

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

Joshua D. Sarnoff[†]

TABLE OF CONTENTS

I.	INTRODUCTION	170
I.	HISTORICAL LEGISLATIVE CATEGORY ERRORS OF UTILITARIAN FUNCTION, AESTHETICS, AND TYPE OF PROTECTION	172
A.	1842 ORIGINS AND CONFUSING COPYRIGHT AND PATENT	172
B.	POST-1842 CHANGES TO FOCUS ON ORNAMENTALITY BUT CONTINUED CONFUSION OVER FUNCTIONAL UTILITY	174
C.	POST-1870 ACT INTERPRETATIONS TO CREATE EXTRA-STATUTORY COPYRIGHT-LIKE STANDARDS AND TRADEMARK-LIKE PROTECTIONS, AND CONTINUING UTILITY CONFUSION	177
II.	HISTORICAL JUDICIAL CATEGORY ERRORS OF REFERENTS AND ARTICLE OF MANUFACTURE	181
III.	DESIGN AS A WHOLE AND THE EXACERBATION OF FUNCTIONAL PROTECTION THROUGH PARTIAL DESIGN PATENTS	188
IV.	PARTIAL DESIGN PATENTS AS THEFT OF THE PUBLIC'S RIGHT OF REPAIR	190
V.	CONCLUSION	194

DOI: <https://doi.org/10.15779/Z38PN8XG4C>

© 2021 Joshua D. Sarnoff.

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

I. INTRODUCTION

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

Affording protection for functional advances short of applying the *utility* patent law's more exacting novelty, nonobviousness, and disclosure requirements would be, as the Supreme Court observed in denying copyright protection for a system of accounting (and the associated lined forms), "a surprise and a fraud upon the public" and undermine free competition.¹

But their cogent analysis fails to focus adequately on the harm to the public from such fraud and restricts the scope of the fraud to functionality. Instead, I argue that design patents and the law surrounding them have been a series of category errors from the beginning. It is therefore unsurprising that things have only become worse since 1842, and not just for functionality doctrine.

The entire concept of a design patent is "a surprise and a fraud upon the public," and it is the public that loses its rights (and pays from its metaphorical wallet) when that fraud occurs. Unfortunately, we have doctrines of judicial and legislative immunity that protect these judicial and legislative "thieves" of (and not just fraudsters on) the public's rights, and these doctrines prevent the stolen money from being compensated (including through takings law, as the public can lose its entire rights to private propertization without compensation, but not the other way around). "Property is theft"² for designs as much as for realty. And treating designs as patents and keeping the public from making those designs without even copying them or when copying only functions unprotected by utility patents,³ under the bad historical developments that

1. Peter S. Menell & Ella Corren, *Design Patent Law's Identity Crisis*, 36 BERKELEY TECH. L.J. 1, 6 (2021) (quoting *Baker v. Selden*, 101 U.S. 99, 102 (1879)).

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

3. Note that the focus here is on the nature of the exclusive right and what is protected. This is not to suggest that we should protect designs like copyrights in regard to abstract works not limited to specific things the designs embody, which might then expand design protection scope relative to current design-patent doctrine. Cf. *Curver Luxembourg SARL v. Home Expressions, Inc.*, 938 F.3d 1334, 1339–43 (Fed. Cir. 2019) (restricting design protection to the claimed articles of manufacture of which they are a part); *id.* at 1340 ("For over one hundred years, the Patent Office has made clear that it does not grant patents for designs disembodied from an article of manufacture."); see generally Sarah Burstein, *Not (Necessarily) Narrower: Rethinking the Relative Scope of Copyright Protection for Designs*, 3 IP THEORY Art. 4 (2013). Nor do I mean to suggest that infringement would be found on the basis of copying functional aspects alone, but rather that we might limit infringement to copying only sufficiently creative

Menell and Corren criticize,⁴ only makes the theft more costly to the public. We should eliminate design patents, and if we are to protect the ornamentality of designs for useful articles, I would create a *sui generis* right that incorporates only some aspects of claiming and examination from our design patent regime.

