RECONCEPTUALIZING PROPERTY IN DESIGNS

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I. INTRODUCTION

Over the last decade the significance of design has grown immensely across the world. Design has become a highly conspicuous part of visual culture. Design consultancies have become an essential part of the manufacturing process and, as a result, a variety of industries are making huge investments in designs. Individual designers, such as Phillip Starck and Gianni Versace, have become business and cultural superstars. Design has become much more than superficial styling concerned with surface appearance, but rather integrates technology, aesthetics and social values, and affects industrial objects, images, and even services. Thus, design has become the new art of industrial and

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... technological culture. Nevertheless, in the United States, industrial design law is completely stagnant, while other intellectual property fields are constantly developing to adapt to ongoing technological and cultural developments. This article aims to bring industrial design back into legal discourse by proposing a new dynamic and a scheme relatively easy to implement, while offering design protection that corresponds to their nature.

A design is hard to define but is easily described. A simple description of a design would be the aspects of a product’s appearance. The character of a design, then, is concerned with external appearance of articles. In emphasizing a product's appearance as the goal of design, aesthetic rather than technical and functional goals are stressed. It is clear, therefore, that a design is a creation of similar nature to artistic works in general, whose boundary lines are hard to draw. Nevertheless, designs have a different nature from a pure imaginary work of art, since it is also dictated by features stemming from function, technology and fashion. This difference raises several questions. How should designs be treated: as artistic works or as technological innovations? Should, and on what grounds, we differentiate between types of functional-artistic works? These questions demonstrate the yet unresolved nexus of art and industry in the intellectual property world.

Industrial design is situated at the crossroads of art, technology, and the entire industry dedicated to attracting the consumer’s attention. Thus, legally speaking, design suffers from a hybrid nature since it has much in common with the three major

1 See Australian Law Reform Commission, supra note 1, ¶ 2.15.
2 Richard Buchanan & Victor Margolin, Introduction, in DISCOVERING DESIGN, EXPLORATIONS IN DESIGN STUDIES xvi-xvii (Richard Buchanan & Victor Margolin eds.,

4 See Buchanan & Margolin – Introduction, supra note 2, at x (indicating designers would define design as the "conception and planning" of all the products made by human beings).
5 Design is concerned with what an article looks like and not with how the article performs in function. See KEVIN BARNETT ET AL., COOPERING AND SYNE JAMES ON COPYRIGHT 713 (2005) (hereinafter COOPERING); JOHN HESSELT, INDUSTRIAL DESIGN 177 (1993) ("Following the widespread development of mass-production, purely visual aspects of design came to predominance as the means of attracting consumers.").
6 See STEPHEN P. LADAS, II PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 829 (Harvard Univ. Press 1975). Defining artistic or creative activity involves multidisciplinary inquiries into areas such as psychology, sociology and philosophy, and is thus beyond the scope of this article. Here, I shall refer to the dichotomy between artistic-creative activity versus scientific/innovative as is common in the legal intellectual property ("IP") realm.
7 See COOPERING, supra note 5, 713; HESSELT, supra note 5, at 10 ("[I]ndustrial design is a process of creation, invention and definition separated from the means of production, involving an eventual synthesis of contributory and often conflicting factors into a concept of three-dimensional form, and its material reality, capable of multiple reproduction by mechanical means.").
intellectual property paradigms – copyright, patent and trademark laws – yet it does not exactly fit any one of them. This mixture of characteristics has caused many difficulties and much debate with respect to the proper treatment of industrial designs. The outcome is a legal zone in the broad intellectual property field, which is poorly regulated as part of the patent paradigm, with an ongoing departure from its basic essence.

This article will re-open the industrial design discourse discussing its exact nature and consequently its proper location in the field of intellectual property. After deciding on the appropriate location for designs in the intellectual property field, I will suggest the exact scheme appropriate for designs, inter alia, by setting a concrete differentiating mechanism from other intellectual property modes of protection.

In Section Two of the article, I will address the definition and function of a design, stressing its important role in enhancing market efficiencies. Throughout this section, I will analyze some contemporary insights with respect to the essence of design. This section will be concluded by the need to acknowledge a right protecting designs from imitation per se, thus encouraging investments in designing activity.

In Section Three, I set down the doctrinal basis for my principal analysis by describing the triple protection designs enjoy in the U.S., through all three major intellectual property disciplines: copyright, patent and trademark. A closer inspection reveals that designs enjoy very limited protection by means of these three disciplines, since they do not fit exactly within each realm. The outcome is inappropriate and inadequate protection for designs. A review of the protection of design in international law reveals that the protection in the international law suffers from the same basic problem with respect to national design law: since there are difficulties in locating the subject matter in the intellectual property world, there is no international consensus with respect to the proper treatment of design.

Sections Four and Five comprise the heart of the article. In these sections, I begin a detailed analysis of design’s appropriate position on the intellectual property map. This analysis promotes a better understanding of design’s nature, and consequently, a design’s market needs. My conclusion is that design does not fit the patent paradigm; instead, its appropriate location is with the copyright paradigm, although not with positive copyright law. Designs should enjoy a specially accorded law – a sui generis law –

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9 See COPINGER, supra note 5, at 715-16; JAMES LAHORE, COPYRIGHT AND DESIGNS §§ 64,605 (1996).

8 There were several attempts in the past to enact such a law in the United States. Briggs claims that various types of design legislation have been introduced in Congress at least 88 times since 1914. See Briggs, supra note 1, at 201 n.292.


11 For example, the "Popeye The Sailor" figure was first created as part of an advertisement, which is a copyrighted work, and only later on, after realizing its attraction, was commercialized into dolls and other useful objects. See King Features Syndicate, Inc. v. O & M Kleeman Ltd., [1941] A.C. 417 (H.L.) (U.K.).
design law.

2. WHAT IS A DESIGN, AND WHAT FUNCTIONS DOES IT SERVE?

In the vast mass of scholarly writings in the realm of intellectual property, there is a remarkable absence of a significant discourse with respect to design law. This lack of scholarly work does not mean that designs do not have tremendous value to industries; on the contrary, enormous amounts of money are invested in industrial design, it plays a major role in industry, and design presents and affects current social and cultural value.

In order to present my insights with respect to the appropriate legal treatment of designs, I briefly describe what a design is and what functions it serves. Industrial designs first emerged in the nineteenth century, with the Industrial Revolution. As the costs of production of goods dropped, the foundations of the current "consumer society" were laid: supply grew, competition was created, and producers had to attract consumers by improving the quality and appeal of their merchandise. This historical process led to the development of a new profession, that of "art-workers," whose job it was to adapt the artistic skills of the old-world fine-arts realm into the service of modern consumer society, including the artistic shaping of industrialized merchandise. In the twentieth century there were further developments in conceptualizing designs, as art and industry merged, and the designer began to be seen as an artist in his own right. In response, social definitions strengthened the differentiation between implicitly lower-class artisans and implicitly upper-class artists, with the former in charge of utility

28 PAUL TORRESI, INTELLECTUAL PROPERTY LAW 361 (Butterworths 3d ed. 2001).
29 See Braegger, supra note 12, at 13.
30 JULES STICK, PRODUCT DIFFERENTIATION IN TERMS OF PACKAGING PRESENTATION, ADVERTISING, TRADE MARKS 67, 101 (Kliewer 1985).
31 UMA SUTHERSAN, DESIGN IN EUROPE 6 (Sweet & Maxwell 2009); Braegger, supra note 12, at 22.
32 Gianfranco Zaccari, Art and Technology, Aesthetic Reflected in DISCOVERING DESIGN: EXPLORATIONS IN DESIGN STUDIES 3, 6-7 (Richard Buchanan & Victor Margolin eds., Univ. of Chicago Press 1995) (explaining that, historically, producers initially focused on the technological aspects of production, but now, recruitment other specialists from the arts, sales, and finance to participate in the product development process); SUTHERSAN, supra note 16, at 6.
33 See SUTHERSAN, supra note 16, at 7.
34 See id. at 12.

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and the latter in control of beauty, or art for art's sake. Oscar Wilde captured this insight by stating: "[a] ll art is quite useless." Wilde's view dominated the nineteenth century, and ran counter to a tradition established much earlier by Horace that good art is "dulce et utile," or instructive and pleasant. The utilitarian emphasis allied craftsmanship, and later mass production techniques, with diminished artistic worth, and these social practices were reflected and enshrined in legislation. The cross-fertilization of high art and design in the past hundred years led to the present questioning of this rationale. Yet the development of a body of law pertaining to design was a long and essentially random process. The problem of defining designed products has remained relevant because the question of whether designs are industrial or artistic property remains unresolved. Even without assigning an appropriate classification on design, there are many utilitarian justifications for commodification of designs and acknowledging their proprietary character, per se.

Investment in product design increases attractiveness and furthers market competition, which enhance the market's efficiency. Investment in product design furthers efficiency by serving customers' benefit in terms of both quality and the aesthetic appearance of the product. By furthering a product's aesthetic appearance, design makes a positive contribution to market efficiency because the product increases the consumer's aesthetic pleasure, aside from its utility. Furthering enjoyment by aesthetic products has a positive value, per se, which enhances public welfare, even if such investment might make the product more expensive. This benefit stemming from advancing design

20 See HESSELT, supra note 5, at 11, 20; BARBARA BLOEMINK, DESIGN + ART: FUNCTIONAL OBJECTS FROM JONAS JUDJ TO RAUL BIRGER (2004), 18-19.
21 OSCAR WILDE, Preface to THE PICTURE OF DORIAN GRAY (1891).
22 HORACE, ARS POETICA II, 343-44 (meaning "useful and sweet").
23 See HESSELT, supra note 5, at 20, 23.
24 See id.
25 See id. at 829-31.
28 This illustration could be described by the following example: if a customer chooses to pay $1,000 for an ornamental belt buckle, it is not because of its function -- to hold one's pants up -- but because of other values served by the product. See PAUL GOLDSTEIN, COPYRIGHT, PRINCIPLES, LAW AND PRACTICE § 25.3(e) (Little, Brown and Co. 1989).
29 If it has also been argued that the investment in industrial design does not further public welfare since it results in a shift of costs to end-customers. For the presentation of such argument, see J.H. Reichman, Design Protections and the Legislative Approach, 55 L. & CONTEMP. PROBS. 281, 292 (1992). See also Robert C. Denicola, Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 MINN. L. REV. 707, 722-23 (1983). This argument is not supported by contemporary microeconomic and price
is also rooted in a socio-economic context which encourages personal preferences of taste, style, etc. As there is room for different flavors of the same foodstuff to suit consumers' likes and dislikes, the same logic applies to other products, such as furniture and fashion.\footnote{See \textit{Zupan, Microeconomics, Theory and Applications} 330-47 (John Wiley \\& Sons 8th ed. 2004); \textit{Steven F. Landsburg, Price Theory and Applications} 107, 189, 195, 202 (South-Western 2005); \textit{Paul A. Samuelson \\& William D. Nordhaus, Microeconomics} 152 (McGraw-Hill Irwin 2005).} In today's consumer society, consumption of goods no longer depends only on necessity, but has multiple sociological and psychological functions. Consumption symbolizes a certain life-style and socio-economic status, but it also serves various goals, such as social equalization, self-identification, etc.\footnote{Opponents of making design rights proprietary contend that the only beneficiary of design protection is whoever commissions the design, not the end-consumer.\footnote{V. See \textit{Stuck, supra note 15, at 4} for the argument, are not justified from a utilitarian point of view.\footnote{The industrial designer's role, it is theory doctrines. These doctrines support the hypothesis that investment in a product's features to further its competitiveness does not necessarily increase the product's prices in the long run, due to competition in the market. See \textit{Edgar K. Browning \\& Mark A. Zupan, Microeconomics, Theory and Applications} 330-47 (John Wiley \\& Sons 8th ed. 2004); \textit{Steven F. Landsburg, Price Theory and Applications} 107, 189, 195, 202 (South-Western 2005); \textit{Paul A. Samuelson \\& William D. Nordhaus, Microeconomics} 152 (McGraw-Hill Irwin 2005).} Therefore, investment which serves other social and human functions does further public welfare.\footnote{See \textit{Stuck, supra note 15, at 4.} See \textit{id. at 6-7, 10-11; Mariette J. De Moor, Consumer Behavior and Culture: Consequences for Global Marketing and Advertising} 100 (2004); \textit{Del I. Hawkins, David L. Mothersbaugh \\& Roger J. Best, Consumer Behavior: Building Marketing Strategy} 822 (2007). Another question is whether the "obsolescence policy," under which designs are changed rapidly in order to make old models seem outdated to increase sales, should be subject to consumer protection regulation. Obsolescence policy is prevalent in fashion and automobile industries and is beyond the scope of this article. See \textit{Stuck, supra note 15, at 11.} See \textit{Stuck, supra note 15, at 10.} For an analysis of the price discrimination mechanism in Intellectual Property markets, see Michael J. Meurer, \textit{Price Discrimination, Personal Use and Piracy: Copyright Protection of Digital Works, 45 B.U. L. Rev. 845, 870-71 (1997); Julie E. Cohen, Copyright and the Perfect Copy, 53 Vand. L. Rev. 1799, 1803 (2000).} Opponents of making design rights proprietary contend that the only beneficiary of design protection is whoever commissions the design, not the end-consumer.\footnote{The industrial designer's role, it is theory doctrines. These doctrines support the hypothesis that investment in a product's features to further its competitiveness does not necessarily increase the product's prices in the long run, due to competition in the market. See \textit{Edgar K. Browning \\& Mark A. Zupan, Microeconomics, Theory and Applications} 330-47 (John Wiley \\& Sons 8th ed. 2004); \textit{Steven F. Landsburg, Price Theory and Applications} 107, 189, 195, 202 (South-Western 2005); \textit{Paul A. Samuelson \\& William D. Nordhaus, Microeconomics} 152 (McGraw-Hill Irwin 2005).} Therefore, investment which serves other social and human functions does further public welfare.\footnote{See \textit{Stuck, supra note 15, at 4.} See \textit{id. at 6-7, 10-11; Mariette J. De Moor, Consumer Behavior and Culture: Consequences for Global Marketing and Advertising} 100 (2004); \textit{Del I. Hawkins, David L. Mothersbaugh \\& Roger J. Best, Consumer Behavior: Building Marketing Strategy} 822 (2007). Another question is whether the "obsolescence policy," under which designs are changed rapidly in order to make old models seem outdated to increase sales, should be subject to consumer protection regulation. Obsolescence policy is prevalent in fashion and automobile industries and is beyond the scope of this article. See \textit{Stuck, supra note 15, at 11.} See \textit{Stuck, supra note 15, at 10.} For an analysis of the price discrimination mechanism in Intellectual Property markets, see Michael J. Meurer, \textit{Price Discrimination, Personal Use and Piracy: Copyright Protection of Digital Works, 45 B.U. L. Rev. 845, 870-71 (1997); Julie E. Cohen, Copyright and the Perfect Copy, 53 Vand. L. Rev. 1799, 1803 (2000).}}


elements of information—from cultural and social values to "objective" attributes—through the product’s appearance—increases market efficiency since it enhances market segmentation and makes the consuming process short and satisfactory. The social, cultural, and political impact of design on consumer society is well known and hard to overstate. There is vast scholarly research on consumer behavior and the sociological effects of consumption on self-concept and cultural identity, which in turn further both market efficiency and other cultural goals.

As to product quality, the role of design in furthering the public’s welfare is profound since the differentiation of products involves the physical and intrinsic change of their appearance, in matters such as size, weight, form, and material, which might have as goals comfort and suitability to meet personal needs and individual requirements. The differentiation accomplished by design to increase sales may also increase the product’s functional quality, beyond just appealing to buyers’ personal aesthetic preferences. Nevertheless, the aesthetic pleasure in a product is in and of itself a utilitarian value, and hovers between objective, functional benefit and non-objective, personal sensory benefit. Thus, the dichotomy between the two qualities, the functional and the aesthetic, soon breaks down and is further challengeable, since functional, utilitarian features are themselves subject to a dynamic socio-economic and cultural context. Design asks first for whom the product is intended, then determines the appropriate features for his or her socio-economic cohort.

