Principal Trademark Registration and Patent Policy: An Inherent Conflict Which Requires Denial of Registration to Container Designs

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PRINCIPAL TRADEMARK REGISTRATION AND PATENT POLICY: AN INHERENT CONFLICT WHICH REQUIRES DENIAL OF REGISTRATION TO CONTAINER DESIGNS

I. INTRODUCTION

The plaintiff in Sears v. Stiffel Co. sought to enjoin defendant's simulation of his pole lamp, alleging that this copying constituted both infringement of his design patent and unfair competition. The lower court, although holding the design patent invalid, enjoined defendant's copying, reasoning that there was a likelihood of confusion as to the source of the product, and that hence, the copying constituted unfair competition which could be enjoined under state law. On appeal, the United States Supreme Court reversed, holding that copying of an unpatented article could not be enjoined through application of a state's unfair competition laws, because federal patent policy establishes that the public has the right to freely copy any unpatented article, since such articles are part of the public domain. The doctrine of pre-emption mandated that state unfair competition law could not withhold from the public something which is within its domain under applicable federal law.

The Sears case, standing alone, was limited in breadth because of two qualifications announced by the Court. First, it was said that a state could nevertheless require product sources to be readily identifiable through clear labeling. Second, a state could still protect businesses in the use of their trademarks or distinctive packages in order to prevent misleading product source identification. Thus, it appeared that Sears would preempt state unfair competition law only when it clashed with the objectives of federal patent law. However, this interpretation of Sears becomes somewhat uncertain when it is related to the companion case of Compco Corp. v. Day-Brite Lighting, Inc., in which it was again held that copying of an unpatented design could not be enjoined by state law. In Compco there were express findings that the design of plaintiff Day Brite's reflector identified that company to the trade and that defendant had followed the design closely enough to raise the likelihood of confusion as to product source. Despite these facts, however, the Court concluded that, absent patent or other federal statutory protection, federal policy permitted copying "in every detail by whoever [sic] pleases," even though

2. Sears Roebuck & Co. v. Stiffel Co., 313 F.2d 115 (7th Cir. 1962).
3. 376 U.S. at 232. A contrary result would allow states to permit perpetual protection from copying to articles not entitled to patent protection; whereas, articles entitled to such protection would be immune from copying for only fourteen or seventeen years.
4. Id.
5. Id. at 231.
7. Compco Corp. v. Day-Brite Lighting, Inc., 311 F.2d 26, 30 (7th Cir. 1962).
8. 376 U.S. at 238.
the design might be: (1) distinctive; (2) non-functional;9 (3) arbitrary;10 (4) possessive of secondary meaning;11 and (5) even though the copy results in confusion as to the source of the product.12 The thrust of the Court’s opinion was that patent law protection from copying could not be extended beyond its limited duration because such an extension would be contrary to the patent law policy of allowing free copying of unpatented articles.

The Court attempted to limit the scope of Compco by intimating that copying of unpatented designs might be enjoined where such an injunction was based upon “other federal statutory protection.”13 Under the Lanham Trademark Act of 1946,14 an injunction can issue when a Principal Register trademark15 is copied.16 Registration on the Principal

9. A design is non-functional if it is not essential to the use of the container or article and not necessary for successful operation of the product. For example, if it is simply ornamental or serves merely as a badge or identifying mark, it will be considered non-functional. See, e.g., J.C. Penny Co. v. H.D. Lee Mercantile Co., 120 F.2d 435 (2d Cir. 1941); Lektro-Shave Corp. v. General Shaver Corp., 92 F.2d 700 (2d Cir. 1939); cert. denied, 296 U.S. 648 (1935), aff’d on rehearing, 109 F.2d 566 (2d Cir. 1940).

10. A feature or design is arbitrary if its existence is not essential to the product’s use or if it has no functional value. See, e.g., Champion Spark Plug Co. v. A.R. Mosler & Co., 233 F. 112 (S.D.N.Y. 1916).

11. A design, symbol or feature is deemed to have acquired secondary meaning if it has, by sufficiently long and exclusive use, become associated in the minds of purchasers with the source or origin of the goods. If the feature identifies the producer to the trade and if it is broadly known to the public as denoting a product of certain origin, it has acquired secondary meaning. See Annot., 150 A.L.R. 1067, 1079-82 (1944).

12. 376 U.S. at 238. The Court stated that these factors might be relevant in applying state labeling law but that they could not furnish a basis for prohibiting copying. In support of this proposition the Court relied upon Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938), but that case would seem to be weak support for such a conclusion, since: (1) the plaintiff in Kellogg had failed to show that secondary meaning had attached; and (2) the Court took great pains to distinguish its position from one in which secondary meaning had attached. Id. at 119-21. Moreover, where the copying takes place for the specific purpose of making one’s goods appear to be those of another, it would seem that the states should be permitted more discretion in stopping such predatory business practices than mere labeling laws. See Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 232 (Harlan, J., concurring).

13. 376 U.S. at 238.


15. In order for a trademark to be registrable on the Principal Register, the applicant must provide verification that his mark is in use in commerce and that no other person has the right to use it and thereby cause mistake, confusion, or deception. 15 U.S.C. § 1051(a) (1) (1964). See Blisserald of Hollywood v. United Plastics Co., 294 F.2d 694 (2d Cir. 1961); In re Hehr Mfg. Co., 279 F.2d 526 (C.C.P.A. 1960).


16. The owner of a trademark is entitled to the exclusive right to use it. See, e.g., In re Helene Curtis Indus., Inc., 305 F.2d 492 (C.C.P.A. 1962). 15 U.S.C. § 1065 (1964), provides in pertinent part that:

[T]he right of the registrant to use such registered mark . . . for the goods . . . on . . . which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration . . . shall be incontestable. . . . Thus, not only can use be prohibited, but the registration cannot be challenged after five years. Moreover, any person who uses or copies a registered trademark in such
Register may be obtained for configurations if they are non-functional, distinctive and if they possess secondary meaning. Moreover, protection under the Lanham Act may continue indefinitely if the registrant continues to use the mark. In *Compco*, the patent policy of free copying mandated that the distinctiveness, non-functionality, and secondary meaning of an object could not operate to prohibit copying of unpatented designs and that the limited duration of protection from copying could not be extended after the expiration of a patent. Inasmuch as both results might inure from principal registration under the Lanham Act, it would appear that, despite its nebulous disclaimer, *Compco* implicitly suggests that there is a conflict between federal patent policy and federal trademark law. Moreover, this conflict would seem to belie the suggestion in *Sears* that protection could still be extended to businesses in the use of their trademarks.

