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## Design Law in the United States as Compared to the European Community Design System: What Do We Need to Fix?

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### Cover Page Footnote

Editor-in-Chief, Fordham Intellectual Property, Media & Entertainment Law Journal, Volume XXIV; J.D. Candidate, Fordham University School of Law, May 2014; LL.M., Intellectual Property and Information Technology Law, Fordham University School of Law, 2010; BSc., Chemistry, Imperial College of Science, Technology and Medicine, London U.K., 2005. I would like to thank Professor Hugh Hansen for advising me on my Note specifically at the time of topic inception, as well as being a great mentor; Zachary A. Slates & Nick Bartelt at the Fordham IP Institute for their support; all the staff past and present of the Fordham IP Institute for being great friends and colleagues; and my family. To my brother, Bijan.

# Design Law in the United States as Compared to the European Community Design System: What Do We Need to Fix?

Tiffany Mahmood\*

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## INTRODUCTION

Now in their tenth year, European community designs were created to enhance harmonization in design protection across the Member States of the European Union (“EU”). The United States (“US”), in contrast, has only once expanded its protection for designs during that time, namely for vessel designs. Pushes have been made for further *sui generis* protection for Fashion law, but it is unclear why the US has not adopted a system similar to that of Europe, particularly taking into consideration the general uniformity between the two regions’ systems in other intellectual property areas. This Note looks to answer that question by

investigating the nature of US protection of industrial designs, while comparing it to the European system. Part I of this Note will describe how industrial designs can seek protection under Patent law, trade dress, and Copyright law in the United States. Furthermore, Part I will discuss the law of European community designs as well as the Hague Agreement concerning the International Registration of Industrial Designs. Part II will look into the notion that the US regime has some apparent differences with the European regime, and will evaluate the arguments for extra design protection in the US, namely in Fashion law, while taking note that other industries have not found issue with the current protection available for designs in the US. Finally, Part III of this Note will argue that although the US system is somewhat fragmented, this piecemeal approach permits for flexibility for the protection of designs across different industries and that reform should be made in the administration of the examining procedure of the United States Patent and Trademark Office.

#### I. BACKGROUND ON DESIGN PROTECTION IN DOMESTIC, EUROPEAN AND OTHER INTERNATIONAL REGIMES

One of the key factors relating to the difference in design law protection between the United States and the European Union is the absence of any strict principles grounded in international law treaties, specifically the Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPs”).<sup>1</sup> Articles 25 and 26 of TRIPs relate to industrial design protection.<sup>2</sup> Article 25 provides that signatories of the agreement shall provide for:

[T]he protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members

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<sup>1</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, The Legal Texts: The Results Of The Uruguay Round Of Multilateral Trade Negotiations 320 (1999), 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994), *available at* [http://www.wto.org/english/tratop\\_e/trips\\_e/t\\_agm0\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm) [hereinafter TRIPs Agreement].

<sup>2</sup> *See id.* at Annex 1C, § 4.

may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.<sup>3</sup>

Article 25(2) also provides for securing protection for textile designs, in a way that is not prohibitive in cost, and which may be accomplished through either industrial design law or Copyright law.<sup>4</sup> These broad provisions essentially set up loose standards for protection. For example, novelty or originality can be defined based on standards of non-obviousness and TRIPS does not exclude a higher standard for novelty or originality. This may account for the existence of different standards, not only within the US regime but also in comparison to the European community design system.<sup>5</sup>

#### A. What is a “Design”?

John Heskett, a design historian, has described design as “to produce a design to design a design.”<sup>6</sup> Evidently, answering the question “what is a design?” is harder than one might think. Initially, design was considered to be the supplementary stylistic aspects of the appearance of a product, prevalent more in the fields of advertising and sales, as opposed to the actual development of the product itself and its features.<sup>7</sup> Integrated functionalism then replaced the “styling” of earlier years, which then transitioned to the mass-production and market forces wanting more aesthetically pleasing functional products.<sup>8</sup> It is this merging of aesthetics with function that has led to the overarching theme of ornamentality versus functionality that is prevalent in design law protection.<sup>9</sup>

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<sup>3</sup> *Id.* art. 25(1).

<sup>4</sup> *See id.* art. 25(2).

<sup>5</sup> *See id.* art. 25(1).

<sup>6</sup> *See* Alice Rawsthorn, *What Defies Defining, but Exists Everywhere?*, N.Y. TIMES, <http://www.nytimes.com/2008/08/18/arts/18iht-DESIGN18.1.15327742.html?pagewanted=all> (last visited Mar. 19, 2014).

<sup>7</sup> *See* Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Design Protection in the European Union*, 24 AIPLA Q.J. 611, 626–27 (1996).

<sup>8</sup> *See id.* at 627–28.

<sup>9</sup> *See infra* note 22 and accompanying text (discussing design patents requirements, including ornamentality); *infra* note 81 and accompanying text (discussing Community designs where aesthetic features are protectable as long as they are not dictated by function alone).

*B. The U.S. System—Design Patents, Trade Dress and Copyright Protection for Designs*

Designs have been protected under the various rubrics of intellectual property (“IP”) law in the US. Under Patent law, certain designs are protectable as a design patent.<sup>10</sup> Copyright law protects designs as pictorial, graphic, and architectural works,<sup>11</sup> as well as vessel designs,<sup>12</sup> and trade dress has recognized designs that have formed somewhat of a brand by themselves.<sup>13</sup> There is no uniform protection for the designs created by various industries that would permit similar standards for each design. Thus, design rights in the US follow a more fragmented approach whereby each rubric deals with them differently, providing varying levels of protection and various hurdles to acquire any rights at all. Some industries arguably have no recourse at all.<sup>14</sup>

1. Design Patents

Design patents afford inventors strong IP rights if they are able to meet the standards of patentability, as well as those specific to design patents. Section 171 of the Patent Act of 1952 (“Patent Act”) provides for protection to “[w]hoever invents any new, original and ornamental design for an article of manufacture.”<sup>15</sup> Under section 171, the subject matter of a design patent must be a design for “an article of manufacture.”<sup>16</sup> The Manual of Patent Examining Procedure (“MPEP”) defines the design as “the visual characteristics or aspect displayed by the article.”<sup>17</sup> It may relate to the configuration or shape of an article, to the surface ornamentation on an article, or both.<sup>18</sup> Moreover, the design must be inseparable from the article to which it is applied and cannot

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<sup>10</sup> See 35 U.S.C. § 171 (2012).

<sup>11</sup> See *infra* Part I.A.2.

<sup>12</sup> See 17 U.S.C. § 1301 (2012).

<sup>13</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

<sup>14</sup> See Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 118 (Peter K. Yu ed., 2007).

<sup>15</sup> 35 U.S.C. § 171 (2012).

<sup>16</sup> *Id.*

<sup>17</sup> Manual of Patent Examining Procedure §1502, ¶15.42 (2012) [hereinafter MPEP].

