

Spring 2010

## Trade Dress Protection and The Confusion with Design Patents Part Two: Design Patents

Roy Girasa  
*Pace University*, [rgirasa@pace.edu](mailto:rgirasa@pace.edu)

Richard J. Kraus  
*Pace University*, [rkraus@pace.edu](mailto:rkraus@pace.edu)

Follow this and additional works at: <https://digitalcommons.fairfield.edu/nealsb>

---

### Recommended Citation

Girasa, Roy and Kraus, Richard J. (2010) "Trade Dress Protection and The Confusion with Design Patents Part Two: Design Patents," *North East Journal of Legal Studies*: Vol. 19 , Article 1.  
Available at: <https://digitalcommons.fairfield.edu/nealsb/vol19/iss1/1>

This item has been accepted for inclusion in DigitalCommons@Fairfield by an authorized administrator of DigitalCommons@Fairfield. It is brought to you by DigitalCommons@Fairfield with permission from the rights-holder(s) and is protected by copyright and/or related rights. **You are free to use this item in any way that is permitted by the copyright and related rights legislation that applies to your use. For other uses, you need to obtain permission from the rights-holder(s) directly, unless additional rights are indicated by a Creative Commons license in the record and/or on the work itself.** For more information, please contact [digitalcommons@fairfield.edu](mailto:digitalcommons@fairfield.edu).

THE DIMINISHING ROLE OF INTERNATIONAL  
TREATIES AND DECISIONS OF THE INTERNATIONAL  
COURT OF JUSTICE IN THE COURTS OF THE UNITED  
STATES

*J.L. Yvanski Nasuti*.....82

TRADE DRESS PROTECTION AND THE CONFUSION WITH  
DESIGN PATENTS  
PART TWO: DESIGN PATENTS

by

Roy J. Girasa\*  
Richard J. Kraus\*\*

INTRODUCTION

There are two major forms of protection given to ornamental designs of a particular product, namely protection given by In Part One of this article we reviewed the protection given under trademark law which has, as its basis, the prevention of confusion to consumers who seek to purchase a particular product having the unique, non-functional ornamental appearance of a product or packaging. In this Part Two, we will explore the protection granted under patent law which seeks to protect any new, original and ornamental design in a manufactured product. We will make a comparison both between a design patent and the more common form of utility patents as well as between a design patent and trade dress protection. Parenthetically, we will also include a discussion of the possible applicability of copyright law to the unique designs of a product.

---

\*Professor of Law, Lubin School of Business, Pace University, Pleasantville, New York.

\*\*Professor of Law and Chairperson of Department of Legal Studies and Taxation, Lubin School of Business, Pace University, Pleasantville, New York.

## DESIGN PATENT PROTECTION

### *Design Patent*

Patents are protected by the U.S. Patent Act under Title 35 of the U.S. Code. The Act states:

#### §101 Patents patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

#### §171. Patents for design.

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Protection is given to the appearance of an article of manufacture and not to its functionality or utility which are covered by a utility patent.<sup>1</sup> The latter protects a process, a product, an invention, or a composition of matter. A design patent relates only to the visual ornamental characteristics embodied in or applied to a manufactured item. It may constitute the configuration or shape of an article, to the surface ornamentation applied to an article, or to a combination of a configuration and the surface ornamentation. It must be an

inseparable part of the manufactured article; it must have a definite pattern of surface ornamentation.<sup>2</sup> The protection is narrow, limited to what is shown in the drawings in the patent and limited only to the novel ornamental features of the patented design.<sup>3</sup> The U.S. Patent and Trademark Office has classified design patents into 33 categories.<sup>4</sup> It is necessary to apply to the U.S. Patent and Trademark Office which examines and grants protection to any person meeting the statutory and regulatory standards of the Office.<sup>5</sup>

The design need not be obvious to the user but may be located out-of-view. In *Seiko Epson Corp. v. Nu-Kote Int'l, Inc.*,<sup>6</sup> the issue arose concerning the validity of the design and shape of ink cartridges that were not in view after its installation and during its use in the printer. The District Court said that the consumer was not concerned with the design of the cartridge and, thus, was not a valid design patent. The U.S. Court of Appeals reversed the lower Court's decision stating that: "The validity of a design patent does not require that the article be visible throughout its use; it requires only that the design of an article of manufacture and that the design meets the requirements of Title 35 [the Patent Act]." The Court cited a case involving a design patent for a hip prosthesis that was no longer in view after implementation that also was found to be protected.<sup>7</sup> It further noted that the ornamental design need not be esthetically pleasing; although a design is for a useful article, furthermore, its patentability is to be based on the article's design rather than its use.