In other words, the utilitarian justification for design as an incentive to invest in a product’s appearance is concerned with furthering both quality and aesthetics equally.

To conclude, design satisfies the needs and desires of heterogeneous consumers. Accordingly, design may be defined as both a result of human imaginative endeavor in contrast to the purely mechanistic, but guided also by certain inherent features, such as technology, function, and fashion.

Design provides benefits similar to those derived from other forms of creative and intellectual effort. Like these forms of effort, design deserves the protection given to intellectual property in general. The legal explanations justifying the protection afforded to other forms of effort apply equally to design. It is broadly accepted that there is a need to create incentives to invest in innovative intangible values, and a complementary need to avoid parasitic behavior, which undermines incentive to investments. However, along with the basic justification for proprietary rights, design law differs from the general problem of intellectual property rights, which is the need to fine-tune the right’s scope to prevent superfluous incentives and to balance competing interests. Therefore, we must now look at how current positive law protects design, and whether such protection is appropriate.

products from the kitchen and the office to the hospital and the warehouse, shaping these to fit their customers and to make effective use of industrial processes.

See IDSA Report, supra note 1, at 1.

See Reichman, supra note 29, at 999-83; McCARTHY, supra note 39, § 7.9; Australian Law Reform Commission, supra note 1, § 3.3-3.5.

For the limits of economic analysis of intellectual property law and the difficulties to set the accurate "optimum" standard of protection, see James Boyle, A Theory of Law and Information: Copyright, Spheres, Blackmail, and Insider Trading, 80 Cal. L. Rev. 1413, 1435 (1992); Wendy J. Gordon, An Inquiry into the Metrix of Copyright: The Challenges of Consistency, Consent, and Encouragement, 41 Stan. L. Rev. 1435, 1438 (1989); Glynis S. Lynskey, Jr., Reexamining Copyright's Incentives: Access Paradigm, 49 Vand. L. Rev. 485, 606 (1996);

Jeremy Waldron, From Authors to Copyers: Individual Rights and Social Values in Intellectual Property, 68 Chi.-Kent L. Rev. 841, 866-87 (1992). One of the arguments against enactment of a design law in the U.S. is that there is no need to interfere with the current legal situation since the design industry seems to be prosperous. See Kal Raustiala & Christopher Sprigman, The PiracyParadise: Innovation and Intellectual Property in Fashion Design, 92 Va. L. Rev. 1687, 1693, 1699 (2006); A Bill to Provide Protection for Fashion Design; Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary, 109th Cong. 87 (2006) (statement of Christopher Sprigman, Law Professor). Springman’s argument is rhetorical, since in measuring the optimal standard of protection, the loss from free-riding should be included in the calculus.
3. DESIGN PROTECTION IN CURRENT LAW

A. The Location of Design in the Intellectual Property Realm

The different intellectual property laws are distributed over what could be called three main axes: protection of inventions, protection of works, and protection of trademarks.51 These axes could also be described according to the basic protected subject matter: the protection of novel technological ideas; the protection of original expressions; and the protection of reputation.52 At the head of the ideas—innovations axis stands patent law, at the head of the expressions—works axis stands copyright law, and at the head of the trademarks—reputation axis stands trademark law. There are other intellectual property laws that might be located on these three axes, according to the protected subject matter and the kind of right conferred.53 These three axes of the intellectual property field reflect different underpinnings, different legal mechanisms, and different rationales.54 Where exactly in the intellectual property field is design law located and where should it be located? Should overlapping protection be allowed? These questions result from design law standing at the meeting point of all three intellectual property paradigms.55 Design is connected to copyright law because designs are concerned with form and external appearance or shape. It is clear, therefore, that a design is a creation of a similar nature to that of artistic works in general, which are protected by copyright. And design nowadays is already acknowledged as art.

51 See McCARTHY, supra note 30, § 6.6 (providing a simplified chart of the three major Intellectual Property paradigms.) Reichman describes the intellectual property field as a bipartite paradigm, divided between copyright and patent paradigms, while the trademark branch is located with patents because traditionally it was regarded as industrial property, since the launching of the Paris Convention, supra note 10. Yet, according to Reichman, the third paradigm of intellectual property law should be added with trade-secrets law. See JH. Reichman, Legal Hybrids Between the Patent and Copyright Paradigms, 94 Colum. L. Rev. 2429, 2436 (1994). In my view, trademarks reflect a completely distinct paradigm from patents, even if parcelled together in the Paris Convention. As expressed, these laws reflect different underpinnings, different legal mechanisms and different rationales. See infra note 54. Nevertheless, it is clear that trade-secrets reflect a distinct paradigm, a fourth axis however, this issue is not relevant for this article.

52 See id.

53 See supra note 51.


55 See CORNISH & LLEWYN, supra note 39, at 535; Merges et al., supra note 54, at 557; Donald S. Chisum, Chisum on Patents §§ 1.04(5)-(6) (2005); Jerome Gilson, TRADEMARK PROTECTION AND PRACTICE § 2A.10 (2007).

since its boundary lines are notoriously hard to define.56 Patent law affects design because in certain cases, aesthetic and utilitarian qualities merge, which results in a novel, technological idea for the function of the device or article.57 Finally, design is related to trademark law, because in certain cases, the form of the product is a means for identifying the source of goods and distinguishes the original producer from competitors. This function of design is becoming more important today.58 It belongs to the branch of trademark law that deals with “get-up” or “trade dress,” where a product’s physical configuration functions as a trademark.59 Accordingly, countries have adopted various legal means to protect designs.60 As I will explain below, international law embodies the entire spectrum of design protection,61 which entails a dis harmonious international standard, resulting in an even more complicated field of law.62

The intellectual property field is characterized as extremely dynamic and subject to constant expansion. A repeating jurisdiction mechanism may be observed here: new subject-matter arises, which initially eludes existing legal categorizations. The new subject-matter is made to assume a position under the jurisdiction of one of the major intellectual property laws. As time passes and more cases accumulate, it is realized both on the national and the international levels, that the initial choice of law now poses various encumbrances on major law. At this point a new legal hybrid comes into being, usually ending with new sui generis legislation situated on the axis of the major law from which it was transferred.63 This development of intellectual property law, based on hybrids of hybrids of laws, may be viewed as an excessive division of law into pigeonholes, which creates distinctions between essentially similar things.64 However, I believe design demands a distinct pigeonhole. At present, design fits almost all paradigms, but none perfectly. The majority of hybrids being created in intellectual property law are aimed to fill the lacunae between copyright and patent protection, and to strengthen the

56 See supra note 6 and accompanying text. See also McCARTHY, supra note 30, § 6.5; Setdliff, supra note 35, at 61-68.


58 Cornish & Llewelyn conclude that “there is no easy borderline to be drawn between design and trade mark rights.” CORNISH & LLEWYN, supra note 39, at 535. See also McCARTHY, supra note 39, §§ 6.5, 7.25, 7.91; GILSON, supra note 55, § 2A.10.

59 David Ketchin et al., Rerkly’s LAW OF TRADE MARKS AND TRADE NAMES 508-12 (2005); Chisum, supra note 55, § 1.04(5)(e); McCARTHY, supra note 39, § 8.1.

60 See chapter C: The International "No Standard"

61 See infra Section 3.C (discussing the lack of international standard for designs).

62 See CORNISH & LLEWYN, supra note 39, at 536.

63 See Reichman, supra note 52, at 2A.10.

64 See LASA, supra note 6, at 837.
focus on underlying principles. This approach can reduce reliance on complex rules within the major laws. The segmentation and restructuring of intellectual property law to channel design-related legislation into a legal hybrid will eventually clarify and simplify the law.

My proposition, accordingly, which will be explained further in Section Four, is that design law should be located on the copyright axis, albeit by a special sui generis law. In order to support this conclusion, I will briefly outline current design protection in the United States.

B. Current Design Protection in the United States

In the United States, there are currently three major legal paths for protecting industrial designs: copyright law, patent law, and trademark law. The Unfair Competition Tort may have been invoked as well; however, it is significantly barred due to relations between federal and state protections and the preemption rule. While it seems that this triple protection creates excessive protection for designs, as I will explain, each of these paths only partially protects designs. The outcome is that some designs do not have any protection, and since I claim there is an incentive for creating designs, this outcome is inappropriate, resulting in an inadequate level of protection. Such inappropriate legal treatment for designs in U.S. legislation has been described as "extreme" and "irregular."

(1) Copyright Protection

To understand the complicated path of copyright protection for designs in current American law, its legal history must be tracked. One of the results, in the nineteenth century, of the debate about whether designs are industrial or artistic property was the acceptance in American legal discourse that art should be separated from utility. It was not until 1903 that the Supreme

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72 See Australian Law Reform Commission, supra note 1, § 3.63.
77 See Reichman, supra note 29, at 292. See also WILLIAM F. PATRY, PATRYS ON COPYRIGHT § 3:124 (2005).
78 18 U.S.C. §§ 101-104 (1982); see also Carol Barnhart Inc. v. Econ. Cover Corp., 773 F.2d 411, 415 (9th Cir. 1985); Denicola, supra note 29, at 710; Reichman, supra note 71, at 1148-49.
79 See GOLDSMITH, supra note 28, § 2.5.5; Denicola, supra note 29, at 710-11; Reichman, supra note 71, at 1148-49.
80 See Denicola, supra note 29, at 711; Reichman, supra note 71, at 1149-50.
82 See Reichman, supra note 29, at 712.
84 37 C.F.R. § 202.10(c) (1995) (emphasis added); see Denicola, supra note 29, at 715.
Despite the *Mazer* holding, the Copyright Office believed that on principle, copyright should not be extended to commercial industrial design.\(^{87}\) The Office made intensive attempts to introduce such opinions into the legislative agenda, both by influencing the proposed new copyright legislation and by promoting a *sui generis* legislation for design protection.\(^{88}\) The guidelines that the Copyright Office adopted were aimed to read the *Mazer* holding very narrowly in order to prevent the “flood” of copyrighting of applied art which, according to the Office’s ideology, would hinder the enactment of a “proper” special design law.\(^{89}\) Accordingly, on the eve of the 1976 Copyright Act there was an attempt to legislate a *sui generis* law in the United States.\(^{90}\) Under this proposed *sui generis* law, a limited and short-time protection would be offered to industrial designs, based in part on copyright principles.\(^{91}\) This law, however, was withdrawn at the last minute.\(^{92}\) Instead of a separate *sui generis* law for designs, a narrow codification of the *Mazer* holding was enacted.\(^{93}\)

From recent research tracking the legislative history of the 1976 Copyright Law, it seems that the last-minute shelving of the *sui generis* initiative was totally accidental.\(^{94}\) The reason for that accidental shelving is connected to the District Court opinion in *Esquire v. Ringer*,\(^{95}\) which was later reversed on appeal.\(^{96}\) The decision was handed down during the House of Representatives’ sessions, and stated that the Copyright Office’s ideology of limiting the registration of applied art until Congress had passed the *sui generis* design legislation was retracted.\(^{97}\) As a result, the

\(^{87}\) See Demircioğlu, supra note 29, at 171-21. See also PATRY, supra note 70, §§ 3:124-135.  
\(^{88}\) See PATRY, supra note 70, §§ 3:124-135 (describing the Copyright Office’s pivotal role in the development of design law).  
\(^{89}\) The Copyright Office conduct was even called *ultra vires*, since it promoted its own independent ideology that contradicted the Supreme Court holding. PATRY, supra note 70, § 3:132.  
\(^{90}\) See Protection of Ornamental Designs of Useful Articles, S. 22, 94th Cong. (1975).  
\(^{91}\) See id. See also Carol Barnhart, Inc. v. Econ. Cover Corp., 773 F.2d 411 (2d Cir. 1985) (reviewing the history of this bill); GOLDSTEIN, supra note 28, § 2.5.5 n.72; MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08(B)(3) n.117 (2005); Reichman, supra note 81, at 370; Seltiff, supra note 35, at 60-61.  
\(^{92}\) See Protection of Ornamental Designs of Useful Articles, S. 22, 94th Cong. (1976). 
\(^{93}\) This design legislation was deleted from the final Copyright Act by the House of Representatives. See H.R. REP., No. 1476, at 82. See also Carol Barnhart Inc. v. Econ. Cover Corp., 773 F.2d 411, 416-416 (2d Cir. 1985) (reviewing the history of this bill); GOLDSTEIN, supra note 28, § 2.5.5 n.72; NIMMER, supra note 87 at § 2.08(B)(3) n.117 (2005); Reichman, supra note 81, at 370; Seltiff, supra note 35, at 60-61.  
\(^{94}\) See PATRY, supra note 70, § 3:134 (describing the legislative history of the initiative for a *sui generis* design act and the ultimate shelving of the 1976 enactment). See also Demircioğlu, supra note 29, at 270-21; Carol Barnhart Inc., 773 F.2d at 411 (reviewing the historical development of design law in the United States).  
\(^{95}\) See PATRY, supra note 70, § 3:134.  
"the appearance springs truly from the structure, and is a logical expression of it."

This functionalist approach is reflected in the known aphorism "form follows function." However, achieving a visual effect by eliminating ornamentation must not be confused with flogging too consider visual effect entirely. Specifically, functionalism is concerned with aesthetic appearance. Even a flexible application of the "separability" criterion prevents most of the more up-to-date designs from receiving copyright protection. Consequently, in its more extreme phrasings, the "separability" criterion in the United States preserves the theoretical aesthetic perceptions of the Victorian era, in which decoration means additional external embellishment attached to objects.

(2) Patent Protection

Since 1842, patent law may also protect designs. A patent is a right given with respect to invention, subject to registration; and invention, normatively speaking, is a technological idea. In addition to being useful, a patentable invention must meet high thresholds of novelty and non-obviousness on a global level. This begs the question of how to patent a design, since design is based on the aesthetic appearance of a product and not a technological invention.

The historical development of a design patent right in the United States reveals that its purpose was to fill the gap between copyright and patent protection, with the legislative intent of encouraging the decorative arts. To this end, an additional requirement was added to a design patent right, which is "ornamentality" that is not dictated by functional considerations, while the utility requirement that is compulsory with respect to

102 Denicolò, supra note 50, at 740 n.157 (quoting WILLIAM DENNIS CAHN, ENGINEERING PRODUCT DESIGN 157 (Business Books 1969)). See also id. at 740 n.158; GOODSTEIN, supra note 28, § 2.5.2(b); Settiff, supra note 55, at 62.
104 Australian Law Reform Commission, supra note 1, § 2.12.
105 See Nimmer, supra note 87, § 2.06(B)(5) (reviewing the complexities stemming from the conceptual "separability" test, employed by courts).
106 See PATRY, supra note 70, § 3.14 n.16 (offering a somewhat similar critique).
109 Id. at §§ 101-03.
110 See CHISHOLM, supra note 55, § 1.04(1); MERGES ET AL., supra note 54, at 357.
111 35 U.S.C. § 171; Chisholm, supra note 55, at § 1.04(2).

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patents was dropped. Thus, in contrast to "regular" inventions, a patent covering design consists of purely aesthetic features, such as surface ornamentation, although most other patentability requirements are maintained, such as novelty and non-obviousness. The outcome is an industrial property scheme for design, accompanied by all the characteristics attached to the patent scheme: high standard requirements for eligibility, a long and expensive process of registration as a pre-condition for protection, and a strong monopolistic right for a short period (fourteen years).

