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What's the Frequency, Kenneth?¹ Channeling Doctrines in Trademark Law

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Trademark law appears to be concerned with something entirely different than copyright and patent laws. And at least in terms of the subject matter of protection, that used to be a fair conclusion. Courts traditionally protected trademarks solely for the purpose of preventing one producer from passing off its products as those of another, while copyright and patent laws protected creative works and useful inventions for the purpose of encouraging their development and dissemination. Thus, at risk of oversimplification, trademark law focused on word marks and labels, leaving copyright and patent laws to protect the underlying products or services with which those marks or labels were used.

But that generalization no longer suffices. The normative goals of trademark law have expanded beyond passing off, and producers have sought to protect with trademark law a variety of product designs and creative content formerly protected by patent and copyright. Modern trademark law applies not only to word marks and logos but allows "anything at all that is capable of carrying meaning" to serve as a trademark.² There is reason for concern here in that American law has long recognized patent and copyright protection as exceptions to a general freedom to copy that is integral to free economic competition.³

In fact, precisely because they are departures from the freedom to copy, copyright and patent laws impose restrictions on scope and duration that trademark law does not. Patent law, for example, confers relatively strong rights,⁴ but those seeking patent rights face, at least in theory, much more exacting review than those who seek trademark protection. Specifically, the inventor must demonstrate that her invention is new, useful, and nonobvious, and she must disclose the invention with enough detail that others with ordinary skill in the relevant art can practice the invention.⁵ Those seeking design patent protection, which is available for purely ornamental features of industrial designs,⁶ likewise must demonstrate that the claimed features are new and original.⁷ Patent rights also have a limited lifespan, generally lasting only twenty years from the date of a

patent application for utility patents and only fourteen years from the date of the grant for design patents.⁸

Copyright protection attaches more easily and lasts much longer—for the life of the author plus seventy years or, in the case of anonymous or pseudonymous works and works made for hire, for ninety-five years from the date of first publication or 120 years from the year of its creation, whichever expires first.⁹ Yet copyright offers a weaker form of protection than patent law. Copyright gives the author the exclusive right to reproduce, distribute, publicly display or perform, and make derivative works from the copyrighted work.¹⁰ It does not, however, prevent others from using the ideas embodied in a particular work, and it allows for a variety of “fair uses” of the copyrighted expression.¹¹

Trademark law lacks many of the requirements and limitations of copyright and patent laws. Most significantly, in direct contrast to patent and copyright and their expressly limited duration,¹² trademark rights can last indefinitely, as long as the mark continues to signify source.¹³ Trademarks need not be new, useful or nonobvious, nor must they be creative.¹⁴ Their use is subject to different, and generally more limited, fair use defenses.¹⁵ Thus, to the extent trademark law can be used merely as a substitute form of protection for subject matter ordinarily protected by copyright or patent law, owners can evade many of the restrictions of those statutory schemes.

Because substitution of trademark protection in such situations could undermine the balance those systems seek to strike between encouraging creation and dissemination and the freedom to copy, courts have developed doctrines to limit trademark protection when there is risk of interference with copyright or patent law. These doctrines seek to channel protection for certain types of subject matter into particular intellectual property regimes, reflecting Judge Calabresi's view that “intellectual property owners should not be permitted to recategorize one form of intellectual property as another.”¹⁶

This chapter describes several of these channeling doctrines and the contexts in which they operate. It also suggests that, in focusing so much on the subject matter of protection, courts and commentators have missed an important sense in which the various modes of intellectual property protection overlap. Even when copyright and patent laws are applied to different features than trademark law, the ability of parties to benefit from multiple forms of protection for singular commercial products leaves open the possibility of significant overlap in terms of the economic consequences of protection. When courts and policy makers fail to recognize, for example, the ways in which branding allows companies to capture many of the same benefits copyright and patent laws are presumed necessary to achieve, they are likely to calibrate the level of protection incorrectly.

TRADE DRESS AND THE TRADEMARK/PATENT INTERFACE

Courts that have expressed concerns about overlapping patent and trademark rights have focused primarily on the protection of product packaging and design,

which are collectively referred to as "trade dress." Protection for trade dress traditionally was limited to the overall appearance of labels, containers, and wrappings used to package a product as well as displays and other materials used in presenting the product to prospective purchasers.¹⁷ Trade dress law has since expanded, however, to include the overall image or totality of elements in which a product or service is packaged or presented.¹⁸ Most controversially, courts have allowed trade dress protection of the shape and design of a product itself,¹⁹ as long as the claimed features have source significance.²⁰ Here there is clear potential for conflict since many of a product's design features also could be the subject of patent protection.

Trademark law naturally avoids this conflict to some extent because trademark law does not apply in all of the circumstances that might be covered by patent law. In order to prevent another party's use of particular features, the plaintiff must demonstrate that it has used the claimed features in commerce, that the features indicate source, and that the defendant is using features that are likely to confuse consumers as to the source of its products. To determine whether an accused design infringes a design patent, by contrast, courts compare the designs at issue under two distinct tests, both of which must be satisfied in order to find infringement: (a) the "ordinary observer" test and (b) the "point of novelty test."²¹ Under the "ordinary observer" test,

if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other."²²

This test resembles the test for trademark infringement in that it speaks in terms of consumer deception, but it is both narrower and broader. It is narrower in the sense that it requires greater similarity between the features at issue than does trademark law, finding infringing only designs so similar that a consumer would "purchase one supposing it to be the other." It is also broader in that the similarity need not relate to features that indicate source.

