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Design Patents: Law Without Design

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DESIGN PATENTS: LAW WITHOUT DESIGN

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ABSTRACT

Design patents have recently burst onto the intellectual property stage, but they are surprisingly underdeveloped for a body of law that is more than a century and a half old. Design patents are, quite simply, a body of law without design: there is little coherent theoretical underpinning for this long overlooked form of intellectual property. Now, as design patents are poised to assume greater prominence in the legal and economic realms, the time is ripe for examining myriad justifications for exclusive rights in design in order to develop a richer theoretical foundation for this body of law. To that end, this Article draws from statute, doctrine, legislative history, and academic commentary to identify various theoretical justifications for design patents related to promoting progress, beautifying the human environment, rewarding creative labor, and reducing consumer confusion and promoting distinctiveness. We critically examine the cogency of these justifications and identify hidden tensions among them. Our ultimate aim is to help develop a body of design patent doctrine that is more accountable to theory. We conclude that even the most persuasive and defensible justifications for design patents counsel a limited right at best.

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INTRODUCTION

Global litigation between Apple and Samsung over the design of smartphones and tablets has cast significant light on design patents,¹ a relatively understudied branch of intellectual property law. While scholars, policymakers, and the bar have devoted substantial attention to copyrights, trademarks, and utility patents, design patents have largely languished on the periphery of intellectual property.² Recent developments suggest that this state of affairs will soon change. Among other effects, litigation between Apple and Samsung has revealed the increasing value of design in the modern economy as well as the increasing importance of design patents as a mechanism for capturing and monetizing that value.³ The rise in global design patent filings

1. See Paul Elias, *Apple's Victory Could Mean Fewer Phone Options*, SEATTLE TIMES (Aug. 24, 2012, 3:03 PM), http://seattletimes.com/html/nationworld/2018986876_apusapplesamsungtrial.html (noting litigation between the two companies in South Korea, Germany, Japan, Italy, the Netherlands, Britain, France, and Australia); Nick Wingfield, *Jury Awards \$1 Billion to Apple in Samsung Patent Case*, N.Y. TIMES (Aug. 24, 2012), <http://www.nytimes.com/2012/08/25/technology/jury-reaches-decision-in-apple-samsung-patent-trial.html>; see also Susanna Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 501 (2012) (noting the importance of design in the modern economy). In March 2013, Federal District Court Judge Lucy Koh reduced Samsung's damages by almost half, noting that jurors had not followed her instructions in calculating the initial damages. Paul Elias, *Samsung's \$1B Bill in Apple Case Reduced by \$450M*, ASSOCIATED PRESS (Mar. 1, 2013, 6:51 PM), http://www.apnewsarchive.com/2013/Samsung%27s_%241B_bill_in_Apple_case_reduced_by_%24450M/ id-0ff9328d74164a1b8087126b7f72bc7c.

2. See Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 840 (2013) (stating that “[s]cholars have written very little about the design patent system” and then listing notable exceptions) [hereinafter Du Mont & Janis, *Origins*].

3. See, e.g., Tim Bradshaw, *Designers on the Ascendant in Silicon Valley*, FIN. TIMES (July 7, 2013, 1:22 PM), <http://www.ft.com/cms/s/0/b587e678-e42c-11e2-91a3->

suggests that design-related litigation will become increasingly common.⁴ As design patents are poised to grow in stature and economic importance, the time is ripe to reevaluate and critically assess their theoretical foundations.⁵

This Article engages in a “first principles” examination of design patent law and theory. It explores the theoretical bases underlying the design patent system and analyzes whether current design patent law is constructed to achieve these aims. Our conclusions are sobering. Congress created design patents in 1842 to fill the interstices left by copyright, trademark, and utility patent law.⁶ Designers bemoaned the ease of copying and the proliferation of knock-offs in the wake of the industrial revolution.⁷ Responding to arguments that trademark, copyright, and utility patents failed to protect the large investments made in successful designs, Congress enacted a design patent statute to protect this value. Nowadays, other intellectual property doctrines also protect elements of design, but they contain important limitations based on prudential interests in maintaining wide access to design. Design patents lack many of these limitations, thus threatening to be the exception that swallows the rule.⁸

Design patent law’s shortcomings, which we detail below, are not surprising given its underdeveloped theoretical foundations and the poor fit between defensible theories of design protection and current doctrine. While commentary on design patent theory is relatively scarce, we draw from statute, doctrine, legislative history, and academic scholarship to identify several proffered theories attempting to justify exclusive rights in design related to promoting progress, beautifying the human environment, rewarding creative labor, and reducing consumer confusion and promoting distinctiveness. This Article reveals several hidden tensions and assumptions among these theories, and it attempts to distill the most cogent justifications for design patent law. In so doing, it argues for restructuring current doctrine so that the design patent system can better achieve its proper goals. We argue that design patent law currently protects its subject matter rather expansively and coarsely and that it

00144feabdc0.html (describing how Apple’s success has led designers to become more commonplace—and a virtual necessity—for technology companies).

4. Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 863 (2010) (noting that the recent increase in design patent applications far outpaces the increase in utility patent applications) [hereinafter Beebe, *Sumptuary Code*]; Du Mont & Janis, *Origins*, *supra* note 2, at 839.

5. Cf. Du Mont & Janis, *Origins*, *supra* note 2, at 841 (“[S]ome view the design patent system as having never developed a distinctive identity, a *raison d’être*.”).

6. See *infra* note 10 and accompanying text.

7. See *infra* note 110 and accompanying text.

8. We develop a detailed comparison of the limits that constrain design protection under trademark, copyright, utility patent, and design patent law in a separate paper. See Peter Lee & Madhavi Sunder, *The Law of Look and Feel* (2013) (unpublished manuscript) (on file with authors).

should incorporate a more limited, granular, and contextually-sensitive approach to protecting design.

This Article proceeds in three Parts. Part I provides an overview of design patents, comparing this legal regime with other fields of intellectual property law that also protect design. We find that, on the whole, design patents lack important limitations that promote access to design in copyright, trademark, and utility patent law. Part II draws from statute, doctrine, legislative history, and academic commentary to provide the first comprehensive assessment of design patent theory. We critically examine the cogency of justifications proffered for design patents and identify hidden tensions among them. We conclude that even the most persuasive and defensible justifications for design patents counsel limitations on exclusive rights that currently do not exist. Part III offers suggestions for making design patent doctrine more accountable to theory by limiting the strength and scope of design patents.

I. DESIGN PATENTS: EXPANSIVENESS IN PROTECTING DESIGN

A. *Overview of Design Patents*

Because design patents have received relatively little scholarly attention compared to other forms of intellectual property,⁹ this Part provides an overview of this body of law. Congress enacted the first design patent statute in 1842 based on a perceived lack of protection for ornamental designs.¹⁰ At the time that Congress introduced design patents, they were the only form of intellectual property protection available for designs.¹¹ As Jason Du Mont and Mark Janis observe, developments in manufacturing technology, particularly refinements in the production of cast-iron goods, played a key role in the economic and political impetus behind the first design patent statute.¹² In addition, rampant piracy in the British textile industry and Parliament's ensuing passage of copyright-like protection for textiles also helped motivate domestic design patent legislation.¹³ Interestingly, the initial bill that evolved into the U.S. design patent statute was modeled on the copyright-based act that

9. See Janice M. Mueller & Daniel Harris Brean, *Overcoming the "Impossible" Issue of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 423 (2011) ("Despite their increasing popularity, design patents and the legal requirements for obtaining them have garnered surprisingly little notice or study.").

10. See Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. OFF. SOC'Y 380, 380 (1948).

11. Du Mont & Janis, *Origins*, *supra* note 2, at 843.

12. See *id.* at 848-51.

13. *Id.* at 855; see S. 269, 26th Cong. (1841) (entitled "A bill for promoting the progress of useful arts, by securing the right of invention and copy-right to proprietors of new designs for manufactures, for limited times").

