

## THE CONSTITUTIONALITY OF DESIGN PATENTS

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### ABSTRACT

*Design patents have been part of American law since 1842. In that time, only just over 600,000 design patents have been issued, with more than half of these being granted in the last twenty years. This quantity is dramatically fewer than the number of utility patents issued which is rapidly approaching 9,000,000 issued patents. Possibly because of the low usage of design patents over time, no case law and little literature address the constitutional issues raised by them. This article intends to overcome that shortcoming. Two constitutional aspects of design patents will be examined.*

*First, congressional authority to adopt the design patent laws will be examined. The Constitution in Article I, Section 8, Clause 8 grants Congress specific powers to adopt both patents and copyrights. When a design is examined, it is unclear that it is an invention making its patentability suspect. At the same time, establishing a design as a writing is not problematic, leading to its eligibility for copyright. In this case, the clause itself must be examined to determine if something that qualifies only for copyright protection can nevertheless be granted a patent. The words chosen in the clause, particularly based on the way some of them were used in the Eighteenth Century, suggest that the answer is “no.” Of course, any*

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*historical analysis of the Constitution may prove to be an inaccurate predictor of how modern courts would address an issue, but this analysis does suggest a significant Article I problem for design patents.*

*Second, even if the Article I problem can be overcome, serious First Amendment issues are raised. Unlike a utility patent, design patents are far more likely to have direct impacts on speech. If so, the patent laws would have to accommodate that speech unless there is a compelling governmental need for it to not do so. Copyright law, for example, avoids much of this First Amendment conflict through the recognition of the Fair Use Defense under 17 U.S.C. § 107 which allow society to use copyrighted materials despite the legal protection where important First Amendment issues are raised. Patent law has no such defense, but may need one to avoid constitutional problems.*

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## I. INTRODUCTION

When most people think of patents, they probably will be considering utility patents. These are by far the most numerous kind of patent in the U.S.<sup>1</sup> and are the kind of legal protection obtained by the famous inventors such as Thomas Edison.<sup>2</sup> Utility patents establish rights to an invention<sup>3</sup> that is new,<sup>4</sup> useful,<sup>5</sup> and not just an obvious extension of what has already been invented.<sup>6</sup>

1. See *Table of Annual U.S. Patent Activity Since 1790*, U.S. PAT. & TRADEMARK OFFICE (Mar. 26, 2014, 12:17:45 PM), [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/h\\_counts.htm](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/h_counts.htm) (showing that 8,601,356 utility and 696,093 design patents have been issued by the U.S., over a twelve to one ratio).

2. See, e.g., U.S. Patent No. 307,031 (filed Oct. 21, 1884) (claiming the electrical filament light bulb).

3. 35 U.S.C. § 101 (2012) (“Inventions can be machines, manufacturers, compositions of matter, or methods”). See, e.g. *Diamond v. Charkrabarty*, 447 U.S. 303, 308–09 (1980) (holding patent on bacterium that consumes oil eligible); *id.* at 309 (“The laws of nature, physical phenomena, and abstract ideas have been held not patentable.”). The dividing line between these unpatentable abstract ideas and a patentable invention is enigmatic, at best. See *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (“[W]e must distinguish between patents that claim the building blocks of human ingenuity and those that integrate the building blocks into something more, thereby transforming them into a patent-eligible invention.” (quotation and citation omitted)); *Bilski v. Kappos*, 130 S. Ct. 3218, 3229–31 (2010) (holding patent that claims a method of hedging risks in commodity trading ineligible).

4. See 35 U.S.C. §§ 101-02 (2012). If an invention that is claimed for patent has already been made, it is described as being “anticipated.” See *Structural Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation requires that each element in the patent claim is found in the prior art. See *id.* at 715–16.

5. See 35 U.S.C. § 101 (2012); *Brenner v. Manson*, 383 U.S. 519, 528–29 (1966) (rejecting a patent on a newly created chemical because no use for the chemical was disclosed).

6. See 35 U.S.C. § 103 (2012); *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Nonobviousness operates on top of anticipation. If a claimed invention has been already fully described,

Utility patents, however, have a lesser known sibling—the design patent. Design patents are available for the ornamental aspects of an article of manufacture.<sup>7</sup> As with utility patents, these ornamental features must be new and non-obvious,<sup>8</sup> though they cannot be useful.<sup>9</sup>

Congress's authority to allow patents to be granted is contained in Article I, Section 8, Clause 8 of the Constitution. Today, this clause is commonly called the Intellectual Property Clause.<sup>10</sup> This short-hand phrase leads to a problem in analysis, however. Although we now consider intellectual property to be a unified field of law, this was not true when the Constitution was drafted and does not reflect the language used in the clause. Consequently, while the authority for Congress to adopt utility patents is clear, design patents are problematic as they do not meet squarely the requisites of the Clause.

Furthermore, granting a monopoly to make, use, or sell a patented design limits others from incorporating the design into their own creations. Because of the ornamental nature of a design patent, this rescission from the marketplace raises free speech issues that utility patents do not. It would be possible, for example, to exploit a design patent to suppress political expression, social commentary, or creative art. Others would be prohibited

it is anticipated. See authorities cited *supra* note 4. If it has not been fully described, but is a clear extension of what is already known, § 103 bars the patent. See *John Deere Co.*, 383 U.S. at 17–18.

7. See 35 U.S.C. § 171(a) (2012) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”). For an excellent description of the basics of design patent law, see Sarah Burstein, *Design Patent Myths—An Introduction*, THE FACULTY LOUNGE BLOG, (Oct. 2, 2013, 4:10 PM), <http://www.thefacultylounge.org/2013/10/design-patent-mythsan-introduction.html>; Sarah Burstein, *Design Patent Myths—It's Really Difficult to Get a Design Patent*, THE FACULTY LOUNGE BLOG, (Oct. 4, 2013, 9:25 AM), <http://www.thefacultylounge.org/2013/10/really-difficult-to-get-a-design-patent.html>; Sarah Burstein, *Design Patent Myths—Most Designs Can't Satisfy the Requirement of “Nonobviousness”*, THE FACULTY LOUNGE BLOG, (Oct. 14, 2013, 9:09 PM), <http://www.thefacultylounge.org/2013/10/nonobviousness.html>; Sarah Burstein, *Design Patent Myths—Only Artistic Designs Can Be Patented*, THE FACULTY LOUNGE BLOG, (Oct. 16, 2013, 9:24 AM), <http://www.thefacultylounge.org/2013/10/design-patent-mythsonly-artistic-designs-can-be-patented.html>; Sarah Burstein, *Design Patent Myths—You Can Only Get Design Patents for Applied Ornaments*, THE FACULTY LOUNGE BLOG, (Oct. 21, 2013, 8:12 AM), <http://www.thefacultylounge.org/2013/10/ornaments.html>.

8. See 35 U.S.C. § 171(b) (2012) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

9. See *L.A. Gear*, 988 F.2d at 1123.

10. See, e.g., Christi J. Guerrini, *Defining Patent Quality*, 82 FORDHAM L. REV. 3091, 3112–13 (2014); Jane Bambauer, *Is Data Speech?*, 66 STAN. L. REV. 57, 75 (2014); Miriam Bitton, *Patenting Abstractions*, 15 N.C. J.L. & Tech. 153, 209 (2014); Ralph D. Clifford, *Random Numbers, Chaos Theory, and Cogitation: A Search for the Minimal Creativity Standard in Copyright Law*, 82 DENV. U. L. REV. 259, 266 (2004).

from making or using the representations protected by the design patent,<sup>11</sup> even when the public interest in promoting the free flow of information and ideas outweighs the interest in granting the time-limited patent monopoly. The law of design patents, as presently understood, incorporates none of the accommodations of expression known in other areas of IP law, particularly the copyright fair use doctrine. In other words, design patents can directly and adversely impact speech that is at the core of First Amendment protection.

This article will discuss both of these issues. In section two, the Article I power of Congress to adopt design patents will be examined. The result of this analysis will be to call into question the appropriateness of the enactment. The third section of the paper will consider the omission of First Amendment accommodation in design patent law and show that the Patent Act must have some exception to protect freedom of speech. The analysis will describe a doctrine of design patent fair use, modeled on the copyright fair use provision.<sup>12</sup> As happened in copyright law,<sup>13</sup> the design patent fair use concept is susceptible of judicial construction.

## II. AN ANALYSIS OF THE CONGRESSIONAL POWER TO GRANT DESIGN PATENTS

Design patents are not new creations.<sup>14</sup> The first version of them was authorized by the Patent Act of 1842.<sup>15</sup> The design patent provisions were

11. See 35 U.S.C. § 154(a)(1) (2012) (“Every patent shall . . . Grant to the patentee . . . The right to exclude others from making, using, offering for sale, or selling the invention throughout the United States”).

12. See 17 U.S.C. § 107 (2012); see also Deepa Varadarajan, *Trade Secret Fair Use*, 83 FORDHAM L. REV. 1401 (2014) (making a parallel argument for establishing a fair use defense in trade secret law).

13. See, e.g., *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 549 (1985) (noting that 17 U.S.C. § 107 “codif[ied] the common-law doctrine”).

14. For a comprehensive history of the design patent laws, see Jason J. Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837 (2013).

15. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44:

[A]ny citizen . . . who by his . . . own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his . . . invention . . . may make application . . . to the Commissioner of Patents . . . and the Commissioner . . . may grant a patent therefor.

The fact that design patents were adopted early in the history of the U.S. does little to establish their constitutionality under Article I. Early Congresses could be just as prone to adopt constitutionally suspect provisions as current ones are. The law of seditious libel is a good example. See *Sedition Act*, July 14,

amended multiple times before 1952<sup>16</sup> when Congress adopted the current patent code that covers both utility and design patents.<sup>17</sup>

Examining the history and structure of the Intellectual Property Clause<sup>18</sup> shows constitutional weaknesses underlying the adoption of design patents. In fact, Congress's power to act as it has is hard to justify.

*A. The "Intellectual Property" Clause Has Two Dichotomous Powers—One for Patents and One for Copyrights*

The congressional power to grant patents is contained in Article I, Section 8, Clause 8 of the Constitution. The clause reads, "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 . . ." <sup>19</sup> Under modern parlance, this clause is usually referred to as the Intellectual Property Clause.<sup>20</sup> This treatment of the clause as a single, unified grant of power is inappropriate, however.

Although the copyright and patent powers are combined into a single clause, they are nevertheless distinct and dichotomous. The proper treatment

1798, ch. 74, § 1, 1 Stat. 596 (1798) (expired in 1801) (prohibiting "oppos[ing] any measure or measures of the government of the United States . . ."); *id.* § 2 (prohibiting "any person [from] writ[ing], print[ing], utter[ing] or publish[ing] . . . [anything about] Congress, or the . . . President, [which] . . . bring[s] them, or either of them, into contempt or disrepute"). This law was also adopted early in the history of the United States by many of the same people who had drafted the Bill of Rights despite its almost certain violation of the First Amendment. Indeed, this law was enforced without concern about the constitutional problem. See JOHN C. MILLER, *CRISIS IN FREEDOM: THE ALIEN AND SEDITION ACTS* 211–20 (1951) (describing the conviction of James Callender for violating the Sedition Acts for writing that the John Adams administration was a "continual tempest of malignant passions.").

The unconstitutionality of the Sedition Act has been long acknowledged. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 276 (1964) (noting that Congress acknowledged the unconstitutionality of the Act in 1840 and refunded all penalties that had been assessed under the law). See generally, Lawrence Rosenthal, *First Amendment Investigations and the Inescapable Pragmatism of the Common Law of Free Speech*, 86 *IND. L.J.* 1, 19–22 (2011) (discussing the interrelationship between the Sedition Act and the meaning of the First Amendment); Tom W. Bell, *Treason, Technology, and Freedom of Expression*, 37 *ARIZ. ST. L.J.* 999, 1008 n.36, 1027–40 (2005) (discussing First Amendment implications of the Sedition Act as well as treason laws).

16. See Act of March 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (extending term of design patents); Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209–10 (expanding items subject to design patent); Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387 (modifying design patent rights); Act of May 9, 1902, ch. 783, 32 Stat. 193, 193 (redefining design patents).

17. Patent Act of 1952, Pub. L. No. 593, 66 Stat. 792 (revising the patent laws and codifying it at Title 35 of the U.S. Code). The current design patent provision reads: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 171(a) (2012).

18. U.S. CONST. art. I, § 8, cl 8.

19. *Id.*

20. See, e.g., *supra* authorities cited in note 10.

of the clause establishes a copyright power, “To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings,”<sup>21</sup> and a patent power, “To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.”<sup>22</sup> To understand why this has to be, the text of the constitution must be examined, the intent of the drafters must be divined, and the historic treatment of the clause must be traced.

### 1. Textual Reasons Why the IP Powers Are Dichotomous

According to the constitutional clause, the writings of authors and discoveries of inventors are held by each “respectively.”<sup>23</sup> The word “respectively” means “in precisely the order given; sequentially.”<sup>24</sup> It means that the items in the list are “referr[ed] or appl[ied] to in a parallel or sequential way.”<sup>25</sup> “The implication of the word [respective] in this respect is disjunctive, and separates each group . . . from the other groups.”<sup>26</sup>

As discussed in an earlier examination of the clause, grammatically, it represents a “balanced sentence.”<sup>27</sup> The purpose of a balanced sentence is to tie together each individual phrase and set it in distinction to the other phrase or phrases.<sup>28</sup> In Clause 8, the “science” of “authors” in their “writings” is balanced with the “useful art[]” developed by “inventors” in their “discoveries.”<sup>29</sup>

Clause 8 only has two groups: authors and inventors.<sup>30</sup> To treat their rights “respectively” and to maintain the balance implemented in the Clause requires the writings and inventions to be treated as separate things. In other words, the clause says that authors have writings to advance science and

21. U.S. CONST. art. I, § 8, cl. 8.

22. *Id.*

23. *Id.*

24. RANDOM HOUSE UNABRIDGED DICT. 1640 (2d ed. 1993).

25. *Id.*

26. *Sandford v. Stagg*, 150 A. 187, 188 (N.J. Ch. 1930). *See Ex Parte Collett*, 337 U.S. 55, 61 n.11 (1949) (listing four statutes with their respective new definitions).

27. Karl B. Lutz, *A Clarification of the Patent Clause of the U.S. Constitution*, 18 GEO. WASH. L. REV. 50, 51 (1949–50).

28. *See* ALBERT LEROY BARTLETT & HOWARD LEE MCBAIN, *THE ELEMENTS OF ENGLISH GRAMMAR* 281 (1906) (describing the creation and use of balanced sentences).

29. *See* Lutz, *supra* note 27; *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966) (acknowledging the clause is balanced).

It should be noted that “science” as used in the Constitution does not have the modern meaning of the word. At the time the Constitution was written, “science” meant “learning in general,” Lutz at 51–52; rather than a systematic body of knowledge that was derived using confirmable experiments. Similarly, “useful arts” was a term that meant “technology” in the 1700s. *Id.* at 54.

30. *See* U.S. CONST., art. I, § 8, cl. 8.

inventors have discoveries to advance the useful arts, but does not recognize the converse. Inventors do not have writings and authors do not have discoveries.

## 2. The Drafters' Intent Matches the Text

Very little direct “legislative” history exists for Clause 8.<sup>31</sup> What does exist treats copyrights and patents as distinct: “The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors.”<sup>32</sup> In Madison’s view, as the constitutional text states, copyrights go to authors and patents go to inventors.

Another method of divining the drafters’ original intent is to examine how the first Congress dealt with the power in question.<sup>33</sup> Here, the evidence is not conclusive although it suggests that Congress ultimately determined that the two powers were distinct. Initially, Congress considered a bill on its

31. See *Bilski v. Kappos*, 130 S. Ct. 3218, 3242 (2013) (Stevens, concurring); Ralph D. Clifford, *Simultaneous Copyright and Trade Secret Claims: Can the Copyright Misuse Defense Prevent Constitutional Doublethink?*, 104 DICK. L. REV. 247, 271 (2000); Thomas B. Nachbar, *Patent and Copyright Clause*, THE HERITAGE GUIDE TO THE CONSTITUTION (2012), available at <http://www.heritage.org/constitution#!articles/1/essays/46/patent-and-copyright-clause> (“There is little direct evidence about the Patent and Copyright Clause’s original meaning.”).

A recent article by Professor Sean M. O’Connor looks at the history of the clause and suggests that the clause drafters were more likely to have been expressing a method of advancing progress that was consistent with French thought rather than English. See Sean M. O’Connor, *The Overlooked French Influence on the Intellectual Property Clause*, U. CHI. L. REV. (forthcoming), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2409796](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2409796). This analysis makes the proposition that the two powers are distinct as a matter of legislative history more compelling as the French distinctions between the useful arts and the sciences were even stronger than the modern one. See *id.* at 4.

32. THE FEDERALIST No. 43 (James Madison), available at [http://thomas.loc.gov/home/histdox/fed\\_43.html](http://thomas.loc.gov/home/histdox/fed_43.html). Although Madison’s belief that copyrights were part of the common law of England was almost certainly wrong, see Nachbar, *supra* note 31, he was correct in describing them as separate from patents.

33. See *Marsh v. Chambers*, 463 U.S. 783, 788 (1983) (noting that the drafters of the First Amendment approved of paid chaplains as an argument that such arrangements are constitutional). Of course, this method of constitutional analysis is highly suspect. See David Felsen, Comment, *Developments in Approaches to Establishment Clause Analysis: Consistency for the Future*, 38 AM. U. L. REV. 395, 415–19 (1989). Members of the first Congress were just as subject to the politics of the times as current politicians are. It is not uncommon for legislatures to adopt provisions that are patently unconstitutional as a political move. See, e.g., *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2327 (2013) (holding that “[i]t is . . . a basic First Amendment principle that freedom of speech prohibits the government from telling people what they must say,” so law requiring organization to oppose prostitution is unconstitutional). See also *supra* discussion and authorities cited in note 15. Who is to say that the members of the first Congress were more concerned with the recently adopted constitution than with the next election? See DAVID McCULLOUGH, JOHN ADAMS 125–39 (2001) (describing the political considerations that affected each representative’s consideration of the Declaration of Independence).

first reading that apparently treated copyrights and patents together.<sup>34</sup> This bill was not further considered in the session, so it died on adjournment.<sup>35</sup> In the next session, when Congress returned to the consideration of copyrights and patents, Congress split its treatment of them into separate matters.<sup>36</sup> The patent provision was enacted first in April of 1790 with a copyright act following approximately one month later.<sup>37</sup> Thereafter, copyrights and patents were always dealt with as distinct subject matters.<sup>38</sup>

Consequently, by 1790, both the limited pre-adoption history behind Clause 8 and its treatment in the first Congress result in a recognition that it is comprised of two separate powers. This dichotomy is clear as the two powers were used and discussed through the first 150 years of the country's existence.

### 3. The Powers Have Been Treated as a Dichotomy Historically

The split established by the language of the Constitution was routinely acknowledged until very recently. Copyrights and patents were considered highly distinct areas of the law from the time the Constitution was adopted through the 1940s or 50s. Evidence of this can be found in several places. First, the academic literature recognized the split. Second, published casebooks indicate that the areas were taught as separate subjects. Finally, the courts recognized the dichotomy in the few cases where this was relevant. Each will be considered in turn.

#### *a. Law Reviews*

Based on searches of the Westlaw database of all law journals and reviews,<sup>39</sup> the first reference in the literature to “intellectual property” as referring to both copyrights and patents occurred in a book review that was published in 1945.<sup>40</sup> Interestingly, the author of the review was critical of the

34. See Lutz, *supra* note 27, at 52 (noting that a bill passed on its first reading but that the contents, beyond the title which included all of the Clause 8 text, are unknown).

35. *Id.*

36. *Id.*

37. *Id.* at 52–53. See Patent Act of 1790, Ch. 7, 1 Stat. 109 (1790); Copyright Act of 1790, Ch. 15, 1 Stat. 124 (1790).