<sup>18</sup> *Id.* §1502, ¶15.43.

merely be the “chance result of a method or of a combination of functional elements.”<sup>19</sup>

The ornamental characteristics of the design must be apparent and cannot be concealed; that is, at some point in the life of the article, at least an occasion must arise when the appearance of the article becomes a “matter of concern.”<sup>20</sup> When an article is hidden from the human eye as it arrives at the final use of its functional life, a design upon that article cannot be ornamental.<sup>21</sup> Furthermore, a design must present an aesthetically pleasing appearance that is not dictated by function alone for it to be ornamental.<sup>22</sup>

Originality in design patents is also required. A design for an article that simulates a well-known or naturally occurring object or person is unpatentable under section 171 of the Patent Act for lack of originality.<sup>23</sup>

Like all patents, the design must comply with the patentability standards of novelty<sup>24</sup> and non-obviousness.<sup>25</sup> Non-obviousness, as with other types of patents, is measured from the view of a person skilled in the art.<sup>26</sup> In contrast, novelty is seen from the eyes of an ordinary observer as opposed to a person skilled in the art.<sup>27</sup> Design patents do have other notable differences compared to other types of patents. Specifically, the right of priority for

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<sup>19</sup> *Id.* §1502, ¶15.44.

<sup>20</sup> *See In re Webb*, 916 F.2d 1553, 1557 (Fed. Cir. 1990).

<sup>21</sup> *Id.*

<sup>22</sup> *See Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566 (Fed. Cir. 1996) (“[I]f the design claimed in a design patent is dictated solely by the function of the article of manufacture, the patent is invalid because the design is not ornamental.” (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989))); *see also* *PHG Techs., LLC v. St. John Cos., Inc.*, 469 F.3d 1361, 1366–67 (Fed. Cir. 2006) (discussing factors to be considered to determine whether the patent design as a whole is dictated by function, such as the existence of alternative designs that are just as useful as the present design).

<sup>23</sup> *See* MPEP, *supra* note 17, § 1504.01(d); *see also* *Gorham Mfg. Co. v. White*, 81 U.S. 511, 525 (1871) (discussing the selection of a form for a now well-known and celebrated building does not demonstrate invention).

<sup>24</sup> *See* 35 U.S.C. §102 (2012).

<sup>25</sup> *See id.* §103.

<sup>26</sup> *See* *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966).

<sup>27</sup> *See* *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237 (Fed. Cir. 2009).

foreign applications based on a US design patent application is six months instead of the regular twelve months—that is, the applicant would need to file their foreign application within six months to benefit from the earlier priority date in the US design patent application.<sup>28</sup> Furthermore, design patents are restricted to a term of fourteen years, as opposed to the regular twenty years.<sup>29</sup>

## 2. Trade Dress

Trade dress “includes the total look of a product including its packaging, and even includes the design and shape of the product itself.”<sup>30</sup> Trade dress has been protectable under Trademark law through the Lanham Act by virtue of the broad definition of a trademark as “any word, name, term, symbol, or device, or any combination thereof” in section 43(a).<sup>31</sup> Originally thought to consist of only labels, wrappers, and containers used for the packaging of a product, trade dress now involves the “total image of a product and may include features such as size, shape, color or color combinations, textures, graphics, or even particular sales techniques.”<sup>32</sup> As discussed below, trade dress has been used for various designs including children’s clothing,<sup>33</sup> computer tablets,<sup>34</sup> and even the inside and layout of a Mexican restaurant.<sup>35</sup>

The main hurdle of trade dress protection under Trademark law is demonstrating that the trade dress is distinctive, either inherently or through acquired secondary meaning.<sup>36</sup> Like the rest of Trademark law, generic trade dress is not protectable under the

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<sup>28</sup> See 35 U.S.C. §172.

<sup>29</sup> See *id.* §173.

<sup>30</sup> J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.4 (4th ed. 2013).

<sup>31</sup> 15 U.S.C. § 1125(a) (2012).

<sup>32</sup> *Two Pesos, Inc. v. Taco Cabana*, 505 U.S. 763, 764 n.1 (1992) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)).

<sup>33</sup> See generally *Wal-mart Stores, Inc., v. Samara Bros., Inc.*, 529 U.S. 205, 207–08 (2000).

<sup>34</sup> See generally *Apple, Inc. v. Samsung Elecs. Co.*, 920 F. Supp. 2d 1079 (N.D. Cal. 2013).

<sup>35</sup> See generally *Two Pesos*, 505 U.S. at 765–66.

<sup>36</sup> See *id.* at 769.

Lanham Act.<sup>37</sup> Inherent distinctiveness essentially pertains to the design itself and whether, by its nature, the trade dress is distinctive enough to warrant protection. Many tests have been adopted to measure distinctiveness for all trademarks, most commonly the *Abercrombie* spectrum and the *Seabrook* test.<sup>38</sup> A showing of secondary meaning is essentially created in the mark itself, to the extent that the mark used has become intrinsically associated with the goods manufactured by the owner.<sup>39</sup>

In considering a Mexican restaurant concept as trade dress under the Lanham Act, the Supreme Court in *Two Pesos v. Taco Cabana* held that trade dress that is inherently distinctive is protectable under section 43(a) of the Lanham Act without a showing that it has acquired secondary meaning.<sup>40</sup> The Supreme Court's decision in *Wal-Mart v. Samara Brothers*, however, held that product design trade dress could never be inherently distinctive and always required a proof of secondary meaning.<sup>41</sup> Prior rules still apply to packaging, as per *Two Pesos*, and inherent distinctiveness is measured using the *Abercrombie* spectrum and/or the *Seabrook* test.<sup>42</sup>

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<sup>37</sup> See, e.g., *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995); *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1049 (9th Cir. 1998) (holding that grape-leaf designs have become generic emblems of wine).

<sup>38</sup> See 1 MCCARTHY, *supra* note 30, § 8:13. Under the *Abercrombie* test, a trademark is analyzed to determine whether it is generic, descriptive, suggestive, arbitrary, or fanciful. Generic trademarks are generally unprotectable, a descriptive mark requires secondary meaning, a suggestive mark connotes something about the product that allows inferring its source, and fanciful and arbitrary marks are protectable by nature. A fanciful trademark is one that has been invented whereas an arbitrary trademark is one that is well-known in a different context. This test is generally used for word marks and can be used for trade dress in certain circumstances. See *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F. 3d 363, 369 (4th Cir. 1999). Under the *Seabrook* test, the analysis surrounds whether: "(1) whether the design or shape is a common, basic shape or design; (2) whether it was not unique or unusual in a particular field; (3) whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods which consumers would view as mere ornamentation." 1 MCCARTHY, *supra* note 30, § 8:13.

<sup>39</sup> See 2 MCCARTHY, *supra* note 30, § 15.7.

<sup>40</sup> See *Two Pesos*, 505 U.S. at 776.

<sup>41</sup> See *Wal-mart*, 529 U.S. at 214.

<sup>42</sup> See 1 MCCARTHY, *supra* note 30, § 8:13 (discussing the applicability of the *Abercrombie* and *Seabrook* tests to product designs).

