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## Remarks on the Problem of Scope in IP

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REMARKS ON THE PROBLEM OF SCOPE IN IP\*

*Mark P. McKenna*\*\*

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INTRODUCTION

As I contemplated the focus of this conference, issues about the nature of the rights that are the subject of a deal stood out to me. A good deal of my recent work has focused on challenges in determining the scope of IP rights. And since those rights are the inputs to various kinds of transactions—or, perhaps even more importantly, ability to assess the scope of a right affects whether a transaction is needed—I’m going to focus here on the relationship between the scope of IP rights and potential IP transactions.

There is already quite a bit of scholarship on the importance of clarity of property rights, both in giving notice to others as to how to avoid the rights and in helping structure transactions. For

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\*\* John P. Murphy Foundation Professor of Law, Notre Dame Law School. These remarks were given as the keynote talk at The Art and Science of the Deal Conference at the University of Washington School of Law. Thanks to Zahr Said for the invitation, and to Jeanne Fromer, Mark Lemley, Rebecca Tushnet, and Jessica Silbey for helpful discussions of the ideas in these remarks.

example, Henry Smith has emphasized the importance of standardized forms of property,<sup>1</sup> and Mike Meurer and Jim Bessen have argued that the social value of patents is a function of the clarity of the property rights.<sup>2</sup> My colleague Steve Yelderman has written about the value of accuracy in the patent system—and particularly its relation to incentives.<sup>3</sup> But it's notable that this literature focuses primarily—perhaps even overwhelmingly—on utility patent law, particularly patent claim scope,<sup>4</sup> as evidenced by the extensive literature on patent claim construction.<sup>5</sup>

I'm going to suggest that the problem may be more pervasive than people have thought, in part because there generally has not been enough focus on *claiming* outside of utility patent,<sup>6</sup> or on problems relating to scope. So I will focus here on two related dimensions of the problem: (1) disparate claiming methodologies across areas of intellectual property (IP); and (2) the ways our legal system determines and enforces the scope of a party's rights. I'm going to address these in the context of design. I don't do that because I think it's the only context in which these issues arise, but because the problems may be the worst there, and because there are some particular features of our legal treatment of design that combine to exacerbate the problems.

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<sup>1</sup> See Henry E. Smith, *Intellectual Property as Property: Delineating Entitlements in Information*, 116 YALE L.J. 1742 (2007).

<sup>2</sup> See generally JAMES BESSEN & MICHAEL MEURER, *PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK* (2008).

<sup>3</sup> Stephen Yelderman, *The Value of Accuracy in the Patent System*, 84 U. CHI. L. REV. 1217 (2017).

<sup>4</sup> See, e.g., Janet Freilich, *The Uninformed Topography of Patent Scope*, 19 STAN. TECH. L. REV. 150, 152–53 (2015); Richard Gilbert & Carl Shapiro, *Optimal Patent Length and Breadth*, 21 RAND J. ECON. 106 (1990); Paul Klemperer, *How Broad Should the Scope of Patent Protection Be?*, 21 RAND J. ECON. 113 (1990); Robert P. Merges & Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 COLUM. L. REV. 839 (1990).

<sup>5</sup> See, e.g., Dan Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. PA. L. REV. 1743 (2009); Timothy R. Holbrook, *Patents, Presumptions, and Public Notice*, 86 IND. L.J. 779, 809 (2011); Mark A. Lemley, *The Changing Meaning of Patent Claim Terms*, 104 MICH L. REV. 101, 119–21 (2005).

<sup>6</sup> Jeanne Fromer's excellent work is the obvious exception here. See Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719 (2009).

What makes design such a unique and important context for discussion is that it is highly unusual in the extent of overlapping protection. Obviously, I don't mean that it's the only subject matter that implicates multiple forms of intellectual property protection. But design is unusual, if not absolutely unique, because in most of the other contexts of overlapping protection, different IP regimes deal with different aspects of a product. To take the example of software—utility patent deals with the functional aspects, while copyright deals with the non-functional, expressive aspects of the code.<sup>7</sup> As much of Pam Samuelson's work has shown, that division between the functional and non-functional isn't always perfect, just as the distinctions are not perfect in any of the contexts in which different rights might apply to different aspects of the same commercial product.<sup>8</sup> But in all of those other contexts, courts have developed substantial doctrine that aims to channel protection of particular aspects of the work to the right regime.<sup>9</sup>

Design is different. It is relatively common for parties to claim multiple forms of legal protection, not for different parts, but for *exactly the same* features of a design.<sup>10</sup> Indeed, complaints regularly allege both design patent infringement and trade dress infringement based on copying of the exact same features.<sup>11</sup> In light of the

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<sup>7</sup> Dennis S. Karjala, *The Relative Roles of Patent and Copyright in the Protection of Computer Programs*, 17 J. MARSHALL J. COMPUTER & INFO. L. 41, 41–42 (1998).

<sup>8</sup> For a thorough discussion of the respective roles of utility patent and copyright in the software context, see Pamela Samuelson, *Functionality and Expression in Computer Programs: Refining the Tests for Software Copyright Infringement*, 31 BERKELEY TECH. L.J. 1215 (2017). See also Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493 (2017).

<sup>9</sup> See Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1 (2014) (describing IP law's utility patent supremacy principle, by which IP law tries to channel functional features to utility patent law).

<sup>10</sup> Or at least *probably* the same features—given different claiming methodologies, it's often hard to tell. See Jeanne C. Fromer & Mark P. McKenna, *Claiming Design*, 167 U. PA. L. REV. (forthcoming 2018).

<sup>11</sup> See e.g., *Jenny Yoo Collection, Inc. v. David's Bridal, Inc.*, 1:16–cv–02647 (S.D.N.Y. Apr. 8, 2016) (alleging trade dress and design patent infringement in designs of convertible bridesmaid's dresses); *Deckers Outdoor Corp. v. J.C.*

Supreme Court’s recent *Star Athletica* decision,<sup>12</sup> I suspect we are going to see copyright asserted much more frequently as well. In fact, just after *Star Athletica* was decided, Puma filed a lawsuit against Forever 21 over these “Bow Slides”—alleging design patent, trade dress, and copyright infringement.<sup>13</sup>



Figure 1: Image Comparison of Puma’s “Bow Slide” Slipper to Forever 21’s “Bow Slide” Slipper.

Each of those areas of law—design patent, trademark, and copyright—makes some effort to channel protection of the functional features of design to utility patent. But beyond that, our IP system is largely comfortable with overlapping protection for the nonfunctional aspects of design. That overlap, as Jeanne Fromer and I discuss in a current project,<sup>14</sup> means that strategic parties can use different forms of IP additively or as substitutes for each other—and they can do so much more effectively than can parties claiming

Penney Co. Inc., 45 F. Supp. 3d 1181 (C.D. Cal. 2014). Courts have explicitly endorsed these overlapping claims. *See Kohler Co. v. Moen Inc.*, 12 F.3d 632, 638 (7th Cir. 1993) (“[A] product’s different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.”).

<sup>12</sup> *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

<sup>13</sup> *Puma SE v. Forever 21, Inc.*, No. 2:17-cv-02523 (C.D. Cal. Apr. 3, 2017).

<sup>14</sup> Fromer & McKenna, *supra* note 10.

rights in just about any other subject matter.

