

SARAH BURSTEIN

Suffolk University Law School
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ACADEMIC APPOINTMENTS

Suffolk University Law School

Academic Co-Director, IP Center, 2022–Present

Professor of Law, 2022–Present

Courses: Civil Procedure, Patents, Design Law

University of Oklahoma College of Law

Associate Professor of Law, 2012–2018

Professor of Law, 2018–2022

Courses: Civil Procedure I/ II, Copyright, Design Law, Intellectual Property Survey,
Trademarks & Unfair Competition, Art & Cultural Heritage Law, Patents

Notre Dame Law School

Visiting Professor, Fall 2019

Courses: Intellectual Property, Patents

Chicago-Kent College of Law

Research Affiliate, Center for Design, Law & Technology, 2017–Present

EDUCATION

University of Chicago Law School

Juris Doctor, June 2007

Honors: Edmund A. Spencer Scholar

Iowa State University

B.A. with Honors and with Distinction, May 2004

Honors: National Merit Scholarship; Honors Program; Top Graduating Student, College of Design

Studies: Majors in Art & Design and Journalism & Mass Communication; Minor in French

PUBLICATIONS & WORKS-IN-PROGRESS

Uncreative Designs, 73 DUKE L.J. __ (forthcoming).

Design Patents, in ENCYCLOPAEDIA OF INTELLECTUAL PROPERTY LAW (Bernd Justin Jütte, Irini Stamatoudi,
Paul Torremans & Peter Yu, eds.) (Edward Elgar Publishing) (forthcoming).

The Truth About Design Patents, 71 AM. U. L. REV. 1221 (2022) (with Saurabh Vishnubhakat).

Selected for inclusion in the 2023 INTELLECTUAL PROPERTY LAW REVIEW, a Thomson Reuters
(West) anthology of the best IP law review articles published the previous year.

Whole Designs, 92 COLO. L. REV. 181 (2021).

Selected for inclusion in the 2022 INTELLECTUAL PROPERTY LAW REVIEW, a Thomson Reuters (West) anthology of the best IP law review articles published the previous year.

How Design Patent Law Lost its Shape, 41 CARDOZO L. REV. 555 (2019).

Intelligent Design & Egyptian Goddess, 68 DUKE L.J. ONLINE 94 (2019).

Is Design Patent Examination Too Lax?, 33 BERKELEY TECH. L.J. 607 (2018) (symposium).

The “Article of Manufacture” Today, 31 HARV. J.L. & TECH. 781 (2018).

Cited in: Order Requiring New Trial on Design Patent Damages, *Apple Inc. v. Samsung Elecs. Co.*, No. 5:11-cv-01846 (N.D. Cal. Oct. 22, 2017), ECF 3530.

The “Article of Manufacture” in 1887, 32 BERKELEY TECH. L.J. 1 (2017).

Cited in: Order Requiring New Trial on Design Patent Damages, *Apple Inc. v. Samsung Elecs. Co.*, No. 5:11-cv-01846 (N.D. Cal. Oct. 22, 2017), ECF 3530.

Positively reviewed in: Mark McKenna, *Designing Design Patent Subject Matter*, JOTWELL: THE JOURNAL OF THINGS WE LIKE (LOTS) (Mar. 22, 2018).

Costly Designs, 77 OHIO ST. L.J. 107 (2016).

Featured by Larry Solum on LEGAL THEORY BLOG (July 8, 2015).

The Patented Design, 83 TENN. L. REV. 161 (2015).

Cited in: *Curver Luxembourg SARL v. Home Expressions, Inc.*, 938 F.3d 1334 (Fed. Cir. 2019).

Positively reviewed in: Pamela Samuelson, *What Scope for Design Patents?*, JOTWELL: THE JOURNAL OF THINGS WE LIKE (LOTS) (Feb. 15, 2016).

Faux Amis in Design Law, 105 TRADEMARK REP. 1455 (2015) (invited contribution).

Moving Beyond the Standard Criticisms of Design Patents, 17 STAN. TECH. L. REV. 305 (2013) (symposium).

Republished (in shortened and updated form) as: *The Standard Criticisms of U.S. Design Patents*, 25 JAP. SOC. SCI. DES. 84 (October 2017) (Japanese translation by Kodai Kimura).

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

Visual Invention, 16 LEWIS & CLARK L. REV. 169 (2012).

Cited by both sides (and some *amici*) in *LKQ v. GM Global Tech.*, No. 21-2348 (Fed. Cir.) (*en banc*).

