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### Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-Trips Era

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# INTELLECTUAL PROPERTY IN THE BALANCE: PROPOSALS FOR IMPROVING INDUSTRIAL DESIGN PROTECTION IN THE POST-TRIPS ERA

*Every single thing made by man or woman  
since the beginning of time has been designed.*<sup>1</sup>

## I. INTRODUCTION

Industrial design is the ornamental or aesthetic design of products that are useful for the consumer or manufacturer,<sup>2</sup> such as a chair,<sup>3</sup> a teapot,<sup>4</sup> or even an electric razor.<sup>5</sup> While designers during the Industrial Revolution intended primarily to enhance the performance of machinery,<sup>6</sup> the modern industrial designer is more concerned with marketing and expressing an image that attracts consumers.<sup>7</sup> The advent of new materials and technologies in current society provides industrial designers with more flexibility than ever to create appealing styles for products.<sup>8</sup>

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1. Sir Terence Conran, *Industrial Design from 1851 into the 21st Century*, in INDUSTRIAL DESIGN: REFLECTION OF A CENTURY 8, 8 (Jocelyn de Noblet ed., 1993) [hereinafter INDUSTRIAL DESIGN].

2. See MICHAEL BLAKENEY, TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS: A CONCISE GUIDE TO THE TRIPS AGREEMENT 16 (1996).

3. See Jocelyn de Noblet & Eric Mezil, *The Feltri Armchair*, in INDUSTRIAL DESIGN, *supra* note 1, at 267, 267.

4. See Eric Mezil, *Alessi*, in INDUSTRIAL DESIGN, *supra* note 1, at 265, 265.

5. See Eric Mezil, *The Razor*, in INDUSTRIAL DESIGN, *supra* note 1, at 240, 240.

6. See Jocelyn de Noblet, *Design in Progress*, in INDUSTRIAL DESIGN, *supra* note 1, at 21, 21-22.

7. See Marion Hancock, *Industrial Design Today*, in INDUSTRIAL DESIGN, *supra* note 1, at 268, 272.

8. See de Noblet, *supra* note 6, at 25.

With the increasing expressivity in industrial design has come an increasing need for protection against rote copying, which dilutes the return on investment for designers.<sup>9</sup> Intellectual property laws are the traditional way society provides such protection, thereby encouraging innovation.<sup>10</sup> Intellectual property is principally considered to consist of three<sup>11</sup> general areas of law: patent,<sup>12</sup> copyright,<sup>13</sup> and trademark.<sup>14</sup> This Comment discusses the fourth area of the intellectual property "trilogy," the area of industrial design protection.

Industrial designs consist of articles that are both useful to society and have artistic value,<sup>15</sup> much like works of architecture.<sup>16</sup> The

9. See *id.* at 25-26.

10. See J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2434 (1994).

11. See, e.g., Steven A. Church, Note, *The Weakening of the Presumption of Validity for Design Patents: Continued Confusion Under the Functionality and Matter of Concern Doctrines*, 30 IND. L. REV. 499, 502 n.14 (1997). Church actually finds four areas of law, since he considers trade dress law separate from trademark law. See *id.* However, both trade dress and trademark are protected by the Lanham Act. See *infra* Part V.B.

12. See 35 U.S.C. §§ 1-376 (1994). A patent is granted to one who invents something new, useful, and nonobvious. See *id.* §§ 101-103. In addition to processes, methods, machines, manufacture, and compositions of matter, patents can also be granted for designs. See *id.* § 171.

13. See 17 U.S.C. §§ 101-1101 (1994). The copyright laws constitutionally apply to authors. See U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . ."). Despite this language, the types of works protected by copyright include pictorial or graphic works (art), and sculptural works. See 17 U.S.C. § 106(5). Included in the category of "pictorial, graphic and sculptural works" are useful articles that have artistic features. See *id.* § 101.

14. The Lanham Act, 15 U.S.C. §§ 1051-1127 (1994), is the federal act that codified "trademark law." While a trademark is traditionally considered a name or phrase designating the origin of a company or product, Lanham Act protection is more expansive than common law trademark protection. In addition, the Lanham Act also covers subject matter such as unfair competition through false designation of origin or false description. See *id.* § 1125(a).

15. See *supra* note 2 and accompanying text.

16. Congress, in recognizing the dual nature of architecture, quoted architecture critic Ada Louise Huxtable when considering improved intellectual property protection for architectural works. Congress found that "[t]he key to the art of architecture is the conviction and sensitivity with which technology and function are interpreted aesthetically, in solutions of a practical social pur-

Industrial Designers Society of America defines industrial design as "[t]he professional service of creating and developing concepts and specifications that optimize the function, value, and appearance of products and systems for the mutual benefit of the user and the manufacturer."<sup>17</sup>

Industrial design is an area of intellectual property protected under the recently-signed Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).<sup>18</sup> TRIPs provides its signatory countries with minimum standards for protecting intellectual property rights and limitations on those rights.<sup>19</sup> In enacting legislation implementing TRIPs in the United States, President Clinton stated that existing intellectual property laws sufficiently protect industrial design.<sup>20</sup>

Contrary to President Clinton's contention, none of the major bodies of intellectual property law currently provide adequate protection for industrial designs. Design patent protection fails to protect these goods, for if the goods survive all of the patent law requirements and the patent finally issues, protection will often be too late to be effective for industrial design, due to its short product life-cycle.<sup>21</sup> Trademark and unfair competition laws might provide protection for the "trade dress" of a product,<sup>22</sup> but courts are becoming

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pose." H.R. REP. NO. 101-735, at 18 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6949.

17. Cooper C. Woodring, *A Designer's View on the Scope of Intellectual Property Protection*, 24 AIPLA Q.J. 309, 309 (1996) (quotation omitted).

18. See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31 (1994), arts. 25-26, 33 I.L.M. 1197, 1207 (1994) [hereinafter TRIPs]. TRIPs was adopted in conjunction with the Uruguay Round of Multilateral Trade Negotiations, which also contained thirteen other agreements relating to multilateral trade. See BLAKENEY, *supra* note 2, at 7-8.

19. See Laurence R. Helfer, *Adjudicating Copyright Claims Under the TRIPs Agreement: The Case for a European Human Rights Analogy*, 39 HARV. INT'L L.J. 357, 360 (1998).

20. See *infra* notes 48-52 and accompanying text.

21. See *infra* Part V.A.

22. Trademarks refer to situations where the product's identifier is a word or a logo; trade dress refers to a product's packaging or its own design. See Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471, 477 (1997). Trade dress is protected by section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). See Din-

increasingly hostile towards the use of these laws to protect industrial design.<sup>23</sup> Copyright law, therefore, would be the best place to protect this artistry, but copyright law too is currently deficient in offering predictable protection.<sup>24</sup>

In fact, none of these laws provide consistent protection for industrial designs. Industrial designers are currently faced with an intellectual property void: no matter where they turn—whether it is to copyright, trade dress, or design patent law—their work remains extremely difficult to protect.

There is a perception that copyright laws protect industrial design; however, the protection comes with a “catch.” That catch is the requirement of conceptual separability.<sup>25</sup> Because copyright law protects only the aesthetic and creative expression of authors, the protected features of design—the parts that would be created by an artist or author—must be physically or conceptually separable from the product’s functional features.<sup>26</sup> This conceptual separability requirement has degenerated into a multitude of inconsistent tests that provide only limited and inadequate protection for industrial design.<sup>27</sup>

When Congress recognized that conceptual separability was disastrous for protecting architecture, it removed the conceptual separability requirement for architecture by modifying the copyright laws, making architecture protection easier.<sup>28</sup> While the substantive nature of this new architecture copyright protection has not been extensively tested in the courts, its policies, such as protecting the aesthetic features of original architecture, are consistent with the policies underlying industrial design protection.<sup>29</sup> Given these similar policies, one proposal to improve industrial design intellectual property laws is to expand the newly enacted architectural copyright laws to include industrial design protection.<sup>30</sup>

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woodie, 75 N.C. L. REV. at 475-76 & n.14.

23. See *infra* Part V.B.

24. See *infra* Part IV.

25. See *infra* Part IV.

26. See *infra* Part IV.

27. See *infra* Part IV.B.

28. See *infra* Part VI.

29. See *infra* notes 271-72 and accompanying text.

30. See *infra* Part VII.A.

Before considering such a proposal, however, one should first consider the need for a balanced approach in drafting intellectual property law. A desired balance weighs access to prior works against protection for new works as an incentive for their creation. No matter what approach lawmakers take to improve industrial design protection, the desired balance should always be kept in mind.<sup>31</sup> Otherwise, the proposal to expand architecture copyright law to include industrial design will encounter problems because the monopoly power inherent in the copyright laws<sup>32</sup> could outweigh the benefits to designers.

Congress may need to look to other solutions. Another proposal might be to carve out a fourth area of intellectual property law specifically for design protection.<sup>33</sup> This new design protection law could be tailored to achieve the appropriate balance between stimulation of new designs through increased protection and limitations to check monopoly power. Whether the architecture copyright law is expanded or a new design law is created, increasing industrial design protection will benefit society by promoting creativity and innovation in product design while preventing consumer confusion.

This Comment examines the failure of intellectual property protection for industrial design and proposes solutions within and outside of copyright law. Part II explores the TRIPs Agreement, and its underlying goal of protecting all forms of intellectual property, including industrial design, while maintaining the balance appropriate to intellectual property laws. Part III examines the constitutional and statutory background of copyright law and summarizes the attempted solutions of the 1976 Copyright Act. Part IV addresses how copyright law treats industrial design, which it calls "useful articles," focusing on the various conflicting tests for conceptual separability. Part V surveys the alternative modes of protection, namely design patent and trade dress, and concludes that these are insufficient due to the uncertainty of design patent enforcement and the hostility

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31. The exact wording of laws necessary to achieve this balance is beyond the scope of this article. However, TRIPs appears to keep the balance in mind. See *infra* Part II.

32. See *infra* note 277 and accompanying text.

33. See *infra* Part VII.B.

toward product configuration trade dress.<sup>34</sup> Part VI examines the copyright protection for architecture, discussing the motivations of Congress and the policies surrounding this new law. Part VII discusses alternative methods of protecting industrial design, expanding architecture copyright law and creating new *sui generis*<sup>35</sup> protection. Finally, this Comment concludes that whether Congress chooses to borrow from the architectural copyright standards or create a fourth area of design protection, society will benefit from increased industrial design protection.

## II. INDUSTRIAL DESIGN IN THE TRIPS AGREEMENT

TRIPS is one subsection of GATT, the General Agreement on Tariffs and Trade, adopted as part of the Uruguay Round of multilateral trade negotiations after close to seven years of talks.<sup>36</sup> TRIPS, Annex 1C of GATT, consists of 73 articles which outline:

a detailed code of rules setting standards for the availability, scope and use of intellectual property rights, including patents, copyright, the rights of performers and producers of sound recordings, trademarks, geographical indications including appellations of origin, industrial designs, layout designs of integrated circuits, protection of trade secrets, and control of anti-competitive practices in intellectual property.<sup>37</sup>

After minor technical revisions,<sup>38</sup> TRIPS was signed in Marrakesh, Morocco, on April 15, 1994.<sup>39</sup> Over one hundred countries signed the Final Act.<sup>40</sup>

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34. See *infra* note 190 and accompanying text (defining product configuration trade dress).

35. *Sui generis* means "[o]f its own kind or class." BLACK'S LAW DICTIONARY 1434 (6th ed. 1990).

36. See Amelia Porges, *Introductory Note, in* General Agreement on Tariffs and Trade - Multilateral Trade Negotiations (the Uruguay Round): Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Dec. 15, 1993, 33 I.L.M. 1, 1-2 (1994).

37. *Id.* at 4.

38. See Amelia Porges, *Introductory Note, in* General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Apr. 15, 1994, 33 I.L.M. 1125, 1128 (1994).

The TRIPs Agreement begins with a declaration of the purposes of the new treaty.<sup>41</sup> On one hand, the signatory countries recognized the need for "effective and appropriate means for the enforcement of trade-related intellectual property rights."<sup>42</sup> On the other hand, the members also recognized that they must "ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade."<sup>43</sup> TRIPs, therefore, strikes a balance between the stimulation of intellectual property through added protection and the necessary guarantee of a free market.

This balance is also evident within the TRIPs Industrial Design provisions themselves. For example, TRIPs allows industrial designers to "prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design."<sup>44</sup> Such industrial design protection is clearly a broad new right for intellectual property owners. TRIPs tempers this new right, however, with limitations: a limited duration of ten years of protection,<sup>45</sup> an originality requirement,<sup>46</sup> and an option that "[m]embers may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations."<sup>47</sup> Having limitations such as these is key to achieving the appropriate balance between protection and competition.

TRIPs also addressed implementation, providing that:

Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of

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39. *See id.* at 1125.

40. *See id.* at 1131.

41. *See* TRIPs Prologue.

42. *Id.*

43. *Id.*

44. *Id.* art. 26, § 1.

45. *See id.* art. 26, § 3.

46. *See id.* art. 25, § 1.

47. *Id.*



implementing the provisions of this Agreement within their own legal system and practice.<sup>48</sup>

In essence, TRIPs has integrated the intellectual property laws of most major countries into a single international legal scheme.