One reason courts have not been able to manage that overlap effectively is that the claiming methodologies of design patent, trademark, and copyright differ significantly. In fact, there are some pervasive issues with design claiming that complicate application of design patent, trademark, and copyright doctrines and make it very difficult for others to evaluate the scope of a party's claims relating to a design. These claiming problems also make it harder for courts to give valid rights the correct scope—which is in turn made worse by the way courts tend to structure their approach to validity and infringement. As Mike Madison would say, all of these areas of law struggle to identify and delineate the boundaries of the relevant legal thing.<sup>15</sup>

## I. CLAIMING METHODOLOGY<sup>16</sup>

Let me begin by talking about three issues relating to claiming methodology in design patent, trademark and copyright: (1) differences in the timing of the claims; (2) differences in the format of the claims, and particularly the relative emphasis on visual and verbal identification of the claimed features; and (3) a pervasive level of abstraction problem.

### A. *Design Patent*

Like utility patents, design patents do not exist until the Patent Office issues them. Design patent claims are submitted to the Patent Office as part of the application, independent of a dispute with any alleged infringer. That means that, while claiming is strategic in the sense that applicants draft claims with an eye toward the anticipated conduct of other market participants, they generally cannot draft those claims in reaction to a particular third-party use. Once issued, a design patent provides a “definitive” record of a party's claim which, at least in theory, binds the party in all assertions of rights.

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<sup>15</sup> See Michael J. Madison, *Law as Design: Objects, Concepts and Digital Things*, 56 CASE WESTERN L. REV. 381 (2005).

<sup>16</sup> Remarks in this section are adapted from Fromer & McKenna, *supra* note 10.

Notably, design patent claims are visual.<sup>17</sup> At the Patent Office, they are usually *only* visual; applicants can include some textual material that explains or limits the claim, but the claim itself is an image.<sup>18</sup> Because a design patent can only issue for the design of an article of manufacture, but a party need not *claim* the design of the entire article, parties use solid lines to identify claimed features and dotted lines to indicate the portions that are not claimed and depicted only for context.<sup>19</sup> That means, of course, that reading a design patent entails visual interpretation.

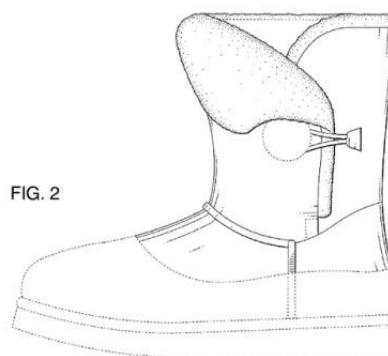


Figure 2: Design Patent D599,999.

Visual interpretation remains important, at least formally, when courts are evaluating validity and/or infringement, though there is an interesting and important outlier here, namely nonobviousness, where the Federal Circuit explicitly requires courts to render the

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<sup>17</sup> U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (9th ed. 7th rev., Nov. 2015) [hereinafter MPEP] (“The design for an article consists of the visual characteristics embodied in or applied to an article.”).

<sup>18</sup> 37 C.F.R. § 1.153(a) (2012).

<sup>19</sup> MPEP, *supra* note 17, at § 1503.2, ¶ 15.49 (“The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines.”)

claimed design verbally in order to compare it to prior art.<sup>20</sup> Apparently that comparison can be done perfectly well without verbal elaboration when the issue is novelty, but not in the context of nonobviousness.<sup>21</sup>

Courts in design patent cases emphasize the visual because of their concern that deconstruction and verbal description will inevitably focus decisionmakers too much on individual features rather than the overall creativity of a composite design.<sup>22</sup> That concern is not unique to design patent law, of course – we see it in the “overall look and feel” cases in copyright,<sup>23</sup> and as we’ll see, the issue arises in trademark law too.<sup>24</sup> Concern for the overall design pushes courts to give visual representation priority.

But it turns out to be essentially impossible to maintain that exclusive focus on visual claims, because drawings actually don’t speak for themselves when designs must be compared to prior art or allegedly infringing products, and when courts have to give reasons for their determinations about whether those comparators are sufficiently similar to the claimed design to meet the legal standard. As a result, notwithstanding their repeated insistence that the visual takes priority, courts can’t resist describing the designs verbally.

One important reason for the persistence of verbal description is that designs often include features or collections of features that, standing alone, wouldn’t be protectable – because they are not new,

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<sup>20</sup> See *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301 (Fed. Cir. 2013).

<sup>21</sup> Cf. Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. INTEL. PROP. L. 409 (2012) (critiquing translation of images to verbal descriptions).

<sup>22</sup> See *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1302 (Fed. Cir. 2010) (“Depictions of the claimed design in words can easily distract from the proper infringement analysis of the ornamental patterns and drawings.”); see also *Egyptian Goddess v. Swisa, Inc.*, 543 F.3d 665, 679–80 (Fed. Cir. 2008).

<sup>23</sup> See, e.g., *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003) (“Essentially, the total-concept-and-feel locution functions as a reminder that, while the infringement analysis must begin by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not simply a matter of ascertaining similarity between components viewed in isolation.”); see also *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970).

<sup>24</sup> See *infra* Part I.B.



or because they are functional. Those design features are only protectable when used in the particular overall design, and the risk of gestalt comparison is that infringement might be found based on similarity that is attributable only to the unprotectable parts.<sup>25</sup> Courts are aware of that problem, and as a result, validity decisions—those dealing with ornamentality, novelty, and of course nonobviousness—nearly always include verbal descriptions, even if not acknowledged as such.

*International Seaway Trading Corp. v. Walgreens* provides just one example.<sup>26</sup> In that case, the court compared the claimed design in the '263 patent to the prior art design in the '789 patent.

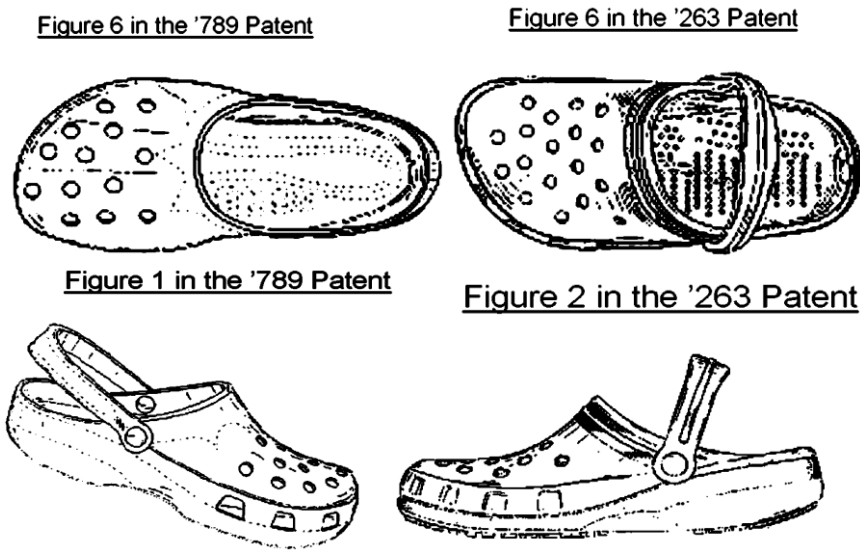


Figure 3: Image Comparison of the '263 Patent to the Prior Art Design in the '789 Patent.

In doing so, the court could not help but to highlight the long, U-shaped dimpling pattern on the insole of the design in the '789 patent, which it contrasted with the multiple short rows of dimples depicted in the '263 patent.<sup>27</sup> That difference, it believed, might be

<sup>25</sup> See Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197, 2206–07 (2016).

