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Note: Trademark Protection of Objects and Configurations: A Critical Analysis

The law has long reflected a tension between the desire of manufacturers to copy their competitor's products and ideas and the desire of the competitors to prevent such copying. One area which has been most affected by this tension is that of legal protection of the shape or configuration of a manufacturer's product. Manufacturers have argued that the physical shape or configuration of a product or container identifies the producer to the consuming public, and that therefore the law should prohibit imitation of these patterns. A possible statutory response to this argument is trademark registration under the Lanham Trademark Act, which is available for a broad range of shapes and configurations. The kinds of objects which may be granted such registration have grown in number over the last twenty years, however, until the protection now extends well beyond the original rationale of assuring source identification. For example, registrations under the Lanham Trademark Act have been attempted for beverage containers, the shape of a table, and other configurations at least arguably intended to do

2. Precisely speaking, the law does not protect the product itself, but rather the manufacturer's rights in the product: the patent statute confers the right to prevent any unauthorized manufacture, while the trademark statute grants a right to prevent use of the product as an indicator of source. In common parlance, however, these statutes are said to protect the product, and that phraseology will be used in this Note. In a similar manner, the term "object" will be used more or less interchangeably with "shape" and "configuration." Although it is not technically accurate to say, for example, that a manufacturer can obtain trademark protection for an object when what is really meant is its shape or design, in many cases the distinction is a meaningless one. It matters very little, for example, whether one refers to protection of the Honeywell thermostat cover itself or of its shape. See notes 137-45 infra and accompanying text. On the other hand, the term "pattern" will be used to indicate a quite distinct part of an object, such as the pattern on a china plate.
4. Examples include the Haig and Haig "Pinch Bottle," the Mogen David wine decanter, and the Pepsi-Cola bottle. See notes 22, 52, and 70 infra.
6. See, e.g., In re Mem Co., 165 U.S.P.Q. 88 (T.T.A.B. 1970) (barrel-shaped closure on cosmetics bottles); In re International Playtex...
more than identify the product and its manufacturer.

Besides registration under the Lanham Act, there are other possible sources of protection for product shapes and configurations. These include mechanical and design patents, copyrights, and the common law of unfair competition. The various protections frequently overlap, however. For nonmechanical, non-written shapes and configurations, the most likely overlap or conflict with the trademark system occurs when the item in question is covered by a design patent. The extent to which this conflict exists will be an important factor in determining whether trademark protection should be extended to include product designs.

The purpose of this Note is to examine critically the use of trademark protection to prevent the copying of product configurations. The conclusion which will be reached as a result of this analysis is that the number of occasions on which Lanham Act registration is permitted for product configurations should be sharply limited. Alternative methods of controlling or restricting the scope of trademark protection will then be discussed.

I. THE STATUTORY BACKGROUND

A. TRADEMARK PROTECTION

The Lanham Trademark Act of 1945 provides protection for trademarks that are registered on either its Principal or its Supplemental Register. A manufacturer who seeks listing on the Principal Register must show that his trademark is inherently distinctive or has acquired secondary meaning as an indicator of the product's source. Once a trademark has been entered


8. A trademark is defined by the Act as a "word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." Id. § 1127.
9. Section 2(f) of the Act requires that the trademark be distinctive of the applicant's goods or services. 15 U.S.C. § 1052(f) (1970). Unless secondary meaning—actual operation of the symbol as an indicator of source—is shown, the item must be inherently distinctive in order to qualify for protection on the Principal Register. For example, in In re McIlhenney Co., 278 F.2d 953 (C.C.P.A. 1960), the court found that the applicant's pepper sauce (Tabasco sauce) bottle was not inherently distinctive and denied registration. The applicant had not proved secondary meaning.
10. Secondary meaning denotes the actual operation in trade of the symbol as an indicator of source and therefore satisfies the statutory re-
on the Principal Register, its owner can prevent registration of similar or confusing marks\(^1\) and secure injunctive relief and damages against infringers\(^2\) in federal court.\(^3\) In addition, the owner can prevent the importation of goods with infringing marks,\(^4\) assert the registration in court as prima facie evidence of his right to exclusive use,\(^5\) and after five years' use have the mark treated as incontestable.\(^6\)

An applicant for supplemental registration, on the other hand, need only show that his mark\(^7\) is "capable of distinguishing applicant's goods or services"\(^8\) in order to qualify for the protection of that register. This is a significantly less restrictive requirement than that demanded for the Principal Register, since the Supplemental Register requires only that the symbol possess the potential for distinguishing the manufacturer's good, rather than the actual ability to distinguish necessary for principal registration. The protections afforded the supplemental registrant are correspondingly limited to the ability to prevent registration of confusing marks\(^9\) and the right to injunctive relief\(^10\) and damages in federal court.\(^11\)

The rationale for providing two registers rather than a single one is unclear; but there is some suggestion that the reason for creating the Supplemental Register was to allow domestic manufacturers to register certain trademarks in foreign countries.\(^12\) Thus, the provision of supplemental registration in this country now makes it possible for a manufacturer to insure the exclusive use of his symbol in countries that refuse protection to marks

\(^{14}\) Id. § 1052(d).
\(^{15}\) Id. §§ 1114, 1116, 1117.
\(^{16}\) Id. § 1121.
\(^{17}\) Id. § 1124.
\(^{18}\) Id. §§ 1057(b), 1115(a).
\(^{19}\) Id. §§ 1065, 1115(b).
\(^{20}\) "Mark" is a less specific term than "trademark." It is defined to include symbols—such as trademarks, service marks, collective marks, or certification marks—which are entitled to registration whether or not actually registered. Id. § 1127.
\(^{21}\) Id. § 1091.
\(^{22}\) Id. § 1053(d).
\(^{23}\) Id. §§ 1114, 1116, 1117.
\(^{24}\) Id. § 1121.

not registered in the country of origin.\textsuperscript{23} Textual evidence that this was the congressional intent is provided by the language of section 23 of the Act, which applies only to the Supplemental Register:

Upon a proper showing by the applicant that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year's use and may grant registration forthwith.\textsuperscript{24}

Certain sections of the Act have particular relevance to the protection of configurations and three-dimensional objects. Section 23 provides that marks registrable on the Supplemental Register may include configurations of goods.\textsuperscript{25} Section 2(f) states that "[e]xcept as expressly provided in . . . this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."\textsuperscript{26} The Commissioner of Patents has read these two sections together as establishing that containers are configurations of goods and thus may qualify for the protection of the Supplemental Register, with graduation to the Principal Register upon proof of established secondary meaning.\textsuperscript{27}

B. Patent Protection

Patent protection\textsuperscript{28} represents a second statutory method of preventing one's competitors from copying products and configurations. Although utility patents\textsuperscript{29} are occasionally employed

\begin{footnotes}
\footnote{25. For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral or device or any combination of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services. Id. § 1091.}
\footnote{26. Id. § 1052(f). For a list of the narrow exceptions of the section, see note 159 infra.}
\footnote{27. In Ex parte Boye Needle Co., 100 U.S.P.Q. 124 (Dec. Com. Pat. 1953), and Ex parte Minnesota Mining & Mfg. Co., 92 U.S.P.Q. 74 (Dec. Com. Pat. 1952), the Commissioner refused principal registration for containers. In Ex parte Haig & Haig Ltd., 118 U.S.P.Q. 229 (Dec. Com. Pat. 1958), that position was repudiated and the Pinch bottle—which had been listed on the Supplemental Register—was granted principal registration.}
\footnote{29. "Utility patent" refers to the monopoly protection granted to inventive creations, other than ornamental designs, under the United States patent statutes. The invention must be unanticipated, as well as previously unknown and unpatented. 35 U.S.C. § 102 (1970). The holder of
for this purpose, design patents are usually more suitable for objects or configurations which might conceivably be granted trademark registration. Thus, design patents are the restriction on imitation most likely to conflict with Lanham Act protection.

