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Copyrights and Design Patents—The Common Zone Between

Albert P. Sharpe, III*

The overlapping of our present-day Copyright and Design Patent Laws, apparently initially created by random legislative development and recently aggravated by the decision of the Supreme Court in Mazar v. Stein,¹ has resulted in a legal morass of substantial proportions.

The purpose of this paper is to explore briefly the influence which gave rise to this situation, to discuss the present state of the law and its practical impact upon the practicing patent advocate, and finally to review and evaluate proposed legislation, past and present, in an effort to determine the possible course of future developments.

HISTORICAL BACKGROUND

To understand adequately the nature and the extent of the area of overlapping protection under the Copyright and Design Patent Laws, it is first necessary to trace in a general way the historical evolution of these laws from the time of their inception to the present.

A. Development of the Copyright Law ²

Modern concepts of copyright date as far back as 1710 when in England the celebrated Statute of 8 Anne was enacted. The Statute of Anne has been considered the forerunner of all legislation for the protection of literary property and provided for penalties to be levied against one who reprinted or imported protected books without the consent of the authors or proprietors. Surprisingly, the Statute of Anne promulgated two of the three requirements, namely registration and deposit of copies, contained in our present Copyright Law.

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¹ 347 U. S. 201 (1954).

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Various other European nations followed England's example in the middle and late 18th century and the early 19th century, and the first American experiments with statutory copyright came in 1783 when Connecticut, Massachusetts, and Maryland adopted copyright laws of one sort or another. Pursuant to a recommendation by Congress later in that same year that copyright protection be instituted for protection of United States citizens generally, New Jersey, New Hampshire, and Rhode Island also enacted copyright legislation of varying types. Apparently, however, state legislation was largely unsatisfactory and the Constitutional Convention in 1787 incorporated into the Constitution of the United States a provision for the protection of intellectual property rights.\(^3\) Congress was given the power

To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

Acting under the authorization of the constitutional enactment, Congress in 1790 passed into law the first Federal Copyright Act,\(^4\) which provided for the protection of "books, maps, and charts." The Act required registration of claim and deposit of copies, but not until 1802 was it amended\(^5\) to require that a work to be protected carry a copyright notice. At the same time, copyright protection was extended to historical prints.

Through successive amendments to the Act of 1790, the area within which copyright protection would be granted was amended to include in 1831\(^6\) "any print or engraving"; in 1856, authors or proprietors of dramatic compositions were granted the right of public performance; in 1865, the Act was expanded to include protection for photographs; and in 1870\(^7\) the law was substantially revised and the classes of works which were declared eligible for protection were set forth as being: Any book, map, chart, dramatic or musical composition, engraving cut, print, or photograph or negative thereof, painting, drawing, chromo, statue, statuary, and models of designs intended to be protected as works

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\(^3\) Art. I, Sec. 8.
\(^4\) 1 Stat. 124 (1790).
\(^5\) 2 Stat. 171 (1802).
\(^6\) Revision of 1831, 4 Stat. 436 (1831).
\(^7\) Par. 86, 16 Stat. 212 (1870).
of the fine arts. In 1891\(^8\) and in 1905\(^9\) laws were passed with a view toward extending some measure of copyright protection to foreigners; in 1897\(^10\) the Register of Copyrights and his staff were established; and finally in 1909, the Copyright Statute which forms the basic foundation for that presently in force\(^11\) was enacted.

It is perhaps significant to note that the Act of 1909, which superseded previous copyright legislation, deleted the Fine Arts clause of the 1870 Act so that "works of art and models or designs for works of art" were eligible for copyright protection under the statute.\(^12\) Very possibly it was this very Act that laid the groundwork for subsequent conflict between design and copyright forms of protection.

**B. Development of Design Patent Law\(^13\)**

As was the case with copyrights, the advent of the United States into the realm of legislation for protection of designs for articles of utility or manufacture came several years after the initiation of similar activities on the part of European countries. Protection for designs was available in France as early as 1737, and England made provision for such protection in 1787 by enactment of Statute 27 Geo. 3, Ch. 38.

The efforts of the United States relative to Design Patents date from 1842 when Congress afforded protection for a manufacture, whether metal or other material; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original design for a bust, statue, bas-relief, composition in alto or basso relievo; any new and original impression or ornament to be placed on any article of manufacture, the same being formed in marble or other material; any new and useful pattern, print or picture to be worked into, worked on, or printed, painted, cast, or otherwise fixed on any article of

\(^8\) 26 Stat. 1109–1110 (1891).
\(^9\) 33 Stat. 1000 (1905).
\(^10\) 29 Stat. 481 (1897).
\(^11\) The Act of 1909 [35 Stat. 1075 (1909)] with some amendments was codified into law pursuant to an Act of 30 July 1947, and now appears as Title 17 U. S. Code.
\(^12\) See 35 Stat. 1076g (1909).
manufacture; and any new, useful, and original shape or con-
figuration of any article of manufacture.\textsuperscript{14} About twenty years
later, the Act of March 2, 1861\textsuperscript{15} was passed into law and did
not confer a scope of protection materially different from that
of the earlier Act.

