Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection

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Introduction ........................................... 596
I. Trade Dress and Functionality .......................... 597
   A. The Historical Antecedents of the Nonfunctionality Requirement .......... 597
      1. Trade Dress Doctrine and Its Early Development ......................... 597
   B. The Sears-Compco Doctrine .................................. 609
      1. The Constitution and Functional Designs ................................. 609
      3. Functionality and Federal Law in the Wake of Sears-Compco-Bonito Boats ........ 619
II. Copyright and the Constitution ......................... 627
   A. The "Sweat of the Brow" Doctrine ............................ 627
   B. Feist Publications, Inc. v. Rural Telephone Service Co. .................. 634
III. Accommodation of Constitutional Principles Under Federal Trade Dress Law .................. 637
   A. The Constitutional Significance of Feist to Trade Dress Law ............. 637
   B. The Limits of "Thin" Trade Dress Protection ............................ 647
Conclusion .................................................................. 652

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INTRODUCTION

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, the Supreme Court rejected the rule prevailing in at least three circuits that written works produced through industrious labor, in addition to those produced through original creation, were eligible for federal copyright protection. In doing so, however, the Court declined to hold, merely as a matter of statutory interpretation, that the so-called "sweat of the brow" doctrine was invalid under the Copyright Act of 1976's requirement that copyrightable works possess a threshold level of original creativity. Rather, the Court went well beyond this determination to hold the principle fatally inconsistent with the Constitution's Intellectual Property Clause, which authorizes Congress "[t]o 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." In doing so, the Court recognized in the copyright context an apparent constitutional right to copy separate and independent of any such right that may be found in the statute.

It is the thesis of this Article that the constitutional principles upon which *Feist* rests are equally applicable in another area, namely federal trade dress protection under the Lanham Act. Specifically, this Article argues that *Feist* merely reaffirmed the Court's prior holdings in cases involving product configurations that the Intellectual Property Clause creates and defines a public domain that trumps all federal intellectual property legislation and not just that in *Feist*. As set forth below in greater detail, the boundaries of the right to copy set by this constitutional public domain extend in the trade dress context to

5. Trade dress encompasses the image, packaging and labels for a product or service. For a full discussion, see *infra* notes 11-17 and accompanying text.
the purely functional aspects of plaintiffs' designs. Recognition of these boundaries is particularly important in light of the prevailing tendency among courts to treat trade dress law's nonfunctionality requirement as a mere creature of statute, subject to legislative abrogation.\footnote{See infra notes 126-134 and accompanying text (describing case law holding that passage of the Lanham Act altered traditional treatment of functional configurations).}

Part I of this Article explores the principles governing trade dress protection under the common law and the Lanham Act. This Part includes a critical examination of the Supreme Court's interpretations of the Intellectual Property Clause in \textit{United States v. Steffens (The Trade-Mark Cases)},\footnote{100 U.S. 82 (1879).} \textit{Bonito Boats, Inc. v. Thunder Craft Boats, Inc.},\footnote{489 U.S. 141 (1989).} and \textit{Compco Corp. v. Day-Brite Lighting, Inc.},\footnote{376 U.S. 234 (1964).} the latter of which contains two constitutional holdings rather than the single pronouncement most commonly recognized by courts and commentators. Part II of the Article examines the rise and fall of the sweat of the brow doctrine, with a particular focus on the Supreme Court's treatment of the Intellectual Property Clause in \textit{Feist}. Part III argues that the constitutional holding of \textit{Feist} unmistakably answers certain questions about the law governing the protection of trade dress that the lower federal courts have failed to resolve. This Part proposes a new "thin" concept of protectable trade dress consisting of functional and nonfunctional elements that corresponds to the "thin" copyright recognized by \textit{Feist} and that more fully complies with the mandates of the Intellectual Property Clause than the doctrine currently applied by most courts.

I. TRADE DRESS AND FUNCTIONALITY

A. THE HISTORICAL ANTECEDENTS OF THE NONFUNCTIONALITY REQUIREMENT

1. Trade Dress Doctrine and Its Early Development

Defined generally, "trade dress" is the overall image used to present a product or service to purchasers.\footnote{See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc., 112 S. Ct. 2753, 2755 n.1 (1992) (describing trade dress as the total image of a business); John H.} In its most
common form, trade dress consists of the packaging and labels for a particular product.\textsuperscript{12} It also, however, can include characteristics of a good itself, such as its configuration,\textsuperscript{13} color,\textsuperscript{14} or fragrance.\textsuperscript{15} In still less common situations, cognizable trade dress can consist even of the physical appearance of buildings associated with a plaintiff's services\textsuperscript{16} or its unique sales

Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983) ("Trade dress' involves the total image of a product.").


TRADE DRESS PROTECTION

1996

Techniques. Although historically less well recognized than its trademark and service mark counterparts, trade dress serves the identical function of identifying the origin of its owners' goods and services. Under section 32 and section 43(a) of the Lanham Act, as well as under the common law, a plaintiff with prior use of a valid trade dress in commerce can proceed


18. Under the Lanham Act, a "trademark" may be "any word, name, symbol, or device, or any combination thereof" used by its owner "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown," while a "service mark" acts to identify and distinguish the services of its owner. 15 U.S.C. § 1127 (1994). Although they emerged relatively late in the history of unfair competition law, the Act also provides for federal protection of "certification marks," which certify such things as a product's regional origin or mode of manufacture, and "collective marks," which include designations indicating membership in a union, an association or other organization. Id. In keeping with the convention employed by the Act, and because the distinctions between purely verbal indicators of origin are largely irrelevant for purposes of this Article, the term "marks" as used in this Article collectively refers to all of these designations unless otherwise noted.

19. See Two Pesos, 112 S. Ct. at 2760 ("[T]he protection of trademarks and trade dress . . . serves the same statutory purpose of preventing deception and unfair competition. There is no persuasive reason to apply [a] different analysis to the two.").

20. Section 32 of the Lanham Act creates a cause of action on behalf of the owner of a federally registered trade dress against anyone who, without consent, uses in interstate commerce a "reproduction, counterfeit, copy, or colorable imitation" of the registered mark or trade dress. 15 U.S.C. § 1114 (1994). Similarly, section 43(a) of the Act allows the owners of registered or unregistered marks or trade dresses to bring infringement actions against defendants using "false designation[s] of origin." Id. § 1125(a). Although trade dresses, like trademarks, service marks, collective marks, and certification marks, may be federally registered, see, e.g., McDonald's Corp. v. Moore, 383 F.2d 435 (5th Cir. 1966) (federal registration of yellow parabolic arches used in design of plaintiff's buildings), most trade dress infringement cases involve owners of unregistered trade dresses proceeding under section 43(a).

21. As the Restatement has explained:

Rights can be acquired in a designation only when the designation has been actually used as a [trade dress] . . . or when an applicable statutory provision recognizes a protectable interest in the designation prior to actual use. A designation is "used" as a [trade dress] . . . when the designation is displayed or otherwise made known to prospective purchasers in the ordinary course of business in a manner that associates the designation with the goods, services, or business of the user . . . .
against others using confusingly similar trade dresses.\textsuperscript{22} To qualify for protection, the plaintiff’s trade dress must be (1) a distinctive indicator of origin\textsuperscript{23} and (2) "nonfunctional" or, in


22. As framed by Justice Stevens:

[T]he test for liability [for trademark infringement] is likelihood of confusion: "[U]nder the Lanham Act . . . , the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks. . . . Whether we call the violation infringement, unfair competition or false designation of origin, the test is identical—is there a 'likelihood of confusion?'"


23. Although an inquiry into the distinctiveness requirement for trade dress protection is beyond the scope of this Article, the plaintiff owner of a trade dress must demonstrate in an infringement suit that prospective purchasers perceive the trade dress as a symbol of identification that indicates an association with a particular source. \textit{See, e.g.}, Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 716 F.2d 854, 857-62 (11th Cir. 1983) (holding that design affixed to athletic shoe was not inherently distinctive and that plaintiff had not established secondary meaning). The most cost-effective means for meeting this requirement often is for a plaintiff to receive under the Lanham Act a federal registration covering the trade dress in question. Under section 3(a) of the Act, a certificate of registration constitutes "prima facie" evidence of distinctiveness. 15 U.S.C. §§ 1057(b), 1115(a) (1994). If the registration is more than five years old, this presumption can become "conclusive," provided that the registrant complies with certain procedural formalities. \textit{See id.} §§ 1065, 11.15(b); \textit{see also} Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 205 (1985) (holding that incontestable registration precludes challenges to distinctiveness of registered mark).

The plaintiff owner of an unregistered trade dress may establish distinctive-
TRADE DRESS PROTECTION

other words, not essential to the use or purpose of the associated good or service or affecting the cost or quality of the good or service.24

The nonfunctionality requirement's significance to the relationship between federal trade dress law and that covering utility patents25 is the focus of this Article. Because trade

ness through one of two showings:

(a) the designation is "inherently distinctive," in that, because of the nature of the designation and the context in which it is used, prospective purchasers are likely to perceive it as a designation that, in the case of a [trade dress], identifies goods or services produced or sponsored by a particular person, whether known or anonymous ...; or

(b) the designation, although not "inherently distinctive," has become distinctive, in that, as a result of its use, prospective purchasers have come to perceive it as a designation that identifies goods, services, businesses ... in the manner described in Subsection (a). Such acquired distinctiveness is commonly referred to as "secondary meaning."

RESTATEMENT, supra note 21, § 13(a)-(b), at 104-05.

Although the precise factors used by courts to determine whether an unregistered trade dress has, in fact, achieved the requisite secondary meaning differ, the test applied by the Eleventh Circuit is characteristic:

The factors to consider ... are: (1) the length and manner of its use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the public's mind between the [trade dress] and the plaintiff's product or business; and (4) the extent to which the public actually identifies the [trade dress] with the plaintiff's product or venture.

Conagra, Inc. v. Singleton, 743 F.2d 1508, 1513 (11th Cir. 1984).


25. Subject to certain exceptions, see infra note 221 and accompanying text, utility patents are available to any person who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof." 35 U.S.C. § 101 (1994). As explained by the United States Patent and Trademark Office:

A patent for an invention is a grant of a property right by the Government to the inventor (or his heirs or assigns), acting through the Patent and Trademark Office. . . .

. . . .

The right conferred by the patent grant is, in the language of the statute and of the grant itself, "the right to exclude others from making, using, or selling" the invention. What is granted is not the right to make, use, or sell, but the right to exclude others from making, using, or selling the invention.

dress rights accrue from, and are dependent on, use of the trade dress in commerce, they differ in a critical aspect from the protection provided by utility patents. Utility patent protection expires at the end of a statutory term, whether or not the patentee actually makes use of its invention. By contrast, trade dress rights are not so temporally limited in scope. Rather, as the Court of Customs and Patent Appeals has noted:

The underlying purpose and the essence of patent rights are separate and distinct from those appertaining to [trade dresses]. No

Federal law also authorizes the issuance by the government of design patents for “any new, original and ornamental design for an article of manufacture.” 35 U.S.C. § 171 (1994). “To qualify for protection [under a design patent], a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability.” Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 148 (1989).

26. Tally-Ho, Inc. v. Coast Community College Dist., 889 F.2d 1018, 1022-23 (11th Cir. 1989) (per curiam) (“Trademark ownership is always appurtenant to commercial activity. Thus, actual and continuous use is required to acquire and retain a protectible interest in a mark.” (footnote omitted)); Blue Bell, Inc. v. Farah Mfg. Co., 508 F.2d 1260, 1265 (5th Cir. 1975) (“The exclusive right to a trademark belongs to one who first uses it in connection with specified goods.”); see also supra note 21 and accompanying text (describing the Lanham Act’s “use” requirement).

27. For utility patents in force on June 8, 1995, and patent applications filed on or before June 7, 1995, and subject to certain limited exceptions, 35 U.S.C. § 154(c)(1) (1994) provides for a term of the longer of 20 years from the date of filing or 17 years from the date of issue. For utility patent applications filed on or after June 8, 1995, and again subject to certain limited exceptions, 35 U.S.C. § 154(a)(2) (1994) provides that the term of a patent shall be 20 years from the date of filing of the application or, if the application makes reference to an earlier filed application under 35 U.S.C. §§ 120, 121, or 365 (1994), from the date on which the earliest such application was filed.

28. See Michael H. Davis, Death of a Salesman’s Doctrine: A Critical Look at Trademark Use, 19 GA. L. REV. 233, 241 n.19 (1985) (“Trademark rights exist only as long as the mark is used, although there is no fixed limit on protection so that, theoretically, they could be perpetual. . . . [However,] [t]here is no requirement that the patentee use or work the patent to maintain the patent rights.”); see also supra notes 20, 26 and accompanying text (describing the requirement that trade dresses be used in commerce as a prerequisite to receiving protection).

right accruing from the one is dependent upon or conditioned to the other. The longevity of the exclusivity of [a patent] is limited by law while [a trade dress] may be extended in perpetuity.30

The scope of this potentially perpetual protection traditionally has been uncertain in light of the Intellectual Property Clause's restriction of protection for "Discoveries" to "limited Times."31 This ambiguity originated in the treatment of word marks under nineteenth-century common law, which, like the Lanham Act, afforded mark owners protection against the use of confusingly similar marks.32 Early common law cases suggested this cause of action had two aspects, one turning on the need to reward the enterprise of mark owners and the other focusing on prevention of consumer confusion.33

In 1879, however, the Supreme Court made clear in United States v. Steffens (The Trade-Mark Cases)34 that the purpose of trademark law was not to reward creativity and ingenuity. The

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30. In re Mogen David Wine Corp., 328 F.2d 925, 929 (C.C.P.A. 1964); see also Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300, 1304 (1995) (distinguishing patent law as the avenue to short-term protection of functional features); Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1215 (8th Cir.) ("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."), cert. denied, 429 U.S. 861 (1976); In re Pollak Steel Co., 314 F.2d 566, 570 (C.C.P.A. 1963) (refusing to grant trademark registration covering product configuration that would give perpetual rights to a functional characteristic of a product); In re Shakespeare Co., 289 F.2d 506, 508 (C.C.P.A. 1961) (denying trademark registration covering product configuration on the ground that the Lanham Act does not permit monopolization of a process); Alan Wood Steel Co. v. Watson, 150 F. Supp. 861, 862 (D.D.C. 1957) ("While a patent is issued for only a limited term, a trade-mark becomes the permanent property of its owner and secures for him a monopoly in perpetuity.").


32. See, e.g., Ellis v. J.H. Zeilin & Co., 42 Ga. 91, 93 (1871) (recognizing a cause of action against the use of confusingly similar marks); see also supra note 22 (discussing the "likelihood of confusion" standard of modern decisions).

33. One classic example stated:

The first appropriator of a name or device pointing to his ownership, or which, by being associated with articles of trade, has acquired an understood reference to the originator, or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. Thus the custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another's use, and this is done by deceiving the public, by inducing the public to purchase the goods and manufactures of one person supposing them to be those of another.

Delaware & Hudson Canal Co. v. Clark, 80 U.S. (13 Wall.) 311, 323 (1871).