<sup>26</sup> 589 F.3d 1233 (Fed. Cir. 2009).

<sup>27</sup> *Id.* at 1242–43.

significant in the eyes of the ordinary observer armed with the knowledge of the prior art. By contrast, the court was confident that slight variations in the number and position of the circular holes on the top of the respective shoes, differences in the rectangular holes on the toes of the shoes, and differences in the shapes of the rectangles on the soles of the shoes were all so minor that they wouldn't have had any effect on the ordinary observer.<sup>28</sup>

Comparisons are particularly difficult in the infringement context because they necessarily entail comparison of an accused *product*—typically a physical object—with the patent *drawing*, which might claim only partially. Because comparing a real object to a drawing is not comparing like to like, interpretation is inherently necessary. Obviously that challenge can sometimes arise in novelty and obviousness comparisons, but it does not always do so, since the universe of prior art includes prior patents and publications.<sup>29</sup>

To help with the infringement comparison, courts used to line up the accused product, the claimed design, and the closest prior art in order to identify the point of novelty in the claimed design—the feature or features that made the design patentable over the prior art.<sup>30</sup> The point was to assure that the accused design was similar to the patented design in terms of those features. So rather than simply looking at the accused design side by side with the patented design, as in Figure 4, one could have some context against which to evaluate elements of similarity, as in Figure 5.

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<sup>28</sup> *Id.* at 1243.

<sup>29</sup> MPEP, *supra* note 17, at § 1501(a)(1) (“Prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the patent . . .”).

<sup>30</sup> *See, e.g.,* FMC Corp. v. Hennessy Indus., Inc., 836 F.2d 521, 527 (Fed. Cir. 1987); *see also* Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F.2d 428, 430 (6th Cir. 1933).

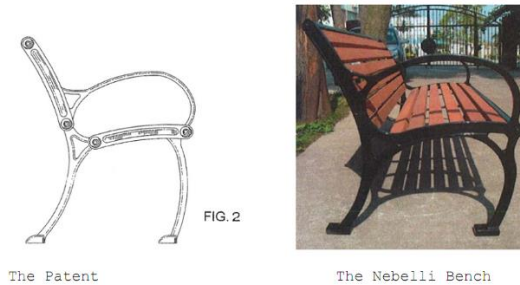


Figure 4: Image Comparison of Defendant's Nebelli Bench Design to Plaintiff's Design Patent D523,263.<sup>31</sup>

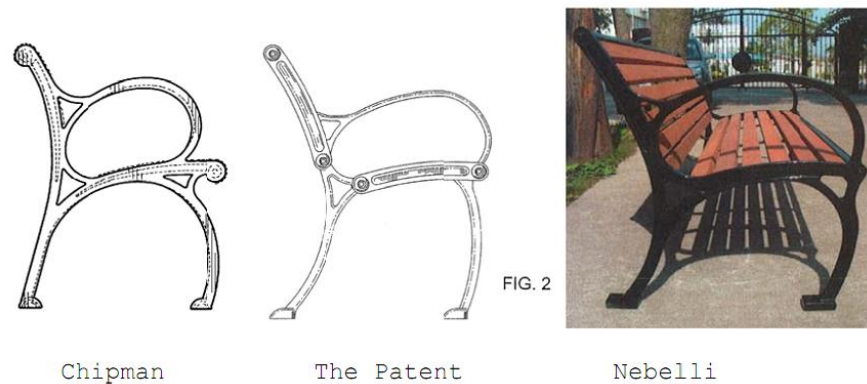


Figure 5: Image Comparison of Defendant's Nebelli Bench to Plaintiff's Design Patent D523,263 and Prior Art design D419,341.<sup>32</sup>

Sometimes that three-way comparison served to highlight particular similarities, as in the bench example. Often, however, a three-way comparison drew out dissimilarities or highlighted the fact that the similarities were only with respect to common, unprotectable elements.

<sup>31</sup> Victor Stanley, Inc. v. Creative Pipe, Inc., No. CIV.A. MJG-06-2662, 2011 WL 4596043, at \*19 (D. Md. Sept. 30, 2011), *aff'd*, 499 F. App'x 971 (Fed. Cir. 2013).

<sup>32</sup> *Id.*

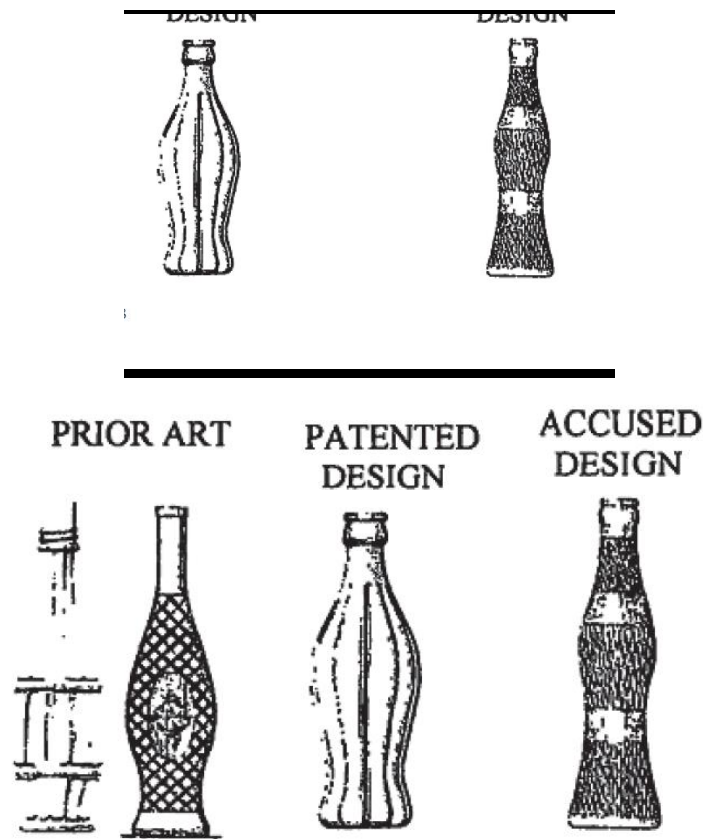


Figure 6: Image Comparison from *Coca-Cola Co. v. Whistle Co. of America*, 20 F.2d 955, 957 (D. Del. 1927).

But we no longer use this point of novelty approach, nor do we explicitly require a comparison with the closest piece of prior art. While the infringement comparison is still supposed to be made in light of the prior art, post-*Egyptian Goddess*, courts are no longer to identify and describe the point of novelty.<sup>33</sup> They are instead just

<sup>33</sup> See *Egyptian Goddess v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (“Our rejection of the point of novelty test does not mean, of course, that the differences between the claimed design and prior art designs are irrelevant. To the contrary, examining the novel features of the claimed design can be an important component of the comparison of the claimed design with the accused design and the prior art. But the comparison of the designs, including the examination of any novel features, must be conducted as part of the ordinary observer test, not as part

supposed to assume that the decisionmaker will notice differences between the claimed design and the prior art and take them into account.

