

PRODUCT APPEARANCE IN THE LAW OF UNFAIR COMPETITION—PREEMPTION OR PROTECTION?*

WHEN a producer seeks judicial relief from a competitor's alleged pirating of the design or identifying feature of his product, and has been unable to secure protection under a federal design patent, he may yet persuade a court to protect him from his competitor's allegedly underhanded behavior, on the basis of doctrines derived from common-law unfair competition. One line of cases would grant relief, both injunctive and in damages, against persons who can be shown to have attempted to capitalize on the innovating producer's reputation by "palming off" their products as those of the innovator. Another, based upon state court expansion of principles suggested by the Supreme Court, grants similar relief against a competitor who "misappropriates" the innovator's product, selling it as his own. Perhaps prompted by the desire to find a means of protecting innovators against copying where patent protection seems inadequate, some courts have now stretched the boundaries of traditional unfair competition to such an extent that they seem to trespass on a congressional balance struck between free consumer choice and producer protection. Two Seventh Circuit decisions, recently granted certiorari by the Supreme Court,¹ raise interesting questions concerning the extent to which state law of unfair competition may prohibit imitation of commercial product designs—the extent to which state authorities may share control of the market place with federal. In *Day-Brite Lighting, Inc. v. Compco Corp.*,² defendant marketed copies of plaintiff's industrial fluorescent lighting fixture. In *Stiffel Co. v. Sears, Roebuck & Co.*,³ defendants sold copies of plaintiff's floor-to-ceiling pole lamp. In both cases, plaintiffs held design patents on their products; in both cases, the patents were declared invalid.⁴ Nevertheless, the plaintiffs succeeded in obtaining injunctions against further imitation on the ground that defendants were engaged in unfair competition as a matter of Illinois law.⁵

**Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26 (7th Cir. 1962); *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115 (7th Cir. 1963).

1. *Compco Corp. v. Day-Brite Lighting, Inc.*, 83 Sup. Ct. 1868 (1963); *Sears, Roebuck & Co. v. Stiffel Co.*, 83 Sup. Ct. 1868 (1963).

2. 311 F.2d 26 (7th Cir. 1962).

3. 313 F.2d 115 (7th Cir. 1963).

4. In *Day-Brite* the court found that the design was directed by the manufacturing process and thus did not meet the standard of invention for a design patent. 311 F.2d at 28-29. In *Stiffel* the design was found to have been on the market for more than a year before application for patent and was thus invalid because "anticipated in the prior art." 313 F.2d at 117.

5. 311 F.2d at 30; 313 F.2d at 118 n.7. Jurisdiction rested on 28 U.S.C. § 1338(b) (1958), which allows federal courts to hear unfair competition claims when "joined with a substantial and related claim under the copyright, patent or trade-mark laws."

Local law applies to claims of unfair competition and common-law trade-mark infringement. *Pecheur Lozenge Co. v. National Candy Co.*, 315 U.S. 666, 667 (1942).

These holdings are only the most recent evidence of extensions of the common-law protection against the imitation of product design. Traditionally, it has been considered unfair competition for a merchant to "palm off" his product as that of his competitor by using the competitor's trade name, if it could be shown that the buying public associated that name with a single source and bought the product because of its source.⁶ It is the attempt to capitalize on this public identification which constitutes the legally improper act. The notion of unfair competition was extended to design copying on the theory that a particular feature of a product may itself have acquired a capacity for identifying its source to the consumer.⁷ Thus, when a competitor copies design elements which are relied upon by consumers as an indication of source, courts have found actionable unfair competition.⁸

But design copying has not been proscribed as freely as trade name imitation. Because courts have also been concerned with the importance of competition and with ensuring a high degree of consumer choice, the traditional doctrine places serious limitations on the availability of injunctions for trade name or design imitation. Where identifying terms are concerned, distinctions are drawn between generic words and words which are primarily identifiers of a particular source.⁹ Correspondingly, courts have distinguished between design features which are "functional"—a term of art which denotes, in addition to usefulness, any feature of a product which in itself makes the product more desirable to consumers¹⁰—and those which are "nonfunctional"—a mere arbitrary embellishment to the product which may serve to identify its source.¹¹ Generally, courts have enjoined imitation only where the product design with this identification characteristic is nonfunctional.¹² In the instances in which consumers rely upon functional design aspects—for example, the pink color of Pepto-Bismol,¹³ or the shape of a Zippo lighter¹⁴—for source identification,

6. See 1 NIMS, UNFAIR COMPETITION AND TRADE-MARKS § 37 (4th ed. 1947).

7. *Id.* § 134, at 370-71.

