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Gregory R. Mues

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DUAL COPYRIGHT AND DESIGN PATENT PROTECTION: WORKS OF ART AND ORNAMENTAL DESIGNS

The legislative evolution of copyright and design patent statutes has resulted in an overlapping zone of protection with respect to certain works of art and ornamental designs. A review of legislative history might lead one to conclude that Congress intended to make concurrent coverage available in this narrow band of endeavor. Yet, the same examination might indicate that such overlap was nothing more than the result of inadvertence. Seemingly adopting the latter approach, courts have traditionally denied dual and concurrent copyright and design patent protection for a work qualified under both statutes. By judicial interpretation, the owner of such work has been compelled to choose either a copyright or design patent, his election thereafter barring any alternate coverage.¹

In a recent break with precedent, the Court of Customs and Patent Appeals, in *In re Yardley*,² disregarded the election doctrine, holding that the proprietor of an artistic design for a work of art may, in a proper case, obtain dual copyright and design patent protection. The 1974 *Yardley* decision departed from case law that had survived for 64 years,³ and answered a question avoided by the Supreme Court 20 years earlier.⁴ To fully appreciate the significance of this decision, however, an overview of the development of copyright and patent law is warranted.

DIFFERENTIATING COPYRIGHT AND PATENT PROTECTION

Copyrights and patents are governmental grants of monopolies afforded authors and inventors for their "respective Writings and Discoveries."⁵ Although these grants reward individual contributions, their primary purpose is to foster social and industrial development for the public good. Consequently, Congress was given the power to implement

¹ See, e.g., *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927).

² 493 F.2d 1389 (C.C.P.A. 1974).

³ The judicial doctrine which required the owner of a dual qualifying design to elect either copyright or design patent protection first arose in 1910. See *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150 (C.C.S.E.D. Pa. 1910), *aff'd*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914). See also text accompanying notes 115-19 *infra*.

⁴ In *Mazer v. Stein*, 347 U.S. 201 (1954), the Supreme Court touched upon the election doctrine but refused to decide its validity because the issue was not properly presented for resolution. See text accompanying note 148 *infra*.

⁵ U.S. CONSR. art. I, § 8. See *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127-28 (1932) (copyrights and patents are given as incentives for further productive and ingenious efforts).

these societal concerns by awarding monopolies which would otherwise be contrary to a freely competitive system. As noted by Mr. Justice Reed:

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.⁶

Although at times viewed interchangeably by laymen, a copyright is not the equivalent of a patent.⁷ The rights protected by each are distinct and may be illustrated in the following example. Assume a chemist, having discovered a new chemical mixture which yields a previously unknown curing agent, chooses to write a book detailing his experiments and the relative proportions of the chemicals used. Should the chemist secure a copyright on his book, he would retain the exclusive right to print, reprint, and publish the work. The contents, however, would remain open to public exploitation; the chemist could not prevent others from following his instructions and producing the med-

⁶ *Mazer v. Stein*, 347 U.S. 201, 219 (1954). See also *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543-44 (2d Cir. 1964).

⁷ The substantive and procedural differences between copyrights and patents were outlined in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971). The court explained:

The owner of a patent is granted the exclusive right to exploit for a period . . . [a maximum of fourteen years for design patents] the conception that is the subject matter of the patent. . . . The grant of this monopoly, however, is carefully circumscribed by substantive and procedural protections. To be patentable the subject matter must be new and useful, and represent a nonobvious advance . . . an advance that would not be obvious to a hypothetical person skilled in the art and charged with knowledge of all relevant developments publicly known to that point in time. . . . A patent is granted only after an independent administrative inquiry and determination that these substantive standards have been met. . . . This determination is subject to both administrative and court review. . . .

Copyright registration, on the other hand, confers no right at all to the conception reflected in the registered subject matter. . . . Accordingly, the prerequisites for copyright registration are minimal. The work offered for registration need only be a product of the registrant. So long as it is not a plagiarized copy of another's effort, there is no requirement that the work differ substantially from prior works or that it contribute anything of value. . . . A copyright is secured simply by publishing the work with the required notice . . . and registration is accomplished simply by filing a claim . . . with the Register of Copyrights. . . . There is no administrative investigation . . . of the validity of the claim. A certificate is refused only if the object falls outside the broad category of matter subject to copyright registration. . . . A copyright affords little protection Because the registrant's protection is limited and the social cost therefore small, the life of the copyright is long. . . .

Id. at 740-41 (citations omitted).

See also *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951); *Pellegrini v. Allegrini*, 2 F.2d 610, 612 (E.D. Pa. 1924).

icine for commercial gain.⁸ Had the chemist obtained a patent encompassing the manufacturing process, he would have precluded others from using the process and selling the drug for the term of the grant.

Thus, the copyright protects the *form of expression* of the author's ideas, not the ideas themselves.⁹ As a consequence, the copyright monopoly is limited to "the exclusive right . . . [t]o print, reprint, publish, copy, and vend the copyrighted work . . ." ¹⁰ However, the forms of expression potentially protected by the copyright are not restricted to those manifested in printed books. The applicable statute broadly provides that works subject to copyright "shall include all the writings of an author."¹¹ The breadth of statutory coverage is evidenced by provision for fourteen classes of copyrightable works, including musical compositions, photographs, and motion pictures.¹² Accordingly, in seeking a copyright, the applicant must indicate the class of intellectual endeavor he wishes to protect.¹³

In contrast to the more limited protection of the copyright laws is the complete monopoly granted by a patent to the ingenious labors of an inventor. A patent gives "the right to exclude others from making, using, or selling the invention throughout the United States . . ." ¹⁴ To be patentable, an invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and use-

⁸ See *Baker v. Selden*, 101 U.S. 99, 102-03 (1880).

⁹ See, e.g., *id.*; *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512 (2d Cir. 1945). As has been repeatedly held, there is no copyright available for ideas. See, e.g., *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1139 (6th Cir. 1973). This rule is recognized in the regulations of the Copyright Office, which deny a copyright grant to "[i]deas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing." 37 C.F.R. § 202.1(b) (1974).

¹⁰ 17 U.S.C. § 1 (1970), as amended, 17 U.S.C. § 1(f) (Supp. I, 1971).

¹¹ 17 U.S.C. § 4 (1970). In *Mazer v. Stein*, 347 U.S. 201 (1954), Mr. Justice Douglas, in his dissenting opinion, questioned the constitutionality of granting a copyright to models or designs for works of art. He noted that the Court had never held this classification, along with other classes of copyrightable subject matter, as defined in 17 U.S.C. § 5 (1970), as amended, 17 U.S.C. § 5(n) (Supp. I, 1971), to be within the constitutional ambit of the "writings" of "Authors." Justice Douglas did comment, however, that, prior to *Mazer*, articles such as bookends, clocks, lamps, candlesticks, and piggy banks had been granted copyright registration as works of art. 347 U.S. at 220.

The constitutional scope of the term "writings" has never been directly considered by the Court. In *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), however, the Court held a photograph to be copyrightable. In *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), a chromolithograph, used as a circus advertisement, was found to be within the copyright laws. Thus, it seems that the Court has and will continue to construe the term "writings" very broadly.

¹² See 17 U.S.C. § 5 (1970), as amended, 17 U.S.C. § 5(n) (Supp. I, 1971).

¹³ *Id.* The applicant is to specify in which enumerated class, (a) through (n), he desires to place his work. These specifications, however, "shall not limit the subject matter of copyright as defined in section 4 . . ." *Id.*

¹⁴ 35 U.S.C. § 154 (1970).

ful improvement thereof"¹⁵ Design patents, on the other hand, are not concerned with the mechanical or utilitarian features of a "machine," but rather are granted to one who "invents any new, original and ornamental design for an article of manufacture"¹⁶ Thus, the prime factor in granting a design patent for an article of manufacture is its decorative and eye appeal. The question to be asked is not "what will it do," but "how does it look?"¹⁷

Despite apparent dissimilarities, an area of overlap exists between copyright and design patent protection.¹⁸ This field of coverage appears restricted to a small group of works copyrightable as "works of art; models or designs for works of art."¹⁹ To the extent that the artwork can be applied to an article of manufacture, imparting to it an original, ornamental design, the proprietor may merit dual protection. Qualification for recognition under both schemes seemingly would depend on a determination that the work meets the prerequisites of each statute. The requirements for qualification, however, differ greatly, since each statute protects separate conceptual characteristics.

Copyright Prerequisites

Both the copyright and design patent statutes encompass the protection of aesthetic qualities. Yet, their respective protections are distinct in that "the dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and

¹⁵ *Id.* § 101.

¹⁶ *Id.* § 171 (emphasis added).

¹⁷ *Rowe v. Blodgett & Clapp Co.*, 112 F. 61, 62 (2d Cir. 1901). The Supreme Court, in *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1872), defined the nature of the design patent and the aspects contemplated as patentable:

The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that, not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. . . . And the thing invented or produced, for which the patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. . . . It is the appearance itself . . . that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.

Id. at 524-25. See also *Majestic Elec. Dev. Co. v. Westinghouse Elec. & Mfg. Co.*, 276 F. 676 (9th Cir. 1921); *Baker v. Hughes-Evans Co.*, 270 F. 97 (2d Cir. 1920).

¹⁸ See, e.g., 1 M. NIMMER, *THE LAW OF COPYRIGHT* § 38 (1974). See also note 114 and accompanying text *infra*.

¹⁹ 17 U.S.C. § 5(g) (1970). See, e.g., *In re Yardley*, 493 F.2d 1389, 1394 (C.C.P.A. 1974).

ornamental design for design patents."²⁰ Regulations of the Copyright Office explicitly require that a work of art or a model or design for a work of art be capable of independent existence as a work of art, irrespective of its utilitarian embodiment.²¹ The art value alone comes within the purview of the copyright monopoly.

Aside from independent existence as a work of art, the sole remaining copyright prerequisite is that the item be an original work of its author.²² The work must owe its existence to the creator and be the independent result of his intellectual efforts.²³ Generally, since a copyrightable work need not be unique or novel,²⁴ the quantum of originality that must be present is minimal. The judicial yardstick has been the presence of an independent contribution by the author.²⁵ One court recently stated that "any 'distinguishable variation' resulting from an author's independent creative endeavor will constitute sufficient originality."²⁶ Thus, the originality demanded for copyright pro-

²⁰ *Mazer v. Stein*, 347 U.S. 201, 218 (1954).

²¹ 37 C.F.R. § 202.10(c) (1947) states:

[I]f the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

This statement should be read in conjunction with the Supreme Court's description of the aspects of a utilitarian article. See note 17 *supra*. The design patent contemplates the appearance of the article inseparable from its ornamentation. The copyright, on the other hand, is granted if the design can stand on its own as an autonomous work of art.