34. 100 U.S. 82 (1879).
Trademark Acts of 1870\(^{35}\) and 1876,\(^{36}\) each of which Congress had passed in reliance on the Intellectual Property Clause, precipitated this holding. On the appeal of three defendants convicted of violating the criminal provisions of the 1876 Act, the Court held both statutes fatally inconsistent with the clause under which Congress passed them:

> The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. . . . It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.\(^{37}\)

In holding that a designation of origin could not underlie the statutory monopoly contemplated by the Intellectual Property Clause, *The Trade-Mark Cases* thus recognized a principle recurring in the Court's opinions and given full effect in *Feist*: In addition to containing grants of authority to Congress, the Clause also contains *restrictions* on federal protection of intellectual property.

2. The Historical Obfuscation of Constitutional Issues in Trade Dress Law

Two aspects of early trade dress cases helped obscure the significance of *The Trade-Mark Cases*’ constitutional holding to the problem of functionality for the next eighty-five years. First, most trade dress cases during the late nineteenth and early twentieth centuries addressed only the protectability of wholly nonutilitarian label designs.\(^{38}\) Thus, for example, in *M.A. Thedford Medicine Co. v. Curry*,\(^{39}\) the Georgia Supreme Court recognized the availability of relief on a showing that “the defendant fraudulently, deceitfully, and with the intent to injure [the plaintiffs’] business . . . simulated [the plaintiffs’] wrappers, and thus deceived the public into buying large quantities of the spurious [product] as the genuine.”\(^{40}\) Likewise, the New York Court of Appeals concluded in *Fischer v. Blank*\(^{41}\) that equity

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37. 100 U.S. at 94.
39. 22 S.E. 661 (Ga. 1895).
40. Id. at 663.
41. 33 N.E. 1040 (N.Y. 1893).
would enjoin use of the elements making up packaging "when all, or a number of them, are combined . . . and so arranged and exhibited that when they strike the eye of the intending purchaser, possessed of ordinary intelligence and judgment, the false impression is likely to be produced that the goods of the plaintiffs are offered." Although these types of cases resulted in an expansion of trade dress rights, the preoccupation of turn of the century litigants with labels and packaging gave courts little occasion to address the scope of protection available to functional product configurations, much less the significance of *The Trade-Mark Cases* to that issue.

Second, and notwithstanding the then-pendency of *Swift v. Tyson,* courts hearing unfair competition cases did not create a separate body of federal law, but instead relied equally upon state and federal precedents in entering or denying relief. The absence of a recognized distinction between state and federal law resulted in part from congressional timidity following *The Trade-Mark Cases* in reenacting federal legislation under the auspices of the Commerce Clause. As late as the Trademark Act of 1905, for example, the federal cause of action for infringement extended only to marks registered with the

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42. *Id.* at 1041.
44. *See,* e.g., *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.,* 250 U.S. 28, 29-30 (1919) (relying on federal and Massachusetts case law in refusing to enjoin defendant from using brown bottles with brown labels allegedly similar to those of plaintiff); *Centaur Co. v. Neathery,* 91 F. 891, 898-900 (5th Cir. 1898) (relying on federal and New York case law in enjoining defendant from using elixir bottles and labels confusingly similar to those used by plaintiff); *Philadelphia Novelty Mfg. Co. v. Rouss,* 40 F. 585, 586 (C.C.S.D.N.Y. 1889) (relying on federal and numerous states' case law in refusing to enjoin defendant from marketing its hair-crimpers in packages reasonably dissimilar to the packages used by plaintiff).
45. The Commerce Clause grants Congress the plenary power to "regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes." U.S. CONST., art. I, § 8, cl. 3. Although invalidating the 1870 and 1876 acts under the Intellectual Property Clause, the Supreme Court in *The Trade-Mark Cases* nevertheless suggested that similar legislation might withstand constitutional scrutiny under the Commerce Clause instead. *See* 100 U.S. at 95-96. Accepting this invitation, Congress initially adhered so literally to this provision's express text that it in 1881 granted the Commissioner of Patents the authority to register only trademarks used in commerce with foreign nations or with Native American tribes. *See* Act of Mar. 3, 1881, ch. 138, 21 Stat. 502 (repealed 1946).
Commissioner of Patents. Likewise, although the Trade-mark Act of 1920 recognized for the first time a cause of action against the infringement of unregistered "designation[s] of origin" (rather than merely of verbal word marks), it nevertheless offered little guidance on the subject of what might qualify for protection. Consequently, little, if any, statutory framework existed when trade dress cases first began to reach federal appellate courts.

Despite the absence of legislative guidance, federal courts eventually imposed a significant restriction on the protection available under trade dress law. As Learned Hand noted in 1917:

[T]he plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy the plaintiff's goods slavishly down to the minutest detail; but he may not represent

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49. Section 3 of the 1920 Act provided:
That any person who shall willfully and with intent to deceive, affix, apply, or annex, or use in connection with any article or articles of merchandise, or any container or containers of the same, a false designation of origin, ... shall be liable at law to an action for damages and to an action in equity for an injunction.
41 Stat. at 534.
50. As Justice Stevens has explained:
Section 3 [of the 1920 Act] was destined for oblivion largely because it referred only to false designation of origin, was limited to articles of merchandise, thus excluding services, and required a showing that the use of the false designation of origin occurred "willfully and with intent to deceive." As a result, "[a]lmost no reported decision can be found in which relief was granted to either a United States or foreign party based on this newly created remedy."
51. See JAMES L. HOPKINS, THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION § 47, at 112 (2d ed. 1905) ("It is obvious that if a commercial article itself could constitute a trademark, there would be little use for patent laws. As Judge Carpenter said, 'in the very nature of the case, ... the trademark must be something other than, and separate from, the merchandise.' " (quoting Davis v. Davis, 27 F. 490, 492 (C.C.D. Mass. 1886)).
himself as the plaintiff in their sale.\textsuperscript{52} By 1941, this doctrine applied to more than the product configuration context addressed by Hand. Indeed, it encompassed a general right to copy all functional aspects of a plaintiff's trade dress not covered by a utility patent:

[The appropriation of a competitor's unpatented improvements] is one of the privileges of our system of competitive enterprise. It insures to the public the benefit of all natural, useful progress in the industrial and commercial arts. Any article, structure or design, which is unpatented, may accordingly be imitated or appropriated in its functional aspects, if no unfair competition [\textit{e.g.}, palming off] is involved in the manner of its use.\textellipsis In permitting unpatented functional features to be subjected to competitive commercial appropriation, the law treats a non-functional aspect of goods as constituting in effect a mere form of merchandising or a business method.\textsuperscript{53}

Moreover, the exclusion of functional trade dress from federal protection extended to the registration process.\textsuperscript{54} not only did

\begin{itemize}
\item \textsuperscript{52} Crescent Tool Co. v. Kilborn & Bishop Co., 247 F. 299, 301 (2d Cir. 1917). The Seventh Circuit offered an alternative statement of Hand's test in William H. Keller, Inc. v. Chicago Pneumatic Tool Co., 298 F. 52 (7th Cir. 1923), \textit{cert. denied}, 265 U.S. 593 (1924), in the context of a defendant's copying of an article covered by an expired utility patent:
\begin{quote}
[If the structure which the patentee makes pursuant to his patent is an embodiment of the elements of the claims or a claim therein, and contains no artistic or distinguishing marks, but is strictly a utilitarian article, where simplicity of structure and cheapened cost of production are inherent in the combination and constitute its virtue, then the mere fact that a Chinese copy is made does not impose on the maker the burden of establishing his good faith or the absence of unfair trade methods.\textsuperscript{53}]
\end{quote}
\item \textsuperscript{53} J.C. Penney Co. v. H.D. Lee Mercantile Co., 120 F.2d 949, 953-54 (8th Cir. 1941); \textit{see also} American Safety Table Co. v. Schreiber, 269 F.2d 255, 272 (2d Cir.) ("The Congress \ldots has therefore confined and limited the rewards of originality to those situations and circumstances comprehended by our patent, copyright, and trade-mark laws. When these statutory frameworks are inapplicable, originality is \textit{per se} unprotected and often unrewarded.").\textsuperscript{54} cert. \textit{denied}, 361 U.S. 915 (1959); West Point Mfg. Co. v. Detroit Stamping Co., 222 F.2d 581, 589 (6th Cir.) ("The identical imitation of the goods of another does not in itself constitute unfair competition.").\textsuperscript{54} cert. \textit{denied}, 350 U.S. 840 (1955).
\item Under the Lanham Act, federal registration of a trade dress on the United States Patent and Trademark Office's Principal Register can provide the registrant with important procedural and substantive advantages in an infringement lawsuit. Federal registrants, for example, enjoy nationwide constructive notice of their use and ownership of the underlying trade dress. 15 U.S.C. § 1072 (1994). Of equal importance, prior to the fifth anniversary of the issuance of a registration, the registration is prima facie evidence of the registrant's exclusive right to use the trade dress in interstate commerce, as well as of the validity of the trade dress as an indicator of origin. \textit{Id.} §§ 1057(b), 1115(a). After five years, and provided that the registrant complies
\end{itemize}
the Commissioner of Patents routinely deny trade dress registration to functional product configurations, but enthusiastic courts generally upheld these refusals. Critically, courts made little effort to provide the nonfunctionality requirement with statutory or doctrinal moorings. Hand, for example, rested his application of the requirement on the ambiguous theory that "all the features of beauty or utility [of the plaintiff's good] which commend them to the public are by hypothesis already in the public domain." Indeed, even after the 1946 enactment of the Lanham Act, the Court of Customs and Patent Appeals admitted that its practice of upholding refusals by the Patent and Trademark Office to register functional configurations had no express textual basis. The court nevertheless justified this practice under the extra-statutory theory that "the 1946 Act is premised on the idea that only nonfunctional configurations may be registrable thereunder."

The basis of the nonfunctionality doctrine became even more uncertain because explications of it by federal courts occurred with certain procedural formalities, these evidentiary presumptions can become "conclusive." Id. §§ 1065, 1115(b); see Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 196 (1985).


56. Crescent Tool Co., 247 F. at 300.

57. See In re Deister Concentrator Co., 289 F.2d 496, 501 (C.C.P.A. 1961). Perhaps significantly, the Patent and Trademark Office itself has acknowledged the lack of express statutory authorization for this practice:

If something is de jure functional, it cannot be registered on either the Principal Register or the Supplemental Register. The refusal [to register] made in such a situation is based on §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the matter does not function as a mark. The refusal rests, however, upon the foundation of effective competition... Thus, the refusal has more to do with public policy than it has to do with §§1, 2 and 45 of the Act.

PATENT AND TRADEMARK OFFICE, UNITED STATES DEPT OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1202.03(a)(i)(C), at 1202-5 (1993).

TRADE DRESS PROTECTION

almost exclusively in cases involving expired utility patents.\textsuperscript{59} As the Supreme Court noted in reversing an injunction against the copying of a product configuration in \textit{Singer Manufacturing Co. v. June Manufacturing Co.},\textsuperscript{60} "[i]t is self evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property."\textsuperscript{61} Under this rule, "[s]haring in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested."\textsuperscript{62} Thus, before the Court's 1964 announcement of the \textit{Sears-Compco} doctrine, courts generally understood functionality as a mere negative implication, dependent on the metes and bounds of federal utility patent law.\textsuperscript{63}

B. THE \textit{SEARS-COMPCO} DOCTRINE

1. The Constitution and Functional Designs

The refusal of federal courts, for whatever reason, to protect putative trade dresses consisting of functional product configurations did not go unnoticed by the states. Although many states originally imposed a nonfunctionality requirement as strict as that applied by federal courts,\textsuperscript{64} this rule soon eroded in favor of increased protection without apparent regard to functionality.\textsuperscript{65} This tendency led, for example, to the Supreme Judicial Court of Massachusetts extending protection to the shape of a

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\item \textsuperscript{59} See, e.g., William H. Keller, Inc. v. Chicago Pneumatic Tool Co., 298 F. 52, 57 (7th Cir. 1923) ("The entry of one manufacturer into the field at the expiration of [a] patent is perfectly legitimate and justifiable."), cert. denied, 265 U.S. 593 (1924).
\item \textsuperscript{60} 163 U.S. 169 (1896).
\item \textsuperscript{61} Id. at 185.
\item \textsuperscript{62} Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938).
\item \textsuperscript{63} See also Marvel Co. v. Pearl, 133 F. 160, 161 (2d Cir. 1904) ("In the absence of protection by patent, no person can monopolize or appropriate to the exclusion of others elements of mechanical construction which are essential to the successful practical operation of a manufacture, or which primarily serve to promote its efficiency for the purpose to which it is devoted.").
\item \textsuperscript{64} See, e.g., Candee, Swan & Co. v. Deere & Co., 54 Ill. 439, 461 (1870) ("[The inventors of a plow] have no patent upon any portion of their plows; any one, therefore, has a perfect right to make plows in their exact similitude, even to 'the curve of the mould board' and 'the tip of the handles'—in the minutest, as well as in the most important points . . . .").
\item \textsuperscript{65} See, e.g., Weinstock, Lubin & Co. v. Marks, 42 P. 142, 145 (Cal. 1895) (enjoining the use of putatively distinctive building design).
\end{itemize}
loaf of bread, while the Georgia common law supported an injunction against the defendant's use of (presumably functional) "glacine paper" for its packaging.

Of greatest importance, however, it also led to the Seventh Circuit's application of Illinois law to product configurations that ultimately produced the Sears-Compco doctrine. Sears, Roebuck & Co. v. Stiffel Co. and Compco Corp. v. Day-Brite Lighting, Inc. each involved appeals from holdings by the Seventh Circuit that the defendants' copying of unpatented lighting fixtures was actionable under Illinois unfair competition law. Both cases presented apparently intentional copying of designs originally covered by patents but left unprotected by federal law after the patents' invalidation. In each, the Supreme Court reversed the Seventh Circuit, holding that state protection under these circumstances impermissibly conflicted with federal policy.

The decisions differed, however, in the means used to achieve this end. Noting that the Intellectual Property Clause was meant to supersede the haphazard grant of monopolies by the states, the Sears Court held that passage of the federal patent laws preempted any state action in the area under the Supremacy Clause. Applying this rule to the facts before it, the Court concluded that "just as a State cannot encroach upon the 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 federal patent laws."

