

THE DOCTRINE OF ELECTIONS: HAS THE NEED TO CHOOSE BEEN LOST?*

I. INTRODUCTION

An ornamental design¹ may be protected by several different forms of intellectual property rights.² While copyrights, patents, trademarks, and trade secrets³ may individually protect a particular design,⁴ it is uncertain whether more than one of these forms of protection can be applied to the same design.⁵ Historically, the Doctrine of Elections ("Doctrine") limited the creator of an ornamental design to only one form of protection.⁶ Over time, the Doctrine has been substantially abandoned. Today, the only dual protection not allowed is copyright protection for a design already patented.⁷ Although lower courts have virtually abandoned the Doctrine,⁸ there is no Supreme Court opinion ad-

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¹ Since this Note considers the overlapping protections available for designs under intellectual property laws, the definition of "ornamental" coincides with the definition of "ornamental" necessary to acquire a design patent—the narrowest of all the intellectual property definitions required for design protection. See 2 A. DELLER, *DELLER'S WALKER ON PATENTS* § 160 (2d ed. 1964 & Supp. 1984) [hereinafter *DELLER*]; *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 696 (2d Cir. 1961) ("To be patentable, a design, in addition to being new and inventive, must be ornamental. This means that it must be the product of aesthetic skill and artistic conception.") (citing *Burgess Vibrocrafters, Inc. v. Atkins Indus.*, 204 F.2d 311 (7th Cir. 1953)); see also *Bentley v. Sunset House Distrib. Corp.*, 359 F.2d 140, 146 (9th Cir. 1966) (an ornamental design need not be attractive to judges). Compare these definitions with copyright law where the Supreme Court held "ornamental" as relating to something of aesthetic value. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903).

² D. BURGE, *PATENT AND TRADEMARK TACTICS AND PRACTICE* 147-49 (1984) [hereinafter *BURGE*] (designs may be protected under patent, trademark, and copyright law).

³ While designs may also be protected by trade secrets, this is not a practical application of the law. See H. ANAWALT, *IDEAS IN THE WORKPLACE* 8 (1988).

⁴ See generally *BURGE*, *supra* note 2, at 3; Drabiak, *Patents, Copyrights, and Trademarks: A Primer on Protecting Intellectual Work Product*, 11 S. ILL. U.L.J. 1 (1986) [hereinafter *Drabiak, Patents*] (reviewing each form of intellectual property protection).

⁵ *But see Gerber, Two Protections are Better Than One*, L.A. Daily J., Apr. 20, 1989, at 7, col. 1.

⁶ Kluth & Lundberg, *Design Patents: A New Form of Intellectual Property Protection for Computer Software*, 70 J. PAT. & TRADEMARK OFF. SOC'Y 847, 857 (1988) ("Historically, the owner of a design was estopped by the doctrine of election of protection from seeking more than one of patent protection, trademark protection, or copyright protection."). See *infra* notes 48-97 and accompanying text.

⁷ The only remaining aspect of the Doctrine of Elections occurs in Copyright Office regulation § 202.10(a). 37 C.F.R. § 202.10(a) (1990). See *infra* notes 157-98 and accompanying text.

⁸ See *infra* notes 98-133 and 188-98 and accompanying texts.

dressing this issue. Thus, the question remains whether more than one form of protection for a particular design is constitutionally prohibited. And, if so, whether this prohibition applies to all combinations of available protection.

Designs may be classified as either functional or ornamental. Functional features of a design are not protectible under trademark, copyright, or design patent law.⁹ However, ornamental features of designs—that is, non-functional designs—may be protected under each of these laws.¹⁰ Protections most often sought for ornamental designs (“designs”)¹¹ are trademark and design patent.¹² Under trademark law, a design must be inherently distinctive or have acquired secondary meaning to be registered; the design must have “become distinctive of the applicant’s goods in commerce.”¹³ Design patent law affords protection for a design if it is new and original.¹⁴ While the bases of trademark law and design patent law are different, the laws afford overlapping protections which raises constitutional issues about providing multiple protections.

This Note traces the development of the Doctrine of Elections and analyzes a possible solution to the conflict between singular and multiple protection rules for ornamental designs.¹⁵

⁹ The phrase “functional design” is misleading because a design eligible for copyright, trademark, or design patent protection must be nonfunctional. *See, e.g., In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961) (holding that a rhomboidal-shaped table used for ore processing was utilitarian and thus not subject to trademark protection).

¹⁰ *See* 17 U.S.C. § 102(a)(5) (1988) (copyright protection is available for original works of authorship which include “pictorial, graphic, and sculptural works”); Lanham Act § 2(f), 15 U.S.C. § 1052(f) (1988) (trademark registration for designs through secondary meaning); 35 U.S.C. § 171 (1988) (Patent law protects “[w]hoever invents any new, original and ornamental design for an article of manufacture.”).

¹¹ For the definition of an ornamental design, *see supra* note 1.

¹² *See* BURGE, *supra* note 2, at 147-49.

¹³ Lanham Act § 2(f), 15 U.S.C. § 1052(f). For the text of section 2(f), *see infra* note 29. Because functional items cannot receive trademark protection, only the scope of design patents, not utility patents, will overlap with that of trademarks. *See In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.) (“When federal trademark rights have been sought for functional subject matter disclosed in a utility patent, . . . the acquisition of such rights will not be allowed in view of the ‘overriding public policy of preventing their monopolization, of preserving the public right to copy.’”) (citations omitted), *cert. denied*, 419 U.S. 1080 (1974), *aff’d after remand*, 532 F.2d 180 (C.C.P.A. 1976).

¹⁴ 35 U.S.C. § 171. Utility patents, the more familiar branch of patent law, are obtained under tests similar to those for ornamental designs, but relate to functional inventions. *See* 2 DELLER, *supra* note 1, § 157, at 733 (“The principles applying to patents generally also apply to design patents.”). *See infra* note 21. *See* 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor . . .”).

¹⁵ While the principal focus of this Note is the conflict between trademark and design patent law, copyright law will also be discussed. *See infra* notes 157-98 and accompanying text.

Part II examines the conflicts for which the Doctrine was created to resolve. Part III analyzes several leading Doctrine cases and discusses court-suggested resolutions to the conflict. The concept of functional aesthetics, which narrows the field of designs protectible under trademark and design patent law, is reviewed in Part IV. Part V discusses the only remaining recognized Doctrine prohibition which the Copyright Office maintains through a regulation. Finally, considering recent decisions, Part VI predicts the future viability of the Doctrine of Elections.

II. THE RATIONALE FOR THE DOCTRINE OF ELECTIONS

The Doctrine of Elections evolved from a belief that trademark protection combined with design patent protection converts the limited monopoly granted under the design patent into a perpetual monopoly. The Doctrine was founded on the belief that the "limited Times . . . exclusive Right" language of the Constitution relating to patents and copyrights¹⁶ must be interpreted strictly and that the monopoly may never be extended.¹⁷ The rejection of the Doctrine with respect to the overlap of trademark and patent law is based on the goals of both laws. Thus, it is necessary to examine the laws controlling trademarks and design patents to fully understand the respective protections.

Patent protection originates from article I of the Constitution which permits Congress to grant a limited exclusive right to inventors.¹⁸ Design patent law was created to encourage the de-

¹⁶ U.S. CONST. art. I, § 8, cl. 8. For the text of this clause, see *infra* note 18.

¹⁷ There are two forms of extensions—limited and perpetual. Under the Doctrine, a limited extension would occur when a design patent is followed by copyright registration. A perpetual extension arises when a design patent is followed by a trademark registration for the same design. Interestingly, there may be a split in the interpretation of the Doctrine of Elections as to whether no extension of the original monopoly is permitted, or if the extension is limited, it is deemed constitutional.

¹⁸ "The Congress shall have 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." U.S. CONST. art. I, § 8, cl. 1, 8.

The Supreme Court first discussed design patents in *Gorham Co. v. White*, 81 U.S. 511 (1871):

[Design patent law] proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. *The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing, or product, which the patent law regards.*

velopment of the decorative arts¹⁹ and increase the desirability of manufactured goods to the public.²⁰ As an incentive, the law gives the owner an exclusive right to exploit his creation.²¹ However, the right is not perpetual,²² and thus the public may gain unrestricted access to the design after the patent expires.

Trademark law, another form of protection available to merchants who have acquired the right to a product from its designer, originates from the commerce clause²³ and is therefore controlled by Congress.²⁴ A trademark is "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish

Id. at 525 (emphasis added).

The rationale for limiting the length of time for authors' and inventors' exclusive rights followed similar reasoning.

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Mazer v. Stein, 347 U.S. 201, 219 (1954).

For a history of the development of design patent law, see 2 *DELLER*, *supra* note 1, §§ 155-157. There have been no significant changes in the language of the design patent law since its inception in 1842. See D. CHISUM, *PATENTS* § 1.04[1] (1990).

¹⁹ The present design statute, 35 U.S.C. § 171 (1988), is based on Act, ch. 230, § 71, 16 Stat. 209 (1870). See *Gorham*, 81 U.S. at 524 ("The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.").

²⁰ See *Gorham*, 81 U.S. at 525 ("The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public."); *Hueter v. Compco Corp.*, 179 F.2d 416, 417 (7th Cir. 1950) ("The purpose of the design patent law is to promote the decorative arts and to stimulate the exercise of inventive faculty in improving the appearance of articles of manufacture.").

²¹ "Every patent shall . . . grant to the patentee . . . for the term of seventeen years . . . the right to exclude others from making, using, or selling the invention throughout the United States . . ." 35 U.S.C. § 154. The right to exclude others applies to design patents as well as utility patents since "[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." *Id.* § 171. The only exception to the 17 year period in section 154 is the term for design patents which "shall be granted for the term of fourteen years." *Id.* § 173.

The exclusivity is considered a negative right because it is not a promotion of the invention, but rather an exclusion of others from producing the patented object. See, e.g., *BURGE*, *supra* note 2, at 27-29.

²² 35 U.S.C. § 173.

²³ "The Congress shall have Power . . . To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes." U.S. CONST. art. I, § 8, cl. 1, 3.

²⁴ See 1 J.T. MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION* § 5:3, at 135-36 (2d ed. 1984 & Supp. 1990) [hereinafter *MCCARTHY*] ("Congress' power to regulate trademarks [is] limited to an exercise of the Commerce power."). The modern version of trademark law is "[t]he Lanham Act, a product of some twenty-two years of effort to overhaul the antiquated 1905 Act." 1 J. GILSON, *TRADEMARK PROTECTION AND PRACTICE* § 1.04[1], at 1-40 (1990).

them from those manufactured or sold by others.”²⁵ Trademarks function as seals of quality, allowing consumers to purchase goods based on reputation or personal experience.²⁶ Over time, ornamental designs used in commercial products frequently acquired the attributes of trademarks. This development resulted from the constant consumer exposure to the ornamental design and its acquisition of “secondary meaning.” Eventually, the doctrine of secondary meaning²⁷ developed and is “now . . . regarded as one of the most vital phases of the substantive law of trade-marks.”²⁸ By complying with statutory criteria of secondary meaning, an ornamental design may be registered as a trademark.²⁹ Trademark protection lasts as long as the mark is used,³⁰

²⁵ 15 U.S.C. § 1127 (1988).

²⁶ See *infra* note 38.

²⁷ While the original definition of secondary meaning only encompassed words and phrases, the definition was judicially expanded to include symbols and devices, such as containers. The first container was registered in 1958. *Ex parte Haig & Haig, Ltd.*, 118 U.S.P.Q. (BNA) 229 (C.C.P.A. 1958).

²⁸ W. DERENBERG, TRADE-MARK PROTECTION AND UNFAIR TRADING 325 (1936).

