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PROTECTING THE FORM BUT NOT THE FUNCTION:

IS U.S. LAW READY FOR A NEW MODEL?

Dana Beldiman

Introduction

As our society develops, it produces new and different kinds of intangible goods. However, many of the mechanisms available to protect such goods date back hundreds of years and are inadequate and in desperate need of an overhaul in order to adapt to the new realities of our world. Overly rapid doctrinal expansion can result in negative collateral effects, such as lack of precisely defined standards and blurring of boundaries between doctrines. Such side-effects risk disturbing the delicate balance between free competition and protection that underlies the structure of our intellectual property laws. The growth of intellectual property protection must therefore involve a constant rebalancing between the interests of creators and those of the public at large.

One of the areas that has undergone rapid change in recent years is protection of product design. Pressured by systemic demands for stronger protection mechanisms, judicial decisions have dramatically broadened the scope of protection, in particular in the area of trade dress law. Many of these decisions, however, are rendered in an immature doctrinal environment, characterized by the use of imprecisely defined concepts and doctrines that are incongruous with the needs of the intellectual property to be protected. This incongruity between problem and solution can create precedents that threaten the balance between free competition and protection. That balance can be restored, however, by limiting trade dress protection and
implementing specialized design protection mechanisms. Legislative models for more closely tailored protection mechanisms exist, and should be considered.

Summary

Part I. Our society continually produces new types of intellectual property ("IP"). The protection required by these new types of IP drives existing IP laws to relentless expansion. The effects of rapid growth of legal doctrines can easily disturb the balance between free competition and protection by forcing a new problem into an old solution. Part I of this paper delves into the manifestations of doctrinal expansion. Such symptoms include a change in the underlying function of the laws, convergence of doctrines (in particular copyright and trademarks which are the focus of this paper), blurred doctrinal dividing lines, creation of hybrid judicial monopolies that are immune to the limitations of either doctrine, and the use of protection mechanisms that do not fit the needs of the particular form of IP to be protected.

Part II discusses a type of claim that has emerged in recent years and is pushing protection under the Lanham Act beyond its originally intended scope. The "type of look" protection, a variety of product design, covers not individual products, but rather the common elements of an entire line of products. In a crowded marketplace, distinctive design plays an increasingly important role as product differentiator. Designer articles are particularly vulnerable to copying because, unlike an internal mechanical part or a chemical composition, they wear their ingenuity on the outside, for all to see. This section then discusses three lines of conceptually related cases, in which protection is extended to an entire line of items in the areas of visual art, music and utilitarian product design.

Part III analyzes the two defining elements of trade dress: non-functionality and distinctiveness. These elements present the following four problems with respect to product design "type of look" cases:

1. most courts eschew the aesthetic functionality analysis, because no standards for application exist. Although in some cases its application could help limit the scope of trade dress protection, opinions on the need for this doctrine are mixed;
2. the basic requirement for "type of look" protection is "precise expression" of the claimed design, however no
criteria exist to define the requisite level of precision. As a result, courts can easily factor in extraneous, and sometimes inappropriate, considerations;

(3) the legal concept of distinctiveness is too easily confused with a design’s striking appearance and the line between the aesthetic function of the design and its source indicative function is virtually impossible to draw;

(4) while resting on sound principles, the rule that requires a showing of secondary meaning for product design essentially eliminates trade dress as a method for protection of most of product design.

These factors, in addition to the incongruity between the protection offered by trade dress and the needs of holders of design rights, lead to the conclusion that trade dress is not the optimal method for protection of “type of look,” IP, and, possibly for product design in general. This paper reviews a spectrum of IP protected under trademark/trade dress law, in decreasing order of source indicative information content, with word marks at one end and “type of look” at the other. At a given point in that spectrum, distinctiveness becomes so tenuous as to suggest that trade dress protection for product design, including “type of look” be cut off.

Part IV considers whether product design should be protected by methods other than design patent, trademark, or copyright. Existing models of industrial design protection laws are reviewed, including TRIPS, the EU design laws, the German models Gebrauchsmuster and Geschmacksmuster, and the Vessel Hull Protection Amendment to the Copyright Act. The review indicates that there is much greater congruity between the needs of product design owners and the industrial design protection laws, than in trade dress law. Continued use of an improper mechanism to protect product design disturbs the delicate balance between free competition and protection sought by the existing IP laws, and may result in judicial monopolies which remove valuable assets from the public domain for generations.
Part I

THE RELENTLESS EXPANSION OF INTELLECTUAL PROPERTY RIGHTS—DO NEW TIMES DEMAND NEW TOOLS?

One of the main characteristics of an information society is that it produces wealth that comes in intangible form. Statistics show that in the past 20 years the value of intangible assets in leading US businesses has more than tripled. These assets demand protection. As new protection mechanisms are created and adapted to the newly created forms of IP, IP laws expand and new laws are created.

US IP law has been resistant to change due to Congress's reluctance to legislate new types of protection. By way of example, the U.S. has declined to adopt legislation implementing international treaties, such as certain aspects of TRIPS, Article 6bis of the Berne Convention, and the European Database Directive. With respect to protection of product design, the US takes the position that the existing patent, copyright and trademark laws offer adequate protection with respect to design protection. This means that new realities and concepts have to be handled within the existing set of traditional IP doctrines, which are consequently being manipulated to fit these new advancements.

A multitude of policy considerations factor into the decision whether to create new forms of protection. On the one hand, new

2. Copyright: A Radical Rethink, THE ECONOMIST, Jan. 23, 2003 (noting the many difficult issues raised by the spread of the internet and related technologies).
forms of IP protection pose a potential threat to innovation and competition. On the other, use of a protection mechanism that does not meet the needs of a particular type of IP can result in undesired effects even more harmful to innovation and competition than narrowly tailored new laws.

Each form of protection is a finely tuned instrument, geared to achieve a particular policy goal. The U.S. Constitution requires Congress to secure "to Authors and Inventors the exclusive right to their respective writings and discoveries" in order to "promote the progress of science and useful arts." An exclusivity period granted under defined circumstances secures a fair return for the authors' creative labor, and operates as an incentive to further creation. This policy underlies Congressional legislation to protect inventions and creations, and is undoubtedly responsible for much of the progress of our society. Patent and copyright laws are about incentives to invent and to create. Trademark and unfair competition law is about the efficient operation of the market. Its rules are intended to enable consumers to recognize and repurchase goods with which they have previously been satisfied. As a by-product, the product's maker reaps the rewards of the reputation it has built.

The policies underlying these laws date back hundreds of years and are as valid today as they were at the time of their inception. The most important consideration in deciding whether to expand old laws, as opposed to creating new protection mechanisms, is to not disturb the delicate balance between the interest of rights owners and those of the public at large that draws from the public domain.

Innovation and creation require access to essential building blocks, which must remain in the public domain. Our culture and

11. Denicola, supra note 7, at 1663.
civilization draw heavily on the public domain's accumulated wisdom of the ages. Its wealth can be maintained only by increasing the stock of knowledge and of art.\textsuperscript{14} No progress can take place if the world is not allowed to build on the work of its predecessors. The situation has been aptly described by a statement that "a dwarf standing on the shoulders of a giant can see farther than the giant himself."\textsuperscript{15} IP laws are designed to let the dwarf build on what the giant has accomplished.

The history and growth of IP protection is a story of constant efforts to balance and re-balance the competing interests of creators and the public.\textsuperscript{16} It is a never-ending story, accompanying the relentless expansion of IP laws.

1. \textit{The Insatiable Lanham Act}

Since the enactment of the Lanham Act in 1947, trademark rights have witnessed a huge expansion both substantively and procedurally.\textsuperscript{17}

Originally, trademark was a doctrine that granted protection to word marks. Over the years it has come to cover color, sound, labels, packaging, two dimensional design objects, three dimensional design objects, art, lines of product, etc. in the guise of "words, names, symbols or devices."\textsuperscript{18} It supports blocking registrations in order to reserve marks for future use,\textsuperscript{19} and it applies to bad faith in cyberspace.\textsuperscript{20} Likelihood of confusion, a concept originally meant for

14. Denicola, \textit{supra} note 7 at 1676 (citing Twentieth Century Music Corp v. Aiken, 422 U.S. 151,156 (1975)).
the protection of the consumer, now also applies to third parties' post sale confusion and inures to the protection of the mark owner.\textsuperscript{21}

Starting out as a doctrine meant to protect against marks which cause a likelihood of confusion among competing products, trademark has become a doctrine which protects against the "gradual whittling away and dispersion of the identity"\textsuperscript{22} in non-competing products without a need for likelihood of confusion.\textsuperscript{23} The doctrine has now come to be used to restrict such legitimate uses as comparative advertising\textsuperscript{24} and parodies directed at the trademark owner.\textsuperscript{25}

As owners of designs began to migrate to the new trade dress doctrine in order to avoid both the stringent formalities and costly prosecution of the design patents,\textsuperscript{26} and the uncertainty of copyright protection for useful articles,\textsuperscript{27} trademark laws grew to allow outright ownership of phrases, useful objects, designs and style, and to prevent their use regardless of context.\textsuperscript{28}

2. \textit{The Expanding Copyright Act}

Copyright law has seen an equal expansion. Its magnitude is illustrated by the length and complexity of the Copyright Act.\textsuperscript{29}

As framed, copyright afforded protection to "writings" and "authors."\textsuperscript{30} Writings has now come to include a range of creative

\begin{itemize}
\item \textsuperscript{21} Hermes Int'l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 108-09 (2d Cir. 2000); Payless Shoesource, Inc. v. Reebok Int'l, Ltd., 998 F.2d 985, 989-90 (2d Cir. 1993).
\item \textsuperscript{22} Frank Schechter, The Rational Basis for Trademark Protection, 40 HARV. L. R. 813, 825 (1927).
\item \textsuperscript{24} Deere & Co. v. MTD Prods., 41 F.3d 39 (2d Cir. 1994) (enjoining a parody of a competitor's advertisement).
\item \textsuperscript{25} Anheuser-Busch v. Balducci Publ'ns, 28 F.3d 769 (8th Cir. 1994) (enjoining the use of plaintiff's trademarks in a parody advertisement alluding to environmental problems).
\item \textsuperscript{26} See infra text accompanying note 90.
\item \textsuperscript{27} Kieselstein-Cord v. Accessories By Pearl, Inc. 632 F. 2d 989, 992 (2d Cir. 1980).
\item \textsuperscript{28} See Lemley supra note 19, at 1696.
\item \textsuperscript{29} Denicola, supra note 7, at 1683.
\item \textsuperscript{30} U.S. CONST. art. I, § 8, cl. 8.
\end{itemize}
works, from photographs\textsuperscript{31} to computer programs,\textsuperscript{32} useful articles,\textsuperscript{33} computer chips,\textsuperscript{34} and sound recordings.\textsuperscript{35}

The Copyright Acts went from prohibiting literal copying to covering work with the same "concept and feel."\textsuperscript{36}

Introduction of new technology has resulted in new laws amending the Copyright Act, such as the Audio Home Recording Act of 1992,\textsuperscript{37} which prohibits sale of digital audio recording devices, and the Digital Millennium Copyright Act,\textsuperscript{38} which forbids circumvention of technological measures,\textsuperscript{39} now criticized for impinging on the public domain and free speech.

