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WHERE IS THE PROTECTION FOR CREATIVE PRODUCT DESIGN?

Albert C. Johnston†

Existing design patent law falls far short of effectively protecting original designs of useful articles.⁴ Legislation to provide short-term copyright protection for original designs of useful articles has come close to enactment in the United States from time to time for decades, yet it has continually failed to become law for one reason or another.

During the 100th Congress, a revised design copyright bill, known as S. 791 in the Senate, and H.R. 1179 in the House, again failed to be enacted into law. The proposed bill provided a system for the protection against copying any original design of a useful article which is distinct in shape or surface appearance. The bill also would have enabled owners of protected designs of parts of useful articles to control the replacement of such parts of their products. This gave rise to a dispute regarding motor vehicle "crash parts," which in turn generated opposition to the bill by consumer advocates and automobile insurance companies.

Since 1842, when the design patent law was enacted, many original designs have remained prey to copyists for two main reasons. First, original designs of useful articles, with limited exceptions, are outside the "works of art" definition of the Copyright Act.⁵ Second, the procedures and determinations required for the procurement and enforcement of design patents are inappropriate for ornamental designs.

This Article will consider some of the most recent issues surrounding proposed design copyright legislation and discuss the need for a design copyright system. The evaluation will be aided by an historical review of efforts to protect original designs of useful articles.

As early as 1914, some members of Congress recognized the inadequacies in the laws protecting ornamental designs. H.R. 11321, the first bill dealing with effective design protection, was introduced in the 63d Congress, but failed to become law.⁶ In the 1920s, the House Committee on

1. See Johnston & Fitch, Design Piracy—The Problem and Its Treatment Under NRA Codes, in TRADE PRACTICES STUDIES SECTION (Work Materials No. 52, 1936). Johnston and Fitch found, on the basis of interviews and questionnaire returns in several industries, the following:
   Design patents are used by only a small number of the concerns which develop original designs, and by... that group only to a very limited extent. The chief objections... seem to be:
   (1) The procedure... is too slow...
   (2) ... too costly, except for items... proven successful.
   (3) ... too often invalid or unenforceable.
   This report also provides information regarding design protection events occurring prior to 1936.
Patents sponsored a series of design protection bills. Each sought a limited copyright system for the protection of original industrial designs.

H.R. 6249, introduced in the 69th Congress, and known as the Vestal Bill, would have repealed the existing design patent law and enacted a system in the Copyright Office for the registration of designs. Such registration was necessary before enforceable rights in those designs would vest. Registration would have given rise to a two-year term of protection, renewable for eighteen years. The makers of repair parts, as well as product distributors, would have been immune from copyright infringement, except with regard to acts after notice or knowledge of a copyright.

In 1933, H.R. 14727, known as the Sirovich Bill, and its companion bill in the Senate, S. 241, known as the Hebert Bill, provided for the registration of designs applied to textiles, laces, and embroidery. The Sirovich Bill provided for a five-year term of protection following a Copyright Office search regarding the "originality" and "novelty" in the design.

In 1935, H.R. 8099, known as the O'Malley Bill, largely paralleled the Sirovich Bill, but extended protection to the design of any manufactured product in several specified industries, including all types of land, water, and air vehicles. Later in 1935, S. 3047, known as the Duffy Copyright Bill, sought a twenty-year term of protection under the 1909 Copyright Act. This bill sought protection for any artistic design or "original feature thereof" embodied in a manufactured product, except in cases of motor vehicles and articles of clothing.

During consideration of these bills, many organizations took steps to promote a more effective system of design protection. In 1928, for example, a Design Registration Bureau was established by the Silk Association of America. A similar organization was established by a group of embroidery manufacturers in 1933. Dress and fabric manufacturers established the Fashion Originators' Guild of America in 1931, and guild members refused to furnish products to dealers who sold copies of guild members' designs. The Fashion Originators' Guild's system operated until 1941, when it was held to be in violation of federal antitrust law.4

The Federal Trade Commission became involved in design protection in 1933 through its "Group II" trade practice rules of Trade Practice Conferences. These rules, which applied to twelve industries, condemned the practice of usurping designs, styles, or patterns of a competitor and taking them for one's own use. These rules, however, contained no provision for enforcement.

Beginning in 1933, under the depression-born National Industrial Recovery Act (NIRA), design protection became the subject of many fair competition codes adopted by industries. Between 1934 and 1935 eighty-four industries adopted NIRA provisions on design piracy. These systems

of self-regulation met their demise in 1935, however, when the Supreme Court held that the NIRA legislation amounted to an unconstitutional delegation of legislative power.\(^5\)

During the post-depression and World War II years, there was little or no activity with regard to the enactment of an effective system for design protection. Soon after the war, however, draftsmen were at work on legislation for the codification and revision of the patent laws, with designs constituting a portion of their agenda. The Patent Act of 1952 (Patent Act)\(^6\) represented the results of their efforts, but the existing design patent law was left intact for further study and later legislation.