The problem is further compounded by a decision rendered by the Court of Customs and Patent Appeals on the same day as the *Sears-Compco* cases. In the *Mogen David Wine* case, the applicant sought principal registration for the bottle which contained his product. The Trademark Trial and Appeal Board decided that registration could not be obtained because the bottle was already protected by a design patent. The appellate court reversed, holding that the existence of a design patent did not, as a matter of law, preclude registration on the Principal Register. Furthermore, it was ruled that use during the existence of a design patent could amount to trademark use sufficient to entitle the owner of the design to a trademark. This holding was based upon the assumption that patent law existed independently of trademark law and served different purposes. In reaching this conclusion, the court stated that it knew "of no provision of patent law, statutory or otherwise, that a way as to cause confusion, mistake, or deception is liable to the registrant in a civil action for trademark infringement. 15 U.S.C. §§ 1114-15 (1964)."

17. Configurations of goods or containers are considered registrable on the Principal Register because the following language of section 2(f) is deemed broad enough to include configurations:

[N]othing in this chapter shall prevent registration of a mark... which has become distinctive of the applicant's goods in commerce...

18. Although 15 U.S.C. § 1058 (1964), places a twenty year limit upon the time during which a registration certificate remains in force, the section which follows it provides that the registration may be renewed for additional periods of twenty years. 15 U.S.C. § 1059 (1964).


22. *Id.* at 931-32. This ruling was based upon the rationale that Congress had the power to include the subject matter of design patents used during the life of the patent, one of the exceptions to the distinctive marks which could be registered after sufficient trademark use and that the court should not exercise that power in the face of Congress' failure to do so.
guarantees to anyone an absolute right to copy the subject matter of any expired patent."\(^2\)

It is apparent that the *Mogen David* court's conception of patent policy was radically different than that of the *Sears-Compco* Court. However, since these cases were decided on the same day, it was left for developing case law and commentators' analysis to determine whether a container configuration could be made uncopiable through trademark registration, despite the absence of patent protection. Accordingly, it is the initial purpose of this Comment to examine developing trademark law as it relates to configuration registration. Second, the effect of *Sears-Compco* upon trademark registration will be analyzed as well as the status of the apparent inconsistency between those cases and *Mogen David*. Finally, the conflict between patent policy, as stated in *Sears-Compco*, and coexistent trademark protection will be examined in order to reach a conclusion as to whether the existence of a valid, invalid, or expired design patent on a container configuration should, as a matter of law, preclude principal trademark registration.

II. HISTORY

A. Early Trademark Law

Under common law and early trademark registration statutes,\(^2\) the forms and configurations of packages and containers were not recognized as trademarks because it was believed that the number of shapes available for such items was so limited that a grant of trademark protection to the first appropriators would impose marketing hardships upon late-comers in the field.\(^2\) Thus, it is apparent that even early trademark theory was imbued with manifest concern regarding the possible commercial effects of granting trademark registration.\(^2\) Moreover, it was considered that trademark protection of physical objects would result in perpetual monopolies of those objects; therefore, the proper means by which to prevent copiers from using a distinctive shape was deemed to be patent protection, rather than common law trademark protection or registration under trademark statutes.\(^2\) Consequently, the few registrations of shapes that

\(^{23}\) Id. at 930. On rehearing, it was held that the bottle could not be registered because, as a factual matter, it could not be said that the design was non-functional or that secondary meaning had been attached to it. Judge Smith, in a concurring opinion, responded directly to the *Sears-Compco* opinions and concluded that the Court in those cases did not purport to define the boundaries between federal patent law and federal trademark law. It was Judge Smith's opinion that *Sears-Compco* only relates to state unfair competition law. *In re Mogen David Wine Corp.*, 372 F.2d 539 (C.C.P.A. 1967).

\(^{24}\) See, e.g., 21 Stat. 502 (1881); 33 Stat. 724 (1905); 41 Stat. 533 (1920).

\(^{25}\) See, e.g., Harrington v. Libby, 11 F. Cas. 605 (S.D.N.Y. 1877); Enoch Morgan's Sons' Co. v. Troxell, 89 N.Y. 292 (1884); Hoyt v. Hoyt, 143 Pa. 623, 22 A. 755 (1891).


\(^{27}\) See Enoch Morgan's Sons' Co. v. Troxell, 89 N.Y. 292 (1884); Hoyt v. Hoyt, 143 Pa. 623, 22 A. 755 (1891).
had been permitted under early statutes were declared invalid. 28 Furthermore, no registration of articles which were the subjects of expired design patents was permitted. 29 This denial of trademark recognition for configurations and other indicia not consisting of words was most unreasonable at a time when widespread use of such marks would have been extremely useful to illiterate or non-English speaking buyers who might have been benefited by relying upon product source as a basis for purchasing. 30

B. Unfair Competition Principles

Although granted only meager protection under early trademark law, the shapes and forms of containers were given some protection under the principles of unfair competition. Sometime prior to 1618 an unreported case declared that English Common Law allowed a cause of action against a defendant who passed off his wares as those of another by use of the other's trademark. 31 Subsequently, the United States Supreme Court, reviewing English and American precedent, concluded that equity should grant relief in copying cases because one man should not be permitted to offer his goods as those of another. 32 Later, in Singer Mfg. Co. v. June Mfg. Co., 33 these broad statements were somewhat restricted. In Singer, the plaintiff was denied relief from defendant's simulation because the design patent on his sewing machine had expired and the Court believed that to grant relief would, in effect, extend the patent monopoly. Hence, the copying defendant was permitted to use the design of plaintiff's sewing machine and to use the mark, "Singer." The only limitation on such use was that the Court required the copier, through labeling, to clearly identify himself as the source of the product. Subsequent application of Singer resulted in the "confusion of source" theory of unfair competition law. Under this theory, a plaintiff's relief from copying was dependent upon proof not only that the primary significance of the container's shape was to identify the producer, but also that the imitation was likely to deceive prospective purchasers with respect to the source of the goods. 34

