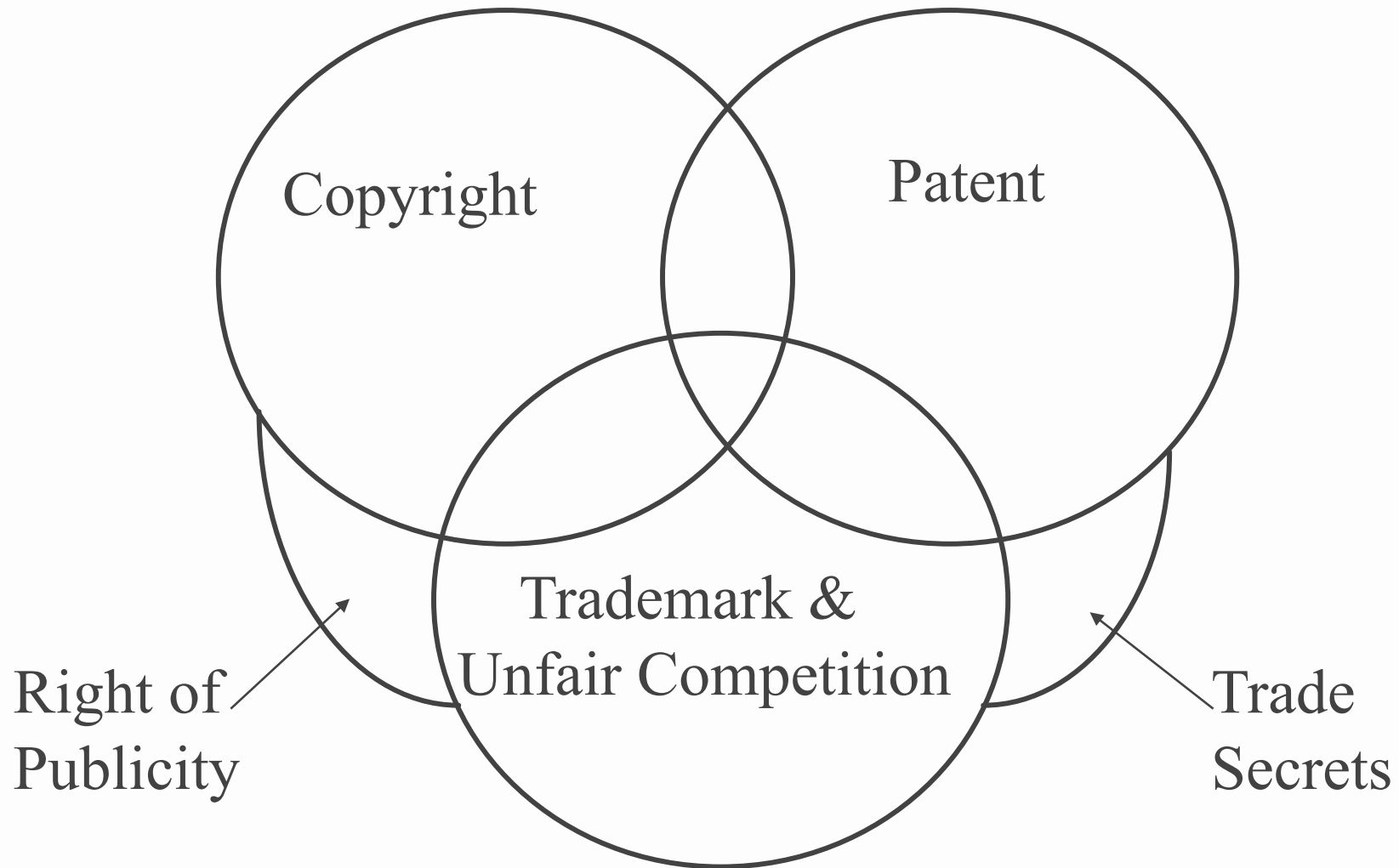


# Industrial Design

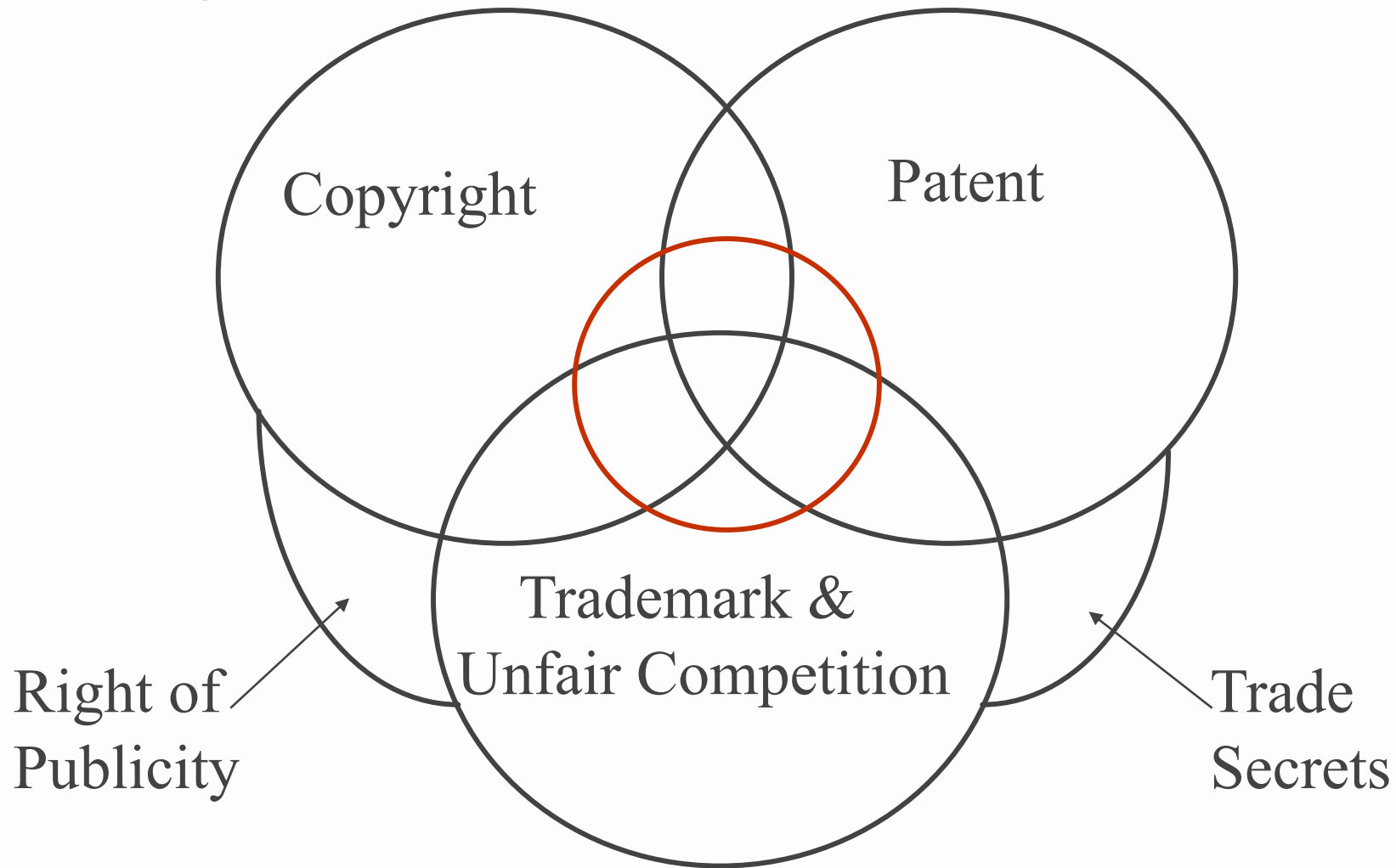
William Fisher

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