Design Protection--Time to Replace the Design Patent

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I. INTRODUCTION

Although designs are not creations which would be attributed to an act of invention, they have long received patent protection in the United States. In providing such protection both Congress and the courts have analogized the standards for protecting designs to rules for granting mechanical patents. Since this analogy is basically unsound, Congress has had difficulty formulating legislation to provide suitable protection, and the courts have found it difficult to apply these statutes. Although the courts have recently tended to alter their interpretation of the statutory standard of patentability for designs, resulting in a standard analogous to that applied under the English registration system, an examination of present design patent law clearly indicates the need for reformation.

II. CHARACTERIZATION OF DESIGNS

A design is the characteristic or impression displayed by a tangible object.\(^1\) It does not exist in isolation, as does a two-dimensional picture, but must be affixed to some object.\(^2\) Design is a completely subjective concept consisting only of its effect upon the senses of the observer.\(^3\) Thus, for the purposes of patent law, a design has been defined as:

\[\text{[T]hat characteristic of a physical substance which, by means of lines, images, configuration, and the like, taken as whole, makes an impression, through the eye, upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but ... in that indefinable whole that awakens some sensation in the observer's mind.}^{4}\]

To qualify for design patent protection, the object expressing the design must be an article of manufacture\(^5\) which is capable of being reproduced.\(^6\) By definition the term does not include...
natural products or elements, nor does it include a process. Design patents have been upheld on a wide range of articles of manufacture, such as silverware, an electric light socket, a toy duck, an embroidered textile fabric, and an ornamental awning fabric. There is some question as to whether a protectable design can be hidden part of the time, but it is clear that articles intended for an obscure use cannot obtain a design patent. The fact that any article of manufacture has movable parts does not disqualify protection, but a mere dimensional change of an existing object is not patentable as a design.

Although a design may qualify for a mechanical patent or a copyright, the qualifications for these types of design protections are distinguishable. While a mechanical invention must be useful to qualify for patent protection, utility plays no part in

(E.D. Wis. 1922). See In re Hadden, 20 F.2d 275 (D.C. Cir. 1927); Harmon Paper Co. v. Prager, 286 Fed. 267, 271 (E.D.N.Y. 1922), aff'd, 287 Fed. 841 (2d Cir. 1928).
7. Mott, supra note 1, at 549.
8. See Waldman v. Swanfeldt, 66 F.2d 294, 296 (9th Cir. 1933); In re Shetterly, 18 C.C.P.A. (Patents) 1169, 48 F.2d 421 (1931).
13. See Swanfeldt v. Waldman, 50 F.2d 445 (S.D. Cal. 1931), rev'd on other grounds, 66 F.2d 294 (9th Cir. 1933).
determining the validity of a design patent. However, a design is not unpatentable as a design although it has some mechanical or utilitarian function. Broadly speaking, copyrights protect works of art, while design patents protect the configuration of an article of manufacture. The most significant distinction between the two lies in the more stringent requirements to qualify for a design patent. A design must possess novelty to be patentable, while the novelty of the art or the object described is irrelevant in determining the validity of a copyright. A copyright protects only the treatment of a subject—the expression of the author’s idea—whereas a patent protects the subject itself.

19. E.g., Koch Mfg. Co. v. Blue Star Auto Stores, 103 F.2d 598, 599 (7th Cir. 1939); In re Bigelow, 39 C.C.P.A. (Patents) 827, 830, 194 F.2d 545, 548 (1952).
20. E.g., In re La Montagne, 19 C.C.P.A. (Patents) 880, 882, 55 F.2d 486, 488 (1932).
21. Compare 17 U.S.C. §§ 4, 5 (1964), with 35 U.S.C. § 171 (1964). Frequently the two will overlap. See generally Pogue, Borderland—Where Copyright and Design Patent Meet, 52 Minn. L. Rev. 33 (1953); Note, 66 Harv. L. Rev. 877 (1953); Note, 27 Ind. L.J. 130 (1951). Overlapping usually occurs when an article of manufacture is also a work of art. See William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264 (W.D. Pa. 1951); Jones Bros. v. Underkoffler, 16 F. Supp. 729 (M.D. Pa. 1936). It has been held that merely because a design is patentable copyright protection is not precluded. Mazer v. Stein, 347 U.S. 201 (1954). However, whether a design can be patented and also have copyright protection still appears to be an open question, although several cases indicate this has been done. See, e.g., Rosenthal v. Stein, 205 F.2d 633 (9th Cir. 1953); Wilson v. Haber Bros., 275 Fed. 346 (2d Cir. 1921).
23. See note 29 infra and accompanying text.
24. See, e.g., Baker v. Selden, 101 U.S. 99, 102-03 (1879). In general terms novelty means the design in question is not anticipated by the prior art. Anticipation means a prior art disclosure (a previous patent on a similar design) is nearly identical to the design in question. Interchemical Corp. v. Sinclair & Carroll Co., 50 F. Supp. 381, 389 (S.D.N.Y. 1943), rev’d on other grounds, 144 F.2d 842 (2d Cir. 1944); rev’d on other grounds, 325 U.S. 327 (1945). See generally 1 Walker § 87.
25. See F. W. Woolworth Co. v. Contemporary Arts, Inc., 193 F.2d 162 (1st Cir. 1951), aff’d, 344 U.S. 228 (1952); Anseh v. Puritan Pharmaceutical Co., 61 F.2d 131 (8th Cir. 1932); Muller v. Triborough Bridge Authority, 43 F. Supp. 298 (S.D.N.Y. 1942). However, the United States Supreme Court, in Mazer v. Stein, 347 U.S. 201 (1954), 68 Harv. L. Rev. 517 (1955), indicated that perhaps this latter distinction is rather nebulous by holding that a statuette intended for commercial use as a lamp base was entitled to copyright protection. The statuette design may also have been patentable, but the Court did not face this issue. See 347 U.S. at 217.
III. DEVELOPMENT OF DESIGN PATENT LAW IN THE UNITED STATES