As this theory developed, the federal courts attempted to strike a balance between the competing concepts of free use of that which is within the public domain and commercial necessity, which posited that consumers not be subjected to the liklihood of confusion resulting from

33. 163 U.S. 169 (1896).
34. See, e.g., Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938); James Heddon's Sons v. Millsite Steel & Wire Works, 128 F.2d 6 (6th Cir. 1942); Crescent Tool Co. v. Kilburn & Bishop Co., 247 F. 299 (2d Cir. 1917).
wholesale copying of trademarks.\textsuperscript{35} This balance resulted in limited protection for container designs even under unfair competition principles, and only on rare occasions did courts utilize such theories to enjoin copying of distinctive designs. Such protection was even less available when the copier used his own labels to indicate product source, or where the container design in issue had, at any time, been protected by a design patent.\textsuperscript{36} In general, relief was granted only where commercial necessity required that the product source be identified by reference to the distinctive container.\textsuperscript{37}

Although its application in distinctive design cases has been generally limited, the commercial necessity theory has occasionally supported injunctions against copying a particular form of bottle, even though the copier used his own identifying labels\textsuperscript{38} and the bottle simulated had once been protected by a design patent.\textsuperscript{39} Clearly then, although not the general rule, courts have shown concern for the producer's right to market goods in a distinctive container free from third party interference.\textsuperscript{40} However, since protection from unfair competition is exclusively within state domain\textsuperscript{41} and since \textit{Sears-Compco} declares that state law is powerless to enjoin such copying, it would appear that any protection for such containers must be sought at the federal level.\textsuperscript{42} The Lanham Act would seem to be the proper statute under which to seek such protection.

\textbf{C. Pre Sears-Compco Application of the Lanham Act}

Initially, principal registration under the Lanham Act was dependent upon whether proposed indicia fell within the trademark classifications

\begin{itemize}
\item \textsuperscript{36} See Rushmore v. Manhattan Screw & Stamping Works, 163 F. 939 (2d Cir. 1908); Yale & Towne Mfg. Co. v. Adler, 154 F. 37 (2d Cir. 1907); Enterprise Mfg. Co. v. Landers, 131 F. 240 (2d Cir. 1904); Galbally, \textit{Unfair Trade in the Simulation of Rival Goods — The Test of Commercial Necessity}, 3 Vill. L. Rev. 333 (1957).
\item \textsuperscript{37} Such relief was granted only where it could be justified by commercial necessity and the basic unfairness of defendant's appropriation of another's ideas and designs. See generally Galbally, supra note 36.
\item \textsuperscript{38} See, e.g., Tas-T-Nut v. Variety Nut & Date Co., 245 F.2d 3 (6th Cir. 1957); Charles E. Hires Co. v. Consumers Co., 100 F. 809 (7th Cir. 1900).
\item \textsuperscript{39} See, e.g., Cook & Bernheimer Co. v. Ross, 73 F. 203 (S.D.N.Y. 1896).
\item \textsuperscript{40} This concern has been even more manifest in the Ninth Circuit since passage of the Lanham Act. That circuit sees the statute as a basis for developing federal unfair competition law. See, e.g., Pagniero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952); Doran v. Sunset House Distribution Corp., 197 F. Supp. 940 (S.D. Cal. 1961), \textit{aff'd}, 304 F.2d 251 (9th Cir. 1962).
\item \textsuperscript{41} See Eric R.R. v. Tompkins, 304 U.S. 64 (1938).
\item \textsuperscript{42} Slavish imitation or "Chinese Copying" has, nevertheless, been permitted in later unfair competition cases. See, e.g., O'Day Corp. v. Talman Corp., 310 F.2d 623 (1st Cir. 1962) (defendant was permitted to copy plaintiff's boats); American Safety Table Co. v. Schreiber, 269 F.2d 255 (2d Cir. 1959) (only unnecessary confusion of source would justify injunction against copying).
\end{itemize}
enumerated in section 45 of the Act,\footnote{15 U.S.C. § 1127 (1964).} which limits such indicia to words, symbols, names or devices. Container configurations are not included in this list. Since the Act was not deemed to have altered either the early common law or prior statutory concepts of trademark law,\footnote{The limited number of configurations was deemed sufficient reason to deny registration under early law. See p. 536 supra.} shapes and forms of containers were not considered registrable.\footnote{See, e.g., Ex parte B.F. Goodrich Co., 98 U.S.P.Q. 197 (Comm'r 1953); Ex parte Minnesota Mining & Mfg. Co., 92 U.S.P.Q. 74 (Comm'r 1952). See also Lucien Lelong, Inc. v. Lenel, Inc., 181 F.2d 3 (5th Cir. 1950). Although section 23 of the Act permits registration of any configuration possessing secondary meaning, 15 U.S.C. § 1091 (1964), the comprehensive language of that section was considered limited in its application. However, occasionally it has been interpreted to allow design patent protection and registration on the Supplemental Register to co-exist. See, e.g., In re Minnesota Mining & Mfg. Co., 335 F.2d 836 (C.C.P.A. 1964); In re Pepsi-Cola Co., 120 U.S.P.Q. 468 (T.T.A.B. 1959); Ex parte Caron Corp., 100 U.S.P.Q. 356 (Comm'r 1954). See also 3 CALLMANN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES 974 (3d ed. 1969); Wehringer, Two for One: Trademarks and Design Patents, 50 T.M.R. 1158 (1960). Where the configuration resulted from mechanical processes which were the subject of patent protection, however, registration on both Principal and Supplemental Registers has been refused. See Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938); West Point Mfg. Co. v. Detroit Stamping Co., 222 F.2d 581 (6th Cir. 1955), cert. denied, 350 U.S. 840 (1955); Ex parte United States Plywood Corp., 103 U.S.P.Q. 111 (Comm'r 1954); Ex parte Jongleux & Lundquist, Inc., 101 U.S.P.Q. 77 (Comm'r 1954). Yet, even if supplemental registration is permitted to co-exist with design patent protection, such co-existence does not resolve the issue of whether design patent protection and trademark protection through principal registration conflict because there is no incon-testability feature with respect to supplemental registration. See Diaz & Rotert, supra note 29, at 34. Moreover, the main purpose of registration on the Supplemental Register is to enable the registrant to obtain protection for his design in foreign countries not affording protection through unfair competition law. See In re Pepsi-Cola Co., 120 U.S.P.Q. 468, 469 (T.T.A.B. 1959).} Since the contour of the bottle itself had, in fact, come to indicate a singleness of origin in the minds of consumers, it was sufficiently distinctive to merit registration.\footnote{See, e.g., Ex parte Robbins & Myers, Inc., 104 U.S.P.Q. 403 (Comm'r 1953); Ex parte American Erika Corp., 81 U.S.P.Q. 476 (Comm'r 1949). Moreover, some commentators contend that Pinch-Bottle was actually the registration of a slogan, rather than the registration of the container's configuration. Wehringer, supra note 45, at 1161. The importance placed on the

