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Inventions and Patents  
December 19, 2005

### **The Difficulty of Protecting Design**

People feel an innate right to their own property. Indeed, the moral and religious prohibition, “Thou shalt not steal,” demonstrates society’s sentiment toward ownership. This feeling, however, can be less clear for intangible “intellectual property.” Historically, people have felt more strongly for their own belongings than for ideas or inventions; however, the authors of the United States Constitution had the foresight to recognize the great value of intellectual property. Located just following the vital provision for the establishment of the post office, Article 1, Section 8, Clause 8 of the U.S. Constitution outlines our commitment to intellectual property rights:

*To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.*

Although the constitutional emphasis on intellectual property rights may seem to provide for ownership for the sake of ownership, we can see that the authors had a grander purpose. The clause “To promote the progress of science and useful arts” suggests that the purpose of these exclusive rights is to promote entrepreneurship and industrial development. Thus, we see that we must balance the proprietary rights of the creator with the benefit that society can gain from the use of their intellectual property. We have dealt with this issue by defining different areas of protection, divided by subject matter as it corresponds to social value. Patents, copyrights and trademarks offer varying amounts of protection to what we have defined as different types of

intellectual property. The protection of designs, however, presents a sticky situation for our current system. For which form or forms of protection does a novel design qualify?

By examining the design of the current system, one can understand the motivation for the division of intellectual property areas. The United States Code (U.S.C.) describes these different areas in detail. First, patents protect the type of intellectual property that may come to mind most easily: inventions. 35 U.S.C. § 101 describes the types of inventions that can be patented:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

From this description, we distill the requirements for protection that are common to all intellectual property, as well as those factors that are unique to patents.

We see that, in order for the US Patent and Trademark office to deem an invention patentable, it must be new (and non-obvious, as described in 35 U.S.C. § 103.), as well as useful. The requirement that an invention be useful may seem unimportant to anyone who considers the patent system simply to be a way to put their name on an invention; however, the framers of the Constitution as well as the authors of the patent statute have recognized that usefulness is key to promoting entrepreneurship. Unless an invention is useful, it will have no profitable function in the marketplace. To see this, we can consider a patent to be like a contract between the government and the inventor. In exchange for the inventor's creating a useful invention that may spawn successful entrepreneurship, the government will protect the exclusive rights of the inventor. The government is not interested in protecting a useless invention. What would be the societal benefit to doing so?

When determining the term of protection given to a patent, the government evaluates a central tradeoff between the owner's proprietary rights and the usefulness of that invention's

being in the public domain. The highly commercial nature of the patent statute demonstrates just how valuable this type of intellectual property is to owners of the rights. Thus, we can understand how the term of patent protection can be just twenty years from the date of issuance. This term provides ample incentive for the inventor to develop and market his or her invention, perhaps creating a viable and thriving business. The limits to the term provide both the transfer of benefit to the public domain after the term has expired, as well as avoidance of unfair monopolies.

A second section that our system describes for intellectual property describes the protection afforded by copyrights. 17 U.S.C. § 102 describes the subject matter covered by a copyright:

*Copyright protection subsists... in original works of authorship fixed in any tangible medium of expression... Works of authorship include the following categories: (1) literary works; (2) musical works... (5) pictorial, graphic, and sculptural works*

We can see that copyrights differ from patents in that they do not protect the useful arts.

Copyrights cover literary, musical, dramatic, and artistic works, and need not be marketable in any way for the government to issue a copyright. We can see that the contract here is different between the government and the author. The copyright's function is much closer to simply putting one's name on a creation. The government does not consider this intellectual property to be of great economic value, so the copyright statute is laid out in a much more altruistic way. The term of protection supports this conclusion, as most copyrights are valid for the life of the author, and an additional seventy years.

Trademarks represent a third section of our intellectual property system. Trademarks are generally symbols, words, phrases, pictures, or designs that distinguishes the products of one company from all others. 15 U.S.C. § 1051 outlines the subject matter protected by a trademark:

*The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee...*

From this brief definition, one may discount the importance of trademarks; however, in rare cases, trademarks can represent more than half of a company's assets. For example, the Coca Cola trademark is an invaluable one to the parent company. The brand loyalty shown by consumers, as well as the familiarity with the Coca Cola trademark worldwide, make it an extremely valuable item of intellectual property. One can also see that there is little value to restricting the term provided to the holder of a trademark. If the government wishes to increase economic value, as we assume it does, there would be very little reason to return a trademark to the public domain. Thus, the term of a trademark is ten years, but can be renewed many times.

