

# UNCREATIVE DESIGNS

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## ABSTRACT

*It is often said that the standards for patent protection are higher than the standards for copyright protection. Specifically, commentators assert that the copyright requirement of originality is easier to satisfy than the patent requirements of novelty and nonobviousness. And yet, the USPTO regularly grants patents for designs that fall below the low standard of copyright originality set by the Supreme Court in Feist v. Rural. Some may suggest that the existence of these “sub-Feist” design patents is a result of the USPTO abandoning its duty to scrutinize design patent applications. Or they may suggest that it is a result of the Federal Circuit making it more difficult to invalidate designs as anticipated or obvious. This Article argues that sub-Feist designs exist because the standard for “originality” (at least, in the sense of “minimal creativity”) is not really “lower” than novelty or nonobviousness—it’s just different. This has implications for how we think about the law and theory of copyright and patents as well as specific implications for design patent law and practice. Importantly, this suggests that we should take the word “original”—which is also an explicit statutory requirement for design patents—seriously. We should not assume that a design that qualifies, under the Patent Act, as “novel” and “nonobvious” is also “original” under the Feist standard. And if, as the Supreme Court has held, the Feist originality standard is a requirement of the Progress Clause, we should not let applicants use design patents to evade that requirement.*

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## INTRODUCTION

It is often said that the standards for patent protection are higher than the standards for copyright protection.<sup>1</sup> Copyright, on the one

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1. See, e.g., Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75, 121 (2018) (stating that a design patent has a “high[er] creativity threshold” than copyright); Lucas S. Osborn, *Intellectual Property Channeling for Digital Works*, 39 CARDOZO L. REV. 1303, 1345 (2018) (“[T]o obtain a design patent, the design must be novel and nonobvious, a more rigorous standard that will limit protection to fewer files than copyright.”); Peter Lee & Madhavi Sunder, *The Law of Look and Feel*, 90 S. CAL. L. REV. 529, 560 (2017) (“[T]he substantive standards of obtaining a design patent are relatively high compared to copyright and trademark. The thresholds necessary to obtain a copyright (originality) and trademark (distinctiveness) are quite low compared to the originality, ornamentality, and nonobviousness demanded of design patents.”); see also Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS., no. 2, 1992, at 3, 17 (“Creativity most definitely is a lower standard than novelty . . . .”); Gideon Parchomovsky &

hand, attaches to works of authorship that meet the low bar of “minimal creativity” set forth by the U.S. Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>2</sup> Under this standard, “[t]he vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”<sup>3</sup> Patent law, on the other hand, requires that a design patent be both “novel” and “nonobvious” to be protectable.<sup>4</sup> This is generally viewed to be a higher standard of innovation.<sup>5</sup>

And yet, as this Article shows, the U.S. Patent and Trademark Office (“USPTO”) regularly grants patents for designs that fall below the “minimal creativity” bar set forth by the Supreme Court in *Feist*.<sup>6</sup> Indeed, sophisticated and experienced design patent attorneys have repeatedly stated that design patents are easier to get than copyrights, precisely because design patent law lacks the *Feist* originality requirement.<sup>7</sup>

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Alex Stein, *Originality*, 95 VA. L. REV. 1505, 1510–11 (2009) (“It should be noted that originality and fixation, the ‘gatekeepers’ of copyright law, fall short of the ‘gatekeepers’ employed by patent law.”); Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1442 (2010) (“To grant protection, patent law requires inventions to meet the high hurdle of novelty, nonobviousness, and utility, while copyright law requires only the lower threshold of originality.” (footnote omitted)); Andrew Beckerman-Rodau, *The Problem with Intellectual Property Rights: Subject Matter Expansion*, 13 YALE J.L. & TECH. 36, 75 (2011) (“Although a creativity requirement must be satisfied under copyright law, this is a very low or minimal threshold requirement, which unlike the patent law nonobviousness requirement, is easily met.”); Christopher Buccafusco, Zachary C. Burns, Jeanne C. Fromer & Christopher Jon Sprigman, *Experimental Tests of Intellectual Property Laws’ Creativity Thresholds*, 92 TEX. L. REV. 1921, 1921 (2014) (“Copyright law sets the creativity bar especially low for new works of authorship, whereas patent law demands that a putative inventor prove that her creation is highly innovative.”); Joseph P. Fishman, *Originality’s Other Path*, 109 CALIF. L. REV. 861, 863 (2021) (characterizing the patent requirement of nonobviousness as “requir[ing] far more” than “copyright’s originality standard”).

2. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

3. *Id.* (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][1] (1990)) (quotation marks omitted).

4. 35 U.S.C. §§ 102, 103.

5. *See generally supra* note 1.

6. 499 U.S. at 345; *see infra* Parts II.A–II.B.

7. *See, e.g.*, Tracy-Gene G. Durkin, *Another Way To Look at Software Protection*, MANAGINGIP, May 2016, at 12, [https://www.sterneckessler.com/sites/default/files/2017-11/Another\\_way\\_to\\_look\\_at\\_software\\_protection\\_managing\\_intellectual\\_property\\_durkin\\_2016.pdf](https://www.sterneckessler.com/sites/default/files/2017-11/Another_way_to_look_at_software_protection_managing_intellectual_property_durkin_2016.pdf) [<https://perma.cc/D9BN-UZUK>] (listing the fact that “there is no creativity requirement” as a “distinct advantage[]” of design patents over copyright); *see also* Tracy-Gene Durkin & Daniel Gajewski, *New USPTO Director Quickly Focuses on Much Needed Protection of Virtual Designs*, IP WATCHDOG (May 8, 2022), <https://www.ipwatchdog.com/2022/05/08/new-uspto-director-quickly-focuses-much-needed-protection-virtual-designs/id=148899> [<https://perma.cc/5SVS-2PGK>] (suggesting that copyright’s originality standard is a “high bar[]” that is justified in light of

If patents require a higher standard of innovation than copyright does, how can this be the case? Some may suggest that this is a result of the USPTO abandoning its duty to substantively examine design patent applications.<sup>8</sup> Or they may suggest that this phenomenon is a result of the U.S. Court of Appeals for the Federal Circuit eroding the substantive requirements for design patentability.<sup>9</sup> While the Federal Circuit has certainly done so,<sup>10</sup> that does not completely explain why design patents are being issued for designs that fall below the “minimal creativity” standard of *Feist* (or, as this Article refers to them, “sub-*Feist* designs”).<sup>11</sup> This Article adds to previous work by Ryan Vacca,

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copyright’s longer term); Rani Mehta, *Screen In: How Counsel Protect Graphical User Interfaces*, MANAGINGIP (Sept. 30, 2022), <https://www.managingip.com/article/2aoyjul1owyhivyh46mm8/screeen-in-how-counsel-protect-graphical-user-interfaces> [<https://perma.cc/8ESK-VECK>] (“Durkin at Sterne Kessler adds that GUIs often aren’t creative enough to qualify for copyright protection anyway.”).

8. Cf. Dennis D. Crouch, A Trademark Justification for Design Patent Rights 19 (Aug. 10, 2010) (unpublished manuscript), <http://ssrn.com/abstract=1656590> [<https://perma.cc/3SED-Z4W9>] (noting that the “high-allowance rate appears to be primarily triggered by the USPTO’s *sub silento* abdication of its gatekeeper function in the realm of design patents”). *But see* Sarah Burstein, *Is Design Patent Examination Too Lax?*, 33 BERKELEY TECH. L.J. 607, 624 (2018) [hereinafter Burstein, *Lax*] (arguing that “we shouldn’t blame the USPTO for (all) bad design patents”).

9. Cf. Buccafusco, Lemley & Masur, *supra* note 1, at 124 (“Patent law’s novelty and nonobviousness standards are intended to impose a significant hurdle for claimants.”); *id.* at 125 (suggesting that one way to improve design patent law would be to “rais[e] the obviousness bar”). The Federal Circuit has exclusive jurisdiction over design patent appeals. 28 U.S.C. § 1295(a)(1) (“[T]he Federal Circuit shall have exclusive jurisdiction . . . of an appeal from a final decision of a district court . . . in any civil action arising under . . . any Act of Congress relating to patents or plant variety protection.”). Others may argue that the existence of sub-*Feist* designs is evidence that patent requirements like novelty and nonobviousness are fundamentally incompatible with design. Cf. Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 4 (2013) (“[D]esign patent law errs by attempting to impose a nonobviousness requirement on primarily aesthetic expression.”). But “the idea that a protectable design must not only be new, but new *enough*, is not an entirely foreign concept to design law. Historically, many design-protection laws have included some type of novelty-plus requirement.” Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 STAN. TECH. L. REV. 305, 328 (2013); *see also* J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6, 23 n.87 (1989) (“Besides th[e] requirement of novelty in the sense of an absence of references to prior art, most design laws superimpose some qualitative standard as well, which is either cast in terms of ‘originality’ or as a subtest of the general novelty requirement.”). So, while there is room to critique how the Federal Circuit has interpreted and applied these statutory requirements with respect to designs, comparative analysis shows us that the concept of a novelty-plus requirement is not inherently incompatible with this subject matter.

10. *See* Burstein, *Lax*, *supra* note 8, at 613–24.

11. *Infra* Part III.B.2.

who noticed that the USPTO was granting design patents for one particular type of sub-*Feist* design—blank forms.<sup>12</sup>

This Article argues that sub-*Feist* designs exist because “minimal creativity” is not really a lower standard than novelty or nonobviousness—it’s just different.<sup>13</sup> The *Feist* standard of originality and the patent law requirements of novelty and nonobviousness are not rungs on a single ladder; they are more like separate hurdles.<sup>14</sup> A hurdle may be, in some sense, “lower” than others. But it still needs to be jumped.

Conceptualizing originality as a separate hurdle, not a lower rung, has implications for how we think about the law and theory of copyright and patents as well as specific implications for design patent law and practice. For example, it suggests that we should take the requirement of originality seriously in the context of design patents.<sup>15</sup>

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12. See generally Ryan Vacca, *Design Patents: An Alternative When the Low Standards of Copyright Are Too High?*, 31 S. Ill. U. L.J. 325, 325 (2007). Vacca did not, however, ground his critique in the design patent requirement of originality. See *id.* at 347. Instead, Vacca accepted the conventional wisdom that design patents are more difficult to get than copyrights, and he argued that it was logically inconsistent to protect blank forms under design patent law but not under copyright. *Id.* at 325; see also *id.* at 362 (“Given the general agreement that design patents are, and should be, more difficult to obtain, it appears that the law has turned itself completely backwards with respect to truly blank forms.”). Vacca argued that the USPTO should promulgate a rule, Congress should pass an amendment barring the protection of blank forms by design patents, *id.* at 359, or copyright law should be expanded to cover blank forms, *id.* at 360. And his main concern did not seem to be with any particular design patent doctrine; rather, his concern was that “[t]he law should strive to be consistent and rational” because, “[w]ithout these qualities, those living under it will fail to appreciate and respect it.” *Id.* at 361. He argued that the inconsistency should be resolved by either barring design patents for blank forms or expanding copyright to cover them. *Id.* at 359–60. He expressed no opinion on which option would be best. *Id.* at 358. He did not discuss (or make any argument about) any other type of sub-*Feist* designs. See *id.*

13. Some may question whether the existence of sub-*Feist* designs is either surprising or concerning. But given the conventional wisdom in the field, see *supra* note 1 and accompanying text, as well as recent efforts to expand design patent protection for the apparent purpose of evading *Feist*, see *infra* note 67 and accompanying text, this question is at least worth consideration.

14. *Infra* Part I.

15. Peter Menell and Ella Corren have also called on the Federal Circuit to “give meaning to” the originality requirement. Peter S. Menell & Ella Corren, *Design Patent Law’s Identity Crisis*, 36 BERKELEY TECH. L.J. 1, 129 (2021). They state that design patent originality “is not merely a novelty standard but serves to exclude designs that . . . are so minimal or simple as to not merit protection.” *Id.* They do not, however, provide any citations for that point. Elsewhere, they seem to apply the *Feist* standard to design patents. See *id.* at 133 (“[T]he Apple claim should have been held to fall below the modicum of creativity required for originality”); *id.* at 127 (“[M]inimal designs do not rise to the modicum of creativity necessary to meet the originality requirement for design patent protection.”).

After all, it is an explicit statutory requirement for patentable designs.<sup>16</sup> Originality may also be a constitutional requirement—specifically, a requirement of the Progress Clause, which empowers Congress to grant both copyrights and patents.<sup>17</sup> And originality is not, as some prior commentators have suggested, always or necessarily “subsumed” by the requirements of novelty and nonobviousness.<sup>18</sup>

This Article proceeds in four parts. Part I provides a brief introduction to copyright and design patent law. Part II provides specific examples of sub-*Feist* designs. Part III considers various potential explanations for why sub-*Feist* designs exist and ultimately rejects them, concluding that creativity is not a “lower” requirement but a different one. Part IV discusses some implications. It argues that, whatever “original” should mean in the context of design patents, the *Feist* standard should at least be the floor. There is no good reason to allow patents for sub-*Feist* designs. And if *Feist* originality is, as the Supreme Court has held, a constitutional requirement of the Progress Clause, then applicants should not be able to use the design patent system to subvert that requirement.

## I. BACKGROUND

This Part provides a brief introduction to copyright and design patent law with a focus on the types of subject matter each regime covers and how the rights are obtained.

### A. Copyright

In the United States, copyright protection is available for “original works of authorship.”<sup>19</sup> In 1976, Congress defined the universe of potentially protectable “works of authorship” in broad, expansive terms, stating that:

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16. See *infra* Part IV.C.1.a.

17. See *infra* Part IV.C.1.b.

18. William J. Seymour & Andrew W. Torrance, *(R)evolution in Design Patentable Subject Matter: The Shifting Meaning of “Article of Manufacture,”* 17 STAN. TECH. L. REV. 183, 187 (2013) (“Both the newness and originality requirements of the design patent statute appear to be subsumed within the requirements imposed by [35 U.S.C.] §§ 102 and 103(a).”).

19. 17 U.S.C. § 102(a).

Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.<sup>20</sup>

For the purposes of this Article, two categories of “works of authorship” are particularly relevant—“audiovisual works” and “pictorial, graphic, and sculptural [PGS] works.”<sup>21</sup>

As defined in the Copyright Act, “audiovisual works” are:

[W]orks that consist of a series of related images which are intrinsically intended to be shown by the use of machines, or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.<sup>22</sup>

This category includes movies,<sup>23</sup> videogames,<sup>24</sup> some graphical user interface (“GUI”) designs,<sup>25</sup> and virtual reality environments.<sup>26</sup>

The category of PGS works includes “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs,

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20. See Copyright Act of 1976, Pub. L. No. 94-553, § 102, 90 Stat. 2541, 2544–45 (codified as amended at 17 U.S.C. § 102(a) (2018)); Pamela Samuelson, *Evolving Conceptions of Copyright Subject Matter*, 78 U. PITT. L. REV. 17, 51 (2016) (noting that “the 1976 Act defines enumerated subject matter categories broadly enough so that many unforeseeable creations made possible by advances in technology have generally fit quite comfortably within the 1976 Act categories”). In 1990, Congress added “architectural works” to the list. Architectural Works Copyright Protection Act, Pub. L. No. 101-650, tit. VII, § 703, 104 Stat. 5143, 5143 (codified in relevant part at 17 U.S.C. § 102(a)(8) (2018)).

21. See 17 U.S.C. § 102(a) (listing the types of copyrightable works of authorship).

22. 17 U.S.C. § 101.

23. See 17 U.S.C. § 102(a)(6) (“Works of authorship include . . . motion pictures and other audiovisual works . . .”).

24. See *Midway Mfg. Co. v. Bandai-Am., Inc.*, 546 F. Supp. 125, 139 (D.N.J. 1982) (“It is also unquestionable that video games in general are entitled to copyright protections as audiovisual works.” (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 617–18 (7th Cir. 1982))); *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 856–57 (2d Cir. 1982)); see also U.S. COPYRIGHT OFF., COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 503.1(B) (3d ed. 2021) [hereinafter COMPENDIUM] (listing “[v]ideogames, slide presentations, online audiovisual

prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans.”<sup>27</sup> This category includes works that are embodied in traditional media such as paper and clay as well as those that are embodied in digital files and holograms.<sup>28</sup> Accordingly, designs for computer icons would qualify as PGS works.<sup>29</sup>

A qualifying work is protected by copyright from the moment it is “fixed in a tangible medium of expression.”<sup>30</sup> Registration is not required; however, owners who do not register their works promptly will not be able to take advantage of certain presumptions<sup>31</sup> or the strongest remedies provided by the Copyright Act.<sup>32</sup>

The term of a copyright starts at fixation and lasts, as a general matter, for the life of the author plus seventy years.<sup>33</sup> A copyright gives

works (e.g., smartphone and tablet applications, online courses and tutorials, website content)” as examples of audiovisual works).

25. See COMPENDIUM, *supra* note 24, § 503.1(B) (listing “smartphone and tablet applications” as examples of audiovisual works); *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994) (describing “the Macintosh GUI” as “a dynamic audiovisual work”). The phrases “graphical user interface” and “GUI” have fallen out of favor in the design world; it is more common to hear designers today speak about “user interface” (“UI”) design or “user experience” (“UX”) design. But design patents focus on the visual, and not all types of UI/UX designs constitute design-patentable subject matter. Therefore, this Article will continue to use “graphical user interface” and “GUI” as helpful shorthand for the types of UI/UX designs that are currently considered to be “designs for articles of manufacture.” See 35 U.S.C. § 171(a).

26. COMPENDIUM, *supra* note 24, § 807.1 (providing examples of audiovisual works).

27. 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works”).

28. COMPENDIUM, *supra* note 24, § 904 (noting that “[t]he U.S. Copyright Office will register visual art works that are embodied in a wide variety of two-dimensional and three-dimensional forms,” including those listed above).

29. See 17 U.S.C. § 101 (defining “[p]ictorial, graphic, and sculptural works”); *cf.* COMPENDIUM, *supra* note 24, § 807.7(C) (“Many apps contain a significant amount of preexisting artwork, such as icons.”).

30. 17 U.S.C. § 102(a). At this point, the owner can license their work, assign their copyright, and send takedown notices under the Digital Millennium Copyright Act, but they cannot sue in federal court until they register. See 17 U.S.C. § 411; *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 886 (2019) (“We hold . . . that registration occurs, and a copyright claimant may commence an infringement suit, when the Copyright Office registers a copyright.”).

31. 17 U.S.C. § 410(c) (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.”).

32. 17 U.S.C. § 412. For example, “no award of statutory damages or of attorney’s fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.” *Id.*

33. See 17 U.S.C. § 302(a). There are different rules for calculating the term of jointly authored works, anonymous and pseudonymous works, and works made for hire. See *id.* § 302(b)–(c).



its owner—with some important exceptions—the exclusive right to do certain things, including:

- (1) to reproduce the copyrighted work . . . ;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies . . . of the copyrighted work to the public . . . ;
- . . .
- (5) in the case of . . . pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly . . . .<sup>34</sup>

To prevail on a claim of infringement, a copyright owner must prove that the defendant copied “constituent elements of the work that are original.”<sup>35</sup> Copying ideas is not enough,<sup>36</sup> though line-by-line duplication is not required.<sup>37</sup>

A copyright owner’s rights are limited in other important ways. For example, if a use is deemed a “fair use,” it is not infringing.<sup>38</sup> As Rebecca Tushnet has explained:

Copyright has always had some safety valves. If every unauthorized use of copyrighted works were infringement, many socially valuable

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34. 17 U.S.C. § 106 (2018).

35. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548 (1985)).

36. *See id.*; *see also, e.g.*, Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1922 (2007) (explaining that “the so-called idea/expression dichotomy” is “the longstanding copyright principle that this law protects authors against illicit appropriations of expressive aspects of their works, although not of the ideas the works contain”); Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work’s “Total Concept and Feel,”* 38 EMORY L.J. 393, 395 (1989) (explaining that the idea/expression dichotomy “is presently embodied in Section 102(b) of the copyright code” and “operates by denying protection to the ideas which underlie copyrightable works”); *id.* (“Consequently, only the original ‘expressions’ contained in these works can actually receive copyright protection. This makes certain portions (the ‘ideas’) of every work freely available for others to copy.”).

37. Additionally, “copyright typically does not require any ‘formal’ claim beyond the work itself until a dispute occurs.” Jeanne C. Fromer & Mark P. McKenna, *Claiming Design*, 167 U. PA. L. REV. 123, 161 (2018) (footnotes omitted). “[T]he copyrighted work itself is used as the prototype against which all allegedly infringing works are compared to see if they share sufficient salient characteristics to fall within the scope of the copyright holder’s rights.” *Id.*

38. *See* 17 U.S.C. § 106 (noting that all of these rights are “[s]ubject to sections 107 through 122”); 17 U.S.C. § 107 (“[F]air use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”).

activities would be impaired. For example, a book review would be unable to quote the book in question without permission, and permission could be withheld without a favorable review, a large payment, or both. As one way to solve this problem, courts developed the doctrine of fair use, codified in the 1976 Copyright Act.<sup>39</sup>

The Supreme Court has identified the fair use doctrine as an important “built-in First Amendment accommodation[]” in copyright law.<sup>40</sup> There are other speech-protective limits to copyright protection, including “the merger doctrine, which allows copying when there are only a small number of ways to express an idea.”<sup>41</sup>

The Copyright Act also has special rules for the designs of “useful articles”—that is, an “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>42</sup> A PGS work is protected “if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>43</sup> And § 113 of the Copyright Act places extra limits on rights relating to useful articles.<sup>44</sup>

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39. Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 544 (2004).

40. The Supreme Court’s syllabus in its *Eldred* opinion summarizes that copyright law contains built-in First Amendment accommodations. First, 17 U.S.C. § 102(b), which makes only expression, not ideas, eligible for copyright protection, strikes a definitional balance between the First Amendment and copyright law by permitting free communication of facts while still protecting an author’s expression. Second, the “fair use” defense codified at § 107 allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself for limited purposes. “Fair use” thereby affords considerable latitude for scholarship and comment and even for parody.

*Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003) (internal citations omitted). Whether or not the fair use doctrine actually does an adequate job of protecting First Amendment values is a different question. *See, e.g.*, Tushnet, *supra* note 39, at 538 (“The current version of copyright, in which free speech problems are solved by keeping copyright owners from controlling certain transformative uses but in which more ordinary unauthorized copying is prohibited, is incompatible with the First Amendment.”).

41. Tushnet, *supra* note 39, at 553 (listing other speech-protective rules and limits in copyright law like the general performance right for sound recordings and the first-sale doctrine).

42. 17 U.S.C. § 101.

43. *Id.*

44. 17 U.S.C. §§ 113(b), (c).

## B. Design Patents

Design patents are a different form of IP. Congress created this type of patent in 1842.<sup>45</sup> While the purpose of utility patents (the first type of patent) is to promote useful inventions, design patents have long been understood to be “intended to give encouragement to the decorative arts.”<sup>46</sup> As the USPTO has explained: “In general terms, a ‘utility patent’ protects the way an article is used and works (35 U.S.C. 101), while a ‘design patent’ protects the way an article looks (35 U.S.C. 171).”<sup>47</sup>

Unlike a copyright, a design patent does not arise automatically when certain criteria are satisfied. A design patent must be granted by the USPTO. Design patents are available for “any new, original and ornamental design for an article of manufacture,” provided those designs meet the other requirements of the Patent Act.<sup>48</sup> Those other requirements include novelty and nonobviousness, which are discussed in more detail below.<sup>49</sup>

A design patent must claim a design “for an article of manufacture.”<sup>50</sup> The Supreme Court has interpreted the phrase “article of manufacture” to mean “simply a thing made by hand or machine.”<sup>51</sup> Notably, under this definition, an “article of manufacture” is not a

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45. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842). Currently, the United States grants three types of patents: utility patents, plant patents, and design patents. See 35 U.S.C. §§ 101, 161, 171.

46. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 524 (1871) (describing the value of design patents to the decorative arts).

47. U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1502.01 (9th ed., rev. 07.2022, Feb. 2023) [hereinafter MPEP] (parentheticals omitted).

48. 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”).

49. See discussion *infra* Parts III.B.1–2.

50. 35 U.S.C. § 171(a).

51. *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 60 (2016). This dictionary-based definition, however, ignores the fact that “article of manufacture” has long been a term of art in design patent law and practice. See Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1, 5 (2017) [hereinafter Burstein, 1887]. In the context of design patent law,

[a] close examination of the relevant statutory text, late nineteenth-century patent treatises, Patent Office decisions, and court cases shows that, in 1887, “article of manufacture” was a term of art referring to a tangible item made by humans—other than a machine or composition of matter—that had a unitary structure and was complete in itself for use or for sale. Therefore, in 1887, “article of manufacture” did not mean any “thing made by hand or machine.”

*Id.* at 83.

synonym for “useful article” in the copyright sense.<sup>52</sup> Designs for useless articles have always been considered design-patentable subject matter.<sup>53</sup> If we assume that the word “articles” in the Copyright Act refers to only items made by humans (that is, that the category does not include naturally occurring items), then all useful articles are articles of manufacture, but not all articles of manufacture are useful articles.<sup>54</sup> The Venn diagram would look something like this<sup>55</sup>:

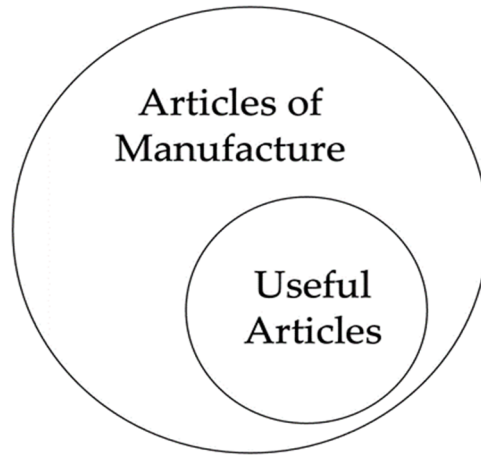
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52. Compare *Burstein, 1887, supra* note 52, at 5 (defining an article of manufacture as a tangible item made by humans with a unitary structure complete in itself for use or sale), with *Samsung Elecs. Co. v. Apple Inc.*, 580 U.S. 53, 60 (2016) (“An article of manufacture . . . is simply a thing made by hand or machine.”).

53. See Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (providing protection for, *inter alia*, “any new and original design for a bust, statue, or bas relief or composition in alto or basso relieve”). There are some dicta floating around in the Federal Circuit that suggest that “articles of manufacture” must be useful. See, e.g., *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997) (“[T]he fact that the article of manufacture serves a function is a prerequisite of design patentability, not a defeat thereof.”). But that dictum is contradicted by history. See Act of Aug. 29, 1842, *supra*.

54. This distinction is further supported by the Copyright Office’s distinction between the “design of a useful article” and “works of artistic craftsmanship.” See COMPENDIUM, *supra* note 24, § 924 (internal citation omitted) (citing 17 U.S.C. § 101); *id.* § 925.3 (“Unlike a work of artistic craftsmanship, the copyright law does not protect the overall form, shape, or configuration of the useful article itself, no matter how pleasing or attractive it may be.”). According to the Copyright Office, “[a] work of artistic craftsmanship is a decorative or ornamental object that can be considered a ‘work of art,’ even though it ‘might also serve a useful purpose.’” *Id.* § 925.1 (citation omitted). The examples the Copyright Office gives—ornamental jewelry, decorative masks, stained glass windows, tapestries, mosaics, wallpaper designs, decorative bookends or paperweights, and Benvenuto Cellini’s salt cellar—are all “articles of manufacture” for the purposes of design patent law. Compare *id.* § 925.1 (listing the Copyright Office’s examples), with *Samsung Elecs. Co.*, 580 U.S. at 50 (“An article of manufacture . . . is simply a thing made by hand or machine.”).

55. The sizes of these circles are not meant to be to scale. This Article leaves the question of the relative sizes of these fields for another day. For now, the point is that they are not coextensive, and one is a subset of the other.



It has long been held that a design patent applicant can claim: (1) a design for “surface ornamentation applied to an article;” (2) a design for “the configuration or shape of an article;” or (3) a design for a combination of surface and shape.<sup>56</sup> These longstanding categories overlap with the copyright category of PGS works.<sup>57</sup>

For shape designs,<sup>58</sup> these categories overlap to some degree.<sup>59</sup> For example, a design for a statue would be considered both a sculptural

56. Burstein, *1887*, *supra* note 51, at 8 (“[I]t has long been held that there are two classes of protectable designs—designs for ‘surface ornamentation applied to an article’ and designs for ‘the configuration or shape of an article’—and that applicants can claim a design for configuration, surface ornamentation, or a combination of both.”).

57. *See supra* Part I.A.

58. The terms “configuration” and “shape” are generally used as synonyms in U.S. design law. Sarah Burstein, *How Design Patent Law Lost Its Shape*, 41 *CARDOZO L. REV.* 555, 563 (2019) [hereinafter Burstein, *Shape*]. Accordingly, they will be used as synonyms here.

59. *See supra* notes 27–29 and accompanying text. If, as some scholars and the Copyright Office have read it, the Supreme Court’s decision in *Star Athletica* bars copyright protection for the whole shape of a useful article, that would be another distinction. *Cf.* Rebecca Tushnet, *Shoveling a Path After Star Athletica*, 66 *UCLA L. REV.* 1216, 1236–37 (2019) (discussing scholarly interpretations of *Star Athletica*, *L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405 (2017), which interprets the Copyright Act’s “separability” requirement); *COMPENDIUM*, *supra* note 24, § 924.3(B) (“The Supreme Court made it clear that ‘the separated feature [must] qualify as a nonuseful pictorial, graphic, or sculptural work on its own.’ The feature cannot ‘be a useful article’ in and of itself.” (internal citations omitted) (quoting *Star Athletica*, 580 U.S. at 420, 415)). By contrast, under current law and practice, design patents claim designs for both whole shapes and fragments thereof. *See MPEP*, *supra* note 47, § 1502 (allowing applicants to claim any “visual characteristic[] embodied in or applied to an article” as a separate design). This difference makes it difficult to “translate” copyright decisions about useful articles directly in the context of at least some patented designs, but a full discussion of that issue is beyond the scope of this Article.

work (for copyright) and a design for the shape of an article of manufacture (for patent).<sup>60</sup>

For surface designs, there is even more overlap. For example, a design for a calico print would be considered a design for the surface ornamentation of an article of manufacture and, thus, design-patentable subject matter.<sup>61</sup> It would also be considered a pictorial or graphic work and, thus, copyrightable subject matter.<sup>62</sup>

The USPTO has increased the amount of copyright and design patent overlap by declaring that both static and animated GUI designs qualify as design-patentable subject matter, declaring them to be (or at least be akin to) designs for “surface ornamentation.”<sup>63</sup> The USPTO recently sought comments on whether it should expand this area of overlap even further by reinterpreting 35 U.S.C. § 171 to cover designs for “projections, holograms, and virtual and augmented reality.”<sup>64</sup>

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60. See *supra* note 53 (discussing the fact that statues have long been considered design-patentable subject matter); 17 U.S.C. § 101 (“Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art . . . .); cf. *Star Athletica*, 580 U.S. at 417 (“[T]he approach we outline today interprets §§ 101 and 113 in a way that would afford copyright protection to the statuette in *Mazer* regardless of whether it was first created as a standalone sculptural work or as the base of the lamp.” (citing *Mazer v. Stein*, 347 U.S. 201, 218–19 (1954))).

61. Sarah Burstein, *The “Article of Manufacture” Today*, 31 HARV. J.L. & TECH. 781, 812–13 (2018) (noting that “textile fabrics, articles of personal attire, general hardware, [and] house furnishing goods” have long been considered “articles of manufacture” (quoting WILLIAM EDGAR SIMONDS, A SUMMARY OF THE LAW OF PATENTS FOR USEFUL INVENTIONS WITH FORMS 19 (1883))).

62. More precisely, it would be considered protectable as long as it was deemed to be “separable.” *Star Athletica*, 580 U.S. at 409; see also COMPENDIUM, *supra* note 24, § 924.1 (listing “textile fabrics” as an example of a useful article). Although the Court refused to hold that “two-dimensional artistic features on the surface of useful articles are ‘inherently separable,’” *Star Athletica*, 580 U.S. at 412, it is difficult to imagine situations where they would not be under the Court’s test.

63. See Guidelines for Examination of Design Patent Applications for Computer-Generated Icons, 61 Fed. Reg. 11381–82 (Mar. 20, 1996); David Leason, *Design Patent Protection for Animated Computer-Generated Icons*, 91 J. PAT. & TRADEMARK OFF. SOC’Y 580, 580 (2009) (noting that, in 2005, the USPTO stated in an office action that “The Office has determined that ‘animated icons’ are patentable subject matter” (citing U.S. Application Serial No. 29/208,172 (filed Sept. 20, 2005)); MPEP, *supra* note 47, § 1504.01(a)(I) (“Computer-generated icons, such as full screen displays and individual icons, are 2-dimensional images which alone are surface ornamentation.”); *id.* § 1504.01(a)(IV) (“Computer generated icons including images that change in appearance during viewing may be the subject of a design claim.”). These interpretations of the Patent Act, to the author’s best knowledge, have not been tested in—let alone ratified by—any court.

64. See U.S. PAT. & TRADEMARK OFF., SUMMARY OF PUBLIC VIEWS ON THE ARTICLE OF MANUFACTURE REQUIREMENT OF 35 U.S.C. § 171 at 1 (2022), <https://www.uspto.gov/sites/default/files/documents/USPTO-Articles-of-Manufacture-April2022.pdf> [<https://perma.cc/8GHQ-2BLK>].

Nearly three years after soliciting comments on the issue, the USPTO rejected calls to make such an expansion but, in doing so, doubled down on its prior conclusion that both static and animated GUI designs constitute proper statutory subject matter.<sup>65</sup>

Should the issue arise again, it is worth noting that we do not need to stretch the language of the Patent Act to provide IP protection for either projected designs or for GUIs. Projected designs—like GUIs—are already protected by copyright as either audiovisual or PGS works, as long as they are sufficiently creative.<sup>66</sup> Indeed, it appears that one reason that some applicants and attorneys seek such an expansion is for the express purpose of evading the low bar set by *Feist*.<sup>67</sup> It has been suggested, for example, that design patent protection needs to be expanded to cover projected designs because many of them are not sufficiently creative to obtain copyright protection.<sup>68</sup>

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65. See generally Sarah Burstein, *GUI Guidelines: The Old Rules Are New Again*, PATENTLY-O (Nov. 21, 2023), <https://patentlyo.com/patent/2023/11/guidelines-rules-again.html> [<https://perma.cc/NS8X-7C8R>] (discussing Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces, 88 Fed. Reg. 80277 (Nov. 17, 2023)). For a fuller explanation of why the proposed expansion would have been problematic, see Sarah Burstein, Christopher Buccafusco, Jonathan S. Masur, Mark McKenna, Pamela Samuelson & Rebecca Tushnet, Comment Letter on the Proposed Article of Manufacture Requirement (Feb. 4, 2021) [hereinafter Burstein et al., Comment Letter], <https://www.regulations.gov/comment/PTO-C-2020-0068-0009> [<https://perma.cc/P3YZ-M4FR>].

66. See Sarah Burstein, *Guest Post: Old Designs, New Design Patents*, PATENTLY-O (Apr. 27, 2022), <https://patentlyo.com/patent/2022/04/designs-design-patents.html> [<https://perma.cc/4S-DJ-M65U>] [hereinafter Burstein, *Old Designs*] (explaining that, while some of the technology used to project these types of designs may be new, the designs themselves are neither new nor unprotected). As the prior section has shown, these types of designs are already copyrightable subject matter. And the concept of projecting designs is not new. Magic lantern technology, for example, goes back to at least the seventeenth century. See Burstein et al., Comment Letter, *supra* note 65, at 18 n.73 (citing CHARLES MUSSER, 1 HISTORY OF THE AMERICAN CINEMA—THE EMERGENCE OF CINEMA: THE AMERICAN SCREEN TO 1907, at 20 (1990)). Specifically, projected designs that include multiple images that are meant to be shown in a series would qualify as audiovisual works. See 17 U.S.C. § 101. Projected designs consisting of a single image (not meant to be shown in a series) would be PGS works. See *supra* note 27 and accompanying text. So would holograms. See COMPENDIUM, *supra* note 24, § 904 (listing “holograms” as a type of visual artwork that can be protected by copyright). A similar analysis would apply to designs for virtual reality and augmented reality. Cf. *id.* § 807.1 (listing “virtual reality environments” as a type of audiovisual work). See Burstein et al., Comment Letter, *supra* note 65, at 7–9 (explaining how copyright protects projected designs).

67. See Durkin & Gajewski, *supra* note 7 (arguing that design patents are better suited to projected designs and suggesting that design patents need not meet the copyright “creativity requirement[]” because design patent terms are shorter than copyright terms).

68. See *id.*; Burstein, *Old Designs*, *supra* note 66 (discussing this argument in more detail).

## II. SUB-*FEIST* DESIGN PATENTS EXIST

This Part demonstrates the existence of sub-*Feist* design patents—patents for designs that fall below the standard for originality set forth in *Feist*. First, this Part will briefly explain the *Feist* standard. Then, it will provide examples of sub-*Feist* design patents.

### A. *The Feist Standard*

As noted above, copyright protection is only available for works that are “original.”<sup>69</sup> In *Feist Publications, Inc. v. Rural Telephone Service Co.*, the Supreme Court held that, in order to be “original,” a work must: (1) be “independently created by the author (as opposed to copied from other works)” and (2) “possess[] at least some minimal degree of creativity.”<sup>70</sup> To satisfy the minimal creativity requirement, the work must “possess some creative spark, no matter how crude, humble or obvious it might be.”<sup>71</sup> In so ruling, the Court rejected the “sweat of the brow” theory,<sup>72</sup> which conceptualized “copyright [as] a reward for the hard work that went into compiling facts.”<sup>73</sup> According to the *Feist* Court, the requirement of originality was not just a statutory requirement but a constitutional one.<sup>74</sup>

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69. 17 U.S.C. § 102(a).

70. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The second part of this formulation has been the subject of scholarly debate. *See, e.g.*, Russ VerSteege, *Sparks in the Tinderbox: Feist, “Creativity,” and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 550–51 (1995) (“The legislative history suggests that the drafters did not intend ‘creativity’ to be a required element of copyrightability.” (footnote omitted)); Abrams, *supra* note 1, at 3, 15 (“The formulations of the standard for originality prior to *Feist* required little more than independent effort, and certainly did not seem to incorporate a standard of creativity.” (footnote omitted)); Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 374 (1992) (“There is room for argument that the *Feist* court misapplied prior Supreme Court interpretations of the Patent-Copyright Clause. . . . The ‘Author’ at the ‘origin’ of a work, as contemplated in *Burrow-Giles*, could include the maker of a compilation of information, without regard to the creativity of the compilation.”). Whether minimal creativity was rightly or wrongly added to the test for originality, it is now well established in U.S. copyright law and will be accepted as settled precedent for the purposes of this Article.