Some nine years passed and the Patent Act of July 8, 1870\textsuperscript{16}
was promulgated and took the place of previous Design Patent
legislation. The Act of 1870 did not depart in any substantial
respect from the Act of 1861 except that the provision for prints
for woolen, silk, cotton, or other fabrics, deleted from the Act
of 1842 by the Act of 1861, was restored. In 1874, the law pertain-
ing to Design Patents was codified into positive law and became
part of the revised statutes.\textsuperscript{17} Subsequently, the Act of May 9,
1902\textsuperscript{18} evolved and under the terms of this Act, the specification
of particular designs for which patents would lie was deleted in
favor of the more general designation, “Article of Manufacture,”
on the theory that this term was amply descriptive of all those
classes of design which had been enumerated in previous en-
actments.\textsuperscript{19}

In the years immediately preceding the Act of 1902 some
confusion had arisen regarding the interpretation to be placed
upon the word “useful” in determining the patentability of a
given design. However, in 1872 the Supreme Court held that the
Acts which authorized the granting of patents for designs con-
templated not so much utility as appearance, and that it was the
appearance of the object which constituted mainly, if not entirely,
the contribution to the public which the law deemed worthy of
recompense.\textsuperscript{20} To avoid, in line with this decision, the previously
existing implication that functional utility was to be considered
as having a significant bearing on design patentability, rather
than ornamental appearance, the Act of 1902 substituted the
word “ornamental” for the word “useful” as it had been em-
ployed in earlier enactments. Some consideration had been

\textsuperscript{14} 5 Stat. 543 (1892).
\textsuperscript{15} 12 Stat. 246 (1861).
\textsuperscript{16} 16 Stat. 209 (1870).
\textsuperscript{17} Rev. Stat. Secs. 4929-4933.
\textsuperscript{18} 32 Stat. 193 (1902).
\textsuperscript{19} For an expression of the interpretation given by the Commissioner of
Patents to the term “article of manufacture” as used in the Act of 1902, see
his statement to the Committees of Congress quoted in Ex Parte Fulda, 194
O. G. 549; 1913 C. D. 206.
\textsuperscript{20} Gorham Mfg. Co. v. White, 81 U. S. 511 (1872).
given to the use of the term "artistic" instead of the term "ornamental," but the former eventually was abandoned in favor of the latter.

The Act of 1902 is the basis of our present Design Patent Law and pursuant to the Patent Act of July 19, 1952,21 it has been consolidated with utility patent laws and enacted as Title 35 of the United States Code. Under the terms of the present statute, whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor.22

C. Evolution of the Overlapping Zone of Protection Under the Copyright and Design Patent Laws

Perhaps one of the factors which has contributed to the twilight area between copyrights and design patents, and probably the first such factor in point of time, is the constitutional authorization itself. It has been seen that the basis for both patents and copyrights is to be found in the same constitutional passage. This passage is said to represent a classic example of the balanced composition popular during the Colonial period and over the years has caused a considerable amount of confusion to lawyers seeking to interpret its meaning.

If the constitutional authorizing clause is taken disjunctively, it may be broken down into two separate statements. First, Congress shall have the power to promote the progress of science by securing to authors the exclusive right to their writings and, second, Congress shall have the power to promote the progress of the useful arts by securing to inventors the exclusive right to their discoveries. To appreciate fully the meaning intended to be given the clause by the drafters of the constitution, one must be cognizant of the fact that in those days the words "science" and "art" had somewhat different meanings than they do today. The word "science" as used in the constitutional enactment bore more the connotation of learning in general than that of natural science. Similarly, the word "art" bore more the connotation of technology, or useful crafts, than perhaps it does in our modern era. Hence, it was the apparent intention of the founding fathers that authors' writings be protected to promote general learning and that inventors' discoveries be protected to promote the useful arts.

For our purposes, these considerations are germane only because they illustrate that the interpretation of the constitutional enactment to reveal its true meaning is not so elementary as it might at first blush appear to be. Consequently, it is a matter which has been surrounded by a degree of popular uncertainty. As the years passed, the environment within which the enactment was born became more isolated in point of time, and the situation became ripe for the development of areas of confusion. The constant but subtle modification of the meaning of words, and the modernization of the language no doubt contributed to misunderstandings and misapprehensions concerning the respective objectives of the copyright and the patent systems. Even were it otherwise, it may be logically asked whether there exists some common ground where general learning and useful arts becomes so intertwined as to be one and the same. At any rate, the uncertainty which prevailed was reflected in the development of the law of intellectual property.

Another contributing factor appears to have been gradual expansion of the scope of applications of copyrights and the design patents, both by the legislation itself (as appears from the outline above of the statutory development of the respective forms of protection), and by the courts. Parenthetically, one wonders whether the Constitutional Convention, at the time Article 2, Section 8, was drafted, had in mind that the term “writing” should be given a meaning as broad as that which it is accorded under present implementing legislation and under prevailing judicial sentiment, or that the scope of the patent system should be such as to include ornamental works. It is currently clear that such items as photographs, jewelry, glassware, stationery and so on are proper subject for copyright protection. At the time the Constitution was adopted, almost the only works considered worthy of copyright were books. While early legislation expanded somewhat on this concept, it was not until nearly 100 years later that models of designs intended to be protected as works of the fine arts were considered sufficiently significant to merit copyright protection; and as we have seen, the first provision for design patents came some 60 odd years after adoption of the Constitution.

Be that as it may, the fact remains that the terms “authors” and “writings,” as used in the original constitutional authorization, have through the years been expanded gradually to include meanings not ordinarily attributed to the words, when
used in their general sense. In 1884, the Supreme Court, in holding a photograph copyrightable, adopted the definition of an "author" as being "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature." The Court then proceeded to indicate that "writings," as used in the Constitution, was meant to include all forms by which the idea in the mind of the author are given visible expression.\(^{23}\) Presumptively, this definition of the term "writings" would include nearly any concrete work product of an author. It is difficult, if not impossible, to distinguish the Court's concept of the "author" of a "writing," as expressly in this instance, from present concepts of the "inventor" of an "ornamental design."

