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Design

This chapter deals with IP protections for the designs of three-dimensional objects. The fundamental conceptual challenge such objects present is that they can be both useful and beautiful, and the bodies of IP law we have studied so far tend to insist either that they only protect the useful aspects or only that they don't protect the useful aspects. Thus, the doctrinal challenge in each IP area is how to draw the line between the utilitarian/functional/useful/applied aspects of an object's design and everything else. As we will see, design patents cut the Gordian knot by defining utility extraordinarily narrowly. But to understand how that solution works, we first need to see the difficulties other approaches face. And, as we will see, the design-patent solution creates its own difficulties.

A Patent

There are no per se rules preventing the issuance of utility patents on three-dimensional designs; they are just not usually an effective tool for protecting design as such. One problem is utility: if the design's only improvement over the prior art is that it looks better, this might not qualify even under the permissive *Juicy Whip* standard. Another is claim drafting: to twist the phrase, writing about design is like dancing about architecture. Indefiniteness and enablement are likely to hem in the applicant's ability to capture the design in words. So while utility patents are well adapted to capturing the functional aspects of a design, they are so awkward as to be useless at capturing everything else.

B Copyright

Copyright deals with the functionality problem for three-dimensional objects in three different ways, depending on whether

If you add in *Baker* and the variations introduced for computer software, there are at least five different functionality tests.

the work is sculptural or architectural, and on whether VARA is in play.

1 Useful Articles

One could imagine drawing a distinction between fine art (like paintings and novels) and non-art (like boats and tools). *Bleistein*, however, dooms any inquiry into a work's artistry. Instead, the modern test focuses on utility; if a work is useful at all, the question is how much of the work is infected by its utility. You already know the answer in two dimensions: it is given by *Baker* and the merger doctrine. In three dimensions, the test is somewhat more stringent.

Mazer v. Stein

Respondents are partners in the manufacture and sale of electric lamps. One of the respondents created original works of sculpture in the form of human figures by traditional clay-model technique. From this model, a production mold for casting copies was made. The resulting statuettes, without any lamp components added, were submitted by the respondents to the Copyright Office for registration as "works of art" or reproductions thereof and certificates of registration issued. Thereafter, the statuettes were sold in quantity throughout the country both as lamp bases and as statuettes. Petitioners are partners and, like respondents, make and sell lamps. Without authorization, they copied the statuettes, embodied them in lamps and sold them.

[Under the 1909 Copyright Act, copyright extended to "all the writings of an author," and the two potentially applicable classes of works were "Works of art; models or designs for works of art" and "Reproductions of a work of art".]

The case requires an answer, not as to a manufacturer's right to register a lamp base but as to an artist's right to copyright a work of art intended to be reproduced for lamp bases. Petitioners question the validity of a copyright of a work of art for "mass" production. "Reproduction of a work of art" does not mean to them unlimited reproduction. Their position is that a copyright does not cover industrial reproduction of the protected article.

It is not the right to copyright an article that could have utility that petitioners oppose. Their brief accepts the copyrightability of the great carved golden saltcellar of Cellini but adds:

If, however, Cellini designed and manufactured this item in quantity so that the general public could have salt cellars, then an entirely different conclusion would be reached. In such case, the salt cellar becomes an article of manufacture having utility in addition to its ornamental

347 U.S. 201 (1954)



Lamp base

value and would therefore have to be protected by design patent.

The [longstanding] practice of the Copyright Office was to allow registration “as works of the fine arts” of articles of the same character as those of respondents now under challenge. It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art. 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 hold that the [design] patentability of the statuettes, 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.

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in “Science and useful Arts.” Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Douglas, J., concurring:

An important constitutional question underlies this case—a question which was stirred on oral argument but not treated in the briefs. The Copyright Office has supplied us with a long list of such articles which have been copyrighted – statuettes, book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays. Perhaps these are all “writings” in the constitutional sense. But to me, at least, they are not obviously so.

Mazer frames the question. Here is how Congress tried to answer it in the 1976 Copyright Act.

Copyright Act

- “Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of



Salt cellar by Benvenuto Cellini.

The Cellini Salt Cellar, worth an estimated \$60 million, was stolen in 2003 from the Kunsthistorisches Museum in Vienna and recovered in 2006 after the thief was identified.

17 U.S.C. § 101
Definitions

artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

- 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”.

H.R. Rep No. 94-1476

1976 U.S.C.C.A.N. 5659

The Committee is seeking to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design. A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies’ dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design – that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.

In reporting S. 22, the House Judiciary Committee has deleted Title II, which would create a new limited form of copyright protection for “original” designs which are clearly a part of a useful article, regardless of whether such designs could stand by themselves, sepa-

rate from the article itself. Thus designs of useful articles which do not meet the design patent standard of "novelty" would for the first time be protected. The Committee chose to delete Title II in part because the new form of design protection provided by Title II could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision. In addition, Title II left unanswered at least two fundamental issues which will require further study by the Congress. These are: first, what agency should administer this new design protection system and, second, should typeface designs be given the protections of the title? The issues raised by Title II have not been resolved by its deletion from the Copyright Revision Bill. Therefore, the Committee believes that it will be necessary to reconsider the question of design protection in new legislation during the 95th Congress. At that time more complete hearings on the subject may be held.

Brandir Intern., Inc. v. Cascade Pacific Lumber Co.

The courts have had difficulty framing tests by which the fine line establishing what is and what is not copyrightable can be drawn. Once again we are called upon to draw such a line, this time in a case involving the "RIBBON Rack," a bicycle rack made of bent tubing that is said to have originated from a wire sculpture.

Against the history of copyright protection well set out in the majority opinion in , and in

One aspect of the distinction that has drawn considerable attention is the reference in the House Report to "physically or conceptually" separable elements. The District of Columbia Circuit in *Esquire, Inc. v. Ringer*, (holding outdoor lighting fixtures ineligible for copyright), called this an "isolated reference" and gave it no significance. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, this court accepted the idea that copyrightability can adhere in the "conceptual" separation of an artistic element. Indeed, the court went on to find such conceptual separation in reference to ornate belt buckles that could be and were worn separately as jewelry.

In *Carol Barnhart Inc. v. Economy Cover Corp.*, a divided panel of this circuit affirmed a district court grant of summary judgment of noncopyrightability of four life-sized, anatomically correct human torso forms. *Carol Barnhart* distinguished *Kieselstein-Cord*, but it surely did not overrule it. The distinction made was that the ornamented surfaces of the belt buckles "were not in any respect required by their utilitarian functions," but the features claimed to be aesthetic or artistic in the *Carol Barnhart* forms were "inextricably intertwined with the utilitarian feature, the display of clothes." As Judge Newman's dissent made clear, the *Carol Barnhart* majority did not dispute "that conceptual separability is distinct from 'physical separability'

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



RIBBON Rack

Esquire: 591 F.2d 796 (D.C. Cir. 1978)



Lighting fixture in *Esquire*

Kieselstein-Cord: 632 F.2d 989 (2d Cir. 1980)

Carol Barnhart: 773 F.2d 411 (2d Cir. 1985)

and, when present, entitles the creator of a useful article to a copyright on its design.”

“Conceptual separability” is thus alive and well, at least in this circuit. The problem, however, is determining exactly what it is and how it is to be applied. Judge Newman’s illuminating discussion in dissent in *Carol Barnhart* proposed a test that aesthetic features are conceptually separable if “the article stimulates in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function.” This approach is to be distinguished from other possible ways in which conceptual separability can be tested, including whether the primary use is as a utilitarian article as opposed to an artistic work, whether the aesthetic aspects of the work can be said to be “primary,” and whether the article is marketable as art, none of which is very satisfactory. But Judge Newman’s test was rejected outright by the majority as “a standard so ethereal as to amount to a ‘nontest’ that would be extremely difficult, if not impossible, to administer or apply.”

Denicola: 67 Minn. L. Rev. 707 (1983)

Perhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*. There, Professor Denicola points out that although the Copyright Act of 1976 was an effort “to draw as clear a line as possible,” in truth “there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.” Denicola argues that “the statutory directive requires a distinction between works of industrial design and works whose origins lie outside the design process, despite the utilitarian environment in which they appear.” He views the statutory limitation of copyrightability as “an attempt to identify elements whose form and appearance reflect the unconstrained perspective of the artist,” such features not being the product of industrial design. “Copyrightability, therefore, should turn on the relationship between the proffered work and the process of industrial design.” He suggests that “the dominant characteristic of industrial design is the influence of non-aesthetic, utilitarian concerns” and hence concludes that copyrightability “ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations.” To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences, conceptual separability exists.

We believe that Professor Denicola’s approach provides the best

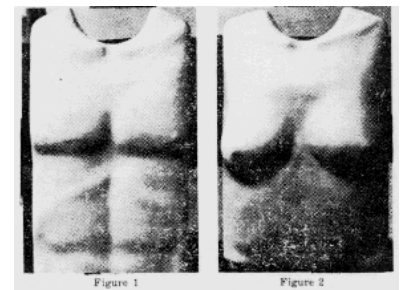
test for conceptual separability and, accordingly, adopt it here for several reasons. First, the approach is consistent with the holdings of our previous cases. In *Kieselstein-Cord*, for example, the artistic aspects of the belt buckles reflected purely aesthetic choices, independent of the buckles' function, while in *Carol Barnhart* the distinctive features of the torsos – the accurate anatomical design and the sculpted shirts and collars – showed clearly the influence of functional concerns. Though the torsos bore artistic features, it was evident that the designer incorporated those features to further the usefulness of the torsos as mannequins. Second, the test's emphasis on the influence of utilitarian concerns in the design process may help, as Denicola notes, to "alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis."³ Finally, and perhaps most importantly, we think Denicola's test will not be too difficult to administer in practice. The work itself will continue to give "mute testimony" of its origins. In addition, the parties will be required to present evidence relating to the design process and the nature of the work, with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations.

Turning now to the facts of this case, we note first that Brandir contends, and its chief owner David Levine testified, that the original design of the RIBBON Rack stemmed from wire sculptures that Levine had created, each formed from one continuous undulating piece of wire. These sculptures were, he said, created and displayed in his home as a means of personal expression, but apparently were never sold or displayed elsewhere. He also created a wire sculpture in the shape of a bicycle and states that he did not give any thought to the utilitarian application of any of his sculptures until he accidentally juxtaposed the bicycle sculpture with one of the self-standing wire sculptures. It was not until November 1978 that Levine seriously began pursuing the utilitarian application of his sculptures, when a friend, G. Duff Bailey, a bicycle buff and author of numerous articles about urban cycling, was at Levine's home and informed him that the sculptures would make excellent bicycle racks, permitting bicycles to be parked under the overloops as well as on top of the underloops. Following this meeting, Levine met several times with Bailey

³We are reminded not only by Judge Gesell in the district court in *Esquire* but by Holmes in *Bleistein*, by *Mazer*, and by numerous other opinions, that we judges should not let our own view of styles of art interfere with the decisionmaking process in this area. Denicola suggests that the shape of a Mickey Mouse telephone is copyrightable because its form is independent of function, and "a telephone shape owing more to Arp, Brancusi, or Moore than Disney may be equally divorced from utilitarian influence." This is true, of course, of the artist Christo's "Running Fence," approved as an example of conceptual separability in *Kieselstein-Cord*.



Belt buckle from *Kieselstein-Cord*



Torso from *Carol Barnhart*



Mickey Mouse telephone



Christo and Jeanne-Claude, *Running Fence* (1972–76)

and others, completing the designs for the RIBBON Rack by the use of a vacuum cleaner hose, and submitting his drawings to a fabricator complete with dimensions. The Brandir RIBBON Rack began being nationally advertised and promoted for sale in September 1979.

Between September 1979 and August 1982 Brandir spent some \$38,500 for advertising and promoting the RIBBON Rack, including some 85,000 pieces of promotional literature to architects and landscape architects. Additionally, since October 1982 Brandir has spent some \$66,000, including full-, half-, and quarter-page advertisements in architectural magazines such as *Landscape Architecture*, *Progressive Architecture*, and *Architectural Record*, indeed winning an advertising award from *Progressive Architecture* in January 1983. The RIBBON Rack has been featured in *Popular Science*, *Art and Architecture*, and *Design 384* magazines, and it won an Industrial Designers Society of America design award in the spring of 1980. In the spring of 1984 the RIBBON Rack was selected from 200 designs to be included among 77 of the designs exhibited at the Katonah Gallery in an exhibition entitled “The Product of Design: An Exploration of the Industrial Design Process,” an exhibition that was written up in the *New York Times*.

Sales of the RIBBON Rack from September 1979 through January 1985 were in excess of \$1,367,000. Prior to the time Cascade Pacific began offering for sale its bicycle rack in August 1982, Brandir’s sales were \$436,000. The price of the RIBBON Rack ranges from \$395 up to \$2,025 for a stainless steel model and generally depends on the size of the rack, one of the most popular being the RB-7, selling for \$485.

In November 1982 Levine discovered that another company, Cascade Pacific Lumber Co., was selling a similar product.

Applying Professor Denicola’s test to the RIBBON Rack, we find that the rack is not copyrightable. It seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements. This is true even though the sculptures which inspired the RIBBON Rack may well have been – the issue of originality aside – copyrightable.

Brandir argues correctly that a copyrighted work of art does not lose its protected status merely because it subsequently is put to a functional use. The Supreme Court so held in *Mazer*, and Congress specifically intended to accept and codify *Mazer* in section 101 of the Copyright Act of 1976.

Had Brandir merely adopted one of the existing sculptures as a bicycle rack, neither the application to a utilitarian end nor commercialization of that use would have caused the object to forfeit its copyrighted status. Comparison of the RIBBON Rack with the earlier sculptures, however, reveals that while the rack may have been de-

rived in part from one of more "works of art," it is in its final form essentially a product of industrial design. In creating the RIBBON Rack, the designer has clearly adapted the original aesthetic elements to accommodate and further a utilitarian purpose. These altered design features of the RIBBON Rack, including the spacesaving, open design achieved by widening the upper loops to permit parking under as well as over the rack's curves, the straightened vertical elements that allow in- and above-ground installation of the rack, the ability to fit all types of bicycles and mopeds, and the heavy-gauged tubular construction of rustproof galvanized steel, are all features that combine to make for a safe, secure, and maintenance-free system of parking bicycles and mopeds. Its undulating shape is said in *Progressive Architecture*, January 1982, to permit double the storage of conventional bicycle racks. Moreover, the rack is manufactured from 2 3/8-inch standard steam pipe that is bent into form, the six-inch radius of the bends evidently resulting from bending the pipe according to a standard formula that yields bends having a radius equal to three times the nominal internal diameter of the pipe.

Brandir argues that its RIBBON Rack can and should be characterized as a sculptural work of art within the minimalist art movement. Minimalist sculpture's most outstanding feature is said to be its clarity and simplicity, in that it often takes the form of geometric shapes, lines, and forms that are pure and free of ornamentation and void of association. As Brandir's expert put it, "The meaning is to be found in, within, around and outside the work of art, allowing the artistic sensation to be experienced as well as intellectualized." People who use Foley Square in New York City see in the form of minimalist art the "Tilted Arc," which is on the plaza at 26 Federal Plaza. Numerous museums have had exhibitions of such art, and the school of minimalist art has many admirers.

It is unnecessary to determine whether to the art world the RIBBON Rack properly would be considered an example of minimalist sculpture. The result under the copyright statute is not changed. Using the test we have adopted, it is not enough that, to paraphrase Judge Newman, the rack may stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept. While the RIBBON Rack may be worthy of admiration for its aesthetic qualities alone, it remains nonetheless the product of industrial design. Form and function are inextricably intertwined in the rack, its ultimate design being as much the result of utilitarian pressures as aesthetic choices. Indeed, the visually pleasing proportions and symmetry of the rack represent design changes made in response to functional concerns. Judging from the awards the rack has received, it would seem in fact that Brandir has achieved with the RIBBON Rack the highest goal of modern industrial design, that is, the harmo-



Richard Serra, *Tilted Arc* (1981)

Tilted Arc was dismantled and removed in 1989, i.e., the year before VARA's moral right against destruction of a work of recognized stature.

nious fusion of function and aesthetics. Thus there remains no artistic element of the RIBBON Rack that can be identified as separate and "capable of existing independently, of, the utilitarian aspects of the article." Accordingly, we must affirm on the copyright claim

WINTER, Circuit Judge, concurring in part and dissenting in part:

The grounds of my disagreement are that: (1) my colleagues' adaptation of Professor Denicola's test diminishes the statutory concept of "conceptual separability" to the vanishing point; and (2) their focus on the process or sequence followed by the particular designer makes copyright protection depend upon largely fortuitous circumstances concerning the creation of the design in issue.

In my view, *Carol Barnhart* and *Kieselstein-Cord* are not reconcilable. *Carol Barnhart* paid only lip service to the fact that the "conceptual separability" of an article's aesthetic utilitarian aspects may render the design of a "useful article" a copyrightable "sculptural work." Actually, the *Carol Barnhart* majority applied a test of physical separability. They thus stated:

What distinguishes [the *Kieselstein-Cord*] buckles from the *Barnhart* forms is that the ornamented surfaces of the buckles were not in any respect required by their utilitarian functions; the artistic and aesthetic features could thus be conceived of as having been *added to, or superimposed upon*, an otherwise utilitarian article. The unique artistic design was wholly unnecessary to performance of the utilitarian function. In the case of the *Barnhart* forms, on the other hand, the features claimed to be aesthetic or artistic, e.g., the life-size configuration of the breasts and the width of the shoulders are inextricably intertwined with the utilitarian feature, the display of clothes.

In contrast, *Kieselstein-Cord* focused on the fact that the belt buckles at issue could be perceived as objects other than belt buckles:

We see in appellant's belt buckles conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist.

My colleagues' adaptation of the Denicola test tracks the *Carol Barnhart* approach, whereas I would adopt that taken in *Kieselstein-Cord*, which allows for the copyrightability of the aesthetic elements of useful articles even if those elements simultaneously perform utilitarian functions.¹ The latter approach received its fullest elaboration in

¹Indeed, *Kieselstein-Cord* approved Professor Nimmer's example of Christo's "Running Fence" as an object whose sculptural features were conceptually, but not

Judge Newman's dissent in *Carol Barnhart*, where he explained that "for the artistic design features to be 'conceptually separate' from the utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function."

In other words, the relevant question is whether the design of a useful article, however intertwined with the article's utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article's use. The answer to this question is clear in the instant case because any reasonable observer would easily view the Ribbon Rack as an ornamental sculpture.² Indeed, there is evidence of actual confusion over whether it is strictly ornamental in the refusal of a building manager to accept delivery until assured by the buyer that the Ribbon Rack was in fact a bicycle rack. Moreover, Brandir has received a request to use the Ribbon Rack as environmental sculpture, and has offered testimony of art experts who claim that the Ribbon Rack may be valued solely for its artistic features. As one of those experts observed: "If one were to place a Ribbon Rack on an island without access, or in a park and surround the work with a barrier, its status as a work of art would be beyond dispute."

My colleagues also allow too much to turn upon the process or sequence of design followed by the designer of the Ribbon Rack. They thus suggest that copyright protection would have been accorded "had Brandir merely adopted as a bicycle rack" an enlarged version of one of David Levine's original sculptures rather than one that had wider upper loops and straightened vertical elements. I cannot agree that copyright protection for the Ribbon Rack turns on whether Levine serendipitously chose the final design of the Ribbon Rack during his initial sculptural musings or whether the original design had to be slightly modified to accommodate bicycles.

Eames Chair Problem

This is the Eames Lounge Chair by Charles and Ray Eames. Is its design copyrightable?

Copyright Act

- (a) Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial,

physically, separable from its utilitarian aspects. The fact that the Running Fence's aesthetic features were "inextricably intertwined" with its functional aspects, however, creates doubt as to whether it is a copyrightable "sculptural work" under *Carol Barnhart* or the instant decision.

²The reasonable observer may be forgiven, however, if he or she does not recognize the Ribbon Rack as an example of minimalist art.



Eames Lounge Chair

17 U.S.C. § 113

Scope of exclusive rights in pictorial, graphic, and sculptural works

graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise.

- (b) This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.
- (c) In the case of a work lawfully reproduced in useful articles that have been offered for sale or other distribution to the public, copyright does not include any right to prevent the making, distribution, or display of pictures or photographs of such articles in connection with advertisements or commentaries related to the distribution or display of such articles, or in connection with news reports. ...

Report of the Register of Copyrights on the General Revision of the Copyright Law (1961)

§ II.C.1.c

Relationship between copyright and the designs of useful articles

There remains the question of protection to be given to a copyrighted work of art that is utilized as a design in the manufacture of useful articles. We believe that, where the copyrighted work is used as a design or decoration of a useful article, it should continue, as under the present law, to be protected by copyright if the owner wishes. However, where the "work of art" actually portrays the useful article as such – as in a drawing, scale model, advertising sketch, or photograph of the article – existing court decisions indicate that copyright in the "work of art" does not protect against manufacture of the useful article portrayed. We agree with these decisions and the distinctions made in them.

Some examples will illustrate these points.

- (3) Since the protection available to a copyrighted pictorial, graphic, or sculptural work is not affected by use of the work as a design or decoration of a useful article, the following works would continue to be accorded full protection under the copyright statute:
 - A copyrighted painting reproduced on textile fabrics;
 - A copyrighted cartoon drawing or photograph reproduced on fabrics or in the form of toys or dolls;
 - A copyrighted drawing of a chair reproduced on a lampshade;

The present § 113 may be inartfully worded, but do you see how it adopts the Register's recommendations?

- A copyrighted sculptured figure used as a lamp base.
- (4) Under distinctions indicated in existing court decisions, that the copyright in a work portraying a useful article as such would not protect against manufacture of that article, copyright protection would not extend to the following cases:
- A copyrighted drawing of a chair, used to manufacture chairs of that design;
 - A copyrighted scale model of an automobile, used to manufacture automobiles of that design;
 - A copyrighted technical drawing showing the construction of a machine, used to manufacture the machine;
 - A copyrighted picture of a dress, used to manufacture the dress.

Model Car Problem

You represent Schafer Software, creator of the hit *Out of Control* series of racing video games. Sterling normally pays car companies licensing fees to include their cars in the *Out of Control* games as part of the licensing agreement. Negotiations with Corley Motors have broken down over Corley's excessive licensing fee demands for its Corley Polecat – ten times higher than any other company is demanding per vehicle.

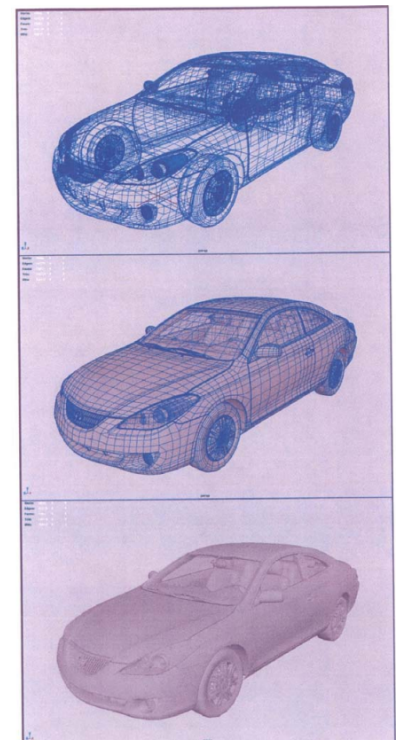
Marketing is desperate to include the Polecat in *Out of Control 2017* and has asked the development team to think of ways to include the Polecat without Corley's cooperation. They have suggested two ways of doing so. First, they could rent a Polecat and scan it with a high-resolution laser scanner that would generate an extremely detailed three-dimensional model. Second, it appears that digital copies of Corley's engineering diagrams for the Polecat have leaked onto car-enthusiast websites, where they have been available for months (with Corley's tacit acquiescence, it appears). The diagrams contain extremely detailed specifications for every part in the Polecat, as well as renderings showing a fully assembled Polecat from numerous angles. The developers believe that although both approaches would require significant work by Corley's 3D modeling artists, either approach would work for generating the files they would need to put the Polecat in *Out of Control 2017*.

Should Schafer proceed, and if so, how?

2 Architecture

Initially, the 1976 Copyright Act treated buildings as useful articles. The 1990 Architectural Works Copyright Protection Act changed that, adding "architectural works" to the list of types of copyrightable sub-

Loosely based on *Meshwerks, Inc. v. Toyota Motor Sales USA, Inc.*, 528 F.3d 1258 (10th Cir. 2008)



3D car model

ject matter in § 102(a) and adding a few special rules for them. The AWCPA is purely prospective; it applies only to architectural works created on or after December 1, 1990.

Kevin Emerson Collins

Economically Defeasible Rights to Facilitate Information Disclosure: The Hidden Wisdom of Pre-AWCPA Copyright

Architects were not entitled to rights on par with the rights to which other creative professionals were entitled. Most importantly, architectural drawings and buildings received different treatment: the former were protected but the latter were not. Pre-AWCPA copyright recognized architectural drawings as copyrightable subject matter. Duplicating the original expression embodied in a drawing in copy that is also a drawing violated pre-AWCPA copyright if performed without authorization. However, pre-AWCPA copyright did not protect original expression when that expression was embodied in a constructed building. Copying a constructed building did not constitute infringement before the AWCPA, even if the building was constructed from copyrighted drawings and regardless of whether the copy took the form of a drawing or a building. Constructed buildings were simply not copyrightable subject matter, so they could be freely copied. One architect was free to make “measured drawings” of an original building constructed by another architect and use those drawings to construct a copy of the building, even when the drawings that were used to build the original building were copyrighted. In other words, copying original expression from a constructed building was permitted even though copying the exact same original expression from a drawing was not.

The doctrinal reasoning that supported the unprotectability of constructed buildings has been viewed by some as suspect, but this limit on pre-AWCPA copyright was never seriously challenged. Constructed buildings were classified as useful articles, so, in theory, they could have been protected insofar as they had aesthetic aspects that were conceptually separable from their utilitarian aspects. However, apart from sculptures like gargoyles that were attached to architectural works, the aesthetic features of constructed buildings never came to be viewed as separable from the buildings’ functional features, so copyright protection never protected the architectural designs embodied in constructed buildings. Even a highly original building like Frank Lloyd Wright’s Guggenheim Museum was not protectable at all under pre-AWCPA because the building’s originality was not embodied in add-on ornamentation.

Pre-AWCPA copyright also disprivileged constructed buildings in another way. Although architectural drawings were copyrightable subject matter, constructing the building depicted in an architectural

(unpublished draft 2015)



Frank Lloyd Wright, Guggenheim Museum

drawing was not actionable because it was not considered to involve the creation of a derivative work.

Copyright Act

- (a) *Pictorial Representations Permitted.* – The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.
- (b) *Alterations to and Destruction of Buildings.* – Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.

17 U.S.C. § 120
Scope of exclusive rights in architectural works

17 U.S.C. § 101
Definitions

37 C.F.R. § 202.11
Architectural works

An “architectural work” is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

Code of Federal Regulations

- (b) *Definitions.* –
- (2) The term building means humanly habitable structures that are intended to be both permanent and stationary, such as houses and office buildings, and other permanent and stationary structures designed for human occupancy, including but not limited to churches, museums, gazebos, and garden pavilions.
- (d) *Works excluded.* – The following structures, features, or works cannot be registered:
- (1) *Structures other than buildings.* – Structures other than buildings, such as bridges, cloverleaves, dams, walkways, tents, recreational vehicles, mobile homes, and boats.

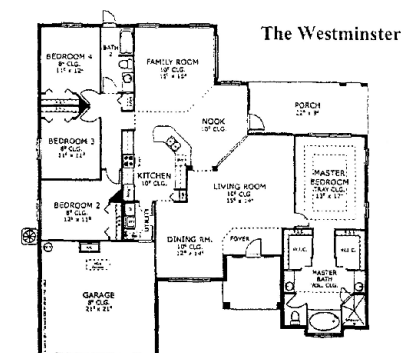
Intervest Construction, Inc. v. Canterbury Estate Homes

The definition of an architectural work closely parallels that of a “compilation” under the statute. Accordingly, any similarity comparison of the works at issue here must be accomplished at the level of protected expression – that is, the arrangement and coordination of

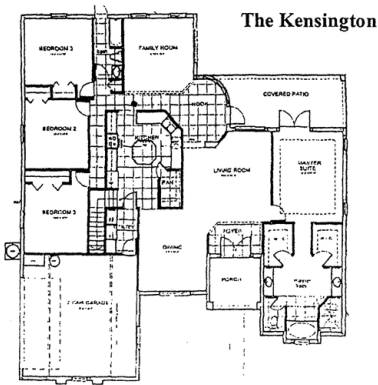


Is the Statue of Liberty an architectural work?

554 F.3d 914 (11th Cir. 2008)



Plaintiff's plan



Defendant's plan

754 F.3d 95 (2d Cir. 2014)

those common elements ("selected" by the market place, i.e., rooms, windows, doors, and "other staple building components"). In undertaking such a comparison it should be recalled that the copyright protection in a compilation is "thin." *Feist* Thus, when viewed through the narrow lens of compilation analysis only the original, and thus protected arrangement and coordination of spaces, elements and other staple building components should be compared.

Given that the plans at issue were protected by compilation copyrights which were "thin," the district court correctly determined that the differences in the protectable expression were so significant that, as a matter of law, no reasonable properly-instructed jury of lay observers could find the works substantially similar. Accordingly, the district court did not err in granting summary judgment to the appellee, the putative infringer.

Zaleski v. Cicero Builder Dev., Inc.

What aspects of Zaleski's designs are protectable? A fundamental rule of copyright law is that it protects only "original works of authorship," those aspects of the work that originate with the author himself. Everything else in the work, the history it describes, the facts it mentions, and the ideas it embraces, are in the public domain free for others to draw upon. It is the peculiar expressions of that history, those facts, and those ideas that belong exclusively to their author. Thus, any author may draw from the history of English-speaking peoples, but no one may copy from *A History of the English-Speaking Peoples*. Any artist may portray the Spanish Civil War, but no one may paint another *Guernica*. And anyone may draw a cartoon mouse, but there can be only one Mickey.

While we agree with the outcome in *Intervest*, we disagree with its reasoning. Every kind of work at some level is a compilation, an arrangement of uncopyrightable "common elements." No individual word is copyrightable, but the arrangement of words into a book is. No color is copyrightable, but the arrangement of colors on canvas is. Likewise, doors and walls are not copyrightable, but their arrangement in a building is. Some architectural designs, like that of a single-room log cabin, will consist solely of standard features arranged in standard ways; others, like the Guggenheim, will include standard features, but also present something entirely new. Architecture, in this regard, is like every art form.

Labeling architecture a compilation obscures the real issue. Every work of art will have some standard elements, which taken in isolation are un-copyrightable, but many works will have original elements—or original arrangements of elements. The challenge in adjudicating copyright cases is not to determine whether a work is a creative work, a derivative work, or a compilation, but to determine

what in it originated with the author and what did not. *Intervest* fails to do this. It compares the floor plans of the two houses, “focusing only on the narrow arrangement and coordination” of what it deems “standard ... features” and intuits that there was no copying of the arrangement. But it fails to provide any analysis of what made a feature “standard” and unprotectable. Hence, we find it of little assistance here.