38. See *id.* at 53.

39. See JOURNALS & LAW REVIEWS (JLR), <http://www.westlaw.com> (last visited Sept. 10, 2015).

40. Stephen P. Ladas, *Harold G. Fox, The Canadian Law of Copyright*, 58 HARV. L. REV. 1268 (1945) (reviewing a book). There was an earlier book that used the term “intellectual property” that was published in 1855. LYSANDER SPOONER, *THE LAW OF INTELLECTUAL PROPERTY; OR AN ESSAY ON THE RIGHT OF AUTHORS AND INVENTORS TO A PERPETUAL PROPERTY IN THEIR IDEAS* (1855), available at [http://lf-oll.s3.amazonaws.com/titles/2243/Spooner\\_1518\\_Bk.pdf](http://lf-oll.s3.amazonaws.com/titles/2243/Spooner_1518_Bk.pdf). Although the title makes it appear as if both copyrights and patents are covered, the book itself addresses rights in ideas without concern of the

book's author for considering copyright law "as a branch of the law of industrial property."<sup>41</sup> In distinction, the book review author asserted that "[c]opyright is rather related to industrial property both being branches of what we may call 'Intellectual Property.'"<sup>42</sup> Before this use, "intellectual property" was used within the literature to reference copyright law exclusively.<sup>43</sup>

The next use of "intellectual property" in the literature to cover more than just copyright occurred six years later, again in a book review.<sup>44</sup> It was not until the 1960s that the term "intellectual property" began to be routinely broadened to apply to both patents and copyrights;<sup>45</sup> indeed, trademarks<sup>46</sup> and trade secrets<sup>47</sup> also began to be incorporated. Of course, by the first decade of this century, Westlaw report over 10,000 articles that use the term as a collective for all types of protection.<sup>48</sup>

### *b. Casebooks*

The split seen in the academic literature is also seen in the casebooks that were published to teach patents and copyrights in law schools. The first casebook that treated intellectual property as a unified subject matter area was E. Ernest Goldstein, *Cases and Materials on Patent, Trademark and Copyright Law*, published in 1957.<sup>49</sup> Before 1957, there were copyright

specific system that created them. *See id.* Also, the book argues that a perpetual right to each person's ideas should be recognized which moves the essay far away from the American constitutional scheme of copyright and patent protection.

41. Ladas, *supra* note 40 at 1268.

42. *Id.*

43. *See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 202-03 (1890); Francis J. Swayze, *The Growing Law*, 25 YALE L.J. 1, 10 (1915); Peter J. Hamilton, *The Spanish Civil Code*, 31 HARV. L. REV. 1089, 1094 (1918); Note, *Revision of the Copyright Law*, 51 HARV. L. REV. 906, 921 (1938); Note, *Rights of Performers and Recorders Against Unlicensed Record Broadcasts*, 49 YALE L.J. 559, 559 (1940). *Cf.* Roscoe Pound, *Classification of Law*, 37 HARV. L. REV. 933, 958-59 (1924).

44. John F. Oberlin, *Le Droit D'auteur. by Henri Desbois*, 64 HARV. L. REV. 1042, 1044 (1951) (reviewing a book).

45. *See, e.g.,* Steven Duke, *Foreign Authors, Inventors, and the Income Tax*, 72 YALE L.J. 1093, 1094 n.5 (1963).

46. *See* Jack C. Davis, *Navy Patent Matters*, 18 JAG J. 214, 231 (1964) (stating that "[p]atents together with trademarks and copyrights are generally included within the generic term 'Intellectual Property.')" (footnotes omitted).

47. David Bender, *Computer Programs: Should They be Patentable?*, 68 COLUM. L. REV. 241, 248-50 (1968).

48. *See* JOURNALS & LAW REVIEWS (JLR), <http://www.westlaw.com> (last visited Sept. 10, 2015).

49. DOUGLAS W. LIND, BIBLIOGRAPHY OF AMERICAN LAW SCHOOL CASEBOOKS, 1870-2004 440 (William S. Hein and Co. 2006).

casebooks and there were patent casebooks, but there were no casebooks that unified the topics.<sup>50</sup>

It took even longer for the term “intellectual property” to make its way to the title of a casebook. The first such book was Alpert P. Blaustein & Robert A. Gorman, *Intellectual Property; Cases and Materials 1960–1970*, published in 1971.<sup>51</sup> Since the 1970s, of course, the term has proliferated.<sup>52</sup>

### *c. Use in Court*

The transition of the term intellectual property into one that covers all of the different species of protection can also be seen in how the term has been used in the courthouse. Before the 1970s, the use of the term was very rare. Fewer than one percent of the cases involving patents or copyrights used the term intellectual property.<sup>53</sup> Even through the 1980s, fewer than ten percent of the cases used the term.<sup>54</sup> More recently, the percentage continues to grow and is approaching fifty percent.<sup>55</sup>

At least one opinion expressly recognized the dichotomous nature of Clause 8. In *Application of Yardley*,<sup>56</sup> the court acknowledged the dichotomy: “the framers of the Constitution recognized a distinction between ‘authors’ and ‘inventors’ and ‘writings’ and ‘discoveries.’”<sup>57</sup> The court then determined that the constitution does not prevent an “author-inventor” from seeking protection—even simultaneously—under both the patent and copyright laws.<sup>58</sup>

It is important to note what the *Yardley* case does not establish. Simultaneous copyright and patent protection is a common occurrence, particularly within the computer software industry, where each system is used to protect a different aspect of the same product.<sup>59</sup> The concept that multiple intellectual property schemes may apply to the legal protection of a

50. *See id.* at 439–51.

51. *See id.* at 441.

52. *See id.* at 439–51.

53. *See* Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1033–34 (2005).

54. *See id.*

55. *See id.*

56. *Application of Yardley*, 493 F.2d 1389, 1391 (C.C.P.A. 1974).

57. *Id.* at 1395.

58. *Id.* at 1395–96.

59. *See* RAYMOND T. NIMMER, THE LAW OF COMPUTER TECH. § 1:4 (WestLaw last updated Apr., 2014) (“Today, no serious debate exists about the copyrightability of computer programs; virtually all computer programs are copyrighted unless the program is extremely narrow or inextricably connected to the process or function it serves.”); *id.* § 2:21 (“[S]oftware-based invention . . . [is] patentable subject matter.”).

product is, today, unremarkable.<sup>60</sup> What *Yardley* does not establish, however, is that Congress is free to ignore the meaning of Clause 8. Where Congress enacts a provision outside of the copyright or patent powers, the provision is unconstitutional.<sup>61</sup>

#### 4. Conclusion

To reach a supportable conclusion about the meaning of Clause 8, it must be considered under a two-part analysis. It is not appropriate to determine that something is intellectual property and apply the clause as a unified qualifier; instead, the Clause requires that it be determined whether the power being exercised by Congress is the copyright power or the patent power. Only enactments that satisfy the relevant power—copyright or patent—should be found to be constitutional under Clause 8.

When examined this way, design patents are problematic as they are neither fish (copyrights) nor fowl (patents). A preliminary demonstration of this can be obtained by examining the basic standards used to determine if design patent infringement has occurred. The basic test for this was articulated by the Supreme Court in 1871 in *Gorham Mfg. Co. v. White*.<sup>62</sup> The Court held:

that if, in the eye of an 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.<sup>63</sup>

This test incorporates aspects of copyright law as an observer needs to find that the infringing product is “substantially the same” as the claimed design. This closely mirrors the substantially similar presumption that is used in most copyright cases where direct evidence of copying is unavailable.<sup>64</sup> At the same time, the test references the standards used in a trademark infringement case. The examination of whether the alleged infringing product’s “resemblance [to the patented design] is such as to deceive . . . an observer, inducing him to purchase one supposing it to be the other,” matches

60. See, e.g., discussion of the *Georgia-Pacific* case, *infra* pp. 55–59.

61. See *In re Trade-Mark Cases*, 100 U.S. 82, 90 (1879) (holding that the federal trademark laws could not be adopted under the power given in art. I, § 8, cl. 8 as they are neither the discovery of an inventor nor the writings of an author).

62. *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871).

63. *Id.* at 528.

64. See, e.g., *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969) (stating “[t]he ultimate test in a copyright infringement case of this sort is whether an average lay observer would find a substantial similarity in the designs, recognizing the copy as an appropriation of the copyrighted work.”).

the basic rule for trademark infringement.<sup>65</sup> Importantly, the standard “reading on” analysis that is used to determine patent law infringement is missing from the Supreme Court’s standard.<sup>66</sup> This preliminary analysis suggests that design patents may not fit within either branch of Clause 8. Consequently, the next section of the paper will engage in a more comprehensive analysis of whether design patents are authorized by Clause 8.

*B. The Consequences of the Dichotomy—Are Industrial Designs Within the Patent Power?*

To be properly enacted, design patents must have been adopted pursuant to the patent power contained within Article I of the Constitution.<sup>67</sup> When the Clause is examined, however, the appropriateness of the design patent provisions is doubtful. To start the analysis, the limited amount of case law that has considered the constitutionality of design patents will first be examined. Then, because the case law is not definitive, the text of the patent power will be dissected. This will show that design patents have a shaky constitutional foundation.

### 1. Limited Case Law

The Supreme Court has not determined the constitutionality of the design patent laws although the Court has acknowledged their existence numerous times.<sup>68</sup> In none of these cases, however, was the issue of Article

65. See, e.g., *Mushroom Makers, Inc. v. R. G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (stating “[i]t is well settled that the crucial issue in an action for trademark infringement. . . is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”).

66. See *Organic Seed Growers & Trade Ass’n v. Monsanto Co.*, 718 F.3d 1350, 1353 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 901, 904 (2014). “Reading on” compares an alleged infringing device with each limitation in a patent claim and, if there is a fit, infringement is found. See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950). Of course, this “reading on” process is rarely as simple as it sounds. See e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 726 (2002) (applying the doctrines of equivalents and prosecution history estoppel).

67. U.S. CONST., art. I, § 8, cl. 8. See *supra* part II. A.

68. See *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124, 133 n.5 (2001) (*dicta*); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (indicating that a party could obtain a design patent); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (holding that state law may not protect “unprotected *design* and utilitarian ideas embodied in unpatented boat hulls”) (emphasis added); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 238 (1964) (stating “[b]ut if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will.”); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964) (stating “[a]n unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so.”); *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680-82 (1893) (rejecting design patent as lacking innovation); *New York Belting & Packing Co. v. New Jersey Car-Spring & Rubber Co.*, 137 U.S. 445, 449 (1890) (holding that design patent failed for a lack of novelty); *Dobson v. Dornan*, 118 U.S. 10, 17-18 (1886) (awarding nominal damages for design patent infringement); *Dobson v. Hartford Carpet Co.*; *Dobson v. Bigelow Carpet Co.*, 114 U.S. 439, 445-46 (1885) (reversing damage award for

I constitutionality raised.<sup>69</sup> Without the issue of constitutionality directly raised, the Court will not consider any potential constitutional infirmity.<sup>70</sup> We are left, therefore, without Supreme Court guidance.

There is slightly more case law in the lower courts. Not surprisingly, the more significant of these cases were decided by the Federal Circuit's predecessor court, the Court of Customs and Patent Appeals ["C.C.P.A."].

In 1974, the C.C.P.A. decided the *Application of Yardley* case which addressed whether the same design could constitutionality be protected by both a copyright and a design patent.<sup>71</sup> Yardley had obtained a copyright on a watch face and had then applied for a design patent on it.<sup>72</sup> The patent office rejected the patent as it then required a party who had an object that could be both copyrighted and patented to elect which system was going to be used.<sup>73</sup> The C.C.P.A. disagreed with this holding that "[t]he Congress, through its legislation under the authority of the Constitution, has interpreted the Constitution as authorizing an area of overlap where a certain type of creation may be the subject matter of a copyright and the subject matter of a design patent."<sup>74</sup>

*Mazer v. Stein*<sup>75</sup> was the primary authority on which the *Yardley* court relied.<sup>76</sup> Unfortunately, although the C.C.P.A. treated the language from *Mazer* as holding, it was only *dicta* as the Supreme Court expressly refused to rule on the constitutional issues raised.<sup>77</sup> Indeed, the Court eschewed any consequence on the patent laws, stating, "As we have held the statuettes here involved copyrightable, we need not decide the question of their patentability. Though other courts have passed upon the issue as to whether allowance by the election of the author or patentee of one bars a grant of the other, we do not."<sup>78</sup> Thus, *Yardley's* reliance on *Mazer* as establishing the constitutionality of design patents was incorrect. Without other

design patent infringement and remanding for the entry of a nominal judgment); *Lehnbeuter v. Holthaus*, 105 U.S. 94, 97 (1881) (finding design patent valid); *Gorham Mfg. Co.*, 81 U.S. (14 Wall.) 511, 528 (1871) (establishing the test for design patent infringement).

69. See cases cited in note 68, *supra*.

70. See *Mazer v. Stein*, 347 U.S. 201, 208 (1954) (refusing to reach constitutional question about the constitutionality of applying copyright law to industrial designs as the issue was not raised by the parties in the courts below).

71. *Application of Yardley*, 493 F.2d 1389, 1393 (C.C.P.A. 1974).

72. See *id.* at 1390-91.

73. See *id.* at 1393.

74. *Id.* at 1396.

75. *Mazer*, 347 U.S. at 206.

76. See *Application of Yardley*, 493 F.2d at 1394-95.

77. See *Mazer*, 347 U.S. at 206 n.5.

78. *Id.* at 217.

substantiation, the assumption in *Yardley* that design patents can apply to either inventions or writings—the two objects within the Clause 8 dichotomy—is highly questionable.

The C.C.P.A. upheld design patents as constitutional in several earlier cases.<sup>79</sup> Each time, however, the lack of a legal argument justifying the decision is apparent. In *Dieterich v. Leaf*, the court stated that “[the design patent provision] is, of course, based upon the same constitutional provision as [the utility patent provisions],”<sup>80</sup> but there is not justification for so holding. Similarly, in *In re Schnell*, the C.C.P.A. stated that “Congress in 1842, under the authority granted by article 1, Sec. 8 of the Constitution, enacted the first design patent law (Statute II, August 29, 1842, c. 263, 5 Stat. 543), . . .”<sup>81</sup> but again failed to substantiate the statement with an examination of whether the enactment was a valid exercise of the power.

There does not appear to be any case in the Courts of Appeal where the constitutionality of the design patent laws was expressly considered. As with the C.C.P.A., the cases that exist assume that the design patent laws are constitutional without actually litigating the issue.<sup>82</sup>

There are obviously numerous district court cases that rule on the enforceability of design patents without any concern about the constitutional validity of the provision. A search of the U.S. District Court Cases Database on WestLaw for “design patent,” for example, returns 1,403 cases.<sup>83</sup> If the search is further limited by requiring “constitutional” to be in the same paragraph as “design patent,” the return drops to fifteen cases.<sup>84</sup> Most of these cases involve potential constitutional problems other than the interpretation of Clause 8 such as standing,<sup>85</sup> personal jurisdiction,<sup>86</sup> and preemption.<sup>87</sup> With these alternate ground cases removed, only three have considered any potential Article I problem.

79. *Dieterich v. Leaf*, 89 F.2d 226, 229 (C.C.P.A. 1937); *In re Schnell*, 46 F.2d 203, 205 (C.C.P.A. 1931).

80. *Dieterich*, 89 F.2d at 229.

81. *In re Schnell*, 46 F.2d at 205.

82. *See, e.g.*, *Goudy v. Hansen*, 247 F. 782, 789 (1st Cir. 1917) (finding a design patent invalid for lack of novelty); *Mygatt v. Schaffer*, 218 F. 827, 838 (2d Cir. 1914) (finding a design patent valid); *Charles Boldt Co. v. Turner Bros. Co.*, 199 F. 139, 144 (7th Cir. 1912) (finding a design patent invalid for lack of novelty).

83. *See* U.S. DISTRICT COURT CASES (DCT), <http://www.westlaw.com> (last visited Sept. 10, 2015).

84. *See id.*

85. *See e.g.*, *Vita-Herb Nutraceuticals, Inc. v. Probiohealth, LLC*, No. SACV 11-1463 DOC, 2013 WL 1182992, at \*3-5 (C.D. Cal. Mar. 20, 2013).

86. *See e.g.*, *Int'l Truck & Engine Corp. v. Dawson Int'l Inc.*, 216 F. Supp. 2d 754, 758 (N.D. Ind. 2002).

87. *See e.g.*, *I.P. Lund Trading ApS v. Kohler Co.*, 11 F. Supp. 2d 112, 118 (D. Mass.) *aff'd in part*, 163 F.3d 27 (1st Cir. 1998).

The most directly relevant of these is *Hadco Products, Inc. v. Lighting Corp. of America, Inc.*<sup>88</sup> In the case, the court asks, “The requirement of advancement, present in the constitutional standard of patentability, seems to have far less practical application in design cases. Moreover, if the Constitution requires that a patent advance or add to the sum of useful knowledge, how can a design patent be constitutional?”<sup>89</sup> Frustratingly, the court fails to answer its own question although it does ultimately enforce the design patent in question.<sup>90</sup>

The other two potential cases on the constitutionality of design patents follow the pattern of the C.C.P.A. and Courts of Appeal cases discussed above. *Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Products, Inc.*,<sup>91</sup> obliquely raised the constitutional issue by indicating that what was claimed

failed to meet the constitutional requirement of invention reflected in the Section 103 nonobviousness condition for patentability. Article I, Section 8, Clause 8 of the Constitution grants Congress the power “(t)o promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” In exercise of that power, Congress enacted Title 35 of the United States Code specifying the procedure and requirements for obtaining a patent [including s]ection 171 of Title 35, providing specifically for design patents . . .<sup>92</sup>

Similarly, *Columbus Plastic Products v. Rona Plastic Corp.*,<sup>93</sup> stated that

[u]nder somewhat stringent requirements of inventiveness in this circuit, any new, original and ornamental design for an article of manufacture, might be protected by design patent. But these remedies grant a monopoly of sharply limited duration, and then only upon the basis of a legislative appraisal of the conflicting interests involved which is specifically authorized by the Constitution [in] Art. I, Sec. 8.<sup>94</sup>

Consequently, while both cases acknowledge the constitutional issue and do not rule that design patents are constitutionally infirmed, there is also a lack of legal argument and support for the constitutionality of them and no indication that the issue of Article I constitutionality was actually litigated.

88. *Hadco Products, Inc. v. Lighting Corp. of Am.*, 312 F. Supp. 1173, 1177 (E.D. Pa. 1970), *vacated on other grounds sub nom.*, *Hadco Products, Inc. v. Walter Kidde & Co.*, 462 F.2d 1265 (3d Cir. 1972).

89. *Id.* at 1177 (footnotes omitted).

90. *See id.* at 1185. The Court of Appeals reversed this case on the ground that the design patent in question was obvious in light of the prior art. *See Hadco*, 462 F.2d at 1272–73.

91. 418 F. Supp. 224 (D.C. Colo. 1976), *aff'd*, 597 F.2d 201 (10th Cir. 1979).

92. *Id.* at 227–28 (citations omitted).

93. 111 F. Supp. 623, 625 (S.D.N.Y. 1953).

94. *Id.* at 625 (citations and quotation marks omitted).

## 2. Basic Requirement of the Patent Clause: An Industrial Design Must Be a “Useful Art” and an “Inventor’s” “Discovery”

As shown, there is no persuasive legal authority establishing the constitutionality of design patents under the Patent Power.<sup>95</sup> Those courts that have enforced them have done so without a convincing argument being made for either their validity or invalidity under the Constitution. This section of the paper will develop that argument. The result of this articulation raises doubt concerning the Article I sufficiency of design patents.

Initially, the Constitutional language—“To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries”<sup>96</sup>—must start the analysis. Three phrases from the clause must be understood: “useful arts,” “inventors,” and “discoveries.” Each will be discussed in turn.

### *a. “Useful Arts”*

There has yet to be definitive case law that establishes the meaning of the term “useful arts” as it is used in Clause 8. In fact, the term seems to be appear in a significant number of copyright cases,<sup>97</sup> suggesting that the courts have not read the clause carefully as copyrights should advance “science” as that term was understood in the 1700s not “useful arts.”<sup>98</sup>

Recently, however, a Supreme Court concurring opinion discussed the term “useful arts” in some depth.<sup>99</sup> The opinion stated:

Noah Webster’s first American dictionary defined the term “art” as the “disposition or modification of *things* by human skill, to answer the purpose intended,” and differentiated between “useful or mechanic” arts, on the one hand, and “liberal or polite” arts, on the other. Although other dictionaries defined the word “art” more broadly, Webster’s definition likely conveyed a message similar to the meaning of the word “manufactures” in the earlier English statute. And we know that the term “useful arts” was used in the founding era to refer to manufacturing and similar applied trades. Indeed, just days before the Constitutional

95. U.S. CONST., art. I, § 8, cl. 8.

96. *Id.*

97. *See, e.g.,* Greenberg v. National Geographic Soc., 533 F.3d 1244, 1272 n.27 (11th Cir. 2008) (“This broad protection encourages authors to create more works and thereby advance the progress of science *and useful arts.*” (emphasis added)); Aalmuhammed v. Lee, 202 F.3d 1227, 1235 (“The Founding Fathers gave Congress the power to give authors copyrights in order “[t]o promote the progress of Science *and useful arts.*” (emphasis added)).

