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THE NATURE OF THE PROTECTION OF ARTISTIC AND INDUSTRIAL DESIGNS
LEONARD MICHAELSON

INTRODUCTION

In recent years, it has become increasingly clear through the decisions rendered by the courts in design patent infringement suits, that the grant of a design patent by the Patent Office does not necessarily include a grant of a limited monopoly for the manufacture and sale of the article patented which, theoretically at least, was sanctioned by the Constitution. The number of fatalities, that is, patents held invalid, in design patent litigation, has been unusually high in recent years and has led to the agitation for legislation or some form of relief to aid the designer against the copyist and infringer. It is the purpose of this article to point out that basic problems involved in securing adequate design protection and to suggest a possible solution either in the form of legislative enactment or judicial interpretation.

THE ORIGIN AND LEGISLATIVE DEVELOPMENT OF DESIGN PATENTS

The patent system stems from the well known provision set forth in Article I, Section 8, of the Constitution and although Congress enacted several patent laws prior to the adoption of the Constitution, it was not until 1836 that Congress provided for the establishment of the Patent Office and a system of examination. The design patent was established in 1842 by the enactment of the Patent Act of 1842 and provided for the grant of a patent for a limited time to anyone who 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 woolen, 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 original impression or ornament, or to be placed on...

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1. U.S. CONST. Art. 1, § 8, gives Congress the power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their inventions and discoveries."
3. See Note 1, supra.
6. 5 STAT. 543 (1842).
7. The Act of 1842 provided that the duration of the patent granted for a design would be seven years.
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.”

The Patent Act of March 2, 1861 eliminated fabrics from the list of designs protected, but broadened the term of protection to three and a half, seven or fourteen years at the election of the applicant. In the Consolidated Patent Act of 1870 fabrics were once again given design protection and the term “useful” was inserted in the statute to define the design to be protected.

The Patent Act of May, 1902 amended the design statute to eliminate the anomalous term “useful” and substituted “ornamental” therefor. The word “produced” was also eliminated from the statute and as a result the 1902 Act crystallized the modern definition of a design patent and authorized the grant of a patent to “any person who has invented any new, original and ornamental design for an article of manufacture . . .

**The Judicial Interpretation of the Design Patent Laws**

Early decisions.—The first basic interpretation of the design patent laws was made by the Supreme Court in the leading case of Gorham Mfg. Co. v. White, wherein the court defined design infringement and furthermore established a definition for patentability, stating:

The Acts of Congress, which authorize the grant of patents for designs were plainly intended to give encouragement to decorative arts. They contemplate not so much utility as appearance, and that, not as an abstract impression or picture, but an aspect given to those objects mentioned in the Acts. * * * And, the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The

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8. 12 Stat. 246 (1861).
9. The optional term of protection is included in the law today and the government fees for filing and granting the design patent vary in accordance with the number of years protection elected.
10. 10 Stat. 198 (1870).
14. 81 U.S. 511 (1871).
15. The definition of infringement in design cases as laid down by the court in the Gorham case is universally accepted as the test today. This test, normally referred to as the “eye test,” was defined by the court as follows: “We hold, therefore, 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 observer, inducing him to purchase one supposing it to be the other -- the first one patented is infringed by the other.”
law manifestly contemplates that giving certain new and original appearances to a patented article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, not matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but in whatever way produced, it is the new thing or product which the law regards.

It was this interpretation given the patent act by the Supreme Court that ultimately led to the Act of 1902 and the elimination of the word "useful" from the statute.\(^{16}\)

A standard of invention had not been established by the courts in design cases during these early years of the growth of designs, but the Supreme Court in the case of Dobson v. Dorman,\(^{17}\) in holding a design patent for a carpet valid and infringed, did attempt to establish a test to be used in determining novelty and infringement. The court found in the Dobson case that:

Undoubtedly the claim in this case covers the design as a whole and not any part and it is to be tested as a whole as to novelty and infringement.

The court of the second circuit in 1893,\(^ {18}\) in holding a patent for a watch case valid and infringed, made a liberal interpretation of the design patent laws, comparing an inventor to an artist, sculptor or photographer, and held that even though the design in suit did not present a wide departure from other designs, it would be protected. However, the Supreme Court in the same year in the case of Smith v. Whitman Saddle Co.,\(^ {19}\) was soon to establish a precedent for invention in design cases that eventually resulted in the present agitation for legislative relief. The Supreme Court in the Whitman Saddle case approved the rule in the lower court decision of Northrup v. Adams,\(^ {20}\) and for the first time predicated design patentability on invention as in mechanical cases. The "genius" theory was also first introduced into the concept of design patentability

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17. 118 U.S. 10 (1886).
18. Untermeyer v. Freund, 37 Fed. 342 (S.D.N.Y. 1889). The opinion by Judge Coxe in this case recognized the principle of originality and the advantages that ought to accrue to the originator of a design. He went on to say, "If it (design) presents a different impression upon the eye from anything which precedes it, if it proves to be pleasing, attractive, and popular, if it creates a demand for the goods of its originator, even though it be simple and does not show a wide departure from other designs, its use will be protected."
19. 148 U.S. 674 (1893). This case was the last patent suit involving a design patent to be considered by the Supreme Court.
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when the language in the Northrup case was quoted by the Supreme Court as follows:

To entitle a party to the benefit of the act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention.21

This unfortunate choice of language has since been regarded as the criterion for design invention by many jurisdictions and has undoubtedly been a contributing factor in the gradual decline of the protection of artistic and industrial designs for their creators. The Supreme Court evidently did not recognize at the time of the Whitman Saddle case any shades or variations in invention. What was “akin to genius” was not defined but it was definitely established by the court that the originality of the design involved must be of a high order of invention involving “inventive genius.” Although the Supreme Court later in 191122 recognized that there were orders of invention, and the second circuit several years later in 191323 suggested that the courts regard design patents in a lesser light than utility patents, the general view has been to regard design patents on the same plane as utility patents and to employ the same test of invention.24 Accordingly, the courts have normally attempted to maintain a high standard of invention in design cases25 since the Whitman Saddle case and have continually referred to the “genius test”26 in seeking the answer to whether invention was present in developing the design in question.

21. It is interesting to note that the Supreme Court in the Whitman Saddle case did not actually intend that their language be interpreted that a combination of old elements could never be patentable. Mr. Justice Fuller speaking for the court went on to say: “The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty and the result is in effect a new creation the design may be patentable.” The court in this case found no infringement but did not rule on validity, leaving the lower court’s definition of invention undisturbed.

22. Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428 (1911). The patent in suit related to a mechanical device (tire), the court stating that the “art was crowded” and further that degrees of change are recognized by the law and invention may be divided into primary and secondary degrees.


25. E.g., see Moore v. C. R. Anthony Co., 198 F.2d 607 (10th Cir. 1952); General Time Instruments Corp. v. U.S. Time Corp., 165 F.2d 853 (2d Cir. 1948); Zangerle & Paterson Co. v. Venice Furniture Novelty Mfg. Co., 133 F.2d 266 (7th Cir. 1943).

26. The Whitman Saddle case referred to invention as being something “akin to genius,” but many of the courts when applying the genius theory state that the inven-
Raising the standard of invention.—In 1941 the Supreme Court handed down the highly controversial decision of Cuno Engineering Corp. v. The Automatic Device Corp.,27 wherein the court sought to maintain the high standard of invention established in the Whitman Saddle case. In the Cuno case, the court emphasized that invention must be the result of a “flash of creative genius” and that “perfection of workmanship” was not enough to define invention. Mr. Justice Douglas speaking for the court said:

We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statute the device must also be an “invention” or “discovery” (and) it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art . . . . That is to say the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.

The court in attempting to raise the standard of invention28 set down such a stringent standard for patentability that it is little wonder a Supreme Court justice was moved a few years later to remark, in the oft quoted language, that the “only patent that is valid is one which this court has not been able to get its hands on.”29 Although the Cuno case did not involve a design patent, the general attitude of the court and the standards for patentability set forth therein have been reflected in the decisions of the lower courts in design cases30 as well as in mechanical cases,31 and thus it followed that during the ten-year period subsequent to the Cuno
decision, out of forty-eight adjudications of validity of design patents, thirty-seven were declared invalid.\textsuperscript{32} 

To add to the confusion, the Supreme Court in the case of The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,\textsuperscript{33} decided in December of 1950, once again denounced the low standards of invention presumably sanctioned by the Patent Office and the lower courts. Although the majority opinion in the A & P case did not set forth any new standards or tests for invention, it was emphasized therein what is required to produce a patentable combination of elements, and that a uniting of old elements with no change in their respective functions "obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men." However, it was the concurring opinion by Mr. Justice Douglas that caused the storm of controversy following the decision.\textsuperscript{34} In his opinion, Mr. Justice Douglas used the following language:

The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The Patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents—gadgets that obviously have had no place in the constitutional scheme of advancing scientific knowledge.

The effect of the A & P Case.—Although the A & P case also related to a mechanical patent, the lower courts, as in the Cuno case, construed the general intent of the Supreme Court to maintain a high standard of invention whether the invention be mechanical or design. The judicial thinking set forth in the A & P decision was very shortly reflected in the decision of the lower courts. The District Court for the Southern District of New York in December 1950, less than a month after the A & P decision, in the case of The Kono Mfg. Co. v. Vogue Optical Mfg. Co., Inc.,\textsuperscript{35} held a design patent for a spectacle frame invalid, citing the A & P case as emphasizing that a high standard of invention is essential to obtain a patent. Judge Kauffman, in the Kono case, cited both the majority and concurring opinions in the A & P case and stated:

The Supreme Court most recently expressed its views on the subject of invention in patents with great clarity. In the case of

\textsuperscript{32} See note 2, supra.
\textsuperscript{33} 340 U.S. 147 (1950).
\textsuperscript{35} 94 F. Supp. 251 (S.D.N.Y. 1950).
The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, the Court, in denying the patentability of a mechanical device because it was a mere aggregate of known elements, emphasized the high standard of invention required to obtain a patent. Mr. Justice Douglas in his concurring opinion stated that the grant to Congress in Article 1, Section 8 of the Constitution of power to permit patents to be issued was for the purpose of promoting the progress of science and useful arts. He pointed out that: "Every patent is the grant of a privilege of exacting tolls from the public. The Framers plainly did not want those monopolies freely granted. * * * (T)rue through the years the opinions of the Court commonly have taken ‘inventive genius’ as the test.