Courts should treat architectural copyrights no differently than other copyrights. This is what Congress envisioned, and it is an approach we have employed before. In *Attia v. Society of the New York Hospital*, for example, the plaintiff had been retained by New York Hospital to design an expansion of its facility over FDR Drive. The hospital rejected his preliminary sketches, but ultimately went with a similar design by another firm. The plaintiff admitted that his drawings were “preliminary and generalized” “outlines” of “concepts.” Although there were some similarities between the plaintiff’s and the defendant’s designs, there were also significant differences. Thus, we held that any copying went to unprotected ideas, “concepts,” rather than concrete expression.

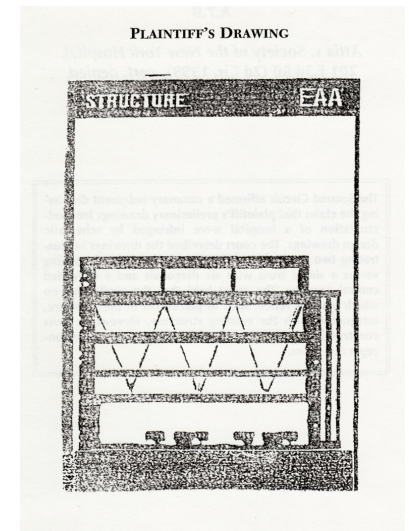
In *Peter F. Gaito Architecture, LLC v. Simone Development Corp.*, on a similar set of facts, we held that copying of “architecture that was light, airy, and transparent,” as well as design parameters and “generalized notions of where to place functional elements,” went only to ideas and not protected expression. Finally, in *Sparaco v. Lawler, Matusky, Skelly, Engineers LLP*, we held that although a construction site preparation plan was preliminary in the sense that it pertained to the early phases of construction, it was extremely detailed and thus more than a mere idea.

Efficiency is an important architectural concern. Any design elements attributable to building codes, topography, structures that already exist on the construction site, or engineering necessity should therefore get no protection.

There are scènes-à-faire in architecture. Neoclassical government buildings, colonial houses, and modern high-rise office buildings are all recognized styles from which architects draw. Elements taken from these styles should get no protection. Likewise, there are certain market expectations for homes or commercial buildings. Design features used by all architects, because of consumer demand, also get no protection.

Our prior architecture cases support this approach. In *Sparaco*, we held that there can be no copyright in a plan insofar as it merely represents the topography of a building site. Topography is an uncopyrightable “fact.” In *Attia* we recognized that “generalized notions of where to place functional elements, how to route the flow of traffic, and methods of construction” are un-protectable. Architects

Attia: 201 F.3d 50 (2d Cir. 1999)



Plaintiff's sketch in *Attia*

Gaito Architecture: 602 F.3d 57 (2d Cir. 2010)

Sparaco: 303 F.3d 460 (2d Cir. 2002)

cannot claim that good engineering is original to them—or at least can get no copyright protection for it. Finally, in *Gaito Architecture*, we held that there is no copyright in a building plan’s design parameters. Constraints placed on an architect by the way her client plans to use the building do not originate with the architect.

After considering these principles and reviewing the designs in question, we conclude that even if Defendants copied Zalewski’s plans, they copied only the unprotected elements of his designs. Plaintiff’s principal argument is that Defendants’ designs are so close to his that Defendants must have infringed. He is correct that the designs are, in many respects, quite close, but this is not enough. It proves at most copying, not wrongful copying.



One of Zalewski's colonial designs

First, many of the similarities are a function of consumer expectations and standard house design generally. Plaintiff can get no credit for putting a closet in every bedroom, a fireplace in the middle of an exterior wall, and kitchen counters against the kitchen walls. Furthermore, the overall footprint of the house and the size of the rooms are “design parameters” dictated by consumer preferences and the lot the house will occupy, not the architect.

Finally, most of the similarities between Plaintiff’s and Defendants’ designs are features of all colonial homes, or houses generally. So long as Plaintiff was seeking to design a colonial house, he was bound to certain conventions. He cannot claim copyright in those conventions. Great artists often express themselves through the vocabulary of existing forms. Shakespeare wrote his Sonnets; Brahms composed his Hungarian Dances; and Plaintiff designed his colonial houses. Because we must preserve these forms for future artists, neither iambic pentameter, nor European folk motifs, nor clapboard siding are copyrightable.

Plaintiff makes no attempt to distinguish those aspects of his designs that were original to him from those dictated by the form in which he worked. For example, Zalewski claims that the “front porches are the same design, size, and in the same location.” But a door centered on the front of the house is typical of many homes, and colonials in particular. Moreover, there are subtle differences in the paneling, size, and framing of Plaintiff’s and Defendants’ doors. These differences are not great, but given the constraints of a colonial design, they are significant. The same is true of the windows and garage doors that Plaintiff claims are identical. They are quite similar in location, size, and general design, but again, the similarities are due primarily to the shared colonial archetype. The window panes, shutters, and garage-door paneling all have subtle differences. Likewise, the designs’ shared footprint and general layout are in keeping with the colonial style. There are only so many ways to arrange four bedrooms upstairs and a kitchen, dining room, living room, and

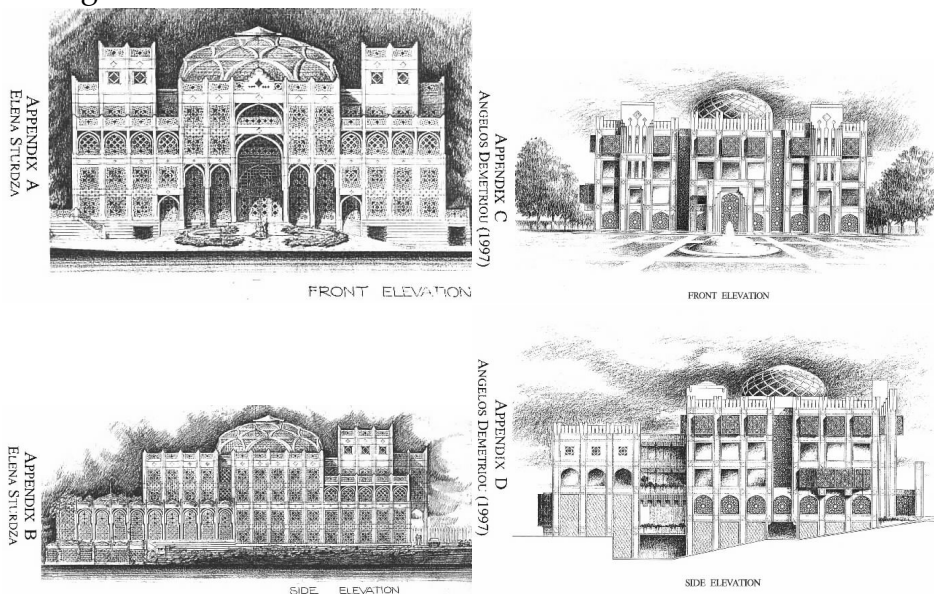
study downstairs. Beyond these similarities, Plaintiff's and Defendants' layouts are different in many ways. The exact placement and sizes of doors, closets, and countertops often differ as do the arrangements of rooms.

Although he undoubtedly spent many hours on his designs, and although there is certainly something of Plaintiff's own expression in his work, as long as Plaintiff adhered to a pre-existing style his original contribution was slight—his copyright very thin. Only very close copying would have taken whatever actually belonged to Plaintiff. Copying that is not so close would—and in this case did—only capture the generalities of the style in which Plaintiff worked and elements common to all homes. Defendants' houses shared Plaintiff's general style, but took nothing from his original expression.

Embassy Problem

Here are sketches front and side elevations of plaintiff's and defendant's designs for a proposed embassy. If the defendant had access to the plaintiff's plans, are the similarities strong enough that a jury could find infringement? Are they so strong that a jury must find infringement?

Based on *Sturdza v. United Arab Emirates*, 281 F.3d 1287 (D.C. Cir. 2002)



3 Moral Rights

VARA excludes from its coverage works of "applied art." Query how this standard differs from the tests applicable to the scope of copyright in a "useful article" or an "architectural work."

Cheffins v. Stewart

We must decide whether the Visual Artists Rights Act applies to a used school bus transformed into a mobile replica of a 16th-century

825 F.3d 588 (9th Cir. 2016)



La Contessa

Spanish galleon.

Plaintiffs Simon Cheffins and Gregory Jones, along with a number of volunteers, built the *La Contessa*, a replica of a 16th-century Spanish galleon for use at the Burning Man Festival.¹ Cheffins began his creation by acquiring a used school bus. He and Jones then designed and constructed the galleon facade, including a hull, decking, masts, and a handcrafted figurehead. These elements and the bus were then transported to the Black Rock Desert in northern Nevada, the site of Burning Man, and assembled. When completed, the *La Contessa* was approximately sixty feet wide and sixteen feet long with a mast over fifty feet tall.

The *La Contessa* first appeared at the Festival in 2002. Festival participants took rides on the *La Contessa*, and at least two weddings were performed on its deck. It reappeared in 2003 and 2005. In 2003, it was used as part of a marching band performance, and, in 2005, it was the centerpiece of a children's treasure hunt, among other things.

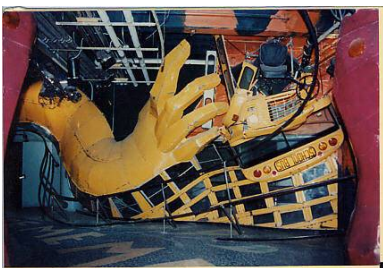
After the 2003 and 2005 Festivals, Cheffins and Jones stored the *La Contessa* on land in Nevada held in life estate by one Joan Grant, who had given them permission to do so. In late 2005, however, Grant's home burned down, causing her to abandon the life estate. Thereafter, defendant Michael Stewart took possession of the land in fee simple through a limited liability company.

Cheffins and Jones did not relocate the *La Contessa* after the change of property ownership. Rather, it sat unmoved on Stewart's land until December 2006. Sometime during that month, Stewart intentionally burned the wooden structure of the *La Contessa* so that a scrap metal dealer could remove the underlying school bus from his property.

As the text of the statute shows, the VARA only applies to "works of visual art." On summary judgment, Stewart asserted, and the trial court subsequently concluded, that the *La Contessa* was not a "work of visual art" because it was "applied art."

The VARA does not define the term "applied art," and federal courts have rarely had occasion to interpret its meaning. In *Carter v. Helmsley-Spear, Inc.*, the Second Circuit held that a sculpture constructed of portions of a school bus and affixed to a wall in a building lobby was not "applied art." It explained that the term "applied art" means "two- and three-dimensional ornamentation or decoration that is affixed to otherwise utilitarian objects." The court further explained that the sculpture was not "applied art" simply because it was affixed to "the lobby's floor, walls, and ceiling" because "interpreting applied art to include such works would render meaningless

Helmsley-Spear: 71 F.3d 77 (2d Cir. 1995)



Installation by Jx3 from *Helmsley-Spear*

¹Burning Man is an art and countercultural festival held each year for the week preceding Labor Day.

VARA’s protection for works of visual art installed in buildings.”

The Second Circuit provided an additional gloss on what constitutes a “work of visual art,” and by extension what constitutes “applied art,” in *Pollara v. Seymour*, where it explained that the “VARA may protect a sculpture that looks like a piece of furniture, but it does not protect a piece of utilitarian furniture, whether or not it could arguably be called a sculpture.” The court went on to hold that an elaborate painted banner was not a “work of visual art” eligible for protection under the VARA.

We agree in large part with the Second Circuit’s analysis. As the Second Circuit suggested, the focus of our inquiry should be on whether the object in question originally was – and continues to be – utilitarian in nature. Dictionary definitions suggest that, in its ordinary meaning, applied art consists of an object with a utilitarian function that also has some artistic or aesthetic merit.

Further, this approach makes sense in the statutory context in which “applied art” is used in 17 U.S.C. § 101. “Applied art” is enumerated in a list that also contains, inter alia, maps, globes, charts, technical drawings, diagrams, models, newspapers, periodicals, data bases, and electronic information services. The fact that the other items in the list are utilitarian objects leads us to conclude that the listed items are related by their practical purposes and utilitarian functions, requiring a focus on utility when construing the term “applied art.”

We therefore hold that an object constitutes a piece of “applied art” – as opposed to a “work of visual art” – where the object initially served a utilitarian function and the object continues to serve such a function after the artist made embellishments or alterations to it.⁶ This test embraces the circumstances both where a functional object incorporates a decorative design in its initial formulation, and where a functional object is decorated after manufacture but continues to serve a practical purpose. Conversely, “applied art” would not include a piece of art whose function is purely aesthetic or a utilitarian object which is so transformed through the addition of artistic elements that its utilitarian functions cease.

We respond briefly to the concern expressed in the concurrence that the standard we adopt today may not be workable – that it raises difficult questions regarding where exactly the line defining “applied art” will be drawn. The analysis we adopt today directs the court’s attention away from assessments of an object’s artistic merit and in-

⁶With recognition that nearly every object on which art is installed will be in some sense “utilitarian,” we caution that the utilitarian function must be something other than mere display of the work in question. See also 17 U.S.C. § 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.”).

Pollara: 344 F.3d 265, 269 (2d Cir. 2003)



Banner by Joanne Pollara

stead toward the object's practical utility.

We now apply this standard to the facts of this case.

The *La Contesssa* began as a simple school bus – an object which unquestionably served the utilitarian function of transportation. To transform the bus into the *La Contesssa*, Cheffins and Jones adorned it with the visual trappings of a 16th-century Spanish galleon. While the *La Contesssa's* elaborate decorative elements may have had many artistic qualities, the *La Contesssa* retained a largely practical function even after it had been completed. At Burning Man, the *La Contesssa* was used for transportation, providing rides to festival-goers, hosting musical performances and weddings, and serving as a stage for poetry and acrobatics shows. Indeed, the *La Contesssa* often was driven about the Festival grounds and was banned from the Festival in 2004 because "its unsafe driving practices far exceeded community tolerance and out-weighed the visual contribution" it made.

Under the definition we adopt today, the *La Contesssa* plainly was "applied art." It began as a rudimentary utilitarian object, and despite being visually transformed through elaborate artistry, it continued to serve a significant utilitarian function upon its completion. As "applied art," the *La Contesssa* was not a work of visual art under the VARA and therefore not eligible for its protection. Therefore, the trial court properly granted summary judgment to Stewart on Cheffins and Jones's VARA claim.

McKeown, Circuit Judge, concurring:

To better effectuate the purpose of VARA, we need a more nuanced definition of "applied art" that balances between the risk of unduly restricting VARA's reach and the risks of turning judges into art critics or consigning to litigation every work of art that includes some utilitarian function. In determining whether a work is "applied art," the right question to ask is whether the primary purpose of the work as a whole is to serve a practical, useful function, and whether the aesthetic elements are subservient to that utilitarian purpose. Because the bus/Spanish galleon *La Contesssa* is applied art under either standard, I concur in the judgment.

Although many court decisions have addressed applied art, these cases provide little guidance on how to distinguish applied from visual art. The issue in nearly all applied art cases is whether the work was copyrightable applied art or instead a noncopyrightable work of "industrial design."

The analysis in these cases is driven by the principle that works may unquestionably be applied art, such as a detailed carving on the back of a chair – an obviously utilitarian object – but may also enjoy certain copyright protection.⁴ Whether such a work falls under

⁴Indeed, examples of original "pictorial, graphic, and sculptural works" pro-

VARA's protections is a different question. Thus, while these opinions have coalesced around a definition of applied art for the purpose of copyright protection as pictorial, graphic, and sculptural works that are intended to be or have been embodied in useful articles, they do not provide an answer under VARA because VARA protects a new and different genus of "works of visual art."

VARA's protections cannot be limited only to works entirely devoid of any utilitarian purpose. Many outstanding sculptures, including the Caryatids of the Acropolis and the monumental carvings of Ramses at the temple of Karnak are in fact columns that provided buildings with structural integrity. Medieval tapestries not only represented a form of fine art, but also kept castles and cathedrals free from drafts. Of course, the famous Bayeux tapestries, which depict events leading to the Battle of Hastings, retain their utilitarian function to some extent: they could still be used to keep a drafty castle warm. Likewise, Tracy Emin's *My Bed*, displayed at the Tate Britain, incorporates Emin's real bed as a "monument to the heartache of a relationship breakdown." The bed arguably retains its original utilitarian function – it remains a bed, and could still be slept in – but it is no longer meant or used for this utilitarian purpose. Rather, like the Bayeux tapestries, *My Bed* is now appreciated and viewed as a work of creative expression and, when viewed as a whole, the utilitarian object has become part of a visual art piece.

The modern era abounds with examples of fine art that serve some utility. Perhaps the most famous sculpture of the modern era – Rodin's *The Thinker* – was conceived when the artist was designing a set of monumental doors titled *The Gates of Hell*. Doors, of course, are utilitarian objects that facilitate the movement of people into and out of buildings. Likewise, a young Pablo Picasso painted a massive background piece for the ballet *Le Tricorne*. Although that painting surely served some utilitarian purpose as a stage curtain, following that debut, it has been displayed as a painting for half a century. The painting was the focus of intense debate when it was removed last year from the Four Seasons restaurant in New York's Seagram Building, where it had hung since 1959. Some sculptures designed by Dale Chihuly are fantastically artistic and original and yet could also serve a utilitarian purpose of diffusing fresh water or serving as a room divider. The artistic and utilitarian aspects are entwined in some of Chihuly's pieces.

It is easy to imagine a sculpture composed of an array of utilitarian objects. Indeed, a Florida plumber/artist who created a sculpture with auto parts, plumbing fixtures and scrap wiring, found himself in

tected by copyright include dolls and toys, mosaics, and stained glass designs.



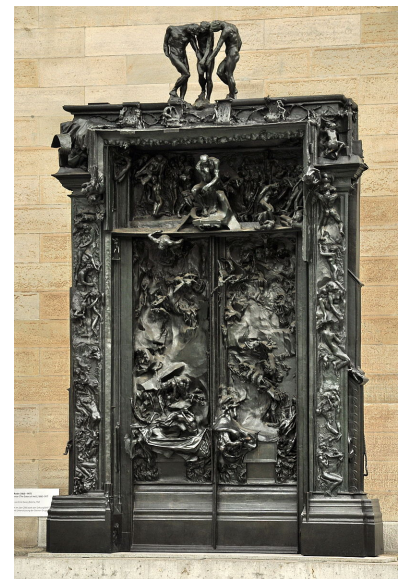
Caryatid Porch of the Erechtheum



Portion of the Bayeux tapestry



Tracy Emin, *My Bed* (1998)



Auguste Rodin, *The Gates of Hell* (1880–1917)



Pablo Picasso, *Stage Curtain for the Ballet "Le Tricorne"* (1919)



Dale Chihuly, *The Sun*

the middle of VARA litigation when the “junk” was removed.⁹ Automatically relegating these pieces – which are unquestionably works of visual art – beyond the scope of VARA simply because they may serve some practical function would undermine the purpose of the law.

To effect the purpose of VARA and provide guidance for the art community, I believe courts should evaluate the work as a whole, asking whether its primary purpose is to serve a useful function and whether the artistic creation is subservient to that purpose. If the primary purpose is for the work to be viewed and perceived as art, then any incidental utilitarian function will not push it outside the scope of VARA. If a work’s primary purpose is functional, however, no amount of aesthetic appeal will transfer it into visual art subject to VARA’s protections. Determining a work’s primary purpose need not constitute a judicial inquiry into the nature of art. Rather, as in other legal contexts, courts should ask whether “a reasonable observer” would “consider [the work] designed to a practical degree” for a utilitarian or artistic purpose.

In this case, applying the analysis I outline yields the same result as the majority: *La Contesssa* was applied art. The school bus-turned-galleon was designed for, and employed as, a performance venue, restaurant, and means of transportation around the Burning Man festival. Poets, acrobats, and bands performed on its decks. It drove revelers from party to party within Nevada’s Black Rock desert. On various occasions, the galleon was driven at high speeds, prompting festival organizers to send Cheffins and Jones a letter condemning its “unsafe driving practices.” When *La Contesssa* was not serving this purpose, it was dragged to a field, covered with a tarp, and left to sit idle for months at a time. Taken as a whole, this is powerful evidence that the primary purpose of *La Contesssa* was to serve the utilitarian functions of performance venue, gathering space, and people-mover. Although Cheffins and Jones testified passionately about *La Contesssa*’s beauty and the artistic expression they felt it embodied – and it is an impressive work of art in many respects – I conclude it is applied art because its aesthetic appeal was subservient to its primary utilitarian purpose. Thus, the VARA claim fails.

C Trademark

Trademark protects designs under the general heading of trade dress, using the same general distinctiveness analysis as it does for word

⁹The story of this fascinating dispute is outlined in Christopher J. Robinson’s note *The “Recognized Stature” Standard in the Visual Artists Rights Act*, 68 Fordham L. Rev. 1935 (2000). The parties did not contest that the work was a sculpture, but fought bitterly over whether the visual art was of “recognized stature.”

marks and logos. But two very important limiting doctrines apply. One is that product design is effectively always at most descriptive: it can have acquired distinctiveness (via secondary meaning) but not inherent distinctiveness. The other is that functional aspects of a design are never protectable, even if they have secondary meaning.

Wal-Mart Stores, Inc. v. Samara Brothers, Inc.

In this case, we decide under what circumstances a product's design is distinctive, and therefore protectable, in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act.

Respondent Samara Brothers, Inc., designs and manufactures children's clothing. Its primary product is a line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like. A number of chain stores, including JCPenney, sell this line of clothing under contract with Samara.

In 1995, Wal-Mart contracted with one of its suppliers, Judy-Philippine, Inc., to manufacture a line of children's outfits for sale in the 1996 spring/summer season. Wal-Mart sent Judy-Philippine photographs of a number of garments from Samara's line, on which Judy-Philippine's garments were to be based; Judy-Philippine duly copied, with only minor modifications, 16 of Samara's garments, many of which contained copyrighted elements. In 1996, Wal-Mart briskly sold the so-called knockoffs, generating more than \$1.15 million in gross profits.

The breadth of the definition of marks registrable under § 2, and of the confusion-producing elements recited as actionable by § 43(a), has been held to embrace not just word marks, such as "Nike," and symbol marks, such as Nike's "swoosh" symbol, but also "trade dress" – a category that originally included only the packaging, or "dressing," of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product. [Cases cited protected the designs of bedroom furniture, sweaters, and notebooks.] These courts have assumed, often without discussion, that trade dress constitutes a "symbol" or "device" for purposes of the relevant sections, and we conclude likewise.

The text of § 43(a) provides little guidance as to the circumstances under which unregistered trade dress may be protected. Nothing in § 43(a) explicitly requires a producer to show that its trade dress is distinctive, but courts have universally imposed that requirement, since without distinctiveness the trade dress would not "cause confusion ... as to the origin, sponsorship, or approval of [the] goods," as the section requires.

In evaluating the distinctiveness of a mark under § 2 (and therefore, by analogy, under § 43(a)), courts have held that a mark can be distinctive in one of two ways. First, a mark is inherently distinc-

529 U.S. 205 (2000)

(Scalia, J.)



Samara Brothers dress

tive if its intrinsic nature serves to identify a particular source. In the context of word marks, courts have applied the now-classic test originally formulated by Judge Friendly, in which word marks that are “arbitrary” (“Camel” cigarettes), “fanciful” (“Kodak” film), or “suggestive” (“Tide” laundry detergent) are held to be inherently distinctive. See *Abercrombie & Fitch*. Second, a mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.

The judicial differentiation between marks that are inherently distinctive and those that have developed secondary meaning has solid foundation in the statute itself. Nothing in § 2, however, demands the conclusion that every category of mark necessarily includes some marks “by which the goods of the applicant may be distinguished from the goods of others” without secondary meaning – that in every category some marks are inherently distinctive.

Indeed, with respect to at least one category of mark – colors – we have held that no mark can ever be inherently distinctive. In *Qualitex Co. v. Jacobson Products Co.*, petitioner manufactured and sold green-gold dry-cleaning press pads. After respondent began selling pads of a similar color, petitioner brought suit under § 43(a), then added a claim under § 32 after obtaining registration for the color of its pads. We held that a color could be protected as a trademark, but only upon a showing of secondary meaning. Reasoning by analogy to the *Abercrombie & Fitch* test developed for word marks, we noted that a product’s color is unlike a “fanciful,” “arbitrary,” or “suggestive” mark, since it does not “almost automatically tell a customer that it refers to a brand,” and does not “immediately signal a brand or a product source.” However, we noted that, “over time, customers may come to treat a particular color on a product or its packaging ... as signifying a brand.” Because a color, like a “descriptive” word mark, could eventually “come to indicate a product’s origin,” we concluded that it could be protected upon a showing of secondary meaning.

It seems to us that design, like color, is not inherently distinctive. The attribution of inherent distinctiveness to certain categories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product. Although the words and packaging can serve subsidiary functions – a suggestive word mark (such as “Tide” for laundry detergent), for instance, may invoke positive connotations in the consumer’s mind, and a garish form of packaging (such as Tide’s squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer’s attention on

Qualitex: 514 U.S. 159 (1995)



Qualitex dry-cleaning pad



Tide bottle

a crowded store shelf – their predominant function remains source identification. Consumers are therefore predisposed to regard those symbols as indication of the producer, which is why such symbols almost automatically tell a customer that they refer to a brand, and immediately signal a brand or a product source. And where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source – where, for example, the affixed word is descriptive of the product (“Tasty” bread) or of a geographic origin (“Georgia” peaches) – inherent distinctiveness will not be found. That is why the statute generally excludes, from those word marks that can be registered as inherently distinctive, words that are “merely descriptive” of the goods or “primarily geographically descriptive of them. In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.

Respondent contends that our decision in *Two Pesos, Inc. v. Taco Cabana, Inc.* forecloses a conclusion that product-design trade dress can never be inherently distinctive. In that case, we held that the trade dress of a chain of Mexican restaurants, which the plaintiff described as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals,” could be protected under § 43(a) without a showing of secondary meaning. *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that product-design trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product design. It was either product packaging – which, as we have discussed, normally is taken by the consumer to indicate origin – or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.

Respondent replies that this manner of distinguishing *Two Pesos* will force courts to draw difficult lines between product-design and



Penguin-shaped cocktail shaker

Two Pesos: 505 U.S. 763 (1992)



Taco Cabana exterior



Earl Dean's Coca-Cola bottle design

product-packaging trade dress. There will indeed be some hard cases at the margin: a classic glass Coca-Cola bottle, for instance, may constitute packaging for those consumers who drink the Coke and then discard the bottle, but may constitute the product itself for those consumers who are bottle collectors, or part of the product itself for those consumers who buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former. We believe, however, that the frequency and the difficulty of having to distinguish between product design and product packaging will be much less than the frequency and the difficulty of having to decide when a product design is inherently distinctive. To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning.

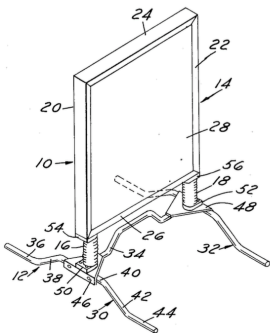
We hold that, in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning.

Lanham Act

15 U.S.C. § 1052 [Lanham Act § 2]
Trademarks registrable on principal register ...

15 U.S.C. § 1125 [Lanham Act § 43]
False designations of origin, false descriptions, and dilution forbidden

532 U.S. 23 (2001)
 No. 3,646,696 and No. 3,662,482



Patented dual-spring design

No trademark ... shall be refused registration on the principal register on account of its nature unless it—

(e) Consists of a mark which ... (5) comprises any matter that, as a whole, is functional.

(a) Civil Action

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

Traffix Devices, Inc. v. Marketing Displays, Inc.

Temporary road signs with warnings like "Road Work Ahead" or "Left Shoulder Closed" must withstand strong gusts of wind. An inventor named Robert Sarkisian obtained two utility patents for a mechanism built upon two springs (the dual-spring design) to keep these and other outdoor signs upright despite adverse wind conditions. The holder of the now-expired Sarkisian patents, respondent Marketing Displays, Inc. (MDI), established a successful business in

the manufacture and sale of sign stands incorporating the patented feature. MDI's stands for road signs were recognizable to buyers and users (it says) because the dual-spring design was visible near the base of the sign.

This litigation followed after the patents expired and a competitor, Traffix Devices, Inc., sold sign stands with a visible spring mechanism that looked like MDI's. MDI and Traffix products looked alike because they were. When Traffix started in business, it sent an MDI product abroad to have it reverse engineered, that is to say copied. Complicating matters, Traffix marketed its sign stands under a name similar to MDI's. MDI used the name "WindMaster," while Traffix, its new competitor, used "WindBuster."

II

It is well established that trade dress can be protected under federal law. The design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquires this secondary meaning, assuming other requisites are met, is a trade dress which may not be used in a manner likely to cause confusion as to the origin, sponsorship, or approval of the goods. In these respects protection for trade dress exists to promote competition. Congress confirmed this statutory protection for trade dress by amending the Lanham Act to recognize the concept. Lanham Act S 43(a)(3) provides: "In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional." [The Court discussed *Qualitex*, *Two Pesos*, and *Wal-Mart Stores*.]

Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. Copying is not always discouraged or disfavored by the laws which preserve our competitive economy. Allowing competitors to copy will have salutary effects in many instances. Reverse engineering of chemical and mechanical articles in the public domain often leads to significant advances in technology.

The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed func-



Traffix "Little Buster" sign with dual-spring base

tional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

In the case before us, the central advance claimed in the expired utility patents is the dualspring design; and the dual-spring design is the essential feature of the trade dress MDI now seeks to establish and to protect. MDI did not, and cannot, carry the burden of overcoming the strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patents.

The dual springs shown in the Sarkisian patents were well apart (at either end of a frame for holding a rectangular sign when one full side is the base) while the dual springs at issue here are close together (in a frame designed to hold a sign by one of its corners). As the District Court recognized, this makes little difference. The point is that the springs are necessary to the operation of the device. The fact that the springs in this very different-looking device fall within the claims of the patents is illustrated by MDI's own position in earlier litigation. In the late 1970's, MDI engaged in a long-running intellectual property battle with a company known as Winn-Proof. Although the precise claims of the Sarkisian patents cover sign stands with springs "spaced apart," the Winn-Proof sign stands (with springs much like the sign stands at issue here) were found to infringe the patents by the United States District Court for the District of Oregon, and the Court of Appeals for the Ninth Circuit affirmed the judgment. *Sarkisian v. WinnProof Corp.* Although the WinnProof traffic sign stand (with dual springs close together) did not appear, then, to infringe the literal terms of the patent claims (which called for "spaced apart" springs), the WinnProof sign stand was found to infringe the patents under the doctrine of equivalents. In light of this past ruling – a ruling procured at MDI's own insistence – it must be concluded the products here at issue would have been covered by the claims of the expired patents.

The rationale for the rule that the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality is well illustrated in this case. The dual-spring design serves the important purpose of keeping the sign upright even in heavy wind conditions; and, as confirmed by the statements in the expired patents, it does so in a unique and useful manner. As the specification of one of the patents recites, prior art "devices, in practice, will topple under the force of a strong wind." The dual-spring design allows sign stands to resist toppling in strong winds. Using a dual-spring design rather than a single spring achieves important operational advantages. For

example, the specifications of the patents note that the “use of a pair of springs as opposed to the use of a single spring to support the frame structure prevents canting or twisting of the sign around a vertical axis,” and that, if not prevented, twisting “may cause damage to the spring structure and may result in tipping of the device.” In the course of patent prosecution, it was said that “the use of a pair of spring connections as opposed to a single spring connection forms an important part of this combination” because it “forc[es] the sign frame to tip along the longitudinal axis of the elongated ground-engaging members.” The dual-spring design affects the cost of the device as well; it was acknowledged that the device “could use three springs but this would unnecessarily increase the cost of the device.” These statements made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design.