8. *Ibid.*

9. See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111-18 (1938); 1 NIMS, *op. cit. supra* note 6, § 41.

10. See, e.g., *Ainsworth v. Gill Glass & Fixture Co.*, 26 F. Supp. 183 (E.D. Pa. 1938), *aff'd*, 106 F.2d 491 (3d Cir. 1939). See generally 1 NIMS, *op. cit. supra* note 6, § 134, at 375; *Developments in the Law—Trade-marks and Unfair Competition*, 68 HARV. L. REV. 814, 856 (1955).

11. *Pagliari v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952); *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 Fed. 299 (2d Cir. 1917). See 1 NIMS, *op. cit. supra* note 6, at §§ 116-33.

12. See Pollack, *Unfair Trading By Product Simulation: Rule or Rankle?*, 23 OHIO ST. L.J. 74, 76 (1962); Note, 72 HARV. L. REV. 1520, 1527-28 (1959).

13. *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569 (2d Cir. 1959), *cert. denied*, 362 U.S. 919 (1960).

14. *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670 (S.D.N.Y. 1963).

imitation is tolerated. But the imitator will be required by the court to take reasonable steps to distinguish himself from the other source.¹⁵

Thus, in the absence of legislation, courts have opted for a doctrine which permits competitors to offer substantially the same products to consumers.¹⁶ Although it is frequently difficult to distinguish between nonfunctional and functional aspects of a product,¹⁷ common-law doctrines of unfair competition insist that the distinction be drawn, in the interests of a specific social policy fostering product competition.¹⁸ The only limit imposed on imitation, in the name of proscribing "unfair competition," is directed to imitation of a competitor's identity. This limitation is required if the general desideratum of competition is to be obtained. Only if a consumer can exercise choice among rival producers or vendors, by identifying a product's source or sponsorship, can the judgment of the competitive market place be effectuated.¹⁹

A preliminary objection to the Seventh Circuit's decisions in *Day-Brite* and *Stiffel* is that the court found enjoined unfair competition without inquiring into actual consumer reliance upon the duplicated design elements as an indication of preferred source.²⁰ It awarded relief to plaintiffs solely on the basis

15. *Zippo Mfg. Co. v. Rogers Imports, Inc.*, *supra* note 14, at 697; *J. C. Penny Co. v. H. D. Lee Mercantile Co.*, 120 F.2d 949 (8th Cir. 1941); *Champion Spark Plug Co. v. A. R. Mosler & Co.*, 233 Fed. 112 (S.D.N.Y. 1916); RESTATEMENT, TORTS § 741(b) (ii) (1938).

16. See Chafee, *Unfair Competition*, 53 HARV. L. REV. 1289, 1317-18 (1940); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938); *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 270-71 (2d Cir. 1959), *cert. denied*, 361 U.S. 915 (1960) (decision for plaintiff on other grounds); Rahl, *The Right to "Appropriate" Trade Values*, 23 OHIO ST. L.J. 56, 71-72 (1962).

17. Pollack, *supra* note 12, at 77.

18. See Rahl, *supra* note 16, at 71-72; 1 NIMS, *op. cit. supra* note 6, § 13, at 79; § 134, at 373-75.

19. See 1 NIMS, *op. cit. supra* note 6, § 187; Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 LAW & CONTEMP. PROB. 173, 180 (1949); Comment, *Quality Control and the Antitrust Laws in Trademark Licensing*, 72 YALE L.J. 1171, 1174-78 (1963).

