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Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress?

Regan E. Keebaugh

University of Georgia School of Law

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INTELLECTUAL PROPERTY AND THE PROTECTION OF INDUSTRIAL DESIGN: ARE SUI GENERIS PROTECTION MEASURES THE ANSWER TO VOCAL OPPONENTS AND A RELUCTANT CONGRESS?

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I. INTRODUCTION

The protection of industrial design has been a recurring topic among industrial designers and intellectual property scholars since product design became an integral part of the manufacturing process during the industrial revolution. Proponents argue that protecting industrial design will foster more creativity and innovation from American designers and will be the first step toward returning America to a leading world industrial manufacturer. On the other side, opponents of stronger industrial design protection base their argument on the adverse economic effects that extending or expanding protection would have on the price and availability of consumer goods. Despite the persistence of those advocating stronger protection, United States lawmakers have been reluctant and resistant to creating stronger protection for industrial design. As a result, many feel that United States intellectual property law provides inadequate protection for industrial design, especially when compared to the protection afforded by other industrialized nations.

The results of this lack of protection are broad and far-reaching. Economic data shows that the American manufacturing industry is declining at an alarming rate. According to a report issued by the US-China Economic and Security Review Commission, although the new trend of outsourcing labor to foreign countries is affecting white collar jobs as well as blue collar jobs, the overwhelming majority of workers affected by the shift are those in the manufacturing industry. Each year, the United States loses between 70,000 and

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2 These proponents argue that the reason for America's decline in the manufacturing industry is in part due to inferior product design of American products caused by the lack of protection for industrial design under U.S. law. See Cooper C. Woodring, A Designer's View of Current Industrial Design Protection in the U.S., 19 U. BALT. L. REV. 154, 157-58 (1989) (blaming America's decline in manufacturing prowess on weak industrial design protection) (citing Robert H. Hayes & William J. Abernathy, Managing Our Way to Economic Decline, 58 HARV. BUS. REV. 67 (1980)).

3 See Goldenberg, supra note 1. The opponents of stronger protection for industrial design historically have consisted of industries that would suffer from the strengthening of design protection. Id. at 25. A few that have been particularly vocal include the automobile insurance industry, the lower-end clothing industry, and the replacement parts industry. Id. at 25-31. The lobby groups for these industries have played a large role in preventing the adoption of much of the proposed legislation in this area. Id.

4 Id. at 22.

5 Id.

100,000 jobs to Mexico, China, India, and other Asian countries. In the past, the manufacturing jobs being lost to foreign countries were lower-end production jobs, but now, high-end production jobs, including production of products like bicycles, engines, generators, and computer components, are being lost as well. The manufacturing industry has already lost over three million jobs to foreign countries, and as many as fourteen million jobs are at risk for outsourcing. Many blame this loss on the lower wages and cheaper facilities available in other countries, and their arguments are well founded. In a global economy where trade agreements and treaties have removed the economic impediments to international trade and advanced technology has removed many of the transportation and communication costs of conducting business with far-off nations, simple economic theory tells us that, in the long-run, manufacturing will move to where it can be done at the lowest cost. Because wages and facilities are major factors in manufacturing cost, countries in which these costs are lower than in the United States will have an economic advantage that would require an abrogation of well-founded economic principles to overcome.

So what do we do to stop this? The source of America’s economic prowess is not limited to its ability to manufacture goods, but can also be attributed to its ability to adjust to changing economic conditions through innovation, advancement in technology, and mobility of labor from industry to industry. These are the advantages the United States has over other countries, and it must use these advantages to conform to the demands of a changing, global economy. This is where design protection fits in. If economic reality means the United States can no longer compete in the production side of manufacturing, then one way to maintain jobs in the manufacturing industry is through developing a strong design industry to ensure that products made overseas are designed in the United States.

Providing strong protection for industrial design is the first step in encouraging growth in the design industry. The current level of protection for industrial design in the United States is simply too weak to accomplish the goal of rebuilding a strong design industry in America. Although industrial design can be protected through design patents, copyright, and trade dress, all of these methods of protection have limits and difficulties that render them inadequate for the protection needs of industrial designers.

This Note offers an analysis of this issue. In order to give the reader a better understanding of just what is at stake when people talk about the protection of industrial design.
industrial design, this Note will begin by giving a description of what industrial design is and why it should or should not be protected. It will then describe the current state of industrial design protection in the United States, including the advantages and disadvantages of the current system. Finally, this Note will conclude with a suggested approach to protection of industrial design in the United States based on the current developments in sui generis protection of industrial design.

II. PROTECTION OF INDUSTRIAL DESIGN IN THE UNITED STATES

A. INDUSTRIAL DESIGN DEFINED

The United States Patent and Trademark Office (PTO) defines design as "the visual ornamental characteristics embodied in, or applied to, an article of manufacture." Furthermore, the Industrial Designers Society of America describes an industrial designer's work as "the professional service of creating and developing concepts and specifications that optimize the function, value and appearance of products and systems for the mutual benefit of both user and manufacturer." The work of industrial designers can be seen in almost all manufactured goods including cars, televisions, coffee makers, cellular phones, furniture, and computers. If you like the way a product looks or the way it functions, you have an industrial designer to thank.