Unlike design patents, trade dress need not be registered to be enforceable against infringers, although common law trade dress protection has its own constraints.<sup>43</sup> Furthermore, registered trade dress is protectable for a duration of ten years and is renewable in perpetuity.<sup>44</sup> However, one of the key differences between trade dress and utility patent law (utility patents falling under the main rubric of Patent law, and design patents being separate) is the issue of functionality—namely, trade dress cannot be protected if it is functional.<sup>45</sup> The policies behind this include the prevention of trade dress seeping into the area of Patent law, which is largely focused on utility, and the promotion of competition in the market place, in that providing patent-like rights of exclusion to such trade dress would hamper competition between market actors.<sup>46</sup> Courts have looked at functionality on the basis of utility, but some courts have considered the doctrine of aesthetic functionality, which in itself appears to be somewhat of an oxymoron.<sup>47</sup> Generally speaking, if the product design or packaging trade dress is solely functional and would be necessary for others to compete, it is unlikely that it will be able to receive any protection under the Lanham Act.<sup>48</sup>

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<sup>43</sup> Unregistered trademark rights are enforceable under the common law of the state in which those rights are sought to be enforced. To acquire those rights, one must show the use in that state. However, registered trademarks are enforceable against any infringing use in the United States without having to show use or intent to use in every single state. *See Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 815–16 (1st Cir. 1987).

<sup>44</sup> *See* 3 MCCARTHY, *supra* note 30, § 19:142; *see also* 15 U.S.C. §§ 1058–59 (2010).

<sup>45</sup> *See* 1 MCCARTHY, *supra* note 30, § 7:63; *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

<sup>46</sup> *See* 1 MCCARTHY, *supra* note 30, § 7:64 (citing *Pope Automatic Merch. Co. v. McCrum-Howell Co.*, 191 F. 979, 981 (7th Cir. 1911)).

<sup>47</sup> *See* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 221–22 (2d Cir. 2012) (“Despite its counterintuitiveness (how can the purely aesthetic be deemed functional, one might ask?), our Court has long accepted the doctrine of aesthetic functionality.”); *see also* 1 MCCARTHY, *supra* note 30, § 7:81 (“That both words ‘utilitarian’ and ‘aesthetic’ are appended to the same base word ‘functionality’ is misleading semantics.”).

<sup>48</sup> *See* 1 MCCARTHY, *supra* note 30, § 7:63.

### 3. Copyright Protection for Designs

Copyright law offers protection for designs, notably through pictorial, graphic or sculptural work subject matter,<sup>49</sup> and specifically for vessels and boats.<sup>50</sup> The requirements for copyright protection include originality,<sup>51</sup> whether the subject matter for which protection is sought is excluded from protection,<sup>52</sup> and whether the subject matter falls into a category of protectable works of authorship.<sup>53</sup>

Originality has two components: (1) the author must independently create the work, and (2) the work must possess at least some minimal degree of creativity.<sup>54</sup> Creativity has frequently been an issue for designs, even though this standard is generally thought to be quite minimal and easily met.<sup>55</sup> Components of a design work might be unoriginal by themselves but their combination might meet the originality requirement.<sup>56</sup>

Under section 102(b), exclusions from copyright protection include an “idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated or embodied.”<sup>57</sup> This largely deals with the concept of idea versus expression in Copyright law, as well as separating what can and should be protected under Patent law as opposed to copyrights.<sup>58</sup>

Pictorial, graphic, and sculptural (“PSG”) works are defined to include:

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<sup>49</sup> See 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:134 (2013).

<sup>50</sup> See 17 U.S.C. § 1301 (2012).

<sup>51</sup> See *id.* § 102(a).

<sup>52</sup> See *id.* § 102(b).

<sup>53</sup> See *id.* § 102(a).

<sup>54</sup> See *Feist Publ'n, Inc. v. Rural Tel. Serv.*, 499 U.S. 340, 345 (1991).

<sup>55</sup> See GRAEME DINWOODIE & MARK D. JANIS, TRADE DRESS AND DESIGN LAW 434 (2010).

<sup>56</sup> See *Yurman Studio, Inc. v. Castaneda*, 591 F. Supp. 2d 471, 483 (S.D.N.Y. 2008) (where designers of jewelry and luxury watches enforced their copyright ownership, as well as their trade dress, trademark and design patent, against a competitor).

<sup>57</sup> 17 U.S.C. § 102(b).

<sup>58</sup> See, e.g., *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741–42 (9th Cir. 1971) (discussing the balance that Congress sought to strike between the Patent Act and the Copyright Act).

[T]wo-dimensional and three dimensional works of fine, graphic, and applied art, photographs, prints and art reproduction . . . . Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be *identified separately from, and are capable of existing independently of*, the utilitarian aspects of the article.<sup>59</sup>

The 1976 Act was intended to distinguish creative works that enjoy protection from elements of industrial design that do not.<sup>60</sup> The notion of separability as referred to under § 101 refers to both the idea of physical separability as well as conceptual separability.<sup>61</sup> Physical separability means that artistic features of an article that are necessary for the utilitarian function of the article would remain intact if they were removed.<sup>62</sup> Physical separability between the aesthetic and original aspects of a design from the function of the article will permit protection for those aesthetic aspects.<sup>63</sup> Conceptual separability, on the other hand, has been said to exist when “there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.”<sup>64</sup>

Under the approach to designs suggested by the Supreme Court of the US in *Mazer v. Stein*, fabric designs were not copyrightable,

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<sup>59</sup> 17 U.S.C. § 101 (emphasis added).

<sup>60</sup> See *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004) (citing H.R. Rep. No. 94-1476, at 55 (1976)).

<sup>61</sup> See *id.*

<sup>62</sup> See 1-2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.08[B][3] (Matthew Bender, rev. ed., 2013).

<sup>63</sup> See *id.*; see also *Mazer v. Stein*, 347 U.S. 201, 212–13 (1954) (holding that works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned such as jewelry, enamels, glassware, and tapestries, are protectable under copyrights. The lamp bases at issue were also protectable under copyright law.).

<sup>64</sup> See 1-2 NIMMER, *supra* note 62, § 2:08[B][3] (referring to the test as the Nimmer/Poe test for likelihood of marketability).

but, in any event, it was since established by Congress that they are afforded protection under the 1976 Act.<sup>65</sup> Dress designs, which consist of the “shape, style, cut, and dimensions for converting fabric into”<sup>66</sup> finished clothing, are largely unprotectable under Copyright law by virtue of running afoul of separation between the functional nature of the garment.<sup>67</sup>

In addition, the Copyright Act has further afforded design protection specifically to vessels and boats under section 1301.<sup>68</sup> The Vessel Hull Design Protection Act added chapter 13 to title 17 in 1998.<sup>69</sup> Under this chapter, the designer of an original design of a useful article that makes the article attractive may secure protection under the 1976 Act.<sup>70</sup> Useful articles are defined as restricted solely to vessel hulls or decks.<sup>71</sup> Vessel features that are protectable include the “design of a vessel hull, deck, or combination of a hull and deck, including a plug or mold.”<sup>72</sup> Section 1302 includes certain important exceptions from protection, namely designs that are dictated solely by a utilitarian function<sup>73</sup> or designs that are commonplace and standard in the industry.<sup>74</sup>

### C. *The European Community Designs System*

Due to disparities in design protection within the European Community (the “Community”), harmonization of these rights was established by virtue of the Directive on the Legal Protection of Designs (the “Directive”)<sup>75</sup>, and the Regulation on Community

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<sup>65</sup> See generally *id.* § 2:08[H]; see also *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759 (2d Cir. 1991); *Peter Pan Fabrics v. Brenda Fabrics Inc.*, 169 F. Supp. 142 (S.D.N.Y. 1959).