20. [I]t is . . . an absolute condition precedent to any relief whatever that the plaintiff . . . show that the appearance of his wares has in fact come to mean that some particular person . . . makes them, and that the public cares who does make them, and not merely for their appearance and structure. . . .

Crescent Tool Co. v. Kilborn & Bishop Co., 247 Fed. 299, 300 (2d Cir. 1917) (L. Hand, J.).

Accord, *Day-Brite Lighting, Inc. v. Sandee Mfg. Co.*, 286 F.2d 596, 600 (7th Cir. 1960); *Zangerle & Peterson Co. v. Venice Furniture Novelty Mfg. Co.*, 133 F.2d 266, 270 (7th Cir. 1943); *Vaughan Novelty Mfg. Co. v. G. G. Greene Mfg. Corp.*, 202 F.2d 172, 173 (3d Cir.), *cert. denied*, 346 U.S. 820 (1953); *Sinko v. Snow-Craggs Corp.*, 105 F.2d 450 (7th Cir. 1939). See generally Stern, *Buyer Indifference and Secondary Meaning in Unfair Competition and Trademark Cases*, 32 CONN. BAR J. 381 (1958). *But cf.* 3 CALLMAN, THE LAW OF UNFAIR COMPETITION AND TRADEMARKS § 80.5 (2d ed. 1950).

There is a line of cases which seem to support a theory that relief will be given if the imitation of a product is likely to cause confusion, even in the absence of a showing that

of a showing that the goods were confusingly similar in appearance.²¹ But, even if consumers were confused as to source, it need not follow that consumers bought one product *because* of its source. The consumers may have been indifferent to the source of the pole lamps or fluorescent lights. Indeed, the opinion in *Stiffel* indicated that Sears, Roebuck was marketing a pole lamp identical to Stiffel's at a substantially lower price, and that consumers seemed to prefer the cheaper copy to the original.²²

The Seventh Circuit seemed to recognize that it was shifting from the traditional standard, requiring a showing that consumer purchases stemmed from identification of design element with a desired source.²³ It sought to find justification for dispensing with the element of consumer motive in favor of a holding that only a likelihood of consumer confusion as to source need be shown, by analogy from a parallel development in the Illinois law of trade names.²⁴ The attempt may have been prompted by a combination of circumstances: the mandate of *Erie R.R. v. Tompkins*²⁵ to a federal court sitting on law matters and the fact that the question presented by *Stiffel* and *Day-Brite* had not arisen in Illinois courts.²⁶ But the difference between trade name protection and design protection may be so fundamental in terms of the effect on competition, that the extension of the standard by analogy is improper. Even if confusingly similar trade names on competing products are prohibited, the consumer will not be short-changed: competing producers may still put before him a host of identical products under different names. In product imitation cases, on the other hand, each relaxation of proof requirements upon the producer seeking exclusivity for his wares is likely to reduce the number of like products offered to consumers. In *Stiffel* and *Day-Brite*, the Seventh Circuit extended the common-law unfair competition doctrine to deprive consumers of goods they

the imitated features are associated with source in the minds of the buying public. 3 CALLMAN, *op. cit. supra*, § 77.4(e)2, at 1259-60. The better view, it is submitted, is that taken by Prof. E. H. Pollack—that these cases do not constitute anything more than a “procedural variation of the majority rule” and cannot be distinguished substantively. Pollack, *supra* note 12, at 86-95.

21. 311 F.2d at 29; 313 F.2d at 118.

22. *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115, 118 (7th Cir. 1963). And see Appendix to Brief for Plaintiff-Appellant, pp. 53-54.

23. *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26, 30 (7th Cir. 1962); *Stiffel Co. v. Sears, Roebuck & Co.*, *supra* note 22, at 118 n.7.

24. *Investors Syndicate v. Hughes*, 378 Ill. 413, 38 N.E.2d 754 (1941); *Lady Esther, Ltd. v. Lady Esther Corset Shoppe, Inc.*, 317 Ill. App. 451, 46 N.E.2d 165 (1943). See generally CHICAGO BAR ASS'N, *THE LAW OF COMPETITION IN ILLINOIS* 78-85 (1962).