Early evidence of the existence of a possible conflict between copyrights and design patents is to be found in the case of Louis deJonge & Co. v. Breuker & Kessler.\(^{24}\) The lower court was of the opinion that a design representing sprigs of holly, mistletoe, and spruce, arranged in the shape of a square and repeated on a single sheet twelve times for use as holiday wrappings (an item of obvious utility), was a "writing" copyrightable as painting and also an ornamental design patentable as such, but held against the copyright owner on the basis of defective copyright notice. The Circuit Court of Appeals reserved opinion as to whether the sphere of copyright and design patent overlapped but affirmed the decision of the lower court relative to the insufficiency of statutory notice. The decision of the Circuit Court was affirmed by the Supreme Court which similarly withheld judgment relative to the overlapping zone between the two forms of intellectual property involved.

Evidence again arose in 1921, this time concerning three-dimensional works. A copyright and a design patent for a doll, known as a "kewpie" were held valid and infringed,\(^{25}\) but in the process the court avoided a consideration of the issue as to whether or not the plaintiff could simultaneously have copyright and design protection, inasmuch as by a consent decree in the lower court the defendant had agreed that both patent and copyright were valid. Some six years later, the District of Columbia Court of Appeals indicated that either design patent

\(^{23}\) Burrow-Giles Lithographic Co. v. Sacony, 111 U. S. 53 (1884).
\(^{25}\) Wilson v. Haber Bros., 275 F. 346 (2d Cir. 1921).
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or copyright (as a label) would be proper for a hosiery ticket design. In 1936 the Pennsylvania District Court held that a design for a cemetery monument was a copyrightable "design for a work of art" within the meaning of the Copyright Act, notwithstanding the fact that the monument was an article of manufacture as well as an object of art. More recently it was held that a loop design as a decoration for glassware was either design patentable or copyrightable within the purview of the appropriate statutes.

These cases illustrate that over a period of several years, the courts tended gradually, in line with constant literalization of statutory law, to extend the frontiers of copyright protection into the realm of designs incorporated in useful articles and consequently into that traditionally occupied by design patents.

The Copyright Office itself seems to have played a part in this metamorphosis as may be determined from an examination of its own changing interpretation of the scope of the copyright laws. In 1910 the pertinent copyright regulations interpreting the 1909 Act defined works of art as including all works belonging fairly to the so-called fine arts, and including paintings, drawings, and sculpture. Productions of the industrial arts, utilitarian in purpose and character, were not considered subject to copyright registration even if artistically made or ornamented. This view on the part of the Copyright Office seems to have prevailed even though, as we have seen, the 1909 Act substituted the term "works of art" for the term "works of fine art" as it had appeared in the Act of 1870.

The Office's interpretation of the Act appears to have been relaxed mildly in 1917 when the copyright regulations were rephrased to indicate that the protection of productions of the industrial arts, utilitarian in purpose and character, even if artistically made or ornamented, depends upon action under the Patent Law; but registration in the Copyright Office has been made to protect artistic drawings, notwithstanding they may afterwards be utilized for articles of manufacture. Under this latter terminology, it would appear that, in the eyes of the

26 In re Blood, 23 F. 2d 772 (D. C. Cir. 1927).
29 Rules and Regulations for the Registration of Claims to Copyright, Bulletin No. 15 (1919-8).
30 37 C. F. R., 1939, Par. 201.04(7).
Copyright Office, subsequent incorporation of a design, once copyrighted, in a utilitarian article would not be fatal to the copyright, at least if there were no intent at the time of registration to make such incorporation.

More currently, works of art as a category have been described by the regulations of the Copyright Office as including works of artistic craftsmanship insofar as their form, but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture.\(^{31}\)

Consequently, when the changing attitudes of the Congress, of the courts and of the Copyright Office are examined and compared, a concurrent and constantly increasing recognition of designs incorporated in useful articles as being copyrightable is to be noted. We have already seen that from the time of inception of design patent protection it was within the contemplation of the legislature to extend protection to ornamental works embodied in utilitarian articles of manufacture, with significance being placed upon appearance rather than utility. With the expansion of copyright frontiers came a situation in which two completely different systems were committed to the protection of virtually the same form of visual expression, and ultimately a situation in which protection under either system was made available for a form possessed of particular characteristics, i.e., a work of art.

The question of the presence or absence of an area of overlap between copyrights and designs was resolved definitely by the advent of the landmark case of *Mazer v. Stein*.\(^{32}\) That case involved the validity of copyright for statuettes of male and female dancing figures made of semi-vitreous china intended for use and used as bases for table lamps with electric wiring, sockets, and lamp shades attached. The copyright owner had been involved in much litigation in various circuits concerning the copyrighted subject matter prior to the *Mazer v. Stein* suit. In most instances he had come off second best, for the courts involved had adopted a theory that copyright ought not to lie for a work intended as a utilitarian article. It was accordingly the position of these courts that the copyright owner should have protected himself by design patent rather than by copy-
right. The Supreme Court, after an exhaustive review of the authorities and of the development of the copyright law, held that the lamp bases were copyrightable as “works of art.” The court indicated that “the dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents.” The Court found nothing in the copyright statute to support the argument that either the intended use or the actual use in industry of an article eligible for copyright bars or invalidates its registration. The Court placed significance on the fact that the Act of 1909 had replaced the term “fine arts” as used in the Act of 1870 with the term “works of art” and expressed the view that this amendment destroyed verbal distinctions between purely aesthetic articles and useful works of art and that the Copyright Statute as amended was intended to include more than the traditional fine arts.

Mazer generally is recognized as the foundation for the now prevailing view that the incorporation of a “work of art” in a utilitarian article does not bar copyright. The case does not hold, apparently, that each and every industrial design may be protected by copyright, but only those which may be independently classified as “works of art.” Just what constitutes a copyrightable “work of art” on the one hand and an uncopyrightable industrial design on the other, is not a matter capable of precise definition. However, the Copyright Office has prepared the following test:

If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such feature will be eligible for registration.  

