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Article

THE CHALLENGE OF PROTECTING INDUSTRIAL DESIGN IN A GLOBAL ECONOMY

Susanna Monseau*

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***496 Introduction**

Empirical research tells us that "[d]esign-led companies have produced dramatically better share-price performance for their investors."[1] Outside the U.S., there is starting to be an appreciation of the importance of design to the economy with a variety of scholarly articles and government reports noting the link between economic performance and good design.[2] "There is little doubt that design is a vital ***497** component for economic prosperity."[3] In the U.S., in contrast to all European and the majority of other countries around the world, the legal system provides no specific protection for market entry design.[4] A few, very innovative, designs may qualify for patent protection, trademarks can sometimes be used to protect the shape of a design that has acquired secondary meaning, and--under certain conditions--the creative portions of a design, if separable from its functional aspects, may qualify for copyright protection, but there is no legal protection for design per se.[5] Critics have suggested that the U.S. system is hostile to design innovation and that this is one of the reasons why American companies have often ceded innovation, and relinquished customers, to better European-designed products.[6] Part of this hostility to design is seen in the legal system's lack of recognition of design as worthy of protection on its own merits.

In the U.S., the lack of legal protection for market-entry design does not stem from the fact that Congress has never considered providing legal protection for design. There have been numerous attempts over the years to pass a design law.[7] Most recently, fashion designers have taken up the cause, claiming that fashion design piracy has become a "blight that affects all who depend on the U.S. fashion industry."[8] The Council of Fashion Designers of America (CFDA) has lobbied actively for several years now for the passage of U.S. legislation that would provide a copyright-like protection for fashion designs.[9] Fashion designers argue that such legislation is essential to protect their industry from rampant copying.[10] However, thus far fashion designers have not enjoyed any more success than earlier designers ***498** in securing legal protection for their designs.[11] Most recently, on July 15, 2011, the Subcommittee on Intellectual Property, Competition and the Internet held a hearing on the newly reintroduced IDPPPA.[12]

This paper discusses the growing importance of industrial design to the global economy and reviews the development of legal protection for industrial design since the early twentieth century in order to put forward three arguments. First, the rise in counterfeiting and design piracy is detrimental to both designers and consumers and requires a legislative response from Congress. Second, a review of international design laws shows some clear areas of agreement emerging in international agreements on the legal principles that should govern the protection of industrial design. Third, a U.S. design protection law can be constructed in the way that will fit comfortably within existing U.S. legal principles and be consistent with the obligations of the U.S. under international design laws.

Part I of the paper evaluates the growing evidence of the importance of industrial design to the global economy. It identifies counterfeiting as the greatest threat for innovative design-intensive industries, which leads to the argument that to provide protection for designers against counterfeiters there is a need for short-term legal protection from copying. Part II focuses on the history and development of the various concepts underpinning legal protections for industrial design. It briefly traces the chronology of international efforts to define and protect industrial design and considers in more depth the relatively recent EU attempts to harmonize design laws in Europe, especially the adoption of the unregistered design right. It demonstrates

that there is, in fact, a slowly developing international consensus on several aspects of legal protection for industrial design. Part III explores the unsatisfactory and piecemeal manner in which protection for industrial design is currently provided by U.S. law. It explains the shortcomings of each type of legal protection and briefly addresses some of the problems with the fashion lobby's various fashion design law proposals. Part IV of the article proposes that the U.S. provide an unregistered limited protection against copying for all market-entry industrial design following the principles of protection found in international law, and especially in key aspects of the European unregistered design right. The paper argues that this new law would benefit society, consumers and designers.

I. Industrial Design

A. What is Industrial Design?

Industrial design as a term originated in the early 20th Century with German architect Peter Behrens, credited as being the first industrial designer.[13] The Patent ***499** Office first used the term industrial designer in 1913.[14] "A design is hard to define but is easily described."[15] According to the International Council of Societies of Industrial Design (ICSID) "[d]esign is a creative activity whose aim is to establish the multi-faceted qualities of objects, processes, services and their systems in whole life cycles."[16] More simply, design is about "shaping products . . . to serve [people's] needs."[17] In this article I will refer to the people who shape products in this way as designers, with industrial designers as those who shape all types of mass-produced products.

Before the First World War, manufacturers paid less attention to manipulating the look of a product to attract consumers and more to developing its functional aspects and enhancing its performance.[18] French-born, Raymond Loewy, a fashion illustrator by training, was one of the first people to convince American manufacturers that the appearance of their products mattered; by the transformation of various products, he was able to show that changes to the outward appearance could result in products that were easier to manufacture, cheaper to produce, and more pleasurable to use.[19]

B. Industrial Design and Legal Protection

Traditionally, systems of intellectual property protection recognize a split between the different types of protection provided to different creative endeavors.[20] In the simplest terms, patents protect innovation whereas copyright protects creative expression. This divisive view of the major intellectual property rights has been criticized.[21] The criticism is especially valid for design. A 2005 Report on creativity in Britain for the U.K. government described design as the process that ***500** "links creativity and innovation."[22] This definition helps explain why the underpinnings of legal protection for industrial design are so complicated.

As an industrial process that concerns the creativity and the aesthetics of utilitarian objects, industrial design is particularly hard to categorize under either a patent or copyright scheme of protection. Whether design is primarily about aesthetics, technical function, or both, causes dispute even among industrial designers themselves.[23] The design of an object can also be used by the designer to indicate a particular source of manufacture, traditionally the subject of yet another intellectual property regiment, trademark protection. The design of iPod® and Coke® bottles both illustrate this use of design.

In the U.S., design is primarily protected as a sub-category of patent law.[24] However, because of the high standard of novelty required to obtain a design patent, the majority of new market-entry designs are not protected by the U.S. legal system. In most other legal regimes, design is now treated as a species of copyright and provided with a limited copyright-like protection.[25] Over time, the positions taken by some countries on how and what industrial design to protect have shifted.[26] Despite the lack of international consensus on the type and standards of protection most suited for design, some commonalities in approach are developing which, it is argued later in this paper, could be used to inform a clearer and more conceptually consistent protection for market-entry industrial design under U.S. law.[27]

Apart from the question of where designs fits on the patent, copyright, and trademark paradigm,[28] legal systems have also struggled with several other important questions concerning the protection of designs. These include the standard of creativity required for a design to be protected, whether both the functional and artistic features of a design deserve protection, and where the legal protection for industrial design should intersect with the protection provided to fine art and other ***501** artistic works by copyright law. These questions will be developed and addressed in Part II.

C. The Importance of Industrial Design and the Global Economy

1. Industrial Design and Modern Consumer Culture

Design is becoming increasingly important in modern life.[29] It is no accident that the top global companies are also design leaders in their respective fields.[30] In the crowded modern consumer culture, "[d]esign is the only thing that differentiates one product from another in the marketplace."[31]

Industrial design allows a company to distinguish its goods and services from the competition in an interconnected global market where many different products constantly compete for the consumers' attention. There is strong evidence that good design can achieve goals as varied as improving health, creating environmental benefits and even affecting the results of elections.[32]

Designers are now employed in virtually every industry to create "eye-appeal" for products and to differentiate between the many products in a crowded market to attract consumers. One only has to consider the success of design icons like the iPod® and related products to conclude that the process of design is important in selling products. There are other MP3 players on the market, yet the iPod® continues to be a top seller, at least in part because of its eye-pleasing and functional design. Good, well-constructed design benefits consumers by making products aesthetically pleasing and often of higher quality.[33] The economic argument in favor of a company expending resources on design is that market efficiency is increased when design improvement sparks competition between manufacturers of goods.[34]

In a consumer society where the consumption of goods is no longer based on necessity alone, but on a whole host of sociological and psychological factors,[35] design provides many less-quantifiable benefits to both the consumer and the market as a whole. Designs allow a consumer to differentiate himself from others in his design choices. The design not only serves as a communicator of the objective attributes of the product (what it can do), but it also communicates information like cultural values (e.g., taste, style), and even social values (e.g. environmentally sustainable ***502** design). In addition to providing these indicators of choice to consumers, the attributes of design allow producers to segment the market and potentially increase profits.[36] Automobiles, for example, are primarily useful objects to move people and their possessions, but they tend to have significance and meaning imputed to them which goes far beyond their utility. Cars act as a symbol of their owner's lifestyle and aspirations.[37] These are all reasons for providing legal protection to encourage the investment required to create good industrial design.

2. The Link between Industrial Design and Global Competitiveness

According to a variety of studies, "[d]esign is increasingly being recognized as important for national competiveness" in the global economy.[38] Certainly governments, particularly in Europe and Asia,[39] as well as some corporations,[40] are becoming considerably more aware of the effects of design on market performance. Although comparable data on national design industries are relatively hard to collect, thus making reliable comparisons between nations difficult, several studies have linked business success to the use of design.[41] Design can create new markets, providing consumers with something they did not know was missing, from ring tones to medical devices.[42] Companies like GE and P&G are trying to transform their processes so that design-led innovation helps them create new products and new markets.[43]

In a study by the U.K. Design Council, companies that were "effective users of design" outperformed the U.K. stock market (FTSE 500 index) by more than 200% between 1994 and 2004.[44] The study selected companies for inclusion in the "design portfolio" primarily on the basis of their being nominated for and winning design-related awards.[45] The study concluded that companies which focused on product design not only substantially outperformed their competitors during good economic times, they also fared significantly better during economic downturns and recovered market share more quickly.[46] A U.S. study published in 2005 confirmed ***503** that "good industrial design is related to corporate financial performance and stock market performance even after considering expenditures on industrial design".[47] In other words, design pays for itself.

Some critics have suggested that the hostility of the U.S. legal environment to protecting design innovation explains why American companies like GM have focused comparatively little on design.[48] U.S. car companies have lost market share to car companies from Germany and Japan because, although American automakers employ designers to style the outward appearance of their cars, they do not pay the same close attention as German and Japanese manufacturers to a holistic notion

of design and product quality.[49] BMW understands the importance of design. A representative of that company has described its automobiles not as cars but as "moving works of art that express the driver's love of quality."[50]

3. Government Policy and Design

The effect of government policy on industrial design has not been lost on newly industrialized countries. These countries--particularly those in Asia-- which have long competed globally on the basis of low cost manufacturing, have started to compete with the advanced industrialized nations increasingly on the basis of design and innovation.[51] "China, for example, is putting a huge amount of effort and resources into building an indigenous design capability."[52] At the 2008 International Design Excellence Awards (IDEA) for the best global designs, although the U.S. came in first overall in number of awards, its lead was narrowed; designers from South Korea, China, Europe and Latin America all increased their shares.[53] South Korea was also highlighted by the U.K. Treasury's Cox Review as a nation whose government has determined to increase its competitiveness in industrial design by aggressively committing resources towards establishing the country as a design hub within East Asia.[54] As if to confirm this commitment, at the 2009 IDEA awards Samsung Electronic (a Korean company) was the top corporate winner of design awards--ousting Apple from that position.[55] The IDEA awards for 2010 ***504** and 2011 show many design schools, companies, and consultants from outside the U.S. winning increasing numbers of awards.[56]

In Europe, governments have had design policies for decades.[57] European countries have endeavored, by various means and with varying degrees of success, to promote design and emphasize its economic and cultural role in modern society.[58] These governments have become particularly concerned recently about the impact of competition from the newly industrializing countries in the area of creativity and innovation (which are viewed as traditional areas of European strength) and various reports have suggested solutions to assist European businesses in improving their design capabilities to become more competitive globally.[59] Even in the U.S., which has never had a specific design policy or a focus on design as a competitive strength in the global economy,[60] the private sector clearly recognizes the importance of branding and the design services sector to the economy.[61] This is a particularly important lesson for European and American firms which cannot compete with the labor costs of their Asian rivals.

4. Current U.S. Focus on Protecting Fashion Design

This article looks beyond the current narrow focus, in the U.S. at least, of lobbyists, legislators, and academics on the legal protection of fashion design. It concurs with the fashion design lobby that U.S. law has significant shortcomings when it comes to the protection of design, but it does not agree with the fashion lobbyists' limited suggestions for fixing the problem. The U.S. legal regime on design already lacks coherence and clarity. Additionally, the fashion proposals are examples of self-interested legislation which, while they may benefit some members of the fashion industry, will do nothing to ensure the law balances the needs of industrial designers and their customers.

The author believes that useful lessons could be learned from the treatment of design protection in international treaties like the World Trade Organization's Trade Related Aspects of Intellectual Property Agreement[62] and other efforts to ***505** harmonize laws on design, such as the European Union's recent experience with its member states' industrial design laws.[63]

An analysis of the development of industrial design protection internationally will demonstrate that Congress should not focus on protecting a single industry--such as fashion--from design copying; rather, it should create a coherent, unified approach to the protection of all industrial design. Discussing the lack of legal protections for industrial designs, Register Fischer of the U.S. Copyright Office stated prophetically over fifty years ago, "if nothing is done the problem will increase in complexity . . . the matter has become so urgent that we should deal with it promptly before we find vested interests in different industries involved . . . ."[64]

The discussion concerning whether fashion design merits special legal protection has generated a vast amount of debate among legal scholars in recent years.[65] On the one hand, there are arguments that the industry shows little sign of blight,[66] and has thrived, at least in part, because of the lack of legal protections, or "low-IP equilibrium."[67] On the other hand are the arguments that the new technologies of copying and the effects of various other changes in the fashion business mean that the original designers are being denied the economic fruits of their creative labors.[68]

***506** Another group of scholars has concentrated on the protection of industrial design, or applied art, generally under American law.[69] Orit Fischmann Afori argues that industrial design enhances market efficiency[70] and is under-protected by

U.S. law.[71] Design law has certainly been updated much less frequently than other areas of intellectual property law, following a cyclical pattern without undertaking any significant change since the 1950s.[72] Various legal scholars have argued that the piecemeal legal protection for design under U.S. law has significant shortcomings.[73] This paper focuses on explaining the changing dynamics of industrial design to argue that all market-entry industrial design should have a limited protection under U.S. law.