Parliament had recently passed.¹⁴ Through a combination of political maneuvering and political self-dealing, parties closely associated with the Patent Office helped transform the proposed design patent legislation into a patent rather than copyright system,¹⁵ and it has remained in this form ever since.¹⁶

Design patents cover “any new, original and ornamental design for an article of manufacture.”¹⁷ By explicit statutory provision, they are subject to the same requirements as utility patents,¹⁸ such as novelty and nonobviousness, although those requirements may differ slightly in the design patent context.¹⁹ In addition, a design must be “original” to be patented, which is often understood as analogous to the copyright meaning of that term.²⁰ Regarding subject matter, design patents are intended to protect ornamental features rather than function itself.²¹ Very early, the Supreme Court emphasized that design protection encompasses “not so much utility as appearance.”²² The scope of protection of a design patent is defined by a single claim, which is often expressed as a short phrase and one or several drawings.²³ Notably, the standard for infringement for design patents differs from that for utility patents.²⁴ Under the design patent statute, infringement arises when a party:

1. applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or
2. sells or exposes for sale any article of manufacture to which such design or

14. Du Mont & Janis, *Origins*, *supra* note 2, at 859-61.

15. *Id.* at 864-68.

16. See Mueller & Brean, *supra* note 9, at 451-52 (“[T]he square peg of design was forced into the round hole of the utility patent system with its associated complexities and costs, where it remains today.”).

17. 35 U.S.C. § 171 (2011).

18. *See id.* (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

19. See Matthew A. Smith, Design Patents 57-74 (Dec. 17, 2012) (preliminary draft), available at http://www.patentlyo.com/2012-12-17_design_patents.pdf.

20. *See id.* at 52; Feist Publ’ns. v. Rural Tel. Serv. Co., 499 U.S. 340, 346 (1991) (defining originality in the copyright context as encompassing “independent creation plus a modicum of creativity”).

21. Not surprisingly, defining “ornamental” has proven quite controversial. See Jason J. Du Mont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTELL. PROP. L. 261, 264-69 (2012) [hereinafter Du Mont & Janis, *Functionality*].

22. Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 524 (1871).

23. Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (“[A]s a rule the illustration in the drawing views is its own best description.” (alteration in original) (quoting U.S. PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1503.01 (8th ed., Aug. 2006))).

24. Compare 35 U.S.C. § 289 (2011), with 35 U.S.C. § 271 (2011). The Federal Circuit recently clarified the standard for infringement in design patent cases, eliminating the “point of novelty” test as an independent criterion of infringement. *Egyptian Goddess*, 543 F.3d at 678.

colorable imitation has been applied . . .²⁵

In 1871, the Supreme Court influentially interpreted the standard of infringement in *Gorham Co. v. White*:

[I]f, in the eye of the ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.²⁶

Turning to remedies, design patent law incorporates all of the remedies available to prevailing parties in utility patent litigation.²⁷ In addition, design patents have a unique provision allowing a patentee to recover a defendant's "total profit" based on infringement.²⁸

In elucidating design patents, it is useful to explore some high-level differences between this intellectual property regime and copyrights, trademarks, and utility patents, which also protect elements of design.²⁹ While design patents and copyrights are both limited to nonfunctional subject matter, the definition of functionality is broader in copyright than it is in design patent law.³⁰ In addition, the threshold for protection is lower for copyrights than for design patents; copyrights arise upon fixing original expression in a tangible medium while design patents are subject to an application and examination process mediated by the Patent and Trademark Office (PTO).³¹ Furthermore, as noted, design patents must satisfy the relatively rigorous standards of novelty, utility, and nonobviousness.

Design patents also differ from trademarks and trade dress in important ways. These regimes are similar in that their respective tests for infringement consider consumer deception.³² However, while neither trademarks nor design

25. 35 U.S.C. § 289.

26. *Gorham*, 81 U.S. (14 Wall.) at 528.

27. See 35 U.S.C. §§ 171, 284.

28. 35 U.S.C. § 289.

29. This Part will examine some of these differences in greater detail below.

30. See *infra* notes 60-62 and accompanying text. Compare *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (asserting a broad conception of functionality in the copyright context that covers design elements that arise from *any* functional influence), with *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (asserting a narrow conception of functionality in the design patent context that only covers elements "dictated by function").

31. Compare *Feist Publ'n. Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 355 (1991) ("The two fundamental criteria of copyright protection [are] originality and fixation in a tangible form." (alteration in original) (quoting H.R. REP. NO. 94-1476, at 51 (1976))), U.S. PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (8th ed. Rev. 9, Aug. 2012) [hereinafter MPEP] (describing the examination process for design patent applications as well as the requirements of ornamentality, novelty, nonobviousness, enablement, and definiteness), available at <http://www.uspto.gov/web/offices/pac/mpep/index.html>.

32. See *Monseau*, *supra* note 1, at 530. Compare *Richardson v. Stanley Works, Inc.*,

patents protect functional material, the definition of functionality is broader for trademarks than for design patents.³³ Furthermore, while designs must satisfy the relatively high standards mentioned above to be patented, the primary threshold for obtaining a trademark is distinctiveness.³⁴

Finally, notwithstanding their similar names, design patents differ from utility patents in a variety of respects. Regarding subject matter, utility patents cover functional technologies while design patents cover ornamental (nonfunctional) designs. Furthermore, utility patents typically contain numerous textual claims, while design patents generally contain only a single claim comprised of a drawing. In addition to several other differences, the term of protection is shorter for design patents (fourteen years) as compared to utility patents (twenty years).³⁵ In practical terms, design patents are also much faster and cheaper to obtain than utility patents; it takes on average fourteen months to obtain a design patent,³⁶ in contrast to the daunting average wait of almost three years to obtain a utility patent.³⁷

Parties have used design patents to protect many aspects of industrial design. Historically, design patents have covered everything from the ornamental handles of silverware³⁸ to the shape of saddles³⁹ to the modernist design of a microwave oven.⁴⁰ In contemporary times, the significance of design patents has been somewhat limited to certain niche industries, such as

597 F.3d 1288, 1295 (Fed. Cir. 2012) (holding that a design patent is infringed if “an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design”), *with Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407-08 (Fed. Cir. 1997) (requiring a plaintiff in a trade dress cause of action to show that “the asserted trade dress (1) is not functional, (2) is inherently distinctive or has acquired distinctiveness through secondary meaning, and (3) is likely to cause confusion with defendant’s products”).

33. *See Smith, supra* note 19, at 12-13.

34. Compare 15 U.S.C. § 1052(f) (2011) (“Except as expressly excluded in [various subsections], nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”), *with 35 U.S.C. § 171* (listing the design patent requirements of novelty, originality, and ornamentalism, and stating that requirements relating to utility patents shall apply to design patents, except as otherwise provided).

35. Compare 35 U.S.C. § 173 (establishing a fourteen-year term for design patents), *with 35 U.S.C. § 154(a)(2)* (establishing a twenty-year term for utility patents).

36. U.S. PATENT AND TRADEMARK OFFICE, DESIGN PATENTS JANUARY 1988-DECEMBER 2012: A PATENT TECHNOLOGY MONITORING TEAM REPORT 1 (Mar. 2013), available at <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.pdf>.

37. U.S. PATENT AND TRADEMARK OFFICE, PERFORMANCE AND ACCOUNTABILITY REPORT FISCAL YEAR 2012, at 22 (2012) (indicating an average total pendency of 32.4 months for utility patent applications), available at <http://www.uspto.gov/about/stratplan/ar/USPTOFY2012PAR.pdf>.

38. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871).

39. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893).

40. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (4th Cir. 1984).

shoes and furniture.⁴¹ More recently, however, design patents have increased in importance, due in part to a 2008 en banc Federal Circuit opinion that made it easier to prove design patent infringement.⁴²

As suggested above, design patents have been particularly important in protecting aspects of smartphones and tablets. In *Apple v. Samsung*, Apple accused Samsung of infringing four design patents covering: 1) the minimalist face of an iPhone, front speaker slot, and edge-to-edge glass of the front display;⁴³ 2) the minimalist face of an iPhone, home button, and rounded corners;⁴⁴ 3) the layout of Apple's graphical user interface, including a grid of home screen icons with a band of "permanent" apps at the bottom;⁴⁵ and 4) the basic design of an iPad, including flat front and back surfaces, rounded corners, a thin bezel, an edge-to-edge front glass display, and a generally minimalist aesthetic.⁴⁶ Notably, these design patents cover both physical as well as electronic aspects of look and feel, meaning both the physical shape of various devices as well as the graphical user interface that consumers use to interact with them. Apple's \$1.05 billion jury verdict against Samsung, some of which is attributable to design patent infringement, suggests that firms will place even greater emphasis on design patents going forward.⁴⁷

41. Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1356 (1987) ("[D]esign patent remains a Cinderella who never goes to the ball."); Edward R. Ergenzer Jr., *The American Inventor's Protection Act: A Legislative History*, 7 WAKE FOREST INTELL. PROP. L.J. 145, 149 (2006) ("Except for certain fields such as the furniture industry, a design patent is typically worthless when attempting to commercialize a product.").

