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BORDERLAND—WHERE COPYRIGHT AND DESIGN PATENT MEET*

Richard W. Pogue†

COPYRIGHT law and design patent law contemplate basically different objects of protection. Yet at the outer fringes of these types of protection certain concepts overlap to form a rather undefined borderland in which it is difficult to say what law is applicable—copyright law, patent law, neither, or both. It is the purpose of this paper to explore this borderland area in the light of traditional copyright and patent law principles, with attention given to policy considerations involved, and to offer suggestions toward drawing a sharper boundary between the two.¹

The Problem

At the heart of the difficulty lies the fact that certain works of art apparently copyrightable may have application as manufactured articles so as to bring them within the language of the design patent sections of the Patent Code. Such articles seem to be "Works of art; models or designs for works of art" within the meaning of the Copyright Code,² and yet they may also seem to be a "new, original and ornamental design for an article of manufacture" as referred to in the Patent Code.³ The best litigated example of the kind of article which seems to fall into

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¹ The same problem has been impossible to resolve on an international level. The Berne Copyright Convention leaves the problem to national action; the last paragraph of article 2 provides that works of art applied to industry "are protected so far as the domestic legislation of each country allows." LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY* 247 (1938).

² 17 U.S.C. (Supp. V, 1952) §5(g). Section 5 provides in major part as follows: "§5. Classification of Works for Registration.—The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs: (a) Books, including composite and cyclopedic works, directories, gazetteers, and other compilations. (b) Periodicals, including newspapers. (c) Lectures, sermons, addresses (prepared for oral delivery). (d) Dramatic or dramatico-musical compositions. (e) Musical compositions. (f) Maps. (g) Works of art; models or designs for works of art. (h) Reproductions of a work of art. (i) Drawings or plastic works of a scientific or technical character. (j) Photographs. (k) Prints and pictorial illustrations including prints or labels used for articles of merchandise. (l) Motion-picture photoplays. (m) Motion pictures other than photoplays."

³ The pertinent section of the Patent Code [66 Stat. L. 805 (1952), 35 U.S.C.A. (1952 Supp.) §171] reads as follows: "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.

"The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

this twilight zone is the type of artistic statuette, sold as a table-lamp base, involved in the series of *Stein* cases (petition for writ of certiorari pending in the Supreme Court at the time of this writing).^{*} Discussion of these cases will be presented below; for present purposes suffice it to say that the product in suit in the first of the *Stein* copyright infringement cases, decided in 1951, was a modern statuette of a Balinese dancer for which copyright registration had been obtained. Defendant's statuettes were identical with those made by plaintiff. Both parties sold them as bases for table lamps. Defendant's contention that the statuettes as lamp bases did not constitute copyrightable subject matter, since they were intended to be used for a utilitarian purpose, was upheld, and the copyright count of the plaintiff's suit was dismissed.⁴

Although most of the controversy has arisen under section 5(g) of the Copyright Code ("Works of art; models or designs for works of art"), the problem also lurks as a latent possibility in connection with section 5(h) which protects "Reproductions of a work of art," and section 5(i) which covers "Drawings or plastic works of a scientific or technical character."⁵ As a matter of pure theory, the borderland problem could occur with respect to an article not falling within any one of these specific categories, since the thirteen classifications listed in section 5 do not limit the subject matter of copyright⁶ but are simply guides for the benefit of the Copyright Office.⁷ In practice, however, these classifications are fairly well determinative of what is copyrightable and what is not. As a result, although other possibilities of overlap of copyright and design patent coverage exist, the focal point of the problem has been the "works of art" classification in section 5.

The need for decision of whether a particular article which is a useful work of art is properly the subject matter of copyright or design patent protection may occur in any proceeding in which the validity of a copyright or design patent is challenged on the ground of improper subject matter. Sometimes the issue is stated to be whether a defendant's copying of the article into a useful form *infringes* the copyright of the work of art. As might be expected, the problem arises generally

⁴ *Stein v. Expert Lamp Co.*, (D.C. Ill. 1951) 96 F. Supp. 97.

⁵ This category was involved in *Taylor Instrument Companies v. Fawley-Brost*, (7th Cir. 1943) 139 F. (2d) 98.

⁶ "The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secured under this title." 17 U.S.C. (Supp. V, 1952) §5.

⁷ "Section 5 refers solely to a classification made for the convenience of the copyright office and those applying for copyrights." H.Rep. 2222, 60th Cong., 2d sess., 10 (1909), reporting out H.R. 28192, which ultimately became the Copyright Act of 1909. See also *Seltzer v. Sunbrock*, (D.C. Cal. 1938) 22 F. Supp. 621.

^{*} See note 107 *infra*.—Ed.

in suits based on infringement of copyright or design patent,⁸ or in disputes over rulings of the Patent Commissioner.⁹ Occasionally a court, in deciding a case on common law grounds, makes collateral reference to the possibility of copyright and/or design patent protection of a certain article.¹⁰ Aside from these procedural channels through which the problem may arise, certain conceptual matters may force the issue—e.g., the fear of double protection and the theory allowing an election between the benefits available under the respective statutes.¹¹

The importance of the problem to manufacturers of artistic creations which ornament objects of manufacture is great. They must gamble on which type of protection to seek, since their own determination may later prove incorrect, on judicial review, and they may prejudice their standing if they attempt to follow both paths of protection. Differences in design patent and copyright procedure, as well as ultimate scope of protection, which will be alluded to below, may cause one or the other to dovetail to their industrial needs. In the present hazy state of the law applicable to these hybrid articles, designers or their assignees have few satisfactory guides in their attempts to anticipate what conduct will assure what protection.

Comparison of Copyright and Design Patent

Dissimilarities in philosophy, procedure, and protection characteristic of copyright and design patent make important the problem of overlapping legislative grace. While an average businessman perhaps considers the two as substantially identical, and while analogies in the two fields of law are often interchanged,¹² important differences appear as a result of Congress' traditional approach in developing two separate bodies of law under the one clause in the Constitution.¹³ A short

⁸ E.g., the Stein cases, *infra* p. 52; *De Jonge & Co. v. Breuker & Kessler Co.*, (C.C. Pa. 1910) 182 F. 150; *Korzybski v. Underwood*, (2d Cir. 1929) 36 F. (2d) 727; *Jones Bros. v. Underkoffler*, (D.C. Pa. 1936) 16 F. Supp. 729. And see *Columbus Plastic Products, Inc. v. Rona Plastic Corp.*, (D.C. N.Y. 1953) 111 F. Supp. 623.

⁹ *In re Blood*, (D.C. Cir. 1927) 23 F. (2d) 772; *Ex parte Cady*, 1916 C.D. 57, 62; *Ex parte Appeal*, 34 J. PAT. OFF. SOC. 463 (1952). This issue might be raised in any other form of litigation, however, in which validity of a particular patent or copyright is attacked—e.g., charges of price fixing.

¹⁰ E.g., some aspect of unfair competition. *Wm. A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, (D.C. Pa. 1951) 95 F. Supp. 264.

¹¹ Although technically inaccurate, the term "election of remedies" is sometimes used to refer to this choice of protection.

¹² See exhaustive list of situations where patent law was referred to in copyright cases, or vice versa, in Wolff, "Copyright Law and Patent Law: A Comparison," 27 *IOWA L. REV.* 250 (1942).

¹³ It has been suggested that one phase of the distinction is implied in the very terms "author" and "inventor" as found in the Constitution. "The latter carries an implication

examination of the meaningful variances is essential before any solution can be attempted.

A. *Theoretical Differences.* Although with respect to works of art both copyright and design patent protect embodiments of artistic appearance, the exact objects of the protection differ. Copyright seeks to secure to the author the exclusive right to reproduce, or copy, the fruit of his particular intellectual labors;¹⁴ this exclusive mantle is draped not about his ideas themselves but the literary expression of these ideas.¹⁵ Patent law, from which the design patent flows, aims more directly at *development* in the particular field of science, and consequently confers a monopoly on the first man concocting a new idea and reducing it to physical form. The distinction is plain: two men independently making maps of a certain territory, if perfectionists, will produce exactly identical maps;¹⁶ both may obtain the exclusive right to make copies from their own particular map, and yet neither will have infringed the other's copyright.¹⁷ Patent law, on the other hand, rewards the first man to produce the new invention; the second man to the Patent Office loses all rights even though he was entirely ignorant of the other's efforts. While the copyright claimant is held to know only what his actual knowledge tells him,¹⁸ the prospective patentee is charged with notice of everything which has preceded his invention. In return the patentee is granted a complete monopoly as to the appearance of the particular design, while the copyright proprietor can only prevent copying.¹⁹ Various offspring of this basic difference are manifested in respective procedures, protections, and tests for subject matter and infringement.

B. *Procedural Requirements.* In some ways the most illuminating focal point of the differences between the two fields is the procedure

which excludes the results of ordinary skill, while nothing of this is necessarily involved in the former." *Henderson v. Tompkins*, (C.C. Mass. 1894) 60 F. 758 at 764.

¹⁴ For discussion of the origin of the term "copyright," as arising out of English printers' attempts to justify protection on a property theory after monopolies became unpopular, see LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY* 15 (1938).

¹⁵ *Baker v. Selden*, 101 U.S. 99 (1880).

¹⁶ This illustration was relied upon by L. Hand, J., in *Fred Fisher, Inc. v. Dillingham*, (D.C. N.Y. 1924) 298 F. 145 at 151, quoting BOWKER, *COPYRIGHT, ITS HISTORY AND ITS LAW* 255 (1912).

¹⁷ A compiler of a directory cannot preclude another person compiling a similar directory if it is the product of independent work. *Sampson & Murdock Co. v. Seaver-Radford Co.*, (1st Cir. 1905) 140 F. 539. And see annotation, 26 A.L.R. 585 (1923).

¹⁸ "Anything a perfect ignoramus produces must of necessity be original with him, that is, original in the copyright sense." Umbreit, "A Consideration of Copyright," 87 UNIV. PA. L. REV. 932 at 948 (1939).

¹⁹ This distinction becomes important where there is a likelihood of concurrent independent creation of a work.

involved in obtaining the particular exclusive right. The copyright aspirant's task is by far the easier.

Copyright administration is handled by the Copyright Office, which registers over 200,000 claims each year.²⁰ The method of obtaining copyright registration is simple and quick: the author publishes the work with a notice of copyright affixed to each copy published, and then promptly deposits two copies with the Copyright Office. The filing fee is four dollars. The Copyright Office conducts a cursory examination directed to the presence or absence of copyrightable subject matter, after which the Register of Copyrights issues a certificate of registration. No examination as to originality of authorship is undertaken.

Patent Office procedure is more difficult, expensive, and prolonged.²¹ The inventor must first make application in writing to the Commissioner of Patents, and file in the Patent Office a description of his invention. He must state under oath that he truly believes himself to be the first inventor of the art. The claim then undergoes a thorough examination by the Commissioner of Patents,²² and if it meets all the requirements established by law, the Commissioner issues the patent. Filing fees in the case of design patents are ten, fifteen, and thirty dollars, depending on the period for which protection is sought.

Thus patent procedure is much more complicated and time-consuming than comparable copyright practice. The preparation of a patent application often requires extensive work by patent attorneys and skilled draftsmen, and frequently the application is preceded by a patient search of "prior art" which may require additional employees. The legal fees and other expenses involved in prosecuting the patent application, which may take the better part of a year,²³ are generally high. When

²⁰ This has been true at least during the past five years. *ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS* 8 (1952). In the fiscal year 1952, 4,820 "works of art," 1,040 "reproductions of works of art," and 1,554 "drawings of plastic works of a scientific or technical character" were registered.

