

THE CONVERGENCE OF DESIGN PATENT LAW, TRADEMARK LAW, AND COPYRIGHT LAW FOR BETTER PROTECTION OF INTELLECTUAL PROPERTY FOR COMMERCIAL DESIGNS

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I. Introduction	122
II. What are Copyrights, Trademarks and Design Patents?	124
A. Copyrights	126
B. Trademarks	130
C. Patents and Design Patents	135
III. An Introduction to Protection Overlapping	138
A. Overlaps between Copyrights and Design Patent.....	139
B. Overlaps between Trademarks and Design Patent.....	141
C. Overlaps between all three forms of federal protection	147
D. Problems of overlapping	148
IV. Conclusion.....	151

I. INTRODUCTION

Products, services, and brands cover all aspects of modern life. In order to be successful among costumers, it is vital to take into consideration their appearance and ornamental design, as well as their utility and functional elements. As CIBC (put the entire word and not just the abbreviation) Professor of Entrepreneurship and e-Commerce at the Wharton School of the University of Pennsylvania, Karl T. Ulrich, expounds:

Let me cite three reasons, giving a preview of a theory of aesthetics to follow. All other things equal, most users will prefer a beautiful artifact to an ugly one, even in highly functional domains such as scientific instruments. Thus, beauty can be thought of as “just another attribute” in a user’s evaluation of preference, alongside durability, ease of use, cost, and safety. In this respect, the aesthetic

quality of an artifact is an important factor in providing a satisfying user experience, the prime motive for design.¹

Big companies invest a large percentage of their budget on research and product development in order to keep up with technological advances. This way, they can get an advantage in the market place and surpass their competition. Accordingly, companies engage in a process known as Research and Product Development (R&D) in order to transform their market opportunities and ideas into profitable market products.² R&D is defined as “the process of acquiring knowledge to create a new product to serve the needs and wants of customers who are already buying a company's products”³ or as the process of acquiring new clients. The R&D process is costly and can take an effort of years; in fact, a magazine specialized in business and industrial innovation, *Battelle's R&D Magazine*, forecasted that U.S. research and development expenditures will grow by slightly more than two percent from 2011, with an estimate of \$427.2 billion, to \$436.0 billion in 2012.⁴

In today's technologically driven world, the speed of innovation and product development grows at a faster pace. For the purpose of this article, commercial design will be defined as “the process concerned with planning,

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¹ KARL T. ULRICH, DESIGN: CREATION OF ARTIFACTS IN SOCIETY 97 (2011), available at <http://opim.wharton.upenn.edu/~ulrich/ulrichbook-10Aug12.pdf>.

² See Vish Krishnan & Karl T. Ulrich, *Product Development Decisions: A Review of the Literature*, *Management Science*, 47 MGMT. SCI. 1 (2001), available at <http://www.ktulrich.com/uploads/6/1/7/1/6171812/pdreview.pdf>.

³ L.G. Mohamed, *The Significance of Product Development to Firm Competitiveness: A Case of Plastic Product Firms in Ekurhuleni*, ANNUAL FORUM 2005, TRADE AND UNEVEN DEVELOPMENT: OPPORTUNITIES AND CHALLENGES 775-2 (2005), available at <http://www.tips.org.za/files/775.pdf>.

⁴ See BATELLE WITH R&D MAGAZINE, 2012 GLOBAL R&D FUNDING FORECAST (2011), available at http://battelle.org/docs/default-document-library/2012_global_forecast.pdf.

designing, and manufacturing new consumer products using the disciplines of art and engineering.”⁵ Correspondingly, commercial design can include: *product design*, where a designer concentrates on the design of a product; *brand design*, where a designer creates a distinct identity and personality to promote an organization, product or service; or *technology design*, where a designer develops new and modern technological advances.

Companies must protect their investment in innovation. Otherwise, the company’s lack of protection may result in a deficit of successful earnings or the recovery of previous investments. As a result, companies are constantly searching for new and more effective ways to protect the investment that goes into their product development and the ideas that they transform into merchandise for the public. Companies not only need to protect their investments, but also once all the effort and investment is turned into final products, companies have the complicated task of protecting their final products, services, and brands.

Nowadays, a wise businessperson or entrepreneur would take a few moments to learn how Intellectual Property Law can work to their benefit. Companies and small business need to seek broad protections, which are nimble to implement and capable of providing effective mechanisms to defend their inventions, brands, new products, and technological developments against infringement. The existing legal scheme in the United States provides for three types of intellectual property rights: patents, copyrights, and trademarks.

This paper will focus specifically on the discussion about the convergence and juxtaposition of these protections. Specifically, this article covers the rights protected by design patents, Trademark Law and Copyright Law to shield commercial designs from both: a theoretical perspective and a practical business approach. In addition, this paper will provide a general guideline designed to help business owners and entrepreneurs make informed decisions regarding their trademarks, copyright, and patents rights.

II. WHAT ARE COPYRIGHTS, TRADEMARKS AND DESIGN PATENTS?

Copyrights, trademarks, and patents are part of the wider body of law known as *Intellectual Property*. The term “Intellectual Property” refers to the mind’s work product which is considered an intangible asset. The Supreme Court of Puerto Rico has defined Intellectual Property as the set of rights recognized to the author of an intellectually created work. The Court emphasized that authorship will be recognized and respected by authorizing

⁵ *What is Commercial Design?*, WHATISINDUSTRIALDESIGN.COM (FEB. 20, 2012), <http://whatisindustrialdesign.com/what-is-commercial-design>.

or denying reproduction.⁶ Although the term intellectual property rights include the aforementioned set of legal rights, it is important to note that each is distinguished by the structure, scope, and spheres of application. Trademarks, copyrights, and patents protect different types of intellectual property. As the United States Patent and Trademark Office (USPTO) explains:

A trademark typically protects brand names and logos used on goods and services. A copyright protects an original artistic or literary work. A patent protects an invention. For example, if you invent a new kind of vacuum cleaner, you would apply for a patent to protect the invention itself. You would apply to register a trademark to protect the brand name of the vacuum cleaner. And you might register a copyright for the TV commercial that you use to market the product.⁷

Despite the fact that each of these rights has a particular subject matter, they are prone to an overlapping protection and thus, a work can be simultaneously protectable through design patents, copyrights, and trademarks. Patent, copyright, and trademark are familiar concepts that protect products emerging from today's competitive business environment. All of these have the power of granting the owner exclusive rights over the economic exploitation of his idea or creation.⁸ "Such rights are generally exclusive, meaning that the owner is given a special kind of legal monopoly over the protected creation over a certain amount of time."⁹

Such body of law exists pursuant to Art. I § 8, cl. 8 of the United States Constitution which grants Congress the power "[t]o promote the progress of science and useful Arts, by securing for limited times to Authors . . . the exclusive right to . . . their . . . writings."¹⁰ This clause has been commonly referred to as the "Patent and Copyright Clause" or the "Intellectual Property Clause." In words of the United States Supreme Court: "the economic philosophy behind the clause empowering Congress to grant patents and

⁶ See *Cotto Morales v. Ríos*, 140 P.R. Dec. 604, 612 (1996).

⁷ UNITED STATES PATENT AND TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 1 (2012), available at <http://www.uspto.gov/trademarks/basics/BasicFacts.pdf>.

⁸ See Giovanni B. Ramello, *Intellectual Property and the Markets of Ideas*, 4 REV. OF NTWK. ECON. 161 (2005), available at <http://www.degruyter.com/view/j/rne.2005.4.2/issue-files/rne.2005.4.issue-2.xml>.

⁹ *Id.* at 1.

