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DISCUSSION OF INDUSTRIAL DESIGN PROTECTION PRACTICE IN GOVERNMENTAL AGENCIES AND COURTS*

Mr. Saidman: Design patents need to be prepared and prosecuted just as carefully as utility patents. You have a duty of disclosure in utility patents. Attorneys are very well accustomed to sitting down with inventors and going over the entire history of the invention with them. The facts have come out in the utility situation. Most attorneys would have taken those facts and turned them over to the U.S. PTO [United States Patent and Trademark Office].

When it does not happen in a design situation, it is probably more due to the cavalier attitude that patent attorneys take when it comes to design patents. They are an afterthought. They are a stepchild. But if you pay attention to them, as I did in the *Avia* case, where we sat down and we did get that prior art. We submitted it. Then those kind of defenses do not work.

Mr. Ansher: The Mickey Mouse telephone turned out to be a highly commercial phone that was designed, more or less, to coordinate with the theme parks at Disney World. They also have a copending utility patent issued on that phone. The utility patent has claims directed to the handset hanger which has some interesting electronic functions. We still attempt to provide patent protection to deserving designers.¹

Ms. Schrader (responding to a question concerning the copyright separability test): I am aware, of course, that conceptual separability has been discussed in recent court cases. Obviously, I think this is because those who seek protection would attempt to make a showing that there is in fact something conceptually separable. It is easier to prove than physical separability. What I am trying to say is that physical separability is more of a fact. Conceptual separability is more in the mind. The Copyright Office does not have any particular difficulty at this point with the standard of conceptual separability. For us the test is being able, in your mind, to separate the artistic features and the basic utilitarian shape.

For most applied designs, especially modern furniture designs, there is no separation, in our opinion, between the basic utilitarian shape and the functional design. There is simply no separation, so we do not have any particular difficulty with conceptual separability. For us, conceptual separability really means that the separability does in fact exist, but it cannot be maintained physically. That is, you cannot take the item apart easily and

* This is an extract of a discussion on the conference session on industrial design protection practice in governmental agencies and courts. Each session of the conference was recorded, and the transcribed record was used as the source for this extract. Every effort was made to reproduce faithfully the full discussion. Some editing, however, was necessary due to transcription quality and space limitations.

1. The Mickey Mouse design and utility patents discussed herein are found *infra* at 485-95.

have a utilitarian object on the one hand and a free-standing work of art at the same time.

Most of the cases that we decide are in fact conceptual separability cases. In most cases we find that there is not any conceptual separability because the artistry and the functional design merge.

Ms. Schrader (responding to a question of whether placing a work in a museum affects the Copyright Office decision on registrability): Officially, if it is an article of utility that you are dealing with, then you apply the separability test. The fact that the museum has decided, for other reasons, presumably for aesthetic reasons, that this is something of particular value and should be put on display, is not something that we [Copyright Office] would ordinarily take account of. Again, I should stress that we are talking only about articles of utility. If you happen to have a particular object that is not an article of utility, then the fact that a museum has recognized it as a painting or a sculpture or something like that has some significance.

Ms. Schrader (responding to a question concerning the *Brandir* case, which involved a bike rack design): That was an extremely difficult question, but that particular object was so simple, so symmetrical in appearance, as it was presented to the Copyright Office. It always looked like a bicycle rack to us. Even if it had never been used as a bicycle rack, it would have been a difficult question. There is no doubt of that. Basically, you do not apply the separability test [if a work is not a useful article]. Instead you apply a test of originality alone. You make a determination of whether there is sufficient creative expression in the object, as a whole, to warrant registration. You know, generally, the opinions of experts, such as museums, that the object may be within the historic category of a work of art. The museum recognition might have significance. It is a very difficult question when you are getting down to such a minimal approach as was used in the bicycle rack.

Ms. Schrader (responding to a question concerning the Copyright Office's reaction to modern art): I think modern art in this context means primarily the design style that has been filed at least since World War II, and really through much of this century. It really is distinguishing it from a historical design style that might be more given to ornamentation. I was only suggesting that if you have ornamented objects, you generally do have some separable artistic features. I mean the obvious examples that have always been given are a lion's head carved on top of a chair, a piece of sculpture attached to the hood of an automobile. Obviously, a clearly victorian work applied to a refrigerator might also have been applied on canvas or on a piece of paper. Those are obvious examples of separable artistic features that have no relationship to the basic shape of the utilitarian object, whereas

I understand many, if not all modern designers, attempt to merge aesthetics and function.

Unfortunately, I do not have pictures to illustrate the copyright cases, as did the gentleman from the U.S. PTO. When you look at the copyright cases, most of them are fairly clear issues of copyrightability. An example is the leading case *Mazer v. Stein*, where you had a statue, a sculpted human figure. Of course, that is a fairly easy case now, we say. The issue in *Mazer* was whether you lose protection once you put that copyright subject matter into mass production and treat it as an article of utility. At least I think the *Mazer* case stands above all for the principle that if you take something that is a work of sculpture within the meaning of the copyright law, the fact that it can be mass produced, or the fact that it is made part of an article of utility, does not destroy its protection.