²¹ In general the same procedures followed in applications for mechanical patents apply to design patent applications. For some aspects of procedure having particular relation to design patents, see *SHOEMAKER, PATENTS FOR DESIGNS* 270-301 (1929).

²² "... the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the invention sought to be patented. The examination shall be complete with respect both to compliance of the application with the statutes and rules and to the patentability of the invention as claimed. . . ." Rules of Practice, United States Patent Office §1.104(a) (1951).

²³ A period of five months was said to be the usual length of time necessary to obtain a design patent in Hearings before Senate Committee on Patents, 71st Cong., 3d sess., 112 (1930). Cf. 31 *COL. L. REV.* 477 at 484 (1931). The period is occasionally shorter. "The oldest application at the end of the year had been awaiting examiner action for less than five months, a decrease during the year of almost twelve months." *ANNUAL REPORT OF SECRETARY OF COMMERCE* 80 (1951). Cf. 1952 Report (four months).

these obstacles²⁴ are contrasted with the four dollar filing fee and two deposits required of copyright registrants, one reason becomes obvious as to why producers of ambiguous articles may desire copyright, in preference to design patent, protection.

C. *Protection Available.* The fundamental difference in protection has been referred to above—the patentee enjoys the exclusive right to prevent others from “making, using, or selling the invention”²⁵ (i.e., a complete monopoly), while the copyright registrant enjoys only certain exclusive rights spelled out in the statute,²⁶ the essence of which is the right to make copies of the work.²⁷ Both statutes permit either the inventor, his executors, or administrators to apply for the protection sought; both permit an assignee to obtain protection.²⁸ The duration of the exclusive rights differs, the copyright owner enjoying a possible fifty-six years of protection and the design patentee being limited at his option to three and a half, seven, or fourteen years.

Criteria established by case law for determining whether there has been infringement represent another difference in the effectiveness of protection. In *Gorham v. White*, a Supreme Court case in which defendant's silverware resembled closely the design used by plaintiff, the proposition was established that in design patent cases “. . . if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other . . .”²⁹ relief will be awarded. That is, “Experts, therefore, are not the persons to be deceived.”³⁰ Although at first blush the language in copyright opinions to the same effect would seem to indicate congruity on this point, it must be remembered that the plaintiff in an action for copyright infringement must prove not mere similarity, as in the case of patent infringement suits, but plagiarism. Consequently, lack of access to the infringed copyrighted work is a

²⁴ These practical details are discussed in Buckles, “Property Rights in Creative Works—A Comparison of Copyright and Patent Laws,” 32 J. PAT. OFF. SOC. 414 at 424 (1950).

²⁵ 66 Stat. L. 811 (1952), 35 U.S.C.A. (1952 Supp.) §§271, 154.

²⁶ 17 U.S.C. (Supp. V, 1952) §1.

²⁷ In *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 at 350-351, 28 S.Ct. 722 (1907), the Supreme Court, in refusing to restrain sales by a retailer of a copyrighted book at a certain price, reached its conclusion “. . . in view of the language of the statute, read in the light of its main purpose to secure the right of multiplying copies of the work. . . .”

²⁸ 17 U.S.C. (Supp. V, 1952) §9; Rules of Practice, United States Patent Office §§1.41 to 1.47 (1951). The Patent Office Rules require the inventor to make the application but permit issuance of the patent to the assignee.

²⁹ 14 Wall. (81 U.S.) 511 at 528 (1871).

³⁰ *Ibid.*

defense. Where denied, access may be proved indirectly by showing a striking similarity between the two works or by other evidentiary facts.³¹ Where access is admitted, the presumption of copying raised by slavish identity will be difficult to overcome.³² As in the case of design patents, however, the language of the courts vests the standard in the average person³³ rather than the experts.³⁴

D. *Subject Matter*. Another distinction arises out of the difference in criteria for protectability: design patents must meet the four requirements of novelty, originality, ornamentality, and invention—and the most difficult of these is “invention.”³⁵ While language in some opinions indicates that the courts will insist on the presence of the inventive faculty³⁶ to the same extent as in the case of mechanical patents,³⁷ the suggestion that “. . . there may be often more inventive genius displayed by the court in finding invention in design patents than the inventor disclosed in placing it there”³⁸ probably holds more

³¹ HOWELL, *THE COPYRIGHT LAW* 122 (1952). See statement in *Arnstein v. Porter*, (2d Cir. 1946) 154 F. (2d) 464 at 468: “If evidence of access is absent, the similarities must be so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result.”

³² *Pellegrini v. Allegrini*, (D.C. Pa. 1924) 2 F. (2d) 610 at 612. On the other hand, in plaintiff's attempt to prove infringement, “It certainly is not necessary that it be what is commonly called a Chinese copy.” As there pointed out, similarity of two works may simply be the result of the same subject matter.

³³ E.g., *Roe-Lawton v. Hal E. Roach Studios*, (D.C. Cal. 1927) 18 F. (2d) 126 (“The standard of the ordinary observer”); *Contemporary Arts v. F. W. Woolworth Co.*, (D.C. Mass. 1950) 93 F. Supp. 739 at 744, quoting with approval *Allegrini v. De Angelis*, (D.C. Pa. 1944) 59 F. Supp. 248 (“whether the ordinary reasonable person would fail to differentiate . . . or would consider them dissimilar by reasonable observation”); *Schwartz v. Universal Pictures Co.*, (D.C. Cal. 1945) 85 F. Supp. 270 at 274 (“ . . . impression to me, not as a judge, not as a person who may be more or less familiar with literature, but as an average person”); *McConnor v. Kaufman*, (D.C. N.Y. 1943) 49 F. Supp. 738 at 744 (“and the ordinary observer rule is an accepted test”). Cf. majority and dissenting opinions in *Arnstein v. Porter*, (2d Cir. 1946) 154 F. (2d) 464.

³⁴ *Hirsch v. Paramount Pictures*, (D.C. Cal. 1937) 17 F. Supp. 816 at 818; *Cain v. Universal Pictures Co.*, (D.C. Cal. 1942) 47 F. Supp. 1013 at 1015-1016 (“ . . . not upon the minute, scalpel-like dissection of an expert who transmutes each incident into an abstraction or sublimation in order to find identity, but upon the impression of sameness which the two works carry to the ordinary reader and observer.”)

³⁵ The requirement that the invention be “useful” was eliminated in 1902. See discussion *infra*.

³⁶ Cases collected in *SHOEMAKER, PATENTS FOR DESIGNS* 42-43 (1929).

³⁷ “. . . the test for invention is to be considered the same for designs as for mechanical patents; i.e., was the new combination within the range of the ordinary routine designer?” L. Hand, J., in *Strause Gas Iron Co. v. William M. Crane Co.*, (2d Cir. 1916) 235 F. 126 at 131. Statements to like effect may be found elsewhere, but this proposition may be open to question in view of the recent controversy over applicable standards of invention for mechanical patents. A different approach is indicated in some of the opinions: “A design patent necessarily must relate to subject matter comparatively trivial and the courts have looked with greater leniency upon design patents than patents for other inventions.” *Dominick & Haff v. R. Wallace & Sons Mfg. Co.*, (2d Cir. 1913) 209 F. 223 at 224.

³⁸ *Charles Boldt Co. v. Turner Bros. Co.*, (7th Cir. 1912) 199 F. 139 at 142.

than a kernel of truth.³⁹ Nonetheless, as long as the statutory requirement exists, the standard will necessarily be different from that applicable in copyright law, where the only requirement is originality.⁴⁰

Statutory History

Although developments in the patent and copyright laws since the Constitutional Convention in 1789 have been documented in other literature,⁴¹ a brief review of the history of currents in design patent and copyright legislation aids in understanding policies underlying the two forms of statutory protection. Legislative history is relevant since solutions to the borderland problem are generally phrased in terms of the "intention of Congress."⁴²

The source of both types of protection is of course the Constitution. In the well-known Article I, Section 8, Clause 1, Congress is delegated authority "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The colonies, by general copyright laws and special patent legislation,⁴³ had recognized the benefit accruing to the public when this type of protection was granted to authors and inventors, and consequently the matter did not arouse controversy in the proceedings of the Constitutional Convention.⁴⁴ Precedent afforded by English practice made it seem natural and desirable to enable Congress to encourage progress in these related fields by doling out exclusive rights in standardized instances. The essential fact, however, a fact often reiterated in the opinions, is that the benefit to the *public*, in the case of copyright and of patent, was the controlling

³⁹ The standards used to measure an "invention" in "appearance" would seem necessarily less objective than in the case of mechanical patents. Whether this is the reason, or because it is inherently easier to make advance over prior art in the design area, case-by-case development of the applicable standards seems less rigorous for design patents, as indicated by the quotation in the text. For the view that this analysis may represent divergence of value judgments, see 66 HARV. L. REV. 877 at 883 (1953).

⁴⁰ A few scattered statements to the contrary may be found: "... the same test is to be applied as in the case of patents; that is, it must indicate an exercise of the inventive genius as distinguished from mere mechanical skill or change." *Arnstein v. Edward B. Marks Corp.*, (D.C. N.Y. 1935) 11 F. Supp. 535 at 536. But see 40 GEO. L.J. 327 (1952).

⁴¹ E.g., 2 CURTIS, CONSTITUTIONAL HISTORY 339-340 (1854); Fenning, "The Origin of the Patent and Copyright Clause of the Constitution," 17 GEO. L.J. 109 (1929); 27 IND. L.J. 130 (1951); 21 GEO. WASH. L. REV. 353 (1953); BOWKER, COPYRIGHT, ITS HISTORY AND ITS LAW (1912); Hudson, "A Brief History of the Development of Design Patent Protection in the United States," 30 J. PAT. OFF. SOC. 380 (1948).

⁴² WEIL, COPYRIGHT LAW 227 (1917).

⁴³ 17 GEO. L.J. 109 at 115 (1929). See also Fenning, "Copyright Before the Constitution," 17 J. PAT. OFF. SOC. 379 (1935).

⁴⁴ 17 GEO. L.J. 109 at 114. No controversy occurred in the states when adoption of the Constitution was in progress, and the *Federalist* referred to copyright and patent law in a few short lines.

motivation prompting the constitutional grant of power. "Not that any particular class of citizens, however worthy, may benefit, but because the policy is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention, to give some bonus to authors and inventors."⁴⁵

Developments in Copyright Legislation

The history of copyright legislation represents a gradual extension of the areas of protection and an inclusion of more and more new types of subject matter. Among the many statutes passed by Congress since 1789, five stand out as significant to discussion of the present problem.

The first piece of public legislation on copyright was proposed in January, 1790;⁴⁶ a few months later the Act of May 31, 1790, was passed.⁴⁷ This statute conferred on "authors of any map, chart, book or books already printed" who obtained copyright the "sole right and liberty of printing, reprinting, publishing and vending"⁴⁸ the protected articles for a fourteen year period, with a right of renewal for an additional fourteen years. The act established procedures in infringement proceedings, and required that before copyright could be valid copies of the work should be deposited with the clerk of the proprietor's local district court and the Secretary of State.

By virtue of the Act of April 29, 1802,⁴⁹ the second major copyright law, the list of persons enjoying benefits under the Copyright Act was expanded. The new coverage was granted to persons "who shall invent and design, engrave, etc, or work . . . any historical or other print or prints. . . ." The act also included notice and forfeiture provisions.

Several substantial changes were introduced along with the first general revision of the copyright laws in 1831, when legislation was enacted⁵⁰ extending protection to authors of musical compositions, and lengthening the copyright period from fourteen to twenty-eight years with a fourteen year renewal period. Subsequent minor laws dealt with a variety of subjects.⁵¹ Then in 1870 the second general revision of the

⁴⁵ H. Rep. 2222, 60th Cong., 2d sess., 7 (1909).