Nevertheless, even in infringement cases, unless we are to throw the comparison entirely to a jury and not require any stated reasons for the similarity determination, it shouldn't be a surprise that we still see lots of verbal articulation of a claimed design, and descriptions of the similarities and differences between the accused product and that claimed design.<sup>34</sup> Indeed, *Egyptian Goddess* gives courts continuing discretion to use verbal description if they think it would be helpful.<sup>35</sup> But there is an enormous level of generality problem here, in significant part because courts exercise that discretion in the shadow of a rule that formally warns them away from doing verbal description at all. Courts engaged in the practice of verbally describing things that they purport not to be describing do so at quite different levels of generality, a problem of which the Federal Circuit essentially washed its hands when it held that the level of generality is a matter of discretion.<sup>36</sup> Sometimes the Federal Circuit determines that district courts' verbal comparisons operate at too high a level of abstraction, failing to highlight the design elements,<sup>37</sup> but other times equally or more abstract descriptions seem fine.<sup>38</sup> Without any methodology for determining the appropriate level of generality, it's very difficult to know how to evaluate similarities or differences in any systematic way.

To summarize, design patent claiming has the virtue of early claiming independent of a dispute, giving at least the sense of a stable public record. But the claiming is in the form of images. Images in general—and even more these kinds of images in particular—beg courts for description in order to do comparison. When courts have to make comparisons for validity or infringement purposes, it turns out that verbal description is inevitable. Yet these

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of a separate test focusing on particular points of novelty that are designated only in the course of litigation.”).

<sup>34</sup> See, e.g., *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1328–33 (Fed. Cir. 2012).

<sup>35</sup> *Egyptian Goddess*, 543 F.3d at 679.

<sup>36</sup> *Id.*

<sup>37</sup> See, e.g., *Apple*, 678 F.3d at 1328–33.

<sup>38</sup> See, e.g., *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332–36 (Fed. Cir. 2014).

descriptions are wildly inconsistent and lacking in any clear methodology. The notice value of the *ex ante* design patent claim is actually quite questionable.

In a world with an extremely tight infringement standard, and particularly one in which functionality plays a significant limiting role, that might not be a significant problem. But, in my judgment, the infringement standard has broadened over time to the point that I don't think it can be said anymore in the context of design patent that "that which infringes, if it later, anticipates if earlier."<sup>39</sup> And I think the Federal Circuit has largely eliminated functionality as a constraint.<sup>40</sup>

### B. Trademark

In the trademark context, we formally have a dual regime with registered and unregistered marks.<sup>41</sup> Registered marks appear to share with design patents the fact that they have a definitive claim made prior to, and independent of, any particular dispute. The Trademark Office has pretty elaborate rules about the form in which the mark is to be depicted—often requiring verbal elaboration of the design elements of the mark in addition to the description of goods and services.<sup>42</sup>

But that really overstates things in a couple of important ways. First, most trade dress—particularly of the product configuration variety—is not registered, so any notice value a registration might provide is lacking, at least in most litigated cases. And second, the form of the registration really doesn't matter in the context of a dispute; courts focus overwhelmingly on the nature of the parties' *uses* in the marketplace.<sup>43</sup> As a result, registration provides only a weak form of notice.

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<sup>39</sup> *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (quoting *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889)).

<sup>40</sup> *See, e.g., Sport Dimension, Inc. v. Coleman Co., Inc.*, 820 F.3d 1316, 1320–21 (Fed. Cir. 2016).

<sup>41</sup> *See* 15 U.S.C. §§ 1051–52 (2012) (providing for registration of marks and grounds for refusal of registration); 15 U.S.C. §§ 1114, 1125 (providing causes of action for registered and unregistered marks, respectively).

<sup>42</sup> *See* MPEP, *supra* note 17, at §§ 807–809.

<sup>43</sup> *See* Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 907 (2017).

Of course, in many cases involving registered marks, and even in cases involving unregistered marks, the claimant has used the design in the market, and that use itself provides some bit of notice. Particularly in the context of product configuration, however, use-based notice is very poor because these complex designs include a number of features which are not themselves protectable. And trade dress often changes over time, forcing parties to identify the features that remain consistent and therefore potentially protectable.

Courts understandably are uncomfortable about allowing parties simply to refer to their trade dress or even just to depict it, and most courts now require—often as a matter of pleading—that a trade dress claimant verbally describe the claimed trade dress so as to identify the features.<sup>44</sup> It’s worth noting here that courts have done this only in trade dress cases, even though one might have the same notice concerns much more broadly—especially when it comes to other visual matter that isn’t trade dress. But perhaps because trade dress highlights the risk of functionality, courts are more sensitive to this issue here.

In any event, at least as implemented now, this verbal description requirement doesn’t work very well. The most basic issue is the level of generality problem. Even when courts require parties to describe the trade dress verbally, there is no agreement, and certainly no consistent practice, as to the level of generality at which they require the trade dress to be described. Thus in

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<sup>44</sup> See, e.g., *Gen. Motors Corp. v. Lanard Toys, Inc.*, 468 F.3d 405, 415 (6th Cir. 2006) (“In requiring a list of discrete elements, we are looking to avoid vague and indeterminate references to the overall appearance or look of plaintiff’s packaging.”); *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 116–17 (2d Cir. 2001) (“[W]e hold that a plaintiff seeking to protect its trade dress in a line of products must articulate the design elements that compose the trade dress.”); *Heller Inc. v. Design Within Reach, Inc.*, No. 09 Civ. 1909 (JGK), 2009 WL 2486054, at \*6 (S.D.N.Y. Aug. 14, 2009) (“The plaintiff alleges that because ‘a picture is worth a thousand words,’ the images ‘without a doubt provide the most precise definition of the protected trade dress possible.’ However, images alone do not satisfy the plaintiff’s obligation to articulate the distinctive features of the trade dress.”); *Nat’l Lighting Co. v. Bridge Metal Indus., LLC*, 601 F. Supp. 2d 556, 562 (S.D.N.Y. 2009) (holding that the court could not be expected to distill from a set of images those elements that are common to a line of products and both distinctive and non-functional).

*Landscape Forms, Inc. v. Columbia Cascade Co.*,<sup>45</sup> the Second Circuit rejected as too abstract a description of site furniture that “incorporates large three-inch tubing, with a powdered cosmetic finish, bent in gentle turns that roll around the perimeter of the furniture which in combination with the various seating surfaces gives the viewer a floating or suspended feeling.”<sup>46</sup> Meanwhile in the famous *Two Pesos* case,<sup>47</sup> the court accepted this description:

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.<sup>48</sup>

The verbal description requirement does constrain parties’ claiming in some cases, because a party that claims too broadly risks describing a trade dress for which it will have trouble satisfying trademark law’s protectability requirements of distinctiveness<sup>49</sup> or nonfunctionality.<sup>50</sup> At the extreme, courts sometimes do not even recognize vague or underspecified claims as describing trade dress at all.<sup>51</sup> But because courts are often reluctant to invalidate, they will

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<sup>45</sup> 113 F.3d 373 (2d Cir. 1997).

<sup>46</sup> *Id.* at 381.

<sup>47</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

<sup>48</sup> *Id.* at 765.

<sup>49</sup> See *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 39–45 (1st Cir. 2001).

<sup>50</sup> See *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 81 (2d Cir. 1990) (“Wallace seeks trademark protection, not for a precise expression of a decorative style, but for basic elements of a style that is part of the public domain. As found by the district court, these elements are important to competition in the silverware market.”).

<sup>51</sup> See, e.g., *Test Masters Educ. Servs., Inc. v. State Farm Lloyds*, 791 F.3d 561, 566–67 (5th Cir. 2015) (finding that plaintiff failed to assert a trade dress infringement claim despite allegations that defendant created a “confusingly similar web site” because the “alleged confusion . . . stems from the use of a



typically narrow the claims or try to define the rights appropriately themselves,<sup>52</sup> so there is often little downside to claiming broadly and strategically.

