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Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright Protection for Designs

Sarah Burstein*

There is ongoing and long-standing debate about whether the United States should provide more intellectual property protection for designs and, if so, what form that protection should take.[1] A number of prior commentators have argued that the United States should protect designs using copyright or a copyright-like *sui generis* regime.[2] These commentators often base their arguments, at least in part, on the assertion that copyright protection is narrower than design patent protection.[3] Although commentators sometimes point to various copyright doctrines in support of this assertion,[4] the basic premise—*i.e.*, that a "right to prevent copying"[5] of designs would be narrower than design patent protection—seems to be generally accepted as a truism.

This Essay questions that premise. Even if, as a general matter, a patent provides "a stronger monopolistic right"[6] for its prototypical subject matter than a copyright provides for its prototypical subject matter, that does not necessarily mean that the same is true when each regime is applied to designs.[7]

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1. As used in this Essay, "design" refers to a design for the configuration of all or part of anything that qualifies as a "useful article" under the U.S. Copyright Act. *See* 17 U.S.C. § 101.
2. *E.g.*, Susanna Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 Tex. Intell. Prop. L.J. 495, 543 (2012) (arguing that Congress should amend the Vessel Hull Design Protection Act, which provides copyright-like *sui generis* protection, to protect "all industrial design").
3. *E.g.*, Steve W. Ackerman, Note, *Protection of the Design of Useful Articles: Current Inadequacies and Proposed Solutions*, 11 Hofstra L. Rev. 1043, 1049 (1983) ("The extent of design patent protection . . . greatly surpasses that of copyright protection.") (citing Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951)).
4. *See* Section II, *infra*.
5. *See* William T. Fryer, III, *Design Patent System for the Twenty-First Century*, 24 AIPLA Q.J. 331, 355 (1996). As conceptualized in this Essay, a "right to prevent copying" would not be subject to a separability requirement. *See generally* note 37, *infra*.
6. *See* Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 Cardozo Arts & Ent. L.J. 1105, 1134 (2008).
7. *Cf.* Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 Tex. L. Rev. 989, 1029 (1997) (noting that "[c]opyright is traditionally thought to afford weaker . . . protection than patent law" but arguing that "in the context of improvements, the opposite result obtains").

This Essay briefly reviews the relevant portions of U.S. design patent and copyright law and the limiting copyright doctrines discussed by prior commentators. Based on this preliminary analysis, this Essay concludes that a right to prevent copying designs could be just as broad as—if not broader than—design patent protection. If this is true, then many of the arguments made in support of adopting a copyright-like regime to protect designs need to be reexamined.[8]

I. Brief Background on The Relevant Law

In the United States, design patents are available for "any new, original and ornamental design for an article of manufacture."[9] Design patents, like other patents, are only granted after substantive examination by the United States Patent and Trademark Office ("PTO").[10] Once a design patent is granted, the owner has the right to exclude others from making, using, offering to sell, selling or importing objects embodying the design.[11]

By contrast, U.S. copyright law grants authors six discrete rights, including the right "to reproduce the copyrighted work in copies" and "to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending."[12] These rights arise upon fixation; no *ex ante* substantive examination is required.[13]

Most designs qualify as "useful articles"[14] under the Copyright Act and, thus, are protected "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."[15] Therefore, designs are largely excluded from copyright protection in the United States.

II. Copyright Is Not (Necessarily) Narrower For Designs

In support of the assertion that copyright is narrower than design patent protection, previous commentators have pointed to three aspects of copyright law: (1) the idea-expression dichotomy; (2) the requirement of copying; and (3) the doctrine of fair use. However, even a brief examination of these principles indicates that none of them would necessarily make the

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8. *See* Section III, *infra*.
9. 35 U.S.C. § 171.
10. *See id*. § 131. In practice, however, the PTO appears to apply little, if any, substantive scrutiny to design patent applications. *See* Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* 7 (U. Mo. Sch. of L. Legal Studies Research Paper No. 2010-17), available at http://ssrn.com/abstract=1656590 (arguing "that the current design patent examination system operates as a *de facto* registration system").
11. *See* 35 U.S.C. § 271(a).
12. 17 U.S.C. §§ 106(1), (3).
13. *Id*. § 102(a).
14. *See id*. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article'.")
15. *See id*. (defining "[p]ictorial, graphic, and sculptural works").

scope of copyright (or a copyright-like right to prevent copying) narrower than design patent protection.