⁴⁶ The first actual reference to copyright was made in Congress April 15, 1789, when a publisher petitioned the House for protection. COPYRIGHT IN CONGRESS, 1789-1904, prepared by Thorvald Solberg, 112 (1905).

⁴⁷ 1 Stat. L. 124 (1790).

⁴⁸ It is interesting that while the essence of a copyright proprietor's protection is often said to be the right to prevent others from "copying" the word "copy" did not appear in the 1790 description of the author's rights.

⁴⁹ 2 Stat. L. 171 (1802).

⁵⁰ Act of February 3, 1831, 4 Stat. L. 436.

⁵¹ Twenty-five public laws were passed in the period 1789-1904. Solberg, *supra* note 46 at 84-93.

copyright laws was effected as part of the consolidated Patent, Trade-mark and Copyright Act.⁵² This act repealed former laws and added considerable material to existing copyright concepts. Protection was granted for a "painting, drawing, chromo, statue, statuary, and . . . models or designs intended to be perfected as works of the fine arts."⁵³ Passage of this act, with its expanded definitions of copyrightable subject matter, prepared the path to overlapping protection, since the same act, in the sections dealing with patents, retained the description of design patentability which had existed (in substance) since 1842:

"any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; . . . any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture. . . ." ⁵⁴

There were some works of art which would have been covered by both sections but for the requirement in the copyright section that the products be "*intended* to be perfected as works of the *fine arts*."⁵⁵ Even with this provision, however, potential double coverage existed; the most striking example was the case of statuary—each of the sections specifically mentioned statues.

One final copyright statute, the Act of 1909,⁵⁶ is important to the present problem. This act, which forms the basis of our copyright law today, constituted a complete revision and amendment of previous copyright laws, and contained substantive changes material to this discussion.⁵⁷ Copyright protection was extended to "all the writings of an

⁵² Act of July 8, 1870, 16 Stat. L. 198.

⁵³ *Id.*, §86.

⁵⁴ *Id.*, §71.

⁵⁵ Emphasis supplied. Importance of the distinction between the "fine arts" and other arts seems to have been recognized by Congress, for in 1874 an act was adopted providing in part that ". . . the words 'Engraving,' 'cut' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. . . ." Act of June 18, 1874, 18 Stat. L. 78. This distinction was observed in the lower courts; e.g., *J. L. Mott Iron Works v. Clow*, (C.C. Ill. 1896) 72 F. 168, in which copyright enforcement was refused since the purpose with which plaintiff's pictures of bathtubs were registered was not to show them as works of the fine arts but rather for advertising. Importance of the distinction was cut down in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S.Ct. 298 (1903), when Justice Holmes concluded that even if the "fine arts" limitation applied to "pictorial illustrations," circus advertisements could properly be copyrighted because of the illustrations.

⁵⁶ Act of March 4, 1909, 35 Stat. L. 1075.

⁵⁷ In addition to the changes mentioned in the text, this act lengthened the renewal period to 28 years.

author."⁵⁸ When this clause was read in conjunction with the famous *Sarony* case,⁵⁹ which had held photographs copyrightable despite the constitutional argument that such were not "writings" of an "author," the sweep of protection was broadened considerably. More significant, however, for purposes of this discussion, was the deletion of the qualifying clause "intended to be perfected as works of the fine arts." The new standard, one of eleven⁶⁰ classifications introduced by this act, was simply "Works of art; models or designs for works of art." Although this change was a salutary one, it contributed to the danger of overlapping in two ways: (1) the removal of the "fine arts" qualification muddled the line of demarcation between purely aesthetic articles and useful works of art;⁶¹ and (2) the omission of any reference to the "intention" of the proprietor seemed to represent congressional dissatisfaction with intention as an ingredient in determining what is copyrightable.⁶²

These were the last major changes in copyright law; the purpose of the Act of 1947, in addition to enacting Title 17 of the United States Code into positive law, was to rearrange and repeal various prior laws.⁶³ The fundamental statutory material of the Act of 1909 was retained.

The current visible throughout this stream of legislation has been extension of copyright protection to more and more products of artistic endeavor. Consequently, it is not too surprising that eventually this gradual expansion began to eat into areas formerly covered by design patent law.

Along with statutory developments, practices followed in the Copy-

⁵⁸ The text writers interpret this addition as making everything copyrightable which could constitutionally be made copyrightable. *WHEEL, COPYRIGHT LAW* 214 (1917); *HOWELL, THE COPYRIGHT LAW* 8 (1952). But see language of the Committee Report, *supra* note 45 at p. 10: "Section 4 is declaratory of existing law. It was suggested that the word 'works' should be substituted for the word 'writings,' in view of the broad construction given by the courts to the word 'writings,' but it was thought better to use the word 'writings,' which is the word found in the Constitution. It is not intended by the use of this word to change in any way the construction which the courts have given to it."

⁵⁹ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S.Ct. 279 (1884).

⁶⁰ Classes (l) and (m) were added by Act of August 24, 1912, 37 Stat. L. 488.

⁶¹ Testimony by the Librarian of Congress during the hearings which led to the Act of 1909 supports the position that Congress intended an expansion of coverage by the elimination of the "fine arts" qualification: "The term 'works of art' is deliberately intended as a broader specification than 'works of the fine arts' in the present statute with the idea that there is subject-matter (for instance, of applied design, not yet within the province of design patents), which may properly be entitled to protection under the copyright law." Hearings, before Committees on Patents, on S. 6330 and H.R. 19853, 59th Cong., 1st sess., 11 (1906).

⁶² See discussion of argument in the Stein cases over "intention" as a factor in copyrightability, *infra* p. 52 et seq.

⁶³ Act of July 30, 1947, 61 Stat. L. 652. For discussion as to whether by this legislation Congress intended to adopt previous interpretations given by Copyright Office Regulations, see 27 *IND. L.J.* 130 at 135, note 30 (1951).

right Office demand attention. The early Rules and Regulations,⁶⁴ issued soon after enactment of the Act of 1909, continued by administrative rule-making the distinction between "fine" arts and works of art having a useful purpose, a distinction which apparently had been abandoned by the Act of 1909. The statement of the Rules was as follows:

"12(g) *Works of art.* This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture). *Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.* No copyright exists in toys, games, dolls, advertising, novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or any similar articles."⁶⁵

Subsequent amendment of these rules represented a short step away from a black-white distinction based on utility. The second sentence of the regulation quoted above became:

"The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented, depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture."⁶⁶

Although these regulations were open to the criticism that they ignored the spirit of the changes made by the Act of 1909, the Copyright Office operated on the premise that design patent and copyright should and could be separated.⁶⁷ Not until 1948 were the Regulations susceptible of an interpretation permitting copyright of a work of art which contemporaneously possessed utilitarian features; in that year the applicable regulation was amended to read:

"§ 202.8 *Works of art (Class G)* . . . (a) *In general.* This class includes works of artistic craftsmanship, *in so far as their form but not their mechanical or utilitarian aspects are concerned*, such

⁶⁴ Subject to the approval of the Librarian of Congress, the Register of Copyrights is authorized to make rules and regulations for the registration of copyrights. 17 U.S.C. (Supp. V, 1952) §207.

⁶⁵ WEIL, COPYRIGHT LAW 625 (1917). Emphasis supplied.

⁶⁶ Regulation 12(g) (1926). Note that the second clause of the quoted Regulation was in accord with cases holding that copyright is not lost by later incorporation of the subject matter into useful articles. E.g., *Falk v. T. P. Howell & Co.*, (C.C. N.Y. 1888) 37 F. 202; *King Features Syndicate v. Fleischer*, (2d Cir. 1924) 299 F. 533. However, the clause did limit copyrightability to "artistic drawings" in this category.

⁶⁷ 27 IND. L.J. 130 at 133 (1951).

as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings, and sculpture.”⁶⁸

Examination of these three regulations in chronological order indicates a gradual relaxation by the Copyright Office in the standards it imposed on potential copyright proprietors of useful works of art. This metamorphosis appears in the change from the mandate that products “utilitarian in purpose and character” are not subject to copyright even though artistically made, to the guarded insertion of a clause protecting artistic drawings once copyrighted though subsequently put to functional use, and finally to the present statement that works of art are to be protected except insofar as their mechanical or utilitarian *aspects* are concerned.⁶⁹ This shift in Copyright Office announced policy⁷⁰ accords with the apparent desire of Congress in the Act of 1909 fully to exercise its delegated power in granting protection to “all the writings of an author.”

Developments in Design Patent Legislation

Birth of the design patent occurred in 1842 when Congress, in enacting the Patent Act of August 29, 1842,⁷¹ established a new kind of seven-year patent for inventors of

“ . . . any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture. . . . ”⁷²

⁶⁸ 37 C.F.R. §202.8(a) (1949). Emphasis supplied. But see reference to actual practice of the Copyright Office, *infra* note 152.

⁶⁹ The Regulation is subject to a possible alternative interpretation. Thus the defendant in *Stein v. Mazer*, *infra* note 117, argued that “The very wording of the above regulation, which was promulgated by the Copyright Office itself indicates clearly that the Copyright Office excludes from its orbit of authority any right to grant monopolies on articles which have mechanical or utilitarian aspects, such as electric table lamps here under consideration.” Brief for Defendants-Appellees, No. 6572, United States Court of Appeals for the 4th Circuit 11 (1953).

⁷⁰ For actual practice of the Office, see note 152 *infra*.

⁷¹ 5 Stat. L. 543 (1842).

⁷² *Id.* at 544.

Most of the basic matter covered in the 1842 statute was left unchanged by the Act of March 2, 1861,⁷³ which repealed the former law. One innovation in this act which has considerable significance in a comparison of patent and copyright rights and remedies was the provision that the inventor desiring a design patent would be given an option of three and a half, seven, or fourteen years of protection. Nine years later design patent coverage was limited somewhat by the consolidated Patent, Trade Mark and Copyright Act of 1870 referred to above, but the essential provisions remained intact.

One change effected by the Act of 1870 which did cause difficulties was the addition of the word "useful."⁷⁴ The term was sometimes construed to mean "adaptation to producing pleasant emotions";⁷⁵ in one case, decided even before the Act of 1870, utility itself was held to be the basis of a design patent.⁷⁶ A more sound approach interpreted "useful" to mean ornamental as applied to a useful article, so that the new appearance to a manufactured article "may enhance its salable value, . . . and be a meritorious service to the public."⁷⁷

Radical modification in language came with the Act of 1902,⁷⁸ in which Congress ceased its practice of specifically enumerating classes of patentable subject matter and shrunk the standard to a simple "any new, original, and ornamental design for an article of manufacture." This criterion remains in the present statute.⁷⁹ One main purpose of this change was to eliminate the bothersome word "useful"; although "artistic" was suggested originally by the Commissioner of Patents, the Committee on Patents recommended "ornamental" as the substitute.⁸⁰

⁷³ 12 Stat. L. 246 (1861).

⁷⁴ The Acts of 1842 and 1861 spoke of a "new and useful pattern, or print, or picture . . . fixed on, any article of manufacture," but in 1870 Congress amended "any new and original shape or configuration of any article of manufacture" by adding "useful" as a modifier.

⁷⁵ *Ex parte Parkinson*, 1871 C.D. 251; *Rowe v. Blodgett*, (2d Cir. 1901) 112 F. 61 at 62.

⁷⁶ "Articles have been, and are being constantly, patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles." *Ex parte Bartholomew*, 1869 C.D. 103 at 105.

⁷⁷ *Gorham Co. v. White*, 14 Wall. (81 U.S.) 511 at 525 (1871). And see discussion of the meaning of useful in the 1842, 1861, and 1870 statutes in SIMONDS, *DESIGN PATENTS* (1874).

