

## CONCURRENCE AND CONVERGENCE OF RIGHTS: THE CONCERNS OF THE U.S. SUPREME COURT

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“Convergence” is becoming a buzzword in scholarly discussion of intellectual property law.<sup>1</sup> But several different developments in contemporary intellectual property law might be subsumed under that label. In the first part of this paper, I suggest a series of ways in which the term “convergence” could be understood. As we will see, different articulations of the phenomenon of convergence, though distinct, are inevitably related. This paper, however, confines itself primarily to one aspect of the concurrence and convergence of rights, namely, the potential regulation of the same conduct by a defendant under two or more intellectual property regimes.

In that regard, the second part of the paper turns to two recent decisions in which the United States Supreme Court has addressed the extent to which a plaintiff may restrain under trademark and unfair competition law conduct that would not be within the (temporal) scope of patents or copyrights that the plaintiff owned.<sup>2</sup> Some scholars might seek to draw from those decisions a general convergence principle that defines the ability of plaintiffs to attack conduct as infringement under two or more regimes. And the fact that the Court denied relief in both cases might make the identification of a coherent and organizing principle an enticing task. But a closer analysis of the Court’s two opinions reveals that the Court has adopted a more incremental approach to this longstanding problem. Over time, the circumstances in which converging rights under different regimes might be applied to the same conduct may become apparent, but one should not read the Court’s most recent opinions as anything other than a halting step toward regulating opportunistic use of alternative intellectual property rights.

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<sup>1</sup>See, e.g., Willem Grosheide, *Concurrence of Trademark and Copyright Standards: Some Thoughts - Developments in Dutch Law with Reference to American Law* (Fordham Conference on Intern. Intell. Prop. Law & Policy 1999); F. Willem Grosheide, *Crossing Borders: Convergence in the Field of IPR's*, (Fordham Conference on Intern. Intell. Prop. Law & Policy 2001); Shira Perlmutter, *Convergence and the Future of Copyright*, Paper Presented at ALAI Study Days, Stockholm 2000.

<sup>2</sup>See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

## I. Convergence Type A: Overlap in Subject Matter

“Convergence” may refer to a number of different aspects of contemporary intellectual property law. Thus, the term may refer to the increasing overlap in the subject matter of the different intellectual property regimes. The trend is clear in all of the principal forms of intellectual property. The first U.S. copyright statute offered protection to “map, charts, and books.” The present statute defines protectable subject matter in far more all-encompassing (and more conceptual) terms: copyright subsists in “original works of authorship.”<sup>3</sup> (An examination of the illustrative list of types of works protected only confirms the breadth of the subject matter of modern copyright law.) Likewise, trademark law was originally a tool for the protection of source-identifying words and visual symbols. Yet, in 1995 the United States Supreme Court held that anything that is capable of “carrying meaning” may potentially be trademark subject matter.<sup>4</sup> As a result, trademark and unfair competition law protects the design of three-dimensional articles, color per se, sounds, and even smells, provided that they satisfy the general prerequisites for trademark protection (principally, distinctiveness and use in commerce). Finally, patentable subject matter has become relatively boundless. According to the Supreme Court, “anything under the sun that is made by man” is potentially patentable,<sup>5</sup> and traditional limits (such as the prohibition on the patenting of business methods) have gradually been eroded, at least in some countries.<sup>6</sup>

These three occasionally abutting forms of traditional protection – one protecting art and literature, one offering rights in mechanical inventions, and the other protecting words and logos that served as brands – have thus over time come to protect, in many cases, very similar subject matter. In theory the protection under each regime is offered to different intangible creations fixed in the same tangible vessel. Copyright protects the work, patent the invention, and trademark the goodwill, embodied in the physical object. But viewed more functionally in terms of the types of information products that are regulated by the alternative rights, it is clear that subject matter that was traditionally the focus of one regime is increasingly the object of protection under other regimes.

Moreover, the troublesome issues raised by the convergence of the three principal intellectual property systems have been magnified by the proliferation of *sui generis* regimes protecting discrete slices of innovative activity, typically at the margins of traditional protection.

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<sup>3</sup>See 17 U.S.C. § 102(a).

<sup>4</sup>See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

<sup>5</sup>See *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (quoting S.Rep. No.1979, 82d Cong., 2d Sess., 5 (1952); H.R.Rep. No.1923, 82d Cong., 2d Sess., 6 (1952)).

<sup>6</sup>See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998).

Thus, for example, in recent years the EU has created the *sui generis* database right<sup>7</sup> (which protects compilations that might be covered by copyright) and the unregistered design right (which affords rights in subject matter that might be the subject of protection under copyright, trademark, patent, utility model, unfair competition, and registered design laws).<sup>8</sup> Plants that may be protected under general patent laws might alternatively be protected under plant-specific variations.<sup>9</sup>

## II. Convergence Type B: The Nature of Rights

The title of this panel specifically refers to a concurrence and convergence of *rights*, which I take in the context of intellectual property law to mean the exclusive ability to deal in particular ways with the work, invention, or mark. Or, to view that proposition negatively (as rightholders are often wont to do), analysis of whether there has been a convergence in rights might be understood as inquiring whether there has been an approximation of the types of competitor or user conduct that can be restrained by the assertion of rights.

Here, too, there has been a convergence among the different regimes. Most notably, although patent law has long conferred something approaching a strong property right, the same could not be said of copyright or trademark law. Because copyright protection attached easily to a broad range of works, and because socially beneficial third party treatment of a work nominally implicated the *prima facie* exclusive rights of the copyright owner (e.g., to copy the work), copyright law contained a range of exceptions that made the property right relatively porous. Trademark law classically afforded an even more limited form of protection. Even if the right-holder could demonstrate that its mark was distinctive and thus warranted protection, that protection extended only so far as to prevent unauthorized third party uses that would likely cause confusion among consumers.