To make my point, principally about judicial theft, but starting with legislative theft and bad drafting, I'll highlight four issues. In Part II, I'll address historical category errors for designs, particularly that the ornamental (aesthetic) aspects are the only ones that are supposed to receive protection, and thus design protection was never appropriately placed within a technological patent statute having doctrines intended for technological evaluations.⁵ Since 1624, we have increasingly restricted the grant of patent rights to *technological* advances.⁶ Design patents are thus an aberration.⁷ In Part III, I'll address some doctrinal errors that build off of this category error concern and off of the insights of Menell and Corren. These include: the failure to appreciate that an "article of manufacture" is neither a "machine" nor a produced product unless that product is functional in itself; and the incongruity that design patent standards for novelty (but not nonobviousness) and for infringement are viewed from the perspective of an ordinary observer rather than the hypothetically skilled technological (or, for designs, aesthetic) artisan. These category errors makes design patent a chimera of trademark and copyright law that should have no place in our intellectual property zoo.⁸ In

ornamentation when also copying functional features, elements, and aspects. *See infra* notes 91–94 and accompanying text; cf. Sarah Burstein, *Intelligent Design and Egyptian Goddess: A Reply to Professors Buccafusco, Lemley & Masur*, 68 Duke L.J. Online 94, 109–14 (2019) (arguing that explicitly filtering out functionality may not change infringement determination outcomes).

4. *See generally* Menell & Corren, *supra* note 1; Jason J. Du Mont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTELL. PROP. L. 261 (2012).

5. *See, e.g.*, *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 267 (1850) (“[T]hat degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful [sic] *mechanic*, not that of the inventor.” (emphasis added)).

6. Statute of Monopolies, 21 Jac. I, ch. 3 (1624) (Eng.); *see, e.g.*, Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 909 (2002).

7. However, I will not address here whether design patents are also unconstitutional as not within the “useful Arts” or as not “Discoveries” of “Inventors,” or are otherwise within Commerce Clause power. U.S. CONST., art. I, § 8, cl. 3, 8.

8. Trademark law, as consumer protection, sensibly focuses on the “ordinary purchaser” of products as the ordinary observer to assess aesthetic confusion. *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 422 (2015) (“‘Commercial impression,’ like most issues in trademark law, should be determined from the perspective of the ordinary purchaser of these kinds of goods or services.” (citation omitted)). Copyright law less sensibly focuses on the ordinary observer (rather than the skilled fine artisan in the relevant field) to assess aesthetic

Part IV, I'll address the most recent important conceptual error—partial (and fragment⁹) design protection authorized in 1980 by Judge Giles S. Rich and the U.S. Court of Appeals for the Federal Circuit in *In re Zahn*¹⁰—that makes functionality doctrine even worse, based on the failure to understand that a design is a whole. Finally, in Part V, I'll address how the partial (and fragment) design patentability doctrine has eliminated the public's right to repair their purchased products using unauthorized third-party parts that embody such partial (or fragment) design patents. This expanded protection is contrary to the patent law repair and exhaustion doctrines, the latter of which the Supreme Court recently held was not merely a function of implied license but rather a matter of fundamental patent policy.¹¹ In short, I complement Menell and Corren's article as a serious critique of the inconsistencies of one particular aspect of the history, theory, and doctrine of design patent law—functionality and ornamentation. But I hope to show that design patent law is unnatural metaphysics and doctrinal jackalopes all the way down.

I. HISTORICAL LEGISLATIVE CATEGORY ERRORS OF UTILITARIAN FUNCTION, AESTHETICS, AND TYPE OF PROTECTION

A. 1842 ORIGINS AND CONFUSING COPYRIGHT AND PATENT

Menell and Corren's article describes the origins of design patent protection in the United States as an “effort to transplant England's design *copyright* regime” by adopting a “misabeled law” of “design patent[s]” that “served as a proto-federal trademark registration system before Congress established trademark protection in the mid to late 19th century.”¹² I won't repeat most of (but will refer extensively to) their ornamental tracing of that

“substantial similarity.” See, e.g., *Abdin v. CBS Broad. Inc.*, 971 F.3d 57, 66 (2d Cir. 2020) (“The standard test for substantial similarity between two items is whether an ordinary observer . . . regard[s] [the] aesthetic appeal as the same” (citation omitted)).

