

DESIGN PATENTS ARE THEFT, NOT JUST A “FRAUD ON THE PUBLIC,” WHO NEED LEGISLATION TO RESTORE THEIR REPAIR RIGHTS

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Introduction

As Professor Peter Menell and Ms. Ella Corren explain in their excellent and timely historical analysis of design patent law and the awful historical development of its current functionality doctrine:

Affording protection for functional advances short of applying the utility patent law’s more exacting novelty, non-obviousness, and disclosure requirements would be, as the Supreme Court observed in denying copyright protection for a system of accounting (and the associated lined forms), “*a surprise and a fraud upon the public*” and undermine free competition.²

But their cogent comment fails to focus adequately on the harm to the public from such fraud, and restricts the scope of the fraud to functionality. Instead, I will argue, that design patents and the law surrounding them have been a series of category errors from the beginning. It is therefore

1. Professor of Law, DePaul University; Author of White Paper on Protecting the Consumer Patent Law Right of Repair and the Aftermarket for Exterior Motor Vehicle Repair Parts: The PARTS Act, S. 812; H.R. 1879, 115th Congress (Nov. 2017), available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3082289, which this work builds upon. I thank Professor Sarah Burstein for her many contributions to my understanding of design patents (including Sarah Burstein, *The Article of Manufacture in 1887*, 32 BERKELEY TECH. L.J. 1, 3 (2017)), as well as the participants of the symposium (including Mark Janis, and his co-author Jason DuMont for their fine historical work, Jason J. DuMont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837 (2013)). I am also grateful for the opportunity to comment on the important work of Professor Menell and Ms. Corren. I just think they are much too polite and that they need to take the kid gloves off in regard to bad legislative drafting judicial reasoning; I have sought to do so here.

2. Peter S. Menell & Ella Corren, Design Patent Law’s Identity Crisis, __ Berkeley Tech. L.J. __, 6 (2021) (quoting *Baker v. Selden*, 101 U.S. 99, 102 (1879) (emphasis in article)).

unsurprising that things have only become worse since 1842, and not just for functionality doctrine.

As I will argue, the *entire concept* of a design patent is a “fraud upon the public,” and it is the public that loses its rights (and pays from its metaphorical wallet) when that fraud occurs. Unfortunately, we have doctrines of judicial and legislative immunity that protect these “thieves” of (not just fraudsters on) the public’s rights, and which doctrines prevent the stolen money from being compensated (including through takings law, as the public can lose its entire rights to private propertization without compensation, but not the other way around). “Property is theft,”³ for designs as much as for realty. And treating designs as patents and keeping the public from making those designs without even copying them or when copying only functions unprotected by utility patents, under the bad historical developments that Professor Menell and Corren criticize,⁴ only makes the theft more costly to the public.

To make my point, principally about judicial theft but starting with legislative theft and bad drafting, I’ll highlight: (1) some historical category errors that protection of designs, the ornamental features of which are the only ones supposed to receive protection and which designs are aesthetic, or as an aesthetic-functional hybrid, and thus design protection was never appropriately placed within a technological patent statute; (2) some doctrinal errors that build off of this and off of the insights of Professor Menell and Ms. Corren, such as the failure to appreciate that an “article of manufacture” is neither a “machine” nor a produced product unless that product is functional in itself, and the standards for novelty (but not non-obviousness) and infringement that are viewed from the perspective of an ordinary observer rather than the hypothetically skilled technological (or aesthetic) artisan, which then makes design patent a chimera of trademark and copyright law that should have no place in our intellectual property zoo; (3) the most recent important conceptual error that makes functionality doctrine even worse (based on the failure to understand that a design is a whole), which when combined with the problematic understanding of “article of manufacture” permits not only partial design patent rights, as

3. PIERRE-JOSEPH PROUDHON, WHAT IS PROPERTY? OR AN INQUIRY INTO THE PRINCIPLE OF RIGHT AND GOVERNMENT (1840). *See generally* James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 L. & CONTEMP. PROBS. 33 (2002).

4. *See* Menell & Corren, *supra* note 2, at ____. *See generally* Jason J. DuMont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTELL. PROP. L. 261 (2012).

expressly created by Judge Giles S. Rich in the 1980 *In re Zahn* case⁵ just before creation of the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), but also fragment design patent rights; and (4) how the partial (and fragment) design patentability doctrine has eliminated the public’s right to repair their purchased products using unauthorized third-party parts that embody such partial (or fragment) design patents, contrary to the patent law repair and exhaustion doctrines, the latter of which the Supreme Court recently held was not merely a function of implied license but rather a matter of fundamental patent policy.⁶ In short, although one could compliment Professor Menell’s and Ms. Corren’s article as a serious critique of the inconsistencies of one particular aspect of the history, theory, and doctrine of design patent law – functionality and ornamentation -- I hope to show viscerally that design patent law is unnatural metaphysical and doctrinal platypi all the way down.

Historical Legislative Category Errors of Utilitarian Function, Aesthetics, and Type of Protection

A. 1842 ORIGINS AND CONFUSING COPYRIGHT AND PATENT

As Professor Menell and Ms. Corren note, their article:

aims to correct this [ornamentality/non-functionality doctrine] fundamental misinterpretation of intellectual property law. Part II tells the remarkable story of how the effort to transplant England’s design copyright regime to the United States spawned a confusingly labeled “design patent” regime and examines the confusion wrought by this mislabeled law during the mid to late 19th century. It also reveals a period in which design patent law served as a proto-federal trademark registration system before Congress

5. *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980). Cf. Menell & Corren, *supra* note 2, at 52 (“Judge Giles Rich, whose protectionist predilection defined his long career....”).

6. *See* *Impression Products, Inc. v. Lexmark Intern. Inc.*, 137 S.Ct. 1523, 1534 (2017) (“The misstep in this logic is that the exhaustion doctrine is not a presumption about the authority that comes along with a sale; it is instead a limit on ‘the scope of the *patentee’s rights*.’”) (citation omitted; emphasis in original). *But see* Sean M. O’Connor, *The Damaging Myth of Patent Exhaustion*, 28 *Tex. Intell. Prop. L.J.* 443, 446 (2020) (the Supreme Court would not adopt key parts of the modern exhaustion doctrine in cases involving actual sales of goods until decades[after *Bloomer v. McQuewan*, 55 U.S. (14 How. 539 (1853)): 1873 for a use right on purchased goods, and 1895 for a right of resale”).

established federal trademark protection in the late 19th century. Remnants of that dalliance still confusingly resonate in the design patent system today.⁷

I won't repeat most of (but will refer extensively to) the history that they trace and their ornamental tracery, although I generally agree with both the statement above and with their detailed discussion of that history, particularly how judicial misinterpretation led to confusion over design patents as providing copyright-like or trademark-like protection in the context of a patent statute (a point that I'll return to in the next section). Instead, I want to focus here on a few of the conceptual category errors of Congress (and secondarily the courts) during this development.

When first enacted by Congress in 1842, the design patent subject matter eligibility provision applied to the aesthetic features of various categories of complete, manufactured, *functionally useful* products (that were useful in themselves, a point I'll come back to in the last section). These were: a "manufacture"; printed "fabrics"; impressions or ornaments on "any article of manufacture" in marble or other material; patterns and pictures "worked into or worked on, or printed, painted, cast, or otherwise fixed" on "any article of manufacture"; any "shape or configuration" of "any article of manufacture"; and various kinds of "statue."⁸ Although the last category – statues – is commonly understood in the present to have a principally ornamental "function," the category of statues is notable, as most two year olds who play the game would say, as being "not like the others." Professors Menell and Corren, and Janis and DuMont, attribute its inclusion to the political economy of seeking to impose copyright-like protection⁹ (to the public's detriment to freely *copy* such works when "publicized," notwithstanding the "sincerest form of flattery" implied of the sculptor thereby¹⁰) at a time when copyright did not yet legislatively extend to statues as "writings" of "authors" within the legislative grant of power in the Constitution.¹¹ To adopt the most charitable view of

7. Menell & Corren, *supra* note 2, at abstract.

8. . Act of Aug. 29, 1842, ch. 263, sec. 3, 5 Stat. 543, 543-44.