As a result of the prevailing view, it will be apparent immediately that there is in fact an area of intellectual endeavor

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34 Copyright Office Regulations, as amended June 18, 1959, 37 C. F. R. Par. 202.10(c).
within which both copyright and design patents will lie. The existence of this fact gives rise to a rather perplexing question relative to selection of the form of protection to be obtained for the design falling within this area.

(a) Practical Considerations in Selecting the Form of Protection under the Present State of the Law.

The term "selection" has been used with making a determination of the type of protection to pursue on behalf of a client. For some time the lower courts have thought that the owner of intellectual property might choose whether he wished copyright or patent protection, but that he could have only one form of statutory protection and would be bound by this election. The Supreme Court in *Mazer v. Stein* recognized the existence of this doctrine but refused to pass upon it, thereby leaving validity of the doctrine of election in doubt, but at least unchallenged by the High Court. Recognizing that few patent cases ever reach the Supreme Court these days, the practicing attorney will accept the election doctrine, even though with reservation, and proceed to choose between the two forms of protection available for works of art.

In making a selection, one must consider many factors. The ease with which each form of protection can be obtained, the expense involved, the time required, the mortality rate in the courts of the copyright as opposed to the design patent, the scope of protection to which each form is accorded, and the manner of proofs which will be required of the litigant in a copyright or design patent suit, are but a few of the factors which must be taken into account in making a final determination of the type of protection to obtain for a given design.

Perhaps one of the most important of these is the ease with which a copyright, or a design patent, may be obtained. This is determined in large measure by the tests for copyrightability and for design patentability. The primary prerequisite for copyrightability is originality, i.e., the work to be copyrightable must be original with the author. The courts have interpreted the requirement for originality to mean little more than a prohibition

35 See notes 24 and 26-28 *supra*; Cf. Korzybski v. Underwood & Underwood, Inc., 36 F. 2d 727 (2d Cir. 1929), where it was held that it might be possible for a given article to have features protectable both by utility patent and by copyright if the article had sufficient significance as a work of art or science apart from the disclosure in the specification of the patent but not if there was no substantial distinction between the disclosure of a utility patent and the design of the copyright.
of actual copying. On the other hand to be eligible for design patent, a work must not only be novel and ornamental, but also it must be inventive. There must be something akin to genius . . . an effort of the brain as well as the hand. The standard of invention required for design patents is as high as that for utility patents.

The difficulty with which a design patent may be obtained is considerably greater in comparison to that involved in securing a copyright. By its very nature the design patent system is one of examination, while the copyright system is essentially one of mere registration of claim. The application for a design patent must go through a period of evaluation in the Patent Office for novelty and inventiveness (or more modernly, unobviousness). An application for copyright, on the other hand, is accepted almost immediately and there is no examination process involved other than a determination of whether the work sought to be copyrighted falls within the statutory area of copyright eligibility, i.e., whether the work is the writing of an author, as defined by the courts.

The examination procedure by the Patent Office of an application for a design patent may extend over a period of two years or more and during this time the services of an attorney are required to assist in the processing of the application through the office. Not only is this procedure quite costly as compared with the processing of copyright applications, but it also has presented a considerable thorn in the side of some industries, such as dressmakers, for example, where the commercial usefulness of a given design has come and gone before patent protection is granted.

From the standpoint of theory, patent protection once granted, should be much stronger than copyright protection as a result of the presumption of validity which supposedly attaches to a design patent once issued. As a practical matter, however, the courts have whittled away upon this presumption until now only a vestige remains. An unofficial survey of recent design patent litigation conducted by the writer indicates that

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39 35 U. S. C. Par. 282, A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.
perhaps but one in three or four design patents is adjudicated valid. While this survey may not be entirely representative by reason of bias in sampling techniques, it does most certainly establish a recognizable trend.

A consideration of vital concern in making an election of protection revolves around the matter of infringement. Because the granting of a design patent confers upon the patentee the exclusive right to make, use and sell the patented invention, it need only be shown to establish design patent infringement that in the eye of the ordinary observer, using the attention that a purchaser usually gives, the alleged infringing design so deceives the observer that he is induced to purchase it, thinking it to be the patented design. This holds true regardless of whether the infringer knowingly copied the infringing design, or whether he contrived the same independently.

In contrast, the copyright owner is given essentially only the right to print, reprint, publish, copy, and vend the work which is the subject of copyright. Thus, to prove infringement of copyright, there must have been a copying of the work, for if the accused conceived his work independently, there is no infringement. Therefore, it is normally necessary for the copyright owner to prove access to the work on the part of the one charged with infringement. This is a considerably more rigid requirement than in the case of design patents and sometimes may be difficult of proof. Where the copyright owner is unable to prove access the similarities between the copyrighted work and the alleged infringing one must be so striking as to preclude any possibility that the defendant might have arrived at his result independently of plaintiff. If it is possible to show access the copyright owner need show only a substantial copying or appropriation of the work.

Once an infringement has been shown, innocent vendors and so-called "secondary users" such as retailers, dress pattern publishers, repair part manufacturers and motion picture producers are not exempted from liability by existing copyright

41 See note 20 supra; Nagel Chase Mfg. v. Kofsky, 71 F. 2d 967 (3d Cir. 1934).
42 Sheldon v. Metro Goldwyn, 81 F. 2d 49 (2d Cir. 1936); 91 F. 2d 978 (2d Cir. 1937).
43 Arnstein v. Porter, 154 F. 2d 454 (2d Cir. 1946).
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statutes and having participated in the infringement may be held to account by the copyright proprietor. Obviously, this feature confers rather sweeping protection upon the owner of a copyright.

Similarly, liability for design patent infringement extends not only to the producer of the infringing work, but also to those who make use of it or who market it for the patent owner is given not only the exclusive right to make the protected design, but also to use and to sell it.

