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Unchecked Monopolies: The Questionable Constitutionality of Design  
Patent and Product Design Trade Dress Overlap in Light of Egyptian  
Goddess, Inc. v. Swisa, Inc.

# UNCHECKED MONOPOLIES: THE QUESTIONABLE CONSTITUTIONALITY OF DESIGN PATENT AND PRODUCT DESIGN TRADE DRESS OVERLAP IN LIGHT OF *EGYPTIAN GODDESS, INC. v. SWISA, INC.*

by Ellie B. Atkins

## INTRODUCTION

Last summer, Samsung suffered a large blow in what has now been dubbed by the media as the “Smartphone Wars” when Apple received a \$1.05 billion dollar jury award after suing Samsung for patent and trade dress infringement.<sup>1</sup> The policy underlying intellectual property law reflects a tension between incentivizing invention by protecting creators’ rights and maximizing the public benefit. This balance was clearly at the heart of the now notorious *Apple v. Samsung* case, where following the large jury award for Apple, the parties quickly issued public statements expressing opposing sentiments.<sup>2</sup> Apple characterized the win as a victory for inventors’ rights:

The lawsuits . . . were about much more than patents or money. They were about values. At Apple, we value originality and innovation and pour our lives into making the best products on earth. We make these products to delight our customers, not for our competitors to flagrantly copy. We applaud the court for . . . sending a loud and clear message that stealing isn’t right.<sup>3</sup>

Samsung, however, emphasized the alternative side of the tension, saying, “Today’s verdict should not be viewed as a win for Apple, but as a loss for the American consumer.”<sup>4</sup>

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1. See Agustino Fontevicchia, *Smartphone Wars: Who Wins And Who Loses From The Apple-Samsung Patent Ruling*, FORBES (last visited Mar. 11, 2013), <http://www.forbes.com/sites/afontevicchia/2012/08/27/smartphone-wars-who-wins-and-who-loses-from-the-apple-samsung-patent-ruling/>.

2. Brian X. Chen, *Apple Beats Samsung: First Reactions*, NY TIMES BLOG: BITS (last visited Mar. 11, 2013), <http://bits.blogs.nytimes.com/2012/08/24/samsung-apple-reactions/>.

3. Chen, *supra* note 2.

4. Bryan Bishop, *Samsung: Today’s Verdict ‘a Loss for the American Consumer’*, THE VERGE (last visited Apr. 11, 2013), <http://www.theverge.com/2012/8/24/3266653/samsung-todays-apple->

As intellectual property law continues to evolve, the underlying policy goals endure unchanged. This recent case highlights the economic importance of intellectual property law<sup>5</sup> and serves as an example of a rights holder seeking to maximize his protection by obtaining overlapping rights. In fact, Apple obtained both design patent protection and trade dress protection for the iPhone and iPad, the products at the heart of this dispute.<sup>6</sup> In light of the high financial stakes,<sup>7</sup> it is important that courts remain diligently committed to preserving the balance between benefitting the public and incentivizing innovation. However, in a 2008 decision, the Federal Circuit shifted the balance of intellectual property rights, blending design patent and trade dress in a way this Comment argues is potentially unconstitutional.<sup>8</sup>

Conflating these two intellectual property rights tilts the underlying balance strongly in favor of the inventor or rights holder. Design patents are constitutionally granted for a limited amount of time,<sup>9</sup> whereas trade dress protection exists

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trial-statement-loss-american-consumer.

5. The jury awarded Apple \$1.05 billion for Samsung’s infringement. See Connie Guglielmo, *Apple Wins Over Jury in Samsung Patent Dispute, Awarded \$1.05 Billion in Damages*, FORBES (last visited Mar. 11, 2013), <http://www.forbes.com/sites/connieguglielmo/2012/08/24/jury-has-reached-verdict-in-apple-samsung-patent-suit-court-to-announce-it-shortly/>.

6. Apple obtained registered trade dress for the iPhone design, but also asserted unregistered trade dress protection in this case. See Nilay Patel, *Apple vs. Samsung: inside a jury’s nightmare*, THE VERGE (last visited Apr. 11, 2013), [www.theverge.com/2012/8/23/3260463/apple-samsung-jury-verdict-form-nightmare](http://www.theverge.com/2012/8/23/3260463/apple-samsung-jury-verdict-form-nightmare).

7. Part of the \$1.05 billion award in the *Apple v. Samsung* case was attributable to trade dress infringement and design patent infringement. See Guglielmo, *supra* note 5; see also Debra Cassens Weiss, *Adidas Award of \$305M in Trademark Infringement Case May be Record*, ABA JOURNAL NEWS (last visited Mar. 11, 2013), [http://www.abajournal.com/news/article/adidas\\_award\\_of\\_305m\\_in\\_trademark\\_infringement\\_case\\_may\\_be\\_record/](http://www.abajournal.com/news/article/adidas_award_of_305m_in_trademark_infringement_case_may_be_record/) (\$305 million jury award for trademark infringement).

8. See *Egyptian Goddess, Inc. v. Swisa, Inc.* 543 F.3d 665 (Fed. Cir. 2008) (abridging the previous design patent infringement test and establishing the ordinary observer test as the sole analysis for design patent infringement).

9. See U.S. CONST. art. 1, § 8, cl. 8 (“Congress shall have power to . . . promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”).

potentially indefinitely.<sup>10</sup> Considered an important case for clarifying the design patent infringement test, *Egyptian Goddess, Inc. v. Swisa, Inc.*,<sup>11</sup> also, perhaps inadvertently, tore down a wall separating product design trade dress protection from design patents when it abridged the previous design patent infringement test and adopted a test remarkably similar to the infringement test for trade dress. Courts repeatedly stated prior to *Egyptian Goddess* that parties may pursue trade dress protection for a product design already protected by a design patent because they considered the two protections separate and distinct bodies of law granting independent rights.<sup>12</sup> However, following the *Egyptian Goddess* decision, the rights grew alarmingly close, theoretically allowing for parties to undermine the policy considerations supporting these legal doctrines.<sup>13</sup> The potential for abuse is specifically concerning for product design trade dress, which requires a showing of secondary meaning<sup>14</sup> a burden much lessened by the existence of a design patent granting monopolized use for fourteen years.<sup>15</sup>

This Comment will argue that the rationale

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10. See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 605 (1996) (explaining that trademarks' indefinite protection depends on the strength and duration of the public's recognition of the mark); see also 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:1 (4th ed.) (noting trade dress receives the same protection as trademarks under the Lanham Act).

11. 543 F.3d 665 (Fed. Cir. 2008).

12. See *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985) (citing their separate infringement tests as justification for the allowance of trade dress and design patent overlap); *Application of Mogen David Wine Corp.*, 140 U.S.P.Q. 575, 549 (1964) ("In our opinion, 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.").

13. The potential overlap of design patent and trade dress protection could provide an extended patent monopoly. Justification for the patent law monopoly is that the right is time-limited. However, as the rights begin to merge closer together it is more difficult to condone allowing a design patent holder to obtain indefinite trade dress protection for the same ornamental design subject of a design patent. See *Krueger Int'l, Inc.*, 915 F. Supp. at 604-05 (stating the policy goals of patent law are to encourage invention by providing a limited monopoly whereas the goals of trademark law are to prevent consumer confusion as to the source of the goods).

14. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000) (deciding that product design trade dress requires secondary meaning to establish the distinctiveness necessary for trade dress protection).

15. See *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 903 F. Supp. 1457, 1460-61 (D. Kan. 1995) ("Granting trade dress protection to an item for which a patent has expired creates tension because the product may have obtained secondary meaning or inherent distinctiveness precisely because the product was patented. If so, the trade dress protection does not have an independent basis and effectively extends the monopoly granted by the patent.").

for allowing trade dress protection proceeding from an expired or current design patent is erroneous in light of the *Egyptian Goddess* test for design patent infringement. In focusing on the infringement test, it will assess whether trade dress (particularly for product design) and design patents are actually distinct, independent legal doctrines. This Comment will conclude that courts should hold parties seeking trade dress protection for product design where they already have a design patent to a higher standard, in line with the Supreme Court's goals in *Wal-Mart Stores Inc., v. Samara Brothers, Inc.*<sup>16</sup>

Part I will discuss the history of design patent and trade dress protection. Specifically, it will assess the history of the infringement tests for each intellectual property doctrine and the rationales underlying the infringement tests. Furthermore, it will evaluate case law before and after *Egyptian Goddess* to compare courts' design patent infringement analysis. It will also review case law prior to *Egyptian Goddess* that assessed the coexistence of design patent and trade dress to further examine courts' varying rationales. Part II will assess whether design patents and product design trade dress are really distinct, independent legal doctrines. Assessing the substantial shift caused by *Egyptian Goddess*, the Comment will argue that courts' previous reasoning for allowing design patent and trade dress overlap—that the legal regimes are separate and distinct—is now erroneous because the two protections have been rendered nearly identical over time. By analyzing potential situations in which this may allow for extended protection, this Comment will discuss the potential unconstitutionality of this protective overlap and its opposition to patent and trademark policy. In conclusion, this Comment will recommend a more stringent standard for product design trade dress where the design was previously, or is currently, protected by a design patent to ensure these legal doctrines do, in fact, remain independent and distinct. Specifically, requiring strong proof of distinctiveness for secondary meaning may provide the necessary safeguard from unchecked design monopolies.