A. Early History

Immediately after ratification of the Constitution, which empowers Congress to promote the useful arts by authorizing grants of limited monopoly, copyright and patent laws were enacted. Writings and drawings were protected by copyright law, while articles of manufacture and processes were protected by patents. However, articles of manufacture with an ornamental or pleasing appearance could not be provided protection solely on the basis of their appearance, since the nature of such designs fell between the protection provided by the patent and copyright laws. It was not until 1842 that the first laws were enacted specifically to provide protection for designs. Finding designs more analogous to patents than copyrights, Congress framed the law in terms of patentability. No significant change was made until the Consolidated Patent Act of 1870 which repealed and replaced previous law. Although the 1870

26. U.S. Const. art. I, § 8. The underlying theory is that economic protection of creative contributions is necessary to encourage further contributions. The resulting activity benefits the economic and cultural welfare of the public. Lemlein, Patents—Their Origin, Nature & Subject Matter, 2 Boston B.J. 21, 22 (May 1888); see Robinson, Patents 16-23 (1890). But see Lewis, Monopoly and the Law, 6 Mod. L. Rev. 97 (1943). Lewis believes the patent grant is inconsistent with the public interest because the user as well as the inventor is entitled to the monopoly. Thus a firm could buy up all the monopolies to the detriment of the public interest. Id. at 105. See also Pfaff, Patents and Progress, 29 S.B. Calif. J. 36, 37 (1954); Prager, Historic Background and Foundation of American Patent Law, 5 Am. J. Legal Hist. 309 (1961).


29. Hudson, supra note 27, at 382-83. It has also been suggested that Congress resorted to patent protection rather than copyright protection because, at the time, there was no central copyright depository. Id. at 383.

act was otherwise similar to its predecessors, its wording made it appear that a design had to be "useful" to be protected.\textsuperscript{31} Since this change raised problems of interpretation which could not be resolved in a uniform manner,\textsuperscript{32} the 1870 act was amended in 1902.\textsuperscript{33} This act substituted the word "ornamental" for "useful", and the term "article of manufacture" was substituted for the specific classes of articles previously enumerated.\textsuperscript{34}

B. State of the Law Under the Present Statute

1. Prior to the Laverne Case

In 1952 an entire new set of patent laws was enacted, including the present Design Patent Act which provides:

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.\textsuperscript{35}

Originally there was some question as to whether the 1952 act was a codification of existing law, or whether it established a new standard. Although only a minority of contested design patents were upheld prior to the 1952 act\textsuperscript{36} the act's legislative history\textsuperscript{37} and several court opinions\textsuperscript{38} indicate that the strict standard of patentability for designs remained unchanged. Thus, there appear to be four requirements for a design patent

\begin{itemize}
\item \textsuperscript{32} One case held that the term meant "adaptation to producing pleasant emotions." \textit{Ex parte} Parkinson, 1871 C.D. 251. Another interpreted "useful" to mean "giving certain new and original appearances to a manufactured article [tending to] enhance its salable value . . . ." Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 525 (1871). Several cases held that utility may constitute the basis for granting a design patent. See Hudson, \textit{supra} note 27, at 386.
\item \textsuperscript{33} The 1902 act provided: "Any person who has invented any new, original, and ornamental design for an article of manufacture . . . may . . . obtain a patent therefor." Design Patent Act of 1902, ch. 783, § 4929, 32 Stat. 193.
\item \textsuperscript{34} See \textit{ibid.} Congress' intent was to alleviate the problems encountered under the previous acts by providing a broad, general standard to be interpreted by the courts. See Hudson, \textit{supra} note 27, at 389-92.
\item \textsuperscript{35} 35 U.S.C. § 171 (1964).
\item \textsuperscript{37} See H.R. REP. No. 1923, 82d Cong., 2d Sess. 3 (1952). \textit{But see} 98 CONG. REC. 9323 (1952) (remarks of Senator McCarran) (bill makes some changes in the law of patents).
\item \textsuperscript{38} E.g., Hawley Pros. Co. v. United States Trunk Co., 259 F.2d 69, 72 (1st Cir. 1958).
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under the 1952 act: invention, novelty, originality, and ornamentality.\(^3\)