If you take the case of the Esquire outdoor light, you have a fairly simple structure that is essentially to house the bulb of the utilitarian object. The housing feature is, of course, part of the utilitarian shape. You would not just mount, or at least ordinarily not mount an outdoor light without some type of housing to protect it, as a part of the basic shape of the utilitarian object. There is nothing separate.

Ms. Schrader (responding to a question regarding the Copyright Office's meaning of ornamentation): Well, as to ornamentation, there is no question modern designers use ornamentation, and they have separable artistic features. They can get registration for those separable artistic features. If I am not mistaken, there is little ornamentation in modern design. If I am wrong about that, then to the extent there is ornamentation, certainly it can be registered.

Your point about other subject matter. A book, I should say more precisely a literary work, is not an article of utility. That is the whole point. We are here talking only about the question of the extent to which designs applied to articles of utility can be given copyright protection. Whether they should be given what is essentially a minimum of seventy-five years of protection. Whether they should be protected both with respect to conscious and unconscious infringement. That the infringement can be found with respect to retailers who sell the object without having any idea that it is an infringing object. These are the basic principles of copyright.

I return to the point that a literary work is not an article of utility, and therefore even those that are sometimes referred to as useful works, are not strictly within the meaning of the law. They, in general, give information. Maps have always had utility, they give information, but they are not strictly speaking utilitarian objects.

Question: I would be interested in asking Mr. Ansher if he would verbalize as to how he applies the section 103 test [35 U.S.C. § 103]. What

process do you go through in your analysis of whether or not you are going to reject it or allow it?

Mr. Ansher: The standard one normally uses, without getting too legalistic, is one where you have to find a reference that substantially teaches the general, overall, appearance of the design being applied for. Normally, the reference would disclose all the essential features of that particular design. The examiner would reject it with the one reference, because the differences between that design applied for and the reference is such that someone with ordinary skill in that art (your fictitious ordinary, competent worker or designer in that art with the patent examiner playing that role) would find them obvious changes. If the differences are such that they are very minor, they have very little or no visual impact on the overall design, and the claim would be rejected.

If a combination of references is needed, you would have to find a single reference that is essentially the same as the claimed design, and the differences would have to be shown with a secondary reference, or references. The teaching reference would have to show that to put these secondary expedients together, in such a manner as to result in what was being planned would be obvious to that person skilled in the art. For example, if you had a tape recorder, where you found a reference that was strikingly similar, in overall appearance, to the claimed design, you would start out by saying that the claim is rejected as unobvious over the basic reference A, being strikingly the same as applicant's design. To further modify that basic reference by providing a conventional knob, as taught by the secondary reference B, and further arrange them in the manner taught by reference C, would be obvious to one skilled in the art. The differences were shown to be old and well-known design expedients in the art. To combine these features together in this manner would be an obvious modification to one with the ordinary skill in the art.

Question: Does the U.S. PTO examine for functionality?

Mr. Ansher: Yes, if the inherent function of that particular design is based primarily on functional considerations. In other words, it is inherent in the particular design that it have that specific configuration. It is strictly functional. Then we reject it on lack of ornamentality under 35 U.S.C. § 171.

Mr. Pravel (responding to a question concerning whether the pending legislation has a simpler test than the design patent law): I think we have been trying to answer that question. Is there any way to avoid the obviousness issue that is fundamentally involved in design patent law? I suppose the answer is the proposed legislation does remove that issue in its complexity.

It has a slight test, so it cannot be exactly the same as the prior art involved. I think that the proposed legislation does do that. For me, that is one advantage of it, in terms of the ordinary designers.

Comment from a designer in the audience: I do not have any solution. I think one of the reasons I do not have a solution, and neither do you really, is that I think so much differently from you. Designers think differently from lawyers, by necessity. One of the comments I said earlier was designers are visual people, and visual people think visually. It is the way you folks talk about design, that it is a foreign language to me, because I see so many things. I know what is involved. You people, rightly so, have to put it into words and that is where the problem lies. I do not have any solution.

Mr. Saidman: I want to thank the panel. I for one hope this conference will be remembered as the first of many such annual events. I think it puts industrial design on a pedestal where it belongs. It focuses on the importance and the need for adequately protecting the creators of these unique intellectual properties. I think we, therefore, need to acknowledge the vision, commitment, the plain hard work that Professor Fryer and his staff have made in putting this wonderful program together.

Professor Fryer: Thank you Perry. I think you have done a marvelous job, as did all the other moderators. I do not know how to thank you all adequately.

Industrial designers are such strong individuals who independently carve out their own domain. They have made their presentations here very effectively.