However, in the landmark decision of \textit{Ex Parte Haig & Haig, Ltd.},\footnote{118 U.S.P.Q. 229 (Comm'r 1958) [hereinafter referred to as \textit{Pinch-Bottle}].} the applicant was granted registration of his scotch whiskey container on the Principal Register because it was held to be a symbol or device identifying his goods and distinguishing them from the goods of others.\footnote{Id. at 230.} The container had been used as an identifying device for many years,\footnote{As early as 1912, an Illinois court had found that dealers and customers had come to identify applicant's whiskey by the "pinched decanter." See Diaz & Rotert, supra note 29, at 27. The mark, "Pinch," had been registered by applicant since 1955 (Reg. No. 608,451).} and there was no other means by which to order the whiskey without describing the "pinched" contour of the bottle.\footnote{See Diaz & Rotert, supra note 29, at 27.} Since the contour of the bottle itself had, in fact, come to indicate a singleness of origin in the minds of consumers, it was sufficiently distinctive to merit registration.\footnote{This holding would seem to settle the question whether containers are registrable on the Principal Register and, thus, bring the issue of conflict with patent law policy into sharp focus. However, the facts involved in \textit{Pinch-Bottle} were unique and the only cases leading up to it which might support its conclusion involved principal registration of slogans. See, e.g., Ex parte Robbins & Myers, Inc., 104 U.S.P.Q. 403 (Comm'r 1953); Ex parte American Erika Corp., 81 U.S.P.Q. 476 (Comm'r 1949). Moreover, some commentators contend that \textit{Pinch-Bottle} was actually the registration of a slogan, rather than the registration of the container's configuration. Wehringer, supra note 45, at 1161. The importance placed on the
registration of contours was not specifically excluded by section 2 of the Act, registration was deemed appropriate even though configurations were not specifically mentioned. This rationale was later applied in the case of In re Duro-Test Corp., in which it was held that configurations may be registered on the Principal Register because section 2(f) of the Act, permitting registration of goods distinguished from those of others, is broad enough to include distinctive configurations. Therefore, it appears settled that a producer may have a container registered under the Act if he makes a sufficiently strong showing of distinctiveness. Since container configurations are registrable on the Principal Register and also patentable, the question arises whether there is a philosophical difference between federal patent and trademark law.

III. DESIGN PATENT AND TRADEMARK RATIONALES

A. Design Patent Philosophy

The primary policies behind granting design patent protection are to promote the decorative arts and to foster inventiveness. By offering patent protection, it is hoped that a creator will be encouraged to experiment and invent as a result of the opportunity to obtain a limited monopoly in return for his efforts. It has been argued that this policy represents a quid pro quo between the creator and the public whereby the public grants a limited right to exclude copiers for a certain period of time in return for an unlimited right to copy when the exclusionary right expires. Obviously, exclusion of copiers after a patent expires would be repugnant to this theory because such exclusion would defeat the consideration running to the public. However, it is submitted that this theory is not properly descriptive of the consideration that actually runs to the public. The public's right to copy is a common law right of necessity of using the word “pinch” in order to get the whiskey would tend to support such a contention. See Derenberg, The Eleventh Year of Administration of The Lanham Trademark Act of 1946, 48 T.M.R. 1037, 1045 (1958). Thus, it could be argued that, even if there is a philosophical conflict between federal trademark and federal patent law, such conflict is de minimus because of the small number of situations in which the issue would arise. Such an argument finds support in the case of In re McIlhenny Co., 278 F.2d 953 (C.C.P.A. 1960), wherein applicant’s attempt to register his capped bottle of pepper sauce failed because it could not be said that the naked bottle in fact identified and distinguished his goods.

56. See Note, 55 T.M.R. 1032, 1033 (1965); Diaz & Rotert, supra note 29, at 33.
57. The time period is seventeen years for non-design patents and a maximum of fourteen years for design patents. 35 U.S.C. §§ 154, 173 (1964).
longstanding,9 and patent protection developed as an exception to this right.60 The power to legislate with respect to this common law exception was delegated to the federal government under Article I, Section 8 of the Constitution,61 but there is no indication that the public, through the states, also delegated to the federal government the power to otherwise affect its right to copy.62 It is difficult to see how granting the public a right which it already has may be consideration for its grant of the limited exclusionary right. Moreover, the Patent Act63 is silent on the question of a right to copy being granted by the patentee in return for the limited exclusionary right,64 and, thus, it would not appear to support such a quid pro quo theory.

