As the economic value of ideas increases, the creators and owners of ideas are seeking greater protection from intellectual property law. One way to achieve greater protection is to claim the benefits of multiple forms of intellectual property for a single creation. With no per se prohibition against this practice, intellectual property owners are seeking cumulative protection with increasing regularity.

However, the intellectual property laws do not necessarily lend themselves nicely to aggregation. Each form of intellectual property strikes its own balance among several competing interests: spurring innovation and creativity, protecting the owner's investment in its intellectual property, and allowing the public to use the information and inventions created by others. The policies underlying one form of intellectual property may be frustrated by the policies underlying another form. When this is the case, cumulative application of the laws could create a conflict.

A recent Seventh Circuit case, Thomas & Betts Corp. v. Panduit Corp., illustrates the conflict that can arise between patent law and trademark law. The owner of an expired patent claimed trade dress protection in the product configuration disclosed as the best mode of practicing the patented invention. The court determined that patent policy did not preclude trademark protection of the product configuration. Unfortunately, the court came to this conclusion only after predating trademark protection on the claims of the patent, which only confuses the issue.


2. The courts used to enforce a "doctrine of elections" in intellectual property—the owner elected the single form of intellectual property to protect subject matter eligible for protection under more than one form. This doctrine has not been enforced since the 1960s. See generally Douglas R. Wolf, The Doctrine of Elections: Has the Need to Choose Been Lost?, 9 CARDOZO ARTS & ENT. L.J. 439 (1991).
4. Although "trademark" traditionally refers to text or a drawing while "trade dress" refers to the packaging or appearance of an item, the Supreme Court has ruled that the Lanham Act "provides no basis for distinguishing between trademark and trade dress." Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 773 (1992). The two terms are used interchangeably in this Note.
Trademark protection should hinge only upon the alleged trademark, and not upon the wording of any patent claims that might cover the mark.

I. THE INTERSECTION OF PATENT AND TRADEMARK LAW

A. Background

Under its constitutional mandate, patent law exists to "promote the progress of [the] useful Arts, by securing for limited Times to ... Inventors the exclusive Right to their ... Discoveries." The patent laws are designed to reward people who invent something new, useful, and nonobvious, and who fully disclose the invention in a patent application. The reward is a grant of the exclusive right to create, sell, and use the invention for, at most, 20 years. The patent system has been described as a bargain in which the inventor receives the right to exclude others from practicing the patented invention. In exchange, the public gets the benefit of the dissemination of a new invention.

Trademarks, on the other hand, exist primarily to prevent consumer confusion and, as a secondary concern, to protect the trademark holder's investment in the mark. Trademark protection is more limited in scope than patent protection: a trademark gives an owner the right to prevent use of the mark by others only when such use is likely to cause confusion. Trademarks are valid for as long as the mark is used in commerce and as long as the mark remains non-generic.

Given these very different rationales—innovation versus consumer protection—conflict between these two forms of intellectual property can occur whenever the product configuration of a patented invention serves as an identifier of product source. To help channel inventions to the proper form of intellectual property protection, judges created the concept of

5. U.S. Const. art. I, § 8, cl. 8. The same clause also provides the authority for federal copyright law.
7. See id. § 101.
8. See id. § 103.
9. See id. § 112.
10. See id. § 271.
11. Until 1995, patents were valid for 17 years from issuance. Now, a patent expires 20 years from the date the application was filed. See 35 U.S.C. § 154(a)(2).
functionality in trademark law. The functionality doctrine derives directly from the desire to prevent trademark and patent law from conflicting.

Functionality has two distinct, but related, definitions. In one of the earliest cases to mention functionality, the Supreme Court in 1938 defined a functional feature as one that, by its absence, would raise cost and lower quality of the product. This definition led to the effective competition test: if the feature is required for competitors to compete effectively, it will be found to be functional. More recently, functionality was expanded to include features that are essential to the use or purpose of the product, in other words, utilitarian features.

B. Singer and Kellogg: the right to copy an expired patent

The conflict between patent and trademark law was apparent over a century ago in Singer Manufacturing Co. v. June Manufacturing Co. The Singer Company brought suit against a competitor that sold machines with the same distinctive shape as formerly-patented Singer machines. Singer claimed a trademark on the configuration of the machines. The Supreme Court refused to find the machines' configuration to be a protectable trademark, deciding that patent policy required the configuration to be in the public domain:

16. See In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1336 (C.C.P.A. 1982) ("This requirement of 'nonfunctionality' is not mandated by statute, but 'is deduced entirely from court decisions.'") (quoting In re Mogen David Wine Corp., 328 F.2d 925, 932 (C.C.P.A. 1964) (Rich, J., concurring)).

