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FEDERAL PREEMPTION OF A FEDERAL STATUTE: THE CASE OF VORNADO AIR CIRCULATION SYSTEMS V. DURACRAFT CORPORATION

I. INTRODUCTION

The Supremacy Clause of the United States Constitution states that:

This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.¹

Nowhere in the Constitution is it written that one federal statute can preempt another federal statute. Such a proposition is absurd considering two underlying assumptions regarding such statutes and their enactment. First, is the assumption that there is no inherent hierarchy of importance among federal statutes. Second, is the assumption that Congress does not intentionally pass conflicting laws.

The Tenth Circuit, in Vornado Air Circulation Systems v. Duracraft Corp.,² however, has implied through its holding, that not only can there be a hierarchy among federal statutes, but that one federal statute may preempt another federal statute. In Vornado, the Tenth Circuit held that a product configuration which may be protected under the Lanham Act³ as a trade dress⁴ will be prevented from attaining fed-

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¹. U.S. Const. art. IV, cl. 2.
². 58 F.3d 1498 (10th Cir. 1995). Throughout the comment, I will refer to this court as the "Vornado court," "appellate court," and the "Tenth Circuit" interchangeably.
⁴. See infra notes 51-55 and accompanying text.
eral trademark protection by patent law, where the product is a significant inventive aspect of a utility patented invention.\(^5\)

This comment begins by defining and laying out the general distinctions between patent and federal trademark law.\(^6\) Next, the inherent flaws behind the appellate court's rationale in reaching its conclusion will be analyzed.\(^7\) The comment then proposes that just as the Patent Act\(^8\) can take something out of the public domain, the Lanham Act also equally has this right.\(^9\) This comment also proposes that in reviewing cases which contain both patent and trademark issues, courts should disregard any relationship or overlapping concerns and conflicts shared by the two federal statutes and consider each patent or trademark issue separately.\(^10\) Finally, this comment addresses the dangers of allowing a hierarchy among federal statutes to develop, not only to the legal community, but also to the public at large.\(^11\)

II. BACKGROUND

A. Patent Law

The United States patent laws provide a federal statutory basis for protecting certain types of inventions for a limited period of time.\(^12\) The federal power to grant patent rights arises from the U.S. Constitution, article I, section 8, clause 8, which authorizes Congress "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."\(^13\) The type of protection given to

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5. *Vornado*, 58 F.3d at 1510. The *Vornado* court held that: [W]here a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention, [citation] so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional. Id.

6. See infra part II.

7. See infra part III.


9. See infra part IV.

10. See infra part V.

11. See infra part V.


an inventor of a patentable product is the "right to exclude others from making, using, or selling the invention throughout the United States," for the limited period of time prescribed. In exchange for this protection, the inventor is required to fully disclose a description of the invention in the patent application, as set forth in 35 U.S.C. section 112. An inventor seeking the protections afforded from a patent on an invention must also meet further requirements, depending on the type of patent the inventor seeks to obtain.

The United States Patent and Trademark Office identifies two main types of patents, utility patents and design patents. Utility patents generally regulate the functional features of inventions, whereas design patents "embrace the visual characteristics displayed by an object and relate to configuration, shape or surface ornamentation." An invention will be entitled to a utility patent if it falls within the boundaries of 35 U.S.C. section 101, as well as meeting the requirements of utility, novelty and nonobviousness. An invention will be entitled to a design patent if the design is

15. See supra note 12 (noting the length of patent protection).
17. 35 U.S.C. § 112 (1988). Section 112 of the patent statute states in pertinent part:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Id.
18. See infra notes 19-28 and accompanying text.
20. "In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." Inwood Lab. v. Ives Lab., 456 U.S. 844, 850 n.10 (1982). See also discussion infra part II.D.
23. 35 U.S.C. § 101 (1988). The section provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Id.
24. See id.
new, original and ornamental. A design which is primarily functional as opposed to ornamental, can never be the subject of a design patent.

One of the principal goals of patent law is to encourage and reward inventors, by promoting the disclosure of their inventions in order to stimulate further innovation. In order to further this goal, the framers of the United States Constitution wanted to adopt a balance between free competition and limited government-sponsored monopolies. Thomas Jefferson at first opposed all forms of government-sponsored monopolies, arguing that "an individual has no natural right to an idea or invention," but he eventually realized the social utility in rewarding inventors for their labors through such monopolies. James Madison also believed that invention was encouraged through the reward of government-sponsored monopolies. Unlike Jefferson, Madison argued that an individual did have natural rights in inventions and ideas. According to Madison, "the right to useful inventions . . . belong[s] to the inventors. The public good fully coincides . . . with the claims of individuals." Thus, the disclosure of ideas required under patent law serves the purpose of increasing and rewarding technological innovation.

B. Federal Trademark Law: The Lanham Act

Unlike patent law, which finds specific authority in the Constitution, authority for the federal protection of trade-

28. See Payne Metal Enterprises, Ltd. v. McPhee, 382 F.2d 541, 546 (9th Cir. 1967) (holding a design patent invalid because it described a device which was determined to be functional). See also Epstein, supra note 12, at 5-24.
31. Id.
34. See Dowell, supra note 30, at 150 (discussing Madison's support for government sponsored monopolies).
36. U.S. Const. art. I, § 8, cl. 8. See also supra text accompanying note 1.
marks is indirectly taken from the "Commerce Clause."\textsuperscript{37} While one basic source of trademark protection is derived from state common and statutory law,\textsuperscript{38} the Lanham Act\textsuperscript{39} "provides a system of federal registration for trademark rights and for the administration of the system by the Patent and Trademark Office"\textsuperscript{40} (hereinafter "P.T.O."). In order to gain the protections of the Lanham Act, a product must be inherently distinctive, nonfunctional and not likely to cause customer confusion as to the source of the product.\textsuperscript{41} In return, owners of a trademark are given "the right to use a particular mark and the right to exclude others from using the same or similar mark in a manner that is likely to cause confusion in the marketplace."\textsuperscript{42}

Under common law, trademark rights may be acquired if one first uses the mark in trade in a way that allows the consumer to rely on it for its ultimate purpose.\textsuperscript{43} No registration or other administrative process is necessary to acquire ownership rights.\textsuperscript{44} Federal law, however, provides that trademarks may be registered on the Lanham Act Principal Register.\textsuperscript{45} Prior to registration on the Lanham Act Principal Register, the owner of the mark must file an application with the P.T.O. based on either existing ownership of the mark\textsuperscript{46} or on the intent to use the mark in trade and interstate commerce, as well as meet various other requirements set forth in 15 U.S.C. section 1051.\textsuperscript{47} Registration under the Lanham Act provides additional rights and remedies beyond those

\begin{thebibliography}{9}
\bibitem{37} The Commerce Clause states that Congress shall have the power "to regulate Commerce with foreign Nations, and among several States." U.S. Const. art. I, § 8, cl. 3.
\bibitem{38} EPSTEIN, \textit{supra} note 12, at 7-8.
\bibitem{40} EPSTEIN, \textit{supra} note 12, at 7-8.
\bibitem{42} EPSTEIN, \textit{supra} note 12, at 7-30; see also Homeowners Group Inc. v. Home Marketing Specialists, Inc., 931 F.2d 1100 (6th Cir. 1991).
\bibitem{43} See generally PAUL GOLDSTEIN, \textit{COPYRIGHT, PATENT, TRADEMARK AND RELATED DOCTRINES}, at 203-05 (revised 3d ed. 1993) (discussing requirements for trademark protection).
\bibitem{44} \textit{Id.}
\bibitem{45} 15 U.S.C. § 1051(a), (b) (1988)
\end{thebibliography}
available under the common law. Among the benefits of federal registration under the Lanham Act are "nationwide protection of trademarks, access to the federal courts, and constructive notice of trademark protection."