Industrial design is important to both consumers and manufacturers. Industrial designers benefit consumers by creating products that maximize utilitarian and aesthetic functions. According to the Industrial Designers Society of America,

> Industrial Designers work to make our lives more comfortable, pleasurable and efficient. By studying people at work, at home and in motion, they create products like office chairs that promote proper posture, kitchen tools that are comfortable even for elderly hands and toys that provide safe play and learning for all children. In particular, Industrial Designers deal with the parts of a product that humans interact with, striving to give universal access to...

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12 See INDUS. DESIGNERS SOC'Y OF AM., WHAT IS ID?, http://www.idsa.org/webmodules/articles/articlefiles/id_brochure.pdf (describing the work that industrial designers perform).
products that are ecologically responsible and safe to use. Also, they give a product that distinctive elegance that makes us want it. 13

In addition to the functional aspects of a product, industrial designers are also responsible for the aesthetic appearance of products. Therefore any utility consumers receive from the functional or aesthetic aspects of the products they consume is largely attributable to the work of industrial designers.

Manufacturers benefit from industrial design in several ways. By employing superior industrial design in the design and manufacture of their products, manufacturers can use industrial design to gain an advantage over competitors. 14 When consumers are faced with deciding among products that serve the same purpose, product appearance and utility will likely be important considerations in purchase decisions. Therefore, manufacturers that produce goods that look or function better than other similar products will have an advantage over their competitors. 15

In addition, industrial designers assist manufacturers by designing products to minimize production and marketing costs, often leading to reductions in the ultimate price of the product. 16 By creating products that minimize manufacturing costs through the efficient use of materials, man hours, and machinery, and that minimize the cost of packaging and preparing the product for sale, industrial designers make products more profitable for manufacturers and cheaper for consumers. 17 As consumer purchasing decisions become increasingly based on product appearance, utility, and price, industrial design is gaining importance as a part of the manufacturing process. Therefore, access to skilled industrial designers is crucial to the manufacturing process and to the manufacturing industry as a whole. 18

13 Id.
14 Id.
15 Because other factors, like price and brand name affiliation, affect consumer purchase decisions, function and utility will not always be the deciding factors. Nevertheless, function and utility will certainly be important contributing factors in the consumer’s ultimate decision.
16 See INDUS. DESIGNERS SOC’Y OF AM., supra note 11 (describing the role of industrial designers in the manufacturing process).
17 See INDUS. DESIGNERS SOC’Y OF AM., supra note 12 (explaining the work that industrial designers perform).
18 See INDUS. DESIGNERS SOC’Y OF AM., supra note 11 (describing the role of industrial designers in the manufacturing process).
B. WHY INDUSTRIAL DESIGN SHOULD BE PROTECTED

Many reasons have been given in support of protecting industrial design. The most popular argument is that strong design protection will lead to increased innovation and creativity by providing designers with an economic incentive to develop better products. This increased creativity and innovation creates other benefits. For instance, some feel that strong industrial design protection will have a trickle-down effect on the manufacturing industry in the United States. That is, strong industrial design protection will lead to more creativity and innovation which will lead to higher-quality American products, which will result in an increase in the number of consumer goods manufactured in the United States, and end with the return of the United States as a leading world manufacturer. Whether stronger industrial design protection will actually bring about these results is questionable, nevertheless, manufacturers and industrial designers seek stronger protection.

C. THE CURRENT STATE OF INDUSTRIAL DESIGN PROTECTION IN THE UNITED STATES

Currently, protection for industrial design can be found under copyright law, patent law, and trademark law. Each of these areas of intellectual property law provides a different level of protection, and each has distinct advantages and disadvantages when compared to other forms of protection for industrial design. Despite the protection that each of these areas of law provides for industrial design, the consensus among intellectual property scholars and industrial designers is that none provides a level of protection that adequately serves the needs of the design community.

1. Protection under Patent Law. The protection offered under United States patent law comes in the form of design patents. Unlike utility patents that protect the functional and utilitarian aspects of useful articles, design patents protect the

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19 See Woodring, supra note 2, at 155-59 (describing how comparative protections led to greater creativity in both fifteenth century Venice and modern-day Japan).
20 See id. at 158 (noting the estimate that "the average industrial designer annually affects over $100 million of the United States gross national product").
21 See id. at 157 (stating that the additional incentive resulting from heightened protection of industrial designs will substantially aid the United States in "maintaining equality with [its] competitors").
appearance of useful articles. Some scholars have argued that design patents are the answer to the protection needs of industrial designers, but the majority of literature on this topic supports the conclusion that the inadequacies of design patents render the patent system unable to protect the designs of the majority of manufactured products.

The requirements and characteristics of design patents prevent the designers of many products from benefiting from the protection that design patents offer. First, in order to obtain a design patent, the design must meet the nonobvious requirement imposed on all patents, both utility and design. In order to meet the nonobvious requirement, the design of a product must not be obvious from the standpoint of someone skilled in the trade in light of all existing designs of similar products. Many product designs cannot meet this requirement even though the design is new and, as argued by many, deserving of an equitable level of protection for the designer. The fashion industry provides many examples of this shortfall of design patents. Although many popular clothing designs are new and innovative, when the standard for a design patent is applied, the design fails to qualify for a design patent because the design is not nonobvious to someone skilled in the industry—other clothing designers—in light of existing clothing designs.