The United States enacted changes to its intellectual property laws to conform with TRIPs in a law passed on December 8, 1994.<sup>49</sup> In presenting the TRIPs Agreement to Congress for consideration, President Clinton submitted a Statement of Administrative Action,<sup>50</sup> which detailed how each article of TRIPs either was already addressed by existing law, or needed to be addressed by Congress.<sup>51</sup> The Statement of Administrative Action provided that TRIPs "will also better protect . . . industrial designs."<sup>52</sup> But in determining which changes were necessary to implement this improved protection in the United States, the Statement concluded that "[p]rotection currently available under U.S. patent and copyright law meets the requirements of these [TRIPs industrial design] articles."<sup>53</sup> Determining the accuracy of this conclusion requires a detailed examination of existing United States intellectual property law, to see if each area of law complies with TRIPs by protecting industrial design. Most of the recent legislation involving industrial design has centered around copyright law.<sup>54</sup> Therefore, it is appropriate to examine this area of the law first.

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48. *Id.* art. 1, § 1.

49. *See* Uruguay Round Agreements Act, Pub. L. No. 103-465, tit. V, 108 Stat. 4809, 4973-90 (1994) (codified as amended in scattered sections of 15 U.S.C., 17 U.S.C., and 35 U.S.C.).

50. The report was submitted on September 27, 1994. *See* Letter from President William J. Clinton to the Congress of the United States (Sept. 27, 1994), in MESSAGE FROM THE PRESIDENT OF THE UNITED STATES TRANSMITTING THE URUGUAY ROUND TABLE AGREEMENTS, TEXTS OF AGREEMENTS IMPLEMENTING BILL, STATEMENT OF ADMINISTRATIVE ACTION AND REQUIRED SUPPORTING STATEMENTS 1-2 (1994) [hereinafter MESSAGE TRANSMITTING URUGUAY ROUND TABLE AGREEMENTS].

51. *See* THE URUGUAY ROUND AGREEMENTS ACT: STATEMENT OF ADMINISTRATIVE ACTION, reprinted in MESSAGE TRANSMITTING URUGUAY ROUND TABLE AGREEMENTS, *supra* note 50, at 656 [hereinafter STATEMENT OF ADMINISTRATIVE ACTION].

52. *Id.* at 1154.

53. *Id.* at 985.

54. *See infra* Parts VI, VII.B.

### III. BACKGROUND—HOW COPYRIGHT CAME TO “PROTECT” INDUSTRIAL DESIGN

#### A. *The Early Years of Copyright Protection*

Copyright protection traces its roots to when Queen Mary of England granted protection to some of the first book printers in 1557.<sup>55</sup> While early English copyright cases centered around book publishing, maps and charts were also considered proper subjects of copyright protection.<sup>56</sup>

The United States of America provided constitutional protection for copyright from its inception,<sup>57</sup> and enacted its first Copyright Act in 1790 to protect books, maps, and charts.<sup>58</sup> This protection was gradually expanded between 1802 and 1870 to include prints, musical compositions, photographs, and three-dimensional works of fine art.<sup>59</sup> The United States Supreme Court, in two separate cases, explained that the Constitution's inclusion of the terms “author” and “writer” did not limit these words to their traditional definitions; thus the Court gave photographers and engravers protection as well.<sup>60</sup> Of particular interest was Justice Holmes' conclusion in *Bleistein v. Donaldson Lithographing Co.* that the use of a work of art for a commercial purpose did not prevent copyright protection.<sup>61</sup> This conclusion was greatly significant because it permitted even the earliest designers and artists to receive copyright protection for their commercial artistic works.

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55. See BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 3 (1967).

56. See *id.* at 16.

57. See *supra* note 13.

58. See Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1802); Shira Perlmuter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y USA 339, 341 (1990).

59. See Sally M. Donahue, Comment, *The Copyrightability of Useful Articles: The Second Circuit's Resistance to Conceptual Separability*, 6 Touro L. REV. 327, 329 (1990).

60. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250-51 (1903); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884).

61. See *Bleistein*, 188 U.S. at 251; Donahue, *supra* note 59, at 330.

In reaction to these two cases, the drafters of the 1909 Copyright Act afforded protection to all "works of art,"<sup>62</sup> which the Court interpreted to include the aesthetic elements of copyrighted design works.<sup>63</sup> This ruling opened the door to Copyright Office protection for such diverse objects as "clocks, candlesticks, inkstands, door knockers, ashtrays and salt shakers."<sup>64</sup>

*B. The Supreme Court Reaffirms Protection in Mazer v. Stein*

In *Mazer v. Stein*, the Supreme Court confronted the issue of whether a lamp manufacturer could copyright a base that doubled as an artistic work, a statuette of a female dancer.<sup>65</sup> The petitioner urged the Court to limit copyright protection for useful articles in light of available design patent protection.<sup>66</sup> The Court rejected this argument, and distinguished between the separate purposes of copyright and patent laws:

Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.

Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.<sup>67</sup>

The Court found "nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration."<sup>68</sup> Furthermore, the Court failed to offer any guidance as to when elements of a useful article are copyrightable.<sup>69</sup>

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62. Copyright Act of 1909, ch. 320, § 5(g), 35 Stat. 1075, 1077 (repealed 1976).

63. See *Mazer v. Stein*, 347 U.S. 201, 212-13 (1954) ("[I]t is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts.").

64. Perlmutter, *supra* note 58, at 342 (citing *Mazer*, 347 U.S. at 219, 221 (Douglas, J., dissenting)).

65. See 347 U.S. at 204-05.

66. See *id.* at 215.

67. *Id.* at 217 (citations omitted); see also Perlmutter, *supra* note 58, at 345 (discussing *Mazer*).

68. *Mazer*, 347 U.S. at 218.

69. See Perlmutter, *supra* note 58, at 345; Donahue, *supra* note 59, at 332-

### C. *The Copyright Act of 1976*

After *Mazer*, the Copyright Office tinkered with its regulations in an effort to satisfy the Supreme Court's grant of protection to useful articles.<sup>70</sup> After a few attempts, the 1960 version of the regulation read as follows:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates 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, such features will be eligible for registration.<sup>71</sup>

By focusing on artistic features that can be identified separately, the 1960 regulation provided the first test that allowed protection for industrial design.

The 1976 Copyright Act incorporated the Copyright Office regulation in its definition of "[p]ictorial, graphic, and sculptural works."<sup>72</sup> In adopting this test, the House Committee report noted that "[u]nless the shape of . . . [the] industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill."<sup>73</sup> Thus were born the dual tests of physical separability and conceptual separability. Physical separability is somewhat easy for courts to understand—the functional part of an object must be physically detachable from the artistic part.<sup>74</sup>

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70. See Perlmuter, *supra* note 58, at 345-46.

71. 37 C.F.R. § 202.10(c) (1960); *see also* Perlmuter, *supra* note 58, at 346 (explaining history of regulation).

72. 17 U.S.C. § 101.

73. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668.

74. *See, e.g.,* Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc., 832 F. Supp. 1378, 1392 (C.D. Cal. 1993) (finding the artistic labeling of a perfume box physically separable from the utilitarian aspects of the perfume itself, thereby avoiding a conceptual separability analysis); *see also* 1 PAUL GOLDSTEIN, COPYRIGHT § 2.5.3, at 2:64 (2d ed. 1998) (discussing physical separability of a miniature eagle sculpture welded to an outdoor lighting fix-

Conceptual separability, on the other hand, is a more difficult idea that has become the subject of much discussion.<sup>75</sup>

Before dissecting conceptual separability, however, it is important to note that Congress did not stop at merely incorporating the 1960 Copyright Office regulations. Congress also changed the language in 17 U.S.C. § 101<sup>76</sup> by redefining which articles would trigger application of the conceptual separability test. Whereas the test previously applied only to works with a "solely utilitarian function," it now governs any design with "*an* intrinsic utilitarian function."<sup>77</sup> This severely limits protection by subjecting "virtually all 'ornamental designs of useful articles' . . . to the [conceptual] separability test."<sup>78</sup>

Determining what items are useful can be a difficult task for district court judges. If the word "useful" is construed broadly, stuffed animals and other toys might fail to receive copyright protection, as these items are useful as entertainment for small children.<sup>79</sup> Some judges that do follow a broad definition of "useful" find costumes and other works of fashion very difficult to protect under copyright laws due to the utility of these garments in clothing the body; once this utility conclusion is reached, a finding of conceptual separability is practically impossible.<sup>80</sup>

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ture; remove the useful lighting fixture and the eagle sculpture remains intact).

75. See, e.g., Edward A. Nolfi, Annotation, *Copyrightability of Sculptural Works*, 83 A.L.R. FED. 845 (1987) (discussing cases that interpret the 1976 Act and its conceptual separability requirement).

76. 17 U.S.C. § 101 is the section of the Copyright Act that provides general definitions of terms used in the Act.

77. 17 U.S.C. § 101 (emphasis added); see also H.R. REP. NO. 94-1476, at 54-55 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667-68 (proposing the conceptual separability test).

78. Keith Aoki, *Contradiction and Context in American Copyright Law*, 9 CARDOZO ARTS & ENT. L.J. 303, 324 (1991). To illustrate how restrictive this change was, note that it would have denied copyright protection to one of the most-discussed objects of industrial design ever copyrighted—the pencil sharpener shaped like an antique telephone. See *Ted Arnold, Ltd. v. Silvercraft Co.*, 259 F. Supp. 733, 736 (S.D.N.Y. 1966) (noting that, while the article had a function, being a pencil sharpener was not its sole function).

79. *But see* *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983) (rejecting the contention that a toy airplane is "useful").

80. See, e.g., *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 853 F. Supp. 319, 324 (N.D. Cal. 1994), *aff'd in part, vacated in*

The reason Congress narrowed protection for useful articles perhaps lies with the separate protection Congress planned to give works of industrial design in Title II of the Copyright Act of 1976.<sup>81</sup> Title II would have granted a shorter term of protection to industrial design without other significant limitations.<sup>82</sup> But Congress deleted Title II, partially due to concerns that the law extended copyright protection into areas that were not constitutionally permitted.<sup>83</sup> The Copyright Office itself opposed Title II, arguing to the District of Columbia Circuit Court of Appeals that it feared creating a new monopoly for industrial design, despite the limited nature<sup>84</sup> of the so-called new monopoly.<sup>85</sup> Congress dropped what appeared to be a viable plan for protecting industrial design, instead leaving courts to the confusing analysis of useful articles and conceptual separability.

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part on other grounds, 122 F.3d 1211 (9th Cir. 1997) (refusing copyright protection for costumes of "Toucan Sam" and the "Pillsbury Doughboy"); S. Priya Bharathi, Comment, *There is More than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1678 (1996) (discussing the failure of copyright law's useful article doctrine to protect fashion works). To further illustrate the difficulty courts have with conceptual separability and useful articles, compare *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348 (S.D. Cal. 1988), upholding copyright protection for costumes, with *Whimsicality, Inc. v. Rubie's Costume Co.*, 721 F. Supp. 1566, 1576 (E.D.N.Y. 1988), *aff'd in part, vacated in part on other grounds*, 891 F.2d 452 (2d Cir. 1989), denying copyright protection for costumes virtually identical to those in *National Theme Productions*.

81. See H.R. CONF. REP. NO. 94-1733, at 82 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810, 5823.

82. Title II would have, in fact, granted ten years total protection, excluding only "commonplace" shapes. See J.H. 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, 1252-55.

83. See Perlmutter, *supra* note 58, at 349 (citing H.R. REP. NO. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5663).

84. Title II design protection would have limited the term of copyright for design works to ten years. See *id.* at 349 n.43.

85. See *Esquire v. Ringer*, 591 F.2d 796, 801 (D.C. Cir. 1978). The court upheld the rejection by the Copyright Office of a copyright application for artistically designed lamps. The head of the Copyright Office at that time, also known as the Register of Copyrights, was Barbara Ringer. See *id.* at 806; see also Aoki, *supra* note 78, at 325-29 (discussing the *Esquire* argument and decision).

#### IV. THE CONFUSION OF THE USEFUL ARTICLES AND CONCEPTUAL SEPARABILITY TESTS

The industrial designer today, facing the daunting task of seeking protection under copyright law, must convince a judge that either the item to be protected is not useful or the useful part of the item is separable from the artistic part. This Section explores the major tests that have evolved in the utility and separability areas, arguing that none of the tests provides a clear, predictable path for protection of industrial design.

##### *A. The Importance of the Useful Article Analysis*

Non-useful articles are granted copyright protection as pictorial, graphical, or sculptural works.<sup>86</sup> If an article has "an intrinsic utilitarian function," however, it is a useful article which can only be copyrighted if its artistic features are capable of being identified separately from its useful features.<sup>87</sup> While it appears that the best way to avoid the conceptual separability problem is to argue against the usefulness of an article, that argument may be difficult to accept because practically everything is useful.<sup>88</sup> One commentator has pointed out that some subject matter is copyrightable despite the fact that it is useful in some definition of the word: "Usefulness per se, however, is not necessarily a bar to copyrightability. Computer programs are both useful and protected. Traditional art forms are also useful; art and music therapy are not modern upstarts. Aristotle encouraged drama and music for their cathartic effects. The Stoics justified poetry by its moral effects."<sup>89</sup> In fact, this commentator even noted, without elaboration, that Congress had already made an exception by providing protection for architectural works separate from other useful articles.<sup>90</sup>

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86. See 17 U.S.C. § 101 (1994).

