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2013

# Moving Beyond the Standard Criticisms of Design Patents

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# MOVING BEYOND THE STANDARD CRITICISMS OF DESIGN PATENTS

Sarah Burstein\*

CITE AS: 17 STAN. TECH. L. REV. 305 (2013)  
<http://stlr.stanford.edu/standardcriticisms.pdf>

## ABSTRACT

*The U.S. design patent system has been widely criticized. Certain arguments against design patents have been made so often—and accepted so uncritically—that one might believe that the case against design patents was overwhelming and that the failure of the system was beyond dispute. These standard criticisms can be grouped into three main categories: (1) designs aren’t patent subject matter; (2) patent requirements are not “appropriate” for designs; and (3) patent protection is overbroad. This article examines each of these standard criticisms and concludes that they are not persuasive. Therefore, the case that is commonly made against design patents is not as strong as the existing literature suggests. Moreover, these standard criticisms tend to obfuscate, rather than answer, the difficult policy questions raised by any design protection scheme. In order to meaningfully evaluate the current system and proposed alternatives, these questions need to be confronted directly, not hidden behind oft-repeated litanies about the supposed evils of design patents.*

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\* Associate Professor of Law, University of Oklahoma College of Law. Many thanks to Paul Goldstein, Jessica Kiser, Amy Landers, Viva Moffat, Megan Shaner and Elaine Bradshaw for helpful comments on earlier drafts of this article. Thanks also to the participants in the Stanford Design Patents Conference Academic Day, the Twelfth Annual Intellectual Property Scholars Conference and the 2012 Intellectual Property Scholars Roundtable at Drake University Law School for their insightful comments and suggestions. Finally, thanks to Hayes Martin for able research assistance.

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## INTRODUCTION

Design patents have been widely and repeatedly criticized, mainly—though not exclusively—by commentators who believe that the United States should protect designs using copyright or a copyright-like *sui generis* regime.<sup>1</sup> The design patent system has been called “ineffective,”<sup>2</sup> “unworkable,”<sup>3</sup> and “unquestionably a misfit and a failure.”<sup>4</sup> One commentator even went so far as

1. E.g., Barbara A. Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 BULL. COPYRIGHT SOC'Y U.S.A. 25, 25 (1959). Of course, copyright and patent are not the only possible paradigms for design protection. See Annette Kur, *The Green Paper's "Design Approach"—What's Wrong with It?*, 15 EUR. INTEL. PROP. L. REV. 374, 376 (1993) (challenging “the unfortunate but common view that designs must belong either to the patent or the copyright side, *tertium non datur*”). And designs do not necessarily need to be protected as intellectual property. Cf. Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845, 846 (2003) (arguing that “there are sound public policy reasons against extending a property right to most commercial art”). However, consideration of all of the different options for design protection (or non-protection) is beyond the scope of this Article.

2. E.g., Jacques M. Dulin, *Design Protection: Walking the Pirate Plank*, 12 BULL. COPYRIGHT SOC'Y U.S.A. 321, 323 (1965).

3. *Protection of Industrial Designs of Useful Articles: Hearing on H.R. 1179 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the Comm. on the Judiciary*, 100th Cong. 170 (1988) (statement of William T. Fryer, III, Professor, Univ. of Balt.). *But see id.* (statement of Ralph S. Brown, Professor, Yale Univ.) (“I don't agree that design patents are unworkable. They're not easy to get and they shouldn't be easy to get because they do give you a monopoly on that particular design.”).

4. Henry D. Williams, *Copyright Registration of Industrial Designs*, 7 J. PAT. OFF.

to say that, “[v]iewed on a system basis, the design patent is a waste of national resources and a fraud on the public.”<sup>5</sup>

Certain arguments against design patents have been made so often—and accepted so uncritically—that one might believe that the case against design patents was overwhelming and that the failure of the system was beyond dispute.<sup>6</sup> The standard criticisms of design patents can be grouped into three broad categories: (1) designs aren’t patent subject matter; (2) patent requirements are not “appropriate” for designs; and (3) patent protection is overbroad. But despite their frequent repetition and widespread acceptance in the literature,<sup>7</sup> these standard criticisms are not actually very persuasive.

Moreover, the standard criticisms tend to obfuscate, rather than answer, difficult and fundamental policy questions about how—and whether—to protect designs. These questions include:

- What designs, if any, do we want to protect?
- What is the normative basis for any such protection?
- What are the relative merits of using an examination system versus a registration system?
- Should designs be protected by property rules or liability rules?
- Should the law encourage or allow overlapping design rights and product-design trade dress protection?

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Soc’y 540, 540 (1925).

5. William Thompson, *Product Protection Under Current and Proposed Design Laws*, 19 U. BALT. L. REV. 271, 273 (1989).

6. These are not the only criticisms that have been—or could—be made. But their widespread repetition and largely unquestioned acceptance in the literature make them particularly worthy of careful consideration.

7. For years, Perry J. Saidman was a notable exception, staunchly defending the design patent system. *See, e.g.*, Perry J. Saidman, *Design Patents—the Whipping Boy Bites Back*, 73 J. PAT. & TRADEMARK OFF. SOC’y 859 (1991) [hereinafter Saidman, *Whipping Boy*]; Perry J. Saidman & Mark B. Mondry, *Sneakers, Design Patents and Summary Judgments: Opening a New Era in the Protection of Consumer Product Designs*, 71 J. PAT. & TRADEMARK OFF. SOC’y 524, 536 (1989) (arguing that “U.S. designs patents have many benefits which presently make their application in the consumer product arena exceptionally attractive”). But in 2007, he declared “the law of designs [to be] in a state of crisis,” arguing that the “positive attributes of design patents are at best under attack, and at worst are no longer true.” Perry J. Saidman, *The Crisis in the Law of Designs*, 89 J. PAT. & TRADEMARK OFF. SOC’y 301, 304 (2007) [hereinafter Saidman, *Crisis*]. Saidman now advocates the adoption of a European-style design registration system. Perry J. Saidman & Theresa Esquerra, *A Manifesto on Industrial Design Protection: Resurrecting the Design Registration League*, 55 J. COPYRIGHT SOC’y U.S.A. 423, 425 (2008). *But see* Dennis D. Crouch, A Trademark Justification for Design Patent Rights 7, (Aug. 10, 2010) (unpublished manuscript), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1656590](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1656590) (“tentatively reject[ing] the oft-stated conventional wisdom that design patents are worthless for many because they are too slow, expensive and difficult to obtain”).

To be clear, the goal of this article is not to provide answers to all of these questions or a normative evaluation of the current design patent system. Instead, this Article takes an important first step toward addressing those larger issues by critically examining and responding to the standard criticisms of design patents. After all, if—as the standard criticisms suggest—the case against design patents is really so overwhelming, then perhaps we should just abolish them and not waste any more time thinking about reforming or improving the system. But if, on the other hand, the standard case against design patents is not that strong, then perhaps the system deserves closer consideration.

Part I of this Article provides a brief overview of the types of design protection currently available in the United States. Part II examines each of the standard criticisms of design patents and concludes that they are unpersuasive. It also identifies several important policy questions that tend to be obscured by these criticisms. This Article concludes that the standard case that is made against design patents is much weaker than the current literature suggests. It also argues that, in order to meaningfully evaluate the current system and proposed alternatives, we need to debate the underlying policy questions directly instead of hiding them behind the standard criticisms of design patents.

## I. U.S. DESIGN PROTECTION – A BRIEF INTRODUCTION

The category of “design” is a broad one. It can include everything from fashion design to user interface design to industrial design. Discussions about design are complicated by the fact that “[n]o one is quite sure how to define design. Is it a process or a product? Is it a verb or noun?”<sup>8</sup> Indeed, the “variable meaning of the word ‘design’ . . . can be illustrated by a seemingly nonsensical sentence: ‘Design means designers design designs by means of designs.’”<sup>9</sup> In other words, “design” can be a verb, a part of the noun “designers,” a noun “describ[ing] the total activity in an all-embracing and undifferentiated sense,” a noun “refer[ring] to a concept or plan,” or a noun “describ[ing] the realized object.”<sup>10</sup>

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8. JEFFREY L. MEIKLE, *DESIGN IN THE USA* 14 (2005). Indeed, “industrial design”—the type of design that is perhaps most commonly focused on in debates about design protection—has been used in both ways. See CARROLL GANTZ, *THE INDUSTRIALIZATION OF DESIGN: A HISTORY FROM THE STEAM AGE TO TODAY* 1 (2011) (defining “industrial design” as “the external design of products of mass production to make them more attractive, useful, and appropriate to human sensibilities”); EDWARD LUCIE-SMITH, *A HISTORY OF INDUSTRIAL DESIGN* 7 (1983) (defining “industrial design” as “the business of determining the form of objects which are to be made by machines, rather than produced by hand”).

9. John Heskett, *Industrial Design*, in *DESIGN HISTORY: A STUDENTS’ HANDBOOK* 112 (Hazel Conway ed., 1987).

10. *Id.* at 112-13. To make matters more confusing, in Europe, the word “design” has an additional meaning; it is used to describe both the protectable subject matter and the IP right itself. See *FAQs—Community Design: CD General Questions*, OFF. FOR

The last two definitions—“a concept or plan” or “the realized object”—probably align most closely with how the term is generally used in debates about design protection. In the United States, these types of designs can potentially be protected using three different intellectual property (IP) regimes—design patents, copyrights, and trade dress.

### A. *Design Patents*

Since 1842, the United States has protected designs using the patent system.<sup>11</sup> The current Patent Act provides, in relevant part:

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.<sup>12</sup>

Therefore, in order to be patentable, designs must satisfy the general requirements for patentability, including novelty and nonobviousness.<sup>13</sup> A patentable “design for an article of manufacture” may consist of: “(A) a design for an ornament, impression, print, or picture applied to or embodied in an article of manufacture (surface indicia); (B) a design for the shape or configuration of an article of manufacture; [or] (C) a combination of the first two categories.”<sup>14</sup>

Like other patents,<sup>15</sup> design patents are issued by the U.S. Patent and Trademark Office (PTO) following substantive examination.<sup>16</sup> So, getting a

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HARMONIZATION IN THE INTERNAL MKT., <https://oami.europa.eu/ohimportal/en/cd-general-questions> (last visited Dec. 16, 2013) (“1.1. What is a design? The outward appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials and/or its ornamentation.”), *id.* (“1.20. What is the difference between a patent and a design? A patent covers the function, operation or construction of an invention. . . . A design covers the appearance only of a product. A design cannot protect the function of a product.”); *see also Types of IP*, U.K. INTELL. PROP. OFFICE, <http://www.ipo.gov.uk/types.htm> (last visited Dec. 12, 2013) (“Designs protect the appearance of a product/logo, from the shape of an aeroplane to a fashion item.”).

11. *See* Patent Act of 1842, 1842, ch. 263, § 3, 5 Stat. 543. According to the Supreme Court, the purpose of design patents is to promote the decorative arts. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 524-25 (1872). For more on the meaning of the term “decorative arts,” *see* Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169, 172-73 (2012).

12. 35 U.S.C. § 171 (2011).

13. *See* 35 U.S.C. §§ 102, 103. These requirements will be discussed in more detail in Subpart II.B.1 below.

14. *See* U.S. PATENT & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1504.01 (8th ed. Rev. 9, Aug. 2012), *available at* <http://www.uspto.gov/web/offices/pac/mpep/s1504.html#d0e152237>; *see also id.* § 1502.01 (“The ornamental appearance for an article includes its shape/configuration or surface ornamentation *applied to* the article, or both.”).

15. There are three types of patents—utility patents, plant patents, and design patents.

16. *See* 35 U.S.C. § 131 (“The Director [of the PTO] shall cause an examination to be

design patent takes time. In recent years, the average pendency for granted design patent applications has been around 15 months.<sup>17</sup> And “[m]ore than 45% of design patents issued in 2009 had a pendency of less than one year.”<sup>18</sup> For design patents issued through the PTO’s “rocket docket” system in 2007, “the average pendency was approximately 9.2 months.”<sup>19</sup> Getting a design patent also takes money—the applicant must pay various PTO fees<sup>20</sup> and, in most cases, attorney’s fees.<sup>21</sup> According to a survey of American Intellectual Property Law Association (AIPLA) members, the median charge for preparing and filing a design patent application in 2012 was \$1,818.<sup>22</sup>

### B. Copyright

Since at least the mid-twentieth century, some designs have been protected by copyright law.<sup>23</sup> Unlike design patent protection, copyright protection arises

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made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.”). Design patents are examined by examiners with backgrounds “in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts or art teacher education.” See Job Announcement No. CP-2013-0038 (“Design Patent Examiner”), USAJOBS, <https://www.usajobs.gov/GetJob/ViewDetails/347049400> [no longer available] (last visited July 8, 2013) (on file with the author) (describing requirements for entry-level design patent examiner positions). However, people with backgrounds that would qualify them to be design patent examiners are not allowed to sit for the patent bar unless they also have scientific or technical training. See 37 C.F.R. § 11.7 (2013); U.S. PATENT AND TRADEMARK OFFICE, GENERAL REQUIREMENTS BULLETIN 4-9 (2012), [http://www.uspto.gov/ip/boards/oed/exam/GRB\\_march2012\\_forms\\_expire\\_2014\\_Sept\\_30.pdf](http://www.uspto.gov/ip/boards/oed/exam/GRB_march2012_forms_expire_2014_Sept_30.pdf). Although a full discussion of this issue is beyond the scope of this Article, this system tends to systematically exclude lawyers with art and design backgrounds from practicing design patent law. See Sarah Burstein, *Design Patent Myths—on Examiners and Expertise*, FACULTY LOUNGE (Oct. 30, 2013, 8:04 AM), <http://www.thefacultyounge.org/2013/10/design-patent-examiners.html>.

