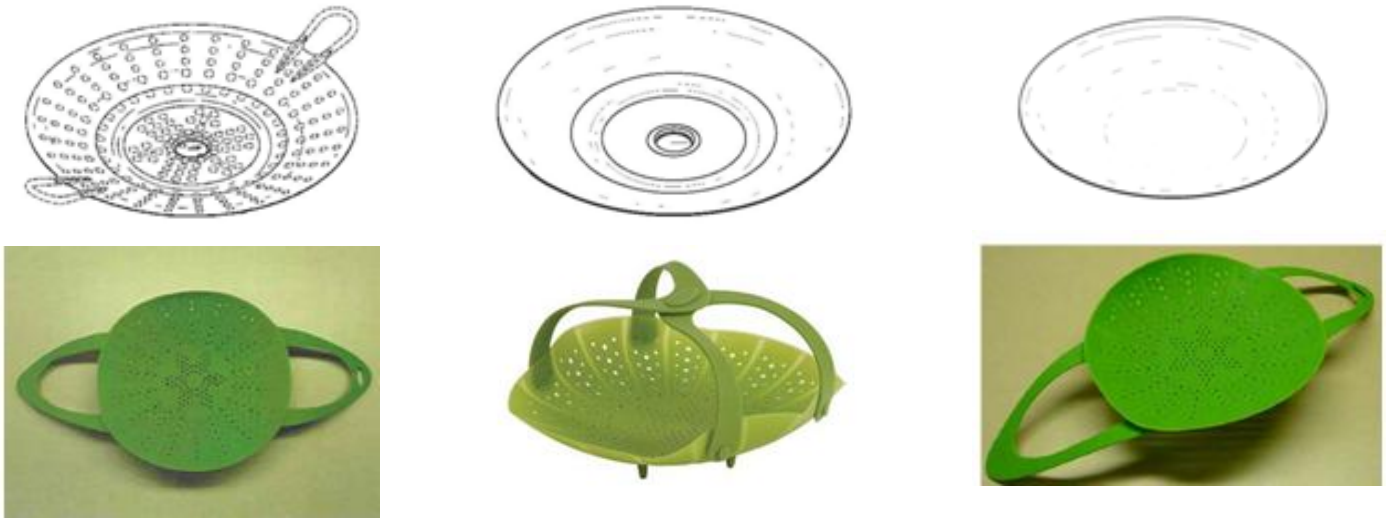
Trudeau Steamer

NO INFRINGEMENT

– District court granted accused infringer's motion for summary judgment of non-infringement, noting that an ordinary observer familiar with the prior art would recognize that the '503 patent "presents a more complex structure in terms of slope." *Chef'n v. Trudeau Corp.* (W.D. Wash. June 4, 2009).

Design Patent Infringement

- *Chef'n v. Trudeau*



– Lines "depict change in curvature or slope of a surface." Trudeau steamer has only one change in slope.
– The '503 patent has a "small, depressed ring at the center." Not present in Trudeau steamer (other than hole pattern, which is irrelevant because of disclaimed elements).

Damages

- 35 U.S.C. 284. Damages
  - Same damages as for utility patent
  - Injunction, money damages, attorney's fees
  - Reasonable royalty, price erosion, incremental profit
- 35 U.S.C. 289. Additional Remedy…
  - Infringer's total profit for sale of an article including the design
  - Not less than $250
  - Cannot recover profit twice—in other words you can't get 284 and 289 damages, and you can't multiply 289 damages

Trade Dress Protection

Trade Dress: Definition

- What is trade dress?
  - Overall image and appearance of a **product** and/or its **packaging**
  - Trade dress "involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." —*Two Pesos, Inc. v. Taco Cabana, Inc*., 505 U.S. 763 (1992).

What's in a name ?

Types of Trade Dress

1. Product Packaging
   - Appearance of packages, label graphics, fonts, color combinations, textures, etc.
   - Examples:
     - Layout and appearance of a catalog
     - 
     - Motif of a restaurant's décor, menu, signage, and server's uniforms
     - Inclusion of a lighthouse in the layout of a golf hole

Types of Trade Dress

2. Product Design
   - Shape, appearance, and/or design of product itself (as contrasted with packaging)
   - Examples:
     - The design of a doorknob
     - The shape of a flashlight

     - The combined features of a water meter
     - The appearance of a kitchen mixer

Protectable Trade Dress

- To receive protection, trade dress must be BOTH
  1. **Distinctive**—through either
     a. Inherent distinctiveness
     b. Acquired distinctiveness (e.g., secondary meaning – namely, consumer recognition that the trade dress identifies the product source rather than the product itself or a feature of the product)
  2. **Non-Functional** (aka "competitive need test")

     "A product feature is functional . . . if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix Devices v. Mktg. Displays, Inc*., 532 U.S. 23, 24 (2001).

