

FOOD FOR THOUGHT: INTELLECTUAL PROPERTY PROTECTION FOR RECIPES AND FOOD DESIGNS

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“Always remember: If you’re alone in the kitchen and you drop the lamb, you can always just pick it up. Who’s going to know?”

— Julia Child¹

ABSTRACT

As any chef will tell you, cooking and food preparation is a creative, sometimes innovative, endeavor. Much thought and time is invested in selecting ingredients, developing the process for preparing the dish, and designing an interesting or appealing look and feel for a food item. If this is true, then it should come as no surprise that recipes, food designs, and other culinary creations can be protected by various forms of intellectual property, namely: trade secrets, design and utility patents, trade dress, but usually not copyright. This article considers how intellectual property law has been applied to protect recipes and food designs, along with broader issues relating to how these rights may overlap and their implications for competition.

INTRODUCTION

“One cannot think well, love well, sleep well, if one has not dined well.”² We are a society that has become increasingly obsessed with food. Food and cooking shows are television’s fastest-growing subgenre.³ Food blogging has become a lucrative industry.⁴ One can go to any fine dining establishment and observe patrons taking pictures of their food and posting those pictures on their social media before digging in. A unique recipe might be the core asset of a specialty restaurant.⁵ Not unexpectedly, chefs,

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¹ Mike Sager, *Julia Child: What I’ve Learned*, ESQUIRE (Aug. 15, 2014), <https://www.esquire.com/food-drink/interviews/a1273/julia-child-quotes-0601/#ixzz1uygKZ7hJ>.

² VIRGINIA WOOLF, *A ROOM OF ONE’S OWN* 23 (Harcourt, Inc. 1929).

³ Michael O’Connell, *Welcome to Peak Food TV: Inside Hollywood’s Growing Hunger for Culinary Shows*, HOLLYWOOD REP. (July 19, 2019, 6:00 AM), <https://www.hollywoodreporter.com/features/gordon-ramsay-more-hollywoods-growing-hunger-food-tv-shows-1225214>.

⁴ One food blog, Pinch of Yum, reports that in just one month (November 2016), it brought in over \$95,000 in revenue. See Jillian Kramer, *How to Make a Living as a Food Blogger*, FOOD & WINE (Mar. 22, 2018), <https://www.foodandwine.com/news/make-living-food-blogger>.

⁵ Some examples of well-known “signature dishes” include the Brown Derby’s cobb salad, Spago’s house-smoked salmon pizza, and Nobu’s black cod with

restaurant owners, and others involved in the culinary world often consider their recipes and food designs to be creatively invented works of art. As such, can recipes and food design be protected by intellectual property rights that are available to more traditional inventions and forms of art?

This article explores whether two aspects of food preparation – recipes and the design of the food itself – are eligible for protection by the principal forms of intellectual property. In Part I, this article explores the various forms of available intellectual property protection: trade secrets, copyright, utility and design patents, and trademarks and trade dress. Next, we analyze whether and how intellectual property rights have been used to protect recipes and food design. The article concludes that the availability of intellectual property protection for recipes and food design, and the requirements for such protection, varies greatly depending on the form of protection sought. For both recipes and food design, copyright offers limited or no protection. Recipes may find some protection with trade secrets and utility patents. Food design may be eligible for both design patent and trade dress protection. The strongest protection for food designs may arise from some combination of the two.

In Part II, this article explores whether there should be intellectual property protection for recipes and food design at all and, if so, under what circumstances. There is existing intellectual property protection for various items: dinosaur-shaped crackers, heart-shaped candy canes, irregular-shaped hamburger patties, cupcakes with swirl icing, hot dogs with crisscross cuts, among other food designs. We consider whether such broad protection serves or hinders the purposes of intellectual property protection. Finally, we address how existing intellectual property law enables an owner of a food design to circumvent the Supreme Court's requirement that product designs have secondary meaning before they are entitled to trademark protection by permitting the owner to initially seek design patent protection, use its period of limited monopoly to develop secondary meaning, and thereafter obtain potentially infinite trademark protection.

I. AN OVERVIEW OF INTELLECTUAL PROPERTY PROTECTION FOR RECIPES AND FOOD DESIGN

The best known forms of available intellectual property protection are trade secrets, copyrights, utility and design patents, and trademarks and trade dress. In this part, we consider whether and to what extent intellectual property rights have been used to protect recipes and food designs. In practice, we find that there is uneven protection for food as well as important limitations on that protection.

A. Trade Secrets

Trade secret protection promotes the diffusion of knowledge, economic development, and the maintenance of standards of commercial ethics.⁶ A trade secret is business information with actual or potential

miso. See Beth Kracklauer, *9 Signature Dishes*, SAVEUR (Mar. 10, 2009), <https://www.saveur.com/article/Kitchen/9-Signature-Dishes>.

⁶ See generally *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481–93 (1974).

economic value and is subject to reasonable measures to maintain its secrecy.⁷ As long as the information is not generally known to the public, has a potential economic benefit or competitive advantage to the business, and is subject to reasonable efforts to maintain its secrecy, trade secret protection can last indefinitely.⁸ There is no registration or examination process required.⁹ Trade secrets encompass technical and financial data, recipes, chemical formulas, compilations of data, computer programs, devices, methods and systems, techniques, processes, and lists of actual or potential customers or suppliers.¹⁰

The information must be sufficiently secret so that the owner derives actual or potential economic value because it is not generally known or readily ascertainable.¹¹ Finally, to ensure that the information is not generally known or easily discovered, the owner must make reasonable efforts to maintain the secrecy of the information.¹² Liability for trade secret misappropriation results when a person acquires another's trade secret by improper means or uses or discloses it without the trade secret owner's permission.¹³ Improper means include obtaining the trade secret by "bribery, misrepresentation, breach or inducement" to breach a duty to keep the information secret or industrial espionage.¹⁴ However, liability for misappropriation can be negated by proof of reverse engineering of a lawfully acquired product containing the trade secret,¹⁵ "or through [the] independent discovery of the same information constituting the trade secret."¹⁶

As to food design—the shape and appearance of food—trade secret protection is unlikely to be available. Food design presents a formidable challenge to trade secret protection: once the food is displayed and distributed to consumers, its design is no longer secret.¹⁷ However, under trade secret law, certain recipes, formulas, and manufacturing and

⁷ See UNIF. TRADE SECRETS ACT § 1(4) (amended 1985), 14 U.L.A. 538 (2005) [hereinafter UTSA].

⁸ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 39 (AM. L. INST. 1995) [hereinafter Restatement].

⁹ See Michael R. McGurk & Jia W. Lu, *The Intersection of Patents and Trade Secrets*, 7 HASTINGS SCI. & TECH. L. J. 189, 191 (2015).

¹⁰ See Restatement § 39 cmt. d. In addition, a trade secret can be "negative" information or know-how that results from research blind alleys, failed designs, and methods that do not work. *Id.* at cmt. e. The information need not be novel, in continuous use, or exist in a tangible form to be protected. *Id.* at cmt. f.

¹¹ UTSA § 1(4)(i).

¹² *Id.* § 1(4)(ii).

¹³ *Id.* § 1(2).

¹⁴ *Id.* § 1(1).

¹⁵ "Reverse engineering is the process by which an engineer takes an already existing product and works backward to re-create its design and/or manufacturing process." *United Techs. Corp. v. FAA*, 102 F.3d 688, 690 n.1 (2d Cir. 1996).

¹⁶ See Kurt M. Saunders & Nina Golden, *Skill or Secret? — The Line Between Trade Secrets and Employee General Skill and Knowledge*, 15 N.Y.U. J. L. & BUS. 61, 75 (2018).

¹⁷ Of course, the process or procedure for creating the food design could be a trade secret if it was maintained in secrecy and not readily ascertainable by others in the industry. See *supra* notes 11–12 and accompanying text.

preparation processes may be protected. Some of the more well-known protected formulas and recipes are the original recipe for Kentucky Fried Chicken, the recipes for Twinkies and Krispy Kreme donuts, and, for a time, McDonald's special sauce.¹⁸ When recipes have not qualified for trade secret protection, an often-cited reason is their lack of economic value in the trade secret sense. Basic cooking and food preparation methods and concepts are ineligible for trade secret protection because they are already known or too easily discoverable to derive value from secrecy. In *Buffets, Inc. v. Klinke*,¹⁹ for instance, the court held that the plaintiff could not claim trade secret protection for recipes for buffet cuisine, such as barbecued chicken and macaroni and cheese, because they were American staples and generally known.²⁰ By contrast, the court in *Peggy Lawton Kitchens, Inc. v. Hogan*²¹ found that a carefully guarded recipe for nut meal infused chocolate chip cookies had economic value because the cookies had an original and distinctive flavor and had been a commercial success.²²

Also critical to successfully maintaining a recipe as a trade secret is a requirement that the owner takes reasonable steps to maintain its secrecy. Here, absolute secrecy is not required, and the reasonableness of the measures taken to maintain secrecy depends on the particular circumstances of the business, including the nature of the product or service, the state of the art in the trade or industry, and the level of risk of disclosure.²³ For instance, many chefs rely on nondisclosure agreements to preserve the secrecy of their recipes.²⁴ The case of *Magistro v. J. Lou, Inc.*²⁵ involved recipes for pizza dough and tomato sauce used in a family restaurant business. Only family members created and prepared the recipes and no one outside the family knew the recipes. The owners protected the family recipes by putting the ingredients into packets that were sealed and refrigerated until needed, and an employee would add water to make the sauce and the dough.²⁶ Based on these efforts, the court concluded that the recipes derived independent economic value from not

¹⁸ See Babak Zarin, *Knead to Know: Cracking Recipes and Trade Secret Law*, 8 ELON L. REV. 183, 192 (2016).

¹⁹ 73 F.3d 965 (9th Cir. 1996).

²⁰ See *id.* at 968–69. See also *Li v. Shuman*, No. 5:14-cv-00030, 2016 WL 7217855, at *20 (W.D. Va. 2016) (holding that recipes for common Asian dishes are generally known); *Little Caesar Enters., Inc. v. Sioux Falls Pizza Co.*, No. CIV. 12-4111-KES, 2012 WL 3190788, at *3 (D.S.D. 2012) (holding that systems for making ready-to-pick-up pizzas are generally known and lack economic value); *Vraiment Hosp., LLC v. Binkowski*, No. 8:11-CV-1240-T-33TGW, 2021 WL 1493737, at *14 (M.D. Fla. 2012) (holding that a recipe for salted caramel brownies is not secret because it can be found on the internet).

²¹ 466 N.E.2d 138 (Mass. Ct. App. 1984).

²² See *id.* at 140.

²³ See Saunders & Golden, *supra* note 16, at 73.

²⁴ See Emily Cunningham, *Protecting Cuisine Under the Rubric of Intellectual Property Law: Should the Law Play a Bigger Role in the Kitchen*, 9 J. HIGH TECH. L. 21, 49–50 (2009).

²⁵ 703 N.W.2d 887 (Neb. 2005).

²⁶ See *id.* at 890–91.

being known to other persons and that the owners made reasonable efforts under the circumstances to maintain their secrecy.²⁷

Even when one can establish that a recipe is a trade secret, a claim of misappropriation depends on proof that the defendant either acquired the recipe through improper means or used or disclosed it without consent.²⁸ In *Magistro*, even though the court agreed that recipes were protectable trade secrets, the plaintiffs failed to prove that the defendant was using their trade secrets, so their claim failed.²⁹ By contrast, in *Bimbo Bakeries USA, Inc. v. Botticella*,³⁰ the owner of the recipe for Thomas' English Muffins, including the secret behind the muffins' unique "nooks and crannies" texture, prevailed in obtaining a preliminary injunction based on threatened misappropriation against a former senior executive who had accepted a similar position working for a competitor.³¹ According to the court in *Botticella*, there was sufficient evidence that the former employee intended to use the trade secret because he had not disclosed his acceptance of a job offer from a direct competitor, remained in a position to receive confidential information after committing to the other job, and copied trade secret information from his work laptop onto external storage devices.³²

As these cases demonstrate, it is imperative that a recipe is not merely kept confidential, but that its value is derived from its uniqueness within the industry. Finally, owners of trade secrets in recipes must remember that they are not protected from reverse engineering of the recipes by others, nor can they assert their trade secret rights against others who independently develop the same or similar recipes. A claim for relief must be based on evidence of actual or threatened misappropriation of the trade secret at issue.³³ Nevertheless, due to its potentially unlimited duration and informality by which it can be established, trade secrecy remains an attractive form of protection for recipes.³⁴

²⁷ *Id.* at 891.

²⁸ *See supra* notes 13–14 and accompanying text.

²⁹ *See Magistro*, 703 N.W.2d at 892.

³⁰ 613 F.3d 102 (3d Cir. 2010).

³¹ *Id.* at 119.

³² *Id.* at 118. *See also* Revzip, LLC v. McDonnell, No. 3:19-cv-191, 2020 WL 1929523, at *8–9 (W.D. Pa. 2020) (requiring employees to sign confidentiality agreements, disclosing the recipes for sandwich dressing only on a need-to-know basis, and protecting the recipes with electronic security were reasonable secrecy measures); Uncle B's Bakery, Inc. v. O'Rourke, 920 F. Supp. 1405 (N.D. Iowa 1996) (injunction against former employee to protect bagel air tight packaging process); Christopher M's Hand Poured Fudge, Inc. v. Hennon, 699 A.2d 1272 (Pa. Super. Ct. 1997) (injunction against former employee to protect secret recipe and manufacturing process).

³³ *See* UTSA §§ 2, 3.

³⁴ For a more detailed discussion of the advantages of trade secret protection for recipes, see Babak, *supra* note 18.