III

In finding for MDI on the trade dress issue the Court of Appeals gave insufficient recognition to the importance of the expired utility patents, and their evidentiary significance, in establishing the functionality of the device. The error likely was caused by its misinterpretation of trade dress principles in other respects.

Discussing trademarks, we have said “in general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Qualitex*. Expanding upon the meaning of this phrase, we have observed that a functional feature is one the “exclusive use of which would put competitors at a significant nonreputation-related disadvantage.” *Id.* The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity.” This was incorrect as a comprehensive definition. A feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device. The *Qualitex* decision did not purport to displace this traditional rule. It is proper to inquire into a “significant non-reputation-related disadvantage” in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the traditional formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.

The Court has allowed trade dress protection to certain product features that are inherently distinctive. In *Two Pesos*, however, the Court at the outset made the explicit analytic assumption that the trade dress features in question (decorations and other features to evoke a Mexican theme in a restaurant) were not functional. The trade dress in those cases did not bar competitors from copying functional product design features. In the instant case, beyond serving the purpose of informing consumers that the sign stands are made by MDI (assuming it does so), the dual-spring design provides a unique and useful mechanism to resist the force of the wind. Functionality having been established, whether MDI's dual-spring design has acquired secondary meaning need not be considered.

There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

Because the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say, by using a box or framework to cover them, as suggested by the Court of Appeals. The dual-spring design assures the user the device will work. If buyers are assured the product serves its purpose by seeing the operative mechanism that in itself serves an important market need. It would be at cross-purposes to those objectives, and something of a paradox, were we to require the manufacturer to conceal the very item the user seeks.

In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent. The inquiry into whether such features, asserted to be trade dress, are functional by reason of their inclusion in the claims of an expired utility patent could be aided by going beyond the claims and examining the patent and its prosecution history to see if the feature in question is shown as a useful part of the invention. No such claim is made here, however. MDI in essence seeks protection for the dual-spring design alone. The asserted trade dress consists simply of the dual-spring design, four legs, a base, an upright, and a sign. MDI has pointed to nothing arbitrary about the components of its device or the way they are assembled. The Lanham Act does not exist to reward manufacturers for their innovation

in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller. The Court of Appeals erred in viewing MDI as possessing the right to exclude competitors from using a design identical to MDI's and to require those competitors to adopt a different design simply to avoid copying it. MDI cannot gain the exclusive right to produce sign stands using the dual-spring design by asserting that consumers associate it with the look of the invention itself.

In re Florists' Transworld Delivery, Inc.

Florists' Transworld Delivery, Inc. appealed from the final refusal of the trademark examining attorney to register the proposed mark shown [in the margin] for "flowers and live cut floral arrangements." The specimen of use is reproduced [in the margin]. The description of the mark is:

The mark consists of the color black as applied to a substantial portion of the outside surface of a box which serves as a container or packaging for the goods and in part forms a background to design and literal elements applied thereto.

Section 2(e)(5) of the Trademark Act prohibits registration of a mark if it "comprises any matter that, as a whole, is functional." There are two forms of functionality, utilitarian functionality and aesthetic functionality. A feature that is not essential to the use or purpose of the article, or does not affect the cost or quality of the article – in other words, would not be considered as utilitarian functional – is still prohibited from registration if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage.

In *Brunswick Corp. v. British Seagull Ltd.*, the applicant sought to register the color black for outboard engines. In affirming the Board's finding that the color black is de jure functional for outboard motors, the Federal Circuit reasoned:

The color black does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose. Rather, the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller. With these advantages for potential customers, there is competitive need for engine manufacturers to use

106 U.S.P.Q.2d (TTAB 2013)



Proposed mark



Specimen of use

Brunswick Corp.: 35 F.3d 1527 (Fed. Cir. 1994)

black on outboard engines.

Kichler: 192 F.3d 1349 (Fed. Cir. 1999)

The Federal Circuit also focused on competitive need in *L.D. Kichler Co. v. Davoil, Inc.*. There, the Federal Circuit reversed a district court's cancellation on summary judgment of a registration for the "Olde Brick" finish of a lighting fixture backplate. The Federal Circuit found a genuine issue of material fact as to whether there was a competitive need for others to use the "Olde Brick" finish and remanded. In particular, the Court noted:

There is evidence that many customers prefer Olde Brick and other composite "rust-type" colors. It is not clear, however, that Olde Brick is one of a few colors that are uniquely superior for use in home decorating. Thus, the district court erred in granting summary judgment that Olde Brick was de jure functional.

In the present case, applicant seeks to register a single-color mark, black, for the outside of the box which serves as the container or packaging for its goods. We therefore determine factually whether registration of the color black for boxes for flowers and live cut floral arrangements serves a non-trademark purpose that would hinder the ability of others to effectively compete with the registrant.

The evidence in the record reflects that, indeed, in the floral industry, color has significance and communicates particular messages. It is commonly known that a dozen red roses are given as a message of love, particularly for Valentine's Day. [Numerous florist websites referred to the importance of the color of flowers in a bouquet and its packaging, e.g. red roses in a white box. Numerous websites also stated that black in connection with flowers connotes elegance or luxury.]

"The color is functional because it indicates the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc." *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197 (11th Cir. 2004). Is that right?

In addition, the evidence reflects that black has significance on somber occasions such as in the context of death. Office action at 8), states "Black has been ... often associated with death." Black is the traditional sign of mourning; it is common knowledge that black clothing is traditionally worn at funerals. Flowers and floral displays play an important role in the context of funerals and mourning; flowers are ubiquitous at funerals and it is also common knowledge that flowers are commonly presented as an expression of condolence. With regard to floral packaging, black is an appropriate color for floral packaging, and is used as floral packaging in bereavement bouquets

When we consider the evidence in the record, we find that the examining attorney has demonstrated prima facie that there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers. Competitors who, for example, want to offer flowers for bereavement purposes, Halloween

or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging. As the examining attorney stated, "competitors will need to use black packaging to convey an appropriate message or sentiment, whether that is elegance, style, festivity, grief or sympathy" and "allowing singular entities to control certain colors, in a field where color is both dynamic and has significance, would severely limit the availability of appropriate color choices to consumers seeking particular floral arrangement gifts."

Maker's Mark Distillery, Inc. v. Diageo North America, Inc.

Plaintiff Maker's Mark is a Kentucky-based distiller specializing in bourbon whisky. Since 1958, when it first began producing bourbon, the company has capped its bottles with a red dripping wax seal that partially covers the neck of the bottle and drips down to the bottle's shoulder. Since 1985, Maker's Mark has held a federally registered trademark, U.S. Trademark Reg. No. 1,370,465, consisting of the "wax-like coating covering the cap of the bottle and trickling down the neck of the bottle in a freeform irregular pattern." Notably, the trademark does not mention the color red – it is silent as to color. [During the course of litigation, Maker's Mark narrowed its argument to assert protection only for a red dripping wax seal.]

The facts giving rise to this case began in the mid-1990s, when [Jose] Cuervo executives decided to create a high-end tequila to celebrate the company's 200th anniversary of producing tequila products legally. They designed the new product, Reserva de la Familia, in conjunction with a U.S. marketing firm and production began in 1995. Initially, the Reserva bottle design included a straight-edge, non-dripping wax seal capping the bottle, along with a stamp of the Cuervo crest imprinted into the wax and a small blue ribbon extending from underneath the wax.

Juan Domingo Beckmann, now Chief Executive Officer of Casa Cuervo, testified that sometime around 1997, he decided to alter the wax seal to include dripping wax after seeing such a bottle in mid-production, before its drips were cut off. Beckmann thought the uncut seal, with its drips, created a unique and artisanal look. By 2001, Reserva, with its red dripping wax seal, had entered the U.S. market. Packaged in a wooden box designed each year by a different Mexican artist, it retailed for about \$100 per bottle.

Defendants argue the red dripping wax seal is functional because it protects a cork from air, moisture and contaminants, thus preserving the contents of the bottle on some bottles of alcohol. They further argue that drips are a natural byproduct of such a coating, and are costly to remove. In the Court's view, Cuervo completely failed to show that wax seals are functional. Not only did Cuervo fall short of

703 F. Supp. 2d 671 (W.D. Ky. 2010),
aff'd, 679 F.3d 41 (6th Cir. 2012)



Maker's Mark



Cuervo Reserva

proving that the wax seal on the Reserva bottle was functional, it also did not prove that *any* current wax seal users employ the method for a functional purpose. For example, Cuervo's production manager, Alfredo Guerrero, acknowledged that the company seals other Cuervo products with plastic caps or shrink wrap, and that some of those methods are less expensive than creating a wax seal.

Even assuming that the Sixth Circuit would apply the aesthetic functionality doctrine, the Court finds the case for its application here is unpersuasive. None of Cuervo's witnesses convinced the Court that it would be difficult or costly for competitors to design around the red dripping wax trademark. Furthermore, red wax is not the only pleasing color of wax that competitors may employ on their product, nor does it put competitors at a significant non-reputation related disadvantage to be prevented from using red dripping wax. There are other ways of making a bottle look artisanal or unique. Therefore, the doctrine of aesthetic functionality is inapplicable here.

Eames Chair Problem, Revisited

Look again at the Eames Lounge Chair. Is its design protectable trade dress?

Pez Dispenser Problem

Make yourself familiar, if you are not already, with PEZ dispensers. To what extent can Patrafico AG (the PEZ corporate parent) obtain trademark or trade dress protection in the appearance of PEZ dispensers? Can it trademark the spring-loaded flip-top design? The number of candies in a pack? The fluted front and footed base of a dispenser? Does it matter what heads the PEZ dispensers have? Against what products and uses will these rights be effective?

D Design Patent

Design patent law has, until recently, been one of the most academically neglected fields of intellectual property law. The immense importance of design patents in smartphone litigation, however, has thrust them on the public stage again. As you read this section, pay close attention to how they deal with the limits on protections for functional matter hard-wired into copyright and trademark. There is a functionality test for design patents, but it is far more forgiving.

Design patents are an interesting hybrid of IP concepts we have seen elsewhere. They borrow their basic structure from utility patent law: a designer obtains exclusive rights to a design by filing an application that is examined under the same substantive and procedural rules as a utility patent application would be. But the subject mat-

There are no canonical design patent treatises. Chisum's patent-law treatise has a chapter on design patents, and Matthew A. Smith has a draft treatise available online.

ter that is actually protected, and the infringement test used to measure similarity, looks much more like copyright. There are even hints of trademark-law confusion concepts in the historical infringement tests for design patents, although recent cases insist that whether consumers are confused is (mostly) not the right question to ask.

Patent Act

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 171
Patents for designs

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Patents for designs shall be granted for the term of fourteen years from the date of grant.

35 U.S.C. § 173
Term of design patent

United States Patent [19]

Giugiaro

[11] **Patent Number: Des. 283,882**

[45] **Date of Patent: ** May 20, 1986**

[54] **AUTOMOBILE**

[75] **Inventor: Giorgetto Giugiaro, Turin, Italy**

[73] **Assignee: Delorean Motor Company**

[**] **Term: 14 Years**

[21] **Appl. No.: 273,091**

[22] **Filed: Jun. 12, 1981**

[52] **U.S. Cl. D12/91**

[58] **Field of Search D12/91, 92; 296/185**

[56] **References Cited
PUBLICATIONS**

Road & Track, 3/73, p. 50, Lamborghini P250 Uracco, top right side of page.

Primary Examiner—James M. Gandy
Attorney, Agent, or Firm—David A. Maxon

[57] **CLAIM**

The ornamental design for an automobile, as shown and described.

DESCRIPTION

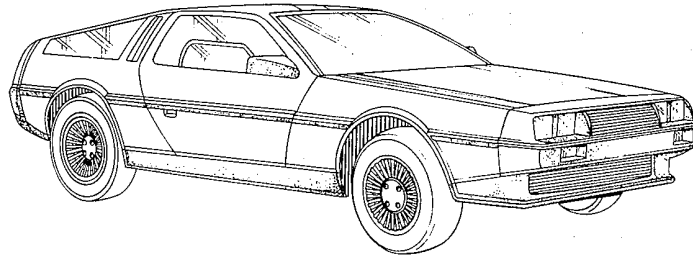
FIG. 1 is a front perspective view of an automobile showing my new design;

FIG. 2 is a rear perspective view thereof;

FIG. 3 is a front elevational view thereof; and

FIG. 4 is a rear elevational view thereof.

The side opposite to that shown in FIGS. 1 and 2 of the drawing is substantially a mirror image thereof.



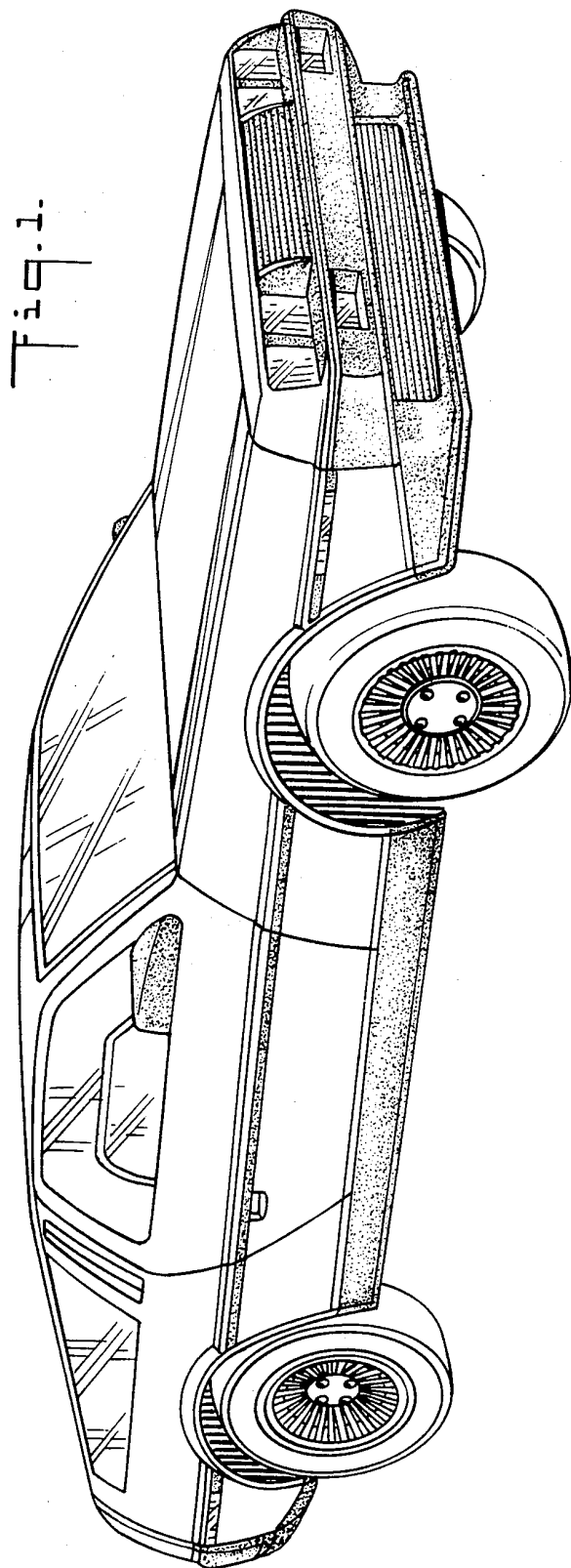


Fig. 2.

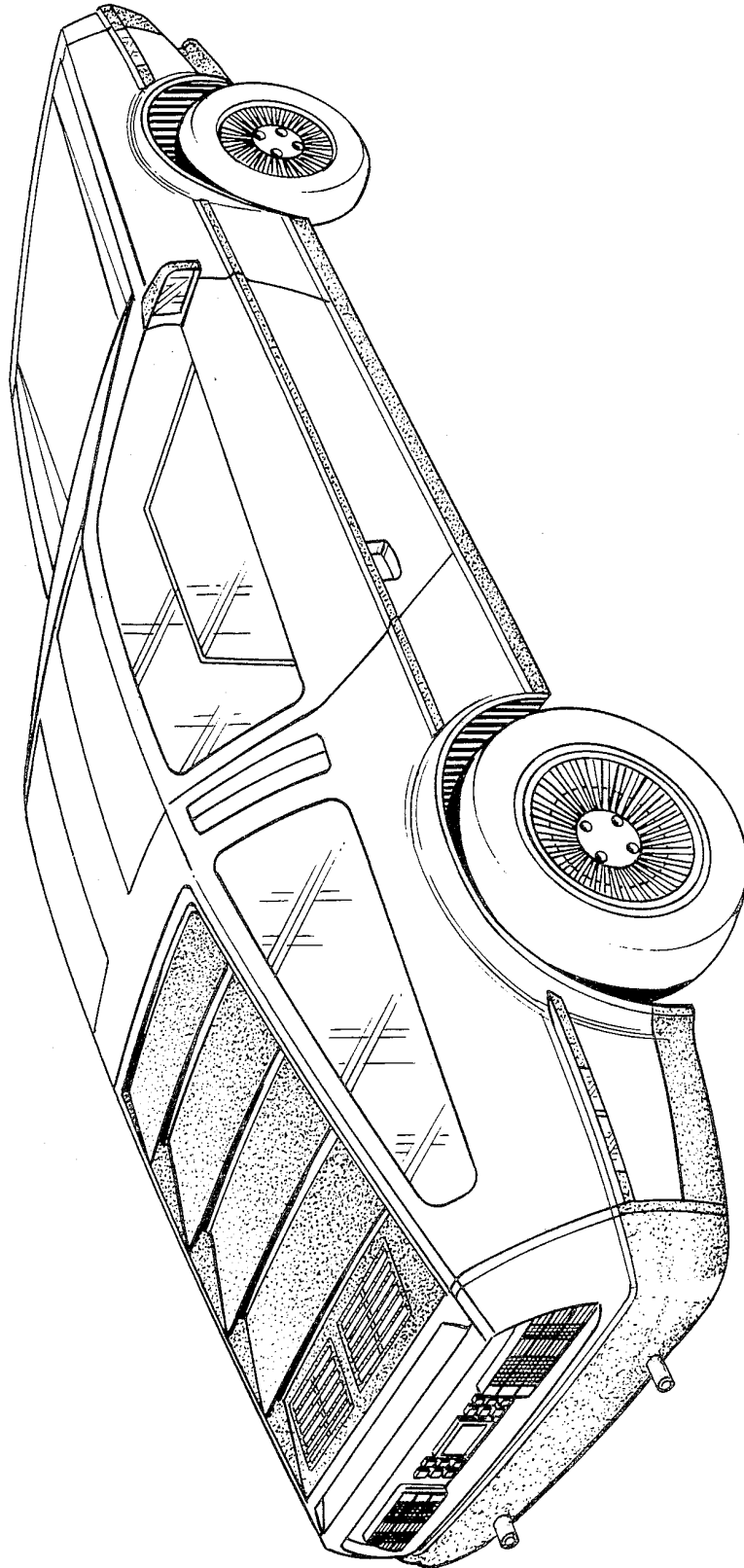


Fig. 3

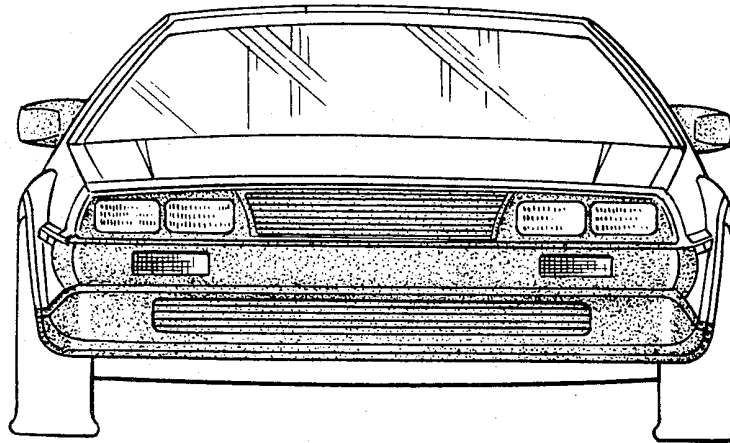
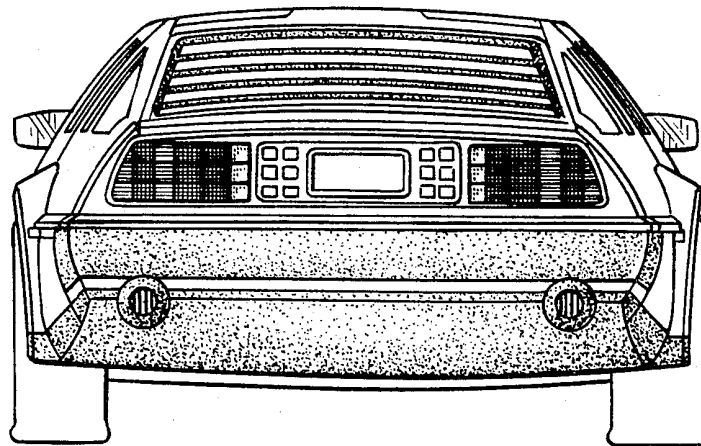


Fig. 4.



1 Subject Matter

Section 171 provides two subject matter threshold conditions: a design patent can apply only to a design for "an article of manufacture" and the design must be "ornamental."

a Articles of Manufacture

In re Hruby

These appeals are from split decisions of the Patent Office Board of Appeals wherein the majority affirmed the rejection of appellant's claims in four design patent applications. The single claim in each application reads:

The ornamental design for a water fountain as shown and described.

The sole rejection was that the claim in each case does not define an article of manufacture. The precise question before us, therefore, is whether that portion of a water fountain which is composed entirely of water in motion is within the statutory term "article of manufacture."

The board said, "we appreciate that the forms created in water by fountains are a well recognized and much used decorative device" and that it "is evident as urged by appellant that the shape created in a specific fountain is manufactured by man in the sense that water as a raw material is put into planned patterns of motion for accomplishment of a decorative purpose." The majority further expressed disagreement with the examiner's objection that the water of which the designs are produced is a "natural" product, and wisely so as that argument would apply to every article made of wood or stone. Nor did it think much of the argument that the water droplets constantly changed position. Nevertheless the board majority concluded that the water display itself is not "an article of manufacture." The only reasons we can perceive for this conclusion in the board's opinion are that "the pattern created is wholly a fleeting product of nozzle arrangements and control of operating pressure or pressures" and that "the pattern exists only as a product or 'effect' of the mechanical organization during its continued operation."

The dissenting member of the board soundly answered the "fleeting" argument as follows:

Although appellant did not disclose the particular means for producing the fountain effect, it is recognized that if certain parameters such as orifice configuration, water pressure and freedom from disturbing atmospheric conditions are maintained, the ornamental shape of the foun-

373 F.2d 997 (CCPA 1967)
(Rich, J.)

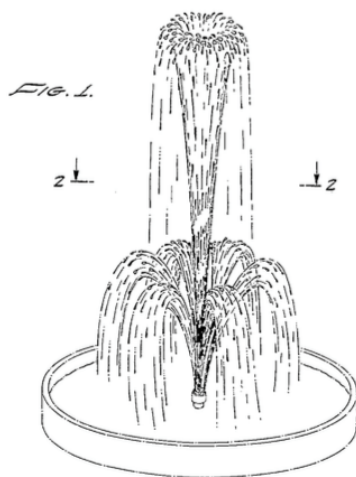


Figure 1 from Hruby's application

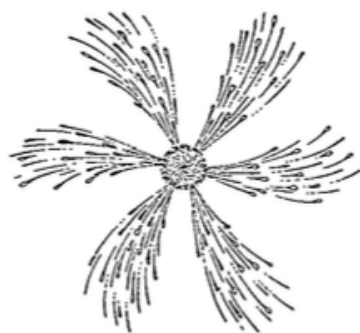


Figure 2 from Hruby's application

tain will remain substantially constant and will at such times present an over-all appearance virtually the same from day to day.

We agree with the dissenter on that and would add that the permanence of any design is a function of the materials in which it is embodied and the effects of the environment thereon. Considering the fact that the Romans and the French built now famous fountains hundreds of years ago which still produce the same water designs today, the notion that a fountain is "fleeting" is not one which will "hold water."

The dissenting member continued:

It is true that a particular droplet or droplets may be "a fleeting product" but the fountain itself is not. The fountain in its entirety under proper conditions presents a product of constant appearance rather than a fleeting product. I assume that the majority would find no objection if a design effect would be produced in the form of frozen water. Is it logical or reasonable to find objection to a related design effect also having a constant appearance merely because of continuous movement of water droplets? I am unable to find any logical or legal basis for such a distinction. It must be remembered that in a design it is the over-all appearance due to the form or shape of the product that is determinative of patentability and not the minutia of the details that form the design.

Again we agree. The physicists and philosophers teach us that what we think we see is not really there at all; that the very concept of "solid" is something of an illusion and objects are mostly empty space, "substance" consisting of nuclei with electrons orbiting about them. In common parlance, however, what we see here are fountains, not droplets of water moving in space, any more than we see nuclei and electrons or atoms or molecules in solid objects.

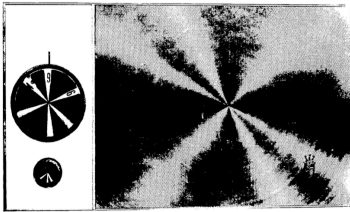
Fountains are what appellant (or someone connected with him) sells. At oral argument, counsel presented us with a stereoscopic film-slide card, a sales device showing fountains like those here involved in three-dimensional pictures as offered for sale. There is no doubt in our minds that prospective buyers of these fountains would select them for the decoration of buildings or grounds according to specific, reproducible³ designs, intending to us them as permanent decoration.

³We use the term "reproducible" in the practical sense of making another thing which has the same appearance to the average viewer. The examiner was concerned about the obvious fact that "the exact arrangement and configuration of droplets" could not be reproduced by a person skilled in the art. We do not

The fountains are certainly made by man (manufactured) for sale to and use by such buyers. They certainly carry into effect the plain intent of the design patent statute, which is to give encouragement to the decorative arts.

The brief for the Patent Office makes but a single argument in support of the contention the fountains *should* not be considered to be "an article of manufacture." It is, as the examiner contended, that water sprays "cannot exist of themselves," being dependent on the existence of the nozzles and the water under pressure. Only because of this dependence are we asked to affirm the rejection.

We fail to see any force in this argument. It is not denied that designs exist. It is perfectly clear that these designs are of the three-dimensional or configuration-of-goods type. The "goods" in this instance are fountains, so they are made of the only substance fountains can be made of – water. We see no necessary relation between the dependence of these designs made of water upon the means for producing them and their being articles of manufacture. A majority of this court recently held patentable a grille for a radio cabinet with a circularly brushed appearance which also had evenly-spaced small perforations. The peculiarity of this grille was that "with variations in viewing angle and ambient lighting" (emphasis added) a varying moiré effect was produced and the majority felt that this effect made the ornamental appearance unobvious and patentable. The design was thus dependent, insofar as the feature which made it patentable was concerned, on something outside itself, it did not exist alone, because without the proper angles of ambient lighting and viewing there was no moiré effect. *In re Boldt* We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design "for an article of manufacture." Many such designs depend upon outside factors for the production of the appearance which the beholder observes. The design of a lampshade may not be apparent unless the lamp is lighted. The design of a woman's hosiery is not apparent unless it is in place on her legs. The designs of inflated articles such as toy balloons, water toys, air mattresses, and now even buildings are not apparent in the absence of the compressed air which gives them form, as the water pressure



Boldt's radio cabinet. Unfortunately, the same moiré effect remarked on by the court also makes the image in Boldt's filing hard to copy or scan faithfully.

Boldt: 344 F.2d 990 (1965)

think this important. The same problem exists to some degree with most everything made of such variable materials as wood, cloth, clay and many others which minutely vary from piece to piece. What matters with an ornamental design is only the ultimate over-all appearance of the article which embodies it. Technically, "exact" reproduction is an impossibility. It is always an approximation. We see no reason why design law – law being one of the greatest approximations of all – should be any more concerned with the "exact arrangement" of water droplets than it is with the exact arrangement of molecules, grains of sand, or even grosser building blocks so long as the general appearance is not affected.

here gives shape to the fountain. Even the design of wall paper is not always fully apparent in the commodity as it is sold and requires a wall and the services of a paperhanger to put it into condition for enjoyment by the beholder, which is the ultimate purpose of all ornamental design.

Worley, Chief Judge, dissenting:

It is inconceivable that Congress could possibly have intended Sec. 171, in letter or spirit, to allow an individual to remove from the public domain and monopolize mere sprays of water. To do so, one must necessarily rely on strained semantics at the expense of common sense. The instant sprays, so evanescent and fugitive in nature, presumably subject to the whims of wind and weather, incapable of existing in and of themselves, are merely the effect flowing from articles of manufacture, but certainly are no more articles of manufacture per se than are the vapor trails of jets, wakes of ships or steam from engines.

It appears that appellant presently enjoys patent protection on the mechanical elements of the fountains, but apparently not satisfied with that, now seeks to monopolize certain configurations of moving water, whether produced by a garden hose or otherwise. It is not difficult to imagine the potential harassment that could result from such a monopoly.

In re AlSabah

AlSabah seeks a design patent on, “The ornamental design for a Teaching Aid for Teaching Arabic as shown and described.” AlSabah’s design is a table of synopsisized Arabic letters divided into numbered groups and arranged in eleven rows and two columns.

The Board properly found that AlSabah’s design is directed to nonstatutory subject matter as provided under 35 U.S.C. § 171 because the design is not embodied in or applied to an article of manufacture. Specifically, AlSabah seeks a design patent on a design for a teaching aid, where the design is a table of information (synopsisized Arabic letters divided into groups arranged in an eleven rows and two columns). AlSabah’s design can theoretically be applied to a variety of articles, from poster boards to coffee mugs, but has not yet been applied to any article. In other words, AlSabah seeks to improperly patent an abstract design.

A design patent may be obtained for a “new, original and ornamental design for an article of manufacture.” An article of manufacture is a tangible man-made object. For example, a computer-generated icon shown on a computer screen is a patentable design on an article of manufacture. The icon itself is not patentable, but when claimed as an icon embodied on a computer screen, monitor,

No. 2015-1264 (Fed. Cir. 2015)

The examiner rejected AlSabah’s application, and the PTAB affirmed. This is the brief for the USPTO in AlSabah’s appeal to the Federal Circuit, which affirmed the PTAB without opinion. 621 Fed. Appx. 659, 2015 WL 6080577 (Fed. Cir. 2015).

Group	Lateefa Groups
1 st	أ
2 nd	ب ت ث د هـ ز
3 rd	ح حـ خ
4 th	د ذ
5 th	ر ز
6 th	س ش
7 th	ص ض ط ظ
8 th	ع غ ف ق
9 th	ك
10 th	ل م ن هـ ة و ي

AlSabah’s design

or other display panel, the combination of the icon and the display panel (or portion thereof) is patentable as a design.