Design patents protect only the ornamental aspects of the patented design, and not the functional aspects. This outcome poses the same problems as the "separability" measurement in copyright law: it is difficult for courts to distinguish the protectable ornamental aspects from the unprotectable functional aspects of a design product that incorporates both. Consequently, patent design protection does not offer full protection for many contemporary designs, whether due to the inappropriate eligibility requirement, the unsuitable process of registration, or lack of adequate protection for aesthetics merged with function. Since there are two main routes for protecting designs—patent and copyright—the question remains whether protection is cumulative, or whether the designer must choose one of the options. The Maier v. Stein holding did not answer this question, which led to contradictory decisions in lower courts. Nevertheless, in practice the availability of patent protection for
design does not preclude copyright protection; thus, presumably, protection could be received under both statutes.122

(3) Trademark Protection

The third path for protecting designs is through trademark law, or a trade dress claim. Courts approve trademark protection if the design acquires sufficient distinctiveness (secondary meaning) in order to function as a trademark; namely, the design must function as a means to identify the origin of goods.123 Another important requirement for a design's protection as a trademark is that it does not contain functional elements.124 Discussions concerning these two requirements show that when a product's design becomes distinctive and non-functional, the use of this third path has become increasingly popular.125 However, some complications have arisen with the operation of these two requirements with respect to product design and have posed barriers to successful trade dress actions.126 Moreover, trade dress action will not always be available, since the United States Supreme Court has interpreted the term "origin of goods" in the trademark statute (Lanham Act) as referring to the producer of the designed tangible goods, and not the producer of the (potentially) copyrightable or patentable designs that cover or are adhered to the goods.127 Therefore, designers are barred from claming trade dress protection independently of the tangible

122 See GOLSTEIN, supra note 28, § 2.2.3 n. 75.
126 The most significant obstacle for trade dress action is that product design does not enjoy inherent distinctiveness, and therefore it should be presumed that such quality was gained by actual use in the course of time; that is the "secondary meaning" requirement. See Wal-Mart, 529 U.S. at 214; Braigger, supra note 12, at 116-19. Another significant obstacle for trade dress action was the "esthetic functionality" approach. Under this approach, when goods are bought largely for their aesthetic value, their features may be functional because they contribute to the utility and the appearance of an objective for which the goods are intended. See Pagliaro v. Wolfe China Co., 128 F.3d 339, 345 (9th Cir. 1997). See also RESTSTATEMENT (FIRST) OF TORTS § 745 comm. at 1 (1938); Braigger, supra note 12, at 127-20. However, recently the Supreme Court narrowed this doctrine by holding that the aesthetic and the utilitarian functionality must be distinguished. Traffic Devices, Inc., 532 U.S. at 28.
127 Duster Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 57 (2003).

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goods' producer, and consequently trade dress protection does not function as a full substitute for design right protection. Trade dress remains unchanged: protection against misleading customers and not prevention of imitation per se.128

Case law demonstrates that, given the optional overlapping of trademark, copyright, and patent protection, trademark protection for design is not precluded, provided the requirements of non-functionality and distinctiveness are met.129 In these cases, the overlap does not undermine the balance of design's protection through patent or copyright. The design's protection is not undermined because the purpose is not to tailor the appropriate incentive for creation, as it is in patent and copyright, but rather to protect customers.130 This latter purpose also underlies trademark law, and protection through trademark should be allowed as long as the design is sufficiently distinct and there is a possible misleading use of trade dress.131 Although cumulative protection of design and trademark law is permissible on both theoretical and doctrinal grounds, a series of United States Supreme Court decisions warned against use of trademark law as a broad catch-all federal protection whenever other intellectual property rights are not in force or are unenforceable.132 Trade dress, to conclude, is not the best alternative for design protection, and its excessive use (or rather misuse) only supports the need for a specially tailored solution for designs that would bar imitation per se.

128 See CHISUM, supra note 55, § 1.04(6)(a)(c); see also Fisch, supra note 35, at 71-73.
129 See GILSON, supra note 55, § 2A.10; McCARTHY, supra note 39, § 6.3. See also Duster Corp., 539 U.S. at 33-34. However, some opinion that such overlap might be problematic, since the reputation of the design right owner is free of competition during the term of the design registration. See also RECONCEPTUALIZING PROPERTY IN DESIGNS, supra note 128, at 116-19. Another significant obstacle for trade dress action was the "esthetic functionality" approach. Under this approach, when goods are bought largely for their aesthetic value, their features may be functional because they contribute to the utility and the appearance of an objective for which the goods are intended. See Pagliaro v. Wolfe China Co., 128 F.3d 339, 345 (9th Cir. 1997). See also RESTSTATEMENT (FIRST) OF TORTS § 745 comm. at 1 (1938). See also GILSON, supra note 128, at 127-20. However, recently the Supreme Court narrowed this doctrine by holding that the aesthetic and the utilitarian functionality must be distinguished. Traffic Devices, Inc., 532 U.S. at 28.
A significant change in design protection in United States legislation is found in the Vessel Hull Design Protection Act of 1988 ("VHDPAs"). The VHDPAs define originality to meet the threshold of creative endeavor, based on copyright doctrines, and protect an "original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public." Clearly, this enactment confers a form of sui generis design protection, limited to the realm of boat hulls. The VHDPAs was a response to Bonito Boats, Inc. v. Thunder Craft Boats, Inc., in which the Supreme Court criticized the ineffectual federal protection of designs, while striking down a state law protecting the design of boat hulls on the constitutional grounds of pre-emption. Congress responded to the Bonito Boats holding with an enactment addressing boat hulls, but left the rest of the design realm untouched. Nevertheless, the VHDPAs can be seen as pilot legislation for the change required in U.S. design law, since it incorporates a sui generis law for designs, tailored after the copyright paradigm, by requiring some kind of registration and setting a short term of protection. The hull registration is to be made at the Copyright Office, and it appears to be more of a deposit than a registration which includes examination. The Copyright Office must determine only whether the application "relates to a design which on its face appears to be subject to protection" under the VHDPAs. The Copyright Office is not obligated to compare the design with other registered and known designs. Finally, the statute explicitly states that dual protection by design patent and under the VHDPAs is foreclosed. However, a different provision leaves open the possibility of cumulative protection on other bases, such as trademark and unfair competition laws. These developments, with respect to boat hulls, may be the beginning of a trend creating a quick, low-formality and exclusive copyright kind of protection. This, as will be explained in more detail below, should be levered into a comprehensive new sui generis design law for all designs in the United States.

Aside from the VHDPAs there is one more sui generis form of protection incorporated into the Copyright Act, which is the Semiconductor Chip Protection Act of 1984. This legislation could demonstrate the intellectual property expansion mechanism described above by subdivision into a patchwork of hybrid laws. However, the subject matter referred to in this special provision is slightly different, since although it deals with industrialized articles, it pertains to their functional typeface, or typography, rather than aesthetic appearance. While the VHDPAs remains the major model for future design legislation, the special publication, whether in the U.S. or abroad. See id. at §§ 1502(3)-(11). The total term of protection is ten years. See id. at § 1505.


135 But there are other ways to implement this kind of protection, such as with unfair competition law. See, e.g., William T. Freyer, An Overview of Industrial Design Law Global Development, 10 U. BALT. INT’L PROP. L.J. 63, 66 (2002).

136 For a similar opinion, see Reesvich, supra note 1, at 275-77. The Copyright Office has also recently expressed a similar opinion, according to which the VHDPAs was written in such a way that it could later be amended to cover designs of useful articles in general. . . . Alternatively, it could be amended to cover additional specific types of useful articles. . . . See Hearing on H.R. 3555 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the House Comm. on the Judiciary, 109th Cong. 195, 205 (2006) (statement of the United States Copyright Office) [hereinafter Copyright Office Opinion].


138 See supra note 86 and accompanying text.

139 In U.S. legislation, the integrated circuit is called "mask work," and refers to semiconductor chips. For the definition, see 17 U.S.C. § 901. However, the "definition" doesn’t really define "mask work," it defines the protections extended to such works. See also Nimmer, supra note 87, § 8(A)(1)-12 (explaining the content and scope of this special protection).
protection given to semiconductor chips should be borne in mind in modeling any future design scheme, since it raises the question of protection of functional designs that will have clear and immediate implications on various markets, as in the production of spare parts for mechanical and electrical products, and in the location of such designs in the intellectual property realm.\(^{151}\)

C. The International "No Standard"

On the international level, the three significant instruments, the Berne Convention for Protection of Literary and Artistic Works,\(^{152}\) the Paris Convention of Industrial Property\(^{153}\) and the Agreement on Trade-Related Aspects of Intellectual Property ("TRIPS Agreement"),\(^{154}\) do not compel a paradigm for protection of industrial designs, besides the mere necessity to acknowledge some protection.\(^{155}\) The legal history of each of these international instruments reveals the basic conflict with respect to designs: the difficulty of locating them in the intellectual property realm. The outcome is that there is no compelling international standard, and there exists a disharmonious protection over designs around the globe.\(^{156}\)

During various conferences that followed and amended the 1886 Berne Convention, there was an ongoing debate with respect to designs and their possible location within the copyright branch of intellectual property.\(^{157}\) The result was a decision not to decide, and to allow member states full freedom on the subject.\(^{158}\) Only in 1948 did the parties reach what seems to be the only possible agreement, according to which works of applied art were added to the enumeration of protected works in Article 2(1), and a new article (now Article 2(7)) was adopted, leaving member states the freedom to choose the scope and kind of protection given to applied art. This was the last attempt to introduce harmonized doctrine into the Berne Convention, and the question has not been re-examined since.\(^{159}\) Accordingly, there are different modes for protecting designs in member countries, all in accord with the flexible Berne Convention formula.\(^{160}\)

The debate over the legal paradigm appropriate for designs was also reflected in the Paris Convention launched, similarly to the Berne Convention, at the end of the nineteenth century. The Paris Convention deals with industrial property, mainly patents and trademarks, and establishes international regulation with respect to national registration of intellectual property rights. At the Convention, there was a long debate as to whether designs should be included in this instrument.\(^{161}\) This debate was partly resolved in 1958, when Article 5(5) of the Paris Convention was adopted, according to which "Industrial Designs shall be protected in all the countries of the Union." Notably, the parties agreed only on the obligation to protect designs, without setting any standard with respect to the eligibility or scope of design protection.\(^{162}\) Therefore, once something is identified as an industrial design according to a member state's law, it is protected. However, such protection can be achieved by a wide spectrum of legal means, from copyright, to special design laws assimilated into patent law, to unfair competition law.\(^{163}\) All methods, of course, comply with the Paris Convention's lack of standardization. There are thus two international conventions regulating designs – the Berne and Paris Conventions – and this well-established legal situation shows no sign of changing in the foreseeable future.\(^{164}\)

The TRIPS Agreement also defers the decision concerning

\(^{151}\) See CHISHOLM, supra note 55, § 14.03(4) (discussing protection of spare parts via different legal means, such as utility models or "patentable" in other countries); see also MARTIN HOWE & A.D. RUSSELL-CLARKE, RUSSELL-CLARKE ON INDUSTRIAL DESIGNS 84-87, 257-58 (Sweet & Maxwell 2005); Klaes-Jörger Michaeli, Protection of Industrial Designs: An Overview of German Law, in INDUSTRIAL DESIGN RIGHTS: AN INTERNATIONAL PERSPECTIVE 121, 124 (Brian W. Gray & Efiie Bouzakis, eds., Kluwer Law International 2001); Joseph Struan, Design Protection for Spare Parts Gone in Europe? Proposed Changes to the EC Directive: The Commission's Mandate and Its Undeletable Exclusion, 27 EUR. INTELL. PROP. REV. 391 (2005) (Eng). For more on "spare parts," see infra notes 364-366 and accompanying text.

\(^{152}\) Berne Convention, supra note 10.

\(^{153}\) Paris Convention, supra note 10.

\(^{154}\) TRIPS Agreement, supra note 10.

\(^{155}\) Article 2 (7) of the Berne Convention, supra note 10; Article 5(5) of the Paris Convention, supra note51; Article 25 (1) of the TRIPS Agreement, infra note 10.

\(^{156}\) For a review of the different schemes for designs' protection in different countries, see ANNE MARIE GREENE, DESIGNS AND UTILITY MODELS THROUGHOUT THE WORLD (2007).

\(^{157}\) The French delegates stressed the French doctrine of full acceptance of copyright protection for designs, while the English delegates promoted the English doctrine of full separation between designs and copyright, resulting in no substantive agreement. See SAM WARE, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS 1886-1990, at 271-73 (1987).

\(^{158}\) See id. at 271-73.

\(^{159}\) See id. at 280.


\(^{161}\) There have been different attempts to define what a design is, to establish a mechanism for evaluating the novelty of designs, and to mandate a minimal period of protection. All of these proposals were rejected due to lack of consensus, and therefore these issues remain under the sole jurisdiction of the member states. See id. at 86.

\(^{162}\) See id. at 86. See also COPYRIGHT AND DESIGNS LAW, REPORT OF THE COMMITTEE TO CONSIDER THE LAW ON COPYRIGHT AND DESIGNS, 1977, Cmd. 7038, at 32 [hereinafter WHITTING REPORT].

\(^{163}\) For a similar conclusion, see RICKETSON, supra note 158, at 282.
the scheme of design protection to the individual states, though it
does show a slight movement in the direction of harmonization.
According to the TRIPS Agreement, member states "shall provide
for the protection of independently created industrial designs that
are new or original." The wording "new or original" reflects an
agreement to include both originality from the copyright realm
and novelty from the industrial property field as requirements.
Therefore, again, the TRIPS Agreement does not oblige any
standard of protection, and the spectrum of acceptable rights
allowed by the Paris Convention was preserved. Even a specific
article in the TRIPS Agreement, setting special requirements for
textile designs in terms of cost and duration of obtaining
protection, is not a deviation from the "no standard" in
international law since it stipulates that members are free to meet
this obligation through either copyright or industrial design law.
Finally, the only compelling minimum standard adopted by the
TRIPS Agreement concerns the term of protection, which should
be at least ten years. This means that the only international
harmonization that exists with respect to design protection relates
to the minimum duration of protection, and nothing more than
that.

Another international instrument that should be mentioned
is the Hague Agreement Concerning International Registration of
Industrial Designs, which establishes an international system for
the registration of designs. However, the Hague Agreement says
that contracting parties should comply with the provisions of the
Paris Convention concerning industrial designs. Moreover, the provisions of the Hague Agreement do not effect any greater

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166 TRIPS Agreement, supra note 10, art. 25(1) (permitting members to legislate
different requirements with respect to eligibility).
167 See D. GERVAIS, THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS 212-
18 (Sweet & Maxwell 2005). According to one commentator's view, TRIPS art. 25(1) does
not permit accumulation of requirements and the eligibility standard should be one
or the other, either new or original. Nevertheless, it is clear that both the copyright and patent
standards are permitted with no preference for one system or the other. See GUZMAN &
CARVALHO, THE TRIPS REGIME OF TRADEMARKS AND DESIGNS 402 (Kluwer Law
International 2006).
168 See GERVAIS, supra note 167, at 212-13; CARVALHO, supra note 167, at 395-400.
169 TRIPS Agreement, supra note 10, art. 25(2). This Article addresses the need of the
textiles industry to protect designs quickly given the short time of profits from creation
until end of potential marketing. Therefore, usually in cases when designs are protected
with a patent-like kind of legislation, the industry's needs are not fulfilled. See GERVAIS,
supra note 167, at 213-14.
170 TRIPS Agreement, supra note 10, art. 25(2).
171 Geneva Act of the Hague Agreement of 6 November 1925 Concerning the
International Registration of Industrial Designs art. 14(1), July 9, 1999 (extending the
Hague Agreement Concerning the Deposit of Industrial Designs of 1934, amended in
1960) [Hereinafter Hague Agreement, Geneva Act].
172 Id. at 2(2).
CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS:
DRAFTING HISTORY AND ANALYSIS 23-33 (2005) (thoroughly describing the Hague Agreement and its
formation).
174 Hague Agreement, Geneva Act, supra note 170, art. 14(1); Fidler III, supra note 173,
at 23-33.
175 See SITHERSMANN, supra note 16, at 23; Commission Green Paper on the Legal Protection
of Industrial Designs, (June 1991). For a thorough review of the different design protection
regimes in European nations, see SITHERSMANN, supra note 16, at 113. See also Robin
Davies, European Community Design Law, in INDUSTRIAL DESIGN RIGHTS, AN INTERNATIONAL
PERSPECTIVE 75, 86 (Brian W. Gray & Effie Boulas eds., 2001).
177 Id. arts. 2-5, 9-12; see also SITHERSMANN, supra note 16, at 26-27; RUSSELL-CLARKE,
supra note 151, at 4-5.
178 E.C. Design Directive, supra note 177, art. 16.
179 Id. art. 17.
choice. It is clear, therefore, that the European Design Directive reflects the spirit of compromise. It was described as the fruit of non-consent, which led to an eclectic result, further complicating the legal protection of designs.