Furthermore, the Lanham Act not only provides protection for federally registered marks under section 1114, but it also provides protection for unregistered marks, as well as the trade dress of a product under section 1125 (hereinafter "section 43(a)"). The trade dress of a product includes the product's overall image or appearance. A trade dress will only be protected if it is distinctive, not likely to cause cus-

52. The scope of trade dress has been described as "the overall image used to present it to purchasers; it could thus include, to give a partial list, the product's size, shape, color, graphics, packaging, and label." Vaughan Mfg. Co., 814 F.2d at 348; see also Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1042 (2d Cir. 1992) (although individual aspects of trade dress may be protected under trademark law in their own right, the entire look of a product should be the focus in examining a trade dress).
53. See Taco Cabana Int'l, Inc. v. Two Pesos, 932 F.2d 1113, 1120 (5th Cir. 1991) (jury instructions explained that "[d]istinctiveness is a term used to indicate that a trade dress serves as a symbol of origin"). See also Restatement (Third) of Unfair Competition § 13, cmt. a (1993) ("a designation is distinctive only if it functions as a symbol of identification"). See generally Jamison Dean Newberg, The Same Old Enchilada? The Supreme Court Simplifies the Protection of Inherently Distinctive Trade Dress in Two Pesos v. Taco Cabana, 13 Rev. Litig. 299, 312-13 (1994) ("Distinctiveness can be established in two ways: by proving that the trade dress is inherently distinctive or by showing that it has acquired secondary meaning."). "Secondary meaning exists when in addition to their literal, or dictionary, meaning, words connote to the public a product from a unique source." Goldstein, supra note 12, at 60 (quoting Charcoal Steak House of Charlotte, Inc. v. Staley, 139 S.E.2d 185 (Va. Sup. Ct. 1964)).
customer confusion regarding the product's source, and nonfunctional. Unlike patent law, which is designed to reward and promote inventions through disclosure of ideas in the marketplace in exchange for a limited monopoly, federal trademark law focuses on preventing customers from being "confused, misled, or deceived as to whose product they are buying." Trademarks "foster competition and the maintenance of quality by securing to the producer the benefits of a good reputation." Trademark law thus benefits both the consumer and manufacturer of a product. Consumers are able to rely on trademarks to distinguish between competing products as well as be assured of a certain level of quality in their purchase. Manufacturers enjoy the right to "control the quality of the goods manufactured and sold under the trademark."

C. Cases Discussing Patent and Federal Trademark Law as Providing Distinct and Separate Forms of Protection

Several courts have held that generally, patents and trademarks provide separate and different forms of protection and the absence or presence of one should not automatically preclude protection under another. In In Re Mogen

54. See 15 U.S.C. § 1125(a) (1988) ("Any person who . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof . . . which - (A) is likely to cause confusion . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such an act."). See also Vornado Air Circulation Sys. v. Duracraft Corp., 58 F.3d 1498, 1503 (10th Cir. 1995) ("plaintiff must show that potential customers are likely to be confused by the defendant's trade dress into thinking that the defendant is affiliated, connected or associated with the plaintiff or that the defendant's goods originated with, or are sponsored or approved by the plaintiff").

55. A product must be nonfunctional if it is to be eligible for trade dress protection. See Restatement (Third) of Unfair Competition § 13, cmt. d (1993).

56. Vornado, 58 F.3d at 1508.


59. Patents provide incentives to creators of useful or ornamental inventions via the limited monopoly. See supra part II.A. Trademarks protect consumers from confusion as to the source of a given product or service. See supra part II.B.

60. Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir. 1975), cert. denied, 429 U.S. 861 (1976). See also In re Mogen David Wine Corp.,
David Wine Corp., the Court of Customs and Patent Appeals held that the existence of a design patent for the Mogen David Wine Bottle did not preclude the right to register the bottle shape as a trademark for the wine on the Lanham Act Principal Register. One of the rationales behind the court’s conclusion is based on the premise that:

The underlying purpose and the essence of patent rights are separate and distinct from those appertaining to trademarks. No right accruing from the one is dependent upon or conditioned by any right concomitant to the other. The longevity of the exclusivity of one is limited by law while the other may be extended in perpetuity.

Therefore, patent and trademark protection may coexist within a single product because each provides separate and distinct forms of protection.

In Rolls-Royce Motors Limited v. A & A Fiberglass Incorporated, the deciding court held that patent and trademark protection may coexist in a single product because they provide separate and distinct forms of protection. In Rolls-Royce, plaintiff, Rolls-Royce Motors, Ltd., contended that the defendant’s parts for radiator grill modification and hood ornamentation, included in their automobile customizing kits, were copies of similar parts installed on Rolls-Royce cars. The defendant argued that “to the extent that these parts are functional, protection can be found only in the patent laws and that, to the extent that they are nonfunctional, copyright is the only safeguard.” Furthermore, the defendant insisted that “if these two parts are not functional, they are merely ornamental and could be covered only by copyright or a design patent.” The court, however, held that:


61. 328 F.2d 925 (C.C.P.A. 1964).
62. See supra text accompanying note 45.
63. Mogen David Wine Corp., 328 F.2d at 929.
64. The proposition that patent and trademark protection may coexist within a single product is only applicable if the patent in question is a design patent. See discussion infra part II.C. Utility patents may not be accorded trademark protection based on the presumption that products with utility patents are functional. See discussion infra part II.D.
66. Id. at 690.
67. Id. at 692.
68. Id.
There is no doubt that the plaintiff's Classic Grill and Flying Lady are attractive objects. As such, they may be deserving of copyright or design patent protection. Their entitlement to trademark recognition, however, depends not on their eye appeal but on their characteristic of identifying the manufacturer of Rolls-Royce motor cars.

The court thus held that patent and trademark protection are separate and distinct fields capable of coexistence and Rolls-Royce was granted relief because the defendant's product caused public confusion as to sponsorship of its kits.

Lastly, in Truck Equipment Service Company v. Fruehauf Corporation, the Eighth Circuit also noted that patent and trademark law were distinctive fields. In Fruehauf, the sole issue before the court was whether Fruehauf's actions constituted unfair competition under section 43(a) of the Lanham Act. The appellate court held that the defendant's acts of using photographs of plaintiff's trailers in its sales literature and copying the exterior design of plaintiff's Cornhusker 800 in the manufacture of its own twin hopper bottomed grain semi-trailer, constituted unfair competition under section 43(a) of the Lanham Act. The court further noted that:

The protection accorded by the law of trademark and unfair competition is greater than that accorded by the law of patents because each is directed at a different purpose. The latter protects inventive activity which, after a term of years, is dedicated to the public domain. The former protects commercial activity which, in our society, is essentially private.