To leave unguarded long established and well known marks which had assumed a position of importance in trade would affront the purpose and aim of equity. In this sense, “secondary meaning” signifies so general a recognition of the mark as to lead to its popularizing the brand of goods to which it is affixed

Id. at 326; see also *G. & C. Merriam Co. v. Saalfield*, 198 F. 369 (6th Cir. 1912), *cert. denied*, 243 U.S. 651 (1917). The Sixth Circuit stated:

[The “secondary meaning” theory] contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark. So it was said that the word had come to have a secondary meaning, although this phrase, “secondary meaning,” seems not happily chosen, because, in the limited field, this new meaning is primary rather than secondary; that is to say, it is, in that field, the natural meaning.

Id. at 373.

²⁹ To obtain trademark protection, a design must become distinctive of the producer from the viewpoint of the consumer. Section 2 of the Lanham Act, which discusses secondary meaning, provides in part:

[N]othing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f).

“[I]f the configuration is not inherently distinctive, it must be proven to have acquired secondary meaning to be registrable on the Principal Register.” 1 McCARTHY, *supra* note 24, § 7:31, at 265.

³⁰ See 15 U.S.C. § 1058(a). For a discussion of various ways one may lose trademark rights, see Drabiak, *Patents, supra* note 4, at 25-26. See also *infra* note 117.

the requisite renewals are filed, and the fees are paid.³¹

Allowing trademark registration for a design patent owner raises two major issues. The first is whether the trademark protection constructively "stretches"³² the life of the patent beyond the limited scope constitutionally allowed,³³ thus creating a perpetual monopoly.³⁴ The second issue is whether acquired secondary meaning should be permitted to create a trademark right only if the design has been subjected to the competitive pressures of the marketplace.³⁵

Some contend that a design patent owner should not have fourteen years to exploit the design without fear of competition,³⁶ while simultaneously satisfying the secondary meaning requirement to obtain exclusive use. For example, assume an ornamental design for hairbrushes covered by a design patent achieves secondary meaning by virtue of exclusive sales during the fourteen years of the design patent protection. In that case, trademark protection may be acquired solely through the use of design patent law and not through any competitive process. Others contend, however, that the method of obtaining such sec-

³¹ 15 U.S.C. § 1059(a). This Note only considers registration on the Principal Register.

³² The notion that patent protection is extended is known as the "stretching" argument since the limited monopoly allowed under the Constitution is "stretched" into a perpetual monopoly under trademark law. 1 McCARTHY, *supra* note 24, § 6:3, at 156-57; see also SK&F, Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055 (3d Cir. 1980).

³³ See *supra* note 21.

³⁴ See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (often interpreted as finding an extension). *But see In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964) (finding no monopoly extension); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918) ("The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly. In truth, a trade-mark confers no monopoly whatever in a proper sense . . .") (citations omitted).

³⁵ In one trademark case, the court stated that it is a fundamental principle of trademark law that "nothing which the public has or would have a right to copy, in the absence of valid patent or copyright protection, can be the subject of a valid trademark registration and . . . this is so irrespective of public acceptance of the subject matter sought to be registered." *In re Pollak Steel Co.*, 314 F.2d 566, 567 (C.C.P.A. 1963) (Rich, J.). This statement was later clarified as being limited to functional designs. *Mogen David*, 328 F.2d at 932-33 (Rich, J., concurring). This clarification, however, does not make sense because copyright protection was also mentioned in the phrase "in the absence of valid patent or copyright protection." While "patent" may refer to utility patents, "copyright" cannot be similarly explained because copyright protection cannot apply to functional items.

Descriptive terms may not automatically be registered even if they have acquired secondary meaning. The public's interest in the term outweighs the interest in the mark as a signal of its source. See *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855 (C.C.P.A. 1962); *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961); *De Walt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656 (C.C.P.A. 1961); *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437 (C.C.P.A. 1960).

³⁶ 35 U.S.C. § 173 (1988).

ondary meaning is not relevant since the ultimate goal of trademark law is to prevent consumer confusion.³⁷

The Doctrine of Elections originated under policy considerations shared with design patent law. The drafters of design patent law wanted a limited monopoly to encourage invention and to allow eventual price competition on the design after the patent expired. In contrast, the drafters of trademark law sought to reward creators of popular designs while fostering quality and preventing consumer confusion.³⁸ During the demise of the Doctrine of Elections, the policy considerations espoused by the courts shifted from the enhancement of competition, the aim of patent law and a basis for the Doctrine, to the prevention of consumer confusion, one of the goals of trademark law.³⁹ To clarify this dichotomy, consider an opponent of the Doctrine of Elections ("anti-Doctrinist") as one who believes that patented designs should also be registrable as trademarks to prevent consumer confusion.⁴⁰ Alternatively, a supporter of the Doctrine of Elections ("pro-Doctrinist") views a perpetual monopoly for a patented design as undesirable and in violation of the Constitution's limitation on exclusive use.

While anti-Doctrinists and pro-Doctrinists seem diametrically opposed, a compromise may exist between their two positions. If a design is protected by a design patent, and the consumer recognition under which secondary meaning is claimed stems in substantial part from the period of design patent protection, the design should be denied trademark registra-

³⁷ This goal was once considered constitutional in nature, coming from a broad reading of the "general welfare" clause which grants Congress the power to protect the consumer. U.S. CONST. art. I, § 8, cl. 1. However, this reading was rejected in *United States v. Butler*, 297 U.S. 1 (1936).

³⁸ Trade-marks . . . are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will
S. REP. No. 1333, 79th Cong., 2d Sess. 4 (1946).

³⁹ The turning point occurred in *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964). For a discussion of this case, see *infra* notes 98-124 and accompanying text.

⁴⁰ See *infra* notes 98-124 and accompanying text. Additional consumer protection arguments relate to the quality of the product associated with the design. For example, it can be argued that inferior products will more likely be produced by manufacturers imitating the creator's successful design. To prevent the making of an inferior product, and possible association of an inferior product with its original manufacturer, the creator, some argue, should be able to obtain trademark registration by acquiring secondary meaning for his design. However, anti-Doctrinists argue that product competition in general lowers market prices, benefiting the consumer.

tion. However, if evidence of secondary meaning develops separately from the protection afforded by the patent, trademark registration should be permitted. A waiting period of five years should be required to parallel the present requirement for establishing secondary meaning.⁴¹ Trademark protection for designs would then become a reward for an association gained through the rigors of the competitive marketplace. This compromise maintains the requirement of success in the marketplace which is currently needed to achieve trademark protection.

If the proposed compromise is adopted, then trademark protection may still be obtained, but only if the applicant's competitors have had a chance to adopt the design. Secondary meaning protection, under the compromise, will have been fought for in the marketplace and thus trademark registration will remain a reward for consumer affinity. Even if the merchant is forced to wait five years between the patent's expiration and trademark protection, a design's value as indicating source of origin will probably maintain itself over that period.⁴² While other merchants may choose not to adopt the new design, the opportunity to adopt the favored design exists, and the purpose of trademark law—protecting associations formed by consumers—is maintained. This compromise allows trademark protection for a design that has been patented, conditioned upon a reasonable opportunity for competitive merchants to exploit the design once the design patent expires.

Such a compromise, however, does not address the question of whether there is a constitutional conflict between the monopolies granted under patent and trademark law. While the Constitution⁴³ and the Lanham Act⁴⁴ both provide protection for designers, it is unclear whether the exclusive rights afforded under trademark law may extend those granted by design patent law. The Court of Customs and Patent Appeals ("CCPA") had emphatically responded in the negative.⁴⁵ However, this inter-

⁴¹ For the text of section 2(f) of the Lanham Act, see *supra* note 29.

⁴² Unfair competition claims should still be applicable. See *infra* note 61.

⁴³ See *supra* note 18.

⁴⁴ 15 U.S.C. §§ 1051-1127 (1988).

⁴⁵ "In our opinion, trademark rights . . . which happen to continue beyond the expiration of a design patent, do not 'extend' the patent monopoly." *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964). While *In re Honeywell, Inc.*, 497 F.2d 1344 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974), follows *Mogen David*, the court hesitated to completely deny the monopoly theory:

With that distinction in mind, this court decided that the public interest—protection from confusion, mistake, and deception in the purchase of goods and services—must prevail over any alleged extension of design patent

pretation does not fully consider the impact of the overlapping monopolies on the constitutional requirement of limited protection for designs.⁴⁶

Granting trademark protection after a patent expires may not only extend the length of time of the monopoly but also expand the scope of protection. Reconsider the hairbrush design.⁴⁷ During the term of a design patent, no manufacturer may make, use, or sell the ornamentation. When trademark protection begins, no competitor may use the design on hairbrushes or related products even if the design patent has expired. However, if the design has become so well-known that use on products other than hairbrushes creates consumer confusion, the trademark protection may be expanded to include such other products. This scenario is inconsistent with the limited monopoly established by the design patent. Not only are competitors banned from using the ornamentation on hairbrushes and similarly related products, but now the ornamentation is protected on an even broader scope of products.

III. CASE LAW AND THE REJECTION OF THE DOCTRINE OF ELECTIONS

A. *The Early Years of the Doctrine of Elections*

While the Doctrine of Elections was not formally recognized until 1910,⁴⁸ its roots can be traced to the Supreme Court decision in *Coats v. Merrick Thread Co.*⁴⁹ In *Coats*, the plaintiffs obtained a design patent on April 5, 1870 "for embossing the ends of sewing-thread spools."⁵⁰ The patent expired in 1877, but before expiration, plaintiffs registered a trademark for the design

rights, when a trademark is non-functional and does in fact serve as a means to distinguish the goods of the trademark owner from those of others.

Id. at 1348.

⁴⁶ This is not to say that trademark protection is a strict extension of the design patent, but it does prohibit a competitor from using a registered design on, or in relationship with, the product for which the trademark was registered. The exclusive right an inventor receives under patent law is maintained under trademark law, and in fact may be broadened because the test for infringement under each is different. A trademark is infringed if there is a "likelihood of confusion," while a design patent is infringed if there is actual confusion of the ordinary observer. See *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026 (Fed. Cir. 1986). Even though the *Unette* court affirmed the lower court's finding of design patent infringement, it stated that the district court's application of trademark's "likelihood of confusion" test was unnecessary and inappropriate because it blurred the otherwise "clear line that exists between" the two tests. *Id.* at 1029.

⁴⁷ See *supra* text following note 36.

⁴⁸ See *infra* notes 62-64 and accompanying text.

⁴⁹ 149 U.S. 562 (1893).

⁵⁰ *Id.* at 567. Today, while this case would most likely be dismissed due to the func-

in 1875.⁵¹ Suit followed soon after defendants embossed a slightly different design on the same location of a spool. While the Court implied that relief under an unfair competition claim could have been granted,⁵² it stated that “plaintiffs’ rights to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it never had been patented.”⁵³ Therefore, with little explanation, the Court intimated that no trademark protection was available for a patented design.⁵⁴

Several years later, the court in *Allen v. Walton Wood & Metal Co.*⁵⁵ discussed in dicta that trademark protection for designs in an expired patent may be possible, but no definitive viewpoint was expressed. *Allen*, however, is distinguishable from *Coats* because it involved a utility patent rather than a design patent.⁵⁶ The subject of the utility patent in *Allen* was the “Flexible Flyer” sled.⁵⁷ The court found that “the exclusive right in complainant to such shapes and forms and colors so used expired with that first patent, and the right to use them passed to the public.”⁵⁸ However, the court then added that “[i]f, on the other hand, the form and ornamentation was [sic] adopted and used to denote origin simply, we may have another question.”⁵⁹ Like *Coats*,⁶⁰ the *Allen* court implied that unfair competition was a possible claim.⁶¹

tionality aspects of the design, it is important to note the degree of finality given an expired design patent.

⁵¹ *Id.* at 568.

⁵² “There can be no question of the soundness of the plaintiffs’ proposition that, irrespective of the technical question of trade-mark, the defendants have no right to dress their goods up in such manner as to deceive an intending purchaser, and induce him to believe he is buying those of the plaintiffs.” *Id.* at 566. However, in this case, the court denied relief, stating: “[Defendants] could do little more than place their own name conspicuously upon the label Having done this, we think they are relieved from further responsibility.” *Id.* at 573.