4. THE PRINCIPAL QUESTION OF PATENT OR COPYRIGHT PARADIGM

After the long detour into the labyrinth of positive design law comes the principal question: which paradigm of law is more suitable to the design realm – patent or copyright? Furthermore, should designs be protected by existing copyright and patent schemes or should they enjoy a sui generis law, based on the preferred paradigm? I will deal with these questions below. The question of protection under trademark will not be dealt with here since, as stressed above, my assumption is that certain proprietary rights per se should be acknowledged with respect to designs in order to encourage investment in their creation, and trademark protection can in any case be supplementary to the main path elected for protecting designs against imitation per se.

A. The Deficiencies of the Patent Paradigm and Compatibility with the Copyright Paradigm

An ongoing dilemma in this niche of intellectual property law concerns the apt paradigm for designs. I suggest that the copyright paradigm is much more apt for the design realm, however positive copyright law as it stands is not entirely suitable. Therefore, the optimal legal regime is a sui generis law based on the copyright paradigm. The arguments for rejecting the patent paradigm and favoring the copyright paradigm for design are many and varied, from theoretical to practical:

(1) Designing is a Creative not an Inventive Activity – Equal Treatment for Creations

One of the basic differences between copyright and patent lies in the scope of protection: copyright is mainly an anti-copying right and patent is a monopolistic right enabling the holder to exclude use of the subject matter, even when not copied. The questions of the appropriate scope for the different intellectual property rights and what degree of exclusivity is to be vested in them is beyond the scope of this article, but as long as the common differentiation continues between artistic works and technological inventions in terms of the applicable right’s strength, consistency must be kept. Therefore, as I will argue, similar designs should be assimilated to artistic works, the scope of exclusivity should be attached to the works’ expression of ideas on the subject matter axis of the intellectual property zone; otherwise, anomaly is created. Why should designs be assimilated to the work’s subject matter? The answer lies in the justification for acknowledging an intellectual property right with respect to designs, which is to encourage the development of the aesthetic appearance of useful articles. Namely, the fundamental element of incentive to create lies at the basis of the design right. Designing is an activity of human imagination and is of a different order than inventing a technical device or achieving a scientific outcome. Therefore, legally speaking, designing activity should be assimilated to creative endeavors. In this respect, it should be borne in mind that designs are artistic works with some special

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10. For a similar argument, see WHITEFORD REPORT, supra note 164, at 37, 46.
11. For a discussion of justification for designs, see supra Section 2.
12. See COPINGER, supra note 4, at 713.
characteristics, such as their utilitarian functions and their industrial designations; however, designs' basic nature as works of the imagination is that of an artistic work. Accordingly, the usual considerations of time and money needed to create a design are taken to belong to the realm of works and not to that of inventions. Thus, consistency with the perception that an anti-copying right is necessary for encouraging creativity must lead to acknowledging the same right with respect to designs. There is practical evidence that protection against copying is what is needed, and even in a system that favors monopolism, plaintiffs have succeeded in cases of evidential copying.

(2) Designing is a Creative Not an Inventive Activity – The Constitutional Argument

Aside from the simple logic of protecting similar subject matter with a similar right, a constitutional argument could be invoked. The Intellectual Property Clause of the Constitution empowers Congress to legislate copyright and patent laws ""[t]o promote the [p]rogress of [s]cience and the useful [a]rts."" The Supreme Court has interpreted this clause as a mandate to shape law according to utilitarian considerations. Thus, according to a possible constitutional argument, as long as there is no good reason for conferring an excessive scope of protection for designs, in comparison with artistic works, such excessive protection does not comply with the constitutional mandate. In other words, inconsistency by favoring designs (i.e. by conferring a stronger monopolistic right than that of copyright) must be explained in economic or incentive terms. Without an explanation, excessive protection might be challenged as unconstitutional.

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198 See supra note 6 and accompanying text.
199 Nevertheless, as will be explained below, the quid pro quo of lesser protection leads to a longer term of protection that should not be employed with respect to designs.
200 See WHITFORD REPORT, supra note 164, at 37, 43.
201 U.S. CONST. art. I, § 8, cl. 8 ("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").
203 Not surprisingly. I found no such explanation in scholarly writings and legislative records. In contrast, for example, see the Constitutional rational explanation given by the Supreme Court in approving the extension of the copyright term of protection. Eldred v. Ashcroft, 537 U.S. 186, 206-207 (2003) ("In addition to international concerns, Congress passed the CTEA in light of demographic, economic, and technological changes, ... and rationally credited projections that longer terms would encourage copyright holders to invest in the restoration and public distribution of their works").
204 See infra, Section 4.1, The Historical and Structural Reasons for Design's Semi-Patent Protection.
206 For a description of the application process, see MERGES ET AL., supra note 54, at 150-64 (estimating that "[t]he `average' prosecution takes approximately 2.77 years.").
207 For the patent fees, see 35 U.S.C. § 41 (2008). It should be noted, however, that design fees are a little lower. See id. § 41(1)(C)(5). See also COPINGER, supra note 5, at 714 ("[M]onopolies are usually provided under a system of registration which is likely to be expensive and, for many types of design, impractical.
208 For the implicit contract in patent law between the inventor and society, see MERGES ET AL., supra note 54, at 150.
209 See supra note 200.

(3) Patent's Basic Features Are Not Appropriate for Designs

Besides the basic economic and theoretical justification for electing an anti-copying right, rather than a strong monopolistic one for designs on the simple basis of consistency with protection over similar subject matter, the accompanying features of patent law are not suitable for the design subject matter. By this I refer both to the basic eligibility requirement of novelty and non-obviousness and to the long and costly process of registration. Assimilating design protection to patents leads to a system of registration, based upon material examination (prosecution) of the qualification for registration. With respect to technological inventions, this is the basic "bargain": the law confers a strong monopolistic right and in exchange, the inventor reveals an invention that is novel and demonstrates an inventive step on a worldwide scale. Thus, prior to registration of a patent right, a long and stringent examination takes place. Furthermore, this process of registering a patent is costly. Only professionals can write the patent claims and negotiate with the Registrar until final registration, and high registration fees are paid in order to cover the professional expenses of examination. Are these conditions suitable to the designs realm? The answer is clearly negative.

(a) Novelty Standard is not Appropriate for Artistic Features

The high standard of novelty for patents is completely incompatible with design's subject matter. Although the novelty standard of patent law is much more objective than the originality
standard of copyright law, it is nevertheless inappropriate for artistic features. Designs are concerned with the aesthetic appearance of products, and therefore designs are always based on parameters set by the product and prior knowledge. Furthermore, aesthetics are actually concerned with "art." Novelty is an absolute criterion in the sense that a novel subject matter must not have been anticipated by anything previously in existence anywhere and at any time. Thus, a novelty threshold is irrelevant to the assessment of "art." If the aim is to encourage the development of aesthetics in design, then the enforcement of a novelty threshold will mean non-protection over a vast number of designs. Such an outcome clearly misses the purpose of encouraging creative activity with respect to individuating product configuration. Accordingly, in those legal systems in which novelty is indeed a requisite for the eligibility of designs, then practically speaking, such a threshold is being maintained in a subjective manner.

The subjectivity of the novelty requirement in the context of designs is expressed by different means, such as the interpretation given to the requirement of "non-obviousness" in U.S. law, which is part of the novelty assessment. The essence of design is the question of how to make an article more ornamental and attractive, and these qualifications are normative in character and thus more open-ended. For example, how can one tell whether a chair with curved arms is or is not legally different enough from a chair with straight arms, such that it might be regarded as "new"? Any assessment of the obviousness of designs is necessarily subjective, since aesthetics have no intrinsic measurable value. Courts have openly admitted that this is the de facto reality. In other words, the assessment of the qualification of a design under a novelty threshold cannot truly determine its newness, since there is no objective tool for evaluating the differences between two compared ornamental features. Accordingly, de facto, the threshold which is being activated is the "substantial similarity" in the overall appearance between the design in question and the prior work(s) relied upon, to which it is being compared. The term "substantial similarity" is borrowed from the copyright field, and is used for deciding when an alleged reproduction of a copyrighted work does indeed infringe. It has been shown that the substantial similarity measurement in copyright law is based on a judge's personal, subjective assessment.

The subjective nature of the interpretation of the novelty requirement for designs is also reflected in other jurisdictions. For example, in the United Kingdom, a "new" design is defined by law as that which differs from earlier designs in more than "immaterial details" or in features which are variants commonly used in "trade." This criterion of novelty works according to the

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208 Alfred C. Yen, Copyright Opinions and Aesthetic Theory, 71 S. C. L. Rev. 247, 247 (1998). See also Bein & Donaldson, "Reform Commission, supra note 1, § 3.6.4.7. The Australian report also commented that 97% of the design technology Australia uses is not developed in Australia. Id. § 3.7.


210 See Reichman, Legislative Agenda, supra note 25, at 286-87, 291; Australian Law Reform Commission, supra note 1, § 3.6.4.7. The Australian report also commented that 97% of the design technology Australia uses is not developed in Australia. Id. § 3.7.

211 See Reichman, Legislative Agenda, supra note 25, at 286-87, 291; Whitford Report, supra note 164, at 44. See also Briggs, supra note 1, at 176-78 (examining the difficulties that the design industry encounters in applying the rigid patent standards of novelty and non-obviousness with respect to clothing designs).


214 See Chisum, supra note 55, § 1.1.04(2)(b).
“eye of the judge” test, which is far from being an objective or “clear cut” test. The E.C. Design Directive establishes a similar criterion, requiring a design to have an “individual character,” in addition to the novelty requirement. The E.C. Design Directive stipulates in a special provision that a design shall be considered to have an “individual character” if “the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before,” and that “in assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.” This test of “overall impression” is similar to the old English “eye of the judge” test. However, it is refined so that the relevant eye is that of the “informed user.” This refinement means that the threshold is according to a more objective “person skilled in the art” standard, familiar in patent law. Nevertheless, even if the “eye test” is examined through an “informed user/customer” prism, the basic question still relates to the assessment of degree of similarity between aesthetic or ornamental features, which, as I argued above, cannot have a precise and definite resolution.

Another example for the subjectivity actually employed in assessing design eligibility under the novelty requirement is in the limited examination process prior to registration, in which some countries focuses on non-reassemblies with prior already registered designs, and only on a national level. Such an examination is consistent with the acknowledgement that it is impossible to examine true novelty with respect to designs, and therefore, the examination is satisfied with prima facia novelty on a very formal level. Accordingly, the E.C. Design Directive, though adhering to a semi-patent paradigm for design, opted for a sofer deposit system rather than registration after examination.

The inevitable conclusion is that the whole matter of designs fits into the work’s originality assessment, which requires a non-copying threshold (in which high similarity functions as a circumstantial proof of subjective or actual copying), plus a minimal degree of minimal artistic creativity. Below, I further address the “originality” requirement with respect to designs. I also suggest that when the eligibility threshold is reduced, as a matter of consistency with the convention in the intellectual property realm, the scope of the right should be limited accordingly to prevent copying in contrast to full monopoly power.

(b) Registration’s Consequences are not Appropriate for Design Markets

Aside from the fact that the novelty requirement is incompatible with design eligibility, such a high requirement causes a long and costly process of registration, as with patents. However, the process is in itself not appropriate to designed products’ markets, which are often dynamic in nature and characterized by a short life span of the product. Moreover, it has been noted that a significant number of designs are developed by small to medium scale firms. With respect to such businesses, compulsory registration might have a chilling effect due to lack of profitability in investing in the registration process ex-ante. Such businesses may suffer from lack of sufficient legal awareness as to the need to register the design in order to enjoy protection. Therefore, such a rule will be inefficient for such businesses ex-post.

More arguments against a design registration system could be invoked: with respect to registered monopoly-type rights, courts do not grant interim injunctions until the right is registered after examination. Thus, for a significant period of time the alleged owner of a right is “exposed” with no protection. During this period, competitors might exploit the subject matter (invention/design) and only after a grant of right can the
owner/patentee recover damages retroactively.234 This situation is especially unsuitable for the design market, in contrast to patents, because of its dynamic and short life span.235 Thus, for such markets, an automatic grant of right is crucial in order to obtain immediate injunctive relief.236 Without remedy, competitors will enjoy the full period of a product's life, and build their own goodwill and clientele on the design owner's account. All the while, the only relevant relief available to the design owner from the court is retroactive damages. Moreover, assuming that the designs' market comprises mainly of small to medium-sized firms, an additional concern is that such competitors will not be able to pay adequate royalties and other monetary relief retroactively, due to solvency problems.237 Thus, for this kind of market, early preventive relief is crucial.

Other specific characteristics of design justify deviation from the semi-patent registration paradigm. For example, designs are easily copied, and thus registration accompanied by publication might actually harm instead of protect the right holder. This is a well-known phenomenon in the design market.238 Therefore, in some countries, a non-disclosure rule is adopted, according to which the confidentiality of the design "claims" is kept for a certain period of time, while only the "biographical" data of the respective design is published.239 In such a case the purpose of conducting open registration of rights - to increase flow of information in the market and to increase the market's efficiency by preventing competitors from investing time and money in developing the same design - are not achieved. In other words, the quid pro quo of patents is irrelevant to designs in such circumstances, and nevertheless registration is required.240 The main advantage of the design registration system is to function as a means to prove the time of creation, which in due time may serve as evidence to prove or rebut claims of non-originality.241 Such a system, that provides proof of originality, is a welcome addition to the field of applied art. This is because in comparison to other artistic creations (i.e. copyrighted works), it is harder to prove the personal "touch" of the designer because the creation is dictated at least in part by impersonal utilitarian considerations.242 Accepting this as the main purpose of a design registration system means that deposit rather than comprehensive examination suffices: there is no waste of resources, and the designer can market the design immediately after creating it; registration will serve as a means to prove originality, non-copring or prior use. If done under limited-time confidentiality, this will not function as a source for copiers.243 This scheme has been adopted by the E.U. registration system244 and by the Hague International Registration System.245 Furthermore, a deposit system in some jurisdictions is a d e f a c t o legal reality.246

(4) The Historical and Structural Reasons for Design's Semi-Patent Protection

The many enumerated deficiencies of semi-patent protection for designs beg the question of how such a legal regime was chosen in so many jurisdictions over time. The answer is both historical and structural.

One commentator explains the decline of design law into the semi-patent paradigm, the process of adoption of various bodies of
law in France, the United Kingdom and the United States as a "historical accident."

When the first patent law that included designs was enacted in the United States, there was no central registration of copyright, but there was a central patent office. Therefore, when the insufficient protection given to designs was acknowledged, and it was recognized that some form of registration was required to afford this protection, it was decided to transfer designs to the Patent Office authority. It is here that designs began to be treated like inventions, for reasons of administrative convenience. The same historical process of including designs in the patent scheme took place in France and in England: since it was decided that the protection of designs required a system of registration and deposit, and there was only the patent registration system, designs were transferred into the patent office's mandate. The patent office thereafter assimilated designs to patents in terms of eligibility as well as scope of protection.