Augmentations of copyright law, and expansions in the rights available to trademark owners, have made those limited property rights less distinct (and less limited). Thus, the strength of the rights granted copyright owners under the anticircumvention provisions of the Digital Millennium Copyright Act 1998<sup>10</sup> means that copyright owners can, through the application of technological measures, effectively confer on themselves property rights that do not necessarily preserve the limits classically maintained by the statute, and the courts have (with

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<sup>7</sup>See Council Directive on the legal protection of databases, Council Directive 96/9/ EC, 1996 O.J. L77/20.

<sup>8</sup>See Council Regulation on the legal protection of designs, Regulation No. 6/2002/EC, 2002 O.J. (L003) 1; see generally Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Design Protection in the European Union*, 24 AM. INTEL. PROP. L. ASS'N Q.J. 611 (1996).

<sup>9</sup>See generally Mark D. Janis, *Supplemental Forms of Intellectual Property Protection for Plants*, 6 MINN. J. L. SCI. & TECH. 305 (2004).

<sup>10</sup>See 17 U.S.C. 1201.

some minor exceptions) been unwilling to read limits into the statutory language.<sup>11</sup> The EU Information Society Directive reaches a similar position, albeit with an inchoate legislative commitment in Article 6(4) to preserving certain limitations in the face of restrictive technological protection measures.<sup>12</sup>

And the classical confusion-based limits of trademark law have been weakened or evaded in three principal ways. First, the confusion rationale has been used to encompass third party behavior that gives rise to confusion other than as to the source or origin of the product. Thus, confusion as to affiliation, endorsement, or sponsorship – the theoretical basis for modern merchandizing activities – is clearly actionable in the United States and Europe arguably reflecting the role that trademarks play in contemporary consumer culture.<sup>13</sup> Second, protection of famous marks (or marks with a reputation) against non-confusing dilution has become a worldwide norm.<sup>14</sup> Although the TRIPS Agreement arguably does not require member countries to grant dilution protection,<sup>15</sup> later non-binding joint recommendations of the World Intellectual Property Organization and Paris Union affirm an international commitment to the dilution concept.<sup>16</sup> And dilution laws are taking root internationally, aided perhaps by bilateral agreements that include implementation of the non-binding resolution as among the obligations

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<sup>11</sup>See *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001). *But see* *Chamberlain Group, Inc., v. Skylink Technologies, Inc.* 381 F.3d 1178 (Fed. Cir. 2004); *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004).

<sup>12</sup>For an assessment of both the limits and the potential of Article 6(4), see Remarks of Graeme B. Dinwoodie, *Anticircumvention Protection in the European Union, Edited & Excerpted Transcript of the Symposium on the Law & Technology of Digital Rights Management*, 18 BERK. TECH L. J. 697, 763 (2003).

<sup>13</sup>Cf. TRIPS Agreement, art. 16(3) (mandating such protection for well-known marks).

<sup>14</sup>See 15 U.S.C. 1125(c) (granting dilution protection to famous marks); First Council Directive 89/104/EEC of 21 December 1988 to Approximate the Laws of the Member States Relating to Trade Marks, art. 5(2), 1990 O.J. (L 40) 1 (granting protection where the junior mark “without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of a trademark” with a reputation).

<sup>15</sup>See Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law From the Nation-State*, 41 HOUS. L. REV. 885 (2004). Congress claimed in 1995 that Article 16(3) required the enactment of dilution protection to “famous marks.” See H.R. REP. NO. 104-374, at 4 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1031 (noting that dilution protection for famous marks is required for consistency with TRIPS). However, strong arguments exist that the legislative history of the dilution law overstates the obligations of Article 16(3) and that confusion-based causes of action under U.S. law satisfy Article 16(3). See Paul J. Heald, *Trademarks and Geographical Indications: Exploring the Contours of the TRIPS Agreement*, 29 VAND. J. TRANSNAT’L L. 635, 654 (1996).

<sup>16</sup>See *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, adopted by Assembly of the Paris Union for the Protection of Industrial Property and General Assembly of the World Intellectual Property Organization*, WIPO Doc. 833(E), art. 2(3)(i) (Sept. 1999).

of the signatory states.<sup>17</sup> Finally, the scourge of cybersquatting prompted Congress in the Anticybersquatting Consumer Protection Act 1999 to provide trademark owners with rights to recover domain name registrations registered in bad faith without proof of likely confusion among consumers.<sup>18</sup> A similar position prevails internationally by dint of the Uniform Domain Name Dispute Resolution Policy,<sup>19</sup> promulgated by ICANN but for all intents and purposes the global standard.<sup>20</sup> Taken together, these developments have moved trademark law closer to the misappropriation end of the spectrum more traditionally occupied by patent (and, to a lesser extent) copyright law.