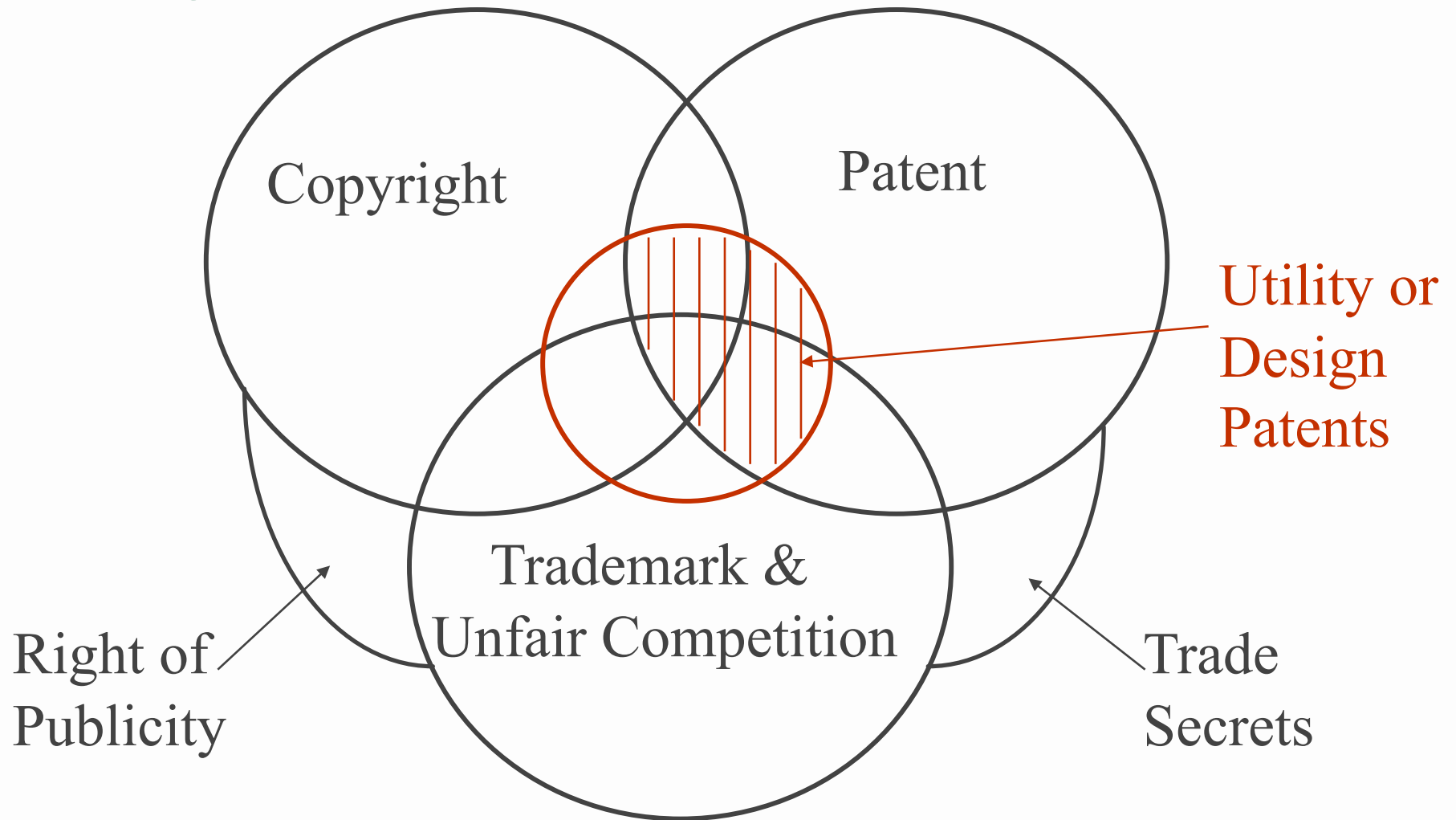
# The Sectors of Intellectual Property Law



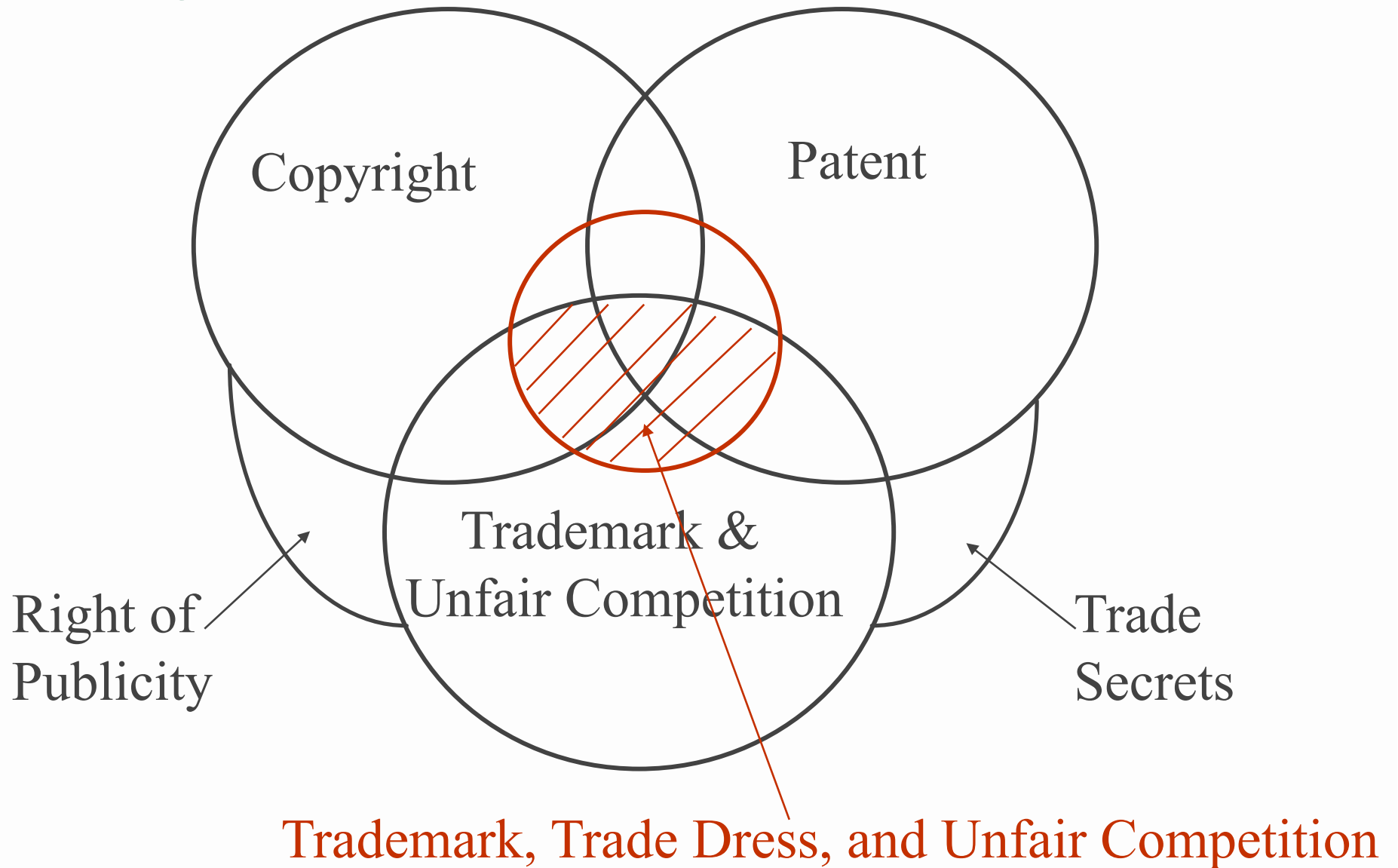
# Intellectual Property Protection for Industrial Designs



