

COPYRIGHT-LIKE PROTECTION FOR DESIGNS

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I. INTRODUCTION

For many decades, the preferred route to protection against imitators of original designs has been a variation of the protection of the law of copyright. Many participants and observers, both interested and disinterested, believe that design is under-protected. Congress, however, has yet to be persuaded that additional protection is needed.

This Article reviews the quest for copyright-like protection of designs. This quest falls into two uneven time spans. One stretches from before the 1930s¹—more intensely from 1957—through 1983. Every Congress, since the 85th in 1957,² has witnessed the introduction of a bill to protect the *ornamental* designs of useful articles. These bills have passed the Senate five times³ but have never received favorable treatment in the House. The second time span is just a blink from 1985, when the perennial bill came to be titled “Industrial Designs of Useful Articles,”⁴ and a significant shift of emphasis occurred. This Article considers whether this changeling has any better chance of passage than its predecessors, and further, whether as a matter of public policy, it *should* become law.

II. OTHER ROADS TO PROTECTION

Before analyzing the two copyright-like versions of design protection, it would be useful to survey the alternatives to a new form of protection, and discuss briefly why certain roads are not taken, or, if they are, why they appear to come to a dead end. The discussion will focus particularly on design patent, copyright, trademark and trade dress, and misappropriation.⁵

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1. For a history of design legislation, see a valuable publication produced by the Copyright Office: *BIBLIOGRAPHY ON DESIGN PROTECTION* (1955 & Supp. 1959, 1976). The most penetrating of the American scholarly writings on design protection are Professor J.H. Reichman's massive articles: Reichman, *Design Protection and the New Technologies: The United States Experience in a Transactional Perspective*, 19 U. BALT. L. REV. 6 (1989); Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143 [hereinafter Reichman, *Design Protection in Copyright Law*]; Reichman, *Design Protection After the Copyright Act of 1976: A Comparative View of the Emerging Interim Models*, 31 J. COPYRIGHT SOC'Y 267 (1984).
2. During the 85th Congress in 1957, the Willis bill, H.R. 8873, 85th Cong., 1st Sess. (1957), was introduced. For further discussion of these bills, see generally Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341 (1987) [hereinafter Brown, *Overview*].
3. See Brown, *Overview*, *supra* note 2, at 1395.
4. H.R. 1900, 99th Cong., 1st Sess. (1985).
5. For an extensive discussion of each of these areas of the law, see generally Brown, *Overview*, *supra* note 2.

A. Design Patents

Upon initial consideration, design patent would seem to be a precise and effective method of design protection. Particularly, section 171 of the Patent Act states: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor."⁶

Well known, however, are the difficulties of obtaining and enforcing design patents.⁷ The main problem is that the design must display inventiveness; it must be nonobvious. These requirements are incorporated through section 171, which states that "[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."⁸

For a time, the burden on those persons applying for design patents was somewhat lighter. In an attempt to make design patents more accessible, the Court of Customs and Patent Appeals (CCPA), guided by Judge Giles Rich, held in 1966 that inventiveness was to be tested by the eyes of the ordinary observer, rather than by the statutory construct of "a person having ordinary skill in this art."⁹ By 1981, however, three or four federal circuits had rejected the "ordinary observer" test and adhered to one based on the "ordinary designer."¹⁰ The CCPA on the eve of its metamorphosis to the Court of Appeals for the Federal Circuit, followed the lead of those circuits, and adopted the "ordinary designer" test, with a rueful concurrence by Judge Rich. In *In re Nalbandian*,¹¹ the CCPA held that "[i]n design cases we will consider the fictitious person identified in section 103 as 'one of ordinary skill in the art' to be the designer of ordinary capability who designs articles of the type presented in the application."¹²

The significance of the use of the "ordinary designer" test is not readily apparent either in judicial review by the Federal Circuit, or in the examining and review standards of the Patent and Trademark Office (PTO). In any event, the statutory standard requiring nonobviousness now appears judicially riveted into place, and there is no movement of which I am aware for any congressional modification of that standard with regard to design patents. This lack of movement may reflect a resigned acceptance that it is

6. 35 U.S.C. § 171 (1988).

7. See, e.g., Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? 20 Years of Design Patent Litigation Since Compco v. Day-Brite Lighting, Inc., and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY U.L. REV. 195 (1985).

8. 35 U.S.C. § 171 (1988). The nonobviousness requirement comes from 35 U.S.C. § 103 (1988).

9. *In re Laverne*, 356 F.2d 1003, 1006 (C.C.P.A. 1966).

10. See *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Prods., Inc.*, 597 F.2d 210 (10th Cir. 1979); *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265 (3d Cir.), cert. denied, 409 U.S. 1023 (1972); *Fields v. Schuyler*, 472 F.2d 1304 (D.C. Cir. 1972), cert. denied, 411 U.S. 987 (1973); *Rains v. Niaqua, Inc.*, 406 F.2d 275 (2d Cir.), cert. denied, 395 U.S. 909 (1969).

11. 661 F.2d 1214 (C.C.P.A. 1981).