The Honorable Giles S. Rich of the United States Court of Appeals for the Federal Circuit was one of the principal draftsmen of the Patent Act. In 1951, at the request of Judge Rich, this author prepared an outline of the key features envisioned for the new design legislation. A special committee of the New York Patent Law Association developed that outline into a draft for a design copyright bill, which was later endorsed by patent law associations nationwide. In 1954, work toward the perfection and enactment of the bill became the focus of a coordinating committee of the National Council of Patent Law Associations. Judge Rich chaired that committee, and worked with the drafting subcommittee toward refining drafts of the bill.\(^7\)

The main objective of the drafting subcommittee was to provide limited, short-term, copyright protection for the original ornamental designs of useful articles. Visually distinctive designs which contributed to the value or attractiveness of the product constituted ornamental designs. The protection was to be available only for designs embodied or fixed in the useful articles: those represented only on paper would not qualify for the protection.

The protection was to begin when an article embodying the design was “made public” with a prescribed notice affixed. Originally, the term of protection was to be five years, renewable for another five years. The term for protection was later changed to a single term of ten years. If an application for registration of the design was not filed within six months\(^8\) after the design was first made public, eligibility for protection was lost. A simple application for registration would have enabled the applicant to perfect the design protection so that a civil action could be brought to remedy an infringement.

Rights under the draft bill would have been infringed only by an article

\(^7\) P.I. Federico, legislative counsel of the Patent Office, George Carey, then-General Counsel of the Copyright Office, George E. Frost, who later became General Patent Counsel of General Motors Corporation, Philip T. Dalsimer, Alan Latman, and this author, among others, served on this subcommittee.
\(^8\) This requirement was later changed to one year.
copied from the protected design, and ordinarily only by making or import-
ing such an article for sale or for use in trade. A distributor or seller, how-
ever, would have been liable in the event of having induced or colluded in the
manufacture or importation of the article, or of failing upon request to dis-
close its source. In short, the objectives of the bill were: (1) to protect or-
iginal ornamental designs of useful articles; (2) to make the design protection
available immediately upon making a design public; and (3) to have designs
protected for a reasonable cost.

The first design protection bill based on the work of the coordinating
committee, known as H.R. 8873, was introduced in 1957 by Congressman
Edwin Willis, then-Chairman of the House Committee on the Judiciary.
Similar bills were introduced in the House and Senate in each of the next six
Congresses.

A bill introduced in 1961 by Senator Philip Hart, S. 1884, was passed
by the Senate on July 23, 1962, but was held up in a House committee. In
the next Congress, Bill S. 776, also known as the Hart Bill, passed the Sen-
ate, but met a similar demise in the House. Likewise, in 1965, the
Talmadge-Hart Bill, S. 1237, was passed by the Senate, but perished in the
House.

Following the failure of four 1967 House design bills to move forward,
the Subcommittee on Criminal Laws and Procedures of the Senate Commit-
tee on the Judiciary, chaired by Senator McClellan, incorporated the Design
protection bill as Title III of S. 543, the bill then being developed for general
revision of the copyright law. Similar McClellan Bills were introduced in
1971, S. 664, and 1973, S. 1361, but none was enacted into law. In 1975,
McClellan Bill S. 22 passed the Senate by a unanimous vote of 97-0. Title
II of that bill encompassed design protection. The House, however, deleted
Title II from what was to become the Copyright Act of 1976.

Following the deletion of Title II in 1975 by the House, the drive for
design legislation abated. Beginning in 1979, however, the continuing need
for design protection led to the introduction of bills based on Title II of S.
22. In addition, courts troubled with the difficulty of resolving “obvious-
ness of invention” issues in design patent cases remarked from time to time
about the impropriety of such a standard for the entirely visual aspects of
useful article designs. For example, in In re Nalbandian, Judge Rich, in a
concurring opinion, stated:

The present case and its companion . . . are but the latest exam-

revealed that for the first time in over forty years, prospects appeared favorable for the
enactment of a design bill. The report claimed that the committee believed the bill to
meet the practical needs of all concerned, including the industry, tradesmen, the public,
the major bar associations, the Copyright Office, the Patent Office, the United States
Senate, and numerous other groups concerned with creativity in useful article design.
pies of the need for a law tailored to the problems of designers, of their employers and clients in the business world, and of the government agencies now concerned. The now-pending legislation is substantially the same bill introduced in 1957, after the refining process of 24 years of legislative consideration. It is time to pass it and get the impossible issue of obviousness in design patentability cases off the backs of the courts and the Patent and Trademark Office, giving some sense of certainty to the business world of what designs can be protected and how.\textsuperscript{11}

Sponsors of some of the more recent design bills included former Congressman Railsback (H.R. 2985 in 1983; H.R. 20 in 1981; and H.R. 4530 in 1979), Congressman Moorhead (H.R. 902 in 1989; H.R. 379 and H.R. 1179 in 1987; and H.R. 1900 in 1985), and Senators DeConcini and Hatch (S. 791 in 1987). These bills provided a basis upon which the Semiconductor Chip Protection Act of 1984 was drafted and enacted.\textsuperscript{12}

The United States undoubtedly needs a simple, inexpensive, and reliable system of protection against the copying of original designs of useful articles, with such protection effective from the outset of their market entry. This need could and should be met by a renewed drive for enactment of a design bill similar to the current Moorhead Bill, H.R. 902.