9. *See* Menell & Corren, *supra* note 2, at 8 ("copyright protection extended only to books, maps, charts, and prints, not to three-dimensional works"); DuMont & Janis, *supra* note 1, at 868 ("Ellsworth's proposal (and the design patent legislation as ultimately enacted) covered works of fine art (statues, for example), in addition to traditionally manufactured goods").

10. *See, e.g.*, CHARLES C. COLTON, LACON: OR MANY THINGS IN FEW WORDS, ADDRESSED TO THOSE WHO THINK (1820).

11. U.S. CONST., art. I, § 8, cl. 8.

Congress' category error, statues at the time (and since) may possess a "utilitarian" function in instilling public values, and thus (unlike the "function" of other fine arts) could be better understood for inclusion with other functional, utilitarian objects. a current hot topic in regard to whether to remove statues celebrating figures of the Confederacy or who supported slavery.¹²

I leave to the reader to review the fine discussions of Professor Menell and Ms. Corren (and earlier of Professors DuMont and Janis) of the political economy and international trade concerns behind these category confusions, in particular the desire of Commissioner Henry Ellsworth to expand the Patent Office's fiefdom.¹³ But I will quote Professors DuMont and Janis for the point that the evidence belies that Congress had in mind any clear understanding of the categories of things that it was seeking to protect through *aesthetic* protection against *copying*, using patent concepts of exclusive rights that did not require copying to effectuate.

Our research uncovered no evidence of any debate over the wisdom of the core idea that substantive utility patent law rules should govern a new design protection regime and no indication that drafters of the design patent statute were sufficiently prescient to foresee that copyright and utility patent jurisprudence would evolve along divergent paths in the decades to come.¹⁴

Nevertheless, it should be obvious that one of these things – statues – was not like the others in regard to its principally ornamental (as opposed to principally utilitarian) function. Perhaps all of the subsequent category confusions would have been avoided had Congress kept design patent protection as a copyright bill (and then we could deal with functionality, albeit also poorly,¹⁵ under copyright law – although then we would have to deal with each protected work for much, much longer). The central point

12. See, e.g., Elisha Ibrahimji, et al., Confederate statues are coming down following George Floyd's death. Here's what we know, CNN (July 1, 2020), at <https://www.cnn.com/2020/06/09/us/confederate-statues-removed-george-floyd-trnd/index.html>.

13. See Menell & Corren, *supra* note 2, at 8-12; DuMont & Janis, *supra* note 1, at 864-73; Jason DuMont & Mark D. Janis, *U.S. Design Patent Law: A Historical Look at the Design Patent/Copyright Interface*, in *THE COPYRIGHT/DESIGN INTERFACE: PAST, PRESENT & FUTURE* — (Estelle Derclaye ed., 2018).

14. DuMont & Janis, *supra* note 1, at 868.

15. See *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S.Ct. 1002, 1007-1015 (2017).

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is that Congress legislated the loss of the public's rights to freely copy aesthetic productions based on protectionist urges, and went well beyond it to protect even copying of functional features not protected by utility patents and to protect non-copying independent creations of the same aesthetic features. If Congress was going to pick the public's pocket, one would have hoped that Congress could have done so more cleanly and without generating so much fuss, confusion, and unnecessary litigation.

B. POST-1842 CHANGES TO FOCUS ON ORNAMENTALITY BUT
CONTINUED CONFUSION OVER FUNCTIONAL UTILITY

Needless to say, the 1842 Act created substantial confusion over interpretation, given both its unclear purposes and its category-blurring language. Under the 1842 Act the patent-eligible design had to be "invented or produced," and had to be "new and original," except for patterns, prints, and pictures that had to be "new *and useful*."¹⁶ As noted by Commissioner Simonds in 1874, the "new and useful" language for prints reflected an understanding that:

It is not unreasonable to assume it was this application of aesthetic ideas or principles to the adornment of *useful articles*, moving in the minds of the legislators who drafted the laws of 1842 and 1861, that induced them to insert the word "useful" into the text when they named as patentable subject matter "any new and useful pattern, print or picture".... All inventions or discoveries having utility as their basis were fully protected by laws other than those relating to designs, and *it is not reasonable to suppose that the originators of the design patent acts intended to offer another method of protection to things already protected*. It would then seem tolerably plain that the legislators who originated the design patent acts had in mind ... *designs for ornament applied to articles capable of serving a useful purpose*....¹⁷

Note in particular the quoted language of Simonds that the idea that Congress intended to provide protection of function was "not reasonable." As Professors Menell and Corren note,

16. Thomas B. Hudson, *A Brief History of the Development of Design Patent Protection in the United States*, 30 J. PAT. OFF. SOC'Y 380, 381-83 (1948) (emphasis added).

17. *Id.* at 384 (quoting WILLIAM EDGAR SIMONDS, A SUMMARY OF THE LAW OF PATENTS FOR USEFUL INVENTIONS AND FORMS (1874)) (emphasis added).

The inclusion [in the 1842 Act] of the term “useful” and recognition of protection for “shape or configuration” of an article of manufacture led to confusion as to whether the 1842 Act protected functional elements of useful articles. The Patent Office initially took a parsimonious approach, recognizing that the design statute covered *artistic* designs as distinguished from functional elements.

...

[But] after initially questioning the availability of design patent protection for *functional* features of articles of manufacture, the Patent Office reversed course. By 1869, the Patent Office extended design patent protection to functional features of articles of manufacture.¹⁸

In 1870, Congress further revised the design patent eligibility provisions to be ““defined in more concise language.”¹⁹ As Menell and Corren further note:

The 1870 Act’s most relevant design patent amendment deleted the word “useful” from the class of “pattern, print, or picture” and added it to the class of “shape or configuration” of an article. The result was that a law aimed at protecting appearance and not function now confusingly conjoined “utility” with “shape or configuration.”²⁰

This category confusion, like the earlier one, then led to continuing *judicial* controversy over the term “useful” in one of the subcategories of relevant subject matter.²¹ In turn, this judicial confusion prompted Congress to further revise the statute in 1902 to make clear that design patent protection applied only to “new, original, and *ornamental*” designs for an “article of manufacture.”²² (Note carefully that this choice of categories for design protection did *not* include ornamental designs for “machines,” which had been a category of *utility* patent subject matter since 1790, but we’re getting ahead of ourselves.) Congress thus eliminated all of the separate, original (and slightly modified) *enumerated* categories of functional products (and statues) in favor of a single, *collective term* referring to *functionally useful* articles,

18. Menell & Corren, *supra* note 2, at 14, 18 (emphasis added).

19. Hudson, *supra* note 15, at 383-84.

20. Menell & Corren, *supra* note 2, at 18.

21. See Menell & Corren, *supra* note 2, at ___; DuMont & Janis, *supra* note 4, at ___-___.

22. Act of May 9, 1902, ch. 783, sec. 4929, 32 Stat. 193 (emphasis added).

i.e. “articles of manufacture.”²³ As Menell and Corren put it, “This [legislative] change sought to limit design patents to original ornamental features and channel functional advances to the utility patent regime.”²⁴ And although Congress in 1887 had addressed the design patent damages provision, there is no indication that Congress then meant to affect the subject matter provision when also referring to “article of manufacture” in regard to profits.²⁵

In summary, Congress finally (and at least somewhat more coherently) settled on a limitation of design patents and their protection to *only* the *aesthetic* features of a limited class of functional objects, “articles of manufacture.” But that would not satisfy the appetite of the courts to provide greater, extra-statutory, and more trademark-like and copyright-like protections, even when formally subject to patent-law requirements. Again, I won’t retrace those developments, but will simply quote Professor Menell’s and Ms. Corren’s conclusion regarding the judicially developed standards up to 1980 (as I’ll pick up the tale again then in regard to partial design patenting below), as well as their discussion of the Federal Circuit’s further expansions of eligibility under the “availability of alternative designs” test and by “viewing designs as a whole”²⁶ (which I think is correct, even if that insight is not applied properly by the Federal Circuit, again as discussed further below).