A search of Westlaw’s Allfeds database shows 36 cases where both “useful arts” and “definition” appear in the same paragraph. *See* ALL FEDERAL CASES (ALLFEDS), <http://www.westlaw.com> (last visited Sept. 10, 2015). One third of these were copyright cases. *See id.*

98. *See supra* part II.A.1.

99. *See* *Bilski v. Kappos*, 130 S. Ct. 3218, 3243–44 (2013) (Stevens, concurring).

Convention, one delegate listed examples of American progress in “manufactures and the useful arts,” all of which involved the creation or transformation of physical substances. Numerous scholars have suggested that the term “useful arts” was widely understood to encompass the fields that we would now describe as relating to technology or “technological arts.”<sup>100</sup>

In his discussion, Justice Stevens quoted a law review article by Professor John Thomas that distinguished what the useful arts are by putting them in contrast with what would not qualify. The article, and thus the concurring opinion, would limit the useful arts to the scope established by “[the Framers of the Constitution who] undoubtedly contemplated the industrial, mechanical and manual arts of the late eighteenth Century, in contrast to the seven ‘liberal arts’ and the four ‘fine arts’ of classical learning.”<sup>101</sup>

The issue this raises is clear. Design patents do not address the “industrial, mechanical or manual arts” by the very definition of the statute;<sup>102</sup> indeed, a design patent excludes these very things.<sup>103</sup>

In summary, the patent power allows for the protection of the “useful arts:” things that are “[o]f practical use, as for doing work; producing material results; supplying common needs.”<sup>104</sup> The design of a product does not meet this requirement. Consequently, whatever may be advanced by a design patent, it is not the constitutionally mandated “useful arts.”

#### *b. “Inventor”*

The party that can be granted a patent for advancing the “useful arts” under the constitution is an “inventor.”<sup>105</sup> This term, too, has a meaning that

100. *Id.* (footnotes and citations omitted).

101. John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1164 (1999). Professor Thomas provides a definition for the liberal and fine arts by quoting Robert Coulter’s article, *The Field of the Statutory Useful Arts, Part II*, 34 J. PAT. OFF. SOC’Y 487, 494 (1952): “The seven historic ‘liberal arts’ were: grammar, logic (dialectics), rhetoric, arithmetic, geometry, music and astronomy[.] The four ‘fine arts’ were: painting, drawing, architecture and sculpture; to which were often added: poetry, music, dancing and drama.” Thomas, 40 B.C. L. REV. at 1164 n.189.

102. See 35 U.S.C. § 171 (2012) (“Whoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)).

103. See *Spaulding v. Guardian Light Co.*, 267 F.2d 111, 112 (7th Cir. 1959) (“A design patent cannot be obtained to protect a mechanical function or cover an article whose configuration affects its utility alone.”); *Application of Weil*, 201 F.2d 946, 947–48 (C.C.P.A. 1953) (“It is well settled, however, that a design patent cannot be granted for the protection of utilitarian advances over the prior art.”); *Weisgerber v. Clowney*, 131 F. 477, 480 (C.C.D.N.J. 1904) (“There may be no objection to the article to which it relates being useful as well as ornamental, but the attempt to patent a mechanical function, under cover of design, is a perversion of the privilege given by the statute.”).

104. RANDOM HOUSE UNABRIDGED DICT. 2097 (2d ed. 1993).

105. U.S. CONST., art. I, § 8, cl. 8.

calls design patents into question although not as conclusively as consideration of “useful arts” did.

The patent act’s definition of “inventor” is exceedingly unhelpful. “The term ‘inventor’ means the individual . . . who invented or discovered the subject matter of the invention.”<sup>106</sup> Other than limiting the term to human individuals,<sup>107</sup> the definition tells us no more than an inventor is someone who invents. The case law is only slightly more helpful. As one court stated, an “‘Inventor,’ in patent law, is the person who conceived patented invention. Conception, in turn, is the formation in the mind of the inventor, of a definite and permanent idea of complete and operative invention as it is hereafter to be applied in practice.”<sup>108</sup> As this definition shows, the courts are more interested in knowing who the inventor is as that is the party who can file a patent application than they are in knowing what an inventor is.<sup>109</sup>

The common definitions for “inventor” are more helpful. An “inventor” is one who “originate[s] or create[s] [something] as a product of one’s own ingenuity, experimentation, or contrivance.”<sup>110</sup> “Ingenuity,” in turn, does seem to suggest that the creator of an industrial design can be an inventor as it means “cleverness or skillfulness of conception or design.”<sup>111</sup> As the essence of a design patent is “cleverness . . . of . . . design,” this aspect of inventorship is demonstrated in industrial design. On the other hand, neither “experimentation”—“a test, trial, or tentative procedure; an act or operation for the purpose of discovering something unknown or of testing a principle supposition, etc.”<sup>112</sup>—nor “contrivance”—“something [‘plan[ned] with ingenuity, devise[d], invent[ed]’]; a device esp. a mechanical one”<sup>113</sup>—are apropos to design patents. Fundamentally, industrial designs are created through a process of creativity, but they are not discovered. Similarly, they are not unknown and are not found through a process of testing. They are certainly not a contrivance as that term so strongly implies a mechanically operating object. “Far from being a . . . science, design is more akin to an art

106. 35 U.S.C. § 100(f) (2012).

107. See Ralph D. Clifford, *Intellectual Property in the Era of the Creative Computer Program: Will the True Creator Please Stand Up?*, 71 TUL. L. REV. 1675, 1695–1702 (1997).

108. *University of Colorado Foundation, Inc. v. American Cyanamid Co.*, 105 F. Supp.2d 1164, 1176 (D. Colo. 2000) (quotation marks and citations omitted).

109. See *Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994).

110. RANDOM HOUSE UNABRIDGED DICT. 1640 (2d ed. 1993).

111. *Id.* at 981.

112. *Id.* at 681.

113. *Id.* at 442.

form. Unlike inventors of utility inventions, designers do not seek to solve specific . . . problems with their designs.”<sup>114</sup>

The Oxford Dictionary has a similar understanding of the term “inventor” defining it as someone who “find[s] out [or] discover[s], esp. by search or endeavor.”<sup>115</sup> In other words, you invent something by having a goal in mind and then seeking ways to achieve that goal. But this does not describe the process of industrial design:

For example, to say that a particular product is “ugly” or “looks cheap” does not identify a specific problem in any meaningful way, such that a hypothetical designer exercising ordinary skill could point to an “obvious solution” to make the product appear more attractive or expensive. Given the subjectivity of aesthetics, ten designers may form ten different yet valid opinions as to why the product looks ugly or cheap. Likewise, all ten designers may hold different yet valid opinions about how the product’s design could be modified to make the product more appealing.<sup>116</sup>

It is not completely wrong to claim that an “inventor” creates an industrial design. At the same time, however, this stretches the meaning of the word. Consequently, while the constitutional term does not preclude design patents in any absolute way, it suggests that design patents are on the extreme edge of inventorship.

### c. “Discovery”

As with the other two constitutional terms, the match between an industrial design and a “discovery” is feeble. Here, far more than with “inventor” and even more than with “useful arts,” design patents grind against the definition.

A “discovery” is something “see[n], [gotten] knowledge of, learn[ed] of, [found], or [found] out; gain[ed] sight or knowledge of; . . . notice[d] or realize[d].”<sup>117</sup> None of these methods from the definition describe what happens in the *creation* of a design. One does not just see it or stumble across it; one must originate the ornamental design and apply it to the product in question. Similarly, the Oxford Dictionary defines “discovery” as something “[found] unexpectedly or during a search; bec[a]me aware of (a fact or situation); [was] the first to find or observe (a place, substance, or scientific

114. Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 438–39 (2011)

115. 1 SHORTER OXFORD ENGLISH DICT. 1424 (6th ed. 2007).

116. Mueller & Brean, *supra* note 114, at 439.

117. RANDOM HOUSE UNABRIDGED DICT. 1640 (2d ed. 1993)

phenomenon) . . . .”<sup>118</sup> This definition, too, suggests that discoveries occur when an existing thing or concept is found rather than being crafted from a series of artistic choices.

Further, unlike utility patents, design patents do not legally protect something that is engineered.<sup>119</sup> If an inventor is crafting a novel plow, for example, it will be possible to compare the operation of the new plow against the old. The comparative worth of the two plows can be analyzed and, if the new plow is a better plow, an improvement patent can be obtained.<sup>120</sup> Design patents cannot be analyzed this way as the “better” design is completely a subjective determination:

Any “problem” that a designer addresses via aesthetics is necessarily ill-defined, elusive, and subjective. For example, to say that a particular product is “ugly” or “looks cheap” does not identify a specific problem in any meaningful way, such that a hypothetical designer exercising ordinary skill could point to an “obvious solution” to make the product appear more attractive or expensive. Given the subjectivity of aesthetics, ten designers may form ten different yet valid opinions as to why the product looks ugly or cheap. Likewise, all ten designers may hold different yet valid opinions about how the product’s design could be modified to make the product more appealing.<sup>121</sup>

In other words, “good” designs cannot be “found,” “learned about,” or “observed”; they must be created. Fundamentally, the process of engineering that leads to discoveries that are subject to utility patents—the scientific method combined with trial and error—is not the process that leads to the cosmetic embellishments that are patented as a design.

### 3. Maybe Design Patents Are Unconstitutional

#### *a. Design Patents Cannot Be Justified Under the Patent Power*

Consequently, it is likely that design patents cannot be justified under the Patent Power in Article I, Section 8, Clause. 8. Industrial designs are not part of the “useful arts.” They are not created by “inventors.” They are created, not “discover[ed].” As a design fails to meet any of the constitutional

118. OXFORD DICT. <http://www.oxforddictionaries.com/us/definition/english/discover> (last visited Sept. 10, 2015).

119. Evidence of this can be found in the qualifications needed for patent examiners. *See Patent Examiner Positions*, <http://www.uspto.gov/web/offices/pac/exam.htm> (last modified Nov. 16, 2003, 02:21:03 am) (noting that “scientists and engineers” examine the “discoveries of inventors” while no such requirement is placed on those who examine design patents).

120. *See* 35 U.S.C. § 101 (2012) (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, *or any new and useful improvement thereof*, may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)).

121. Mueller & Brean, *supra* note 114 at 439.

requisites for a grant of a patent, including them within the Patent Act seems inappropriate as it exceeds congressional power.

The premise of this, though, is that the patent and copyright powers must be completely dichotomous. As shown earlier, this is clearly what the language says,<sup>122</sup> which matches the intent of the drafters.<sup>123</sup> Constitutional law is rarely that clean, however, so an examination of the gap between patents and copyrights is necessary.

*b. Is It Allowable to Issue a Patent Under the Copyright Power?*

Clearly, industrial design could be protected under the Copyright Act.<sup>124</sup> The constitutional authority under Article I, Section 8, Clause 8 to provide *copyright* protections for industrial design also seems clear.<sup>125</sup> This section will review each of these and will then reach the ultimate question about whether the copyright power can be used to sustain a patent.

Statutorily, the Copyright Act expressly protects “pictorial, graphic and sculptural works.”<sup>126</sup> These are defined within the act:

Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned . . . .<sup>127</sup>

Industrial designs, whether two- or three-dimensional, would normally be considered a form of “applied art,”<sup>128</sup> except that Congress wished to exclude pure forms of industrial design from being copyrighted.<sup>129</sup> Consequently, Congress imposed significant limitations on the coverage of “pictorial, graphic and sculptural works” to exclude most industrial designs:

122. See *supra* part II.A.1.

123. See *supra* part II.A.2.

124. See 17 U.S.C. § 102(a)(5) (2012). Although all industrial design seems to be within the scope of a copyright under the Act under § 102(a), there are statutory limitations that greatly limit the industrial designs that can claim protection. These will be discussed in this section, *infra*.

125. Cf. *Mazer v. Stein*, 347 U.S. 201, 217–18 (1954) (refusing to rule directly on the constitutional question as the parties had not properly raised the issue, but holding that “use in industry” does not make an work uncopyrightable).

126. 17 U.S.C. § 102(a)(5) (2012).

127. *Id.* § 101, para. 33

128. See *Ochre LLC v. Rockwell Architecture, Planning and Design, P.C.*, 530 Fed. App’x. 19, 20 (2d Cir. 2013) (equating “applied art” and “industrial design”); RANDOM HOUSE UNABRIDGED DICT. 102 (2d ed. 1993) (“of or pertaining to those arts or crafts that have a primary utilitarian function, or to the designs and decorations used in these arts.”).

129. H.R. Rep. No. 94–1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668 (“On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill.”).

[T]he design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.<sup>130</sup>

Thus, “useful articles”<sup>131</sup>—industrial designs, in other words—have quite limited copyright protection under the 1976 Act.<sup>132</sup>

Although industrial design is mostly excluded from statutory protection,<sup>133</sup> this is not because a copyright could not be extended to an industrial design under the Constitution.<sup>134</sup> Both pictures<sup>135</sup> and sculptures<sup>136</sup> have long been considered to be “writings” under the Copyright Power. Thus, assuming that the basic requirements for copyrightability are obtained—fixation<sup>137</sup> and creativity<sup>138</sup>—copyrights can be constitutionally used to protect industrial design.

Having established that industrial designs can be properly copyrighted, the Clause 8 interstitial question can be addressed. Can Congress grant patents to the writings of authors? To decide this question, the nature of the

130. 17 U.S.C. § 101, para. 33 (2012).

131. The Section defines a “useful article” as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’” *Id.* para 47.

132. Of course, determining the line between a protectable work of authorship that is severable from a useful article and one that is not is nearly analytically impossible. *See* Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411 (1985). Between the majority opinion and Judge Newman’s dissent in *Carol Barnhart*, eight different tests for separating the copyrightable aspects of a useful object from those that are not protected are discussed. *See id.*, *passim*. *See generally*, Robert C. Denicola, *Applied Art and Industrial Design: a Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

133. *See, e.g.*, Carol Barnhart, 773 F.2d at 418 (“the aesthetic and artistic features of the Barnhart forms are inseparable from the forms’ use as utilitarian articles. . .”); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978) (upholding regulations adopted by the copyright office that tended to exclude industrial designs from being registered).

134. *See Mazer v. Stein*, 347 U.S. 201, 206–08 (1954) (“The constitutional power of Congress to confer copyright protection on works of art or their reproductions is not questioned. Petitioners assume, as Congress has in its enactments and as do we, that the constitutional clause empowering legislation ‘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,’ Art. I, § 8, cl. 8, includes within the term ‘Authors’ the creator of a picture or a statue.”) (footnotes omitted).

135. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56–58 (1884).

136. *See Mazer*, 347 U.S. at 214.

137. *See* 17 U.S.C. § 102(a) (2012) (extending copyright to all works of authorship that are “fixed in a tangible medium of expression”). “A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy, . . . by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” *Id.* § 101, para. 20.

138. *See Feist Pub., Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340, 345 (1991) (holding that a work must possess “at least some minimal degree of creativity” to be copyrightable). *See generally*, Clifford, *supra* note 10.

two monopolies must be compared because, if the differences are significant, the transference of a power from one to the other becomes more suspect.

*Patents:* Patents give the inventor a negative monopoly.<sup>139</sup> Without the permission of the patent holder, “making, using, offering for sale, or selling” the patented design is prohibited.<sup>140</sup> Indeed, one cannot experiment with or use the design for any purpose unless it is “solely for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry . . . .”<sup>141</sup> The power granted by a patent is a negative power—the inventor can prevent others from practicing the claimed invention but may not be able to do so him or herself if an earlier shadowing patent exists.<sup>142</sup>

*Copyrights:* Copyrights give an author much more limited rights.<sup>143</sup> The primary right the author obtains is against copying<sup>144</sup> although some modification of the author’s work are also included.<sup>145</sup> If a new work is independently created without any form of copying of the old, both authors would be entitled to similar copyright rights.<sup>146</sup> Further, many aspects of a work are not protected even where a copyright is claimed including, importantly, the ideas, concepts and principles underlying the work.<sup>147</sup>

139. See *United States v. Line Material Co.*, 333 U.S. 287, 308 (1948) (“During its term, a valid patent excludes all except its owner from the use of the protected process or product. This *monopoly* may be enjoyed exclusively by the patentee or he may assign the patent ‘or any interest therein’ to others.” (citations omitted) (emphasis added)).

140. See 35 U.S.C. § 154(a)(1) (2012) (“Every patent shall . . . grant to the patentee . . . the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States . . .”).

141. *Madey v. Duke University*, 307 F.3d 1351, 1362 (Fed. Cir. 2002).

142. See Deepa Varadarajan, *Improvement Doctrines*, 21 GEO. MASON L. REV. 657, 688 (2014) (discussing how an earlier “blocking” patent can prevent use of an improvement patent).

143. Cf. *White v. Leanore Frocks*, 120 F.2d 113, 114–15 (2d Cir. 1941) (“What they [industrial designers] need is rather a statute which will protect them against the plagiarism of their designs; a more limited protection [than design patents] and for that reason easier to obtain if the law recognized copyright in the subject matter at all.”).

144. 17 U.S.C. § 106(1) (2012). See *Mazer*, 347 U.S. at 218 (“Absent copying there can be no infringement of copyright.”).

145. 17 U.S.C. § 106(2) (2012). See, e.g., *Lee v. A.R.T. Co.*, 125 F.3d 580, 582 (7th Cir. 1997) (holding that making a derivative requires the original work to be recast into another work). See generally, Amy B. Cohen, *When Does a Work Infringe the Derivative Works Right of a Copyright Owner?*, 17 CARDOZO ARTS & ENT. L.J. 623 (1999).

146. See *Mazer*, 347 U.S. at 217–18 (“The distinction is illustrated . . . [by] two men, each a perfectionist, independently making maps of the same territory. Though the maps are identical each may obtain the exclusive right to make copies of his own particular map, and yet neither will infringe the other’s copyright.” (citations omitted)); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) (“The ‘author’ is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his.”).

147. 17 U.S.C. § 102(b) (2012). See *Mazer*, 347 U.S. at 217 (“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.”).

Finally, all copyrights are limited where a countervailing public need for the work exists under the fair use doctrine,<sup>148</sup> including where the work is used as the source material for a new transformative work.<sup>149</sup>

Clearly, the differences between the two rights are significant.<sup>150</sup> Recently, for example, a design patent was granted for the medical “Rx” symbol that is used as the header on a drug prescription.<sup>151</sup> The claim made in the patent is for “the ornamental design for the ‘prescription greetings decal,’ as shown.”<sup>152</sup> Figure 1 of the patent claim shows the “Rx” symbol in the upper left corner of a square (presumably the sticker).<sup>153</sup> Unfortunately for many doctors, this design patent might claim the classical medical prescription pad depending on how the court ultimately construes the limitation “decal” as it is used in the patent, raising the possibility of infringement for a doctor who uses the pad. Because patents carry a presumption of validity that can only be overcome with clear and convincing evidence,<sup>154</sup> any attempt to avoid liability would be difficult and consequently expensive.<sup>155</sup>

Were the same “Rx” design claimed for a copyright, significantly fewer rights would be obtained by its claimant. First off, independent creation of a design that matches the claimant’s would not infringe the copyright so a doctor’s independent use of the “Rx” symbol on a decal would not impose liability. Second, the primarily *ex post* analysis of copyright validity makes challenges significantly easier because, although registered copyrights also carry a presumption of validity,<sup>156</sup> this presumption merely shifts the burden of proof from the plaintiff to the defendant without raising the quantum of proof needed to the clear and convincing level.<sup>157</sup>

148. See 17 U.S.C. § 107 (2012); *infra* Section III.E.

149. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

150. See *Alfred Bell & Co.*, 191 F.2d at 103 (“On that account, we have often distinguished between the limited protection accorded a copyright owner and the extensive protection granted a patent owner.”).

151. U.S. Patent No. D690,766S (filed May 2, 2012). Although issued by the PTO, the appropriateness of this patent is highly questionable. See Sarah Burstein, [*“Rx”*] *Decals*, DESIGN LAW BLOG (last visited Sept. 10, 2015), <http://design-law.tumblr.com/post/63042465731/seriously-issued-this-week-d690-766-for-a>.

152. U.S. Patent No. D690,766S (filed May 2, 2012).

153. *Id.* at 2. The design patent claim is not being reprinted within this article as to do so might constitute the use of the patent, subjecting the authors to a patent infringement suit.

154. See *Microsoft Corp. v. i4i Ltd. Partnership*, 131 S. Ct. 2238, 2245–48 (2011).

155. See Mark A. Lemley & A. Douglas Melamed, *Missing the Forest for the Trolls*, 113 COLUM. L. REV. 2117, 2126 (2013) (describing “bottom-feeder” patent trolls who litigate low (or no) quality patents in hopes of obtaining a quick nuisance-value settlement); Guerrini, *supra* note 10, at 3101 (linking patent trolls and patent quality).