²² Neither the Constitution nor the copyright laws mandate originality as a prerequisite to copyrightability. See, e.g., *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971). Although the patent laws define specific elements necessary for a patentable invention or design, the copyright laws do not. Originality seems to have developed as a corollary to the statutory requirement of authorship. In *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), the Supreme Court defined an author to be, in the constitutional sense of the word, "[h]e to whom anything owes its origin; originator; maker" *Id.* at 58.

²³ See, e.g., *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1139 (6th Cir. 1973); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951). See also 1 M. NIMMER, *THE LAW OF COPYRIGHT* § 6 (1974).

²⁴ It has been consistently held that novelty or uniqueness play no role in the determination of copyrightability. The term "authorship" does not require the presence of these qualities. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 218 (1954); *Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir. 1967). Although there have been isolated statements to the effect that copyrightability does entail some measure of novelty, see, e.g., *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971), this does not appear to be the majority position.

²⁵ See, e.g., *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951), wherein the court stated: "[T]o satisfy both the Constitution and the statute . . . the 'author' [must contribute] . . . something recognizably 'his own.'" *Id.* at 103 (footnote omitted).

²⁶ *M.M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1139 (6th Cir. 1973). See also *Best Medium Publishing Co. v. National Insider, Inc.*, 385 F.2d 384 (7th Cir. 1967).

tection would appear to be satisfied if the work is the product of autonomous creative effort. The "creative effort" which a work of art must embody²⁷ would appear to relate to the formative process; the creator must have applied aesthetic principles rather than mechanical ones.²⁸

Design Patent Prerequisites

As the grant of a patent monopoly completely bars the use of the patented article by others, its statutory prerequisites are stricter than those employed with respect to copyrights.²⁹ The prospective patentee must present a device which is novel,³⁰ original,³¹ and nonobvious.³² A

²⁷ The requirement of creativity is found in the regulations of the Copyright Office. "In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form." 37 C.F.R. § 202.10(b) (1974).

²⁸ In *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776 (S.D.N.Y. 1968), the district court discussed the element of creativity as it relates to copyrightable works of art. While originality relates to the author's independent contribution to the artwork, creativity contemplates the nature of the work. Creativity merely refers to the work being artistic in nature and "not supplied through innovations which are solely utilitarian or mechanical." *Id.* at 781. See also 37 C.F.R. § 202.10(a) (1974).

²⁹ See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971); note 7 *supra*. See also *Graham v. John Deere Co.*, 383 U.S. 1, 5-12 (1966) (the stricter tests are necessary to weed out those inventions not meritorious of the exclusive grant so that the growth of commerce will not be retarded).

³⁰ 35 U.S.C. § 102 (1970).

³¹ *Id.* § 101.

³² *Id.* § 103. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court stated that the requirement of nonobviousness means that an invention

which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. . . . If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

Id. at 14.

In *Graham*, the Court considered the test of nonobviousness as applied to mechanical patents. There has been some conflict, however, as to the extent to which the test of nonobviousness is to influence the ultimate grant of a design patent. The conflict centers about 35 U.S.C. § 103 (1970) which, in part, provides:

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

This section is applicable to design patents through § 171.

The Court of Customs and Patent Appeals found difficulty in applying the test of "a person having ordinary skill in the art" in *In re Laverne*, 356 F.2d 1003 (C.C.P.A. 1966). There, the court took a lenient approach toward design patent applications. It reasoned that since most of the work of industrial designing is done by ordinary craftsmen employed as designers, a complete acceptance of mechanical patent prerequisites would bar the grant of design patents to the majority of these works. *Id.* at 1006. Ultimately, the court held that the test of obviousness, as pertaining to designs, was to be made according to the eye of the ordinary intelligent person. The court reasoned that since the test must be a visual one, and since all individuals react differently to appearances, the opinion of the normal observer should determine whether the design was obvious or not. *Id.* The court believed that such a requirement would foster the progress

design patentee must demonstrate, in addition, ornamentability³³ and a primary purpose for the design which is not functional or utilitarian.³⁴ Moreover, the use of inventive faculties in the conception of a patentable design has been judicially demanded.³⁵ This element of inventiveness must extend to the article's ornamentability and appearance,³⁶ the traditional standard of inquiry being whether the ordinary observer can distinguish novelty in its appearance.³⁷

Originality, as it relates to designs, is not satisfied by the copyright standard of independent creation by the designer. Instead, this requirement contemplates a design entirely new and not known before.³⁸ Furthermore, the prerequisites of inventiveness, novelty, and originality are not satisfied by the presence of new mechanical functions.³⁹ On the contrary, if the article owes its pleasing appearance to these mechanical functions, the design patent should not be issued.⁴⁰

of industrial designs. *Id.* at 1006. *Accord*, *Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.*, 444 F.2d 295 (9th Cir. 1971); *In re Schilling*, 421 F.2d 747 (C.C.P.A. 1970).

In reaching its decision, the *Laverne* court construed § 171 as distinguishing design and invention patents. Thus, the court concluded it was the legislative intent to treat the two differently. 356 F.2d at 1005. This reasoning, however, contradicts the language of § 171, which provides: "The provisions . . . relating to patents for inventions shall apply to patents for designs, except as otherwise provided." 35 U.S.C. § 171 (1970). There is in fact no provision that excepts design patents from the literal operation of the § 103 requirement of nonobviousness. *See* §§ 101-03.

In *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265 (3d Cir. 1972), the ordinary intelligent person test was rejected. In *Hadco*, the Third Circuit pointed out that, insofar as the issue of obviousness is concerned, the law for both design and invention patents is the same. The court could not reconcile the statutory interpretation of the *Laverne* court. Rather, the Third Circuit noted: "[A]ny basic change in present standards and requirements should be by appropriate legislative reform rather than judicial fiat." *Id.* at 1272.

It now appears that the literal requirement of nonobviousness, as construed in *Graham*, is applied when testing the validity of design patents. *See* *Fields v. Schuyler*, 472 F.2d 1304 (D.C. Cir. 1972).

³³ *See* *Barofsky v. General Elec. Corp.*, 396 F.2d 340, 342 (9th Cir. 1968).

³⁴ *See id.* *See also* *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265, 1269 (3d Cir. 1972).

³⁵ *See, e.g.*, *Frantz Mfg. Co. v. Phenix Mfg. Co.*, 457 F.2d 314 (7th Cir. 1972), wherein the court stated:

[A] patented design, like the subject matter of a mechanical patent, must embody invention. The purpose of the statute is to reward, and thereby to encourage, creative artistic activity rather than mere changes of detail which may produce "novelty" but do not reflect "invention."

Id. at 327.

³⁶ *See* *Hopkins v. Waco Prods., Inc.*, 205 F.2d 221, 223 (7th Cir. 1953) ("A mechanical patent must disclose inventive novelty and utility—a design patent inventive originality in design and ornamentation").

³⁷ *See* *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265, 1272 (3d Cir. 1972), wherein the court held that the ordinary observer test is to be utilized in weighing the novelty and ornamentation of a design for an article of manufacture.

³⁸ *See, e.g.*, *Hopkins v. Waco Prods., Inc.*, 205 F.2d 221, 223 (7th Cir. 1953).

³⁹ *See* *D. Klein & Son, Inc. v. Giant Umbrella Co.*, 341 F. Supp. 1400, 1403 (S.D.N.Y. 1972).

⁴⁰ *See* *Barofsky v. General Elec. Corp.*, 396 F.2d 340, 342 (9th Cir. 1968). It should

Infringement

Parallel to the wide variance existing between the requirements of copyrightability and patentability is the difference in establishing infringement of either monopoly. This is partially a result of the lenient standard of originality in copyright law. Theoretically, two cartographers could set out separately to capture the geography of the same area. If both men were perfectionists, each would produce an identical map. Yet, the map maker who published second would not have infringed the copyright of his previously published colleague since each map was the independent creative work of its respective author.⁴¹ Consequently, a multitude of valid copyrights may exist, each having the same or nearly identical subject matter and format. No question of infringement need ever arise if each work product has been independently created.⁴²

To establish a claim of copyright infringement, a plaintiff must prove that the defendant had access to the allegedly copied work⁴³ and that substantial similarity exists between the forms embodying plaintiff's and defendant's labors.⁴⁴ When direct evidence of access is unavailable, courts have allowed an inference of access to be drawn from striking similarities between the contested works.⁴⁵ Despite the availability of this inference, proof of infringement remains difficult because the standard of substantial similarity is "of necessity vague."⁴⁶ This vagueness is compounded by the fact that the infringement of artwork entails copying not the idea itself, but the expression of the idea⁴⁷ as viewed by the ordinary observer.⁴⁸ Accordingly, any attempt

be noted, however, that the mere presence of a new mechanical function will not invalidate or foreclose a design patent. Such protection will be afforded where the inventive faculty relates to the ornamentation design and is distinguishable from mechanical functions. See *Hopkins v. Waco Prods., Inc.*, 205 F.2d 221, 223 (7th Cir. 1953).

⁴¹ See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104 n.21 (2d Cir. 1951).

⁴² *Id.* at 103. Since it is much easier to establish the copyright requirement of originality, a copyright should be less susceptible to an infringement claim than a comparable attack on a patent. See I M. NIMMER, *THE LAW OF COPYRIGHT* § 10.1 (1974). Because the burden of establishing an infringement is necessarily high, clearly the copyright affords lesser protection than does a patent. *Id.*

⁴³ See, e.g., *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

⁴⁴ See, e.g., *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966).

⁴⁵ See *Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir. 1967). See also *Arnstein v. Porter*, 154 F.2d 464, 468-69 (2d Cir. 1946). Although similarity may lessen the burden of showing access, the reverse is not true. Therefore, strong evidence that the defendant had access to the allegedly infringed work will never lessen the burden of showing substantial similarity. See *Williams v. Kaag Mfrs., Inc.*, 338 F.2d 949, 951 (9th Cir. 1964).

⁴⁶ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

⁴⁷ *Id.*

to establish substantial similarity between artistic works where one is allegedly a copy must overcome the obstacles created by varying individual aesthetic sensitivities.

Where the claim is one of design patent infringement, the burden of proof is not as great. This result follows naturally from the higher burden met by the patentee in obtaining his grant. The test for infringement is whether the ordinary observer may be misled into buying the infringing article because of its like appearance to the patented design.⁴⁹ Unlike his copyright counterpart, the patentee-plaintiff is not required to establish access and copying. Instead, a designer, like an inventor, is charged with knowledge, actual or constructive, of all prior designs.⁵⁰ Therefore, an independently created design, though nonactionable as a copyright infringement, may nonetheless represent an infringement of a prior design patent.⁵¹

Based on the distinctive protection provided by copyright and design patent statutes, the desire for dual and concurrent coverage has arisen. Such protection is particularly apt where an artistic design can be easily divorced from the host article and readily applicable to other items of differing utilitarian function.⁵² Under these circumstances, an inventor-designer could initially copyright his artistic design. Having done so, he might incorporate the design into a number of serviceable articles, such as vases, pitchers, goblets, dishes, or ashtrays. Assuming

⁴⁸ Under this test, the bona fide copyrightee would be protected from nearly exact reproductions of his art because the ordinary observer would not be required to examine the copy for minute differences. If the overall artistic appeal of the original and the counterfeit appear the same to this ordinary observer, then infringement would be found. "[U]nless he set out to detect the disparities, [h]e would be disposed to overlook them, and regard their *aesthetic appeal as the same*. That is enough . . ." *Id.* (emphasis added). See also *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966); *Williams v. Kaag Mfrs., Inc.*, 338 F.2d 949, 951 (9th Cir. 1964).