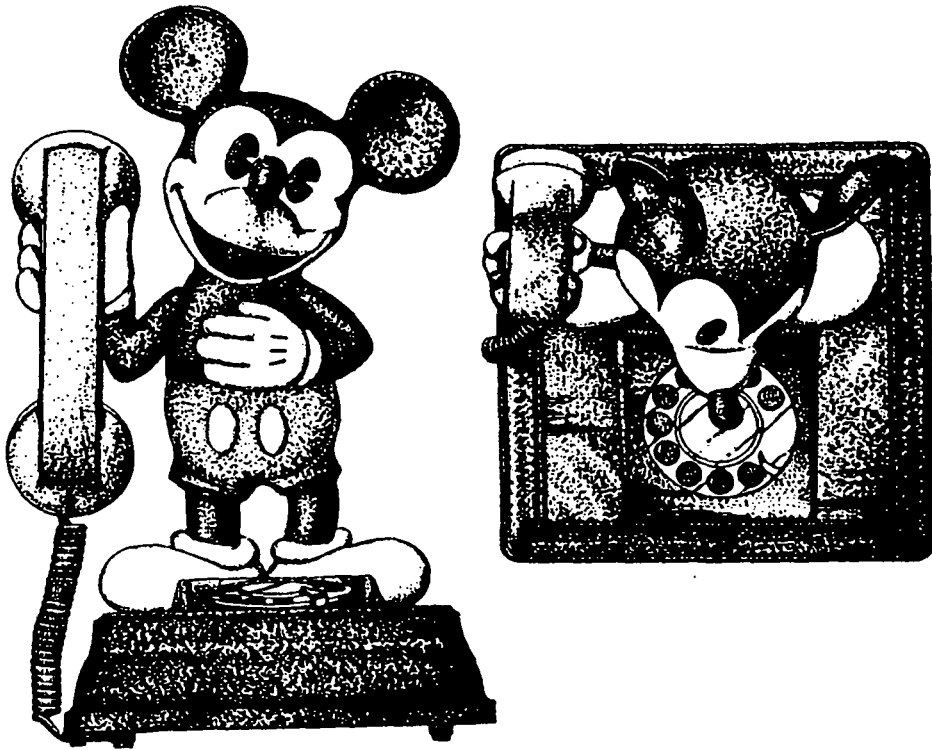
On behalf of the University of Baltimore, and other sponsoring organizations, I thank you for coming to this conference. It has been a pleasure having you here. I hope, as Perry said, that this is really the beginning of a dialogue. So we are talking to each other, the lawyers, industrial designers, and government people. I felt a certain empathy coming across the table between designers and others. There is a better understanding of each other.