71. *Feist*, 499 U.S. at 345 (internal quotation marks omitted) (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.08[C][1] (1990)).

72. *Id.* at 359–60.

73. *Id.* at 352 (“Making matters worse, these courts developed a new theory to justify the protection of factual compilations. Known alternatively as ‘sweat of the brow’ or ‘industrious collection,’ the underlying notion was that copyright was a reward for the hard work that went into compiling facts.”).

74. The *Feist* Court emphasized,



The Court stated that copyright’s “originality requirement is not particularly stringent,”<sup>75</sup> suggesting that there is only “a narrow category of works” that fail to meet the minimal creativity bar, namely those “in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.”<sup>76</sup>

In *Feist*, Rural claimed that Feist had infringed its copyright in a telephone white-page directory.<sup>77</sup> Those white pages “list[ed] in alphabetical order the names of Rural’s subscribers, together with their towns and telephone numbers.”<sup>78</sup> The Court concluded that the white pages did not “satisfy the minimum constitutional standards for copyright protection” because:

Rural’s white pages are *entirely typical*. Persons desiring telephone service in Rural’s service area fill out an application and Rural issues them a telephone number. In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a *garden-variety* white pages directory, *devoid of even the slightest trace of creativity*.

Rural’s selection of listings could not be more *obvious*: It publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service. This is “selection” of a sort, but it *lacks the modicum of creativity* necessary to transform mere selection into copyrightable expression. Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.<sup>79</sup>

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The source of Congress’ power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution . . . . In two decisions from the late 19th century—*The Trade-Mark Cases*, 100 U.S. 82 (1879); and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)—this Court defined the crucial terms “authors” and “writings.” In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.

*Id.* at 346. The Court’s conclusion that originality is a constitutional requirement has been a matter of some controversy in the literature. See John T. Cross, *Justifying Property Rights in Native American Traditional Knowledge*, 15 TEX. WESLEYAN L. REV. 257, 286 n.94 (2009); Ginsburg, *supra* note 70, at 368. This Article does not intend to enter that debate but merely notes that if the Court was right on this point, then it may have consequences for patents as well as for copyrights.

75. *Feist*, 499 U.S. at 358.

76. *Id.* at 359.

77. *Id.* at 344 (“Rural sued for copyright infringement in the District Court for the District of Kansas taking the position that Feist, in compiling its own directory, could not use the information contained in Rural’s white pages.”).

78. *Id.* at 342.

79. *Id.* at 362–63 (emphasis added). Here, the Court seems to have been using “obvious” in its plain-English sense—not in its special patent sense.

The Court further explained that the white pages lacked sufficient creativity because arranging phone numbers in alphabetical order was “an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course,” calling the arrangement “not only unoriginal” but “practically inevitable.”<sup>80</sup> According to the Court, “[t]he standard of originality is low, but it does exist.”<sup>81</sup>

As prior commentators have noted, the Court’s decision in *Feist* does not provide much more detail about what *would* pass the bar of minimal creativity, mainly defining that requirement in the negative.<sup>82</sup> As Jane Ginsburg wrote shortly after the decision was released, “[t]he *Feist* opinion is more explicit in describing what is not original than in delineating what is.”<sup>83</sup> But at the same time, as Joseph Miller has observed, “the Court’s descriptors paint a picture: a fatally uncreative expressive work is typical, garden-variety, obvious, an age-old practice, traditional, commonplace, expected as a matter of course, practically inevitable.”<sup>84</sup>

### B. *Patents for Sub-Feist Designs*

A number of recent patents—including some asserted in litigation—fall below the low bar set by *Feist*. Specifically, they seem to fall below *Feist*’s “minimal creativity” threshold.<sup>85</sup> So when this Article

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80. *Id.* at 363.

81. *Id.* at 362.

82. *E.g.*, Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 481 (2009) (“The Court’s analysis is, admittedly, more a negative statement than an affirmative one, more a description of how Rural fell short than a description of how much creativity it takes to clear the constitutional minimum.”); Diane Leenheer Zimmerman, *It’s an Original! (?): In Pursuit of Copyright’s Elusive Essence*, 28 COLUM. J.L. & ARTS 187, 188 (2005) (“What is the minimum necessary to satisfy *Feist*’s demand for creativity? On this point, the opinion offered no real answer.”); Abrams, *supra* note 1, at 15 (“*Feist* itself does not promulgate a definition or a test for determining creativity.”).

83. Ginsburg, *supra* note 70, at 343.

84. Miller, *supra* note 82, at 482.

85. At least on the face of these patents, there is no indication that the designs were not independently created. And if they were, that would seem to run afoul of the requirement that a patent only be issued to a design’s *inventor* (or the inventor’s assignee). See 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)). It is difficult to see how one could be deemed an “inventor” of a design they did not independently create. It is possible, of course, that applicants or purported inventors could be lying to the USPTO about inventorship. But that is not something we can generally tell from the issued patents. *But see* Julie Zerbo, *A Mysterious Chinese “Inventor” Is Amassing Patents for Others’ “It” Bags*, THE FASHION L. (June 27, 2019), <http://www.thefashionlaw.com/a-little-known->

talks about sub-*Feist* designs, it is referring to design patents that claim designs that fail—or seem like they should fail—to satisfy *Feist*'s requirement of minimal creativity. This Section will share just a few examples.

First, though, it is worth noting that sophisticated and experienced design patent attorneys consider the *Feist* creativity standard to impose a higher bar than the current requirements for design patentability.<sup>86</sup> Looking at issued design patents, it is difficult to say that they are wrong.

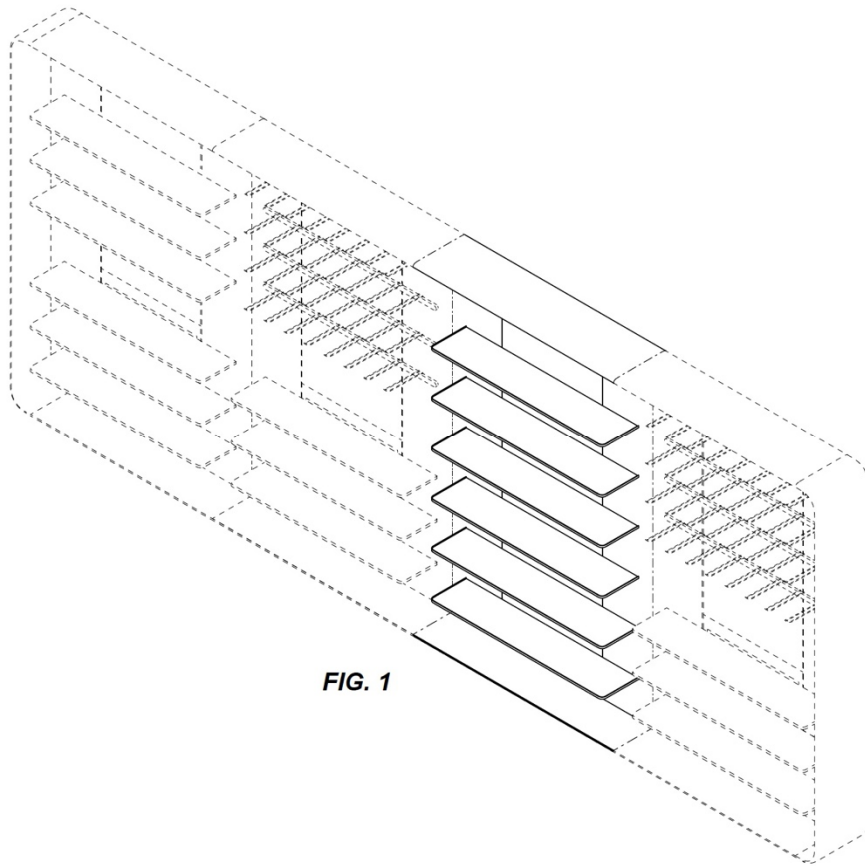
For example, consider this design patent that recently issued to Apple for a design for some shelves<sup>87</sup>:

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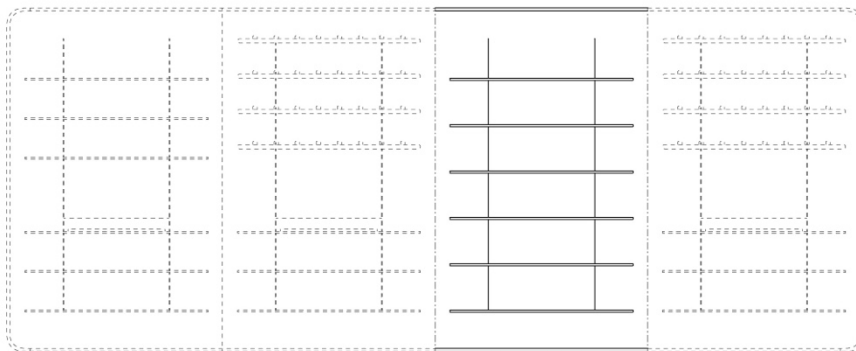
inventor-is-amassing-patent-protections-for-others-it-bags [https://perma.cc/S7TR-X7QP]. As to what, precisely, a design inventor (or creator) must create, recent (and well-reasoned) caselaw informs us that the relevant invention is the design as applied, not the design *per se*. See *In re SurgiSil, L.L.P.*, 14 F.4th 1380, 1382 (Fed. Cir. 2021) (“A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.”). So the question *vis-à-vis* independent creation, with respect to patentable designs, should not be “did you create this shape?” but “did you come up with the conception of how to apply this shape to a particular article?”

86. See, e.g., Durkin, *supra* note 7, at 12 (listing the fact that “there is no creativity requirement” as a “distinct advantage” of design patents over copyright); see also Durkin & Gajewski, *supra* note 7 (suggesting that copyright’s originality standard is a “high bar[]” that is justified in light of copyright’s longer term); Rani Mehta, *Screen In: How Counsel Protect Graphical User Interfaces*, MANAGINGIP (Sept. 30, 2022), <https://www.managingip.com/article/2a0yjul1owyhivyh46mm8/screen-in-how-counsel-protect-graphical-user-interfaces> [https://perma.cc/H3XD-53AB] (“Durkin at Sterne Kessler adds that GUIs often aren’t creative enough to qualify for copyright protection anyway.”).

87. Retail Fixture, U.S. Patent No. D995,171 figs.1 & 2 (issued Aug. 15, 2023).



**FIG. 1**



**FIG. 2**

This patent makes use of a common contemporary claiming convention, stating that the parts shown in dotted lines “form no part of the claimed design.”<sup>88</sup> Therefore, this claim covers just the six rectangular shelves, the uprights, and the top and bottom surfaces of the shelving unit.<sup>89</sup> It is difficult to tell from the drawings, but there may be some kind of rim or ridge around the shelves.<sup>90</sup> Even so, the overall effect is one of a typical, garden-variety shape for shelving—not a creative one.

For another example, consider this design patent. It claims a design for a “tape forming a toy building block base”<sup>91</sup>:

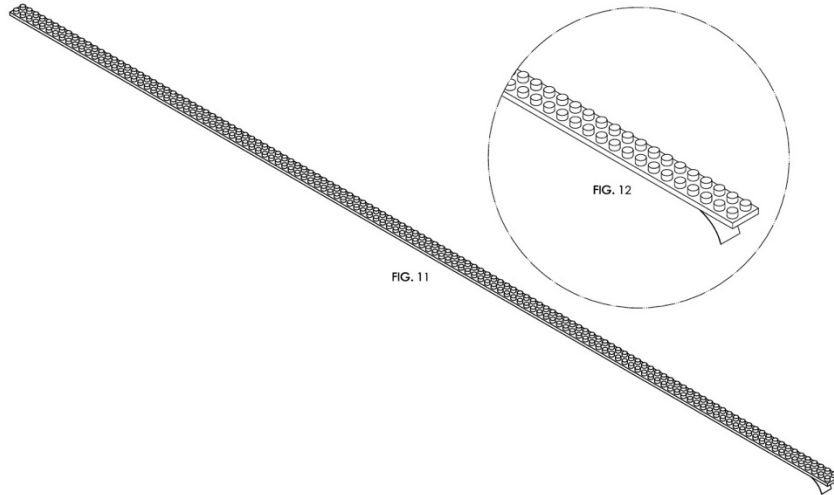
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88. *Id.* at Description. For a critique of this claiming convention and the Federal Circuit case that endorsed it, see Burstein, *Shape*, *supra* note 58.

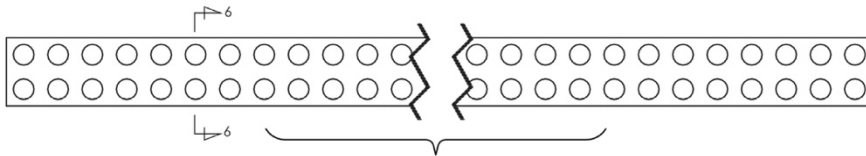
89. And an accused shelf unit needs only look the same as the parts shown in solid lines to infringe. Burstein, *1887*, *supra* note 51, at 11 (“[I]n analyzing infringement, the fact finder must compare the claimed portion of the design—i.e., whatever is shown in solid lines in the patent drawings—to the corresponding portion of the accused design.” (citing *Hutzler Mfg. Co. v. Bradshaw Int’l, Inc.*, No. 1:11-cv-07211, 2012 WL 3031150, at \*9–10 (S.D.N.Y. July 24, 2012))).

90. See *Retail Fixture*, U.S. Patent No. D995,171 figs.1 & 3 (issued Aug. 15, 2023).

91. *Tape Forming a Toy Bldg. Block*, U.S. Patent No. D813,317 figs.11 & 12. (issued Mar. 20, 2018). It has also been asserted in litigation. *Complaint, Zuru Inc. v. Ontel Prods. Corp.*, No. 6:18-cv-00132 (E.D. Tex. Mar. 20, 2018), ECF 1 (alleging infringement of U.S. Patent No. D813,317); *Complaint, Chrome Cherry Design Studio (Pty) Ltd v. P’ships & Unincorporated Ass’ns Identified on Schedule “A,”* No. 1:20-cv-06326 (N.D. Ill. Oct. 26, 2020), ECF 1 (same); *Complaint, Chrome Cherry Design Studio (Pty) Ltd v. P’ships & Unincorporated Ass’ns Identified on Schedule “A,”* No. 1:21-cv-06089 (N.D. Ill. Nov. 15, 2021), ECF 1 (same).



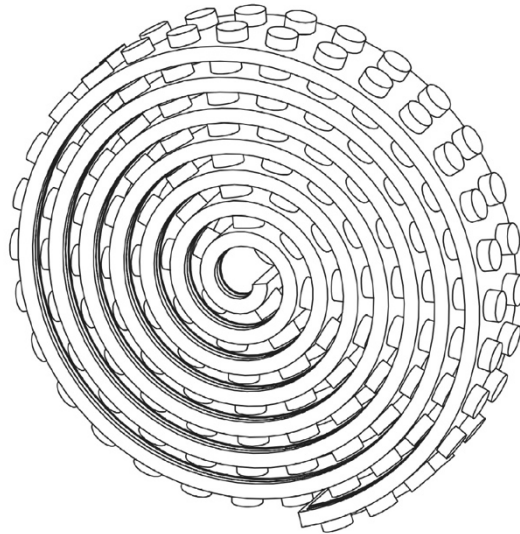
According to the description of the drawings, figure 12 of the patent (reproduced above) shows “an enlarged partial view of a portion of” figure 11 (also shown above).<sup>92</sup> Here is another close-up, partial view<sup>93</sup>:



92. Tape Forming a Toy Bldg. Block, U.S. Patent No. D813,317, at [57] (issued Mar. 20, 2018).

93. *Id.* at fig.1. The description of the drawings indicates that figures, like the one shown above, that include portions “separated and bound by bracket are disclosed as such for the ease and clarity of illustration,” presumably because the tape is too long to show in its entirety at this level of detail. *Id.* at [57]. The arrows and “6” markings indicate that this drawing was prepared for a utility patent application.

The patent also shows the tape rolled up in various ways, including the following<sup>94</sup>:



Granted, the concept of making toy “tape” that could be used with LEGO and LEGO-type toys might be “creative” in some sense of that word.<sup>95</sup> But design patents protect shapes, not concepts.<sup>96</sup>

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94. *Id.* at fig.21.

95. See Complaint, *Zuru Inc. v. Ontel Prods. Corp.*, No. 6:18-cv-00132 (E.D. Tex. Mar. 20, 2018), ECF 1 (describing the commercial embodiment of the design as “rolls of flexible building block tape compatible with the products of major toy lines such as Lego®, Mega Bloks®, and Creo®”).

96. See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1332 (Fed. Cir. 2015) (“Ethicon’s Design Patents cover only the specific ornamental conceptions of the features shown in their figures, and not the general concepts of an open trigger, a rounded button, and a fluted torque knob oriented in some configuration as part of an ultrasonic surgical device.”); Sarah Burstein, *Intelligent Design & Egyptian Goddess: A Response to Professors Buccafusco, Lemley & Masur*, 68 DUKE L.J. ONLINE 94, 111 n.67 (2019) [hereinafter Burstein, Goddess] (“Coleman appears to have been laboring under what I’ve referred to as ‘the concept fallacy’ in design patent litigation—*i.e.*, the mistaken belief that design patents protect general concepts, as opposed to just the claimed designs.” (citing Sarah Burstein, *Design Law*, TUMBLR (July 2, 2014), <https://design-law.tumblr.com/post/90571053836/does-this-reflector-for-use-in-golf-infringe> [<https://perma.cc/8P7Y-KJWS>])). If the concept of LEGO tape were useful, novel, and nonobvious, the originator could always seek utility patent protection. See 35 U.S.C. § 101 (providing utility patent protection for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”).

Once you start from the concept of “LEGO tape,” it is hard to see much *visual* creativity in how that concept has been implemented here. Indeed, when the patentee attempted to register this tape design with the Copyright Office as a “sculptural work,” the application was refused for lack of minimal creativity.<sup>97</sup>

For a third example, this design patent claims a design for “label pattern for a medical label sheet”<sup>98</sup>:

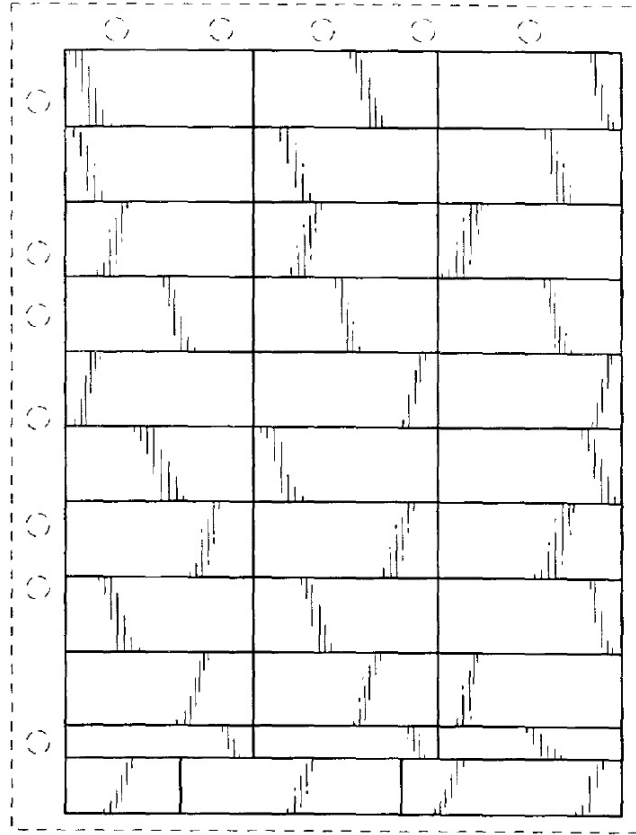
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97. Letter from U.S. Copyright Off. Rev. Bd. to Cortland C. Putbrese, Esq., Dunlap Bennett & Ludwig PLLC, Re: Second Request for Reconsideration for Refusal To Register Toy Block Tape Sculpture; Correspondence ID: 1-2ZHO1FU; SR 1-5105710482, 1-5105710968, at 3, 6 (Mar. 26, 2019), <https://www.copyright.gov/rulings-filings/review-board/docs/toy-block-tape-sculpture.pdf> [<https://perma.cc/HU4X-J5P9>] (“[T]he combination of elements does not produce a work that contains the necessary creativity according to *Feist*.”).