Therefore, the Fruehauf court also recognized the inherent distinctions between patents and trademarks by focusing on the different types of protections each provide.

69. Id. at 692-93.
71. 536 F.2d 1210 (8th Cir. 1975), cert. denied 429 U.S. 861 (1976).
72. Id. at 1213.
73. Id. at 1213. See also 15 U.S.C. § 1125 (1988).
74. Truck Equip. Serv. Co., 536 F.2d at 1215.
D. Functionality Doctrine Solves Any Conflicts Between Patent and Trademark Law

Any feature which serves a utilitarian purpose and affords benefits not practically available through alternative designs is functional. The functionality doctrine prevents any conflict between trademark and utility patent law because it denies trademark protection to functional designs. Functional qualities of a product are not allowed trademark protection for two reasons. First, the underlying purpose of trademark law prevents functional features from being protected. A trademark is used "to identify the source of its associated product or service to the public" and because of the "assumption that functional features do not, and cannot perform this role, and that only arbitrary, non-functional symbols can designate the producer," trademark protection may not be given. Second, and more importantly, denying trademark protection to functional features protects the integrity of utility patents because it prevents manufacturers from avoiding the stringent requirements for utility patent protection by claiming functional aspects of their products as trademarks.


76. Inwood Labs. v. Ives Labs, Inc., 456 U.S. 844, 850 (1982) ("In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."). See also Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176, 1189 (7th Cir. 1989) ("A feature is functional if it is one that is costly to design around or do without, rather than one that is costly to have.").

77. See McCarthy, supra note 19, at 236 ("If there is to be legal protection for functional features, such protection can only be gained by utility patent protection limited in time, not perpetual protection under trademark law.").


79. Id.

80. Id.

81. See supra text accompanying notes 16-18, 23-26.

82. Bauer, supra note 78, at 717.
The requirement of non-functionality as a preclusion to trademark protection is not statutory. Rather, the requirement of non-functionality is a judicial creation to further the public policy of reconciling trademark and utility patent law.\(^8\) The Third Circuit has ruled against trademark protection of functional features to prevent conflicts with patent law.\(^9\) In \textit{Sylvania Electric Products Inc. v. Dura Electric Lamp Company},\(^5\) the court held that trademark protection is not granted to functional features in order "to prevent the grant of a perpetual monopoly by the issuance of a trademark in the situation where a patent has either expired, or for one reason or another, cannot be granted."\(^8\) Similarly, in \textit{Keene Corporation v. Paraflex Industries},\(^7\) the Third Circuit held that:

The purpose of the rule precluding trademark significance [for functional features] is to prevent the grant of a perpetual monopoly to features which cannot be patented . . . . Products or features which have not qualified for patent protection but which are functional are in the public domain and, are fair game for imitation and copying.\(^8\)

Several other circuits have held that conflicts between the Patent Act and the Lanham Act are eliminated by the functionality doctrine.\(^8\)

The Court of Customs and Patent Appeals has also restricted registration of functional features as trademarks. In \textit{Best Lock Corporation v. Schlage Lock Company},\(^9\) the court stated that "[t]he reason is clear. If a configuration is functional ... then everyone has the right to use the configuration for its functional purpose, subject only to such exclusive right

\(^{83}\) \textit{Id.} at 737 ("Thus the rationale behind the public policy requirement of non-functionality is the need to accommodate trademark and unfair competition law with functional patent law.").

\(^{84}\) \textit{See} \textit{Sylvania Elec. Prods., Inc. v. Dura Electric Lamp Co.}, 247 F.2d 730 (3d Cir. 1957); \textit{Keene Corp. v. Paraflex Indus., Inc.}, 653 F.2d 822, 824 (3d Cir. 1981); \textit{Best Lock Corp. v. Schlage Lock Co.}, 413 F.2d 1195 (C.C.P.A. 1969).

\(^{85}\) \textit{Sylvania Elec. Prods., Inc.}, 247 F.2d at 730.

\(^{86}\) \textit{Id.} at 732.

\(^{87}\) \textit{Keene Corp.}, 653 F.2d at 824.

\(^{88}\) \textit{Id.}

\(^{89}\) \textit{See, e.g.}, \textit{Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.}, 626 F.2d 193 (2d Cir. 1981); \textit{Int'l Order of Job's Daughters v. Lindeburg & Co.} 633 F.2d 912 (9th Cir. 1952); \textit{Keebler Co. v. Rovira Biscuit Corp.}, 624 F.2d 366 (1st Cir. 1980).

\(^{90}\) 413 F.2d 1195 (1969).
for a limited time as may exist under the patent laws." In *In re Deister Concentrator Co.*, the court noted that "[a] feature dictated solely by 'functional' (utilitarian) considerations may not be protected as a trademark."

The functionality doctrine not only prevents conflicts between trademark and patent law, but it also furthers a common goal addressed by both areas of the law — to foster competition. The doctrine promotes competition by allowing competitors to copy even distinctive features of a product which indicate the product's source. Therefore, as stated by the Court of Customs and Patent Appeals Court in *Deister*, "[a] certain amount of customer confusion may even be tolerated in order to give the public the advantages of free competition."

E. **The Main Case:** Vornado Air Circulation Systems, Inc. v. Duracraft Corporation

1. **The Facts**

The plaintiff, Vornado Air Circulation Systems (hereinafter "Vornado") in *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, started to sell its fans with spiral grills in November 1988. On January 9, 1989, Vornado applied for a utility patent on itsducted fan with a spiral grill, claiming that "their spiral grill produced an optimum air flow, although their own tests had shown that it performed about the same as the more common straight radial grill, and later tests suggested that some other grills worked better in some respects." On May 22, 1990, Vornado was issued a utility patent on the ducted fan. The spiral fan grill by itself was not patentable because "a spiral grill per se was already in

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91. *McCARTHY,* *supra* note 19, at 236 (quoting *Best Lock Corp.*, 413 F.2d at 1195). *See also* Dratler, *supra* note 75, at 945 ("Although originally and primarily intended to protect the integrity of utility patent law . . . . The [functionality] doctrine has assumed a related but much broader purpose: protecting competition in general.").
93. *See* *McCARTHY,* *supra* note 19, at 237-38.
95. *In re Deister Concentrator Co.*, 289 F.2d at 496.
96. 58 F.3d 1498 (10th Cir. 1995).
97. *Id.*
98. *Id.* at 1500.
99. *Id.*
100. *Id.*
the public domain as 'prior art,' a patent law term for what was already known from previous patents or other sources.”

Vornado sold approximately 135,000 fans between January 1989 and August 1990.

Duracraft Corporation (hereinafter “Duracraft”), in August 1990, began selling an inexpensive electric household fan called the Model DT-7 “Turbo Fan.” Duracraft’s Turbo Fan copied Vornado’s more expensive fan models by incorporating in their fans the spiral vane structure grill. Duracraft’s Turbo fan however, was purposefully designed not to infringe Vornado’s patent. Nearly one million Turbo Fans were sold in the United States by November 1992, making the Turbo Fan Duracraft’s second largest selling household fan product.