42. See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc) (eliminating the "point of novelty" test as an independent requirement of proving infringement); George C. Lewis, *Design Patents, A Tool Being Redesigned for the 21st Century*, 84 Pat. Trademark & Copyright J. (BNA) 1082 (Oct. 26, 2012).

43. U.S. Patent No. D618,677 S (filed Nov. 18, 2008).

44. U.S. Patent No. D593,087 S (filed July 20, 2007).

45. U.S. Patent No. D604,305 S (filed June 23, 2007).

46. U.S. Patent No. D504,889 S (filed Mar. 17, 2004); see Christopher V. Carani, *Apple v. Samsung: Design Patents Take Center Stage*, LANDSLIDE, Jan.-Feb. 2013, at 26.

47. See Daniel Fisher, *Apple's Samsung Victory Shows Patents Aren't Just for Inventions Anymore*, FORBES (Aug. 27, 2012), <http://www.forbes.com/sites/danielfisher/2012/08/27/apples-samsung-victory-shows-patents-arent-just-for-inventions-any-more>. As noted, this award was subsequently reduced. See text accompanying *supra* note 1. Design patents have been particularly important to Apple's strategy. While 2.7% of patents granted to technology companies are design patents, such patents comprise 13.4% of Apple's 5,432 patents. Peter Burrows, *Apple v. Samsung: Can Look and Feel Be Patented?*, BLOOMBERG BUSINESSWEEK (Aug. 1, 2012), <http://www.businessweek.com/news/2012-08-01/apple-v-samsung-can-look-and-feel-be-patented>. In the fifteen years between 1997 and 2012, the number of design patents granted almost doubled from 11,414 to 21,951. *U.S. Patent Statistics Chart*, U.S. PAT. & TRADEMARK OFF. (June 7, 2013), http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm.

B. *The Expansive Nature of Design Patent Protection*

While Congress intended design patents to fill a gap left by other intellectual property regimes, they are subject to some limitations relative to copyrights, trademarks, and utility patents. First, relative to copyrights and trademarks, the process of obtaining a design patent involves considerable expense, effort, and delay. Obtaining copyrights and trademarks is rather trivial. Copyright protection attaches upon fixation of original expression in a tangible medium,⁴⁸ and trademark rights are available through relatively expeditious registration⁴⁹ and may even arise without registration merely by using a mark in commerce.⁵⁰ Design patents are only granted after substantive examination by the PTO, a process that can take several thousand dollars and over a year to complete,⁵¹ though this process is less expensive and faster for design patents relative to utility patents.

Second and relatedly, the substantive standards of obtaining a design patent are relatively high compared to copyright and trademark. The thresholds necessary to obtain a copyright (originality) and trademark (distinctiveness) are relatively easy to satisfy.⁵² However, design patents must satisfy all of the substantive requirements of utility patents (such as novelty, utility, and nonobviousness)⁵³ as well as be “ornamental.” The requirement of nonobviousness is a particularly high hurdle to overcome.⁵⁴ Analogously to utility patent law, the nonobviousness of a design is assessed from the perspective of an ordinary designer, not an untrained, ordinary observer.⁵⁵ In utility patent law, a debate raged for years over whether one must show some “teaching, suggestion, or motivation” to combine references in the prior art in order to demonstrate that some claimed invention was obvious.⁵⁶ In 2007, the Supreme Court in *KSR v. Teleflex* rejected a strict application of the so-called “TSM test,” noting that implicit motivations and market trends could render a

48. 17 U.S.C. § 102(a) (2011).

49. See 15 U.S.C. § 1051(a) (2011).

50. See 15 U.S.C. § 1125(a) (2011).

51. See U.S. PATENT AND TRADEMARK OFFICE, *supra* note 36, at 1 (“[T]he average time period between filing for a design patent and the issuing of that patent . . . has been about 14 months.”); Monseau, *supra* note 1, at 530.

52. See *Feist Publ’ns. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (defining an “original” work as one that is independently created and exhibits a modicum of creativity); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (noting that anything that can designate source can function as a trademark).

53. See 35 U.S.C. § 171 (2011).

54. See *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (providing a framework for nonobviousness analyses for design patents).

55. See *In re Nalbandian*, 661 F.2d 1214, 1216-17 (C.C.P.A. 1981).

56. See *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999); Peter Lee, *Patent Law and the Two Cultures*, 120 YALE L.J. 2, 35-39, 51-56 (2010).

particular claimed invention obvious.⁵⁷ While *KSR* made it more difficult to establish nonobviousness for utility patents, its implications for design patents remain unclear.⁵⁸ Some design patent cases hew closer to the traditional requirements of the TSM test, suggesting that there may be a somewhat easier standard for obtaining a design patent compared to a utility patent.

Finally, another clear limitation of design patents is their relatively short term of protection. Design patents grant exclusive rights for fourteen years, which is far less than the potential terms of copyrights (the life of the author plus seventy years) and trademarks (as long as the mark distinctively identifies a source). It is even shorter than the term of protection for utility patents (twenty years from the date of filing). All of these limitations tend to blunt the exclusionary force of this intellectual property regime.

Although design patents are in some ways more constrained than their intellectual property siblings, on balance they provide expansive protection for designs and lack important limitations found in copyright, trademark, and utility patent law. For example, the safeguard against protecting functional matter is quite limited in design patents. As in several other fields, design patents are not intended to cover functional elements. Indeed, the Federal Circuit's recent opinion in *Egyptian Goddess v. Swisa* holds that courts should separate functional from nonfunctional elements in design patent claim construction.⁵⁹ However, the definition of functionality is narrower in design patents compared to copyrights, thus broadening the potential scope of protection. In copyright law, an aesthetic element of a useful article is protectable if it is physically or conceptually separable from the functional aspects of a work. This is a difficult standard to satisfy, for design elements must arise from "artistic judgment exercised *independently* of functional influences" in order to be separable and thus protectable under copyright.⁶⁰ In the design patent context, however, the definition of functionality is narrower,

57. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 402 (2007).

58. See *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1384-85 (Fed. Cir. 2009); Mueller & Brean, *supra* note 9, at 507-11; Smith, *supra* note 19, at 69.

59. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc) ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent." (quoting *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997))). This practice is problematic, however, given that functionality is a question of fact whereas claim construction is a question of law. See Shin Chang, *The Proper Role of Functionality in Design Patent Infringement Analysis: A Criticism of the Federal Circuit Decision in Richardson v. Stanley Works, Inc.*, 19 TEX. INTELL. PROP. L.J. 309, 321 (2011).

60. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (emphasis added); see generally Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983) (discussing physical and conceptual separability in copyright).

leaving more room for protectability. Although there is some doctrinal controversy as to the exact standard of functionality,⁶¹ a prominent test holds that an element is only functional (and thus not protectable by a design patent) if it is “dictated by function.”⁶² Because it is relatively easy to find *some* nonfunctional motivation for a design, it is relatively easy to avoid being characterized as functional, thus widening the scope of protection in the design patent context.

Furthermore, design patent law lacks the concept of “aesthetic functionality” in trademark law that tends to limit protection.⁶³ In the trademark context, several courts have noted that the appearance of a product may be functional and thus not protectable if the design is why people buy the product, rather than just an indicator of source.⁶⁴ Thus, if the design of an iPhone or iPad signals “cool” rather than “Apple,” and constitutes a look and feel that consumers want regardless of the source of the product, then under a theory of aesthetic functionality Apple could not get trademark or trade dress protection in its minimalist design. Design patent law also prohibits protection of “functional” elements, but it lacks any recognition that appearance alone, perhaps bolstered by consumer expectations, may also be functional.⁶⁵ Design patents are also more capacious than trademarks in the infringement context. While both bodies of law consider consumer confusion or deception, the test for infringement in design patents is less contextually sensitive, thus leaving greater room to recognize infringement.

Finally, in important ways, design patents are more capacious than utility patents. As mentioned, design patent prosecution is faster and less expensive

61. One must proceed cautiously here, for the Federal Circuit has on occasion articulated different standards for functionality: a categorical test that recognizes functionality when some design is “dictated by” functional considerations, and a balancing test that reaches the same conclusion when a design element is “primarily functional.” See Du Mont & Janis, *Functionality*, *supra* note 21, at 281; Perry J. Saidman, *Functionality and Design Patent Validity and Infringement*, 91 J. PAT. & TRADEMARK OFF. SOC’Y 313, 314 (2009); Perry J. Saidman & John M. Hintz, *The Doctrine of Functionality in Design Patent Cases*, 19 U. BALT. L. REV. 352, 353 (1989).

62. Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1378 (Fed. Cir. 2002) (“[T]he design of a useful article is deemed functional where ‘the appearance of the claimed design is ‘dictated by’ the use or purpose of the article.’” (quoting L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993)); see Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 148 (1989) (“To qualify for [design patent] protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone.”). A design patent owner can show that a claim is nonfunctional by showing that alternate designs perform the same function. See *Rosco*, 304 F.3d at 1378.

63. See Brown, *supra* note 41, at 1367-68.

64. See, e.g., Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 164 (1995) (noting that anything that can designate source can function as a trademark).

65. As one commentator notes, adoption of the concept of aesthetic functionality “would probably eliminate most design patents.” Matthew Nimetz, *Design Protection*, 15 COPYRIGHT L. SYMP. 79, 116 (1967).

than utility patent prosecution. Furthermore, the damages available for design patent infringement may be significantly higher than those arising from utility patent infringement. In the context of integrated technological products that infringe several utility patents, such as semiconductors, courts endeavor to apportion infringement damages based on the rough economic contribution of a component patent to the broader product. However, successful plaintiffs in design patent litigation may recover an infringer's "total profit," even where the infringed design accounts for very little of the economic value of the broader, integrated product. As Mark Lemley has argued, this lack of apportionment may vastly overcompensate design patentees and impose undue costs on infringers.⁶⁶

II. A THEORETICAL APPRAISAL OF DESIGN PATENTS: JUSTIFICATIONS AND LIMITATIONS

This Part builds upon the previous doctrinal discussion by focusing on the theoretical foundations of design patent law. Outside of the statutory prerogative to promote the progress of the decorative arts, articulations of the purpose and theory of the design patent system are relatively scarce. This Part draws from statute, doctrine, legislative history, and scholarly commentary to examine several theories that parties have put forth to justify exclusive rights in the design of manufactured articles. Consistent with the dominant justification of most intellectual property law, design patents are often understood as motivated primarily by a utilitarian objective of strengthening incentives to create new, original designs. This traditional "incentives thesis" assumes a particular meaning in the design patent context, for exclusive rights are intended to produce designs that beautify the human environment. In addition to these utilitarian rationales, commentators have also invoked fairness and Lockean labor theory to justify exclusive rights in design. Finally, design patent law also contains inflections of trademark-related interests in preventing consumer deception and maintaining distinctiveness in the marketplace. We show in this Part that, taken at face value, these varied theories for design patent protection both justify exclusive rights as well as suggest limitations that the current doctrine does not possess.⁶⁷ Going further, we identify tensions within and between these competing theories and question whether any of them adequately justify exclusive rights for fourteen years in the "look and feel" of

66. Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 224-32 (2013).

67. This examination of the origins and purpose of design patents, moreover, calls into question whether design protection should arise from a copyright-like or patent-like system, an issue that others have explored. See Du Mont & Janis, *Origins*, *supra* note 2, at 875-79 (criticizing the primacy of claiming and comparisons with the prior art, which are classic patent functions, in protecting design).

popular commercial goods.

A. Incentives to Create

The dominant theoretical justification for most intellectual property in the United States, particularly patents and copyrights, is utilitarian: the law grants exclusive rights in order to maintain incentives to create.⁶⁸ As its namesake suggests, design patents share with utility patents the objective of maintaining incentives to create.⁶⁹ However, in the case of design patents, exclusive rights are aimed at creating new, original, ornamental designs. The utilitarian nature of design patents is expressed in the foundational Supreme Court case of *Gorham v. White*, which observed that statutes creating design patents “were plainly intended to give encouragement to the decorative arts.”⁷⁰ Legislative history⁷¹ and scholarly commentary⁷² have echoed this utilitarian rationale. Of course, “progress” is a rather nebulous term admitting of multiple meanings. From one perspective, progress may involve achieving a higher level of aesthetic value. In this sense, design patents are distinct from utility patents in that the goal is not increasing functionality, but beauty.⁷³ From another perspective, progress may simply involve a proliferation of new and different designs. In this sense, design patents incentivize unorthodox thinking,⁷⁴ as

68. Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1031 (2005) (“Intellectual property protection in the United States has always been about generating incentives to create.”) [hereinafter Lemley, *Free Riding*].

69. See U.S. CONST. art. I, § 8, cl. 8 (empowering Congress “[t]o 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”).

70. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 524 (1871); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (*Gorham* represents “[t]he starting point for any discussion of the law of design patents”); Robert W. Brown & Co. v. De Bell, 243 F.2d 200, 202 (9th Cir. 1957) (“It is true that the purpose of Congress in authorizing the grant of design patents was to give encouragement to the decorative arts.”); see also HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS SHOWING THE OPERATION OF THE PATENT OFFICE DURING THE YEAR 1841, H.R. DOC. NO. 27-74, at 2 (1842) [hereinafter ELLSWORTH REPORT] (“Competition among manufacturers for the latest patterns prompts to the highest effort to secure improvements, and calls out the inventive genius of our citizens. . . . If protection is given to designers, better patterns will, it is believed, be obtained, since the impossibility of concealment at present forbids all expense that can be avoided.”). But see *Du Mont & Janis*, *supra* note 2, at 845 (characterizing *Gorham*’s rationale as “a placeholder recitation” and questioning its value in determining the appropriate scope and structure of a design patent right).

71. E.g., S. COMM. ON PATENTS, REPORT TO ACCOMPANY BILL S. 1813, S. REP. NO. 49-206, at 1 (1886) (“Property in original designs . . . is a property of great and increasing value, intimately related to material progress in the industrial arts.”).

72. E.g., Saidman & Hintz, *supra* note 61, at 357 (observing that the purpose of design patents is “to promote the decorative arts”).

73. See *infra* Subpart II.B.

74. Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Design*

epitomized by design maverick Apple's slogan, "Think different."

It is important to note, however, that incentive rationales both justify exclusive rights in design as well as counsel limiting those rights. The dominant utilitarian rationale for design patents embodies the intrinsic tradeoffs at the heart of much intellectual property law. Design patents may (and this is an empirical question) induce the creation of new ornamental designs, but they do so at the expense of raising costs and decreasing access to such designs.⁷⁵ This is particularly problematic given the nonrival nature of designs; design patents create artificial scarcity in an otherwise inexhaustible resource. Looking beyond such "static" allocational inefficiency⁷⁶ to "dynamic" inefficiency, a proliferation of exclusive rights on designs may contribute to innovation-dampening anticommons regimes or patent thickets,⁷⁷ thus preventing the emergence of new designs.⁷⁸ The chilling effects of design patents can even extend beyond the decorative arts to impede technological innovation as well; if Samsung is prevented from marketing a new, technologically advanced smartphone because that phone infringes Apple's design patents, Samsung's incentive to invest in technological innovation is seriously diminished. Design patents thus implicate traditional intellectual property concerns over enabling monopolies, restricting freedom to operate, and curtailing follow-on innovation. Turning to aesthetic considerations, the principle of awarding design patents to help beautify the human environment, while compelling, suggests more stringent screening of design patents along this metric.⁷⁹ Otherwise, design patents may have the perverse effect of inducing the creation of bland, ugly designs that crowd out designs possessing greater aesthetic

Protection in the European Union, 24 AIPLA Q.J. 611, 630-31 (1996) ("Lack of protection for those who assume risk and discard the shackles of orthodoxy contributes to design conservatism, and to the banality that such conservatism inevitably engenders.").

75. Interestingly, the legislative history of revisions to the design patent statute from 1886 suggests that design patents may actually *decrease* the cost of articles of manufacture. H.R. REP. NO. 49-1966, at 3 (1886), reprinted in 18 CONG. REC. 834 (1887) ("It was also shown that the effect of design patent laws was to cheapen production and so ultimately reduce prices, because it enabled the manufacturer to run longer on a given design than he otherwise could, and thus avoiding machinery."). This rationale, however, depends on very high fixed costs of producing new designs, which are arguably lower in an era of more modular manufacturing techniques.

76. Lemley, *Free Riding*, *supra* note 68, at 1053.

77. Cf. Michael A. Heller & Rebecca S. Eisenberg, *Can Patents Deter Innovation? The Anticommons in Biomedical Research*, 280 SCIENCE 698, 698-701 (1998); Carl Shapiro, *Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard Setting*, 1 INNOVATION POL'Y & ECON. 119, 120 (2001).