Specifically, the patentee “submitted two registration applications, each covering a distinct configuration of the building tape.” *Id.* at 1 (footnote omitted). The views correspond with figures 42 and 28 of the D’317 patent. *See id.* at 2.

98. Label Pattern for a Medical Label Sheet, U.S. Patent No. D503,197 fig.1 (issued Mar. 22, 2005). This patent was litigated in *PHG Technologies, LLC v. St. John Companies, Inc.*, 469 F.3d 1361, 1363 (Fed. Cir. 2006) (“PHG owns the two design patents at issue in this case: United States Patent Nos. D496,405 . . . and D503,197.”). The issue of originality was not raised in that case. *See id.*





As discussed above, based on current case law and practice, this claim covers only the parts shown in solid lines.<sup>99</sup>

Focusing, then, on the portions in solid lines, it is difficult so see even minimal visual creativity here. According to the record in the case, “The first nine rows are depicted to contain three labels of equal size, the size being consistent with a standard medical chart label. The tenth and eleventh row each contain differently sized labels which apparently correspond to the size of a pediatric and adult patient wristband respectively.”<sup>100</sup> Shaping labels to fit standards and placing

99. See *supra* notes 88–89 and accompanying text. This claim also includes vertical lines, which are apparently meant to show that the labels are flat.

100. *PHG Techs.*, 469 F.3d at 1363. To be clear, the challenge raised in this case was a lack of ornamentality, not a lack of originality. See *id.* at 1365 (“St. John asserts that the district court erred in finding that the patented designs are primarily ornamental rather than merely a byproduct of functional considerations.”).

them in rows—presumably to maximize usage of the print area—seems “not only unoriginal, [but] . . . practically inevitable.”<sup>101</sup> Yes, perhaps the wristband labels could have arbitrarily been put at the top instead of the bottom, etc., but that sort of variation would not be the type of *visual* creativity that design patents are supposed to promote.<sup>102</sup>

There are also a large number of sub-*Feist* designs in the GUI space. And they are not just being issued. They are being asserted in court. For example, in the past few years, companies associated with a single inventor, William Grecia, have filed over a dozen cases alleging infringement of design patents for “animated graphical user interface[s].”<sup>103</sup> All of these patents claim designs that seem to fall below the low bar set in *Feist*.

Consider this patent, which has been asserted against a number of companies.<sup>104</sup> In its second embodiment,<sup>105</sup> it claims a sequence of three images<sup>106</sup>:

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101. See *Feist*, 499 U.S. at 363 (1991).

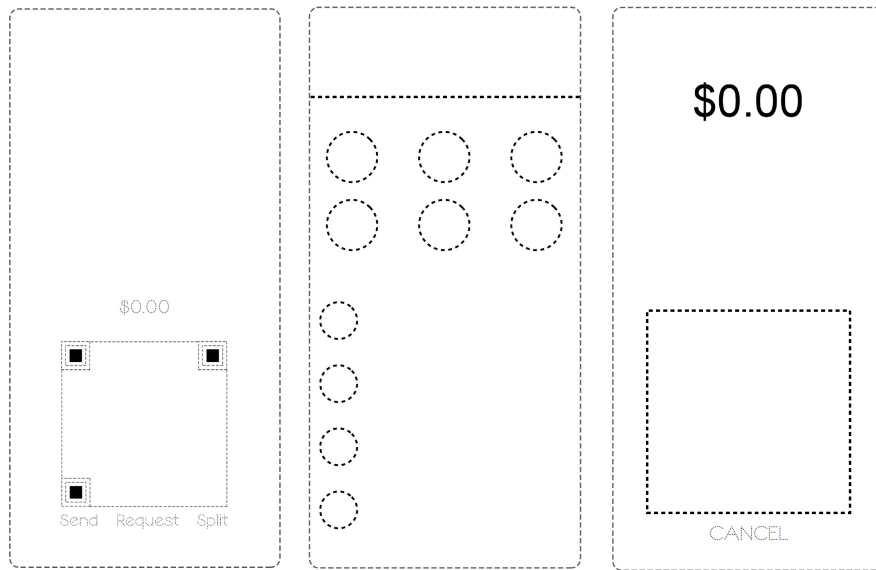
102. See *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 524 (1871) (“The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.”).

103. See, e.g., Complaint, ETLA, LLC v. PayPal, No. 6:21-cv-01005 (W.D. Tex. Sept. 28, 2021), ECF 1 (alleging infringement of U.S. Patent No. D931,899 for a design for a “[d]isplay screen portion with animated graphical user interface”); Complaint, Wepay Glob. Payments LLC v. PNC Bank, N.A., No. 1:21-cv-05052, at \*7 (N.D. Ill. Sept. 23, 2021), ECF 1 at \*7 (alleging infringement of U.S. Patent No. D930,702, for a design for a “[d]isplay screen portion with animated graphical user interface”); Complaint, Fintech Innovation Assocs. LLC v. Samsung Elecs. Co., No. 1:22-cv-01213 (N.D. Ill. Mar. 8, 2022), ECF 1 (alleging infringement of U.S. Patent No. D945,453, for a design for a “[d]isplay screen portion with animated graphical user interface”).

104. See, e.g., *Wepay Glob. Payments LLC v. PNC Bank N.A.*, No. 2:22-cv-00592, 2022 WL 1782504, at \*1 (W.D. Pa. June 1, 2022); see also Sarah Burstein, *Animated Design Patents*, PATENTLY-O (June 20, 2022) [hereinafter Burstein, *Animated Design Patents*], <https://patentlyo.com/patent/2022/06/animated-design-patents.html> [<https://perma.cc/AN9Y-AXHW>] (discussing this case).

105. A design patent can only contain one claim. 37 C.F.R. § 1.154(b)(6) (2023). However, the USPTO will allow a design patent applicant to claim more than one “embodiment” of that claim “if they involve a single inventive concept according to the nonstatutory double patenting practice for designs.” MPEP, *supra* note 47, § 1504.05 (citing *In re Rubinfeld*, 270 F.2d 391 (C.C.P.A. 1959)). But “the real test seems to be: ‘What can you get past the examiner?’” Sarah Burstein, *Whole Designs*, 92 U. COLO. L. REV. 181, 240 (2021) [hereinafter Burstein, *Whole*].

106. Display Screen Portion with Animated Graphical User Interface, U.S. Patent No. D930,702 figs.3–5 (issued Sept. 14, 2021).



This patent, like the one for the medical label shown above, uses the broken-line convention to disclaim portions of the overall GUI design—really, to disclaim almost all of it.<sup>107</sup> In accordance with USPTO rules for claiming “changeable computer generated icons,” the patent also indicates that “[t]he process or period in which one image transitions to another image forms no part of the claimed design.”<sup>108</sup>

Thus, the second embodiment claims a sequence of images showing what appears to be the three inner squares of a QR code, taking up a significant portion of the lower half of the screen; then, a screen wherein all the visual elements have been disclaimed,<sup>109</sup> and then, a screen showing a zero-dollar balance, in a sans-serif font, in the upper portion of the screen. The claim excludes the periods of transition between these screens.

107. *Id.* at Description (indicating that the broken lines are meant to “form[] no part of the claimed design”).

108. *Id.* The MPEP explains that

[c]omputer generated icons including images that change in appearance during viewing may be the subject of a design claim. Such a claim may be shown in two or more views. The images are understood as viewed sequentially, no ornamental aspects are attributed to the process or period in which one image changes into another.

See MPEP, *supra* note 47, § 1504.01(a)(IV).

109. It is not clear why the applicant might have claimed this second part. If there were a continuation pending, one might think the applicant was planning to do some daisy-chain claims. See Burstein, *Shape*, *supra* note 58, at 603–04 (explaining this “daisy-chain” technique and why applicants use it). But the file wrapper for the D’702 patent shows no continuity data.

There has been some debate over the scope of this claim. In one case, a Grecia company argued that its patent covers any app with an icon array of three squares that simulate a QR code; [that] cycle[s] to a functional screen where the user may choose to whom the money will be sent; and [] conclude[s] with the display screen with a display of a zero value, where the user may input the amount of money that the user wishes to send.<sup>110</sup>

In other words, the company seemed to take the position that the placement and proportions of the claimed design elements did not matter. But the court disagreed, concluding that “notable differences in shape size and spacing” of the design elements precluded a finding of infringement.<sup>111</sup> Whatever the precise scope of the claim, the patent seems to fall below the *Feist* standard. Indeed, another defendant challenged the originality of this patent in a different case.<sup>112</sup> But the judge denied the motion on procedural grounds without addressing the substantive issue.<sup>113</sup>

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110. *Wepay Glob. Payments LLC v. PNC Bank N.A.*, No. 2:22-cv-00592, 2022 WL 1782504, at \*2 (W.D. Pa. June 1, 2022).

111. *See id.* at \*3. For more on this decision, see Burstein, *Animated Design Patents*, *supra* note 104. Wepay filed an appeal, but that appeal was dismissed for failure to prosecute. Order, *Wepay Glob. Payments LLC v. PNC Bank, Nat’l Ass’n*, No. 22-2268 (Fed. Cir. Dec. 23, 2022), ECF 5.

112. Defendant PayPal’s Rule 12(b)(6) Motion to Dismiss for Lack of Ornamentation and Lack of Originality, *Wepay Glob. Payments LLC v. PayPal, Inc.*, No. 6:21cv1094 (W.D. Tex. Dec. 13, 2021), ECF 7. PayPal did not cite *Feist* in its motion but instead focused on the “independent creation” interpretation of “original” from *Seaway*. *Id.* at 5 (citing *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009)). For more on *Seaway*, see *infra* Part IV.C.

113. The judge reasoned that,

The cases cited by PayPal, Inc. are unavailing under a rule 12(b)(6) standard. Many of the cited cases are of Rule 12(c) posture or present distinct facts. Thus, the Court DENIES Defendant’s Rule 12(b)(6) Motion to Dismiss (ECF No. 7) and grants leave for Defendant PayPal, Inc. to file a Rule 56 Motion for Summary Judgment or Rule 12(c) Motion for Judgment on the Pleadings.

Order Denying Defendant PayPal’s Rule 12(b)(6) Motion to Dismiss for Lack of Ornamentation and Lack of Originality at 2, *Wepay Glob. Payments LLC v. PayPal, Inc.*, No. 6:21cv1094 (W.D. Tex. June 9, 2022), ECF 29.

Notably, PayPal seemed to interpret the design patent as covering free-floating motifs, at least for the purposes of their motion on the pleadings. Defendant PayPal’s Rule 12(b)(6) Motion to Dismiss for Lack of Ornamentation and Lack of Originality at 5, *Wepay Glob. Payments LLC v. PayPal, Inc.*, No. 6:21cv1094 (W.D. Tex. Dec. 13, 2021), ECF 7 (“As Mr. Grecia clearly took the dollar sign and the QR code from elsewhere in the public space, the lack of originality is a subject of this motion.”); *id.* at 8 (“Even if one assumes for the purposes of this motion that the QR code portion followed by a ‘\$0.00’ is a legally proper animated design (which it is not), there is no conceivable originality in displaying a QR code and ‘\$0.00’ on a screen.”).

### III. WHY DO SUB-*FEIST* DESIGN PATENTS EXIST?

If, as the conventional wisdom holds, design patent law has a higher creativity threshold than copyright law, the existence of sub-*Feist* design patents presents something of a puzzle.<sup>114</sup> This Part considers some possible explanations in turn.

#### A. *Is the USPTO Failing at Examination?*

Some might argue that sub-*Feist* patents are being issued because the USPTO is not doing a good job of examining patent applications.<sup>115</sup> It is difficult to fully evaluate the quality of design patent examination, however, because the USPTO generally does not publish design patent applications unless and until they mature into issued design patents.<sup>116</sup> We do know that, at least in recent years, the USPTO's design patent allowance rate—as best as we can tell—has been very high—well over 80 percent.<sup>117</sup>

Dennis Crouch has suggested that the high grant rate is the result of “the USPTO's *sub silento* abdication of its gatekeeper function in the realm of design patents.”<sup>118</sup> But, given the best available evidence, that seems unlikely. If the USPTO were misapplying Federal Circuit law, we would expect to see a high rate of design patent invalidation in litigation.<sup>119</sup> But the rate of design patent invalidation, like the rate of design patent rejection, is quite low.<sup>120</sup>

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114. See *supra* note 1.

115. Cf. Crouch, *supra* note 8, at 19 (“The high-allowance rate appears to be primarily triggered by the USPTO's *sub silento* abdication of its gatekeeper function in the realm of design patents.”).

116. See 35 U.S.C. § 122(b)(2)(A)(iv). Applications filed using the Hague System are an exception. See *id.* § 154(d)(1); see also *id.* § 381 (providing definitions for the Hague-ratification provisions). But Hague applications are likely not a representative sample. Sarah Burstein & Saurabh Vishnubhakat, *The Truth About Design Patents*, 71 AM. U. L. REV. 1221, 1234 (2022).

117. *Id.* at 1265 (“For nearly the last quarter-century, the apparent success rate of design patent applications has been over 85%.”). As of December 2023, the USPTO reported a design patent allowance rate of 82.7 percent “[c]umulative for fiscal year 2024.” *Design Data December 2023*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/dashboard/patents/design.html> [<https://perma.cc/9M2L-4F6L>].

118. Crouch, *supra* note 8, at 19.

119. Burstein & Vishnubhakat, *supra* note 116, at 1279 (“But if [abdication] were the case, we would expect to see more design patents invalidated in court and in the PTAB.”).

120. *Id.* at 1282 (reporting that, “in district-court cases filed between 2008–2020, when validity was adjudicated, design patents were invalidated only 11.6% of the time”); *id.* at 1283 (“In other words, in district-court cases filed between 2008–2020, when validity was adjudicated, the design patent was upheld 88.4% of the time.”). Design patents have also fared well in the USPTO's Patent Trial & Appeal Board (“PTAB”). See *id.* at 1283 (“Between 2012 and August

The more likely explanation for the USPTO's high grant rate is the case law.<sup>121</sup> The Federal Circuit has eroded the requirements for design patentability to the point that it is very difficult for the USPTO to reject design patent applications, no matter how ordinary or banal the claimed design.<sup>122</sup> The next Section will take a closer look at the Federal Circuit's tests for design patent validity.

*B. Has the Federal Circuit Gotten the Law Wrong?*

Some might argue that sub-*Feist* designs exist because the Federal Circuit has misapplied the requirements of novelty and nonobviousness in the context of designs.<sup>123</sup> This Section discusses those requirements in turn. For each requirement, it first explains what the Federal Circuit's current test is and why it does not weed out sub-*Feist* designs. It then considers the question of whether each requirement can or should do so.

1. *Novelty.*

*a. In practice, the test for novelty does not weed out sub-Feist designs.* Pursuant to § 102 of the Patent Act, a patentable design must be novel.<sup>124</sup> The Federal Circuit has held that a design patent claim is not

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2020, the overall survival rate for design patents challenged in post-grant-review proceedings in the PTAB was 79%. Specifically, the rate was 78% for IPR challenges and 81% for PGR challenges.”).

121. Burstein, *Lax*, *supra* note 8, at 624 (“Federal Circuit law makes it nearly impossible for the USPTO to reject most design patent claims—no matter how banal, trivial, or uncreative. This, not some ‘*sub silentio* abdication of its gatekeeper function,’ would seem to be the most likely explanation for the USPTO’s high design patent allowance rate.” (citation omitted)).

122. *Id.*

123. It might also be argued that sub-*Feist* designs should be deemed invalid as not “ornamental.” See 35 U.S.C. § 171(a) (“Whoever invents any new, original and *ornamental* design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)); cf. Brian L. Frye, *Against Creativity*, 11 NYU J.L. & LIBERTY 426, 446 (2017) (“In the alternative, the Court could have held that copyright cannot protect a white pages telephone directory as a compilation of facts because the selection, ordering, and arrangement of those facts is purely functional.”). Perhaps this statutory requirement could be interpreted to include something akin to *Feist*’s minimal creativity, but the statute does not compel such a reading. If we construe “ornamental” using its modern-day synonym, “decorative,” the issue becomes clearer. Items can be decorative but also uncreative, like generically shaped Christmas lights or a classic string of pearls. Or they might seem visually creative but not decorative, like an aesthetically pleasing machine part that is hidden in use.

124. 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, *subject to the conditions and requirements of this title.*” (emphasis added)); *id.* § 102 (requiring novelty).

novel (or is “anticipated”) when an “ordinary observer,” a hypothetical “purchaser familiar with the prior art,”<sup>125</sup> would think the claimed design looks the same as a design disclosed in a single prior art reference.<sup>126</sup> In accordance with patent law’s symmetry principle, this “ordinary observer” standard is the same standard that is used for design patent infringement.<sup>127</sup> The principle that design patent infringement is a test of visual similarity goes all the way back to the Supreme Court’s first design patent case, *Gorham v. White*.<sup>128</sup> In describing how similar two designs must be for infringement to occur, the Court stated that they must be so visually similar “in the eye of an ordinary observer” that they might “purchase one supposing it to be the other.”<sup>129</sup> The contemporary version of the ordinary observer standard was laid out in *Egyptian Goddess v. Swisa*<sup>130</sup> and recognized as the standard for anticipation in *International Seaway v. Walgreens*.<sup>131</sup>

In applying the ordinary observer standard, the factfinder must consider the claimed design as a whole.<sup>132</sup> Anticipation, like infringement, must be based on the visual similarity of the actual shapes or surface designs claimed, not the similarity of the products’

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125. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 683 (Fed. Cir. 2008) (en banc).

126. *See Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1244 (Fed. Cir. 2009) (holding that the *Goddess* “ordinary observer” test is the sole test for design patent anticipation).

127. *Seaway*, 589 F.3d at 1239 (“[I]t has been well established for over a century that the same test must be used for both infringement and anticipation. This general rule derives from the Supreme Court’s proclamation 120 years ago in the context of utility patents: ‘that which infringes, if later, would anticipate, if earlier.’” (internal citation omitted) (quoting *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889))). “The same rule applies for design patents.” *Id.* (citing *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1378 (Fed. Cir. 2004), *abrogated on other grounds by Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312 (Fed. Cir. 2001); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1440 (Fed. Cir. 1984)).

128. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 526 (1871) (“We are now prepared to inquire what is the true test of identity of design. Plainly, it must be sameness of appearance . . .”).