¹⁰ U.S. CONST. art. 1, § 8, cl. 8.

copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in science and useful arts.”¹¹ Moreover, the congressional power to enact trademark laws derives from the Commerce Clause of the Constitution, Art. 1, § 8, cl. 3, which grants Congress the “power to regulate commerce with foreign nations, and among the several States, and with the Indian tribes.”¹²

A. Copyrights

Copyright is a legal concept enacted by most countries, granting exclusive rights to the creator of an original work, usually for a limited period of time. In the United States a copyright of a work created on or after January 1, 1978 subsists from its creation and during the life of the author, plus an additional 70 years after the author’s death.¹³

Broadly, a copyright guarantees the author of the work several exclusive rights: the right to copy his work, the right to be credited for the work, the right to determine who may adapt the work to other forms, who may perform the work, and who may financially benefit from it, among other related rights. Copyright relates to artistic creations such as books, music, paintings, and sculptures, as well as films and technology-based works such as computer programs and electronic databases. The copyright implies that the main use, reproduction or alteration of literary and artistic creations may be made by the author or with the author’s authorization.¹⁴ This way, the copyright law protects the property rights of the owner against those who copy, use or alter the form in which the original work was expressed by the author.

In Puerto Rico the protection of copyrights, also called “author’s rights”, is divided in two main categories. One gives statutory protection over the moral rights of a creation while the other protects the creator’s economic rights over his creation. There are two laws that give legal force to this policy. One is the *Copyright Act of 1976*,¹⁵ a federal law that protects an author’s “economic rights” (rights of an author to obtain economic benefit from their work) on its work. The other is the *Copyright Law of Puerto Rico*,¹⁶ which

¹¹ Mazer v. Stein, 347 U.S. 201, 219 (1954).

¹² U.S. CONST. art. 1, § 8, cl. 3.

¹³ See 17 U.S.C. §§ 302–303 (2012).

¹⁴ See WORLD INTELL. PROP. ORG., UNDERSTANDING COPYRIGHT AND RELATED RIGHTS, available at http://www.wipo.int/freepublications/en/intproperty/909/wipo_pub_909.pdf.

¹⁵ Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541 (codified as amended in scattered sections of 17 U.S.C.).

¹⁶ Authors’ Moral Rights Act of Puerto Rico, Law 55-2012, P.R. LAWS ANN. tit. 31, §§ 1401i–1401ff (2013).

protects authors' "moral rights" (rights of an author to defend the integrity, reputation and prestige of his work).¹⁷

Nevertheless, the *Federal Copyright Act of 1976* preempts state law and exclusively rules the legal or equitable economic rights as specified in sec. 106 of the Act, which provides:

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.¹⁸

¹⁷ See Cotto Morales, 140 P.R. Dec. at 620. See also Pedro F. Silva Ruiz, *Nueva Ley de Derechos Morales de Autor de Puerto Rico* [Puerto Rico's New Authors' Rights Act], ACADEMIA NACIONAL DE CIENCIAS SOCIALES Y DERECHO DE CÓRDOBA [ACADERC] (Sp.), available at http://www.cea.unc.edu.ar/acaderc/doctrina/articulos/nueva-ley-de-derechos-morales-de-autor-de-puerto/at_download/file.

In general terms, copyright law does not prohibit a person from reselling, copying or altering legitimately obtained copies of copyrighted works if such reproduction, copy or alteration is done by or with the permission of the copyright holder. The copyright infringement occurs when a party who does not own the copyright to a work exploits one of the rights conferred without permission. Often, it may involve a claim of improper copying or a creation of a new work based upon the original, but it may also include other type of violations.

For example in *Litchfield v. Spielberg, et al.*,¹⁹ plaintiff asserted that the producers of the movie *E.T.* infringed the copyrights of a music play she had wrote entitled *Lokey from Maldemar*. In *Litchfield*, the court clearly stated the steps for indirectly proving copyrights infringement. The person alleging the infringement must show: (1) ownership of the copyrighted work; (2) that the alleged infringer had “access” to the copyrighted work; and (3) that there is “substantial similarity” between the copyrighted work and the alleged infringer’s work.²⁰

In any case of copyright infringement, the fact that a person copied the work is easier to prove indirectly since direct proof would require that the infringer would confess or that a witness would testify that the alleged infringer was observed copying the work. Any similar type of evidence would be extremely difficult to produce. The best manner to prove that the person alleging infringement owns the copyrights is to show that the work is registered in the U.S. Copyright Office. As to the second step of the test, “access” is defined as the reasonable opportunity to review the copyrighted work. For example, in *Litchfield*, the plaintiff submitted a copy of the music play to the defendants to consider adapting the play into a movie and defendants reviewed and rejected the play.²¹ In a case involving a claim of infringement, proving access depends upon the facts and circumstances of each particular case. Ultimately, to establish “access” it must be proved that the alleged infringer actually reviewed or had a reasonable opportunity to review the work. Finally, to prove copyright infringement, plaintiff must show that there is a “substantial similarity” between the copyrighted work and the defendant's work.²² Nevertheless, “substantial similarity” is one of the most difficult determinations in copyright law and courts have applied different tests depending on the nature and complexity of the subject matter at issue.²³

¹⁸ 17 U.S.C. § 106 (2012).

¹⁹ See *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984).

²⁰ See *id.* at 1356.

²¹ See *id.* at 1355.

²² See *id.* at 1358.

²³ See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A] (1998).

However, there is a well-known exception to the use of a copyright that permits the use of copyrighted works without the authorization of the author or copyright holder. The doctrine is known as *fair use* or *fair dealing*. Accordingly, not all copies or replications are banned. The fair use doctrine, codified by the *Copyright Act of 1976* as 17 U.S.C. Section 107, permits some copying and distribution without permission of or payment to the copyright holder in certain circumstances. The statute does not clearly define fair use, but instead gives four non-exclusive factors to consider in a fair use analysis. Those factors are: (1) the purpose and character of the use, including whether such use falls under a commercial nature or if it is used for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) what amount and proportion of the whole work is copied, and (4) the effect of the use upon the potential market for or value of the copyrighted work.²⁴

Although, to obtain copyright protection over a creation an author is not required to file a copyright registration in the United States Copyright Office, since the law provides protection as soon as the creation is placed in a tangible or fixed medium of expression, in reality “a copyright without copyright registration is next to worthless.”²⁵ The U.S. Copyright Office describes registration as:

[A] legal formality intended to make a public record of the basic facts of a particular copyright. However, even though registration is not a requirement for protection, the copyright law provides several inducements or advantages to encourage copyright owners to make registration. Among these advantages are the following:

- 1-Registration establishes a public record of the copyright claim.
- 2-Before an infringement suit may be filed in court, registration is necessary for works of U.S. origin.
- 3-If made before or within five years of publication, registration will establish prima facie evidence in court of the validity of the copyright and of the facts stated in the certificate. If registration is made within three months after publication of the work or prior to an infringement of the work, statutory damages and attorney's fees will be available to the copyright

²⁴ See 17 U.S.C. § 107 (2012).

²⁵ Jeff Schewe, *The Key To Copyright Protection*, APA Bus. Handbook, available at <http://www.apanational.com/files/public/keytoprotection.pdf>.

owner in court actions. Otherwise, only an award of actual damages and profits is available to the copyright owner.