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16. See *Samara Bros., Inc.*, 529 U.S. at 212 (recognizing that trade dress for product design, like a color, does not immediately serve a source-defining function in the minds of consumers, and thus, since it is not inherently distinctive, should require secondary meaning to establish distinctiveness before trade dress protection attaches).

## I. BACKGROUND

### A. The History and Basic Principles of Patent Law

Patent law authority is derived from the Constitution.<sup>17</sup> The Constitution provides, in what is commonly referred to as the Intellectual Property Clause, “Congress shall have power to . . . promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”<sup>18</sup> This clause provides the constitutional authority for patent rights, laying out the framework for providing a time-limited monopoly in an effort to incentivize invention.<sup>19</sup> Patents are a negative right in that they require no positive action be taken by a patent holder and provide only for the right to exclude others from using or selling a patented invention.<sup>20</sup> Patent law has three central purposes: first, to encourage and reward invention; second, to disclose inventions; and, third, to protect the public domain by maintaining stringent patentability requirements.<sup>21</sup>

### B. DESIGN PATENTS

There are two types of patents: utility patents for functional inventions and design patents for ornamental designs. Protection for design patents was codified in 1842 to fill a gap that existed between copyright and patent law.<sup>22</sup> There are fundamental differences between utility and design patents, most

notably the functionality requirement and the length of protection.<sup>23</sup> Utility patents last for twenty years beginning on the application filing date, whereas the term for a design patent is only fifteen years.<sup>24</sup> Moreover, functionality is a requirement for the issuance of a utility patent, but it is not a requirement for a design patent.<sup>25</sup>

Previously, design patents were routinely mischaracterized and underutilized.<sup>26</sup> However, throughout the past decade, design patenting has experienced rapid growth.<sup>27</sup> Some of the growth correlates to the creation of the Court of Appeals for the Federal Circuit in 1982, a court established to unify and strengthen the patent system.<sup>28</sup> However, other design patent growth spikes correlate with recent landmark trade dress cases such as *Samara Bros.* and *Traffix*, cases that resulted in more stringent trade dress requirements and thereby made design patents more appealing.<sup>29</sup> Additionally, the recent *Egyptian*

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23. See 35 U.S.C. §§ 171, 173 (2011), amended by Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, 126 Stat. 1527.

24. Compare 35 U.S.C. § 154(a)(2) (2011) (dictating the term length for a utility patent), with 35 U.S.C. § 173 (2011) amended by Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, 126 Stat. 1527 (dictating the term length for a design patent); see also Jeff John Roberts, *From I-pads to Crocs, New Patent Law Protects Design*, BLOOMBERG BUSINESSWEEK (Dec. 28, 2012), [www.businessweek.com/articles/2012-12-28/from-ipads-to-crocs-new-patent-law-protects-design#p1](http://www.businessweek.com/articles/2012-12-28/from-ipads-to-crocs-new-patent-law-protects-design#p1) (discussing the recently-signed Patent Law Treaties Implantation Act of 2012, which changed the design patent term from fourteen years to fifteen years, and speculating that the United States Patent and Trademark Office should expect a dramatic rise in design patent applications as a result of the new law).

25. Compare 35 U.S.C. § 101 (2011), with 35 U.S.C. § 171 (2011); see also Crouch, *supra* note 22 (manuscript at 9) n. 36 (noting that the requirements for a utility patent are that the invention be new, useful, and classifiable into one of four categories, whereas the requirements for a design patent are that it be new, original, ornamental, and a design for an article of manufacture).

26. See Scott D. Locke, *Fifth Avenue and the Patent Lawyer: Strategies for Using Design Patents to Increase the Value of Fashion and Luxury Goods Companies*, 5 J. MARSHALL REV. INTELL. PROP. L. 40, 53 (2005) (acknowledging that some refer to design patents as “soft or minor patents”).

27. See Crouch, *supra* note 22 (manuscript at 16-20) (documenting the dramatic increase in design patents over the course of the last decade); see also Roberts, *supra* note 24 (predicting that design patents will become even more popular as a result of the newly-signed Patent Law Treaties Implantation Act of 2012).

28. See *Id.* (manuscript at 17-18).

29. See *id.* (suggesting that these cases resulted in stricter requirements for trade dress protection because the *Samara Bros., Inc.* holding required that trade dress for product design obtain secondary meaning before protection attaches, and the court in *Traffix* stated that there should be a strong presumption of functionality where a utility patent previously existed, which created a strong hurdle for those seeking trade dress protection on a

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17. See U.S. CONST. art. 1, § 8, cl. 8.

18. *Id.*

19. See *Wilcox & Gibbs Sewing-Mach. Co. v. Gibbens Frame*, 17 F. 623, 624 (S.D.N.Y. 1883) (explaining that patent law provides a benefit to both the inventor and the public because the inventor is given a limited monopoly and the public benefits from the invention’s disclosure).

20. See *Cont’l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 425 (1908) (describing the patent right as the “right to exclude”).

21. *Aranson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979).

22. See Susan Scafidi et al., *Panel II: The Global Contours of IP Protection for Trade Dress, Industrial Design, Applied Art, and Product Configuration*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 783, 787 (2010) (explaining that design patents do not have a functionality component like utility patents because they were created to “fill the gap between copyright and patent protection”), see also Dennis D. Crouch, *A Trademark Justification for Design Patent Rights*, 24 HARV. J.L. & TECH. (2010) (manuscript at 41), available at [http://ssrn.com/abstract\\_id=1656590](http://ssrn.com/abstract_id=1656590) (recounting the Commissioner of Patents’ remarks in support of the Patent Act of 1902 when he testified that the role of design patents would be as a “gap-fill[er]” for the space between utility patents and copyright law).

*Goddess* case may explain some of the latest design patent popularity.<sup>30</sup> Recently decided in 2008, this case simplified the design patent infringement test, lessening the burden for rights holders to prove design patent infringement.<sup>31</sup>

The process of obtaining a design patent can be much faster than that of other intellectual property rights. In comparison to trade dress, obtaining a design patent, a process referred to as “prosecution,” is a much simpler and faster process.<sup>32</sup> Whereas trade dress protection for product design requires secondary meaning before protection attaches, design patents can be issued even before the product is used in commerce or known to the consumer.<sup>33</sup>

Prior to *Egyptian Goddess*, courts used a test for evaluating design patent infringement that consisted of two steps.<sup>34</sup> First, courts employed the ordinary observer test, which assessed whether an ordinary observer would be deceived by the allegedly infringing design into thinking it was the patented object.<sup>35</sup> Second, courts applied the point of novelty test, which required that the allegedly infringing device incorporated the same point of novelty as the patented device.<sup>36</sup> Novelty is a requirement for

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feature previously covered by a utility patent).

30. See Bruce A. Kugler & Craig W. Mueller, *A Fresh Perspective on Design Patents*, 38-Jul COLO. LAW. 71 (2009) (suggesting there will be a surge in design patents after the *Egyptian Goddess* decision).

31. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 668 (Fed. Cir. 2008).

32. See Crouch, *supra* note 22, (manuscript at 18-19) (noting that the design patent issuance rate is more than ninety percent and suggesting that this rate results from the fact that design patents are not closely scrutinized by the patent examiners). Design patents issue much faster than trade dress, particularly trade dress for product design, which requires secondary meaning before any rights attach. Compare *Id.* (manuscript at 20) (calculating that nearly half of the design patents issued in 2009 were under review for less than a year), with *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (establishing product design trade dress requires secondary meaning to establish the distinctiveness necessary for trade dress protection). See also Roberts, *supra* note 24 (quoting a lawyer who stated he believes the prosecution process for design patents is relatively easy and has obtained a design patent in approximately sixty days).

33. See Crouch, *supra* note 22, (manuscript at 23-24) (explaining Apple’s multi-layered protection approach, which included a design patent application filed weeks before its public release date, followed by trademark registration for the same design).