87. *Id.*

88. Copyright law actually does limit what is considered to be useful—a "useful article" is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.*

89. Malla Pollack, Comment, *Intellectual Property Protection for the Creative Chef, or How to Copyright a Cake: A Modest Proposal*, 12 CARDOZO L. REV. 1477, 1487-88 (1991).

90. See *id.* at 1488. Pollack proposed similar separate protection for "the

Unfortunately, examination of case law dealing with useful articles does not reveal any consistency as to what constitutes "useful." While some courts call costumes useful and deny copyright protection,<sup>91</sup> the Third Circuit found that animal nose masks were *not* useful because their use was to create humor, which was not a use encompassed within the statutory definition of 17 U.S.C. § 101.<sup>92</sup> Other courts have held that a sculpture-like article, such as a mannequin, is not a useful article when its only use is to portray its appearance.<sup>93</sup> Some courts, however, *have* found mannequins to be useful due to their function in displaying clothes.<sup>94</sup>

In light of the ambiguity over the utility test, designers seeking copyright protection should try to assert that their designs are not useful articles, for that avoids the conceptual separability test. Should the designer run into utility logic like that found in cases like *Carol Barnhart*, however, there may still be a need to plead conceptual separability.<sup>95</sup>

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edible arts." *Id.* at 1486.

91. See *supra* note 80 and accompanying text.

92. See *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990); see also *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983) (holding that a toy airplane is not a useful article even though it is used "to be played with and enjoyed").

93. See, e.g., *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 494 (4th Cir. 1996) (analyzing deer mannequins and finding them not useful).

94. See, e.g., *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (noting that parties conceded that human mannequins were useful). It is understandably easier to argue that mannequins or clothing would be useful articles than it is to argue the same for toys or stuffed animals.

95. See, e.g., *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284-85 (10th Cir. 1996). The Tenth Circuit analyzed whether the toy dolls in question were copyrightable, and quoted from 17 U.S.C. § 101, noting that the first part of the statutory language does not give outright copyright protection to works that have utilitarian functions. See *id.* at 1287. However, the court applied the statute and improperly considered only the first clause of the quoted sentence. The court failed to note the latter clause, which protects useful articles if they contain artistic features that are physically or conceptually separable. See 17 U.S.C. § 101. In fact, the court never discussed whether the *toy dolls* in question were indeed useful. See *Country Kids*, 77 F.3d at 1287.

Not all courts make this mistake. In a recent case involving the design of a ring, the district court judge performed the analysis correctly, declining a defendant's invitation to analyze conceptual separability, in light of the fact that the piece of jewelry in question was not a useful article. See *Donald Bruce &*



*B. The Many Tests of Conceptual Separability*

In the seminal Supreme Court decision of *Mazer v. Stein*,<sup>96</sup> the Court could find "nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration."<sup>97</sup> *Mazer* should have put to rest the argument about *whether* an item of industrial design can receive copyright protection. Yet, the debate over whether industrial design was properly protected by copyright raged on for years. Many courts followed *Mazer* and protected industrial design;<sup>98</sup> still, some courts felt that industrial design copyright protection was impermissible.<sup>99</sup>

Congress, in revising the Copyright statute, attempted to clear up the confusion by noting that pictorial, graphic, and sculptural works that were also useful articles could be copyrighted as long as the "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."<sup>100</sup> The legislative history of the 1976 Copyright Act "clarified" this section as requiring separability, either "physically or conceptually."<sup>101</sup>

As a preliminary matter, there are very few cases involving physical separability;<sup>102</sup> conceptual separability is where there is much debate. But by setting forth a test such as conceptual separability without providing any guidance, Congress opened the flood

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Co. v. B.H. Multi Com Corp., 964 F. Supp. 265, 267 (N.D. Ill. 1997).

96. 347 U.S. 201 (1954).

97. *Id.* at 218.

98. *See, e.g.*, *Ted Arnold Ltd. v. Silvercraft Co.*, 259 F. Supp. 733, 736 (S.D.N.Y. 1966) (finding separate consumer desires for artistic telephone and utilitarian pencil sharpener and therefore finding copyrightability in light of *Mazer*).

99. *See, e.g.*, *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800-01, 805 (D.C. Cir. 1978) (disparaging copyright of industrial design). Although *Esquire* was a post-1976 Act case, it applied pre-1976 Act law. *See id.* at 799 n.8.

100. 17 U.S.C. § 101 (1994).

101. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668.

102. *But see* *Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc.*, 832 F. Supp. 1378, 1392 (C.D. Cal. 1993) (finding utilitarian box design physically separable from aesthetic perfume).

gates to a wide variety of interpretations. These judicial interpretations have led one commentator to declare that conceptual separability is "an increasingly unintelligible body of law."<sup>103</sup> An examination of five tests developed by various courts supports this opinion.

### 1. The *Kieselstein-Cord* "primary-subsidary" test

The first major opinion to discuss conceptual separability originated in the Second Circuit in *Kieselstein-Cord v. Accessories By Pearl, Inc.*<sup>104</sup> Barry Kieselstein-Cord created artistic belt buckles that won him many design awards; even the prestigious Metropolitan Museum of Art accepted the buckles for its permanent collection.<sup>105</sup> The defendant made unauthorized copies and urged the Second Circuit to invalidate the copyright.<sup>106</sup> Judge Oakes examined the statute, legislative history, and various scholarly publications and concluded that the buckle design passed the conceptual separability test because "[t]he primary ornamental aspect of the . . . buckles is conceptually separable from their subsidiary utilitarian function."<sup>107</sup>

Many courts have attempted to follow the *Kieselstein-Cord* test by considering the primary and subsidiary purposes of a piece of industrial design. However, these attempts have been inadequate because the courts have not specified exactly what is a primary or subsidiary purpose.<sup>108</sup> In fact, courts and commentators have criticized this test as being beyond anything found in the statute or legislative history.<sup>109</sup> For example, what if the ornamental and utilitarian

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103. Aoki, *supra* note 78, at 383-84.

104. 632 F.2d 989 (2d Cir. 1980).

105. *See id.* at 991.

106. *See id.*

107. *Id.* at 993.

108. *See, e.g.,* Act Young Imports, Inc. v. B and E Sales Co., 673 F. Supp. 672, 673 (S.D.N.Y. 1987) (citing *Kieselstein-Cord* to find backpacks shaped like animals conceptually separable, but not analyzing primary-subsidary aspects); Trans-World Mfg. Corp. v. Al Nyman & Sons, 95 F.R.D. 95, 98 (D. Del. 1982) (finding *Kieselstein-Cord* "well-reasoned and persuasive" in holding eyeglass display case artistic design conceptually separable from utilitarian function, without analyzing primary-subsidary aspects).

109. *See* Perlmutter, *supra* note 58, at 359-60; *see also* Norris Indus. v. International Tel. & Tel. Corp., 696 F.2d 918, 923-24 (11th Cir. 1983) (finding the wavy pattern of a wire-spoked wheel cover to be primarily useful). Some have criticized the application of the primary-subsidary test in *Norris Indus-*

aspects were equal?<sup>110</sup> While Judge Oakes proclaimed *Kieselstein-Cord* to be "on a razor's edge of copyright law,"<sup>111</sup> Congress probably envisioned the conceptual separability test to be easier than the primary-subsidary test proposed by Judge Oakes.

## 2. The *Carol Barnhart* "inextricably intertwined" test

Five years after *Kieselstein-Cord*, the Second Circuit had another opportunity to discuss conceptual separability in *Carol Barnhart Inc. v. Economy Cover Corp.*<sup>112</sup> This case involved copied mannequins of partial human torsos.<sup>113</sup> The Second Circuit, in a two-to-one decision, denied copyright protection because the "aesthetic and artistic features of the Barnhart forms are inseparable from the forms' use as utilitarian articles."<sup>114</sup> The court distinguished the buckles of *Kieselstein-Cord* as having artistic design "wholly unnecessary to performance of the utilitarian function."<sup>115</sup> The court compared the buckles with the mannequin torsos and found the torsos' artistic elements "inextricably intertwined" with the torsos' utilitarian features, and therefore not copyrightable.<sup>116</sup>

The *Carol Barnhart* test borders on the ludicrous. As one critic of the decision observed, "[a]ny artistic features that are . . . inextricably intertwined with the object's utilitarian function will almost inevitably be physically inseparable."<sup>117</sup> This test makes conceptual separability such a high hurdle for industrial design, that it would protect very few, if any, works.<sup>118</sup>

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*tries* as inconsistent with Supreme Court warnings that judges should not be arbiters of artistic taste; these commentators felt that *Norris Industries* was beyond the scope of the Copyright Act. See Donahue, *supra* note 59, at 342 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903) (Holmes, J.)).

110. See Perlmutter, *supra* note 58, at 359.

111. *Kieselstein-Cord*, 632 F.2d at 990.

112. 773 F.2d 411 (2d Cir. 1985).

113. See *id.* at 412-13.

114. *Id.* at 418.

115. *Id.* at 419.

116. *Id.*

117. Perlmutter, *supra* note 58, at 362.

118. See Aoki, *supra* note 78, at 340.

### 3. The Judge Newman/Copyright Office displacement test

Judge Newman dissented in *Carol Barnhart* in a thorough opinion that analyzed all of the then-existing conceptual separability tests.<sup>119</sup> He examined the previous tests for conceptual separability in the majority opinion and in *Kieselstein-Cord*. Judge Newman rejected these tests because they misconstrued the word *conceptual*, which he defined as occurring "in the 'mind's eye' of the beholder."<sup>120</sup> Judge Newman phrased his own conceptual separability test as follows:

I believe we would be more faithful to the Congressional scheme if we insisted that a concept, such as that of a work of art, is "separate" from the concept of an article's utilitarian function only when the non-utilitarian concept can be entertained in the mind of the ordinary observer without at the same time contemplating the utilitarian function.<sup>121</sup>

This means that Judge Newman would require "temporal displacement" of the aesthetic and utilitarian features of a useful article.<sup>122</sup> While this test is perhaps truer to the definition of conceptual, it obviously is not a simple task to determine what is in "the mind of the ordinary observer."

Coincidentally, the Copyright Office issued regulations<sup>123</sup> at about the same time as the *Carol Barnhart* decision. The Copyright Office defines conceptual separability as existing when "[t]he artistic features and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article."<sup>124</sup> This test is, for all practical purposes, the same as Judge Newman's temporal displacement test.

Perhaps the biggest criticism of the Judge Newman/Copyright Office test came from the *Carol Barnhart* majority, who called it a

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119. *Carol Barnhart*, 773 F.2d at 419-24 (Newman, J., dissenting).

120. *Id.* at 422 (Newman, J., dissenting).

121. *Id.* at 423 (Newman, J., dissenting).

122. See WILLIAM F. PATRY, *LATMAN'S THE COPYRIGHT LAW* 44 (6th ed. 1986).

123. LIBRARY OF CONGRESS, *COMPENDIUM OF COPYRIGHT OFFICE PRACTICES* (2d ed. 1984).

124. *Id.* § 505.03, at 500-11.

"bottomless pit."<sup>125</sup> The majority criticized the displacement test as being "a standard so ethereal as to amount to a 'non-test' that would be extremely difficult, if not impossible, to administer or apply."<sup>126</sup> For example, consider a hammer with a uniquely shaped handle. One could always imagine the handle as a simple wooden stick; the artistic part could always appear "in the mind's eye" to be separate.

#### 4. The Denicola/*Brandir* artistic judgment test

Professor Robert Denicola surveyed the different tests for conceptual separability and concluded that none of the tests truly captured the purpose of separability—to divide copyrightable art from uncopyrightable industrial design.<sup>127</sup> Denicola stated that "[t]he dominant feature of modern industrial design is the merger of aesthetic and utilitarian concerns."<sup>128</sup> He proposed a sliding scale between art and utility; the more a work is influenced by utilitarian considerations, the less it can be copyrighted.<sup>129</sup>

The Second Circuit adopted Professor Denicola's test in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*<sup>130</sup> The opinion, written by Judge Oakes of *Kieselstein-Cord* fame, restated the Denicola test:

[I]f design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.<sup>131</sup>

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125. *Carol Barnhart*, 773 F.2d at 419 n.5.

126. *Id.*

127. See Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 738 (1983).

128. *Id.* at 739.

129. See *id.* at 741.

130. 834 F.2d 1142 (2d Cir. 1987).

131. *Id.* at 1145.