The "point of novelty" test also differentiates design patent protection. That test requires proof that the accused design appropriates the novelty which distinguishes the patented design from the prior art.²³ The points of novelty, however, need not indicate source. Moreover, trademark law does not require that actionable consumer confusion derive from copying of any particular elements. Thus, trade dress protection for design features is not coextensive with potential design patent protection. As the U.S. Court of Appeals for the Seventh Circuit has said

Federal trademark protection does not transform the durationally limited monopoly of a design patent into a perpetual right. . . . [The registrant] simply has the right to preclude others from copying its trademarked product *for the purpose of confusing the public as to its source*. [A competitor] is free to copy [the registrant's] design so long as it insures that the public is not thereby deceived or confused into believing that its copy is a [registrant's] faucet.²⁴

Trade Dress Distinctiveness

Much of the differentiation between trademark and design patent protection, however, depends on courts' ability to determine effectively which product design features indicate source. In the context of word marks, courts interrogate the relationship between a term and the products or services with which it is used in order to evaluate its distinctiveness. To do so, a court determines the meaning of the term at issue and considers the extent to which the term conveys information about the product or service with which it is used.

The court then places the claimed mark in one of four categories, in ascending order of distinctiveness: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.²⁵ A term that conveys no information about the product (an arbitrary or fanciful term),²⁶ or that is only suggestive of a product's features or characteristics, is considered inherently distinctive. Such a term is entitled to protection without further evidence because by its intrinsic nature it identifies the particular source of a product.²⁷ A descriptive term, one that describes a product or its features, is not inherently distinctive, but it may become distinctive if it acquires "secondary meaning."²⁸ "Secondary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a particular kind of good, service or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous, entity."²⁹ A generic term can never serve as a trademark because it is the generally recognized name of a product or service (car, for example) and therefore does not signify a particular source.³⁰

This approach works well with word marks because words have generally recognized meanings and it is relatively easy for courts to determine whether those meanings relate to the products or services with which they are used. But the framework is awkward in the context of trade dress because most product packaging and design features have no generally understood meaning.

Consequently, courts have developed a couple of additional considerations in trade dress cases. First, the Supreme Court has distinguished between product design and product packaging and declared that, with respect to product design features, parties may not rely on presumptions of source significance but must demonstrate it by providing evidence of secondary meaning. Second, courts have long held, and the Lanham Act now explicitly states, that functional product features, even those with source significance, are ineligible for trademark protection.³¹

Inherently Distinctive Trade Dress Does Not Require Proof of Secondary Meaning

In *Two Pesos, Inc., v. Taco Cabana, Inc.*,³² the Supreme Court resolved a circuit split on the question whether inherently distinctive trade dress is protectable under section 43(a) of the Lanham Act without a showing that it has acquired secondary meaning. In that case, the jury had found that Taco

Cabana's eating atmosphere was inherently distinctive but lacked secondary meaning, a finding the Fifth Circuit believed disqualified Taco Cabana's trade dress from protection. The Supreme Court held the absence of evidence of secondary meaning irrelevant, however, when the trade dress is inherently distinctive.³³

The Court noted that there was no indication in the Lanham Act that trade dress should be treated differently from other trademarks, and with respect to other marks "the general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive or (2) it has acquired distinctiveness through secondary meaning."³⁴ Additionally, the court suggested that "[d]enying protection for inherently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator's dress in other markets and to deter the originator from expanding into and competing in those areas."³⁵

Though the Supreme Court believed it was merely creating symmetry between trade dress and trademark law, the *Two Pesos* decision actually was something of a departure from traditional practice. Some appellate courts had been requiring that trade dress features be inherently distinctive *and* have acquired secondary meaning to be protectable. Those courts probably were drawing on the practice of courts prior to passage of the Lanham Act, when, in order to receive trade dress protection, the plaintiff needed to prove both "(1) recognition—that consumers believed that certain features came from a certain source; and (2) materiality—that the identification of source mattered to consumers."³⁶ Thus, the Supreme Court in *Two Pesos* either created broader protection for trade dress than had traditionally been afforded or recognized that the Lanham Act did so without explicitly mentioning trade dress.

Product Design Is Not Capable of Being Inherently Distinctive

Because the lower court in *Two Pesos* had found Taco Cabana's trade dress inherently distinctive, a finding *Two Pesos* did not contest, the Supreme Court never addressed in that case the question of what types of trade dress could be deemed inherently distinctive. It addressed that question squarely in *Wal-Mart Stores Inc. v. Samara Brothers, Inc.*³⁷

In *Wal-Mart*, Samara Brothers designed and manufactured children's clothing and sold it to various retailers.³⁸ Most of the outfits were seersucker cloth with heart and flower decals, and some of the elements of the clothing were copyrighted.³⁹ Wal-Mart approached a manufacturer and instructed it to copy Samara's clothing, which it did with only minor modifications.⁴⁰ Samara brought an action against Wal-Mart for, among other claims, infringement of unregistered trade dress under section 43(a) of the Lanham Act.⁴¹

Writing for the majority, Justice Scalia began his decision by distinguishing between two types of trade dress: product packaging and product design. Consumers are accustomed to seeing product packaging as an indication of source,

Scalia believed, and they use packaging in their searches for the products they desire. But, according to Justice Scalia, consumers generally do not view product designs as indications of source.⁴² Even the most unusual product design, such as a cocktail shaker shaped like a penguin, is not intended primarily to identify the source, but rather to make the product more useful or more appealing.⁴³

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.⁴⁴

Consequently, although inherently distinctive trade dress features are protectable without evidence of secondary meaning, product design is incapable of being considered inherently distinctive. For product design features to receive trade dress protection, a party must demonstrate that the claimed features have acquired secondary meaning.⁴⁵