⁴⁹ As stated by the Court in *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1872):

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. at 528.

⁵⁰ See *Hadco Prods., Inc. v. Walter Kidde & Co.*, 462 F.2d 1265 (3d Cir. 1972), wherein the court stated: "It is basic that the patentee, as a designer, is chargeable with a comprehensive knowledge of . . . prior art." *Id.* at 1274. See also *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).

⁵¹ See 1 M. NIMMER, *THE LAW OF COPYRIGHT* § 10.1 (1974).

⁵² See, e.g., *Mazer v. Stein*, 347 U.S. 201 (1954). The copyrighted statuettes of male and female Balinese dancers therein used as electric lamp bases could have well been used in other articles such as bookends, vases or candelabras. In *In re Yardley*, 493 F.2d 1389 (C.C.P.A. 1974), the petitioner's patented design for a watch face was patented without the hour numerals printed on the design. Therefore, this design could be applied to other items as well.

the design imparts inventive ornamentality to any or all of these items design patent protection could then be sought.

Unfortunately, the traditional election approach prohibited the inventor from proceeding in the foregoing manner. While recognizing the existence of an overlapping zone encompassing works of art, courts nevertheless refrained from granting monopolies in both the copyright and patent spheres.⁵³ Thus, when considering registration of a work, copyrightable due to its artistic merit and patentable as a result of its commercially useful inventive ornamentation, the creator would be compelled to forego one realm of coverage in order to obtain the other. Responding to this incongruity and finding no statutory or policy mandate for the foreclosure of one monopoly in the presence of another, *In re Yardley*⁵⁴ rejected the election doctrine.

In re Yardley: JUDICIAL DEMISE OF THE ELECTION DOCTRINE

At issue before the Court of Customs and Patent Appeals in *Yardley* was a rejection of a design patent application for a novelty watch face. Accompanying its application to the Patent Office examiner, Yardley submitted a drawing depicting a caricature of former Vice President Spiro Agnew with arms extended as hour and minute hands. Omitted from the drawing, however, were the hour numerals. In affirming the rejection of the examiner, the Patent Office Board of Appeals found the design to be "obvious."⁵⁵ Moreover, noting that Yardley had previously registered the design for the watch face with the Copyright Office, the Board held that he was barred under the election doctrine from obtaining a design patent grant.⁵⁶

In reversing the Board's decision, the court first considered the issue of obviousness. The prior work consisted of a design patent issued for the "Breger" design. This, too, was an ornamental watch face design depicting a person with extended arms employed as hour and minute hands.⁵⁷ Unlike the Yardley design, the Breger work included hour numerals and a circular second hand feature. In considering both designs, the court noted that the human figure could be represented

⁵³ See, e.g., *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927).

⁵⁴ 493 F.2d 1389 (C.C.P.A. 1974).

⁵⁵ *Id.* at 1390-91. See 35 U.S.C. § 103 (1970); note 32 *supra*.

⁵⁶ The fact of the prior copyright registration was made known to the patent examiner by copies of newspaper advertisements which Yardley had attached to his brief. The advertisement showed the watch face and bore a copyright notice, "© 1970 The Novelty Watch Co.," and a further notice of "Pat. pend." 493 F.2d at 1391-92.

⁵⁷ Although the caricature on the Breger design was not specifically identifiable, the slick black hair, bulging eyes, the legs spread at 90 degrees in a type of ludicrous dance step, and the 1930 vintage of the design tends to bring Eddie Cantor to mind. See 493 F.2d at 1390.

in various ways, subject to obvious changes in "facial, body, and dress characteristics,"⁵⁸ and that these traits, individually, could be made to predominate according to the designer's will. The court did not concur with the Board's ruling that Yardley's design was obviously derived from the Breger watch face. Although the concept may have been similar, it was the different appearance that controlled.⁵⁹

Having determined that patent protection was otherwise available, the court next reversed the Board's denial of the patent application because of the prior copyright registration.⁶⁰ In challenging the validity of the election doctrine, the court framed two questions. First, the court considered whether there existed an area of overlap between the copyright and design patent laws wherein a work could qualify for registration under either statute.⁶¹ Second, assuming an affirmative answer to the initial question, the court asked whether the owner could secure both a copyright and a design patent.⁶²

Relying on prior case law and statutory language, the court had no difficulty in finding the requisite area of overlap.⁶³ With regard to

⁵⁸ *Id.* at 1392.

⁵⁹ The court appears to have completely overlooked the test of obviousness under § 103. See note 32 *supra*. While the questions of ornamentality and appearance are to be considered through the eyes of the ordinary observer, the question of obviousness is answered by relating the work to a designer of ordinary skill in that particular art. The question then becomes whether it would be obvious for a watch face designer to incorporate on the face a caricature of a noted personality of the day, *i.e.*, Spiro Agnew. This type of design work is apparently an old technique, exemplified by the Mickey Mouse watch, although the latter might be distinguishable as a fictitious character. Moreover, as the Second Circuit has noted "[i]n such crowded competitive fields as that of ornamented wrist watches it would seem well nigh impossible to produce anything which can fairly be considered new invention, or a real advance over prior art." *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 642 (2d Cir. 1958) (Clark, C.J., dissenting).

⁶⁰ 493 F.2d at 1393. The court noted that the Novelty Watch Company, Yardley's assignee, had registered the watch face pursuant to 17 U.S.C. §§ 5(b) & (g) (1970). It was the registration under the overlapping band of dual protection existing within subsection (g), *see* text accompanying note 19 *supra*, that caused the appeals board to reject the design on the basis of the doctrine of election. *See In re Blood*, 23 F.2d 772 (D.C. Cir. 1927).

It appears that the design would also have been denied dual protection if a design patent had first been secured. In addition to the doctrine of election, the Copyright Office regulations provide that a copyright shall not be registered if a prior design patent has been obtained. *See* 37 C.F.R. § 202.10(b) (1974).

⁶¹ 493 F.2d at 1393.

⁶² *Id.*

⁶³ The statutory phraseology of 17 U.S.C. § 5(g) and 35 U.S.C. § 171 (1970) indicated a congressional intent to recognize a class of works protectable under both schemes. Moreover, prior to *Yardley*, the Court of Customs and Patent Appeals had held the area of overlap to exist. *See In re Deister Concentrator Co.*, 289 F.2d 496, 500 n.2 (C.C.P.A. 1961), wherein the Supreme Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954), was cited as the highest judicial recognition of the existence of the overlap. *See also* text accompanying notes 114-31 *infra*.

the second issue, however, a less secure basis for decision was utilized. In answering the second inquiry affirmatively, the court drew support from the absence of a statutory command to the "author-inventor" to elect either one of the available monopolies. Noting the statutory overlap and the failure by Congress to expressly mandate a choice of coverage, the court deemed the doctrine of election to be contrary to congressional intent.⁶⁴ Furthermore, dismissing the Commissioner's contention that election was required since the framers of the Constitution distinguished authors and inventors, the court held that the Constitution no more mandated election than did the acts of Congress.⁶⁵

The court, in removing any continuing viability from the election doctrine, rejected the argument of the Commissioner of Patents that this case was governed by the Supreme Court's decision in *Sears, Roebuck & Co. v. Stiffel Co.*⁶⁶ *Sears* held that when the patent term expires, so does the owner's monopoly. Thereafter, the public has the right to reproduce the article as previously patented.⁶⁷ In *Yardley*, the Commissioner contended that upon expiration of the design patent, a continuing copyright would prevent the public from acting in the manner contemplated in *Sears*. Finding *Sears* inapplicable in that it did not deal with dual copyright and design patent protection,⁶⁸ the court refused to deny the design patent solely because a copyright would persist on the artistic subject matter when the patent expired.⁶⁹

In reaching its decision, the *Yardley* court unfortunately failed to expressly denote the different aspects of the creation respectively contemplated by the copyright and design patent. Yet, differentiating the zones of protection is vital to reconciling the grant of both monopolies. While copyright coverage extends to the purely artistic qualities of a creation, the design patent encompasses its commercial ornamental values.⁷⁰ Notwithstanding the court's failure to distinguish the respective qualities safeguarded by each statute, the *Yardley* reasoning remains convincing in view of the apparent intent of Congress to create over-

⁶⁴ 493 F.2d at 1394. The court noted that since the doctrine was founded in dicta, no "positive legal authority" existed for its support. *Id.* at 1395. See also note 119 *infra*.

⁶⁵ 493 F.2d at 1395.

⁶⁶ 376 U.S. 225 (1964).

⁶⁷ *Id.* at 230.

⁶⁸ The question in *Sears* was whether a state's unfair competition laws could prohibit the copying of an article which was not covered by either a federal patent or copyright, the issue being one of federal law preemption. *Id.* at 227-28.

⁶⁹ Although not specifically stated, the *Yardley* court implied that one federal statute could not preempt another without specific congressional authorization. This would lead one to conclude that the court considered federal statutes as existing in *pari-materia*, to be applied as such in the absence of any express hierarchy of one over the other. See generally 172 N.Y.L.J. 90, Nov. 7, 1974, at 1, col. 1.

⁷⁰ See, e.g., text accompanying notes 129-32 *infra*.

lapping coverage without a corresponding statutory requirement of election. A review of the relevant legislative changes to the initial copyright and design patent laws over the years should evidence that an overlapping band of protection was specifically intended and was not the result of congressional oversight.

LEGISLATIVE EVOLUTION OF COPYRIGHT AND DESIGN PATENT OVERLAP

Congress is empowered by the Constitution "[t]o 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"⁷¹ Since the word "respective" prefaces the two fields of endeavor, one might conclude that the draftsmen of the Constitution intended separate protection for the "exclusive right" of "Authors" to their "Writings" and that of "Inventors" to their "Discoveries."⁷² Indeed, Charles Pinckney and James Madison seemed to advocate that independent coverage be afforded the labors of authors and inventors.⁷³ Significantly, the two fields of endeavor, although mentioned in a single clause in the Constitution, have been advanced under divergent bodies of legislation.⁷⁴ Despite this apparent intent to separate, however, a readily discernible area of overlapping coverage has crept into the statutory scheme.