The phrase “design for an article of manufacture” encompasses three categories of designs: (1) a design for an ornament, impression, print or picture to be applied to an article of manufacture (surface ornamentation); (2) a design for the shape or configuration of an article of manufacture; and (3) a combination of the first two categories. *In re Schnell* With respect to the sort of surface ornamentation at issue in this appeal, this Court’s predecessor, the United States Court of Customs and Patent Appeals held that section 171 requires that “design must be shown not to be the mere invention of a picture, irrespective of its manner of use, but that the applicant should be required to show by an appropriate drawing the manner of its application.” The court went on to state that “it is the application of the design to an article of manufacture that Congress wishes to promote, and an applicant has not reduced his invention to practice and has been of little help to the art if he does not teach the manner of applying his design.”

Schnell: 46 F.2d 203 (CCPA 1931)

The title of AlSabah’s application and claim generically describe the claimed design as being “for a Teaching Aid for Teaching Arabic.” The drawing in AlSabah’s application fails to identify an article of manufacture to which the claimed design must be affixed. Rather, the drawing simply shows synopsised Arabic letters in an eleven row by two column table and nothing more – i.e., a mere abstract design.

AlSabah argues that her application is in “full compliance” with section 171 because teaching aids and tables are articles of manufacture. While a design for a teaching aid is patentable subject matter, the problem for AlSabah is that her so-called design is the teaching aid. And, although AlSabah’s design can be applied to an unlimited number of articles of manufacture, there is no way for a person looking at AlSabah’s claim and drawing to discern whether the claimed design is applied, for example, to a paper handout, a computer icon, or even a coffee mug. Without application to a defined article of manufacture, AlSabah’s design is nothing more than an abstract idea.

AlSabah erroneously argues that her design is “applied to or embodied in an article of manufacture” because “the design is printed on a piece of white paper, and a piece of white paper is an article of manufacture.” More specifically, AlSabah argues that her design is “applied to or embodied” in paper because her design patent application was printed on paper and submitted to the USPTO for examination in paper form. According to AlSabah, an applicant can put any printed material in a design patent application, submit it to the USPTO, and because the application is transmitted to the Office on paper the application should not get rejected for not claiming a design for an article of manufacture. Following AlSabah’s logic, all such proposed design patents would be embodied in paper just because they

were submitted to the USPTO for examination. But that makes little sense, what matters is the context of the application itself. AlSabah's design is not depicted as being a table on paper nor is it described as being on paper in her application.

If AlSabah wanted to claim the design in Figure 1 as applied to paper, AlSabah could have done so using broken or dotted lines to represent the paper. But AlSabah's Figure 1 "as shown and described" does not depict any article of manufacture, let alone paper. For all these reasons, AlSabah's arguments regarding paper are inapt.

b Ornamentality

In re Webb

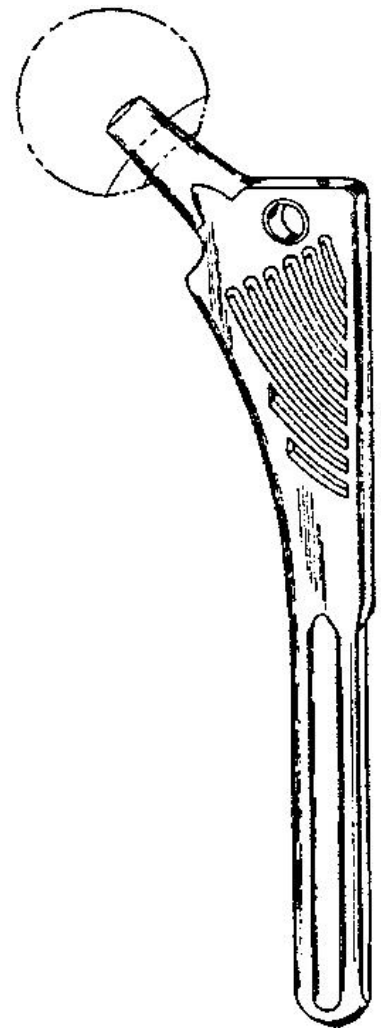
This is an appeal from a decision of the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences affirming the final rejection of the sole claim of appellants' U.S. Design Patent Application Serial No. 833,470. The Board affirmed the Examiner's holding that the design, "clearly not intended to be visible in actual use," "is not proper subject matter under 35 U.S.C. § 171." The Board's decision creates a per se rule that a design for an article which will not be visible in the final use for which the article was created is non-statutory subject matter even if the design is observed at some stage of the article's commercial life. We reverse and remand.

Hip stem prostheses of the design invented by Webb are metallic implants that are generally used by orthopedic surgeons to supplant the functioning of a diseased or broken femur, near the hip, where the femur is joined to the pelvis. According to Webb, and not disputed by the Patent and Trademark Office ("PTO"), surgeons are made aware of differing brands and types of prostheses through advertisements in professional journals and through trade shows, where the prostheses themselves are displayed. Advertisements that were put in the record prominently and visually display the features of the prostheses. Furthermore, the applicant's agent submitted that "an implant's appearance is observed by potential and actual purchasers, surgeons, nurses, operating room staff, and other hospital personnel." After purchase, the prosthesis is surgically implanted into a patient's body where the implant is to remain indefinitely. Neither party disputes that, after implantation, the prosthesis is no longer visible to the naked eye.

In the Final Office Action, the Examiner stated:

There is not sound reason or logic for "normal use" to include the repair, service, replacement, sale or display of the article which incorporates the claimed design. While such occasions are of course "normal" in the sense of com-

916 F.2d 1553 (Fed. Cir. 1990)



Webb's '470 design

monplace or routine occasions of an item's use, for patent purposes "normal use" should be limited to the ordinary functioning for which it was designed, not incidents in the article's life which are not integral to its function or purpose. Items are not designed for sale, display, replacement or repair.

The issuance of design patents is limited by statute to designs that are ornamental. Our predecessor court has affirmed the rejection of design applications that cannot be perceived in their normal and intended uses. For instance, the Court of Customs and Patent Appeals affirmed the rejection of a design claim for a vent tube placed in the wall of a frame house, stating that "it is well-settled that patentability of a design cannot be based on elements which are concealed in the normal use of the device to which the design is applied." *In re Cornwall*. Even earlier, that court affirmed the rejection of a design claim for a vacuum cleaner brush. *In re Stevens*. There the court noted:

Cornwall: 230 F.2d 457 (CCPA 1956)

Stevens: 173 F.2d 1015, (CCPA 1949)

Articles which are concealed or obscure are not proper subjects for design patents, since their appearance cannot be a matter of concern. Almost every article is visible when it is made and while it is being applied to the position in which it is to be used. Those special circumstances, however, do not justify the granting of a design patent on an article such as here under consideration which is always concealed in its normal and intended use.

We read those cases to establish a reasonable general rule that presumes the absence of ornamentality when an article may not be observed. This is a sound rule of thumb, but it is not dispositive. In each case, the inquiry must extend to whether at some point in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a "matter of concern."

Here, we read the Board's decision to have established a per se rule under § 171 that if an article is hidden from the human eye when it arrives at the final use of its functional life, a design upon that article cannot be ornamental. The rule in *Stevens* does not compel the Board's decision. Instead, *Stevens* instructs us to decide whether the "article such as here under consideration" – a hip stem implant – "is always concealed in its normal and intended use." The issue before us, then, is whether "normal and intended use" of these prosthetic devices is confined to their final use.

Although we agree that "normal and intended use" excludes the time during which the article is manufactured or assembled, it does not follow that evidence that an article is visible at other times is legally irrelevant to ascertaining whether the article is ornamental for

purposes of § 171. Contrary to the reasoning of the Examiner in this case, articles are designed for sale and display, and such occasions are normal uses of an article for purposes of § 171. The likelihood that articles would be observed during occasions of display or sale could have a substantial influence on the design or ornamentality of the article.

In short, we construe the “normal and intended use” of an article to be a period in the article’s life, beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article. Although the period includes all commercial uses of the article prior to its ultimate destination, only the facts of specific cases will establish whether during that period the article’s design can be observed in such a manner as to demonstrate its ornamentality.

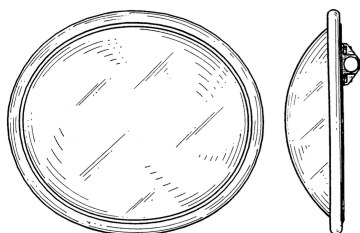
It is possible, as in *Stevens*, that although an article may be sold as a replacement item, its appearance might not be of any concern to the purchaser during the process of sale. Indeed, many replacement items, including vacuum cleaner brushes, are sold by replacement or order number, or they are noticed during sale only to assess functionality. In such circumstances, the PTO may properly conclude that an application provides no evidence that there is a period in the commercial life of a particular design when its ornamentality may be a matter of concern. However, in other cases, the applicant may be able to prove to the PTO that the article’s design is a “matter of concern” because of the nature of its visibility at some point between its manufacture or assembly and its ultimate use. Many commercial items, such as colorful and representational vitamin tablets, or caskets, have designs clearly intended to be noticed during the process of sale and equally clearly intended to be completely hidden from view in the final use. Here, for example, there was ample evidence that the features of the device were displayed in advertisements and in displays at trade shows. That evidence was disregarded by the Board because, in its view, doctors should select implants solely for their functional characteristics, not their design. It is not the task of the Board to make such presumptions.

Rosco, Inc. v. Mirror Lite Co.

Rosco, Inc. (“Rosco”) appeals the decision of the United States District Court for the Eastern District of New York finding Rosco’s design patent, United States Design Patent No. 346,357 (“the ‘357 patent”), invalid as functional.

Rosco and Mirror Lite are competitors in the school bus mirror market. This dispute involves “cross-view” mirrors, which are convex, three-dimensional, curved surface mirrors mounted on the front fender of a school bus, enabling the bus driver to view the front and

304 F.3d 1373 (Fed. Cir. 2002)



Rosco's '357 design

passenger side of a school bus. Rosco's '357 design patent shows a highly convex, curved-surface, three-dimensional oval mirror with a black, flat metal backing. In May 1992, Rosco began manufacturing the mirror of the '357 patent under the name "Eagle Eye." Rosco alleged that Mirror Lite infringed the '357 patent by manufacturing and selling a duplicate of Rosco's mirror under the name "Hawk Eye."

We apply a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where the appearance of the claimed design is dictated by the use or purpose of the article. [For a design patent to be valid,] the design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function. When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. That is, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.

The district court found that because the mirror's oval shape, the asserted point of novelty of the '357 patent, "of necessity dictates its function," the '357 patent was invalid as functional. The court based its determination of functionality on its findings that the mirror of the '357 patent offered a unique field of view (when compared to Mirror Lite's Bus Boy mirror); that Rosco represented to the Patent and Trademark Office that its mirror provided a superb field of view; and that Rosco marketed the mirror of the '357 patent as more "aerodynamic" than other cross-view mirrors.

The mere fact that the invention claimed in the design patent exhibited a superior field of view over a single predecessor mirror (here, the Bus Boy) does not establish that the design was "dictated by" functional considerations, as required by *L.A. Gear*. The record indeed reflects that other mirrors that have non-oval shapes also offer that particular field of view. Similarly, nothing in the record connects the oval shape of the patented design with aerodynamics, and the record shows that other non-oval shaped mirrors have the same aerodynamic effect.

Mirror Lite has not shown by clear and convincing evidence that there are no designs, other than the one shown in Rosco's '357 patent, that have the same functional capabilities as Rosco's oval mirror. Under these circumstances it cannot be said that the claimed design of the '357 patent was dictated by functional considerations.

In re Koehring

This appeal from the decision of the Commissioner of Patents, refusing a patent for a design for a concrete mixer truck body and frame, presents as its main issue the very interesting, and oftimes trouble-

some, question as to what articles of manufacture may constitute the subject-matter of design patents. Before us the Commissioner urges that it must be held, under *In re Stimpson* that this character of machine is not "inventively ornamental." The riveting machine in controversy in *Stimpson* was held not to be ornamental, because the drawing showed that it was

purely utilitarian, and without ornamentation of any kind. There is nothing about the assembled mechanical device which serves to beautify, embellish, or adorn it. The several parts of the mechanism, whether circular, curved, rounded, or spiral, are assembled into an entirety which is lacking in symmetry, wanting in grace, and destitute of any appeal to the senses or emotions. The design has no human interest, other than that aroused by the utilitarian nature of the machine.

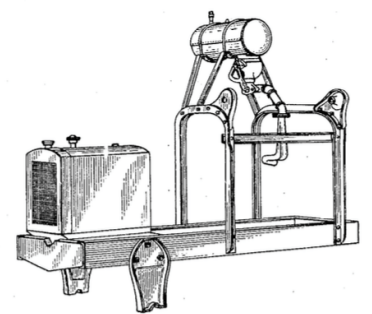
In our view of the case, the beauty and ornamentation requisite in design patents is not confined to such as may be found in the "aesthetic or fine arts." It is not reasonable to presume that Congress, in basing a patent right upon the ornamentation or beauty of a tool or mechanical device, intended that such beauty and ornamentation should be limited to such as is found in paintings, sculpture, and artistic objects, and which excites the aesthetic sense of artists alone.

By the enactment of the design patent law, Congress expressed a desire to promote more beauty, grace, and ornamentation in things used, observed, and enjoyed by our people. Appellant's design of a truck body and frame for a concrete mixer shows the frame to be so designed as to place the different elements of the whole machine, including the hood, gas tank, mixer, etc., into a more symmetrical and compact whole than was known in the prior art. Aside from this arrangement, which removes much of the unsightliness from the machine, the covering of the motor is made to resemble, in appearance, an automobile hood, and the angular bars and framework of the same are given a rounded or oval appearance. By the plan of assembly of the more or less rounded hood, round gas tank, and rounded frame corners into a compact and more symmetrical whole, an article, possessing more grace and pleasing appearance than existed in the prior art, has been produced. This effect in the design as a whole is ornamental and inventive.

Since it is clear that Congress meant the design patent law to apply to tools and mechanisms of utilitarian character, it follows, we think, that it had in mind the elimination of much of the unsightly repulsiveness that characterizes many machines and mechanical devices which have a tendency to depress rather than excite the esthetic sense. In this mechanical age, when machines, engines, and various

Stimpson: 24 F.2d 1012 (D.C. Ct. App.)

"Design applications which disclose subject matter which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions, should be rejected as nonstatutory subject matter." MPEP § 1504.01(e).



Koehring's design

kinds of mechanisms are transported on our public highways and streets and moved by their own momentum from place to place, it is certainly not undesirable that some of the unsightliness – and, as frequently occurs, frightfulness – of such contrivances be eliminated, if possible.

2 Procedures

Most of the mechanics of obtaining a design patent are the same as for a utility patent. The principal difference is that designs are claimed by illustration rather than in words. This creates some distinctive drafting issues. Design patents also have a shorter term. (In addition, design patent prosecution is procedurally simpler in several ways not here relevant.)

Manual of Patent Examining Procedure

MPEP § 1503
Elements of a Design Patent Application Filed Under 35 U.S.C. ch. 16

A preamble, if included, should state the name of the applicant, the title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

No description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its own best description. However, while not required, such a description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper. Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.

The following types of statements are not permissible in the specification:

- (1) A disclaimer statement directed to any portion of the claimed design that is shown in solid lines in the drawings.
- (2) Statements which describe or suggest other embodiments of the claimed design which are not illustrated in the drawing disclosure, except one that is a mirror image of that shown or has a shape and appearance that would be evident from the one shown.
- (3) Statements describing matters that are directed to function or are unrelated to the design.

A design patent application may only include a single claim. The single claim should normally be in formal terms to “The ornamental design for (the article which embodies the design or to which it is

applied) as shown.” The description of the article in the claim should be consistent in terminology with the title of the invention.

When the specification includes a proper descriptive statement of the design, or a proper showing of modified forms of the design or other descriptive matter has been included in the specification, the words “and described” must be added to the claim following the term “shown”; i.e., the claim must read “The ornamental design for (the article which embodies the design or to which it is applied) as shown and described.”

Full lines in the drawing show the claimed design. Broken lines are used for numerous purposes. Under some circumstances, broken lines are used to illustrate the claimed design (i.e., stitching and fold lines). Broken lines are not permitted for the purpose of identifying portions of the claimed design which are immaterial or unimportant. There are “no portions of a design which are “immaterial” or “not important.” A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.

Every design patent application must include either a drawing or a photograph of the claimed design. As the drawing or photograph constitutes the entire visual disclosure of the claim, it is of utmost importance that the drawing or photograph be clear and complete, and that nothing regarding the design sought to be patented is left to conjecture.

When inconsistencies are found among the views, the examiner should object to the drawings and request that the views be made consistent. When the inconsistencies are of such magnitude that the overall appearance of the design is unclear, the claim should be rejected under 35 U.S.C. 112(a) and (b) as nonenabling and indefinite.

The drawings or photographs should contain a sufficient number of views to disclose the complete appearance of the design claimed, which may include the front, rear, top, bottom and sides. Perspective views are suggested and may be submitted to clearly show the appearance of three dimensional designs.

Views that are merely duplicative of other views of the design or that are flat and include no surface ornamentation may be omitted from the drawing if the specification makes this explicitly clear. For example, if the left and right sides of a design are identical or a mirror image, a view should be provided of one side and a statement made in the drawing description that the other side is identical or a mirror image. If the design has a flat bottom, a view of the bottom may be omitted if the specification includes a statement that the bottom is flat and devoid of surface ornamentation.

Sectional views presented solely for the purpose of showing the internal construction or functional/ mechanical features are unneces-

Are enablement and definiteness the same for design patents?

sary and may lead to confusion as to the scope of the claimed design. The examiner should object to such views and require their cancellation.. However, where the exact contour or configuration of the exterior surface of a claimed design is not apparent from the views of the drawing, and no attempt is made to illustrate features of internal construction, a sectional view may be included to clarify the shape of said design.

While surface shading is not required, it may be necessary in particular cases to shade the figures to show clearly the character and contour of all surfaces of any 3-dimensional aspects of the design. Surface shading is also necessary to distinguish between any open and solid areas of the article. Lack of appropriate surface shading in the drawing as filed may render the design nonenabling and indefinite under 35 U.S.C. 112(a) and (b). Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror. Contrast in materials may be shown by using line shading in one area and stippling in another. By using this technique, the claim will broadly cover contrasting surfaces unlimited by colors.

The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. 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. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design. Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof. A boundary line may be shown in broken lines if it is not intended to form part of the claimed design.

Patent Act

35 U.S.C. § 173
Term of design patent

Patents for designs shall be granted for the term of 15 years from the date of grant.

3 Ownership

Skip this section. Not forever, just for a bit. Read the following section on the similarity analysis in design patent infringement. Then come back. Don't worry. This section will still be here, and it will make much more sense.

Inventorship for design patents is much the same as for utility

patents and initial ownership. Design patents pose more difficult questions when it comes to the tests for anticipation under § 102 and for nonobviousness under § 103. The difficulty flows from the fact that design patents use depictions rather than verbal claims, so that the claim-based tests used for utility patents simply map cleanly onto design patents.

a Novelty

For the most part, the are the rules for priority and for what counts as prior art are the same for design patents and utility patents. The test for experimental use is a little different because what counts as necessary experimentation is different for ornamentation than for function. In *In re Mann*, for example, the applicant exhibited a wrought-iron table embodying the design at a trade show, but argued that it was an "experimental use." The court disagreed, writing, "Obtaining the reactions of people to a design – whether or not they like it – is not 'experimentation' in that sense. In the case of a design, if market testing shows that it has no appeal and the design is changed, the result is a new and different design; the original design remains just what it was." It is the test for anticipation that requires modification.

Mann: 861 F.2d 1581 (Fed. Cir. 1988)
(Rich, J.)

International Seaway Trading Corp. v. Walgreens Corp.

Plaintiff International Seaway filed suit against Walgreens Corporation and Touchsport Footwear claiming infringement of Seaway's patents, U.S. Design Patents Nos. **D529,263**, **D545,032**, and **D545,033**. The district court granted summary judgment for defendants, finding that the claims of the asserted patents were invalid under 35 U.S.C. § 102 as anticipated by a patent assigned to Crocs, Inc., U.S. Design Patent No. **D517,789**.

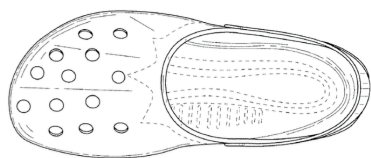
589 F.3d 1233 (Fed. Cir. 2009)

Seaway's patents claim designs for casual, lightweight footwear, which are typically referred to as "clogs." Seaway asserted that Touchsport had imported and continued to import shoes that infringed the Seaway patents and that Walgreens had sold and continued to sell the allegedly infringing shoes. The district court granted summary judgment of anticipation, finding that the three Seaway patents were anticipated by the Crocs '789 patent.

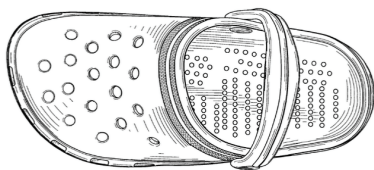
It has been well established for over a century that the same test must be used for both infringement and anticipation. His general rule derives from the Supreme Court's proclamation 120 years ago in the context of utility patents: "that which infringes, if later, would anticipate, if earlier." *Peters v. Active Mfg. Co.* The same rule applies for design patents. In *Egyptian Goddess*, we abandoned the point of novelty test for design patent infringement and held that the ordinary observer test should serve as the sole test for design patent infringe-

Peters: 129 U.S. 530 (1889)

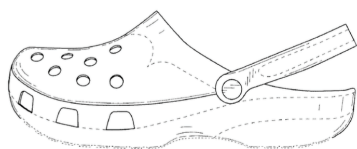
The test for anticipation of a utility patent is the mirror image of the *literal* infringement test. But the design patent infringement test bears more than a passing resemblance to the doctrine of equivalents in utility patents. What does this do to the symmetry argument? Should anticipation in design patents be confined to identical designs? Or is it all irrelevant, since obviousness under § 103 will take care of such cases?



'789 insole



'263 insole



'789 side view

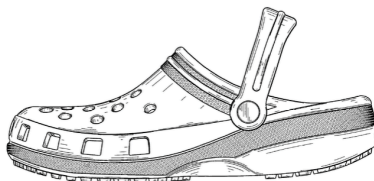


Fig. 2

'263 side view

ment. we now conclude that the ordinary observer test must logically be the sole test for anticipation as well.

Walgreens and Touchsport argue that the asserted differences between the insoles of the patents-in-suit and the prior art "were at most slight variations of design elements already present in the Crocs prior art." We disagree. The insole pattern for the patents-in-suit is distinctly different than the Crocs insole pattern.

The Crocs '789 patent contains a long, U-shaped dimpling pattern on the insole. In contrast, the patents-in-suit have a dimpling pattern that includes multiple short rows of dimples. Because we cannot say that these differences are insignificant as a matter of law, a genuine issue of material fact exists as to whether the designs would be viewed as substantially similar in the eyes of the ordinary observer armed with the knowledge of the prior art.

Beyond the insole features of its patented designs, Seaway argues that a genuine issue of material fact exists as to whether the exterior features of its designs preclude a finding of anticipation. It claims that four exterior features differ from the prior art to the degree necessary to preclude summary judgment: (1) the number and arrangement of the circular openings on the upper of the clog; (2) the number and position of the rectangular cut-outs in the lower portion of the upper of the clog; (3) the shape of the toe portion of the clog; and (4) the raised pattern of the outsole of the clog. These features are identical in all three of Seaway's patents-in-suit. With regard to these alleged dissimilarities, the district court stated:

Slight variations on the number and position of the circular holes on the top of the shoe, the rectangular holes on the toe of the shoe as well as the design of different shaped rectangles on the sole of the shoe would not convince a reasonable jury, or an ordinary observer with knowledge of the prior art, that the limitations were not inherently disclosed in the '789 patent. This conclusion does not change merely because plaintiff slightly changed the arrangement of the textured portions on the top and around the bottom portion of the sides of the shoe.

We agree with the district court that these minor variations in the shoe are insufficient to preclude a finding of anticipation because they do not change the overall visual impression of the shoe. Although the ordinary observer test requires consideration of the design as a whole, this does not prevent the district court on summary judgment from determining that individual features of the design are insignificant from the point of view of the ordinary observer and should not be considered as part of the overall comparison. The mandated overall comparison is a comparison taking into account significant differ-

ences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another. Just as minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement,, so too minor differences cannot prevent a finding of anticipation.

b Obviousness

The *Graham* framework is nominally the same for design patents and for utility patents. But the application is very different. Query whether the tests used by the Federal Circuit survive *KSR*.

MRC Innovations, Inc. v. Hunter Mfg., LLP,

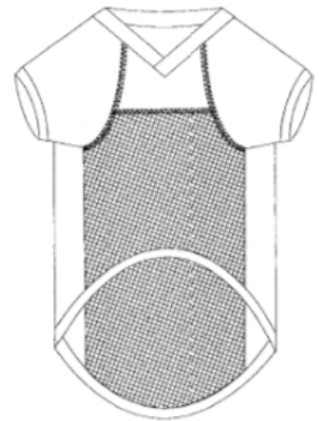
MRC Innovations, Inc. appeals from a final judgment of the U.S. District Court for the Northern District of Ohio granting summary judgment of invalidity with respect to U.S. Design Patent No. **D634,488**. The '488 patent claims an ornamental design for a football jersey for a dog.

The district court concluded that the '488 patent would have been obvious in view of several prior art pet jerseys. MRC now appeals that determination. Obviousness is a question of law based on underlying factual questions. The underlying factual inquiries include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. *Graham*.

In the context of design patents, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. To answer this question, a court must first determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. That inquiry involves a two-step process. First, the court must identify a single reference, something in existence, the design characteristics of which are basically the same as the claimed design. The "basically the same" test requires consideration of the visual impression created by the patented design as a whole. The trial court judge may determine almost instinctively whether the two designs create basically the same visual impression, but "must communicate the reasoning behind that decision.

Once the primary reference is found, other "secondary" references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. These secondary references must be so related to the primary reference that the appearance of certain ornamental features in one would suggest the ap-

747 F.3d 1326 (Fed. Cir. 2014)



'488 design

"The 'ordinary designer' means one who brings certain background and training to the problems of developing designs in a particular field, comparable to the 'mechanic' or 'routinier' in non-design arts. We do not have a name for that person in the design field other than 'designer' which is also the name we must use for the person who creates a patentable design." *Nalbandian*

"For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art." *International Seaway*



"Eagles" design

plication of those features to the other.

A. Primary Reference

The district court used the "Eagles" pet jersey as the "primary reference" under step one of the analysis. MRC argues that this was legally erroneous because there are significant differences between the Eagles jersey and the patented design of the '488 patent. Specifically, there are three differences: (1) the patented design has a V-neck collar where the Eagles jersey has a round neck; (2) the patented design contains an interlock fabric panel on the side portion of the design rather than mesh; and (3) the patented design contains additional ornamental surge stitching on the rear portion of the jersey. MRC argues that the district court overlooked these differences by focusing on the claimed design at too high a level of abstraction. If the district court had translated the claimed design into a verbal description as required by High Point, MRC insists, it would have concluded that neither the Eagles jersey nor any other prior art reference contained design characteristics that were basically the same as the claimed design.

As an initial matter, it is true that the district court did not expressly undertake to translate the claimed design into a verbal description. However, the purpose of requiring district courts to describe the claimed design in words is so that the parties and appellate courts can discern the trial court's reasoning in identifying a primary reference. It is entirely clear from the district court's opinion what it considered to be the relevant design characteristics of the '488 patented design.

First, the district court pointed out three key similarities between the claimed design and the Eagles jersey: an opening at the collar portion for the head, two openings and sleeves stitched to the body of the jersey for limbs, and a body portion on which a football logo is applied. If the district court's analysis had ended there, it might indeed have failed to meet the verbal description requirement. However, the district court went on to point out two additional similarities between the two designs: first, the Eagles jersey is made "primarily of a mesh and interlock fabric"; and second, it contains at least some ornamental surge stitching – both features found in the '488 claimed design. The district court also went on to acknowledge the three major differences between the two designs that are enumerated above. Taking all of those things together (the at least five design characteristics that the claimed design shares with the Eagles jersey and three design characteristics that differ from it), the district court painted a clear picture of the claimed design. The district court did far more than merely ask whether the Eagles jersey disclosed the general concept of a pet jersey; it thoroughly considered the "distinctive visual ap-

pearances of the reference and the claimed design. Thus, the district court did not err by failing to provide an express verbal description of the claimed design; rather, it described the claimed design in the context of comparing it to the prior art.

Nor did the district court err in finding that the design characteristics of the '488 design created basically the same overall visual impression as the Eagles jersey prior art reference. As the district court noted, both designs contain the same overall shape, similar fabric, and ornamental surge stitching. That there are slight differences in the precise placement of the interlock fabric and the ornamental stitching does not defeat a claim of obviousness; if the designs were identical, no obviousness analysis would be required.¹ Indeed, we have permitted prior art designs to serve as "primary references" when their differences are as great or greater than the differences in this case. See *Jore Corp. v. Kouvato, Inc.* (finding prior art drill bit to be a primary reference despite containing a smooth cylindrical shaft rather than the grooved hexagonal shaft of the claimed design); *In re Nalbandian* (finding tweezer design obvious in light of prior art reference that contained vertical rather than horizontal fluting and straight rather than curved pincers).³

B. Secondary References

After concluding that the Eagles jersey could be a "primary reference," the district court determined that the V2 jersey and another reference known as the "Sporty K9" jersey were "so related to the



"V2" design

Jore: 117 Fed. Appx. 761 (Fed. Cir. 2005)

Nalbandian: 661 F.2d 1214 (CCPA 1981)

¹This conclusion is not inconsistent with the law of this circuit on design patent infringement. In that context, we have often noted that design patents have "almost no scope" beyond the precise images shown in the drawings. *Mann*. However, in practice, our focus on the "overall visual appearance" of a claimed design rather than on individual features has led us to find products infringing despite differences in specific ornamental features. For example, in *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294 (Fed. Cir. 2010), we concluded that all of the accused products infringed the asserted design patents despite the fact that two of the infringing products (the Groovy DAWGSTM shoes and Big DAWGSTM shoes) contained a wider shoe front with an additional row of holes, and another infringing product (the Effervescent Waldies AT shoe) contained square holes on the top of the shoe rather than round ones.

³Alternatively, the district court could have relied on the V2 jersey as the primary reference. The only differences between the V2 jersey and the claimed design are: (1) that the V2 jersey does not contain an "interlock" fabric panel; (2) it has "drop" sleeves while the claimed jersey has "raglan-style" sleeves; and (3) the V2 jersey lacks any ornamental surge stitching. A side-by-side comparison of the two designs demonstrates that of those three differences, only the ornamental surge stitching truly alters the "overall visual appearance" of the design. Moreover, the ornamental stitching on the claimed design is suggested by the seam lines on the V2 jersey, further minimizing the difference in overall appearance. Thus, either the "Eagles" jersey or the V2 jersey could have served as a "primary reference" for purposes of the obviousness analysis.

primary reference” that they could serve as “secondary references” that would motivate the skilled artisan to make the claimed design.

The district court found that both jerseys suggested the use of a V-neck pattern and non-mesh fabric on the side panels – the first two differences described above. MRC argues that the district court erred by failing to explain why a skilled artisan would have chosen to incorporate those features of the V2 and Sporty K9 jerseys with the Eagles jersey.