Take the example of another recently filed case in which Lisa Frank, a company that makes various school supplies, stickers, and other products for kids, sued Orb Factory, which sells similar products under its Plushcraft mark.<sup>53</sup> A representative sampling of Lisa Frank's products look like this:



Figure 7: Images of Lisa Frank's Products.

Compare these samples to the extraordinarily broad way Lisa Frank described its trade dress in its complaint:

the combination of some or all of the following elements, depending upon the product and its packaging, that create a unique overall image and distinct visual impression... (1) brightly colored

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similar service mark ("Testmasters"), and the false representation that TES offers a similar service (live LSAT courses offered nationwide)"); *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 309–11 (3d Cir. 2014) (dismissing the plaintiff's claim for trade dress infringement when it had claimed only (1) "a hodgepodge of unconnected pieces of its businesses," which did not "together . . . comprise any sort of composite visual effect" and (2) "web design," without further specificity).

<sup>52</sup> See Lemley & McKenna, *supra* note 25, at 2224–2266 (reviewing doctrines in copyright, trademark, and patent law developed to address issues of scope).

<sup>53</sup> *Lisa Frank, Inc. v. Orb Factory Ltd.*, No. 15–cv–00433, at \*8 (D. Ariz. Sept. 16, 2015).

bold graphics of distinctive animal characters depicted individually or grouped with one or more other such characters, with rainbow colored features, large eyes, and happy, friendly expressions; (2) use of brilliant, often rainbow sequenced, colors, graduated color sequences, and rainbow colors that fade into one another . . .; (3) package, cover and product surface designs featuring, in addition to the distinctive animal characters, combinations of rainbows, flowers, ice cream cones, butterflies, birds, rabbits, fish, cupcakes, bubbles, peace symbols, random words, hearts, happy faces, and stars, often in groups including colorful backgrounds employing rainbow colors, color fades and Lisa Frank pink, props and landscape features such as trees, pools, and snow; and (4) product packaging incorporating the look and feel of the products.<sup>54</sup>

Not incidentally, the Orb Factory products to which Lisa Frank refers in the complaint look like this:<sup>55</sup>



Figure 8: Images of Orb Factory's Allegedly Infringing Products.

As a result of this generality problem, the descriptions trade dress plaintiffs give frequently fail to provide significant notice. Perhaps more importantly, courts do not tend to structure the

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<sup>54</sup> *Id.* at \*5.

<sup>55</sup> *Id.* at \*9.

validity phase of the case in order to identify the *particular* aspects of the complex design to which source designation is attributable—which, to foreshadow a bit, makes it very hard to enforce anything about the scope of the rights.<sup>56</sup>

There is some incentive to claim clearly non-functional aspects of trade dress as courts increasingly interpret the Supreme Court’s *Traffix* decision to require a finding of functionality whenever the claimed features are not “ornamental, incidental, or arbitrary”<sup>57</sup>—that is to say, not entirely unrelated to function.<sup>58</sup> But that’s only true in cases where courts recognize the utilitarian functionality of some of the claimed features, and the level of generality of the claim has much to say about whether that will happen.

As a result, in comparison to design patent, claims in trademark law are anchored by a party’s actual use, supplemented formally and necessarily by verbal description.<sup>59</sup> In practice, however, these claims don’t do much to help better define the features of the trade dress that are protectable, and in fact sometimes obscure more than they illuminate.

And of course this is only to flag problems with notice relating to the nature of the trade dress itself—not including issues relating to the contexts in which that trade dress has source significance, geographic scope of rights, or anything else that might be relevant to notice of the scope of rights.

### C. Copyright

Claiming in copyright has many of the same problems I’ve already identified: the copyrighted work serves as the exemplar, but it doesn’t give very much notice in many cases because the work

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<sup>56</sup> See Lemley & McKenna, *supra* note 25, at 2251–53.

<sup>57</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30 (2001).

<sup>58</sup> *Groeneveld Transp. Efficiency, Inc. v. Lubecore Intern., Inc.*, 730 F.3d 494, 505 (6th Cir. 2013); *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1323 (Fed. Cir. 2012); *Specialized Seating, Inc. v. Greenwich Indus. L.P.*, 616 F.3d 722, 726–28 (7th Cir. 2010); *Eppendorf–Netheler–Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355 (5th Cir. 2002).

<sup>59</sup> See *Lisa Frank, Inc. v. Orb Factory Ltd.*, No. 15–cv–00433 at \*6 (D. Ariz. Sept 16, 2015); see also *id.* at \*8.

frequently incorporates many uncopyrightable features;<sup>60</sup> registration doesn't require identification of the specific elements claimed;<sup>61</sup> further delineation only occurs in litigation;<sup>62</sup> and, in the context of design, copyright suffers from all the same visual/verbal challenges as those previously discussed.<sup>63</sup> In some respects, these problems are even worse in copyright because copyright worries even less about claiming methodology than do design patent and trademark law.

But I think it is worth noting that *Star Athletica*<sup>64</sup> puts additional pressure on claiming in cases involving useful articles—which is to say, most cases of design. The most obvious claiming issue relates to the uncertainty about whether Varsity was claiming the design of various chevrons and lines by themselves, or the designs of the uniforms of which the chevrons were merely features. The Supreme Court majority accepted that Varsity claimed a two-dimensional design that was *applied to* the useful article of the cheerleading uniform.<sup>65</sup> But it is hardly obvious that is so, and the correct understanding of Varsity's claim seems to me to turn at least in part on whether we are to emphasize the visual deposit copy or the plaintiff's characterization of that design.

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<sup>60</sup> See Lemley & McKenna, *supra* note 25, at 2227 (“[I]n general, copyright law only rarely disqualifies works altogether and instead generally relies on infringement doctrine to limit the scope of rights in a work so that it reflects that work’s marginal copyrightability.”); Fromer, *supra* note 6, at 745.

<sup>61</sup> *Copyright Basics*, UNITED STATES COPYRIGHT OFFICE, (last visited Jun. 15, 2017), available at <https://www.copyright.gov/circs/circ01.pdf#page=7>.

<sup>62</sup> Fromer, *supra* note 6, at 746.

<sup>63</sup> For discussions of the difficulties courts have in evaluating nonwritten works in IP, see, for example, Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683 (2012); Jessica Silbey, *Evidence Verité and the Law of Film*, 31 CARDOZO L. REV. 1257 (2010); Jessica M. Silbey, *Judges as Film Critics: New Approaches to Filmic Evidence*, 37 U. MICH. J. L. REFORM 493 (2004).

<sup>64</sup> *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017).

<sup>65</sup> *Id.* at 1008.

As Justice Breyer suggested, look at the designs Varsity registered:<sup>66</sup>



Figure 9: Image Comparison of Varsity's Registered Designs.<sup>67</sup>

The majority's characterization of these as drawings of various features in some arrangement<sup>68</sup> ignores the reality of the images submitted to the Copyright Office. They are not simply depictions of chevrons—they are pictures of uniforms that have particular design features. But registration does not require a clear statement on this score.