A design patent may be granted for "any new, original and ornamental design for an article of manufacture," if the design meets the general requirements applicable to all patents. The most notable of these are the requisites of invention, novelty, and originality. Once granted, the patent gives its holder the right to exclusive control of the design for a period of up to 14 years. The burden of showing invalidity of the patent is on the party challenging it. Remedies for infringement include injunctive relief and damages, with minimum damages being at least equal to a reasonable royalty and subject to tripling at the court's discretion. Attorneys' fees may also be awarded in exceptional cases.

The design patent, however, has proved to be an exceedingly unreliable device for preventing imitation. Many patent applicants have found it difficult to demonstrate the necessary novelty and originality. In addition, courts have been reluctant to up-

the patent is given the right to exclude others from making, using, or selling the invention throughout the United States for 17 years, 35 U.S.C. § 154 (1970), and also is provided a substantial array of remedies for infringement, 35 U.S.C. §§ 281-93 (1970).

31. A "design patent, in order to be valid, must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman." Amerock Corp. v. Aubrey Hardware Mfg., Inc., 275 F.2d 346, 348 (7th Cir. 1960). See also Capex Co. v. Schwartz, 166 F.2d 5 (7th Cir. 1948); In re Stevens, 173 F.2d 1015 (C.C.P.A. 1949).

32. At the applicant's option, the patent may be issued for a period of 3½, 7, or 14 years. 35 U.S.C. § 173 (1970).
33. Id. § 282.
34. Id. § 281.
35. Id. § 283.
36. Id. § 284.
37. Id.
38. Id. § 285.
hold the design patents granted by the Patent Office.40

II. THE FUNCTIONALITY LIMITATION ON TRADEMARK PROTECTION

In order to understand fully the protections which are available for a product's shape or configuration, it is necessary to explore a common law concept which has often been used by courts to limit registrations under the Lanham Act: the doctrine of functionality.41 Simply stated, this doctrine provides that functional features of products will not be protected from copying.42 One motivation behind the development of this doctrine was the desire to assure the continued potency of the common law right to copy essential features of marketable products.43 Obviously, the doctrine's impact on trademark protection of product configurations will depend greatly on the breadth given to the definition of "functional": a liberal definition of the concept will increase the scope of permissible copying by diminishing the number of cases in which protection will be afforded.

A generally accepted44 definition of what is functional is offered by the Restatement of Torts: "A feature of goods is functional . . . if it affects their purpose, action or performance, or the facility or economy of processing, handling or using them; it is non-functional if it does not have any of such effects."45 This definition appears to be intended to provide an "objective" test for functionality—that is, if the product possesses any feature

40. For example, between 1937 and 1960 the Court of Appeals for the Seventh Circuit invalidated 22 design patents and upheld none. Amerock Corp. v. Aubrey Hardware Mfg., Inc., 275 F.2d 346, 349 n.1 (7th Cir. 1960).
42. Marvel Co. v. Pearl, 133 F. 160 (2d Cir. 1904). For a comprehensive discussion of the doctrine of functionality, see Note, Unfair Competition and the Doctrine of Functionality, 64 COLUM. L. REV. 544 (1964).
43. See notes 92-93 infra.
44. "[D]ecisional law has generally supported the view of the Restatement." Note, supra note 42, at 562. See, e.g., Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569 (2d Cir. 1959), cert denied, 362 U.S. 919 (1960) (pink color of Pepto Bismol is functional); Pagliero v. Wallace China Co., 196 F.2d 399 (9th Cir. 1952) (designs on hotel china are functional); J.C. Penney Co. v. H.D. Lee Mercantile Co., 120 F.2d 949 (8th Cir. 1941) (pocket design has commercial appeal and is functional); Sylvania Elec. Prods. v. Dura Elec. Lamp Co., 144 F. Supp. 112 (D.N.J. 1956), aff'd 247 F.2d 730 (3d Cir. 1957) (blue dot on flashbulb is functional).
45. RESTATEMENT OF TORTS § 742 (1938).
which displays the effects listed, the product is functional regardless of any countervailing considerations. Many courts have applied the test in this way.46

The Court of Customs and Patent Appeals, however, has dealt with the issue in a manner which clouds the simple language of the Restatement test. For example, in *In re Deister Concentrator Co.*,47 the court rejected an application for registration of the company's rhomboid-shaped shaking table on the Principal Register, citing the Restatement definition. The rationale for holding the Deister shape functional was said to be not that "the shape possesses utility, but that it is in essence utilitarian."48 In *In re Simmons Co.*,49 the same court reversed the Trademark Trial and Appeal Board's denial of supplemental registration for a mattress stitching pattern, noting that the board had not found the pattern "inherently functional."50 Both these characterizations suggest that the court is balancing or weighing functional and nonfunctional considerations, rather than simply applying the Restatement test. Such departures from an "objective" test not only make the Restatement definition harder to apply and increase uncertainty in the area, but also dilute what was originally a broad denial of trademark protection, thus decreasing the scope of permitted copying contrary to the apparent intent of the restaters and the courts that first forged the doctrine.51

Further depreciation of the functionality concept has come from several prominent cases which have allowed registration of product configurations without addressing that issue directly. For example, in *Ex parte Haig and Haig Ltd.*,52 the Pinch whiskey bottle was placed on the Principal Register without discussion of functionality. The Commissioner apparently felt that, since the bottle had previously been listed on the Supplemental Register,53 secondary meaning was the only relevant issue. Similarly, when the Minnesota Mining and Manufacturing Company (3M) sought to record the triangular shape of a chemical

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46. See cases cited in note 44 supra.
47. 289 F.2d 496 (C.C.P.A. 1961).
48. Id. at 506 (emphasis in original).
49. 278 F.2d 517 (C.C.P.A. 1960).
50. Id. at 519.
53. Id. at 229 n.1.
composition on the Supplemental Register, the Trademark Trial and Appeal Board refused registration on a ground other than functionality. In reversing the Board’s decision, the Court of Customs and Patent Appeals did not really consider functionality, finding merely that the composition’s shape had no functional significance “so far as the record shows.” Such a reluctance to inquire into this issue sets a precedent which could substantially erode the functionality doctrine. The importance of the concept, however, has been reaffirmed in other cases. In the recent case of In re Honeywell, Inc., the Court of Customs and Patent Appeals emphasized the importance of the functionality limitation. The court reversed the denial by the Trademark Trial and Appeals Board of principal registration of the company’s round thermostat cover, but it remanded for consideration of the functionality issue which the Board had not addressed. An application for certiorari in this case was recently denied; thus the scope of this doctrine remains in doubt.

The Restatement definition of functionality, when properly applied, is a broad one. The comment to that formulation expands it even further, demonstrating that the drafters intended the definition to include aspects of goods which operate only to make the goods attractive and therefore marketable:

When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended. Thus, the shape of a bottle or other container may be functional though a different bottle or container may hold the goods equally well. The determination of whether or not such features are functional depends upon the question of fact whether prohibition of imitation by others will deprive the others of something which will substantially hinder them in competition.

56. 335 F.2d at 840.
57. 497 F.2d 1344 (C.C.P.A. 1974).
59. RESTATEMENT OF TORTS, Explanatory Notes § 742, comment a (1938). See also id. § 741 and Explanatory Notes, which discuss the application of the functionality principle to the law of unfair competition.
Thus, the comment recognizes that form may be functional—a concept that has been termed "esthetic functionality." In addition, it also emphasizes that a proper test for esthetic functionality is keyed to the competitive result of the feature in question rather than to the manufacturer's intent or purpose. That is, a feature is functional if it affects competition, regardless of whether that attribute was meant to perform a particular function.