The Court rejected its own relevant precedents in the area of product imitation (see Seventh Circuit cases cited at note 20 *supra*) in favor of past Seventh Circuit trade name cases developed on the Illinois state trend. See, *e.g.*, *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.*, 205 F.2d 921 (7th Cir. 1953); *Radio Shack Corp. v. Radio Shack, Inc.*, 180 F.2d 200 (7th Cir. 1950).

25. 304 U.S. 64 (1938).

26. There is dictum in an 1870 Illinois trade name case which states a policy condoning extensive product copying. *Candee, Swan & Co. v. Deere & Co.*, 54 Ill. 439, 461 (1870).

probably purchased for bargain rather than for source. It is questionable whether this use of the doctrine can be justified as protecting any substantial consumer interest.

A more serious objection to the Seventh Circuit's decision arises from its failure to consider the distinction between "functional" and "nonfunctional" aspects of design in framing its relief. Despite indications that both cases involved functional aspects of design,²⁷ the court, ignoring the distinction, required both defendants wholly to cease marketing their imitative products.²⁸ But if the copied features were functional, the remedy most consonant with the common-law policy of protecting competition in similar products would have been to allow the defendants to continue manufacture and sale, but to require them to label their products more clearly, so that source confusion would be eliminated.²⁹ By virtue of the full injunctive remedies granted, both cases present in classic outline the problem of increasing overlap between common-law principles of unfair competition and federal regulation of market practices through the patent and antitrust laws.³⁰ This overlap may have been prompted to some degree by the frequency with which patent protection is denied—particularly in the case of design patents.³¹ After such failure, a producer naturally may be expected to look to the development of common-law remedies which will immunize his market from the intrusion of competition. Courts sympathetic to the producer's plea for effective protection of his innovations will respond.³² Perhaps reflecting such sympathies, both cases present the curious spectacle of the state law of unfair competition replacing and exceeding federal patent law in granting relief to producers seeking a product monopoly on the basis of their purported innovations.

The spectacle is of recent birth. When, in 1938, the Supreme Court last considered an unfair competition case treating product imitation, in *Kellogg*

27. In *Day-Brite*, the design patent was held invalid because the design was functional in the sense that it was dictated by the manufacturing process. 311 F.2d at 28.

In *Stiffel* there was evidence that the design innovation had a great impact on the trade and was moving toward a mass market. This would seem to indicate functionality in the sense of customer appeal. 313 F.2d at 118.

Aside from the question of customer appeal, it would seem that there would be some features of a floor-to-ceiling lighting fixture essential to the genus "pole lamp" which, barring patent protection, are free to be imitated.

28. *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26, 29 (7th Cir. 1962); Appendix to Brief for Plaintiff-Appellant, p. 351, *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115 (7th Cir. 1963).

29. See authorities cited at note 15 *supra*.

30. See *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 277-82 (2d Cir. 1959) (Clark, J., dissenting), *cert. denied*, 361 U.S. 915 (1960); Pollack, *A Projection for the Revaluation of Unfair Competition*, 13 OHIO ST. L.J. 187, 222-26 (1952).

31. See Note, 72 HARV. L. REV. 1520, 1521-24 (1959); Note, 59 COLUM. L. REV. 902, 904-05 (1959). S. 776, 88th Cong., 1st Sess. (1963), recently passed by the Senate, would provide a design registration system with greatly relaxed standards of originality and inventiveness.

32. See Note, 72 HARV. L. REV. 1520, 1528 (1959); Note, 59 COLUM. L. REV. 902, 906 (1959) (extra-legal attempts to protect products).