156. See, e.g., *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F.2d 546, 549 (7th Cir. 1965).

157. See *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1019 (9th Cir. 1985).

These differences between patents and copyrights are not of modern origin.<sup>158</sup> English law as it existed when the Constitution was drafted distinguished in the kinds of rights that should be associated with each protection scheme.<sup>159</sup> Although it is close to impossible to be certain about anything that was drafted in the late 1700s, particularly where the motivational documentation for the actions taken in creation of Article I, Clause 8, Section 8 of the Constitution is sparse, it is nevertheless appropriate to conclude that the dichotomy written into Clause 8 was either deliberate or the most reasonable interpretation of the constitutional language.<sup>160</sup> Being dichotomous, the answer to the ultimate question of this half of the article is “no”—Congress may not grant a patent to works that are only qualified for copyrights.

### III. FIRST AMENDMENT LIMITATIONS

Even if design patents pass constitutional muster as an appropriate exercise of Article I power, their capacity for expression sets them apart from utility patents and requires that they be constrained by the First Amendment. In other words, if design patents themselves are constitutional, then there must be a free expression or “fair use” defense to design patent infringement. The defense is essential to ensure that patent law does not extinguish art, commentary, parody, and criticism, especially when the subsequent user of a patented design is not an economic competitor of the design owner. The intellectual property trade-off in such a cases—the public grant of exclusive property rights as reward and incentive for continuing productivity and ultimate contribution to the public domain—is outweighed by the public interest in the subsequent use.

A “hybrid” species of intellectual property,<sup>161</sup> design patents have some in common with trademarks, but far more in common with copyrights; indeed, they have more in common with their cousins copyrights than with their statutory sisters utility patents. When examining the competing public

158. Compare Statute on Monopolies, 21 JAC. 1, ch. 3 (1623) (limiting patents to “working or making of any manner of new manufactures”) with Statute of Anne, 8 ANN., c. 19 (1710) (granting rights to the author to control reprinting of books). See generally, 1 R. CARL MOY, MOY’S WALKER ON PATENTS § 1:6 (4th ed. online update 2013); 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 1.5 (online update Mar., 2014).

159. See sources cited in note 158, *supra*.

160. Cf. THE FEDERALIST No. 43 (James Madison), available at [http://thomas.loc.gov/home/histdox/fed\\_43.html](http://thomas.loc.gov/home/histdox/fed_43.html).

161. J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2459 (1994). See also Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531, 532, 609 (2009–10) (explaining inappropriateness of utility patent system to design protection, especially with regard to “non-obvious” requirement).

policies of intellectual property and free expression, commonalities with copyright dominate the analysis because the use of a patented design constitutes *expression*—communication of ideas between people—in a way that the use of a utility-patented thing or process does not. Thus policy dictates that when allegedly infringing use of a patented design is expressive, the infringement analysis must account for countervailing free expression norms in a way that the utility patent infringement analysis need not. Various analyses in the law already exist to fill this gap; in particular, the copyright fair use doctrine provides the best fit with design patents and should be incorporated into design patent infringement law.

### A. Copyrights and Free Expression

The concept of balance between intellectual property, in part as authorized by the IP Clause of the Constitution,<sup>162</sup> and freedom of expression, as guaranteed by the First Amendment,<sup>163</sup> is now well entrenched in constitutional law.<sup>164</sup> It is well settled as a matter of originalism that the absolutist command of 1791, that the government “make no law . . . abridging the freedom of speech, or of the press,”<sup>165</sup> negated neither the 1789 IP Clause<sup>166</sup> nor the Commerce Clause,<sup>167</sup> and the 1868 incorporation of the Bill of Rights to the states<sup>168</sup> did not negate the state law of trademark,<sup>169</sup> tort,<sup>170</sup>

162. U.S. CONST. art. I, § 8, cl. 8.

163. *Id.* amend. I. *See also id.* amend. XIV, § 1 (incorporating the First Amendment through the Due Process Clause).

164. *E.g.*, Andrew Beckerman-Rodau, *Prior Restraints and Intellectual Property: The Clash Between Intellectual Property and the First Amendment from an Economic Perspective*, 12 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1, 19–24 (2001) (discussing competing economic rationales for the IP Clause in balance with the First Amendment). *Cf. PruneYard Shopping Center v. Robins*, 447 U.S. 74, 84–85 (1980) (approving, upon heightened scrutiny in due process and takings challenge, expressive activity authorized by state law despite infringement of right to exclude others from real property). *Accord Marsh v. Alabama*, 326 U.S. 501, 509 (1946) (“When we balance the Constitutional rights of owners of property against those of the people to enjoy freedom of press and religion, as we must here, we remain mindful of the fact that the latter occupy a preferred position.”).

165. U.S. CONST. amend. I.

166. *Id.* art. I, § 8, cl. 8; *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (“The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers’ view, copyright’s limited monopolies are compatible with free speech principles. Indeed, copyright’s purpose is to promote the creation and publication of free expression.”); *Golan v. Holder*, 132 S. Ct. 873, 889–91 (2012).

167. U.S. CONST. art. I, § 8, cl. 3. *E.g.*, *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 662 (1994) (articulating First Amendment intermediate scrutiny test for regulation of interstate commercial telecommunications market implicating freedom of speech).

168. U.S. CONST. amend. XIV.

169. *E.g.*, Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 *SMU L. Rev.* 381, 407 (2008).

170. *E.g.*, *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 347 (1974).

nor, insofar as not preempted, copyright.<sup>171</sup> But the U.S. Supreme Court has recognized the need to strike a balance between IP and free expression, especially through a body of case law in copyright in the last century. Article I powers, expressed through federal law, and state law are limited by the freedom of expression.<sup>172</sup> Thus IP rights, whether constitutional, statutory, or common law, are subject to First Amendment scrutiny.<sup>173</sup>

Free expression may be accommodated in IP by examining the public interest that warrants the IP right to begin with,<sup>174</sup> then weighing that interest against the public interest in free expression.<sup>175</sup> In the case of copyrights and patents, public interest supports a constructive property right in an abstraction. The rights are granted with legislative constraints and for a limited time to further the public interest in a market that incentivizes the continuing production of similar valuable property. Our focus here is on copyright law, principally because of its shared rationale with design patent law under the IP Clause.<sup>176</sup>

171. *E.g.*, *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 845 (2d Cir. 1997) (describing misappropriation claim in New York law insofar as not preempted by federal copyright law).

172. *See Rumsfeld v. Forum for Academic & Institutional Rights, Inc.*, 547 U.S. 47, 58 (2006) (recognizing that "legislation that raises armies," U.S. CONST. art. I, § 8, cls. 1, 12–13, "is subject to First Amendment constraints").

173. *E.g.*, Beckerman-Rodau, *supra* note 164, at 31.

174. *See id.* at 16–17 (articulating essentiality of IP system to efficient marketplace).

175. *E.g.*, Thomas I. Emerson, *Toward A General Theory of the First Amendment*, 72 YALE L.J. 877, 878–84 (1963) (articulating free speech-public interests in self-fulfillment, truth, democracy, and the balancing of social stability and change). *See, e.g.*, Megan D. Hargraves, Note, *Constitutional Law—First Amendment & Freedom of Speech—Students May Be Regarded As Closed-Circuit Recipients of the State's Anti Drug Message: The Supreme Court Creates A New Exception to the Tinker Student Speech Standard*. *Morse v. Frederick*, 127 S. Ct. 2618 (2007), 30 U. ARK. LITTLE ROCK L. REV. 565, 567 (2008) (recognizing influence of Emerson). *See also* Beckerman-Rodau, *supra* note 164, at 6–7 (articulating essentiality of free speech to free society relative to need to protect IP); Clay Calvert, *Off-Campus Speech, on-Campus Punishment: Censorship of the Emerging Internet Underground*, 7 B.U. J. SCI. & TECH. L. 243, 282 (2001) (elaborating on latter Emerson interest, citing RODNEY A. SMOLLA, *FREE SPEECH IN AN OPEN SOCIETY* 13 (1992)).

176. In addition to its commercial and non-constitutional rationale, trademark law is for many reasons ill-suited as a model for design patent fair use. A broad range of doctrinal approaches populate a rough and unsettled terrain at the border of trademark and free speech, all pointing to some manner of heightened First Amendment scrutiny. Prominent is the test of *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), under which, when a mark is used in an "artistic work"—"such as art works, motion pictures and books, not . . . ordinary, non-artistic, commercial speech." 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (4th ed.). *See also* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:22 (4th ed.) (citing *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008))—a court must balance the mark owner's interest in precluding confusion against the user's free speech rights, thus recognizing the public interest at stake on each side. *Rogers*, 875 F.2d at 999. "[T]hat balance will normally not support application of the [Lanham] Act [1] unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, [2] unless the title explicitly misleads as to the source or the content of the work." *Id.* For explicit misleading, likelihood of confusion must be "particularly compelling to outweigh the First Amendment . . ." 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:144.50 (4th ed.) (quoting *Twin Peaks Productions, Inc. v. Publications Intern., Ltd.*, 996 F.2d 1366, 1370 (2d Cir. 1993)). Extremely limited doctrines of "fair use" operate in

Authorized by Article I of the Constitution, copyrights exemplify the incentive rationale for IP, “promot[ing] science . . . by securing for limited times to authors . . . the exclusive right to their . . . writings . . . .”<sup>177</sup> The notion that authors require protection for expressive works as an incentive to produce and publish them is not without detractors,<sup>178</sup> but that is the widely accepted theory that grounds modern copyrights.

Copyrights are in inherent tension with freedom of expression, because the very definition of that which may be copyrighted requires “fix[ation] in a[] tangible medium of *expression*.”<sup>179</sup> Thus an author’s or owner’s assertion of copyright, for its duration, necessarily subtracts from the range of permissible expression for all others in the society. Copyright law the world over recognizes the need for balance with free expression, and the fair use doctrine strikes the balance in U.S. law.<sup>180</sup> Abundant treatises thoroughly explicate copyright law and its compromise with free expression; a full treatment is beyond the scope of this work. But a short recitation of the origin and essential standards of free expression and fair use in copyright here informs our ultimate thesis, that a fair use defense based on the copyright model is the best methodology to balance design patents and free expression.

the context of infringement by dilution. *See* 15 U.S.C. § 1125(c)(3) (2012); 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:67, 24:124 (4th ed.). *See also* 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (2012) (fair use in Anticybersquatting Consumer Protection Act). For discussion of the limited manner in which trade dress protects industrial design, see Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPs Era*, 32 LOY. L.A. L. REV. 531, 558–65 (1999). *See also* 15 U.S.C. § 1125(c)(4)(A) (2012) (trade dress dilution); 1 TRADE DRESS PROTECTION § 10:2 (2d ed.) (same); Anthony E. Dowell, Note, *Trade Dress Protection of Product Designs: Stifling the Progress of Science and the Useful Arts for an Unlimited Time*, 70 NOTRE DAME L. REV. 137, 191–92 (1994–95) (calculating that trade dress and copyright, with their indefinite and long terms, respectively, so undermine the innovation-exclusivity balance as to demand preemption by patent).

177. U.S. CONST. art. I, § 8, cl. 8.

178. *E.g.*, Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 282–84 (1970).

179. 17 U.S.C. § 102 (2012) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”). *See also* Beckerman-Rodau, *supra* note 164, at 19 (recognizing risk to free expression inherent in IP protection of information and ideas).

180. *See, e.g.*, *Golan*, 132 S. Ct. at 890 (“the ‘fair use’ defense [is] recognized in our jurisprudence as [a] ‘built-in First Amendment accommodation[.]’ (footnote omitted)). For a short treatment of the position that a policy-based First Amendment defense may exist distinct from fact-driven fair use analysis, see Shyamkrishna Balganesh, *Copyright and Free Expression: The Convergence of Conflicting Normative Frameworks*, 4 CHI.-KENT J. INTELL. PROP. 45, 69–71 (2004). Various authors furthermore examine copyright itself as a fundamental norm of human rights. *See, e.g.*, Maurizio Borghi, *Copyright and Truth*, THEORETICAL INQUIRIES IN L., vol. 12, no. 1, at 12–14 (2011), <http://ssrn.com/abstract=2358893>, <http://dx.doi.org/10.2139/ssrn.2358893> (emphasizing relationship between copyright and truth-seeking).

Cousin to “fair dealing” in foreign law,<sup>181</sup> fair use roots reach to 18th-century British law (pre-dating the Constitution)<sup>182</sup> and Judge Story’s famous 19th-century opinion in *Folsom v. Marsh*.<sup>183</sup> Under the 1831 Copyright Act, Judge Story found violation in the revelation of previously unpublished correspondence of President Washington, though the court searched for “a justifiable use. . . such as the law recognizes as no infringement.”<sup>184</sup> The concept of justification evolved into “fair use” in U.S. federal courts, ultimately manifesting as at least four factors stated in the 1976 Copyright Act:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>185</sup>

Though none is dispositive<sup>186</sup> and non-listed factors can also be considered,<sup>187</sup> economic effects are important, given the economic rationale for IP protection.<sup>188</sup> The relationship between the First Amendment and fair use is not certain, but the Supreme Court recognized in 1985 that the former compels the latter.<sup>189</sup> Patry abhorred the popular characterization of the statute as “codifying” common law.<sup>190</sup> Rather, he emphasized—and the

181. See Richard J. Peltz, *Global Warming Trend? The Creeping Indulgence of Fair Use in International Copyright Law*, 17 TEX. INTEL. PROP. L.J. 267, 277–86 (2009) (discussing fair dealing and public interest defenses in foreign law, in comparison with U.S. fair use). See also 4 PATRY ON COPYRIGHT, *supra* note 158, § 10:2 (“kissing cousin”).

182. See *Gyles v. Wilcox*, 2 Atk. 141, 143, 26 E.R. 489 (Ct. Ch. 1740), [http://copy.law.cam.ac.uk/cam/tools/request/showRecord.php?id=record\\_uk\\_1741](http://copy.law.cam.ac.uk/cam/tools/request/showRecord.php?id=record_uk_1741) (recounting counsel’s argument that British copyright in 1710 Statute of Anne should be construed liberally to incentivize production of useful works, namely an abridgment that evidences the subsequent author’s “invention, learning, and judgment”).

183. 9 F. Cas. 342 (C.C.D. Mass. 1841).

184. *Id.* at 348–49 (analyzing “the nature of the new work, the value and extent of the copies, and the degree in which the original authors may be injured”). Judge Story went so far as to express his hope for a settlement, recognizing that the defendants’ “meritorious labors” were geared to educational use. *Id.* at 349.

185. 17 U.S.C. § 107 (2012).

186. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994).

187. The four criteria are introduced with the word “include.” 17 U.S.C. § 107 (2012). Congress defined “include” in the statute to be “illustrative and not limitative.” *Id.* § 101, para. 24.

188. *Beckerman-Rodau*, *supra* note 164, at 43–44.

189. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985) (citing *Schnapper v. Foley*, 667 F.2d 102 (1981); 1 MELVILLE B. NIMMER, COPYRIGHT § 1.10[B], at 1–70, n.24 (1984); WILLIAM F. PATRY, THE FAIR USE PRIVILEGE IN COPYRIGHT LAW 140–42 (1985)).

190. 4 PATRY ON COPYRIGHT, *supra* note 158, § 10:8.

Court emphasized in 1994—that Congress, per its own committee reports, meant only to “recogniz[e]” fair use<sup>191</sup> and to “continue the common-law tradition of fair use adjudication.”<sup>192</sup> Thus courts should preserve “[t]he constitutional balance between sufficient incentives to authors and reasonable, unconsented-to and uncompensated uses by the public can be maintained only if courts fully and comfortably don their common-law hats.”<sup>193</sup> Public interest, not authors’ interests, is paramount.<sup>194</sup>

While fair use embodies free expression as an affirmative defense to copyright infringement, copyright in the first instance also bears structural protection for free expression.<sup>195</sup> As a threshold matter, a work must be minimally creative, or “original,”<sup>196</sup> to warrant copyright. The meaning of the requirement is highly debated, but it is “central” to the Article I balance between incentivizing productivity and protecting economic monopoly.<sup>197</sup> The principle is important in First Amendment law because the republication

191. *Id.*

192. *Campbell*, 510 U.S. at 577 (citing H.R. Rep. No. 94-1476, at 66 (1976), U.S.C.C.A.N. 1976, at 5659; S. Rep. No. 94-473, at 62 (1975), U.S.C.C.A.N. 1976, at 5679). Patry lamented courts’ infidelity to this understanding. While placing “the lion’s share of the blame . . . squarely on copyright owners’ wildly inflated views of the scope of their rights,” he also accused courts of “squeeze[ing] a common-law concept of great flexibility and scope into the straight jacket of statutory words meant merely to evoke but not encapsulate and certainly not to constrain the doctrine.” 4 PATRY ON COPYRIGHT, *supra* note 158, § 10:1.50.

193. 4 PATRY ON COPYRIGHT, *supra* note 158, § 10:8.

194. *Id.* § 10:1.50.

195. Beckerman-Rodau, *supra* note 164, at 39.

196. 17 U.S.C. § 102(a) (2012). Works lacking sufficient creativity are not eligible for copyright protection; importantly, simply working hard to produce a work does not justify a copyright absent creativity. *See* Clifford, *supra* note 10. The paradigmatic “sweat of the brow” case, involving a telephone directory, is *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (holding that the white pages of a telephone book cannot be copyrighted as insufficient creativity is shown).

There have been increasingly ardent calls to depart from this norm in the case of databases, *see* Jacqueline Lipton, *Balancing Private Rights and Public Policies: Reconceptualizing Property in Databases*, 18 BERKELEY TECH. L.J. 773, 784–90 (2003); *e.g.*, L.M. BROWNLEE, IP DUE DILIGENCE IN CORPORATE TRANSACTIONS § 9.3 (2014), which have been the source of trans-Atlantic angst, *e.g.*, John Edwards, Note, *Has the Dreaded Data Doomsday Arrived?: Past, Present, and Future Effects of the European Union’s Database Directive on Database and Information Availability in the European Union*, 39 GA. L. REV. 215, 215–18 (2004), and in the debated but narrow context of the hot news doctrine, *see generally* VICTORIA SMITH EKSTRAND, NEWS PIRACY AND THE HOT NEWS DOCTRINE: ORIGINS IN LAW AND IMPLICATIONS FOR THE DIGITAL AGE 1–8 (2005).

197. 2 PATRY ON COPYRIGHT, *supra* note 158, § 3:33. Patry acknowledged that the theory is not universally accepted. *Id.* § 3:33, n.1 (positing that the originality requirement serves primarily to ease the evidentiary burden on courts confronted with “two indistinguishable works (indistinguishable because they contain trivial amounts of expression . . .)” citing, WILLIAM M. LANDES AND RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 90 (2003)). *See also* Clifford, *supra* note 10. Perhaps owing to uncertainty over what the requirement means, it more often arises in infringement cases than at the threshold of copyright, despite its definitional nature. 2 PATRY ON COPYRIGHT, *supra* note 158, § 3:33. Of course, unlike patents, copyright registration is not a prerequisite for obtaining legal rights. 17 U.S.C. § 408(a) (2012). In fact, registration often does not occur until just prior to litigation as registration is a prerequisite for filing an action by most U.S. copyright holders. *See id.* § 411(a).

of facts remains unhindered by copyright as long as the republication carries over no injection of creativity from the original expression.<sup>198</sup>

The fixation and creativity requirements for copyright furthermore bolster the idea-expression dichotomy, by which copyright protects only expression and cannot preclude the taking and reuse of the ideas communicated by the expression.<sup>199</sup> Accordingly, the law expressly denies copyright to the ideas that animate a protected work.<sup>200</sup> Patry criticized the popular conception of dichotomy, positing instead an “expression continuum,” from idea to embodiment, which conveys the essence of the fact-finder’s job, distinguishing among shades of gray that which the law protects against copying from that which may be copied.<sup>201</sup> The essence of the distinction anyway serves “to accommodate First Amendment values” in copyright law.<sup>202</sup> The Supreme Court recognized the connection in 1985<sup>203</sup> and reiterated in 2003<sup>204</sup> and 2012<sup>205</sup> that “copyright law contains built-in First Amendment accommodations,” namely the idea-expression dichotomy and the fair use defense.<sup>206</sup>

The most important modern case that models reconciliation of copyright and free expression is *Campbell v. Acuff-Rose Music*.<sup>207</sup> Salient here is the nature of the use of the copyrighted materials in *Campbell*, an admittedly imitated song melody and lyrics, although arguably as a parody.<sup>208</sup> Parody is especially problematic at the juncture of intellectual property and free expression, because for a parody to be successful, the author must republish enough of the original to evoke the resemblance in the perception of the audience—even better to create, for a moment, the

198. See, e.g., *Baker v. Selden*, 101 U.S. (11 Otto) 99, 101–04 (1879).

199. E.g., 17 U.S.C. § 102(b) (2012); 2 PATRY ON COPYRIGHT, *supra* note 158, § 4:31.

200. 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

201. 2 PATRY ON COPYRIGHT, *supra* note 158, § 4:36. See, e.g., *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (L. Hand) (establishing the series of abstractions test).