12. *Id.* at 1216.

not the nonobvious requirement that makes design patents unpopular; it is, rather, the patent process itself. The requirement that the PTO search the prior art, and make a judgment regarding obviousness and novelty makes the process inescapably tedious and expensive. Despite strenuous efforts in recent times to surmount the backlog and accelerate the search process, it still can take eighteen months to two years before a design patent is approved or denied. In addition, substantial application and lawyers' fees must be paid. It is not difficult to envision, therefore, why designers yearn for a system that combines low search costs and high speed.¹³

B. Copyrights

Copyright appears to meet the goals of convenience lacking in design patents;¹⁴ it is cheap and expeditious. In fact, there was a time some thirty-five years ago, during the immediate aftermath of *Mazer v. Stein*,¹⁵ when copyright seemed hospitable to artistic design. *Mazer* held that the intended use of a Balinese figure as a lamp base did not preclude copyright in the figure. Initially, the Copyright Office supported such an outcome in its amicus brief, and further encouraged the Court to legitimize a supposed Copyright Office practice of registering artistic objects having utilitarian applications.

The ink was hardly dry on *Mazer* before the Copyright Office began to backtrack. It was inundated with useful objects claiming artistic shapes.¹⁶ Although amended regulations¹⁷ created no barrier to commercial use or mass production of qualifying works, they succeeded in disqualifying the shapes of most useful articles, except for features "such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art."¹⁸ The "separability test" arising from the amended regulations was upheld in *Esquire, Inc. v. Ringer*,¹⁹ where the Circuit Court for the District of Columbia determined that the denial of a copyright for lighting fixtures whose form followed their function was proper.

The separability test was ultimately incorporated into the 1976 General

13. See Fryer, *Industrial Design Protection in the United States of America—Present Situation and Plans for Revision*, 19 U. BALT. L. REV. 198 (1989) [hereinafter Fryer, *Industrial Design*].

14. See generally Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

15. 347 U.S. 201 (1954).

16. See *Design Protection: Hearing on S. 2075 and S. 2852 Before the Senate Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary*, 86th Cong. 2d Sess. 1, 58-59 (1960) [hereinafter *1960 Hearing*] (testimony of Register of Copyrights Arthur Fisher).

17. See Brown, *Overview*, *supra* note 2, at 1345.

18. 37 C.F.R. § 202.10(c) (1959).

19. 591 F.2d 796 (D.C. Cir. 1978) (setting forth relevant regulations), *cert. denied*, 440 U.S. 908 (1979).

Revision as part of the definition in section 101 of “[p]ictorial, graphic, and sculptural works.”²⁰ Nonetheless, modern design sometimes escapes the separability restrictions by being deemed “conceptually” separable even though not physically separable. The most successful escape artist was Barry Kieselstein-Cord with his belt-buckles.²¹ The Second Circuit, however, over dissents in two other leading cases, has refused to find separability in mannequins²² and in a bicycle rack made of bent piping of undenied sculptural origin.²³

Conceptual separability still may have a brighter future, although scarcely anyone argues that it should encompass the whole field of design of useful articles.²⁴ To say that because one can imagine the shape of an article independently of the article’s utility, the article can be copyrighted, would extend the copyright monopoly to a myriad of articles, without anyone’s having tested whether the article’s utility is either novel or inventive in origin.

C. Trademarks and Trade Dress

Trademark and trade dress law afford an expanding but incomplete protection for designers. A distinctive trademark applied to a distinctive design will, if functioning as their proponents say they will, attract buyers to the trademarked product.²⁵ Trademarks do not prevent others from copying a design; all the imitator must do is put a distinctive brand name on the product. Associating a designer with a design through a trademark or trade name is so familiar that we perhaps underrate the efficacy of trademarks. If one cannot endlessly intone a famous designer’s mark, like Ralph Lauren, one can still emphasize a source as “the original” or “the authentic.”

Unfair competition law, in its classic mission to prevent an imitator from passing off his goods as those of an originator, is of little direct use to a designer. An offended designer, or in many cases, the producer of the designed article, cannot directly prevent copying if she is not protected by a utility patent, design patent, or copyright. Indeed, there is weighty public policy that undergirds the privilege to copy.²⁶

20. 17 U.S.C. § 101 (1988).

21. *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 995 (2d Cir. 1980) (illustrating design severability).

22. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 425-26 (2d Cir. 1985) (illustrations).

23. *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987) (illustrations).

24. *But cf.* 1 M. NIMMER & D. NIMMER, *NIMMER ON COPYRIGHT* § 2.01[B][3], at 2-96.5 (1986) (accepting copyright in “a myriad of industrial forms” until design legislation comes to being).

25. *See* 1 J. GILSON, *TRADEMARK PRACTICE AND PROTECTION* ch. 1 (1988); 1 J. MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION* ch. 3 (1984).

26. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146-48 (1989).