In addition to meeting the nonobvious requirement, designs must also meet an ornamentality requirement to qualify for a design patent. Design patents only protect the ornamental aspects of the patented design, therefore, a design patent...

24 Id. § 171.
25 See Saidman, supra note 22 (advocating design patents as the solution to the protection needs of industrial designers).
28 See, e.g., Briggs, supra note 26, at 176-77 (noting that courts have defined the standard for nonobviousness as being whether the design is obvious to an ordinary designer); Saidman, supra note 22, at 181 (citing In re Cho, 813 F.2d 378, 382, 1 U.S.P.Q.2d (BNA) 1662, 1664 (Fed. Cir. 1987), and In re Nalbandian, 661 F.2d 1214, 1217, 211 U.S.P.Q. (BNA) 782, 785 (C.C.P.A. 1981) for the standard that a design patent must be obvious to a designer of ordinary skill in view of all earlier designs).
29 See Briggs, supra note 26, at 176-77 (explaining that “even new clothing designs that do not incorporate any known design elements can still fail to qualify for design patent protection”).
30 Id. at 179.
31 Id. at 176-78.
will not protect functional aspects. This requirement does not present a problem for designs that are clearly ornamental, but for designs that incorporate ornamental and functional aspects in the same product, courts have had trouble distinguishing between the protectable ornamental aspects and the unprotectable functional aspects. This problem is particularly applicable to the work of industrial designers because the products they design will inevitably have both functional aspects and ornamental aspects. Therefore, the ability and willingness of the courts to develop rules to extract the protectable ornamental aspects of a design is crucial to the successful protection of industrial design through design patents, but courts have not yet developed an easily applied rule in this area.

Even if a product design can meet the nonobvious and ornamentality requirements of a design patent, the logistics of obtaining a design patent prevents many products from benefiting from the protection they provide. Design patents are expensive and can take up to two and a half years to obtain. Although this presents no problem for the manufacturers of certain products, for many others, the high cost and long processing time for design patents create barriers that defeat the benefits of a design patent and make design patents financially impractical. For example, for products like cars, which have a high sales volume and a design that may last for years, these barriers are not insurmountable. On the other hand, for product designs that remain popular for short periods of time, like clothing, these barriers make protection through design patents financially unfeasible.

Despite these inadequacies, for products that meet the requirements of design patents and have the characteristics that make obtaining a design patent feasible,
design patents do offer relatively strong protection. Once a design patent is obtained, it prevents unauthorized copying of the design for fourteen years from the date of the grant. In addition, since the D.C. Circuit Court of Appeals was created to handle patent related cases, the law regarding patent validity and infringement has become much more uniform. Therefore, manufacturers are better able to assess the actual protection their designs will enjoy. In sum, design patents do offer advantages, but these advantages only benefit the designers and manufacturers of products that meet the requirements of a design patent and have characteristics that make obtaining a design patent feasible. Ultimately, for many products, design patents simply are not the solution to the need for the protection of industrial design.

2. Protection under Copyright Law. Protection for industrial design can also be found under current United States copyright law embodied in the Copyright Act of 1976 (the Copyright Act). The Copyright Act extends copyright protection to “original works of authorship fixed in any tangible medium of expression . . . .” An original work of authorship includes, among other categories, “pictorial, graphic, and sculptural works . . . .” Copyright protection gives the owner of the copyright the exclusive right to copy or reproduce the protected work, and the protection begins at the time the design is created and lasts for the life of the author plus seventy years.

Similar to protection under patent law, design protection via copyright law has its pros and cons. One advantage of copyright protection for industrial design is the relative ease with which it is obtained. As mentioned above, copyright protection begins at the moment of creation. There are no fees to pay and no application process. As a result, copyright protection is not only logistically easier to obtain relative to other forms of protection for industrial design, but it can also be much cheaper. Another advantage of copyright protection is its long duration. If a designer can successfully obtain protection for his design through copyright, he will not only have the exclusive right to replicate his design for the rest of his life plus seventy years, but he will also have the option of selling this right to others. Some have argued that the long duration of copyright protection actually

40 See Saidman, supra note 22, at 186 (discussing the advantages of design patents for protecting industrial design).
41 Id.
43 Id. § 102(a).
44 Id. § 102(a)(5).
45 Id. § 302(a).
46 See id.
47 Id.
hinders advancement of industrial design by creating monopoly-like control over certain designs for periods that could easily last more than a century.\(^48\) This argument is weakened somewhat by the fact that copyright law allows for independent discovery and fair use.\(^49\) Nevertheless, the possibility of a century of protection is overkill for many designs.

