

# HAVING YOUR CAKE AND EATING IT TOO: INTELLECTUAL PROPERTY PROTECTION FOR CAKE DESIGN

HANNAH BROWN

## CONTENTS

I.	Introduction.....	32
II.	The Booming Business of Cake Design .....	37
III.	Cake Design as Intellectual Property – The Available Means of Protection .....	45
A.	<i>Copyrights to Protect Cake Design</i> .....	46
1.	Background on Copyright Law .....	46
2.	Copyrights, Clearly Suitable for Cake Design ... .....	52
B.	<i>Trademark and Trade Dress to Protect Cake Design</i> .....	59
1.	Background on Trademark and Trade Dress Law .....	60
2.	Characteristic Cake Designs as Trademarks .....	65
C.	<i>Trade Secret Law to Protect Cake Design</i> .....	72
1.	Background on Trade Secret Law .....	72
2.	Cake Designs, Methods, and Recipes as Trade Secrets .....	74
D.	<i>Design Patents to Protect Cake Design</i> .....	77
1.	Background on Patent Law.....	77

2.	Design Patents, for Wealthy Cake Designers .....	81
3.	Using Design Patents for Cake Design.....	83
IV.	A Logical Solution .....	88
V.	Conclusion .....	98

## I. INTRODUCTION

“Let them eat cake!” exclaimed Marie Antoinette upon hearing that the French citizens did not have enough food.<sup>1</sup> Back in 1789, “cake,” when spoken in this context, did not refer to the cake that society is used to today.<sup>2</sup> The actual phrase stated was “Qu’ils mangent de la brioche,” which literally translates to, “Let them eat the expensive, egg-based bread.”<sup>3</sup> Yet, the quote somehow was translated to say “cake,” and we remember it as cake.<sup>4</sup> However, cake

---

<sup>1</sup> *Did Marie Antoinette Really Say “Let Them Eat Cake”?*, HISTORY (Oct. 24, 2012), <http://www.history.com/news/ask-history/did-marie-antoinette-really-say-let-them-eat-cake> [<http://perma.cc/8YDC-FYSM>]. Marie Antoinette actually probably did not say these words. *Id.* According to historians, this phrase would have been uncharacteristic of the French queen because she was a charitable woman who cared deeply about the citizens of France. *Id.*

<sup>2</sup> Jonah Goldberg, *Marie Antoinette Goes to Hollywood*, NAT’L REV. (Aug. 7, 2001, 1:50PM), <http://www.nationalreview.com/articles/204991/marie-antoinette-goes-hollywood/jonah-goldberg> [<http://perma.cc/M97Z-Y4EZ>].

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* The expression first came from Jean-Jacques Rousseau’s *Confessions*, a treatise written in 1768. *Id.* Rousseau wrote *Confessions* two years before Antoinette moved to France. *Id.* Therefore, it is possible that Rousseau said the phrase himself, or Queen Marie Therese could have said it. *Id.* Historians are not

today is no longer mere rich, egg-based bread. Cake has evolved not only in taste and in ingredients, but also in meaning, and has become the symbol of a celebration, used to signify a special moment in one's life such as a birthday or a wedding.<sup>5</sup> Cakes have become works of art often created specially by cake design artists.<sup>6</sup>

---

surprised that the phrase has been attributed to Antoinette because she was kindhearted. *Id.* Whoever he or she was, the speaker of this famous phrase was probably not saying it to be rude. *Id.* In 1789, a French law required bakers to sell their expensive, egg-based bread at the same price as inexpensive bread. *Id.* This turned out to be an unfortunate law for the lower class. *Id.* In context, the speaker of this phrase most likely meant, "If they have run out of inexpensive bread, let them eat the expensive bread," suggesting that the bakers should follow the law and feed the lower class the expensive bread, even though the bakeries would lose money as a result. *Id.*

<sup>5</sup> See *Birthday Cakes*, AMAZING CAKES BAKERY, <http://amazingcakesbakery.com/birthday-cakes/> [<http://perma.cc/Y92W-8UWT>] (last visited Sept. 19, 2014) (website for a bakery that believes no celebration is complete without a special cake); *Wedding Cakes*, PORTO'S BAKERY, <http://www.portosbakery.com/content/wedding-cakes> [<http://perma.cc/NH78-9LQ5>] (last visited Sept. 19, 2014) (website for a bakery that believes the wedding cake is as significant and memorable as the couple's first kiss or their walk to the alter).

<sup>6</sup> See *WORKS OF ART CAKES*, <http://www.worksofartcakes.com/> [<http://perma.cc/2NFS-Z4LZ>] (last visited Sept. 19, 2014) (website for a bakery whose slogan is "If you can dream it, we can cake it!"); see also Glenn Yoder, *The Drill: Make It Delicious*, BOS. GLOBE (Sept. 20, 2011), <http://www.bostonglobe.com/lifestyle/foodandddining/2011/09/20/the-drill-make-delicious/sfmYVyx3AKuV9WIIWLQNI/story.html> [<http://perma.cc/6URB-JBWS>] (describing an interview with Chef Ron Ben-Israel, a cake design artist). Chef Ben-Israel hopes to push chefs "to do something that has imagination and culture." *Id.* He points out that "vanilla cake doesn't have to be just vanilla, it can have a little thyme. Or you could have a custard with a little lavender in it, which is just amazing." *Id.*

When most people hear the word “art,” they think of a painting, a drawing, or maybe a sculpture. But when many chefs think of art, they picture an extravagant cake.<sup>7</sup> Breathtaking cakes that double as works of art are newly popular, and have turned many previously mediocre bakeries into thriving businesses.<sup>8</sup> Many cakes today, such as those created for celebrity weddings or for competitions on television shows, are as novel and as beautiful as many paintings and sculptures.<sup>9</sup> Therefore, like other works of art, cake designs are readily copied by infringers who hope to create works that are as wonderful as the original.<sup>10</sup> This

---

<sup>7</sup> Some chefs even describe certain cakes as “edible masterpiece[s].” *Cake is Art*, DELICIOUS CAKES (Mar. 27, 2012), <http://www.deliciouscakes.com/2012/03/27/cake-is-art/> [<http://perma.cc/6NYV-YFRT>].

<sup>8</sup> See Glenn Collins, *Extravagant Wedding Cakes Rise Again*, N.Y. TIMES (June 6, 2014), <http://www.nytimes.com/2014/06/08/fashion/weddings/extravagant-wedding-cakes-rise-again.html> [<http://perma.cc/G48R-RVKM>] (noting consumers’ returning desire for big weddings and extravagant and expensive cakes). The article notes that ninety percent of couples offer cake at their weddings. *Id.* This is a yearly expenditure of two billion dollars for American weddings alone. *Id.* Bakeries throughout the country reap the financial benefits of the desire for large and pricey cakes. *Id.*

<sup>9</sup> For a look at *Brides* magazine’s most beautiful wedding cakes, see Heather Lee, *The 50 Most Beautiful Wedding Cakes*, BRIDES, <http://www.brides.com/wedding-ideas/wedding-cakes/editorial-pick/2008/01/the-50-most-beautiful-wedding-cakes#slide=1> [<http://perma.cc/5UNU-LFQ4>] (last visited Sept. 23, 2014). The cakes pictured in this article are beautiful and unique, looking almost too good to eat. *Id.*

<sup>10</sup> Elizabeth Armijo, Comment to *Cake Ideas, is it Stealing????*, CAKES WE BAKE (Aug. 3, 2011, 9:10PM), <http://www.cakeswebake.com/forum/topics/cake-ideas-is-it-stealing> [<http://perma.cc/57M2-GWAR>] (blogger commenting that she “see[s] nothing wrong with borrowing someones [sic] idea.”); Dawn Becker,

Comment uses the term “cake design” to refer to every aspect of what makes a cake appearance unique, including the use of cake molds, frosting designs, shapes, and decorations, as well as the methods used to create such designs.<sup>11</sup>

Chefs today have come to expect that others will copy their cake designs.<sup>12</sup> This imitation is flattering to some chefs, yet offensive to others.<sup>13</sup> Unfortunately, most

---

Comment to *Cake Ideas, is it Stealing????*, CAKES WE BAKE (Aug. 3, 2011, 2:26AM), <http://www.cakeswebake.com/forum/topics/cake-ideas-is-it-stealing> [<http://perma.cc/57M2-GWAR>] (another blogger noting that she “always see cakes [at fairs]” that she recognizes from the internet). Blogger Armijo uses the word “borrowing” but this act is truly using someone else’s intellectual property for one’s own profit. This copying is comparable to the copying that takes place with other forms of art. See Kaitlyn Ellison, *5 Copyright Infringement Cases (and what you can learn)*, 99DESIGNS, <http://99designs.com/designer-blog/2013/04/19/5-famous-copyright-infringement-cases/> [<http://perma.cc/VK8Q-QKZA>] (last updated Nov. 6, 2014) (discussing the commonly copyrighted works of art).

<sup>11</sup> The arguments in this paper regarding the appropriate protection of cake design could also expand to the protection of food in general, but that argument is beyond the scope of this Comment.

<sup>12</sup> See Katy McLaughlin, ‘*That Melon Tenderloin Looks Awfully Familiar...*’, WALL ST. J. (June 24, 2006, 11:59 PM), available at <http://online.wsj.com/articles/SB115109369352989196> [<http://perma.cc/UQ9K-57SG>] (“Chefs copying other chefs is [a] time-honored . . . culinary tradition . . .”).

<sup>13</sup> Holly F, Comment to *Cake Ideas, is it Stealing????*, CAKES WE BAKE (Aug. 2, 2011, 5:01PM), <http://www.cakeswebake.com/forum/topics/cake-ideas-is-it-stealing> [<http://perma.cc/57M2-GWAR>] (one chef blogs, “I think that we are here to inspire eachother, [sic] and if someone were to someday think enough of me to replicate one of my creations, I’d be flattered.”). *Contra* Gretchen Belsome, Comment to *Cake Ideas, is it Stealing????*, CAKES WE BAKE (Aug. 3, 2011, 11:47 AM), <http://www.cakeswebake.com/forum/topics/cake-ideas-is-it-stealing> [<http://perma.cc/57M2-GWAR>] (another blogger on the same thread

chefs do not use legal protection to protect their designs as extensively as they could.<sup>14</sup> The available protection under intellectual property law includes copyright law, which protects the expressive arts; trademark law, which protects the marks associated with a company’s products; trade secret law, which protects confidential business information; and patent law, which protects inventions.<sup>15</sup> Currently, a few companies use design patents, a branch of patent law, to protect the designs of their cakes.<sup>16</sup> For example, Cold Stone Creamery currently has a design patent for its Strawberry

---

noting that she might feel insulted if someone used her idea for a cake).

<sup>14</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1768 (2006) (noting that food is a negative space of intellectual property law). Although these scholars were primarily referring to recipes as a negative space, other scholars take this idea further, arguing that “culinary creations” in general also fall into this negative space. Caroline M. Reeb, *Sweet or Sour: Extending Copyright Protection to Food Art*, 22 DEPAUL J. ART, TECH. & INTELL. PROP. L. 41, 41 (2011). There is little to no precedent specifically on protecting cake design as opposed to food art design, but it falls into the “culinary creation” category and is therefore not protected. Intellectual property law and cake designs do interact, but primarily in the context of trademarked images. See Peter Elkind, *Stop Copying That Mickey, or We’ll Shoot! Why You Can’t Have Your Cartoon-Character Cake and Eat It Too*, FORTUNE (Dec. 29, 1997), available at [http://archive.fortune.com/magazines/fortune/fortune\\_archive/1997/12/29/235894/index.htm](http://archive.fortune.com/magazines/fortune/fortune_archive/1997/12/29/235894/index.htm) [<http://perma.cc/2TQ9-YX85>] (noting that the owners of cartoon media, such as Disney and United Media, are sending cease-and-desist letters to bakeries who use their trademarked characters on cakes).

<sup>15</sup> *Intellectual Property Protection*, UPCOUNSEL, <https://www.upcounsel.com/intellectual-property-protection> [<http://perma.cc/FBW3-LVCD>] (last visited Dec. 14, 2014).

<sup>16</sup> See *infra* Part III.D.2.

Passion cake, a red velvet cake with strawberry frosting.<sup>17</sup> This Comment argues that cake design is eligible for copyright, trademark, and trade secret protection, but not for patent protection. Cake design should be excluded from patent protection because cake design is not an article of manufacture. Instead, if cake designers want to use legal means to protect the appearance of their work, they should use copyright law, and if they are searching for general brand recognition, they should use trademark law. Furthermore, cake designers can use trade secret law to protect specific elements of the cake design process. Finally, if cake designers do not want to protect their work through legal means, there are many non-legal options available. Part II of this Comment explains the cake design business and why it is important that cakes receive protection. Part III introduces copyrights, trademarks, trade secrets, and design patents and includes comparisons to other forms of art that are currently protected by these four areas of law. Part IV explains why cake designs should not be eligible for design patent protection, but suggests more suitable legal and extralegal methods to protect them instead.

## **II. THE BOOMING BUSINESS OF CAKE DESIGN**

When a couple gets married, they can choose to symbolize their marriage with a generic white cake from their local bakery decorated with plain frosting, or they can go to Ron Ben-Israel, a baker in New York City known for

---

<sup>17</sup> See U.S. Patent No. D571,526 (filed Apr. 11, 2007); *Strawberry Passion*, COLD STONE CREAMERY, [https://coldstonecreamery.com/cakes/signaturecakes/strawberrypassion/index.html#.VgRE64\\_BzGc](https://coldstonecreamery.com/cakes/signaturecakes/strawberrypassion/index.html#.VgRE64_BzGc) [http://perma.cc/PDM3-HCNW] (last visited Dec. 14, 2014).

his over-the-top cakes.<sup>18</sup> Ben-Israel's past creations include a cake with an ornamental peacock on the top, a five-layer cake covered in edible flowers, and a beautiful blue and gold cake that looks like it belongs in a royal museum.<sup>19</sup> Ben-Israel does not reveal the price of his cakes, but he will admit that the starting price for any of his sculptured cakes is \$1,500 and that he once sold a wedding cake for \$30,000.<sup>20</sup>

Although Ben-Israel's website currently says nothing about intellectual property protection for his cake designs, he does proclaim that he will not send measurements or designs to other bakers and will not let anyone watch him work.<sup>21</sup> However, he does teach classes, willingly offering to explain basic cake art to pastry

---

<sup>18</sup> Jacqueline Raposo, *Ron Ben-Israel on Changing the Course of Wedding Cakes*, SERIOUS EATS (Aug. 6, 2013, 11:45 AM), <http://newyork.serious eats.com/2013/08/ron-ben-israel-on-changing-the-course-of-wedding-cakes.html> [<http://perma.cc/7655-9ZH7>]. Ben-Israel is one of the most successful bakers today. *Id.* Ben-Israel began baking in 1993 and, soon after this, Martha Stewart discovered him and his career took off. *Id.* His cakes have been featured in *The New York Times*, *New York Magazine*, *Martha Stewart Living*, *Cosmopolitan*, and *Vogue*. *Id.* Ben-Israel was also the host of Food Network's reality-based cooking television series, *Sweet Genius*, which ran from 2011 to 2013. *Id.*

<sup>19</sup> For pictures of Ben-Israel's cakes, see *Collections*, WEDDING CAKES, <http://www.weddingcakes.com/> [<http://perma.cc/H3ZN-D87T>] (last visited Sept. 19, 2014).

<sup>20</sup> See COLLINS, *supra* note 8.

<sup>21</sup> See *Questions and Answers*, WEDDING CAKES, *supra* note 19..19. This may be a way to protect Mr. Ben-Israel's trade secrets. See *infra* Part III.(C)(2). It is common for cake designers to use this or other protection to lessen the copying of their designs. See, e.g., E-mail from Nanci Ross, Overseer of media and informational requests for Sylvia Weinstock, to author (Oct. 1, 2014, 5:25AM PST) (on file with author) (Ms. Ross stated that Ms. Weinstock does not comment on the copying of cake designs).



students.<sup>22</sup> Although Ben-Israel has acquired a trademark for RON BEN-ISRAEL CAKES for custom cake baking and decorating services,<sup>23</sup> a search of the United States Patent and Trademark Office (USPTO) website reveals no issued patents for any of his cake designs, nor is there any sign on Ben-Israel's website of his use of copyright protection.<sup>24</sup>

With the economy recovering, the desire for big wedding cakes has grown and more couples are choosing unique, expensive cakes rather than generic ones.<sup>25</sup> This interest in cake design has boosted bakery sales. In 2008, the average bakery earned approximately \$2,582 per week purely off of in-store cake sales.<sup>26</sup> Cakes represent 28.6% of the average bakery's total dollar sales, with decorated cakes representing 35.9% of these sales.<sup>27</sup> People are captivated by beautiful cake designs, a fad that is not ending anytime soon, and has even spawned new interest in cupcake

---

<sup>22</sup> *Questions and Answers*, WEDDING CAKES, *supra* note 19.