17. See Crouch, *supra* note 7 at 20.

18. *Id.*

19. *Id.* at 23.

20. See *Fee Schedule*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/web/offices/ac/qs/ope/fee031913.htm> (last visited Dec. 12, 2013). For example, the basic design patent filing fee is \$180, which is reduced to \$90 for small entities and \$45 for micro entities. *Id.*

21. It is possible to prosecute a patent application *pro se*. *Pro Se and Pro Bono*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/inventors/proseprobono/index.jsp> (last visited Dec. 12, 2013).

22. AM. INTELLECTUAL PROP. LAW ASS’N, REPORT OF THE ECONOMIC SURVEY 2013, at I-124 (2013).

23. See J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6, 56 (1989) [hereinafter Reichman, *New Technologies*] (“[T]he modern period of design protection in the United States really opened with the landmark case of *Mazer v. Stein* in 1954, in which the Supreme Court first upheld copyright protection for works of applied art.” (footnote omitted) (citing 347 U.S. 201 (1954))).

automatically when a qualifying work is “fixed in any tangible medium of expression.”<sup>24</sup> Copyright protection is, therefore, instantaneous and essentially costless.

Copyrights can be registered with the U.S. Copyright Office.<sup>25</sup> There are a number of significant benefits to registration. For example, the owner of a registered copyright can recover statutory damages and, in some circumstances, attorney’s fees.<sup>26</sup> According to the Copyright Office, it takes “generally, 3 to 4-1/2 months” to process e-filed applications and “generally, 5 to 8 months” for paper applications.<sup>27</sup> And while there are fees, they are modest; it costs only thirty-five dollars to file an electronic application to register a copyright.<sup>28</sup> It costs sixty-five dollars to file a paper application.<sup>29</sup>

Copyright protection extends to certain “original works of authorship.”<sup>30</sup> A work is “original” if it “was independently created by the author (as opposed to copied from other works), and . . . possesses at least some minimal degree of creativity.”<sup>31</sup> Protectable “works of authorship” include “pictorial, graphic, and sculptural works.”<sup>32</sup> This category, sometimes referred to as “PGS works,” includes “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.”<sup>33</sup>

Two-dimensional designs, such as fabric designs, easily qualify for copyright protection. But three-dimensional designs face an additional hurdle. Most consumer products and fashion items are deemed to be “useful articles” under the Copyright Act.<sup>34</sup> And “the design of a useful article . . . [is] considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian

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24. 17 U.S.C. § 102(a) (2011).

25. 17 U.S.C. § 408(a).

26. 17 U.S.C. § 412.

27. *I’ve Submitted My Application, Fee, and Copy of My Work to the Copyright Office. Now What?*, U.S. COPYRIGHT OFF., <http://www.copyright.gov/help/faq/faq-what.html#certificate> (last visited Dec. 12, 2013) (listing its “[c]urrent processing times”).

28. *Fees*, U.S. COPYRIGHT OFF., <http://www.copyright.gov/docs/fees.html> (last visited Dec. 12, 2013) (effective Aug. 1, 2009).

29. *Id.*

30. 17 U.S.C. § 102(a).

31. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citing 1 M. NIMMER & D. NIMMER, COPYRIGHT §§ 2.01[A], [B] (1990)).

32. 17 U.S.C. § 102(a)(5).

33. 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works”).

34. *See id.* (“A ‘useful article’ is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”).

aspects of the article.”<sup>35</sup> This “separability”<sup>36</sup> requirement excludes most product-configuration and fashion designs from copyright protection.<sup>37</sup>

Therefore, this is the category of designs—i.e., designs for the configurations of “useful articles”—that lies at the heart of debates about design protection in the United States. These designs could potentially be protected by design patents but do not qualify for cheap, easy-to-obtain copyright protection under the current Copyright Act. Because this is the category of designs that critics of the design patent system are usually concerned about, this category will be the focus of this Article.<sup>38</sup>

### C. Trade Dress

Since at least the 1970s, designs have enjoyed a third type of protection commonly referred to as product-design “trade dress.”<sup>39</sup> Originally, the term “trade dress” referred to “the overall appearance of labels, wrapper, and containers used in packaging a product.”<sup>40</sup> However, this definition “was expanded in the early 1980s to encompass . . . the shape and design of the product itself.”<sup>41</sup>

The reason for making a semantic distinction between “trademarks” and “trade dress” is largely historical. Early in the development of the law, a distinction was drawn between the law of “trademarks” and the law of “unfair competition,” with the latter encompassing, among other things, trade dress. Today, any such distinctions have largely disappeared. Today, many types of designations protectable as “trade dress” are also registerable as

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35. *Id.* (defining “[p]ictorial, graphic, and sculptural works”).

36. *See, e.g.,* *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922 (7th Cir. 2004) (discussing “physical separability” and “conceptual separability”).

37. Arguably, it should exclude even more. *See generally* Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 896 (1988) (“[C]onceptual separability seems to contradict the unmistakable tenor of both the statute and the passage from the legislative history in which the two words appear. Fairly read, that passage clearly expresses Congress’s intention to deny copyright protection to the shape and configuration of useful articles as a whole.”) (footnotes omitted); Viva R. Moffat, *The Copyright/Patent Boundary*, U. RICHMOND L. REV. (forthcoming 2014) (manuscript at 39), available at <http://ssrn.com/abstract=2273840> (suggesting that “courts . . . abandon their efforts to define and determine ‘conceptual separability’” and adopt “[a] bright-line rule that protects only physically-separable aesthetic elements of useful articles”).

38. Accordingly, unless otherwise noted or used in a quotation, the word “design” will be used for the rest of this Article to refer to a design for the configuration of all or part of anything that qualifies as a “useful article” under the U.S. Copyright Act. *See* 17 U.S.C. § 101.

39. *See generally* Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1022 (2012).

40. J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:1 (4th ed.).

41. *Id.*

“trademarks.”<sup>42</sup>

Consequently, today’s product-design trade dress can be protected as a “trademark” under the Lanham Act.<sup>43</sup> However, product-design trade dress must satisfy some requirements that do not apply to all trademarks. Specifically, to qualify for protection under the Lanham Act, product-design trade dress must be “nonfunctional.”<sup>44</sup> And while, in general, trademarks may be inherently distinctive—and thus protectable upon use in commerce—product-design trade dress can never be inherently distinctive.<sup>45</sup> Therefore, it can only “be protected upon a showing of secondary meaning.”<sup>46</sup>

So under current law, there is significant overlap in the subject matter of trade dress protection and design patents.<sup>47</sup> Although this Article will not focus on product-design trade dress protection, the existence—and wisdom—of this type of protection is relevant to some of the larger policy questions that will be discussed below.<sup>48</sup>

## II. THE STANDARD CRITICISMS OF DESIGN PATENTS

The standard criticisms of design patents can be grouped into three broad categories. To some extent, this categorization is artificial; in practice, these criticisms are often interrelated, sometimes inextricably. However, for ease of discussion and examination, they will be addressed separately.

### A. *Designs Aren’t (or Aren’t Like) Patent Subject Matter*

Some critics have suggested that designs are not (or are not analogous to) patent subject matter. These arguments generally fall into one of two general groups; this Subpart will discuss them in turn.

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42. *Id.* (footnotes omitted).

43. *See* *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001).

44. *See id.* at 32-33.

45. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000) (“[D]esign, like color, is not inherently distinctive.”).

46. *See id.* at 216 (“[I]n an action for infringement of unregistered trade dress . . . a product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning.”); *id.* at 210 (“Distinctiveness is . . . an explicit prerequisite for registration of trade dress . . .”).

47. Whether or not this overlap is desirable—or even constitutional—is beyond the scope of this Article. *See, e.g.*, *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 644-51 (7th Cir. 1993) (Cudahy, J., dissenting) (discussing the constitutional conflict between product-design trade dress protection and design patent protection).

48. *See infra* Subpart II.B.2.a.

1. *Designs are art*

Some commentators have argued that designs—or, at least, some designs—should be considered “art” and, therefore, should be protected by copyright.<sup>49</sup> This argument is often made in the context of fashion designs.<sup>50</sup>

This type of argument appears to be based on the premise that if something is “art,” it should be protected by copyright. But even if copyright has been traditionally understood as protecting “artistic works,”<sup>51</sup> that does not necessarily mean that copyright protection must extend to anything and everything that qualifies as “art.”<sup>52</sup> But even if it did, difficult questions would remain, including who gets to decide what qualifies as “art” and when that decision should be made. Even putative experts such as museum curators are not necessarily disinterested, neutral observers.<sup>53</sup> For example, the Museum of Modern Art’s “good design” initiative was intentionally didactic, with the goal of shaping popular opinion, not reflecting it.<sup>54</sup> And, importantly, art theory is

49. *E.g.*, Daniel H. Brean, *Enough Is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX. INTELL. PROP. L.J. 325, 374 (2008) (“Designs are art. They are the product of creative expression. . . . The best treatment would be to protect designs through copyright law to the extent that they are artistic . . .”).

50. *E.g.*, Arielle K. Cohen, *Designer Collaborations as a Solution to the Fast-Fashion Copyright Dilemma*, 11 CHI.-KENT J. INTELL. PROP. 172, 178-79 (2012) (“It is clear that there has been widespread societal recognition of fashion as a form of art. Therefore, copyright law should fall in line with popular opinion and Congress should expand the interpretation of useful articles and extend [copyright] protection to fashion design . . .”); Biana Borukhovich, Note, *Fashion Design: The Work of Art that Is Still Unrecognized in the United States*, 9 WAKE FOREST INTELL. PROP. L.J. 155, 155-56 (2009) (arguing that fashion is art and, therefore, “should be protected by laws similar to those that protect other kinds of artistic creations”).

51. *Cf.* Berne Convention for the Protection of Literary and Artistic Works art. 2, Sept. 9, 1886, 828 U.N.T.S. 221 (amended Sept. 28, 1979) (indicating that copyright protection should extend to “literary and artistic works”). *But see generally* Neil Weinstock Netanel, *First Amendment Constraints on Copyright After Golan v. Holder*, 60 UCLA L. REV. 1082, 1097 n.63 (2013) (noting that the first American “copyright statute provided only for an exclusive right to copy books, maps, and charts” (citing Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1831))).

52. *Cf.* *Kelley v. Chicago Park Dist.*, 635 F.3d 290, 304 (7th Cir. 2011) (“We fully accept that the artistic community might classify Kelley’s garden as a work of postmodern conceptual art. We acknowledge as well that copyright’s prerequisites of authorship and fixation are broadly defined. But the law must have some limits; not all conceptual art may be copyrighted.”). *But see* Glen Cheng, *The Aesthetics of Copyright Adjudication*, 19 UCLA ENT. L. REV. 113, 114 (2012) (asserting that “[a]ll original artworks should be copyrightable”).

53. *See, e.g.*, JONATHAN M. WOODHAM, TWENTIETH-CENTURY DESIGN 154-55 (1997) (“The twentieth-century design galleries of many museums around the world have their roots in the collection and display of objects which, it was originally felt, would ‘improve’ standards of taste and enhance the cultural well-being of their visitors.”).

54. *See id.* at 156 (stating that the “Good Design” program sought “to educate both the public and manufacturing industry.”); *see also* PENNY SPARKE, AN INTRODUCTION TO DESIGN

dynamic and ideas about what qualifies as “art” change over time. Therefore, art status is a particularly unstable foundation upon which to build a legal rule.<sup>55</sup> So without some type of explanation or theory as to why art status should be dispositive and how or when that status should be decided, this type of argument is ultimately unpersuasive.

Even if a convincing case could be made that art status should be dispositive, the “design is art” argument would still suffer from another flaw. There simply is no broad consensus on the relationship between “art” and “design.”<sup>56</sup> To the contrary, “artists and writers have always disagreed on the relationship of the two from the early days of the Industrial Revolution.”<sup>57</sup> So the question, “Is design art?” is simply not settled.<sup>58</sup>

And even if there were a clear answer, “Is design art?” is still the wrong question. By focusing on whether designs are “art,” these types of arguments obscure a larger, more important question—namely, are there any differences between designs and prototypical copyrightable works (such as sculptures)<sup>59</sup> that would make copyright less appropriate when applied to designs? In other words, is there any reason to treat designs differently for IP purposes? Some commentators have suggested the denial of copyright protection to designs is—or could only be—the result of snobbery or unfair discrimination.<sup>60</sup> However, if

AND CULTURE: 1900 TO THE PRESENT 107 (3d ed. 2013) (“The fear of being overrun by bad taste, associated with an uncontrolled marketplace that threatened an ordered society, was experienced internationally [in the mid-twentieth century]. In the USA, the Museum of Modern Art in New York ran a series of exhibitions, entitled ‘Good Design,’ which aimed to educate the consumer.”).

55. Cf. Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805, 809 (2005) (arguing that the law should not “privileg[e] . . . one particular definition of art” over the others because “[s]uch an approach would reify this definition through the practice of precedent”).