D. The Problem is Counterfeiting

Commentators have been warning for years that "counterfeiting is endemic" in the field of design.[74] The boost to earnings which companies gain from well-designed products is a lead which is very vulnerable to copying and may be lost to sales of counterfeit goods.[75] Counterfeit activity has actually risen dramatically in recent years.[76] Several government and international reports have recognized that one of the biggest threats to the creativity and innovation advantage that industrial design can provide to a corporation is the increasing ease with which counterfeit goods can be quickly and cheaply produced--often in the newly industrializing countries such as China--and traded all over the world.[77]

***507** The term "counterfeit" is often used in the U.S. to denote goods which infringe the trademark of another; however, the Organisation for Economic Co-operation and Development (OECD) Report on the Economic Impact of Counterfeiting uses the term for a range of activities which infringe trademarks, copyrights, patents and design rights, as well as a bundle of other intellectual property rights.[78] For the purposes of our discussion, the term will be used in the same way as in the OECD Report.

1. Reasons for Rise in Counterfeiting

Counterfeit producers are greatly assisted today by instantaneous global communication and ready access to well-equipped modern factories in China and other newly-industrialized Asian countries.[79] China's rate of increase in R&D is the highest in the world.[80] Its leaders are building China as a high investment, high level of skills, low cost base economy.[81] According to the Design Business Association, "[t]he new economies have fantastic factories but don't know what to make."[82] While IPR protection is improving in China, the command economic model has traditionally placed little importance on legal rights, especially intellectual property protections. These conditions have caused China to become the largest single source economy for counterfeit goods.[83] Asia produces a staggering two-thirds of all counterfeit goods seized in international trade.[84]

In one other indication of the counterfeiting trend and its legal impact, the last few years have seen numerous lawsuits in many jurisdictions against the online marketplace eBay by luxury goods manufacturers (common targets of design piracy). eBay's own estimates, in defending a lawsuit by Tiffany, put the percentage of goods sold on eBay labeled as originals of designer goods which were, in fact, counterfeits, at 30%.[85] All of the lawsuits claimed that eBay had, by its practices, enabled the global counterfeit industry to flourish,[86] and although these lawsuits ***508** have met with widely divergent results,[87] they do illustrate the extent of the global problem of counterfeiting, and the harm it causes to design-intensive industries.

The next section reviews the harms of counterfeiting as described in three recent reports on the topic by the OECD,[88] the Department of Justice Taskforce on Intellectual Property,[89] and European Union Customs.[90]

2. Harms of Counterfeit Goods

a. The OECD Report

A comprehensive study prepared by the OECD, based on data from customs seizures of counterfeit goods in OECD countries, assesses the magnitude and effects of counterfeiting and piracy. It catalogs three types of harm produced by the sale of counterfeits: harms to society as a whole, harms to intellectual property rights holders, and harms to consumers and governments.[91] The report concludes that the effects of piracy are so significant "that they compel strong and sustained action from government, businesses and consumers".[92]

According to the OECD, the socio-economic effects of counterfeiting on society are to decrease innovation, employment, foreign direct investment, and trade and economic growth, while simultaneously increasing criminal activity and harm to the environment.[93] In connection with these harms, the report notes differences in these economy-wide effects in different industrial sectors. The risks for innovators are particularly high, for example, where research and development costs are

high.[94] For some industries, the level of counterfeit activity is relatively important, while for others it is a minor consideration. Foreign direct investment from the U.S., Germany, and Japan has been found to be higher generally in economies with lower rates of counterfeiting, although the report cautions that this analysis is based on a limited dataset.[95] The report notes a similar caution with regard to its finding that the types of product traded between countries are influenced by counterfeiting.[96] While counterfeiting and piracy transfer economic rents to all types of parties engaged in illegal activity, the effects of counterfeiting on the environment are ***509** especially deleterious in industries like the chemical industry where many products can have environmentally damaging consequences.[97]

For rights holders and creators, counterfeit goods have a deleterious effect on sales volume and prices, royalties, brand value and firm reputation, investment and the cost to companies of combating piracy, the scope of operations, and consumer utility.[98] The report notes two types of sales lost to counterfeiters: those lost from consumers who believe that they are purchasing a genuine product, and those lost from consumers who are knowingly purchasing a lower-priced counterfeit.[99] Counterfeits damage the brand image and reputation, particularly where consumers believe they are buying a genuine product.[100] Counterfeits of luxury goods tend to make the goods less desirable.[101] Respondents to the OECD industry survey mentioned instances where "losses in brand value due to piracy had driven companies out of business or reduced their scale of operations".[102]

The OECD Report notes that there are also effects of counterfeiting and piracy on government and consumers which come in the form of lost tax revenues and the cost of anti-counterfeit activities, including responding to public health and safety consequences and corruption.[103] Concerns over health and safety appear frequently in OECD survey responses, particularly in the automotive, food and drink, chemicals, pharmaceuticals and toiletry and household products industries.[104] Counterfeiters have little interest in ensuring quality, safety, or performance of their products.[105]

The OECD initially estimated cross border trade in counterfeit goods at $200 billion, but it recently increased its estimate of the total cost to the world economy of international trade in counterfeit and pirated goods to $250 billion.[106] The report concedes that there is little research and a lack of data on counterfeit activity.[107] The fragmentary nature of the information makes it difficult for "stakeholders to assess the situation in a comprehensive and coherent fashion".[108] More and better ***510** information would help governments and businesses develop more effective practices to combat counterfeiting and piracy.[109]

The OECD surveys found that counterfeit goods were being sold in virtually all regional economies. The sales level of counterfeit goods appeared to be higher in less developed countries with these countries also tending to experience significant sales of more common products like automotive parts, tobacco products, and pharmaceuticals.[110] More developed countries tended to have more problems with sales of counterfeit luxury goods--such as designer clothing and upscale watches.[111] Counterfeit electrical goods, toiletries, and household products appeared in markets worldwide.[112] The report noted that the types of products being counterfeited were numerous and growing and that the counterfeiting of even the most common and lower priced products was increasing in developed countries partly because the liberalization of international trade has enabled the counterfeiters to infiltrate legitimate supply chains and partly due the rise of Internet as a place to sell products.[113]

Media reports of dangerous counterfeit consumer goods like toys, personal care products, medicines, and spare parts reaching the market in developed countries,[114] those with supposedly stronger regulatory systems and strong IP protections and enforcement,[115] have recently focused public attention on the increased threat to public health and safety from counterfeits of common consumer products.[116]

b. Department of Justice Report

The DOJ Report states that the Office of the United States Trade Representative puts the economic costs of what it describes as "intellectual property theft" to American corporations at $250 billion per year.[117] This estimate is higher than the OECD estimate but includes domestic as well as international counterfeit activity. According to the Report, "[i]ntellectual property is America's competitive advantage ***511** in the global economy of the 21st century" ,[118] and the DOJ has made intellectual property enforcement a high priority.[119] The report is mainly focused on the DOJ's achievements in increasing its criminal prosecutions of IP crime.[120]

The DOJ Report unwittingly demonstrates the lack of specific protection for design under U.S. law. As an example, it describes two types of counterfeit goods: those including the imitation of famous trademarks and those involving the imitation of patented drugs.[121] While the report notes that those buying products with counterfeit trademarks may pay more believing the trademark to be genuine, it is far more concerned with the sale of counterfeit drugs which "pose serious risks to

consumers health and safety."[122] The report makes no mention of the other dangers of sales of counterfeit products like the automotive parts, household products, toys and games mentioned in the OECD report, presumably since many of these products would infringe design rights rather than trademarks or patent rights and so are not caught by the DOJ enforcement efforts.

The DOJ Report describes intellectual property rights as being protected by four types of legal protection: patent, trademark, copyrights, and trade secrets.[123] It does not mention design patents or any type of design protection. It is difficult to know how much of the economic cost of design piracy is actually captured by the report's figures on intellectual property theft. Design patents may be included in the patent category, and trademark infringing goods (which are counted) will often necessarily include the copying of a product's design as well as any trademark or other rights, so that it is probable that at least some of the huge economic costs attributed by the DOJ Report to "intellectual property theft" would include losses to designers from the copying of their designs.

The DOJ Report attributes the same main types of direct harm to sales of counterfeit goods as does the OECD. It states that counterfeit goods decrease incentives to create new and innovative products, hurt the economically important, innovative sectors of the economy, as well as threaten public health and safety by persuading consumers to purchase cheaply-produced and sometimes dangerous counterfeits.[124] It also notes that counterfeiting can fund criminal activity and that improvements in technology have increased opportunities for intellectual property theft by making the creation and distribution of counterfeit goods "easier and more ***512** anonymous."[125] After briefly mentioning the harms of counterfeit goods, the majority of the report focuses on the DOJ's efforts to improve intellectual property enforcement and, particularly its efforts in increasing criminal prosecutions of all types of IP crime.[126] It notes some success in prosecuting of sellers of counterfeit luxury goods like handbags, presumably under trademark law.[127]

c. EU Customs Report

The EU customs report's aim is to track customs seizures of counterfeit and pirated goods at EU borders.[128] The customs report does not speculate on the harms produced to the economy by counterfeit activity; rather, it provides details each year of the seizure of goods at EU borders by customs officials. According to the 2008 figures, China continued to be the main source of all counterfeit goods with 54% of the total amount,[129] and the total number of seizures from 2007-2008 of counterfeit goods increased 126%.[130] Counterfeit clothing, CDs, DVDs, and cigarettes continue to head the list of the goods with the greatest number of large seizures.[131] However, seizures of other types of goods--including electronics and personal care goods--are increasing.[132] According to the EU Customs Report, most of these seizures were of trademark infringing goods (only 1.24% of goods seized infringed design rights)[133] but, of course, many goods which infringe a company's trademarks will also copy its product designs in order to deceive the consumer into believing that they are buying a genuine product.

Most design infringements found by EU customs concerned shoes, but other products where designs were infringed included accessories for cell phones, toys, medicine, and tools.[134] Seizures in the toy's category were up 136% on the previous year's figures,[135] demonstrating the increasing problem of counterfeit activity for designers of all industrial products and also the move of counterfeit goods, noted by the OECD report, into common products as well as luxury goods.

Despite the difference in figures, all these recent reports on counterfeiting activity agree that the amount of and the economic costs of counterfeit goods are increasing ***513** at an alarming rate and the effects of sales of counterfeit goods on the world economy is substantial and growing.[136]

To highlight the problem of design counterfeiting in a different way, a German group has been giving awards since 1977 to the most egregious design knock-offs sold in the German market each year.[137] The organizers of the Plagiarus Awards hope that the media coverage surrounding receipt of an award will deter producers and sellers of counterfeit products from infringing the designs of others.[138] The awards have sometimes achieved this aim, with those nominated often pulling their counterfeit products from the market.[139] However, the deterrent effects of such a venture are necessarily limited to a few infringers targeted in one market each year.

The next section of the paper reviews the theoretical underpinnings, and traces the development of legal protection for industrial design internationally--especially the relatively recent harmonization efforts undertaken by the European Union. Its aim is to show that despite the apparent muddle of laws, and lack of international consensus on the best methods for protecting design, there are some international standards emerging for the protection of industrial design, which, in turn,

might guide the development of U.S. law.

II. The Development of Legal Protection For Industrial Design Interna- tionally

A. Different Theories of Protection

The intellectual property triumvirate of patents, copyrights and trademarks were not created specifically to protect industrial design, and the extension of laws beyond their original purpose is often problematic and has unintended consequences.[140]

Patent law is designed to provide a relatively short term but very strong monopoly to encourage the development of industrially useful inventions. The strong monopoly it provides would have an anti-competitive effect if available to primarily aesthetic designs, but it is difficult for courts to distinguish the un-protectable functional aspects from the protectable ornamental aspects of a design that includes both.[141]

***514** Copyright law provides a longer time period of protection for merely original--rather than innovative--creative works against copying. Arguably, its protection, while suited to the aesthetic nature of most design, is far longer in duration than necessary or desirable to protect industrial products, especially in fast moving industries that are characterized by lots of derivative works.