The following table compares the law governing design patents with the regulation of utility patents.

Table 1. Summary Comparison of Design Patents with Utility Patents<sup>8</sup>

Utility Patents	Design Patents
14-year protection	20-year protection
Must contain only one claim	May have multiple claims
Protects only ornamental features of article	Protects entire invention or process
Must be non-functional	Must be functional
Must be new and non-obvious	Must be new, non-obvious, and useful
Relatively inexpensive and easy to file	Complex and expensive to file
No maintenance fees for life of patent	Maintenance fees to be paid three times during life of patent
No provisional patents permitted	Provisional patents permitted
No pre-issue publication of design patent applications	Pre-issue of utility patent applications
No protection from Patent Cooperation Treaty	Protection from Patent Cooperation Treaty

*The Expiration of Design Patents and the Continuation of Trade Dress Protection:*

Whether an expired design patent may allow the patent holder to claim trade dress protection has yet to be determined by the Supreme Court. But the Court did determine, as described above, that the expiration of a utility patent would most likely preclude the holder from trade dress protection. The reasoning in *TrafFix*, however, may not be applicable to design patents. Unlike a functional utility patent, §171 of the Patent Act gives design patent protection to a “new, original and ornamental design for an article of manufacture.” One author has suggested that if and when the issue is presented to the Supreme Court, the Court would likely hold that “trade

dress law cannot be used to ‘extract’ subject matter that is in the public domain by virtue of an expired patent.”<sup>9</sup>

Two post-*TrafFix* lower court cases are relevant. *Keystone Mfg. Co., Inc. v. Jaccard Corp.*,<sup>10</sup> described District Court cross-motions to construe the defendant’s expired utility patent and the claim by the defendant of trade dress infringement. The defendant claimed that its design patent gave rise to a presumption that the ornamental design on an expired utility patent for a meat tenderizer was non-functional and thus is entitled to trade dress protection. The Court determined that the defendant’s assertion of a presumption of non-functionality was not warranted. The Court noted that other District Court decisions had reasoned that: “[b]ecause a design patent is granted only for non-functional designs, it can serve as evidence that a plaintiff’s trade dress is not functional” and that a design patent presumptively indicates that design is not *de jure* functional.<sup>11</sup> The Court, however, refused to find a presumption of non-functionality. It cited the treatise of J. Thomas McCarthy, *1 McCarthy on Trademarks and Unfair Competition* 7:93 (4<sup>th</sup> ed. 2005). McCarthy stated that “while a design patent is some evidence of non-functionality, alone it is not sufficient without *other evidence*.” The case was to continue in order to gather evidence of the merits of the respective claims.

The Sixth Circuit Court of Appeals upheld a District Court decision in *Fuji Kogyo Co., Ltd. v. Pacific Bay Int’l, Inc.*<sup>12</sup> The plaintiff, Fuji, had appealed from an adverse decision of the District Court which dismissed its action for alleged infringement of its registered and unregistered trademarks. Fuji had previously applied for and been granted certain utility and design patents concerning fishing line guides on a fishing rod. The plaintiff then learned of a competitor’s intent to market similar guides upon the expiration of the utility

patents. Fuji then registered its product designs as trademarks. The trademark claims were based on a portion of the fishing guides consisting of legs forming a “V” design. The District Court determined that the trademark product configurations were functional and thus beyond trademark protection.<sup>13</sup> The Court of Appeals agreed. It noted that: “The ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.”<sup>14</sup> Once the protective period of 20 years for utility patents has expired, “knowledge of the invention inures to the people, who are thus enabled without restriction to practice it and profit by its use.”<sup>15</sup>

The question of whether design patents and trade dress protection are mutually exclusive, then, remains to be determined.<sup>16</sup> It appears at this juncture that a possessor of a design patent may also claim trade dress common law trademark protection under limited circumstances. Earlier precedents emphasized that, upon the expiration of a patent, the subject matter becomes public property.<sup>17</sup> But the Court of Customs and Patent Appeals (now the Court of Appeals for the Federal Circuit) in 1964 decided that trademark rights are independent of patent rights; the expiration of patent protection has no effect on the determination of trademark rights.<sup>18</sup> Later cases appear to confirm the independence of patent from trademark rights. Each claim must be looked at separately to determine whether to permit a claim for protection under either or both forms of intellectual property protection.<sup>19</sup> The ultimate determination will likely come from the Supreme Court. It did deny trade dress protection after the expiration of a utility patent in the *TrafFix* case but the basis of its reasoning was the functionality of the claimed mechanism.<sup>20</sup> A design patent, however, may contain essential elements of a product that are merely ornamental and may be, then, the basis for trade dress protection.