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247 See Ladas, supra note 6, at 829-31.
248 In 1842, Congress enacted the first design patent law, see Act of August 29, 1842, ch. 263, § 2, 5 Stat. 543; Chisum, supra note 55, at § 23.20; While, only in the copyright act of 1909 registration of copyright by deposit was required as a condition precedent to an infringement action, see 17 U.S.C. § 13 (1909 Act); Nimocks, supra note 87, at § 7.16 [B] [III] [I].
249 See Ladas, supra note 6, at 850-51.
250 See Ladas, supra note 6, at 850-51.
251 In France, industrial designs were made a branch of industrial property by the law of 1886. See Ladas, supra note 75, at 829-30. This is the first industrial property law which was imitated all over the world. This law too has been described as "accidental": the French law of 1886 was enacted after the manufacturers of Lyon asked Napoleon to remedy the insufficient protection and regulation of their industries. See id. at 829-830. According to this law the factories in Lyon could deposit and register their designs in the archive of the trade councils of each industry. These provisions were merely meant to supplement the law on property of artistic property, which was aimed at creating a mechanism for proving ownership and creation. However, French courts extended this regulation to all industrial designs and distinguished them from artistic designs. See Ladas, supra note 6, at 829-30; see also Marie-Ange Peris Morel, Specific Protections of Designs and Its Relation to Protection by Copyright in French Law, in DESIGN PROTECTION, supra note 240, at 45, 47-48. The French law of 1886 had a substantial effect on the development of industrial designs and models of industrial property in France. A special section was thus accomplished, though in fact definite boundaries between the two fields have never been established. See Ladas, supra note 6, at 830. The development of design protection in the English law also reflects the somewhat "accidental" development of this branch of intellectual property. Id. at 825; Wharton Report, supra note 164, at 27. The development of English design law started at the end of the eighteenth century when Parliament enacted a series of acts aimed to enlarge the copyright protection established by the Copyright Act of 1799, known as the Queen Anne Act. See Russell Clarke, supra note 152, at 7-11. Finally, the design Act of 1842 was enacted, replacing most of the previous scattered legislation, but preserving the Board of Trade's duties and powers in relation to designs' deposit. See id. at 8-9. It was only in 1875 that a special act transferred these duties and powers of the Board of Trade to the Patent Office, since there was no central registration of designs in England. See id. at 11. The development of the Hague system in the 1890s led to the process of assimilating designs to patents, but for the reasons discussed above, this was not a complete transfer of protection. The document was sent to the Patent Office for examination, and the possibility of securing a design patent was not a serious alternative. The design patent law, however, was not a complete solution, as the design patent was not a separate category. The Patent Office led to the process of assimilating designs to patents, but for the reasons discussed above, this was not a complete transfer of protection. The document was sent to the Patent Office for examination, and the possibility of securing a design patent was not a serious alternative.
252 The strong Patent Office influence on intellectual property legislation is a known fact. For a description of the role of AIPA—a national bar association consisting primarily of intellectual property lawyers in private practice—in fostering the industrial design registration system, see William Y. Feyer III, International Industrial Design Protection Improvement: The Hague Agreement Revision, 2 U. Balt. Intell. Prop. L.J. 37, 37 (1993). See also AM. INTELLIGENT. PROP. ASS'N, REPORT OF AIPA INDIPE DESIGN COMM. MEETING (OCT. 14, 2004), available at http://www.aipa.org/MS/Template.cfm?Section=2004_Annual_Meeting&Site=Industrial-Design&Templates/ContentManagement/ContentDisplays.cfm&ContentID=7482. For a description of WIPO efforts to maintain the international registration method within the Hague Agreement scheme, and to further national registration systems in order to foster the viability of the Hague system, see Feyer, International Industrial Design, supra note 253; Feyer, An Overview, supra note 146, at 64.
253 See Reichman, Legislative Agenda, supra note 29, at 287-91.
254 See id.
255 See id. at 291-93.
B. **Incompatibility with Copyright Law and the Need for a Sui Generis Law**

As concluded above, the copyright paradigm is much more suited to design subject matter. However, I further stress that positive copyright law in itself is not tailored to comply with the exact nature and characteristics of designs. Therefore, the optimal solution is a *sui generis* law for designs, based upon copyright principles. It should be noted that by referring to the need to tailor a separate legislation for designs, I do not necessarily mean that such legislation must be physically separated from the copyright title. Rather, conceptually, different rules should apply, wherever they are situated.

Why is positive copyright law incompatible for designs? Different copyright features, that I will discuss below, beyond those of the very basic principles relating to the subject matter (i.e. artistic work) and of the type of protection (i.e. non-copying), are not compatible with designs. Design is neither a scientific process nor exactly art-like,

and thus asks for a methodology of its own.

In other words, the design realm needs a fine-tuned copyright rule that acknowledges its special characteristics, which are a mixture of art and technology. The desired deviation from copyright legislation shall be demonstrated below with respect to five major issues: (1) the originality standard; (2) a term of protection; (3) the deposit system; (4) moral rights; and (5) the right to prepare derivative works.

(1) **Originality Standard**

One of the hardest questions with respect to the integration of designs into the copyright paradigm is: what standard of originality should be employed with respect to designs? This question is part of the larger nexus between applied art and industrial designs. The originality standard for copyrighted works in American law is in itself not on solid ground, but that is beyond my scope here. For our needs I shall summarize the general doctrine of originality as follows: originality entails independent creation of a work featuring a modicum of creativity.

Independent creation requires only that the author has not copied the work from some other source.

A more complicated question is the precise degree of creativity needed in order to satisfy the originality standard. The traditional approach is that the level of creativity is low, and as long as a work possesses some creative spark, no matter how crude, humble or obvious, the requirement of originality is thereby fulfilled.

This threshold of creativity, or the quantum of originality necessary to support a copyright, is a question of degree. According to the traditional doctrine, any "distinguishable variation" from a prior work will constitute sufficient originality to support copyright if such variation is the product of the author's independent efforts, and is more than merely trivial.

In the seminal *Feist* decision, the U.S. Supreme Court stressed the need for some degree of creativity in order to attain copyright protection. The Court rejected the "sweat on the brow" doctrine, and thus more than just labor is required.

It is not clear whether the *Feist* holding influenced the originality requirement for all applied art and industrial designs. Should the designs of teapots, hairbrushes and other everyday equipment fulfill the *Feist* originality measurement, and if so, can the everyday designs cross this higher threshold? Without discussing the developments of the originality requirement, although it is highly relevant, I would advance the originality requirement adopted by the VHIDPA, which defines original design as "the result of the designer's creative endeavor that produces a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source." Such a definition of originality is appropriate for the design realm since it reflects both the need for encouraging investment in designing activity and preventing exclusivity over trivial additions, which would have a chilling effect on the market. The difference between the VHIDPA standard of

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256 See supra note 87, at § 2.01; MERCES ET AL., supra note 54, at 377 ("As developed by the courts, originality entails independent creation of a work featuring a modicum of creativity").

257 See supra note 87, at § 2.01 (B).

258 "Id. at § 2.08 (B)(2)," Alfred Bell & Co. v. Catalda Fine Arts, Inc. 191 F. 2d 99, 103 (2d Cir. 1951).

259 See supra note 87, at § 2.01 (B). This doctrine originates from *Blaskein v. Donaldson Lithographing Co.,* 188 U.S. 259 (1903).


261 Nimmer describes at length the ramifications of the "separability" measurement when employed in order to attain copyright for applied art with the originality requirement folded into such measurement, concluding that while it is indeed very problematic, it is better than conferring no protection for designs at all. See supra note 87, at § 2.08 (B)(3).

originality and the standard that applies in copyright law, inasmuch as there is divergence in the content given to the "originality" threshold, is what causes and maintains the separation between the two fields. Nevertheless, in my view, even if the same originality standard were to be employed for designs and copyrighted works, it is still better for policy considerations to separate industrial design from copyright law protection. This prevents the imposition of a narrow interpretation of the originality requirement from within the copyright law framework in the future. Indeed, courts in various jurisdictions outside the U.S. adopt higher standards of copyright eligibility in cases of industrial designs in order to separate everyday designs from copyright law.\textsuperscript{206} Thus, the courts intuitively make the benchmark distinction between artistic quality and a merely aesthetically pleasing product.\textsuperscript{207} The courts' apprehension is that the protection of design through copyright law would provide too strong a protection, with negative impact on market competitiveness, which is also a basis for attacks on the copyright system as a whole.\textsuperscript{208} Namely, the originality standard for copyright employed in relation to industrialized design will inevitably be interpreted in a different framework, since courts are apparently motivated to separate imaginative art from the combination of art and technical function. However, the selective application of the originality standard with respect to different kinds of work—such as with respect to a statue and a lamp with a crafted base—is difficult to employ and defend. Such application of the originality standard entails artistic assessment, often with rulings that are both arbitrary and incoherent.\textsuperscript{209} Thus, a better policy would be to divorce designs from copyright, and create an originality threshold that will be developed free of the impulse to protect designs with a weaker right. It is to be hoped that over the course of time a different common law will develop for the originality requirement of industrial designs, one that will evolve independently from the idea of originality used within the copyright scheme.

\textsuperscript{206} For this development in Germany, see Adolf Diez, Copyright in INTERNATIONAL COPYRIGHT AND PRACTICE § 2(1)(C) (2000). In France, see Reichman, Comparative Woes, supra note 81, at 573; André Lucas, Pascal Kamina, & Robert Plaisant, France, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE, supra, at §2(1)(C). In Israel, see CA 513/89 Interlego A/S v. Extralines Bros, S.A. (2001) IsrSC 48(4) 133.

\textsuperscript{207} For such a distinction made by courts in Germany, see Katenberger, supra note 240, at 100.

\textsuperscript{208} See Diez, supra note 269, at § 2(1)(b).

\textsuperscript{209} Finite, supra note 241, at 626. And, as I explained above, according to the Supreme Court, there should be no discrimination of applied art on the merits; see Heirin v. Deardorn Lithographing Co. 188 U.S. 239, 251 (1903).
entails a shorter term of protection than copyright grants.\(^{282}\) Every design is based on a previous one, at least to some extent, and the contribution of an original or new design might be reflected in a slight change.\(^{283}\) Moreover, designs deal with the form and configuration of useful articles. Thus by definition protection is conferred on the combination of "shapes," which are the basic elements of "forms." Though those shapes, which are the upshot of a specific function, are not protected, the entire subject of protection of shapes might put constraints on future developments.\(^{284}\) Thus, a long period of protection poses severe obstacles for the market dynamic, prevents fast development, and defeats competition.\(^{285}\) This conclusion is uncontroversial, and the only question is the optimal length of such a term of protection. Since designs usually have a short lifespan in the market because their essence attracts customers by their aesthetic appearance, designs must be constantly redeveloped in order to keep up with fashion, and producers must constantly improve designs in order to keep a competitive edge.\(^{286}\) Thus, a long term of protection is usually unnecessary for designs. The need for a shorter term of protection is also reflected in positive law, by the ongoing debate concerning the cumulative protection of designs.\(^{287}\) Since there are significant gaps in the term of protection provided by the different laws, the apprehension is that the shorter term of protection will be circumvented.\(^{288}\) The only way to solve this problem is by unifying all terms of protection into the shorter term decided upon.\(^{289}\)

(3) Deposit

One clear conclusion reached above is that there is no need for an examination system of registration with respect to designs.\(^{290}\) If the "originality" standard is employed, then it is clear that no examination is initially possible, as with copyright. The only advantage of the registration system lies in its probative function. Since designs are dictated by imminent guidelines, it is harder to prove non-copying with respect to them and thus, the

\(^{282}\) See COPINGER, supra note 5, at 714.
\(^{283}\) See Reichman, Legislative Agenda, supra note 29, at 286-87, 291.
\(^{284}\) See GOLSTEIN, supra note 29, § 2.5.3(c).
\(^{285}\) See COPINGER, supra note 5, at 714.
\(^{286}\) See supra notes 37-40, and accompanying text.
\(^{287}\) For a description of this ongoing debate, see RECKFSON, supra note 158, at 280-81.
\(^{288}\) See Whitford Report, supra note 164, at 30. See also id. at 33. (quoting from an Australian Design Law Review Committee under the chairmanship of Mr. Justice Frankl, which issued a report in 1973).
\(^{289}\) Such a measure was taken in the U.K. See infra notes 442-443 and accompanying text.
\(^{290}\) See supra Section 4.1(c)(ii).
However, the latter function favors publication or public access to the material deposited. This could undermine designs' protection by piracy. The archival function, even when used fairly, is ineffective without a deposit classification system. However, operating such a classification system will necessarily make the deposit more expensive, and hence undermine the aim of lowering costs for obtaining a design right. The remaining function is the probative one, which vests an advantage to the legal owner in court. In my view, it is not certain that compelling a higher court to accept such a procedural advantage is justified. Moreover, as explained above, the design market is dynamic and composed of small-to-medium enterprises. A compulsory deposit system could therefore undermine their protection. The alternative is automatic protection with a voluntary deposit.

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(4) Moral Rights

Another issue that demonstrates the need to separate designs from copyright scheme refers to "moral rights." Moral rights are a bundle of rights given to the author of a work, even if another owns the copyright that confers control over the economic exploitation of the work. Moral rights usually include the author's right of attribution and the right of integrity of the work. The United States has acknowledged moral rights to a limited extent. Moral rights, as acknowledged in federal legislation, apply only to "visual art works, such as paintings and sculptures, and explicitly..."
exempt applied art from its definition.313 Furthermore, moral rights are acknowledged only with respect to works not made within a "work for hire" scheme.314 Such a scheme refers to works produced in the course of employment, as well as various ordered or commissioned works that the parties agreed, in writing, to include in such a scheme.315 Thus it is clear that in the United States, positive copyright law moral rights are not relevant to industrial designs.

Nevertheless, theoretically speaking, there remains the question of whether these moral rights, even if acknowledged more broadly according to the Berne Convention standard,316 are suitable with respect to industrial designs. My contention is that moral rights, in any event, are not suited to the industrial design realm. With respect to designs that were made in the course of employment or under a work for hire scheme, there is much reason to refuse to acknowledge their designer's moral rights.317 It would be absurd for a designer's name to appear on each hairbrush handle, lamp base, etc. Because a design's purpose is to enhance marketability, it is subject to the employer/commissioner's needs. For this reason, it would be impossible to allow a designer to object to modification of a commissioned industrial design. Moreover, even with respect to designs that were made independently, and not under a work for hire scheme, it should still be noted that it is problematic to reconcile issues of the industrial design realm with moral rights perceptions.318 This is not to say that there is no personal bond at all between the designer and the design.319 Rather, a design is attached to a utilitarian object purchased by customers in the open market, and that customer's proprietary interest in the material utilitarian object must prevail.320 Limitation of moral rights with respect to industrially designed objects might also be concluded from the implied consent doctrine.321 As a matter of policy, the application of the implied consent doctrine encourages the free flow of goods in the market with no intellectual property encumbrances since it might lead to the conclusion that the designer agreed to the different modifications done with respect to the designed object, whether by the producer or by the buyer.322 Therefore, even if moral rights were broadly acknowledged in the United States, with no prejudice with respect to certain kind of works, there is still much justification and logic for excluding moral rights from industrial designs. In sum, moral rights are another reason for the incompatibility of industrial designs within the general copyright scheme.

(5) The Right to Prepare Derivative Works

The last and most troublesome question is whether it is appropriate to acknowledge the right to prepare derivative works from industrial designs. As already explained, the designing process involves, to a large extent, the use of previous designs.323 Therefore, encouraging design innovation is not simply a matter of granting exclusive legal rights to all design activity. Design protection must strike a balance between sufficient protection against free-riding and encouragement of adequate financing for industrial design on the one hand, and a certain degree of freedom for designers to use prior designs on the other hand.