Trademark law protects consumers from being misled into buying counterfeit goods and also protects trademark owners from those who would free-ride on their goodwill. Trademarks protect the reputation, particularly of well-known brands, but they do not protect product design specifically. Therefore, to avoid providing monopoly awards for successful designs, trademarks should not provide any protection until a design is well-known and linked in the minds of consumers with a particular design source.[142]

To compound the problems inherent in attempting to squeeze design protection into existing intellectual property schemes, U.S. courts have unfortunately tended to view each type of intellectual property separately rather than part of a larger scheme to protect innovation generally.[143] As designers have tried to fit their requirements for protection into each of the traditional IP frameworks in turn, judges and legislators have found reason to limit the doctrinal expansion of the right, and designers have been frustrated in their attempts to protect their designs.[144]

1. Type of Legal Protection for Industrial Design

Both in the U.S. and other legal systems, the debate over whether to categorize industrial designs as either belonging to the copyright or industrial property and patent law paradigm has raged since industrial design was recognized as worthy of legal protection.[145]

Patents traditionally protect novelty and inventiveness and encourage the creation of new industrial processes. Industrial property protection is characterized by a short period of monopolistic protection and a registration scheme which is used to assess whether a particular invention is sufficiently novel to merit the monopoly protection and also to serve to provide notice to others of how to make the invention once the monopoly period is over. The view of those who advocate for a patent-like protection for industrial design is that industrial design is primarily about the engineering rather than the aesthetics of a product, so in order to avoid an anti- ***515** competitive effect only novel advances in the product's functional features should be protected.[146]

However, much industrial design is about incremental or aesthetic improvement to existing products rather than the creation of completely new products. Designers are usually different than inventors. Their job can be seen as the creation of a better, more functional, aesthetically-pleasing mouse trap rather than the invention of a new mousetrap. It can be argued that design is more about aesthetic expression than function.[147] The obvious problem with using patent law to protect design is that it tends to under-protect new industrial design because few designers can claim to have created a truly new functional product.[148]

A copyright regime, by contrast, is concerned with protecting original expression rather than innovation. It tends to overprotect design because it protects the particular form of the expression of an idea from copying for a relatively long

period.[149] Few, if any, formalities are required to obtain copyright protection, but the protection is more limited than the monopoly provided by a patent and can only be used to prohibit imitators and not independent creators. Since a copyright system protects artistic work, there is an argument that copyright is the best regime for protecting design because design "embodies aesthetic expression".[150]

The main argument that design should be treated in exactly the same manner as other artistic works and protected by copyright law is that judges should not be arbiters of the level of creativity involved in an artistic work. This "unity of art" doctrine, most often strongly linked with French jurisprudence, holds that there "should be no discrimination between useful art and pure art."[151] A well-designed salt cellar or chair should enjoy protection in the same manner as an object of fine art like a painting or a book. Any artificial distinction in protection based on where or how the product is used should be avoided. This broad approach has the merit of clarity and unambiguousness.[152] Under the "unity of art" doctrine, all designs--irrespective of their form, mode of production, level of creativity, or purpose--would qualify for protection by copyright law.

However, copyright protection provides long term protection: currently, life plus 70 years. If applied to design, it will protect the most mundane of everyday ***516** objects that are only likely to have a shelf life of a few years--or in some cases, mere months--for the full life plus 70 years copyright term. In France, the birthplace of the "unity of art" doctrine, the courts have applied arbitrary rules to deny protection to utilitarian objects, much as the U.S. courts and Congress have done in limiting the application of copyright law for designs in the U.S.[153]

Even when the type of legal protection to be accorded to design is determined, at least three very important questions remain for the legal regime: the standard of creativity required for design protection; whether functional or merely ornamental aspects of the design should be protected; and, if design is to receive something less than full copyright protection, the intersection between the design protection law and copyright law.

2. The Creativity Standard

The question of the type of protection that the legal regime should provide for industrial design (i.e. protection against any acts inconsistent with ownership or just against copying) raises the related question of what level of creativity is required for industrial designs to be protected. Under a patent regime, the level of creativity required for protection is high; the patent standard is novelty. Only truly new and inventive designs (generally of functional features) are worthy of the protection. The U.S. design patent requires a design to be "new, original and ornamental."[154]

Under a copyright regime, the level of creativity is lower than that required for patent protection, and there is less need for a pre-registration review of the design. Copyright law requires an "original" work for protections to apply. At the lowest level of originality, this can mean simply that a work originated with the author; that is, it was not copied.[155] Alternatively, originality can require more than "sweat of the brow," some level of personal involvement of the author and a modicum of creativity. This is generally considered to be the U.S. standard. The judge will not enquire into the artistic merit of the work[156] and the Supreme Court has explained that "the requisite level of creativity is extremely low."[157] Nothing is required beyond some creative spark, "no matter how crude, humble or obvious it might be."[158] An even higher--and more subjective--standard of originality is possible. Some copyright regimes require a consideration of whether artistic creativity ***517** is involved in the creation of the work.[159] Whatever standard of creativity is chosen, any copyright law standard of originality is going to be lower than a patent standard. Thus, more industrial designs will qualify for protection under a copyright standard than under a patent standard.

3. The Aspects of Design which Deserve Protection

The next important issue relating to whether design is protected by a patent-like or copyright-like regime is the question of whether protection should apply only to the aesthetic parts of the design or should also cover the functional parts of the design. Patent law protects functional aspects of an invention. It provides a monopoly protection which allows the patent owner to control all uses of his invention. Critics have argued that since industrial design concerns incremental and often aesthetic improvements to a product, it would be anticompetitive to provide designers with a protection of functional features.[160]

Copyright protection schemes protect artistic elements but generally exclude protection of purely functional features. Thus, the reproduction of a design affixed to a teacup will be protected by copyright law but not the reproduction of the teacup

itself, even of an unusual design, because it is a functional object. The difficulty for most industrial designs--as opposed to art later applied to a useful object--is separating the form from the function of the object. For example, clothing, however creative, must fit the human form.

Fashions change in everything, and the philosophy of the function of industrial design has changed over time. A predominant modern philosophy of design is one of functionality; a product's features should dictate and be closely linked with its function. The philosophy is captured by the aphorism, "form follows function."[161] Non-functional, strictly ornamental flourishes--such as were common on 1950s automobiles or Victorian buildings-- are out, and streamlined simple and functional designs are in.[162] The fact that many modern designers tend to emphasize the marriage of form and function makes it harder for them to obtain legal protection for their designs under current U.S. law because the functional and artistic aspects of the design cannot easily be separated.[163]

***518** In trying to solve the anticompetitive effect of the overprotection of functional features, Robert Denicola proposed a sliding scale between art and utility. His view was that the more a work is influenced by utilitarian considerations the less likely it ought to be to attract copyright protection.[164] In this way, mundane objects in which little design is evident will not attract protection but rather more creative objects will be protectable. This approach does not work well for functionalist design because in a functionalist design the functional and artistic portions of the design cannot be easily conceptually separated, and so, under Denicola's test, the design will not be protectable. Denicola's test was adopted by the Second Circuit in a case concerning a bike rack where the designer of the rack had reworked a sinuous metal sculpture to function as a bike rack.[165] The court held the rack design, although it had received much praise and won design awards, was not protectable under copyright law because the form was not conceptually separate from the function.[166] If all functional features are excluded from legal protection, then it is difficult to create a design law that will protect functionalist design.

4. The Intersection between Design and Copyright Law

Unless all designs are protected by copyright law (the 'unity of art' doctrine), the legal system must address the intersection between the laws protecting industrial design and art. At least three approaches are possible. The legal system may cumulate protections for industrial design so that all and any rights are available to design and it does not matter whether the creative work is fine art or functional design.[167] One disadvantage of this type of system is that there may be little or no incentive to apply for a shorter duration of design protection, if the longer protection of copyright law will arise automatically on the creation of the artistic work. EU law specifically endorses the cumulation of all rights that EU member states' laws provide for design in order to avoid conflict between the different legal schemes of protection.

A second approach is non-cumulation; here, the legal system provides for the protection of some original industrial designs and denies copyright protection to those that fail or are unable to obtain design protection.[168] This approach will leave many designs unprotected. It is basically the current U.S. approach. There remains an area where even this approach will intersect with copyright and that is art later applied to a functional object, or applied art. If a design is artistically creative and separable from the functional aspects of a product it will constitute applied art and ***519** protection will be available to the art under copyright law with its long duration and lack of formalities even though it is used in industry.

The third approach is partial cumulation. A design law protects all objects of original industrial design and copyright law protects art.[169] Copyright protection is not denied to original design but some test is used to keep most industrial design out of copyright protection. In her recent article, Professor Afori proposes a partial cumulation type approach which she calls "unity of design."[170] Afori suggests that the borderline between copyright and design law is currently in the wrong place; it requires courts to determine whether an object is art or not and so protectable by copyright, which is a subjective judgment.[171] If industrial design was fully protected by a design law rather than copyright law, courts would not have to consider the question of whether an industrial design was art.[172] At the lower end of the design spectrum, design law would protect all and any original industrial design whether artistic or functional.[173] At the higher end of the spectrum, applied art, which might, in some legal systems, be protectable by copyright, would be protected by design law if it was manufactured on an industrial scale.[174] Essentially, Afori's test as to whether an object is protectable by design law or copyright would shift to the industrial use of the object rather than focusing on its degree of artistic content. The merit of this approach is that the determination of how the design is used is more objective and easier to apply than the more subjective assessment of whether a design contains conceptually separable artistic elements.

Most commentators argue that there is no international consensus on these legal principles on which design should be protected.[175] In the next section the history of design protection internationally is reviewed to demonstrate that, while there is

not complete agreement, there is a growing consensus on the important questions of what legal regime is best suited to protecting industrial design and what level of protection it should provide.

***520 B. A Brief Chronology of the Legal Recognition of Industrial Design Rights Internationally**

1. International Recognition of Industrial Design Rights

Patent rights were subject to the first international intellectual property treaty in 1883,[176] followed by copyrights in 1886.[177] Initially, these treaties attempted to define and harmonize the protection accorded to useful inventions and creative works respectively.[178] The newer field of industrial design did not figure into legal treaties or discussions until the 1920s at the earliest.[179]

There are now four agreements and two organizations at the international level that are relevant to the protection of industrial design. None of them provide a completely agreed-upon international standard for the protection of design and their history illustrates the continuing conflict on many issues related to industrial design. However, despite the confusion and points of disagreement, some tentative areas of emerging harmonization can be divined from the international efforts to protect industrial design.

a. The Hague Agreement

In 1925, The Hague Arrangement Concerning the International Registrations of Industrial Designs was the first treaty to specifically focus on the international protection of industrial design rights. The Hague Arrangement is not particularly important since it does not attempt to harmonize design laws or set any standards for the legal protection of industrial design. Its aim was to simplify the international legal procedure for obtaining protection for industrial designs by creating a centralized international deposit of industrial designs. This change would make it easier to register designs in multiple countries.[180] The original agreement had few contracting parties.[181] There have been three revisions to the Hague Arrangement and the treaty is now administered by the World Intellectual Property Organization (WIPO).[182] Even after three revisions, the Hague Arrangement has not added any clear theory of protection to the law of industrial design.[183] Although the revisions ***521** have simplified procedures, membership in the Hague Agreement remains unappealing to countries--like the U.S.--which provide for a substantive review of design applications for originality, because the Hague mechanism gives countries a maximum of six months to refuse protection to a deposited design.[184] This short time limit clearly does not envisage a patent approach to protection but the agreement provides no harmonized standards for the type of protection members of Hague Arrangement should provide to industrial design.

b. The Berne Convention Recognizes Applied Art

The Berne Convention for the Protection of Literary and Artistic Works, signed in 1886 by a group of countries wishing to enshrine certain basic principles of copyright protection, has protected applied art since 1948.[185] For much of the earlier years of the Berne Convention, there was an ongoing debate about whether or not to include applied art (which could include some industrial design) as copyrightable subject matter.[186] The Berne Union countries first agreed to protect applied art as a separate category of work akin to copyright at the Brussels Conference to revise the convention in 1948.[187]

The French delegates managed to obtain the agreement of the other members on the concept that designers of all ornaments, whatever their merit or purpose, should be entitled to legal protection.[188] The delegates of many other countries including Italy and Germany were wary of this argument.[189] Their view was that since industrial design concerned industrial processes rather than art for art's sake, it would be anticompetitive to provide industrial designers with the long period of copyright protection afforded to creative works.[190] Ultimately, since neither side could agree, an awkward compromise was reached. They agreed to add works of applied art to the protectable subject matter of the Convention, but each country retained the right to define applied art, to limit the duration of copyright in applied art, and also to distinguish between protectable applied art and a category called "designs and models"--which could be subject to a more restrictive industrial property regime.[191]

***522** Thus, although it was agreed that applied art should be subject to copyright protection, the 1948 Brussels Conference did not require countries to protect all industrial design under copyright law. Countries could choose to write sui generis design laws to protect industrial design, and even if they used the copyright scheme as a basis for design protection, these countries could still limit the duration of protection of applied art as opposed to fine art.[192] The change to Berne in 1948 was

probably the high point of the "unity of art" approach to design protection. This movement lost momentum after 1948--both inside and outside the Union--as countries sought to pass sui generis laws and protect design as a type of industrial property.[193] This trend was a rejection of the full copyright approach and perhaps a recognition of the growing importance of industrial designs with the need for more short-term protection.

c. The Paris Convention Adopts Industrial Design Article

In 1958, the Paris Convention on Industrial Property also extended its provisions to cover industrial design. It adopted a new article at its Lisbon Conference that provided that all member states should protect "industrial designs," but, as at the 1948 Brussels Conference, it was agreed that each state could determine the nature, subject matter and conditions of such protection.[194] The tension between design as industrial or creative property remained unresolved. Two international conventions determined to add industrial design protection to their terms, but they specified neither the type of protection regime nor the standards for protection amongst copyright and industrial design.

d. The World Intellectual Property Organization

The next step in the protection of industrial design came in the 1960s when the World Intellectual Property Organization (WIPO) was created.[195] A worldwide effort also started to develop a model design law or agreed set of principles.[196] At this point, it seemed that many countries were interested in creating specific design protection laws. However, the reform movement fizzled out without setting a clear international standard.[197]

e. World Trade Organization

About thirty years later, in 1994, the Trade Related Aspects of Intellectual Property Agreement (TRIPS) was adopted, after nearly seven years of talks, as one ***523** of the General Agreement on Tariffs and Trades (GATT) sub-agreements.[198] Its purpose was to ensure the effective appropriate enforcement of IP rights worldwide.[199] TRIPS is an important addition to the international agreements that contain provisions on industrial design because it covers the largest number of countries[200] and it is the first agreement to provide some direction on the type of protection. Article 25 of TRIPS provides for "the protection of independently created industrial designs that are new or original."[201] It requires member countries to protect these "new or original" designs through either industrial design law or copyright law.[202] Once again, the agreement does not clearly mandate a particular standard for protectable subject matter by using both the words "new" and "original." However, TRIPS is the first treaty to be more specific in terms of minimum standards for the type and duration of protection. It requires designs to be protected from copying for a minimum of ten years.[203] The requirement for protection against copying appears to recognize that copying is the main problem for designers, and a copyright-type approach, focusing on protecting originality rather than novelty, is the most relevant for industrial design. The minimum term requirement is much less than the full copyright term, suggesting a recognition of the industrial application of design and a rejection of the full copyright approach.