#### AN ADDED PROTECTION: COPYRIGHT COUPLED WITH TRADE DRESS

A *copyright* is the protection given to a person for the expression of an idea, such as a book, poem, musical composition, dance movements and other such creations. Copyright law today has its legal basis in the U.S. Constitution and in statutory enactments.<sup>21</sup> Copyright protection is given to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>22</sup> It is not enough to have a creative thought or concept. It must “fixed” in a tangible medium of expression, such as in a copy that may be seen, reproduced, or communicated in a somewhat permanent form. Works of authorship include but are not limited to: (1) literary works; (2) musical works, including the accompanying words; (3) dramatic works including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.<sup>23</sup> The work to be protected must be *original*, i.e., not a duplication from a prior work. It need not be useful, as patented products or processes often are.

*Knitwaves Inc. v. Lollytog Ltd.*<sup>24</sup> illustrates the interplay of copyright and trademark trade issues. The District Court issued a permanent injunction and other relief against a sweater manufacturer finding a violation of both the Copyright Act, the Lanham Act and the New York statute prohibiting unfair competition. In 1990, the plaintiff, Knitwaves, had introduced its “Ecology Group” collection of sweaters. The company’s “Leaf Sweater” was a multicolored striped sweater with puffy leaf appliqués; its “Squirrel Cardigan” had a squirrel and leaves applied onto its multipaneled front. The defendant

copied the styles in 1992 as part of its competing line of sweaters. The Court of Appeals upheld the finding of a copyright violation but reversed as to the finding of a trade dress violation.

The Court, citing §101 of the Copyright Act,<sup>25</sup> stated that clothes are not copyrightable as useful articles that have an intrinsic utilitarian function rather than merely to portray the appearance of the article to convey information.<sup>26</sup> On the other hand, fabric designs, as that of the art work on the plaintiff's sweaters, are considered to be "writings" and are protected under copyright law.<sup>27</sup> To prove infringement of a valid copyright, the plaintiff is required to prove:

- (1) The defendant has actually copied the plaintiff's work; *and* (2) the copying is illegal because a substantial similarity exists between the defendant's work and the protectable elements of plaintiff's.<sup>28</sup>

The Court denied defendant's contention that its copy was not substantially similar to that of the plaintiff's sweaters. The test of "substantial similarity" is the "ordinary observer test" which means whether "an average observer would recognize the alleged copy as having been appropriated from the copyrighted work."<sup>29</sup> The Court agreed with the District Court that there was overwhelming similarity of the sweaters "total concept and feel" with that of the plaintiff, even though there were some differences.<sup>30</sup>

On the other hand, the Court reversed the District Court's decision of a finding of a trade dress violation; under the functionality doctrine the alleged violation would be defeated. The doctrine applies even to features of a product that are purely ornamental.<sup>31</sup> The primary purpose of the

Knitwaves' sweaters was not source identification but rather was aesthetic. The sweaters did not meet the first requirement of an action under §43(a) of the Lanham Act because they were not used as a mark to identify or distinguish the source of the articles. To prevail in the case, the plaintiff would have to prove that its dress is distinctive of the source and that there is a likelihood that consumers would be confused as to the source of the product as being either that of the plaintiff or that of the defendant.<sup>32</sup> "To establish that trade dress is distinctive of a particular source, a plaintiff must demonstrate that it is 'inherently distinctive' or that it has become distinctive through acquiring 'secondary meaning' to the consuming public."<sup>33</sup> The test for trade dress was whether the product's ornamental features served as a designator of the origin of the product, that is, whether a buyer of the sweater would immediately differentiate it from those of competitors. Because the primary objective of Knitwaves was aesthetic rather than source identification, the Court refused to find a violation of trade dress.<sup>34</sup>