The foregoing comparison of the respective requirements for infringement of copyrights and design patents at first glance seems to indicate that the copyright proprietor is put to considerably more strenuous proofs in establishing his case in an infringement situation than is the owner of a design patent. This situation seems to be greatly illusory, however, as a result of the failure of the courts to hold design patents in particularly high esteem. The strict requirements for design patentability respecting novelty and invention are so rigidly applied by the courts that the patent owner faces the strong possibility that his patent may be declared invalid. This consideration normally should outweigh the advantage which technically design patents possess in regard to proofs.

A further favorable aspect of the copyright lies in the 56-year term of protection available as compared with the 14-year period secured by the granting of a design patent. The copyright owner may, therefore, extend his protection over a period of time four times as great as that during which the design patentee is protected.

Copyrights, as favorable a form for the protection of designs as they appear to be, are not entirely without their shortcomings. A condition precedent to obtaining copyright protection is publication with statutory notice. Publication of a work without notice invalidates the copyright and dedicates the property in the work to the public. Difficulties have arisen in several instances relative to the matter of what constitutes proper statutory notice. The court in the deJonge case held that where a repetitive design was involved the statutory notice must be reproduced at least once for each repetition of the design. Failure to do so on the part of the copyright owner

46 17 U. S. C. par. 10.
47 See note 24 supra.
invalidated the copyright. The practical problems which present themselves as a result of such a requirement are self-evident.

In contrast, notice is not a prerequisite to securing design patent protection and a given work of art may be published or reproduced and sold without prejudice to securing a subsequent design patent, with the exception that in order to avoid the public use bar, application must be made within six months of the first public use or sale. It follows that in the case of a patent, the availability of design protection is less likely to be lost by inadvertence or ignorance of the creator.

Further possible shortcomings relative to copyright protection may lie in the strict interpretation which the Copyright Office has given the *Mazer v. Stein* case. While the Register of Copyrights does not submit applications to examinations for novelty or invention, works of art embodied in utilitarian articles are subjected to the close scrutiny to determine whether they truly constitute “works of art” and thus fall within the realm of copyright protection as applied to useful articles. It is not unlikely that, as the number of applications for registration of designs incorporated in utilitarian marks increases, this scrutiny will become more severe. Even so, statistics indicate that despite refusal of many applications, artistic registrations granted in the fiscal year 1960 were, in the utility field, some 70 percent greater than registrations in the prior year.48

All things considered, under the present state of the law, the advantages to be obtained by protecting works of art through copyright appear in most instances to outweigh the advantages available through design patent protection.

(b) *Historical Review of Legislative Proposals Relative to Designs and Copyrights.*

For a period of nearly 50 years there has been almost continuous agitation for legislation to solve some of the rather serious problems entailed in protecting commercial designs. The usual tone of proposed legislation has been an emphasis on copyright principles rather than upon those of patent. The first general attempt to base design protection on copyright instead of design patent precepts came during the second session of the 63rd Congress in 1914, when the Oldfield Bill49 was introduced

48 Hearing Before the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary, 86th Con., 2d Sess., at 56 (1960).

49 H. R. 11321, 63d Congress, 2d Session (1914). A companion bill (S. 3950) was concurrently introduced to the Senate by Mr. James.
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into the House of Representatives. This bill provided for protection of any original design for a manufactured product upon application by the author and the grant of a registration. Under the provisions of the bill, protection would have been made available for features of pattern, shape, and form as well as surface design, for a period of 3, 10, and 20 years, and a certificate of registration was to have been prima facie evidence of exclusive right of the registrant to the protected design.

Support for the bill came largely from the silk and stove manufacturers, and from the Merchants' Association of New York. Opposition came principally from the National Protective Repair Association which felt that the bill would permit manufacturers to obtain an unwarranted monopoly over repair and replacement parts. While it was generally agreed that the bill as a whole represented a considerable improvement over the existing Design Patent Law, no action on it was taken by the legislative branch. Modified versions of the original Oldfield Bill were introduced during the years 1915, 1916, 1917, 1918 and 1924. While these bills contained some variations over the earlier bill, the underlying principles were essentially the same. Here again, no further action was taken.

During the period from 1924 to 1931, a series of bills were introduced to the House and Senate by Mr. Vestal. The Vestal Bills, like their predecessors, were founded basically upon copyright principles for the protection of design. There were some rather substantial variations from bill to bill in the series, particularly with regard to the presence or absence of a requirement for publication with notice. Various of the Vestals Bills were much discussed at the time and were generally recognized as a needed improvement in the realm of intellectual property protection. The bills, however, were met with strong opposition from several quarters, notably repair part manufacturers, style magazine and pattern publishers, lace manufacturers and various retail interests.

In 1930 one of the bills was passed by the House of Representatives and sent to the Senate where it was referred to the Senate Committee on Patents. Hearings were conducted before the Committee on December 16, 1930 and January 8, 1931, at which time the scope of the bill was restricted in application to original designs for textiles, lace, and embroideries of all kinds, furniture, lamps and lighting fixtures, shoes or other footwear,

50 H. R. 11852, 71st Congress, 2d Session (1930).
and jewelry or articles manufactured from gold, silver and other precious metals, on the theory that the bill passed by the House, which covered practically all fields of activity in manufacture, might work unforeseen hardships and might be difficult to administer.

The minority report presented objections to the bill, based upon the theory that because it was limited to specific categories of designs, it represented class legislation. The minority felt also that the bill was unconstitutional because if original designs were to be protected regardless of novelty, and science, the useful arts would not be promoted. The bill was finally reported out of Committee on January 26, 1931, but was never voted upon by the Senate.

Later in that same year, in the first session of the following Congress, the bill was reintroduced into the House and the Senate but died in Committee without having been reported out.