Prior to 1952 it was generally held that the standard of invention for design was the same as for a mechanical patent: \(^4\) "was the new combination within the range of the ordinary routine designer?" \(^4\) The standard was not met when a product only represented the skill of an ordinary designer chargeable with knowledge of the prior art. \(^4\) In other words, if the design was one which was obvious to a designer skilled in the art, it was not patentable. \(^4\)

A new section governing the standard of invention was incorporated into the 1952 act:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . . \(^4\)

In R. M. Palmer Co. v. Ludens, \(^4\) this section was held applicable as the standard of invention for design patents. Although the courts initially disagreed as to whether the standard of invention was more strict or more liberal under this section, \(^4\) the Supreme Court finally resolved the question by holding that this provision neither raised nor lowered the standard of invention. \(^4\) Thus it


\(^{41}\) Strause Gas Iron Co. v. William M. Crane Co., supra note 40, at 131.

\(^{42}\) S. Dreener & Son v. Doppelt, 120 F.2d 50, 52 (7th Cir. 1941); Mary Muffet, Inc. v. Loma Dress Co., 39 F. Supp. 415, 417 (S.D.N.Y. 1941).


\(^{45}\) 236 F.2d 496 (3d Cir. 1956), 45 Calif. L. Rev. 385 (1957).


\(^{47}\) Graham v. John Deere Co., 383 U.S. 1, 3-4 (1965), 34 Geo.
seems established that a design must still be "nonobvious to a person of ordinary skill in the art" to be patentable under the 1952 act.48

As was the case under previous acts, the test of novelty under the 1952 act is determined with reference to the sight impression of an ordinary observer.49 The design in question is compared with previous articles of design, and if both designs appear to the ordinary observer to be essentially the same, the design is not novel.50 Therefore, minute differences which would appear to an expert, but which would escape notice by an average observer, are not taken into consideration;51 the average observer must feel the design is not merely a modification of the prior art.52 In defining the scope of the prior art, the courts have universally held that any type of patent upon an article can constitute anticipation of a design patent.53

Although a design must meet the additional requirements of originality54 and ornamentality,55 these requirements are


49. E.g., Goudy v. Hansen, 247 Fed. 782, 785 (1st Cir. 1917), cert. denied, 246 U.S. 667 (1918).


53. E.g., In re Rutledge, 18 C.C.P.A. (Patents) 1081, 1083, 47 F.2d 797, 798 (1931). See generally 2 WALKER § 167. Thus, a mechanical patent may anticipate a design patent. E.g., Waring Prods. Corp. v. Landers, Frary & Clark, 263 F.2d 160, 162 (2d Cir. 1959); In re Hoffman, 21 C.C.P.A. (Patents) 924, 926, 88 F.2d 978, 979 (1934); In re Hargraves, 19 C.C.P.A. (Patents) 784, 785, 53 F.2d 900, 901 (1931); see, e.g., In re Lamb, 51 C.C.P.A. (Patents) 1040, 1045, 327 F.2d 679, 682 (1964). See also In re Eppinger, 23 C.C.P.A. (Patents) 945, 94 F.2d 401 (1933).


55. See, e.g., In re Bartlett, 49 C.C.P.A. (Patents) 969, 300 F.2d 942
rarely considered by the courts. Their main concern invariably centers on invention and novelty.\(^{56}\)

Both the courts and the Patent Office frequently have had difficulty distinguishing the standard of invention from that of novelty. In *In re Johnson*,\(^{57}\) the United States Court of Customs and Patent Appeals stated:

> Courts in considering design patents almost universally apply the rule that it is not enough if a particular design be new, original, and ornamental, but there must be present the exercise of the inventive faculty as well. The courts seem to be of one accord in stating that the fourth element of the formula which tests the patentability of a design, viz., the exercise of the inventive faculty, defies definition and resides as a subjective standard in the mind of the judge considered as an “average observer.”\(^{58}\)

Thus *Johnson* seemed to require that a design not be obvious to an average observer to be inventive, but omitted any reference to a person having ordinary skill in the art. The case also held that the test of novelty was whether the average observer would acknowledge the new design as different from the prior art.\(^{59}\) Hence, *Johnson* implied the tests for the standard of invention and novelty are nearly identical.\(^{60}\)

More than ten years later, in *In re Bartlett*,\(^{61}\) the same court commented that *Johnson* only enunciated the test for novelty and not the test of invention.\(^{62}\) However, the *Bartlett* court conceded that “whether the design is unobvious is a question not unrelated to novelty . . . and the differences in degree and in kind which one can observe are the only criteria of decision available to us.”\(^{63}\) This statement indicates that although the *Johnson* test of patentability was apparently incorrect, the reasoning of

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\(^{57}\) 36 C.C.P.A. (Patents) 1175, 175 F.2d 791 (1949).