56. See Barbara Bloemink, *On the Relationship of Art and Design—Introduction: Sameness and Difference*, in DESIGN ≠ ART: FUNCTIONAL OBJECTS FROM DONALD JUDD TO RACHEL WHITEREAD 17 (Barbara Bloemink & Joseph Cunningham, eds., 2004) (asking “[i]s there a difference between art and design?” in the catalog of an exhibition held at the Cooper-Hewitt, National Design Museum). Compare, e.g., STEPHEN BAYLEY, IN GOOD SHAPE: STYLE IN INDUSTRIAL PRODUCTS 1900 TO 1960, at 10 (1979) (“Industrial design is the art of the twentieth century.”), with ADRIAN FORTY, OBJECTS OF DESIRE: DESIGN & SOCIETY FROM WEDGWOOD TO IBM 7 (1986) (bemoaning “the confusion of design with art”).

57. David Irwin, *Art Versus Design: The Debate 1760-1860*, 4 J. DESIGN HIST. 219, 219 (1991); see also *id.* (“Today’s discussions on the divide between ‘art’ and ‘design’ are not new.”).

58. Indeed, “[t]he ‘what is art?’ debate has raged for centuries without resolution.” Farley, *supra* note 55, at 808.

59. Cf. Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 518 (2012) (“The paradigmatic copyrightable works are products of pure aesthetics—paintings, sculptures, and sonatas—whose forms are unconstrained by the banalities of utility or function.”).

60. E.g., Peter Nolan, *An Appraisal of Copyright Protection for Useful Articles*, 1982 A.B.A. SEC. PAT. TRADEMARK & COPYRIGHT L. PROC. 216, 216 (1982).

designs (or some subset thereof) are not similarly situated, then it is neither unfair nor unwise to treat them differently.<sup>61</sup>

It would be difficult to argue that there are no differences.<sup>62</sup> Even some critics of the design patent system have acknowledged that there are relevant differences between designs and items that have traditionally been considered “art.”<sup>63</sup>

One important difference is that designers face constraints that traditional artists do not.<sup>64</sup> Product designs, for example, are constrained by the product’s intended utility—a successful design for a chair must actually function as a chair. Due to these types of constraints, the tests developed for prototypical copyrightable subject matter do not necessarily translate well to the context of designs.<sup>65</sup>

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61. Professor Brown argued that “[a]ll kinds of designers . . . ought to be treated equally, unless some ground exists for a variation in treatment.” Ralph Brown, *Copyright-Like Protection for Designs*, 19 U. BALT. L. REV. 308, 321 (1989). He saw “[n]o persuasive reason” to distinguish, for example, between “designers of textile fabrics,” whose creations qualify for copyright, and “designers of modern lighting fixtures,” whose creations (generally) do not. *See id.* However, he did not explain why all designers (or designs) “ought to be treated equally.” *See id.* As discussed, the word “design” covers a broad range of objects and activities. *See supra* Part I. So the mere fact that different types of creations are referred to as “designs” does not necessarily mean that they are similar in all relevant respects. Perhaps instead of asking—as Professor Brown seems to suggest—whether there is a justification for treating different types of designs differently, we should be asking whether there is any justification for treating them all the same.

62. Again, as used here, the word “designs” refers to designs for configurations of items that qualify as a “useful articles” under the U.S. Copyright Act. *See supra* note 38. The following analysis could be very different in other contexts. Consider, for example, surface designs. There is no obvious reason to treat a graphic or pictorial work differently depending on whether it is printed on upholstery fabric or painted on canvas and framed in an art gallery. The design is not bound by utilitarian constraints in either case. Nor is there a risk that IP protection for the design could effectively capture any utilitarian aspects of an underlying product. Therefore, it makes sense that copyright applies to surface designs as well as to traditional paintings.

63. *See, e.g.,* Ringer, *supra* note 1, at 27 (“Straight copyright protection is too broad for designs. . . . It is now generally agreed that designs represent a special type of creative work and that they require a special type of protection—more flexible and easier to acquire than design patent, but shorter and more limited than copyright.”).

64. *See* MEIKLE, *supra* note 8, at 15 (“Constraints are the essence of the design process.”); *see also* Burstein, *supra* note 11, at 172-73 (citing P. Rioux de Maillou, *The Decorative Arts and the Machine*, in *THE THEORY OF DECORATIVE ART: AN ANTHOLOGY OF EUROPEAN AND AMERICAN WRITINGS, 1750-1940*, at 184, 184 (Isabelle Frank ed., David Britt trans., 2000)). Of course, the nature and extent of these constraints may vary depending on the type of design at issue—there may be fewer limits on, for example, an item of *haute couture* than on an item of furniture.

65. *See, e.g.,* Note, *Protection for the Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520, 1532 (1959) (observing that, due to various constraints imposed on designers, nonliteral similarity may not be nearly as probative of copying “with respect to utilitarian designs than with respect to other subjects of copyright”).

And, as Professor Gerard Magliocca has noted, these constraints can affect the relative costs and benefits of IP protection:

There are an almost infinite number of ways to express an abstract idea, such as justice or love, through the purely esthetic means that are the focus of copyright. Thus, copyright law rarely denies protection to this kind of incremental improvement because there is no cost imposed on others by having some of these expressions owned by private parties. By contrast, there is a finite set of possible esthetic designs for something like a car or a vacuum cleaner. That does not mean that the supply of design options is small; it just says that it is smaller than the alternatives to a typical copyright. In other words, there is a greater cost imposed on future creators by protecting marginal improvements in design than there is from protecting incremental innovations that are purely esthetic.<sup>66</sup>

So, even if we assume that copyright law reflects a proper balance of costs and benefits in the context of prototypical copyrightable works,<sup>67</sup> the same will not necessarily be true for designs.<sup>68</sup>

Architecture and design historian Adrian Forty has pointed out another potentially important distinction between art and industrial design:

[A]rt objects are usually both conceived and made by (or under the direction of) one person, the artist, whereas this is not so with manufactured goods. Both conceiving and fabricating their work allows artists considerable autonomy, which has led to the common belief that one of art's main functions is to give free expression to creativity and imagination. Whether or not this is an accurate view of art, it is most certainly not true of design. In capitalist societies, the primary purpose of the manufacture of artefacts, a process of which design is a part, has to be to make a profit for the manufacturer. Whatever degree of artistic imagination is lavished upon the design of objects, it is done not to give expression to the designer's creativity and imagination, but to make the products saleable and profitable. Calling industrial design 'art' suggests that designers occupy the principal role in production, a misconception which effectively severs most of the connections between design and the processes of society.<sup>69</sup>

This distinction could have a number of important implications for IP policy. For example, it suggests that a designer might not have the same type of personality interests in a design that a painter might have in a painting.<sup>70</sup> And that might

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66. Magliocca, *supra* note 1, at 880.

67. This is, of course, a large assumption.

68. *See generally* Magliocca, *supra* note 1, at 880 (arguing that this difference in costs to future creators "explains why . . . the argument that designs and copyrights should be given similar protection is unsound").

69. FORTY, *supra* note 56, at 7 (referring to this as a "crucial distinction").

70. *See generally* Jeanne C. Fromer, *Expressive Incentives in Intellectual Property*, 98 VA. L. REV. 1745, 1753 (2012) ("Personhood theories [of IP] . . . establish intellectual property protection as a moral right of sorts, but unlike labor-desert approaches, they see a creative work as a Hegelian extension of the author's personality." (citing Jeremy Waldron, *THE RIGHT TO PRIVATE PROPERTY* 4 (1988); Margaret Jane Radin, *Property and Personhood*, 34 STAN. L.

affect the way we choose to calibrate any IP incentives.<sup>71</sup> Of course, it would be possible to argue that these types of differences are immaterial or otherwise unimportant.<sup>72</sup> But such arguments should be made expressly, not assumed away by narrowly focusing on whether or not designs (or some subset of designs) should be considered “art.”

There is an additional, more pragmatic problem with these types of arguments. It has long been recognized that full copyright protection would provide an excessive scope of protection for designs.<sup>73</sup> A number of commentators have argued that instead of full copyright, designs should be granted only a short-term right to prevent copying akin to the 17 U.S.C. § 106(1) reproduction right.<sup>74</sup> But, if such *sui generis* protection were based on the premise that designs are “art” and, therefore, “deserve” copyright, then it would be difficult to justify any such limitations. So even if Congress passed a limited design-protection statute, it could be difficult to “hold the line,” so to speak, against future calls for “equal rights for design.”<sup>75</sup> This is not just a hypothetical

REV. 957, 957 (1982))).

71. See generally *id.* at 1809 (arguing that originality can be seen as an “expressive incentive” because “[i]t communicates to authors that it will protect works infused with the author’s personality”); *id.* at 1807 (“Copyright law’s originality requirement, while not protective of authors’ moral-rights interests in any substantive way, helpfully expresses solicitude for them.”).

72. At least one commentator has argued that function-related constraints do not really distinguish design from painting. See Roy V. Jackson, *A New Approach to Protection for the Designs of New Products*, 38 J. PAT. OFF. SOC’Y 448, 454 (1956). Jackson argues that “[j]ust as the painter cannot express his ideas with colours that do not exist in his palette, or beyond the two dimensional plane of his canvas, the designer is hedged in by inflexible properties of materials, techniques of production and mechanical laws.” *Id.* However, this argument seems premised on an unduly narrow understanding of what constitutes ‘painting,’ ignoring the possibilities of mixing pigments, using shaped canvases, painting on surfaces other than canvas, and innumerable other possibilities.

73. E.g., *Protection of Indus. Designs of Useful Articles: Hearing on H.R. 1179 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the Comm. on the Judiciary*, 100th Cong. 33 (1988) (prepared statement of Ralph Oman, Register of Copyrights) (arguing that full copyright is “inappropriate for the protection of most industrial designs,” because “the term of protection under copyright would be too long for the majority of designs, and the scope of protection would be too broad”); Alan Latman, *The Status and Impact of Design Piracy*, 2 PAT. TRADEMARK & COPYRIGHT J. RES. & EDUC. 286, 287 (1958) (stating that “copyright may afford too much” protection for designs).

74. E.g., Ringer, *supra* note 1, at 30-32 (arguing in favor of a bill that would give design owners, essentially, the right to prevent unauthorized reproduction and stating that “nearly everyone agrees that [the then-existing copyright law] is inappropriate” for design protection because, among other reasons, “[f]ifty-six years protection is much too long”).

75. See, e.g., Michelle Ogundehin, *Equal Rights for Design, Achieved!*, *Editor’s Blog*, ELLE DECORATION U.K. (May 23, 2012), <http://www.elledecoration.co.uk/editors-blog/wedid-it-press-release-from-the-design-council> (discussing the magazine’s “Equal Rights for Design” campaign and the subsequent amendment of UK copyright law). But see *Queen’s Speech*, ANTI COPYING IN DESIGN (May 8, 2013), <http://www.acid.uk.com/news-article/items/queens-speech.html> (arguing that the changes made in the wake of Elle Decoration UK’s

possibility. Similar arguments have been made recently in the UK, apparently with some success.<sup>76</sup> For all of these reasons, the standard criticisms that are based on the premise that design is “art” are not convincing.

## 2. *Designs are more like art than engineering*

Some commentators have argued that designs are more like art than useful inventions and, therefore, should be protected by something that looks more like copyright than patent. For example, Professor Orit Fischman Afori has argued that “a design is a creation of similar nature to artistic works”<sup>77</sup> and that “[d]esigning is an activity of human imagination [that] is of a different order than inventing a technical device or achieving a scientific outcome.”<sup>78</sup> Therefore, “consistency with the perception that an anti-copying right is necessary for encouraging creativity [for works of art] must lead to acknowledging the same right with respect to designs.”<sup>79</sup> According to Professor Afori, this follows from “the simple logic of protecting similar subject matters with a similar right.”<sup>80</sup>

This “simple logic” has a great deal of intuitive appeal; however, it is complicated by the breadth of the category of “design.”<sup>81</sup> Some designs do seem to be much more like art than like engineering. For example, the *Masters Chair*, designed by Philippe Starck and Eugeni Quittlet, is undeniably artistic.<sup>82</sup>

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“Equal Rights for Design” campaign did not go far enough and would not make a practical difference for most designers).

76. See Ogundehin, *supra* note 75; see also discussion *infra* Subpart II.B.3.c.

77. Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1107 (2008). At certain points in this article, Professor Afori suggests that design is not only “like art” but is, in fact, “art.” *Id.* at 1116 (“[D]esign nowadays is already acknowledged as art.”); *id.* at 1106-07 (“[D]esign has become the new art of industrial and technological culture.”). However, she does draw distinctions between “art” and “design.” *E.g.*, *id.* at 1107 (“Nevertheless, design has a different nature from a pure imaginary work of art, since it is also dictated by features stemming from function, technology and fashion.”). The overall thrust appears to be that design is more like art than engineering. But, in any case, it does not appear that her analysis hinges on whether or not design is “art” or is merely “like art.”

78. *Id.* at 1133.

79. *Id.* at 1134.

80. *Id.*

81. See *supra* Part I.

82. *Philippe Starck for Kartell*, ARTTRAV (Nov. 3, 2010, 9:27 AM), <http://www.arttrav.com/wp-content/uploads/2010/11/starck-Masters.jpg> (last visited Dec. 12, 2013).