202. 2 PATRY ON COPYRIGHT, *supra* note 158, § 4:44.

203. *Harper & Row Publishers, Inc. v. Nation Enters.* 471 U.S. 539, 556 (1985) (citing *inter alia*, as example, *New York Times Co. v. United States*, 403 U.S. 713, 726, n.\* (1971) (Brennan, J., concurring) (iterating in landmark prior restraint case scope of copyright as exclusive of ideas)).

204. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

205. *Golan v. Holder*, 132 S. Ct. 835, 890 (2012).

206. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003). Specifically in the context of the 1998 Copyright Term Extension Act in that case, the Court also pointed to an archiving privilege, 17 U.S.C. § 108(h) (2012), and a small-business exemption from broadcast music royalties, *id.* § 110(5)(B). *Eldred*, 537 U.S. at 220.

207. 510 U.S. 569 (1994).

208. See *id.* at 572–73.

mistaken impression that the audience is perceiving the original, thus the very confusion that evidences infringement in copyright and trademark analysis.<sup>209</sup> At the same time, parody is a time-honored American political tradition, so lies at the heart of First Amendment protection for political speech and social commentary.<sup>210</sup>

Applying the fair use factors, the Court refused to find the defendant's commercial motive as presumptively contrary to fair use in "purpose and character" analysis.<sup>211</sup> The Court found "not much help" in "nature" analysis, because "parodies almost invariably copy publicly known, expressive works."<sup>212</sup> The Court conducted "amount and substantiality" analysis mindful of the defendant's legitimate parodic purpose, "to 'conjure up' at least enough of that original to make the object of its critical wit recognizable."<sup>213</sup> In this light, even the parodist's taking from the "heart" of the original is not necessarily fatal.<sup>214</sup>

On the fourth factor, market effect, the Court emphasized the transformative nature of parody, which typically renders a product that is not a "market replacement" for the original.<sup>215</sup> Critically on the oft weighty fourth factor, the Court observed that even when "a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act."<sup>216</sup> The relevant market for fair use analysis in such a case is the market for "critical commentary" (or similar derivative work),<sup>217</sup> like the defendant's work, not the market for the target of the commentary, the plaintiff's work.

The Court in *Campbell* scarcely mentioned the First Amendment,<sup>218</sup> but the notion of constitutional protection for critical speech ran deep in the opinion. In later construction of the Copyright Term Extension Act in 2003, the Court cited *Campbell* in the heart of an iteration of copyright's balance with the First Amendment, parallel to fair use "'latitude for scholarship and comment'" and complementary to the idea-expression dichotomy.<sup>219</sup>

209. *See id.* at 580–81.

210. *E.g.*, *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 54–55 (1988).

211. *Campbell*, 510 U.S. at 583.

212. *Id.* at 586.

213. *Id.* at 588.

214. *Id.*

215. *Id.* at 591.

216. *Id.* at 591–92.

217. *Id.* at 593.

218. *See id.* at 583 (citing *Yankee Publishing Inc. v. News America Publishing, Inc.*, 809 F. Supp. 267, 280 (S.D.N.Y. 1992), and noting that the District Court applied the First Amendment to parodies).

219. *Eldred v. Ashcroft*, 537 U.S. 186, 220 (2003) (quoting *Harper & Row*, 471 U.S. at 556–560; citing *Campbell*, 510 U.S. 569).

A final point of friction between copyright and free expression arose in the Supreme Court's refusal to fetter Congress in construction of Article I's "limited times" authorization. In *Eldred v. Ashcroft*, upholding the 1998 Copyright Term Extension Act against various constitutional challenges, the Supreme Court employed the deference of mere rationality review to test the scope of congressional power.<sup>220</sup> As mentioned above, the Court explicitly recognized the shared common function of the Copyright Clause and the First Amendment in furthering public access to knowledge.<sup>221</sup> The Court held that the balance struck in the Copyright Clause itself was sufficient to resist heightened First Amendment scrutiny.<sup>222</sup> But the Court also observed that "the D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'"<sup>223</sup> Repeatedly the Court recalled that the primary purpose of copyright exclusivity is public access to copyrighted work;<sup>224</sup> a grant of property rights to authors is only a means to that "'constitutional aim."<sup>225</sup>

Also informative is the *Eldred* and *Golan* Courts' inclusion of patents in discussing the copyright cases. In *Eldred*, the Court upheld retroactive copyright term extension partially upon analogy to the same practice in patent law, under the same Article I power.<sup>226</sup> In comparing the two areas, the Court recognized that both patents and copyrights strive for access to knowledge by balancing the exclusivity incentive to innovation with anti-monopolism.<sup>227</sup> But the Court drew a sharp distinction between copyrights and patents in approach. In patents, *quid pro quo* is an apt description of the bargain, because an inventor is incentivized by a property grant to bring to public light a process or thing that otherwise would remain secret. In copyrights, "disclosure is the desired objective, not something exacted from the author in exchange for the copyright."<sup>228</sup> Furthermore, copyright law's limited reach to expression, but not to fact or idea, limits the subtraction from the public domain. "A reader of an author's writing may make full use of

220. *Id.* at 204.

221. *Id.* at 218–20.

222. *Id.*

223. *Id.* at 221.

224. *Id.* at 205 (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)); 207 (quoting H.R. Rep. No. 105-452, at 4 (1998)); 213 (quoting *Sony Corp.*, 464 U.S. at 429); 214 (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)); 219 (quoting *Harper & Row*, 471 U.S. at 558 (copyright as "engine of free expression")).

225. *Id.* at 223 (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 6 (1966) (referencing IP Clause in upholding legislative condition of patentability)).

226. *Id.* at 202–03.

227. *Id.* at 215.

228. *Id.* at 216.

any fact or idea she acquires from her reading”); in contrast, “patent[s]. . . prevent full use by others of the inventor’s knowledge.”<sup>229</sup> Similarly, in *Golan*, the Court cited several patent cases that upheld the restoration of patent rights to inventions that had briefly entered the public domain to sustain Congress’s restoration of copyrights to Berne works under the Uruguay Round of trade negotiations.<sup>230</sup>

Copyrights always have had an uneasy, overlapping coverage with product design protection.<sup>231</sup> The 1870 Copyright Act extended art protection to designs as “fine art,” including three-dimensional objects, while design patent was authorized in the same statute for works within “any article of manufacture.”<sup>232</sup> In a “sea change,” the 1909 Copyright Act dropped the “fine art” requirement.<sup>233</sup> Patry reported that the change resulted specifically from bar advocacy favoring “protection of designs of useful articles,”<sup>234</sup> though eligibility for copyright of functional design features remained a point of contention for 45 years.<sup>235</sup>

In 1954, in *Mazer v. Stein*, the Supreme Court at last ruled that functionality did not preclude copyright, holding that dancing statuettes were copyrightable even though they formed the bases for electric lamps.<sup>236</sup> Moreover, the Court rejected the argument that copyright and design patent must be mutually exclusive.<sup>237</sup> Both serve the public interest with an incentive-reward bargain: copyright protects expression and originality in “art,” while patent protects “invention of original and ornamental design.”<sup>238</sup>

Copyright law today maps protection co-extensively with non-functionality. “Pictorial, graphic, and sculptural works” are protected only insofar as they “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>239</sup> This standard

229. *Id.* at 217.

230. *Golan v. Holder*, 132 S. Ct. 835, 886–87 (2012).

231. For a thorough history of design protection in U.S. and foreign copyright law from 1948 to 1976, 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, 1145–264.

232. 2 PATRY ON COPYRIGHT, *supra* note 158, § 3:125 & n.2 (quoting Act of July 8, 1870, 41st Cong., 2d Sess., 16 Stat. 198, 209, 212).

233. *Id.* § 3:126 (quoting 17 U.S.C. § 5(g) (1909, repealed 1978)).

234. *Id.*

235. See *id.* §§ 3:126–3:131. See generally Note, *Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?*, 66 HARV. L. REV. 877 (1953).

236. *Mazer v. Stein*, 347 U.S. 201, 217 (1954). For our earlier discussion of the *Mazer* case, see *supra* text accompanying and following note 75.

237. *Mazer*, 347 U.S. at 217.

238. *Id.* at 217–19.

239. 17 U.S.C. § 101 (2012). See also *Fabrica Inc. v. El Dorado Corp.*, 697 F.2d 890, 893 (9th Cir. 1983) (summarizing legislative history); 2 PATRY ON COPYRIGHT, *supra* note 158, § 3:135 (summarizing

admits of simultaneous enforcement of a copyright and design patent. For example, the Federal Circuit, in *Amini Innovation Corp. v. Anthony California, Inc.*, remanded for trial a case involving copyright and design patent infringement claims regarding ornamental features carved into the plaintiff's wood furniture.<sup>240</sup> The copyright claim reached "features includ[ing] a lion's paw, ball, reeds, leaf-and-flower motifs, foliate scrolls, C- and S-shaped scrolls, a serpentine decoration, a seashell motif, laurel wreaths, an iron-canopy rail, beads, and moldings."<sup>241</sup> The design patent claimed "[t]he ornamental design for a bed frame" and "show[ed] the complete bed frame with many ornamental features."<sup>242</sup> The differences in the analyses, side by side, is instructive, because the circuit court concluded that the trial court had erred in understanding both.<sup>243</sup>

The copyright analysis begins with the identification of the protected work, which is ascertained, by statute, in the search to separate utilitarian features from artistic features.<sup>244</sup> The analytical process then diverges in the circuits; the Ninth Circuit, for example, applies a two-part, conjunctive test: first, an "extrinsic test," . . . an objective comparison of specific expressive elements," employing expert testimony; and second, an "intrinsic test," . . . a subjective comparison that focuses on whether the ordinary reasonable audience would find the works substantially similar in the 'the total concept and feel . . . .'"<sup>245</sup> The *Amini* trial court had been too quick to let its feature-by-feature extrinsic analysis control the outcome. The court improperly took

legislative history). With regard to copyrightable aspects of useful articles, the act further provides that when the articles are offered for sale or public distribution, copyright does not preclude the "making, distribution, or display of pictures or photographs . . . in . . . advertisements or commentaries related to the distribution or display . . . or in . . . news reports." 17 U.S.C. § 113(c) (2012). The scope of copyright protection for works of visual art issued in limited editions, including the three-dimensional, was subsequently enhanced by the Visual Artists Rights Act of 1990, codified at *id.* § 106A, which introduced some of the European-conceived "moral rights" framework into U.S. law after Berne Convention accession. See generally, e.g., Lindsey A. Mills, Note, *Moral Rights: Well-Intentioned Protection and Its Unintended Consequences*, 90 TEX. L. REV. 443, 445–49 (2011).

240. 439 F.3d 1365, 1368 (Fed. Cir. 2006). See also Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845, 853–54 (2003) (citing jewelry as example of commercial art protected in copyright). *Amini*, used for guidance here, is explicated in Daniel H. Brean, *Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Design*, 16 TEX. INTELL. PROP. L.J. 325, 361–63 (2008).

241. *Amini*, 439 F.3d at 1368.

242. *Id.* at 1371 (quoting patent).

243. *Id.* at 1372.

244. *Id.* at 1368–69. For discussion of "conceptual separability" and the more lenient test for architecture, see Frenkel, *supra* note 176, at 534–35, 565–71. The separation might be easier said than done. See, e.g., Brean, *supra* note 240, at 339–41; discussion, *supra* note 132.

245. *Amini*, 439 F.3d at 1369 (quoting *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002)). See also Brean, *supra* note 240, at 348–49 (discussing substantial similarity in context of product design). But see discussion, *supra* note 132 (recognizing eight different tests).

the “total concept” question away from the jury, which is favored to decide it.<sup>246</sup>

In comparison, the design patent analysis also begins by identifying that which is protected. Simply enough to state, the design patent reaches “non-functional aspects of an ornamental design as seen as a whole and as shown in the patent.”<sup>247</sup> Those aspects of the design are then subject to infringement and novelty analysis. As to infringement, the court tests whether “in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, [meaning] the resemblance is such as to deceive [the] observer, inducing him to purchase one supposing it to be the other.”<sup>248</sup> The deception must flow from “overall design, not . . . similarities in ornamental features considered in isolation.”<sup>249</sup> The ordinary observer’s analysis is informed by the points of novelty that distinguished the patented design from the prior art, and which arguably were appropriated by the accused design.<sup>250</sup> At minimum, the plaintiff must enter into evidence the patent prosecution history and some contentions as to novelty.<sup>251</sup> In the furniture case, the trial court was too in the weeds, “mistakenly analyz[ing] each element separately instead of analyzing the design as a whole from the perspective of an ordinary observer.”<sup>252</sup> Moreover, the trial court had disposed of the matter on summary judgment before the plaintiff had entered evidence of novelty for the fact-finder to consider.<sup>253</sup>

These analyses show both differences and similarities. Both strive to differentiate the utilitarian, as not protected, from the artistic, as protected.<sup>254</sup>

246. *Amini*, 439 F.3d at 1370.

247. *Id.* (quoting *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)).

248. *Id.* at 1371 (quoting *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871)); *Du Mont*, *supra* note 161, at 531 (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678–79 (Fed. Cir. 2008)). *See also* *Brean*, *supra* note 240, at 346–47.

249. *Amini*, 439 F.3d at 1371.

250. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 676–79 (Fed. Cir. 2008) (rejecting conjunctive model of ordinary-observer and points-of-novelty tests, while explaining relevance of points of novelty to sole ordinary-observer test); *Amini*, 439 F.3d at 1371 (citing *Oakley, Inc. v. International Tropic-Cal, Inc.*, 923 F.2d 167, 169 (Fed. Cir. 1991)). For explanation of how the consolidation of infringement analysis under the “ordinary observer” banner effected a shift in the burden of proof to favor the patent holder, *see, e.g.*, Bruce A. Kugler & Craig W. Mueller, *A Fresh Perspective on Design Patents*, COLO. LAW., July 2009, at 71.

251. *Amini*, 439 F.3d at 1372.

252. *Id.*

253. *Id.* at 1371–72.

254. These analyses are close enough to the same for our purposes here, but approaches developed in the courts do differ. For a thorough discussion of various approaches and the confusion surrounding the differences, *see* *Frenkel*, *supra* note 176, at 544–54.

*Copyrights:* Copyrights require originality, though upon a trifling threshold, just past sweat of the brow.<sup>255</sup> In ascertaining the contours of the protected subject matter, copyrights focus on originality of expression. Expert examination of particular ornamental features is sensible in the first step, complemented by the lay “total feel” approach in the second. The copyright claim is narrative and specific as to scope, as if the protected design elements were “writings” in the classic sense.

*Design Patents:* Design patents meanwhile focus on novelty of idea.<sup>256</sup> The analysis is big-picture, appropriate to the examination of ideas, much like as if there were a useful invention at issue. Protected content arises in the delta from prior art, and a design is otherwise viewed as a whole.

Both analyses mean protection to what is new, whether original or novel—that is, “Progress” in the constitutional language.<sup>257</sup> Both analyses focus infringement analysis on similarity, that is, the copying of expression or the taking of idea. Neither analysis will find infringement without testing for some kind of mistake or interchangeability from an observer’s perspective.<sup>258</sup>

### *B. Design Patents and Copyright Fair Use; Or, a Tale of Two Toilet Tissues*

As discussed previously, design patents are neither fish nor fowl,<sup>259</sup> overlapping functionally and historically with copyrights. The concept of design protection was known at the time the Constitution was framed, as the

255. See Clifford, *supra* note 10.

256. See Beckerman-Rodau, *supra* note 164, at 20 & n.90 (finding common ground in “unique[ness]” between copyright originality and patent novelty). Design patents also formally require non-obviousness. See 35 U.S.C. § 103 (2012); Frenkel, *supra* note 176, at 554–56. That requirement, however, once heralded as near prohibitive, *e.g.*, Brean, *supra* note 240, at 338, seems today to have been reduced to negligibility, see Burstein, *Design Patent Myths—Most Designs Can’t Satisfy the Requirement of “Nonobviousness,” supra* note 7 (touting originality analysis as more appropriate than novelty analysis for design protection).

257. Laura Heymann, *Overlapping Intellectual Property Doctrines*, 17 STAN. TECH. L. REV. 239, 246 (2013). Heymann articulated a “contrast” between copyright and design patent in that the former means to attain the “worthwhile” through the proliferation of works, while the novelty in design patent “is concerned with progress in a more linear sense: the development of the practice of design over time.” *Id.* at 247. She furthermore cited the Supreme Court in *Mazer* drawing a distinction between art for art’s sake and applied art. *Id.* at 247 n.21 (citing Gregory R. Mues, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs*, 49 ST. JOHN’S L. REV. 543, 572 (1974–75)). With utilitarian function separated out in copyright analysis and design patent scope, we see no “contrast” remaining in this distinction. Rather, to assess art based on its application seems normatively hazardous from a First Amendment perspective.

258. See Heymann, *supra* note 257, at 248.

259. See *supra* part II.A.4; Magliocca, *supra* note 240, at 845 (“The protection of esthetic product design is the most intractable issue in intellectual property law.”).

British gave limited protection to design as a kind of copyright in the Designing and Printing of Linen Act of 1787.<sup>260</sup> British protection extended beyond textiles with the Copyright and Design Act of 1839, then the Design Act of 1842.<sup>261</sup> Design patents as a creature of statute in the United States date to 1842.<sup>262</sup> Design patents always were regarded as things apart from utility patents.<sup>263</sup> The patent commissioner by 1851 would have preferred to treat designs like engravings under copyright law, but that shift was never to be.<sup>264</sup> Meanwhile copyrights came over time to embrace “works of artistic craftsmanship,” excluding “utilitarian aspects.”<sup>265</sup> Today both copyrights and design patents may attach to a product design, regardless of whether it constitutes the mundane, such as the design of a concrete mixer,<sup>266</sup> or fine art, as might be found in a museum.<sup>267</sup>

Formally, if coincidentally, design patents are offspring of the patent family.<sup>268</sup> Design protection today retains its location alongside patents in title 35 of the U.S. Code and has *sui generis* protection as “community design” in the European Union.<sup>269</sup> Like utility patents, if not as burdensome,<sup>270</sup> design patents are cumbersome and expensive to prosecute,

260. See *History of Designs*, NATIONAL ARCHIVES (U.K.), INTELLECTUAL PROPERTY OFFICE, <http://webarchive.nationalarchives.gov.uk/20140603093549/http://www.ipo.gov.uk/types/design/d-about/d-what/d-history.htm> (last visited Sept. 10, 2015).

261. See *id.*

262. Brean, *supra* note 240, at 327 (citing Act of Aug. 29, 1842, ch. 263, s. 3, 5 Stat. 543 (1842) (codified as amended at 35 U.S.C. § 171 (2012))); Du Mont, *supra* note 161, at 538–39. See also Heymann, *supra* note 257, at 244.

263. Du Mont, *supra* note 161, at 538.

264. *Id.* at 539.

265. *Id.* (quoting 1949 regulation).

266. Heymann, *supra* note 257, at 14 (citing *In re Koehring*, 37 F.2d 421, 424 (C.C.P.A. 1930)). Attractiveness is immaterial. *E.g.*, Brean, *supra* note 240, at 336.

267. The difference might lie only in the eye of the beholder. See generally, *e.g.*, MADSONIAN MUSEUM OF INDUSTRIAL DESIGN, <http://www.madsonian.org/> (last visited Sept. 10, 2015).

268. Magliocca, *supra* note 240, at 850 (describing location of design protection in patent law as “largely an accident of circumstance”).

269. See *e.g.*, *Community Design*, INTERNATIONAL TRADEMARK ASSOCIATION, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/CommunityDesignFactSheet.aspx> (last visited Sept. 10, 2015). See also Brean, *supra* note 240, at 371–74. Proposals in the United States have ranged from modest refinement to the *status quo*, Dowell, *supra* note 176, at 191–92, to *sui generis* protection, *e.g.*, Frenkel, *supra* note 176, at 575–79, to expanded copyright, Steve W. Ackerman, Note, *Protection of the Design of Useful Articles: Current Inadequacies and Proposed Solutions*, 11 HOFSTRA L. REV. 1043, 1065–68 (1983); Valerie V. Flugge, *Works of Applied Art: An Expansion of Copyright Protection*, 56 S. CAL. L. REV. 241, 253–56 (1982); Ronald L. Panitch, *Design Patents*, ALA-ABA COURSE OF STUDY, C602 ALI-ABA 295, 308 (Apr. 11, 1991), to the phasing out of express design protection in favor of copyright and trademark, Brean, *supra* note 240, at 374–81.