MICKEY MOUSE DESIGN PATENT

U.S. Patent

Oct. 24, 1978

Des. 250,023



U.S. Patent Oct. 24, 1978 Des. 250,023

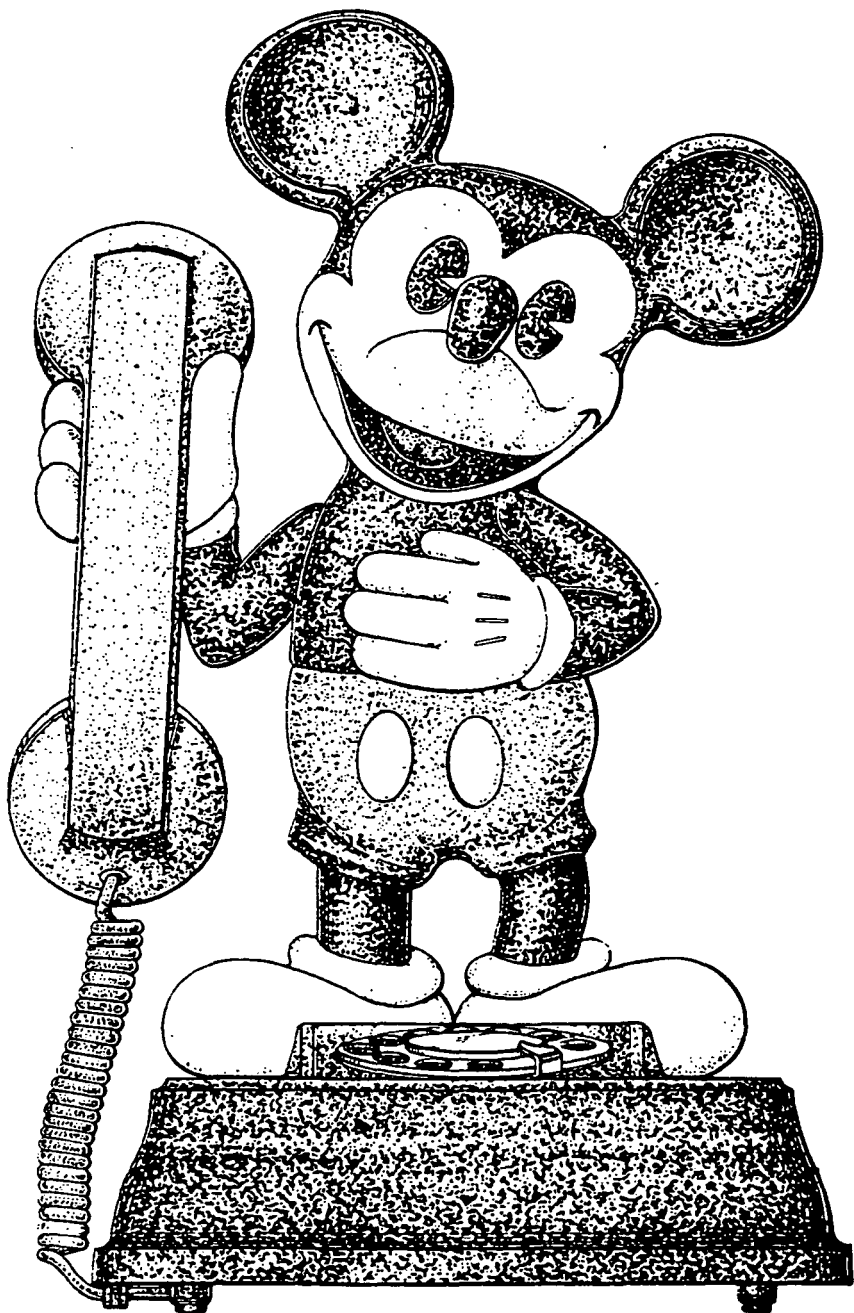


Figure 1.