He emphasized that the Patent Office has too frequently departed from the constitutional standards which are supposed to govern the granting of patents.

In another recent district court case, Acton Mfg. Co. Inc. v. Louisville Tin & Stove Co., a design patent for a portable beverage cooler was held invalid, the court quoting freely from the A & P decision and particularly Mr. Justice Douglas' concurring opinion. The court in the Acton case emphasized that a high standard of invention must be maintained by the judiciary and went on to say:

Every improvement, either in utility or design, even to the extent of radical changes in appearance and function, is not such evidence of inventive genius that the most recent workman can claim a monopoly of production under the patent laws.

To my mind the decision in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra, sharply directed the attention of the trial courts to the fact that decisions in cases such as the one at bar have drifted far beyond the intent of the legislative patent protection enactments. It was pointed out in the opinion in that case: “The concept of invention is inherently elusive when applied to combination of old elements.

With the rebuke of the patent system so apparent in the A & P case, the lower courts have been reluctant to find invention in even the most outstanding designs and the record reveals that since the A & P decision, out of twenty design patents adjudicated by the lower courts, fifteen have been declared invalid and five valid. With the record


37. Figures compiled from decisions published by U.S. Patents Quarterly.

38. Of the 15 patents declared invalid, 4 decisions were rendered by the Courts of Appeal. These were Hopkins v. Waco Products, 205 F.2d 221 (7th Cir. 1953); Burgess Virocrafters v. Atkins Industries, 204 F.2d 311 (7th Cir. 1953); Moore v. C. R. Anthony Co., 198 F.2d 607 (10th Cir. 1952); Tupper Corp. v. Tilton & Cook, 101 U.S. PAT. Q. 1 (1954).

39. The same patent was held valid and infringed by the third and fourth Circuit Courts of Appeal. See Sanson Hosiery Mills, Inc. v. Warren Knitting Mills, Inc., 202 F.2d 381 (3d Cir. 1953); and Glen Raven Knitting Mills, Inc. v. Sanson Hosiery Mills, Inc., 189 F.2d 845 (4th Cir. 1951).
of the courts showing an overwhelming tendency to invalidate design patents, the thought naturally arises whether a valid design patent does exist under the present judicial thinking. The United States Court of Appeals for the Second Circuit apparently believes there does not, setting forth in the recent case of Charles D. Bridell, Inc. v. Alglobe Trading Corp.,\(^\text{40}\) that “to obtain a valid design patent is exceedingly difficult.” It would appear, however, that the Patent Office does not subscribe to this rather pessimistic view and during the one-year period ending July 28, 1954, issued 2635 design patents.\(^\text{41}\) Why then, does the Patent Office continue to issue this relatively large number of design patents in view of the judicial interpretation of the patent laws? The answer, apparently, is in the different standards\(^\text{42}\) of invention employed by the Patent Office and the courts. Thus, the Patent Office in arriving at a decision to grant a patent determines patentability on a more or less relaxed standard, while the courts invoke a rigid standard for invention.

**What is invention?**—By statute, a design must be new, original, ornamental and involve the element of invention.\(^\text{43}\) Ordinarily, it is not difficult to determine whether the design involved is new, original and ornamental since the design only need differ somewhat from the prior art to satisfy these requisites. However, in determining whether invention is present in the design over the prior known designs has defied even the most judicious minded bodies. At least one court has openly professed its difficulty in determining design invention\(^\text{44}\) and other courts have lamented that the standards used are “vague and difficult of application.”\(^\text{45}\) In seeking to find invention in a design, the courts, as well as the Patent Office, have repeatedly emphasized that it is not sufficient to merely show that the design is novel, ornamental, or pleasing in appearance,\(^\text{46}\) but that the design must reveal a greater skill than that exercised by the ordinary designer who is chargeable with knowledge of the prior art.\(^\text{47}\) The validity of the design must be tested by the appearance


\(^{41}\) Figures compiled from Official Gazette of the U. S. Patent Office.

\(^{42}\) The word “standard” is actually used by the courts to denote “tests” as well as in a relative sense, that is, a high standard or a low standard.


\(^{44}\) The Court of Customs and Patents Appeals in In re Bigelow, 194 F.2d 550 (C.C.P.A. 1950) said “it is difficult, if not impossible to set out a hard and fast rule of what constitutes design invention.” Also see In re Warren, 194 F.2d 715 (C.C.P.A. 1951).