Trade Dress: Distinctiveness

- *Two Pesos, Inc. v. Taco Cabana, Inc.* (1992):
  - Taco Cabana's protectable trade dress consisted of the following elements for its fast-food restaurants:

    "[A] festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme."

Trade Dress: Distinctiveness

- *Two Pesos, Inc. v. Taco Cabana, Inc.* (1992)
  - The U.S. Supreme Court held that trade dress can be inherently distinctive, and thus may not require a showing of secondary meaning in order to be protected under Section 43(a) of the Lanham Act
  - The Court found that there was no statutory support to differentiate between trademarks and trade dress

Trade Dress: Distinctiveness

- *Qualitex Co. v. Jacobson Products, Inc.* (1995)
  - The U.S. Supreme Court held that a single color (here, green/gold for dry cleaning press pads) may be protectable as a trademark if the color has acquired secondary meaning
  - A single color cannot be inherently distinctive, but "consumers may [over time] come to treat a particular color or its packaging as signifying a brand."

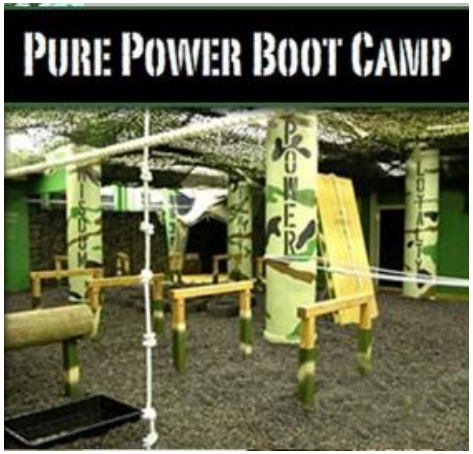
Trade Dress: Distinctiveness

- *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* (2000)
  - The U.S. Supreme Court held that a product's design or configuration is **never inherently distinctive**, and thus requires a **showing of secondary meaning** for trade dress protection.
  - In cases where it is difficult to determine whether trade dress is product-packaging type or product-design type, courts should err on the side of caution and classify trade dress as product design.

WAL★MART

Trade Dress: Distinctiveness

- *Pure Power Boot Camp, Inc. v. Warrior Fitness Boot Camp, LLC* (S.D.N.Y. 2011)
  - Claimed trade dress consisted of fixed indoor obstacle course coupled with special design features inspired by the United States Marine Corps
  - Trade dress must focus on the overall "look and feel" or "total image" of facility, not any of the "ideas, concepts, or innovations" behind it
  - Having found that Pure Power's trade dress was inherently distinctive, courts need not examine whether plaintiff's trade dress has acquired secondary meaning

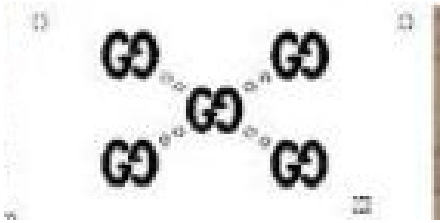


Trade Dress: Acquired Distinctiveness

- Courts look to the following factors in determining whether a particular trade dress has acquired **secondary meaning**:
  - Long use
  - Sales success
  - Substantial advertising expenditures
  - Advertising stressing the design features
  - Unsolicited media coverage
  - Requests from third parties to license the design
  - Intentional copying of the trade dress by competitors
  - Survey evidence