78. By one estimate, upwards of 250,000 utility and design patents may cover technical and ornamental aspects of a smartphone. See Steve Lohr, *Apple-Samsung Case Shows Smartphone as Legal Magnet*, N.Y. TIMES (Aug. 25, 2012), <http://www.nytimes.com/2012/08/26/technology/apple-samsung-case-shows-smartphone-as-lawsuit-magnet.html>.

79. But see Du Mont & Janis, *Functionality*, *supra* note 21, at 264 (criticizing "unconstrained judicial speculation into artistic merit").

merit.⁸⁰

The central problem with the incentives rationale for design patents is that the oft-repeated mantra of incentives has weak empirical support. Commentators have long argued that the United States' relatively limited protection for design has threatened to undermine global leadership and competitiveness in this area.⁸¹ But it is an open question whether and to what extent design patents are necessary to induce innovation in design.⁸² Critics, including courts, point to manufacturers' natural incentives to develop new designs and consumer experiences, particularly in today's economy where product quality is easily and cheaply replicated. Design is an increasingly important determinant of value in the modern economy, where the look and feel of a product or service is critical for creating market distinction.⁸³ This is clear, for example, from Apple's business strategy. Courts have recognized that design patents are not necessary to spur the kind of ordinary design innovation that companies engage in as standard business practice. As one skeptical court noted, design patent law "was never intended to grant a monopoly just for the purpose of stimulating the natural instincts of mankind to make goods and merchandise attractive."⁸⁴ In short, market incentives, such as natural competitive imperatives to differentiate and enhance one's products, first-

80. One empirical study suggests that over the past several decades, the Federal Circuit has tended to place less emphasis on aesthetics in determining the validity of design patents. Andrew W. Torrance, *Beauty Fades: An Experimental Study of Federal Court Design Patent Aesthetics*, 19 J. INTELL. PROP. L. 389, 390 (2012) ("[Courts] seem not to discriminate between attractive and unattractive designs in terms of validity."); *see also* Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1350 (Fed. Cir. 2005) (criticizing the claiming of an "aesthetically pleasing" feature as subjective and indefinite); Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 526 (2012).

81. See David Goldenberg, *The Long and Winding Road, A History of the Fight over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC'Y U.S.A. 21, 21-22 (1997) ("[M]any critics feel that it is the hostile legal environment faced by American designers which has caused the United States to lag behind European and Asian countries in design innovation, even during a period in which the United States has dominated in other areas of protection."); Monseau, *supra* note 1, at 497; cf. J.H. Reichman, *Design Protection and the Legislative Agenda*, 55 L. & CONTEMP. PROBS. 281, 282-83 (1992) (arguing for new design protection legislation).

82. See generally Nimetz, *supra* note 65, at 128-29 (outlining arguments against the incentive rationale for design patent protection and concluding that "[e]conomic considerations . . . militate generally against design protection in any form"); Mueller & Brean, *supra* note 9, at 426 ("Leading industrial designers view the current U.S. design patent system as a failure.").

83. See, e.g., Monseau, *supra* note 1, at 501-02.

84. Charles Boldt Co. v. Turner Bros. Co., 199 F. 139, 141 (7th Cir. 1912); *id.* at 623-25 ("It is, of course, extremely difficult to mark the line at which symmetry and attractiveness cease to be matters of good taste and become touched with a spark of inventive genius. . . . Invention calls for more than the exercise of a mere desire to please for mercenary ends.").

mover advantage, and the search for the elusive (and commercially valuable) designation of being “cool” all motivate investments in design without the need for formal exclusive rights.⁸⁵ Recall that similar critiques arose around the rise of business method and software patents, which commentators suggested were unnecessary and even counterproductive.⁸⁶

Furthermore, there are compelling arguments that design innovation flourishes better *without* intellectual property protection rather than with it. Recently, scholars have persuasively argued that incentives in the form of exclusive rights may be particularly misplaced in the context of fashion design. As Kal Raustiala and Christopher Sprigman remind us, the fact that people are constantly craving something new in fashion pushes against the need for intellectual property protection in this industry, though perhaps not in others.⁸⁷

The standard utilitarian account applied to design patents has additional weaknesses. Patents involve a “quid pro quo”—they encourage companies to develop useful products and methods faster and to disclose knowledge about their inventions to benefit science more broadly. Design patents do not fit well within this paradigm. To begin with, design patents provide *no disclosure benefit*, as designs, once sold, are immediately known to all.⁸⁸ Secondly, designs, it can be argued, “do not present the same urgency; consequently we need not offer a government bounty in order to hurry up advancement in the

85. See, e.g., Nimetz, *supra* note 65, at 128-29 (“The economic case for design protection is a weak one at best. There is no need in the present economy to provide extramarket inducements to encourage the manufacture of more attractive goods; the market mechanism, the producers’ desire to differentiate goods, the public’s preference for variety, and the integration of designing into the production process are sufficient to ensure the maintenance of a high level of design activity.”); cf. Lauren Fisher Kellner, *Trade Dress Protection for Computer User Interface “Look and Feel,”* 61 U. CHI. L. REV. 1011, 1014 (1994) (noting that copyrights are not necessary to create new computer interfaces, as the market provides robust incentives for manufacturers to do so).

86. See *Bilski v. Kappos*, 130 S. Ct. 3218, 3254 (2010) (Stevens, J., concurring) (“Many have expressed serious doubts about whether patents are necessary to encourage business innovation.”); Rochelle Cooper Dreyfuss, *Are Business Method Patents Bad for Business?*, 16 SANTA CLARA COMPUTER & HIGH TECH. L.J. 263, 274 (2000); Robert P. Merges, *As Many as Six Impossible Patents Before Breakfast: Property Rights for Business Concepts and Patent System Reform*, 14 BERKELEY TECH. L.J. 577, 582 (1999) (questioning the need for patent-based incentives to encourage the development of business methods); John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1181 (1999).

87. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Intellectual Property and Innovation in Fashion Design*, 92 VA. L. REV. 1687, 1775 (2006) (arguing that despite the lack of design protection in the United States “the fashion industry continues to create new designs on a regular basis”); cf. C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1170-84 (2009) (discussing threat of “fast fashion” copyists like Forever 21 to fashion innovation).

88. Nimetz, *supra* note 65, at 129 (“There is no need to provide a special inducement in order to encourage disclosure because designs by their nature are fully public once displayed.”).

applied arts; we can let popular desires, as reflected in the market, set the rate of change.⁸⁹ This argument, of course, cuts both ways. The fact that designs may be ultimately less vital than utilitarian products suggests on the one hand that they ought not to be protected by exclusive rights at all; on the other hand, it could also justify exclusive rights because the social consequences of such rights in design may be minimal compared to utility patents.⁹⁰ But we disagree that design patents have limited social harm. Design patents raise prices and reduce access to contemporary styles, products, and technologies, as the *Apple v. Samsung* litigation reveals. Furthermore, design patents can enforce rigid status hierarchies anathema to democratic society, as we explain further below.

B. Aesthetic Benefits

Commentators have also justified design patents as enhancing consumer welfare by stimulating the creation of beauty and pleasure alongside the creation of new goods.⁹¹ As one early observer characterized the social and psychological value of design:

In a civilized state men have sufficient leisure and affluence to concern themselves with more than the bare necessities of survival. They can afford to make ordinary things-tools, utensils, shelters-more pleasing aesthetically as well as more efficient technically. And societies are measured, as much as we can ever measure societies, for their artistic accomplishments as well as for their technical achievements. It is therefore no exaggeration to assert that the promotion of the arts, particularly such applied arts as architecture and design, is a traditional and important social endeavor.⁹²

Gorham underscores this emphasis on aesthetic merit, noting that “it is the effect upon the eye which adds value to articles of trade or commerce.”⁹³ Similarly, an early court observed that the object of design patents “is to encourage works of art and decoration which appeal to the eye, to the esthetic emotions, to the beautiful.”⁹⁴ Yet another court noted that the goal of design

89. *Id.* at 103.

90. *Id.* at 129 (“There is no need to concern ourselves with speeding ‘progress’ in the field of applied design because first, it is relatively unimportant even if we could define it, and second, we have at best only a vague notion of what such progress is; moreover, if there is such a thing as important innovation in design, it comes from major conceptual and structural breakthroughs and not from the proliferation of shapes and forms.”).