Still an artful marketer can protect the actual shape and appearance of a product by taking two affirmative positions and one defensive posture. First, the marketer must show that the buying public associates the appearance of her product with a single source. This step is called (or rather mis-called) the creation and recognition of secondary meaning. Next, the marketer must persuade a court that the imitator's copying creates a likelihood of confusion among customers, although it is not necessary that the marketer prove actual confusion. Likelihood of confusion is sufficient, and often can be inferred from the notion that the imitator's motive in copying is to create confusion. Finally, the marketer will very likely have to defeat a charge by the imitator that the design is not entitled to protection because it is functional.²⁷

Currently, a popular definition of "functionality" embraces the concept that "a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."²⁸ Several decisions emphasize the "essentiality" portion of the definition.²⁹ Indeed, it is fairly easy to prove that a design feature is not essential, and as such, not functional. In a recent Second Circuit case regarding a bicycle rack made by bending pipe so that it became a string of *U*'s and inverted *U*'s, the court determined that a copyright would not satisfy conceptual separability of design from function.³⁰ Yet in the next breath, Judge Oakes strongly encouraged an unfair competition count, and declared that there were many ways to prop up a bicycle, including trees and fire hydrants.³¹

To what extent design protection can coexist with the functional working of a useful article is, of course, a central problem in the copyright-like approach. With regard to the applicability of unfair competition in trade dress, it is enough to say that counter-charges that a design is too functional can be defeated.

The favored channel for condemning appearance copying as unfair competition is section 43(a) of the Lanham Trademark Act (Lanham Act). That section was recently embellished, and perhaps strengthened, by amendments made in 1988,³² even though it was strong enough before it was amended. Section 43(a)'s basic condemnation of any false representations of origin is a commerce clause-based federal statute and runs free of the preemptive power of the Copyright Act on state law.³³ The Lanham Act is also immune from the submission of the states to federal patent and

27. For a more detailed discussion of unfair competition as it applies to design protection, see generally Brown, *Overview*, *supra* note 2.

28. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982).

29. *See, e.g., LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71 (2d Cir. 1985) (a functional feature is one that is essential to the use or purpose of the article).

30. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1148 (2d Cir. 1987).

31. *Id.* at 1148 n.5.

32. 15 U.S.C. § 1125(a) (1988).

33. 17 U.S.C. § 301 (1988). Federal legislation avoids preemption by virtue of § 301(d).

copyright policies associated with the decisions in *Sears, Roebuck & Co. v. Stiffel Co.*³⁴ and *Compco Corp. v. Day-Brite Lighting Co.*³⁵

D. Misappropriation

Misappropriation—the weakest of the four weapons against imitators—emanates from classic unfair competition law, with its roots in consumer confusion, and the policies behind the doctrine. The classic example of the application of the doctrine of misappropriation is found in the previously discredited, but recently rehabilitated, *International News Service v. Associated Press* decision.³⁶ In that case, the Associated Press (AP) asserted that the International News Service (INS), which was barred from the European war zone in 1916, copied AP's news reports, and misappropriated the fruits of AP's labors. The Supreme Court agreed.

The product of a designer is an end similar to AP's news reports in that the designer spends both time and effort on the creation and promotion of a design. The imitator, on the other hand, takes the benefits of the popular design without bearing the burdens of its creation. The misappropriation remedy has powerful equitable appeal, and churns along in subterranean ways, occasionally surfacing in recognized legal channels.

This equitable argument for turning an intangible interest into a property right has been kept in check by the coolness with which law has historically treated its impulsive sibling, equity. As a matter of positive law, the system usually dismisses complaints of misappropriation in this wise: inventions, writings, and designs are all public goods, as they are not consumed by use; only the legislature can create rights in intangibles like design. Although the Constitution does permit the creation of exclusive rights in writings and discoveries, Congress enjoys the ultimate power over the creation of those rights, and the states may act only on matters which Congress has left unattended.³⁷

Courts sometimes get carried away by their own rhetoric, and proclaim, for example, that

34. 376 U.S. 225 (1964).

35. 376 U.S. 234 (1964). For a vigorous endorsement of § 43(a) as the preferred channel of protecting designs, see Dratler, *Trademark Protection of Industrial Designs*, 1988 U. ILL. L. REV. 887.

36. *International News Serv. v. Associated Press*, 248 U.S. 215 (1918). *International News Service*, which Judge Learned Hand tried to read almost out of existence, see *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929), recently was quoted by the Supreme Court in *Carpenter v. United States*, 484 U.S. 19, 26 (1987), as supporting the Wall Street Journal's property right in unpublished material that an employee used for illicit securities trading. Prior to that time, the Wisconsin Supreme Court had proclaimed, in a record piracy case, "*I.N.S. stands.*" *Mercury Record Prods., Inc. v. Economic Consultants, Inc.*, 64 Wis. 2d 163, 182, 218 N.W.2d 705, 714 (1974), cert. denied, 420 U.S. 914 (1975).