### III. Convergence Type C: Legal Norms

Convergence in the field of intellectual property law might also refer to a convergence of legal norms. As a result of the TRIPS Agreement, adopted ten years ago, and a multitude of other international harmonization initiatives, there has in recent years been a steady convergence of the norms of national intellectual property laws. Policy makers clearly act fully conscious of this dynamic.<sup>21</sup> Legislators and advocates frequently seek to build support for their reform proposals by referring to (and, often, providing a gloss on) existing international obligations.<sup>22</sup> And new initiatives are often touted as vehicles through which prospectively to achieve

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<sup>17</sup>See Free Trade Agreement, May 6, 2003, U.S.-Sing., art. 16.2(b)(1) (providing that each party shall give effect to the Joint Recommendation on Well-Known Marks), [http://www.ustr.gov/Trade\\_Agreements/Bilateral/Singapore\\_FTA/Section\\_Index.html](http://www.ustr.gov/Trade_Agreements/Bilateral/Singapore_FTA/Section_Index.html) (last visited Oct. 7, 2004); cf. Free Trade Agreement, June 6, 2003, U.S.-Chile, art. 17.2(9) (recognizing the importance of the Joint Recommendation and undertaking to be guided by its principles), [http://www.ustr.gov/Trade\\_Agreements/Bilateral/Chile\\_FTA/Section\\_Index.html](http://www.ustr.gov/Trade_Agreements/Bilateral/Chile_FTA/Section_Index.html) (last visited Oct. 7, 2004).

<sup>18</sup>See 15 U.S.C. 1125(d); see also *Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 497 (2d Cir. 2000) (noting the difference between confusingly similar marks and marks the use of which was likely to confuse consumers).

<sup>19</sup>See Uniform Domain Name Dispute Resolution Policy, <http://www.icann.org/dndr/udrp/policy.htm>.

<sup>20</sup>See Council for Trade-Related Aspects of Intellectual Property Rights, *Electronic Commerce Work Programme: Submission from Australia*, IP/C/W/2337, ¶ 44 (Dec. 7, 2000) (suggesting that the UDRP has become the de facto international standard in cybersquatting disputes), [http://www.dfat.gov.au/ip/revised\\_aust\\_ecommerce.pdf](http://www.dfat.gov.au/ip/revised_aust_ecommerce.pdf).

<sup>21</sup>See Graeme B. Dinwoodie, *Incorporating International Norms in the Development of Contemporary Copyright Law*, 62 OHIO STATE L.J. 733 (2001).

<sup>22</sup>See *supra* note 15 (discussing dilution obligations in the TRIPS Agreement); see also Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to Be Revised*, 14 BERK. TECH. L.J. 519 (1999) (discussing relationship between the DMCA and the WIPO Copyright Treaty).

international influence in a climate of convergence, when new statutory models quickly assume the status of a template for replication.<sup>23</sup>

#### IV. Convergence Type D: Cumulation of Rights

The use of the term “concurrency” in the title of this panel implicates another concept upon which there has been much more scholarship going back many years, namely, *cumulation* of rights under different intellectual property regimes. Obviously, the cumulation phenomenon is related to the convergence of subject matter discussed above. Cumulation is directed however at the ability of member states to seek *additional* protection under two or more regimes, or (less conventionally understood) the ability to fill gaps in protection under one regime with protection available under other regimes. To be sure, the ability to cumulate rights or fill gaps arises from the convergence in subject matter protected by different regimes, but cumulation does not necessarily follow from convergence. The convergence of subject matter might simply allow right holders to elect between, rather than to cumulate, different forms of protection.

A subsidiary theme, taken up in Dr. Westkamp’s paper, is the relationship between the general regimes and multiplying *sui generis* protection of discrete forms of innovation. Again, concurrency and convergence in this sense has increased of late.<sup>24</sup> Two notable examples of this phenomenon in the European Union are design protection and database protection, referred to earlier under the heading of subject matter convergence.<sup>25</sup> And this is an extremely important issue in the broader international climate to which I just referred. There, rationalizing forms of protection in ways that might reduce certain forms of protection in particular countries has proved difficult for obvious historical and political reasons. The focus of the twentieth century was on affording minimum protections. And curtailing protection interferes with vested rights and expectations.

The historical and political climates may, however, be changing. Twenty-first century international intellectual property policy will, among other things, have to pursue a fair balance of rights when most countries comply with minimum standards. And the political economy of

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<sup>23</sup>See Dinwoodie, *supra* note 8 (discussing the motivations behind the EU Design Directive).

<sup>24</sup>See also *J.E.M. AG Supply v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124 (2001) (newly developed plant breeds are patentable subject matter, under general utility patent statute, notwithstanding additional protections potentially available under Plant Patent Act and Plant Variety Protection Act).

<sup>25</sup>For a while, the United States Copyright Office practice was to deny copyright registration claimed in a “patented design or in the drawings or photographs in a patent application . . . after the patent has issued.” 37 C.F.R. § 202.10(a) (1991). In essence, the Copyright Office sought to impose an election upon the author of the design. This has changed, however, and an election is no longer imposed. Moreover, the courts have long adopted a more generous view and permitted cumulation of design patent and copyright. See *In re Yardley*, 493 F.2d 1389, 1394 (C.C.P.A.1974) (“Congress has not provided that an author-inventor must elect between securing a copyright or securing a design patent,” and allowing cumulation). The Vessel Hull Design Protection Act, enacted in 1998, permitted cumulation of design right and other rights (except design patent). See 17 U.S.C. §§ 1329-30 (1998).

intellectual property lawmaking now includes representatives of users who argue that enactment of enhanced protections interferes as acutely with vested rights of users and competitors in ways that undermine competing expectations of free use. If harmonization is not simply to mean the grant of additional weapons to a plaintiff without regard to an appropriately legislated balance, provisions limiting the ability to cumulate rights – unless the rights truly protect different legal interests – will be important legislative tools, both domestically and internationally.