Vornado sued Duracraft for intentionally copying its grill design. Vornado argued that because the curved vanes in their fans were legally nonfunctional, it was protected as a trade dress under section 43(a) of the Lanham Act. Both Vornado and Duracraft agree that the Turbo Fan did not infringe Vornado’s patents.

The district court granted Vornado an injunction but no damages on its section 43(a) claim. The court found that Vornado’s grill design was inherently distinctive, nonfunctional and that “consumers were likely to be confused by Duracraft’s use of a similar grill.” The court also held that trade dress protection of nonfunctional product configurations under the Lanham Act did not conflict with patent law. Duracraft appealed to the Tenth Circuit, contending that the district court committed legal error on several issues.

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101. Vornado, 58 F.3d at 1500.
102. Id.
103. Id.
104. Id. at 1501.
105. Id.
106. Vornado, 58 F.3d at 1501.
107. Id.
108. Id.
109. Id.
110. Id. at 1502.
111. Vornado, 58 F.3d at 1502.
112. Id. at 1501-02.
113. Id. at 1502.
sue of whether Vornado's trade dress claim was barred by federal patent law.\textsuperscript{114}

2. \textit{Majority Opinion}

On appeal, the appellate court held that:

Where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention, so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional.\textsuperscript{115}

Furthermore, the appellate court held that “although a product configuration must be nonfunctional in order to be protected as a trade dress under section 43(a),\textsuperscript{116} not every non-functional configuration is eligible for that protection.”\textsuperscript{117}

In reaching its conclusion, the appellate court first discussed several Supreme Court cases which were interpreted to collectively manifest a “clear and continuing trend . . . in favor of the public's right to copy.”\textsuperscript{118} Among the Supreme Court Cases discussed was \textit{Kellogg Co. v. National Biscuit Co.}\textsuperscript{119} According to the \textit{Vornado} appellate court, the Kellogg Company in \textit{Kellogg} was allowed to copy National Biscuit Company's pillow-shaped, shredded wheat cereal because the invalidation of National Biscuit Company's design patent on the cereal shape and expiration of its utility patents for the machines to make the cereal shapes, created a public right to copy the product.\textsuperscript{120} The appellate court in \textit{Vornado} interpreted the holding in \textit{Singer Manufacturing Co. v. June Manufacturing Co.}\textsuperscript{121} in a similar manner.\textsuperscript{122} According to the appellate court, the court in \textit{Singer} allowed the defendant to

\begin{itemize}
  \item \textsuperscript{114} \textit{Id.}
  \item \textsuperscript{115} \textit{Id.} at 1510.
  \item \textsuperscript{117} \textit{Vornado Air Circulation Sys. v. Duracraft Corp.}, 58 F.3d 1498, 1500 (10th Cir. 1995).
  \item \textsuperscript{118} \textit{Id.} at 1505.
  \item \textsuperscript{119} 305 U.S. 111 (1938).
  \item \textsuperscript{120} \textit{See id} at 114; \textit{see also Vornado}, 58 F.3d at 1504.
  \item \textsuperscript{121} 163 U.S. 169 (1896).
  \item \textsuperscript{122} \textit{Vornado}, 58 F.3d at 1504. The appellate court, in its presentation of the holdings in the \textit{Kellogg} and \textit{Singer} cases, implies that the invalidation and expiration of patents creates a right to copy the products which were patented.
\end{itemize}
copy Singer sewing machines because the expiration of their patents created a public right to copy that product. 123

The appellate court then presented Supreme Court cases which discussed the federal preemption of state statutes 124 in support of its conclusion that the right to copy must prevail when there is conflict between patent and trademark law. 125 Among the cases presented was Sears, Roebuck & Co. v. Stiffel Co. 126 In Sears, Stiffel Company's design and mechanical patents covering the design and operation of a pole lamp were invalidated. 127 The district court and the Seventh Circuit both held that, under Illinois common law, the copying of Stiffel's pole lamp by Sears constituted unfair competition because it was likely to cause customer confusion as to source. 128 The Supreme Court reversed, holding that a state had no power to extend the life of a federal patent beyond its expiration date or give protection to products that do not qualify for federal patent protection. 129

In Compco Corp. v. Day-Brite Lighting, Inc., 130 Day-Brite Lighting Company's design patent on a fluorescent light fixture reflector with crossribs was held invalid. 131 Compco Company was enjoined by the lower courts from making and selling reflectors with a similar appearance to Day-Bright Lighting Company's fluorescent light fixture, based on Illinois unfair competition law. 132 The Supreme Court reversed, holding that although the reflector was nonfunctional, had acquired secondary meaning, and was likely to cause customer confusion as to source; no injunction against copying

123. See id.
125. Vornado, 58 F.3d at 1504 ("When asked to balance the concerns of patent law against those of unfair competition law with respect to the copying of product shapes, the Supreme Court has ruled repeatedly over the years that the right to copy must prevail.").
126. Sears, 376 U.S. at 225.
127. Id.
128. Id.
129. Id. at 231 ("Just as a state cannot encroach upon federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws.").
131. Id.
132. Id.
may be granted as a result of potential policy conflicts with patent law.133

The appellate court interpreted the holdings in Sears and Compco as the Supreme Court once again holding "that patent law's public domain concept must prevail over unfair competition concerns about consumer confusion where those concerns arose solely from the product copying."134 The same conclusion was also reached in the case of Bonito Boats Inc. v. Thunder Craft.135 In Bonito Boats, a Florida statute prohibiting the copying of boat hull designs by the direct molding process, was held to be preempted by the patent laws.136 The Bonito Boats court thus reaffirmed the central holding of Sears/Compco, that "the efficient operation of the federal patent system depends upon substantially free trade in publicly known, unpatented design and utilitarian conceptions."137

To add credence to its conclusion that patent law prevents trade dress protection for a product configuration that is part of a utility patent claim,138 the appellate court dismissed the well established assumption that the functionality doctrine eliminated any possible conflicts between the Lanham Act and the Patent Act.139 To support the court's conclusion that the functionality doctrine was ineffective in solving the conflicts between the Patent and Lanham Act, the appellate court noted that "[d]espite what appears to be a widespread perception that product configurations covered by utility patents are automatically functional for Lanham Act purposes, the district court in our case ably demonstrated that this is not so."140 The Vornado court then proceeded to define functionality "in terms of competitive need."141 Furthermore, the Vornado court concluded that "core patent

133. Id.
136. Id.
137. Id. at 156.
138. See Vornado, 58 F.3d at 1510.
139. Id. at 1506 (listing cases that have supported that a nonfunctionality requirement would eliminate any possible conflicts between the Lanham Act and the Patent Act, and explaining how the district court's holding proved these cases to be erroneous). See discussion infra parts II.D, III.C.
140. Id. at 1506.
141. Id. at 1507.
principles will be significantly undermined if we do not allow the copying in question, and peripheral Lanham Act protections will be denied if we do."