The leading case endorsing esthetic functionality is Pagliero v. Wallace China Co., in which the plaintiff sought damages and an injunction against use by a competitor of a name and design similar to that employed on the plaintiff's hotel china. The Court of Appeals for the Ninth Circuit refused to enjoin imitation of the pattern, holding that the decorative features of china are very closely related to its salability and are therefore "functional." The court then stated a test that closely parallels the "competitive result" standard of the Restatement: "If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright." The Restatement standard has also apparently been approved by other courts. For example, in an earlier Eighth Circuit opinion, J.C. Penney Co. v. H.D. Lee Mercantile Co., the court refused to hold that the defendant had competed unfairly by copying the pocket design from the front of bib overalls sold by the plaintiff, since the design had commercial appeal and was therefore functional. Consistent with the "competitive result" test, the opinion recognized that the concept of functionality includes features which are not strictly utilitarian, but which result in increased sales. Similarly, a district court in the Fifth Circuit recently endorsed the marketing aspect of functionality in Boston Professional Hockey Association Inc. v. Emblem Manufacturing Co. The plaintiff there sought to enjoin the defendant from manufacturing cloth emblems embodying the registered trade-
marks of National Hockey League teams. The court, citing Pagliero, went on to state that "[w]hen an artistic rendition creates a demand in the market which is unrelated to its feature as an indicia of source, the law will not afford that design protection under the trademark laws. In the instant case, the registered trademark is, in effect, the product itself."

The injunction was denied.

Not all courts, however, have shown as willing an acceptance of esthetic functionality as they have of the general functionality limitation. For example, one court apparently held that the function of an ashtray is to hold ashes, shape and appearance being therefore nonfunctional. Another court seemingly found that the only function of a decorative clock costing 175 dollars was to tell time. The concept of esthetic functionality was suggested in In re Mogen David Wine Corp., but the Court of Customs and Patent Appeals rejected it quite summarily, describing the argument as "ingenious" and finding no support for it in the cases cited.

In summary, the functionality doctrine, if broadly interpreted, can serve to assure public access to valuable products. In order for it to so operate, however, the doctrine—including the corollary of esthetic functionality—should be objectively applied.

III. TRADEMARK PROTECTION: A CRITICAL ANALYSIS

It has been shown that several types of protection are available for product configurations. The most generally available of these is the Lanham Act, but such protection may not be desirable for a number of reasons which are discussed in this section.

66. Id. at 464.
70. 328 F.2d 925 (C.C.P.A. 1964).
71. Id. at 930. In a concurring opinion, Judge Rich found the issue worth discussion, but concluded that the wine decanter was not esthetically functional because protection would not hinder competition, and loss of the right to copy would not take anything of value from the copier. 328 F.2d at 933.
A. UNSOUND BASES

One major reason for objecting to Lanham Act protection for product configurations is that the theoretical bases for this extension of trademark registration are unsound. Accordingly, expansion of the Act to cover this new field may not only be unwarranted but also dangerous.

1. The Sears and Compco Decisions

Two 1964 Supreme Court cases, Sears, Roebuck and Co. v. Stiffel Co.\(^{72}\) and Compco Corp. v. Day-Brite Lighting, Inc.,\(^ {73}\) suggest that protection against copying—other than that afforded by the constitutionally authorized patent system—is not permissible. The Sears case involved the sale by Sears of an exact copy of a pole lamp originally manufactured by the Stiffel Co., on which Stiffel had procured both design and mechanical patents. Compco had copied a cross-ribbed reflector used in a lighting fixture, originally manufactured and design patented by Day-Brite. All the patents had been held invalid by district courts.\(^ {74}\) There had been no finding, however, that either defendant was passing off its goods as those of the original manufacturer. In Sears there was no evidence of customer confusion about source, and the evidence of source confusion in Compco suggested that it occurred after the fixtures were in use, not at the time of purchase.\(^ {75}\)

On review, the United States Supreme Court ruled that state courts may not enjoin the copying of an article unprotected by patent or copyright, since such an injunction would be inconsistent with federal patent and copyright policy.\(^ {76}\) The effect of

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73. 376 U.S. 234 (1964). Both cases are extensively discussed in Product Simulation Symposium, 64 Colum. L. Rev. 1178 (1964).
75. The evidence was that fixtures made by one manufacturer were sent to another for repair. Not only is this incident suggestive only of confusion after a purchase had been made, but also there is considerable evidence of the care taken by Compco to prevent customer confusion, including clearly labelling both the fixtures and the containers in which they were shipped and not selling through manufacturer's representatives who handled competing lines. 376 U.S. at 237 (emphasis in original).
76. Justice Black's opinion in Compco seems to find in the Constitution and federal patents statutes a right to copy which conflicts with state power to issue injunctions against imitation. The right to copy exists at common law, however, and is therefore not dependent upon those
these decisions on the scope of Lanham Act protection is not clear. If the decisions are interpreted as being of constitutional dimension, the provisions of the Lanham Act which seemingly permit trademark protection of objects and configurations might then arguably be unconstitutional and invalid as restrictions on the right to copy.\textsuperscript{77} Thus, Justice Black, who wrote the majority opinion in both cases, stated 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."\textsuperscript{78} Other language in the majority opinions, however, appears to retreat from this apparently clear statement of a constitutional basis and instead indicates possible reliance on statutory preemption doctrines.\textsuperscript{79} Moreover, it can be argued that trademark protection is not precluded by \textit{Sears} and \textit{Compco} even if the decisions are constitutional in nature, since registration arguably does not prohibit copying the article but merely bars its use for the same or a similar purpose. The protection afforded therefore does not fall within the sphere of \textit{Sears} and \textit{Compco} and would not be unconstitutional.\textsuperscript{80}

Even if \textit{Sears} and \textit{Compco} rest only on federal preemption doctrines, arguments that these cases rule out Lanham Act protection for objects remain. One argument is simply that any attempt to rationalize the trademark act with the patent statutes as interpreted by the Supreme Court requires preservation of the right to copy. A more imaginative argument reflects the observation that the Lanham Act only permits registration of exist-
TRADEMARK PROTECTION

ing rights: it does not create new ones. Under this theory, the effect of the Supreme Court’s interpretation of the patent statutes is to deny that there are existing source identification rights, thus leaving nothing to be registered under the Lanham Act.

Whatever interpretation is given to the Sears and Compco decisions, however, one thing is clear: they represent a strong endorsement of the competitive economy and the right to copy. This fact alone undercuts the theoretical basis for protection of product configurations under the Lanham Act.

2. Improper Judicial Motivation

Some courts have apparently based their protection of shapes and product configurations upon a moralistic reaction to what these courts perceive as outrageous actions by copiers. For example, in Compco, the Court of Appeals for the Seventh Circuit concluded that Compco’s actions violated “old fashioned Honesty.” An even better example is the opinion of Judge Medina in American Safety Table Co. v. Schreiber, which concerned the detailed copying of a product on which the patent had expired. Judge Medina, though recognizing the importance of imitation, decried the defendant’s “willful and cunningly contrived

81. “It is our understanding of the Lanham Act that it is for the registration, not the creation, of trademarks. Its terminology—indeed, the history of federal trademark statutes—presupposes the pre-existence of a trademark to be registered.” Mine Safety Appliances Co. v. Electric Storage Battery Co., 405 F.2d 901, 904 (C.C.P.A. 1969) (emphasis in original). See also S.C. Johnson & Son, Inc. v. Johnson, 175 F.2d 176, 181–82 (2d Cir. 1949) (Clark, J., dissenting); In re Deister Concentrator Co., 289 F.2d 496, 501 (C.C.P.A. 1961).