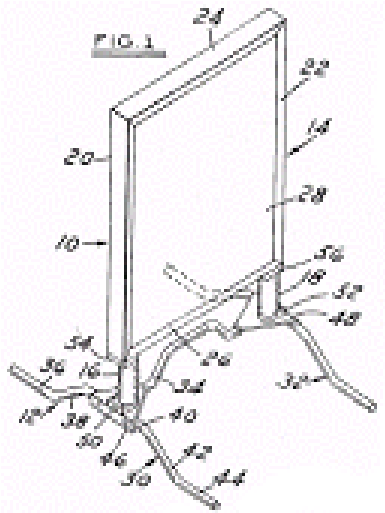
Trade Dress: Acquired Distinctiveness

- *Gucci America, Inc. v. Guess?, Inc.* (S.D.N.Y. 2012)
  - In finding Gucci's Diamond Motif trade dress protectable, court concluded that the trade dress possessed strong secondary meaning both to consumers and within the trade based on:
    1. Extensive advertising expenditures
    2. Unsolicited media coverage
    3. Sales success
    4. Exclusive use of trade dress for over fifty years
    5. Evidence that defendants meticulously copied trade dress



Trade Dress: Functionality

- Trade dress is not registrable or protectable if it is *de jure* functional
- The Supreme Court's decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.* (2001) addressed the issues of utilitarian and aesthetic functionality and their effects on trade dress



Trade Dress: Functionality

- *TrafFix Devices, Inc. v. Marketing Displays, Inc.* (2001)
  - The Supreme Court held that plaintiff's alleged trade dress was functional, and thus incapable of protection as trade dress, because the dual spring design of the plaintiff's alleged trade dress was disclosed and claimed in a utility patent
  - The existence of a utility patent is "strong evidence that the features claimed therein are functional"

Trade Dress: Functionality

- The Functionality Test(s), per *TrafFix*:
  - "Traditional rule": "a product feature is functional . . . if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."
  - According to the Supreme Court in *TrafFix*, "[w]here the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature."

Trade Dress: Functionality

- The "Second Test" for Functionality, per *TrafFix*:
  - Under the second test, which is commonly called the "competitive necessity" test, and generally applied in cases of aesthetic functionality, "a functional feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.'"
    - *Dippin' Dots, Inc. v. Frosty Bites Dist*., LLC (11th Cir. 2004) (citing *TrafFix Devices, Inc. v. Marketing Displays, Inc*.)

Trade Dress: Functionality

- What does it all mean?
  - "A design feature 'affecting the cost or quality of an article' is one which permits the article to be manufactured at a lower cost, or one which constitutes an improvement in the operation of the goods." *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.* (S.D.N.Y. 2003).
  - "A design feature of a particular article is 'essential' only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough." *Id*.

Trade Dress: Functionality

- The *In re Morton-Norwich* "Alternative Test" for Functionality:
  - The existence of a utility patent disclosing the utilitarian advantages of the design
  - The existence of advertising or promotional materials in which the originator of the design touts the design's utilitarian advantages;
  - The availability to competitors of functionally equivalent designs
  - Whether or not the design results from a comparatively simple, cheap, or superior method of manufacture

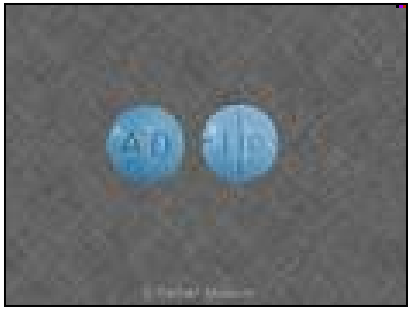
Trade Dress: Functionality

- *Malaco Leaf, AB v. Promotion in Motion, Inc.* (S.D.N.Y. 2004)
  - Held that Malaco Leaf's product configuration for its Swedish Fish candy was functional, and thus not protectable
  - Extending protection to the fish-shaped candy design would eliminate competition in a category where many third parties already compete, placing competitors at a significant non-reputation-related disadvantage

  - Malaco Leaf's efforts to distinguish its products by imprinting the word "SWEDISH" on the body of the design did not negate the design's functional aspects

Trade Dress: Functionality

- *Shire U.S. Inc. v. Barr Labs., Inc.* (3rd Cir. 2003)
  - Held that color and shape of ADDERALL drug product were functional because they were linked to dosage



  - Court relied heavily on affidavits indicating that patients using the drugs rely on visual cues and experience less confusion when using drugs that are color-coded to dosage
  - A generic drug's similarity in appearance to the brand name product also enhances user compliance

