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Article

**ENOUGH IS ENOUGH: TIME TO ELIMINATE DESIGN PATENTS AND RELY ON MORE APPROPRIATE
COPYRIGHT AND TRADEMARK PROTECTION FOR PRODUCT DESIGNS**

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***326 I. Introduction**

In 1841, the United States did not afford protection to new and original product designs.¹ The Commissioner of Patents, Henry Ellsworth, had received many complaints from designers who were astonished that the Patent Office did not protect their designs and that others could freely copy and sell them with no legal consequences.² Ellsworth heard their pleas and addressed Congress, urging it to adopt a new form of statutory protection to cover the ornamental appearance of useful articles of manufacture.³ At that time, copyright laws extended protection to only purely intellectual products such as writings, prints, and musical compositions.⁴ Patent laws protected “new and useful machines, manufactures, and compositions of matter.”⁵ Thus, product designs seemed to fit somewhere in between the patent and copyright systems.⁶ Although product designs are not useful in the way that the products themselves are, the designs are embodied in useful physical products.⁷ This may be one of the reasons that Congress ultimately decided to protect product designs under the patent laws instead of the copyright laws.⁸ Congress may have also been compelled to protect product designs under the patent laws because the original suggestion came from the Commissioner of Patents.⁹

Whether Congress should have initially protected product designs under the copyright laws is a moot point. In 1842 the first design patent statute was enacted.¹⁰ The act created patent protection for new and original (1) designs for products, (2) shapes or configurations of products, (3) impressions or ornaments to be placed on products, (4) patterns, prints, or pictures to be worked or fixed onto products, (5) designs for the printing of fabrics, and (6) designs for sculptures or carvings.¹¹ Thus, the original subject matter of design patents covered virtually all artistic and distinctive aesthetic innovations in the commercial products realm. The scope of design patent subject matter remains the same today.¹²

Patent protection is a very strong form of intellectual property protection because it grants the patentee the broad right to exclude others from making, using, offering for sale, selling, or importing the claimed subject matter without permission.¹³ Proof of copying or consumer confusion is not required to infringe a patent,¹⁴ unlike copyright infringement¹⁵ and trademark infringement,¹⁶ respectively. Copyright and trademark rights are also qualified, for example, by their respective doctrines of fair use.¹⁷ When the first design patent legislation was passed, although product designs did not fit neatly into the patent laws, there were no appropriate or more suitable alternatives. However, the federal trademark and *328 copyright laws have since evolved to the point where they now cover essentially the same subject matter as design patents.¹⁸ As design patent law has evolved, it has become apparent that designs, as products of creative expression applied to goods, are more suitably protected under modern copyright and trademark statutory schemes. Because copyright is intended to protect and promote artistic expression,¹⁹ it can protect designs to the extent that designers need those incentives. Because trademark law is intended to protect against consumer confusion and deception,²⁰ it can protect designs to the extent that it prevents those harms. Promoting artistic designs and preventing consumer deception are the twin goals of the design patent system, and those can now be more appropriately addressed without design patents. Therefore, design patents should be phased out of existence.

Part II of this paper explores and explains the original motivations for and purposes of the design patent laws. Part III illustrates how copyright and trademark laws have evolved since the first design patent statutes to now cover the subject matter of product designs. Part IV compares the requirements for design protection under the patent, copyright, and

trademark laws, showing the strong similarity between them. Part V compares the standards for infringement of designs under the patent, copyright, and trademark laws, demonstrating their effective similarity. Part VI explores how designs are protected across the different statutory schemes. Part VII considers the reliance interests in the design patent system. Part VIII looks comparatively at how the European Union protects its designs. Finally, Part IX concludes by explaining that the purposes of the design patent system are best served by dually protecting designs under copyright and trademark laws.

II. The Original Purposes of the Design Patent Laws

When Commissioner Ellsworth spoke to Congress in 1841, he stressed that without design protection, manufacturers could freely copy their competitors' designs.²¹ Thus, there was little incentive for designers to invest much of their resources in creating new designs.²² With protection, Ellsworth argued, the financial incentive would increase design output and quality.²³ Congress agreed *329 and adopted Ellsworth's recommendation as well as much of his language.²⁴ Ellsworth made a strong case that design protection would promote the creation of new and better designs. While his argument required some form of protection, it did not specifically require patent protection. Congress' main intent in enacting the design patent statutes can be fairly deemed to be merely a desire to protect, and thereby promote, designs. Patent protection was simply a convenient option at the time.

It soon became clear that designs were far removed from the traditional subject matter of utility patents, which protect the useful features of machines, processes, articles of manufacture, and compositions of matter.²⁵ In *Gorham Manufacturing Co. v. White*,²⁶ the Supreme Court noted that design patent law was "plainly intended to give encouragement to the decorative arts."²⁷ The Court emphasized that "[i]t is the appearance itself . . . that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense."²⁸ Therefore, designs merit protection to the extent that they provide some aesthetic value, rather than utility.

The Court in *Gorham* also noted that designs "enhance [the] salable value" and "enlarge the demand" for products.²⁹ While discussing the standard for infringement, the Court expressed serious concern over consumers being "misled" or "induced to purchase what is not the article they supposed it to be."³⁰ Thus, under *Gorham*, a product infringes a patented design when it looks similar enough to that design to potentially deceive consumers.³¹ Design patents therefore help to prevent competitors from unfairly profiting from another's distinctive design.

Two primary motivations for designing were identified by the Supreme Court in *Gorham*: (1) designs can make the world a more aesthetically pleasing place,³² and (2) designs can enable manufacturers to distinguish their products from those *330 of their competitors.³³ The Court explained that an exclusive right to one's design would preserve these motivations and thereby "promote the decorative arts" while at the same time protecting against potential consumer confusion. It was not until much later that copyright and trademark laws matured to the point that they could serve these purposes for designs.

III. The Historical Development of Copyright and Trademark Protection for Designs

This section looks at the copyright and trademark laws in place when the design patent system was first established and shows why each could not initially protect product designs. This section also illustrates how, over time, the respective doctrines have independently evolved to cover effectively the same subject matter as design patents.

A. How Copyright Came to Protect "Designs for Useful Articles"

The Copyright Act of 1870 added "statues" and "models or designs intended to be perfected as works of the fine arts" to the list of copyrightable subject matter.³⁴ After this Act, the U.S. Copyright Office began registering sculptures incorporating useful articles as works of art.³⁵ In the Act of 1909, Congress eliminated the requirement that models and designs be "intended to be perfected as works of the fine arts."³⁶ The 1909 Act listed more generally that "works of art" (encompassing sculpture, drawings, and paintings)³⁷ and "models or designs for works of art" were copyrightable.³⁸ Interpreting the Act, the Copyright Office no longer registered matter "utilitarian in purpose and character," "even if artistically made or ornamented."³⁹ After the 1909 Act there were no more distinctions made by Congress between "purely aesthetic articles and useful works of art."⁴⁰ Nevertheless, the Copyright Office changed its regulations to acknowledge that *331 useful articles can sometimes be fairly considered works of art, and continued to register sculptural works embodied in useful products through 1952.⁴¹

In the landmark case of *Mazer v. Stein*, the Supreme Court addressed the question of whether the copyright statutes afforded protection for designs incorporated into commercial products.⁴² *Mazer* involved a statuette of a dancing figure that was registered in the copyright office as a sculpture, but was actually used as the base of a table lamp.⁴³

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

Picture 1: Stein Statuette⁴⁴

The alleged infringer argued that the existence of the design patent laws precluded the availability of copyright protection for the lamp.⁴⁵ The Court rejected that argument and held that the lamp design's eligibility for patent protection did not bar it from also being copyrightable as a work of art.⁴⁶ This decision was based on the distinction between the protection afforded by patent law and copyright law--patent law protects the invention of an original design while *332 copyright law protects art.⁴⁷ Noting that (unlike patent law) copyright law protects only the expression of an idea and not the idea itself, the Court stated that the lamp designer "may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such or as incorporated in some other article."⁴⁸ Here, the Court seems to suggest that if the statuette were covered by a design patent, the patentee would have the broad right to exclude others from using the general idea of a human figure as the base of a lamp.⁴⁹ However, such a reading would be a misstatement of the right to exclude that is afforded by a design patent. The test for infringement of a design patent is whether an ordinary observer would find that the allegedly infringing design has a "sameness of appearance" to the patented one, not whether the accused infringer used the same artistic idea in general.⁵⁰

The *Mazer* rule was codified in the Copyright Act of 1976.⁵¹ The Act expressly declared that the design of a useful article is eligible for copyright protection as a pictorial, graphic, or sculptural work.⁵² However, Congress qualified that rule by stating that a design could be protected by copyright "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 aspects of the article."⁵³ Useful articles were defined as "article[s] having an intrinsic utilitarian function that [are] not merely to portray the appearance of the article[s] or to convey information."⁵⁴ Thus, by 1976 product designs were clearly covered by copyright law.

B. How Trademark Law came to Protect "Trade Dress" and "Product Design"

For thousands of years, humans have used symbols to lay claim to articles or indicate their origin.⁵⁵ Perhaps the earliest and most well-known example of this is the branding of animals, from which the term "brand name" originates.⁵⁶ *333 Eventually, English common law recognized a cause of action in the tort of deceit against those who placed another's mark onto their own inferior goods.⁵⁷ Around the beginning of the nineteenth century, United States common law developed a similar doctrine to prevent unfair competition and consumer confusion.⁵⁸ The doctrine prohibited "passing off" one's own goods as those of another.⁵⁹

In 1870, Congress enacted the first trademark statute.⁶⁰ The Supreme Court noted that Congress' power to create trademark law does not stem from its constitutional mandate to promote the progress of art and science.⁶¹ Finding that "the ordinary trademark has no necessary relation to invention or discovery," the Court observed that trademark rights derive from being the first to adopt and use a "distinctive symbol."⁶² The symbol "requires no fancy or imagination, no genius, nor any laborious thought," and can be "plain, simple, old, or well-known."⁶³ On the other hand, copyright and patent laws require originality and invention.⁶⁴ The Court has maintained that unfair competition laws are intended to serve different purposes than those of patent and copyright law:

The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source. While that concern may result in the creation of "quasi-property rights" in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.⁶⁵ Trademark and unfair competition law has stayed true to its roots: it continues to emphasize the prevention of harm to consumers by deceptive trade practices.

In order to prevent certain harms to consumers, section 43(a) of the Lanham Act was enacted in 1946.⁶⁶ Section 43(a) covers various forms of unfair competition and unfair trade practices that misappropriate or harm one's *334 goodwill.⁶⁷ In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court held that section 43(a) provides for certain trademark-like rights in distinctive "trade dress."⁶⁸ Trade dress refers to a product's "total image and overall appearance."⁶⁹ In *Two Pesos, Taco Cabana*, a Mexican restaurant, asserted trade dress rights in its festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio include[d] interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building [was] a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue[d] the theme.⁷⁰

The Court was clear that "an identifying mark [e.g., trade dress] is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning."⁷¹ Ultimately, the Court held that trade dress, such as *Taco Cabana*'s, could be inherently distinctive and thus protectable without proof of secondary meaning.⁷² However, the Court also noted that trade dress is protected only to the extent that it is "nonfunctional."⁷³

The Supreme Court further addressed the topic of trade dress in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*⁷⁴ There, the Court noted that trade dress had been construed by the Circuit Courts to mean not only the external packaging or dressing of a product, but also product design.⁷⁵ The Court took up the question of when product design is distinctive, and therefore protectable under section 43(a).⁷⁶ *Samara Brothers* asserted trade dress rights in its "line of spring/summer one-piece seersucker outfits decorated with appliqués of hearts, flowers, fruits, and the like."⁷⁷ *335 The Court distinguished product packaging from product design, saying that the purpose of distinctive product packaging is to identify the source of the product.⁷⁸ On the other hand, [i]n the case of product design . . . consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs - such as a cocktail shaker shaped like a penguin - is intended not to identify the source, but to render the product itself more useful or more appealing.⁷⁹

The Court possessed "little confidence that a reasonably clear test [for inherent distinctiveness of product design could] be devised."⁸⁰ It also expressed concerns that competition would be stifled by groundless assertions of inherently distinctive product design infringement.⁸¹ Accordingly, the Court ultimately held that secondary meaning must be shown for product designs to be protectable under section 43(a).⁸² The availability of design patent and copyright protection, the Court said, should mitigate any harm to producers that might result from having to prove secondary meaning.⁸³ In other words, the Court encouraged designers to rely on patent and copyright protection until they could build up enough secondary meaning to obtain trademark protection. Thus, with some important qualifications, product designs were clearly covered by trademark and unfair competition law after *Wal-Mart*.

IV. Comparing the Current Subject Matter of Protectable Designs Under the Patent, Copyright, and Trademark Laws

Having established that product designs are now eligible for protection under patent, copyright, and trademark laws, this section explores in further detail the subject matter of protectable product designs under the respective intellectual property schemes. The requirements for protection under each system, as well as the tests for determining whether those requirements are met, are compared. With the exception of the unique requirements of nonobviousness for patents and secondary meaning for trademarks, the prerequisites for protection are closely analogous, if not interchangeable, across the different schemes.

***336 A. The Subject Matter of Design Patents**

The current design patent laws cover "any new, original, and ornamental design for an article of manufacture."⁸⁴ Designs must also be nonobvious.⁸⁵ Essentially, designs fall under three categories: (1) shapes or configurations of articles of manufacture, (2) ornaments, impressions, prints, or pictures applied to or embodied in articles of manufacture, and (3) combinations of the first two categories.⁸⁶ What constitutes an article of manufacture has been broadly construed by courts to include "anything made 'by the hands of man' from raw materials, whether literally by hand or by machinery or by art."⁸⁷ The design patent covers the individual design features (the so-called points of novelty) that are applied to the article.⁸⁸

To satisfy the ornamental requirement, the claimed design must essentially be arbitrary, that is, not dictated by how the article is used.⁸⁹ Note that attractiveness is not the test for determining whether the ornamental requirement has been satisfied.⁹⁰ Many useful articles of manufacture are naturally pleasing to the eye because their function or mechanical operation dictates such a form.⁹¹ Despite this *337 reality, design patents protect only aesthetic design features that are independent of functional considerations.⁹²

The “ornamental” requirement of the design statute means that the design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function. . . . The design may contribute distinctiveness or consumer recognition to the design, but an absence of artistic merit does not mean that the design is purely functional.⁹³

Thus, a design patent can be obtained with little aesthetic consideration or artistic skill. Because the artistic threshold is so low, any arbitrary design decision--any decision not motivated by practical concerns like functionality-- will satisfy the ornamental requirement.