The Copyright Term Extension Act (CTEA), also referred to as the Sonny Bono Act, was lobbied for by copyright owners,\textsuperscript{40} and extends the terms of all copyrights for 20 years,\textsuperscript{41} both prospectively and retrospectively.\textsuperscript{42}

In short, copyright, like trademark law, suffers from what has been termed a "doctrinal creep".\textsuperscript{43}

\begin{enumerate}
\item See Ets-Hokin v. Skyy Spirits Inc., 225 F.3d 1068 (9th Cir. 2000).
\item Id. at § 101.
\item Id. at § 902.
\item Id. at § 102(a)(7).
\item See Cavalier v. Random House, Inc., 297 F.3d 815 (9th Cir. 2002).
\item Audio Home Recording Act, 17 U.S.C. §§ 1001(1)–(10) (1992) (prohibiting the importation, manufacture, distribution of digital audio recording devices unless the devices are equipped to prevent "serial copying").
\item SHELDON HALPERN, COPYRIGHT LAW—PROTECTION OF ORIGINAL EXPRESSION, Carolina Academic Press, at 240 (2002). The law makes actionable circumventing technological measures that effectively controls access to copyright protected work and trafficking in such technology, as well as interfering with copyright management information.
\item Brenda Sandburg, U.S. Law Extending Copyrights Upheld, THE RECORDER, Feb. 21, 2001 ("The CTEA was supported by every group of creators and copyright owners you can imagine").
\item 17 U.S.C. §§ 302(a), (c) and 304 (creating terms for works after 1978, life of the author plus 70 years, 120 years from creation and 95 years from publication for anonymous, or pseudonymous or is work made for hire).
\item The Act, intended to harmonize U.S. copyright law with the European Copyright Directive, has been generally regarded as benefiting primarily large rights holders, and therefore also termed the "Mickey Mouse." Its purported policy rationale of providing greater incentives for creation, has met skepticism from commentators as well as the Supreme Court, who questioned how an extra twenty years of protection after the author's death incentivizes creation. Long, supra note 13, at 867. Nonetheless the Act survived judicial scrutiny in Eldred v. Ashcroft, 123 S. Ct. 1505; 155 L. Ed. 2d 243 (2003).
\end{enumerate}
COLLATERAL EFFECTS OF EXPANSION

One way in which the "doctrinal creep" becomes manifest is further expansion of already inflated doctrines to cover new forms of IP. Often there is no natural congruity between the needs of the new form of IP and the function and scope of the doctrine selected. Despite efforts to force existing theories to protect new IP, what results is the transformation of the laws' underlying functions, convergence of the doctrines, and a blurring of the dividing lines between them.

1. Convergence of Functions

With the trend toward stronger protection, the underlying functions of individual IP laws gradually erode and the laws are transformed into pure investment protection instruments. Copyright protection is meant to stimulate artistic creativity of authors, but has become largely an instrument to maximize the returns of authors and publishers. The trademark/unfair competition doctrine is intended to protect consumers from trickery or deceit, but as currently applied, this doctrine has become a mechanism by which companies recoup advertising and marketing expenses.

2. Convergence of Doctrines

The convergence of function is accompanied by the convergence of the doctrines themselves. This applies particularly to doctrines such as copyright and trademark, which naturally complement each other

44. For instance, software requires protection for the span of its useful life, on an average 3–5 years, yet the protection term under copyright law is life plus 70 or 120 years from creation. 17 U.S.C. §§ 302(a), (c) and 304. Similarly, industrial design protected under trade dress law is not a good fit. See infra text accompanying notes 229–232.

45. See Michael Todd Helfand, When Mickey Mouse is as Strong as Superman: the Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters, 44 STAN. L. REV. 623 (1992) (arguing that convergence of copyrights and trademarks is manifest by the courts functionally merging tests of infringement; use of similar language and reasoning and tacking on claims to favorable rulings on other claims).

46. Jessica Litman, Breakfast with Batman: The Public Interest in the Advertising Age, 108 YALE L.J. 1717, 1725 (1999) ("There has been inexorable pressure to recognize as an axiom the principle that if something appears to have substantial value to someone, the law must and should protect it as property").

47. See Denicola, supra note 7, at 1676 (citing Ralph S. Brown, Eligibility for Copyright: a Search for Principled Standards, 70 MINN. L. REV. 579 (1985)).

by covering discrete needs.\textsuperscript{49} Certain types of property lend themselves to dual protection by copyright and trademarks, covering the expressive unit and the function as source indicator, respectively. Such types of IP include graphic representations of persons or characters, literary works and their titles\textsuperscript{50} and certain aspects of visual art and three dimensional design objects.\textsuperscript{51} Works originally covered by copyright may gain trademark significance by use as a symbol of origin, and obtain trademark coverage upon expiration of the copyright. As long as each doctrine adheres to its function, and protects different aspects of an item, the two doctrines complement each other in a salutary manner.\textsuperscript{52}

Dual use however may have a less salutary effect, when it results in the interchangeable use of language and reasoning, merger of infringement tests and hybrid judicially created monopolies, which are not subject to the limitations of either doctrine.\textsuperscript{53} An example in point is the case of \textit{Edgar Rice Burroughs, Inc. v. Manns Theaters}.\textsuperscript{54} The plaintiff's trademark registration of the name "Tarzan" was the basis for precluding third party use of this mark. The court reasoned that "famous character names in copyrighted works may not be used by others during the life of the copyright without authorization of the copyright proprietor."\textsuperscript{55} Without the benefit of conducting a likelihood of confusion or substantial similarity analysis, the court granted a trademark-like protection that is immune to charges of copyright infringement, or to defenses of abandonment\textsuperscript{56} or fair use.

\textsuperscript{49} Copyright law protects original expression in literary and artistic works. 17 U.S.C. § 102(a). Trademark law prevents confusion as to the source of goods. See 4 MCCARTHY, supra note 48, § 2:3.

\textsuperscript{50} Such as books, magazines, movies, records.

\textsuperscript{51} Mazer v. Stein, 347 U.S. 201 (1954) (holding a design of a lamp protectable under copyright law).

\textsuperscript{52} Some intellectual property can function as identifier of source as well as expressive unit and can therefore implicate both doctrines without overlap or conflict. Tristar Pictures, Inc. v. Del Taco, Inc., 59 U.S.P.Q. 2d 1091 (C.D. Cal. 1999); MCCARTHY, supra note 48, at 6-8 (citing Kohler Co. v. Moen, Inc., 12 F.3d 632, 29 U.S.P.Q. 2d 1241, 1246 (7th Cir. 1993) ("Courts have consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of IP").

\textsuperscript{53} See generally Helfand, supra note 45. See infra text accompanying notes 162–163.


\textsuperscript{55} Id.

\textsuperscript{56} See Helfand supra note 45, at 647–48.
3. *The Blurring of Distinctions Between Copyrights and Trademarks*

Failure to strictly observe doctrinal dividing lines results in interchangeability of concepts. As illustrated in the following case, the Lanham Act can be called upon to perform a trademark function.

In *Gilliam v. American Broadcasting Companies, Inc. (ABC)*, the creators of the television series "Monty Python’s Flying Circus" complained that ABC had drastically shortened the programs, and edited the profanity from them for rebroadcast in America. They sued for copyright infringement and mutilation of the work in violation of the Lanham Act. The right to prevent mutilation and modification of one's work is a right recognized under the Berne Convention. However, the U.S. has not implemented this rule, a fact which effectively leaves Monty Python without remedy. The Second Circuit avoided this roadblock by giving the Lanham Act an expansive construction, sufficient to protect against mutilation of artistic works as a false designation of origin of goods. The court found that ABC's edits presented the work in a form that substantially departed from the original work, and that "to deform [the creator's] work is to present him to the public as the creator of work that is not his own." Presentation in this manner would create a false impression of the product's origin in violation of Section 43(a).

This treatment of moral rights was subsequently validated during the debate to amend the Copyright Act to include “moral rights” in conformance with the Berne Convention. Congress concluded that an express provision for moral rights was unnecessary, given the judicial expansion of Section 43(a) of the Lanham Act, citing *Gilliam v. ABC*. Thus Section 43(a) remains a permanent “gap filler” for the near-absence of moral rights in the Copyright Act. *Gilliam* illustrates that the dividing lines between trademarks and copyrights are so

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57. 538 F.2d 14 (2d Cir. 1976).
59. The court noted that American copyright law does not recognize a cause of action for violation of artists' moral rights that would protect against unauthorized changes in the work. See Halpern, supra note 39, at 228. See also Gilliam, 538 F.2d at 26-27.
60. Gilliam, 538 F.2d at 24.
porous that the two doctrines can function virtually interchangeably in given circumstances.

4. Use of the Wrong Protection Tool

Protection mechanisms must be adapted to the new forms of IP our society produces. Lack of congruity between the tools used and the needs of the IP lead, on the one hand, to excessive protection, which unnecessarily impinges on free competition and, on the other, to failure to meet the needs for protection, all of which results in economic inefficiency. Furthermore, in order to accommodate the needs of new IP, courts strain the analysis to make things "fit," stretching concepts beyond their original meaning.

Rapid expansion also affects the definiteness of standards. Due to constant expansion, doctrines have little time to mature, with the result that concepts are not clearly defined, no distinguishing terminology exists, and dividing lines become blurred.

The absence of clearly defined standards causes them to be misapplied, giving fact finders more leeway in making ultimate decisions. Considerations of fairness, sympathy and other visceral reactions can come into play. All of this creates a general environment of uncertain legal standards and unpredictable outcomes. Transaction costs increase because additional resources are devoted to compensate for the lack of predictability.

Part II

PROTECTING THE "TYPE OF LOOK"?

Expanded protection is fuelled by the creation of new types of IP, resulting in efforts to "stretch" the existing doctrines. Lawsuits which attempt to stretch existing doctrines far beyond their originally intended scope are presented to courts on a regular basis. Even if initial attempts to assert a particular new spin on a theory are fruitless,

62. See infra text accompanying notes 241–244.
63. See infra text accompanying notes 196–202.
64. See infra text accompanying notes 208–210.
65. Transaction costs between consumer and producer increased, because resources are expended to achieve added predictability, both producer and consumer lose in the process.
66. Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120, 127 (2d Cir. 1999). The Second Circuit recognized that plaintiff owner of trade dress rights can have a claim for the "Samara type of look."
the persistent pressure and passage of time eventually erodes the doctrine's original borders and open the door to broad protection.67

A claim that has seen significant growth in the past year is the "type of look" claim, attempting to protect a category of product design.68 Its main characteristic is that it covers not just a single product, but an entire line of products having the same features.