\(^{58}\) See supra note 55.

\(^{59}\) *Id.* at 1177, 175 F.2d at 792. Although the holding of *Johnson* appears contra to authority, the case has been dismissed as merely being a poorly written opinion. See note 62 infra and accompanying text.

\(^{60}\) See *ibid.* Both tests use the ability of the average observer to distinguish as the measure. In the first the design must be unobvious, and in the second it must be different from the prior art. It is arguable that “unobvious” and “different from the prior art” are two analogous terms describing the same concept. A trivial difference is not sufficient to establish novelty. The requisite greater degree of difference is probably reached when the design in question is unobvious from the prior art.

\(^{61}\) 49 C.C.P.A. (Patents) 969, 300 F.2d 942 (1962).

\(^{62}\) *Id.* at 971, 300 F.2d at 943.

\(^{63}\) *Id.* at 972, 300 F.2d at 944.
the Johnson court was not entirely invalid. Finally, in In re Boldt,\textsuperscript{64} the Court of Customs and Patent Appeals recognized that the test for standard of invention was whether it would be "obvious to one of ordinary skill in the art . . . ."\textsuperscript{65}

2. The Laverne Standard

In Application of Laverne,\textsuperscript{66} the same court held that the standard of patentability for a design was that the design cannot have been obvious to the ordinary intelligent man.\textsuperscript{67} The Laverne court wrestled with the problem of using the test of a person skilled in the art, but it decided this test was not suited to the design area.\textsuperscript{68} The court said that although the 1952 act did not clearly define the standard of patentability, it abolished the necessity of defining a standard of invention and substituted the unobviousness test.\textsuperscript{69} The opinion then stated:

We feel that the test of patentability of an admittedly new design cannot be whether it is no more than a "competent designer" might produce. That would be parallel to saying of a mechanical invention that it is no more than a "competent inventor" might produce. The test must be obviousness, for that is the dictate of section 103, but it must be applied in a way which will implement the legislative intent to promote progress in the field of industrial design by means of patent incentive. This will not be done by denying patents to everything competent designers produce by the skill of their calling.\textsuperscript{70}

Laverne also shed new light upon the question of what constitutes the prior art. Contrary to the weight of authority, Laverne indicated that the art involved was limited to the field of design.\textsuperscript{71} It would seem to follow from this reasoning that a

\textsuperscript{64} 52 C.C.P.A. (Patents) 1283, 344 F.2d 990 (1965).
\textsuperscript{65} Id. at 1285, 344 F.2d at 991. However, the dissent seemed to be in a quandary as to whether the standard of invention was really isolated from the test of novelty. Id. at 1285, 344 F.2d at 991-92. The dissent was written by Judge Rich who later wrote the majority opinion in the landmark case of Application of Laverne, 356 F.2d 1003 (C.C.P.A. 1966). See notes 66, 67 infra and accompanying text.
\textsuperscript{66} 356 F.2d 1003 (C.C.P.A. 1966).
\textsuperscript{67} Id. at 1006.
\textsuperscript{68} Ibid.
\textsuperscript{69} Ibid.
\textsuperscript{70} Ibid.
\textsuperscript{71} The application the Laverne court held to be erroneously rejected by the patent office was for a chair design. The court felt that "since those who create designs are designers, not chair makers, it would seem to follow that he is operating in the field of industrial design and that it is the 'art' involved." Id. at 1005-06. It seems arguable that the design was obvious from the prior art. See id. at 1004. For a chair design held unpatentable in view of the prior art compare Howell Co. v. Royal Metal Mfg. Co., 93 F.2d 112 (7th Cir. 1937).
mechanical patent could no longer anticipate a design patent. Thus Laverne appears to have inaugurated some new standards for design patents concerning both the standard of patentability and what constitutes the prior art.

C. Evaluation of the Purported New Standard

The Laverne rule implies that the test for the standard of invention is identical to the test for novelty. Thus if a design is novel with respect to the prior art, it is patentable.72 By employing such a test, the court disregarded all of the generally accepted precedents.73 However, as the history of the law of design patents indicates, the courts have always had difficulty formulating standards of patentability for designs.