129. *Id.* at 528. Contemporary readers sometimes misread this part of *Gorham* as establishing a test that looks something like the contemporary consumer-confusion test that is used in trademark law. For an explanation of why that is not the case, *see Sarah Burstein, The Patented Design*, 83 TENN. L. REV. 161, 177 (2015) [hereinafter *Burstein, The Patented Design*] (explaining that the *Gorham* test is one of visual similarity, not consumer confusion).

130. *Egyptian Goddess*, 543 F.3d at 678 (“[W]e hold that the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed.”). For more on the *Goddess* test and how it works, *see Burstein, Goddess, supra* note 96, 96–105 (discussing design patent infringement under *Egyptian Goddess*).

131. *Seaway*, 589 F.3d at 1239.

132. *Id.* at 1243 (“[T]he ordinary observer test requires consideration of the design as a whole . . .”).

functions or of the general design concepts.<sup>133</sup> As the Federal Circuit explained in *Seaway*: “In the case of infringement, in applying the ordinary observer test, we compared the patented design with the accused design. In the case of anticipation, we compared the patented design with the alleged anticipatory reference.”<sup>134</sup> And the required degree of visual similarity is quite high.<sup>135</sup>

It can also be especially difficult to find close prior art—that is, items that could count as potentially anticipatory references—for design patents.<sup>136</sup> And even if it is found, it may be difficult to get into evidence. Patent law places various limits on how challengers can plead and prove the content of the prior art. For example, someone cannot simply testify: “My grandma used to wear those exact pants.”<sup>137</sup> There must be corroborating documentary evidence.<sup>138</sup> This may be especially difficult in areas relating to the decorative arts, especially for items that traditionally are—or can be—made at home, such as hand-knitted products. That means that designs that are not, in fact, novel may still be patented due to a dearth of discoverable or admissible evidence.

For all of these reasons, the standard for design patent novelty does not subsume the *Feist* standard.<sup>139</sup> In some cases, it might overlap with *Feist*’s requirement of independent creation.<sup>140</sup> If a claimed design looked the same as a single piece of prior art, it would seem unlikely that the design was independently created. But it might have been. In this sense, design patent novelty might fairly be seen as a higher rung on the newness ladder. If there is a single prior art reference that

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133. Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 117 (2016) [hereinafter Burstein, *Costly*] (“[A] design patent protects only the claimed designs, not the general design concept.”).

134. *Seaway*, 589 F.3d at 1238 (internal citation omitted).

135. Burstein, Goddess, *supra* note 96, at 99–102 (providing a few representative examples from infringement cases).

136. See Burstein & Vishnubhakat, *supra* note 116, at 1257–61 (discussing some difficulties with design searching).

137. This is a slightly paraphrased version of the kinds of replies I sometimes get when I post real design patent images on social media.

138. See *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 740 (Fed. Cir. 2002) (explaining that “[h]istorically, courts have looked with disfavor upon finding anticipation with only oral testimony,” citing generally to *The Barbed Wire Patent*, 143 U.S. 275 (1892)).

139. Cf. *Seymour & Torrance*, *supra* note 18, at 187 (“Both the newness and originality requirements of the design patent statute appear to be subsumed within the requirements imposed by §§ 102 and 103(a).”).

140. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (holding that for a work to be original, it must first be “independently created by the author (as opposed to copied from other works)”).



discloses the claimed design but the designer did *not* copy that reference, the design would be invalid under *Seaway* but not under prong one of *Feist*. Subjective newness (newness to the designer) is enough under *Feist*; a more objective kind of newness is required by *Seaway*.<sup>141</sup>

But nothing in the *Seaway* test subsumes the minimal creativity requirement of *Feist*. “Does this design look the same as a single piece of prior art?” is a fundamentally different question than “Is this design creative, even minimally so?” Nothing in the *Seaway* test allows courts (or examiners) to invalidate a design that is not creative *per se*. It only allows them to invalidate a design that looks the same as something that qualifies as prior art. Therefore, as currently implemented, the design patent anticipation test cannot reliably weed out sub-*Feist* designs.

*b. Could (or should) the requirement of novelty weed out sub-Feist designs?* Some might argue that the *Seaway* test is flawed and that a properly calibrated novelty test could or should subsume the *Feist* standard.<sup>142</sup> But no matter how the test for design patent anticipation is framed, § 102 dictates that the ultimate issue is whether the design is objectively new.<sup>143</sup> Whether a design is objectively new is a fundamentally different question than whether that design is creative. A design could be new and creative. Or it could be new and not creative. In the latter case, the sub-*Feist* design would not be anticipated.<sup>144</sup> Some might suspect that uncreative designs are more likely to be anticipated, but that is at least questionable as an empirical matter.<sup>145</sup>

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141. Cf. J.H. Reichman, *Charting the Collapse of the Patent-Copyright Dichotomy: Premises for a Restructured International Intellectual Property System*, 13 CARDOZO ARTS & ENT. L.J. 475, 481 n.22 (1995) (distinguishing between “originality or subjective novelty” and “objective novelty”).

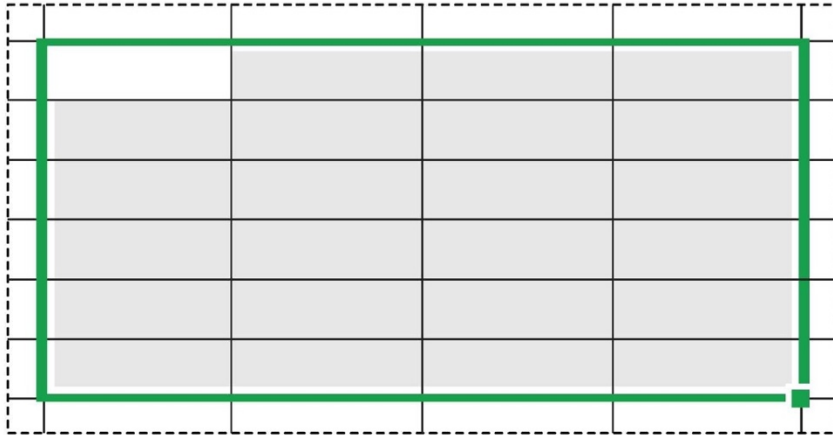
142. While the author has not seen that particular argument made, commentators have criticized *Seaway* on other bases. See, e.g., Buccafusco, Lemley & Masur, *supra* note 1, at 113 (criticizing the courts and the USPTO for “seem[ing] to require that the two designs be nearly identical in every feature” before declaring a design invalid for lack of novelty).

143. See 35 U.S.C. § 102 (defining the requisite novelty).

144. In theory, of course, § 102 could always be revised. But given long pattern and practice, it seems unlikely to be changed in a way that would be directly tied to creativity.

145. And of course, it would depend on the exact nature of the § 102 test.

Consider, for example, this design patent that was issued to Microsoft in 2013 for a design for a part of a “Display Screen With Graphical User Interface”<sup>146</sup>:



The claim covers a range of conventionally shaped spreadsheet cells.<sup>147</sup> The cells are all filled in with grey save for the cell in the upper left, and the entire range of cells is surrounded by a green line that is thicker than the black lines that define the spreadsheet cells.<sup>148</sup>

As of the filing date, June 13, 2012, it may have technically been novel to put a green line around what appear to be greyed-out spreadsheet cells. The examiner would have been hard-pressed to find admissible prior art (if it even existed). But it does not seem to be particularly creative. Especially when it is the same green Microsoft uses for its Excel spreadsheet program branding. So basically, the design boils down to: “Highlight some cells in the brand color.”

Indeed, because of patent law’s symmetry principle, creativity in the *Feist* sense cannot be a test for novelty—at least, not without making fundamental changes to the nature of design patent law. Creativity, in the *Feist* sense, is not a part of the longstanding “ordinary observer” approach to design patent infringement. And it is difficult to see how it could be part of any design patent infringement test, unless

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146. Display Screen with Graphical User Interface, U.S. Patent No. D691,154, fig.2 (issued Oct. 18, 2013).

147. *Id.*

148. *Id.* Where the green lines visually meet at the bottom right, there is a green box.

we abandon the longstanding principle that design patent infringement should be a matter of visual similarity.<sup>149</sup> One might argue that the symmetry principle should be abandoned for designs, but that also would be a major, fundamental change.<sup>150</sup>

And even if we tweaked the *Seaway* test to allow for anticipation by less visually similar designs,<sup>151</sup> that still would not directly get at the issue of creativity *per se*. “More different” is not necessarily the same as “more creative”—or even “better.”<sup>152</sup> And in design, quantitatively small differences can have a big qualitative impact.<sup>153</sup> So it is unclear whether requiring a greater quantum of difference would result in increasing the quality (let alone creativity) of patented designs. And doing so would also come at a cost. Unless we abandon the symmetry principle, allowing for anticipation by less visually similar designs would also require allowing for infringement by less visually similar designs.<sup>154</sup>

In the end, regardless of the precise test used, “new” is just a fundamentally different concept than “creative.” So, while the *Seaway* test may be criticized, the Federal Circuit’s application of § 102 does not seem to explain, at least not entirely, the existence of sub-*Feist* design patents.

## 2. *Nonobviousness.*

*a. In practice, the test for nonobviousness does not weed out sub-Feist designs.* Pursuant to § 103 of the Patent Act, a patentable design

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149. See generally, *supra* notes 128–29 and accompanying text (describing the ordinary observer test and the limits of a design patent claim).

150. At a minimum, the costs and benefits of a change of that magnitude should be given close consideration before a change of that magnitude is made.

151. See Buccafusco, Lemley & Masur, *supra* note 1, at 124–25 (“When prior art discloses a design that substantially anticipates the principal features of the claimant’s design . . . the PTO should deny the patent or the courts should invalidate it.”); Burstein, Goddess, *supra* note 96, at 106–07 (arguing against this “substantially anticipates” test).

152. See W. Nicholson Price II, *The Cost of Novelty*, 120 COLUM. L. REV. 769, 794 (2020) (“[P]atent doctrine does not require that inventions be better, only new.”).

153. See Burstein, *Whole*, *supra* note 105, at 247 (“Focusing on the size of any changes or differences, however, misses a key point. When it comes to design, quantitatively small changes can make a big qualitative impact.”).

154. See Burstein, Goddess, *supra* note 96, at 107 (“If the price of maintaining a very limited scope is an extremely high burden for anticipation, the tradeoff may well be worth it.”).

cannot be “obvious.”<sup>155</sup> According to the Federal Circuit, the proper inquiry under § 103 is whether “a designer of ordinary skill who designs articles of the type involved,” that is, an ordinary designer, “would have combined teachings of the prior art to create the same overall visual appearance as the claimed design.”<sup>156</sup>

Under the framework set forth by the Supreme Court in its first § 103 decision, *Graham v. John Deere Co. of Kansas City*,<sup>157</sup> a factfinder must make “several basic factual inquiries” when a patent is challenged under 35 U.S.C. § 103.<sup>158</sup> Specifically, the factfinder must determine “the scope and content of the prior art,” the “differences between the prior art and the claims at issue,” and “the level of ordinary skill in the pertinent art.”<sup>159</sup> Factfinders may also consider “[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc.” in order “to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”<sup>160</sup>

To determine whether a design is obvious, the Federal Circuit uses the two-part test set forth in *Durling v. Spectrum Furniture Co.*<sup>161</sup> First,

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155. See 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, *subject to the conditions and requirements of this title.*” (emphasis added)); *id.* § 103 (requiring nonobviousness).

156. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (citing *In re Rosen*, 673 F.2d 388, 390 (C.C.P.A. 1982); *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)).

157. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1 (1966).

158. *Id.* at 17.

159. *Id.*

160. *Id.* at 17–18. The Federal Circuit often refers to these secondary factors as “objective indicia of nonobviousness.” *E.g.*, *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021). And while the Supreme Court has characterized these as factors that “might be utilized,” *Graham*, 383 U.S. at 17, the Federal Circuit says they “must” be considered, *Sash Controls, Inc. v. Talon, L.L.C.*, Nos. 98–1152, 98–1182, 185 F.3d 882, 1999 WL 110546, at \*5 (Fed. Cir. 1999) (per curiam) (unpublished table decision) (“We have held that secondary considerations must always be considered in an obviousness determination, and it was error by the district court to exclude that evidence from consideration in making its obviousness determination.” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983))). Importantly, “[e]vidence of objective indicia of nonobviousness must have a nexus to the claims, i.e., ‘there must be a legally and factually sufficient connection between the evidence and the patented invention.’” *Campbell Soup*, 10 F.4th at 1276 (quoting *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019)).

161. *Campbell Soup*, 10 F.4th at 1275 (Fed. Cir. 2021) (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). This may, however, be changing. On June 30, 2023, the Federal Circuit granted rehearing en banc in a design patent case and ordered briefing on the continuing viability of the *Durling* test, including the *Rosen* primary reference requirement. See *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383, 1384 (Fed. Cir. 2023). For more on *Rosen*, see *infra* note 162 and accompanying text. While the appellant in that case asks the court to eliminate the *Durling* and *Rosen* tests, it does not challenge the basic concept of obviousness as a measure of distance from the prior art. Nor does it challenge the combining-

the factfinder “must determine whether there exists a ‘primary reference,’ that is, a single reference that creates ‘basically the same visual impression’ as the claimed design.”<sup>162</sup>

Second, and only if a proper primary reference is identified, the factfinder “must determine whether, using secondary references, an ordinary designer would have modified the primary reference to create a design that has the same overall visual appearance as the claimed design.”<sup>163</sup> But “secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’”<sup>164</sup>

So one big difference between § 102 (novelty) and § 103 (nonobviousness) is that invalidation under § 103 can be based on multiple references. But when does a secondary reference provide sufficient “suggestion” under step two of the *Durling* test? It is hard to know because the Federal Circuit rarely gets to that step.<sup>165</sup> In recent years, the Federal Circuit has required an extremely high degree of visual similarity for primary references, seeming to leave little room between what qualifies as “the same” design (and, thus, anticipates) and “basically the same” (and, thus, would constitute a proper primary

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references approach to § 103. *See infra* notes 189–92 and accompanying text. So no matter what the court does in *LKQ*, it seems unlikely to undermine the main arguments being made in this Article.

162. *Campbell Soup*, 10 F.4th at 1275. This requirement goes back to the 1982 CCPA case *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982). Accordingly, a primary reference is sometimes called a “*Rosen* reference.” *See, e.g.*, Janice M. Mueller & Daniel Harris Brean, *Overcoming the “Impossible Issue” of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 493 (2011) (using this terminology); Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531, 608 n.474 (2010) (noting that “primary references are commonly referred to as *Rosen* references”). It is also worth noting that the design patent primary reference approach is somewhat analogous to the “lead compound” approach used when analyzing utility patent claims for chemical compounds. *See Eisai Co. v. Dr. Reddy’s Lab’s, Ltd.*, 533 F.3d 1353, 1359 (Fed. Cir. 2008) (“[A] *prima facie* case of obviousness for a chemical compound . . . in general, begins with the reasoned identification of a lead compound.”); Price, *supra* note 152, at 786–87 (citing Briana Barron, *Structural Uncertainty: Understanding the Federal Circuit’s Lead Compound Analysis*, 16 MARQ. INTELL. PROP. L. REV. 401, 423 (2012)).

163. *Campbell Soup*, 10 F.4th at 1275 (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).

164. *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996) (alteration in original)).

165. While this “so related” language has been used in design patent cases for a long time, “its meaning has never been particularly clear.” Burstein, *Lax*, *supra* note 8, at 616; *see also* Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169, 183–85 (2012) [hereinafter Burstein, *Visual Invention*] (discussing the “so related” test and some of the troubles courts have had in applying it).

reference).<sup>166</sup> This overly rigid application of the primary reference requirement makes the *Durling* test difficult for challengers (and patent examiners) to satisfy.<sup>167</sup>

And, most importantly for our purposes, the *Durling* test does not necessarily subsume the “minimal creativity” requirement of *Feist*.<sup>168</sup> It does not allow for any direct inquiry into the issue of creativity *per se*. The question of whether “an ordinary designer would have modified the primary reference to create a design that has the same overall visual appearance as the claimed design”<sup>169</sup> might overlap, in some cases, with the question of whether the resulting design “possess[es] some creative spark, no matter how crude, humble or obvious it might be.”<sup>170</sup> But not always. And certainly not when the former question has to be considered within the framework set forth in *Durling*.

The overall question raised in the nonobviousness inquiry—that is, “whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design”—is a different question than “whether this design is creative, even minimally so.” The differences may be subtle, but they are important. Nothing in the *Durling* test allows courts (or examiners) to inquire into whether a design is creative *per se*. It only allows them to invalidate a design patent claim when its rigidly applied (in the first part) and confusing (in the second part) requirements are met.

For example, if the LEGO tape discussed above were challenged as obvious in court, the factfinder would not inquire into whether the

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166. Burstein, *Lax*, *supra* note 8, at 617 (“In theory, there should be some blue sky between a design that is ‘basically the same’ as a claimed design . . . and a design that is ‘the same’ . . . . But in practice, it’s difficult to see much difference in how these standards are applied.” (footnote omitted)). For another example, see Burstein, *Visual Invention*, *supra* note 165, at 202–05 (discussing *Vanguard Identification Sys., Inc. v. Kappos (Vanguard III)*, 407 F. App’x 479, 480 (Fed. Cir. 2011) (*per curiam*)).

167. Burstein, *Lax*, *supra* note 8, at 617. It is worth noting that the problem here is not the *Rosen* requirement *per se*; it is the overly rigid way in which the Federal Circuit has applied it. See Sarah Burstein, *In Defense of Rosen References*, PATENTLY-O (Dec. 6, 2022) [hereinafter Burstein, *Rosen References*], <https://patentlyo.com/patent/2022/12/defense-rosen-references.html> [<https://perma.cc/C2W4-YMWV>].

168. Cf. *Seymour & Torrance*, *supra* note 18, at 187 (“Both the newness and originality requirements of the design patent statute appear to be subsumed within the requirements imposed by §§ 102 and 103(a).”); see also Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169, 173 (2008) (“In general, creativity does not enter directly into patent protection analysis, because to the extent creativity is a necessary condition, it is already built into a more specific statutory framework, especially the requirement for nonobviousness.”).

169. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021) (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).

170. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (quotations omitted).

shape was creative in some broad sense. Instead, they would have to consider whether it was sufficiently different in appearance from the prior art, starting with the primary reference requirement. If the idea of LEGO tape was new, there probably is not a primary reference; there is likely nothing out there with “basically the same” shape.<sup>171</sup> But again, design patents are supposed to protect shapes, not ideas. And creativity in concept is not the same as creativity in visual appearance.

Therefore, as currently implemented, the design patent anticipation test cannot reliably weed out sub-*Feist* designs.

*b. Could (or should) the test for nonobviousness weed out sub-Feist designs?* The Federal Circuit may well be misapplying § 103 to design patents. There is, for example, plenty of room to criticize the *Durling* approach.<sup>172</sup> But that does not necessarily mean that Federal Circuit § 103 caselaw is the reason—or at least the main reason—why we see sub-*Feist* design patents. Instead, as this Section shows, “nonobviousness” and “minimal creativity” are different concepts, not higher and lower rungs on a single ladder of creativity.<sup>173</sup>

Section 103 of the Patent Act provides:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the

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171. For example, a standard LEGO brick could not be a primary reference because a brick would not have “basically the same” shape as the claimed spool of toy tape.