17. See J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 7.63 ("In order to accommodate trade dress law to the policies of patent law and of free competition, the common law early developed the policy that no trade dress or trademark rights could validly be claimed in 'functional' shapes or features.").


19. See, e.g., Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159, 169 (1995) ("The functionality doctrine ... forbids the use of a product's feature as a trademark where doing so will put a competitor at a significant disadvantage...."); Morton-Norwich, 671 F.2d at 1339 ("[T]he public policy involved in this area of the law [is] not the right to slavishly copy articles which are not protected by patent or copyright, but the need to copy those articles, which is more properly termed the right to compete effectively.").


21. This may not be a completely separate test. See, e.g., Morton-Norwich, 671 F.2d at 1340 ("'[F]unctionality' is determined in light of 'utility,' which is determined in light of 'superiority of design,' and rests upon the foundation 'essential to effective competition.'").

22. 163 U.S. 169 (1896).

23. See id. at 169.
It is self-evident that on the expiration of a patent ... the right to make the thing formerly covered by the patent becomes public property. ... It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. 24

The Supreme Court revisited the issue forty years later in Kellogg Co. v. National Biscuit Co. 25 Nabisco purchased the assets of The Shredded Wheat Company, which had been producing shredded wheat since the turn of the century using a patented machine designed to make only pillow-shaped biscuits. 26 Once the patent on the machine expired, Kellogg started selling pillow-shaped shredded wheat. 27 Nabisco sued in an effort to protect, among other things, its claimed trade dress in the pillow shape of its shredded wheat biscuits. 28 The Court reasoned that Kellogg could continue selling the pillow-shaped biscuits because, once the patents expired on the machines that produced only pillow-shaped biscuits, that form “was dedicated to the public.” 29

These two decisions have been relied upon in many subsequent Supreme Court decisions to stand for the proposition that there is a right to copy an expired patent. In Scott Paper Co. v. Marcalus Manufacturing Co., 30 the Court was asked to decide whether the assignor of a patent was estopped from asserting the patent’s invalidity due to anticipation in an expired prior art patent. The Court determined that there was no such estoppel, because “the patent laws ... dedicate to all the public the ideas and inventions embodied in an expired patent.” 31

Twin decisions handed down by the Court in 1964—Sears Roebuck & Co. v. Stiffel Co. 32 and Compco Corp. v. Day-Brite Lighting, Inc. 33—overturned an Illinois unfair competition law that had been interpreted to

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24. Id. at 185.
26. See id. at 113, 119.
27. See id. at 113.
28. See id. at 116.
29. Id. at 117. The Court also suggested that the pillow-shaped biscuit was a generic form not eligible for trademark protection. “[A] particular manufacturer can[not] assert exclusive rights in a form in which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than a particular producer....” Id. at 120.
31. Id. at 256.
prevent copying of lamps not protected by a patent or copyright.\textsuperscript{34} In
\textit{Sears}, the Court stated that "when the patent expires the monopoly created
by it expires, too, and the right to make the article—including the right to
make it in precisely the shape it carried when patented—passes to the
public."\textsuperscript{35} \textit{Compco} held that "if the design is not entitled to a design patent
or other federal statutory protection, then it can be copied at will."\textsuperscript{36}

The Supreme Court relied upon all of the above cases in \textit{Bonito Boats, Inc. v. Thunder Craft Boats, Inc.}\textsuperscript{37} to determine that state law could not extend "patent-like" protection to inventions that did not qualify for fed-
eral protection.\textsuperscript{38} The Court, referring to \textit{Singer} and \textit{Kellogg}, stated that
"[f]or almost 100 years it has been well established that in the case of an
expired patent, the federal patent laws do create a federal right to 'copy
and use.'"\textsuperscript{39}

\section*{C. Recent cases: no right to copy}

Despite the Supreme Court’s pronouncements, lower courts have rou-
tinely acted as if there were no absolute right to copy an invention covered
by an expired patent. For instance, in \textit{In re Mogen David Wine Corp.},\textsuperscript{40} the
Court of Customs and Patent Appeals decided that a bottle design pro-
tected by a design patent can also be the basis for a trademark registration.
The court held that the conclusion was justified, for "[w]e 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."\textsuperscript{41}