To complicate matters further, the same visual image could reflect two different types of claims. One might, for example, make a model of a car and submit an image of that model to claim rights in the model of the car. As Justice Thomas noted, the model of the car is copyrightable, even if it cannot be enforced against a party that makes an actual car.<sup>69</sup> Yet one could also characterize an image of a car in the same way Varsity described its uniforms in order to claim design features that might be—in the majority's language—

<sup>66</sup> *Id.* at 1036 (Breyer, J., dissenting).

<sup>67</sup> *Id.* at 1016 (appendix to the opinion of the court).

<sup>68</sup> *Id.* at 1008–09 (“In this case, our task is to determine whether the arrangements of lines, chevrons, and colorful shapes appearing on the surface of respondents' cheerleading uniforms are eligible for copyright protection as separable features of the design of those cheerleading uniforms.”).

<sup>69</sup> *Id.* at 1010.

“applied to” the car itself.<sup>70</sup> The very same sorts of images could be used to lay claim to a particular depiction of a car, but not a car, or to features of an actual car, at least as long as those features could be “imagined” separately from the car.<sup>71</sup> That might be acceptable if ordinarily the copyright registration process forced a party to delineate its claim – identifying which features of the submitted work it claimed, and for what purpose. But typically, the Copyright Office does not require anything like that, and the claim will be defined, if at all, in litigation.

That brings me to the second issue. The majority opinion makes separability turn on whether features of a useful article can be imagined separately as a work of authorship that is not itself a useful article.<sup>72</sup> But what features are we to “imagine” separately, and how do we know whether those features can be recognized as a work of authorship or, alternatively, simply depict the useful article?

The majority isn’t very clear on either one of those things, having simply accepted that the features in that case were a series of chevrons and other lines arranged in some format. But actually the question must turn on which features the plaintiff *claims* should be imagined separately. Here we see a problem very much like the others we’ve seen in other contexts.

At various points during the litigation, Varsity verbally described the aspects of this design it thought were copyrightable: “the lines, stripes, coloring, angles, V’s [or chevrons], and shapes and the arrangement and placement of those elements.”<sup>73</sup> Courts at every level of the litigation basically accepted that description, similarly characterizing Varsity’s copyright claim as relating to “graphic features of Varsity’s designs—the arrangement of stripes,

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<sup>70</sup> *Id.* at 1005.

<sup>71</sup> *Id.* at 1012 (“In sum, a feature of the design of a useful article is eligible for copyright if, when identified and imagined apart from the useful article, it would qualify as a pictorial, graphic, or sculptural work either on its own or when fixed in some other tangible medium.”).

<sup>72</sup> *Id.* at 1010.

<sup>73</sup> *Id.* at 1018 (emphasizing “the lines, stripes, coloring, angles, V’s and shapes and the arrangement and placement of those elements”); *cf. id.* at 1007 (referring to all five designs as “compris[ing] original combinations, positionings, and arrangements of elements which include V’s (chevrons), lines, curves, stripes, angles, diagonals, inverted V’s, coloring, and shapes, etc.”).

chevrons, zigzags, and color-blocking.”<sup>74</sup>

But when Varsity needed to describe the designs to the Copyright Office in order to overcome the Office’s initial rejection, its description was *much* more specific:

Design 538 . . . has a central field of black bordered at the bottom by a gray/white/black multistripe forming a shallow “vee” of which the left-hand leg is horizontal, while the right-hand leg stretches “northeast” at approximately a forty-five degree angle. Below the upward-angled leg of the shallow “vee” is a similarly angled wider white stripe, succeeded by an area of black. The central field of black is bordered on top by an “X” figure formed of the same gray/white/black multistripe that appears at the bottom, with the colors reversed. Above the “X” is a field of white; the wedges at either side of the “X” are subdivided horizontally into approximately equal-sized wedges of black over white.<sup>75</sup>

The descriptions are likely to matter in a lot of these cases, because at different levels of generality the purportedly separable features are going to look more like works of authorship that could be imagined apart—or more like representations of the platonic form of the useful article.

The majority waves its hand at this issue, simply asserting in a footnote that no features of a shovel could be imagined separately, because they would just represent a shovel.<sup>76</sup> But, in my view, Justice Breyer is obviously correct that, given the low standard of

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<sup>74</sup> Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468, 491 (6th Cir. 2015).

<sup>75</sup> Joint Appendix at \*140, *Varsity Brands*, 2016 WL 3924018. Chances are that Varsity intended this very granular claiming strategically to convince the Copyright Office to register something that might otherwise have been seen as lacking authorship or originality, possibly for being a useful article as clothing. By being very granular about its contribution, Varsity (probably correctly) thought the Copyright Office was more likely to acknowledge an original and copyrightable contribution.

<sup>76</sup> *Star Athletica*, 137 S. Ct. at 1002 n.2.

originality, any feature of a shovel described with sufficient particularity could be “imagined” as a separate work, at least unless we are to layer the analysis with some determination of whether those features, standing alone, necessarily “bring along” the useful article.<sup>77</sup>

All of that is to say that I think *Star Athletica* is going to put lots of pressure on courts to start thinking more about claiming methodology in useful article cases.

## II. SCOPE<sup>78</sup>

The second major dimension I want to address is the problem of determining the scope of admittedly valid rights. Obviously, the difficulty of nailing down scope is, in some significant part, the result of a lack of clarity about what is claimed. Indeed, the claiming problems I identified before can allow parties to act strategically, sometimes even within a case, emphasizing some aspects of a design for some purposes (validity) and other aspects for other purposes (infringement).

But the difficulty of identifying the boundaries of the claimed property then combines with challenges in delineating the penumbra of rights associated with that claim. To oversimplify this, I mean to say that there are two levels of difficulty in doing the comparison between the accused product and the claimed design. The first is figuring out what the claimed design is, so that we know to what we are supposed to compare the accused product. The second is determining how broadly we will enforce rights in that claimed design—how far beyond identity will we go.

The identification of the claimed property is supposed to be an input into a validity determination; we analyze the validity of the *claimed* design, trade dress, or work. As I noted earlier, every area of IP allows parties to claim rights in works or inventions that are only marginally protectable – they all allow protection for works that consist in some substantial part of components which, by themselves and sometimes even in particular combinations, would not be protectable.

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<sup>77</sup> *Id.* at 1033. (Breyer, J. dissenting).

<sup>78</sup> Portions of this section are adapted from Lemley & McKenna, *supra* note 25.



But our willingness to protect those works or inventions despite their many unprotectable parts is supposed to be counterbalanced by a recognition that the scope of rights in them is correspondingly narrow. That is to say that there's an institutional design choice with respect to how to treat complex works with many unprotectable parts. We could aggressively disqualify them from protection because of the unprotectable elements, thereby saving ourselves a lot of concern about tailoring protection but also eliminating a number of things that have at least some marginally inventive, original, or source-indicating matter. Or we could let most of those works qualify for protection in recognition of their marginal contribution, but then have to deal with the consequences of that approach when we evaluate infringement.

With the exception of utilitarian functionality in trademark law—at least as applied in most courts—IP law has chosen the latter approach.<sup>79</sup> Concerned about underprotecting even marginal contributions, we rarely rule things out categorically and instead put all of the pressure on scope. But it turns out that, as Mark Lemley and I have described, courts often have a difficult time making good on the promise of narrow scope.<sup>80</sup>

Take, for example, *Reynolds Consumer Products v. Handi-Foil Corp.*<sup>81</sup> In that case, Reynolds objected to the packaging of a new line of Handi-Foil aluminum foil products. Reynolds claimed to own rights in the “overall look, feel and commercial impression of its Reynolds Wrap packaging design,” which it described as consisting of:

- (a) the color scheme; (b) the use of the color scheme; (c) the use of prominent lettering within the blue section; (d) the use of silver bands to separate the blue and pink sections; (e) the placement of the quantity information; (f) the inclusion of the “made in the U.S.A.” lettering; (g) the repetition of the color scheme and type on the ends of the boxes; (h) the “press here to lock” feature at the ends of the boxes; (i) the use of graphics with how-to information; (j) the “Lift”

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<sup>79</sup> See generally, Lemley & McKenna, *supra* note 25.