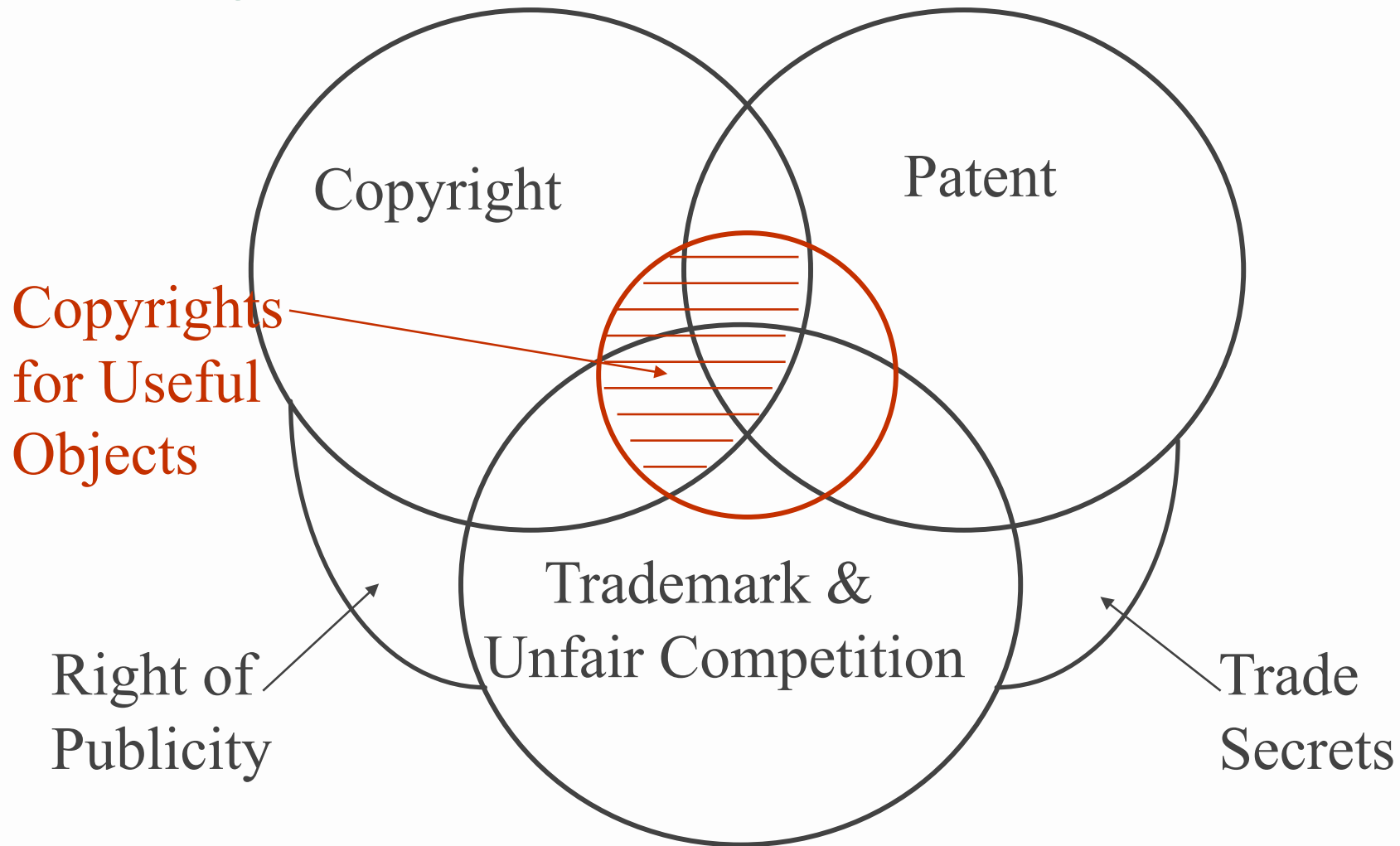
# Intellectual Property Protection for Industrial Designs



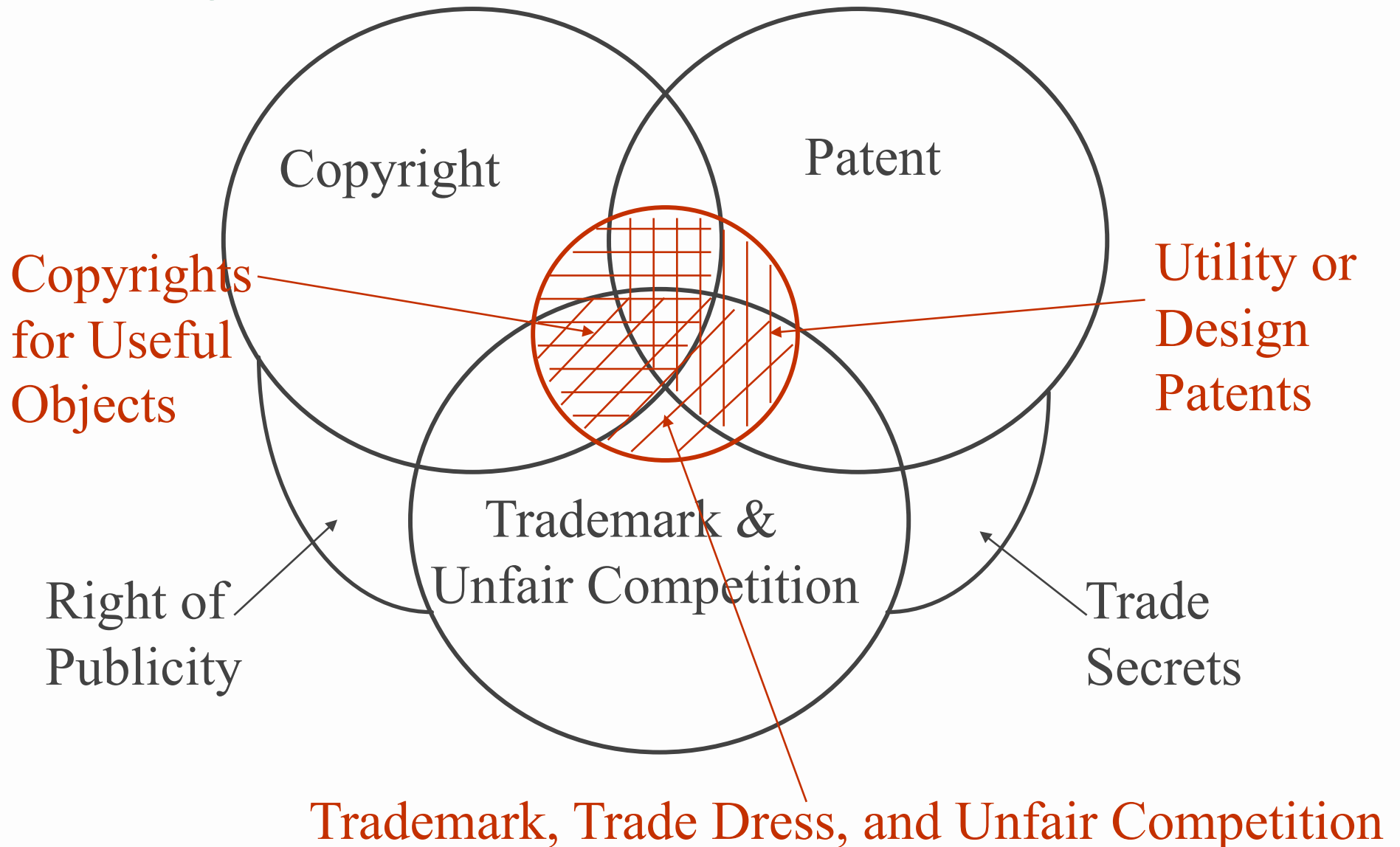
# Intellectual Property Protection for Industrial Designs



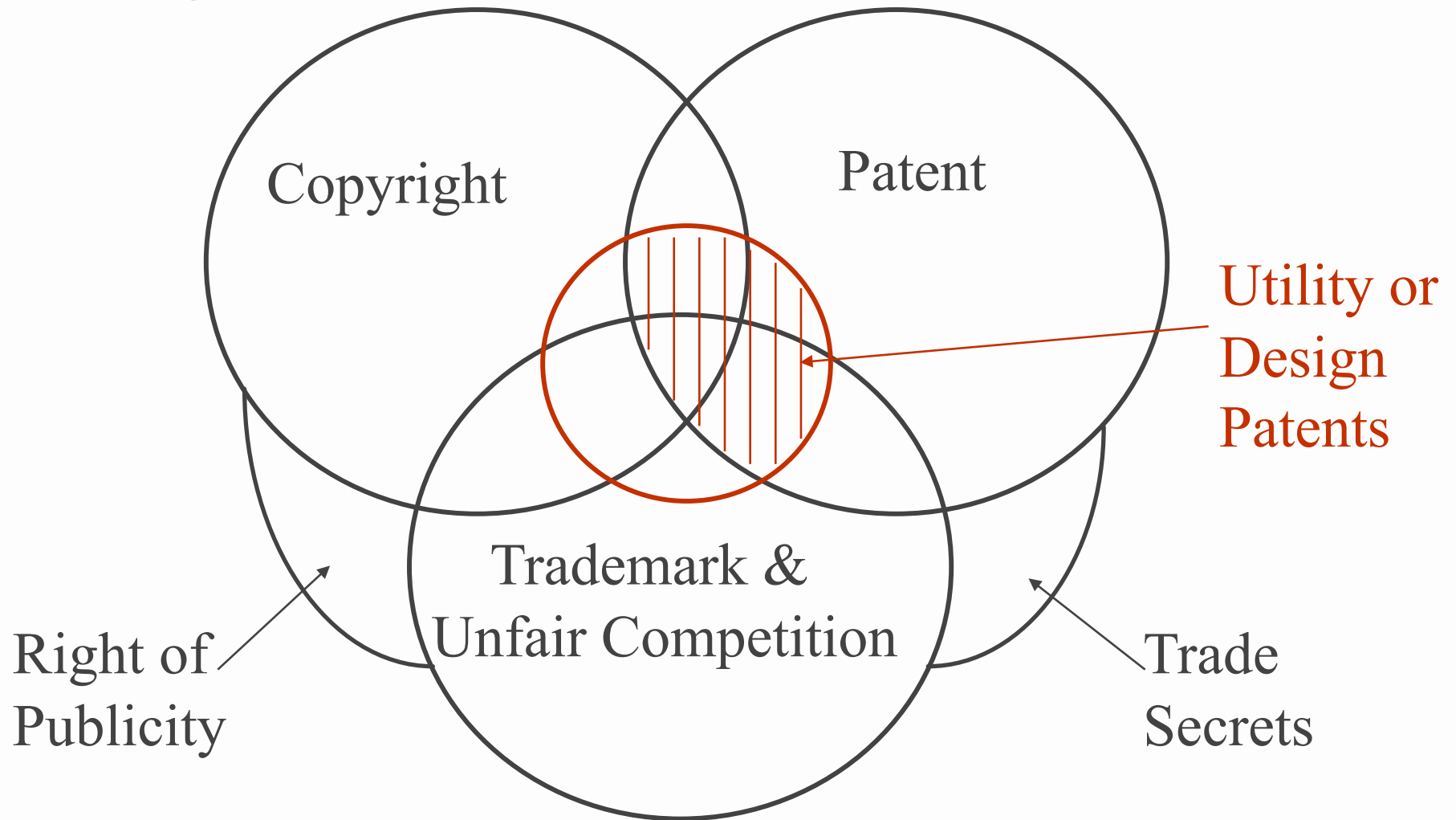
# Intellectual Property Protection for Industrial Designs