4- Registration allows the owner of the copyright to record the registration with the U.S. Customs Service for protection against the importation of infringing copies.²⁶

Although after March 1, 1989, registration in the U.S. Copyright Office is optional for purposes of preserving the right, registration is still of great importance.²⁷ As discussed, the reality is that, absent a registration, the creator loses some important advantages and impedes the enforcement by the court of law. In Puerto Rico, in order to protect an author's moral rights, the author must file an Intellectual Property Registry at the Department of State of Puerto Rico.²⁸

B. Trademarks

A trademark is a legally protected name, word, symbol, or design (and their combinations) used by a manufacturer or seller to identify a product or service and distinguish it from other goods.²⁹ A trademark is used to identify the maker of a good. Since buyers ordinarily infer information about the features of goods by experience in using certain brands, Congress sought trademark protection by enacting the *Federal Trademark Act of 1946*, also known as *The Lanham Act*. In U.S. Supreme Court's words: "[t]raditional trademark infringement law is a part of the broader law of unfair competition, that has its sources in English common law, and was largely codified in the Lanham Act."³⁰ Furthermore, many States offer some trademark protection within their respective boundaries through a registration process.

It is imperative to understand that trademarks serve two primary purposes: "protecting consumers from being confused or deceived about the source of goods or services in the marketplace, and encouraging merchants

²⁶ US COPYRIGHT OFFICE, CIRCULAR 1: COPYRIGHT BASICS (rev. 2012), available at <http://www.copyright.gov/circs/circ01.pdf>.

²⁷ See ECO ONLINE SYSTEM, <http://www.copyright.gov/eco/> (last visited March 12, 2013), for more information on the federal copyright registration process.

²⁸ See REGISTRO DE PROPIEDAD INTELECTUAL [Intellectual Property Registry] <http://www2.pr.gov/agencias/estado/Pages/PropIntelectual.aspx> (Sp.) (last visited March 12, 2013), for more information on the copyright registration process in the Commonwealth of Puerto Rico.

²⁹ 15 U.S.C. § 1127 (2012).

³⁰ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003).

to stand behind their goods and services by protecting the goodwill they have developed in their trademarks.”³¹ As the U.S. Supreme Court has noted:

[T]rademark law, by preventing others from copying a source-identifying mark, “reduce[s] the customer’s costs of shopping and making purchasing decisions,” for it quickly and easily assures a potential customer that this item — the item with this mark — is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial reputation related rewards associated with a desirable product.³²

An internationally recognized scholar, Professor Nicholas Economides, of the Stern School of Business at New York University *expounds trademark protections* in his article *Trademarks Forthcoming in the New Palgrave Dictionary of Economics and the Law*.³³ He explicitly mentions that:

The trademark holder is given a legal monopoly on the use of these trademarked symbols and names in connection with the attached commodity, and is exclusively protected against infringement... Legal protection of trademarks is granted with respect to specified and related goods and does not extend to all products. For example, the trademark FORD owned by the automobile manufacturer does not cover unrelated items, say clothing. Thus, the same (or similar) trademark can be used by different owners in different product categories.

Trademarks qualify for legal protection immediately upon use when they are “inherently distinctive.” For marks that are not “inherently distinctive,” the owner must establish a “secondary meaning” or “acquired distinctiveness” to receive legal trademark protection. Inherently distinctive trademarks fall into three types, “fanciful,” “arbitrary,” and “suggestive” trademarks. Fanciful trademarks are words that usually have no other meaning, such as EXXON. Arbitrary marks are words that have an inherent meaning, but have no apparent meaning when applied to the specific product,

³¹ MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW 2 (LexisNexis, 2nd ed. 2009).

³² *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 514 U.S. 159, 163 (1995).

³³ Nicholas Economides, *Trademarks*, in THE NEW PALGRAVE DICTIONARY OF ECONOMICS AND THE LAW (Peter Newman ed., 1997), available at <http://citeseerx.ist.psu.edu/viewdoc/download?doi=10.1.1.29.4217&rep=rep1&type=pdf>.

such as APPLE as applied to computers. Suggestive trademarks imply or suggest certain properties of the product to which they apply, such as FRIDGEDAIRE as applied to refrigerators. For suggestive trademarks the implied meaning is not immediate but requires mental effort by the consumer.

Non-inherently distinctive trademarks are legally protected if they have acquired a “secondary meaning,” attesting to the mark’s acquired distinctiveness. Non-inherently distinctive trademarks may be surnames, such as MACY’S that have acquired a distinctiveness. They also may be geographically descriptive terms, such as MARLBORO, which have acquired distinctiveness and do not indicate the place of origin of a good.

The existence of a “secondary meaning” must be proved as an association in the consumer’s mind between the trademark and the origin of the good. Marks that are merely descriptive terms for a good or its features or purpose do not qualify for legal protection.

A “generic” term that just describes a class of goods is a primary example of a descriptive mark that cannot be trademarked. For example, the word BOOK cannot be trademarked. Often, the big success of certain brand names makes them vulnerable to becoming generic by describing a whole class of goods rather than the product(s) of a particular manufacturer. Famous examples of trademarks that became generic to the detriment of the original trademark owners include ASPIRIN, ESCALATOR, CELLOPHANE, and THERMOS.³⁴

Trademark law also encompasses the protection known as *Trade Dress*. Trade dress is the design and appearance of a product, including all the elements that compose the overall image that serves to identify the product presented to the consumer.³⁵ In other words, trade dress is a product’s “look and feel.” Trade dress may include features such as size, shape, colors, texture, graphics or even particular sales techniques.³⁶ Trade dress is a broad concept, encompassing both product packaging and product design/configurations.³⁷ If conditions for its configuration are met, the protection of a trade dress may apply to the features of a business or its product. For instance, it may apply to a restaurant decor, both interior and exterior and to written materials used in brochures such as texture, finishes,

³⁴ *Id.*

³⁵ See *Yankee Candle Co., Inc. v. Bridgewater Candle Co.*, 259 F.3d 25, 38 (1st Cir. 2001).

³⁶ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992).

³⁷ See *Wal-Mart Stores, Inc. v. Samara Bros Inc.*, 529 U.S. 205, 209–10 (2000).

color combinations, design elements, artwork, logos, signs, shapes, sounds, smells, among others.

However, for trade dress or a trademark protection to apply, the elements making the commercial design need to be both, non-functional and distinctive.³⁸ Under trademark law, a product feature is functional and thus not protectable “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”³⁹ The United States Supreme Court has indicated that having a utility patent on a product is strong evidence that the patented features are functional and thus, are not protectable under trade dress.⁴⁰

Like any other element of a trademark protection, a trade dress has to meet the distinctiveness requirement by demonstrating that it: 1) is inherently distinctive; or 2) has acquired distinctiveness through secondary meaning.⁴¹ Generally, distinctiveness of a product’s design trade dress will not be considered inherent and can only be obtained through secondary meaning.⁴² On the other hand, distinctiveness of product packaging trade dress may be either inherent or acquired.⁴³ In many instances, the most practical way to develop secondary meaning for trade dress and trademark protection is by advertising a product’s features or design elements in such a way that the feature, brand and source become readily associated.⁴⁴ Certainly, advertising plays a major role for acquiring distinctiveness on a brand in relation to the brand’s competitor and thus, developing secondary meaning.

It is important to understand that acquiring secondary meaning and distinctiveness for trademark protection is not a merely legal formalism. As the World Intellectual Property Organization (WIPO) explains:

By enabling companies to differentiate themselves and their products from those of the competition, trademarks play a pivotal role in the branding and marketing strategies of companies, contributing to the definition of the image, and reputation of the company’s products in the eyes of consumers. The image and reputation of a company create trust which is the basis for

³⁸ See *id.* at 210; see also *Two Pesos*, 505 U.S. at 775.

³⁹ *Qualitex*, 514 U.S. at 165.

⁴⁰ See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

⁴¹ See *Two Pesos*, 505 U.S. at 769.

⁴² See *Wal-Mart Stores*, 529 U.S. at 214–16.

⁴³ See *id.* at 214–15.