The Counterfeit Sham (work-in-progress).

Secret Design Litigation (with Saurabh Vishnubhakat) (work-in-progress).

Fixing Broken-Line Claiming (with Mark A. Lemley) (work-in-progress).

CASEBOOK & SUPPLEMENT

PATENT LAW: AN OPEN-ACCESS CASEBOOK (2021) (with Sarah R. Wasserman Rajec & Andres Sawicki)
<https://patentlawcasebook.com>.

One Day on Designs (with Sarah R. Wasserman Rajec & Andres Sawicki) (2021).

SELECTED ADDITIONAL WRITING

“Design Patent Exceptionalism” Isn’t, PATENTLY-O (July 6, 2023).

In defense of Rosen references, PATENTLY-O (Dec. 6, 2022).

We need to talk about the NDIL’s Schedule A cases, PATENTLY-O (Oct. 30, 2022).

Old Designs, New Design Patents, PATENTLY-O (April 27, 2022).

Against the Design-Seizure Bill, PATENTLY-O (Jan. 3, 2020).

Design Patents After Curver Luxembourg, PATENTLY-O (Sept. 16, 2019).

Analysis of U.K. Legislation Criminalizing the Infringement of Registered Designs, COMPARATIVE PATENT REMEDIES (May 23, 2014).

Design Patent Myths—On examiners and expertise, THE FACULTY LOUNGE (Oct. 30, 2013).

Classic Design Patent Scholarship, WRITTEN DESCRIPTION (Apr. 5, 2013).

Design Patents and Apple v. Samsung, MADISONIAN.NET (Aug. 27, 2012).

Apple v. Samsung, PATENTLY-O (May 18, 2012).

SELECTED FEDERAL AGENCY COMMENTS

Comment from Sarah Burstein, *in response to* U.S. PATENT & TRADEMARK OFFICE, Request for Comments: Expanding Admission Criteria for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office, 87 FR 63044, PTO-P-2022-0027 (Jan. 31, 2023), <https://www.regulations.gov/comment/PTO-P-2022-0027-0033> (arguing that design patent practice should not be limited to individuals with scientific or technical backgrounds).

Comment from Design Law Professors, *in response to* U.S. PATENT & TRADEMARK OFFICE, Request for Comments on the Article of Manufacture Requirement of 35 U.S.C. 171, 85 FR 83063 (Feb. 4, 2021) (lead author), <https://www.regulations.gov/comment/PTO-C-2020-0068-0009> (arguing, among other things, that projected designs do not need design patent protection because they already qualify as copyrightable subject matter).

SELECTED PRESENTATIONS & CONFERENCES

New York University School of Law, Innovation Policy Colloquium, *Uncreative Designs* (scheduled for Mar. 28, 2024).

M³ IP Scholars Workshop, *A Counterfeit Rationale for Design Protection* (May 19, 2023).

Boston University School of Law, Intellectual Property Workshop, *A Counterfeit Rationale for Design Protection* (Apr. 24, 2023).

Suffolk University Law School, Twentieth Annual Works-in-Progress Intellectual Property Colloquium, *Secret Design Litigation* (Feb. 3, 2023) (with Saurabh Vishnubhakat).

Hofstra Law, Intellectual Property Colloquium, *Uncreative Designs* (Jan. 24, 2023).

ChIPs New York, “Rethinking the Design Bar: A Conversation with Sarah Burstein” (Jan. 10, 2023).

Suffolk University Law School, Fourth Annual IP & Innovation Conference, Moderator & Organizer, “Designing the Patent Bar” (Nov. 10, 2022).

U.S. Patent & Trademark Office, TC2900 Design Speaker Series, “Why Design Patent Examination Matters” (Nov. 9, 2022) (the first in a new series of learning opportunities for design patent examiners).

University of Iowa, Intellectual Property Scholarship Seminar, *Uncreative Designs* (Oct. 12, 2022).

Northeastern University School of Law, Faculty Colloquium, *Uncreative Designs* (Sept. 28, 2022).

U.S. Patent & Trademark Office, Design Webinar Series, “The Fashion Frontier: Current and Emerging Issues in Design Patents,” Panelist (July 27, 2022).

The UK Chartered Institute of Trade Mark Attorneys (CITMA) Webinar, Speaker, *Introduction to U.S. Design Law* (May 25, 2022).