Notwithstanding the Court's reliance on the Supremacy Clause in Sears, its decision on the same day in Compco made

70. Sears, 376 U.S. at 227; Compco, 376 U.S. at 236.
71. In both cases, the plaintiffs had secured design patents covering their configurations, while the plaintiff in Sears also had received a utility patent. Each, however, was invalidated at the district court level. See Sears, 376 U.S. at 225-26; Compco, 376 U.S. at 234-35.
72. Sears, 376 U.S. at 229-30.
73. Id. at 230-31. The Supremacy Clause, U.S. CONST. art. VI, cl. 2, mandates the invalidation, on preemption grounds, of any state law whose enforcement "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." Hines v. Davidowitz, 312 U.S. 52, 67 (1941).
74. Sears, 376 U.S. at 231.
no reference whatsoever to that provision.75 Rather, in reaching the same result, namely that state law could not prohibit the copying of unpatented articles, the Compco Court concluded that "[t]o forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."76 By linking its holding directly to the Intellectual Property Clause, Compco recognized a constitutional foundation for the right to copy product configurations, with liability possible only if a defendant's labeling failed to eliminate the risk of confusion caused by its copying of distinctive nonfunctional elements of the plaintiff's design.77

Compco's analysis, however, did not stop with a recognition of the right to copy as a mandate of the nation's organic law. Rather, by directly applying a restriction found in Article I of the Constitution to the states, the Court reached a second constitutional holding that became the focus of most subsequent treatment of the decision. Had the Court meant to limit its holding to a statement on federal-state relations, the obvious

75. Compco's omission of any reference to the Supremacy Clause often is overlooked by courts and commentators alike. See, e.g., Kohler Co. v. Moen Inc., 12 F.3d 632, 640 (7th Cir. 1993) ("[N]o Lanham Act issue was raised in either Sears or Compco; the decision in each case was based on the Supremacy Clause."); Time Mechanisms, Inc. v. Qonaar Corp., 422 F. Supp. 905, 911 (D.N.J. 1976) ("The focus of both Sears and Compco . . . was the Supremacy Clause of the Constitution . . . ."); Jay Dratler, Jr., Trademark Protection for Industrial Designs, 1988 U. ILL. L. REV. 887, 919 ("[T]he [Sears and Compco] decisions involved no issue of federal trademark law; they were based strictly on the supremacy clause.") (footnote omitted)); Dan Rosen, A Common Law for the Ages of Intellectual Property, 38 U. MIAMI L. REV. 769, 776 (1984) ("In both [Sears and Compco], the Court concluded that the supremacy clause of the Constitution prevented states from contradicting the federal intellectual property laws."); Gary Schuman, Trademark Protection of Container and Package Configurations—A Primer, 59 CHI.-KENT L. REV. 779, 792 (1983) ("The focus of both Sears and Compco was the Supremacy Clause of the Constitution . . . .").

76. 376 U.S. at 237 (emphasis added).

77. See id. at 238. The efficacy of labeling as a means for reducing confusion in the marketplace since has been the subject of debate. Compare Bose Corp. v. Linear Design Labs., Inc., 467 F.2d 304, 310 (2d Cir. 1972) ("[T]here is hardly likelihood of confusion or palming off when the name of the manufacturer is clearly displayed.") with T & T Mfg. Co. v. A.T. Cross Co., 449 F. Supp. 813, 822-23 (D.R.I.) (disparaging use of disclaimers generally and noting that in trade dress context in particular "[d]isplay of the infringer's name . . . is least likely to avoid confusion when the infringement involves the design of the item itself and not the package or the tradename"), aff'd, 587 F.2d 533 (1st Cir. 1978), cert. denied, 441 U.S. 908 (1979).
analysis would have been to hold, as the Court did in Sears, that the incompatibility of the state laws with federal patent laws rendered the former void under the Supremacy Clause.\textsuperscript{78} Indeed, in light of the Court's practice of avoiding direct constitutional conflicts, such an approach might be expected.\textsuperscript{79} Yet, the Compco Court skirted this analysis and instead expressly rested the outcome on the Supremacy Clause's far more obscure cousin, the Intellectual Property Clause.

In contrast to classic preemption cases, therefore, a holding of invalidity under the Constitution did not necessarily turn on the prior congressional passage of a federal statute\textsuperscript{80} having national effect under the Supremacy Clause. In this departure, Compco's second holding invalidated the state policies at issue not merely because they conflicted with a federal statutory regime, but because their limits on the copying of functional features violated the Constitution itself.\textsuperscript{81} At first blush,

\begin{quote}
\textsuperscript{78} To the extent that the relevant state laws imposed an inordinate burden on interstate commerce, the Court might also have relied upon the Commerce Clause in reaching its result. See generally Bibb v. Navajo Freight Lines, Inc., 359 U.S. 520, 529-30 (1959) (invalidating state law requiring use of contoured mudguards on trucks as impermissible burden on interstate commerce).

\textsuperscript{79} See American Communications Ass'n v. Douds, 339 U.S. 382, 407 (1950) ("[I]t is the duty of this Court to construe a statute so as to avoid the danger of unconstitutionality if it may be done in consonance with the legislative purpose."); see also United States v. CIO, 335 U.S. 106, 120-21 (1948) ("The obligation rests also upon this Court in construing congressional enactments to take care to interpret them so as to avoid a danger of unconstitutionality."); United States v. Delaware & Hudson Co., 213 U.S. 366, 407 (1909) ("[I]f the statute be reasonably susceptible of two interpretations ... it is our plain duty to adopt that construction which will save the statute from constitutional infirmity.").

\textsuperscript{80} For an explanation of this interpretation of Sears-Compco, see EDMUND W. KITCH & HARVEY S. PERLMAN, LEGAL REGULATION OF THE COMPETITIVE PROCESS 48 (3d ed. 1986). These commentators have noted the Sears Court's decision not merely to extend the rule stated in such cases as Singer Manufacturing Co. v. June Manufacturing Co., 163 U.S. 169 (1896) and Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938), namely that the expiration of a utility patent leaves the underlying technology open for misappropriation: The Court could have simply extended that position to designs covered by invalid as well as expired patents on the theory that the act of obtaining a patent constituted a dedication of the disclosure of the patent to public use. But the Court in its discussion put no weight on the fact that there was an invalid patent covering the pole lamp. Rather the Court relied upon the existence of the patent system itself without regard to whether the particular design had been patented. KITCH & PERLMAN, supra, at 48.

\textsuperscript{81} As the Fifth Circuit noted in an application of Compco's second holding, "[i]t runs counter to federal purposes, and perhaps borders on the unconstitu-
therefore, Compco's direct application to the states of a constitutional restriction appeared nothing less than a commercial law equivalent of the Court's "incorporation" of selected provisions of the Bill of Rights into the Due Process Clause.\footnote{383 U.S. 1 (1966).}

Significantly, the Warren Court's next substantive treatment of the Intellectual Property Clause left little doubt that Compco's first holding—that the Constitution contains affirmative restrictions on the scope of protection available to functional configurations—was not inadvertent. Two years after Sears and Compco, in Graham v. John Deere Co.,\footnote{383 U.S. 1 (1966).} the Court addressed the utility patent statute restricting federal protection to nonobvious inventions.\footnote{The statute provides for the rejection of applications if "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103 (1994).} Declining simply to interpret the statute, however, the Court prefaced its holding of invalidity by observing that the Intellectual Property Clause "is both a grant of power \textit{and a limitation}. . . . The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or

\textit{tional}, for a state to prolong or to create any trade monopoly to an originator by forbidding the production of copies under the rubric of unfair competition." B.H. Bunn Co. v. AAA Replacement Parts Co., 451 F.2d 1254, 1258-59 (5th Cir. 1971) (emphasis added).

\footnote{Although, like the Intellectual Property Clause, the Bill of Rights on its face applies only to the federal government, the Supreme Court, beginning in Palko v. Connecticut, 302 U.S. 319 (1937), expressly has held that certain provisions of the first eight amendments apply to the states through their "incorporation" into the Due Process Clause of the Fourteenth Amendment. See, e.g., Everson v. Board of Educ., 330 U.S. 1, 15-16 (1947) (applying First Amendment Establishment Clause to states through the Fourteenth Amendment). Viewed in light of the Warren Court's acceleration of this process in the early 1960s, Compco's direct reference to the Intellectual Property Clause as a ground for the invalidation of a state practice, rather than to the interplay of a federal statute and the Supremacy Clause, is hardly surprising. See, e.g., Pointer v. Texas, 380 U.S. 400, 403-06 (1965) (Sixth Amendment right to confront witnesses); Malloy v. Hogan, 378 U.S. 1, 3 (1964) (Fifth Amendment right against self-incrimination); Gideon v. Wainwright, 372 U.S. 335, 339-45 (1963) (Sixth Amendment right to counsel); Robinson v. California, 370 U.S. 660, 667 (1962) (Eighth Amendment protection against cruel and unusual punishment); Mapp v. Ohio, 367 U.S. 643, 650-53 (1961) (Fourth Amendment protection against unreasonable search and seizure).}
social benefit gained thereby.\textsuperscript{85} Graham therefore provided the federal law counterpart to Compco's application of the Intellectual Property Clause.

2. Post-Compco Erosion of the Direct Application of the Intellectual Property Clause to the States

Unfortunately, the continued significance to federal law of both Compco's first constitutional holding and the Court's observations in Graham largely has been obscured by the Court's ultimate rejection of the second step of the Compco analysis, namely the direct application of a constitutional nonfunctionality requirement to state unfair competition law. The Court began to back off Compco's theory of the Intellectual Property Clause as an affirmative bar to state protection of intellectual property rights in Goldstein v. California,\textsuperscript{86} decided nearly a decade after Sears and Compco.\textsuperscript{87} In Goldstein, the Court confronted a state statute criminalizing the piracy of sound recordings, which were then not covered by federal copyright law.\textsuperscript{88} The Goldstein petitioners challenged the statute's validity under a variety of theories, including a statutory preemption claim of the sort adopted in Sears.\textsuperscript{89} They also, however, advanced a claim grounded in Compco's second constitutional holding, namely that the state legislation directly conflicted with the Intellectual Property Clause itself.\textsuperscript{90}

The Court dismissed this latter argument, but did so in a manner that left fully intact Compco's first constitutional holding. With respect to the constitutional preemption

\textsuperscript{85} 383 U.S. at 5-6 (emphasis added).
\textsuperscript{86} 412 U.S. 546 (1973).
\textsuperscript{87} This retreat was perhaps signaled by dictum in Justice Harlan's opinion for the Court in Lear, Inc. v. Adkins, 395 U.S. 653 (1969), to the effect that, Sears and Compco notwithstanding, the states retained the power to enforce a royalty agreement for an unpatentable invention during the pendency of a patent application. \textit{See id.} at 674-75 (dictum).
\textsuperscript{88} During the pendency of the state criminal proceedings under the state statute that led to the convictions of the petitioners in Goldstein, Congress amended the federal copyright laws to encompass unauthorized copying of sound recordings. \textit{See} Pub. L. No. 92-140, 85 Stat. 391 (1971). The effective date of the federal amendments, however, did not sweep the petitioners' activities within the scope of federal law. \textit{See} 412 U.S. at 551-52.
\textsuperscript{89} 412 U.S. at 551.
\textsuperscript{90} \textit{See id.}
claims, the Court concluded that "[t]he clause of the Constitution granting to Congress the power to issue copyrights does not provide that such power shall vest exclusively in the Federal Government. Nor does the Constitution expressly provide that such power shall not be exercised by the States." Significantly, however, the *Goldstein* Court did not question the proposition that the Intellectual Property Clause contains substantive restrictions as well as enumerated powers, but instead concluded only that "whatever limitations have been appended to such powers can only be understood as a limit on congressional, and not state, action."

This trend continued in the Court's next opinion to address the issue, *Kewanee Oil Co. v. Bicron Corp.* Unlike the product configurations at issue in *Sears* and *Compco* and the sound recordings in *Goldstein*, *Kewanee* addressed the constitutional limits on state protection of trade secrets. The subject of the litigation was an Ohio statute criminalizing the misappropriation of trade secrets, which the Sixth Circuit held was legislatively preempted by federal patent laws, creating a split with the Second, Fourth, Fifth, and Ninth Circuits.

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91. As to the petitioners' statutory claims, the Court concluded that, unlike the federal patent regime addressed by *Sears* and *Compco*, the then-extant copyright act did not expressly provide for the ineligibility for protection of the pirated goods. In the absence of such statutory guidance, the Court held that federal copyright statutes were not so pervasively broad that they precluded the states from protecting the materials at issue. *Id.* at 561-70.

92. *Id.* at 553.

93. *Id.* at 560 (emphasis added).


95. Under the definition accepted by the *Kewanee* Court:

> A trade secret may consist of any formula, pattern, device or compilation of information which is used in one's business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it. It may be a formula for a chemical compound, a process of manufacturing, treating or preserving materials, a pattern for a machine or other device, or a list of customers.

*Id.* at 474-75 (quoting *RESTATEMENT OF TORTS* § 757 cmt. b (1939)).

96. *Kewanee Oil Co. v. Bicron Corp.*, 478 F.2d 1074 (6th Cir. 1973), *rev'd*, 416 U.S. 470 (1974). Curiously, although ultimately framing its discussion in statutory preemption terms, the Sixth Circuit opened its discussion with the observation that "there is a very serious and important issue of a claimed conflict with the provisions of the Constitution of the United States relating to Patents, Article I, Section 8 (Clause 8)." *Id.* at 1078.

In overturning this result, the Supreme Court employed much the same analysis as it had in *Goldstein*. The Court began with the premise that "[t]he only limitation on the States is that in regulating the area of patents and copyrights they do not conflict with the operation of the laws in this area passed by Congress . . . ." The Court concluded that the state legislation afforded a lower degree of protection than did the utility patent statutes and therefore did not conflict with federal law. Moreover, and in contrast to its holding in *Sears* that the pervasiveness of federal patent law in and of itself preempted state protection, the *Kewanee* Court relied on the absence of an express preemptive intent by Congress.

The Court retreated still further from *Compco*'s constitutional preemption analysis in *Aronson v. Quick Point Pencil Co.* *Aronson* arose from the Eighth Circuit's invalidation of a license covering a device for which the Patent and Trademark Office had denied a utility patent. The Supreme Court reversed, however, citing three general principles of "federal patent law" that were not expressly grounded either in the Intellectual Property Clause, the Supremacy Clause, or any federal statute:

First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent protection seek to assure that ideas in the public domain remain there for the free use of the public.

The death knell of constitutional preemption occurred in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, a decision that, ironically, reaffirmed *Compco*'s first constitutional holding. In the wake of *Goldstein* and *Kewanee*, most courts and commentators not only disparaged the Intellectual Property Clause as anything but a grant of powers, but even disregarded the

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(9th Cir. 1970), cert. denied, 402 U.S. 945 (1971).
98. 416 U.S. at 479.
99. See id. at 490 ("Where patent law acts as a barrier, trade secret law functions relatively as a sieve.").
100. See id. at 493 ("Congress, by its silence over these many years, has seen the wisdom of allowing the States to enforce trade secret protection.").
103. 440 U.S. at 262.
statutory preemption analysis found in Sears. An exception to this rule, however, was the Florida Supreme Court, which in 1987 held its state's prohibition against direct molding in the boat industry preempted by federal law.

In affirming the Florida Supreme Court and disapproving the Federal Circuit's contrary interpretation of a similar California statute, the Bonito Boats Court adopted an approach that diverged from Compco's treatment of the Intellectual Property Clause. Addressing the preemption question, the Court

105. See, e.g., Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 526 n.7 (10th Cir. 1987) (declining to apply Sears-Compco on ground that states clearly retain "the ability to prohibit infringement of ... trade dress indicating a product's origin"); Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1214 (8th Cir.) (characterizing preemptive statements in Sears and Compco as "dictum"), cert. denied, 429 U.S. 861 (1976); see also 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 7:25, at 232-33 (2d ed. 1984) ("[I]t is difficult to discern exactly what, if anything, is left of Sears-Compco policy."); Robert C. Denicola, Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 MINN. L. REV. 707, 724 n.88 (1983) ("With surprising pluck, several courts have simply rejected the rationale of Sears and Compco and continued to offer protection under state unfair competition law."); Dratler, supra note 75, at 917 (noting that "many lower courts [sic] refuse to construe the Sears/Compco decisions broadly; some have distinguished them, and others have virtually ignored them"); Beverly W. Pattishall, The Lanham Trademark Act—Its Impact Over Four Decades, 76 TRADEMARK REP. 193, 206 (1986) ("During the twenty-one years since Sears and Compco, nearly all of the law that has referred to their doctrine has effectively diminished rather than enlarged their scope.").