1. *Increased Role of Design in Contemporary Society*

"Type of look" claims arise mainly in the area of industrial design, but extend into art, and even music. As markets become increasingly crowded, producers of goods are looking to design as a product differentiator. Increased investment in production of designer goods results in more designer products on the market and in consumers' tastes becoming more sophisticated. Our society currently has an insatiable appetite for designer articles, ranging from designer clothes to designer faucets to designer vehicles.69 Basic articles of everyday use, such as bottle openers, computers and stereo systems command a higher price based on distinctive sleek design. Manufacturers hire designers70 in order to increase their cachet, stores hire architects to design flagship showrooms71 and TV channels named "Style" and "Design" are launched. As industrial design is accepted as a creative activity that is valuable to society, design museums are established in major cities of the world.72

Design can give a product the necessary competitive edge it needs in a crowded market, which makes it an important ingredient in a product's commercial success. Good product design can result in product that is reliable and easy to use; it can give an aesthetic appeal, style and image to the product. The more designer products are

67. See Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 62 (2d Cir. 2001); See also text accompanying notes 166-173.
68. The terminology is not entirely clear. This type of claim is referred to varyingly as "overall look," "type of look," "the look and feel," "concept and feel" or "style."
69. The Great Design Issue, ARCHITECTURAL DIGEST, May 2003, at 53 (celebrating "the eternal spirit of innovation that guides the world's greatest designers in their work").
70. DAILY NEWS RECORD, Sept. 10, 2001 (Target Stores have exclusive deals with famous designers Todd Oldham, Michael Graves, and Mossimo).
71. Blair Kamin, New York stories of flagship stores; Gehry's design is on the money while Koolhaas' 'costly wave' flags, CHICAGO TRIBUNE, Apr. 7, 2002, at 6 (Miyake hires architect Frank Gehry to design flagship New York store; Prada retains Rem Koolhaas for Manhattan flagship).
created, the more they penetrate into public use, and in turn fuel the demand for such products.

From an IP protection standpoint, the problem is that product design bears its know-how on its face, because its ingenuity is openly displayed. For this reason, design can be imitated relatively quickly and inexpensively. This is of great concern to companies which invest heavily in the development and commercialization of new product designs. Consider the case of company A which has been in the business of selling children’s clothes for many years. Company A hires a designer to create a particularly attractive line of clothing which becomes the lifeblood of the company. A competitor, company B, buys samples of the entire line of garments produced by company A. B then contracts with a Philippine company to replicate the garments, and sells millions of dollars worth of the clothes, while A’s sales plummet.\(^{73}\)

This is not an uncommon occurrence. Cheap imitations of designer goods are easily produced in countries with low labor rates. They can be placed on the market with astonishing speed and at low prices, long before the originator has had a chance to recoup its investment in the creation of the design.\(^{74}\) To survive, the originator must seek some form of protection.

2. “Type of Look”—How Far Does it Extend?

The fact that design features frequently extend over an entire line of products gave rise to the “type of look” theory. “Type of look” claims also involve other kinds of creative activity, such as art and music, in which creators lay claim to the “style” or type of look of their creations, be it visual or musical.

Most of the “type of look” claims are brought as trade dress claims under Section 43(a) of the Lanham Act.\(^{75}\) Unlike traditional trade dress protection of product design, which protects a single product, the “type of look” protection extends to the “recognizable and consistent overall look”\(^{76}\) across an entire line or series of

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73. This hypothetical is patterned after the facts of Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000).
74. Counterfeiting—In Praise of the Real Thing, THE ECONOMIST, May, 17 2003, at 12 (“Copying is a profitable business: it needs no R&D and no expensive advertising campaigns. Just copy a popular product, sell it at a discount and rake in the returns. This simple business model, when combined with new technologies, free trade and the rising value of brands, is opening a far broader range of consumer goods and markets to enterprising copycats”).
76. Rose Art Indus., Inc. v. Swanson, 235 F.3d 165, 170 (3d Cir. 2000).
products characterized by the same features. Products for which protection has been sought include a line of outdoor furniture, the look of video packaging for seventeen animated films, the appearance of labels on a line of decorative candles, a line of children’s clothes, a line of handbags, the visual style of an artist’s work, the layout of a chain of pool halls, and the musical style of a performer’s signature recording.

Concerns about hindering competition are a serious consideration in granting trade dress protection, even for individual products. This concern is heightened in “type of look” cases, because such claims are broader in scope. The precise scope of protection of “type of look” is still unclear, but it could be extremely broad. To illustrate, consider a line of penguin shaped bar ware, consisting of a cocktail shaker, a bottle opener, a corkscrew, a strainer, a.o. Most likely the “type of look” would cover a third party’s penguin shaped bottle opener, and a fourth party’s cork screw, whether they are part of a line of products or not. Would it cover a duck-shaped bottle opener? Or a plastic duck-shaped bottle opener, if the original one was made of metal? Conceivably, each of these items could be confusing to the consumer and therefore qualify for trade dress protection. If allowed, such protection would expand exponentially and take a huge territory away from competitors.

77. Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373 (2d Cir. 1997).
79. Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d. 25 (1st Cir. 2001).
85. Landscape, 113 F.3d at 380 (“Courts have exercised particular caution when extending protection to product designs. . denying protection that would hamper competition”).
86. Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120, 127 (2d Cir. 1999); Yurman Design v. PAJ, Inc., 262 F.3d 101, 117 (2d Cir. 2001) (“[F]or obvious reasons, concern for protecting competition is in that context [protection for an entire line of products] particularly acute. A claim of trade dress covering an array of items is likely to be broader than one for an individual product’s design”).
3. Protection Options for Product Design

Trade dress is not the only option available for protection of the “type of look,” design patent and copyright could also qualify.87 Design patents, which are granted to articles of manufacture that meet the requirements of being original, novel and ornamental,88 have been on the increase in recent years.89 Many rights owners, however, are reluctant to rely on design patent protection because of the lengthy and costly process of prosecuting the application and obtaining the right.90 Consequently, because neither copyrights nor trademarks necessarily require advance registration,91 claims are often brought, strategically, under both theories, regardless of whether they in fact apply.92

Copyright extends to “type of look” claims only under certain very limited circumstances. A “useful article” covers most product design, but is limited to a pictorial, graphic or sculptural work,93 and only if the design can be separated from the utilitarian aspects of the article.94 So long as the utilitarian aspect is physically separable95 from the ornamental aspect, the test is easy to apply.

87. “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.” 35 U.S.C. § 171 (1999). See also Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238 (Fed. Cir. 1986) (noting that if a patented design is primarily functional rather than ornamental, the patent is invalid). “Copyright subsists... in original works of authorship fixed in any tangible medium of expression...”17 U.S.C. 102(a).
89. James Hamilton, Philippe Signore & Christopher Ward, An Underdog That Bites, MANAGING INTELLECTUAL PROPERTY, Nov. 2002 (“An increase in design patents has been registered, from less than 200 in 1991 to more than 1100 in 2001”).
90. Design patents are subject to the conditions and requirements governing utility patents. 35 U.S.C.S. § 171 (1999) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided”).
92. Asserting both claims, gives them a better chance of prevailing on at least one theory. In effect the result of this strategy is that courts often have a hard time in the analytical separation of the two types of claims. See also Helfand, supra note 45 at 641. Favorable ruling on one count allows finding of infringement on others, especially since plaintiffs allege every conceivable theory of protection. Prevailing on one gives right to injunction, which in many instances is tantamount to winning the case.
94. See id.
When physical separation is not possible because the two aspects are closely intertwined, "conceptual separability" is required. Numerous tests have been advanced to achieve conceptual separability, including the "primary-subsidiary" test, the "inextricably intertwined" test, the "temporal displacement" test, and the Denicola/Brandir artistic judgment test. Neither their names nor their number inspire confidence in the simplicity of the analysis or the predictability of the outcome, and many rights holders have been deterred from relying on copyright for protection.

4. "Type of Look" Under the Lanham Act

This leaves the Lanham Act as the doctrine of choice for rights holders. Although its current version covers the categories of "word, name, symbol or device," much of the Lanham Act grew out of common law trademark law and was originally intended for word marks. Gradually, protection extended to logos and symbols capable of carrying meaning and thereby identifying a product's source. The doctrine was further expanded to include labels, wrappers, and containers used in packaging, including three dimensionally shaped packaging. Three dimensional design of products independent of packaging took protection one step farther. Trade dress is a relatively recent creation, not much more than 20 years old. It is defined as "the total image of a product [that] may include features such as size, shape, color or color combination, texture, graphics or

96. Kieselstein-Cord v. Accessories By Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (articulating the concept of "conceptual separability" of utilitarian from ornamental aspects of the work and granting protection to decorated belt buckle). After Kieselstein the courts have struggled with the concept.

97. Id. at 993 (If the primary ornamental aspect is conceptually separable from the subsidiary utilitarian function, the item is protectable).

98. Carol Barnhart, Inc. v. Econ. Cover Corp., 773 F.2d 411 (2d Cir. 1985) (holding that if aesthetic and artistic features are inextricably intertwined, copyright protection will be denied).

99. Id. at 422–23 (dissenting opinion by Judge Newman) (explaining that if the ordinary observer can focus on the non-utilitarian aspect alone, protection may be granted).

100. Brandir Int'l v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987). This test proposes a sliding scale between art and utility, the more the work is influenced by utilitarian considerations, the less it can be copyrighted.


104. McCarthy, supra note 48 at § 8:1.
even particular color techniques." 105 In other words, "the design and appearance of a product together with the elements making up the overall image that serves to identify the product presented to the consumer." 106 In 1999 Subsection 43(a)(3) of the Lanham Act was amended to protect unregistered trade dress. 107

"Type of Look" rights holders prefer trade dress protection because the requirements for protectability are relatively simple. All that needs to be shown is that the product is distinctive and non-functional. 108

As applied to product design, trade dress is still a very young and developing doctrine with which courts are still ill at ease. 109 Because the trade dress doctrine borders closely on both copyright and design patents, legitimate concern exists that over-extensions of trade dress protection will thwart policy rationales of copyright and trademark law, and negatively affect competition. 110

In an effort to stem the flow of product design cases brought under a trade dress theory, over the last three years the Supreme Court has restated the standards for both distinctiveness 111 and non-functionality, 112 the two defining elements of trade dress. The Court’s expectation was that the decisions would reduce the frequency and difficulty of such cases. This did not occur. As one commentator points out, more than two years after these decisions "butchers, bakers

106. Chrysler Corp. v. John C. Silva, Jr., 118 F.3d 56, 58 (1st Cir. 1997) (quoting Fundamental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 999 (2d Cir. 1997)).
107. Subsection 43(a)(3) of the Lanham Act, added in 1999, refers to “civil actions for trade dress infringement under this chapter for trade dress not registered on the principal register.” 15 U.S.C. § 1125(a)(3) extends protection not only to words and symbols, but also to “trade dress.”
110. Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 32 (2d Cir. 1995) (“Overextension of trade dress protection can undermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas”).
112. Traffix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001) (“Discussing trademarks, we have said ‘in general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article’”).
and candlestick makers, waving trade dress claims, still line the courthouse steps.113

Can trade dress, a doctrine that itself is still in flux, expand to include protection for the "type of look"?

"TYPE OF LOOK" IN CASE LAW

The overriding theme present throughout "type of look" cases is the need to ensure that the proper balance between free competition and protection is observed.114 This interest dictates denial of trade dress rights on two grounds. The first, functionality, acts as a bar to features that (1) are essential to the use or purpose of the article, and (2) affect its cost or quality.115 The second, non-distinctiveness, results from the failure to articulate the claimed design features with sufficient precision and their consequent inability to act as an indicator of source.116 Functionality is present mostly in its aesthetic functionality variety,117 which is germane to design protection because of the visual aesthetic element involved. However, distinctiveness has proven to be the true stumbling block with respect to design protection, since, as the following discussion points out, design, for the most part, is simply not "distinctive" in a trademark sense.