# Intellectual Property Protection for Industrial Designs



# Intellectual Property Protection for Industrial Designs





# Utility Patents: Standard Doctrine Applies

- ☞ Novelty
- ☞ Nonobviousness
- ☞ Utility
- ☞ Enablement

# Design Patents -- 35 U.S.C. 171-173

## ☛ Requirements:

- “Design”
- “Primarily ornamental”; not “functional”
- Novelty and Statutory Bar
- Nonobviousness

## ☛ 14-year term

# “Design”

- ☛ Appearance
- ☛ Ephemeral is OK
- ☛ Unstable doctrine concerning protectability of parts

# “Ornamental”

- ☞ Form dictated by function?
- ☞ Product of aesthetic skill and artistic conception?
- ☞ Visible?

# Novel

- ☞ Different from any single prior-art reference or device
- ☞ Overall impression
- ☞ “Ordinary observer” standard

# Novel

“If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, novelty of design is deemed to be present. The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not for a modified already-existing, design.”

--Bartlett (CCPA 1962)

## Section 102(b)

☞ invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the US

# Nonobvious

- ☞ Scope and content of the prior art
- ☞ Differences between prior art and claims
- ☞ Level of ordinary skill in the prior art
  - PHOSITA = “ordinary designer”
- ☞ Secondary (“Objective”) factors:
  - commercial success
  - long-felt, unsolved needs
  - failure of others
  - industry acquiescence
  - suggestions in prior art
  - fact that defendant chose to copy



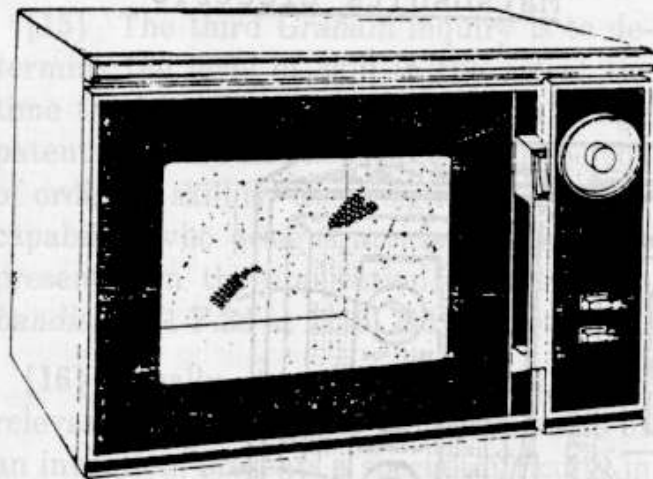
# Procedure

- ☞ Reduction to practice requires 3-dimensional embodiment
- ☞ Simple specification:
  - drawing
  - title
  - single claim

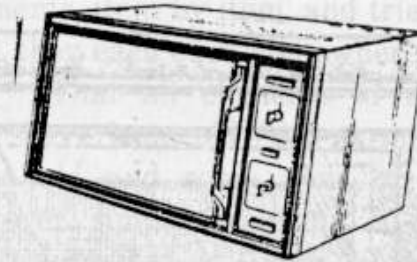
# Infringement

- ☞ No need for plaintiff and defendant to be competitors
- ☞ The 2 designs are substantially the same to an ordinary observer
- ☞ The accused device must appropriate the novelty in the patented device which distinguishes it from the prior art

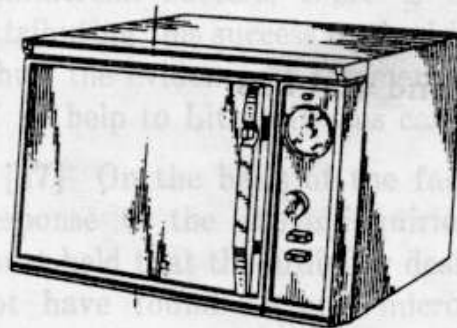
# Prior Art



D-228,607  
Binzer, Schmitt, Wooding,  
Sugunoya and Miyake (10/16/73)  
General Electric



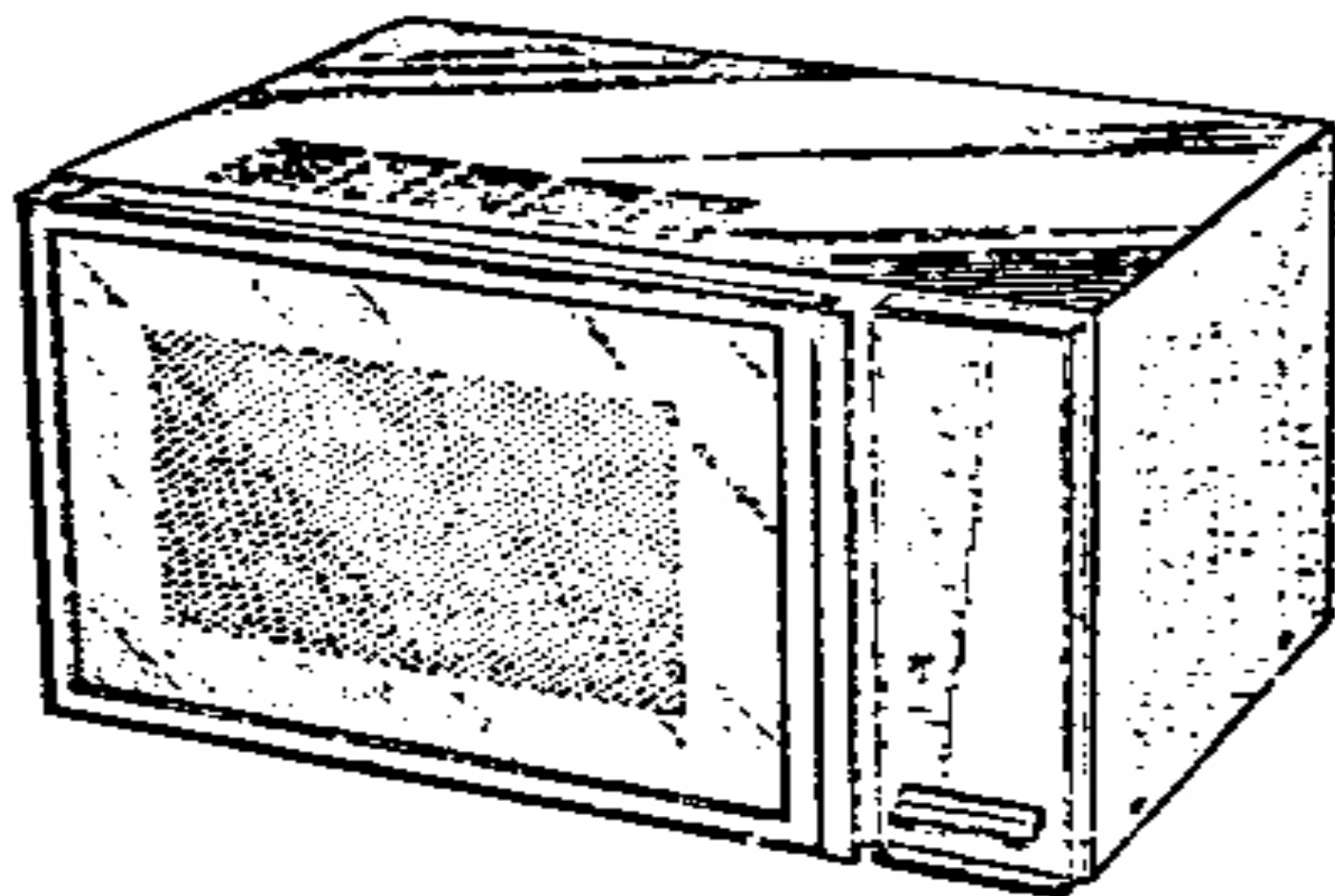
D-228,313  
Sugunoya and Miyake  
(9/4/73)  
Sharp