A. Idea-Expression Dichotomy

Commentators have pointed to the idea-expression dichotomy in support of the assertion that copyright protection is narrower than design patent protection.[16] "The idea/expression dichotomy is codified at 17 U.S.C. § 102(b): 'In no case does copyright protec[t] . . . any idea, procedure, process, system, method of operation, concept, principle, or discovery . . . described, explained, illustrated, or embodied in [the copyrighted] work.'"[17]

Finding the line between "idea" and "expression" is difficult in any case. Judge Learned Hand famously observed that, "[o]bviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be *ad hoc*."[18] As at least one prior commentator has noted, however, the problem is particularly difficult in the context of industrial design.[19]

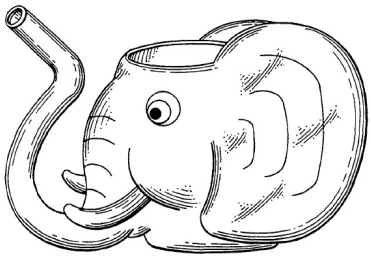
The difficulty is apparent in the context of nonrepresentational designs.[20] Consider, for example, Philippe Starck's *Juicy Salif*:[21]

16. *See, e.g.*, Jacques M. Dulin, Note, *Statutory Design-Rights: Solution to the Unfair Competition of Piracy*, 34 Geo. Wash. L. Rev. 110, 122 (1966) ("[U]nlike a design patent, a [copyright-like] design-right gives no exclusive right to the style idea disclosed; protection is given only to the expression of the style, not the style idea itself.").
17. Golan v. Holder, 132 S. Ct. 873, 890 (2012) (alterations in original).
18. Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960)).
19. *See* Note, *Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following* Mazer v. Stein, 38 U. Chi. L. Rev. 807, 810–11 (1971).
20. *See generally* Paul Zelanski & Mary Pat Fisher, Design Principles and Problems 321 (2d ed. 1996) (defining "nonrepresentational art" as "[a]rt that does not depict real or natural things in any manner").
21. *PSJS – Juicy Salif, Citrus-squeezer – Alessi citrus-squeezer*, Alessi, http://www.alessi.com/en/2/110/kitchen-accessories/psjs-juicy-salif-citrus-squeezer (last visited Dec. 1, 2012).

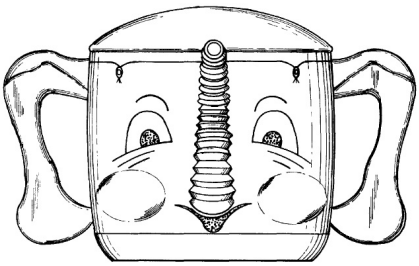
This is undoubtedly an innovative design for a citrus squeezer.[22] But it does not embody any objectively-discernable "idea" that would limit the scope of a right to prevent copying.

In the context of representational[23] designs, the idea-expression dichotomy could, theoretically, limit the scope of a right to prevent copying. For example, the idea-expression dichotomy would make it clear that the first person to create a cup for children in the shape of an elephant head could not monopolize that general concept.[24] However, the same would be true under design patent law.

Unlike utility patents, design patents are not claimed using verbal descriptions.[25] Instead, the inventor must claim a specific visual design using drawings or photographs.[26] For example, here is an illustration from an actual design patent:[27]



This design patent has been cited in—and therefore, the PTO did not deem it to anticipate—other elephant-shaped cup design patents, including this one:[28]



22. *See id*. (calling the design "revolutionary").
23. *See generally* Zelanski & Fisher, *supra* note 20, at 321 (defining "representational" as "[d]escriptive of art that depicts objects from the world of our experience").
24. *Cf*. Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 741–42 (1971) (discussing the difference between "idea" and "expression" in a case involving a jeweled pin shaped like a bee).
25. *Compare*, *e.g*., U.S. Patent & Trademark Office, U.S. Dep't of Commerce, Manual of Patent Examining Procedure § 706.03(d), Form ¶ 7.34.15 (8th ed., rev. 9, Aug. 2012) (hereinafter "MPEP"), *with id*. § 1503.02.
26. *Id*. § 1503.02.
27. U.S. Patent No. Des. 351,530 at Fig. 1 (filed Jan. 8, 1993).
28. U.S. Patent No. Des. 427,855 at Fig. 1 (filed Jul. 29, 1999).