113. See Defining Trade Dress After Wal-Mart v. Samara Brothers, LEGAL TIMES, Mar. 4, 2002 at 20. In Vasquez v. Ybarra, 150 F. Supp. 2d 1157 (D. Kansas 2001), the owners of a Mexican restaurant sued the owners of a competing restaurant for trade dress infringement, alleging the overall look of the restaurant's menu was trade dress. The court found that the overall visual appearance of a menu is a tertium quid similar to the restaurant layout in Two Pesos v. Taco Cabana, 505 U.S. 763 (1992), which allowed the plaintiff to argue the menu is inherently distinctive. In Clicks Billiards Inc. v. Sixshooters Inc., 251 F.3d 1252 (9th Cir. 2001), as in Two Pesos v. Taco Cabana, Clicks sought to protect its trade dress in the overall layout of its pool halls, on the ground that the combination of elements created a "distinctive visual impression." Clicks made a strategic decision to try to establish secondary meaning, and the Ninth Circuit reversed summary judgment for the defendant on the ground that an issue of fact had been raised concerning secondary meaning.

114. Yurman Design, 262 F.3d at 115 ("[T]rade dress claims raise a potent risk that relief will impermissibly afford a level of "protection that would hamper efforts to market competitive goods" (quoting Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 380 (2d Cir. 1997)).


117. Commentators have pushed for a more robust use of the doctrine, to maintain design within bounds. See Denicola, supra note 7, at 1670–71.
1. The "Line of Product" Cases

The most often cited case relating to protection for an entire line of products is Landscape Forms, Inc. v. Columbia Cascade Company. In Landscape, plaintiff sought protection for its "Petoskey" line of outdoor furniture, which featured three inch curved metal tubing that gives the viewer a floating feeling. To satisfy the distinctiveness requirement, a plaintiff must provide a "precise expression of the character and scope" of the claimed trade dress. The court felt plaintiff's description of the product was too abstract and denied protection to the design. At the same time the court opened the door to similar claims: "there is no question that trade dress may protect the "overall look." Other cases followed shortly thereafter.

Yankee Candle Co. v. Bridgewater Candle Co., involved a set of labels used for different candle fragrances. The labels graphically depicted the fragrance of the particular candle by showing the associated fruit or flower. The court emphasized that a claim to protect a series or line of products must show that the appearance of the several products is sufficiently distinct and unique to merit protection. The elements presented by plaintiff were not so "unique and unusual" as to be source indicative in the absence of secondary meaning.

In Yurman Design, Inc. v. PAJ, Inc., the court denied a trade dress claim for a line of jewelry, because, in that case, the plaintiff had not articulated the elements of the trade dress sufficiently to be a protectable, source-identifying expression. However, the Second Circuit made a point of emphasizing that, in general, "a Plaintiff such as Yurman may seek trade dress protection for an entire product line,

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118. 113 F.3d 373 (2d Cir. 1997).
119. Landscape, 113 F.3d at 381. The elements of the trade dress claimed by Landscape were "large three-inch tubing, with a powdered cosmetic finish, bent in gentle turns that roll around the perimeter of the furniture which in combination with the various seating surfaces gives the viewer a floating or suspended feeling."
120. The court found that the features listed by Landscape were not enough to be "likely to be perceived by consumers as bearing the stamp of their maker." Accordingly, the design did not qualify for trade dress protection because it was not likely to serve as primary source indicator and granting trade dress protection to an ordinary product design would create monopoly in the goods themselves. Id. at 381.
121. Id.
122. 259 F.3d 25 (1st Cir. 2001).
123. Id. at 43.
124. 262 F.3d 101, 111 (2d Cir. 2001).
125. Id. at 117.
by establishing that the "overall look" in each separate product is consistent, i.e. that there is no legal obstacle to the assertion of such claims.

Predictably, some cases resulted in "type of look" claims being upheld.

In *Wal-Mart v. Samara Bros.*, plaintiff ("Samara Bros.") designed and manufactured a line of children's clothing with decorative appliques. Based on photographs of the Samara Bros. clothing, Defendant ("Wal-Mart") contracted to have knock-offs manufactured and offered them for sale. Samara Bros. sued for trade dress infringement.

The Second Circuit upheld the jury verdict in favor of Samara Bros. Samara Bros.' description of the appliques was a "distinctive combination of ingredients" which sufficiently depicts the "Samara type of look." Although the Supreme Court reversed the Second Circuit opinion, it left intact the possibility that trade dress could be used to protect a "type of look," provided that secondary meaning is shown. If on remand in *Wal-Mart* the Plaintiff had proven secondary meaning, the Supreme Court decision would not have precluded the Second Circuit's ruling.

*Coach v. We Care Trading Co.* involves the sale of imitation Coach leather bags. Coach identified four trade dress elements, at a fairly high level of generality. Defendant ("We Care") is in the

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126. Id. at 116. The Second Circuit made a similar statement in Landscape four years earlier. In the interim it decided *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, in which it found the plaintiff's "type of look" protected. Although the facts in *Yurman* did not warrant protection, the court even in the wake of *Wal-Mart*, is clearly sending the message that "type of look" is protectable.


128. The specific design elements claimed by Samara included: "seersucker fabric; large bold appliques; large collars with the appliques generally integrated into the collar and any pockets on the garment; general absence of printed images, black outlines, alphanumeric characters, three-dimensional features or heavy ornamentation (such as bibs or fringe) which are frequently used in children's clothing; and full-cut, one-piece conservative bodies." *Id.* at 126–27.


130. *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 127 (2d Cir. 1998) (upholding the Second Circuit decision that Samara's trade dress was inherently distinctive).


132. The elements of the trade dress claimed by Coach: "glove-tanned leather, bound edges, brass or nickel-plated brass hardware, and a lozenge-shaped hangtag with a beaded
business of distributing imitation handbags. Its owners travel to Asia three or four times a year to purchase handbags. The evidence presented handbags sold by We Care, described as vinyl handbags made to simulate leather, bound edges, simulated brass hardware, and a Coach look-alike blank hangtag. A video of We Care's premises showed two rooms packed with imitation handbags, belts and hangtags.\(^{133}\)

On these facts, the court upheld Coach's trade dress claim. Secondary meaning was found based on a survey, in which a majority of the women questioned recognized the bags as Coach bags. The court held the designs to be non-functional because numerous other ways of making handbags exist, and, consequently, the trade dress granted would not hinder competition.\(^{134}\) The Second Circuit affirmed in part.\(^{135}\) The Supreme Court denied certiorari.\(^{136}\)

2. The Style Cases

Although the "style" cases do not arise in the context of utilitarian articles, as in the "type of look" cases, they do seek to establish protection beyond a single product into an entire line, claiming protection for style or type of look of an artist's creation. As in utilitarian design, the first attempts were unsuccessful.

In *Hughes v. Design Look, Inc.*,\(^{137}\) defendant produced calendars featuring uncopyrighted images by Andy Warhol.\(^{138}\) The estate of Andy Warhol claimed protection for the artist's unique style because the images at issue—Marilyns and Campbell's Soup—have come to represent Warhol. The court rejected the claim because the applicable test is not whether the images must come to signify Andy Warhol as the artist, but rather whether the plaintiffs are the source of the product, in this case, the calendars.\(^{139}\) A similar effort to claim a trademark for the "particular lines, unique figural constellation,"
colors, stylistic features and design\textsuperscript{140} of Salvador Dali was rejected in \textit{Galerie Furstenberg} v. \textit{Coffaro}.\textsuperscript{141} The court noted that the plaintiff used the mechanism of trademark protection to enforce, what is at best, a copyright claim.\textsuperscript{142}

Eventually however, the efforts to protect an artist's visual style proved successful. As in \textit{Galerie Furstenberg} and \textit{Hughes}, plaintiffs in \textit{Romm Art} v. \textit{Simcha}.\textsuperscript{143} sought protection for the visual style of a well known poster artist. The plaintiffs ("Romm Art") were the exclusive licensees of the internationally renowned poster artist Itzak Tarkay. Defendants ("Simcha") sold a series of works called the Patricia line of posters,\textsuperscript{144} alleged by Plaintiffs to be slavishly similar and entirely derived from the Tarkay posters. The only claims alleged were trademark and unfair competition.\textsuperscript{145} No copyright claim was made.

Visual art is properly protected under copyright, not the Lanham Act.\textsuperscript{146} In absence of a copyright claim the court indulged the plaintiffs' unfair competition claims, but in doing so, used trademark and copyright concepts indiscriminately. The analysis was conclusory: because the posters presented a "distinctive visual impression,"\textsuperscript{147} secondary meaning was present and the posters were deemed not functional.\textsuperscript{148} Protection was granted.

The opinion contains a number of misconceptions. First, the court mistakenly attributes the incentives of copyright law to the Lanham Act. "One salutary purpose of the Lanham Act in this context is to protect a creative artist's rights in his or her creation and thus provide incentive to be creative."\textsuperscript{149} In fact it is not the purpose

\textsuperscript{141} \textit{Id.} at 1282.
\textsuperscript{142} \textit{Id.} at 1290.
\textsuperscript{144} \textit{Id.} at 1131.
\textsuperscript{145} The claims alleged were violation of (1) plaintiff's trade dress under the Lanham Act; (2) dilution under the New York statute and (3) unfair competition under the New York statute. \textit{Id}.
\textsuperscript{146} \textit{Galerie Furstenberg}, 697 F. Supp. at 1290.
\textsuperscript{147} \textit{Romm Art}, 786 F. Supp. at 1136.
\textsuperscript{148} Plaintiffs alleged that the combination of visual features of the Tarkay posters created a distinctive visual impression that is not functional and therefore protectable under 43(a). \textit{Id}.
\textsuperscript{149} \textit{Romm Art}, 786 F. Supp. at 1135 (citing Hartford House Ltd. v. Hallmark Cards, Inc., 647 F. Supp. 1533, 1540 (D.C. Colo. 1986)) ("one salutary purpose of the Lanham Act in this context is to protect a creative artists' rights in his or her creation and thus provide incentive to be creative. By protecting and fostering creativity, a product with features different and perhaps preferable to the ... product [at issue] may well be developed. Offering consumers a choice in the non-occasion greeting card market stimulates, rather than stifles competition").
of unfair competition law, in the guise of consumer protection, to implement a policy of encouraging innovative designs by protecting them once designed.\textsuperscript{150} This misconception of policy results in an outcome that crosses the doctrinal dividing lines.