D-225,579  
Sugunoya and Miyake  
(12/19/72)  
Sharp



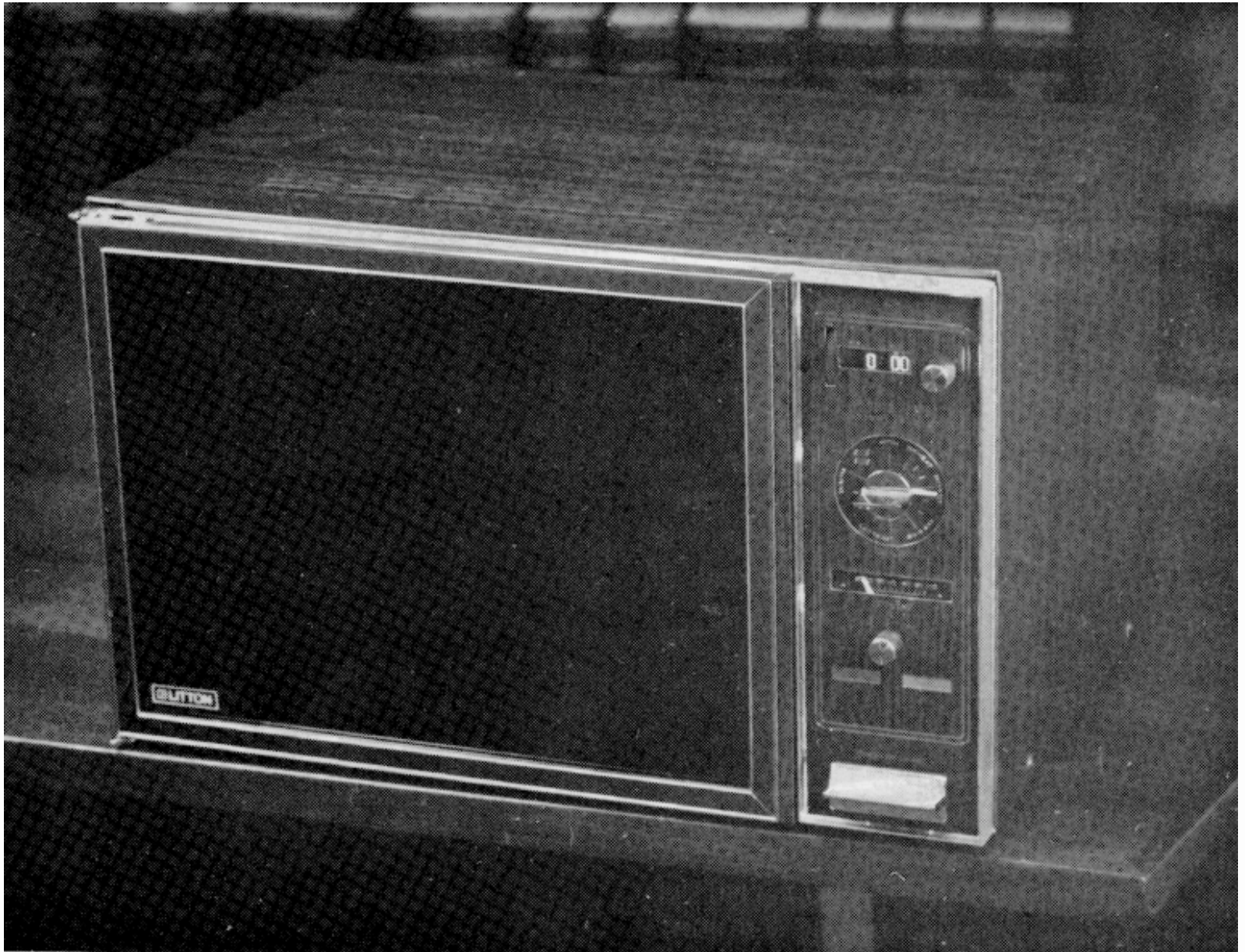
D-225,780  
Binzer, Schmitt & Wooding  
(1/2/73)  
General Electric