The basic "idea" of both designs is the same. Each patent claims a design for a child's cup shaped like an abstracted[29] elephant's head, with a straw shaped like a trunk and handles shaped like ears. But both designs have been deemed patentable. And rightly so—no ordinary observer would think these cups have "substantially the same" design.[30] So even in the context of representational designs, it is not clear that the idea-expression dichotomy would actually make a right to prevent copying any narrower than design patent protection.[31]

B. Requirement of Copying

Commentators have also pointed to copyright's requirement of copying in support of the assertion that copyright protection is narrower than design patent protection. For example, Professor Susanna Monseau has argued that "the protection [provided by copyright] is more limited than the monopoly provided by patent" because it "can only be used to prohibit imitators and not independent creators."[32] This raises at least two issues relevant to the instant discussion—the copyright owner's burden of proof and the independent creation defense.

1. Burden of Proof

Prior commentators have noted that, unlike patent law, copyright law requires proof of copying.[33] In copyright cases, the word "'[c]opying' is regularly used as a shorthand to refer to the infringement of a copyright holder's exclusive rights."[34]

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29. *See generally* Zelanski & Fisher, *supra* note 20, at 319 (defining "abstract art" as "[a]n art form in which subjects are simplified, with emphasis on design rather than realism") (emphasis omitted).
30. *See* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (explaining that a design patent is infringed if, "in the eye of an ordinary observer . . . 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" (quoting Gorham Co. v. White, 81 U.S. 511, 528 (1871)); *see also* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1244 (Fed. Cir. 2009) (explaining that the ordinary observer test is used for anticipation as well as for infringement).
31. Additionally, Professor Rebecca Tushnet has argued that "[a]pplication of the idea/expression dichotomy to images fails because styles are neither true nor false, neither fact nor expression." Rebecca Tushnet, *Worth A Thousand Words: The Images of Copyright*, 125 Harv. L. Rev. 683, 724 (2012). Although Professor Tushnet was focusing on two-dimensional images, her argument could be applied with equal force to three-dimensional designs.
32. *E.g.*, Monseau, *supra* note 2, at 515.
33. *See, e.g.*, Daniel H. Brean, *Enough Is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 Tex. Intell. Prop. L.J. 325, 366 (2008) ("[W]hile a design patent would prevent any making or use of the patented design, copyright only protects against copying.").
34. Country Kids 'N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1284 n.2 (10th Cir. 1996) (citing Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 832 n.6 (10th Cir. 1993)).

As discussed above, U.S. copyright law grants authors six different exclusive rights, including the right to create derivative works and the right to display a work publicly.[35] However, it has long been realized that it would be neither necessary nor wise to grant all of these rights to designs.[36] Accordingly, some proponents of using copyright to protect designs argue that designs should be given only a right to prevent copying, akin to the reproduction right granted by 17 U.S.C. § 106(1).[37]

In order to prove infringement of the § 106(1) reproduction right, a plaintiff must prove, *inter alia*, that the defendant copied the plaintiff's work.[38] As the Seventh Circuit recently explained:

> Where direct evidence, such as an admission of copying, is not available (as is typically the case a plaintiff may prove copying by showing that the defendant had the opportunity to copy the original (often called "access") and that the two works are "substantially similar," thus permitting an inference that the defendant actually did copy the original.[39]

Thus, in most cases, "copying" is proven through circumstantial evidence of access and substantial similarity.[40]

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35. *See* 17 U.S.C. § 106.
36. *E.g.*, J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. Balt. L. Rev. 6, 144 (1989) (arguing that designs should not "obtain all the benefits of the mature copyright paradigm").
37. *See, e.g.*, Barbara A. Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 Bull. Copyright Soc'y U.S.A. 25, 30–32, (1959) (arguing in favor of a bill that would have given design owners, essentially, a right to prevent unauthorized reproduction of their designs). Such proposals seem to contemplate the elimination of the separability requirement. *See generally id.* at 30 (identifying the separability requirement as one feature of copyright law that rendered it "inappropriate" for designs); Section I, *supra*. Therefore, this Essay will assume that this proposed "right to prevent copying" would not be limited to features that could be physically or conceptually separated from a design's utilitarian aspects.
38. *See* Robert Brauneis & Roger E. Schechter, Copyright: A Contemporary Approach 214 (2012).
39. Peters v. West, 692 F.3d 629, 633 (7th Cir. 2012) (internal citation omitted). Some of the circuits use different formulations of this test but the broad principles are largely the same. *See id.*; *see also* Brauneis & Schechter, *supra* note 38, at 214–15 (discussing the basic requirements for proof of copying).
40. Of course, in a copyright-like *sui generis* regime, a different test could be devised for designs. For example, the latest fashion-protection bill provided that "a design shall not be deemed to have been copied from a protected design if that design . . . is not substantially identical in overall appearance to and as to the original elements of a protected design . . ." Innovative Design Protection Act of 2012 ("IDPA"), S. 3523, 112th Cong. § 2(f)(5) (2012). Notably, however, the IDPA's definition of "substantially identical" is reminiscent of the design patent test for infringement. *Compare id.* § 2(a) ("[T]he term 'substantially identical' means an article of apparel which is so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial."), *with* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (explaining that a design patent is infringed if, "in the eye of an ordinary observer . . . 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" (quoting Gorham Co. v. White, 81 U.S. 511, 528 (1871)), *and id.* (noting that "slight variances in configuration . . . will not destroy the substantial identity" (quoting *Gorham*, 81 U.S. at 527) (omission in original)).