The Federal Circuit has reaffirmed this holding, post-\textit{Bonito Boats}, in
two cases challenging the court’s jurisdiction.\textsuperscript{42} In \textit{Leatherman Tool
Group, Inc. v. Cooper Industries},\textsuperscript{43} a manufacturer of a pocket tool sued a
competitor for infringing the tool’s trade dress. The original complaint did

\begin{footnotesize}
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\item 35. \textit{Sears}, 376 U.S. at 230.
\item 36. \textit{Compco}, 376 U.S. at 238.
\item 37. 489 U.S. 141 (1989).
\item 38. \textit{See id.} at 156.
\item 39. \textit{Id.} at 165.
\item 40. 328 F.2d 925 (C.C.P.A. 1964).
\item 41. \textit{Id.} at 930.
\item 42. Unless a district court case arises under the patent laws, the Federal Circuit has
no jurisdiction to hear the appeal. Conversely, the Federal Circuit has exclusive appellate
jurisdiction over \textit{all} cases "arising under" the patent laws. \textit{See} 28 U.S.C. \textbf{\$} 1338(a)
(granting district courts jurisdiction, exclusive of state courts, for causes "arising under"
the patent laws); \textit{id.} \textbf{\$} 1295(a)(1) (granting the Federal Circuit exclusive jurisdiction over
appeals of cases in which the district court’s jurisdiction is "based, in whole or in part, on
28 U.S.C. \textbf{\$} 1338").
\item 43. 131 F.3d 1011 (Fed. Cir. 1997).
\end{itemize}
\end{footnotesize}
not include a patent action, but the competitor defended on the grounds that the patent laws allow copying of an unpatentable design. The court examined *Bonito Boats* and determined that "the Supreme Court made clear that the patent laws provide a limited right to exclude others from making, using, or selling a claimed invention for a limited period of time, but ... create no affirmative right ... to make or copy what is in the public domain and excluded from patent protection." 44 The Federal Circuit transferred the appeal to a regional circuit because no part of the case "arose under" the patent laws and, therefore, it had no jurisdiction.

In *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 45 the plaintiff sought a declaration that it had a right to copy and use material in the public domain. The Federal Circuit "reaffirm[ed], consistent with our precedent, that there is neither a federal right to copy and to use, be it constitutional or statutory in source, nor an implied remedy for that purported right." 46 The court dismissed the count for lack of jurisdiction, for the "allegation of a right and remedy is, without doubt, meritless." 47

**D. Vornado’s significant, inventive aspect test**

The only recent case directly addressing whether a product configuration disclosed in a patent can be protected as a trademark is the Tenth Circuit’s decision in *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.* 48 Vornado sold a patented fan with a spiral grill. 49 The spiral shape of the grill was an element of the patent claims. 50 A competitor copied the grill design, but did not infringe Vornado’s patent in doing so. 51 Vornado claimed trade dress protection over the grill’s spiral design. 52 The court rejected the trade dress claim, holding that patent policy dictated that a "described, significant inventive aspect" of a patented invention be free for copying upon expiration of the patent. 53 The court decided that the spi-

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44. *Id.* at 1015.
45. 153 F.3d 1318 (Fed. Cir. 1998).
46. *Id.* at 1325.
47. *Id.* at 1328.
48. 58 F.3d 1498 (10th Cir. 1995).
49. See *id.* at 1500.
50. See *id.*
51. See *id.* at 1501.
52. See *id.*
ral grill was a significant inventive aspect of Vornado's patent based upon its inclusion as an element of the patent claims.\(^5\)

II. THE THOMAS & BETTS DECISION

A. Facts of the case and procedural history

Thomas & Betts (T&B) and Panduit both manufacture cable ties, which are designed to bundle wires together. A cable tie is a thin strip of plastic, usually shorter than 10 inches, with a slotted head on one end into which the opposite end of the tie can be inserted and locked into place. The locking mechanism can either be one-piece, in which the plastic of the head is molded to act as a one-way ratchet, or two-piece, in which a metal barb in the head of the tie holds the tail in place.

T&B received a patent in 1965 on a two-piece cable tie. This patent, referred to in the court decisions as the Schwester patent,\(^5\) expired in 1982. The Schwester patent discloses a self-clinching cable tie, described in the patent specification with a head-end portion terminating in an "oval shaped clinching eyelet."\(^5\) The patent claims, however, are much broader, ignoring the shape of the head.\(^7\) T&B has continued to produce a tie essentially identical to that disclosed in the Schwester patent.\(^8\) In 1994, Panduit began to produce a cable tie, sold under the "Barb-Ty" trademark, substantially similar in appearance to T&B's tie, including the oval-shaped head.\(^9\)

T&B filed suit in the Northern District of Illinois shortly after Panduit began selling its Barb-Ty.\(^6\) T&B sought to permanently enjoin Panduit from manufacturing the Barb-Ty on the grounds that Panduit infringed T&B's trade dress in the oval shape of the cable tie head.\(^6\) The magistrate judge granted a preliminary injunction in favor of T&B in December

\(^{54}\) See id. The court recognized, however, that the contribution of a particular feature may not be clear, and it did not rule out the possibility of a court conducting a factual inquiry to "supplement its reading of the patent's claims and descriptions." Id.