34. See generally *Egyptian Goddess, Inc.*, 543 F.3d 665 (discussing the merits of the second step of design patent infringement, namely, the point of novelty test).

35. See *Egyptian Goddess, Inc.*, 543 F.3d at 670 (explaining the history of the ordinary observer test, which originated from *Gorham Co. v. White*, 81 U.S. 511 (1871)).

36. See *id.* (crediting *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), as the creator of the point

design patentability.<sup>37</sup> A design is considered novel if an ordinary observer would consider the design to be different from prior designs, rather than a mere modification of an existing design, when viewing the design as a whole.<sup>38</sup>

*Egyptian Goddess* eliminated the second step, taking issue with the applicability of the point of novelty test.<sup>39</sup> The court reasoned that the point of novelty test required exaggerated emphasis on small, often inconsequential, differences between the patented and accused products, thereby assigning undue importance to a feature simply because it could be characterized as novel.<sup>40</sup> In this landmark case, *Egyptian Goddess* sued Swisa, Inc. for design patent infringement of its nail buffer.<sup>41</sup> *Egyptian Goddess*’ nail buffer consisted of a rectangular hollow tube with a square cross-section that featured buffer surfaces on three of its four sides.<sup>42</sup> Swisa’s product was a rectangular, hollow tube with a square cross-section, but it had buffer surfaces on all four sides.<sup>43</sup> In finding no infringement and ruling for Swisa, the Federal Circuit said “no reasonable fact-finder could find that EGI met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design.”<sup>44</sup> The Federal Circuit stressed in its decision that an ordinary observer with knowledge of the relevant prior art is well-equipped to determine whether two designs are substantially similar. Thus, the court argued, adopting the Ordinary Observer test as the sole test for infringement better achieves the original goals of the Point of Novelty Test and avoids the Point of Novelty

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of novelty test because it held that proof of similarity under the ordinary observer test was not enough to prove design patent infringement).

37. See 35 U.S.C.A. § 171 (stating a design must be “new” to be patentable).

38. See generally Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169 (2012).

39. *Egyptian Goddess, Inc.*, 543 F.3d at 671-78 (discussing potential problems with the point of novelty test including that it is difficult to apply where there are multiple point of novelty).

40. See *id.* at 677 (taking issue with the point of novelty serving as an excuse for potential design patent infringers).

41. See *id.* at 682-83. However, after establishing the new test, the Court did not remand to the lower court, instead analyzing the case itself. Ultimately, it found the relevant consumer was unlikely to be deceived by the allegedly infringing device. See Perry J. Saidman, *Egyptian Goddess Exposed! But Not in the Buff(er)* . . . , 90 J. PAT. & TRADEMARK OFF. SOC’Y 859, 880-87 (2008) (arguing the Federal Circuit misapplied the test to the facts of this case).

42. See *Egyptian Goddess*, 543 F.3d at 668.

43. See *id.*

44. *Id.* at 682.

Test pitfalls.<sup>45</sup>

### C. History and Basic Principles of Trademark Law

Unlike patent and copyright law, trademark law does not derive its authority from the Intellectual Property clause of the Constitution.<sup>46</sup> Instead, trademark law is grounded in the Lanham Act,<sup>47</sup> which draws its constitutional authority from the Commerce Clause.<sup>48</sup> The primary goal of trademark law is to prevent consumer confusion as to the source of goods and to protect companies' good will.<sup>49</sup> This doctrine of law strives to ensure that companies are able to properly distinguish their goods from others so that consumers may easily ascertain the source of goods they see in commerce.<sup>50</sup>

A trademark must be distinctive to receive Lanham Act protection, and distinctiveness may be acquired either inherently or through secondary meaning.<sup>51</sup> Distinctiveness is assessed on a sliding scale ranging from generic terms to arbitrary or fanciful words.<sup>52</sup> Generic marks are not granted any protection, whereas an arbitrary or fanciful mark receives automatic protection upon its use in commerce.<sup>53</sup> Between these two ends of the spectrum are descriptive terms and suggestive terms.<sup>54</sup> Suggestive terms, like arbitrary or fanciful terms, are considered to be

inherently distinctive and thus trademark protection is granted automatically upon the product's use in commerce.<sup>55</sup> However, merely descriptive terms require an additional showing of secondary meaning (or five years use in commerce) before trademark protection attaches.<sup>56</sup> Secondary meaning requires that, in the minds of the public, the primary significance of the mark is to identify the source of the product rather than the product itself.<sup>57</sup> This does not necessarily mean that the consumer must know which specific source the goods come from, only that the consumer must know it comes from a single, albeit often unknown, source.<sup>58</sup> In analyzing secondary meaning, courts look to a non-exhaustive list of factors, none of which are alone determinative, including advertising costs, consumer studies, media coverage, amount of sales, and length and exclusivity of the trade dress use.<sup>59</sup>

Additionally, trademark law restricts protection to those marks that are not functional.<sup>60</sup> The functionality doctrine forbids a producer to control a useful product feature, which would inhibit legitimate competition, in adherence to the overarching goals of trademark law of protecting the consumer by promoting competition and protecting companies' reputations.<sup>61</sup> A product feature is considered functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article and would put competitors

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45. *See id.* at 677-78 (reasoning that an ordinary observer would be naturally drawn to the differences between the claimed and accused designs that render them distinct from prior art).

46. Trademark Law is derived from the Lanham Act 15 U.S.C. §§ 1051-1141(n).

47. *Id.*

48. U.S. CONST. art. 1, § 8, cl. 3.

49. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992) (describing the purposes of the Lanham Act as preventing deception and protecting against unfair competition).

50. *See id.* (citing 15 U.S.C. § 1127 in discussing eligibility of marks only if they serve source-identifying purposes).

51. *See id.* at 768 (setting forth the "general rule" that trademarks may achieve distinctiveness either inherently or by acquisition); *see also Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (setting forth the four categories of distinctiveness).

52. *See Abercrombie & Fitch Co.*, 537 F.2d at 9 ("Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.").

53. *See id.* (explaining that a mark may become cancelled at any point if it becomes generic, a burden no secondary meaning can overcome because it would put competitors at an unfair disadvantage).

54. *See id.* (clarifying that descriptive words may obtain protection upon a showing of secondary meaning, but that suggestive words do not).

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55. *See id.* (explaining suggestive marks were created to fill the large void between merely descriptive and arbitrary marks).

56. *See id.* at 10 (suggesting that the five year exception was created so as not to deprive the mark owner who has put forth substantial effort and money into creating good will and brand recognition).

57. *See Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163 (1995) (assessing secondary meaning in determining whether a color can achieve trademark protection (citing *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n. 11 (1982))).

58. *See McCARTHY*, *supra* note 10, § 3:1 (stating that the purpose of trademarks is to distinguish the source of one seller's goods from another source's goods).

59. *See Topps Co. v. Gerrit J. Verburg Co.*, 1996 U.S. Dist. LEXIS 8556, at \*15 (S.D.N.Y. 1996) (weighing factors such as Topps' advertising, sales success, and extended exclusive use in the United States to determine that the Ring Pop trade dress has achieved secondary meaning).

60. *See Qualitex Co.*, 514 U.S. at 165 ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.").

61. *See Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 605 (S.D.N.Y. 1996) ("the doctrine serves to promote competition by protecting advances in functional design from being monopolized and encouraging the broadest dissemination of useful design features." (quoting *Warner Bros. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir. 1983) (internal quotation marks omitted)). *See also McCARTHY*, *supra* note 10, § 7:26[3][b].

at a significant, non-reputation related disadvantage.<sup>62</sup>

#### D. Trade Dress

The Lanham Act also protects trade dress, which is either the product packaging of a good or the product design or configuration, so long as it serves a source-identifying function.<sup>63</sup> Trade dress protection can protect the product itself, the design of the product, the package design, or even “features such as size, shape, color or color combinations, texture, [or] graphics.”<sup>64</sup>

The Supreme Court created separate distinctiveness rules for product packaging and product design in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>65</sup> In this trade dress infringement case, Samara Brothers, Inc. sued when Wal-Mart intentionally began selling direct replicas of Samara Brothers baby clothes.<sup>66</sup> Following Supreme Court precedent in *Taco Cabana*,<sup>67</sup> Samara Brothers argued that its marks were inherently distinctive and thus did not require proof of secondary meaning.<sup>68</sup> The Court required proof of secondary meaning for Samara Brothers clothing, while still upholding *Taco Cabana*, by classifying Taco Cabana’s trade dress as product packaging and Samara Brothers’ trade dress as product design.<sup>69</sup> Thus, the *Taco Cabana* decision came to stand for the premise that product packaging is inherently distinctive and does not require proof of secondary meaning, whereas the *Samara Brothers* case asserted that product design is not inherently distinctive, therefore requiring proof of secondary meaning before trade dress protection attaches.<sup>70</sup>