⁵³ *Id.* at 572.

⁵⁴ The Court held that the trademark itself was not valid, but “[w]ithout deciding whether if the embossed periphery had contained a word which was capable of being appropriated as a trade-mark, defendants could have appropriated the same upon expiration of [plaintiffs’] patent.” *Id.*

⁵⁵ 178 F. 287 (N.D.N.Y. 1910).

⁵⁶ This distinction is followed elsewhere. In *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827 (3d Cir. 1916), the court found that fluting on a rubber hose was a functional aspect of the invention, its inclusion in the patent was not merely for source of origin, and trade-mark protection was not available. “Were this the law, it would follow that . . . he could . . . turn his patent . . . into a perpetual patent.” *Id.* at 834.

⁵⁷ United States Patent No. 797,338 issued on August 15, 1905. *Allen*, 178 F. at 288.

⁵⁸ *Id.* at 300.

⁵⁹ *Id.* at 301. The ornamentations discussed were not the subject of the patent, but were arguably presented for illustrative purposes.

⁶⁰ See *supra* note 52.

⁶¹ *Allen*, 178 F. at 301. See also *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827 (3d Cir. 1916) (wherein unfair competition is possibly available to expired patents); *Société*

The first generally recognized Doctrine of Elections case involved a conflict between copyright and design patent law. In *Louis De Jonge & Co. v. Breuker & Kessler Co.*,⁶² the applicant sought to invoke both copyright and design patent protection for his painting *Holly, Mistletoe, and Spruce*. While the painting could have received design patent protection for its use as wrapping paper, the court found that the owner was bound to his original election of copyright protection.⁶³ The court further reasoned that forcing an applicant to choose would promote knowledge of the various forms of protection.⁶⁴

The Doctrine of Elections was again raised in *In re Blood*⁶⁵ where a design for a hosiery label was eligible for protection under both design patent and trademark law. In this case, the court applied the Doctrine of Elections for reasons previously not stated: "The design is not entitled to double registration, once as a label design, and again as a design for a hosiery ticket. Such a course would result for all practical purposes in an extension of the design monopoly."⁶⁶ The court's rationale was that a patentee dedicates his invention to the public in exchange for securing a limited monopoly for the design.⁶⁷

B. *Reaffirming the Anti-Monopoly Theory*

The Supreme Court has strictly construed the limitations on the duration of intellectual property rights under the Constitution.⁶⁸ In fact, even the CCPA, which earlier rejected the Doc-

Anonyme de la Distillerie de la Liqueur Benedictine de L'Abbaye de Fecamp v. Puziello, 250 F. 928 (E.D.N.Y. 1918) (when trademark protection is not available, unfair competition may still be). *But see* *Corning Glass Works v. Pasmantier*, 30 F. Supp. 477, 481 (S.D.N.Y. 1939) ("Patentees may not properly attempt to immortalize their patents by the use of trade-marks or counts in unfair competition."); *see also* Treece, *Copying Methods of Product Differentiation: Fair or Unfair Competition?*, 38 NOTRE DAME LAW. 244, 244 (1963) [hereinafter *Copying Methods*] ("in markets where competition is the regulator, certain methods of product differentiation, such as product and package design and configurations of goods, which do not qualify for statutory protection, do not merit judicial protection against copiers in unfair competition actions").

⁶² 182 F. 150 (S.E.D. Pa. 1910), *aff'd*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914).

⁶³ *Id.* at 152.

⁶⁴ "[I]f applicants understand clearly that they cannot apply for protection of one kind and hope to receive protection of the other, they will probably be very careful to ask for precisely what they want." *Id.* at 155.

⁶⁵ 23 F.2d 772 (D.C. Cir. 1927).

⁶⁶ *Id.* at 772 (citing *Louis De Jonge*, 182 F. 150).

⁶⁷ *See* *Korzybski v. Underwood & Underwood, Inc.*, 36 F.2d 727, 729 (2d Cir. 1929) ("When [plaintiff] filed his application and received his patent, he made a full disclosure of his invention and dedicated it to the public, save for the right to make, use, and vend it during the period for which the patent gave him that monopoly.").

⁶⁸ *See* *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945) (patent monopoly is only granted for a limited time, and after the patent expires "any attempted

trine of Elections, stated in dicta that extending a patent monopoly through trademark law runs contrary to the purpose and intention of patent law.⁶⁹

The Supreme Court case which some consider to strongly support the Doctrine of Elections is *Kellogg Co. v. National Biscuit Co.*⁷⁰ This case raised the question of whether Kellogg could produce shredded wheat biscuits in a pillow-shaped form. Justice Brandeis concluded that "upon expiration of the patents[,] the form . . . was dedicated to the public."⁷¹ Although the Court did not specifically refer to the Doctrine of Elections, it ruled that the design could not be protected as a trademark.⁷² However, in *Kellogg*, the design was also found to be functional. While National Biscuit had an earlier design patent covering the shape of the biscuit, it had been deemed invalid.⁷³

The narrow interpretation of *Kellogg* is that a shape which is dictated by a utility patent may not have extended protection through secondary meaning trademark protection. The opinion's strong reliance on the anti-monopoly theory, however, suggests to some a broader interpretation, that protection for the biscuit shape could not be extended beyond the duration of the patent because the rights passed to the public upon termination of the patent.⁷⁴ While the Court examined the underlying patent law policies, including the prevention of extended monopolies and the encouragement of invention, the case was decided on unfair competition grounds and the prevention of consumer confusion.⁷⁵

In considering the problem of consumer confusion, the Court focused on the manner by which the boxes were labeled.⁷⁶ The Court allowed the product to be copied since it found that

reservation or continuation in the patentee or those claiming under him of the patent monopoly, . . . runs counter to the policy and purpose of the patent laws."); see also *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185-86 (1896) (Following the expiration of a patent, the patented device enters the public domain and the ownership of the device passes to the public along with the generic designation of the device. To hold otherwise would "perpetuate indefinitely an exclusive right.").

⁶⁹ *In re Honeywell, Inc.*, 497 F.2d 1344, 1347 (C.C.P.A. 1974) (involving utility rather than design patents).

⁷⁰ 305 U.S. 111 (1938).

⁷¹ *Id.* at 119-20. Justices McReynolds and Butler, however, dissented from this view. *Id.* at 123.

⁷² *Id.* at 120.

⁷³ *Id.* at 119 n.4.

⁷⁴ See Note, *The Protectability of Package, Container, and Product Configurations [Part I]*, 5 U.S.F. L. REV. 451, 513 (1971) [hereinafter *Product Configurations [Part I]*] (noting broad interpretations of *Kellogg*).

⁷⁵ *Kellogg*, 305 U.S. at 120-21.

⁷⁶ *Id.*

the alterations made by the copier were significant enough so as not to cause confusion between the original product and the copier's.⁷⁷ "There is no evidence of passing off or deception on the part of the Kellogg Company; and it has taken every reasonable precaution to prevent confusion or the practice of deception in the sale of its product."⁷⁸ Thus, as in *Coats*⁷⁹ and *Allen*,⁸⁰ unfair competition was considered an appropriate vehicle for protection when trademark protection was unavailable.

C. *The Last Stand for the Doctrine*

A string of Doctrine of Elections cases began with the 1947 Second Circuit case *Lucien Lelong, Inc. v. Lander Co.*⁸¹ The plaintiff, Lucien Lelong, began selling perfume in ball-shaped, long-necked bottles in April 1933. In 1934⁸² and 1937,⁸³ Lucien Lelong obtained design patents on the bottles. After both patents expired, Lucien Lelong sought relief for the defendant's use of the design through common law trademark rights by arguing that the bottle design had acquired secondary meaning.⁸⁴ The court of appeals affirmed the district court's finding for the defendant, stating in part that the bottle shape had been dedicated to the public since the design patent had expired.⁸⁵

The Second Circuit opinion began with a misleading statement which could be interpreted to mean trademark protection is available for patented designs—"plaintiff may prevail only if it proves that its style of bottle has acquired a secondary meaning."⁸⁶ However, in the context of the entire opinion, the court meant that the plaintiff's secondary meaning claim was the only reasonable argument. The court, nevertheless, emphatically rejected the argument as demonstrated in a later passage:

⁷⁷ This principle would apply quite well in a *Mogen David* type situation. If the copier of a wine bottle design clearly marked his label so that consumers would not confuse his wine with that of Mogen David, copying the consumer-preferred bottle design should be allowed. See *infra* notes 98-124 and accompanying text.

⁷⁸ *Kellogg*, 305 U.S. at 122 (footnote omitted).

⁷⁹ See *supra* note 52.

⁸⁰ See *supra* note 61.

⁸¹ 164 F.2d 395 (2d Cir. 1947).

⁸² Design patent No. 91,372 was issued on January 16, 1934 to Joseph S. Stein and assigned to Lucien Lelong, Inc. with a term of 7 years. 438 Off. Gaz. Pat. Office 575 (Jan. 16, 1934).

⁸³ Design patent No. 106,647 was issued on October 26, 1937 to John D. Buckingham and assigned to Lucien Lelong, Inc. with a term of 7 years. 438 Off. Gaz. Pat. Office 927 (Oct. 26, 1937).

⁸⁴ *Lucien*, 164 F.2d at 398.

⁸⁵ *Id.* at 397.

⁸⁶ *Id.*

Asserting that a secondary meaning had been acquired during the life of the patent, [plaintiff] urges that, even after the expiration of the design patents, the secondary meaning afforded protection against the marketing of cologne by others in like shaped bottles. This is a novel and sweeping claim, which would seem to run counter to the policy and purpose of the patent laws. A patent is the grant of a temporary monopoly to the patentee; at its expiration all are free to use the invention.⁸⁷

The court's position is clear. The "novel and sweeping claim" of secondary meaning was rejected. The plaintiff could not prevail even if he could show that his design satisfied the requirement of secondary meaning.⁸⁸

This interpretation is further buttressed by the court's later statement that the "plaintiff has had its patent protection for the period of the patent and cannot longer enjoy its monopoly of the very designs patented. Moreover, as we have seen, plaintiff was not able to prove secondary meaning."⁸⁹ Thus the court determined that the plaintiff failed to overcome one of the reasons for limiting the duration of patents—the prevention of monopolies.⁹⁰

Two important secondary meaning arguments were presented in *Lucien*. The first argument, derived from *Kellogg*,⁹¹ stated that as long as the labeling was clear and some variation in the bottle was evident, confusion could not be claimed.⁹² The second argument focused on the date when the copier entered the market.⁹³ The design patentee would have had an unfair advantage in establishing secondary meaning during the term of the patent due to his right to exclusive use. "During the life of the patent a purchaser will naturally associate the product with the producer, since the patent prevents others from producing. But such association does not furnish justification for an extension of such protection unlimited in

⁸⁷ *Id.* (citing *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 255 (1945)).

⁸⁸ *Id.*

⁸⁹ *Id.* at 398.

⁹⁰ The *Lucien* court looked to other cases to support its decision not to consider secondary meaning: *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960 (2d Cir. 1918); and *James Heddon's Sons v. Millsite Steel & Wire Works, Inc.*, 35 F. Supp. 169 (E.D. Mich. 1940), *aff'd*, 128 F.2d 6 (6th Cir.), *cert. denied*, 317 U.S. 674 (1942). See also *Zangerle & Peterson Co. v. Venice Furniture Novelty Mfg. Co.*, 133 F.2d 266, 269 (7th Cir. 1943) ("After a [design] patent expires, one may copy it. It then belongs to the public. The patentee's monopoly is gone.") (citing *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896)).

⁹¹ See *supra* note 78 and accompanying text.

⁹² *Lucien*, 164 F.2d at 397.