Hence, it cannot be said that patent policy represents a quid pro quo with the right to copy being the public's consideration. Rather, it would seem that the actual consideration running to the public, if any, is disclosure of the inventor’s design idea. Moreover, such a disclosure of something which is exclusively the creator’s property would seem to add to the public treasury by increasing its store of ideas; whereas, a right to copy, as consideration, would appear to merely grant the public that which it already has and, therefore, add nothing to its benefit. Consequently, the quid pro quo theory positing disclosure of the design idea as the public's consideration would seem to be the more logical theory. Concededly, exclusion of copiers after patent expiration would not be totally inconsistent with this theory because the public would not be deprived of any consideration as a result thereof. However, the danger of frustrating the congressional intent to limit the exclusionary right65 still exists because of the possible indefinite nature of the protection granted through registration on the Principal Register.66 Hence, it is apparent that patent protection may conflict with trademark protection, even though the former is rooted in concepts of the creator’s property in his idea and regardless of whether the right to copy or the inventor’s disclosure is considered the quid pro quo for the patent grant.

60. Id.
62. See Kunin, supra note 59, at 744. Under the theory that the federal government was only delegated power to grant an incursion or limitation on the common law right to copy, it could be argued that state unfair competition law merely represents a balance between the following two state interests: (1) the interest in protecting against confusion of source and (2) the interest in free competition or free copying.
64. 35 U.S.C. § 154 (1964), states in pertinent part: Every patent shall contain a . . . grant to the patentee . . . for the term of seventeen years . . . of the right to exclude others from making, using, or selling the invention . . . . This language seems to support the argument that patent laws do not grant a right to copy; rather, they merely grant a right to exclude. See generally Arnold, supra note 26; Chapman, supra note 59.
65. See note 56 supra.
B. Design Patent Protection Compared With Trademark Protection

In order for a design to obtain patent protection, it must be new, original, and ornamental, and it must show inventiveness. The question whether a design patent has been infringed normally turns exclusively upon the similarity of the copy to the original. If the copy is so similar to the subject of the patent that it might be mistaken for the original, the patentee has an enforceable right to prohibit use by the copier, regardless of the fact that no use is made of the design by the patentee. Moreover, the form of use which the copier makes of the design is immaterial to the patentee's recovery.

While design patent protection exists to encourage and protect creators, inventors, and entrepreneurs, the main purpose of trademark protection is to prevent purchaser confusion as to the source of marketed goods. Since the question whether a design is registrable as a trademark turns upon whether the applicant has used it in such a way and to such an extent that it has acquired secondary meaning, the crucial inquiry is directed toward the distinctiveness of the configuration. Moreover, trademark rights can be acquired only through actual use of the configuration as a trademark with respect to specifically enumerated goods. Where a question of trademark infringement arises, the determinative issue is whether the use by a copier is such that it will result in confusion as to the source of goods with respect to which the trademark has been registered. Thus, from a comparison of the two protections it is clear that trademark protection differs from design patent protection in: (1) the basic purposes for which each is available; (2) the role that actual use plays in the initial grant of protection; and (3) in the subsequent enforcement against infringement. These basic differences result in far less extensive protection through trademark recognition than from patent protection because the former merely prohibits copying of non-functional features. In contrast, a patentee is protected against all copying, no matter what its purpose. Furthermore, even if all the fea-

68. 35 U.S.C. §§ 102, 103 (1964). See also In re Walter, 39 F.2d 724 (C.C.P.A. 1930).
69. See, e.g., Gorham Co. v. White, 814 U.S. (14 Wall.) 511 (1871).
70. See Diaz & Rotert, supra note 29, at 33.
71. See p. 540 supra.
72. See Note, supra note 56, at 1033.
74. See note 15 supra.
77. See p. 535 supra.
78. See text accompanying note 70 supra.
tures of a design could attain trademark registration, it is questionable whether an injunction against copying based on secondary meaning would provide the extensive relief found where an injunction is issued against infringement of a design patent.\textsuperscript{79}

Even though trademark protection is generally more limited than patent protection, in certain situations it may be the only effective protection available to a distinctive container because design patents, like mechanical patents, are susceptible to frequent attack.\textsuperscript{80} Moreover, the identity of a patentee as the producer of a particular product may be connected to a particular design or feature thereof, and this identification may survive the expiration or invalidity of a patent because of the distinctiveness of the design or feature. Under these circumstances, the surviving distinctive features would not seem to be related to former patent rights. Therefore, a copier's use of such features might be limited in the interest of fair competition, even though the interest in free competition embraced by the \textit{Sears-Compco} theory of patent policy would seem to dictate that no limitation be placed on such copying.\textsuperscript{81} Thus, the existence of basic differences in the two forms of protection\textsuperscript{82} and the existence of extraordinary situations in which one form of protection, being more desirable, could be attained without doing violence to the other,\textsuperscript{83} would seem to support the conclusion that federal patent policy and federal trademark law do not conflict.

\section*{C. Dysfunctional Effects of the Conflict}

Although the foregoing rationale might suggest that patent and trademark law do not conflict, there are, nevertheless, more persuasive arguments which compel the conclusion that the two necessarily conflict. In the first place, to allow trademark registration subsequent to the termination of patent protection would, in practical effect, expand the time limit placed on the patent monopoly.\textsuperscript{84} Moreover, to permit subsequent registration of a container would effectively make design patent protection a form of supplemental registration through which secondary meaning

\textsuperscript{79} See, \textit{e.g.}, \textit{Food Fair Stores, Inc. v. Food Fair, Inc.}, 177 F.2d 177 (1st Cir. 1949) (equity decrees are always open to modification if circumstances change).

\textsuperscript{80} This is indicated by the fact that sixty-one percent of the patents granted between 1948 and 1954 were subsequently held invalid by appellate courts. \textit{Hearings on S. Res. 92 Before a Subcomm. of the Senate Comm. on the Judiciary, 84th Cong., 1st Sess. 178 (1955)}.

\textsuperscript{81} \textit{See} 1 \textit{Nims, Unfair Competition and Trademarks} 390 (4th ed. 1947).