Given the dichotomy of treatment for product packaging and product design, proper categorization of particular features is critical. But that categorization also is often difficult. While some features are obviously product packaging, in many cases attractive packaging could be considered a product in itself. Coca-Cola bottles, for example, originally serve as packaging for soft drink products, but those bottles have become collectors items bought and sold as products.⁴⁶ Nevertheless, the Court concluded that the frequency and difficulty of having to distinguish between product design and product packaging would be less than the frequency and the difficulty of having to decide when a product design is inherently distinctive.⁴⁷

Moreover, to help resolve these close cases the Court instructed courts to "err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning."⁴⁸ Thus, to the extent categorization of Coca-Cola bottles is difficult, the burden is on the party seeking protection to demonstrate secondary meaning. This presumption reflects a belief that the potential harm of overprotecting is greater than the cost of requiring evidence of secondary meaning, particularly since a producer has alternative protection mechanisms available to her—design patent and/or copyright protection.⁴⁹

Functional Product Features Are Not Protectable

The most explicit recognition of trademark law's potential to interfere with the policies of patent law is the rule that functional product features—even ones with source significance—cannot be protected by trademark law. If a product's functional features could be protected by trademark law, the creator could

potentially enjoy perpetual rights to those features because trademarks can be renewed indefinitely as long as they are used as source indicators.⁵⁰ But "[t]he Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity."⁵¹

Courts generally have recognized two types of functionality: mechanical and aesthetic functionality. Mechanically functional features are product features that are "essential to the use or purpose of the article or . . . [affect] the cost or quality of the article."⁵² Features also may be deemed aesthetically functional "when aesthetic considerations play an important role in the purchasing decisions of prospective consumers," and a particular design feature "substantially contributes to the aesthetic appeal of a product."⁵³ For example, one court found the color green for farm equipment was functional based upon evidence that farmers preferred their farm equipment to be in matching colors.⁵⁴

A party seeking protection of unregistered trade dress has the burden of proving that the claimed features are not functional.⁵⁵ Registration carries a presumption of nonfunctionality, but functionality remains a valid affirmative defense that survives incontestability and can be raised at any time. These rules "give[] force to the well-established rule that trade dress protection may not be claimed for product features that are functional."⁵⁶

Moreover, the Supreme Court has adopted a relatively broad definition of functionality, at least as far as mechanical functionality is concerned. After the Supreme Court's decision in *Qualitex*, a case in which the Court considered the protectability of color standing alone, a number of appellate courts had required, in all cases where functionality was at issue, evidence that the particular product configuration was a competitive necessity.⁵⁷ Those courts were reacting to the Court's language in *Qualitex* defining a product feature as functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article"⁵⁸ and if "exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage."⁵⁹

In *Traffix*, however, the Supreme Court specifically rejected the notion that competitive necessity was the lynchpin of functionality. Instead, functionality serves a channeling function, disqualifying from trademark protection useful features that should be protected by patent law. Thus, according to the Court, in cases of mechanical functionality, a feature is functional "when it is essential to the use or purpose of the device,"⁶⁰ whether or not that feature is competitively necessary. Competitive need, then, is relevant only in cases of aesthetic functionality.⁶¹

Moreover, though the Court in *Traffix* rejected the defendant's suggestion that features of products formerly subject to patent protection be barred from trade dress protection categorically, it held that expired utility patents have vital significance in the mechanical functionality determination. A utility patent is "strong evidence of functionality" and "adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party

seeking trade dress protection."⁶² Thus, in cases where there is an expired patent, the party seeking trade dress protection has a "heavy burden" to establish that the claimed feature is purely ornamental or incidental and not functional.⁶³

THE TRADEMARK/COPYRIGHT INTERFACE

Courts have only more recently begun to express concern about trademark law trenching on copyright law, perhaps because copyright provides a weaker form of protection than patent law, and perhaps because trademark and copyright laws have long coexisted in some contexts. For example, a picture of a character like Mickey Mouse is copyrightable as a pictorial work and may also be used as a mark to identify the source of particular goods or services.⁶⁴ Trademark and copyright laws also have worked in complementary fashion with respect to literary works. "Copyright law might give protection to the tangible expression of the work, but copyright law does not protect the literary title alone. However, the title of a series of literary works may function as a trademark and may be registered and protected as such."⁶⁵

But trademark and copyright laws may conflict when a party seeks to use trademark law to protect creative content as such. This conflict, as with the conflict between trademark and patent law, is mediated to some extent by the nature of the rights trademark law provides. Indeed it is the nature of trademark rights that has allowed them to coexist with copyright protection. Trademark rights are infringed only when one uses the mark in a manner likely to confuse consumers about the source of the material or the creator's sponsorship of or affiliation with the junior user. Under this test, reproducing Mickey Mouse does not, in and of itself, necessarily constitute trademark infringement, even though it would constitute copyright infringement. In some cases, however, this natural limitation on trademark rights is not sufficient to prevent a conflict between the two bodies of law.