U.S. Patent

Oct. 24, 1978

Des. 250,023

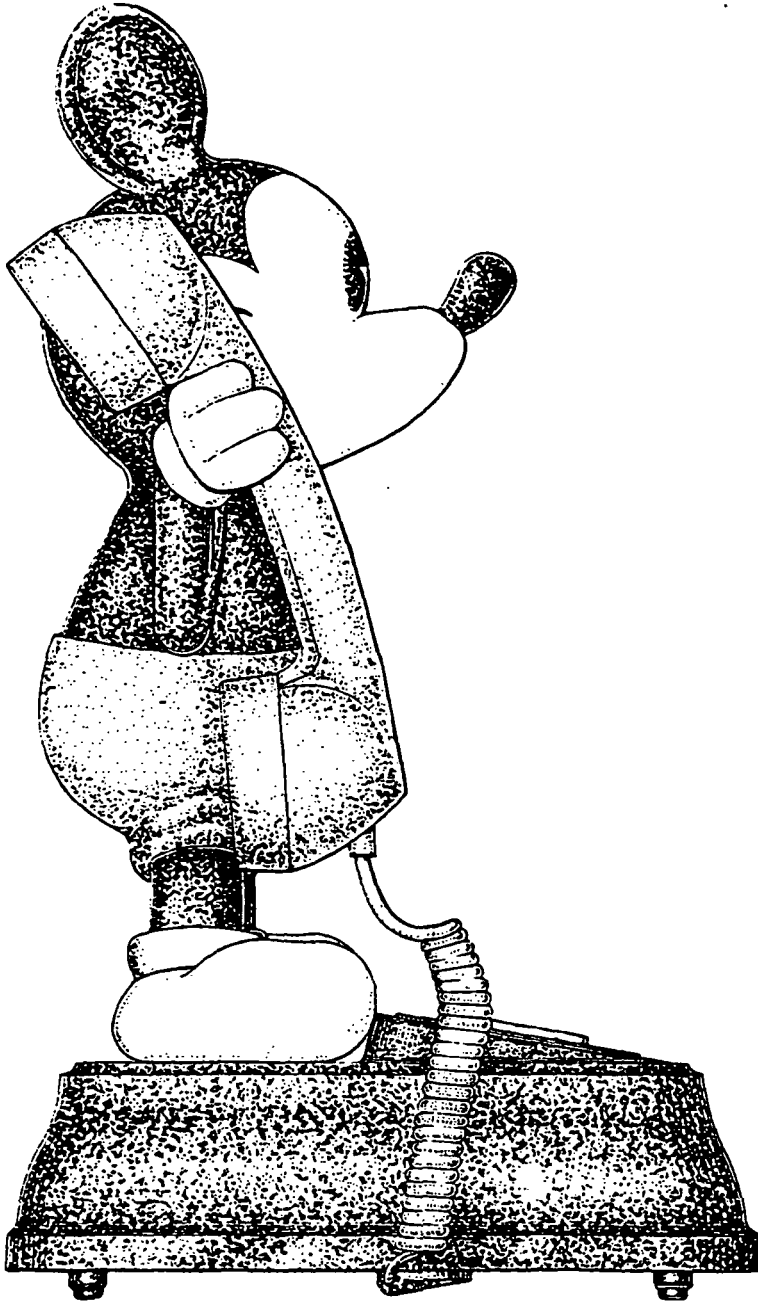


Figure 2

U.S. Patent

Oct. 24, 1978

Des. 250,023

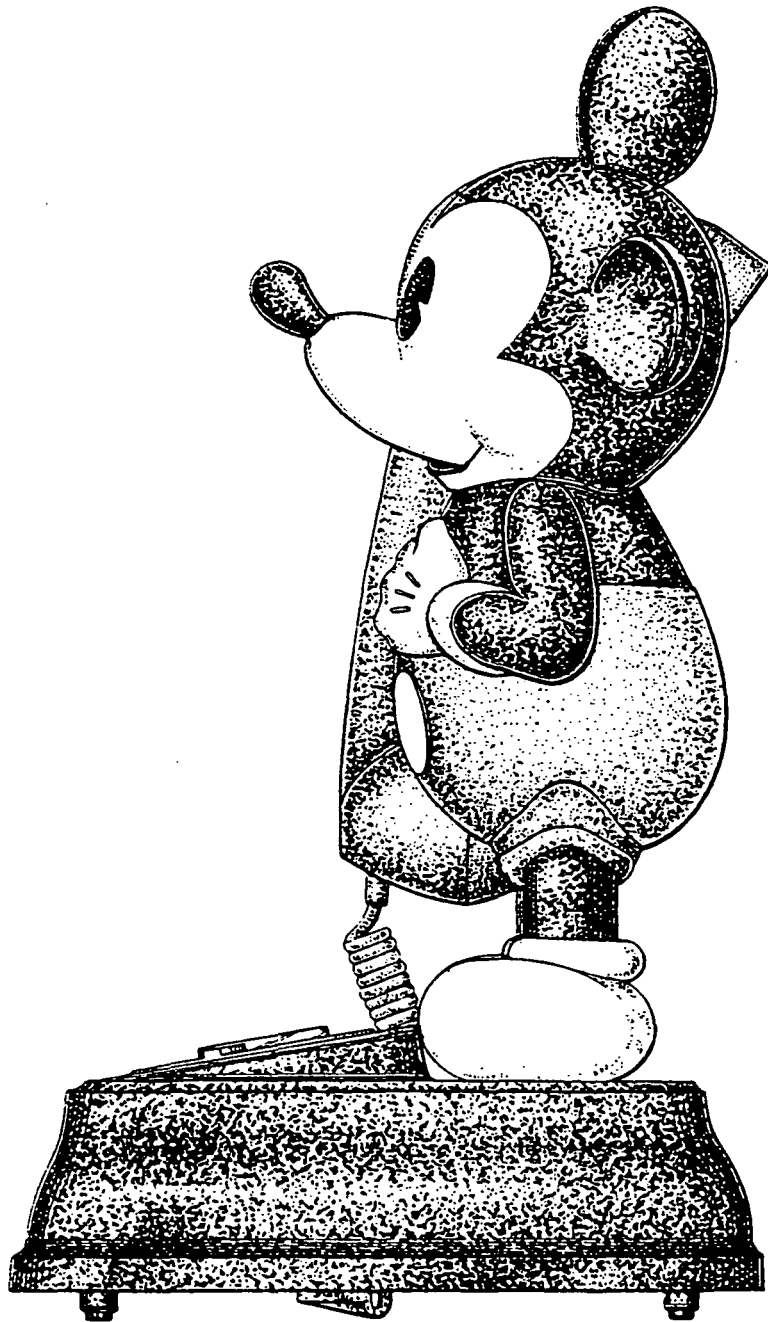


Figure 3

U.S. Patent