<sup>23</sup> RON BEN-ISRAEL CAKES, Registration No. 3,404,683.

<sup>24</sup> For more on Ben-Israel, see Andrea Keeney, *Top 10 Most Expensive Mouthwatering Wedding Cakes*, *THE RICHEST* (May 20, 2014), <http://www.therichest.com/luxury/most-expensive/top-10-most-expensive-wedding-cakes/> [<http://perma.cc/GJZ7-RZY4>] (describing a cake created by Ben-Israel for the movie *Sex and the City 2*..). The cake took him 450 hours to create. *Id.* It is therefore logical that Ben-Israel would not want anyone to unfairly profit from his hard work.

<sup>25</sup> See COLLINS, *supra* note 8 (baker Cheryl Kleiman states that almost all of her clients request customized cakes and that the bakery business is better than it was three years ago).

<sup>26</sup> Cakes, affordable Indulgence, BAKERY WHITE PAPER (Dawn Food Products, Inc.), Dec. 2008, at 5, available at [http://www.dawnfoods.com/Public/Managed/indexedfiles/WhitePaper\\_sDec08\\_4of4\\_Cakes.pdf](http://www.dawnfoods.com/Public/Managed/indexedfiles/WhitePaper_sDec08_4of4_Cakes.pdf) [<http://perma.cc/LWM4-D5LD>].

<sup>27</sup> *Id.*

design.<sup>28</sup> Patents also exist in the cupcake world. U.S. Patent No. D616,260, for example, is a design patent for the ornamental design of a cupcake mold; there are many design patents for cupcake holders and carriers as well.<sup>29</sup> Cupcakes arguably deserve the same protection as cakes due to the vast similarities between cakes and cupcakes, but that protection is beyond the scope of this Comment.

The emerging cake business is largely due to the creation of reality television shows that follow cake chefs as they create masterpieces for wealthy clients.<sup>30</sup> *Cake Boss*, a reality television show that follows chef Buddy Valastro as he makes elaborate, unique cakes in his bakery, averages two

---

<sup>28</sup> See, e.g., *Sunday's Cable Ratings: "True Blood" Remains Unstoppable for HBO*, FUTON CRITIC (July 10, 2012, 1:16PM), [http://www.thefutoncritic.com/ratings/2012/07/10/sundays-cable-ratings-true-blood-remains-unstoppable-for-hbo-439410/cable\\_20120708/](http://www.thefutoncritic.com/ratings/2012/07/10/sundays-cable-ratings-true-blood-remains-unstoppable-for-hbo-439410/cable_20120708/) [<http://perma.cc/J5UJ-8Q8G>], (noting the ranking and 1.4 million-strong viewership of *Cupcake Wars*, a Food Network reality competition show centering on the creation of unique cupcakes).

<sup>29</sup> See, e.g., U.S. Patent No. D616,260 (filed July 31, 2009).

<sup>30</sup> See *Dessert Professional's Top Ten Cake Artists of North America 2014*, DESSERT PROF'L (Aug. 10, 2014), <http://www.dessertprofessional.com/index.php/top-ten-chefs/top-10-cake-artists-of-2014> [<http://perma.cc/VQ7T-NPQ9>] (chef Charity Pykles-George noting that the cake artistry field has changed due to the influence of *Ace of Cakes* and *Cake Boss*. The chef notes that before these shows aired, cakes were boring. Now, "customers have seen what's possible with edible mediums and they are open to creativity . . ."); Esmeralda Pinilla, *Cake Blog*, COUTURE CAKE SHOP, <http://www.couturecakeshop.com/CAKEBLOG.html> [<http://perma.cc/8MCF-7DFX>] (last visited Jan. 9, 2015) (bakery owner noting that cakes are "becoming more refined thanks to television shows . . ." like *Ace of Cakes* and *Cake Boss*. "Thank goodness for that...our business is booming!").

million viewers per episode.<sup>31</sup> On the show, Valastro has created a cake in the shape of a castle, one that replicates a garden, and even a massive aquarium cake complete with a real fish tank.<sup>32</sup> The cakes Valastro creates on his show are one-of-a-kind, but a search of the USPTO website reveals no design patents acquired by Valastro, nor is there any evidence of use of copyright on his website. However, Valastro has granted a small New Jersey company a license to sell mass-produced versions of his cakes.<sup>33</sup>

*Ace of Cakes*, another reality show on the Food Network, follows the life of chef Duff Goldman as he wows viewers with his awe-inspiring cakes.<sup>34</sup> In every episode of the show's ten seasons, viewers observed chefs create novelty cakes such as a Hogwarts Castle for the opening of *Harry Potter*, a shark ray for the Newport Aquarium, and a Hubble Space Telescope for NASA.<sup>35</sup> Goldman's cakes have been described as "more than delicious – they're works

---

<sup>31</sup> Kyla Brewer, *Sweet Success: TLC's Ratings Rise with 'Cake Boss'*, TV TABLOID, <http://decoy.tvpassport.com/news/sweet-success-tlcs-ratings-rise-cake-boss> [<http://perma.cc/3D2M-44F8>] (last visited Sept. 19, 2014).

<sup>32</sup> TLC, *Buddy's Most Amazing Cakes – Cake Boss*, YOUTUBE (June 29, 2012), <http://www.youtube.com/watch?v=JJSaCLpXdm0> [<http://perma.cc/JQE6-N7NZ>].

<sup>33</sup> Michael Stone, *Top 10 Licensed Brand Extensions of 2012*, FORBES, (Jan. 22, 2013, 2:42 PM), <http://www.forbes.com/sites/michaelstone/2013/01/22/top-10-licensed-brand-extensions-of-2012/>.

<sup>34</sup> *Ace of Cakes*, IMDB, <http://www.imdb.com/title/tt0842903/> [<http://perma.cc/LL4N-9XCQ>] (last visited Sept. 19, 2014). Gordon is known for his untraditional style, and has been known to use power tools to assist in his cake decorating.

<sup>35</sup> *NASA has its Hubble cake, can't eat it too*, COLLECTSPACE (Apr. 6, 2009), <http://www.collectspace.com/news/news-040609a.html> [<http://perma.cc/Z7U6-R5MB>].

of art.”<sup>36</sup> Like Valastro, Goldman does not use design patents to protect his cakes, nor is there any evidence of use of copyright on his website.<sup>37</sup> However, Goldman has created a custom line of baking and decorating products that allow his fans to create their own cakes at home.<sup>38</sup> Goldman is known for using “tools that may not be considered traditional” and has profited off the sales of replicas of such tools to aspiring bakers.<sup>39</sup>

The cake decorating business has not only been publicized on television. Other media forms have popularized this booming business as well. Magazines such as *American Cake Decorating*,<sup>40</sup> *Cake Central*,<sup>41</sup> and *Cake Craft and Decoration* thrive,<sup>42</sup> enticing local bakers and

---

<sup>36</sup> *Ace of Cakes*, TV.COM, <http://www.tv.com/shows/ace-of-cakes/> [http://perma.cc/2KRZ-2NRW] (last visited Sept. 23, 2014).

<sup>37</sup> See DUFF, <https://www.duff.com/> [http://perma.cc/6ZEE-HULD] (last visited Jan. 9, 2015).).

<sup>38</sup> *Duff Goldman*, DUFF, <https://www.duff.com/about-duff-goldman> [http://perma.cc/HB7A-QSML] (last visited Sept. 23, 2013).

<sup>39</sup> *Id.*

<sup>40</sup> See *About ACD*, AM. CAKE DECORATING, [http://americancakedecorating.com/?page\\_id=1098](http://americancakedecorating.com/?page_id=1098) [http://perma.cc/CZ4N-PUMK] (last visited Sept. 20, 2014). *American Cake Decorating* began circulating in 1995 and has recently added a website that welcomes over 23,000 visitors per month. See *Advertise*, AM. CAKE DECORATING, <http://www.americancakedecorating.com/advertise.html> [http://perma.cc/HYE8-NPW4] (last visited Sept. 20, 2014).

<sup>41</sup> See *About Cake Central Magazine*, CAKE CENTRAL MAG., <http://cakecentralmagazine.com/about/> [http://perma.cc/8PQP-GQ55] (last visited Sept. 20, 2014). The creators of *Cake Central* recognized the desire for cake decorating tips, trends, and articles and launched both a print and online magazine in March 2010.

<sup>42</sup> CAKE CRAFT & DECORATION, <http://www.cake-craft.com/> [http://perma.cc/N95S-NXVU] (last visited Oct. 2, 2014). *Cake Craft*

amateur chefs to try the issue's featured recipe or design.<sup>43</sup> Furthermore, after various celebrity weddings, many online media outlets post pictures of the couple's wedding cake, sometimes interviewing the chef, but always noting how beautiful and elaborate the cake was.<sup>44</sup>

Viewers are excited by the prospect of having cakes as extravagant as the ones they see in their favorite cooking show and ask their local bakers for something similar. As a result, the amount of copying of cake designs is increasing.<sup>45</sup> Some chefs have no problem copying other chef's cakes when creating one for a client.<sup>46</sup> The Royal Wedding cake

---

*&and Decoration*, self-proclaimed "the world's leading monthly magazine for all those interested in cake decoration and sugarcraft magazine," contains projects in each issue, teaching all skill levels how to create cakes using sugar art and decoration. *Id.*

<sup>43</sup> More cake magazines include *Sweet Magazine*, *Cake Masters Magazine*, and *Cake Decoration Heaven*.

<sup>44</sup> See Bonnie Faller, *Photos! Chelsea Clinton's Wedding Cake*, HOLLYWOOD LIFE (Aug. 1, 2010, 4:50 PM), <http://hollywoodlife.com/pics/chelsea-clinton-wedding-cake-photos-la-tulipe-desserts/> [<http://perma.cc/YK9F-Z7VY>]; Eva Longoria *Wedding Cake*, WEDDINGCAKE.NAME (May 26, 2011), <http://weddingcake.name/eva-longoria-wedding-cake/> [<http://perma.cc/7ZYM-XCKL>].

<sup>45</sup> Patrick, *Cake Design and Copyright Law*, THE INTELLECTABLE (Sept. 28, 2010), <http://theintellectable.blogspot.com/2010/09/cake-design-and-copyright-law.html> [<http://perma.cc/CP8N-9BK7>] (blogger states that cake design copying is increasing, a statistic he determined after speaking to food artists around the country).

<sup>46</sup> See *Photo Theft vs. Design Copying*, CAKE-THIEF (Nov. 27, 2010, 8:58 AM), <http://cake-thief.blogspot.com/2010/11/id-like-to-get-some-clarification-on.html> [<http://perma.cc/CF9Q-ALXQ>] (chef notes that he often creates cakes based off of pictures of others' designs); Susan, Comment to *Copying or Stealing?*, CAKE FU (Apr. 26, 2012, 10:44 AM), <http://www.cakefu.com/copying-or-stealing/> [<http://perma.cc/2W47-6BQM>] (chef notes that she will copy a picture

has specifically been copied many times, some with varying degrees of success.<sup>47</sup> This copying may be a result of unclear law, as many chefs are unsure whether they can copy another’s design.<sup>48</sup> In the cake design culture, like in other artistic cultures today, many chefs do not go through the legal system to protect their work, but instead use other, extralegal means.<sup>49</sup> Based on blog posts and chef forums

---

of a cake a client brings in or that she finds online as long as the cake was originally made by a chef in another state).

<sup>47</sup> E-mail from Kishore Patel and Fiona Cairns, Owners of Fiona Cairns Wedding Cakes and designers/chefs of the Royal Wedding Cake, to author (Sept. 24, 2014, 5:17 AM PST) (on file with author). Mr. Patel stated that gaining intellectual property protection for any invention in the United Kingdom is extremely expensive, so his company chooses to avoid it even though he knows that other chefs have copied his cake. *Id.* Mr. Patel noted that he might rethink using legal protection if the other chefs who copy his cakes began negatively impacting his company’s brand. *Id.*

<sup>48</sup> See, e.g., CAKE-THIEF, *supra* note 46 (Various chefs gave conflicting answers to a confused baker’s question. The baker asked how he should know whether or not he can copy a cake because copying another’s cakes is not illegal. See Anonymous, Comment to *Photo Theft vs. Design Copying*, CAKE-THIEF (Nov. 27, 2010, 1:49 PM), <http://cake-thief.blogspot.com/2010/11/id-like-to-get-some-clarification-on.html>; [<http://perma.cc/JB92-44RQ>] (one responder commenting that copying from photos of cakes is wrong, and that making a cake based on another’s design is infringement) ; see also CustomCakesBySharon, *Copyrights on a Cake Design?*, CAKE CENTRAL (July 6, 2007, 11:46AM), <http://www.cakecentral.com/forum/t/387813/copyrights-on-a-cake-designdesign> [<http://perma.cc/J7RJ-MBA8>] (confused baker asks “can you put a copyright on a cake design?”).

<sup>49</sup> See Dotan Oliar & Christopher Sprigman, *There’s No Free Laugh (Anymore): The Emergence of Intellectual Property Norms and the Transformation of Stand-Up Comedy*, 94 VA. L. REV. 1787, 1790–91 (2008). These scholars argue that although copyright law would protect jokes and comedy routines, comedians have strayed away from intellectual property protection and have used other means of

online, many chefs know that others will copy their cakes but hope that those copiers will give them credit.<sup>50</sup> Other chefs, whose opinions are most likely not based on any legal knowledge but are purely personal views, do not even think that cake designs are legally protectable.<sup>51</sup> Currently, cake designs are protectable under all four types of intellectual property protection. However, this Comment argues that only copyright, trademark and trade secret law should be utilized, as cake design is not an article of manufacture and is therefore not protectable by design patents.

### **III. CAKE DESIGN AS INTELLECTUAL PROPERTY – THE AVAILABLE MEANS OF PROTECTION**

---

protection instead. *Id.* Jokes and routines are protected by social norms, such as sanctions imposed by others in the business. *Id.* These sanctions can take the form of badmouthing and threats, and will result in the joke-thief receiving less work and a hampered career. *Id.*

<sup>50</sup> See e.g., Carmijok, Comment to *Cake Design Copyright*, CAKE CENTRAL (Nov. 27, 2010, 1:02AM), <http://www.cakecentral.com/forum/t/703303/cake-design-copyright> [<http://perma.cc/UG8Z-5LFT>] (chef who often copies pictures of others' cake, but agrees that giving credit is nice); Anonymus, Comment to *Photo Theft vs. Design Copying*, CAKE-THIEF (Nov. 27, 2010, 1:49 PM), <http://cake-thief.blogspot.com/2010/11/id-like-to-get-some-clarification-on.html> [<http://perma.cc/BX4Z-FXPM>] (commenting that when using another chef's cake design as inspiration, credit should be given to the original artist).

<sup>51</sup> Carmijok, *supra* note 49 (one chef posts, "Like fashion, cake designs can't really be copyrighted."); Debbie B, Comment to *Copying or Stealing?*, CAKE FU (July 6, 2012, 9:47 PM), <http://www.cakefu.com/copying-or-stealing/> [<http://perma.cc/2W47-6BQM>] (one chef posts, "there is [n]o copyrite [sic] regarding cake.").

### A. *Copyrights to Protect Cake Design*

Copyrights protect an author’s creative expression.<sup>52</sup> Cake design is clearly an example of a chef’s creative expression and is therefore protectable under copyright law.<sup>53</sup> Cake design fits under the pictorial, graphic, and sculptural works category of copyright law.<sup>54</sup>

#### 1. **Background on Copyright Law**

Copyright law protects the creative expression of artistic and literary works. To qualify for copyright protection, a work must be an original work of authorship fixed in a tangible medium of expression.<sup>55</sup> First, to be original, a work must display “some minimum level of creativity.”<sup>56</sup> This is a liberal test, and the Supreme Court has added, “the vast majority of compilations will pass this test, but not all will.”<sup>57</sup> Works that are not original include words or short phrases, familiar symbols or designs, and mere listings of ingredients.<sup>58</sup> Second, a “work of authorship” traditionally falls into eight categories: literary works; pictorial, graphic, and sculptural works; musical works; sound recordings; dramatic works; pantomimes and choreographic works; motion pictures and other audio-visual works; and architectural works.<sup>59</sup> This list is

---

<sup>52</sup> 17 U.S.C. § 102(a) (2012).

<sup>53</sup> See *infra* Part III.A.2.

<sup>54</sup> *Id.*

<sup>55</sup> 17 U.S.C. § 102(a).

<sup>56</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.* 499 U.S. 340, 358 (1991).

<sup>57</sup> *Id.* at 358–59.