The Second Circuit then applied the test, finding that the aesthetic aspects of the bicycle rack were one and the same as the functional aspects, and found no conceptual separability.<sup>132</sup>

Two criticisms of the Second Circuit's restatement of the Denicola test are apparent. First, Judge Oakes seemed to require that industrial design be a result of either "artistic judgment" or "functional influences"; Professor Denicola looked at the "extent to which the work reflects artistic expression."<sup>133</sup> In essence, Professor Denicola's approach was more of a sliding scale, lessening the influence of functionality and therefore increasing copyrightability with more artistic influence.<sup>134</sup>

Second, while the test sounds good, it is itself conceptually difficult to apply—the test requires judicial analysis of artistic judgment.<sup>135</sup> For example, there have been two post-*Brandir* copyright cases involving costumes, like those worn during Halloween. In *Whimsicality, Inc. v. Rubie's Costume Co.*,<sup>136</sup> the Second Circuit cited *Brandir* to find that the artistic and utilitarian functions of clothing merge, and denied copyright protection.<sup>137</sup> In *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*,<sup>138</sup> however, a district court in the Ninth Circuit cited the same portion of *Brandir* as the Second Circuit, but concluded the opposite—that the function of costumes has little to do with their design—and granted copyright protection.<sup>139</sup> The Southern District of California court rested its

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132. *See id.* at 1146-47.

133. Denicola, *supra* note 127, at 741; *see also id.* at 746-47.

134. *See* Perlmutter, *supra* note 58, at 368.

135. Perhaps that is why at least one appellate court merely recited the *Brandir* test and purported to follow it, yet omitted the part about analyzing artistic judgment. *See* *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 494 (4th Cir. 1996).

136. 891 F.2d 452 (2d Cir. 1989).

137. *See id.* at 455. To illustrate how the Second Circuit position in *Whimsicality* does not make sense, in a later case the court held that while "clothes are not copyrightable[,] . . . [i]n contrast, fabric designs, such as the artwork on Knitwaves' sweaters, are considered 'writings' for purposes of copyright law and are accordingly protectible." *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (citations omitted). In essence, despite *Whimsicality*, it seems that clothes *are* copyrightable in the Second Circuit.

138. 696 F. Supp. 1348 (S.D. Cal. 1988).

139. *See id.* at 1353-54.

conclusion on a determination that "the Second Circuit improperly applied the Denicola test . . . [which] will cause decisions to turn upon 'largely fortuitous circumstances.'"<sup>140</sup> Those who desire protection for works of fashion prefer the *National Theme Productions* test, of course, but all industrial designers plead for a more consistent standard to apply.<sup>141</sup>

One further criticism of *Brandir* is its potentially inconsistent application.<sup>142</sup> This inconsistency directly stems from the requirement that judges decide what the intent of the artist is—how the artist used artistic judgment. This analysis leads to a wide variation between judges as to whether a designer had artistic intent or not. Judicial analysis of artistic intent requires judges to "interject their own subjective standards . . . . Copyrightability could turn on the personal experiences of the fact finder. One judge could consider an idea original while another could consider it commonplace."<sup>143</sup> Such judgment of artistic intent, should it be applied without analysis, would indeed be a danger of the *Brandir* test.

One judge recently performed a thoughtful analysis using the *Brandir* test to analyze another item of industrial design—a watch. The district court judge in *Severin Montres, Ltd. v. Yidah Watch Co.*<sup>144</sup> relied on the *National Theme Productions* court's interpretation of *Brandir* in finding that the plaintiff's wristwatch was copyrightable. The plaintiff, the licensee of the Gucci trademark for the purpose of creating watch designs,<sup>145</sup> created the Gucci *G-watch*, a watch with its rectangular frame forming a three-dimensional letter *G*.<sup>146</sup> The defendants, who made a *J-watch* and an *E-watch*,<sup>147</sup>

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140. *Id.* at 1353 (quoting *Brandir*, 834 F.2d at 1151 (Winter, J., concurring in part and dissenting in part)).

141. See Peter K. Schalestock, Comment, *Forms of Redress for Design Piracy: How Victims Can Use Existing Copyright Law*, 21 SEATTLE U. L. REV. 113, 125-28 (1997).

142. See *supra* notes 136-41 and accompanying text.

143. Lori Petruzzelli, Comment, *Copyright Problems in Post-Modern Art*, 5 DEPAUL J. ART & ENT. L. 115, 138 (1995).

144. 997 F. Supp. 1262 (C.D. Cal. 1997). The author of this article was involved as a law clerk for the plaintiffs in this case. The opinions herein are those of the author only.

145. See *id.* at 1264 n.1.

146. See *id.* at 1265.

claimed that the frame was functional, and could not be protected by copyright law.<sup>148</sup>

According to Judge Wardlaw, “[w]here design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.”<sup>149</sup> Judge Wardlaw further found that a watch could be deconstructed to basic elements of a case, a bezel, a face, and a bracelet, each of which “may have distinctive features and may be designed in any number of ways.”<sup>150</sup> She decided that the plaintiff’s artistic expression contained enough artistic design to be unique and protectable under the *Brandir* test.<sup>151</sup> While Judge Wardlaw provided enough factual basis for her conclusion that the watch design was “artistic enough,” other judges may not be as diligent, leading to opinions that are hard to review or apply in later cases.

#### 5. The Ninth Circuit’s “lack of test” test

Of course, having a confusing test may be better than having no test at all. The Ninth Circuit seems to have exactly that—no test. In *Fabrica Inc. v. El Dorado Corp.*,<sup>152</sup> Fabrica sought copyright protection for a folder of carpet samples.<sup>153</sup> The Ninth Circuit found that “no element of the folders . . . can be separated out and exist independently of their utilitarian aspects.”<sup>154</sup> The court did not recite a specific conceptual separability test or even a case analyzing a test or concept; the court merely recited the copyright statute and legislative history without providing further analysis.<sup>155</sup> By avoiding such an analysis, the court seemingly avoided having to analyze artistic judgment. In a way, such an analysis-free test is toothless, for it allows a court to jump to whatever conclusion feels right, given the facts and circumstances of the case.

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147. *See id.* at 1263.

148. *See id.* at 1265.

149. *Id.* (quoting *National Theme Productions*, 696 F. Supp. at 1353, and citing *Brandir*, 834 F.2d at 1145).

150. *Id.*

151. *See id.*

152. 697 F.2d 890 (9th Cir. 1983).

153. *See id.* at 892.

154. *Id.* at 893.

155. *See id.* at 893.



The Ninth Circuit had an opportunity to correct this lack of analysis recently in *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*<sup>156</sup> In *Entertainment Research Group*, the plaintiff received copyright registration for costumes of such popular figures as "Toucan Sam" and "Cap'n Crunch."<sup>157</sup> The Ninth Circuit, in analyzing the originality of such costumes, raised the subject of useful article protection.<sup>158</sup> Given these facts, the court could have easily chosen a conceptual separability test to see if the costumes warranted protection, or it could have boldly abandoned the doctrine altogether. But, alas, the court merely cited the statute and *Fabrica*, and avoided significant substantive analysis.<sup>159</sup>

## V. ALTERNATIVE INTELLECTUAL PROPERTY PROTECTION

### A. *The Uncertainty of Design Patent Protection*

With all of the uncertainty surrounding conceptual separability, the natural tendency for an industrial designer is to seek other forms of protection. One possibility is the design patent.<sup>160</sup> Obtaining a design patent does provide the industrial designer with a solid form of protection. This, however, is not a very good alternative, for several reasons.

A design patent is a patent that may be issued only for novel inventions that are also original and ornamental.<sup>161</sup> Furthermore, a design patent, like a utility patent, must be nonobvious.<sup>162</sup> Nonobvious means that it must "represent[] a distinct inventive step in advance of the prior art in the particular field."<sup>163</sup> The nonobviousness

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156. 122 F.3d 1211 (9th Cir. 1997).

157. *Id.* at 1218.

158. *See id.* at 1221.

159. *See id.* The court merely concluded that "in light of § 101 of the Copyright Act, . . . these utilitarian aspects are not copyrightable." *Id.* The court did not identify the utilitarian aspects of the costumes. *See id.*

160. *See* 35 U.S.C. § 171 (1994).

161. *See id.* In the context of patent laws, "ornamental" means that the shape of the invention is not dictated by its function. *See Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460-61 (Fed. Cir. 1997).

162. *See* 35 U.S.C. § 103.

163. Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1356 (1987).

requirement imposes a large financial burden upon the designer, who must examine a wide array of prior designs to distinguish the innovation.<sup>164</sup> Once the designer spends the money and submits the patent application, the examiner from the Patent and Trademark Office (PTO) rejects the application roughly half of the time.<sup>165</sup>

Another problem with design patents is the length of time required to obtain one. As of 1988, the PTO took an average of two years to process a design patent after receiving an application.<sup>166</sup> By 1995, despite a program to reduce the examination time by half, the PTO still took an average of eighteen months per application.<sup>167</sup> Often this length of time to obtain a patent is burdensome for the industrial designer, whose product cycle is much shorter before the design becomes obsolete.<sup>168</sup>

A third major problem with design patents is that even if designers secure patent approval in the PTO, the courts often find design patents invalid.<sup>169</sup> The invalidity concern stems from the strict patent

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164. See Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 894. Dratler observes that "simply filing and prosecuting the patent application may cost from \$2,000 to \$5,000, and there may be additional charges for overcoming the patent examiner's objections." *Id.*

165. See Thomas B. Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty 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, 204-07 (1985).

166. See Dratler, *supra* note 164, at 893-94.

167. See William T. Fryer, III, *Seeking a Benefits Balance in the Industrial Design Treaty Revision (Hague Agreement): Fifth Meeting of Experts, Held June 13-16, 1995*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 931, 942-43 (1995). The PTO accomplished this goal by increasing the number of design patent examiners from twenty to over fifty. See *id.* at 943.

168. See Dratler, *supra* note 164, at 894. Supporting the idea that perhaps copyright law is more appropriate for industrial design, one commentator has proposed significantly shortening the length of time between design patent application and possible judicial review, based on the copyright law model. See William T. Fryer, III, *Design Patent System for the Twenty-First Century*, 24 AIPLA Q.J. 331, 346-47 (1996).

169. See Church, *supra* note 11, at 501 & nn.11-12. This fact is based on a study of design patent litigation from 1987-1993. See *id.* at 501. The Federal Circuit was created in the fall of 1982 to, among other things, have the power of review over the federal district courts in patent matters. See *id.* at 501 n.11. Before the Federal Circuit was created, the number of design patents held invalid was much higher, up to two-thirds. See *id.* at 500-01 & n.10; see also

law requirements for originality; a designer may be able to protect a slight design variation under copyright standards, but patent law requires that the design not be "obvious" in light of prior designs.<sup>170</sup> Additionally, once the valid patent is analyzed against a competing design, courts will find patent infringement only about half of the time.<sup>171</sup> The bottom line is that design patents seem to be a long-shot,<sup>172</sup> and often the target of judicial hostility.<sup>173</sup>

Yet, despite the drawbacks of a design patent, many companies still opt for this protection and enforce their patents vigorously.<sup>174</sup>

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Brown, *supra* note 163, at 1356 (stating that of the thirty percent of design patents that are held valid, only half will be found to have been infringed).

Much of the concern over design patent invalidity stems from the requirement that the protected product design be ornamental, a description that conflicts with the concept that form and function are often inseparable. See Woodring, *supra* note 17, at 311-12. In fact, one commentator noted that "the reported cases on . . . instances when a design patent has been successfully enforced can be counted in single digits per year." William S. Thompson, *U.S. Design Protection: Discussion of Status and Suggested Proposals*, 24 AIPLA Q.J. 393, 405 (1996).

170. See 35 U.S.C. § 103.

171. See Brown, *supra* note 163, at 1356; see also Dan Gallagher, *Judge Frees Qualcomm to Start Manufacture of Its New 'Q' Phone*, SAN DIEGO DAILY TRANSCRIPT, Apr. 25, 1997, at 1A (noting that the judge upheld Motorola's cellular phone design patent as valid, but found it not infringed).

172. An eight-to-one longshot, to be exact—one half are issued by the PTO, half of those are found valid by the courts, and half of those are strong enough to survive an infringement lawsuit. See *supra* text accompanying notes 165-71.

173. See Aoki, *supra* note 78, at 349; see also *In re Nalbandian*, 661 F.2d 1214, 1217-18 (C.C.P.A. 1981) (ignoring artistic differences between two designs of combination tweezer/spotlight as *de minimis*, per the court's conception of the ordinary designer). Some thought that maybe the advent of the Federal Circuit, see *supra* note 169, as a replacement for the Court of Customs and Patent Appeals would improve matters for design patentees. See Brown, *supra* note 163, at 1356. However, Federal Circuit cases defeat this optimism. See, e.g., *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240 (Fed. Cir. 1986) (reversing district court's finding that electrical rotary dimmer switch packaging was ornamental and instead finding design functional). But see Hupp, 122 F.3d at 1460, 1465 (finding that the mere fact that the article of manufacture served a function should not adversely affect design patentability, unless the design itself is functional, yet still finding the valid design patent not infringed).

174. See, e.g., Lisa Levenson, *Oakley Sues Nike over Sunglasses*, OREGONIAN, July 18, 1997, at D1 ("Oakley's [sunglasses] technology and innovations are protected by more than 300 patents worldwide . . .").