107. See Interpart Corp. v. Italia, 777 F.2d 678 (Fed. Cir. 1985). The Interpart court upheld the direct molding statute before it on the ground that "[t]he statute prevents unscrupulous competitors from obtaining a product and using it as the 'plug' for making a mold. ... [T]he patent laws 'say nothing about the right to copy or the right to use, they speak only in terms of the right to exclude.'" Id. at 685 (quoting Mine Safety Appliances Co. v. Electric Storage Battery Co., 405 F.2d 901, 902 n.2 (C.C.P.A. 1969)). After the Federal Circuit's decision in Interpart, but before the Supreme Court's decision in Bonito Boats, a California state appellate panel relied on the Federal Circuit's holding to similar effect in concluding that the California plug-molding statute was not preempted by federal patent law. See Gladstone v. Hillel, 250 Cal. Rptr. 372, 378-79 (Cal. Ct. App. 1988).
employed a statutory, rather than a constitutional, analysis in
holding the Florida statute fatally incompatible with federal
patent laws and therefore invalid under the Supremacy
Clause.\textsuperscript{108} Indeed, \textit{Bonito Boats} closed the door on an issue
that the Court’s post-\textit{Compco} decisions had not expressly
resolved, namely whether the Intellectual Property Clause
operates as an affirmative restriction on state action:

Our decisions since \textit{Sears} and \textit{Compco} have made it clear that the
Patent and Copyright Clauses do not, by their own force or by negative
implication, deprive the States of the power to adopt rules for the
promotion of intellectual creation within their own jurisdictions. Thus,
where Congress determines that neither federal protection nor freedom
from restraint is required by the national interest, the States remain
free to promote originality and creativity in their own domains.\textsuperscript{109}

Although finalizing the Court’s retreat from \textit{Compco}'s
constitutional preemption analysis, \textit{Bonito Boats} did nothing in
conflict with either \textit{Compco}'s other constitutional holding or the
Court’s observations in \textit{Graham}, namely that the Intellectual
Property Clause contains substantive restrictions on the federal
protection available to functional configurations. Indeed, the
Court went so far as to cite with approval \textit{Compco}'s statement
of nonfunctionality as a constitutional, rather than a statutory,
requirement,\textsuperscript{110} and was equally careful to reaffirm that “the
Clause contains both a grant of power \textit{and certain limitations
upon the exercise of that power}.”\textsuperscript{111} Whatever the continuing
viability of preemption under Article I, the principle that it is
“implicit in the [Intellectual Property] Clause itself[that] free
exploitation of ideas will be the rule, to which the protection of
a federal patent is the exception,”\textsuperscript{112} remains alive and well
even after the Court’s retreat from \textit{Compco}'s second holding.

\begin{footnotesize}
\begin{enumerate}
\item \textsuperscript{108} 489 U.S. at 165-68.
\item \textsuperscript{109} \textit{Id.} at 165 (quotations and citations omitted).
\item \textsuperscript{110} \textit{See id.} at 153. The Court explained its reasons for having invalidated
the application of state law at issue in \textit{Compco}:

With some notable exceptions, including the interpretation of the
Illinois law of unfair competition at issue in \textit{Sears} and \textit{Compco}, the
common-law tort of unfair competition has been limited to protection
against copying of \textit{nonfunctional aspects of consumer products} which
have acquired secondary meaning such that they operate as a
designation of source.

\textit{Id.} at 157-58 (citations omitted and emphasis added).
\item \textsuperscript{111} \textit{Id.} at 146 (emphasis added).
\item \textsuperscript{112} \textit{Id.} at 151.
\end{enumerate}
\end{footnotesize}
3. Functionality and Federal Law in the Wake of Sears-Compco-Bonito Boats

For the most part, federal courts hearing trade dress cases under the Lanham Act after Sears-Compco have applied a nonfunctionality requirement of some sort. Protection therefore will not attach to a particular design "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage." Under this standard, a utility patent covering a design in which trade dress significance is alleged is very strong, if not conclusive, evidence of functionality. Other relevant


114. Qualitex, 115 S. Ct. at 1304 (quoting Inwood Labs., 456 U.S. at 850 n.10); see also RESTATEMENT, supra note 21, § 17, at 172 ("A design is 'functional'... if the design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used... that are important to effective competition by others and that are not practically available through the use of alternative designs.").

Significantly, the fact that a particular feature performs some function is not dispositive of functionality within the meaning of trade dress law:

[Trade dress doctrine] separates the term "functional" into two parts, de jure and de facto, which may be distinguished, in part, according to the degree of utility present in the design of the product.

In essence, de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid. De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape. This distinction is useful because the configuration of a product is not necessarily lacking in trademark significance because of "the mere existence of utility"; rather, it should depend on "the degree of design utility."


115. See, e.g., In re Telesco Brophrey Ltd., 170 U.S.P.Q. (BNA) 427, 428 (T.T.A.B. 1971) ("[A] utility patent comprehending the configuration in question is adequate evidence to establish that the configuration is indeed functional in character."); see also In re Bose Corp., 772 F.2d 866, 871-72 (Fed. Cir. 1985) (buttressing a holding that the design in question was primarily utilitarian by referring to a utility patent covering the identical configuration); In re Shenango Ceramics, Inc., 362 F.2d 287, 291-92 (C.C.P.A. 1966) (same); In re Oscar Mayer
factors typically have included whether the design owner has touted utilitarian advantages of its product in its advertising,\textsuperscript{116} whether acceptable alternatives exist,\textsuperscript{117} and whether the design results from a comparatively simple or inexpensive method of manufacture,\textsuperscript{118} or is necessary to conform to industry standards.\textsuperscript{119}


\textsuperscript{116} See, e.g., American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1142 (3d Cir. 1986) ("If the marketer of a product advertises the utilitarian advantages of a particular feature, this constitutes strong evidence of its functionality."); In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1341 (C.C.P.A. 1982) (holding probative of functionality that "the originator of the design touts its utilitarian advantages through advertising"); Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980) (holding plaintiff's putative trade dress functional on showing that plaintiff's "advertising [repeatedly and predominantly] emphasize[s] the functional nature" of its product).

\textsuperscript{117} See RESTATEMENT, supra note 21, § 17, at 172; see also Clamp Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512, 516 (9th Cir.) (holding evidence of alternative designs probative on issue of functionality), cert. denied, 493 U.S. 872 (1989); In re Bose Corp., 772 F.2d 866, 872 (Fed. Cir. 1985) (same); New England Butt Co. v. International Trade Comm'n, 756 F.2d 874, 878 (Fed. Cir. 1985) (same); Textron, Inc. v. United States Int'l Trade Comm'n, 753 F.2d 1019, 1026 (Fed. Cir. 1985) (noting lack of evidence that alternative designs could perform a similar function without increased cost in upholding finding of functionality).

Perhaps significantly, the existence of alternative designs will not necessarily dispose of a defendant's claims of functionality. See Keene Corp. v. Paraflex Indus., Inc., 653 F.2d 822, 827 (3d Cir. 1981) ("[M]erely because there are other shapes and designs 'which defendant could use and still produce a workable' product, the design used is not thereby non-functional.") (quoting Vaughan Novelty Mfg. Co. v. G.G. Greene Mfg. Corp., 202 F.2d 172, 175 n.10 (3d Cir.), cert. denied, 346 U.S. 820 (1953)). Rather, the real inquiry is whether the putative trade dress at issue "has been or can be designed in an alternative manner and work as well, at an equivalent cost." Textron, 753 F.2d at 1026.

\textsuperscript{118} See, e.g., Bose Corp., 772 F.2d at 873 (finding the shape of a loudspeaker enclosure functional largely because it conformed to the shape of the speaker's sound matrix); see also J.R. Clark Co. v. Murray Metal Prods. Co., 219 F.2d 313, 320 (5th Cir. 1955) (holding plaintiff's putative trade dress functional because product appearance was merely a cost-effective "result of a well known manufacturing process").

\textsuperscript{119} See, e.g., John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 984 n.31 (11th Cir. 1983) (stating that the size and shape of a check stub may be functional "because check companies often fill reorders from consumers who initially had obtained their check products from a competitor"); see also New England Butt Co., 756 F.2d at 879 (finding complainant's design functional in part on showing that the putative infringer "was compelled by competitive necessity to copy because [its] customers ... insisted that their ... machine's parts be interchangeable with those of [the complainant]"); Deere & Co. v. Farmhand, Inc., 560 F. Supp. 85, 91-92 (S.D. Iowa 1982) (holding "John Deere green" functional in light of evidence of industry preference for matching equipment), aff'd, 721 F.2d 253 (8th Cir. 1983) (per curiam).
These cases, however, have left unresolved two critical substantive issues, the first of which concerns the doctrinal underpinnings of the nonfunctionality requirement. Specifically, most federal courts have concluded that in articulating the Sears-Compco doctrine "the Supreme Court did not purport to consider or decide the boundaries between federal patent law and federal trademark law." The result is that a "suit brought under ... the Lanham Act survives the stringent limitations on state unfair competition laws imposed by the decisions of the Supreme Court." Having mistaken the Court's retreat from Compco's constitutional preemption analysis for a retreat from the substantive restrictions of the Intellectual Property Clause recognized by that case and its progeny, these courts have failed to address, much less to resolve, the issue of

120. In addition to the substantive issues unresolved under current trade dress doctrine that are discussed infra at notes 121-144 and accompanying text, a split in the circuits exists on the procedural question of which party bears the burden of proof on the issue of functionality. See RESTATEMENT, supra note 21, § 17 cmt. b, at 181. For representative cases treating nonfunctionality as an element of the plaintiff's prima facie case, see Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co., 963 F.2d 628, 633 (3d Cir. 1992); Ferrari SPA Esercizio Fabbriche Automobili E Corse v. Roberts, 944 F.2d 1235, 1239 (6th Cir. 1991), cert. denied, 112 S. Ct. 3028 (1992); Clamp Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512, 516 (9th Cir.), cert. denied, 493 U.S. 872 (1989); Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 716 F.2d 854, 857 (11th Cir. 1983); Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980) (dictum). Cases treating functionality as an affirmative defense to be established by the defendant include: Badger Meter, Inc. v. Grinnell Corp., 13 F.3d 1145, 1151 (7th Cir. 1994); Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1271 n.3 (10th Cir.), cert. denied, 488 U.S. 908 (1988); Stormy Clime Ltd. v. ProGroup, Inc., 809 F.2d 971, 974 (2d Cir. 1987); see also Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 863 (1982) (White, J., concurring) ("Functionality is a defense to a suit under § 43(a) of the Lanham Act."); cf. In re Teledyne Indus., 936 F.2d 966, 971 (Fed. Cir. 1992) (holding in context of trademark application process that Patent and Trademark Office bears initial burden of demonstrating functionality).


As one court has explained this consensus:

The potential for conflict between the patent law and the law governing unfair competition is further reduced by the enactment of section 43(a) of the Lanham Act, since that federal statute represents a congressional determination that the public should be protected from potentially confusing or misleading indicia of source of origin, including trade dress. The federalization of this body of law thus entirely avoids the immediate thrust of Sears-Compco.

why the Lanham Act does not supersede or augment the protection afforded to functional features under utility patent law.\textsuperscript{123} Although it may be true that "it is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time,"\textsuperscript{124} it is equally true that, as a matter of statutory law, there is nothing to prevent Congress from altering this balance.\textsuperscript{125}

Indeed, although some courts have concluded that a nonfunctionality requirement is necessary to prevent a statutory clash between the utility patent and trademark laws,\textsuperscript{126} others have been less inclined to recognize such a conflict.\textsuperscript{127} Thus, for example, in Shakespeare Co. v. Silstar Corp. of America,\textsuperscript{128} the Fourth Circuit concluded that the Lanham Act expressly eliminates defendants' access to the functionality doctrine in certain cases involving federal trade dress registrations.\textsuperscript{129}

\begin{itemize}
\item \textsuperscript{123} Cf. Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1215 (8th Cir.) (distinguishing protection afforded by Lanham Act from patent protection on ground that trade dress protection "may be extended in perpetuity"), cert. denied, 429 U.S. 861 (1976).
\item \textsuperscript{125} See, e.g., Picard v. United Aircraft Corp., 128 F.2d 632, 643 n.22 (2d Cir.) (addressing, in dictum, the possibility of Congress authorizing grants of patents to noninventors under the Commerce Clause), cert. denied, 317 U.S. 651 (1942); see also 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 7.25[4], at 7-109 to 7-111 (3d ed. 1993) (discussing plaintiffs' ability to avoid Sears/Compco preemption issues by grounding their claims on the Lanham Act).
\item \textsuperscript{126} See, e.g., W.T. Rogers Co. v. Keene, 778 F.2d 334, 337 (7th Cir. 1985) (upholding protection of plaintiffs trade dress under Lanham Act, but noting that "provided that a defense of functionality is recognized, there is no conflict with federal patent law").
\item \textsuperscript{127} See S. Stephen Hilmy, Note, Bonito Boats' Resurrection of the Preemption Controversy: The Patent Leverage Charade and the Lanham Act "End Around," 69 Tex. L. Rev. 729, 754-55 (1991) ("[T]he lower [federal] courts have managed, with considerable interpretive effort, to read section 43(a) of the Lanham Act as a vehicle for accomplishing precisely what Sears-Compco had formerly precluded, namely, prohibiting the copying and sale of unpatented and uncoprighted articles in the public domain." (footnotes omitted)).
\item \textsuperscript{128} 9 F.3d 1091 (4th Cir. 1993), cert. denied, 114 S. Ct. 2134 (1994).
\item \textsuperscript{129} In Shakespeare, the plaintiff had secured a federal trade dress registration covering the design of its fishing rod and subsequently sought to enforce its trade dress rights against a competitor using a similar design. Before the District Court, the defendant initially succeeded in canceling the plaintiff's federal registration on the ground that the registration covered a functional design. See Shakespeare Co. v. Silstar Corp. of Am., 802 F. Supp. 1386 (D.S.C. 1993), rev'd, 9 F.3d 1091 (4th Cir. 1993), cert. denied, 114 S. Ct. 2134 (1994). On appeal, however, the Fourth Circuit held that by providing
Similarly, in *Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts*, the Sixth Circuit examined Compco's observation that "a defendant can copy at will if the design is 'not entitled to a design patent or other federal statutory protection'" and concluded that the Lanham Act is just such "other statutory protection." As the *Ferrari* court stated, "[b]ecause trademark law and patent law address different concerns, and because of the narrow focus of the Supreme Court's inquiry in *Compco* and *Sears*, . . . these decisions do not preclude Lanham Act protection of designs." These courts' theory of functionality would allow Congress to extend protection to functional trade dresses outside the ambit of utility patent law, just as it had enacted the Trademark Act of 1881 and its successors under the Commerce Clause, rather than the Intellectual Property Clause.

The second issue left unresolved by modern trade dress doctrine is the extent of protection available for combinations of nonfunctional and functional features. On the one extreme, the apparent majority rule among the circuits is to recognize protectable trade dress rights in overall configurations that are certain express grounds upon which federal registrations that have passed the fifth anniversary of their issuance "may" be canceled, section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3) (1994), expressly excludes all others, including the possible functionality of the underlying trade dresses. 9 F.3d at 1097 ("[I]t . . . seem[s] anomalous for Congress to enumerate specific grounds for cancellation for a five-year old registration, as it has done in § 1064, and not list functionality, if it intended functionality to serve as such a ground."); accord Kransco Mfg. Inc. v. Hayes Specialties Corp., 33 U.S.P.Q.2d (BNA) 1999, 2001 (E.D. Mich. 1994) (concluding that "functionality is not a ground upon which an incontestable trademark can be challenged").