The cumulation dilemma is not simply a product of new *sui generis* rights. It may, and increasingly does, involve the pursuit of rights under two or more primary intellectual property regimes. In the remainder of this paper, I address two recent opinions of the United States Supreme Court that address, albeit without detailed discussion, the problem of cumulation of rights under copyright, patent, and trademark law. One might ask, however, why these two cases are likely to offer fresh insights to this problem. After all, the United States Supreme Court has issued several opinions dating back to 1896 in cases where plaintiffs sought to use trademark and unfair competition law to evade (intentional) limits in patent protection. In several of those cases the Court mentioned the right of competitors to copy the subject matter of an expired patent.<sup>26</sup> Most of those “right to copy” cases, however, involved claims of rights asserted under state unfair competition or trade secret law in circumstances where federal patent law afforded no relief. As a result, the availability of relief in those older cases was informed as much by principles of federalism as by core beliefs about the appropriate scope of intellectual property protection under alternative schemes. In the two cases I will discuss, the competing regimes under which the plaintiff sought to cumulate rights were both federal in character, thereby removing the federalism variable and isolating the basic question of intellectual property policy.

Given the constitutional dimension to these prior cases (rooted in constitutional principles of federalism, and the Supremacy Clause in particular), as well as the fetish of constitutionalism that currently animates intellectual property scholars in the United States,<sup>27</sup> there is a reflexive tendency among some U.S. academics to believe that the results announced in these cases were likewise constitutionally grounded. But the Court was careful to deny the constitutional pedigree of its opinions, suggesting *greater* potential universality. Ironically, in ways perhaps not fully appreciated by those seeking to constitutionalize contemporary debate, the Court’s refusal to ground its decisions in the U.S. Constitution enhances the influence of the Court in the broader international environment in which domestic intellectual property policymaking is often framed.

By the same token, the opinions (especially *Dastar*) purport in large part to be literalist exercises in statutory interpretation, which may rob them of broader application absent similar

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<sup>26</sup>See *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249 (1945); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

<sup>27</sup>See Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004); Graeme W. Austin, *The Berne Convention as a Canon of Construction: Moral Rights after Dastar*, \_\_\_ ANN. SURVEY OF AM. LAW \_\_ (2005) (forthcoming).

statutory language and structure in other countries and cultures.<sup>28</sup> And, as I will suggest below, the Court's progress toward general principles on cumulation is halting at best. But the similarities between the Court's doctrinal approach in *TrafFix Devices* and that of the European Court of Justice in *Philips v. Remington* suggest that, at least in minor respects, courts are developing a common approach to these questions across national lines.

## V. Two Recent Supreme Court Cases

### 1. *TrafFix Devices v. Marketing Displays, Inc.*

Trademark law excludes from protection or registration designs that are “functional.”<sup>29</sup> Although the principle is uncontested, in recent years, the courts have applied a myriad of doctrinal tests to determine whether a design is functional. The Supreme Court has never provided completely clear signals regarding the appropriate test of functionality. Nor has the Court adhered to a constant position regarding the relevance of a prior utility patent to the availability of trademark protection in general, and to the functionality rule in particular. But in recent years, the Court has identified the functionality rule as one way of ensuring that broad protection under trademark law does not circumvent limits (temporal and otherwise) intentionally incorporated in the patent scheme.<sup>30</sup>

In *TrafFix Devices v. Marketing Displays, Inc.*,<sup>31</sup> the plaintiff sought to protect the dual-spring design of a road sign on which its utility patents had expired. The dual-spring design enabled the road sign to withstand the gusts that would often blow on the open road. When a rival copied the dual-spring design after the expiry of the plaintiff's patents, the plaintiff brought an action under trademark and unfair competition law.

The Court's opinion touched on both the primary respects in which the functionality concept was unclear. On the doctrinal test to be applied, the Court articulated an approach that in several respects corresponds to the approach adopted by the European Court of Justice in interpreting the functionality exclusion contained in Article 3(1)(e) of the EU Trademark

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<sup>28</sup>See Graeme B. Dinwoodie, *The Seventh Annual Honorable Helen Wilson Nies Memorial Lecture on Intellectual Property Law: The Trademark Jurisprudence of the Rehnquist Court*, 8 MARQ. INTELL. PROP. LAW R. 187 (2004).

<sup>29</sup>See Restatement (Third) of Unfair Competition § 17 (1995). Such designs will also be denied registration by the Trademark Office. See 15 U.S.C. § 1052(e)(5). In an infringement action under Section 32 (i.e., where the design is registered as a trademark), the burden to prove functionality rests upon the defendant; in an action for infringement of an unregistered design mark (under Section 43), the plaintiff must prove nonfunctionality. See 15 U.S.C. § 1125(a)(3) (1999 Supp.)

<sup>30</sup>See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>31</sup>532 U.S. 23 (2001).

Directive. The Court confirmed that “in general terms, a product feature is functional . . . if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>32</sup> This test, first announced by the Court in dicta in *Inwood Laboratories, Inc. v. Ives Laboratories Inc.*<sup>33</sup> had previously been endorsed by the Court in *Qualitex* in 1995, but because of an ambiguous elaboration by the Court in that case, lower courts had applied the test in a number of different ways.

In particular, it was unclear, in applying the *Inwood* test, what role was served by analysis of competitive necessity and, relatedly, the existence of alternative designs that could perform the same function. The Court rejected competitive necessity as a comprehensive measure of functionality<sup>34</sup> and found that there was no need to have regard to alternative design possibilities if the *Inwood* test was met. That is to say, if a design feature is essential to the use or purpose of the article in question or affects the cost or quality of the article (the *Inwood* test), then the design feature is functional without further analysis. Thus, for example, the Supreme Court in *TrafFix Devices* regarded the dual-spring design of a road sign as functional because that design “provides a unique and useful mechanism to resist the force of wind.”<sup>35</sup>

Although this test is not without its problems, and may yet require courts as a practical matter to consider the variables that the Court suggests are not *necessary* to consider,<sup>36</sup> the conclusion of the Court on the relevance of competitive necessity and alternatives parallels the decision of the European Court of Justice in *Philips*. This strict application of functionality indirectly affects the problem of cumulation by restricting further the number of product designs

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<sup>32</sup>*TrafFix Devices*, 532 U.S. at 32 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

<sup>33</sup> 456 U.S. 844, 850 n.10 (1982).