Vanderbilt Law School, Vanderbilt IP Program, Panelist, “Domestic & International Perspectives on U.S. Design Law” (Apr. 6, 2022).

Javeriana University (Bogotá), Panelist, “Diseños Industriales & Design Patents: Regímenes Andino & Estadounidense” (Nov. 9, 2021).

UC Berkeley School of Law, BCLT/BTLJ Symposium: Navigating and Rectifying the Design Patent Muddle, Panelist (Feb. 19, 2021).

Notre Dame Law School, Patent Colloquium (September 2020–May 2021).

University of Texas School of Law, Texas Law Review Symposium: Remedies in Complex Litigation, Moderator, “Copyright & Trademark” (Jan. 31, 2020).

Michigan Law School, Intellectual Property Workshop, *Whole Designs* (Nov. 25, 2019).

Notre Dame Law School, Design Law Scholars Roundtable (Nov. 15-16, 2019).

Houston Law Center, Institute for IP & Information Law Annual Fall Lecture (Nov. 7, 2019).

Notre Dame Law School, Remedies Roundtable (June 20, 2019).

University of Houston Law Center, Sixteenth Annual Works-In-Progress Intellectual Property Colloquium, *Whole Designs* (Feb. 9, 2019) (selected for the plenary session).

Association of American Law Schools (AALS) Annual Meeting, Section on Remedies, Panelist, "Intellectual Property Remedies at the Supreme Court and Worldwide" (Jan. 4, 2019).

International Trademark Association (INTA) 141st Annual Meeting, Panelist, "Comparative Design Remedies" (May 18, 2019).

New York University School of Law, Engelberg Center Symposium: Proving IP, Panelist, "Proving Damages" (May 16, 2019).

Chicago-Kent College of Law, Center for Design, Law & Technology Series, *Whole Designs* (Nov. 14, 2018).

UNC School of Law, Faculty Workshop Series, *Whole Designs* (Oct. 11, 2018).

UC Berkeley School of Law, BCLT/BTLJ Symposium: The Administrative Law of Intellectual Property, *Is Design Patent Examination Too Lax?* (Apr. 12, 2018).

Intellectual Property Law Association of Chicago, *Is There Anything to Cheer About In The Aftermath of Star Athletica?* (Mar. 8, 2018).

Chicago-Kent College of Law, 8th Annual Supreme Court IP Review (SCIPR), Panelist, *Samsung v. Apple* (Sept. 28, 2017).

Indiana University Maurer School of Law, Intellectual Property Colloquium, *The "Article of Manufacture" Today* (Sept. 14, 2017).

International Trademark Association (INTA) 139th Annual Meeting, Panelist, "Exploring the Boundaries of Functionality: Aesthetic and Acquired Functionality in the U.S. and Europe" (May 22, 2017).

New York University School of Law, Design2 Conference, *Partial Designs* (May 11, 2017).

Kanazawa University, Fifth Asia-Pacific IP Forum, *Partial Designs* (Mar. 19, 2017).

Waseda University, Presenter, Design Protection System Seminar, "Design Protection in the US: The Patent Approach" (Mar. 11, 2017).

- Association of American Law Schools (AALS) Annual Meeting, Moderator & Organizer, Section on Art Law Program on “Art, Separability, and the Future of Copyright for Designs” (Jan. 4, 2017).
- Chicago Bar Association, Young Lawyers Section Intellectual Property Committee Meeting, “Design Patent Damages” (May 4, 2016).
- University of Pennsylvania Law School, Design Intellectual Property Exploratorium (Apr. 8, 2016).
- Boston University School of Law, IP Speaker Series, “Design Patent Damages” (Mar. 30, 2016).
- Northwestern Pritzker School of Law, Northwestern Journal of Technology and Intellectual Property Symposium, Panelist, “Design Patent Construction in the post *Apple v. Samsung* Era” (Mar. 10, 2016).
- ETH Zürich, Transatlantic Innovation Scholarship Conference: “Design Protection → Design Innovation?” (June 11–12, 2015).
- New York University School of Law, Innovation Policy Colloquium, *The Patented Design* (Feb. 19, 2015).
- College Art Association 103rd Annual Conference, Discussant, Session on “Copyright and the Visual Arts in America: A Historical Perspective” (Feb. 11, 2015).
- The George Washington University Law School, IP Speaker Series, *Costly Designs* (Oct. 16, 2014).
- Savannah College of Art & Design, Industrial Designers Society of America (IDSA) Southern District Conference, Presenter, “Patenting Designs” (Apr. 12, 2014).
- UC Hastings College of the Law, Fashion Law Symposium, Presenter, “Design Patents in Apparel” (Feb. 28, 2014).
- College Art Association 102nd Annual Conference, Session on “Design and the Law: Opportunity and Constraint,” *Costly Designs* (Feb. 13, 2014).
- Chicago-Kent College of Law, Chicago Intellectual Property Colloquium, *Costly Designs* (Jan. 28, 2014).
- Association of American Law Schools Annual Meeting, Section on Intellectual Property, Moderator, “Protecting Design” (Jan. 4, 2014).
- Max Planck Institute for Intellectual Property & Competition Law, Design Law Roundtable (Nov. 22-23, 2013).
- Stanford Law School, Design Patents in the Modern World Symposium, *In Defense of Design Patents* (Apr. 6, 2013).
- University of Oxford, The Future of Design Protection Conference, *Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright for Designs* (Nov. 3, 2012).