\(^{47}\) Nat Lewis Purses, Inc. v. Carole Bags, Inc., 83 F.2d 475 (2d Cir. 1936). Also see 1 WALKER, PATENTS 426 (Delter’s ed. 1937).
of the design as a whole, but mere mechanical skill of the artist is no more sufficient to constitute inventive art in the case of the design artist than in the case of the engineer. The reassembling and regrouping of old elements that perform no new function, and if within the skill of the ordinary designer, is not invention. However, the reassembling or regrouping of familiar forms and decorations may constitute a patentable design, if a new result is obtained, and if ingenuity is displayed in producing something new, which imparts to the eye a pleasing impression even though it be the result of uniting old forms and parts, such production is a "meritorious invention." In a recent case, the court held a patent for a child's toilet seat valid and infringed and said that even though "each element in a patented design is old does not of itself negative invention since patentability may reside in the manner in which the elements are combined." A design, to be patentable, moreover, must not be dictated by mechanical or functional requirements, but the mere fact that the design involves some mechanical or utilitarian function does not render it unpatentable. In the case of Glen Raven Knitting Mills v. Sanson Hosiery Mills, the court, in holding a design for a lady's stocking valid and infringed, took a more liberal view of validity, declaring that secondary factors supplementing the usual tests for patentability should be considered and gave considerable emphasis to the fact that the design in question was commercially successful. However, it is well established that commercial success without invention will not make patentability. Although these
theoretical rules for determining design invention are acknowledged by the courts, there still exists a sense of confusion as to what constitutes patentable invention. With the question of inventions and patentability in such a confused state, and with various courts and tribunals each applying a different standard to determine invention, it is reasonable to presume that subsequent litigation will continue to result in invalid patents. If the Patent Office were to adopt the judicial standard of invention, the high mortality rate in design patents may be decreased, since such a standard would allow only a mere handful of design patents to be granted during the course of a year. Yet, there are many designs for artistic and industrial developments which have novelty and originality and that should be afforded some form of protection.

The apparel arts—A special problem.—In some fields, such as the wearing apparel arts, the problem is acute and although design protection through patents is theoretically the only relief available, the courts have completely denied such relief and have even advanced the proposition that patent protection for fabrics is not within the purview of the patent statutes. Since the courts have denied the dress designers any effective relief against the design pirates, it has become a common and accepted practice in the garment industry for a skilled designer to develop highly styled designs at great expense, only to have the less principled competitors pirate the designs and introduce them on the market at a lesser price. Although other fields have recently been afforded some relief through patent protection, it is still a calculated risk to bring suit on a design patent.

SOLVING THE PROBLEM

Judicial interpretation.—In view of the judicial history of the unsuccessful attempts to obtain adequate protection for designs, what then can

59. Design protection has been denied in the form of copyrights. See Verney v. Rose Fabrics Converters Corp., 87 F. Supp. 802 (S.D.N.Y. 1949); Kemp & Beatley v. Hirsch, 34 F.2d 291 (E.D.N.Y. 1929); and relief through suit for unfair competition has also been declared unavailable. See Cheney Bros. v. Doris Silk Corp., 35 F.2d 279 (2d Cir. 1929).


61. In White v. Lombardy, 40 F. Supp. 216 (S.D.N.Y. 1941), Judge Inch declared that a dress design may be “new, original and attractive and yet not be patentable” and “it makes one wonder how any patent on such dresses can be obtained provided true invention is required.” For a discussion of the particular problems involved in the wearing apparel art, see 27 IND. L.J. 130 (1952).


64. See notes 37-39, supra.
be done to provide the protection so urgently needed in this field? A possible solution is for the courts to take judicial notice of the fact that design invention is normally not of the same order as mechanical invention. That is, the same standard of invention applied by courts in mechanical cases should not be applied in design cases, since the processes employed to arrive at a new design by the very nature of the subject-matter involved is less demanding than that for mechanical inventions. Moreover, differences in design are less pronounced than differences in mechanical movements, and a slight change in design over the prior art may be of a high order of design invention, but a slight change in a mechanical movement over the prior art may be nothing more than that which could be accomplished by one skilled in the art. Of course, the standard of invention would again be determined by subjective reasoning, but if this doctrine could be established by judicial interpretation, the presumption of validity of a design patent granted by the Patent Office would be given more than just lip service and the burden of overcoming the presumption would weigh heavily on one asserting invalidity. It is realized that this solution, as advocated, is not capable of immediate application and would require a period of indoctrination, and, moreover, would more than likely require a Supreme Court interpretation. However, in view of the resistance to change in the design patent laws by legislative enactment, it should be noted that in a thirty-year period, some thirty-five bills have been introduced into Congress which were designed to modify or to abolish the present system of design patent protection and to provide protection in other forms such as, for example, by copyright. None of the bills were enacted into law.

Supporting the "different standard of invention" theory is the theory that it was the true intent of Congress in enacting the first design Patent Act of 1842 not to require invention in designs in the same sense as in mechanical devices. Thus, it has been advocated in some instances, although unsuccessfully, that the true intent of Congress in enacting the Patent Act of 1842, was to provide for the issuance of a patent to any one who "invented or produced . . . any new and original design for a manufacture." It is argued, therefore, that the design need not require

65. See note 23, supra.
66. Ibid. But cf. S. Dresner & Son v. Doppelt, 120 F.2d 50 (7th Cir. 1941).
68. For a list of the bills introduced into Congress, see Derenberg, Copyright No Man's Land: Fringe Rights in Literary and Artistic Property, 35 J. Pat. Off. Soc'y 770, 784-788 (Nov. 1953); see also Weikert, Design Piracy, 19 Ind. L.J. 235 (1944).
70. Emphasis supplied. In Gorham Co. v. White, 81 U.S. 511 (1871), the court specifically referred to the production of the design. The court said: "And the thing invented or produced, for which a patent is given, is that which gives a peculiar or
invention to be patentable as long as it is produced within the meaning of the statute. The courts have rejected this theory and in the case of S. Dresner & Son v. Doppelt, they specifically noted that the Act of 1870 changed the wording of the statute to “invented and produced.” The court went on to say:

By the terms of the present act, patentable design for an article of manufacture must be characterized by invention of a new, original and ornamental design. The mere production of such a design is not sufficient. The word ‘produced’ which appeared in the earlier enactments has disappeared from the present Act, and there is no authority to substitute it for the word ‘invented’ and thereby qualify the usual concept of invention.