Perhaps one cause for industrial designers' optimism is the recent change in copyright policy allowing designers to hold both useful article copyrights and design patents for their designs.<sup>175</sup>

Before 1995 the Copyright Office mandated a choice between protection by copyright and protection by design patent.<sup>176</sup> This was true despite *Mazer v. Stein*,<sup>177</sup> where the Court explicitly found that the statuette at issue could be protected by both copyright and design patent, adding that "[w]e do not read such a[n either/or] limitation into the copyright law."<sup>178</sup>

The Copyright Office ignored *Mazer*, maintaining that the case is "inapplicable to the subject of design patents because the statuettes at issue in *Mazer* were obviously works of art and not useful works of industrial design to which only [design] patent protection should be extended."<sup>179</sup> In support of this rationale, the Copyright Office cited a 1929 appellate court decision that held that "[a]n inventor who has applied for and obtained a patent cannot extend his monopoly by taking out a copyright."<sup>180</sup> This policy restricted the industrial designer, and not all agreed that the policy was sound. For example, the PTO recognized that copyright law and design patent law complement each other, and allowed both a copyright and a design patent for a novelty watch depicting Spiro Agnew on its face.<sup>181</sup>

The Copyright Office finally saw the error of its ways and revised its regulations in 1995.<sup>182</sup> The Office explained as follows:

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175. The optimism is appropriate because two longshots are better than one.

176. See David Goldberg & Robert J. Bernstein, *The Either/Or Protection Issue*, N.Y.L.J., Mar. 19, 1993, at 3.

177. 347 U.S. 201 (1954).

178. *Id.* at 218.

179. Goldberg & Bernstein, *supra* note 176, at 3.

180. *Korzybski v. Underwood & Underwood, Inc.*, 36 F.2d 727, 729 (2d Cir. 1929).

181. See *In re Yardley*, 493 F.2d 1389, 1396 (C.C.P.A. 1974) ("Congress has not required an author-inventor to elect between the two modes which it has provided for securing exclusive rights on the type of subject matter here involved. If anything, the concurrent availability of both modes of securing exclusive rights aids in achieving the stated purpose of the constitutional provision.").

182. See Registrability of Pictorial, Graphic, or Sculptural Works Where a Design Patent Has Been Issued, 60 Fed. Reg. 15,605, 15,606 (1995) (codified at 37 C.F.R. § 202.10(a) (1995)).

The Copyright Office regulations . . . have been criticized. In his treatise on copyright, Nimmer observes: "[w]ithout offering the rationale of publication . . . , Copyright Office Regulations . . . simply provided that once a patent has been issued, copyright registration would be denied to a work of art. . . . There appears to be no statutory or other justification for this position. It would seem on principle that if a work otherwise meets the requirements of copyrightability, it should not be denied such simply because the claimant happens to be entitled to supplementary protection under other legislation." We agree.<sup>183</sup>

The new copyright regulation provides that the availability of design patent protection "will not affect the registrability of a claim in an original work of pictorial, graphic, or sculptural authorship."<sup>184</sup> While this change in policy may increase the number of industrial designs subjected to design patent protection, obtaining a design patent may be too difficult to achieve to make it worth the industrial designer's efforts, considering the length of time and degree of proof for validity.<sup>185</sup>

#### *B. The Hostility of Product Configuration Trade Dress Protection*

A designer can also seek protection for product configuration under section 43(a) of the Lanham Act.<sup>186</sup> This section protects a product's unregistered symbols, otherwise known as its "trade dress."<sup>187</sup> Trade dress specifically refers to "the total visual image of a product and the overall impression it creates."<sup>188</sup> Trade dress can refer to product packaging as well as product configuration.<sup>189</sup>

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183. *Id.* (citing DAVID NIMMER & MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 2.19 (1994)) (punctuation altered by Federal Register).

184. 37 C.F.R. § 202.10(a) (1997).

185. See *supra* notes 161-73 and accompanying text.

186. See 15 U.S.C. § 1125(a) (1994).

187. See Hermenegildo A. Isidro, Note, *The Abercrombie Classifications and Determining the Inherent Distinctiveness of Product Configuration Trade Dress*, 62 BROOK. L. REV. 811, 812 (1996).

188. *Id.* at 811 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992)).

189. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 cmt. b (1995).

While "product packaging" refers to the outer container or label for the product, "product configuration trade dress" refers to the visual image inherent in the product itself.<sup>190</sup> The advantages of trade dress include the fact that the protection lasts forever; a patentee can still prevent competitors from exactly copying the patented product once the patent term expires.<sup>191</sup> This may explain why manufacturers litigate trade dress infringement cases with increasing frequency to protect product design features.<sup>192</sup>

Just as trade dress protection for industrial design is starting to look attractive, however, critics are becoming openly hostile to trade dress when applied to product configuration.<sup>193</sup> Simultaneously, a "terrible trio" of circuit cases has discouraged industrial designers

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190. See *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1439 (3d Cir. 1994).

191. See generally Michael S. Pérez, Note, *Reconciling the Patent Act and the Lanham Act: Should Product Configurations Be Entitled to Trade Dress Protection After the Expiration of a Utility or Design Patent?*, 4 TEX. INTELL. PROP. L.J. 383 (1996).

192. See Dinwoodie, *supra* note 22, at 473-74; see also *Lyons Partnership v. Giannoulas*, 14 F. Supp. 2d 947, 949 (N.D. Tex. 1998) (describing how the creator of Barney, the lovable purple dinosaur, sued the San Diego Chicken for trade dress infringement); Kathryn Bold, *In Search of the Bogus Barney*, L.A. TIMES, Sept. 17, 1997, at E2 (explaining how Barney, not content with suing other costumed creatures, is also suing entertainers for trade dress infringement when they don similar purple dinosaur costumes to please children); David S. Jackson, *Sour Grapes: Kendall-Jackson Is Charging in Court That Gallo Copied Its Wine-Bottle Design, Thereby Siphoning Sales. The Result: Two Angry Vintners, Not Much Reserve*, TIME, Apr. 7, 1997, at 64 (discussing how the owner of Kendall-Jackson wine sued the owner of Turning Leaf for trade dress infringement).

193. See generally Bradley K. Groff, *Bare-Fisted Competition or Palming Off? Protection of Product Design As Trade Dress Under the Lanham Act*, 23 AIPLA Q.J. 65 (1995) (suggesting that product design be protected under patent law as Congress intended, rather than under the Lanham Act); Manotti L. Jenkins, *A Request to the High Court: Don't Let the Patent Laws Be Distracted by a Flashy Trade Dress*, 15 J. MARSHALL J. COMPUTER & INFO. L. 323 (1997) (discussing the history of the Patent Act and the Lanham Act and predicting that the Supreme Court would rule that product designs are covered by the former and not the latter); Kerrie A. Laba, Note, *Have Trade Dress Infringement Claims Gone Too Far Under the Lanham Act?*, 42 WAYNE L. REV. 1649 (1996) (arguing for a strict definition of trade dress in order to avoid conflicts between the patent laws and the Lanham Act).

from seeking copyright protection,<sup>194</sup> beginning with *Versa Products Co. v. Bifold Co.*<sup>195</sup> In *Versa Products*, the Third Circuit found that “[w]here product configurations are concerned, we must be especially wary of undermining competition. Competitors have broad rights to copy successful product designs when those designs are not protected by (utility or design) patents.”<sup>196</sup> The Third Circuit determined to “decide product configuration cases so as to harmonize them with the federal patent laws.”<sup>197</sup> Based on this perceived conflict between trade dress and patent laws, the court went on to drastically change the test for trade dress infringement in the circuit so as to make it almost impossible for a product designer to obtain protection.<sup>198</sup> For example, the court held that “in a product configuration case . . . the greatest weight must be given to the primary means by which consumers identify the products’ sources: packaging, trademarks, and advertising.”<sup>199</sup> The *Versa Products* court further found that “marketing and labeling” were “fundamental in product configuration cases.”<sup>200</sup> Basically, a company following *Versa Products* can copy the packaging or product configuration of another, put on a new label, and avoid liability.<sup>201</sup>

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194. The trio consists of *Versa Products Co. v. Bifold Co.*, 50 F.3d 189 (3d Cir. 1995), *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376 (7th Cir. 1996), and *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995). The trio is only “terrible” to those who believe that design protection is warranted. Others believe that over-protecting design might limit the alternatives available for consumers, thereby stifling competition and raising prices. See, e.g., Jenkins, *supra* note 193, at 357; Laba, *supra* note 193, at 1682-83.

195. 50 F.3d 189 (3d Cir.), *cert. denied*, 516 U.S. 808 (1995).

196. *Id.* at 207.

197. *Id.*

198. See *id.* at 208-16. The Third Circuit found that under their new trade dress product configuration standard, the defendant’s offshore oil-drilling rig valve did not infringe upon the plaintiff’s valve patent. See *id.* at 216.

199. *Id.* at 209.

200. *Id.* at 212.

201. See, e.g., *Hershey Foods Corp. v. Mars, Inc.*, 998 F. Supp. 500, 520 (M.D. Pa. 1998) (noting that the clearly labeled packaging of peanut butter M&M’s weighed against trade dress infringement of Reese’s Pieces packaging under *Versa Products*). This “labeling” solution has been criticized as insufficient in most realistic consumer situations. See Jay Dratler, Jr., *Trade Dress Protection for Product Configurations: Is There a Conflict With Patent Pol-*

The Third Circuit's reliance on the "conflict" between trade dress and patent laws is misplaced. As Judge Richard Posner noted ten years before the *Versa Products* decision:

[P]rovided that a defense of functionality is recognized, there is no conflict with federal patent law, save possibly with . . . a design patent. But the courts that have considered the issue have concluded, rightly in our view, that this section does not prevent the enforcement of a common law trademark in a design feature. . . . [T]here is therefore no necessary inconsistency between the two modes of protection.<sup>202</sup>

Judge Posner recognized that patent law and trade dress law were both federal laws, created for different purposes. He looked at those underlying purposes to hold that protection could exist for industrial designers in the non-functional features of their industrial designs.

Others hostile toward trade dress rely upon three Supreme Court cases:<sup>203</sup> *Sears, Roebuck & Co. v. Stiffel Co.*,<sup>204</sup> *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>205</sup> and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*<sup>206</sup> Reliance on these cases, however, is also misplaced. The Supreme Court in *Sears* and *Compco* held that federal patent and copyright laws trumped conflicting state unfair competition laws.<sup>207</sup> Similarly, *Bonito Boats* found that Florida could not pass a state law granting patent-like protection for boat hull designs, because federal patent laws automatically preempted such a law.<sup>208</sup>

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icy?, 24 AIPLA Q.J. 427, 574-79 (1996).

202. *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985).

203. While coincidental, these three Supreme Court cases are *not* the "terrible trio" described at *supra* note 194 and accompanying text. One commentator has called *Sears*, *Compco*, and *Bonito Boats* a "holy trinity." See Dratler, *supra* note 201, at 456.

204. 376 U.S. 225 (1964).

205. 376 U.S. 234 (1964).

206. 489 U.S. 141 (1989).

207. See *Sears*, 376 U.S. at 231-32; *Compco*, 376 U.S. at 237-38.

208. See *Bonito Boats*, 489 U.S. at 151-52, 167; see also *Leatherman Tool Group, Inc. v. Cooper Indus. Inc.*, 131 F.3d 1011, 1015 (Fed. Cir. 1997) (rejecting contention that *Bonito Boats* supported argument that patent law created a federal "right to copy," thereby preempting trade dress, and noting that *Bonito Boats*' emphasis on the right to exclude others from making, using or



The Seventh Circuit's *Kohler Co. v. Moen Inc.*,<sup>209</sup> on the other hand, reflects a more informed view. *Kohler* involved a dispute between two competitors over the protection of a faucet design: Moen had applied for registration of its design as a trademark, and the Kohler Company opposed.<sup>210</sup> After the Trademark Trial & Appeal Board dismissed Kohler's opposition, Kohler appealed to a federal district court under 15 U.S.C. § 1071(b) and was again denied.<sup>211</sup> Upon further appeal, the Seventh Circuit Court of Appeals rejected Kohler's argument that *Sears* and *Compco* provide the basis for finding a conflict between design patent and trade dress.<sup>212</sup> The Seventh Circuit explained that the *Compco* decision had found

that a defendant may copy at will if the design is "not entitled to a design patent or other federal statutory protection. . . ." Of course, the Lanham Act falls under the rubric of "other federal statutory protection," and courts have expressly held that *Sears* and *Compco* do not preclude federal trademark protection of designs.<sup>213</sup>

*Kohler* then rejects the view that *Sears* and *Compco* provide any support for those who would deny protection to industrial designs.

The support for trade dress in the Seventh Circuit did not last long, however. Three years later the Seventh Circuit changed its position in the second case of the terrible trio, *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*,<sup>214</sup> a case involving the trade dress protection for the external design of a "clamshell" corn starch washer.<sup>215</sup> The court stated that "[i]n the case of product configurations [trade dress], . . . this broad principle runs headlong into the patent laws."<sup>216</sup> The court essentially ruled that the federal patent laws preempted the federal trade dress laws. Although the court noted *Kohler*, it relied heavily

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selling a patented invention did not relate to trade dress law).

209. 12 F.3d 632 (7th Cir. 1993).

210. *See id.* at 633.

211. *See id.*

212. *See id.* at 640.

213. *Id.* (emphasis in original) (citation omitted).

214. 94 F.3d 376 (7th Cir. 1996).

215. *Id.* at 377-78.