Thus by 1980, the standard for assessing design patent eligibility of functional shapes was badly splintered. The use of the “dictated by functional considerations” as a judicial shortcut for disposing of easy cases involving clearly functional designs had opened the door to more lax and subjective standards. The “primarily ornamental” and “primarily functional” standards introduced significant subjectivity and caused the standards to drift farther from the 1902 Act’s text and underlying rationale.... None of these decisions referred back to the clear purpose of the 1902 Act to exclude functional features from design patent

23. See Hudson, *supra* note 15, at 388-89.

24. Menell & Corren, *supra* note 2, at 29. See *id.* at 24-32.

25. See Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387 (currently codified at 35 U.S.C. § 289); Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. __, __-__ (2017) (manuscript at 26-28, 34-35, 56-60); Sarnoff, *supra* note 1, at 10 n.33; Menell & Corren, *supra* note 2, at 1__-__.

26. Menell & Corren, *supra* note 2, at 68. See *id.* at 62-__.

protection..... Inventors and designers increasingly sought to use design patents to protect minimal functional features.²⁷

That inventors and designers so sought is unremarkable. That the courts obliged them without legislative warrant (and, per Simonds, *unreasonably*) based on the judges' protectionist instincts and to the public's detriment is the impolite point that Professor Menell and Ms. Corren simply refuse to state explicitly. As I think that such politesse obscures responsibility and encourages stasis against judicial reinterpretation or legislative correction, I simply refuse to be quite so polite.

C. POST-1870 ACT INTERPRETATIONS TO CREATE EXTRA-STATUTORY COPYRIGHT-LIKE STANDARDS AND TRADEMARK-LIKE PROTECTIONS, AND CONTINUING UTILITY-CONFUSION

As Professors Menell and Corren note, “[b]etween 1842 and 1870, the Patent Office granted more than 200 graphic trademark design patents.”²⁸ And as they further note, the Supreme Court in 1871 in *Gorham Manufacturing Company v. White*²⁹ clearly “held that design patents cover ornamentality, not functionality.”³⁰ But what they failed to state is that in *Gorham*, the Supreme Court nevertheless confused its categories for infringement protection (and hence for validity³¹) by adopting a “substantial similarity” standard of infringement viewed from the perspective of the “ordinary observer.”³² And doing so then provides protection beyond what patent law is supposed to reward – sufficient creativity as recognized by a skilled artisan (whether fine or useful). Instead, in *Gorham*, the Court created from whole cloth a novel set of copyright-like standards in the service of trademark-like protections for owners of aesthetic designs. It did so by focusing on the appearance to an *ordinary observer* rather than to the *skilled (fine) artisan (i.e., designer)*. And it did so based on that time-honored, rhetorical trope for expanding protections to the public's detriment, *piracy*.³³

27. Menell & Corren, *supra* note 2, at 61.

28. Menell & Corren, *supra* note 2, at 14.

29. 81 U.S. 511, 524-25 (1871).

30. Menell & Corren, *supra* note 2, at 23.

31. See *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (it “is axiomatic that claims are [to be] construed the same way for both invalidity and infringement.”) (citing *W.L. Gore & Assoc., Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)).

32. *Gorham Mfg. Co.*, 81 U.S. at 527.

33. *Cf., e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 612-13 (Black, J., dissenting) (“I heartily agree with the Court that ‘fraud’ is bad, ‘piracy’ is evil, and ‘stealing’ is reprehensible. But in this case, where petitioners are not charged with any such malevolence,

If, then, identity of appearance, or (as expressed in *McCrea v. Holdsworth*) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer.... There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them.... Experts, therefore, are not the persons to be deceived.... It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the 'cottage' design, and, therefore, are the production of the holders of the Gorham, Thurber, and Dexter patent, when in fact they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.³⁴

Again, the purpose of the patent laws is to promote the progress of Science and useful Arts,³⁵ and even if those categories are not mutually exclusive, nothing in the Constitution suggests a focus on viewing exclusive rights from the perspective of ordinary observers or on protecting consumers from deception (which of course is a perfectly reasonable purpose for legislation under the Commerce Clause³⁶ and the Necessary and Proper Clause³⁷). Rather, the constitutional purpose of patent protection is to reward authors or inventors for their aesthetic or technological contributions to society. Why that contribution was thought to be measured from the perspective of

these lofty principles do not justify the Court's sterilization of Acts of Congress and prior decisions, none of which are even mentioned in today's opinion.”)

34. *Gorham Mfg. Co.*, 81 U.S. at 527-28.

35. U.S. CONST., art. I, § 8, cl. 8.

36. U.S. CONST., art. I, § 8, cl. 3.

37. U.S. CONST., art. I, § 8, cl. 18.

ordinary observers, as suggested by the Court in *Gorham*, remains a mystery. And what purchasers being misled has to do with whether a product appropriates an aesthetic advance – particularly without copying – that is made by another is similarly a mystery.³⁸

In addition to adopting copyright-like standards providing trademark-like protections, the Supreme Court after *Gorham* went on to further confuse its categories by providing protection for utility and functionality in *Lehnbeuter v. Holthaus*, *Smith v. Whitman Saddle*, and *Northrup v. Adam*, as Professor Menell and Ms. Corren ably describe.³⁹ They further describe the detailed further history of judicial confusion under the 1902 Act (as *not* amended in relevant part by the 1952 Act), including through the creation of the Federal Circuit. I won't retrace their description of these subsequent doctrinal developments regarding assessing functionality and whether and when designs should be considered ornamental under the 1902 Act, but will just quote their summary.

How did courts veer so badly off course?... courts gradually lost their compass and, through a flawed common law evolution, developed standards that not only diverged from Congress's clear intent but also contradicted the Supreme Court's seminal intellectual property channeling principle enunciated in *Baker v. Selden*.⁴⁰

I just want to add here that the *reason* for these judges “losing their compass” was and remains excessive judicial solicitude for creating private property rights, rather than for protecting the interests of the public, or even for adhering to Congress' enactments and intentions that deprived the public of only some of their rights initially (however deeply flawed the choice of patent protection for designs was from the beginning). I will provide only one example, taken from *unaddressed* language in two cases that Professor Menell and Ms. Corren peripherally address for a slightly different purpose. The first case is *Egyptian Goddess v. Swisa*,⁴¹ where the en banc Federal Circuit's focus on protecting consumers (a trademark function) led the court in 2008

38. *Cf.* *Lee v. Dayton Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988) (“A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall ‘resemblance is such as to deceive.’”) (quoting *Gorham Mfg. Co.*, 81 U.S. at 528). See Menell & Corren, *supra* note 2, at 70 (quoting *Lee*).

39. Menell & Corren, *supra* note 2, at 30.

40. Menell & Corren, *supra* note 2, at 22-24.

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

to reject the “point of novelty” approach to infringement, which, contrary to the Federal Circuit’s explicitly *professed* reasoning, was in fact more protective of the public’s rights.

This court has characterized the purpose of the point of novelty test as being “to focus on those aspects of a design which render the design different from prior art designs.”... *That purpose can be equally well served*, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art.⁴²

It should be self-evident that that purpose cannot be “equally well served,” because the differences of appearance from prior art designs to an ordinary designer are almost certain to be viewed more restrictively than by an ordinary purchaser, *i.e.*, the “ordinary observer.” And the en banc Court of Claims and Patent Appeals in *In re Nalbandian*⁴³ had made that point much earlier. An “expert’s perception of color in the dyestuff art is necessarily subjective, but nonetheless entitled to more weight than a layman’s evaluation of the same color.”⁴⁴

The second case that I want to highlight, *Nalbandian*, overturned Judge Rich’s earlier creation of the “ordinary observer” standard for the *obviousness* of designs under Section 103⁴⁵ in *In re Laverne*.⁴⁶ In doing so, Judge Nies made crystal clear just how Judge Rich had ignored legislative language and intent.

In *In re Laverne* ... this court specifically rejected the interpretation generally given to the statutory language “one of ordinary skill in the art” as referring to a designer. The court concluded that this interpretation would not effectuate the intent of Congress to promote progress in designs *since it would result in the denial of patent protection for the work of competent designers*.

...