\(^{55}\) U.S. Patent No. 3,186,047 (issued June 1, 1965) [hereinafter Schwester patent].

\(^{56}\) Id. at col. 2, l. 4.

\(^{57}\) The three claims all cover "[a] self clinching bundling strap comprising a head-end portion, a tapered tail-end portion and a body portion therebetween...." Id. at col. 3, ll. 17-21, 36-38; col. 4, ll. 9-11.

\(^{58}\) See Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 282 (7th Cir. 1998).

\(^{59}\) See id.

\(^{60}\) See id.

\(^{61}\) See id.
1994.\textsuperscript{62} The Seventh Circuit reversed in September 1995.\textsuperscript{63} The district court subsequently granted summary judgment to Panduit.\textsuperscript{64} The Seventh Circuit again took the appeal in \textit{Thomas & Betts} and reversed the summary judgment.

**B. The Seventh Circuit's reversal of summary judgment**

\textit{Thomas & Betts} provided the Seventh Circuit with an issue of first impression: whether "a product configuration that is disclosed in an expired utility patent [can] be protected as trade dress under the Lanham Act."\textsuperscript{65} The court started its analysis with a brief review of the policies underlying the patent and trademark laws. It then discussed Supreme Court precedent.\textsuperscript{66} The court distinguished each cited case on its facts, leaving no relevant precedent for it to follow. \textit{Sears} and \textit{Bonito Boats} were dismissed as relating only to federal preemption of state intellectual property and unfair competition law and were inapplicable to federal trademark law.\textsuperscript{67} The court held that \textit{Singer} only applies when "the machines' shapes [are] dictated by patents covering the machines' various components," which was not the case in \textit{Thomas & Betts}.\textsuperscript{68} \textit{Kellogg} was distinguished on similar grounds—"the shape of the shredded wheat biscuit was dictated by the patented machines used to produce it, a situation not present in [Thomas & Betts]."\textsuperscript{69} The court dismissed \textit{Scott Paper} as dicta because the main issue in that case was assignor estoppel.\textsuperscript{70} Finally, the court cited \textit{Compco} for the proposition that trade dress protection may be available for the oval head, pointing out that the Lanham Act qualifies as "other federal statutory protection."\textsuperscript{71}

The Seventh Circuit examined the Tenth Circuit's decision in \textit{Vornado}\textsuperscript{72} to decide whether the Tenth Circuit's reasoning was determinative. The Seventh Circuit decided that \textit{Vornado} did not apply because the oval

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\textsuperscript{62} See \textit{Thomas & Betts Corp. v. Panduit Corp.}, 34 U.S.P.Q.2d (BNA) 1545 (N.D. Ill. 1994).
\textsuperscript{65} \textit{Thomas & Betts Corp. v. Panduit Corp.}, 138 F.3d 277, 283 (7th Cir. 1998).
\textsuperscript{66} \textit{Id.}
\textsuperscript{67} \textit{Id.}
\textsuperscript{68} \textit{Id.}
\textsuperscript{69} \textit{Id.}
\textsuperscript{70} See discussion of these cases, \textit{supra} Part I.B.
\textsuperscript{71} \textit{Id.}
\textsuperscript{72} 58 F.3d 1498 (10th Cir. 1995).
\end{flushleft}
The court reached this conclusion by examining the claims of the patent, which do not contain the word "oval." Because the oval head was not part of the claims, there was no per se bar to protecting the oval head as trade dress.

The court proceeded to apply the tests it would use in any other trade dress infringement case and decided that there were material questions of fact in each of Panduit's defenses. The available consumer surveys could be interpreted as showing secondary meaning. T&B had evidence that showed likelihood of confusion was a potential problem. Finally, the court decided that T&B had enough evidence to question the accuracy of the district court's determination that the oval head was functional and, therefore, unprotectable as trade dress. With these material questions of fact on T&B's side, the court held summary judgment for Panduit to be inappropriate and remanded the case for trial.