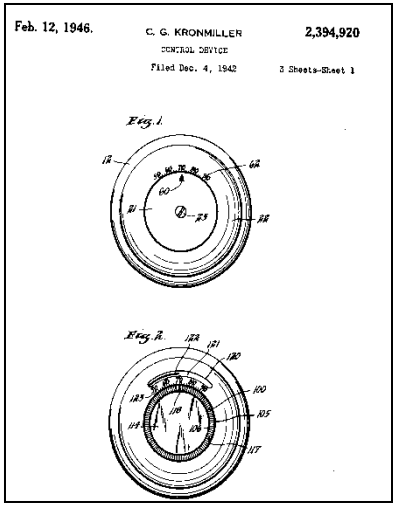
Trade Dress: Functionality

- *Frosty Bites, Inc. v. Dippin' Dots, Inc.* (N.D. Tex. 2003)
  - Held that the size, shape, and color of Dippin' Dots' flash-frozen ice cream product were functional
  - Those elements affect the taste, packaging, and method of service, and also indicate the flavor of the product
  - Granting exclusive protection for these features would place competitors at a significant non-reputation-related disadvantage

dippin' dots
Ice Cream of the Future.

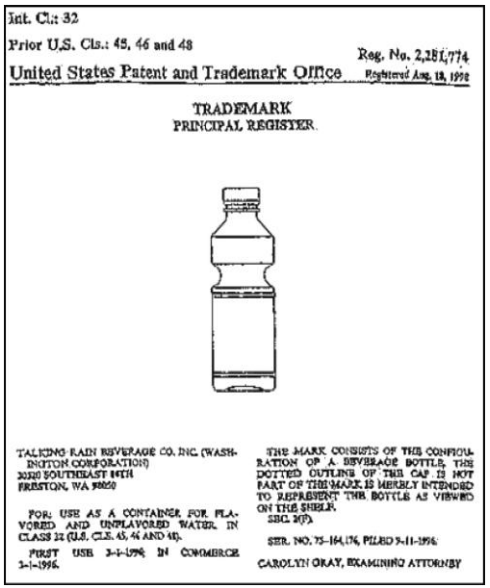
Trade Dress: Functionality

- *Eco Mfg. V. Honeywell Int'l, Inc.* (7th Cir. 2003)
  - Honeywell's request for protection of its well-known circular, convex model thermostat with a round dial was denied
  - Several aspects of the design were claimed in expired utility patents, and Honeywell did not meet the extremely heavy burden of proof that its trade dress was not functional in light of the expired patents


Feb. 12, 1946. C. G. KRONMILLER 2,394,920
CONTROL DEVICE
Filed Dec. 4, 1942 3 Sheets-Sheet 1

Trade Dress: Functionality

- *Talking Rain Bev. Co. v. South Beach Bev. Co.* (9th Cir. 2003)
  - Held that the design of Talking Rain's beverage bottle, which featured a recessed groove, was functional
  - The indentation added structural stability during manufacturing and afforded the user a better grip on the bottle, which was a feature touted through Talking Rain's "Get a Grip" slogan and advertising campaign



Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

Reg. No. 2,281,774

United States Patent and Trademark Office

Registered Aug. 18, 1999

TRADEMARK
PRINCIPAL REGISTER

TALKING RAIN BEVERAGE CO. INC. (WASHINGTON CORPORATION)
20210 SOUTHEAST 84TH
FRESTON, WA 98050

FOR: USE AS A CONTAINER FOR FLAVORED AND UNFLAVORED WATER, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 3-1-1996; IN COMMERCE 3-1-1996.

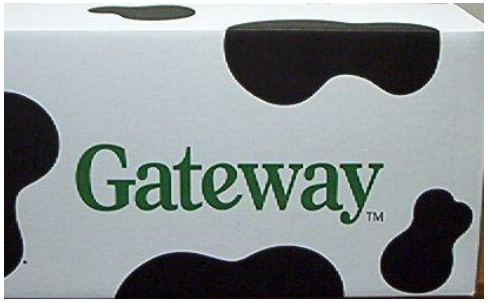
THE MARK CONSISTS OF THE CONFIGURATION OF A BEVERAGE BOTTLE, THE DOTTED OUTLINE OF THE CAP IS NOT PART OF THE MARK IS MERELY INTENDED TO REPRESENT THE BOTTLE AS VIEWED ON THE SHELF.

SER. NO. 75-164,176, FILED 5-11-1996.