In order to support its holding that "although a product configuration must be nonfunctional in order to be protected as trade dress under section 43(a)," not every nonfunctional configuration is eligible for that protection," the appellate court criticized the emphasis placed by the district court on the Senate report accompanying the bill to expand section 43(a) in 1988. The appellate court concluded that the district court "read too much into this report" and thus this court "cannot conclude that because at the time of the report, certain nonfunctional configurations of goods' had received trade dress protection, Congress was saying that in the future, all such configurations should."

III. Analysis

A. Vornado Court Erroneously Interpreted Cited Supreme Court Cases

1. Expiration of Patents Do Not Create a Public Right to Copy

The appellate court's discussion of the Supreme Court cases of Kellogg and Singer erroneously implies that the expiration of patent protection creates a public right to copy. As one commentator has observed, "[s]ome judicial opinions and legal writers have misconstrued the law by stating that when patent rights expire, the mark of the patented article will automatically fall into the public domain along with the invention of the patent. However, this is not the law, and never has been." Furthermore, it has been stated as early as 1916 that "[t]here is no presumption of law, without proof

142. Id. at 1509.
144. Vornado Air Circulation Sys. v. Duracraft Corp., 58 F.3d 1498, 1500 (10th Cir. 1995).
145. Id. at 1506.
146. Id.
147. See supra text accompanying notes 118-23. See also Mine Safety Appliances Co. v. Electric Storage Battery Co., 405 F.2d 901, 902 n.2 (C.C.P.A. 1969) ("Patent laws function only to keep things out of the public domain temporarily. They have nothing to do with putting things into it. They say nothing about right to copy or right to use, they speak only in terms of right to exclude.").
148. See McCARTHY, supra note 19, at 568.
of the fact . . . that a name used on a patented article passes
to the public domain."\textsuperscript{149}

In reality, both the \textit{Kellogg} and \textit{Singer} courts denied
common law unfair competition protection\textsuperscript{150} not because the
expiration of a patent created a public right to copy, but
rather because the products in question did not qualify for
such protection. A product becoming generic\textsuperscript{151} and thus in-
capable of both common law and trademark protection,\textsuperscript{152} is
in no way related to the expiration of a patent. As one com-
mentator noted, "[t]he fact that legal challenges usually arise
after the patents have expired, has misled some courts into
thinking that there is some causal relationship between pat-
ent expiration and the generic use of the alleged mark."\textsuperscript{153}
Rather, a product may have become generic during the life of
the patent and not as a result of patent expiration, as was the
case in \textit{Kellogg}.\textsuperscript{154} In \textit{Kellogg}, Justice Brandeis stated that:

Since during the life of the patents 'Shredded Wheat' was
the general designation of the patented product, there
passed to the public upon expiration of the patent, not
only the right to make the article as it was made during

\textsuperscript{149}\hspace{1em} \textit{Id.} at 569 (quoting President Suspender Co. v. MacWilliam, 238 F. 159
(2d Cir. 1914), cert. denied, 243 U.S. 636 (1916)).

\textsuperscript{150}\hspace{1em} Requirements for protection under common law unfair competition and
federal trademark law are similar. Both require that the product at issue be
nonfunctional, distinctive and not likely to cause customer confusion as to the
source of a product. \textit{See}, e.g., SK&F, Co. v. Premo Pharmaceutical Labs., 625
F.2d 1055, 1065 (3d Cir. 1980) (noting that § 43(a) of the Lanham Act is similar
to the New Jersey law of unfair competition); \textit{Park’N Fly}, 469 U.S. 189, 198
(1985) ("The protection of trademarks and trade dress under 43(a) serves the
statutory purpose of preventing deception and unfair competition."); \textit{cf.}
Melissa R. Gleiberman, Note: \textit{From Fast Cars to Fast Food: Overbroad Protection of
Product Trade Dress Under Section 43(a) of the Lanham Act}, \textit{45 STAN. L. REV.}
2037, 2061 (1993) ("It is important to remember that while section 43(a) is
found within the Lanham Act, it is still an unfair competition law.").

\textsuperscript{151}\hspace{1em} A generic designation is a term that denominates a general type or class
of goods, services, or businesses. \textit{See RESTATEMENT (THIRD) OF UNFAIR
COMPETITION § 14 cmt. a (1995).}

\textsuperscript{152}\hspace{1em} Generic designations are not subject to appropriation as trademarks at
common law and are ineligible for registration under federal and state trade-
mark registration statutes. \textit{Id. See also Park ’N Fly}, 469 U.S. at 194 (noting
that generic marks which are or have become the common descriptive name of
the product to which they refer, are never registrable as trademarks).

\textsuperscript{153}\hspace{1em} \textit{McCarthey, supra} note 19, at 570. \textit{See also King-Seeley Thermos Co. v.
Aladdin Indus., 321 F.2d 577, 579 (2d Cir. 1963) (noting that plaintiff's mark
"Thermos" was no longer protected because it had become a generic name for
vacuum-insulated bottles).

\textsuperscript{154}\hspace{1em} \textit{McCarthey, supra} note 19, at 571.
the patent period, but also the right to apply thereto the name by which it had become known.155

Therefore, phrases such as "'Shredded Wheat' was the general designation of the patented product"156 and "the right to apply thereto the name by which it had become known,"157 both indicate that the product had already become generic during the life of the patent, and thus passed to the public domain void of its distinctiveness. As one commentator noted:

Thus "Shredded Wheat" had already become generic before the patent ever expired. It is respectfully submitted that Justice Brandeis confused cause and effect. Upon expiration of patent rights, anyone was free to make biscuits in that shape and with that machinery. But the right to use the name "shredded wheat" had already passed into the public domain because of public usage even before anyone else could make this shape of biscuit. It was merely because no one else could make this kind of biscuit during the patent period that no other seller had need to use "shredded wheat" as a generic term.158

Therefore, in Kellogg, protection under common law unfair competition was not granted because the expiration of a patent created a public right to copy. Rather, protection under common law unfair competition was not granted because the product did not qualify for unfair competition protection since it had become generic during the life of the patent.

Singer was another case cited by the Vornado court which supports the proposition that a name does not become generic because a patent has expired. In Singer, the court noted:

[W]here, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created . . . .159

155. Id. (quoting Kellogg Co. v. National Biscuit Co., 305 U.S. 111 at 118 (1938)).
156. Id. (emphasis added).
157. Id. (emphasis added).
158. Id.
As one commentator observed:

Note that this does not state that the name became generic because the patents expired, but merely that if the name had already become generic during the patented "single source" period, then when others were free to copy the public domain product, they of course, could use the generic name.160

Therefore, Kellogg and Singer, as cited by the Vornado court, do not support that court's conclusion that patent expiration on a particular product automatically places that product in the public domain, free for all to copy.