9. For further definition and elaboration, see Sarah Burstein, *How Design Patent Law Lost Its Shape*, 41 CARDOZO L. REV. 555, 568 (2019).

10. *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980); cf. Menell & Corren, *supra* note 1, at 52 (“Judge Giles Rich[s] protectionist predilection defined his long career . . .”).

11. See *Impression Products, Inc. v. Lexmark Intern. Inc.*, 137 S. Ct. 1523, 1534 (2017) (“The misstep in this logic is that the exhaustion doctrine is not a presumption about the authority that comes along with a sale; it is instead a limit on ‘the scope of the *patentee's rights*.’” (citation omitted)); but see Sean M. O'Connor, *The Damaging Myth of Patent Exhaustion*, 28 Tex. Intell. Prop. L.J. 443, 446 (2020) (“[T]he Supreme Court would not adopt key parts of the modern exhaustion doctrine in cases involving actual sales of goods until decades [after *Bloomer v. McQuewan*, 55 U.S. (14 How.) 539 (1852)]: 1873 for a use right on purchased goods, and 1895 for a right of resale.”).

12. Menell & Corren, *supra* note 1, at 7.

history, although I generally agree with their detailed discussion. In particular, I commend their discussion of how judicial misinterpretation led to confusion over design patents as providing trademark-like or copyright-like protection in the context of a patent statute (a point that I'll return to in the next section). Instead, I want to focus here on a few of the conceptual category errors of Congress (and only secondarily of the courts) during this development.

When first enacted by Congress in 1842, the design patent subject matter eligibility provision applied to the aesthetic aspects of various categories of complete, manufactured, *functionally useful* products. These were: a “manufacture”; printed “fabrics”; impressions or ornaments on “any article of manufacture” in marble or other material; patterns and pictures “worked into or worked on, or printed, painted, cast, or otherwise fixed” on “any article of manufacture”; any “shape or configuration” of “any article of manufacture”; and various kinds of “statue.”¹³ The last category—statues—is commonly understood in the present to have ornamental rather than utilitarian “function.” But the category of statues is notable, as most two-year-olds who play the game “One of These Things” would say, as being “not like the others.” Menell and Corren,¹⁴ and Janis and Du Mont,¹⁵ attribute the inclusion of statues to the political economy of seeking to impose copyright-like protection¹⁶ at a time when copyright did not yet legislatively extend to statues as “writings” of “authors” within the legislative grant of power in the Constitution. But at the time, statues may have been thought to possess a “utilitarian” function in instilling public values,¹⁷ and thus could be better understood for inclusion along with more obviously functional, utilitarian objects like fabrics and articles of manufacture.

Menell and Corren—and earlier Du Mont and Janis—have traced the political economy and international trade concerns behind these category

13. Act of Aug. 29, 1842, ch. 263, sec. 3, 5 Stat. 543, 543–44.

14. See Menell & Corren, *supra* note 1, at 8 (“[C]opyright protection extended only to books, maps, charts, and prints, not to three-dimensional works.”).

15. See Jason John Du Mont & Mark D. Janis, *The Origins of American Design Patent Protection*, 88 IND. L.J. 837, 868 (2013) (“Ellsworth’s proposal (and the design patent legislation as ultimately enacted) covered works of fine art (statues, for example), in addition to traditionally manufactured goods.”).

16. Providing such protection restricted the public’s ability to freely *copy* such works when “publicized,” notwithstanding the “sincerest form of flattery” implied of the sculptor thereby. See, e.g., CHARLES C. COLTON, LACON: OR MANY THINGS IN FEW WORDS, ADDRESSED TO THOSE WHO THINK (1820); see U.S. CONST., art. I, § 8, cl. 8.