⁹³ *Id.* (citing *Upjohn Co. v. William S. Merrell Chem. Co.*, 269 F. 209 (6th Cir. 1920), *cert. denied*, 257 U.S. 638 (1921)).

time."⁹⁴ Interestingly, the court implied that it may have allowed a claim of secondary meaning on particular features of the bottle.⁹⁵ However, the court continued, since the plaintiff sought secondary meaning on the whole bottle, granting secondary meaning protection would improperly extend the rights afforded under the design patent.⁹⁶ Thus, the *Lucien* line of cases demonstrates the possibility that some jurisdictions may revive the Doctrine of Elections.⁹⁷

D. *The Demise of the Doctrine of Elections*

The turning point for the Doctrine of Elections occurred in a 1964 case, *In re Mogen David Wine Corp.*⁹⁸ *Mogen David* involved a wine manufacturer who initially obtained a design patent for a wine bottle.⁹⁹ The manufacturer later applied for trademark registration for the wine bottle,¹⁰⁰ claiming that the public had grown to associate the bottle with his product and thus secondary meaning had been acquired.¹⁰¹ After being denied registration by the examiner because the bottle failed to distinguish the applicant's wines from those produced by others,¹⁰² the applicant appealed to the Trademark Trial and Appeal Board ("TTAB").¹⁰³ The TTAB affirmed the denial of registration on the grounds that the applicant had already acquired a patent which granted protection for only fourteen years.¹⁰⁴ Since the applicant had already acquired a patent for his bottle, he was not entitled to subsequent trademark protection.¹⁰⁵ The applicant then appealed to

⁹⁴ *Id.* at 398.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ See *infra* notes 208-11 and accompanying text.

⁹⁸ 328 F.2d 925 (C.C.P.A. 1964), *aff'g* 134 U.S.P.Q. (BNA) 576 (T.T.A.B. 1962).

⁹⁹ Design patent No. 158,213 was issued on April 18, 1950 to William A. Nester and assigned to Obear-Nester Glass Company with a term of 14 years. 633 Off. Gaz. Pat. Office 981 (Apr. 18, 1950).

¹⁰⁰ Serial No. 73,406 filed May 11, 1959. *Mogen David*, 328 F.2d at 926 n.1.

¹⁰¹ *Id.* at 926-27.

¹⁰² "Registration has been refused on the ground that the subject matter for registration is a non-distinctive configuration of the container for the goods and that as such it does not identify and distinguish applicant's wines from those produced and sold by others." *Mogen David*, 134 U.S.P.Q. (BNA) at 577.

¹⁰³ *Id.*

¹⁰⁴ *Id.* at 578.

¹⁰⁵ This case was affirmed on the grounds that the use of the subject matter of a design patent during the life of the patent cannot properly be considered as trademark use. As stated by the Commissioner in *Ex parte Caron Corporation*, 100 USPQ 356, 360 (1954):

"During the fourteen year term of the patent, applicant was fully protected against all uses by others, and use of the bottle by applicant during that period probably was not a use which would entitle it to claim any rights under the trademark laws. The 'exclusive use' during that period was by virtue of its right to exclude under the patent laws and

the Court of Customs and Patent Appeals which reversed¹⁰⁶ and remanded the case to determine whether the wine bottle was non-functional.¹⁰⁷

In reversing the case, the CCPA began by noting that the question was one of first impression.¹⁰⁸ To approach "a proper resolution of the issue here requires recognition of the distinction in purpose underlying the protection accorded designs under the patent laws and that protection accorded trademarks . . . on the basis of secondary meaning."¹⁰⁹ Because "[t]he underlying purpose and the essence of patent rights are separate and distinct from those appertaining to trademarks,"¹¹⁰ the court held that one could obtain trademark registration based on secondary meaning even though the design had already been patented.¹¹¹ The court then broadly stated:

[T]rademark rights, or rights under the law of unfair competi-

was not the 'exclusive use' contemplated by the trade mark law as a distinguishing mark."

It thus seems clear that while applicant's decanter bottle, although the subject matter of a subsisting design patent, may in view of the distinctive character of the decanter and the record adduced by applicant be capable of distinguishing applicant's wines and hence be registrable on the Supplemental Register, it is precluded as a matter of law during the life of the design patent from constituting subject matter which may properly be registered on the Principal Register. See: *In re The Deister Concentrator Company, Inc.*, [289 F.2d 496 (C.C.P.A. 1961).] The question whether or not the decanter bottle has acquired a secondary meaning and therefore serves as a trademark to identify and distinguish applicant's wines is one which can be considered, if at all, only after the expiration of the design patent.

Id.

¹⁰⁶ The reversal was based on arguments contrary to the Doctrine of Elections. *Mogen David*, 328 F.2d 925 (C.C.P.A. 1964).

¹⁰⁷ *Id.* at 932. See *infra* notes 134-56 and accompanying text.

¹⁰⁸ *Mogen David*, 328 F.2d at 928. See C.K. Wehringer, *Two For One: Trademarks and Design Patents*, 50 TRADEMARK REP. 1158 (1960).

¹⁰⁹ *Mogen David*, 328 F.2d at 928.

¹¹⁰ *Id.* at 929.

¹¹¹ Unfortunately, there is a problem with the following hypothetical put forth by the appellant which persuaded the court:

A is the originator of a distinctive and novel bottle configuration. By use and extensive exploitation for a period of six months as a container for wines, association between the configuration and wines is sufficient to establish secondary meaning in the configuration in relation to wines. Upon application properly supported registration on the Principal Register is issued at the end of ten months after the bottles containing wines are first sold by A. A week later, A files application for a design patent for the configuration in full compliance with the design patent law and so meeting the criteria of patentability. What law or what rule in rhyme or reason would preclude the patent grant or inhibit the concurrent enjoyment of the rights appertaining to both the design patent and the trademark?

Id. at 929-30.

First, there is a five year requirement in section 2 of the Lanham Act. See *supra* note 29. Also consider that this hypothetical design was never left unprotected in the marketplace. Thus, a broad reading of this case has led to different conclusions regarding

tion, which happen to continue beyond the expiration of a design patent, do not "extend" the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it. We know of no provision of patent law, statutory or otherwise, that guarantees to anyone an absolute right to copy the subject matter of any expired patent. Patent expiration is nothing more than the cessation of the patentee's right to exclude held under the patent law.¹¹²

Furthermore, the court stated that "[i]t was within the province of Congress to write an exception in the provisions of the statute to preclude use of the subject matter of a design patent during the life of the patent as trademark use. It did not see fit to do so."¹¹³ Thus, the court took the position that that which Congress did not address should not be addressed by the courts. This position, however, is inconsistent with the holdings by which the court allowed containers to be registered as trademarks¹¹⁴ because registration of containers

protection from competition in the marketplace. Furthermore, recall that in the hypothetical, secondary meaning was obtained prior to the design patent.

Relevant, but not within the scope of this Note, is the doctrine of "secondary meaning in the making" which the Second Circuit first considered in 1974. See *National Lampoon, Inc. v. American Broadcasting Cos.*, 376 F. Supp. 733 (S.D.N.Y.), *aff'd on other grounds*, 497 F.2d 1343 (2d Cir. 1974). Skeptical about the vitality of the doctrine, the Court of Appeals for the Federal Circuit in 1990 noted that "[a]fter considerable study of the matter, we are of the opinion that the Second Circuit, if faced with the question, would reject the doctrine of secondary meaning in the making." *Cicena Ltd. v. Columbia Telecommunications Group*, 900 F.2d 1546, 1550 (Fed. Cir. 1990). In response to *Cicena*, the Second Circuit stated, however, that it had yet to find a proper "secondary meaning in the making" case, implying that the Second Circuit has not rejected the theory. *Murphy v. Provident Mutual Life Ins. Co.*, 17 U.S.P.Q.2d (BNA) 1299, 1304 (2d Cir. 1990).

The debate between the Second Circuit and the Court of Appeals for the Federal Circuit ("CAFC") demonstrates the importance of the CAFC's exclusive jurisdiction over patent-related cases but not over trademark-related cases. See *infra* text following note 207. Thus, a challenge to trademark rights when no patent issue is involved is not decided by the CAFC, but rather by the appellate court of the jurisdiction in which the case arose.

¹¹² *Mogen David*, 328 F.2d at 930. See MANUAL OF PATENT EXAMINING PROCEDURE ch. 1512, at 1500-14 (1991) [hereinafter MPEP]; see also *Product Configurations [Part I]*, *supra* note 74, at 510 (finding dual protection under trademark law and design patent law acceptable because they are "entirely different legal theories"). But cf. *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150, 152 (S.E.D. Pa. 1910) ("The method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision."); *Derenberg, Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1192, 1201 (1964) ("theoretically perpetual monopoly of a configuration that ordinarily would be dedicated to the public upon expiration of the patent").

¹¹³ *Mogen David*, 328 F.2d at 931.

¹¹⁴ See *supra* notes 27-29.

is a concept that Congress did not address either.¹¹⁵ Section 45 of the Lanham Act does not “clearly” include containers in the list of protectible items.¹¹⁶ Therefore, when the court asserted that Congress would have affirmatively acted if they had intended to adopt the Doctrine of Elections, it ignored the basic premise that patent monopolies are expressly limited by constitutional strictures.

The court was apparently not concerned with the possible creation of a perpetual monopoly—a monopoly in which protection afforded after the patent expiration might be broader than the scope of protection allowed during the term of the design patent. More than just affording a longer duration of protection,¹¹⁷ a trademark also facilitates expansion into other classes. While patents must be novel and nonobvious,¹¹⁸ trademark registration has no such requirements.¹¹⁹ This encourages expansive registration of the design in classes not necessarily related to the original. Furthermore, an increase in the number of classes discourages competitors from attempting to adopt the design even in unrelated classes.¹²⁰

¹¹⁵ There is no express provision in the Lanham Act for registration of container or package configurations on the Principal Register. By 1960, however, the Court of Customs and Patent Appeals held that the § 45 list of ‘word, name, symbol or device’ was not an all-inclusive list, but that other types of marks were included within the list. Thus, container configurations also became registrable as trademarks on the Federal Principal Register.

Schuman, *Trademark Protection of Container and Package Configuration—A Primer*, 59 CHI. [-]KENT L. REV. 779, 797 (1983) (footnotes omitted).

¹¹⁶ 15 U.S.C. § 1127 (1988).

¹¹⁷ The perpetual trademark monopoly is not guaranteed. For example, the designer could lose his trademark through lack of use. “A mark shall be deemed to be ‘abandoned’—(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.” *Id.*

¹¹⁸ 35 U.S.C. §§ 102, 103 (1988).

¹¹⁹ Prior art limits the scope of the design patent such that the earliest patent in the field defines the scope of protection. Trademark law does not consider prior art, but only whether the design creates an association with the manufacturer. Therefore, even if Company A acquired registration for a particular design, A’s abandonment and Company B’s subsequent use, sufficient to create an association, would allow Company B to register the mark.

¹²⁰ ALTMAN, CALLMANN UNFAIR COMPETITION TRADEMARKS AND MONOPOLIES § 19.25, at 128 (4th ed. 1990).

Although normally no protection is available for a descriptive . . . mark . . . until the process of acquiring secondary meaning has been concluded, a mark with secondary meaning in-the-making should be protected against those who appropriate it with knowledge or good reason to know of its potential in that regard, or with an intent to capitalize on its goodwill. Whether protection will be granted at this stage depends on the nature of the mark itself.

Id. § 19.25, at 127 (footnotes omitted). The moment one has a design patent, one has an unfair advantage over others in developing the secondary meaning for trademark protection. Moreover, because others need not “knowingly” use the dress to be enjoined, the protection afforded under patent law can be greater than that afforded by trademark law. For a discussion of the status of secondary meaning in the making, see *supra* note 111.