B. Copyrights

Copyright protection affords “a set of exclusive rights granted to authors as to the ownership and use of their creative works.”³⁵ The work of authorship must be original and fixed in a tangible medium to qualify for protection, like being recorded or preserved in some steady, physical form.³⁶ The Copyright Act provides that the fixation requirement has been met “when its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”³⁷ Originality requires that the work’s origin is the author, who has not copied it from another source.³⁸ Moreover, the work must demonstrate “some minimal degree of creativity.”³⁹

According to the Copyright Act, copyright protection extends only to the original and fixed expression embodied in works of authorship, including (1) literary works; (2) musical works; (3) dramatic works; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and audiovisual works; (7) sound recordings; and (8) architectural designs.⁴⁰ Computer software can be protected as well.⁴¹ A compilation of facts or data is protected to the extent that there is originality in selecting, coordinating, or arranging the elements.⁴² However, ideas, discoveries, principles, methods, procedures, and useful articles are not eligible for copyright protection.⁴³ Only expression is protected, but the merger doctrine dictates that the expression is uncopyrightable when there is only one way to express the idea or fact.⁴⁴

Copyright protection for a work of authorship vests the moment an original work is fixed, regardless of whether it is ever published. Although not required, the copyright owner may register the copyright

³⁵ KURT M. SAUNDERS, *INTELLECTUAL PROPERTY LAW: LEGAL ASPECTS OF INNOVATION AND COMPETITION* 259 (2016).

³⁶ Copyright Act of 1976, 17 U.S.C. § 102(a). A work is “fixed” when embodied in a copy or phonorecord, both of which are defined in the Copyright Act as a material object. *See id.* § 101. The embodied work must be stable rather than temporary or transient to be fixed. *See, e.g.,* Kelley v. Chi. Park Dist., 635 F.3d 290, 303 (7th Cir. 2011) (reasoning “that a living garden lacks the kind of authorship and stable fixation normally required to support copyright”); Stern Elecs., Inc. v. Kaufman, 669 F.2d 852 (2d Cir. 1982) (explaining that a video game satisfies fixation because of “[t]he repetitive sequence of a substantial portion of the sights and sounds of the game”).

³⁷ 17 U.S.C. § 101.

³⁸ *See* Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

³⁹ *Id.*

⁴⁰ 17 U.S.C. § 102(a).

⁴¹ *See* Comput. Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 702 (2d Cir. 1992).

⁴² *See Feist*, 499 U.S. at 345.

⁴³ 17 U.S.C. § 102(b) (1990).

⁴⁴ *See* Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458 (5th Cir. 1990) (holding that maps of pipeline locations are not copyrightable); *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 673 (1st Cir. 1967) (holding that subject matter of contest rules is not copyrightable).

with the U.S. Copyright Office.⁴⁵ The term of copyright protection for most works is the author's lifetime, plus seventy years.⁴⁶ Copyright owners have the exclusive rights to reproduce their works, adapt their works to create derivative works, publicly distribute them, and publicly perform and display their works.⁴⁷ In addition, the copyright owner may transfer by license or assignment any or all of these rights to another.⁴⁸ Any person who exercises any of the copyright owner's exclusive rights without authorization may be liable for copyright infringement.⁴⁹

As applied to recipes, copyright law affords little protection. At the risk of making cooking sound like a mechanical operation, courts have viewed recipes as processes or procedures for creating or assembling a particular dish. As section 102(b) provides, “[i]n no case does copyright protection for an original work of authorship extend to any . . . procedure [or] process . . .”⁵⁰ In other words, most recipes do not constitute original expression. The court in *Publications International, Ltd. v. Meredith Corp.*⁵¹ explained that “the content of recipes are clearly dictated by functional considerations, and . . . lack the required element of originality.”⁵² That case involved a cookbook compilation of recipes made with yogurt, which the court viewed as functional lists of ingredients and directions on how to combine them.⁵³ Similarly, in *Lambing v. Godiva Chocolatier*,⁵⁴ the court held that a recipe for a chocolate truffle was not copyrightable since it was a mere statement of facts and lacking in any expressive content.⁵⁵ One might view the lack of originality in recipes as a merger of idea, fact, and expression since the nature of the dish dictates the listing of ingredients and the directions for preparation.⁵⁶ As the court in *Sassafras Enterprises, Inc. v. Roshco, Inc.*⁵⁷ explained, recipes are ineligible for copyright protection because they “dictate themselves and flow from the characteristics and intended use of the product, not from the imagination of any independent author.”⁵⁸

⁴⁵ 17 U.S.C. § 408(a) (2005). Registration creates a presumption of ownership of a valid copyright. See H.R. REP. NO. 94-1476, at 157 (1976), *reprinted in* 17 U.S.C. § 410 (1976).

⁴⁶ See 17 U.S.C. § 302(a) (1998).

⁴⁷ See *id.* § 106 (2002).

⁴⁸ See *id.* § 201(d) (1978).

⁴⁹ See *id.* § 501(a) (2019).

⁵⁰ *Id.* § 102(b) (1990) (internal punctuation omitted).

⁵¹ 88 F.3d 473 (7th Cir. 1996).

⁵² *Id.* at 481 (quoting MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.18[1], at 2-204.25 to .26 (May 1996)). *Accord* Harrell v. St. John, 792 F. Supp. 2d 933 (S.D. Miss. 2011).

⁵³ *Publ'ns Int'l*, 88 F.3d at 480.

⁵⁴ 142 F.3d 434 (6th Cir. 1998).

⁵⁵ *Id.* at 434.

⁵⁶ See *Lorenzana v. S. Am. Rests. Corp.*, 799 F.3d 31, 34 (1st Cir. 2015) (holding that a recipe as a combination of ingredients for making a sandwich not copyrightable); *Lapine v. Seinfeld*, 375 Fed. Appx. 81, 83 (2d Cir. 2010) (holding that the underlying idea of recipes containing vegetable purees for hidden use in children's food is not copyrightable).

⁵⁷ 889 F. Supp. 343 (N.D. Ill. 1995).

⁵⁸ *Id.* at 347.

On the other hand, recipes containing other original expression, such as commentary or artistic elements, could qualify for protection. In *Barbour v. Head*,⁵⁹ for instance, the court distinguished between rote recitations of ingredients and instructions to find copyrightable expression in the “light-hearted or helpful commentary” that accompanied the recipes in a Texas-themed cookbook.⁶⁰ This echoes the court’s statement in *Publications International* that recipes warranting protection may be those where the recipe includes expressive content such as “suggestions for presentation, advice on wines to go with the meal, or hints on place settings with appropriate music,” or where the recipes are accompanied by “tales of their historical or ethnic origin.”⁶¹ Other courts have found similar expression warranting protection to include the use of pictures and illustrations, quotations and poems, handwritten script, and similar artistic and graphic elements.⁶² Nevertheless, others would be free to explain or illustrate a recipe using dissimilar expressions.

Although most recipes themselves may garner no copyright protection, a compilation of recipes may be protected if their selection, coordination, and arrangement are original.⁶³ For instance, in *Tomaydo-Tomahhdo, LLC v. Vozary*,⁶⁴ the plaintiffs asserted copyright protection for a book of recipes for family-friendly foods based on its restaurant menu. After observing that the recipes themselves did not merit copyright protection because they were factual statements and functional directions, the court reasoned that protection might extend to a book of recipes to the degree that the compilation demonstrates originality in selecting or arranging of the recipes.⁶⁵ However, the court found that the compilation of family-friendly recipes was not original because the plaintiffs never identified what was original and creative in the process of selecting and arranging them.⁶⁶

Courts have noted that food and specifically food designs, are typically ineligible for copyright protection because they do not satisfy the Copyright Act’s requirement that the work be fixed in a tangible medium.⁶⁷ In *Kim Seng Co. v. J & A Importers, Inc.*,⁶⁸ the plaintiff claimed

⁵⁹ 178 F. Supp. 2d 758 (S.D. Tex. 2001).

⁶⁰ *Id.* at 764.

⁶¹ *Publ’ns Int’l, Ltd. v. Meredith Corp.*, 88 F.3d 473, 481 (7th Cir. 1996).

⁶² *See, e.g., Branch v. Ogilvy & Mather, Inc.*, No. 89 CIV. 2440 LLS, 1990 WL 74540 (S.D.N.Y. 1990).

⁶³ Section 101 of the Copyright Act defines a “compilation” as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101 (2018).

⁶⁴ 629 F. App’x. 658 (6th Cir. 2015).

⁶⁵ *Id.* at 661.

⁶⁶ *Id.* One court has found that the lack of originality problem can extend to photographs of cooked food dishes as well. *See Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 546 (S.D.N.Y. 2001) (holding that photos of common Chinese dishes as they appear on plates served to customers were insufficiently original for copyright protection).

⁶⁷ *See supra* note 37 and accompanying text.

⁶⁸ 810 F. Supp. 2d 1046 (C.D. Cal. 2011).

copyright protection for a food sculpture of a traditional Vietnamese dish.⁶⁹ The court, however, found that the sculpture failed to satisfy the fixation requirement of the Copyright Act.⁷⁰ Relying on *Kelley v. Chicago Park District*,⁷¹ the court found that a bowl of perishable food similarly did not satisfy the fixation requirement because it was not sufficiently stable or permanent.⁷²

Furthermore, the court in *Kim Seng* reasoned that the combination of unprotectable elements in a display of traditional Vietnamese cuisine lacked originality and were inseparable from their underlying utilitarian purpose, which is to be consumed.⁷³ This issue is directly related to copyright protection of the design of any three-dimensional work of useful or applied art. Copyright protection extends to applied art “only if, and only to the extent that, such design incorporates . . . sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”⁷⁴ As such, any artistic or aesthetic elements of a dish would have to be identified separately from the food and exist independent of the utilitarian purpose of consuming the food. It is difficult to imagine that many food sculptures or designs could meet this requirement unless they were created for the purpose of not being eaten.⁷⁵

In sum, the limitations and restrictions of copyright law make it an impractical fit for recipes and food designs. Basic recipes alone are not copyrightable unless the recipes contain a sufficient number of other original expressions beyond and unrelated to the listing of ingredients and the procedure for combining them. Likewise, recipes are also unprotectable unless protection is sought for a compilation of recipes that reflect a requisite measure of originality in selecting and arranging those recipes.⁷⁶ As for food displays, designs, and sculptures, the primary

⁶⁹ *Id.* at 1051.

⁷⁰ *Id.* at 1054.

⁷¹ 635 F.3d 290, 303 (7th Cir. 2011) (holding that an artistically arranged living garden was not stable or permanent enough to be a work of fixed authorship).

⁷² *Kim Seng Co.*, 810 F. Supp. 2d at 1054. For the same reason, tattoos and facial make-up designs are not fixed on human skin, although courts have ruled that such works can be fixed if recorded on paper or in photographs. See *Mourabit v. Klein*, 816 F. Appx. 574 (2d Cir. 2020) (make-up artistry); *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16-CV-724-LTS-SDA, 2018 WL 1626145 (S.D.N.Y. 2018) (tattoos). However, infringement would be difficult to prove if the tattoo or make-up appeared on a person’s skin since it would not itself be a copy. See Saunders, *supra* note 35, at 270 (“The unauthorized copy must be fixed in a material object . . .”).

⁷³ *Kim Seng Co.*, 810 F. Supp. 2d at 1053.

⁷⁴ 17 U.S.C. § 101.

⁷⁵ More than one commentator has proposed expanding the Copyright Act’s protection for moral rights in works of visual art to encompass protection for “food art.” See Caroline M. Reeb, *Extending Copyright Protection to Food Art*, 22 DEPAUL J. ART, TECH. & INTELL. PROP. L. 41 (2011); Cathay Y. Smith, *Food Art: Protecting “Food Presentation” Under U.S. Intellectual Property Law*, 14 J. MARSHALL REV. INTELL. PROP. L. 1 (2014).

⁷⁶ See *supra* notes 63–66 and accompanying text.

roadblock to protection is that they cannot meet the fixation requirement⁷⁷ for copyrightability and suffer from the secondary barrier of being ultimately inseparable from their underlying utilitarian purpose as edible food.⁷⁸

C. Utility and Design Patents

A patent is a right granted by the United States, which allows an inventor to exclude others from practicing the invention during the patent term.⁷⁹ In other words, patents protect inventions.⁸⁰ The purpose of patent law is to promote the progress of the useful arts by disclosing inventions in exchange for a limited term of protection.⁸¹ The two main types of patents are utility patents and design patents.

1. Utility Patent Protection

A utility patent can be granted on a “process, machine, manufacture, or composition of matter or any new and useful improvement thereof.”⁸² A recipe typically describes a list of ingredients, instructions on combining and cooking them, and the resulting food product or dish. Since a recipe consists of a list of ingredients and instructions, a recipe can be considered a process and a food product or dish as a composition of matter or a manufacture. To obtain a patent, a party must apply to the U.S. Patent & Trademark Office, where it is subject to a detailed examination process to determine whether the claimed invention satisfies the requirements for patentability.⁸³ If granted, the term of protection for a utility patent is twenty years from the date the application was filed.⁸⁴ A patent owner has the right to exclude others from making, using, selling, or offering to sell, and importing the invention in the United States.⁸⁵

An invention must be useful, novel, and nonobvious to qualify for patent protection.⁸⁶ An invention is useful only if it has a practical application or serves a specific benefit.⁸⁷ In the case of recipes or food products, the utility requirement would be met if the invention is a process for preparing edible food or if the product itself was an article or combination of ingredients that could be consumed.⁸⁸ Novelty is demonstrated if the claimed invention has never before been publicly disclosed through use, sale, patenting, or publication anywhere in the

⁷⁷ See *supra* notes 67–72 and accompanying text.

⁷⁸ See *supra* notes 73–75 and accompanying text.

⁷⁹ See Saunders, *supra* note 35, at 97.

⁸⁰ See 35 U.S.C. § 101 (2018) (providing that inventors may obtain patents).

⁸¹ See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974).

⁸² 35 U.S.C. § 101.

⁸³ For an explanation of the patent application and examination process, see AMY L. LANDERS, *UNDERSTANDING PATENT LAW* 19–56 (2d ed. 2012).

⁸⁴ See 35 U.S.C. § 154(a)(2).

⁸⁵ *Id.* § 271(a).