17. Cf., e.g., Alisha Ebrahimji, Artemis Moshtaghian & Lauren M. Johnson, *Confederate Statues Are Coming Down Following George Floyd’s Death. Here’s What We Know*, CNN (July 1, 2020), <https://www.cnn.com/2020/06/09/us/confederate-statues-removed-george-floyd-trnd/index.html>.

confusions, in particular the desire of Commissioner Henry Ellsworth to expand the Patent Office's fiefdom.¹⁸ The evidence belies that Congress had in mind any clear understanding of the categories of things for which it was seeking to provide aesthetic protection against copying, using patent concepts of utilitarian exclusive rights that did not require copying to effectuate.¹⁹ Perhaps all of the subsequent category confusions would have been avoided had Congress kept design patent protection as a copyright bill, and had dealt with functionality (albeit also poorly²⁰) under copyright law.²¹

The central point is that Congress legislated the loss of the public's rights to freely copy aesthetic aspects of functional products based on protectionist urges and went well beyond that point. Congress protected even against copying of *functional aspects* not protected by utility patents and independent creation of functional products having the same aesthetic aspects. If Congress was going to pick the public's pocket, one would have hoped that Congress could have done so more cleanly and without generating so much fuss, confusion, and unnecessary litigation.

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

The 1842 Act created substantial confusion over interpretation, given both its unclear purposes and its category-blurring language. Under the 1842 Act, the patent-eligible design had to be “invented or produced” and had to be “new and original,” except for patterns, prints, and pictures that had to be “new *and useful*.”²² Much confusion resulted from including the term “useful” here.²³ As noted by Commissioner Simonds in 1874, the “new and useful” language for prints reflected an understanding by Congress in 1842 and 1861 that the aesthetic aspects were for “the adornment of *useful articles* . . . [and] that induced them to insert the word ‘useful’ into the text when they named as [design] patentable subject matter ‘any new and useful pattern, print or

18. See Menell & Corren, *supra* note 1, at 9–13; Du Mont & Janis, *supra* note 15, at 864–73; Jason J. Du Mont & Mark D. Janis, *U.S. Design Patent Law: A Historical Look at the Design Patent/Copyright Interface*, in *THE COPYRIGHT/DESIGN INTERFACE: PAST, PRESENT & FUTURE* 341, 351, 351 n.44 (Estelle Derclaye ed., 2018).

19. Du Mont & Janis, *supra* note 15, at 868.

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

21. There are good reasons, however, to provide sui generis rights for designs than copyrights. See, e.g., Barbara A. Ringer, *The Case for Design Protection and the O'Mahoney Bill*, 7 *BULL. COPYRIGHT SOC'Y U.S.A.* 25, 25 (1959).

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

23. See *id.* at 385.

picture.’”²⁴ More importantly, Simonds concluded that “it is not reasonable to suppose that the originators of the design patent acts intended to offer another method of protection to things already protected [and thus Congress intended to protect only] designs for ornament applied to articles capable of serving a useful purpose”²⁵

Note in the quoted language of Simonds that the idea that Congress intended to provide protection of function was “not reasonable.” Nevertheless, as Menell and Corren note, “after initially questioning the availability of design patent protection for *functional* features of articles of manufacture, the Patent Office reversed course. By 1869, the Patent Office extended design patent protection to functional features of articles of manufacture.”²⁶

In 1870, Congress further revised the design patent eligibility provisions to be “defined in more concise language.”²⁷ As Menell and Corren further note, although Congress deleted the word “useful” from before the category of prints, Congress “added it to the class of ‘shape or configuration’ of an article. The result was that a law aimed at protecting appearance and not function now confusingly conjoined ‘utility’ with ‘shape or configuration.’”²⁸ This category confusion, like the earlier one, then led to continuing judicial controversy over the term “useful” in one of the subcategories of relevant subject matter.²⁹