Oct. 24, 1978

Des. 250,023

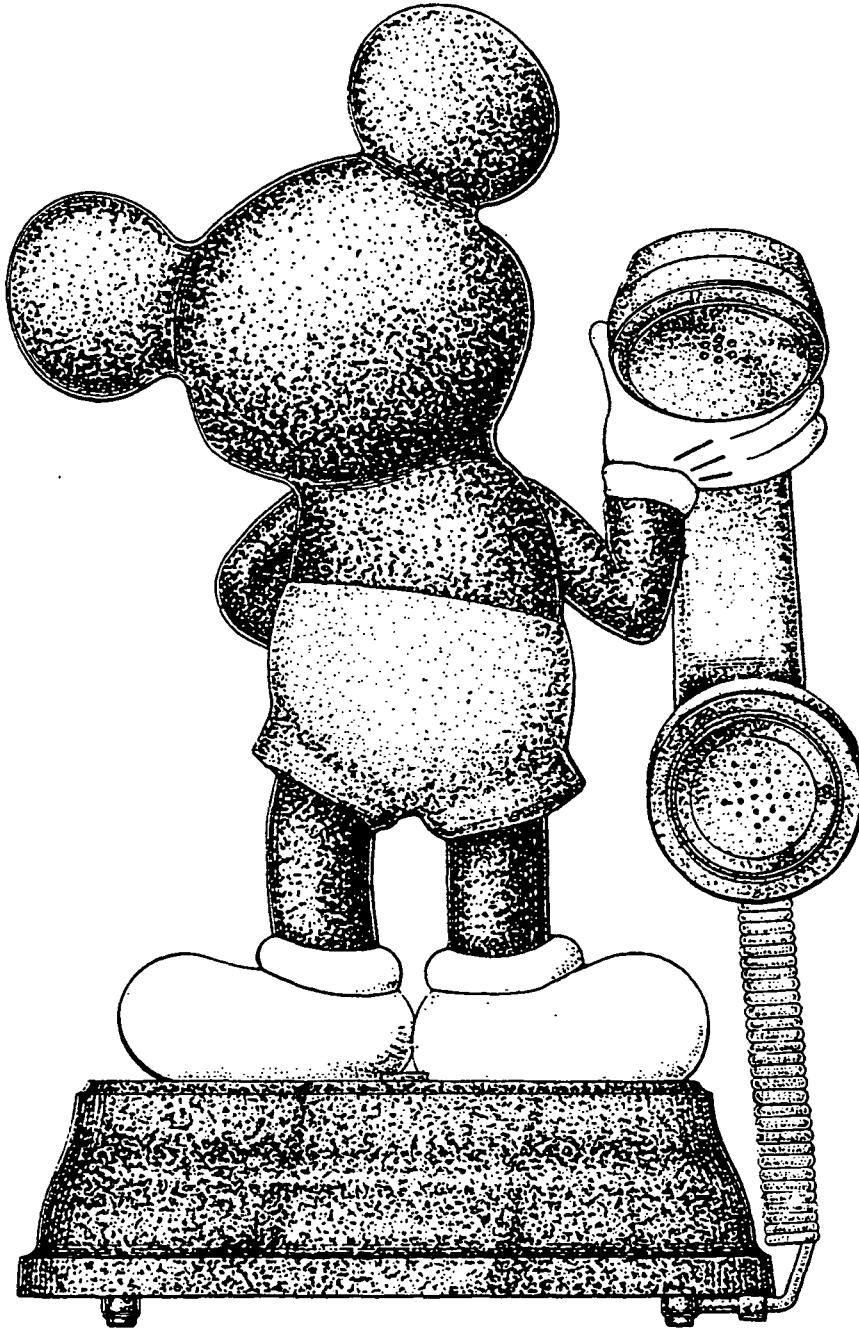


Figure 4

U.S. Patent Oct. 24, 1978 Des. 250,023

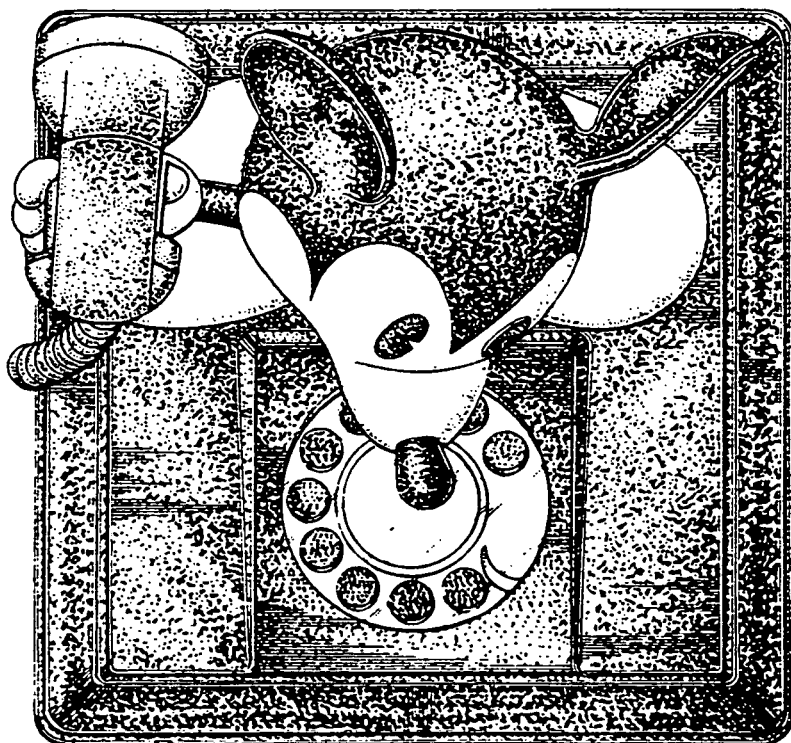


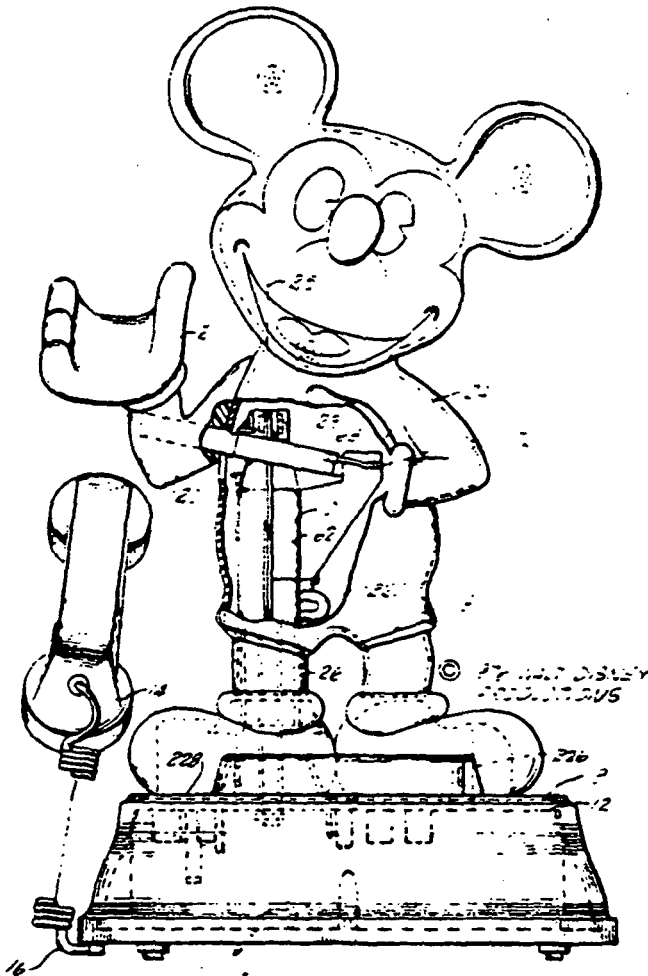