⁸⁶ *Id.* §§ 101, 102(a), 103.

⁸⁷ See *Brenner v. Manson*, 383 U.S. 519, 534–35 (1966).

⁸⁸ See Morgan P. Arons, *A Chef's Guide to Patent Protections Available for Cooking Techniques and Recipes in the Era of Postmodern Cuisine and Molecular Gastronomy*, 10 J. BUS. & TECH. L. 137, 141 (2015).

world before the date on which the patent application was filed.⁸⁹ There is an exception if the inventor has publicly disclosed the invention, as long as the inventor files an application within one year after the date of the disclosure.⁹⁰

Novelty is a technical and precise requirement. To disqualify a patent application for lack of novelty, the preceding disclosure must involve a single prior art source or reference that disclosed an identical invention to that claimed in the application.⁹¹ The prior disclosure must be enabling, so that those who are knowledgeable in the field can understand it,⁹² and it must be publicly accessible so as to be located.⁹³ In the context of food, this means that the recipe or food product must be new in the sense that it represents a previously unknown combination of ingredients or variation on a known recipe.⁹⁴ In *Proctor & Gamble Co. v. Nabisco Brands*,⁹⁵ Proctor & Gamble had secured a patent for a recipe and process for making a dual-textured cookie—crispy on the outside and chewy on the inside—by baking and tempering the laminated dough structure.⁹⁶ When the defendants began marketing their own dual-textured cookies, Proctor & Gamble sued for infringement, and the defendants argued that the patent was invalid and unenforceable based on a cookie recipe published in an earlier cookbook. After examining each element of the claimed invention, the court determined that the recipe and process were invalid as anticipated by the earlier recipe found in the printed publication.⁹⁷

In addition to being novel, the invention must be nonobvious. Because novelty and nonobviousness are distinct requirements, even if a recipe or food product is novel, the recipe or food product could still be considered obvious and unpatentable. An invention is nonobvious when those of ordinary skill in the field and familiar with the existing technology would not have easily conceived it.⁹⁸ In other words, if the differences between the invention and prior art are such that make the invention obvious at the time it was made to persons with ordinary skill in the art,

⁸⁹ See 35 U.S.C. § 102(a)(1).

⁹⁰ *Id.* § 102(b).

⁹¹ See Saunders, *supra* note 35, at 124.

⁹² *Impax Lab'ys, Inc. v. Aventis Pharms. Inc.*, 468 F.3d 1366, 1383 (Fed. Cir. 2006) (“In order to be anticipating, a prior art reference must be enabling so that the claimed subject matter may be made or used by one skilled in the art.”).

⁹³ See *Jazz Pharms., Inc. v. Amneal Pharms., LLC*, 895 F.3d 1347, 1355–56 (Fed. Cir. 2018) (“A reference is considered publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’” (quoting *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981)).

⁹⁴ See Arons, *supra* note 88, at 141.

⁹⁵ 711 F. Supp. 759 (D. Del. 1989).

⁹⁶ *Id.* at 760.

⁹⁷ *Id.* at 773.

⁹⁸ See 35 U.S.C. § 103.

then it is not patentable.⁹⁹ Thus, the key to assessing nonobviousness is to compare the invention as a whole with the references in the prior art.¹⁰⁰ If an objective person skilled in the art would have found the claimed invention to be an obvious next step beyond the current field of technology, then the invention is obvious.¹⁰¹ If the combination, preparation, or variations of known ingredients leads to expected results or flavors because the ingredients react in well-understood ways, the product is likely to be considered obvious to a person having ordinary culinary arts skills.¹⁰²

The utility patent at issue in *Ex parte Kretchman*¹⁰³ illustrates these points. An invention relating to a crustless peanut butter and jelly sandwich was the issue at the heart of *Kretchman*.¹⁰⁴ The patent application described an arrangement of the jelly layer in the center so that it is surrounded by the peanut butter layers and crimped at the edges to prevent the jelly from leaking out.¹⁰⁵ When the patent examiner rejected the application because the patent was invalid due to obviousness, Smucker appealed.¹⁰⁶ The prior art references included a book of recipes describing a device for creating a crustless sandwich.¹⁰⁷ Another prior art reference was a newspaper article that recommended applying peanut butter to both pieces of bread before the jelly to prevent the bread from becoming soggy.¹⁰⁸ Based on these references, the Board of Patent Appeals and Interferences¹⁰⁹ ruled that the patent was invalid because those of ordinary skill in the field would consider the Smucker invention obvious.¹¹⁰

⁹⁹ Unlike lack of novelty due to any single source of prior art that discloses the same invention, a finding of obviousness may be based on a combination of prior art sources that deal with the same problem or together suggest the same solution to the problem. See *In re Nylene*, 97 Fed. Appx. 293 (Fed. Cir. 2004); *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992).

¹⁰⁰ See Landers, *supra* note 83, at 365.

¹⁰¹ See *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 399 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

¹⁰² See Arons, *supra* note 88, at 145.

¹⁰³ No. 2003-1754, 2003 WL 23507730 (B.P.A.I. Dec. 10, 2003).

¹⁰⁴ *Id.* at *1.

¹⁰⁵ *Id.* at *2.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at *2–3.

¹⁰⁸ *Id.*

¹⁰⁹ This board is now known as the Patent Trial and Appeal Board. It conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings. It also hears appeals from adverse examiner decisions in patent applications and reexamination proceedings, and renders decisions in interferences. See generally *Patent Trial and Appeal Board*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/patents/ptab> (last visited Apr. 2, 2021).

¹¹⁰ See *Kretchman*, at *6–7. Specifically, the Board explained that based on the two prior art references, “one of ordinary skill in the art . . . would [understand] . . . that the peanut butter should be applied in a manner so as to encapsulate the jelly, that is, the jelly layer would be made smaller in area so that it does not contact the bread.” *Id.* at *7.

Despite the apparent difficulties in securing utility patents, utility patents have been granted for recipes and food products. Examples include: a recipe for instant stuffing mix,¹¹¹ a method for making a microwaveable sponge cake,¹¹² burrito on a stick,¹¹³ cereal coated with dry milk,¹¹⁴ a process for making fruit ganache,¹¹⁵ yogurt cream cheese,¹¹⁶ microwaveable sponge cake,¹¹⁷ sugarless baked goods,¹¹⁸ an egg substitute,¹¹⁹ processes for making fried baked potato pieces,¹²⁰ low-fat potato chips,¹²¹ frozen popsicles,¹²² and battered foods.¹²³ While it is often difficult to meet the requirements for obtaining a utility patent, it offers one of the most robust forms of intellectual property protection allowing the patentee to exclude all others from using the recipe, or making, selling, or importing the food product.¹²⁴ However, it must be kept in mind that the length of protection is finite—expiring after twenty years—thus allowing the recipes or food product to become part of the public domain at that time.¹²⁵

2. Design Patent Protection

While utility patents protect how an article works and is used, design patents protect how an article looks. A design patent protects new, original, and ornamental designs for articles of manufacture.¹²⁶ An article of manufacture is a product that results from a manufacturing process.¹²⁷ The design consists of the visual ornamental characteristics embodied in or applied to an article of manufacture.¹²⁸ Design patents have been issued for a broad assortment of products—including furniture, tools, automobiles, water fountains, vending machines, microwave ovens, tire

¹¹¹ U.S. Patent No. 3,870,803 (filed Jul. 7, 1971).

¹¹² U.S. Patent No. 6,410,074B1 (filed Oct. 4, 2000).

¹¹³ U.S. Patent No. 4,399,156 (filed Jan. 25, 1982).

¹¹⁴ U.S. Patent No. 6,051,262 (filed July 27, 1998).

¹¹⁵ U.S. Patent No. 5,958,503 (filed Feb. 21, 1997).

¹¹⁶ U.S. Patent No. 7,258,886 (filed Mar. 18, 2005).

¹¹⁷ U.S. Patent No. 6,410,074 (filed Feb. 9, 2001).

¹¹⁸ U.S. Patent No. 5,700,511A (filed Mar. 1, 1996).

¹¹⁹ U.S. Patent No. 4,120,986 (filed June 28, 1977).

¹²⁰ U.S. Patent No. 8,329,244 (filed July 15, 2011).

¹²¹ U.S. Patent No. 8,163,321 (filed Oct. 31, 2007).

¹²² *Popsicle Corp. v. Weiss*, 40 F.2d 301, 302 (S.D.N.Y. 1929).

¹²³ U.S. Patent No. 6,117,463 (filed Nov. 25, 1998).

¹²⁴ See *supra* note 85 and accompanying text.

¹²⁵ See *supra* note 84 and accompanying text.

¹²⁶ 35 U.S.C. § 171.

¹²⁷ See *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016) (observing that “[a]n article of manufacture, then, is simply a thing made by hand or machine”).

¹²⁸ See MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (9th ed. Rev. 10.2019, June 2020) [hereinafter MPEP] (reviewing case law that defines the subject matter of design patents).

tread, and computer screen icons.¹²⁹ The term of a design patent is limited to 15 years from the date the patent is granted.¹³⁰

As to the requirements for design patent protection, originality requires that the design originate with the applicant.¹³¹ A design is novel if no prior art reference publicly discloses the identical design before the application was filed.¹³² In addition, the design must be nonobvious. A design is nonobvious if a designer of ordinary skill who designs articles of the same type would consider differences in the visual appearance of the design and those from the prior art not to be obvious.¹³³ Furthermore, the design must be ornamental and nonfunctional.¹³⁴ If its function dictated the entire appearance of the article, then the design is not ornamental.¹³⁵ If a particular design is essential to the use of an article because it is dictated by the use or purpose of the article or enhances the article's performance, then the design is functional.¹³⁶

¹²⁹ *E.g.*, U.S. Patent No. D485,709 (filed Apr. 16, 2003) (furniture); U.S. Patent No. D772,671 (filed June 24, 2015) (hammer); U.S. Patent No. D732,431 (filed Aug. 15, 2014) (motor car); Application of Hruby, 373 F.2d 997 (C.C.P.A. 1967) (water fountain); Unidynamics Corp. v. Automatic Prods. Int'l, Ltd., 157 F.3d 1311 (Fed. Cir. 1998) (vending machine); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423 (Fed. Cir. 1984) (microwave oven); Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113 (Fed. Cir. 1998) (tire tread); U.S. Patent No. D668,263 (filed Oct. 8, 2010) (computer icon).

¹³⁰ 35 U.S.C. § 173. Design patents usually contain a single claim comprised of a drawing, unlike a utility patent, which contains multiple textual claims. Design patent claims are limited to what is shown in the application drawings. *See* MPEP § 1503.02. As with utility patents, a design patent must disclose the claimed design with definiteness as assessed by an ordinary observer. *See In re Maatita*, 900 F.3d 1369, 1377 (Fed. Cir. 2018).

¹³¹ *See Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009) (suggesting that the originality requirement for design patents, like that for copyright, requires that the design have originated with the creator).

¹³² 35 U.S.C. § 102(a). However, such a disclosure will not be treated as prior art if the design was publicly disclosed by the applicant one year or less before filing a patent application. *Id.* § 102(b).

¹³³ *See Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). In determining nonobviousness, the patent examiner considers whether a prior art reference or a combination of references shares design characteristics that are basically the same as the visual impression created by the claimed design. If a designer of ordinary skill would be likely to believe this, then the claimed design is obvious and not patentable. *See* MPEP § 1504.03.

¹³⁴ 35 U.S.C. § 171.

¹³⁵ *See Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557 (Fed. Cir. 1988) (noting that the analysis of ornamentality is holistic, focusing on the overall appearance of the claimed design rather than the appearance of the article itself). Courts may consider the availability of alternative designs for the article as an important and persuasive factor in evaluating the functionality of a claimed design. *Id.*

¹³⁶ *See Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996); *Auto. Body Parts Ass'n v. Ford Global Techs., LLC*, 930 F.3d 1314, 1320–21 (Fed. Cir. 2019) (explaining that “*Best Lock* turned on the admitted fact that no alternatively designed blade would mechanically operate the lock—not that the blade and lock were aesthetically compatible”). Of course, since some articles of manufacture

A number of food designs have been granted design patents: dinosaur-shaped crackers,¹³⁷ a cheesecake with embedded swirl,¹³⁸ a teddy-bear-shaped sugar confection,¹³⁹ stuffed pizza pockets,¹⁴⁰ a deep dish pizza slice,¹⁴¹ heart-shaped candy canes,¹⁴² waffles,¹⁴³ chocolate bars,¹⁴⁴ and embossed bread,¹⁴⁵ among others. In addition, many patented designs apply to well-known branded products, including: Mars Candy bars,¹⁴⁶ Breyer's Viennetta frozen desserts,¹⁴⁷ Wrigley's Eclipse gum,¹⁴⁸ Coldstone Creamery's Strawberry Passion ice cream cake,¹⁴⁹ Morton salt blocks,¹⁵⁰ numerous Kraft pastas,¹⁵¹ and Frito Lay snack food products.¹⁵²

As with utility patents, a design patent confers the right to exclude others from making, using, selling, importing, and offering to sell certain products bearing the same or substantially similar appearance to the patented design.¹⁵³ Proving infringement of a design patent requires that the accused design be identical or substantially the same as the patented design.¹⁵⁴ This determination is made from the standpoint of the ordinary observer.¹⁵⁵ Under this test, infringement occurs when—in the view of an ordinary observer familiar with prior art design—the similarities are substantially the same so that the ordinary observer would believe that the allegedly infringing design is the same as the overall patented design.¹⁵⁶

may possess both functional and ornamental characteristics, they may be protected by both utility and design patents.

¹³⁷ U.S. Patent No. D782,777 (filed May 9, 2016).

¹³⁸ U.S. Patent No. D762,342 (filed Dec. 18, 2014).

¹³⁹ U.S. Patent No. D788,400 (filed Jun. 30, 2016).

¹⁴⁰ U.S. Patent No. D784,650 (filed Mar. 19, 2015).

¹⁴¹ U.S. Patent No. D783,225 (filed Apr. 9, 2015).