131. Id. at 1241 (quoting Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 238 (1964)).
132. Id.
133. See A. Samuel Oddi, Consumer Motivation in Trademark and Unfair Competition Law: On the Importance of Source, 31 VILL. L. REV. 1, 17 (1986) ("Since *Sears* and *Compco* were based on the supremacy clause of the Constitution and federal preemption, this would still leave open the possibility that other federal laws, not specifically preempted, could protect against product simulation.").
134. See supra note 45 and accompanying text (noting that Congress closely followed the Court's suggestion in *The Trade-Mark Cases* to base trademark legislation on the Commerce Clause).
135. See generally 1 McCaRTHY, supra note 125, § 7.26[3][ff], at 7-134 to 7-137 (discussing trade dress law as focusing on the total image or overall impression of a product); id. § 8.01[1], at 8-1 to 8-5 (discussing protection of the combination of functional and nonfunctional features).
"primarily nonfunctional." Under this standard, "[w]hen the thing claimed as trade dress or a trademark consists of a combination of individual design features, then it is the functionality of the overall combination that controls." In jurisdictions adhering to this principle, defendants may be subject to broad injunctions prohibiting them from copying entire articles, even if those articles include functional elements unprotected by utility patent law.

Other courts have applied a two-tiered standard for functionality that turns on the nature of the particular trade dress at issue. Under this rule, if a would-be plaintiff's trade dress consists of the packaging for its product, it may include both functional and nonfunctional components, and the appropriate inquiry is the functionality of the trade dress as a whole. The standard is different, however, if a claimant


137. As Learned Hand summarized this rule in a pre-Sears-Compco case, "We usually confine relief to 'nonfunctional' elements, because the defendant will suffer nothing by abandoning them; but it does not inevitably follow that only these may be included." Wesson v. Galef, 286 F. 621, 623 (S.D.N.Y. 1922); see also CPG Prods. Corp. v. Pegasus Luggage, Inc., 776 F.2d 1007, 1013-14 (Fed. Cir. 1985) (applying Eleventh Circuit law to uphold injunction against entire product line); Robarb Inc. v. Pool Builders Supply, 21 U.S.P.Q.2d (BNA) 1743, 1746 (N.D. Ga. 1991) ("Specific elements that are separately functional and thus unprotected can be protected as part of a trade dress which, as a whole may be protectable.").

138. See, e.g., In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1342 (C.C.P.A. 1982) (discussing protectability of packaging that has both functional and nonfunctional elements).


140. This rule presupposes that the applicant is seeking to protect the appearance of its packaging as a trademark for the enclosed goods, rather than for the configuration of the packaging itself. Although it is common for "a"
alleges protectable rights in the design of a product itself, as “before an overall product configuration can be recognized as a trademark, the entire design must be arbitrary or non de jure functional.” Although this distinction originally arose in the federal registration and import exclusion contexts, some jurisdictions have begun to apply it in infringement litigation involving unregistered trade dresses. Carried to its limits, this rule mandates that “unique arrangements of purely functional features constitute a functional design not entitled as a matter of law to protection under the Lanham Act,” without regard to whether the unique arrangements themselves are nonfunctional.

To date, the Supreme Court has declined to provide express guidance on this issue. In the landmark case of Two Pesos, Inc. v. Taco Cabana, Inc., the Court resolved a split in the circuits on whether inherently distinctive trade dress could be protected in the absence of so-called “secondary meaning” or an

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141. Textron, Inc. v. United States Int'l Trade Comm'n, 753 F.2d 1019, 1025 (Fed. Cir. 1985); accord Petersen Mfg. Co. v. Central Purchasing, Inc., 740 F.2d 1541, 1550 (Fed. Cir. 1984) (stating that an overall design is not protectable, i.e., non de jure functional, merely because it includes some arbitrary features).


143. See, e.g., Clamp Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512, 516 (9th Cir.) (“For an overall product configuration to be recognized as a trademark, the entire design must be nonfunctional.”); cert. denied, 493 U.S. 872 (1989); Ohio Art Co. v. Lewis Galoob Toys, Inc., 799 F. Supp. 870, 884 (N.D. Ill. 1992) (“For this court to recognize the overall product configuration of the [plaintiff's] toy as a trademark, the entire design must be arbitrary or nonfunctional.”); Tenax Corp. v. Tensar Corp., 19 U.S.P.Q.2d (BNA) 1881, 1888-89 (D. Md. 1991) (same). Thus, under these cases, a plaintiff must prove that the particular features allegedly copied by the defendant are nonfunctional. See, e.g., Gale Group, Inc. v. King City Indus. Co., 23 U.S.P.Q.2d (BNA) 1208, 1212 (M.D. Fla. 1992) (holding that although the individual parts of plaintiff's product each had a functional purpose, the distinctive arrangement of certain parts within the product provided a “total image” that was not entirely functional).

144. Rachel v. Banana Republic, Inc., 831 F.2d 1503, 1506 (9th Cir. 1987) (citations and quotations omitted).

acquired distinctiveness as an indicator of origin.\textsuperscript{146} Although holding that inherently distinctive trade dresses are entitled to protection immediately upon adoption,\textsuperscript{147} the \textit{Two Pesos} Court

\textsuperscript{146} See supra note 23 and accompanying text (describing the distinctiveness requirement for trade dress protection).

Prior to the Supreme Court's opinion in \textit{Two Pesos}, the Fifth and Eleventh Circuits had been the most strident advocates of the protection of inherently distinctive trade dress. See, e.g., AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1535 (11th Cir. 1986) (affirming finding that plaintiff's trade dress was inherently distinctive and therefore protectable in the absence of secondary meaning on the ground that "the ... trade dress is not a basic shape of common design"), cert. denied, 481 U.S. 1041 (1987); Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695, 702 (5th Cir. Unit A 1981) ("If the features of the trade dress sought to be protected are arbitrary ... there is no reason to require a plaintiff to show consumer connotations associated with such arbitrarily selected features."); cert. denied, 457 U.S. 1126 (1982). In contrast, the Second Circuit had long required a demonstration of secondary meaning for all trade dresses, without consideration of the extent to which they might be inherently distinctive. See LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985); Vibrant Sales, Inc. v. New Body Boutique, Inc., 652 F.2d 299, 303-04 (2d Cir. 1981) (noting that because the section of the Lanham Act covering trade dress, 15 U.S.C. § 1125(a), is the only section of the Act not limited to registered marks, a plaintiff seeking to protect an unregistered trade dress must show secondary meaning to secure relief), cert. denied, 455 U.S. 909 (1982).

\textsuperscript{147} \textit{Two Pesos}, 112 S. Ct. at 2758-59. Perhaps significantly, certain courts and commentators have concluded that this principle is entitled to reduced force in cases involving putative trade dress in (presumably primarily functional) product configurations. See, e.g., Duraco Prods., Inc. v. Joy Plastic Enters., 40 F.3d 1431, 1450 (3d Cir. 1994) ("Protecting a product configuration without a showing of secondary meaning because the configuration is pleasant rather than because it identifies the source of the product would risk seriously transgressing the protective zones mapped by the patent laws."); Kohler Co. v. Moen Inc., 12 F.3d 632, 641 n.11 (7th Cir. 1993) ("The only distinction courts make between trade dress generally and product configuration cases in particular is to require plaintiffs asserting [the latter] to prove secondary meaning because a product's shape is never inherently distinctive."); \textit{In re DC Comics, Inc.}, 689 F.2d 1042, 1050-51 (C.C.P.A. 1982) (Nies, J., concurring) (stating that a product design must be distinctive as an indication of origin, not simply distinctive in the sense of being unusual). As the Restatement has explained, "[a]s a practical matter, ... it is less common for consumers to recognize the design of a product or product feature as an indication of source. ... Product designs are more likely to be seen merely as utilitarian or ornamental aspects of the goods." \textit{Restatement, supra} note 21, § 16 cmt. b, at 159; see also William F. Gaske, Note, \textit{Trade Dress Protection: Inherent Distinctiveness as an Alternative to Secondary Meaning}, 57 FORDHAM L. REV. 1123, 1125 (1989) (arguing that "inherent distinctiveness is a proper test for protecting a trade dress [consisting of] package design from infringement but not for protection of the design of a product itself"); 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}, 45 STAN. L. REV. 2037, 2043 (1993) ("When the mark being protected is the configuration of the product itself, to say that the design feature is not
declined to hear the second question presented by the petition for certiorari, namely "whether a business may exercise a monopoly over a 'trade dress' consisting virtually in toto of a combination of admittedly functional features on the ground that these features are combined in an 'arbitrary' fashion."148

Taken as a whole, therefore, federal applications of the nonfunctionality doctrine have not satisfactorily addressed two issues. First, why is nonfunctionality essential to protection under the Lanham Act, particularly if, as it is most commonly characterized, the doctrine is nothing more than a negative implication of a congressional decision not to extend utility patent protection to particular devices or features of those devices? And, second, is there a rational basis for determining the extent to which a plaintiff may protect functional features under the theory that its design as a whole is nonfunctional? The remaining portions of this Article argue that the Supreme Court's decision in Feist Publications, Inc. v. Rural Telephone Service Co.149 provides the key to resolving each of these questions.

II. COPYRIGHT AND THE CONSTITUTION

A. THE "SWEAT OF THE BROW" DOCTRINE

Feist arose from a split among the Circuits over the extent of federal copyright law protection available to so-called "low authorship" works reflecting low levels of originality.150 These works typically include compilations151 of information such as
descriptive of the product is simply inaccurate in the large majority of cases."

(footnote omitted)).

150. See Jane C. Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUM. L. REV. 1865, 1870 (1990) ("We have now, as we have long had, two kinds of copyright: in high authorship works, such as novels and narrative histories, . . . [and] in low authorship works, such as telephone directories and compilations of stock quotations . . . ").
151. In contrast to other types of works potentially eligible for copyright protection, compilations presuppose preexisting elements:

When an author creates a compilation, she begins with specific and identifiable preexisting elements. Those elements consist of three types: 1) elements capable of copyright protection in their own right, as in the case of a collective work; 2) elements that, for one reason or another, are in the public domain and, consequently, are not capable of independent copyright protection; and 3) elements that are incapable of achieving copyright protection alone, such as raw data or facts.
directories, databases, and mailing lists produced through industrious gathering, rather than original creation. Notwithstanding their unexciting nature, low authorship works historically have been the subject of considerable controversy under federal law and, in fact, "[t]he kind of works at issue in early copyright disputes were most often highly useful, if artistically uninspiring, works such as maps, arithmetic and grammar primers, calendars, and law books." 

For much of the twentieth century in particular, copyright law and factual compilations have been uneasy bedfellows. In substantial part, this tension results from the failure of the Copyright Act of 1909 expressly to address the extent of protection available to the original and unoriginal elements of compilations. Indeed, the 1909 Act provided only the vague guidance that "[t]he works for which copyright may be secured under this title shall include all the writings of an author." This ambiguity produced two irreconcilable lines of cases that eventually led to Feist.

The first line of cases embodied the so-called sweat of the brow doctrine, which protected factual compilations on the basis
of the labor expended in their collection. These cases were grounded in nineteenth-century jurisprudence that recognized as "a fundamental principle of the law of copyright . . . that a work, to be free from piracy, must be the result of the author's 'own labor, skill, and use of common materials and common sources of knowledge open to all men.' On one level, these cases held that a subsequent author could not merely copy facts from a prior work, even if those facts were later independently verified because to do so would misappropriate the first author's labor. Taken to an extreme, however, this theory could prevent the use of a prior work solely to confirm the defendant's own independent research.

The leading application of this principle under the 1909 Act, albeit one eventually overruled in its own jurisdiction was the Second Circuit's 1922 opinion in Jewelers' Circular Publish-
In upholding an injunction issued by then-District Judge Learned Hand, the Jewelers’ Circular court held that:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright. . . .

In contrast to the Jewelers’ Circular conception of copyright, other courts read into the 1909 Act a tacit statutory requirement of originality based on two nineteenth-century Supreme Court opinions. The first of these was The Trade-Mark Cases constitutional holding that a work must reflect originality,

166. 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922).
168. 281 F. at 88.
169. See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01 n.5, at 2-6 to 2-7 (1995) (citing federal appellate decisions). In rarer decisions, courts reached this result on their own initiative through reference to the Constitution. See, e.g., Hartford Printing Co. v. Hartford Directory & Publishing Co., 146 F. 392, 393 (C.C.D. Conn. 1906) (ultimately issuing relief against copying of directory, but noting that "in so far as [the plaintiff] merely records accurately the names of residents, with their occupations, and where to find them at home and in business, it is impossible to discover wherein the useful arts and sciences are promoted.")
170. 100 U.S. 82 (1879).
TRADE DRESS PROTECTION

namely a combination of independent creation and creativity, to fall "under the head of writings of authors." The second was the Court's definition of "author" in Burrow-Giles Lithographic Co. v. Sarony as "he to whom anything owes its origin; originator; maker," and its concomitant holding that copyright protection was limited to the "original intellectual conceptions of the author." Lower federal courts relying on these precedents "inferred the [originality] requirement from the fact that copyright protection may only be claimed by 'authors'... [and] reasoned that since an author is 'the ... creator, originator' it follows that a work is not the product of an author unless the work is original." Under these cases, therefore, a defendant could prevail if it only made use of the facts contained in the plaintiff's work, and then added its own creative expression.