\textsuperscript{82} \textsuperscript{83} \textsuperscript{84} There is considerable authority to the effect that trademark usage cannot be utilized to expand the limited duration of design patent protection. \textit{See, \textit{e.g.}}, \textit{North British Rubber Co. v. Racine Rubber Tire Co.}, 271 F. 936 (2d Cir. 1921); \textit{Rowley v. Treisenberg}, 37 F. Supp. 90 (E.D.N.Y.), \textit{aff'd} \textit{per curiam}, 123 F.2d 844 (2d Cir. 1941); \textit{New England Lace Mills, Inc. v. American Textile Co.}, 42 U.S.P.Q. 73 (S.D.N.Y. 1939). \textit{See also} \textit{Coca-Cola Co. v. Whistle Co. of America}, 20 F.2d 955, 957 (D. Del. 1927), in which it was stated in dictum that even where product confusion resulted from use of the same container by two different parties, a design patent infringement would not be found because product confusion could not be used to expand the time limit for the patent monopoly.
could be developed without third party interference. Thus, although it can be argued that precluding the copying of a container does not inhibit free competition in the product and, therefore, permitting trademark registration presents no conflict with free competition theories which demand free copying,85 it is clear that the necessary effect of two protections for the container will be the patentee's exclusion of design competitors for a period sufficient to establish the requisite secondary meaning in the container contour and thus, obtain trademark registration under which he may exclude copiers for an indefinite period after the patent expires. Consequently, the limited time during which the patentee, by virtue of his patent, may exclude others from use of his design is extended, and secondary meaning is permitted to attach while the owner is completely insulated from competitive use by others.86 It is clear that the drafters of the Patent Act intended the patentee's right to exclude others to be limited.87 Since co-existent protections for an entrepreneur's design permits the limited duration of the patent monopoly to be extended, it would appear that the conclusion that patent law and trademark law conflict is inescapable. In light of the foregoing, an important inquiry would seem to be whether concern with this conflict has been a major consideration in trademark cases subsequent to Sears-Compco.

IV. THE EFFECT OF THE Sears-Compco RATIONALE IN SUBSEQUENT TRADEMARK CASES.

In Piel Manufacturing Co. v. George A. Rolfs Co.,88 plaintiff sought relief from defendant's simulation of his design on grounds that such copying infringed his trademark "curry-trol." It was suggested by the court that not only is the doctrine of secondary meaning of little significance after Sears-Compco,89 but that, where relief is sought on the basis of trademark infringement and the infringement allegations center mainly upon the act of copying a design rather than upon the act of copying another form of mark, trademark law conflicts with the patent and copyright clause90 of the Constitution.91 However, since the trademark involved in that case was a word rather than a design, the issue of whether

85. See Arnold, supra note 26, at 433.
86. Moreover, there may be instances in which the container is such that the only use of it that could be made is that which is made by the patentee. Under such circumstances, it is even clearer that exclusive use by him after expiration of the patent extends the patent monopoly. Not even the use of additional labels by a competitor would afford him a reasonable opportunity to make use of the configuration because they may make his product unsaleable. See, e.g., Frankfort Distilleries v. Kasko Distillers Prod. Corp., 111 F.2d 481 (C.C.P.A. 1940). Thus, it would appear that, even if secondary meaning was not developed until after patent expiration, the two protections would, nevertheless, conflict.
87. 35 U.S.C. §§ 154, 173 (1964). The patentee's ability to exclude competitors from his invention shall exist for not more than seventeen years or, if there is a design patent, fourteen years.
89. Id. at 896.
91. 233 F. Supp. at 898.
such a conflict exists was not squarely before the court; thus, leaving it free to rule that the mark “curry-trol” was too descriptive of the product and therefore, not a valid trademark.92

Although Piel recognized the problem posed by the conflict, it left the question unresolved. This strongly suggests that Mogen David is still in force. Moreover, while the bottle design involved in Mogen David was eventually denied registration on the Principal Register, the court’s ruling that the existence of a design patent on the same object did not preclude registration was not overturned. Rather, the denial of registration was based upon a finding that the bottle was not, in fact, a trademark.94 Judge Smith, in his concurring opinion, stated that the original decision on the law remained intact and that, since the Court in Sears-Compco did not purport to define the interrelationships between federal patent law and federal trademark law, the Court of Customs and Patent Appeals remained free to rule that a design was registrable, even though such design was the subject of a design patent.95 Thus, in the aftermath of Mogen David, containers were considered registrable, but there was no indication of the extent to which such registration would be permitted.

In some early dispositions the Trademark Trial and Appeal Board took the position that the Sears-Compco cases dealt only with pre-emption of state unfair competition law and that they did not deal with matter registrable under the Lanham Act.96 This attempt to distinguish Sears-Compco was followed by the Court of Customs and Patent Appeals in In re Minnesota Mining & Manufacturing Co.,97 which broadened the scope of registrability to the extent that the entire outer-contour of a product was held registrable on both the Supplemental and Principal Registers provided such contour was arbitrary, non-functional, and capable of showing origin.98 A federal district court in Kentucky has also adopted this position and held a spiral spot pattern on a sash cord to be a distinctive trademark having secondary meaning and hence, within the scope of trademark law.99 The court, distinguishing between trade dress simulation and product simulation, held the former impermissible while viewing the Sears-Compco rule as limited to the latter.100 Under this rationale, the distinctive design of a container configuration could be registered as trade dress and simulation thereof would be prohibited as dress simula-

92. Id. at 899. See also 15 U.S.C. § 1052 (1964).
95. 372 F.2d at 543 (Smith, J., concurring).
97. 335 F.2d 836 (C.C.P.A. 1964).
98. Id. at 839–40.
100. In this context, trade dress refers to that which functions only to enhance the appearance of a product and is not related to the product itself.
The broad scope of these trademark cases would appear to permit widespread registration of container configurations. Should such a trend go unharnessed, the public would be adversely affected by the potential increase in trademark registration especially since an applicant's subjective and self-serving statements may be the basis for finding a container distinctive enough to be entitled to principal registration. The ultimate result could well be that almost any outer contour would be considered a trademark and that the concept of a "mark" would become diluted and thus, no longer supportive of the theory that secondary meaning presupposes something so distinctive that any copying thereof would be done ipso facto for purposes of representing one's goods as those of another.

