
CONTENTS

<i>Preface</i>	xvii
PART I	
INTRODUCTION	1
<hr/>	
CHAPTER 1	
Introduction to Trade Dress and Design Law	3
A. Introduction: What is Design?	4
Jon Wilde, <i>Why Apple AirPods Came to Be Everywhere</i>	5
Graeme B. Dinwoodie, <i>Federalized Functionalism: The Future of Design Protection in the European Union</i>	7
Robert C. Denicola, <i>Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles</i>	9
Orit Fischman Afori, <i>Reconceptualizing Property in Designs</i>	11
Notes and Questions	13
B. The Modern Legislative Landscape for Trade Dress and Design Protection	15
1. The International Intellectual Property Law of Design	15
a. TRIPS	15
b. The Hague Agreement Concerning the International Registration of Industrial Designs	16
2. U.S. Intellectual Property Laws Regarding Design	16
a. Trademark and Unfair Competition Protection	16
b. Patent Protection	17
c. Copyright Protection	18
3. European Union Design Law	20
C. Case Study: Protecting the AirPods Design in the United States	20
Notes and Questions	22
PART II	
TRADE DRESS	25
<hr/>	
CHAPTER 2	
Distinctiveness	27
A. Trade Dress and Designs as Protectable Subject Matter under Trademark and Unfair Competition Principles	27
<i>Flagg Mfg. Co. v. Holway</i>	28
<i>George G. Fox Co. v. Hathaway</i>	29

	<i>Enterprise Mfg. Co. v. Landers, Frary & Clark</i>	30
	<i>Crescent Tool Co. v. Kilborn & Bishop Co.</i>	31
	Notes and Questions	32
	<i>Sears, Roebuck & Co. v. Stiffel Co.</i>	33
	Notes and Questions	35
	<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i>	36
	Notes and Questions	43
	<i>Kohler Co. v. Moen Inc.</i>	43
	Notes and Questions	53
B.	The Framework for Assessing Distinctiveness in Trade Dress and Design Cases	55
1.	The Abercrombie Spectrum	55
2.	The Seabrook Analysis	57
	<i>Amazing Spaces, Inc. v. Metro Mini Storage</i>	58
	Notes and Questions	64
3.	Mere Ornamentality	65
	<i>In re Lululemon Athletica Canada Inc.</i>	65
	<i>In re Peace Love World Live, LLC</i>	70
	<i>The Pennsylvania State University v. Vintage Brand, LLC</i>	72
	Notes and Questions	76
4.	The Supreme Court's Framework for Trade Dress Distinctiveness	79
	<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i>	79
	Notes and Questions	86
	<i>Qualitex Co. v. Jacobson Products Co., Inc.</i>	87
	Notes and Questions	92
	<i>Wal-Mart Stores, Inc. v. Samara Brothers, Inc.</i>	93
	Notes and Questions	97
C.	Trade Dress and Design Distinctiveness After <i>Wal-Mart</i>	99
1.	Product Design vs. Product Packaging	99
	<i>In re Slokevage</i>	99
	<i>In re Forney Industries, Inc.</i>	102
	Notes and Questions	105
2.	Secondary Meaning and Dress Definition	115
	Restatement (Third) of Unfair Competition (1995) Section 13,	
	Comment (e)	115
	<i>Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC</i>	116
	<i>In re Larian, LLC</i>	121
	<i>P and P Imports LLC v. Johnson Enterprises, LLC</i>	128
	<i>Yurman Design, Inc. v. PAJ, Inc.</i>	132
	Notes and Questions	136
CHAPTER 3		
Functionality		
A.	An Introduction to the Concept of Functionality	141
	<i>Kellogg Co. v. National Biscuit Co.</i>	141
	Notes and Questions	145
B.	The Scope of the Functionality Doctrine	146
1.	Utilitarian Features	146
	<i>In re Morton-Norwich Products, Inc.</i>	146
	Notes and Questions	153