Bodily Appropriation and False Designation of Origin

Authors have, for example, sometimes asserted unfair competition claims against parties who have used or distorted the author's creative material. In those cases, the author has complained that another party has partially or completely copied the author's expression and presented it as though the author's work was her own. This "reverse passing off" allegedly constituted a misrepresentation as to the source of the creative work—a "false designation of origin" under section 43(a) of the Lanham Act.⁶⁶

Before the Supreme Court decision of *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁶⁷ some courts allowed these types of reverse passing off claims without requiring a showing of consumer confusion, thereby creating a significant overlap between copyright and trademark law.⁶⁸ Twentieth Century Fox relied

on those cases when it complained that Dastar had copied substantially all of the *Crusade in Europe* television series created by Twentieth Century Fox (which had fallen into the public domain due to failure to renew a copyright) and labeled the product with its own name and marketed it without attribution to Fox.⁶⁹ The Ninth Circuit, affirming the district court, ruled that Dastar had committed a "bodily appropriation" of Fox's series.⁷⁰ This "bodily appropriation" of the original series was sufficient to establish reverse passing off, and no showing of confusion was needed because, according to the Ninth Circuit, the bodily appropriation test included the "less demanding 'consumer confusion' standard."⁷¹

The Supreme Court reversed in a decision that turned in large part on the meaning of "origin" as used in the "false designation of origin" language of section 43(a). There was no dispute in the case that Dastar was the source of the physical video cassettes it distributed. Thus, for Dastar's designation of the origin of its product to have been even arguably false, the "product" at issue must have been something else. Twentieth Century Fox argued that, for a communicative product such as a television series, "origin of goods" should be construed to include not only the producer of the physical item but also the creator of the content the physical item conveys.⁷²

The Supreme Court rejected that interpretation, believing it would be too difficult to determine who deserved credit as the origin of creative content, considering the many ways copyright rights can be assigned and transferred. According to Justice Scalia, the Lanham Act does not require such a "search for the source of the Nile and all its tributaries."⁷³ "Source" as it is used in the Lanham Act refers only to the source of the physical goods.

This construction of "origin" has justly been criticized as somewhat tortured.⁷⁴ Many of the products we consume are not actually produced by the entity with which we associate them, but that fact has not mattered in trademark law for some time. "Source" and "origin" in modern trademark law do not refer to an actual historical or physical source but to the entity consumers believe stands behind the quality of a particular product or service.⁷⁵ In other words, modern trademark law asks only whether some entity assures that the claimed mark is applied to products or services of reasonably consistent quality, whoever the actual producer of that product happens to be. That is the reason why trademark licensing has been accepted even though the true physical sources of licensed products often are unknown to consumers and related to the mark owners only through contract.

The Court's interpretation in *Dastar* flouts not only this legal reality, but also commercial reality. In many cases, consumers of creative content care much more about the identity of the content creator than the producer of the physical item. When we look for movies at Blockbuster, we search by title, not according to who manufactured the videotapes or DVDs on which the movies are stored.

The Supreme Court recognized this to some extent when it conceded that, with respect to communicative products, it may make more sense to interpret "origin of goods" in section 43(a) to include "not merely the producer of the

physical item [the publisher or video producer] but also the creator of the content that the physical item conveys [the author]."⁷⁶ Yet considering the content creator the "source" of the goods and allowing it to assert claims under section 43(a) would create a conflict with copyright law.

As the *Dastar* court described it, one who wants to use public domain content, as she is entitled to do under copyright law, faces a dilemma. On the one hand, if she copies the public domain work and does not give credit to the creator of the work on which her lawful copies were based, she faces a reverse passing off claim for attempting to pass off another's "product" as her own. On the other hand, if she copies the work and attributes it to the original creator, she could face liability for implying the creator's sponsorship or approval of the copy.⁷⁷

The bind is less severe in cases where the copyist republishes the original work in whole or in substantial part, as claims based on truthful use of an author's name in connection with public domain material have tended to fail in the past. But the copyist faces a more difficult decision when she copies part of a work but modifies it substantially. That was the situation in *Gilliam v. American Broadcasting Cos.*⁷⁸ In that case, the plaintiffs, a group of British writers and performers known as Monty Python, sued ABC, the sublicensee of Monty Python's BBC programs. ABC had licensed the Monty Python programs to air in the United States and, despite having given assurances that it would edit the programs only for insertion of commercials and to comply with censorship rules, ultimately cut over twenty-four minutes of material from the original ninety-minute program.⁷⁹

Monty Python successfully asserted claims for copyright infringement and for violation of section 43(a) of the Lanham Act. With respect to the Lanham Act claim, Monty Python claimed that the editing done by ABC damaged the original work and that ABC's broadcasting of the program as a Monty Python creation constituted passing off.⁸⁰ The court accepted that argument, reasoning that when one deforms a work and still attributes the work to the original author it makes the author subject to criticism for content for which the author may not have been responsible.⁸¹

Juxtaposing the Ninth Circuit's bodily appropriation precedent and cases like *Gilliam*, it is clear that the double bind the *Dastar* court anticipated was not far-fetched. If one who used uncopyrighted material was required to attribute the material to the original creator, but the creator could pursue claims against the attributors when they did not like the modified material attributed to them, then the original creators would essentially have a backdoor means of control over creative content that should be acquired through the front door of the Copyright Act.⁸² In such a legal environment, the only way for the *Dastars* of the world to avoid being sued, either for attributing or for failing to attribute, would be to copy the original work in its entirety or to get the original author to agree to any modifications.