<sup>66</sup> 1-2 NIMMER, *supra* note 62, § 2:08[H][1].

<sup>67</sup> See *id.* § 2:08[H][3].

<sup>68</sup> 17 U.S.C. § 1301(a)(1) (2012).

<sup>69</sup> Vessel Hull Design Protection Act, ch. 13, sec. 108, § 502, 112 Stat. 2860 (1998).

<sup>70</sup> 17 U.S.C. § 1301(a)(1).

<sup>71</sup> See *id.* § 1301(b)(2).

<sup>72</sup> *Id.* § 1301(a)(2).

<sup>73</sup> See *id.* § 1302(4).

<sup>74</sup> See *id.* § 1302(2).

<sup>75</sup> Directive 98/71/EC, of the European Parliament and of the Council of 13 October 1998 on the Legal Protection of Designs, 1998 O.J. (L 289) 28 [hereinafter the “Directive”].

Designs (the “Regulation”).<sup>76</sup> The Directive harmonizes the national laws as to registered designs, and the Regulation establishes a unitary Community-wide law of registered and unregistered designs, which is in addition to the protection afforded at the national level.<sup>77</sup> The Office of Harmonization for the Internal Market (“OHIM”) is responsible for the administration of community designs, namely, registration and invalidation applications.<sup>78</sup>

### 1. Standards Under European Design Law

Both the Directive and the Regulation define designs to mean “the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.”<sup>79</sup> The definition contains no reference to the aesthetic or functional nature of the design.<sup>80</sup> However, any features of appearance that are solely dictated by the technical function of the product are excluded from protection.<sup>81</sup>

A design has to be new and has to have individual character.<sup>82</sup> Novelty exists when “no identical design or immaterially different design [has] previously been made available to the public as of the date of filing of the application, or if priority is claimed, the date of priority,” for a registered design.<sup>83</sup> In the case of unregistered designs, novelty is measured against the date the unregistered design has been made available to the public.<sup>84</sup> This is said to be a clear incorporation of the absolute novelty standard found in

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<sup>76</sup> Council Regulation (EC) 6/2002, of 12 December 2001 on Community Designs, 2002 O.J. (L 3/1), 1 [hereinafter the “Regulation”].

<sup>77</sup> See TREVOR COOK, EU INTELLECTUAL PROPERTY LAW 460–61 (2010).

<sup>78</sup> *Id.* at 463; see also Commission Regulation (EC) 2245/2002 of 21 October 2002 implementing Council Regulation No. 6/2002 on Community designs, 2002 O.J. (L 341) 28.

<sup>79</sup> Directive, *supra* note 75, art. 1(a); Regulation, *supra* note 76, art. 3(a).

<sup>80</sup> See DINWOODIE, *supra* note 55, at 530; *c.f.* Registered Designs Act of 1949 in the United Kingdom prior to its amendment, in light of the Directive requiring designs to have “eye-appeal” for protection.

<sup>81</sup> Directive, *supra* note 75, art. 7; Regulation, *supra* note 76, art. 8.

<sup>82</sup> See Directive, *supra* note 75, art. 3(2); Regulation, *supra* note 76, art. 4(1).

<sup>83</sup> Directive, *supra* note 75, art. 4; Regulation, *supra* note 76, art. 5.

<sup>84</sup> See Regulation, *supra* note 76, art. 5.

European Patent law.<sup>85</sup> Both the Directive and Regulation also further define the individual character requirement as the overall impression the design produces on the informed user in that it differs from the overall impression of an earlier design which has been made available to the public either before the date of the application for registered designs,<sup>86</sup> or the date the unregistered design at issue has been made available to the public.<sup>87</sup> Individual character will more likely be found for smaller advances in design when the designer is in a crowded field of industry.<sup>88</sup>

Complex products that contained designs incorporated within the product shall only be deemed to be new and to possess individual character if those components remain visible once incorporated and during the normal use of the product, and to the extent that the visible features are novel and individual.<sup>89</sup> Furthermore, community designs must not run contrary to public policy or accepted principles of morality, much like many European IP rights.<sup>90</sup>

Community design rights afford the designer protection through all Member states, in addition to national systems for design rights that may exist.<sup>91</sup> Registered designs last for a term of five years from the date of filing the application, but may be renewed every five years for a total term of twenty-five years from the date of filing.<sup>92</sup> Unregistered designs last for three years from the date on which the design was first made available to the public in the Community.<sup>93</sup> Furthermore, as of January 2008, a registered Community Design can serve as the basis for an application under the Hague Agreement.

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<sup>85</sup> See *Green Lane Prods. Ltd. v. PMS Int'l Grp. plc*, [2008] EWCA (Civ) 358, [20] (Eng.).

<sup>86</sup> See Directive, *supra* note 75, art. 5; Regulation, *supra* note 76, art. 6.

<sup>87</sup> See Regulation, *supra* note 76, art. 6.

<sup>88</sup> See *DINWOODIE*, *supra* note 55, at 657 (discussing the provisions under Article 5 of the Directive and Article 6 of the Regulation for the degree of freedom of the designer in developing the design as a consideration for individual character).

<sup>89</sup> See Directive, *supra* note 75, art. 3(3); Regulation, *supra* note 76, art. 4(2).

<sup>90</sup> See Directive, *supra* note 75, art. 8; Regulation, *supra* note 76, art. 9.

<sup>91</sup> See Regulation, *supra* note 76, art. 1(3).

<sup>92</sup> See Directive, *supra* note 75, art. 10; Regulation, *supra* note 76, art. 12.

<sup>93</sup> See Regulation, *supra* note 76, art. 11.

*D. International Design Rights—The Hague Agreement*

The Hague Agreement Concerning the International Registration of Industrial Designs permits designers to obtain protection for a design in designated countries by filing a single application with the World Intellectual Property Organization (“WIPO”).<sup>94</sup> The Hague Agreement consists of three international treaties: the Geneva Act of 1999, the Hague Act of 1960, and the London Act of 1934.<sup>95</sup> As of March 21, 2014, there are 61 contracting parties, including the European Union.<sup>96</sup> The United States has yet to fully accede to the Hague Agreement.<sup>97</sup> The US was one of the original signatories to the Geneva Act of 1999, but the Senate did not ratify the treaty until 2007 and the US did not implement the final legislation until December 2012.<sup>98</sup> The legislation took effect in December 2013, and the United States will have fully acceded to the Hague Agreement once the USPTO issues its Final Rules on implementing the Agreement.<sup>99</sup>

To be entitled to file a Hague application, an applicant must be either a national of a Contracting Party or of a member state of an intergovernmental organization that is a Contracting Party, have domicile in the territory of a Contracting Party, or have a real and effective industrial or commercial establishment in the territory of a Contracting Party.<sup>100</sup> The applicant would either file with WIPO or the office of the applicant’s Contracting Party.<sup>101</sup> Registration

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<sup>94</sup> See Hague Agreement Concerning the International Deposit of Industrial Designs, July 2, 1999, 2279 U.N.T.S. 156, available at <http://www.wipo.int/treaties/en/registration/hague> [hereinafter Hague Agreement].

<sup>95</sup> See *id.*

<sup>96</sup> World Intellectual Property Organization, Hague Agreement Concerning the International Registration of Industrial Designs, *Contracting Parties*, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=9](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=9) (last visited Mar. 21, 2014).