Acting on the advice of the Register of Copyrights,

171. Id. at 94.
172. 111 U.S. 53 (1884).
173. Id. at 58 (quoting WORCHESTER'S DICTIONARY OF THE ENGLISH LANGUAGE 99 (1897)).
174. Id.
175. 1 NIMMER & NIMMER, supra note 169, § 2.01, at 2-6 to 2-7 (footnote omitted). Perhaps significantly, however, courts adopting this principle under the 1909 Act frequently eviscerated it by then applying extremely low standards for finding the required originality. See, e.g., American Code Co. v. Bensinger, 282 F. 829, 833 (2d Cir. 1922) (extending protection to code book); No-Leak-O Piston Ring Co. v. Norris, 277 F. 951, 953 (4th Cir. 1921) (extending protection to piston sizing guide).
176. See, e.g., Edward Thompson Co. v. American Law Book Co., 122 F. 922, 923 (2d Cir. 1903) (noting that an author may collect copyrighted works and use selected parts to support the author's own original text); see also Collins v. Metro-Goldwyn Pictures Corp., 106 F.2d 83, 86 (2d Cir. 1939) (finding that a motion picture did not infringe on copyright covering book, even though similar events occurred in both the movie and the book); Oxford Book Co. v. College Entrance Book Co., 98 F.2d 688, 691 (2d Cir. 1938) (holding that plaintiffs could use a copyrighted work as long as they did not copy any substantial part of the copyrighted work); National Tel. News Co. v. Western Union Tel. Co., 119 F. 294, 300-01 (7th Cir. 1902) (allowing the gathering of news and its transmission by telegraph, even though the news was taken from another source); Davies v. Bowes, 209 F. 53 (S.D.N.Y. 1913), aff'd, 219 F. 178 (2d Cir. 1914) (permitting copying of a fictional short story because the author represented it as a factual event in a newspaper story).
Congress limited the protection of the Copyright Act of 1976\textsuperscript{178} to “original works of authorship.”\textsuperscript{179} Section 101 of the 1976 Act extends protection to any work “formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.”\textsuperscript{180} This language, however, is limited by section 103’s admonition that “[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.”\textsuperscript{181}

Based on these changes, some courts began to reject attempts to protect industrious collections on the theory that “[a] copyright in a [factual compilation] . . . is properly viewed as resting on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information.”\textsuperscript{182} In infringement actions, therefore, “[c]opyright protection [did] not extend to the facts themselves, and the mere use of the information contained in a [factual compilation] without a substantial copying of the format [did] not constitute infringement.”\textsuperscript{183} Prior to \textit{Feist}, the Fifth,\textsuperscript{184} Ninth,\textsuperscript{185} and Eleventh Circuits\textsuperscript{186} adopted this standard, as did the Second, which, having retreated from its

\begin{footnotesize}
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\item[179.] See 17 U.S.C. § 102(a) (1994).
\item[180.] 17 U.S.C. § 101.
\item[181.] 17 U.S.C. § 103(b).
\item[182.] Miller v. Universal City Studios, Inc., 650 F.2d 1365, 1369 (5th Cir. 1981).
\item[183.] \textit{Id.} at 1369-70; see also Triangle Publications, Inc. v. Sports Eye, Inc., 415 F. Supp. 682, 685 (E.D. Pa. 1976) (noting that form is protectable but data are not).
\item[184.] See Miller, 650 F.2d at 1369-70 (holding that facts themselves are unprotectible).
\item[185.] See Worth v. Selchow & Righter Co., 827 F.2d 569, 573 (9th Cir. 1987) (noting that use of facts is not infringement), \textit{cert. denied}, 485 U.S. 977 (1988); Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 491 (9th Cir. 1985) (stating that “[c]opyright law never protects the facts”).
\item[186.] See Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801, 809 (11th Cir. 1985) (holding that facts are not copyrightable).
\end{enumerate}
\end{footnotesize}
earlier holding in *Jewelers' Circular*,\(^ {187}\) held that "[t]here cannot be any such thing as copyright in the order of presentation of the facts, nor, indeed, in their selection."\(^ {188}\)

Unfortunately, the 1976 Act does not expressly define "originality." According to its drafters, "the phrase ... is purposefully left undefined [and] is intended to incorporate without change the standard of originality established by the courts under the present copyright statute."\(^ {189}\) Prior to 1991, this legislative history led some courts to conclude that the 1976 Act retained the sweat of the brow doctrine.\(^ {190}\) For example, in *Schroeder v. William Morrow & Co.*,\(^ {191}\) the Seventh Circuit concluded that "only ‘industrious collection,’ not originality in the sense of novelty, is required" to warrant protection.\(^ {192}\)

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187. See Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303, 310 (2d Cir. 1966) (repudiating the *Jewelers' Circular* sweat of the brow doctrine with the observation that "[w]e ... cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material"), *cert. denied*, 385 U.S. 1009 (1967).

188. Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 978 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); see also Financial Information, Inc. v. Moody's Investors Serv., Inc., 808 F.2d 204, 205, 207-08 (2d Cir. 1986) (declining to extend protection to bond sale data).


190. As one commentator has noted of the relationship between the 1976 and 1909 Acts on the subject of factual compilations:

> A quick look at the [1976] copyright code reveals no obvious problems with the treatment of factual compilations. Section 102(a) extends protection to "original works of authorship," and section 103 specifically mentions compilations as copyrightable subject matter. The trouble begins when one discovers that Congress specifically adopted, without change, the definition for copyrightable subject matter established under the [1909] copyright statute.

Alfred C. Yen, *The Legacy of Feist: Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 OHIO ST. L.J. 1343, 1349 (1991) (footnotes omitted); see also Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 857 (1987) ("Courts ... have apparently found [the 1976 Act] an unhelpful guide. For the most part, they look elsewhere for answers, relying primarily on prior courts' constructions of an earlier and very different statute on the same subject [the 1909 Act].")

191. 566 F.2d 3 (7th Cir. 1977).

192. *Id.* at 5. For additional case law from the Seventh Circuit embracing the sweat of the brow doctrine, see Rockford Map Publishers, Inc. v. Directory Serv. Co., 768 F.2d 145, 148-49 (7th Cir. 1985) (extending copyright protection to boundary lines depicted on a map), *cert. denied*, 474 U.S. 1061 (1986); Illinois Bell Tel. Co. v. Haines & Co., 883 F. Supp. 1204, 1207-08 (N.D. Ill. 1988) (extending copyright protection to telephone directory listings), *aff'd*, 905 F.2d
wise, in West Publishing Co. v. Mead Data Central, Inc.,\textsuperscript{193} the
Eighth Circuit extended protection to mere "labor and industry,"
without inquiring into the originality of the works in ques-
tion.\textsuperscript{194} Of greatest importance, however, the sweat of the
brow doctrine led the Tenth Circuit to uphold an injunction
against the copying of a "white pages" telephone directory in
Rural Telephone Service Co. v. Feist Publications, Inc.\textsuperscript{195}

B. Feist Publications, Inc. v. Rural Telephone
Service Co.

Feist resolved an issue that the Supreme Court previously
recognized as hotly disputed, namely "the ways in which
uncopyrightable elements combine with the author's original
contributions to form protected expression."\textsuperscript{196} The case
resulted from the defendant's use of the plaintiff's telephone

1081 (7th Cir. 1990).

In contrast to some decisions extending protection to industrious collection
works that "strain[ed] to find (or . . . simply declare[d] the existence of)
'selection and arrangement' in . . . patently nonselective and 'un-arranged'
compilations," see Ginsburg, supra note 150, at 1894, at least one Seventh
Circuit trial court abandoned this approach in favor of an alternative rationale
for its holding:

Compilations such as [the defendant's] have value because the
compiler has collected data which otherwise would not be available.
The compiler's contribution to knowledge normally is the collection of
the information, not its arrangement. If his protection is limited solely
to the form of expression, the economic incentives underlying the
copyright laws are largely swept away. Recognizing this, the courts
have long afforded protection under the copyright laws against
appropriation of the fruits of the compiler's industry.

That protection does not fit nicely into the conceptual framework
of copyright law and has for that reason been criticized . . . . The courts
have generally rested, however, not on an analysis of copyright
concepts but on the economic incentives premise of the copyright law
and the injustice of permitting one to appropriate the fruit of another's

(N.D. Ill. 1982).

194. Id. at 1227; see also Hutchinson Tel. Co. v. Fronteer Directory Co., 770
F.2d 128, 131-32 (8th Cir. 1985) (extending copyright protection to telephone
directory under the sweat of the brow doctrine). For a comprehensive critique
of Eighth Circuit sweat of the brow jurisprudence, see L. Ray Patterson & Craig
Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports
195. 916 F.2d 718 (10th Cir. 1990), aff'd 663 F. Supp. 214 (D. Kan. 1987),
(1985).
directory in the preparation of the defendant's own directory. Although the defendant attempted to verify the accuracy of the plaintiff's information before its incorporation into the defendant's competing directory, four of the defendant's final entries were identical to fictitious listings planted in the plaintiff's directory to detect copying. On the basis of these and 1304 other verbatim reproductions, the plaintiff brought a suit for copyright infringement, and received summary judgment on the theory that "[c]ourts have consistently held that telephone directories are copyrightable." In an unpublished opinion, the Tenth Circuit subsequently upheld this holding of liability as a matter of law.

Granting certiorari to resolve the split in the circuits' treatment of factual compilations, the Supreme Court reversed. The Court began by noting that the case "concern[ed] the interaction of two well-established propositions. The first is that facts are not copyrightable; the other, that compilations of facts generally are. . . . There is an undeniable tension between these two propositions." In light of the tradition of resolving this tension under the auspices of federal copyright legislation, the Court might well have been expected to turn to the 1976 Act for guidance.

The Court, however, took a far different tack. Rather than

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198. *Id.*
199. *Id.*
200. *Id.* at 218.
202. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 498 U.S. 808, 808 (1990) (limiting grant of certiorari to a single issue: "[whether] the copyright in a telephone directory . . . prevent[s] access to that directory as a source of names and numbers to compile a competing directory, or does copyright protection extend only to the selection, coordination, or arrangement of those names and numbers")
204. *Id.* at 344-45.
205. *See supra* notes 177-195 and accompanying text (describing copyright legislation and subsequent case law).
206. Thus, for example, in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), the Court applied a statutory analysis to conclude that "[n]o author may copyright his ideas or the facts he narrates . . . . [T]he news element—the information respecting current events contained in the literary production—is not the creation of the writer, but is a report of matters that ordinarily are *publici juris . . . ." *Id.* at 556 (quoting International News Serv. v. Associated Press, 248 U.S. 215, 234 (1918)) (citation omitted).
determining the original contribution required for an "original work[] of authorship" under the 1976 Act, the Court announced a framework mirroring those in The Trade-Mark Cases, Compco, and Graham:

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings."

. . . .

"The originality requirement is constitutionally mandated for all works."

The Court's constitutional analysis did not stop with reaffirming that the Intellectual Property Clause imposes substantive restrictions on the federal protection of intellectual property. On the contrary, the Court went on to offer guidance on how to apply the constitutional right to copy to works consisting of both protectable and unprotectable elements. On this issue, protection could not extend to unoriginal factual material even if that material was "commingled" with original selection and arrangement. Rather, "[a] factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." Consequently:

This inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.

Applying this rule to the facts before it, the Court concluded that the putatively original aspects of the plaintiff's arrangement—the alphabetization of the directory's factual information—fell well below the constitutional level of originality required to warrant even "thin" copyright protection. In

208. 499 U.S. at 346-47 (quoting Patterson & Joyce, supra note 194, at 763 n.155).
209. Id. at 349 ("No matter how original the format, . . . the facts themselves do not become original through association.").
210. Id. at 350-51; see also id. at 349 ("[I]f the selection and arrangement are original, these elements of the work are eligible for copyright protection." (emphasis added)).
211. Id. at 349.
212. Id. at 363 ("[T]here is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted
light of the plaintiff's inability to demonstrate that any aspect of its work was original, the entire work was thus subject to copying.213

III. ACCOMMODATION OF CONSTITUTIONAL PRINCIPLES UNDER FEDERAL TRADE DRESS LAW

A. THE CONSTITUTIONAL SIGNIFICANCE OF FEIST TO TRADE DRESS LAW

Feist's constitutional holding provides the key to answering the first critical question left unresolved by current trade dress doctrine: against whom or what are the constitutional restrictions on the protection of functional designs enforceable if, as Bonito Boats held, they are inapplicable to the states? Anticipating Feist's application of the Intellectual Property Clause to factual compilations,214 Compco, Graham, and Bonito Boats had each acknowledged that the provision creates a public domain of functional product configurations.215 Nothing in the Court's statutory preemption analyses in Sears, Goldstein, or Kewanee conflicts with the Clause's restrictions in this area and, indeed, the Court in both Sears and Goldstein acknowledged their existence.216 Bonito Boats' emphasis on the constitution-

213. Id. at 363-64.
214. For an additional holding to this effect, albeit in the copyright fair use context, see Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, 429 (1984):

The monopoly privileges that Congress may authorize [under the Constitution] are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired. Id. at 429.
215. See supra notes 76-80, 84-86, and 111-113 and accompanying text (discussing the holdings of these cases).
216. In Sears, although holding that the interaction of pervasive federal patent legislation and the Supremacy Clause preempted the Illinois common law doctrine at issue, see supra notes 72-74 and accompanying text, the Court nevertheless noted that the extension of possibly perpetual state protection to the configuration before it would conflict with "federal constitutional standards," Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 232 (1964) (emphasis added). The Goldstein Court's treatment of the issue was more subtle, recognizing that
al underpinnings of the nonfunctionality doctrine, despite the Court's retreat from the separate and independent issue of the preemption of state unfair competition law under the Intellectual Property Clause, is therefore no accident.\textsuperscript{217} On the contrary, when coupled with \textit{Feist}'s return to the tradition of \textit{The Trade-Mark Cases} and \textit{Graham}, the Court's approach demonstrates that not only is it entirely proper to apply the Constitution to limit or to invalidate federal intellectual property legislation,\textsuperscript{218} but the Court has every intention of doing so again in the future.\textsuperscript{219}

\textit{Feist} therefore speaks directly to the issue of whether the nonfunctionality requirement is nothing more than the negative implication of the patent statutes.\textsuperscript{220} If the Supreme Court had concluded in \textit{Compco} and \textit{Bonito Boats} only that state law cannot prevent the copying of a functional article unprotected by a utility patent, then protecting functional trade dress under the Lanham Act would pose few, if any, doctrinal problems. In other words, although Congress has chosen to preclude certain classes of wholly functional inventions, e.g., those that lack novelty or that are obvious, from qualifying for utility patent protection,\textsuperscript{221} it does not necessarily follow that Congress is unable

\begin{footnotesize}
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\item \textsuperscript{217} See, e.g., \textit{Bonito Boats, Inc. v. Thundercraft Boats, Inc.}, 489 U.S. 141, 151 (1989) ("That [the] free exploitation of ideas will be the rule, to which the protection of a [utility] patent is the exception," is "implicit in the [Intellectual Property] Clause itself.").
\item \textsuperscript{218} That the Court views the various limitations contained in the Intellectual Property Clause as applicable to all federal intellectual property legislation and not merely the specific forms of protection presented by individual cases is apparent in the Court's repeated citation of \textit{The Trade-Mark Cases} as support for the invalidation of the copyright law doctrine at issue in \textit{Feist}. See \textit{Feist Publications, Inc. v. Rural Tel. Serv. Co.}, 499 U.S. 340, 346, 351, 362 (1991).
\item \textsuperscript{219} As Professor Lange has noted of \textit{Feist}'s likely impact in the copyright context, "the Court has signaled its intentions to employ the Constitution to curtail the worst inclinations in a rapidly expanding field." David Lange, \textit{Copyright and the Constitution in the Age of Intellectual Property}, 1 J. INTELL. PROP. L. 119, 133 (1993).
\item \textsuperscript{220} See supra notes 121-134 and accompanying text (discussing the theory that passage of the Lanham Act altered defendants' access to functionality defense).
\item \textsuperscript{221} 35 U.S.C. § 102 (1994) requires patentable subject matter to be "novel," in the sense that it is not already known:

\begin{quote}
[The utility patent statutes] operate in tandem to exclude from consideration for patent protection knowledge that is already available
\end{quote}
\end{itemize}
\end{footnotesize}
to provide alternative avenues of relief to their owners. As both the Fourth and Sixth Circuits have concluded in this area, the federal government can giveth just as easily as it can taketh away. Consequently, if the functionality doctrine is nothing more than an ill-defined statutory policy created by the negative implications of federal patent legislation, nothing in this
paradigm would prevent Congress from altering this balance through the passage of the Lanham Act or through new legislation.\textsuperscript{224}

\textit{Feist}, however, forecloses this result by reaffirming that the right to copy under United States law has roots far deeper than any statutory regime.\textsuperscript{225} Even if perpetual protection for functional configurations is a proper vehicle for stimulating commerce,\textsuperscript{226} Congress cannot override constitutional limitations on its own authority merely by invoking the Commerce Clause.\textsuperscript{227} On the contrary, it is apparent that "Congress has plenary authority in all areas in which it has substantive legislative jurisdiction so long as the exercise of that authority does not offend some other constitutional restriction."\textsuperscript{228} Indeed, in the wake of \textit{Feist}'s linkage of the right to copy to the Constitution itself, even critics of \textit{Feist} have questioned congressional authority to override the decision through legislation granting a surrogate patent monopoly over the feature for an indefinite duration in contravention of the patent policy of limiting the duration of functional monopolies.


