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# Trade Dress and Design Law

■ GRAEME B. DINWOODIE ■ MARK D. JANIS



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# ***TRADE DRESS AND DESIGN LAW***

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**Wolters Kluwer**

Law & Business

AUSTIN BOSTON CHICAGO NEW YORK THE NETHERLANDS

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Aspen Publishers  
Attn: Order Department  
PO Box 990  
Frederick, MD 21705

Printed in the United States of America.

1 2 3 4 5 6 7 8 9 0

ISBN 978-0-7355-6832-7

### **Library of Congress Cataloging-in-Publication Data**

Dinwoodie, Graeme B.

Trade dress and design law / Graeme B. Dinwoodie, Mark D. Janis.

p. cm.

Includes bibliographical references and index.

ISBN 978-0-7355-6832-7 (perfectbound : alk. paper) 1. Design protection—United States. 2. Trademarks—Law and legislation—United States. 3. Actions and defenses—United States. I. Janis, Mark D. II. Title.

KF3086.D56 2010

346.7304'84—dc22

2010010762

COVER ART: The Legless Glass Table and sketch on the cover of this book are both the creation of Peter Devins, designer and artist. Web site: [www.devinsdesign.com](http://www.devinsdesign.com)

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AND DESIGN LAW***

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## PREFACE

As Jerry Reichman suggests in the quote with which we begin this book, the protection of design is a fascinating and arguably still-unsolved challenge for intellectual property law. Jerry's observation resonated easily with both of us: design protection was the focus of Graeme's doctoral research, and Mark litigated design patents in practice. In part for that reason, we decided that it merited the in-depth treatment that we provide in this book. But there are other reasons too. Of course, design is crucially important in today's economy, across virtually all industries. The legal protection offered to such an economically significant enterprise is thus important in and of itself. However, a number of pedagogical considerations also prompted this book. Design raises many of the policy puzzles that arise in the better known intellectual property regimes (such as copyright, patent, and trademark). Design protection law offers an efficient vehicle for addressing the sorts of policy choices that are debated throughout intellectual property law. Moreover, because design protection implicates a number of intellectual property regimes, students who have studied those regimes can apply their knowledge in an intensive manner that allows consideration of a wide range of social and commercial contexts. Finally, because discussions of design protection frequently contemplate departures from the traditional regimes in favor of *sui generis* protection, the study of design protection offers a theoretical window into possible new paradigms of intellectual property protection (especially for new types of subject matter). Thus, materials on design protection are versatile, and capable of being used for a survey exploration of intellectual property, for an advanced course in applied intellectual property, or for a seminar that probes recurring theoretical dilemmas — not to mention, for simply learning about design protection law.

One way to view design protection is through a trademark lens, a perspective that generous judicial decisions (especially, but not exclusively, in the United States) have periodically encouraged. We explore that perspective in Chapters 2-4 of this book. In that part of the book, we borrow some core materials from our book *Trademarks and Unfair Competition: Law and Policy*,

and we augment those materials with new cases, notes, questions, and problems applying general trademark principles specifically to trade dress.

In the United States, the design patent regime has long been part of the design protection landscape. But it receives cursory treatment in most intellectual property casebooks. In Chapters 5 and 6, we hope to remedy this deficiency by addressing all aspects of design patent validity and enforcement. The lack of any sustained, prior treatment of design patents may have reflected design's position at the intersection of other major intellectual property rights as well as the lack of confidence in design patents as effective instruments of protection. But, as will be seen from the very recent date-stamp on many appellate decisions in Chapters 5 and 6, there has been a contemporary rejuvenation of interest in design patent protection. The materials in these chapters are the first to tackle that rejuvenation.

Copyright protection also remains an alternative for producers of innovative designs. The cases and materials in Chapter 7 allow the instructor to explore not only the core question of how copyright protects designs generally, but also the more specific treatment of architectural designs by the Copyright Act. Finally, in Chapter 8, we discuss *sui generis* design regimes, using the prominent example of the free-standing design protection regimes available in the European Union. American producers are heavy users of the EU regimes, and the treatment in this Chapter allows us to pursue the comparative dimension to the topic that we otherwise weave throughout the materials (especially in our treatment of trademark law). Moreover, the EU system is often offered as a model for potential adoption in the United States; a detailed analysis also enables the instructor to raise questions about whether the U.S. should consider its own stand-alone, comprehensive design protection scheme (taking into account the limited *sui generis* design protection regimes, such as those for boat hulls, which we also address in Chapter 8).

We are indebted to many people who were crucial to the completion of this book. Carol McGeehan first persuaded us that the innovations we tried in our *Trademarks and Unfair Competition* book could successfully transfer to the topic of designs. John Devins helped us immensely, and displayed great patience in allowing us to explore design protection in the way and to the extent that we thought it warranted. And he also introduced us to his brother Peter, whose design graces the front cover of this book, for which we are grateful. Erica Anderson, Julie Mowers, Liz Peters, and many other research assistants helped us with early drafts, and Mike Morris and Leslie Prill assisted with more recent incarnations of the manuscript. Kati Jumper provided outstanding secretarial support, as always.

Finally, to our considerable amazement, Brian, Julie, and our respective families all permitted us to work on yet another book. As they occasionally remind us, we owe them big time for their limitless support, patience and love.

Graeme B. Dinwoodie  
Mark D. Janis

April 2010



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