Design Patent Evolution

The concept of a design patent developed from a need to halt the commercial piracy of ornamental designs incorporated into useful articles of manufacture.⁷⁵ The articles themselves may have been of com-

⁷¹ U.S. CONST. art. I, § 8.

⁷² There is case law supporting this construction. See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 100 (2d Cir. 1951). However, the Court of Customs and Patent Appeals in *Yardley* construed this language as not mandating election since subsequent acts of Congress provided for an overlapping zone of protection. 493 F.2d at 1393-94.

⁷³ In a letter to the Convention, Mr. Madison urged:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right at common law. The right to useful invention seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals.

THE FEDERALIST NO. 43, at 288 (J. Cooke ed. 1888). See also Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L.J. 109 (1929).

⁷⁴ Congress, in implementing this provision, recognized that the framers of the Constitution had merged two separate definable monopolies into one clause. See, e.g., H.R. REP. NO. 1923, 82d Cong., 2d Sess. 4 (1952); S. REP. NO. 1979, 82d Cong., 2d Sess. 3 (1952).

⁷⁵ See Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. OFF. SOC'Y 380 (1948) [hereinafter cited as Hudson].

mon usage and knowledge, *e.g.*, spoons or forks, and therefore not worthy of a mechanical patent, which at one time was the sole protection available.⁷⁶ Yet, the manufacturer of these implements may have used his inventive genius in designing their shape, configuration, or ornamentation so as to present an attractive article for sale. Nevertheless, since the designer of these ornate utensils was without statutory protection, his design could be freely copied by others less talented. The designer was thereby deprived of the fruits of his labor.⁷⁷

The destruction of incentive and the accompanying adverse impact on industry caused by this piracy were brought to the attention of Congress in 1841 by then Commissioner of Patents Ellsworth. In his report, the Commissioner advised:

The law . . . should embrace alike the protection of new and original designs for a manufacture of metal or other material, or any new and useful design for the printing of woollens, silk, cotton, or other fabric, or for a bust, statue, or bas-relief, or composition in alto or basso-relievo. All this could be effected by simply authorizing the Commissioner to issue patents for these objects, under the same limitations and on the same conditions as govern present action in other cases.⁷⁸

In response to this proposal, Congress, in 1842, enacted the first design patent statute, including almost verbatim, the definitional classes of patentable designs set forth by Commissioner Ellsworth.⁷⁹

⁷⁶Such was the protection afforded by the first patent statute, which in relevant part provided:

[U]pon the petition of any person . . . to the Secretary of State, the Secretary for the department of war, and the Attorney General of the United States, setting forth, that he . . . invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used . . . it shall . . . be lawful . . . for . . . letters patent to be made out in the name of the United States . . . for any term not exceeding fourteen years

Act of April 10, 1790, ch. 7, § 1, 1 Stat. 109.

⁷⁷See *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1872).

⁷⁸Hudson, *supra* note 75, at 381.

⁷⁹The Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543 in pertinent part provided:

Any citizen . . . or alien . . . who by his . . . own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture . . . who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application . . . to the Commissioner of Patents . . . and the Commissioner . . . may grant

Understandably, the question arises as to why the subject matter of applied art found initial protection under the patent rather than the copyright laws. One commentator has suggested that the answer lies in the ultimate use of this applied art and the source of the suggested need for the design patent statute.⁸⁰ At the time the first design patent legislation was enacted, copyright protection was reserved to works of purely intellectual or fine art value.⁸¹ On the other hand, the existing mechanical patent statutes were devoted to the furtherance and protection of industrial advancement. Thus, since the purpose of applied designs was commercial enterprise, it was reasonable that regulation fall under the patent laws.⁸² Additionally, it should be noted that it was the recommendation of the Commissioner of Patents, and not the Register of Copyrights, which informed Congress of the problem.⁸³

Through legislation enacted in 1870, the potential for overlapping copyright and design patent protection became apparent.⁸⁴ This potential developed, in large part, from the presence of the word "useful" as employed in both the 1842 and 1870 design patent statutes.⁸⁵ Courts were in disagreement as to whether the term "useful" was to be construed in its usual sense, *i.e.*, something of utilitarian operation, or whether it meant merely that the design must have ornamental value.⁸⁶

a patent therefore, as in the case now of application for a patent . . . the duration of said patent shall be seven years

⁸⁰ See Hudson, *supra* note 75, at 383.

⁸¹ See Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124. In the Trade Mark Cases, 100 U.S. 82 (1879), the Supreme Court delineated the scope of copyright coverage by noting, "The writings which are to be protected are *the fruits of intellectual labor . . .*" *Id.* at 94 (emphasis in original). See also *J.L. Mott Iron Works v. Clow*, 82 F. 316, 318 (7th Cir. 1897).

⁸² See Hudson, *supra* note 75, at 383.

⁸³ *Id.*

⁸⁴ Section 71 of the 1870 Act, dealing with design patents, provided in relevant part:

[A]ny person who . . . has invented or produced any new and original design for a manufacture, bust, statue . . . or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof . . . may, upon . . . due proceedings . . . as in cases of inventions or discoveries, obtain a patent therefor.

Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209.

⁸⁵ In the 1870 statute "useful" appeared in the context of "any new, *useful*, and original *shape or configuration of any article of manufacture . . .*" *Id.* (emphasis added). In the 1842 version "useful" appeared as "any new and *useful pattern, or print, or picture*, to be . . . worked into or . . . on . . . any article of manufacture" Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543.

⁸⁶ If the term was given its usual meaning, conceivably there would have been an encroachment by the design patent law into the field of mechanical patents. The question of dual design and mechanical patentability raises an issue parallel to that presented in this Note. Two interesting articles discussing this matter are Megley, *Design and Mechanical Patents Relating to the Same Subject Matter*, 44 J. PAT. OFF. Soc'y 309 (1962),

Any existing conflict in interpretation⁸⁷ was resolved by the Supreme Court in *Gorham Co. v. White*.⁸⁸ Rejecting the more conventional meaning of the term, the Court upheld the interpretation given in a prior Patent Commission decision⁸⁹ that the legislative intent was strictly to reserve design patents for those works imparting ornamental beauty to articles of manufacture. Since *Gorham*, courts have consis-

and Gambrell, *Mechanical and Design Inventions: Double Patenting Rejections and the Doctrine of Election*, 45 N.Y.U.L. REV. 441 (1970).

⁸⁷ The troublesome word was given the more conventional interpretation in *Ex parte Bartholomew*, 1869 Dec. Com. Pat. 103. Commissioner of Patents Fisher believed that to deny a patent to a utilitarian design because it rendered no pleasing ornamentation to the article and yet, to hold a design, having no utilitarian value patentable merely because of its artful effect would be an absurdity. *Id.* at 105. This view ignored the fact that new and useful utilitarian features were intended to be the subject of mechanical patents. However, other cases followed this logic. *See, e.g., Ex parte Crane*, 1869 Dec. Com. Pat. 7 (Commissioner Foote construed the 1842 statute to embrace designs for utility as well as designs relating to ornamentation); *Ex parte Fenno*, 1871 Dec. Com. Pat. 52 (Acting Commissioner Duncan found that a design for a stove pipe damper, hidden from view inside the flue pipe, was entitled to a design patent even though if it was within open sight it would not be ornamental).

The contrary position was taken in *Ex parte Parkinson*, 1871 Dec. Com. Pat. 251. *See note 89 infra.*

⁸⁸ 81 U.S. (14 Wall.) 511, 524 (1872). *Gorham* involved design patent infringement suit brought under the 1842 statute. Nevertheless, the Supreme Court decisively construed the design patent law as extending only to the inventive ornamental or aesthetic design of an article of manufacture. *See note 17 supra.*

Smith v. Whitman Saddle Co., 148 U.S. 674 (1893), was decided on the basis of the 1870 statute where "useful" had been interposed in modification of "shape or configuration of any article of manufacture." *See note 84 supra.* In *Whitman Saddle*, the Court seemed to modify the *Gorham* ruling by stating: "where a new and original shape or configuration of an article of manufacture is claimed, its utility may be also an element for consideration." *Id.* at 678.

This apparent broadening of the *Gorham* decision, because of the position of the word "useful" in the 1870 statute, did not mean, however, that design patents had any viability in the realm of utilitarian function. The Court of Appeals for the District of Columbia recognized this distinction in *In re Tournier*, 1901 Dec. Com. Pat. 306. The *Tournier* court cited *Whitman Saddle* as introducing functional utility as an element to be considered, but merely for the purpose of deciding whether a design merits a patent in a close case:

We do not . . . understand the [*Whitman Saddle*] Court as intending to go further than this, and to hold that functional utility is to be regarded as a controlling or even an essential element in a patent for a design. For if so, the design patents would virtually be placed upon the same footing . . . [as] patents for mechanical inventions.

Id. at 308.

The impact of *Whitman Saddle* has, however, lost virtually all of its force through supervening legislation and subsequent case law rulings. *See notes 39-40 supra* & 94 *infra.*

⁸⁹ *Ex parte Parkinson*, 1871 Dec. Com. Pat. 251, wherein the Commissioner ruled:

The legislature never intended by this section to let down the standard for patents. It was never contemplated to grant a design patent for every possible change of form that might be given to a machine or article of manufacture. By "article of manufacture," as used in this section, the legislature evidently meant only ornamental articles, articles used simply for decoration.

Id. at 252.

tently foreclosed all aspects of mechanical utility when considering the patentability of a design.⁹⁰

The interpretation of the word "useful" as meaning artistic or pleasing to the sight constituted a major step in the development of dual protection for artistic works since, at this juncture, both copyrights and design patents contemplated aesthetic qualities only. This evolution continued when the design patent law was again modified in 1902. The 1902 Act,⁹¹ which mirrors today's design patent definitional section,⁹² used language of a more generic character, and thus was thought to encompass all works Congress intended to be patentable as designs.⁹³ More significantly, the term "useful" was eliminated. Instead, "ornamental" was substituted, thereby evidencing a legislative intent to restrict the influence of mechanical utility when considering the grant of a design patent. Since design patents now related to the aesthetic aspects of a design,⁹⁴ this change operated as a further catalyst in the ultimate realization of common protection.

Copyright Evolution

To encourage and protect the writings of authors, Congress enacted the first copyright legislation in 1790.⁹⁵ This Act, while limiting

⁹⁰ See, e.g., *Rowe v. Blodgett & Clapp Co.*, 112 F. 61 (2d Cir. 1901); *Westinghouse Elec. & Mfg. Co. v. Triumph Elec. Co.*, 1900 Dec. Com. Pat. 219.

⁹¹ Act of May 9, 1902, ch. 783, § 1, 32 Stat. 193. This statute provided:

Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others . . . before his invention thereof may . . . by . . . due proceedings . . . as in cases of inventions or discoveries . . . obtain a patent therefor.

⁹² 35 U.S.C. § 171 (1970).

⁹³ See *Hudson*, *supra* note 75, at 389.