It is encouraging to note that Congress in the Patent Act of 1952 did attempt to establish a uniform standard for patentability. In Section 103 of the Patent Act, the conditions to be satisfied before a patent may be granted are set forth as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The standard is defined in Section 103 in a negative sense; that is, the subject-matter must not have been obvious to one having ordinary skill in the art. Actually, this standard is not new and has been applied by the courts for more than 100 years and the courts today have continually enunciated the rule. However, this standard taken with the second sentence of Section 103 combines to form an objective test that provides a basis at least for the courts establishing a uniform standard of invention. The second sentence in Section 103 specifically sets forth that it matters little in what manner the invention was made and thus attempts to diminish the judicially-established “flash of genius test” which test in effect did

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71. 120 F.2d 50 (7th Cir. 1941).
72. Emphasis supplied. Note also the interpretation of the Court of Customs and Patent Appeals in In re Faustmann, 155 F.2d 388 (C.C.P.A. 1946). The word “produced” has since been removed from the statute by the Act of 1902 and the word “discovered” substituted therefor.
73. Enacted into law January 1, 1953.
75. See note 47, supra.
not look to the state of the art but to the manner in which the invention had been made. At least the invention resulting from a logical period of development now stands on an equal footing with invention resulting from a “flash of genius.”

Although the Patent Act of 1952 attempted to establish an objective standard for determining patentability, it, unfortunately, did not define what constitutes invention in a design. The requirements for patentability of a design, as set forth in Section 171 of the Patent Act, still provide that the design, in addition to being new, original and ornamental, must involve invention, and it is not unlikely that the courts in subsequent litigation will continue to maintain their extremely high standards for design invention.

Legislative enactment.—In the absence of judicial acknowledgment of a different order of invention between designs and mechanical devices, if any relief is to be afforded the artistic and industrial designer, it must result from legislative enactment. Although prior attempts at amending or eliminating the design patent laws have proved unsuccessful, more recent and vigorous agitation for statutory change may well result in the changes advocated during the past thirty years.

1. Copyrights as a source of protection.—Since the subject-matter of design patents involves artistic creations as well as industrial designs, many of the proposed legislative changes have suggested either the incorporation of all designs in the copyright laws or a copyright type of design patent law. Such proposals have been given thorough consideration by proponents and opponents alike, particularly in view of the limited requirements for registration of a copyright and the relatively long period of protection.

76. The report of the House Judiciary Committee which interpreted the newly codified Patent Act made the following note with reference to § 103 — “The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from a long toil and experimentation or from a flash of genius.”

77. The courts have for many years recognized the need for legislative aid in securing protection for designs. See e.g., Nat Lewis Purses, Inc. v. Carole Bags, Inc., 83 F.2d 475 (2d Cir. 1936); Roseweb Frocks, Inc. v. Moe-Feinberg-Mor Wiesern, Inc., 40 F. Supp. 579 (S.D.N.Y. 1941); White v. Lombardy, 40 F. Supp. 216 (S.D.N.Y. 1941); White v. Leonore Frocks, Inc., 120 F.2d 113 (2d Cir. 1941).

78. See note 68, supra.


81. Copyrights are registered in the Copyright Office of the Library of Congress upon application therefor when publication of the work of art appropriately marked is shown. Two copies of the work are deposited in the Copyright Office and a certificate of registration is issued after a cursory examination as to whether the subject-matter is proper for registration. The only requirement for registration is originality but there is no examination as to the originality of authorship. If the subject-matter is proper for registration, the Register of Copyrights must, as a matter of right, issue the copyright, there being no discretionary power vested in his office.
therefor. A further advantage in the copyright form of protection is the low cost involved upon filing for registration. Moreover, obtaining a design patent is considerably more time-consuming than is registering a copyright since a period of examination is required to determine whether the design in question meets the requirements for patentability.

The copyright law specifically provides for the registration of "works of art" and thus have been interpreted to include many of those designs that could also be the subject of the design patent laws. Hence, it is argued that since there is an acknowledged existing overlap between the two laws, all designs should be incorporated into the copyright laws.