However, under TRIPS, members essentially remain free to determine the subject matter and type of design protection--as long as it covers copying--and the method of implementation.[204] When President Clinton signed legislation implementing TRIPS into U.S. law, he stated that existing U.S. law already protected industrial design sufficiently to comply with TRIPS.[205] Design patents do protect some novel designs for fourteen years.[206] The U.S. felt compelled to modify its copyright law in order to protect architecture in compliance with TRIPS, but shied away from a recognition that the current design patent approach does not in fact adequately protect all market-entry industrial design, just a narrow set of the most novel designs at the more creative end of the design spectrum.[207]

***524** Although the Paris and Berne treaties mostly serve to illustrate the debate rather than provide assistance in terms of the principles of protection to follow,[208] TRIPS can be viewed as providing a clearer attempt at the international level to enunciate the principles for the protection of industrial design. The TRIPS provisions envisage that design protection should be short (like other industrial property rights) and focused mainly on protecting designs against copying (like copyright law). Thus, the TRIPS provisions are evidence that a modified copyright approach to the protection of design is becoming the international standard. Since TRIPS, further attempts to harmonize industrial design laws have occurred in the European Union. These attempts, reviewed in the next section, also suggest that the emerging consensus on the protection of industrial design is in favor of an approach based on modified copyright principles focusing on short term protection against copying and that the U.S. approach to design protection is increasingly anomalous.

C. The European Union Attempts to Harmonize Design Protection

1. The Difficulty of Harmonizing European Design Law

Until recently, European law was characterized by the confusion and variety of legal schemes of protection that have typified design law. Within Europe, all schools of design protection theory were represented, from the French "unity of art" doctrine to the Italian separability doctrine of inscindibili.[209] All of the long-standing members of the European Union were also long-standing members of the Berne Union and the Paris Convention, and thus, were part of the discussions and messy compromises of 1948 and 1958. As a result of the failure of these agreements to require specific standards, the laws of EU member states on design remained varied; and to add to the confusion, the positions of some countries on industrial design changed over time.[210]

In 1977, a subcommittee of the European Community's Coordinating Committee for Harmonizing the Law of Industrial Property met to consider reforming design protection at the European level; however, no further action was taken on the report produced by the subcommittee for another sixteen years.[211] In the 1990s, the EU once again turned its attention to the process of harmonizing the protection provided to industrial design with more success perhaps because of a growing ***525** recognition of the importance of design-intensive industries to the economy.[212] The first EU action in 1998 was to pass a directive requiring all EU members to provide a registered right to exclusive use of the design renewable in five year increments for up to twenty-five years.[213] More importantly, in 2002 came the passage of a regulation containing two pan-European design protection rights administered at the European level.[214] The first, the registered design right, was essentially the same as the right created by the earlier directive at the level of the member states.[215] The second, the unregistered design right, provided a short-term (three-years) copyright-like right to prevent the copying of a design.[216] This right required no registration, but arose automatically on the first marketing of the design in the EU.[217] The Design Regulation was criticized by some as falling short of a complete harmonization of European law since it left in place most national rights and failed to address some important issues like the position of spare parts.[218]

However, the unregistered design right the Regulation creates is a completely new type of right and it has achieved some measure of standardization of European law. Aspects of the unregistered design right are instructive for U.S. law on design, particularly the standard of originality required for protection, the actions which constitute infringement, and the fact that no formalities are required for its creation.

2. The Community Design Directive

The Design Directive seeks to "provide[] for the establishment of an internal market characterized by the abolition of obstacles to the free movement of goods and also for the institution of a system ensuring that competition in the internal market is not distorted."[219] It cleared up several differences in the laws of different European countries by determining that design law should not protect "features dictated solely by a technical function," thus hampering technological innovation.[220] It defined a protectable design as one that produced on the informed user, "a different overall impression"[221] to other designs, thus providing a guide for the standard of ***526** originality required for protection. It established the important principle of cumulation of different IP protections; this meant that countries that had both copyright and specific design protection legislation protecting designs did not have to choose between the different legal regimes for the protection of industrial design.[222] Thus, although the directive still left European countries with several types and levels of design protection, and purposely avoided thorny issues like whether to prohibit the copying of spare parts,[223] it still made several important contributions to the harmonization of design law in Europe. If other EU directives relating to copyright are considered, an even clearer pattern emerges as to the direction the EU is taking with harmonization in this field.[224]

3. The Community Design Regulation

In 2001, in the Design Regulation, the EU tackled more of the continued, potentially market-distorting, substantial differences between the laws of some EU member states on design.[225] The Design Regulation introduced a scheme of design protection at the European level which allowed European designers to bypass messy and confusing individual national laws, and protect designs either through one Europe-wide registration or an unregistered, short-term, copyright-like right which attached to a design from first marketing in the EU.[226]

The Design Regulation mirrored the standards of originality in the Design Directive, protecting all designs that are "new" and have "individual character."[227] The standard is similar to, although not as broad as, the U.S. copyright standard of originality.

To be protected, a design must not be identical to, or produce the same overall impression as, one already on the market, but it is not required to be new in the patent sense. The EU has clearly chosen a modified copyright approach to the protection of design which is in line with the direction already taken at the international level in TRIPS.

a. Unregistered Design Rights

The real innovation of the Design Regulation is the introduction of the unregistered design right. Unregistered designs receive three-years of copyright-like ***527** protection from the date the design was first made public within the EU.[228] This protection is based on the U.K. unregistered design right, introduced by the Copyright Designs and Patents Act 1988,[229] and was clearly a compromise designed to provide some minimal level of protection that does not require registration in those EU countries that do not provide for the protection of design through copyright law. In these countries, if a new design is not registered, then it is unprotected because it will receive no protection from copyright laws.

Designers in countries which required registration for the protection of industrial design were clearly at a disadvantage in protecting their work by comparison with designers from countries like France who can automatically obtain lengthy copyright protection for many of their designs. It can be argued that the unregistered design right simply defers the problem of lack of harmonization of European law for a few years, after which discrepancies in the duration of legal protection provided to different types of design reappear. For example, in France, many designs will be protected by copyright (life plus seventy years), while in the U.K. or Italy, where industrial designs are generally only protectable by registration, protection for the same design will lapse once the three year unregistered design right ends. EU law explicitly makes rights cumulative so it does not shut off the copyright route to protection in countries where it is available. However, the unregistered design rights are still helpful because they provide all designers with the type of short term protection most beneficial to protecting the first-to-market advantage for a short period. In many design-intensive industries, fashions change quickly and the short term of protection provided by the unregistered design right is sufficient to provide a tool to fight counterfeiters, thus encouraging innovation in design.

One major difference between the European unregistered design right and the original U.K. law is that the U.K. right provides for a much longer (up to fifteen years) term of protection[230] during which "[t]he owner of design right in a design has the exclusive right to reproduce the design for commercial purposes".[231] The British unregistered design right was introduced to deal with the non-cumulation problem in the U.K. British designs could be protected by the patent-like protection of the registered design law, but there was a possible entrance into copyright law for even the most functional of designs because of the ability to claim copyright infringement of two dimensional drawings by a three dimensional object.[232] ***528** This enabled designers to obtain full copyright protection for even the most utilitarian and functional designs by claiming copyright infringement of the blueprint drawing.[233] The unregistered design right was introduced to fix this flaw by providing a shorter copyright-like right for all original designs while at the same time shutting the door to derivative copyright protection for drawings of commercially exploited objects.[234] The EU unregistered design right has been introduced to provide some short term protection for all design to blunt the advantage to designers in some countries of full copyright protection for design. In the author's view, the shorter term EU unregistered design right is preferable to the U.K. unregistered design right because it restricts design innovation for a shorter period.

Under current U.S. law, there is no protection similar to the unregistered design right; while designers attempt to use the three main branches of IP law to protect their industrial designs, there are gaps left by all these rights. The problems of attempting to protect industrial design using design patent, copyright, and trademark protection under U.S. law are discussed in the next section.

III. Legal Protections for Industrial Design under U.S. Law

In contrast to the recent legislative activity in Europe, the state of design law in the U.S. can only be described as stagnant.[235] Although there has been a seemingly relentless expansion of some other types of IP, such as copyrights and patents,[236] Congress has been reluctant to legislate a new type of protection for industrial design.[237] Courts have also been somewhat wary of stretching copyrights, patents, and trademarks too far beyond their intended purposes in order to protect design and so have tended to limit the level of protection available through traditional IP rights for design.[238] As each new type of protection has been tried by designers, it has been closed off by courts wary of blurring the lines between different types of IP and expanding protection into new areas.[239]

***529** So, although the U.S. has the world's biggest design industry,[240] U.S. intellectual property laws are acknowledged as some of the strongest in the world, and the enforcement of intellectual property laws-- particularly those against piracy--is claimed by the DOJ to be a priority,[241] when it comes to the protection of industrial design there is a conceptual void. Part of the reluctance to protect industrial design can be explained by concern that such protection could be anticompetitive and might be used to restrict competition. The argument is, however, losing its force as copying by free riders becomes more and more of an economic burden on designers and the economy in general.[242]

The U.S. is one of the last countries to rely mainly on a patent approach for the protection of industrial design instead of a sui generis design law based on modified copyright principles. This has forced designers to look for creative legal strategies to protect designs, which are not or cannot be registered as design patents, or through copyright and trademark law.

A. U.S. Copyright, Patent and Trademark Law

1. Design Patents

Congress has protected industrial designs through patent law since 1842.[243] Apparently, this came about not for any clear doctrinal reason, but because there was no central registry for copyrights at the time and the request for the protection of industrial designs originated with the Patent Office.[244] During that period, patent law was seen as the stronger branch of intellectual property, which was possibly another reason why it was chosen for design protection.[245] This state of affairs has now more or less completely reversed, with copyright having been significantly extended in terms of both duration and subject matter.[246] There are both conceptual and practical disadvantages with the protection of industrial designs through design patents.

The novelty required to obtain a design patent is a higher standard than copyright originality, requiring something completely new rather than merely an eye-pleasing variation of an existing product. Many designs fail to meet this standard, ***530** even those which are arguably creative, distinguishable, and appealing to consumers.[247] The vast majority of new designs are not registered as design patents.[248]

The test for determining whether a design patent has been infringed is also strict and judicial decisions have made the law unclear. The newest iteration of the standard to determine whether a design patent has been infringed is "that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs."[249] This test is really quite similar to the test for trade dress infringement, essentially amounting to a customer confusion standard likely to be triggered by direct copying. Possibly, this test might encourage more use of design patents despite the conceptual problems with protecting primarily aesthetic subject matter through patent law.[250] However, design patents also have the practical disadvantages for designers of requiring the time-consuming substantive review of a registration which publicizes the new design proposal to potential infringers.[251]

Some have argued that the disclosure of the new design in the application has considerably more disadvantages for designers than inventors since designers tend to make incremental and aesthetic changes to product design which can easily be communicated to the competition for copying through the design patent application.[252] Minor variations, once disclosed, are easily and cheaply copied or incorporated into another's new product. Even when design patents are obtained, courts often invalidate them because of the high standard of novelty required for patent protection.[253]

For a limited number of innovative designs, acquiring a design patent can be a useful step in a strategy to obtain long term monopoly protection through trademark law. However, for most designers, the time and expense of applications, together ***531** with the strict requirement of novelty, preclude the use of design patents to protect their designs.

2. Copyright Law

For designers, the great benefit of copyright protection over design patent protection is that no registration or other formalities are required to obtain copyright, the protection period is long, and the required level of originality of the design is much lower than the patent law standard. However, the line between copyrightable applied art and non-copyrightable industrial design is the most important and difficult boundary in any system for the protection of industrial design. In the U.S., because of fears of the anticompetitive nature of providing long term copyright protection, the role of copyright in protecting industrial design has been almost eliminated.

a. Mazer v. Stein

The U.S. Supreme Court was given the chance to consider the position of applied art under U.S. copyright law in 1954. The Copyright Office had finally put the provisions of the 1909 Act into practice and started to register copyrights in three-dimensional objects in 1949.[254] The issue of whether to protect three-dimensional objects as applied art when they were used in industry quickly came before the court in the Mazer v. Stein case.[255] The court ruled that a lampbase design of a statuette of a Balinese dancer was eligible for copyright protection.[256] Justice Reed said, "[w]e find nothing in the copyright statute to support the argument that the intended use in industry of an article eligible for copyright bars or invalidates its registration."[257]

The Mazer ruling potentially put the U.S. squarely into the "unity of art" camp. It appeared to create a general protection for an article of industrial design as part of copyright law. The case explicitly made no distinction between applied and fine art.[258] For a time after this ruling, courts started interpreting what designs could be copyrighted very broadly.[259] However, efforts to revise copyright (which eventually culminated in the 1976 Act) were already under way and the Copyright Office adopted new regulations that introduced the notion of conceptual separability.