After some eight years of unsuccessful attempts, Mr. Vestal's name fades from the list of those actively engaged in the introduction of design legislation to Congress but others took up where he had left off and in the years 1932 to 1935, renewed efforts were made without success. Generally, the bills introduced during this period of time were sharply restricted insofar as the scope of the area to be protected was concerned. Several required a test of novelty as a prerequisite to securing protection. One effort of particular interest is that of Mr. Payser in 1934.51 His bill was based on a considerably different principle from previous ones mentioned and declared design piracy to be an unfair method of competition. Like its forerunners, this bill failed to make appreciable headway.

The next significant attempt for legislation came in 1935 in the form of the Duffy Copyright Bill,52 of which only the Vandenberg amendment concerned protection of designs. This amendment provided that the author of any artistic model or design to be applied or embodied in any manufactured product, could obtain a copyright therefor upon compliance with the Copyright Act. This time, the Senate took the initiative and after a further amendment excluding motor cars and accessories from the designs eligible for protection, passed the bill on July 29, 1935. After passage by the Senate, the proposed enactment was referred to the House, which this time was the culprit and

51 H. R. 7359, 73d Congress, 2d Session (1934).
52 S. 3047, 74th Congress, 1st Session (1935).
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took no further action on the bill. Modifications of the Duffy bill with the Vandenberg amendment were introduced to Congress in 1936, 1937, 1939, 1940 and 1941, but failed to receive acceptance. Bills of sharply limited scope for the purpose of protecting designs for textile fabrics were introduced in 1946 and 1947 without success.

The more current legislative proposal of importance is the Willis bill originally introduced in 1957 to the first session of the 85th Congress and later introduced in two revised versions in 1959 to the first and second sessions of the 86th Congress. These two revised bills, while differing from one another in two material respects, represent a comprehensive approach to the solution of the serious problems confronting designers today, and merit careful examination.

The first bill in point of time is entitled "A Bill to Encourage the Creation of Original Ornamental Designs for Useful Articles by Protecting the Authors of Such Designs for a Limited Time Against Unauthorized Copying." It would create a hybrid design patent and copyright type of protection although it more closely resembles the classic copyright concept. Under the terms of the bill, an original ornamental design consisting of those original elements of a useful article that are intended to give the article an ornamental appearance could be protected upon making known the design by publicly exhibiting, distributing, offering for sale, or selling it with design notice applied. The form of the notice would be much like that of copyright and would include the words "protected design" or an abbreviation thereof, or the letter "D" within a circle D, together with the year when the design was first made known and the name of the proprietor. After registration, the registration number may be used in lieu of the latter two elements of the notice.

To avoid problems attendant to the omission or removal of notice after registration, the bill provides that such omission shall not cause loss of protection or prevent recovery for infringement against any person who begins an undertaking leading to infringement after having received written notice of the design protection. A suitable proviso is included to prevent recovery against a person who began an undertaking leading to infringement before receiving written notice of a design protection.

Both two and three dimensional designs would be protected

54 S. 2075, 86th Congress, 1st Session.
under the provisions of the proposed bill but a stable or commonly known design, such as a standard geometric figure, an emblem, or a motif would not. Further, any design which is dedicated solely by function or purpose of the article embodying the design would not be eligible for protection. Additionally ineligible would be designs in the public domain unless the design for which protection is sought was created without actual knowledge of the subject matter in the public domain. As in our present Design Patent Law, protection under the proposed Act would be lost if application for registration is not made within a six-month period after the date on which the design was first made known.

The proposed Act apparently would not provide for a novelty test of any kind, but would require that each application submitted be examined to determine whether or not it relates to a design subject to protection under the Act. Presumably, this examination would have as its object the determination of whether or not the design was a staple or commonly known design, or was dictated solely by the function or purpose of the article which embodies it. Whether the examination would also be directed to the question of whether the design was "ornamental" is not entirely clear.

Provision is made for contesting a holding of the administrator adverse to the applicant, as well as for a publication and opposition procedure, similar in some respects to that now used in trademark cases. The only ground for opposition specified in the proposed Act, however, is that the design is staple or commonly known.

In making application for a registration, the applicant must make oath that to the best of his knowledge and belief, the design was created by the author named in the application; that the design is original and has not previously been registered on behalf of the applicant or his predecessor in title; that the design has been made known as provided in the Act; and that the applicant is the person entitled to protection and to registration under the Act. The certificate which issues on a given application shall under the Act be admitted in any court as prima facie evidence of the facts stated in it.

The term of protection provided for in the Act is five years from the date upon which protection commenced, and is computed from the date shown in the notice. While a design utilized in the same form in a number of different articles is protected
as to all articles when protected as to one of them, with only one registration being required, protection in the particular design lapses upon expiration of the term, regardless of the number of different articles in which the design may have been utilized during such term.

Under the Act anyone who makes, has made, or imports for sale or use in trade an infringing article, or anyone who sells an infringing article who did not make or import it, will be considered an infringer only if he induced or acted in collusion with the manufacturer to make, or with the importer to import the article, or if he refuses or fails, upon the request of the proprietor of the design, to make a prompt and full disclosure of his source of the infringing article and orders or reorders such article after having received a personal written notice of the protection subsisting in the design. Infringement is not deemed under the Act to result when an infringing article is made, caused to be made, sold, or imported without actual knowledge of the protected design.

Interestingly enough, the proposed Act contains a section which provides that a manufacturer who incorporates in his own product an infringing article acquired from others in the ordinary course of business shall not be deemed an infringer except in those instances where he induced or acted in collusion with a manufacturer to make the infringing article, or in cases where he refuses or fails upon request of a design proprietor to make a disclosure of his source of the article.

The scope of protection which would be granted by the proposed act is somewhat narrower than that theoretically available under the design patent statutes, in that an infringing article is defined by the Act as any article the design of which has been copied from the protected design without the proprietor's consent. (Emphasis added.) Thus, protection is available only against unauthorized copying. Where an article embodies only a feature of the protected design which is dictated solely by the function or purpose of the article or which is in the public domain, it is not considered to be an infringement. Unlike copyright, the presence of an illustration or picture of a protected design in a book, periodical, newspaper, photograph, broadcast, or motion picture does not amount to an infringement of the protected design.