On the other hand, consider this “mailbox nut”.<sup>83</sup>

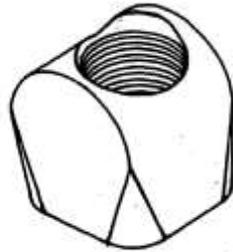


Figure 2a

At first, it may seem to be more creative or ornamental than the average nut. However, its shape appears to be largely—if not entirely—designed to fit in a particular configuration, as can be seen in this diagram:<sup>84</sup>

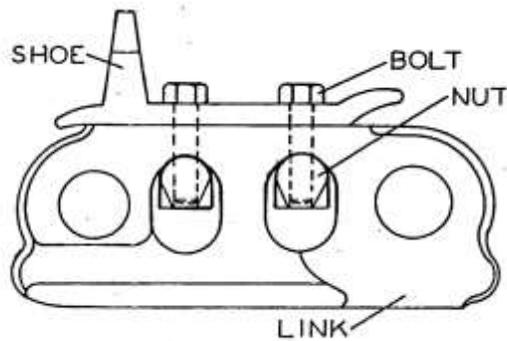


Figure 1

It is difficult to argue that this nut is more like art than like a mechanical invention. Yet it has been used as an example of the type of design that should

83. Thompson, *supra* note 5, at 285 (discussing this piece of hardware); *id.* at 306 (showing illustration).

84. *Id.* at 305.

be protected using a copyright-like *sui generis* law.<sup>85</sup>

Because the category of design is so broad, any arguments based on sweeping analogies between designs and prototypical patent or copyright subject matter are ultimately unpersuasive. Design protection could be limited to designs that are artistic or ornamental,<sup>86</sup> but that raises a larger question of what, precisely, do we want to protect? Do we want to protect anything that falls under some definition of “industrial design”? Or some different set of “designs”?

Moreover, even if the process of creating designs is different from “inventing a technical device or achieving a scientific outcome,”<sup>87</sup> that does not necessarily mean that it is completely—or even mostly—like creating art.<sup>88</sup> Indeed, industrial designers tend to bristle at any suggestion that their job is all about aesthetics.<sup>89</sup> And even if designs are, in fact, more like art than engineering, that still would not answer the larger question discussed above—is there any reason to treat designs differently from art in the context of IP law?

### B. *Patent Requirements Are Not “Appropriate” for Designs*

Commentators have repeatedly argued that the requirements for design patent protection are “inappropriate” for designs.<sup>90</sup> They have criticized both the

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85. *See id.* at 285 (suggesting that this is an example of a design “that might reasonably be protected and that provides an acceptable balance between the rights of the original designer and those who might want to supply an alternative” product).

86. That is, designs that are “created for the purpose of ornamenting.” *See In re Carletti*, 328 F.2d 1020, 1022 (C.C.P.A. 1964). Although the Patent Act requires that patentable designs be “ornamental,” the U.S. Court of Appeals for the Federal Circuit “has effectively read out of the statute any affirmative requirement that the patentee’s design contain aesthetic ornamental features.” Buccafusco, *supra* note 59, at 527; *see also* Sarah Burstein, *Design Patent Myths—Only Artistic Designs Can Be Patented*, FACULTY LOUNGE (Oct. 16, 2013, 9:24 AM), <http://www.thefacultyounge.org/2013/10/design-patent-myths-only-artistic-designs-can-be-patented.html>.

87. Afori, *supra* note 77, at 1133.

88. *But see* Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 433 (2011) (arguing design is “essentially an art form”). Mueller and Brean argue that “design is more akin to an art form,” *see id.* at 438, based on interviews they conducted with designers, who said things like, “industrial design is not a science,” *id.* at 438 n.79, and who “express[ed] the view that industrial designers are right-brained, non-linear thinkers,” *id.* However, this analysis appears to reflect a false binary between science/engineering and “art.”

89. *Cf.* GANTZ, *supra* note 8, at 1 (deploring books that “tend to emphasize only design’s stylistic and esthetic aspects,” and arguing that “[t]his narrow practice simplistically reduces designs to ‘works of art’ and denies their inherent multidisciplinary context, which includes business, psychological, mechanical, innovative, and promotional aspects”).

90. *E.g.*, Albert C. Johnson, *Where Is the Protection for Creative Product Design?*, 19 U. BALT. L. REV. 191, 191 (1989) (“[T]he procedures and determinations required for the procurement and enforcement of design patents are inappropriate for ornamental designs.”).

substantive<sup>91</sup> and procedural<sup>92</sup> requirements and argued that, as a result of these requirements, the design patent regime excludes too many designs.<sup>93</sup> This Subpart will consider those requirements in turn.

### 1. *Substantive requirements*

Commentators have frequently criticized the substantive requirements of design patent protection.<sup>94</sup> Two requirements—novelty and nonobviousness—have received the most criticism.<sup>95</sup>

#### a. *Novelty*

To be patentable, a design must be “novel.”<sup>96</sup> In the context of designs, this means that:

[A] design cannot be “substantially the same” as a prior design, when viewed by “an ordinary observer, giving such attention as a purchaser usually gives.” If the appearance of the new design “is such as to deceive such an observer, inducing him to purchase [the new design] supposing it to be the other,” then the design is not novel.<sup>97</sup>

This requirement has been repeatedly criticized. For example, Professor Afori has argued that:

The high standard of novelty for patents is completely incompatible with design’s subject matter . . . . Designs are concerned with the aesthetic appearance of products, and therefore designs are always based on parameters set by the product and prior knowledge. Furthermore, aesthetics are actually concerned with “art.” Novelty is an absolute criterion in the sense that a novel subject matter must not have been anticipated by anything previously in existence anywhere and at any time. Thus, a novelty threshold is irrelevant to

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91. *E.g.*, Ringer, *supra* note 1, at 25-26 (listing as the “basic deficiencies” of the design patent law “[t]he requirement of novelty” and “[t]he requirement of ‘invention’”). These arguments are often made alongside the subject matter arguments discussed above in Subpart III.A.

92. *E.g.*, Dulin, *supra* note 2, at 323 (“Design patents have proven notoriously ineffective as a means of protection [for designs] for two reasons. First, the examination procedure in the Patent Office usually takes longer than the critically short design lifetime. Second, courts require the presence of ‘invention’ as in the case of a utility patent.”).

93. *E.g.*, J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2460 (1994) [hereinafter Reichman, *Legal Hybrids*].

94. *E.g.*, Dratler, *supra* note 37, at 892 (asserting that “patents are ordinarily useless for industrial designs” due to “the high standards required for patent protection”).

95. *See, e.g., id.* at 892-93.

96. 35 U.S.C. § 102(a) (2011); *see also id.* § 171 (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

97. Burstein, *supra* note 11, at 175 (footnotes omitted) (quoting *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009)).

the assessment of “art.”<sup>98</sup>

But even if “novelty . . . is irrelevant to the assessment of art,” there is no reason why the requirements for design protection must include any such assessment. It is possible to determine whether something is actually new—or new enough—to merit legal protection without assessing whether or not it is “good” in some measurable sense. Moreover, this argument appears to be based, at least in part, on the premise that all designs are (at least mostly) aesthetically driven. But, as discussed above, that premise is by no means clearly established.<sup>99</sup>

Similarly, Roy V. Jackson has argued that a novelty requirement should not be applied to designs because “the novelty of a design (unlike the novelty of a useful idea) has no particular value to the State.”<sup>100</sup> But even if one accepts the premise that novelty has “no particular value” to the government in and of itself, there are still good reasons why design protection should be limited to novel designs. If the law protected both novel and non-novel designs, it would be difficult to tell if the accused infringer copied from the claimed design or the public domain.<sup>101</sup> This could create a high risk of evidentiary errors and chill legitimate competition. Therefore, these types of attacks on the novelty requirement are ultimately unpersuasive.

b. *Nonobviousness*

In addition to being novel, a patentable design must be nonobvious.<sup>102</sup> Section 103 of the Patent Act provides that:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.<sup>103</sup>

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98. Afori, *supra* note 77, at 1135-36 (footnotes omitted).

99. *See supra* Subpart II.A.1.

100. *See* Jackson, *supra* note 72, at 458.

101. *Cf.* Note, *Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807, 813 (1971) (“The normal test for infringement is ‘whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.’ Thus, despite the difficulty of distinguishing between ideas and expression in commercial copyright cases, the court is forced to formulate its judgment on the basis of an overall impression—precisely the level at which the public domain elements are most likely to predominate.” (footnote omitted) (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966))).

102. 35 U.S.C. § 103 (2011); *see also id.* § 171 (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

103. 35 U.S.C. § 103.

In other words, a patentable design must not only be new, it must be *sufficiently* new.<sup>104</sup> This Subpart will discuss the two main criticisms of applying § 103 in the context of designs.

i. *Section 103 is an “onerous” requirement*

The main criticism of this requirement is that it is unduly “onerous.”<sup>105</sup> Commentators have argued that § 103 inappropriately excludes “the bulk of all”<sup>106</sup> or, at least, “many”<sup>107</sup> industrial designs from protection. But even if that was true at some point in the past, it is not true today. Under the current law, nonobviousness is not a “substantial hurdle,”<sup>108</sup> let alone “onerous.”<sup>109</sup>

Under the current law, “[t]he ultimate inquiry in an obviousness analysis is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.”<sup>110</sup> This involves a two-step process:

When assessing the potential obviousness of a design patent, a finder of fact employs two distinct steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “[o]nce this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.”<sup>111</sup>

The first step in this process—the identification of a proper “primary reference”—is particularly important. If there is no primary reference, then the

104. Some critics of the design patent system have suggested that nonobviousness must be a measure of “the aesthetic success of a product’s external design” or “the extent of an advancement in design.” *E.g.*, Mueller & Brean, *supra* note 88, at 425. Although such glosses have been applied to § 103 (and its predecessor requirement, “invention”) in the utility patent context, that does not necessarily mean that those glosses must be applied in the design patent context. *See generally* Burstein, *supra* note 11, at 175 n.28.

105. Saidman & Esquerra, *supra* note 7, at 424-25. *But see* Perry J. Saidman, *The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It*, 19 U. BALT. L. REV. 167, 181-83 (1989) [hereinafter Saidman, *Glass Slipper*] (defending the nonobviousness requirement).

106. Reichman, *Legal Hybrids*, *supra* note 93, at 2460 (citing Reichman, *New Technologies*, *supra* note 23, at 24-25, 53-56).

107. David Goldenberg, *The Long and Winding Road: A History of the Fight over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC’Y U.S.A. 21, 22 (1997) (“The problem with a design patent for many designers is that many industrial designs are not inventive, although they do represent a new product in the market.”).

108. *See* Mueller & Brean, *supra* note 88, at 434.

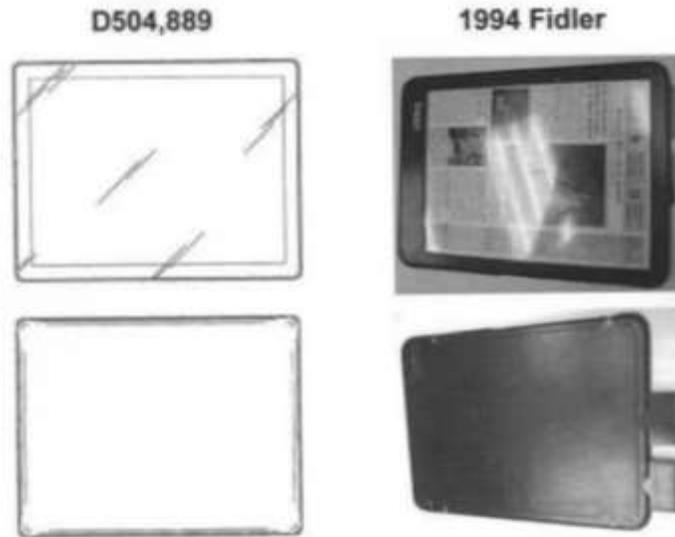
109. Saidman & Esquerra, *supra* note 7, at 424-25.

110. *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1312 (Fed. Cir. 2013) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)) (internal quotation marks omitted).

111. *Id.* (quoting *Durling*, 101 F.3d at 103 (alterations in original)).

design patent cannot be invalidated as obvious.<sup>112</sup>

Recently, however, the Federal Circuit has been making it increasingly difficult for anything to qualify as a proper primary reference. For example, in the first *Apple v. Samsung* appeal, the Federal Circuit held that the reference shown below was not a proper primary reference for Apple's claimed tablet design<sup>113</sup>:



Although these designs are not identical, they are extremely similar.<sup>114</sup> But, according to the Federal Circuit, they are not similar enough.<sup>115</sup>

112. See *Durling*, 101 F.3d at 105 (“Without . . . a primary reference, it is improper to invalidate a design patent on grounds of obviousness.”).

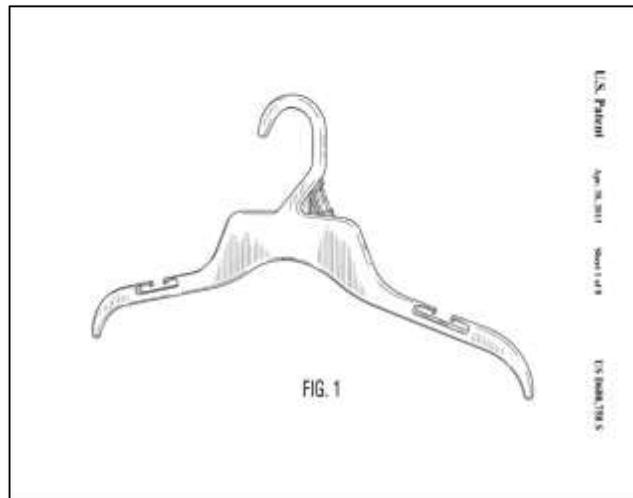
113. *Apple, Inc. v. Samsung Elecs. Co., Ltd.*, 678 F.3d 1314, 1330 (Fed. Cir. 2012).