⁷⁸ 32 Stat. L. 193, c. 783 (1902).

⁷⁹ 53 Stat. L. 1212 (1939), 35 U.S.C. (Supp. V, 1952) §73.

⁸⁰ The immediate effect of the amendment was a decrease in the number of design patent applications; this fact, along with later judicial decisions, represented substantial attainment of the Patent Office's goal to eliminate the design patent as a means of protecting advances primarily of a mechanical or functional nature. Hudson, "A Brief History of the Development of Design Patent Protection in the United States," 30 J. PAT. OFF. SOC. 380 at 392 (1948).

Case Law

A. *Other Than the Stein Cases.* Forming a backdrop to the current *Stein* litigation, which has presented in pinpoint fashion the borderland problem, a number of previous cases have dealt with one or another phase of the interrelation of the two statutes. Common to the opinions is judicial condemnation of attempts to obtain double protection.

Several substantive issues may arise when plaintiff asserts copyright or design patent rights in works of art having utilitarian features.

1. *Whether the work is proper subject matter within the meaning of the statute.* Although nothing in the Code or Regulations mentions the presence or absence of utility as a test for copyrightability (with the exception of the Regulation including in section 5 (g) works of art "insofar as their form but not their mechanical or utilitarian aspects are concerned"), the probability in a given case that an article is patentable will no doubt influence a court in determining copyrightability. In the words of one textwriter, ". . . in doubtful cases the Courts will hold that, presumptively, the fact that a given work is patentable is ground for holding it is not copyrightable. . . ." ⁸¹ The apprehension that as a practical matter copyright validity will secure monopoly rights (properly the reward furnished by patent law) for the longer period of protection may influence the decision in certain cases. ⁸² In practice the Copyright Office has not followed this approach, and has refused to deny registration merely because of the possible utilitarian aspects of an article. Thus, registration has been granted for, inter alia, stained glass windows, bas-relief bronze doors, sculptures embodied in book-ends, candlestick holders, sanctuary lamps, paperweights, automobile radiator caps, and savings banks. ⁸³ In each case registration was granted because the article was basically a work of art; the Register of Copyrights simply ignored the presence of the utilitarian aspects in deter-

⁸¹ WEIL, COPYRIGHT LAW 84 (1917).

⁸² E.g., *Davis v. Comitti*, 52 L.T. 539 at 540 (1885). Similar reasoning appears in *Brown Instrument Co. v. Warner*, (D.C. Cir. 1947) 161 F. (2d) 910 at 911, where declaratory relief against the Register of Copyrights regarding right to register a temperature recording chart was denied: ". . . to copyright the charts would in effect continue appellant's monopoly of its machines beyond the time authorized by the patent law."

⁸³ Brief of the Register of Copyrights as Amicus Curiae, in *Stein v. Mazer*, No. 6572, United States Court of Appeals for the 4th Circuit, 12-13. Footnote 2 to this brief gives further examples: altar candle stick, sanctuary lamp model, set of dishes for Tabernacle service, sundial, Egyptian Jardiniere. Illustrative examples may be found in the annual Catalogs of Copyright Entries [required to be published by 17 U.S.C. (Supp. V, 1952) §210]. Examples of articles denied registration because of a wholly utilitarian nature, even though graced with a pleasing design, are refrigerators, clocks, stoves, gasoline pumps, and oil dispensers.

mining whether there was proper subject matter of copyright. The courts have held valid copyright claims to useful objects in the "works of art" and other categories—e.g., a candle holder,⁸⁴ playing cards,⁸⁵ Christmas wrapping paper designs,⁸⁶ and paintings used as circus posters⁸⁷ or cigar advertisements.⁸⁸ The same result is reached when the issue is infringement—the fact that the defendant's copy accomplishes some useful purpose does not avoid liability.⁸⁹ Despite these holdings, in some cases the defendant's position that the particular article in suit properly belongs under the other statute will prevail.⁹⁰

2. *Whether the availability of one type of protection precludes the other.* (a) *Where only one is sought.* In two decisions involving possible overlap of copyright and *mechanical* patent protection it has been held that the two fields are mutually exclusive. The court in *Taylor Instrument Companies v. Fawley-Brost Co.*, in denying copyright protection to charts used in recording temperature, said:

"While it may be difficult to determine in which field protection must be sought, it is plain, so we think, that it must be in one or the other; it cannot be found in both. In other words, there is no overlapping territory, even though the line of separation may in some instances be difficult of exact ascertainment."⁹¹

This analysis has not been carried over to the design patent-copyright area, where a common ground of protection of appearance is evident; there the courts often speak of choice of protection. The first case clearly announcing this latter doctrine was *De Jonge & Co. v. Breuker & Kessler Co.*,⁹² in 1910. An artist commissioned to paint a design for Christmas wrapping paper produced an artistic painting of holly,

⁸⁴ *Pellegrini v. Allegrini*, (D.C. Pa. 1924) 2 F. (2d) 610.

⁸⁵ *Richardson v. Miller*, (C.C. Mass. 1877) 20 Fed. Cas. No. 11,791 at 722.

⁸⁶ *De Jonge & Co. v. Breuker & Kessler Co.*, (C.C. Pa. 1910) 182 F. 150.

⁸⁷ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S.Ct. 298 (1903).

⁸⁸ *Schumacher v. Schwencke*, (C.C. N.Y. 1885) 25 F. 466.

⁸⁹ *Falk v. Howell*, (C.C. N.Y. 1888) 37 F. 202 (copyright of photograph infringed by raised leather figure on furniture); *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, (2d Cir. 1934) 73 F. (2d) 276 (copyright of "Betty Boop" cartoon infringed by doll reproductions); *King Features v. Fleischer*, (2d Cir. 1924) 299 F. 533 at 535, 536 (copyright of "Spark Plug" cartoon infringed by doll reproduction; "We do not think it avoids the infringement of the copyright to take the substance or idea, and produce it through a different medium. . . . The concept of beauty expressed in the materials of statuary or drawing, is the thing which is copyrighted. That is what the infringer copies.").

⁹⁰ E.g., *Taylor Instrument Cos. v. Fawley-Brost Co.*, (7th Cir. 1943) 139 F. (2d) 98; *Brown Instrument Co. v. Warner*, (D.C. Cir. 1947) 161 F. (2d) 910. For the view that perhaps this factor is present only when the protection sought is copyright, see 38 *Iowa L. Rev.* 334 (1953).

⁹¹ (7th Cir. 1943) 139 F. (2d) 98 at 99; see *Brown Instrument Co. v. Warner*, *supra* note 90.

⁹² (C.C. Pa. 1910) 182 F. 150.

spruce, and mistletoe leaves. In a subsequent copyright infringement action based on this design, infringement by defendant was assumed, as was the intention of the artist and his patron to use the design commercially. The principal defense relied upon was that the painting should have been patented under the design patent law. In rejecting this argument of mutual exclusiveness as controlling, the federal circuit court said,

"It is, I think, difficult to see how a painting that may be either copyrighted or patented can be said to be 'designed' for one rather than for the other form of protection until the author or owner makes his final choice. Up to that time he may do what he pleases with his property. If he chooses to copyright it as a work of art, he may do so; if he prefers to patent it as a design, he is free to do this also. . . .

". . . Ordinarily, of course, there is no difficulty. Not many paintings are suitable for use as designs, and only a few designs possess the qualities demanded by the fine arts. But it is easily conceivable that here and there a painting may be eligible for either class, and the water color in question is, I think, an excellent example."⁹³

Subsequent cases have referred to this reasoning with approval.⁹⁴ It was followed as a basis for the decision in *Jones Bros. Co. v. Underkoffler*,⁹⁵ a suit for copyright infringement. The district court there concluded that plaintiff's decorative design for a memorial monument was eligible for either patent or copyright, and gave relief despite the defendant's contention that the monument should have been patented as a design for an article of manufacture.⁹⁶

(b) *Where both are sought.* Although the courts have recognized that a proprietor enjoys this election, the line is drawn when he attempts to obtain the benefits of both spheres of protection. Dictum

⁹³ Id. at 151, 152. The court went on to find that while the design was proper subject matter of copyright, plaintiff's method of posting copyright notice did not comply with copyright provisions, and on this ground relief was denied. The court of appeals and the Supreme Court affirmed on this ground, reserving opinion on the election issue. (3d Cir. 1911) 191 F. 35; 235 U.S. 33, 35 S.Ct. 6 (1914).

⁹⁴ In re Blood, (D.C. Cir. 1927) 23 F. (2d) 772; *Korzybski v. Underwood*, (2d Cir. 1929) 36 F. (2d) 727. Cf. *William A. Meier Glass Co. v. Anchor Hocking Glass Corp.*, (D.C. Pa. 1951) 95 F. Supp. 264.

⁹⁵ (D.C. Pa. 1936) 16 F. Supp. 729.

⁹⁶ At page 730 the court said, "It is apparent that under the above definitions of manufacture and art a certain object may be an article of manufacture as well as a work of art and the design therefor might well come under the Design Patent Law as a design for an article of manufacture or under the Copyright Act as a design for a work of art."

in the *De Jonge* case, *supra*, was the foundation of this theory. The court stated, at page 152:

"Since [the design] was qualified for admission into the two statutory classes, I see no reason why it might not be placed in either. But it could not enter both. The method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by that decision. . . . Such a work may be used in both the fine and the useful arts; but it can have protection in only one of these classes. The author or owner is driven to his election, and must stand by his choice."

In none of the cases in this area has double protection been justified by holding or dictum. In one case plaintiff obtained relief for infringement of both design patent and copyright on the same "kewpie" dolls; however, this decision was based upon a consent decree in which defendant estopped himself from contesting the validity of the copyright.⁹⁷ Generally the approach has been that once the artist seeks shelter under one statute, protection under the other is lost. The primary rationale for this position is probably fear of undue extension of exclusive rights; thus in a case where the proprietor's design for a hosiery ticket had already been registered as a label (copyright protection), the Commissioner of Patent's refusal to grant a design patent was upheld, since the course urged by the applicant "would result for all practical purposes in an extension of the design monopoly."⁹⁸ In addition, two legalistic arguments for the theory have been suggested. In *Korzybski v. Underwood & Underwood, Inc.*,⁹⁹ plaintiff had been granted a patent on a scientific model allegedly illustrating Einstein's theories. Later he registered the model with the Copyright Office. When defendant photographed the model, plaintiff brought suit for copyright infringement. Relief was denied, in part on the ground that by the patent application and grant plaintiff had made a full disclosure of his invention to the public, except for the right to make, use and vend it for a certain period, and consequently that everything disclosed became part of the public domain. Since the work was part of the public domain (save the exceptions mentioned), it could not properly

⁹⁷ *Wilson v. Haber Bros.*, (2d Cir. 1921) 275 F. 346. The court made plain its reservation of opinion as to the propriety of copyrighting the doll.

⁹⁸ *In re Blood*, (D.C. Cir. 1927) 23 F. (2d) 772. In 1927 copyright registration of commercial prints and labels was administered by the Patent Office. This function was transferred to the Copyright Office in 1939. 17 U.S.C. (Supp. V, 1952) §6.

⁹⁹ (2d Cir. 1929) 36 F. (2d) 727.

be the subject matter of copyright.¹⁰⁰ The second idea was expressed in an ex parte opinion delivered in the Patent Office.¹⁰¹ Applicant for a design patent on a roof design had previously registered the design for copyright as a work of art. The Examiner's decision adverse to the applicant was affirmed. It was pointed out that part of the consideration given by a patent applicant is recognition that the public will be entitled to use the invention at the expiration of the patent. If the public will be unable to use the article at the expiration of the design patent, because of continuing copyright protection, this consideration will be lacking, and the patent should not issue.