\textsuperscript{225} \textit{See also} \textit{Bonito Boats}, \textit{489 U.S.} at 151 (noting that it is "implicit in the [Intellectual Property] Clause itself[ ] that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception" (emphasis added)).

\textsuperscript{226} \textit{See} Edward S. Irons \& Mary H. Sears, \textit{The Constitutional Standard of Invention—The Touchstone for Patent Reform}, 1973 UTAH L. REV. 653, 675-76 ("[A] separate patent clause was included at least in part to emphasize that Congress had no power to provide for the granting of patents primarily as a stimulant to commerce.").

\textsuperscript{227} \textit{See} United States v. Lopez, \textit{115 S. Ct.} 1624, 1628 (1995) ("[E]ven ... modern-era precedents which have expanded congressional power under the Commerce Clause confirm that this power is subject to outer limits.").

promulgated under the Commerce Clause. Although Congress may indeed create "other federal statutory protection" outside the restrictions of the Intellectual Property Clause, efforts to evade the Clause's limits are valid only if they create qualitatively different protection.

In restricting recovery for infringement to cases in which a plaintiff (1) uses in commerce (2) a nonfunctional trade dress and can prove (3) that the trade dress is a distinctive indicator of origin and (4) that the defendant has employed a confusingly similar trade dress, federal trade dress law obviously differs in significant respects from its utility patent counterpart. Nevertheless, however desirable the other prerequisites may be to prevent a statutory conflict with federal utility patent legislation, only the second—nonfunctionality—has a textual basis in the Constitution and none of the Court's

229. See, e.g., Ginsburg, supra note 152, at 370 ("Assuming that the more specific clause does limit the more general one, Congress does not have power to override Patent-Copyright Clause limitations by creating under the Commerce Clause a form of protection of compiled information coextensive with copyright protection."); Yen, supra note 190, at 1377 (noting that congressional attempts to overrule Feist on the merits could "precipitate a constitutional crisis over the scope of copyright"); Jennifer R. Dowd, Note, A Selective View of History: Feist Publications, Inc. v. Rural Telephone Service Co., 34 B.C. L. REV. 137, 158 (1992) ("In light of the Feist Court's insistence upon the constitutional origin of the originality standard, however, such an amendment would not be constitutional."); cf. L. Ray Patterson, Copyright Overextended: A Preliminary Inquiry Into the Need for a Federal Statute of Unfair Competition, 17 U. DAYTON L. REV. 385, 410 (1992) (suggesting that congressional efforts to overrule Feist under the Commerce Clause would violate the First Amendment).


232. See Haymaker Sports, Inc. v. Turian, 581 F.2d 257, 261 (C.C.P.A. 1978) ("The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly.").

233. See supra notes 19, 23 and accompanying text (describing the source identification function of trademarks).

234. See supra note 22 and accompanying text (describing the "likelihood of confusion" test for trademark infringement liability).

235. As one court has explained, albeit in the design patent context, "[t]he trademark owner has an indefinite term of protection, it is true, but in an infringement suit must also prove secondary meaning and likelihood of confusion, which the owner of a design patent need not do; there is therefore no necessary inconsistency between the two modes of protection." W.T. Rogers Co. v. Keene, 778 F.2d 334, 337 n.8 (7th Cir. 1985).
decisions has suggested that satisfaction of the other factors will obviate this requirement. As long as it does not reach utilitarian features, the Lanham Act is consistent with the Intellectual Property Clause. The Act’s extension to functional elements at the behest of trade dress owners, however, would create a regime of protection directly overlapping that contemplated by the Clause, independent of any other requirements that may be imposed on plaintiffs.

Thus, in light of the holding in Compco and its progeny that the protection of functional designs is subject to constitutionally mandated temporal limitations, prohibiting the copying of these designs under the Act would create more than a conflict with statutory patent law. Rather, as one court has noted in determining the eligibility of the plaintiff’s product configuration for federal trade dress protection, “[a] prohibition against copying under such circumstances would contravene the policy

236. Indeed, it is apparent that in cases involving functional designs, issues of distinctiveness and confusing similarity become moot. See, e.g., Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co., 791 F.2d 423, 427 n.4 (5th Cir. 1986) (“[A] design cannot be found both legally functional—that is, not entitled to trademark protection—and ‘sufficiently distinctive’ to serve as an indicator of source.”); TMEP, supra note 57, § 1202.03(a)(i)(C), at 1202-5 (“A showing of acquired distinctiveness is irrelevant with regard to a design that is de jure functional.”).

237. See David Lange, Recognizing the Public Domain, 44 LAW & CONTEMP. PROBS., Autumn 1981, at 147, 168 (“[P]roprieters of trademarks and related impedimenta are subject to natural pressures to expand the boundaries of their interests, even at the risk of appearing silly or rapacious and not infrequently at the cost of expropriatory excursions into the public domain.”).

238. For an express judicial recognition of the constitutional conflict created by a disregard of the nonfunctionality requirement for trade dress protection, see Kohler Co. v. Moen Inc., 12 F.3d 632 (7th Cir. 1993). In Kohler, the Seventh Circuit upheld the registrability of an admittedly nonfunctional trade dress against the appellant’s claims that registration under the Lanham Act would impermissibly conflict with the Intellectual Property Clause. This result, however, was conditioned upon the premise that “‘provided that a defense of functionality is recognized, there is no conflict with federal patent law . . . .’” Id. at 638 (quoting W.T. Rogers Co. v. Keene, 778 F.2d 334, 337 (7th Cir. 1985)). As the court additionally acknowledged in reaching its holding, “Congress could conceivably enact legislation conferring perpetual patent-like monopolies that would conflict with the patent clause’s requirement that exclusive rights to authors and inventors be only ‘for limited Times.’” Id. at 642-43; see also Tempo Communications, Inc. v. Columbian Art Works, Inc., 223 U.S.P.Q. (BNA) 721, 722 (N.D. Ill. 1983) (“Just as state laws conferring perpetual monopolies could undermine the constitutional language of securing exclusive rights to authors and inventors ‘for limited Times,’ Art. I, § 8, so Congress, conceivably, could circumvent that language by granting perpetual patents and copyrights under the guise of some other form of trade regulation.”).
of the Constitution which gives the public free access to those materials in the public domain."

Because the Lanham Act can no more abrogate constitutional mandates than can other federal legislation, its potentially perpetual protection does not reach individually functional elements—not only because the Act does not expressly address them, but because it cannot do so.

239. R.M. Smith, Inc. v. Collins Ltd., 219 U.S.P.Q. (BNA) 465, 468 (W.D. Pa. 1983) (emphasis added); see also Versa Prods. Co. v. Bifold Co., 50 F.3d 189, 204 (3d Cir. 1995) (noting in context of federal trade dress infringement action that "'[t]he federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain is an ever-present consideration').

240. See Tempo Communications, 223 U.S.P.Q. (BNA) at 722 ("It is true that some concerns expressed in Sears and Compco are valid also with respect to federal legislation."). For representative cases holding findings of liability under the Lanham Act subject to constitutional limitations, see Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc., 886 F.2d 490, 493-97 (2d Cir. 1989) (holding trademark "parody" subject to heightened First Amendment standard of liability); Rogers v. Grimaldi, 875 F.2d 994, 997-1002 (2d Cir. 1989) (holding movie title protected by First Amendment against liability under Lanham Act); Ocean Bio-Chem, Inc. v. Turner Network Television, Inc., 741 F. Supp. 1546, 1552-53, 1553 n.2 (S.D. Fla. 1990) (applying heightened First Amendment standard for liability).

241. See Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co., 791 F.2d 423, 425 n.2 (5th Cir. 1986) (concluding, in federal trade dress infringement action brought under Lanham Act, that "[s]tated simply, 'functionality' privileges the copying of . . . features that are functional" (quoting Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 422 (5th Cir. 1984)).

242. On this issue, Bonito Boats' observations on the degree of permissible congressional action under the Intellectual Property Clause are clear and unambiguous:

[T]he Clause contains both a grant of power and certain limitations upon the exercise of that power. Congress may not create patent monopolies of unlimited duration, nor may it "authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."

Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989) (quoting Graham v. John Deere Co., 383 U.S. 1, 6 (1966)). As one commentator has noted of similar statements elsewhere in the opinion:

The Lanham Act end around used by some courts clearly flies in the face of the Bonito Boats reaffirmation of the reasoning of Sears-Compco. If a prohibition on the copying and selling of an article substantially conflicts with "the strong federal policy favoring free competition in ideas which do not merit patent protection," then that conflict is present whether the prohibition derives from state common law or from the decisional creativity of some of the lower federal courts interpreting the Lanham Act. If prohibiting the copying of an article "substantially impedes the public use of the otherwise unprotected design and utilitarian ideas" embodied in the article, then that
Recognition of the constitutional dimensions of the nonfunctionality requirement would resolve the second unanswered question of trade dress law, namely the extent to which competitors may protect designs that consist entirely of functional elements. On this issue, the Lanham Act’s treatment of trade dress differs from copyright law’s treatment of factual compilations in that it does not contain a framework to protect the copying of unprotectable elements. Thus, although the Feist Court rested its holding on the Intellectual Property Clause, such a broad analysis was unnecessary and, indeed, arguably undesirable. Rather, the Court might well have

substantial impediment is present whether it happens to have been produced by a state court or a [federal] circuit court.

Hilmy, supra note 127, at 756 (footnotes omitted); cf. Dratler, supra note 75, at 923 (“[A]ll doubt concerning trademark protection for industrial designs does not, like an evil spirit, disappear upon incantation of the words ‘Lanham Act.’”).

243. See supra notes 135-148 and accompanying text (discussing the extent of protection for functional and nonfunctional design features under prevailing law).

244. Likewise, the Lanham Act contains no express provision corresponding to the 1976 Copyright Act’s treatment of works consisting of both functional and nonfunctional elements:

[T]he design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101 (1994). As the legislative history notes of this language:

[Althou[h the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

H.R. REP. NO. 1476, 94th Cong., 2d Sess. 55 (1976). For applications of this standard, compare Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (upholding copyright protection for belt buckles on ground that “[t]he primary ornamental aspect of the . . . buckles is conceptually separable from their subsidiary utilitarian function”) with Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411, 419 (2d Cir. 1985) (declining to extend copyright protection to partial human mannequins on ground that “the features claimed to be aesthetic or artistic . . . are inextricably intertwined with the utilitarian feature, the display of clothes”). On conceptual separability in the copyright context, see generally Bussert, supra note 224.

245. As Professor Ginsburg has noted, “it is ironic that the Feist opinion’s author, while announcing an unsought constitutional resolution [in Feist], elsewhere . . . [has] admonished the Court for unnecessary decisions of constitutional issues.” Ginsburg, supra note 152, at 382 (citing Webster v.
simply relied upon the express text of the 1976 Copyright Act. "Having found that the statute barred [the] plaintiff's claim, the Court had no further need to declare a constitutional basis for the result, much less announce that basis 'no fewer than thirteen times.'"247

In light of this preexisting legislative accommodation under the 1976 Copyright Act, it is hardly surprising that post-Feist copyright cases have begun to give the Intellectual Property Clause the respect it is due.248 In contrast, however, courts applying the constitutional mandate of Compco and Bonito Boats in the trade dress context have not had the benefit of similar express legislative guidance.249 Thus, even federal jurists

Reproductive Health Servs., 492 U.S. 490, 526 (1989) (O'Connor, J., concurring in part and concurring in the judgment); see also supra note 79 (noting that the Court will attempt to construe a statute to avoid the danger of unconstitutionality).

246. For a comprehensive critique of the sweat of the brow doctrine from a statutory, as well as a constitutional, perspective, see Patterson & Joyce, supra note 194; see also Dowd, supra note 229, at 156 ("The United States Supreme Court could have reached the conclusion that the directory in Feist was not protected without invoking the Constitution.").


249. See In re Deister Concentrator Co., 289 F.2d 496, 501 (C.C.P.A. 1961); see also Two Pesos, Inc. v. Taco Cabana, Inc., 112 S. Ct. 2753, 2760 (1992) (noting that 15 U.S.C § 1125(a), which creates the most commonly invoked
recognizing that the Clause mandates a public domain in the trade dress context, as well as under patent and copyright law, have conceded that "[t]he doctrine of functionality is an extra-statutory doctrine, neither defined nor limited by the express provisions of the Lanham Trademark Act . . . ."250

Nor have the lower federal courts had the benefit of clear interstitial lawmaking from the Supreme Court. In perhaps its clearest opportunity to define "functionality" under the Lanham Act, Inwood Laboratories, Inc. v. Ives Laboratories, Inc.,251 the Court limited its holding to the proper scope of appellate review under the "clearly erroneous" standard.252 Likewise, as noted above,253 the Court in Two Pesos, Inc. v. Taco Cabana, Inc.254 went out of its way to avoid the issue of whether purely functional elements can be arranged to create a protectable trade dress.255 For better or for worse, therefore, the Court's failure to address this issue leaves trade dress law without the clear statement afforded to copyright law by Feist.256

252. See id. at 855-59. In Inwood Laboratories, the district court had found, as a factual matter, that the nonfunctionality requirement protected the defendants' copying of the putative trade dress of the plaintiff's drug tablets. See Ives Labs. v. Darby Drug Co., 488 F. Supp. 394, 397 (S.D.N.Y. 1980), rev'd, 638 F.2d 538 (2d Cir. 1981), rev'd and remanded sub nom. Inwood Labs. v. Ives Labs., 456 U.S. 844 (1982). On appeal, however, the Second Circuit reversed the district court's holding in the defendants' favor, without addressing whether the result of the district court's functionality analysis was clearly erroneous. See 456 U.S. at 857 n.20. Although concluding that the district court's finding "[w]as not, as a matter of law, unreasonable," id. at 856 n.16, the Court offered little guidance as to what standard governed this holding, noting only that "[i]n 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." Id. at 851 n.10; see Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 517 (8th Cir. 1987) ("In the Inwood Laboratories case, the Supreme Court stated the standard for determining functionality only 'in general terms,' and that in dictum.").
253. See supra notes 146-148 and accompanying text (describing the Court's holding in Two Pesos).
255. See id. at 2757 n.6.
256. See Vincent N. Palladino, Trade Dress After Two Pesos, 84 TRADEMARK REP. 408, 417 (1994) (noting that Two Pesos "may have raised more questions than it answered").
B. The Limits of “Thin” Trade Dress Protection

In the absence of express guidance from either the Supreme Court or Congress on the extent of protection properly afforded to trade dress consisting of both functional and nonfunctional elements, federal courts have been largely unreceptive to a doctrinal framework reflecting the trade dress equivalent of Feist, namely that “functional features which are not the subject of a valid [utility] patent or copyright may be imitated with impunity.” Such a rule clearly is reflected in Textron, Inc. v. United States International Trade Commission, in which the manufacturer of a milling device unsuccessfully sought exclusion of a competing machine under section 337 of the Tariff Act of 1930. Although the manufacturer successfully convinced the International Trade Commission that the overall configuration of its device constituted a nonfunctional trade dress, the Federal Circuit reversed this holding because only one of the device’s components “has been or can be designed in an alternative manner and work as well, at an equivalent cost.” Concluding that no nonfunctional features were duplicated by the competitor’s device, the court held exclusion to be inappropriate on the ground that “where most of the product’s overall design is functional, the nonfunctional components alone, rather than the overall design, are capable of being considered a

257. Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980); accord Sunbeam Corp. v. Equity Indus. Corp., 635 F. Supp. 625, 635 (E.D. Va. 1986), aff’d, 811 F.2d 1505 (4th Cir. 1987); see also AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1538 (11th Cir. 1986) (extending protection to certain elements of plaintiff’s trade dress, but holding that, with respect to the functional elements, “[the defendant] was ... free to imitate those features of the [plaintiff’s] packaging with complete impunity”), cert. denied, 481 U.S. 1041 (1987).