114. At least one observer opined that they “create almost identical visual impressions.” Rebecca Tushnet, *Brand Dilution as a Design Patent Theory of Harm*, REBECCA TUSHNET’S 43(B)LOG (May 16, 2012, 11:34 AM), <http://tushnet.blogspot.com/2012/05/brand-dilution-as-design-patent-theory.html>.

115. See *Apple*, 678 F.3d at 1331 (“Based on the differences between the Fidler tablet and the D’889 design, we hold that the Fidler tablet does not give the same visual impression as the D’889 patent . . .”). It has never been precisely clear how similar a reference must be to be deemed to be “basically the same” as the claimed design—i.e., how similar it must be to be deemed a proper primary reference. But it is clear that “basically the same” must be different—and, specifically, less similar—than “substantially the same.” If a prior design is “substantially the same” as a claimed design, the claimed design will be anticipated. See *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (citing *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871)). And if a design is anticipated, nonobviousness does not even come into play. See *generally* 35 U.S.C. §§ 102, 103 (2011).

So, under the current law, the bar for invalidating a design patent under § 103 is quite high. If the Federal Circuit continues to require such a high degree of similarity between claimed designs and primary references, § 103 will bar few—if any—designs from patentability.<sup>116</sup>

The Federal Circuit's strict interpretation of the primary reference requirement may explain, at least in part, why the PTO has been issuing design patents for so many apparently obvious designs lately.<sup>117</sup> This patent was recently issued for a "Garment Hanger"<sup>118</sup>:

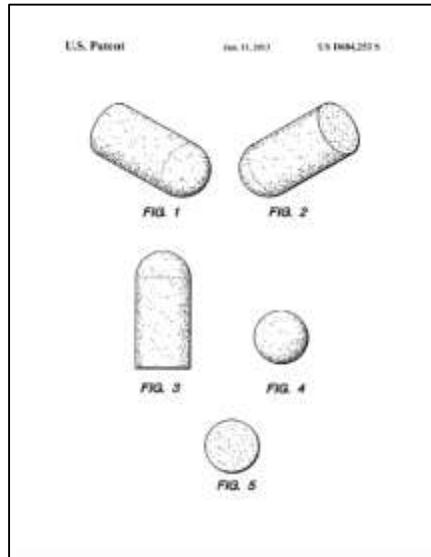


116. This low bar also applies in the prosecution context. *See generally* Burstein, *supra* note 11, at 202-05 (discussing Vanguard Identification Sys., Inc. v. Kappos, 407 F. App'x 479, 480 (Fed. Cir. 2011) (per curiam)).

117. Some of these, including the examples that follow, do not seem to be even plausibly novel. *See generally supra* Subpart II.B.1.a (discussing the requirement of novelty).

118. U.S. Patent No. D680,758 (filed Nov. 29, 2012).

As was this one, which claims a “Cylinder Earplug”<sup>119</sup>:



So was this one, which claims a “Bottle.”<sup>120</sup>



Admittedly, these design patents have not yet been tested in litigation. But *Apple*

119. U.S. Patent No. D684,253 S (filed Feb. 24, 2011).

120. U.S. Patent No. D675,098 S (filed Jun. 13, 2011).

v. *Samsung* suggests that even designs like these could be difficult to invalidate under § 103. And these are not isolated or rare examples; the PTO issues design patents for similarly trivial and/or uncreative designs every week.<sup>121</sup>

If designs like these can be patented, it is difficult to argue that the substantive requirements are rigorous at all—let alone onerous.<sup>122</sup> So, to the extent that criticisms of the nonobviousness requirement are based on the premise that it is onerous, those criticisms are not at all persuasive.

ii. *Nonobviousness is a conceptual misfit.*

A number of commentators have argued that applying § 103 to designs simply does not make sense, as a conceptual matter.<sup>123</sup> These types of arguments appear to be based on the premise that designs are—or are more like—art.<sup>124</sup> As discussed above, however, that premise is highly questionable.<sup>125</sup> And even if the concept of nonobviousness is a bad conceptual fit in the context of designs, that does not mean that copyright's "originality" standard would be a better fit.

Indeed, the idea that a protectable design must not only be new, but new *enough*, is not an entirely foreign concept to design law. Historically, many design-protection laws have included some type of novelty-plus requirement.<sup>126</sup> And today, the European design-protection regime only protects designs that have "individual character" in addition to being novel.<sup>127</sup> Additionally, the latest U.S. fashion-protection bill would have only extended protection to "original elements of [an] article of apparel . . . that . . . provide a unique, distinguishable,

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121. See generally Sarah Burstein, DESIGN LAW, <http://design-law.tumblr.com> (collecting, among other things, examples of newly-issued design patents).

122. This is not to say that it should be difficult to invalidate designs under § 103, only that—at least under the current law—it is difficult to do so.

123. See, e.g., Ringer, *supra* note 1, at 26 ("[V]iewed objectively a design certainly seems closer to the concept of 'the writing of an author' than to that of 'the discovery of an inventor.' To impose on designs the standards of invention required by the patent law appears conceptually and philosophically inappropriate.").

124. See *id.*; Mueller & Brean, *supra* note 88, at 466, 433 (criticizing the "the conceptual misfit in applying nonobviousness to designs," apparently based—at least in part—on their conclusion that design is "essentially an art form"). This type of argument is also sometimes based on the idea that all of the judicial glosses from the utility patent context must be imported to the design context. See *supra* note 104.

125. See *supra* Subpart II.A.

126. Reichman, *New Technologies*, *supra* note 23, at n.87 ("Besides th[e] requirement of novelty in the sense of an absence of references to prior art, most design laws superimpose some qualitative standard as well, which is either cast in terms of 'originality' or as a subtest of the general novelty requirement.").

127. Council Regulation 6/2002, II art. 4(1), 2001 O.J. (L 3) 1 (EC); see also UMA SUTHERSANEN, DESIGN LAW: EUROPEAN UNION AND UNITED STATES OF AMERICA 114-21 (2d ed., 2010) (discussing how the "individual character" requirement has been interpreted and applied).

non-trivial and non-utilitarian variation over prior designs for similar types of articles.”<sup>128</sup> This standard is reminiscent of some judicial interpretations of § 103’s predecessor requirement, “invention,” in the context of design patents.<sup>129</sup> So it’s difficult not to wonder if “the same rose by any other name would smell as sweet.”<sup>130</sup>

## 2. *Procedural requirements*

Commentators have repeatedly lamented the “the long and costly process of” patent prosecution.<sup>131</sup> It is not difficult to see why expense and delay would be “unpopular”<sup>132</sup> with those who seek design rights. As Professor Ralph Brown observed:

The requirement that the PTO search the prior art, and make a judgment regarding obviousness and novelty makes the process inescapably tedious and expensive. Despite strenuous efforts in recent times to surmount the backlog and accelerate the search process, it still can take eighteen months to two years before a design patent is approved or denied. In addition, substantial application and lawyers’ fees must be paid. It is not difficult to envision, therefore, why designers yearn for a system that combines low search costs and high speed.<sup>133</sup>

But the mere fact that designers (or their employers) might want faster, cheaper rights does not mean that granting such rights would be good for society as a whole.<sup>134</sup> This Subpart will examine the main criticisms that have been made about the cost and length of design patent prosecution.

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128. Innovative Design Protection Act of 2012, S. 3523, 112th Cong. § 2(A)(1) (2012).

129. *Compare id.*, with Burstein, *supra* note 11, at 178-79.

130. *See* Harry R. Mayers, *Proposed Legislation for the Protection of Ornamental Design*, 7 BULL. COPYRIGHT SOC’Y U.S.A. 32, 37 (1959) (“It is perhaps unfortunate that this minimum degree of creativity has been called ‘invention,’ in analogy to the test applied to mechanical patents, but the same rose by any other name would smell as sweet to a prospective defendant in design litigation.”); *see also id.* at 36 (“Since [1850] . . . , a requirement of inventive creativity as a condition of patentability has been an essential feature of our patent system. I predict that in the long run society will demand that a similar requirement be met by any scheme devised for the general protection of ornamental designs.”).

131. *E.g.*, Afori, *supra* note 77, at 1135. *But see* Saidman & Mondry, *supra* note 7, at 537 (arguing that “[t]he total cost of a design patent in many cases is relatively insignificant when compared with the millions of dollars in sales of consumer goods being protected”).

132. *See* Brown, *supra* note 61, at 309-10 (“[I]t is not the nonobvious requirement that makes design patents unpopular; it is, rather, the patent process itself.”).

133. *Id.* at 310 (citing William T. Fryer, *Industrial Design Protection in the United States of America—Present Situation and Plans for Revision*, 19 U. BALT. L. REV. 198 (1989)).

134. *Cf.* Kal Raustiala and Christopher Sprigman, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201, 1222 (2009) (“[S]ome might argue that the proper legal regime in a given economic domain ought to reflect the stated preferences of the regulated industry. We disagree with this producerist perspective in general: it ignores consumer interests and therefore cannot fairly assess policy in terms of overall social welfare.”).

a. *Obtaining a design patent takes too long*

Critics argue that it “take[s] too long” to get a design patent.<sup>135</sup> The average length of time it takes to get a design patent has varied significantly over time.<sup>136</sup> But the actual amount of time does not seem to be essential to this criticism. Commentators have complained that the process took “too long” whether it took “almost 2.5 years,”<sup>137</sup> “around 2 years,”<sup>138</sup> “over twenty months,”<sup>139</sup> “about one year,”<sup>140</sup> “four to six months”<sup>141</sup> or “one to two months.”<sup>142</sup> In the 1930s, representatives from the silk industry told Congress that “even twenty-one days was too long”<sup>143</sup> and that they needed protection within seven days.<sup>144</sup> So this criticism seems to boil down to an argument that *any* delay in the acquisition of design rights is “too long.” Indeed, some commentators have made this point directly, arguing that “instantaneous protection on creation” is “essential” for industrial designs.<sup>145</sup>

A number of commentators have suggested that quick protection is necessary because many designs have short commercial lives.<sup>146</sup> These types of

135. See, e.g., Fryer, *supra* note 133, at 198 (“The present [design patent] systems take too long to provide protection.”).

136. See Crouch, *supra* note 7, at 21-22 (charting average pendency rates over time).

137. See Fryer, *supra* note 133, at 834 (“Another factor decreasing the usefulness of the design patent system is the time it takes to obtain [a design patent], an average of almost 2.5 years.” (citing U.S. DEP’T OF COMMERCE, 1986 PTO ANNUAL REPORT 46, 21(1987))).

138. Saidman, *Crisis*, *supra* note 7, at 331.

139. Dratler, *supra* note 37, at 894 (citing Donald J. Quigg, PTO Commissioner, Speech Before American Bar Association in New York (Aug. 21, 1986), in 32 Pat. Trademark & Copyright J. (BNA) 436, 437); *id.* (arguing “[f]or most designs,” this is “too long”).

140. See Ringer, *supra* note 1, at 25-26; see also Saidman, *Crisis*, *supra* note 7, at 332 (arguing that even “1 year” is “unacceptably long for many designs”).

141. *The Vestal Bill for the Copyright Registration of Designs*, 31 COLUM. L. REV. 477, 484 (1931); see also *id.* at 477-78 (“[T]he apparently adequate protection afforded by the Design Patent Law is limited by practical obstacles of time and expense. At present, it probably takes from four to six months to secure a design patent . . .”).

142. Goldenberg, *supra* note 107, at 39.

143. *Id.* at 39.

144. See *id.* at 37-38 (citing, inter alia, *Copyright Registration of Designs: Hearings on H.R. 11852 Before the Senate Comm. on Patents, 71st Cong., 2d Sess.* 19 (1930) (statement of Horace B. Cheney)). It appears that at least one bill incorporated this “seven day registration” requirement. See *id.* at 43 (referring to H.R. 2860, 80th Cong. (1947) (first introduced as H.R. 5887 in 1946)).

145. E.g., *Protection of Industrial Designs of Useful Articles: Hearing on H.R. 1179 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the Comm. on the Judiciary*, 100th Cong. 118 (1988) (written statement of William T. Fryer, III, Professor, Univ. of Balt.).

146. E.g., Christopher P. Bussert, *Copyright Law: A Review of the “Separability Test” and a Proposal for New Design Protection*, 10 RUTGERS COMPUTER & TECH. L.J. 59, 67-68 (1983-1984) (calling design patent a “resounding failure” because of “the delay in receiving the design patent”); *id.* at 68 (“Immediate protection . . . was often crucial . . . because of the

arguments often seem to assume that producers cannot seek design patent protection until a product is launched or otherwise disclosed to the public.<sup>147</sup> But that is not the case.<sup>148</sup> Unlike trade dress protection, there is no requirement that a design be “used in commerce” prior to applying for a design patent.

In a similar vein, Harry F. Manbeck, Jr., then-Commissioner of Patents and Trademarks, argued that “withholding the design from the market until the patent issues, is impractical in many industries where styles change rapidly, even seasonally.”<sup>149</sup> But if a design has to be launched quickly to prevent it going out of style, that suggests the design’s value comes mostly—if not entirely—from some larger trend. Truly pioneering designs would seem to have a longer “shelf life.” Such designs could, at least in theory, be withheld from the market until a patent issues. So the delay caused by design patent examination might actually serve to weed out less-innovative designs from the design patent system by discouraging their designers from even applying for protection.

Moreover, in trend-driven industries, making IP rights available more quickly and easily could actually be counterproductive. In the fashion industry, for example, “freedom to copy is vital, because copying drives the trend cycles that in turn drive consumption of fashion.”<sup>150</sup> And even in the fashion industry, which is often held up as the prototypical example of an industry in which designs go in and out of style too quickly for design patents,<sup>151</sup> designers can

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relatively short successful commercial life enjoyed by many designs.”).