***532** b. Copyright Act of 1976

Thanks mainly to the Copyright Office position that design should be dealt with under a separate design law,[260] the Mazer rule was codified very narrowly in the Copyright Act of 1976 to take most industrial design out of copyright law. Under section 1302(4) of the 1976 Act, the Mazer rule is codified that if the shape of an article is "dictated solely by a utilitarian function of the article that embodies it," the design element cannot be protected under copyright law.[261] This means that designs per se are not protected but pictorial, graphic, or sculptural works which are physically or conceptually separable from the design--such as a textile print or ornamental embellishment--are protectable.[262] This has caused much confusion as to what design is protectable, and the law is not a workable guide for designers.[263] Unfortunately, although numerous efforts have been made over the years, the U.S. has never actually passed the sui generis design law necessary to complement this narrow treatment of industrial design by copyright.[264]

U.S. legislative and judicial actions have therefore limited copyright law as a means to protect design, while at the same time failing to balance this limitation with a sui generis design law. Thus it can be argued that current U.S. law does not protect design by either of the methods (copyright or design law) envisaged by TRIPS.[265] The doctrine of conceptual separability is particularly problematic given the dominance of the design philosophy of functionalism (good design is dictated by the function of the object). If, as is likely given the case law and legislative action since Mazer, copyright law is not going to protect the majority of industrial design as applied art, then it is incumbent on Congress to give some thought to the sui generis design law that the Copyright Office thought was necessary over fifty years ago.[266]

***533** 3. Trademark Law Protections

a. Trademarks

Given the problems with design patents and copyright, some designers have turned to trademark protection for industrial design. Commentators have argued that trademark law is not the best place for protection of design: "[t]he problem is this: protection of industrial design, unless kept firmly tied to source recognition as a trademark, easily slides into an unpredictable system of monopoly awards for successful designs, uninhibited by the statutory standards of copyright law or design patent law."[267] A trademark enjoys potentially perpetual protection without the need for patent novelty, or even originality under copyright law. The courts are afraid that overprotection of design through trademark law would protect functional objects and thus be anticompetitive.[268] The problem is that in their attempts to ensure that trademarks do not provide designers with monopolies over non-distinctive features, the courts have rendered trademarks useless for protecting market-entry designs while in some ways strengthening their use for well-established designers who can use them to monopolize particular design features.[269]

b. Trade Dress

Trademark protection is also available where a designer can show that a particular design function is a means to identify the origin of the goods.[270] Only distinctive and non-functional elements of a design are protected. Successive Supreme Court

decisions have made clear that the purpose of trademark law is to protect consumers from confusion and not to protect designers from would-be innovators.

In Wal-Mart v. Samara, the Supreme Court held that clothing designs that are "inherently source identifying" can ordinarily be protected with design patents (an assertion that is highly debatable because clothing is unlikely to reach the design patent standard of inventiveness).[271] Thus, in order to avoid overlapping protection the court held that a design must acquire some secondary meaning to attract protection as a trademark.[272]

In Justice Scalia's opinion, competition would be deterred if a product design was entitled to protection without a showing that it had acquired secondary meaning. ***534** [273] In other words, the designer must prove that the primary importance of the clothing design is to identify the source of the product.[274]

Samara alleged that Wal-Mart had copied its seersucker children's clothes designs.[275] The Supreme Court held that the design of the clothing had not acquired the necessary secondary meaning for it to function as a source identifier, such that a consumer could recognize from looking at the clothing where it came from, and thus refrained from providing Samara with a remedy against Wal-Mart for the copying of its line of clothing.[276] Samara would have been better off with some limited type of protection against direct copying of its clothing (which Wal-Mart admitted). It did not really require a perpetual trademark monopoly, but a short-term advantage for its innovative design work before others could copy it would have enabled Samara to prevent Wal-Mart from essentially pirating its designs immediately after it produced them and destroying Samara's first-to-market advantage.

The Samara decision effectively prevents designers from using trade dress to protect new market-entry design because it will not have acquired secondary meaning. Obtaining trade dress protection is also problematic for designers because design aspects that are functional will never qualify for trade dress protection. The purpose of the "functionality doctrine" is to ensure that no one can use trademark law to control useful product features.[277]

B. Laws Specific to Design Industries

U.S. designers are left with few options to protect their designs. Congress has failed to pass a sui generis design law, while it has also significantly limited the use of copyright to protecting design.[278] Judicial decisions have had the same effect for design patents[279] and trademarks.[280] Instead of a unified approach to make clear where design fits into intellectual property law, over the last twenty years there have been three particular design industries singled out for more specific legal protections.

1. Architectural Works, Semiconductors and Vessel Hulls

Congress added "Architectural works" to the list of categories of work protected by copyright law in the Architectural Works Copyright Protection Act, to ***535** comply with the Berne Convention.[281] This Act provides direct protection to building designs and blueprints. Some have argued that the U.S. also fails to protect industrial design in line with its obligations under the Berne Convention and also under TRIPS.[282] To head off such criticism, President Clinton specifically stated when he signed the law implementing TRIPS that U.S. law protecting design was sufficient to comply with its requirements.[283]

Two other industries lobbied Congress for copyright-like protection with respect to design: the semiconductor and the vessel hull industries. In 1984, Congress adopted the Semiconductor Chip Protection Act which afforded protection for "mask works," which enable the etching of circuitry onto silicon wafers,[284] and in 1998 it passed The Vessel Hull Design Protection Act (VHDPA).[285] This act came about because the Supreme Court struck down a Florida statute protecting boat hulls on the basis of federal preemption,[286] and once boat designers were prevented from using state unfair competition laws to protect their designs they lobbied Congress for federal protection of boat hull designs.[287] The act gave boat designers copyright-like rights to "useful articles" for a period of ten years, so long as the design of the article is registered within two years of the date it was made public.[288] The use of the term "useful article" (in the act defined as a boat hull) suggests that Congress must have envisaged that the act could be relatively easily extended in the future to cover other articles of industrial design simply by expanding this definition to include all articles of industrial manufacture.

Under the VHDPA, a hull design needs to be "original" in order to be registered and protected by copyright. Original design is defined as providing a "distinguishable variation over prior work pertaining to similar articles which is more than ***536**

merely trivial and has not been copied from another source."[289] There are similarities between the VHDPA and the European registered design right in terms of originality and infringement requirements. Once the design is registered, the owner has the exclusive right to make or import hulls which incorporate the protected design for a period of ten years.[290] However, there are differences as well. The EU law provides different levels and longer protection (up to a total of twenty-five years), and is not limited to one industry.

2. Proposed Legal Protections for Fashion Design

The CFDA started first to actively protect fashion design using litigation.[291] Next, they joined boat designers and pushed for new legislation to protect their rights. This action followed the long U.S. tradition of allowing special interest lobbyists to direct copyright legislation reform.[292]

The fashion lobby has proposed at least three design bills (the fashion bills) over the last few years, most recently with the reintroduction of the IDPPPA as H.R. 2511 in July, 2011.[293] Each bill uses the VHDPA as a framework to expand protection to fashion designs as well as boat hulls. Under the most recent version of the fashion bill, the protection for boat hulls would be extended to "apparel," defined as clothing and accessories.[294] This narrow definition allows the CFDA to argue that its extension of current law is modest, and that it seeks only to protect its members from counterfeit goods because the law only protects fashion designs.[295]

The test of originality in the proposed law is similar to the VHDPPA. It requires that the design "provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source."[296] It continues, "[t]he presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be ***537** considered in determining the originality of a fashion design."[297] This copyright-like test potentially allows fashion designers to use the law to protect against derivative works as well as identical copies. The defenses to infringement are, that a design "is not substantially identical" to a protected work or is "the result of independent creation."[298]

A central issue with the copyright-like standard is that it protects designers very broadly, thereby enabling them to prevent more than just identical copies or knock-offs of their work because the exclusive rights of a copyright owner include the right to prohibit reproduction and derivative works.[299] Broad protection is problematic since many legitimate designers borrow substantially from the work of others.[300] In the fashion business, prohibiting designs which are closely and substantially similar to the original may give too much power to well-financed and legally savvy designers who know to register their designs since design borrowing or interpretation is such accepted practice.[301]

The IDPPPA is the first U.S. design bill which drops registration as a prerequisite for protection. Any design fitting the bill's originality requirement will be protected. The bill's proponents argue that this feature will ensure the protection of new, as well as established, designers.[302] Removing the registration requirement opens up protection to all designers, although the bill continues to protect designers in only one industry: fashion. This ought to give pause to counterfeiters considering copying any new and original fashion design, not just those designs which have been registered.

IV. Redesigning U.S. Law to Properly Protect Industrial Design

A. The Issues

1. Design Piracy Affects All Designers

Fashion designers have brought their concerns about knock-offs to the attention of Congress and the public.[303] In recent years the amount of design copying has expanded greatly worldwide and in all industries.[304] It is clear that fashion is ***538** not the only industry where design is important and copying is rife. Design copying affects industries from automobiles to apparel.[305] To protect the short-lived advantage of investing in good industrial design, all designers should be protected from direct copying by counterfeiters.

Many studies have found counterfeiting to be a major and growing problem for designers.[306] In their paper contending that the fashion industry does not require legal protection, Raustiala and Sprigman argue that imitation allows the fashion business to

thrive.[307] They argue that the "low IP equilibrium" is therefore well-suited for the fashion industry because it speeds the fashion cycle and frees up designers to reinterpret trends or borrow from each other without fear of lawsuits.[308] This argument is specific to the highly derivative and fast-moving fashion industry and it therefore fails to make a distinction between different types of copying -specifically knock-offs or exact copies on the one hand, and substantially similar or derivative work on the other.[309] In many design-intensive industries there is a difference between the slavish copying of a counterfeiter and the more interpretive actions of a follower who may closely copy many elements of an earlier design, perhaps in order to sell it at a lower price point.[310]

2. Current U.S. Legal Protections for Design Lack Coherence

In the U.S., the approach to the legal protection of design has tended to be piecemeal, with specific industries lobbying for protection, but no clear general direction to the law.[311] There is clearly no conceptual rationale for providing legal protection for the designers of boat hulls but not for the designers of other goods, and extending the protection boat hull designers enjoy to fashion designers alone also makes little sense. While fashion is hard hit by copyists, the increasingly technologically savvy producers of knock-offs and counterfeits copy good design in all industries and lessen the incentives to invest in developing good industrial design.

Aspects of industrial design can currently be protected in the U.S. under patent, copyright, or trademark law, but none of these legal regimes are really suited ***539** to the protection of designers from counterfeits as they focus on innovation, creativity and reputation respectively.

Design patents, although they are considered to be the main method for protecting design in the U.S, have numerous disadvantages including the practical (the application process and time and money necessary to achieve protection) and the conceptual (the requirement for an inventive step, and the non-protection of the functional aspects of design). The usefulness of design patents, if any, is limited to innovative design in which there has been substantial financial investment.

Copyright protection provides an artistic work with a very long term of protection--arguably unnecessarily--and is also anti-competitive for industrial products. Copyright also provides a far broader set of exclusive rights than are necessary for designers--or beneficial for their customers--such as the right to object to derivative work. In addition, U.S. legal tradition and the post-Mazer line of judicial decisions and Copyright Office policy decisions interpreting "conceptual separability" make it unlikely that copyright law can now be fashioned into a tool to protect functional industrial design.

Trademarks are likewise generally unsuitable for the purpose of protecting design, given that the focus of trademark law is the protection of the consumer from confusion and the protection of the reputation of the trademark owner, rather than the development of new designs for useful articles. Among other problems, the requirement for "secondary meaning" for the protection of trade dress means that using trade dress to protect design is rarely, if ever, going to protect market-entry designs because it takes time to acquire secondary meaning. The designs which are likely to be protected by the long duration of the trademark monopoly will be well-known designs by well-known designers.

Due to the shortcomings of the three main intellectual property rights--the unwillingness of judges to expand the scope of the different intellectual property protections, or consider an overlap of protections, and the lack of legislative action--the protection of industrial design remains a notable gap in U.S. law.

B. Goals of a Redesign of the Law

1. Balance and Limited Protection

Since counterfeiting is a problem for society as a whole, the goal for any industrial design protection should be two-fold: to prevent knock-off producers who put no original effort into their products from benefiting from the creativity of others, while avoiding stifling the creativity that goes into advances in design. The law should attempt to achieve this balance by providing designers with as limited a protection in terms of length and breadth, as is consistent with prohibiting free-riders. The aim of the law should be to avoid the protection being used by well-established designers to perpetuate a monopoly position for longer than is necessary to recoup their initial investment.