172. *E.g.*, Buccafusco et al., *supra* note 1, at 125 (criticizing the current approach and suggesting that it should be possible to invalidate a design patent under § 103 without a primary reference). Additionally, if applied rigidly, the *Durling* test is in serious tension—if not outright conflict—with the flexible approach the Supreme Court called for in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). *See id.* at 401–02 (rejecting the use of “rigid and mandatory formulas” in making § 103 determinations); Burstein, *Visual Invention*, *supra* note 165, at 200–05 (arguing that the *Rosen* primary reference requirement is not *per se* incompatible with *KSR* but noting that the Federal Circuit may be applying that requirement too rigidly); Maureen Long, *The Nonobviousness Requirement for Design Patents: What Is the Standard and Why Shouldn’t It Obviously Be Modified After KSR?*, 45 AIPLA Q.J. 193, 199 (2017) (“This article argues that the two-step test for design patent nonobviousness analysis is inappropriate in light of *KSR* as it is too rigid and narrows the universe of prior art on which obviousness analysis may rely.”); Mueller & Brean, *supra* note 162, at 522 (2011) (“To the extent that the Supreme Court’s recent *KSR* decision is relevant at all to the nonobviousness of designs, it would be only for the general principle that the nonobviousness requirement should be applied in a flexible manner.”).

173. *Cf.* Aaron X. Fellmeth, *Uncreative Intellectual Property Law*, 27 TEX. INTELL. PROP. L.J. 51, 87 (2019) (arguing, in a piece focused on utility patents, that “[w]e must resist the temptation to equate the nonobviousness requirement to a creativity condition”).

claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.<sup>174</sup>

Reading this text, one might argue that the statutory command to determine whether a design is “obvious” necessarily involves (or even subsumes) the question of whether the design is “creative.” While that argument might make sense in plain English, patent English is different. In patent English, “obviousness” is not about creativity in and of itself; rather, it is about the quantum of newness.<sup>175</sup> While § 102 requires that a design be “new” in an absolute sense, § 103 requires that the design be new *enough*.<sup>176</sup>

By its own terms, § 103 does not allow a factfinder to engage in a free-wheeling, open-ended inquiry into whether a design is “obvious” in some broad sense. Instead, it commands the factfinder to focus on “the differences between the claimed invention and the prior art.”<sup>177</sup> As discussed above, “the prior art” is a patent term of art. It does not (and probably should not be construed to) include everything in existence prior to the creation of the claimed design.<sup>178</sup>

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174. 35 U.S.C. § 103.

175. See, e.g., Price, *supra* note 152, at 785 (“The purpose of the obviousness requirement is to ensure that patents are not available for trivial advances in technology by requiring more substantial differences [than § 102] . . .”).

176. Sarah Burstein, *Moving Beyond the Standard Criticisms of Design Patents*, 17 STAN. TECH. L. REV. 305, 328 (2013) (describing nonobviousness as “the idea that a protectable design must not only be new, but new *enough*” (emphasis in original)).

177. See *id.* at 323. It also includes that obviousness be evaluated using “the effective filing date of the claimed” design. See *id.* But presumably, the timing requirement would be the same for originality. Section 103 also demands that obviousness be determined from the point of view of an ordinary designer. See *id.*; *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981) (“In design cases we will consider the fictitious person identified in [§] 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application.”). In theory, a determination of originality need not be bound to the same point-of-view requirement. This might not have a significant impact on the result of validity determinations, but it might well have an impact on cost and the feasibility of bringing an originality defense. Obviousness issues often require expert testimony, which is expensive. And, at least under current Federal Circuit law, there may not even be an applicable expert in some cases, such as where the design is directed to a new type of product. See *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1323 (Fed. Cir. 2016) (affirming the exclusion of a proffered expert because he did not have direct experience designing the particular type of article at issue in the case). The logic and wisdom behind the *Sport Dimension* exclusion decision is questionable; however, a full discussion of that issue is beyond the scope of this Article.

178. See Burstein, *The Patented Design*, *supra* note 129, at 209 (noting that “the act of taking an existing appearance and adapting it to a new product is, in itself, a valuable act of design”).



So, at bottom, § 103 is not about *Feist* minimal creativity but about difference—specifically, difference from the prior art. Whereas § 102 requires that a design be objectively new, § 103 requires that it be new enough.<sup>179</sup> But “new enough” is not necessarily the same as “better.”<sup>180</sup> Or even “good.” Let alone “creative” in the *Feist* sense. To the contrary, the final line of § 103 indicates that something may be patentable if it was discovered by plodding<sup>181</sup> or even by accident.<sup>182</sup> As Aaron Fellmeth has noted, “[i]nventive” is a common synonym of “creative” in everyday English, so it might seem logical to conclude that “patents encourage creativity.”<sup>183</sup> But, as Fellmeth also notes, the last sentence of § 103 suggests “that no actual creativity (in the sense of imagination or ingenuity) is required” for an invention to be considered nonobvious.<sup>184</sup> Under § 103, the key question is whether the

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179. See, e.g., Price, *supra* note 152, at 785 (“The purpose of the obviousness requirement is to ensure that patents are not available for trivial advances in technology by requiring more substantial differences [than § 102] . . .”).

180. See *id.* at 794 (noting that requirements like §§ 102 and 103 “promote divergent innovation but do not require improvement”); *id.* at 769 (“Patent law tries to spur the development of new and better innovative technology. But it focuses much more on ‘new’ than ‘better’ . . .”).

181. See Glynn S. Lunney, Jr. & Christian T. Johnson, *Not So Obvious After All: Patent Law’s Nonobviousness Requirement, KSR, and the Fear of Hindsight Bias*, 47 GA. L. REV. 41, 59 (2012) (noting that, following the addition of the “not be negated” line, an invention could still be nonobvious “even if the result of plodding and steady progress, rather than a flash of creative genius”); John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 43 (2007) (“[The ‘not be negated’] provision was intended to clarify that the particular inventor’s method and talents would be irrelevant . . . Thus, the inventor seized with a ‘flash of genius’ would not be favored over an engineer with ordinary skill and ingenuity who worked diligently . . . toward a useful advance.”); Jacob S. Sherkow, *Negating Invention*, 2011 BYU L. REV. 1091, 1102 (2011) (“The pre-*Hotchkiss* invention standard, a change in the ‘principle’ of the invention, did not materially favor one method of invention over another. Changes in the ‘principle’ of a machine could come through either a bout of ingenuity or diligent plodding at the workbench.”). As one of the drafters of the Patent Act explained, the last sentence means “that it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.” P. J. Federico, *Commentary on the New Patent Act*, 75 J. PAT. & TRADEMARK OFF. SOC’Y 161, 184 (1993). Federico’s reference to “long toil” sounds a lot like the “sweat of the brow” theory of originality that the Supreme Court rejected in *Feist*. See Fellmeth, *supra* note 173, at 87 (“[A]n invention discovered through painstaking but mechanical research—‘sweat of the brow’—with neither creativity nor fortuitous accident, is equally entitled to a patent. In adopting Section 103 of the 1952 Patent Act, Congress [clarified] that the absence of ingenuity, imagination or genius must not negate a patent.”).

182. Fellmeth, *supra* note 173, at 87 (“We must resist the temptation to equate the nonobviousness requirement to a creativity condition, however . . . . A product or process resulting from an accident . . . is entitled to a patent precisely as much as a product or process invented by the ingenuity or imagination of the inventor.”).

183. *Id.* at 70.

184. See *id.* at 75.

design is new enough—that is, how far it is from the prior art—not whether it is good or creative *per se*.

It is true that, in its 2007 decision in *KSR v. Teleflex*,<sup>185</sup> the Supreme Court invoked the concept of “creativity” while discussing obviousness. The Court stated that the “person of ordinary skill” referred to in § 103 is “a person of ordinary creativity, not an automaton.”<sup>186</sup> But, in doing so, the Court was not equating the § 103 inquiry with an inquiry into creativity. Instead, the Court was referring to the steps a person of skill (or in the design case, an ordinary designer) might take with respect to combining references.<sup>187</sup> Specifically, the Court said that, when considering whether it would have been obvious to combine certain references, “a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”<sup>188</sup> That is very different from saying that a court should consider whether the resulting combination was “creative” in the *Feist* sense.

This combining-references approach to analyzing obviousness is deeply embedded in patent law.<sup>189</sup> In considering whether a claimed invention is obvious, courts do not (as one might read the text of § 103 to suggest) simply consider “the differences between the claimed

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185. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

186. *Id.* at 421.

187. The Court emphasized in *KSR* that

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. . . . As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*Id.* at 418.

188. *Id.* On this point, the Court also noted in *KSR*,

[t]he second error of the Court of Appeals lay in its assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem. The primary purpose of Asano was solving the constant ratio problem; so, the court concluded, an inventor considering how to put a sensor on an adjustable pedal would have no reason to consider putting it on the Asano pedal. Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.

*Id.* at 420 (citations omitted).

189. We could, of course, change this approach—or amend § 103—but that would be a dramatic and fundamental change.

invention and the prior art.”<sup>190</sup> Instead, “[a]n obviousness determination requires finding that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.”<sup>191</sup> In other words, the contemporary § 103 test focuses on combining references. Although the Supreme Court criticized the Federal Circuit in *KSR* for being too “rigid” in the ways it allowed challengers to prove that such motivation existed, it did not question or dislodge this basic combining-references approach.<sup>192</sup>

In adapting these principles to the design space, courts have framed the basic § 103 inquiry as “whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design.”<sup>193</sup> Therefore, the question of what constitutes “the prior art” is key.

In utility patents, the scope of the prior art depends on which statutory requirement we are analyzing. For novelty, anything that was “described in a printed publication, or in public use, on sale, or otherwise available to the public” or described in a patent or patent application “before the effective filing date of the claimed invention” counts as a prior art.<sup>194</sup> For nonobviousness, case law further limits the scope of prior art to “analogous arts.”<sup>195</sup> The rules are different for designs. Novelty prior art is much more limited in the context of designs given the different nature of the invention protected and the

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190. 35 U.S.C. § 103. As Aaron Fellmeth has noted, “[t]he term ‘obvious’ is not defined in the Act, and the concept of obviousness is no more semantically self-defining than are the concepts of ingenuity or inventiveness.” Fellmeth, *supra* note 173, at 73; *id.* at 73 n.129 (“This was the position taken by the head of the Department of Justice’s Patent Litigation Unit at the time of drafting.” (citing *Patent Law Codification and Revision: Hearing on H.R. 3760 Before the Subcomm. No. 3 of the H. Comm. on the Judiciary*, 82d Cong. 38, 95 (1951) (statement of T. Hayward Brown))).

191. *Regents of Univ. of California v. Broad Inst., Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018) (citing *In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017)).

192. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007). This might more precisely be called a “hypothetical combination” approach; no one really thinks that (most) inventors are literally sitting there combining references.

193. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)).

194. *See* 35 U.S.C. § 102(a). For patents and patent applications, the rule is, specifically, that it must be “described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.” *Id.* § 102(a)(2).

195. *See, e.g., In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

difference in scope.<sup>196</sup> Nonobviousness prior art can also be said to be limited to “analogous arts,” but courts use a different concept of analogousness in the design context.<sup>197</sup> And again, this comparison is about how different the claimed design is from that prior art—not whether it is creative *per se*.

Of course, we could change what constitutes § 103 prior art for design patents. For example, we might say that a shape for any article could be considered “prior art” for a shape claim. But that could destabilize the recently (and correctly) settled question of design patent scope—that is, that design patents cover designs *as applied*, not designs *per se*.<sup>198</sup> And an anything-goes approach to § 103 prior art could also have the perverse effect of denying patentability to designs

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196. *In re SurgiSil*, L.L.P., 14 F.4th 1380, 1382 (Fed. Cir. 2021) (concluding that design for a lip implant could not be anticipated by a design for an art tool).

197. Compare the Federal Circuit’s emphasis that

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

*Bigio*, 381 F.3d at 1325 (citing *In re Deminski*, 769 F.2d 436, 442 (Fed. Cir. 1986) and *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)), with *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956) (“The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”). To be clear, having different “universes” of prior art for design patents is entirely appropriate and a good thing. See Burstein, *The Patented Design*, *supra* note 129, at 207 (“[T]he patented design should be conceptualized as the design as applied to a particular type of product.”); *id.* at 222–28 (explaining how this should affect the scope of the prior art). Contrary to some arguments that have been made recently, the Patent Act does not require courts to apply utility patent doctrine to design patents. Sarah Burstein, “*Design Patent Exceptionalism*” *Isn’t*, PATENTLY-O (July 6, 2023), <https://patentlyo.com/patent/2023/07/design-patent-exceptionalism.html> [<https://perma.cc/S9UA-JELM>]. To the extent that the decision in *Glavas* was based on—or may have implicitly assumed—that design patents protect designs *per se*, that “so related” test may need to be reevaluated in light of case law that definitively rejected the design *per se* view. See *In re SurgiSil*, L.L.P., 14 F.4th 1380, 1382 (Fed. Cir. 2021) (“A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.”); *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1340 (Fed. Cir. 2019) (“[D]esign patents are granted only for a design applied to an article of manufacture, and not a design *per se* . . .”).

198. *In re SurgiSil*, L.L.P., 14 F.4th 1380, 1382 (Fed. Cir. 2021) (“A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract.”); *Curver Luxembourg*, 938 F.3d at 1340 (“[D]esign patents are granted only for a design applied to an article of manufacture, and not a design *per se* . . .”); see also Burstein, *The Patented Design*, *supra* note 129, at 163 (explaining that this issue was still unsettled, at least at the Federal Circuit level, as of 2015).

that creatively apply old shapes to new contexts, like a handbag shaped like a binder clip<sup>199</sup> or a chandelier made up of tiny chairs.<sup>200</sup>

We could also eliminate the primary reference requirement. But despite the rigidity with which the Federal Circuit currently applies that requirement, that general approach does have the benefit of focusing the inquiry on the design as a whole.<sup>201</sup> And it is hard to say that a design is “obvious” in any meaningful sense of that word if there is no other article of the same type that looks “basically the same.”<sup>202</sup>

One exception might be pioneering products—those that effectively create a new product category. In those cases, there might be nothing that qualifies as prior art at all, depending of course on how broadly we define the scope of the prior art. But a design for a pioneering product might still seem “obvious” in the normal English sense of that word. For example, imagine that the first company to produce a heat-resistant fabric used an old surface design to decorate it. If the prior art is limited to only heat-resistant fabrics—as opposed

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199. *Clip Bag*, PETER BRISTOL (2024), <http://www.peterbristol.net/projects/clip-bag> [<https://perma.cc/8AXL-ECHM>] (noting that the “[n]ew scale creates new purpose”).

200. Burstein, *The Patented Design*, *supra* note 129, at 209 (“[T]he act of taking an existing appearance and adapting it to a new product is, in itself, a valuable act of design. Consider Paola Pivi’s ‘Love Ball’ chandelier, which was made from miniature models of chairs sold by Swiss furniture company Vitra.”).

201. Burstein, *Visual Invention*, *supra* note 165, at 200 (“The primary reference requirement performs the valuable function of focusing the nonobviousness inquiry on the design ‘as a whole.’”); *see also* Burstein, *Rosen References*, *supra* note 167 (arguing that, “properly and flexibly applied, [the primary reference] approach makes sense for designs and is consistent with” Supreme Court precedent).

202. *See id.* (“If a new design is so different from other products of its type that no primary reference can be found, that would generally be strong evidence of nonobviousness.” (citing *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966))). There may be cases where a proper primary reference is lacking but the design still seems “obvious.” *See* Burstein, *Visual Invention*, *supra* note 165, at 201–02 (discussing the fact patterns in *Bennage v. Phillippi*, 9 O.G. 1159 (1876), and *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680 (1893)).

to all fabrics—examples of the old surface design would not count as prior art.<sup>203</sup> So the design could not be (legally) obvious.<sup>204</sup>

Another situation where there might be no prior art but where a design might seem obvious is where a new design is shaped to fit to another product. Consider, for example, this design patent for a “removable transparent protective anti-graffiti road sign cover”<sup>205</sup>:

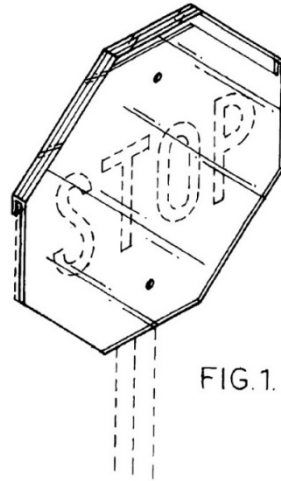


FIG. 1.

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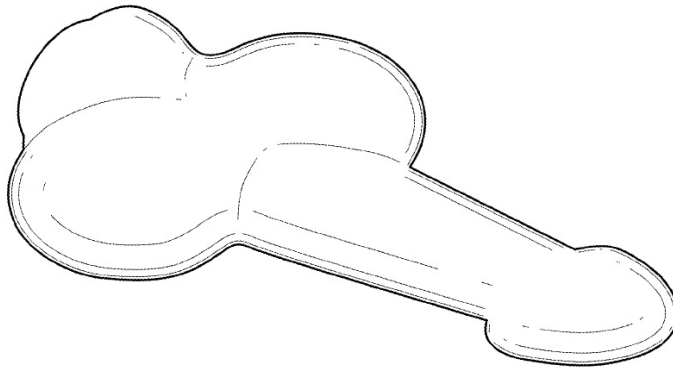
203. This example is loosely inspired by the facts of *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363 (Fed. Cir. 2023). See *Design Patents: Line Drawing & Locarno*, PATENTLY-O (Jan. 13, 2023), <https://patentlyo.com/patent/2023/01/burstein-patents-drawing.html> [<https://perma.cc/4KWY-B2YW>]. In its most recent decision in the *Columbia* case, the Federal Circuit addressed the question of the scope of the prior art for the purposes of applying the infringement test. *Columbia Sportswear*, 80 F.4th 1363 at 1379 (“[T]o qualify as comparison prior art, the prior-art design must be applied to the article of manufacture identified in the claim.”). But the question of whether the *Glavas* standard remains good law for § 103 prior art in the wake of *Curver* and *Surgisil* remains an open question. See *supra* note 197 and accompanying text.

204. But perhaps if we still think this type of design should be invalid, § 103 does not have to do the work. Perhaps this might be a perfect case for a renewed originality requirement. See *infra* Part IV.C.2.

205. Removable Transparent Protective Anti-Graffiti Road Sign Cover, U.S. Patent No. D509,544, fig.1 (issued Sept. 13, 2005).

Notice that the sign itself is shown in dotted lines and “form[s] no part of the claimed design.”<sup>206</sup> So the claim is directed only at the cover. If this is the first stop sign cover, there may well be nothing that looks “basically the same” and would qualify as a proper primary reference.<sup>207</sup> Could a stop sign itself be the primary reference? The answer would seem to be “no,” no matter how the “analogous arts” standard is interpreted.<sup>208</sup> We might think that if the design problem is “how to shape a road sign cover,” the factfinder should be able to consider the shapes of road signs. But that proposition is far from clear in the case law. And it is not clear conceptually either. The shape of a road sign would seem like it should be relevant to patentability. But is it something we should consider “prior art”? Under the text of § 103, is the factfinder to compare the shape of the sign with the shape of the cover? Or should they look only at other covers or similar types of products?