2. Aesthetic Features	154
<i>Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.</i>	155
<i>Brunswick Corp. v. British Seagull Ltd.</i>	159
Notes and Questions	160
C. The Modern Approach to Functionality	161
1. The U.S. Supreme Court Framework	161
<i>Qualitex Co. v. Jacobson Prods. Co., Inc.</i>	162
<i>TrafFix Devices, Inc. v. Marketing Displays, Inc.</i>	163
Notes and Questions	168
2. Applying the Modern Supreme Court Framework after <i>TrafFix</i>	170
a. Utilitarian Features	171
<i>Valu Engineering, Inc. v. Rexnord Corp.</i>	171
<i>Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH</i>	174
<i>Jay Franco & Sons, Inc. v. Franek</i>	175
<i>Fuji Kogyo Co., Ltd. v. Pacific Bay Int'l, Inc.</i>	180
<i>Bodum USA, Inc. v. A Top New Casting Inc.</i>	185
<i>Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp.</i>	190
<i>Apple Inc. v. Samsung Electronics Co. Ltd.</i>	196
<i>Groeneveld Transport Efficiency v. Lubecore Int'l</i>	200
<i>McAirlaids, Inc. v. Kimberly-Clark Corp.</i>	210
Notes and Questions	214
The Evidentiary Inference: Further Notes and Questions	217
b. Aesthetic Features	221
<i>Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters</i>	221
<i>Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.</i>	225
<i>Leapers, Inc v. Smts, LLC</i>	229
<i>Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.</i>	231
Notes and Questions	238
D. Beyond Functionality?	242
<i>Vornado Air Circulation Sys., Inc. v. Duracraft Corp.</i>	243
Notes and Questions	251
<i>Bretford Mfg., Inc. v. Smith System Mfg. Corp.</i>	258
Notes and Questions	261
CHAPTER 4	
Enforcement and Defenses	263
A. Trade Dress Infringement—Likelihood of Confusion	263
1. Applying the Multifactor Test in Trade Dress Cases	265
a. Product Packaging	265
<i>J-B Weld Co., LLC v. Gorilla Glue Co.</i>	265
Notes and Questions	274
Problem 4-1: Likelihood of Confusion in Private-Label Goods Cases	279
b. Product Design	282
<i>Versa Products Company, Inc. v. Bifold Company (Manufacturing) Ltd.</i>	282
<i>Groeneveld Transport Efficiency v. Lubecore Int'l</i>	290
Notes and Questions	300
2. Confusion Away from the Point of Sale	304
<i>Ferrari S.P.A. Esercizio Fabriche Automobili e Corse v. Roberts</i>	304

Notes and Questions	308
<i>Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP</i>	310
Notes and Questions	316
B. Trade Dress Dilution and Other Non-Confusion-Based Theories	317
1. Protection Against Dilution	317
<i>Blumenthal Distributing, Inc. v. Herman Miller, Inc.</i>	319
Notes and Questions	323
2. Protection Against Counterfeiting	326
C. Permissible Use of Another's Trade Dress	327
<i>Herman Miller, Inc. v. A. Studio S.R.L.</i>	327
Notes and Questions	330
<i>Mattel Inc. v. Walking Mountain Productions</i>	332
<i>Vans, Inc. v. MSCHF Prod. Studio, Inc.</i>	338
Notes and Questions	346
Problem 4-2: Shoe "Customization"	349
D. Remedies	350

PART III

DESIGN PATENTS 351

CHAPTER 5

Securing Rights 353

Patent and Trademark Office Manual of Patent Examining Procedure	355
A. What is a "Design for an Article of Manufacture"?	358
Problem 5-1: Design Patent Protection Concurrent With Other Forms of Protection	361
<i>Curver Luxembourg, SARL v. Home Expressions Inc.</i>	364
Notes and Questions	369
Problem 5-2: The Middle Finger Design	372
B. Ornamentality and Functionality	372
<i>In re Webb</i>	376
Notes and Questions	378
<i>Best Lock Corp. v. Ilco Unican Corp.</i>	380
<i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i>	385
Notes and Questions	390
C. Novelty and Nonobviousness	397
1. Novelty	397
<i>International Seaway Trading Corp. v. Walgreens Corp.</i>	399
Notes and Questions	407
<i>In re Surgisil, L.L.P.</i>	410
Notes and Questions	411
2. Nonobviousness	411
<i>In re Rosen</i>	413
<i>Durling v. Spectrum Furniture Co., Inc.</i>	416
<i>MRC Innovations, Inc. v. Hunter Mfg., LLP</i>	419
Notes and Questions	427
Problem 5-3: Applying the Design Patent Obviousness Analysis	430
D. Adequate Disclosure	434
1. Section 112(a) Enablement and Section 112(b) Definiteness	434

<i>In re Maatita</i>	436
Notes and Questions	440
2. Section 112(a)'s Written Description Requirement	441
<i>In re Daniels</i>	441
Notes and Questions	444
CHAPTER 6	
Enforcing Rights	449
A. The Infringement Analysis	449
1. "Ordinary Observer" Test for Infringement	450
<i>Gorham Co. v. White</i>	450
Notes and Questions	454
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i>	456
Notes and Questions	465
<i>Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc.</i>	471
Notes and Questions	478
2. Claim Interpretation, Scope Functionality, and Related Doctrines	479
<i>Crocs, Inc. v. International Trade Commission</i>	480
Notes and Questions	483
<i>Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC</i>	484
Notes and Questions	490
<i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i>	494
<i>Sport Dimension, Inc. v. Coleman Co., Inc.</i>	499
<i>Lanard Toys Ltd. v. Dolgencorp LLC</i>	503
Notes and Questions	508
3. Permissible Use	509
<i>Automotive Body Parts Assoc. v. Ford Global Techs., LLC</i>	509
Notes and Questions	511
B. Remedies	512
1. Injunctive Relief	513
<i>Apple Inc. v. Samsung Elec. Co., Ltd.</i>	513
Notes and Questions	518
2. Damages	519
<i>Samsung Electronics Co., Ltd. v. Apple Inc.</i>	519
Notes and Questions	523
PART IV	
COPYRIGHT	527
<hr/>	
CHAPTER 7	
Copyright	529
A. Copyrightability in General	529
1. Originality	529
<i>Yurman Studio, Inc. v. Castaneda</i>	530
Notes and Questions	532
2. The Section 102(b) Exclusions	534
<i>Herbert Rosenthal Jewelry Corp. v. Kalpakian</i>	535
Notes and Questions	537