82. Language in In re Honeywell, Inc., 497 F.2d 1344, 1349 (C.C.P.A. 1974), cert. denied, 43 U.S.L.W. 3349 (U.S. Dec. 17, 1974), suggests that the lessons of Sears and Compco are irrelevant to that case: Nor do we believe that the language of the opinions in Sears, Roebuck and Co. v. Stiffel Co. and Compco Corp. v. Day-Brite Lighting, Inc., which were concerned with the conflict between a state’s law of unfair competition and the federal patent law, is pertinent to the present issue of registrability for federal trademark protection (citations omitted).

The Sears and Compco decisions are clearly relevant, however, in endorsing the right to copy and may also reflect constitutional limitations which would determine the Honeywell case. See text accompanying notes 76–81 supra.


84. 269 F.2d 255 (2d Cir.), cert. denied, 361 U.S. 915 (1959).

85. “For imitation is the lifeblood of competition. It is the unimpeded availability of substantially equivalent units that permits the nor-
pirating." Judge Clark dissented in an opinion which pointed out the inappropriateness of emotive terms such as "poach," "deceitful," and "fraudulent."

It seems apparent that the moral outrage evidenced by the courts in many of these cases reflects a perceived violation of some property rights which the plaintiff is thought to hold. The patent and copyright laws, however, were designed to establish a property right that had not previously existed, in derogation of a conceded common-law right to copy. The essential circularity of this attempt to reach a decision on the basis of perceived rights is apparent if one considers that the more modern conception of property is as a collection of rights and obligations that society either protects or requires. This conception makes it clear that the nature of any property involved is only a reflection of the preliminary decision as to the extent of protection that will be afforded. Neither the motivation of the copier nor the sensibilities of the judge should be a factor in deciding whether a copied item is to be protected, except to the extent that the copier is shown to have deceived the public about the source of his goods.

3. Foreign Trademark Protection

There is substantial evidence that the drafters of the Lanham Act created the Supplemental Register to assist American manufacturers in obtaining foreign protection of their trademarks. Some countries refuse to respect trademarks unless they are also protected in the country of origin. It is therefore possible to argue that at least supplemental registration should be broadly extended to product shapes and configurations in order to avoid prejudicing international trade possibilities. Denial of supplemental registration of shapes and objects, however, will only interfere with foreign protection of that class of symbols: it will leave intact the registration of more traditional two-

86. Id. at 270.
87. Id. at 277.
88. Even the terminology of the court's outrage reflects violation of property rights; for example, Judge Medina refers to "piracy," "pirating," and "poaching." Id. at 270, 272.
89. See note 93 infra.
90. See text accompanying notes 22-24 supra.
dimensional trademarks. Furthermore, this argument raises serious questions as to the extent to which interference with domestic competitive mechanisms should be accepted to obtain a dubious international advantage. Thus, although the goal of securing foreign trademark protection supports extension of the Lanham Act's coverage to product configurations, it is not really a substantial reason for doing so.

B. THE ECONOMIC EFFECTS OF TRADEMARK PROTECTION FOR OBJECTS: PRODUCT DIFFERENTIATION VERSUS SOURCE IDENTIFICATION

A major factor in any decision to extend trademark protection to shapes and objects must be the economic effect which any such extension would have. Public policy in this area favors free competition and thus preservation of the right to copy. Conversely, trademark protection of objects is certain to have some deleterious effect on competition: the Commissioner of Patents has characterized such protection as a monopoly on the protected item, which allows the registrant to exclude any other supplier from direct competition. The scope of this perceived monopoly is an important factor in determining whether such protection should be afforded, and thus it becomes necessary to examine carefully the specific economic effects of any expanded prohibition of imitation.

Trademark protection of product shapes or configurations may enhance either or both of two forms of identification. The consumer may use the registered shape or configuration to identify the product or type of product which he wishes to purchase.

92. "Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested." Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938).
93. The right to copy is a right which exists under the common law. Id. at 116; In re Deister Co., 289 F.2d 496, 501 n.3 (C.C.P.A. 1961). See also Leeds, supra note 76, at 1180.
94. "While a patent is issued for only a limited term, a trademark becomes the permanent property of its owner and secures for him a monopoly in perpetuity." Alan Wood Steel Co. v. Cranston, 150 F. Supp. 861, 862 (D.D.C. 1957).
95. See text accompanying notes 119-26 infra.
96. Professor Treece suggests the Skotch Kooler as an example. Hamilton Skotch Corporation began producing a cylindrical beverage cooler in 1951, which by 1957 was being imitated. The question Treece poses is whether purchasers sought only a cylindrical, plaid-decorated cooler or desired the Hamilton-Skotch product specifically. Treece, Protectability of Product Differentiation: Is and Ought Compared, 18 Rutgers L. Rev. 1019, 1019-20 (1964).
or the consumer may use the protected feature to identify the supplier of the product. The former pattern of identification has been characterized by Professor Treece as product differentiation,97 which he argues has four significant anticompetitive effects. First, it permits the seller to acquire a control over price which he could not otherwise maintain.98 Second, product differentiation impedes rational individual purchase decisions.99 Third, it adds to the cost of production and marketing by requiring expenditures for differentiation not related to the quality or actual needs of the product.100 Fourth, entry into an industry is made more expensive because of higher initial losses while the consumer learns to identify the product by a new shape.101 Treece argues that consumers concerned about source can be adequately informed by labelling,102 without suffering the anticompetitive effects which result from the protection of product or container configurations.

The second identification pattern, which might well be termed source identification or differentiation, occurs when the consumer uses the shape or configuration of a product to identify the manufacturer or supplier. This pattern is an expression of the concept of secondary meaning and is the one which trademark registration is theoretically intended to protect.103 Source identification has long been recognized as an important factor in maintaining accountability and competitive quality.104

97. Id.
98. Id. at 1020. The suggestion is that if a manufacturer can differentiate his product in appearance and protect the distinction, purchasers will buy the product even though the quality level is no higher than a nondifferentiated product.
99. Id. at 1021. Treece suggests that purchase decisions are often made on the basis of advertising, with little thought as to relative quality or source of goods.
100. Id. An example is the cost of yearly car model changes.
101. Id. at 1022.
102. This is apparently Justice Black's position in Sears and Compco as well. See text accompanying notes 72-82 supra.
103. This identification pattern has been thought to be valuable because it allows the copier to share in the goodwill of the product, but not of the producer. "From the Kellogg case, the conclusion is to be drawn that one who claims that another is guilty of unfair competition in copying his product, must show that the consuming public is primarily concerned in the producer, rather than in the product itself . . . ." West Point Mfg. Co. v. Detroit Stamping Co., 222 F.2d 581, 589 (6th Cir. 1955). See also Crescent Tool Co. v. Kilbourn & Bishop Co., 247 F. 299, 300 (2d Cir. 1917).
The economic effects of trademark protection for objects must therefore be considered positive insofar as they prevent consumer source confusion and negative to the extent that they prevent the operation of the usual competitive processes. If the desired source identification can be assured through labelling or other procedures, therefore, the anticompetitive effects of product differentiation make a strong argument for denying trademark protection.

One example of a court's attempt to weigh these countervailing effects is *Lucien Lelong Inc. v. George W. Button Corp.*, an unfair competition case. The *Lelong* court granted an injunction prohibiting defendant's continued use of a perfume bottle very similar to that of the plaintiff. The court rejected labelling as a method of protecting source identification, noting that the eventual location of the perfume bottle would be the boudoir rather than the pantry, and that any label large enough to be effective in identifying the manufacturer would destroy the value of the product. The apparent conclusion of the court was thus that the anticompetitive effects of product differentiation must be suffered for lack of a reasonable method by which to protect source identification. Even if the court's rather summary dismissal of labelling was justifiable in *Lelong*, it is clear that similar holdings in cases involving thermostats, liquor bottles, wine decanters and the like are less convincing. Because labelling will effectively protect source identification in the substantial majority of cases, the reasonable course would normally be to avoid competitive difficulties by restricting trademark protection.