Despite the advantages of copyright protection, many feel that the requirements of copyright protection render it unable to provide adequate protection for industrial design.\(^50\) Designers must jump many hurdles before a design will qualify for copyright protection. The first and highest hurdle is proving that the article is a “work of authorship” within the “pictorial, graphic, and sculptural works” category of § 102 of the Copyright Act in order to make it eligible for copyright protection.\(^51\) The Copyright Act indicates that “the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and capable of existing independently of, the utilitarian aspects of the article.”\(^52\) Further, a useful article is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”\(^53\) So, the answer to the question of whether a certain useful article will qualify for copyright protection depends on whether its aesthetic aspects can be separated from its utilitarian aspects. This presents a serious problem for industrial designs because the very nature of industrial design involves a melding of utility and function, often making separation of the utilitarian aspects of the design from the functional aspects very difficult, if not impossible. Nevertheless, over the years, industrial designers have had some limited success in protecting their designs

\(^{48}\) See Brown, supra note 26, at 1342 (discussing the disadvantages of copyright protection for industrial design).

\(^{49}\) 17 U.S.C. § 107 (codifying the fair use doctrine). The code provides that “the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” Id. The fair use doctrine was developed to give courts the ability to avoid strict application of copyright law in situations where a finding of infringement would stifle creativity and advancement instead of encouraging it. See Stewart v. Abend, 495 U.S. 207, 14 U.S.P.Q.2d (BNA) 1614 (1990).

\(^{50}\) See Saidman, supra note 22, at 171-72; Brown, supra note 26, at 1342; Briggs, supra note 26, at 182-83.


\(^{52}\) Id. § 101.

\(^{53}\) Id.

\(^{54}\) See INDUS. DESIGNERS SOC’Y OF AM., supra note 11.
through copyright. In response to the confusion created from these cases, Congress added the language quoted above to the Copyright Act to codify both common law developments and Copyright Office regulations in an effort to "draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." Despite these efforts, determining which aspects of a design, if any, qualify for copyright protection under the Copyright Act still requires an examination of cases that address this issue.

One of the earliest cases that addressed the issue of copyright protection for the design of useful articles is *Mazer v. Stein*. In *Mazer*, the dispute was between two lamp manufacturers. The respondent, Stein, created statuettes of human figures and obtained copyrights for the statuettes before using them as lamp bases. The petitioner copied these statuettes for use as lamp bases in their own lamp making business without obtaining permission from the respondent. The respondent sued for copyright infringement. The petitioner claimed that no infringement had occurred because copyright protection did not extend to the statuettes when used as lamp bases because when used as such, the statuettes could only be protected through a design patent. The Supreme Court rejected this argument and upheld the validity of the petitioner's copyright in the statuettes even when used as lamp bases. The Court's holding in *Mazer v. Stein* indicated that the subsequent incorporation of a copyrighted work of art in a manufactured useful article did not necessarily invalidate its copyright protection, but the decision did not clarify how far the Court was willing to extend this rationale. The question of separability of form from function still remained. By holding that aspects of useful articles can, under certain circumstances, be protected through copyright, the *Mazer* decision set the stage for later cases to hash out what these circumstances are. From a separability standpoint, the issue in *Mazer* was simple. Not only could the aesthetic aspects of the statuette be easily separated from the functional aspects of the lamp, but the petitioner had also been selling the statuettes as statuettes, not just as lamp bases. Subsequent cases would not be so simple.

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55 See Brown, supra note 26, at 1345-46.
58 Id. at 203.
59 Id. at 202-03.
60 Id. at 203.
61 Id. at 203-04.
62 Id. at 205.
63 Id. at 218.
64 Id. at 203.
In *Esquire, Inc. v. Ringer*, the D.C. Circuit Court of Appeals faced the issue of the copyrightability of the overall shape of outdoor lighting fixtures.® Esquire designed a contemporary, elliptically-shaped outdoor lighting fixture and attempted to register the design with the Copyright Office.® The Register of Copyrights refused to register Esquire’s claim to copyright of the design on the grounds that the aesthetic aspects of the light fixture could not be separated from the utilitarian aspects, therefore the design was not properly the subject of copyright.® On appeal, the district court reversed the decision of the Register of Copyrights and held that Esquire’s design was entitled to registration in accordance with *Mazer v. Stein*.® In reversing the decision of the district court, the court of appeals distinguished *Mazer* on the grounds that *Mazer* dealt with invalidation of copyright due to the use of a copyrighted work of art in a useful article, while this case dealt with the copyrightability of the overall shape of the utilitarian object.® The court stated that “the dancing figures considered in *Mazer* would clearly be copyrightable. The statuettes were undeniably capable of existing as a work of art independent of the utilitarian article into which they were incorporated.”® The court concluded that, unlike the statuettes in *Mazer*, the lighting fixtures manufactured by Esquire were not copyrightable because the overall shape would not qualify the fixtures as works of art independent of their functional purpose.®

A comparison of the results in *Mazer* and *Esquire* reveals the basic reasoning used by the courts to distinguish copyrightable works of art from uncopyrightable useful articles. This reasoning has come to be known as the separability test.® The *Mazer* and *Esquire* decisions are seen as embodying the physical separation prong of the separability test.® Under this prong, aesthetic aspects of a useful article are eligible for copyright protection if they can be physically separated from the useful article itself.® The statuettes in *Mazer* are a perfect example of this type of aesthetic aspect because they were easily physically separable from the lamps.® But the physical separability test is of little use to many aesthetic aspects of useful