91. See, e.g., Franklin Lamp Mfg. Co. v. Albe Lamp & Shade Co., 26 F. Supp. 960, 960 (E.D. Pa. 1939) (“[T]he design must be a thing of beauty which is a joy forever.”); see also ANTHONY WILLIAM DELLER, DELLER’S WALKER ON PATENTS § 160, at 752 (2d ed. 1964) (“The term ‘ornamental’ as applied to designs relates to something beautiful, something giving a pleasing appearance, something which appeals to the aesthetic emotions or has artistic merit.”).

92. Nimetz, *supra* note 65, at 104.

93. Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 526 (1871).

94. Rowe v. Blodgett & Clapp Co., 103 F. 873, 874 (Cir. Ct. D. Conn. 1900), quoted

patents is “to eliminate ‘much of the unsightly repulsiveness that characterizes many machines.’”⁹⁵ To be protected by a design patent, “a design must present an aesthetically pleasing appearance.”⁹⁶ Conversely, Judge Learned Hand famously rejected protection in the design of a tricycle, deeming that the cycle had “neither proportion, ornament, nor style.”⁹⁷ Legislative history from 1871 revisions to the design patent statute also reflect this interest in beautifying manufactured goods: “So far as the *consumers* are concerned, the effect of design patent laws . . . is to give them more beautiful carpets and wall-papers and oil-cloths for the same money. . . .”⁹⁸

Contemporary design theory recognizes that the benefit conferred by good design is not merely utilitarian but also social and psychological.⁹⁹ Design infuses markets with *meaning*. Today, design is a vehicle for catering to consumers’ diverse tastes, preferences, and identities. Design helps to distinguish otherwise comparable products by infusing articles of manufacture with identities and by creating new lifestyles, experiences, and communities.¹⁰⁰ In today’s markets, consumption does not merely satisfy material need, but also emotional and social needs, enabling consumers to signal social status, politics, community, preference, taste, and identity through their purchases.¹⁰¹ Thus there is a democratic element to design, which allows for product

in *Rowe v. Blodgett & Clapp Co.*, 112 F. 61, 62 (2d Cir. 1901); S. REP. NO. 57-1139, at 8 (1902).

95. *Du Mont & Janis, Functionality*, *supra* note 21, at 267-68 (citing *In re Koehring*, 37 F.2d 421, 422 (C.C.P.A. 1930)).

96. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989); *see also* *Rains v. Cascade Indus., Inc.*, 402 F.2d 241, 247 (3d Cir. 1968) (“To be ornamental . . . the design as a whole must produce a pleasing impression on the aesthetic sense.”); *In re Hruby*, 373 F.2d 997, 1001 (C.C.P.A. 1967) (articulating that design is “for the enjoyment of the beholder”); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 696 (2d. Cir. 1961) (stating that design must “be the product of aesthetic skill and artistic conception”).

97. *H.C. White Co. v. Morton E. Converse & Son Co.*, 20 F.2d 311, 312 (2d Cir. 1927). Hand’s conclusion is inconsistent with his earlier declaration in the case that “in aesthetics there are no standards.” *Id.*

98. H.R. REP. NO. 49-1966, at 3 (1886), *reprinted in* 18 CONG. REC. 834 (1887).

99. Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1111 (2008) (“By furthering a product’s aesthetic appearance, design makes a positive contribution to market efficiency because the product increases the consumer’s aesthetic pleasure, aside from its utility. Furthering enjoyment by aesthetic products has a positive value per se, which enhances public welfare”).

100. Tim Brown, *Design Thinking*, HARV. BUS. REV., June 2008, at 84, 92 (“As more of our basic needs are met, we increasingly expect sophisticated experiences that are emotionally satisfying and meaningful Design thinking is a tool for imagining these experiences as well as giving them a desirable form.”).

101. *See Afori, supra* note 99 at 1112 (“[D]esign . . . serves as a means to communicate information, such as cultural values (of taste and style) . . . [and] social values (of environmental impact and equal availability)”).

differentiation to suit various cultural and socioeconomic needs and tastes.¹⁰² Those who create new designs—that is, new ways of knowing and being in the world—seek incentive and reward for conferring such benefit.¹⁰³

At the same time, an interest in furthering the social and psychological benefits of design suggests that property rights in design must be limited in order to ensure democratic access to new standards and to meet consumer expectations. In the fashion world, for example, copyright, trade dress, and utility patents offer limited protection against copying, thereby allowing democratic access to the look and feel of the times. Forever 21 and Ikea help bring beauty and a modern look and lifestyles to ordinary people,¹⁰⁴ not just the upper classes.¹⁰⁵ Indeed, theorists going as far back as John Dewey have argued that there is a popular interest in aesthetic experience.¹⁰⁶ As Barton Beebe explains in a recent article, early aesthetic pragmatists understood aesthetic experience as fundamentally connected to the beauty and art of the everyday, evocative more of popular culture than fine art.¹⁰⁷ We need to consider the social implications of inhibiting access to technologies and aesthetics that come to symbolize a particular time and place.

Of course, not all will agree that Madison Avenue adds value to society. But even if we do agree that beauty and aesthetic pleasure have important social and psychological benefits, it is not necessarily the case that a patent is required to generate this value, as we have discussed above. Critics of design patents argue that market incentives are sufficient to produce beautiful new products and styles each season.¹⁰⁸

Finally, though promoting aesthetic values is laudable, courts may not be well-suited to the task. Judge Hand is an exception; on the whole, judges have

102. See JOHN A. QUELCH & KATHERINE E. JOEZ, GREATER GOOD: HOW GOOD MARKETING MAKES FOR BETTER DEMOCRACY 1-26 (2007).

103. See *id.*

104. See, e.g., Ruth La Ferla, *The Campus as Runway*, N.Y. TIMES (Oct. 12, 2011), <http://www.nytimes.com/2011/10/13/fashion/on-campus-taking-fashion-seriously.html> (describing move away from the traditional garb of sweatpants and t-shirts toward high fashion styles on college campuses).

105. Beebe, *Sumptuary Code*, *supra* note 4, at 812-13; see also Nimetz, *supra* note 65, at 124 (“[T]here is a strong social interest in allowing goods for low-price markets to make use of the advances introduced by more expensive goods.”).

106. See, e.g., JOHN DEWEY, ART AS EXPERIENCE (1934). See generally THORSTEIN VEBLEN, THE THEORY OF THE LEISURE CLASS: AN ECONOMIC STUDY OF INSTITUTIONS (1899).

107. Barton Beebe, *Bleistein*; or, Copyright Law, and the Problem of Aesthetic Progress (unpublished manuscript) (on file with authors) (arguing that pragmatist aesthetics recommends a vision of aesthetic progress that focuses not on the stockpiling over time of fixed, archivable works, but rather on the quality of ephemeral aesthetic experience in the present).

108. See, e.g., Nimetz, *supra* note 65, at 105 (“Because of the importance of attractiveness as a matter of sales technique, the need for a patent as an additional inducement is minimal.”).

been reluctant to make aesthetic judgments in design patent cases. A recent study by Andrew Torrance finds that “both legal doctrine and empirical data reflect a decline in the importance of aesthetic considerations in design patent decisions by federal courts over the last three decades.”¹⁰⁹

In short, beautification may be a worthy goal, but it is still not clear that the promise of a patent is required to produce the desired result. We need better empirical proof of the need for design patents, because there are costs to our democracy of limiting access to design and beauty. Furthermore, aesthetic benefit is a notoriously difficult standard for courts to apply.

C. *Lockean Labor Theory and Fairness*

Design patent protection also has strong roots in principles of fairness and commercial morality. Indeed, a major impetus for the federal design patent statute in the mid-nineteenth century was the plea of design manufacturers complaining that their substantial investments in new designs were being undermined by pirates using the new technologies of the industrial revolution. Designers appealed to Congress with arguments about protecting labor and investment, petitioning that their “new designs and patterns often require a considerable expenditure of time and money, and can be made use of by any person so disposed, in such a manner as to undersell the inventor or proprietor.”¹¹⁰ When Patent Commissioner Henry Ellsworth, the leading proponent of the first design patent statute, addressed these concerns in his Annual Report for 1841, he echoed many of the sentiments in the manufacturers’ petition, including concerns about pirating designs and the ethical need to protect creators.¹¹¹ It is important to recognize that in supporting the idea of a new design patent statute, Commissioner Ellsworth was not simply motivated by utilitarian concerns about promoting the decorative arts, as the conventional wisdom holds. The introduction of federal design patent legislation was a pragmatic response to the deluge of knockoffs in a new economy, as well as a moralistic act that saw copyists as unfairly appropriating value created by designers.¹¹²

109. Torrance, *supra* note 80, at 390.

110. JORDAN L. MOTT ET AL., PETITION OF A NUMBER OF MANUFACTURERS AND MECHANICS OF THE UNITED STATES, PRAYING THE ADOPTION OF MEASURES TO SECURE TO THEM THEIR RIGHTS IN PATTERNS AND DESIGNS, S. DOC. NO. 25-154 (1841).