258. 753 F.2d 1019 (Fed. Cir. 1985).


Section 337, in relevant part, declares unlawful: “Unfair methods of competition and unfair acts in the importation of articles ... the effect or tendency of which is to destroy or substantially injure an industry ... in the United States.” Thus, to prove a violation of section 337, the complainant must show both an unfair act and a resulting detrimental effect or tendency.

New England Butt Co. v. International Trade Comm’n, 756 F.2d 874, 876 (Fed. Cir. 1985). Actions under section 337 are initially heard by the International Trade Commission, whose factual holdings are then subject to review by the Federal Circuit under a substantial evidence test. Id.

260. 753 F.2d at 1026 (footnote omitted).
This treatment of trade dress consisting in part of functional elements is equally apparent in American Greetings Corp. v: Dan-Dee Imports, Inc.,\textsuperscript{262} in which the plaintiffs sought to preclude the defendant's use of "tummy graphics" on toy bears.\textsuperscript{263} Although the district court concluded that the graphics themselves were functional, in that they were "the best possible way" of communicating the personalities associated with the bears,\textsuperscript{264} it nevertheless barred the defendant from producing or selling products "embody[ing] a combination of elements [including the tummy graphics] such that their overall appearance is likely to cause confusion with the overall appearance of plaintiffs' [product]."\textsuperscript{265} On appeal, however, the Third Circuit reversed this aspect of the injunction because it prohibited the defendant's use of individually functional elements.\textsuperscript{266} Anticipating Feist's holding in the copyright context, the appellate court concluded that "a court may not enter an injunction the practical effect of which is to preclude the defendant from using the functional features of the plaintiffs' combination. This proposition is a necessary corollary of the functionality doctrine."\textsuperscript{267}

\textsuperscript{261} Id. at 1027 (emphasis added); see also Petersen Mfg. Co. v. Central Purchasing, Inc., 740 F.2d 1541, 1550 (Fed. Cir. 1984) ("To assert an overall product shape as a mark, the entire design must be arbitrary or non de jure functional.").

\textsuperscript{262} 807 F.2d 1136 (3d Cir. 1986).

\textsuperscript{263} As described by the court, these features were "pictorial designs on ... white stomachs." \textit{Id.} at 1138.


\textsuperscript{265} \textit{Id.} at 1221.

\textsuperscript{266} See 807 F.2d at 1144-45.

\textsuperscript{267} \textit{Id.} at 1144 (emphasis added). Applying this rule to the facts before it, the Third Circuit concluded that:

Because teddy bears are in the public domain, it necessarily follows . . . that the duty of [the defendant] to distinguish its products where feasible to do so does not extend to abandoning the standard configuration of a teddy bear. In short, [the defendant] appears to be entitled to market teddy bears just as it is entitled to utilize tummy graphics on plush toys. It should not be enjoined from using both together absent a finding that it is feasible, by altering other features of a teddy bear, to avoid a likelihood of confusion . . . .

\textit{Id.} at 1145.

For a dissenting opinion applying a similar analysis, see Ferrari S.P.A. Esercizio Fabbriche Automobili E Corse v. Roberts, 944 F.2d 1235 (6th Cir. 1991), \textit{cert. denied}, 112 S. Ct. 3028 (1992):

[T]he majority opinion does more than protect consumers against
Even upon the most cursory of examinations, these decisions reflect a "thin" conception of trade dresses composed of individually functional features that is equivalent to the "thin" copyright covering factual compilations such as that at issue in *Feist*. Just as the owner of a copyright covering a compilation of facts cannot preclude the copying of those facts by adding in scattered "false" ones, so too is it inappropriate for courts to extend protection to the entirety of a putative trade dress that encompasses functional, as well as nonfunctional, components. As both the Federal and Ninth Circuits have concluded, "the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were accorded trademark protection because they included a few arbitrary and nonfunctional features.

Despite the absence of express guidance from the Supreme Court, therefore, courts can and should recognize that, just as the Constitution restricts the ability of copyright owners to protect public domain elements of their works, it concomitantly
restricts the ability of trade dress owners to do the same.\textsuperscript{271} If, as the \textit{Feist} Court concluded in its constitutional analysis, "[c]ommon sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place,"\textsuperscript{272} the same principles apply with equal force in the trade dress context.\textsuperscript{273} Simply put, elements that are individually unprotectable in and of themselves do not magically acquire trade dress status through mere association with each other and in the absence of a separate and independent nonfunctional gloss.\textsuperscript{274}

Significantly, however, because "particular features may become an indication of source even though the entire product shape does not meet the [nonfunctionality] criteri[on],"\textsuperscript{275} recognition of a thin conception of trade dress would not preclude plaintiffs from protecting individually nonfunctional features or the nonfunctional gloss covering arrangements of functional features.\textsuperscript{276} Thus, for example, the Second Circuit in \textit{Le Sportsac, Inc. v. K Mart Corp.}\textsuperscript{277} rejected the contention

\textsuperscript{271} Cf \textit{Restatement, supra} note 21, § 21 cmt. c, at 230 ("Similarities that are attributable to the use of only unprotected elements will not support a finding of infringement.").

\textsuperscript{272} \textit{Feist}, 499 U.S. at 345; see also id. at 349 ("No matter how original the format . . . the facts themselves do not become original through association.").

\textsuperscript{273} See \textit{Elmer v. ICC Fabricating, Inc.}, 67 F.3d 1571, 1580 (Fed. Cir. 1995) (finding no liability for trade dress infringement as a matter of law on the ground that plaintiff "did not show at trial, nor does it now explain, how combining the [functional] elements of its asserted trade dress renders the trade dress as a whole primarily nonfunctional"); see also \textit{Jerre B. Swann, The Design of Restaurant Interiors—A New Approach to Aesthetic Functionality}, 76 \textit{Trademark Rep.} 408, 410 (1986) ("[A]ny implicit suggestion that patently functional features may achieve some modicum of insulation by the admixing of other features is suspect.").

\textsuperscript{274} See, e.g., \textit{Textron}, 753 F.2d at 1025 ("In cases where the holders of [composite functional and nonfunctional] designs seek trademark protection, it can be obtained only for those features that are nonfunctional."); \textit{Vuitton et Fils S.A. v. J. Young Enters.}, Inc., 644 F.2d 769, 774 (9th Cir. 1981) (same); \textit{Leisurecraft Prods. Ltd. v. International Dictating Equip. Inc.}, 210 U.S.P.Q. (BNA) 193, 194 (D.D.C. 1981) (requiring plaintiff to demonstrate that protectable elements of its design were "distinctive and arbitrary enough to separate [themselves] from the function of the product").

\textsuperscript{275} \textit{Petersen Mfg. Co. v. Central Purchasing, Inc.}, 740 F.2d 1541, 1550 (Fed. Cir. 1984).

\textsuperscript{276} See, e.g., \textit{John H. Harland Co. v. Clarke Checks, Inc.}, 711 F.2d 966, 983-84 (11th Cir. 1983) (upholding plaintiff's jury verdict on ground that, although certain copied features were functional, sufficient evidence supported finding that nonfunctional elements had been copied as well).

\textsuperscript{277} 754 F.2d 71 (2d Cir. 1985).
that the district court's injunction impermissibly prevented the defendant from using individually functional features, noting that "[the plaintiff] claims as its mark the particular combination and arrangement of design elements . . . ." Likewise, in Vaughan Manufacturing Co. v. Brikam International, Inc., the Seventh Circuit upheld a preliminary injunction prohibiting the copying of the plaintiff's folding table against a challenge grounded in the functionality of the table's constituent elements:

The district court in this case carefully limited the protectible trade dress to features of the table that were not essential to the overall function of the table: the yellow color of the table sides; the color of the masonite top; the black color of the frame; and the style, shape, and color of the lock, handle, label, and other brass parts. At the hearing, [the plaintiff] brought forward evidence that other folding picnic table manufacturers had products that varied significantly from [the plaintiff's] table with respect to these features.

These decisions recognize the converse of Feist, namely that liability may attach once a defendant's appropriation has moved beyond the scope of the right to copy created by the Intellectual Property Clause, even if an otherwise functional product configuration is concerned. Because, according to its text and under The Trade-Mark Cases' application of that text, the Clause's "for limited Times" language is directly applicable to

278. Id. at 76 (emphasis added); see also Taco Cabana Int'l Inc. v. Two Pesos, Inc., 932 F.2d 1113, 1119 (5th Cir. 1991) ("[A] particular arbitrary combination of functional features, the combination of which is not itself functional, properly enjoys protection."); aff'd, 112 S. Ct. 2753 (1992).

279. 814 F.2d 346 (7th Cir. 1987).

280. Id. at 350 (emphasis added). For another holding to similar effect in the furniture trade dress context, see Devan Designs, Inc. v. Palliser Furniture Corp., 25 U.S.P.Q.2d (BNA) 1991 (M.D.N.C. 1992), aff'd without op., 998 F.2d 1003 (4th Cir. 1993), in which the plaintiff successfully defeated the defendant's claims of functionality (although it ultimately failed to demonstrate that its trade dress was a distinctive indicator of origin):

In this case, both the parties agree that the material dictates eighty percent of the design options for furniture of this type. The twenty percent of the options remaining, however, still constitute a significant number. While furniture itself has a functional purpose, the shape of a drawer or the color of a case good's front, are not dictated by utilitarian characteristics. A furniture manufacturer has room, even within [a particular] medium, to craft a design without all the elements of the Plaintiff's design.

Id. at 2002.

281. The test for protectable trade dress proposed by this Article thus is consistent with the conclusion of the Seventh Circuit in Kohler Co. v. Moen Inc., 12 F.3d 632 (7th Cir. 1993), that product configurations are not inherently incapable of protection under a trade dress theory. Id. at 636-43.
"invention and discovery," this restriction is inapplicable to nonfunctional elements that do not result from "sudden invention," "genius," or "laborious thought." Thus, although there may be "absolutely nothing legally or morally reprehensible about exact copying of things in the public domain," full recognition of the Clause in the trade dress context would not mean "that the copying of a functional feature ... protects a defendant who has also reproduced nonfunctional features." Nor would it preclude liability if a defendant's copying of entirely functional features is coupled with separate and independent acts of unfair competition such as "palming off," false advertising, or deceptive trade practices. On the contrary, relief under these circumstances is not only permissible, but appropriate.

CONCLUSION

Americans take their constitutional freedoms seriously,
perhaps as seriously as do their law professors. Nevertheless, the right to copy has not been historically regarded as one of the nobler freedoms in the constitutional pantheon and, indeed, in many contexts copying may constitute a de facto "capital offense" subjecting the offender to overwhelming opprobrium and possible liability. Consequently, "when appropriated [materials] are used to construct a work that is virtually identical to the original, courts can be expected to find infringement without regard to the theoretical limitations of doctrine."

As this Article has demonstrated, however, the constitutional foundation of these doctrinal limitations renders courts' persistent disregard of them in the trade dress context particularly inappropriate. If the Supreme Court's decision to link the outcome in *Feist* to a constitutional right to copy in fact "signal[s] its intention to begin the serious business of bringing


290. Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 528 (1981) (characterizing outcomes in pre-*Feist* sweat of the brow cases). As Professor Heald has explained in the trade dress context:

The disrepute into which *Sears/Compco* fell was not only the result of a failure to understand that *Goldstein, Kewanee, and Aronson* were not "at war with the philosophy of *Sears/Compco, *" but also an interesting sociological phenomenon: antipathy for the copycat. Many cases have evinced a visceral dislike of the competitor who "intentionally copies" a product. Frequently, copiers are condemned without analysis of the valuable function the patent law recognizes they serve: lowering of prices through cheap reproduction and preventing the reinvention of the wheel.


291. Cf. *Keene Corp. v. Paraflex Indus.*, Inc., 653 F.2d 822, 824 (3d Cir. 1981) (reh'g en banc) (noting that "natural inclination" to condemn copying in the trade dress context "must give way to the public policy favoring competition, even by slavish copying, of products not entitled to federal patent protection"); *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 272 (2d Cir.) ("[I]mitation is the life blood of competition. It is the unimpeded availability of substantially equivalent units that permits the normal operation of supply and demand to yield the fair price society must pay for a given commodity."); *cert. denied*, 361 U.S. 915 (1959).
to intellectual property the constitutional coherence it deserves,292 this coherence is as long overdue in the trade dress area as it historically has been in the copyright sphere. Although the Court may have abandoned the constitutional preemption analysis employed in Compuco, this retreat should not obscure the Court’s reaffirmations of Compuco’s other holding, namely that nonfunctionality is a constitutional prerequisite for trade dress protection that is immune to statutory abrogation.293

Nor, for that matter, should it obscure Feist’s clear instruction on how to apply the constitutional right to copy to subject matter consisting of both protectable and unprotectable elements.294 Although “[t]he line between nonfunctional and functional is difficult to draw and an obvious source of litigation,”295 standards for drawing that line not only exist, they demarcate the public domain just as much as they define proprietary rights.296 Recognition of a thin level of protection for trade dress consisting primarily of functional elements, equivalent to the thin copyright for factual compilations recognized in Feist, would return federal law to the constitutional foundations apparent in the express text of the Intellectual Property Clause and in Compuco and its progeny.297


293. See Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co., 963 F.2d 628, 633-34 (3d Cir. 1992) (“To allow indefinite trademark protection of product innovations would frustrate the purpose of the limited duration of patents to foster competition by allowing innovations to enter the public domain after [twenty] years.”).


296. Cf. Lange, supra note 237, at 150 (“[N]o exclusive interest should ever have affirmative recognition unless its conceptual opposite is also recognized. Each right ought to be marked off clearly against the public domain.”).

297. Although this Article has focused on the nonfunctionality requirement under federal law, it is apparent that a thin concept of trade dress is warranted in applications of state law as well, albeit for statutory, rather than constitutional, reasons. Under federal patent law, functionality is a statutory requirement for the issuance of a utility patent, see 35 U.S.C. § 101 (1994), and the Patent and Trademark Office routinely disallows claims in utility patent
Failure to take such a step, however, will stretch the thin line separating protectable trade dress and the public domain beyond the breaking point.

applications that cover nonutilitarian aspects of putative inventions. See Patent and Trademark Office, United States Dep't of Commerce, Manual of Patent Examining Procedure § 706.03(p), at 700-19 (6th ed. 1995) (defining procedures governing the statutory rejection for lack of utility). If, as Bonito Boats held, material potentially falling within the scope of permissible utility patent protection is beyond the reach of state law, it necessarily follows that, by definition, only nonfunctional elements remain.