The divisions present in our system seem to function logically, emphasizing the commercial nature of patents and providing the shortest term to inventions that would benefit society if they were in the public domain. The extended protection available to copyrights and trademarks also seem an efficient policy, due to the economic value derived from leaving these types of intellectual property in the hands of the author or creator. Unfortunately, not all types of intellectual property fit neatly into these three boxes. The broad category of designs offers a challenge: Which types of protections cover designs, and why do we use these types over others?

To select the proper protection for a design, we must examine the value to the author of the protection, as well as the value to society of having it in the public domain. This evaluation, however, is not always easy, and I believe that the framers of our system have struggled with this issue. The way our system currently functions, any one of the three types of protections can protect a design, depending on its use. However, examples of these protections in action beg the question, is the value of a lamp that looks like a palm tree really so different from a sculpture of a palm tree? Or from a very similar logo of a palm tree on a shirt? By examining the different

types of protections offered to designs, we can see what the US system is attempting to do with this tricky issue.

The protection for design afforded by trademark is the clearest of the three types. There is no “design trademark” category, as we will see with patents. The general definition of trademark already encompasses designs that identify the product as made by a certain company. Thus, a trademark can exist for a new design for a bottle, as it does for the distinctive Coca Cola bottle. The protection given to this bottle is intended to prevent confusion on the part of the consumer in recognizing proprietary designs.

The issue becomes much fuzzier when we examine copyrights for designs and design patents. As one might expect, copyrights for designs generally provide protection to artistic portions of the article. 17 U.S.C. § 1301 describes the designs protected by copyrights:

*The 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...*

The term provided by the copyright is ten years, and is not renewable. This limited term stands in stark contrast to the “life of the author plus seventy years” that copyrights usually feature.

Design patents exist as section of patent protection that is entirely separate from utility patents. Section 35 U.S.C. § 171 describes the designs covered by design patents:

*Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title*

Patent protection is given for fourteen years to designs that are inseparable from the article itself, and such articles must be articles of manufacture.

These definitions of design copyrights and patents both cover aesthetic features of articles, and the distinction between them can be slight. A copyright can be given to a utilitarian article, but only if the design can exist independent of the article. If it is an inseparable feature of

the article, then a design patent must be used for protection. Interestingly, even the copyright statute reflects the confusion that these slight distinctions cause. 17 U.S.C. § 1329, entitled “Relation to design patent law,” states:

*The issuance of a design patent under title 35, United States Code, for an original design for an article of manufacture shall terminate any protection of the original design under this chapter.*

If there was not misunderstanding between the subject matter covered by design patents and copyrights, why would one ever see both the copyright office and the patent office convinced of the validity of a single design’s protection requests? This organizational difficulty forms the main reason for my proposal: the design patent section of the USPTO should be combined with design copyrights, and both should be issued by the copyright office.

What would be some of the results of placing those designs that formerly qualified as design patents under the administration of the copyright office? First, no confusion would exist as to which type of application would apply to an aesthetic feature of an article. Any such application would go through the copyright office, and would be subject to ten years of protection. The current term of fourteen years for design patents is not radically different from ten, and therefore we should see no great economic effects. Additionally, the divide in motivation for protection between patents and copyrights, as examined before, does not exist nearly as much for designs. Thus, our system would not suffer for the combination of the two sections.

The benefits to an organized system are practical, as well as theoretical. Practically speaking, this change would decrease the workload of the currently backlogged USPTO. Although design patents are much shorter than utility patents, the overworked and under-funded patent examiners must still put some effort into these applications. Thus, I believe that this

switch would increase the efficiency of the USPTO, which is an office that could use anything to make life easier.

The divisions in our system between patent, copyright and trademark exist for real economic and practical reasons; however, the area of designs complicates these distinctions. The protection afforded to designs by trademarks stands firmly on its own, due to the function of the trademark as identifying the product as made by a certain company. The distinction between design patents and copyrights, however, brings to mind a dashed line that comes close to disappearing altogether in certain instances. In the interest of efficiency, I suggest that the design copyright section of the copyright office take control of the issuance and administration of the patent section of the USPTO.

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