Co. v. National Biscuit Co.,³³ it could portray unfair competition law in the traditional terms related above. In *Kellogg*, respondent sought protection for both the name of its product—shredded wheat—and the distinctive shape in which it was manufactured.³⁴ The Court, denying protection, explicitly indicated that consumers' interests in free imitation were to be preferred to producers' interests in guarding exclusive markets for their products.³⁵ In these circumstances, the Court did not find it necessary to hold that this result was dictated by considerations of pre-emption, although its presentation of the federal common law of unfair competition, which it assumed to be the same as current state law, reflected an interdependence between common-law and statutory protections.³⁶ Since *Kellogg*, however, there have been persistent movements to expand the law proscribing product imitation beyond that expressed in *Kellogg*. Just as the Seventh Circuit in *Day-Brite* purported to rest its analysis on considerations of "old fashioned honesty,"³⁷ other courts prompted by the same notions have applied, as a branch of unfair competition law, the doctrine of "misappropriation."³⁸ Under both approaches the result is the same; product imitations are broadly restrained. The Supreme Court could fruitfully use the Seventh Circuit opinions in *Day-Brite* and *Stiffel* as occasions for considering the propriety of these general attempts to expand state remedies for product imitation against the backdrop of federal legislation.

33. 305 U.S. 111 (1938).

34. Patents on the machines used to make shredded wheat had expired, and a design patent on the shape of the shredded wheat biscuit had previously been held invalid. 305 U.S. at 119 n.4.

35. It is urged that all possibility of deception or confusion would be removed if [defendant] . . . should refrain from using the name "Shredded Wheat" and adopt some form other than the pillow-shape. But the name and form are integral parts of the goodwill of the article. To share fully in the goodwill [defendant] . . . must use the name and the pillow-shape. And in the goodwill, [defendant] . . . is as free to share as the plaintiff. . . . Sharing in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.

Id. at 121-22.

36. *Id.* at 113 n.1.

37. Indeed, in *Day-Brite*, the heart of the Seventh Circuit's indictment of the defendant appears to rest here; the court stated

. . . several choices of ribbing were apparently available to meet the functional needs of the product. The defendant did not avail itself of the other type but instead chose precisely the same design used by the plaintiff. . . . The essence of "unfair competition" is that it be unfair, that "in all cases of unfair competition, it is principles of old fashioned honesty which are controlling."

Day-Brite Lighting, Inc. v. Compco Corp., 311 F.2d 26, 30 (7th Cir. 1962).

38. The most notable example is *Dior v. Milton*, 9 Misc. 2d 425, 155 N.Y.S.2d 443 (Sup. Ct.), *aff'd*, 2 App. Div. 2d 878, 156 N.Y.S.2d 996 (1956). See Stern & Hoffman, *Public Injury and the Public Interest: Secondary Meaning in the Law of Unfair Competition*, 110 U. PA. L. REV. 935, 941, 969 (1962).

Advocates of state restraint on product imitation may argue that pre-*Erie* decisions of federal courts permitted a federal common law of unfair competition to exist, despite overlap with the policy declared, *inter alia* by the federal patent laws, and that state common law should be no more narrowly treated. The strongest support for this argument appears to arise from the Supreme Court's promulgation of the misappropriation doctrine in *International News Service v. Associated Press*³⁹—a case in which the competitor, I.N.S., was barred from copying and marketing A.P. news releases while they still had commercial value. But, although there are dicta of considerable breadth in the opinion,⁴⁰ the case on its facts is strongly reminiscent of common-law conversion. The true "product" marketed by the A.P. was the intangible "service" of making news available, rather than the tangible news releases themselves.⁴¹ Thus the I.N.S., in copying the releases and selling them, was doing more than imitating the type of services performed by the A.P.; the I.N.S. was taking A.P.'s intangible "product" and selling it as its own. And when the argument was made by producers that the dicta should be expansively interpreted, to provide the broad protection against copying now characteristic of some courts' use of the misappropriation doctrine,⁴² it met formidable opposition. In 1929, Judge Learned Hand said for the Second Circuit, in *Cheney Bros. v. Doris Silk Corp.*,⁴³ that reliance on a broad misappropriation doctrine arising from *I.N.S. v. A.P.* was misplaced; he suggested that common-law remedies might be seriously limited by relevant federal legislation. Judge Hand stated that, if the argument for a broad reading of *I.N.S. v. A.P.* were to prevail, the court must:

. . . suppose that the [Supreme Court] meant to create a sort of common-law patent or copyright for reasons of justice. Either would flagrantly conflict with the scheme which Congress has for more than a century devised to cover the subject-matter.