Trade dress infringement is analyzed according to the same consumer confusion test used for trademark

infringement.<sup>71</sup> Each federal circuit employs their own version of a multi-factor test for infringement focused on whether or not the consumer would be confused as to the source of the goods.<sup>72</sup> The federal circuit tests differ slightly, but generally reflect the same eight factors: strength of the mark, proximity of the goods, similarity of the marks, actual confusion, similar marketing channels, consumer sophistication, bad faith of the defendant, and quality of the defendant’s goods.<sup>73</sup>

#### E. A Brief History of the Relevant Case Law

##### 1. Courts’ interpretation of design patent infringement and the focal shift resulting from *Egyptian Goddess*

Prior to *Egyptian Goddess*, courts employed the two-part infringement test.<sup>74</sup> For example, in *Hosley International Trading Corp. v. K Mart Corp.*,<sup>75</sup> plaintiff Hosley International Trading Corporation had a design patent for the ornamental design of a cauldron-shaped votive candleholder, which it claimed was infringed by the defendant. The court found no infringement, citing the second prong of the two-part test, namely that the two designs did not incorporate the same point of novelty.<sup>76</sup> In *Metrokane, Inc. v. Wine Enthusiast*,<sup>77</sup> Metrokane sued for design patent infringement concerning its corkscrew opening device, trademarked and sold under the name “the Rabbit.”<sup>78</sup> The court granted summary judgment for the defendants, finding design patents inappropriate for part of the device and a lack of substantial similarity between the two devices.<sup>79</sup>

After eliminating the second part of the two-part test in *Egyptian Goddess*, courts naturally began to

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62. See *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 850 n.10 (1982).

63. See *Krueger Int’l*, 915 F. Supp. at 601 (setting forth the different interpretations of trade dress as either the total image of the product or particular features).

64. See *id.* (quoting *LeSportsac, Inc. v. KMart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985)).

65. 529 U.S. 205 (2000).

66. See *id.* at 207-08 (discussing Wal-Mart’s actions in sending its designer photographs of plaintiff’s goods and requesting exact replicas to be sold in Wal-Mart stores).

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

68. See *Samara Bros.*, 529 U.S. at 214-15 (dismissing respondent’s contention that *Two Pesos* forbids requiring all product design trade dress to show secondary meaning).

69. See *id.* (finding the décor in the Taco Cabana restaurant qualifies as product packaging rather than product design).

70. Once something has proven distinctiveness, the party seeking trade dress protection must also establish that the mark is non-functional.

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71. See *Taco Cabana, Inc.*, 505 U.S. at 766 (applying the likelihood of confusion test to trade dress infringement).

72. See *e.g.*, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 493 (2d Cir. 1961); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

73. See *AMF Inc.*, 599 F.2d at 341 (explaining the multi-factor test for infringement).

74. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (explaining the previously used two-part test that consisted of the ordinary observer test and the point of novelty test).

75. 237 F. Supp. 2d 907, 911 (N.D. Ill. 2002).

76. See *id.* at 912-13 (denying plaintiff’s motion for summary judgment after finding that defendant’s accused device did not incorporate the same ring and raised pattern on the handle that served as a point of novelty for plaintiff’s device).

77. 185 F. Supp. 2d 321 (S.D.N.Y. 2002).

78. *Id.* at 324.

79. *Id.* at 327-30.



focus on ordinary observer confusion in infringement cases.<sup>80</sup> In *Hutzler Manufacturing Co. v. Bradshaw International Inc.*,<sup>81</sup> Hutzler sought an injunction barring the sale of Bradshaw's products, which Hutzler alleged infringed its design patents for garlic and onion food-preserving storage containers.<sup>82</sup> The court granted Hutzler's preliminary injunction, finding that the two products would appear visually very similar to an ordinary consumer shopping for the product.<sup>83</sup>

## 2. The Supreme Court's Long-Standing Skepticism of Overlapping Rights

The Supreme Court has long viewed overlapping rights, or more specifically rights stemming from a current or expired patent, with skepticism.<sup>84</sup> For example, in *Singer Manufacturing Co. v. June Manufacturing Co.*,<sup>85</sup> the plaintiff, Singer, had many utility patents for its sewing machines, and upon expiration of those patents, competitors entered into the field copying the functional aspects of the machines and calling them Singer sewing machines.<sup>86</sup> Singer sued, claiming trademark rights in the name Singer, and attempted to prevent its competitors from copying the name *and* design of Singer machines.<sup>87</sup> Although the Court ultimately ruled that the competitors were barred from using the name Singer on their goods, it recognized that the competitors were, however, free to copy the design and form of the machine:

It 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. It is upon this condition that the patent is granted. It follows, as

a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent.<sup>88</sup>

Echoing this same sentiment, the Court in a more recent case, *Sears, Roebuck & Co. v. Stiffel Co.*,<sup>89</sup> wrote "when [a] patent expires, the monopoly created by it expires, too, and the right to make the article—including the right to make it in precisely the shape it carried when patented—passes to the public."<sup>90</sup>

In each of these cases, the Court emphasized its concern with maintaining an equal balance between the public domain and the benefit to the designer or inventor. Specifically, the Court addresses its unease with rights holders exploiting or manipulating various protections to circumvent the legal intentions of each, specifically, their limitations.

## 3. Lower Courts' Inconsistent Case Law Concerning Trade Dress and Design Patent Overlap

Despite courts' longstanding reservations about potential protective overlap, many courts do allow simultaneous protection, and it is very common for plaintiffs to obtain multiple forms of intellectual property protection.<sup>91</sup> In 1995, the Southern District of New York addressed the validity of trade dress protection for a product feature already protected by a design patent in *Hubbell Inc. v. Pass & Seymour, Inc.*<sup>92</sup> Hubbell sued defendants Pass & Seymour and Legrand for trade dress infringement concerning Hubbell's electrical products.<sup>93</sup> The defendants, citing Supreme Court precedent, argued that Hubbell's expired design patents for their product precluded trade dress protection.<sup>94</sup> The court rejected this view, reiterating that trade dress and patent law are separate bodies of law, with independent policy justifications, different

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80. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 671 (Fed. Cir. 2008) (eliminating the second part test, and thus shifting the focus to the first prong of the test: confusion amongst ordinary observers).

81. *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, 11 CIV. 7211 PGG, 2012 WL 3031150 at \*1 (S.D.N.Y. July 25, 2012).

82. *Id.*

83. *Id.* at \*13-15.

84. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896).

85. 163 U.S. 169 (1896).

86. *Id.* at 170.

87. *Id.*

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88. *Id.* at 185.

89. 376 U.S. 225 (1964).

90. *Id.* at 230.

91. See Crouch, *supra* note 22 (manuscript at 45) (explaining that it is not uncommon for patent litigation to also include allegations of copyright, trade dress, and unfair competition charges).

92. *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 957-58 (S.D.N.Y. 1995).

93. See *id.* (discussing Hubbell's trade dress for its plugs and connectors).

94. See *id.* at 959 (stressing the unlawful nature of extending the patent monopoly).

sources of authority, and separate infringement tests.<sup>95</sup>

A year later, the same court in *Topps Co. v. Gerrit J. Verburg Co.*<sup>96</sup> went a step further in finding that the existence of an expired design patent “presumptively indicates that the design at issue is not de jure functional.”<sup>97</sup> In this case, Topps Co., creator of the Ring Pop, sued Gerrit J. Verburg Co. for the defendant’s Diamond Pop, alleging trade dress infringement.<sup>98</sup> After finding that the Ring Pop had achieved secondary meaning, the court also addressed the potential functionality of the trade dress, which if found to be functional would bar trade dress protection.<sup>99</sup> Addressing the expired design patent, the court echoed its sentiment from *Hubbell Inc.* in finding no conflict between trademark and patent overlap, but also indicated that the existence of a design patent could prove beneficial to a party seeking trade dress protection in that it served to show non-functionality.<sup>100</sup>

Again in 1996 the Southern District of New York reiterated that “[a] design patent is analytically distinct from a protectable trade dress, and industrial products may qualify for both kinds of protection without violating the policy goals of either patent or trade dress law.”<sup>101</sup> Similar to its decision in *Topps*, the court argued trade dress protection does not extend a design patent monopoly, that when a design patent expires it becomes copyable, just not “in such a way

that customers are deceived about what they are buying.”<sup>102</sup>

Many years prior to these cases the Court of Customs and Patent Appeals<sup>103</sup> (C.C.P.A.) paved the way for the later decisions in finding no issue with trade dress protection and design patent overlap. Twice, in *In re Mogen David Wine Corp.*<sup>104</sup> and *In re Honeywell, Inc.*,<sup>105</sup> the C.C.P.A. overturned the Trademark Trial and Appeal Board (T.T.A.B.) to find that trade dress does not extend a design patent monopoly.<sup>106</sup> Interestingly, despite the C.C.P.A.’s previous decision in *In re Mogen David Wine Corp.*, the T.T.A.B. again denied registration of a trademark where a design patent already existed, reasoning it would undermine patent law policy. Predictably, the C.C.P.A. reversed, citing its earlier decision.