82. Copyrights are registered for a period of 28 years and may be renewed for an additional 28 years, 63 STAT. 154 (1947), 17 U.S.C. § 23 (1952).
83. The normal expense incurred in filing for registration of a copyright is the filing fee of four dollars. The expenses incurred in filing application for a design patent are dependent upon the amount of preparatory work done by an attorney, which should include a pre-filing search of the "prior art". The Government fee for filing an application for a design patent is $10, $15 or $30, depending upon the term of protection elected.
84. Normally a waiting period of five to eight months may be expected before a design patent issue after the application is filed in the Patent Office, although the period varies in accordance with the work load and may be shorter or longer. See 52 Mich. L. REV. 33, (Nov. 1953) footnote 23. Many of the design applications filed do not issue on the first action by the Patent Office since the Examiner may raise the question of lack of invention that must be argued, or a procedural point may arise with which compliance is necessary for the issuance of the patent. It is interesting to note that the Patent Office in the fiscal year 1952-1953 set a goal of two months for taking action on a case after receipt of application. However, this goal was never attained. The report of the Commissioner of Patents follows: "A total of 4,868 applications was pending in the design divisions at the beginning of the year. From 3 to 3½ months elapsed from receipt of application or amendment to office action. The objective was to reduce the backlog by 5,000 cases in the design divisions and to take action within two months of receipt of applications. By the end of the year the backlog had increased to 4,908 cases, and average pendency to action had lengthened to about 4 months, reflecting a greater number of new applications and a considerably smaller number of dispositions than expected."
85. 61 STAT. 652 (1947), 17 U.S.C. § 5(g) (1952), Works of Art; Models or designs for works of art. The complete classification of works for registration is as follows: (a) books, including composite and cyclopedic works, directories, gazeteers, and other compendiums; (b) portraits (prepared for oral delivery); (d) dramatic or dramatico-musical compositions; (e) musical compositions; (f) maps; (g) works of art; models or designs for works of art; (h) reproductions of a work of art; (i) drawings or plastic works of a scientific or technical character; (j) photographs; (k) prints and pictorial illustrations including prints or labels used for articles of merchandise; (l) motion-picture photoplays; (m) motion pictures other than photoplays.
87. For discussion as to the overlap of design patent and copyright laws, see 27 IOWA L. REV. 250 (1951); 52 MICH. L. REV. 33 (1953); 9 J. PAT. OFF. SOC'Y 298 (1927); 7 J. PAT. OFF. SOC'Y 540 (1925); 35 J. PAT. OFF. SOC'Y 627 (1953).
88. WILLIAMS, COPYRIGHT REGISTRATION OF INDUSTRIAL DESIGNS, 7 J. PAT. OFF. SOC'Y 540 (1925). The author at this early date recognized the "misfit and failure" of the design patent laws. "The fundamental error of Congress was in classifying industrial designs with mechanical invention instead of with literary and artistic work."
The courts have recognized the overlapping of the laws but normally have restricted the author or designer to an election of one law, which election barred the protection of the other law. The overlap between copyrights and design patents was brought into sharp focus in the recent Supreme Court decision of *Mazer v. Stein*. In the *Mazer* case a statuette had been registered in the copyright office under Section 5(g), Works of Art, but was subsequently fitted with a base and then sold commercially as a lamp. The infringers slavishly copied the statuette and also sold the article as a lamp with a base attached. The issue then arose whether the statuette was the proper subject-matter for a copyright, since it was embodied in an industrial article in its final form. Obviously, the statuette with the base attached would have been the proper subject-matter of a design patent if the creator had so chosen to elect this avenue of protection. It is also likely that the statuette without the base, and as registered as a copyright, was within the statutory class of articles protected by design patents. The court in holding the copyright valid and infringed declared the statuette as registered was not improper subject-matter for a copyright. The court then said:

> We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.

> Nor do we think the subsequent registration of a work of art published as an element in a manufactured article, is a misuse of the copyright. This is not different from the registration of a statuette and its later embodiment in an industrial article. The court further recognized the co-existence of the copyright and patent laws and indicated that a twilight zone did exist in the protection afforded by the two laws, stating:

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90. 347 U.S. 201 (1954). The *Mazer* case was considered by the Supreme Court after a conflict resulted in the lower courts. The copyright for the statuette was declared invalid in *Stein v. Expert Lamp Co.*, 188 F.2d 611 (7th Cir. 1951), and Stein v. Bernaderet, 109 F. Supp. 364 (E.D. Mich. 1952), but was held valid in *Rosenthal v. Stein*, 205 F.2d 633 (9th Cir. 1953) and *Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953).

91. The petitioners urged that, "The design patent laws should be interpreted as denying protection to artistic articles embodied or reproduced in manufactured articles. They say: 'Fundamentally and historically, the copyright office is the repository of what each claimant considers to be a cultural treasure, whereas the Patent Office is the repository of what each applicant considers to be evidence of the advance in industrial and technological fields'."

92. Although § 171 of the Patent Code provides for the grant of a patent for "an article of manufacture," it is recognized that design patents embrace articles classified in the "fine arts." Note that Design Division B of the Patent Office has jurisdiction over articles relating to "Household, Personal and Fine Arts" — see *Official Gazette* of the U.S. Patent Office.
We do hold that the patentability of the statuette, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.