. . . To exclude others from the enjoyment of a chattel is one thing; to prevent any imitation of it, to set up a monopoly in the plan of its

39. 248 U.S. 215 (1918).

40. [D]efendant, by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown, and . . . is appropriating to itself the harvest of those who have sown. Stripped of all disguises, the process amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not. . . .

248 U.S. at 239-40.

41. It has been suggested that "intangible services" is the key to distinguishing cases where the misappropriation doctrine may or may not be validly applied. Rahl, *The Right to "Appropriate" Trade Values*, 23 *Ohio St. L.J.* 56, 57-67 and *passim* (1962).

42. See authorities cited at note 38 *supra*.

43. 35 F.2d 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930).

structure, gives the author a power over his fellows vastly greater, a power which the Constitution allows only Congress to create.⁴⁴

In addition to using the federal patent and copyright laws to construe away the expansive *I.N.S. v. A.P.* dicta, Judge Hand may have been indicating that the Constitution, through the patent clause,⁴⁵ has an inhibiting effect on the ability of judges to "create a sort of common-law patent or copyright. . . ." This reading of *I.N.S. v. A.P.*, far from supporting expanded state protection by federal common-law precedent, indicates that this expansion is prohibited even to the federal courts. It argues for, rather than against, pre-emption. At the least, Judge Hand's reasoning would prevent state legislation and common-law development which restrained product imitation to a greater extent than limitations on producer action derived from congressional statutes. It recognizes that the result of producer monopoly sanctioned by the patent clause is an exception to the overall pattern encouraging producer competition in the national economy.⁴⁶ The exception is tolerated only "to promote the progress of science and useful arts" and the decision as to what constitutes protectible activity is vested in Congress.⁴⁷ When protection is afforded through application of unfair competition doctrines, promotion of progress is no longer a criterion: it is the producer's identity, not his inventiveness, that is being preserved and rewarded. Furthermore, when protection is afforded under the constitutional grant, it is for only "limited times,"⁴⁸ in recognition of the necessity that even patented ideas must eventually be dedicated to the public. When a remedy is formulated under common-law principles, the market shelter given the producer is usually of unlimited duration.⁴⁹ In *Day-Brite* and *Stiffel*, the court, by granting protection against limitation for an indefinite period of time, gave an exclusive market for the same features of the product to which

44. *Id.* at 280.

45. The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. CONSR. art. I, § 8.

46. A federal patent is available to anyone who invents a "new, original and ornamental design." 35 U.S.C. § 171 (1958). The courts have required high levels of inventiveness and originality. See, *e.g.*, *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 681 (1893); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950). See generally, authorities cited at note 32 *supra*. Because patent privileges are restrictive of the free market function, they are strictly construed. See *United States v. Masonite Corp.*, 316 U.S. 265, 280 (1942); *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 92 (1941).

47. See *Pennock v. Dialogue*, 2 Pet. (27 U.S.) 1, 17-21 (1829); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 171 (1896); Chafee, *Unfair Competition*, 53 HARV. L. REV. 1289, 1318 (1940); BARNETT, PATENT PROPERTY AND THE ANTI-MONOPOLY LAWS 20-22 (1943).

48. A design patent may be obtained for up to fourteen years. 35 U.S.C. § 173 (1958).

49. See, *e.g.*, *Pope Automatic Merchandising Co. v. McCrum-Howell Co.*, 191 Fed. 979, 981-82 (7th Cir. 1911).

Congress had denied protection, and to which it could have agreed to extend protection for only a limited time. Congressional judgment concerning the degree to which it is socially desirable to protect product originators, despite inhibition of market place competition, is thus superseded; by virtue of the supremacy clause of the Constitution, state law which establishes a different balance should give way.