¹⁴² U.S. Patent No. D785,900 (filed Sep. 24, 2009).

¹⁴³ U.S. Patent No. D373,452 (filed Sep. 20, 1995).

¹⁴⁴ U.S. Patent No. D788,401 (filed Nov. 5, 2012).

¹⁴⁵ U.S. Patent No. D790,154 (filed Jan. 14, 2016).

¹⁴⁶ U.S. Patent No. D593,276 (filed Jul. 10, 2008).

¹⁴⁷ U.S. Patent No. D486,951 (filed Nov. 18, 2002).

¹⁴⁸ U.S. Patent No. D539,007 (filed Sep. 5, 2003).

¹⁴⁹ U.S. Patent No. D571,526 (filed Jun. 23, 2004).

¹⁵⁰ U.S. Patent No. D848,107 (filed Apr. 11, 2017).

¹⁵¹ *E.g.*, U.S. Patent No. D525,411 (filed May 31, 2005) (map of United States); U.S. Patent No. D517,772 (filed May 31, 2005) (dinosaur shape); U.S. Patent No. D515,272 (filed Aug. 28, 2003) (magic wand shape).

¹⁵² *E.g.*, U.S. Patent No. D789,027S (issued Jun. 13, 2017); U.S. Patent No. D787,152S (issued May 23, 2017); U.S. Patent No. D787,151S (issued May 23, 2017); U.S. Patent No. D786,526S (issued May 16, 2017); U.S. Patent No. D785,280S (issued May 2, 2017); U.S. Patent No. D785,278S (issued May 2, 2017); U.S. Patent No. D783,928S (issued Apr. 18, 2017); U.S. Patent No. D779,777S (issued Feb. 28, 2017).

¹⁵³ *See* 35 U.S.C. § 271(a).

¹⁵⁴ *Gorham Co. v. White*, 81 U.S. 511, 528 (1871).

¹⁵⁵ The ordinary observer is the person who regularly purchases such items. *See Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1320 (Fed. Cir. 2007); *Arc'Teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, No. 2:07-CV-59 TS, 2008 WL 4838141, at *2 (D. Utah Nov. 4, 2008).

¹⁵⁶ *See Gorham*, 81 U.S. at 528 (observing that infringement occurs only if the ordinary observer would mistake one product for the other). An "ordinary

The focus is on similarities with the overall patented design, not on similarities of individual elements.

In *Egyptian Goddess, Inc. v. Swisa, Inc.*,¹⁵⁷ the court applied the ordinary observer test. Egyptian Goddess owned a design patent on a rectangular, hollow nail buffer.¹⁵⁸ Egyptian Goddess sued Swisa Inc., alleging that a Swisa fingernail buffer infringed the patent.¹⁵⁹ Swisa moved for a summary judgment of noninfringement.¹⁶⁰ The district court granted Swisa's motion and Egyptian Goddess appealed.¹⁶¹ The Federal Circuit held that the district court correctly granted summary judgment of noninfringement.¹⁶² According to the court, under the ordinary observer test, infringement will not be found unless the accused design "embodies the patented design or any colorable imitation thereof."¹⁶³ The allegedly infringing Swisa design could not reasonably be viewed as so similar to the claimed Egyptian Goddess design that an ordinary observer familiar with the prior art would be deceived by the similarity between the claimed and accused designs.¹⁶⁴

Design patent infringement cases involving food-related products are rare, but *Contessa Food Products, Inc. v. Conagra, Inc.*,¹⁶⁵ provides one example. The owner of a design patent for shrimp serving trays brought an action against a competitor selling allegedly infringing trays.¹⁶⁶ The patent covered a circular serving tray with a center receptacle for cocktail sauce to facilitate a circular arrangement of concentric rows of shrimp aligned together in a mound.¹⁶⁷ The defendant sold a similar shrimp platter.¹⁶⁸ In applying the ordinary observer test, the court of appeals held that the "ordinary observer" analysis is not limited to those features visible at the point of sale, but instead must encompass all ornamental features visible at any time during normal use of the product.¹⁶⁹ As such, the district court had erred in failing to consider the underside of the serving tray as well as the visible portion to assess substantial

observer" is "someone who—while not an expert in the product—is not entirely ignorant of it, and indeed has some degree of familiarity with it. The 'ordinary observer' thus includes someone who has purchased, or shopped for, a like item in the past." *Hutzler Mfg. Co. v. Bradshaw Int'l, Inc.*, No. 11 CIV. 7211 PGF, 2012 WL 3031150, at *6 (S.D.N.Y. Jul. 25, 2012).

¹⁵⁷ 543 F.3d 665 (Fed. Cir. 2008).

¹⁵⁸ *Id.* at 668.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.* at 669.

¹⁶² *Id.* at 670.

¹⁶³ *Id.* at 678.

¹⁶⁴ *Id.* at 682–83. Note also that the defense of patent exhaustion and the related repair and reconstruction doctrine apply to design patents. *See* *Automotive Body Parts Ass'n v. Ford Global Techs., LLC*, 930 F.3d 1314, 1322–25 (Fed. Cir. 2019).

¹⁶⁵ 282 F.3d 1370 (Fed. Cir. 2002).

¹⁶⁶ *Id.* at 1376.

¹⁶⁷ U.S. Patent No. D404,612 (issued Jan. 26, 1999).

¹⁶⁸ *Contessa Food Prods.*, 282 F.3d at 1375.

¹⁶⁹ *Id.* at 1379–81.

similarity.¹⁷⁰ The importance of focusing on the *overall* ornamental appearance, particularly with simple and inexpensive designs, was underscored in a subsequent infringement case involving garlic and onion storage containers.¹⁷¹

D. Trademarks and Trade Dress

Trademarks identify and distinguish the source of goods or services,¹⁷² and generally take the form of a word, phrase, symbol, design, or some combination of these.¹⁷³ Trademarks can also be scents, sounds, and colors.¹⁷⁴ Trade dress is a type of trademark that refers to the overall appearance of a product or its packaging.¹⁷⁵ Trade dress consists of “the total image and overall appearance” of a product and “may include features such as size, shape, color or color combinations, textures, graphics, or even particular sales techniques.”¹⁷⁶

Trademark rights are intended to protect against potential consumer confusion as to the source of a particular product,¹⁷⁷ and may be protected under state common law of unfair competition, state trademark statutes,¹⁷⁸ and the federal Lanham Act.¹⁷⁹ To obtain trademark protection,

¹⁷⁰ *Id.* at 1381.

¹⁷¹ *See* Hutzler Mfg. Co., 2012 WL 3031150, at *14–15. Another case involved an infringement claim based on a design patent for a peace sign-shaped pretzel. *See* U.S. Patent No. D423184 (issued Apr. 25, 2000). The plaintiff alleged that the defendants were selling similarly shaped pretzel chips, but the case eventually settled. *See* Complaint at 3–4, *Friend v. Keystone Pretzels*, No. 2:13-cv-01028-DSC (W.D. Pa. Jul. 17, 2013), 2013 WL3878103.

¹⁷² *See* 15 U.S.C. § 1127 (2018); *see also* Restatement § 9 (1995) (“A trademark is a word . . . that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”).

¹⁷³ *See* 15 U.S.C. §§ 1051(a)(3), 1127.

¹⁷⁴ Scents that have been trademarked include floral fragrances for sewing thread, *In re Clark*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990), and Play-Doh scent (U.S. Reg. No. 5,467,089, May 15, 2018). Trademarked sounds include the NBC chimes (U.S. Reg. No. 916,522, Jul. 13, 1971), MGM’s roaring lion (U.S. Reg. No. 1,395,550, Jun. 3, 1986), and the Tarzan yell (U.S. Reg. No. 2,210,506, Dec. 15, 1998). In *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995), the Supreme Court held that a color (in this case green gold dry cleaning pads) could be trademarked as long as it had acquired secondary meaning. Tiffany blue is also a registered trademark (U.S. Registration No. 2,359,351, June 20, 2000).

¹⁷⁵ *See* Saunders, *supra* note 35, at 534.

¹⁷⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).

¹⁷⁷ 15 U.S.C. § 1125(a) (recognizing a cause of action for the use by any person of “any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods . . .”).

¹⁷⁸ For an overview and discussion of the role of state trademark law, see John T. Cross, *The Role of the States in United States Trademark Law*, 49 U. LOUISVILLE L. REV. 485 (2011).

¹⁷⁹ 15 U.S.C. §§ 1051–1128. The Lanham Act was enacted in 1946 out of concern that leaving trademark protection to the states would create inconsistency and uncertainty in the law and in order to provide national protection for trademarks used in interstate and foreign commerce. S. REP. NO. 1333, 79th Cong., 2d Sess. 5 (1946).

users must be the first to use it in trade and must use it continuously thereafter.¹⁸⁰ The Lanham Act permits the owner of a trademark to federally register the mark if it is (1) distinctive and (2) used in interstate or international commerce.¹⁸¹ Federal registration lasts for ten years and may be renewed for additional ten-year periods as long as the mark remains in commercial use.¹⁸² While federal registration provides a trademark owner with additional protections and remedies,¹⁸³ an unregistered trademark is entitled to protection under the Lanham Act if it satisfies the requirements for federal registration.¹⁸⁴

1. Protectable Trademarks and Trade Dress

Different types of marks—inherently distinctive marks, descriptive marks, and generic marks—receive different levels of protection. A mark that is considered inherently distinctive receives the most protection.¹⁸⁵ Inherently distinctive marks can be fanciful, arbitrary, or suggestive.¹⁸⁶ A fanciful mark is one consisting of a made-up word or a combination of letters and numbers with no known meaning.¹⁸⁷

¹⁸⁰ If two parties use the same distinctive mark, the first to use the mark, known as the senior user, will have priority in the mark. The exception is if the second party to use the mark establishes a strong consumer identification with the mark in a geographic area separate from the senior user's area, in which case the second party will have priority in that separate geographic area. *See Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 365 (2d Cir. 1959).

¹⁸¹ 15 U.S.C. §§ 1051, 1052, 1127.

¹⁸² *Id.* §§ 1058–1059.

¹⁸³ Placement on the federal trademark register gives the trademark owner several advantages. Among other things: (1) it gives constructive notice of the user's claim to the mark; (2) it provides prima facie evidence of ownership; (3) it permits the owner to sue in federal rather than state court, 15 U.S.C. § 1114; (4) the right to use the mark becomes virtually incontestable after five years, *id.* § 1065; and (5) it allows the owner to obtain rights in a larger geographic area than allowed under common law. *Id.* § 1115(a). *See also* *U.S.P.T.O. v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). If a mark is not placed on the Principal Register because it is descriptive and not distinctive, it may be placed on the Supplemental Register if it has potential to become distinctive. Placement on the Supplemental Register confers few benefits; however, it allows the owner to display the registered symbol, which may discourage infringers. It may also help establish secondary meaning. *See Booking.com B.V.*, 140 S. Ct. at 2302.

¹⁸⁴ 15 U.S.C. § 1125(a). *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *Sugar Busters, LLC v. Brennan*, 177 F.3d 258, 267 (5th Cir. 1999); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 299 n.9 (3d Cir. 1986); *Thompson Med. Co. v. Pfizer, Inc.* 753 F.2d 208, 215–16 (2d Cir. 1985). State laws may provide similar protections to registration on the Principal Register. *See, e.g., Viacom Int'l, Inc. v. IJR Capital Invs., LLC*, 891 F.3d 178, 184–85 (5th Cir. 2018) (applying Texas law).

¹⁸⁵ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976).

¹⁸⁶ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210–11 (2000); *Abercrombie & Fitch Co.*, 537 F.2d at 10–11.

¹⁸⁷ *Abercrombie & Fitch Co.*, 537 F.2d at 11 n.12.

Examples of fanciful marks would be Pepsi, Kodak, and Exxon.¹⁸⁸ Arbitrary marks are actual words with a known meaning that have no association to or relationship with the protected product.¹⁸⁹ Examples would be Apple for computers and Blackberry for a personal digital assistant. Suggestive marks are those that have no immediate association to the product but suggest its characteristics or qualities.¹⁹⁰ For example, Speedi Bake, Noburst, Dri-Foot, Sno-Rake and Frankwurst have each been found to be suggestive marks.¹⁹¹

Marks that describe the qualities or characteristics of a product are called descriptive marks.¹⁹² Descriptive marks receive trademark protection only when they have acquired secondary meaning.¹⁹³ Secondary meaning arises when consumers have begun to associate the trademark with the source of the product rather than the product itself.¹⁹⁴ Finally, marks that describe the type or class of product itself are generic and are not registerable.¹⁹⁵ Some examples of marks that have become generic and therefore have lost their trademark status include: aspirin, heroin, cellophane, escalator, trampoline, thermos, dry ice, kerosene, yo-yo, and zipper.¹⁹⁶

¹⁸⁸ See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01(a) (Oct. 2018) [hereinafter TMEP].

¹⁸⁹ *Abercrombie & Fitch Co.*, 537 F.2d at 11 n.12.

¹⁹⁰ *Id.* at 10–11.

¹⁹¹ See TMEP § 1209.01(a).

¹⁹² *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985).

¹⁹³ *Id.*; see also *Test Masters Educ. Servs., Inc. v. Robin Singh Educ. Servs., Inc.*, 799 F.3d 437, 445 (5th Cir. 2015).

¹⁹⁴ *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 851 n.11 (1982). In determining whether secondary meaning exists, courts will weigh several factors, including: (1) association of the trademark with a particular source by actual purchasers, typically measured by customer surveys; (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. See *Converse, Inc. v. ITC*, 909 F.3d 1110 (Fed. Cir. 2018).

¹⁹⁵ 15 U.S.C. §§ 1052(e), 1064(c); *Abercrombie & Fitch Co.*, 537 F.2d at 9. In *U.S.P.T.O. v. Booking.com B.V.*, 140 S. Ct. 2298 (2020), the Supreme Court rejected the contention of the Patent and Trademark Office that the combination of a generic word and “.com” is generic. “A ‘generic.com’ term might also convey to consumers a source-identifying characteristic: an association with a particular website.” *Id.* at 2306. A registered mark may be cancelled at any time on the ground that it has become generic. 15 U.S.C. §1064(3).