216. *Id.* at 383.

on *Sears* and *Versa Products* and severely limited trade dress protection for product configurations in the Seventh Circuit.<sup>217</sup>

Fortunately for industrial designers, at least one panel of the Seventh Circuit has again drastically changed that circuit's course with respect to product configuration trade dress. In *Thomas & Betts Corp. v. Panduit Corp. (Thomas & Betts II)*,<sup>218</sup> the plaintiff's cable tie patent had expired, and the plaintiff sought to enforce trade dress protection as an alternative.<sup>219</sup> The defendant argued that allowing such protection is counter to public policy, and the district court agreed.<sup>220</sup> The Seventh Circuit held that "[u]nlike state laws prohibiting unfair competition, federal trademark protection cannot be preempted by patent law."<sup>221</sup> After an extensive review of *Sears*, *Compco*, and *Bonito Boats*, the Seventh Circuit reaffirmed its holding in *Kohler* that "courts have consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one statutory means for protection of intellectual property."<sup>222</sup> According to the court, trade dress protection for industrial

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217. See *id.* at 383-84. The *Dorr-Oliver* court also cited heavily to *Duraco Products, Inc. v. Joy Plastic Enterprises*, 40 F.3d 1431 (3d Cir. 1994). See *Dorr-Oliver*, 94 F.3d at 383. *Duraco Products* was the first case to narrowly construe *Two Pesos*. See *infra* note 232. *Versa Products* cited extensively from *Duraco Products*. See *Versa Prods.*, 50 F.3d at 198, 203, 207.

218. 138 F.3d 277 (7th Cir. 1998), *cert. denied*, 67 U.S.L.W. 3,257 (U.S. Oct. 13, 1998). This was the second reported decision by the Seventh Circuit on this same case; the earlier decision denied a preliminary injunction based on product configuration trade dress, relying extensively on the reasoning of courts finding a conflict between patent laws and trade dress laws. See *Thomas & Betts Corp. v. Panduit Corp. (Thomas & Betts I)*, 65 F.3d 654, 659-60 (7th Cir. 1995), *cert. denied*, 516 U.S. 1159 (1996). Given the similarities between *Thomas & Betts I* and *Dorr-Oliver*, the turnabout of the Seventh Circuit in *Thomas & Betts II* is surprising.

219. See *id.* at 282.

220. See *id.* at 285.

221. *Id.*

222. *Id.* at 287-88 (quoting *Kohler*, 12 F.3d at 638 (citations omitted)). The Seventh Circuit has seemed to weave between favorable and unfavorable views towards protection of industrial design, from *Kohler* to *Dorr-Oliver* to *Thomas & Betts II*, without much explanation as to why prior precedent was incorrectly decided.

design is reasonable because of the limitation in trademark law that functional features cannot be protected.<sup>223</sup>

The third case of the terrible trio is *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*<sup>224</sup> *Vornado* involved the trade dress of a household fan grill design.<sup>225</sup> *Vornado* had received a utility patent for the aerodynamic qualities of the fan.<sup>226</sup> However, it did not seek to enforce their patent against Duracraft; instead it decided to enforce the product configuration trade dress of the fan.<sup>227</sup> The *Vornado* court started its decision on the wrong foot, declaring that

[t]his case presents an issue of first impression in our circuit concerning the intersection of the Patent Act and the Lanham Trademark Act. We must decide whether a product configuration is entitled to trade dress protection when it has been a significant inventive component of an invention covered by a utility patent.<sup>228</sup>

Of course, the *Vornado* court did find a conflict between the patent and trademark laws and denied trade dress protection for *Vornado's* fan grill industrial design.<sup>229</sup> The court relied heavily on *Sears, Compco*, and *Bonito Boats*, a consistent theme among the terrible trio.<sup>230</sup>

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223. See *id.* at 288-89.

224. 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 516 U.S. 1067 (1996).

225. See *id.* at 1500.

226. See *id.*

227. See *id.* at 1501. *Vornado* agreed that its utility patent was not infringed by Duracraft's product. See *id.*

228. *Id.* at 1499.

229. See *id.* at 1510. In making its decision, the Tenth Circuit seemed to preempt one federal law, the Lanham Act, with another federal law, the Patent Act. For a good criticism of this preemption, see Ruby Ann David, Comment, *Federal Preemption of a Federal Statute: The Case of Vornado Air Circulation Systems v. Duracraft Corporation*, 37 SANTA CLARA L. REV. 253 (1996). The Federal Circuit, the appellate court with jurisdiction to hear all appeals in patent cases, see 28 U.S.C. § 1295(a) (1994), has also criticized such preemption or suggestion that the federal patent laws create any affirmative rights, such as the right to copy. See *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1327 (Fed. Cir. 1998); see also *Leatherman Tool Group*, 131 F.3d at 1014-15 (stating that the "right to copy" is not an affirmative right created by the federal patent laws, but is instead a common law right).

230. See *Vornado*, 58 F.3d at 1503-05. Professor Dratler has found the *Vornado* preemption analysis to be flawed, although he did opine that the result of

With decisions like *Vornado*, it is time for the Supreme Court to either justify or negate the hostility.<sup>231</sup> For now, judicial views of trade dress are too hostile for trade dress to be an attractive alternative to either the confusion of conceptual separability or the uncertainty of design patent protection.<sup>232</sup>

#### VI. THE ARCHITECTURAL WORKS COPYRIGHT PROTECTION ACT OF 1990<sup>233</sup>—A BEACON?

Given the failure of current patent, trademark, and copyright law to provide consistent protection for industrial design,<sup>234</sup> the United States should modify its laws to comply with the requirements of TRIPs, notwithstanding the assurances of President Clinton.<sup>235</sup>

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*Vornado* may be correct due to a real limit on the design alternatives available to competitors. See Dratler, *supra* note 201, at 538-39.

231. As of October 1998, the Supreme Court had received at least seven petitions for certiorari from product design trade dress cases in an eighteen month span and denied them all. See *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998), *cert. denied*, 67 U.S.L.W. 3,257 (Oct. 13, 1998); *Sunbeam Prods. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), *cert. denied*, 118 S. Ct. 1795 (1998); *Insty\*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663 (8th Cir. 1996), *cert. denied*, 117 S. Ct. 1085 (1997); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *cert. denied*, 516 U.S. 1159 (1996); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 516 U.S. 1067 (1996); *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260 (Fed. Cir.) (applying Second Circuit trade dress substantive law), *cert. denied*, 516 U.S. 909 (1995); *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189 (3d Cir.), *cert. denied*, 516 U.S. 808 (1995).

232. This hostility appears to be primarily directed at product configuration trade dress for now. This is in part due to an interpretation of *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), holding that the Supreme Court decision only applies to packaging trade dress and not product configuration trade dress. See, e.g., *Duraco Prods.*, 40 F.3d at 1442 (distinguishing *Two Pesos* as a packaging trade dress case and not a product configuration case because restaurant décor is akin to packaging). But see *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 787-88 (8th Cir. 1995) (criticizing and declining to follow *Duraco Prods.* and its "new test for . . . trade dress comprising product features or shape as opposed to packaging"); *Lainer v. Bandwagon, Inc.*, 983 F. Supp. 292, 300 (D. Mass. 1997) (following the *Stuart Hall* approach for expansive trade dress protection).

233. Pub. L. No. 101-650, 104 Stat. 5133 (codified at 17 U.S.C. §§ 101-102, 120 (1994)).

234. See *supra* notes 21-24 and accompanying text.

235. See *supra* note 20 and accompanying text.

TRIPs requires that "[m]embers *shall* give effect to the provisions of this Agreement."<sup>236</sup> It further dictates that "[m]embers *shall* provide for the protection of independently created industrial designs that are new or original."<sup>237</sup> TRIPs also makes clear that, in providing industrial design protection, a member country may determine that such protection should not extend to "technical or functional considerations."<sup>238</sup> One way to modify United States intellectual property law to comply with TRIPs is to create a separate, independent body of intellectual property law, also known as a *sui generis* industrial design law.<sup>239</sup> Another possibility is to modify existing architectural copyright law to include industrial design within its domain of protection.

Industrial design, like architecture, benefits society when its functional underlying works are at the same time artistic and aesthetically pleasing to behold. Therefore, it is only appropriate to consider the changes made to strengthen copyright protection for architecture as potentially applicable to industrial design. Before deciding whether the current architecture laws are sufficient, however, it is informative to first examine the way architecture was treated before Congress changed the copyright laws.

#### A. *The History of Architecture Copyright Protection*

Prior to 1990, an architectural work was treated as a pictorial, graphic, or sculptural work under 17 U.S.C. § 102(a)(5), because architecture was considered to be a form of large-scale sculpture.<sup>240</sup> As such, architecture was a useful article, for it certainly had a utilitarian function—that of housing people or businesses.<sup>241</sup> Being a useful article brought architecture under the conceptual separability test, and, "given the difficulty of separating a building's utilitarian

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236. TRIPs art. 1, § 1 (emphasis added).

237. *Id.* art. 25, § 1 (emphasis added).

238. *Id.*

239. *See generally infra* Part VII.B.

240. *See* Gregory B. Hancks, Comment, *Copyright Protection for Architectural Design: A Conceptual and Practical Criticism*, 71 WASH. L. REV. 177, 179 (1996).

241. *See* *Demetriades v. Kaufmann*, 680 F. Supp. 658, 663 n.7 (S.D.N.Y. 1988) ("A 'useful article' . . . necessarily includes living quarters.").

aspects from its design, the copyright law generally denied architects any protection for constructed architectural works."<sup>242</sup> The conceptual separability test does not apply to non-useful articles, so architectural works that were purely ornamental still received protection.<sup>243</sup>

The lack of protection for architectural works in general did not, however, include the copyrighting of architectural plans.<sup>244</sup> This distinction provided that a copyist could not copy plans in order to duplicate a building, but could meticulously study the building itself to create a copy.<sup>245</sup> This architectural plan-building distinction was so strong that it became a sort of maxim that allowed judges to avoid discussing separability at all when the copyrightability of architectural structures was at issue.<sup>246</sup>

This treatment of architectural structures was inconsistent with the goal of copyright—to encourage and protect creativity in original works.<sup>247</sup> What early treatment of architecture ignored was its role as an art form, both romantic and innovative; instead, architecture was viewed as a science, merely rational and imitative.<sup>248</sup> How can a

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242. Clark T. Thiel, *The Architectural Works Copyright Protection Gesture of 1990, Or, "Hey, That Looks Like My Building!"*, 7 DEPAUL J. ART & ENT. L. 1, 10 (1996); see also *Gemcraft Homes, Inc. v. Sumurdy*, 688 F. Supp. 289, 295 n.12 (E.D. Tex. 1988) ("[T]he building is not within the subject matter of copyright.").

243. This protection would mainly include embellishments such as gargoyles and friezes. See, e.g., *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 280-82 (5th Cir. 1970) (ignoring separability discussion for architectural work that is purely a "work of art").

244. See *Eales v. Environmental Lifestyles, Inc.*, 958 F.2d 876, 879-80 (9th Cir. 1992).

245. This distinction was often very confusing. See, e.g., *Herman Frankel Org. v. Tegman*, 367 F. Supp. 1051, 1053 (E.D. Mich. 1973) ("A person cannot, by copyrighting plans, prevent the building of a house similar to that taught by the copyrighted plans. . . . A person should, however, be able to prevent another from copying copyrighted house-plans and using them to build the house.").

246. See, e.g., *Schuchart & Assocs., Prof'l Eng'rs, Inc. v. Solo Serve Corp.*, 540 F. Supp. 928, 941 (W.D. Tex. 1982) (ignoring 1976 Act and summarily rejecting protection for "the structure depicted in the [architectural] drawings").

247. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) ("The *sine qua non* of copyright is originality.").

248. See Raleigh W. Newsam, II, *Architecture and Copyright—Separating*

work of architecture not also be a work of art when it is described as being able to "elevate the soul?"<sup>249</sup> When architecture can truly transform a city to the point where critics proclaim that the city does not deserve such beautiful architecture,<sup>250</sup> it has risen to a level deserving protection beyond that provided by conceptual separability. Of course, an "elevate the soul" standard would provide little protection; the law should, and does, aim its test a little lower.

### *B. Congress Changes The Architecture Copyright Law*

When Congress changed the architecture copyright laws in 1990, it did not do so in response to criticism that architecture deserved protection as art. Instead, it changed the law in response to international pressure to comply with the Berne Convention.<sup>251</sup> As early as 1976, when overhauling the copyright laws, the United States wanted to move towards Berne Convention compliance.<sup>252</sup> However, since the Berne Convention required "that member nations extend full copyright protection to architectural works," Congress asked the Copyright Office for recommendations.<sup>253</sup>

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*the Poetic from the Prosaic*, 71 TUL. L. REV. 1073, 1076 (1997); see also ADA LOUISE HUXTABLE, ARCHITECTURE ANYONE? 45-46 (1986) ("[An architect] mak[es] poetry out of visual devices, as a writer uses literary or aural devices. As words become symbols, so do objects; the architectural world is an endless source of symbols with unique ramifications in time and space.").