⁹⁴ There was some debate over the choice of a word to replace the term "useful." The Patents Committee had suggested that the term "ornamental" be used in lieu of "artistic." See *id.* Commissioner Allen, in his report to the Patents Committee, noted:

[I]f the present bill [S. 4647] shall become law the subject of design patents will occupy its proper philosophical position in the field of intellectual production, having upon the one side of it the statute providing protection to mechanical constructions, and upon the other side the copyright law, whereby objects of art are protected, reserving to itself the position of protecting objects of new and artistic quality pertaining however, to commerce, but not justifying their existence upon functional utility. If the design patent does not occupy this position there is no other well defined position for it to take.

S. REP. NO. 1139, 57th Cong., 1st Sess. (1902), reprinted in *Hudson*, *supra* note 75, at 390-91.

The term "ornamental" was eventually chosen to replace "useful," since the word "artistic" was subject to different meanings under the mechanical and design patent laws. See H.R. REP. NO. 1923, 82d Cong., 2d Sess. 6 (1952). Moreover, the change to "ornamental" also carried forward the original intent underlying the first design patent law of 1842. See *Ex parte Knothe*, 1903 Dec. Com. Pat. 42.

⁹⁵ Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124.

the definition of "writings" to "any map, chart, book or books,"⁹⁶ granted to the author "the sole right and liberty of printing, reprinting, publishing and vending . . . for . . . fourteen years."⁹⁷ Although this initial legislation failed to include a generic definition of copy-rightability, subsequent statutes expanded the original definitional scope.⁹⁸

As part of the major revision of the copyright and patent laws in 1870, additional materials were set forth as falling within the realm of copyright protection.⁹⁹ Moreover, an overlapping zone of protection arose, since both the copyright and design patent revisions made provision for statues.¹⁰⁰ However, dual coverage was foreclosed for "models or designs," since the copyright statute provided that in order to be copyrightable, such items must have been "intended to be perfected as works of the fine arts."¹⁰¹ Therefore, to the extent that "models or

⁹⁶ *Id.*

⁹⁷ *Id.* The term was renewable for an additional fourteen years at the election of the author, should he be living upon the expiration of the original period. *Id.*

⁹⁸ Under the 1802 statute, etchings, engravings, and designs for historical prints were added to the list of copyrightable matter, Act of April 29, 1802, ch. 36, § 2, 2 Stat. 171. It is of interest that this statute extended its protection to "every person . . . who shall invent and design, engrave . . . or from his own works and inventions, shall cause to be designed . . . any historical or other print . . ." *Id.* Such language was confusing as it was more germane to a patent statute.

This expansive trend continued in 1831 when "musical compositions" were included. Act of Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436. The requirement that historical prints be "invented or designed" was retained in this statute. Additionally, the copyright term was extended from 14 to 28 years. *Id.* But the 14 year renewal term was retained. *Id.* § 2.

In 1856, dramatic compositions were included, and thus, playwrights and their theatrical enterprises were brought within the copyright sphere. Act of Aug. 18, 1856, ch. 169, § 1, 11 Stat. 138. Artistic photography was recognized in 1865 when Congress supplemented the definitional scope with "photographs and the negatives thereof." Act of Mar. 3, 1865, ch. 126, § 1, 13 Stat. 540.

⁹⁹ Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198. This new definitional section provided:

[T]he author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts . . . shall . . . have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others

Id.

¹⁰⁰ Section 86, governing copyrights, spoke of statues and statuary, *see id.*, while the design patent section stated that a monopoly was available for "any new and original design for a manufacture, bust, statue . . ." *Id.* § 71.

¹⁰¹ *See* note 99 *supra*; Pogue, *Borderland Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 42 (1953). It would appear that Congress included this qualification in recognition of the fact that design patents were intended to protect the industrial application of artistic designs, whereas the copyright law had traditionally been limited to works of a purely intellectual nature. The requisite of intended use in the fine arts, therefore, was an attempt to reserve the copyright for purely artistic endeavor.

designs" were intended to be incorporated into an "article of manufacture," design patents represented their only available means of protection.

Four years later, a further step was taken to prevent potential double coverage. Section 3 of the 1874 Act extended the utilitarian "intended use" sanction to engravings, cuts, or prints when applied to pictorial illustrations.¹⁰² If such illustrations were intended for commercial purposes, their proprietor was foreclosed from a copyright and had to register under the patent laws.¹⁰³ This legislative attempt to prevent simultaneous coverage was rendered less effective, however, when the Supreme Court construed the 1874 statute as not precluding copyright protection for advertising posters containing artistic prints.¹⁰⁴ In weakening the "intended use" test, the Court noted: "Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use — if use means to increase trade and to *help make money*."¹⁰⁵ By so holding, the Court permitted the author to utilize a work of fine art for commercial gain without subjecting the work to loss of copyright protection. This judicial inroad of the copyright into the commercial sphere, previously occupied solely by the design patent, provided a significant step forward in the ultimate realization of dual coverage.

Under copyright legislation enacted in 1909, the forerunner of today's copyright definitional provision,¹⁰⁶ the statutory overlap came to fruition. Pursuant to section 5 of the Act, there was no longer any requirement that models or designs for works of art be perfected as works of fine art.¹⁰⁷ This deletion indicates that Congress sought to

¹⁰² Act of June 18, 1874, ch. 301, § 3, 18 Stat. 79. This section provided:

[I]n the construction of this act, the words "Engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office.

¹⁰³ *Id.*

¹⁰⁴ See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

¹⁰⁵ *Id.* at 251. (emphasis added). The limitation placed on the "intended use" test appears to be that the test is not failed if the engraving, cut, or print has the effect of helping to make money. The Court reasoned that the limiting phrase, *i.e.*, "connected with the fine arts," only qualified the term "works." *Id.* at 250. Hence, a work may be connected with the fine arts, have commercial use, and still not be precluded from a copyright. The Court noted that "[a] picture is none the less a picture, and none the less a subject of copyright that it is used for an advertisement." *Id.* at 251.

¹⁰⁶ 17 U.S.C. § 5 (1970).

¹⁰⁷ Act of Mar. 4, 1909, ch. 320, § 5, 35 Stat. 1076.

The Copyright Act of 1909 also expanded the scope of copyrightable subject matter. Of significance was the additional provision that those subjects listed as copyrightable were not exhaustive but rather, were specific examples. *Id.* This was interpreted as introducing a generic sense to the definition of a copyright.

depart from the prior safeguards against overlapping coverage and to expand the field of copyrightable works to include applied designs.¹⁰⁸ Indeed, subsequent legislative amendments, extending copyrightability to "prints or labels used for articles of merchandise,"¹⁰⁹ evidence the congressional intent to discard the "fine art" intended use prerequisite.

Contrary to Congress' apparent intent, however, regulations adopted by the Copyright Office shortly after the passage of the 1909 Act contained the stipulation that no copyright would be granted if there was a utilitarian purpose for the work of art.¹¹⁰ Nevertheless, consistent judicial refusal to bar copyright protection because of the presence of such intent forced the Copyright Office to relax its position.¹¹¹ Today, the present regulation takes no utilitarian purposes or

Also expanding the available coverage was § 4 of this statute which defined a copyright to "include *all the writings of an author.*" *Id.* § 4 (emphasis added). The Supreme Court had previously interpreted the word "writings," in *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), as including photographs. The term was meant to encompass all the literary productions of authors including "all forms of writing . . . by which the ideas in the mind of the author are given visible expression." *Id.* at 58. Thus, *Burrow-Giles* considerably broadened the constitutional scope of copyrightable material now embodied in § 4.

In reporting out the bill that finally resulted in the 1909 Act, the subcommittee noted, with respect to § 4, that "works" might have been used instead of "writings" because of the very broad sense in which the courts had interpreted "writings." Nevertheless, it was decided to maintain "writings" in the statute because the word was found in the Constitution. This retention, however, was not intended to narrow the broad judicial interpretation previously given the term. See H.R. REP. No. 2222, 60th Cong., 2d Sess. 10 (1909). See also S. REP. No. 6187, 59th Cong., 2d Sess. 4 (1907).

¹⁰⁸ Testimony given before the Committee on Patents, relative to the passage of the bill, is indicative of the congressional intent to extend copyright protection to applied designs. See *Hearings on § 6330 and H.R. 19853 Before Comm. on Patents*, 59th Cong., 1st Sess. 11 (1906) (testimony of Librarian of Congress).

¹⁰⁹ Act of July 31, 1939, ch. 396, § 2, 53 Stat. 1142. See also H.R. REP. No. 70, 76th Cong., 1st Sess. 1 (1939); S. REP. No. 793, 76th Cong., 1st Sess. 1, 2 (1939), which indicate the clear congressional intent to overrule the 1874 legislation that required such pictorials to be registered in the Patent Office if used as articles of manufacture.

¹¹⁰ Specifically, the early regulation stated:

12(g) *Works of art.* This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture). *Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.* No copyright exists in toys, games, dolls, advertising, novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or any similar articles.

Regulation 12(g), reprinted in Pogue, *Borderland Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 44 (1953) (emphasis added).

¹¹¹ The 1939 version of regulation 12(g) recognized that, as to artistic drawings, the copyright grant was to be made in recognition of the artistic qualities of the drawing. Future use for utilitarian gain would not preclude the copyright of the drawing. The rule stated:

The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented, depends upon action under the patent law; but registration in the Copyright Office has been made to protect

intent into consideration provided the item may be classified as a work of art. The regulation provides:

This class [works of art] includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.¹¹²

These successive legislative enactments, expanding copyright protection to include artistic works having commercial application and patent coverage to encompass ornamental designs, evidence substantial legislative thought and deliberation. The slow evolutionary process itself would seem to rebut any argument that the overlapping aspect of the patent and copyright laws was the result of congressional inadvertence. Indeed, it would appear reasonable to conclude that Congress sought to provide separate protection for the artistic and the commercial ornamental values of the same work. Accordingly, the concurrent protection extended by the *Yardley* court appears consistent with this [congressional intent].

Although an overview of legislative history would seemingly justify the *Yardley* decision, prior courts steadfastly refused to grant dual coverage. Generally, these older decisions rested on the fear that such protection would eventually be detrimental to the public good.¹¹³ A review of the pertinent cases will illustrate a gradual judicial movement away from this restrictive approach, culminating in the *Yardley* rationale.

JUDICIAL DENIAL OF CONCURRENT COVERAGE

Establishing the Election Doctrine

After enactment of the Copyright Act of 1909, the existence of an overlapping zone was judicially recognized.¹¹⁴ Nevertheless, dual

artistic drawings notwithstanding that they may afterwards be utilized for articles of manufacture.

37 C.F.R. § 201.4(b)(7) (1939).

¹¹² *Id.* § 202.10(a) (1974).

¹¹³ See text accompanying notes 122-32 *infra*.