We could say that factfinders are allowed to look at coordinating items or products, but what if we do not know they exist? In the case of the road sign cover, it is pretty clear what type of sign the cover is supposed to fit to. In other situations, though, that might not be so apparent. Consider this recently granted design patent for a water bottle cover<sup>209</sup>:



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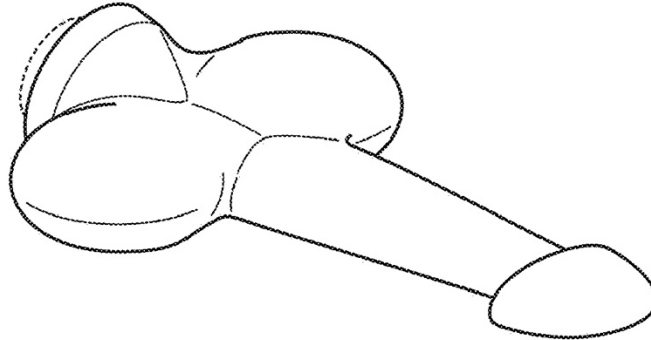
206. *Id.* at Description of Fig. 1.

207. We will assume, for the purposes of this Article, that “basically the same” means “basically the same” and not “the same.” *See supra* note 166 and accompanying text.

208. *See supra* note 197 and accompanying text.

209. Cover for a Water Bottle, U.S. Patent No. D961,384, fig.1 (issued Aug. 23, 2022).

As with the road sign cover, we might suspect that there are no prior water bottle covers that look “basically the same.” And maybe there are no water bottle covers that look similar in any way. Indeed, the cited art includes no water bottle covers at all.<sup>210</sup> Thus, this shape might not seem like an obvious one—in any sense of the word—for a water bottle cover. But what if the bottle is shaped like this?



This drawing is, in fact, from a design patent for a water bottle that was issued to the same inventor as the bottle cover patent.<sup>211</sup> These two patents were prosecuted at the same time, and there is no question that they were meant to be a matched set.<sup>212</sup> In other cases, the fact that something was designed to match something else might not be so clear.<sup>213</sup>

If the bottle had been created by one person at an earlier date and someone else later came up with the bottle cover design, should the

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210. *Id.* at References Cited.

211. Water Bottle, U.S. Patent No. D953,117, fig.1 (issued May 31, 2022).

212. *See Application No. 29/698,756: Cover for a Water Bottle*, U.S. PAT. & TRADEMARK OFF.: PAT. CTR., <https://patentcenter.uspto.gov/applications/29698756> [<https://perma.cc/L3C4-M7CP>].

213. Applicants and counsel may understandably loathe to highlight any such connections. Indeed, “don’t admit that anything is meant to fit anything” seems to be the main lesson many attorneys took away from the ornamentality case of *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563 (Fed. Cir. 1996). *See id.* at 1566 (“Best Lock admitted that no other shaped key blade would fit into the corresponding keyway, and it presented no evidence to the contrary.”).



latter design be considered obvious?<sup>214</sup> In the plain-English sense, maybe. But neither the text of § 103 nor the *Graham* framework give us a clear way to get there. It might depend on how we frame the problem. Is it “what would be a good shape for a water-bottle cover?” or “what would be a good shape for a cover for this particular bottle?” But even in the latter sense, is the bottle really the kind of thing we should consider to be “prior art”? As with the stop sign, it seems like the bottle’s shape should be relevant to patentability, but there is not a clear way to fit it into the framework laid out in § 103. Accordingly, and assuming § 103 itself is not amended, it is difficult to see how any § 103 test can perfectly (or even mostly) subsume *Feist*’s “minimal creativity” requirement. These two doctrines are asking different questions.

So while the *Durling* test may be criticized (and probably should be revised), the existence of sub-*Feist* design patents does not seem to be the result of the Federal Circuit misapplying § 103.

#### IV. IMPLICATIONS

If minimal creativity is not subsumed in the novelty or nonobviousness requirements but is instead—as argued here—a fundamentally different inquiry, that has a number of implications for law and policy, both at practical and theoretical levels. This Part discusses some of those implications.

##### A. *For the Conventional Wisdom*

1. *The relative standards of copyright versus design patentability.* This analysis undermines the conventional wisdom about the relative standards for copyright and design patentability. The design patent requirements of novelty and nonobviousness do not subsume copyright’s creativity requirement.<sup>215</sup> Design patents are available for designs that do not meet that low bar—both in theory and in contemporary law and practice. Therefore, it is simply not correct to

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214. And even if the bottle and cover were created at the same time, is a design patent really needed to incentivize (or reward) the creation of the matching cover? One might reasonably conclude that a patent for the bottle would be enough.

215. *But see* Seymour & Torrance, *supra* note 18, at 187 (“Both the newness and originality requirements of the design patent statute appear to be subsumed within the requirements imposed by §§ 102 and 103(a).”); Karjala, *supra* note 168, at 173 (“In general, creativity does not enter directly into patent protection analysis, because to the extent creativity is a necessary condition, it is already built into a more specific statutory framework, especially the requirement for nonobviousness.”).

assert or assume that the standard of design patent validity is “higher” than the standard for copyrights. The design patent standard is not higher—it’s just different.

2. *The strength-justification link.* Another frequent refrain in the IP literature is that the stronger a right is, the more difficult it should be to acquire.<sup>216</sup> It is widely agreed that it is harder to get a patent than a copyright, and, as Joseph Fishman has explained,

Most intellectual property (IP) commentators today think that this difference in legal protection is sensible, and there’s a large literature devoted to justifying it. One argument is that the two fields are simply trying to maximize different things, with patents trying to funnel activity into a problem’s most efficient solution and copyright trying to generate the widest abundance of information possible. Another is that users of technological goods tend to welcome a high degree of newness, while audiences for expressive works tend to devalue works that they deem too new. Still another is that, even if copyright had a good reason to encourage works of greater creativity, it lacks the sort of objective criterion for assessing value that patent law can deploy for scientific inventions. While these theories differ, they all end up in the same place: a patent should require the demonstration of above-average ingenuity, and a copyright should not. And that’s exactly what the two bodies of law give us.<sup>217</sup>

The literature on this topic does not always clearly distinguish between design patents and utility patents, the patents that protect useful inventions.<sup>218</sup>

Utility patents do, at least generally and in most circumstances, provide stronger exclusionary rights than copyrights. Utility patent rights are defined by verbal claims that set forth the outer limits of the exclusionary rights. Those claims are strategically drafted by the applicant to be as broad as the prior art allows. Utility patent claims

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216. *E.g.*, Miller, *supra* note 82, at 464 (“The stronger the exclusion right, the harder it should be to obtain.”).

217. Fishman, *supra* note 1, at 863 (2021) (footnotes omitted).

218. *See* 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a [utility] patent therefor, subject to the conditions and requirements of this title.”). This language was written when there was only one type of patent, the type we now call “utility patents.” But despite its reference to “patents,” it is clear it only applies to utility patents. *See* Sarah Burstein, *Does § 101 Apply to Design Patents?*, PATENTLY-O (Apr. 24, 2019) [hereinafter Burstein, *Does § 101 Apply*], <https://patentlyo.com/patent/2019/04/%E2%80%A2-design-patents.html> [https://perma.cc/7KBP-48UR].

can be infringed both literally and through the doctrine of equivalents, which gives them scope beyond their plain terms. There is no independent invention defense to or scienter requirement for patent infringement—if someone makes, sells, offers to sell, imports, or even merely *uses* something that reads on a utility patent’s claims without permission, they are an infringer.<sup>219</sup>

Copyright, on the other hand, grants a more limited right. Independent creation is a full defense.<sup>220</sup> Fair use and the doctrines discussed above limit the ability of a copyright owner to control uses of their work—and not all uses are infringements anyway. It is fair to think of this as a less “strong” form of protection.

But when it comes to design patents, the relative strength of the rights is not so clear. Unlike utility patent claims, design patent claims consist mainly of pictures. There is less room for creative wordsmithing in drafting design patent claims and in litigating them. And because of the high level of visual similarity required to support a finding of design patent infringement, design patent claims are generally narrower in scope than utility patent claims.

As a general matter, a design patent has a narrower scope than a copyright. The level of visual similarity required to support a finding of copyright infringement is lower than the level required for design patent infringement. There is no derivative-work right for design patents. And the limits of copyright, such as fair use, do not necessarily create significant limits for certain types of designs, such as product-shape designs.<sup>221</sup>

So even if it is fair to say that a utility patent for a prototypical type of useful invention (like a machine) generally provides stronger protection than copyright does for a prototypical type of work (like a book), it does not follow that design patent rights are “stronger” than copyright rights would be for the same design. This is not to say that it *should* be easier to get a design patent than it is to get a copyright. It is only that the question of the relative strength of these two regimes is

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219. 35 U.S.C. § 271(a).

220. *E.g.*, *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1064 (9th Cir. 2020) (en banc) (“Because independent creation is a complete defense to copyright infringement, a plaintiff must prove that a defendant copied the work.” (citing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46 (1991))).

221. *See generally* Sarah Burstein, *Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright Protection for Designs*, 3 IP THEORY 114 (2013) [hereinafter Burstein, *Narrower*] (questioning the conventional wisdom that copyright protection is narrower than design patent protection).

more complicated than the literature currently suggests. Indeed, the answer to the question “which is stronger” may well vary based on the type of design. In any case, the realities of design patent law and practice complicate the standard narratives regarding the strength-justification link and deserves closer attention.

In addition to theoretical implications, the question of relative strength may also have practical implications. Design originators and their attorneys continue to push the USPTO to expand design patent protection to areas already covered by copyright.<sup>222</sup> Some attorneys have made express strength-justification-based arguments in support of design patent expansion, suggesting that it is appropriate to grant design patents for designs that do not meet copyright’s “high bar” of creativity because design patent protection has a shorter standard term.<sup>223</sup> So these debates are live, and the issues are important.

3. *Backdoor copyrights.* There has been much talk in the literature about the danger of letting people use copyright or trademark law to get “backdoor patents.”<sup>224</sup> But as the discussion above shows, perhaps we should be concerned about applicants using design patents to get backdoor copyrights. If, as the Supreme Court indicated in *Feist*, minimal creativity is required not just by the Copyright Act but by the Progress Clause of the Constitution, then applicants should not be allowed to use the design patent system to evade the low bar set by *Feist*.<sup>225</sup>

Some may argue that “backdoor copyrights” are not a problem because the design patent term (fifteen years) is shorter than the

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222. See *supra* notes 64–67 and accompanying text.

223. Durkin & Gajewski, *supra* note 7 (arguing that copyright’s creativity requirement is a “high bar[]” that is “in place partly due to the long potential terms of copyright”).

224. See, e.g., Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476 (2004) (“[I]n *Traffix Devices, Inc. v. Marketing Displays, Inc.*, the Court rejected a request to use trademark law to [effectively] extend a patent past its expiration . . . . An attempt to gain additional protections for an item that falls within the subject matter of patent law may be termed a ‘backdoor patent.’”); Clark D. Asay, *Intellectual Property Law Hybridization*, 87 U. COLO. L. REV. 65, 97 (2016) (“[I]f owners of copyrighted materials are able to assert copyright law in ways that inhibit higher levels of creativity required for patent-eligible innovation (what some have called ‘backdoor patents’) then copyright law may in some cases significantly impede the utilitarian purposes of patent law.”).

225. And, as discussed in more detail below, there is at least a potential argument that this constitutional requirement also applies to patents. See *infra* Part IV.C.1.b.

copyright term (at least seventy years).<sup>226</sup> But in many fast-moving design fields, including GUI design, fifteen years may as well be a hundred years. And especially for surface designs that have communicative content,<sup>227</sup> allowing applicants to avoid copyright's fair use and other speech-protective doctrines<sup>228</sup> is no small thing.

While design patents' scope is narrower than copyright—in the sense that the degree of visual similarity required to support a finding of infringement is higher—that does not fully alleviate these concerns.<sup>229</sup> It can be expensive to defend against even the weakest design patent infringement claims.<sup>230</sup> And the mere existence of these patents can have other costs.<sup>231</sup>

### B. For Copyright

This analysis also has implications for copyright law and policy. Some commentators have suggested that minimal creativity is, in practice, a pointless requirement for copyright.<sup>232</sup> But the existence of sub-*Feist* design patents shows that, while the hurdle is low, it does exist. And it may be screening out more designs from copyright than some may realize, as evidenced by the existence of sub-*Feist* design patents and the desire of the patent bar to obtain them.<sup>233</sup>

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226. See 35 U.S.C. § 173 (“Patents for designs shall be granted for the term of 15 years from the date of grant.”); 17 U.S.C. § 302 (setting forth the copyright terms).

227. See Burstein et al., Comment Letter, *supra* note 65, at 9–13 (discussing the ways that design patent protection might conflict with the First Amendment).

228. See *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (listing fair use and the idea-expression dichotomy as “built-in First Amendment accommodations” in copyright law).

229. See generally Burstein, *Narrower*, *supra* note 221, at 118–122 (explaining why doctrines generally thought to be limiting in copyright law might not actually be so limiting when applied to designs).

230. See Burstein, *Costly*, *supra* note 133, at 129 (discussing the costs of bad design patents).

231. See *id.* at 129–32.

232. Brian L. Frye, *Against Creativity*, 11 N.Y.U. J.L. & LIBERTY 426, 427 (2017) (“The creativity requirement is . . . irrelevant, because it does not actually affect the scope of copyrightable subject matter . . .”); *id.* at 447 (“If the Court intended the ‘creativity’ requirement to limit the scope of copyrightable subject matter, it failed miserably.”); Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885, 889 (1992) (“Given that copyright’s demands in this regard are indeed minimal, it is difficult to see what social policy is served by continuing to demand intellectual creativity as a basis for copyright protection.” (footnotes omitted)); Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169, 171 (2008) (“[T]his article argues that creativity plays little or no useful role in copyright analysis and carries great potential for harm.”).

233. See *supra* note 67 and accompanying text.

### C. For Design Patents

1. *Originality*. Even though originality is an express statutory requirement for design patents, the Federal Circuit has not said much about what it means for a design to be “original” for the purposes of 35 U.S.C. § 171.<sup>234</sup> One panel addressed the issue, in dicta, in its 2009 decision in *In re Seaway*.<sup>235</sup> In that case, the panel seemed to conclude that the word “original” did not really create—or, at least, suggested that it had not, to date, been seen as creating—an independent requirement for design patentability.<sup>236</sup> But maybe it should.

As the analysis above shows, originality—at least, in the full *Feist* sense—is not currently “subsumed within the requirements imposed by §§ 102 and 103(a).”<sup>237</sup> And even if the requirements for design patentability are not (or do not have to be) more difficult than copyrightability requirements, there are still at least three reasons why courts should take design patent originality seriously. This Section discusses those in turn.

*a. “Original” is in the statutory text.* Section 171(a) states that “[w]hoever invents any new, *original* and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”<sup>238</sup> In *Seaway*, the Federal Circuit speculated that the word “original” was meant to “incorporate the copyright concept of originality,” which the court seemed to

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234. See 35 U.S.C. § 171(a) (“Whoever invents any new, *original* and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)).

235. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009).

236. *Id.* (stating, without citation or support, that “courts have not construed the word ‘original’ as requiring that design patents be treated differently than utility patents”). Similarly, the USPTO has not had much to say on the subject of originality, mainly just one ill-reasoned and ill-supported section of the MPEP. See Burstein et al., Comment Letter, *supra* note 65, at 19–21 (explaining various problems with the USPTO’s “simulation” rule). But, in any case, the USPTO’s interpretations of § 171 are not entitled to deference. See Melissa F. Wasserman, *The Changing Guard of Patent Law: Chevron Deference for the PTO*, 54 WM. & MARY L. REV. 1959, 1968 (2013) (“[U]nlike most agencies, the PTO’s legal interpretations of its enabling act—the Patent Act—are afforded no deference, much less strong judicial deference.”); John M. Golden, *The USPTO’s Soft Power: Who Needs Chevron Deference?*, 66 SMU L. REV. 541, 542 (2013) (“[C]ourts view the USPTO as . . . generally not meriting high-level deference for its interpretations of substantive aspects of the Patent Act.”).

237. See Seymour & Torrance, *supra* note 18, at 187 (“Both the newness and originality requirements of the design patent statute appear to be subsumed within the requirements imposed by §§ 102 and 103(a).”).

238. 35 U.S.C. § 171(a) (emphasis added).

understand as merely “requiring that the work be original with the author.”<sup>239</sup> Understood that way, the term “original” in § 171 would seem to be superfluous, as § 171 already requires that the applicant be (or be authorized to apply by) the design’s creator.<sup>240</sup> This interpretation would, therefore, seem to run afoul of the longstanding canon of statutory construction that requires courts to give meaning and effect to all of the words in a statute.<sup>241</sup>

In *Seaway*, the Federal Circuit also attempted to construe § 171, which sets forth the statutory subject matter for design patents, by comparison to § 101, which sets forth the statutory subject matter for utility patents.<sup>242</sup> This textual analysis is also unpersuasive.

Section 101 provides, “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a [utility] patent therefor, subject to the conditions and requirements of this title.”<sup>243</sup>

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239. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009) (citing 1–2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.01 (2005)). The court made no mention of the second part of the *Feist* test, minimal creativity. *See id.*

240. 35 U.S.C. § 171(a) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” (emphasis added)).

241. *Ysleta Del Sur Pueblo v. Texas*, 142 S. Ct. 1929, 1939 (2022) (referring to the “longstanding canons of statutory construction” that require courts to “normally seek to construe [statutes] ‘so that effect is given to all provisions, so that no part will be inoperative or superfluous, void or insignificant’” (quoting *Corley v. United States*, 556 U.S. 303, 314 (2009))); *City of Chicago v. Fulton*, 141 S. Ct. 585, 591 (2021) (“Reading § 362(a)(3) to cover mere retention of property, as respondents advocate, . . . would render the central command of § 542 largely superfluous. ‘The canon against surplusage is strongest when an interpretation would render superfluous another part of the same statutory scheme.’” (quoting *Yates v. United States*, 574 U.S. 528, 543 (2015))); *see also* John M. Golden, *Redundancy: When Law Repeats Itself*, 94 TEX. L. REV. 629, 655 (2016) (“The Supreme Court has stated that ‘[i]t is a cardinal principle of statutory construction that a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.’” (quoting *TRW Inc. v. Andrews*, 534 U.S. 19, 31 (2001))); Anita S. Krishnakumar, *Statutory Interpretation in the Roberts Court’s First Era: An Empirical and Doctrinal Analysis*, 62 HASTINGS L.J. 221, 243 (2010) (noting that “the rule against superfluities . . . instructs courts to interpret a statute in a manner that gives effect to all of its provisions, such that no one part is rendered superfluous by another” (citing *United States ex rel. Eisenstein v. City of New York*, 129 S. Ct. 2230, 2234 (2009); *Hibbs v. Winn*, 542 U.S. 88, 101 (2004); *Circuit City Stores, Inc. v. Adams*, 532 U.S. 105, 113 (2001); *United States v. Alaska*, 521 U.S. 1, 59 (1997); 2A NORMAN J. SINGER, *STATUTES AND STATUTORY CONSTRUCTION* § 46.06, at 181–86 (rev. 6th ed. 2000))).

242. *Seaway*, 589 F.3d at 1238. Because there seems to be confusion in some corners on this issue, it is worth pointing out that § 101 does not apply to design patents. *In re Finch*, 535 F.2d 70, 71–72 (C.C.P.A. 1976); *see also* Burstein, *Does § 101 Apply*, *supra* note 218 (explaining why § 101 does not apply to design patents).

243. 35 U.S.C. § 101.