Masquerading a perpetual monopoly in trademark clothing is troublesome, regardless of the size of the monopoly. The *Mogen David* court's holding does not interpret, but rather adopts new public policy in the area of design protection. These views have been followed extensively, even though they are only dicta, since the Mogen David bottle was found to be functional and no trademark registration was allowed.¹²¹

The perpetual monopoly contemplated by *Mogen David* prevents competitors from creating deceptively similar items by effectively eliminating competition. But such a result has a price. With no incentive to make improvements on a product controlled by a single source, the monopoly owner can offer an inferior product or even none at all.¹²² Finally, prices for the product may be higher in the absence of competition.¹²³ This exclusivity may be terminated by abandonment or discontinued use of the design by its owner.¹²⁴

Another important Doctrine of Elections decision was *In re Honeywell, Inc.*¹²⁵ *Honeywell* involved a thermostat cover which originally had been protected by a design patent.¹²⁶ Later, Honeywell applied for trademark registration¹²⁷ claiming that the requirements of secondary meaning had been satisfied. The TTAB denied the application¹²⁸ on similar grounds to those stated in *Mogen David*,¹²⁹ while simultaneously distinguishing the two cases.¹³⁰ Although the *Honey-*

¹²¹ *Mogen David*, 372 F.2d 539 (C.C.P.A. 1967).

¹²² Market forces, however, could force the creation of alternative designs.

¹²³ This conclusion is based on monopolistic economic theory. As demand rises and supply remains the same, the most efficient point of sales would be lost.

¹²⁴ See *supra* note 117.

¹²⁵ 497 F.2d 1344 (C.C.P.A. 1974). Prior to this case, the CCPA stated that "[t]he mere existence of design patent rights is independent of, and immaterial to, the ownership of trademark rights." *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 1015 (C.C.P.A. 1973) (candy bar wrapping design).

¹²⁶ Design Patent No. 176,657 was issued on January 17, 1956 to Henry Dreyfuss and assigned to Minneapolis-Honeywell Regulator Company with a term of 14 years. 702 Off. Gaz. Pat. Office 708 (Jan. 17, 1956).

¹²⁷ Serial No. 306,776 was filed on September 6, 1968. *Honeywell*, 497 F.2d at 1345 n.1. Note that the application for trademark registration occurred prior to the expiration of the design patent.

¹²⁸ *In re Honeywell, Inc.*, 169 U.S.P.Q. (BNA) 619 (T.T.A.B. 1971).

Since applicant's design patent expired in 1970, it is apparent that the issuance of a registration for the same subject matter, including the same mark and goods, would be inconsistent with the right of others under the terms of the patent grant to make fair use of the ornamental design for control instruments including thermostats after the expiration of the patent and that it would serve, in effect, to extend the protection accorded the patented design contrary to the purpose and intent of the patent law.

Id. at 621.

¹²⁹ See *supra* text accompanying note 104.

¹³⁰ The *Mogen David* case relied on by applicant is clearly distinguishable from the instant case in that the applicant was seeking to register the subject matter of the design patent, namely, the design or configuration of a bottle

well decision analyzed the case law more thoroughly than the *Mogen David* court,¹³¹ the TTAB arrived at the same conclusions. The court stated that *Mogen David* was highly relevant and that the *Mogen David* court's

holding recognized the clear distinction between the underlying bases of the federal trademark and design patent laws. Federal design patent laws were created to encourage the invention of ornamental designs. Federal trademark laws, which are independent in origin from the design patent laws, seek to prevent the public from encountering confusion, mistake, and deception in the purchase of goods and services and to protect the integrity of the trademark owner's product identity. With that distinction in mind, this court decided that the public interest—protection from confusion, mistake, and deception in the purchase of goods and services—must prevail over any alleged extension of design patent rights, when a trademark is non-functional and does in fact serve as a means to distinguish the goods of the trademark owner from those of others.¹³²

Thus, the *Mogen David* and *Honeywell* decisions turned the tide completely away from the earlier days of the Doctrine of Elections. By balancing the values of trademark law and design patent law, the *Honeywell* court rejected the Doctrine of Elections and found consumer protection to be more important.¹³³

IV. DISTINGUISHING FUNCTIONALITY AND NONFUNCTIONALITY

Although current case law permits single nonfunctional designs to be afforded both patent and trademark protection, functional items do not receive such dual protection because they cannot be registered as trademarks.¹³⁴ The rule prohibiting functional items from receiving trademark protection "is not mandated by statute, but is 'deduced entirely from court deci-

or container for a product contained therein, namely, wine and not for a bottle or container, per se, whereas here applicant is seeking to register the design of the product for the product itself.

Honeywell, 169 U.S.P.Q. at 622.

¹³¹ The Trademark Trial and Appeal Board considered the following cases which the Court of Customs and Patent Appeals later distinguished: *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249 (1945). *Honeywell*, 497 F.2d at 1347-49.

¹³² *Honeywell*, 497 F.2d at 1348.

¹³³ *Id.*

¹³⁴ Functional items also cannot receive copyright protection. 17 U.S.C. § 102(b) (1988) ("[i]n no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery").

sions.’”¹³⁵ The public policy for this court derived rule is “the need to accomodate [sic] trademark and unfair competition law with functional patent law.”¹³⁶ This need is fulfilled by preventing inventors of functional items from attempting “an end-run around functional patent law requirements.”¹³⁷

There is no fear, however, that registering nonfunctional design features as trademarks forms an “end-run” around design patent law.¹³⁸ Designs are presently protected under both trademark and design patent law on the theory that nonfunctional or nonutilitarian trademarks are incidental to the use of the basic article while the functional features are essential to such use.¹³⁹ Therefore, even if a particular design on an article serves as a trademark, the article may still be produced, but with a different design.

The prohibition on trademark protection for functional designs has been rationalized as necessary to prevent an extension of utility patent protection through trademark registration. This rationalization, however, is problematic. The Constitution does

¹³⁵ *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982) (quoting *In re Mogen David Wine Corp.*, 328 F.2d 925, 932 (C.C.P.A. 1964) (Rich, J., concurring)).

¹³⁶ 1 MCCARTHY, *supra* note 24, § 7:26, at 236.

[It] is not that [functional features] cannot or do not indicate source to the purchasing public but that there is an overriding public policy of preventing their monopolization, of preserving the public right to copy. A certain amount of purchaser confusion may even be tolerated in order to give the public the advantages of free competition.

In re Diester Concentrator Co., 289 F.2d 496, 504 (C.C.P.A. 1961). The recognition of a functional feature as an indication of source is merely “de facto secondary meaning,” and carries no weight in overcoming the feature’s functionality to make it registrable as a trademark. 1 MCCARTHY, *supra* note 24, § 7:26, at 237-38.

Although the functionality doctrine recognizes the need to preclude protection for useful product features that may have been protected under a utility patent for a limited period, the basis for precluding protection is the concern that useful product features should be freely accessible and not that an inherent conflict between the utility patent and trademark laws exists.

Note, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 *FORDHAM L. REV.* 345, 359 (1982) (footnotes omitted) [hereinafter *Broad Sweep*]. *Broad Sweep* is strongly critical of the Doctrine of Elections. *Id.* at 357-58.

¹³⁷ 1 MCCARTHY, *supra* note 24, § 7:26, at 236. “Functional product and packaging designs are incapable of trademark protection in light of the important public policy of allowing and promoting free competition so that no one gains exclusive rights in useful product features, except under the patent laws.” Kevlin, *Review of the 1985 Trademark Decisions of the Court of Appeals for the Federal Circuit*, 35 *AM. U.L. REV.* 1149, 1162 (1986) [hereinafter Kevlin] (citing *Broad Sweep*, *supra* note 136, at 346-47).

¹³⁸ *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A. 1974) (“public interest [in] protection from confusion, mistake, and deception . . . must prevail over any alleged extension of design patent rights”).

¹³⁹ 1 MCCARTHY, *supra* note 24, § 7:26, at 236.

“The functionality doctrine more discriminately assigns to the public domain that which is most appropriate—useful product features that are important enough to competition to require their accessibility for public use.” *Broad Sweep*, *supra* note 136, at 359.

not distinguish between functional and nonfunctional inventions. Therefore, by stating that trademark registration would extend utility patent protection, it must follow that trademark registration would extend design patent protection. While Congress' power to provide patent protection is optional, any right granted must be limited in time whether a design or utility patent.¹⁴⁰ One commentator has stated that "[i]f there is to be legal protection for functional features, such protection can only be gained by utility patent protection limited in time, not perpetual protection under trademark law."¹⁴¹ Therefore, rationalizing that trademark registration would extend utility patent protection¹⁴² is inconsistent with the theory that no perpetual monopoly occurs with designs protected as trademarks after the issuance of a design patent.¹⁴³

The courts have also distinguished functional and nonfunctional features on the basis of necessary designs, where few possible designs are available, and unnecessary designs, where a purely arbitrary design is used.¹⁴⁴

The burden on competition in such a case is so great, regardless of economic viewpoint, that as a matter of public policy, protection cannot be granted. The fact that the monopoly given is perpetual is really irrelevant. The impact on potential competition of the monopoly is or should be the controlling

¹⁴⁰ U.S. CONST. art. I, § 8, cl. 8. "The constitutional provision is not self-executing. It empowers but does not command the Congress to grant patent rights." *Cali v. Japan Airlines, Inc.*, 380 F. Supp. 1120, 1124 (E.D.N.Y. 1974), *aff'd*, 535 F.2d 1240 (2d Cir. 1975). *Cali* has been cited to stand for the broad proposition that the commerce clause and the patent and copyright clause are separate and distinct. However, the facts of the case specifically dealt with foreign commerce and treaties, and did not involve domestic commerce.

¹⁴¹ 1 MCCARTHY, *supra* note 24, § 7:26, at 236. This quote from Professor McCarthy does not necessarily represent his views. However, it does demonstrate some of the confusion in understanding the policies for preventing trademark registration of functional items.

¹⁴² *Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 732 (3d Cir. 1957) ("The purpose of this rule is obviously to prevent the grant of perpetual monopoly by the issuance of a trade-mark in the situation where a patent has . . . expired."); *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195 (C.C.P.A. 1969) (A functional configuration is only protectible for a limited time under patent law and cannot be registered as a trademark.); *see also* Zelnick, *The Doctrine of "Functionality"*, 73 TRADEMARK REP. 128, 129 (1983) [hereinafter Zelnick] ("If the thing copied is 'functional' then to prohibit its use would be anticompetitive—to grant a *pseudo patent*; but if it is not functional, prohibiting its use would be competitively inconsequential and thus appropriate, if necessary to avoid confusion.") (emphasis added).

¹⁴³ *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964). *But see* 1 DELLER, *supra* note 1, § 20, at 134 (design and utility patents should be treated as if on the same "high plane") (citing *Western Elec. Mfg. Co. v. Odell*, 18 F. 321 (N.D. Ill. 1883)); *Goudy v. Hansen*, 247 F. 782 (1st Cir. 1917).

¹⁴⁴ *Mogen David*, 328 F.2d at 933 (Rich, J., concurring).

factor.¹⁴⁵

Some courts have expanded the scope of characteristics that have been found to be functional to further competition in the marketplace—even when the design has arbitrary, nonfunctional, and secondary meaning attributes. This is known as “aesthetic functionality.” “Under the theory of ‘aesthetic functionality’ visually attractive and aesthetically pleasing designs are categorized as ‘functional’ and hence free for all to copy and imitate.”¹⁴⁶

One of the first cases discussing aesthetic functionality was *Pagliari v. Wallace China Co.*¹⁴⁷ Plaintiff was a manufacturer of china and created many patterns for use on plates. Plaintiff, in conjunction with its product, “acquired a reputation . . . for the excellence and attractiveness of its designs . . . [and] the allegedly superior quality of its product.”¹⁴⁸ None of the designs had been copyrighted, patented, or registered as trademarks. Plaintiff claimed unfair competition.