In view of the judicial history of design patents, it is not unlikely to reason that if the creator of the statuette had chosen the design patent law as her means of protection, the resulting infringement suit would have resulted in just another invalid patent. It can be understood then, that the proponents of the copyright system of registration for designs have greeted this case with no little acclaim. Although the doctrine in the Mazer case may afford the artistic designer of works of art relief against the plagiarist, it should be pointed out that the court in this case also touched on the salient features of the objections to incorporating all designs into the copyright law. Despite the fact that the copyright office has interpreted the copyright laws to permit registration of those works embodying "mechanical or utilitarian aspects," the court in the Mazer case strictly interpreted the applicable copyright regulations, noting that "Regulation Section 202.8 . . . makes clear that artistic articles are protected in 'form but not their mechanical or utilitarian aspects.'"

Although design patents may not depend upon utility for patentability, it is apparent that the vast majority of designs as, for example, cigarette lighters, furniture, fixtures, fabrics, etc., are employed in a functional sense and thus may be classified as industrial designs as distinguished from works of art, which include statuary and pictures. It is these industrial designs that under the present definition of copyrights are incapable of being protected. Even if the copyright law were to be amended as advocated to include industrial designs, protection may be afforded the designer against the proven plagiarist or copyist but, due to the very definition of copyrights, there would undoubtedly arise serious obstacles to adequate overall protection that would leave the designer in no better position than he is today. "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to

93. "From 1909 to 1948 the Regulations . . . provided that works of the fine arts would be accepted . . . but that utilitarian objects . . . would be rejected. In practice, however, an object of artistic conception in a standard arm form — e.g., sculpture or painting — has not been denied registration merely because of its possible utilitarian aspects. . . . In 1948 the Register . . . concluded that the long-existing Regulations adequately defined only the extremes of permissible and non-permissible registration, leaving in doubt the works which fall intersticially between the two extremes." Brief of the Register of Copyrights as Amicus Curiae to the United States Court of Appeals for the 4th Circuit, Stein v. Mazer, 204 F.2d 472 (4th Cir. 1953) at 11-12. See 52 Mich. L. Rev. 33 (Nov. 1953), footnote 172.

94. Copyright Regulations published in 37 Code Fed. Regs. § 202.8 (1949), reads as follows: "Works of art (Class G)—(a)—In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enameled, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture."

95. See note 54, supra.
the expression of the idea—not the idea itself." That is to say, there can only be protection afforded the specific article copyrighted and it is well established in copyright law that "the copyright protects originality rather than novelty or invention—confering only 'the sole right of multiplying copies.'" Thus, if a similar article is produced by independent effort, there is no infringement of the copyright or, stated in another way, "absent copying there can be no infringement of copyright." Another basic objection to a copyright type of law for designs is the absence of examination as to originality. Although dispensing with the examination of the prior known designs would materially speed up the period of registration and would provide quick registration for those designs of a seasonal character where immediate protection is necessary, a more irreparable harm may be imposed upon those who would invest large sums of money in financing an industrial design only to find a comparable article already being commercially produced.

2. A suggested solution.—One solution to the matter would be to retain the present system of granting patents for designs, which includes the examination of the prior art, but to amend the design statute to properly define the requirement for design invention found therein. Novelty, originality and ornamentality are the elements that distinguish one design over another, and it is these elements that should by statutory definition define design invention. It is known that many courts, in adjudicating design patents, have found that a design was novel, original and ornamental, but upon employing the judicial standards and tests to determine invention could not justifiably sustain the validity of the patent in suit. The presence of originality, ornamentality and novelty in a design should be sufficient to define invention and to warrant the issuance of a patent.

96. Mazer v. Stein, note 93, supra. Also see F. W. Woolworth Co. v. Contemporary Arts, 193 F.2d 162 (1st Cir. 1951); Ansehl v. Puritan Pharmaceutical Co., 61 F.2d 131 (8th Cir. 1932); Fulmer v. United States, 103 F. Supp. 1021 (Ct. Cl. 1952); Muller v. Triborough Bridge Authority, 43 F. Supp. 298 (S.D.N.Y. 1942).
101. E.g., dresses — See 7 J. PAT. OFF. Soc'y 540 (July, 1925), for one view in favor of dispensing with the examination period. "Novelty and priority of production form no part of the equities of an original design."
102. The necessity for an examination to obtain an exclusive right in an art was found by the Supreme Court in Baker v. Selden, 101 U.S. 99 (1880) — "To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public."
103. See note 46, supra.
since such elements in the field of designs attest to the addition of the "stockpile of knowledge" in the particular art to which the design may relate. Invention in any instance is only relative, but in the realm of designs, the slightest change in appearance over that which had been known before may well constitute an outstanding design achievement, yet by present judicial standards would be found to be totally lacking in invention.

3. A further solution.—Although a statutory definition of design invention may increase the area of protection for designs, many objectionable features inherent in the present system of granting design patents would remain in the law. The solution would appear then to lie in the enactment of a completely new form of design law. The new law may be designed to protect those articles classified as industrial designs and could be modeled somewhat after the type of law protecting industrial designs in Great Britain. The problems involved in creating a new type of protection for industrial designs are many and complicated, for it is apparent that such a law to be effective must be a hybrid of copyright and patent protection. These problems may be classified into four main groups or headings as follows:

1. Subject-matter to be protected;
2. Procedural method of obtaining protection;
3. Nature of protection including the definition of infringement and period of protectability; and
4. Source of the authority for the law.