249. Nicolai Ouroussoff, *A Modern Sanctuary*, L.A. TIMES, Sept. 23, 1997, at F1. Ouroussoff analyzed architect José Rafael Moneo's plans for the new \$50-million Roman Catholic Archdiocese cathedral for Los Angeles. See *id.* Moneo's architectural goals, he said, included "provid[ing] an antidote for a world he perceives as increasingly spiritually empty." *Id.*

250. David Geffen, in an early tour of the new Getty Center museum, proclaimed that the museum was "too good for Los Angeles." Kurt Andersen, *A City on a Hill*, THE NEW YORKER, Sept. 29, 1997, at 66, 66.

251. See Thiel, *supra* note 242, at 17-18. The Berne Convention for the Protection of Literary and Artistic Works has been the major international copyright law for the last 100 years. See Hancks, *supra* note 240, at 181 & n.33. The United States finally agreed to join the Berne Convention in 1988, primarily to enjoy the benefit of more stringent enforcement and remedies for violations of American copyright overseas. See Dawn M. Larsen, Comment, *The Effect of the Berne Implementation Act of 1988 on Copyright Protection for Architectural Structures*, 1990 U. ILL. L. REV. 151, 157-58.

252. See Hancks, *supra* note 240, at 181-82 & n.33 (quoting S. REP. NO. 100-352, at 2 (1988), reprinted in 1988 U.S.C.C.A.N. 3706, 3707).

253. Thiel, *supra* note 242, at 18.

As a result of these recommendations, Congress made significant changes to the protection of architecture within copyright law.<sup>254</sup> Architecture is now protected in a category separate from pictorial, graphic, and sculptural works.<sup>255</sup> It is subject to the same rights and limitations as other copyrighted works, with some exceptions.<sup>256</sup> To protect an architectural work, a plaintiff still must prove that the infringer had access to the plaintiff's work and that the infringer's work was substantially similar.<sup>257</sup> Access and substantial similarity are tests that can be quite hard to interpret.<sup>258</sup>

The advantage of the new law is that an architectural work is no longer considered a pictorial, graphic, or sculptural work.<sup>259</sup> As such, architecture does not have to be analyzed under the useful article or conceptual separability tests.<sup>260</sup> The new law transported architecture copyright law from "intellectual property limbo" to a law

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254. See generally *Leicester v. Warner Bros.*, 47 U.S.P.Q.2d 1501, 1506-07 (C.D. Cal. 1998) (discussing extensive changes to architectural copyright laws as a result of the need to comply with the Berne Convention).

255. See 17 U.S.C. § 102(a)(8) (1994).

256. Since architectural works are visible from a public place, Congress carved out a fair use exception that permits the unauthorized "making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work." 17 U.S.C. § 120(a) (1994). The copyright law is also concerned that "individual standard features," such as doors and windows, be in the public domain. See *id.* § 101. The legislative history interpreted the definition of "architectural work" to exclude elements that were "functionally required." See *infra* note 264 and accompanying text. The fact that Congress retained limitations on the new law is important because the limitations maintained a balance between protection and competition.

257. See, e.g., *J.R. Lazaro Builders, Inc. v. R.E. Ripberger Builders, Inc.*, 883 F. Supp. 336, 342-44 (S.D. Ind. 1995) (interpreting the new act and noting the difficulty in assessing the designer's creativity in the context of an ordinary residence).

258. See, e.g., *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir.) (describing the Ninth Circuit substantial similarity test as being in a twenty year state of evolution), *cert. dismissed*, 118 S. Ct. 27 (1997).

259. See 17 U.S.C. § 102(a)(8) (1994).

260. See *id.* § 101 (definition of pictorial, graphic, or sculptural work is the only part of the copyright statute that refers to useful articles or conceptual separability); see also *Richmond Homes Management, Inc. v. Raintree, Inc.*, 862 F. Supp. 1517, 1525 (W.D. Va. 1994) ("[A]rchitectural works need no longer serve primarily nonfunctional, creative purposes, akin to sculptures . . ."), *aff'd in part, rev'd in part on other grounds*, 66 F.3d 316 (4th Cir. 1995) (unpublished table decision).



where "structures, as well as plans, are subject to the same copyright protection."<sup>261</sup>

One motivation for creating a separate category for architecture, in addition to Berne Convention compliance, was to avoid conceptual separability. The House Report describing the 1990 Act declared that

the copyrightability of architectural works shall not be evaluated under the separability test applicable to pictorial, graphic, or sculptural works embodied in useful articles. There is considerable scholarly and judicial disagreement over how to apply the separability test, and the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this disagreement.<sup>262</sup>

Legislators knew that the conceptual separability test was difficult to apply, and deleted it from the architecture test.

Congress, however, knew it needed some limitation to the protection for architectural works. Although legislative history contained a two-step test, Congress did not include the test in the text of the statute itself.<sup>263</sup> The two-step test included first determining whether the architectural work contained original design elements, and then determining if the work "functionally require[s]" the design elements.<sup>264</sup> Adding a functionality test could confuse some judges who misapply the test; a judge might not notice that the law no longer requires dissection of works to determine which parts are functional and which are decorative.<sup>265</sup> Congress may have realized the potential for confusion, for it further explained that "[e]vidence that there is more than one method of obtaining a given functional

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261. *Richmond Homes*, 862 F. Supp. at 1524-25; see also *J.R. Lazaro Builders*, 883 F. Supp. at 339 ("Therefore, copyright protection is extended to . . . the house itself.").

262. H.R. REP. NO. 101-735, at 20 (1990) (citing Perlmutter, *supra* note 58), reprinted in 1990 U.S.C.C.A.N. 6935, 6951.

263. See *id.*

264. See *id.* at 20-21, reprinted in 1990 U.S.C.C.A.N. 6935, 6951-52. There has not been any judicial construction of the "functional requirement" language.

265. The key concept involved in the architecture analysis is that works can be functional and aesthetic yet still be protected.

result may be considered in evaluating registrability or the scope of protection.”<sup>266</sup> Presumably, the more ways there are to design a structure to obtain its desired functional result, the broader the protection will be for the architect. In any event, the courts would, upon challenge to the copyrightability of the work, “be free to decide the issue upon the facts presented, free of the separability conundrum presented by the useful articles doctrine.”<sup>267</sup>

## VII. PROPOSALS FOR IMPROVING INDUSTRIAL DESIGN LAW

### *A. Applicability to Industrial Design*

In an effort to achieve the intellectual property balance,<sup>268</sup> Congress should act to expand the architectural protection to all useful articles, thereby eliminating the conceptual separability test. Other countries provide,<sup>269</sup> or are planning to provide, specific protection for industrial design.<sup>270</sup> The policy behind the Architectural Works Copyright Protection Act of 1990 easily applies to industrial design, as industrial design protection also serves important social purposes,<sup>271</sup> distinguishing products and promoting creativity and art.<sup>272</sup>

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266. *Id.* at 21, reprinted in 1990 U.S.C.C.A.N. 6935, 6952.

267. *Id.*

268. See *supra* notes 31-33 and accompanying text.

269. See, e.g., JOON KOO LEE & PARTNERS, *THE 1990 REVISION OF THE KOREAN INDUSTRIAL PROPERTY LAW (COMPARED WITH THE PREVIOUS LAW)* 186 (1990) (noting that Article 2(1) of the Korean law protects “the shape, pattern, color or combination thereof in an article which produces an aesthetic visual impression.”).

270. See Hugh C. Hansen, *The Harmonization of Trademark, Copyright and Design Law in the European Community*, in *GLOBAL TRADEMARK AND COPYRIGHT 1995: MANAGEMENT AND PROTECTION* 173, 198 (Practising Law Institute ed., 1995). The European Community proposal looked remarkably similar to the new United States architectural protection in that “[n]o distinction is made between aesthetic and functional designs, however features necessary to achieve a technical function and which leave no freedom as regards arbitrary elements are unprotectable in order not to monopolize technical functions by way of design protection.” *Id.*

271. One industrial designer has commented about design and its relationship to society as follows:

The history of the world can be documented by the design of objects and the study of these objects gives a clear message about the changes that were taking place in society. Indeed, it is reasonable to conclude

The impact of such a change in United States copyright laws would be a death knell for conceptual separability, thereby saving judicial resources from being wasted in constantly interpreting this confusing concept. Designers would be entitled to protection for their functional and artistic works; this added protection would undoubtedly spur creativity, thereby "promot[ing] the [p]rogress of . . . [the] useful [a]rts."<sup>273</sup> Perhaps this new industrial design law would contain a further advantage by requiring modern-day knock-off artists to resort to their own creative skills rather than absconding with those of others.<sup>274</sup>

The extension of greater protection for industrial design is also consistent with the goals of the former Congressional Act that proposed design protection, Title II of the 1976 Copyright Act.<sup>275</sup> In passing the 1976 Act, Congress stated that deleting Title II design protection required new committee consideration of that legislation.<sup>276</sup> In deleting Title II, Congress particularly expressed concerns

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that in many instances, especially in the 20th century, it is the very design and innovation of products that induced change in society.

Conran, *supra* note 1, at 8.

272. Many would argue that architecture embodies a higher form of creativity than does industrial design. Architects, like those who built the Getty Center in Los Angeles, work on a much grander scale, creating visible works with real societal impact. The typical industrial designer, such as a watch designer, exposes his or her creation to only a relatively small portion of society. In spite of these dissimilarities, the industrial designer is still creating a work of art, and spends a significant amount of creative effort making a unique product. See Hancock, *supra* note 7, at 272-75; see also Reichman, *supra* note 10, at 2459-60 (noting that smaller-sized companies often attempt to overcome a smaller market share by improving the appearance of their products). The fact that the architect works on an even grander scale, spending more time and money than the typical industrial designer, is really quite irrelevant in copyright law. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) ("The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.'" (quoting U.S. CONST. art. I, § 8, cl. 8)).

273. U.S. CONST. art. I, § 8, cl. 8.

274. *But see* H.R. REP. NO. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5663 (rejecting proposed design copyright law due to assertion by the Justice Department of anticompetitive effect). Since the United States is now more aligned with international copyright law as part of the Berne Convention, perhaps it is time to revisit Title II.

275. See *supra* notes 81-85 and accompanying text.

276. See H.R. REP. NO. 94-1476, at 50, *reprinted in* 1976 U.S.C.C.A.N.

with creating new monopolies.<sup>277</sup> However, by following the advice of the congressional committee that passed the Architectural Works Copyright Protection Act of 1990,<sup>278</sup> and the similar advice of other Berne Convention nations,<sup>279</sup> Congress could institute a workable copyright law to protect industrial design.

Furthermore, it makes sense from an economic point of view to enhance protection for industrial designers. When courts deem original designs unprotectable, common sense dictates that manufacturers will pay less for the opportunity to use such designs to distinguish their products. This discourages, rather than encourages, the artist or author and clearly contradicts copyright's goal of spurring creativity.<sup>280</sup> Consumers suffer economically, too. Without original, artistic designs with strong intellectual property protection, products become harder to distinguish. A consumer may become confused and purchase a lower quality product that lasts fewer years than the product the consumer had intended to buy.<sup>281</sup> While this "likelihood of confusion" standard is traditionally the hallmark of trademark/trade dress law,<sup>282</sup> upholding design protection through strong copyright legislation would fulfill the goal of eliminating consumer confusion without the hostility that is directed towards the unlimited nature of trade dress law.<sup>283</sup> Such an industrial design law might achieve the desired balance between allowing protection while not over-burdening competition, a balance that may have allowed the enactment of Title II had Congress discovered it.

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5659, 5663.

277. *See id.* The House Report noted the Justice Department's concern that the benefits of increased design protection had not been shown to "outweigh the disadvantage of removing such designs from free public use." *Id.*

278. *See supra* text accompanying notes 263-67.

279. *See supra* note 270.

280. *See* L. RAY PATTERSON & STANLEY W. LINDBERG, *THE NATURE OF COPYRIGHT: A LAW OF USERS' RIGHTS* 2 (1991).

281. *See* *United States v. Torkington*, 812 F.2d 1347, 1353 (11th Cir. 1987) ("[Harm occurs] when potential purchasers . . . see unauthentic goods and identify these goods with the trademark holder.").

282. *See* 15 U.S.C. § 1114(1) (1994); *see also* *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979) (outlining factors for likelihood of confusion test); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (same).

283. *See supra* Part V.B.

Since the life of a product is often short, perhaps industrial design protection does not need the same duration as other copyrighted works, which receive protection for the life of the author plus an additional seventy years.<sup>284</sup> Critics might argue that such a long duration would have adverse effects on the free market, and exhaust product differentiation choices. As a response, Congress could shorten the protection period for industrial design. Congress could also consider incorporating much of the same fair use limitations seen for architectural works.<sup>285</sup> However, these additional limitations may not be needed for industrial design. For example, once a product is sold containing an industrial design, the first sale doctrine of copyright law allows purchasers to resell<sup>286</sup> the product or display it.<sup>287</sup> Creators of architectural works receive limited rights to prevent the destruction of works; these rights are based on the premise that architecture is typically stationary.<sup>288</sup> Industrial design would not need these extra rights and limitations.