Another design patent requirement is novelty and it can be much more difficult to satisfy than the ornamental requirement. The test for design novelty (i.e., anticipation) is the same as that for design infringement.⁹⁴ The difference between anticipation and infringement is timing: “that which infringes, if later, would anticipate, if earlier.”⁹⁵ A design is anticipated if its nonfunctional features are substantially similar to those of a prior art design.⁹⁶ “Two designs are substantially the same if their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other.”⁹⁷ In other words, designs are patentable only to the extent that they would not lead an ordinary observer to be confused as to the source of the design.

The next requirement to obtain a design patent is originality. Designs are considered original as long as the patentable ornamental features were first conceived by the patent applicant, and not derived from others who are not named as inventors of the design.⁹⁸ For example, some courts have held that simulations *338 or imitations of natural objects (e.g., people, animals, and trees) are unpatentable, while artistic renderings or caricatures of them can be.⁹⁹

The final requirement to obtain a design patent is nonobviousness, and it is the most difficult requirement to meet.¹⁰⁰ Early Supreme Court cases dealt with obviousness by requiring “the exercise of the inventive faculty.”¹⁰¹ The modern test is somewhat analogous: “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.”¹⁰² The determination of obviousness is more difficult to make in the case of design patents than utility patents, in large part because it is normative and necessarily subjective.¹⁰³ As a result, it can be “exceedingly difficult” for designers to prove nonobviousness unless their designs are truly extraordinary, outstanding, or remarkable.¹⁰⁴

B. Copyrightable Designs for Useful Articles

Copyright protection is available for “original works of authorship fixed in any tangible medium of expression.”¹⁰⁵ The Supreme Court has construed the originality requirement as follows:

The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.¹⁰⁶ *339 Notably, the standard for copyright originality is much easier to satisfy than the combined requirements of originality, novelty, and nonobviousness for design patents.¹⁰⁷

Original designs for useful articles are protectable only if the design features are separately identifiable from and can exist independently of the functional aspects of the article.¹⁰⁸ In practice, it can be difficult to distinguish the creative elements of the design from the utilitarian features of the product, just as it can be difficult to discern which features of a patented design are ornamental.¹⁰⁹ When the creative and functional elements cannot be physically separated, courts have come up with various tests for determining if a design is “conceptually separable” from the article in which it is embodied.¹¹⁰ One test in particular, formulated by Robert Denicola, has been influential and gained support among several circuit courts.¹¹¹ Denicola’s

test asks whether the elements of the design “reflect the unconstrained perspective of the artist,” independent of functional considerations.¹¹² This test is effectively the same as that under the functionality doctrine for design patent law: both tests emphasize that the design features must not be motivated by practical concerns, but only artistic or arbitrary ones.¹¹³

To illustrate Denicola’s test, it is helpful to consider a few examples where copyright was asserted in designs. In *Kieselstein-Cord v. Accessories by Pearl, *340 Inc.*, the plaintiff was a designer of two creatively and uniquely sculpted belt buckles that combined art nouveau influences with Spanish architecture in one design (the “Vaquero”), and with the butt of an antique Winchester rifle in another (the “Winchester”).¹¹⁴

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Picture 2: Kieselstein-Cord Belt Buckles¹¹⁵

The court held that the sculptural features incorporated into the buckles were instances of art being “applied” to a belt buckle.¹¹⁶ The original and creative elements of the design went beyond what is functionally required to hold up one’s pants, and also beyond mere variations of the basic shape and structure of a belt buckle.¹¹⁷ Therefore, the court held that the buckles contained conceptually separable and copyrightable expression.¹¹⁸

In *Brandir International v. Cascade Pacific Lumber Co.*, Brandir designed the “Ribbon Rack,” a bike rack constructed from bent tubing.¹¹⁹

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Picture 3: Brandir Bike Rack¹²⁰

***341** The court expressly adopted Denicola’s test for conceptual separability and found that despite its aesthetic appeal, the design features of the rack were constrained by functional concerns.¹²¹ The material, size, and dimensional proportions of the rack are what enabled it to accommodate an optimal number of bikes both safely and securely.¹²² Therefore, the design features asserted in the rack were not deemed to be independent artistic choices, and were not conceptually separable from the rack itself.¹²³ Accordingly, the rack was denied copyright protection.¹²⁴

The Brandir court emphasized the fact that the designer had made similar looking sculptures before, and had adapted them to make the bike rack.¹²⁵ However, in so doing, the court misapplied its own test for conceptual separability. It is true that the rack was adapted in terms of certain proportions and materials to best accommodate bicycles, and that several design features were thus dictated by function.¹²⁶ However, the court’s adopted test is supposed to look at whether individual design features reflect the unconstrained perspective of the artist, not the design as a whole.¹²⁷ Likewise, to prove infringement, a copyright holder must first show that individual design elements have been copied before proving that such copying amounts to an improper appropriation.¹²⁸ Thus, a design is copyrightable as long as there exist some features that are original and nonfunctional, but the protection extends only to those particular features. The design patent system operates in a similar fashion, affording protection only to the features that satisfy ***342** the criteria for patentability, which sometimes may yield only narrow coverage for a product design.¹²⁹

In Brandir, although the designer did have to adjust the bike rack design in some ways to serve its utilitarian purpose, the court erred in finding that there were no copyrightable features in the design. For example, the designer made an artistic choice to use a continuous piece of metal that was only anchored to the ground at the two ends, leaving the central undulations floating above the ground. The designer could have attached the rack to the ground at each undulation, or could have made the rack consist of a series of upside-down U’s, each one individually anchored to the ground. Furthermore, the designer chose to have the rack be smoothly rounded instead of square or triangular. The designer could have used any of these alternative designs and still preserved the utilitarian proportions that allow the rack to function properly. Thus, the Brandir court incorrectly denied the rack copyright protection across the board. Even when there are many features that are dictated by function (which there typically will be since the designs are for useful products), copyright law still protects any individual arbitrary design features.

This low threshold for originality should allow the vast majority of designers to obtain some copyright protection for their designs, even if the scope of that protection is narrow in some instances.¹³⁰ In order to obtain broader protection, designs

simply must be more creative--this legal reality promotes progress in the designing arts.

C. Product Designs Under Lanham Act § 43(a)

There are essentially three requirements for trade dress protection under section 43(a) of the Lanham Act: the trade dress must be (1) distinctive, (2) nonfunctional, and (3) not confusingly similar to any pre-existing trade dress in use.¹³¹

Distinctiveness enables the trade dress to indicate the source of a product, and can be either inherent or acquired through secondary meaning.¹³² To show that the trade dress is inherently distinctive, the product is compared to competing products *343 to illustrate its uniqueness. In *Two Pesos*, the Court expressly endorsed the classification system for trademarks set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, saying that the system was both a proper and useful way to determine whether trade dress is inherently distinctive.¹³³ The Abercrombie court constructed a spectrum of distinctiveness for trademarks--arbitrary or fanciful, suggestive, descriptive, and generic--in order of decreasing distinctiveness.¹³⁴ Thus, the more arbitrary the features of trade dress are, the more inherently distinctive the trade dress is overall.

In the Wal-Mart Court's discussion of trade dress distinctiveness, the line drawn between product packaging and product design trade dress is not easy to decipher.¹³⁵ The design for Tide laundry detergent, "squat, brightly decorated plastic bottles," was considered product packaging which could be inherently distinctive,¹³⁶ while the penguin-shape of cocktail shakers was considered a product design that required proof of secondary meaning.¹³⁷ The Court's test for how to categorize trade dress was whether its purpose is to identify or signal the source of the product (i.e., the brand) or whether its purpose is to make the product more appealing to consumers.¹³⁸ The Court conceded that there would be tough cases at the margins.¹³⁹ For example, the classic Coke bottle design would be considered packaging by the purchaser who simply wants to drink the soda, but the same design would be considered the product for the purchaser who collects bottles or who prefers to drink soda out of glass bottles.¹⁴⁰ Such close calls, the Court declared, should be deemed product designs to protect consumers and producers alike from the competitive harms that can result from improper assertions of inherently distinctive trade dress rights.¹⁴¹

The Federal Circuit has held that whether trade dress is product packaging or product design is determined by considering how consumers perceive the trade dress.¹⁴² This perception is a question of fact that is best proven with potentially *344 costly consumer testimony, surveys, etc.¹⁴³ Although some courts have had no trouble classifying trade dress as either product packaging or product design,¹⁴⁴ a number of courts have found trade dress classifications to be ambiguous and have deemed them to be product design as required by Wal-Mart.¹⁴⁵ The Wal-Mart framework therefore presents a very real risk that any commercial product's trade dress may well be deemed product design, requiring proof of secondary meaning. Small startup companies may suffer from having to wait until their trade dress has had enough time to establish secondary meaning before they can acquire trademark rights.¹⁴⁶ This requirement, that non-inherently distinctive designs must be shown to function as source identifiers, is unique to trademark law. Source identification and consumer association are not requirements for product designs to be eligible for protection under patent or copyright law.

The second requirement under section 43(a) is that the trade dress must be nonfunctional.¹⁴⁷ This requirement ensures that producers cannot stifle competition by attaining perpetual monopolies on useful product features.¹⁴⁸ Product features are functional when they are necessary for the article to be used, serve the article's purpose, or affect the quality or cost of the article.¹⁴⁹ For example, the bike rack in *Brandir* was the subject of a section 43(a) claim in addition to the copyright *345 claim.¹⁵⁰ The court noted that the nonfunctionality requirement for trade dress is somewhat different from that for copyright because it stems from a slightly different policy.¹⁵¹ According to *Brandir*, trade dress nonfunctionality analysis would ask whether there are alternative bike rack constructions that would function in the same way so that bike rack manufacturers could compete in the market without using the specific features of *Brandir*'s rack.¹⁵² Thus, trade dress nonfunctionality would be proven by showing that a design feature was "merely an ornamental, incidental, or arbitrary aspect of the device."¹⁵³ Similarly, the copyright doctrine of conceptual separability focuses more on the artistic process than on competitive harm--it requires that the design features "reflect the unconstrained perspective of the artist."¹⁵⁴ Thus, the nonfunctional requirement for trade dress, although it stems from different policy considerations, is tested in essentially the same manner as the conceptual separability requirement in copyright law.¹⁵⁵ Additionally, both of these requirements are closely analogous to the ornamental requirement for design patents.¹⁵⁶ Under all three schemes, the design features must be the product of arbitrary or unconstrained decisions by the designer.

Finally, trade dress cannot be appropriated if it is confusingly similar to an existing trade dress.¹⁵⁷ This is analogous to the novelty requirement for design patents, which requires that a design not appear similar enough to a prior art design to deceive

consumers into thinking that it actually is the prior art design.¹⁵⁸ Consumer confusion will be addressed in greater detail in the following section.

***346 V. Comparing the Current Standards for Infringement of Designs Under the Patent, Copyright, and Trademark Laws**

Each of the three intellectual property schemes have similar prerequisites for extending protection to designs. This section addresses how rights in protected designs may be successfully enforced. The standards for infringement and the scope of the property rights will be shown to be effectively the same for each of the three intellectual property schemes.

A. Design Patent Infringement - The Ordinary Observer Test

A design patent grants the patentee the right to exclude others from making, using, offering for sale, selling, or importing the claimed design.¹⁵⁹ The scope of design patent protection is not limited to enforcement against directly competing articles.¹⁶⁰ As long as the patented design has been appropriated, it does not matter if the products are sold in different markets to different purchasers; in fact, the patentee does not need to produce the product at all.¹⁶¹ However, the accused design is almost invariably embodied in the same type of product.¹⁶² This is because significant changes in the underlying product typically alter the appearance to the point that infringement is unlikely.¹⁶³ However, the U.S. Patent Office and the courts allow some flexibility as to what particular types of articles can be covered by the same design patent.¹⁶⁴ For example, one court held that a design for an adult's tennis shoe could be infringed by a shoe made for children.¹⁶⁵ Another court held that a design designated as a "tire tread" was not limited to truck tires, even though truck drivers would be the ordinary purchasers of the article, because the application and prosecution history made no such limitations.¹⁶⁶

Infringement is determined by comparing the accused product to the claimed design, not by comparing it to the patentee's commercial embodiments, if any.¹⁶⁷ *347 The scope of the design patent claim is dictated by the drawing(s) that are submitted in the patent application, as opposed to the literally worded claims of utility patents.¹⁶⁸ Since design patent claims do not have the inherent difficulties of linguistic precision that utility patent claims do, courts generally see no need to use the doctrine of equivalents to find infringement of design patents.¹⁶⁹ However, the scope of a design patent claim may be limited by the prosecution history if, for example, the patentee tried to assert rights in a design feature that had previously been argued not to be a point of novelty.¹⁷⁰

To determine if an accused design infringes the patent, the courts look from the perspective of the ordinary observer to see if the designs are substantially similar.¹⁷¹ "Two designs are substantially the same if their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other."¹⁷² Thus, the scope of a design patent is limited to its "overall ornamental visual impression, rather than to the broader general design concept."¹⁷³ However, regardless of how similar a product appears to a patented design, there can be no infringement unless the product specifically includes the patented design's points of novelty.¹⁷⁴

When testing for design patent infringement, the identity of the "ordinary observer" varies along with the particular design.¹⁷⁵ As a general rule, the ordinary observer is the "ordinary purchaser of the article charged to be an infringement."¹⁷⁶ For example, in *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, the Federal Circuit held that the ordinary observer for a truck tire is a truck driver or fleet operator, not tire purchasers in general, who would tend to be less discriminating in their purchases.¹⁷⁷

***348 B. Copyright Infringement - Substantial Similarity and Fair Use**

The Supreme Court has noted that "[n]ot all copying [constitutes] copyright infringement."¹⁷⁸ To prove copyright infringement of a design for a useful article, the owner of a valid copyright must show that the alleged infringer copied the protected elements of the design, i.e., the original and arbitrary features.¹⁷⁹ However, the inquiry does not end simply because protected elements of the design have been copied; the owner must also prove that the copying was substantial enough to amount to an improper appropriation of the design.¹⁸⁰

In the copyright context, "copying" means actually copying from the copyrighted work.¹⁸¹ Because direct evidence of copying