The basis of the courts' difficulty is Congress' subconscious attempt to equate design patents with mechanical patents. For example, one of the requirements for granting a mechanical patent is that the invention have "utility."74 However, there is no reason for requiring the design of such an article to have utility in order to be patentable.75 Another unfortunate choice is Congress' use of the word "invent" throughout all of the design patent acts to describe the process of creating a design. The long established standard of patentability for designs probably arose from use of these inapplicable terms.76

It has been advocated that novelty should be the standard of invention for all patents in lieu of that expressed in section 103 of the 1952 act.77 As it relates to design patents, such a standard seems justifiable. A design is not something which

72. It is assumed for the purpose of this discussion that the design is also original and ornamental—the other prerequisites for granting a design patent. See note 39 supra and accompanying text.
73. See note 48 supra and accompanying text.
76. See 356 F.2d at 1005 n.1. Even the commentators cannot agree on the meaning of the word "invention." One writer says there are two distinct meanings to the word—a new creation or merely a first introduction. INLOW, The Patent Grant 133 (1950). Another believes that invention and discovery are synonymous terms. Henry, Standards of Invention in Mechanical Cases, 32 J. Pat. Off. Soc'y 97, 100 (1950).
77. See 356 F.2d at 1005 n.1. Even the commentators cannot agree on the meaning of the word "invention." One writer says there are two distinct meanings to the word—a new creation or merely a first introduction. INLOW, The Patent Grant 133 (1950). Another believes that invention and discovery are synonymous terms. Henry, Standards of Invention in Mechanical Cases, 32 J. Pat. Off. Soc'y 97, 100 (1950).
comes out of a laboratory to fulfill a need, nor is it an ingenious
gadget valuable to the user because of its functional aspects.
For this reason it is meaningless to say that a design is invented.
A design is instead a creation which is only valuable in the eye
of the person beholding it—the average observer—and its value
lies in its aesthetically pleasing qualities. While there are many
elements a competent designer considers in creating a design, these
are not in themselves crucial to the beholder, since he may
believe an artistically poor design to be extremely beautiful.
There is no overriding reason why such a design should be
denied protection merely because it is obvious to one skilled in
the art. As long as a design is novel—appears materially different
to the average observer—it should be given patent pro-
tection.

If the test for the standard of patentability of being non-
obvious to one having ordinary skill in the art is maintained,
the demise of all design patents could eventually result. Presently,
ordinary skill is a statistical concept designating a mini-
mum level, and ingenuity is the intangible skill above the mini-
mum level a designer must employ to receive a patent. However,
this is a cyclical process in which the ingenuity or crea-

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78. Some of the elements a modern designer may consider in his
creation include: fitness to function, materials, and techniques; unity
and simplicity; rhythm of proportion and of line and form; dominance,
accent, and scale; balance and symmetry; and style and individuality.
Bowen, Design Patents and Modern Industrial Designs, 37 J. PAT. Off.
Soc'y 744, 748-50 (1955). An industrial designer may also consider the
additional factors of economical manufacture, sales appeal, and advice
from production and sales departments. Id. at 752.

79. The artistic value of a work of art is immaterial in providing
it copyright protection. See Jones Bros. Co. v. Underkoffler, 16 F. Supp.
729, 730 (M.D. Pa. 1936); Pellegrini v. Allegreni, 2 F.2d 610, 611 (E.D.

80. Even though the courts have not examined the concept of orna-
mentality in much detail, at least one writer feels a design should be
patentable only if its over all aesthetic effect is pleasing and attractive.
Mott, supra note 55, at 551. However, this is an extremely difficult
test to apply, as in most cases any reference to an advance in aesthetic
value is meaningless. Note, 72 Harv. L. Rev. 1520, 1523 (1959). But
see Belding Heminway Co. v. Future Fashions, Inc., 143 F.2d 216, 217
(2d Cir. 1944).

81. Again it must be remembered that this is the result only if the
design is also original and ornamental. See note 39 supra. But see
Bowen, supra note 78, at 751. Bowen believes that all the considera-
tions a competent designer takes into account when creating a design
should be relevant as to whether a design is patentable.

83. See Frankl, On Judgments of Patentability, 37 J. PAT. Off.
Soc'y 125, 131 (1955).
84. Id. at 138.
tivity of a few individuals of past years becomes the present level of ordinary skill in the community.\textsuperscript{85} Thus, the past extraordinary creations of a few become the present ordinary level of skill for all in the group.\textsuperscript{86} Although there may be some basis for this cycle in the area of mechanical patents, there is no reason to keep increasing the level of sophistication necessary for the grant of a design patent.\textsuperscript{87}

The slight modification of an existing design may constitute a new design which should be provided protection.\textsuperscript{88} In this respect "modern design is not static but instead is moving in a direction toward improvement. . . . [D]esign . . . is only alive when it is in a state of flux."\textsuperscript{89} By making design protection easier to obtain, a design is kept in a state of flux, thereby advancing the cultural welfare of the country.\textsuperscript{90} Implementing novelty as the test for design protection is a feasible method of achieving this goal.\textsuperscript{91}

If novelty is established as the standard of patentability for designs, the language in \textit{Laverne} concerning the prior art must also be adopted.\textsuperscript{92} An inventor or designer is stimulated by a number of concurring situations in making his discovery or creation.\textsuperscript{93} In the case of an invention it is necessary to examine prior patents in all arts to be sure that the item for which protection is sought would not have been an obvious result of the efforts of the skilled mechanics. In the case of a design, however, what stimulates the designer is totally irrelevant under the \textit{Laverne} novelty test. All that must be known is whether the design is novel. To be novel, a design must be different from previous designs, as seen by an average observer.