The Court of Appeals in *Brighton Collectibles, Inc. v. Renaissance Group Int'l*<sup>35</sup> upheld the District Court's decision enjoining the defendant, Renaissance, from distributing purses that were manufactured with dangling hearts similar to watches manufactured by the plaintiff. The Court determined that there were several major similarities between Renaissance's heart and the heart copyrighted by the plaintiff. A likelihood of confusion existed among customers purchasing the defendant's purses because the customers were familiar with the size, shape, and color of the plaintiff's decorative watch design. The defendant could manufacture and use an ornamental dangling heart provided it was not confusingly similar to the dangling heart made by the plaintiff. The Court also based its decision upon trade dress protection

violations, noting that the “total image” of the dangling heart of both parties was similar.<sup>36</sup>

In *Blue Nile, Inc. v. Odimo Inc.*,<sup>37</sup> the District Court noted that the plaintiff owned and operated a fine jewelry retail business, making sales through its three websites. Defendants operated similar businesses and also sold products through their respective websites. The plaintiff claimed that the defendants copied elements of the plaintiff’s websites protected by the Copyright Act, and that the defendants copied the “look and feel” of plaintiff’s diamond search webpage. The Court analyzed the claim for trade dress infringement. It denied defendants’ request for dismissal of the claim on the basis of the alleged preemption of §301 of the Copyright Act over claims arising under state common law or statutes.<sup>38</sup> The Court stated that §301 does not limit rights or remedies under other federal statutes although courts have limited the application of the Lanham Act when copyright interests are at issue.<sup>39</sup> The claim of “look and feel” under trade dress common law trademark, furthermore, although novel, survives the motion to dismiss because it is a theory outside the Copyright Act.<sup>40</sup> The difference is whether the claim of “look and feel” arises out of the expression of an idea that is the province of copyright or is the idea itself, which is outside the purview of copyright. In addition, there appeared to be support for trade dress “look and feel” claims in a number of law review articles and several unpublished District Court cases. The solution must be left to proof elicited at the trial of the action.<sup>41</sup>

The Court of Appeals denied copyright protection to a RIBBON RACK, a bicycle holding rack made of bent tubes in *Brandir Int’l, Inc. v. Cascade Pacific Lumber Co.*<sup>42</sup> The plaintiff Brandir claimed that the wire sculpture which inspired the RIBBON RACK was initially displayed in the artist’s home as a means of personal expression, but was never sold; that

allegedly the creation of the wire sculpture in the shape of a bicycle was never thought to be utilitarian in nature.

The Court cited in part the legislative history of the Copyright Act. The House Committee’s intention was not to grant copyright protection to the shape of an industrial product that may be aesthetically pleasing and valuable unless it was separable from the utilitarian aspects of the article.<sup>43</sup> It adopted the test offered by Professor Robert Denicola<sup>44</sup> who stated that “the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear.”<sup>45</sup> The Court concluded that “if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”<sup>46</sup> Accordingly, although the bicycle RIBBON Rack had aesthetic aspects, nevertheless, there were no artistic elements that were separable and independent from the utilitarian aspects of the product.<sup>47</sup> The Court remanded the case to the District Court, however, for a plenary consideration as to with respect to whether trade dress protections offered by the Lanham Act may have been violated by the defendant.<sup>48</sup>

#### POSITIVE AND NEGATIVE ASPECTS OF TRADE DRESS AND DESIGN PATENT PROTECTIONS

Commentators<sup>49</sup> have noted that design patents are weak patents and should be used sparingly. These patents protect only the ornamental exterior design of an object and not the idea or the invention itself. Both modes of protection nevertheless may well constitute part of an arsenal of weapons

to be used to prosecute claims against alleged infringers. Claims under these two modes of protection, joined with state claims of unfair competition, may offer significant protections for the owner of the claimed rights. Protection of a product's design may be critical to a company. The design serves as an important marketing tool for the product's sale and distribution; just prior to the introduction of Apple Computer's iPod, for example, Apple filed for a protective design patent.<sup>50</sup>

The following table compares the law governing trade dress protection with the regulation of design patents. It will assist the determination of methods needed to protect the owner of claimed rights.