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® Id. at 798.
® Id. at 798-99.
® Id. at 799.
® Id. at 804-05.
® Id. at 804.
® See id. (discussing the difference between the statuettes in *Mazer* and the lighting fixtures in the case at bar).
® See Saidman, supra note 22, at 170.
® Id. at 169 n.19.
® Id. at 170.
articles, specifically those that clearly would be copyrightable if they were capable of existing independently from the useful article they adorn. For example, a design stained onto a silk robe or a carving on the back of a wooden rocking chair would both be eligible for copyright protection standing alone, but under the physical separability test, because they cannot be physically removed from the useful objects to which they are attached, they would not be eligible for copyright protection. This irrational result gave rise to the conceptual prong of the separability test, under which the aesthetic aspects of a useful article can be copyrighted if they are conceptually separable from the functional aspects of the article. 76

The question then becomes, just what is conceptually separable? It would appear that the silk design and wood carving from the above example would be eligible for copyright under the conceptual separability test, but what about the lighting fixtures in *Esquire*? The Second Circuit dealt with the conceptual separability issue in *Kieselstein-Cord v. Accessories by Pearl, Inc.* 77 Mr. Kieselstein-Cord, appellant, was a successful designer of ornamental belt buckles made from precious metals including gold and silver. 78 The appellee was making exact copies of the buckles designed by Mr. Kieselstein-Cord using common metal. 79 The appellee did not deny copying the appellant’s buckle designs. Rather, he argued that the designs of the belt buckles were not copyrightable because the aesthetic aspects could not be separated from the utilitarian aspects of the buckle 80 and that “the buckles are merely useful objects, which include decorative features that serve an aesthetic as well as a utilitarian purpose.” 81 In rejecting the appellee’s claim that physical separability was required for the appellant’s buckle designs to be protected, the court recognized the possibility of conceptual separability and stated that “[the court] see[s] in appellant’s belt buckles conceptually separable sculptural elements, as apparently have the buckles’ wearers who have used them as ornamentation for parts of the body other than the waist.” 82 Based on this conceptual separability, the court concluded that the fact that the belt buckle encompassed both utilitarian and aesthetic aspects did not prevent it from being copyrightable. 83

76 Saidman, *supra* note 22, at 170.
78 *Id.* at 990-91.
79 *Id.* at 991.
80 *Id.*
81 *Id.* at 993.
82 *Id.*
83 *Id.* at 993-94. Despite this finding, the court remanded the case for determination of whether the originality and creativity requirements of copyright law would otherwise prevent the buckles
The Kieselstein-Cord decision validated the conceptual separability test. But, even with this test, it is still unclear whether the aesthetic aspects of many industrial designs would be eligible for copyright protection. Because the buckles designed by Mr. Kieselstein-Cord were also worn as jewelry, it was easier for the court to recognize and emphasize their artistic qualities over their utilitarian purpose. In fact, when worn as jewelry rather than attached to a belt, a belt buckle is no longer a combination of form and function, but rather is comprised of aesthetic features alone. This does not mean that wearing the light fixtures from Esquire around one’s neck would make their design copyrightable, but it does underscore the confusion surrounding the conceptual separability test.

The results of other cases that have confronted the idea of conceptual separability demonstrate the lack of clarity with which the test is applied. In Custom Chrome, Inc. v. Ringer, the D.C. District Court confronted the conceptual separability test head-on and decided that the Copyright Office did not act unreasonably by refusing registration to motorcycle accessories designed by the plaintiff due to lack of conceptual separability. In refusing to acknowledge registration of the motorcycle accessories, the Register of Copyright rejected the notion that the custom motorcycle parts were copyrightable because they had artistic elements that could be conceptualized separately from the utilitarian aspects of the parts. Rather, the Register took the position that the parts were not copyrightable because “they were useful articles that lacked separable copyrightable sculptural or artistic features.”

In Pivot Point International, Inc. v. Charlene Products, Inc., the Seventh Circuit held that a mannequin head developed for use as an educational tool in the hair design industry was copyrightable. The court stated, “[i]t certainly is not difficult to conceptualize a human face, independent of all of [the mannequin’s] specific facial features, i.e., the shape of the eye, the upturned nose, the angular cheek and jaw structure, that would serve the utilitarian functions of a hair stand and, if proven, of a makeup model.” The court emphasized that the mannequin was the “product of [the designer’s] artistic judgment.”

from being copyrightable. Id. at 994.

84 Id. at 991.
86 Id. at *3-*4.
87 Id.
89 Id. at 931.
90 Id.
In *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, the Fourth Circuit used reasoning similar to that used by the Second Circuit in *Pivot Point* when it affirmed the copyrightability of fish and animal mannequins used as taxidermy forms despite the fact that they serve a functional purpose. The court opined that:

> Even though covered with a skin, the mannequin is not invisible but conspicuous in the final display. The angle of the animal's head, the juxtaposition of its body parts, and the shape of the body parts in the final display is little more than the portrayal of the underlying mannequin. Indeed, the mannequin can even portray the intensity of flexed body parts, or it can reveal the grace of relaxed ones. None of these expressive aspects of a mannequin is lost by covering the mannequin with a skin. Thus, any utilitarian aspect of the mannequin exists "merely to portray the appearance" of the animal.