111. ELLSWORTH REPORT, *supra* note 70, at 2; *see also* Nimetz, *supra* note 65, at 80 n.1 (noting that Patent Commissioner Ellsworth, “like most supporters of design protection, spoke explicitly of the public interest in the creation of superior designs, but made clear also the ethical overtones of his plan to protect creators”).

112. *See* Nimetz, *supra* note 65, at 108 (contending that the argument that designers are unfairly put at the mercy of copiers “is no longer an argument that the public need for designs requires the patent. It is an ethical argument, supporting the claim of producers who create their own designs against producers who imitate the designs of others”).

Fairness operates at several levels in justifying design patents. First, as suggested above, commentators have legitimized design patents under a variant of natural rights or Lockean labor theory in which a designer obtains property rights over a design through exercising his or her creative labor.¹¹³ Indeed, the first design patent statute explicitly limits protection to those who produced new, original designs by “industry, genius, efforts, and expense.”¹¹⁴ In addition, early design patent cases emphasize the creative labors of designers in justifying protection.¹¹⁵ Inflections of labor theory also inform the legislative history of statutory revisions to the design patent statute.¹¹⁶ Second, fairness operates at the level of horizontal equity to justify design patents by placing designers on the same plane as authors and inventors, both of whom receive formal exclusive rights in the form of copyrights and utility patents. Both of these fairness-related sentiments are reflected in the observations of Commissioner Ellsworth: “if authors can so readily find protection in their labors, and inventors of the mechanical arts so easily secure a patent to reward their efforts, why should not discoverers of designs, the labor and expenditure of which may be far greater, have equal privileges afforded them?”¹¹⁷

Fairness in the design patent context also invokes notions of commercial morality, regulating behavior among competitors in a marketplace. Animating design patent protection is the moralistic notion that one party’s appropriation of value created by another is unfair. The Supreme Court’s foundational design patent opinion in *Gorham*, for example, reveals its concern in protecting the substantial economic value created by popular designs. The law’s stated utilitarian rationale notwithstanding, the Court in *Gorham* focused on the enormous commercial value of Gorham’s popular silverware design, which far surpassed the economic value of most other designs of the time.¹¹⁸ Indeed, we may even understand the extensive focus on “appearance” in *Gorham* and its design patent progeny as primarily concerned not with beauty or aesthetic progress, but rather with the *exchange value* that accrues from an object’s design and visual effect. The Court in *Gorham* expressly recognized that design may “enhance” an object’s “salable value [and] may enlarge the demand for

113. See generally ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 2-3 (6th ed. 2012).

114. Patent Act of 1842, ch. 263, § 3, 5 Stat. 543, 543-44.

115. See, e.g., *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679 (1893) (“There must be something akin to genius—an effort of the brain as well as the hand.”).

116. See H.R. REP. NO. 49-1966, at 2 (1886), reprinted in 18 CONG. REC. 834 (1887) (“So far as the designers are concerned they create a property for which they have a right to demand protection.”).

117. ELLSWORTH REPORT, *supra* note 70, at 2.

118. The Court noted “[i]t was testified that the money value of the [Gorham] patent was ‘immense,’ at least \$50,000.” *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 511 n.3 (1871).

it,”¹¹⁹ adding that “[i]t is the effect upon the eye which adds value to articles of trade or commerce.”¹²⁰ To say that a design is “appealing” means that it is commercially successful and more likely to be copied.¹²¹ The Supreme Court made clear the connection between appearance and economic value in *Whitman Saddle*, stating “[i]t is the appearance itself which attracts attention and calls out favor or dislike.”¹²² Design patent law “proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them.”¹²³ Under this view, design patent seeks to prevent the appropriation of one firm’s exchange value by another.

Intellectual property in all forms ought not ignore basic principles of fairness and morality. However, we are concerned about a design patent law that seeks to rest substantially on an “if value, then right” mode of reasoning. First, this reasoning is anathema to the quid pro quo view of patents recognized under U.S. law. The costs of patents—limited access to designs and higher prices—must be justified by a substantial public benefit. To the extent that design patent law is not truly concerned about producing beauty, but protecting popular designs that are lucrative for their producers, this benefit alone may not be enough to counterbalance the high social cost of design patents. Moreover, as the Supreme Court has stated again and again, there is nothing intrinsically immoral about copying. After all, copying plays a highly beneficial role in an innovation framework in which patents and copyrights are (in their ideal form) carefully-crafted exceptions to a default norm of free appropriation.¹²⁴ Indeed, copying is the essence of competition and a free market.

The *Apple v. Samsung* litigation heralds a new age of design. But the high value of design in today’s marketplace, where consumers put a premium on distinctiveness and aesthetics, already provides a powerful incentive for

119. *Id.* at 525.

120. *Id.* at 526.

121. See Michael Hages, *The Design of Design Patents*, CORE 77: DESIGN MAGAZINE & RESOURCE (Aug. 2012), http://s3files.core77.com/blog/images/2012/09/Design_of_Design_patents.pdf (arguing that design patents should seek to capture “the aspects of an overall design that are likely to catch the attention of a copyist or get stuck in someone else’s head and eventually wind up in their own designs”).

122. *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 678 (1893).

123. *Id.*

124. See, e.g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231-32 (1964) (holding that goods not protectable under federal copyright or patent laws are freely copyable and not eligible for protection against copying under state unfair competition laws) *Compo Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964) (“[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain. Here Day-Brite’s fixture has been held not to be entitled to a design or mechanical patent. Under the federal patent laws it is, therefore, in the public domain and can be copied in every detail by whoever pleases.”).

innovation in commercial design without the significant costs of exclusive rights. Recognizing rights in design merely because they have economic value is not only circular—they have value because they are legally protected—but in tension with conventional utilitarian patent theory.

Finally, even if fairness is a valid rationale for design patent rights, it also suggests some intrinsic limitations on such rights.¹²⁵ For instance, fairness suggests proportionality between contribution and reward, which has clear implications for the scope of design patent protection as well as the appropriate measure of remedies upon a finding of infringement. Additionally, fairness demands some recognition of the important role of consumers and the public at large in contributing to the value of new designs.¹²⁶ After all, the value of an innovative design depends not only on the design itself, but on an audience that appreciates and appropriates it. The interests of the community in maintaining access to novel styles and ornamentation, moreover, should factor into the scope and contour of exclusive rights in design.

D. Reducing Consumer Confusion and Promoting Distinctiveness

Finally, courts and commentators have articulated trademark-related justifications for design patents. Indeed, the nexus between design patents and trademarks is so tight that courts sometimes confuse the standards of protectability and infringement from these two bodies of law.¹²⁷ Observers have noted striking parallels between design patents and two of the primary functions of trademarks: reducing consumer confusion and protecting distinctiveness in the marketplace.¹²⁸

Design patent law's concern with reducing consumer confusion is evident in its doctrinal standard for infringement, which considers whether an ordinary observer would be confused between an accused design and the patented design.¹²⁹ At least on its surface, this is very similar to the "likelihood of

125. For example, horizontal equity with inventors and authors suggests that designers should receive some protection but not substantially more than these other types of creators.

126. Cf. Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1588 n.277 (1993) ("[E]ven standard intellectual products . . . will be beneficial only if someone appreciates them; labor is never the only source of value, even for Locke.").

127. See Beebe, *Sumptuary Code*, *supra* note 4, at 863 (citing examples).

128. See, e.g., Smith, *supra* note 19, § B.3, at 12 ("Design patents mimic (and modify) certain concepts from trademark/trade dress law, making the two forms of protection at least abstractly related.")