Table 2: Summary Comparison of Trade Dress with Design Patent<sup>51</sup>

Design Patent	Trade Dress
Non-functional item	Non-functional but may be functional if ornamental or surface decoration dominates
Indefinite renewal of trademark	14-year protection
Normally requires secondary meaning (source identification) and avoid confusion	Must be new and non-obvious; need not be useful or have secondary meaning
Common law trademark	Requires examination and issuance by U.S. Patent and Trademark Office
May concern multiple claims	Must include only a single claim
Protected without governmental filing	Costly process of filing though much less than an

	utility patent
Takes place when connection to a company is demonstrated	Has demonstrable property right as a patent grant
Must be proven in court	Presumption of validity at a trial
Relief generally of injunction and must prove damages	Compensatory and statutory damages for infringement including infringer's profits
Protection against reproduction of similar article and protect reputation and source of the product	Seeks to protect a specific design
Requires distinctiveness in the marketplace	Owner may receive rights prior to a sale

#### EXTRATERRITORIAL EFFECTS OF AN INJUNCTION WHICH SEEKS TO PROTECT THE RIGHTS OF AN OWNER

A court will almost always grant an injunction barring a defendant from abusing an alleged trademark or patent right upon a finding that a plaintiff is likely to succeed in its claim of a violation of such an intellectual property right. A difficulty may arise concerning the injunction's extraterritorial effect. This issue appeared in *Fun-Mental Too, Ltd. v. Gemmy Industries Corp.*<sup>52</sup> The defendant Gemmy had manufactured the allegedly infringing toys through its Chinese factory. The company now claimed that the injunction issued against it by the District Court was an improper extension of the Lanham Act to a foreign jurisdiction. The Court in determining the issue cited *Steele v. Bulova Watch Co.*<sup>53</sup> This Supreme Court decision set forth a three-fold test for analyzing the extraterritorial reach of the Lanham Act. The test requires a



court to address the following questions: (1) does the defendant's conduct have a substantial effect on United States commerce; (2) is the defendant a United States citizen; and (3) is there an absence of conflict with trademark rights established under federal law? The Court answered all three questions in the affirmative and asserted the extraterritorial effect of the injunction. The Court further stated that federal courts have previously granted injunctions for violations of the Lanham Act but have also declined to do so on other occasions if the three questions could not be answered affirmatively.<sup>54</sup>

## CONCLUSION

A manufacturer with a new design for a product has a variety of legal measures that may offer assistance in protecting the uniqueness of its creation. The menu of choices, however, contains a certain degree of confusion. The choices of federal protection include that of asserting trade dress and design patent protections. But the *Wal-Mart* decision differentiated product design and product package trade dress. The choice will have to be whether to rely on the much longer but less certain protection of trade dress trademark protection or seek a 14-year monopoly by a design patent filing. We must await the further determinations of the Supreme Court concerning the relevant issues such as the use of trade dress protection after the expiration of a design patent and other relevant issues. It is imperative to seek counsel who is familiar with the latest developments in this fluid area of the law.

---

## ENDNOTES

<sup>1</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

<sup>2</sup> [www.uspto.gov/web/offices/pac/design/toc.html](http://www.uspto.gov/web/offices/pac/design/toc.html).

<sup>3</sup> *Keystone Mfg. Co. v. Jaccard Corp.*, No. 03-CV-638S, 2007 U.S. Dist. LEXIS 13094 (W.D.N.Y., Feb. 26, 2007) citing *In re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988) and *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

<sup>4</sup> The classification follows:

- D01- Edible products
- D02- apparel and haberdashery
- D03- Travel goods and personal belongings
- D04- Brushware
- D05- Textile or paper yard goods; sheet material
- D06- Furnishings
- D07- Equipment for preparing or serving food or drink not otherwise specified
- D08- Tools and hardware
- D09- Packages and containers for goods
- D10- Measuring, testing, or signaling instruments
- D11- Jewelry, symbolic insignia, and ornaments
- D12- Transportation
- D13- Equipment for production, distribution, or transformation of energy
- D14- Recording, communication, or information retrieval equipment
- D15- Machines not elsewhere specified
- D16- Photography and optical equipment
- D17 Musical instruments
- D18- Printing and office machinery
- D19- Office supplies; artists' and teachers' materials
- D20- Sales and advertising equipment
- D21- Games, toys, and sports goods
- D22- Arms, pyrotechnics, hunting and fishing equipment
- D23- Environmental heating and cooling; fluid handling and sanitary equipment
- D24- Medical and laboratory equipment
- D25- Building units and construction elements
- D26- Lighting
- D27- Tobacco and smokers' supplies
- D28- Cosmetic products and toiletries articles
- D29- Equipment for safety, protection, and rescue
- D30- Animal husbandry
- D32- Washing, cleaning, or drying machine
- D34- Material or article handling equipment
- D99- Miscellaneous

See [www.freepatentsonline.com/design-patents.html](http://www.freepatentsonline.com/design-patents.html).