While the previous cases are representative of the majority viewpoint,<sup>107</sup> some courts do reach alternative conclusions.<sup>108</sup> Notably, in *Winning Ways, Inc. v. Holloway Sportswear Inc.*, the district court expressed hesitation about the coexistence of design patent and trade dress protection, saying,

[g]ranting trade dress protection to an item for which a patent has expired creates tension because the product may have obtained secondary meaning or inherent distinctiveness precisely because the product was patented. If so, the trade dress protection does not

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95. See *id.* (comparing the goals of patent law and trademark law and concluding patent law seeks to further invention whereas trademark law seeks to protect the consumer from brand or source confusion); *id.* at 960 (discussing the history of patent and trademark coexistence); *id.* (“The 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.” (quoting *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985)).

96. No. 96 Civ. 7302, 1996 U.S. Dist. LEXIS 18556 (S.D.N.Y. Dec. 13, 1996).

97. See *id.* at \*30.

98. See *id.* at \*1-5 (noting the substantial similarities between the two products such as the sales method, configuration of the product, and product packaging).

99. See *id.* (finding no “particular manufacturing need or requirement” for the configuration of the Ring Pop design, and noting that this design was probably more difficult and costly to manufacture than other available designs).

100. See *id.* at \*29-30 (suggesting that the existence of a design patent helps parties overcome the burden of showing non-functionality in obtaining trade dress protection); see also *E.Z. Bowz, L.L.C. v. Professional Product Research Co.*, 2003 WL 22068573 No. 00 Civ. 8670 (S.D.N.Y. 2003), at \*24 (finding a design patent to be helpful evidence of non-functionality, and thus also helpful in establishing trade dress protection).

101. See *Krueger Int’l Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 604 (S.D.N.Y. 1996) (clearing up “common misconceptions” concerning design patent and trade dress overlap).

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102. See *id.* at 605. (alluding to the trade dress infringement test, which analyzes consumer confusion).

103. This court was the precursor to the court of appeals for the federal circuit. See *History of the United States Court of Appeals for the Federal Circuit*, THE FEDERAL CIRCUIT HISTORICAL SOCIETY, <http://www.federalcircuithistoricalsociety.org/historyofcourt.html> (last visited April. 11, 2013).

104. 328 F.2d 925 (C.C.P.A. 1977).

105. 532 F.2d 180 (C.C.P.A. 1976).

106. *In re Mogen David Wine Corp.*, 328 F.2d at 1266; *In re Honeywell, Inc.*, 532 F.2d at 183.

107. Julia A. Matheson & Stephen L. Peterson, *Combine and Conquer: How the Synthesis of Design Patent and Trade Dress Achieve Maximum Protection for Your Product Design*, FINNEGAN (May 2009), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=74f843be-c63a-40cc-8ae0-007bc50fdd99>.

108. See *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977-78 (2d Cir. 1987) (“Courts must proceed with caution in assessing claims to unregistered trademark protection in the design of products so as not to undermine the objectives of the patent laws . . . . Since trademark protection extends for an unlimited period, expansive trade dress protection for the design of products would prevent some functional products from enriching the public domain.”).

have an independent basis and effectively extends the monopoly granted by the patent.<sup>109</sup>

This minority viewpoint indicates some courts remain suspicious of the potential coexistence of design patent and trade dress, recognizing the overlap's potential to undermine the policy goals of the legal doctrines in tipping the benefits largely in favor rights holder and out of the public's favor.

## II. ANALYSIS

In light of the *Egyptian Goddess* design patent infringement test shift, the potential coexistence of trade dress following the issuance of a design patent undermines the constitutional grant and policy goals of patent law.<sup>110</sup> Prior to *Egyptian Goddess*, courts justifying simultaneous trade dress and design patent protection reasoned that the two were distinct bodies of law, evidenced by their separate policy goals and infringement tests.<sup>111</sup> In light of the fact that trade dress and design patents now adhere to similar infringement tests, the boundaries of these rights are also nearly identical.<sup>112</sup> The potential for overlap is most concerning for product design trade dress, which the Supreme Court ruled in *Samara Brothers* could never be inherently distinctive.<sup>113</sup> As a result, the Court

required that all product design trade dress achieve secondary meaning before trade dress protection attaches.<sup>114</sup> Allowing trade dress protection where a design patent already protects the same feature significantly lessens the burden that the Supreme Court established in *Samara Brothers*.<sup>115</sup> That burden, establishing secondary meaning, will be significantly lessened by the years of monopolized use resulting from the patent.<sup>116</sup>

- A. The *Egyptian Goddess* holding lessens the burden for rights holders in proving infringement and further merges design patents with trade dress.

Prior to *Egyptian Goddess*, design patent infringement was not as common as the two-part test was often a difficult hurdle for patent holders to overcome.<sup>117</sup> Even where a party could show that an

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U.S. 205, 214-15 (2000) (distinguishing product design from product packaging and finding that the former cannot be inherently distinctive).

114. *Id.* at 215.

115. *See id.* at 212-13 (explaining that product design serves more than just a source-designating function and thus secondary meaning should be established as a burden to show that it does in fact serve a source-identifying function before trade dress protection attaches).

116. Secondary meaning is established when in the minds of the relevant consumers, the trademark or trade dress comes to serve a source-identifying function. McCARTHY, *supra* note 10, § 15:1. If potential consumers are prevented from utilizing the same design patented feature(s), the product design will begin to serve as a differentiating function for the brand, thus separating it from the competitors' products. It will then also more easily become a source-identifying feature rather than a descriptive feature for the product because of its unique status as the only product with that design amongst its competitors. For example, if a particularly popular salt and pepper shaker was shaped as a penguin, and the company that sold this product obtained a design patent for the penguin shape, it could use that design patent to prevent any competitor from selling a similar good in a similar penguin shaped design. Thus, consumers will begin to associate the penguin shape with the source of the good (the company that makes it) and not as an indicator that the product is a salt and pepper shaker, which hypothetically may have been the case if competitors were able to copy the design and the penguin shape became an increasingly popular shape for salt and pepper shakers. Additionally, the design patent will give the company fifteen years of production that can serve as evidence of continued sales, which would help establish secondary meaning. *See* McCARTHY, *supra* note 10, § 15:1 (4th ed.) (stating that evidence of secondary meaning may consist of direct evidence, in the form of a customer survey, or circumstantial evidence, in the form of the input of the seller or circumstantial evidence, which can consist of evidence of sales volume, length of time used, and the quantity and quality of advertising and promotion exposing customers to the symbol).

117. *See* Hosley Int'l Trading Corp. v. K Mart Corp., 237 F. Supp. 2d 907, 911 (N.D. Ill. 2002) *dismissed sub nom.* Hosley Int'l Trading Corp. v. Designco, 79 F. App'x 429 (Fed. Cir. 2003) (noting that the case "not surprisingly" turned on whether the two devices

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109. *See* *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 903 F. Supp. 1457, 1460-61 (D. Kan. 1995) (emphasizing adherence to the underlying policy goals of patent law in noting that the public's access is still restricted where trade dress protection attaches to a design that should have fallen into the public domain following the design patent's expiration).

110. This Comment argues that following *Egyptian Goddess*, the infringement tests for design patents and trade dress became nearly identical, thereby conflating the rights and the protections associated with them. As such, a rights holder could potentially obtain both design patent protection and trade dress protection, which would allow him to extend the patent monopoly right in substance, but not in name.

111. *See, e.g., In re Mogen David Wine Corp.*, 328 F.2d 925, 579 (C.C.P.A. 1964) ("In our opinion, 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.").

112. The court in *Egyptian Goddess* abridged the infringement test for design patents, eliminating the point of novelty test and re-focusing infringement on consumer confusion. *See* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 671 (Fed. Cir. 2008). The infringement test for trade dress also hinges on the likelihood of consumer confusion; *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (explaining the multi-factor test for infringement). As such, both legal doctrines protect the rights holder from products that might deceive a consumer in the marketplace.