270. Design patents are substantially less burdensome in application fees, attorney fees, time to issuance, and litigation costs, while affording design patent holders minimum statutory damages that are unavailable to utility patent holders. For a comparison in 2009, see Kugler & Mueller, *supra* note 250.

a matter up front for patent attorneys and product experts.<sup>271</sup> In contrast, copyrights afford protection automatically upon creation<sup>272</sup> and offer additional protection through a lay-accessible registration process.<sup>273</sup> Most expenses are postponed until infringement is claimed, and unlike design patent, copyright holders can be awarded statutory damages.<sup>274</sup> The 14-year term of the design patent<sup>275</sup> is close to the 20-year term of the utility patent<sup>276</sup> and far short of the life-plus- 70-, 95-, or 120-year terms of copyright.<sup>277</sup> To qualify for patent, a design must be novel, non-obvious, and ornamental, the former two elements in common with the utility patent, and only the latter distinguishing design from its “useful” sibling.<sup>278</sup> Infringement of a design patents is governed by the same make-use-sell-import formula as utility patents.<sup>279</sup>

Looking at design patents from the perspective of their functionality, however, demonstrates that they have more in common with their copyright cousins than with their utility patent sisters. Sitting at the confluence of copyright and patent,<sup>280</sup> design patents, like copyrights, protect inherently expressive content, in contrast with utility patents’ protection of “process[es], machine[s], manufacture[s], or composition[s] of matter.”<sup>281</sup> For example, qualifications for a design patent examiner focus on art—the domain of copyright—rather than technology—the domain of the utility patent.<sup>282</sup> Magliocca wrote of the inherently subjective character of design patent analysis, “Lawyers cannot just go into a phone booth and change into

Kugler and Mueller also pointed out that because design patents are unpublished until issued, infringers might already be invested in the marketing and sale of their products when they discover their wrong. *Id.*

271. For a short treatment of the arrangement of the application, see Panitch, *supra* note 269, at 302–04.

272. See 17 U.S.C. § 102(a) (2012) (“Copyright protection *subsists*. . .” (emphasis added)).

273. See *id.* §§ 408–09; Dowell, *supra* note 176, at 137–38 (positing dangerousness to innovation in indefinite trade dress monopoly to protect design).

274. See 17 U.S.C. §§ 412, 504–05 (2012).

275. 35 U.S.C. § 173 (2012).

276. *Id.* § 154(a)(2). There are a variety of facts that can extend the 20-year term for a longer period, most dealing with a delay in issuing a patent that is caused by the Patent and Trademark Office, see *id.* § 154(b) or by the need to obtain regulatory approval for the marketing of the product, see *id.* § 156.

277. See 17 U.S.C. § 302 (2012) (addressing works created on or after January 1, 1978); *id.* §§ 303–04 (addressing works created earlier).

278. 35 U.S.C. § 171; see generally, Burstein, Design Patent Myths—An Introduction, *supra* note 7.

279. 35 U.S.C. § 271(a) (2012); see, e.g., Brean, *supra* note 240, at 346.

280. E.g., Magliocca, *supra* note 240, at 850.

281. 35 U.S.C. § 101 (2012).

282. Burstein, *Design Patent Myths—An Introduction*, *supra* note 7. For comparison of the design patent and copyright overlap in artistic product design, see Kruger & Mueller, *supra* note 250.

art critics.”<sup>283</sup> Indeed, infringement analysis in a copyright infringement suit acknowledges and attempts to avoid this subjective inquiry.<sup>284</sup>

The overlap of design patents with their cousins is nicely illustrated by an analogous example; consider the diamond quilting pattern in toilet tissue that was at issue in *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.*<sup>285</sup> The example is especially attractive here because of its resemblance to the 18th-century, textile-print origin of industrial design protection. In an opinion that must have rubbed Georgia-Pacific raw, the Seventh Circuit upheld cancellation of the company’s trademark, the only issue on appeal.<sup>286</sup> To the soothing comfort of competitor Kimberly-Clark, the court observed that Georgia-Pacific had in its own advertising touted the functionality of quilting for softness and moisture absorption, thus rendering the design to the domain of the utility patent rather than trademark.<sup>287</sup>

Saliently for our analysis, though, successfully or not, Georgia-Pacific had deployed a full arsenal of IP tools to protect its diamond design, including copyright, trademark, utility patent, design patent, and unfair competition law.<sup>288</sup> These tools cannot all be applicable simultaneously for the same aspect of intellectual property because of the functionality-ornamentation dichotomy between trademarks and copyrights, on one side, and utility patents on the other. But had the design been held merely ornamental, as Georgia-Pacific argued,<sup>289</sup> then copyright, trademark, and design patent could have applied simultaneously, to the exclusion of utility patent, demonstrating the conceptual qualities the three share. The U.S. Congress and courts have not embraced a doctrine of exclusive election in which IP owners must choose a preferred regime of protection;<sup>290</sup> rather, the

283. Magliocca, *supra* note 240, at 852.

284. See, e.g., *Steinberg v. Columbia Pictures Ind., Inc.*, 663 F. Supp. 706, 711–14 (S.D.N.Y. 1987) (describing process of determining substantial similarity). This case was selected out of the many establishing the point in homage to Robin Williams (1951–2014). The case involved a poster used to publicize his movie, *Moscow on the Hudson* (1984), for which he was nominated for a Golden Globe Award for Best Actor. R.I.P.

285. *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.*, 647 F.3d 723 (7th Cir. 2011). The case involves the more distant cousin of design patents, trademarks, rather than copyrights. The distinction between functionality that drives utility patents and ornamentation that drives trademarks, however, mirrors the same split between utility patents and copyrights. See *supra* part II.B.3.b.

286. *Id.* at 732.

287. *Id.* at 731.

288. *Id.* at 726.

289. *Id.* at 730.

290. See, e.g., discussion of *Application of Yardley* case, *supra* text accompanying and following note 71; *Swanson Mfg. Co. v. Feinberg-Henry Mfg. Co.*, 147 F.2d 500, 503–04 (2d Cir. 1945).

IP areas operate in overlapping spheres, each upon its native norms, rarely interfering with the applicability of the others.<sup>291</sup>

Copyright protects expression, that is, here, the original expression of diamond design as fixed in the tangible medium of toilet tissue. Functionality does not preclude copyright, but non-copyrightable utilitarian features must be separated conceptually from copyrightable artistic features in infringement analysis.<sup>292</sup> For a limited time—and barring the improbable independent creation, as opposed to copying<sup>293</sup>—copyright subtracts the use of this particular diamond expression from the marketplace of ideas. Meanwhile the *idea* of diamond-quilted toilet tissue may be freely reiterated in the society—for whatever it's worth without the expression.<sup>294</sup>

Should copyrights not be used, design patents would likely be the best alternative to protect any merely ornamental and nonfunctional patterns contained on Georgia-Pacific's toilet paper. Consistently with the patent code, an infringement claim could arise from making, selling, or using the protected design.<sup>295</sup> An infringement claim would test for novelty and demand comparison of the novel aspects of the two designs.<sup>296</sup> Infringement would rest upon the ordinary observer's potential to mistake the latter use for the protected use.<sup>297</sup>

291. Heymann, *supra* note 257, at 256. *See also* Brean, *supra* note 240, at 355–60 (analyzing overlap for Statue of Liberty, classic Coca-Cola bottle, and Levi Strauss jeans pocket); Gregory R. Mues, *Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs*, 49 ST. JOHN'S L. REV. 543, 568–73 (1974–75) (observing failure of election doctrine). For background on the interaction of copyright and design patent regimes, see Brean, *supra* note 240, at 330–32; Flugge, *supra* note 269, at 246–47; Frenkel, *supra* note 176, at 539–43; Heymann, *supra* note 257, at 251–56; Panitch, *supra* note 269, at 305–06. For exploration of the specific problem of blank-form protection in at the junction of copyright and design patent, see Ryan Vacca, *Design Patents: An Alternative When the Low Standards of Copyright Are Too High?*, 31 S. ILL. U. L.J. 325, 355–58 (2007). For background on the interaction of trade dress and design patent regimes, see Brean, *supra* note 240, at 332–36. For discussion of how overlapping regimes should be managed through the judicious analysis of harms and employment of remedies and defenses, see Heymann, *supra* note 257, at 241–42, 269–75; Clifford, *supra* note 31.

292. *See supra* part II.B.3.b & note 132.

293. *See, e.g.,* *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984) (“[N]o matter how similar the two works may be (even to the point of identity), if the defendant did not copy the accused work, there is no infringement.”).

294. *See* 17 U.S.C. § 102(b) (2012). Of course, the idea and expression contained in the diamonds on the toilet paper may be so non-severable as to invoke the merger doctrine. *See* *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). This would not be a problem for more complex designs, however.

295. *See* 35 U.S.C. § 271(a) (2012).

296. *See* *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (“For a design patent to be infringed, however, no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” (quotation marks omitted)).

297. *See* *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871).

Design patents therefore have far more in common with copyrights than with utility patents. Utility patent infringement arises from copying, or from equivalence of function, manner, and result.<sup>298</sup> Thus copyright and all patent infringement involves a sort of copying, notwithstanding copyright's defense of independent creation. But the focus of utility patent infringement is on function.<sup>299</sup> Were Georgia-Pacific to claim utility patent protection for its moisture-wicking toilet tissue, the analysis in an infringement claim would focus on the invented process.<sup>300</sup> In contrast, both copyrights and design patents focus on artistic or ornamental features, whether of toilet tissue or a bed frame.<sup>301</sup> Process plays no role in copyright and design patent analyses, which focus instead on the expression that is subtracted from the marketplace of ideas. Copyrights demand alienation of utilitarian aspects from their analysis, and design patents fail for the inclusion of functional characteristics. In the IP-free speech balance, market substitution is a critical factor in the copyright analysis, just as consumer confusion is key to trademark infringement,<sup>302</sup> and observed interchangeability is key to design patent infringement. Where utility patents under the doctrine of equivalence, in the absence of plain copying, examine element by element with specificity, the court in copyright and design patent infringement is admonished to regard the defendant's product "as a whole," for "total concept and feel."<sup>303</sup> Rather than technological advancement that the utility patents promote, copyrights and design patents place at issue, and reward in the IP-clause bargain, artistic creation. Copyrights and design patents are

298. See *Van Kannell Revolving Door Co. v. Revolving Door & Fixture Co.*, 293 F.2d 261, 262 (S.D.N.Y. 1920) (L. Hand). Cf. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950) (discussing the doctrine of equivalence).

299. See *Brenner v. Manson*, 383 U.S. 519, 528–29 (1966) (describing the requirement that an invention be "useful" to qualify for a utility patent).

300. See 5A-18A CHISUM ON PATENTS § 18.03[1][a] ("A fundamental tenet of patent law is that a patent's scope is determined by the wording of the claim or claims.").

301. E.g., *Heymann*, *supra* note 257, at 242 (observing application of copyright and design patents to "items with aesthetic appeal" and exclusion of the "useful or functional").

302. Design patent furthermore has more in common with copyright than with trademark, considering trademark's commercial focus and lack of constitutional dimension. See *supra* note 176. In contrast with copyright, trademark usually awaits the acquisition of secondary meaning upon the would-be owner's investment of time and resources. See *Brean*, *supra* note 240, at 364–66 (emphasizing secondary meaning in comparing trademark with design patent). Fanciful and arbitrary marks may be protected sooner, but their abstruse nature minimizes the risk of inadvertent infringement and ensures a negligible subtraction from the marketplace of ideas. Previous proposals for design patent reform have focused on growing the extant capacity of copyright to protect design. E.g., *Ackerman*, *supra* note 269, at 1068–71. Cf. *supra* note 269.

303. See *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871) (design patents); *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133 (2d Cir. 2003) (copyrights).

unified as they both require modest originality or novelty—even that found in the aesthetic appeal of toilet tissue.

### C. *The First Amendment Difference*

Copyrights structurally protect free speech, both in their definitional foundation and in their potent fair use defense to infringement. But in design patents, the First Amendment is missing from the story.<sup>304</sup> This omission is attributable to multiple factors. First, insofar as design patents protect commercial products, infringement is likely to involve the misleading or false commercial expression of a business competitor. In such a case, even if the First Amendment applies formally, it probably poses no barrier to enforcement of the patents. The case would be analogous to the sideline role of the First Amendment in the usual case of trademark infringement by a competitor,<sup>305</sup> or in consumer protection enforcement involving misleading or false advertising.<sup>306</sup>

Second, design patent holders are far less likely to seek enforcement against a non-commercial infringer than against a commercial infringer. A non-commercial user, or even an artist wishful of profits, offers little reward in profit disgorgement. Royalties might be perceived as substantial by the artist-defendant, but rarely make litigation affordable in the calculus of the commercial plaintiff,<sup>307</sup> particularly as there is not a generalized fee-shifting provision within the Patent Act.<sup>308</sup> Further, non-commercial use is unlikely to interfere with patent holder profits. Even if the non-commercial use is disparaging of the patent holder's product or brand, thus potentially affecting the market, patent enforcement might only amplify the artist-defendant's

304. Brean, *supra* note 240, at 351; Heymann, *supra* note 257, at 250.

305. See, e.g., *Tell Me More: Fumbled Patent: Is it Just a Matter of Business?* (NPR radio broadcast June 19, 2014), available at <http://www.npr.org/2014/06/19/323576751/fumbled-patent-is-it-just-a-matter-of-business> (explaining immateriality of First Amendment to trademark dispute over name of football team).

306. E.g., *Spirit Airlines, Inc. v. United States Dep't of Transp.*, 687 F.3d 403, 412–13 (D.C. Cir. 2012) (discussing relative standards for regulation of false or misleading commercial speech and for regulation compelling affirmative commercial disclosures).

307. See 35 U.S.C. § 284 (2012) (“Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.”).

308. See *id.* § 285; *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014) (“We hold, then, that an ‘exceptional’ case is simply one that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.”).

message.<sup>309</sup> If the subsequent use is not disparaging, it might do as much good for the brand as harm—think Andy Warhol’s *Soup Cans*.<sup>310</sup>

Third, design patents are still relatively new animals in terms of judicial experience. As commentators have observed, exploitation of the design patent has been only recently explosive.<sup>311</sup> The cell phone wars, exemplified by *Apple, Inc. v. Samsung Electronics Co.*,<sup>312</sup> are only now beginning to map this unfolding frontier in the courts.<sup>313</sup> Unexplored contours mean unpredictable outcomes in litigation, especially when lay jurors are the deciders, so litigation is deterred. From the plaintiff’s perspective, the ready patentability of the mundane gives prospective litigants pause. Dubious patent claims exert market chilling effect, as over-claiming is incentivized and risk-averse defendants are deterred from challenging validity.<sup>314</sup>

Looking to the defense, the Internet has only relatively recently opened up a global market for infringing commercial and artistic products through new channels of communication that expose infringers to discovery.<sup>315</sup> Global fair use in copyright is still an infant concept;<sup>316</sup> design patents have far to go before norms emerge around questions as nuanced as the IP-free speech balance. Making matters worse, the absurd ease with which design patents can be attained<sup>317</sup> looks more like the ease of obtaining copyright than

309. See, e.g., Richard J. Peltz-Steele, *U.S. Business Tort Liability for the Transnational Republisher of Leaked Corporate Secrets*, 1 AMITY J. MEDIA & COMM. STUDS. 68, 71 (2011), available at <http://ssrn.com/abstract=1947129> (explaining electronic-era “Streisand effect,” by which efforts to suppress information inadvertently spur prolific dissemination). Nevertheless, as we explain below, it is especially these potential defendants whose free speech is in jeopardy, whether facing a determined plaintiff or suffering a chilling effect.

310. See *Campbell Soup Cans*, MOMA LEARNING, [http://www.moma.org/learn/moma\\_learning/andy-warhol-campbells-soup-cans-1962](http://www.moma.org/learn/moma_learning/andy-warhol-campbells-soup-cans-1962) (last visited Sept. 10, 2015).

311. E.g., Dennis D. Crouch, *A Trademark Justification for Design Patent Rights*, University of Missouri School of Law Legal Studies Research Paper No. 2010-17, at 12 (draft, Aug. 10, 2010), <http://ssrn.com/abstract=1656590> (charting design patent grants from 1840 to 2010, showing upward spike from 1990 to 2010), cited in Burstein, *Design Patent Myths—An Introduction*, *supra* note 7.

312. 678 F.3d 1314 (Fed. Cir. 2012).

313. For a helpful summary of infringement lessons from *Apple v. Samsung*, see Christopher Carani, *Design Patent Lessons from Apple v. Samsung*, MANAGING IP, Sept. 2012, at 35.

314. E.g., Brean, *supra* note 240, at 377–78.

315. For discussion of global industrial design protection under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), see Frenkel, *supra* note 176, at 536–38.

316. Peltz, *supra* note 181, at 286–88.

317. See, e.g., Burstein, *Design Patent Myths—It’s Really Difficult to Get a Design Patent*, *supra* note 7 (citing recent patents for the garment hanger, cylindrical earplug, and bottle). To link to a delicious parody of this ease, see Rebecca J. Rosen, *Apple Patents Letters (JK JK)*, ATLANTIC (Nov. 26, 2012, 1:11 PM ET), <http://www.theatlantic.com/technology/archive/2012/11/apple-patents-letters-jk-jk/265590/>. The parody followed up the very real. See Emily Price, *Apple Patents the Virtual Page Turn*, CNN (Nov. 19, 2012, updated 2:53 PM ET), <http://www.cnn.com/2012/11/16/tech/innovation/apple-page-turn-patent/>.

the infamous arduousness of utility patent prosecution.<sup>318</sup> But design patents lack the inversely tempering derogation of copyright fair use.

While there is no body of free expression doctrine in design patent law, the First Amendment also has not been excluded consciously. Its omission likely is an oversight, corollary to the non-deliberate location of design protection in the patent regime (or *sui generis* in the EU) rather than in copyright. Had historical tides rested design protection in copyright, where it started in 18th-century England, there would be little serious question today that fair use would pertain as a defense. Significantly, free expression seems immaterial to the usual case of utility-patent infringement, because the offense arises in the construction of a machine, manufacturer or composition of matter or in the execution of a process, all almost always involving non-expressive conduct.<sup>319</sup> In stark comparison, the reiteration of a design is inherently expressive. Even when design patent infringement is accomplished most immediately through conduct, such as the sale or import of infringing goods, there is a First Amendment dimension to the problem, as when copyrights were allegedly infringed in the recent Supreme Court case concerning the re-sale and import of textbooks.<sup>320</sup> The underlying content is expressive nonetheless, and the sale or import perpetuates the expression.

There is nothing structural about design patents that makes them incompatible with fair use; to the contrary, the similarity between copyrights and design patents makes fair use a good fit. Public interest is paramount in either case, because both copyrights and design patents are rooted in the IP Clause. The defendant in a simple case of unfair commercial competition, such as the subsequent user of an ornamental design for toilet tissue, would readily flunk the fair use test, if the defendant could assert expressive interest at all. Cases of artistic merit—say an architect designing a museum of technology borrowed the patented glass staircase of an Apple store<sup>321</sup>—could

318. See *FY 2013 USPTO Workload Tables, Table 4: Patent Pendency Statistics*, USPTO (2013), available at <http://www.uspto.gov/about/stratplan/ar/USPTOFY2013PAR.pdf#page=191> (showing that it currently takes 29.1 months on average for a utility patent application to be processed).

319. A clever law professor might construct a hypothetical that would pit the utility patent against free expression in its core sphere of influence. *Cf., e.g.*, Beckerman-Rodau, *supra* note 164, at 34–35 (observing limitation on offers of sale under utility patent, in relation to First Amendment commercial speech doctrine). Perhaps imagine, as a political statement about the impact of unregulated capitalism on climate change, a patented process that dramatically combusts the U.S. flag into a red, white, and blue chemical cloud that scrubs loose carbon from the air as it dissipates. We go only so far as to hypothesize that a First Amendment case against utility patent infringement might be articulated on the right extraordinary facts, regardless of whether the defense could survive intermediate scrutiny.

320. *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351, 1357 (2013).