<sup>34</sup>The *TrafFix Devices* Court placed its imprimatur upon one of the several elaborations on the *Inwood* test found in its *Qualitex* opinion. See *TrafFix Devices*, 532 U.S. at 32 (“Expanding upon the meaning of this phrase, we have observed that a functional feature is one ‘the exclusive use of [which] would put competitors at a significant non-reputation related disadvantage’”(quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). But the Court stressed that this “expansion” of the *Inwood* test articulated in *Qualitex* was not a comprehensive definition of functionality. The *TrafFix Devices* Court appeared to regard the elaboration of *Inwood* articulated in *Qualitex* as targeted at what the U.S. courts call “aesthetic functionality.” This historically confusing doctrine excludes from trademark protection designs which, though aesthetic rather than utilitarian, are essential for rivals to imitate in order to compete.

<sup>35</sup> See also *id.* at 31 (noting that the design for which trade dress protection was sought “serves the important purpose of keeping the sign upright even in heavy wind conditions . . . , [does so] in a unique and useful manner” and “achieves important operational advantages” by preventing twisting of the sign, and “affects the cost or quality” of the sign because use of an additional spring in the design would increase the cost); *id.* at 34 (“the dual-spring design . . . is the reason the device works”).

<sup>36</sup>Although the Court has rejected the lack of alternatives or competitive necessity as necessary components of a court’s analysis (or of a defendant’s case), some lower courts have continued to have regard to both these questions (often while acknowledging the *TrafFix* opinion).

that might receive trademark protection, and thus reducing the number of potential conflicts with patent law. However, this part of the Court’s opinion did not directly address the issue of cumulation because whether a design is “essential to the use or purpose of an article” is not necessarily linked to whether the design could have been or was protected by patent. As the Tenth Circuit pointed out in *Vornado v. Duracraft*, the concepts of novelty and utility that drive patent law do not neatly correspond to the requirements of distinctiveness and functionality on which trademark protection depends.<sup>37</sup>

On the question more directly connected to cumulation, the Court appears to depart from the approach of the European Court of Justice in *Philips*. The Court was, however, even less clear in this context than it was in analyzing the basic functionality standard. Indeed, the approach that the Court adopted to the expiry of the patent raises more questions than it answers. Yet this was the precise question upon which the Court granted certiorari: could trademark rights be asserted in the design of an article that had previously been the subject of a utility patent (since expired)?

A split had developed among the lower appellate courts. One circuit court, the Court of Appeals for the Tenth Circuit, had held that “[w]here a product configuration is a significant inventive component of an invention covered by a utility patent . . . it cannot receive trade dress protection . . .”<sup>38</sup> Several other circuits had (like the European Court of Justice in *Philips*) refused to foreclose trade dress protection merely because the design feature for which trade dress was claimed had been the subject of an expired patent.<sup>39</sup>

The *TrafFix* Court held that “[a] utility patent is strong evidence that the features therein claimed are functional.” In the case before it, the Court found that there was a “strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patents,” such design being “the central advance claimed in the expired utility patents” and “the essential feature of the [claimed] trade dress . . .” Then, the Court concluded (without much analysis) that the plaintiff had failed to overcome the inference of functionality.

The Court’s opinion raises at least two questions concerning the inference derived from the expiry of a patent. First, which aspect of the Court’s description of the dual-spring design triggered the “strong evidentiary inference of functionality”?<sup>40</sup> Second, in what ways could the

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<sup>37</sup>See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995).

<sup>38</sup>See *id.* at 1500.

<sup>39</sup>See, e.g., *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998); *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir. 1999).

<sup>40</sup>In addition to the “central advance claimed in the patent” and the “essential feature of the claimed “trade dress”, the Court noted that “the springs are necessary to the operation of the device” and that the defendant’s product would

plaintiff overcome this inference? The answer to each of these questions might be more easily detected if the purpose or source of the “evidentiary inference” were more clearly explained by the Court. Some briefs submitted to the Court sought to rest non-protection for design features covered by an expired patent on the so-called “right to copy” the subject matter of expired patents (to which some briefs ascribed a constitutional pedigree, based upon the conflict between the Copyright and Commerce Clauses of the United States Constitution). The Court expressly deferred consideration of the constitutional arguments to another day.<sup>41</sup>

Instead, the inference would appear to flow from the likelihood, as an empirical matter rather than as a rule of law, that design features included within the claims of a patent are essential to the purpose of the article (and thus within the *Inwood* test).<sup>42</sup> As such, the Court does not appear to have endorsed any firm principle against cumulation. By limiting the effect of the expired patent to an “evidentiary inference” that can be rebutted, the Court has declined to bar cumulation by recognizing that *some* trade dress claims may yet succeed. To be sure, the Court appears to have endorsed a strengthened functionality prohibition, but the less generous trademark protection it envisages for product designs is a function of considerations internal to trademark law rather than any external commitment to a principle of non-cumulation.

By the same token, the Court’s recognition that product designs can indeed be protected by trademark law even after the expiry of a patent on the design should not be read as a disregard for the concerns that motivate opposition to cumulation. The Court is clearly wary of allowing broad trademark protection for patented designs. It says so explicitly in *TrafFix* (as it did two years earlier in *Wal-Mart*). It prefers, however, to address those concerns indirectly through strict application of core trademark doctrine rather than to develop any principle designed to regulate directly the overlap between patent and trademark law. The Court in *TrafFix* is a long way from getting its arms around the issue of cumulation.