III. DISCUSSION

The court in Thomas & Betts reached the correct conclusion: patent law does not prevent a product configuration disclosed in an expired patent from being protected as trade dress. However, the Seventh Circuit's analysis creates an unfortunate precedent arising from its misunderstanding of the relationship between patent and trademark law. Had the court examined the true relationship between these two forms of intellectual property, it would have realized that the proper analysis would have been simply to examine the allegedly-trademarked feature—the oval head—without reliance on the patent. Such an analysis would have avoided a highly unusual procedure undertaken by the court in Thomas & Betts—the construction of patent claims by a regional circuit.

A. Patent and trademark are separate forms of intellectual property

The Seventh Circuit's analysis inextricably links the availability of trademark protection for product configurations to the claims of a patent.

73. Thomas & Betts, 138 F.3d at 290-91.
74. See id. at 290 ("Despite the advanced level of legalese with which these claims are drafted, they resemble English closely enough for us to clearly discern that the oval-shaped head of T&B's cable tie is not part of the claimed invention.").
75. See Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 290-91 (7th Cir. 1998).
76. See id. at 295.
77. See id. at 297.
78. See id. at 299-300.
Such a linkage means that the outcome of a case such as *Thomas & Betts* turns not on the feature on which trade dress is claimed, but by the language chosen by the prosecuting patent attorney to describe the invention in the patent. Patent and trademark are separate forms of intellectual property protection; to condition trademark protection on the language of a patent, as opposed to the characteristics of the claimed trade dress, creates a relationship between the two forms of intellectual property that is neither dictated by law nor suggested by policy.

1. **The "right to copy" is only a general rule, not an affirmative right**

The many Supreme Court decisions announcing a “right to copy” an expired patent are very misleading. No such right exists—lower courts have long recognized that no constitutional or statutory authority mandates it. The “right to copy,” however, does have a kernel of truth in it: in the vast majority of cases, the public will be allowed to “slavishly copy” a patented invention upon expiration of the patent. The “right to copy” is not an affirmative right at all; rather, it is a general rule subject to the factual circumstances surrounding each case.

The absence of an affirmative right to copy has been acknowledged by the courts by their treatment of design patents. Configurations and designs protected by a design patent may be protected by trademark law after expiration. Although design patents and utility patents are granted on different categories of inventions, nothing in patent law (or the Constitution)

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79. See, e.g., cases discussed *supra*, Part I.C. See also *Kohler Co. v. Moen*, Inc., 12 F.3d 632 (7th Cir. 1993); *In re Honeywell*, 497 F.2d 1344 (C.C.P.A. 1974) (reaffirming *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964)).

80. This phrase appears in many trademark and patent cases dealing with copying. It derives from Learned Hand’s opinion in a trademark infringement case, *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299 (2d Cir. 1917):

[T]he plaintiff has the right not to lose his customers through false representations ..., but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy the plaintiff’s goods slavishly down to the minutest detail; but he may not represent himself as the plaintiff in their sale.

*Id.* at 301.

81. See, e.g., *Mogen David*, 328 F.2d 925. See generally *Wolf*, *supra* note 2 (examining the demise of the Doctrine of Elections).

82. A design patent provides protection for an ornamental design. See 35 U.S.C. § 171 (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor...”). A utility patent, on the other hand, can only be granted on something that is useful. See *id.* § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter ... may obtain a patent therefor...”).
suggests that design patents can be protected by other forms of intellectual property while utility patents cannot. Both types of patents arise from the same constitutional provision, and the section of the Patent Act authorizing design patents expressly incorporates the utility patent provisions to govern the granting of design patents. That design patents may be protected by trademark after expiration suggests that utility patents may be as well.

Even if utility patents were to be treated differently than design patents, patent law is not able to create an affirmative right to copy upon expiration. A patent gives the owner the ability to exclude others from practicing the patented invention; it does not create a right to make the invention. For instance, there could be a blocking patent on the invention, or state law might prohibit the production of a patented invention (such as a radar detector or a gambling device). If the owner of a patent has no affirmative right to practice the patent when the patent is valid, the expiration of the patent cannot possibly create such a right. The only significance to the expiration of a patent, therefore, is that the right granted by the patent laws to exclude others from practicing the invention no longer exists.

Once it expires, a patent is generally said to be in the public domain. But “[t]he fact that there are distinct and separate bodies of law for patent, trademark and copyright demands careful use of the terminology ‘in the public domain.’ A thing may be in the ‘public domain’ for one area of law, but not for the others.” The expiration of a patent merely puts the inven-

83. See 35 U.S.C. § 171 (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”). The exceptions are minimal: ornamentality rather than usefulness, id., certain priority rights, id. § 172, and the term of the patent, id. § 173. See also Wolf, supra note 2, at 459-60.

