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INDUSTRIAL DESIGN LAW AND PRACTICE— INTRODUCTION TO A SYMPOSIUM

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The National Conference on Industrial Design Law and Practice was held on March 10 and 11, 1989, at the University of Baltimore School of Law. The conference brought together industrial designers from different design fields, as well as lawyers, academics and governmental agency officials to discuss recent developments in industrial design protection. It included four sessions: the first was an overview of the United States' situation; the second session included specific issues of design protection; the third session covered international developments; and the fourth session encompassed design protection practices in United States governmental agencies and courts.

Inspiration to organize the conference came from many sources. Some industrial designers were asking for assistance in effectively using intellectual property protection laws. Many intellectual property lawyers were frustrated with design protection laws, pointing out gaps and inequalities in protection. More assistance was needed for United States governmental agencies that control industrial design protection, even though they were doing their best to enforce the laws with limited resources. For example, the United States Patent and Trademark Office (PTO) had an increasing design patent application backlog which resulted in as much as a three-year wait to obtain a design patent.

Congress was considering legislation on an additional form of protection.¹ While this type of legislation had been pending for many years, the

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1. In the 101st Congress, there were three industrial design related bills pending before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary: H.R. 3499, 101st Cong., 1st Sess. (1989); H.R. 3017, 101st Cong., 1st Sess. (1989); and H.R. 902, 101st Cong., 1st Sess. (1989). H.R. 3499 was supported by the Bush Administration and contained the same general features as the other bills. H.R. 3017 had 28 cosponsors and it included revisions to clarify the scope of subject matter protection. H.R. 902 was sponsored by Congressmen Moorhead, Fish and Michel. There were no corresponding Senate bills pending, but there was a hearing held in the Senate on March 26, 1987, concerning The Industrial Innovation and Technology Act of 1987, S. 791, 100th Cong., 1st Sess. (1987), that corresponded generally to the current bills. The House Subcommittee held a hearing in 1988 on H.R. 1179, corresponding generally to the pending bills. *Protection of Industrial Designs of Useful Arti-*

need for improvement in design protection had become more generally recognized, as illustrated by the growing number of lobbying groups formed by major industries to support the pending legislation.

The international picture was also changing to reflect the importance of design protection in most foreign, industrialized countries. Canada and Japan, for example, were considering changes in their industrial design protection laws, and the United Kingdom had recently enacted legislation² similar in some respects to the United States' pending legislation. Another development was in international cooperation, with more interest being shown in the Hague Agreement Concerning the International Deposit of Industrial Designs³ (Hague Agreement) which set up a centralized system for filing design applications in several important countries.

All these events inspired the conference and resulted in this Symposium which contains papers presented at the conference and other articles on design protection. The Symposium is organized like the conference, with four main topic sections. In addition, extracts from discussions involving the conference participants are included in each section. The first section includes papers from leading authorities on their views concerning current United States design protection. This section begins with a review of the historical development of United States industrial design protection law by J.H. Reichman, a professor at the Vanderbilt University School of Law. Professor Reichman notes the unique features of copyright, design patent and trademark law and identifies a cyclical nature to the concerns over improving industrial design protection. Cooper C. Woodring, an industrial designer, follows with his paper which stresses the significant impact of industrial design on our lives.

The third paper in this section is by Thomas Lowy, a former president of a lamp manufacturing company. Mr. Lowy discusses his recent, successful litigation to protect one of his designs known as the "Dove" lamp. Mr. Lowy's experience with imitators is typical of the industrial design problems faced by United States companies and designers, in part because the trademark law only applies when significant market recognition has been developed. According to Mr. Lowy, tremendous company time and money were expended to bring the suit and the usefulness of the suit was very limited. He expressed the need for a simpler, more effective system to protect product designs. The Dove lamp litigation is discussed further in a case history that follows Mr. Lowy's paper. The case history discusses the economic

cles: Hearing on H.R. 1179 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary, 100th Cong., 2d Sess. (1988).

2. See Copyright, Designs and Patents Act, 1988 [United Kingdom], ch. 48, pt. III.

3. Act of The Hague, Nov. 6, 1925, 47 Stat. 1789, T.S. No. 941, 74 L.N.T.S. 341, revised at London, June 2, 1934, 205 L.N.T.S. 179, reprinted in WIPO & BIRPI, MANUAL OF INDUSTRIAL PROPERTY CONVENTIONS, items A-1, B-1.

principle that there must be adequate protection to stimulate creativity and product development.

The fifth paper in section one is by Perry J. Saidman, a design patent attorney. Mr. Saidman discusses the merits of using design patents when they are properly obtained and litigated. The next paper is by Albert Johnston, an attorney in private practice, who reviews United States governmental research on industrial design protection dating back to the 1930s. Mr. Johnston advocates improving industrial design protection by passing the pending legislation. The last paper in section one is my survey of United States design law protection and a detailed explanation of the pending legislation.

The second section addresses specific industrial design protection issues. It begins with a discussion of the controversial crash parts protection issue, which is one of the major obstacles to the passage of the pending industrial design legislation. The insurance industry is concerned about the effect on the price of car replacement parts if new industrial design protection is enacted. In the first paper, Kenneth Enborg, a General Motors attorney, explains why industrial design protection is vital to automobile manufacturers. The second paper is by James F. Fitzpatrick, an attorney whose clients include a member of the car insurance industry. Mr. Fitzpatrick points out that industrial design protection raises complex economic questions, and he submits that there is no economic justification for the pending legislation, at least as to the auto parts business. The next paper is by William S. Thompson, a representative from the heavy equipment industry, who illustrates the impact of imitators on his industry and calls for the passage of the current design legislation.