In the context of designs, access should normally be easy to prove.[41] After all, successful designs—which would seem to be the most attractive targets for imitators—tend to be widely advertised and distributed.[42] So, in practice, "infringement in industrial design cases ordinarily would turn on evidence of substantial similarity."[43]

As Professor Jeanne Fromer has explained, "[s]ubstantial similarity in copyright law has traditionally been measured by asking 'whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.'"[44] However, as Professors Mark Lemley and Mark McKenna have noted,

> [T]he meaning of "substantial" has broadened significantly over time. Whereas the defendant's work once would have needed to be virtually identical to the plaintiff's in order to be considered an infringement, courts now find infringement based on fragmented literal similarity and nonliteral or pattern similarity . . . .[45]

Thus, under current law, "copyright protects not only the whole, but also all significant parts" of a work.[46]

Moreover, "[s]ome circuits follow an 'inverse ratio' rule, under which the strength of proof of similarity varies inversely with the proof of access (*i.e.*, strong proof of access allows for only weak proof of similarity, and vice versa)."[47] In these circuits, a design owner's burden of proof would be especially low, particularly in cases involving commercially-successful, mass-produced designs.

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41. Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. Ill. L. Rev. 887, 912 (1988).
42. *See id*. at 912 n.134 ("Most industrial designs of commercial value are widely distributed in the marketplace. Absent special circumstances, proof of wide distribution ordinarily allows the fact finder to infer access.") (citing Selle v. Gibb, 741 F.2d 896, 901 (7th Cir. 1984); Abkco Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988, 998 (2d Cir. 1983)).
43. *Id*. at 912.
44. Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. Chi. L. Rev. 719, 746 (2009) (quoting Warner Bros. Inc. v. Am. Broad. Cos., 654 F.2d 204, 208 (2d Cir. 1981)). Although a full discussion of this issue is beyond the scope of this Essay, there are reasons to believe that the copyright "substantial similarity" test is particularly ill-suited for designs. *See, e.g.*, Note, *Protection for the Artistic Aspects of Articles*, 72 Harv. L. Rev. 1520, 1532 (1959) (observing that non-literal similarity may not be nearly as probative of copying "with respect to utilitarian designs than with respect to other subjects of copyright").
45. Mark A. Lemley & Mark P. McKenna, *Is Pepsi Really a Substitute for Coke? Market Definition in Antitrust and IP*, 100 Geo. L.J. 2055, 2105 (2012) (footnote omitted).
46. Dratler, *supra* note 41, at 912–13 (citing 3 M. Nimmer & D. Nimmer, Nimmer on Copyright § 13.03[A][1], [2] (1988)). Of course, it is possible for a designer to claim only portions of a product's design, instead of—or, in addition to—the overall design. *See* MPEP, *supra* note 25, § 1503.02(III) (stating that broken lines may be used to indicate unclaimed portions of a design). But partial claiming is not unique to patent or patent-like systems. *See, e.g.*, A Fulton Co Ltd v Totes Isotoner (UK) Ltd, [2003] EWCA (Civ) 1514, [2004] R.P.C. 16 (Eng.). And the fact remains that a design patent, unlike a copyright, does not provide protection for parts—significant or otherwise—of the claimed whole.
47. Peters v. West, 692 F.3d 629, 634 (7th Cir. 2012) (citing, *inter alia*, Three Boys Music Corp. v. Bolton, 212 F.3d 477, 485 (9th Cir. 2000)).

Under design patent law, by contrast, there is no requirement of copying; instead, the patent owner must prove that "in the eye of an ordinary observer, giving such attention as a purchaser usually gives, [the] two designs are substantially the same."[48] At first blush, this might sound like copyright "substantial similarity." But the two tests have been interpreted and applied very differently. In design patent law, there is no sliding scale based on access and no theory of fragmented literal similarity or non-literal similarity. And the scope of design patent protection is generally fairly narrow. Therefore, the range of designs that will be deemed "substantially the same" as a patented product design should be much smaller than the range of designs that would be deemed "substantially similar" under the copyright test.