The court refused to enjoin the defendant from using the designs on the ground that effective competition would be inhibited if the plaintiff's designs were protected. Protection would only be available for arbitrary designs which were “unrelated to basic consumer demands.”¹⁴⁹ The court, by its ruling, expanded the definition of functionality to include “the attractiveness and eye-appeal” of the design¹⁵⁰ as well as the commercial success of the product.¹⁵¹ Moreover, the court found that while the designs may have been an indication of source, the need for competition was more important.¹⁵²

¹⁴⁵ Zelnick, *supra* note 142, at 133. As Judge Rich noted, “‘Functionality’ is determined in light of ‘utility,’ which is determined in light of ‘superiority of design,’ and rests upon the foundation ‘essential to effective competition.’” *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340 (C.C.P.A. 1982).

¹⁴⁶ 1 McCARTHY, *supra* note 24, § 7:26, at 243. Generally, the 1938 *Restatement of Torts* is regarded as the source of the theory. “When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended.” RESTATEMENT OF TORTS § 742 comment a (1938). One commentator, however, views earlier case law as the origin. Duft, “Aesthetic” Functionality, 73 TRADEMARK REP. 151, 167-74 (1983).

¹⁴⁷ 198 F.2d 339 (9th Cir. 1952).

¹⁴⁸ *Id.* at 340. Although the court later found the designs to be functional, the requirements of secondary meaning apparently were satisfied. *Id.* at 343. For a discussion of secondary meaning, see *supra* notes 27-29 and accompanying text.

¹⁴⁹ *Pagliari*, 198 F.2d at 343.

¹⁵⁰ *Id.* at 343-44.

¹⁵¹ *Id.* at 343.

¹⁵² *Id.* at 344. “Of course, [defendant] can also compete by developing designs even more aesthetically satisfying, but the possibility that an alternative product might be developed has never been considered a barrier to permitting imitation competition in

The theory of aesthetic functionality is not well accepted.¹⁵³ Professor McCarthy calls it "an unwarranted and illogical expansion of the functionality policy, carrying it far outside the utilitarian rationale which created the policy."¹⁵⁴ To protect such policies, Professor McCarthy proposes use of the "mere ornamental" rule which considers the consumer's perception as to whether a design is merely ornamental or an indication of source.¹⁵⁵

other types of cases." *Id.* Thus, under this theory, even though other designs are clearly available, the consumer demand for one particular design makes it unprotectible.

¹⁵³ 1 MCCARTHY, *supra* note 24, § 7:26, at 247-48. *But cf. Oddi, Consumer Motivation in Trademark and Unfair Competition Law: On the Importance of Source*, 31 VILL. L. REV. 1, 74 (1986) [hereinafter *Consumer Motivation*] ("denying competitors access to . . . nonutilitarian features could adversely affect competition in products in the public domain").

For a survey of the federal circuits and some state courts, see 1 MCCARTHY, *supra* note 24, § 7:26. The Third, Fifth, and Federal Circuits, as well as the Patent and Trademark Office, have expressly rejected the theory of aesthetic functionality. *Id.* (citing *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136 (3d Cir. 1986); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417 (5th Cir. 1984); *In re Deere & Co.*, 7 U.S.P.Q.2d (BNA) 1401 (T.T.A.B. 1988)). The rejection of the theory by the Federal Circuit is a continuation of the policy initiated by the Court of Custom and Patent Appeals. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) was followed by *In re Bose Corp.*, 772 F.2d 886 (Fed. Cir. 1985) and *Textron, Inc. v. ITC*, 753 F.2d 1019 (Fed. Cir. 1985). Courts which implicitly reject the theory are the Sixth and Eleventh Circuits. 1 MCCARTHY, *supra* note 24, § 7:26 (citing *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084 (6th Cir. 1983); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966 (11th Cir. 1983)). Finally, courts which have been inconsistent in their holdings include the Second, Seventh, Ninth, and Tenth Circuits. *Id.* See also Peroff & Deckinger, "Conditional" Functionality: The New Standard for Evaluating "Aesthetic" Functionality Established by the Second Circuit in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.*, 1 FORDHAM ENT., MEDIA & INTELL. PROP. L.F. 117 (1991) [hereinafter "Conditional" Functionality]. The Eighth Circuit approves of the doctrine of aesthetic functionality. *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 98 (S.D. Iowa 1982), *aff'd per curiam*, 721 F.2d 253 (8th Cir. 1983) (green color of a farm loader is aesthetically functional because farmers prefer to match the color of the loader with the tractor).

¹⁵⁴ 1 MCCARTHY, *supra* note 24, § 7:26, at 247. Furthermore, "application of the 'aesthetic functionality' theory can only result in more consumer confusion as to the source of products." *Id.* Professor McCarthy does have critics. See *Consumer Motivation*, *supra* note 153.

[A]s an affirmative defense, the copier should have the opportunity to establish that consumers are motivated to purchase the product for nonutilitarian reasons and that competition would be adversely affected if copying were barred. Admitting such an affirmative defense would conflict with present CAFC practice in registration cases, but is consistent with the policy rationale of the Lanham Act—protecting trade identity and consumers—as recently restated by the Supreme Court in [*Inwood Laboratory, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 861-62 (1982)]. Additionally, on balance this approach would still provide a reasonable incentive for the creation of aesthetically pleasing and unique products by placing the burden on the copier to justify its copying on competitive grounds.

Id. at 78-79 (footnote omitted); see also *Copying Methods*, *supra* note 61, at 262.

If legal-economic policy is based on competition, and if the essence of competition is copying, then courts should rarely forbid competitors to copy methods of product differentiation such as product and package design and configuration, even if a particular court believes consumers regard a method of differentiation as a symbol of origin.

Id.

¹⁵⁵ 1 MCCARTHY, *supra* note 24, § 7:26, at 247-48. See "Conditional" Functionality, *supra*

Because the Doctrine of Elections only applies to nonfunctional items, it is necessary to understand the scope of functionality. It has been noted, however, that “[d]espite use of the functionality concept for approximately sixty years there is still no judicial agreement as to its present or proper scope.”¹⁵⁶ Today, with no Supreme Court decision in this area and not much progress in reaching judicial accord, the confusion concerning the functionality concept has passed its eighty-fifth birthday.

V. COPYRIGHT CONFLICTS IN THE DOCTRINE OF ELECTIONS¹⁵⁷

Copyright law is derived from the same clause of the Constitution as patent law.¹⁵⁸ The Copyright Act provides the author or creator of a work copyright protection immediately upon creation—neither registration nor notice is required.¹⁵⁹ In addition to the copyright laws enacted by Congress, the Copyright Office, which is independent of the Patent and Trademark Office, has the authority to enact its own regulations,¹⁶⁰ including identifying material which cannot be registered. “Under this authority, the Copyright [Office] has established a policy of refusing to register material which has already been protected by issued design patent.”¹⁶¹ Supporting the Doctrine of Elections, section 202.10(a) of the Copyright Office regulations states in relevant part:

The potential availability of protection under the design patent law will not affect the registrability of a pictorial, graphic, or sculptural work, but a copyright claim in a patented design

note 153, at 127. (“It would appear that the ‘merely ornamental rule’ is, in essence, the modern name for the doctrine of secondary meaning as applied specifically to ornamental features of trade dresses.”). For additional discussion of “mere ornamentation,” see generally Oddi, *The Functions of “Functionality” in Trademark Law*, 22 Hous. L. Rev. 925, 953-54 (1985) and *In re Burgess Battery Co.*, 112 F.2d 820 (C.C.P.A. 1940) (finding black and white striped battery label design as “mere ornamentation” and not primarily recognized as an indication of source).

¹⁵⁶ *Developments in the Law—Competitive Torts*, 77 HARV. L. REV. 888, 919 (1964).

¹⁵⁷ The Copyright Office and the Patent and Trademark Office are conducting a joint study concerning the possible overlap between patent and copyright protection. Letter from Dorothy Schrader, General Counsel, Copyright Office, to Douglas R. Wolf (Mar. 14, 1991) [hereinafter Schrader letter]. At the earliest, the study will be released to the public in August 1991.

¹⁵⁸ U.S. CONST. art. I, § 8, cl. 8.

¹⁵⁹ 17 U.S.C. § 408(a) (1988) (“At anytime during the subsistence of copyright in any published or unpublished work, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim Such registration is not a condition of copyright protection.”); *id.* § 401(a) (“notice of copyright . . . may be placed on . . . copies”).

¹⁶⁰ 17 U.S.C. § 702 (authorizing the Register of Copyrights to establish regulations).

¹⁶¹ Letter from Kent Dunlap, Principal Legal Advisor, Copyright Office, to Douglas R. Wolf (Apr. 17, 1991) [hereinafter Dunlap letter].

or in the drawings or photographs in a patent application will not be registered after the patent has been issued.¹⁶²

The Patent and Trademark Office, on the other hand, will issue a patent on a qualified submission regardless of whether the design has been afforded copyright registration.¹⁶³ Even if a creator neglects to obtain copyright registration before design patent protection¹⁶⁴—which would avoid refusal under section 202.10(a)—legal action under copyright law is not precluded.¹⁶⁵ “However, the availability of statutory damages and attorney’s fees under section 412 in cases where a copyright claim has been refused registration is unclear.”¹⁶⁶

Although circumventing section 202.10(a) is not difficult, understanding its purpose is.¹⁶⁷ The Copyright Office states that its purpose adheres to both case law and congressional intent.¹⁶⁸ Among the cases which the Copyright Office cites is *Louis De Jonge & Co. v. Breuker & Kessler Co.*,¹⁶⁹ one of the earliest Doctrine of Elections cases.¹⁷⁰ The *De Jonge* court found that the protections afforded under copyright law and design patent law are different, and, therefore, the creator “must decide to which region of intellectual

¹⁶² 37 C.F.R. § 202.10(a) (1990).

¹⁶³ The Copyright Office does not actively police the possible issuance of design patent for the design submitted for copyright registration. However, if a Copyright Examiner learns of the existing design patent, copyright registration will be refused. Telephone interview with Kent Dunlap, Principal Legal Advisor, Copyright Office (Feb. 28, 1991) [hereinafter Interview with Dunlap].

¹⁶⁴ If copyright and design patent applications are filed simultaneously, there should be no section 202.10(a) refusal. Design patents often take two years before the first office action.

¹⁶⁵ 17 U.S.C. § 411(a) (“where . . . registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights”).

¹⁶⁶ Dunlap letter, *supra* note 161.

The policy behind the withdrawal of statutory damages and attorney’s fees for a delayed registration is to promote timely registration. Clearly where a copyright claim has been refused registration, the applicant is faultless in his inability to make a timely registration. Therefore, it would appear that the preferred statutory construction of section 412 would allow the date of refusal to be taken as the date of registration for purposes of statutory damages and attorney’s fees.

Id.; see 17 U.S.C. § 412.

¹⁶⁷ The regulation first appeared in 24 Fed. Reg. 4958 (June 18, 1959) (codified at 37 C.F.R. § 202). The Copyright Office, however, states that “[t]he existing regulation represents a policy adopted . . . at least since 1956.” Schrader letter, *supra* note 157. There is little published history concerning the regulation. Comment, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Design*, 49 ST. JOHN’S L. REV. 543, 566 n.128 (1975) [hereinafter Comment].

¹⁶⁸ Interview with Dunlap, *supra* note 163.

¹⁶⁹ 182 F. 150 (S.E.D. Pa. 1910), *aff’d on other grounds*, 191 F. 35 (3d Cir. 1911), *aff’d*, 235 U.S. 33 (1914).