CAROLYN GRAY, EXAMINING ATTORNEY

Trade Dress: Functionality

- *Gateway, Inc. v. Companion Prods., Inc.* (8th Cir. 2004)
  - Black-and-white cow spots used as trade dress by trademark holder that sold computers and computer accessories
  - Gateway's trade dress was found to be non-functional, since the black-and-white cow spots are an arbitrary embellishment that serve only to distinguish Gateway computers from computers produced by other manufacturers
  - The purely decorative nature of the design plays no part whatsoever in the performance of Gateway's computers



Trade Dress: Functionality

- *Globefill Inc. v. Elements Spirits, Inc.* (9th Cir. 2012)
  - Globefill's claimed trade dress for vodka container included "a bottle in the shape of a human skull, including the skull itself, eye sockets, cheek bones, a jaw bone, a nose socket, and teeth, and including a pour spout on the top thereof."
  - Ninth Circuit applied *In re Morton-Norwich* "Alternative Test" for Functionality
  - In finding trade dress protectable, court emphasized purely ornamental or aesthetic container, which was the antithesis of a functional, utilitarian design

Trade Dress: Aesthetic Functionality

- *Maker's Mark Distillery, Inc. v. Diageo North America, Inc.* (6th Cir. 2012)
  - Sixth Circuit applied Aesthetic Functionality Test—"where an aesthetic feature (like color), serves a significant function . . . courts should examine whether the exclusive use of that feature by one supplier would interfere with legitimate competition."
  - In holding the trade dress for Maker's Mark red dripping wax seal not aesthetically functional, court found that it would not be "difficult or costly for competitors to design around" the trade dress nor "does it put competitors at a significant non-reputation related disadvantage."

Benefits of Trade Dress Protection

- Unlike in patent context, a federal registration is not required to enjoy protection or be able to enforce rights (under common law)
- **Federal registration** affords multiple additional benefits (evidentiary and damages related)
- **Benefits**—ability to preclude competitors from creating confusingly similar designs indefinitely!

Costs and Timing?

- Assuming no significant legal issues
  - Cost: $2500—to file and prosecute through to registration
  - Timing: 9 months to 2 years
- If evidence of secondary meaning and/or likelihood of confusion issues raised—cost and timing can be significantly more

Test for Trade Dress Infringement

- The plaintiff has to show that
  1. It owns protectable product design trade dress (presumed if federally registered); and
  2. That use of similar trade dress by the defendant creates likelihood of consumer confusion

Test for Trade Dress Infringement

- Likelihood of confusion factors courts generally consider
  - Strength of the plaintiff's trade dress
  - Proximity of goods
  - Similarity of the plaintiff's trade dress and the defendant's trade dress
  - Level of purchaser care
  - Marketing channels utilized by both parties
  - Evidence of actual confusion
  - Defendant's intent in adopting the trade dress
  - Likelihood of expansion of product lines

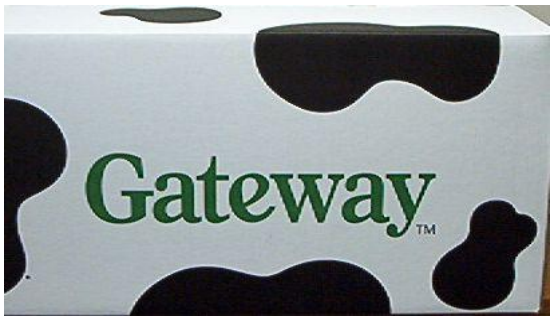
*** Evaluation of factors is not a mechanical process where the party with the greatest number of factors weighing in its favor wins. Rather, court focus on the ultimate question of whether consumers are likely to be confused

Infringement of Trade Dress

- *Pure Power Boot Camp, Inc. v. Warrior Fitness Boot Camp, LLC* (S.D.N.Y. 2011)
  - Despite having found Pure Power's trade dress protectable, court found dress not sufficiently similar, as the likelihood of confusion factors weighed in favor of Defendant
  - Key factor—similarity of the trade dresses—Pure Power is not entitled to exclusive use of fixed obstacles and military theme; protection only with respect to its own distinctive blend and manner of implementing these elements and concepts. Overall, that implementation is quite different from the "look and feel" of Defendant's trade dress .
  - Key Factor—actual confusion—clients testified that each had a different "look and feel"