3. *The question of infringement.* Although somewhat collateral to the principal inquiry of this paper, the problem of whether certain conduct of a defendant infringes a concededly valid copyright sometimes involves the interrelation of copyright and patent principles. A recent Court of Claims decision, *Fulmer v. United States*,¹⁰² illustrates the problem. Plaintiff copyrighted a design showing a parachute with irregular curved lines painted on the cloth. From information disclosed by the design (according to the allegations) the United States produced camouflaged parachutes. The government's motion to dismiss was granted, the court pointing out that plaintiff had not patented his design and thereby obtained a monopoly of the process, but had sought the limited protection available under copyright law. Primary reliance was placed upon *Baker v. Selden*,¹⁰³ the famous case in which the author of a book explaining a system of bookkeeping was denied copyright protection as to use of the system itself. Other cases close but distinguishable involve three-dimensional reproduction of two-dimensional copyrighted cartoons—particularly the "toy doll" cases¹⁰⁴—in which infringement has generally been found. These decisions have been referred to in the *Stein* cases, *infra*, where the question is sometimes posed as to whether manufacture of a lamp can infringe copyright

¹⁰⁰ Section 7 of the Copyright Act provided "That no copyright shall subsist in the original text of any work which is in the public domain." The same basic provision is now in 17 U.S.C. (Supp. V, 1952) §8.

¹⁰¹ Reported in 34 J. PAT. OFF. SOC. 463 (1952).

¹⁰² (Ct. Cl. 1952) 103 F. Supp. 1021.

¹⁰³ 101 U.S. 99 (1880). The court also referred to *Muller v. Triborough Bridge Authority*, (D.C. N.Y. 1942) 43 F. Supp. 298 (copyright of novel bridge approach not infringed by construction of such a bridge). See also *Brief English Systems v. Owen*, (2d Cir. 1931) 48 F. (2d) 555 (shorthand system).

¹⁰⁴ *Fleischer Studios v. Ralph A. Freundlich, Inc.*, (2d Cir. 1934) 73 F. (2d) 276; *King Features Syndicate v. Fleischer*, (2d Cir. 1924) 299 F. 533. Cf. *Hill v. Whalen*, (D.C. N.Y. 1914) 220 F. 359 (dramatic performance held infringement of "Mutt and Jeff" cartoon copyright); *Jones v. Underkoffler*, (D.C. Pa. 1936) 16 F. Supp. 729 (cemetery use of memorial held infringement).

of a statuette. The fear always hovers that a copyright registrant is attempting in an easy fashion to secure monopoly rights in the invention of an art, rather than mere protection against plagiarism of his method of expression.

B. *The Stein Cases*. Imitations of the creative efforts of Rena Stein, designer of the lamp statuettes involved in the currently important *Stein* cases,¹⁰⁵ have provoked a number of infringement suits. At this writing the validity of the *Stein* copyrights has been adjudicated in four United States district courts and three United States courts of appeals, appeal is pending in another circuit, and a petition for certiorari is on file in the Supreme Court. In the seven decisions to date, three have gone in favor of the Steins and four against. Two of the three appellate decisions, however, decided in May and June of 1953, have sustained the copyright claim.

A folio of the litigation, and the treatment received by the plaintiffs' claim in each case (in brackets), includes:

Stein v. Expert Lamp Co., (D.C. Ill. 1/23/51) 96 F. Supp. 97 [rejected]; affirmed, (7th Cir. 5/2/51) 188 F. (2d) 611 [rejected]; certiorari denied, 342 U.S. 629 (10/8/51) [not considered]; (D.C. Ill. 7/8/52) 107 F. Supp. 60 [collateral point].

Stein v. Rosenthal, (D.C. Cal. 3/21/52) 103 F. Supp. 227 [upheld]; affirmed, (9th Cir. 6/26/53) 98 U.S.P.Q. 180 [upheld].

Stein v. Benaderet, (D.C. Mich. 12/23/52) 109 F. Supp. 364 [rejected]; appeal pending in 6th Circuit.¹⁰⁶

Stein v. Mazer, (D.C. Md. 2/20/53) 111 F. Supp. 359 [rejected]; reversed, (4th Cir. 5/19/53) 204 F. (2d) 472 [upheld]; petition for certiorari pending.¹⁰⁷

The first action, *Stein v. Expert Lamp Co.*, brought in Illinois, was based upon theories of copyright infringement and unfair competition. The Steins, husband and wife who had begun the manufacturing of these artistic devices in 1947, had obtained copyright on "statuettes" under the "works of art" classification in section 5 of the code. Defendant allegedly infringed. Undisputed were the facts that both

¹⁰⁵ These cases are sometimes referred to as the "Reglor" litigation, because plaintiffs (the same in all the suits) manufacture and sell their products under the name Reglor of California. Recent law review commentary relating to this litigation includes 66 HARV. L. REV. 877 (1953); 21 GEO. WASH. L. REV. 353 (1953); 37 MINN. L. REV. 212 (1953); 38 IOWA L. REV. 334 (1953); 27 IND. L.J. 130 (1951); 2 DECALOGUE J. 5 (1951).

¹⁰⁶ No. 11,384, January 29, 1953.

¹⁰⁷ No. 228, October Term 1953-54, August 3, 1953. Other actions brought in New York and Michigan were settled out of court. [Certiorari was granted by the Supreme Court in *Mazer v. Stein*, No. 228, October 12, 1953. 22 LAW WEEK 3081.—Ed.]

parties had sold the statuettes as bases for table lamps, and that the articles produced by the two parties were practically identical.¹⁰⁸ In dismissing the copyright count of the complaint, the court rested its determination that the statuette was not copyrightable subject matter upon the ground that an article *intended* to be put to practical use cannot be copyrighted. Relied upon by the court was the quotation from the *Taylor* case, *supra*, stating that there is no overlapping between (mechanical) patent and copyright protection. No reference was made to the cases recognizing a borderland area in the case of *design* patents and copyrights.

Inasmuch as this was the first decision of the series, and thereby assumed considerable stature as precedent, a point which has been discussed in the subsequent opinions should be noted here. In expounding the "intended useful purpose" test, the district court stated:

"It would seem that plaintiff's submission of the statuettes *with the lamp mounting stubs* to the copyright office was evidence of the practical use to which they were intended to be put. Had it been merely the statuette, use of the statuette thereafter in any practical manner would not remove it from the scope of copyright protection."¹⁰⁹

As a matter of actual fact, the photographs of the statuettes as submitted to the Copyright Office did *not* possess the mounting stubs for electrical connections; the court was misinformed through an inadvertence. Plaintiff subsequently petitioned the district court to reconsider its decision because of this mistake, but the petition was denied on the ground that its contents were "immaterial to the decision in this case."¹¹⁰ Affirmance by the Court of Appeals for the Seventh Circuit was apparently reached without consideration of the denial of the petition since no mention thereof was made in the opinion; in addition, the appellate court did not disturb the trial judge's holding that "plaintiffs' submission of the statuettes with the lamp mounting stubs to the Copyright Office was evidence of the practical use to which the statuettes were intended to be put. . . ."¹¹¹ The court of appeals

¹⁰⁸ These uncontroverted facts characterized all the suits in this series. As referred to in the opinions, evidence showed that only a very few of the thousands of Stein sales were statuettes without lamp attachments.

¹⁰⁹ 96 F. Supp. 97 at 98. Emphasis supplied.

¹¹⁰ This information is obtained from the district court opinion in *Stein v. Mazer*, (D.C. Md. 1953) 111 F. Supp. 359. Some of these facts are also reported in *Stein v. Benaderet*, (D.C. Mich. 1952) 109 F. Supp. 364.

¹¹¹ 188 F. (2d) 610 at 612. Cf., however, statement in *Benaderet*, criticizing *Rosenthal*: ". . . evidently Judge Tolin's attention had not been directed to the fact that both Judge La Buy and the 7 Circuit had knowledge that the Stein statuettes submitted to the copyright office did not include projecting lamp stubs." 109 F. Supp. 364 at 365.

indicated that the proper place for protection, if any, was design patent law. Certiorari was denied by the Supreme Court.

The reason that the misunderstanding of the facts may be significant is that the district court, in a subsequent dispute over attorneys' fees, indicated that registration of the statuettes *with the mounting stubs* was the controlling factor:

"The pertinent feature compelling the court to make the decision of January 23, 1951 was the submission to the copyright office of plaintiff's statuette 'having the threaded mounting stub to receive a lamp socket'. This technicality and the interpretation accorded the copyright statute defeated the plaintiff's claim."¹¹²

Although the value of speculation is questionable, it is arguable that the factual misunderstanding in the *Expert* case was prejudicial to plaintiffs. The decision can be read to stand on the narrow ground that a work of art is not copyrightable if the depiction submitted to the Copyright Office itself indicates that a utilitarian purpose is contemplated.

This factual distinction was relied upon in the second case, *Stein v. Rosenthal*,¹¹³ in the southern district of California. The court, in holding directly contrary to the decision in the *Expert* case, went farther and rejected the "intention" test as set forth in *Expert*. The court reasoned that the statuette as submitted (by photograph) to the Copyright Office (clearly without mounting stubs) was an artistic work capable of copyright registration, and that extrinsic incorporation of utilitarian features does not destroy protection for the statuette itself. The plaintiffs would not be able to enjoin manufacture of action lamps of similar design, but they would be entitled to enjoin copying of the statuette in whatever form it appeared. Rejected was defendant's contention that "copyright protection is very narrow and if a manufacturer conceives an object of utility into which or onto which copyrighted material can be copied, the combining of a copy of a copyrighted work of art with an object of utility destroys the protection of the copyright."¹¹⁴ In pointing out that adoption of the defendant's theory would require inquiry into the subjective motivations of every copyright proprietor, the court squarely repudiated the intention test.¹¹⁵

¹¹² 107 F. Supp. 60 at 61.

¹¹³ (D.C. Cal. 1952) 103 F. Supp. 227, affirmed (9th Cir. 1953) 98 U.S.P.Q. 180. Judgment was rendered for defendant on the unfair competition count of the complaint.

¹¹⁴ 103 F. Supp. 227 at 231.

¹¹⁵ "The appropriateness of copyright registration is determined by the character of the registered work of art as registered and not by the ability, intent or hope of the registrant to use it as a dress for a utilitarian object." 103 F. Supp. 227 at 230.

The third round in the series, litigated in Michigan, was determined adversely to the Steins. The district court, in *Stein v. Benaideret*,¹¹⁶ expressly adopted the intention test discarded in *Rosenthal*, emphasized that "it is the intent and purpose" of the designer which are important, and referred plaintiffs to the design patent laws. The new element present in this case was a deposition by the Register of Copyrights to the effect that the practice of the Copyright Office was to register claims for copyright of any work which it considered "art" even if the work had utilitarian aspects. To the plaintiffs' argument that denial of protection would overrule years of established practice in the Copyright Office, the court answered that this factor would be immaterial even if true, since registration of an article primarily intended to be useful would amount to circumvention of the design patent laws.

Another setback was suffered by the Steins in *Stein v. Mazer*,¹¹⁷ a case tried in the District Court for the Maryland District. In a 1953 opinion, the court examined the previous *Stein* litigation and followed the *Expert* decision in the Seventh Circuit. The reasoning in the *Rosenthal* opinion, both on its interpretation of the significance of the factual issue involved in *Expert* and on its doctrinal analysis, was not accepted. In relying on the rationale expressed in *Expert*, the court made reference to the provision of the Copyright Regulations holding as proper subject matter works of art "in so far as their form but not their mechanical or utilitarian aspects are concerned" and to the practice of the Copyright Office as disclosed by the deposition of the Register; the court concluded that the effect of these two considerations was *adverse* to the plaintiff, emphasizing the aspect of the deposition indicating "that thus, by issuing a certificate of registration the Office purported to give applicant *no* rights so far as any mechanical or utilitarian purpose is concerned."¹¹⁸ In addition, the court examined the history of design patent law, and reflected upon the difference in what is intended by each of the statutory schemes. A further analysis of the factual mix-up in *Expert* was presented, the court concluding that to attribute to the Seventh Circuit a holding based solely on the district court's narrow interpretation of its own decision¹¹⁹ would be to torture the language of the appellate opinion.