In the recent *Apple v. Samsung* trial, for example, the jury found—consistent with current law—that Samsung's Galaxy Tab 10.1 did not infringe U.S. Patent No. Des. 504,889.[49] Apple claims that the iPad 2 is an embodiment of its patented design.[50] If Apple had a right to prevent others from copying the iPad2, the result would probably have been very different. The iPad 2 is an extraordinarily successful and highly-publicized product. So it would have been easy for Apple to prove that Samsung had access to the design.[51] And because the Ninth Circuit recognizes the inverse ratio rule,[52] Apple would have had an even lower burden on the issue of "substantial similarity." There is little doubt that Apple could have met that burden. After all, in real life, Apple managed to convince the district court that the Galaxy Tab 10.1 was "virtually indistinguishable from" the iPad 2.[53]

Additionally, as Professor Jay Dratler has observed, "copyright law is not intended to protect specific products at all, but to protect abstract expression . . . ."[54] Therefore, "the standard for copyright infringement is substantial similarity in the abstract, divorced from any relationship with particular products or the marketplace."[55] But "designs are product-specific. That is, each design is generally prepared for a single product and no other."[56] Indeed, in order to be patented, a design must be embodied in or applied to a specific

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48. Revision Military, Inc. v. Balboa Mfg. Co., 700 F.3d 524, 526 (Fed. Cir. 2012) (quoting Gorham Co. v. White, 81 U.S. 511, 528 (1871)). In some cases, the differences must be viewed in light of the prior art. *See id.* (citing Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 677 (Fed. Cir. 2008) (en banc)).
49. *See* Amended Verdict Form, Apple Inc. v. Samsung Elecs. Co., Ltd., No. 5:11-cv-1846, ECF No. 1931 at 7 (Aug. 24, 2012).
50. *See, e.g.*, Apple Inc. v. Samsung Elecs. Co., Ltd., No. 5:11-cv-1846, 2011 WL 7036077, at *4 (N.D. Cal. Dec. 2, 2011), *rev'd in part on other grounds*, 678 F.3d 1314 (Fed. Cir. 2012). This claim is quite dubious, but that issue is beyond the scope of this Essay.
51. *See generally* 3 William F. Patry, Patry on Copyright §§ 9:25–26 (2007) (discussing how a plaintiff can prove access by inference when a work is widely available).
52. *See, e.g.*, Benay v. Warner Bros. Entm't, Inc. 607 F.3d 620, 625 (9th Cir. 2010).
53. *Apple*, 2011 WL 7036077, at *28.
54. Dratler, *supra* note 41, at 914.
55. *Id.* at 915.
56. *Id.* at 914.

article of manufacture.[57] So, in this respect, a right to prevent copying could actually be significantly broader than design patent protection.[58]

2. Independent Creation

Independent creation is a complete defense to copyright infringement.[59] However:

> [S]ubconscious copies—liberally found to exist except under "circumstances when the possibility of the [alleged infringer] having access to the [copyrighted] work was increasingly remote"—are not considered to be independently created. Therefore, mere plausible access to copyrighted work combined with substantial similarity can add up to an inference of copying and thus infringement.[60]

Although the theory of subconscious copying has so far been largely confined to cases involving musical works,[61] it could easily be applied to designs. If a claimed design is shown, for example, in a widely-disseminated catalog, on a website, or at a major industry trade show, it would be easy to show that a defendant had "plausible access." If the claimed product is successful and widely publicized, the showing would be even easier. Thus, it is not clear that the independent creation defense would meaningfully narrow the scope of a right to prevent copying of designs.

C. Fair Use

At least one commentator, Daniel Brean, has argued that "design patents provide much stronger exclusive rights" than copyright because design patent law does not include a fair use defense.[62] The Copyright Act expressly provides that:

> [T]he fair use of a copyrighted work . . . is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

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57. *See* MPEP, *supra* note 25, § 1502 ("The design for an article consists of the visual characteristics *embodied in or applied to* an article. . . . Design is inseparable from the article to which it is applied . . . .") (emphasis added); *see also id*. § 1503.01 ("The title of the design must designate the *particular* article.") (quoting 37 C.F.R. § 1.153(a)) (emphasis added).
58. *Cf*. Dratler, *supra* note 41, at 914 (arguing that "[c]opyright principles . . . might provide overbroad protection" for designs in this respect).
59. *See* 2 PATRY, *supra* note 51, § 3:30.
60. Fromer, *supra* note 44, at 749 (footnotes omitted).
61. Tushnet, *supra* note 31, at 729 n.209.
62. *See* Brean, *supra* note 33, at 351.