C. CONFLICT WITH THE PATENT SYSTEM

1. Judicial Development of the Interplay Between Patents and Trademarks

General acceptance of the availability of Lanham Act protection for three-dimensional objects would make conflict or overlap with the protection afforded by patents, particularly design patents, inevitable. This section will consider how interaction between those two forms of protection bears on whether the trademark laws should be so extended.

106. Id. at 710.
107. See text accompanying note 179 infra.
Traditionally, courts have held that a trademark registration cannot be obtained during or after the life of a design patent. The rationale in many cases has been that to allow a trademark on a shape or design would provide an unlimited monopoly on that item in direct conflict with the expressly limited term of a patent. The substantial body of cases that have adopted this rationale are illustrative of what may be termed the "quid pro quo" theory of patents. This theory holds that the patent grant is a contract between society and the inventor under which the inventor agrees to dedicate his invention to the common weal in return for a complete monopoly over a limited term. Trademark protection of the very item which had been design patented would be inconsistent with that postulate: it would extend the monopoly and thus destroy the careful balance of interests which the theory suggests lies behind the patent principle.

Recently some courts—most notably the Court of Customs and Patent Appeals—have begun to repudiate the quid pro quo theory. In one such case, Ex parte Caron Corp., the Commissioner compared the purpose and function of design patents and trademarks. He found that, while the function of the design patent is to "protect the patentee in his right to exclude others from making, using or selling the article," the trademark func-

109. "The Trade Mark Act of 1946 clearly was not intended to repeal the law as to design patents and it is not believed that an alternate form of protection, without limitation as to time could have been intended." Id. at 176.
110. In re Deister Concentrator Co., Inc., 289 F.2d 496 (C.C.P.A. 1961); In re Shakespeare Co., 289 F.2d 506 (C.C.P.A. 1961). Two cases which postdate the apparent rejection of the quid pro quo theory by the Court of Customs and Patent Appeals in In re Mogen David Wine Corp., 328 F.2d 925 (C.C.P.A. 1964), involved requests for trademark protection of items that had previously been protected by utility patents. In Best Lock Corp. v. Schlage Lock Co., 413 F.2d 1185 (C.C.P.A. 1969), and In re Shenange Ceramics, Inc., 362 F.2d 287 (C.C.P.A. 1966), the court held that the patents established the functionality of the items and denied trademark protection. This achieves the quid pro quo result without accepting the theory. The opinion of the Shenange court, however, left some doubt as to its position on the theory by speaking of the patented item as having entered the public domain and thus become inappropriate for protection. Id. at 292.
112. Utility patents are granted for 17 years. 35 U.S.C. § 154 (1970). Design patents are granted for 3½, 7, or 14 years at the election of the applicant. Id. § 173.
114. Id. at 358.

A DIFFERENT WAY OF STATEING THE ARGUMENT WHICH SUGGESTS THAT THE TWO PROTECTIONS DO NOT CONFLICT WAS OFFERED IN *IN RE PEPsi-COLA CO.*119 IN THAT CASE, THE COURT HELD THAT WHILE A DESIGN PATENT ALLOWS THE PATENTEE TO PREVENT ANY MANUFACTURE OR USE OF THE PROTECTED SUBJECT,120 TRADEMARK PROTECTION IS OF A MORE LIMITED SCOPE AND ONLY REGISTERS THE HOLDER'S RIGHT TO USE THE MARK AS AN IDENTIFIER OF HIS GOODS.121 IN OTHER WORDS, A COPIER WOULD PRESUMABLY HAVE THE RIGHT TO USE A WHISKEY BOTTLE122 TO HOLD FLOWERS, OR A WINE DECANTER123 TO SELL MILK, SO LONG AS THE RESULT OR INTENT WAS NOT TO CAUSE SOURCE CONFUSION. THE DIFFICULTY WITH THIS SUGGESTION APPEARS MOST GRAPHICALLY IF ONE TRIES TO IMAGINE WHAT OTHER USE COULD REASONABLY BE MADE OF A THERMOSTAT COVER,124 OR OF A TAPE DISPENSER.125 WHEN THREE-DIMENSIONAL OBJECTS ARE IN-

115. Id.
116. Id.
117. Id.
118. Id. at 359.
120. Under the law of trade secrets, independent creation or "reverse engineering" could legitimately be used to deprive the originator of his exclusive use. However, under the patent statute the holder of a patent can prohibit any such duplication. Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 491 (1974).
olved, the verbal distinctions which these courts have attempted to draw between patent and trademark protection represent almost no significant difference in reality. The actual effect of the argument is thus to allow the trademark holder almost complete rights in the object, effectively extending the limited monopoly originally granted by the design patent.126

A second, more straightforward, type of attack on the quid pro quo theory is the argument that the right to copy was not created by the patent laws, but rather is a pre-existing common law right.127 The inventor therefore cannot grant that right in exchange for his monopoly. What he does give up is secrecy; that is, he discloses his invention in return for the proffered monopoly. The inventor therefore has satisfied his obligation at the beginning of the patent term, and nothing should prevent him from seeking trademark protection at the end of the monopoly period. If the nature of the item is such that trademark protection will assure near monopoly, however, it seems difficult to locate the public's "quid" under this theory.128

Another way in which patent and trademark protection may interact involves the trademark requirements of commercial use and secondary meaning. One of the requirements for supplemental registration is a period of use of the mark in commerce,129 and graduation to the Principal Register requires that the symbol be shown to have acquired a secondary meaning as an indicator of the product's source.130 Obviously, either of these requirements would be more easily met during the monopoly period of an existing patent, since the manufacturer could exclude similar objects from the marketplace during that time, thus frustrating the commercial viability prerequisites of the Lanham Act. A suggested solution is to require that the necessary trademark

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126. In light of the limited term of the patent monopoly, see note 112 supra, the very high failure rate of design patents, see note 40 supra, and the essentially monopolistic protection afforded by trademark protection in some cases, it seems at least arguable that trademark protection may be more substantial.

127. See note 93 supra.

128. See text accompanying notes 119-26 supra.

129. "All marks . . . which have been in lawful use in commerce by the proprietor thereof, upon or in connection with any goods or services for the year preceding the filing of the application . . . ." 15 U.S.C. § 1091 (1970).

130. See note 10 supra,
standards be met after the expiration of the patent period;\textsuperscript{131} this result has apparently been endorsed in one case.\textsuperscript{132} There are, however, two difficulties with the proposed solution. First, if secondary meaning has already been established during the monopoly period, any further waiting period can only be arbitrary. It would be difficult to prove that something which was previously established has now been independently re-established, especially when the concept in question is one as tenuous as that of secondary meaning. Second, since both the commercial use and secondary meaning requirements appear designed to put the symbol to the test of the marketplace before protection will be afforded, use of the patent monopoly for establishing the product would seem to frustrate the policy behind the Lanham Act requirements. Professor Treece has suggested that a substantially longer waiting period could be required of a patentee who applies for trademark protection, so as to counterbalance the higher costs and risks which competitors of the fully differentiated product would incur upon entering the market when the patent expires.\textsuperscript{133} The suggested solution is thus fatally flawed; moreover, no other fair method appears to prevent use of the patent monopoly to frustrate the marketplace requirements of the trademark act, if both patent and trademark protection are to be allowed.

It is therefore clear that a pragmatic, rather than a formalistic, consideration of the interplay of patent and trademark shows that trademark protection can amount to an effective extension of the patent monopoly. Difficulty also arises in reconciling the patent monopoly and the trademark market requirements. Both these problems suggest the need to restrict the overlap of patent and trademark protection.