In a sense, then, if "origin" was interpreted to include the creator of expressive content, section 43(a) would create a species of perpetual copyright protection, and a particularly striking one given that the United States has not embraced the

moral right of attribution, apart from the narrow provisions of the Visual Artists Rights Act (VARA).⁸³ The Court noted that when Congress has wanted to create an addition to copyright law in the past it has done so with much more specificity than the Lanham's Act's ambiguous use of the word "origin."⁸⁴

Finally, the Court explicitly connected its decision in *Dastar* to its other decisions that limited the scope of trademark protection because of concerns about overlap with patent law. According to the Court, interpreting section 43(a) to create a cause of action for the plagiarism without attribution of otherwise unprotected works would be difficult to reconcile with its previous decisions, including *Wal-Mart*⁸⁵ and *Bonito Boats*.⁸⁶ In *Wal-Mart*, for example, the Court concluded that clothing designs could not be protected under section 43(a) without a showing that they had acquired secondary meaning.⁸⁷ That limitation would "be entirely pointless if the 'original' producer could turn around and pursue a reverse passing off claim under exactly the same provision."⁸⁸ Likewise, a broader interpretation of section 43(a) would be at odds with the Court's decision in *Bonito Boats*, which rejected the plaintiff's attempt to protect unpatented boat hulls under a state law that prohibited making molds of the hull designs.⁸⁹

Dastar can therefore be seen as the Court's most recent expression of its general concern about trademark law serving as an alternative form of protection for subject matter copyright and patent laws deal with specifically. In construing the Lanham Act, the Court has, by its own admission, "been 'careful to caution against misuse or over-extension' of trademark and related protections into areas traditionally occupied by patent or copyright."⁹⁰ Generally, unless patent or copyright protects an item, others are free to copy it.

Trade Dress and Architectural Design

Another area in which trademark and copyright laws have sometimes come into tension, though with less explicit recognition by courts, has been in cases where parties have attempted to use trade dress law to protect architectural designs or depictions thereof. This conflict is of relatively recent vintage since, apart from some limited protection afforded to architectural drawings under the pictorial, graphic, and sculptural works provision,⁹¹ copyright protection traditionally was not available for architectural works. In 1990, however, Congress enacted the Architectural Works Copyright Protection Act (AWCPA), which afforded protection to architectural works created on or after December 1, 1990 (the effective date of the AWCPA).⁹² Thus, under current law, all architectural works embodied in existing buildings or published plans or drawings as of December 1, 1990, are not protectable by copyright.⁹³ Practically speaking then, as a matter of copyright law, one is free to copy the design of a building built prior to 1990 so long as she copies from the physical structure and not from the architectural drawings.

Moreover, even after enactment of the AWCPA, copyright protection for architectural works is relatively limited for the purpose of protecting designers

from use of their work to design or build other buildings. Copyright protection for architectural works expressly "does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place."⁹⁴

Given these limitations on the scope of copyright protection for architectural works, it is no surprise that parties have sometimes tried to protect their works by claiming that those who design similar structures or depict their structures falsely designate the "origin" of their architectural works. These cases generally, though not exclusively, involve chain operations that use consistent design elements for each of their outlets.

These chain operators have had somewhat mixed results seeking protection for the design elements of their stores. Courts have been particularly reluctant to allow trademark protection for building features to the extent they are generally functional in design, appearance, and use.⁹⁵ Courts in these cases seem concerned primarily with the patent/trademark overlap. What is most striking about the few cases that have considered trademark protection for these types of building designs, however, is how little recognition there is of potential overlap with copyright law.

In *Fotomat Corp. v. Photo Drive-Thru, Inc.*, one of the few instances of concern about copyright law, the court noted that its "conclusion that nonarbitrary aspects of a building design should be preserved in the public domain is buttressed" by its analogy to copyright law. As the court noted, at that time an architectural structure itself was copyrightable only if it could qualify as a work of art or reproduction thereof.⁹⁶ The fact that building designs could not be protected unless they qualified as works of art certainly does support the view that functional design features should not be protected by trademark law. But the court could have gone further; the fact that copyright law contemplated and dealt with protection for building designs might suggest that trademark law should not offer *any* type of protection to design elements, functional or not. By limiting their concern to functionality, these courts left open the possibility of trade dress protection for nonfunctional design elements, without distinguishing in any meaningful way between chains and single structures.

These types of cases may now have limited applicability, however, particularly after *Wal-Mart*. Building designs used for retail outlets, like the design of the restaurant in *Two Pesos*, probably fall into that category of close cases in terms of whether they constitute product design or product packaging. If that is the case, then, under *Wal-Mart*, courts should err on the side of caution and require evidence of secondary meaning. As a result, the only parties that should be able to qualify for trade dress protection of design features would be companies with several such buildings that truly are chains and not individual or isolated structures.⁹⁷

A different twist on the overlap between trademark law and copyright protection for architectural works came up in *Rock and Roll Hall of Fame and Museum*,

Inc. v. Gentile Productions.⁹⁸ In that case, the owners and operators of the Rock and Roll Hall of Fame asserted a variety of trademark and unfair competition claims against a professional photographer who was selling a poster featuring a photograph of the museum against a colorful sunset.⁹⁹ Of particular significance here, the museum contended that the unique and distinctive design of the museum, which was created by the famed architect I.M. Pei, served as a trademark for the museum and that Gentile's posters were likely to cause consumer confusion. The museum claimed that Gentile's use of the Rock and Roll Hall of Fame in his poster "was like going into a store, getting a bottle of [C]oke, taking a picture, [of it and] putting . . . [C]oke underneath."¹⁰⁰

The court rejected the museum's argument, but it did so purely on trademark grounds. Specifically, it held that, because the museum did not use a consistent depiction of its building design in its commercial endeavors, unlike Coke, which had made consistent use of the Coca-Cola bottle, it had failed to create the consistent and distinct commercial impression that is a prerequisite for trademark protection.¹⁰¹

Unfortunately, however, the court did not recognize another sense in which the museum's case was obviously distinguishable from a case involving a photograph of a Coke bottle. The Copyright Act explicitly permits parties to "mak[e], distribut[e], or public[ly] display pictures, paintings, photographs, or other pictorial representations of [an architectural] work, if the building in which the work is embodied is located in or ordinarily visible from a public place."¹⁰² Clearly that provision is applicable to the Rock and Roll Hall of Fame; just as clearly it is inapplicable to Coke bottles. The court missed an opportunity to channel protection by failing to recognize the plaintiff's attempt to use trademark law to circumvent the restrictions of the Copyright Act.