> (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.[63]

Once again, it is difficult to see how this doctrine would actually make a right to prevent copying narrower than the current scope of design patent protection.[64] As Professor Dennis Karjala has explained:

> Most improvements of functional works will aim at commercial markets, which points away from fair use under factor one of the fair use analysis (purpose and character of the use), although an improvement might also be said to be a productive use, which points in the other direction under that factor. Improved products would likely be sold in competition with the copyright owner's product, however, thus flunking factor four . . . .[65]

Brean concedes that, in the context of competing product designs, the commercial nature and competition would tend to weigh against a finding of fair use.[66] He suggests, however, that fair use may still be able to play a significant role by allowing uses that are "transformative."[67]

In *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court stated that "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."[68] According to Professor Neil Netanel, in cases decided after *Campbell*, "different expressive purpose, not new expressive

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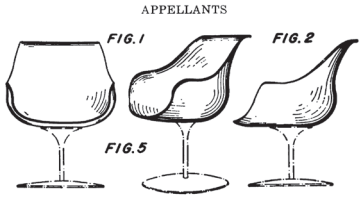
63. 17 U.S.C. § 107.
64. Professor Dennis Crouch has recently suggested that there might be a role for fair use in the context of design patents for graphic user interface ("GUI") icons. *See* Dennis Crouch, *Apple Patents an Encircled Musical Note*, Patently-O (Oct. 25, 2012, 1:34 a.m.), http://www.patentlyo.com/patent/2012/10/apple-patents-an-encircled-musical-note.html. But it is not clear that reproducing the image associated with a GUI icon on a website would actually constitute an actionable "use" of the invention. *See generally* MPEP, *supra* note 25, § 1502 ("The design for an article consists of the visual characteristics embodied in or applied to an article. . . . Design is inseparable from the article to which it is applied . . . ."). Additionally, although the PTO considers GUI elements to be patentable subject matter, the PTO's interpretation of the relevant statutory language is strained and unpersuasive. *See id* § 1504.01(a). A full discussion of these issues is, however, beyond the scope of this Essay.
65. Dennis S. Karjala, *Distinguishing Patent and Copyright Subject Matter*, 35 Conn. L. Rev. 439, 462 n.88 (2003); *see also id*. at 448 ("For these purposes, I have defined 'functional' to be distinct from merely 'useful' and have relied on the Copyright Act's definition of a 'useful article' as a starting point for focusing on the differences between patent and copyright subject matter . . . .") (footnote omitted).
66. Brean, *supra* note 33, at 350.
67. *Id*.
68. 510 U.S. 569, 579 (1994).

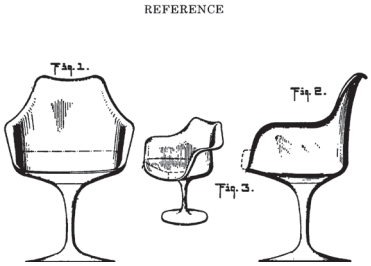
content, is almost always the key" to a finding of transformative use.[69] In the context of designs, it is difficult to see how the use of all (or even part) of a design on a competing product could qualify as "transformative" in this respect, let alone meet the other statutory factors. However, it is difficult—and likely unproductive—to discuss these highly fact-specific issues in the abstract. An example may be helpful.

D. An Example

Consider the designs at issue in the Court of Customs and Patent Appeals case of *In re Laverne*.[70] *Laverne* involved a design patent application filed by the noted designers Erwine and Estelle Laverne.[71] The Lavernes claimed part of a design for a chair.[72] The PTO rejected the design as obvious, based on a single reference.[73] The Lavernes appealed.[74]

Judge Giles S. Rich wrote the opinion on appeal. In that opinion, he provided the following illustration of the Lavernes' design and the cited reference:[75]





69. *See* Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 Lewis & Clark L. Rev. 715, 747 (2011).
70. *In re* Laverne, 356 F.2d 1003 (C.C.P.A. 1966), *overruled by In re* Nalbandian, 661 F.2d 1214 (C.C.P.A. 1981).
71. *See* Mel Byars, The Design Encyclopedia 320 (1994) (discussing the Lavernes and their designs); Mary Schoeser & Whitney Blausen, *Wellpaying Self Support, in* Women Designers in the USA 1900–2000: Diversity and Difference 156 (Pat Kirkham, ed. 2000) (discussing the Lavernes and noting that when their "firm closed in the mid-1960s it had received many accolades including four Good Design Awards from MoMA and five awards from the American Institute of Decorators").
72. *See Laverne*, 356 F.2d at 1004.
73. *Id*. at 1004–05.
74. *Id*. at 1003.
75. *Id*. at 1004.