D-226,990  
Wolfe, Tapper (5/23/73)  
Litton

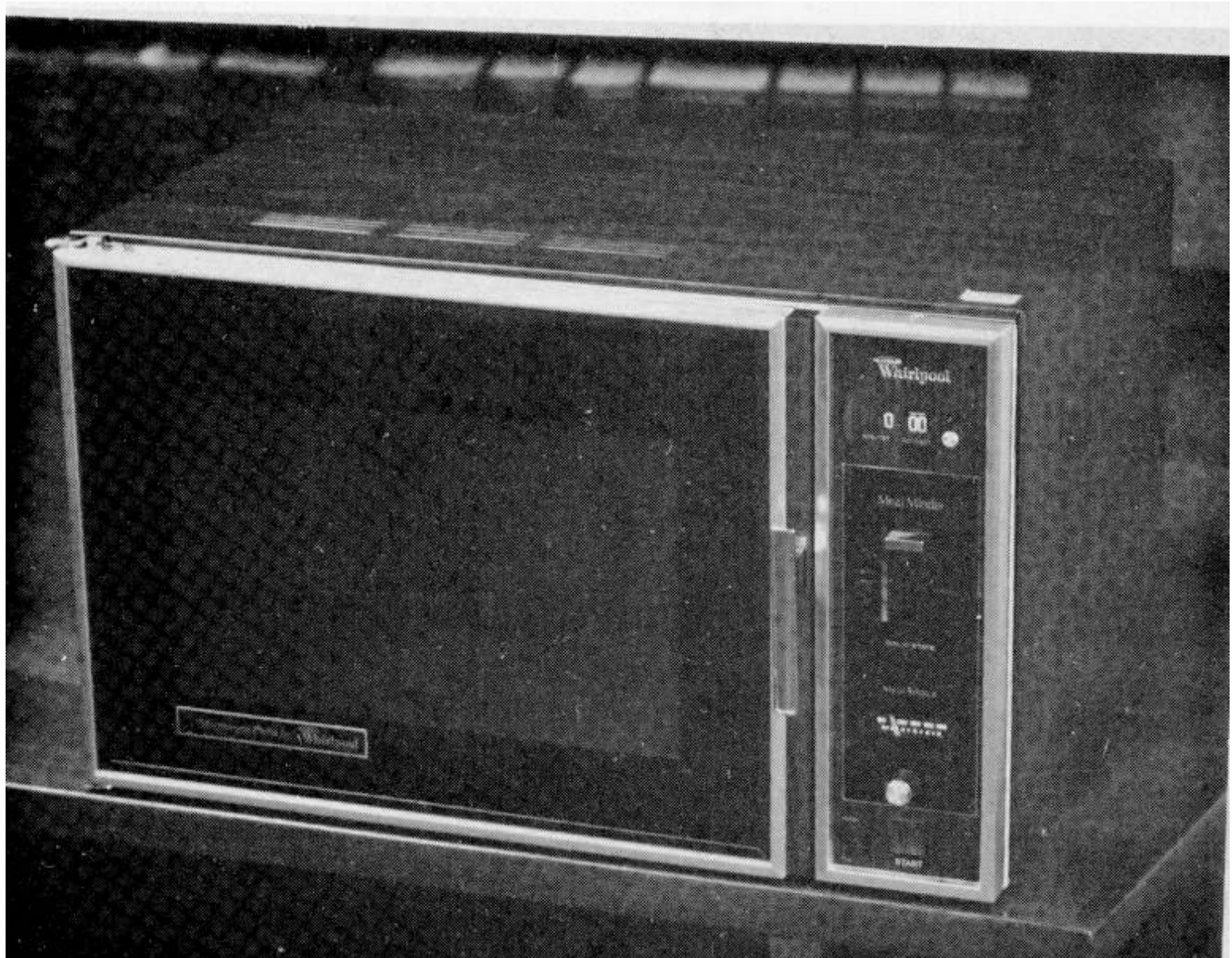


# Litton Model 419

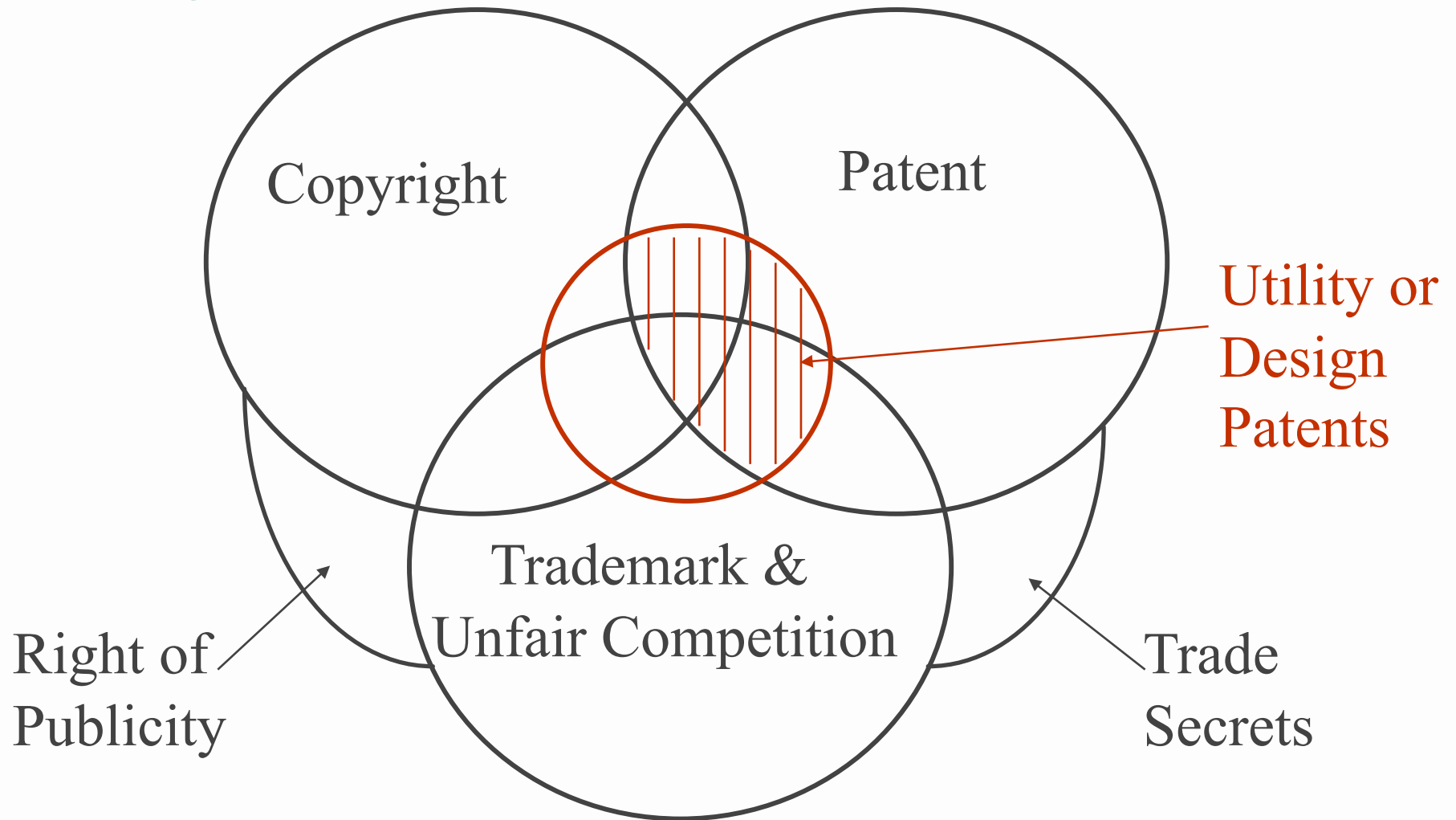




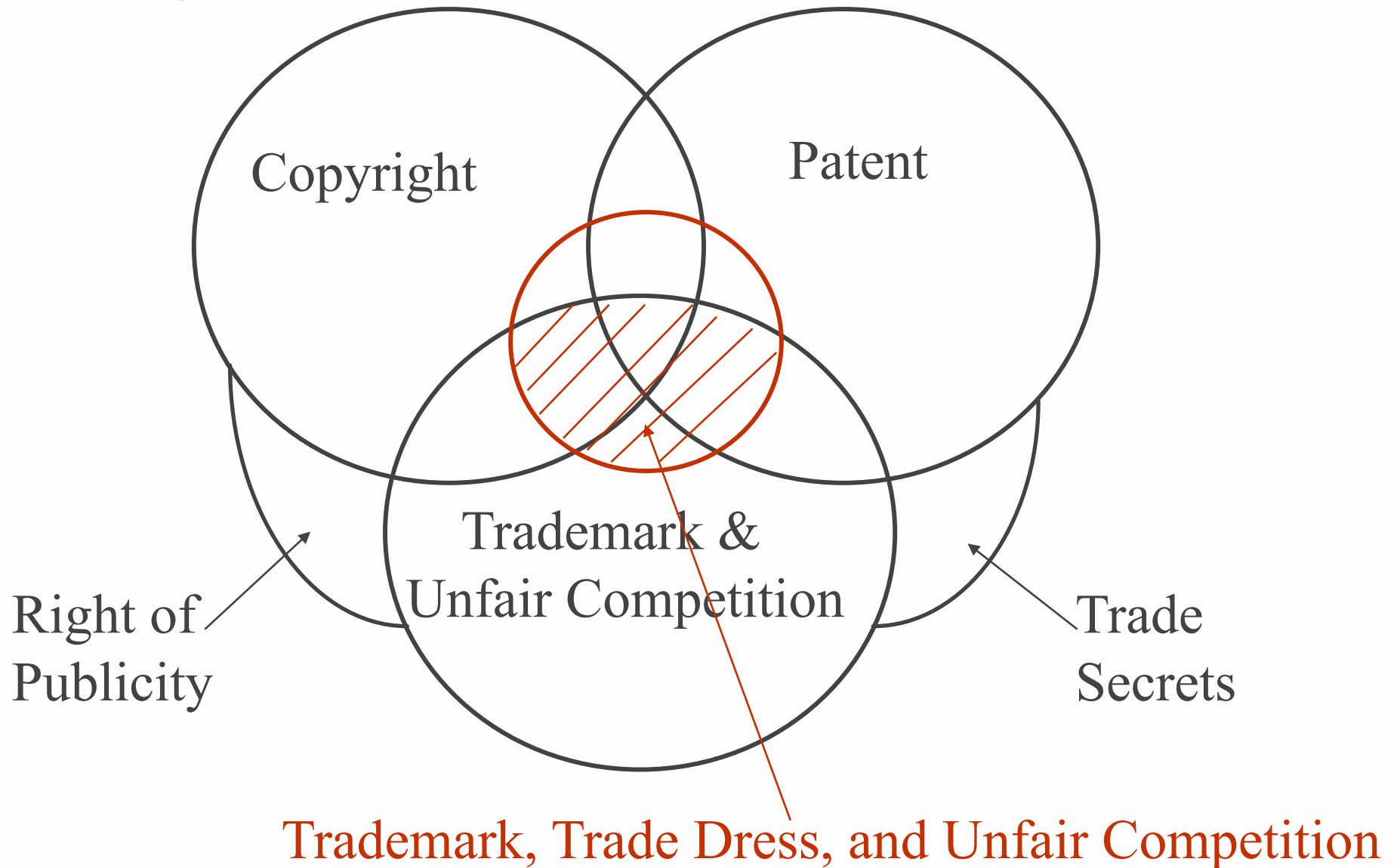
# Whirlpool Model 7600



# Intellectual Property Protection for Industrial Designs



# Intellectual Property Protection for Industrial Designs





# Registrability of ID as a Trademark

- ☞ Permissible trademarks include "any word, name, symbol, or device, or any combination thereof" that is used to identify or distinguish one's goods
- ☞ Either:
  - currently used by a person
  - or a person has a bona fide intention to use it in commerce and applies for registration

# Trademark may extend to (e.g.):

- ☛ containers (e.g., design of a wine decanter)
- ☛ colors
- ☛ shapes (e.g., faucet and handle)
- ☛ (drawings of) Superman dolls

# Trademark may extend to (e.g.):

☛ containers (e.g., design of a wine decanter)

☛ colors

☛ shapes (e.g., faucet and handle)

☛ (drawings of) Superman dolls

# Trade Dress Protection for ID

- ☞ Trade dress extends to product configurations
- ☞ Design must be distinctive
  - Now requires secondary meaning (*Walmart*)
- ☞ Design features must be nonfunctional
  - utilitarian functionality is always a bar
  - aesthetic functionality is sometimes a bar
- ☞ Likelihood-of-confusion test
  - point of purchase limitation?