<sup>80</sup> *Id.*

<sup>81</sup> See *Reynolds Consumer Prods., Inc. v. Handi-Foil Corp.*, No. 1:13-CV-214, 2014 WL 3615853 (E.D. Va. July 18, 2014).

graphic; (k) the positioning of the brand name on the top flap of the box; and (l) the color yellow, placement, and text used to caution the consumer.<sup>82</sup>

Though the court noted that trade dress with more elements is supposed to have narrower scope, it never addressed validity or attempted to identify the features that made the Reynolds trade dress protectable. It simply compared Handi-Foil's and Reynolds's packages and concluded that "the similarity between the overall impressions" was "striking."<sup>83</sup>



Figure 10: Image Comparison of Plaintiff's Reynolds Wrap and Defendant's Handi-Foil.<sup>84</sup>

In fact, the court thought the similarities between the two packaging designs were striking "even if the boxes' color schemes [were] put aside."<sup>85</sup> What were the damning similarities?

The two boxes both say "non-stick" and "heavy duty." The Reynolds box says "foods lift right off!" and the Handi-Foil box says "Food Easily Lifts Off!" Both boxes place the (identical) square footage on the right end of the box, with the metric conversions typed neatly below. Additionally, the two-dimensional images above cannot capture the similarity of the boxes' side and end panels, all of which bear striking semblance. Add to these characteristics the "Made in USA" language on the right portion of the boxes in Example No. 1.<sup>86</sup>

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<sup>82</sup> *Id.* at \*11.

<sup>83</sup> *Id.* at \*9.

<sup>84</sup> *Id.*

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

The obvious problem here is that the elements of similarity called out by the court were not even elements of the trade dress articulated by Reynolds, very likely because those elements almost certainly were not things Reynolds was entitled to own. Phrases like “Food Easily Lifts Off” and “Made in the USA” are clearly descriptive, so any rights Reynolds owned in relation to the phrases must have been related to the particular stylization—which Handi-Foil did not copy. When one limits the trade dress in the Reynolds Wrap packaging to only the sorts of things Reynolds is legally entitled to own, the similarities disappear.

These scope challenges are to some extent a consequence of the infringement tests themselves. Having moved away from the point of novelty test, for example, courts in design patent cases no longer highlight the protectable features, simply asking factfinders to compare the accused design to the claimed design “in light of the prior art,”<sup>87</sup> which can allow for slippage between validity and infringement assessments. We see a similar result in the *Reynolds* case.

But there is also a major structural dimension to the problem. Notwithstanding the interconnectedness of the various scope questions courts must address, those questions arise in different parts of the tripartite case structure typically associated with IP cases: validity, infringement, defenses. The result of this separation is a number of disconnects—circumstances in which the law should reach a consistent scope result but fails to do so because each IP doctrine assumes that others will take care of the problem. First, different decisionmakers decide different doctrines, often at different times. Judges and juries sometimes have fundamentally different approaches to similar questions, and the gaps are even more likely when the jury hears only part of the story because the judge has already decided other parts. Second, even if the decisionmaker is the same, validity, infringement, and defenses often come with different burdens of proof and different allocations of those burdens. For example, registered IP rights are all presumed

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<sup>87</sup> See, e.g., *Egyptian Goddess v. Swisa, Inc.*, 543 F.3d 665, 676 (Fed. Cir. 2008) (“When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art.”).

valid when challenged in court; the standard of proof differs from a preponderance of the evidence in copyright and trademark cases to clear and convincing evidence in patent and design patent cases.<sup>88</sup> Proving infringement is the IP owner's burden, always by a preponderance of the evidence; proving a defense is a defendant's burden, and again the level of proof required may differ by doctrine and defense.<sup>89</sup> Third, courts and juries are often reluctant to invalidate IP rights.<sup>90</sup> When validity and infringement are separated, the reluctance of courts to invalidate an IP right altogether means that they find it hard to reach the right result when the tools for limiting the right are classed as invalidity or general defenses rather than infringement doctrines or conduct-specific defenses. When, for example, courts understand aesthetic functionality as an all-or-nothing validity doctrine, they are reluctant to use it in individual cases in which that particular defendant has a strong competitive need to use the feature, even if others wouldn't have the same need.<sup>91</sup>

All of these problems exist even if no one tries to exploit these gaps. They are inherent disconnects between the rules of validity, infringement, and defenses. But parties inevitably seek to exploit them for their own advantage, often by trying to separate the determination of validity from the determination of infringement, either by having them done at separate times or by different decisionmakers. Whenever the two are separated, IP owners argue in the validity context that the rights are quite narrow and therefore valid, but then turn around in the infringement context and emphasize the breadth of their rights. Accused infringers do the reverse.

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<sup>88</sup> See Lemley & McKenna, *supra* note 25, at 2222–23.

<sup>89</sup> *Id.* at 2221 n.88 (“Inequitable conduct in patent law, for instance, requires proof by the defendant by clear and convincing evidence . . . Most other defenses require a defendant to show only a preponderance of the evidence.”); see also *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1287–1291 (Fed. Cir. 2011) (en banc).

<sup>90</sup> See Roger Allan Ford, *Patent Invalidity Versus Noninfringement*, 99 CORNELL L. REV. 71, 103 (2013) (arguing that courts are often too willing to resolve cases on infringement grounds even when the IP right should be invalid).

<sup>91</sup> See, e.g., *Au–Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1071 (9th Cir. 2006).

Utility patent law tries to limit that strategic behavior, and to eliminate the gaps between validity and infringement, by use of a *Markman* hearing.<sup>92</sup> There are, of course, plenty of concerns about the way *Markman* hearings are actually used,<sup>93</sup> but they have one significant virtue: they put the scope question front and center and settle on the scope of the right once and for all—a claim scope that then is held constant for validity and infringement purposes.

We lack a similar mechanism for constraining strategic behavior in other areas of IP, even though we should have all the same concerns about that outside of utility patent law.

### III. COSTS OF DIFFICULTIES WITH CLAIMING AND SCOPE

Some of the costs associated with difficulties identifying the claimed subject matter and delineating the scope of a party's rights are pretty obvious. They generally make it more difficult for parties to determine what others own, either so that they can steer clear of the protected matter or seek a license, if it's a setting in which licensing would be possible. That means we are likely to have inefficiencies in multiple directions: risk-averse licensing when licenses are not needed, and inefficient designing around when copying would have been legitimate or, perhaps, when there was a deal to be had.

Another type of cost persists even when there has been a licensing relationship. Licenses very commonly refer to legally defined rights when identifying the subject of the license—referring to particular design patents or to trade dress, for example. To the extent such a reference to legally-defined subject matter imports ambiguity regarding the boundaries of the licensed matter, parties may wind up fighting over whether conduct violates a license *even when they mean to abide by it*. I'll just use one example here, namely the case of *Premium Balloon Accessories, Inc. v. Creative Balloons Mfg., Inc.*<sup>94</sup>

Premium and Creative both made balloon accessories, including balloon weights, which are objects that weigh down helium balloons

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<sup>92</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384–87 (1996).