(such as an admission) is rare, actual copying is typically proven circumstantially by showing both access to the copyrighted work and substantial similarity to it.¹⁸² The more similar the allegedly infringing product is to the copyrighted design, the less important proof of access becomes, and vice versa.¹⁸³ Evidence of coincidence, independent creation, or prior common source can be used by the defendant to negate an inference of copying.¹⁸⁴ However, evidence of a “striking similarity” between the copyrighted work and the allegedly infringing works can rebut those defenses.¹⁸⁵

Once actual copying has been shown, the point at which the similarity between the accused and copyrighted works becomes substantial enough to infringe is concededly an arbitrary line, but the test is intentionally vague to allow courts to account for the difficulty in determining what expressions in a work are protectable through copyright law.¹⁸⁶

In the case of verbal “works” it is well settled that although the “proprietor’s” monopoly extends beyond an exact reproduction of the words, there can be no copyright in the “ideas” disclosed but only in their “expression.” Obviously, no principle can be stated *349 as to when an imitator has gone beyond copying the “idea,” and has borrowed its “expression.” Decisions must therefore inevitably be ad hoc. In the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible. No one disputes that the copyright extends beyond a photographic reproduction of the design, but one cannot say how far an imitator must depart from an undeviating reproduction to escape infringement. In deciding that question one should consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used.¹⁸⁷ Thus, infringement of a copyrighted design turns on whether an “ordinary observer” would overlook any dissimilarities between the designs and “regard their aesthetic appeal as the same.”¹⁸⁸ Who should be considered an ordinary observer for any given work is subject to some debate.¹⁸⁹ When a work is directed to a specific audience instead of the general public, the dominant approach by courts places special emphasis on the impression that the accused work has on that target audience.¹⁹⁰ For example, when a work is specifically geared toward children, the similarity must be evaluated from the perspective of the child audience.¹⁹¹ Thus, if a child would see a “Duffy” costume and think that it is actually the popular “Barney” dinosaur character, the “knock-off” would infringe even though more discerning adults would be the ones making the actual purchases.¹⁹² The standard for design copyright infringement asks whether the relevant audience of ordinary observers would find that an accused design is substantially similar to the copyrighted one, such that it amounts to an improper appropriation of the copyrighted features.¹⁹³ This standard is similar to that for design patent infringement.¹⁹⁴

***350** Accused copyright infringers can defend themselves under the doctrine of “fair use.” Fair use of a copyrighted work includes use for the purpose of criticism, comment, teaching, or scholarship.¹⁹⁵ Courts analyze a fair use defense using four factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.¹⁹⁶

In the case of product designs, the subject matter covered by copyright is more creative than factual, so factor (2) would tend to weigh against fair use.¹⁹⁷ Also, to the extent that an allegedly infringing design is applied to a competing product, that use would be commercial and affect the market for the copyrighted design; for this reason, factors (1) and (4) would also tend to weigh against fair use.¹⁹⁸ Finally, the weight of factor (3) on a fair use defense will vary from case to case with the amount of copyrighted material used by the accused infringer. Ultimately, the success of a fair use defense will likely depend on the extent to which the accused use is “transformative.”¹⁹⁹ Transformative uses are those which tend to serve a different purpose, or add some new meaning or expression to the work.²⁰⁰ By doing so, transformative works further the copyright system goal of promoting artistic progress.²⁰¹ “[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh *351 against a finding of fair use.”²⁰² By contrast, design patents provide much stronger exclusive rights that are not qualified by a fair use defense.²⁰³

C. Trade Dress Infringement - Likelihood of Confusion

Liability for trade dress infringement under section 43(a) requires proof that consumers would likely be confused as to the source of the product.²⁰⁴ Courts have analyzed likelihood of confusion by looking at various factors.²⁰⁵ Direct evidence of actual confusion, such as affidavits and consumer surveys, is usually strong evidence of likely confusion.²⁰⁶ In evaluating likelihood of confusion, courts consider the strength of the trade dress, or its distinctiveness--the more distinctive or arbitrary, the stronger the protection.²⁰⁷ For example, a van with a clown picture on it was found to be a generic and weak trade dress for an ice cream truck, so it was not entitled to protection.²⁰⁸

The similarity of two trade dresses is also an important factor in determining if consumer confusion is likely.²⁰⁹ Another factor is the similarity of the channels of trade. Under this factor, courts evaluate the extent to which the goods compete in the same market and are purchased by the same people.²¹⁰ Similarity of trade dress becomes especially important when the goods are in direct competition (i.e., when two designs for the same product are being sold in the same market).²¹¹ However, even if the trade dress is used on different goods sold in a completely separate market, the accused infringer could still be liable for "dilution" if the trade dress is famous and the competing use tends to take away from the distinctiveness of the original.²¹² Courts also look at the care exercised by the relevant consumers *352 and have found that the more expensive the product, or the more knowledge or expertise required for the purchase, the less likely consumers are to be confused.²¹³ These considerations of market channels and consumer care are very similar to how courts determine who the ordinary observers are for design patent and copyright infringement.²¹⁴

Finally, bad faith on the part of the accused infringer in using the trade dress may indicate that the use was intended to confuse consumers.²¹⁵ Because a primary goal of trademark law is to promote fair competition, intentionally copying another's product packaging trade dress undermines this goal--there is no competitive need to copy the packaging to effectively sell the product.²¹⁶ By contrast, intentionally copying another's product design tends to suggest only the copier's desire to compete.²¹⁷ Unless the product is otherwise protected (e.g., patented or copyrighted), competitors can freely copy it because "[i]t is not unfair competition for someone to trade off the good will of a product; it is only unfair to deceive consumers as to the origin of one's goods and thereby trade off the good will of a prior producer."²¹⁸ Therefore, intent to copy another's trade dress weighs less in favor of likely confusion for product design than product packaging.²¹⁹

The copying of another's trade dress can be defended based on trademark fair use, which is using another's trade dress (1) other than as a mark (2) to describe one's own goods or services, done (3) fairly and (4) in good faith.²²⁰ For example, in Car-Freshner Corp. v. S.C. Johnson & Son, Inc., Car-Freshner made scented pine tree shaped air fresheners for cars, using that shape as a trademark for its product.²²¹ S.C. Johnson & Son sold home air fresheners called "Glade Plug-ins" *353 that plugged into electrical outlets and dispersed aromatic scents.²²² When S.C. Johnson & Son created a "Holiday Pine Potpourri" scented plug-in shaped like a pine tree, Car-Freshner sued for trade dress infringement.²²³ The court held that the plug-in did not infringe because the pine tree shape, as used, was descriptive of the pine scent and the Christmas season.²²⁴ The plug-in also displayed the "Glade" trademark prominently on the product itself as well as on the packaging, indicating that the pine tree shape was not used as a mark; this made the use unlikely to be confusing, and was therefore fair and in good faith.²²⁵

On the whole, the likelihood of confusion test for trade dress infringement is analogous to the ordinary observer test for design patent infringement. Both tests require the court to identify the relevant consumers and then evaluate how attentive or discerning they are likely to be.²²⁶ Furthermore, both tests are more likely to find infringement if the accused product would compete with the original product in the same market.²²⁷ However, because patentees do not need to be actually engaged in commerce, some courts have held that design patent infringement is a narrower inquiry "which does not concern itself with the broad issue of consumer behavior in the marketplace."²²⁸ Such courts conclude that "[d]esign patent infringement relates solely to the patented design, and does not require proof of unfair competition in the marketplace or allow of avoidance of infringement by labelling [sic]."²²⁹ To a great extent, these courts have drawn a distinction without a difference. Although patentees need not enter the market with their products, the courts analyze cases as if the claimed designs were real commercial products and *354 determine whether the designs would appear deceptively similar to relevant purchasers. Although some likelihood of confusion factors (such as intent) may be less relevant for design patent infringement, the same type of empirical testimonial and survey evidence is the best evidence to prove that two products (albeit one hypothetical) are deceptively similar in appearance.

A final but important qualification of trademark rights is that prior users of an unregistered trademark can sometimes retain their rights despite the existence of another's federal trademark registration for a confusingly similar mark.²³⁰ Such prior users may continue to use their otherwise infringing mark within the geographic area that they had been continuously using it prior to the subsequent user's federal registration.²³¹ The use must be in good faith and without prior notice that its mark was infringing the federal mark.²³² There is also some similar recourse under the patent law for those who have made a design that

is later patented by another person: the prior maker of the design can invalidate a subsequently issued patent under § 102(g) as long as the making was sufficiently publicized.²³³

VI. How Designers and Manufacturers Can and Do Protect Their Designs

This paper has shown that intellectual property rights in designs can be protected under all three statutory schemes, with some important legal and practical distinctions. This section discusses how designers actually opt to protect and assert their rights. It concludes that design patents are not necessary for designers to obtain an appropriate and effective scope of design protection.

A. Who is Receiving Design Patents

Since 1976, the top fifteen most common types of issued design patents, as classified by the Patent Office, were as follows:

No.	USPTO Design Classification ²³⁴	Number Issued Since 1976 ²³⁵
D6	Furnishings	35,400
D14	Recording, Communication, or Information Retrieval Equipment	28,069
D8	Tools and Hardware	24,079
D21	Games, Toys and Sporting Goods	22,677
D12	Transportation	22,546
D7	Food Preparation and Serving	20,572
D23	Environmental Heating and Cooling, Fluid Handling and Sanitary Equipment	17,683
D9	Packages and Containers for Goods	17,592
D10	Measuring, Testing, or Signaling Instruments	15,004
D24	Medical and Laboratory Equipment	14,927
D26	Lighting	12,007
D3	Travel Goods, Personal Belongings, and Storage or Carrying Articles	11,511
D13	Equipment for Production, Distribution, or Transformation of Energy	11,254
D2	Apparel	11,049
D11	Jewelry, Symbolic Insignia, and Ornaments	10,021

*355 Table 1: Top Fifteen Classifications for USPTO Issued Design Patents

Generally, the number of design patent applications and the number of issued design patents has increased each year since 1976.²³⁶ The owners of the largest number of design patents are Sony and Nike.²³⁷ Other companies with large design *356 patent portfolios include Goodyear, Motorola, Black & Decker, Kohler, Rubbermaid, Toyota, Apple Computer, and Coca-Cola.²³⁸ All of the above classes of products are potentially eligible for protection under copyright or trademark laws. In fact, the following section will show that the subject matter of many design patents is often asserted under those other schemes.

B. Designers Who Have Utilized Copyright and Trademark Protection in Addition to or in Lieu of Design Patents

Designers and producers have historically taken advantage of all the various ways that their designs can be protected. This section examines several instances of designers utilizing different combinations of available intellectual property schemes to suit their needs.

1. The Statue of Liberty

In 1876, soon after the copyright laws first covered sculptural works, French sculptor Frederic Auguste Bartholdi obtained a copyright registration for his “Statue of American Independence,” which today is called the Statue of Liberty.²³⁹ Bartholdi also obtained a design patent for Lady Liberty, with the following drawing dictating the scope of his claim.²⁴⁰

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Picture 4: Bartholdi “Liberty Enlightening the World” Design²⁴¹

*357 Since Bartholdi had already obtained a copyright registration, there was really no need for him to also get a patent.²⁴² When a designer wishes to prevent unauthorized copying and publication of a design that will not be sold as part of a product or service, copyright can be an adequate form of protection. Here, the Statue of Liberty was enormously famous, so it would be nearly impossible for a designer charged with copyright infringement to assert an independent creation defense.²⁴³ Furthermore, Bartholdi could have licensed the use of his design to others if he wished to exploit it for capital gain.²⁴⁴

2. The Classic Coke Bottle

In 1915, Coca-Cola obtained a design patent for its unique bottle design.²⁴⁵

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Picture 5: Design Patent for Coca-Cola Bottle²⁴⁶

That patent has long since expired, but the distinctive bottle shape has come to indicate the source of the product inside the bottle. Today, trademark law protects Coca-Cola’s distinctive bottle shape.²⁴⁷

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***358 Picture 6: Trademark for Coca-Cola Bottle²⁴⁸**

The registered trademark covers the “three dimensional configuration of the distinctive bottle as shown” when used in connection with soft drinks.²⁴⁹ Coca-Cola’s need to protect its bottle is not to prevent people from copying it for any conceivable purpose, but rather to prevent others from using it to mislead consumers into buying a competitor’s product, thinking that it is Coca-Cola. Because trademark rights provide adequate protection to Coca-Cola, design patent protection is unnecessary.