Fortunes turned for the Steins in the early summer of 1953, when

¹¹⁶ (D.C. Mich. 1952) 109 F. Supp. 364. Appeal pending in 6th Circuit, No. 11,384.

¹¹⁷ (D.C. Md. 1953) 111 F. Supp. 359, reversed (4th Cir. 1953) 204 F. (2d) 472.

¹¹⁸ 111 F. Supp. 359 at 363. Emphasis by the court.

¹¹⁹ See note 112 *supra*.

the Fourth Circuit reversed the *Mazer* decision and the Ninth Circuit affirmed the district court's holding in *Rosenthal*.

Distinctive of the case in the Fourth Circuit was the filing of a brief by the Register of Copyrights as *amicus curiae*. This brief threw further light on the actual practice of the Copyright Office in the period since 1909, in its determinations of registrability of works of art incorporated into articles of manufacture. It also, *inter alia*, indicated governmental dissatisfaction with the concepts that intention is the controlling element (since this places an impracticable administrative burden on the Copyright Office), and that design patent law and copyright law are mutually exclusive. The court, in declaring the copyrights valid and infringed, accorded deference to the long practice of the Copyright Office, but expressly bypassed the question of whether a design patent-copyright borderland exists.¹²⁰ Judge Dobie went on, in perhaps the most exhaustive opinion in the series, to review the pertinent cases, statutes, and regulations, quoted extensively from the Register's deposition, and expressly rejected the doctrine of the *Expert* case "if this case be not distinguishable" (because of the absence of mounting paraphernalia). The opinion is notable for its clear statement of the position in support of copyright protection—

"Concededly, a copyright does not purport to give to the copyrightee any rights to the mechanical or utilitarian uses of a work of art. A copyright, does, however, protect the work of art *qua* work of art without regard to any functional use to which it might be put. A subsequent utilization of a work of art in an article of manufacture in no way affects the right of the copyright owner to be protected against infringement of the work of art itself. The critical inquiry, therefore, is not whether the particular work sought to be registered has utility but whether it is a work of art irrespective of its utility."¹²¹

Latest holding in the *Stein* caravan is the decision of the Court of Appeals for the Ninth Circuit, affirming the district court in the *Rosenthal* case.¹²² The opinion, in dismissing the concept that protection is lost because of the concurrence of art and utility in the same article, criticized the assumption (perhaps implicit in the *Benaderet* opinion) that design patent law is to be favored to copyright law be-

¹²⁰ "It is strenuously contended by plaintiffs, and by the Government in its brief as *amicus curiae*, that the Copyright Statute and the Design Patent Statute are overlapping. . . . This is vigorously denied by defendants. We do not think it necessary, in order to decide the case before us, to pass upon this important question." 204 F. (2d) 472 at 480.

¹²¹ *Id.* at 477.

¹²² See note 113 *supra*.

cause of the more stringent conditions precedent to patent protection.¹²³ The court reached a pole opposite that of the court in *Expert* (which placed reliance on purpose and intention) in maintaining that rights obtained under the copyright law "cannot be affected by the gratuitous use of the creations by strangers for ornamental supports for a household utility—in this case a lamp."¹²⁴ Perhaps more important to the problem of this paper, the court was the first in the *Stein* series to note affirmatively the existence of a borderland in which a given work might qualify under either design patent or copyright principles. Thus the court recognized that

"The area in which a thing would be either a copyrightable work of art or a patentable design, but not the other, is perhaps unsurveyable. Whether a thing is a work of art or a patentable design, or is a patentable design and not a work of art, cannot be determined by excluding one from the other. A thing is a work of art if it appears to be within the historical and ordinary conception of the term art. A thing is a design by the same token. The two are not necessarily distinct one from the other. Neither goes to the functioning of a utility."¹²⁵

This, the latest judicial pronouncement on the subject at the time of this writing, accords with the philosophy earlier expressed in the *De Jonge* case, *supra*, that a producer of a work which meets the requirements of both statutes may, since no rule of mutual exclusion has ever been written into legislation, choose his alley of protection.

Significant in these two most recent *Stein* adjudications are two propositions: (1) that copyrightability under section 5 (g) depends purely on whether the object submitted is a "work of art," regardless of a possible utilitarian function for which the object may be adaptable (the corollary is that *intention* is not a relevant consideration), and (2) that there does exist a twilight zone of statutory protection in which either a design patent or a copyright may be sought successfully, and that this overlap should have no influence upon a particular determination of the proper subject matter of copyright.¹²⁶

¹²³ The court in the *Benaderet* case quoted Justice Bradley in *Baker v. Selden*, 101 U.S. 99 (1880) ("To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public"), and concluded that "If plaintiffs desired the protection they now claim, they should have submitted to the rigid scrutiny of the Patent Office and applied for a design patent." 109 F. Supp. 364 at 366.

¹²⁴ 98 U.S.P.Q. 180 at 182.

¹²⁵ *Ibid.*

¹²⁶ This harmonizes with the position of the Copyright Office. "Since 1909, it has been the settled practice of the Copyright Office to accept for copyright registration works of art, possessing utilitarian aspects, which might also be eligible for design patent protec-

C. *The Wearing Apparel Cases.* One area of industrial design has been treated as a somewhat special field, that of dress designs. Traditionally dress designs have been denied copyright relief. A leading case for this proposition is *Kemp & Beatley v. Hirsch*,¹²⁷ which based its conclusion on *Rosenbach v. Dreyfuss*,¹²⁸ an old case refusing protection for pattern prints of balloons under the "prints or works of art" category in the then section 5. The *Kemp* case was decided in 1929, long after the "fine arts" limitation in force at the time of *Rosenbach* had been wiped out by the Act of 1909. Subsequent removal of the Copyright Office's similar limitation by the 1948 change in regulations was likewise ineffective, a 1949 textile design case reaching the result attained in the *Kemp* case.¹²⁹ Particularly significant is the fact that in this field other relief is unavailable, unfair competition protection having been declared unobtainable by *Cheney Bros. v. Doris Silk Corporation*,¹³⁰ and design patent protection practically worthless because of the ephemeral nature of style designs. The dress designers' problem, however, is generally considered separately from other "works of art," because of its own peculiarities.¹³¹

Developments in England

By way of contrast to the situation in the United States, England has attempted, through legislation and administrative rules, to draw a workable line between the Copyright and Registered Designs Acts.¹³² This attempt has failed to some degree, as indicated by the fact that the Board of Trade Committee on Copyright devoted 26 pages of its 1952

tion were such an election made." Brief of the Register of Copyrights as Amicus Curiae to the United States Court of Appeals for the 4th Circuit, *Stein v. Mazer*, (4th Cir. 1953) 204 F. (2d) 472 at 15-16.

¹²⁷ (D.C. N.Y. 1929) 34 F. (2d) 291. Other statements to this effect appear in *Nat Lewis Purses v. Carole Bags*, (2d Cir. 1936) 83 F. (2d) 475 at 476; *White v. Leaneore Frocks*, (2d Cir. 1951) 120 F. (2d) 113 at 114-115 (indicating probable invalidity of most design patents on dresses because of lack of novelty or invention); *Belding Heminway Co. v. Future Fashions*, (2d Cir. 1944) 143 F. (2d) 216 at 218.

¹²⁸ (D.C. N.Y. 1880) 2 F. 217.

¹²⁹ *Verney Corp. v. Rose Fabric Converters Corp.*, (D.C. N.Y. 1949) 87 F. Supp. 802. This case denied relief against plaintiff's reliance on the Act of July 31, 1939, 53 Stat. L. 1142, which added to section 5 the words "including prints or labels used for articles of merchandise." As pointed out in *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, (D.C. N.Y. 1934) 112 F. Supp. 187, a dress designer may have copyright protection against copying of the *drawing* of the dress.

¹³⁰ (2d Cir. 1929) 35 F. (2d) 279.

¹³¹ See 27 IND. L.J. 130 at 136 (1951).

¹³² England was the first country to enact any sort of design protection legislation. Act of 1787 (27 Geo. III, c. 38).

report to Parliament to the topic "Artistic Copyright and Industrial Designs."¹³³ Consideration of the English borderland problem¹³⁴ and the suggestions embodied in the Copyright Committee's Report are helpful in analyzing the situation in the United States.

Statutes in England comparable to American legislation are the Copyright Act of 1911 and the Registered Designs Act of 1949. While neither of these acts require any showing of "invention" such as is necessary in American patent cases, the design patent is issued only for "new" articles. The Registered Designs Act provides for the protection of designs applied to articles by industrial processes or means, designs being defined as "features of shape, configuration, pattern or ornament." The Copyright Act protects "artistic works" (which includes "works of drawing" and "works of artistic craftsmanship"). The possibility of overlap is clear from a reading of these two classifications.

Principal differences between the two acts in available protection run parallel to differences in the American system. The Copyright Act protects original artistic works automatically upon their creation without need for compliance with formalities, and the period of the protection is lifetime of the author plus 50 years; the Designs Act protects only art which is registered, and then only for five years, with two subsequent five year renewal periods. The Copyright Act protects a work of art if it is "original" in the copyright sense of being independently achieved; the Designs Act protects a work only if it is novel in the sense of being dissimilar to anything before created.

Cognizant of the overlap of the two statutes, Parliament attempted to minimize its litigation-breeding effect. Section 22 of the Copyright Act provides, in essence, (1) that the Copyright Act does not apply to designs (a) capable of being registered under the Designs Act, and (b) used or intended to be used as models or patterns to be multiplied by any industrial process; and (2) that general rules under the Designs Act can be made for determining specific conditions under which such designs shall be deemed to be so used. The terms of the general rules established under this authority were as follows:

"A design shall be deemed to be used as a model or pattern to

¹³³ REPORT OF THE COPYRIGHT COMMITTEE, Board of Trade 82-98 (1952).

¹³⁴ For an analysis of the English problem written before the Report of the Committee on Copyright, see RUSSELL-CLARKE, COPYRIGHT AND INDUSTRIAL DESIGNS 233-243 (1951). Any consideration of the legislative solutions to the problem as it exists in the United States should be taken only with the warning of the English Copyright Committee in mind: "It is probably impossible in drafting to avoid using broad terms, leaving the Courts to decide border-line cases on their merits." (At 82.)

be multiplied by any industrial process within the meaning of Section 22 of the Copyright Act, 1911:

- (a) When the design is reproduced or is intended to be reproduced in more than 50 single articles . . .
- (b) When the design is to be applied to [certain specified articles]. . . ."

The net effect of these rules when read in the light of section 22 is that if a work is capable of registration as a design, and is intended to be reproduced in more than 50 single articles¹³⁵ or is to be applied to any of the articles referred to in "(b)" above, it will receive no protection under the Copyright Act.

Despite this effort to effectuate a clear division in the area covered, borderland difficulties have arisen. The intention test has been severely criticized as inequitable and impractical, and the Report of the Committee on Copyright also expressed dissatisfaction with the fact that even under present rules many articles are capable of double protection.¹³⁶ The example most cited under the English system is a cartoon which is copyrighted and then later applied industrially as a brooch or doll; if registered under the Designs Act before publication the article would thus meet the requirements of both statutes.