¹¹⁴ See *Korzybski v. Underwood & Underwood, Inc.*, 36 F.2d 727 (2d Cir. 1929) (in action for copyright infringement, copyright was denied validity because of prior design patent grant); *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927) (denial of a design patent application because of prior copyright registration); *William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264 (W.D. Pa. 1951) (action based on breach of trust in the use of an uncopyrighted and unpatented design); *Jones Bros. Co. v. Underkoffler*, 16 F. Supp. 729 (M.D. Pa. 1936) (action in copyright infringement); *Louis DeJonge & Co. v. Breuker & Kessler Co.*, 182 F. 150 (C.C.S.E.D. Pa. 1910), *aff'd*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914).

At the same time, it has been held that there is no overlap between copyright and

registration was disallowed, and the individual was permitted to proceed under only one of the statutory schemes. This "doctrine of election" was first enunciated in *Louis De Jonge & Co. v. Breuker & Kessler Co.*¹¹⁵ The plaintiff had copyrighted a small painting, depicting branches of sprigs of holly, mistletoe, and spruce, which was reprinted on seasonal wrapping paper. Seemingly infringing on plaintiff's statutory right, defendant copied this design on its own wrapping paper. In defense of its action, the defendant claimed the design was not copyrightable because of its utilitarian use. It was argued that a copyright should be limited to pure works of art, and that this design, to be properly protected, should have been patented.¹¹⁶

The court rejected the defendant's contentions and held that a copyright could not be found invalid merely because the author put his labor to utilitarian use. Such utilization did not make the painting any less a work of art and it was the artistic aspect which was meant to be protected by the copyright.¹¹⁷ The court further stated that the design might have been eligible, in addition, for a patent, thereby acquiring the protection of both statutory schemes.¹¹⁸ Inexplicably, however, the court decided that if the owner was entitled to either monopoly, he could not procure both. The *De Jonge* court rationalized:

The method of procedure, the term of protection, and the penal-

mechanical patents. In *Taylor Instrument Co. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943), plaintiff brought a copyright infringement suit for the copying of its blank recording charts that were fitted into its patented recording and measuring instruments. The court held that the chart was a mechanical element of the recording device and was not itself a means of passing on information to the public; the chart itself neither taught nor explained any art or process. Thus, the blank chart was not copyrightable. *Id.* at 100.

The absence of any overlap between copyright and mechanical patents was reaffirmed in *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir. 1947), a suit against the Register of Copyrights regarding the copyrightability of recording charts. Here also the question turned on the fact that these charts did not themselves teach or explain any art. The court stated that "[a]rticles intended for practical use in cooperation with a machine are not copyrightable." *Id.* at 911. Further, the court noted that "[b]oth law and policy forbid monopolizing a machine except within the comparatively narrow limits of the patent." *Id.*

It is clear that the court was limiting its remarks to copyrights and mechanical patents because the word "machine" was used. Nevertheless, both *Taylor Instrument* and *Brown Instrument* have caused some confusion where enterprising defendants have attempted to apply the precedent of these two cases to the copyright versus design patent issue. See, e.g., *Stein v. Expert Lamp Co.*, 188 F.2d 611 (7th Cir. 1951).

¹¹⁵ 182 F. 150 (C.C.S.E.D. Pa. 1910), *aff'd*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914).

¹¹⁶ 182 F. at 150.

¹¹⁷ The court relied upon *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). See text accompanying notes 104-05 *supra*.

¹¹⁸ 182 F. at 151.

ties for infringement, are so different that the author or owner of a [work] that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision.¹¹⁹

The rationale underlying the election doctrine surfaced in *In re Blood*,¹²⁰ wherein the plaintiff was denied a patent for his design of a hosiery ticket since the design had been previously copyrighted. This factual situation was similar to *Yardley* in that both protections were sought in the same sequence. Citing *De Jonge* as controlling, the Court of Appeals for the District of Columbia recognized that the applicant was feasibly entitled to either grant, but that the prior copyright barred a subsequent patent.¹²¹ The court reasoned that the election doctrine was necessary, because allowance of both protections "would result for all practical purposes in an extension of the design monopoly."¹²² Unfortunately, the court ventured no reason as to why undue extension of the patent monopoly would result.

Despite the lack of explanation for this supposed fear, there is some available support for the proposition that monopolies would be prolonged at the public's expense should dual coverage be permitted. The basis for judicial apprehension and the resultant election doctrine may well be found in *Baker v. Selden*,¹²³ an 1880 Supreme Court decision. In *Baker*, the complainant had copyrighted a series of publications which described a system of bookkeeping utilizing ledger columns and headings. The defendant's system was similar, but employed a somewhat different arrangement. Alleging an infringement, the complainant argued that the copyright gave him the exclusive use of the system described in his books.¹²⁴

In rejecting this argument, the *Baker* Court held that where copying of copyrighted materials is for purposes of use, rather than for explanation, no infringement occurs.¹²⁵ Of more significance to the

¹¹⁹ The court in *Yardley* noted that the *DeJonge* election doctrine was merely dicta. In *DeJonge*, relief was ultimately denied because the plaintiff had failed to comply with the statutory requirements as to copyright notice. The court's statements as to design patentability and overlap were unnecessary to its decision. Subsequently, the Supreme Court affirmed the result based upon the question of copyright notice. No opinion by the Court was rendered as to the doctrine of election. See *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150 (C.C.S.E.D. Pa. 1910), *aff'd*, 191 F. 35 (3d Cir. 1911), *aff'd*, 235 U.S. 33 (1914).

¹²⁰ 23 F.2d 772 (D.C. Cir. 1927).

¹²¹ *Id.*

¹²² *Id.*

¹²³ 101 U.S. 99 (1880).

¹²⁴ *Id.* at 101.

¹²⁵ *Id.* at 103. The Court stated:

[W]here the art it teaches cannot be used without employing the methods and

present discussion, however, is dicta found within the opinion. As to artistic models and designs, works which come within the overlapping coverage, the Supreme Court refused to apply the permissive use rule. The Court stated:

Of course, [this rule is] not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said that their form is their essence, and their object the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition as are the lines of the poet or the historian's periods.¹²⁶

The doctrine of election, therefore, may be viewed as an outgrowth of judicial recognition that ornamental or aesthetic designs are afforded a high degree of protection under the copyright laws. If a designer obtained a patent for his creation, upon expiration of the patent the public would be free to copy the design in every detail. However, if a copyright was also granted and still in effect at the termination of the patent, the public would be prohibited from copying, even if the copying was for "use."¹²⁷ Thus, the argument is made that if the designer acquires a patent, giving him the exclusive right to use, manufacture, and sell the design, a concurrent or subsequent copyright would for all practical purposes amount to an extension of the design monopoly.¹²⁸

diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Id.

See also *Muller v. Triborough Bridge Auth.*, 43 F. Supp. 298 (S.D.N.Y. 1942). Plaintiff copyrighted a drawing showing a new type of bridge approach to be used as a means of unsnarling traffic. The defendants built an approach based upon plaintiff's copyrighted design. The court, finding no infringement, said *Baker* controlled. For a more recent discussion of the use issue, see *Scholz Homes, Inc. v. Maddox*, 379 F.2d 84 (6th Cir. 1967).

¹²⁶ 101 U.S. at 103-04. Subsequently, lower courts have consistently held that three-dimensional reproductions of copyrighted models or designs for works of art, even though for use, constitute a copyright infringement. See, e.g., *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (2d Cir. 1934). *But cf.* *Fulmer v. United States*, 103 F. Supp. 1021 (Ct. Cl. 1952).

¹²⁷ See *In re Yardley*, 493 F.2d 1389, 1395 (C.C.P.A. 1974) (argument of the Commissioner of Patents). The term of protection under a design patent is generally shorter than that under copyright registration. Compare 35 U.S.C. § 173 (1970), with 17 *id.* § 24, as amended (Supp. III, 1973).

¹²⁸ Perhaps this is the reasoning which underlies the regulation of the Copyright Office disallowing the grant of a copyright if there has been a prior design patent issued on the work of art.

The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented

This reasoning is insufficient to justify the election mandate. *Ted Arnold Ltd. v. Silvercraft Co.*¹²⁹ is, perhaps, illustrative of the point. There, a pencil sharpener in the form of an antique telephone casing was held to be copyrightable as a work of art since its artistic quality had an independent existence.¹³⁰ Assuming, *arguendo*, that the design was patentable as well, during the life of the patent others would be prevented from applying this ornamental design to an article of manufacture. Upon the expiration of the design patent, the design would be free for public use. The remaining copyright would only protect the owner from the slavish copying of his antique casing and any noticeable variation in a similar casing would foreclose a copyright infringement claim.¹³¹ Accordingly, the persisting copyright, limited to its protection of pure art and constrained by the high burden of proof of infringement, would not effectively extend the total monopoly of a design patent. The copyright, rather than extending the design patent, would provide no more protection than if the design patent had not been initially obtained.¹³²

Despite its apparent lack of necessity, courts continued to follow the election doctrine. In *Korzybski v. Underwood & Underwood, Inc.*,¹³³ plaintiff obtained a patent and later brought suit for infringement of a pending copyright on the same work. The court, utilizing a different rationale for the election rule, held that, apart from the monopoly granted under the patent, the prior design patent application constituted a public disclosure of the art contained in the design. The court reasoned, therefore, that such disclosure barred the subsequent copyright grant since no copyright would be available for the original text of a work already in the public domain.¹³⁴

design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.

37 C.F.R. § 202.10(b) (1974). There is no statutory basis for this regulation other than the broad power given to the Register to promulgate regulations.

¹²⁹ 259 F. Supp. 733 (S.D.N.Y. 1966).

¹³⁰ Copyrightability in cases where pure art resides in a utilitarian host article depends upon whether the pure art can stand apart. See 37 C.F.R. § 202.10(c) (1974); text accompanying note 21 *supra*.

¹³¹ See text accompanying note 26 *supra*.

¹³² The actual absence of danger was recognized by an eminent writer on the subject:

While in doubtful cases the Courts will hold that, presumptively, the fact that a given work is patentable is ground for holding it is not copyrightable and vice versa it seems that *there is no rule of law nor is there any consideration of public policy which will prevent the issuance of both a copyright and a patent to cover the same work in its different aspects*

J. WEIL, COPYRIGHT LAW 84-85 (1917) (emphasis added).

¹³³ 36 F.2d 727 (2d Cir. 1929).

¹³⁴ *Id.* at 729. This holding seems to provide good argument for the subsequent bar

The persisting judicial adherence to the election rule is difficult to justify. In each instance, the particular court had no problem in differentiating the separate aspects of the work respectively contemplated by the copyright and design patent statutes. These cases consistently held that the utilitarian use of a copyrightable design would neither bar nor render an existing copyright void.¹³⁵ Why the courts recognized that it was the art value protected by the copyright, irrespective of any utilitarian ornamentation, and yet demanded election cannot be fully comprehended.¹³⁶

Mazer v. Stein — Relaxing the Election Doctrine?