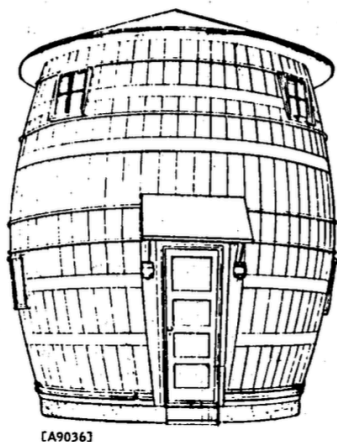
We disagree. It is true that in order for secondary references to be considered, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. However, the teachings of prior art designs may be combined only when the designs are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. In other words, it is the mere similarity in appearance that itself provides the suggestion that one should apply certain features to another design.

In re Borden discussed what is required for a reference to be considered sufficiently “related” for that test to apply. There, we noted that the secondary references were “closely akin” to the claimed design, and relied heavily on the fact that “the two missing design elements [were] not taken from unrelated references, but [were] found in other dual-chamber containers.” Thus, those references could be used “to bridge the small gap between the [primary] container and Borden’s claimed design.” So too, here, the secondary references that the district court relied on were not furniture, or drapes, or dresses, or even human football jerseys; they were football jerseys designed to be worn by dogs. Moreover, as discussed above, the V2 could easily have served as a primary reference itself, so similar is its overall visual appearance to that of the claimed design and the Eagles jersey. We therefore agree that those references were “so related” to the Eagles jersey that the striking similarity in appearance across all three jerseys would have motivated a skilled designer to combine features from one with features of another.

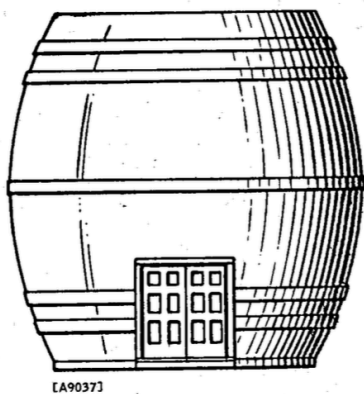
With respect to the only remaining difference between the Eagles jersey and the ’488 claimed design – the presence of additional ornamental surge stitching running down the rear of the jersey – the district court acknowledged that no prior art reference contained exactly that same stitching on the rear of the jersey, but nevertheless concluded that this was not a “substantial” difference that created a patentably distinct design, but rather was a “de minimis change[] which would be well within the skill of an ordinary designer in the art.”

MRC argues that adding any ornamental feature to a primary reference that is not suggested by the prior art is, by definition, more

Borden: 90 F.3d 1570 (Fed. Cir. 1996)



Prior art barrel-shaped building



Barrel-shaped building design held obvious in light of prior art

than de minimis. But our case law plainly contradicts that position; on numerous occasions we have invalidated design patents despite the inclusion of ornamental features that were entirely absent from prior art designs. *See, e.g., Nalbandian* (different shape of fluting on finger grips and different shape of pincers were de minimis differences in design for tweezers); *In re Cooper* (affirming Board's conclusion that numerous changes to the design of a prior art building – including a single rather than double door and the addition of windows – were de minimis because the overall impression was still a building that looked like a barrel).

Cooper: 480 F.2d 900 (CCPA 1973)

Here, the Eagles jersey had already disclosed the use of ornamental surge stitching. The only additional step needed was to extend the stitching down the sides of the rear of the jersey. Moreover, the V2 jersey plainly suggested the addition of vertical lines down the rear of the jersey through the use of the seams between the two types of fabric. We agree with the district court that adding ornamental surge stitching on top of a preexisting seam was an insubstantial change that would have been obvious to a skilled designer.⁶

4 Infringement: Similarity

The "ordinary observer" analysis used to assess the similarity of designs actually predates its use in copyright law, which borrowed the term and some of the concepts from design patent law. *Egyptian Goddess* sets out the modern test. *Wing Shing* shows the test in action and deals with the problem of filtering out unoriginal elements of a design; *OddzOn* deals with the related problem of filtering out unprotectable functional elements. *L.A. Gear* clears up a couple of conceptual points about how the analysis actually works.

"Judges and lawyers in general are highly uncomfortable with images, yet design patents force direct legal engagement with images." Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. Intell. Prop. L. 409 (2012)

Egyptian Goddess, Inc. v. Swisa, Inc.

I

The starting point for any discussion of the law of design patents is the Supreme Court's decision in *Gorham Co. v. White*. That case involved a design patent for the handles of tablespoons and forks. In its analysis of claim infringement, the Court stated that the test of identity of design "must be sameness of appearance, and mere difference of lines in the drawing or sketch ... or slight variances in configuration... will not destroy the substantial identity." Identity of appear-

543 F.3d 665 (Fed. Cir. 2008)

Gorham: 81 U.S. 511 (1871)

⁶To be clear, we do not intend to suggest that merely because one prior art reference used ornamental surge stitching, any use of such stitching would have been a de minimis change. Rather, the addition of the surge stitching in this case was de minimis because it merely followed the visual lines created by the seams of the V2 jersey; in other words, it served only to highlight a design feature that had already existed in the V2 prior art jersey.

ance, the Court explained, or "sameness of effect upon the eye, is the main test of substantial identity of design"; the two need not be the same "to the eye of an expert," because if that were the test, "there never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them."

The *Gorham* Court then set forth the test that has been cited in many subsequent cases: "If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." In the case before it, the Court concluded that "whatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the same in general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing – so much alike that even persons in the trade would be in danger of being deceived."

Since the decision in *Gorham*, the test articulated by the Court in that case has been referred to as the "ordinary observer" test and has been recognized by lower courts, including both of this court's predecessors, as the proper standard for determining design patent infringement. However, in a series of cases tracing their origins to *Litton Systems, Inc. v. Whirlpool Corp.*, this court has held that proof of similarity under the ordinary observer test is not enough to establish design patent infringement. Rather, the court has stated that the accused design must also appropriate the novelty of the claimed design in order to be deemed infringing. The court in *Litton Systems* wrote as follows:

For a design patent to be infringed, no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art. That is, even though the court compares two items through the eyes of the ordinary observer, it must nevertheless, to find infringement, attribute their similarity to the novelty which distinguishes the patented device from the prior art.

After identifying the combination of features in the design that it considered novel, the court in *Litton Systems* held that the accused design had none of those features and therefore did not infringe.

In a number of cases decided after *Litton Systems*, this court has interpreted the language quoted above to require that the test for design patent infringement consider both the perspective of the ordinary observer and the particular novelty in the claimed design.

The extent to which the point of novelty test has been a separate test has not always been clear in this court's case law. In cases decided shortly after *Litton*, the court described the ordinary observer test and the point of novelty test as "conjunctive." It has not been until much more recently that this court has described the ordinary observer and point of novelty tests as "two distinct tests" and has stated that the merger of the point of novelty test and the ordinary observer test is legal error.

Regardless of the differences in the way it has been characterized, the point of novelty test has proved reasonably easy to apply in simple cases in which the claimed design is based on a single prior art reference and departs from that reference in a single respect. In such cases, it is a simple matter to identify the point of novelty and to determine whether the accused design has appropriated the point of novelty, as opposed to copying those aspects of the claimed design that were already in the prior art. However, the point of novelty test has proved more difficult to apply where the claimed design has numerous features that can be considered points of novelty, or where multiple prior art references are in issue and the claimed design consists of a combination of features, each of which could be found in one or more of the prior art designs. In particular, applying the point of novelty test where multiple features and multiple prior art references are in play has led to disagreement over whether combinations of features, or the overall appearance of a design, can constitute the point of novelty of the claimed design. In light of the questions surrounding the status and application of the point of novelty test, we use this case as a vehicle for reconsidering the place of the point of novelty test in design patent law generally.

II

[The court reviewed previous caselaw in detail.]

As noted, this court has cited *Litton Systems* for the proposition that the point of novelty test is separate from the ordinary observer test and requires the patentee to point out the point of novelty in the claimed design that has been appropriated by the accused design. We think, however, that *Litton Systems* and the predecessor cases on which it relied are more properly read as applying a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused product in the context of the prior art. When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be

Whitman Saddle: 148 U.S. 674 (1893)

important to the eye of the hypothetical ordinary observer. It was for that reason that the Supreme Court in *Smith v. Whitman Saddle Co.* focused on the one feature of the patented saddle design that departed from the prior art – the sharp drop at the rear of the pommel. To an observer familiar with the multitude of prior art saddle designs, including the design incorporating the Granger pommel and the Jenifer cantle, “an addition frequently made,” the sharp drop at the rear of the pommel would be important to the overall appearance of the design and would serve to distinguish the accused design, which did not possess that feature, from the claimed design.

Applying the ordinary observer test with reference to prior art designs also avoids some of the problems created by the separate point of novelty test. One such problem is that the point of novelty test has proved difficult to apply in cases in which there are several different features that can be argued to be points of novelty in the claimed design. In such cases, the outcome of the case can turn on which of the several candidate points of novelty the court or fact-finder focuses on. The attention of the court may therefore be focused on whether the accused design has appropriated a single specified feature of the claimed design, rather than on the proper inquiry, i.e., whether the accused design has appropriated the claimed design as a whole.

In addition, the more novel the design, and the more points of novelty that are identified, the more opportunities there are for a defendant to argue that its design does not infringe because it does not copy all of the points of novelty, even though it may copy most of them and even though it may give the overall appearance of being identical to the claimed design. In such cases, a test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce results more in line with the purposes of design patent protection.

This court has characterized the purpose of the point of novelty test as being “to focus on those aspects of a design which render the design different from prior art designs.” That purpose can be equally well served, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art. If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing. At the same time, unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.

This approach also has the advantage of avoiding the debate over the extent to which a combination of old design features can serve

as a point of novelty under the point of novelty test. An ordinary observer, comparing the claimed and accused designs in light of the prior art, will attach importance to differences between the claimed design and the prior art depending on the overall effect of those differences on the design. If the claimed design consists of a combination of old features that creates an appearance deceptively similar to the accused design, even to an observer familiar with similar prior art designs, a finding of infringement would be justified. Otherwise, infringement would not be found.

On the basis of the foregoing analysis, we hold that the "point of novelty" test should no longer be used in the analysis of a claim of design patent infringement. In accordance with *Gorham* and subsequent decisions, we hold that the "ordinary observer" test should be the sole test for determining whether a design patent has been infringed.

In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer, as required by *Gorham*. In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art, as in many of the cases discussed above and in the case at bar. Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.

We emphasize that although the approach we adopt will frequently involve comparisons between the claimed design and the prior art, it is not a test for determining validity, but is designed solely as a test of infringement.

III

One of the issues raised by this court in its order granting en banc review was whether trial courts should conduct claim construction in design patent cases. While this court has held that trial courts have a duty to conduct claim construction in design patent cases, as in utility patent cases, the court has not prescribed any particular form that the claim construction must take. To the contrary, the court has recognized that design patents typically are claimed as shown in drawings, and that claim construction is adapted accordingly. For that reason, this court has not required that the trial court attempt to provide a detailed verbal description of the claimed design, as is typically done in

the case of utility patents. Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to “construe” a design patent claim by providing a detailed verbal description of the claimed design.

While it may be unwise to attempt a full description of the claimed design, a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court’s own analysis, various features of the claimed design as they relate to the accused design and the prior art. Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as describing the role of particular conventions in design patent drafting, such as the role of broken lines; assessing and describing the effect of any representations that may have been made in the course of the prosecution history; and distinguishing between those features of the claimed design that are ornamental and those that are purely functional,

Wing Shing Products (BVI) Co. v. Sunbeam Products, Inc.

665 F. Supp. 2d 357 (S.D.N.Y. 2009)

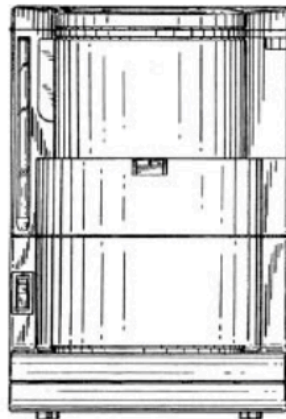
Plaintiff Wing Shing owns United States Design Patent No. **D348,585** for the ornamental design of a coffeemaker. Defendant Sunbeam is a Delaware corporation that sells coffee makers under the MR. COFFEE brand. The subject of this action is a line of MR. COFFEE automatic coffee-making devices called the “AR series,” which defendants manufactured and sold between 2001 and 2006.

Sunbeam argues that the ‘585 patent and the primary accused device – the AR 10/12 – are so plainly dissimilar that, even without considering any prior art, no reasonable fact-finder could conclude that they would appear “substantially the same” to an ordinary observer. The argument is not without merit. The two designs are pictured below:

'585 PatentAR 10/12 (Accused)

Two major differences between the designs are apparent. First, they have different bases: the '585 has a "bullnose" base – it is flat with a rectangular cross section up to the tip, where the top and bottom meet on a curve – while the AR 10/12 has a smooth base that slopes gradually from the heating plate. The designs also have dramatically different tops: the '585's is flat, whereas the AR's has a circular indent partially overhung by the lid to the water reservoir. As Sunbeam points out, these differences come at "focal points" in the designs: the top and base are the most visually commanding features of a coffeemaker, along perhaps with the brew basket. At least one district court applying Egyptian Goddess has granted summary judgment without considering prior art where two designs differed primarily at one highly significant feature. Here, however, in the cluttered world of the drip-coffeemakers, it seems senseless to attempt to determine whether the "ordinary observer" would confuse two designs without looking to the prior art for a point of reference. That "a purchaser of things of similar design," as the ordinary observer has been defined, could be deceived by the devices' similarities seems unlikely to the Court, but resolution of the inquiry would benefit from a concrete guidepost. Thus, though the Court acknowledges manifest differences in the overall appearance of the '585 and the AR 10/12, it turns to the prior art for context.

Defendants identify numerous examples of prior art. The primary piece is a coffeemaker called the "Accel" that Sunbeam itself developed in the early 1990's. The Accel and the '585 are pictured below:

'585 patentAccel (Prior Art)

The two designs are quite similar. Each has a large, smooth brew basket with a circular cross section that is partially encased by vertical shafts connecting the brew basket to the base of the machine. Each has a similarly shaped recess for the carafe. Both designs call to mind the familiar white or black coffeemaker that graces most American kitchens. As will be noted, differences exist, but on the whole the claimed design when compared to the prior art bespeaks "a field ... crowded with many references relating to the design of the same type of appliance." *Egyptian Goddess*. Accordingly, the scope of protection afforded the '585 patent falls in a narrow range.

As for dissimilarities, the base is surely the most prominent observable difference between the designs. In contrast to the "bullnose" on the '585, the Accel has an angular base with a trapezoidal cross section. To the extent the devices have distinct overall appearances, their different bases supply them. There are additional minor differences – the top of the Accel is slightly crowned, while the '585's is flat; and the water reservoir on the '585 extends further around the circumfer-

ence of the brew basket – but these small details do not make nearly the visual impression that the distinct bases do.

If the AR 10/12 (the accused design) had copied the '585's bullnose base – the one feature of the '585 that departs conspicuously from the prior art as depicted in the Accel – an inference of infringement might arise. Instead, the AR 10/12 has its own, unique base, as is all the more apparent when viewed alongside both the '585 and the Accel:



Because the AR 10/12 and the '585 differ at the very feature that primarily distinguishes the '585 from the Accel, no ordinary observer familiar with the Accel would be deceived into believing that the AR 10/12 and the '585 are the same. Indeed, since it is difficult to tell the '585 and the Accel apart without focusing on their bases, it would be unreasonable to conclude that any observer capable of distinguishing those two machines would confuse the AR 10/12 and the '585, which also have different bases. Additionally, the AR 10/12's unique lid configuration, which distances it from both the '585 and the prior art, further solidifies the conclusion that no genuine issue of material fact as to non-infringement exists here.

The Court remains mindful of the Federal Circuit's admonition to analyze the design as a whole and not engage in an element-by-element comparison of the devices in question. Nonetheless, when the prior art is used as a frame of reference, the tops and bases of the devices in question dominate the overall visual impressions they make. As *Egyptian Goddess* itself recognized, where a particular design element sharply distinguishes, against the context of the prior art, the claimed design from the accused design, it is not error to focus on that element in the infringement analysis.

Plaintiff argues that summary judgment cannot be granted here because, unlike in *Egyptian Goddess*, the AR 10/12 is closer to the patented design than the prior art. Plaintiff contends that the AR 10/12 is closer to the '585 patent than the Accel because the "body" of the AR 10/12 – the region from "the bottom of the lid to the top of the base" – is "substantially identical" to the body of the '585 design. The Court does not find this argument persuasive. First, in focusing on the "body" of the design, plaintiff has chosen a frame of reference that conveniently excludes the salient points of comparison – the top and the base. Under this framework, the Accel itself could be found to infringe, because to the layman's eye, its "body" is not readily distinguishable from the '585 patent. This is exactly the type of absurd result that consideration of the prior art is meant to avoid. Secondly, whether the accused device is "closer" to the patented design than to the prior art is not the controlling inquiry. *Egyptian Goddess* notes that strong similarities between the accused design and the prior art are an indication of non-infringement, but it does not require a mechanical determination – which in this case of "crowded art" would be impractical – that the accused device is "closer" to either the patent or the prior art. Instead, *Egyptian Goddess* requires an assessment of how the prior art will impact the ordinary observer's perception of the accused and claimed designs. Here, for example, though reasonable jurors might disagree on whether the AR 10/12 is "closer" to the Accel or the '585 patent (it is different than both), no reasonable juror could dispute that an ordinary observer familiar with the Accel

would not believe the AR 10/12 to be the "same as" the '585 patent.

OddzOn Products, Inc. v. Just Toys, Inc.

OddzOn is a toy and sporting goods company that sells the popular "Vortex" tossing ball, a foam football-shaped ball with a tail and fin structure. The Vortex ball is OddzOn's commercial embodiment of its design patent, U.S. Patent D346,001, which issued on April 12, 1994. Just Toys, Inc., another toy and sporting goods company, sells a competing line of "Ultra Pass" balls.

OddzOn argues that the district court erred in finding a lack of infringement. We do not agree.

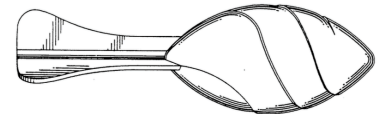
In *Gorham*, the claimed elements were purely ornamental, being limited to the scroll work on the handle portion of flatware. If, on the other hand, a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design. The patentee must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.

In construing the claim of OddzOn's patent, the district court carefully noted the ornamental features that produced the overall "rocket-like" appearance of the design. We agree with the district court's claim construction, which properly limits the scope of the patent to its overall ornamental visual impression, rather than to the broader general design concept of a rocket-like tossing ball.

OddzOn argues that the shape of a football with an arrow-like tail is an ornamental feature because "it is not required for a tossing ball." While OddzOn correctly states that there are many ways of designing "tossing balls," it is undisputed that the ball in question is specifically designed to be thrown like a football, yet travel farther than a traditional foam football. It is the football shape combined with fins on a tail that give the design these functional qualities. The tail and fins on OddzOn's design add stability in the same manner as do the tail and fins found on darts or rockets. They are no less functional simply because 'tossing balls' can be designed without them.

Because the accused products are clearly similar to OddzOn's design in terms of their football shape and their tail and fins, it was incumbent on OddzOn to submit evidence establishing that the ornamental aspects of their football-with-tail-and-fin combination accounted for the similarity perceived by the survey participants. None of the evidence, when viewed in the light most favorable to OddzOn, would support a jury verdict that the accused devices are similar to the patented design with its football-shaped ball, slender tailshaft, and three fins which seemingly protrude out of the football and gently flare outwardly.

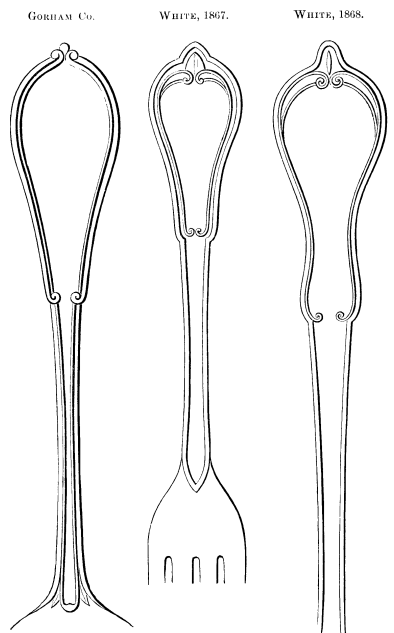
122 F.3d 1396 (Fed. Cir. 1997)



'001 design



Ultra Pass balls



Plaintiff's and defendant's designs from *Gorham*

OddzOn also submitted evidence establishing that Just Toys' balls were returned to OddzOn by retailers on nineteen different occasions. The district court excluded this evidence of alleged "actual confusion" on the ground of lack of relevance. We agree with OddzOn that the exclusion of the "actual confusion" evidence on relevance grounds was an abuse of discretion. Given the low threshold for relevancy, it is clear that the evidence was relevant. We find this error harmless, however, because it does not change the result of OddzOn's appeal.

988 F.2d 1117 (Fed. Cir. 1993)

L.A. Gear, Inc. v. Thom McAn Shoe Co.

Although design patent analysis requires comparison of the claimed design with the accused articles, Melville has not argued that the patent drawing differs from the embodiment in the L.A. Gear shoe, and has offered no reason why the finding of substantial similarity between the actual shoes was not applicable to the infringement analysis. When the patented design and the design of the article sold by the patentee are substantially the same, it is not error to compare the patentee's and the accused articles directly; indeed, such comparison may facilitate application of the *Gorham* criterion of whether an ordinary purchaser would be deceived into thinking that one were the other.

Design patent infringement relates solely to the patented design, and does not require proof of unfair competition in the marketplace, or allow of avoidance of infringement by labelling.

5 Infringement: Prohibited Conduct

Patent Act

35 U.S.C. § 289
Additional remedy for infringement of
design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

A few notes:

1. Section 289 provides additional remedies; the clear implication is that the usual theories of direct, inducing, and contributory patent infringement under § 271 are also available for design patents. (See *Milo & Gabby* below.)
2. As with utility patents, there is no requirement of copying from the plaintiff; design patents give a general right to exclude anyone from using the patented design.
3. Design patents probably also borrow their rules on intent from utility patent law: one can infringe without knowing of the patent or intending to infringe it.
4. Both prongs of § 289 have explicitly commercial thresholds: they turn on "the purpose of sale" and on "sells or exposes for sale," respectively.
5. § 289 is silent on questions of indirect liability. There is essentially no caselaw on point.

Milo & Gabby, LLC v. Amazon.com

In this action, Plaintiffs, Milo & Gabby, LLC and Karen Keller, sought money damages from Defendant, Amazon.com, Inc., for its "offering to sell" products that allegedly infringe certain design patents. Amazon has stipulated that the allegedly infringing products are substantially similar to the designs covered by the Milo & Gabby patents.

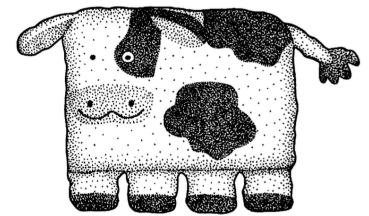
When a third-party seller wants to offer a new product for sale on the Amazon.com platform, the third-party seller is responsible for sending Amazon, via an automated file upload system, content related to the new product, such as a product description, an image of the product, and the product's price. This content is used to automatically generate a "product detail page" and, in some instances, to create advertisements related to the new product. The third-party seller is responsible for the uploaded content, and specifically represents and warrants that it has the right to grant Amazon a license to use all content, trademarks, and other materials provided by it. Under Amazon's Intellectual Property Violations Policy, third-party sellers are responsible for ensuring that the products they offer for sale are legal. With respect to images, third-party sellers agree that it is their responsibility to "ensure that they have all the necessary rights for the images they submit." Third-party sellers may ship their products to customers directly or, for a fee, use the "Fulfillment by Amazon" ("FBA") service. Third-party sellers who use Amazon's FBA service retain legal title to their products, while Amazon provides fulfillment services for the products, such as storage and shipping.^{D547,587}

While the Federal Circuit has most often addressed "offer to sell" liability in the jurisdictional context, analyzing where the offer took place, this Court is not aware of any Federal Circuit case directly ad-

144 F. Supp. 3d 1251 (W.D. Wash. 2015)

How much does it matter that the plaintiff held design rather than utility patents? Not at all, or less than zero?

The description of Amazon's operations is taken from an earlier unreported opinion, available at 2015 WL 4394673 (July 16, 2015).



U.S. Des. Pat. No. , "Cow-Shaped Pillow Case"

addressing the central issue before this Court—that is, who made the alleged “offer to sell.” Thus, this Court acknowledges its difficulty in reaching its conclusion in this matter.

Nonetheless, based on the factual determinations made by the Jury, the Court concludes that Amazon did not “offer to sell the alleged infringing products in this case. The Jury specifically found the following:

- Amazon, through its website, did not communicate a description of the allegedly infringing products;
- Amazon, through its website, did not communicate the price at which the allegedly infringing product could be purchased;
- Amazon did not provide the descriptions of the allegedly infringing products;
- Amazon did not set the price at which the allegedly infringing products could be purchased;
- Amazon did not set the quantity(ies) of the allegedly infringing product(s) for sale on its website;
- Amazon, through its website, did not communicate that it was willing to enter into a bargain to sell the allegedly infringing products

Based on these findings, and having reviewed the evidence and testimony presented in this matter, the Court can only conclude that Amazon did not offer to sell the alleged infringing products because there was no manifestation of the willingness of Amazon to enter into a bargain, so made as to justify another person in understanding that his assent to that bargain is invited and will conclude it.

However, the Court is troubled by its conclusion and the impact it may have on the many small retail sellers in circumstances similar to the Plaintiffs. There is no doubt that we now live in a time where the law lags behind technology. This case illustrates that point. Amazon’s representative, Christopher Poad, testified that Amazon completely changed the online market place by creating a platform where any seller can offer products to Amazon’s customers. He further testified that Amazon allows sellers to offer their products with minimal effort, by simply filling out an online information form, clicking on an agreement to Amazon’s terms and conditions, and providing certain banking information. Amazon then offers those sellers both payment processing and fulfillment services, all with an asserted interest in providing the best service to their customers. Mr. Poad also testified that when customers cannot resolve problems with a particular seller, Amazon will often step in to make things right. As a result, Amazon enables and fosters a market place reaching millions of customers, where anyone can sell anything, while at the same time taking little

If the third-party sellers are infringing by both selling and offering to sell the infringing products, could Milo & Gabby hold Amazon liable for contributory patent infringement or inducing patent infringement under § 271(b) or (c)? Does § 289 work against Amazon?

responsibility for “offering to sell” or “selling” the products.¹ Indeed, under the current case law, Amazon has been able to disavow itself from any responsibility for “offering to sell” the products at all. The purpose of adding “offer[] to sell” to section 271(a) was to prevent generating interest in a potential infringing product to the commercial detriment of the rightful patentee. In this instance, the Court is not convinced that such purpose has been fulfilled. However, that is a subject which must be addressed to Congress and not the courts.

6 Defenses

Jazz Photo Corp. v. International Trade Com'n

[Fuji Photo Film Co. sold disposable cameras.] The cameras are intended by the patentee to be used only once. After the film is exposed the photo-processor removes the film container by breaking open a pre-weakened portion of the plastic casing which is accessed by removal of the cardboard cover. Discarded LFFPs, subsequently purchased and refurbished by the respondents, are the subject of this action.

We conclude that for used cameras whose first sale was in the United States with the patentee’s authorization, and for which the respondents’ activities were limited to the steps of (1) removing the cardboard cover, (2) cutting open the plastic casing, (3) inserting new film and a container to receive the film, (4) replacing the winding wheel for certain cameras, (5) replacing the battery for flash cameras, (6) resetting the counter, (7) resealing the outer case, and (8) adding a new cardboard cover, precedent requires that the described activities be deemed to be permissible repair.

[Most of the opinion dealt with the repair/reconstruction distinction as it bore on the exhaustion of Fuji’s utility patents. But the court also discussed exhaustion of Fuji’s design patents.]

The patented designs depict the exterior shape of the camera. The exterior design is unaffected by the “remanufacturing” process; it remains in its original form in the outer box and plastic structure of the camera. The respondents do not dispute that their cameras have the same design as the original cameras; indeed, their argument is that their cameras are the original cameras, repaired for reuse.

For original cameras that have been permissibly repaired, the principle of exhaustion applies to the design patents as well as to the utility patents. The design patent right, like all patent rights, is exhausted by unrestricted first sale in the United States, and is not infringed by the importation and resale of the repaired articles in their original design.

264 F.3d 1094 (2001)

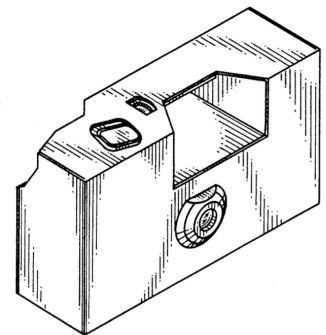


Figure 1, U.S. Des. Pat. No. D345,750, "Single use camera."

14 Chi.-Kent L. J. Intell. Prop. 553
(2015)

Ralph D. Clifford & Richard J. Peltz-Steele
The Constitutionality of Design Patents

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

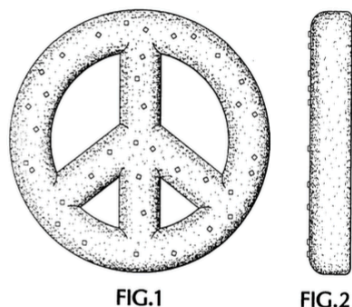


FIG.1

FIG.2



FIG.3

'184 design

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

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

The missing piece in the *Friend* lawsuit, and the unresolved problem presented by design patents, is fair use. Insofar as Friend was a sympathetic plaintiff, Laurel Hill and Keystone were profiting off the ingenuity of another and may have been expected fairly to pay up. But change the defendant to a non-commercial user, and the case takes on a different cast. Imagine a city rally for Ukrainian-Russian peace at which a sponsoring ethnic bakery makes and gives away peace-sign-shaped pretzels. Or suppose that a German-American citizens group decides to counter community angst over immigration by uniting local persons of different backgrounds in Oktoberfest beer gardens to dialog over homemade peace-sign-shaped pretzels. Peace-sign-shaped cookies, adorned or not with sugar crystals, or other ed-

ibles, also might run afoul of the design patent, as the controlling diagrams say nothing about the edible ingredients.

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

We can complicate the case further if we trade out the peace sign for a more controversial symbol. To choose a plaintiff that engenders less sympathy, suppose that the multinational oil and gas company BP obtained a design patent on a distinctive container for motor oil—let us borrow the double-sphere bottle in which POM Wonderful sells fruit juice. After the BP oil spill, a protestor and artist creates a sculpture depicting a blackened, oil-sodden pelican, surrounded by upturned BP oil bottles, also blackened, but recognizable by their shape. The artist might re-create (*make*) the bottles, or *use* discarded bottles. The artist might auction off (*sell*) the sculpture and donate the proceeds to an environmental advocacy group.

Critical training is hardly required to perceive the artist's message favoring environmental protection, or inversely, blaming BP for environmental degradation. But the work plainly runs afoul of the design patents, as the artist has made or used, and sold, the patented bottles. The ordinary observer properly perceives the BP bottles; indeed, the artist might be using BP bottles, which our auction winner buys because they are what they appear to be.

Without the structural safeguards and fair use defense that shape copyrights to accommodate free speech, design patents exclude the activists and artists from political advocacy and social commentary. These functions lie at the heart of First Amendment protection, and for good reason. If design patents can be perverted to freeze out this speech, then the public policy goals of free speech³⁹⁵ are not achieved.