316 Berne Convention, supra note 10, art. 6 bis. For the higher moral right standard compelled by the Berne convention, see RECKSON, supra note 158, at 462.
317 This is in comparison to other fields of creation. For a critique of the limited scope of moral rights for employees, see Catherine L. Fisk, Credit Where It's Due: The Law and Norms of Attribution, 95 GEO. L.J. 49 (2006).
318 For a similar opinion, see KAHN, supra note 35, at 577.
319 Nevertheless, even in France, homeland of moral rights, it was noted that courts since with respect to a creation that was dictated by functional and economic different modification of the work should be allowed. See Carolyn McCool, Limitations on Moral Rights and French Deal w/Auteur, 41 COPYRIGHT L. SYMP. (ASCAP) 425, 447-53 (1998). It also should be noted that for the very same reason computer programs are exempted from moral rights in various countries, including the U.K. and France. See Copyright, Design, and Patents Act (Eng.); Code de Propriete Intellectuelle, Law No. 94-361, art. 2 Official Journal, (1 May 1994).
313 By the same logic, in many countries "moral right" is limited with respect to architectural works, and thus modification done by the owner of a building in order to suit his needs cannot be prevented. See, e.g., Copyright Act, 1988, § 105AT (Austl.) [hereinafter Copyright Modifications of Architectural Works]; supra note 308. Thus, it follows that other modifications of artwork attached to buildings are permitted. For an example in American law, see 17 U.S.C. §§ 113, 120(b), (d). For an Australian example, see Copyright Act (Austl.) § 106AT(2).
317 Even in France and Germany, where the "integrity right" is interpreted very broadly, it is restricted by courts with respect to various utilitarian works, such as architectural works. See McCool, supra note 320, at 445-49; Adolf Dietz, The Artist's Right of Integrity Under Copyright Law: A Comparative Approach, 25 INT'L J. REV. L. INDUS. PROP. & COPYRIGHT L. 177, 187-89 (1994). This is because the proprietor's interest must be taken into account, and the creator, being aware of the fact that his work will serve a utilitarian function, is thus subject to limitation with respect to modifications done in order to suit the user's needs. See id.
321 For the potential of the implied consent doctrine in the intellectual property field, see Food Consulting Group, Inc. v. Mushi Games Asakusa, 270 F.3d 821, 832 (9th Cir. 2001) ("But there is another type of implied contract, one that is "created otherwise than by assent and without any words or conduct that are interpreted as a promise." ... Such an implied contract is not a contract at all; it is a legal obligation the law imposes between certain parties where there is no actual agreement between them").
322 For the potential of implied consent doctrine and tangible assets incorporating intellectual property rights, see Ori Fischman Afori, Copyright Enforcement Without Copying: Reflections on the Thalberg Case, 59 OTTAWA L. REV. (forthcoming 2008).
323 See supra notes 304, 383-284 and accompanying text.
Therefore, design rights must not be too restrictive so as to act as a barrier to further innovation in the field. The main restrictive right that bars further use of creations is the exclusive right to prepare derivative works.258 A "derivative work" is a work based on a previous work, that has an original addition, such as a cinematographic work (movie) based on a novel, translation, musical arrangement, etc.259 Therefore, the right to prepare derivative works is that which restricts further use of a work for the preparation of a work based upon it. With respect to low-originarity works, usually utilitarian ones, there is authority to claim that the copyright conferred is "thinner" in that it prevents mere copying, in contrast to adaptation.257 There are many explanations for this tendency, based upon the basic rule that ideas, including purely functional elements, are not protected.258 Vast protection of utilitarian works might end with protection over functional elements, which should be left in the public domain.256 In order to prevent a chilling effect on the design innovation market, and taking into account that design's building blocks are shapes and forms, it is appropriate to acknowledge a narrower derivative right.259 Actually, the broad reproduction right, assessed by the substantial similarity standard, might supply sufficient protection for designs.260 Therefore, also in this final and important respect, there is much support for an industrial design scheme separate from the copyright scheme.

259 See GOLDSTEIN, supra note 28, §§ 8.4.2, 8.5.2.1; Paul Goldstein, Derivative Rights and Goldstein, Derivative Rights. For such doctrine in English law, see W.R. CORNISH & ALLIED RIGHTS 430-21 (1999); Hugh Laddie et al., THE MODERN LAW OF COPYRIGHT AND DESIGN 215 (2000).
260 See Baker v. Selden, 101 U.S. 99 (1879) (distinguishing copyright infringement in case of accounting tables' copying since such tables reflect the underlying unprotected (1890) 25 Q.B. D. 99, 102 (holding that a basic drawing will enjoy protection only against literal copying).
262 For a similar opinion, see Kour, supra note 35, at 875. This approach is the answer to further innovation. See Magliocco, supra note 37, at 862.
263 Anyway, some commentators hold the view that the broad reproduction right includes within its scheme the derivative right. See Nimmer, supra note 87, §§ 8.09(A); Serk, supra note 188, at 1218.

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5. THE APPLIED ART AND INDUSTRIAL DESIGN NEXUS AND THE RECONCILING OF THE "UNITY OF DESIGN" DOCTRINE

A. The Impossible Divorce of Applied Art from Industrial Design

After concluding that design law should be located on the copyright axis in the intellectual property realm, and treated within a special sui generis law, we still have not resolved the main problem of design law, namely, what is the exact subject matter to be protected by the recommended sui generis law, and how exactly should the borderline between copyright law and such a sui generis law be formed. The reconciliation of all the tensions of design law and its proper location in the intellectual property realm await answers. The idea of enacting a sui generis copyright law for design is not a new one, and it enjoys some scholarly advocacy.261 However, the phrase "sui generis" is not magic, and the mere proposal of such a law does not solve the problems. The next stage must be to define the subject matter of this hybrid law, and to sketch the mechanism for its separation from copyright law.

In the modern post-industrial revolution era, art is reflected in most designs, since the attractiveness of a product is a major selling point, aside from its functionality.262 Many bona-fide artists seek to create works that will be a commercial success, specifically those that will be produced on an industrial scale. Thus the borderline between the categories of applied art and industrial design are blurred.263 Further blurring of the line between industrial design and aesthetic appeal are creations which are admitted to be artistic but were intended originally for practical purposes, or were incorporated in functional articles.264 Consequently, some hold the view that a clear definition of works of applied art is not possible.265 The difficulty stems both from the

261 There were several attempts in the past to enact such a law in the U.S. Briggs claims that various types of design legislation have been introduced in Congress at least 88 times since 1914. See Briggs, supra note 1, at 201 n.202. Furthermore, there is scholarly support for such an enactment. See, e.g., Reichman, Legislative Agenda, supra note 29, at 291-99; Keesburg, supra note 1; Goodwin, supra note 120, at 575-76; Brown, supra note 69; Steve W. Ackerman, Protection of the Design of Useful Articles: Current Inadequacies and Proposed Solutions, 11 HOWSTRA L. REV. 1043, 1068-71 (1983). As to the current Copyright Office position, it seems as though it takes no position with respect to the merits of extending design protection (explicitly for fashion design). However, if such enactment is approved then the VHPDA should serve as its model. See Copyright Office Opinion, supra note 148, at 208-09.
262 See supra notes 27-42 and accompanying text. See also LADAS, supra note 6, at 831.
263 See GOLDSTEIN, supra note 28, § 2.5.5 n.71 and accompanying text.
264 For example, this phenomenon is reflected in the "ready-made" trend, inaugurated in 1917 when Marcel Duchamp exhibited a discarded urinal under the title "Fountain." See J. Alex Ward, Copyrighting Contests: Law for Plumbing's Sake, 17 COLUM.-VA. L.J. & ARTS 159, 159 (1995); Nimmer, supra note 87, § 2.09(b)(3).
265 See LADAS, supra note 6, at 833.
grounds of logic justifying the distinction between the categories of art and industrial designs,156 and from the limits of legal language in expressing a line that will effectively separate different intellectual property policies.157

In this context, the French approach must be presented. From its inception, the French system acknowledged a separate industrial design regime and did not reject a cumulative protection over designs by copyright law.158 The reasoning behind this cumulation was the "unity of art" doctrine, which was widely accepted in French legal discourse.159 According to this doctrine there should be no discrimination between useful art and "pure" art. Art should get the fullest protection even if it is integrated in an industrial product. There is no basis for distinction between different types of art, and it is not possible to segregate between minor and major art.160 Art has no limits, no beginning and no end. Therefore, a clear-cut distinction between art and industry is not possible, by definition.161 Since such a distinction is impossible, any segregating rule would have to be subjective and arbitrary, and finally the many necessary exceptions would undermine the validity of the rule.162 The unity of art doctrine was legislated within French copyright law, protecting as a matter of principle any work, whatever its genre, form of expression, merit, or intended purpose.163 And, indeed, the merit of the French rule, according to which all designs irrespective of their purpose or mode of production are copyrighted, is that it has provided an

156 See Goldstein, supra note 28, § 2.5.3 p.81 and accompanying text. The Whitney Committee reported that one of the major arguments raised in the hearings and papers submitted was that "there is no difference in principle between the 'industrial' exploitation of artistic works and, for example, the printing of books or pictures and the production in numbers of decorative sculptures. It is difficult to justify on the one hand refusing to give copyright to a chair or carpet design and on the other hand granting it to a street directory or a fixture list. . . ." See WITTFORD REPORT, supra note 164, at 37.
157 See Goldstein, supra note 28, § 2.5.3.
158 See Finnis, supra note 242, at 630; Lucas et al., supra note 269, at § 2(1)(b)(ii)(D); Ricketson, supra note 158, at 269.
159 See Finnis, supra note 242, at 620.
160 See Finnis, supra note 242, at 620; Lucas et al., supra note 269, at § 2(1)(b)(ii)(D).
161 Ricketson, supra note 158, at 269. A similar philosophy may be found in the Weimar Bauhaus school of thought, which attempted to harmonize art, craft and industry by removing the demarcation between art and industry. See AUCHERLEBEN, supra note 16, at 12. See also Brugghe, supra note 12, at 232.
162 This idea is attributed to Poulet. See Morel, supra note 252, at 45, 47 (referring to C.F. Poulet, "roit Théorique et Pratique des Droits et Modes, 1911.
163 See Morel, supra note 252, at 45.
165 See Ricketson, supra note 158, at 269-70.
166 See Lucas et al., supra note 269, at § 2(4)(c).
167 The main argument French courts use for concluding that form is separable from function is the theory of the "multiplicity of forms," according to which, if there are several options to shape the form in order to achieve the same functional result, then the form is separable from the function and not dictated solely by it. See Luc et al., supra note 269, at § 2(4)(c) nn.133-36. See also Morel, supra note 252, at 67, 71.
168 See Reichman, Comparative Views, supra note 81, at 297-303.
170 See Finnis, supra note 242, at 629.
171 See Reichman, Comparative Views, supra note 81, at 308-21.
173 See supra notes 98-106 and accompanying text.
174 At the same time that the French "unity of art" doctrine flourished, there were continental European attempts in Italy and Germany to develop a counter-theory justifying the segregation of pure art from useful art. Such counter-theories adhered to the need to exclude copyright from low creativity productions, and from productions reflecting the customers' taste and not the creator's artistic self-expression. See Reichman, Comparative Views, supra note 81, at 276-77. "Artistic" quality was contrasted to a merely "aesthetic" or "photographic" product. See Katscher, supra note 240, at 100. These theories have supported the "skill effort" approach, according to which a separate special law should protect low artistic productions as a sui generis copyright law. See Reichman, Comparative Views, supra note 81, at 279. Nevertheless, such a theory is denied currently both in Germany and in Italy; in Germany a system similar to the French one governs, according to which applied art can be copyrightable and enjoy cumulatively the registered design right. However, courts in Germany have sometimes imposed narrower standards.
The "Unity of Design" Doctrine

(1) The Proposed "Unity of Design" Doctrine

Under the proposed "Unity of Design" doctrine, there will be no discrimination between applied art and industrial designs; all will be protected under one sui generis semi-copyright law. The classical "unity of art" doctrine was aimed to draw industrial designs into the copyright realm, giving them "higher" status. However, as explained earlier, a solution via copyright law is not an appropriate scheme for everyday products, and some needed deviations from copyright law are needed. Instead, I propose the opposite: the Unity of Design doctrine will return applied art to the realm of a sui generis design regime on a noncumulative basis (i.e., with no additional protection by copyright or any other semi-patent right). In this manner no discrimination will be made between different designs according to their quality—an impossible procedure anyway—and all designs shall enjoy a sort of copyright, however for a shorter term. This proposal is compatible with all international standards. The proposed unity of design doctrine is based partially on the English approach, attempting to exclude designs from the copyright realm. However, as I shall explain shortly, the English approach is marred by complexities, which my model tries to circumvent.

"Design" in the proposed doctrine shall include all external appearance of shape, configuration or ornamentation of applied articles that are manufactured industrially. Protection over designs will include all such external appearances, as long as such design is original and not the result assured by the doctrine. There is still a need to address the "minimum" and "maximum" boundaries of the unity of design doctrine, specifically, there is a need to sketch the mechanism for differentiating the design subject matter from all other subject matter scattered on the copyright axis. As to the minimum boundary, arguedo, the proposed model might protect all designs, with no need to distinguish between their respective aesthetic merit. The only requirement will be originality and will provide no protection for ideas and mere functional features. That is, features that are completely dictated by their purpose function are not protected, in contrast to features that may have a pure functional purpose but whose design is not dictated completely by their function. I stress this holistic approach as arguedo, since there is an ongoing debate whether design law should protect pure mechanical and functional articles, such as spare parts, for example. The inclusion of such articles

294 and accompanying text.
295 See infra notes 152-173 and accompanying text.
296 See infra Section 5(b)(3)(c).
297 For the employed originally standard, see supra Section 4(b)(1) Originality Standard.
298 See CORDING, supra note 5, at 714 - 715 ("Given that designs vary from the purely technical to the almost purely artistic, a form and period of protection which is inappropriate for one design may be wholly inappropriate for another. . . . Yes, if differing forms or degrees of protection are to be available for different types of design, the need to define clear boundaries between those different types of designs becomes vital. The law has long decided that industrial designs should have some form of protection but it is the drawing of these boundaries which has caused difficulties.").
299 For a similar approach, according to which the idea-expression dichotomy, which denies protection of ideas, might bar protection of pure functional aspects of designs (since basic shapes are no doubt the collective domain), see GOLDSTEIN, supra note 28, § 9.5.3.1(b)-(c). Sometimes this threshold of "functionality" is examined through the question of "range of possibilities," namely whether there are real options to design the article. If the designer had free choice between several possibilities then the design is not dictated solely by its function. See infra note 298 and accompanying text.
300 This issue was much debated in English law. See TORRENS, supra note 13, at 315-19, 344-46. The English Whitchurch Report recommended enacting two categories of designs: Category A includes designs whose aesthetic appearance influences a purchaser in making a purchase, and Category B includes designs in which the appearance of the article does not influence the purchaser. All the replacement parts were meant to be included in this category. However, there was disagreement between the committee members on whether such Category B designs should enjoy even weak
in the design scheme involves different policy considerations, such as antitrust law and post-purchase tie-ins, which are beyond the scope of this article. Nevertheless, if such products do deserve some mode of protection, then there is no reason the proposed scheme cannot contain them as well. It accords a short term of protection, based on a semi-copyright framework, but with an independent originality requirement. In other words, the proposed scheme has the potential for hosting both applied art (transferred from the copyright realm), and other designed mechanical articles (transferred from other intellectual property schemes, or not protected at all). It should be stated at the outset that defining the maximum boundary of applied art—when the external appearance of an article will be regarded as applied art to be protected by a design right and when it will be regarded as a copyrighted work—the central problem of creating a design doctrine is a notoriously hard undertaking. Any definition might be rebutted as a self-contradiction to the "unity" of the unity of design doctrine, and as a result, hypothetically all artistic works reflected in an "article," including "pure" aesthetical artifacts, would be drawn to the design realm. However, this outcome is not realistic and can be avoided, since the justification for a separate law for designs is based on their unique character of mixture of art and function. Accordingly, the Berne Convention allows deprivation of copyright only from "applied art" (and industrial designs). Practically speaking, this maximum boundary must be drawn, and there are two main possibilities for a differentiating rule-of-thumb: one on the basis of usefulness and the other on the basis of industrialization. Both pose difficulties. The usefulness measurement would define a potential subject matter for design protection according to whether the article has a useful or functional purpose. Since the justification for segregating designs protection. See Whittford Report, supra note 164, at 44, 50. Finally, the 1968 law reform in English design law chose not to protect spare parts at all. See supra note 151.

305 For a similar opinion, see TORREMAN, supra note 13, at 361.

306 For example, the protection of integrated circuits, which are "functional designs," could be incorporated into this inclusive design right. See supra note 150.

307 See supra Section 2.

308 Since there is no comprehensive definition of useful art in contrast to pure aesthetic one, see supra notes 332-337 and accompanying text.