84. At least one court has made a similar holding with regard to copyrights, the other form of intellectual property authorized by Article I, section 8, clause 8 of the Constitution. See Frederick Warne & Co. v. Book Sales, Inc., 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979) (“The fact that a copyrightable character or design has fallen into the public domain should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance.”).

85. See, e.g., Leatherman Tool Group, Inc. v. Cooper Indus., 131 F.3d 1011, 1015 (Fed. Cir. 1997) (“[T]he federal patent laws do not create any affirmative right to make, use, or sell anything.”).

86. See Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 185 (1896) (“It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist…”); In re Mogen David Wine Corp., 328 F.2d 925, 930 (C.C.P.A. 1964) (“Patent expiration is nothing more than the cessation of the patentee’s right to exclude held under the patent law.”).

87. MCCARTHY, supra note 17, § 6.5 (emphasis in original).
tion in the patent public domain, meaning it is no longer protected (or protectable) under the patent laws. An absolute right to copy exists only for items fully in the public domain, i.e., not protected by any body of intellectual property law. This statement is nothing more than a truism—if no law prohibits the copying of an idea, it is free for the taking.

It may be rare for there to be additional protection on portions of the invention contained in an expired patent. States are barred from protecting utilitarian inventions as such, as this would undermine the Constitution’s Patent Clause. Congress and the courts have developed policies as part of the federal intellectual property laws to guard against “back-door” patents, under the theory that patent law ought to be the only available intellectual property protection for utilitarian inventions. For instance, copy-

88. The public domain is also not permanent—in many instances, trademarks come from the public domain, appropriated by a producer of a product to distinguish its goods in the marketplace. See, e.g., Trade-Mark Cases, 100 U.S. 82, 94 (1879) (“The trademark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it.”) (emphasis added); Boston Professional Hockey Assoc., Inc. v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004, 1014 (5th Cir. 1975) (“An individual selects a word or design that might otherwise be in the public domain to represent his business or product. If that word or design comes to symbolize his product or business in the public mind, the individual acquires a property right in the mark.”); Jessica Litman, The Public Domain, 39 EMORY L.J. 965, 1014 (1990) (“The trademark statute permits a word to be withdrawn from the public domain only if, and only to the extent that, it has acquired a proprietary meaning.”).

89. The same could be said about real and personal property as well. Absent any law granting an exclusive right to use a parcel of land, for instance, the land would be available for all to use.

90. See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 164 (1989) (“[T]he federal standards for patentability, at a minimum, express the congressional determination that patent-like protection is unwarranted as to certain classes of intellectual property.”). But courts have also recognized that patent law ought not be the only possible protection for all aspects of these inventions. See Sears Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 232 (1964) (“[A state] may protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods.”).

91. Congress was explicitly granted the power to issue patents to prevent each state from protecting inventions under its own set of laws. Under the Articles of Confederation, a patent on the same invention was sometimes granted to different people in different states. See ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 125-26 (1997).

right law will not protect a utilitarian invention unless it was originally designed as a work of applied art (as opposed to an industrial design). Trademark protection of utilitarian inventions is prevented through the doctrine of functionality.

With both copyright and trademark law refusing to protect utilitarian inventions and with the inability of states to protect such inventions, the expiration of any patent protection on a utilitarian invention will usually leave the entire invention unprotected and, therefore, free for the taking. Thus, the "right to copy" does not come from patent (or other intellectual property) law, but from the usual lack of protection on the invention once the patent expires. This means that, in certain cases, portions of an invention could be protected under other intellectual property regimes after patent expiration.

2. **Functionality is a trademark doctrine and should be analyzed with regard to the trademark at issue**

Functionality has long been seen as preventing all conflict between the patent and trademark laws. The Tenth Circuit, however, remarked in *Vornado* that "[c]onfigurations can simultaneously be patentably useful, novel, and nonobvious and also nonfunctional, in trade dress parlance." If this is true, there could be instances in which a trademark could be granted for a patentable feature.

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93. See, e.g., Brandir Int'l Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142 (2d Cir. 1987).

94. See supra notes 18-21 and accompanying text.

95. See In re Deister, 289 F.2d 496, 501 n.3 (C.C.P.A. 1961) ("[T]he right to copy is not derived in any way from the patent law; it is a right which inheres in the public under the general law except to the extent the patent law may remove it.").