Where an infringement of a design protected under the proposed Act occurs, the proprietor of the protected design would
have a remedy by civil action instituted after the issuance of a certificate of registration. In proper instances the courts having jurisdiction would be permitted at their discretion to grant injunctions to prevent infringement, including temporary restraining orders and preliminary injunctions.

The court, upon a finding in favor of the design proprietor, would also be empowered to award damages adequate to compensate for the infringement, but these damages could in no event be less than the reasonable value of the use made of the design by the infringer in the course of the infringement. When damages are not found by a jury, the court shall itself assess them and in any event may at its discretion award up to treble damages, but this award shall be considered as compensation to the proprietor and not as a penalty. Recovery for any infringement committed more than three years prior to the filing of a complaint is barred absolutely.

As is the case relative to copyright infringement, the court is given the power, pursuant to the proposed Act, to order destruction of all infringing articles, plates, molds, patterns, models, or other means specifically adapted for producing the infringing design.

Of particular interest is the relationship of the proposed law to the copyright and design laws and it is this feature of the proposed Act which has been the most controversial. On the one hand, termination of protection of a design under the proposed Act would result upon the issuance of a design patent. Thus, should the proprietor of a protected design apply for and be granted a design patent for an ornamental design which comes within the purview of the proposed Act, his protection under the proposed Act would come to an end. There is no specific provision for the converse situation where the proprietor of a design obtains patent protection first and then applies for protection under the design patent law, but as a practical matter it is doubtful that this situation would occur with any frequency and in any event it would seem a reasonable view that prior issuance of a design patent would act as a bar to subsequent obtaining of a design registration.

On the other hand, where a copyright subsists for a pictorial, graphic, or sculptural work which is utilized in the design of a useful article by the copyright proprietor or under an express license from him, the resulting design is regarded, under the
proposed Act, as an original ornamental design of a useful article and accordingly is subject to and dependent for protection on compliance with the provisions of the proposed design act.

To bring the copyright law into harmony with this provision, the proposed act would itself amend Title 17, chapter 1 of the United States Code by adding a section which would provide that the ornamental design of a useful article shall not be subject to copyright and that where a pictorial, graphic, or sculptural work in which copyright subsists is utilized in the design of a useful article, protection will be dependent upon the design act. The section proposed to be added to the copyright act would define a useful article as one normally having an intrinsic function other than merely to portray its own appearance or to convey information.

A number of miscellaneous provisions are also set forth in the bill which more or less parallel those in both the copyright law and the design law. Penalties are provided for certain situations in which false marking has been done or a false representation has been made in securing the certificate of registration. Provision is also made for correction of errors in certificates, for transfer of ownership, for priority based on the filing of foreign applications, for cancellation of a registration in instances where the court deems it appropriate, and so on.

The second bill introduced in the 86th Congress is entitled "A Bill to Encourage the Creation of Original Ornamental Designs for a Limited Time Against Unauthorized Copying and to Preserve Copyright Protection for Creators of Artistic Works for which Copyrights Subsist." This bill differs from the one previously discussed in but two ways. One of these is the term of protection and the other is the relationship to the copyright law. Under the second bill, protection would be available for an initial term of five years and for second and third extensions of five years each, for a total protected term of fifteen years.

The relationship of the second bill to the copyright law is substantially different from that of the first, in that the proprietor of a copyright in a pictorial, graphic, or sculptural work will be required to rely for protection upon the design act only where he marks the design or article embodying the design with the statutory design notice, or where he makes an application for registration of the design pursuant to the design act for the

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55 S. 2852, 86th Congress, 2d Session (Talmadge Bill).
purpose of securing protection under that act. Where these two contingencies occur, the resulting design is regarded as an original ornamental design of a useful article and is from that time forward subject to and dependent for protection upon compliance with the provisions of the design act. Thus, the fact that a given design in which copyright subsists is incorporated in a useful article will not of itself force the copyright proprietor to turn to the design act for protection. He is required to do this only where he places the design notice on the article or seeks registration of the design under the Design Act.

Both revised bills have in principle received considerable support from those concerned with protection of intellectual property although certain specific provisions, particularly those dealing with the relationship of the proposed design act to the copyright law have been the subject of some controversy.

The statement of Robert C. Watson, Commissioner of Patents, to Senator Eastland, Chairman of the Committee on the Judiciary, urged that full consideration of the bill be given but refrained from reaching a conclusion upon the bills pending receipt of statements from those industries concerned. The Commissioner expressed agreement with the thought behind the relationship of S.2852 to the copyright law, indicating that where one has a copyright in conventional copyright material, such as a picture of statuary, he should be protected against copying even though the copy may be placed upon a useful article and even though the copyright proprietor may be publishing the picture or statuary attached to or forming part of useful articles. He felt, however, that perhaps S.2852 went too far, and that some amendment to the copyright law would be needed in the way of restriction and clarification to prevent useful articles from being registered under the copyright law and to clarify the distinction in this respect.

L. Quincy Mumford, Librarian of Congress, in his statement to Senator Eastland urged favorable action on S.2075. Mr. Mumford viewed both design patents and copyright law as inappropriate for protecting original designs in useful articles. This view was based on the fact that too much time was required for securing design patent protection and upon a feeling that copyright protection was entirely too broad for designs, par-

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56 Hearings, supra note 48, at 16.
57 Hearings, supra note 48, at 20.
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particularly with respect to the term of protection and the failure of the existing copyright laws to exempt innocent vendors and secondary users from liability as infringers. Inasmuch as the copyright law protects only those designs which can be separately identified as works of art, large areas of ornamental designs are not subject to protection, and Mr. Mumford considered this to be inequitable.