Judge Rich described the reference simply as "the design patent to Eero Saarinen, Des. 181,945, issued Jan. 21, 1958."[76] He failed to mention (or perhaps was not aware) that the cited reference claims one of the most famous examples of mid-century modern design—Eero Saarinen's iconic *Tulip* chair.[77]

The *Tulip* chair featured a "revolutionary one-leg design."[78] According to Saarinen, "[t]he undercarriage of chairs and tables in a typical interior [made] an ugly, confusing, unrestful world."[79] The pedestal concept was his solution to this "slum of legs."[80] Over time, the *Tulip* chair "became as familiar a piece of furnishing in high-style architectural interiors as any piece by Mies van der Rohe or Le Corbusier."[81]

The Lavernes' design, the *Champagne* chair, was clearly inspired by the *Tulip* chair.[82] But the Lavernes were not mere imitators; they creatively built upon Saarinen's revolutionary pedestal-chair concept and created their own innovative design. Indeed, both the *Tulip* chair and the *Champagne* chair are considered to be examples of *avant-garde* furniture design.[83]

In *Laverne*, the sole issue was whether the claimed design was invalid as obvious.[84] The PTO did not claim that the *Tulip* chair anticipated the *Champagne* chair.[85] This is important because, in U.S. patent law, there is a longstanding principle that a reference "which infringes, if later, would anticipate, if earlier."[86] Therefore, at least from the perspective of the PTO, the two designs are not similar enough to raise an issue of infringement.

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76. *Id*. at 1003.
77. *See* U.S. Pat. No. Des. 181,945 (filed Mar. 1, 1957) (showing Saarinen's *Tulip* chair); *see also* Kathryn Hiesinger & George Marcus, Landmarks of Twentieth-Century Design 195 (1993) (identifying the *Tulip* chair as a "landmark" of design). Saarinen was, of course, the famous architect who designed, among other things, the St. Louis Gateway Arch and the TWA terminal at Kennedy Airport. Byars, *supra* note 71, at 488; *see also* Hiesinger & Marcus at 381. He also designed the University of Chicago Law School's main building. Eero Saarinen: shaping the future 194 (Eeva-Liisa Pelkonen & Donald Albrecht eds., 2006).
78. Hiesinger & Marcus, *supra* note 77, at 195.
79. *Id*. (quoting Eero Saarinen, *Furniture Design 1947 to 1958*, *in* Eero Saarinen on His Work 66 (Aline B. Saarinen ed., 1962)).
80. *See id*.
81. Stephen Bayley & Terence Conran, Design: Intelligence made visible 270 (2007).
82. *See* Charlotte Fiell & Peter Fiell, 1000 Chairs 310 (1997) (stating that the *Champagne* chair was "[i]nspired by Saarinen's earlier 'Tulip' chair").
83. *See id*. at 318–19 (listing both the *Tulip* chair and the *Champagne* chair as examples of *avant-garde* chair design); *see also* Byars, *supra* note 71, at 320 (noting that the *Champagne* chair was shown in a 1984 design exhibition); *id*. at 488 (listing museum exhibitions in which the *Tulip* chair was shown).
84. *In re Laverne*, 356 F.2d 1003, 1003 (C.C.P.A. 1966) ("The sole issue, as we see it, is the obviousness of appellants' design . . . .").
85. *See id*. at 1004 ("The Patent Office does not question novelty.").
86. Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1239 (Fed. Cir. 2009) (quoting Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889)).

But imagine what would have happened if Saarinen had a right to prevent others from copying the *Tulip* chair. In that situation, the three aspects of copyright law discussed above would not meaningfully narrow the scope of that right—at least as compared to the protection provided by his real-life design patent.

1. Idea-Expression Dichotomy

The *Tulip* chair is a rare nonrepresentational design that might actually have an objectively-discernible "idea" that can be separated from its "expression." One could say that the "idea" is a pedestal chair; the expression would be the precise shape (and arguably, the smooth texture) chosen by Saarinen. If the idea-expression dichotomy were applied, it would be clear that Saarinen could not monopolize all pedestal chairs. However, Saarinen's design patent does not extend to all pedestal chairs. Saarinen did not just claim the pedestal—he claimed the upper "shell" portion as well.[87] And even if Saarinen had claimed just the pedestal, he would still be limited to the shape shown in the drawings. He would not have been able to claim that his design patent was infringed by, for example, a chair set on a Roman-style pedestal. So, the idea-expression dichotomy would not meaningfully narrow the scope of a right to prevent copying, at least as compared to the scope of the design patent.