ECONOMIC OVERLAP

All of the channeling doctrines discussed in this chapter focus on the subject matter to which the modes of intellectual property protection are applied. All reflect a concern that parties will attempt to use trademark law to protect subject matter that should be protected with copyright or patent law. These are reasonable concerns, but they miss another, and potentially more significant, sense in which trademark law serves as a substitute (or additional) form of protection.

If, as the Supreme Court observed in *Traffix*, it is the purpose of patent law and its period of exclusivity, and not trademark law, to reward manufacturers for their innovations,¹⁰³ then we cannot ignore the reality that, in fact, manufacturers can and do achieve many of the same economic benefits from branding that they do from patent or copyright protection. Commentators have at times noted some of those alternative mechanisms—the first mover advantage and trade secret protection among others. But courts and commentators concerned about use of trademark law to protect patentable or copyrightable subject matter have paid far

too little attention to the role of branding in achieving the same types of benefits as copyright or patent law.

Pharmaceutical companies, for example, have been particularly effective at branding and re-branding compositions to build and maintain supracompetitive pricing even after generic entry. Early empirical studies showed, in one case, that while the average price of drugs declines approximately 20 percent within two years of generic entry, brand name drugs experience only slight reductions in price and in some cases even experience slight price increases.¹⁰⁴ Thus, pioneer drugs maintain significant price differentials over their generic competitors.¹⁰⁵ One clear implication of this data is that, even where trademark protection is not applied to the same subject matter as patent law—in this example the patent protects the composition itself and trademark law protects the name and perhaps its packaging—the economic effects of branding overlap significantly with those of patent law. If courts and policy makers are serious about contentions that patent law is necessary only to provide incentives for production and dissemination of inventions, and that the incentive is the sole province of patent law, then courts should consider to a much greater extent than they have the ways in which inventors can capture through branding economic benefits that are similar to those copyright and patent laws sought to afford.

NOTES

1. I borrowed this title, in part, from R.E.M. R.E.M., *What's the Frequency, Kenneth*, on *Monster* (Warner Bros. 1994).

2. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (holding that color, standing alone, can serve as a trademark).

3. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 164 (1989).

4. A patent owner has the exclusive right during the life of the patent to make, use, sell, offer to sell, and import the patented invention into the United States. 35 U.S.C. § 271(a) (2004).

5. See 35 U.S.C. §§ 101 (utility); 102 (novelty); 103 (nonobviousness); and 112 (disclosure).

6. As the Supreme Court explained in *Bonito Boats*, “[t]o qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability.” 489 U.S. at 148. Design patent protection is available only for “industrial” design or works of applied art, as opposed to purely artistic works such as paintings or sculptures, which can qualify for copyright protection. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:90 (4th ed. 1996). Often a single product has elements protected by both design and utility patents; the utility patent protects functional features and the design patent protects the ornamental features. For example, a utility patent might protect the unique design of a sofa, while a design patent protects the special decorative covering of the sofa.

7. 35 U.S.C. § 171.

8. 35 U.S.C. §§ 154(a)(2) (utility patent duration); 173 (design patent duration).

9. 17 U.S.C. § 302.

10. 17 U.S.C. §§ 106(1)–(5). The owner of a copyright in a sound recording also has the exclusive right to perform the copyrighted work publicly by means of a digital audio transmission. 17 U.S.C. § 106(6).

11. See *Baker v. Selden*, 101 U.S. 99 (1879) (holding that copyright did not extend to “a peculiar system of book-keeping” or to forms for use therewith when there were few ways to express those forms). The notion that copyright protection will be denied when there are few ways of expressing a particular idea has become known as the “merger doctrine.” See also 17 U.S.C. §§ 102(b) (preventing copyright protection in any idea, procedure, process, system, method of operation, concept, principle, or discovery); 107 (fair use).

12. Patent and copyright legislation based on Congress’ power under the so-called “Intellectual Property Clause” of the United States Constitution must be durationally limited. U.S. Const. art. 1, § 8, cl. 8 (giving Congress the power “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

13. Trademark rights, unlike the rights granted by the patent and copyright statutes, are not created by statute but derive from actual use of a mark in commerce. *San Juan Prods., Inc. v. San Juan Pools, Inc.*, 849 F.2d 468, 474 (10th Cir. 1988) (“Unlike the registration of a patent, a trademark registration of itself does not create the underlying right to exclude. Nor is a trademark created by registration. While federal registration triggers certain substantive and procedural rights, the absence of federal registration does not unleash the mark to public use. The Lanham Act protects unregistered marks as does common law.”).

14. Primarily for this reason, the Supreme Court held, in *The Trade-Mark Cases*, that federal trademark protection could not be based on the Intellectual Property Clause. 100 U.S. 82, 94 (1879).

15. See 15 U.S.C. §§ 1115 (b)(4) (allowing use of a mark, other than as a trademark, to describe a product or its features); 1125(c)(4) (recognizing fair use defenses to dilution actions); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302 (9th Cir. 1992) (recognizing nominative fair use defense where the defendant uses a trademark to describe the plaintiff’s product, rather than its own, and (1) the product or service in question is readily identifiable without use of the trademark; (2) the defendant uses only so much of the mark or marks as is reasonably necessary to identify the product or service; and (3) the defendant does nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder).

16. *Chosun Int’l, Inc. v. Chrisha Creations*, 413 F.3d 324, 327 n.2 (2d Cir. 2005).