As the above cases demonstrate, courts have tried to develop a coherent test to offer guidance to other courts facing the issue of the separability of form and function and to give designers a clearer understanding of which aspects of their designs will and will not qualify for copyright protection. Maybe with time, a more definite, brighter-line rule will emerge that will allow designers to better predict which aesthetic aspects of the useful articles they design will be protected. For now, except for those designers who design products that have already had their copyrightability affirmed through litigation, the majority of designers will have to rely on either an interpretation of the existing case law or on a determination of copyrightability by the Copyright Office, which assures only a presumption of copyright validity. Further, in the end, designers have no practical way to assure themselves that their designs will enjoy protection under copyright law. Even a bright-line test, though helpful, would not extend copyright protection to aesthetic aspects of useful articles that do not pass the separability test. Therefore, for many designers, like the designer of the lighting fixture in *Esquire*, a definitive test would be useful only to the extent that it

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92 Id. at 494 (citing 17 U.S.C. § 101).
93 See, e.g., Fonar Corp. v. Domenick, 105 F.3d 99, 104 (2d Cir. 1997) (stating that acknowledgment of registration by the Copyright Office provides only a presumption that the copyright is valid).
informs designers that they will need to look elsewhere to find protection for their design.

In addition to the weakness of the separability test demonstrated through case law, Congress has also expressed limits to the application of the separability test. The legislative history behind the Copyright Act—in which Congress intended to codify the conceptual separability test—clearly demonstrates Congress's intent to prevent the application of the test from extending beyond purely artistic aspects of useful articles. House Report 1476 indicates:

A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statue or carving is used to embellish an industrial product or, as in the Mazer case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill.

This inside look into the standard for separability that Congress wanted to create when passing the Copyright Act shows that Congress simply did not intend for the act to serve as a method of protecting industrial design.

Besides the problem associated with passing the conceptual separability test, other difficulties with obtaining a copyright add to the inadequacy of the protection copyright provides for industrial design. One of these problems stems from the creativity requirement of copyright protection. The creativity requirement of copyright appears in Feist Publications, Inc. v. Rural Telephone Service Co. In Feist, the Supreme Court established that in order for a work of authorship to qualify for copyright protection, it must display a minimal level of creativity. The dispute in Feist was between the publishers of two telephone

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95 Id. (emphasis added).
97 Id.
directories that covered overlapping geographical areas.\textsuperscript{98} Rural Telephone Company compiled a telephone directory with information it collected from its subscribers.\textsuperscript{99} Feist Publication requested permission from Rural Telephone Company to use the information in its local directory for the creation of a regional directory, which would include the communities serviced by Rural Telephone Company.\textsuperscript{100} Rural Telephone Company refused to allow Feist to use the information, but Feist used it anyway.\textsuperscript{101} In turn, Rural Publication sued for copyright infringement.\textsuperscript{102} The Court concluded that Rural Telephone’s directory did not meet the minimum level of creativity required for copyright protection because of the lack of creativity displayed by the method that Rural Telephone employed to organize the information in its directory.\textsuperscript{103} Therefore, the court held that Feist’s use of the information in Rural Telephone’s directory did not result in infringement.\textsuperscript{104}

Although the requisite level of creativity is relatively low, some argue that many product designs are not able to meet this minimal creativity requirement and therefore cannot obtain protection under copyright.\textsuperscript{105} For example, many clothing designs may incorporate aspects from other designs in a novel and original way, but this combination may be found as insufficient to meet the creativity requirement. On its face, this argument seems weak; assuming this argument is correct, if one of the main reasons for protecting industrial design is to encourage creativity and innovation in design, it would appear that not protecting designs that do not meet the minimal creativity requirement would not interfere with this goal. But, from a practical standpoint, if designers are not finding the protection they need and deserve under copyright law or any other area of U.S. law, their plight should be given a more in depth examination before a conclusion can be made as to whether current design protection is adequate.

In sum, protection for industrial design can be found in copyright law if the particular article or aspects of the article can either be physically or conceptually separated from its utilitarian aspects and if the design of the article meets the minimum level of creativity required by copyright law. To be sure, some, if not many, industrial designs will successfully find protection by satisfying these requirements, but many designs will not. Further, the current type of protection offered by copyright law, even for those designs that are copyrightable, may not
be the type of protection that the industrial design community desires. The conceptual separability test is too unpredictable to meet the protection needs of many industrial designers, and the costly litigation required to defend a copyright against infringers often destroys any financial advantages that protection through copyright offers.

3. Protection under Trademark Law. Protection for industrial design can also be found under trademark law. This protection comes in the form of trade dress protection. Black’s Law Dictionary defines trade dress as “the overall appearance and image in the marketplace of a product or a commercial enterprise.”

Trade dress encompasses many characteristics of a product including color, size, weight, texture, shape, and graphics, or a combination of these characteristics. When the trade dress of a product becomes so popular that consumers begin to associate the particular dress with the source of the product, the trade dress can then be protected under trademark law.