In turn, this judicial confusion prompted Congress to further revise the statute in 1902 to make clear that design patent protection applied only to “new, original, and *ornamental*” designs for an “article of manufacture.”³⁰ Note carefully that this choice of categories for design protection did not include ornamental designs for “machines,” which had been a category of utility patent subject matter since 1790. Congress thus eliminated all of the separate, original (and slightly modified) enumerated categories of functional products (and statues) in favor of a single, collective term referring to *functionally useful* articles, i.e., “articles of manufacture.”³¹ As Menell and Corren put it, “[t]his [legislative] change sought to limit design patents to original *ornamental* features and

24. *Id.* at 385 (quoting WILLIAM EDGAR SIMONDS, A SUMMARY OF THE LAW OF PATENTS FOR USEFUL INVENTIONS AND FORMS (1874)) (emphasis added).

25. *Id.* (quoting SIMONDS, *supra* note 24) (emphasis added).

26. Menell & Corren, *supra* note 1, at 18 (emphasis added).

27. Hudson, *supra* note 22, at 383–84.

28. Menell & Corren, *supra* note 1, at 18.

29. *See* Menell & Corren, *supra* note 1, at 24–27; *see also* Du Mont & Janis, *supra* note 18, at 359–61 (discussing the purpose of the 1870 Act and the lack of legislative intent to alter subject matter scope for design patents).

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

31. *See* Hudson, *supra* note 22, at 388–89.

channel functional advances to the utility patent regime.”³² And although Congress in 1887 had addressed the design patent damages provision, there is no indication that Congress then meant to affect the subject matter provision when also referring to “article of manufacture” in regard to profits.³³

In summary, Congress finally (and at least somewhat more coherently) settled on a limitation of design patents and their protection to only the aesthetic aspects of a limited class of functional objects—“articles of manufacture.” But that would not satisfy the appetite of the courts to provide greater, extra-statutory, and more trademark-like and copyright-like protections, even when formally subject to patent-law requirements. Menell and Corren trace the judicially developed standards up to 1980, as well as discuss the Federal Circuit’s further expansions of eligibility under the “availability of alternative designs” test and by “viewing designs as a whole”³⁴ (only the latter of which I agree with, although not how the Federal Circuit approaches such viewing, so I agree with Menell’s and Corren’s criticism of that approach).³⁵ As they correctly conclude, the consequence of these judicial approaches to eligibility was that “[i]nventors and designers increasingly sought to use design patents to protect minimal functional features.”³⁶ That inventors and designers sought such expanded protection is unremarkable. That the courts obliged them without any legislative warrant (and, per Simonds, *unreasonably*) based on the judges’ protectionist instincts and to the public’s detriment is the impolite point that Menell and Corren refuse to state explicitly. As I think that such politesse obscures responsibility and encourages stasis against judicial reinterpretation or legislative correction, I refuse to be quite so polite.

32. Menell & Corren, *supra* note 1, at 28–29.

33. See Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387 (currently codified at 35 U.S.C. § 289); Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1, 27–31, 53–61 (2017); JOSHUA D. SARNOFF, WHITE PAPER ON PROTECTING THE CONSUMER PATENT LAW RIGHT OF REPAIR AND THE AFTERMARKET FOR EXTERIOR MOTOR VEHICLE REPAIR PARTS: THE PARTS ACT, S. 812; H.R. 1879, 115TH CONGRESS 10 n.33 (Nov. 2017), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3082289; Menell & Corren, *supra* note 1, at 26, 26 nn.76, 79.

34. Menell & Corren, *supra* note 1, at 68; see *id.* at 64–68.

35. See *id.* at 65–66.

36. *Id.* at 61.