Section two continues with a paper by Ralph S. Brown, a professor at Yale Law School, who reviews the history of industrial design copyright protection and discusses how the pending legislation may be interpreted. The next section two paper, by Wallace R. Burke, Supervisory Design Patent Examiner of the PTO, focuses on one of the most difficult issues in design patent law, the interpretation of the nonobviousness standard.⁴ Mr. Burke reviews the historical development of the standard as it applies to design patents. In section four, Mr. Ansher's paper reviews how this standard is applied in PTO design patent application examinations.

The historical development of trademark law on industrial design protection is reviewed in the next paper, by John B. Pegram, an attorney in private practice. Mr. Pegram's analysis of the trademark law principles explains the substantial burden of proof Mr. Lowy had in the Dove lamp litigation. The last paper in section two is by Perry J. Saidman and John M. Hintz, discussing the doctrine of functionality in design patent cases. The discussion extract from section two includes comments of O. Charles

4. The standard is codified at 35 U.S.C. § 103 (1988).

Leinbach, a full-time industrial designer, lawyer and adjunct professor on intellectual property law at Ohio State University. Mr. Leinbach stressed the tremendous financial investment in product design for even small products. His remarks illustrate industrial designers' frustrations caused by having ineffective protection for soft designs, the type of features that cannot be protected by utility patents.

The section three papers concentrate on international developments in industrial design protection. In the first paper, Christine Fellner, a barrister in London, reviews the major change recently undertaken in industrial design protection laws in the United Kingdom. A Design Right⁵ was added, which is a system similar to copyright protection and the pending United States industrial design legislation. The United Kingdom Design Right is a reciprocal arrangement, similar to the United States Semiconductor Chip Act,⁶ which requires the United States to have an equivalent form of protection for its citizens to receive the benefit of the Design Right. Although the United States does not currently have an equivalent form of protection, the pending legislation may provide sufficient protections to allow the United States to take advantage of the United Kingdom Design Right. The discussion extract at the end of section three briefly addresses this issue.

Section three includes a paper by Pierre Maugué, a specialist in industrial design law and representative of the World Intellectual Property Organization (WIPO), the United Nations agency in Geneva, Switzerland that administers the world's major intellectual property treaties. Mr. Maugué explains that the Hague Agreement functions in some respects like the Patent Cooperation Treaty⁷ because it offers simultaneous filing of design applications in twenty-one countries through a single filing with WIPO. It is a system that United States design owners cannot use directly because the United States is not a signatory to the Hague Agreement. There are obstacles to the United States joining the Hague Agreement, including the examination requirement⁸ under United States design patent law and the significant delay before design protection begins. The pending legislation may be more compatible with the Hague Agreement and permit the United States to adhere to this treaty.

The section three papers by Robert E. Mitchell from Canada and Yoichiro Yamaguchi from Japan provide reports on industrial designs protection in these countries. Canada, for example, recently changed its copyright system to increase the industrial design subject matter protected. In Japan a very large number of design registrations have been filed, indicating a strong interest in industrial design protection. The last paper in section

5. Copyright, Designs and Patents Act, 1988 [United Kingdom], ch. 48, pt. III.

6. 17 U.S.C. §§ 901-14 (1988).

7. Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7647, T.I.A.S. No. 8733.

8. 35 U.S.C. § 131 (1988).

three was presented by Rosemarie G. Bowie, from the PTO Office of Legislation and International Affairs, which handles international issues and domestic intellectual property legislation. Ms. Bowie reviews the history of United States industrial design legislation and comments on several international developments. Of particular interest is that the PTO led the effort to obtain the Bush Administration support for industrial design legislation, culminating in the Administration preparing an industrial design bill filed in 1989.⁹

Section four, the last group of papers, addresses industrial design protection practice in the United States Copyright Office, the PTO and the courts. The first paper presents an overview of the development of copyright law protection. This paper was presented by Dorothy Schrader, Associate Register of Copyrights for Legal Affairs of the Copyright Office. Ms. Schrader provides insights on the failure of the copyright law to offer sufficient protection for industrial designs.

There are many aspects of design patent and utility patent litigation which are the same. In a section four paper, B.R. Pravel, an attorney in private practice, reviews litigation practices concerning design patents and discusses problems in the application of patent law to design patents. In the next section four paper, Roland Carter reports his experience as an industrial designer expert witness in a design patent lawsuit. The final paper in section four, by Bernard Ansher, Supervisory Patent Examiner of the PTO, is a comprehensive review of PTO practice in the Design Patent Group. Mr. Ansher provides insights on improving design patent application practice and notes that design patent application drawings are the key to what is protected.

This Symposium provides an analysis of industrial design law and practice. It illustrates where improvements are needed in the substance and administration of the United States design protection laws. Further, it demonstrates the value of a comprehensive examination of all forms of United States intellectual property affecting industrial designs and the importance of international developments and treaties.

The conference would not have been possible without the help of the University of Baltimore Law School administration, faculty, the *Law Review* staff and the students who supported the conference and this publication. In addition, I gratefully acknowledge the cosponsorship of the conference and other support by the American Bar Association, Section on Patents, Trademark and Copyright law, the American Intellectual Property Law Association, the Association of Professional Design Firms, and the American Society of Furniture Designers.

9. See H.R. 3499, 101st Cong., 1st Sess. (1989).