The Kellogg and Singer cases also have no direct application to the Vornado case because both are distinguishable. Singer was distinguished by the Vornado court itself. As stated by the court:

We also can distinguish Singer because it was decided at a time when the tort of unfair competition was generally perceived to require fraudulent passing off, and unfair competition law has since evolved and expanded, so that it may be violated without active deceit, wherever a product shape has acquired secondary meaning and a likelihood of consumer confusion is found.161

The Vornado court's attempt to minimize the force of this distinction, by noting that "both the Supreme Court and our own circuit have also preserved defendant's right to copy even where defendants were found to have deliberately palmed off their goods in an effort to deceive consumers," is insufficient.162 Regardless of what the Supreme Court or the Tenth Circuit has ruled in the cases cited163 to support the above conclusion, none of the cases mentioned involve a conflict with federal trademark law. Thus, the Vornado court's attempt to find connections and similarities between the cases it has cited and the Vornado case is futile.

Kellogg is distinguishable because in that case, no finding of secondary meaning164 nor inherent distinctiveness was

160. Id.
162. Id.
163. Id.
164. See AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1536 n.14 (11th Cir. 1986) ("Secondary meaning is the connection in the consumer's mind between
found.\textsuperscript{165} In the Vornado case, the district court found inherent distinctiveness.\textsuperscript{166} Furthermore, the Kellogg court, in explaining why copying of the goods in the same pillow-shape was permitted, stated that “[t]he evidence is persuasive that this form is functional — that the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.”\textsuperscript{167}

In the Vornado case, the district court explicitly stated that the spiral grill was nonfunctional and that “other feasible grill structures could easily do as well on other relevant performance tests, and the spiral grill was not shown to be cheaper to manufacture.”\textsuperscript{168} Therefore, not only was the product in Kellogg generic, but it also did not meet the requirements of distinctiveness and nonfunctionality which are crucial to protection under common law unfair competition\textsuperscript{169} and federal trademark law.\textsuperscript{170} The shape of the biscuit could not be protected without resort to the policies of patent law. The spiral grill in the Vornado court, however, did meet all of the requirements needed to attain trademark protection. Thus, the Vornado court was erroneous in not allowing federal trademark protection to the spiral grill.

2. Federal Preemption Cases Cited Not Applicable to the Vornado Case

The Supreme Court preemption cases cited by the Vornado court, namely Sears, Compco and Bonito Boats, all dealt with federal preemption of state unfair competition statutes.\textsuperscript{171} No Lanham Act issue was raised. Therefore, because the three Supreme Court cases were strictly based on

\textsuperscript{165} See Kellogg v. Nat'l Biscuit Co., 305 U.S. 111, 120 (1938) (noting that no inherent distinctiveness was found because the shape of the biscuit was “primarily associated with the article rather than the particular producer”). See also Vornado, 58 F.3d at 1505.

\textsuperscript{166} Vornado, 58 F.3d at 1502 (“The court further found the grill design was a suggestive symbol combined with a device, and thus inherently distinctive, so that no showing of secondary meaning was required.”).

\textsuperscript{167} Kellogg, 305 U.S. at 122.

\textsuperscript{168} Vornado, 58 F.3d at 1501.

\textsuperscript{169} See supra note 55 and accompanying text.

\textsuperscript{170} See supra note 42 and accompanying text.

\textsuperscript{171} See supra text accompanying notes 125-37.
the Supremacy Clause of the Constitution\textsuperscript{172} and because federal trademark law is not subject to preemption by the supremacy clause,\textsuperscript{173} the \textit{Sears/Compco/Bonito Boats} line of cases is not applicable to the \textit{Vornado} case.

Federal trademark law is not subject to preemption by another federal statute. Therefore, to the extent that a plaintiff can convert a state unfair competition case into a federal case by invoking the Lanham Act, the preemptive thrust of \textit{Sears/Compco/Bonito Boats} line of cases can be avoided. For example, the Eighth Circuit has taken the position that section 43(a)\textsuperscript{174} was not preempted by \textit{Sears} and \textit{Compco} in \textit{Truck Equipment Service Co. v. Fruehauf Corporation}.\textsuperscript{175} In that case, defendant's contention that it was privileged to copy the exterior design of the plaintiff's product based on \textit{Sears/Compco} was denied by the court.\textsuperscript{176} According to the \textit{Fruehauf} court, "[n]either case is controlling here . . . . The issue before the Court (\textit{Sears/Compco} Courts) was whether state law could extend the effective term of patent protection granted by federal statutes. The focus of the Court was the Supremacy Clause of the Constitution."\textsuperscript{177}

Other circuits have adopted the Eighth Circuit's view that \textit{Sears/Compco} has no effect on the Lanham Act. For example, the Second Circuit in \textit{Ives Laboratories Inc. v. Darby Drug Co.},\textsuperscript{178} stated that:

It is surely true that in the \textit{Sears} and \textit{Compco} opinions the Supreme Court said nothing about the federal tort created by section 43(a) . . . . The Court, it can be strongly argued, had no need to be concerned with marking out the

\begin{footnotesize}
172. U.S. Const. art. VI. \textit{See also} discussion infra parts I.A, IV.
173. By definition, preemption means that state law protection ceases when it is inconsistent with a federal interest and a federal regulatory regime. \textit{Black's Law Dictionary} 1117 (6th ed., 1990). The Lanham Act is not a state statutory regime but rather a federal statute; therefore, it may not be preempted by the Supremacy Clause. \textit{Cf.} Preston State Bank v. Ainsworth, 552 F. Supp. 578, 580 (N.D. Tex. 1982) (discussing how the Lanham Act section 43(a) should not be preempted by the National Banking Act as "two federal laws applicable to the same situation should be applied harmoniously").
175. 536 F.2d 1210, 1210 (8th Cir. 1975); \textit{see, e.g.}, Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd. 604 F.2d 200 (2d Cir. 1979); \textit{see also} discussion infra part II.C.
176. \textit{Truck Equip.}, 536 F.2d at 1214.
177. \textit{Id.}
178. 601 F.2d 631 (2d Cir. 1979), \textit{rev'd sub nom.} on other grounds 638 F.2d 538 (2d Cir. 1981).
\end{footnotesize}
boundaries of a federal tort over which it had complete control and which Congress could contract if the courts were pressing it further than that body desired.\(^{179}\)

The Third Circuit has also agreed that a "[s]uit brought under section 43(a) survives the stringent limitations on state unfair competition laws imposed by the decisions of the Supreme Court [in Sears-Compco]."\(^{180}\)

Furthermore, the Compco decision itself stated that "[i]f the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will."\(^{181}\) Bonito Boats also noted that by enacting section 43(a) of the Lanham Act, "Congress has thus given federal recognition to many of the concerns which underlie the state tort of unfair competition and the application of Sears and Compco to nonfunctional aspects of a product which have been shown to identify source must take account of competing federal policies in this regard."\(^{182}\) This passage thus indicates that the Supreme Court fully recognizes that the preemption rationale of Sears/Compco has no relevance to the use of Lanham Act section 43(a) as a means of asserting a federal claim against product copying.

B. The Vornado Court Erroneously Concluded that the Functionality Doctrine Provided an Incomplete Answer to the Conflicts Between the Patent Act and the Lanham Act

The proposition that the functionality doctrine eliminates conflicts between the Patent Act and the Lanham Act has been widely accepted by various courts and commentators.\(^{183}\) The Vornado court attempted to dispel this widely accepted proposition by erroneously concluding that all product configurations or product parts must be functional before a utility patent may be issued.\(^{184}\) The Vornado court also at-

\(^{179}\) Id. at 642.