According to the Federal Circuit: “There are two differences in wording between the requirements for a design patent under § 171 and for a utility patent under 35 U.S.C. § 101. Section 171 excludes the word ‘useful’ (to distinguish design patents from utility patents) and adds the word ‘original.’”<sup>244</sup> After speculating that the concept of originality may have been imported from copyright, the court asserted, without any citation or support, that “the courts have not construed the word ‘original’ as requiring that design patents be treated differently than utility patents.”<sup>245</sup>

This comparison to § 101 is odd on a number of levels. Most relevant to our purposes, though, it is odd to see the court set forth “useful” and “original” as parallel terms and then conclude that “original” should (or does) have no independent meaning. Courts have read “useful” as creating a substantive requirement for utility patents.<sup>246</sup> By the inherent logic of this parallel construction, if “useful” has substantive meaning, so should “original.” And if swapping “original” for “useful” is—as the *Seaway* court suggests—the salient difference between these two provisions, that difference ought to have some legal effect.<sup>247</sup>

In any case, and regardless of what the Federal Circuit has said, the word “original” is in the design patent subject-matter provision. It deserves to be given some legal effect.<sup>248</sup>

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244. *Seaway*, 589 F.3d at 1238. These are not, in fact, the only two differences in wording between the two sections. For example, § 171 requires that a patentable design also be “ornamental.” Compare 35 U.S.C. § 101, with *id.* § 171(a).

245. *Seaway*, 589 F.3d at 1238. Further research would be necessary to evaluate whether or not this characterization of the prior case law is accurate.

246. The standard may be a low one, but it does exist. See, e.g., Michael Risch, *A Surprisingly Useful Requirement*, 19 GEO. MASON L. REV. 57, 58 (2011) (“The level of ‘utility’ an applicant must currently demonstrate to obtain a patent is extremely low: the invention need only operate as described and potentially provide some de minimis public benefit.”). And stated this way, it sounds a lot like *Feist* minimal creativity.

247. As noted above, this is not actually the only difference between the two subject-matter provisions. See *supra* note 244. But the *Seaway* court seemed to think it was the most salient. *Seaway*, 589 F.3d at 1238.

248. As explained in *Mkt. Co. v. Hoffman*,

It is a cardinal rule of statutory construction that significance and effect shall, if possible, be accorded to every word. As early as Bacon’s Abridgment, sect. 2, it was said that “a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.” This rule has been repeated innumerable times. Another rule equally recognized is that every part of a statute must be construed in connection with the whole, so as to make all the parts harmonize, if possible, and give meaning to each.

*Mkt. Co. v. Hoffman*, 101 U.S. 112, 115–16 (1879).



*b. Originality might be a constitutional requirement.* As discussed above, the Supreme Court has said that minimal creativity is required by Article I, § 8, clause 8 of the U.S. Constitution, the clause that allows Congress to grant copyrights.<sup>249</sup> The same clause allows Congress to grant patents. If, as the Supreme Court indicated in *Feist*, minimal creativity is required by that clause,<sup>250</sup> then it is worth considering whether minimal creativity should also be a threshold requirement for design patents.<sup>251</sup> If novelty and nonobviousness subsumed the *Feist* standard, it would be a moot point. But they do not, so the question remains.

Although the Court's decision in *Feist* focused on copyrights, one of the main cases on which it relied was not so limited.

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to "secure for limited Times to Authors the exclusive Right to their respective Writings." In two decisions from the late 19th century—*The Trade-Mark Cases* and *Burrow-Giles Lithographic Co. v. Sarony*—this Court defined the crucial terms "authors" and "writings." In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.<sup>252</sup>

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249. See *supra* Part IV.A.3.

250. This proposition has been contested by some scholars:

[O]ne can make a strong argument that originality is not a constitutional requirement, at least for copyrights. The primary difficulty with the Court's argument is that the Copyright Clause does *not* contain the word 'original,' nor any synonyms such as novel or new. Nor can an originality requirement be implied from the text.

John T. Cross, *Justifying Property Rights in Native American Traditional Knowledge*, 15 TEX. WESLEYAN L. REV. 257, 293 (2009) (citation omitted). Some do not even accept that minimal creativity is required by the Copyright Act. See, e.g., Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 550 (1995) ("[T]his Article challenges the *Feist* Court's fundamental assertion that a 'spark of creativity' is a condition of copyrightability. In holding that 'creativity' is necessary for copyrightability, the *Feist* Court ignored relevant evidence in the legislative history of the 1976 Copyright Act.").

251. And perhaps for other patents. After all, plant patents and utility patents also are granted under the same clause. *But see* Oskar Liivak, *Maintaining Competition in Copying: Narrowing the Scope of Gene Patents*, 41 U.C. DAVIS L. REV. 177, 183 n.23 (2007) (arguing against the adoption of a minimal creativity standard for utility patents). Perhaps § 101 has been acting as a sort of *de facto* "minimal creativity" requirement in recent years. See generally Joshua D. Sarnoff, *Patent-Eligible Inventions After Bilski: History and Theory*, 63 HASTINGS L.J. 53, 111–12 (2011) (arguing that § 101 "eligibility requires . . . identifying what the inventions consist of and assessing them for minimal creativity of the relevant kind"). A full discussion of these issues, however, is beyond the scope of this Article.

252. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (citations omitted).

The *Feist* Court's discussion of *The Trade-Mark Cases*<sup>253</sup> deserves closer attention:

In *The Trade-Mark Cases*, the Court addressed the constitutional scope of “writings.” For a particular work to be classified “under the head of writings of authors,” the Court determined, “originality is required.” The Court explained that originality requires independent creation plus a modicum of creativity: “[W]hile the word writings may be liberally construed, as it has been, to include original designs for engraving, prints, &c., it is only such as are original, and are founded in the creative powers of the mind. The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like.”<sup>254</sup>

Here, the *Feist* Court understandably focused on what *The Trade-Mark Cases* said about copyright law. But the decision in *The Trade-Mark Cases*—including the points quoted in *Feist*—was not just about copyright. It was about the Progress Clause more generally. And, in *The Trade-Mark Cases*, the Court identified originality as a constitutional requirement of both copyright *and* patent law.<sup>255</sup>

In *The Trade-Mark Cases*, the Court was faced with the question of whether the Progress Clause gave Congress the power to enact federal trademark laws.<sup>256</sup> The Court concluded that the Progress Clause did not give Congress that power because trademark law—which predated and was not established by the federal acts—did not require originality.<sup>257</sup> According to the Court, trademarks were not analogous to either patentable inventions or copyrightable works:

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253. *Trade-Mark Cases*, 100 U.S. 82 (1879).

254. *Feist*, 499 U.S. at 346 (citations and emphasis omitted).

255. See Liivak, *supra* note 251, at 194 (“Although originality, especially after the *Trade-Mark Cases*, has been a central pillar of copyright law, it has been inexplicably unexplored in patent law. Only a few commentators have appreciated that the *Trade-Mark Cases* directly apply to patent law.” (citing R. CARL MOY, *MOY’S WALKER ON PATENTS* § 1:15 (4th ed. 2003); Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 281 (2004))).

256. *Trade-Mark Cases*, 100 U.S. at 93 (noting that, specifically, the question was whether Congress had “the power . . . to legislate on the subject [of trademarks], to establish the conditions on which these rights shall be enjoyed and exercised, the period of their duration, and the legal remedies for their enforcement” via “the eight clause of sect. 8 of the first article”).

257. As explained in the *Trade-Mark Cases*,

[t]he right to adopt and use a symbol or a device to distinguish the goods or property . . . has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. . . . The whole system of trademark property and the civil remedies for its protection existed long anterior to [the federal trademark] act, and have remained in full force since its passage.

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. *In this, as in regard to inventions, originality is required.*<sup>258</sup>

Notably, in this passage, the *Trade-Mark Cases* Court identifies “originality” as the common thread between patent and copyright law.

So while *The Trade-Mark Cases* decision does talk about the meaning of the constitutional term “writings,”<sup>259</sup> it does not do so in a vacuum.<sup>260</sup> Indeed, the very passage from which the *Feist* Court quoted *The Trade-Mark Cases* as saying that, for copyright, “originality is required”<sup>261</sup> actually said that originality was required for copyright “*as in regard to inventions*” — that is, as for patents.<sup>262</sup> If the *Feist* Court was correct in concluding that *The Trade-Mark Cases* means that originality is a constitutional requirement for copyrights, that logic would seem to apply with equal force to patents.<sup>263</sup> At a minimum, it would seem to

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*Id.* at 92; *see also id.* at 94 (ruling that trademarks could not be protected as “writings of authors” because for copyright, “as in regard to inventions, originality is required”). Trademark law still does not require originality.

258. *Id.* at 94 (emphasis added).

259. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (quoting *Trade-Mark Cases*, 100 U.S. at 94).

260. *See Trade-Mark Cases*, 100 U.S. at 94 (discussing “objections” to “classify[ing] [trademarks] under the head of writings of authors”).

261. *Feist*, 499 U.S. at 346 (quoting *Trade-Mark Cases*, 100 U.S. at 94).

262. *Trade-Mark Cases*, 100 U.S. at 94 (emphasis added); *see also id.* at 93 (stating that, by 1870, the terms “*patents* and *copyrights*” had “long since become technical, as referring, the one to inventions and the other to the writings of authors”).

263. *See* Oskar Liivak, *The Forgotten Originality Requirement: A Constitutional Hurdle for Gene Patents*, 87 J. PAT. & TRADEMARK OFF. SOC’Y 261, 274 (2005) (stating that, in *The Trade-Mark Cases*, “[t]he Court held that authority under the Patent and Copyright clause is limited to original acts”); Thomas B. Nachbar, *supra* note 255, at 281 (reading *The Trade-Mark Cases* as deciding that “the words ‘Writings’ and ‘Discoveries’ both imply that the article being protected be original—that it originate with the party claiming the right”); Miller, *supra* note 82, at 473 (“Once again, [in *The Trade-Mark Cases*,] the Court used ‘originality’ to denote creativity, in both copyright and patent. A century later, in *Feist*, the Court expressly relied on this portion of *The Trade-Mark Cases* to explain its conclusion that ‘originality requires independent creation *plus a modicum of creativity*.” (quoting *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991))); Linda J. Demaine & Aaron Xavier Fellmeth, *Reinventing the Double Helix: A Novel and Nonobvious Reconceptualization of the Biotechnology Patent*, 55 STAN. L. REV. 303, 374–75

suggest that applicants should not be able to subvert the requirement of minimal creativity by getting a design patent instead of relying on copyright.<sup>264</sup> This is especially true for designs for GUIs and other types of designs that are clearly within the realm of copyright subject matter but that are not clearly and properly considered to be of design-patentable subject matter.<sup>265</sup>

*c. There is no compelling reason to grant design patents for sub-Feist designs.* A full discussion of what “original” should mean in the context of design patents is a question for another day. However, wherever that hurdle is set, it should be no lower than *Feist*. As discussed above, the *Feist* requirement of “independent creation” is already subsumed in the patent requirement of inventorship. But there is no good reason to grant design patents for designs that fail to meet the low hurdle of *Feist* “minimal creativity.”

Even if *Feist* does not (or should not) directly apply to design patents, that does not mean it is a good idea to grant patents for designs that fall below that low standard. None of the standard normative theories of patent protection justify the issuance of patents for sub-*Feist* designs. On the utilitarian side, there is no reason to think that design patents are necessary to speed up<sup>266</sup> or incentivize the

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(2002) (“The Supreme Court has held [originality] to be a constitutional requirement [in *Feist*]. . . . These principles apply as much to patent law as to these other bodies of intellectual property law.”). Edward C. Walterscheid has argued, based on authorities other than the *Trade-Mark Cases* and *Feist*, that, even if “[a]ll that the Patent Clause literally requires” is newness, originality—in the sense of independent creation—may be required for patents. See Edward C. Walterscheid, “*Within the Limits of the Constitutional Grant*”: *Constitutional Limitations on the Patent Power*, 9 J. INTEL. PROP. L. 291, 318 (2002) (“Nonetheless, it is reasonable to suppose that in light of the rapid information transfer and retrieval now available worldwide that the Supreme Court would interpret novelty under the Clause as requiring originality.”).

264. In other words, *Feist* might be seen as raising the bar for Progress Clause protection as a whole. Even if one does not agree (or thinks the Court raised the bar but was wrong to do so), the question remains whether there is any compelling reason to grant design patents for designs that do not meet the low “minimal creativity standard.” For an argument that there is not, see *infra* Part IV.C.1.c. In other words, the idea of a “minimal creativity” floor for Progress Clause protection might be seen as a compelling insight even if it is not binding precedent.

265. See Burstein et al., Comment Letter, *supra* note 65, at 15–16 (explaining why design patent protection for GUI designs is both logically and legally flawed).

266. Some scholars argue that there is an independent justification for the patent system in encouraging patent races:

Mark Lemley argues that patent races may perform an important function, and that a patent’s role in encouraging these races provides an independent theoretical justification for the patent system. According to this theory, inventors do not necessarily need the incentive of the patent to invent in the first instance. The fact that

production,<sup>267</sup> disclosure,<sup>268</sup> or commercialization<sup>269</sup> of sub-*Feist* designs. There is no reason to believe that granting patents for sub-*Feist* designs will lead to the efficient development of design innovation in a given field.<sup>270</sup>

On the nonutilitarian side, it is hard to see any significant labor deserving of a reward in the creation of a sub-*Feist* design.<sup>271</sup> Nor is there a serious case to be made that protection of these uncreative designs is important to protect the creator's moral claim to their personality.<sup>272</sup> When it comes to distributive justice,<sup>273</sup> granting monopolies (even limited ones) may well do more harm than good. Applicants might want patents for these designs on the principle of "if

a patent is available, however, will tend to speed the pace of innovation as individuals and groups literally race for the patent prize.

Stephanie Plamondon Bair, *The Psychology of Patent Protection*, 48 CONN. L. REV. 297, 308 (2015) (citing Mark A. Lemley, *The Myth of the Sole Inventor*, 110 MICH. L. REV. 709, 750–51, 757 (2012)).

267. *See id.* at 303 ("The chief justification for the patent system is the so-called incentive theory. According to this theory, patents are necessary to efficiently incentivize the production of new ideas." (citing Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 129–30 (2004)).

268. *See id.* at 304 ("In contrast to incentive theory, disclosure theory does not presume that patents are necessary to incentivize invention. Instead, this theory posits that inventors will solve the problems that arise from the non-rivalrous, non-excludable nature of ideas by maintaining secrecy over their inventions." (footnotes omitted)).

269. *See id.* at 307 ("[C]ommercialization theory focuses on the patent as an incentive for inventors to develop their ideas and, ultimately, bring them to market." (citing Michael Abramowicz, *The Dangers of Underdeveloped Patent Prospects*, 92 CORNELL L. REV. 1065, 1073–76 (2007); Ted Sichelman, *Commercializing Patents*, 62 STAN. L. REV. 341, 347–53 (2010))).

270. For example, prospect theory:

concerns itself with behavior that takes place after the initial inventive steps have been taken. Edmund Kitch, the first proponent of the theory, compared a field of invention to a mining prospect. He argued that just as a mining claim is given to a single firm for reasons of efficiency, so too should a broad patent be granted to an inventor to manage his invention and control further innovation within the field.

*See id.* at 305–306 (citing Edmund W. Kitch, *The Nature and Function of the Patent System*, 20 J.L. & ECON. 265, 269 (1977)).

271. Courts and scholars have articulated several justifications for intellectual property law, including:

(1) labor-desert theory, which originates loosely from John Locke's Two Treatises and posits that creators deserve to own the fruits of their intellectual labor; (2) personality theory, which extends from Hegel by way of Margaret Jane Radin and suggests that creators have a moral claim on their creations as an expression of their personalities; and (3) distributive justice, the idea that formal intellectual property rules should advance a "just and attractive culture."

Zahr K. Said, *Coming of Age in IP: What Goods, Infrastructures, and Property Theory Suggest About the Flourishing of Intellectual Property Scholarship*, 49 TULSA L. REV. 515, 519 n.22 (2013).

272. *See id.*

273. *See id.*

value, then right.”<sup>274</sup> But that does not mean that we should let them have it.

2. *Nonobviousness.* Revitalizing the statutory requirement of originality might also affect how we think about other statutory requirements, such as nonobviousness. For example, in my first design patent article, I suggested that there may be situations where a design should be deemed obvious even if there is no primary reference.<sup>275</sup> But those types of situations might better be analyzed under the rubric of originality. For example, if someone makes a souvenir for a Centennial Exhibition in the shape of that exhibition’s Memorial Hall, is that minimally creative?<sup>276</sup> That might be the better way to analyze the patentability of the design. Similarly, if there is an industry custom of mixing and matching existing visual elements<sup>277</sup> in ways that create visually predictable results, perhaps we should consider that to raise a question of originality, not obviousness.<sup>278</sup>

## CONCLUSION

This analysis shows, both theoretically and in practice, that design patent novelty and nonobviousness are not heightened versions of copyright’s originality test—they are just different. Originality,

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274. See Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990) (identifying and critiquing the “if value, then right” approach to intellectual property).

275. Burstein, *Visual Invention*, *supra* note 165, at 680 (first discussing *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680 and then discussing *Bennage v. Phillippi*, 9 O.G. 1159 (1876), reprinted in HECTOR T. FENTON, *THE LAW OF PATENTS FOR DESIGNS* 287 (1889)). This discussion assumes that the primary reference requirement survives *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383 (Fed. Cir. 2023). See *supra* note 161.

276. See Burstein, *Visual Invention*, *supra* note 165, at 201 (discussing the facts of *Bennage v. Phillippi*, 9 O.G. 1159 (1876), reprinted in HECTOR T. FENTON, *THE LAW OF PATENTS FOR DESIGNS* 287 (1889)). Indeed, the USPTO itself cites *Bennage* as a case where the design failed for insufficient originality. See MPEP, *supra* note 47, § 1504.01(d). The USPTO’s reasoning in that section leaves much to be desired. See Burstein et al., Comment Letter, *supra* note 65 (critiquing the USPTO’s “simulation” rule). But perhaps the USPTO’s conclusion—that *Bennage* should be considered an originality case—might still be correct.

277. Here, I use the word “elements” to refer to “visual sub-parts of a claimed design.” See Burstein, Goddess, *supra* note 96, at 109 (distinguishing between “elements,” “features,” and “aspects” of a design).

278. See Burstein, *Visual Invention*, *supra* note 165, at 201–202 (discussing the facts of *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680 (1893)). As with all issues of design patent law, any such inquiry should focus on the *visual* creativity, not the *technical* creativity. The fact that an ordinary designer would have known how to mix and match preexisting visual elements does not mean it could never be *visually* creative to do so.

novelty, and nonobviousness do not form a single validity ladder on which the latter two requirements are higher “rungs.” Instead, they are—in both theory and in practice—more like separate hurdles that a creator must jump before obtaining a particular IP right.

Accordingly, and contrary to the conventional wisdom, the copyright requirement of originality is not “lower” than the substantive requirements for design patentability. It’s just different. This explains why so many design patents issue for designs that fail to meet the low standard of “minimal creativity” set forth by the Supreme Court in *Feist*.

This analysis shows that we should take the statutory requirement that a patentable design be “original” seriously. We should not just assume that it is subsumed within the other requirements of patentability. Design patent applicants should have to jump the hurdle of originality. This Article leaves for another day the question of how, precisely, that hurdle should be placed and shaped. However, that hurdle should be set no lower than the standard set by the Supreme Court in *Feist*. There is simply no good reason to patent sub-*Feist* designs.