37. *Goldstein v. California*, 412 U.S. 546 (1973).

the law of unfair competition does not rest solely on the ground of direct competitive injury, but on the broader principle that property rights of commercial value are to be and will be protected from any form of unfair invasion or infringement and from any form of commercial immorality, and a court of equity will penetrate and restrain every guise resorted to by the wrongdoer.³⁸

The actual application of such exuberance is infrequent. In fact, the tort of misappropriation remains amorphous, and designers cannot reasonably depend upon the willingness of courts to fashion remedies without legislative guidance.³⁹

So we now turn to an examination of the two statutory models, the long-lived bill for the protection of "ornamental designs of useful articles,"⁴⁰ and the recent variant that speaks to "industrial designs of useful articles."⁴¹

III. "ORNAMENTAL" OR "INDUSTRIAL"? WHAT IS THE REAL DIFFERENCE?

A fundamental question about any proposed design legislation is: "What *does* it protect?" That question is welded to one equally fundamental: "What *should* it protect?" Working through these questions requires attention to both the standards and reach of the closely related systems of design patent and copyright. Once a pattern which is substantively harmonious with those systems is achieved, it will remain to be seen whether they will mesh with each other in operation. An additional issue that must be addressed is whether a designer may take advantage of more than one system of protection.

The mechanics of design protection are neither controversial nor of any great interest. They are adapted from copyright, the main variation being that design protection does not become effective until registration.⁴²

38. *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483, 493 (N.Y. Sup. Ct. 1950), *aff'd per curiam*, 279 A.D. 632, 107 N.Y.S.2d 795 (1951).

39. The preemptive power of Congress was recently underscored by the unanimous decision of the Supreme Court in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), where the Court struck down statutes in a dozen states which attempted to make actionable direct molding ("plug" molding), which is the use of an original manufactured object to make a mold from which copies are then made. The decision strongly reaffirms the teachings of *Sears and Compco*, and makes it quite clear that, with respect to designs of useful objects, state law is effectively limited to preventing consumer confusion.

40. S. 22, 94th Cong., 20 Sess. tit. II (1976).

41. H.R. 1990, 99th Cong., 1st Sess. (1985). There have also been subsequent proposals to H.R. 1990. See, e.g., H.R. 379, 100th Cong., 1st Sess. (1987); S. 791, 100th Cong., 1st Sess. (1987); H.R. 902, 101st Cong., 1st Sess. (1989).

42. See Brown, *Overview, supra* note 2, at 1397-98. Substantial parts of the remainder of this Article are adapted, expanded or borrowed from Part V of that article.

Proponents of the new version of design protection⁴³ argue that the elimination of any reference to ornamentality is of no real significance. Consider the views of William S. Thompson, counsel for Caterpillar, Inc., who is, perhaps, the most persistent advocate of this new version. In response to the comments of the Register of Copyrights, Ralph Oman, made after Senate hearings in 1987 on the new bill, to the effect that the elimination of "ornamental" seriously altered the direction of the bill, Mr. Thompson made the extraordinary statement that when the Willis Bill of 1957 defined "ornamental designs" as "attractive, artistic or distinctive," "the base requirement was that the design be distinctive and that was the interpretation given the ornamentality definition." Mr. Thompson further asserted that "[t]he inclusion [by the Register] of the aesthetic criteria deviates from the 30-year history of this legislation. . . . It was never there."⁴⁴ Mr. Thompson's statement that "ornamental" means only "distinctive" is questionable; such a characterization flies in the face of both the dictionary and of common sense.

In the version of the bill which almost became Title II of the 1976 Copyright Revision, "distinctive" was changed to "distinct," a modification that caused the bill to lose both strength and context. Similarly, the definition of "ornamental" was modified to "attractive or distinct in appearance,"⁴⁵ although no reason can be adduced to suppress "attractive" and leave only "distinct" as the controlling term. Professor Fryer, in the only detailed analysis of the new version hitherto published, also attempts to subordinate "attractive" and seemingly is opposed to having any artistic element in the law "similar to the 'ornamental' requirement in design patent law."⁴⁶ Professor Fryer states that "[o]thers consider the 'attractive' and 'distinctive' terms adequate to define any product design that can be recognized."⁴⁷

These very limited views ignore the goal of thirty years of draftsmen, sponsors, and witnesses⁴⁸ to enact a bill that would protect "*ornamental designs of useful articles*." That is what all the bills were called. The word "ornamental" was, one would suppose, chosen *because* it paralleled the design patent language.

It appears that the old bill, that is, the bill which almost became Title II of the 1976 Copyright Revision, simply and neatly took the word "ornamental" from the design patent statute because it had a fairly well-developed

43. The bills before Congress in 1990 were H.R. 902, H.R. 3017, and H.R. 3499, 101st Cong., 1st Sess. (1989). They were alike as to essentials and most details.

44. W.S. Thompson, Comments and Proposed Amendments in Response to the Statement of Register of Copyrights Ralph Oman to Senate Judiciary Subcommittee on Patents, Copyrights and Trademarks, RE: S. 791, May 12, 1987, at 1. This significant document is not part of the 1987 printed Hearings.

45. S. 22, 94th Cong., 2d Sess. tit. II, § 201 (1976), reprinted in *CASES ON COPYRIGHT* 143 (R. Brown & R. Denicola ed. Supp. 1990).