***540** TRIPS suggests that the law should focus mainly on providing protection from copying.[312] Like TRIPS, the European

standard of infringement for design rights follows the approach of protecting originality, rather than novelty. European design laws prohibit exact copies while still permitting derivative work. In order to infringe a prior design, a design must create the same overall impression as the prior design.[313] An unregistered design right is only infringed if copying is proven.[314]

The IDPPPA is an improvement over earlier fashion lobby bills in that it follows the more recent logic of design law internationally by providing a limited protection against copying only. It defines infringement narrowly as a "substantially identical" design and provides an originality standard that protects only designs which "provide a unique, distinguishable, nontrivial and non-utilitarian variation over prior designs."[315] It appears that fashion lobbyists have listened to the criticisms that their earlier bills overprotected designers and could be used to insulate them from legitimate competition as well as prohibiting counterfeiting. There is a question as to exactly how the new standards of infringement and originality in this bill, which are narrower than the copyright standard and use unfamiliar language, will be interpreted by courts. This short-term uncertainty about what type of designs will be protected and what constitutes counterfeiting is an inconvenience but should not dissuade Congress from protecting design.[316]

Commentators, like Raustiala and Sprigman (who spoke to the Subcommittee on the recent bill),[317] express concerns that any additional legal protections against copying would upset the "low-IP equilibrium" that they argue functions so well in the fashion business. As noted, observation of the more legally protected fashion industry in Europe does not appear to entirely bear out their concern.[318] Although it is obviously hard to measure creativity, it is also noteworthy that the cheap chic fashion retailers in Europe employ designers, unlike similar U.S. chains (like Forever 21).[319] The European retailers seem to have perfected an art in taking a high-end design and "reinterpreting" it for mass-market sale, producing it on a large scale, and having a supply chain that gets the new look into the stores very quickly. ***541** European high-end fashion designers also seem less litigious--perhaps realizing that litigation is not always beneficial to their brand[320]--instead relying on design strategies, like making their work difficult to copy.[321]

The lack of protection provided by current U.S. legislation and the growing problem of counterfeiting have together persuaded many observers that legislation is needed to protect all industrial design.[322] IDPPPA has taken many of the criticisms about the broad reach of earlier fashion bills into account. The addition of a definition of infringement and standard of originality tailored very specifically to prohibiting" substantially identical" copies of "unique, distinguishable, nontrivial and non-utilitarian" designs focuses this bill more clearly on protecting originality in designs rather than limiting competition, but the limited focus on one industry is retained.

2. No Registration Requirement

IDPPPA is the first U.S. bill to drop the registration requirement for protecting design. Registration is a formal step requiring knowledge of the law and--in all likelihood--the need to retain an attorney. There are significant advantages to avoiding a registration scheme.[323] Most designers keep design drawings. An organized and dated design portfolio would provide sufficient evidence to prove independent creation and ownership of a particular design. IDPPPA is a great improvement over earlier design bills in providing a right that arises automatically on first sale without the need for a formal application because it puts counterfeiters on notice that they risk legal liability if they copy any new industrial design. The bill remains too narrow in that it just protects designers in one industry--fashion.

3. Flexible Types of Protection

There are different levels of creativity and financial investment in different design industries. This is recognized in the European law by the provision of two different types of protection to be chosen by designers in order to suit the size of their investments in the design. Two levels of legal protection to suit the investment in design could also be achieved quite easily under U.S. law. Under current U.S. law, some more novel industrial designs are able to obtain protection under design patent law, but as pointed out by those opposed to protection for fashion designers, ***542** in fast-moving industries long term protection is unnecessary and harmful. Much new industrial design is obsolete within a matter of years or even months of its creation. The differences between the investments of different designers could be dealt with by providing a short term automatic right to supplement the design protection already provided by patent law. Designers could choose which level of protection was best suited to their investments.

For many designs, a short duration of protection against copying that arises automatically on first sale would be the ideal method to safeguard investment and protect the first-to-market advantage against counterfeiters. It would balance the interests of the designer in securing protection for the investment with the interests of consumers in enabling competition

among designers. For more novel or highly innovative design, the design patent would continue to be available. It would be supplemented by a short-term modified copyright-like right arising without the need for registration.

The shorter term protection for less innovative, but still original, designs is entirely lacking under U.S. law. The IDPPPA could be the vehicle to provide this protection. The registration requirement, which favored well-established designers with attorneys, has now been dropped from the bill. The standard of both infringement and originality was narrowed to avoid charges of overbroad protection of established designers. The principal remaining problem is that this bill continues the focus of all recently proposed design legislation on one industry--the fashion industry. U.S. law needs to be broadened to cover all market-entry industrial design and avoid the piecemeal approach of allowing lobbyists from one industry to write law to promote only their own interests.

4. Originality and Remedies

It is also important to focus on the remedies available for infringement of any design right. Very strong remedies will discourage designers from recycling earlier designs, thus limiting the availability of subsequent copies of these designs to the public. For commonplace designs, this may provide short-term monopoly rights to the first designer. In their article, Originality, Gideon Parchomovsky and Alex Stein suggest applying the concept of property and liability rules in the copyright context.[324] Their suggestion is to calibrate the remedies available to copyright holders according to the level of originality in an author's work.[325] Parchomovsky and Stein maintain that judges already make determinations in copyright cases about the level of creativity in an author's work.[326]

***543** I have argued that this remedy model could also be used for the protection of industrial design.[327] This would increase customer choice by allowing the public access, in certain cases, to several versions of a design. Designers would be able to decide whether it was worth suing to prohibit the use of their earlier design--a very inventive design would obtain injunctive relief, but where the earlier design was itself the result of copying then a damages award would be the main form of relief. This would enable designers to make decisions about whether to sue. Creativity among designers would not be stifled and designers could make informed decisions about the use of earlier designs in subsequent work.

V. Conclusion

Design is increasingly important to global competitiveness and counterfeiting is a growing problem which harms designers and consumers all over the world. International design laws provide some evidence of a developing consensus that all original design should be protected against copying on modified copyright principles. U.S. law does not protect most design adequately with its reliance on patent law principles. The U.S. should join the majority of other jurisdictions and protect market entry design against copying for a period long enough for the designer to recoup the investment in the design. This would benefit designers of new industrial products and the consumers that use them, as well as enabling the U.S. to live up to its obligations under international treaties, particularly TRIPS. The current sui generis law protecting boat hull design--the VHDPA--clearly envisions the possibility of protecting all industrial design by defining original designs of "useful articles." In that act, "useful articles" are currently limited to boat hulls,[328] but the law could easily be applied to all new design with an expansion of the definition of "useful article." Congress should resist the short-sighted proposals by fashion designers to merely expand the law to protect clothing and accessories, and ensure that any new law protects all industrial design. Congress should also avoid the inclusion of any registration requirement for short-term design protection. Design patent law already provides a longer term protection for truly inventive design. Although not without flaws, this law can be used by designers who have invested significant time and money in a novel design. Congress should now concentrate on passing a law which automatically provides a short term of protection to all market-entry design without the need for application. This would give U.S. designers two levels of protection to choose from based upon the level of their investment and the ***544** originality and longevity of the design. The law could be further tempered to avoid overprotecting commonplace designs by the use of remedies calibrated to the amount of creativity in the design.

The only problem with advocating for the inclusion of all industrial design in any new design legislation is the awkward fact that, while the fashion industry in the U.S. has long argued for more protection, there appears to be no major lobbying for protection from other design industries. Does this mean that they believe that current legal protections for industrial designers in the U.S. through copyright, design patents and trademarks are, in fact, adequate?

Footnotes

[1] Design Council, The Impact of Design on Stock Market Performance, Design Council (July 2005), http://www.designcouncil.org.uk/documents/documents/publications/design%20Index% 202005_Design_council.pdf; see also Julie H. Hertenstein, Majorie B. Platt & Robert W. Veryzer, The Impact of Industrial Design Effectiveness on Corporate Financial Performance, 22 J. Prod. Innov. Mgmt. 3-21 (2005) (finding that firms rated as having "good" design were stronger on all measures except growth rate).

[2] See, e.g., Design Council, supra note 1, at 5 (reporting the relationship between the use of design and share price performance of UK-FTSE quoted companies); Hertenstein et al., supra note 1, at 4 (introducing research conducted by Dutch authors on relationship between industrial design and company performance).

[3] James Moultrie & Finbarr Livesey, International Design Scoreboard: Initial Indicators of Inter-national Design Capabilities, Design Council (2009), http://www.designcouncil.org.uk/Documents/Documents/Publicaitons/Research/InternationalDesignScoreboard.pdf

[4] See, e.g., David Goldenberg, The Long and Winding Road: A History of the Fight Over Industrial Design Protection in the United States, 45 J. Copyright Soc'y U.S.A. 21-22 (1997) (stating that good American design generally goes unrewarded).

[5] Infra Section IIIA.

[6] John Heskett, Toothpicks and Logos: Design in Everyday Life 32 (Oxford University Press 2002).

[7] See Goldenberg, supra note 4, at 25 (stating that designers have sought legislation protecting design since 1898).

[8] Design Piracy Prohibition Act: A Bill to Provide Protection for Fashion Design: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Common the Judiciary, 109th Cong. 9 (2006) [hereinafter H.R. 5055 Hearings] (statement of Jeffrey Banks, Designer).

[9] See, e.g., Innovative Design Protection and Piracy Prohibition Act, H.R. 2511, 112th Cong. (2011) [hereinafter IDPPPA] (a bill to amend Title 17, United States Code, to extend protection to fashiondesign and for other purposes); S. 3728, 111th Cong. (2010) [hereinafter S. 3728] (a bill for the same purposes); H.R. 2196, 111th Cong. (2009) [hereinafter H.R. 2196] (a bill for the same purposes).

[10] Ben Winograd & Cheryl Lu-Lien Tan, Style & Substance: Can Fashion Be Copyrighted?--Designers Want to Halt Knockoffs But Some Say They Spur Sales; Few People Can Spend $4,000, Wall St. J., Sept. 11, 2006, at B1.

[11] See Goldenberg, supra note 4, at 26 (stating that designers have never managed to secure the passage of any major design protection reform).

[12] IDPPPA: Hearing on H.R. 2511 Before the Subcomm. On Intellectual Property, Competition, and the Internet of the H. Comm. on the Judiciary, 112th Cong. (2011).

[13] Terence Conran, Terence Conran on Design 197 (Overlook Press 1996).

[14] IDSA Overview, IDSA, http://www.idsa.org/idsa-overview (last visited Mar. 2, 2012).

[15] Orit Fischman Afori, Reconceptualizing Property in Designs, Cardozo Arts & Ent. L.J. 1105, 1107 (2008).

[16] Definition of Design, Int'l Council of Societies of Indus. Design, http://www.icsid.org/about/about/articles31.htm (last visited Mar. 2, 2012).

[17] Carnegie Mellon School of Design, http://www.design.cmu.edu/show_ program.php?s=1 (last visited Mar. 2, 2012) ("[W]e believe design to be a humanistic discipline: the art of conceiving, planning and shaping products that are made to serve people in answer to their individual and collective needs and desires.").

[18] Richard G. Frenkel, Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPS Era, 32 Loy. L.A. L. Rev. 531, 531 (1999).

[19] Conran, supra note 13, at 195.

[20] See Afori, supra note 15, at 1117 (describing the division of intellectual property law into pigeonholes).

[21] See Gideon Parchomovsky & Peter Siegelman, Towards an Integrated Theory of Intellectual Property, 88 Va. L. Rev. 1455, 1455 (2002) (analogizing the current intellectual property theory as six blind persons discerning the shape of an elephant).

[22] George Cox, The Cox Review of Creativity in Business: Building on the UK's Strengths, London: HM Treasury (2005), http://www.hm-treasury.gov.uk/coxreview_index.htm.

[23] Eric Setliff, Copyright and Industrial Design: An "Alternative Design" Alternative, 30 Colum. J. L. & Arts 49, 51-52 (2006).

[24] See J. H. Reichman, Past and Current Trends in the Evolution of Design Protection Law, 4 Fordham Intell. Prop. Media & Ent. L.J. 387, 388 (1993) (stating that the United States adheres to a full patent approach with protecting design).

[25] Daniel H. Brean, Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs, 16 Texas Intell. Prop. L.J. 325, 372 (2008).

[26] J. H. Reichman, Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976, 1983 Duke L.J. 1143, 1169 (1983).

[27] Infra Section II.

[28] Afori, supra note 15, at 1116.

[29] See Daniel H. Pink, A Whole New Mind 84 (2005) (arguing that better design of the ballots could have changed the result of the presidential election in 2000).

[30] Ravi Sawhney & Deepa Prahalad, The Role of Design in Business, Businessweek, Feb. 1, 2010, available at http:// www.businessweek.com/innovate/content/jan2010/id20100127_743970.htm.

[31] Tom Peters, Re-Imagine! Business Excellence in a Disruptive Age 134 (2003).

[32] Pink, supra note 29, at 82-83.

[33] Afori, supra note 15, at 1111.

[34] Id.

[35] Id. at 1112.

[36] Id. at 1112-13.

[37] Heskett, supra note 6, at 44-45.

[38] Moultrie & Livesey, supra note 3, at 14.

[39] See, e.g., Design Council, supra note 1, at 5 (finding effects of design on market performance for UK companies).

[40] Venessa Wong, How Business Is Adopting Design Thinking, Businessweek, Nov. 3, 2009, availa-ble at http:// www.businessweek.com/innovate/content/sep2009/id20090930_853305.htm.

[41] Id.

[42] Pink, supra note 29, at 79-81.

[43] Wong, supra note 40

[44] Design Council, supra note 1, at 5.

[45] Id.

[46] Id.

[47] Hertenstein et al., supra note 1, at 3.

[48] Goldenberg, supra note 4, at 21-22.

[49] Heskett, supra note 6, at 32.

[50] Pink, supra note 29, at 79.

[51] Cox, supra note 22, at 6.

[52] Id. at 7.

[53] Bruce Nussbaum, The Best Global Design of 2008, Businessweek, July 17, 2008, available at http://www.businessweek.com/magazine/content/08_ 30/b4093044731823.htm?.

[54] Moultrie & Livesey, supra note 3, at 48.

[55] Helen Walters, IDEA 2009: Designing a Better World, Businessweek, July 29, 2009, available at http:// www.businessweek.com/innovate/content/jul2009/id20090727_885997.htm.