[As stated in *Laverne*,] “if we equate him with the class of mechanics, as the examiner did, and refuse design patent protection to his usual work product, are we not ruling out, as a practical matter, all patent protection for ornamental designs

42. *Id.* at 677 (emphasis added).

43. 661 F.2d 1214 (C.C.P.A. 1981) (en banc).

44. *Id.* at 1217 (citing *In re Neave*, 370 F.2d 961, 968 (C.C.P.A. 1967)).

45. 35 U.S.C. § 103.

46. 356 F.2d 1003 (1966).

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for articles of manufacture? Yet the clear purpose of the design patent law is to promote progress in the ‘art’ of industrial design and who is going to produce that progress if it is not the class of ‘competent designers?’”

...

The “ordinary designer” means one who brings certain background and training to the problems of developing designs in a particular field, comparable to the “mechanic” or “routinier” in non-design arts.... In any event, we do not believe the determination of the level of ordinary skill in the art, as required under *Graham v. John Deere Co.*⁴⁷ ... cannot be made with respect to designs. Thus, in view of the statutory requirement that patents for designs must be evaluated on the same basis as other patents, the test of *Graham* must be followed.⁴⁸

Judge Rich concurred separately (given that a majority of the Court had decided to overturn *Laverne*): (1) to bemoan the raising of the skill bar for patentable designs (and thus implicitly the reduction of private propertization); (2) to decry the failure of Congress to pass legislation that he had spearheaded to make designs finally subject to copyright registration (a point I will end with), because nonobviousness is not a concept that fits with ornamentality or designs, and (3) to poke at Judge Nies by noting the statutory rather than the Supreme Court origin of the requirement to assess the artisan’s skill.

Laverne thus being dead, I deem it appropriate, as the father of the so-called “ordinary observer” test (as applied to ... § 103), to say a few kind words over the corpse.... The majority is not now talking of “competent designers” but of “ordinary designers” from which it follows that there may be extraordinary designers who will produce unobvious designs which ordinary designers will not routinely produce.... The real problem, however, is not whether the § 103 fictitious “person” is an ordinary observer or an ordinary designer but with the necessity under Title 35 of finding unobviousness in a design.... It is time to pass [new legislation] and get the impossible issue of obviousness in design patentability cases off the backs of the courts and the Patent and Trademark

47. 383 U.S. 1 (1966).

48. *Nalbandian*, 661 F.2d at 1215-17.

Office, giving some sense of certainty to the business world of what designs can be protected and how.... The statute makes that requirement of the courts, all of them, from the highest on down.⁴⁹

Finally, Judge Nies clearly recognized in *Nalbandian* that she remained bound by *Gorham Manufacturing Company*, which no doubt must have offended her exquisite sense of categories. As she stated:

[R]ejection of the ‘ordinary observer’ test under ... § 103 does not preclude its application in other contexts. The “ordinary observer” test was applied in determining whether a claim to a design had been infringed as long ago as *Gorham Co.*... Further, the “ordinary observer” test has been applied when determining anticipation under § 102 by courts which apply the “ordinary designer” test under § 103.

And of course, *Egyptian Goddess* restored the full force of the “ordinary observer” test for both infringement and anticipation, in place of the “point of novelty” test under *Whitman Saddle* that had partially restored a more patent-like feel to *Gorham’s* improvident, non-patent approach.

In summary, by purporting to protect the public’s interest, while actually harming it and ignoring the legislative command, federal judges have sought to divert attention from what was really at stake and from the extra-statutory activism in which they were engaged. For many judges, apparently no amount of private property protection is too much, and like Nature, such judges abhor a vacuum. We thus should remain cognizant of Professor Benjamin Kaplan’s important point that legislative gaps are not holes to be filled, but rather reflect important decisions as to what should *not* be protected, so as to protect the *public’s* interests.⁵⁰ Nevertheless, those materialists among us will not be surprised by these developments, given

49. *Id.* at 12 .

50. *See, e.g.*, Benjamin Kaplan, *An Unhurried View of Copyright: Proposals and Prospects*, 66 Colum. L. Rev. 831, 836 () (“To ‘follow *I.N.S.* and construct a kind of irregular patent or copyright, whether it be called ‘unfair competition’ or something else, would ‘flagrantly conflict with the scheme which Congress has for more than a century devised to cover the subject-matter.’ This view was reinforced by a prevision of the difficulties that would arise in conditioning the anomalous rights-should it be tune with statute, or in some other way.”) (quoting *Cheney Bros. v. Doris Silk Co.*, 35 F.2d 279, 280 (2d Cir. 1929) (Hand, J.)). *Cf.* JESSICA LITMAN, *DIGITAL COPYRIGHT* 79 (Prometheus Books 2006) (“[Through the mid-1970s, c]opyright was seen as designed to be full of holes.... If you’re dissatisfied with the way the spoils are getting divided, one approach is to change the rhetoric.”).

Mancur Olson's work on the political power of concentrated interests relative to the limited power of diffuse coalitions.⁵¹

Historical Judicial Category Errors of Referents and Article of Manufacture

The rest of my analysis, thankfully, can be briefer, while covering more ground. As should be evident to anyone who thinks about it, when Congress in 1902 adopted the generic term “article of manufacture” as its category for *all* of the substantive objects that were to be protectable by patents if they contained *ornamental* designs (removing the lists of objects as to which design patent protection previously applied), there was a history since 1790 in patent law of protecting *inventions* using similar categories as to the types of things that those inventions had to embody. Specifically, the 1790 Act provided authority to grant patents for “any useful art, manufacture, engine, machine, or device, or any improvement therein” that was “invented or discovered.”⁵² In 1793, Congress made minor revisions, in particular adding “compositions of matter” to the enumerated categories of things that could be patented if invented (removing “or discovered”), as well as adding “new and useful” before the enumeration.⁵³ This change then suggested that “useful” was meant as a series modifier (just like “new”) and in a utilitarian functional sense applicable to all of the enumerated categories of things, not just to “useful art” as in the 1790 Act.⁵⁴ Thus, the inclusion of “new and useful” as

51. *See generally* MANCUR OLSON, *THE LOGIC OF COLLECTIVE ACTION: PUBLIC GOODS AND THE THEORY OF GROUPS* (1965).

52. Act of April 10, 1790, ch. 7, § 1, 1 Stat. 109. As Professor Robinson noted, “[t]he words ‘engine’ and ‘device’ convey no idea not embraced in ‘manufacture’ and ‘machine,’ and no phrase is introduced which clearly covers a substance formed by the intermixture of ingredients, though this could have been here, as it was in England, included under ‘manufacture.’” I WILLIAM ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 69, at 107 n.2 (1890).

53. Act of February 21, 1793, ch. 11, § 1, 1 Stat. 317.

54. *See, e.g.*, *Lockhart v. United States*, 136 S.Ct. 958, 962-68 (2016) (applying the “rule of the last antecedent” rather than the “series qualifier” canon of construction to a statute); *id.* at 965 (“This Court has long acknowledged that structural or contextual evidence may ‘rebut the last antecedent inference.’... [T]his Court declined to apply the rule of the last antecedent where ‘[n]o reason appears why’ a modifying clause is not ‘applicable as much to the first and other words as to the last’ and where ‘special reasons exist for so construing the clause in question.’... [T]his Court declined to apply the rule of the last antecedent where ‘there is no reason consistent with any discernable purpose of the statute to apply’ the limiting phrase to the last antecedent alone.... Likewise ... the Court suggested that the rule would not be appropriate where the ‘modifying clause appear[s] ... at the end of a single, integrated list.’”) (quoting *Jama v. Immigration and Customs Enforcement*, 543 U.S. 335, 345, 344 n.4 (2005), *Porto Rico Railway, Light & Power Co. v. Mor*, 253 U.S. 345 348 (1920), and *United States v.*

a series modifier in 1793 implied the exclusion of fine arts and objects whose purpose and creative advance was ornamental, by employing that most important of interpretive tools, “*expressio unius est exclusio alterius*.”⁵⁵ (This created (much later) a perceived need in some legislators for some *other* enactment (as described earlier) to cover designs that were not then protected by copyright as “writings” of “authors,” the political economy of which again has been capably described by Professor Menell and Ms. Corren and by Professors DuMont and Janis.⁵⁶) Although, the 1836 Patent Act restored “discovered or,” it otherwise preserved the categories in the 1793 Act.⁵⁷ That brings us back to the design patent history and its categories.