\textsuperscript{85} Id. at 135.

\textsuperscript{86} Id. at 137.

\textsuperscript{87} A mechanical patent is granted for invention of a useful article. However, since our society's technological advancement is and has been so rapid, to be protected, an invention should involve something more than the existing technological state. If it did not, every discovery would be patentable. However, this argument does not seem to apply to designs. See \textit{ibid.}

\textsuperscript{88} \textit{Callmann, supra} note 75, at 557-58.

\textsuperscript{89} \textit{Bowen, supra} note 73, at 751.

\textsuperscript{90} \textit{Pfaff, Patents and Progress}, 29 S.B. CALIF. J. 36, 37 (1954). It is arguable that by lowering the standard there will be more opportunity for competing goods to enter the market. As a consequence, competition will be advanced, and the grant of a monopoly will be limited to a closer function of the design's contribution to society.

\textsuperscript{91} \textit{But see} Note, 72 HARV. L. REV. 1520, 1535 (1959).

\textsuperscript{92} \textit{See note 71 supra} and accompanying text.

\textsuperscript{93} \textit{See Frankl, \textit{On Judgments of Patentability}, 39 J. PAT. OFF. Soc'y 122, 132 (1957).}
Merely because an article covered by a patent other than a design patent is aesthetically pleasing does not constitute grounds to include it in the prior art, even though it may appear to be a stimulus for the design in question. If the previous design is novel, and the creator wishes to protect it, he should apply for design protection. If he does not protect his design, there seems to be no reason to deny protection to a subsequent design by anticipation. In all areas of patent law it is recognized that novelty is not negatived by any previous patentable invention, if the patentability of that invention was not recognized until later than the date of the invention sought to be anticipated thereby. Once a patent has been obtained, however, a subsequent designer seeking protection in that particular art will have to originate a novel design as compared to the first one. In this way the art of design is stimulated, and those designers desiring protection may receive it.

D. IMPLICATIONS OF THE LAVERNE STANDARD

1. Design Is Not a Patent Concept

By implication Laverne points out the misconception which has bothered Congress and the courts from the start—designs simply are not concepts which can be analogized to mechanical patents. Although the Laverne court stated that its holding was dictated by section 103 of the 1952 act, that section must be read very broadly to arrive at this interpretation. It is the duty of Congress, not the courts, to designate the type of protection to be provided designs and the standards governing that protection.

94. See, e.g., Tilghman v. Proctor, 102 U.S. 707, 711 (1880); International Nickel Co. v. Ford Motor Co., 166 F. Supp. 551, 561 (S.D.N.Y. 1958). Of course it must be remembered that this doctrine is limited by 35 U.S.C. § 102(a) (1964). Thus if a design is in the general public domain, patentability is precluded. See generally 1 WALKER § 67 at 318.


96. 356 F.2d at 1006.

In its effort to provide adequate design protection, it is unfortunate that Congress did not consider an entirely separate category of protection. Such an approach undoubtedly would have alleviated many of the problems encountered over the last century. With the state of the law as it is, it is probable that in the near future Congress will be faced with a proposal for deleting the present patent protection for designs and adopting a new type of protection.

2. The English System of Protecting Designs

The British recognize that design is neither a patent nor a copyright concept by providing a separate registration system for designs. Employing standards similar to those stated in Laverne, they have solved many of the problems still being faced by American courts.

The act currently governing designs provides:

1. Subject to the following provisions of this section, a design may, upon application made by the person claiming to be the proprietor, be registered under this Act in respect of any article or set of articles specified in the application.
2. Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

98. The wording of the Constitution does not specify a patent and copyright dichotomy as the exclusive types of protection. The Constitution merely specifies that protection may be granted to the items therein. See Note, 68 Harv. L. Rev. 517, 522 (1955).
99. One writer believes the present insecurity is due to short-sightedness of the 1902 act. Callmann, supra note 75, at 557. The 1952 act did not alleviate these problems, since the act was essentially a crystallization of present law. See Moellenberg, The Question of Choice Between Copyrighting or Patenting a Design, 13 A.S.C.A.P. Copyright L. Sym. 165, 169 (1964).
For a design to be qualified for registration: it must be a “design” as contemplated by the statute; the person seeking registration must be the proprietor of the design; it cannot have been previously published in the United Kingdom; and it must be “new or original.”