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

As Menell and Corren note, “[b]etween 1842 and 1870, the Patent Office granted more than 200 graphic trademark design patents,”³⁷ and the Court in 1871 in *Gorham Manufacturing Company v. White*³⁸ clearly “held that design patents cover ornamentality, not functionality.”³⁹ But in *Gorham*, the Supreme Court nevertheless confused its categories for infringement protection (and hence for validity⁴⁰) by adopting a “substantial similarity” standard of infringement viewed from the perspective of the “ordinary observer.”⁴¹ Doing so provided protection beyond what patent law is supposed to reward—sufficient creativity as recognized by a skilled artisan (whether fine or useful). Instead, the Court created from whole cloth a novel set of copyright-like standards in the service of trademark-like protections for owners of aesthetic designs.⁴² The Court did so by focusing on the appearance to an ordinary observer/purchaser rather than to the skilled (fine) artisan (i.e., designer).⁴³ And it did so based on that time-honored, rhetorical trope for expanding protections to the public’s detriment—piracy⁴⁴:

37. *Id.* at 14.

38. 81 U.S. 511, 524–25 (1871).

39. Menell & Corren, *supra* note 1, at 22.

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

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

42. *See id.* at 528 (“Experts, therefore, are not the persons to be *deceived* . . . It is persons of the latter class [observers of ordinary acuteness] who are the principal purchasers of the articles to which designs have given novel appearances, and if they are *mised*, and induced to purchase what is not the article they supposed it to be . . . the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.” (emphasis added)); *but see* Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 177 (2015) (“Read in isolation, this language suggests that design patents are product-specific, because who would be deceived into buying one product when they meant to buy a totally different type of product? However, when read in context, it is clear that *Gorham*’s test is one of visual similarity, not a test of actual deception or trademark-like likelihood of confusion. Indeed, that is how it has been read and interpreted by the Federal Circuit.”).

43. *See Gorham Mfg. Co.*, 81 U.S. at 528 (“[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to *deceive such an observer, inducing him to purchase one supposing it to be the other*, the first one patented is infringed by the other.” (emphasis added)).

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

If, then, identity of appearance, or (as expressed in *McCrea v. Holdsworth*) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. . . . There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like that an expert could not distinguish them.⁴⁵

The purpose of the patent laws is “[t]o promote the Progress of Science and useful Arts,”⁴⁶ and even if those categories are not mutually exclusive, nothing in the Constitution suggests a focus on viewing exclusive rights from the perspective of ordinary observers or on protecting consumers from deception (which of course is a perfectly reasonable purpose for legislation under the Commerce Clause⁴⁷ and the Necessary and Proper Clause.⁴⁸ Rather, the constitutional purpose of patent protection is to reward authors or inventors for their aesthetic or technological contributions to society. Why that contribution was thought to be measured from the perspective of ordinary observers, as suggested by the Court in *Gorham*, remains a mystery. And what purchasers being misled has to do with whether a product appropriates an aesthetic advance—particularly without copying—that is made by another is similarly a mystery,⁴⁹ at least if the constitutional basis for the legislation (as it should be for exclusive patent rights) is to “promote the Progress of . . . useful Arts.”⁵⁰

In addition to adopting copyright-like standards while intending trademark-like protections, courts after *Gorham* went on to further confuse its categories by providing protection for utility and functionality in *Lehnbeuter v.*

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

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

46. U.S. CONST., art. I, § 8, cl. 8.

47. U.S. CONST., art. I, § 8, cl. 3.

48. U.S. CONST., art. I, § 8, cl. 18.

49. See, e.g., *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988) (“A device that copies the utilitarian or functional features of a patented design is not an infringement unless the ornamental aspects are also copied, such that the overall ‘resemblance is such as to deceive.’” (quoting *Gorham Mfg. Co.*, 81 U.S. at 528)); see Menell & Corren, *supra* note 1, at 75 (discussing *Lee*).