<sup>97</sup> See Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, 126 Stat. 1527 (2012).

<sup>98</sup> See Marshall J. Brown, *The Hague Agreement: A New Frontier for U.S. Design Patent Applicants*, INTELLECTUAL PROPERTY TODAY, <http://www.iptoday.com/issues/2013/02/the-hague-agreement-new-frontier-for-us-design-patent-applicants.asp> (last visited May 14, 2013).

<sup>99</sup> See Changes to Implement the Hague Agreement Concerning International Registration of Industrial Designs, 78 Fed. Reg. 71870 (proposed Nov. 29, 2013) (to be codified at 37 C.F.R. pts. 1, 3, 5, and 11).

<sup>100</sup> See Hague Agreement, *supra* note 94, art. 3.

<sup>101</sup> See *id.* art. 4.

under the Hague Agreement essentially helps the applicant to acquire protection in the territory of the Contracting Parties in which the applicant wishes to seek protection, without the need for filing a multitude of separate applications.<sup>102</sup> The Hague Agreement does not provide for any harmonized standards for the type of protection that Contracting Parties to the agreement should provide to designs.<sup>103</sup>

Accession to the Hague Agreement by the US will have an impact on industrial design protection under US Patent law. Design patent terms will be extended from fourteen years to fifteen years and applicants will be able to file for up to 100 designs in one single application, as long as they are all within the same Locarno Classification.<sup>104</sup>

## II. ARE THERE SUBSTANTIVE EXPLANATIONS BEHIND THE DIFFERENCES IN US AND EU DESIGN PROTECTION

Community designs have now been around for ten years, but still the United States has not adopted a comparable *sui generis* form of protection for industrial designs. There is a significant numerical gap between Community designs and US design patents—the latter being considered the closest IP protection in the US to designs in the EU. As of 2003, the year the EU design system was adopted, 205,035 design patents were registered at the United States Patent Office compared to a staggering 711,375 Community designs registered at OHIM.<sup>105</sup> Comparing these two systems on a substantive basis may provide insight into this discrepancy. Furthermore, looking at whether there are industries

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<sup>102</sup> See DINWOODIE, *supra* note 55, at 16.

<sup>103</sup> See Susanne Monseau, *The Challenge of Protecting Industrial Design in a Global Economy*, 20 TEX. INTELL. PROP. L.J. 495, 520 (2012).

<sup>104</sup> See Harold C. Wegner, *The New Industrial Design Law, a TRIPS Trap?*, PATENTLY-O BLOG (Nov. 15, 2012), <http://patentlyo.com/media/docs/2012/11/wegnerindustrialdesignsnov12.pdf>.

<sup>105</sup> Compare U.S. Patent and Trademark Office, *Patent Technology Monitoring Team*, U.S. Patent Statistics Chart, [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm) (last visited May 14, 2013), with Office for Harmonization in the Internal Market, *Statistics of Community Designs*, [http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ssc007-statistics\\_of\\_community\\_designs\\_2013.pdf](http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ssc007-statistics_of_community_designs_2013.pdf) (last visited May 14, 2013).

that seek protection in one regime over another could further shed some light on this difference. First, it is important to look to arguments of the proponents of the Innovative Design Protection Act of 2012 that have long argued that a gap exists in US design law, specifically in relation to fashion designs.

*A. The Innovative Design Protection Act of 2012*

Various proponents for the Innovative Design Protection Act have argued that the US IP system does not afford sufficient protection to the fashion industry.<sup>106</sup> The Innovative Design Protection Act of 2012 (“IDPA”) is a bill that was before Congress, seeking to protect fashion designs under chapter 13 of the 1976 Act.<sup>107</sup> The Act sought to extend the copyright protection afforded to vessel designs under § 1301 to fashion designs.<sup>108</sup> Protection would last for a term of three years from the date of publication of the fashion design registration or from when the design is first made public,<sup>109</sup> and would be awarded to the elements that are creative and provide “a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles.”<sup>110</sup>

This definition seems somewhat broader than the rights granted under registered community designs, which require a showing of novelty and individual character.<sup>111</sup> Under the IDPA, fashion designs would not have needed to be novel, but must have demonstrated that they included features that were unique,

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<sup>106</sup> See, e.g., Written Statement of Susan Scafidi on H.R. 5055, “The Design Piracy Prohibition Act” Presented to the Subcommittee on Courts, the Internet, and Intellectual Property (July 27, 2006) (arguing that Fashion design is part of the logical subject matter of Copyrights as it is now recognized as a form of expression); see also Loni Schutte, *Copyright for Couture*, 2011 DUKE L. & TECH. REV. 11 (2011); Susanne Monseau, *European Design Rights: A Model for the Protection of All Designers from Piracy*, 48 AM. BUS. L.J. 27 (2011).

<sup>107</sup> Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012) [hereinafter the “IDPA”]; see also Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011) (which was the related bill introduced in the House of Representatives).

<sup>108</sup> See *id.* § 2(a).

<sup>109</sup> See *id.* § 2(d).

<sup>110</sup> *Id.* § 2(a)(2).

<sup>111</sup> See *supra* Part I.C.

distinguishable and non-trivial.<sup>112</sup> The IDPA did not elaborate on these standards. For example, the level of uniqueness was not described, nor was the type of observer that would determine the level of similarity between prior designs.<sup>113</sup> To base the legal standards of the IDPA on the argument that fashion designs are successfully protected internationally, such as in the EU, would therefore be incorrect, as community designs are afforded using stricter standards. The IDPA eventually died in Congress as the 112th Congress ended and the bill was not enacted.<sup>114</sup>

In a practical context, looking at the market of Fashion law, it has been argued that the lack of IP protection in Fashion law relates to the actual nature of the industry itself.<sup>115</sup> Namely, fashion goods are considered “positional goods,” in that clothing confers status.<sup>116</sup> Moreover, fashion is cyclical, and the role that IP law plays in the creation of that cycle is not appreciated.<sup>117</sup> Free appropriation of clothing designs contributes to a more rapid obsolescence of designs by generating low-price versions of certain goods, turning the elite into mass.<sup>118</sup> Furthermore, when copies are not as easily discernible from originals, Trademark law sweeps in to help separate the elite from the masses where necessary.<sup>119</sup>

Finally, fashion designs have been protected under the various rubrics of IP law, as discussed above. For example, Lululemon Athletica, an athletic apparel company, notoriously owns design patents for some of its apparel,<sup>120</sup> while its clothing has been

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<sup>112</sup> See IDPA, *supra* note 107, § 2(a)(2).

<sup>113</sup> *C.f. supra* Part I.B for a discussion on the informed user standard used in Community designs.

<sup>114</sup> As did the Innovative Design Protection and Piracy Prevention Act that was introduced in the House of Representatives.

<sup>115</sup> See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1689, 1717–18 (2006).

<sup>116</sup> *Id.* at 1718–19.

<sup>117</sup> *See id.* at 1722.

<sup>118</sup> *See id.*

<sup>119</sup> *See id.* at 1723.