2. The Honeywell and Mogen David Cases

Despite the apparent conflicts between the two forms of protection, the Court of Customs and Patent Appeals has held in


\textsuperscript{132} In \textit{Ex parte Caron Corp.}, 100 U.S.P.Q. 356, 360 (Dec. Com. Pat. 1954), the Commissioner stated that use of a perfume bottle under the patent "probably was not a use which would entitle it to claim any rights under the trademark laws." However, the Commissioner found sufficient use after the item entered the public domain, and allowed supplemental registration.

\textsuperscript{133} See note 101 \textit{supra} and accompanying text.
two cases that registration on the Principal Register is permissible after the expiration of a valid design patent. In the first case, Mogen David Wine Corporation applied to have its wine decanter listed on the Principal Register. The Trademark Trial and Appeal Board refused to order registration, holding that trademark protection would constitute an illegal extension of the design patent which the company already held on the decanter.\footnote{In re Mogen David Wine Corp., 134 U.S.P.Q. 576 (T.T.A.B. 1962), rev'd, 328 F.2d 925 (C.C.P.A. 1964).} The Court of Customs and Patent Appeals reversed, holding that "trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not 'extend' the patent monopoly. They exist independently of it, under different law and for different reasons."\footnote{328 F.2d at 930.} The case was then remanded for a determination of whether secondary meaning had in fact been established.\footnote{On remand, the Board held that the applicant had not made a sufficient showing of secondary meaning and denied registration. In re Mogen David Wine Corp., 145 U.S.P.Q. 85 (T.T.A.B. 1965).}

Ten years later, the same court in \textit{In re Honeywell, Inc}.\footnote{In re Honeywell, Inc., 169 U.S.P.Q. 619 (T.T.A.B. 1971).} held that it was error for the Trademark Trial and Appeal Board to have refused to order principal registration of the round cover of the Honeywell thermostat.\footnote{The configuration involved is a smooth outer ring with a clear plastic center, and comprises nearly the entire visible part of the thermostat. Examples are omnipresent; Honeywell claims to have sold more than twenty million of these covers. \textit{Id.} at 621.} This configuration had been covered by a design patent that expired while the trademark application was pending.\footnote{497 F.2d at 1344 (C.C.P.A. 1974), cert. denied, 43 U.S.L.W. 3349 (U.S. Dec. 17, 1974).} The Trademark Examiner had refused registration on the grounds that the configuration was functional and therefore not capable of being a trademark,\footnote{497 F.2d at 1345.} and that the existence of the previous design patent did not "enhance applicant's attempt to secure trademark protection for the same subject matter."\footnote{497 F.2d at 1344 (C.C.P.A. 1974), cert. denied, 43 U.S.L.W. 3349 (U.S. Dec. 17, 1974).} The Trademark Trial and Appeal Board af-
firmed the Examiner's decision without addressing the functionality question, holding directly that the trademark protection sought would constitute an illegal extension of the design patent.\textsuperscript{142} The Board distinguished the \textit{Mogen David} holding by noting that the wine bottle in that case was only the container for the product, whereas the Honeywell application pertained to a part of the product itself.\textsuperscript{143} On appeal, the Court of Customs and Patent Appeals reemphasized what it had held in \textit{Mogen David} to be clear differences between the bases of trademark and design patent protection, and reversed the Board,\textsuperscript{144} remanding the case for consideration of the functionality issue. The Supreme Court has recently denied certiorari in the case.

The \textit{Honeywell} and \textit{Mogen David} cases represent the only two instances in which courts have dealt with the overlap between design patents and the substantial safeguards afforded by principal registration. They demonstrate that at least the Court of Customs and Patent Appeals is unwilling to limit the apparent conflict between the patent and trademark laws to the Supplemental Register. This result is subject to all of the criticisms previously raised; indeed, it is even less defensible because listing on the Principal Register approximates monopoly protection more closely than inclusion on the Supplemental Register. The cases thus graphically illustrate the need for courts to limit trademark protection of shapes and configurations.

D. PROTECTION OF SUBPATENTABLE ITEMS

It is clear from the foregoing discussion that trademarks may indeed afford for some objects protection which approximates a patent monopoly. Since the trademark requirements do not include the prerequisite that the object show any level of innova-

\begin{itemize}
\item \textsuperscript{142} "[R]egistration must be refused on the ground that the registration sought by applicant would extend the monopoly which the applicant has enjoyed for a period of fourteen years from the issuance of the design patent on January 17, 1956." 169 U.S.P.Q. at 621.
\item \textsuperscript{143} \textit{Id.} at 622. This distinction does not seem tenable. Although the cover will stay with the thermostat as long as the product is in use, the wine bottle is certainly likely to accompany the wine until consumption, and the bottle, if sufficiently decorative, may continue to be used long after. Although the product/container distinction does suggest a way of defeating the Honeywell application, it would introduce complex and unnecessary questions of how the distinction is to be made.
\item \textsuperscript{144} 497 F.2d at 1348-49.
\item \textsuperscript{145} 43 U.S.L.W. 3349 (U.S. Dec. 17, 1974).
\end{itemize}
tion, however, trademark registration can provide a monopoly of infinite duration for objects that could not be granted even the limited term protection allowed by the patent clause of the United States Constitution. To the extent that patent protection for the "limited times" specified in the Constitution is read as exclusive, such use of trademark registration is arguably unconstitutional. At the least, such an interpretation of the Lanham Act seems to be in conflict with the intent of the patent statutes.

This problem would still exist even if the quid pro quo theory of patents were more rigorously enforced, since the objects in question here are concededly non-patentable. In fact, forced to a choice between short-term patent protection and infinite trademark protection, many manufacturers might abandon the design patent. This seems particularly likely in light of the high failure rate of the design patents when tested in court.

IV. ALTERNATIVE METHODS OF RESTRICTING TRADEMARK REGISTRATION

The arguments which have been examined suggest that trademark registration of objects and shapes should be curtailed. Such a policy would beneficially affect commerce. Source identification could be maintained. Curtailment of Lanham Act protection of configurations would also alleviate the conflict between the patent and trademark systems and enhance the competitive economy endorsed in the Sears and Compco cases. A possible adverse effect of curtailment, however, would be a reduction of available foreign trademark protection. This section will consider alternative methods of implementing such a restriction of trademark registration.

147. See text accompanying note 76 supra.
148. Abandonment of the design patent system may not be to society's detriment, however. Since the courts refuse to enforce most design patents, see note 40 supra, the theoretical monopoly is a doubtful phenomenon. It therefore seems unlikely that possible design patent protection acts as a significant stimulus to the creation of new ornamental designs.
149. See note 40 supra.
150. "The literacy rate is high enough in the United States, after all, to justify the courts in requiring consumers who care about source to read names on labels." Treece, Copying Methods of Product Differentiation, 38 Notre Dame Law. 244, 261 (1962).
TRADEMARK PROTECTION

A. UNCONSTITUTIONALITY OR INCONSISTENCY WITH
   PATENT STATUTES

One possible way in which trademark protection could be re-
stricted would be by a Supreme Court decision that Sears and
Compco rest on constitutional grounds, thus making section 23
of the Lanham Act unconstitutional as conflicting with the pat-
ents clause. This solution is unlikely to be adopted in light
of the Court's reluctance to render constitutional decisions. Al-
ternatively, the Court could declare that registration of objects
should be abandoned as a matter of reconciling the two statutes.
Either of these solutions, however, would only address the prob-
lem of conflict with the patent statutes; presumably neither
would significantly restrict registration of subpatentable config-
urations, unless object registration under the Lanham Act were
to be completely eliminated. A further difficulty with a rem-
edy of this nature would be the necessity of defining what is
subpatentable: the patent office standard for issuance of a
design patent is clearly quite different from the standard em-
ployed by the courts to evaluate its validity.