129. See *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (articulating the infringement standard as whether "an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.").

confusion” standard for trademark infringement.¹³⁰ Some early legislative history of the design patent statute also reveals a trademark-like rationale for protecting designs.¹³¹ While modern design patent law has moved away somewhat from the trademark standard of consumer confusion,¹³² the objective of preventing deception in purchasing decisions still informs the standard of design patent infringement. Further consistent with traditional trademark theory, design patents allow firms to internalize goodwill arising from product quality. In the view of one court, firms obtain design patents to protect their “reputation for innovation or uniqueness,”¹³³ which parallels one of the prime functions of trademarks.¹³⁴

This focus on avoiding consumer deception, however, both justifies design patent protection and suggests limiting it to specific contexts. In particular, it suggests that appropriating someone else’s patented design in a manner that is not likely to result in consumer deception should not constitute infringement. Putting a Samsung logo on the front of a smart phone, for example, ought to minimize consumer confusion potentially resulting from a similar design. Furthermore, in the trademark context, the Ninth Circuit has observed that the consumer confusion standard for infringement limits a trademark holder’s control over mark-related expression, thus mitigating conflicts between trademark law and the First Amendment.¹³⁵ In other words, this rather narrow test for infringement prevents trademarks from undermining important social interests in free expression. Analogously, design patent law’s standard of infringement, which limits exclusive rights to instances of consumer deception, should in theory leave wide berth for expressive interests in the realm of design.

Turning to the maintenance of distinctiveness in the marketplace, Barton Beebe has noted that design patents, as well as proposed legislation to protect apparel designs, “are essentially antidilution laws.”¹³⁶ Within this view, one of the aims of design patents is to maintain distinctiveness through product differentiation; indeed, courts have observed that firms obtain design patents to

130. See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

131. H.R. REP. NO. 49-1966, at 3 (1886), reprinted in 18 CONG. REC. 834 (1887) (“[Design patents create] a tendency to encourage the purchase of articles of standard qualities as opposed to shoddy imitations, which is a true economy in individuals and so in masses.”).

132. See, e.g., *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026 (Fed. Cir. 1986) (“Likelihood of confusion as to the source of goods is not a necessary or appropriate factor for determining infringement of a design patent.”).

133. *Torpso Hockey Int’l, Inc. v Kor Hockey Ltd.*, 491 F. Supp. 2d 871, 882 (D. Minn. 2007).

134. See Beebe, *Sumptuary Code*, *supra* note 4, at 863 (quoting this justification for design patent protection and noting its similarity to trademark doctrine).

135. See *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900-01 (9th Cir. Cal. 2002).

136. Beebe, *Sumptuary Code*, *supra* note 4, at 862.

protect the “uniqueness of [their] designs.”¹³⁷ As Du Mont and Janis observe, the Supreme Court’s discussion of design patents in *Gorham* emphasizes the value of product differentiation by observing that the designer’s act of “giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public.”¹³⁸ Invoking a concept familiar in the utility patent context, the Federal Circuit has observed that design patents provide an incentive for “‘designing around’ patented inventions, thus creating new innovations.”¹³⁹ In another parallel to trademark theory, such distinctiveness functions as a proxy for information about underlying product quality.¹⁴⁰ In particular, consumers lacking the expertise to assess high-tech goods can rely instead on the design of such goods as aesthetic proxies for quality.

While, as a descriptive matter, design patents promote distinctiveness as an end itself, whether or not this is a proper goal of design patents is open to debate. To begin, trademark law already ensures distinctiveness in the marketplace as a means of lowering information costs for consumers. More broadly, Beebe critiques this “sumptuary” function of design patents, which creates “relative” value in terms of distinguishing one good from another rather than the “absolute” value arising from superior technical merit.¹⁴¹ Similarly, critics argue that marketers and designers create false distinctions between similar goods to extract high rents from unwitting customers.¹⁴²

III. RENDERING DESIGN PATENT DOCTRINE MORE ACCOUNTABLE TO THEORY

As the previous discussion reveals, design patents are motivated by myriad theoretical justifications, some of which are in tension with each other.¹⁴³ For example, the objective of encouraging higher degrees of aesthetic merit and

137. *Pac. Furniture Mfg. Co. v. Preview Furniture Corp.* 626 F. Supp. 667, 670 (M.D.N.C. 1985) (finding this true of the plaintiff firm).

138. *Du Mont & Janis, Origins, supra* note 2, at 846; *see also Gorham Co. v. White*, 81 (14 Wall.) U.S. 511, 525 (1871).

139. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 828 (Fed. Cir. 1992).

140. *See Beebe, Sumptuary Code, supra* note 4, at 863. (noting that the tests for protectability in both design patent and trademark law “arguably involve an analysis of distinctiveness”).

141. *Id.* at 868.

142. *See generally* NAOMI KLEIN, NO LOGO (2000); Gary S. Becker & Kevin M. Murphy, *A Simple Theory of Advertising as Good or Bad*, 108 Q.J. ECON. 941 (1993); Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1170-74 (1948); Christina Binkley, *How Can Jeans Cost \$300?*, WALL ST. J. (Jul. 7, 2011), <http://online.wsj.com/article/SB10001424052702303365804576429730284498872.html>.

143. Cf. Buccafusco, *supra* note 80, at 506 (“[D]esign patent law (protecting the visual ornamental features of utilitarian objects) [is] among the most confused and contested areas in IP law.”).

beautifying the human environment may be undermined by the parallel objective of simply encouraging a proliferation of new designs, some of which may be quite bland and unattractive. In a broader sense, the objective of absolute progress in the decorative arts may be undermined by the push toward mere product differentiation that creates distinctions without a difference. Furthermore, the Lockean imperative to reward creative labor by granting strict exclusive rights may conflict with the aim of promoting progress in the decorative arts, as progress may depend on wide access to existing designs.

More importantly, even when taken on their own terms, many of the theoretical justifications for design patents suggest limitations on exclusive rights that the current doctrine does not possess. As discussed, it is unclear whether exclusive rights are even necessary to motivate new designs. Furthermore, progress in the decorative arts may require access as much as exclusivity regarding new aesthetic creations. The objective of beautifying the human environment contains a democratic element that also calls for wide access to ornamental designs. Due regard for the creation of aesthetic value suggests countenancing not only designers, but also the public that appreciates their work.

The mismatch between design patent theory and design patent law creates an opportunity for restructuring the current doctrine, a project that we aim to take up in subsequent work. The ambition of this Article is simply to lay the foundation for such reforms by comprehensively examining and critiquing various theories justifying exclusive rights in design. That being said, some preliminary thoughts on doctrinal reforms for design patents are in order.

Perhaps due to the hodge-podge nature of design patent theory, design patent doctrine lacks the nuanced limitations that balance private and public interests in other legal doctrines protecting design. For example, copyright, trademark, and utility patent law are sensitive in important ways to standardization and consumer expectations. Doctrines such as scenes a faire in copyright, genericide in trademark, and the test for injunctive relief in utility patent law limit protection of expressive works, marks, and even inventions when they become “standard.” While such safeguards are understood as promoting creative, commercial, and technological progress, they are absent from design patent law. In a similar vein, notions of functionality, including aesthetic functionality, play an important role in curbing exclusive rights in trademark; they should play a similarly limiting role in design patent law. Finally, the objectives of design patent law would be better served by adopting greater attentiveness to context, similar to that found in its more mature intellectual property siblings. Preventing consumer confusion, for example, suggests closely tailoring tests for infringement to situations where deception is likely. Like trademark law’s multi-factored determination of infringement or utility patent law’s determination of damages, design patent law should take a more granular, contextual approach to protecting designs, thus advancing the overriding objective of promoting progress in the decorative arts.

CONCLUSION

Historically overshadowed by its intellectual property siblings, design patent law promises to grow substantially in legal and economic significance.¹⁴⁴ The time is ripe for a thorough examination of the theoretical justifications for exclusive rights in design. After comparing design patents to copyrights, trademarks, and utility patents, this Article has drawn upon statute, doctrine, legislative history, and scholarly commentary to provide a comprehensive account of design patent theory. This examination has revealed several theoretical justifications underlying this law, encompassing enhancing incentives to create, beautifying the human environment, promoting fairness, and reducing consumer deception and promoting product differentiation. Some of these theoretical objectives are in tension with each other, suggesting a need to clarify the reasons for why the law grants exclusive rights in design in the first place. More importantly, these various theoretical justifications suggest limitations on design patents that existing doctrine does not possess. Design patents are currently a body of law without clear design. However, careful attention to the theories animating design patents can motivate doctrinal reforms, thus ensuring that design patents play their proper role in the aesthetic, commercial, and legal realms.

144. *See supra* notes 3-4 and accompanying text.