<sup>120</sup> See *Lululemon Sues Calvin Klein Over Patent Infringement*, HUFFINGTON POST (Aug. 23, 2012, 5:43 PM), [http://www.huffingtonpost.com/2012/08/23/lululemon-calvin-klein-sues-patent\\_n\\_1826151.html](http://www.huffingtonpost.com/2012/08/23/lululemon-calvin-klein-sues-patent_n_1826151.html).

protected under trade dress,<sup>121</sup> and its fabric designs protected under Copyright law.<sup>122</sup> Therefore, taking into account the IP protection that is available for fashion designs, and the nature of the products themselves, little is left to support the argument for the enactment of the IDPA, especially when its standards are not in line with those available internationally for designs. Furthermore, this argued disparity in US design law is not one that can explain the numerical gap between the US and EU systems.

### *B. The Use of Designs Across Industries*

To further investigate the gap in US design law, it is relevant to consider which industries seek to protect their designs. Moreover, a specific investigation into the saga between Apple, Inc. and Samsung Electronics illustrates that both US law and EU law successfully protect designs in certain industries.

#### 1. Designs Registered Under the Hague Agreement

The Hague Yearly Review provides interesting insight into the use of the industrial design register at WIPO by members of the design industry.<sup>123</sup> Of note from the 2012 Hague Yearly Review, the Procter & Gamble Company led the way with the top number of Hague applications, the list of which also included members of the watch industry, the automotive industry (for example, Volkswagen, Daimler), other pharmaceutical giants, such as Unilever, and the technology industry. Only one member of the fashion industry is listed—the luxury retailer Hermès. Should there have been a prevalence of fashion houses in this list, the argument that fashion designs are well protected elsewhere would help the IDPA garner more credence. However, no specific industry is responsible for a mass of design registration in the

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<sup>121</sup> See *supra* note 38 and accompanying text.

<sup>122</sup> See 1-2 NIMMER, *supra* note 62, § 2:08[H].

<sup>123</sup> HAGUE YEARLY REVIEW, INTERNATIONAL REGISTRATIONS OF INDUSTRIAL DESIGNS, WIPO ECONOMICS & STATISTICS SERIES (2012), available at [http://www.wipo.int/export/sites/www/freepublications/en/designs/930/wipo\\_pub\\_930\\_2012.pdf](http://www.wipo.int/export/sites/www/freepublications/en/designs/930/wipo_pub_930_2012.pdf).

international forum; and the industries that are at the top of these lists also seek protection in the US.<sup>124</sup>

## 2. Apple Protects Its Designs Against Samsung in Both the US and the EU

The technology industry has recently demonstrated that designs can be protected under both regimes for the same products. Both Apple and Samsung have been engaged in a lengthy battle over the designs associated with their smartphones, namely the iPhone and the Galaxy SII and SIII series.<sup>125</sup> In the US, Apple has successfully claimed infringement of various design patents relating to its smartphones and other devices against Samsung.<sup>126</sup> In Europe, Apple's registered community designs were used against Samsung. For example, in the United Kingdom ("UK"), the Court of Appeals affirmed the Patents County Court decision that certain Samsung tablets do not infringe on the registered Apple design.<sup>127</sup> By contrast, the German courts had initially granted Apple a pan-European preliminary injunction against the production of certain Samsung tablets.<sup>128</sup>

The varying outcomes between these litigations do not stem from any differences in regimes between the US and EU. In fact, design patents were just as unsuccessfully used against Samsung's tablets in the US and the UK. If anything, the disparity, for example, between German and British law, can be explained away by the differences between their enforcement procedures—the German system being known to be very pro-injunctions, in contrast

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<sup>124</sup> See Dennis Crouch, *Top-25 Design Patent Recipients from the Past Year*, PATENTLY-O BLOG (Oct 25, 2012), <http://www.patentlyo.com/patent/2012/10/who-is-getting-design-patents.html>.

<sup>125</sup> See Alex Dobie, *Apple Looks to Add Samsung Galaxy S4 to Patent Infringement Suit*, ANDROID CENTRAL (May 14, 2013, 11:02 AM), <http://www.androidcentral.com/apple-looks-add-samsung-galaxy-s4-patent-infringement-suit>.

<sup>126</sup> See *Apple, Inc. v. Samsung Elecs. Co.*, 920 F. Supp. 2d 1079, 1091 (N.D. Cal. 2013).

<sup>127</sup> See *Samsung Elecs. (U.K.) Ltd. v. Apple, Inc.*, [2012] E.W.C.A. (Civ) 1339 (Eng.).

<sup>128</sup> See Lance Whitney, *Samsung Galaxy Tab Ban Lifted in Europe*, CNET (Aug. 16, 2011, 7:40 PM), [http://news.cnet.com/8301-13579\\_3-20092944-37/samsung-galaxy-tab-ban-lifted-in-europe](http://news.cnet.com/8301-13579_3-20092944-37/samsung-galaxy-tab-ban-lifted-in-europe) (discussing that the injunction was then limited to sales within Germany only).

with other European systems.<sup>129</sup> Nonetheless, the case of Apple and Samsung demonstrates that certain industries do adequately protect their design innovations under both EU and US IP regimes, and so at a first glance, it is unclear where the difference between the two systems stems from.

### C. *US Design Rights in the International Forum*

A substantive comparison of the two regimes may help the investigation of what differences have led to such a disparity in registration numbers. Instead of a *sui generis* form of protection for design rights, the US has adopted a more fragmented approach by covering the area of designs under design patents, trade dress, and Copyright law, as described above.<sup>130</sup> Each area that affords protection to designs has its own shortcomings as well as benefits, in particular in comparison with Community Designs. A look at how the US design law system sits among international treaties can also shed some light as to the former's shortcomings.

#### 1. US Designs Versus Community Designs: A Design Patent Comparative Focus

When looking at both the US and EU systems for protecting industrial designs, US design patents are the closest analogue to community designs, and therefore, this Note will use design patents as the starting point for a comparative discussion. When looking at both design patents and community designs, certain similarities are clear.<sup>131</sup> Differences in what can be protected include the novelty, non-obviousness, and originality requirements. The vast breadth of the definition of what can be protected under the Directive and Regulation is significant,<sup>132</sup> but what cannot be ignored is the availability of protection under trade dress, Trademark law and Copyright law in the US to counter this. Strong disparities do exist, however, at the administrative level in

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<sup>129</sup> See, e.g., *Google Can't Enforce German Microsoft Injunction, Court Says*, 25 No. 12 WESTLAW J. SOFTWARE L. 2 (quoting Professor Brian Love).

<sup>130</sup> See *supra* Part II.A

<sup>131</sup> See generally P. Rodinger, *US Design Patents and Registered Community Designs Comparison of Main Characteristics*, AIPLA, <http://www.aipla.org/learningcenter/library/papers/am/AM08Materials/Documents/Rodinger-paper.pdf>.