113. *See* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529

ordinary observer would be deceived by the allegedly infringing product, oftentimes the points of novelty would be different, thus stifling a party's claim for infringement. *Hosley Intern. Trading Corp. v. K Mart Corp.*<sup>118</sup> provides a good example of this exact scenario. This case concerns a design patent for the ornamental design of cauldron-shaped votive candleholders, which plaintiff Hosley International Trading Corporation alleged was infringed by Designco.<sup>119</sup> In defense, Designco argued that its products do not incorporate the same two points of novelty as plaintiff's patent.<sup>120</sup> Agreeing with the defense, the court found that the patentee's points of novelty were not incorporated by the defendant, and thus granted Designco's motion to dismiss despite finding that the defendant's design might deceive an ordinary observer.<sup>121</sup>

Prior to *Egyptian Goddess*, courts focused largely on the actual design patents, rather than the perspective of the typical consumer, to find infringement. In *Metrokane, Inc. v. Wine Enthusiast*,<sup>122</sup> a design patent infringement case concerning a lever-operated corkscrew device for opening wine, the court in finding no infringement reiterated the two-part infringement test, but placed little emphasis on the perspective of the relevant consumer.<sup>123</sup> Even in its assessment of the ordinary observer test—the first part of the infringement test—the court did not address the point of view of the consumer, instead substituting its own interpretation of the design patent drawings to determine the similarity of the goods.<sup>124</sup>

Following the *Egyptian Goddess* decision, courts began to determine infringement according to consumer deception. Although the Ordinary Observer Test was utilized before *Egyptian Goddess*, it received much greater emphasis afterwards when it became the sole measurement for infringement. As such, courts began to place less emphasis on the claims in the design patents and began to focus on consumer deception.

In interpreting the Ordinary Observer test, courts understood the ordinary observer to be a typical purchaser and accordingly found infringement when

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incorporated the same point of novelty).

118. *Id.*

119. *Id.* at 908.

120. *Id.* at 912.

121. *Id.* at 911-12.

122. 185 F. Supp. 2d 321 (S.D.N.Y. 2002).

123. *See id.*

124. *See id.* at 330 (analyzing the independent visual features of the devices one by one and concluding “the overall visual impressions they create are markedly different” without assessing how an ordinary purchaser might construe the similarity of the goods).

a typical consumer might be confused as to the source of the goods during a typical shopping experience.<sup>125</sup> In *Hutzler Mfg. Co. v. Bradshaw Int'l Inc.*,<sup>126</sup> the court assessed design patent infringement by focusing on consumer deception instead of the design patent claims.<sup>127</sup> Despite the fact that the similarities of the ornamental designs are typically assessed by the design patent drawings, the court assessed consumer deception in commerce: “Accordingly, the ‘ordinary observer’ here is someone who has seen, shopped for, or purchased food storage items of similar design.”<sup>128</sup>

- B. A comparison of the design patent and trade dress infringement tests following *Egyptian Goddess* demonstrates how the two doctrines are now the same.

Patentees were pleased with the *Egyptian Goddess* holding because it lessened the burden for proving infringement.<sup>129</sup> While the Federal Circuit's concerns in *Egyptian Goddess*<sup>130</sup> were legitimate, its actions in simply eliminating the second step of the previous infringement test did not account for the potential new problems this shift might create.<sup>131</sup>

The Supreme Court sought to reinstate the

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125. *See e.g.*, *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, 11 CIV. 7211 PGG, 2012 WL 3031150, at \*15 (S.D.N.Y. July 25, 2012); *Minka Lighting, Inc. v. Maxim Lighting Int'l, Inc.*, No. Civ. A. 3:06-CV-995-K, 2009 WL 691594, at \*4 (N.D. Tex. Mar. 16, 2009) (“The ordinary observer is therefore a member of the public who is currently shopping for or has recently purchased lighting fixtures—indeed, a ‘purchaser of things of similar design.’”).

126. 11 CIV. 7211 PGG, 2012 WL 3031150 (S.D.N.Y. July 25, 2012).

127. *Hutzler*, 2012 WL 3031150, at \*13 (S.D.N.Y. July 25, 2012) (“patent infringement can be found for a design that is not identical to the patented design.” (internal quotation marks omitted) (quoting *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 820 (Fed. Cir. 1992))); *see also id.* at \*14 (“The Federal Circuit has made clear that it is error for a trial court to focus on ‘each [design] element separately instead of analyzing the design as a whole from the perspective of an ordinary observer.’” (quoting *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006))).

128. *See Hutzler*, 2012 WL 3031150, at \*7.

129. Marta Kowalczyk, *Design Patent Infringement: Post-Egyptian Goddess*, 2010 U. ILL. J.L. TECH. & POL'Y 239, 253-54 (2010) (arguing that the elimination of the point of novelty test strengthened design patent holders' rights because the burden in infringement cases had been shifted from the plaintiff to the accused infringer).

130. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (articulating concerns with the point of novelty test regarding its potential for abuse by design patent infringers).

131. This Comment suggests that amending the infringement test also significantly altered the metes and bounds of the design patent property rights.

goals articulated in *Gorham Mfg. Co. v. White*,<sup>132</sup> stating that the test for design patent infringement “must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity.”<sup>133</sup> The Court further explained that the test need not be analyzed from the viewpoint of an expert.<sup>134</sup> In light of this goal, the court in *Egyptian Goddess* also looked to see if an ordinary observer would perceive the two designs to be substantially the same such as to deceive the observer into purchasing one over the other. Indeed, this test has been referred to as similar to the trade dress infringement test,<sup>135</sup> and the words of the new test explicitly parallel trade dress infringement concerns.<sup>136</sup>

Both tests focus on a layperson’s opinion. The design patent infringement test focuses on the layperson and not an expert because an expert would be highly unlikely to ever find two objects so similar as to the point of deception. Similarly, trade dress is concerned with an ordinary consumer and not an expert in the field. Moreover, the test seems to be concerned with an ordinary consumer of the goods, another factor likening this infringement test to trademark law.<sup>137</sup> Indeed, after *Egyptian Goddess* it appeared that both trademark infringement and design patent infringement were most concerned with the possibility of the average consumer’s likelihood of deception.

C. Allowing the coexistence of design patent and trade dress protection contradicts the Constitutional grant of authority for intellectual property protections for a limited time.

Not only is the potential overlap resulting in

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132. 81 U.S. 511 (1871).

133. *Id.* at 526-27.

134. *See id.* at 527 (suggesting that an expert’s perspective would never warrant finding infringement because every small change may seem large to someone well-versed in the field).

135. *See* Kugler, *supra* note 30, at 71 (describing the design patent infringement test post *Egyptian Goddess* as “somewhat analogous to a likelihood of confusion test, a concept primarily related to trademark law”).

136. *See* Crouch, *supra* note 22 (manuscript at 30) (“the minute distinction between design patent distinctiveness and trade dress distinctiveness may be that a trademark functions to indicate the source of goods while a design patent focuses on the appearance of the goods themselves. These two . . . are, of course, largely overlapping.” (internal quotation marks omitted)).

137. *See* *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871) (emphasizing that the analysis should focus on the principal purchasers of the goods).

automatic secondary meaning concerning for policy implications, but it is also contrary to the constitutional grant of patent authority.<sup>138</sup> The Intellectual Property Clause of the Constitution explicitly states that a patent will issue only for a “limited time.”<sup>139</sup> Trademark law, which is not bound by the Intellectual Property clause of the Constitution, may potentially function indefinitely if the party consistently renews its right and uses the mark.<sup>140</sup>

If courts continue to allow coexistence of these rights, it may allow for an extended patent monopoly.<sup>141</sup> Recognizing the similarity of these rights, evidenced by their nearly identical infringement tests, allowing trade dress protection following a design patent could indefinitely extend the same rights and protections granted by the previous design patent. This potential extension is contrary to the basic tenants of trademark law<sup>142</sup> and upsets the delicate balance patent law seeks to preserve by depleting the public domain without any added benefit to the public as a result.

Concerned with overprotection, the Supreme Court in *Samara Brothers* ruled that product design must always show secondary meaning before trade dress protection attaches.<sup>143</sup> Allowing the overlap of these rights would undermine the Supreme Court’s expressed goals in *Samara Brothers* by lessening the secondary meaning burden for product design.<sup>144</sup> While secondary meaning does require some affirmative step(s) to be taken by the rights holder (such as advertising or sales), fifteen years of

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138. The Constitution grants authority of a patent for a “limited time.” U.S. CONST. art. 1, § 8, cl. 8.

139. U.S. CONST. art. 1, § 8, cl. 8.

140. *See* The Lanham Act, 15 U.S.C. § 1051 (2002) (drawing its authority from the Commerce Clause of the Constitution, it is not limited by the constitutional mandate that the authority be for a limited time).