Further, the court mistakes the posters’ visual uniqueness and the artist’s fame for indicators of source.\textsuperscript{151} Plaintiffs presented testimony that Tarkay is considered one of two of the best selling artists in the world wide poster market.\textsuperscript{152} Without any further evidence, the court concluded that “other than aesthetic gratification these images serve no other purpose than to identify their source/creator,”\textsuperscript{153} and therefore the Tarkay mark is a strong mark which meets “the criteria for an arbitrary or fanciful mark because it identifies the origin of the item.”\textsuperscript{154}

Finally, the court equates the artist with the source. This is not acceptable under trademark law because the identity of the artist is irrelevant for purposes of designation of origin under trademark law.\textsuperscript{155} The proper test, as stated in Hughes v. Design Look, is whether the image has come to signify the source of the product, not whether it signifies the artist.\textsuperscript{156} Unlike Hughes where the images were placed on calendars, here the image and product are merged. The absence of an underlying product makes the analysis more difficult. The court eschewed this issue by simply equating the artist with the source as the “source/creator,”\textsuperscript{157} a solution that may not be correct under current trademark law,\textsuperscript{158} but that may be evolving into acceptability.\textsuperscript{159}

\textsuperscript{150} EMI Catalogue P'ship v. Hill, Hollliday, Connors, Cosmopulos, Inc., 228 F.3d 56, 64 (2d Cir. 2000).
\textsuperscript{151} The combination of visual features of the Tarkay posters created a distinctive visual impression that is not functional and therefore protectable under 43(a). Romm Art, 786 F. Supp. at 1136.
\textsuperscript{152} Id. at 1137.
\textsuperscript{153} Id. at 1136.
\textsuperscript{154} Id.
\textsuperscript{155} MCCARTHY, supra note 48 at § 3.02[1] (“The identity of the designer or artist who created the image is irrelevant unless that person is identified as the source of the product or service sold under the trademark image”).
\textsuperscript{157} Romm Art, 786 F. Supp. at 1137.
\textsuperscript{158} See MCCARTHY, supra note 48 at § 3.02[2].
The outcome of this case is troublesome. In the guise of trade
dress/unfair competition protection, plaintiffs are granted broader
rights than they would be entitled to under a copyright analysis.
Copyright law only protects expressive elements. Here, the
claimed elements are articulated at a very high level of abstraction,
and would probably be unprotectable under copyright law: two
female figures with hats and patterned dresses, a particular
background color and flora. The result is that any poster depicting
two women with hats and patterned dresses etc. could give rise to
likelihood of confusion.

Furthermore, the scope of protection is considerably broader
under trade dress law. While under copyright law the artist would
have the right to preclude copying of work created by the artist,
here plaintiff was granted the potential right to preclude distribution
of posters created by third parties. The result is the effective removal
of the elements listed above from the public domain potentially
perpetually and without the softening effect of the "fair use" doctrine.

The Romm Art decision was widely criticized as going too far.
As one court aptly characterized this outcome, "If the law protected
style at . . . a [high] level of abstraction, Bracque might have prevented
Picasso from selling cubist paintings." Nonetheless, the decision
remains on the books and, given the pressure to protect in the area of
visual style and "type of look," will undoubtedly be followed one day.

3. The Music Cases

A subset of the "style" cases illustrates how rapidly trade dress
law evolves to accept new forms of IP. It is well established that
music has the capacity to act as a source identifier when associated
with a particular product. Here however, protection is sought not
for the music's ability to indicate a source, but to point to the artist
herself. In that regard the protection is not unlike the protection for

monopoly over ideas or themes was not contemplated by the copyright law).
161. Romm Art, 786 F. Supp. at 1138 ("The use of two figures, the hats by the women [sic]
the patterned dresses, the background colors and the appearance of flora").
162. As well as creation of derivative works, public display and distribution.
163. Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 382 (2d Cir. 1997).
164. There are many examples of such music marks, including "William Tell Overture for
the Lone Ranger" (see Registration No. 2155923), "Sweet Georgia Brown" for the Harlem
Globetrotters (see Registration No. 1700895). Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 62 n.1
(2d Cir. 2001).
style sought in *Romm Art*. In *EMI Catalogue Partnership v. Hill*, the Second Circuit categorically refused to expand the definition of trademark so far as to grant a song the status of trademark. The case involved Benny Goodman’s song entitled “Sing, Sing, Sing (With a Swing),” an alliterative version of which (Swing, Swing, Swing) had been used in a commercial for golf clubs. The Second Circuit refused to enjoin this use on a Lanham Act theory because the claimed trademark in the song was coextensive with the music itself, and therefore not appropriate for trademark protection.

Only one year later however, the Second Circuit indicated that it would not be “unthinkable for the trademark law to accord the performing artist a trademark or service mark in her signature performance.” Indeed, the court noted that a number of reasons exist for Congress to extend such protection to artists. Oliveira involved a claim for trade dress protection in performing artist Astrud Oliveira’s 1964 recording of “The Girl from Ipanema.” Oliveira presented evidence that not only is the song her signature piece, but it is the centerpiece of all her concert appearances. Moreover, the public associates the performance of Ipanema with her, and she bills herself as “The Girl from Ipanema.” The court denied the claim apparently not for policy but for practical reasons, to prevent existing licensees from having to request an additional trademark license on a song for which they have already purchased conventional use licenses.

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166. *Id.* at 63 (Trademark law “does not protect the content of a creative work or artistic expression as a trademark for itself”).
167. *Id.* at 64 (“The work itself is protected from misappropriation by the copyright laws and the source-identifying function of trademarks requires that a trademark in a musical composition not be coextensive with the music itself. Rather, the trademark serves to identify the copyrighted music”).
168. *Oliveira*, 251 F.3d at 62.
169. *Id.* at 62–63 (indicating that there are reasons both for and against such extension of protection).
170. *Id.* at 61.
171. *Id.* at 63.

But for a court now to ‘recognize’ the previously unknown existence of such a right would be profoundly disruptive to commerce. Numerous artists who could assert claims similar to Gilberto’s would bring suit against entities that had paid bona fide license fees to all known holders of rights. Indeed, artists who had licensed users under their copyrights and had received fees for the copyright license could bring suits claiming additional compensation for infringement of trademark rights. Immense unforeseen liabilities might accrue, upsetting reasonable commercial expectations.
However, the door to such claims remains wide open. So far, no reported decision has taken this concept a step further, but the attempts continue. As in visual art, if this doctrine is pushed to its logical extreme, signature recordings of contemporary performers could be removed from the public domain well beyond expiration of their copyright.

The style and music cases are similar to design cases in that they seek to protect creations through a line of products in a commercial context. Both types of cases in principle qualify for dual protection under trademark and copyright law. For style cases, copyright protection may be a solution because they do not have to face the conceptual separability hurdle. Clearly, none of the lines of cases discussed above is a natural fit for a trademark analysis.

Part III

WHY COURTS ARE HAVING TROUBLE WITH PRODUCT DESIGN AND THE LANHAM ACT

The two defining elements of the trade dress doctrine are non-functionality and distinctiveness. Both of these elements have undergone fundamental reshaping in the course of the past three years. Failure to meet either of these elements will lead to denial of a trade dress claim. If properly applied, these limitations could help reign in the “doctrinal creep” of trade dress law. This section will discuss how each of these concepts is applied in the context of product design.

FUNCTIONALITY

Functionality serves to promote competition by “encouraging . . . the broadest dissemination of useful design features” and by “protecting advances in functional design from being

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172. See G.M.L., Inc. v. Mayhew, 188 F. Supp. 2d 891, 896–97 (M.D. Tenn. 2002). The plaintiff claimed that Johnny Paycheck Little Darlin masters recording had gained secondary meaning as the work of performing artist Johnny Paycheck. The court declined the claim. Id.


monopolized." Trade dress law denies protection to features which are functional, i.e., features (1) that are essential to the use or purpose of the article, and (2) that affect its cost or quality. Thus a successful trade dress claim must show that the feature is non-functional. The non-functionality element is present in all bodies of law that protect product design. It reflects the policy that exclusive rights to functional features may be regulated only by (utility) patent law.

Aesthetic functionality is an extension of utilitarian functionality and is based on the same type of analysis: an inquiry into the availability of adequate alternative designs. If the range of alternative designs is limited by the nature of the article's aesthetic appeal, or, otherwise stated, if the aesthetics of the design is such as to foreclose alternative designs, protection will be denied. If it can be shown that the design choices for which protection is sought were the only ones that could create the proper aesthetic appeal for the article, if no other design choice would do, protection may be granted. Aesthetic functionality is particularly germane to "type of look,"

176. Traffix Devices, 532 U.S. at 33.
179. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c, ("a finding of aesthetic functionality ordinarily will be made only when objective evidence indicates a lack of adequate alternative designs").
180. The Restatement explains:
A design is functional because of its aesthetic value only if it confers a significant benefit that cannot be practically duplicated by the use of alternative designs. Because of the difficulties inherent in evaluating the aesthetic superiority of a particular design, a finding of aesthetic functionality ordinarily will be made only when objective evidence indicates a lack of adequate alternative designs. Such evidence typically is available only when the range of alternative designs is limited either by the nature of the design feature or by the basis of its aesthetic appeal. The ultimate test of aesthetic functionality, as with utilitarian functionality, is whether the recognition of trademark rights would significantly hinder competition. (Emphasis added).
because product design is primarily focused on visual differentiation of articles. 182

Aesthetic functionality is deemed to be one of the least well understood concepts in IP law. 183 Courts have engaged in a "hopeless tangle about the difference between aesthetics and functionality." 184 Some commentators have called for a more robust use of this doctrine, 185 because it has the potential of serving as a useful tool in keeping design protection within more reasonable bounds, 186 and also to prevent copyrightable features from receiving more protection under trade dress law than they would have received under copyright law. 187

In Wallace International v. Godinger, for example, the Second Circuit proposes a test for application of the aesthetic functionality doctrine that limits protection to "precise expression of a decorative style," and denies protection to "basic elements of style that are part of the public domain." 188 A notable aspect of this test is that it rings very close to the idea-expression analysis utilized in copyright law. 189 However, its practical application is far from clear (as is the copyright idea-expression analysis 190) and is likely to be applied on an "I know it when I see it" basis. 191

Application of the aesthetic functionality doctrine in the Romm Art case could have led to a different result. The Wallace test applied to the Romm Art facts would exclude basic elements of style and

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185. Denicola, supra note 7, at 1670.

186. Id.

187. See Wong, supra note 183, at 1160. The doctrine has been criticized for denying "trade dress protection to design features whose only sin it was to delight the senses." See also Krueger International, 915 F. Supp. at 606.


protect as trade dress only the artist's precise expression. The extent to which Tarkay posters incorporate "basic elements of style" depends on what the trier of fact perceives, and application of the test without further guidelines may be difficult. However, at least in principle, application of the quasi-copyright analysis formulated in *Wallace* would have resulted in protection closer to what plaintiffs would be entitled to under copyright analysis.  

On the other hand, the aesthetic functionality doctrine has its critics as well. Professor McCarthy very bluntly states that there is no need for this theory.  

A closer look at the relationship between aesthetic functionality and the other defining element of trade dress confirms this conclusion. The *Wallace* aesthetic functionality test limits protection to the "precise expression of decorative style."  

The *Landscape* distinctiveness test limits protection to "precise expression of the character of the claimed trade dress." Evidently, these are, as applied, one and the same test, which follow different analytical avenues. The *Wallace* test is intended to protect against monopolies based on aesthetic appeal, while the *Landscape* test is meant to ensure the presence of appropriate source indication. However, the underlying concern is the same—to avoid a negative impact on free competition. This fact would suggest that one of the tests is redundant.

**DISTINCTIVENESS**

"Type of look" product design cases present courts with several challenges with respect to distinctiveness.