The impact of the election doctrine was lessened by a series of cases culminating with the Supreme Court's decision in *Mazer v. Stein*.¹³⁷ The Steins were the owners of copyrights on artistic statuettes of male and female Balinese and Egyptian dancers, their intention being to fit the items with threaded mounting stubs for the adaption of electrical sockets. Thus fitted, the statuettes were to become decorative lamp bases. Alleging copyright infringement, the Steins contended that the defendants' lamps incorporated copies of the Steins' copyrighted artistic bases.

In two lower court decisions, the defendants prevailed upon the theory that the Steins sought to protect by means of copyright a utilitarian lamp, rather than an artistic statue. Such protection was not contemplated by the copyright law.¹³⁸ In holding for the defendants,

of the alternate monopoly. The force of this case appears diluted, however, in light of the prevalent view that the mere filing of a work in a public record does not of itself constitute disclosure. *See, e.g., Douglas Int'l Corp. v. Baker*, 335 F. Supp. 282 (S.D.N.Y. 1971); *Marvin Worth Prods. v. Superior Films Corp.*, 319 F. Supp. 1269 (S.D.N.Y. 1970). Patent application filing is usually the result of governmental command and is not a matter of choice. The general rule is that, to relinquish the right to a copyright, publishing must be an act of free will, not one of compulsion. *See* 1 NIMMER, *THE LAW OF COPYRIGHT* § 58.3 (1974).

Cases subsequent to *Korzybski* continued to breathe vitality into the election doctrine. *See, e.g., William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264 (W.D. Pa. 1951); *Jones Bros. v. Underkoffler*, 16 F. Supp. 729 (M.D. Pa. 1936).

¹³⁵ *See, e.g., William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, 95 F. Supp. 264 (W.D. Pa. 1951):

The plaintiff's design *being novel and original* could have been the subject of a design patent. . . . Furthermore, the plaintiff would have been entitled . . . to invoke the protection of the copyright laws . . . since the creation would fall within the terms of the Copyright Act . . . as [a work] of art

Id. at 267 (emphasis added).

¹³⁶ *See* text accompanying notes 117-19 *supra*.

¹³⁷ 347 U.S. 201 (1954).

¹³⁸ In *Stein v. Expert Lamp Co.*, 96 F. Supp. 97 (N.D. Ill.), *aff'd*, 188 F.2d 611 (7th Cir.), *cert. denied*, 342 U.S. 829 (1951), the defendants asserted that since the statuettes were intended for utilitarian use, they were removed from the traditional concept of art. *Expert Lamp* contended that plaintiffs' should have sought design

the courts misinterpreted a Copyright Office regulation which defined artistic craftsmanship as copyrightable to the extent of its form but not its utilitarian aspects.¹³⁹ Each decision construed the regulation as having no bearing on works primarily intended for commercial enterprise.¹⁴⁰ Other unrelated decisions dealing with the Steins' copyright properly upheld plaintiffs' infringement claims. The courts recognized that the works sought to be protected were the statuettes and not the lamps. The copyrightability of these figures was held not to be lost merely because they were used as "dress" for utilitarian objects.¹⁴¹

patent protection. 96 F. Supp. at 98. The district court agreed and construed *Baker v. Selden*, 101 U.S. 99 (1880), as allowing *Expert Lamp* to copy the statuary for use as a lamp base. 96 F. Supp. at 98. This holding, however, clearly conflicted with the express exception for works of art carved out by the *Baker* Court. See text accompanying notes 123-26 *supra*. Furthermore, despite prior judicial recognition, the court noted that no overlap existed between the copyright and the design patent laws. This dictum, based on *Taylor Instrument Co. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943), appears misplaced, as *Taylor Instrument* recognized the absence of overlap between copyright and mechanical patents. See note 114 *supra*.

On appeal, the Seventh Circuit sustained the lower court's decision, agreeing that there should be no copyright protection for an article of manufacture. 188 F.2d at 612. The Steins asserted that it was not the lamps they sought to copyright, but rather the artistic bases apart from their utilitarian embodiment. *Id.* The appellate court nonetheless found the lamp to be the item sought to be copyrighted. In the court's view, if the Steins desired to protect a lamp, the proper avenue would have been the procurement of a design patent. *Id.* This viewpoint was evident in the court's statement that "[w]e . . . are not persuaded that a design of an electric lamp may be protected as a monopoly by means of copyright registration, registered without an examination as to originality, novelty or inventiveness." *Id.*

In *Stein v. Benaderet*, 109 F. Supp. 364 (E.D. Mich. 1952), *vacated*, 214 F.2d 822 (6th Cir. 1954), although the district court fully recognized that the copyright protected the artistic bases only, it followed the *Expert Lamp* intended-use test. Reasoning that the copyright was invalid because of the intended commercial use, the court held that the appropriate protection was a design patent. 109 F. Supp. at 366.

¹³⁹ 37 C.F.R. § 202.10(a) (1974).

¹⁴⁰ See, e.g., *Stein v. Benaderet*, 109 F. Supp. 364, 366 (E.D. Mich. 1952), *vacated*, 214 F.2d 822 (6th Cir. 1954).

¹⁴¹ In *Stein v. Rosenthal*, 103 F. Supp. 227 (S.D. Cal. 1952), *aff'd*, 205 F.2d 633 (9th Cir. 1953), the district court explicitly rejected the intended-use test espoused in *Expert Lamp*. 103 F. Supp. at 231. As the court aptly stated: "To uphold this argument would be to require the judicial inquiry to plumb the mind of every copyright proprietor and determine his plans and intentions at the time of registration. This impossibility is not contemplated by the Statute." *Id.*

In affirming this result, the Ninth Circuit discussed in more detail the overlapping region between copyrights and design patents. The court strongly suggested that a given work could embody the requisites of both schemes, and that nothing in either the copyright or design patent laws would exclude the operation of the other. The court expressly stated:

We do not read the design patent law as stronger or prevailing over the copyright law, hence we are of the opinion that when the creator of the statuettes was granted copyright privileges as to them, such privileges became rights and cannot be affected by a speculation that possibly the objects could have been patented as designs [T]here is nothing in the design-patent laws which excludes a work of art from the operation of the copyright laws.

205 F.2d at 635.

In *Stein v. Mazer*, 111 F. Supp. 359 (D. Md.), *rev'd*, 204 F.2d 472 (4th Cir. 1953),

Although none of the Stein cases directly concerned the issue of overlap, the clear thrust of the decisions illustrated that the copyright validity of artistic craftsmanship was to be determined by divorcing the artistic value from the utilitarian article. If such value could be found in and of itself, the utilitarian ornamentation secondarily imparted to an article, such as a lamp, was not material to the operation of the copyright law.

The Supreme Court granted certiorari in *Mazer v. Stein*¹⁴² in order to resolve the conflict with respect to the validity of the Steins' copyright. The issue framed for the Court was whether the copyright law would protect an artist who intended to mass-produce his work of art as part of a utilitarian article. The petitioners contended that when such an artist becomes a manufacturer, his work passes out of the realm of copyright. Any further protection the artist might desire would be subject to the tests of the design patent law.¹⁴³

Mr. Justice Reed, after reviewing the statutory history of copyrights, rejected petitioners' assertions and concluded that the utilitarian use of the statuettes did not bar their copyrightability as works of

aff'd, 347 U.S. 201 (1954), the district court believed that the Steins were claiming that it was unlawful for the defendant to use the copyrighted statuary as bases for table lamps. The court did not consider the work of art exception to the *Baker* rule and found for the defendant, implying that the Steins erred in not seeking a design patent. Clearly, the district court erroneously believed the work sought to be protected was the lamp. This opinion is difficult to justify since the Register of the Copyright Office testified that it was the practice of the Copyright Office to disregard any utilitarian feature or intended commercial use in considering registration, 111 F. Supp. at 362-63.

The Fourth Circuit reversed and carefully distinguished the differing nature of copyrights and design patents. The court noted that the copyright does not protect a particular subject, but rather the treatment of the subject. Moreover, this appellate court framed the true issue running throughout the series of cases:

[T]he issue is not whether a design of an electric lamp may be protected as a monopoly by means of a copyrighted registration. Rather, the issue is whether a copyrighted statue may be *copied* irrespective of its use as a statue or as a component part of an electric lamp, or any other article of manufacture.

204 F.2d at 475. The Fourth Circuit dismissed the reasoning of *Expert Lamp* and *Benaderet* and relied heavily upon the testimony of the Register of Copyrights as to the actual intent of the Copyright Office Regulations. *Id.* at 476: This court decided that the copyright of the statuettes barred their unauthorized copying in the medium of a utilitarian article. As the court lucidly stated:

[A] copyright does not purport to give to the copyrightee any rights to the mechanical or utilitarian uses of a work of art. A copyright does, however, protect the work of art *qua* work of art without regard to any functional use to which it might be put.

Id. at 471. The court, however, expressly refused to discuss the question of copyright and design patent overlap. *Id.* at 480.

¹⁴² 347 U.S. 201 (1953).

¹⁴³ *Id.* at 205. The registration of the statue, coupled with its use as a lamp base, was claimed to be an illicit attempt to monopolize the manufacture of the lamps. *Id.* at 206.

art.¹⁴⁴ Although the Court expressly declined to decide whether the statuettes were also patentable,¹⁴⁵ the respective protection given by each scheme was distinguished.

Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea — not the idea itself [C]opyright protects originality rather than novelty or invention. . . . Thus, respondents may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such or as incorporated in some other article.¹⁴⁶

Thus, the Steins did not possess a monopoly on the use of dancing figures as lamp bases. Others, merely by manufacturing alternate figures, could have reaped the fruits of the Steins' idea without incurring liability. The Steins' copyrights only prevented the copying of their artistry.¹⁴⁷

Although the question of election was not in issue, the Court lessened the harshness of the doctrine by stating:

Though other courts have passed upon the issue as to whether . . . the election of the author or patentee of one bars a grant of the other, we do not. We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.¹⁴⁸

It is readily apparent, therefore, that the Court recognized the exist-

¹⁴⁴ *Id.* at 218.

¹⁴⁵ *Id.* at 217. One court has held that a statuette, mounted on and part of an ashtray, was not patentable because of the absence of invention in the design. *Frankart, Inc. v. Apt Novelty Co.*, 57 F.2d 757 (S.D.N.Y. 1931).

¹⁴⁶ 347 U.S. at 217-18.

¹⁴⁷ This reasoning aids greatly in determining the validity of the concurrent protection existing in *Yardley*. The Spiro Agnew watch face copyright would give the copyrightee no monopoly over the manufacture and sale of watches bearing the caricature of political personalities. Other caricatures, capable of equal commercial success, could be used. The import of *Mazer v. Stein* is that the copyright law grants no monopoly over an article of manufacture that may embody the artistic component or ornamentation. The mere copying of the artwork is the only actionable infringement contemplated by the statute.