46. Fryer, *Industrial Design*, *supra* note 13, at 217.

47. *Id.*

48. See, e.g., 1960 Hearing, *supra* note 16, at 60-66 (important testimony of Register Fisher in 1960, making innumerable references to "ornamental" designs).

meaning⁴⁹ and was entirely consistent with the aspirations of the supporters of design legislation for more than a generation. The old "ornamental" bill relieved designers of the patent law obligation of establishing inventiveness, and, having accomplished that, it establishes a modest level of novelty. Both the old and new bills⁵⁰ deny protection for designs that are "staple or commonplace, such as a standard geometric figure, familiar symbol, emblem, or motif, or other shape, pattern, or configuration which has become common, prevalent, or ordinary; [and] different from a design excluded . . . above only in insignificant details or in elements which are variants commonly used in the relevant trades."⁵¹

These passages are full of words and phrases which require definition through experience and litigation. While I am not aware of any objection to their appropriateness, it is clear that some advocates of the new bills are trying to legislate something quite different from the focus of earlier efforts. It is, of course, disingenuous to assert that a dozen earlier bills did not mean what they said. There is not, moreover, a firm party line on the extirpation of any pleasing or artistic elements as criteria for protection in the bill. During the 1988 hearing, a witness from General Motors, trying to obtain protection for automobile body parts, explained that the legislation represented "an effort to afford limited but reasonable protection in the United States for investment in creating useful, aesthetic, and innovative designs." Elsewhere in his brief statement, he referred twice to the "artistic aspects" of exterior panels as deserving protection.⁵²

At this point, it may be helpful to illustrate how any design law would confer protection which is not now available (except, in some cases, through trade dress recognition), and then to determine what else the new bills are trying to achieve and whether that goal is appropriate.

As a copyright-like measure, the first accomplishment of all versions would be to wipe out the separability requirement currently imbedded in the copyright law. The lighting fixtures in *Esquire, Inc. v. Ringer*,⁵³ the mannequins in *Carol Barnhart, Inc. v. Economy Cover Corp.*,⁵⁴ the wire wheel hubcaps in *Norris Industries, Inc. v. International Telephone and Telegraph Corp.*,⁵⁵ and the bicycle rack in *Brandir International, Inc. v. Cascade*

49. See Mott, *The Standard of Ornamentality in the United States Design Patent Law*, 48 A.B.A. J. 548, 643 (1962) (note that this two-part article was prepared at a time of intense interest in design legislation).

50. H.R. 1900, 99th Cong., 1st Sess. § 1002(b)-(c) (1985).

51. *Id.*

52. *Protection of Industrial Designs of Useful Articles: Hearing on H.R. 1179 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary*, 100th Cong., 2d Sess. 87 (1988) (statement of Kenneth Enborg, representing the Motor Vehicle Manufacturers Association).

53. 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

54. 773 F.2d 411 (2d Cir. 1980).

55. 696 F.2d 918 (11th Cir.), *cert. denied*, 464 U.S. 818 (1983).

*Pacific Lumber Co.*⁵⁶ all failed the separability test, yet they would easily pass either as ornamental or industrial designs of useful objects.

An inquiry regarding the prospects for failed design patents brings to mind Stiffel's pole lamp in *Sears*⁵⁷ and Day-Brite's fluorescent light fixtures in *Compco*.⁵⁸ They would probably both gain design protection. The tweezers-with-a-light in *Nalbandian*,⁵⁹ however, were, in my view, on the margin of "variants commonly used."⁶⁰

A persisting problem in all versions since 1976 is a shift to the word "distinct" instead of "distinctive." "Distinctive" supplies a rich and relevant context from trademark law. Distinctiveness in the trademark sense, though sufficient, would not be a necessary condition of protection. The bills may properly say that either attractiveness *or* distinctiveness will make a design ornamental. Distinctiveness is a valid criterion because it has positive content. The *American Heritage Dictionary*, in its discussion of the synonyms of "characteristic," states that "distinctive" adds the idea of "an outstanding, worthwhile quality or feature."⁶¹ "Distinctive" is defined as "serving to identify." "Distinct" means only "not identical" or "not similar."⁶²

This is not word-juggling; the apologists for the new bills are attempting to shift its whole emphasis to "distinct," meaning only, I think, "recognizable." They are doing this for a purpose that will shortly be unfolded.

There is one constraint on the generous reach of both the old and new bills that must be mentioned, namely, the exclusion of a design "dictated solely by a utilitarian function of the article that embodies it."⁶³ Functionality is a morass which cannot be circumvented, whether the approach to design is by patent, copyright, trade dress, or the proposed design registration now under examination. Without slogging through the whole morass, it is enough to say that design legislation is more tolerant of incidental protection of functional aspects than is copyright or trade dress law.

Copyright denies protection to the useful aspects of useful articles both on policy and administrative grounds. Utility, as we were firmly instructed in the great case of *Baker v. Selden*,⁶⁴ is the domain of patent law. Monopolies in useful articles are jealously guarded: they are hard to get and are short-lived. Copyrights, on the other hand, are for artists, not artisans.

56. 834 F.2d 1142 (2d Cir. 1987).

57. 376 U.S. 225 (1964).

58. 376 U.S. 234 (1964).

59. 661 F.2d 1214, 1215 (C.C.P.A. 1981).

60. Excluded from protection in H.R. 1990, 99th Cong., 1st Sess. § 1002(c) (1985).

61. AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 226 (1969).

62. *Id.* at 383.

63. H.R. 1990, 99th Cong., 1st Sess. § 1002(d) (1985).

64. 101 U.S. 99 (1880).