141. Because the trade dress and design patent protection are arguably nearly identical following *Egyptian Goddess*, allowing the overlap of protection would essentially create an extended right. This rights overlap is particularly troublesome because together they cancel out each other’s limitations. Trade dress protection for product design requires that secondary meaning be established before the protection attaches, a burden much lessened by the immediate protection a design patent grants. Design patents allow immediate protection, but they are limited because they only last for a short period of time. However, trade dress protection could extend the same right indefinitely.

142. Trademark law is commonly thought of as an extension of unfair competition law.

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

144. *See id.* at 212 (explaining that design is like color in that it cannot be inherently distinctive, and thus requiring product designs to show they have established a source-identifying function in the consumers’ eyes before allowing trade dress protection to attach).

exclusive use granted by a design patent significantly decreases that burden, and the steps necessary to secure secondary meaning become much easier.<sup>145</sup> Moreover, a design patent may issue before a good even is used in commerce and can be obtained much faster than trade dress protection.<sup>146</sup> Thus, assuming, as this comment argues, that the rights are nearly identical, the immediate protection granted by a design patent undermines the benefit to the public and the free competition—the heart of the Supreme Court’s concerns in *Samara Brothers*.<sup>147</sup>

Some courts have justified overlapping protection by citing the differences between the two areas of law.<sup>148</sup> For example, the Southern District of New York repeatedly cited the differences between design patents and trade dress as rationale for allowing overlapping rights. In cases pre-dating *Egyptian Goddess*, such as *Hubbell*, the court cited the differences in the purposes behind each area of law as reason for allowing overlapping protection.<sup>149</sup> However, this rationale would no longer stand in light of *Egyptian Goddess*, because the rationales might remain distinct, but the practical effect of their protection is nearly identical.

In fact, many courts have even cited the existence of a design patent as evidence that the trade dress is not functional, a bar trade dress rights seekers must overcome before protection attaches.<sup>150</sup> Courts

have said that the existence of a design patent helps to establish that a design on a piece of manufacture is not functional and that the existence of a design patent prior to trade dress protection does not upset policy concerns because upon the expiration of a patent, a design may be copied so long as it does not confuse a consumer.<sup>151</sup>

Interestingly, some courts remained skeptical of overlapping rights even before *Egyptian Goddess*.<sup>152</sup> Specifically, in *Winning Ways*, the district court expressed hesitation about the coexistence of design patent and trade dress protection.<sup>153</sup> In particular, the court was concerned that secondary meaning may be achieved only because of the previously issued design patent.<sup>154</sup> Although it remained the minority viewpoint, this case indicates that some courts remained concerned about potential overprotection resulting from overlapping rights.

D. Addressing the alternative argument: what is the proper role for design patents?

Design patents were originally codified to fill a gap between utility patents and copyright law.<sup>155</sup> As a result, some have theorized that the proper role for design patents is to continue to serve as a legal gap filler, protecting areas from which trade dress specifically has reseeded.<sup>156</sup> Dennis Crouch has observed that design patents are well suited to serve a “bootstrapping” role, specifically as a tool to help

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145. See McCARTHY, *supra* note 10, § 15:1 (4th ed. 2003) (describing secondary meaning as fact-dependent and listing forms of evidence: secondary meaning as customer surveys, evidences of sales volume, the length of time the mark has been used, and quality and quantity of advertising).

146. See Crouch, *supra* note 22, at 20 (calculating that nearly half of the design patents issued in 2009 were under review for less than a year).

147. See *Samara Bros*, 529 U.S. at 215 (predicting that consumers would be harmed if product design trade dress was considered always inherently distinctive).

148. See *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 959 (S.D.N.Y. 1995) (comparing the goals of patent law and trademark law and concluding that the two are distinct areas of law because patent seeks to further invention whereas trademark law seeks to protect the consumer from brand or source confusion); *id.* at 960 (“The 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.” (quoting *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985))).

149. See *Hubbell Inc. v. Pass & Seymour, Inc.*, 883 F. Supp. 955, 959 (S.D.N.Y. 1995) (citing the differences between the trade dress and design patent infringement tests as justification for allowing their overlapping protection).

150. See *E-Z Bowz, L.L.C. v. Prof’l Prod. Research Co.*, No. 00 Civ. 8670, 2003 WL 22068573, at \*24 (S.D.N.Y. 2003) (finding a design patent to be helpful evidence of non-functionality, and thus also helpful in establishing trade dress protection).

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151. See *id.*; *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996) (noting that trade dress infringement requires consumer confusion).

152. See Matheson, *supra* note 102, at 2; *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977-78 (2d Cir. 1987) (“Courts must proceed with caution in assessing claims to unregistered trademark protection in the design of products so as not to undermine the objectives of the patent laws . . . . Since trademark protection extends for an unlimited period, expansive trade dress protection for the design of products would prevent some functional products from enriching the public domain.”).

153. See generally *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1462 (D. Kan. 1996).

154. See *id.* at 1460-61; 903 F. Supp. 1457 (“Granting trade dress protection to an item for which a patent has expired creates tension because the product may have obtained secondary meaning or inherent distinctiveness precisely because the product was patented. If so, the trade dress protection does not have an independent basis and effectively extends the monopoly granted by the patent.”); see also *supra* note 106.

155. See Crouch, *supra* note 22, at 41 (discussing the “gap-filling” role of design patents).

156. See generally *id.* (justifying the purpose of design patents as filling the holes that other intellectual property doctrines, specifically trademark and trade dress, have left unprotected).

rights holders secure trade dress protection.<sup>157</sup> He mentions three specific ways the existence of a design patent alleviates the burden of establishing trade dress.<sup>158</sup> First, he notes that design patents may serve as evidence of non-functionality.<sup>159</sup> The functionality doctrine is a strict burden all trade dress rights seekers must overcome.<sup>160</sup> A design patent, while not enough on its own, serves as strong evidence that the design is not functional.<sup>161</sup> Second, the existence of a design patent facilitates the acquisition of secondary meaning.<sup>162</sup> Exclusive use for fifteen years severely lessens the burden of establishing secondary meaning, which requires that consumers view the design primarily as a source indicator and not as the product itself.<sup>163</sup> Finally, Crouch suggests that a design patent can protect a design immediately, filling the period of time that a rights holder would otherwise have to wait unprotected against copy-cat competitors before trade dress protection came to fruition.<sup>164</sup>

Yet, it is precisely these gaps that trade dress and trademark law must leave open to maintain an equal benefit to the consumers and the rights holders. These gaps represent the tradeoffs rights holders give up to the public domain. Allowing design patents to fill all of these gaps tips the balance strongly in favor of rights holders and depletes the public domain.<sup>165</sup> This is injurious to the public and counter to the policy goals of trademark law.<sup>166</sup> Moreover, it is counter to the

Supreme Court's goals as stated in *Samara Brothers*.<sup>167</sup>

E. Trade dress protection where there is a utility patent: the *Traffix* interpretation

Although the Supreme Court has not yet addressed the effect of an expired design patent on the issuance of trade dress protection, it has analyzed the effect of an expired utility patent. In *Traffix Devices, Inc. v. Marketing Displays, Inc.*,<sup>168</sup> defendant Marketing Displays began copying plaintiff's two-spring sign feature, which was created to keep the sign standing despite strong wind.<sup>169</sup> Traffix Devices, Inc. had obtained a utility patent for this feature, and upon the patent's expiration Marketing Displays, Inc. began copying the device.<sup>170</sup> Traffix Devices, Inc. sued for trade dress protection, arguing its product had achieved the necessary secondary meaning.<sup>171</sup> The Court held that the existence of utility patent creates a strong presumption that a design is functional and thus ineligible for trade dress protection.<sup>172</sup> However, the Court was careful to state that the existence of a utility patent is not necessarily determinative of functionality, but a big aspect for a court to consider.<sup>173</sup>

Conversely, many courts have interpreted the existence of a design patent as evidence that the design seeking trade dress protection is not functional.<sup>174</sup>

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157. *Id.* (manuscript at 38-40).

158. *Id.* (discussing what he calls design patent "bootstrapping").

159. *See id.* (manuscript at 38-49) (calling this phenomenon the "anti-*Traffix* doctrine").

160. *See Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995) (describing the functionality doctrine as a necessary feature of trademark law to promote free and open competition).