Figure 5

MICKEY MOUSE UTILITY PATENT

U.S. Patent

May 2, 1978

4,087,650



U.S. Patent

May 2, 1978

4,087,650

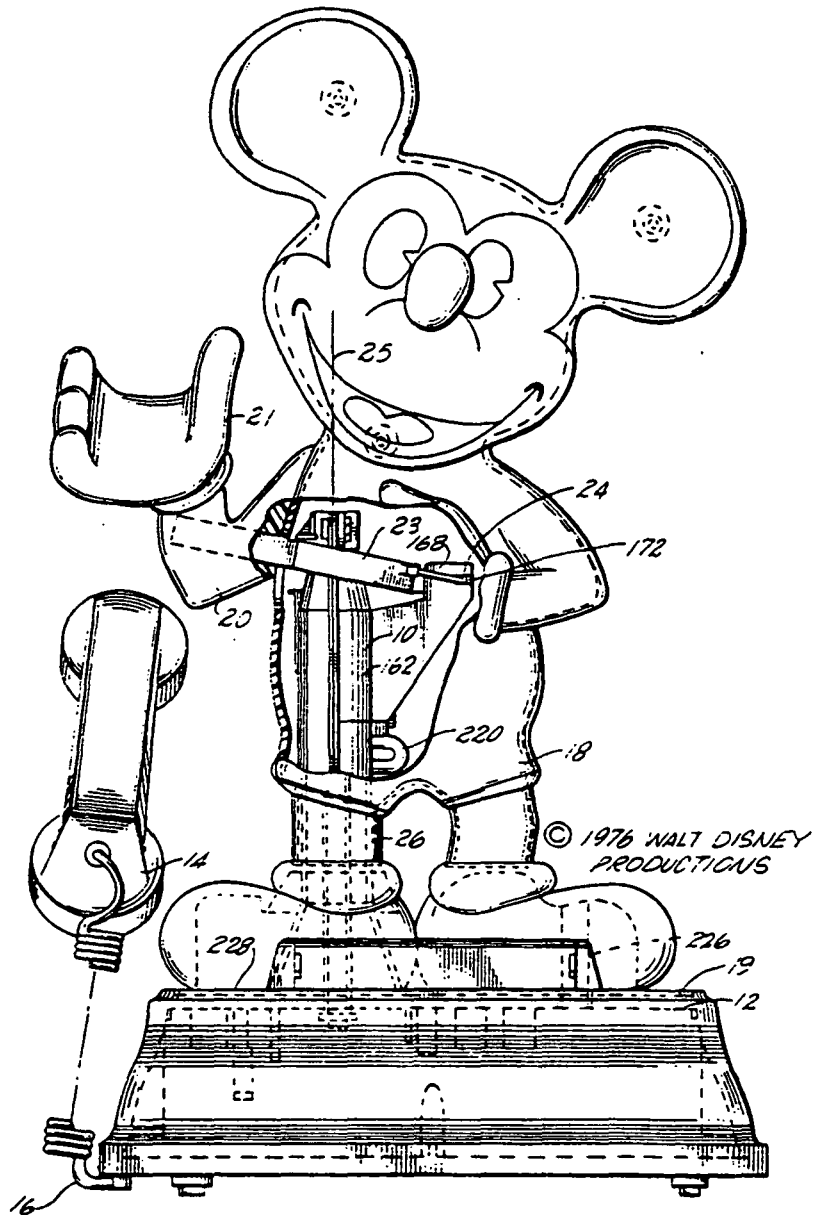


Figure 1

U.S. Patent

May 2, 1978

4,087,650