SELECTED COLLEGE & UNIVERSITY SERVICE

Suffolk University

Clinical Appointments Committee (2023–2024)

Faculty Appointments Committee (2022–2023)

Scholarship Committee (2022–2024)

University of Oklahoma

Faculty Appointments Committee (2020–2021)

Curriculum & Scheduling Committee (2017–2018)

Faculty Advisor, IP Society (2015–2022)

Faculty Senate (2015–2018)

SELECTED PROFESSIONAL SERVICE

The Association of American Law Schools (AALS):

Executive Committee, Remedies Section: 2021, 2022, 2023

Executive Committee, IP Section: 2019, 2022

Executive Committee, Art Law Section: 2014, 2017

Chair, Section on Art Law: 2016

Chair-Elect, Section on Art Law: 2015

Contributor, JOTWELL: J. THINGS WE LIKE (LOTS), IP Section, 2020–Present

Chicago Women in IP (ChiWIP), 2015–2019

Intellectual Property Law Association of Chicago (IPLAC), 2008–2010

U.S. & International Trademark Committee, 2008–2010

Copyright Committee, 2009–2010

Richard Linn American Inn of Court, 2008–2010

TEACHING & RESEARCH INTERESTS

Design Law, Copyright, Trademarks & Unfair Competition, Patents, Art & Cultural Heritage Law,
Civil Procedure, Remedies

WORKSHOPS & CONFERENCES ORGANIZED

Suffolk University Law School, Annual IP & Innovation Conference (co-organizer): 2022, 2023

M³ IP Scholars Workshops (co-organizer): 2020, 2021, 2022, 2023

Works-in-Progress Intellectual Property (WIPIP) Colloquium (co-organizer): 2023

Junior Intellectual Property Scholars Association (JIPSA) Workshop: 2018

Oklahoma Junior Scholars Conference (co-organizer): 2013, 2014, 2015, 2016

SELECTED MEDIA APPEARANCES & QUOTATIONS

Quoted in news outlets including THE WALL STREET JOURNAL, NATIONAL PUBLIC RADIO (ALL THINGS CONSIDERED), REUTERS NEWS, WIRED.COM, FORBES.COM, TIME.COM, FAST COMPANY, CURBED, 99U.COM, 404 MEDIA, MANAGING IP, LAW360 & BLOOMBERG LAW

Sarah Burstein & Saurabh Vishnubhakat on the Truth About Design Patents, IPSE DIXIT PODCAST (Feb. 22, 2022).

Burstein, Rajec & Sawicki on Writing an Open-Access Patent Law Casebook, IPSE DIXIT PODCAST (Oct. 9, 2020).

Sarah Burstein on the Ontology of the Patented Design, IPSE DIXIT PODCAST (Apr. 1, 2019).

BAR ADMISSIONS

Supreme Court of Illinois, U.S. District Court for the Northern District of Illinois, U.S. Court of Appeals for the Federal Circuit, Supreme Court of the United States

PROFESSIONAL EXPERIENCE

The Honorable Robert W. Pratt, U.S. District Court for the Southern District of Iowa
Law Clerk, September 2010–July 2012

Kirkland & Ellis LLP, Chicago, Illinois
Intellectual Property Litigation Associate, September 2007–July 2010
Summer Associate, June 2006–August 2006

The Honorable Richard A. Posner, The University of Chicago Law School
Academic Research Assistant, June 2005–May 2006