<sup>5</sup> The applicable statutory references are: 35 U.S.C. §§171-173, 102-103, 112, 132 and the regulatory references are 37 CFR §§1.84, 1.152, and 1.121.

<sup>6</sup> 190 F.3d 1360 (Fed. Cir. 1999).

<sup>7</sup> *In re Webb*, 916 F.2d 1553 (Fed. Cir. 1990).

<sup>8</sup> 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 (Fall, 2005).

<sup>9</sup> *Saidman*, *supra* note 96, at 205 citing an earlier article containing the same conclusion: Perry J. Saidman, *Kan Traffix Kops Katch the Karavan Kopy Kats? – or- Beyond Functionality: Design Patents are the Key to Unlocking the Trade Dress/Patent Comundrum*, 82 Journal of the Patent and Trademark Office Society (JPTOS) 839 (Dec., 2000).

<sup>10</sup> 2007 U.S. Dist. LEXIS 13094 (No. 03-CV-648S (W.D.N.Y., Feb. 26, 2007).

<sup>11</sup> *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 605 (S.D.N.Y. 1996) and *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342 n. 3 (C.C.P.A. 1982).

<sup>12</sup> No. 05-5854 (Aug. 23, 2006, 6<sup>th</sup> Cir. 2006).

<sup>13</sup> *Fuji Kogyo Co. v. Pac. Bay Int'l*, No. 02-42 (M.D. Tenn.) at 61.

<sup>14</sup> *Id.*, citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1969).

<sup>15</sup> *Id.*

<sup>16</sup> For a discussion, see Tracy-Gene G. Durkin and Julie D. Shirk, *Design Patents and Trade Dress Protection: Are They Mutually Exclusive?*, 87 J. Pat. & Trademark Off. Soc'y 770 (Oct. 2005).

<sup>17</sup> *Wilcox & Gibbs Sewing-Machine Co. v. Gibbens Frame*, 17 F. 623,625, *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896), and *Kellogg Co. V. National Biscuit Co.*, 305 U.S. 111, 119-20 (1938). See Tracy-Gene G. Durkin *Id.*

<sup>18</sup> *In re Mogen David Wine Corp.*, 328 F.2d 925, 926 wherein the Court held that the cessation of a design patent did not preclude a request for trademark registration of the applicant's unique configuration of its wine decanter wine bottles.

<sup>19</sup> See *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996), *Topps Co., Inc. v. Gerrit J. Verburg Co.*, No. 96 Civ. 7302, 1996 U.S. Dist. LEXIS 18556 (S.D.N.Y. Dec. 12, 1996). See Tracy-Gene G. Durkin, *Id.*

<sup>20</sup> *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29-30 (2001).

<sup>21</sup> Article 1, Section 8 of the Constitution provides: "The Congress shall have the power...To promote the Progress of Science and the useful Arts, by securing for limited Times to authors and Inventors the exclusive Right to their respective Writings and Discoveries."

<sup>22</sup> 17 U.S.C. Section 102(a).

<sup>23</sup> *Id.*

<sup>24</sup> 71 F.3d 996 (2d Cir. 1995).

<sup>25</sup> 17 U.S.C. §101.

<sup>26</sup> Citing *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989).

<sup>27</sup> *Knitwaves Inc.* at 1002 citing *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 763 (2d Cir. 1991).

<sup>28</sup> *Id.* at 1002 citing *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 122-23 (2d Cir. 1994).

<sup>29</sup> *Id.* citing *Folio Impressions*, 937 F.2d at 766.

<sup>30</sup> *Id.* at 1004.

<sup>31</sup> Citing *Restatement (Third), §17 cmt. c.* which states that "A design is functional because of its aesthetic value only if it confers a significant benefit that cannot be practically be duplicated by the use of alternative designs."

<sup>32</sup> *Knitwaves, Inc.* at 1006 citing *Jeffrey Milstein, Inc. v. Gregor, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1995).

<sup>33</sup> *Id.* citing *Villeroy & Boch Keramische Werke K.G. v. THC Systems, Inc.*, 999 F.2d 619, 620.

<sup>34</sup> *Id.* at 1009.