<sup>58</sup> 37 C.F.R. § 202.1(a) (2014).

<sup>59</sup> 17 U.S.C. § 102 (2012)(showing that the current law of copyright replaces protected “writings” with the phrase “works of authorship.”)



illustrative rather than exhaustive, and a work that does not fit into any of these categories can still qualify for copyright protection as long as it satisfies the general definition in 17 U.S.C. § 102.<sup>60</sup> The work of authorship requirement is read liberally, for “the ultimate purpose of copyright law is to stimulate creation and dissemination of as many works of authorship as possible, in order to benefit the public.”<sup>61</sup> Third, to be fixed in a tangible medium of expression, the work must be embodied in a physical form “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”<sup>62</sup> For example, oral presentations and speeches are not “fixed” and therefore are not protectable until they become fixed in a tangible form.<sup>63</sup> If these speeches are committed to paper or broadcast on the news, they become fixed and are therefore protectable.<sup>64</sup>

A copyright is protected from the moment it becomes an original work fixed in a tangible medium.<sup>65</sup> It is therefore

---

*See also.* H.R. REP. NO. 94-1476 at 5664 (1976) (explaining the term led to confusion and Congress therefore replaced it..).

<sup>60</sup> MARY LAFRANCE, *COPYRIGHT LAW IN A NUTSHELL* 15 (2nd ed. 2011).

<sup>61</sup> MARGRETH BARRETT, *EMANUEL LAW OUTLINES: INTELLECTUAL PROPERTY C-19* (3rd ed. 2012).

<sup>62</sup> 17 U.S.C. § 101 (2012). (Copyright protection begins at the moment of fixation..). *Copyright Basics: What is Copyright Law?* COPYRIGHT BASICS, <https://www.copyright.com/Services/copyrighthoncampus/basics/law.html> ([\[http://perma.cc/ZH8W-5EBS\]](http://perma.cc/ZH8W-5EBS) (last visited Oct. 31, 2014)).

<sup>63</sup> *Oral Presentations and Speeches*, Copyright L. Rep. (CCH) ¶ 562 (2012).

<sup>64</sup> *Id.*

<sup>65</sup> *Copyright Basics: What is Copyright Law?*, *supra* note 62.

not necessary for the copyright owner to register the work with the U.S. Copyright Office.<sup>66</sup> If the owner places a copyright notice (©) on a published work with the year of publication and the owner's name, this will entitle the owner to certain benefits.<sup>67</sup> This visible notice will ideally prevent others from using the work and claiming that they did not know it was copyrighted.<sup>68</sup> However, the owner can also register the work with the U.S. Copyright Office anytime during the lifetime of the work,<sup>69</sup> the owner must register before he or she can file for infringement.<sup>70</sup> A valid copyright gives the owner the right to produce and sell copies of the work, create derivative copies of the work, display the work, and sell these rights to others.<sup>71</sup> This right lasts for the owner's lifetime plus seventy years.<sup>72</sup> During

---

<sup>66</sup> *Id.*

<sup>67</sup> RICHARD STIM, PATENT, COPYRIGHT & TRADEMARK: AN INTELLECTUAL PROPERTY DESK REFERENCE 172 (13th ed. 2014).

<sup>68</sup> *Id.*

<sup>69</sup> *Copyright Basics*, 7 (2012)), available at <http://www.copyright.gov/circs/circ01.pdf> lists [<http://perma.cc/2R3P-8RDD>] (listing other benefits of registration, such as (1) it establishes a public record of the copyright claim; (2) if registration is made within three months after publication of the work or prior to infringement of the work, statutory damages and attorney's fees will be available to the copyright owner; (3) registration is prima facie evidence of the validity of the copyright.).. Registration may be made any time after the creation of the copyrighted work. *Id.*

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

<sup>71</sup> 17 U.S.C. § 106 (2012). These rights depend on the category the original work falls into. *Id.*

<sup>72</sup> *Copyright Basics*, *supra* note 62, at 5. For works made for hire and for anonymous and pseudonymous works, the duration of the copyright is 95 years from publication or 120 years from creation, whichever is shorter. *Id.*

this period, if the owner determines that someone has violated the copyright, the owner can sue for infringement if he or she can prove “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”<sup>73</sup>

If the owner sues for infringement, the alleged infringer has many available defenses. The alleged infringer can prevail in an infringement action if the owner fails to establish the required elements of ownership and copying, or with an affirmative defense.<sup>74</sup> Available affirmative defenses include a license or assignment from the owner, joint ownership of the work, laches, or *res judicata*.<sup>75</sup> Should these defenses fail and the court find infringement, the owner can recover actual damages and possibly the infringer’s profits.<sup>76</sup> The owner may also choose to recover statutory damages in lieu of actual damages and profits.<sup>77</sup>

An important category of works of authorship that are entitled copyright protection is the “pictorial, graphic, and sculptural works” (PGS) one. This category includes “two-dimensional and three-dimensional works of [art]” such as photographs, globes, and diagrams.<sup>78</sup> Courts have applied this definition broadly, and examples of three-

---

<sup>73</sup> *Feist Publ’ns, Inc. v. Rural Tel. Srv. Co.*, 499 U.S. 340, 361 (1991).

<sup>74</sup> MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.04 (Matthew Bender ed. 2014).

<sup>75</sup> *Id.*

<sup>76</sup> 17 U.S.C. § 504(b) (2012). The owner can recover the infringer’s profits if such profits have not been “taken into account in computing the actual damages.” *Id.*

<sup>77</sup> 17 U.S.C. § 501(b) (2012). Furthermore, 17 U.S.C § 505 allows for attorney’s fees.

<sup>78</sup> 17 U.S.C § 101.

dimensional protected works include souvenir shot glasses,<sup>79</sup> toy airplanes,<sup>80</sup> and toy dolls.<sup>81</sup> These examples, as well as many other protectable works, contain functional aspects as well as artistic ones.<sup>82</sup> Although copyright law does not protect useful articles, or articles having an “intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,”<sup>83</sup> it does protect articles as PGS works if their design elements can be “identified separately from, and are capable of existing independently of” their utilitarian elements.<sup>84</sup> The House Report suggested that this separability might occur either “physically or conceptually.”<sup>85</sup> As a result, courts are split on how to apply separability.<sup>86</sup> Courts have protected many

---

<sup>79</sup> *Billco Int’l. Inc. v. Charles Prod., Inc.*, 776 F. Supp. 2d 105, 114–15 (Md. 2011).

<sup>80</sup> *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 972-73 (6th Cir. 1983).

<sup>81</sup> *JCW Inv., Inc. v. Novelty, Inc.*, 289 F. Supp. 2d 1023, 1027–28 (N.D. Ill. 2003).

<sup>82</sup> A well-known example of a protected work with both functional and artistic elements is a lamp base with a unique design. *See Mazer v. Stein*, 347 U.S. 201, 217 (1954).

<sup>83</sup> 17 U.S.C § 101.

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

<sup>85</sup> H.R. REP, *supra* note 59, at 5668.

<sup>86</sup> *Compare Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (holding that in determining whether or not decorative belt buckles qualified for copyright protection, the Court found that conceptual separation of the artistic features from the utilitarian features is sufficient and that actual separation is unnecessary) *with Esquire Inc. v. Ringer*, 591 F.2d 796, 804 (D.C. Cir. 1978) (holding that conceptual separability is not sufficient). Moreover, some courts determine separability by asking whether or not the designer was able to make aesthetic choices when coming up with the design that can be separated from his functional choices.

works with both functional and artistic aspects, such as furniture<sup>87</sup> and mannequins.<sup>88</sup>

Copyright law protects only the artistic aspects of useful articles, not the functional aspects. This protection of “applied art” extends to all original PGS works that are embodied in useful articles.<sup>89</sup> Essentially, “works of applied art are those pieces of art that perform a dual function: both expressing aestheticism as well as functioning as utilitarian objects to be used for some purpose.”<sup>90</sup> Therefore, copyright law can protect a PGS work “if the work is employed as the design of a useful article, and will afford protection to the copyright owner against unauthorized reproduction of his work in useful as well as non-useful articles.”<sup>91</sup>

Another important category of works of authorship is architectural works. A copyright for an architectural work covers “the design of a building as embodied in any tangible medium of expression, including a building, architectural

---

Brandir Int’l Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) (holding that if the design elements reflect a merger of both aesthetic and functional considerations, the artistic aspects of the work cannot be separable from the utilitarian elements).

<sup>87</sup> *Collezione Europa U.S.A. v. Hillsdale House, Ltd.*, 243 F. Supp. 2d 244, 447 (M.D.N.C. 2003).

<sup>88</sup> *Pivot Point Int’l, Inc. v. Charlene Prod. Inc.*, 372 F.3d 913, 915 (7th Cir. 2004).

<sup>89</sup> H.R. REP, *supra* note 59, at 54566754. To include applied art under its umbrella, the current Copyright Act adopted the holding in *Mazer v. Stein*, where the Supreme Court upheld the copyright of an ornamental lamp base. See *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

<sup>90</sup> J. Austin Broussard, *An Intellectual Property Food Fight: Why Copyright Law Should Embrace Culinary Innovation*, 10 VAND. J. ENT. & TECH. L. 691, 722 (2008).

<sup>91</sup> *Id.* at 5720.

plans, or drawings.”<sup>92</sup> An architectural work copyright protects merely the appearance, architectural plans, drawings, or photographs of a building.<sup>93</sup> Congress has made it clear that the term “architectural work” refers only to the design of a “building” and not any “three-dimensional structure.”<sup>94</sup> It is also clear that the building itself is a fixation of the design; one will still violate the copyright if he or she copies from the look of the actual building, rather than from the drawings.<sup>95</sup> Therefore, when an architectural work is embodied in the plans or drawings for a building, it is protected both as an architectural work and as a PGS work.<sup>96</sup>

## 2. Copyrights, Clearly Suitable for Cake Design

Cake design falls squarely under copyright protection, as it is an original work of authorship fixed in a tangible medium. First, a cake design possesses the

---

<sup>92</sup> 17 U.S.C. § 101 (2012).

<sup>93</sup> *Id.* However, there are limits on rights pertaining to photographs. The Architectural Works Copyright protection Act allows for taking and publishing photographs of a building if the building is located in or ordinarily visible from a public place. 17 U.S.C. § 120(a) (2012).

<sup>94</sup> H.R. REP NO. 101-735 at 6951 (1990) (noting “the term [building] encompass[es] habitable structures such as houses and office buildings. It also covers structures that are used, but not inhabited, by human beings, such as churches, pergolas, gazebos, and garden pavilions.”); *see also* Hunt v. Pasternack, 192 F.3d 877, 879 (9th Cir. 1999) (holding that copyright protected building design infringement); Home Design Services, Inc. v. Starwood Const., Inc., 801 F. Supp. 2d 1111 (Colo., 2011) (holding that copyright for drawings of houses was infringed); Oravec v. Sunny Isles Luxury Ventures L.C., 469 F. Supp. 2d 1148 (S.D. Fla. 2006) (holding that designs for condominiums did not infringe architectural design copyright).

<sup>95</sup> LAFRANCE, *supra* note 60, at 23.

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

minimum degree of creativity required by the Supreme Court in *Feist Publications*, as many cakes double as works of art and clearly show signs of originality and creativity.<sup>97</sup>

Second, cake design is a work of authorship. Cake design falls most easily under the PGS category, which would protect only the appearance of the cake design itself, not the recipe or process for making the cake.<sup>98</sup> More specifically, cake design would fall under PGS protection as applied art. Applying the applied art definition, courts have upheld many forms of art that double as useful articles. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the court determined that decorative belt buckles that were used principally for ornamentation could be copyrighted because the primary ornamental aspect of buckles was conceptually separate from their subsidiary utilitarian function.<sup>99</sup> Similar to decorative buckles, cakes, although they provide nourishment and are therefore functional, are primarily ornamental, and the conceptual separability of the two

---

<sup>97</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991); see also 37 C.F.R. § 202.10(a) (2014) (“in order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form.”).

<sup>98</sup> Food recipes are not easily copyrighted. See *Lambing v. Godiva Chocolatier*, 1998 U.S. App. LEXIS 1983, at \*4 (6th Cir. Feb. 6, 1998) (holding that the recipe for a chocolate truffle was a statement of facts with no expressive content and was therefore not copyrightable); *Harrell v. St. John*, 792 F. Supp. 2d 933, 943 (S.D. Miss. 2011) (holding that the recipes were not copyrightable because they were mere statements of facts). But see *Belford, Clark & Co. v. Scribner*, 144 U.S. 488, 490, 508 (1892) (holding that plaintiff's book of recipes could be copyrighted).

<sup>99</sup> *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980). The court noted that this issue was “on a razor’s edge of copyright law” but still concluded that the buckles were copyrightable. *Id.* at 990.

aspects makes cake design protectable as applied art.<sup>100</sup> In fact, the three-dimensional cake, or utilitarian aspect, is both physically and conceptually separate from the design aspect; the outer design of the cake can be physically removed from the cake itself, and the design can be “identified separately” from the cake.<sup>101</sup> Cake design could therefore receive copyright protection under both tests of separability.

Furthermore, in *Trafari, Krussman & Fishel, Inc. v. Charel Co.*, the court upheld the copyright of plaintiff’s costume jewelry, determining that costume jewelry, even if it is unattractive and functional, is no less art than a painting or a statue.<sup>102</sup> The court reasoned that as long as the work has some degree of individuality to show that the author has created an “original tangible expression of an idea rather than a merely pleasing form dictated solely by functional considerations,” copyright protection is available.<sup>103</sup> Similar to jewelry, many cake designs embody more than a slight degree of originality and have extra designs and additions that are in place to please the viewer, going beyond mere functional considerations.<sup>104</sup>

---

<sup>100</sup> See Broussard, *supra* note 90, at 727 (arguing that food dishes are works of applied art because they have expressive features that are separately identifiable from their utilitarian function of bodily nourishment).

<sup>101</sup> NIMMER, *supra* note 74, at § 2.08 (defining physical and conceptual separability).

<sup>102</sup> *Trafari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551, 553 (S.D.N.Y. 1955). The defendant in this case described the costume jewelry as “junk jewelry” and argued it should not be classified as art. *Id.* at 552.

<sup>103</sup> *Id.* at 553.

<sup>104</sup> See *e.g.*, Keeney, *supra* note 24 (describing that the cake for Catharine Zeta-Jones’s wedding was covered in thousands of sugar



Although a cake design does not fall under the category of “architectural work,” the type of protection this category provides is similar to the protection that would be ideal for cake designers. Cakes, like buildings, are the embodiment of a plan or design drawn up by an artist. Although it can be argued that buildings and cakes are both basic arrangements of elements and therefore do not meet the originality requirement of copyright protection, courts have resolved this concern by placing only “thin” copyrights on buildings, with nearly only identical copies infringing the original.<sup>105</sup> This thin copyright could apply to cake designs as well, protecting only identical copies but allowing cakes inspired by another’s design to flourish. Also similar to building designs, cakes have many essential and plain features, and although these features would not be protected, the cake as a whole would be.<sup>106</sup> Similar to cake design, “creativity in architecture frequently takes the form of a[n] . . . arrangement of unprotectable elements into an original, protectable whole.”<sup>107</sup>

Third, cake design is fixed in a tangible medium of expression. Some may argue that a cake design is not fixed because the cake is usually consumed after presentation.<sup>108</sup>

---

flowers). Sugar flowers are one example of an aesthetic and non-functional add-on that many cake designers use on their works of art.

<sup>105</sup> *Zalewski v. T.P. Builders, Inc.*, 875 F. Supp. 2d 135, 147–49 (N.D.N.Y. 2012).

<sup>106</sup> *Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC*, 827 F. Supp. 2d 607, 613617613 (E.D. Va. 2011) *vacated*, 496 Fed. Appx. 314 (4th Cir 2012) (holding that features that are essential or common to the style or structure of the building are unprotected).

<sup>107</sup> H.R. REP. NO. 101-735 at 6949 (1990).