3. The Levi’s Pocket

Levi Strauss & Co. makes denim jeans that are perhaps the most famous pants in the world. The company has been responsible for many stylistic innovations over the years. One such innovation came in 1873 when it began sewing a distinctive design onto the back pockets of its jeans.²⁵⁰ The design resembled something of an oversimplified seagull in flight, and has come to be associated with Levi's jeans.²⁵¹ Levi's registered the pocket design as a trademark in 1980.²⁵²

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***359 Picture 7: Trademark for Levi's Pocket²⁵³**

Two years later a competitor of Levi's, Englishtown Sportswear Ltd., was issued a design patent covering a similar pocket design.²⁵⁴

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Picture 8: Design Patent for Levi's Pocket²⁵⁵

Like Coca-Cola's bottle, Levi's pocket had come to symbolize its product and its goodwill. As evidenced by the above design patent, had Levi Strauss wanted to patent its pocket stitching, presumably it could have done so. However, the company's concern was not simply to prevent copying of its pocket design, but rather to prevent consumers from buying competing products, thinking that they were getting Levi's jeans. Not surprisingly, Levi, like Coca-Cola, relies on trademark rights to protect its design against alleged infringers.²⁵⁶ Since 2001, Levi has filed nearly 100 lawsuits against competitors for trademark infringement.²⁵⁷ *360 Some of the allegedly infringing jeans are shown here along side of an actual Levi's pocket:

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Picture 9: Designs Accused of Infringing Levi's Pocket²⁵⁸

Levi sought protection for its pocket design to prevent consumer confusion and misappropriation of its goodwill. Its trademark rights alone have been both adequate and successful thus far.²⁵⁹

***361 C. Amini Innovation Corp. v. Anthony Cal., Inc. - A Contemporary Case Study**

Amini Innovation Corp. is a designer of furniture,²⁶⁰ which is by far the most common subject matter of design patents.²⁶¹ Amini obtained a design patent for its uniquely designed and carved bed frame.²⁶²

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Picture 10: Amini Carved Bed Frame²⁶³

Additionally, Amini obtained a copyright registration for its "carved ornamental woodwork," including "a lion's paw, ball, reeds, leaf-and-flower motifs, foliate scrolls, C- and S-shaped scrolls, a serpentine decoration, a seashell motif, laurel wreaths, an iron-canopy rail, beads, and moldings."²⁶⁴ Asserting both design patent and copyright rights, Amini sued furniture designer Anthony California whose furniture contained all of these features.²⁶⁵

On the issue of copyright infringement, the court found that the evidence of Anthony's access to Amini's designs was thin.²⁶⁶ The best evidence of access was that Amini had displayed its designs at a trade show that was allegedly attended by one of Anthony's designers.²⁶⁷ The record also showed that Anthony did not make *362 any effort to determine if its designs would infringe on anyone else's property rights.²⁶⁸ With such weak evidence of access, very strong similarity was required to prove infringement.²⁶⁹ The court held that at least some of the accused designs could satisfy this requirement, noting that the protected design uses a unique lion's paw with five toes; the accused design incorporates a near-copy of this whimsical device, including the anatomically incorrect presentation of the toes. In some cases, the legs rising from the lion's paws in both products are themselves decorated with similar reed and scroll motifs. Headboards in both the protected and accused

designs have a virtually identical serpentine shape, are decorated with moldings of identical shape and placement, and flourish similar bedposts with scrollwork embellishing spherical bases. Vertical decorations in some of the protected and accused products both use a motif of bundled reeds. Furthermore, it is well settled that a jury may even find a combination of unprotectable elements to be protectible under the extrinsic test because “the over-all impact and effect indicate substantial appropriation.”²⁷⁰

Ultimately, the court determined that there was enough evidence to support a jury finding of substantial similarity.²⁷¹ Therefore, summary judgment for Anthony was inappropriate and the case was reversed and remanded.²⁷² For essentially the same reason, the court also reversed and remanded the case on the design patent infringement claim.²⁷³

The court outlined the process to be used on remand for determining whether the accused furniture infringed Amini’s copyright. First, the court must identify which features of the furniture design are protectable, i.e., the physically or conceptually separable features.²⁷⁴ Once those elements have been identified, it must be shown that they appear in the accused device (the “extrinsic” test).²⁷⁵ Finally, if those requirements are met, the fact-finder determines whether the ordinary reasonable audience would find the works substantially similar in “the total concept and feel of the works” (the “intrinsic” test).²⁷⁶ The court also *363 explained how to analyze design patent infringement claims. First, the novel and protectable features of the design are identified, i.e., the non-functional, ornamental features.²⁷⁷ Second, those features must be shown to appear in the accused design.²⁷⁸ Finally, if those features are present, the fact-finder decides whether the patented design and the accused design appear substantially similar “overall.”²⁷⁹

Amini is a great case to illustrate how copyright can protect the same design features as a design patent. Not only was the same subject matter asserted under both statutory schemes, but the procedures for finding infringement were effectively identical. As long as the designer’s protected features appeared in the accused design, the question of infringement went to the jury to decide the issue based on its overall impression. As the Amini court noted, having the jury decide such questions diminishes the legal distinctions between the standards for copyrightability, patentability, and infringement because the ultimate question of liability is based on the jury’s subjective conclusion that there was an improper appropriation.²⁸⁰

Amini could also have asserted trade dress rights in its furniture design if it had used its distinctive ornamental woodwork in a way that was associated with the Amini brand, or if its furniture generally had a “recognizable and consistent overall look.”²⁸¹ Most likely, the ornamental woodwork would be considered product design rather than product packaging under Wal-Mart, and Amini would have to show secondary meaning in order to protect its trade dress.²⁸² However, Amini shows that the inability to prove secondary meaning is by no means fatal to designers. Amini could not clearly prove that Anthony had access to its designs because the furniture was not adequately publicized or sold. However, Amini was still able to get to the jury on the copyright claim. Thus, if a designer is unable to show the secondary meaning necessary to accrue trademark rights, it can still successfully sue for copyright infringement—even if there has been very little commercial activity associated with the design.

***364 VII. Reliance Interests in the Design Patent System**

Because the thesis of this paper that design patents should be phased out of existence, it is important to address the reliance interests at stake if such a proposal is to be realized. This section considers some of the most pressing concerns that the proponents of design patents would likely raise and will explain how those concerns do not necessitate the retention of the design patent system.

A. Design Patents Ease the Burden on Manufacturers to Acquire Secondary Meaning

Product manufacturers can presently utilize the design patent system to obtain a 14-year period of exclusivity for their designs.²⁸³ During this period, they do not need to be engaged in commercial activity in order to have valid rights.²⁸⁴ If manufacturers wish to use their designs as trade dress, the design patent affords them a substantial period of time during which they can develop secondary meaning. This is very useful to big corporations and small startups alike because most product designs will require proof of secondary meaning to be protectable as trade dress.²⁸⁵ Without design patents, the burden on designers to establish secondary meaning would be greatly increased. Small startup companies would be hit the hardest because bigger companies might swoop down and appropriate their designs before the startups have been able to

establish secondary meaning.

While designers and manufacturers have enjoyed this “head start” benefit of design patents, in a sense it is cheating the trademark system. No other types of trademark rights enjoy this exclusivity period for establishing secondary meaning. One cannot register a word or a symbol at the trademark office to simply reserve it for future use, or until secondary meaning is established.²⁸⁶ Additionally, a mark that requires secondary meaning to be registered must actually be used in commerce and acquire its distinctiveness before rights will accrue.²⁸⁷ As a general matter, there are substantial costs involved in launching a new product line, whether the producer is using a new design for the product itself or a new word or symbol affixed to the product. For example, making new packaging and labels for ***365** a product involves significant costs aside from those involved in producing the product itself. Therefore, it is unfair that those who use product designs as their trademarks can get a 14 year head start to establish secondary meaning while those who use words or symbols have to compete in the market for their trademark rights.

When trademarks are not inherently distinctive, the Lanham Act requires proof of secondary meaning in order to ensure that the producer has earned the exclusive right to use the mark through competition in the market. Thus, the Wal-Mart Court was correct to have courts err on the side of requiring designers to prove secondary meaning.²⁸⁸ Product designs are typically intended to make products appear more aesthetically pleasing, not to clearly and immediately signal the source or brand of the product.²⁸⁹ Unless and until consumers recognize such designs as source indicators, it is inappropriate to award the producer any trademark rights because there can be no consumer confusion as to the source. Consumer association cannot happen until producers are actually engaged in commerce. In this sense, abolishing the design patent head start in establishing secondary meaning would be compatible with the trademark-oriented purposes of the design patent system.

Concededly, there is a substantial burden that might be imposed on startup companies if design patents were phased out of existence. It would be unfair to allow bigger companies to copy the designs of smaller companies who lack the economic muscle to quickly establish secondary meaning. Therefore, some early form of protection for designs would be desirable for those small startups that seek trademark protection. Here, copyright could provide designers appropriate coverage before secondary meaning can be established.

Extensive market penetration via promotion, advertising, and sales of a newly designed product is a highly effective way that larger companies can quickly build up secondary meaning for the design. Likewise, such extensive market penetration tends to show that competitors had substantial access to the design for copyright infringement purposes. However, having relatively little market penetration is not fatal to a copyright claim. The Amini case illustrates this point; there, the furniture manufacturer was able to successfully assert a copyright claim despite having engaged in little promotional or commercial activity with the design that could be somehow connected to the accused infringer.²⁹⁰ The close similarity between the copyright holder’s and the accused infringer’s furniture was enough to support a ***366** finding of infringement despite weak evidence that the accused had access to the copyrighted design.²⁹¹

It is important to reiterate here that while a design patent would prevent any making or use of the patented design, copyright only protects against copying. Therefore, if a big company has copied a small company’s design, then the small company can protect its exclusive right. Absent direct evidence of copying, however, the copyright holder would have to prove both access and substantial similarity.²⁹² Since the quantum of proof required for each element is inversely related to the other,²⁹³ the copyright holder would have two different incentives: (1) publicizing its works so as to support a finding of access and lessen its burden on proving similarity, and (2) creating more unique and distinctive designs so that even with weak evidence of access, substantial similarity can be more easily shown. Both of these incentives further the goal of promoting the decorative arts. Encouraging publication enriches the body of known designs that can serve to inspire future designers, and encouraging more creativity promotes advancements in the art of designing. Because design patent infringement does not require proof of copying, these incentives are absent. Thus, while design patents give manufacturers a head start toward establishing secondary meaning, to the extent that such early protection is necessary, copyright can serve the same function while better promoting the designing arts.

Finally, to rely on copyright instead of design patents may nevertheless trouble manufacturers in light of cases such as Brandir, where a fairly artistic bike rack design was denied copyright protection.²⁹⁴ First, it is not clear that a design patent could have been obtained for that bike rack given the novelty and nonobviousness requirements of patent law. Second, as long as courts do not commit the same fallacy as the Brandir court, the threshold for copyrightability would remain low and individual design features would be eligible for protection.²⁹⁵

*367 B. The Public Notice Function of the Design Patent System

The biggest owners and proponents of design patents are large corporations such as Sony and Nike.²⁹⁶ Companies like these are in the business of mass-producing their newly designed products. Before such a company invests substantial capital into making and selling a new product, it would be prudent for it to know whether such production and sales would infringe the rights of others. The design patent system facilitates such prudence by maintaining a centralized database of patented designs to give the public notice of their existence.²⁹⁷ The designs are organized and classified by the types of products in which they are embodied, and the database can be fairly easily searched to locate all the designs for similar products.²⁹⁸ Big companies will routinely have a lawyer or independent company perform a patent search to ensure that their new designs do not infringe any valid patents. Even for smaller companies, a thorough patent search is not very cost prohibitive. Thus, the design patent database is an extremely useful and efficient tool to help assure companies that they can produce their new products without fear of being sued for infringement.

If the design patent system (including the USPTO's database) is phased out of existence, the art of designing would be hindered because companies might become apprehensive about making potentially infringing new designs. However, the USPTO also maintains an extensive trademark database.²⁹⁹ Its trade dress registrations, which contain pictures, can be efficiently searched according to the type of goods and services upon which they are used.³⁰⁰ The Copyright Office also has a database of its registrations, but the information available is very limited.³⁰¹ There are no pictures or descriptions of the copyrighted work.³⁰² The database only contains information such as the name of the author, the date of registration, and the general type of work (e.g., "sculpture," "video," or "design"), so it is virtually useless for the purpose of checking to see if one's new design would be infringing another's copyright.³⁰³ The trademark database would appear to be the next best *368 thing to the design patent database, provided that designers both opted to and were able to register designs there.

However, neither trademark nor copyright laws require formal federal registration to obtain exclusive rights.³⁰⁴ Thus, there will be product designs with secondary meaning and publicized copyrighted designs that, although they do not appear in any centralized location, will have accrued legal protection that could preempt the use of a new, similar design. This problem is not unique to trademarks and copyrights. For those who seek design patents, the patent database is not the sole source of relevant prior art that might preclude patentability.³⁰⁵ This may seem troublesome to companies who are debating whether to launch a new product line. They would not want a small business owner or individual designer to come out of the woodwork and be able to enjoin production. However, professional trademark searches (which, like patent searches, are not particularly cost-prohibitive) are routinely used to discover both registered trademarks and unregistered common law trademarks by searching various databases and internet sources beyond the federal and state registers.³⁰⁶ Although a professional trademark search is likely to uncover nearly all prior users of similar trade dress, in a worst-case scenario the search would fail to reveal a small and localized user. In that case, the most severe remedy would be that the big company would have to let the small user continue to use its trade dress in that region, and the big company might be enjoined from using the trade dress within that region.³⁰⁷ This is a suitable outcome because otherwise the big company would be appropriating the prior user's goodwill, which is contrary to the commercial purposes of the design patent system.

Because designs are embodied in useful articles, both copyrighted and trademarked designs will be sold in the same lines of commerce. Thus, professional trademark searches can also reveal copyrightable designs that have been publicized. If a copyrighted design that was not widely publicized failed to turn up in the search, the big company would not be liable for infringement unless it was shown to have copied the design. Thus, if big companies maintain records *369 that tend to prove their designs were independently created,³⁰⁸ then that evidence combined with the weak or nonexistent evidence of access would likely be a completely successful defense to a claim of infringement. If a company designed its products independently and in good faith, it is highly unlikely that it would have come up with something so strikingly similar that it would infringe a design that had not been substantially publicized. In general, the independent creation doctrine fosters creativity because it allows designers to work without the fear of being sued for copying something to which they have never been exposed.

Even with design patents in place, professional patent searches might not uncover all pertinent prior art designs--manufacturers would have to take that risk when launching a new product. Copyright and trademark searching can be at least as effective in providing manufacturers with confidence to proceed with their production. Thus, the mere absence of the design patent system (and database) should not deter product manufacturers from aesthetic innovation. Through simple searching measures, as well as inherent copyright and trademark doctrines, manufacturers would not be forced to gamble with the legality of a new design. Not only are these safeguards effective, but they are also more appropriate to serve the intended functions of the design patent system.

C. International Rights of Priority

The Paris Convention provides that all signatory countries grant patent and trademark applicants a “right of priority” with regard to filing dates.³⁰⁹ This allows applicants to file their applications in one country and subsequently in another, the latter country treating the application as if it had been filed on the date that it was filed in the former country.³¹⁰ In the case of design patents, the priority period is six months.³¹¹ Generally, the right of priority makes it easier for those who wish to protect their inventions or designs in various countries. Applicants can quickly apply in their home countries to secure an early filing date, and then take some time to file abroad without having to worry about new prior art references affecting their rights.

***370** If the U.S. design patent system was phased out of existence, then the U.S. may no longer afford “similar privileges”³¹² of priority as other countries with respect to design protection. In the absence of U.S. design patent protection, foreign designers would not get the patent-related benefit from an earlier filing in another country. However, this is not problematic. In the absence of a design patent system, designers would not need to secure an early filing date to avoid anticipatory or obviating prior art in the United States. This is because trademark laws also afford a right of priority dating back to the foreign use of the design.³¹³ Moreover, copyright law is concerned with originality, which is easily satisfied. Thus, the absence of a design patent right of priority would not significantly impinge on the rights of foreign designers or their ability to achieve sufficient protection in the United States.