¹⁷⁰ For additional discussion of *De Jonge*, see *supra* notes 62-64 and accompanying text.

effort the work is to be assigned."¹⁷¹

Another case which the Copyright Office relies upon as its "primary authority underlying regulation 202.10(a)"¹⁷² is *Korzybski v. Underwood & Underwood, Inc.*¹⁷³ *Korzybski*, a case decided by the Court of Appeals for the Second Circuit, was heard by a three member panel which included Judges Learned Hand and Augustus Hand. Judge Augustus Hand wrote the unanimous opinion. In *Korzybski*, the plaintiff sought to enjoin infringement of his geometric design under copyright law. The court, however, dismissed the complaint stating that "it is not necessary to decide whether, on general principles, such a model could be copyrighted, because the author . . . applied for a [design] patent."¹⁷⁴ The court, in dicta, indicated that it would afford simultaneous protection for an article under both utility patent law, for the functional features, and copyright law, for the nonfunctional features. This is different from holding that design patent and copyright protection can cover a single feature.¹⁷⁵

The *Korzybski* holding was based on two arguments commonly made in support of the Doctrine of Elections. First, the court found that the protection afforded under copyright law would extend the protection already granted by patent law.¹⁷⁶ Second, once a design is dedicated to the public through design patent law, it cannot be removed.¹⁷⁷ The Copyright Office's argument that there cannot be dual protection through design patent law and copyright registration is a slight variation from the reasoning of the *Korzybski* court. The Copyright Office's contention that Congress never intended patent and copyright law to overlap is also supported by case law.

Congress has provided two separate and distinct fields of protection, the copyright and the patent. . . . While it may be

¹⁷¹ *De Jonge*, 182 F. at 152. "The author or owner is driven to his election, and must stand by his choice." *Id.* See also *Jones Bros. v. Underkoffler*, 16 F. Supp. 729, 731 (N.D. Pa. 1936) (quoting *De Jonge*, 182 F. at 151-52).

¹⁷² Dunlap letter, *supra* note 161.

¹⁷³ 36 F.2d 727 (2d Cir. 1929).

¹⁷⁴ *Id.* at 728.

¹⁷⁵ *Id.* at 729.

¹⁷⁶ "An inventor who has applied for and obtained a patent cannot extend his monopoly by taking out a copyright . . . on what he has already diagrammatically disclosed." *Id.* The court was careful to draw the distinction between design patents and utility patents. While not directly expressing an opinion, the court appeared not to disapprove of simultaneous protection for an item by both utility patent and copyright. *Id.*

¹⁷⁷ When *Korzybski* filed his application and received his patent, he made a full disclosure of his invention and dedicated it to the public, save for the right to make, use, and vend it during the period for which the patent gave him that monopoly. The public had the right to the information disclosed in his patent and the right to use and copy the text and diagrams.

difficult to determine in which field protection must be sought, it is plain, so we think, that it must be in one or the other; it cannot be found in both. In other words, there is no overlapping territory, even though the line of separation may in some instances be difficult of exact ascertainment.¹⁷⁸

The Copyright Office supports regulation 202.10(a) on additional grounds:

In addition to the *Korzybski* decision and other case law support, the Copyright Office believes regulation 202.10(a) yields the soundest public policy. Both the design patent act and the copyright law are intended to foster the creation of new, original, ornamental designs, and the public benefits from the creation of such designs. Both statutes, however, contain important limitations. While the design patent act establishes an absolute monopoly, it lasts for a relatively short duration of fourteen years. Protection under copyright, on the other hand, lasts for life of the author plus fifty years, but protects only against copying. In framing the patent and copyright systems, it is clear that Congress considered these limitations highly important. Yet, if design patent and copyright can cover the same design, these limitations are effectively negated. Under design patent, the owner would receive an absolute monopoly of fourteen years. After expiration of that term, however, the design would not go into the public domain as intended by Congress. Instead, it would then be protected against copying for an additional term of life of the author, plus fifty years. The public would receive the benefit of only one design, yet the owner would benefit from a "super monopoly" unaffected by important limitations in both the patent and copyright statutes. In the absence of any clear indication that Congress intended such an expansive system of protection to apply to certain designs, the Copyright Office believes the sounder public policy requires an owner to elect between systems of protection.

Another significant underpinning of Copyright Office policies on dual protection was the Patent Office practice of requiring the removal of copyright notices from drawings

¹⁷⁸ *Taylor Instrument Cos. v. Fawley-Brost Co.*, 139 F.2d 98, 99 (7th Cir. 1943). It is important to notice that the separation of fields in *Taylor* was not limited to design patents and copyrights but to all types of patents. Thus, instead of stating that only design patent protection overlaps with copyright protection, the *Taylor* court found that the laws in general were created separately with the intention of affording separate protections. The *Taylor* court also cited *Baker v. Selden*, 101 U.S. 99 (1879). *Taylor*, 139 F.2d at 99-100. The Supreme Court in *Baker*, however, did not find that one form of protection was required over another. The Court merely distinguished the protections afforded by patent and copyright law.

published in the [Official Gazette of the United States Patent Office ("Patent Gazette")]. Under the copyright law in effect at the time regulation 202.10(a) was adopted, a general publication without notice of copyright divested copyright protection. Although the Patent Office abandoned its practice of requiring the removal of copyright notices from drawings published in the *Patent Gazette* in 1987,¹⁷⁹ the Copyright Office has not considered modifying its regulation in light of this recent development.¹⁸⁰

In addition to interpreting congressional intent as supporting regulation 202.10(a), the Copyright Office also considers dual protection to extend the original patent monopoly.¹⁸¹ This view is supported by *In re Blood*,¹⁸² which stated that dual registration for a

¹⁷⁹ 1077 Off. Gaz. Pat. Office 22 (Apr. 21, 1987) (footnote in original). A copyright notice, however, is permitted. MPEP, *supra* note 112, ch. 1512, at 1500-13 to -14.

¹⁸⁰ Dunlap letter, *supra* note 161.

¹⁸¹ *Id.*

"Since the machines which cooperate with the charts in suit are useless without them, to copyright the charts would in effect continue appellant's monopoly of its machine beyond the time authorized by the patent law." *Brown Instrument Co. v. Warner*, 161 F.2d 910, 911 (D.C. Cir. 1947); see also Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 50 (1953) [hereinafter *Borderland*] ("[O]nce the artist seeks shelter under one statute, protection under the other is lost. The primary rationale for this position is probably fear of undue extension of exclusive rights . . .").

"[T]he argument is made that if the designer acquires a patent, giving him the exclusive right to use, manufacture, and sell the design, a concurrent or subsequent copyright would for all practical purposes amount to an extension of the design monopoly." Comment, *supra* note 167, at 566. *But see* Casenote, *Patents-Copyrights—Designs for Articles May Be Protected Under Both Design Patents and Copyrights Simultaneously*, 21 WAYNE L. REV. 1239, 1244-45 (1975) [hereinafter *Patents-Copyrights*] (refuting *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927), on grounds similar to those in *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964)). The *Mogen David* court found that trademark and design patent law stemmed from different statutes and afforded different protections, and therefore trademark registration did not create an extension of design patent protection. See *supra* notes 98-124 and accompanying text. Recall, however, that trademark law and patent law are based on separate constitutional clauses, unlike copyright and patent law which stem from the same clause. Moreover, election is more easily argued on a constitutional level between copyright and patent law than between trademark and patent law. The phrase "exclusive Right to their respective Writings and Discoveries" in the patent and copyright clause of the Constitution arguably indicates an intended separation of the two forms of protection. *In re Yardley*, 493 F.2d 1389, 1392 (C.C.P.A. 1974) (citing the TTAB decision). Affording dual protection to a design may thus be a constitutional violation. See Kline, *Requiring an Election of Protection for Patentable/Copyrightable Computer Programs (Part I)*, 67 J. PAT. TRADEMARK OFF. SOC'Y 280, 297 (1985) [hereinafter *Requiring an Election I*] (copyright would be an "impermissible enlargement of the patent monopoly . . . of questionable constitutional validity"). *But see Patents-Copyrights, supra*, at 1246 ("[c]oexisting copyright and patent protections do not create a constitutionally impermissible monopoly"); Note, *The Protectability of Package, Container, and Product Configurations [Part II]*, 6 U.S.F. L. REV. 172, 194 (1971) ("The commerce clause and the patent and copyright clause are found in the same sentence of the Constitution. The constitutional stature of the Lanham Act, passed pursuant to the commerce clause, is equal in magnitude to the patent law.").

¹⁸² 23 F.2d 772 (D.C. Cir. 1927).

design would be a constructive extension of design patent protection.¹⁸³ For the most part, however, case law is not extensive.¹⁸⁴ In fact, the Supreme Court in *Mazer v. Stein*¹⁸⁵ expressly avoided the issue of dual protection altogether.¹⁸⁶ The Court only found that merely because the *Mazer* statuettes could have been afforded design patent protection did not preclude them from obtaining copyright protection. The Department of Justice ("DOJ"), on the other hand, has discussed dual protection. In response to a request for comments on the Design Protection Act of 1962, which, if passed, would have made design protection *sui generis*, the DOJ wrote: "It is the view of the Department that the bill would solve none of the difficulties arising from the dual protection afforded by the design-patent provisions of title 35 and the copyright provision of title 17, as exemplified in the case of *Mazer v. Stein*"¹⁸⁷

One of the most important Doctrine of Elections cases occurred in 1974 when the CCPA decided *In re Yardley*.¹⁸⁸ The appellant was a manufacturer of watches with a caricature of Spiro Agnew on the face. The appellant applied for design patent protection after having secured copyright registration.¹⁸⁹ The Patent Office Board of Appeals ("Board") rejected the application in part because of the

¹⁸³ *Id.* For a further discussion of *Blood*, see *supra* notes 65-67 and accompanying text.

¹⁸⁴ *Borderland*, *supra* note 181, at 69-70.

As a matter of logic, it does not seem objectionable to allow both types of protection on different aspects of the same article. . . . However, as a practical matter, the traditional reluctance of the courts, in adjudications in the public law field, to extend unduly exclusive rights to individuals, should not be regarded lightly, whether or not this is thought of as an unwarranted monopoly phobia.

Id. at 69 n.168 (citations omitted). See also Note, *Design Patents and Copyrights: The Scope of Protection*, 21 GEO. WASH. L. REV. 353, 364-67 (1953) (a single design should not be afforded dual protection).

¹⁸⁵ 347 U.S. 201 (1953).

¹⁸⁶ *Id.* at 217. The Copyright Office considers *Mazer* as supporting the proposition that dual protection should not be available. Interview with Dunlap, *supra* note 163. Support is not clearly found because the Court explicitly refused to discuss dual protection. "Though other courts have passed upon the issue as to whether allowance by the election of the author or patentee of one bars a grant of the other, *we do not.*" *Mazer*, 347 U.S. at 217 (emphasis added). Any reading of *Mazer* to determine the Court's view on dual protection is pure speculation.

¹⁸⁷ S. REP. NO. 1725, 87th Cong., 2d Sess. 16 (1962). The DOJ letter went on to state that "[i]t would appear that the bill would compound these difficulties by adding a third category of monopoly of doubtful constitutionality and which would serve only unduly to burden commerce without concomitant benefits to the public." *Id.* This follows the Copyright Office's argument that each protection for an owner should yield a design to the public. Therefore, dual protection is merely giving the owner an extra protection without additional benefit to the public. See *supra* text accompanying notes 179-80.

¹⁸⁸ 493 F.2d 1389 (C.C.P.A. 1974).