96. See, e.g., Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 164 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation.") (internal citation omitted).


98. Professor McCarthy disagrees with the *Vornado* court on this point. See MCCARTHY, supra note 17, § 7.89 ("[T]he Tenth Circuit's narrow view of what was 'functional' led the court to the peculiar conclusion that a shape which was an element of a patent claim and which was described as functionally superior in the patent disclosure could be one competitor's exclusive property as trade dress upon proof of inherent dis-
A feature disclosed in a patent, however, is not necessarily utilitarian, either from a patent or functionality view. The disclosure of a feature in a patent may be evidence of its utilitarian nature and, hence, its functionality, but it is not conclusive evidence. While it is likely that many, if not most, features disclosed in utility patents are functional and, therefore, ineligible for trademark protection, a categorical rule is not appropriate. The primary concern should not be whether the claimed trade dress appears in the patent or is an element of the patent claims, but whether the claimed trade dress is functional.

The oval head in *Thomas & Betts* amply demonstrates the pitfalls of a categorical rule. Although the oval head appears in the patent, there is no evidence that the oval head was chosen for utilitarian reasons. No utilitarian reasons appear in the patent specification, nor does the advertising used by T&B specifically tout the advantages of the oval head. Panduit sells cable ties with rectangular heads said to have “smooth, round edges,” similar to T&B’s claims about the oval head in its advertising materials. The oval head just does not appear to be utilitarian, despite its disclosure in a patent.

The outcome of the case should not hinge upon the patent claims, but on the invention itself. The claims may not recognizably describe the real invention. As Judge Rich has said, “What the inventor regards as his invention has very little, if anything, to do with most claims.” In fact, the judges in *Thomas & Betts* recognized in an earlier decision in the *Thomas & Betts* saga that predicating trademark protection on the claims of a patent may not be particularly wise:

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99. See id. § 6.10 (“[A] utility patent must be examined in detail to determine whether or not the disclosed configuration is really primarily functional or just incidentally appears in the disclosure of a patent.”).

100. The court in *Thomas & Betts* did not determine that the oval head was, in fact, part of the best mode, the head appears in the patent drawings, and is the only indication of the head’s shape in the specification. See Schwester patent, supra note 55, figs. 2-3 & col. 2, ll. 3-7.


103. See *Thomas & Betts*, 138 F.3d at 299-300.

Whether or not a feature is claimed is not necessarily ... a good indicator of its relative importance to the invention as a whole.... [A] patent applicant seeks to draw his claims as broadly as possible with as few specific elements as he can get away with.... There is no reason, therefore, to infer from its absence as an element in a claim that the shape of the head is any less important to the two-piece cable tie than the spiral grill is to Vornado's fan.105

To illustrate, the cable tie covered by the Schwester patent could certainly have been described in a dependent claim that specified an oval head without affecting the scope of the patent protection. Yet the analysis in Thomas & Betts suggests that had the Schwester patent included the oval head in its claims, trade dress protection for the oval head would have been barred by patent law.106 To predicate trademark protection today on how patent claims were drafted forty years ago makes little sense.

B. Regional circuits should not examine patent claims

The Seventh Circuit, to distinguish its case from Vornado, examined the claims of the Schwester patent. Although this may seem an innocuous action and a necessary step in the court’s analysis, it is an analysis that is nearly unprecedented since the creation of the Federal Circuit. Thomas & Betts is the only regional circuit decision of an appeal filed after 1982 to interpret the claims of a patent, with the exception of a single Sixth Circuit decision from 1985.107 While Thomas & Betts was properly in the Seventh Circuit, Federal Circuit precedent strongly suggests that regional circuits should resolve trade dress infringement cases without reference to patent

105. Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 660 (7th Cir. 1995).

106. It is certainly possible that, had the oval head been mentioned in the claims, that the court in Thomas & Betts would have either refused to follow Vornado or tried to decide whether this “described” feature was a “significant inventive aspect.” But such speculation buries the point—the court should not be referring to the patent to determine whether the oval head qualifies for trade dress protection.

107. Search of Westlaw, CTA database (Dec. 6, 1998) (use terms “PATENT /3 CLAIM! /P (INTERPRET! CONSTRUCT!) & DA(AFT 1982) & CO(C.A.FED.)”). The search retrieved 51 cases. Other than Thomas & Betts, the only case retrieved that involves an interpretation of a patent claim and that has a docket number indicating the appeal was filed after 1982 is Seaman Corp. v. Reeves Bros., 776 F.2d 584 (6th Cir. 1985). Why Seaman was decided by the Sixth Circuit instead of the Federal Circuit is unclear.