Like copyright and design patent protection, protection of industrial design through trade dress law has advantages and disadvantages. One of the major advantages of trade dress protection of industrial design is that registration is not required to enjoy the protection trademark law offers. Another advantage of trade dress protection is that as a result of dealing with trademark issues for such a long time, courts have become accustomed to overseeing litigation involving the various trademark issues that arise in business settings and have many well-developed and easy to follow methods for deciding these issues. Because courts have come up with reliable methods of analyzing trademark and trade dress issues, trade dress owners have a reliable standard to follow when deciding whether their products will be protected. Trade dress protection is also advantageous because the standard for proving trade dress infringement is relatively broad. To prove infringement, the owner of a valid trade dress must only prove that the infringer’s use of the infringing trade dress is likely to cause confusion among consumers about the source of the product.

Protection from trademark law through trade dress also has disadvantages. The major disadvantage of trade dress protection for industrial design is the

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107 See Saidman, supra note 22, at 170 (discussing the advantages and disadvantages of using trade dress to protect industrial design).
108 See id.
109 Id. at 171.
110 Id. (discussing the advantages of trade dress protection).
111 Id.
112 Id.
113 Id.
requirement of secondary meaning. \footnote{114} In the trade dress context, secondary meaning exists when consumers can readily identify the source of a product simply by viewing the trade dress of the product. \footnote{115} Once a product design attains secondary meaning, it enjoys strong protection. Unfortunately, attaining secondary meaning is a long and expensive process. \footnote{116} In order to gain the public recognition required for secondary meaning, the designer or owner of a design must spend large amounts of money on advertising in addition to the time that is required to engrain the product's image and identity into the minds of consumers. \footnote{117} In short, similar to the problems of cost and time associated with obtaining design patent protection, the cost and time required to obtain protection through trade dress will prevent trade dress doctrine from benefiting many designers.

In conclusion, although protection for industrial design can be found under current United States patent, copyright, and trademark law, the consensus among legal scholars and industrial designers is that these protections fall short of the needs of the industrial design community. As a result, designers and manufacturers are left in search of some other method to protect the design of their products. As the next section demonstrates, some of these manufacturers have found the answer to their design protection needs in sui generis protection legislation.

III. THE USE OF SUI GENERIS PROTECTION FOR CERTAIN CATEGORIES OF DESIGN

One of the most recent developments in United States copyright law is the addition of Chapter 13 to Title 17 of the United States Code by the Vessel Hull Design Protection Act (VHDPA) in 1998. \footnote{118} Chapter 13 is entitled "Protection of Original Designs" \footnote{119} and it provides that "[t]he designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter . . . ." \footnote{120} The statute limits the scope of the above language by defining a useful article as "a vessel hull, including a plug or mold, which in normal use has an intrinsic utilitarian function that is not merely to
portray the appearance of the article or to convey information." Because of this limitation, the provisions of this Chapter do not provide copyright protection, rather they provide sui generis protection for the design of boat hulls. The Chapter requires the Register of Copyrights to administer a registration system for original designs of vessel hulls, and since the passage of the act, over 100 vessel hulls have been registered. The design protection offered by this code section lasts for a period of ten years and is only available for designs that have actually been made into vessel hulls. The protection does not extend to designs that exist only in drawings or models. Furthermore, protection does not extend to commonplace designs or other designs that have become prevalent or ordinary. If a design was made public more than two years before the date of the application for registration or if the design is already protected by a design patent, then protection under this code section is not available. In order to enjoy the protection offered under this section, the design owner must give proper notice by affixing notification to the hull in a location that will provide reasonable notice that the vessel design is registered. This notice must include a statement that the design is protected, the year in which protection began and the identity of the owner of the design. Once registration of a design is obtained and proper notice is given, the owner of the design is given the ability to protect the design through legal action against infringement. The remedies available for infringement include damages, recovery of the infringer’s profits, attorney’s fees, injunction, and the ability to seize infringing goods.

121 Id. § 1301(b)(2).
123 Id. at 1.
125 Id.
126 Id. § 1302(2).
127 Id. § 1302(5).
128 Id. § 1329.
129 Id. § 1306.
130 Id. § 1306(b).
131 Id. § 1306(a)(1).
132 Id. § 1321(a).
133 Id. §§ 1322-1323.
IV. EXPANDING SUI GENERIS PROTECTION TO MEET THE NEEDS OF THE DESIGN COMMUNITY

The sui generis protection of boat hull designs created by the VHDPA demonstrates one example of how sui generis protection can be used as a solution to the inadequacies of the current protection of industrial design in the United States. An assessment of the success or failure of the VHDPA provides some insight into the viability of such a solution. In November 2003, the United States Copyright Office and the USPTO released a joint report on the status of the VHDPA. The report addresses specific effects of the VHDPA including (1) the suppression of infringement on registered designs, (2) the extent to which the boat manufacturing industry has utilized the protections offered by the Act, (3) the creation of incentives for new designs, (4) the effect on prices within the industry, and (5) other considerations relevant to the evaluation. The report concludes that as of November, 2003, it was too early to make any final conclusions regarding the effects of the VHDPA, although the information available at that time indicated that the Act was having some success in terms of promoting and protecting new designs. As of October 15, 2003, the Copyright Office had registered 156 hull designs, and one infringement claim had been brought under the VHDPA. Although the results of the report do not provide any conclusive information regarding the success of the sui generis protection offered by the VHDPA, the report does provide a positive early assessment of the viability of sui generis protection for the designs of individual categories of products. With time, legal scholars and lawmakers will have more information to work with and will be better equipped to expand sui generis design protection legislation to other industries if such an expansion is needed.