Infringement of Trade Dress

- *Gateway, Inc. v. Companion Prods., Inc.* (8th Cir. 2004)
  - Held that Companion's "Cody Cow Stretch Pet" for computer decoration infringed Gateway's unregistered trade dress for its black-and-white cow spot design as related to computers
  - In applying likelihood of confusion factors, court emphasized $1.3 billion Gateway had spent on advertising; pervasiveness of trade dress inside Gateway stores and on Gateway products; evidence of intent to copy; lack of time potential customers would consider a Cody Cow purchase as it retailed for $20



Remedies for Trade Dress Infringement

- Prohibitory injunction (infringer must stop using infringing trade dress/design) or mandatory injunction (disclaimer, corrective advertising, product recall/destruction)
- Actual damages
- Defendant's profits
- Attorney's fees and costs (exceptional cases)

Can Design Patent and Trade Dress Protection Coexist?

Distinct Goals of Patent vs. Trademark Law

- **Design patent law** promotes progress in decorative arts and rewards inventors by giving them exclusivity over claimed designs for a limited time—14 years
- **Trademark law** is a species of consumer protection law; protection of trade dress can last as long as the trade dress stays in use and serves as a source-identifier to consumers

Design Patent and Trade Dress Infringement Tests Compared

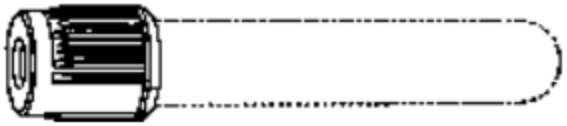
- Trade dress infringement test focuses on marketplace realities, such as consumer confusion and acquired distinctiveness
- Focus of the design patent infringement action is similarity to the design features shown in the design patent drawings, and not similarity to the patentee's "commercial embodiment" of the design

Design Patent and Trade Dress Infringement Tests Compared

- *Ferrari S.p.A. Esercizio Fabriche Automobili E Corse v. Roberts* (6th Cir. 1991)
  - Court upheld trade dress protection for distinctive design of a special model of FERRARI automobile
  - Availability of design patent does not preclude use of Lanham Act § 43(a) as the basis for protection for products whose trade dress have acquired strong secondary meaning
  - Actionable harm results from *either* infringing a design patent or copying a product with secondary meaning

Design Patent and Trade Dress Infringement Tests Compared

- *In re Becton, Dickinson and Co.* (Fed. Cir. 2012)
  - Applicant denied trade dress registration for blood collection tubes based on finding of functionality despite design patent
  - In applying *Morton-Norwich* test, Federal Circuit held that evidence of a design patent may be some evidence of non-functionality, however "the fact that a device is or was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark"
  - Court noted that since the design patent did not reflect the specific design or identity for which trademark protection was sought, the functional "presumption lost force"



Coexistence of Trade Dress and Design Patent

- The same product design can be protected simultaneously or sequentially by a design patent and trade dress
- Examples:

FIG. 1

FIG. 2

FIG. 3

FIG. 4

Coexistence of Trade Dress and Design Patent

- Pucci perfume bottle

FIG. 1

FIG. 2

FIG. 3

FIG. 4

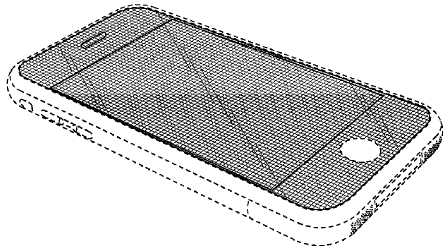
FIG. 5

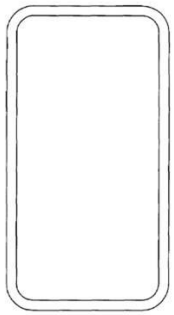
FIG. 6

- Design patent (see above)
- Trade dress (bottle shape, fabric)
- Copyright (fabric—in multiple colorways)

Products Covered by Both Trade Dress and Design Protection

- Trademark Reg. No. 3457218 and 3475327
  Design Patent No. D558,757 and D618,677