A design is generally defined to be a conceptual creation. A vivid illustration of this appears in *Dover, Ltd. v. Nürnberger Celluloidwaren Fabrik Gebrüder Wolff*:

> Design means something which is applicable to an article by printing, painting . . . or any other means whatever, manual, mechanical, or chemical. Design means, therefore, a conception or suggestion or idea of a shape or of a picture or of a device, or of some arrangement which can be applied to an article by some manual, mechanical, or chemical means. It is a conception, suggestion or idea . . . .

As in the United States, a design must be registered in respect to an article of manufacture, and the article must perform some function other than carrying the design. Moreover, the requirements of nonpublication in the United Kingdom and that the proprietor must be the one applying for registration are similar to the American requirements.

The marked difference between the Registered Designs Act and the American Design Patent Act is the statutory provision establishing the standard for granting the limited monopoly. The criterion under the English act, that a design must be “new or original” on its face, appears to provide alternative standards.

Clearly if the design is novel or new it can be registered.

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102. See The Registered Designs Act, 1949, supra note 101 and accompanying text.
103. [1910] 2 Ch. 25 (C.A.).
104. *Id.* at 28.
106. See The Registered Designs Act, supra note 101 and accompanying text.
Novelty is judged through the eye of the observer, who is normally the judge. He is considered an average observer as opposed to one skilled in design art. If there is a marked difference between the design in question and the prior art, the design is novel. By a marked difference it is generally meant that the novelty must be substantial, but a high standard of ingenuity is not required. The problem of what constitutes the prior art is somewhat removed from the corresponding problem in the United States. Since only designs are registered, there is no concept of a mechanical patent anticipating a design, and the prior art is therefore confined to registered designs. However, it is not limited to the class of articles on which the design sought to be registered is carried.

Even if a design is not new, it apparently may be provided protection under the alternative of "originality." It has been suggested that this interpretation follows from applying the novelty test not to the idea itself, but to its use on a new subject matter. If by an exercise of intellectual activity an old design is applied to a new article, the design is novel because it is originally applied. This, however, seems to be a rather strained interpretation. Having established that the test of novelty is applied with respect to all registered designs regardless of


111. Le May v. Welch, 28 Ch. D. 24, 33-34 (C.A. 1884) (not any trifling change can justify registering a design).

112. Like the American courts, the English courts may be facing the problem of determining how substantial the difference must be to be novel. It is very difficult to define the limits of "substantial" because of the lack of recent cases concerning designs. See Note, 72 HARV. L. REV. 1520, 1535 n.96 (1958).


115. Id. at 243-44.

the class of articles carrying them, the "original" design cannot be novel, since it is already carried on another article. Thus, it would appear that this interpretation of "new or original" cannot be accepted. The test must be a singular one; only if the design is novel does it meet the registration requirements of the act.

III. RECOMMENDATIONS CONCERNING A NEW TYPE OF PROTECTION FOR DESIGNS

The English registration system does not involve the problem of trying to fit designs into the American dichotomy of patent or copyright protection. It eliminates the tendency to apply mechanical invention standards to aesthetic creations. The English standard for registering a design appears to be the novelty standard of patentability adopted by Laverne. If, under the English system, a design is novel through the eye of an average observer, as compared to the prior art, it can be protected. However, Laverne enunciates a more concrete test for the degree of difference required for novelty: A design is novel if it is not obvious to the average observer. The British do not consider whether the design is ornamental or original in the sense used in the United States. However, as stated previously, these two requirements are rarely referred to in considering a design patent application.

As indicated by the analysis of the Laverne case, this is probably the most desirable approach to defining a requirement for protection of a design. Design must be in a constant state of flux to be of value. Since the cultural welfare of our society is advanced by keeping design in constant change, the goal of the Constitution in providing a framework for protecting designs is

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117. Stenor, Ltd. v. Whitesides, Ltd., [1947] 2 All E.R. 241 (H.L.) (by implication). Since Stenor holds that a design is not anticipated merely by designs on a like class of articles, it implies that registered designs on all classes of articles constitute the prior art. Hence, it is impossible to have a novel design by applying an old design to a new article. The 1949 act also supports this conclusion by stating that a design cannot be registered if it is the same as a design previously registered in respect to any article, or only differs immaterially. The Registered Designs Act, supra note 101 and accompanying text.

118. This is also purported to be the sole standard presently being applied by the United States Patent Office. REPORT, op. cit. supra note 100, at 12.

119. The British act refers to a "new or original" design, but as indicated previously, "original" probably adds nothing to the wording of the act. See note 116 supra and accompanying text.

120. See note 89 supra and accompanying text.
also advanced.121 By making the requirements for protecting designs less stringent through the use of novelty as the sole criterion, more designs will receive protection. The necessary consequences will be to require subsequent designers to make some novel change before their designs will be protected and noninfringing, and therefore to promote constant change in design.