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have infringed the expired patent based upon the doctrine of equivalents.

<sup>41</sup>See 532 U.S. at 35 (suggesting that such a question might be raised where “trade dress becomes the practical equivalent of an expired utility patent”). The toughest constitutional question – where trade dress might “become the practical equivalent of an expired utility patent” – might have been avoided by other recent developments. Trade dress protection for designs begins to approximate patent protection most readily when its is detached from its confusion-based moorings. Dilution protection for designs – available without regard for confusion – offered this possibility. Although some courts recognized that this pushed the constitutional question to the brink, *See I.P. Lund Trading Aps v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998), other courts were willing to countenance the possibility of dilution protection for design trade dress. *See Sunbeam Prods. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997). And the statutory language would appear to admit of this possibility. But recent developments in dilution case law might avoid this question. The Court of Appeals for the Second Circuit has held that dilution protection is available only to marks that are inherently distinctive. *See TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88 (2d Cir. 2001). Combined with the ruling by the United States Supreme Court that designs may only be protected upon proof of secondary meaning (and thus cannot be inherently distinctive), *see Wal-Mart Stores, Inc. v. Samara Bros, Inc.*, 120 S. Ct. 1339 (2000), this would exclude the possibility of dilution protection for product designs.

<sup>42</sup>See 532 U.S. at 31 (discussing the ways in which “the rationale for the rule that the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality is well illustrated in this case”).

2. *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>43</sup>

Although the Supreme Court previously addressed the potential conflict between patent and trademark protection, it had paid less attention historically to the relationship between copyright and trademark protection. But cumulation of these two rights is clearly a possibility given the liberal approach to subject matter in the lower courts. For example, characters, whether first developed as part of literary, audio-visual, artistic, or other works, are protectable by both copyright and trademark law.<sup>44</sup> Likewise, clothing, furniture, and architectural designs are potentially protectable under both regimes.<sup>45</sup> The cover or appearance of a book may be protected by copyright (as a pictorial, graphic, or sculptural work) provided that the prerequisite of originality has been satisfied. But the appearance of a book may also be protected by trademark law, if the cover or appearance has come to act as a source-identifier.<sup>46</sup>

Courts have developed no rule prohibiting cumulation under copyright and trademark law. In particular, and perhaps most importantly, the courts have developed no generally applicable rule that trademark protection is to be denied where copyright protection is unavailable. As a result, trademark law may be used to restrain free use of a work even when it is in the public domain as a matter of copyright law.<sup>47</sup> The general approach of the courts is to treat the different forms of intellectual property protection quite discretely, an approach often justified by reference to the different purposes of the separate regimes.

In recent years, however, some courts have expressed concern that the convergence of the subject matter of copyright and trademark law has allowed trademark law to provide protection where copyright law affirmatively permitted copying of the work in question. Courts have seen some topics as essentially the “natural territory” of copyright law, and have protected the sovereignty of copyright law in those areas by exhibiting stricter attitudes to trademark eligibility. Thus, for example, although sound marks can be protected and registered, claims that a

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<sup>43</sup>539 U.S. 23 (2003).

<sup>44</sup>*See, e.g.,* Walt Disney Co. v. Powell, 698 F. Supp. 10 (D.D.C. 1988) (the appearance of Mickey Mouse protected by trademark law as well as copyright law).

<sup>45</sup>*See, e.g.,* Wal-Mart v. Samara Bros., 165 F.3d 120 (2d Cir. 1999) (upholding copyright and trade dress claim for infringement of clothing designs), *rev'd on other grounds*, 529 U.S. 205 (2000) (rejecting trade dress claim for the clothing design features).

<sup>46</sup>*See* Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191 (S.D.N.Y. 1979) (denying defendant's motion for summary judgment in case where trade dress rights claimed in the appearance of a book); Reader's Digest Assoc. v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987) (protecting the cover design of a magazine as an original work of authorship and a source-identifying dress).

<sup>47</sup>*See* Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191 (S.D.N.Y. 1979).

“signature song” can serve as a trademark have met with less success.<sup>48</sup> In *EMI Catalogue Partnerships v. Hill, Holiday, Connors, Cosmopolous, Inc.*, the Second Circuit held that, although the title of a song may serve as a trademark in certain circumstances, the musical composition itself may not be protected by trademark, and stressed that “copyright law, not trademark law, is the primary vehicle for protecting the rights of a song’s composer . . . in the musical composition.”<sup>49</sup> And several court decisions have more directly attempted to transpose the limits of copyright law into trademark law where protection is being sought for a work that is, has been, or potentially is, the subject matter of copyright protection. Thus, for example, some courts have determined (and denied) distinctiveness of design features under trademark law by direct appeal to the impact of protecting an idea in violation of copyright law.<sup>50</sup>

But nominally these decisions, with rare exceptions,<sup>51</sup> merely allowed the copyright policy of free copying to inform their conclusion with respect to the distinctiveness (and hence protectability) of the claimed mark. In this regard, these decisions approached the problem of cumulation in ways not unlike the Court in *TraFFix*. They did not tackle in detail the harder question: does there exist a “right to copy” the subject matter of an expired copyright, or parts of a work left unprotected by copyright? One should perhaps not expect clarity on this question, given the failure of the Court after a century of trying to define the status or scope of the right to copy the subject matter of an expired patent. The recent decision of the Court in *Dastar* may contain the first hints about the Court’s attitude – although, as in *TraFFix*, one cannot describe the Court’s guidance in any more definite terms.