321. U.S. Patent No. D478,999S (filed July 15, 2002).

be tested for purpose and character of use, nature of original, amount and substantiality of taking, and effect on the market for the original.<sup>322</sup> In fact, the protected design might be copyrighted simultaneously and subject to fair use analysis just the same. The fair use analysis complements “total concept” and “total feel” approaches already known in copyrights and design patents. As in copyrights, commercial gain from the subsequent use would push the design patent analysis toward infringement, and transformation in subsequent iteration would push the analysis away from infringement.

We are not the first commentators to observe the omission of a fair use defense from the analytical framework in patents or design patents. Brean in 2008 called for design patents “to gracefully step down,” arguing persuasively that copyright and trademark law are up to the job of design protection.<sup>323</sup> But recognizing the unlikelihood of design patent abolition, he posited a series of reforms, including the adoption of a fair use doctrine “to allow the public to use and build upon the works of others,” and “to benefit from better designs and more of them.”<sup>324</sup>

O’Rourke in 2000 assertively articulated the need for a fair use defense in patents generally, modeled after copyrights, to combat economic-market failure in the protection-innovation balance.<sup>325</sup> O’Rourke described copyright fair use itself—a sort of “limited royalty-free compulsory license,” in IP terms—as an effective mechanism to fine-tune economic efficiency in copyrights.<sup>326</sup> She described three situations in which fair use draws the proper balance. First, as in the famous case approving home-television video-recording,<sup>327</sup> fair use worked around the problem of high transaction costs for consumers who would otherwise need program-by-program permission to copy, while not compromising market incentives to create.<sup>328</sup> Second, fair use allows the positive externality of social commentary to outweigh protectionism when the commentary injects a valuable new intellectual product into the public marketplace without excessive taking

322. See 17 U.S.C. § 107 (2012) (copyright fair use provision).

323. Brean, *supra* note 240, at 381.

324. *Id.* at 380 (citing Janice M. Mueller, *The Evanescent Experimental Use Exemption from United States Patent Infringement Liability: Implications for University and Nonprofit Research and Development*, 56 BAYLOR L. REV. 917, 925–36, 976–77 (2004)).

325. Maureen A. O’Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177 (2000). We are indebted to Professor Ruth Okediji, University of Minnesota Law School, for pointing us to this article at the very start of our research process.

326. *Id.* at 1188.

327. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 420 (1984).

328. O’Rourke, *supra* note 325, at 1188–89.

from the inspiring original.<sup>329</sup> Third, fair use makes room for criticism or parody, products that bring value to the public marketplace of ideas, but which the original creator might be unwilling to license.<sup>330</sup>

O'Rourke posited that the fast pace of innovation in the technological age is undermining the public interest in the IP balance.<sup>331</sup> Though patents have adaptive mechanisms to correct the balance—namely, the reverse doctrine of equivalents, the doctrine of blocking patents, the experimental use exception, and the misuse doctrine—O'Rourke found these doctrines no longer up to the job.<sup>332</sup> She reasoned that both patents and copyrights are construed according to “a mixture of statutory provisions and common law principles,”<sup>333</sup> and that because the two bodies of law aim to balance the same economic priorities, courts have evolved and borrowed doctrine, one from the other, as needed to fine-tune the balance, such as in the development of respective “first sale” doctrines.<sup>334</sup> Moreover, Congress has acted to fine-tune the balance in the public interest in narrow contexts, such as in allowance for infringement in the federal drug approval process.<sup>335</sup> Accordingly, she proposed a multi-factor fair use test for patent law, adapted from copyrights.<sup>336</sup> O'Rourke pressed her argument even while acknowledging that “patented inventions are simply not imbued with the same First Amendment interests that copyrighted materials tends to be.”<sup>337</sup> But O'Rourke impliedly focused exclusively on utility patents. Her logic is amplified where design patents are concerned, because the historical interchangeability with copyrights is exaggerated, and free expression does tend to be implicated in infringement cases.

In 2011, Strandburg revitalized the call for a fair use defense to patent infringement.<sup>338</sup> Strandburg explained that while O'Rourke's article was remarkably prescient, the growth of patent trolling and advances in complex technology have exaggerated the need for reform even more than one might have anticipated.<sup>339</sup> Specifically, Strandburg described five developments in

329. *Id.* at 1189. *See e.g.*, Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 569 (1985).

330. O'Rourke, *supra* note 325, at 1189. *See, e.g.*, Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 592 (1994).

331. O'Rourke, *supra* note 325, at 1177.

332. *Id.* at 1192–96.

333. *Id.* at 1196.

334. *Id.*

335. *Id.* at 1197 (citing 35 U.S.C. § 271(e)(1)).

336. *Id.* at 1230–34.

337. *Id.* at 1198.

338. Katherine J. Strandburg, *Patent Fair Use 2.0*, 1 U.C. IRVINE L. REV. 265, 265 (2011).

339. *Id.* at 281.

the patent system: (1) increased recognition that open sourcing facilitates innovation, especially by technology users; (2) diminished protection for consumers under patent exhaustion doctrine and in the repair-reconstruction dichotomy; (3) mounting inadequacy of the notice-and-search system, especially in software and business methods; (4) increased occurrence of independent invention (partly a function of the inadequate notice-and-search system); and (5) growing prevalence of product customization by users, in tandem with a growing divide between the manufacture and design of products.<sup>340</sup> Ultimately Strandburg posited a fair use test tailored to redress shortcoming in the general patent system. Her factors included (1) the justifiability of the alleged infringer's failure to purchase a license, taking account of sub-factors including the social value of the allegedly infringing use; (2) whether the alleged infringer made "substantial improvements" and why blocking patent failed; (3) the ease of "alternative innovation" strategies relative to the incentive function of patent; and (4) whether the alleged infringer was "a knowing copyist, independent inventor, or something in between," relative to the efficacy of the notice-and-search process.<sup>341</sup> Like O'Rourke, Strandburg did not address design patent specifically, but her rationales serve just as well in design patent as in patent in general.

Most recently, Asay has posited a comprehensive theory of "hybridization" for copyright and patent, emphasizing application in technology.<sup>342</sup> He proposed breaking down the rigid dichotomy between the two and permitting interplay between their doctrines, injecting into patent analysis a regard for creative productivity, and injecting into copyright fair use concepts akin to obviousness and novelty.<sup>343</sup> In development contemporaneously with this article, Asay's work accords with our thesis in prioritizing creative productivity. But his approach is fundamentally incompatible with ours.

In formulating a model of hybridization, Asay recognized the implications for creative productivity specifically in design patent,<sup>344</sup> and he considered the influence of the First Amendment on other proposals to blend or borrow between copyright and patent.<sup>345</sup> Looking to the lack of fair use

340. *Id.* at 291-89.

341. *Id.* at 300-01. Strandburg pointed for example to 3D printing, which epitomizes user customization and "blur[s] the distinction . . . between designing and producing tangible goods." *Id.* at 288.

342. Clark D. Asay, *Intellectual Property Law Hybridization*, \_\_\_ U. COLO. L. REV. \_\_\_ (forthcoming), available on SSRN, <http://ssrn.com/abstract=2576021> (draft Mar. 10, 2015).

343. *Id.* at 4.

344. *Id.* at 12.

345. *Id.* at 19-20.

in patent as an example, Asay asserted that allowing dichotomous areas of IP protection to overlap creates the very problem of needing to pick and choose doctrine, while hybridization derives IP law at the start from a coherent body of values.<sup>346</sup> Asay furthermore doubted whether “the First Amendment [is] sufficient to jettison the dichotomy” between copyright and patent.<sup>347</sup> Seeing a host of scholarly theories littering the courts’ cutting-room floors, Asay concluded that a more fundamental reimagining of the relationship between copyright and patent is required to overcome judicial fealty to a misperceived constitutional foundation for dichotomy.<sup>348</sup>

We acknowledge Asay’s efforts to create a model for hybridization, but we maintain that the Constitution compels a copyright-patent dichotomy.<sup>349</sup> Anyway, we are skeptical that a wholesale reimagining will fare better than a modest proposal for borrowed doctrine, especially considering the commitment of the legal profession to existing silos of IP practice. Thus in a narrower vein, this article examines constitutional imperatives specially in design patent, arising from its peculiarly creative character. Asay’s commentary on the inseparability of creativity and invention<sup>350</sup> serves equally well in support of our fair use thesis. Accordingly, part II of this article exposed the fundamental constitutional defect in design patent. But failing the courts’ wholesale rejection of design patent, this part III means at minimum to shore up counsel to argue, and to “embolden[]”<sup>351</sup> courts to recognize, the essentiality of fair use.

In the following part, we hypothesize a case of design patent infringement and demonstrate the essentiality, appropriateness, and application of the fair use test.

#### *D. Design Patents and the Peace Pretzel*

A federal case in 2013, closed upon voluntary dismissal without a court opinion,<sup>352</sup> nicely demonstrates the need for a fair use defense in design patent law. Until the expiration of its 14-year term in April 2014, patent D423,184 protected this “pretzel,” which we call the Peace Pretzel.<sup>353</sup>

346. *See id.* at 12-13.

347. *Id.* at 20.

348. *Id.* at 32-33.

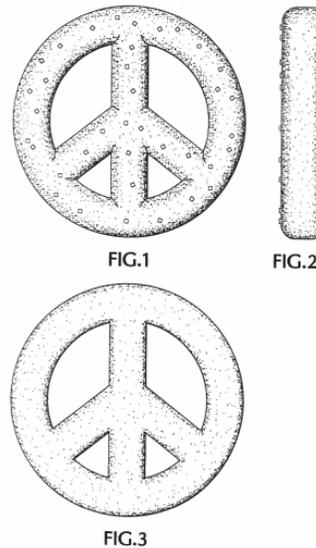
349. *Supra part II.A.*

350. *See Asay, supra note 342 at 23-28.*

351. *Id.* at 33.

352. Notice of Voluntary Dismissal, *Friend v. Keystone Pretzels*, No. 2:13-cv-01028 (W.D. Pa. filed Nov. 18, 2013).

353. U.S. Patent No. D423,184 (filed Apr. 15, 1999).



Plaintiff Leslie Friend of Pittsburgh, Pennsylvania, purchased the design patent in the last year of its validity from the sister of the inventor, Michael Lamont, who had passed away in 2007. Friend's attorneys told media that Friend planned to start a pretzel business.<sup>354</sup> She then discovered the design on offer from an online Massachusetts pretzel purveyor called Laurel Hill Foods. Laurel Hill sold pretzel *chips* in the shape of a peace sign in three flavors—"everything," sea salt, and honey multigrain<sup>355</sup>—which Laurel Hill bought from a Pennsylvania company, Keystone Pretzels. Friend

354. Rich Lord, *Patent of Pretzels Shaped Like Peace Signs at Center of Pittsburgh Federal Lawsuit*, PITTSBURGH POST-GAZETTE, (July 17, 2013, 7:30 PM), <http://www.post-gazette.com/business/legal/2013/07/17/Patent-of-pretzels-shaped-like-peace-signs-at-center-of-Pittsburgh-federal-lawsuit/stories/201307170201>. The inventor was Michael Lamont, founder and owner of a popular art-house cinema, The Bijou Theatre, in Eugene, Oregon, from 1980 until his death in 2007. U.S. Patent No. D423,184 (filed Apr. 15, 1999); *Theater of the Week: Bijou Art Cinemas*, AMIA FILM ADVOCACY TASK FORCE (May 15, 2013), <http://www.filmadvocacy.org/2013/05/15/theater-of-the-week-bijou-art-cinemas/>; T. Davis, *Leaving His (Land)Mark*, DAILY EMERALD ARCHIVES (Jan. 7, 2008, 12:00 AM), <http://dailyemerald.com/2008/01/07/leaving-his-landmark/>. Friend bought the patent from Lamont's sister. UNITED STATES PATENT AND TRADEMARK OFFICE, Patent Reassignment 25039-507 (2010), available at, <http://assignments.uspto.gov/assignments/q?db=pat&pat=D423184>; P.G. Rant, *The Rant: Research Paper on The Bijou Theatre in Eugene, OR*, ITEMS OF VARIOUS IMPORTANCE (Jan. 25, 2011, 8:37 PM) <http://itemsofvariousimportance.blogspot.com/2011/01/research-paper-on-bijou-theatre-in.html>. We could find no accounting of why Lamont applied for the Peace Pretzel patent in 1999, nor whether he ever made them. A biographer noted that Lamont was "a hardcore Republican" who "supported Bush Senior's Gulf War decision." *Id.*

355. Hungry yet? See Laurel Hill, *Pretzel Chips*, <http://laurelhillfoods.com/pretzel-chips/> (last visited Sept. 10, 2015).

sued Laurel Hill and Keystone, seeking royalties or profits, damages, attorney's fees, and an injunction.<sup>356</sup>

A symbol such as the peace sign can qualify for copyright insofar as the symbol constitutes a “pictorial, graphic, [or] sculptural work[.]”<sup>357</sup> For example, the court recognized the copyrightability of a stylized letter omega in a globe, a graphic work of no more complexity than the peace sign, in the 2008 Ninth Circuit case, *Omega S.A. v. Costco Wholesale Corp.*<sup>358</sup> Even though the peace sign has long existed, a particular representation of it could still be copyrighted. For instance, Peace Frogs, Inc., claims copyrights in “various designs and derivative works of combinations of frogs and peace word, signs and symbols.”<sup>359</sup> Similarly, one could imagine a company selling Peace Pretzel T-shirts bearing copyrighted images.<sup>360</sup> Of course, the scope of copyright in such cases only reaches the expression not the idea,<sup>361</sup> so the copyright would afford no monopoly over the concept of twisting an actual, edible pretzel into a peace-sign shape.

But a design patent would ride to the rescue in the pretzel case. The “inventor” of the Peace Pretzel did not have to worry about the idea-expression dichotomy in copyright law; instead, after an apparently easy process to claim a design patent in the Peace Pretzel with little or no scrutiny for qualifying novelty, an enforceable monopoly for 14 years was created.<sup>362</sup>

The design patent affords the Peace Pretzel the best of both worlds. Inventor Lamont's prosecution of the design patent required more than a copyright registration, but not much more; the drawings were technical, but

356. Complaint at ¶¶ A–E, *Friend v. Keystone Pretzels*, No. 2:2013-cv-01028-DSC (W.D. Pa. filed July 17, 2013) (citing 35 U.S.C. §§ 284–85 as to damages and fees).

357. 17 U.S.C. § 102(a)(5) (2012). Conscientious objector Gerald Holtom conceived of the peace sign in 1958, drawing on the semaphore signs for the N in nuclear and the D in disarmament. KEN KOLSBUN WITH MICHAEL S. SWEENEY, *PEACE: THE BIOGRAPHY OF A SYMBOL* 33–35 (2008); Kathryn Westcott, *World's Best-known Protest Symbol Turns 50*, BBC NEWS (Mar. 20, 2008), [http://news.bbc.co.uk/2/hi/uk\\_news/magazine/7292252.stm](http://news.bbc.co.uk/2/hi/uk_news/magazine/7292252.stm). By doing so, he created a work of visual art that would qualify for copyright protection under current law. *See* 17 U.S.C. §§ 102(a)(5) & 101, para. 33 (2012).

358. *Omega S.A. v. Costco Wholesale Corp.*, 541 F.3d 982 (9th Cir. 2008), *aff'd by an equally divided court*, 562 U.S. 40 (2010), *abrogated on different grounds by* *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351 (2013).

359. Complaint at ¶¶ 6, 25–30, *Peace Frogs, Inc. v. K-Mart Corp.*, No. 4:14 cv 22, 2014 WL 938739, at \*1, 3 (E.D. Va. filed Feb. 26, 2014). *See, e.g.*, PEACE FROGS, *Adult Celtic Truth Organic Short Sleeve T-Shirt*, <http://www.peacefrogs.com/product/1391/22> (last visited Sept. 10, 2015).

360. *Cf.* AUNTIE ANNE'S PRETZEL PERFECT, Registration No. 3,327,212 (showing a pretzel trademark registration—the source of our hypothetical t-shirts). The pretzel has been a symbol since it was adopted by the baker's guild in 12th-century Europe. *E.g.*, NADIA HASSANI, *SPOONFULS OF GERMANY: CULINARY DELIGHTS OF THE GERMAN REGIONS IN 170 RECIPES* 220 (2004).

361. *See* 17 U.S.C. § 102(b) (2012).

362. *See* 35 U.S.C. § 173 (2012).

straightforward. Lamont never had to bake or sell a Peace Pretzel, only to think of it. USPTO scrutiny for novelty was negligible, forestalling any validity challenge until a dispute might arise. The Peace Pretzel was then reserved from the marketplace of ideas for 14 years. Lamont and the subsequent owners of the patent, his sister and purchaser Friend, were entitled to exclude others from the design. The patent protection was not limited to combating commercial confusion, nor to the contents of particular artistic expressions; rather, more broadly, the patent precluded the making, using, or selling of a pretzel in the shape of peace sign.<sup>363</sup>

Commentators on the *Friend* lawsuit suggested that Laurel Hill pretzel chips were not deep enough, in dimension, to run afoul of the Peace Pretzel design patent, in which figure 2 suggests a depth of dough equivalent to the width depicted in figure 1.<sup>364</sup> We disagree. Employing design patent infringement analysis, the minimal novelty requirement would be satisfied by the peace-sign shape of the pretzel dough, which is what differentiates the product from the traditional pretzel knot.<sup>365</sup> That very novelty is the defining characteristic of Laurel Hill pretzel chips. The ordinary observer very well might purchase the one, supposing it to be the other.<sup>366</sup> So Friend had a strong lawsuit on her hands, even while she never got her pretzel business off the ground, and the impetus for Lamont's initial conception in 1999 was all but forgotten. Neither news reports nor the case record explain why Friend voluntarily dismissed with prejudice just four months after filing, but it is reasonable to speculate that a settlement was reached.

#### *E. Design Fair Use, Pretzels for Peace, and Oily-Pelican Art*

The Peace Pretzel problem can be used to demonstrate the essentiality, appropriateness, and potential application of a fair use test in design patent. We will examine its implications, varying some of the facts, and introduce another hypothetical case that articulates the problem with even greater urgency.

Friend's case to profit from the Peace Pretzel design is arguable as a matter of good public policy. On the one hand, she might be characterized as a patent troll or at least someone seeking to exploit the ridiculous ease with

363. *See id.* § 154(a)(1).

364. *E.g., Design Patents and the Pretzel Patent Troll*, IP NAV, <http://www.ipnav.com/blog/design-patents-and-the-pretzel-patent-troll/> (last visited Sept. 10, 2015).

365. *See Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 63 (1923) (discussing the need and effect of comparing the patent claims against the prior art); AUNTIE ANNE'S PRETZEL PERFECT, Registration No. 3,327,212.

366. *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871). *See supra* Section II.A.4.

which one can obtain a design patent on the mundane. On the other hand, Friend was the rightful purchaser and owner of Lamont's patent and might well have been on the verge of starting a unique business. The pretzel in its traditional knot has been around more than 1,000 years, and as far as we know, no one until Lamont in 1999 thought to combine it with a symbol for disarmament advocacy.<sup>367</sup> That is progress of some kind within the meaning of the IP clause. Win or lose, Friend's time-limited monopoly came to an end in 2014, remitting the asset of the Peace Pretzel to the public mind, potentially giving us something that we did not have previously.

The missing piece in the *Friend* lawsuit, and the unresolved problem presented by design patents, is fair use. In contrast with copyrights, design patents lack the structural safeguard of the idea-expression dichotomy and are not limited in scope to fixed expressions. Most importantly, design patents, at least as presently understood, lack copyrights' constitutionally critical accommodation of the First Amendment: the fair use doctrine. At minimum, the generic intermediate scrutiny of the First Amendment, for content-neutral government regulations that incidentally affect speech, must come into play when the violation of a design patent is expressive in nature.

Insofar as Friend was a sympathetic plaintiff, Laurel Hill and Keystone were profiting off the ingenuity of another and may have been expected fairly to pay up. But change the defendant to a non-commercial user, and the case takes on a different cast. Imagine a city rally for Ukrainian-Russian peace at which a sponsoring ethnic bakery makes and gives away peace-sign-shaped pretzels.<sup>368</sup> Or suppose that a German-American citizens group decides to counter community angst over immigration by uniting local persons of different backgrounds in Oktoberfest beer gardens to dialog over homemade peace-sign-shaped pretzels.<sup>369</sup> Peace-sign-shaped cookies, adorned or not

367. Pretzel origins might actually fall closer to pacifism than to the Oktoberfest beer garden, as one theory posits that the traditional pretzel knot represented the folded arms of the pious monastic baker. E.g., *Brezel (Laugenbrezel)*, BADISCHE KÜCHEN-KUNDE, <http://www.bad-bad.de/restaur/kuechenkunde/brezel.htm> (last visited Sept. 10, 2015).