147. See, e.g., *Hearings on H.R. 902, H.R. 3017, and H.R. 3499 Before the Subcomm. on Courts, Intellectual Prop., and the Admin. of Justice of the Comm. on the Judiciary*, 101st Cong. 165 (1990) (written testimony of Robert Drobeck, on behalf of the Industrial Designers Society of America) (“Today you need to recoup your investment in under two years if you are competing in the consumer electronics industry. Yet designs can be stolen in a matter of days. That hardly gives you time to spend the two to three years it takes to get a design patent.”).

148. See Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 297 (2011) (“[I]f a fashion patent were to take less than fifteen months to issue, then a savvy fashion designer could file the patent application at the sketching stage and be well on the way to getting the patent issued by the time the product hits the stores.” (citing Laura C. Marshall, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTELL. PROP. L. 305, 310 (2007))); see also Crouch, *supra* note 7, at 23 (“With little exception, design patent applications are kept in confidence by the USPTO until their issuance. This allows a manufacturer to file for design patent protection as early as the market-design is known . . . .” (footnote omitted)).

149. *Hearings on H.R. 902, H.R. 3017, and H.R. 3499 Before the Subcomm. on Courts, Intellectual Prop., and the Admin. of Justice of the Comm. on the Judiciary*, 101st Cong., 492 (1990) (testimony of Harry F. Manbeck, Jr., Commissioner of Patents and Trademarks).

150. See KAL RAUSTIALA & CHRISTOPHER SPRIGMAN, *THE KNOCKOFF ECONOMY* 174 (2012) (“[T]rends are made by copying.”); see also *id.* at 39-49 (explaining how copying promotes innovation in fashion).

151. E.g., Dratler, *supra* note 37, at 894 (“In the fashion industry, for example, product cycles are seasonal or annual, so that even the longest-lived products would be unlikely to receive timely patent protection.”).

and do take advantage of the design patent system.<sup>152</sup> This suggests that at least some fashion designers find value in design patents, despite the delay.<sup>153</sup>

Professor William T. Fryer, III has argued that “[p]rotection is needed promptly” because “[a] design owner’s product usually goes into the market very soon after the invention is conceived.”<sup>154</sup> However, he does not provide details about which—or how many—types of products or industries this might apply to. This may be an area where future empirical studies could be useful. But in the meantime, it seems logical that, in many industries, it would “usually take[] time after the creation of a design for an article to prepare to manufacture it, make up a stock, and distribute it to the trade, before the article actually goes on sale to the public.”<sup>155</sup>

Moreover, even if the examination process does take too long for some designs, that does not mean that it takes too long for all—or even most—designs.<sup>156</sup> So that fact would not justify providing instantaneous protection for all designs.

And even if the exclusion of some designs due to delay is a problem, that does not mean that granting instantaneous rights is the only solution. The Patent Act already allows patentees to recover a reasonable royalty for some infringements that occur between the date the patent application is published and the date the patent is issued.<sup>157</sup> However, design patents applications are not subject to the Patent Act’s general publication requirement.<sup>158</sup> Therefore, design patentees cannot currently take advantage of this provisional remedy.<sup>159</sup> To the

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152. Ferrill & Tanhehco, *supra* note 148, at 295-96 (“In practice, the theory that design patents are impractical for all fashion designs fall short, as many practitioners and designers have found a place for design patents in the fashion industry.”).

153. *See id.*; *see also* Sarah Burstein, DESIGN PATENT LOOKBOOK, <http://designpatentlookbook.tumblr.com> (collecting recently issued fashion-related design patents).

154. William T. Fryer, *Design Patent System for the Twenty-First Century*, 24 AIPLA Q.J. 331, 344 (1996).

155. *See* John Dashiell Myers, *Shall Industrial Designs Go “Out of the Frying Pan Into the Fire?”*, 8 J. PAT. OFF. SOC’Y 425, 427 (1926).

156. *See generally* Regan E. Keebaugh, Note, *Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress?*, 13 J. INTELL. PROP. L. 255, 262 (2006) (noting that the time and expense required to obtain design patents “presents no problem for the manufacturers of certain products” like automobiles); Frank W. Dahn, *Designs—Patents or Copyrights*, 10 J. PAT. OFF. SOC’Y 297, 297-98 (1928) (“It is one of the unavoidable drawbacks of any examination system that it involves delay. In the case of designs for those articles which have a short seasonal life any delay is almost fatal, but with many other articles for which design patents are now sought the delay is inconsequential alongside of the advantages afforded by the examination system and the prima-facie validity attaching to a patent granted thereunder.”).

157. *See* 35 U.S.C. § 154(d) (2011).

158. 35 U.S.C. § 122(b)(2)(iv).

159. Assuming that the Patent Law Treaties Implementation Act of 2012 goes into effect as planned, this will be changing soon for certain applications—specifically, for those filed

extent that we want to prevent designs from being copied with impunity while a design patent is pending, one solution would be to eliminate this exception and publish design patent applications.<sup>160</sup> This would allow design patentees to take advantage of the pre-issuance damages provision of the Patent Act. It could also have other benefits, such as providing the public with notice of pending claims and “reduc[ing] potential conflicts and related litigation.”<sup>161</sup>

This potential solution would not, however, satisfy all critics of the design patent system. For example, Professor Orit Fischman Afori has argued that even a registration system would take too long because designers need to be able to obtain immediate injunctions:

[C]ourts do not grant interim injunctions until . . . after examination. Thus, for a significant period of time the alleged owner of a right is “exposed” with no protection. During this period, competitors might exploit the subject matter (invention/design) and only after a grant of right can the owner/patentee recover damages retroactively. This situation is especially unsuitable for the design market, in contrast to patents, because of its dynamic and short life span. Thus, for such markets, an automatic grant of right is crucial in order to obtain immediate injunctive relief. Without this remedy, competitors will enjoy the full period of a product’s life, and build their own goodwill and clientele on the design owner’s account. All the while, the only relevant relief available to the design owner from the court is retroactive damages. Moreover, assuming that the designs’ market comprises mainly of small to medium-sized firms, an additional concern is that such competitors will not be able to pay adequate royalties and other monetary relief retroactively, due to solvency problems. Thus, for this kind of market, early preventive relief is crucial.<sup>162</sup>

However, if a “design market” really moves this quickly, then granting an immediate right to injunctive relief would impose costs that would likely outweigh any benefits.<sup>163</sup> Indeed, “[w]here the product is seasonal, and has a selling period of only a few weeks, the danger to a manufacturer from a

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pursuant to the Hague System for the International Registration of Industrial Designs. See Marc Albert Robinson, *Patent Law Treaties Implementation Act of 2012*, PROTECTING DESIGNS (Dec. 10, 2012), <http://www.protectingdesigns.com/blog/2012/12/10/patent-law-treaties-implementation-act-of-2012.html> (“The [Patent Law Treaties Implementation] Act will add 35 USC 381-390, of which 390 provides for the publication of the international design application, and will amend 35 USC 154(d) to expand Provisional Rights to a published international design application.”).

160. See Fryer, *supra* note 154, at 344-46 (arguing that most design patent applications should be published within three to six months after being filed).

161. *Id.* at 344, 346.

162. See Afori, *supra* note 77, at 1139-40 (footnotes omitted).

163. Leonard Michaelson, *The Nature of the Protection of Artistic and Industrial Designs*, 9 MIAMI L.Q. 148, 164 (1954-55) (“Although dispensing with the examination . . . would provide quick registration . . . , a more irreparable harm may be imposed upon those who would invest large sums of money in financing an industrial design only to find a comparable article already being commercially produced.”)

temporary injunction is obvious.”<sup>164</sup> If wrongly granted, an “injunction may well be more disastrous to the honest manufacturer than the pen of the ‘pirate.’”<sup>165</sup> Therefore, Professor Afori’s argument implicates a much larger debate about whether IP rights should be protected by property rules or liability rules.<sup>166</sup> That is a debate we should be having directly, not hiding beyond the assertion that design patent prosecution takes “too long.”

Professor Afori’s mention of “goodwill” suggests that there might be another underlying issue. “Goodwill” is a concept usually discussed in the context of trademark rights.<sup>167</sup> Indeed, the question about how—and how quickly—designs should be protected may turn, in significant part, on policy issues related to product-design trade dress. If, for example, one believes that design rights are valuable as a method of establishing trade dress rights,<sup>168</sup> then perhaps quick protection would be more desirable. But if one takes a dimmer view of the merits of protecting product design using the trademark regime, arguments about “goodwill” may be less persuasive. As long as we have a system where overlapping trademark and design rights are allowed, we should confront these questions directly instead of simply saying that design patent prosecution takes “too long.”

b. *Design patent prosecution is too expensive*

Critics have often argued that design patents “cost too much.”<sup>169</sup> It is true that patent prosecution is expensive—at least compared to copyright protection. But it is not clear why copyright should be the relevant baseline, unless the real argument is that designs are art and that it is unjust or inconsistent to treat them

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164. *The Vestal Bill*, *supra* note 141, at 489 (footnotes omitted).

165. *See* Goldenberg, *supra* note 107, at 35 (“[T]he retailers described the practical problems of allowing a remedy of injunction. They described a scenario where the retailer was sued for selling an infringing good. Supposing a preliminary injunction issued, . . . by the time the retailer won the suit, six months had passed and the goods would be worthless because the season had passed.” (citing *Registration of Designs: Hearings on H.R. 6249 Before the House Comm. on Patents Part 2*, 69th Cong. 200 (1926))).

166. *See generally* Mark A. Lemley, *Contracting Around Liability Rules*, 100 CAL. L. REV. 463, 465-69 (2012) (discussing the debate over property rules and liability rules in the context of IP).

167. *See generally* Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 548 (2006).

168. *Cf.* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (suggesting that design patents could properly be used to help a product design develop secondary meaning).

169. *See* Saidman, *Crisis*, *supra* note 7, at 331 (“Some of the biggest objections to design patents over the years have been that they take too long to get, that they cost too much, that you can only protect one design per application, and that it is hard to satisfy the design patent standard of ‘non-obviousness.’”).

differently than paintings and sculptures.<sup>170</sup>

It has been argued that patent “fees constitute a burdensome expense, especially when it is considered that few of the designs which are produced and tried on the public catch the public fancy.”<sup>171</sup> However, the Patent Act allows designers “some opportunity to test the market before incurring the expense of patent prosecution.”<sup>172</sup> And it may be true that “the high cost and long processing time for design patents create barriers that . . . make design patents financially impractical”<sup>173</sup> for some—or even most—designs. But that is not inherently problematic, at least from a social welfare standpoint.<sup>174</sup>

Moreover, the criticism that design patents are “too expensive”—like the criticism that they “take too long” to obtain—conceals a much larger policy question about the relative merits of registration versus examination systems. Both types of systems have advantages and disadvantages.<sup>175</sup> Even if the cost (or delay) of ex ante examination is seen as a disadvantage, the potential benefits deserve to be discussed as well.<sup>176</sup> For example, as David Gerck has observed, “[a] design registration system might save a dollar and a day at initial filing, but will likely cost more time and money when traveling down the road of enforcement, licensing, or settlement.”<sup>177</sup> Therefore, to the extent that these arguments focus on cost as a disadvantage while ignoring the potential advantages, they are unpersuasive.

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170. See generally *supra* Subpart II.A.1.

171. *The Vestal Bill*, *supra* note 141, at 484 (footnote omitted).

172. See Reichman, *New Technologies*, *supra* note 23, at 23 (discussing the grace period allowed by the prior version of § 102). Although § 102 was recently amended by the America Invents Act (AIA), designers should still have some opportunity to test the market prior to filing a design patent application. See generally KIMBERLY A. MOORE, TIMOTHY R. HOLBROOK & JOHN F. MURPHY, *PATENT LITIGATION AND STRATEGY* 691-98 (4th ed., 2013) (discussing the new AIA provisions).

173. See Keebaugh, *supra* note 156, at 262.

174. Cf. David Fagundes & Jonathan S. Masur, *Costly Intellectual Property*, 65 *VAND. L. REV.* 677, 679 (2012) (“In this Article, we question this conventional wisdom, arguing that the costliness of patents and the costlessness of copyrights have positive, rather than negative, effects on social welfare.”); see also *id.* at 693 (setting up a rubric of possible types of patents). A preliminary analysis, using the model employed by Fagundes and Masur, suggests that design patents tend to array more like utility patents than copyrights across dimensions of private and social value. This suggests that the costliness of design patents may actually have a net positive effect on social welfare.

175. See David R. Gerck, *The Debate over the Preferred System for Protecting Design in the United States: Patents Versus Registrations*, 26 *IPL NEWSL.* (ABA Section of Intellectual Property Law), Spring 2008, at 17-21 (identifying a number of potential advantages of the current examination system).

176. See also *id.* at 17; cf. *id.* at 22 (arguing that “it would be somewhat misleading to compare the speed of [examination versus registration] systems without accounting for distinctions in the end product that results”).

177. *Id.* at 18.

### 3. *Exclusion of many (or most) designs*

Numerous commentators have criticized the design patent system for excluding too many designs.<sup>178</sup> As discussed above, however, the design patent system—at least as currently administered—does not actually exclude that many designs.<sup>179</sup> In fact, “[f]or the past decade, the allowance rate for design patent applications has remained over 90%.”<sup>180</sup> But even if the design patent system did actually exclude a large number of designs, these types of arguments would still not be particularly persuasive. This Subpart will address those arguments in turn.