<sup>108</sup> This was a critique by one court when a company attempted to copyright a food product. The court in *Kim Seng Co. v. J & A Importers, Inc.* 810 F. Supp. 2d 1046, 1054 (C.D. Cal. 2011) held that

However, the term “fixed” does not require permanence; the article simply must be able to be perceived or communicated for a period of more than transitory duration.<sup>109</sup> Copyright law requires no particular form of fixation; the work must simply be capable of being “retrieved.”<sup>110</sup> Should the chef draw out the cake design beforehand, this permanence would meet the legal requirement of fixation because the drawn-out design remains long after the cake has been consumed.<sup>111</sup> Furthermore, if the chef takes weeks to prepare the cake and then displays it for a period of time before it is eaten, the cake has existed for a short duration and arguably meets the

---

a bowl of food cannot be considered “fixed” for the purposes of 17 U.S.C § 101. Kim Seng claimed copyright protection for a bowl of food, arguing that the bowl of food constituted a fixed sculpture. *Id.* The court concluded that the food items could not be separated from their utilitarian function, which is to provide nourishment. *Id.* Additionally, the court concluded that because the food is perishable, it cannot be considered fixed. *Id.*

<sup>109</sup> 17 U.S.C. § 101 (2012). The 7th Circuit has held that an artistically arranged garden is not fixed for copyright purposes, reasoning that a living garden is not stable or permanent enough to be a work of fixed authorship. *Kelley v. Chi. Park Dist.*, 635 F.3d 290, 303 (7th Cir. 2011). Cake design is distinguishable from a garden, which is a living thing that is constantly changing and growing. A cake is immobile and is set in a fixed shape and design. It is true that if a cake spoils or rots, it will diminish and also change shape. However, the photographs and drawn out designs of the cake are permanent representations of the cake.

<sup>110</sup> NIMMER, *supra* note 74, at app. 15, ch. 1. For example, this treatise notes that a musical composition is copyrightable if it is written or recorded in words or in any visible notation. *Id.*

<sup>111</sup> This fixation is similar to that of architectural designs, which are two-dimensional designs embodied in three-dimensional objects. Buildings, like cakes, do not last forever either. For example, if the building were to be hit with a wrecking ball a day after it is created, the building would still be considered “fixed,”<sup>”</sup> and the design itself would be a permanent representation of the destroyed building.

statutory requirement, especially considering the fact that the fixation requirement is read broadly.<sup>112</sup>

Critics have argued that using intellectual property protection for cakes is unnecessary because in the chef culture, copying another's designs is very common and chefs may simply be accustomed to the practice.<sup>113</sup> However, if chefs want to prevent others from benefitting from their hard work, they should be encouraged to attach the copyright symbol to the pictures of their cakes they place on their websites. This act may deter consumers from printing these pictures and asking a local baker to copy someone else's work.<sup>114</sup> This deterrence provides meaningful protection to a cake design.<sup>115</sup> Although a copyright might not have the

---

<sup>112</sup> *Kelley*, 635 F.3d at 304.

<sup>113</sup> See Pete Wells, *New Era of the Recipe Burglar*, FOOD & WINE (Nov. 2006), available at <http://www.foodandwine.com/articles/new-era-of-the-recipe-burglar> [<http://perma.cc/BJ6B-FJXU>] (“Chefs have traditionally worked on an open-source model, freely borrowing and expanding on each other’s ideas and, yes, sometimes even stealing them outright.”).

<sup>114</sup> See Jessica Harris, CAKE BLOG, <http://jessicaharriscakedesign.com/> [<http://perma.cc/83MQ-6YHY>] (last visited Jan. 16, 2015) (demonstrating a blogger who has placed this copyright notice on her page: “Copyright © 2010-2015 Jessica Harris. All content on this blog, including text, original photos, templates and ideas, are the sole property of the author. If you intend to use any of the text, templates or images within, it must be linked back to this site with credit given to [www.jessicaharriscakedesign.com](http://www.jessicaharriscakedesign.com) and/or Jessica Harris Cake Design. No methods, designs, images, templates, text or other content from this site can be copied or used for profit in any form without proper approval and a licensing agreement is reached.”)

<sup>115</sup> Michele Herman, *The Protection of Computer Databases Through Copyright*, 65 PA. B.A. Q. 35, 36 (1994) (“[A]n obvious display of a copyright notice may deter potential infringers from copying any part of the database, or at a minimum, deter them from appropriating any

same deterrence effect that a patent does, the notice of copyright coupled with a cease and desist letter to the copier is likely to decrease copying.<sup>116</sup> In the end, if a chef or company determines that their cake designs are worth the protection, it would be beneficial for them to utilize copyright protection.<sup>117</sup>

Critics may also argue that a copyright may provide too much protection. However, it is important to note the limits of copyright law and how they will be applied to cake design. Copyrights only protect original expression of ideas, not the ideas themselves.<sup>118</sup> Therefore, the idea of designing cakes in general will not be protected, but the expression of the design, as depicted by the unique cake itself, is

---

more than the bare factual data.”). This same argument of deterrence can be made about using a copyright notice on one’s cake designs.

<sup>116</sup> See Cecilia Ogbu, *I Put up a Website About my Favorite Show and All I Got was This Lousy Cease-And-Desist Letter: The Intersection of Fan Sites, Internet Culture, and Copyright Owners*, 12 S. CAL. INTERDISC. L.J. 279, 285 (2003) (noting that cease-and-desist letters are common and effective ways to inform infringers about their use of copyright-protected materials in an unauthorized yet coercive manner).

<sup>117</sup> But see Sarah Ockler, *Home*, ORIGINAL CAKE LADY, <https://originalcakelady.wordpress.com/> [<https://perma.cc/DJU9-PUU2>] (last visited Sept. 22, 2014) (suggesting that a baker who hopes her viewers can “find inspiration among the photos of the many cakes [she has] done over the years,” indicates she would not copyright her designs). *Contra* Keeney, *supra* note 24 (listing cakes worth up to millions of dollars that seemingly would be worth the copyright protection); Pam, Comment to *Copying or Stealing?*, CAKE FU (May 31, 2012, 2:10 PM), <http://www.cakefu.com/copying-or-stealing/> [<http://perma.cc/6G9N-4QUS>] (baker who thinks that using another’s designs is “stealing” and would be upset if another baker used her design).

<sup>118</sup> 17 U.S.C. § 102(b) (2012); *see also* Baker v. Selden, 101 U.S. 99, 103 (1879) (explaining the idea-expression dichotomy).

protected.<sup>119</sup> Cake design is an expression of a chef's creative idea and is therefore protectable under copyright law.

**B. Trademark and Trade Dress to Protect  
Cake Design**

Trademark law protects the name or symbol used to identify a company's goods or products.<sup>120</sup> Trade dress

---

<sup>119</sup> See *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992) (upholding the copyright for a photograph of puppies, holding that “[i]t is not therefore the idea of a couple with eight small puppies seated on a bench that is protected, but rather Roger’s *expression* of this idea—as caught in the placement, in the particular light, and in the expressions of the subjects—that gives the photograph its charming and unique character, that is to say, makes it original and copyrightable.”).

<sup>120</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.1 (4th ed. 2006). Both federal and state law protects trademarks. This Comment will focus on trademarks under federal law. Trademarks are distinguishable from trade names. Under 15 U.S.C. § 1127, trade names, another subset of trademark law, are a name used by a person to identify his business or vocation and distinguish it from the businesses of others. A cake design company could protect the name of its company, such as in *Faciane v. Starner*, where a restaurant owner gained trade name protection for his restaurant “White Kitchen.” 15 U.S.C. § 1127 (2012); *Faciane v. Starner*, 129 F. Supp. 430, 432 (N.D. Fla. 1955); see also *Peters v. Machikas*, 105 A.2d 708, 711 (Pa. 1954) (plaintiff had a trade name for his restaurant ‘Majestic Restaurant’ The court held that the ‘Majestic Grille’ was likely to confuse the public and therefore infringed the trade name). A bakery could also attach a trade name to the name of a dish or cake, as long as the name was unique and not basic. See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 116-17 (1938) (holding that Kellogg could not acquire a trade name for “Shredded Wheat” when the name was represented by a dish with pillow-shaped biscuits in it.) The court reasoned that the term ‘Shredded What’Wheat’What’ is generic. *Id.* Kellogg does not have the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit. *Id.*

protects a product’s overall appearance.<sup>121</sup> A design can be a protectable trademark and cake designs can be trademarks if they meet the trademark requirements and sufficiently identify the company that makes them.<sup>122</sup>

### 1. Background on Trademark and Trade Dress Law

A trademark is “any name, symbol, device, or any combination thereof” used to identify and distinguish the goods of one company from the goods of others.<sup>123</sup> Trademarks serve four purposes: to identify a seller’s goods and distinguish them from goods sold by others, to signify that all goods bearing the trademark come from one source, to signify that all goods bearing the trademark are on an equal level of quality, and as an instrument in advertising and selling the goods.<sup>124</sup> Trademarks exist so a company can place a distinct mark on its goods, allowing customers to recognize that mark and purchase the product based on the company’s name or reputation.<sup>125</sup> Trademarks therefore

---

<sup>121</sup> 1 MCCARTHY, *supra* note 120, at § 8:1.

<sup>122</sup> *See infra* Part III.B.2.

<sup>123</sup> 15 U.S.C. § 1127 (2012). Similarly, a service mark identifies the source of services. *Id.* Generally, the same rules apply to both. *Id.* This Comment discusses using cake designs as trademarks.

<sup>124</sup> 1 MCCARTHY, *supra* note 120, at § 3:2.

<sup>125</sup> 74 Am. Jur. 2d, Trademarks and Tradenames § 1. Trademarks most commonly protect brand names and logos used on goods and services. *Id.* Trademarks are used to prevent a business from trading off another business’s goodwill, or the factor by which consumers associate certain standards with a company. *Id.* Studies have shown that the human brain may have something called a “buy button.” *See* Sandra Blakeslee, *If Your Brain Has a “Buy Button,” What Pushes It?*, N.Y. TIMES (Oct. 19, 2004), 19, 2004), <http://www.nytimes.com/2004/10/19/science/19neuro.html> [<http://perma.cc/A96N-JDA4>]. . Companies use brand recognition and loyalty to stimulate this button. *Id.* Therefore, even if a person

answer the question “Who made it?” rather than “What is it?”<sup>126</sup> Unlike under patent and copyright law, “neither originality, invention, discovery, science, nor art is in any way essential” to the creation of trademark rights.<sup>127</sup> A mark may be “plain, simple, old, or well-known” and can still be protected under trademark law if the mark identifies and distinguishes the goods.<sup>128</sup>

Trade dress, a particular type of trademark, is the overall appearance of a product or the totality of the product’s elements.<sup>129</sup> Companies use trade dress to protect the visual image the product presents to customers.<sup>130</sup> Trade dress can be the design of the product or its packaging and can include “features such as size, shape, color, or color

---

likes a product based on sense alone (i.e. taste, feel, or look), the “buy button” in their brain might override this, and they will state that they actually prefer the brand they are loyal to. *Id.*

<sup>126</sup> *Clairol Inc. v. Gillette Co.*, 389 F.2d 264, 269 (2d Cir. 1968); 1 MCCARTHY, *supra* note 120, at § 3:6.

<sup>127</sup> *In Re Trademark Cases*, 100 U.S. 82, 94 (1879). In fact, the delivery service UPS holds a trademark for the color brown, something clearly non-unique or creative, yet still protectable by trademark if it has acquired secondary meaning. See Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 778 (2005). This article also lists other nontraditional trademarks, such as the scent of exhaust fumes and the sound of a duck quacking ‘AFLAC’. *Id.* at 797, 803.

<sup>128</sup> *In re Trademark Cases*, 100 U.S. at 94. For example, the term “Apple” could not be copyrighted because it is a short, uncreative word. However, “Apple” is a protectable trademark.

<sup>129</sup> 1 MCCARTHY, *supra* note 120, at § 8:1. Trade dress is “the design and appearance of a product together with the elements making up the overall image that serves to identify the product presented to the consumer.” *Chrysler Corp. v. Silva*, 118 F.3d 56, 58 (1st Cir. 1997).

<sup>130</sup> 1 MCCARTHY, *supra* note 120, at § 8:1.

combinations, texture, [or] graphics.”<sup>131</sup> Similar to trademark, trade dress must be used to denote the product’s source.<sup>132</sup> Examples of trade dress include the design of the Apple iPhone,<sup>133</sup> the design of a line of cookware,<sup>134</sup> the appearance of a Mexican-style restaurant,<sup>135</sup> and the design of a line of children’s clothing.<sup>136</sup> In certain situations, trade dress requires a showing of secondary meaning. Secondary meaning has developed “when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.”<sup>137</sup> Trade dress that is inherently distinctive is protectable without a showing that it has acquired secondary meaning,<sup>138</sup> but product

---

<sup>131</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).

<sup>132</sup> *See Fabrication Enters. v. Hygenic Corp.*, 64 F.3d 53, 57 (2d Cir. 1995) (“[T]o earn protection under the Lanham Act, a manufacturer must show that its trade dress is capable of distinguishing the owner’s goods from the competitor’s and identifying the source of the goods.”).

<sup>133</sup> *See Apple, Inc. v. Samsung Elec. Co.*, 920 F. Supp. 2d 1079, 1095 (N.D. Cal. 2013).

<sup>134</sup> *See Belk, Inc. v. Meyer Corp.*, U.S., 679 F.3d 146, 150–51 (4th Cir. 2012).

<sup>135</sup> *See Two Pesos, Inc.*, 505 U.S. 763, 775-76.

<sup>136</sup> *See Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 216 (2000).

<sup>137</sup> *Id.* at 211. The factors applied in determining whether a mark has acquired secondary meaning include: “(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant’s intent in copying the trade dress.” *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998).

<sup>138</sup> *Two Pesos, Inc.*, 505 U.S. at 763771763. The court determined that this holding was logical because such trade dress, i.e. one that is inherently distinctive, is capable of identifying products or services as



design trade dress can never be inherently distinctive and the product owner must therefore always prove that the design has acquired secondary meaning.<sup>139</sup> Trade dress and trademark are protected under similar rules under the Lanham Act.<sup>140</sup>

Trademarks and trade dress are established through priority<sup>141</sup> and must pass certain requirements in order to be protected. First, the mark must be distinctive, meaning it must have the “tendency to identify the goods sold as emanating from a particular, though possibly anonymous,

---

coming from a specific source, and therefore, no secondary meaning is required. *Id.* The court reasoned that imposing a secondary meaning requirement would be overly burdensome; such a requirement would make it difficult for the producer to identify itself with its products. *Id.* at 774. Furthermore, the requirement would lead to anticompetitive effects due to the high burdens it would place on small startup businesses. *Id.*

<sup>139</sup> *Wal-Mart Stores Inc.*, 529 U.S. at 206.

<sup>140</sup> *Two Pesos*, 505 U.S. at 771776771 (Stevens, J., concurring) (interpreting “this section [§ 43(a)] as having created a federal cause of action for infringement of unregistered trademark or trade dress and concludes that such a mark or trade dress should receive essentially the same protection as those that are registered.”).

<sup>141</sup> The right to use of a trademark is founded on priority of use; “the first to use a mark on a product or service in a particular geographic market...acquires rights in the mark in that market.” *Tally-Ho Inc. v. Coast Cmty. Coll. Dist.*, 889 F.2d 1018, 1023 (11th Cir. 1989).

source.”<sup>142</sup> Second, the mark must be nonfunctional.<sup>143</sup> Third, the mark must be used in commerce.<sup>144</sup> Trademarks have potentially infinite duration if they are maintained through use and continue to distinguish the owner’s goods from those of another.<sup>145</sup>

---

<sup>142</sup> *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979). The law recognizes two types of distinctive marks: “inherently” distinctive marks and marks that have acquired distinctiveness. 1 MCCARTHY, *supra* note 120, at § 11:2. An inherently distinctive mark is likely to be perceived as distinguishing or identifying goods due to the nature of the mark or the context of its use. *Id.*; see, e.g., *In re Chippendales USA, Inc.*, 90 U.S.P.Q. 2d 1535, \*1 (T.T.A.B. 2009) (determining that the “Cuffs & Collar” design mark used by Chippendale’s male dancers is not inherently distinctive). A mark that has acquired distinctiveness has been perceived as distinguishing or identifying goods as a result of its use in the marketplace. 1 MCCARTHY, *supra* note 120, at § 11:2.

<sup>143</sup> 15 U.S.C. § 1052(e)(5) (2012) (prohibiting registration of a mark that “comprises any matter that, as a whole, is functional”). *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) lays out the test for functionality. Product trade dress is functional “when it is essential to the use or purpose of the device or when it affects the cost or quality of the device.” *Id.* This prevents trademark law from limiting legitimate competition by allowing the producer to control the product’s useful features. *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 164 (1995). A similar test is used to determine if a design is aesthetically functional: “A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995).

<sup>144</sup> 3 MCCARTHY, *supra* note 120, at § 17:9. “Use in commerce” to establish priority requires a bona fide commercial transaction followed by activities proving a continuous intent to use the mark. *Avakoff v. S. Pac. Co.*, 765 F.2d 1097, 1098 (Fed. Cir. 1985).

<sup>145</sup> 3 MCCARTHY, *supra* note 120, at § 17:9. A mark is deemed abandoned if it is no longer put to use and there is an intention not to resume use. 15 U.S.C. § 1127 (2012); 3 MCCARTHY, *supra* note 120, at § 17:5.