309 See supra note 159 and accompanying text.

310 "Useful article" in current U.S. copyright law is defined as "an article having an intrinsic utilitarian function that is not merely to convey information. An article that is normally a part of a useful article is considered a 'useful article.'" 17 U.S.C. § 101 (2008). For the rule that the article at stake serves a function as a prerequisite for design patentability, see Hupp v. Siroflex of America, Inc.

312 23 F.3d 1156 (1994) [MILLS, supra note 209, at § 8:2.]

313 For such an argument, see FATRY, supra note 70, § 2:154. This critique is actually another manifestation of the French "unity of art" doctrine. See supra notes 340-344 and accompanying text.

314 See GOLDSMITH, supra note 28, § 2.5.3.

315 For the theoretical underpinnings of the reasonableness standard in tort liability doctrines, mainly due to its relative objectivity, see Goy L. McChesney, III, The Defense of Reasonableness: A Critical Analysis of Monopolistic Theories of Tort Liability, 69, 97-99, 1980 (unpublished Ph.D. thesis, Rice University) (on file with author). The normative expected use standard is incorporated in the "three step test" for limiting copyright, codified at Article 9(2) of the Berne Convention, supra note 10, and Article 13 of the TRIPS Agreement, supra note 10. The three conditions for setting limitation to the rights are as follows: (1) the exception should be limited to certain special cases, (2) it does not conflict with normal exploitation of the work, and (3) it does not unreasonably prejudice the legitimate interests of the rightholder. These standards were interpreted by the World Trade Organization panel discussing Section 110(3) of the U.S. Copyright Act. For example, the panel interpreted the standard of "normal" as incorporating both the existing-empirical situation with the recommended one. See id. at 6.106. See also MARTIN SFBELTMANN, COPYRIGHT, LIMITATIONS AND THE THREE-STEP TEST: AN ANALYSIS OF THE TRIPS ARTICLES 11 AND 12(1) IN INTERNATIONAL AND EC COPYRIGHT LAW 193 (2004).

316 See supra notes 268-270, 354-355 and accompanying text, explaining why it is impossible to unify protection over all artistic objects and the deaths of the French "unified" approach of the useful article design.

317 This benchmark is the basic doctrine in English law. See Registered Design Act, supra note 240, art. 1 (defining registrable design as including requirement for from copyright stems from the fact that designs are art in the service of function and, therefore, are also dictated by iniminent considerations, it is logical to incorporate the functional purpose of the article in the differentiating mechanism. The difficulties with this benchmark are clear. As I stressed, it is impossible to discriminate between arts according to an evaluation of their "intrinsically" functional or aesthetical goals, and it is hard to deduce objectively from the form itself. For example, one could claim that a sculpture, created only for aesthetic purposes, could be used as a paperweight, lampstand or, doll, that is for a useful purpose, just as it might be placed on a shelf for decoration, which is also a consumer-added value. Nevertheless, like other open-standard norms, the usefulness measurement can also be developed according to mechanisms such as reasonableness, significant character, and normative expected usage. As an alternative, a totally clear segregation of all artistic works of form should be made, which will include them in the design realm; however, as explained earlier, this result is unwarranted. Another problem stemming from the usefulness measurement relates to singular designed objects. For example, unique chairs, dresses, or pieces of jewelry, which are no doubt useful, raise the question of whether they should be treated as designs or as copyrighted works. The second measurement answers this kind of difficulty by including as applied artistic articles only those designs that are manufactured or intended for manufacture on an industrial scale, and thus have become industrialized products. Here, once again, the term "industrial
production/manufacture
could be employed by general
interpretive tools. This second measurement could be
supported by the fact that the entire project of justifying design
right is to enhance market competitiveness and efficiency.
However, when a design is not industrialized it does not function
as a "product" in the marketplace but rather as a pure artifact,
despite its usefulness. Nevertheless, industrialization will not
necessarily surrender copyright. For example, a statue which is
exhibited in the museum and its industrialized replicas sold in the
museum shop should not lose their copyrightability. By the same
token, industrialized tourists’ souvenir statues should maintain
their copyrightability because of the additional usefulness
measurement.

As we know, legal language has a limited ability to define all
subject matters to be protected by intellectual property rights.
The most remarkable example is the fact that the term "work" in
copyright law is not defined. Thus, the border between
industrial designs, including applied art, and copyright law,
cannot be hermetically closed, given that both copyrightable works
and applied art are left as open standard norms. However, below I
shall further try to tailor the distinction as clearly as possible with
a mechanism that, in my view, solves much of this central problem.

In English law there is an enacted presumption according to which a design
is intended to be reproduced in more than fifty single articles. See Designs Rules, 1903, art.
reproduction or industry for a design to qualify for registration, (Geschütz), art. 1(1). This requirement was interpreted by German case law as a
WILHELM STOKMARK, THE PROTECTION OF TECHNICAL INNOVATIONS AND DESIGNS IN

See supra Chapter 2. What is a Design, and What Functions does it Serve? For
further justifications for design right, see supra Section 2.

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2 (2) Exceptions to the "Unity of Designs" Doctrine

Although the advantage of the proposed unity of design doctrine is that it is a comprehensive approach in its attempt to
define a simple rule applicable to almost all situations, legal reality is
always much more complex. Especially in the intellectual
property realm, the common and unavoidable legislation
mechanism is made of rules accompanied by exceptions, aimed to
tune the principal rule according to different competing
interests, such as a public or sectorial interests. Accordingly, I
wish to introduce some exceptions to the rule of unity of design
document, each of which reflects a different kind of complexity.
The most important exception pertains to pure artistic work later
exploited for functional purposes. As will be explained, this
exception recognizes the point where the parallelism of the
differentiating rules of copyright and design breaks down, and the
two merge. This will be discussed in some detail below. Two
additional possible exceptions that will be mentioned briefly are
two-dimensional designs and architectural designs, which deserve
a thorough discussion elsewhere.

(a) Architectural Works

The first category of designs that might be excluded from the
"unity of designs" doctrine, namely maintaining its
copyrightability, refers to architectural works. The reason for such
potential exclusion is both formal and material. According to the
Berne Convention, architectural works are copiable by
author. However, materially, it could be argued that architectural works
invoke special considerations in contrast to other designed
products
and thus justify full copyright.

854 Sec. 10, 101, art. 2(1). For this very reason, in 1990 a special
act was passed in the U.S. in order to set adequate copyright protection for architecture,
as it was required in order to comply with the Berne Convention standard.
855 Sec. 101(1). "No work..." see supra note 87, at § 220(A). Moreover, for the same reason, Canadian law, which in
principal excludes copyright protection from industrial designs, maintains the
copyrightability of architectural works. See Copyright Act, R.S.C., ch. C-42, art. 64(3)(d) (1945) (Can.) [hereinafter Copyright Act (Can.)].
856 Arguably, architectural works reflect both high personal creative character and a
substantial investment of resources, and thus the proposed deviation from the old law's
scheme are inappropriate. Namely, a longer term of protection might be needed in order
to supply the basic incentive for creation; moral rights and derivative rights are relevant
architectural works, and finally a higher originality standard is apt. As was said in it
(b) Two-Dimensional Designs

Another category of designs which might be excluded from the "unity of designs" doctrine are two-dimensional designs. Generally speaking, there is much difference between two and three-dimensional designs. The three-dimensional design is reflected in an article or product which by itself serves some useful goal, while the two-dimensional design is reflected in a drawing or a surface appearance attached to the useful device, such as a drawing pasted to dishes, tiles surfaces and wallpaper or tapestry decorations. In the category of two-dimensional design, more "products" could hypothetically be included, such as greeting cards, postcards, and even posters. Thus, it could be claimed that by definition, two-dimensional design is actually an artistic work, such as painting or drawing, which is attached to its "carrier," however, the artistic work per se is not applied art and only the product, into or onto which the artistic work was incorporated, achieves a utilitarian function.

The principal difference between two and three-dimensional design is reflected in many positive-doctrinaire rules. For example, the "separability" test is not problematic with respect to two-dimensional designs, such as graphic or fabric designs, since the design itself is not intrinsically utilitarian. Furthermore, with respect to registration of designs, the asymmetrical legal situation between two- and three-dimensional design is remarkable: in cases of two-dimensional designs, which are basically an artistic work, such as a drawing or painting used for decorating a variety of articles that have a functional purpose, it is pointless to compel owners to register each one of the articles independently in order to achieve effective protection. That is because the new or original element is only in the drawing per se, which has no intrinsic functional use, and whose sole merit is therefore artistic. Finally, the incommensurability of two-dimensional design to the industrial design scheme is acknowledged in current positive law, both in the U.K. and Canada: in the U.K., two-dimensional designs ("surface decoration") are excluded from the unregistered design right scheme, which will be introduced further below, and thus enjoy only copyright. Canadian law maintains copyrightability of graphic designs on the face of articles, and of character merchandising, -- namely of two-dimensional designs -- although it adheres a non-cumulating regime which excludes copyright protection from (almost) all industrial designs. This exclusion is based on the apprehension that two-dimensional designs are artistic works attached to different three-dimensional forms, and thus should maintain their copyrightable nature. Nevertheless, I admit that this conclusion needs more review.

(c) Pure Artistic Work Exploited for Functional Purposes - The "Popeye the Sailor Syndrome"

One of the hardest questions in tailoring the divorce of industrial designs from the copyright realm refers to a scenario in which a pure artistic work was initially created, and at a later stage it was exploited industrially, whether by its merchandising in derivatives (such as dolls, etc.) or by its mass reproduction. The question is whether such industrial exploitation surrenders or diminishes copyright and repositions the protection of such creation within the sui generis design right, under the unity of design doctrine.

As explained above with respect to two-dimensional designs, the decoration remains two-dimensional (i.e. flat) even when is attached to three-dimensional functional forms, and thus should maintain its copyrightability. But what of the transformation of a drawing into a three-dimensional functional article, such as a cartoon character into a doll or toy? In such cases the design is indeed merged into the useful article itself, with no way of separating the aesthetic and utilitarian parts. Should these...
dimensional designs, based upon artistic work, be protected through copyright or through the proposed sui generis design right? This question might be coded as the "Popeye The Sailor Syndrome," following the seminal English decision in King Features, in which a cartoon figure drawing was created initially for an advertisement, and only later was merchandised industrially through dolls and other objects. However, the question is much broader, and is in principle the same question that arises in all situations in which a "pure" artistic work is later exploited industrially through a useful object. This is the Master v. Stein dilemma again: what should be the law with respect to a statue initially created only for aesthetic merits that later on was used industrially as a useful article or as part of a useful article? Is copyright or rather design-right applicable (or even both)? A possible test aimed to solve this problem is the "intent of the creator," which will be presented below, and rejected. I shall propose a different solution which I believe is much more coherent and workable.

(i) Separation According to the Intent of the Creator at Time of Creation

One of the ways of finding a definition of copyrightable subject matter has been to examine the process of creation rather than the final result. This test takes into consideration the creator's intent at time of creation, whether the work was intended to be used industrially or not. This test suffers from some severe failures. Since the state of mind of a creator at the time of creation can never be established with exactitude, a test based on such criteria is doomed to end with subjective and arbitrary court decisions. It has happened before. The assumption that "the work itself will continue to give "mute testimony" of its origins" is unfounded, and it creates a vicious circle: since industrial design includes a wide spectrum of materials which combine functional and aesthetic aims, the "mute testimony" will not reveal whether the design is more functional or more aesthetic; it will reveal both aims.

Moreover, considering the creator's intent with respect to the purpose of his work (i.e. artistic or utilitarian) at the very time of the creative process, as a criterion for deciding whether such creation will enjoy copyright or industrial design protection is completely arbitrary since it relies on a contractual element, non-intrinsic to the work itself, and which is totally occasional. In some instances the artist/designer is lucky enough to have a contract with an industrial entity already ordering the creation for utilitarian purposes, and sometimes the artist/designer creates with no specific purpose, only having the creation industrialized at some later point. Therefore, sorting the protection over creative works according to the question of whether the work was initially commissioned or not is illogical, and leads to subjective and arbitrary results. Thus, there is need for a simpler, clearer, more objective and more consistent benchmark rule for the scenario at stake.

(ii) The Proposed Test: Separation According to the Type of Use Alleged to be the Infringing Act

In order to resolve the problem of where to locate a copyrighted work which is later industrialized, I propose to sort rights according to the alleged infringing use. The decision where to locate the subject matter, in copyright law or in designs law, will be done according to the nature and purpose of exploitation of the subject matter alleged to be infringing. If the exploitation is made in order to produce industrialized useful articles then design law

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384 For further discussion on this decision, see infra notes 495, 496 and accompanying text.
386 This test was furthered in American legal discourse by Demicolli. Id. at 1145-46. However, this test had been used already in 1946 by the House of Lords holding in King Features, in which the court ruled that since the drawing of a figure was made with the intention at time of creation not to be used industrially but rather for artistic purposes (i.e., an advertisement), it is still copyrighted, even though dolls based upon that drawing were later commercialized. See also RUSSELL-CARDELL, supra note 101, at 253-36.
387 For a similar critique, see Brown, supra note 69, at 1350.
will be enforced; if the exploitation is made in order to reproduce copyrightable materials, then copyright is to be enforced. This identification of the applicable right is not based on an ex-ante inspection of the intrinsic characteristics of the subject matter in a sterile environment; rather, it is an ex-post inspection of the characteristics of the relevant exploitation of the subject matter in order to locate the specific issue at stake in the right legal scheme. For example, in the Popeye the Sailor case: if the alleged infringer copied the Popeye dolls in order to produce other industrialized dolls, then design right should be enforced; and if the alleged infringer copied Popeye in order to produce another comic strip, book or picture, then copyright should be enforced.

Admittedly, it could be argued that there is no difference in principle between a merchandised "Popeye" doll and a merchandise cup with a "Popeye" drawing attached to it. How can we defend such an outcome? Specifically for the case of cartoon characters and the like, this is indeed a "second best" solution: the very long term of protection in copyright law has no justification in such cases. But if this is the only flaw of the proposed model — dividing between copyright and design right, is that with respect to one group of subject matter (i.e., three-dimensional designs based on artistic work which is copied in order to make two-dimensional designs) — then it is not fatal. Another justification is that the proposed mechanism enables the creation of a coherent, uniform and dynamic rule. As an alternative it is possible to set a special exemption in both design and copyright legislation, which either takes all the merchandising industry into the copyright field, or into the design-right field. The Canadians chose the first option by maintaining character merchandising copyrightability, in whichever dimension it appears. Namely, all of the cartoon derivative market, including applied derivative works in two and three dimensions, is still protected through copyright. However, such a reconciling exception returns us to the basic question posed by the "unity of design" doctrine: why favor character merchandising and discriminate against other applied art? A more coherent rule would be to either treat all applied art as copyrightable works (under a "unity of art doctrine") or as designs ("unity of design doctrine"). But we must also be realistic — the powerful lobbies demand their compromise in the intellectual property field.

The advantage of the proposed mechanism is that it answers the basic need to balance competing interests in the industrial design realm: if the action is in the applied art products' market, then the exclusivity of designs will be the governing doctrine, whose purview is immediate redress and short-term protection.

The proposed mechanism also introduces a uniform and dynamic mechanism, enabling us to reconcile the tension along the borderline of copyright and design field. The mechanism shifts the final identification of the cause of action to the court's discretion, on an ex-post basis, however it does not deprive the plaintiff from protection, such as the "all or nothing" type of rule, since in any event once the system is in place there will be no formalities required in order to obtain both copyright and design right under the proposed model. The main difference, practically speaking, is with respect to the term of protection, namely the longer term of copyright protection or a shorter one applicable to designs. There are other examples in positive law in which different terms of protection are conferred with respect to the same work, according to the exploiting act.}


408. See supra Chapter 4 & A (3)(b) Registration's Consequences are Not Appropriate for Design Markers and A B (2) Term of Protection.