B. “Pictorial, Graphic and Sculptural Works”: Useful Articles and the Separability Doctrine	538
1. Copyright Protection for the Design of Useful Articles	538
<i>Mazer v. Stein</i>	538
Notes and Questions	542
2. The Separability Doctrine under the 1976 Act	543
<i>Star Athletica, L.L.C. v. Varsity Brands, Inc.</i>	544
Notes and Questions	558
<i>Silvertop Associates Inc. v. Kangaroo Manufacturing Inc.</i>	561
Problem 7-1: Assessing the Usefulness of Costumes	565
Problem 7-2: Applying the Conceptual Separability Standard	566
C. Scope of Copyright Protection	568
1. Copyright Infringement	569
<i>Peter Pan Fabrics, Inc. v. Martin Weiner Corp.</i>	569
<i>Tj, Inc. v. GMA Accessories, Inc.</i>	571
<i>JCW Investments, Inc. v. Novelty, Inc.</i>	574
<i>Mattel, Inc. v. MGA Ent., Inc.</i>	578
Notes and Questions	583
Problem 7-3: Assessing Infringement	585
Problem 7-4: Assessing Scope	586
2. Defenses to Infringement	586
<i>Mattel Inc. v. Walking Mountain Productions</i>	587
Notes and Questions	593
Problem 7-5: Assessing Fair Use	593
3. Remedies	595
D. Architectural Works	595
<i>T-Peg, Inc. v. Vermont Timber Works, Inc.</i>	595
Notes and Questions	601
<i>Leicester v. Warner Brothers</i>	603
Notes and Questions	616
E. Works of Visual Art	617
<i>Kelley v. Chicago Park District</i>	617
<i>Cheffins v. Stewart</i>	626
<i>Castillo v. G&M Realty L.P.</i>	634
Notes and Questions	640
Problem 7-6: Brother Billy’s Salvage Yard and Museum	642
<i>Martin v. City of Indianapolis</i>	643
<i>Massachusetts Museum of Contemporary Art Foundation Inc. v. Büchel</i>	647
Notes and Questions	655

PART V

SUI GENERIS REGIMES 657

CHAPTER 8

Sui Generis Design Protection 659

A. Design Rights in the European Union	659
1. Introduction	659
a. Responses to the Costs of Registration	660
b. Relationship between Registered and Unregistered E.U.-Wide Rights	661
Notes and Questions	661

2. Subject Matter of Design Protection	665
Notes and Questions	666
3. Exclusions: Functionality	668
a. Direct Functionality Exclusions	669
Community Design Regulation, Article 8	670
<i>Lindner Recyclingtech GmbH v. Franssons Verkstäder AB</i>	670
<i>DOCERAM GmbH v. CeramTec GmbH</i>	675
Notes and Questions	679
b. Component Parts of Complex Products	680
Community Design Regulation, Article 4	681
<i>Monz Int'l GmbH & Co. KG v. Büchel GmbH & Co. Fahrzeugtechnik KG</i>	681
Notes and Questions	684
4. Thresholds for Protection	685
a. Prior Disclosures	685
Community Design Regulation, Article 7	686
<i>Green Lane Prod. v. PMS Int'l Grp.</i>	686
Notes and Questions	694
b. Novelty	696
Community Design Regulation	696
<i>Imperial Int'l Ltd. v. Handl Cookware Ltd.</i>	696
Notes and Questions	699
c. Individual Character	700
Community Design Regulation, Article 6	701
<i>PepsiCo, Inc. v. Grupo Promer Mon Graphic SA & OHIM</i>	701
Notes and Questions	707
<i>Karen Millen Fashions Ltd. v. Dunnes Stores</i>	710
Notes and Questions	713
5. Infringement	714
Community Design Regulation	714
<i>Procter & Gamble Co. v. Reckitt Benckiser (UK) Ltd.</i>	714
Notes and Questions	725
<i>Samsung Elec. (UK) Ltd. v. Apple Inc.</i>	726
Notes and Questions	736
<i>PMS Int'l Grp. v. Magmatic Ltd.</i>	737
Notes and Questions	748
6. Limitations on the Protection of E.U. Designs	749
Notes and Questions	751
B. Sui Generis Regimes Under U.S. Law	753
Notes and Questions	757
Epilogue	758
<i>Table of Cases</i>	759
<i>Index</i>	775

