THE CONVERGENCE OF PRODUCT DESIGNS AT THE CORNER OF TRADE DRESS LAW & PATENT LAW

By William E. Levin

Because the theme this month is convergence, the intersection of patent law and trade dress law is an interesting one. These two separate and discrete areas of intellectual property law both converge upon, from entirely different directions, and meet at, the arena of protecting product designs. Product designs may legally be protected by a patent, or trade dress, or, at times, both forms of intellectual property rights. These two types of law may overlap and be consistent with each other, or they may conflict and create unacceptable tension. In any case, the design of a product is the point of convergence.

First of all, what is trade dress? Trade dress may be defined as the look and feel of a product or a service. Trade dress particularly includes packaging and product designs or product configurations. For example, the shape of the classic Coke bottle is protectable trade dress. The distinctive appearance of a Coke can, is also trade dress. The well-known Martinelli's apple juice bottle appearance has been federally registered in the United States Patent and Trademark Office ("PTO") as trade dress. The design and appearance of an unusual high-end garden cart has been protected by an injunction against copying. A box or a bottle or other containers have been protected.

Examples of trade dress of the product design type include the design of a Sunbeam household blender, the shape and appearance of a computer such as the new I Mac's from Apple, the design of the Vornado fan, the distinctive design of new lighting fixtures, the design of a Ferrari car or even a Volkswagen (old or new versions), and virtually an unlimited number of products out there in the marketplace. Trade dress extends to the design of an Internet web site.

So broad is the trade dress concept that the courts, and the PTO have construed trade dress to include the shape of a distinctive building, such as the Rock and Roll Hall of Fame; a particular scent or smell for a product or service business; a sound or series of sounds, such as the familiar roar of the MGM lion; a single color, such as pink fiberglass insulation or the green-gold color of a dry cleaning press pad; the exterior and interior decor of a restaurant; the series of letters and related materials used by a car-service reminder business; the lines and colors of a major airline's plane; the uniforms worn by sports groups or cheerleaders; the appearance of a computer screen's; a particular musical style of an entertainment group; the distinctive look of an entire product line, such as furniture or greeting cards; and a host of other mundane or also spectacular goods or services in many different industries.

Trade dress law protects against copying of trade dress, such as a knock-off of a competitor's product. To be protected, the trade dress must be distinctive, either as originally made, or it must have become distinctive in the market over a period of time. It also cannot be functional, which itself is another legal can of worms that implicates patent law in various ways. Thus, almost all product designs serve a functional purpose, but that does not mean they are functional under the specialized meaning of that term in trade dress law. Basically, functionality in trade dress law means that competitors must be able to use the same design in order to effectively compete, and could not do so using an alternative design. Patent law, on the other hand, will preclude competition, for a limited time, if a product is utilitarian and meets the other stringent elements for a patent to issue. Confused? Well, for trade dress protection, but not patent protection, confusion of source or sponsorship is the core legal element for an infringement.

Trade dress protection can last forever, just like any other form of trademark protection, as long as the protect or service is being marketed. However, there are limits to trade dress protection, and some of the most perplexing limitations arise from the convergence of trade dress law and patent law, particularly for product designs.

Patent law protects inventions, including a new product design if the standards for obtaining a patent are met. A design patent will protect the appearance of a product design if it is "new" and "non-obvious." If the product also has new useful features, it may be protected by a utility design.

Patents, unlike trade dress, are a legal monopoly, and can exclude competitors from selling the same product design even if they independently created it, did not copy it from another company, and had never seen a similar design. Because the patent monopoly is so powerful, it is limited by the time period it is allowed to remain in effect, to a relatively few short years, not more than two decades. Thus, if the design of the Coke bottle were originally patented, that patent expired many years ago, but the trade dress protection lives on to the present day.

Some courts have refused to product a product design under trade dress law if the design in question is already covered (or, as it is called, "claimed") by a patent, or if the design is sufficiently disclosed in the patent or its drawings. The primary basis is that there is a competing interest of competitors to be able to copy product designs which are not protected by either a patent or a copyright, in order to encourage competition, innovation, and free enterprise. Society encourages new inventions and new ideas, and affording unlimited protection to one, may preclude or discourage others from improving upon it. For example, if a patent for the first mousetrap never expired, and it covered any kind of possible mousetrap, no one might ever bother to improve the original mousetrap. Courts do not want trade dress to become a patent-like monopoly that does not meet the rigorous standards for patent protection.

On the other hand, there are judges who feel that trade dress is a totally different type of protection than a patent, with the result that protecting a product design under both does not conflict. Trade dress law, like protection of any trademark, has the requirement that the consuming public will be confused or misled as to the source of the product design, or as to the affiliation between two different companies or their respective product designs, if two different competitors product a similar looking design. For example, if consumers seeing the familiar Coke bottle would think that a similar bottle, even if branded with a different trademark (say, Genesis), might think that the Coca-Cola Company had licensed the Genesis Company to product that bottle, or that Genesis was a subsidiary of Coca-Cola, or even that Coca-Cola was actually the manufacturer.

Product designs represent a convoluted area of trade dress law, and judges and lawyers have struggled, particularly during the last several decades, with the relationship between trade dress and patent protection for the same product design. That struggle continues, and undoubtedly will for a long time. In its most recent ruling on product design issues, the U.S. Supreme Court decided that product design will continue to be protected trade dress, but increased the legal barriers to achieve such protection.

Now, at least in the U.S., a product design can never be protected as trade dress when it is first made. Only after the product design has, through advertising, sales, marketing, publicity, and similar promotion of the trade dress, actually become associated by its customers with a particular single source (called secondary meaning), will the design be protected. This requirement may make it difficult to protect a product design as trade dress if competitors copy it when the design is first produced.