#### a. *Broader is just better*

Many design patent critics seem to assume that an ideal IP regime would protect most, if not all, designs that are “original” in the copyright sense.<sup>181</sup> For example, Steve W. Ackerman has argued that designs should not be subject to “rigorous requirements” such as novelty and nonobviousness because designers “should be allowed to reap the benefits” of their efforts.<sup>182</sup>

This type of argument—like most of the other arguments that assert or assume that broad protection should be the goal—seems to be based on a labor-deserts theory of IP.<sup>183</sup> That theory “sees intellectual property rights as a Lockean acknowledgment of the labor of creation, in granting copyright or patent

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178. *E.g.*, Goldenberg, *supra* note 107, at 22 (complaining that “patents are impossible to obtain for many new products”).

179. At least, not as a result of the substantive requirements or PTO examination. *See supra* Subpart II.B.1.b. If anything, the system should exclude *more* designs than it currently does.

180. Crouch, *supra* note 7, at 18; *see also id.* at 11 (“The number of design patents issued each year has increased over time. The most dramatic rise has been over the past 25 years.”); *id.* at 12 (charting this rise); Saidman, *Whipping Boy*, *supra* note 7, at 862 (“[I]t is . . . my personal experience that in many product areas a vast majority of design patent applications are allowed on the patent examiner’s first Office Action.”).

181. *See supra* Subpart I.B (discussing the copyright concept of originality).

182. Steve W. Ackerman, Note, *Protection of the Design of Useful Articles: Current Inadequacies and Proposed Solutions*, 11 HOFSTRA L. REV. 1043, 1053 (1983).

183. *See id.*; *see also, e.g.*, Saidman, *Crisis*, *supra* note 7, at 334 (“A design patent system created in 1842 no longer suffices to adequately protect most industrial designs. Something more suited to modern 21st century realities needs to be created to make sure designers and manufacturers get their just due, and are not willy-nilly knocked-off . . . . The present system in many cases is tantamount to legalized theft.”). Professor Afori is a notable exception; she suggests that broad protection would be ideal but frames her argument in utilitarian terms. *See Afori, supra* note 77, at 1136 (“If the aim is to encourage the development of aesthetics in design, then the enforcement of a novelty threshold will mean non-protection over a vast number of designs. Such an outcome clearly misses the purpose of encouraging creative activity with respect to individuating product configuration.”).

protection to creators that have worked sufficiently hard.”<sup>184</sup> But that is not the only normative theory of IP.<sup>185</sup> As Professor Jeanner Fromer has explained, a different theory currently dominates U.S. case law and academic commentary:

The Supreme Court, Congress, and many legal scholars consider utilitarianism the dominant purpose of American copyright and patent law. According to utilitarian theory, copyright law provides the incentive of exclusive rights for a limited duration to authors to motivate them to create culturally valuable works. Without this incentive, the theory goes, authors might not invest the time, energy, and money necessary to create these works because they might be copied cheaply and easily by free riders, eliminating authors’ ability to profit from their works.<sup>186</sup>

And, from a utilitarian perspective, “there are sound public policy reasons against extending a property right to most commercial art.”<sup>187</sup> This is not to say that it would be impossible to make a labor-desert case for design IP in the United States—or that utilitarianism is the only acceptable normative basis. But simply asserting that we need new IP rights “to make sure designers and manufacturers get their just due”<sup>188</sup> obscures a much larger and more important question about the normative basis for design rights. That question should be debated directly, not just assumed away.

Additionally, “the belief that an innovator ‘deserves to benefit from her labor’ does not lead ineluctably to a pro-[IP] conclusion.”<sup>189</sup> There are other types of possible rewards, such as “fees, awards, acknowledgement, gratitude, praise, security, power, status, and public financial support.”<sup>190</sup> Any argument for broader design rights based on the idea that “designers and manufacturers [should] get their just due”<sup>191</sup> also needs to explain why that “just due” must be secured by an IP right. For all of these reasons, the arguments that have been made that simply assume broader protection is better are unconvincing.

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184. Fromer, *supra* note 70, at 1753 (citing ROBERT P. MERGES, *JUSTIFYING INTELLECTUAL PROPERTY* 31-67 (2011); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *YALE L.J.* 1533, 1540-83 (1993); Justin Hughes, *The Philosophy of Intellectual Property*, 77 *GEO. L.J.* 287, 296-330 (1988)).

185. *See generally id.* at 1749-56 (discussing various normative theories of IP).

186. *Id.* at 1750-51.

187. *See Magliocca, supra* note 1, at 846; *see also id.* at 847 (“[T]he evidence is persuasive that the costs of a property right outweigh the benefits.”).

188. Saidman, *Crisis, supra* note 7, at 334.

189. *Cf.* Daniel J. Hemel & Lisa Larrimore Oullette, *Beyond the Patents-Prizes Debate*, 92 *TEX. L. REV.* (forthcoming 2013) (manuscript at 35), available at <http://ssrn.com/abstract=2245691>.

190. *Id.* (quoting Edwin C. Hettinger, *Justifying Intellectual Property*, 18 *PHIL. & PUB. AFF.* 31, 41 (1989)).

191. Saidman, *Crisis, supra* note 7, at 334.

b. *Designers deserve “recognition”*

A number of commentators have suggested that excluding too many designs from protection is problematic because designers deserve recognition for their valuable contributions and/or creativity. For example, Perry Saidman and Theresa Esquerra have argued that there is a “moral imperative to recognize the creativity of industrial designers”<sup>192</sup> and that “[t]he enormous creativity of industrial designers who sell their work in the United States . . . deserves to be recognized by implementing a [*sui generis*] law that effectively protects their work from knock-off artists.”<sup>193</sup> Others have argued that fashion designs should receive copyright (or copyright-like) protection because they deserve to be recognized as “art”—or their creators deserve to be recognized as “artists.”<sup>194</sup> However, as Professor Brown has noted, “[e]xaltation of authorship, whatever its emotional appeal, is not, in itself, enough to justify extending existing rights, even if it is likely that creating a new property right will in fact shift resources in the authors’ direction.”<sup>195</sup>

Even if there is some sort of imperative—moral or otherwise—to “recognize” designers or designs, that does not necessarily mean that it is the government’s role to provide that recognition. And even if it were, that recognition need not take the form of an IP right—let alone an IP right that is cheap and easy to obtain.<sup>196</sup> A government could recognize the practice (and/or

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192. Saidman & Esquerra, *supra* note 7, at 433.

193. *Id.* at 427. Specifically, they argue, Congress should enact a *sui generis* design protection law modeled on the one used by the European Union. *See id.* at 429, 433.

194. *E.g.*, Borukhovich, *supra* note 50, at 158 (arguing that there is a “need to recognize that fashion designs are a form of art that need further protection within the intellectual property field”); Anya Jenkins Ferris, *Real Art Calls for Real Legislation: An Argument Against Adoption of the Design Piracy Prohibition Act*, 26 CARDOZO ARTS & ENT. L.J. 559, 575 (2008) (“[I]f copyright protection should be extended to fashion design at all, it should be on the basis of the public policy of protecting artists against infringement and giving legal recognition to original designers as artists in their own right.”).

195. Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579, 591-92 (1985).

196. It may be true that IP laws do, in practice, provide some type of “recognition.” For example, “a patent can signal to an inventor’s friends and family that the inventor should be esteemed.” William Hubbard, *Inventing Norms*, 44 CONN. L. REV. 369, 406 (2011). And “[p]rotectability standards in intellectual property law communicate to potential creators that certain classes of works are of value and ought to be produced and protected.” Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1499 (2010). However, that does not necessarily mean that IP rights—and design rights in particular—should be easy or cheap to obtain. *See id.* (arguing that IP protectability “standards . . . ought to be calibrated as accurately as possible to cover works considered to be creatively valuable.”); *see also* Fromer, *supra* note 70, at 1747 (referring to “the ways in which copyright and patent law can protect creators’ labor and personhood interests and employ rhetoric communicating concern for these interests [as] ‘expressive incentives’”); *id.* at 1748 (“Expressive interests . . . ought to be protected only when the utilitarian analysis indicates that the benefits of doing so exceed the costs.”). Nor does it mean that such rights should arise

practitioners) of design in other ways, such as creating “promotional agencies, tax credits, and reaching out to design at the highest levels.”<sup>197</sup> Governments could also recognize talented designers by sponsoring awards.<sup>198</sup> The United States actually already does this; since 2000, the Smithsonian Cooper-Hewitt, National Design Museum has given National Design Awards to designers in various fields.<sup>199</sup> Additionally, governments could promote good design through “subsidization policies” such as “the awarding of lucrative government contracts to firms producing ‘good’ design.”<sup>200</sup> And even if an IP right were deemed necessary to “recognize” designers, that does not mean that designers must be given a right to prevent copying. As Professor Amy Landers recently suggested, designers could be given a right of attribution instead.<sup>201</sup> Without some explanation as to why this “moral imperative” must be satisfied by an IP right—and, in particular, a right to exclude—these types of “recognition” arguments are not persuasive.

These arguments also obscure a much larger question—namely, what exactly do we want to protect? Some defined type of artifact? Or artifacts made by certain people? In other words, should we protect designs because they have certain attributes? And if so, what are those attributes? Or should we protect designs because they are created by people we deem to be “designers”? Objects that result from the process of “industrial design”? To date, little attention seems to have been paid to these questions, which deserve to be discussed and debated

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automatically, without ex ante substantive examination. Cf. Hubbard, *supra*, at 399 (“Because a patent issues only after administrative examination, the patent indicates with at least modest credibility that these requirements for patentability have been met and thus identifies the patentee as the creator of a meaningful new invention.”).

197. See Ravi Sawhney, *U.S. Innovation Can’t Stay on Top Without Smart Government*, FAST COMPANY CO.DESIGN (Dec. 20, 2011, 12:19 PM), <http://www.fastcodesign.com/1665684/us-innovation-cant-stay-on-top-without-smart-government>; see also Hemel & Oullette, *supra* note 189, at 1 (observing that there are various “mechanism[s] for incentivizing the production of new knowledge,” including patents, prizes, grants and tax incentives).

198. See generally Goldenberg, *supra* note 107, at 52 (noting that, a design hearing held in 1980, some discussion focused on “the fact that nearly all European countries rewarded good design with awards and shows” but that “some speakers” argued that “rather than award designers, the government should seek to encourage public appreciation of good design through expositions and workshops”).

199. See generally *National Design Awards*, COOPER HEWITT, NATIONAL DESIGN MUSEUM, <http://www.cooperhewitt.org/national-design-awards> (last visited Dec. 12, 2013).

200. See Michael Crew, *Undesirable in Theory, Absurd in Practice—The Protection of Industrial Designs in England and New Zealand*, 2 AUCKLAND U. L. REV. 1, 21, 21 n.68 (1975).

201. See Amy L. Landers, *The Anti-Economy of Fashion: An Openwork Approach to Intellectual Property Protection*, 24 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. (forthcoming 2014) (manuscript at 63), available at <http://ssrn.com/abstract=2296769> (arguing that “Rather than accord[ing] monetary and injunctive relief as the primary remedies to the rights owner,” fashion IP legislation should “protect the creator’s reputation as a cultural producer” by making attribution the primary remedy).

directly.

c. *Professor Reichman's argument*

In a series of pieces written between 1989 and 1994, Professor Jerome Reichman suggested one reason why excluding a large number of designs from protection might be bad for society as a whole.<sup>202</sup> According to Professor Reichman, “[t]he modified patent approach . . . institutionalizes a state of chronic underprotection.”<sup>203</sup> This “leads to chronic overprotection in [copyright] law, which in turn inspires further reactive reforms of [trademark or patent law] tending to reinstate levels of underprotection that will foster renewed appeals to copyright law.”<sup>204</sup> And the perception of “underprotection” can also strain trademark law:

Comparative intellectual property law demonstrates that, unless restrained by the enactment of *sui generis* design laws or by the periodic strictures of higher authority, foreign judges are reluctant to condone systematic design piracy in blind obedience to liberal economic theory. Given room to maneuver, there is a nearly universal tendency to strain trademark and unfair competition laws sounding in the confusion and deception rationales to the point where they at least occasionally deter slavish imitation on a case-by-case basis.<sup>205</sup>

Indeed, in the United States, “design industries that were denied *sui generis* protection in 1976 soon turned to federal unfair competition law for a substitute form of relief that has produced increasingly anti-competitive effects.”<sup>206</sup>

According to Professor Reichman, “[t]he logical and most expedient solution” to “these oscillations between states of over- and underprotection” is for the United States to pass a *sui generis* law based on copyright principles.<sup>207</sup>

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202. See *Industrial Design Litigation: Hearing on H.R. 902, H.R. 3017, and H.R. 3499 Before the Subcomm. on Courts, Intellectual Prop., and the Admin. of Justice of the H. Comm. on the Judiciary*, 101st Cong. 514, 523 (1990) (prepared statement of Jerome H. Reichman) [hereinafter Reichman testimony]; Reichman, *Legal Hybrids*, *supra* note 93, at 2460; J.H. Reichman, *Design Protection and the Legislative Agenda*, 55 *Law & Contemp. Probs.* 281 (1992) [hereinafter Reichman, *Legislative Agenda*]; Reichman, *New Technologies*, *supra* note 23; J.H. Reichman, *Design Protection After the Copyright Act of 1976: A Comparative View of the Emerging Interim Models*, 31 *J. COPYRIGHT SOC'Y U.S.A.* 267, 379 (1984) [hereinafter Reichman, *Comparative View*].