As for domestic designers, again the trademark right of priority would still exist for U.S. designers who wish to market their products abroad.³¹⁴ However, should a U.S. designer insist on foreign patent or patent-like³¹⁵ design protection, that designer would not really be any worse off without a U.S. design patent system. Such a designer could file an international patent application under the Patent Cooperation Treaty³¹⁶ with about the same amount of preparation and effort as a regular U.S. application.³¹⁷ This international filing would also secure a right ***371** of priority as of the date it is filed.³¹⁸ Thus, the rights and opportunities of U.S. designers would not be significantly affected with regard to foreign priority if the design patent system were eliminated.

It should be noted that the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS), to which the United States is a signatory, requires that all member countries “provide for the protection of independently created industrial designs that are new or original.”³¹⁹ If design patents were to be eliminated in the United States, there is some question as to whether that would violate TRIPS. However, TRIPS does not specifically require that designs be protected by patents; copyright or *sui generis* industrial design law can be utilized.³²⁰ U.S. copyright protection for original designs appears to fully satisfy the minimum standards of TRIPS.³²¹ Therefore, the elimination of design patents in the U.S. would likely not violate TRIPS.

VIII. The European Union’s Approach to Design Protection

This section discusses the European Union regulations for the protection of designs, adopted in 2002.³²² These design rights, which are not patents, incorporate many principles similar to U.S. copyright and trademark laws. This is instructive because it illustrates how copyright and trademark principles not only provide ***372** effective protection for designs, but also how, in many instances, copyright and trademark laws could wholly substitute for design patent provisions and doctrines.

In the European Union, the current regulation for design protection includes many features that are akin to those found in U.S. copyright and trademark laws, but are notably absent from U.S. design patent law. For example, property rights exist in a design even if the design has not been formally applied for and registered.³²³ Unregistered designs are protected for three years, provided that they are “published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialized in the sector concerned.”³²⁴ Adding a requirement that an unregistered design be somehow publicly disclosed highlights an underlying policy concern that use of a design should not be actionable unless the original designer has somehow laid a claim to the design in a way that is apparent to others. This policy concern is similar to the policy concerns underlying the requirements of U.S. law that copyright holders prove accused infringers had access to their designs,³²⁵ and that trademark owners prove their designs were used in commerce such that the designs would be attributed to them.³²⁶

Another feature of EU regulation that can be found in U.S. trademark law, but not in U.S. patent law, is the ability to renew a registration. The EU provides registered designs with an initial term of five years, renewable for five-year periods up to a

total of twenty-five years.³²⁷ The reason for the renewability feature is the same for EU design law and U.S. trademark law: some designs will remain marketable and should be protectable for periods of time beyond the initial term.³²⁸

In contrast to registration and renewability rights, eligibility and scope of protection for designs in the EU share many similarities with U.S. design patent laws. EU designs must be novel, and the protection covers only the ornamental, nonfunctional features of the product.³²⁹ However, the level of ingenuity required is fairly low. The novelty requirement is satisfied as long as the design is not *373 “identical” to another that has been made available to the public.³³⁰ Thus, like the U.S. copyright standard of originality, even a very small amount of creativity will suffice. Furthermore, while there is no requirement like nonobviousness, the EU requires that the design have “individual character.”³³¹ This is satisfied when “the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.”³³² The individual character requirement is evaluated from the perspective of an informed user of the product, rather than an experienced designer, to see if the designs would appear distinct from one another. Individual character is therefore very similar to novelty for U.S. design patents, which asks whether the design appears substantially similar to a typical purchaser of the product.³³³ It is also much like the U.S. trademark law prohibition against any design appropriation that is likely to cause confusion among the relevant consumers.³³⁴

Lastly, the fundamental rights afforded to EU designs are essentially the same as those for U.S. design patents. In both the U.S. and the EU, designers may prevent others from making, using, offering for sale, and importing their designs.³³⁵ Importantly, however, the EU provides certain exceptions for conduct that it will not deem to be infringing on the rights of the designer.³³⁶ The design rights do not cover private and non-commercial uses, experimental uses, or reproductions for the purpose of citation or teaching, “provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.”³³⁷ These exceptions are similar to those of the U.S. copyright fair use provisions,³³⁸ and they reflect the recognition that, given the artistic nature of designing, the public needs such exceptions to build upon the work of others and thereby promote better designs. Moreover, the EU allows for limited use and exploitation of a design by a third party who has in good faith made or used a protected design, or at least “made serious and effective preparations to *374 that end,” even for commercial purposes, as long as it was not “copied” from the other’s design.³³⁹ This exception is available only to prior users of the design, which is similar to the U.S. trademark laws that allow prior users to continue using their unregistered trade dress to the extent that they had been using it in good faith.³⁴⁰ The EU prior user provision also echoes some of the policies behind the U.S. copyright defense of independent creation.³⁴¹

While on its face the European Union appears to protect its designs with patent-like features, the EU law parallels design protection under both U.S. copyright law and trademark law in important respects. The design protection offered by the European Union is therefore something of a hybrid between U.S. copyright and trademark laws. Thus, the EU regulation supports the proposition that a hybrid system of design protection not only warrants serious consideration in the U.S., but also that it is in many ways more desirable and more workable than a strictly U.S. patent approach.

IX. Time for Design Patents to Gracefully Step Down

Designs are art. They are the product of creative expression. Copyright and trademark laws both emphasize this characteristic by only protecting designs that are creative and arbitrary expression independent of functional and utilitarian concerns. For the past 165 years, designs have been protected by patents as if they were somehow analogous to machines or articles of manufacture. However, designs are of a fundamentally different character and therefore require a different type of treatment. The best treatment would be to protect designs through copyright law to the extent that they are artistic, and to protect them through trademark law to the extent that they signify their origins to consumers. Because modern copyright and trademark laws can now fully protect the artistic and source-signaling purposes of designs, the design patent system should be phased out of existence.

Copyright law sets the bar low so that even minimally creative designs are eligible for protection.³⁴² This is good because it provides incentive to all artists without regard to their relative levels of ingenuity. Long ago, Justice Holmes commented that those trained in the law should not be the final judges on the worth *375 and value of art.³⁴³ This sentiment has been echoed throughout modern copyright law³⁴⁴ and suggests that to the extent the design patent law purports to “promote the decorative arts,” the threshold for protectable designs must be kept low to prevent people like lawyers, judges, juries, and politicians from having the final say as to what constitutes artistic merit. Otherwise, the judgments of those people might suppress entire artistic movements and multitudes of artists by removing much of their incentive to be creative. The nonobviousness

requirement for design patents is particularly problematic since the nature of nonobviousness is that it continually escalates the minimum level of creativity for protectable designs.³⁴⁵ “This is a cyclical process in which . . . [t]he past extraordinary creations of a few becomes the present ordinary level of skill for all in the group.”³⁴⁶ While this may be appropriate for utility patents, it tends to stifle competition that would yield new and better designs.³⁴⁷ A patent system where designs must be nonobvious may even result in “the demise of all design patents.”³⁴⁸ For this reason, at least one *376 scholar has suggested that novelty be the only prior art related requirement for design patentability.³⁴⁹

The following graph shows the grant rate for all design patent applications filed over the past several decades:

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

Chart 1: U.S. Design Patent Grant Rates (1962-2005)³⁵⁰

The shape of this plot is interesting. The number of design patents and applications is steadily increasing,³⁵¹ but the grant rate has unusual cyclic fluctuations. The design patent grant rate peaks about once each decade, followed by a clear decline. Although this data does not look at the trend in grant rates for an individual class of designs, one plausible explanation for its shape could be the cyclical nature of obviousness. Because nonobviousness is the most difficult hurdle toward design patent protection, it is plausible that the grant rates are dictated largely by that requirement. The peaks of the graph might represent a flourish of great designing ingenuity, while the subsequent declines indicate the rejection of designs being held to the standards set by the previous extraordinary *377 designers. As a result, protection is denied to more and more designers until the next wave of great creativity. Although one of the sharpest declines in allowance rates is occurring at present, it is impossible to say from this data whether the nonobviousness requirement is causing “the demise of all design patents.”³⁵² However, if the shape of the above graph is indeed the result of such a cyclical suppression of design patentability, then it is because the patent examiners are acting as the “final judges of the worth” of designs.³⁵³ This practice, whereby every day patent examiners decide which designs are meritorious and warrant protection, is clearly at odds with Justice Holmes’ warning that such judgments about art can diminish creativity and impede cultural growth.³⁵⁴

The term for a design patent is fourteen years from issuance.³⁵⁵ During this period, any unauthorized use of the design is an act of infringement.³⁵⁶ The term for copyright runs much longer--more than seventy years.³⁵⁷ However, copyright protection is limited by fair use and transformative use doctrines that, in certain circumstances, allow non-owners to use the material during the copyright term without the owner’s authorization.³⁵⁸ The policy behind the fair use doctrine is to promote creativity by allowing people to use the work of others in ways that do not undermine the prior artist’s incentive to create in the first place.³⁵⁹ Fourteen years is an eternity in the world of art, style, and popular culture. Stylistically, the whole world looks very different every few years.³⁶⁰ Preventing all uses of a design for the full fourteen-year term could severely hinder another designer’s ability to compete in the market. Even worse, such usage restrictions may prevent or *378 discourage some designers from designing at all due to fear of being sued for patent infringement.

Although design patents reward designers for their “novel” contributions, works of art are almost never truly new, but rather they build upon the prior work of others. Usually, the “originality” is in the way that artists put their works together. The fair use doctrine in copyright law accounts for this reality and provides some flexibility to allow artists to build upon existing art. On the other hand, design patent law protections are more absolute and do not accommodate the artistic process as easily. Thus, copyright law is better able to promote the decorative arts than design patent law. Furthermore, recall that novelty is a requirement for patent law while copyright requires only originality. Because originality is the more appropriate standard for measuring whether a designer has added something of value to the realm of designs, copyright should be the preferred method for protecting designs.³⁶¹

To the extent that the design patent laws were intended to prevent consumer deception, trade dress as protected under section 43(a) of the Lanham Act is more than adequate to protect designs. Trademarks are indefinitely renewable, provided that the trademark is still being used as a source indicator.³⁶² This is fitting because as long as a design is recognized by consumers as the indicator of the product’s source, fairness requires that the trademark owner be allowed to protect it from being used by others in ways that would misappropriate its goodwill. Concededly, designers would likely have to show secondary meaning to protect their designs as trade dress. Such a requirement could be quite burdensome for startup companies because it is unlikely that their designs would have had sufficient time to develop secondary meaning. However, if it is too difficult or expensive to show the necessary secondary meaning, then so be it. Trademark law aims to protect the consumer’s ability to identify and distinguish the sources of products. If a design has not achieved the requisite degree of consumer recognition and

source-association, the design should not be entitled to trademark protection. As previously noted, designers can still rely on copyright protection while they are waiting to acquire secondary meaning.³⁶³

***379** The dual purposes of the design patent laws can be both adequately and more appropriately addressed by copyright and trademark law. However, there are domestic and international reliance interests in the maintenance of the design patent system given its more than 160 year history. This reliance is misplaced in light of the modern copyright and trademark doctrines, as well as international intellectual property treaties.³⁶⁴ Copyright and trademark laws afford protection to an even broader class of designs than patent law because they do not share patent law's more stringent requirements, particularly nonobviousness. Also, copyright law and trademark law doctrines afford effective remedies against infringers, including injunctive relief, lost profits, and harm to goodwill. They generally prohibit using the design in ways that yield substantially similar appearances, such that the appropriation would either undermine the designer's incentive to create or unfairly exploit the designer's goodwill.

While the design patent system is not necessary to adequately protect property rights in designs, as a practical matter, many designers and producers already rely on the system when formulating strategic intellectual property business decisions. Therefore, the design patent system should be gradually phased out of existence by reducing the patent term for newly issued patents over time to zero. The term for currently existing patents would remain undisturbed. Designers and producers could use the transition period to adjust their strategic intellectual property plans and to become comfortable with the newly proposed two-pronged design protection regime. While phasing out design patents would be a substantial change to the law, the change would be justified given that copyright and trademark laws are better able to meet the practical realities of design protection. In fact, it is almost certain that designs would have been protected by copyright and trademark laws beginning in 1842 if those laws had been mature enough at the time to handle the subject matter.

Nevertheless, given that the complete abolition of design patents would be a momentous change in the law, an arguably less extreme alternative solution should also be considered. Instead of completely abolishing design patents, that system could remain basically intact with respect to practical matters (e.g., filing and examination would remain at the Patent Office) and could be reformed with respect to the substantive law. By retaining the design patent infrastructure, patent practitioners, designers, and manufacturers would not have to abandon their basic understanding of procedure or their strategies for design protection. Also, the foreign right of priority would remain available. However, the current design patent system would only continue to exist in its outward appearance. In the end, ***380** the substance of the law would look more like the European Union's Community Design Right.³⁶⁵ The following is a list of important recommendations for design patent reform, roughly in order of priority:

- (1) Obviousness should be eliminated from design requirements because it is an inappropriate way to judge the worth of artistry--it tends to stifle creativity rather than foster it.³⁶⁶
- (2) Fair use provisions should be enacted to allow the public to use and build upon the works of others. This would allow society to benefit from better designs and more of them.³⁶⁷
- (3) Novelty should be analyzed primarily in light of originality to be in accord with the reality of how art is made. The features that should be considered "novel" would reflect the designer's original artistic vision and would therefore contribute to the distinctive overall appearance of the product.
- (4) Prior use and independent creation should be affirmative and tenable defenses to infringement.
- (5) Protection should be made available for unregistered designs that have been publicly used in ways that have tended to associate the design or product with its origin.
- (6) The term of the new design patent should be shorter so that commercially unviable designs fall into the public domain more quickly.
- (7) The term should also be renewable so that commercially viable designs that have come to be associated with their sources can be fairly exploited during their marketable life.

Concededly, this list amounts to a tremendous overhaul of design patent law. To enact any of the above provisions would be to effectively sneak copyright and trademark doctrines in through the back door of the Patent Office. However, because

copyright and trademark doctrines provide the appropriate means for protecting designs, a design patent system without such provisions is failing to serve its purposes in a suitable manner. Ultimately, it might be more shocking and difficult to impose even a few of the above recommendations on the design patent system than it would be to abolish the system altogether. The uncertainty as to how people could obtain and enforce design patents under the reformed system might be enormous unless the changes are fairly gradual, perhaps by enacting one or two of the above provisions at a time. Another way to minimize uncertainty would be to phase out design patents while simultaneously making a new system available with the above provisions. While these methods would allow the public some time to *381 adjust to the new system, the end result would still leave the design patent scheme unrecognizable.