2. Requirement of Copying

Likewise, in this case, the requirement of copying would not make a right to prevent copying narrower than design patent protection. Indeed, the protection provided by a right to prevent copying would appear to be significantly broader than Saarinen's actual design patent. The *Tulip* chair was so famous and so widely promoted that there can be little doubt that the Lavernes were aware of Saarinen's design. Thus, they probably could not mount a plausible defense of independent creation or argue that they did not have access to Saarinen's design. So the only real issue would be substantial similarity and these designs are almost certainly similar enough to pass that test. In jurisdictions that recognize the "inverse ratio" rule, the fame of the *Tulip* chair might lower the bar for similarity even further. Therefore, Saarinen might have a fairly strong case against the Lavernes for copying. By contrast, in the real-life design patent case, there was no hint that the Lavernes' chair was similar enough to infringe Saarinen's design patent.

3. Fair Use

Finally, the fair use doctrine would not provide any meaningful limit to the scope of a right to prevent copying. The *Champagne* chair was a potentially competing commercial product, Saarinen's chair was highly creative, and, arguably, the Lavernes

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87. *See* U.S. Pat. No. Des. 181,945 (filed Mar. 1, 1957); *see also* MPEP, *supra* note 25, § 1503.02(III) ("Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines.").

used most of Saarinen's design.[88] All of these factors would point against a finding of fair use.[89] And although the Lavernes added new expressive content, the expressive purpose of both works appears to be identical—i.e., making an attractive, modern chair. Therefore, the Lavernes' use is unlikely to qualify as "transformative."[90] For all of these reasons, a fair use defense would not narrow the scope of a right to prevent copying Saarinen's design.

III. Implications & Conclusion

These initial observations suggest that copyright is not necessarily narrower than design patent protection—at least in the context of designs. Indeed, in some respects, a copyright-like right to prevent copying could be even broader than the current scope of design patent protection. If these preliminary conclusions are correct, then many of the arguments that have previously been made will need to be reevaluated.

For example, Professor William T. Fryer, III has argued that "[f]or intellectual property rights of a lesser scope than a patent, such as the right to prevent copying, a system giving protection without prior novelty examination is justified."[91] If a right to prevent copying is not, in fact, narrower than a design patent, then Professor Fryer's justification for lowering the eliminating the requirement of *ex ante* examination would disappear.

Professor Orit Fischman Afori has even suggested that the relative scope of these types of protection could have constitutional implications. According to Professor Afori, there is "a possible constitutional argument" against granting patents (or patent-like protection) for designs.[92] She observes that the Supreme Court has interpreted the Progress Clause "as a mandate to shape law according to utilitarian considerations."[93] Professor Afori asserts that patents "confer[] a stronger monopolistic right than that of copyright" and argues that "as long as there is no good reason for conferring an excessive scope of protection for designs, in comparison with artistic works, such excessive protection does not comply with the constitutional mandate."[94] But if, as my preliminary analysis suggests, copyright-

88. In real life, Lavernes disclaimed the pedestal portion of their design. *See Laverne*, 356 F.2d at 1004 (showing that portion in broken lines). But even if that was all they used from Saarinen's design, he could still claim that the pedestal was the "heart" of his design and defeat a fair use claim. *See* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 575 (1994) ("In *Harper & Row*, . . . the Nation had taken only some 300 words out of President Ford's memoirs, but we signaled the significance of the quotations in finding them to amount to 'the heart of the book,' the part most likely to be newsworthy and important in licensing serialization.") (quoting Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 565 (1985)).
89. *See* 17 U.S.C. § 107; *see also* Section II(C), *supra*.
90. *See* Netanel, *supra* note 70, at 747.
91. *See* Fryer, *supra* note 5, at 355 (1996) (citing 17 U.S.C. §§ 901–14 (1994) (Semiconductor Chip Protection Act of 1984)).
92. *See* Afori, *supra* note 6, at 1134.
93. *Id*. (citing, *inter alia*, *Campbell*, 510 U.S. at 575).
94. *Id*.

like protection could actually be broader than design patent protection, Professor Afori's constitutional analysis would actually support the opposite conclusion.

At a minimum, this analysis suggests that further research is needed on this issue. To be clear, this Essay is not intended to present a full and complete analysis of the relative scope of copyright-like protection as compared to design patent protection. Rather, with this Essay, I hope to start a new discussion on these important issues. ■