Sui generis protection for industrial design has characteristics that make it an ideal solution for the inadequacies of the current system. One advantage is that it allows Congress to custom-fit protection legislation according to the specific needs of the targeted industry. For example, one of the complaints reported in the joint report on the VHDPA was that the ten year term of protection afforded under the VHDPA was not long enough to justify registration of hull designs for...
many manufacturers.\textsuperscript{139} The complaint was that when a design is registered, it is also made public. Therefore, in order for registration to be beneficial to the designer, the design must be protected for a sufficiently long period to allow the designer to recoup his investment in the design before others are allowed to copy it without infringing.\textsuperscript{140} For across-the-board design legislation that protects many different industries, responding to this type of complaint would be difficult for Congress because the decision would affect all industries covered by the protective legislation. Because the VHDPA currently only applies to boat hull designs, lawmakers have more freedom from industry influence when it comes to making changes to the statute. If the boating industry supports the change and Congress agrees with the alteration, then the adjustments can be made without affecting other industries.

Another advantage of sui generis design protection is that it allows stronger protection to be given to industries that desire increased protection by avoiding opposition from other industries that oppose such measures. One of the biggest hurdles faced by Congress when it comes to passing design protection legislation is strong opposition from certain industries.\textsuperscript{141} Utilizing sui generis design protection allows Congress to sidestep this problem by passing legislation with limited scope. If a particular industry is ready for stronger protection, then their efforts to obtain such protection will not be thwarted by vocal opposition from other industries.

Sui generis design protection does create new burdens for Congress and for the United States Copyright Office. Although custom-made legislation for each industry may take more time and effort to develop than across-the-board design protection, there are ways in which Congress can make the process of creating sui generis legislation less burdensome. As more and more industries are covered, Congress will be able to recycle certain parts of legislation that have already been developed for and tested by other industries. In time, developing new legislation for an individual industry could be a matter of piecing together a suitable combination of legislation that has already been put to use by other industries. Further, under the VHDPA, the Copyright Office is charged with the responsibility of managing the registration process created by the Act.\textsuperscript{142} Assuming the Copyright Office will retain this responsibility, any expansion of sui generis design legislation could create a considerable increase in registrations. Again, this burden can be curtailed by developing an efficient registration and

\textsuperscript{139} See id.
\textsuperscript{140} Id.
\textsuperscript{141} See Goldenberg, supra note 1, at 61-62.
\textsuperscript{142} U.S. COPYRIGHT OFFICE & USPTO, supra note 122, at 4.
review process and using registration fees to support a larger staff.\textsuperscript{143} Furthermore, the increased burden to the Copyright Office is offset by the benefits to the industries that are receiving the protection provided by the legislation.

In sum, the advantages of sui generis protection of industrial design include (1) allowing Congress to design legislation to serve the specific needs of individual industries and (2) giving Congress the ability to pass design protection legislation with limited scope and effect, thereby allowing Congress to strengthen protection for industries that support stronger protection and avoid opposition from industries that do not. Although sui generis legislation does create new burdens for Congress and for the Copyright Office, methods exist by which both of these institutions can minimize and control these burdens. The bottom line is that sui generis design protection provides an efficient and effective way for Congress to meet the needs of the design community.

V. CONCLUSION

The general consensus among intellectual property scholars and industrial designers is that current intellectual property law in the United States does not provide adequate protection for industrial design. One of the only inroads in the area of increased design protection is the Vessel Hull Design Protection Act. This act, passed in 1998, created sui generis protection for original designs of vessel hulls. Overall, the registration program established by the VHDPA has been successful and has enjoyed wide acceptance from the industry it protects.

The success of the sui generis protection created by the VHDPA raises the question of whether this type of sui generis protection would be successful if applied to other industries. One advantage of sui generis protection is that it allows industries that would benefit from stronger design protection to acquire the protection they want without massive changes to existing law, which in the past has lead to opposition from other industries and the ultimate failure of expanded protection. Another advantage of sui generis protection is that it allows Congress to draft design protection legislation crafted specifically to address the

\textsuperscript{143} The registration fee under the VHDPA is currently $140. U.S. Copyright Office, Registration of Vessel Hull Designs, available at http://www.copyright.gov/vessels/.
needs of individual industries. Sui generis protection of industrial design may not be the complete solution to the serious threats faced by the United States manufacturing industry, but it does provide one way to curtail the effects of these. Expanding sui generis design protection legislation to industries other than the boat manufacturing industry would be a solid first step toward strengthening the American economy and protecting American jobs.

REGAN E. KEEBAUGH