<sup>93</sup> See Lemley & McKenna, *supra* note 25, at 2269–71.

<sup>94</sup> 573 F. App'x. 547 (6th Cir. 2014).

so they don't fly away.<sup>95</sup> Premium had previously sued Creative, alleging that Creative's balloon weights infringed Premium's trade-dress rights in four of its balloon weights, including a star-shaped weight. The parties entered into a settlement agreement under which Creative agreed to pay Premium for “a fully paid-up license under the trade dress that was the subject of the Complaint.”<sup>96</sup> Soon after the agreement was signed, Premium began manufacturing a new star-shaped “Heavy Weight” balloon weight, which was similar in appearance to the star-shaped weight that it already sold except that it was thicker and heavier.<sup>97</sup> In 2009, Creative introduced a similar weight to the market, calling it the “SuperStar” balloon weight.<sup>98</sup> You can see what’s coming here—Premium sued Creative for infringing the trade dress of its new star-shaped Heavy Weight.<sup>99</sup> Creative argued that it had a license to use Premium's design under the previous settlement agreement, and that the new design was similar enough to the old design to be covered under that license agreement.<sup>100</sup>

The Sixth Circuit ultimately agreed with Creative that it had a license to use Premium's trade dress in certain balloon weight products, including its lighter star-shaped weight, and that the new star-shaped Heavy Weight used essentially the same trade dress as the star-shaped weight the design of which Creative licensed, albeit with minor, primarily functional modifications, such as for size and weight.<sup>101</sup>

But the parties had to litigate this case to the Sixth Circuit to understand the scope of the design rights reflected in the license. Indeed, the District Court had concluded that Creative’s new design was not the same as the old design and so wasn’t covered by a license that referred to the previous star-shaped weight.<sup>102</sup> The dispute was entirely about the scope of the trade dress subject to the license. Everyone recognized it wasn’t limited to the exact shape

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<sup>95</sup> *Id.* at 548.

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 549.

<sup>102</sup> *Premium Balloon Accessories, Inc. v. Creative Balloons Mfg., Inc.*, No. 1:10CV979, 2013 WL 3947191 (N.D. Ohio July 31, 2013).

previously used, but the scope of the design covered by the license was unclear, leaving the court with two difficult questions: (1) was Creative’s weight sufficiently *different* from the designs under the license such that the new weight was not covered by the license?; and (2) was the new weight also sufficiently *similar* to Premium’s new trade dress—which was very similar to its previous design—such that it could be considered infringing?

Let me finish by returning to something I said early on—these claiming issues create enough scope problems even if we just think about each of these areas of law in isolation. But it would be a mistake only to consider them in isolation, because it is so common for parties to assert multiple forms of rights with respect to the same design.

Take, for example, Deckers’s case against H&M.<sup>103</sup> In that case, Deckers alleged that H&M infringed a design patent covering various aspects of the design of Deckers’s UGG boots:



Figure 11: Image Comparison of Allegedly Infringing Product and Design Patent D599,999.

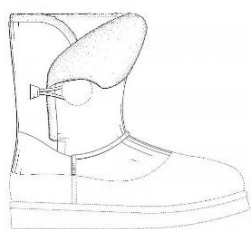
Deckers also claimed that H&M infringed its trade dress rights in the Bailey Boot, which it described as follows:

- Classic suede boot styling made famous by the UGG® Brand;

<sup>103</sup> Deckers Outdoor Corp. v. H&M Hennes & Maurtiz, L.P., No. 2:17-cv-00103. (C.D. Cal. Jan. 9, 2017).

- Overlapping of front and rear panels on lateral side of the boot shaft;
- Curved top edges on the overlapping panels;
- Exposed fleece-type lining edging the overlapping panels and top of the boot shaft; and
- One or more buttons (depending on the height of the boot) prominently featured on the lateral side of the boot shaft adjacent the overlapping panels.<sup>104</sup>

That is to say that Deckers asserted that the same H&M boots infringed both the design patent and the trade dress.<sup>105</sup> Indeed, it lined them all up side by side in the complaint:



**Design Patent D599,999**



**UGG® Bailey Button Boot**



**Defendant's Accused Boot**

Figure 12: Image Comparison of Defendant's Allegedly Infringing Products and Deckers's Bailey Button Boot and Design Patent D599,999.

Here's the piece I want to highlight: the design patent and the trade dress refer, ostensibly, to the same design, but there are some interesting and notable differences in the claims. In some ways, the trade dress claim is obviously broader than the patented design, referring for example to "one or more buttons."<sup>106</sup> That is, the trade dress claim is really to a line of boots, not to a particular boot design—boots of multiple different numbers of buttons and of different heights. The trade dress claim is also conceivably narrower in the sense that it refers to a fleece-type lining, whereas the design patent clearly depicts some kind of lining but doesn't denote a

<sup>104</sup> *Id.* at \*4.

<sup>105</sup> *Id.* at \*4–5.

<sup>106</sup> *Id.* at \*5.



material.<sup>107</sup> To figure out what it could and couldn't do, H&M would have needed to layer both of those claims on top of each other to determine their collective scope.

## CONCLUSION

The problems I've discussed here strongly indicate the need to put the scope question front and center in litigation, both conceptually and structurally. That will necessarily require that we think much more about claiming methodology in design patent, trademark, and copyright law. I certainly don't mean to suggest that we would simply want to take everything that utility patent law has done with respect to claim interpretation and import it into other areas. Obviously, there are plenty of concerns about claim construction methodology even in utility patent—though notably some significant part of that has to do with utility patent law's emphasis on language rather than on the actual invention,<sup>108</sup> a sort of analogous problem to the one I've described. We might also have good reasons to want to do interpretation differently in other areas of IP. But far too much of the law dealing with claiming and scope is being done implicitly and inconsistently now, and we would be better off if that changed.

Finally, I think these concerns ought to make us more uncomfortable with the extent of overlapping protection in this context. I have been on record elsewhere arguing for greater channeling generally in IP law.<sup>109</sup> But the reason overlap is particularly problematic here is that the variation in claim interpretation and scope determinations across different areas of IP can create significant uncertainty and opportunity for strategic manipulation. That is an especially significant concern now, since

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<sup>107</sup> See *id.* at \*8.

<sup>108</sup> See generally, Burk & Lemley, *supra* note 5; see also, Fromer, *supra* note 6, at 758.

<sup>109</sup> See Mark P. McKenna & Christopher Jon Sprigman, *What's in, and What's Out: How IP's Boundary Rules Shape Innovation*, 30 HARV. J.L. & TECH. 491 (2017); McKenna & Strandburg, *supra* note 9; Mark P. McKenna, *(Dys)functionality*, 48 HOUS. L. REV. 823 (2011); Mark P. McKenna, *An Alternate Approach to Channeling?*, 51 WM. & MARY L. REV. 873 (2009).

the majority opinion in *Star Athletica* essentially dismissed concerns about overlap, embracing the possibility of overlapping copyright and design patent protection for design.<sup>110</sup> To my mind, that would be an unwelcome development that would further exacerbate the problems I've identified here.

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<sup>110</sup> See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1015 (2017) (“[W]e have long held that design patent and copyright are not mutually exclusive.”)