Fortunately, this trend has not gone completely unchecked. Rather, some cases have taken a restrictive view of the non-functionality requirement and denied registration. The landmark case adopting such a position is In re Deister Concentrator Co., in which the rhomboidal shape of the desk on an ore-shaking table was denied registration on grounds that it was a functional shape and that public policy against monopolizing functional shapes mandated rejection of the application. The leading post Sears-Compco case relying upon Deister is In re Shenango Ceramics, Inc. In Shenango the under-ribbing of applicant's china was denied registration because it was deemed too functional to be a trademark. The majority distinguished Mogen David on grounds that, although the unpatented container design involved in that case might be registrable, such registration differed from the application for registration of a functional and utilitarian product shape in that the bottle design in Mogen David appeared to be wholly arbitrary and non-functional. This propensity

101. A more recent case has gone so far as to hold that buildings are registrable as design marks. See In re Griffis of America, Inc., 157 U.S.P.Q. 592 (T.T.A.B. 1968). Furthermore, it has been ruled that the ornamental nature of a design does not preclude it from becoming a valid mark capable of distinguishment. See In re Gingher Mfg. Co., Inc., 156 U.S.P.Q. 475 (T.T.A.B. 1968).

102. This trend marks a fundamental departure from the more conservative position taken by patent office tribunals. See, e.g., American-Marietta Co. v. Krigsman, 275 F.2d 287 (2d Cir. 1960); Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569 (2d Cir. 1959), cert. denied, 362 U.S. 919 (1960); Speedry Prods., Inc. v. Dr. Mark Prods., Inc., 271 F.2d 646 (2d Cir. 1959).

103. 15 U.S.C. § 1051(a)(1) (1964), provides that the applicant shall supply the necessary verification with regard to the mark's use. Thus, trademark recognition is dependent upon information supplied by the owner which could well be self-serving.


105. 289 F.2d 496 (C.C.P.A. 1961).

106. Judge Rich attempted to draw a distinction between cases involving merely aesthetic features which are so arbitrary that no harm would result from monopolization and the Deister case involving features which are functional enough that some harm would result. 289 F.2d at 504-06. However, this distinction would seem to be an insufficient answer to the inherent conflict with patent law extant in the Mogen David and Pinch-Bottle cases since patent law fails to make the same distinctions between aesthetic and functional designs. See 35 U.S.C. § 171 (1958).


108. Id. at 292. In the Trademark Trial and Appeal Board decision, a concurring member argued that product shapes should be unregistrable as a matter of law, regardless of questions of functionality. In re Shenango Ceramics, Inc., 143 U.S.P.Q. 48, 52 (T.T.A.B. 1964).
toward construing registrability as a factual question turning upon whether the contour was functional, arbitrary, or distinctive and whether secondary meaning had been acquired has been followed in the recent case of In re Tri-X-Corp.,\(^{109}\) in which principal registration was denied on grounds that the configuration involved did not primarily indicate origin, but rather indicated that its prime purpose was functional.\(^{110}\)

It is apparent that trademark tribunals have been reluctant to overturn earlier statements that configurations are not per se unregistrable.\(^{111}\) By denying registration on factual grounds, they have avoided the issue of whether patent protection precludes trademark registration. Thus, it can be concluded that the statement of patent policy promulgated in Sears-Compo has not caused a significant upheaval in trademark law. The failure to confront these issues is most unfortunate because the continuing opportunity for protection through registration on the Principal Register where a design patent has not yet been obtained, could induce entrepreneurs, faced with the increased possibility of securing no protection under state unfair competition laws, to indiscriminately seek federal trademark registration.\(^{112}\) The potential increase in applications could cause the dilution of secondary meaning concepts. Such a dilution would decrease the value of trademarks as indicators of product source.\(^{113}\) It is clear that this unfortunate result would not only frustrate the very purpose for granting trademark protection,\(^{114}\) but also would exacerbate the conflict between patent policy and trademark law. Under these circumstances, the question arises whether these factors, along with elements relating to the public good, mandate a conclusion that container designs which have been the subject of valid, invalid, or expired design patents should be denied trademark protection as a matter of law.

V. SHOULD PATENT PROTECTION PRECLUDE TRADEMARK REGISTRATION?

Even though trademark tribunals have been reluctant to declare that unpatented container configurations are unprotectible through trademark registration,\(^{115}\) it is submitted that, since the necessary effect of co-existent protection is extension of the patent monopoly,\(^{116}\) only an overriding consumer interest in preserving the possibility of a container obtaining both protections would justify a conclusion that patent policy should not

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110. Apparently, a greater showing of distinctiveness would have caused registration to be allowed. See also In re G. Leblanc Corp., 155 U.S.P.Q. 603 (T.T.A.B. 1967); In re Chas. O. Larson Co., 155 U.S.P.Q. 750 (T.T.A.B. 1967).
111. See pp. 545-47 supra.
112. U.S. TRADEMARK ASSOCIATION, YEAR END REPORT (1964) indicates that, during 1964, a record number of trademark applications were made, and a record number were allowed. See also Denenberg, The Eighteenth Year of Administration of the Lanham Trademark Act of 1946, 55 T.M.R. 609 (1965).
113. See p. 542 supra.
114. Id.
115. See pp. 545-47 supra.
116. See pp. 543-44 supra.
preclude principal trademark registration when the configuration in issue has been granted a design patent. Despite their distaste for unscrupulous simulation by a competitor, courts have long recognized that, in general, greater consumer interests are served if free copying is permitted and free competition preserved.\textsuperscript{117} Permitting such free competition in container designs which are not protected by existing patents would prevent producers from charging a premium price based upon new designs which draw buyers merely because they are attractive.\textsuperscript{118} In addition, the producer will shoulder the burden of convincing prospective purchasers that his product, without more, is of such a quality that it should be purchased at the price for which it is available.\textsuperscript{119} The desirable result of such a policy is that competition will be focused upon actual product quality thus, minimizing the subtle effects that unique container configurations can have on consumer choice.\textsuperscript{120} On the other hand, it should be acknowledged that product differentiation is essential to free competition, and it would seem that distinction among competitors is necessary for such differentiation. Therefore, it may be argued that container designs which become the means by which consumers distinguish between competitors should be protected in order that product differentiation be preserved.\textsuperscript{121} However, the use of adequate labels or non-contour trademarks would suffice to insure that the public is able to distinguish one competitor from another. Therefore, to the extent that competitor identity is necessary in product differentiation, such can be accomplished without granting originators of unpatented container designs the right to indefinitely exclude copiers through registration as principal register trademarks.\textsuperscript{122} Moreover, nothing bars the owner of the configuration from seeking a patent. In short, the arguments against free copying of container designs are not persuasive, and it would appear that the greater public good created through free competition would be best assured by uniformly adhering to the policy of free copying announced in \textit{Sears-Compco}. Furthermore, such a result is consistent with the intent of the founders of trademark law who were concerned with protecting the public from


\textsuperscript{119} Id. at 959.