It is unnecessary to craft a new strict scrutiny test under the First Amendment because the copyright fair use doctrine provides a well-drawn test designed already to accommodate the balance between the IP Clause and the First Amendment. The deep similarity of copyrights and design patents, notwithstanding their semantic differences and historical divergence, further suggest the appropriateness of fair use to design patents with only slight adaptations that can be done as a matter of constitutional law, without modification to statutory patent law



Hypothetical anti-BP protest sculpture

Look again at the Eames Lounge Chair. Could its design be effectively protected with a design patent?

E *Sui Generis* Regimes

There are two *sui generis* design-protection regimes codified in the Copyright Act. Neither has been extensively used. Compare them to copyright, to design patent, and to each other.

1 Semiconductor Masks

Under the Semiconductor Chip Protection Act of 1984, the “mask works” used to create computer chips are protected by a special *sui generis* IP regime. It is codified in the Copyright Act and borrows extensively from copyright law in some respects, while relaxing the application of the useful article rule. As will be seen, the SCPA also borrows from trade secret law. Does the resulting hybrid make sense?

17 U.S.C. ch. 9

Pamela Samuelson

Creating a New Kind of Intellectual Property: Applying the Lessons of the Chip Law to Computer Programs

70 Minn. L. Rev. 471 (1985)

Semiconductor chip products are most frequently manufactured by a process known as “photolithography” or “masking.” After the two and three dimensional features of shape and configuration of a chip have been determined, the layout (or “topography”) of the chip can be fixed in pictorial form – a so-called “composite” drawing of the various layers of the chip, shown in different colors on a very large sheet of paper. The same information can be recorded in digital form, by storing all the relevant coordinates of points in the composite drawing. This information is then used to generate a series of “masks,” which are stencils used to manufacture chips. Chips are manufactured by etching material (or otherwise removing it) away from semiconductor wafers and depositing material (or otherwise placing it) on the wafers. The etching and depositing processes configure the chips to the patterns comprising the mask. The masks are used to control the etching and depositing processes.

Congress generally allows utilitarian works to be freely copied if they do not meet the patent standards of novelty and invention. For chip designs, however, Congress made an exception. The House Committee [debating the Semiconductor Chip Protection Act of 1984] perceived the chip to be “at the vortex” of the new information society. “More than perhaps any other invention, the semiconductor chip has brought us into the information age.” Laying out the pattern of circuits so that hundreds of thousands or even a million transistors can be fit efficiently and economically onto the surface of a chip is “a

fine art and also a costly one." The period of time from the initial layout of the design to the successful manufacture of the first chip can "take the innovating chip firm years, consume thousands of hours of engineer and technician time, and cost millions of dollars. The development costs for a single new chip can reach \$100 million." By comparison, copying a chip's design is very cheap. In several months, for a cost of less than \$50,000, a pirate firm can duplicate the mask work of an innovator. This piracy was perceived to be a clear threat, not only to the health of the U.S. semiconductor industry, but to the growth of American information industries.

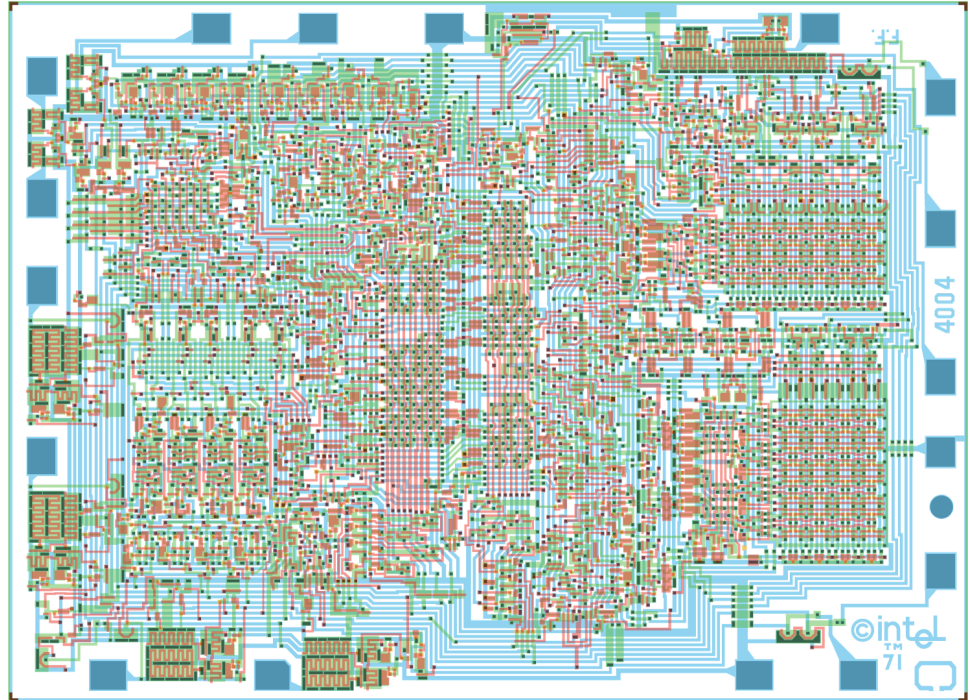
The major argument in favor of *sui generis* protection for chip designs, as reflected in the House Report, was actually an anti-copyright argument. Mask works and chip products were not subject matters that historically had been regarded as copyrightable, and the House Committee believed there were sound reasons for refusing to extend copyright protection to include them. The Register of Copyrights had refused to register mask works and chip products because they were "utilitarian" in a copyright sense; that is, they had a function beyond merely portraying an appearance or conveying information.

Although copyright sometimes had been extended to artistic features of utilitarian works, such features were only protected by copyright when they could be identified separately from and were capable of existing independently of the utilitarian aspects of the work. In the case of chips and chip masks, this "separate-identification-and-independent-existence" test could not be met. That is, a copyright for a chip product or chip mask would have to be a copyright on its functional features.

The House Committee recognized that mask works were in some respects similar to maps, technical drawings, photographs, and audiovisual works, all clearly copyrightable. The Committee described these similarities as "superficial," however, and found mask works to be "in fact very dissimilar in function and nature of creativity" from these other items. Mask works were to be protected because of

the technical and creative skill employed in laying out or designing electronic circuitry. Mask works have no intrinsic aesthetic purpose. Even if the layouts convey information, that is not their sole or main purpose: their primary purpose is to be used in the manufacture of a useful article – semiconductor chip products.

This is a mask for the Intel 4004, released in 1971 -- hundreds of times simpler than the state of the art in 1984, and millions of times simpler than current chips.



92 Va. L. Rev. 1687 (2006)

Kal Raustiala & Christopher Sprigman
The Piracy Paradox, Innovation and Intellectual Property in Fashion Design

In 1984, Congress adopted the Semiconductor Chip Protection Act. The SCPA protects "mask works," which are the stencils used to control the process of etching onto silicon wafers the circuitry that make up a microprocessor.

Under the SCPA, a mask work is protected if it is fixed in a semiconductor chip and is original. The SCPA requires that mask works either be registered with the Copyright Office or be commercially exploited as a condition of protection.

Once an owner complies with the SCPA's formalities, he possesses the exclusive right for a period of ten years "to reproduce the mask work by optical, electronic, or any other means." As in copyright law, the exclusive right of reproduction granted is not limited to identical copies. The owner of a mask work protected by the SCPA has the right to enjoin any work that is "substantially similar" to the protected work. The SCPA also gives the owner an exclusive right for the same ten-year period "to import or distribute" a chip for which the protected mask work has been used in production.

424 F.3d 1079 (9th Cir. 2005)

Altera Corp. v. Clear Logic, Inc.

This case involves an infringement action by Altera against Clear Logic under the Semiconductor Chip Protection Act of 1984. A jury found for Altera on all claims and a judgment was entered for

\$30.6 million in damages, \$5.4 million in prejudgment interest and \$394,791.68 in costs. The district court judge also entered an injunction preventing Clear Logic from engaging in those activities against Altera. We affirm the judgment and the injunction.

This is one of a very small handful of reported cases on the SCPA.

I. OVERVIEW

Altera and Clear Logic are competitors in the semiconductor industry. Altera manufactures programmable logic devices (“PLDs”), which are chips that can be programmed to perform various logic functions. A customer uses Altera’s MAX+PLUS II software to program the PLD to perform the desired function. The software helps to route the functions through the thousands of transistors that make up the PLD, ideally achieving the maximum functionality for the particular function desired. Because the PLD can be programmed and reprogrammed, the customer, working with Altera, can continue to work with the PLD and the software until the PLD meets the customer’s exact needs. This process can take months.

Clear Logic manufactures a different type of chip: Application-Specific Integrated Circuits (“ASICs”). These chips are designed to perform one specific function and cannot be programmed by the customer. They use less power, are smaller and, for a customer with a large order, are often cheaper. Customers will sometimes start with PLDs and switch to ASICs once they have determined exactly what they need the chips to do. Traditionally, a company that converts from PLDs to ASICs must again start from a high level of description and work toward the end product, the ASIC. This can take a few months and there is a substantial risk that even after the initial attempt, the first chip will not work and more time and money will have to be invested in perfecting the product.

Clear Logic works from a different business model. When customers program Altera devices, using the Altera software, a file called a bitstream is generated. Clear Logic asks customers to send the bitstream to Clear Logic, and Clear Logic uses the bitstream to create an ASIC for the customer. Clear Logic only produces ASICs that are compatible with Altera chips. The laser process Clear Logic uses to create chips with the bitstream allows for a turnaround time of just a few weeks, and rarely produces an incompatible chip.

II. THE SEMICONDUCTOR CHIP DESIGN PROCESS AND THE SEMICONDUCTOR CHIP PROTECTION ACT

Altera asserts that the placement of groupings of transistors on the chip was copied, and does not specifically address the layout of the transistors within those groupings. Clear Logic argues that the placement of the groupings is a system or an idea and is not entitled to protection under the SCPA. We reject this contention; the boundaries

and organization of these groupings are more than conceptual.

Commentators have suggested analyzing the levels of abstraction in the production of a computer program or a mask work to identify the distinction between ideas and expression, and the degree of similarity, in these formats. Under this approach, we identify the broad idea behind the design and assess each successive step in the design process, identifying the point at which the idea becomes protectable expression.

In considering the chip design process, we recognize, as do the parties, that with each step, the ideas become more concrete until they are finally expressed in the layout of the transistors in the mask work. The customer's idea is at the highest level of abstraction, and the schematics and floor plans convey more concrete ideas, 1086*1086 designating how the chip may be structured or organized. These drawings are preliminary sketches that would not be protected under traditional copyright principles. It is not until the level of the mask work, the piece of the process that Congress chose to protect, that there is an expression of that idea. Those ideas that are physically expressed in the mask work are subject to protection under the SCPA.

The district court correctly determined that the organization of the groupings is physically a part of the mask work. The mask work is structured according to the groupings that Altera highlighted and the district court correctly allowed the jury to determine whether those similarities constituted an infringement of the act. Unlike the outline of an article or the chapters in a book, these groupings physically dictate where certain functions will occur on a chip and describe the interaction of parts of the chip. The placement of logic groupings in a mask work is not an abstract concept; it is embodied in the chip and affects the chip's performance and efficiency as well as the chip's timing. It is the province of the jury to determine whether those aspects of the mask work are material, and whether the similarity between the mask works is substantial.

III. REVERSE ENGINEERING

The SCPA specifically protects the right of

- (1) a person to reproduce the mask work solely for the purpose of teaching, analyzing, or evaluating the concepts or techniques embodied in the mask work or the circuitry, logic flow, or organization of components used in the mask work; or
- (2) a person who performs the analysis or evaluation described in paragraph (1) to incorporate the results of such conduct in an original mask work which is made to be distributed.

This reverse engineering provision explicitly protects industry prac-

tices and encourages innovation. The second mask work must not be substantially identical to the original, and as long as there is evidence of substantial toil and investment in creating the second mask work, rather than mere plagiarism, the second chip will not infringe the original chip, even if the layout of the two chips is, in substantial part, similar.

The legislative history, relying on the testimony of industry representatives, indicated that most cases would probably present clear cut evidence of direct copying or of innovation and that in cases falling into the gray area between outright copying and complete originality, the courts should consider the presence or absence of a paper trail by the second firm. A firm that simply copied another firm's mask work would have no evidence of its own investment and labor, whereas a legitimate reverse engineering job would require a trail of paper work documenting the analysis of the original chip as well as the development of an independent design. In *Brooktree Corp. v. Advanced Micro Devices, Inc.*, the Federal Circuit analyzed the defendant's paper trail, but held that "the sheer volume of paper" was not dispositive.

Brooktree: 977 F.2d 1555 (Fed. Cir. 1992)

The SCPA's reverse engineering provision allows copying the entire mask work. It does not distinguish between the protectable and non-protectable elements of the chip as long as the copying is for the purpose of teaching, evaluating, or analyzing the chip. Although the product created from that analysis must be original, the process of studying the chip is not limited to copying ideas or concepts. The district court's instructions initially define "legitimate reverse engineering" to allow copying and analyzing only "non-protectable concepts or techniques." This is an incorrect statement of the law. [The incorrect statement was held not to have been prejudicial.]

2 Vessel Hulls

The Vessel Hull Design Protection Act of 1988 is also codified in the Copyright Act. Like the SCPA, the VHDPDA borrows from copyright law while also easing the useful article rule. Pay attention to how closely *Maverick Boat* hews to copyright – or doesn't.

Bonito Boats, Inc. v. Thunder Craft Boats, Inc.

489 U.S. 141 (1989)

We must decide today what limits the operation of the federal patent system places on the States' ability to offer substantial protection to utilitarian and design ideas which the patent laws leave otherwise unprotected.

In September 1976, petitioner Bonito Boats developed a hull design for a fiberglass recreational boat which it marketed under the trade name Bonito Boat Model 5VBR. Designing the boat hull required substantial effort on the part of Bonito. A set of engineering

drawings was prepared, from which a hardwood model was created. The hardwood model was then sprayed with fiberglass to create a mold, which then served to produce the finished fiberglass boats for sale. The 5VBR was placed on the market sometime in September 1976.

In May 1983, after the Bonito 5VBR had been available to the public for over six years, the Florida Legislature enacted Fla. Stat. § 559.94. The statute makes "[i]t ... unlawful for any person to use the direct molding process to duplicate for the purpose of sale any manufactured vessel hull or component part of a vessel made by another without the written permission of that other person." The statute also makes it unlawful for a person to "knowingly sell a vessel hull or component part of a vessel duplicated in violation of subsection (2)."

On December 21, 1984, Bonito filed this action in the Circuit Court of Orange County, Florida. The complaint alleged that Thunder Craft Boats had violated the Florida statute by using the direct molding process to duplicate the Bonito 5VBR fiberglass hull, and had knowingly sold such duplicates in violation of the Florida statute.

It is readily apparent that the Florida statute does not operate to prohibit "unfair competition" in the usual sense that the term is understood. [For the most part] the common-law tort of unfair competition has been limited to protection against copying of nonfunctional aspects of consumer products which have acquired secondary meaning such that they operate as a designation of source. In contrast to the operation of unfair competition law, the Florida statute is aimed directly at preventing the exploitation of the design and utilitarian conceptions embodied in the product itself.

In this case, the Bonito 5VBR fiberglass hull has been freely exposed to the public for a period in excess of six years. For purposes of federal law, it stands in the same stead as an item for which a patent has expired or been denied: it is unpatented and unpatentable. Yet, the Florida statute allows petitioner to reassert a substantial property right in the idea, thereby constricting the spectrum of useful public knowledge.

That the Florida statute does not remove all means of reproduction and sale does not eliminate the conflict with the federal scheme. In essence, the Florida law prohibits the entire public from engaging in a form of reverse engineering of a product in the public domain. This is clearly one of the rights vested in the federal patent holder, but has never been a part of state protection under the law of unfair competition or trade secrets.

It is for Congress to determine if the present system of design and utility patents is ineffectual in promoting the useful arts in the context of industrial design. By offering patent-like protection for ideas deemed unprotected under the present federal scheme, the Florida

"My vast erudition on the subject allows me to formulate a highly technical and scrupulously accurate description of plug molding: Take a boat, turn it upside-down, and spread Silly Putty all over it; after you remove the goop, then turn it right-side-up, and pour silicone in the resulting space. Now, you have a new boat that is identical to the old boat. That is 'plug molding,' also known as 'hull splashing.'" David Nimmer, *Copyright and the Fall Line* 31 *Carozo Arts & Ent. L.J.* 803 (2013)

statute conflicts with the strong federal policy favoring free competition in ideas which do not merit patent protection. We therefore agree with the majority of the Florida Supreme Court that the Florida statute is preempted by the Supremacy Clause, and the judgment of that court is hereby affirmed.

Copyright Act

- (a) *Designs Protected.* –
- (1) *In general.* – The designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter.
 - (2) *Vessel features.* – The design of a vessel hull, deck, or combination of a hull and deck, including a plug or mold, is subject to protection under this chapter, notwithstanding section 1302(4).
- (b) *Definitions.* – For the purpose of this chapter, the following terms have the following meanings:
- (1) A design is “original” if it is the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.
 - (2) A “useful article” is a vessel hull or deck, including a plug or mold, which in normal use has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article which normally is part of a useful article shall be deemed to be a useful article.
 - (3) A “vessel” is a craft –
 - (A) that is designed and capable of independently steering a course on or through water through its own means of propulsion; and
 - (B) that is designed and capable of carrying and transporting one or more passengers.

Protection under this chapter shall not be available for a design that is –

- (1) not original;
- (2) staple or commonplace, such as a standard geometric figure, a

17 U.S.C. S 1301

Designs protected

Why am I including such extensive excerpts from a rarely used *sui generis* statute for boat designs? Wrong question! The right question is why Congress drafted such a detailed and extensive *sui generis* statute for boat designs. Pay close attention to the definitions.

17 U.S.C S 1302

Designs not subject to protection

familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;

- (3) different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;
- (4) dictated solely by a utilitarian function of the article that embodies it; or
- (5) embodied in a useful article that was made public by the designer or owner in the United States or a foreign country more than 2 years before the date of the application for registration under this chapter.

17 U.S.C § 1303

Revisions, adaptations, and rearrangements

Protection for a design under this chapter shall be available notwithstanding the employment in the design of subject matter excluded from protection under section 1302 if the design is a substantial revision, adaptation, or rearrangement of such subject matter. Such protection shall be independent of any subsisting protection in subject matter employed in the design, and shall not be construed as securing any right to subject matter excluded from protection under this chapter or as extending any subsisting protection under this chapter.

17 U.S.C § 1304

Commencement of protection

The protection provided for a design under this chapter shall commence upon the earlier of the date of publication of the registration under section 1313(a) or the date the design is first made public as defined by section 1310(b).

17 U.S.C § 1305

Term of protection

- (a) *In General.* – Subject to subsection (b), the protection provided under this chapter for a design shall continue for a term of 10 years beginning on the date of the commencement of protection under section 1304.
- (b) *Expiration.* – All terms of protection provided in this section shall run to the end of the calendar year in which they would otherwise expire.

17 U.S.C § 1308

Exclusive rights

The owner of a design protected under this chapter has the exclusive right to –

- (1) make, have made, or import, for sale or for use in trade, any useful article embodying that design; and
- (2) sell or distribute for sale or for use in trade any useful article embodying that design.

17 U.S.C § 1309

Infringement

- (b) *Acts of Sellers and Distributors.* – A seller or distributor of an infringing article who did not make or import the article shall be deemed to have infringed on a design protected under this chapter only if that person –
- (1) induced or acted in collusion with a manufacturer to make, or an importer to import such article, except that merely purchasing or giving an order to purchase such article in the ordinary course of business shall not of itself constitute such inducement or collusion; or
 - (2) refused or failed, upon the request of the owner of the design, to make a prompt and full disclosure of that person's source of such article, and that person orders or reorders such article after receiving notice by registered or certified mail of the protection subsisting in the design.
- (c) *Acts Without Knowledge.* – It shall not be infringement under this section to make, have made, import, sell, or distribute, any article embodying a design which was created without knowledge that a design was protected under this chapter and was copied from such protected design.
- (d) *Acts in Ordinary Course of Business.* – A person who incorporates into that person's product of manufacture an infringing article acquired from others in the ordinary course of business, or who, without knowledge of the protected design embodied in an infringing article, makes or processes the infringing article for the account of another person in the ordinary course of business, shall not be deemed to have infringed the rights in that design under this chapter except under a condition contained in paragraph (1) or (2) of subsection (b). Accepting an order or reorder from the source of the infringing article shall be deemed ordering or reordering within the meaning of subsection (b)(2).
- (e) *Infringing Article Defined.* – As used in this section, an "infringing article" is any article the design of which has been copied from a design protected under this chapter, without the consent of the owner of the protected design. An infringing article is not an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium. A design shall not be deemed to have been copied from a protected design if it is original and not substantially similar in appearance to a protected design.
- (g) *Reproduction for Teaching or Analysis.* – It is not an infringement of the exclusive rights of a design owner for a person to reproduce the design in a useful article or in any other form solely for the purpose of teaching, analyzing, or evaluating the appear-

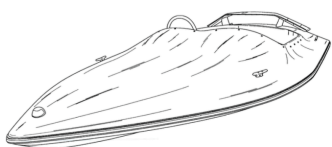
17 U.S.C § 1310**Application for registration**

FIG. 3

Library of Congress
Received
FEB 13 2012
U.S. Copyright Office
900 7001

Diagram from vessel hull registration
DVH0507 (2012)

17 U.S. Code § 1313**Examination of application and issue or refusal of registration****17 U.S.C § 1329****Relation to design patent law****418 F.3d 1186 (11th Cir. 2005)**

This is the only reported case alleging
infringement under the VHDPA.



Pathfinder 2200 TRS (updated version
of design at issue)

ance, concepts, or techniques embodied in the design, or the function of the useful article embodying the design.

- (a) *Time Limit for Application for Registration.* – Protection under this chapter shall be lost if application for registration of the design is not made within 2 years after the date on which the design is first made public.
- (h) *Pictorial Representation of Design.* – The application for registration shall be accompanied by two copies of a drawing or other pictorial representation of the useful article embodying the design, having one or more views, adequate to show the design, in a form and style suitable for reproduction, which shall be deemed a part of the application.
- (a) *Determination of Registrability of Design; Registration.* – Upon the filing of an application for registration in proper form under section 1310, and upon payment of the fee prescribed under section 1316, the Administrator shall determine whether or not the application relates to a design which on its face appears to be subject to protection under this chapter, and, if so, the Register shall register the design. Registration under this subsection shall be announced by publication. The date of registration shall be the date of publication.

The issuance of a design patent for an original design for an article of manufacture shall terminate any protection of the original design under this chapter.

Maverick Boat Co., Inc. v. American Marine Holdings, Inc.

Maverick, AMH, and Blazer are manufacturers of recreational boats, and each company manufactures a boat known as the “bay boat.” Maverick introduced its Pathfinder 2200 V–Hull bay boat at its July 1998 dealer meeting, and it sold more than 30 of these boats that same year. Following this initial sale, however, Maverick became aware of problems with the boat’s tooling. Specifically, Maverick became aware of customer complaints about the “sheer line” (the intersection of the hull sides with the top of the boat’s deck) on the boat. Paul Ellig, who was primarily responsible for correcting the sheer line, testified at trial that the irregularities in the boat’s lines were not intended to be present in the original boat and, thus, were the result of mistakes.

Because the sheer line was off, other boat lines, including the “style line” (the offset made on the hull sides to establish a unique graphic form or signature of the model or brand name) and the “chine line” (the line formed by the intersection of the hull lines with the

bottom of the boat), were also off. Ellig testified that once an element of a boat is changed because of an irregularity, other aspects of the boat are also affected. Maverick corrected these lines in a “revised design.” However, at trial, Maverick did not introduce any records to show the changes that it made to any of the boat’s lines: Maverick did not introduce any internal memoranda, drawings, correspondence, or documents of any kind that refer to the “revised design.”

For a period of time after the original model had been retooled, both the “original design” and the “revised design” were in production. On or about May 4, 1999, Maverick began shipping boats with the revised design. The name and model number of the boat remained the same, and Maverick’s advertisements never mentioned the design change. Also, during the time that Maverick sold both the “original design” and the “revised design,” it never informed its dealers or the public which design they were obtaining.

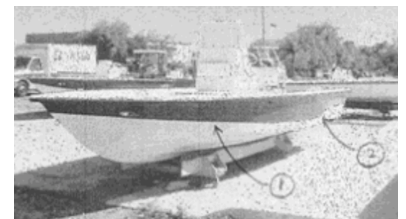
On February 27, 2001, Maverick submitted the application for Registration Number DVH 0049 to the United States Copyright Office. Maverick admitted in its pleadings that pursuant to 17 U.S.C. § 1302(5), DVH 0049 is invalid because it was for the “original design,” which was made public more than two years prior to the date of its application.

On April 10, 2001, Maverick submitted a second application, for the Pathfinder 2200 V-Hull, Registration Number DVH 0056, to the United States Copyright Office. The registration states that the design is a “new improved version of earlier design. Revised original hull (forward) shape, style line location.” Leffew photographed a Pathfinder 2200 V-Hull and submitted the photographs with the application for DVH 0056. But, Leffew did not know the model year of the boat depicted in the photographs that he submitted. In fact, when Leffew photographed the boats for each application, he did not know whether he was photographing a boat with an original or revised design.

During the summer of 2001, Maverick learned that AMH was marketing a boat with a vessel hull that appeared to have been copied from a Pathfinder 2200 V-Hull. Maverick asked Lee Dana, an architect and small craft designer, to analyze the respective hull designs and make a determination as to their similarities. On December 3, 2001, Dana sent a letter to Maverick stating, in part, that “it is very probable that the mold for the 22 Pro-Line was ‘back cast’ from a 22 Pathfinder Hull.” [Similarly for Blazer’s 2220 bay boat.]

A. Cancellation of DVH 0056

Maverick argued in the district court (as it does here) that its revised design is a substantial revision of the original design and, thus, that it is entitled to protection pursuant to 17 U.S.C. § 1303. The district



Photograph of Pathfinder 2200 from registration no. DVH 0056



Blazer 2200

court disagreed and specifically found that the design Maverick registered in DVH 0056 was not a “substantial revision, adaptation, or rearrangement” of the original Pathfinder 2200 V–Hull design as required by 17 U.S.C. § 1303.

The district court correctly determined that the changes made to the original design were merely corrections to a mistake, and not substantial. AMH and Blazer’s expert witness, Augusto Villalon, testified that the changes made to the original design were minimal (such as straightening the sheer line) and that they did not affect the design of the boat. Maverick did not proffer any expert testimony as to the differences between the two boats. In fact, Maverick did not attempt to secure an original design to compare it with a revised design, and it did not point to any specific differences between the two boats – either apparent to the naked eye or based on specific measurements – that would demonstrate the extent of the differences in the two designs. Moreover, Maverick failed to introduce any records to reflect the actual changes between the original design and the alleged revised design; there was no change made to the name of the boat or the model number of the boat; the two boats were held out to the public as the same boat; nothing in Maverick’s advertising indicated that there was an original and a revised design; and Maverick sold both versions simultaneously without any representation that one was an original design and the other a revised design.

We conclude that the district court was correct in finding that the changes made by Maverick to the original Pathfinder 2200 V–Hull design were merely corrections to a mistake. In fact, the correction of an unintended problem does not create a new design, but merely makes the original design what it was always intended to be. Accordingly, we agree with the district court’s finding that Maverick is not entitled to the protection offered by the VHDPA for DVH 0056.

B. AMH and Blazer’s Infringement

Because we agree with the district court that Maverick’s Pathfinder 2200 V–Hull design is not protected under the VHDPA, we need not address Maverick’s infringement claim. The district court, however, addressed it for the sake of argument; so, we will discuss it briefly. [The district court had written:

There is no dispute that AMH and Blazer used the Pathfinder 2200 V–Hull as a starting point for the development of the allegedly infringing boat. However, this fact alone does not constitute infringement. There are ten differences between the Pathfinder 2200 V–Hull and the Pro–Line 22. Mr. Deal himself testified that there are a number of differences between the decks of the Pathfinder

2200 V-Hull and the Pro-Line 22. These differences include: the cockpit sole was raised by two inches at the aft end, an anchor compartment was added, the aft platform was raised and its compartments redesigned, and the entire deck surface was covered with a special non-skid material. In addition to the differences in the deck, the hull of the Pro-Line 22 is six inches longer than the hull of the Pathfinder 2200 V-Hull. The changes AMH made in getting from the Pathfinder 2200 V-Hull as its starting point to the Pro-Line 22 demonstrate that the Pro-Line 22 is an original and is “not substantially similar in appearance” to the allegedly protected design of the Pathfinder 2200 V-Hull, particularly where the protected design includes the deck of the vessel.]

After reviewing the record, we cannot say that those findings are clearly erroneous. In fact, the evidence at trial clearly showed that the differences between the hulls of AMH’s Pro-Line 22 and Maverick’s Pathfinder 2200 V-Hull were substantially greater than the minimal differences between the designs in Maverick’s invalid DVH 0049 and DVH 0056. Thus, at a minimum, Maverick cannot credibly claim that DVH 0056 is valid over the admittedly invalid DVH 0049, while at the same time claiming that AMH’s accused boat (which is substantially different) is an infringement of DVH 0056.

F Fashion

Fashion offers a fascinating case study in the limits of the various techniques for protecting designs. This section finishes with materials on a proposed fashion-specific legal regime. Does it solve the recurring problems of design law, or just create new ones?

1 Copyright

Jack Adelman, Inc. v. Sonners & Gordon, Inc.

The bill of complaint alleges that the defendants have infringed plaintiff’s copyright of a drawing of a dress by making and selling a dress like the one in plaintiff’s drawing.

Does the copyright of a drawing of a dress give the owner of that copyright the exclusive monopoly to produce the dress itself? This depends solely upon the extent of the rights secured by the copyright owner upon filing his drawing in the copyright office.

Plaintiff stated in its application that it was filing a drawing for registration. The dress itself could hardly be classed as work of art

Congress responded to *Maverick Boat* by amending the VHDPA to clarify that it applies to “a vessel hull or deck.” Where does that leave the test for infringement under the VHDPA?

112 F. Supp. 187 (S.D.N.Y. 1934)

and filed in the Register's office. Moreover, [a Copyright Office regulation] lists "garments" among those articles in which "The exclusive right to make and sell ... should not be sought by copyright registration." All the plaintiff could accomplish under this section was to register its drawing, and unless we read into the statute something which is not there plaintiff secured no exclusive monopoly of the dress shown in the drawing. This seems clear if it be kept in mind that it is the drawing which is assumed to be a work of art and not the dress. It follows that plaintiff's copyright gives it the exclusive right to make copies or reprints of the drawing only, and that it gives the copyright owner no monopoly of the article illustrated.

Bracken: 151 F. 136 (C.C. N.D. Ill. 1907)

Plaintiff cites *Bracken v. Rosenthal* which held that a photograph of a copyrighted piece of sculpture was an infringement. But the distinction is plain. A dress is not copyrightable. A picture of a dress is; and the statute expressly includes sculpture.

35 F.2d 279 (2d Cir. 1929)

(Learned Hand, J.)