They are easy to get and long-lived. Even if the Copyright Office was not barred from the world of utility by history and policy, it could not cope with it. As we observed in *Mazer v. Stein*,⁶⁵ the design door may be opened too wide. The Copyright Office has not only closed it most of the way, but it was deeply involved in the drafting of the old design bill through Arthur Fisher, the outstanding Register who unleashed *Mazer v. Stein*, and his able successors, Abraham Kaminstein, George Cary, and Barbara Ringer,⁶⁶ who each desired a statute for ornamental designs of useful articles because they felt that regular copyright was unsuitable for their protection.

Trade dress law, as we have seen,⁶⁷ is struggling with the concept of functionality. Judges who wield the sharp sword of section 43(a) of the Lanham Act are sensitive (though sometimes less than they should be) about conferring the equivalent of perpetual patents⁶⁸ in the guise of trade dress protection.

One kind of functionality barrier to trade dress protection, though of diminishing recognition, is "aesthetic functionality," which encourages the view that if elements of appearance were "an important ingredient of the commercial success of the product," then they should be open to imitators.⁶⁹ Whatever the merits of this view, it has no place in a design law since pleasing appearance is precisely the subject of design protection.

Consideration must next be given to whether the new design bills sufficiently fend off conferring protection of ordinary functionality—the useful aspects of the useful article. It is necessary to recall that the procedures utilized involve no search or appraisal of inventiveness. Furthermore, the functionality barrier to design protection is a thin one; a design is excluded only if it is "dictated *solely* by a utilitarian function of the article that embodies it."⁷⁰

One must wonder whether many consciously contrived designs do respond solely to utilitarian functions. The Copyright Office was troubled by this query, as evidenced by its March 1987 statement: "In the experience of the Copyright Office when registering applied designs, virtually no designs are *dictated solely* by a utilitarian function."⁷¹

It is noteworthy that design patent law distinguishes between design and function in that courts reject design patents if they are "primarily

65. 347 U.S. 201 (1954).

66. See *Industrial Innovation and Technology Act: Hearing on S. 791 Before the Subcomm. on Patents, Copyrights, and Trademarks of the Senate Comm. on the Judiciary*, 100th Cong., 1st Sess. 23, 25 (1987) [hereinafter *1987 Hearing*] (Letter from Judge Giles Rich to Congressman Robert W. Kastenmeier, Apr. 20, 1976).

67. See *supra* notes 25-35 and accompanying text.

68. There is no durational limit on protection under § 43(a).

69. The quoted phrase is from the leading case on aesthetic functionality, *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952) (floral designs on dinner plates were what attracted customers; no trade dress protection). The "diminished recognition" of this doctrine is canvassed in *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 517-21 (10th Cir. 1987).

70. H.R. 1900, 99th Cong., 1st Sess. § 1002(d) (1985).

71. *1987 Hearing*, *supra* note 66, at 243-44.

functional.”⁷² Although this is not a bright line test, it does offer some degree of guidance. One good example of the application of the “primarily functional” test by the Federal Circuit is found in its recent decision, *Power Controls Corp. v. Hybrinetics, Inc.*⁷³ In that case, the court denied a request for a preliminary injunction by the “inventor” of a plastic container for an electric dimmer switch, finding that the container followed precisely the contours of the switch that it enclosed, and was, therefore, “primarily functional” rather than “primarily ornamental.”⁷⁴

This further instance of needed textual tinkering brings us closer to the promised realistic question: what are the new bills seeking that the old bill did not offer? Based upon statements made at public hearings (although one cannot be confident that there are no hidden agendas) two major movements for protection are apparent. First, there is a forceful movement by the original equipment manufacturers to retain control of the billion-dollar market for automobile “crash parts”⁷⁵—those exterior parts which are easy to crumple and costly to restore. Crash parts have become easy to copy, and the impact of lower-priced competition has led to cries for help.

The other major movement for protection is by Caterpillar regarding the innards of its massive machines. Caterpillar’s able spokesman, William S. Thompson, focused his remarks at the 1987 hearings on a fuel injection nozzle. The only nonfunctional feature of the nozzle is a distinctive “indentation in the casing,” and even that feature is described as being “caused by the manufacturing process.”⁷⁶ Mr. Thompson explained that a competitor, who omits the indentation on the nozzle, or even varies the labeling and packaging, could not be checked even under the new bills. After presenting labeling and packaging variants that concededly infringed upon Caterpillar’s registered trademarks, Mr. Thompson urged the legislators to take appropriate remedial measures to protect the design itself.⁷⁷

Both the crash parts and working parts’ spokespersons are assisted by a quirk in the definition of “useful article.” Both bills state that “[a]n article which normally is a part of a useful article shall be deemed to be a useful article.”⁷⁸ This definition requires clarification, as the Copyright Office

72. *Barofsky v. General Elec. Corp.*, 396 F.2d 340 (9th Cir. 1968), *cert. denied*, 393 U.S. 1031 (1969).

73. 806 F.2d 234 (Fed. Cir. 1986).