⁴⁴ See 2 J.T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 8.01 (Clark Boardman Callaghan, 3rd ed. 1996).

establishing a loyal clientele and enhancing a company's goodwill. Consumers often develop an emotional attachment to certain trademarks, based on a set of desired qualities or features embodied in the products bearing such trademarks.⁴⁵

As a result, a carefully selected and nurtured trademark is a valuable business asset for any company. For some, it may be the most valuable asset they own. However, it must be emphasized, as Professor Mary LaFrance of the William S. Boyd School of Law, University of Nevada, Las Vegas, indicates that:

Unlike other types of intellectual property, such as patents and copyrights, trademark rights are not property rights in gross. A fundamental principle of trademark law is that trademark rights arise only through the actual use of a mark in commerce to indicate the source of goods and services, and the public must actually recognize the mark as a source indicator in order for it to be protected.⁴⁶

The Supreme Court addressed this trademark aspect in *United Drug Co. v. Theodore Rectanus Co.*,⁴⁷ stating that “[t]here is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”⁴⁸ Another different aspect of trademark is the duration of the protection conferred. “The rights of a trademark owner last as long as the owner continues to use the mark, provided it is not abandoned or forfeited, and provided the mark does not otherwise cease to function as an origin indicator.”⁴⁹

Similar to copyrights, Trademark registration in the United States Patent and Trademark Office (USPTO) is not required to assert ownership. The creation of a trademark right is based on the use of the mark in commerce, independent of a formal registration. However, owning a federal trademark registration provides several advantages, including:

A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods and services listed in the registration (whereas a state

⁴⁵ WORLD INTELL. PROP. ORG., *Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises*, in INTELLECTUAL PROPERTY FOR BUSINESS SERIES 1 (2006), available at http://www.wipo.int/freepublications/en/sme/900/wipo_pub_900.pdf

⁴⁶ LAFRANCE, *supra* note 31, at 1.

⁴⁷ *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918).

⁴⁸ *Id.*

⁴⁹ LAFRANCE, *supra* note 31, at 12.

registration only provides rights within the borders of that one state); public notice of your claim of ownership of the mark; listing in the USPTO's online databases; the ability to record the U.S. registration with the U.S. Customs and Border Protection Service to prevent importation of infringing foreign goods; the right to use the federal registration symbol ®; the ability to bring an action concerning the mark in federal court; and the use of the U.S. registration as a basis to obtain registration in foreign countries.⁵⁰

The word "commerce" in the concept "use of the mark in commerce" refers only to interstate commerce. Therefore, a business in a state or in Puerto Rico must demonstrate that its products are being traded in another state of the Union. In Puerto Rico, a business may acquire protection under the recently approved Act No. 169 of 2009, known as the "Trademark Act of the Commonwealth of Puerto Rico"⁵¹ by using the mark in Puerto Rico's commerce and filing a registration at the Trademark Registry of the Department of State of Puerto Rico. All the other conditions are the same as those of the federal protection.

C. Patents and Design Patents

Since copyright protection does not extend to the utilitarian elements of a creation and trademarks do not covert functional components, patent law plays a unique role in the protection of the way an article is used and works. As defined by the United States Patent and Trademark Office (USPTO):

A patent is an intellectual property right granted by the Government of the United States of America to an inventor "to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States" for a limited time in exchange for public disclosure of the invention when the patent is granted.⁵²

There are three types of patents: utility, design, and plant patents. Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, composition of matter or

⁵⁰ UNITED STATES PATENT AND TRADEMARK OFFICE, *supra* note 7.

⁵¹ P.R. LAWS ANN. tit. 10, §§ 223–224b (2013).

⁵² *Patents*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/patents/index.jsp> (last visited April 4, 2013).

any new and useful improvement thereof. Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture. Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant. While a utility patent protects the way an article is used and works,⁵³ a design patent protects an article's ornamental appearance.⁵⁴ Both a design and a utility patent may be obtained on an article if invention resides both in its ornamental appearance and its utility.

To understand and explain the concept of design patents, one must first comprehend the definition of the term "design". The USPTO defined design as "the visual ornamental characteristics embodied in, or applied to an article of manufacture."⁵⁵ Since a design is connected to the appearance, the subject matter of a design patent application relates to the configuration or shape of an article, the surface ornamentation applied to an article, or the combination of both.⁵⁶ A design patent confers to its owner the right to prevent others from making, using, offering to sell, or actually selling within the United States or in international transactions.⁵⁷

Although the criteria for obtaining design and utility patents are the same, as in the available remedies for their infringement, some requirements may vary. There are five main requirements for obtaining a design patent: the subject matter must be an article of manufacture,⁵⁸ original,⁵⁹ novel,⁶⁰ non-obvious,⁶¹ and ornamental.⁶² Attorneys James Hamilton, Philippe Signore & Christopher Ward of the *Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P.*, one of the largest law firms in the United States focusing exclusively in intellectual property law, explain the requirements of design patents:

The design to be patented must be "for an article of manufacture." In other words, the patentable design must be embodied into, or applied to, a man-made tangible object... Importantly, the US design patent statute does not limit design protection to a whole article of

⁵³ See 35 U.S.C. § 101 (2012).

⁵⁴ See 35 U.S.C. § 171 (2012).

⁵⁵ U.S. PAT. & TRADEMARK OFF., A GUIDE TO FILING A DESIGN PATENT APPLICATION, available at http://www.uspto.gov/web/offices/com/iip/pdf/brochure_05.pdf

⁵⁶ 35 U.S.C. §171 ("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.")

⁵⁷ See 35 U.S.C. § 271 (2012).

⁵⁸ See 35 U.S.C. § 171.

⁵⁹ See *id.*

⁶⁰ See 35 U.S.C. § 102 (2012).

⁶¹ See 35 U.S.C. § 103 (2012).

⁶² See 35 U.S.C. § 171.

manufacture, but can be for a portion of an article of manufacture, which is useful to obtain a relatively broad protection.

The originality requirement bars issuance of a design patent for a design derived from any source or person other than the individuals named as inventors. A design can be original even if it corresponds to a reassembling or grouping of familiar forms and decorations. However, any simulations of known objects, persons, or naturally occurring forms are excluded from patentability.

The standard for evaluating the novelty of a design is the “average observer test”. The overall appearance of a design in the eyes of an average or ordinary observer must be different of any other prior design. There is an important difference between the novelty of a design patent and a utility patent. The novelty of a design patent comes from the ornamentation of the claimed design, while the novelty of a utility patent comes from the technical characteristics of the claimed invention. Accordingly, a product can be protectable by a design patent based on its appearance and separately protectable by a utility patent based on its technical components.

The courts have held that the proper standard to evaluate a design’s non-obviousness is whether “a designer of ordinary skill of the articles involved” would have found the design as a whole obvious at the time the design was invented. The non-obviousness analysis for design patents therefore, closely parallels the non-obviousness analysis for utility patents.