Cheney Bros. v. Doris Silk Corporation

The plaintiff, a corporation, is a manufacturer of silks, which puts out each season many new patterns, designed to attract purchasers by their novelty and beauty. Most of these fail in that purpose, so that not much more than a fifth catch the public fancy. Moreover, they have only a short life, for the most part no more than a single season of eight or nine months. It is in practice impossible, and it would be very onerous if it were not, to secure design patents upon all of these; it would also be impossible to know in advance which would sell well, and patent only those. Besides, it is probable that for the most part they have no such originality as would support a design patent. Again, it is impossible to copyright them under the Copyright Act, or at least so the authorities of the Copyright Office hold. So it is easy for any one to copy such as prove successful, and the plaintiff, which is put to much ingenuity and expense in fabricating them, finds itself without protection of any sort for its pains.

Taking advantage of this situation, the defendant copied one of the popular designs in the season beginning in October, 1928, and undercut the plaintiff's price.

The plaintiff asks for protection only during the season, and needs no more, for the designs are all ephemeral. It seeks in this way to disguise the extent of the proposed innovation, and to persuade us that, if we interfere only a little, the solecism, if there be one, may be pardonable. But the reasoning which would justify any interposition at all demands that it cover the whole extent of the injury. A man whose designs come to harvest in two years, or in five, has *prima facie* as good right to protection as one who deals only in annuals. Nor could we consistently stop at designs; processes, machines, and secrets have an equal claim. The upshot must be that, whenever any

one has contrived any of these, others may be forbidden to copy it. That is not the law. In the absence of some recognized right at common law, or under the statutes — and the plaintiff claims neither — a man's property is limited to the chattels which embody his invention. Others may imitate these at their pleasure.

True, it would seem as though the plaintiff had suffered a grievance for which there should be a remedy, perhaps by an amendment of the Copyright Law, assuming that this does not already cover the case, which is not urged here. It seems a lame answer in such a case to turn the injured party out of court, but there are larger issues at stake than his redress. Judges have only a limited power to amend the law; when the subject has been confided to a Legislature, they must stand aside, even though there be an hiatus in completed justice. An omission in such cases must be taken to have been as deliberate as though it were express, certainly after long-standing action on the subject-matter. Indeed, we are not in any position to pass upon the questions involved. We must judge upon records prepared by litigants, which do not contain all that may be relevant to the issues, for they cannot disclose the conditions of this industry, or of the others which may be involved. Congress might see its way to create some sort of temporary right, or it might not. Its decision would certainly be preceded by some examination of the result upon the other interests affected. Whether these would prove paramount we have no means of saying; it is not for us to decide. Our vision is inevitably contracted, and the whole horizon may contain much which will compose a very different picture.

Fashion Originators' Guild of America v. Federal Trade Commission

312 U.S. 457 (1941)

The Circuit Court of Appeals, with modifications not here challenged, affirmed a Federal Trade Commission decree ordering petitioners to cease and desist from certain practices found to have been done in combination and to constitute "unfair methods of competition" tending to monopoly.

Some of the members of the combination design, manufacture, sell and distribute women's garments — chiefly dresses. Others are manufacturers, converters or dyers of textiles from which these garments are made. Fashion Originators' Guild of America (FOGA), an organization controlled by these groups, is the instrument through which petitioners work to accomplish the purposes condemned by the Commission. The garment manufacturers claim to be creators of original and distinctive designs of fashionable clothes for women, and the textile manufacturers claim to be creators of similar original fabric designs. After these designs enter the channels of trade, other manufacturers systematically make and sell copies of them, the copies usually selling at prices lower than the garments copied. Peti-



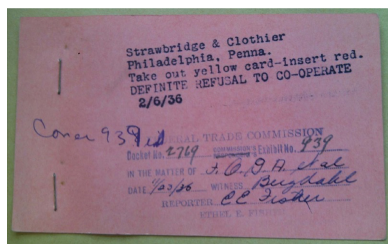
Fashion Originators Guild registration

tioners call this practice of copying unethical and immoral, and give it the name of "style piracy." And although they admit that their "original creations" are neither copyrighted nor patented, and indeed assert that existing legislation affords them no protection against copyists, they nevertheless urge that sale of copied designs constitutes an unfair trade practice and a tortious invasion of their rights. Because of these alleged wrongs, petitioners, while continuing to compete with one another in many respects, combined among themselves to combat and, if possible, destroy all competition from the sale of garments which are copies of their "original creations." They admit that to destroy such competition they have in combination purposely boycotted and declined to sell their products to retailers who follow a policy of selling garments copied by other manufacturers from designs put out by Guild members. As a result of their efforts, approximately 12,000 retailers throughout the country have signed agreements to "cooperate" with the Guild's boycott program, but more than half of these signed the agreements only because constrained by threats that Guild members would not sell to retailers who failed to yield to their demands – threats that have been carried out by the Guild practice of placing on red cards the names of noncooperators (to whom no sales are to be made), placing on white cards the names of cooperators (to whom sales are to be made), and then distributing both sets of cards to the manufacturers.



Fashion Originators Guild label

The one hundred and seventy-six manufacturers of women's garments who are members of the Guild occupy a commanding position in their line of business. In 1936, they sold in the United States more than 38% of all women's garments wholesaling at \$6.75 and up, and more than 60% of those at \$10.75 and above. The power of the combination is great; competition and the demand of the consuming public make it necessary for most retail dealers to stock some of the products of these manufacturers. And the power of the combination is made even greater by reason of the affiliation of some members of the National Federation of Textiles, Inc. – that being an organization composed of about one hundred textile manufacturers, converters, dyers, and printers of silk and rayon used in making women's garments. Those members of the Federation who are affiliated with the Guild have agreed to sell their products only to those garment manufacturers who have in turn agreed to sell only to cooperating retailers.



Fashion Originators Guild red card

The Guild maintains a Design Registration Bureau for garments, and the Textile Federation maintains a similar Bureau for textiles. The Guild employs 'shoppers' to visit the stores of both cooperating and non-cooperating retailers, for the purpose of examining their stocks, to determine and report as to whether they contain copies of registered designs. An elaborate system of trial and appellate tribunals exists, for the determination of whether a given garment is in fact a

copy of a Guild member's design. In order to assure the success of its plan of registration and restraint, and to ascertain whether Guild regulations are being violated, the Guild audits its members books. And if violations of Guild requirements are discovered, as, for example, sales to red-carded retailers, the violators are subject to heavy fines.

Paragraph 3 of the Clayton Act declares "It shall be unlawful for any person engaged in commerce to make a sale or contract for sale of goods on the condition, agreement or understanding that the purchaser thereof shall not use or deal in the goods of a competitor or competitors of the seller, where the effect of such sale, or contract for sale may be to substantially lessen competition or tend to create a monopoly in any line of commerce." The relevance of this section of the Clayton Act to petitioners' scheme is shown by the fact that the scheme is bottomed upon a system of sale under which (1) textiles shall be sold to garment manufacturers only upon the condition and understanding that the buyers will not use or deal in textiles which are copied from the designs of textile manufacturing Guild members; (2) garment manufacturers shall sell to retailers only upon the condition and understanding that the retailers shall not use or deal in such copied designs. And the Federal Trade Commission concluded in the language of the Clayton Act that these understandings substantially lessened competition and tended to create a monopoly. We hold that the Commission, upon adequate and unchallenged findings, correctly concluded that this practice constituted an unfair method of competition.

Not only does the plan in the respects above discussed thus conflict with the principles of the Clayton Act; the findings of the Commission bring petitioners' combination in its entirety well within the inhibition of the policies declared by the Sherman Act itself. Section 1 of that Act makes illegal every contract, combination or conspiracy in restraint of trade or commerce among the several states; Section 2 makes illegal every combination or conspiracy which monopolizes or attempts to monopolize any part of that trade or commerce. And among the many respects in which the Guild's plan runs contrary to the policy of the Sherman Act are these: it narrows the outlets to which garment and textile manufacturers can sell and the sources from which retailers can buy; subjects all retailers and manufacturers who decline to comply with the Guild's program to an organized boycott; takes away the freedom of action of members by requiring each to reveal to the Guild the intimate details of their individual affairs; and has both as its necessary tendency and as its purpose and effect the direct suppression of competition from the sale of unregistered textiles and copied designs.

But petitioners further argue that their boycott and restraint of in-

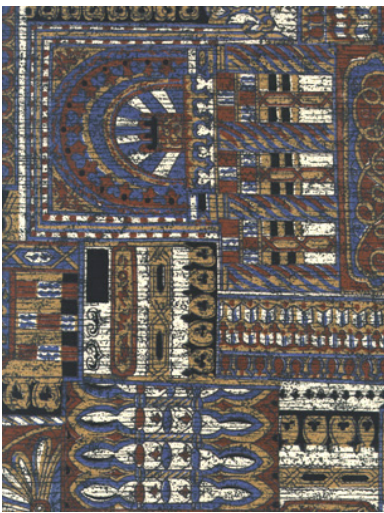
15 U.S.C. § 14

15 U.S.C. §§ 1, 2

In the proceedings below, Judge Learned Hand wrote for the Second Circuit, "The author of a design for a dress should be deemed to be on the same footing as the author of a drawing or a picture; and the author of a drawing or a picture has a "common-law property" in its reproduction. While we have been unable to discover any case which squarely presented the situation -- that is, in which "intellectual property", not covered by the copyright act then in existence, was challenged because of its "publication" -- there are plenty of general expressions in the books that the "common-law property" does not survive. We conclude therefore that, regardless of whether the Guild's designs could be registered or not, "publication" of them was a surrender of all its "common-law property" in them."

terstate trade is not within the ban of the policies of the Sherman and Clayton Acts because "the practices of FOGA were reasonable and necessary to protect the manufacturer, laborer, retailer and consumer against the devastating evils growing from the pirating of original designs and had in fact benefited all four." The Commission declined to hear much of the evidence that petitioners desired to offer on this subject. As we have pointed out, however, the aim of petitioners' combination was the intentional destruction of one type of manufacture and sale which competed with Guild members. The purpose and object of this combination, its potential power, its tendency to monopoly, the coercion it could and did practice upon a rival method of competition, all brought it within the policy of the prohibition declared by the Sherman and Clayton Acts. Under these circumstances it was not error to refuse to hear the evidence offered, for the reasonableness of the methods pursued by the combination to accomplish its unlawful object is no more material than would be the reasonableness of the prices fixed by unlawful combination.

169 F. Supp. 142 (S.D.N.Y. 1959)



Peter Pan's fabric

Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.

Plaintiff Peter Pan Fabrics has obtained certificate of copyright covering a design printed upon dress fabric. The design is known as "Style 680, Range 1, Byzantium". Defendant is producing and selling a printed fabric almost indistinguishable from plaintiff's.

The problem to be decided is whether a design printed upon dress fabric is a proper subject of copyright. In *Bleistein*, Mr. Justice Holmes dispelled the idea that the word "art" in the Copyright Act imported any idea of merit or high degree or appeal to the better educated classes. In *Mazer*, Mr. Justice Reed said in the opinion of the court:

It is clear Congress intended the scope of the copyright statute to include more than the traditional fine arts. Herbert Putnam, Esq., then Librarian of Congress and active in the movement to amend the copyright laws, told the joint meeting of the House and Senate Committees:

The term "works of art" is deliberately intended as a broader specification than "works of the fine arts" in the present statute with the idea that there is subject-matter (for instance, of applied design, not yet within the province of design patents), which may properly be entitled to protection under the copyright law.

In Dr. Putnam's statement before the joint meeting we have an authoritative construction of the term "works of art" in the Copyright Act as including "applied design". No better description of the sub-

ject matter of this litigation could be devised.

I therefore find that plaintiffs' design is a proper subject of copyright both as a work of art and as a print. It was described in the application for copyright as a work of art but that does not preclude sustaining its copyrightability on the ground that it is a print.

Varsity Brands, Inc. v. Star Athletica, LLC

Are cheerleading uniforms truly cheerleading uniforms without the stripes, chevrons, zigzags, and color blocks? That is the question that strikes at the heart of this appeal. Plaintiffs have registered copyrights for multiple graphic designs that appear on the cheerleading uniforms and warm-ups they sell. Defendant also sells cheerleading gear bearing graphic designs that, according to Varsity, are substantially similar to the designs for which Varsity has valid copyrights.

Question One: We begin our analysis by first identifying whether Varsity's designs are "pictorial, graphic, or sculptural works." Varsity's designs, for which they received copyright registration, are "two-dimensional works of ... graphic ... art."

Question Two: Are Varsity's designs "design[s] of ... useful article[s?]" Varsity's designs are sketches that depict cheerleading crop tops and skirts — the components of a cheerleading uniform. In other words, they are designs of cheerleading uniforms and sportswear, which have an "intrinsic utilitarian function that is not merely to portray the appearance of [clothing] or to convey information."

Question Three: What are the "utilitarian aspects" of cheerleading uniforms? Cheerleading uniforms have "an intrinsic utilitarian function," namely to cover the body, wick away moisture, and withstand the rigors of athletic movements. Star contends that cheerleading uniforms identify the wearer as a cheerleader and a member of a cheerleading team. But this is no different than saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer of the uniform is a cheerleader for a particular team. And therefore Star's purported utilitarian aspect of a cheerleading uniform is an impermissible factor.

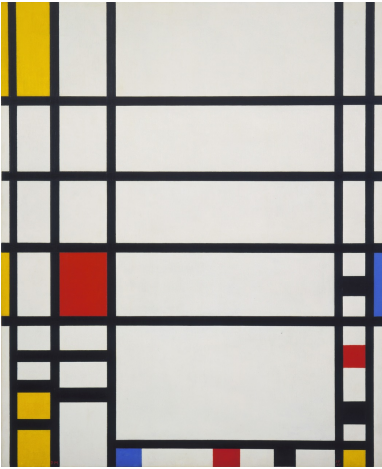
It also appears that Star makes one final argument as to why Varsity's graphic designs cannot "be identified separately from, and are [in]capable of existing independently of, the utilitarian aspects of the article": the designs' "decorative function" is one of the "utilitarian aspects" of a cheerleader uniform.

To the extent that Star contends that pictorial, graphic, or sculptural features are inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function, we reject that argument. Such a holding would render nearly all artwork unprotectable. Under this theory of functionality, Mondrian's painting would be unprotectable because the painting decorates the

799 F.3d 468 (6th Cir. 2015), cert granted, 136 S. Ct. 1823 (2016)



Varsity uniform design



Piet Mondrian, *Trafalgar Square* (1939–43)

room in which it hangs. But paintings are copyrightable. It would also render the designs on laminate flooring unprotectable because the flooring would be otherwise unattractive. But the Copyright Act protects flooring designs that hide wear or other imperfections in the product. And statuettes adorning the base of a lamp would not be copyrightable under this theory because they serve the function of decorating an otherwise boring lamp base. But they are copyrightable under certain circumstances. *Mazer* Finally, holding that the decorative function is a “utilitarian aspect[] of [an] article,” would make all fabric designs, which serve no other function than to make a garment more attractive, ineligible for copyright protection. But it is well-established that fabric designs are eligible for copyright protection. We therefore conclude that a pictorial, graphic, or sculptural work’s “decorative function” does not render it unable to “be identified separately from,” or “[in]capable of existing independently of, the utilitarian aspects of the article.”

Question Four: Can we identify pictorial, graphic, or sculptural features separately from the parts of the cheerleading-uniform design, which cover the body, permit free movement, and wick moisture? We can identify graphic features of Varsity’s designs — the arrangement of stripes, chevrons, zigzags, and color-blocking. The district court concluded that these graphic features are not separately identifiable from a cheerleading uniform because a cheerleading uniform “without team colors stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular, is not recognizable as a cheerleading uniform.” We disagree. First, Varsity’s graphic designs do not enhance the cheerleading uniform’s functionality qua clothing. A plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip. The top and skirt are still easily identified as cheerleading uniforms without any stripes, chevrons, zigzags, or color-blocking. Moreover, the record establishes that not all cheerleading uniforms must look alike to be cheerleading uniforms. The five Varsity designs are examples of how a cheerleading uniform still looks like a cheerleading uniform no matter how different the arrangement of the stripes, chevrons, colorblocks, and zigzags appear on the surface of the uniform. All of Varsity’s graphic designs are interchangeable. Varsity’s customers choose among the designs in the catalog, including the five designs at issue, select one of the designs, and then customize the color scheme. The interchangeability of Varsity’s designs is evidence that customers can identify differences between the graphic features of each design, and thus a graphic design and a blank cheerleading uniform can appear “side by side” — one as a graphic design, and one as a cheerleading uniform. We therefore conclude that each of these graphic design concepts can be identified separately

from the utilitarian aspects of the cheerleading uniform.

Question Five: Can the arrangement of stripes, chevrons, color blocks, and zigzags "exist[] independently of" the utilitarian aspects of a cheerleading uniform? We believe they can. Varsity's designers sketch their designs and select, place, and arrange various graphic elements, such as stripes, lines, chevrons, inverted chevrons, angles, curves, coloring, and shapes. Varsity's production department either applies these graphic designs onto cheerleading uniforms or recreates the designs by sewing panels of fabric together. Varsity's designs may be incorporated onto the surface of a number of different types of garments, including cheerleading uniforms, practice wear, t-shirts, warm-ups, and jackets, among other things. This evidence establishes that the designs are transferrable to articles other than the traditional cheerleading uniform (crop top and skirt). In addition, the interchangeability of Varsity's various designs is evidence that the graphic design on the surface of the uniform does not affect whether the uniform still functions as a cheerleading uniform. Indeed, nothing (save perhaps good taste) prevents Varsity from printing or painting its designs, framing them, and hanging the resulting prints on the wall as art. We therefore conclude the arrangement of stripes, chevrons, color blocks, and zigzags are wholly unnecessary to the performance of the garment's ability to cover the body, permit free movement, and wick moisture.

Because we conclude that the graphic features of Varsity's designs "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of [cheerleading uniforms]," we hold that Varsity's graphic designs are copyrightable subject matter. This conclusion is faithful to the statutory text of the Copyright Act and consistent with other courts' treatment of the protectability of clothing and the pictorial and graphic features that appear on clothing under the Copyright Act. Courts have drawn a line between "fabric design" and "dress design." "Fabric designs" are "designs imprinted on a fabric, such as a rose petal, which in a completed dress may appear repeatedly throughout the dress fabric, or may appear but once on a given dress." *Nimmer*. Take the work of Piet Mondrian, for example. Mondrian's artwork or design is separable as a work of art because not only is it possible to recreate the design on t-shirts, grocery bags, cellphone cases, or notebooks, but also it actually has been done: Yves St. Laurent used Mondrian's famous color-blocking and thick, black stripes to create cocktail dresses known as the "Mondrian look." Mondrian's arrangement of color blocks and use of stripes are pictorial and graphic features "that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of" Yves St. Laurent's dress.

In contrast, it is impossible either physically or conceptually to



YSL Mondrian dresses

separate a “dress design,” which “graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment,” from the utilitarian aspects of clothing, i.e., to cover, protect, and warm the body. *Nimmer* The shapes of the neckline (v-neck, square-neck, crew-neck), sleeves (short, long, puffy), skirt shape (a-line, pencil, midi, maxi), trouser cut (pleated, plain-front, cuffed), or pockets (patch, welt, jetted) – these are the components of a design that are inextricably connected with the utilitarian aspects of clothing: pockets store pencils or pens; pants and skirts cover the legs; shirts cover the torso modestly or less modestly depending on the neckline. The designs of these components of an article of clothing “can[not] be identified separately from, [or be] capable of existing independently of, the utilitarian aspects of the article [of clothing].”

The Copyright Act protects fabric designs, but not dress designs. A designer may obtain valid copyrights for “a multicolored striped sweater with puffy leaf appliques” and a cardigan, “which has a squirrel and leaves appliqued onto its multipaneled front.” *Knitwaves, Inc. v. Lollytogs Ltd.* The sweater has a utilitarian function — to provide warm cover for the torso and arms — and the sweaters still perform that function without the leaf or squirrel designs. Similarly, the design of a rose and “the placement of that rose repeated in horizontal rows against an ornate background” on fabric receive copyright protection. *Folio Impressions, Inc. v. Byer Cal.* But the creative arrangement of sequins, beads, ribbon, and tulle, which form the bust, waistband of a dress, do not qualify for copyright protection because each of these elements (bust, waistband, and skirt) all serve to clothe the body. *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.* And a collection of uniforms, which includes chef hats shaped like vegetables, tuxedo jackets with a “distinctive shawl collar styling with a deep V neckline,” and semi-fitted jackets with princess seams and star buttons, does not receive copyright protection. *Galiano v. Harrah’s Operating Co., Inc.* Creative and arguably attractive as these articles may be, they are merely inventive designs used to cover the wearer’s body and hair. Thus, the design of these hats and jackets (useful articles) “can[not] be identified separately from,” and are not “capable of existing independently of, the utilitarian aspects of” a hat or a jacket.

Because we believe that the graphic features of Varsity’s cheerleading-uniform designs are more like fabric design than dress design, we hold that they are protectable subject matter under the Copyright Act. We therefore enter summary judgment for Varsity solely on the issue of the protectability of Varsity’s designs as pictorial, graphic, or sculptural works. We express no opinion about whether Varsity’s designs are ineligible for copyright protection be-

Knitwaves: 71 F.3d at 996 (2d Cir. 1995)



Sweater from *Knitwaves*

Folio Impressions: 937 F.2d 759 (2d Cir. 1991)

Jovani: 808 F. Supp. 2d 542 (S.D.N.Y. 2011)

Galiano: 416 F.3d 411 (5th Cir. 2005)

cause they lack originality or any other reason.

McKEAGUE, Circuit Judge, dissenting.

I agree with the majority's general approach. We first define the work's function and then ask whether the claimed elements can be identified separately from, or exist independently of, that function. I depart with the majority's analysis, however, in how the function of these designs is defined. I would hold that there is no conceptual separability and that Varsity's designs are not copyrightable. I therefore dissent.

Function. The majority explains that the function of a cheerleading uniform is to wick away moisture and "permit the wearer to cheer, jump, kick, and flip." That broad definition could be used to describe all athletic gear. But the particular athletic uniforms before us serve to identify the wearer as a cheerleader. Without stripes, braids, and chevrons, we are left with a blank white pleated skirt and crop top. As the district court recognized, the reasonable observer would not associate this blank outfit with cheerleading. This may be appropriate attire for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad.

Clothing provides many functions, but a uniform at its core identifies its wearer as a member of a group. It follows that the stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function. The majority rejects this categorization because this holding would purportedly "render nearly all artwork unprotectable." That's not true. It renders unprotectable only artwork that is integral to an item's utilitarian function. In defining that function, we are confined by caselaw and by common sense. Take a dresser, for example. The function of a dresser is to store clothes and other articles. Any ornamental designs displayed on the surface of a dresser are not integral to that function. Those ornamental designs would therefore be copyrightable. In contrast, a painting is not subject to the separability analysis because it does not qualify as a "useful article."

Separability. Once function is properly defined, it logically follows: the placement of the stripes, braids, and chevrons is not separable from that function. In *Jovani*, in relation to a prom dress, the court excluded from copyright "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching on the dress waist; and layers of tulle on the skirt." Here, as in that case, there is no evidence that Varsity's designers exercised artistic judgment independently of functional influences, rather than as a merger of aesthetic and functional considerations. In both cases, the designers' aesthetic considerations merged with functional concerns: to cover the body in an attractive way for a special occasion, and to identify the

wearer as a member of a particular cheerleading squad. Without the stripes, braids, and chevrons, a blank shell of a cheerleading uniform would lose an important dimension of its functional utility.

It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess – and it has been for a long time. The majority takes a stab at sorting it out, and so do I. But until we get much-needed clarification, courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law.

2 Trademark

Christian Louboutin v. Yves Saint Laurent America

778 F. Supp. 2d 445 (S.D.N.Y. 2011)

Sometime around 1992 designer Christian Louboutin had a bright idea. He began coloring glossy vivid red the out-soles of his high fashion women's shoes. Whether inspired by a stroke of original genius or, as competitor YSL retorts, copied from King Louis XIV's red-heeled dancing shoes, or Dorothy's famous ruby slippers in "The Wizard of Oz," or other styles long available in the contemporary market – including those sold by YSL Christian Louboutin deviated from industry custom. In his own words, this diversion was meant to give his line of shoes "energy," a purpose for which he chose a shade of red because he regarded it as "engaging, flirtatious, memorable and the color of passion," as well as "sexy." In pursuit of the red sole's virtues, Louboutin invested substantial amounts of capital building a reputation and good will, as well as promoting and protecting Louboutin's claim to exclusive ownership of the mark as its signature in women's high fashion footwear.



Louboutin Pigalle red-sole shoe

Over the years, the high fashion industry responded. Christian Louboutin's bold divergence from the worn path paid its dividends. Louboutin succeeded to the point where, in the high-stakes commercial markets and social circles in which these things matter a great deal, the red outsole became closely associated with Louboutin. Leading designers have said it, including YSL, however begrudgingly. Film stars and other A-list notables equally pay homage, at prices that for some styles command as much as \$1,000 a pair. And even at that expense, a respectable niche of consumers wears the brand, to the tune of about 240,000 pairs a year sold in the United States, with revenues of approximately \$135 million projected for 2011. When Hollywood starlets cross red carpets and high fashion models strut down runways, and heads turn and eyes drop to the celebrities' feet, lacquered red outsoles on high-heeled, black shoes flaunt a glamorous statement that pops out at once. For those in the know, cognitive bulbs instantly flash to associate: "Louboutin." This recognition is

acknowledged, for instance, at least by a clientele of the well-heeled, in the words of a lyrical stylist of modern times:

Boy, watch me walk it out ... Walk this right up out the house I'm throwin' on my Louboutins ...

The PTO awarded a trademark with Registration No. 3,361,597 (the "Red Sole Mark") to Louboutin on January 1, 2008. The certificate of registration includes both a verbal description of the mark and a line drawing intended to show placement of the mark as indicated [in the margin.] The verbal description reads: "THE MARK CONSISTS OF A LACQUERED RED SOLE ON FOOTWEAR."

YSL, a fashion house founded in 1962, produces seasonal collections that include footwear. According to YSL, red outsoles have appeared occasionally in YSL collections dating back to the 1970s. Louboutin takes issue with four shoes from YSL's Cruise 2011 collection: the Tribute, Tribtoo, Palais and Woodstock models. Each of the challenged models bears a bright red outsole as part of a monochromatic design in which the shoe is entirely red (or entirely blue, or entirely yellow, etc.).

Courts have approved the use of a single color as a trademark for industrial products. *See, e.g., Qualitex* (green-gold for pads used on dry cleaning presses); *In re Owens-Corning Fiberglas Corp.* (pink for fibrous glass insulation). In some industrial markets the design, shape and general composition of the goods are relatively uniform, so as to conform to industry-wide standards. Steel bolts, fiber glass wall insulation and cleaning press pads, for example, are what they are regardless of which manufacturer produces them. The application of color to the product can be isolated to a single purpose: to change the article's external appearance so as to distinguish one source from another.

But, whatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs – the creativity, aesthetics, taste, and seasonal change – that define production of articles of fashion. That distinction may be readily visualized through an image of the incongruity presented by use of color in other industries in contrast to fashion. Can one imagine industrial models sashaying down the runways in displays of the designs and shades of the season's collections of wall insulation? The difference for Lanham Act purposes, as elaborated below, is that in fashion markets color serves not solely to identify sponsorship or source, but is used in designs primarily to advance expressive, ornamental and aesthetic purposes.

In the fashion industry, the Lanham Act has been upheld to permit the registration of the use of color in a trademark, but only in distinct patterns or combinations of shades that manifest a conscious

Jennifer Lopez, "Louboutins" (Epic Records 2009)



Line drawing from Louboutin's registration



YSL monochromatic Tribtoo in suede
Owens-Corning: 774 F.2d 1116 (Fed. Cir. 1985)

Euro Moda: No. 08 Civ. 5781, 2009 WL 1675080 (S.D.N.Y. June 10, 2009)

effort to design a uniquely identifiable mark embedded in the goods. See, e.g., , *Dooney & Bourke* ("LV" monogram combined in a pattern of rows with 33 bright colors); *Burberry Ltd. v. Euro Moda, Inc.* (registered Burberry check pattern entitled to statutory presumption of validity). In these cases the courts clearly point out that the approved trademark applies to color not as an abstract concept, or to a specific single shade, but to the arrangement of different colors and thus their synergy to create a distinct recognizable image purposely intended to identify a source while at the same time serving as an expressive, ornamental or decorative concept.

The narrow question presented here is whether the Lanham Act extends protection to a trademark composed of a single color used as an expressive and defining quality of an article of wear produced in the fashion industry. In other words, the Court must decide whether there is something unique about the fashion world that militates against extending trademark protection to a single color, although such registrations have sometimes been upheld in other industries.

To answer this question, and recognizing the fanciful business from which this lawsuit arises, the Court begins with a fanciful hypothetical. Suppose that Monet, having just painted his water lilies, encounters a legal challenge from Picasso, who seeks by injunction to bar display or sale of those works. In his complaint, Picasso alleges that Monet, in depicting the color of water, used a distinctive indigo that Picasso claims was the same or too close to the exquisite shade that Picasso declares is "the color of melancholy," the hallmark of his Blue Period, and is the one Picasso applied in his images of water in paintings of that collection. By virtue of his long-standing prior use of that unique tinge of blue in context, affirmed by its registration by the trademark office, Picasso asserts exclusive ownership of the specific tone to portray that color of water in canvas painting. Should a court grant Picasso relief?

The creative energies of painter and fashion designer are devoted to appeal to the same sense in the beholder and wearer: aesthetics. Both strive to please patrons and markets by creating objects that not only serve a commercial purpose but also possess ornamental beauty (subjectively perceived and defined). Quintessentially, both painting and fashion embrace matters of taste. In consequence, they share vicissitudes natural to any matter of palate or palette. They change as the seasons change. Styles, features, whole lines come and go with passing likes and dislikes, to be replaced by new articles with origins from regions where genius charts a different course. Items fall in and out of fashion in all nuances of the word, conveying not only currency but seasonality and transience. Perhaps capturing something of that relative inconstancy, painting and fashion share a vocabulary. They speak in ethereal terms like fanciful, inventive, eccentric, whimsical,

visionary, and, to quote Louboutin again, “engaging, flirtatious” – all words which also have in common an aim to evoke and affect things of the moment.

These creative means also share a dependence on color as an indispensable medium. Color constitutes a critical attribute of the goods each form designs. Alone, in combinations, in harmonious or even incongruous blends, in varying patterns and shapes, the whole spectrum of light serves as a primal ingredient without which neither painting nor fashion design as expressive and ornamental art would flourish. For, color depicts elemental properties. As it projects expression of the artist’s mental world, it captures the mutability, the fancy, the moods of the visual world, in both spheres working as a means to execute singular concepts born of imagination for which not just any other shade will do. Hence, color in this context plays a unique role. It is a feature purposely given to an article of art or design to depict the idea as the creator conceived it, and to evoke an effect intended. In ornamenting, it draws attention to itself, and to the object for which its tone forms a distinct expressive feature. From these perspectives, color in turn elementally performs a creative function; it aims to please or be useful, not to identify and advertise a commercial source.