¹⁹⁶ See Mary Beth Quirk, *15 Product Trademarks That Have Become Victims of Generization*, CONSUMER REPS. (July 19, 2014), <https://www.consumerreports.org/consumerist/15-product-trademarks-that-have-become-victims-of-generization/>. In the context of food, the mark “pretzel crisps” has been held to be generic for a pretzel cracker snack. See *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 963 (Fed. Cir. 2015). For other examples of food marks held to be generic, see *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (shredded wheat), *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971 (8th Cir. 2006) (brick oven pizza), *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845 (C.C.P.A. 1961) (egg noodles),

Trade dress similarly receives different levels of protection depending on whether the trade dress consists of product packaging or product design. Trade dress originally included only the packaging or “dressing” of a product,¹⁹⁷ but subsequently was expanded to include the design of the product itself.¹⁹⁸ *Two Pesos, Inc. v. Taco Cabana, Inc.*¹⁹⁹ involved packaging in the form of restaurant design. Taco Cabana’s claimed trade dress consisted of “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals.”²⁰⁰ Subsequently, Two Pesos opened a Mexican restaurant with a motif similar to Taco Cabana’s, and Taco Cabana sued for trade dress infringement.²⁰¹ The Supreme Court held that product packaging, in this case, restaurant décor, may be inherently distinctive and therefore, immediately protectable without a showing of secondary meaning.²⁰²

Eight years later, in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,²⁰³ the Supreme Court determined the circumstances in which a product’s design, as opposed to its packaging, is distinctive and therefore protectable in an action for infringement of unregistered trade dress. Samara Brothers, Inc. was a manufacturer of children’s clothing.²⁰⁴ Wal-Mart took pictures of Samara’s designs and had its clothing manufacturer produce a very similar line of clothing, which Wal-Mart then sold.²⁰⁵ Samara brought an action for trade dress infringement.²⁰⁶ Wal-Mart defended on the ground that Samara’s clothing design had not acquired secondary meaning, and therefore was not protectable.²⁰⁷ The Supreme Court agreed, concluding that product design, like color,²⁰⁸ can never be inherently distinctive.²⁰⁹ In so ruling, the Court distinguished the product

and *Skinner Mfg. Co. v. Kellogg Sales Co.*, 143 F.2d 895 (8th Cir. 1944) (raisin bran).

¹⁹⁷ *Storck USA, L.P. v. Farley Candy Co.*, 14 F.3d 311 (7th Cir. 1994) (pictures and graphics on packages of candy); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378 (9th Cir. 1987) (antifreeze bottles); *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837 (9th Cir. 1987) (restaurant design); *Chevron Chem. Co. v. Voluntary Purchasing Grps., Inc.*, 659 F.2d 695 (5th Cir. 1981) (bottles of insect spray and packaging for bone meal).

¹⁹⁸ *Ashley Furniture Indus., Inc. v. Sangiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999) (bedroom furniture); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995) (sweaters); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995) (notebooks).

¹⁹⁹ 505 U.S. 763 (1992).

²⁰⁰ *Id.* at 765.

²⁰¹ *Id.*

²⁰² *Id.* at 776.

²⁰³ 529 U.S. 205 (2000).

²⁰⁴ *Id.* at 207.

²⁰⁵ *Id.* at 207–08.

²⁰⁶ *Id.* at 208.

²⁰⁷ *Id.*

²⁰⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (finding that color can never be inherently distinctive but may receive trademark protection upon a showing that it has acquired secondary meaning).

²⁰⁹ *Wal-Mart Stores, Inc.*, 529 U.S. at 216.

design involved in *Wal-Mart* from the product packaging involved in *Two Pesos*.²¹⁰ In short, while product packaging may be immediately protectable by trademark if it is inherently distinctive, the design of a product itself may never be protectable by trademark unless and until it has acquired secondary meaning.

Functionality is another limitation to the availability of trade dress protection for packaging and product design. In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,²¹¹ the Supreme Court noted that § 1125(a)(3) of the Lanham Act does not allow trade dress protection for functional product features.²¹² In *TrafFix Devices*, the plaintiff had acquired utility patents for a dual spring design for outdoor signs.²¹³ After the patents expired, the plaintiff sued a competitor using a similar design for trade dress infringement.²¹⁴ The Court held that a utility patent was strong evidence that the features claimed were functional.²¹⁵ In this case, the dual spring design was both the central claim advanced in the expired patents and the essential feature of the alleged trade dress.²¹⁶ Because the defendant established functionality, the Court held that the trade dress claim was barred.²¹⁷

Likewise, in the context of food products, the non-functionality of a particular design or packaging is required for protection as trade dress. In *Application of World's Finest Chocolate, Inc.*,²¹⁸ the court held that the packaging of a chocolate candy bar was not functional because it provided no utilitarian advantages; meanwhile, other packaging designs were available.²¹⁹ By contrast, in *Universal Frozen Foods, Co. v. Lamb-Weston, Inc.*,²²⁰ the product design for the shape of “curlicue fries” was found to be functional because the configuration resulted in “superior yield, lower portion cost, better cosmetic plate coverage, improved flavor, faster service time and better heat penetration.”²²¹

Food designs that have federally registered trademarks include: Pepperidge Farm’s Milano Cookies,²²² Carvel’s Fudgie the Whale Ice

²¹⁰ The Court noted that product design almost always serves purposes other than source identification, including aesthetic purposes. *Id.* at 213.

²¹¹ 532 U.S. 23 (2001).

²¹² *Id.* at 29.

²¹³ *Id.* at 25.

²¹⁴ *Id.* at 26.

²¹⁵ *Id.* at 29–30.

²¹⁶ *Id.* at 30.

²¹⁷ *Id.* at 29–30, 33.

²¹⁸ 474 F.2d 1012 (C.C.P.A. 1973).

²¹⁹ *Id.* at 1014–15.

²²⁰ 697 F. Supp. 389 (D. Or. 1987).

²²¹ *Id.* at 392. *Accord* *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572–73 (2d Cir. 1959) (finding neither proof of secondary meaning nor that Pepto-Bismol’s pink color was entitled to trademark protection because it served the functional purpose of giving the medicine a more pleasing appearance and therefore more likely to be accepted by an upset stomach).

²²² Registration No. 3,852,499. In December 2015, Pepperidge Farm sued Trader Joe’s for selling Milano cookies that Pepperidge Farm claimed infringed its trademark. The lawsuit was settled by the parties. David Godman, *Trader*

Cream Cake,²²³ Dairy Queen ice cream curl on top,²²⁴ Hershey's kisses,²²⁵ Hershey's chocolate bar,²²⁶ Frito Lay Sun Chips,²²⁷ Izzy's ice cream shop for ice cream cones topped with a baby scoop of ice cream,²²⁸ J. Dawgs for hotdogs with crisscross cuts,²²⁹ General Mills' Bugles,²³⁰ Tootsie Rolls Tootsie Pops,²³¹ and Magnolia Bakery's cupcakes bearing its signature swirl icing.²³²

2. Trademark Infringement

The Lanham Act permits the holder of a registered trademark to file a trademark infringement claim against any person who, without the registered trademark holder's consent, uses "in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive."²³³ The plaintiff in a trademark infringement action must prove that the mark is valid,²³⁴ the

Joe's settles Milano cookies infringement spat, CNN BUS. (Mar. 31, 2016, 9:19 AM), <https://money.cnn.com/2016/03/31/news/companies/trader-joes-milano-pepperidge-farm/index.html>.

²²³ Registration No. 3,094,986.

²²⁴ Registration No. 2,183,417.

²²⁵ Registration No. 2,138,566.

²²⁶ Registration No. 4,322,502.

²²⁷ Registration No. 3,293,236.

²²⁸ Registration No. 4,078,826.

²²⁹ Registration No. 4,550,211.

²³⁰ Registration No. 1,929,420.

²³¹ Registration No. 1,459,412.

²³² Registration No. 4,519,385 (Supplemental Register). Magnolia Bakery sued one of its former employees who had opened a competing café for selling cupcakes with swirl icing. The former employee went out of business. Eliza Murphy, *Magnolia Bakery in Buttercream Battle with Former Employee*, ABC NEWS (Sept. 12, 2012) <https://abcnews.go.com/blogs/lifestyle/2012/09/magnolia-bakery-in-buttercream-battle-with-former-employee>.

²³³ 15 U.S.C. § 1114 (2018). A prevailing party in a trademark infringement action may:

[R]ecover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. . . . In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Id. § 1117(a). The infringing items may also be ordered destroyed. *Id.* § 1118.

²³⁴ *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) ("[T]he threshold requirement [is] that the plaintiff must possess a protectable mark, which must be satisfied before infringement can be actionable."). Federally registered marks are presumed to be valid. *See supra*, note 183.

plaintiff is the senior user of the mark, and the defendant's use of the mark creates a likelihood of confusion in the minds of the consumer.²³⁵ Therefore, trademark infringement actions focus on whether the consumer is likely to be confused as to the source of a product or service by a party's use of a particular mark.²³⁶

The likelihood of confusion test was applied in a case involving food design in *Nabisco Brands, Inc. v. Conusa Corp.*,²³⁷ where the trial court found that defendant's sale of a round hard candy with a hole in the middle infringed upon the trademark of the LifeSaver candy.²³⁸ The court rejected the defendant's contention that because its candy had raised letters on one side, it was sufficiently different from the LifeSaver candy so as not to create a likelihood of confusion.²³⁹ More recently, in *Denbra IP*

²³⁵ 15 U.S.C. § 1125(a)(1)(A). *See also* *Viacom Int'l, Inc. v. IJR Capital Invs. L.L.C.*, 891 F.3d 178, 185 (5th Cir. 2018) (explaining that the plaintiff must show confusion to prevail); *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 516–17 (10th Cir. 1987) (citing *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71 (2d Cir. 1985)) (stating that confusion is required to succeed for a trade dress infringement); *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 (11th Cir. 1986) (“[T]o prevail on a trade dress infringement claim under § 43(a) [of the Lanham Act], the plaintiff must prove three elements: 1) its trade dress is inherently distinctive or has acquired secondary meaning, 2) its trade dress is primarily non-functional, and 3) the defendant's trade dress is confusingly similar.”).

²³⁶ In *Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), the Second Circuit Court of Appeals articulated a multi-factor test to determine whether a particular use of a mark creates a likelihood of confusion in the minds of the consumer. The Second Circuit considers:

[T]he strength of [the] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.

Id. Most Circuits follow a similar multi-factor test in determining likelihood of confusion. *See, e.g.*, *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1371–73 (Fed. Cir. 2018); *Georgia-Pacific Consumer Prods. LP v. Four-U-Packaging, Inc.*, 701 F.3d 1093, 1100–01 (6th Cir. 2012); *Pizzaria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1205 (1st Cir. 1983) (citing *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981)); *SquirtCo v. Seven-Up, Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated on other grounds by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003). *See also In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317 (Fed. Cir. 2014) (relying on the multifactor test from *In re E.I. DuPont DeNemours & Co.* to assess an application for trademark registration). Not all factors are relevant to every case and the courts may give the factors different weight depending on the facts of the particular case. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361–62; *Georgia-Pacific Consumer Prods. LP*, 701 F.3d at 1100–01.

²³⁷ 722 F. Supp. 1287 (M.D.N.C. 1989), *aff'd*, 892 F.2d 74 (4th Cir. 1989).

²³⁸ *Id.* at 1291–92.

²³⁹ *Id.* at 1289, 1291.

Holdings, LLC v. Thornton,²⁴⁰ the trial court issued a preliminary injunction against the defendant's use of a frosting pattern on Bundt cakes that was likely to cause confusion with the plaintiff's frosting design.²⁴¹

3. Trademark Dilution

An owner of a "famous" mark may also have a cause of action for dilution against another party's use of an identical or substantially similar mark if the other party's use of the mark hurts the value of the famous mark by harming its reputation or impairing its distinctiveness.²⁴² "[A] mark is famous if it is widely recognized by the general consuming public . . . as a designation of source of the goods or services of the mark's owner."²⁴³ Unlike a trademark infringement claim, a cause of action for dilution may exist regardless of the presence or absence of actual or likely confusion, competition, or actual economic injury.²⁴⁴

There are two types of causes of action for trademark dilution: tarnishment and blurring. In a tarnishment action, the issue is whether an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark."²⁴⁵ In a

²⁴⁰ No. 4:20-CV-813-SDJ, 2021 WL 674238 (E.D. Tex. Feb. 22, 2021).

²⁴¹ *Id.* at 9.

²⁴² 15 U.S.C. § 1125(c).

²⁴³ *Id.* § 1125(c)(2)(A).

In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark. (iv) Whether the mark was registered . . .

Id.

²⁴⁴ *Id.* § 1125(c)(1).