409. For example, a special problem exists with respect to films based upon literary works (derivative cinematographic works), since films are protected for a shorter period of time than literary works. See 17 U.S.C. § 302, 304. The outcome was called a "copyright ambush," because while a film might fall into public domain its use is still not free since there are "hidden" exclusive rights with respect to the underlying literary work. See Francis M. Nevin, Jr., The Doctrine of Copyright Ambush: Limitation on the Free Use of Public Domain Derivative Works, 25 ST. LOUIS U.L.J. 59 (1981); Peter Zemel, Where Works Commerce: Copyright Against Freedom of Expression, Copyright Against Freedom of Deformation, and the Public Interest, 25 U.C.L.A. L. REV. 713, 717-19 (1981). See also Stewart v. Abend, 495 U.S. 207 (1990). Australian law has introduced an original solution for such "copyright ambush," according to which if the term of protection over a film has expired, then causing the film to be shown be broadcast, however, its reproduction and broadcasting is still subject to the underlying work's right. See Copyright Act (Ausl.), supra note 321, art. 110(1)(c). Thus, a spectrum of time period of
One of the main reasons for the complexity in detaching designs from copyright is the difficulty of differentiating between commercialized derivative works from industrial designs. All the merchandising industry of dolls, cups, key–holders, and other accessories based upon copyrighted works, such as cartoon figures, is an industry of applied art. It should be clarified that I refer here to three-dimensional designs, in which the artistic work is merged with the useful object (for example a Popeye doll), in contrast to two-dimensional designs in which there is a "drawing" attached to an object (for example an ordinary cup with an applied drawing of "Popeye" on it). Why should there be a difference between all of these merchandised applied art and other kinds of applied art, initially designed for industrial mass production? For example, why should there be a different legal protection for a statue designed to function as a base of a lamp and a statue of Popeye functioning as a base of a lamp, although the first is labeled industrial design and the second is regarded as a derivative work of applied art? Intrinsically, however, both are the same. Under the proposed model, the question of whether the Popeye statue functioning as a lamp–stand will enjoy copyright protection or design protection is to be decided according to the alleged infringing act. If the copier produces Popeye statues for lamps, then the protection will be by sui generis design right, while if the copier produces another Popeye movie or book, then it will be protected by copyright. With respect to derivative applied art—the merchandising industry—there will be some limitation on the right to prepare derivative works, since it will prevent derivatives for a shorter period of time, assimilated to design right. This makes economic sense. From a copyright perspective, after the term of protection of a design has expired, the copyright holder can expect to have earned adequately, or if not, then a longer term will be unfair for competition. Thus, the incentive to create is fulfilled and there is no justification for further exclusiveness. Moreover and most importantly, trademark law continues to apply and might prevent copying, in case of a goodwill acquired by the design, and the justification for further exclusiveness is transferred to another field of justification—avoiding customer confusion with respect to origin of goods, and from a consumer protection perspective—maintenance of goodwill and the economic value of brands. The proposition is logical since it relocates each subject matter to its most accurate axis of intellectual property: the merchandising industry of copyrighted works is a branch of industrial applied art, and after a certain period of time, its main force of attraction is not with its unique quality of appearance but with its brand characteristic. Therefore, it should be transferred into the appropriate "pigeonhole" law in the intellectual property realm.

(iii) Improvement on the Unregistered Design Right Introduced in the U.K.

The model proposes an improvement of the unregistered design right introduced in the U.K., one of five options for protecting designs in the U.K., introduced in a 1988 enactment. This right is conferred with no formalities, commencing automatically from first marketing. The eligibility requirement for unregistered design right is "originality." U.K. unregistered design right protects designs from copying, and thus is assimilated to copyright. However, there is a narrower definition of infringing copying. The term of protection is up to ten years. This unregistered design right is aimed to circumvent the inadequacy of protection over films is created, according to the type of use of the film. With respect to public performance, the usual term of protection of fifty years applies from the day of publication. See id. at § 42. With respect to other actions, such as broadcasting and reproduction, the term might be longer. See id. at § 13. See also LAHORE, supra note 8, at § 42.

As one commentator has phrased it, at the heart of the controversy of protecting industrial designs is how to balance two conflicting needs. On the one hand, the need to provide protection so as to reward human endeavour and creativity; on the other, the need to allow competition in the production of articles which fulfill a particular function of purpose. See COPINGER, supra note 5, at 713–714.

According to the basic utilitarian justification for copyright, its aim is to function as an adequate incentive for the creation of works; however, a superfluous incentive is not efficient since it represents the deadweight loss of the exclusive right. See CHAY. S, 1996; Stewart E. Sterk, Rhetoric and Reality in Copyright Law, 94 MICH. L. REV. 1197, 1996; MENGES ET AL., supra note 54, at 1710.

415 For the protection of products design as a trademark, see supra Chapter 5 BTrademark Protection.

416 For the three intellectual property acts, see supra Chapter 3 A. The Location of Design in the Intellectual Property Realm.

417 Id. § 215(4). It is clarified by law that the threshold for design eligibility is above the "not-copied" requirement, since according to the law "a design is not 'original'... if it is commonplace in the design field in question at the time of its creation." See also RUSSELL-CLARKE, supra note 151, at 202, 204-05; PHILLIPS & FIRTH, supra note 247, at 850.

418 Copyright, Designs, and Patents Act (Eng.), supra note 320, at § 23. See also RUSSELL-CLARKE, supra note 151, at 220-21.

419 However, after five years it is subject to a compulsory license scheme. See Copyright, Designs, and Patents Act (Eng.), supra note 320, at § 216.
enactment, through the 1956 enactment and finally in the current 1988 Copyright Act, English law has attempted solve this problem, still without full success.\textsuperscript{428} The question of claiming copyright infringement of the two-dimensional drawing with respect to an act of copying the three-dimensional industrial design arose in the U.K. in two decisions of the House of Lords: the \textit{King Features} holding of 1940 that dealt with copying Popeye the Sailor dolls; and the \textit{British Leyland} holding of 1986 that dealt with the copying of car exhausts. In both cases the alleged infringer copied the three-dimensional product of industrial design, and since the design was not registered, the plaintiff claimed for copyright infringement via \textit{indirect copying} of the two-dimensional drawing which was the basis for the production of the respective industrial design products. In \textit{King Features}, the two-dimensional drawing was the cartoon figure created initially for advertisements; and in the \textit{British Leyland} case the two-dimensional drawing was the technical sketch of a product created in order to enable industrial production.\textsuperscript{429} In both decisions the House of Lords allowed the invocation of copyright protection.\textsuperscript{430} Furthermore, in both cases Parliament reacted by overhauling the statutes, trying to seal the leak in the strict mutual exclusivity rules.\textsuperscript{431}

\textsuperscript{428} See \textit{RUSSELL-CLARKE}, supra note 151, at 14-21; See \textit{COPENGER}, supra note 5, at 723-725.

\textsuperscript{429} \textit{King Features Syndicate, Inc.}, A.C. 417.


\textsuperscript{431} \textit{King Features Syndicate, Inc.}, A.C. 417; \textit{British Leyland Motor Corp.}, A.C. 577.
The Copyright, Design, and Patents Act of 1988, which is the current binding law, sought to fix all previous flaws in the basic principle of excluding copyright from industrial designs, as well as to provide a workable rule for distinguishing the new unregistered design right, assimilated to copyright, from "full" copyright. 443
The tortuous principle of the current English rule might be summarized as follows: 444
First, the law defines two terms: the first is a new one of "design document," which means any two-dimensional record of the design, whether by drawing, written description, photograph, data storage in computer or other. 445 The second term is "design" which for the purpose of the excluding rule means "the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration." 446
Second, the law provides that it is not an infringement of copyright in a design document or in a design (per se), other than an artistic work, to copy the design or to make an article according the design document. 447 Namely, the British Leyland ruling is overturned and it is not a copyright infringement of the underlying drawing of a design to reproduce the three dimensional design. 448 Moreover, the overlapping zones between copyright and design are restricted, since any applied art falling into the vast definition of a design is to be protected either by unregistered or registered design rights. 449 In this respect one must bear in mind that the unregistered design right is actually a copyright restricted to a ten-year term of protection.

Nevertheless, and this is the new complexity of the English rule, the law provides that an "artistic work" will not be excluded from copyright protection. 450 The purpose of this exemption to the exclusion of design form copyright protection is that a design with independent and inherent artistic characteristics will enjoy the dual protection of both copyright and design right. This immediately raises the question of how to recognize these characteristics. Since the answer is bound to be subjective, this new law was criticized as leaving a penumbra of vagueness with respect to basic issues concerning the relation between applied art and industrial design. 451 But if this artistic craftsmanship is multiplied industrially (i.e. more than fifty pieces) then the copyright term of protection is limited to twenty-five years from the date of marketing the design — in other words, the result — not the artist's intent — is the determining test. 452 The law further clarifies that if the artistic work, or part of it, is not exploited industrially, then full copyright term of protection subsists (i.e. life of the author plus seventy years). Only industrial exploitation shortens the term of protection of an artistic work, up to twenty-five years. 453 In those cases in which English law accepts dual protection, the term of protection is unified into the shorter term held in registered design rights. 454 It is also apparent that in those cases in which twenty-five years of copyright protection are conferred, the unregistered design right is "swallowed" into the copyright.455

It is apparent that the new English rule is tortuous, complicated to handle, and adds another complicating legal term — "design document" — in order to solve the already complicated problem at stake. My proposed model is simpler, and reaches a better result: all designs, whatever their aesthetic merit, that are manufactured industrially are protected through a sui generis design right, assimilated to copyright, with a longer term of protection. In the case of an artistic work later oriented industrialized, then the term of protection will be determined by the nature of the alleged infringing act: if industrialized designs are reproduced, then a shorter term of protection will apply, and if copyrightable works are reproduced then a full copyright term will apply. The term "design document" in English law is redundant, since the type of infringement determines whether it is "art" or

443 See CORNISH & J.LEVEY, supra note 39, at 554. Others have proposed a "probability test" between the artistic and functional merits of an article. See RUSSELL-CLARKE, supra note 151, at 266.
444 Copyright, Designs, and Patents Act (Eng.), supra note 320, at § 52(2).
445 Id. § 52(3); RUSSELL-CLARKE, supra note 151, at 257.
446 Copyright, Designs, and Patents Act (Eng.), supra note 320, at § 52(2).
447 See RUSSELL-CLARKE, supra note 151, at 257.
448 See COPINGER, supra note 5, at 724.
449 Copyright, Designs, and Patents Act (Eng.), supra note 320, at § 52.
"design." Furthermore, in the proposed model there are only two potential modes of protection, with only two relevant terms of protection: long copyright or short design right.

C. Concluding Remark - The Timeliness of the Proposed Design Scheme for American Law

As already mentioned, on the eve of the 1976 Copyright Act there was an attempt to legislate a sui generis design law in the United States, however, at the last moment it was withdrawn with the intention of inspecting the whole issue in more depth.\(^{447}\) Thirty years have passed, and the time has come for enacting a design law in the United States. Many things have changed. The American legal discourse has become more internationalistic.\(^{448}\) Several profound developments have occurred in the theoretical and legal arenas in this time. In the theoretical arena, two major relevant developments should be noted: the first is the growing acknowledgement of the economic and sociological role of design, and consequently the need for encouraging and protecting it.\(^{449}\) The second is the growing movement in favor of limiting the scope of intellectual property rights.\(^{450}\) As to the major legal developments: in 1984 the Semiconductor Chip Protection Act was enacted, protecting the visual appearance of semiconductor chips, which are pure functional designs.\(^{451}\) In 1989, the U.S. joined the Berne Convention and consequently introduced some amendments into copyright law, including some nullification of the registration requirement, and furthermore tacitly acknowledges that under the Berne Convention there is no obligation to protect industrial designs via copyright.\(^{452}\) In 1993 the TRIPS Agreement was signed, presenting a loose standard for design protection.\(^{453}\) And in 1998 the VHDPA was enacted, the first experimental legislation for all industrial design.\(^{454}\)

These developments indicate that the current atmosphere in American legal discourse could be receptive to a comprehensive sui generis design law, based on a copyright paradigm.\(^{455}\) The proposed scheme presents both a positive incentive to create designs per se, and at the same time limits the scope of the right in comparison to copyright. Thus, the proposed scheme answers both current theoretical trends - those of enhancing innovation for the benefit of consumer society, and of limiting intellectual property rights. Moreover, such a sui generis design law is permitted according to all international law standards, fits the U.S. enactment trend thus far, and it is a logical and coherent scheme for resolving most of the issues in the seemingly never-ending applied art/industrial design nexus.

6. Summary

The design of products is central to modern economy and its civil-cultural life, but nevertheless, the legal protection over designs in the U.S. has suffered from continuous neglect. One of the reasons for this is that design sits at the crossroads of copyright, patent and trademark, and was believed to enjoy the protection of all three. Yet in reality, although designs have some of the characteristics of all three major intellectual property disciplines, designs do not fit any of them entirely. The result is that designs suffer from inappropriate legal treatment, which is reflected by both under-protection for welcome designs and encumbrances of legal complexities in the three major intellectual property schemes. Therefore, there is an urgent need for a specially tailored, sui generis design law.

How should such sui generis design law be tailored? My clear conclusion is that it should be based on a copyright paradigm, since design is much closer to a creative than inventive endeavor. Design focuses on the appearance of useful products, and is aimed to please customers. Therefore, design is more like “work” than scientific “invention.” However, design is also guided by some eminent features, such as technology, function and fashion, and is based on previous work. The copyright scheme, while fitting some designs perfectly and constraining others greatly, is at best a partial solution, but a necessary model. Strict copyright rules are not appropriate for the design realm, from the long term of

\(^{447}\) See supra note 87.


\(^{449}\) For a discussion with respect to justification for design's protection, see supra notes 24-48 and accompanying text.

\(^{450}\) See supra note 326 and accompanying text.

\(^{451}\) See supra notes 145-150 and accompanying text.

\(^{452}\) See supra notes 292-293 and accompanying text.

\(^{453}\) See supra notes 165-169 and accompanying text.

\(^{454}\) See supra notes 185-187 and accompanying text.

\(^{455}\) There are constant attempts to introduce a new enactment for fashion design, based on the VHDPA model. See, e.g., Design Piracy Prohibition Act, H.R. 2933, 110th Cong. (2007). Though such an enactment is needed, in my view it is better policy to introduce a comprehensive design act and not to add additional subject matter on an accidental basis. The Copyright Office takes no position with respect to the merits of extending design protection to fashion designs, however, if such protection is accepted, then the VHDPA model is an appropriate one since it was initially legislated so as to include other subject matters. See Copyright Office Opinion, supra note 149. In my view, though such enactment is needed, it is a better policy to introduce a comprehensive design act and not to leak in additional subject matters on an accidental basis.
protection, to different doctrines such as moral rights or derivative rights.

To avoid the more restrictive aspects of copyright, then, we must ask how should such *sui generis* design law, based on the copyright paradigm, be segregated from copyright law subject matter? This is the most Gordian debate with respect to the applied art and industrial design nexus. My proposal is to cut through this complexity by adopting a unity of design doctrine, which suggests conferring *sui generis* design protection to both applied art and to industrial design. Namely all designs, whatever their merit or aesthetic quality, will be drawn into the specially tailored law. Such a mechanism is logical, is recommended by policy considerations, simplifies law, and is compatible with all international standards.

Nevertheless, some inevitable exceptions to this mechanism do exist, the most complex of which refers to copyrightable subject matter which was later on industrialized into applied products. This is the "Popeye the Sailor Syndrome," in which, for example, characters from movies or books are later on merchandised with derivative applied products. Should all these derivative products be subject to copyright protection, as the original figure is, or to *sui generis* design protection? This is the heart of the difficulty in divorcing designs from the copyright realm. I propose to resolve this problem with a dynamic and simple rule, according to which the final differentiation between copyright enforcement or *sui generis* design right enforcement will be determined by courts, according to the nature of the alleged infringing act. If the alleged infringer has copied the subject matter in order to produce industrially applied articles, then design right will be enforced. However, if copyrighted works were reproduced, then copyright will be enforced. Practically speaking, the main difference lies in the term of protection, which will be shorter in cases of design protection. And, once again, such a mechanism is logical, is recommended by policy considerations, simplifies law, and is compatible with all international standards.

456 See King Features Syndicate, Inc., A.C. 417.