In *Dastar*, the plaintiff (Twentieth Century Fox) was the owner of a copyright in a television series based upon President Eisenhower’s book *Crusade in Europe*. After that

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<sup>48</sup>See, e.g., *Oliveira v. Frito-Lay, Inc.*, 50 U.S.P.Q.2d 1152 (S.D.N.Y. 1999) (denying protection and noting that “protection for musical works falls under the rubric of copyright law, not trademark law”).

<sup>49</sup>228 F.3d 56, 63-64 (2d Cir. 2000); see also *Galerie Furstenberg v. Coffaro*, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988) (dismissing trademark claim based upon appropriation of the style of Salvador Dali because such claims are properly brought under the copyright statute).

<sup>50</sup>See, e.g., *Jungle Rags, Inc. v. Rainbow Graphics, Inc.*, 29 U.S.P.Q.2d 1704, 1708 (M.D. Fla. 1993) (flap in shirt in shape of animal’s mouth not inherently distinctive because to make that finding would grant monopoly on the fashion idea); *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995) (“In evaluating claims to distinctive trade dresses, two additional considerations should be borne in mind. . . Second, just as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a generalized type of appearance.”); *Leigh v. Warner Bros.*, Civ. No. 497-340, 1998 WL 351878, at \*8-9 (S.D. Ga. June 22, 1998) (noting the potential for “undermining copyright” by offering trade dress protection to a photograph used on the cover of a book), *aff’d in relevant part*, 212 F.3d 1210 (11th Cir. 2000).

<sup>51</sup>Some courts have suggested that if a work has passed into the public domain under copyright law, trademark law cannot be used to protect it. See *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 596 (9th Cir. 2000) (rejecting claim of trademark in 30-second clip from public domain motion picture and commenting that “we will not entertain this expedition of trademark protection squarely into the dominion of copyright law”).

television series fell into the public domain for failure to comply with copyright renewal formalities, the defendant Dastar purchased tapes of the series, edited them, added material of its own, and sold the revised video tapes as its own product. The packaging for the product made no reference to the original television series: it said “Produced and Distributed by” a Dastar subsidiary. The plaintiffs sued under copyright law (based on other works that were still in copyright) and under Section 43(a) of the Lanham Act, arguing that Dastar’s conduct in failing to credit the source of the television series amounted to reverse passing off. The Ninth Circuit affirmed the judgment for the plaintiffs on the Lanham Act claim, primarily based upon the proposition that the “bodily appropriation” of a plaintiff’s work without attribution was sufficient to support a Lanham Act claim.

The Court proceeded primarily from a literal interpretation of the language of the statute—was the failure to include a reference to Twentieth Century Fox or the television series a “false designation of origin” within the meaning of Section 43(a)? What did “origin” mean? The Court believed that “origin” in section 43(a) simply meant the source of the “tangible goods sold in the marketplace” (the tapes) and could not be extended to the source of the creative content. Dastar *was* the source of the physical tape and thus any designation of origin was accurate.

One could explain the Court’s decision as simply the product of rather dubious statutory interpretation, aided by even more questionable assessments of consumer attitudes to creative products. Thus, Justice Scalia concluded (without any empirical support) that consumers were probably not interested in the source of creative content but instead understood the name on the tape as an indication of the manufacturer and distributor of the physical tape. But regardless of how the Court reached its conclusion, the rule that denies a reverse passing off claim in the circumstances presented in *Dastar* does limit the possibility of cumulation – although, as in *TraFFix*, the Court did so not for any reason explicitly rooted in a position regarding the wisdom of cumulation, and thus without suggesting any predisposition of the Court toward that question.

The scope of the *Dastar* rule, and thus the extent to which cumulation issues are avoided, will depend upon how broadly lower courts read the opinion. Does it preclude actions under Section 43(a) only when the work could be (or was) protected by copyright? Would a product that failed to be sufficiently original to qualify for copyright be similarly treated? Does *Dastar* preclude actions only when the work is in the public domain by virtue of a failure to renew copyright? Would works that enter the public domain for other reasons also be denied Lanham Act protection? Are Lanham Act claims barred by *Dastar* even while the work is still protected by copyright? What if the plaintiff seeks protection for part of the work unprotected by copyright, such as an idea or concept, or to restrain third party conduct not reached by the copyright? If a plaintiff can frame its action without using the phrase “origin” in Section 43(a), does *Dastar* have any effect. (For example, one could plead a Section 43(a) cause of action complaining about a false use of a term that causes confusion as to affiliation.)

Lower courts thus far have read *Dastar* broadly.<sup>52</sup> But none of the questions posed above – all of which might fairly affect the scope of the decision – derives any clear answer from the opinion. If the *Dastar* rule is nominally grounded in interpretation of the term “origin” or indeed in judges’ amateur psychological speculation about consumer attitudes, the rule will continue to develop with only indirect significance for the development of a Court philosophy on cumulation.<sup>53</sup> That is to say, these are the sorts of questions that will determine the ability of *Dastar* to avoid the cumulation problem, but they will be answered without *any* explicit attention to the policy concerns that might counsel in favor of or against cumulation.

Yet, there were other implicit influences in the *Dastar* opinion that might be more directly related to concerns about cumulation. The Court referred to the practical difficulties for rival producers that broad trademark protection would have created. Which persons—authors, directors, actors, publishers, broadcasters—would have to have been identified by *Dastar*? And the Court suggested that if *Dastar* had placed the names of any of those people, including Fox, on its tape, it might have been sued under a false endorsement theory. The Court thus appears concerned that competitors are able to engage in proper competitive conduct—assuming the work is out of copyright—without the uncertainty of not knowing who to credit, and without the risk of being sued no matter what attribution strategy they followed. One could argue that the *Dastar* Court was developing unfair competition law in line with a (barely-stated but defensible) prudential principle of commercial certainty.