Since 1842, designs have been a square peg in the round hole of the patent system. There are two ways to fix this problem: remove the peg by phasing out design patents, or recast the hole by substantially overhauling the patent law. Today, we have a perfectly square hole already fashioned within the combined copyright and trademark systems. The optimal solution is thus to phase out design patents so that designs may be protected in an effective and appropriate manner. It is time for design patents as we know them to gracefully step down.

Footnotes

¹ University of Pittsburgh School of Law, J.D. expected 2008. Registered Patent Agent of the U.S. Patent and Trademark Office. I would like to thank Professor Janice M. Mueller and all the students in the Advanced Topics in Patent Law Seminar of Spring 2007 for their insightful criticism and support in the development of this paper. Also, thanks to my family and friends for what should be patently obvious reasons to all of them.

² Thomas B. Hudson, A Brief History of the Development of Design Patent Protection in the United States, 30 J. Pat. & Trademark Off. Soc'y 380, 380 (1948).

³ Id.

⁴ Id.

⁵ Id.

⁶ Id. at 382-83.

⁷ See U.S. Patent & Trademark Office, Manual of Patent Examining Procedure § 1502 (8th ed. 5th rev. 2006) [hereinafter MPEP] (defining a design as something “inseparable from the article to which it is applied, and [unable to] exist alone merely as a scheme of ornamentation”).

⁸ Hudson, *supra* note 1, at 383.

⁹ Hudson, *supra* note 1, at 383.

¹⁰ Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543 (1842) (codified as amended at 35 U.S.C. § 171 (2006)).

¹¹ Id.

¹² See MPEP, *supra* note 7, § 1502 (“Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.”); see also 35 U.S.C. § 171 (2006) (defining a protectable design as “any new, original, and ornamental design for an article of manufacture”).

¹³ 35 U.S.C. § 271(a) (2006). Patentees also have causes of action against those who actively induce or contribute to infringement. § 271(b)-(c).

¹⁴ See *id.* (requiring only that the infringing activity occurs “without [the] authority” of the patentee).

¹⁵ See *infra* Part V.B (discussing the requirements for copyright infringement).

¹⁶ See *infra* Part V.C (discussing the requirements for trademark infringement).

¹⁷ See 17 U.S.C. § 107 (2006) (stating that the use of a copyrighted work may be noninfringing depending upon “the purpose and character of the use,” “the nature of the copyrighted work,” “the amount and substantiality of the portion used,” and “the effects on the potential market for or value of the copyrighted work”); 15 U.S.C. § 1115(b)(4) (2006) (stating that the use of another’s trademark other than as a mark to describe one’s own goods or services, if done fairly and in good faith, is a noninfringing use).

¹⁸ See *infra* Part III (tracking the evolution of copyright and trademark law regarding designs).

¹⁹ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991) (noting that copyright laws exist to promote the progress of the arts).

²⁰ See 15 U.S.C. § 1052(d) (2006) (refusing to allow federal protection for any trademark that is “likely ...to cause confusion, or to cause mistake, or to deceive” consumers with regard to the source of the goods or services bearing the trademark).

²¹ Hudson, *supra* note 1, at 380.

²² Hudson, *supra* note 1, at 380-81.

²³ Hudson, *supra* note 1, at 380-81.

²⁴ Hudson, *supra* note 1, at 381-82.

²⁵ 35 U.S.C. § 101 (2006).

²⁶ *Gorham Mfg. v. White*, 81 U.S. 511, 531 (1871) (finding patent infringement by handles that had the same “general appearance and effect” as silverware handles, despite the fact that differences in design details might be detected by those in the silverware trade.).

²⁷ *Id.* at 524.

²⁸ *Id.* at 525.

29 Id.

30 Id. at 528.

31 Gorham Mfg. Co. v. White, 81 U.S. 511, 528 (1871) (stating that the “true test” of design patent infringement is “sameness of appearance”).

32 See id. at 525 (“It is the appearance [of the design] itself which attracts attention and calls out favor or dislike.”).

33 See id. at 528 (noting that distinctive designs that go beyond “minor differences of detail” can avoid confusion among purchasers as to product source).

34 Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (1870) (codified as amended at 17 U.S.C. §§ 101-102 (2006)).

35 Mazer v. Stein, 347 U.S. 201, 211 (1954). For example, a candlestick in the form of a woman holding an urn was registered. Id. at 212 n.22.

36 Act of Mar. 4, 1909, ch. 320, § 5, 35 Stat. 1075, 1076 (1909).

37 See Mazer, 347 U.S. at 212 n.23.

38 Act of Mar. 4, 1909, ch. 320, § 5, 35 Stat. 1075, 1076 (1909).

39 Mazer, 347 U.S. at 212 n.23.

40 Id. at 211.

41 Id. at 212.

42 Id. at 202 (evaluating whether statuettes could be protected by United States copyright law when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and the applicant carried the intentions into effect).

43 Id.

44 Julie E. Cohen et al, Copyright in a Global Information Economy Ch. 4 (2d ed. 2006 & Electronic Supp., available at <http://www.coolcopyright.com/cases/chp4/mazerstein.htm> (last visited March 30, 2007)).

45 Mazer v. Stein, 347 U.S. 201, 215-16 (1954).

46 Id. at 217.

47 Id. at 217-18.

⁴⁸ *Id.* at 218.

⁴⁹ See *id.* (stating, “[t]he copyright protects originality rather than novelty or invention--conferring only ‘the sole right of multiplying copies.’”).

⁵⁰ *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871).

⁵¹ 1-2 Melville B. Nimmer & David B. Nimmer, *Nimmer on Copyright* § 2.08 [B][3] (2006).

⁵² 17 U.S.C. § 101 (2006); 17 U.S.C. § 102(a) (2006).

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 5:1 (4th ed. 2006).

⁵⁶ *Id.*

⁵⁷ *Id.* § 5:2.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ See *Act of 1870*, ch. 230, § 77, 16 Stat. 210 (codified as amended 15 U.S.C. §§ 1051-129 (2006)).

⁶¹ *In re Trade-mark Cases*, 100 U.S. 82, 93-95 (1879). The Court expressly declined to decide whether the power of Congress to enact trademark law comes from the Commerce Clause. *Id.* at 95.

⁶² *Id.* at 94.

⁶³ *Id.*

⁶⁴ See *id.*

⁶⁵ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989).

⁶⁶ *Trademark Act of 1946*, ch. 540, § 43(a), 60 Stat. 427, 441 (1946) (codified as amended at 15 U.S.C. § 1125 (2006)).

67 15 U.S.C. § 1125(a)(1) (2006) (stating that one has a cause of action against the use by any person of “any word, term, name, symbol, or device, or any combination thereof ...which ...is likely to cause confusion ... as to the origin, sponsorship, or approval of his or her goods”).

68 Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 774-75 (1992).

69 Id. at 764 n.1 (quoting Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 1256 (5th Cir. 1989)).

70 Id. at 765.

71 Id. at 769 (citing Restatement (Third) of Unfair Competition § 13 (Tentative Draft No. 2, Mar. 23, 1990)). “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” Id. at 766 n.4 (quoting Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 851, n.11 (1982)).

72 Two Pesos, 505 U.S. at 776.

73 Id. at 775.

74 Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000).

75 Id. at 209.

76 Id. at 207.

77 Id.

78 Id. at 212.

79 Id. at 213.

80 Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 214 (2000).

81 Id.

82 Id. at 216.

83 Id. at 214.

84 35 U.S.C. § 171 (2006).

85 MPEP, supra note 7, § 1504.

86 MPEP, supra note 7, § 1504.01.

87 In re Hruby, 373 F.2d 997, 1000 (C.C.P.A. 1967) (quoting Riter-Conley Mfg. Co. v. Aiken, 203 F. 699, 703 (3d Cir. 1913)).

88 Amini Innovation Corp. v. Anthony Cal. Inc., 439 F.3d 1365, 1372 (Fed. Cir. 2006) (stating that courts must “factor out the functional aspects of various design elements” to see if the protectable elements of the design appear in the accused design).

89 See Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368 (Fed. Cir. 1999) (noting that elements of a design are ornamental when the designer is not constrained by the utilitarian aspects of the underlying article; where they are unconstrained by function, designers would be free to ornament the articles however they please, i.e., arbitrarily).

90 Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368 (Fed. Cir. 1999). The designs at issue in this case were for printer ink cartridges, which are not widely regarded as things of beauty. *Id.* at 1362.

91 For example, the contours of a car's body may make the car both aerodynamic and aesthetically pleasing.

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Aerodynamics in Car Racing, National Aeronautics and Space Administration, available at <http://www.nas.nasa.gov/About/Education/Racecar/aerodynamics.html> (last visited December 7, 2007).

92 Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1312-13 (Fed. Cir. 2001) (noting a rectangular shaped feature on the rear side of an integrated door and frame was ornamental because the shape could have been elliptical or triangular without affecting the function of the door); see also U.S. Patent No. D338,718 (filed Feb. 15, 1991).

93 Seiko Epson, 190 F.3d at 1368.

94 Door-Master, 256 F.3d at 1312.

95 Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889).

96 Door-Master, 256 F.3d at 1313 (citing Gorham Mfg. Co. v. White, 81 U.S. 511, 528 (1871)).

97 *Id.*

98 Hoop v. Hoop, 279 F.3d 1004, 1007 (Fed. Cir. 2002); see also 35 U.S.C. § 102(f) (2006) (denying one the right to patent an invention if “he did not himself invent the subject matter sought to be patented”).

99 8 Donald S. Chisum, Chisum on Patents § 23.03[5][b] (2006).

100 See G.B. Lewis Co. v. Gould Prods, Inc., 436 F.2d 1176, 1178 (2d Cir. 1971) (stating that “[w]e have frequently indicated that the requirement of invention is not met by a design which is merely ‘new and pleasing enough to catch the trade’”) (citations omitted).

¹⁰¹ Smith v. Whitman Saddle Co., 148 U.S. 674, 679 (1893) (“Mere mechanical skill is insufficient. There must be something akin to genius--an effort of the brain as well as the hand.”).

¹⁰² Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir. 1996).

¹⁰³ Chisum, *supra* note 99, § 23.03[6].

¹⁰⁴ G.B. Lewis, 436 F.2d at 1178 (stating that “we have insisted that the design reflect ‘some exceptional talent beyond the skill of the ordinary designer’ or ‘inventive genius.’ We have noted that in view of this ‘to obtain a valid design patent is exceedingly difficult.’”) (citations omitted).

¹⁰⁵ 17 U.S.C. § 102(a) (2006).

¹⁰⁶ Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991) (citations omitted). The Court noted that, while the selection and arrangement of facts can be original and copyrightable, the telephone listings at issue were “entirely typical”—the numbers and addresses were simply arranged alphabetically by the person’s last name. *Id.* at 362. Accordingly, the Court found that the directory was “devoid of even the slightest trace of creativity,” and therefore did not satisfy the originality requirement. *Id.* at 362-64.

¹⁰⁷ See *supra* notes 100-104 and accompanying text (noting that the nonobviousness requirement for design patents is particularly stringent).

¹⁰⁸ 17 U.S.C. § 101 (2006).

¹⁰⁹ See, e.g., Pivot Point Int’l, Inc. v. Charlene Prods., Inc., 372 F.3d 913, 921 (7th Cir. 2004) (stating that “[a]lthough the Congressional goal was evident, application of this language has presented the courts with significant difficulty”); Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 670 (3d Cir. 1990) (noting that “[c]ourts have twisted themselves into knots” trying to apply this standard).

¹¹⁰ See, e.g., Carol Barnhart, Inc. v. Econ. Cover Corp., 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J. dissenting) (asking whether the design evokes in an observer a different mental concept than the useful article itself); Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (asking whether the artistic design features of the article are “primary” and the useful ones “subsidiary”).

¹¹¹ Pivot Point, 372 F.3d at 931; Lamps Plus, Inc. v. Seattle Lighting Fixture Co., 345 F.3d 1140, 1147 (9th Cir. 2003); Superior Form Builders v. Dan Chase Taxidermy Supply Co., 74 F.3d 488, 494 (4th Cir. 1996); Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) (stating that the test for copyrightability of designs is whether the “design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences”).

¹¹² Robert C. Denicola, Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 Minn. L. Rev. 707, 742 (1983).

¹¹³ Compare *supra* notes 89-93 and accompanying text with Denicola, *supra* note 112, at 742.

¹¹⁴ Kieselstein-Cord, 632 F.2d at 990-91.

¹¹⁵ Cohen, *supra* note 44, available at <http://www.coolcopyright.com/cases/chp4/kieselsteinpearl.htm> (last visited Mar. 30, 2007).

¹¹⁶ Kieselstein-Cord, 632 F.2d at 993.

¹¹⁷ Id. at 993-94.

¹¹⁸ Id.

¹¹⁹ Brandir Int'l v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1143 (2d Cir. 1987).

¹²⁰ Cohen, *supra* note 44, available at <http://www.coolcopyright.com/cases/chp4/brandircascade.htm> (last visited Mar. 30, 2007).

¹²¹ Brandir, 834 F.2d at 1145, 1147.

¹²² Id. at 1147.

¹²³ Id. at 1147-48.

¹²⁴ Id. at 1148.

¹²⁵ Id. at 1147.

¹²⁶ Id. The court stated:

In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIBBON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack's curves, the straightened vertical elements that allow in-and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds.

Id.

¹²⁷ Brandir Int'l v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) (stating that "where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists") (*emphasis added*).

¹²⁸ See *infra* notes 178-179 and accompanying text (noting that to prove infringement, the plaintiff must first show that individual protectable design elements have been copied).

¹²⁹ See *supra* note 88 and accompanying text (noting that a design patent covers only the individual design features that satisfy the requirements for patentability, i.e., the points of novelty).

¹³⁰ I use the term "narrow" here to refer to the fact that a design with relatively few protectable features is only infringed if someone copies those few features. See *infra* note 181 and accompanying text (noting that actual copying of protectable subject matter is a threshold requirement for copyright infringement). Thus, a design overall can be more similar to such a "narrowly" copyrighted design without infringing, as long as the protectable features have not been copied.

¹³¹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

¹³² Id.

¹³³ Id. at 768 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d. Cir. 1976)).