\textsuperscript{120} See generally V. Packard, \textit{The Hidden Persuaders} (1957).

\textsuperscript{121} See Treece, \textit{Copying Methods of Product Differentiation: Fair or Unfair Competition}, 38 Notre Dame Law. 244, 247 (1963).

\textsuperscript{122} Although it could be argued that such a rule overlooks the possibility of post-sale confusion as to source caused when labels or non-contour trademarks are removed or obliterated, it appears to be well settled that the principles protecting against confusion as to source seek to do so at the \textit{time of sale}, not later. See Urey, \textit{supra} note 117, at 959-60.
dubious commercial practices. Since co-existing protections can result in the deceptive business practice of attracting buyers by reference to mere container attractiveness or producer identity, rather than by reference to product quality, it is submitted that the benefit which results to the public from a policy of free copying mandates a conclusion that container contours should be unregistrable as a matter of law, regardless of the degree of distinctiveness they have acquired. Moreover, there is some indication that such a per se rule of unregistrability has been considered by some tribunals.

The only case that has squarely confronted the inherent conflict between registration on the Principal Register and patent protection is In re International Playtex Corp. In this case, the Trademark Trial and Appeal Board ruled that the petitioner's cylindrical girdle container could not be registered on the Principal Register, despite proof that de facto secondary meaning had been established. The Board reasoned that, since such common forms are available to manufacturers generally and since the public has a right to copy them in the absence of a patent, it should not vest the exclusive right to use them in any one producer. In so ruling the court relied upon In re Pollak Steel Co., in which it was stated that the policy denying registration to that which the public has a right to copy in the absence of patent protection is a fundamental principle of the law of trademark ownership which transcends the provisions of the Lanham Act. Under this rationale, the provisions of the Act permitting registration of distinctive container designs would be subservient to a more fundamental principle, and no amount of distinctiveness or secondary meaning would suffice to permit registration.

It is submitted that proper application of patent policy, as stated in Sears-Corning, requires widespread application of the Playtex-Pollak rationale with the result that principal trademark registration for container designs be denied as a matter of law.

It may be argued that adoption of such a per se rule of unregistrability for container configurations might put trademark tribunals in a

122. Trademark law has its roots in basic commercial concepts. See Arnold, supra note 26, at 430. Some have seen the Lanham Act as creating federal jurisdiction over a branch of unfair competition law. Smith, supra note 58. Moreover, in James Heddons' Sons v. Millsite Steel & Wire Works, Inc., 128 F.2d 6, 9 (6th Cir.), cert. denied, 317 U.S. 674 (1942), it is stated that:

It is . . . fundamental . . . that one man has no right . . . to use . . . indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another . . . .

Thus, it is apparent that a primary concern of the Lanham Act is predatory business practices.

123. Id. at 746-47. Member Leffkowitz dissented, arguing that registrability was a factual matter and that the container should not have been precluded from registration as a matter of law. Id. at 747. 124. 15 U.S.P.Q. 745 (T.T.A.B. 1967).

125. Id. at 746-47. Member Leffkowitz dissented, arguing that registrability was a factual matter and that the container should not have been precluded from registration as a matter of law. Id. at 747.


127. Id. at 567.


quandary with respect to container contours already registered on the Principal Register. However, notwithstanding infringement actions, the problem would be de minimus since when renewal is sought the Board could deny it in deference to the fundamental principle that the public has a right to freely copy unpatented designs. Moreover, even in an action for infringement application of the per se rule of unregistrability would not seem to present an insurmountable problem. It is submitted that courts would have two alternatives in such a situation. First, the rule of unregistrability could be applied retroactively thus, rendering the trademark invalid. However, such retroactive application may be deemed unduly harsh on the owners of contour marks. This harshness could be avoided while still maintaining appropriate application of the rule by placing the burden upon the owner of the mark to show both continued secondary meaning and indistinguishable use by a competitor. The result of this second approach would be to deny the presumptive validity of the mark. Thus, the court would be free to rule the mark invalid, while at the same time the owner thereof would have an opportunity to continue his protection for the full length of the initial grant. It seems clear, therefore, that the door left open by the *Mogen David* approach should be closed and that container contours should be exclusively protected by patents.

**VI. Conclusion**

Even though there are strong arguments supporting the propositions that: (1) patent policy does not include a right to copy; and (2) patent protection and trademark protection have different bases and applications, they are not conclusive as to whether there is an inherent conflict between the two. Rather, the fact that the necessary practical effect of granting trademark protection in the presence of a valid, invalid, or expired patent is to extend the limited duration of the patent law exclusionary right requires a conclusion that there is an inherent conflict between the two branches of law. Although this conflict, to date, has had only minimal effect in the area of principal trademark registration, there have been some indications that it may result in a rule that container designs are per se unregistrable. If such a rule should emerge, even fewer contours will be protected than have been in the past. It is submitted that this would be the preferable approach because: (1) the possibility of vastly increased registrations and the attendant dilution of the “mark” concept will be avoided; and (2) the greater public good resulting from a policy of free copying will be more effectively realized.

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130. *See, e.g.*, Kingsway, Inc. v. Werner, 233 F. Supp. 102 (E.D. Mo. 1964), which was an infringement action wherein the owner of the Principal Register mark, "flourentine," for chessmen was required to show that it had a continued secondary meaning. He failed to do so, and the mark was declared invalid; as a result, defendant's copying was permitted, even though his chessmen were indistinguishable and even though the plaintiff was admittedly the first to use the design and mark.

131. *See* p. 547 *supra*.

132. *See* pp. 547–49 *supra*.