²⁴⁵ *Id.* § 125(c)(2)(C). Because tarnishment relates to reputation and distinctiveness, cases often involve the use of a mark or substantially similar mark in connection with some sex-related product. *See, e.g.*, V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 387–89 (6th Cir. 2010) (finding that the use of the names "Victor's Little Secret" or "Victor's Secret" in connection with a store selling sex toys and other sex-related products created a likelihood of dilution by tarnishment to the Victoria's Secret trademark that the defendant had not overcome); Pfizer Inc. v. Sachs, 652 F. Supp. 2d 512, 525 (S.D.N.Y. 2009) (holding that the display of a Viagra-branded missile at "an adult entertainment exhibition," among other places, would likely dilute by tarnishment Pfizer's famous mark); Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942, 949–50 (N.D. Ill. 2002) (finding that a pornographic website's use of "King VelVeeda" likely tarnished Kraft's "Velveeta" trademark). Tarnishment has also been found when a mark or substantially similar mark is used in connection with an inferior product or creates a negative association. *See, e.g.*, Perkins Sch. for the Blind v. Maxi-Aids, Inc., 274 F. Supp. 2d 319, 323–24 (E.D.N.Y. 2003) (finding the complaint's allegation that the defendant resold the plaintiff's product with an inferior warranty sufficiently alleged a claim for tarnishment); Harris Rsch., Inc. v. Lydon, 505 F. Supp. 2d 1161, 1166 (D. Utah 2007) (finding that the defendant's use of the mark "Chem-Who?" created a negative association with plaintiff's "Chem-Dry" mark sufficient for tarnishment).

blurring action, the issue is whether there is an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”²⁴⁶

Dilution in the food design context was the issue in *Nabisco v. PF Brands*.²⁴⁷ This case centered on a goldfish-shaped orange cracker. Pepperidge Farm had produced goldfish crackers continuously since 1962 and owned numerous trademark registrations for the appearance and name of the cracker.²⁴⁸ In 1994, Pepperidge Farm launched an aggressive marketing campaign of its goldfish cracker, targeted at children.²⁴⁹ The cracker had also been the subject of substantial media coverage.²⁵⁰ In 1998, Nickelodeon Television Network approached Nabisco to explore a joint promotion for its show, “CatDog.”²⁵¹ Nabisco developed a CatDog snack that consisted of small orange crackers in three shapes: the CatDog character, a bone, and a fish.²⁵² After Pepperidge Farm sent Nabisco a cease and desist letter, Nabisco brought a cause of action for declaratory relief.²⁵³ Pepperidge Farm countersued for trademark infringement and

²⁴⁶ 15 U.S.C. § 1125(c)(2)(B).

In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following: (i) The degree of similarity between the mark or trade name and the famous mark. (ii) The degree of inherent or acquired distinctiveness of the famous mark. (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark. (iv) The degree of recognition of the famous mark. (v) Whether the user of the mark or trade name intended to create an association with the famous mark. (vi) Any actual association between the mark or trade name and the famous mark.

Id. See, e.g., *Visa Int’l Serv. Ass’n v. JSL Corp.*, 610 F.3d 1088, 1089, 1091–92 (9th Cir. 2010) (finding that the defendant’s use of the name “eVisa” for an online education business diluted the plaintiff’s “Visa” trademark by creating a new meaning of the word); *Perfumebay.com Inc. v. eBay, Inc.*, 506 F.3d 1165, 1179–81 (9th Cir. 2007) (finding that the name “Perfumebay” diluted the uniqueness of eBay’s trademark); *UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 1886, 1888–90 (T.T.A.B. 2011) (finding that Mattel’s use of the trademark “Motown Metal” on its Hot Wheels cars was likely to dilute the “Motown” trademark); *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1486, 1497 (T.T.A.B. 2010) (finding that the use of the slogan “The Other Red Meat” for fresh and frozen salmon was likely to dilute the trademark “The Other White Meat”).

²⁴⁷ 191 F.3d 208, 212 (2d Cir. 1999), *overruled in part by* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432–34 (2003) (holding that proof of actual dilution is required by the Federal Trademark Dilution Act). Congress subsequently amended the federal Trademark Dilution Act of 1995 to provide that a “likelihood of dilution by tarnishment” is the applicable burden of proof. See *V Secret Catalogue, Inc.*, 605 F.3d at 387.

²⁴⁸ *Nabisco, Inc.*, 191 F.3d at 212.

²⁴⁹ *Id.* at 212–13.

²⁵⁰ *Id.* at 213.

²⁵¹ *Id.*

²⁵² *Id.*

²⁵³ *Id.*

dilution under state and federal law, and sought a preliminary injunction prohibiting Nabisco from distributing the CatDog snack.²⁵⁴

The trial court denied the preliminary injunction on Pepperidge Farm's infringement claim, but granted it on the dilution claim.²⁵⁵ Nabisco appealed.²⁵⁶ The appellate court affirmed the trial court's issuance of a preliminary judgment after reviewing the relevant factors, concluding that "Pepperidge Farm has demonstrated a high likelihood of success in proving that Nabisco's commercial use of its goldfish shape will dilute the distinctiveness of Pepperidge Farm's nearly identical famous senior mark."²⁵⁷

II. SHOULD THERE BE LIMITATIONS ON OR CHANGES TO THE AVAILABILITY OF INTELLECTUAL PROPERTY PROTECTION FOR RECIPES AND FOOD DESIGN?

We now turn to the overarching questions of whether there should be intellectual property protection for recipes and food design at all and, if so, under what circumstances. In addition, we consider whether the interests of competition as well as innovation are furthered by such protection. We proceed first by arguing that a combination of intellectual property protections may best suit recipes and food design. We then consider potential changes to the current state of protections, as outlined above, through a series of three questions. First, should food be considered an article of manufacture for design patent purposes? Second, should food design be considered functional and therefore not eligible for design patent or trademark protection? Third, should doctrinal bootstrapping be eliminated?

A. There is No Single Solution for the Protection of Recipes and Food Designs

As can be seen from the previous discussion, intellectual property protection for food design is extremely varied as to its scope and availability. There is no one size that fits all purposes, and the form of intellectual property protection that works best will likely depend heavily on the context. Recipes, to the extent that they are unique and kept confidential, are good candidates for trade secret protection, which can last as long as the recipe remains secret. The recipe owner must implement measures that are reasonable under the circumstances to maintain its secrecy. On the downside, trade secret protection is easily lost if the recipe is disclosed, and there is no way to prevent a competitor from independently developing the same recipe or reverse engineering it, neither of which will lead to liability for misappropriation.

The alternatives to trade secret protection are copyright and utility patent protection, which are both considered robust forms of intellectual property because of their exclusivity and the rights conferred. While long in duration, copyright protection is less useful since it protects original

²⁵⁴ *Id.*

²⁵⁵ *Id.*

²⁵⁶ *Id.* at 212.

²⁵⁷ *Id.* at 222.

expression only and does not apply to facts, procedures, and methods.²⁵⁸ Thus, copyright may protect a recipe's original, artistic, or creative elements, but not the underlying recipe itself, which is likely to be a list of ingredients and a procedure for combining them. On the other hand, a compilation of recipes may be copyrightable if there is demonstrated originality in the selection, coordination, or arrangement of the recipes.²⁵⁹ Even so, the recipes themselves will remain uncopyrightable.

Utility patent protection remains the other alternative to trade secret protection because it is available for processes and methods, and it is more likely to apply to the process for producing a food product or a particular ingredient than the dish itself.²⁶⁰ Nevertheless, utility patent protection has several practical drawbacks. The process of obtaining a patent can be lengthy and expensive. Moreover, recipes must be publicly disclosed as part of the examination process—rendering the requirements of novelty and nonobviousness a steep hill to climb.²⁶¹ Even if a recipe is truly new because it involves a previously unknown cooking technique or combination of ingredients, it may amount to an obvious or predictable variation on other known recipes.²⁶² In addition, the term of utility patent protection is limited to twenty years, after which the recipe falls into the public domain and becomes freely available.²⁶³

When it comes to food design, trade secret protection holds limited value if the trade secret is identified as the appearance or configuration of the food item itself.²⁶⁴ Trade secrets cannot protect what is easily observable—although the process of creating the design might be protectable if it has economic value is due to its secrecy.²⁶⁵ Likewise, copyright protection is not particularly useful because food is perishable, and therefore it cannot fulfill the requirement that the work be fixed in a medium that is sufficiently stable and permanent.²⁶⁶ In addition, the design or presentation of the dish, even if it is independently identifiable, may not be separable from the food itself as viewed as an edible, useful article.²⁶⁷

²⁵⁸ 17 U.S.C. § 102(b) (1990).

²⁵⁹ See *supra* notes 63–65 and accompanying text.

²⁶⁰ Daniel Joshua Ganz, Comment, *Intellectual Property Protection for Food: Balancing Competing Policy Objectives*, 40 U. LA VERNE L. REV. 128, 132 (2019).

²⁶¹ See *supra* notes 91–102 and accompanying text.

²⁶² See Naomi Straus, Comment, *Trade Dress Protection for Cuisine: Monetizing Creativity in a Low-IP Industry*, 60 UCLA L. REV. 182, 198 (2012) (citing 35 U.S.C. §§ 102–103) (arguing that “patent laws cannot be used to protect restaurant dishes that are created using classic cooking techniques or fail to meet the high standards of originality that the patent system requires because these dishes do not fulfill the requirement that an invention be novel and nonobvious”).

²⁶³ 35 U.S.C. § 154(a)(2).

²⁶⁴ See UTSA § 1(4)(i).

²⁶⁵ *Id.*

²⁶⁶ 17 U.S.C. § 101.

²⁶⁷ *But see* Hannah Brown, *Having Your Cake and Eating it Too: Intellectual Property Protection for Cake Design*, 56 IDEA 31, 53–54 (2016) (arguing that cake icing designs are independently identifiable and separable from the cake as a useful article).

Instead, design patent or trade dress protection may be the preferred option for food designs. Design patents will allow the patent owner to exclude others from making, using, or selling food items incorporating the design. Of course, to be protected, the design must first overcome the high bars of novelty and nonobviousness; and be ornamental rather than related to any functional aspect of the food. As with utility patents, the term of protection is limited, and even more so since the duration for a design patent is fifteen years.²⁶⁸ Lastly, trade dress protection is also a viable option. The design must be have acquired secondary meaning to have become distinctive to the source or supplier of the food.²⁶⁹

Additionally, as with design patent protection, the food design must be nonfunctional, both as to any utilitarian purpose related to the food and as to any aesthetic necessity.²⁷⁰ Once a food design qualifies for trade dress protection, it will remain protected as long as it remains in commercial use.²⁷¹ A product can be protected by a design patent and by trade dress rights as long as the particular design does not have a utilitarian function.²⁷² In fact, the existence of a design patent covering a product is a factor that can lead to a presumption of nonfunctionality for trade dress purposes.²⁷³ As this discussion suggests, recipes and food designs might be best protected by a combination of intellectual property rights.

B. Should Food be Considered an Article of Manufacture for Design Patent Purposes?

Design patents are limited to designs for “articles of manufacture.”²⁷⁴ What constitutes an article of manufacture is not statutorily defined.²⁷⁵ The Supreme Court defined an “article of manufacture” as “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand-labor or by machinery.”²⁷⁶ However, not

²⁶⁸ 35 U.S.C. § 173.

²⁶⁹ See *supra* notes 203–210 and accompanying text.

²⁷⁰ See *infra* notes 295–324 and accompanying text.

²⁷¹ 15 U.S.C. §§ 1058–1059.

²⁷² See, e.g., *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964); *Topps Co. v. Gerrit J. Verburg Co.*, No. 96 CIV. 7302 (RWS), 1996 WL 719381 (S.D.N.Y. 1996).

²⁷³ See *In re Becton, Dickinson & Co.*, 675 F.3d 1368 (Fed. Cir. 2012); *Am. Beverage Corp. v. Diageo N. Am., Inc.*, 936 F. Supp. 2d 555 (W.D. Pa. 2013).

²⁷⁴ 35 U.S.C. § 171.

²⁷⁵ For a discussion of the historical meaning of article of manufacture, see Sarah Burstein, *The “Article of Manufacture” Today*, 31 HARV. J. L. & TECH. 781, 812–817 (2018).

²⁷⁶ *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). See also *Tide-Water Oil Co. v. United States*, 171 U.S. 210, 216 (1898) (“The primary meaning of the word ‘manufacture’ is something made by hand, as distinguished from a natural growth, but, as machinery has largely supplanted this primitive method, the word is now ordinarily used to denote an article upon the material of which labor has been expended to make the finished product.”). More recently, the Supreme Court looked to dictionary definitions of “article” and “manufacture,” and took the

every article of manufacture is eligible for design patent protection. Articles of manufacture, which are more or less hidden from view when in use, are not the proper subject matter for design patents.²⁷⁷ Similarly, designs that create an appearance that cannot “ever really matter to anybody” have been denied patents.²⁷⁸

Further, courts have held that to be a “manufacture” or an “article of manufacture,” some form of permanence is required. *In re Nuijten*²⁷⁹ involved a utility patent application for a signal with an embedded digital watermark encoded. The court was called on to determine whether the signals fell within any of the categories for utility patent eligibility.²⁸⁰ In addressing whether the signals were “manufactures,” the *Nuijten* majority conceded that the signals were man-made, but held that some *article* must result from the process of manufacture.²⁸¹ The court also held that articles of manufacture must be tangible and have some “semblance of permanence.”²⁸² The court concluded that the signals were not manufactures and therefore not eligible for utility patent protection.²⁸³

Some forty years earlier, the court reviewing a design patent application in *In re Hruby*²⁸⁴ found, in connection with a design patent application, that the portion of a water fountain that was composed entirely of water in motion was an “article of manufacture.”²⁸⁵ While at first blush, *Nuijten* and *Hruby* appear to be inconsistent, there is some similarity in their holdings. Like *Nuijten*, *Hruby* placed importance on “permanence” in reaching its holding. The court noted that the dissenting member of the Patent Office Board of Appeals (which had rejected the design patent) had stated: “it is recognized that if certain parameters such as orifice configuration, water pressure and freedom from disturbing atmospheric conditions are maintained, the ornamental shape of the fountain will remain substantially constant and will at times present an over-all appearance virtually the same from day to day.”²⁸⁶ The court agreed with this statement of permanence of design: “We agree with the dissenter on that and would add that the permanence of any design is a function of the

broad view that an article of manufacture is simply a thing made by hand or machine. *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016).

²⁷⁷ *E.g.*, *Rowe v. Blodgett & Clapp Co.*, 112 F. 61 (2d Cir. 1901) (horseshoe calk—a blunt projection on a horseshoe to provide traction—unpatentable); *Bradley v. Eccles*, 126 F. 945 (2d Cir. 1903) (washer for thill coupling unpatentable); *Pashek v. Dunlop Tyre & Rubber Co.*, 8 F.2d 640 (N.D. Ohio 1925) (tire tread unpatentable).