74. *Power Controls*, 806 F.2d at 240. Design patents sometimes issue and are then invalidated (for want of ornamentality) on articles that are concealed in use. A vivid example is a septic tank. See *C & M Fiberglass Septic Tanks, Inc. v. T & N Fiberglass Mfg. Co.*, 214 U.S.P.Q. (BNA) 159 (D.S.C. 1981). In such cases the patentee is probably trying to capture some functional attribute.

75. See, e.g., *1987 Hearing*, *supra* note 66, at 90 (testimony of Jean Hiestand, Vice President and General Counsel, State Farm Mutual Automobile Insurance Co.).

76. *1987 Hearing*, *supra* note 66.

77. *Id.* at 39.

78. S. 22, 94th Cong., 2nd Sess. tit. II, § 201(b)(1) (1976) (old bill); H.R. 1900, 99th Cong., 1st Sess. § 1001(b)(1) (1985) (new bill).

suggested, so as to leave no doubt that a part, as well as the whole, must qualify as not entirely functional and as attractive or distinctive.⁷⁹

Another dimension of both bills—the standard-setting procedures—requires further clarification. Section 2 of both the old and new versions of the bill excludes (a) designs not originating from the designer (embracing the copyright concept of originality); (b) staple or commonplace designs; (c) those differing from (b) exclusions only in insignificant details or common variants; and (d) the solely functional exclusion.⁸⁰ Section 3 of the old and new bills then rehabilitates a design excluded under (b) through (d) if it constitutes “a substantial revision, adaptation, or rearrangement of said subject matter.”⁸¹

Professor Fryer makes a brave attempt to explain what section 3 (which has been neglected) might mean. He points out quite sensibly that most designs, like most intellectual creations, will include *elements* which are functional, and others which are commonplace, and that as the designer rearranges and adds to these elements, a protectable design emerges.⁸² While this is certainly so, one must question whether this complexity is necessary. It might suffice for section 2 to simply start out by saying: “Protection under this chapter shall not be available *for elements of a design* which fall within subsections (a) through (d).” In that case, all of section 3 would be dispensable, including its elaborate proviso that a designer without consent cannot copy subject matter protected by copyright or patent. Perhaps there is an inwardness to section 3 beyond this author’s comprehension.

IV. KEEPING DESIGN AND COPYRIGHT SEPARATE: CUMULATION PROBLEMS

If comprehensive design legislation is achieved, it must be asked whether it is appropriate to continue to offer full copyright protection for those designs which can meet the copyright test of separability. The new bills permit copyright and design protection to coexist, thereby, avoiding the three main arguments for comprehensive design legislation.⁸³

79. 1987 Hearing, *supra* note 66, at 245. This concern responds to rather cloudy suggestions made by Thompson, 1987 Hearing, *supra* note 66, and Fryer, *Industrial Design*, *supra* note 13, at 215-19, that parts of useful objects can be protected as long as they are recognizable and even if they are wholly functional. Would registration be required for each part in which protection is claimed? Caterpillar stocks 450,000 parts! See 1987 Hearing, *supra* note 66, at 39.

The definition of useful article in § 101 of the Copyright Act is identical, including the “part of a useful article” sentence, but that definition serves a very different purpose. It is linked to the *restriction* of protection of useful articles that is a central policy of the Copyright Act. Here it is attempted to be turned to enlarging protection.

80. S. 22, 94th Cong., 2d Sess. tit. II, § 202 (1976) (old bill); H.R. 1900, 99th Cong., 1st Sess. § 1002 (1985) (new bill).

81. S. 22, 94th Cong., 2d Sess. tit. II, § 203 (1976) (old bill); H.R. 1900, 99th Cong., 1st Sess. § 1003 (1985) (new bill).

82. Fryer, *Industrial Design*, *supra* note 13, at 217-19.

83. See, e.g., H.R. 3499, 101st Cong., 1st Sess. § 23 (1989).

Argument one asserts that large categories of deserving designs are now unprotected. Argument two is that copyright is both too easy to get and confers too long a term (seventy-five years). Argument three is that, since copyright protection as it exists today only partially serves the public interest in encouraging the creation of pleasing designs, a scheme of encouragement for all pleasing designs ought to suffice for all designers.

All kinds of designers, even if they are not in competition with one another, ought to be treated equally, unless some ground exists for a variation in treatment. No persuasive reason comes to mind why designers of textile fabrics, for example, can get copyright, with its minimal level of required creativity, its casual registration requirements, and its extended duration, while designers of modern lighting fixtures would have to show that their designs are not "staple or commonplace," would have to register to gain protection, and then would enjoy only a ten-year term of protection (which this author believes is quite long enough).

A clean separation should be made by amending the Copyright Act to exclude designs of useful objects. This could be accomplished by cutting off the definition of pictorial, graphic, and sculptural works in section 101 after providing for "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned."⁸⁴ Then, it would be necessary to deal with section 113, which, as it stands today, constitutes an embarrassment to all concerned because of its increasingly outdated reference in subsection (b) to the law "in effect on December 31, 1977."⁸⁵ Section 113 could be modified to state only that "the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in or on the design of a useful article is governed by chapter 10 of this title," assuming that chapter 10 would, at that time, be the appropriate reference.