1. The Double Entendre of Distinctiveness

The legal term "distinctiveness" is easily confused with the concept of striking visual appearance. Courts have used the term

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192. Application of the *Wallace* analysis would only resolve the impermissible protection of ideas. Other aspects of trade dress protection such as the indefinite duration and the inability to assert copyright fair use would remain in effect; of course, if the article truly functions as a source identifier and deserves trade dress protection, the latter aspects are not troublesome.
195. *Landscape*, 113 F.3d at 381.
196. Distinctiveness refers to the capability of symbols to identify the source of the goods that bear the symbol and to distinguish them from goods of others. If a symbol is incapable of being distinctive, because it is descriptive or otherwise, it cannot function as a trademark or trade dress. See *McCarthy*, supra note 48 at §§ 3:1–3:2.
"distinctiveness" indiscriminately, both in its ordinary meaning as different, striking, unusual, or eccentric,¹⁹⁷ and as a legal term of art to show source indicative capacity.¹⁹⁸ This dual use poses the risk that a subjective impression in response to the quality of the design is substituted for proof of association with a source.¹⁹⁹ As pointed out above, the court in Romm Art confused the unique look and the popularity of Tarkay the artist²⁰⁰ with the Tarkay look as a product source designator.²⁰¹ Similarly, in Yankee Candle, the court implies that a greater quantum of uniqueness will make the trade dress source indicative, i.e. distinctive, again substituting the visual appearance for the legal standard.²⁰² As long as no distinguishing terminology differentiates between aesthetic distinctiveness (striking appearance) and legal distinctiveness (source indicative capability) these two concepts risk being confused.

2. "Precise Expression" Of Design Elements

To prevail in a "type of look" claim, a plaintiff must articulate "a precise expression of the character and scope of the claimed trade

¹⁹⁷. Denicola, supra note 7 at 1673 (citing Ralph S. Brown, Design Protection: An Overview, 34 UCLA L. REV. 1341, 1374 (1987)).

¹⁹⁸. In re DC Comics, Inc., 689 F.2d 1042, 1051 (C.C.P.A. 1982) (concurring opinion by Judge Nies) ("distinctiveness as an indication of origin, not simply that it is a distinctive design in the sense of being unusual").

¹⁹⁹. Denicola, supra note 7, at 1673 (citing Ralph S. Brown, Design Protection: An Overview, 34 UCLA L. REV. 1341, 1374 (1987)). See also Leigh v. Time Warner Entertainment Co., 10 F. Supp. 2d 1371, 1382 (S.D. Ga. 1998). The Romm Art court "confused the popularity of Tarkay the artist look as a product source designator. In such cases the visual impact of the appearance is substituted for proof of association with a source that shows real secondary meaning." Similarly, "here the competitive interest in copying is greater (and the likelihood of actual source association seems smaller) than for labels and packaging, and [. . .] the freedom to copy should give way only in the face of proven source significance." Denicola, supra note 7 at 1673 (citing Ralph S. Brown, Design Protection: An Overview, 34 UCLA L. REV. 1341, 1374 (1987)).

²⁰⁰. In both the style and the music cases, efforts are made to recognize the author as the "source." Traditional trademark law rejects that notion. However, the question arises whether the concept of source is undergoing a change. After all, the concept of source in trademark law has undergone fundamental changes in moving from a physical source of goods to a "single albeit anonymous source," adjusting to modern means of doing business. Lanham Act § 43, 15 U.S.C. 1127 (2001). McCarthy, supra note 48 at §§ 3:03[1] and 3:04[1]. If all indications point to the creator as source and if the public associates the work with the creator, it could arguably be a sufficient source indication to warrant trademark protection. See also ROSEMARY COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES 61 (Duke University Press 1998).


A precise expression is important. It allows the courts to (1) evaluate how unique and unexpected the design elements are in the relevant market; (2) tailor narrow relief; and (3) most significantly, to determine if the claim is pitched too broadly, i.e., if it seeks protection for an overly general and therefore unprotectable style, theme or idea. However, no court has defined how precise the "precise expression" of the elements must be. This complete absence of standards leads to unprincipled results, as illustrated by the divergent outcomes in the "line of product" cases. The following chart compares the description of the claimed trade dress in two cases: Landscape and Coach.

<table>
<thead>
<tr>
<th>Landscape</th>
<th>Coach</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Elements of claimed trade dress:</strong></td>
<td><strong>Elements of claimed trade dress:</strong></td>
</tr>
<tr>
<td>&quot;large three-inch tubing, with a powdered cosmetic finish, bent in gentle turns that roll around the perimeter of the furniture which in combination with the various seating surfaces gives the viewer a floating or suspended feeling&quot;</td>
<td>&quot;glove-tanned leather, bound edges, brass or nickel-plated brass hardware, and a lozenge-shaped hangtag with a beaded chain&quot;</td>
</tr>
<tr>
<td><strong>Holding:</strong> no trade dress protection</td>
<td><strong>Holding:</strong> trade dress granted for type of look</td>
</tr>
<tr>
<td><strong>Special circumstances:</strong> none</td>
<td><strong>Special circumstances:</strong> strong evidence of reprehensible conduct</td>
</tr>
</tbody>
</table>

In Landscape, the plaintiff gave a detailed description of the claimed trade dress, yet the court refused to grant protection because the level of specificity did not meet the three criteria stated above. Compared to Landscape, the design described in Coach is considerably more abstract. In fact, it is so abstract that it describes more than half of the handbags on the market. The description provided by Coach is certainly not precise enough to allow a court to evaluate its uniqueness or to tailor a narrow relief, as required by Landscape. Nonetheless, the Coach court found in favor of the plaintiff.

204. Id.
205. Id. at 373.
207. Landscape, 113 F.3d at 381.
208. Id.
Absent guidance on the required level of precision, courts can all too easily be swayed by considerations extraneous to the elements required to prove the case. In *Coach*, the court was likely influenced by evidence of the defendant’s bad conduct. *Wal-Mart* also involved an admitted copyist as defendant, and also resulted in a finding of trade dress protection for plaintiff. Although society “looks with distaste on copiers [because] they reap where they have not sown,” copying by defendant does not factor into liability considerations for trade dress protection purposes. Trade dress law is meant to protect the consumer, not to punish reprehensible conduct by the defendant. The fact that these extraneous considerations appear to influence the trier of fact shows that the absence of standards too easily allows courts to decide cases based on their sense of fairness or other, subjective, visceral reactions.

However, this circumstance should not simply be dismissed as a deficiency of trade dress law. The fact that two courts on similar facts both considered the defendant’s reprehensible conduct poses the broader question whether or not an equitable resolution of these types of facts does, in fact mandate consideration of copying.

3. “Primarily” Source Indicative

The confusion between aesthetics and source identification in the “type of look” cases also presents difficulties in the distinctiveness analysis.

Word marks serve a dual function. On the one hand, they carry their primary, ordinary meaning. On the other, they carry informational content that identifies and distinguishes the goods as originating from a particular source, also referred to as secondary

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210. Brown, *supra* note 17, at 1386 (Our society “looks with distaste on copiers; [t]hey reap where they have not sown, they compete unfairly”).

211. *See infra* text accompanying notes 230–232.

212. *Wal-Mart Stores*, 529 U.S. at 211 (Primary meaning would be “apple” as a fruit, or “Joe’s Tasty Bagels” as good bagels).

213. *McCARTHY, supra* note 48 at 3.03[2] (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 9, cmt. c.) (“Trademarks serve as means of communication between otherwise unknown or anonymous producers and their prospective customers”). Examples of secondary or acquired meaning are e.g. “Apple” as a source of Mac computers or “Joe’s Tasty Bagels” as Joe’s baking operation. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976) (explaining that the strength of marks is categorized in hierarchical order in terms of whether marks have or support this acquired meaning).
meaning, or acquired meaning. The latter is the basis for protection under the Lanham Act.

When it comes to product design, the purpose of the design is to enhance the visual differentiation of a product. Consequently, the emphasis is on appearance and not on source indicative information. Consumers are less likely to recognize the design of a product as an indication of source, but instead tend to see it as a utilitarian or ornamental aspect of the goods.

This blurred distinction between aesthetics and source identification also raises problems with respect to the requirement that the design be "primarily" an indicator of source in order to qualify for protection. The concept of "primary" source indication is not helpful in this analysis because it forces courts to determine whether the consumer chose the product based on its attractiveness, or based on the fact that it is an identifier of source. The answer is likely both. The manufacturer seeks to differentiate its goods by means of an aesthetically pleasing design that the consumer begins to associate with that manufacturer.

This presents courts with difficult decisions, for how can it be determined where the aesthetic function ends and the source originating function begins? Regardless of where the line is drawn, design clearly does not fall into the category of marks whose only purpose is to serve as source identifier, i.e. marks that can be inherently distinctive, because of the overwhelming importance of the visual differentiation function. This fact ties directly into the holding of the most recent Supreme Court pronouncement on distinctiveness of trade dress.

4. No Inherent Distinctiveness

In Wal-Mart v. Samara Bros., the court differentiated between

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214. Wal-Mart Stores, 529 U.S. at 211 (pointing out that acquired meaning would be a more appropriate term).
215. Denicola, supra note 7 at 1674.
216. Id.
217. Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1009 (2d Cir. 1995) (holding that a design chosen "primarily" for aesthetic reasons is not protectable).
218. Krueger International, 915 F. Supp. at 606; Wal-Mart Stores, 529 U.S. at 211 ("Non-word marks ordinarily have no 'primary' meaning").
product packaging and product design in terms of their ability to act as an indicator of source. Because design is intended not to identify the source, but instead to render the product more appealing, product design was held not to be inherently distinctive.

As a result of this ruling, proof of secondary meaning is required to obtain protection for product design and "type of look." The rule is not new; it used to be the law prior to the Supreme Court's Two Pesos decision, which held design of a restaurant to be inherently distinctive.

The Wal-Mart ruling was prompted by the Court's desire to stem the doctrinal expansion of the trade dress doctrine. This strategy appears not to have met with much success. Wal-Mart effectively expands the categories of cognizable trade dress to three:

1. product configuration that can never be inherently distinctive, hence secondary meaning is required;
2. package configuration for which inherent distinctiveness might exist, and
3. "tertium quid," a new category of trade dress akin to packaging, for which inherent distinctiveness might exist.

While the number of product design claims may drop, litigation will simply shift to whether a given design qualifies as a "tertium quid."

On the other hand, this rule seriously limits the ability to protect product design. Consider the predicament of company A. If company A launches a product, company B can have imitations of A's design on the market in a matter of months, while it may take years to

222. Id. at 213.
223. Id. at 215.
224. Id.
226. See Defining Trade Dress After Wal-Mart v. Samara Brothers, LEGAL TIMES, Mar. 4, 2002. While the Court has effectively limited the ability to obtain trade dress protection for product design, the battle ground has shifted to whether a product is packaging or a "tertium quid," akin to packaging both of which can still be inherently distinctive after Wal-Mart.
227. Wal-Mart Stores, 529 U.S. at 215 (suggesting in dictum that restaurant decor, the subject of Two Pesos v. Taco Cabana might qualify as "either product packaging... or else some tertium quid that is akin to product packaging"). Restaurant décor seems to be part of this category, and décor of a store most likely would too. Reexamining the decision in BestCellars Inc. v. Grape Finds at Dupont Inc., 90 F. Supp. 2d 431 (S.D. N.Y. 1990), which predates the Supreme Court ruling in Walmart Stores v. Samara Bros., the outcome would likely have been the same, as a store design seems to fall into the same "tertium quid" category as the Mexican restaurant in Two Pesos v. Taco Cabana, 505 U.S. 763 (1992), which can be inherently distinctive.
establish secondary meaning. This circumstance rules out trade dress protection for many designers, and, because trade dress is the most utilized and accessible form of protection, this rule also risks being a disincentive for creative design. The shortcomings of the Wal-Mart holding suggest that what is needed is an alternate means of protection for product design.

ARE PRODUCT DESIGN AND TRADE DRESS A MISFIT?