Finally, a patentable design must be “ornamental”. The ornamental design, however, need not be artistic nor aesthetically pleasing. To be ornamental, the design must have an overall distinct appearance that is not dictated by the function of the article of manufacture. In other words, the shape or configuration of a functional object is protectable by a design patent if the shape or configuration is not governed solely by the function of the object.⁶³

As opposed to the other forms of intellectual property, patents are completely governed by federal legislation, no state or common right regulates the concession of patent rights. The USPTO is the federal agency

⁶³ James Hamilton et al., *U.S. Design Patents: An Underdog That Bites*, in 124 *MANAGING INTELL. PROP.* 19 (2002), available at <http://www.oblon.com/sites/default/files/news/18.pdf>.

that examines applications and grants patents on inventions when applicants are entitled to them. The preparation of a design patent application and the conducting of the proceedings in the USPTO to obtain the patent is an undertaking requiring the knowledge of patent law and rules, as well as Patent and Trademark Office practice and procedures. A patent attorney or agent specially trained in this field is best able to secure the more extensive patent protection to which applicant is entitled.⁶⁴ Design patents are granted for a period of fourteen (14) years, from the date of grant.⁶⁵

Recently, the U.S. Court of Appeals for the Federal Circuit (CAFC) in *Egyptian Goddess, Inc. v. Swisa, Inc.*, held that the proper test for infringement of a design patent is solely the ordinary observer test, as performed from the perspective of an individual who is familiar with the prior art.⁶⁶ In order to verify if a design patent is infringed, courts must do a side-by-side comparison of the accused design with the patent figure. The U.S. Supreme Court in *Gorham v. White* elaborated on the ordinary observer test and stated that:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.⁶⁷

III. AN INTRODUCTION TO PROTECTION OVERLAPPING

Historically, the subject matters of patent, copyright, and trademark law were quite distinct and questions of dual protection rarely arose. However, as a result of the expansion of the scope of federal intellectual property protection, the different systems have begun to overlap in significant ways. Overlapping protection arises in two ways: “intellectual property owners may seek concurrent coverage of more than one form of protection or they may request sequential protection.”⁶⁸

The following examples demonstrate only a few instances where convergence of rights can coexist. Nonetheless, there is a possibility of other combinations.

⁶⁴ See UNITED STATES PATENT AND TRADEMARK OFFICE, *supra* note 55, at 10.

⁶⁵ See 35 U.S.C. § 173 (2012).

⁶⁶ See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

⁶⁷ *Gorham v. White*, 81 U.S. 511, 528 (1871).

⁶⁸ Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1499 (2004).

A. Overlaps between Copyrights and Design Patent

Patents and copyrights used to cover very different subject matters: patents were created to protect new and useful inventions and copyrights only protected original expressive works. Therefore, the overlap between utility patents and copyrights has always been virtually impossible since copyright cannot be used to protect strictly utilitarian product designs in the absence of some separable expressive elements, in addition that copyright is not applicable to “useful articles”. A “useful article” is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁶⁹ 17 USC § 102 provides: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

The importance of this distinction was demonstrated in the case of *Aqua Creations USA, Inc. v. Hilton Worldwide, Inc.*⁷⁰ Plaintiffs Aqua Creations USA Inc. and Aqua Creations LTD had designed an artistic light fixture and presented it to Defendant Hilton Hotels Corporation for use in the Hilton’s San Diego Convention Center. Aqua alleged that the parties were unable to agree on a price. Nonetheless, Hilton copied Aqua’s designs and installed them at its San Diego Convention Center. The Court dismissed the claim because it found that Aqua lighting designs constituted “useful articles” under the Copyright Act and did not contain creative elements that were physically or conceptually separable from the light fixtures’ utilitarian aspects.

On the other hand, a significant overlap does exist in the items that can be covered by copyright and design patents. Both the copyright and design patent statutes encompass the protection of aesthetic qualities. In order to obtain both protections, the creation of work must possess the new and ornamental character required by design patents as well as the expressive pictorial, graphic, or sculptural features required by copyright law. Under these circumstances, an inventor-designer could initially copyright his artistic design. Thus, an ornamental design may be copyrighted as a work of art and may also be subject matter of a design patent.

Protecting the aesthetic creations or ornamental features of products with both copyright and patent design has its benefits, especially in the scope of protection to prove infringement. As previously explained, in order to

⁶⁹ 17 U.S.C. § 101 (2012).

⁷⁰ *Aqua Creations USA Inc. v. Hilton Hotels Corp.*, 2011 WL 1239793 (S.D.N.Y. Mar. 28, 2011).

establish a claim of copyright infringement, a plaintiff must prove that the defendant had access to the allegedly copied work and that a substantial similarity exists. Attorney Gregory R. Mues explains, with the forthcoming example, the limits and complications of copyright protection:

Theoretically, two cartographers could set out separately to capture the geography of the same area. If both men were perfectionists, each would produce an identical map. Yet, the mapmaker who published second would not have infringed the copyright of his previously published colleague since each map was the independent creative work of its respective author. Consequently, a multitude of valid copyrights may exist, each having the same or nearly identical subject matter and format. No question of infringement need ever arise if each work product has been independently created.⁷¹

The concurrent existence of a copyright with a design patent may solve this problem since in a claim of design patent infringement the burden of proof is not as demanding. The test for deciding an infringement is whether the ordinary observer may be misled into buying the infringing article because of its like appearance to the patented design.⁷² Unlike its copyright counterpart, the patentee plaintiff is not required to establish access and copying.

This situation is well illustrated in the case *Baby Buddies, Inc. v. Toys "R" Us, Inc.*⁷³ In this case, Baby Buddies had been selling pacifier holders with a decorative bear that could be clipped to an infant's garment. Baby Buddies sold over a million pacifier holder units, and approximately half of those sales came through Toys "R" Us stores.⁷⁴ Toys "R" Us had a consultant design a similar new pacifier holder that Toys "R" Us had manufactured for its stores and soon after began phasing out the Baby Buddies holder, subsequently discontinuing it entirely in 2003. Baby Buddies sued Toys "R" Us for copyright infringement.⁷⁵ Although the Court determined that the ribbon tether, clip and snap components of the pacifier holder were utilitarian and non-protectable as useful articles, the plastic teddy bear and ribbon bow were found to be physically separable and therefore eligible for copyright protection. Although Baby Buddies was successful in securing a right of protection against the copying, the judge determined that there were almost no similarities between the two teddy bear designs beyond the general

⁷¹ Gregory R. Mues, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs*, 49 ST. JOHN'S L. REV. 543, 550 (1975).

⁷² See *Gorham*, 81 U.S. at 528.

⁷³ *Baby Buddies, Inc. v. Toys "R" Us, Inc.*, 611 F.3d 1308 (11th Cir. 2010).

⁷⁴ See *id.* at 1311.

⁷⁵ See *id.* at 1312.

element that comprises the design, in this case: the eyes, nose, mouth, arms, legs, a ribbon bow and a pastel based color scheme. Since copyright does not protect ideas but instead protects the particular expression or authorship, the Court held that there was no copying of protected expression and Baby Buddies' claim was dismissed. A different result for Baby Buddies' would have been reached if their product were to be protected by both a copyright in combination with a design patent.

It is important to note that there have been conflicting interpretations as to whether simultaneous or subsequent copyright and design patent protections can coexist. A solution proposed for this problem has been the so called "election doctrine". However, the Court of Customs and Patent Appeals, in *In re Yardley*,⁷⁶ disregarded the election doctrine, holding that the proprietor of an artistic design for a work of art may, in a proper case, obtain both copyright and design patent protection.⁷⁷ For instance, although not presented directly with the question of election, the United States Supreme Court lessened the harshness of the election doctrine by stating:

Though other courts have passed upon the issue as to whether... the election of the author or patentee of one bars a grant of the other, we do not. We do hold that the 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.⁷⁸

As Attorney Gregory R. Mues points out "it is readily apparent, therefore, that the Court recognized the existence of a zone of overlap, holding that patentability and copyrightability were not mutually exclusive. Left unanswered, however, was the question whether an individual must choose only one of the two schemes available."⁷⁹

B. Overlaps between Trademarks and Design Patent

As previously discussed, trademark law has evolved to protect much more than just names, words, and logos. A wide variety of designs, product configurations, and even the overall "look and feel" of a product, as indicators of source are, protectable under the Lanham Act. Since within the scope of

⁷⁶ *In re Yardley*, 493 F.2d 1389 (1974).

⁷⁷ See Mues, *supra* note 71, at 543.

⁷⁸ *Mazer*, 347 U.S. at 217.