In 1842, when Congress created protection for designs, it chose the various categories described above, but included the category of “a manufacture” preceded by “new and original design for,” as well as the category of “any article of manufacture,” preceded alternately by “any new and original impression to be place on,” “any new and useful pattern ... or otherwise fixed on,” or “any new and original shape or configuration of...”⁵⁸ It is unclear why Congress adopted the differing terminology of “manufacture” and “article of manufacture,” although it may have been to distinguish designs that applied to an entire category of manufactures from designs applying to particular instantiations (embodiments) of a manufacture (a particular “article”). Or perhaps it was just a function of bad drafting. But there is no indication that anything significant was meant by adding “article of” to “manufacture” that would distinguish these categories, and also no indication that the term “useful” as applied to patterns was meant to mean anything other than a referent to the *functional* utility of the *object* for which pattern (as ornamentation) was the protectable feature of the object (as patent law already protected the useful functions, subject to the much more developed standards for inventions).⁵⁹ Being functionally “useful” thus was a necessary *inherent* character of an “article of manufacture,” or of an “art, machine, manufacture, or composition of matter,” to which the patent law

Bass, 404 U.S. 336, 341 (1971)). In the current context, the last shall be first.... MATTHEW 20:16 (King James version).

55. *See, e.g.*, *Barnhart v. Peabody Coal Co.*, 537 U.S. 149, 168 (2003) (“As we have held repeatedly, the canon *expressio unius est exclusio alterius* does not apply to every statutory listing or grouping; it has force only when the items expressed are members of an ‘associated group or series,’ justifying the inference that items not mentioned were excluded by deliberate choice, not inadvertence.”). Further to Benjamin Kaplan... *See supra* note _.

56. *See* Menell & Corren, *supra* note 2, at __; DuMont & Janis, *supra* note 1, at __.

57. Act of July 4, 1836, ch. 357, § 6, 5 Stat 117, 119.

58. Act of Aug. 29, 1842, ch. 263, sec. 3, 5 Stat. 543, 543-44.

59. *See, e.g.*, Menell & Corren, *supra* note 2, at __; DuMont & Janis, *supra* note 1, at __.

(both for designs and inventions) applied.⁶⁰ (Again, the various subcategories of statutes are notable for their – debatable – departure from that inherent characteristic.⁶¹)

The 1861 Patent Act did not change the “new and useful” before “patterns”, etc. for “articles of manufacture.”⁶² In 1870, when Congress substantially revised the Patent Act, including addressing designs, it essentially kept the same prior eligible category terminology both for inventions and for designs, although it kept “useful” between “new” and “original shape or configuration of any” before “article of manufacture.”⁶³ The 1887 Patent Act adopted a particular damages remedy for infringement for “articles of manufacture,”⁶⁴ but without any suggestion of a change to the meaning of “article of manufacture.”⁶⁵ And, as described by Professor Menell and Ms. Corren, the continued inclusion of “useful” before only one of the categories of attributes for “articles of manufacture” created much judicial confusion, eventually leading to removal of the modifiers “new, useful, and original” before “shape or configuration of an article of manufacture” in favor of “new, original, and ornamental designs for an” before “article of manufacture” in 1902.⁶⁶

Given this legislative history, one would have thought that limiting design protection in 1902 to designs for “articles of manufacture” would necessarily exclude designs for “machines,” as much as it would exclude designs for a “composition of matter” or a “processes” (if one could create an intangible design), even if both are “manufactured” in the sense of not occurring in nature but by the hands of man (or by *manus*).⁶⁷ But again, the problem of

60. See, e.g., Menell & Corren, *supra* note 2, at ___; DuMont & Janis, *supra* note 1, at ___. Cf. Avia Group Intern., Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563 (Fed. Cir. 1988) (“a distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Were that not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture”).

61. See *supra* note __ and accompanying text.

62. Act of Mar. 2, 1861, ch. 88, sec. 11, 12 Stat. 246, 248. The 1861 Act appears to have typographical errors, eliminating “f” and adding a comma before “any manufacture,” and eliminating “any” before “original design” in regard to the various kinds of statutes, while also removing the category of particular kinds of fabrics in favor of the generic “material.” *Id.*

63. Act of July 8, 1870, ch. 230, §§ 24, 71, 16 Stat. 198, ___, ___.

64. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387.

65. See Menell & Corren, *supra* note 2, at ___; DuMont & Janis, *supra* note 1, at ___.

66. Act of May 9, 1902, ch. 783, sec. 4929, 32 Stat. 193.

67. . Cf. *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (“the 1952 Act inform[s] us that Congress intended statutory subject matter to ‘include anything under the sun that is made by man’”) (citation omitted).

providing statutorily unauthorized protection where judges think it is warranted got in the way. Most of this story of judicial vacillation over distinguishing manufactures from machines, and of treating parts of machines as manufactures under the design patent act rather than as things that simply were not covered (recall Benjamin Kaplan) has already been told by Professor Burstein and by myself elsewhere.⁶⁸

Here, I wish to note three important logical inferences from the statute, which the history created by these judges has ignored. First, providing protection for parts of machines as “article of manufacture” fails to comport with the careful delineation of the terms of object for utility patent protection as separate categories, on the assumption that “article of manufacture” has the same meaning as “manufacture.” (Recall *expressio unius*, as well as the canons of statutory construction that Congress is aware of other provisions of the same law, as well as that use of the same terms in the same statute is meant to have the same meaning.⁶⁹) Congress was obviously aware of the utility patent enumeration throughout the history of design patent law, when ultimately settling in 1902 on “article of manufacture.” So *wholes or parts* of machines simply should be outside of the protection afforded by the Act, by *expressio unius* (even if the parts are separately produced; I’ll return to this later). Second, even if *parts* of machines were to be included in design patent protection, nothing would thereby suggest that *fragments* of such “article of manufacture” machine parts (as subparts of parts of machines) should therefore be objects of protectable subject matter for designs. And the reason for this is that the Court in *Gorham Manufacturing Company* was quite right when it said that a design is something that is understood as a whole.⁷⁰ Third, and perhaps most importantly, nothing in that history should (although it may) suggest that the class of objects to be protected when they also embodied designs were to be non-functional by themselves, permitting protection based on the fact that they may have been separately produced and then assembled into a functional whole (as parts of an article of manufacture intended to function by themselves or as subparts of parts of machines that then were further assembled into machines).

Nevertheless, as both Professor Menell and Ms. Corren and as Professor Burstin have traced, the Patent Office and the courts expanded protection by treating “articles of manufacture” to include separately manufactured or

68. See Burstein, *supra* note 1, at ___-___; Sarnoff, *supra* note 1, at ___-___.

69. See, e.g., [REDACTED].

70. See *Gorham Mfg. Co. v. White*, 81 U.S. 511, 530 (1871) (“though variances in the ornament are discoverable, the question remains, is *the effect of the whole design* substantially the same”) (emphasis added).

separately sold products that were only intended to function in conjunction with other products (whether part of and incorporated into a larger article of manufacture or as part of a machine).⁷¹ I'll return to how Judge Rich provided such protection by permitting partial-design patents shortly, after briefly addressing the other fundamental problem of categorization that the history reveals (as alluded to earlier). And at least by 1890, Professor William Robinson in his magisterial treatise had described the distinction between a machine and a manufacture (or article thereof) as an "instrument . . . when set in motion, of producing, *by its own operation*, certain *predetermined* effects."⁷² In contrast, "[a] manufacture is an instrument created by the exercise of mechanical forces and designed for the production of mechanical effects, *but not capable*, when set in motion, of attaining *by its own operation* to any predetermined result."⁷³

With that categorical understanding, it is important to reiterate how and why this blurring of the lines happened, and to do so I'll repeat the words of Professor Menell and Ms. Corren:

[I]nnattentive *and protectionist* judicial opinions caused the standard to drift far from these holdings and *into direct conflict with the clear language and intent of the 1902 design patent amendments and fundamental, overarching intellectual property law principles* reflected in the Supreme Court's seminal *Baker v. Selden* decision.⁷⁴

Changing our focus from categories of objects to categories of concepts on which patent law is based, with respect to a design and as required by Section 103 (which applies to both designs and inventions) the requirement of "obviousness" is to be determined from the vantage of "the *designer* of ordinary capability who designs articles of the type presented in the application."⁷⁵ Yet, as we have seen, because of erroneous categorical

71. See Menell & Corren, *supra* note 2, at ___; Burstein, *supra* note 1, at ___-___. Cf. Sarnoff, *supra* note 1, at ___-___.