²⁷⁸ *N. British Rubber Co. v. Racine Rubber Tire Co. of N.Y., Inc.*, 271 F. 936, 938 (2d Cir. 1921) (“It has been well said that there are some articles of manufacture . . . incapable of being the subjects of design patents, for want of reason to suppose that their appearance can ever really matter to anybody.”).

²⁷⁹ 500 F.3d 1346 (Fed. Cir. 2007).

²⁸⁰ *Id.* at 1348.

²⁸¹ *Id.* at 1356.

²⁸² *Id.* (“In essence, energy embodying the claimed signal is fleeting and is devoid of any semblance of permanence during transmission.”).

²⁸³ *Id.* at 1357.

²⁸⁴ 373 F.2d 997 (Cust. & Pat. App. 1967).

²⁸⁵ *Id.* at 1002.

²⁸⁶ *Id.* at 999.

materials in which it is embodied and the effects of the environment thereon.”²⁸⁷ The court then pointed to Roman and French fountains that were built hundreds of years ago that still produce the same water design today.²⁸⁸

Both *Nuijten* and *Hruby* conclude that an article of manufacture must exhibit a degree of tangibility and permanence. Copyright and design patent would then share similar requirements of fixation in a tangible medium.²⁸⁹ The Court’s recognition that articles of manufacture be “fixed” in the copyright sense acknowledges the inherent overlap between design patent and copyright protection, namely their use to protect the aesthetically pleasing aspects of a utilitarian article.²⁹⁰ In fact, design patents had their antecedents in the law of copyright.²⁹¹ If tangibility and permanence are necessary to qualify for design patent protection, then one must ask whether food design also qualifies. Recall the holding of *Kim Seng Co. v. J & A Importers, Inc.*²⁹² that food is not

²⁸⁷ *Id.*

²⁸⁸ *Id.* Rather than examining *Hruby* in any depth, the *Nuijten* Court attempted to distinguish it on the grounds that *Hruby* was addressing a design patent, while *Nuijten* was addressing a utility patent. This is a distinction without meaning. The notion that there is a difference between “manufacture” as used with utility patents and “articles of manufacture” as used with design patents was rejected as early as *In re Hadden*, 20 F.2d 275, 276 (App. D.C. 1927) (“It is difficult to perceive how a thing may be a manufacture, without producing an article of manufacture.”). See also *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016) (interpretation of “article of manufacture” in design patent and “manufacture” in utility patent is consistent); 8 DONALD S. CHISUM, PATENTS § 23.03[2] (2013) (noting that “article of manufacture” in §171 includes what would be considered a “manufacture” within the meaning of § 101).

²⁸⁹ See *supra* note 67 and accompanying text.

²⁹⁰ For a discussion of the intersection between design patents and copyrights, see Valerie V. Flugge, Note, *Works of Applied Art: An Expansion of Copyright Protection*, 56 S. CAL. L. REV. 241, 245–47 (1982). Because both protect the aesthetic features of functional articles, copyright and patents have significant overlap between the subject matter they protect. By contrast, proving design patent infringement is less demanding than that required for copyright infringement. Design patent infringement focuses on whether the ordinary observer would believe that the accused design is the same as the overall patented design based on their similarities. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (holding “that the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed”). Copyright infringement requires proof that the defendant had access to the copyrighted work and that the similarities between the copyrighted work and the allegedly infringing work are substantial. *E.g.*, *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (assessing whether a taken portion of a copyrighted literary work was substantial). For further discussion of the similarities and differences in design patent and copyright infringement, see Sebastian M. Torres Rodriguez, *The Convergence of Design Patent Law, Trademark Law, and Copyright Law for Better Protection of Intellectual Property for Commercial Designs*, 5 U. P.R. BUS. L. J. 122, 139–42 (2014).

²⁹¹ See Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L. J. 837, 856–63 (2013) (discussing the historical development of design patents as originating in British design copyright law).

²⁹² 810 F. Supp. 2d 1046 (C.D. Cal. 2011).

eligible for copyright protection because it is intended to be eaten, and thus not stable or permanent enough to be a work of fixed authorship.²⁹³ By analogy, food is insufficiently stable or permanent enough to be an article of manufacture.

Additionally, at least one commentator has argued that compositions of matter should not be considered an article of manufacture.²⁹⁴ Professor Sarah Burstein, who has written extensively on the meaning of the term, suggests that we should revert to the original definition of “article of manufacture,” which excluded machines and compositions of matter because they are not complete, unitary structures.²⁹⁵ Similarly, such a construction would exclude food design from design patent protection.

C. Should Food Design be Considered Functional and Therefore Not Eligible for Design Patent or Trademark Protection?

Nonfunctionality is a key requirement for both design patent and trade dress protection.²⁹⁶ The standard of functionality as between these two forms of intellectual property differ significantly. In the design patent context, the definition of functionality is narrow.²⁹⁷ By nature, an article of manufacture includes both utilitarian and ornamental features.²⁹⁸ A leading test specifies that a design is functional only if it is “dictated by function.”²⁹⁹ In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,³⁰⁰ the Supreme Court held that “[t]o qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone.”³⁰¹ Therefore, if a particular design is dictated solely by the use or purpose of the article, it cannot be protected by a design patent.³⁰²

²⁹³ *Id.* at 1054.

²⁹⁴ Burstein, *supra* note 275, at 5. A “composition of matter” is a mixture or combination of substances or elements. Saunders, *supra* note 35, at 108.

²⁹⁵ Burstein, *supra* note 275, at 5 (“[I]n 1887, the phrase ‘article of manufacture’ was a term of art in U.S. patent law that referred to a tangible item made by humans—other than a machine or composition of matter—that had a unitary structure and was complete in itself for use or for sale.”).

²⁹⁶ See *supra* notes 134–136, 211–217 and accompanying text.

²⁹⁷ See *supra* notes 134–136 and accompanying text.

²⁹⁸ The scope of design patent protection for an article having both functional and ornamental features is limited strictly to the ornamental features. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010) (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).

²⁹⁹ Peter Lee & Madhavi Sunder, *Design Patents: Law Without Design*, 17 STAN. TECH. L. REV. 277, 287 (2013) (citing *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* 489 U.S. 141, 148 (1989)). See, e.g., *In re Webb*, 916 F.2d 1553 (Fed. Cir. 1990) (discussing but not ruling on the issue of functionality as not raised on appeal).

³⁰⁰ 489 U.S. 141 (1989).

³⁰¹ *Id.* at 148.

³⁰² See, e.g., *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1370–71 (Fed. Cir. 2006) (discussing functionality for design patents); *Rosco*, 304 F.3d at 1378 (assessing the functionality of a mirror for design patent purposes); *L.A. Gear, Inc.*, 988 F.2d at 1123 (discussing the overlap between design and function for a shoe).

Consequently, there is likely more room for protectability with a design patent because it is often relatively easy to find some nonfunctional motivation for a design.³⁰³

Regarding trade dress, the test is somewhat inverted from that of the design patent test. Proof of nonfunctionality generally requires a showing that the design of the product “serves no purpose other than identification.”³⁰⁴ Thus, two tests for determining functionality with respect to trade dress have developed. First, the traditional test asks whether a design is essential to the use or purpose of the article, or if it affects the cost or quality of the article.³⁰⁵ This form of functionality is known as utilitarian functionality.³⁰⁶ Strong evidence of utilitarian functionality is found when there is a utility patent that specifically discloses the utilitarian advantages of features sought to be protected as trade dress.³⁰⁷ Another indication of utilitarian functionality is the unavailability of alternative comparable designs or features that may be used by competitors.³⁰⁸ Advertising that touts the usefulness of a particular design and that it resulted from a relatively simple or inexpensive method of manufacture is also relevant in assessing utilitarian functionality.³⁰⁹

*Ezaki Glico Kabushiki Kaisha v. Lotte International America Corp.*³¹⁰ is an example of utilitarian functionality as applied to food. *Ezaki Glico* involved “Pocky,” a chocolate-covered cookie stick with one end uncoated with chocolate. Ezaki Glico, the creator and manufacturer, claimed trade dress protection for the shape and appearance of the cookie sticks.³¹¹ However, the Third Circuit Court of Appeals held that the design was utilitarian because the uncoated end of the stick allows the consumers to hold it without getting chocolate on their hands as they eat it.³¹² Evidence cited by the court included that the manufacturer advertised “‘the no mess handle of the Pocky stick,’ which ‘mak[es] it easier for multi-tasking without getting chocolate on your hands.’”³¹³ Therefore, the overall shape and look of Pocky was deemed to be functional. Similarly,

³⁰³ Lee and Sunder, *supra* note 299, at 286–87.

³⁰⁴ SK&F Co. v. Premo Pharm. Lab’ys, Inc., 625 F.2d 1055, 1063 (3d Cir. 1980).

³⁰⁵ See *In re* Morton-Norwich Prods., Inc., 671 F.2d 1332, 1340–41 (C.C.P.A. 1982).

³⁰⁶ See Saunders, *supra* note 35, at 543.

³⁰⁷ See *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30–31 (2001) (stating that “[a] utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection”); *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 857 (7th Cir. 2010) (discussing *TraFFix Devices*).

³⁰⁸ *Valu Eng’g, Inc. v. Rexnard Corp.*, 278 F.3d 1268, 1274 (Fed. Cir. 2002).

³⁰⁹ *Id.*

³¹⁰ 977 F.3d 261 (3d Cir. 2020), *rehearing granted and opinion vacated by Ezaki Glico Kabushiki Kaisha v. Lotte Int’l Am. Corp.*, 985 F.3d 1069 (3d Cir. 2021) (mem.).

³¹¹ *Id.* at 263.

³¹² *Id.* at 268–69.

³¹³ *Id.* at 269 (citations omitted).

in *Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC*,³¹⁴ the Eleventh Circuit Court of Appeals held that the design of Dippin' Dots—small, predominately separated colored beads or pieces of ice cream—contributed to the product's creamy taste and was thus functional and not entitled to trade dress protection.³¹⁵ Finally, in *William R. Warner & Co. v. Eli Lilly & Co.*,³¹⁶ the Supreme Court concluded that adding chocolate to a pharmaceutical mixture containing quinine to enhance color and offset the mixture's unpleasant taste was functional.³¹⁷

The second nonfunctionality test is the competitive necessity test, which asks whether the exclusive use of the design would put competitors at a significant non-reputational disadvantage.³¹⁸ Aesthetic functionality, the second form of functionality, concerns a product's required look—the color and other design features provide an appearance that is essential to the product and must be available to competitors.³¹⁹ Often, this is important when the product is purchased because of its visual appearance or aesthetic appeal. In *Wallace International Silversmiths, Inc v. Godinger Silver Art, Co., Inc.*,³²⁰ for instance, the Second Circuit Court of Appeals held that baroque patterns in the form of curls, scrolls, and flowers on the handles of silverware were aesthetically functional features to the appearance of baroque-style silverware, no matter the source of the patterns.³²¹ Consequently, the color white is aesthetically functional for the color of icing on wedding cakes because white is the traditional color associated with bridal gowns and weddings in western cultures. In *Norwich Pharmacal Co. v. Sterling Drug, Inc.*,³²² for instance, the Second Circuit found the pink color of Pepto-Bismol unprotectable trade dress

³¹⁴ 369 F.3d 1197 (11th Cir. 2004).

³¹⁵ *Id.* at 1206. The court also ruled that the color of ice cream was functional because it indicated the flavor of the ice cream. *Id.* at 1204. Note that flavors are generally not protected as trademarks because consumers do not perceive them as trademarks. *See, e.g., In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1649 (T.T.A.B. 2006); *see generally* Leigha Santoro, Note, *A Tasteful Expansion of the Already Full Plate of Intellectual Property*, 12 DREXEL L. REV. 171 (2019); Amanda E. Compton, *Acquiring a Flavor for Trademarks: There's No Common Taste in the World*, 8 NW. J. TECH. & INTELL. PROP. 340 (2010).

³¹⁶ 265 U.S. 526 (1924).

³¹⁷ *Id.* at 529 (“Chocolate is used as an ingredient, not alone for the purpose of imparting a distinctive color, but for the purpose of also making the preparation peculiarly agreeable to the palate, to say nothing of its effect as a suspending medium. While it is not a medicinal element in the preparation, it serves a substantial and desirable use, which prevents it from being a mere matter of dress.”).

³¹⁸ *See Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1039 (11th Cir. 1996) (holding that the design of a composite steel floor deck profile was functional because it added to the quality and strength of the deck).

³¹⁹ *See* Saunders, *supra* note 35, at 549–50.

³²⁰ 916 F.2d 76 (2d Cir. 1990).

³²¹ *Id.* at 81.

³²² 271 F.2d 569 (2d Cir. 1959)

since pink soothed and pleased consumers with upset stomachs.³²³ Further, in *McNeil Nutritionals, LLC v. Heartland Sweeteners LLC*,³²⁴ the Eastern District of Pennsylvania noted that color-coding of various artificial sweeteners was an industry standard that consumers relied on to differentiate their chemical compositions.³²⁵

Therefore, since many food designs also help make food more attractive or fun to eat, a strong argument can be made that food design is not solely to help consumers identify a food product's origin. It is safe to assume no manufacturer of a food product would choose an unappetizing design for the sake of source identification. Take, for example, the Bubba Burger. The Bubba Burger is a perforated and irregularly-shaped frozen hamburger patty. The trademark application for its product design was published for opposition on February 12, 2019.³²⁶ Bubba Foods was then required to demonstrate that its perforated patty shape was not functional.³²⁷ In response, Bubba Foods submitted declarations not only detailing how the unique shape of the burgers lacked functionality in taste or texture but also added to the cost of their manufacture.³²⁸ The examiner later found the mark entitled to registration.³²⁹ But there are more functionality issues at work here.