Trademark protection gives the owner the right to use the mark to identify and distinguish specific goods, but only in the markets in which the owner uses the mark.<sup>146</sup> Infringement occurs if another company uses a similar mark that invades this protected area.<sup>147</sup> The test for infringement is whether use of a mark is likely to cause confusion or deception with another mark.<sup>148</sup> If sued for infringement, the alleged infringer has many defenses available, such as estoppel by laches,<sup>149</sup> unclean hands,<sup>150</sup> and no likelihood of confusion.<sup>151</sup> Should these defenses fail, the trademark owner can receive an injunctive relief and damages.<sup>152</sup>

## 2. Characteristic Cake Designs as Trademarks

Although no cake designer is currently known for trademarking the design or overall shape of his cake, trademark law can provide protection for cake designs and should be utilized. Trademarks have been used to protect popular and distinctive food products, and cake designs

---

<sup>146</sup> 4 MCCARTHY, *supra* note 120, at § 24:6; 5 MCCARTHY, *supra* note 120, at § 26.2.

<sup>147</sup> 4 MCCARTHY, *supra* note 120, at § 23.1.

<sup>148</sup> *Id.*

<sup>149</sup> This defense is available when there has been a delay in filing suit that caused prejudice to the defendant. 6 MCCARTHY, *supra* note 120, at § 31.2.

<sup>150</sup> This defense is available when the plaintiff's improper conduct with respect to the controversy outweighs the defendant's illegal conduct. *Id.* at § 31.46.

<sup>151</sup> For example, if the defendant argues that his mark is a parody, there is no likelihood of confusion because the consumer will not be deceived. *Id.* at § 31.153.

<sup>152</sup> 15 U.S.C. § 1114 (2012). However, in order to recover damages, the trademark registrant must give notice of his registration. 3 MCCARTHY, *supra* note 120, at § 19.144.

should be no different. The unique shape of the KitKat bar as well as the plume-shaped Hershey’s Kiss candy and the three-dimensional shape of Peeps candy are all registered trademarks.<sup>153</sup> Companies such as Hershey secure these trademarks because they know that the shape of their product provides brand recognition, thus improving the company’s image and boosting sales. Hershey spokesman Jeff Beckman noted, “The ‘Kisses’ trademark is one of Hershey’s most iconic brands and most important assets, recognized by consumers around the world.”<sup>154</sup> Hershey has

---

<sup>153</sup> *Top 5: Food Shape Trademarks & Patents*, ARTICLE ONE PARTNERS (Jan. 4, 2013), <http://info.articleonepartners.com/top-5-food-shape-trademarks-patents/> [<http://perma.cc/9CF8-TU3L>].

<sup>154</sup> Scott Flaherty, *Judge Melts Hershey Suit Over Rival’s ‘Swisskiss’ Chocolate*, LAW360 (Jan. 23, 2013, 3:42 PM), <http://www.law360.com/articles/409378/judge-melts-hershey-suit-over-rival-s-swisskiss-chocolate> [<http://perma.cc/PN4E-LNFZ>]. [www.law360.com/articles/409378/judge-melts-hershey-suit-over-rival-s-swisskiss-chocolate](http://www.law360.com/articles/409378/judge-melts-hershey-suit-over-rival-s-swisskiss-chocolate). In the case that this article discusses, the New Jersey district court determined that the Swissmiss chocolates did not infringe the Hershey trademark. *Id.* Swissmiss stated that it was merely trying to develop its own product with its own distinct mark, and Judge Wingenton agreed. *Id.* It is rumored that the Hershey’s Kiss is called a “Kiss” because of the sound it makes when it plops onto the conveyer belt. See Sarah Kawash, *Hershey’s: Why a Kiss is Just a Kiss*, CANDY PROFESSOR (March 3, 2010, 8:32 AM), <http://candyprofessor.com/2010/03/03/hersheys-why-a-kiss-is-just-a-kiss/> [<http://perma.cc/LE22-P534>]. [candyprofessor.com/2010/03/03/hersheys-why-a-kiss-is-just-a-kiss/](http://candyprofessor.com/2010/03/03/hersheys-why-a-kiss-is-just-a-kiss/). However, according to this scholar, this rumor is false. *Id.* When Hershey came up with its Kisses in 1907, a “candy kiss” at that time was another name for a small bite-sized candy. *Id.* It seemed obvious that Hershey should call its candy “Kisses.” *Id.* This name was a stark contrast to the “chocolate buds,” a H. O. Wilbur and Sons product that was dominating the chocolate candy world at the time. *Id.*

successfully associated that shape with its company name.<sup>155</sup> Similarly, should a chef want to associate a shape of a cake with his name, he should be able to do so through trademark law.

Trademarks are names or symbols affixed to the product used for the purpose of signifying the company who created the product.<sup>156</sup> However, designs of articles can be protected by trade dress as long as they acquire secondary meaning.<sup>157</sup> Although cakes are not commonly registered as trademarks, this does not mean that chefs cannot use trademark protection for their designs.

First, the cake design itself must be used as a mark, meaning it must be used to identify its source. To determine if this has been achieved, courts would ask how the relevant

---

<sup>155</sup> Hershey actively protects its trademark, even today. Sadie Gurman, *Hershey sues Colorado edible pot company*, DENVER POST (June 6, 2014), [http://www.denverpost.com/marijuana/ci\\_25915303/hershey-sues-colorado-edible-pot-company](http://www.denverpost.com/marijuana/ci_25915303/hershey-sues-colorado-edible-pot-company) [<http://perma.cc/293R-PS9U>]. In June 2014, Hershey Company sued TinctureBelle, a Colorado marijuana edibles company, claiming the company was infringing its trademark and packaging its edibles in a way that would confuse the customers. *Id.* Hershey noted that this was especially dangerous for children because they could confuse Hershey candy with marijuana-infused candy. *Id.* TinctureBelle settled in September 2014. *Id.*

<sup>156</sup> 15 U.S.C. § 1127 (2012). A different definition applies to service marks. *See Id.*

<sup>157</sup> *See Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 869 (2d Cir. 1986) (upholding trademark for stitching pattern on jean pocket); *Jules Jurgensen/Rhapsody, Inc. v. Rolex Watch U.S.A., Inc.*, 716 F. Supp. 195, 200-01 (E.D. Pa. 1989) (upholding trademark of Rolex watch design); *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1342 (C.C.P.A. 1982) (holding that the container configuration for a spray starch was nonfunctional and could be registered. Although a spray bottle was functional, evidence demonstrated that the bottle was no more useful shaped as it was than if it had been shaped in a variety of other ways).

public would perceive the design.<sup>158</sup> The public must recognize the design as an indication of origin for the specific company. Second, the designer must have priority on his design. To do this, the designer must be the first to use the design in the sale of goods.<sup>159</sup>

Third, the cake design must be distinctive. This can be done through acquisition of secondary meaning, meaning the design must denote the source of the product.<sup>160</sup> This may be a difficult hurdle to overcome, as cake designers do not usually use a signature design to signify the source of their cakes. Unlike companies such as Christian Louboutin, known for its signature red-soled shoes,<sup>161</sup> and FIJI Water, known for its square-shaped plastic bottles,<sup>162</sup> no cake design company has a distinctive cake design that always identifies its product. In fact, the general point of cake design is to make a unique product for every occasion, not use the same cake design for every customer. For example,

---

<sup>158</sup> *In re Eagle Crest, Inc.*, 2010 WL 3441109, \*2 (2010).

<sup>159</sup> *Tally-Ho Inc.*, 889 F.2d at 1023.

<sup>160</sup> *Wal-Mart Stores Inc.*, 529 U.S. at 212.

<sup>161</sup> *See Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 225227225 (2d Cir. 2012) (holding that Louboutin can enforce its trademark of red-lacquered soled shoes, but Yves St. Laurent did not infringe that trademark when he created an entirely red shoe design). The red-soled shoe was a trademark because it had acquired a secondary meaning and sufficiently identified the Louboutin brand. *Id.*

<sup>162</sup> *See Fiji Water Co., LLC, v. Fiji Mineral Water USA, LLC*, 741 F. Supp. 2d 1165, 1172 (C.D. Cal. 2010). In this case, Fiji Water sued a company called Viti, who was also selling artisan water in a rounded plastic bottle with squared shoulders and a similar label. *Id.* at 1171. The court held that the Fiji Water trade dress was non-functional and had secondary meaning. *Id.* at 1172. Furthermore, it was likely the public would be confused between the trade dress of the plaintiff's bottle design and that of the competitor's. *Id.*

Chef Christine D'Angeli states that her goal is to make each cake special for every customer<sup>163</sup> and chef Chantal Carter similarly strives to create something unique for each client.<sup>164</sup> These chefs' goals of creativity would be diminished if they used a distinctive, set cake design for each of their creations.

However, it is possible for cake designs to acquire secondary meaning and be distinct enough to denote the cake's source. An example of a cake that has a unique look and could be recognized as being the product of a certain company is the unique tiered wedding cake that went viral on the Internet in April 2014.<sup>165</sup> This cake's unique design, as well as the way it tells a touching love story, would be a trademark had its designer, Clairella Cakes, acquired secondary meaning. Soon after its debut, this cake received a sequel; an unknown designer created an anniversary cake that matched the style of the wedding cake.<sup>166</sup> If Clairella

---

<sup>163</sup> Mary Beth Adomaitis, *Interview with Pastry Chef Chris D'Angeli*, LOVEtOKNOW, [http://cake-decorating.lovetoknow.com/Interview\\_with\\_Pastry\\_Chef\\_Chris\\_D'Angeli](http://cake-decorating.lovetoknow.com/Interview_with_Pastry_Chef_Chris_D'Angeli) [<http://perma.cc/NWB2-972U>] (last visited Sept. 26, 2014). D'Angeli also notes that she loves participating in each client's event and connecting with the each person to make their memory even more special. *Id.*

<sup>164</sup> Cindy Bureson, *Wedding Cakes, an Interview with a Pastry Chef*, PALM SPRINGS WEDDINGS (May 9, 2014), <http://www.weddingspalm Springs.com/wedding-cakes-an-interview-with-a-pastry-chef/> [<http://perma.cc/W74V-SL2W>].

<sup>165</sup> Lauren Zupkus, *The Internet Is Truly Baffled By This Wedding Cake*, HUFFINGTON POST (April 14, 2014, 5:49 PM), [http://www.huffingtonpost.com/2014/04/14/wedding-cake-reddit\\_n\\_5148145.html](http://www.huffingtonpost.com/2014/04/14/wedding-cake-reddit_n_5148145.html) [<http://perma.cc/8H5V-3ZNP>]. [http://www.huffingtonpost.com/2014/04/14/wedding-cake-reddit\\_n\\_5148145.html](http://www.huffingtonpost.com/2014/04/14/wedding-cake-reddit_n_5148145.html).

<sup>166</sup> Taryn Hillin, *The Most Baffling Wedding Cake Ever Just Got A Beautiful Sequel*, HUFFINGTON POST (May 2, 2014, 2:50 PM),

Cakes had registered a trademark for its original cake after a period of producing similar and recognizable cakes, the anniversary cake would have infringed this trademark, as the designs were confusingly similar. Furthermore, tilted or topsy-turvy wedding cakes are another example of cake designs that could receive trademark protection. These distinct designs are a unique way of elaborating a simple cake design and have a recognizable look.<sup>167</sup> If a company were to continually use a unique tilted cake design, this design could become the company's signature design over time and the company could then trademark it.<sup>168</sup>

Fourth, the cake design must be neither utilitarian nor aesthetically functional. To determine functionality, some courts apply the "works better" test, which states, "a design feature is functional if the article works better because it is in this particular shape."<sup>169</sup> A cake does not necessarily work better simply because it is in the shape of a circle or a square. The ornamental designs applied to the cake, such as

---

[http://www.huffingtonpost.com/2014/05/02/wedding-cake\\_n\\_5255049.html](http://www.huffingtonpost.com/2014/05/02/wedding-cake_n_5255049.html) [<http://perma.cc/BH4L-SQC9>].[http://www.huffingtonpost.com/2014/05/02/wedding-cake\\_n\\_5255049.html](http://www.huffingtonpost.com/2014/05/02/wedding-cake_n_5255049.html).

<sup>167</sup> *Topsy Turvy Cakes, Wedding cakes & Fun Cake Designs*, PERFECT WEDDING DAY, <http://www.perfect-wedding-day.com/topsy-turvy-cakes.html> [<http://perma.cc/9LGD-MNV3>] (last visited Oct. 1, 2014).

<sup>168</sup> See ARTISAN BAKE SHOP, [http://www.artisanbakeshop.com/cakes\\_wonky\\_1.htm](http://www.artisanbakeshop.com/cakes_wonky_1.htm) [<http://perma.cc/9JJY-S662>] (last visited Nov. 2, 2014) (showing an example of a bakery that has created a large number of topsy turvy cakes).

<sup>169</sup> *In re R. M. Smith, Inc.*, 734 F.2d 1482, 1484 (Fed. Cir. 1984). This test has also been approved in *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 1025 (Fed. Cir. 1985) and *Tie Tech, Inc. v. Kinedyne Corporation*, 296 F.3d 778, 785 (9th Cir. 2002).



the frosting flowers, could be attached to a cake of a different shape and be just as well suited. Although it is arguable that if the cake were not a solid shape, the cake would not stand, this argument is not sound. In *Application of Minnesota Mining & Manufacturing Company*, the court held that even though the shape of a chemical cake was a solid triangle, the design was not functional.<sup>170</sup> The court reasoned that the chemical cake, “except for its solidity (all shapes being solid), has no functional significance whatsoever.”<sup>171</sup> Similarly, the design of the cake has no utilitarian functionality.

The design of the cake also cannot be aesthetically functional. A design is aesthetically functional only “if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.”<sup>172</sup> The aesthetic value of a cake design does not give any benefit that would be removed should the designer use an alternate design. Cake designs are therefore not functional. Finally, the designer must put the design to use in commerce. The designer can do this by selling his cakes in a bakery or online.

Critics have argued that if all food designs are protected, there will be nothing left for the competition. For example, in 2009, The Hershey Company sent a stern cease and desist letter to chocolatier Jacques Torres, arguing that Torres’s candy “Champagne Kisses” infringed the Hershey’s kiss trademark.<sup>173</sup> Torres’s attorney replied that

---

<sup>170</sup> *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 840 (C.C.P.A. 1964).

<sup>171</sup> *Id.*

<sup>172</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995).

<sup>173</sup> Daniel Maurer, *Hershey’s v. Jacques Torres: The Lawyer-to-Lawyer Slapdown!*, GRUB STREET (April 22, 2009, 6:21 PM),

Torres’s chocolate design was completely different, arguing that this was “yet another example of a giant, monolithic corporation attempting to take advantage of the little guy.”<sup>174</sup> Despite this concern of trademark monopoly, distinctive cake designs deserve trademark protection; to deny the designers protection simply because of this fear would be unfair. Cake designs, like many food designs, are protectable as trademarks.

### ***C. Trade Secret Law to Protect Cake Design***

Trade secret law protects private information that a company does not want available to the public.<sup>175</sup> This information can include ideas, such as the idea of a cake design that has not been disclosed, methods, such as the method behind creating a cake design, and recipes.<sup>176</sup>

#### **1. Background on Trade Secret Law**

Trade secrets protect confidential business information and can therefore be used to protect cake designs if they are not shared with the public. State laws protect trade secrets, but most states have adopted some form

---

[http://www.grubstreet.com/2009/04/hersheys\\_vs\\_jacques\\_torres\\_the.html](http://www.grubstreet.com/2009/04/hersheys_vs_jacques_torres_the.html) [<http://perma.cc/9EKW-58XW>].

<sup>174</sup> *Id.* This is logical because the Torres Kiss is nothing like the Hershey’s Kiss. *Id.* The Torres Kiss is a square-shaped chocolate with a champagne center. *Id.* It is called a kiss because it has a red lipstick kiss mark on top of the square. *Id.* After this scandal, Torres went on a grassroots campaign, giving out free samples and telling its customers to “Save Jacques Kiss” because “[a]“ powerful company should not rule the world.” Erin Zimmer, *The Jacques Torres vs. Hershey’s Kisses Scandal*, *SERIOUS EATS* (Apr. 29, 2009, 2:45PM), <http://newyork.serious eats.com/2009/04/jacques-torres-vs-hersheys-kisses-scandal.html> [<http://perma.cc/87TJ-USF7>].

<sup>175</sup> ROGER M. MILGRIM & ERIC E. BENSON, *MILGRIM ON TRADE SECRETS* § 1.01 (Matthew Bender ed. 2014).