72. See, e.g., I ROBINSON, *supra* note 52, § 173, at 257 (emphasis added). See also *id.*, § 175, at 259 ("A machine differs from all other mechanical instruments in that its rule of action resides within itself.").

73. See, e.g., I ROBINSON, *supra* note 52, § 182, at 269 (emphasis added). See also *id.* at 269-70 ("In this absence of 'principle' or 'modus operandi' lies the distinction between a manufacture and a machine,— the former requiring constant guidance and control of some separate intelligent agent, the latter operating under the direction of that intelligence with which it was endowed by its inventor when he imposed on it its structural law.").

74. Menell & Corren, *supra* note 2, at abstract (emphasis added).

75. *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981) (en banc) (emphasis added).

reasoning tracing to *Gorham Manufacturing Company*, infringement under Section 271 and (at least since *Egyptian Goddess*) novelty under Section 102 are to be determined from the vantage of the “ordinary observer.”⁷⁶ Not only are such perspectives incompatible, particularly as obviousness under Section 103 requires evaluation in light of prior art under Section 102. More importantly for present purposes, the move to the ordinary observer viewpoint tends to provide protection where it would not otherwise exist, and to find infringement where it would not otherwise be found to occur. After all, if both the ordinary observer and the skilled designer are aware of the prior art, it is more likely that the former than the latter will view a departure therefrom (as all things are created from something) as substantial, or at least as a sufficiently significant one, when viewing the design as a whole for the relevant comparisons.⁷⁷

This only highlights the difficulty of conceptual severability in analysis of ornamental designs for functional products. But although that is the focus of Professor Menell and Ms. Corren, it is not mine here. I thus do not provide a detailed explanation of how I think severability analysis in design patent law should be performed (particularly as I don’t think design patents should exist), but confine my target below to protecting only some of the public’s rights that have been taken away by the move to partial (and fragment) designs. That Professor Menell and Corren would seek to provide a better functionality doctrine is to be commended, but again simply does not go nearly far enough. We need to route out illogic and overprotection by their roots, as well as in only a few (admittedly very important) branches. What I will say for now is that, if we are to keep design patents from claiming functional features, conceptual severability is required and that abstraction, filtration, and *reconstruction* are needed to evaluate the novel features of the designs into some kind of a whole, because designs are always understood as a whole in regard to the object of their referent – the article of manufacture.⁷⁸

76. See *supra* notes __ and accompanying text.

77. This is true without regard to whether an ordinary observer could or could not meaningfully follow instructions to focus *only* on the novel features that provide “originality” to an overall design when assessing anticipation, obviousness, or infringement.

78. Cf. *Barofsky v. Gen. Elec. Corp.*, 396 F.2d 340, 343 (9th Cir. 1968) (“To predicate this functional test upon a consideration only of the individual features of the design, Barofsky contends, is ‘to break the fagot stick by stick,’ a process which Justice Holmes condemned in connection with a copyright infringement question.”). Tyler T. Ochoa, *What is a “Useful Article” in Copyright Law After Star Athletica?*, 166 U. Pa. L. Rev. 105, 110 (2017) (“if the allegedly separable feature has any utilitarian aspects, one must repeat the process [of identifying any separately identifiable aesthetic feature and then asking if it can exist separately

The important point to conclude this part of my analysis is simply to reiterate that the idea of treating *differently* the basic scope of protectable *ornamental* subject matter – what the design patent *claims* in regard to a design for an article of manufacture – based on which *particular* validity doctrine is applied should demonstrate just how far off course the 1842 Act (when combined with the 1952 Act’s Section 103) and *Gorbam* have taken us.⁷⁹ And again, the reason for that departure is the unrequited love of private property as a means of inducing innovation (or just of rewarding its creators).⁸⁰

Design as a Whole and the Exacerbation of Functional Protection Through Partial Design Patents

I will not repeat here what I wrote before,⁸¹ but refer the reader to that discussion of how Judge Rich in *Zahn*⁸² created partial design patents, contrary to the Patent Office’s rejection of such protection.⁸³ “[A]s we hold, a design for an article of manufacture may be embodied in less than all of an article of manufacture....”⁸⁴ I will just add three points.

First, Judge Rich was able to reach this conclusion by treating the *inherently* visual claims for the ornamental designs as permissible, when covering only a *portion* of an overall article of manufacture and *its* design. And Judge Rich did so by using another rhetorical trope, the “dotted line,” which is intended to create the fiction of hiding what “thing” the claimed part is a part of.

[T]he board erred in treating the claim as directed to a drill tool and only to the shank portion of a tool the article itself rather than the design for the article. That is the same flaw that persists in [the Patent Office’s guidance,] which speaks of the “designed article” and prohibits dotted lines therein, because, quoting what we said in *Blum*, “There are no portions of a

from utilitarian aspects, in other words physical separability] until one succeeds (or fails) in identifying a feature that does *not* have any utilitarian aspects.”)

79. See *supra* note __ and accompanying text (axiomatic scope equivalency for validity and infringement).

80. For arguably better alternatives than exclusive intellectual property rights for inducing or generating innovation or rewarding creators, see generally, e.g., Joshua D. Sarnoff, *Government Choices in Innovation Funding (with Reference to Climate Change)*, 62 EMORY L.J. 1087 (2013).

81. See Sarnoff, *supra* note 1, at __-__.

82. *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980).

83. *Id.* at 264 (the Board of Appeals and Interferences had rejected the claim for an inseverable portion of the manufactured article, relying upon *In re Blum*, 374 F.2d 974 (C.C.P.A. 1967)).

84. *Id.* at 267.

design which are ‘immaterial’ or ‘not important.’” We did not there speak of a “designed article” but of a design.... An article may well have portions which are immaterial to the design claimed.”⁸⁵

Note how this conflicts with the “design as a whole” approach of *Gorham Manufacturing Co.*, that the ordinary observer views the design *for the article of manufacture* as a whole. So Judge Rich’s approach was just dotty. More importantly, *Gorham’s* holding was binding law that Judge Rich was obligated to follow and to apply faithfully. To quote Judge Rich himself: “This is mutiny. This is heresy. This is illegal.”⁸⁶

Second, allowing partial (and fragment) design patents provides protection of smaller and smaller portions of overall designs for portions of *some* article of manufacture,⁸⁷ presumably based on separate sales or separate production, rather than on whether the “thing” the ornamentation of which is to be considered for protection performs *externally* imposed functions, as described by Professor Robinson.⁸⁸ But under Judge Rich’s approach, it should not matter if the claim were to an *unseverable* portion of a machine, or to a part or to an unseverable portion of a part of a machine, because the rest of the machine could also be dotted out, leaving for design protection the fragment, part, or fragment of a part that is claimed (at least so long as at least one of these things is considered an “article of manufacture,” and in the case of an inseverable portion of a machine Judge Rich no doubt would have called it an article of manufacture anyway). But the irony of this approach is that it clearly identifies the *claimed protection* as the “point of novelty” of the *overall* design, contrary to the later rejection of that approach in *Egyptian Goddess* for the *claimed* design,⁸⁹ given that the point of novelty approach reduced the

85. *Id.* Cf. *Curver Luxemburg SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1341 (Fed. Cir. 2019) (“The Patent Office’s guidelines governing examination procedure make clear that a design patent will not be granted unless the design is applied to an article of manufacture.”).

86. *Atl. Thermoplastic Co. v. Faytex Corp.*, 974 F.2d 1279, 1281 (Fed. Cir. 1992) (en banc) (Rich., J., dissenting from denial of rehearing en banc).