161. *See Topps Co. v. Gerrit J. Verburg Co.*, No. 96 Civ. 7302, 1996 U.S. Dist. LEXIS 18556, at \*29-30 (S.D.N.Y. Dec. 13, 1996); *E.Z. Bowz, L.L.C. v. Prof'l Prod. Research Co.*, 2003 WL 22068573 No. 00 Civ. 8670 (S.D.N.Y. 2003), at \*24. The requirements for proving functionality, or lack thereof, for a design patent and trademark or trade dress differ, and thus the existence of a design patent does not serve as enough evidence in and of itself to establish nonfunctionality. *See Crouch, Supra* note 22 (manuscript at 39) (discussing *Keystone Mfg. Co. v. Jaccard Corp.*, a case in which the district court allowed trade dress rights to attach to the same design once protected by a design patent and asserting that a design patent "simply serves as another piece of evidence to be used by the jury in determining non-functionality.").

162. *See Crouch, supra* note 22 (manuscript at 40) (explaining that the existence of a design patent does not alone establish secondary meaning, but significantly eases the burden).

163. *Id.*

164. *Id.*

165. The constant goal of intellectual property law is to maintain a balance between incentivizing invention and protecting the public.

166. *See Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp.

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595, 604-05 (S.D.N.Y. 1996) (stating the goals of trademark law are to prevent consumer confusion as to the source of the goods).

167. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (explaining that product design (as compared to product packaging) is more akin to color in that the "consumer predisposition to equate the feature with the source does not exist . . . even the most unusual of product designs-such as a cocktail shaker shaped like a penguin-is intended not to identify the source, but to render the product itself more useful or more appealing"). *But see Crouch, supra* note 22 (manuscript at 6) (suggesting that *Samara Brothers* narrowed trade dress protection precisely because of the availability of design patent protection).

168. *See Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 25-26 (2001).

169. *See id.* (explaining the successful, wind-resistant two-spring device was also a visible feature of the signs).

170. *See id.* (discussing that defendant not only deliberately waited for the utility patent to expire so that he could copy the plaintiff's sign features, but also similarly named his company).

171. *See id.* at 26-27 (reviewing procedural posture whereby the district court found no evidence of secondary meaning and alternatively that the device was functional).

172. *See id.*

173. *See id.* at 30 (describing disproving functionality as a "heavy burden" that can be dispelled by showing the feature is "merely an ornamental, incidental, or arbitrary aspect of the device").

174. *See E.Z. Bowz, L.L.C. v. Prof'l Prod. Research Co.*, 2003 WL 22068573 No. 00 Civ. 8670 (S.D.N.Y. 2003), at \*24 (noting that a design patent is helpful evidence of non-functionality).

However, the existence of a design patent on the same subject matter for which trade dress protection is sought should also trigger courts to examine with great scrutiny whether overlapping rights would be constitutional.

F. Readjusting courts' interpretations of overlapping rights: a recommendation for moving forward

The Supreme Court's decisions in *Egyptian Goddess* and *Samara Brothers* should cause courts to reconsider so easily granting trade dress protection where a design patent currently, or previously, existed.<sup>175</sup> Of course, the existence of a design patent may still be helpful in determining non-functionality, but the burden of showing secondary meaning should remain stringent.

As it stands currently, a design patent provides fifteen years of exclusive use.<sup>176</sup> Moreover, design patent prosecution is a much easier and faster process than the steps necessary for obtaining trade dress protection.<sup>177</sup> As such, a party seeking the strongest protection for a design can obtain a design patent before that design is used in commerce, use the fifteen years (or less) granted by the patent as an aid in establishing secondary meaning, and then when either seeking to register the trade dress or assert unregistered trade dress rights, use the design patent as existence of non-functionality.<sup>178</sup>

The *Egyptian Goddess* infringement test shift lessened the burden on design patent holders for proving infringement.<sup>179</sup> However, it also greatly altered the metes and bounds of the patent property right. As it now stands, according to the current infringement test, a design patent and trade dress protection offer nearly identical protective rights.<sup>180</sup>

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175. See discussion *infra* concerning how a design patent can be used as a useful tool in establishing trade dress protection.

176. 35 U.S.C. § 173.

177. See Crouch, *supra* note 22 (manuscript at 18-21) (discussing the rapidity at which design patents are issued and the available means for speeding up the process).

178. See *id.* (manuscript at 38-40) (discussing what he calls "bootstrapping," or the process whereby a rights owner uses a design patent to fill the holes not protected by trade dress and as a tool in establishing distinctiveness and nonfunctionality).

179. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (abridging the previous design patent infringement test by eliminating the second step and establishing the ordinary observer test as the sole analysis for design patent infringement).

180. See Crouch, *supra* note 22 (manuscript at 3) ("Both regimes focus on the visual appearance of a product or its packaging and both regimes allow the rights-holder to exclude others from uses that lead to customer confusion.").

Allowing design patents to fill the holes left open by trade dress thus only further blurs design patent and trade dress protection.

In line with the Supreme Courts goals in *Samara Brothers*—to enhance the standard required for trade dress protection—courts should not allow parties to use a design patent as an easy road to showing secondary meaning.<sup>181</sup> Certainly the party seeking trade dress protection will still carry the burden of using the good in commerce and marketing the good; however, the burden of achieving secondary meaning will certainly be lessened by fifteen years of exclusive use. Following the Court's rationale in *TraFFix*, this Comment urges courts to view the existence of a current or expired design patent as strong evidence that the design is not distinctive. The Court ruled in *TraFFix* that the existence of a utility patent would trigger a presumption that the trade dress was functional.<sup>182</sup> Similarly, the existence of a design patent should be trigger the presumption that the mark is not distinctive. Of course, for product design trade dress the mark already requires secondary meaning to acquire the distinctiveness necessary for trade dress protection.<sup>183</sup> The existence of a design patent in this situation would therefore trigger a stronger showing of secondary meaning. Courts should view the design patent as a sign that the rights seeker's path to secondary meaning was significantly lessened by the patent monopoly, and thus courts should require that the secondary meaning necessary for distinctiveness be more persuasive than would be necessary otherwise.

## CONCLUSION

The concerns of overlapping rights and extended monopolies have real and tangible effects on the marketplace and competition. The headline grabbing cases such as *Apple v. Samsung* help remind courts and the public of the costs, both financially and to the free marketplace, of loose regulations and casual scrutiny.

The Supreme Court has long regarded overlapping rights with skepticism. This suspicion

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181. The Supreme Court in *Samara Brothers* recognized that product design for trade dress does not inherently serve a source-identifying function. Thus, it requires a showing of acquired distinctiveness (secondary meaning) before trade dress protection can attach. Fifteen years of exclusive use, granted by a design patent, would severely lessen, if not nearly eradicate, the burden the Supreme Court sought to establish in *Samara Brothers*.

182. *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 31 (2001).

183. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000).



is necessary to ensure that the intellectual property rights remained balanced. The underlying policy goals require that the greatest benefit possible be bestowed to both the public and the inventors, to incentivize and to ensure society profits as a result.

This is no different in the case of overlapping trade dress protection and design patents. Although previously courts were able to justify overlapping rights by citing the distinct differences between these two protective rights, they have since merged in a way that allowing overlapping rights without further scrutiny could result in prolonged, unconstitutional monopolistic use. The Court of Appeals for the Federal Circuit in *Egyptian Goddess* altered the infringement test for design patents and in so doing, also altered the defined property rights associated with design patents. As such, the infringement test and the protective rights of design patents are now nearly identical to those of trade dress. Allowing design patents to serve as useful aids in establishing trade dress undermines the stated goals of trade dress protection. The protective gaps left by trade dress protection are not due to congressional or judicial oversight, but are a result of careful consideration and recognition of the delicate balance intellectual property law seeks to maintain. The protective holes are space that is dedicated to the public domain. If design patents are able to fill those gaps, the public domain—and public—suffers as a result.

Consequently, courts must be careful in their consideration of trade dress and design patents for identical subject matter. Moreover, the United States Patent and Trademark Office should also remain diligent when assessing the registration of trade dress for subject matter already protected, or previously protected, by a design patent. The consequences of not doing so may have severe anti-competitive effects. Large companies such as Apple and Nike consistently seek to bolster their intellectual property protective measures, and in allowing this overlap, their competitors are put at a severe disadvantage.

In line with the Court's decisions in *TrafFix* and *Samara Brothers*, the existence of a design patent should trigger a presumption that the trade dress is not distinctive. In the case where the party seeks trade dress protection for product design, which already requires secondary meaning (acquired distinctiveness), the burden on the rights seeking party should be stronger than it would be otherwise to prove that the public views the trade dress as an indication of source.

Bearing in mind this recommendation, courts can continue to evaluate, and allow, some overlapping rights. It is commonplace for one product to be

protected by multiple facets of intellectual property law. However, in light of the recent shift in the protective boundaries of design patents, it is imperative that courts remain diligent in preventing rights holders from extending what the Constitution mandates are "limited rights."<sup>184</sup>

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184. U.S. Const. Art. 1, § 8, cl. 8.