In some preliminary discussions the subject-matter sought to be protected has been generally defined as including any article of manufacture relating to features of shape, pattern, configuration or ornamentation of the article and intended to give it an attractive, artistic or distinctive appearance. It would appear that this definition completely covers the field of industrial designs and furthermore includes fabrics. However, since this definition of subject-matter sought to be protected does not attempt to distinguish between the subject-matter registered under the copyright law, there will be an overlap in protection of certain designs under the present law. It is believed that this is unavoidable due to the interpretation of the protectable

104. The British Registered Designs Act of 1949 provides for the protection of designs which are defined as "features of shape, configuration, pattern or ornament applied to an article by any industrial process or means . . . which in the finished article appeal to and are judged solely by the eye." The industrial design is registered for five years with two optional five-year renewal periods. No showing of invention is required, it only being necessary that the design be "new." The Designs Act expressly excludes artistic works of art which are protected by the Copyright Act of 1911. (In an attempt to distinguish between copyrights and industrial designs, the Copyright Act of 1911 provides that no protection will be afforded a design when it is reproduced in more than 50 single articles. However, there is still an acknowledged overlap in protection. See Mich. L. Rev. 33, 60 (Nov. 1933).

105. The Coordinating Committee of the National Council of Patent Law Associations is currently considering a draft of a proposed bill that is intended to amend the present design laws.
subject-matter given border line designs by the copyright office and the
dictum set forth in the Mazer case, supra. In such instances of overlapping
protection, the avenue of protection should be elected by the designer, but
he should be fully cognizant of the differences in protection afforded by
the two laws and particularly the differences in proof in finding infringe-
ment.106

A registration system for registering industrial designs would appear to
be the answer for affording the industrial designer adequate design pro-
tection, and in addition would essentially eliminate the heretofore known
delays so commonly associated with the granting of a design patent.
In contrast with copyrights, the industrial designs under the proposed
law should be subjected to a test of originality or novelty,107 which test
would necessarily include an examination108 to determine the state of
the prior known designs. As provided under the present patent laws,
the registration of a design should confer upon the designer a monopoly,
restricted to a limited period, giving him the right to exclude others from
making or selling an article similar in design to the article registered. The
period of protection may vary depending upon continued use of the design
and could be restricted to three to five years.109 In order to protect the
public, a penalty of forfeiture of the right to register could be imposed upon
a designer if he neglected to register his design six months after the
publication or indication of public use thereof.110

The test for infringement under the proposed law should be similar
to the tests now employed by the courts under the design patent laws.111
Thus, if two designs resemble one another, so that the ordinary purchaser is
induced to purchase one design believing it to be the other, then the first
one registered is infringed by the other. Unlike the copyright laws,
wilful copying should not have to be proved to make out infringement.
Evidence of similarity should be sufficient to establish infringement. The
public should be presumed to be charged with knowledge of the prior

106. In order to find infringement of a copyright, copying must be proved. See
discussion infra for suggested proofs of infringement under the proposed law.

107. Novelty can only be defined with relation to the prior known designs, thus if
the design so closely resembles the prior art designs in appearance so as to be considered
the same design by the ordinary purchaser, the registration should be denied.

108. Providing an examination of the prior designs for industrial designs subject to
a registration system was also advocated in the Sirowich Bill (H. R. 5859 introduced in the
See also Dohn, Designs — Patents or Copyrights, 10 J. PAT. OFF. Soc'y 297 (May,
1928). This author at an early date recognized the need of a registration system for
designs which included an examination.

109. The term of protection under the present Design Patent Law is either three
and one-half, seven or fourteen years, and is determined by the election of the inventor.

110. The applicant for a design patent must by signed oath swear that his invention
was not "patented or described in a printed publication in this or a foreign country or
in public use or on sale in this country, more than one year prior to the date of the
application for a patent in the United States." 66 Stat. 797, 35 U.S.C. 102 § (b)
(1952).

111. See note 15, supra.
registered designs and if independent effort produces two similar designs, the first one registered will be infringed by the other. Many details of form and procedure of the new law that cannot be included in this discussion must also be thoroughly considered and, moreover, since the registration system is proposed, a completely new form of grant will have to be developed.

The source of authority for enacting the proposed industrial design law should probably be derived from the author and inventor clause\(^{112}\) of the Constitution. The interstate and foreign commerce clause has been suggested as a possible source of authority, but in view of the liberal interpretation given the term “authors” by the copyright office,\(^ {113}\) and in view of the closely analogous protection granted to authors and inventors by Article I, Section 8 of the Constitution, it is believed that this latter clause provides the constitutional sanction for protection of industrial designs.

**Conclusion**

The area of protection afforded the artistic and industrial designer has been unduly limited by judicial interpretation of the design patent laws, and it therefore has become increasingly apparent that there is need for reform thereof. If the designer is to receive judicial aid in protecting his art, an entirely new form of design protection must be introduced into the law. The doctrine set forth in *Mazer v. Stein*, supra, is indicative that the judiciary will validate designs provided there is sufficient basis in the law. It is now squarely up to Congress then to provide this long sought for protection so urgently needed in the field of designs.

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112. See note 1, supra.
113. See note 93, supra.