Pre-emption as a solution to problems of state-federal relationships always poses problems of breadth. What activities of the state fall within the ban of supremacy? Arguably, federal law completely pre-empts the regulatory field, preventing states from granting even relief consonant with that available under the patent program.⁵⁰ No patent right existed at common law;⁵¹ the power to grant patents lay only in the sovereign and was a matter of grace.⁵² Prior to the explicit grant of such power to Congress by the Constitution, the states had exercised such sovereign power, but their grants were of little value.⁵³ And the importance of a national policy concerning the prevalence of economic concentration in the market place might reaffirm a need for centrally established regulation. The discouraging experience with state competency⁵⁴ and the complexity of procedural and substantive standards in the patent area⁵⁵ might leave unmistakable the conclusion that federal regulation is "so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it."⁵⁶

Federal pre-emption in regard to patent protection does not mean, however, that states will be totally divested of a regulatory power in the consumer area. Design patent laws and statutes of that ilk do not deal with the problem of consumer deception—of confusion as to source. And here the functional-

50. A well considered argument for federal supremacy is advanced in an amicus curiae brief recently filed by the United States in the *Day-Brite* and *Stiffel* cases. Brief for the United States as Amicus Curiae, *Compco Corp. v. Day-Brite Lighting, Inc.*, appeal docketed, No. 106, U.S. Sup. Ct. O.T. 1963; *Sears, Roebuck & Co. v. Stiffel Co.*, appeal docketed, No. 108, U.S. Sup. Ct. O.T. 1963, *passim*.

51. *Wheaton v. Peters*, 8 Pet. (33 U.S.) 591, 656, 658 (1834) (copyright case); *Gayler v. Wilder*, 10 How. (51 U.S.) 477, 494 (1850); 2 WALKER, PATENTS § 220, at 1162 (Deller ed. 1937).

52. See generally 1 WALKER, PATENTS §§ 1-5 (Deller ed. 1937).

53. *Id.* § 7, at 28.

54. The patent power came to rest in the federal government early in the nation's life. See INLOW, THE PATENT GRANT 44 (1950). No doubt this was prompted by the Patent Act of 1793, which made relinquishment of any prior state rights a prerequisite to obtaining federal protection. 1 Stat. 318, 322 (1793).

55. See, e.g., 4 WALKER, PATENTS (Deller ed. 1937) (entire volume devoted to pleading, practice and forms); 2 *id.* ch. IX, "The Patent Application."; 1 *id.* (entire volume devoted to substantive requirements for patent).

56. *Pennsylvania v. Nelson*, 350 U.S. 497, 502 (1955), *rehearing denied*, 351 U.S. 934 (1956) (quoting from *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1946)). See *Hines v. Davidowitz*, 312 U.S. 52, 66, 67, 73-74 (1941); *cf.* *Sperry v. Florida*, 373 U.S. 379 (1963).

nonfunctional distinction abandoned by the Seventh Circuit recurs. Those elements of a design which hold promise of inherent appeal to the purchasing public fall within the scope of federal patent laws; consequently, the decision to grant or deny monopoly control should be made by the federal government. But protection of nonfunctional elements of design signifying source, the chief concern of traditional common-law doctrine, does not raise questions of product monopoly.⁵⁷ Nor does the limited protection given by traditional common-law doctrines to producer-identifying functional aspects offend or interfere with federal patent protection. Federal law does not foreclose injunctive relief against copying of nonfunctional aspects of design which serve to identify source; neither does it prevent state courts from requiring clearer labeling where functional aspects of design have been imitated with a resultant likelihood of consumer confusion. The courts which have acted under the revived misappropriation doctrine and the Seventh Circuit in *Day-Brite* and *Stiffel* have overlooked the fact that the producer's right to his commercial identity arises from the common-law policy of protecting consumer choice. These courts have abstracted and extended the producer's right to the point where it inhibits rather than aids the exercise of consumer choice in the product market, as measured by the balance established by federal law.

57. See authorities cited at note 11 *supra*.