87. *See supra* note __ (Ochoa quote).

88. *See* Burstein, *supra* note 1, at 65 (“It is true that, in 1887, an article of manufacture had to be a ‘product’ in the sense it had to be complete enough to be sold to someone. But that “someone” did not have to be the ultimate or end consumer. It could be another manufacturer or artisan.... An item either was an “article of manufacture” or it was not.... Thus, in 1887, an article of manufacture had to be a vendible item.³⁹⁴ But not all vendible items were articles of manufacture.”) (citations omitted); *supra* notes __-__ and accompanying text. Cf. *id.* at 24 n.142 (“*Zahn* itself did not purport to interpret “article of manufacture,” although some commentators have read it that way.”).

89. *See supra* note __ and accompanying text.

potential for protection of the overall design. Apparently, you can't have it both ways.

Third, and most importantly, because patent protection is provided for parts of larger things, the *infringement right* then expands to cover anything incorporating the infringing design (assuming that it remains a “matter of concern” by being visible once so incorporated,⁹⁰ or even perhaps not if the article of manufacture is to be judged by what is separately sold or produced rather than what is functionally used).⁹¹ As the final part discusses, this then permits a finding of design patent infringement when the *overall* article of manufacture is being repaired to *its* original appearance, without reconstruction, but the part (or fragment) that is being repaired may then be considered “reconstructed” (or simply produced by a third party without authorization) and that conduct is then deemed infringing. It will then come as small comfort to the owner that although his legal conduct has been converted to intellectual property “theft,” the amount of damages may then be limited by apportionment to the part that is then considered the “article of manufacture” as to which he or she has to pay the “total profit.”⁹² In other words, Judge Rich’s approach not only takes away rights of the public, it turns the public into the butt of the rhetorical joke that the public are the thieves of *others’* property, when Congress never contemplated as much but rather defined total profits in regard to *total* articles. How “warped” and “frustrated”⁹³ is that?

Partial Design Patents as Theft of the Public’s Right of Repair

90. *See, e.g.,* In re Stevens, 173 F.2d 1015, 1016 (C.C.P.A. 1949) (“Articles which are concealed or obscure[d] are not proper subjects for design patents, since their appearance cannot be a matter of concern.”).

91. *But see* In re Webb, 916 F.2d 1553, 1557 (Fed. Cir. 1990) (“Our predecessor court has affirmed the rejection of design applications that cannot be perceived *in their normal and intended uses.*”) (emphasis added).

92. 35 U.S.C. 289. Note the similarity to the problem in the utility patent context of determining the damages of a claim to an automobile containing a nonobvious windshield wiper, which is the only point of novelty. A claim to the wiper would base damages on the infringing wiper. But the claim to the car containing the wiper would base damages on the infringing car, without any larger inventive contribution by the inventor to the public than the wiper. [Cite Merges & Duffy?] Avoiding such an unjust result of owing damages based on an infringing car rather than on an infringing wiper requires conceptual severability of the utility patent claim, which just “isn’t done.”

93. *It’s a Wonderful Life* (Frank Capra dir. 1946).

I will not repeat here what I wrote before,⁹⁴ but refer the reader to my discussion of how, under *Aro Manufacturing Co. v. Convertible Top Replacement Co. (Aro I)*,⁹⁵ purchasers have the right in patent law to repair legally purchased automobiles (and other machines and manufactures), so long as they do not “reconstruct” those products as a whole.⁹⁶ The repair doctrine finds its source in the patent exhaustion doctrine. What is clear is that if an automobile is a machine (and it is), then it should not be the subject of a design patent unless and until Congress legislates protection of ornamental designs for “machines.” And as Professor Burstein and I have discussed previously, and as noted above, the vacuum of legislative protection led the court to permit parts of machines to be treated as “articles of manufacture” by focusing on separate sale or production rather than use. But *Zahn* then permits ever-smaller components of machines (or articles of manufacture) to themselves be treated as “articles of manufacture” (and fragments to be protected even if not separately sold or produced), which then prevents the reconstruction doctrine from treating the denominator of the fraction being repaired in order to restore the original ornamental appearance to be ever smaller. As the denominator is ever smaller, the portion needing repair (or replacement by what would otherwise be a design-unprotected part) then is held to be “reconstructed” (or originally “made”) and an act of infringement under Section 271. Again, *Zahn* makes the ordinary consumer into a thief, when exercising what would otherwise be their right to repair the products that they have legally purchased. Instead, as I argued before, design patent law should treat as an “article of manufacture” only a product that is functional by itself.⁹⁷

94. See Sarnoff, *supra* note 1, at ___-___. My focus in supporting legislation to assure protection *only* in regard to automobiles was a nod to political reality. Automobiles are the second-most valuable purchase of most households, the product that is most likely to need repairs for designs, and consequently created the only truly significant market for “after-market” repair parts. Of course, if we ban the private automobile and require mass transit, saving countless lives and forcing the rich and the poor to actually interact, not only might our society be better off as a political matter but that aftermarket will no longer be needed. Nevertheless, protection of repair rights would still be needed for other products, even if we are unlikely to care if, e.g., our washing machine still works after being dented beyond recognition by our favorite pet. Americans just do love their cars and how they look....

95. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336 (1961).

96. *Id.* at 346.

97. Of course, difficult line drawing will be needed to distinguish products that are intended to perform functions by themselves and should be treated as articles of manufacture (such as a mirror, even if it can be incorporated into a larger product) from articles that are intended to perform their functions only in regard to incorporation into a larger article of manufacture or a machine (which should not be considered functional by themselves, even if

I won't say anything here about the bad environmental consequences of such a legal rule. (Whoops, I just did.) Nor will I discuss that the patent holder has already received the "full" reward to which they are entitled through the purchase price on the product embodying the patented design (or invention).⁹⁸ (Whoops, I did it again.) Rather, I want to focus on two points that relate to the problem of category errors and patent versus non-patent protection for designs.

First, and again, we would not have this particular set of problems were it not for the confusion created by placing design protection in patent law. We would not then be trying to figure out what the "article of manufacture" is for a design, and if we were to adopt sui generis protection for designs for useful products we could then clearly specify that the protected object for which the design (and the design's scope) is to be determined is a functional object and that both that object and the design are to be determined "as a whole." (Of course, a similar problem would then arise if we protected designs with copyrights, but at least in Europe countries remain free to legislate sui generis protections and to assure consumer protections for repair rights – including the ability of third parties to produce repair parts and services so that consumers may obtain them -- and thus the public is not treated as an infringer when repairing damaged parts without reconstructing their entire purchased products.⁹⁹) Eliminating partial-design patent protection thus would avoid taking away the public's rights to repair purchased products and to obtain parts to do so, without reconstruction of the product as a whole, when designs are only part of the functional products that a consumer (or business entity) purchases. But the public will continue to be prohibited from reconstruction of the whole, and third parties from unauthorized making, of the entirety of such purchased products (or of enough of them as to constitute a reconstruction). That seems to strike a fair balance, and to be sufficiently protective of design innovation incentives for society, just as much as it was back in 1850 when *Wilson v. Simpson*¹⁰⁰ first creating the repair "right" for patented products.

one can use a car mirror to shave with). But such line drawing can't be any worse than what we already do with utility subject matter and claims under Section 101. 35 U.S.C. § 101.

98. See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 497 (1964) (*Aro II*) (plurality opinion) ("an agreement authorizing use of the patented product necessarily also authorized repairs to it; 'so far as the use of it was concerned, the patentee had received his consideration, and it was no longer within the monopoly of the patent.'") (quoting *Adams v. Burke*, 84 U.S. (17 Wall.) 435, 456 (1873)).

99. [cite EU Repair Directive].

100. *Wilson v. Simpson*, 50 U.S. (9 How.) 109, 123 (1850).