Perhaps the only protection industrial designers really need is the right to prevent reproduction<sup>289</sup> and unauthorized derivative works.<sup>290</sup> These limitations may be necessary to perfect the balance sought between the conflicting goals of copyright—protecting both the natural rights of artists and the public benefit.<sup>291</sup> Even with limitations, the proposed changes to copyright laws to benefit industrial design are consistent with constitutional guidelines and would provide benefits that outweigh potential monopolistic concerns. Constitutionally, the useful arts benefit from legal protection for the

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284. See 17 U.S.C. § 302(a) (1998 Supp.). But note that some products arguably will reach the life-plus-seventy duration, such as the Coke bottle. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

285. The limitations include the right to make, distribute or display publicly any pictures, paintings, or photographic representations of any work visible from a public place. See 17 U.S.C. § 120(a) (1994).

286. See *id.* § 109(a).

287. See *id.* § 109(c).

288. See *id.* § 120(b).

289. See *id.* § 106(1).

290. See *id.* § 106(2).

291. See PATTERSON & LINDBERG, *supra* note 280, at 2. Arguably, the public benefit may be served by fewer restrictions on protection. See *supra* text accompanying note 281.

works of authors; such protection promotes innovation, ultimately allowing consumers to benefit from the increasing number of choices of products.

*B. Alternative Protection: Sui Generis Design Law*

Both within current United States intellectual property law, as well as the laws of other countries, *sui generis* protection exists. *Sui generis* protection is often more appropriate than standard copyright law when similar laws in existence provide protection inconsistent with the legislative goals of protection for the product.<sup>292</sup>

For example, in 1984 Congress passed a law aimed at providing protection for semiconductor design, "mask works."<sup>293</sup> The semiconductor industry was concerned with protecting mask works—the surface images of integrated circuit designs contained in semiconductor chips—from blatant copying.<sup>294</sup> By passing a *sui generis* law, Congress was able to provide a shorter period of protection, ten years, for the mask works,<sup>295</sup> as opposed to the typical term of protection for most copyright works, which is equal to the life of the author plus seventy years.<sup>296</sup> Presumably to allow for the fast-paced nature of the semiconductor industry, Congress also built a two-year grace period for mask work registration into the *sui generis* law.<sup>297</sup>

Industrial design is an appropriate candidate for *sui generis* protection. Indeed, several countries already protect industrial design in this fashion.<sup>298</sup> For example, the French government attempted similar *sui generis* protection for computer software.<sup>299</sup>

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292. See generally H.R. REP. NO. 98-781, at 5-11 (1984), reprinted in 1984 U.S.C.C.A.N. 5750, 5754-60 (comparing *sui generis* law to copyright law and concluding that *sui generis* law is more appropriate for semiconductor mask works, given the balance Congress desired to achieve).

293. Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, 98 Stat. 3347 (1984) (codified as amended at 17 U.S.C. §§ 901-914 (1994)).

294. See Reichman, *supra* note 10, at 2478-79.

295. See 17 U.S.C. § 904 (1994).

296. See *id.* § 302(a) (1998 Supp.).

297. See *id.* § 908(a) (1994).

298. See *supra* notes 269-70 and accompanying text; see also Reichman, *supra* note 10, at 2488-90 (discussing *sui generis* protection in Britain and France for industrial design, otherwise known as "applied art").

299. See Reichman, *supra* note 10, at 2481-83.

The United States recently considered a *sui generis* industrial design law. On October 12, 1998, the United States House of Representatives passed a bill that included a section establishing a *sui generis* law for a specific subcategory of industrial design.<sup>300</sup> The overall bill, the Digital Millennium Copyright Act (DMCA),<sup>301</sup> contains as a part of it the Vessel Hull Design Protection Act (VHDPA).<sup>302</sup> The bill was a result of a compromise reached after the Senate had originally deleted the VHDPA from the DMCA.<sup>303</sup>

The VHDPA amends Title 17 of the United States Code to add Sections 1301-1332.<sup>304</sup> At first glance, the new act looks promising to industrial designers, as it provides that "[t]he designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter."<sup>305</sup> A closer examination, however, reveals that the act defines the term "useful article" narrowly as only "a vessel hull, including a plug or mold."<sup>306</sup>

*Sui generis* protection for vessel hulls, ironically, is a reaction to the Supreme Court decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*<sup>307</sup> *Bonito Boats* dealt with federal preemption of state law; nothing in the case precluded a vessel hull designer from seeking useful article copyright protection or even trade dress protection.<sup>308</sup> The reasoning for the VHDPA is unknown; "[t]he record of the floor discussion of H.R. 2281 in the House is entirely silent on the purposes of the title."<sup>309</sup>

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300. See 144 CONG. REC. H10,621 (daily ed. Oct. 12, 1998).

301. H.R. 2281, reprinted in 144 CONG. REC. H10,048-64 (daily ed. Oct. 8, 1998).

302. H.R. 2281, tit. V, reprinted in 144 CONG. REC. H10,060-64 (daily ed. Oct. 8, 1998).

303. See 144 CONG. REC. S10,537 (daily ed. Sept. 17, 1998) (motion of Sen. Santorum).

304. See VHDPA § 502.

305. *Id.* (proposing 17 U.S.C. § 1301(a)(1)).

306. *Id.* (proposing 17 U.S.C. § 1301(b)(2)).

307. 489 U.S. 141 (1989). See *supra* text accompanying notes 203-08.

308. See *supra* text accompanying notes 209-13.

309. Letter from Peter Jaszi of the Digital Future Coalition to Pat Roberts, United States Senator 2 (Aug. 24, 1998) (on file with *Loyola of Los Angeles Law Review*) [hereinafter Digital Future Coalition Letter].

Critics have observed that the VHDPA could “easily be expanded” to cover industrial design, including “automobile body and part designs, furniture designs, and clothing designs.”<sup>310</sup> The critics’ concerns seem to be misplaced. It is true that the VHDPA fulfills the goal of providing protection for industrial design, that of giving rights to valuable intellectual property.<sup>311</sup> On the other hand, the VHDPA limits the time for protection to ten years,<sup>312</sup> which may be sufficient for copyright-like protection in a field with rapid product design turnover without providing too large a monopoly. Furthermore, the VHDPA contains additional safeguards, including an originality requirement<sup>313</sup> and denying protection merely for functionality.<sup>314</sup> These critics maintain that expanding the VHDPA to other industrial design would cause an “extraneous controversy,”<sup>315</sup> and “would represent the ‘opening wedge’ for a potentially far-reaching reconceptualization of American intellectual property law.”<sup>316</sup> However, these VHDPA critics were actually speaking as DMCA advocates; they seemed more concerned that Congress passed the VHDPA as a hidden component of the larger DMCA, which had an entirely different purpose, protecting copyright in the digital environment.<sup>317</sup>

Other critics include the Senators debating the actual bill. For example, Senator Strom Thurmond indicated concern that the new

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310. *Id.*

311. *See* VHDPA § 502 (proposing 17 U.S.C. §§ 1308-1309).

312. *See id.* (proposing 17 U.S.C. § 1305(a)).

313. *See id.* (proposing 17 U.S.C. § 1302(1)).

314. *See id.* (proposing 17 U.S.C. § 1302(4)). Protection would be denied to a design that is “dictated solely by a utilitarian function of the article that embodies it.” *Id.*

315. Digital Future Coalition Letter, *supra* note 309, at 3.

316. *Id.* at 2-3.

317. Surprisingly, after making such strong statements, the Digital Future Coalition declared that it “takes no position on the merits of the design protection issue.” *Id.* at 3. Apparently, the true concern of the Coalition was that the issue was “wholly unrelated to intellectual property rights in the digital environment,” which was the subject matter of the substantive legislation that the Coalition had supported and which provided the original purpose of the DMCA. *See id.* at 3. The VHDPA was but one section of the DMCA, attached to it at the very end, and does not seem to relate to the DMCA’s other subject matter in any way.



bill would protect "functionality . . . in addition to aesthetic aspects. It is my understanding that functionality is protected from copying through patent [law]."<sup>318</sup> This "understanding" of Senator Thurmond is the same flawed logic that has led appellate courts to deny trade dress protection to product configurations associated with an expired utility patent.<sup>319</sup>

Senator Orrin Hatch, however, supported the idea of a *sui generis* intellectual property law for industrial design in general, but noted how controversial such a law would be.<sup>320</sup> In light of this controversy, Senator Hatch devised a special provision to achieve the desired intellectual property balance.<sup>321</sup> The provision Senator Hatch referred to is a sunset provision—after two years, the VHDPA expires, and the heads of the Patent & Trademark Office and the Copyright Office must meet to create a joint report evaluating the effect of the VHDPA.<sup>322</sup> The renewal criteria that Senator Hatch selected are interesting—the VHDPA directs the head of the two offices to consider:

- (1) the extent to which the amendments made by this title has been effective in suppressing infringement of the design of vessel hulls;
- (2) the extent to which the registration provided for in chapter 13 of title 17, United States Code, as added by this title, has been utilized;
- (3) the extent to which the creation of new designs of vessel hulls have been encouraged by the amendments made by this title;
- (4) the effect, if any, of the amendments made by this title on the price of vessels with hulls protected under such amendments; and

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318. 144 CONG. REC. S11,889 (daily ed. Oct. 8, 1998) (statement of Sen. Thurmond).

319. See *supra* notes 224-32 and accompanying text.

320. See 144 CONG. REC. S11,889 (daily ed. Oct. 8, 1998) (statement of Sen. Hatch).

321. See *id.*

322. See VHDPA § 504(a).

(5) such other considerations as . . . may [be] relevant to accomplish the purposes of the evaluation conducted under subsection (a).<sup>323</sup>

This direction is actually a balance, looking at the inspiration the intellectual property regime provides to stimulate creation of boat hull designs, and contrasting that inspiration against barriers such as increased prices for consumers.

In essence, these criteria, selected "to help us make the right decision,"<sup>324</sup> perform the exact balancing needed to optimize a new regime of intellectual property protection by comparing the incentives to designers with the effect on competition and access. Even though the VHDPa only applies to boat hull designs, it will be interesting to see what results from the two-year experiment of the new act.<sup>325</sup>

The reformulated VHDPa seems to be well-suited to the principles underlying a much-needed industrial design law. Such a law would certainly comply with TRIPs both in letter and spirit. If the joint study of the VHDPa shows that a balance between improved industrial design protection and access to prior works has been achieved for boat hulls, it would be appropriate to expand the VHDPa with a simple amendment to cover all industrial design.

### VIII. CONCLUSION

It has been over a century since the Industrial Revolution, when industry began producing designs in mass quantities to attract consumers. After all this time, intellectual property protection for industrial design is still far from certain. Despite President Clinton's assurances that current copyright and patent laws properly protect industrial design,<sup>326</sup> protection today is difficult to achieve.

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323. *Id.* § 504(b).

324. 144 CONG. REC. S11,889 (daily ed. Oct. 8, 1998) (statement of Sen. Hatch).

325. The joint study will take place by November, 2000, since on October 28, 1998, President Clinton signed H.R. 2281, the Digital Millennium Copyright Act, into law. See White House Office of the Press Secretary, Statement by the President Signing H.R. 2281 Into Law (Oct. 28, 1998), available in White House, *Search All White House Publications* (visited Nov. 2, 1998) <<http://www.pub.whitehouse.gov/search/everything.html>> (word search of "all documents" posted after Oct. 20, 1998, for key word "copyright").

326. See *supra* notes 49-53 and accompanying text.

Copyright protection for industrial design is riddled with confusion. If a court determines that the design to be protected is useful, it must pass any one of a number of conceptual separability tests, each with its own supporters and critics. The familiar cry of infringers—"protect it with a design patent"—is often no use, given the extremely short product cycle for industrial design combined with the uncertainty of a designer's ability to enforce a valid design patent. Turning to trade dress protection under the Lanham Act is also becoming increasingly futile. This is due in large part to possibly misplaced academic and judicial hostility towards product configuration trade dress.

A solution to the industrial design protection problem already exists. The Architectural Works Copyright Protection Act of 1990 recognized the importance of protection and provided a simple test to protect previously unprotected architectural structures. This change brought architectural copyright laws into synchronization with international protection, yet provided a functionality restriction and only limited guidance on how to apply the limitation.

To the extent that copyright law provides too much protection for industrial design,<sup>327</sup> *sui generis* design protection under Title 17 of the United States Code presents another solution. *Sui generis* protection would provide the same validity and infringement tests as the proposed industrial design copyright law, but for a much shorter duration and with fewer rights than architecture now receives. Copyright law already successfully protects certain works with *sui generis* protection; for instance, the House of Representatives recently passed a law that would provide industrial design protection for boat hulls. There is no reason why such a stand-alone law could not successfully protect industrial design in general.

It may be true that the guidance Congress provided in the context of the architecture copyright law or the *sui generis* vessel boat hull design law is insufficient and that courts will have as difficult a time with the concept of functionality under those laws as they do with conceptual separability. But even so, it is time to bring domestic industrial design protection in line with international protection, and to finally address the deletion of Title II from the 1976

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327. See *supra* note 272 and accompanying text.

Copyright Act. Either a change in the copyright law, or the addition of *sui generis* design protection, would remove the advantage to infringers, and redeliver a free market to the real artists who deserve to capitalize on their efforts. The architectural standard is the beacon for Congress to find its way out of the conceptual separability darkness. The proposed tests may not be the perfect solution. They are solutions, however, which avoid confusion, uncertainty, and hostility. These solutions are exactly what industrial design deserves.

*Richard G. Frenkel\**

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