B. THE QUID PRO QUO THEORY

A vigorous enforcement of the quid pro quo theory of patents
would eliminate trademark protection of objects which had re-
ceived patent protection. Like the previous solution, this would
not effectively limit the registration of subpatentable items.
Furthermore, its effect would be to offer the manufacturer a
choice between patent and trademark. In light of the limited
time period and poor enforcement rate which characterize design
patents, many applicants would surely opt for trademark protec-
tion. Therefore, although this alternative is a reasonable way
to rationalize the statutes, it might well fail almost completely

151. See text accompanying notes 72-82 supra.
152. Such a result could be premised on a finding that the patent
    clause was intended to occupy the field fully, thus defining a subpatent-
    able area within which neither Congress nor the states could create any
153. The difficulty in deciding which configurations might fall in the
    patentable zone suggests the desirability of avoiding confusion by refus-
    ing registration to all such items. Though this may seem extreme, it
    must be remembered that the configurations incapable of achieving
    patent protection have failed to achieve a significant degree of innovation
    or novelty. See note 31 supra.
154. See note 40 supra.
155. See note 126 supra.
as a method of restricting trademark registration of objects. The problems concerning the unsound theoretical foundation for trademark protection of product configurations and the economic problems discussed earlier would still remain.

C. Restricting Objects to the Supplemental Register

A third remedy would be that of limiting configurations and objects to the Supplemental Register. This would avoid possible limitations on trademark protection in foreign countries. It would eliminate the prima facie right to the mark and the contestability after five years which is assured by the Principal Register. The primary difficulty with this suggestion is that there appears to be no satisfactory way to implement it short of congressional revision of the Lanham Act. The obvious solution would seem to be construction of section 2(f) of the Lanham Act—which governs listings on the Principal Register—as excluding all of the items included in section 23—which applies to the Supplemental Register. This solution would not necessarily be inconsistent with the overall structure of the statute if the creation of the Supplemental Register was shown to exist for some purpose beyond that of a stepping stone to the Principal Register. Unfortunately, the words of the statute do not seem to support such a construction. Section 2(f) uses the word “mark,” which is generally applicable to the Supplemental Register, rather than “trademark,” which relates to the Principal Register. Furthermore, section 2(f) cites sections 2(a) through (d) as the only exceptions to the general rule allowing principal registration of any mark, whatever its form, which has become distinctive of the applicant’s goods. None of these subsections show any promise

156. See text accompanying notes 11-16 and 19-21 supra. Reducing the range of configurations allowed on the Principal Register would, of course, reduce the conflict between the patent and trademark systems.

157. One purpose for its existence, for example, might be as a solution to the foreign trademark registration problem. See text accompanying notes 22-24 supra.

158. See In re Mogen David Wine Corp., 328 F.2d 925, 930-31 (C.C.P.A. 1964). But see the argument in In re Deister Concentrator Co., 289 F.2d 496, 502 (C.C.P.A. 1961), suggesting that the language of section 2(f) does not mandate such registrations, and the discussion in Ex parte Minnesota Mining & Mfg. Co., 92 U.S.P.Q. 74 (Pat. Off. Exam. Chief 1952), where registration was refused on the basis that configurations and containers cannot be registered on the Principal Register.

159. Subsection (a) deals with immoral matter; subsection (b) forbids use of flags or insignia of states or nations; subsection (c) prohibits registration of marks comprising names of living individuals without their consent or of deceased Presidents without the consent of the surviv-
as a basis for denying principal registration to configurations. Another possible method of limiting configurations to the Supplemental Register would be a uniform presumption that such configurations are not capable of achieving secondary meaning, and thus are ineligible for the Principal Register. There is no support for such an idea in case law, however, and it would seem to be in direct conflict with the scheme of the statute, which requires that marks admitted to the Supplemental Register be "capable of distinguishing the applicant's goods." Moreover, this third remedy would still permit the evils of object registration to the extent that such protection is given by the Supplemental Register.

D. A Return to Functionality

The fourth possible way of curtailing registrations of shapes and configurations would be to reinforce the doctrine of functionality. Strict enforcement of the functionality doctrine, including the concept of esthetic functionality, would drastically curtail the range of three-dimensional objects which could be registered.

160. Subsection (e) denies registration to marks which are merely descriptive. 15 U.S.C. § 1052(e) (1970). Judge Rich, concurring in In re McIlhenney Co., 278 F.2d 953, 957 (C.C.P.A. 1960), argued that a two-ounce pepper sauce bottle is pictorial and merely descriptive of the product, which is a bottle of pepper sauce, and therefore not registrable. However, because only subsections (a) through (d) are stated as exceptions to the inclusive language of section 2(f), subsection (e) should not bar principal registration. 15 U.S.C. § 1052(f) (1970).


162. Careful scrutiny of applications for the presence of secondary meaning would alleviate the problem somewhat. An example of such scrutiny is the Mogen David case. The Court of Customs and Patent Appeals remanded the case to the Board to determine the factual issue of whether the decanter operated as a trademark. 328 F.2d at 932. On remand, 145 U.S.P.Q. 85 (T.T.A.B. 1965), the Board held that the applicant had not made a sufficient showing of secondary meaning and denied registration.

163. The possible problem with this alternative is that language in the Compco opinion suggests that Justice Black was there rejecting the functionality doctrine as a test for registrability under the Lanham Act, at least in unfair competition cases:

That an article copied from an unpatented article could be made in some other way, that the design is "nonfunctional" and not essential to the use of either article, that the configuration of the article copied may have a "secondary meaning" which identifies the maker to the trade, or that there may be "confusion" among purchasers as to which article is which or as to who is the maker, may be relevant evidence in applying a State's law requiring such precautions as labelling; however, and regardless
Shapes could still be registered, but only in the unusual circumstance where they perform no marketing or attractiveness function. Although this solution would theoretically reduce the number of marks registrable in foreign markets, it would not affect foreign protection of more traditional types of source identification. An added benefit would be a reduction in the interference between the trademark and patent systems.

In order for this solution to be effective in minimizing the registration of shapes and objects, however, the courts must uniformly adopt the broad view of functionality offered by the Restatement. This would make necessary a rejection of balancing-type tests, which suggest a weighing of functional versus nonfunctional aspects. A more easily applied test, which would result in the advantages sought, might be whether the configuration has any significant functional feature, including the enhancement of its consumer attractiveness.

V. RECOMMENDED SOLUTION

For the reasons presented, reinforcing the doctrine of functionality appears to be the best solution to the problems explored in this Note. Because this solution would drastically reduce the number of instances in which trademark protection is afforded to objects, the theoretical problems of such a system would be minimized, as would conflicts and overlaps with the patent system. Subpatentable ideas would no longer be protect-

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of the copier's motives, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling.

376 U.S. at 238. Professor Leeds, however, argues that the thing copied in Sears was the entire article, and thus necessarily functional, and that the Compco reflector had been held functional in the lower courts. This reasoning suggests that the functionality doctrine may still be applicable in state unfair competition law after Sears and Compco. Leeds, supra note 76, at 1180, 1181. Moreover, regardless of whether Justice Black intended to reject application of the doctrine to unfair competition, it should survive as applied in trademark law. In Sears and Compco the intent of the Court was to broaden the scope of permitted copying. A broad functionality doctrine would have this same effect when applied to the Lanham Act in that the scope of congressionally authorized protection would be restricted.

164. See text accompanying notes 90-91 supra. Shapes and configurations, however, might play a more necessary role in source identification in parts of the world with a substantially lower literacy rate than the United States. See note 150 supra.

165. See text accompanying note 45 supra.

166. See, e.g. In re Deister Concentrator Co., 289 F.2d 496, 506 (C.C.P.A. 1961); In re Simmons Co., 278 F.2d 517, 519 (C.C.P.A. 1960).
able under the trademark laws, unless they had no significant functional features. Finally, the anticompetitive economic effects of product differentiation would be avoided to the extent that manufacturers are denied the infinite monopoly of the Lanham Act.