⁷⁹ Mues, *supra* note 71, at 572.

protection of a patent design lies that of an ornamental design for an article of manufacture, it makes sense that the two regimes may serve overlapping purposes. As a result, ornamental or aesthetic designs that fall within the scope of design patent protection may now fit into the parallel protection conferred by Trademark or trade dress rights. “Both regimes focus on the visual appearance of a product or its packaging and both regimes allow the rights-holder to exclude others from uses that lead to customer confusion.”⁸⁰ However, it should be noted that “design patents are not merely a parallel alternative to trade dress. Rather, the existence of some practical differences means that design patents rights are available in situations where trade dress protection is unavailable or uncertain.”⁸¹

Similarly, the requirements for infringement between both systems are profoundly comparable. “While trademark law directly protects against customer confusion between products on the market, design patent infringement considers the potential for confusion “in the eye of an ordinary observer” between the patented design and the accused design.”⁸² In *Egyptian Goddess*, the Federal Circuit held that design patent infringement is proven with evidence that an ordinary customer familiar with the prior art would understand that the accused device “embodies the patented design or any colorable imitation thereof.”⁸³ The general test for trademark and trade dress infringement asks whether a “likelihood of confusion” exists between the right-holder’s creation and the accused creation.⁸⁴

Precisely by playing with the similarities within the two distinct legal frameworks intellectual property creators are beginning to obtain both patent design and trademark protection. Even further, design patent and trademark overlapping can serve a key role in expanding the duration and quality of rights through a process that Associate Professor Dennis D. Crouch, of the University of Missouri School of Law, has termed *doctrinal bootstrapping*. Professor Crouch has defined doctrinal bootstrapping as “the process of using rights granted under a first doctrine to aid in procuring rights under a second doctrine.”⁸⁵ He correctly illustrated that design patents are being used to help obtain trade dress protection over the same industrial design. Professor Crouch explains:

⁸⁰ Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* 3 (Univ. of Mo. Sch. of Law Legal Studies Research Paper Series, Research Paper No. 2010-17, 2010).

⁸¹ *Id.*

⁸² *Id.* at 30.

⁸³ *Egyptian Goddess*, 543 F.3d at 678 (modifying the ruling in *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)).

⁸⁴ See 15 U.S.C. §1125 (2012); see also ADAM L. BROOKMAN, *TRADEMARK LAW: PROTECTION, ENFORCEMENT, AND LICENSING* 69 (Aspen Publishers, 1999).

⁸⁵ Crouch, *supra* note 80, at 8.

I consider three mechanisms where doctrinal bootstrapping occurs in the dyad of design patent and trade dress rights: (1) By providing a significant period of exclusivity, design patents can aid in the process of developing an association in the eyes of customers between the design and its source. That association then serves as evidence to support trade dress protection. (2) Although the design patent functionality doctrine differs from that of trade dress, courts have also relied on design patents as evidence that the design (or at least aspects of the design) are nonfunctional. This might be termed the “reverse *Traffix* doctrine.” In the first two mechanisms, design patents operate by increasing the likelihood that trade dress rights are later recognized. (3) In the third mechanism, the design patents operate to extend the patent term at the front-end based on the relatively rapid grant of patent rights.⁸⁶

The first form of doctrinal bootstrapping is the use of a design patent as evidence of non-functionality for a subsequent trademark protection. This recent strategy is derived from the United States Supreme Court decision in *Traffix Devices, Inc. v. Marketing Displays, Inc.*⁸⁷ In this case the Court held that the existence of a utility patent covering a particular design creates a presumption that the patented design is functional. Applying this reasoning, since design patents lack functionality, the holding in *Traffix* would suggest that a prior design patent covering a design provides evidence that the design is non-functional.⁸⁸ In the same manner, Professor Thomas McCarthy has expressed a similar position on the role of a design patent in establishing non-functionality:

A design patent, rather than detracting from a claim of non-functional trade dress or trademark, may support such a claim. Since a design patent is granted only for non-functional designs, it may be presumptive evidence of non-functionality and thus support the trademark claimant. However, while a design patent is some evidence of non-functionality, alone it is not sufficient without other evidence.⁸⁹

⁸⁶ *Id.*

⁸⁷ *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

⁸⁸ See Crouch, *supra* note 80, at 38.

⁸⁹ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:93 (4th ed. 2005).

The United States District Court for the Western District of New York decision in *Keystone Mfg. Co., Inc. v. Jaccard Corp.*⁹⁰ is an example of the application of the explained strategy that allows design patent rights to serve as evidence supporting the non-functionality of asserted trade dress rights. Jaccard had created a hand-held meat tenderizer that was covered by a design patent that had expired. Jaccard argued that “the design of its JACCARD® meat tenderizer was protected trade dress and that Keystone violated its intellectual property rights by selling the Deni® tenderizer.”⁹¹ The district court agreed that trade dress rights may protect the subject matter of an expired design patent. However, the Court, following McCarthy’s reasoning, rejected the suggestion that the design patent creates a presumption of non-functionality and instead, held that the design patent serves as evidence in determining non-functionality. The Court sustained:

[I]s in this Court's view an accurate recitation of the evidentiary relationship between a design patent and establishing non-functionality: it is relevant evidence suggesting non-functionality. This Court agrees with Keystone that Jaccard's assertion of a legal presumption of non-functionality stemming from the existence of a design patent is not supported in the case law.⁹²

The pronouncements in *Keystone* are widely supported by previous case law.⁹³

⁹⁰ *Keystone Mfg. Co., Inc. v. Jaccard Corp.*, 2007 WL 655758 (W.D.N.Y. Fed. 26, 2007).

⁹¹ *Id.* at 1.

⁹² *Id.* at 9.

⁹³ *See, e.g.*, *Fuji Kogyo Co., Ltd. v. Pacific Bay Intern, Inc.*, 461 F.3d 675 (6th Cir. 2006) (indicating that design patent creates a presumption of non-functionality); *Levenger Co. v. Feldman*, 516 F.Supp.2d 1272 (S.D. Fla. 2007) (prior design patent can rebut a defense of improper functionality of trade dress); *Adventure Products, Inc. v. Simply Smashing, Inc.*, 2007 WL 2775128 (S.D. Cal. 2007). (“Although Plaintiff does not explicitly state that its claimed dress is nonfunctional, that fact can be implied by the existence of the design patents.”); *Global Mfg. Group, LLC v. Gadget Universe.Com*, 417 F.Supp.2d 1161 (S.D. Cal. 2006) (holding that the plaintiff’s design patent, which enclosed the features of an electric scooter served as evidence of non-functionality); *Krueger Int’l v. Nightingale Inc.*, 915 F. Supp. 595, 605, (S.D.N.Y. 1996) (“Because a design patent is granted only for nonfunctional designs, it can serve as evidence that a plaintiff’s trade dress is not functional.”); *In re R. M. Smith, Inc.*, 219 U.S.P.Q. 629 (T.T.A.B. 1983), *aff’d*, 734 F.2d 1482, 222 U.S.P.Q. 1 (Fed. Cir. 1984) (finding that the existence of a design patent is not alone enough evidence of non-functionality); *Topps Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q.2d 1412, 1417 (S.D.N.Y. 1996). (plaintiff’s expired design patent “is presumptive evidence of non- functionality”); McCarthy, *supra* note 89, § 6:15 (“A design patent, rather than detracting from a claim of non-functional trade dress or trademark, may support such a claim.”)

The second type of doctrinal bootstrapping deals with the employment of design patent exclusive monopoly to facilitate the acquisition of distinctiveness on brands that do not possess inherent distinctiveness. Although a design patent alone does not prove or provide evidence for secondary meaning,⁹⁴ the period of exclusivity offered by a design patent can aid in the process of developing a consumer association between the design and its source.⁹⁵ The period of monopoly and right to exclude can be used to launch an aggressive campaign of advertisement and branding to develop public awareness. The strategy used to rely on design patents in order to obtain secondary meaning has been labeled by some as “cheating the trademark system.”⁹⁶ Comparatively, this strategy may be used in the same manner in relation with the exclusive monopoly conferred by copyrights.