¹⁴⁸ 347 U.S. at 217. This statement seems to vitiate the effect of the Copyright Office regulations that foreclose copyright protection to a previously patented design if the design patent should subsequently be held invalid. See 37 C.F.R. § 202.10(b) (1974). Furthermore, although the Court did not pass on the validity of the election doctrine, its language dilutes the full force of the doctrine in that if an election is made and the choice subsequently invalidated, resort to the alternate scheme would not be barred. The Supreme Court's statement lessens the blow of the election by not binding the "author-inventor" to a bad choice.

tence of a zone of overlap, holding that patentability and copyrightability were not mutually exclusive. Left unanswered, however, was the question whether an individual must choose only one of the two schemes open to him.

Different facets of the decision can be combined to suggest the probable resolution of this unanswered question. Based on *Mazer*, it is apparent that a copyright protects its owner from the plagiarism of the original aesthetic form or expression. The validity of this protection extends only to the art without regard to its utilitarian function. Accordingly, the aspects protected by the copyright and design patent are distinct. For the copyright, it is original pure art *divorced from* any utilitarian embodiment, while for the design patent, it is inventive artistic ornamentation *applied to* commercial endeavor.¹⁴⁹ Such analysis, coupled with the holding that copyrights and design patents are not mutually exclusive, would lead one to conclude that the Court, under proper circumstances, would sanction dual protection.¹⁵⁰

Subsequent to *Mazer v. Stein*, judicial treatment of the overlapping zone of protection has been rare. The only decision prior to *Yardley* seemingly concerned with the question of dual protection is *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*,¹⁵¹ where both design patent and copyright infringement were claimed. Although the district court ultimately found that there was no enforceable copyright, the court saw nothing wrong with concurrent reliance on both claims.¹⁵²

¹⁴⁹ See text accompanying note 146 *supra*.

¹⁵⁰ It is of interest that the Register of Copyrights filed a brief as *amicus curiae* in the Supreme Court. 347 U.S. at 202. In urging the Court to affirm the Fourth Circuit validation of the Steins' copyrights, the Register argued that the copyright should be upheld regardless of the fact that this could lead to situations where designers might be entitled to either statutory protection. The Register also asserted that the availability of one class would not preclude the other.

¹⁵¹ 155 F. Supp. 932 (S.D.N.Y. 1957), *rev'd on other grounds*, 260 F.2d 637 (2d Cir. 1958).

¹⁵² The court stated:

The law as to the relationship between copyright and design patent claims is in an unsettled state [citing *Mazer v. Stein*] . . . and patent counsel are to be commended in seeking for their clients protection under both heads upon the theory that protection under one or the other may be upheld by the courts.

155 F. Supp. at 936. This statement is indicative of the impact of the Supreme Court's dilution of the election doctrine.

On appeal, the district court's upholding of the plaintiff's design patent claim was reversed and remanded for further proceedings on the question of anticipation in the design. *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958). However, in dictum, the Second Circuit recognized the viability of dual protection, stating: "[W]e do not think that a copyright which is not enforceable, even though it may be theoretically in existence, is an obstacle to securing and enforcing a patent." *Id.* at 642.

The *Yardley* ruling thus represents a culmination of growing judicial acceptance of dual protection. Prior to *Yardley*, the stage had been set for the end of the election doctrine. Courts had moved from the enunciation of the doctrine in *In re Blood*,¹⁵³ to its more detailed examination in the Stein cases¹⁵⁴ and finally to the *Mazer v. Stein*,¹⁵⁵ holding that copyright and design patent protections are not mutually exclusive. It is now clear that copyright validity is to be considered apart from utilitarian use while design patent viability can only be considered in conjunction with commercial application. Moreover, the inquiry under each consideration can only be answered by resort to different tests — the relaxed standard of original creative endeavor for the copyright and the stringent demands of invention, novelty, and nonobviousness for the design patent. If a given work can pass muster in both of these vastly different settings, then dual protection should follow.

CONCLUSION

Yardley represents the first direct judicial acceptance of concurrent protection. The court properly determined that there are no sound statutory or judicial reasons why an artist-inventor should be denied the respective rewards owing to the distinctive aspects of his work, each reward being "commensurate with the services rendered."¹⁵⁶ Indeed, the doctrine of election seems contradictory to the avowed purpose of both the copyright and design patent laws. Both statutes seek to foster the use of the intellect in devising new forms of art and commercial ornamentation. There would be no incentive for the artist-inventor to strive for gains in both spheres if he knew that dual protection was foreclosed. This injustice has been laid to rest by the *Yardley* logic that neither statute contemplates those aspects protected by the other and that both can exist concurrently in a model or design for a work of art, provided the necessary requirements of each scheme are met.¹⁵⁷

¹⁵³ 23 F.2d 772 (D.C. Cir. 1927).

¹⁵⁴ See notes 138-41 and accompanying text *supra*.

¹⁵⁵ 347 U.S. 201 (1954).

¹⁵⁶ *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

¹⁵⁷ *Yardley* is not the first instance where both concurrent copyright and design patent protection has existed. See *Wilson v. Haber Bros., Inc.*, 275 F. 346 (2d Cir. 1921). In *Wilson*, the subject of both a copyright and a design patent was a doll known as "kewpie." The plaintiff alleged both copyright and design patent infringement. The defendant, however, was precluded from contesting the validity of either because of a prior consent decree signed by the defendant conceding that both the copyright and design patent were valid. This case preceded *In re Blood*, 23 F.2d 772 (D.C. Cir. 1927), but was not mentioned in the *Blood* opinion. Perhaps the effect of *Wilson* had not yet been fully understood.

Although a prospective dual copyrightee-design patentee can now operate within the framework of both statutes, *Yardley* may be a hollow victory. Patent prerequisites are comparatively easier to establish for mechanical hardware than for ornamental designs. A reason for this lies in the nature of design. Although definition is difficult, a design has been described in the following terms: "The essence of a design resides, not in the elements individually, nor in their method of arrangement, but . . . in that indefinable whole that awakens some sensation in the observer's mind."¹⁵⁸ This highly subjective quality has been recognized by the Supreme Court.¹⁵⁹ Thus, it seems inappropriate to apply the same objective tests, readily discernible in hardware, to works of a purely aesthetic nature. Nevertheless, the tests of novelty, inventiveness, and nonobviousness must be met before a design patent will issue.¹⁶⁰

As a result, it has become extremely difficult to obtain a design patent. Over the past 20 years, the number of design patents issued per year has remained relatively static.¹⁶¹ However, the number of mechan-

¹⁵⁸ *Pelouze Scale & Mfg. Co. v. American Cutlery Co.*, 102 F. 916, 918 (7th Cir. 1900).

¹⁵⁹ *See Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 524 (1872).

¹⁶⁰ The opinion offered in *In re Laverne*, 356 F.2d 1003 (C.C.P.A. 1966), would, in theory, be more hospitable to the encouragement of commercial designs. There, the court, in refusing to apply the literal requirements of nonobviousness to designers, stated:

We cannot equate them with the mechanics in the mechanic vs. inventor test for patentability. The test . . . must be applied in a way which will implement the legislative intent to promote progress in the field of industrial design by means of the patent incentive.

Id. at 1006. *See* note 32 *supra*. The basic subjective nature of a design was again relied on by the Ninth Circuit in *Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.*, 444 F.2d 295 (9th Cir. 1970). In following the reasoning of *Laverne*, the court noted that because all individuals react differently, the test is of necessity nonobjective and, as such, the "determination of patentability in design cases must finally rest on the subjective conclusion of each judge." *Id.* at 300, *quoting In re Bartlett*, 300 F.2d 942, 944 (C.C.P.A. 1962).

For those creations falling in the present overlapping band, the subject matter of both copyright and design patent relates to aesthetic appeal. *See Umbreit, A Consideration of Copyright*, 87 U. PA. L. REV. 932, 934 (1939). In view of this underlying common aspect, it has been suggested that there may have been a fundamental error in incorporating designs into the patent laws in the first instance. *See Williams, Copyright Registration of Industrial Designs*, 7 J. PAT. OFF. SOC'Y 740 (1925) [hereinafter cited as Williams]. As noted previously, incorporation of design protection under patent laws was the result of a plea from the Commissioner of Patents and the fact that in 1842 the sole existing protection for such commercial ventures was granted in patents. *See Hudson, supra* note 75, at 383. Former Commissioner of Patents Allen, in speaking before the congressional committee concerning the passage of the 1902 design patent statute, viewed the design patent as occupying a middle ground between copyright and mechanical patent. *Id.* at 390-91. Of course, for all intents and purposes, Congress, by statutorily applying all of the tests for mechanical patents to design patents, effectively removed the design patent from its "philosophical" middle ground where it was thought to be proper. *See* 35 U.S.C. § 171 (1970).

¹⁶¹ 1972 COMM'R OF PATENTS ANN. REP. 13 (Table 4).

ical patents has doubled in the same period of time.¹⁶² The number of copyrights for subjects in the overlapping zone has also grown.¹⁶³ This retardation in the number of design patents issued indicates that the advancement of ornamental designs for commercial articles is being hindered, rather than helped, by the prospective patentee having to meet the burdens of the patent system.

Due to the minimum use of design patent protection, the repeal of the design patent law has often been suggested.¹⁶⁴ Coupled with this cry for repeal, proposed reforms, aimed at mitigating the rigors of design protection, have been recurrent.¹⁶⁵ For the present, however, *Yardley* offers the correct conceptual approach for acquiring both copyright and design patent protection, despite the practical obstacles involved.¹⁶⁶

Gregory R. Mues

¹⁶² *Id.*

¹⁶³ The number of copyrights registered for works in the overlapping band has risen from 5200 in 1967-1968 to 7400 in 1971-1972. 1972-1973 REGISTER OF COPYRIGHT ANN. REP. 15.

¹⁶⁴ See Williams, *supra* note 160.

¹⁶⁵ In the period from 1914 to 1935, no less than 32 bills were introduced in Congress. See Weikart, *Design Piracy*, 19 IND. L.J. 235, 245 n.28 (1944). Typically, these proposals sought to bring the protection of designs under the copyright statute. Illustrative was H.R. 14,666, 64th Cong., 1st Sess. (1916), which sought to establish copyright protection for any new and original design to be embodied in or applied to a manufactured product.

For an example of a more recent proposal, see Title III of the draft of the General Revision of the Copyright Law, S. 1361, 93d Cong., 1st Sess. (1973). This proposal provided for copyright protection for "Ornamental Designs of Useful Articles." *Id.* § 301 *et seq.*

¹⁶⁶ *Yardley*, of course, could very well be reversed on the issue of nonobviousness under 35 U.S.C. § 103 (1970), without the issue of dual protection having to be passed upon. See note 59 *supra*.