¹³⁴ *Abercrombie*, 537 F.2d at 9.

¹³⁵ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212 (2000).

¹³⁶ Id.

¹³⁷ Id. at 213.

¹³⁸ See *id.* at 212-13.

¹³⁹ Id. at 215.

¹⁴⁰ Id.

¹⁴¹ See *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 214-15 (2000) (stating, “[c]ompetition is deterred, however, not merely by successful suit but by the plausible threat of successful suit, and given the unlikelihood of inherently source-identifying design, the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle.”).

¹⁴² *In re Slokevage*, 441 F.3d 957, 960 (Fed. Cir. 2006).

¹⁴³ Id.

¹⁴⁴ See, e.g., *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 310 (6th Cir. 2001) (finding that a “lounge chair and ottoman are based on product design and cannot be confused with product packaging”); *Continental Lab. Prods., Inc. v. Medax Int’l, Inc.*, 114 F. Supp. 2d 992, 999 (S.D. Cal. 2000) (finding a multiple pipette container to be product design because “[t]he user does not discard the card-holding container upon receipt of the product, but rather, the container remains until the customer has put all of the pipette tips to use.”).

¹⁴⁵ See, e.g., *Slopevage*, 441 F.3d at 962 (“Even if this were a close case, therefore, we must follow [Wal-Mart] and classify the trade dress as product design.”); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 41 (1st Cir. 2001) (requiring proof of secondary meaning upon finding that trade dress rights asserted in the combination of candle designs with certain candle labels, holders, displays, and catalogs were not clearly product packaging or product design); *McKernan v. Burek*, 118 F. Supp. 2d 119, 123-24 (D. Mass. 2000) (finding a novelty bumper sticker to be ambiguous trade dress because “the packaging and the product are so intertwined that distinguishing between them may be regarded as a scholastic endeavor”).

¹⁴⁶ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) (noting that “[d]enying protection for inherently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator’s dress in other markets and to deter the originator from expanding into and competing in these areas.”).

¹⁴⁷ Id. at 769.

¹⁴⁸ Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164-65 (1995).

¹⁴⁹ *Id.* at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.* 456 U.S. 844, 850 n.10 (1982)).

¹⁵⁰ *Brandir Int'l v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1148 (2d Cir. 1987). See *supra* notes 119-130 and accompanying text for a discussion of the *Brandir* case with regard to the copyright claim involved.

¹⁵¹ *Id.*

¹⁵² *Id.* The *Brandir* court remanded the section 43(a) claim for further factual findings related to functionality. *Id.* at 1148-49.

¹⁵³ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30 (2001). Note that the trade dress nonfunctionality test is very similar to the test for inherent distinctiveness. See *supra* notes 131-134 and accompanying text (noting that the more arbitrary the trade dress is, the more inherently distinctive it is).

¹⁵⁴ See *supra* note 112 and accompanying text (discussing Professor Denicola's copyright nonfunctionality test).

¹⁵⁵ See *supra* notes 110-113 and accompanying text (showing that copyright conceptual separability essentially amounts to arbitrariness).

¹⁵⁶ See *supra* notes 89-93 and accompanying text (showing that the ornamental design requirement amounts to arbitrariness).

¹⁵⁷ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). This aspect of trademark protection will be addressed in detail in Part V.C.

¹⁵⁸ See *supra* notes 94-97 and accompanying text (discussing the design patent novelty requirement).

¹⁵⁹ 35 U.S.C. § 271(a) (2006).

¹⁶⁰ *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

¹⁶¹ *Id.*

¹⁶² 8 Chisum, *supra* note 99, § 23.05[2].

¹⁶³ 8 Chisum, *supra* note 99, § 23.05[2].

¹⁶⁴ 8 Chisum, *supra* note 99, § 23.04[2].

¹⁶⁵ *Avia Group*, 853 F.2d at 1565.

¹⁶⁶ *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998). It is important to note that

this finding was with respect to claim construction, and that the fact that truck drivers were the ordinary purchasers was of consequence for purpose of infringement. *Id.*

¹⁶⁷ *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1404-05 (Fed. Cir. 1997) (citing *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995)).

¹⁶⁸ 8 Chisum, *supra* note 99, § 23.05[7].

¹⁶⁹ 8 Chisum, *supra* note 99, § 23.05[7].

¹⁷⁰ 8 Chisum, *supra* note 99, § 23.05[7].

¹⁷¹ *Door-Master Corp. v. Yorktown, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)).

¹⁷² *Id.*

¹⁷³ *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

¹⁷⁴ *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998) (concluding similarity of overall appearance is an insufficient basis for a finding of infringement, unless the similarity embraces the points of novelty of the patented design).

¹⁷⁵ *Id.* at 1116.

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 1116-17.

¹⁷⁸ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (holding that the copying of 1,309 phone numbers from the plaintiff's directory was not actionable since the numbers were not original to the plaintiff and were thus not protectable by copyright).

¹⁷⁹ *Id.*

¹⁸⁰ *Johnson v. Gordon*, 409 F.3d 12, 18 (1st Cir. 2005).

¹⁸¹ *Id.* ("[T]he plaintiff must show that copying actually occurred. This showing entails proof that, as a factual matter, the defendant copied the plaintiff's copyrighted material.").

¹⁸² *Id.* (noting that having to access a work is circumstantial evidence that "gives rise to an inference of actual copying" when the works are substantially similar).

¹⁸³ 4 Nimmer & Nimmer, *supra* note 51, § 13.03[D].

¹⁸⁴ Selle v. Gibb, 741 F.2d 896, 904 (7th Cir. 1984).

¹⁸⁵ See, e.g., *id.* at 904 (explaining that a “striking similarity” exists where the works are so alike that the similarity can only be reasonably explained by copying).

¹⁸⁶ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (stating that “[t]he test for infringement of a copyright is of necessity vague”).

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ 4 Nimmer & Nimmer, *supra* note 51, § 13.03[E].

¹⁹⁰ See, e.g., *Dawson v. Hinshaw Music, Inc.*, 905 F.2d. 731, 733 (4th Cir. 1990) (holding that “obedience to the undisputed principles of copyright law and the policy underlying the ordinary observer test requires a recognition of the limits of the ordinary lay observer characterization of the ordinary observer test. Those principles require orientation of the ordinary observer test to the works’ intended audience, permitting an ordinary lay observer characterization of the test only where the lay public fairly represents the works’ intended audience.”).

¹⁹¹ *Lyons P’ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 802 (4th Cir. 2001) (noting that the intended audience rule helps to protect the copyright owner’s financial interests, e.g., where children are the intended audience, a “knock off” copy would not successfully harm those interests unless children believe it to be the same as the original).

¹⁹² *Id.*

¹⁹³ See *supra* notes 178-188 and accompanying text (explaining the general framework for copyright infringement).

¹⁹⁴ See *supra* notes 171-177 and accompanying text (noting that for design patent infringement purposes, infringement occurs when the ordinary observer perceives the designs to be substantially similar and that the ordinary observer is the typical consumer of the product).

¹⁹⁵ 17 U.S.C. § 107 (2006).

¹⁹⁶ *Id.*

¹⁹⁷ Cf. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 563 (1985) (stating, “[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.”).

¹⁹⁸ Cf. *id.* at 562-63, 566-68.

¹⁹⁹ Cf. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (stating, “[a]lthough such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of

copyright.”).

200 Id.

201 Id.

202 Id.

203 See *supra* notes 159-161 and accompanying text (discussing the broad right to exclude that is provided by a design patent).

204 *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

205 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 2A.05 (2007). These factors include, *inter alia*, the distinctiveness of the trade dress, the similarity of the trade dress, the similarity of marketing channels and relatedness of the products, the knowledge and care of purchasers, the intent to copy or confuse, and actual consumer confusion. *Id.*

206 Id.

207 *Frosty Treats, Inc. v. Sony Computer Entm’t Am., Inc.*, 426 F.3d 1001, 1008 (8th Cir. 2005).

208 Id.

209 LaLonde, *supra* note 205, § 2A.05.

210 LaLonde, *supra* note 205, § 2A.05.

211 *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 214 (3d Cir. 2000) (noting that “when goods are directly competing, both precedent and common sense counsel that the similarity of the marks takes on great prominence” for determining whether consumer confusion is likely).

212 15 U.S.C. § 1125(c) (2006).

213 LaLonde, *supra* note 205, § 2A.05.

214 See, e.g., *supra* notes 171-177 and accompanying text (noting that the ordinary observer is one who typically purchases a patented design product, giving such attention to the product features as such a person would); *supra* notes 189-194 and accompanying text (noting that when copyrighted designs are geared more toward a particular audience, that audience’s impression is especially relevant for infringement).

215 LaLonde, *supra* note 205, § 2A.05; but see *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 206 (3d Cir. 1995) (positing that an intent to copy or confuse is relatively weak evidence of infringement because it gives little to no insight into the actual market effects).

216 *Versa Prods.*, 50 F.3d at 206 (noting that copying a competitor’s product packaging supports an inference that the person is trying to “cash in on the competitor’s goodwill” associated with that packaging).

²¹⁷ Id. at 207 (noting that “[w]here product configurations are concerned, we must be especially wary of undermining competition”).

²¹⁸ Id. (citations omitted).

²¹⁹ Id. at 205-08.

²²⁰ 15 U.S.C. § 1115(b)(4) (2006).

²²¹ *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 268 (2d Cir. 1995).

²²² Id.

²²³ Id.

²²⁴ Id. at 270.

²²⁵ Id.

²²⁶ See *supra* note 172 and accompanying text (noting that design patent infringement is evaluated from the perspective of an ordinary purchaser of the article, being as discerning as that purchaser would be).

²²⁷ See *supra* notes 162-163 and accompanying text (noting that design patent infringement is unlikely when the designs are embodied in different products because such differences tend to change their overall appearances).

²²⁸ *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 828 (Fed. Cir. 1992) (finding that “in showing design patent infringement there is ordinarily no compelling need for empirical evidence” of market effects because it need only be shown that an ordinary observer would be deceived).

²²⁹ *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1126 (Fed. Cir. 1993) (citations omitted). For example, there would presumably be no likelihood of confusion between two identical product designs if they are clearly packaged or labeled as being different brands. *Id.* However, there would be design patent infringement in such a situation because patent law does not inquire as to the realities of how consumers actually encounter the products in the marketplace. *Id.*

²³⁰ 15 U.S.C. § 1115(b)(5) (2006) (noting that a prior user defense exists for those who have continually used their trade dress in a particular geographic region).

²³¹ *Thrifty Rent-A-Car Sys., Inc. v. Thrift Cars, Inc.*, 831 F.2d 1177, 1181 (1st Cir. 1987).

²³² *Id.*

²³³ See 35 U.S.C. § 102(g)(2) (2006) (“A person shall be entitled to a patent unless ...before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it.”); *Int’l Glass Co. v. United States*, 408 F.2d 395, 403-04 (Ct. Cl. 1969) (noting that a prior making of the patented invention did not invalidate the

patent under § 102(g) because the work remained effectively secret).

²³⁴ United States Patent & Trademark Office (USPTO), Classification of Design Patents, <http://www.uspto.gov/web/offices/pac/dapp/sir/co/examhbk/seven.htm> (last visited Mar. 30, 2007).

²³⁵ See USPTO, Patent Full-Text and Full-Page Image Databases, <http://www.uspto.gov/patft/index.html> [hereinafter PTO Database] (follow “Quick Search”; enter classification number in “Term 1” and restrict “Field 1” by “Current US Classification”; then “Search” years “1976 to present (full-text)” (last visited Mar. 12, 2007). See also USPTO, Patent Counts by Class by Year: January 1977-December 2006, available at <http://www.uspto.gov/go/taf/cbcby.pdf> (last visited Mar. 30, 2007).

²³⁶ USPTO, U.S. Patent Statistics: Calendar Years 1963-2006 1 (2007), http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.pdf [hereinafter PTO Patent Statistics].

²³⁷ USPTO, Design Patents: A Patent Technology Monitoring Team Report B1 (2007), <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.pdf>.

²³⁸ Id.

²³⁹ Library of Congress, It May Be the Biggest Statue Ever Copyrighted, LOC.GOV Wise Guide, <http://www.loc.gov/wiseguide/oct04/statue.html> (last visited March 30, 2007).

²⁴⁰ U.S. Patent No. D11,023 (filed Jan. 2, 1879). The design was entitled “Liberty Enlightening the World.” Id.

²⁴¹ Id.

²⁴² It is permissible to obtain both copyright and patent protection for the same design. 1 Nimmer & Nimmer, *supra* note 51, § 2.19.

²⁴³ See *supra* notes 182, 183 and accompanying text (noting that as the evidence of access to a copyrighted work increases, the amount of substantial similarity necessary to prove infringement decreases).

²⁴⁴ 17 U.S.C. § 201(d) (2006).

²⁴⁵ U.S. Patent No. D48,160 (filed Aug. 18, 1915).

²⁴⁶ Id.

²⁴⁷ U.S. Trademark No. 1,057,884 (registered Feb. 1, 1977).

²⁴⁸ Id.

²⁴⁹ Id.

²⁵⁰ Michael Barbaro & Julie Creswell, With a Trademark in Its Pocket, Levi’s Turns to Suing Its Rivals, N.Y. Times, Jan. 29, 2007, at A1.

251 Id.

252 U.S. Trademark No. 1,139,254 (registered Sep. 2, 1980).

253 Id.

254 U.S. Patent No. D258,172 (filed June 13, 1979). Designers are permitted to obtain both design patent and trademark protection for the same design. See 1-2A LaLonde, *supra* note 205, § 2A.10 [1][b] (noting that since the patent and trademark laws were enacted distinctly by Congress to serve different purposes, designs can be protected under both schemes).

255 U.S. Patent No. D258,172 (filed June 13, 1979).

256 Barbaro & Creswell, *supra* note 250, at A1.

257 Barbaro & Creswell, *supra* note 250, at A1.

258 Barbaro & Creswell, *supra* note 250, at A1.

259 Barbaro & Creswell, *supra* note 250, at A1. (noting that Levi's' aggressive protection of its trademark rights has been enough to deter many competitors from using confusingly similar designs, thus preserving the strength of Levi's' trademark rights); see *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986) (finding trademark infringement in large part because Levi's' "back pocket stitching pattern is a fanciful registered trademark with a very strong secondary meaning").

260 Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1367 (Fed. Cir. 2006).