Several solutions were considered and rejected by the committee. The answer ultimately recommended represents a unique contribution to solution of the problem. The basic proposition of the committee was that section 22 be amended to read somewhat as follows:

"(1) This Act shall not apply to designs registered under the Registered Designs Act, 1949.

"(2) Copyright in designs which, although they would, if new or original, be capable of registration under the Registered Designs Act 1949, have not been so registered, shall cease as soon as any article to which the design has been applied, has been reproduced more than 50 times by an industrial process by the owner of the copyright or with his consent."

¹³⁵ The relevant date for this "intention" is the time of making the work. *King Features Syndicate v. Kleemann*, [1941] A.C. 417.

¹³⁶ "We are aware that double protection of a particular article may already exist under the Patents Act and Registered Designs Act, the first, broadly speaking, for basic construction or function, and the second for shape or appearance. But the existence of double protection (for two different terms) for shape or appearance alone is in our view unsatisfactory." Report of the Copyright Committee, Board of Trade, 86-87 (1952).

The effect of this provision would be to establish a cut-off point so that copyright protection would terminate when the proprietor attempted to industrialize his design. The proposal was also made that the scope of this provision include all "associated designs" in addition to the specific design copyrighted. A safeguard for the artist who is unable to anticipate whether his design will be declared registrable as a design was embodied in the recommendation that a refusal by the Registrar to register a design on the ground that it is not registrable under Design Patent rules "should serve definitely to avoid the loss of artistic copyright in the particular design when exploited industrially." Other specific minor qualifications were also proposed by the Committee.¹³⁷

This solution fits particularly the English system, which has already separated fairly sharply the statutes protecting original artistic works generally and novel industrial designs; there are, of course, meaningful differences between the British and American schemes of protection. Nonetheless, the fundamental concept of a condition subsequent represents a second attempt by the English to correlate the provisions of the two laws, an approach which has not yet been tried in the United States. For this reason it merits consideration as one possibility of resolving the problem.¹³⁸

Conclusions

As demonstrated by the divergent results reached by the federal

¹³⁷ The Committee summarized its recommendation as follows, at 92-93:

"(1) artistic copyright should subsist and continue to subsist in all works which are original artistic works, irrespective of whether the intention of the author at the time he creates it is to use the work as an industrial design . . . (2) the copyright, as now, should continue to protect such works against copying . . . and also, with the qualifications stated below, against reproduction in any other 'material form whatsoever'; (3) the protection against others reproducing the author's work should give the author protection against unauthorised industrial designs copying his work, subject to (4) and (5) below; (4) the copyright proprietor should be relieved of the disabling effects of prior publication of the work if he wishes to apply it industrially and applies for registration. On such registration, the protection of the Copyright Act should cease for the designs of the articles as registered. On the expiry of a registration, the registered design and 'associated' designs should go into the public domain; (5) if the proprietor applies the work as an industrial design and does not register the design before doing so, then the protection of the Copyright Act ceases. . . . The original work would continue to enjoy protection against direct copying under the Copyright Act."

¹³⁸ It should be noted that the Committee had in mind principally cases in which the author of a "film, picture, or cartoon" did not originally publish as an industrial design. (REPORT, at 90).

courts in the *Stein* cases, the issue is a close one as to which avenue of protection, if either, will be open to designers of works of art which boast utilitarian potentialities. Difficulty at the international level with articles falling in the borderland area indicates that the problem is one of a conceptually high order and is not attributable simply to the particular statutory scheme which has developed in the United States.

Suggestive of the basic trouble is the contention that "the whole field of creations can be divided into only two classes: that of usefulness and that of beauty."¹³⁹ Legislative attempts a century ago to escape the dilemma arising when the two functions cross in a single article unfortunately concentrated in the patent area, where the primary emphasis is upon utility. This was at best an arbitrary choice; indeed, it has been argued with force that in the abstract, design patent and copyright are much closer cousins than design patent and mechanical patent.¹⁴⁰ Lending vitality to this theoretical objection to the present system is the probability that design patent protection for these hybrid articles is actually a historical accident. The first law protecting industrial designs, an English statute,¹⁴¹ was molded on lines of protection established for artistic, rather than inventive, property. Unfortunately, however, the statute which became the model for design protection legislation in most countries of the world was an 1806 French law which, purely by accident, had the effect of separating industrial designs and models from artistic property.¹⁴² The misclassification has been continued in this country.¹⁴³ It has been asserted that combination of the designation "patent" and subjection to jurisdiction of the Patent Office has virtually compelled the judiciary to develop design patent law in accordance with mechanical patent principles.¹⁴⁴ One author has suggested three reasons why design protection became

¹³⁹ See LADAS, *INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY* 365-409 (1930).

¹⁴⁰ Umbreit, "A Consideration of Copyright," 87 *UNIV. PA. L. REV.* 932 at 934 (1939). The same philosophy was impliedly expressed in *Pellegrini v. Allegrini*, (D.C. Pa. 1924) 2 F. (2d) 610 at 610: "The motive underlying design patents and copyrights of works of art is one readily appreciated. The beautiful and the development of a love of the beautiful and of the artistic sense and taste is as much necessary to a well-rounded life as are the useful things."

¹⁴¹ See note 132 *supra*.

¹⁴² Explanation of this occurrence is detailed in LADAS, *INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY* 367-370 (1930).

¹⁴³ "The fundamental error of Congress was in classifying industrial designs with mechanical inventions instead of with literary and artistic work. Essentially a design is a work of authorship. Its merit is purely aesthetic." 7 *J. PAT. OFF. SOC.* 540 at 541 (1925).

¹⁴⁴ Umbreit, "A Consideration of Copyright," 87 *UNIV. PA. L. REV.* 932 at 934 (1939).

modelled on patent rather than copyright principles: (1) the nature of the subject matter (articles of commerce as distinguished from purely intellectual products); (2) the source of the original suggestion (Commissioner of Patents); and (3) the lack of a central copyright depository at the time the law was passed.¹⁴⁵

In some ways a very aggravating example of the effects of this anomalous situation has been the insistence of Congress and the courts that design patentability depends in part upon a showing of inventiveness. While as an ivory tower proposition it might be urged that invention in appearance, the basic object of design patent protection, is just as possible as invention in mechanical utility,¹⁴⁶ still the tremendous practical difficulties of exploring prior art, and the distasteful realization that ultimately a conclusion of presence or absence of inventiveness will be exceedingly more subjective than in the case of mechanical patents, compel a dissatisfaction with this standard for the design patent. It is understandable why one writer objected in 1927 that:

"In no branch of the Patent Office service is there more opportunity for arbitrary judgment on the part of administrative officials, and in no branch is there a more hazy and indefinite line of decisions from which to endeavor to extract principles and rules which should lead to the establishing of definite standards of what is, and what is not, patentable in the way of a design."¹⁴⁷

As our industrial society progresses and culture becomes more sophisticated, it is to be expected that one continuing trend will be the incorporation of aesthetic ideas into ordinary workaday objects. This trend is surely commendable from the standpoint of social policy and should be encouraged.¹⁴⁸ Serving at times to impede advancement in this area is a curious anomaly, the design patent, which purports to reward achievements in appearance and yet subjects them to tests

¹⁴⁵ Hudson, "A Brief History of the Development of Design Patent Protection in the United States," 30 J. PAT. OFF. SOC. 380 at 383 (1948).

¹⁴⁶ "That there may be as outstanding aesthetic invention as there is mechanical, only barbarians would deny. . . ." *Belding Heminway Co. v. Future Fashions, Inc.*, (2d Cir. 1944) 143 F. (2d) 216 at 217-218.

¹⁴⁷ Allen, "Design Patentability," 9 J. PAT. OFF. SOC. 298 at 299 (1927). Less imposing but nonetheless difficult is the Copyright Office's own burden of subjectivity in determining whether certain submitted articles constitute "works of art."

¹⁴⁸ Viewed from another angle: "The purpose of all parties interested in industrial designs is the promotion of the industry and it is immaterial in a broad sense whether this be done by a copyright system or a patent system, so long as it is well done." 10 J. PAT. OFF. SOC. 297 (1928).

foreign, in a practical sense, to the nature of appearance. Statements placing the design patent mid-way between patent and copyright are overgenerous.¹⁴⁹ The philosophy of the design patent ignores the fact that the value of new expressions of appearance is often short-lived; protection from the time of creation may be vitally needed.

One real evil marking the design patent is its invisible influence behind invalidations of copyrights, as illustrated by the *Stein* cases. As mentioned above, one may ponder whether the artist in those cases would not have been afforded copyright vindication from the start were it not for the subtle influence of the existence of the design patent. The artist's contribution to society for which she seeks protection in the *Stein* cases has not been solely the application of a design to a lamp,¹⁵⁰ which might present the question of invention; rather, her contribution has been the original sculpturing of objects of artistic grace. If both parties in each of the *Stein* cases had been selling statuettes alone, with no lamp attachments, plaintiff would undoubtedly have prevailed. Why should the mere addition of mounting stubs or other attachments, a factor with which copyright law has nothing to do, cause such a difference? It seems wise from the point of view of policy, and in keeping with the constitutional exhortation, to stimulate aesthetic development by allowance of benefits to such artists with disregard of the utilitarian aspects involved. One major objection to this approach, that in effect this confers a monopoly right on the proprietor, which should properly be obtainable only in the patent domain where exhaustive search of prior art is available, may be answered in two ways. First, the proprietor does not have a monopoly under this scheme: for instance, he would be unable to prevent manufacture, sale, or use of identical articles by an independent creator knowing nothing of his work; nor, for example in the *Stein* situation, would he be able to restrain another from manufacturing and selling other types of sculptured figures as lamp bases. And second, this objection assumes, in accordance with traditional assimilation of useful designs into the patent sphere, that the harder-to-get protection of the design patent grant is more beneficial to the public, at best a debatable question.

¹⁴⁹ "The design invention thus occupies a position intermediate between the mechanical invention, having a purely utilitarian function, and the art product of authorship, having a purely esthetic function." *Ex parte Cady*, 1916 C.D. 57 at 61.

¹⁵⁰ See note 123 *supra*.

Apparently no further change in Copyright Office Regulations could remedy the existing confusion in the borderland region; the regulations already state quite explicitly administrative approval of registering the artistic elements of those works which also contain utilitarian features.¹⁵¹ These Regulations were adopted by the Copyright Office after 40 years of official adherence to the "fine arts" distinction which had prevailed prior to 1909.¹⁵² Reversal of stated position after so long a period must have been motivated by strong conviction on the part of the agency, but judicial respect for this change has not been universal.¹⁵³

Probably the best answer would be legislation. Congress might follow a path designed to preserve the present dual system and imitate the example of Great Britain in providing alternative remedies according to actual industrial application. This approach, aside from the criticism that it may act to penalize all but those content to reap small financial harvests, would perhaps seem sufficiently unorthodox and difficult of administration here to be unpopular as a legislative proposal. A sound and more direct attack on the problem would be elimination of the design patent, along with either (1) transfer to copyright jurisdiction of the types of designs now patentable, with a possible cutback in the term of copyright protection (at least in the "works of art" category), or (2) establishment of a new hybrid registration system for industrial works of art and designs, modelled on copyright principles but providing a much shorter duration of the proprietor's exclusive rights. Repeal of the design patent provisions has been

¹⁵¹ 37 C.F.R. §202.8(a) (1949).