[56] See generally, IDEA Awards, IDSA, http://www.idsa/org/awards (last visited Mar. 2, 2012) (giving American companies such as Boeing and Windows the coveted "Best in Show" title at the 2011 awards ceremony).

[57] Heskett, supra note 6, at 180.

[58] Id. at 181.

[59] See Cox, supra note 22, at 9 (mentioning the Dutch and Finnish approach).

[60] Heskett, supra note 6, at 184.

[61] Moultrie & Livesey, supra note 3, at 3. Hertenstein, supra note 1.

[62] Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Annex IC, Legal Instruments--Results of the Uruguay Round vol. 31 (1994), arts. 25-26, 33 I.L.M. 1197, 1207 (1994) [hereinafter TRIPS].

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[64] See Reichman, supra note 26, at 1200 (quoting testimony of Arthur Fisher, Register of Copyright, Hearings on S. 2075 and S. 2852 before the Subcomm. on Patents, Judiciary, 86th Cong., 2d Sess. 56) (1960).

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[66] See Raustiala & Sprigman, supra note 65, at 1734 (discussing theory that fashion practices derive from IP law allowing open appropriation of design).

[67] Id. at 1698-99.

[68] See, e.g., Erika Myers, Justice in Fashion: Cheap Chic and the IP Equilibrium in the United Kingdom and the United States, 37 AIPLA Q.J. 47, 55-57 (2009) (detailing the changes in the dynamics of the industry including the change in the business model of high-end designers and the overlap in customer base between high-end designers and cheap chic).

[69] See generally Afori, supra note 15 (describing industrial design as a situated at a crossroads of "art, technology, and the entire industry dedicated to attracting the consumer's attention"); Gold-enberg, supra note 4 (discussing the "breadth of impact that the lack of effective design protection has had on American industry"); Perry J. Saidman, The Crisis in the Law of Designs, 89 J. Pat. & Trademark Off. Soc'y 301 (2007) (arguing that the law of designs is in a state of crisis); Brean, supra note 25 (arguing that patents on designs "should be phased out of existence"); Setliff, supra note 23 (arguing for a new method for determining the copyrightability of industrial design).

[70] Afori, supra note 15, at 1111.

[71] Id. at 1118.

[72] See Reichman, supra note 24, at 388-9 (describing the cyclical pattern of periods of under-pro-tection followed by periods of over-protection).

[73] See, e.g., Afori, supra note 15 (discussing how the major legal paths for protecting industrial design in the U.S. actually leads to only partial protections for some designs and no protection for other designs); Saidman, supra note 69 (arguing that current copyright law fails to protect against the copying of industrial designs); Setliff, supra note 23 (discussing the ambiguity within the legislative history of the Copyright Act and the uneven application of the Act by the courts).

[74] Reichman, supra note 26, at 1164.

[75] The Economic Impact of Counterfeiting and Piracy: Executive Summary (2008), OECD, http://www.oecd.org/dataoecd/57/27/44088872.pdf ("Counterfeit and pirated products crowd genuine products out of the market, lowering the market share of the rights holder, putting downward pressures on prices.").

[76] See id. (using the term for multiple purposes throughout the report).

[77] EU Customs, Report on Community Customs Activities on Counterfeit and Piracy 2 (2007) http://ec.europa.eu/taxation_ customs/resources/documents/customs/customs_controls/counterfeit_ piracy/statistics2007.pdf. [hereinafter EU Customs Report on Counterfeit and Piracy].

[78] OECD, Magnitude of Counterfeiting and Piracy of Tangible Products: An Update (Nov 2009), www.oecd.orgdataOect/57/27/4408872.pdf.

[79] Cox, supra note 22.

[80] Id. at 6.

[81] Id.

[82] Id. at 8.

[83] See The Economic Impact of Counterfeiting and Piracy, supra note 75, at 13 (describing China a being the largest source economy in Asia, which is the largest source of counterfeit and pirated products).

[84] Id.

[85] Tiffany v. eBay, 576 F. Supp. 2d 463, 486 (S.D N.Y. 2008).

[86] See Sofia H. Ahmed, Life, Liberty, and the Pursuit of Luxury: eBay's Liability for Contributory Trademark Infringement in the United States, Germany, and France, 5 B.Y.U. Int'l L. & Mgmt. Rev. 247, 248 (2009).

[87] Id.

[88] The Economic Impact of Counterfeiting and Piracy, supra note 75.

[89] Department of Justice, Progress Report of Task Force on Intellectual Property (2006), http://www.justice.gov/criminal/cybercrime/2006IPTFProgressReport(6-19-06).pdf. [[hereinafter DOJ Report].

[90] EU Customs Report on Counterfeit and Piracy, supra note 77.

[91] The Economic Impact of Counterfeiting and Piracy, supra note 75, at 6.

[92] Id. at 4.

[93] Id. at 17.

[94] Id.

[95] Id. at 17-18.

[96] Id. at 18.

[97] The Economic Impact of Counterfeiting and Piracy, supra note 75, at 17.

[98] Id. at 18-19.

[99] Id. at 18.

[100] Id.

[101] Id.

[102] Id.

[103] The Economic Impact of Counterfeiting and Piracy, supra note 75, at 20.

[104] Id. at 19.

[105] Id.

[106] Magnitude of Counterfeiting and Piracy of Tangible Products: An Update, supra note 78, at 1.

[107] See The Economic Impact of Counterfeiting & Piracy, supra note 75, at 21 ("Information on counterfeiting and piracy falls far short of what is needed for rigorous analysis and for policymaking.").

[108] Id. at 9.

[109] Id. at 7.

[110] Id. at 13.

[111] Id. at 11.

[112] Id. at 13.

[113] The Economic Impact of Counterfeiting and Piracy, supra note 75, at 14.

[114] Goldirova Renata, Counterfeit Goods Flood Europe, Businessweek, June 1, 2007, available http:// www.businesweek.com/globalbiz/content/jun2007/gb20070601_909719.htm.

[115] See Design Awards: Knocking off the Knock-Offs, Businessweek, March 25, 2009, available at http:// www.businessweek.com/innovate/content/mar2009/id20090325_296592.htm (discussing counterfeit products in the German market).

[116] Renata, supra note 114.

[117] Matthew Benjamin, A World of Fakes: Counterfeit goods threaten firms, consumers, and national security, U.S. News & World Report, Jul. 6, 2003, available at http:// www.usnews.com/usnews/culture/articles/030714/14counterfeit.htm.

[118] DOJ Report, supra note 89, at i.

[119] Id. at 1.

[120] Id. at 2.

[121] Id. at 9-10.

[122] Id.

[123] Id. at 5.

[124] DOJ Report, supra note 89, at 13.

[125] Id.

[126] Id. at 17-35.

[127] Id. at 26.

[128] EU Customs Report on Counterfeit and Piracy, supra note 77, at 4.

[129] Id. at 7.

[130] See id. at 8 (reporting a slower increase than the 264% jump in 2006).

[131] Id. at 9.

[132] Id. at 11.

[133] Id. at 19.

[134] Id.

[135] Id. at 11.

[136] The Economic Impact of Counterfeiting and Piracy, supra note 75, at 14; DOJ Report, supra note 89, at 13.

[137] Design Awards, supra note 115.

[138] Id.

[139] Id.

[140] See Robert C. Denicola, Freedom to Copy, 108 Yale L.J. 1661, 1663 (1999) (discussing how trademark threatened the limited protections given to designs by patent and copyright laws).

[141] Afori, supra note 15, at 1123.

[142] See Denicola, supra note 140, at 1670-1672 (stating that "[d]esign features should be protected only when genuinely distinctive of a particular source").

[143] See Parchomovsky & Siegelman, supra note 21, at 1457 (noting that the U.S. Supreme Court intellectual property jurisprudence treats the constituent fields "as discrete and insular").

[144] See, e.g., Saidman, supra note 69, at 303-304 (summarizing the problem of design patent).

[145] Reichman, supra note 24, at 388-89.

[146] Id. at 389.

[147] See Setliff, supra note 23, at 51 ("[I]ndustrial design actually embodies aesthetic expression to a much greater extent than function.").

[148] Reichman, supra note 24, at 388.

[149] Id. at 398.

[150] Setliff, supra note 23, at 51.

[151] Afori, supra note 15, at 1156.

[152] See id. at 1158 (describing how "unity of design" will eliminate the impossible procedure of differentiating between designs).

[153] See Reichman, supra note 24, at 388 (stating that "[h]istorically, many countries tried to rectify the underprotection characteristic of a full patent model by opening their copyright laws to industrial designs, and France remains the most prominent adherent to this "unity of art" approach").

[154] 35 U.S.C. § 171 (2006).

[155] See Reichman, supra note 26, at n.132 (describing how before the introduction of the unregistered design right in the Copyright Designs and Patents Act 1988, U.K. law protected work without any artistic merit).

[156] Feist Publ'ns., Inc. v. Rural Tel. Serv. Co. 499 U.S. 340, 353-355 (1991).

[157] Id. at 345.

[158] Id. (citing 1 M. Nimmer & D. Nimmer, Copyright § 1.08 (1990)).

[159] See Reichman, supra note 26, at 1161 (describing how the German copyright regime protects some exceptional designs but rejects most industrial design as lacking the requisite degree of artistic intensity or value).

[160] Robert Denicola, Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 Minn. L. Rev. 707, 718 (1983).

[161] Afori, supra note 15, at 1122.

[162] See Project Runway: Sew Much Pressure (Lifetime Network Television broadcast Apr. 1, 2010), available at http://www.youtube.com/watch? v=aq2UswGQHSL8 (the catchphrase of the popular Bravo TV series (now on Lifetime Network) Project Runway is "[i]n fashion, one day you're in, and the next day you're out").

[163] Afori, supra note 15, at 1122.

[164] See Denicola, supra note 140, at 739-743 (copyright "ultimately should depend on the extent to which the work reflects artistic expression uninhibited by functional considerations").

[165] Brandir Int'l Inc. v. Cascade Pac. Lumber 834 F.2d 1142, 1145 (2d Cir. 1987).

[166] Id. at 1146-7.

[167] Council Regulation 6/2002, 2001 O.J. (L. 3/1) 1,4 (EC).

[168] Reichman, supra note 24, at 388-89.

[169] Afori, supra note 15, at 1108-09.

[170] Id. at 1158-60.

[171] Id.

[172] Id. at 1159.

[173] Id.

[174] Id. at 1160-62.

[175] Afori, supra note 15, at 1128.

[176] Paris Convention for the Protection of Industrial Property of 1883 art. 4, July 4, 1967, 21 U.S.T. 1583 [hereinafter Paris Convention].

[177] Berne Convention for the Protection of Literary and Artistic Works art. 6bis, Sept. 9, 1886, revised July 24, 1971, amended Sept. 29, 1979, 828 U.N.T.S. 221 [hereinafter Berne Convention].

[178] Afori, supra note 15, at 1129.

[179] The Hague Arrangement on the International Deposit of Industrial Designs or Models, November 6, 1925, 74 L.N.T.S. 179 [hereinafter Hague Agreement].

[180] The Hague System: A Useful Tool for Corporations & Individual Designers Alike, WIPO Magazine (May 2005), available at http:// www.wipo.int/wipo_magazine/en/2005/03/article_0006.html (last visited Feb. 21, 2012).

[181] Id.

[182] Id.

[183] Hague System for International Registration of Industrial Designs, WIPO http://www.wipo.int/hague/en/ (last visited Feb. 21, 2012).

[184] Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, Rule 18: Notification of Refusal, WIPO, available at http:// www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/hague_common_ regulations.pdf.

[185] Reichman, supra note 26, at 1161-1164.

[186] Id. at 1145-46.

[187] Id. at 1149-64.

[188] Id. at 1156-58.

[189] Id. at 1161.

[190] Id.

[191] Richman, supra note 26, at 1162.

[192] Id. at 1161-62.

[193] Id. at 1163-64.

194 Paris Convention, supra note 176, at 1639.

195 Convention Establishing the World Intellectual Property Organization, July 14, 1967, 2 U.S.T.1749, available at http:// www.wipo.int/export/sites/www/treaties/en/convention/pdf/trtdocs_wo029.pdf.

196 Reichman, supra note 26, at 1165.

197 Id. at 1166-67.

198 TRIPS, supra note 62.

199 Id. at 1197-98.

200 Members and Observers, wto.org, available at http:// www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Mar. 13 2012).

201 TRIPS, supra note 62, art. 25.

202 Id.

203 Id.

204 Id.

205 Frenkel, supra note 18, at 533.

206 35 U.S.C. § 173 (2006).

207 Frenkel, supra note 18, at 534.

208 Afori, supra note 15, at 1128.

209 See Mario Franzosi, Design Protection Italian Style, 1 J. of Intell. Prop. Law & Practice 599 (2006) (describing inscindibilita--the old Italian position denying copyright protection to works of design--as too harsh).

210 See Afori, supra note 15, at 1173 (noting that English law has moved from a patent to a modified copyright approach to the protection of design). See also, Reichman, supra note 24, at 388 (discussing how there is a cyclical pattern that swings from over-protection of industrial design to underprotection).

211 See Proposal for a European Parliament and Council Directive on the legal protection of designs, COM (1993) 344 final (Dec. 3, 1993) (providing a comprehensive framework for the EU to protect design).

212 See id. at pmbl.3 (noting that the differences in design protection regimes across EU member states negatively impacts the market).

[213] Council Directive 98/71, (1), 1998 O.J. (L 289) 28 (EC) [[hereinafter Design Directive].

[214] Council Regulation 6/2002, 2002 O.J (L 3/1) [hereinafter Design Regulation].