50. U.S. CONST., art. I, § 8, cl. 8.

Holthaus, Smith v. Whitman Saddle, and *Northrup v. Adam*.⁵¹ As Menell and Corren note, “courts gradually lost their compass and . . . developed standards that not only diverged from Congress’s clear intent but also contradicted the Supreme Court’s seminal intellectual property channeling principle”⁵²

I just want to add here that the reason for these judges “losing their compass” was and remains excessive judicial solicitude for creating private property rights, rather than for protecting the interests of the public, or even for adhering to Congress’s enactments and intentions. I will provide only one example, taken from unaddressed language in two cases that Menell and Corren peripherally address for a slightly different purpose. The first case is *Egyptian Goddess v. Swisa*,⁵³ where the *en banc* Federal Circuit’s apparent focus on protecting consumers (a trademark function⁵⁴) led the court in 2008 to reject the “point of novelty” approach to infringement. This, contrary to the Federal Circuit’s explicitly professed reasoning, was in fact more protective of the public’s rights:

This court has characterized the purpose of the point of novelty test as being “to focus on those aspects of a design which render the design different from prior art designs.” . . . *That purpose can be equally well served*, however, by applying the ordinary observer test through the eyes of an observer familiar with the prior art.⁵⁵

It should be self-evident that that purpose cannot be “equally well served” because the differences of appearance from prior art designs to an ordinary designer are almost certain to be viewed more restrictively than by an ordinary purchaser, i.e., the “ordinary observer.” And the *en banc* Court of Claims and Patent Appeals in *In re Nalbandian*⁵⁶ had made that point much earlier. An “expert’s perception of color in the dyestuff art is necessarily subjective, but

51. See Menell & Corren, *supra* note 1, at 22–23 (citing *Lehnbeuter v. Holthaus*, 105 U.S. 94 (1882); *Smith v. Whitman Saddle*, 148 U.S. 674 (1893); *Northrup v. Adam*, 18 F. Cas. 374 (1877)); cf. Sarah Burstein, *Visual Invention*, 16 LEWIS & CLARK L. REV. 169, 177 (2012) (discussing *Whitman Saddle* as a case addressing invention rather than infringement).

52. Menell & Corren, *supra* note 1, at 19 n.54, 30 (citing *Baker v. Selden*, 101 U.S. 99 (1879)).

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

54. *Egyptian Goddess*, 543 F.3d at 672 (“As long as the ordinary observer test focuses on the ‘appearance that distinguishes the patented design from the prior art,’ EGI contends that it will enable the fact-finder to address the proper inquiry, i.e., whether an ordinary observer, familiar with the prior art, *would be deceived into thinking that the accused design was the same* as the patented design.” (emphasis added)).

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

56. 661 F.2d 1214 (C.C.P.A. 1981) (*en banc*).

nonetheless entitled to more weight than a layman's evaluation of the same color."⁵⁷

The second case I want to highlight, *Nalbandian*, overturned Judge Rich's earlier creation of the "ordinary observer" standard for the obviousness of designs under Section 103 in *In re Laverne*.⁵⁸ In doing so, Judge Nies made crystal clear just how Judge Rich had ignored legislative language and intent. *Laverne* had rejected the "one of ordinary skill in the art" language of Section 103 as referring to a design. This was purportedly because doing so would deny patent protection "for the work of competent designers," based on a false *reductio ad absurdum* that treating the ordinarily skilled designer as the referent would rule "out, as a practical matter, all patent protection for ornamental designs for articles of manufacture."⁵⁹ But as Judge Nies noted, an ordinary designer should be treated like the ordinary mechanic in utility patent law, and in any event, Judge Nies emphasized the need to focus on "the statutory requirement that patents for designs must be evaluated on the same basis as other patents"⁶⁰

In contrast, Judge Rich concurred separately (given that a majority of the Court had decided to overturn *Laverne*): (1) to bemoan the raising of the skill bar for patentable designs (and thus implicitly the reduction of private propertization); (2) to poke at Judge Nies by noting the statutory rather than the Supreme Court origin of the requirement to assess the artisan's skill; and (3) to decry the failure of Congress to pass legislation that he had spearheaded, to make designs subject to copyright registration rather than design patents, because nonobviousness is not a concept that fits with ornamentality or designs.⁶¹ Thus, even when seeking greater protection, Judge Rich understood the category error of protecting designs with patents. "It is time to pass [new legislation] and get the impossible issue of obviousness in design patentability cases off the backs of the courts and the Patent and Trademark Office"⁶²