Although this consideration is not linked explicitly by the Court to the question of cumulation, it does reflect a concern that underlies criticism of cumulation of rights and might also be seen in the *TrafFix* opinion: cumulation of rights undermines the certainty necessary for competitors to engage in conduct desired by a competitive economy and dynamic innovation policy. Certainty for competitors is, of course, only one policy value that trademark and unfair competition law pursues. Avoiding consumer confusion is also important. But in a more recent opinion, *KP Permanent Makeup v. Lasting Impression*,<sup>54</sup> the Court implicitly accepted that there will be circumstances where the value of avoiding confusion will be over-ridden by other policy values. Does a concern that cumulation might have adverse effects constitute one such reason? One can, unfortunately, only speculate.

Moreover, and perhaps most significantly for the cumulation question, the Court supported its conclusion by arguing that allowing the plaintiff’s claim to proceed would conflict with case law establishing the right to copy a work that has fallen into the public domain. The

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<sup>52</sup>See, e.g., *Zyla v. Wadsworth*, 360 F.3d 243 (1st Cir. 2004) (applying *Dastar* to dismiss claims relating to copyright-protected book); *General Universal Sys. v. Lee*, 379 F.3d 131 (5th Cir. 2004) (protected software).

<sup>53</sup>Perhaps the most significant consequence of the decision has been on the ability to obtain moral rights-like protection in the US courts. See Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263 (2004)

<sup>54</sup>*KP Permanent Make-up, Inc., v. Lasting Impression I, Inc.*, 125 S.Ct 542 (2004).

Court reasoned that “the right to copy, and to copy without attribution, once a copyright has expired, like the right to make [an article on which a patent has expired] – including the right to make it in precisely the shape it carried when patented – passes to the public.”<sup>55</sup> The Court’s continuing concern with what it noted in *TrafFix* is clear, namely, broad protection under the Lanham Act might come to interfere with other intellectual property regimes. Indeed, in this case, the Court described the plaintiff’s argument as seeking to create a species of “mutant copyright.” Again, this suggests *some* concern on the part of the Court regarding a principle of cumulation, but there is nothing in the opinion that offers clear guidance on how that concern might be doctrinally effectuated through a limitation on trademark protection.

And, again as in *TrafFix*, the Court did not adopt an absolute position on the availability of protection against reverse passing off. It explicitly acknowledged that in certain circumstances an action would lie for repackaging of the plaintiff’s creative product. The Court is not barring actions in trademark and unfair competition law. But the Court is skeptical about actions grounded in trademark doctrines (such as the rule of “bodily appropriation” applied by the Ninth Circuit) that sound suspiciously like copyright law or that seek relief against appropriation (akin to copyright law) rather than misrepresentation and confusion (the touchstone of U.S. trademark law). This brings us back to the other aspects of convergence. To avoid the concerns of the Court and enable continued assertion of appropriate trademark claims, a plaintiff’s complaints must be grounded in and pled as complaints of misrepresentation rather than misappropriation.<sup>56</sup>

### Conclusion

After two decisions in which the Supreme Court declined to permit trademark law to provide relief where patent and copyright law, respectively, had expired, it might be tempting to extract from those outcomes a general principle regarding cumulation of rights. In both cases, however, the Court accepted that, with slightly different facts, a claim may lie under the Lanham Act notwithstanding the possibility of protection under other regimes. So, too, although the Court expressed concern about trademark law being used inappropriately to circumvent limits found in other forms of protection, in neither case did it declare that trademark protection should be denied because of a principle of non-cumulation. Instead, the Court gave voice to its concern by tightening in different ways the eligibility for trademark and unfair competition protection. And that tightening reflected broader currents that one can detect across a range of recent

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<sup>55</sup>539 U.S. at 33.

<sup>56</sup>In this regard, the Court did not properly apply the misrepresentation-based precedent upon which it relied to sustain “the right to copy.” In particular, *Kellogg Co. v. National Biscuit Co.* expressly conditioned this right on the defendant’s obligation not to mislabel the product. To be sure, *Dastar* is hardly on all fours with *Kellogg*. In *Dastar*, the plaintiff complained about the failure of the defendant to attribute the creative content of the defendant’s product as emanating from the plaintiff. The *Kellogg* Court would not under any circumstances have required the defendant to acknowledge on its products that the shape of the product was copied from Nabisco. However, even accepting the right to copy, the *Kellogg* Court was conscious of the need to assess and ensure differentiation between the parties’ products.

Supreme Court trademark jurisprudence: concern for certainty sufficient to foster a climate of competition; confining trademark law to its classic purposes; and tolerating some levels of confusion to effectuate competing goals.<sup>57</sup>

This approach to the problem of cumulation may seem convenient. At the very least, it avoids the Court grasping for a solution that has eluded scholars and policymakers throughout the world for over a century. Yet, tackling hard problems sometimes presents fundamental opportunities as well as intractable dilemmas. Facing up directly to the difficulties of cumulation would have allowed the Court to make explicit the concerns identified above, and to develop the relationship between those goals and the consumer-confusion avoidance goals of trademark law. It would have forced the Court to address more explicitly the role of remedies in mediating between the demands of competing social benefits. And it would have required the Court to reconceptualize the status of exceptions and limitations in intellectual property law and to consider whether, as some scholars suggest, such exceptions and limitations have an affirmative value that matches and sometimes outweighs the value of exclusive property rights. Such a candid approach might at first have created some uncertainty, but over time it would have provided policymakers and later courts with guidance not only about the cumulation of rights but also about debates that will shape a range of controversies in intellectual property law.

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<sup>57</sup>See Dinwoodie, *supra* note 28.