Second, it is important to note that the Supreme Court's recent *Impression Products* decision made exhaustion, and thus repair rights, a matter *federal patent law policy*. Thus, the consumer repair right is not (and probably should never have been viewed as) a matter of a defeasible, default presumptive (implied) license against which explicit contracts for the purchase of patented products were to be written, and which rights might then be "voluntarily" waived in purchase contracts.¹⁰¹ Accordingly, contractual restrictions on federal patent law repair rights should be considered *preempted* by the Supremacy Clause of the U.S. Constitution,¹⁰² as contrary to and as conflicting with the "purposes and objectives" of federal (patent) policy¹⁰³ as articulated in *Aro I* and in *Impression Products*. And nothing in the Supreme Court's dicta regarding the ability to enforce prohibitions against repair under

101. See *Impression Products*, 137 S.Ct. at 1532-33 ("This Court accordingly has long held that, even when a patentee sells an item under an express [contractual] restriction, the patentee does not retain patent rights in that product."). Nevertheless, I agree with Professor O'Connor that exhaustion *originated* as a doctrine of implied license, which *could* be defeated by express language in contracts, which are creatures of state law (even though federal common law of contracts for patented goods would make much more sense). See O'Connor, *supra* note __, at __. But we are no longer (if we ever were) living in a Constitutional world of contractual protections *uber alles* (or even *uber mostes*). Compare, e.g., *Lochner v. City of New York*, 198 U.S. 45, __ (1905) (finding a state labor protection law to be an arbitrary exercise of police power in violation of the Contracts Clause of U.S. CONST., Art. I, § 10, cl. 1, as incorporated through Amend XIV, § 1), with *Stone v. Mississippi*, 101 U.S. (11 Otto) 814, 819-21 (1879) ("No legislature can bargain away the public health or the public morals. The people themselves cannot do it, much less their servants.... The contracts which the Constitution protects are those that relate to property rights, not governmental.... Certainly the right to suppress them is governmental, to be exercised at all times by those in power, at their discretion."). But cf. *Home Bldg. & Loan Assn. v. Blaisdell*, 290 U.S. 398, 449(1934) (Sutherland, J., dissenting) ("If the contract impairment clause, when framed and adopted, meant that the terms of a contract for the payment of money could not be altered in invitum by a state statute enacted for the relief of hardly pressed debtors to the end and with the effect of postponing payment or enforcement during and because of an economic or financial emergency, it is but to state the obvious to say that it means the same now."). See generally Stephen A. Siegel, *Understanding the Nineteenth Century Contract Clause: The Role of the Property-Privilege Distinction and Takings Clause Jurisprudence*, 60 S. CAL. L. REV. 1 (1986). And at least since *Aro I*, we properly consider the public as having the "right" to repair their legally purchased, patented products, without having to give up that right by contract (even if they would be willing to do so in exchange for a lower price, or are compelled to do so as the quid pro quo for obtaining the product because the seller will not sell except on those conditions). As *federal* patent rights of repair effectuating federal patent policy, any such state law-based *contractual* provisions purporting to restrict repair rights of purchasers through *contract* remedies should now be treated as preempted, just as much as such contractual "rights" to restrict consumer repair rights through *patent* remedies simply do not exist.

102. U.S. CONST., art. VI, para. 2.

103. *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941) (state law that "stands as an obstacle to accomplishment and execution of the *full* purposes and objectives" of federal law is preempted) (emphasis added).

contract law,¹⁰⁴ and to preserve restrictions on *licensees* in regard to making and sale authority (but apparently not use, which might then imply that the license was actually a restriction-prohibited sale),¹⁰⁵ should be viewed as to the contrary. At a bare minimum, the Patent Act should not be understood to preempt any state *laws* that would *prohibit* contractual or licensing restrictions that would prevent legitimate purchasers from making repairs, on the misguided belief that such state laws conflict with the *infringement* rights that patent law protects (and to prevent state law from diminishing the value of the patent rights that create exclusive suppliers¹⁰⁶). State laws protecting federal repair rights do not create a “theft” of those *purported* infringement rights to prohibit repairs, even if such a restriction on the value of any contractual restrictions thereby prohibited would not amount to a compensable regulatory taking.¹⁰⁷ Rather, once we recognize that a federal patent policy exists to protect repair rights, states should be free to prohibit contracting to the contrary. In that way, states will effectuate federal patent policy, rather than undermine it.

Conclusion

It is long past time to legislate protection from design patent infringement for both purchasers of and aftermarket manufacturers of automobile repair

104. See *Impression Products*, 137 S.Ct. at 1535 (“The purchasers might not comply with the restriction, but the only recourse for the licensee is through contract law, just as if the patentee itself sold the item with a restriction.”).

105. See *id.* at 1534 “[The Federal Circuit reasoned that [i]f patentees can employ licenses to impose post-sale restrictions on purchasers that are enforceable through infringement suits ... it would make little sense to prevent patentees from doing so when they sell directly to consumers. The Federal Circuit’s concern is misplaced.... A patentee can impose restrictions on licensees because a license does not implicate the same concerns about restraints on alienation as a sale. A patentee’s authority to limit *licensees* does not, as the Federal Circuit thought, mean that patentees can use licenses to impose post-sale restrictions on *purchasers* that are enforceable through the patent laws.” (emphasis added); *id.* at 1535 (“Once a patentee decides to sell—whether on its own or through a licensee—that sale exhausts its patent rights, regardless of any post-sale restrictions the patentee purports to impose, either directly or through a license.”) (emphasis added). Note that treating any contractual authorization for use as a sale rather than as a license (or lease) avoids the potential for creating a “post-sale” culture, intended by the seller to avoid giving the public any purchaser rights to which the public would otherwise be entitled. Cf. AARON PERZANOWSKI & JASON SCHULTZ, *THE END OF OWNERSHIP* (MIT Press 2016).

106. See, e.g., Promoting Automotive Repair, Trade, and Sales Act, S. 812, 115th Congress, ___ Sess. (2017) (“PARTS Act”); Promoting Automotive Repair, Trade, and Sales Act, H.R. 1879, 115th Congress, ___ Sess. (2017) (same).

107. Cf. Siegel, *supra* note ___, at ___ (discussing limits on takings by sovereign overriding of contract rights).

parts.¹⁰⁸ But it is also long past time to boldly go where no Congress has gone before, by correcting the mistakes of the past and removing designs from patent law and placing them in a sui generis regime (given the overextension of copyright duration and protections). Perhaps such a result would *not* make Judge Rich roll over in his grave. After all, he bemoaned keeping designs within patent law, and worked hard to remove designs to copyright law.¹⁰⁹ And even if he would not get his wish to place design protection in copyright law, at least he would no longer suffer indigestion at having to stomach nonobviousness of designs being determined from the perspective of the designer of ordinary skill in the (design) art. He thus could have had the last laugh that *Nalbandian* would have been legislated off the books....

Given the propensity of Congress and the courts to create and protect private property out of the public's right to copy or to independently make use of intangible designs, I do not expect such changes to happen in my lifetime. But I'm in the game for the long haul. Until then perhaps Professor Menell's and Ms. Corren's fine contribution will at least induce Congress or the courts to clean up functionality doctrine (and apportionment of total profits), as much as can be done within the constraints of a patent system that should have nothing to do with designs but has been forced to live with them. At least, unless we can convince the Supreme Court that such category blurring, creating property rights that protect private designers at the expense of the public, is unconstitutional under the Authors and Inventors (not Designers) Clause.¹¹⁰

108. *Cf.* *Biotechnology Indus. Org. v. D.C.*, 496 F.3d 1362, 1372-74 (Fed. Cir. 2007) ("The plaintiffs urge that the Act conflicts with Congress's intention to provide their members and other pharmaceutical patent holders with the pecuniary reward that follows from the right to exclude granted by a patent.... Of course, the patent laws are not intended merely to shift wealth from the public to inventors.... The Act is a clear attempt to restrain those excessive prices, in effect diminishing the reward to patentees in order to provide greater benefit to District drug consumers. This may be a worthy undertaking on the part of the District government, but it is contrary to the goals established by Congress in the patent laws.").

109. *See supra* note ___ and accompanying text; *In re Nalbandian*, 661 F.2d 1214, ___ (C.C.P.A. 1981) (en banc) (Rich, J., concurring) (discussing his 1952 Act and subsequent legislative efforts).

110. U.S. CONST., Art. I, § 8, cl. 8.