17. Restatement (Third) of Unfair Competition § 16 cmt. b (1995) [hereinafter Restatement].

18. McCarthy, *supra* note 6, § 8.1.

19. See, e.g., *Ashley Furniture Indus., Inc. v. Sangiacomo N.A., Ltd.*, 187 F.3d 363 (4th Cir. 1999) (protecting features of bedroom furniture); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir. 1995) (protecting designs of sweaters); *Stuart Hall Co. Inc. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995) (protecting designs of notebooks).

20. Trade dress can be registered on the Principal Register of the United States Patent and Trademark Office, but most often parties seek protection of their unregistered trade dress under section 43(a) of the Lanham Act, which provides, in relevant part:

[a]ny person who shall affix, apply . . . or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending

falsely to describe or represent the same . . . shall be liable to . . . any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125(a). Section 43(a) provides for claims against a broader range of practices than does section 1115, which applies to registered trademarks. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 858 (1982).

21. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002).

22. *Id.* (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)).

23. *Id.* (noting that the two tests are distinct and conjunctive and that it is legal error to merge the two tests).

24. *Kohler Co. v. Moen Inc.*, 29 U.S.P.Q. 2d (BNA) 1241, 1248 n.10 (7th Cir. 1993) (emphasis added).

25. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

26. An arbitrary term is one with recognized meaning that is unrelated to the particular product or service with which it is used (i.e., APPLE for computers). A fanciful term is a made-up term with no nontrademark meaning (i.e., EXXON). In practice, this is a distinction without a difference, since terms that fall in either category are deemed inherently distinctive and thus protectable without evidence of secondary meaning.

27. *Abercrombie & Fitch*, 537 F.2d at 9; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

28. *Id.* at 769.

29. Restatement, *supra* note 17, § 13 cmt. e.

30. *Two Pesos*, 505 U.S. at 768.

31. See 15 U.S.C. §§ 1052(e)(5), 1125(a)(3) (2004).

32. 505 U.S. 763 (1992). *Taco Cabana* claimed rights in the interior design of its Mexican restaurants, which it described as

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.

Taco Cabana Int'l., Inc. v. Two Pesos, Inc. 932 F.2d 1113, 1117 (5th Cir. 1991).

33. *Two Pesos*, 505 U.S. at 774.

34. *Id.* at 769. Nonfunctionality is an additional requirement for protection under section 43(a). See 15 U.S.C. § 1125(a)(3).

35. *Two Pesos*, 505 U.S. at 775.

36. Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 Emory L.J. 367, 376-77 (1999).

37. 529 U.S. 205 (2000).

38. *Id.* at 207.

39. *Id.* at 207-08.

40. *Id.* at 208.

41. *Id.*

42. *Id.* at 213.

43. *Id.*

44. *Id.*

45. *Id.* at 215–16. In this respect, product design is treated like color, which also cannot be protected without evidence of secondary meaning. See *Qualitex*, 514 U.S. at 162.

46. *Wal-Mart*, 529 U.S. at 215.

47. *Id.* (“[A] classic glass Coca-Cola bottle, for instance, may constitute packaging for those consumers who drink the Coke and then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those consumers who buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former.”).

48. *Id.*

49. *Id.* at 214.

50. See *Qualitex*, 514 U.S. at 165.

51. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001).

52. *Id.*

53. Restatement, *supra* note 17, § 13 cmt. c.

54. *Deere & Co. v. Farmhand, Inc.* 560 F Supp. (S.D. Iowa), *aff’d*, 721 F.2d 253 (8th Cir. 1982).

55. *Traffix*, 532 U.S. at 29 (citing *Qualitex*, 514 U.S. at 164–65; *Two Pesos*, 505 U.S. at 775).

56. *Traffix*, 532 U.S. at 29.

57. *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1507 (10th Cir. 1995). The Restatement defines product features as functional

if the design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used, apart from any benefits attributable to the design’s significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternatives designs.

Restatement, *supra* note 17, § 17.

58. *Qualitex*, 514 U.S. at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

59. *Qualitex*, 514 U.S. at 165. While *Qualitex* may have encouraged attempts to register single-color marks, the Trademark Trial and Appeal Board has at times been skeptical of such marks. In *In re Orange Commc’ns Inc.*, 41 U.S.P.Q. 2d (BNA) 1036 (T.T.A.B. 1996), the Board upheld the Trademark Office’s refusal to register a bright orange color for pay phones, reasoning that the color was designed to be highly visible by passing motorists even in poor weather, and therefore was functional. Similarly, in *In re Howard S. Leight*, 39 U.S.P.Q. 2d (BNA) 1058 (T.T.A.B. 1996), the Board held that the bright and highly visible coral color of safety plugs was functional. In *In re Hudson News Co.*, 39 U.S.P.Q. 2d (BNA) 1915 (T.T.A.B. 1996), the Board sustained a refusal to register a blue colored décor for a newsstand and store, holding that the blue trade dress was “*de jure* functional because it create[d] a soothing, calming, environment which competitors should be free to create in their stores as well.”

60. *Traffix*, 532 U.S. at 33.

61. *Id.* (holding that courts should inquire into “significant non-reputation-related disadvantage in cases of [aesthetic] functionality” which was the issue in *Qualitex*).

62. *Id.* at 29–30.

63. The existence of a design patent, by contrast, may support a claim of nonfunctionality because design patents are granted only for nonfunctional designs. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342 n.3 (T.T.A.B. 1975); *Topps Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q. 2d (BNA) 1412, 1417 (S.D.N.Y. 1996) (an expired design patent “is presumptive evidence of non-functionality”). A design patent alone, however, is not sufficient evidence of nonfunctionality. See *In re R.M. Smith, Inc.*, 219 U.S.P.Q. (BNA) 629, 634 (T.T.A.B. 1983) (finding the claimed features of applicant’s water nozzle functional despite the fact that the product was covered by an expired design patent).