The limitation of trade dress protection effected by the Wal-Mart holding represent a significant retrenchment from the very broad trade dress protection previously granted to product design. However, its policy underpinnings cannot be questioned, since they are presumptively based on the recognition that product design and trade dress are not a natural fit.

Historically, trade dress developed out of trademark and unfair competition law. Originally protection was restricted to word marks and symbols. For purposes of words and symbols, the appearance of marks is irrelevant. No premium is placed on a particularly pleasing, new or striking appearance, as long as the mark is an indicator of origin. When it comes to product design, however, appearance is critical because pleasing design is its raison d'etre as product differentiator. Being a source indicator is merely a by-product. However, trade dress protects only the by-product and not the primary qualities for which the design was initially created.

Nonetheless product design was assimilated with labels and packaging and treated the same way, i.e. it was cast into a role where it had to protect against confusion in the marketplace. This explains the misfit between product design and the trade dress doctrine, and why the defining elements of trade dress are

228. This concern was recognized by the Supreme Court in Two Pesos v. Taco Cabana: [A]dding a secondary meaning requirement could have anticompetitive effects, creating particular burdens on the startup of small companies. It would present special difficulties for a business, such as respondent, that seeks to start a new product in a limited area and then expand into new markets. Denying protection for inherently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator’s dress in other markets and to deter the originator from expanding into and competing in these areas.

Two Pesos, 505 U.S. at 775.

229. See id.

uncomfortably stretched to accommodate product design. This misfit is further reflected in the incongruity between scope of trade dress protection and the needs of product design. The remedy company A requires is protection of its design against direct copying for a limited period of time, i.e. until it has gained a sufficient head start to recoup its investment and make some profit. Instead, trade dress protects the consumer from being confused as to the source of products. The protection granted extends to designs by third parties that the consumer perceives as similar. It does not, however, necessarily prevent others from copying A's designs.\textsuperscript{231} Furthermore, the protection is for an indefinite duration, granting A a monopoly for the "type of look" of its design, potentially in perpetuity. In short, the protection granted is unnecessarily broad for A's purposes, while A's true needs are not addressed.\textsuperscript{232}

Returning to the example given earlier, trade dress could conceivably allow the owner of the penguin shaped bar ware design to block each item in a third party's line of products individually, i.e. each penguin shaped bottle opener on the market, but also each penguin shaped corkscrew, and possibly each duck shaped bottle opener, etc., going on \textit{quasi ad infinitum}. Such protection is significantly broader than the rights owner needs to protect against a large competitor's speedy copying. Furthermore, its impact on competition is too great to be societally justifiable.

To sort out these concepts, it is helpful to imagine a spectrum of the source indicative information content of the various categories of trademarks and trade dress. The spectrum also parallels the development of the trademark doctrine into trade dress.\textsuperscript{233}

The spectrum lists in descending order of source indicative content: word marks and symbols, labels and packaging, "tertium quid" (restaurant décor),\textsuperscript{234} product design and type of look.\textsuperscript{235} The

\textsuperscript{231} Depending on whether a likelihood of confusion can be established. More likely, it will not, because trademark law is aimed at preventing confusion in the marketplace, and not copying.

\textsuperscript{232} See Bradley K. Groff, \textit{Bare-Fisted Competition or Palming Off? Protection of Product Design as Trade Dress under the Lanham Act}, 23 AIPLA Q. J. 65, 87 (1995). Trademark requirements of distinctiveness, non-functionality and likelihood of confusion, are not adequate to protect against the copying of design which is not otherwise protected by patent or copyright law.

\textsuperscript{233} It could be viewed as a variation of the \textit{Abercrombie & Fitch Co. v. Hunting World, Inc.} spectrum applied to trade dress. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976).

\textsuperscript{234} \textit{Wal-Mart Stores}, 529 U.S. at 215.
"type of look" is listed separately because a broader scope of claims raises the distinctiveness problems already present in product design to a new level of difficulty.

<table>
<thead>
<tr>
<th>Most source indicative</th>
<th>Least source indicative</th>
</tr>
</thead>
<tbody>
<tr>
<td>Word marks and symbols</td>
<td>Type of look; style – line of clothes, art, handbags</td>
</tr>
<tr>
<td>Labels and packaging</td>
<td>Product design – single product</td>
</tr>
<tr>
<td>Tertium quid – restaurant design</td>
<td></td>
</tr>
</tbody>
</table>

Three processes are associated with this spectrum, advancing in the direction of the arrow.

1. The ability to indicate the source weakens. If a design reaches a point where it loses its source significance entirely, it serves merely to describe the product itself and no longer receives trade dress protection;\(^{236}\)

2. the importance of the aesthetic function increases as the source indicative content decreases, and

3. the potential for competitive harm increases.

As illustrated in the preceding sections, efforts to grant protection to IP situated at the right end of the spectrum strain both concepts and policy, and risk an exponential growth of protection, impinging on innovation and competition. On the other hand, the protection granted does not meet the rights owner’s needs in the marketplace. The overall benefit is therefore minimal.

The three lines of cases discussed above, "type of look," music, and visual art, have three elements in common. First, they are situated to the right end of the trade dress distinctiveness spectrum, i.e. they carry little or no source indicative information content; second, they all seek to further expand the Lanham Act; and third, they should, and with more suitable legal mechanisms could, have been decided differently. As it stands, trade dress standards are so indefinite when it comes to product design, that the potential risk to

\(^{235}\) One way to view the "type of look" is that the origin indicative informational content is replaced with the common elements of design of the line of products, i.e. the information content is intended to point not to the source, but to the other products in the line.

\(^{236}\) A work cannot serve as a trademark for itself. If it does so it is descriptive of itself and cannot operate as a trademark. Oliveira, 251 F.3d at 62.
the public domain is unjustifiably great.

The risks and inefficiencies in trying to protect product design and “type of look” IP by means of trade dress law suggest that at a given point of the spectrum, trade dress protection should be cut off. The precise cut-off point is a subject for discussion. A principled solution would be to preclude trade dress coverage for product design and “type of look” claims, because these variations of trade dress claims are defined by their appearance and not by their connection to the source. The remedies provided by trademark law are of no particular use to rights holders, and conversely the protection they need cannot be granted under trademark law. This cut-off point is consistent with the Supreme Court’s ruling in Wal-Mart, which places product design into a category distinct from other forms of trade dress. “Type of look” is simply one step further on the spectrum, deserving even less protection than product design. The necessary corollary of this cut-off however, is the availability of an alternate form of protection that addresses the needs of product design.

Part IV

TO PROTECT OR NOT TO PROTECT?

If trade dress is not the right vehicle to protect product design, are there alternatives? Is design a form of IP in need of protection with nowhere to go? Should it go anywhere? Our society is premised on the understanding that free competition is the norm. Protection mechanisms are exceptions to the norm justified solely by the pursuit of a significant policy goal. One could argue that company A, by creating unique designs that differentiate its products from its competitors, already has a considerable head start in the production of

\[237\] Such cut-off must be correlated with the availability of other protection options and should not be prejudicial to trade dress protection in instances in which the design truly operates as a source indicator.

\[238\] See Landscape, 113 F.3d at 380 (articulating a claim which covers an entire line of products places upon plaintiff the particularly difficult challenge).

\[239\] Eastern Wine Corp. v. Winslow-Warren, Ltd., 137 F.2d 955, 958 (2d Cir. 1943) (Judge Jerome Frank), cert. denied, 320 U.S. 758 (1943) (“there is a basic public policy, deep-rooted in our economy and respected by the courts, resting on the assumption that social welfare is best advanced by free competition . . . .”).

\[240\] Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989) (“free exploitation of ideas will be the rule, to which protection . . . is the exception”). Id. at 151. See also McCarthy, supra note 48 at § 1.15[2].
designer children's clothes. If the products are sufficiently innovative and unique they will be competitive in the market, and company A's innovation will be rewarded. Thus there is no need to protect.

On the other hand, creation of a product requires substantial investment, of both capital and talent. The risk that competitors will copy designs, enter the market and drive prices down to the competitors' marginal costs, makes the prospect of profit uncertain, thereby discouraging creation and investment. As company A's story shows, this scenario is very real. Because in design, the creative, innovative element is on public display, copying is easy. Furthermore, technology and globalization have created the means for competitors to copy and bring to market copies of the originators' goods at lower prices in record time. All this long before the originator can recoup his investment or gain sufficient market share so as not to be vulnerable.

Let's assume that company A's design does not satisfy (1) the novelty requirements of a design patent, that (2) its product is new and no secondary meaning can be established, and that (3) its design has no copyright protection because the ornamental aspect is so intertwined with the utilitarian aspect that they cannot be conceptually separated. In this case Company A has zero protection against Company B's admitted copying.

While there is a distinct sense of unfairness here, unfairness alone will not support protection. One court points out, "as our ambience becomes more merchandized and banal, it would be unfortunate if we were to discourage use of a spark of originality"

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241. Brown explains that:

"Free-riding copiers may diminish investment in socially useful innovation. If the product is one that requires substantial investment, whether of capital or of talent, the investment may not be made if the prospect of profit, cloudy at best, is made more risky by the likelihood that competitors will enter, drive prices down to their marginal costs, and leave the originator with no return on her sunk costs and with no hope of profits that will balance the risk of failure."

Brown, supra note 17, at 1386.


(Copying is a profitable business: it needs no R&D and no expensive advertising campaigns. Just copy a popular product, sell it at a discount and rake in the returns. This simple business model, when combined with new technologies, free trade and the rising value of brands, is opening a far broader range of consumer goods and markets to enterprising copycats).

Id.
which could transform an ordinary product into one of grace.\textsuperscript{243} If society recognizes promotion of this "spark of originality" as a desirable policy goal, and wishes to encourage this type of invention, then an exception to the norm of free competition is warranted.\textsuperscript{244}

THE "CARROT" OF STATUTORY PROTECTION MODELS

So far the U.S. has not adopted legislation to protect design, with the exception of a very narrow provision benefiting vessel hull design owners. However, other countries, with whom the U.S. trades, including the European Union, have implemented such provisions. Indeed, the TRIPS Agreement, of which the U.S. is a signatory, mandates implementation of design protection. The U.S. legislative action could resolve company A's dilemma and present owners with options other than design patent, trademark, or copyright, none of which offer the requisite protection.

1. TRIPS – Industrial Designs

Articles 25 and 26 of TRIPS provide for protection of industrial design. Article 25(1) imposes requirements of novelty, originality and non-functionality. Article 26 grants the owner the right to prohibit others from "making, selling or importing articles bearing or embodying a design which is a copy or substantially a copy of the protected design." The duration of the protection is for a minimum of 10 years.\textsuperscript{245}

The U.S. enacted amendments to conform to TRIPS in a law passed on December 8, 1994,\textsuperscript{246} but did not include an industrial design law. The perception was that existing mechanisms would suffice to provide protection.\textsuperscript{247}

\textsuperscript{243} Brown, supra note 17, at 1387 (quoting Keene Corp. v. Paraflex Indus., 653 F.2d 822, 825 (3d Cir. 1981)).

\textsuperscript{244} If granted, protection would have to be very closely tailored to the needs of the design originator and to afford protection solely to the extent necessary to accomplish the desired policy goal.

\textsuperscript{245} Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 25–26, Apr. 15, 1994 [hereinafter TRIPS].