# Aesthetic Functionality

Pagliario (CA9):

“If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright. On the other hand, where the feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product, imitation may be forbidden where the requisite showing of secondary meaning is made.”

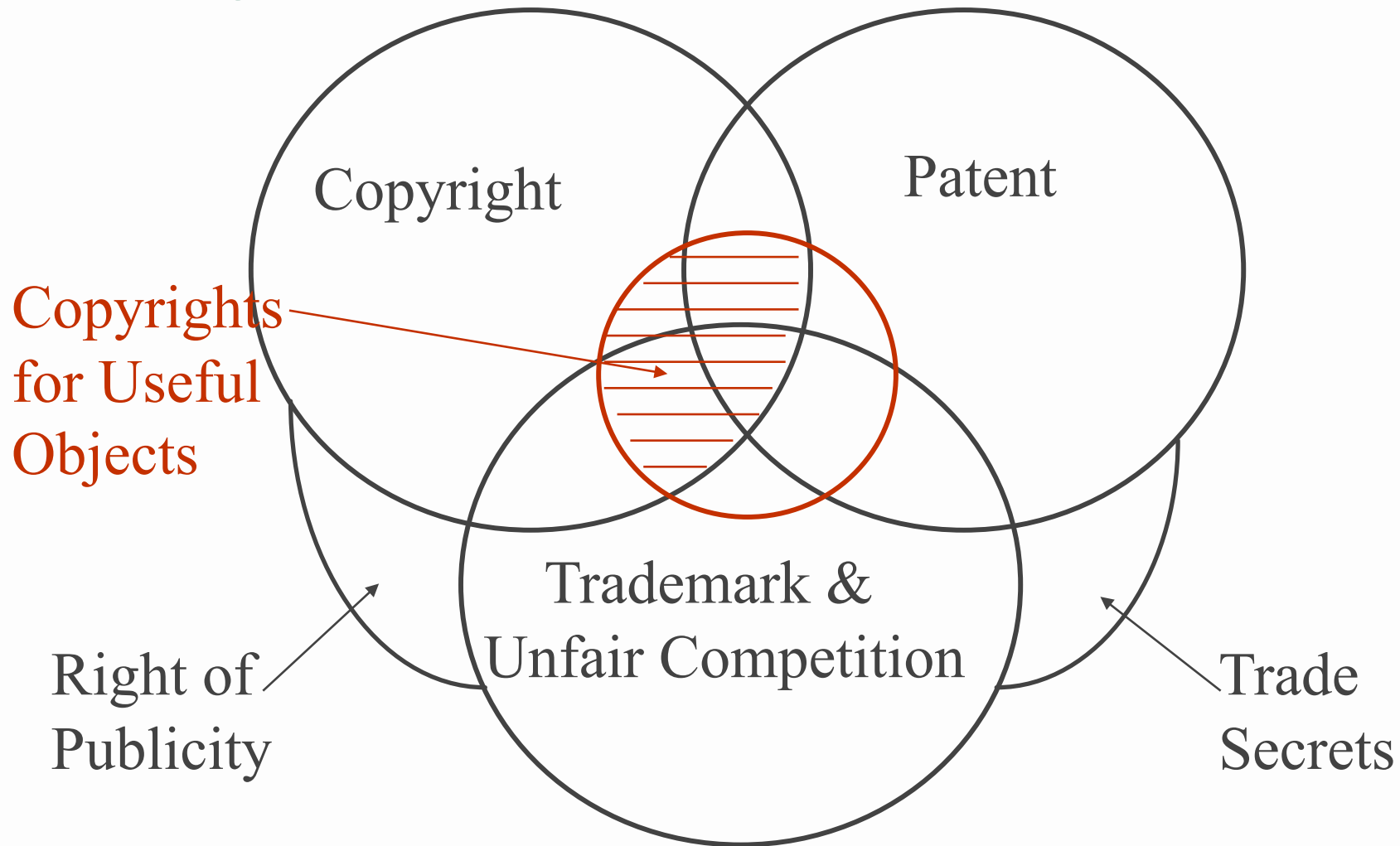
# Posner's Definition of Functionality (Rogers v. Keene)

**[T]he jury has to determine whether the feature for which trademark protection is sought is something that other producers of the product in question would have to have as part of the product in order to be able to compete effectively in the market -- in other words, in order to give consumers the benefits of a competitive market -- or whether it is the kind of merely incidental feature which gives the brand some individual distinction but which producers of competing brands can readily do without. A feature can be functional not only because it helps the product achieve the objective for which the product would be valued by a person indifferent to matters of taste, charm, elegance, and beauty, but also because it makes the product more pleasing to people not indifferent to such things. But the fact that people like the feature does not by itself prevent the manufacturer from being able to use it as his trademark. He is prevented only if the feature is functional ... that is, only if without it other producers of the product could not compete effectively.**

# Likelihood of Confusion -- factors

- ☞ Strength of the mark
- ☞ Similarity of the marks
- ☞ Proximity of the products
- ☞ Quality of the products
- ☞ Likelihood of “bridging the gap”
- ☞ Actual confusion
- ☞ Good faith
- ☞ Sophistication of buyers

# Intellectual Property Protection for Industrial Designs





# History of Copyrightability of Useful Objects

- ☞ 1870: statute reaches 3-dimensional “fine art”
- ☞ *Bleistein* (1903): expansive, relativist conception of art
- ☞ 1909: statute reaches “works of art, models, or designs for works of art”
- ☞ 1910-1948: Copyright Office construes narrowly
- ☞ Regulation §202.8 (1948): works of art “include works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned”
- ☞ Mazer (1954): uphold §202.8
- ☞ 1959: Copyright Office adopts §202.10(c), incorporating separability principle
- ☞ Courts develop concepts of physical and conceptual separability

# Copyrightability of “Useful Articles”

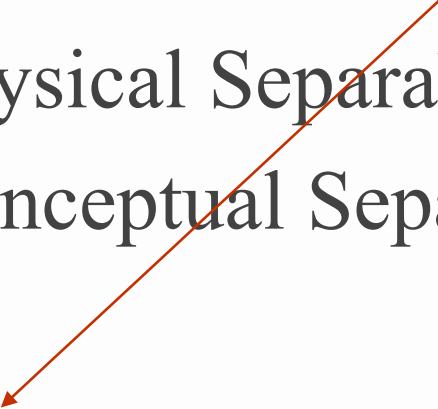
## -- Current Doctrine

- ☞ Special rules applicable to three-dimensional useful objects
- ☞ Physical Separability Test
- ☞ Conceptual Separability Test

# Copyrightability of “Useful Articles”

## -- Current Doctrine

- ☞ Special rules applicable to three-dimensional useful objects
- ☞ Physical Separability Test
- ☞ Conceptual Separability Test



An article that has an intrinsic utilitarian function other than:  
--conveying information;  
--portraying the appearance of the article itself  
§101

# Useful articles

- 👉 Human mannequin?
- 👉 Fish mannequin?
- 👉 Animal mannequin?
- 👉 Mask?
- 👉 Costume?
- 👉 Toy airplane?