<sup>176</sup> *See infra* Part III.C.2.

of the Uniform Trade Secrets Act.<sup>177</sup> This Act defines trade secret broadly; almost anything that has competitive value can be classified as a trade secret as long as it derives independent economic value from not being known or readily accessible to those who would obtain economic value from its use and is the subject of reasonable efforts to maintain its secrecy.<sup>178</sup> Trade secrets do not necessarily protect only ideas; a trade secret may be a fact or information tending to communicate or disclose the idea or fact to another.<sup>179</sup> Courts have therefore held that trade secrets do not have to be tangible.<sup>180</sup>

Trade secrets can last forever if they are properly maintained and protected. Trade secret owners can prevent others from copying, using, or benefitting from their trade secrets. Those who know the trade secret cannot disclose it if they are bound to a duty of confidentiality,<sup>181</sup> acquire the trade secret through theft, or learn about the secret by accident.<sup>182</sup> Should someone unlawfully obtain another's

---

<sup>177</sup> MILGRIM & BENSEN, *supra* note 175.

<sup>178</sup> *Id.*

<sup>179</sup> *See* *Silvaco Data Sys. v. Intel Corp.*, 109 Cal. Rptr. 3d 27, 38 (Cal. Ct. App. 2010) (holding that a trade secret can be a customer's preferences or the location of a mineral deposit).

<sup>180</sup> *See* *Bridgestone/Firestone Inc. v. Lockhart*, 5 F. Supp. 2d 667, 681 (S.D. Ind. 1998) (holding that customer and business planning information is protectable by trade secret law even though the information did not exist in tangible form, but was instead only in the mind of the business owner).

<sup>181</sup> An example of someone bound by a legal duty of confidentiality is someone who signs a nondisclosure agreement. MILGRIM, *supra* note 175, at § 4.01.

<sup>182</sup> *Trade Secret Basics FAQ*, NOLO, <http://www.nolo.com/legal-encyclopedia/trade-secret-basics-faq-29099-3.html> [<http://perma.cc/AC3K-TFVS>] (last visited Dec. 15, 2014).

trade secret, the owner can ask for an injunction preventing future disclosure or use of the secret.<sup>183</sup> However, the potential infringer can argue independent development; people can use or disclose another's trade secrets if they discover the secret independently using legal means.<sup>184</sup> Trade secret law is applicable to cake designs.

## 2. **Cake Designs, Methods, and Recipes as Trade Secrets**

Cake designs themselves could not be trade secrets once they are disclosed to the public. However, designers commonly seek trade secret protection for their designs before disclosure. For example, in *Learning Curve Toys, Inc. v. PlayWood Toys, Inc.*, the court held that the prototype design of an innovative toy train track was a protectable trade secret.<sup>185</sup> The court reasoned that the design was a trade secret after analyzing all six of the Restatement factors.<sup>186</sup> The court did not dwell on the fact that the secret was merely a toy design, but instead stated that toy designers

---

<sup>183</sup> MILGRIM, *supra* note 175, at § 1.01. Damages are also available, depending on the nature of the secret. *Id.*

<sup>184</sup> *Trade Secret Basics FAQ*, *supra* note 182. An example of this is if the trade secret owner failed to take the necessary steps to preserve its secrecy and the secret was disclosed. *Id.*

<sup>185</sup> *Learning Curve Toys, Inc. v. PlayWood Toys, Inc.*, 342 F.3d 714, 716 (7th Cir. 2003).

<sup>186</sup> *Id.* at 722. The Restatement (First) of Torts § 757 lists the six factors that should be considered in determining whether something is a trade secret. *Id.* These factors are: 1. The extent to which the information is known outside of the business; 2. The extent to which the information is known by employees and others inside the business; 3. The extent of measures taken to guard the secrecy of the information; 4. The value of the information to the business and competitors; 5. The amount of effort or money expended in developing the information; and 6. The ease or difficulty with which the information could be properly acquired or duplicated by others. *Id.*

were much like other creative artistic individuals.<sup>187</sup> The court further determined that it was irrelevant that the designer did not spend a significant amount of time and money on the design; the toy train track was still a significant innovation.<sup>188</sup> Furthermore, even though an expert witness stated that the track was “a fairly simple product if you look at it,” the track still could not have been easily duplicated.<sup>189</sup> This simple design therefore was a protectable trade secret. Similar to toy designers, chefs are artists who put time and effort into their creations. Even though a cake design may look simple, it can have non-obvious concepts that the chef does not want available to the public. That chef therefore should have the right to protect the design under trade secret law until he decides to disclose it.

The method behind creating a cake design can also be a trade secret. In *Hutchinson v. KFC Corp.*, the court determined that a trade secret could be the combination of steps behind the process of creating a food product.<sup>190</sup> The court held that a trade secret did not exist in this case because the sequence of steps that Hutchinson sought to protect was basic and publicly available, but if a company were to create a novel approach in food creation, this approach could be a trade secret.<sup>191</sup> Similar to the process behind the production of this food product, the process behind the production of a cake could be protectable by trade secret law as long as the

---

<sup>187</sup> *Id.* at 729.

<sup>188</sup> *Id.* at 728.

<sup>189</sup> *Id.* at 729–30.

<sup>190</sup> *Hutchinson v. KFC Corp.*, 51 F.3d 280 (9th Cir. 1995).

<sup>191</sup> *Id.* at 280.

process meets the necessary requirements.<sup>192</sup> For example, Chef Ron Ben-Israel currently protects the process behind the creation of his cakes, as demonstrated by his registered trademark for “educational demonstrations and teaching in the field of custom cake baking and decorative services.”<sup>193</sup>

Also in the food world, recipes can be trade secrets depending on what type of dish the recipe is for. In *Buffets, Inc. v. Klinke*, the court determined that there could be no trade secret protection for recipes and cooking procedures for staple dishes, such as those for barbeque chicken and macaroni and cheese.<sup>194</sup> Yet in *205 Corp. v. Brandow*, the court held that a restaurant’s pizza sauce and crust recipes were trade secrets.<sup>195</sup> Although pizza can also be a staple dish and the recipes for the dish contained many core and obvious ingredients, the court reasoned that the exact assembly and baking process of the ingredients could not be easily determined by outsiders, therefore making the overall recipe and process a trade secret.<sup>196</sup> Similarly, cake chefs

---

<sup>192</sup> See, e.g., *Lowndes Products, Inc. v. Brower*, 191 S.E.2d 761, 765 (S.C. 1972) (holding that the equipment, formulas, and techniques plaintiff employed to make its nonwoven fabrics were trade secrets).

<sup>193</sup> RON BEN-ISRAEL CAKES, Registration No. 3,404,683.

<sup>194</sup> *Buffets, Inc. v. Klinke*, 73 F.3d 965, 968—69 (9th Cir. 1996). In this case, the court held that its recipes and procedures for making the chicken and pasta dishes were undeniably obvious. *Id.* The court reasoned that this was not a case where obvious material had been refashioned or recreated in such a way to turn it into an original product. *Id.* Instead, the end product itself was unoriginal and therefore not a trade secret. *Id.* Old Country Buffet’s macaroni and cheese recipe contains cheddar cheese, Parmesan cheese, elbow macaroni, bacon, onion, garlic, butter, flour, milk, and paprika. CECIL C. KUHNE III, *THE LITTLE BOOK OF FOODIE LAW* 85 (2012).

<sup>195</sup> *205 Corp. v. Brandow*, 517 N.W.2d 548, 552 (Iowa 1994).

<sup>196</sup> *Id.*

can gain trade secret protection for their unique recipes, such as those for a new flavor of cake or for a rare and non-obvious frosting.<sup>197</sup> Trade secret law can protect cake design and many of its related aspects.

***D. Design Patents to Protect Cake Design***

Design patents are currently used to protect cake designs, although not extensively.<sup>198</sup> Design patents provide strong protection to ornamental designs and have been used by large, wealthy companies to protect their cake designs.<sup>199</sup> However, there are many burdens of obtaining design patents that may outweigh the benefits.<sup>200</sup> Furthermore, cake design is not an article of manufacture and is therefore not patentable.

**1. Background on Patent Law**

Patents provide strong protection for inventions and have been used to protect cake design. Patent law is divided into three main categories, utility patents, design patents, and plant patents.<sup>201</sup> Utility patents protect the functional aspects of an invention and design patents protect the non-functional, ornamental aspects.<sup>202</sup> Although both design

---

<sup>197</sup> E-mail from Kimberly, Chef and co-owner of Cake, a San Diego bakery (Oct. 3, 2014, 10:37 AM PST) (on file with author) (Kimberly noted that her bakery used a special type of fresh better cream in their frosting process, which distinguishes them from other bakers who use fondant). If the bakery's process or recipe for this butter cream was a unique secret, it could gain trade secret protection.

<sup>198</sup> *See infra* notes 225 – 231 and accompanying text.

<sup>199</sup> *See Id.*

<sup>200</sup> *See infra* Part III(D)(3).

<sup>201</sup> DONALD S. CHISUM, CHISUM ON PATENTS § 1.01 (Matthew Bender ed. 2014). This Comment is unrelated to the third category of patents. For more on plant patents, see 35 U.S.C. §§ 161 – 164 (2012).

<sup>202</sup> *Id.* at § 23.05.

patents and utility patents are available to protect edible food items,<sup>203</sup> this Comment will only focus on the use of design patents, rather than utility patents, to protect cake design.

Design patents protect new, original, ornamental designs for articles of manufacture.<sup>204</sup> To qualify as new and original, the article must differ from all previous product designs.<sup>205</sup> To qualify as non-obvious, the article cannot be considered obvious by others in the field.<sup>206</sup> To qualify as ornamental, a design must have a “pleasing aesthetic

---

<sup>203</sup> Patent class 416 allows for the patentability of products in any physical form whose purpose is to be consumed. *See Class 426: Food or Edible Materials: Process, Compositions and Products*, USPTO.GOV, <http://www.uspto.gov/web/patents/classification/uspc426/defs426.htm> (last visited Oct. 3, 2014). Furthermore, scholars have even argued that the taste of a food product can be patented if the flavor meets the patent requirements. *See* Robert J. Lewis, *Protecting A Sensory Attribute of Food by Patent* (2006), available at <http://www.mchaleslavin.com/newsletters/newsletter-05.html> [<http://perma.cc/VJ8R-VDJP>]. Lewis argues that if the taste profile of food passes the non-obviousness and novelty tests, “there appears to be no legal reason why a food product could not be patented with the food being characterized by a sensory attribute as opposed to the classical attributes . . . .” *Id.* However, Lewis notes that if a company was to patent its product’s taste, it would have to disclose its trade secrets; for example, Coca-Cola would need to disclose its secret formula should it want to patent the taste of its product. *Id.*

<sup>204</sup> 35 U.S.C. § 171 (2012).

<sup>205</sup> *Lawman Armor Corp. v. Winner Intern.*, 437 F.3d 1383, 1384–85 (Fed. Cir. 2006), *reh’g denied*, 449 F.3d 1190 (Fed. Cir. 2006), *reh’g en banc denied* 449 F.3d 1192 (Fed Cir. 2006).

<sup>206</sup> *Neufeld-Furst & Co. v. Jay-Day Frocks*, 112 F.2d 715, 715 (2d Cir. 1940) (the standard for non-obviousness for clothing designs is whether or not a skilled dressmaker “who had, or is chargeable with, knowledge of the prior art” finds the design obvious).



appearance” and must be more than purely functional.<sup>207</sup> Design patents can protect the ornamental features of a useful, functional product as long as these features are predominately ornamental.<sup>208</sup> Finally, to be an article of manufacture, the article must be a substance of commodity that is made by giving raw or prepared materials new form.<sup>209</sup>

Patent examiners at the USPTO issue design patents if they determine that the patent application meets the requirements.<sup>210</sup> If the USPTO grants the inventor’s patent, this gives the inventor a private right of exclusion for fourteen years.<sup>211</sup> This right of exclusion protects the

---

<sup>207</sup> CHISUM, *supra* note 201, at § 23.01.

<sup>208</sup> See PHG Tech., LLC v. St. John Co., 469 F.3d 1361, 1366 (Fed. Cir. 2006) (holding that the design of a medical label sheet was not purely ornamental); Best Lock Corp. v. Ilco Uican Corp., 94 F.3d 1563, 1567 (Fed. Cir. 1996) (holding that the design patent of a key blade is invalid because the key was designed to be primarily functional i.e. fit in the lock); L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) (holding that simply because a design consists of some utilitarian elements, this will not result in the denial of protection as long as the design viewed as a whole is not dictated by the utilitarian purpose).

<sup>209</sup> *In re Nuijten*, 500 F.3d 1346, 1356 (Fed. Cir. 2007).

<sup>210</sup> 35 U.S.C. § 2 (2012).

<sup>211</sup> 35 U.S.C. § 173 (2012). However, once the United States implements the Hague System, design patents will last fifteen years. See Darrell G. Mottley, *U.S. Implementation of the Hague Agreement for Industrial Designs: Not a “One-Size-Fits-All” System*, BANNER & WITCOFF LTD. (2013), available at [http://bannerwitcoff.com/\\_docs/library/articles/Mottley.SpringSummer2013Newsletter.pdf](http://bannerwitcoff.com/_docs/library/articles/Mottley.SpringSummer2013Newsletter.pdf) [<http://perma.cc/7M9K-Q4C7>]...

inventor against infringement,<sup>212</sup> allowing the owner to bring a civil lawsuit against the infringer.<sup>213</sup> To determine if a patent is being infringed, courts use the “ordinary observer test.”<sup>214</sup> This test asks whether an ordinary observer who is familiar with the prior art would be deceived into thinking that the accused design is the same as the patented design.<sup>215</sup> Therefore, the second patent will not infringe the first unless it “embodies the patented design or any colorable imitation thereof.”<sup>216</sup>

If a patent holder sues for infringement, the alleged copier has many available defenses. The primary defenses include non-infringement, invalidity of the original patent, a defense based on the patent holder’s authorization to use the patent, or general equitable defenses that bar the patent holder from making a claim, such as laches and equitable estoppel.<sup>217</sup> If these defenses fail and the owner is successful

---

<sup>212</sup> Infringement occurs if someone besides the inventor makes, uses, sells, offers to sell, or imports the invention without permission. 35 U.S.C. § 271 (2012).

<sup>213</sup> 35 U.S.C. § 281 (2012).

<sup>214</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008). This test was first laid out by *Gorham Manufacturing Co. v. White*, 81 U.S. 511 (1871). The *Egyptian Goddess* decision has been criticized for replacing the “ordinary observer,” i.e. the jury, with the “extra-ordinary observer.” See Christopher V. Carani, *The New “Extra-Ordinary” Observer Test for Patent Infringement – On a Crash Course with the Supreme Court’s Precedent in Gorham v. White*, 8 J. MARSHALL REV. INTELL. PROP. L. 354, 357 (2009).

<sup>215</sup> *Egyptian Goddess*, 543 F.3d at 678.

<sup>216</sup> *Id.* (quoting *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116–17 (Fed. Cir. 1998)).

<sup>217</sup> MICHAEL J. KASDAN ET AL., PATENT INFRINGEMENT CLAIMS AND DEFENSES 4–5 (2013), available at [http://www.arelaw.com/downloads/ARElaw\\_PracticeNote101511.pdf](http://www.arelaw.com/downloads/ARElaw_PracticeNote101511.pdf) [<http://perma.cc/2KVG-WFNG>].

in the infringement action, the court can issue damages as well as an injunction preventing the infringer from using the design any further.<sup>218</sup>

## 2. Design Patents, for Wealthy Cake Designers

Patents have been used to protect the appearance of popular food items such as Tostitos Scoops<sup>219</sup> and Pringles.<sup>220</sup> Similar to other food companies, various cake companies have acquired design patent protection for their cake designs. All cake designs on the USPTO website that list their assignee list a large, well-known, and highly profitable company.<sup>221</sup> For example, Cold Stone

---

<sup>218</sup> 35 U.S.C. §§ 283–84 (2012).

<sup>219</sup> *Frito-Lay N. Am., Inc. v. Medallion Foods*, 2012 U.S. Dist. LEXIS 139296 (E.D. Tex. 2012); *see also* Julie Beck, *Jury finds Bowlz chips don't infringe on Frito-Lay's patent for Tostitos Scoops*, INSIDECOUNSEL (March 5, 2013), <http://www.insidecounsel.com/2013/03/05/jury-finds-bowlz-chips-dont-infringe-on-frito-lays> [<http://perma.cc/TC32-UC7M>].

<sup>220</sup> U.S. Patent No. 3,998,975 (filed Aug. 2, 1974). This patent is a utility patent, rather than a design patent, because it also covers the process of making the potato chip. *See also* U.S. Patent No. 3,498,798 (filed July 29, 1966) (claiming a method for packaging snacks in a tall container instead of in a bag).