¹⁵² The annual REPORT OF THE REGISTER OF COPYRIGHTS for 1948 states, at 3, that in that year "the Office reconsidered the question of what constitutes a work of art . . . with the result that it has broadened the list of articles which are accepted. It will not only continue to accept all works of fine art without question, but will also register other works of art if they display artistic features, whether or not . . . they have utilitarian purposes." This does not tell the entire story, however. "From 1909 to 1948 the Regulations . . . provided that works of the fine arts would be accepted . . . but that utilitarian objects . . . would be rejected. . . . In practice, however, an object of artistic conception in a standard art form—e.g., sculpture or painting—has not been denied registration merely because of its possible utilitarian aspects. . . . In 1948 the Register . . . concluded that the long-existing Regulations adequately defined only the extremes of permissible and non-permissible registration, leaving in doubt the works which fall interstitially between the two extremes." Brief of the Register of Copyrights as Amicus Curiae to the United States Court of Appeals for the 4th Circuit, *Stein v. Mazer*, (4th Cir. 1953) 204 F. (2d) 472 at 11-12. And see 204 F. (2d) 472 at 477.

¹⁵³ *Stein v. Export Lamp Co.*, (D.C. Ill. 1951) 96 F. Supp. 97.

proposed to Congress before.¹⁵⁴ Another possibility would be elimination of the "invention" requirement for design patents.¹⁵⁵

However, the prospect of legislation is unpromising. During and after the first World War a number of legislative proposals were offered in Congress to secure design protection under the copyright laws. Over thirty measures attempting to create some better sort of design protection were considered by Congress in a 20-year period, but none were passed.¹⁵⁶ While the primary struggle over these bills centered in the dress design industry, the provisions were often not limited to the garment and textile area; for example, the best known of these proposals, the Vestal Bill,¹⁵⁷ included every

" . . . pattern . . . , shape or form of a manufactured product . . . , dies, molds, or devices by which such a pattern, shape or form, may be produced, original in its application to or embodiment in such manufactured product . . . and which produces an artistic or ornamental effect or decoration, but shall not include patterns or shapes or forms which have merely a functional or mechanical purpose."

This bill, which based protection on a copyright analogy, passed the House in 1930 but died in the Senate, and thereafter violent differences of opinion in industry itself caused enthusiasm for the legislation to wane.¹⁵⁸ Unless the confusion caused by the *Stein* cases stimulates renewed congressional interest in the problem, therefore, it does not seem reasonable to expect that legislation will fare more favorably at this later date. The possibility should not be dismissed, however.¹⁵⁹

Assuming that legislation will not be forthcoming the courts will

¹⁵⁴ See 7 J. PAT. OFF. SOC. 540 (1925).

¹⁵⁵ A further possible solution is the proposal that the copyright statute be amended expressly to provide that incorporation of the copyrighted work of art into utilitarian wares shall neither avoid the copyright nor exonerate the infringer. Kegan and Kipnis, "Protecting Commercial Applications of Art," 2 DECALOGUE J. 5 (1951), digested 2 L. REV. DIG. 9 (1951).

¹⁵⁶ Enumeration of these bills and general treatment of this area appears in Weikart, "Design Piracy," 19 IND. L.J. 235 (1944). See also 31 COL. L. REV. 477 (1931); GOTSHAL AND LIEF, *THE PIRATES WILL GET YOU* 1 (1945).

¹⁵⁷ H. R. 7243, 71st Cong., 2d sess. (1930). Coverage was cut down by a Senate Committee to five specific categories. Weikart, "Design Piracy," 19 IND. L.J. 235 at 249-250 (1944).

¹⁵⁸ Weikart, *supra* note 157. During recent years of international tension, when sellers were in the economic saddle, the urgency of design protection diminished. With a return to a more normal economy, piracy may again become a fighting issue.

¹⁵⁹ For example, the Patent, Trade-Mark and Copyright Law Section of the American Bar Association has been interested in the problem, legislation dealing with the specific problem of industrial design having been recommended by the section in its 1950 Report.

have to continue their attempts to draw the boundaries. Possibly, of course, the whole question will be solved shortly by the Supreme Court.¹⁶⁰ Until such time as the highest tribunal considers the matter on the merits, however, the question remains an open one.

One or two additional comments might be made with respect to judicial determinations invalidating copyrights in this area. When the ground for decision is that the copyright statute is not intended to cover articles of practical use, the court apparently overlooks the point that many of the classifications of section 5 other than "works of art" expressly protect articles utilitarian in purpose. Directories, maps, and plastic works of a scientific nature are but three examples specifically named in the statute. Thus the statute does not appear to discriminate against "writings" which offer a collateral usefulness. Also apparently overlooked in the decisions is section 3 of the Copyright Code, which protects "all the copyrightable component parts of the work copyrighted"; a fair reading of this language would warrant an interpretation that the artistic aspects of a work should be entitled to protection despite the presence of additional utilitarian features.

A point worthy of re-emphasis is that despite the furor raised in the *Stein* cases over the presence of utilitarian features, there is nothing in either statute (copyright or design patent) making even collateral reference to *utility*. Although traditional modes of thought lump patents with usefulness, and copyrights with purely intellectual creativeness, the language of the design patent statute covers "designs for articles of manufacture" and the Copyright Code specifies "works of art," as the statutes stand today. The difference does not lie in utility.¹⁶¹ Differentiating the two are "manufacture" and "art," not necessarily exclusive opposites. Deliberate deletion of the term "useful" by the Design Patent Act of 1902 indicates congressional intention to discard utility (other than that achieved by ornamentation) as a characteristic of the design patent.¹⁶² Perhaps the problem can be

¹⁶⁰ Review by the Supreme Court in the *Stein* controversy is likely because of the importance of the question and the existence of a conflict in the circuits. Supreme Court Rule 38(5)(b). [See note 107 supra—Ed.]

¹⁶¹ Nor does the difference depend upon whether the article is commercialized: "Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use—if use means to increase trade and to help make money." Holmes, J., in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 at 251, 23 S.Ct. 298 (1903). *Accord*, *Rosenthal v. Stein*, (9th Cir. 1953) 98 U.S.P.Q. 180.

¹⁶² As pointed out in a letter from the Commissioner of Patents sponsoring this legislation, elimination of "useful" was motivated by the Patent Office's dissatisfaction with the

assessed with greater clarity if language of past opinions is temporarily put aside, and resort is had to the cold language of the two statutes. No hint of "utility" will then appear. Nor will any reason be apparent why a designer may not produce "works of art" deserving of "manufacture," without concern as to whether functional utility is present.

Numerous decisions support the principle that "Utility plays no part in determining the validity of a design patent,"¹⁶³ an approach which accords with the legislative history of design patent legislation.¹⁶⁴ This is not merely a matter of semantics; there seems to be at best an unfortunate inconsistency if artists seeking copyright protection are referred to the design patent laws on the ground that their works have utilitarian features, when design patent principles expressly reject utility as a criterion. Acknowledgment of this situation, of course, must be accompanied by recognition that generally "articles of manufacture" do serve utilitarian functions. Still, the objective of design patent protection is to beautify articles of commerce, not to siphon away from copyright protection all artistic works which happen to be useful. The concept of utility, which properly controls in mechanical patent cases because of express statutory language,¹⁶⁵ should be irrelevant in cases such as the *Stein* litigation; it should not be permitted to obscure the plain existence of a borderland in the territory of appearance protection.

If the statutes remain in the status quo, the courts have several alternative approaches to the problem of which protection is applicable. Reliance upon utility as a dividing instrument seems unsupportable, especially if it is coupled with the intention test expounded in the

practice whereby inventors who could not meet the requirements established for mechanical patents applied instead under the design patent provisions. S. Rep. 1139, 57th Cong., 1st sess. (1902).

¹⁶³ *Koch Mfg. Co. v. Blue Star Auto Stores*, (7th Cir. 1939) 103 F. (2d) 598 at 599. See also, e.g., *In re Tournier*, 17 App. D.C. 481 (1901); *Hueter v. Compco Corp.*, (7th Cir. 1950) 179 F. (2d) 416. The view of the Patent Office is in harmony: "... The design patent protects only the appearance of an article, and not its structural or utilitarian features." GENERAL INFORMATION CONCERNING PATENTS, Department of Commerce 24 (1953).

¹⁶⁴ "It is thought that if the present bill shall become a law the subject of design patents will occupy its proper philosophical position in the field of intellectual production, having upon the one side of it the statute providing protection to mechanical constructions possessing utility of mechanical function, and upon the other side the copyright law, whereby objects of art are protected, reserving to itself the position of protecting objects of new and artistic quality pertaining, however, to commerce, but not justifying their existence upon functional utility. If the design patent does not occupy this position there is no other well-defined position for it to take." Letter of Commissioner of Patents to (Senate) Committee on Patents, S. Rep. 1139, 57th Cong., 1st sess., 3 (1902).

¹⁶⁵ 66 Stat. L. 797 (1952), 35 U.S.C.A. (1952 Supp.) §101.

Expert case, which seems to have little relation to the real purpose for protection and which has been found unworkable in the English system.¹⁶⁶ One writer has suggested the possibility of classifying useful works of art according to the degree to which the appearance of the article adheres to its function, copyright protection being granted to *Stein*-type articles since they depart so widely from the simple functional requirements of a lamp; or, the idea of using as a standard the degree of objectivity available in determining whether an "improvement" in appearance has been brought about, design patent protection being appropriate where this degree of objectivity is high.¹⁶⁷ Simpler and more in accord with the apparent legislative purpose, which does not appear to be predicated on a mutually exclusive conception of the two statutes, is the principle that each type of protection is to be judged upon its own merits, without regard to possible benefits, often impossible of practical enjoyment, under the other statute. While a certain distrust of monopolistic potentialities would perhaps restrain the courts from ever permitting concurrent protection under *both* laws,¹⁶⁸ it is submitted that the election theory worked out in the earlier cases fulfills the objectives of proprietor and public alike. To the argument that the question of election does not even arise, because the article is determined to be, for example, uncopyrightable in the first instance, the answer is that under current modes of thought the theoretical availability of the alternative protection is probably a material factor in reaching an adverse determination. It seems clear that Congress, whether consciously or not, whether wisely or not, has created an area of overlap; adjudications disregarding this phenomenon serve to warp

¹⁶⁶ The intention test may prejudice an artist who, at the time of his creation, is unsure as to how he will attempt to capitalize on his product. The probability is that he will exploit the work in the manner most desired by the public.

¹⁶⁷ Note, "Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?" 66 HARV. L. REV. 877 at 884-885 (1953); the author of that note does not subscribe to these criteria.

¹⁶⁸ As a matter of logic, it does not seem objectionable to allow both types of protection on different aspects of the same article. 21 GEO. WASH. L. REV. 353 at 366 (1953). Both design and mechanical patent protection are occasionally granted to cover different aspects of a device of pleasing design and mechanical inventiveness. *Boyle v. Rouso*, (8th Cir. 1926) 16 F. (2d) 666, and cases cited in *SHOEMAKER, PATENTS FOR DESIGNS* 21 (1929). In England double protection may exist. *Werner Motors Ltd. v. A. W. Gambage Ltd.*, [1904] 1 Ch. 264; and see note 136 *supra*. A faint mention of possible double protection appeared in the court's opinion in *Korzybski v. Underwood*, (2d Cir. 1929) 36 F. (2d) 727 at 728-729, quoting from *WELL, COPYRIGHT LAW* 85 (1917). However, as a practical matter, the traditional reluctance of the courts, in adjudications in the public law field, to extend unduly exclusive rights to individuals, should not be regarded lightly, whether or not this is thought of as an unwarranted monopoly phobia.

legislative intention rather than to draw clean lines of distinction. The fundamental responsibility for remedying the situation lies with the legislature. But in the absence of legislative surveying, it is to be hoped that works of art which qualify as designs for articles of manufacture will not be denied protection simply because they fall within a statutory borderland. Their dual nature should speak for them, or, at least, not against them.