\textsuperscript{247} The Clinton Administration and Congress considered the need for enacting the industrial design provision and concluded that "protection currently available under U.S. patent and copyright law meets the requirements of these [TRIPS industrial design] articles." See Message from the President of the United States Transmitting the Uruguay Round Table
2. **European Union Design Directive and Regulation**

The European Union's protection of designs is contained in the Community Design Directive and the Community Design Regulation.

The Directive and Regulation collectively require novelty and individual character. "Individual character" is defined as the overall impression a design produces on the informed user that differs from the overall impression produced by other publicly available design. Registered design protection is renewable for up to 25 years; unregistered design is protected for 3 years. The registrations are administered by the Office of Harmonization of the Internal Market (OHIM), effective January of 2003.

3. **Gebrauchsmuster and Geschmacksmuster**

German law provides an interesting dual model for protection for design.

The *Gebrauchsmuster* (utility model or petty patent) covers inventions which are new, involve an inventive step and can be applied in the industry. The level of inventiveness is somewhat lower than that required for regular patent protection. The law specifically excludes processes. Registration is based on a cursory review by the German Patent Office to ensure that the invention generally meets the stated requirements. A regular patent type examination is not undertaken, unless a cancellation proceeding is

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250. Council Regulation 6/2002 on Community Designs, 2002 O.J. (L 3) 1 [hereinafter *Community Design Regulation*]. "Design" is defined as the "appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation." *Community Design Regulation* at art. 3.

251. *Id.* at art. 5-6.

252. *Id.* at art. 6.

253. *Id.* at art. 10.

254. § 1 GbmG (Gebrauchsmustergesetz).


256. Applicants may take advantage of the filing date of an earlier patent application. In the event the patent is not granted, the *Gebrauchsmuster* can still issue effective the patent filing date. § 5 GbmG.
initiated. The protection term is short (three years from the application date, renewable for an additional three-year term).\textsuperscript{257}

The *Gebrauchsmuster* is expressly designed for three dimensional movable articles, and has as its objective "to prevent third parties from duplicating the external configurations of certain handtools and other everyday implements whose creative contribution fall chronically short of the inventive height that the mature patent paradigm required."\textsuperscript{258} German companies typically use this protection method to protect the designs of such items as cars or car parts.\textsuperscript{259}

A second option for design protection under German law is the *Geschmacksmuster* (industrial design or model). It applies to articles which are new and individual (i.e. the product of individual independent creation).\textsuperscript{260} The *Geschmacksmuster* protects the aesthetic configuration of two or three dimensional articles of practical utility, whose configuration is not determined by functional criteria. Articles covered are objects of daily use, such as furniture, jewelry, textiles, electronics or the shape of machines or vehicles. Protection is granted by the German Patent Office without examination, upon simple registration and deposit.\textsuperscript{261} The initial term is 5 years, renewable for a total term of not more than 20 years.\textsuperscript{262}

4. US Design Legislation

In the US attempts to introduce design laws go back to the beginning of the twentieth century. Bills have been introduced into Congress for amendment of the Copyright Act proposing a *sui generis* law related to copyright. However the 1976 Copyright Act failed to include a design protection provision.\textsuperscript{263} In the mid and late 80's, efforts to introduce a similar provision failed again.\textsuperscript{264} Interest in the issue waned for a while, until passage of the only form of statutory

\begin{itemize}
\item \textsuperscript{257} Janis, supra note 255. See also I DONALD S. CHISUM, CHISUM ON PATENTS § 3.06[2], at 3-192 (2003).
\item \textsuperscript{258} J. H. Reichman, Electronic Information Tools—The Outer Edge of World Intellectual Property Law, 17 U. DAYTON L. REV. 797, 808 (1992).
\item \textsuperscript{259} Interview with Karl Heinz Baumann, Senior automotive designer, Daimler Chrysler AG.
\item \textsuperscript{260} § 1 GeschmMG (Geschmacksmustergesetz ). The German term “eigentuemlich” rendered here as individual, means, in literal translation “peculiar.”
\item \textsuperscript{261} Donald S. Chisum, Patents § 3.06(2), at 3-107 (1992).
\item \textsuperscript{262} § 7a. GeschmMG.
\item \textsuperscript{263} Brown, supra note 17, at 1396.
\item \textsuperscript{264} Id.
\end{itemize}
design protection in the U.S., the Vessel Hull Design Protection Act in 1998.

The Vessel Hull Design Protection Act (VHDPA), was passed as part of the Digital Millenium Copyright Act (DMCA) in reaction to the Supreme Court decision in Bonito Boats, Inc. v. Thunder Craft Boats, Inc. (although nothing in that decision prevented a vessel hull designer from obtaining copyright or trade dress protection). The VHDPA creates a sui generis industrial design law. The law provides that "the designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter". This law is premised on copyright principles and requires designs to be original and non-functional. The protection lasts for 10 years.

This law could in fact be a well tailored solution for company A's needs. It would overcome the conceptual separability and secondary meaning hurdles, it would avoid the procedural complexities of obtaining a design patent, it would include protection against copying, and it would grant protection for about the right duration. The only problem is that under this law, protection is limited to a "vessel hull, including a plug or mold." Thus, unless company A happens to be a producer of vessel hulls, it is out of luck. It has been suggested that the VHDPA could be easily expanded to cover industrial design, including automobile body and part designs, furniture designs, and clothing designs. However no progress has been made to date.

The following will briefly summarize some of the features of the statutes listed above. These features are compared to the elements of trade dress protection. Both methods of protection are viewed in light of the minimum requirements that will give a design owner a sufficient headstart in the market. The chart consists of two levels.

266. Id. at § 1201.
269. Id. at §§ 1302(1) and 1305(a).
270. Id. at §§ 1308 and 1309.
271. Id. at § 1302 (b)(2).
The first addresses the design owner's needs for protection, the second contains the elements necessary to ensure that protection granted does not become anticompetitive.

<table>
<thead>
<tr>
<th>Minimum protection for design owner</th>
<th>Design Owner's Needs</th>
<th>Trade Dress</th>
<th>Product Design Law</th>
</tr>
</thead>
<tbody>
<tr>
<td>Protection against copying</td>
<td>Protection against copying or making/using/selling</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Simple mechanism of obtaining rights</td>
<td>Registration subject to proof of secondary meaning. Unregistered rights possible.</td>
<td>Registration/deposit without examination. Unregistered rights possible.</td>
<td></td>
</tr>
</tbody>
</table>

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<thead>
<tr>
<th>Limitations on protection</th>
<th>Non-functionality</th>
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<th>Non-functionality</th>
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<tbody>
<tr>
<td>Aesthetic qualities that merit protection</td>
<td>Ability to indicate source</td>
<td>Novelty, individual character</td>
<td></td>
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<tr>
<td>Limited duration</td>
<td>Indefinite duration</td>
<td>3-25 years</td>
<td></td>
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<tr>
<td>Notice to third parties (central registry)</td>
<td>USPTO – only if registered</td>
<td>Patent Office, Copyright Office. If unregistered, term is extremely short</td>
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The areas of clash between trade dress and design protection are in the nature of the protection afforded, the registration mechanism, the aesthetic qualities required and the duration. In each of these categories specialized product design laws offer a better solution. A more detailed analysis of the existing industrial design protection laws is beyond the scope of this paper. However, even a brief look at the type of tool these industrial design laws offer, makes it clear that adoption of such a law would avoid the threats to innovation and competition inherent in the current system.
THE "STICK" OF PERPETUAL MONOPOLIES

So far we have created monopolies for Superman dolls, Tarkay posters, the Tarzan trademark and removed them from the public domain for the foreseeable future, if not forever. Moreover, the door is wide open to the creation of many more such monopolies. Plaintiffs are encouraged to seek "trade dress protection for an entire product line by establishing that the ‘overall look’ in each separate product is consistent." They are encouraged to appropriate an artist’s visual style, and trademark their musical performances.

The “type of look” has created a doctrine which may have potentially uncontrollable ramifications for the industrial design market. Design of leather luggage, children’s clothes and the like has been monopolized. Romm Art granted a hybrid protection that created exclusive property in artistic style. It transcends the well thought out and balanced policy rationales of the established doctrines and is immune to their limitations. The EMI–Oliveira line of cases is on its way to establish similar inroads in the area of music.

Inroads of this type of protection into the cultural arena are particularly disturbing. If perpetual protection under trademark were

273. In re DC Comics, Inc., 689 F.2d 1042 (C.C.P.A. 1982) (granting registration of drawings of Superman and Batman as trademarks for dolls representing these figures). See Brown, supra note 17, at 1370 ("[T]he function of a Superman doll is to be a Superman doll.") Allowing protection is "tantamount to saying the figures are trademarks of themselves .... What the court has done in DC Comics, since trademarks can last forever, is to safeguard Superman from ever facing the rough-and-tumble of the public domain, which might undo even Superman").


276. Yurman Design, 262 F.3d at 116. Plaintiff “must articulate the design elements that compose the trade dress ... the level of generality at which a trade dress is described as well as the fact that a similar trade dress is already being used by manufacturers of other kinds of products, may indicate that the dress is no more than a concept or idea to be applied to particular products.” The court goes on to say that it would not have been able to decide whether Milstein trade dress is generic, without specific description of elements protected. See Jeffrey Milstein v. Greger, Lawlor, Roth 58 F 3d 27 (2nd Cir. 1995).

277. MCCARTHY, supra note 48 at § 8.01[4] n.22 ("artistic style is no one’s exclusive property"). See also Leigh v. Time Warner Entertainment Co., 10 F. Supp. 2d 1371, 1382 (S.D. Ga. 1998) ("Under copyright law, plaintiff is not entitled to protection of his idea (the use of a forlorn cemetery statue to represent final judgment) ... an expansive application of the principles of trademark law as in Romm Art would allow plaintiff the very protection denied him under copyright law").

278. See Denicola, supra note 7, at 1670 (protection of industrial design, unless kept firmly tied to source recognition as a trademark, easily slides into an unpredictable system of monopoly awards for successful designs, uninhibited by the statutory standards of copyright law or design patent law") See also Jeffrey Milstein v. Greger, Lawlor, Roth, 58 F.3d 27, 32 (2d Cir. 1995).
to extend to visual arts and musical compositions, the public domain would be seriously diminished. The public domain consists of material added on by each generation, for subsequent generations to draw upon, just as our society draws upon art ranging from Michelangelo to the impressionists, and music from Bach to Stravinsky. If “style” becomes property, anyone painting in Jackson Pollock’s “drip and splat” style would be infringing a perpetually protected trade dress. Well known popular songs by composers and performers such as Gershwin, Elvis, the Beatles, etc. would never pass into the public domain. In a generation or two the public domain would be depleted of creations which represent our times.

CONCLUSION

Efforts to “squeeze” new forms of IP into old protection mechanisms lead to results that upset the delicate balance between free competition and protection that underlies our IP laws. The anomalous results obtained in the area of protection of “type of look” of product design under a trade dress doctrine may be a temporary maladjustment in the constant rebalancing that is part of creating IP protection. However, it may herald a new era of protectionism, of liberal grants of rights at the expense of free competition. It is time to look for alternatives which better meet the needs of product design than does current trade dress law.279

279. Among the alternatives to be considered are the industrial design laws passed in various countries, including the United States Vehicle Hull Design Protection Act. Its expansion to products other than vessel hulls would be an “easy fix” for an acute problem.