<sup>221</sup> The other cake design patents found on the USPTO website did not list the assignee. U.S. Patent Nos. D.273,979 (filed June 1, 1982) and D.385,687 (filed June 9, 1995) are patented by an international inventor, and U.S. Patent No. D.618,426 (filed Sept. 29, 2008) is a red velvet cake design patented by an unknown agency. It is unclear why these patents do not have a listed assignee. The assignee for a patent is the entity that has the property right in the patent and therefore is able to take legal action if the patent is infringed. *See* Tony O'Lenick, *Patent Inventor vs. Assignee*, COSMETICS & TOILETRIES (Nov. 19, 2007), <http://www.cosmeticsandtoiletries.com/research/patents/11623111.html> [<http://perma.cc/2LZC-7F2V>].

Creamery<sup>222</sup> and Breyers Ice Cream<sup>223</sup> own patents for ice cream cakes.<sup>224</sup> Sylvia Weinstock<sup>225</sup> and the Pillsbury Company<sup>226</sup> both own patents for decorative ornamental cakes,<sup>227</sup> and Quaker Oats Company owns a patent for a decorated wedding cake.<sup>228</sup> The USPTO cannot grant a

---

<sup>222</sup> Cold Stone Creamery is a large international company and has been listed as number four on CNN’s “Top most popular franchises.” *10 most popular franchises*, CNN MONEY, [http://money.cnn.com/galleries/2010/smallbusiness/1004/gallery.Franchise\\_failure\\_rates/4.html](http://money.cnn.com/galleries/2010/smallbusiness/1004/gallery.Franchise_failure_rates/4.html) [<http://perma.cc/GD77-5TLG>.] (last visited Sept. 26, 2014). The company currently operates more than 1,400 locations. *Id.*

<sup>223</sup> In 2004, Breyers Ice Cream was the second-largest ice cream maker in the United States and made \$600 million in sales. Lynn Cook, *How Sweet It Is*, FORBES (March 1, 20014, 12:00 AM), <http://www.forbes.com/forbes/2004/0301/090.html> [<http://perma.cc/N3ZF-V3C3>].

<sup>224</sup> U.S. Patent No. D.571,526 (filed April 11, 2007) and U.S. Patent No. D.550,927 (filed June 23, 2004) (Cold Stone Creamery cakes); U.S. Patent No. D.487,181 (filed Nov. 18, 2002) and U.S. Patent No. D.486,951 (filed Nov. 18, 2002) (Breyer’s Ice Cream cakes).

<sup>225</sup> Sylvia Weinstock is known for her luxurious yet beautiful cakes. Caitlin Johnson, *Weinstock’s Wedding Cakes For the Wealthy*, CBS (Feb. 8, 2007, 11:10AM), <http://www.cbsnews.com/news/weinstocks-wedding-cakes-for-the-wealthy/> [<http://perma.cc/R454-SVD3>]. A basic Weinstock cake costs \$3,000 and her more elaborate cakes can cost as much as \$50,000. *Id.*

<sup>226</sup> See *World’s Most Innovative Companies*, FORBES, <http://www.forbes.com/companies/general-mills/> (last updated May 2014) (showing that General Mills now owns the Pillsbury Company, and that General Mills is one of the world’s top companies with a current market capitalization of \$3331.8 billion).

<sup>227</sup> U.S. Patent No. D.402,227 (filed Jan. 21, 1997) (Sylvia Weinstock decorative cake); U.S. Patent No. D.347,308 (filed Dec. 9, 1991) (Pillsbury Company ornamental cake).

<sup>228</sup> U.S. Patent No. D.307,970 (filed July 8, 1987).

design patent unless the design is new, original, and ornamental.<sup>229</sup> Thus, it is unclear why some of these cake design patents issued at all. Although Sylvia Weinstock's patent for her Celebration Cake depicts a cake with an elaborate frosting ribbon,<sup>230</sup> other cakes are not as ornate. For example, the Cold Stone Creamery patent depicts a circular cake with strawberry-shaped frosting designs on top.<sup>231</sup> It is difficult to believe that the patent examiners would see a circular design with simple strawberries on top as "non-obvious" it arguably would have "been obvious to a designer of ordinary skill of the articles involved" and therefore not met the statutory requirement.<sup>232</sup> Yet the USPTO approved the design, and it is unclear whether the validity of the patent has ever been subject to litigation. Nonetheless, the patents are valid, and it is important to determine why these companies chose to invest in patent protection for their cakes.

### **3. Using Design Patents for Cake Design**

The above companies have determined that patent protection for their products is worth the effort and price. Although Cold Stone's patented Strawberry Passion cake costs anywhere between \$26.99 and \$79.99 depending on its size, the cake is sold often throughout Cold Stone's 1,400 locations.<sup>233</sup> Cold Stone determined that the high burden of

---

<sup>229</sup> 35 U.S.C. § 171 (1952).

<sup>230</sup> U.S. Patent No. D.402,227 (filed Jan. 21, 1997).

<sup>231</sup> U.S. Patent No. D.571,526 (filed April 11, 2007).

<sup>232</sup> *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982) (identifying the standard that courts apply when determining non-obviousness under 35 U.S.C. § 103).

<sup>233</sup> COLD STONE CAKES, <http://coldstonecakes.com/menu/pacific-beach> [<http://perma.cc/9CUW-8DHR>] (last visited Sept. 26, 2014). Note that the price of the Strawberry Passion cake varies by location. *Id.*

obtaining a patent for its cake design was worth the effort due to the amount of money it makes from sales of this cake. One strong benefit a patent provides is legal protection, for a patented cake can be protected not only through the courts, but is also backed by attorneys who can threaten legal action, which can be just as sufficient.<sup>234</sup> In fact, only 1.5% of all patents are ever litigated.<sup>235</sup> The usual method of enforcement is for the attorney to send a demand letter to the potential infringer and state the concern, either giving the infringer an offer to remove its product from the market or demanding that it do so.<sup>236</sup> This letter usually leads to a discussion among the parties, which can result in the filing of a lawsuit. However, this filing is usually merely the next

---

This price was from a San Diego location of Cold Stone Creamery.  
*Id.*

<sup>234</sup> Telephone interview with R. Lee Fraley, Attorney for Cold Stone Creamery, Snell & Wilmer (Oct. 2, 2014). Cold Stone attorney Mr. Fraley noted that he was unaware of any cake patent litigation and that Cold Stone uses other means to stop infringement instead. *Id.* However, Cold Stone has had to resort to litigation to protect its trademarks. See *Cold Stone Creamery, Inc. v. Gorman*, 361 Fed. Appx. 282 (2d Cir. 2010).

<sup>235</sup> Mark A. Lemley & Carl Shapiro, *Probabilistic Patents*, 19 J. OF ECON. PERSP. 75, 79 (2005), available at <http://faculty.haas.berkeley.edu/shapiro/patents.pdf> [<http://perma.cc/8XY5-YVCF>]. This statistic was confirmed in 2011. See Jason Rantanen, *Patents, Litigation and Reexaminations*, PATENTLY-O (Dec. 29, 2011), <http://patentlyo.com/patent/2011/12/patents-litigation-and-reexaminations.html> [<http://perma.cc/V59L-FT74>].

<sup>236</sup> See *I Got a Letter...*, USPTO.GOV, [http://www.uspto.gov/patents/litigation/I\\_got\\_a\\_letter.jsp](http://www.uspto.gov/patents/litigation/I_got_a_letter.jsp) [<http://perma.cc/G6GP-E8SS>] (last visited Nov. 11, 2014).

step in these negotiations and the parties usually resolve the dispute before actually setting foot in a courtroom.<sup>237</sup>

There are many other benefits in acquiring design patent protection for cakes designs. First, even though a design patent is costly, it is relatively easy to obtain.<sup>238</sup> Second, a company that has a patented product is a step ahead of its competitors. If a business partner or vendor hears that a company has a patent on its products, it may be more likely to do business with that company.<sup>239</sup> Third, a competitor may be more likely to avoid copying a company's products or using them as inspiration if the company has patent protection or a "patent pending"<sup>240</sup> on

---

<sup>237</sup> Irfan A. Lateef & Marko R. Zoretic, *The U.S. Patent Litigation Process* (Knobbe Martens), Dec. 2010, at 1, available at <http://knobbe.com/pdf/2010-December-The-US-Patent-Litigation-Process.pdf> [<http://perma.cc/48FH-2QP6>] ("[T]he high costs of patent litigation create an incentive for the parties to explore settlement at an earlier stage. Indeed, more than 95% of patent cases are resolved before trial—mostly through settlement.").

<sup>238</sup> See Lemley & Shapiro, note 235, at 75 (stating that the USPTO issues around 200,000 patents each year following a limited examination process. These scholars also note that even though many patents are issued, very few turn out to have actual commercial significance); David R. McKinney, *What Every Attorney Ought to Know About Patent Law*, 13-APR UTAH B. J. 18 (2000) (noting that due to their limited coverage, design patents are easy to obtain).

<sup>239</sup> Tamara Monosoff, *To Patent or Not to Patent?*, ENTREPRENEUR (Sept. 26, 2005), <http://www.entrepreneur.com/article/80088> [<http://perma.cc/DM84-BFCL>].

<sup>240</sup> "Patent pending" does not mean that the patent is enforceable, but in the eyes of a competitor, it is a red flag to tread carefully. RICHARD STIM & DAVID PRESSMAN, PATENT PENDING IN 24 HOURS 1/8 (1st ed. 2002) (noting that one advantage of filing a patent application is the ability to use the term "patent pending" on a product to scare off competitors from stealing the invention). The authors encourage inventors to use the term in order to deter competition even though

its products. Competitors give patents a wide berth partly because of the statutory presumption of validity.<sup>241</sup> Competitors are aware that should an infringement suit go to trial, the infringer will be faced with the task of proving that the patent is invalid or that there is no infringement, and will likely pay high damages and be subject to an injunction should the court find otherwise.<sup>242</sup>

There is no doubt that the process a company such as Cold Stone goes through in order to gain patent protection for its cake designs is prolonged and expensive.<sup>243</sup> Including

---

having a patent pending does not provide the potential patentee any legal rights. *Id.*

<sup>241</sup> 35 U.S.C. § 282 (2012) (“A patent shall be presumed valid.”).

However, this presumption only means that the defendant must prove invalidity by clear and convincing evidence, and courts generally only hold around fourteen percent of patents to be valid. Morgan, Lewis & Bockius, *White Paper Report: United States Patent Invalidation Study 2012*, available at [http://www.morganlewis.com/~media/files/publication/presentation/speech/smyth\\_uspatentininvalidity\\_sept12.ashx](http://www.morganlewis.com/~media/files/publication/presentation/speech/smyth_uspatentininvalidity_sept12.ashx).

<sup>242</sup> For example, in *Apple v. Samsung*, the jury determined that Samsung had infringed Apple’s patents and must pay Apple \$119.6 million as a result. Mikey Campbell, *Jury modifies Apple v. Samsung damages but final amount unchanged, calls Google involvement ‘interesting’ [updated with verdict form]*, APPLEINSIDER (May 5, 2014, 1:43 PM), <http://appleinsider.com/articles/14/05/05/jury-modifies-apple-v-samsung-damages-but-final-amount-unchanged-calls-google-involvement-interesting> [<http://perma.cc/2Z7H-QHQ5>].

<sup>243</sup> See U.S. Patent and Trademark Office, FY 2008 Fee Schedule, available at <http://www.webcitation.org/5WoO2Ed9E> [<http://perma.cc/JM4D-RE5B>] (last updated Apr. 1, 2008). This schedule outlines the fees associated with gaining a design patent. *Id.* These fees, which only include those paid to the USPTO, include: the filing fee of \$210.00, the design search fee of \$100.00, the examination fee of \$130.00, the patent post-allowance fee of \$820, the patent maintenance fee, which requires the inventor to pay every few years, and more. *Id.*



all of the application costs to the USPTO and legal costs to attorneys, inventors can end up paying around \$2,500 to \$5000 per design patent.<sup>244</sup> Furthermore, once the USPTO grants the patent, this merely gives the inventor the right to the invention. An approved patent does not promise the inventor any protection and he must therefore still enforce the patent by searching for infringers. If the inventor finds the infringer and files a lawsuit, it is possible that the court will determine the original patent was invalid and that the inventor therefore has no protection.<sup>245</sup> This lawsuit, no matter the result, can cost from one million to five million dollars in litigation costs, depending on the amount in controversy.<sup>246</sup> A final downside of the design patent process is the timeline. The USPTO takes approximately 18-24 months to approve a patent, depending on the patent's complexity.<sup>247</sup> By that time, it may not seem worthwhile for

---

<sup>244</sup> *How Much Does a Patent Cost?*, NEUSTEL LAW OFFICES, <http://www.neustel.com/Patent-Costs-Fees/How-Much-Does-A-Patent-Cost.aspx> [<http://perma.cc/2W7U-VT3M>] (last visited Dec. 14, 2014).

<sup>245</sup> See Morgan, Lewis & Bockius, *supra* note 241. According to a recent survey, between the years 2007 and 2011, federal district courts have evaluated 283 patent claim cases, but only 39 of these patents were determined to be valid and enforceable. *Id.* Furthermore, when a district court holds that a patent is valid, the Federal Circuit can still determine the patent was not infringed or not enforceable. *Id.* In some areas, the Federal Circuit reverses district court judgments one-third of the time. Lemley & Shapiro, *supra* note 235, at 80.

<sup>246</sup> AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, 2013 REPORT OF THE ECONOMIC SURVEY 1 (2013), *available at* <http://www.patentinsurance.com/custdocs/2013aipla%20survey.pdf> [<http://perma.cc/3AVL-HDXR>].

<sup>247</sup> *Frequently Asked Questions About Patents*, MAIER & MAIER PLLC, [http://www.maierandmaier.com/Patent\\_FAQs.aspx](http://www.maierandmaier.com/Patent_FAQs.aspx) [<http://perma.cc/JYX5-4ZKE>] (last visited Dec. 14, 2014).

the inventor to obtain the patent, as others may have copied the invention during this two-year period. These burdens of patent protection arguably outweigh the benefits,<sup>248</sup> especially when other forms of legal protection are readily available.

Even though many large companies have been fortunate enough to reap the benefits of design patent protection for their cake designs, design patent protection should not be extended to cake design because cake design is not an article of manufacture.

#### IV. A LOGICAL SOLUTION

Cake design should not be eligible subject matter for design patents. If cake designers want legal protection for the appearance of their designs, they should use copyright. If designers want to protect the overall image of their products, they should use trademarks. Finally, if designers want to protect undisclosed cake designs, processes, or recipes, they should use trade secret protection.

Although it is arguable that Congress intended the scope of patentable materials to be broad,<sup>249</sup> many categories of products have been excluded from patent protection.<sup>250</sup>

---

<sup>248</sup> See Michael Fitzgerald, *A Patent Is Worth Having, Right? Well, Maybe Not*, N.Y. TIMES (July 15, 2007), [http://www.nytimes.com/2007/07/15/business/yourmoney/15proto.html?\\_r=0](http://www.nytimes.com/2007/07/15/business/yourmoney/15proto.html?_r=0) [<http://perma.cc/YGE9-DWDR>] (quoting a researcher who says that if the invention is worth less than \$10,000, it does not make sense to file the patent).

<sup>249</sup> See *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (“Congress plainly contemplated that the patent laws would be given wide scope.”).

<sup>250</sup> For example, three judicially created exceptions to patentable subject matter are: laws of nature, natural phenomena, and abstract

Design patents protect articles of manufacture that embody ornamental designs, and if an invention does not fit within this definition, it is not patentable.<sup>251</sup> Examples of items that are not articles of manufacture and are therefore not patentable are books, art, and music.<sup>252</sup> For example, courts have held that a picture standing alone is not patentable because it is not embodied onto an article of manufacture.<sup>253</sup> The artist is claiming the picture itself, not the canvas it is applied to. The same reasoning is applied to books; books are not patentable because they are merely the author's words applied to paper. The author can claim the creative expression, but there is no article of manufacture to claim. Copyrights protect creative expression of ideas and are therefore better suited for these types of works.<sup>254</sup> Although some scholars have argued that art is indeed an article of manufacture and should be patentable,<sup>255</sup> this subject matter

---

ideas. Anthony D. Sabatelli, *What is patent eligible? Initial thoughts on the PTO's revised Guidance*, LEXOLOGY (Dec. 22, 2014), 22, 2014), <http://www.lexology.com/library/detail.aspx?g=67148253-de49-433a-9048-e55870b19e45> [<http://perma.cc/L3XQ-FWH4>]. Congress could simply determine that cake design should be categorically excluded and add it to this list.

<sup>251</sup> Manual of Patent Examining Procedure, § 2106 (2007), *available at* <http://www.uspto.gov/web/offices/pac/mpep/s2106.html> [<http://perma.cc/48XP-U2TN>] (noting that if the claimed invention is not a process, machine, manufacture, or composition of matter, it is not patentable).