Certainly, there exist drafting problems with regard to sections 101 and

84. The provision for "works of artistic craftsmanship" first came in by a regulation in 1949. There was only limited experience with the regulation as such before it was swallowed up by the capacious maw of *Mazer*. See Milch, *Protection for Utilitarian Works of Art: The Design Patent Copyright Conundrum*, 10 COLUM. J.L. & ARTS 211 (1986) (extensive consideration of full copyright protection for works of artistic craftsmanship combined with short-term design protection for useful objects).

85. Section 113 provides in part:

(a) Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.

(b) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.

17 U.S.C. § 113 (a)-(b) (1988).

Section 113(c) is a harmless privilege to reproduce pictures of such copyrighted works in advertisements, commentaries, and news reports.

113 which I have not adequately resolved. I hope, however, that an intention to eliminate useful articles altogether from the application of ordinary copyright law is made clear. Indeed, it was the goal of the Copyright Office during its first major push to achieve design legislation in 1960 to eliminate such useful articles from copyright. Interests favoring copyright, notably Disney, with its priceless stable of animated animals, however, mounted an outcry and caused the Copyright Office to make a slow retreat from the principle of keeping the two realms of protection separate.⁸⁶

What the Copyright Office now proposes is not an exclusion of the design of useful articles from copyright but an election. The Copyright Office refers to the old bill as it existed just prior to the fall of 1985, which would amend section 113 to include, among other things, the following language: "Protection under chapters 1 through 8 of this title of a work in which copyright subsists shall terminate with respect to its utilization in useful articles whenever the copyright proprietor has obtained registration of an ornamental design of a useful article embodying said work."⁸⁷

There will always be those who will be timorous about any binding election. It is conceivable that, even after registration, a design might fail because it is unoriginal or commonplace. But, if the design has such flaws, it does not deserve copyright protection. If the designer still believes that he or she has a valid separable copyright, he or she can defend that copyright.

My complaint with the election process is that it is too indulgent. Designs of useful articles should be outside the realm of copyright. All designs should be treated equally.

As for design patent, there appears to have been agreement from the beginning that the achievement of a design patent would terminate a copyright registered design.⁸⁸ With this procedure, there is also a risk: the design patent might be held invalid under circumstances in which a registered design would flourish. The designer does not have to take that risk, however, if he or she will be content with the registered design. It is, of course, entirely speculative whether design patents would or should, continue to exist once a registered design scheme was in place.⁸⁹

V. CONCLUSION

This Article has trudged about in a small corner of the law; it needs no elaborate recapitulation. Although the area is small, it is troubled. The diversity of interests and geography gathered for the 1989 conference evi-

86. The complicated story can be picked out from Reichman, *Design Protection in Copyright Law*, *supra* note 1, at 1187, 1192, 1196, 1200.

87. *1987 Hearing*, *supra* note 66, at 209.

88. H.R. 1900, 99th Cong., 1st Sess. § 1028(b) (1985).

89. In 1966, a Presidential Commission recommended that design patent be abandoned if another form of design protection came into being. U.S. PRESIDENT'S COMMISSION ON THE PATENT SYSTEM, REPORT 12-13 (1966).

dences the need for legislative (or other) solutions to the difficulties experienced by designers. Extensive protection may be the answer for designers, but it is not necessarily in the interest of the consuming public which does not benefit from being forced to purchase a product from a sole source.⁹⁰

There has long been a legislative model which has one vital shortcoming: it cannot win the support of Congress. The last three years of activity have focused on a troubling variation on that model—one that seems to ask more of Congress than it did before. When reviewing all of the verbiage and rationalizations, we discover two new powerful claimants for protection, along with the familiar furniture makers and leather designers: the automobile manufacturers seeking monopolies on the external parts they manufacture, and the heavy equipment people who seek monopolies on the production of their necessary internal parts.

Congressman Kastenmeier, a true statesman in this field, recently suggested a fourfold test that any intellectual property proposal should have to meet.⁹¹ Although all four of his propositions are pertinent to the design problem, one in particular requires special attention. Congressman Kastenmeier suggests that “the proponent of change should present an honest analysis of all the costs and benefits of the proposed legislation.” He explains that “[t]he argument that a particular interest group will make more money and therefore be more creative does not satisfy this threshold standard or the constitutional requirements of the intellectual property clause.”⁹² Adherence to tenets like these is more important than whether the statute uses the word “ornamental.”⁹³

Extensive protection may be the answer for designers, but it is not necessarily in the interest of the consuming public. Nevertheless, when one places the case for limited protection for the ornamental design of useful objects in the context of other limited monopolies in intellectual property, the case is not an unreasonable one.

90. It is worth noting that in the past the Antitrust Division of the Department of Justice routinely recorded its opposition to design legislation.

91. Kastenmeier & Remington, *The Semiconductor Chip Protection Act of 1984: A Swamp or Firm Ground?*, 70 MINN. L. REV. 417, 440 (1985).

92. *Id.* at 441.

93. If “ornamental” has become a disfavored term, and since “industrial” has too strong a suggestion of functionality protection, perhaps a neutral word might be acceptable. Why not call the bill one to provide for protection of the *appearance* design of useful articles?