A matter of some concern, however, is the extent to which the advantageous effects of the present system can be retained. The reciprocal foreign protection benefits would probably be lost, but this would be an insubstantial loss at worst. Of greater import is the possible loss of the source identification behavior which present law fosters. If trademark protection were to be curtailed, however, there remains a common law doctrine which would still be available to preserve the competitive benefits that flow from the ability of consumers to determine the source of the goods they purchase: the palming-off doctrine. The very existence of this doctrine is itself a strong argument that attempts to provide source identification by trademark protection of objects and configurations are unnecessary.

The well recognized right to prevent intentional deception of consumers as to product source is embodied in the palming-off doctrine. Known as such because it prevents a manufacturer from palming off his goods as those of another, it has occasionally been described as allowing copiers to share in the good will of the product, but not of the producer. Cases have held that a manufacturer can be prevented from labelling his product so as to create confusion even though the deception is in fact practiced by a retailer. The doctrine apparently survives unaffected by the Sears and Compco opinions, which cast doubt on the validity of trademark protection for objects. Those decisions indicate that enforcement of the common law prohibition against palming off goods is not proscribed, at least to the extent that it eliminates consumer source confusion by requiring labelling. Language in the Compco opinion further sug-

167. See text accompanying notes 90-91 supra.
168. See text accompanying notes 103-04 supra.
169. A standard was suggested in Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 799 (3d Cir. 1949). "The trial judge found as a matter of fact that 'no intelligent purchaser using reasonable care would be confused as between the goods of either plaintiff.'"
170. See note 103 supra.
172. See text accompanying notes 72-82 supra.
173. "Doubtless a state may . . . require that goods, whether patented or unpatented, be labeled or that other precautionary steps be
gests that a state can impose liability for palming off, though not for the actual act of copying or imitating in the absence of such a violation.

It is reasonable to suggest that any limitation on the right to trademark protection for configurations be accompanied by assurances of the ready availability of protection against palming off. This might be achieved by statutes permitting the state to impose labelling requirements upon a showing that source confusion is likely, rather than requiring a showing of actual consumer confusion in order to grant relief.

Two important aspects of the palming-off doctrine detract from the appeal of this doctrine. First, it is a common-law doctrine and there is therefore no consistent statutory basis for its application. The protection afforded can and will vary substantially from state to state. Second, the primary method of enforcing the doctrine must be by the required labelling of products as to source. As emphasized in the Lucien Lelong cases, this may entail some loss of esthetic appeal for certain products. This loss, however, can be alleviated to a significant degree by recognizing that source identification is important at the time a purchase decision is made, and not necessarily during the entire span of consumer use. Removable labels would therefore meet the requirement of the law while preserving esthetic appeal.

One further issue which should be considered in connection

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174. "A State of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer's reputation for quality and integrity, deceive the public by palming off their copies as the original." Compco Corp. v. Day-Brite Lighting Inc., 376 U.S. 234, 238 (1964).

175. "[N]either these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling." Id.

176. Thus the competitive benefits of source identification would be preserved. See text accompanying note 104 supra.


178. Thus the first Lelong case, Lucien Lelong v. George W. Button Corp., 50 F. Supp. 708, 710 (S.D.N.Y. 1943), held that labelling the cologne bottle would destroy its esthetic value, and was thus not available as a solution. The force of this argument was substantially abated, however, by the second Lelong case, Lucien Lelong v. Lander Co., 164 F.2d 395 (2d Cir. 1947), in which the court found that such labelling would indeed be effective.

179. See note 75 supra and accompanying text.
with this proposed solution is the effect which a pre-existing design patent has upon the question of functionality of objects and shapes. A design patent will be valid only if a product's shape is ornamental and esthetically pleasing. These qualities, of course, are factors that affect the marketability of the product and are therefore functional; the manufacturer's willingness to invest in the procurement and defense of the patent is further evidence of the commercial value of the shape. Thus, two authoritative sources—the patent office and the manufacturer—have proclaimed the esthetically functional nature of the patent item.

Courts could treat these declarations as merely evidencing functionality, or as presumptively establishing it. Treating them as evidence would pose difficulties because they are not cast as evidence, but rather as findings, by entities more closely attuned to the marketplace than most courts. In addition, courts would face the difficult task of balancing the manufacturer's dispassionate decision to seek the patent against his eco-

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180. The Honeywell and Mogen David cases demonstrate that manufacturers will seek both types of protection.
181. See notes 134-45 supra and accompanying text.
182. See text accompanying notes 44-45 supra.
183. In two recent cases, the Court of Customs and Patent Appeals has considered the effect on the functionality issue of expired utility patents. In *In re Shenange Ceramics, Inc.*, 362 F.2d 287 (C.C.P.A. 1966) the court seemingly indicated that the patent would be treated only as evidence of functionality: “The patent is taken only as some evidence, here conclusive, that the invoked under-rim configuration is indeed functional.” *Id.* at 292. In *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195 (C.C.P.A. 1969), however, the court in fact adopted the conclusive evidence rule. The opponent of registration sought summary judgment on the ground that the applicant’s figure-eight-shaped lock core was not registrable. The court noted that summary judgment would be inappropriate if “there is any possibility that there remains a genuine issue of material fact,” and then granted the summary judgment, saying, “it is clear to us that the Best patent incontrovertibly [sic] establishes primary functionality.” *Id.* at 1199.
nomically interested claims that the shape is not functional. For these reasons, the more rational course would be to view a pre-existing design patent as conclusive evidence of the ornamentality and esthetic functionality of the object or shape.

A finding that a design patent is invalid does not necessarily negate this presumption. In most instances a court will hold a patent invalid for reasons that do not refute the esthetic functionality of the shape. Even where the shape is deemed insufficiently ornamental to qualify for a design patent, this finding may not constitute a denial of that configuration's functionality. The manufacturer may only have been trying to protect a mechanically functional feature which was not sufficiently innovative to qualify for a utility patent. In the rare case in which a court holds that a shape lacks sufficient ornamental quality to merit patent protection, that shape may still be a factor in purchase decisions and thus satisfy the functionality doctrine as endorsed here. Furthermore, the patent applicant's judgment that the shape possesses ornamental value would still be relevant. The unlikely possibility that a manufacturer will seek to acquire patent protection for a shape that has no mechanical function or esthetic effect on purchase decisions—thereby losing otherwise available trademark protection—does not justify foregoing the advantages to be achieved by treating the design patent as conclusive evidence of functionality.

The cost of such a conclusive rule would not be high. Courts which correctly apply the suggested test of functionality would find the disputed shapes to be functional in virtually every instance, and the conclusive evidence rule would thus help assure a broad interpretation of the functionality doctrine. The rule would effectively reinstate the quid pro quo theory of patents and would possibly go beyond that theory by denying trademark protection to shapes included in invalid design patents.

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184. See, e.g., Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co., 444 F.2d 295 (9th Cir. 1970) (obviousness); In re Huntington, 279 F.2d 284 (C.C.P.A. 1960) (previous patent on same material); In re Smith, 77 F.2d 514 (C.C.P.A. 1935) (mere imitation of natural forms).


186. There is nothing unreasonable about this. The courts have simply determined that the applicant does not have a protectable interest—no "quid" for society's "quo." No doctrine suggests that ineligibility for one form of protection should assure eligibility for the other.
VI. CONCLUSION

Society receives no benefit from the protection afforded to shapes and objects under the Lanham Act. Consumer responsiveness to source identification can be maintained without such protection, and its elimination would be beneficial to competition. Strict enforcement of the functionality doctrine, including treating a design patent as conclusive evidence of functionality, is the most appealing method of curtailing this superfluous use of the Lanham Act. This method would not require tortured construction of the statute and would substantially reduce the perceived conflict between the patent and trademark systems. It would also effectively discourage the granting of virtual monopoly protection to items not showing patentable originality.