Because the new standard will make design protection much easier to obtain, the grant of an exclusive monopoly should be for a shorter period of time than the present patent grant.122 By adopting a shorter time period, a designer will receive a monopoly for a period of time which is consistent with his contribution to the art.

To achieve these ends, an act should be formulated which would implement the desirable features of both the present design protection law and the English law. Although there have been numerous attempts to legislate in this area,123 most were aimed at halting design piracy among dress creators.124 The majority of these unsuccessful attempts would have made originality of design the critical test, so that infringement would be possible only if the design were copied.125 Although this type of protection might alleviate some of the problems in the garment industry, it would not obviate the necessity of proposing a new type of protection to benefit all designers and to promote the whole of design art.126 The following legislative proposal is not intended to be comprehensive, but it should help to provide a framework for mitigating the most serious problems in this area.

121. See Pfaff, supra note 90.
122. Cf. Note, 68 Harv. L. Rev. 517, 525-26 (1955). It is believed that an appropriate period of time would be three years.
123. Solberg, The Present Copyright Situation, 40 Yale L.J. 184, 187-89 (1930), contains a good summary of the attempts at legislation prior to 1930. One of the more significant attempts was the 1930 Vestal Bill, H.R. 10351, 68th Cong., 2d Sess. (1934), which proposed to eliminate design patents and provide copyright protection. Thus the requirement of "patentable novelty" would be replaced by the more liberal requirement of originality. See Legislation, 31 Colum. L. Rev. 477, 485 (1931).
125. An excellent example is a bill introduced on January 18, 1967 by Congressman Ford. H.R. 2886, 90th Cong., 1st Sess. (1967). The bill would provide protection for any original ornamental design. Id. § 1(a). Protection would operate much the same as would a copyright. See id. § 4. However, the bill was not to affect the current copyright and design patent statutes. Id. §§ 27, 28.
126. See note 125 supra.
IV. AN ACT PROVIDING FOR THE REGISTRATION OF DESIGNS

Section 1. Registration of Designs

Upon application of anyone claiming to be the proprietor of any new design upon an article of manufacture, the Commissioner of Patents may register such design subject to the provisions of this act.

Comment: This section is intended to replace the present Design Patent Act, 35 U.S.C. section 171, and to make novelty the sole prerequisite for registering a design.

Section 2. Definitions

(a) A design is the impression displayed by an article of manufacture.

(b) An article of manufacture is an artificially created tangible object which is capable of being reproduced by an industrial process.

(c) The proprietor is the creator or originator of the design.

Comment: Subsections (a) and (b) are basically a codification of present law. Subsection (c) merely clarifies the mandate of 35 U.S.C. section 102(f) which requires the inventor to be the applicant.

Section 3. Standard for Registration

The test of whether a design is new under this act is novelty. A design shall be deemed novel if the differences between the design sought to be registered and the prior art are such that the design as a whole would not have been obvious through the eye of the average observer at the time the design was created. The prior art shall be limited to designs previously registered or having priority under this act, or designs which are patented under the repealed Design Patent Acts.

Comment: This section is intended to implement the test of novelty enunciated in Laverne. It would abrogate any reliance on one skilled in the art—the mandate of 35 U.S.C. section 103. The prior art would be limited to protected designs, following the British rule and the Laverne dictum.

Section 4. Effect of Registering a Design

The registration of a design under this act shall give to the proprietor the exclusive right to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered. This includes the exclusive right to apply said registered design to any article of manufacture.
Comment: This section is virtually identical to section 7 of the British Design Registration Act. It is only intended to codify the present state of the law concerning the protection a design patent gives its owner.

Section 5. Right of Priority

The right of priority provided by 35 U.S.C. section 119 and the time specified in 35 U.S.C. section 102(d) shall be six months, and both of these sections shall apply in full to the registration of designs.

Comment: This section is virtually identical to the present 35 U.S.C. section 172.

Section 6. Term of Registration

Registration of Designs may be granted for the term of three years.

Comment: This section replaces 35 U.S.C. section 173.

Section 7. Transitional Effect

All patents for designs granted and still effective under the Design Patent Acts shall be deemed duly registered as of the date this Act becomes effective. All previous design patents still in force shall terminate at their expiration date or three years after the effective date of this enactment, whichever occurs first. All applications which have been submitted for Design Patents shall, upon the effective date of this enactment, be deemed to be applications for registration of designs and shall be governed by the provisions of this act.

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

Comment: It is the purpose of this section to provide for the transition from patent to registration protection. Anyone holding a presently valid design patent would be deemed to have a registered design without the necessity of reapplication or filing for a registration certificate to replace his patent certificate. The final paragraph is intended to allow the holder of a registered design to take advantage of all the patent act provisions (infringement remedies, etc.) not inconsistent with this act.