[215] Compare Design Directive, supra note 213, art. 9 & 10 (stipulating that the term of protection is five years, renewable in five year increments "up to a total term of 25 years"), with Design Regulation, supra note 214, at L 3/5 (stipulating the same).

[216] See Design Regulation, supra note 214, at L3/5 ("A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.").

[217] Id.

[218] Design Directive, supra note 213, at L289/29.

[219] Id. at L289/28.

[220] Id. at L289/29.

[221] Id. at L289/31.

[222] Id. at L289/28.

[223] Id. at L289/29.

[224] See generally Bernt Hugenholz et al., The Recasting of Copyright &Related Rights for the Knowledge Economy (2006), available at http://ec.europa.eu/internal_market/copyright/docs/studies/etd2005imd195recast_ report_2006.pdf (assessing the inconsistencies in copyright regimes across the EU and the steps it has taken to harmonize the field).

[225] Design Regulation, supra note 214, at L3/1.

[226] Id. at L 3/7.

[227] Id. at L 3/4. A design is considered "new" if no identical design has been made available to the public, and designs are deemed to be identical if their features differ only in immaterial details. A design has 'individual character' if the overall impression the design produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.

[228] Id. at L 3/5.

[229] Copyright Designs and Patents Act, 1988, c. 48, § 220 (Eng.).

[230] Id. § 216.

[231] Id. § 226.

[232] British Leyland Motor Corp. v. Armstrong Patents Co., [1986] A.C. 577 (U.K.) (allowing copyright protection in a two dimensional drawing to prohibit the creation of a three dimensional design from the drawing).

[233] See Afori, supra note 15, at 1173 (discussing two cases in which the House of Lords found infringement through the copying of two-dimensional drawings).

[234] Id.

[235] See Afori, supra note 15, at 1107 (stating that U.S. design law is stagnant).

[236] See, e.g., Dana Beldiman, Protecting the Form But Not the Function: Is U.S. Law Ready for a New Model?, 20 Santa Clara Computer & High Tech. L.J. 529, 534 (2004) (describing the continuous expansion of IP law in the U.S.).

[237] Id. at 532.

[238] See, e.g., Frenkel, supra note 18, at 534 (asserting that courts are weary of using trademark and unfair competition law to protect design, which is why there is an increase of copyright law pro-tecting design).

[239] See Beldiman, supra note 236, at 540 (stating that because trade dress closely borders both copyright and design patents, over-extending trade dress protection will frustrate the policy rationales of copyright and design patents).

[240] See Moultrie & Livesey, supra note 38 (showing that, based on a number of metrics and described in absolute terms, the U.S. has the largest design industry on the planet).

[241] See DOJ Report, supra note 89, at 2 (using a number of the DOJ's achievements to demonstrate that it has made intellectual property enforcement a priority).

[242] See, e.g., The Economic Impact of Counterfeiting & Piracy, supra note 75, at 2 (noting generally the significant impacts of piracy and counterfeiting in a variety of areas).

[243] Act of Aug. 29, 1842, ch. 263, §3, 5 Stat. 543, 544 (1842) (codified as 35 U.S.C. §171 (2006)).

[244] See Brean, supra note 25, at 326-27 (noting both the difficulty of classifying product design and the fact that the Commissioner of Patents requested that patent law cover designs).

[245] Id. at 327.

[246] See id. at 330-31 (tracing the development of protection for three-dimensional objects under the Copyright Act).

[247] Vessel Hull Design Protection Act of 1997: Hearing on H.R. 2696 Before the H. Subcomm. On Courts and Intellectual Property, 105th Cong. (1997) (statement of Marybeth Peters, Register of Copyrights).

[248] Id. at 556-683 (noting that even when a designer applies for a design patent the Patent and Trademark Office rejects the application roughly half the time).

[249] Egyptian Goddess v. Swisa, Inc., 543 F.3d 665, 683 (Fed. Cir. 2008).

[250] See generally Afori, supra note 15, at 1122-23; Frenkel, supra note 18, at 555-56 (discussing the problems inherent in the fact that design patents protect ornamentation).

[251] William T. Fryer, The Evolution of Market Entry Design Protection, 21 (12) EIPR 618, 620 (1999). An application for a design patent is subject to substantive review by a patent examiner to determine if it is eligible for protection; this process takes approximately two years, and protection is not retroactive. For many areas of industrial design this length of time makes an application for a design patent unappealing - the market is often simply too fast-moving for this protection to ar-rive in time to help a designer fight fakes. The counterfeiters will immediately start copying the design and will in fact, probably be assisted by the details published in the application for registration.

[252] See id. (discussing the process of manufacturing ship hulls with molds).

[253] Frenkel, supra note 18, at 555.

[254] See Beldiman supra note 236, at 53 (explaining the history of how the Copyright Office came to protect the forms of utilitarian objects).

[255] See Mazer v. Stein, 347 U.S. 201, 206 (1954) ("The case requires an answer ... to an artist's right to copyright a work of art intended to be reproduced for lamp bases.").

[256] Id. at 217.

[257] Id. at 218 (emphasis added).

[258] See Reichman, supra note 26, at 1152 ("The Court held that the distinction between 'fine arts' and 'useful works of art' had ended with the 1909 Act's deletion of the fine arts clause of the 1870 act.").

[259] Id. at 1174.

[260] Id. at 1176.

[261] 17 U.S.C. § 1302(4) (2006). Under 17 U.S.C. § 101, "useful articles" are defined as "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."

[262] See Mazer, at 218-19 ("The dichotomy of protection for the aesthetic is not beauty and utility but art for the copyright and the invention of original and ornamental design for design patents.").

[263] See Robert C. Lind, Copyright Law 40 (3d ed. 2006) (noting the split of authority regarding the test of conceptual separability); Brandir Int'l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145 (2d Cir. 1987) (holding that the designer must have intended to exercise artistic judgment independent of functional influences); Poe v. Missing Persons, 745 F.2d 1238, 1243 (9th Cir.1984)

(employing a multifactor test); Carol Barnhart, Inc. v. Economy Cover Corp., 773 F.2d 411, 419 (2d Cir. 1985) (holding artistic features of the article must be superfluous or wholly unnecessary to the performance of the utilitarian function).

264 Reichman, supra note 26, at 1171.

265 See Frenkel, supra note 18, at 533 (disclaiming President Clinton's assertion that legislation im-plementing TRIPs adequately protects industrial design).

266 See Reichman, supra note 24, at 390 (lamenting the fact that sui generis design law has not been implemented).

267 Ralph S. Brown, Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition, 33 J. Copyright Soc'y U.S.A. 301, 309 (1986) (transcript of the Sixteenth Donald C. Brace Memorial Lecture).

268 See Saidman, supra note 69, at 304-306 (discussing the Supreme Court's efforts to roll back trade dress protection in Wal-Mart and TrafFix).

269 Id. at 305.

270 See Afori, supra note 15, at 1124 ("[T]he design must function as a means to identify the origin of goods.").

271 Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 214 (2000).

272 Id. at 216.

273 Id. at 214.

274 Raustiala & Sprigman, supra note 65, at 1703.

275 Wal-Mart at 208.

276 Id. at 216.

277 Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 165 (1995).

278 See Setliff, supra note 23, at 55 (discussing changes made to Copyright law industrial design).

279 See Saidman, supra note 69, at 310 (discussing how courts have limited industrial design protection).

280 Id. at 306.

281 Architectural Works Copyright Protection Act of 1990, Pub. L. No. 101-650, §§ 701-06, 104 Stat. 5089 (codified in scattered sections of 17 U.S.C.).

[282] See, e.g., Shelley C. Sackel, Art is in the Eye of the Beholder: A Recommendation for Tailoring Design Piracy Legislation to Protect Fashion Design and the Public Domain, 35 AIPLA Q. J. 473, 486-87 (2007) (noting that, unlike other signatories of the Berne Convention and TRIPS, the U.S. has not provided protection for fashion designs).

[283] Message from the President of the United States, Transmitting the Uruguay Round Table Agree-ments, Texts of Agreements Implementing Bill, Statement of Administrative Action and Required Supporting Statements 1-2 (1994) (noting the "protection currently available under U.S. patent and copyright law meets the requirements of these articles.").

[284] Semiconductor Chip Protection Act of 1984, § 301, 98 Stat. 3347 (2006) (codified at 17 U.S.C. §§901-14).

[285] Vessel Hull Design Protection Act, §§501-02, 112 Stat. 2860 (2006) (codified at 17 U.S.C. §§1301-32).

[286] Bonito Boats v. Thunder Craft Boats Inc., 489 U.S. 141, 159 (1989).

[287] Response to Copyright, Trademark and Patent Office Request for Comments on the Vessel Hull Design Protection Act submitted by William T. Fryer III (March 18, 2003).

[288] 17 U.S.C. § 1310.

[289] 17 U.S.C. § 1301(b)(1).

[290] 17 U.S.C. § 1305.

[291] See Susan Scafidi, Presidential Power, Counterfeit Chic (March 12, 2007, 12:03 EDT), http://www.counterfeitchic.com/2007/03/presidential_ power.php (quoting CFDA president Diane Von Furstenburg in an interview with Women's Wear Daily addressing counterfeiters: "Beware .. [t]here is no money, there is nothing that will stop me from going after you.").

[292] See Jessica Litman, Digital Copyright, The Art of Making Copyright Law, 23 (2001) (commenting on how what was originally designed to include representation by those affected has turned into a powerful lobby that can block bills that do not go through its approval process).

[293] See IDPPPA: Hearing on H.R. 2511 Before the Subcomm. On Intellectual Property, Competition, and the Internet of the H. Comm. on the Judiciary, 112th Cong. (2011) (discussing testimony of the proposed bill).

[294] Blackmon, supra note 65, at 134.

[295] See H.R. 5055 Hearings, supra note 8 (applauding proponents of the legislation for seeking a modest term of protection that is appropriate for the nature of fashion design).

[296] 17 U.S.C. § 1301 (b)(1) (2006).

[297] S. 3728, supra note 9, § 2(c).

[298] Id. § 2(b).

[299] 17 U.S.C. § 106 (2006).

[300] See Raustiala & Sprigman, supra note 65, at 1705 (discussing the problem with design patents).

[301] See Myers, supra note 68, at 80 (arguing that too wide a protection would hamper the formation of trends and damage the industry).

[302] See Susan Scafidi, Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright, Counterfeit Chic (August 6, 2010), http://counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html (summarizing provisions of the IDPPA).

[303] H.R. 5055 Hearings, supra note 8 (prepared statement of Jeffrey Banks, Designer).

[304] See, e.g., The Economic Impact of Counterfeiting and Piracy, supra note 75, at 4 (discussing the expansion of copying worldwide).

[305] Id. at 12.

[306] See The Economic Impact of Counterfeiting and Piracy, supra note 75, at 5 (discussing the grow-ing problem for designers).

[307] See Raustiala & Sprigman, supra note 65, at 1726-27 (discussing why a copy is advantageous for designers).

[308] Id.

[309] See Hemphill & Suk, supra note 65, at 1181 (pointing out that Raustiala and Sprigman's "analysis does not distinguish close copies from other relationships between fashion designs, such as inter-pretation, adaptation, homage or remixing.").

[310] Id. at 1161.

[311] See, e.g., Goldenberg, supra note 4, at 61-62 (noting that the "lack of any solid protection has led to a tangled and complex mess of quasi-protection").

[312] See TRIPS, supra note 62 (establishing that the IP regimes of member states should allow the owner of a protected industrial design "to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or sub-stantially a copy, of the protected design.").

[313] Council Regulation 6/2002, 10(1) 2002 O.J. (L3/5).

[314] Id. art 19 (2).

[315] S. 3728, supra note 9, § 2(a)(2).

316 See Monseau, supra note 63, at 51-55 (discussing criticisms of the design bills including S. 3728).

317 IDPPPA: Hearing on H.R. 2511 Before the Subcomm. On Intellectual Property, Competition, and the Internet of the H. Comm. on the Judiciary, 112th Cong. (2011) at 74-78.

318 See Myers, supra note 68, at 78 ("[T]he comparison between the U.S. and the U.K. suggests that IP protection for fashion design is mildly beneficial to the industry and to consumers.").

319 Id. at 67.

320 Id. at 76.

321 See id. (noting that Balenciaga, a high-end couture brand, incorporates design features that "cannot be copied inexpensively and well").

322 See, e.g., Blackmon, supra note 65 (opining that "with the introduction of the Design Piracy Prohibition Act comes a hope that fashion designers will for once be respected and recognized, like those before them, for their creative contributions to our society"); Hemphill & Suk, supra note 65 (proposing a new intellectual property right that would protect industrial designs from close copies); Myers, supra note 68 (noting that, un-established designers and labels are especially deserving of protection because "copying stymies their efforts to build a brand").

323 See Monseau, supra note 63, at 70 (discussing why the benefits of registration can be realized without it).

324 Gideon Parchomovsky & Alex Stein, Originality, 95 Va. L. Rev. 1505, 1508 (2008).

325 Id. at 1507. A very inventive piece would be protected by a strong property right, an injunction would be available for breach, while a less creative piece would be protectable by a liability right.

326 Id. at 1523.

327 See Monseau, supra note 63, at 72. Only the most inventive design would be eligible for injunc-tive relief, and the infringement of more commonplace designs would result in damages awards only. This would assist design right holders, copyists and the public. It would protect creative designs more strongly than commonplace designs. Designs with a low level of creativity would still be protected but designers would not be able to prohibit others entirely from using their designs. This would enable an infringer to determine of it was financially worthwhile to copy a particular design.

328 17 U.S.C. §§ 1301-32 (2006).