<sup>132</sup> See *supra* Part I.C.

that community designs do not go through the same rigorous examination process as design patents do at the USPTO.

a) The Legal Standards: Novelty, Non-Obviousness/Individual Character and Ornamentality

Novelty under design patent law is much stricter than in the law of community designs. Notably, a US design patent is not novel when an “average observer takes the new design for a different, and not modified, already-existing design.”<sup>133</sup> This level of inference is stricter in the sense that a Community design will fail the novelty test only if there is a design that is considered identical, whereby any differing features found are considered immaterial.<sup>134</sup>

The non-obviousness and individual character standards are measured through the eyes of two different people—the person skilled in the art, who will tend to have a high level of knowledge and is probably aware of the constraints the designer may have been faced with designing the article,<sup>135</sup> and the informed user, who may know more than the average consumer but is not an expert nor skilled in the art.<sup>136</sup> This could lead to smaller details in a design patent being sufficient for the person skilled in the art to have a different overall impression, while a relatively informed user might get the same overall impression when comparing the same designs.<sup>137</sup>

The ornamental standards in design patents are similar to the requirements under community designs with regards to features not being protectable whereby they are solely dictated by their technical function, and from the fact that the appearance of both US design patents and EU designs must be visible in their end uses.<sup>138</sup> Originality under US design patent law, however, does not have an equivalent in community designs. Further, the requirement that the design be attached to an article of manufacture

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<sup>133</sup> See *In re Bartlett*, 300 F.2d 942, 943 (C.C.P.A. 1962).

<sup>134</sup> See Rodinger, *supra* note 131, at 5.

<sup>135</sup> See *id.* at 7.

<sup>136</sup> See *id.*

<sup>137</sup> See *id.*

<sup>138</sup> See *supra* Part I.B.1 and I.C.

to the extent that it is inseparable from the article does not exist in community designs.<sup>139</sup>

#### b) Term and Eligibility of Design Protection

With regards to protection duration, design patents currently grant exclusive rights for an automatic period of fourteen years, whereas community designs that are registered grant rights for a term of five years, renewable to a maximum twenty-five year term.<sup>140</sup> The term of protection under the US regime will change to fifteen years with the US's accession to the Hague Agreement.<sup>141</sup>

The definition of what is eligible for design protection in the EU is broader than that contained in Patent law for design patents. Namely, community designs cover a wide spectrum of products including those that would be covered under trade dress and Trademark law in the US.<sup>142</sup> This may be the strongest point of difference between the two regimes that can help explain the numerical differences in registrations under both systems.

#### c) Community Design Applications Do Not Go Through an Examination Procedure like Design Patents Do

One of the most substantial administrative differences in how design patents and how community designs are granted belies in the administrative procedure at the USPTO and OHIM, respectively, for evaluating applications. Community designs do not go through a rigorous examining procedure like design patents do in the US.<sup>143</sup> OHIM is only responsible for reviewing *ex officio*

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<sup>139</sup> See Rodinger, *supra* note 131, at 6.

<sup>140</sup> See *supra* Part I.B.1, Part I.C.

<sup>141</sup> See *supra* note 104 and accompanying text.

<sup>142</sup> See *supra* Part I.C (packaging and logos which are covered under US trade dress and Trademark law respectively are referred to as falling under the rubric of Community design law).

<sup>143</sup> See OHIM, *Excluded from Examination*, <https://oami.europa.eu/ohimportal/en/rcd-registration-process> (follow “What we do not check” tab for an explanation of what is excluded from the examination) (last visited Feb. 8, 2014) (“OHIM will not, of its own motion, check whether your design is new or if it possesses individual character.”); see also OHIM, *The Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade Marks and Designs)*, ¶ 2.4, [https://oami.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/designs\\_pract](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_pract)

two of the grounds for non-registrability under Article 47 of the Regulation:

Whether the subject-matter of the application corresponds to the definition of design set forth in Article 3(a) [of the Regulation]; and  
Whether the design is contrary to public policy or accepted principles of morality.<sup>144</sup>

OHIM is also responsible for evaluating whether the application meets additional formal requirements.<sup>145</sup> Other grounds for invalidating a community design, such as a lack of novelty or individual character, allow a third party to raise an invalidation procedure.<sup>146</sup> By contrast, in the USPTO's procedure for examining design patents, it is the examining officer's responsibility to evaluate the design patent's registrability on all substantive grounds.<sup>147</sup> One of the lengthiest parts of the USPTO's

ice\_manual/examination\_of\_applications\_for\_registered\_community\_designs\_en.pdf [hereinafter OHIM Manual].

<sup>144</sup> See OHIM Manual, *supra* note 143, ¶ 2.4; see also OHIM, *Registered Community Designs Registration Process, What We Check, Substantive Examination*, <https://oami.europa.eu/ohimportal/en/rcd-registration-process> (last visited Feb. 8, 2014) (follow "What we check" tab, then follow "Substantive examination" hyperlink) ("OHIM's substantive examination is limited to two issues:

1. Is your design a design?  
Does your design represent the appearance of the whole or part of a product? An examiner will issue a notification if they believe it does not. For example, a design representing a living plant would receive such a notification
2. Does the design contain an element that goes against public policy and morality?  
The concepts of public policy and morality may vary from one country to another. But given the unitary character of an RCD, it is enough that a design be found contrary to public policy in at least part of the European Union for the design to be refused.").

<sup>145</sup> See OHIM, *Registered Community Designs Registration Process, What We Check, Formalities*, <https://oami.europa.eu/ohimportal/en/rcd-registration-process> (follow "What we check" tab, then follow "Formalities" hyperlink).

<sup>146</sup> See OHIM Manual, *supra* note 143, ¶ 2.4 ("A Community design which has been registered in breach of the protection requirements laid down in Article 25(1)(b) to (g) CDR is liable to be invalidated if an interested party files a request for a declaration of invalidity.").

<sup>147</sup> See MPEP, *supra* note 17, § 1504 ("In design patent applications, ornamentality, novelty, nonobviousness, enablement and definiteness, are necessary prerequisites to the grant of the patent . . . . If the examiner determines that the claim of the design patent

examination procedure is the evaluation of prior art to ensure that the design patent application relates to a novel and nonobvious design.<sup>148</sup>

#### d) Administrative Costs and Efficiencies

Another key difference exists at the administrative level.<sup>149</sup> Although both systems have comparable application and examination procedures, they vary drastically in cost<sup>150</sup> and in procedural duration. Design patents by and large are essentially harder to acquire and applications can take up to two years to process, compared to the swift eight weeks at OHIM.<sup>151</sup>

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The substantive differences between these two systems are mostly nominal. The originality standard under US design patents can be interpreted as existing under the individual character requirement for community designs, in that nothing that is a simulation of a well-known or naturally occurring object or person would be considered different to an informed user from designs made available to the public.<sup>152</sup> Furthermore, the breadth of designs that can fall under community design law could be protected under other IP regimes in the US.<sup>153</sup> Finally, and most importantly, the administrative inefficiencies of the USPTO, in contrast to OHIM and the vast costs of applying for a design

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application does not satisfy the statutory requirements, the examiner will set forth in detail, and may additionally summarize, the basis for all rejections in an Official action.”).

<sup>148</sup> See Wegner, *supra* note 104, at 7 (noting that the USPTO’s examination procedure that is “married to the statutory standard of nonobviousness makes little if any sense at all” in light of the product life cycle of designs).

<sup>149</sup> See *id.*

<sup>150</sup> See generally Rodinger, *supra* note 131, at 14; see also USPTO Fee Schedule, available at <http://www.uspto.gov/web/offices/ac/qs/ope/fee031913.htm> (design patent fees can amount to a total \$1,780.00, not including maintenance fees); Commission Regulation (EC) No. 2246/2002 on the fees payable to the Office of Harmonization in the Internal Market (Trade Marks and Designs) in respect of Community designs, 2002 O.J. (L 341), 54, Annex (Dec. 18, 2002) (Community design fees payable amount to a total of €350 for one single application).