But, as an offshoot of color, perhaps most crucial among the features painting and fashion design share as commerce and art, are two interrelated qualities that both creative fields depend upon to thrive, and indeed to survive: artistic freedom and fair competition. In both forms, the greatest range for creative outlet exists with its highest, most vibrant and all-encompassing energies where every pigment of the spectrum is freely available for the creator to apply, where every painter and designer in producing artful works enjoys equal freedom to pick and choose color from every streak of the rainbow. The contrary also holds. Placing off limit signs on any given chromatic band by allowing one artist or designer to appropriate an entire shade and hang an ambiguous threatening cloud over a swath of other neighboring hues, thus delimiting zones where other imaginations may not veer or wander, would unduly hinder not just commerce and competition, but art as well.

No one would argue that a painter should be barred from employing a color intended to convey a basic concept because another painter, while using that shade as an expressive feature of a similar work, also staked out a claim to it as a trademark in that context. If as a principle this proposition holds as applied to high art, it should extend with equal force to high fashion. The law should not countenance restraints that would interfere with creativity and stifle competition by one designer, while granting another a monopoly invested with the right to exclude use of an ornamental or functional medium

necessary for freest and most productive artistic expression by all engaged in the same enterprise.

The question of whether the use of a single color in the fashion industry can constitute a valid mark necessarily raises another one: whether a single color may be “functional” in that context. Use of a single color has been held functional, and therefore not protectable under the Lanham Act, in other contexts. *See, e.g., Brunswick Corp* (black for marine outboard engines held functional because it is “compatible with a wide variety of boat colors and [can] make objects appear smaller”); *Deere & Co. v. Farmhand, Inc.* (green for farm equipment held functional because farmers “prefer to match their loaders to their tractor”), These cases illustrate the principle that aesthetic appeal can be functional; often we value products for their looks.

Deere: 560 F.Supp. 85 (S.D. Iowa 1982)

"The 'classic' aesthetic functionality cases are actually about cognitive or psychological responses in consumers, not aesthetics per se. Based on that observation, I propose that aesthetic functionality should only be found by courts when the product feature at issue triggers a positive cognitive, psychological, or aesthetic response among a substantial composite of the relevant consumers and that response predates the trademark owner's activities." Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 *Cardozo L. Rev.* 1227 (2015)

Louboutin’s claim to “the color red” is, without some limitation, overly broad and inconsistent with the scheme of trademark registration established by the Lanham Act. Awarding one participant in the designer shoe market a monopoly on the color red would impermissibly hinder competition among other participants. YSL has various reasons for seeking to use red on its outsoles – for example, to reference traditional Chinese lacquer ware, to create a monochromatic shoe, and to create a cohesive look consisting of color-coordinating shoes and garments. Presumably, if Louboutin were to succeed on its claim of trademark infringement, YSL and other designers would be prohibited from achieving those stylistic goals. In this respect, Louboutin’s ownership claim to a red outsole would hinder competition not only in high fashion shoes, but potentially in the markets for other women’s wear articles as well. Designers of dresses, coats, bags, hats and gloves who may conceive a red shade for those articles with matching monochromatic shoes would face the shadow or reality of litigation in choosing bands of red to give expression to their ideas.

The effects of this specter – the uncertainty and apprehension it generates – are especially acute in the fashion industry because of its grounding on the creative elements discussed above. Fashion is dependent on colors. It is subject to temporal change. It is susceptible to taste, to idiosyncrasies and whims and moods, both of designers and consumers. Thus, at any moment when the market and the deities of design, by whatever fancy they decide those things, proclaim that “passion” is in for a given season and must be expressed in reds in the year’s various collections, Louboutin’s claim would cast a red cloud over the whole industry, cramping what other designers could do, while allowing Louboutin to paint with a full palette.

Louboutin would thus be able to market a total outfit in his red, while other designers would not. And this impediment would apply not just with respect to Louboutin’s registered “the color red,” but,

on its theory as pressed in this litigation, to a broader band of various other shades of red which would be available to Louboutin but which it could bar others from using.

Louboutin asserts that it is the color depicted in the registration's drawing, and not the verbal reference to the "color red," that controls. In its reply brief, Louboutin identified that color for the first time as Pantone No. 18-1663 TP, or "Chinese Red," part of the PANTONE TEXTILE color system. Yet that identification raises additional issues. Louboutin cannot amend or augment its PTO registration by representations it makes in this litigation. Accordingly, the color that governs here remains, as Louboutin points out, the shade of red depicted in the registration's drawing. As Louboutin concedes, however, because of varying absorption and reflection qualities of the material to which it is applied, a color as it manifests on paper would appear quite different – some lighter, some darker hues – on other mediums such as leather and cloth. A competitor examining the Louboutin registration drawing for guidance as to what color it applies to may therefore remain unable to determine precisely which shade or shades it encompasses and which others are available for it to safely use.

Moreover, YSL has represented to the Court that the precise color of the styles Louboutin challenges is not Chinese Red, and that YSL has never used Pantone No. 18-1663 TP on its outsoles. Undaunted, Louboutin insists that YSL has nonetheless infringed the Red Sole Mark because its challenged shoe models use a shade confusingly too close to Chinese Red. Yet Louboutin cannot provide a satisfactory explanation as to why those models – but not others previously made by YSL that also bear a red outsole – are confusingly similar to its claimed mark. The larger question this conflict poses is how close to a protected single color used in an item of fashion can the next competitor approach without encountering legal challenge from the first claimant of a shade as a trademark.

In response to this legal dilemma, Louboutin proposes that the Court simply draw a designated range both above and below the borderlines of Pantone No. 18-1663 TP, and declare all other stripes of red within that zone forbidden to competitors. Its suggested metric references *Olay Co., Inc. v. Cococare Prods., Inc.* (issuing injunction requiring infringer to use "a discernibly different pink, at least 40% different in terms of [Pantone Matching System] tones" from that used by registrant). Louboutin's proposal would have the effect of appropriating more than a dozen shades of red – and perhaps other colors as well⁶ – and goes far beyond the injunction upon which Louboutin

Olay: 218 U.S.P.Q. 1028 (S.D.N.Y. 1983)

⁶Louboutin's suggestion that the Court require other designers to stay some percentage away from Chinese Red raises the question: some percentage of what? Chinese Red, like any color, is made up of a certain combination of other colors.

relies. In *Olay*, the protectable interest was not “in the color pink alone,” but rather in the color in combination with graphics and packaging. Here, Louboutin’s claimed mark is, in essence, the color red alone when used on the soles of “high fashion” footwear. Moreover, although Louboutin attempts in these proceedings to limit the scope of the mark to high-heeled footwear, no such limitation appears on the face of the registration.

The other options Louboutin’s claim would leave other competitors are no more practical or palatable. As YSL endeavored to do during a deposition of Christian Louboutin in connection with this action, other designers could seek advance clearance from Christian Louboutin himself, spreading the fan of shades before him to see at what tint his red light changes to amber. Or they could go to court and ask for declaratory relief holding that a proposed red sole is not close enough to Chinese Red to infringe Louboutin’s mark, thereby turning the judge into an arbiter of fashion design. Though Qualitex points out that in trademark disputes courts routinely are called upon to decide difficult questions involving shades of differences in words or phrases or symbols, the commercial contexts in which the application of those judgments generally has arisen has not entailed use of a single color in the fashion industry, where distinctions in designs and ideas conveyed by single colors represent not just matters of degree but much finer qualitative and aesthetic calls.

Because Louboutin’s registration specifies that it covers women’s high fashion “designer footwear,” the description is broad enough to encompass all styles of shoes, not just the high-heeled model illustrated in the PTO registration. Louboutin’s argument that it would not pursue a claim of infringement based upon red outsoles on, for example, flat shoes, wedges or kitten heels, is cold comfort to competing designers. In fact, in one case in Paris, Louboutin sought to enforce its French trademark for a “shoe sole in the color red” against the company Zara France, S.A.R.L., which is not a high-end retailer.

Another dimension of uncertainty the Red Sole Mark creates pertains to its coating. Louboutin’s claim extends not just to the base of “the color red,” but also to its gloss. In the registration, it is described more specifically as “lacquered” red. Thus, it is not clear, for example, whether the protection of Louboutin’s trademark would apply to a “Chinese Red” outsole that was not shiny, but entirely flat. In fact, that issue has surfaced in this case. YSL asserts that the color

Based on the Court’s research, this combination can be expressed in various metrics, such as a combination of RGB (red, green, blue) or CMYK (cyan, magenta, yellow, black), or HSB (hue, saturation, brightness). In Adobe Color Picker, a variance of just 10 percent in any of these inputs, in either direction, yields more than a dozen shades visibly different from Chinese Red, in some cases so different as to appear to the casual observer pink on one side of Chinese Red or orange on the other.

tone of some of the shoes Louboutin challenges is not lacquered at all but a flat red. By bringing this litigation, Louboutin is of course calling upon the Court to pass judgment as well on the degree of buffing that a competitor may give to a Chinese Red outsole before it begins to infringe on Louboutin's rights.

Finally, conferring legal recognition on Louboutin's claim raises the specter of fashion wars. If Louboutin owns Chinese Red for the outsole of high fashion women's shoes, another designer can just as well stake out a claim for exclusive use of another shade of red, or indeed even Louboutin's color, for the insole, while yet another could, like the world colonizers of eras past dividing conquered territories and markets, plant its flag on the entire heel for its Chinese Red. And who is to stop YSL, which declares it pioneered the monochrome shoe design, from trumping the whole footwear design industry by asserting rights to the single color shoe concept in all shades? And these imperial color wars in women's high fashion footwear would represent only the opening forays. What about hostile color grabs in the markets for low-fashion shoes? Or for sports shoes? Or expanding beyond footwear, what about inner linings, collars, or buttons on coats, jackets, or dresses in both women's and men's apparel?

In sum, the Court cannot conceive that the Lanham Act could serve as the source of the broad spectrum of absurdities that would follow recognition of a trademark for the use of a single color for fashion items. Because the Court has serious doubts that Louboutin possesses a protectable mark, the Court finds that Louboutin cannot establish a likelihood that it will succeed on its claims for trademark infringement and unfair competition under the Lanham Act.

Christian Louboutin v. Yves Saint Laurent America

696 F.3d 206 (2d Cir. 2012)

The District Court's holding that a single color can never serve as a trademark in the fashion industry is inconsistent with the Supreme Court's decision in *Qualitex*.

III. THE "FUNCTIONALITY" DEFENSE

Although the theory of aesthetic functionality was proposed as early as 1938, the first court to adopt the theory as the basis for denial of protection of a design was the United States Court of Appeals for the Ninth Circuit in *Pagliero v. Wallace China Co.* In *Pagliero*, the Court of Appeals determined that the Wallace China Company was not entitled to the exclusive use of a particular floral design on hotel china, despite its "creation of a substantial market for its products bearing these designs by virtue of extensive advertising." The design, the Court held, was "functional" because it satisfied "a demand for the aesthetic as well as for the utilitarian." Because the "particular feature is an important ingredient in the commercial success of the

Pagliero: 198 F.2d 339 (9th Cir. 1952)

product, the interest in free competition permits its imitation in the absence of a patent or copyright.”

Despite its apparent counterintuitiveness (how can the purely aesthetic be deemed functional, one might ask?), our Court has long accepted the doctrine of aesthetic functionality. We have rejected, however, the circular “important ingredient” test formulated by the Pagliero court, which inevitably penalized markholders for their success in promoting their product. Instead, we have concluded that Lanham Act protection does not extend to configurations of ornamental features which would significantly limit the range of competitive designs available. Accordingly, we have held that the doctrine of aesthetic functionality bars protection of a mark that is necessary to compete in the relevant market.

We note that a product feature’s successful source indication can sometimes be difficult to distinguish from the feature’s aesthetic function, if any. Therefore, in determining whether a mark has an aesthetic function so as to preclude trademark protection, we take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the markholder’s right to protect that mark. Because aesthetic function and branding success can sometimes be difficult to distinguish, the aesthetic functionality analysis is highly fact-specific.

We now turn to the per se rule of functionality for color marks in the fashion industry adopted by the District Court – a rule that would effectively deny trademark protection to any deployment of a single color in an item of apparel. As noted above, *Qualitex* expressly held that “sometimes a color will meet ordinary legal trademark requirements, and, when it does so, no special legal rule prevents color alone from serving as a trademark.” In other words, the Supreme Court specifically forbade the implementation of a per se rule that would deny protection for the use of a single color as a trademark in a particular industrial context. *Qualitex* requires an individualized, fact-based inquiry into the nature of the trademark, and cannot be read to sanction an industry-based per se rule. The District Court created just such a rule, on the theory that “there is something unique about the fashion world that militates against extending trademark protection to a single color.”

Even if *Qualitex* could be read to permit an industry-specific per se rule of functionality (a reading we think doubtful), such a rule would be neither necessary nor appropriate here. We readily acknowledge that the fashion industry, like other industries, has special concerns in the operation of trademark law; it has been argued forcefully that United States law does not protect fashion design adequately. Indeed, the case on appeal is particularly difficult precisely because, as the District Court well noted, in the fashion industry, color can serve

as a tool in the palette of a designer, rather than as mere ornamentation.

Nevertheless, the functionality defense does not guarantee a competitor the greatest range for his creative outlet, but only the ability to fairly compete within a given market.

IV. THE RED SOLE MARK

Having determined that no *per se* rule governs the protection of single-color marks in the fashion industry, any more than it can do so in any other industry, we turn our attention to the Red Sole Mark. The Red Sole Mark has acquired limited secondary meaning as a distinctive symbol that identifies the Louboutin brand, and it is therefore a valid and protectable mark as modified below.

We see no reason why a single-color mark in the specific context of the fashion industry could not acquire secondary meaning – and therefore serve as a brand or source identifier – if it is used so consistently and prominently by a particular designer that it becomes a symbol, the primary significance of which is to identify the source of the product rather than the product itself.

In light of the evidence in the record, including extensive consumer surveys submitted by both parties during the preliminary injunction proceedings, and of the factual findings of the District Court, we think it plain that Louboutin's marketing efforts have created what the able district judge described as "a ... brand with worldwide recognition." We hold that the lacquered red outsole, as applied to a shoe with an "upper" of a different color, has "come to identify and distinguish" the Louboutin brand, and is therefore a distinctive symbol that qualifies for trademark protection.

We further hold that the record fails to demonstrate that the secondary meaning of the Red Sole Mark extends to uses in which the sole does not contrast with the upper – in other words, when a red sole is used on a monochromatic red shoe. As the District Court observed, "When Hollywood starlets cross red carpets and high fashion models strut down runways, and heads turn and eyes drop to the celebrities' feet, lacquered red outsoles on high-heeled, black shoes flaunt a glamorous statement that pops out at once." As clearly suggested by the District Court, it is the contrast between the sole and the upper that causes the sole to "pop," and to distinguish its creator.

The evidentiary record further demonstrates that the Louboutin mark is closely associated with contrast. For example, Pinault, the chief executive of YSL's parent company, wrote that the "distinctive signature" of the Mark is in its "contrast with the general presentation of the shoe, particularly its upper." Of the hundreds of pictures of Louboutin shoes submitted to the District Court, only four were monochrome red. And Louboutin's own consumer surveys show

that when consumers were shown the YSL monochrome red shoe, of those consumers who misidentified the pictured shoes as Louboutin-made, nearly every one cited the red sole of the shoe, rather than its general red color.

Because we conclude that the secondary meaning of the mark held by Louboutin extends only to the use of a lacquered red outsole that contrasts with the adjoining portion of the shoe, we modify the Red Sole Mark, pursuant to Section 37 of the Lanham Act, insofar as it is sought to be applied to any shoe bearing the same color "upper" as the outsole. We therefore instruct the Director of the Patent and Trade Office to limit the registration of the Red Sole Mark to only those situations in which the red lacquered outsole contrasts in color with the adjoining "upper" of the shoe.

In sum, we hold that the Red Sole Mark is valid and enforceable as modified. This holding disposes of the Lanham Act claims brought by both Louboutin and YSL because the red sole on YSL's monochrome shoes is neither a use of, nor confusingly similar to, the Red Sole Mark. Having limited the Red Sole Mark as described above, and having established that the red sole used by YSL is not a use of the Red Sole Mark, it is axiomatic that we need not – and should not – address either the likelihood of consumer confusion or whether the modified Mark is functional.

3 Design Patent

Kal Raustiala & Christopher Sprigman

The Piracy Paradox, Innovation and Intellectual Property in Fashion Design

The design patent provision fails to shelter fashion design for two principal reasons.

The first reason is doctrinal. Unlike copyright, which extends to all "original" expression, that is, all expression not copied in its entirety from others and that contains a modicum of creativity, design patents are available only for designs that are truly "new," and does not extend to designs that are merely reworkings of previously existing designs. Because so many apparel designs are reworkings and are not "new" in the sense that the patent law requires, most will not qualify for design patent protection.

There is, moreover, a second and more substantial limitation to the relevance of design patent as a form of protection for fashion designs. The process of preparing a patent application is expensive, the waiting period lengthy (more than eighteen months, on average, for design patents), and the prospects of protection uncertain (the United States Patent and Trademark Office rejects roughly half of all applica-

15 U.S.C. § 1119

92 Va. L. Rev. 1687 (2006)

tions for design patents). Given the short shelf-life of many fashion designs, the design patent is simply too slow and uncertain to be relevant.

4 *Sui Generis* Protection?

James Surowiecki
The Piracy Paradox

The New Yorker (Sept. 24, 2007)

Designers' frustration at seeing their ideas mimicked is understandable. But this is a classic case where the cure may be worse than the disease. There's little evidence that knockoffs are damaging the business. Fashion sales have remained more than healthy—estimates value the global luxury-fashion sector at a hundred and thirty billion dollars— and the high-end firms that so often see their designs copied have become stronger. More striking, a recent paper by the law professors Kal Raustiala and Christopher Sprigman suggests that weak intellectual-property rules, far from hurting the fashion industry, have instead been integral to its success. The professors call this effect “the piracy paradox.”

The paradox stems from the basic dilemma that underpins the economics of fashion: for the industry to keep growing, customers must like this year's designs, but they must also become dissatisfied with them, so that they'll buy next year's. Many other consumer businesses face a similar problem, but fashion—unlike, say, the technology industry—can't rely on improvements in power and performance to make old products obsolete. Raustiala and Sprigman argue persuasively that, in fashion, it's copying that serves this function, bringing about what they call “induced obsolescence.” Copying enables designs and styles to move quickly from early adopters to the masses. And since no one cool wants to keep wearing something after everybody else is wearing it, the copying of designs helps fuel the incessant demand for something new.

The situation is not necessarily easy on designers, who have to keep coming up with new ideas rather than being able to milk a trend for years. But it means that in the industry as a whole there is more innovation, more competition, and probably more sales than there otherwise would be. And the absence of copyrights and patents also creates a more fertile ground for that innovation, since designers are able to take other people's ideas in new directions. Had the designers who came up with the pinstripe or the stiletto heel been able to bar others from using their creations, there would have been less innovation in fashion, not more.

If copying were putting a serious dent in designers' profits, it might slow the pace of innovation, since designers would have less

incentive to produce good work. But while knockoffs undoubtedly do steal some sales from originals, they are, for the most part, targeted at an entirely different market segment—people who appreciate high style but can't afford high prices. That limits the damage knockoffs do, as does the fact that fashion is one of the few industries in the world where people are still willing to pay a considerable premium to own original brands instead of imitations. (That's why counterfeits, which pretend to be original products, are illegal.) The best evidence of this is the fact that luxury-goods makers, far from cutting their prices in response to the knockoff boom, have instead been able to raise prices consistently. In fact, given the importance to fashion of what the law professor Jonathan Barnett calls "aspirational utility"—the enjoyment people get from imitating the life style of the rich and famous—one might think of knockoffs as being like gateway drugs: access to the lower-quality version makes buyers all the more interested in eventually getting the real stuff.

C. Scott Hemphill & Jeannie Suk

The Law, Culture, and Economics of Fashion

61 Stan. L. Rev. 1147 (2009)

Copying in fashion is not a new problem. U.S. designers in the early 20th century – and, before that, French couturiers – were plagued by competitors who made sketches at shows or measured the seams of procured originals to discern their patterns, and then used local labor to make the copies. Often, these copies could be accomplished quickly, and the copies reached the market before the original.

What has changed is not the fact or speed of copying, but the large scale and low cost at which rapid copies can be made. (For comparison, just think of music, where rapid copying has long been feasible, while large-scale, low-cost rapid copying is a new phenomenon.) Today, a pattern can be based upon an Internet broadcast of the runway show and transmitted electronically to a low-cost contract manufacturer overseas. A gradual easing in import quotas, begun in 1995, has increased scale and thereby lowered overseas manufacturing costs. Electronic communications and express shipping ensure that prototypes and finished articles can be brought to market quickly. As a result, thousands of inexpensive copies of a new design can be produced, from start to finish, in six weeks or less.

The most striking consequence of low-cost, high-scale, rapid copying is not in beating an original to market, but in the ability to wait and see which designs succeed, and copy only those. Copyists can choose a target after retailers have made their buying decisions, or even after the product reaches stores, and customers have begun to buy. Such copyists can reach market well before the relevant trend has ended.

Retailers and manufacturers exploit the resulting opportunity.

They sell copies at a discount to the original – necessarily, given the lower quality – but earn a profit thanks to lower unit costs and the avoided expense of design. The most notorious copyist retailer is Forever 21, though copying also extends to a wide range of department stores and specialty clothing retailers.

Copying is not a necessary element of the fast-fashion business model. Even retailers that sell copies do not sell only copies. And some fast-fashion firms eschew line-for-line copies. For example, the two leading fast-fashion firms, Zara and H&M, avoid close copying. Although Zara and H&M may have become conflated with Forever 21 in the public mind, their strategies are different. Like the copyists, they move product to market very quickly. But their on-trend product, reactive though it is to the latest offerings of top designers, is not a precise copy. Instead, it is an adaptation or interpretation, developed by in-house designers.

A common normative response against the idea of intellectual property protection for fashion design grows out of the assumption that fashion is a visible marker of status. On this theory, making it more difficult to copy fashion may seem undesirable because it would promote the ability of wealthy people to enjoy and signal their status through apparel that only they can have, and thwart those who want to purchase cheaper knockoffs of those goods. After all, if rampant copying makes available cheaper knockoffs, that may disrupt the ability of the wealthy to distinguish themselves as a group through the signal of fashion. On this view, perhaps permission to copy effectively softens the socially stratifying effects of fashion, while legal restrictions on copying would reinforce them.

But there is much more to fashion than signals about status. In light of the broader and more varied communicative and expressive aspects of fashion, status is only one of a wide variety of signals that fashion makes possible. Fashion has the potential to afford a broad vocabulary for the expression of a vast range of possible messages. Conscious or not, people's fashion choices signify and communicate, with meaningful individual and collective valences. We have identified this dynamic between differentiation and flocking as the key to the experience of fashion in social life. People use fashion to signal individual differences while also partaking in common movement with the collectivity.

The current intellectual property regime, in which legal protection from design copying is lacking, tends, if anything, to push fashion consumption and production in the direction of status and luxury rather than more polyvalent innovation. In sum, we have noted two distortions. The first is toward the creation of designs that are legally more difficult to copy. Trademark and trade dress already protect the most salient status-signaling items in fashion, those adorned with lo-

gos of high-end brands. Therefore, those who want to enable effective status signal-jamming should be critical of trademark protection, and not necessarily resist copyright protection for fashion design. The second distortion is toward the creation of goods that are naturally (as opposed to legally) more difficult to copy, or goods that are more difficult for design copying to harm – for example, goods involving unusual or expensive materials or difficult workmanship.

The result of these distortions is to push creators toward the high-end realm of status and luxury, and away from devoting creative resources to design innovation. In a regime that protected original designs from copying, we would expect to see a shift in resources from developing brand-name or luxury goods or attempting close copies of designs toward developing a richer, more polycentric language of fashion that draws on and reinvents available inspirations and influences. We would expect to see greater range and variety in fashion innovation that would enlarge the vocabulary and the set of symbols with which we may produce meaning.

At bottom, though, the main reason not to accommodate the lovers of cheap fashion knockoffs is more basic. It is the same reason that we do not have a legal regime that permits people freely to make and sell photocopies of another author's book and retain the profits. It is the theory of incentives. Obviously, people always want to purchase inexpensive copies of creative works or have them for free. The reason to disallow it is not to deprive them of that benefit but rather to provide creators with an incentive to create. That is no less true in fashion.

Innovative Design Protection Act of 2012
S. 3523 (as introduced Sept. 10, 2012)

A BILL

To amend title 17, United States Code, to extend protection to fashion design, and for other purposes. [The IDPA would have amended chapter 13 as follows:]

17 U.S.C. S 1301
Designs protected

- (a) *Designs Protected.* –
 - (1) *In general.* – The designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter.
 - (2) *Vessel features.* – The design of a vessel hull, deck, or combination of a hull and deck, including a plug or mold, is subject to protection under this chapter, notwithstanding section 1302(4).

- (4) *Fashion Design.* -- *A fashion design is subject to protection under this chapter.*
- (b) *Definitions.* – For the purpose of this chapter, the following terms have the following meanings:
- (1) A design is "original" if it is the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.
- (2) A "useful article" is a vessel hull or deck, including a plug or mold, *or an article of apparel*, which in normal use has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article which normally is part of a useful article shall be deemed to be a useful article.
- (8) *A "fashion design"*
- (A) *is the appearance as a whole of an article of apparel, including its ornamentation; and*
- (B) *includes original elements of the article of apparel or the original arrangement or placement of original or non-original elements as incorporated in the overall appearance of the article of apparel that --*
- (i) *are the result of a designer's own creative endeavor; and*
- (ii) *provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.*
- (10) *The term 'apparel' means --*
- (A) *an article of men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear;*
- (B) *handbags, purses, wallets, tote bags, and belts; and*
- (C) *eyeglass frames.*
- (11) *In the case of a fashion design, the 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.;" and*
- (c) *Rule Of Construction.* -- *In the case of a fashion design under this chapter, those differences or variations which are considered non-trivial for the purposes of establishing that a design is subject to protection under subsection (b)(8) shall be considered non-trivial for the purposes of establishing that a defendant's design is not substantially identical under subsection (b)(11) and section 1309(e)*

17 U.S.C § 1302*Designs not subject to protection*

Protection under this chapter shall not be available for a design that is –

- (1) not original;
- (2) staple or commonplace, such as a standard geometric figure, a familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;
- (3) different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;
- (4) dictated solely by a utilitarian function of the article that embodies it; or
- (5) *(A) in the case of a design of a vessel hull* embodied in a useful article that was made public by the designer or owner in the United States or a foreign country more than 2 years before the date of the application for registration under this chapter.
(B) in the case of a fashion design, embodied in a useful article that was made public by the designer or owner in the United States or a foreign country before the date of enactment of this chapter or more than 3 years before the date upon which protection of the design is asserted under this chapter.

17 U.S.C § 1303*Revisions, adaptations, and rearrangements*

Protection for a design under this chapter shall be available notwithstanding the employment in the design of subject matter excluded from protection under section 1302 if the design is a substantial revision, adaptation, or rearrangement of such subject matter. Such protection shall be independent of any subsisting protection in subject matter employed in the design, and shall not be construed as securing any right to subject matter excluded from protection under this chapter or as extending any subsisting protection under this chapter. *The presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be considered in determining the protection of a fashion design under section 1301 or 1302 or in determining infringement under section 1309.*

17 U.S.C § 1305*Term of protection*

- (a) *In General.* – Subject to subsection (b), the protection provided under this chapter
 - (a) for a design of a vessel hull, shall continue for a term of 10 years beginning on the date of the commencement of protection under section 1304; and*
 - (b) for a fashion design, shall continue for a term of 3 years begin-*

ning on the date of the commencement of protection under section 1304.

(d) Fashion Design. –

- (1) In General. -- In the case of a fashion design, the owner of the design shall provide written notice of the design protection to any person the design owner has reason to believe has violated or will violate this chapter.*
- (3) Commencement of Action. -- An action for infringement of a fashion design under this chapter shall not commence until the date that is 21 days after the date on which written notice required under this subsection was provided to the defendant.*
- (4) Limitation on Damages. -- A person alleged to be undertaking action leading to infringement under this chapter shall be held liable only for damages and profits accrued after the date on which the action for infringement is commenced against such person under paragraph (3).*

17 U.S.C § 1306
Design notice

The owner of a design protected under this chapter has the exclusive right to –

- (1) make, have made, or import, for sale or for use in trade, any useful article embodying that design; and
- (2) sell or distribute for sale or for use in trade any useful article embodying that design.

17 U.S.C § 1308
Exclusive rights

(b) Acts of Sellers, Importers and Distributors. – A retailer, seller, importer or distributor of an infringing article who did not make or import the article shall be deemed to have infringed on a design protected under this chapter only if that person –

- (1) induced or acted in collusion with a manufacturer to make, or an importer to import such article, except that merely purchasing or giving an order to purchase such article in the ordinary course of business shall not of itself constitute such inducement or collusion; or*
- (2) refused or failed, upon the request of the owner of the design, to make a prompt and full disclosure of that person's source of such article, and that person orders or reorders such article after receiving notice by registered or certified mail of the protection subsisting in the design.*

17 U.S.C § 1309
Infringement

(c) Acts Without Knowledge. – It shall not be infringement under this section to make, have made, import, sell, offer for sale, or distribute, any article embodying a design which was created

without knowledge *either actual or reasonably inferred from the totality of the circumstances* that a design was protected under this chapter and was copied from such protected design.

- (d) *Acts in Ordinary Course of Business.* – A person who incorporates into that person’s product of manufacture an infringing article acquired from others in the ordinary course of business, or who, without knowledge of the protected design embodied in an infringing article, makes or processes the infringing article for the account of another person in the ordinary course of business, shall not be deemed to have infringed the rights in that design under this chapter except under a condition contained in paragraph (1) or (2) of subsection (b). Accepting an order or reorder from the source of the infringing article shall be deemed ordering or reordering within the meaning of subsection (b)(2).
- (e)(f) *Infringing Article Defined.* – (1) *In General.* -- As used in this section, an “infringing article” is any article the design of which has been copied from a design protected under this chapter, without the consent of the owner of the protected design. An infringing article is not an illustration or picture of a protected design in an advertisement, book, periodical, newspaper, photograph, broadcast, motion picture, or similar medium. (2) *Vessel Hull Design.* -- *In the case of a design of a vessel hull, a design shall not be deemed to have been copied from a protected design if it is original and not substantially similar in appearance to a protected design.* (3) *Fashion Design.* -- *In the case of a fashion design, a design shall not be deemed to have been copied from a protected design if that design -- (A) is not substantially identical in overall visual appearance to and as to the original elements of a protected design; or (B) is the result of independent creation.*
- (g)(h) *Reproduction for Teaching or Analysis.* – It is not an infringement of the exclusive rights of a design owner for a person to reproduce the design in a useful article or in any other form solely for the purpose of teaching, analyzing, or evaluating the appearance, concepts, or techniques embodied in the design, or the function of the useful article embodying the design.
 - (i) *Home Sewing Exception.* --
 - (1) *In general.* -- *It is not an infringement of the exclusive rights of a design owner for a person to produce a single copy of a protected design for personal use or for the use of an immediate family member, if that copy is not offered for sale or use in trade during the period of protection.*
 - (2) *Rule of Construction.* -- *Nothing in this subsection shall be construed to permit the publication or distribution of instructions or*

patterns for the copying of a protected design.

- (a) *Time Limit for Application for Registration.* – *In the case of a design of a vessel hull, protection under this chapter* shall be lost if application for registration of the design is not made within 2 years after the date on which the design is first made public. *Registration shall not apply to fashion designs.*

17 U.S.C § 1310
Application for registration