This is an extremely useful strategy and the approach has been used by companies like Apple. Also, it could become an especially important consideration in situations where the product designs can be easily copied just by its mere observance:

This layered approach was taken by Apple with its famous iPod Nano design. The iPod Nano design patent application was filed first, in August 2005, a few weeks before its September 2005 public release date. The subsequent trademark design registration application appears identical to the patented design. The trademark registration application was filed in July 2006 and received a registration certificate in January 2008 after Apple presented substantial evidence of acquired distinctiveness. The prerelease design patent application filing allowed Apple to make an early claim for rights without publicly releasing any information regarding the design. The later filed trademark claim offers an additional layer of protection with a potentially longer duration.⁹⁷

⁹⁴ See *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 U.S.P.Q.2d 1705, 1722 (T.T.A.B. 1998) (holding that a design patent of a tire thread did not prove that the design had acquired secondary meaning).

⁹⁵ See Julia Matheson and Stephen Peterson, *Combine and Conquer: How the Synthesis of Design Patent and Trade Dress Achieve Maximum Protection for your Product Design*, FINNEGAN (Apr. 4, 2013), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=74f843be-c63a-40cc-8ae0-007bc50fdd99>

⁹⁶ Daniel H. Brean, *Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTEL. PROP. L.J. 325, 364 (2008).

⁹⁷ Crouch, *supra* note 80, at 23.

The third and final form of doctrinal bootstrapping is related to the use of a trademark to obtain perpetual protection over an ornamental design previously protected by a design patent. Since design patents are limited to a fourteen year period⁹⁸ and trademarks persist as long as they continue to be used in commerce, it becomes easy to see the convenience of obtaining a trademark protection after the design patent has expired in order to extend the exclusive rights to use the ornamental creation. Consequently, trademark law can be used to establish a prolonged monopoly on aesthetic features of a product.

In *In re Mogen David Wine Corp.*,⁹⁹ the Court of Customs and Patent Appeals explained that trademark rights do not extend the patent monopoly because:

[T]hey 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.¹⁰⁰

It has been demonstrated that trademark rights are able to continue beyond the expiration of a design patent meaning that patent and trademark rights exist independently of each other and under different law requirements and schemes. This form of doctrinal bootstrapping presents an "overlapping protection of the same subject matter by different forms of intellectual protection delaying full entrance of that subject matter into the public domain."¹⁰¹ In this form of doctrinal bootstrapping, the overlap between trademark and design patents does more than fill a gap in the trade dress protection regime. The overlap of trademark and design patent can play a synergistic role by extending the duration of the monopoly over a design. An example of this practice was exercised by the company Honeywell in order to obtain trademark protection for its wall-attached thermostat, once the design patent had expired.¹⁰²

⁹⁸ 35 U.S.C. § 173 (2012).

⁹⁹ *In re Mogen David Wine Corp.*, 328 F.2d 925 (CCPA 1964).

¹⁰⁰ *Id.* at 930.

¹⁰¹ Samuel Oddi, *The Tragicomedy of the Public Domain in Intellectual Property Law*, 25 HASTINGS COMM. & ENT. L.J. 1, 6 (2002).

¹⁰² See Crouch, *supra* note 80, at 38. See also *In re Honeywell Inc.*, 497 F.2d 1344 (C.C.P.A. 1974).

In the 1940 and 1950's Honeywell designed its now ubiquitous round wall-attached thermostat and obtained both a utility patent on the control mechanism and a design patent covering visible shape of the thermostat. After those patents expired and after some initial setbacks, Honeywell was able to convince the USPTO to register the shape as trade dress. Although Honeywell's competitor Emerson Electric initially objected the two reached a settlement and the trade dress was eventually registered in 1990.¹⁰³

In agreement, McCarthy expresses that "although the Patent Office, in the early years of the Lanham Act, held that a configuration covered by a design patent was unregistrable as a trademark, this is clearly not the law today."¹⁰⁴ Also, when the Supreme Court directly addressed the issue in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, it found that a prior utility patent did not categorically bar parallel trade dress claims. In fact, the Supreme Court in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*¹⁰⁵ did not comment upon the plaintiff's pursuit of both copyright and trademark claims for children's clothing designs and rejected the trademark claim solely on the basis that plaintiff had not established secondary meaning.

C. Overlaps between all three forms of federal protection

Because of its unique characteristics, ornamental designs have managed to straddle all three areas of protection. Gerard N. Magliocca, Professor at Indiana University Robert H. McKinney School of Law, sustains that "product designs occupy a unique position in the law because they sit at the confluence of patent, copyright, and trademark doctrine. Indeed, commercial art is the only form of property that can be protected under any of these three traditional categories."¹⁰⁶

¹⁰³ *Id.* See also U.S. Design Patent No. D176, 657 (1956); U.S. Trademark Registration No. 1,622,108 (1990).

¹⁰⁴ 1 J. THOMAS MCCARTHY, *supra* note 89, § 7.91 (citing *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 U.S.P.Q. 575 (C.C.P.A. 1964); *Mine Safety Appliances Co. v. Electric Storage Battery Co.*, 405 F.2d 901, 160 U.S.P.Q. 413 (C.C.P.A. 1969); *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 177 U.S.P.Q. 205 (C.C.P.A. 1973); *In re Honeywell, Inc.*, 497 F.2d 1344, 181 U.S.P.Q. 821 (C.C.P.A. 1974), *cert. denied*, 419 U.S. 1080, 42 L. Ed. 2d 674, 95 S. Ct. 669, 184 U.S.P.Q. 129 (1974)). For a historical perspective see WILLIAM L. SYMONS, *THE LAW OF PATENTS FOR DESIGNS* 35 (1914).

¹⁰⁵ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

¹⁰⁶ Gerard Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845, 846 (2003).

There are designs that can benefit from the protection of the three forms of intellectual property. Assistant Professor at the University of Denver College of Law, Viva R. Moffat, points out that “an ornamental design used on the front of a car, for example, would be eligible for all three versions of federal intellectual property protection.”¹⁰⁷ The design patent system protects novel, nonobvious, ornamental designs for a period of fourteen years, providing essentially the same property rights that an invention would obtain with a utility patent.¹⁰⁸ The same design may also qualify for copyright protection, provided it is an original and expressive work.¹⁰⁹ The design also may also function as a trademark as long as it serves to indicate the source of the car.¹¹⁰

This is well illustrated with Bavarian Motor Works’ classic signature design of “kidney” grilles with four headlights. Those aesthetic elements have been used through generations of production as a distinctive design of BMW’s cars. The ornamental details that encompass all models produced by the German corporation are original, expressive works that constitute novel, nonobvious, ornamental designs which, by the passage of time, serve to indicate the car’s source or manufacturer. As long as they do not serve a functional characteristic or utilitarian purpose (for example, enhance the suction of cold air into the motor) and only attend the aesthetic appearance of their models, the details may gain the protection from a design patent, copyright, trademark or the combination of all three.

Thus, it would not be uncommon to see a federal court entertaining a complaint alleging the infringement of all three intellectual protections. This is well illustrated in the following introductory language of a summary judgment order rendered by the District Court of the Southern District of New York: “On February 16, 2007, [the plaintiff] filed suit against defendants, asserting claims for copyright, trade dress, design patent and trademark infringement, as well as, claims for false designation of origin, unfair competition, and deceptive trade practices.”¹¹¹

D. Problems of overlapping

Critics have increasingly disapproved the convergence between various forms of intellectual property protection that often allow for an extensive overlap of rights. Some of the problems identified by the overlapping protections are: the development of “rent-seeking behavior” of industry groups, the increase of the transaction costs for consumers and

¹⁰⁷ Moffat, *supra* note 68, at 1511.