\(^{180}\) Keene Corp. v. Paraflex Indus., Inc, 653 F.2d 822 (3d. Cir. 1981); see, e.g., Ideal Toy Corp. v. Plawner Toy Corp. 685 F.2d 78 (3d Cir. 1982); SK&F Co., 625 F.2d at 1064-65.

\(^{181}\) Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 238 (emphasis added).


\(^{183}\) See discussion infra part II.D.

\(^{184}\) Vornado Air Circulation Sys. v. Duracraft Corp., 58 F.3d 1498, 1506-07 (10th Cir. 1995); see also supra text accompanying notes 186-89.
tempted to dispel the widely held proposition that functional features eliminate conflicts between the Patent Act and the Lanham Act, by overemphasizing an incomplete definition of functionality.\textsuperscript{185}

The \textit{Vornado} court concluded that "[d]espite what appears to be a widespread perception that product configurations covered by utility patents are automatically functional for Lanham Act purposes, the district court in our case ably demonstrated that this is not so."\textsuperscript{186} The appellate court's conclusion was erroneous because not all separate product configurations of a given product must be functional before a utility patent will issue. Rather, functionality is determined by looking at the entire product as a whole. This is evidenced by the fact that the P.T.O. granted \textit{Vornado} a utility patent on their ducted fans, despite the fact that the fan's spiral grill was not in and of itself, capable of being patented. In fact, as noted by the court, "[i]ts fan grill was not patentable by itself because a spiral grill per se was already in the public domain as 'prior art,' a patent law term for what was already known from previous other patents or other sources."\textsuperscript{187}

Furthermore, the district court held that the spiral grill was nonfunctional in a legal sense\textsuperscript{188} and that "other feasible grill structures could easily do as well on other relevant performance tests and the spiral grill was not shown to be cheaper to manufacture."\textsuperscript{189} Therefore, the appellate court's conclusion that the district court disproved a "widespread perception that product configurations covered by utility patents are automatically functional for Lanham Act purposes" was clearly erroneous.\textsuperscript{190} The district court granted protection to a product which met all the necessary requirements for federal trademark protection. The fan grill was inher-

\textsuperscript{185}. The definition of functionality adopted by the \textit{Vornado} court was "in terms of competitive need." \textit{Id.} at 1507. \textit{See also supra text accompanying notes} 138-42.
\textsuperscript{186}. \textit{Vornado}, 58 F.3d at 1506.
\textsuperscript{187}. \textit{Id.} at 1500.
\textsuperscript{188}. \textit{Id.} at 1501 ("The district court found that the spiral grill was functional in a lay sense but not in a legal sense.").
\textsuperscript{189}. \textit{Id.; see also discussion infra part II.D} (discussion supports quote as a definition of functionality).
\textsuperscript{190}. \textit{Id.} at 1506.
ently distinctive, not likely to cause customer confusion as to source and nonfunctional. 191

The Vornado court also attempted to dispel the widely held proposition that functional features eliminate conflicts between the Patent Act and the Lanham Act, by overemphasizing an incomplete definition of functionality. 192 The Vornado court defined functionality exclusively based "in terms of competitive need." 193 By exclusively using this definition of functionality, the Vornado court then argued that a product did not have to be functional in order to meet the requirements of patent protection. 194 Such a conclusion is erroneous because defining functionality exclusively "in terms of competitive need" does not do justice to its true definition or what most courts have interpreted functionality to mean. 195

By definition, any feature which serves a utilitarian purpose and affords benefits not practically available through alternative designs is functional. 196 As one commentator wrote:

[T]he fundamental meaning of the word 'function' in the doctrine's name is not merely any purpose, but a useful or utilitarian purpose in the utility patent sense. If a feature of an article is dictated by such a useful purpose, it is

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191. Keene Corp. v. Paraflex Indus., Inc., 653 F.2d 822 (3d. Cir. 1981); see also supra note 41 and accompanying text.
192. See supra text accompanying notes 140-41.
193. Vornado, 58 F.3d at 1507 (noting that to define functionality "in terms of competitive need" means that "if competitors need to be able to use a particular configuration in order to make an equally competitive product, it is functional, but if they do not, it may be nonfunctional").
194. The Vornado court argues that:

to meet patent law's usefulness requirement, a product need not be better than other alternatives or essential to competition . . . an inventor need only show that an invention is 1) useful in the sense of deriving some identified, beneficial purpose, and then—much more difficult to prove—that it is 2) novel, i.e. not previously known, and 3) nonobvious, or sufficiently inventive, in light of prior art.

Id. at 1506-07.
196. See discussion infra part II.D.
functional and must be protected, if at all, by a utility patent.\textsuperscript{197} This "utilitarian" definition of functionality is thus consistent with the requirements of patent law's requirement that an invention be "useful, in the sense of serving some identified, beneficial purpose."\textsuperscript{198} Thus, the "in terms of competition" definition of functionality that the appellate court used in its analysis was incomplete.

The appellate court's conclusion that the functionality doctrine provides an incomplete answer to conflicts regarding the Patent Act and the Lanham Act was thus erroneous. Not all parts of a product must be functional before the entire product is accorded a utility patent. Therefore, there is no conflict between the P.T.O.'s patent protection of the ducted fan (which for Lanham Act purposes is functional) and the district court's holding that the fan grill was nonfunctional. Furthermore, a complete definition of functionality which includes the "utilitarian" component is sufficiently consistent with, and meets, patent law's requirement that an invention be useful.

C. The Vornado Court does not do Justice to Federal Trademark Law

The Vornado court's analysis and conclusions regarding its attempts to reconcile the two federal statutes do not do justice to federal trademark law. First, the appellate court concludes that allowing an inventor both patent and trade dress protection in a configuration would indirectly inhibit inventors, because by allowing a "double benefit... the inventor's supply of ideas itself and freedom to experiment with them might diminish if the inventor had to do a competitive market analysis before adopting useful features from others' inventions once their patents expired."\textsuperscript{199} Such a conjecture is not only unfounded but unjustly implies a double standard regarding the Patent Act and the Lanham Act.

The standard implied by the Vornado court is that only patent law may freely take a concept or product out of the public domain. This double standard is further emphasized in the court's analysis regarding the effect that trade dress

\begin{footnotes}
\footnote{197}{Dratler, \textit{supra} note 75, at 942.}
\footnote{198}{\textit{Vornado Air Circulation Sys.}, 58 F.3d 1498,1507 (10th Cir. 1995).}
\footnote{199}{\textit{Id.} at 1508.}
\end{footnotes}
protection would have regarding the patent law goal of encouraging public disclosure of ideas. The court concluded that "this case clearly shows that trade dress protection can directly interfere with the public's ability to practice patented inventions after the patents have expired, and that it undermines the principle that ideas in the public domain should stay there."