First, even though the Bubba Burger shape is “irregular,” the options for modifying the shape are curtailed by the limitations on creativity rendered by the traditional hamburger bun, which it must fit to be commercially viable. Second, while Bubba Foods produced evidence that the unusual shape of the burger did not contribute to taste or texture, that does not address aesthetic functionality.³³⁰ This absence raises several questions. Does the unusual shape make the burger more appealing and interesting to eat? Will Bubba Burger now have the right to the exclusive use of an irregular-shaped hamburger patty? Will the rest of the burger manufacturers be constrained to the use of a round or square patty? Does that put competitors at a significant non-reputational related disadvantage? As these questions suggest, while not all food designs are functional, it is likely that a great number of food designs would fail the aesthetic functionality test. Conversely, given the more relaxed functionality standard for design patents,³³¹ food designs seeking patent protection

³²³ *Id.* at 572 (pink color was designed to present a pleasing appearance to the customer and the sufferer; “a disordered stomach will accept that which is pleasing and reject that which is repulsive”).

³²⁴ 512 F. Supp. 2d 217 (E.D. Pa. 2007).

³²⁵ *See id.* at 222.

³²⁶ U.S. Trademark Application Serial No. 87815098 (filed Feb. 28, 2018).

³²⁷ Tommy Tobin & Jeannie Heffernan, *Want Fries With that Trademark?*, A.B.A. (Mar. 13, 2019), <https://www.americanbar.org/groups/litigation/committees/intellectual-property/practice/2019/want-fries-with-that-trademark-fast-food/>.

³²⁸ *Id.*

³²⁹ The mark consists of the configuration of a hamburger patty, Registration No. 5742743.

³³⁰ *See supra* notes 318–25 and accompanying text.

³³¹ *See supra* notes 134–136 and accompanying text.

would likely meet the test in most instances—further underscoring the uneven overlay between trade dress and design patents.

D. Should Doctrinal Bootstrapping be Eliminated?

The Supreme Court stated in *Wal-Mart v. Samara*, that if a product design really were inherently source identifying but had not yet acquired secondary meaning, the owner could obtain a design patent or copyright protection in lieu of a trademark.³³² This statement conflates the purposes and elements of intellectual property protection. Trademark law is concerned with product identification and preventing consumer confusion.³³³ Meanwhile, copyright law and patent law encourage and reward creativity and invention.³³⁴ Consequently, there is no requirement under either law that the work or design be inherently source identifying.³³⁵ Any product design, whether inherently source identifying or not, is eligible for design patent or copyright protection, assuming the requirements for such protections are met.³³⁶

Instead, in *Wal-Mart v. Samara*, the Supreme Court drew a map for how an owner of a product design that is not inherently source identifying may use the design patent period to acquire the secondary meaning necessary to obtain trademark protection. The owner of a product design may apply for a design patent.³³⁷ If successful, the owner will be able to keep all competitors from the market for the term of the design patent and use that time to develop secondary meaning without any threat of competition.³³⁸ Once secondary meaning is established, the owner can then apply for trademark registration, which, unlike a design patent, can last indefinitely.³³⁹

In fact, empirical evidence shows that design patents are relatively easy to obtain. One empirical study showed that nearly eighty-two percent of design patent applications are approved without any objection from the U.S Patent and Trademark Office.³⁴⁰ Over ninety percent of those design

³³² 529 U.S. 205, 214 (2000).

³³³ See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163–65 (1995) (outlining the purpose of trademark law and comparing its purpose to that of patent law).

³³⁴ See *Goldstein v. California*, 412 U.S. 546, 555 (1973) (citing U.S. CONST. art. I, § 8 cl. 8).

³³⁵ Otherwise stated, a trademark is neither a “writing” nor an “invention” within the meaning of copyright and patent law. See *Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

³³⁶ See *supra* notes 35–39, 126–128 and accompanying text.

³³⁷ 35 U.S.C. § 171.

³³⁸ Patents give the owner a negative monopoly, allowing the owner to exclude all others from the use of the design. *United States v. Line Material Co.*, 333 U.S. 287, 308 (1948); 35 U.S.C. § 154 (a)(1). Further, patents carry a presumption of validity that can only be overcome with clear and convincing evidence. *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 95 (2011).

³³⁹ This situation is not unique to food design; it applies to any product design.

³⁴⁰ See Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* 19 (Univ. of Mo. Sch. of Law Legal Studies Research Paper Series, Research Paper No. 2010-17, 2010 (available at <https://scholarship.law.missouri.edu/cgi/viewcontent.cgi?article=1469&context=facpubs>)).

patents are eventually approved, compared with an approval rate of only forty-four percent for utility patents.³⁴¹ Thus, other than the cost and time of obtaining a design patent, there seem to be few barriers for a party to developing secondary meaning during the design patent's exclusivity period without interference by competitors.

This ability to use the exclusivity period provided by a design patent to develop secondary meaning, or "doctrinal bootstrapping," has been reviewed positively by some commentators.³⁴² In contrast, another commentator has referred to reliance on design patents for an exclusivity period as "cheating the trademark system," explaining that "[n]o other types of trademark rights enjoy this exclusivity period for establishing secondary meaning."³⁴³ Recall also that an expired design patent creates a presumption of nonfunctionality if the patent protected design and proposed mark are identical, though this may be rebutted by other evidence pointing to the functionality of the design.³⁴⁴

The ability to bootstrap a design patent into potentially indefinite trademark protection cuts against the policy tradeoffs underlying patent protection—in exchange for public disclosure, the owner is given a *limited* term of protection.³⁴⁵ As the Supreme Court stated in *United States v. Dubilier Condenser Corp.*,³⁴⁶ "upon the expiration of that [patent] period, the knowledge of the invention inures to the people, who are thus enabled without restrictions to practice it and profit by its use."³⁴⁷ The Supreme Court has repeatedly emphasized the importance of free public use once the term of the patent has expired.³⁴⁸

³⁴¹ *Id.* at 18.

³⁴² *Id.* at 31–32. See also Elizabeth D. Ferrill & Danny M. Awdeh, *What Do Sugarina's Bento Box, the Heinz Dip & Squeeze, and the Pepperidge Farm Goldfish Have in Common? Design Rights*, MODERN REST. MGMT. (Oct. 22, 2018), <https://modernrestaurantmanagement.com/what-do-sugarfinas-bento-box-the-heinz-dip-squeeze-and-the-pepperidge-farm-goldfish-have-in-common-design-rights/> ("With respect to design rights and trade dress rights, some companies first secure design rights for their products because this provides protection without proof of secondary meaning, giving the company time to develop trade dress rights without interference from their competitors during the term of the design patent.").

³⁴³ Daniel H. Brean, *Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTELL. PROP. L.J. 325, 364 (2008).

³⁴⁴ See *supra* note 273 and accompanying text.

³⁴⁵ See *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974) (explaining that the government trades a term of exclusive right in exchange for public disclosure that will "stimulate ideas and the eventual development of further significant advances in the art").

³⁴⁶ 289 U.S. 178 (1933).

³⁴⁷ *Id.* at 187. See also *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964) ("[W]hen [a] patent expires the monopoly created by it expires, too, and the right to make the article . . . passes to the public.").

³⁴⁸ See *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979) ("First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions, to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent

Many commentators have proposed that the scope of design patent protection be limited or even eliminated since design patents, copyright, and trademark protections overlap.³⁴⁹ One approach to eliminate this concern would be to have the product design owner choose between design patent, copyright, or trademark. However, lower courts have rejected this “election” approach under the current statutory scheme.³⁵⁰ For instance, in *Application of Mogen David Wine Corp.*, the now defunct the U.S. Court of Customs and Patent Appeals observed that trademark rights do not “extend” the patent monopoly to justify the availability of trademark protection after the design patent expires.³⁵¹ The court pointed out that while a design patent gives the owner a power to exclude others from using the design, a trademark owner must prove that another party’s subsequent design use creates customer confusion.³⁵² While the Supreme Court has yet to rule on this issue, in *Traffix Devices, Inc.*,³⁵³ the Court implied that successive trademark protection could be obtained were the requirements for such protection met, despite denying trademark protection on the grounds that the design at issue was functional.³⁵⁴

However, permitting a design patent owner to bootstrap into trademark registration clashes with patent protection’s underlying policy concerns. Once a patent term expires, the public is supposed to be enabled to practice the invention without restriction and to profit from its use.³⁵⁵ The appropriate question then is whether successive trademark protection is consistent with the policies pursuant to which the patent monopoly was

protection seek to assure that ideas in the public domain remain there for the free use of the public.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (the “centerpiece of federal patent policy” is its “ultimate goal of public disclosure and use”).

³⁴⁹ See Bream, *supra* note 343, at 326–28 (calling for the elimination of design patent protection and relying instead on copyright and trademark); Ralph D. Clifford & Richard J. Peltz-Steele, *The Constitutionality of Design Patents*, 14 CHI.-KENT J. INTELL. PROP. 553 (2015) (arguing that design patents are not authorized by the Constitution); Lee & Sunder, *supra* note 299, at 277 (arguing that even the most persuasive and defensible justifications for design patents counsel a limited right at best).

³⁵⁰ See *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 638 (7th Cir. 1993) (“In sum, courts have consistently held that a product’s different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.”); *Application of Yardley*, 493 F.2d 1389, 1393 (C.C.P.A. 1974) (holding a design may be both the subject of copyright and design patent); see also 1 MCCARTHY ON TRADEMARKS §7.91 (5th ed. 2021 update) (“In the early years of the Lanham Act, the Patent Office held that a product or container design covered by a design patent was unregistrable as a trademark. But by 1959, the Office had changed its position.”). For a discussion of the benefits and detriments of overlapping intellectual property rights, see Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L. J. 1473 (2004).

³⁵¹ 328 F.2d 925, 930 (C.C.P.A. 1964).

³⁵² *Id.*

³⁵³ *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34–35 (2001).

³⁵⁴ *Id.* at 29–30.

³⁵⁵ 35 U.S.C. § 154(a)(2).

granted in the first place. A trademark owner has the right to exclude others from using the product design upon a showing of the likelihood of confusion or, in the case of dilution, upon establishing that the trademark is famous.³⁵⁶ This right significantly restricts the public's ability to profit from patented designs.

In addition to whether doctrinal bootstrapping is consistent with patent law policies, fairness issues are also involved. Blurring the patent and trademark laws may allow parties to game the system by providing unfair advantages to those who can leverage the market for the fifteen year patent exclusivity period to develop secondary meaning and thereafter secure trade dress protection.

For our purposes, this problem would be eliminated if food design was protected by design patent or trade dress, but not both. This article notes several ways that overlapping protections might be eliminated. If food is excluded from categorization as an article of manufacture, it would not be eligible for design patent protection, leaving trade dress as the only form of intellectual property protection. Conversely, if virtually all food design were deemed aesthetically functional, design patent protection would be available with limited to no trade dress protection. However, if food is both (a) excluded from categorization as an article of manufacture and (b) almost always aesthetically functional, no intellectual property protection for food design at all could be another option.

However, these solutions are not ideal. Having no design patent protection would seem to be advantageous to larger companies and hurt smaller entrepreneurs, because the larger companies could copy a food design before it was able to acquire secondary meaning. Although not involving food design, *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*³⁵⁷ presents a good example of how this could happen. Wal-Mart intentionally copied Samara's clothing designs before they were able to acquire secondary meaning.³⁵⁸ Providing no trade dress protection would present similar issues because protection for food design would then be limited to the fifteen-year term of a design patent, at which point it would be freely available to the public to use. In instances where food design is clearly source identifying, such as with the Pepperidge Farm goldfish crackers, the policy of protecting against public confusion as to the source of the food product would not be served after the patent term expired.³⁵⁹ The prospect of having no intellectual property protection for food design at all also does not seem reasonable.

A possible solution to address these issues is to re-examine the wisdom of allowing the owner of a design patent to simultaneously or successively register the configuration as a trademark. The U.S. Patent and Trademark Office once prohibited a trademark registration to the owner of a design patent.³⁶⁰ While some lower courts have rejected this

³⁵⁶ See *supra* notes 233–36, 242 and accompanying text.

³⁵⁷ 529 U.S. 205 (2000).

³⁵⁸ *Id.* at 207–08. See *supra* notes 205–207 and accompanying text.

³⁵⁹ See *supra* notes 246–256 and accompanying text.

³⁶⁰ See MCCARTHY ON TRADEMARKS § 7.91.

approach, the issue has yet to be resolved by the Supreme Court.³⁶¹ This option would permit the owner of a food design to opt for design patent protection or trade dress protection, depending on which protection was best suited for their commercial needs. It would also honor the underlying policies of each form of intellectual property.³⁶² Patented design would become freely available to the public upon the expiration of the patent term, and trade dress would potentially indefinitely protect against confusion as to source of the product.

CONCLUSION

Edible intellectual property seems like an unpalatable concept. Yet recipes and food designs are protectable by a range of intellectual property rights. As we have seen, some forms of intellectual property are a better fit than others for recipes and food designs. They are all subject to limitations, most notably as to their requirements and the scope of rights they afford. Recipes that are not commonly known and kept confidential can be maintained as trade secrets and will be protected against unauthorized use or disclosure and improper acquisition. Protection of recipes as processes and food designs by means of utility patents is a potential but difficult fit due to the exacting requirements of novelty and nonobviousness. Copyright protection of recipes is mostly impossible except for original expression beyond the facts and procedures of the recipe itself, and for original compilations of recipes.

Food designs appear to be better suited to protection by design patents as to their ornamental aspects or, if they are distinctive as to their source, as trade dress. For food designs, copyright protection is made impossible by the requirement of fixation and by the difficulty in separating purely expressive elements from the food design itself. More notably, this article has explored whether there should be intellectual property protection for food design at all. An additional question addressed is whether such broad protection is consistent with the law governing “articles of manufacture” and aesthetic functionality, and whether it serves or hinders the purposes of intellectual property protection and free competition. Especially troublesome is the use of design patent protection as a backdoor into long-term trade dress protection. Given how much people relish innovative cooking and unique culinary creations, these issues are no small potatoes.

³⁶¹ See *supra* notes 353-54 and accompanying text.

³⁶² See *supra* notes 333-34 and accompanying text.