¹⁰⁸ See 35 U.S.C. § 171 (2012).

¹⁰⁹ See 17 U.S.C. § 102 (2012).

¹¹⁰ See *Qualitex*, 514 U.S. at 166.

¹¹¹ *Yurman Studio, Inc. v. Castañeda*, 591 F.Supp.2d 471, 481 (S.D.N.Y. 2008).

competitors, the disruption of the public policy balance established by Congress, the ambiguity of an acceptable use by third parties of design elements protected by various forms of intellectual property, and the decrease in the number of works entering the public domain due to extended or perpetual protection, among others.¹¹² As sustained by Professor Crouch: “this reluctance to allow overlapping rights stems from a commonly held belief that intellectual property owners should not be permitted to re-categorize one form of intellectual property as another, thereby extending the duration of protection beyond that which Congress deemed appropriate for their actual creative efforts.”¹¹³

Even if concerns regarding overlapping rights are legitimate, I believe that the problems associated with the overlap require a more insightful consideration and an extensive investigation over time to discern whether or not they truly present the drastic effects that some critics have stated. The problems relating to intellectual property protection are of great and sensitive commercial and economic importance and require meticulously drafted rules. The first step towards dealing with the overlapping protection would require attention by Congress. First, one must be able to determine if those theoretical problems truly exist. As the Canadian attorney Gordon J. Zimmerman illustrates: “Although conceptually, copyright protection could be used to prevent copying of a design that eventually achieves trademark distinctiveness, the lifetime of protection for copyright is so long that this should not be a practical issue.”¹¹⁴

Second, the Supreme Court counts with a useful tool consisting of the Judges’ exercise of judgment, choice, and discretion required in order to be able to answer the most difficult questions of constitutional and statutory interpretation, with which the Supreme Court can limit the impact of this overlap, if it finds the presence of clear abuses in the use of overlapping protections. “Reliance on jurisprudence and the wording of the statutes as they exist seems likely to be the basis for resolution of these issues for the foreseeable future.”¹¹⁵ To illustrate my position I point out that this happened with one of the problems that Professor Viva R. Moffat exemplified in 2004. Moffat argued that:

¹¹² For more information regarding the problems of overlapping IP, see Moffat, *supra* note 68, at 1512–20. See also Oddi, *supra* note 101, at 43–49.

¹¹³ Crouch, *supra* note 80, at 47.

¹¹⁴ Gordon J. Zimmerman, *Extending The Monopoly? The Risks And Benefits Of Multiple Forms Of Intellectual Property Protection*, 17 CAN. INTELL. PROP. REV. 345, 366 (2000).

¹¹⁵ *Id.* at 367.

If a copyright owner obtains an additional form of protection such as a trademark, however, the public may be deprived of some of these bargained for benefits.

Pressing Mickey Mouse into service yet again, the availability of trademark protection means that some uses of Mickey that might be considered “fair use” under copyright law may be actionable under trademark law. A parody of Mickey Mouse used in a magazine, for example, might be deemed fair use under copyright law, but might nonetheless constitute actionable trademark infringement. In this situation, Disney continues to obtain all of the rights and benefits that ordinarily flow to copyright owners, but the public is deprived of elements of the bargain—the fair use exception is an integral part of copyright law and is a significant element of the copyright bargain.¹¹⁶

However, the Supreme Court in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,¹¹⁷ held that the fair use defense in trademark law is not precluded by the possibility of confusion. The Court expressed:

The common law's tolerance of a certain degree of confusion on the part of consumers followed from the very fact that in cases like this one an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.¹¹⁸

Contrary to some scholars, it is my view that a general rule against overlap would not have a positive impact. This argument is based on the aforementioned cases *In re Mogen David Wine Corp.* and *In re Honeywell Inc.*, and concur with the Court's views that the three forms of intellectual property exist independently of each other, under different law schemes, and for diverse motives. For example, even though, Mickey Mouse, a design originally protected by copyrights, may now or in the future be protected under trademark law, it may do so only because it acquired secondary meaning by its use in relation to some goods and services. It, therefore, meets the underlying public policies of the brand protection that Congress intended to incorporate into *The Lanham Act*.

The Mickey Mouse design, either under trademark, patent design or copyrights, derives its protection from the scheme and set of rules that those

¹¹⁶ Moffat, *supra* note 68, at 1516.

¹¹⁷ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

¹¹⁸ *Id.* at 122.

systems provided. Thereby the Walt Disney Company may lose its Mickey Mouse figure if it abandons or discontinues using the brand in commerce or if the patent design or copyrights expires. Even if the Mickey Mouse design holds overlapping rights, those protections are nonetheless subjected to the consideration and policies that underlie the different forms of intellectual property. Similarly, Zimmerman exemplifies that:

[I]f the drawing in a patent illustrates a functional article with the super-addition of aesthetic features or an aesthetic design such as the face of “Mickey Mouse,” there is no reason why copyright in the design of the “Mickey Mouse” face should be lost. Moreover, if that aesthetic design also functions as a trademark, it would be hard to argue that such protection must be lost simply because the design found its way into patent drawings. Use of that design would almost certainly not be necessary to enjoy the benefit of the invention of the expired patent. The copyright and trademark rights may have preceded the patent rights, and may continue to exist long after the patent expires.¹¹⁹

IV. CONCLUSION

Whether overlapping protection between different forms of intellectual property is desirable or permitted depends on the particular view of those who benefit from it and those who do not. However, there is no denying that such overlap does exist and it presents fertile ground for strategic decision making and commercially oriented planning to maximize the protection of intellectual property. As a result, the creator of the work will achieve higher economic performance and profits in the long run. The different types of protection and their incidental overlapping characteristics reflect the evolution of the industrial, scientific, and artistic production in the United States. It also represents a commercial value in the domestic and international markets. Intellectual Property is one of the United States’ most valuable assets and a key driver of the economy.

As recent as in March 2012, the U.S. Department of Commerce, working with the President’s Council of Economic Advisors and the Chief Economists of the Office of the U.S. Trade Representative, Department of Labor, and other federal agencies, released an economic report identifying the full range of sectors that generate intellectual property, as well as, the

¹¹⁹ Zimmerman, *supra* note 114, at 365-66.

jobs, exports, and wage premiums which those sectors support. The report found that nearly 30% of all jobs in the U.S. are directly or indirectly attributable to the Intellectual Property Industry. Likewise, the study found that intellectual property is also critical to U.S. trades, since goods from the intellectual property industries account for 60% of all U.S. exports. And in 2010 alone, "IP-intensive industries accounted for about \$5.06 trillion in value added, or 34.8 percent of U.S. gross domestic product . . ."¹²⁰

In order to reap the benefits of time, money, and resources invested in the production of intellectual property there must be a legal and regulatory system with the capability to timely process and assert property rights disputes. Nevertheless, the protection of intellectual property rights in United States can be rendered useless if lawful owners and creators are prone to usurpation and legal attrition for not acquiring the protection that best suits their works. The overlap among the laws presents a new and successful strategy to achieve the maximum protection for intellectual property and knowledge of the applicable statutes and regulations. Correct application in federal, state and, international bodies is a first line of defense in exercising that protection.

¹²⁰ ECON. & STAT. ADMIN. WITH U.S. PAT. & TRADEMARK OFF., INTELLECTUAL PROPERTY AND THE U.S. ECONOMY: INDUSTRIES IN FOCUS vi (2012), *available at* http://www.uspto.gov/news/publications/IP_Report_March_2012.pdf.