Such a conclusion is erroneous for two reasons. First, there is no widely held principle that "ideas in the public domain should stay there." This is evidenced by the fact that federal trademark, copyright and patent law, as well as other common law intellectual property protections, take products and ideas in and out of the public domain all the time. Second, such a conclusion implies that patent law may take something out of the public domain. However, if a product is taken away from the public domain to further the goals and objectives of the Lanham Act, it is wrong or somehow hurting society. Such an implication is clearly erroneous because the very purpose of the Lanham Act is to benefit the public by preventing it from being confused as to the source of the products purchased. Lastly, the court misinterpreted the underlying goals of the Lanham Act by concluding that "protecting against that degree of confusion that may arise from such configurations that are significant parts of patented inventions is, at best, a peripheral concern of section 43(a) of the Lanham Act."

The primary, if not only, concern of the Lanham Act is to prevent customer confusion as to source regarding any product. Whether or not a product is a normal everyday product or "a significant part of patented inventions" is unimpor-

200. Id.
201. See McCarthy, supra note 19, at 149 (comparison of patents, trademarks, and copyrights reveal that all three may take things in and out of the public domain for specified periods of time and thus the statement that "ideas in the public domain should stay there" is erroneous).
202. Id. (Federal trademark protection lasts as long as the product or service is distinctive, nonfunctional and not likely to cause consumer confusion as to the source of the product. Utility patent protection is 17 years and design patent protection lasts for 14 years. Copyright protection for works created after January 1, 1978 is the life of the author plus 50 years.)
203. See supra text accompanying note 56.
204. Vornado Air Circulation Sys. v. Duracraft Corp., 58 F.3d 1498, 1509 (10th Cir. 1995).
205. See supra text accompanying note 56.
tant. If that product can meet the requirements of distinctiveness, not likely to cause customer confusion as to the product's source and nonfunctionality, it may be protected by the Lanham Act. Therefore, the court's conclusion that "core patent principles will be significantly undermined if we do not allow the copying in question, and peripheral Lanham Act protections will be denied if we do," is without merit.

The Vornado court's conclusion—that not every nonfunctional configuration is eligible for trade dress protection—is erroneous. The court's rationale for this view relies on the Senate report accompanying the bill to expand section 43(a) in 1988, from which the court infers a Congressional intent to allow all nonfunctional configurations trade dress protection. However, that assumption does not support the result the court reaches. As discussed above, there is no reason not to allow trademark protection if the necessary requirements for protection are met. Even if the Senate report did not imply that all nonfunctional configurations should be given trade dress protection, it is still silent regarding the eligibility of the product configuration to attain trade dress protection. As long as the product is nonfunctional and it meets the other requirements for federal trademark protection of being distinctive and not likely to cause customer confusion as to source, the product should always be eligible for Lanham Act protection.

IV. PROPOSAL

This comment disagrees with the decision in Vornado, that patent law has the power to deny Lanham Act protection to products or services, regardless of whether or not such products meet the Lanham Act requirements for protection. Both the Patent Act and the Lanham Act were enacted to further different goals and purposes. The two federal statutes are separate and distinct. To the extent that patent and

206. See supra text accompanying note 42.
207. *Vornado*, 58 F.3d at 1509.
208. See supra text accompanying notes 143-46.
209. See supra text accompanying notes 30, 56.
210. See discussion supra part II.C.
federal trademark law do conflict, it has been established that the functionality doctrine reconciles these concerns.\textsuperscript{211}

This comment proposes that federal trademark law has just as much right to take something out of the public domain as patent law. In reviewing cases which contain both patent and trademark issues, courts should thus disregard any relationships or overlapping concerns and conflicts shared by the federal statutes. Courts should isolate each patent or trademark issue and analyze the issue of whether or not to allow patent or trademark protection separately. If the requirements for patent or trademark protection are met, then the product should be given such protection, regardless of whether or not the product is already being protected by another federal statute.

This type of standard for review should be applied by the courts for two reasons. First, deciding patent and trademark issues with an eye towards ensuring that the goals of each are not offended in any way, is a futile task. It is inevitable that furthering the goals of one can almost always be interpreted as offending the goals of the other. Therefore, because an argument can always be made that the goals of one will hinder the effective furtherance of the objectives of the other, courts should strictly focus on these two separate and distinct statutes independently. It is only through this strict analysis that the goals of each will truly be furthered.

Furthermore, nowhere is it written that Congress intended the courts to read patent and trademark legislation with a cautionary eye to ensure that neither steps on the toes of the other. The congressional hearings and reports in no way mention the Patent Act in its discussion of the Lanham Act and vice versa. Rather, Congress had clear and separate objectives in enacting the Patent Act and the Lanham Act. The Patent Act was enacted to reward and promote inventions via the disclosure of ideas in the marketplace in exchange for a limited monopoly.\textsuperscript{212} The Lanham Act was enacted to prevent customers from being confused, misled or deceived regarding a product’s source.\textsuperscript{213} In light of the distinct and separate goals of the Patent Act and the Lanham

\textsuperscript{211} See discussion supra part II.D.
\textsuperscript{212} See supra part II.A.
\textsuperscript{213} See supra part II.B.
Act, courts should thus interpret the two statutes independent of each other.

Second, this strict standard of review should be applied because the very notion of one federal statute preemption another federal statute is unfounded and unconstitutional. Federal statutes may preempt state statutes via the Supremacy Clause of the Constitution. The Supreme Court has invoked the Supremacy Clause by allowing the Patent Act to preempt several common law unfair competition statutes, exemplified by Sears, Compco and Bonito Boats. Similarly, the Lanham Act has also preempted state unfair competition statutes where state trademark law has conflicted with the rights and remedies under federal law. The equality of the two federal statutes is thus inherent and the notion that one federal statute may preempt another is absurd. Strict and separate application of the Patent Act and the Lanham Act will circumvent this problem and should thus be used by the courts.

V. Conclusion

The Vornado court erroneously suggested that the goals of patent law are superior to the goals of trademark law. Such a conclusion is not only unsupported by case law or statute, but it is also unconstitutional. No hierarchy exists among two federal statutes, which would allow for one federal statute to preempt another federal statute. Congress does not make it a policy of potentially creating anarchy by passing conflicting laws.

The Vornado court's holding that one federal statute may preempt another federal statute is not only unfounded, but will have adverse effects not only within the legal community, but also within the public at large. Attorneys and judges would not be able to rely on federal statutes if a statute can be held invalid upon a showing that the goals of another to-
tally separate and distinct federal statute may be marginally affected. Society would suffer because justice would no longer be based purely on reliance of the law, if laws were able to be proven unworkable, based on peripheral concerns, in light of other laws of equal importance.

These adverse effects can be avoided if courts interpret each federal statute such as the Patent Act and the Lanham Act in a vacuum, especially absent any congressional intent to the contrary. The Patent Act and the Lanham Act both further different goals and objectives and courts should ensure the furtherance of each if the respective requirements of each statute are met. The Vornado court's holding was clearly erroneous. The spiral grill met the requirements of federal trademark protection. The district court's holding to allow the spiral grill to be protected as a trade dress under section 43(a) of the Lanham Act, should have been upheld. Two coequal federal statutes should never be allowed to pre-empt one another.

Ruby Ann David