The design patent laws which exist today do not serve this Nation's need. The delay and expense involved with the pre-application searches, opinions of counsel, formal drawings, application papers requiring professional service, submissions of "prior art," and statements to the Patent and Trademark Office (PTO) all make the current system impractical for the protection of a great number of creative designs of useful articles. Further delay and costs can arise if additional searches and other official action of the PTO are required. Even after a patent has been issued, legal opinions, costly discovery proceedings, and litigation may become necessary before a design patentee's rights will be either acknowledged or enforced.

The Moorhead Bill, known as H.R. 902, introduced on February 7, 1989, should be supported vigorously, and enacted essentially in its current form to provide the much needed short-term copyright protection. That bill, although titled for the protection of "industrial designs," retains the 1957 Willis Bill's definition of "ornamental" design—that is, an "article attractive or distinct in appearance to the purchasing or using public."\textsuperscript{13} This definition should not be interpreted as a measure enabling wholly utilitarian articles to be protected against copying if they are made with a distinctive shape or surface design having no intended aesthetic or visual appeal.

The carefully tailored design protection bill must not be made into a

\textsuperscript{11} Id. at 1219 (emphasis in original).
law prohibiting "mold copies" of just any industrial article with a distinctive feature of appearance. The merits and detriments of such a law should be addressed by a trade-regulating bill, with the focus of debate on the commercial impact of direct copies of industrial products and not on the design bill's provisions involving notice, registration, and other aspects of intellectual property rights.

Regarding the "crash parts" issue—whether the design bill would prevent replacement of a damaged automobile fender by a copy of the original manufacturer's fender—two different factual situations should be considered. First, the design of the automobile body might be protected under the bill without special protection being obtained for the fender design per se. Second, the fender itself, being a "useful article" as defined in the bill, might be protected per se if original nonutilitarian features make it attractive or distinct in appearance.

In the first factual situation, there really should be no "crash parts" issue. Using a copy of a fender to replace a damaged fender on an original equipment manufacturer's (OEM) car body would not constitute the making of an "infringing article," as defined in the bill. This is because a copy of the design-protected automobile body is not made by the fender replacement. The design bill's language, however, is not completely clear and leaves room for dispute in this regard.

Amendments to the design bill clarifying the provisions on protected designs were recently approved by the American Intellectual Property Law Association (AIPLA) and recommended by the Connecticut Patent Law Association. They are as follows:

1. Amend Section 1002(b) to read (added language italicized):
   
   (b) In no case does protection for a design under this chapter extend, apart from a useful article that substantially embodies the design, to:

   (1) any element or part of the design that in itself either (i) constitutes substantially less than the whole of the protected design or (ii) is dictated solely by a utilitarian function; or

   (2) any idea, procedure, process, system, [etc. per the existing bill].

2. Add to Section 1008, "INFRINGEMENT," a new subsection (g) as follows:

   (g) It is not infringement of a design protection under this chapter for any person to repair or replace a damaged, defective, or lost part of an article that embodies the protected design if the article itself is not an "infringing article" and only such a part of it, con-

14. On February 21, 1989, the Supreme Court held such legislation to be in conflict with federal patent policy, and thus preempted under the Supremacy Clause of the federal constitution. See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989).
stituting substantially less than the whole of the protected design, is reproduced by the repair or replacement.

In the second factual situation, replacement of the damaged fender might indeed be limited to use of a fender made by or under license from the proprietor of the design. This would be true not because the installing seller of a copy would infringe upon the design protection, but rather because the making or importation of the copy without the proprietor's consent would infringe upon that protection.

The design bill with the AIPLA's suggested amendments would provide intended protection for the originator of a distinctive design of a useful article that in use is part of a larger useful article. Upon protection of the part, according to the bill, unauthorized copies would not be available to parts suppliers, repairers, product owners, or insurers. A car owner, of course, requires that a fender replacement look the same as the original fender. To permit unauthorized copies of the OEM's protected design for replacement parts, however, would be contrary to the long-established principles of patent and copyright law. The OEM's interests in enabling repair and maintaining the appearance of its products is a sufficient inducement for it to keep replacements of design-protected parts available to users of the products during the term of the design protection.

It is time to enact the pending design protection bill. The bill should be modified to make clear that it would prevent the copying of only substantially the whole, not merely parts or pieces, of the useful article designs which qualify for protection. The legislation must not be sidetracked again by tangential or unnecessary issues. Similarly, the interests advocated by some copiers, sellers, users, or insurers in the making or obtaining of copies cheaper than the originators' products must be viewed cautiously. The designs of useful articles merit a limited kind and term of copyright protection. This protection must be provided in order to fulfill the Constitution's mandate to promote "the Progress of Science and useful Arts."15

15. U.S. Const. art. 1, § 8, cl. 8.