He favored S.2075 on the belief that the immediate effect of the passage of the bill would be the diminution of a number of difficult legal and operational problems affecting the copyright registration system. Mumford criticized S.2852 on the ground that the term of protection was too long and on the further ground that S.2852 would permit the continuance of existing long term copyright protection for all types of copyrighted works which could be used in the design of useful articles. He therefore reasoned that S.2852 failed to clarify the very problem which had prompted legislative proposals in the first place.

Chief support for S.2852 is to be found among the motion picture and allied interests who oppose the destruction of copyright protection in some works which would result from the enactment of S.2075. These interests favor S.2852 because it would afford design protection to those who desire it, and at the same time would preserve the availability of the copyright law for those to whom it is available and who desire to exercise their rights under that law. They feel that S.2075 would place artistic creators in an unfortunate predicament inasmuch as under this bill when a work in which copyright subsists is utilized in the design of a useful article, protection under the copyright law would terminate. This problem, of course, is of particular concern to the motion picture industry where, for example, copyright in a two-dimensional Mickey Mouse design would terminate when embodied in a Mickey Mouse doll, an article which is arguably useful. Incidentally, among motion picture interests, one of the most vigorous opponents of S.2075 appears to have been Walt Disney Productions.

Lest the preceding discussions convey the impression that acceptance of S.2075 and S.2852 is universal, it should be noted that support for them has been by no means unanimous even in principle. The Department of Justice has objected to the proposed legislation because of its historical opposition to legislation designed to minimize or except certain practices or acts from
the Anti-Trust Laws,\textsuperscript{58} and has indicated that the Bills may present constitutional questions. At least one carpet manufacturer has objected to the bill on the theory that it would create serious burdens and hardships by unduly limiting choice and adoption of designs and by creating nuisance litigation in claims of infringement despite reasonable efforts on the part of carpet manufacturers to remain free of legitimate infringement charges.\textsuperscript{59}

The proposed legislation has also been the subject of scattered opposition as the result of their failure to stipulate novelty requirements as a prerequisite to the conferring of protection.

**Summary and Conclusions**

It is currently clear that within that realm known as intellectual property, a segment does, in fact exist, which may be protected under either the copyright laws or under those laws on design patents.

The influences which have given rise to this situation are varied, but of primary significance among them seems to be a haphazard statutory development in which the legislature has failed to maintain a clear line of distinction between the forms of protection with which we are presently concerned. A lack of planned statutory growth has in turn been reflected in the attitudes of the courts and of the agencies charged with the administration of the laws on intellectual property.

Be that as it may, the artisan who brings forth a design which may be independently classified as a "work of art" may resort either to copyright or to design patent to protect the fruits of his labors. This, notwithstanding that the work may be incorporated in an otherwise utilitarian article. The dividing line between that which may legitimately be classified a "work of art" and that which may not is far from being well defined. In general, however, it would appear that where those features which constitute the article a "work of art" are capable of existing independently, a situation exists in which copyright laws and design patent laws have dual applications.

In a situation in which either design patent or copyright will lie, the designer or his attorney face an election of the form of protection to pursue; for while the Supreme Court has yet to

\textsuperscript{58} *Hearings*, supra note 48, at 19.

\textsuperscript{59} *Hearings*, supra note 48, at 84.
pass on the proposition, the lower courts are firmly entrenched in the view that the designer is not entitled to both forms of protection on the same work. Although mere patentability is not sufficient to bar copyright on a given work, the taking out of a patent on the work is sufficient to constitute a bar, and vice versa.

When making a selection between forms, the attorney would do well to consider seriously the use of copyright in preference to design patent; the patentee's burdens in convincing the court that his design rises to the dignity of patentable subject matter are frequently overly taxing. Coupled with the additional advantages of economy, relatively long term protection, and a minimum time lapse between application and registration, the copyright will very often be a more favorable protective measure than the design patent.

Even so, it would seem that resort to the copyright laws for protection of designs is at best a stop-gap approach. These laws are not geared to protection of industrial designs. Indeed, the scope of protection available under the copyright laws seems far more sweeping than that which is either necessary or desirable adequately to protect the interests of the design industry.

The design patent laws are too unwieldy to be particularly useful. That design protection should have been incorporated into the patent laws in the first place is itself a proposition of dubious validity.

Yet it seems clear that some form of protection, gauged specifically to the needs of the industrial designer, is needed. The designer has, in his own way, a noticeable impact upon the growth of the arts and the sciences. His efforts are as worthy of limited recompense as those of the photographer, the painter, the composer, the sculptor, or the writer.

As a practical matter, the designer appears in most cases to be concerned with the prevention of outright plagiarism over a relatively limited term. By its very nature, a design has commercial value, usually, for only a relatively short period, perhaps for a year or less in the case of the dress design. During this term, a form of protection, comprehensive enough to give adequate remedy against copying should be available.

Both bills which have been recently proposed are a long stride forward in providing the kind of protection a designer needs to conduct his business effectively without at the same time subjecting his competitors to unwarranted restrictions. The bills
as a whole are founded on solid principles and upon a thorough study of the problem.

While it may be questioned whether S.2852 (with its provision permitting resort by some designers to the copyright laws in preference to the proposed design registration laws) would in fact be of as much assistance in establishing a well defined line of demarcation between forms of protection as would S.2075, either bill would be a significant improvement over the laws that presently govern our actions.

The existing law on design protection is confusing and disordered, with the result that the application of law to facts is frequently inequitable and lacking in uniformity. There has historically been opposition to corrective legislation and there probably always will be. Even so, it is high time steps were taken to cut through the maze of contradictory decisions and conflicting statutes in order to establish a well planned and sensible system for protection of designs in an equitable and efficient manner.