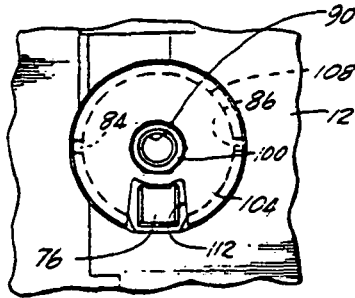


Figure 4

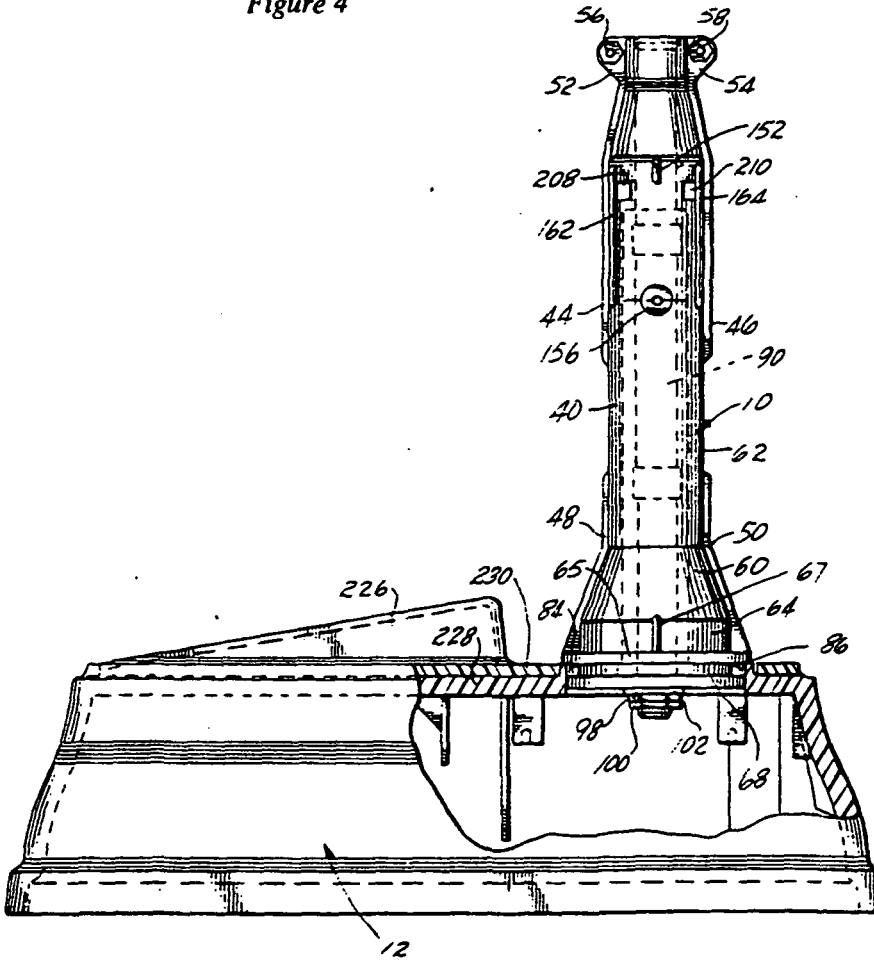


Figure 2.

U.S. Patent

May 2, 1978

4,087,650

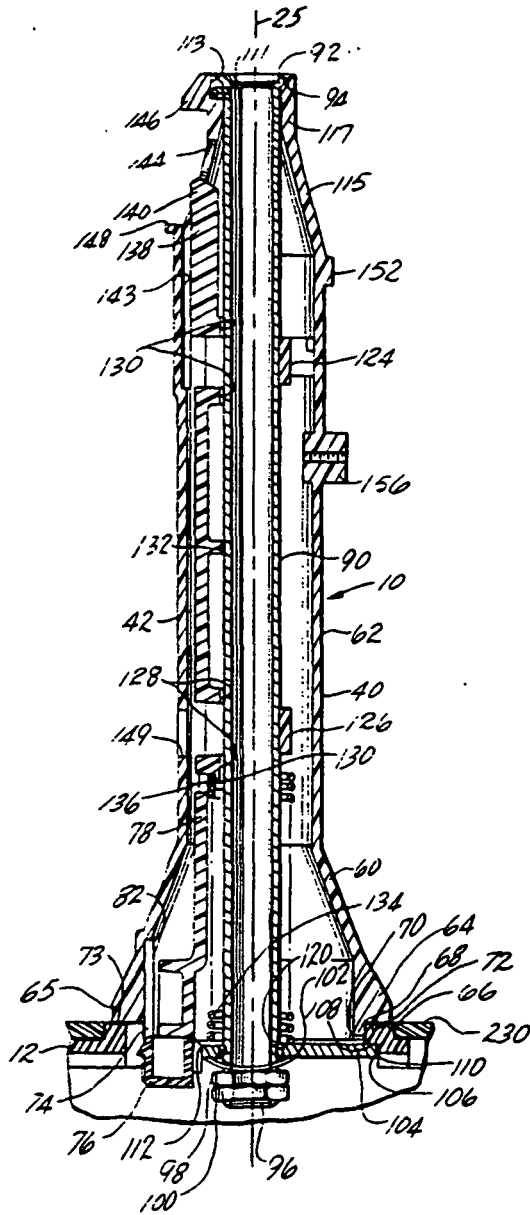


Figure 3.