203. See Reichman testimony, *supra* note 202, at 523.

204. Reichman, *Legal Hybrids*, *supra* note 93, at 2464; see also Reichman, *New Technologies*, *supra* note 23, at 18 (“[T]he behavior of industrial designs under domestic law has followed a cyclical pattern that oscillates between states of chronic underprotection and states of chronic overprotection.”); *id.* at 145-47 (describing his “model design law”).

205. Reichman, *New Technologies*, *supra* note 23, at 81 (footnote omitted).

206. Reichman, *Legislative Agenda*, *supra* note 202, at 281 (footnote omitted); see also Reichman, *Comparative View*, *supra* note 202, at 379 (“The very success of a tough exclusionary line [for copyright protection] would . . . put federal trademark and unfair competition law under immense pressure.”).

207. See Reichman, *New Technologies*, *supra* note 23, at 121.

Professor Reichman's descriptive account—i.e., that producer dissatisfaction with the design patent system has, historically, put pressure on other legal regimes—seems to be correct. And his concerns about the anti-competitive effects of the expansion of trade dress law are certainly well-founded. However, it is not clear that enacting a *sui generis* design law would actually solve the problem, at least not at this late date.

In 1989, Professor Reichman seemed to think that the pendulum might be swinging back toward limiting trademark protection for designs.<sup>208</sup> Therefore, he argued, the time was ripe to try to stop the cycle of over- and underprotection.<sup>209</sup> But today, it is well-established that designs can be protected as “trademarks” under the Lanham Act.<sup>210</sup> On this front at least, the damage seems to be done. Neither a *sui generis* design law nor expanding copyright would, in and of itself, undo this expansion of trademark law.

Congress could, in theory, enact a *sui generis* design law that would abolish product-design trade dress protection—or, at least, require some type of election.<sup>211</sup> However, that seems highly unlikely; the *sui generis* Vessel Hull

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208. *See id.* at 114 (“Although one cannot foresee the future impact of these decisions with any degree of certainty, they add to a growing reaffirmation of the fundamental principle that allows competitors to copy all products not qualifying as ‘inventions’ or ‘literary and artistic works.’” (citations omitted) (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 163-68 (1989))); *see also id.* at 126 (“Whether industrial designs will continue to receive exorbitant protection in unfair competition law after the Supreme Court’s *Bonito Boats* decision in 1989 remains an open question.”).

209. *See id.* at 121 (“The logical and most expedient solution is to pass a similar law now, at a time when the Supreme Court’s *Bonito Boats* decision may have jeopardized recently acquired rights.”); *see also* Reichman, *Legislative Agenda*, *supra* note 202, at 290 (arguing that if “the Supreme Court’s recent decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* . . . restrain[s] the federal appellate courts from covertly treating slavish imitation of product designs as a business tort for the immediate future[,] . . . an incipient period of overprotection in federal unfair competition law will simply give way to another period of chronic underprotection in design patent law unless Congress takes this occasion to enact a *sui generis* design law.” (footnotes omitted)).

210. *See* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209-10 (2000) (agreeing that “trade dress constitutes a ‘symbol’ or ‘device’ for purposes of the relevant sections” of the Lanham Act); *see also id.* (“This reading of § 2 and § 43(a) is buttressed by a recently added subsection of § 43(a), § 43(a)(3), which refers specifically to ‘civil action[s] for trade dress infringement under this chapter for trade dress not registered on the principal register.’” (alteration in original) (quoting 15 U.S.C. § 1125(a)(3))); Lars Smith, *Trade Distinctiveness: Solving Scalia’s Tertium Quid Trade Dress Conundrum*, 2005 MICH. ST. L. REV. 243, 247 n.20 (2005) (“[T]rade dress is currently protectable as an unregistered trademark under § 43(a), and registerable on the Principal register under § 2, at least until the Supreme Court changes its view that the Lanham Act includes trade dress in the definition of trademark or Congress revises the Lanham Act.”).

211. There currently is no requirement of election between design patent and trade dress protection. *See In re Mogen David Wine Corp.*, 328 F.2d 925, 929 (C.C.P.A. 1964) (“The underlying purpose and the essence of patent rights are separate and distinct from those appertaining to trademarks. No right accruing from the one is dependent upon or conditioned by any right concomitant to the other.”); *see also In re Mogen David Wine Corp.*, 372 F.2d

Design Protection Act specifically preserves any overlapping trademark rights.<sup>212</sup> And any move to abolish or limit product-design trade dress would undoubtedly face intense opposition from groups like the International Trademark Association.<sup>213</sup>

And even if, as Professor Reichman argues, *sui generis* design laws can reign in judges, recent events in the UK suggest that *sui generis* design rights may not significantly lessen the pressure on other forms of IP law. In the UK, there are a number of cheap, easy-to-obtain IP rights that can be used to protect designs: UK Copyright, UK Design Right, UK Registered Designs, Unregistered Community Designs, and Registered Community Designs.<sup>214</sup> All of these rights are cheap and easy to obtain, at least compared to design patents.<sup>215</sup> But despite this abundance of inexpensive and easy-to-acquire rights, the pressure for increased protection has not disappeared.

In 2012, for example, the editor of *Elle Decoration UK* led a campaign for “Equal Rights for Design!”<sup>216</sup> Following that campaign, UK copyright law was amended to provide full copyright protection to certain designs.<sup>217</sup> Additionally,

539, 540 (C.C.P.A. 1967) (“On appeal this court in *In re Mogen David Wine Corp.* held, in substance, that the existence of the design patent did not preclude appellant’s right to register [its bottle design] on the Principal Register . . .” (citation omitted)).

212. 17 U.S.C. § 1330(2) (2011) (“Nothing in this chapter shall annul or limit . . . any right under the trademark laws or any right protected against unfair competition.”).

213. Cf. Glynn S. Lunney, Jr., *The Trade Dress Emperor’s New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 HASTINGS L.J. 1131, 1134, 1173-74 (2000) (“While there is an organized trademark bar, it is predominantly a plaintiff’s bar dedicated to and with a systematic interest in obtaining trademark protection for their clients whenever and wherever available.” (citing *Trademark Law Revision Act: Hearings on H.R. 4156 Before the Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the H. Comm. on the Judiciary*, 100th Cong. 101 (1988) (testimony of Ralph S. Brown about INTA, which was then called the United States Trademark Association))).

214. *Do I Need to Register My Design?*, U.K. INTELL. PROP. OFF., <http://www.ipo.gov.uk/types/design/d-applying/d-before/d-needreg.htm> (last visited Dec. 12, 2013).

215. Three of these rights—UK Copyright, UK Design Right, and Unregistered Community Designs—arise automatically and costlessly when the relevant conditions are met. *See id.* (noting that these rights cost “[n]othing”). The registered design rights can be acquired for a small fee and are subject to minimal examination. *See id.*; *Designs: Fees and Payment*, OFF. FOR HARMONIZATION IN THE INTERNAL MKT., <https://oami.europa.eu/ohimportal/en/rcd-fees-and-payments> (last visited Dec. 12, 2013); *see also* Clive Thorne, *United Kingdom, in INTERNATIONAL DESIGN PROTECTION: A GLOBAL HANDBOOK* 377 (Clive Thorne, ed., 2012) (discussing the registration procedure for a UK Registered Design); *id.* at 382 (discussing the registration procedure for a Registered Community Design).

216. *See Equal Rights for Design!*, HM GOVERNMENT E-PETITIONS (closed Jan. 9, 2013), <http://epetitions.direct.gov.uk/petitions/26273>; *Elle Decoration Launches Campaign to Protect the Rights of UK Designers*, DEZEEN (Apr. 3, 2012), <http://www.dezeen.com/2012/04/03/elle-decoration-launches-campaign-toprotect-the-rights-of-uk-designers>.

217. *See* Ogundehin, *supra* note 75; David Musker, *Farewell, Section 52*, CLASS 99 (Apr. 26, 2013), <http://www.marques.org/class99/Default.asp?XID=BHA444> (stating that,

a group called Anti Copying in Design (or “ACID”) has been lobbying since 2004 for increased design protection, including moral rights and criminal sanctions.<sup>218</sup> At the moment, ACID may be on the brink of achieving—in part—a significant legislative victory. On July 30, 2013, the House of Lords passed a bill that would criminalize the infringement of registered design rights.<sup>219</sup> Notably, however, ACID is still not satisfied; it argues that the law should go further and criminalize the infringement of unregistered design rights as well.<sup>220</sup> Therefore, recent history suggests that *sui generis* design rights may not be the solution to expansionist pressures on other legal regimes.

### C. *Patent Protection Is Overbroad*

A number of commentators have argued that it would be better to use copyright—or a copyright-like *sui generis* regime—to protect designs because design patents provide an excessive scope of protection.<sup>221</sup> Professor Afori has even suggested that there is “a possible constitutional argument” against granting patents (or patent-like protection) for designs.<sup>222</sup> According to Professor Afori:

The Intellectual Property Clause of the Constitution empowers Congress to legislate copyright and patent laws “[t]o promote the [p]rogress of [s]cience and the useful [a]rts.” The Supreme Court has interpreted this clause as a mandate to shape law according to utilitarian considerations. Thus, according to a possible constitutional argument, as long as there is no good reason for conferring an excessive scope of protection for designs, in comparison with artistic works, such excessive protection does not comply with the constitutional mandate. In other words, inconsistency by favoring designs (i.e. by conferring

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with this amendment, “[s]ome newly created designs will therefore be protected for the full term of copyright rather than 25 years as at present”).

218. *See Equality of Rights for Designers—History*, ACID, <http://www.acid.uk.com/equality-of-rights-for-designers-history.html> (last visited Dec. 12, 2013) (discussing ACID’s lobbying efforts for “parity of rights for designers” and listing its accomplishments to date).

219. *See Amended IP Bill Passes Through House of Lords*, WORLD INTELL. PROP. REV. (July 30, 2013), <http://www.worldipreview.com/news/amended-ip-bill-passes-through-house-of-lords>. The bill still has to be passed by the House of Commons. *See Intellectual Property Bill [HL] 2013-14*, U.K. PARLIAMENT, <http://services.parliament.uk/bills/2013-14/intellectualproperty.html> (last visited Dec. 12, 2013).

220. *See #SupportClause13 for Unregistered Designs—Facts & Figures*, ACID, <http://www.acid.uk.com/supportclause13-for-unregistered-designs-facts-figures.html> (last visited Dec. 12, 2013).

221. *See, e.g.,* Matthew Nimetz, Comment, *Design Protection*, 15 COPYRIGHT L. SYMP. 79, 129 (1967) (arguing that design patents provide excessive protection because “the standard of infringement is wide” and “the nature of the monopoly is inappropriate” because it covers copiers and independent creators); *id.* at 131 (suggesting that, in certain industries, it may be appropriate to grant “limited protection against copying” instead of “a patent monopoly”); Ringer, *supra* note 1, at 26 (referring to a design patent as “a form of monopoly protection that many feel is too broad . . . for designs”).

222. *See* Afori, *supra* note 77, at 1134-35.

a stronger monopolistic right than that of copyright) must be explained in economic or incentive terms. Without an explanation, excessive protection might be challenged as unconstitutional.<sup>223</sup>

But even if it is true that, as a general matter, patent provides “a stronger monopolistic right”<sup>224</sup> than copyright, that does not mean that the same is true when each regime is applied to designs.<sup>225</sup>

The doctrines that normally narrow the scope of copyright protection will not necessarily do so in the context of designs.<sup>226</sup> Indeed, a “right to prevent copying” akin to the 17 U.S.C. § 106(1) reproduction right might actually provide a *broader* scope of protection in the context of designs.<sup>227</sup> And full copyright protection would, of course, be even broader.<sup>228</sup> Even critics of the design patent system have acknowledged that the full set of § 106 rights—including, for example, the right to create derivative works—would provide excessive protection for designs.<sup>229</sup>

Therefore, arguments that design patents provide an excessive protection—at least as compared to copyright or copyright-like protection—do not hold up to close scrutiny. At a minimum, these arguments need more development, including discussion and analysis of specific examples.

#### CONCLUSION

For all of these reasons, the standard case against design patents is not nearly as strong as the standard criticisms suggest. This is not to say that design patents are perfect. Design patent doctrine has been largely neglected for far too long.<sup>230</sup> The entire system could benefit from increased attention and analysis. However, the situation is not nearly as bleak as the current literature may suggest. In order to properly evaluate the current system and any proposed alternatives, we need to address the underlying policy questions directly. And, at a minimum, we need to stop hiding those difficult questions behind the familiar litany of oft-repeated—yet unpersuasive—standard criticisms of design patents.

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223. *Id.* (alternations in original) (footnotes omitted).

224. *See id.*

225. Sarah Burstein, *Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright Protection for Designs*, 3 IP THEORY 114, 114 (2013).

226. *Id.* at 115-27 (discussing the idea-expression dichotomy, the requirement of proof of copying and the doctrine of fair use).

227. *Id.* at 127.

228. *See* 17 U.S.C. § 106 (2011) (listing the exclusive rights of a copyright owner).

229. *See, e.g.,* Susanna Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 539 (2012) (“Copyright also provides a far broader set of exclusive rights than are necessary for designers—or beneficial for their customers—such as the right to object to derivative work.”).

230. *See* Mueller & Brean, *supra* note 88, at 534 n.582 (citing R. CARL MOY, MOY’S WALKER ON PATENTS § 5:41 (4th ed. 2009)).

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