Thomas & Betts is also the only regional circuit decision to have cited the portion of Markman v. Westview Instruments, 517 U.S. 370 (1996), that declared interpretation of patent claims to be a matter of law. KeyCite query in Westlaw, 517 U.S. 370 (searched on Dec. 6, 1998) (search limited to headnote 10).
claims; otherwise, the Federal Circuit would have jurisdiction over these cases.\textsuperscript{108}

The Federal Circuit has appellate jurisdiction, exclusive of the regional circuits, over cases that arise under the federal patent laws.\textsuperscript{109} The Federal Circuit has recently interpreted its jurisdiction to include any federal or state claim in which the only way a plaintiff may prevail depends on "resolving a substantial question of federal patent law."\textsuperscript{110} These substantial questions include infringement, validity, and enforceability of patents.\textsuperscript{111} Cases raising these questions are ones in which patent claims are normally interpreted. The Supreme Court ruled in \textit{Markman v. Westview Instruments, Inc.}\textsuperscript{112} that uniformity in patent cases can best be served by trial judges constructing patent claims, with sole appeal to the Federal Circuit.\textsuperscript{113} If the analysis in \textit{Thomas & Betts} is the proper way to determine whether a particular configuration may be protectable trade dress, it would seem to fall under the Federal Circuit's jurisdiction and arise under the patent laws.

The Federal Circuit, however, has held in both \textit{Leatherman} and \textit{Hunter Douglas} that public domain defenses to trade dress infringement cases do \textit{not} arise under the patent laws.\textsuperscript{114} This is because patent law does not create an affirmative right to copy, and any policy rationale for not protecting utilitarian features is subsumed wholly within trademark law and the functionality doctrine. The entire analysis in \textit{Thomas & Betts} is undertaken to determine the merits of Panduit's public domain defense. This analysis, rather than construing the patent claims to decide whether the oval head is claimed within the patent, should concentrate instead on the trademark functionality of the oval head. In this way, the analysis in \textit{Thomas & Betts} would clearly be separated from the patent laws, properly be in the Seventh Circuit, and be consistent with Federal Circuit precedent.

\textsuperscript{108} Although Federal Circuit precedent is not binding on regional circuits, its decisions regarding its own jurisdiction would likely be extremely persuasive to a regional circuit. See \textit{Christianson v. Colt Indus. Operating Corp.}, 486 U.S. 800 (1988), for an account of the futile forum transfers that can result from jurisdictional disagreement between the Federal Circuit and a regional circuit.

\textsuperscript{109} See 28 U.S.C. §§ 1292-95 (granting the Federal Circuit exclusive jurisdiction over appeals from cases arising under the patent laws).


\textsuperscript{111} See id. at 1330.

\textsuperscript{112} 517 U.S. 370 (1996).

\textsuperscript{113} See id. at 390-91.

\textsuperscript{114} See discussion supra notes 42-47 and accompanying text.
The desirability of an analysis divorced from claim interpretation is shown not only by the analysis showing that patent and trademark law are separate, but also by the results of the Thomas & Betts experiment in reading patent claims. Thomas & Betts shows the kinds of errors that a court unskilled in reviewing patent claims can make, undermining the uniformity that the Federal Circuit has brought to patent law.

After examining the Schwester patent's claims, the court in Thomas & Betts concluded that the oval head was "not part of the claimed invention" and "not part of the claims." These phrases have no meaning in patent law. "A patent does not protect any single element or limitation, and patent law does [not] recognize any notion that something can be 'part of a claim.'" Although the claim interpretation in Thomas & Betts was not undertaken to determine the scope of patent protection, the analysis is a tool of patent law. The result obtained from this tool ought to be one that makes sense in the proper setting.

IV. CONCLUSION

The intellectual property laws certainly have the potential to conflict, and courts have recognized that for years. But the way to prevent the conflict is to understand exactly what the laws aim to accomplish and how they work. The Seventh Circuit did not address these issues in Thomas & Betts; rather, it followed the reasoning set forth by the Tenth Circuit in Vornado. This caused the case to hinge upon the court's reading of the Schwester patent, tying trademark protection to the way patent claims were drafted in the 1960s. This linkage between patent and trademark law is not required or suggested by statute or case law. The Seventh Circuit should have specifically determined whether the oval head was functional within the definition of trademark law. This determination could have been made without such heavy reliance on the patent claims, which would have prevented the anomaly of regional circuits reading patent claims.

116. Id. at 291.