64. McCarthy, *supra* note 6, § 6.14.

65. *Id.* The title of a single literary work, however, cannot serve as a trademark. See *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

66. 15 U.S.C. § 1125(a) (2004).

67. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

68. See, e.g., *Cleary v. News Corp.*, 30 F.3d 1255 (9th Cir. 1994).

69. *Twentieth Century Fox Film Corp. v. Entm’t Distrib.*, 34 Fed. Appx. 312, 314 (2002).

70. *Id.*

71. *Id.* (quoting *Cleary v. News Corp.*, 30 F.3d at 1261–62).

72. *Dastar*, 539 U.S. at 33.

73. *Id.* at 35–36.

74. See, e.g., Laura A. Heymann, *The Birth of Authonym: Authorship, Pseudonymity and Trademark Law*, 80 Notre Dame L. Rev. 1377, 1440–44 (2005).

75. *Id.* at 1442 (“trademark law does not concern itself with the actual source of any good or service (or its progenitors) . . . [but] concerns itself with maintaining the integrity of the organizational system”).

76. *Dastar*, 539 U.S. at 33. Justice Scalia probably was wrong to restrict this notion of source to communicative products. Under modern trademark law, the “source” of any product is not merely the producer of the physical item but the creator of the brand identity that is attached to the product.

77. *Id.* at 36.

78. 538 F.2d 14 (1976).

79. *Id.* at 18.

80. *Id.* at 18, 24. The statute has been used to prevent misrepresentations that might injure the plaintiff’s business or personal reputation even where no registered trademark was involved. See, e.g., *Mortellito v. Nina*, 335 F. Supp. 1288, 1294 (S.D.N.Y. 1972).

81. *Gilliam*, 538 F.2d at 24.

82. There were plenty of ways the creators could have protected their work under copyright law. The original film footage that Fox used to make its television series could have been copyrighted. *Id.* at 37. Likewise Fox could have been diligent about renewing copyright protection and thereby prevented it from falling into the public domain. *Id.* at 38.

83. 17 U.S.C. § 106A (2004). The Copyright Act of 1976 was amended to include section 106A to protect moral rights of visual artists (among other things, to prevent the use of an artist’s name as author of a work of visual art “in the event of distortion, mutilation or other modification of the work which would be prejudicial to his or her honor or reputation”). 17 U.S.C. § 106A(a)(2). A “work of visual art” includes a painting, drawing,

print, sculpture, existing in a single copy, in a limited edition" or "a still photographic image produced for exhibition purposes only, existing in a single copy." 17 U.S.C. § 101. A work of visual art does not include "any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication"; or "any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container." *Id.*

84. *Dastar*, 539 U.S. at 34.

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

86. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, (1989).

87. *Wal-Mart*, 529 U.S. at 214.

88. *Dastar*, 539 U.S. at 36.

89. *Id.* at 37.

90. *Id.* at 33-34.

91. See, e.g., *Robert R. Jones Assocs., Inc. v. Nino Homes*, 858 F.2d 274, 278 (6th Cir. 1988); *Demetriades v. Kaufmann*, 680 F. Supp. 658, 663 (S.D.N.Y. 1988).

92. See 17 U.S.C. § 102(a)(8) (2004); *Hunt v. Pasternack*, 192 F.3d 877 (9th Cir. 1999). The AWCPA also protected works that were unconstructed but embodied in unpublished plans or drawings as of the effective date of the statute, although that protection expired if the work was not constructed by 2003.

93. These works may have been covered by a design patent to the extent the works contained ornamental features, and creative features that are separable from the useful architectural works were subject to copyright protection.

94. 17 U.S.C. § 120(a).

95. Compare *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 1235 (1977) (holding that Fotomat's building design, which included distinctively shaped roof that was only incidentally functional, served as a valid service mark), and *Fotomat Corp. v. Houck*, 166 U.S.P.Q. (BNA) 271, 272 (Fla. Cir. Ct. 1970) (finding Fotomat's building design distinctive due to its "arbitrary and fanciful design [which] serves to identify the source of the goods and services it sells" and therefore entitled to protection under Florida statutory and common law), with *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693, 704-07 (D.N.J. 1977) (finding Fotomat's kiosks, when considered as a whole, primarily functional in design, and limiting protection to nonfunctional features).

96. *Photo Drive-Thru*, 425 F. Supp. at 707 n.14 (including, as examples of works of art, the Statue of Liberty and the Eiffel Tower, examples offered by Nimmer in his treatise on copyright).

97. Cf. *Demetriades v. Kaufmann*, 680 F. Supp. 658 (S.D.N.Y. 1988) (expressing reservation about whether a residential home can qualify as a nonfunctional good and contrasting Fotomat's consistent use of the same blue and yellow design for its buildings with a residential developer's homes, no two of which were the same).

98. 134 F.3d 749 (6th Cir. 1998).

99. *Id.* at 751.

100. *Id.* at 754.

101. *Id.* at 755.

102. 17 U.S.C. § 120(a) (2004).

103. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

104. See Fed. Trade Comm'n, *Generic Drug Entry Prior to Patent Expiration: An FTC Study 9* (2002), available at <http://www.ftc.gov/os/2002/07/genericdrugstudy.pdf>.

105. *Id.* (citing a “study of 32 drugs that lost patent protection around the time of the passage of the Hatch-Waxman Amendments that found that generic entry results in somewhat higher prices for brand-name prescription drugs (in light of factors such as inelastic demand among users of brand-name products), but large decreases in the prices of corresponding generic drugs”).