261 See *supra* notes 234-235 and accompanying text.

262 U.S. Patent No. D475,218 (filed Apr. 12, 2002).

263 Id.

264 Amini Innovation, 439 F.3d at 1368.

265 Id.

266 Id. at 1369.

267 Id.

268 Id.

269 Id.

270 Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1370 (Fed. Cir. 2006) (citations omitted).

271 Id.

272 Id. at 1372.

273 See *id.* (holding that a reasonable jury could find that the design patent had been infringed, and noting that the trial court mistakenly applied an element-by-element test for design patent infringement).

274 Id. at 1369.

275 Id.

276 See Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1369 (quoting *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002)).

277 Id. at 1371.

278 Id.

279 Id. at 1372.

280 See *id.* at 1370 (noting that “it is well settled that a jury may even find a combination of unprotectible elements to be protectible under the extrinsic test because ‘the over-all impact and effect indicate substantial appropriation’”) (citations omitted).

281 See *Rose Art Indus. v. Swanson*, 235 F.3d 165, 173 (3d Cir. 2000) (holding that the trade dress of a “series or line of products” can be protected if it has a “recognizable and consistent overall look” and that variations are permitted to the extent that the distinctive and uniform character of the trade dress are not affected).

282 See *supra* notes 135-146 and accompanying text (discussing the line that the Wal-Mart court drew between product packaging and product design trade dress).

283 35 U.S.C. § 173 (2006).

284 See *supra* note 161 and accompanying text (noting that design patentees do not need to produce or manufacture any products).

285 See *supra* notes 135-146 and accompanying text (noting that Wal-Mart makes it more likely that product designers will have to establish secondary meaning before they can assert trade dress rights).

286 See *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 485 (7th Cir. 2007) (noting that “[t]rademarks cannot be ‘banked’ or ‘warehoused,’” but must be subject to bona fide use in commerce in order to obtain trademark rights).

287 *Id.*

288 See Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000).

289 *Id.* at 212-13.

290 See *supra* Part VI.C (noting that the thin evidence of access to Amini's copyrighted furniture design, which amounted only to proof that the designs were displayed at trade shows where representatives of Anthony were present, was nevertheless sufficient to survive a summary judgment motion).

291 See *supra* notes 266-269 and accompanying text.

292 See *supra* notes 182-185 and accompanying text (noting that access and substantial similarity are elements of a copyright infringement claim absent direct evidence of copying by the accused).

293 See *supra* note 183 and accompanying text (explaining that the more evidence of access that is established, the less similar the designs need to be, and vice versa).

294 See *supra* notes 119-129 and accompanying text (discussing the Brandir case).

295 See *supra* notes 125-127 and accompanying text (noting that the Brandir court erred in the application of its conceptual separability rule, looking at the whole design rather than its individual artistic features to see if it could be protected).

296 See *supra* note 237 and accompanying text.

297 See PTO Database, *supra* note 235.

298 See PTO Database, *supra* note 235.

299 United States Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://www.uspto.gov/main/trademarks.htm> (last visited Feb. 2, 2008) (click on the "Where do I start" hyperlink and then the "TESS" hyperlink to access the database).

300 *Id.*

301 See U.S. Copyright Office, Records, <http://www.copyright.gov/records/> (last visited Apr. 13, 2007).

302 See *id.* (e.g., performing a search to look for a registered "sculpture" or a "design" yields no pictures or detailed descriptions of the art).

303 *Id.*

304 17 U.S.C. § 408 (2006) (stating that "registration is not a condition of copyright protection"); 15 U.S.C. § 1125(a)(3) (specifically contemplating actions for infringement of unregistered trade dress); Dep't of Parks & Recreation v. Bazaar Del Mundo, Inc., 448

F.3d 1118, 1125 (9th Cir. 2006) (“Registration under the Lanham Act has no effect on the registrant’s rights under the common law”).

305 See 35 U.S.C. § 102 (2006) (defining prior art to include any “printed publication”).

306 See, e.g., Thomson CompuMark, U.S. Availability Search, <http://www.thomson-thomson.com/do/pid/109> (last visited Feb. 8, 2008) (discussing services available for trademark searching).

307 See supra notes 231-233 and accompanying text (noting that prior users of trademarks can continue to use their marks even after a subsequent user obtains a federal registration).

308 For example, if designers kept notebooks or scrapbooks that showed the creation and progress of a design, along with the dates of sketches or models, that evidence would be compelling proof of independent creation.

309 Paris Convention for the Protection of Industrial Property art. 4, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305 (revised July 14, 1967) (amended Sept. 28, 1979), available at <http://www.wipo.int/treaties/en/ip/paris/> [hereinafter Paris Convention].

310 Id. (“Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union ... shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.”).

311 35 U.S.C. § 172 (2006) (“The right of priority provided for by subsections (a) through (d) of [35 U.S.C. § 119] ...shall be six months in the case of designs.”).

312 See 35 U.S.C. § 119(a).

313 15 U.S.C. § 1141g (2006) (“The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property.”).

314 Paris Convention, supra note 309, art. 4.

315 For example, a community design right in Europe is distinct from a patent but affords some similar protections. See *infra* Part VIII.

316 The Hague Agreement is another means by which designs can be protected internationally. See World Intellectual Property Organization, Hague Agreement Concerning the International Deposit of Industrial Designs, July 2, 1999, 2279 U.N.T.S. 156, available at http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/geneva_act_1999.pdf. Essentially, it allows a designer to apply for an International Design Registration (IDR) from the World Intellectual Property Organization (WIPO), which performs no substantive examination, but only ensures that the application complies with all formalities. See World Intellectual Property Organization, Guide to the International Registration of Designs, http://www.wipo.int/export/sites/www/hague/en/guide/pdf/hague_guide.pdf (last visited February 2, 2008). Once the IDR has been obtained, each designated country has an opportunity to reject the application based on its own substantive requirements, if any. Id. To date, the United States has not joined the Hague Agreement, making further discussion of it beyond the scope of this paper. See World Intellectual Property Organization, Members of the Hague Union, <http://www.wipo.int/hague/en/members/> (last visited Feb. 2, 2008) (click on the “List of Members” PDF hyperlink).

317 Compare 37 C.F.R. § 1.431 (2006) (listing the requirements for international patent applications to receive a filing date accorded by the U.S. receiving office), with Patent Cooperation Treaty arts. 3-7, June 19, 1970, 28 U.S.T. 7645, 9 I.L.M. 978, available at <http://www.wipo.int/pct/en/texts/articles/atoc.htm>.

318 Patent Cooperation Treaty *supra* note 317, art. 11.

319 Agreement on Trade-Related Aspects of Intellectual Property Rights art. 25(1), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments--Results of the Uruguay Round, 33 I.L.M. 81, 93 (1994) [hereinafter TRIPS Agreement]. The TRIPS Agreement further states that “[m]embers may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.” *Id.* See also Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (codified in scattered sections of 15, 17, 19, and 35 U.S.C.).

320 J. H. Reichman, Universal Minimum Standards of Intellectual Property Protection Under the TRIPS Component of the WTO Agreement, 29 Int’l Law. 345, 375 (1995) (noting that “the TRIPS Agreement leaves participating states relatively free to draft domestic design protection laws with local objectives in mind”).

321 Compare TRIPS Agreement, *supra* note 319, art. 25(1), 33 I.L.M. at 93 (requiring protection for “independently created industrial designs that are new or original”) with *supra* note 105 and accompanying text (explaining that original designs are eligible for copyright protection). Compare TRIPS Agreement, *supra* note 319, art. 26(1), 33 I.L.M. at 93 (requiring that designers have the right to exclude others from “making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes”) with 17 U.S.C. § 106 (2006) (stating that copyright owners have the right to exclude others from reproducing or distributing their works). Compare TRIPS Agreement, *supra* note 319, art. 26(3), 33 I.L.M. at 93 (requiring that industrial designs be protected for a minimum of ten years) with 17 U.S.C. § 302 (creating a copyright term exceeding seventy years).

322 Council Regulation 6/2006, Community Designs, 2001 O.J. (L 3) 1 (EC), available at http://oami.europa.eu/en/design/pdf/reg2002_6.pdf.

323 *Id.* art. 11.

324 *Id.*

325 See *supra* notes 184-185 and accompanying text (noting that copyright infringement makes it unlawful to copy from someone else’s known work but not to simply create and use the same design).

326 See *supra* notes 74-83 and accompanying text (noting that requiring proof of secondary meaning ensures that the design has come to be associated in consumers’ minds with a particular producer).

327 Council Regulation, *supra* note 322, art. 12.

328 Council Regulation, *supra* note 322, preface ¶ 16 (noting that “there are sectors of industry ...which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products”).

329 Council Regulation, *supra* note 322, arts. 3, 4, 8.

330 Council Regulation, *supra* note 322, art. 5 (“A design shall be considered to be new if no identical design has been made available to the public”).

331 Council Regulation, *supra* note 322, art. 4.

³³² Council Regulation, *supra* note 322, art. 6(2) (“In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.”).

³³³ See *supra* notes 97, 171-177 and accompanying text (discussing the ordinary observer requirement for design patent novelty, and noting that the relevant and typical purchasers of the product dictate the perspective of this analysis).

³³⁴ See *supra* notes 157-158, 226-229 and accompanying text.

³³⁵ Council Regulation, *supra* note 322, art. 19; 35 U.S.C. § 271(a), (c) (2006).

³³⁶ Council Regulation, *supra* note 322, art. 20.

³³⁷ Council Regulation, *supra* note 322, art. 20.

³³⁸ See *supra* notes 195-196 and accompanying text.

³³⁹ Council Regulation, *supra* note 322, art. 22; see *supra* Part V.B.

³⁴⁰ See *supra* notes 231-232 and accompanying text (discussing how prior users of trademarks may continue to use their marks within the geographic region that they had been continuously using them).

³⁴¹ See *supra* note 184 and accompanying text (noting that proof of independent creation can be a complete defense to a charge of copyright infringement).

³⁴² *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (noting that for copyright protection, “the requisite level of creativity is extremely low; even a slight amount will suffice”).

³⁴³ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903). The Bleistein Court stated:
It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value--it would be bold to say that they have not an aesthetic and educational value--and the taste of any public is not to be treated with contempt.
Id.

³⁴⁴ See, e.g., *Feist*, 499 U.S. at 359 (stating that the law should only deny copyright protection when “the creative spark is utterly lacking or is so trivial as to be nonexistent” (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903))); *Mazer v. Stein*, 347 U.S. 201, 214 (1954) (“Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”).

³⁴⁵ Note, *Design Protection--Time to Replace the Design Patent*, 51 Minn. L. Rev. 942, 952-53 (1967).

³⁴⁶ *Id.*

347 Id at 954. (“[D]esigns simply are not concepts [that] can be analogized to mechanical patents.”).

348 Id. at 952. See *In re Laverne*, 356 F.2d 1003, 1006 (C.C.P.A. 1966), abrogated by *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981). The Laverne court stated:

In the field of design the analysis is not so easy. Design inventing or originating is done by designers. The examiner here has referred to ‘the expected skill of a competent designer’ as the basis of comparison. However, if we equate him with the class of mechanics, as the examiner did, and refuse design patent protection to his usual work product, are we not ruling out, as a practical matter, all patent protection for ornamental designs for articles of manufacture? Yet the clear purpose of the design patent law is to promote progress in the ‘art’ of industrial design and who is going to produce that progress if it is not the class of ‘competent designers’?

Laverne, 356 F.2d at 1006.

349 Design Protection--Time to Replace the Design Patent, *supra* note 345, at 960.

350 PTO Patent Statistics, *supra* note 236, at 1. This graph was generated by calculating the number of “Design Patent Grants” divided by the number of “Design Patent Applications,” and then plotting the resulting percentage as a function of the year.

351 PTO Patent Statistics, *supra* note 236, at 1. (the “Design Patent Applications” column, for example, shows that the number of applications was 4,968 in 1963, and that the number had steadily increased to 25,515 by 2006).

352 I say that it is impossible for two reasons. First, I do not have any data after 2005 that would indicate that the allowance rate is heading toward zero and not preparing to begin another cycle. Second, this data encompasses all types of design patents. It is quite possible that similar graphs made for each class of designs would show a clearer trend toward lower allowance rates.

353 *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903).

354 *Id.*

355 35 U.S.C. § 173 (2006).

356 35 U.S.C. § 271(a) (2006).

357 17 U.S.C. § 302(a) (stating that the copyright term for works created by individuals is the life of the author plus 70 years after the author’s death).

358 See *supra* notes 196-199 and accompanying text (noting that copyrighted designs can be used in fair and transformative manners that are noninfringing).

359 See generally 4 Nimmer & Nimmer, *supra* note 51, § 13.05 (discussing the copyright fair use doctrine).

360 If the characterization of the design patent grant rates shown in the graph indeed reflects the cyclical nature of obviousness, then the peaks of the graph which represent flourishes in creativity would each coincide with the start of new designing trends. At each peak year in the graph, a person would likely find that the designs for furniture, consumer products, clothing, vehicles, etc., all looked very different.

361 Even the creative selection or arrangement of a preexisting work by a different author can satisfy the originality requirement. 17 U.S.C. § 103(b) (2006) (stating that copyright protection is available for compilations, however, “[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting

material employed in the work”).

³⁶² 15 U.S.C. § 1059(a) (2006) (stating that “each registration may be renewed for periods of 10 years at the end of each successive 10-year period”).

³⁶³ Not only is the threshold for protection under copyright fairly low, but copyright exists even without any formal registration. 17 U.S.C. § 102(a) (2006) (“Copyright protection subsists ...in original works of authorship fixed in any tangible medium of expression”) (emphasis added). Moreover, registration is a simple matter of filling out a form, paying a nominal \$45 fee, and depositing copies of the work at the Copyright Office. U.S. Copyright Office, Visual Art Works Registration, <http://www.copyright.gov/register/visual.html> (last visited April 13, 2007).

³⁶⁴ See generally *supra* Part VII.

³⁶⁵ See *supra* Part VIII.

³⁶⁶ Design Protection--Time to Replace the Design Patent, *supra* note 345, at 952-54.

³⁶⁷ Cf. Janice M. Mueller, The Evanescent Experimental Use Exemption from United States Patent Infringement Liability: Implications for University and Nonprofit Research and Development, 56 Baylor L. Rev 917, 925-36, 976-77 (2004) (discussing the virtues of the copyright fair use doctrine and noting how the policies behind it support the enactment of a narrow experimental use exception for patent infringement).