<sup>252</sup> Michael Risch, *Everything Is Patentable*, 75 TENN. L. REV. 591, 633–35 (2008).

<sup>253</sup> *Ex parte Strijland*, No. 1992 – 0623, 1992 WL 470727 (B.P.A.I. Apr. 2, 1992).

<sup>254</sup> 17 U.S.C. § 102(b) (2012).

<sup>255</sup> *See* Risch, *supra* note 252, at 633.

has been excluded for a reason, and this reasoning should extend to cake design.

Cake design should fall into the category of non-patentable subject matter. The protectable cake design, made with frosting, colored glaze, and icing flowers, is merely applied to a cake, a combination of sugar, flour, eggs, and other natural ingredients.<sup>256</sup> The cake designer is not claiming that he invented the entire cake—he did not invent the recipe,<sup>257</sup> the ingredients,<sup>258</sup> or the idea of cake<sup>259</sup> – he is merely claiming the design on the cake’s surface. This design is comparable to a picture or painting and is not patentable for the same reason. Although it is true that the claimed design can include the cake’s shape, this same argument can be made for paintings, but it does not make them patentable. A painter can paint a landscape onto a circle canvas, a square paper, or a swath of fabric and the work is still not patentable, but is copyrightable as creative expression. A cake design is also a chef’s creative expression of ideas and is therefore best suited for copyright

---

<sup>256</sup> Robyn, *The Best White Cake Recipe {Ever}*, ADD A PINCH (Aug 9, 2013), <http://addapinch.com/cooking/the-best-white-cake-recipe/> [<http://perma.cc/53Z8-EL2D>] (listing the ingredients for a white cake.) To make this cake, the chef uses butter, vegetable shortening, sugar, eggs, flour, baking powder, salt, milk and vanilla extract. *Id.*

<sup>257</sup> See *In re White*, 39 F.2d 974 (C.C.P.A. 1930) (holding that a mixture of well-known ingredients was not patentable). *But see supra* Part III.C.2 (arguing that a chef’s recipe can be protected by trade secret).

<sup>258</sup> Natural ingredients are not patentable. See *Morgan & Hamilton Co v. City of Nashville*, 270 S.W. 75, 77 (Tenn. 1925) (holding that cotton in bales and tobacco are not articles of manufacture).

<sup>259</sup> Patents do not protect ideas. Gene Quinn, *Protecting Ideas: Can Ideas Be Protected or Patented?*, IPWATCHDOG (Feb. 15, 2014), <http://www.ipwatchdog.com/2014/02/15/protecting-ideas-can-ideas-be-protected-or-patented/id=48009/> [<http://perma.cc/4ALR-AFFR>].

protection.<sup>260</sup> Excluding cake design from patent protection is reasonable, as it would prevent patents from protecting subject matter that fits more properly within the scope of copyright protection.<sup>261</sup>

Cake designers would not be the first group to oppose the use of patents for their products; software designers have contested the use of patent protection for their work and have expressed a preference for copyright protection instead.<sup>262</sup> Software design company Oracle has stated, “copyright protection for computer software is sufficient to preserve the rights of software developers” while patent protection is “excessively broad and enormously expensive.”<sup>263</sup> The USPTO has ignored these protests and has continued to issue software patents even though the use of patents continues to prevent small yet brilliant companies from keeping up with the big companies

---

<sup>260</sup> Robert A. Kreiss, *Patent Protection for Computer Programs and Mathematical Algorithms: The Constitutional Limitations on Patentable Subject Matter*, 29 N.M.L. REV. 31, 58 (1999) (noting that novels, plays, music, and paintings all deserve intellectual property protection, but this protection should be under the copyright system, not the patent system).

<sup>261</sup> LEE A. HOLLAAR, LEGAL PROTECTION OF DIGITAL INFORMATION (2012), available at <http://digital-law-online.info/lpd1.0/treatise54.html> [<http://perma.cc/Y5HN-AEAK>] (making the same argument for printed matter).

<sup>262</sup> Timothy B. Lee, *Patently Absurd – Copyright Law Can Meet the Needs of Software Developers*, CATO INSTITUTE (Oct. 3, 2011) <http://www.cato.org/publications/commentary/patently-absurd-copyright-law-can-meet-needs-software-developers> [<http://perma.cc/L4PP-4CB7>]. 3, 2011), <http://www.cato.org/publications/commentary/patently-absurd-copyright-law-can-meet-needs-software-developers>.

<sup>263</sup> *Id.*

in the software industry.<sup>264</sup> Similar to cake designers, even the smartest and most creative software designers cannot rival the big companies, and fall behind due to their limited funds and lack of patent protection.<sup>265</sup>

Removing cake design from the scope of patent protection would have positive effects on the cake design community. Scholars agree that the USPTO has become too lenient in its willingness to grant patent applications and is no longer applying the tests of novelty and non-obviousness as it should be.<sup>266</sup> The USPTO grants the great majority of patent applications; in 2009, it reviewed around 485,500 patent applications and only rejected 20% of them.<sup>267</sup> This leniency allows big companies to obtain patents for many, slightly differing designs. For example, Cold Stone Creamery’s patented Strawberry Passion cake is a circle cake with strawberries on top.<sup>268</sup> If a Cold Stone competitor were to make a circle cake with another decoration on top, this would not infringe the patent.<sup>269</sup> Cold Stone therefore

---

<sup>264</sup> *Id.*

<sup>265</sup> *Id.*

<sup>266</sup> *Monopolies of the mind*, ECONOMIST (Nov. 11, 2004), available at <http://www.economist.com/node/3376181> [<http://perma.cc/FMK4-3NWS>] (“The qualifying tests for patents are straightforward—that an idea be useful, novel and not obvious. Unfortunately most patent offices, swamped by applications that can run to thousands of pages and confronted by companies wielding teams of lawyers, are no longer applying these tests strictly or reliably.”).

<sup>267</sup> Dennis Crouch, *Design Patent Rejections*, PATENTLYO (Jan. 19, 2010), <http://www.patentlyo.com/patent/2010/01/design-patent-rejections.html> [<http://perma.cc/U8K8-ZMFJ>]. This statistic includes both utility and design patents. *Id.*

<sup>268</sup> U.S. Patent No. D.571,526 (filed April 11, 2007).

<sup>269</sup> This technique of designing an idea that is similar to but does not infringe the other designer’s patent is called “designing around” and is popular in the patent world. *Designing Around Another Patent*,

must obtain separate patents for cakes with different designs on top in order to stop infringement of this type of cake. In fact, Cold Stone does have multiple patents for many different cake designs.<sup>270</sup>

The fact that many large companies have multiple patents for basic designs but small companies usually do not obtain patent protection for even one of their cake designs demonstrates the imbalance in cake design protection. Before a company begins the patent process, it will perform a cost-benefit analysis and will only patent the cakes that it believes will be profitable; this may mean that the company patents only one cake, or it may mean that it patents many. A company like Cold Stone can afford to apply for many different patents, but smaller bakeries may not even be able to apply for one. The fact that only large companies have patents for their cakes is in no way a reflection on the uniqueness or patentability of their designs. A small mom-and-pop bakery could have a cake design that is as unique as a Cold Stone cake, but because it cannot justify spending thousands of dollars on legal fees, it cannot protect its designs as strongly as a large company can. On the other hand, copyrights are far less expensive to obtain than patents,<sup>271</sup> and the use of copyrights instead of patents in this

---

INTELLECTUAL PROPERTY LAW FIRMS,  
<http://www.intellectualpropertylawfirms.com/resources/intellectual-property/patents/designing-around> [<http://perma.cc/ZM6H-BWZN>]  
(last visited Nov. 3, 2014).

<sup>270</sup> See Fraley, *supra* note 234; see also U.S. Patent No. D.550,927 (filed June 23, 2004) (patent for Cold Stone’s Midnight Delight cake, a similar circle cake, yet with chocolate cylinders on top instead of strawberries).

<sup>271</sup> Anh Tran, *You’ve Created an App – What’s Next?*, LEGALZOOM (July 2012), <https://www.legalzoom.com/articles/youve-created-an-app-whats-next> (“[A] copyright registration is significantly cheaper than a patent, and often takes much less time to register.”).

field would allow for equal protection for equally protectable products.

In today's digital era, copying is almost inevitable and it is logical that chefs want to shield themselves from this unfairness. However, chefs may choose extralegal means of protection instead, such as watermarking each photo they put on their website to show ownership, or contacting the infringers themselves. One designer determined that she did not need legal means to stop the infringement of her designs and contacted an infringing bakery without involving a threat of legal action.<sup>272</sup> This method of informal dispute resolution works well in industries like cake design where there are many small businesses involved with not a great deal of money at stake.<sup>273</sup> Another option of protection is private dispute resolution, where chefs could complain to a national bakers association about copying issues instead of bringing legal

---

<sup>272</sup> See E-mail from Kimberly, Chef and co-owner of Cake, a San Diego bakery (Oct. 3, 2014, 10:37 AM PST) (on file with author). Kimberly shared the story of the time her bakery discovered their photo on another company's website. *Id.* The company also had photos of cakes made by The Wilton Company and Ron Ben-Israel. *Id.* Kimberly contacted Ben-Israel and the Wilton Company, who then contacted the infringing bakery, and the problem was resolved. *Id.* If Kimberly had contacted the other bakery herself without the assistance of two major cake corporations, it is unclear if that infringing bakery would have felt threatened enough to remove the pictures of Kimberly's cakes. Kimberly was lucky to be backed by two threatening agencies, but one non-legal threatening letter from one small bakery to another may not have been effective. The backing of legal assistance or a clearly protected cake design is more powerful and effective.

<sup>273</sup> See Oliar, *supra* note 49, at 1791 (discussing the informal resolution used to protect comedians).



action.<sup>274</sup> In fact, one group of chefs has started a cake thief blog, encouraging other chefs to write in and blacklist bakeries who have copied their work.<sup>275</sup> These chefs hope that the cake community can band together and let the thieves know that their actions are inexcusable.<sup>276</sup> This method of using a unique governing system, either an official association or an online accountability forum, instead of legal protection, can create a uniform and simple solution.<sup>277</sup>

Many critics who have expressed the negative implications of expanding intellectual property protection too far would support the idea of using extralegal methods to protect cake design. Critics argue that more protection

---

<sup>274</sup> For example, the American Bakers Association could be mediators. See AM. BAKERS ASS'N., <http://americanbakers.org/> (last viewed Dec. 18, 2014). One chef has suggested that simply asking other chefs for their permission to use their ideas might solve the problem of unfair copying and keep peace in the cake design community. *Ask the Cakelady: Is it OK to Copy Someone's Cake Design?*, CAKE MADE BLOG (Aug. 8, 2014), <http://blog.cakemade.com/2014/08/08/ask-the-cakelady-is-it-ok-to-copy-someones-cake-design/> [<http://perma.cc/394L-PDUC>].8, 2014), <http://blog.cakemade.com/2014/08/08/ask-the-cakelady-is-it-ok-to-copy-someones-cake-design/>.

<sup>275</sup> *The black list*, CAKE-THIEF, <http://cake-thief.blogspot.com/p/black-list.html> [<http://perma.cc/AK96-TV9C>] (last visited Jan. 14, 2014).

<sup>276</sup> *Id.*

<sup>277</sup> See David Fagundes, *Talk Derby To Me: Intellectual Property Norms Governing Roller Derby Pseudonyms*, 90 TEX. L. REV. 1093 (2012) (discussing an extralegal system used by roller derby teams to protect their team names. This system has functioned well because the group is “close-knit and the norms are welfare enhancing.”)

means less competition<sup>278</sup> and more expensive products,<sup>279</sup> causing the small companies to suffer. Furthermore, they argue that extending protection could lead to a slippery slope, for if the law begins to protect cake design, then what products cannot be protected?<sup>280</sup> Additionally, critics claim that overprotection can lead to a monopoly.<sup>281</sup>

On the other hand, advocates of intellectual property protection may argue that extending intellectual property protection to cake design will encourage chefs to come up with more creative ideas and add more originality to the world of cake design.<sup>282</sup> Many chefs already strive to be

---

<sup>278</sup> 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 (2009) (arguing that expanding copyright protection to the culinary world would “hinder competition and . . . discourage creativity and innovation . . .”).

<sup>279</sup> Elizabeth Rosenblatt, *Intellectual Property’s Negative Space: Beyond the Utilitarian*, 40 FLA. ST. U. L. REV 441, 454 (2013).

<sup>280</sup> See H.R. REP, *supra* note 59, at 5664 (“The history of copyright law has been one of gradual expansion in the types of works accorded protection . . .”). *But see* Rosenblatt, *supra* note 279, at 485 (noting the negative spaces in today’s intellectual property protection, such as cuisine, fashion, and stand-up comedy). Rosenblatt argues that everything does not have to be protected and is skeptical about expanding formal protection. *Id.* She suggests that there needs to be a balance of exclusivity. *Id.* This argument may be moot, as cakes are already receiving some protection and they are not a brand new category without any history of protection.

<sup>281</sup> ECONOMIST, *supra* note 266 (calling patents “government-enforced monopolies”).

<sup>282</sup> See Jay Qualls, *About Jay*, FROSTED AFFAIR, <http://www.jayqualls.com/about/> [<http://perma.cc/3AVH-CTBF>] (last visited Oct. 17, 2015) (Chef Jay Qualls is noted for his unique sense of style in cake design. “Whether your style is elegant, simple, whimsical, or traditional, he can design a one-of-a-kind cake to accommodate your unique style and taste.”).

imaginative in their designs, and this encouragement may be beneficial.<sup>283</sup> One chef notes that she tries to be original in all of her designs, and if a client asks for a cake with “frills and corset lacing,” she will search for pictures of actual frills and corsets to inspire her, rather than for pictures of cakes with those elements.<sup>284</sup> This allows her to produce a unique idea that she is proud of, a concept that should be spread to the cake design community at large. Additionally, to prevent potential monopolies, courts can protect only those designs that are truly original and punish only those that copy the design exactly.<sup>285</sup> Therefore, a court could protect a unique cake with black and white layers, but would not need to protect a similar yet slightly altered cake, even if the designer had used the black and white cake as inspiration.<sup>286</sup>

---

<sup>283</sup> Scholars have argued that intellectual property law is not necessary to encourage creativity and innovation, and “that being first in the market, the desire of authors to have their works and ideas widely distributed and other factors, provide adequate rewards for the production of [artistic] works without the need for copyright protection.” Peter S. Menell, *Intellectual Property: General Theories*, 2 ENCYCLOPEDIA OF LAW AND ECONOMICS 148130–55 (B. Bouckert & G. Geest, eds. 1999).

<sup>284</sup> Carina, *The BIG Designer, Re creator, Consumer. COPYING and Copyright Debate.*, FACEBOOK (Oct. 1, 2013, 9:37 AM), <https://www.facebook.com/notes/carinas-cupcakes/the-big-designer-re-creator-consumer-copying-and-copyright-debate/711992942148435> [<http://perma.cc/U6PG-75QX>].

<sup>285</sup> See *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003) (holding that inventor only possessed a thin copyright that protected against only virtually identical copying); *Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003).

<sup>286</sup> For example, it is alleged that Kim Kardashian wanted her cake to resemble the tall, layered Royal Wedding Cake. See *Kim Kardashian Copying Will and Kate’s Wedding Cake*, WONDERWALL (Aug. 4, 2011, 5:35 AM), <http://www.wonderwall.com/tv/kim-kardashian-copying-will-and-kates-wedding-cake-1633981.story> [<http://perma.cc/G59K-FU4C>]. However, a comparison of the two

A law that requires this therefore urges creativity and originality, upholding the purpose behind copyright law.<sup>287</sup>

## V. CONCLUSION

If intellectual property protection should change, spreading the word about the available protection could be accomplished if a show such as *Cake Boss* dedicates an episode to outline the available protection for its viewers. National magazines or websites could also disseminate information, describing both the legal and extralegal methods of protection. This would inform all levels of chefs and designers about the law, creating an equal playing field. It is possible that protection is not needed as of now, but as the culinary world continues to change and grow, copying may become no longer expected, but frowned upon, and protection will be more readily utilized. Although design patents are used to protect cake design, this creative expression fits more fairly under the protections of copyright, trademark, or trade secret law. The legal protection that is available for these works of art should be altered and translated to the entire cake design community.

---

cakes shows no infringement, and the Royal cake may have been used only as inspiration. Some chefs have no issue with using others' designs as inspiration, as long the original designer receives credit. See Carmijok, *supra* note 50 (blogger who often makes her own versions of a famous cakes).

<sup>287</sup> This advocacy of innovation promotes the progress of science and arts. U.S. Const. Art. I § 8, cl. 8.