¹⁸⁹ *Id.* at 1391-92. See also *Ex parte Guild*, 98 U.S.P.Q. (BNA) 464, 465 (Pat. Off. Bd. of App. 1952), *aff'd on other grounds*, 204 F.2d 700 (C.C.P.A. 1953) (Board affirmed the Primary Examiner's decision that copyright registration for a design for a building roof barred design patent protection due to election theory under *Blood* and *De Jonge*).

existing copyright registration. The CCPA reversed. In contrast to the Copyright Office's argument that Congress never intended to allow dual protection, the CCPA in *Yardley* took the opposite view. The CCPA stated that Congress never intended that there *not* be dual protection. Furthermore, the CCPA argued that by creating an overlap of subject matter available for protection under each law, Congress implicitly approved of dual protection.¹⁹⁰ This argument, however, is questionable. Just because Congress has created an area of legal overlap between protectible subject matter, it does not necessarily follow that dual protection was intended. The creation of an area of overlap may simply mean that the *potential* for protection under one law does not preclude the design from actually receiving protection under the other.¹⁹¹

The CCPA in *Yardley* looked for support in *Mazer*.¹⁹² "To paraphrase the Supreme Court in *Mazer v. Stein*: Neither the copyright statute nor the patent statute says that because a thing is copyrighted it may not be patented as a design. We should not so hold."¹⁹³ This paraphrase of *Mazer* is wrong.¹⁹⁴ "*Mazer* stands for no more than the proposition that a work is not barred from copyright protection simply because of its *potential* patentability."¹⁹⁵ By not paraphrasing the Supreme Court decision in terms of potential protection after the Court expressly refused to rule on simultaneous dual protection, the CCPA could not have been following Supreme Court precedent.

No case has ever been litigated based on section 202.10(a).¹⁹⁶

¹⁹⁰ We believe that the "election of protection" doctrine is in direct conflict with the clear intent of Congress The Congress has provided that subject matter of the type involved in this appeal is "statutory subject matter" under the copyright statute and is "statutory subject matter" under the design patent statute, but the Congress has *not* provided that an author-inventor must elect between securing a copyright or securing a design patent. Therefore, we conclude that it would be contrary to the intent of Congress to hold that an author-inventor *must* elect between the two available modes of securing exclusive rights.

Yardley, 493 F.2d at 1394 (emphasis in original).

¹⁹¹ See *Mazer v. Stein*, 347 U.S. 201, 217 (1953).

¹⁹² *Id.*

¹⁹³ *Yardley*, 493 F.2d at 1395.

¹⁹⁴ The text that the *Yardley* court incorrectly paraphrased is as follows: "Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold." *Mazer*, 347 U.S. at 217. For additional text in *Mazer* preceding this passage, see *supra* note 186.

¹⁹⁵ *Requiring an Election I*, *supra* note 181, at 292 (emphasis in original) (*Mazer* is "neutral on the election of protection issue"); MPEP, *supra* note 112, ch. 1512, at 1500-14; *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 642 (2d Cir. 1958) (L. Hand, J.), *modifying* 155 F. Supp. 932 (S.D.N.Y. 1957).

¹⁹⁶ "The regulation has never been challenged in court, perhaps because it is easy to avoid the negative consequences . . . by applying for copyright registration before patent issuance." Schrader letter, *supra* note 157.

The Copyright "Office has not considered the *In re Yardley* case as representing negative precedent: the court did not have jurisdiction of copyright cases."¹⁹⁷ Therefore, without a resolution of the issues relating to the Doctrine of Elections by the Supreme Court or Congress, section 202.10(a) survives.¹⁹⁸

VI. FUTURE RULINGS

To create uniformity in patent law¹⁹⁹ and to ease the heavy case load of the federal appellate courts,²⁰⁰ the United States Court of Appeals for the Federal Circuit ("CAFC") was formed by the merger of the appellate jurisdiction of the Court of Claims and the Court of Customs and Patent Appeals.²⁰¹ While the CAFC uses the Court of Claims and the CCPA decisions as precedent,²⁰² the court has been known to veer from prior decisions.²⁰³ Additionally, "[w]hen necessary, the court modified these precedents or created new law."²⁰⁴ Since the CAFC has exhibited independence from its predecessors,²⁰⁵ adherence to

¹⁹⁷ *Id.* But see *Zachary v. Western Publishing Co.*, 75 Cal. App. 3d 913, 923-24, 143 Cal. Rptr. 34, 42 (Cal. Ct. App. 1977) ("*Korzybski* is no longer the law since . . . federal courts now recognize an overlap between the protections of the patent and copyright statutes") (citing *Yardley*, 493 F.2d at 1395).

¹⁹⁸ If Congress enacted a statute that permitted designs to obtain both copyright and design patent protection, the Copyright Office would accept the legislation. However, the Copyright Office has indicated that it would be better public policy not to allow such dual protection. Interview with Dunlap, *supra* note 163.

¹⁹⁹ The purpose of the Federal Courts Improvement Act of 1982 was "to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law." H.R. REP. NO. 312, 97th Cong., 1st Sess. 23 (1981).

²⁰⁰ Thompson, *Increasing Uniformity and Capacity in the Federal Appellate System*, 11 HASTINGS CONST. L.Q. 457 (1984); see also R. POSNER, *THE FEDERAL COURTS* 65 (1985) (an increase of 686% in a 23 year period).

²⁰¹ Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (codified as amended throughout 28 U.S.C. (1982)). The CAFC debuted on October 1, 1982. For a discussion of the jurisdiction of the CAFC, see Drabiak, *Jurisdiction of the New Court of Appeals for the Federal Circuit*, 73 ILL. B.J. 218 (1984) [hereinafter Drabiak, *Jurisdiction*]. For a detailed history of the CAFC, see Hale, *The "Arising Under" Jurisdiction of the Federal Circuit: An Opportunity For Uniformity in Patent Law*, 14 FLA. ST. U.L. REV. 229 (1986).

²⁰² Drabiak, *Jurisdiction*, *supra* note 201, at 218; see *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982) ("We hold that the holdings of our predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, announced by those courts before the close of business September 30, 1982, shall be binding as precedent in this court.").

²⁰³ Sobel, *The Shift in Patent Law Following the Establishment of the Court of Appeals for the Federal Circuit*, in PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK (PLI 1989).

²⁰⁴ Bender, Griffen & Lipsey, *Patent Decisions of the United States Court of Appeals for the Federal Circuit: The Year 1985 in Review*, 35 AM. U.L. REV. 995, 997 (1986).

²⁰⁵ "The Federal Circuit has, in its brief existence [sic], turned around years of bad patent case law, and has firmly established that the presumption of validity now really means something in patent cases." Saidman & Mondry, *Sneakers, Design Patents and Sum-*

previous doctrine should not automatically be assumed.²⁰⁶ While the CAFC has not discussed the Doctrine of Elections in depth, it has rejected the Doctrine with respect to the overlap of trademark and design patent protection.²⁰⁷

Even with this apparent rejection, the Doctrine may still be viable in appellate courts. The CAFC does not have jurisdiction over non-patent issues unless there are patent issues also pending. In order for an appellate court other than the CAFC to review a Doctrine of Elections case, the design patent at issue must have expired or have been previously found invalid. Therefore, if a state or federal court were to uphold an aspect of the Doctrine of Elections, it is conceivable that forum shopping would occur.²⁰⁸ Moreover, the CAFC could be forced to accept holdings that support the Doctrine of Elections because “[w]hen deciding appeals from district court patent cases that involve non-patent issues, the Federal Circuit applies the law of the circuit in which the district court is located.”²⁰⁹ Therefore, because case

mary Judgments: Opening a New Era in the Protection of Consumer Product Designs, 71 J. PAT. & TRADEMARK OFF. SOC'Y 524, 536 (1989).

²⁰⁶ Additionally,

[t]he Federal Circuit serves as the most significant appellate forum for reviewing the TTAB's registrability decisions. Although parties may elect to institute civil actions in federal district court for a quasi *de novo* review of TTAB decisions, the substantial majority of appeals are taken to the Federal Circuit. Because the availability of the Supreme Court certiorari review has proven more theoretical than actual, the Federal Circuit stands as the final appellate arbiter of most registrability decisions.

Kevlin, *supra* note 137, at 1151-52 (citing Skoler, *Trademark Appeal, Opposition and Cancellation Procedure in Six Nations: A Comparative Examination*, 74 TRADEMARK REP. 367, 372 (1984) [hereinafter Skoler] (approximately 75% of federal court appeals from TTAB decisions are filed with the Court of Appeals for the Federal Circuit, while the remaining 25% are filed with federal district courts)). See *id.* at 1151 nn.12 & 13 (“Although certiorari review to the United States Supreme Court is theoretically available pursuant to 28 U.S.C. § 1254(1) (1982), this review rarely has been exercised in trademark cases.”) (citing Skoler, *supra*, at 371 (from 1980-1984 the Supreme Court only decided one trademark case)).

²⁰⁷ See *In re Teledyne Indus., Inc.*, 696 F.2d 968, 971 n.4 (Fed. Cir. 1982) (basing rejection on CCPA precedent).

²⁰⁸ See, e.g., *Nabisco Brands, Inc. v. Planters Lifesaver Co.*, 892 F.2d 74 (4th Cir. 1989). While the *Nabisco* court ruled that an expired design patent could not invalidate a subsequent trademark registration—a holding that would have clearly been supported by the CAFC—this case illustrates that the various federal appellate courts will decide trademark cases when a design patent is no longer at issue. Therefore, *Nabisco* could have ruled on grounds favorable to the Doctrine of Elections even though the CAFC rulings are to the contrary. See also *Zachary v. Western Publishing Co.*, 75 Cal. App. 3d 913, 143 Cal. Rptr. 34 (Cal. Ct. App. 1977) (California appellate court found that a design patent does not eliminate common law copyright claims).

²⁰⁹ Kevlin, *supra* note 137, at 1170; see *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1033 (Fed. Cir. 1985) (“proper reach of the preemptive effect of the federal patent laws in relation to the diverse assortment of trade regulation laws existing in the fifty states is not a matter over which this court has a mandate to unify”). The CAFC “will apply the law that has evolved in the regional circuit in which the case containing

law varies among the jurisdictions both in trademark law²¹⁰ and design patent law,²¹¹ national uniformity on the Doctrine of Elections is not guaranteed. One should not, however, ignore the influence of the CAFC. The CAFC is quite often regarded as the source for decisions in the intellectual property area, and its opinions are usually closely followed.

Finally, the United States Supreme Court has not decided the status of the Doctrine of Elections.²¹² This may be due to the Court's apparent hesitance to review cases originating in the TTAB. Congress would be a more likely source to either affirm or reject the Doctrine of Elections but, like the Court, has not acted.

VII. CONCLUSION

Since the CAFC does not view the Doctrine of Elections as having any practical or constitutional basis, the Doctrine is essentially a nullity. Even the Copyright Office, which provides the Doctrine some viability through section 202.10(a), would be forced to accept the demise of the Doctrine if Congress chooses to enact legislation defeating it.

In addition to finding no constitutional basis for its existence, courts have rejected the Doctrine on the grounds that the public interest in preventing consumer confusion is more important than allowing access to the designs by other merchants. One problem with this balancing is that designs which would be found functional if challenged in court are monopolized because other merchants do not want to enter prolonged and expensive litigation. A solution would be to require that the designs be available for a minimum period of time after the expiration of the design patent which would at least allow other merchants the opportunity to adopt the design. Secondary meaning then becomes a reward for association with the design because the association

the issue was originally tried." *Id.*; see *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422 (Fed. Cir. 1984); see also *supra* note 111.

²¹⁰ See, e.g., *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981); *Consumer Motivation*, *supra* note 153.

²¹¹ See Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compco v. Day-Brite Lighting, Inc., and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U.L. REV. 195, 236-40 (1985).

²¹² The closest the Court has come to making a decision regarding the Doctrine occurred in *Mazer v. Stein*, 347 U.S. 201 (1954) (expressly refusing to decide) and *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (where the Court addressed both utilitarian and design patents in relationship to trademarks, but not sufficiently with regard to design patents to satisfy the *Mogen David* court). See *supra* notes 70-80 and 185-86 and accompanying texts.

would have been maintained under marketplace competition rather than merely stemming from the exclusivity afforded by design patent protection.

Without a definitive solution to the existence of the Doctrine of Elections by the Supreme Court or Congress, the Doctrine may conceivably reappear in courts which do not find the CAFC opinions persuasive. More importantly, however, because the Doctrine of Elections addresses such fundamental issues as the protection of ideas and the maintenance of a competitive marketplace, any uncertainty in the law should not be allowed to endure.

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