# Useful articles

- ☞ Human mannequin? – yes (*Carol Barnhart* [CA2 1985])
- ☞ Fish mannequin? – no (*Hart* [CA2 1996])
- ☞ Animal mannequin? – no (*Superior Form* [CA4 1996])
- ☞ Mask? – no (*Masquerade* [CA3 1990])
- ☞ Costume? – yes (*Whimsicality* [SDNY 1998])
- ☞ Toy airplane? – no (*Gay Toys* [CA6 1983])

# Interpretations of Conceptual Separability

1. Is form dictated by function? (Barnhart)
2. Is the primary use of the article utilitarian?
3. Is the aesthetically pleasing aspect of the article primary? (Keiselstein Cord)
4. Market test (Nimmer)
5. Is the object beautiful?
6. Temporal Displacement Test (Newman)
7. Temporal Displacement + added appeal (Polakov)
8. Intent of the creator (Denicola; Brandir; Pivot)
9. Stand on its own as work of art (Goldstein; Kanne)

# Factors to Ascertain Temporal Displacement

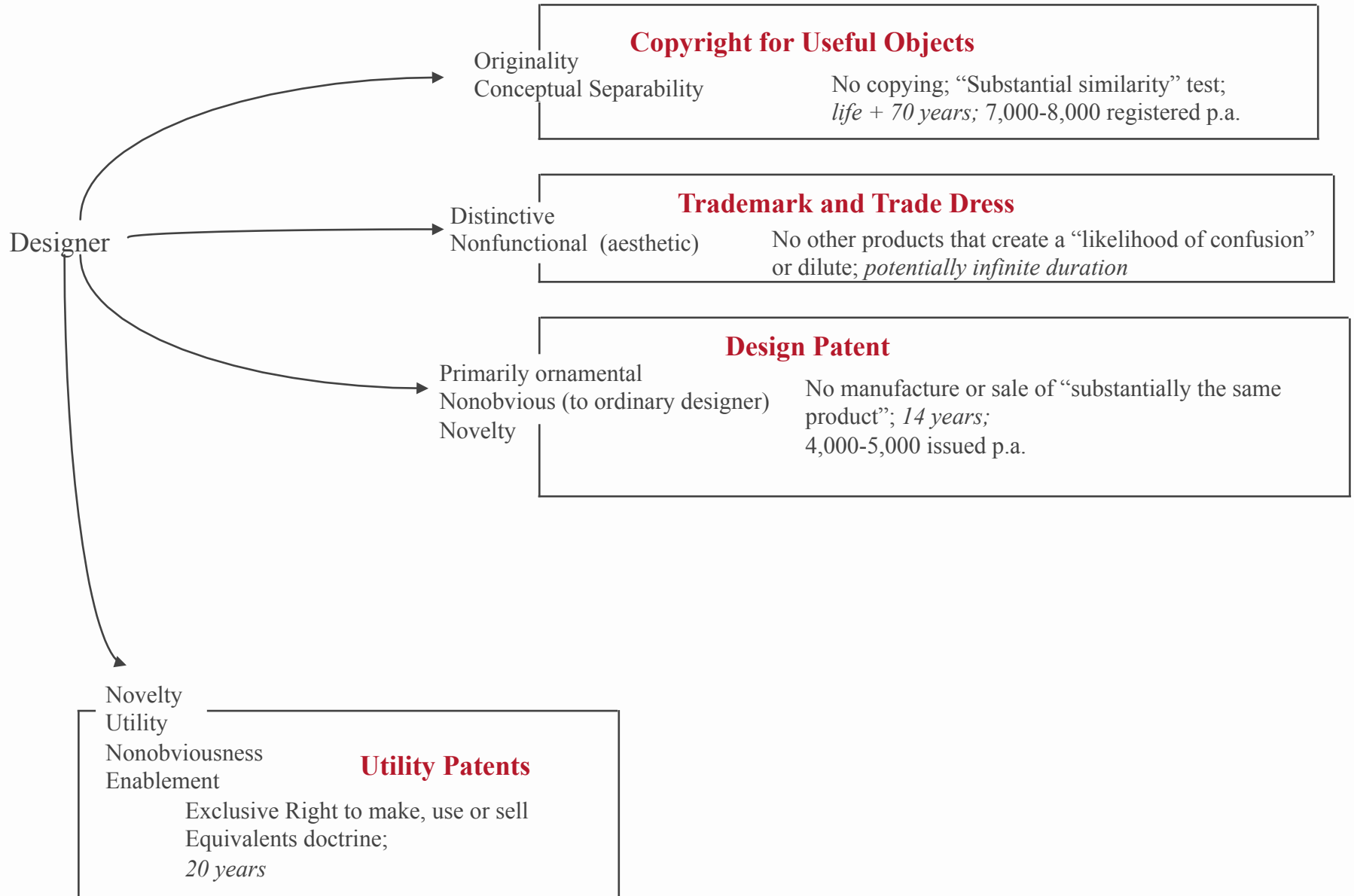
- ☞ Object been displayed or used apart from utilitarian function?
- ☞ Extent of such display?
- ☞ Did such displays result from purchases?
- ☞ Expert Opinion
- ☞ Surveys

# How define art?

☞ One possibility = Coleridge: Art subsists “in simultaneous intuition of the relation of parts, each to each and of all to a whole: exciting an immediate and absolute complacency, without intervenence, therefore, of any interest, sensual or intellectual”



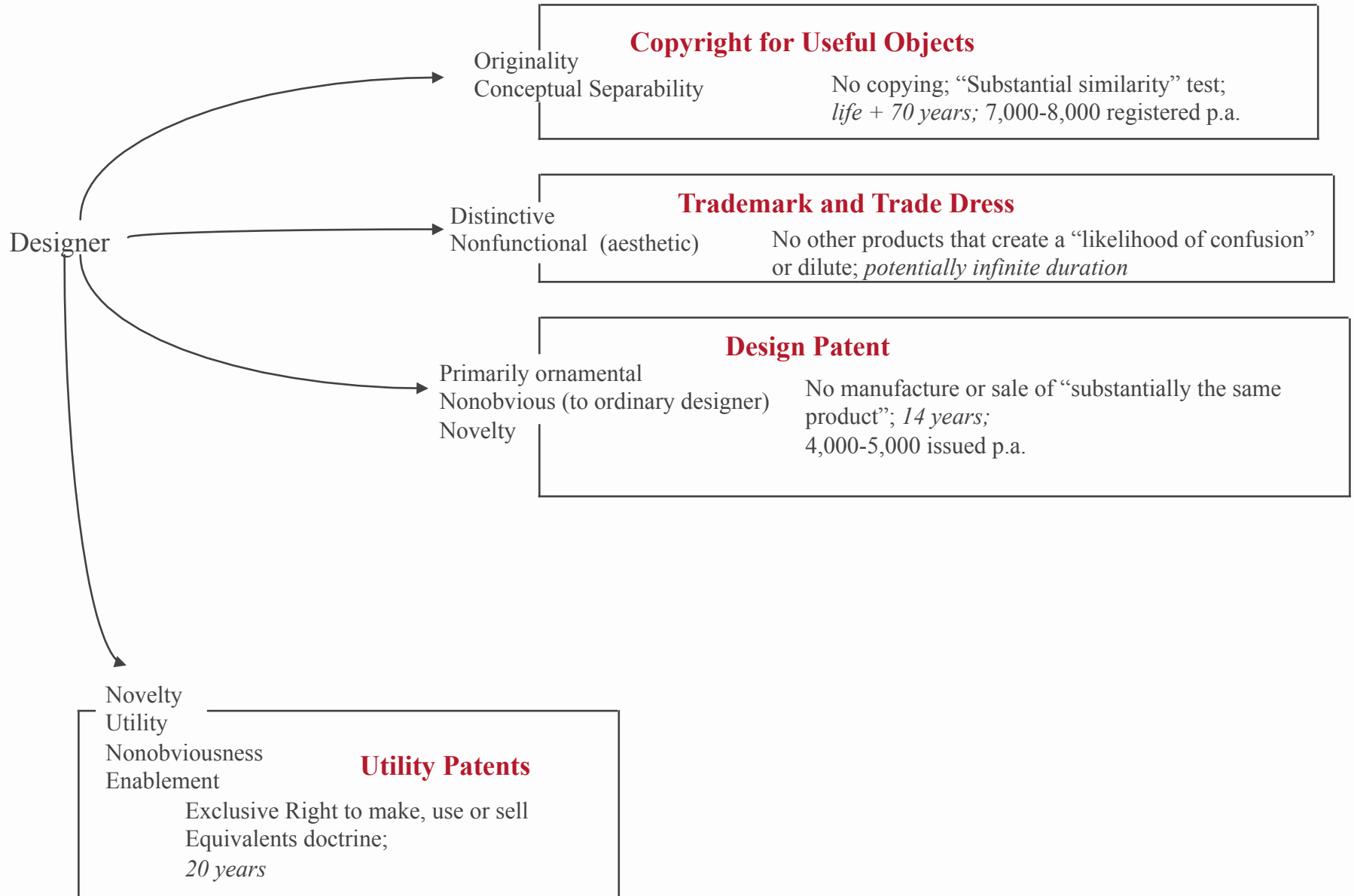
# Current Forms of Protection for Industrial Designs



## Mutually Exclusive?

- ☞ If you have a copyright, you can still get a design patent (*Yardley* 1974) or trademark or trade dress protection
- ☞ If you have a design patent, Copyright Office will not register a copyright (37 CFR 202.10(a))
- ☞ Expiration of Design Patent does not prevent trademark registration (*Mogen* 1964)
- ☞ An expired Utility Patent makes it very difficult to show nonfunctionality for trade dress protection (*Traffix* 2001)

# Current Forms of Protection for Industrial Designs



# Possible Forms of Protection for Industrial Designs