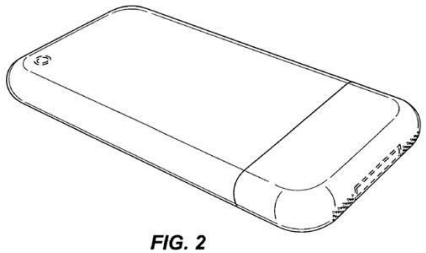


FIG. 2

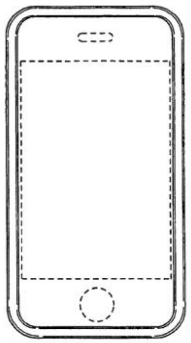
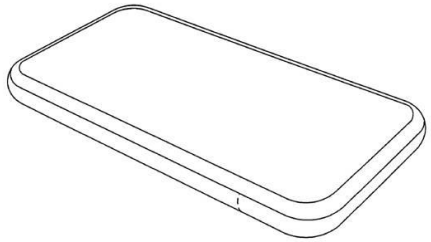


FIG. 3



Coexistence of Trade Dress and Design Patent

- "Trademark rights . . . which happen to continue beyond the expiration of a design patent do not 'extend' the patent monopoly" **because patent and trademark rights "exist independently of, under different law and for different reasons**." *In re Mogen David Wine Corp*., 140 USPQ 575, 579 (C.C.P.A. 1964).
- Existence of a design patent "[r]ather than detracting from a claim of trademark, may actually support such a claim" because "**it may be presumptive evidence of non-functionality**," necessary to obtain trade dress protection. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 6:11 (4th ed. 2008).

Copyright

Copyright: Scope of Protection

- Copyright protection exists for (1) **original works of authorship** (2) fixed in any **tangible medium of expression. 17 U.S.C. § 102(a)**
- **Conceptual Severability Required—** the design of a **useful article** (bicycle grill, dress, lamp, etc.) is copyrightable only to the extent that such design incorporates pictorial, graphic, or sculptural features that can be **identified separately from**, and are **capable of existing independently of**, the utilitarian aspects of the article

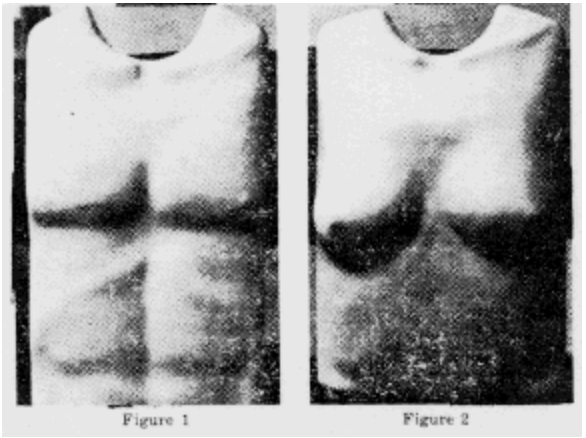
Conceptually Separable?

- **Conceptually Separable**

Statuette forming the base of a lamp in ***Mazer v. Stein,*** 347 U.S. 201 (1954).

Belt buckles in ***Kieselstein-Cord v. Accessories by Pearl, Inc.***, 632 F.2d 989 (2d Cir. 1980).

- **Not Separable from Utilitarian Aspects**



Mannequins in ***Carol Barnhart Inc. v. Economy Cover Corp***., 773 F.2d 411 (2d Cir. 1985) *"One cannot physically separate the shoulders, breasts, or gross shape from the function of the display forms*."

Combination of Design Patent, Trade Dress, and Copyright Protection

- Some product designs, such as fabric designs, can be protected under all three forms of protection

- Some product designs require different forms of protection for different elements. Container shape—design patent & trade dress; Original labels—copyright, trademark, and design patent protection

Contrast: Trade Dress, Design Patent, and Copyright

Form of Protection	Origin of Rights	Requirements for Protection	Scope of Protection	Life	Test for Infringement
Design Patent	Grant by Fed. Gov't upon application	New, original, non-functional, and ornamental subject matter	The drawings, not the patentee's commercial embodiment	14 years	"Ordinary observer" test in light of prior art
Trade Dress	Adoption and use	Non-functional and distinct (either inherently or through acquired secondary meaning)	Product packaging or product design	As long as in use	Likelihood of consumer confusion, mistake, or deception
Copyright	For post-1978 works: creation by the author	Original works of authorship fixed in tangible medium of expression	Protection of original expression, no protection of underlying ideas (***Baker v. Selden)***	Depends on many factors	Copying of the work (usually proven by showing access and substantial similarity)

Thank you

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