<sup>35</sup> No. 06-56008, 2007 U.S. App. LEXIS 15026 (9<sup>th</sup> Cir., June 20, 2007).

<sup>36</sup> Citing *Sports Form, Inc. v. United Press Int'l Inc.*, 686 F.2d 750,762 (9<sup>th</sup> Cir. 1982).

<sup>37</sup> 478 F. Supp.2d 1240 (W.D. Wa. 2007).

<sup>38</sup> §301(a) of the Copyright Act states: "Preemption with respect to other laws. (a) On or after January 1, 1978, all legal and equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright...are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

<sup>39</sup> *Blue Nile, Inc. v. Odimo Inc.*, 468 F. Supp. 2d 1240, 1243 (W.D. Wa. 2007), citing 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, §1.01. The Supreme Court warned against misuse or extension of the Lanham Act in areas traditionally occupied by patent or copyright

---

laws, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003). For a discussion of preemption under the Copyright Act, see Elizabeth Helmer, *The Ever-Expanding Complete Preemption doctrine and The Copyright Act: Is This What Congress Really Intended?*, 7 North Carolina J. of Law and Tech., Issue 1 (Fall, 2005).

<sup>40</sup> *Id.* at 1244.

<sup>41</sup> At 1245-1246. The Court noted that a similar issue arose in *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.* 886 F.2d 1173 (9<sup>th</sup> Cir. 1989).

<sup>42</sup> 834 F.2d 1142 (2d Cir. 1987).

<sup>43</sup> *Id.* at 1143 citing H.R. Rep. No. 1476, at 55.

<sup>44</sup> Robert Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 709-17 (1983).

<sup>45</sup> *Brandir* at 1145 citing Denicola *id.* at 742. Denicola further noted that the statutory limitation of copyrightability as “an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist” that are not the product of industrial design.

<sup>46</sup> *Id.* at 1145.

<sup>47</sup> *Id.* at 1147-1148.

<sup>48</sup> *Id.* at 1148. The Court noted that §43(a) of the Lanham Act may offer protection to the plaintiff inasmuch as “the design of a product may function as its packaging or protectable trade dress.” The question to be determined by the trial court was whether the design feature was “essential to the use of purpose of the article” or “affects the cost or quality of the article.” Trade dress may offer protection if the article has acquired a secondary meaning.

<sup>49</sup> See, for example, Eugene R. Quinn, Jr., *Design Patents*, [www.ipwatchdog.com/design\\_patents.html](http://www.ipwatchdog.com/design_patents.html).

<sup>50</sup> See Robert D. Gunderman and John M. Hammond, “*All That Glitters*,” [http://www.ipfrontline.com/depts\\_article.asp?id=14177&depid=2](http://www.ipfrontline.com/depts_article.asp?id=14177&depid=2).

<sup>51</sup> For a detailed comparison, see Moshe H. Bonder, *Patent & Lanham Acts: Serving Two Legitimate Purposes or Providing an Indefinite Monopoly?*, 15 Alb. L.J. Sci. & Tech. 1.

<sup>52</sup> 111 F.3d 993, 1006 (2d Cir. 1997).

<sup>53</sup> 344 U.S. 280, 286 (1952).

<sup>54</sup> *Fun-Mental* at 1006. In *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 642-43 (2d Cir. 1956), the Court of Appeals refused to extend Lanham Act jurisdiction with respect to issuance of an injunction against a Canadian retailer using a Canadian trademark to sell products within Canada.

## TELLING YOUR PARENTS YOU’RE DRINKING TOO MUCH—FERPA’S PARENTAL NOTIFICATION EXCEPTION

by

Gwen Seaquist\*  
Marlene Barken\*\*

### BACKGROUND

It is perhaps a parent’s worst nightmare: their child is away at a college or university, presumably completing courses and participating in a social life when the telephone rings. University officials inform the parents that their child is dead from a drug overdose or binge drinking. The parents were completely unaware of any problem with their child, or thought that any problems were under control. The University, on the other hand, has been aware of a problem with the student, but has not informed the parents until it is too late. Or, perhaps the parents did contact the school and were refused information about their son or daughter.

---

\*Gwen Seaquist, \*Professor of Legal Studies, Ithaca College, NY.

\*\*Marlene Barken, Associate Professor of Legal Studies, Ithaca College, NY.

The authors wish to express their appreciation to John O’Hara, a senior at Ithaca College, for his assistance in the research of this paper.