<sup>151</sup> See Rodinger, *supra* note 131, at 13.

<sup>152</sup> Compare *supra* note 23 and accompanying text, and Directive, *supra* note 75, art. 5.

<sup>153</sup> See *supra* note 142 and accompanying text.

patent, are clearly a strong force in creating the gap between design patents registrations and OHIM community design registrations. With the USPTO's lengthy examination procedure compared to OHIM's registration procedure that mostly focuses on formalities, design patents applications are faced with a lengthy battle for registration at the administrative level.

## 2. Does Current US Design Law Violate TRIPS and the Effects of the Hague Agreement in the US

Harold Wegner has argued that current American design law is in violation of Article 25 of TRIPS.<sup>154</sup> In particular, the standard for non-obviousness is not one that is required under TRIPS and creates a substantially greater standard under design patent law for protection.<sup>155</sup> Wegner notes that industrial designs are not adequately protected under US design law.<sup>156</sup> Namely, the system of examination with regards to a means for registering designs is ill-suited for the demands of a fast product life cycle.<sup>157</sup>

Wegner also notes that the adoption of the Hague Agreement into American law through the Patent Act will help designers protect themselves from the effects of knock-offs by being able to file for the 100 designs to be protected in one single application.<sup>158</sup> Further, the implementation of the Hague Agreement may give light to further debate over the potential inadequacies of US design law, in the hopes for reform.<sup>159</sup> What is clear is that accession will not automatically rectify the fact that examination procedures at the USPTO take on average two years for design patents.<sup>160</sup>

### III. THE NECESSITY OF REFORM IN US DESIGN LAW

It is argued that the "great bulk of industrial design is simply not protectable by design patents,"<sup>161</sup> and this is supported in the

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<sup>154</sup> See Wegner, *supra* note 104, at 4–6.

<sup>155</sup> See *id.*

<sup>156</sup> See *id.*

<sup>157</sup> See *id.* at 6–7.

<sup>158</sup> See *id.* at 7–8.

<sup>159</sup> See *id.* at 9.

<sup>160</sup> See *id.* at 7.

<sup>161</sup> *Id.* at 1 (quoting Hon. Giles Sutherland Rich).

numbers.<sup>162</sup> However, the answer to this disparity is not in the substantive nature of US design law. The fragments of the US design puzzle actually afford industrial designs with flexibility. No single regime's design law would necessarily fit all types of designs available for all the various relevant industries. Trade dress provides protection for packaging and products that have essentially become part of the designer's brand, and this type of protection is appropriate in the realms of technological industries, such as Apple, for example, and Fashion law where a handbag may be so iconic to the fashion house brand like Hermès.<sup>163</sup> In contrast, design patents may also be appropriate for a different aspect of technology, as seen by the Apple case where both design patents and trade dress were enforced, and with Lululemon who sought to enforce its design patents against Calvin Klein in September 2012.<sup>164</sup>

EU community designs seem to have been successful in adopting a uniform protection.<sup>165</sup> Trade dress is also available in the EU as a form of protection under Trademark law, and therefore, the EU system is not necessarily as substantively different as the fragmented approach in the US.<sup>166</sup> Any differences are not significant enough to account for the numerical disparity in community designs over design patents granted. In particular, the non-obviousness standard, which Wegner states violates Article 25 of TRIPS,<sup>167</sup> exists in a different form under the community design regime through the virtues of the "individual character" requirement.<sup>168</sup>

What is important to note is that the product life-cycles of designs are short.<sup>169</sup> In the fashion industry, this short product life-

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<sup>162</sup> See *supra* note 105 and accompanying text regarding the number of registrations for design patents at the USPTO and the number of registrations of designs at OHIM.

<sup>163</sup> See Ashby Jones, *Downward Docket: The Yoga Pants War*, WALL ST. J. (Sept. 11, 2012), <http://online.wsj.com/article/SB10000872396390443696604577645891750143350.html>.

<sup>164</sup> See *id.*

<sup>165</sup> Dinwoodie, *supra* note 7, at 633–34.

<sup>166</sup> *Id.* at 720.

<sup>167</sup> Wegner, *supra* note 104, at 4–6.

<sup>168</sup> See *supra* Part I.C., text and accompanying footnotes.

<sup>169</sup> See Wegner, *supra* note 104, at 2.

cycle gives rise to a greater level of innovation which essentially benefits the market; and therefore, the fact that this industry will generally not meet the high standard for protection under design law does not necessitate the adoption of a *sui generis* form of protection with lower standards.<sup>170</sup> But for other industries, by the time a design patent may be granted, the designs themselves may prove to be obsolete or just not as sought after in the market.<sup>171</sup> It has long been noted that the time for all patent applications at the USPTO to be granted is exceedingly long and slow.<sup>172</sup> Reform either by virtue of the office itself or by potentially teasing out the design applications into a separate administrative body could prove to be the key in meeting the demands of these short product life-cycles. To cut down the USPTO's examination procedure to a system that is similar to OHIM's registration process could enable the USPTO to register design patents on an expedited time line. Third parties would need to intervene in a design patent application to invalidate a design patent based on more substantive grounds. If the design patent is already granted, and a third party seeks to invalidate it on substantive grounds, this could be a right of action to take either before the USPTO or before a court. While this would be a drastic change in the way that the USPTO operates on patents as a whole, administrative change is a necessary step in the protection of designs, thus incentivizing designers to continue to create. Design rights in themselves, under US Patent law, are powerful tools for protection against knock-offs but they will admittedly lack in sufficiency when it takes so long for these patents to be granted.<sup>173</sup> While OHIM can take a much shorter time to evaluate designs by using similar standards, it seems unnecessary for the examining procedure at the USPTO to take so long, and reform in the area of administrative efficiency is necessary to better meet the demands of designers.<sup>174</sup>

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<sup>170</sup> See *supra* Part I.B.

<sup>171</sup> See Wegner, *supra* note 104, at 6.

<sup>172</sup> See, e.g., John R. Allison & Mark A. Lemley, *The Growing Complexity of the United States Patent System*, 82 B.U. L. REV. 77, 80 (2002).

<sup>173</sup> Wegner, *supra* note 104, at 7.

<sup>174</sup> See *id.* at 9.

## CONCLUSION

Patent law, trade dress, and Copyright law have long protected designs in the United States, but as the demand for more innovative and aesthetically-pleasing designs develops, so too should the intellectual property rights regimes for those designs in order to meet that demand. While the community design system has successfully harmonized the standards for protectability of designs in the EU, the US system remains fragmented and certain industries have pushed for *sui generis* reform. Furthermore, the accession of the US to the Hague Agreement has opened the door to criticism of our current regime, in particular with regards to design patents. Although design patents remain probably the strongest form of protection against knock-offs, they are not used as readily as community designs. However, it is not the substantively fragmented nature of the US system that is the cause for concern. Reform in the administration of design patent applications would help bring the US system more in line with international standards, affording protection that is substantively similar to that in the EU, but that currently takes too long to acquire.