368. Cf. *Consumer and Market Insights: Savory Snacks Market in Ukraine*, REPORT BUYER, <https://www.reportbuyer.com/product/2796575/consumer-and-market-insights-savory-snacks-market-in-ukraine.html> (last visited Sept. 11, 2015) (listing monthly report of Canadean Ltd. On market in Ukraine for savory snacks, including pretzels; analyzing market responses to political instability).

369. Laurel Hill's pretzel chips were featured on the website of the PeaceMeal Project, <http://peacemealproject.com/2012/05/11/pretzels-for-peace/>, which seeks "to explore the connections between peace and food." PEACEMEAL PROJECT, <http://peacemealproject.com/about/> (last visited Sept. 10, 2015).

with sugar crystals,<sup>370</sup> or other edibles,<sup>371</sup> also might run afoul of the design patent, as the controlling diagrams say nothing about the edible ingredients.

Farther afield, suppose shaped pretzels become *objets d'art*. A latter-day Andy Warhol<sup>372</sup> or redirected Thomas Forsyth<sup>373</sup> might create a range of artwork meant to comment on the inequality of food distribution around the world, even employing bread dough as ironic medium.<sup>374</sup> The Peace Pretzel might be just one entry in a series of works, perhaps alongside a doughy stalk of wheat,<sup>375</sup> a floury planet earth,<sup>376</sup> and a bready bas-relief of scythe-wielding farm workers.<sup>377</sup>

We can complicate the case further if we trade out the peace sign for a more controversial symbol. To choose a plaintiff that engenders less sympathy, suppose that the multinational oil and gas company BP<sup>378</sup> obtained a design patent on a distinctive container for motor oil—let us borrow the double-sphere bottle in which POM Wonderful sells fruit juice.<sup>379</sup> After the BP oil spill, a protestor and artist creates a sculpture depicting a blackened, oil-sodden pelican,<sup>380</sup> surrounded by upturned BP oil bottles, also blackened,

370. See, e.g., Lora Wiley, *Tie-Dyed Peace Sugar Cookies*, DIARY OF A MAD HAUSFRAU, (May 27, 2010, 11:18 AM), <http://www.diaryofamadhausfrau.com/2010/05/tie-dyed-peace-sugar-cookies-for.html>.

371. See, e.g., *Peace Sign Molded Sugar Decorations for Cakes, Cookies, and Cupcakes 24 Count*, ZIBBET, <http://www.zibbet.com/Bakingsuppliesgalore/artwork?artworkId=283067> (last visited Sept. 10, 2015). See also *Annie's Homegrown Organic Peace Pasta with Parmesan*, AMAZON, <http://www.amazon.com/Annies-Homegrown-Organic-Parmesan-6-Ounce/dp/B000CQ6LJQ> (last visited Sept. 10, 2015).

372. See THE WARHOL, <http://www.warhol.org/> (last visited Sept. 10, 2015) (describing Warhol's life and art).

373. See *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 796 (9th Cir. 2003) (describing artist who positioned nude Barbie dolls "in various absurd and often sexualized positions").

374. See *You Art What You Eat*, MASSMOCA, [http://www.massmoca.org/event\\_details.php?id=508](http://www.massmoca.org/event_details.php?id=508) (last visited Sept. 10, 2015) (describing an art exhibit of works made out of or commenting on food).

375. See, e.g., *Artisan Bread in Five, How to Form the Pain d'Epi (Wheat Stalk Bread)*, BREADIN5, <http://www.artisanbreadinfive.com/2008/02/22/how-to-form-the-pan-depi-wheat-stalk-bread> (last visited Sept. 10, 2015).

376. See, e.g., Edible Books Contest: Atlas Shrugged, MY SECRET LIFE IN THE KITCHEN, <http://mysecretlifeinthekitchen.wordpress.com/2013/04/25/edible-books-contest-atlas-shrugged/> (last visited Sept. 10, 2015).

377. Cf. Peter Singer, *A Statue for Stalin?*, PRAGUE POST, <http://www.praguepost.com/viewpoint/34357-a-statue-for-stalin> (last visited Sept. 10, 2015).

378. We will here vilify BP, because our story requires a villain. We are not, however, trying to make a political statement or take sides on the Gulf Coast tragedy. *But see* Clifford Krauss & Campbell Robertson, *BP Negligent in 2010 Oil Spill, U.S. Judge Rules*, N.Y. TIMES, Sept. 4, 2014, [http://www.nytimes.com/2014/09/05/business/bp-negligent-in-2010-oil-spill-us-judge-rules.html?\\_r=0](http://www.nytimes.com/2014/09/05/business/bp-negligent-in-2010-oil-spill-us-judge-rules.html?_r=0) (reporting that a district court judge had found BP "grossly negligent" in the 2010 Gulf Coast oil spill).

379. See U.S. Patent No. D510,525S (filed Dec. 2, 2004); U.S. Patent No. D476,899S (filed Mar. 13, 2002).

380. Cf. Don Gialanella, *Oil Spill Duck Sculpture*, LIVESTEEL, <http://livesteel.deviantart.com/art/Oil-Spill-Duck-Sculpture-172960767>, (last visited Sept. 10, 2015)

but recognizable by their shape. The artist might re-create (*make*) the bottles, or *use* discarded bottles. The artist might auction off (*sell*) the sculpture and donate the proceeds to an environmental advocacy group.



Critical training is hardly required to perceive the artist's message favoring environmental protection, or inversely, blaming BP for environmental degradation. But the work plainly runs afoul of the design patents, as the artist has made or used, and sold, the patented bottles. Novelty is not in question; indeed, the artist was counting on the novelty of the bottle design to make her point clear. The ordinary observer properly perceives the BP bottles; indeed, the artist might be *using* BP bottles, which our auction winner buys because they are what they appear to be. In remedy, BP may stand little to gain in profit disgorgement, but our artist will be liable for damages at least at the royalty rate<sup>381</sup> and no less than \$250.00.<sup>382</sup> Further, the artist might be enjoined from creating more sculptures along the same, bottle-laden theme.<sup>383</sup> Most significantly, the artist would face the high cost of patent defense in attorney's fees and other costs and might even be called upon to pay BP's fees.<sup>384</sup>

Neither our protest-pretzel organizers nor our oily-pelican artist would be liable for copyright infringement. Assuming *arguendo* that the Peace

(picturing work of artist who "scoops up blobs of oil" from the Louisiana shoreline to provide his medium).

381. See 35 U.S.C. § 284 (2012).

382. See *id.* § 289.

383. See *id.* § 283.

384. See *id.* § 285.

Pretzel<sup>385</sup> and the hypothetical BP oil bottle<sup>386</sup> would be eligible for copyright, the fair use doctrine would almost certainly preclude liability.<sup>387</sup> The political-advocacy, not-for-profit purpose of the defendants tilts the first factor of fair use analysis heavily in their favor.<sup>388</sup> The second factor, nature of the copyrighted work,<sup>389</sup> arguably disfavors the plaintiffs on the pretzel analysis, because very little originality supplements the public-domain symbol. Like in *Campbell*, the nature factor in the oily-pelican case is “not much help” when the taking is literal and deliberate for the purpose of straight or parodic commentary.<sup>390</sup> On the third factor, amount and substantiality is total on the pretzel case, so arguably favors the plaintiff, but the very slight originality again mitigates the importance of the factor.<sup>391</sup> In the oil can case, the amount and substantiality also are total, but the bottle shape is essential to accomplish the critical purpose.<sup>392</sup> Anything short of the double-bulb design would not “conjure up” the original in the mind of the viewer; an oil-laden pelican sends a message of environmental protection against resource exploitation in general, but does not plainly indict BP as a blameworthy actor. Finally, on the important fourth factor of market appropriation, the pretzel events are not impinging on a market in the

385. Inventor Lamont’s patent application might suffice; to qualify for copyright, the Peace Pretzel would have to be fixed in a tangible medium of expression. An image may be infringed by a three-dimensional representation, as a cartoon character embodied in a doll, just as a portrait may infringe copyright in a three-dimensional character portrayed by a person. But it is not clear whether the patent diagram sufficiently resembles the real thing for copyright purposes, even assuming it introduces enough originality to differentiate it from the public-domain peace sign. The copyrightability of patent diagrams is an interesting tangent, though fair use usually obviates the problem by robustly protecting the reproduction of public records. *See, e.g.,* Rich Stim, *Copyright for Patent Drawings?*, DEAR RICH: NOLO’S INTELLECTUAL PROPERTY BLOG (Apr. 10, 2015, 9:37 AM), <http://dearrichblog.blogspot.com/2009/03/copyright-for-patent-drawings.html> (citing *Rozenblat v. Sandia Corp.*, 79 Fed. App’x. 904 (7th Cir. 2003) (recognizing copyright but finding no infringement for want of substantial similarity)).

386. *See* Lisa Pearson, Andrew Pequignot, & Ashford Tucker, *U.S. Copyright Protection for Logos, Packaging and Products*, INTELLECTUAL PROPERTY MAGAZINE, Oct. 2010, at 37, 38–40. For infringement analysis, the double-bulb feature is here assumed to be an ornamental feature conceptually separable from the bottle’s function as an oil container.

387. The pretzel defendants may defend also with the doctrine of independent creation if they were unaware of the predecessor expression of a Peace Pretzel.

388. *See* 17 U.S.C. § 107(1) (2012); *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 561–63 (1985); *Time Inc. v. Bernard Geis Associates*, 293 F. Supp. 130 (S.D.N.Y. 1968) (finding publication of images taken from a copyrighted film of the John F. Kennedy assassination was fair use because of its political importance).

389. *See* 17 U.S.C. § 107(2) (2012); *Harper & Row Publishers, Inc.*, 471 U.S. at 563–64 (discussing the effect of a copyright in a factual work on fair use analysis).

390. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994).

391. *See* 17 U.S.C. § 107(3) (2012).

392. *Campbell*, 510 U.S. at 588–89 (recognizing that the parodist must copy a significant portion of the original for the parody to be successful).

absence of a developed product.<sup>393</sup> One can force the copyright question by hypothesizing additional facts: the propagation of a successful Peace Pretzel business with product sales knowingly bypassed by giveaways. The case then fairly becomes a closer question, analogous to the satiric portrayal of a politician as a Disney villain.<sup>394</sup> In the oil-bottle case, like in *Campbell*, the auction buyer does not buy the sculpture as a substitute for BP oil bottles.

Design patents, on the other hand, bear an obvious flaw. Without the structural safeguards and fair use defense that shape copyrights to accommodate free speech, design patents exclude the activists and artists from political advocacy and social commentary. These functions lie at the heart of First Amendment protection, and for good reason. If design patents can be perverted to freeze out this speech, then the public policy goals of free speech<sup>395</sup> are not achieved. Human dignity is compromised by restraint on free expression. The marketplace of ideas is hobbled in the attainment of truth. With opinion bottled up, self-governance is impaired, and the expressive safety valve is constricted, putting the society at risk of unhealthy volatility. Rather than perpetuating progress, the IP Clause through unconstrained design patents undermines the IP-free speech balance, flouting the public interest.

The First Amendment might be employed as a backstop, but the fumbling second prong of intermediate scrutiny invites the subjectivity and unpredictability of balancing, less than ideal to protect core political speech.<sup>396</sup> Intermediate scrutiny is inapt anyway when design patents reach beyond the scope of commercial speech and content-neutral regulation. No lesser scrutiny can suffice, because design patents, like copyrights, inherently reserve expression from the marketplace of ideas, and because design patents, unlike trademarks and consumer protection law, do not aim to combat falsity in the commercial marketplace.<sup>397</sup> At the same time, the

393. See 17 U.S.C. § 107(4); *Harper & Row Publishers, Inc.*, 471 U.S. at 566–68 (“Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.” (quoting 1 NIMMER ON COPYRIGHT 1.10[D], at 1–87 (1984))).

394. See Alan White, *13 Global Politicians as Disney Villains*, BUZZFEED (Apr. 10, 2015, 2:59 AM), <http://www.buzzfeed.com/alanwhite/13-world-politicians-imagined-as-disney-villains>.

395. See *supra* note 175.

396. See, e.g., *U.S. v. O’Brien*, 391 U.S. 367, 376–77 (1968); *Turner Broadcasting System, Inc. v. F.C.C.*, 520 U.S. 180, 213–14 (1997).

397. *Compare* *Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.2d 490, 493 (2d Cir. 1989) (noting that trademark protection addresses consumer deception) *with* *Krueger Intern., Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 604 (S.D.N.Y. 1996) (“The purpose of patent law is to encourage innovation by excluding competition (i.e., copying) for a limited period of time.”), *overruled on other grounds by*, *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373 (2d Cir. 1997).

legitimate demands of legal protection under the IP Clause make strict scrutiny an excessively burdensome response.

It is unnecessary to craft a new strict scrutiny test under the First Amendment because the copyright fair use doctrine provides a well-drawn test designed already to accommodate the balance between the IP Clause and the First Amendment. The deep similarity of copyrights and design patents, notwithstanding their semantic differences and historical divergence, further suggest the appropriateness of fair use to design patents with only slight adaptations that can be done as a matter of constitutional law, without modification to statutory patent law. The Supreme Court recognized that fair use in common law manifests a First Amendment imperative.<sup>398</sup> Patry emphasized that as a common law construct, even the “codification” of fair use doctrine should not be taken to stunt its exploration and development in the courts.<sup>399</sup>

The first factor of fair use, as derived from copyright, examines “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.”<sup>400</sup> This factor imports cleanly into design patents. Where copyrights in sculptural works look to the purpose and character of infringing reproduction, derivation, distribution, or public display,<sup>401</sup> the emphasis in patents must be on the purpose and character of making, using, offering, or selling.<sup>402</sup> The latter emphasis only sharpens the usually salient focus on commercialism. This factor cuts against *Laurel Hills* and *Keystone Pretzels*, but in favor of peace activists and artists. Though like in *Campbell*, the fact that an artist seeks to profit from his or her work does not necessarily convert the purpose and character of the use from noncommercial to commercial.<sup>403</sup> With the emphasis of patents on the exchange of invention for limited commercial monopoly, the controlling distinction arises between the character of use as an ornamental feature incidental to a utilitarian commercial product, and the character of use as an aesthetic feature of an artwork regardless of whether it is offered or sold in commerce.

398. See *Golan v. Holder*, 132 S. Ct. 873, 890 (2013) (“[T]he idea/expression dichotomy and the fair use defense . . . are recognized in our jurisprudence as built-in First Amendment accommodations.” (quotation marks and citations omitted)); *Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003).

399. 4 PATRY ON COPYRIGHT, *supra* note 158, § 10:8 (distinguishing “codification” from “statutory recognition”).

400. 17 U.S.C. § 107(1) (2012).

401. See *id.* § 106.

402. See 35 U.S.C. § 271 (2012).

403. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994).

The second factor of fair use considers the nature of the protected work.<sup>404</sup> In copyrights, nature reflects the investment of creativity (or originality) in the original work; the closer to mere sweat of the brow, the less creativity, the less protection. Fiction is preferred to nonfiction.<sup>405</sup> An annotated bibliography is entitled to less protection than an original novel; a news photograph of a public gathering is less protected than an abstract oil painting of an imaginary landscape.<sup>406</sup> Design patents' counterpart to creativity is novelty,<sup>407</sup> and the nature factor adapts well to consider the novelty of the protected work. Design patent infringement already demands focus on the novel ornamental features that distinguish the patented design from prior art.<sup>408</sup> The greater the novelty of the design, the greater is its scope of protection vis-à-vis a competing use.<sup>409</sup> The novelty of a pretzel in the shape of a peace sign introduces very little in addition to the prior art of shaped pretzels and peace signs apart, indicating that the scope of fair use will be broad. In contrast, if we pretend that BP rather than POM Wonderful was the exclusive adopter of the double-bulb bottle, the distinctiveness of the bottle, and accordingly its immediate recognition even in silhouette, favors the plaintiff. Though as the Court observed in *Campbell*, this factor bears less influence in cases of parody or "critical wit," because recognition is the very (permissible) point of the latter use.<sup>410</sup>

The third factor of fair use considers the amount and substantiality of the taken portion relative to the protected whole.<sup>411</sup> This quantum scale also lends itself to easy adoption in the context of design patents. Construction of the "whole" in design patents must be confined to the novel whole, like the original whole in copyrights, not the whole of the product of which the novel design is a feature.<sup>412</sup> In the pretzel cases, focusing on the novel "whole" of the pretzel-peace-sign union, the taking is thorough, tilting this factor to

404. 17 U.S.C. § 107(2) (2012).

405. See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 349 (1991).

406. See *id.* at 350 ("This Court has long recognized that the fact/expression dichotomy limits severely the scope of protection in fact-based works.").

407. See 35 U.S.C. §§ 101–02 (2012).

408. See *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871); *In re Nalbandian*, 661 F.2d 1214, 1215 (C.C.P.A. 1981).

409. Cf. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 63 (1923) ("In administering the patent law, the court first looks into the art, to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent. If what he has done works only a slight step forward . . . then his patent, if sustained, will be given a narrow scope . . .") (utility patent).

410. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 588 (1994).

411. 17 U.S.C. § 107(3) (2012).

412. See *Application of Flett*, 166 F.2d 822, 823–25 (C.C.P.A. 1948) (determining the "point of departure" to evaluate whether a new invention was claimed).

favor the plaintiff. Like in *Campbell*, when the satirist's or imitator's very objective is to remind the audience of the original, the defendant should be afforded latitude to "conjure up."<sup>413</sup> The oily-pelican artist might have no choice short of the whole bottle to ensure communication of her message.

The fourth and critical factor considers "the effect of the use upon the potential market for or value of the [protected] work."<sup>414</sup> This factor too nicely complements infringement analysis in design patents, which already considers whether the design's use might cause the ordinary observer to mistake the imitator for the original.<sup>415</sup> Thus in sync again with the commercial-monopoly function of patents and the lessened First Amendment urgency in commercial transactions, the patented design will enjoy greater protection when the allegedly infringing activity is closer to commercial competition, and less protection when the allegedly infringing activity is closer to noncommercial political or artistic expression. The Laurel Hill pretzel chips might well detract from the market value of Friend's potential business, and certainly would detract from a developed business, tilting this factor in the plaintiff's favor. Probably complimentary and symbolic Pretzels for Peace do not impinge on the market for commercial Peace Pretzels, favoring the defendants in those cases. Occasional Pretzels for Peace might even enhance the market for a regularly available commercial good. But that could change if home-making Pretzels for Peace becomes a widespread movement, or an advocacy organization begins production on a commercial scale. In the case of the oily-pelican artist, the competing use is no market substitute at all for the original. It is important in design patent analysis to recognize that the fourth factor focuses on the market for the whole product that the design adorns—not a market for the design itself—as the design is a means to a commercial end. The artist's sales of blackened bottles-turned-sculpture might dampen enthusiasm for BP products because viewers agree with the artist's political statement, like they might heed the cautions of a gripe site.<sup>416</sup> But the sales of sculpture do not function as a market substitute for bottled motor oil, just as purchasers do not buy 2 Live Crew rap instead of Roy Orbison rockabilly.<sup>417</sup>

In sum, the First Amendment and sound public policy require an affirmative defense to design patent infringement to maintain the IP Clause

413. *Campbell*, 510 U.S. at 588.

414. 17 U.S.C. § 107(4) (2012).

415. *See Gorham Mfg.*, 81 U.S. at 528.

416. *See, e.g., Savannah College of Art and Design, Inc. v. Houeix*, 369 F. Supp. 929 (S.D. Ohio 2004).

417. *See Campbell*, 510 U.S. at 591–92.

in balance with the freedom of expression. The striking doctrinal similarity between design patents and copyrights powerfully suggests that the fair use doctrine draws an appropriate balance. Copyright's flexible fair use test is readily adapted to the design patent context, requiring examination of (1) the purpose and character of the allegedly infringing making, using, offer, or sale, including its commercial purpose, or its educational, political, artistic, or other noncommercial purpose; (2) the nature of the patented design, focusing on its points of novel ornamentation; (3) the amount and substantiality of the portion of design used in relation to the patented design as a whole; and (4) the effect of the allegedly infringing making, use, offer, or sale upon the potential market for or value of the product or products that bear the patented design.

#### IV. CONCLUSION

Design patents represent an exercise of Congress's power that is not given in Article I. While Congress has the unchallengeable authority to grant a patent to an inventor who advances the useful arts, no such power is given for Congress to grant patents to artistic designs.

Even if Article I is interpreted broadly enough for Congress to create design patents, this must be done within the context of the limitations placed on congressional power by the First Amendment Speech Clause. The Patent Act fails to do this. This constitutional infirmity can be repaired using the same approach that was used to fit the Copyright Act within the constitutional framework—the judicial adoption of a fair use defense modeled on the one the courts created for copyright law.