57. *Id.* at 1217 (citing *In re Neave*, 370 F.2d 961, 968 (C.C.P.A. 1967)); cf. Charles L. Mauro, Chris Morley & Paul W. Thurman, *Development and Initial Validation of an Empirical Ordinary Observer Test for Design Patent Infringement* 8–13 (June 5, 2020), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3620088 (discussing neuroaesthetics and the variance between expert perceptions and those of ordinary observers, even hypothetical ones).

58. 35 U.S.C. § 103; see *In re Laverne*, 356 F.2d 1003, 1006 (1966) ("The test must be obviousness, for that is the dictate of section 103, but it must be applied in a way which will implement the legislative intent to promote progress in the field of industrial design by means of the patent incentive Following the mandate of section 103, it would seem that what we have to do is to determine obviousness to the ordinary intelligent man.").

59. *Nalbandian*, 661 F.2d at 1215–17 (quoting *Laverne*, 356 F.2d at 1162).

60. *Id.* at 1217.

61. *Id.* at 1219.

62. *Id.*

In summary, by purporting to protect the public's interest while actually harming it and ignoring the actual legislative language, federal judges have sought to divert attention from what was really at stake and from the extra-statutory activism in which they were engaged. For many judges, apparently no amount of private property protection is too much, and like nature, such judges abhor a vacuum. We thus should remain cognizant of Benjamin Kaplan's important point that legislative gaps are not holes to be filled, but rather reflect important decisions as to what should not be protected so as to protect the public's interests.⁶³ Nevertheless, those materialists among us will not be surprised by these developments, given Mancur Olson's work on the political power of concentrated interests relative to the limited power of diffuse coalitions.⁶⁴

II. HISTORICAL JUDICIAL CATEGORY ERRORS OF REFERENTS AND ARTICLE OF MANUFACTURE

When Congress in 1902 adopted the generic term "article of manufacture" as its category for all of the substantive objects that were to be protectable by patents if they contained ornamental designs (removing the lists of objects as to which design patent protection previously applied), there was already a history since 1790 in patent law of protecting inventions using similar categories as to the types of things that those inventions had to embody. Specifically, the 1790 Act provided authority to grant patents for "any useful art, manufacture, engine, machine, or device, or any improvement therein" that was "invented or discovered."⁶⁵ In 1793, Congress made minor revisions, in particular adding "composition of matter" to the enumerated categories of

63. See Benjamin Kaplan, *An Unhurried View of Copyright: Proposals and Prospects*, 66 Colum. L. Rev. 831, 836 (1966) ("To follow *I.N.S.* and construct a kind of irregular patent or copyright, whether it be called 'unfair competition' or something else, would 'flagrantly conflict with the scheme which Congress has for more than a century devised to cover the subject-matter.' This view was reinforced by a prevision of the difficulties that would arise in conditioning the anomalous rights—should it be done in tune with statute, or in some other way?" (quoting *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir. 1929) (Hand, J.)); but see JESSICA D. LITMAN, *DIGITAL COPYRIGHT* 79 (2nd ed. 2006) ("[Through the mid-1970s, c]opyright was seen as designed to be full of holes If you're dissatisfied with the way the spoils are getting divided, one approach is to change the rhetoric.").

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

65. Act of April 10, 1790, ch. 7, § 1, 1 Stat. 109, 110; see also WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 69, at 107 n.2 (1890) ("The words 'engine' and 'device' convey no idea not embraced in 'manufacture' and 'machine,' and no phrase is introduced which clearly covers a substance formed by the intermixture of ingredients, though this could have been here, as it was in England, included under 'manufacture.'").

things that could be patented if invented (removing “or discovered”), as well as adding “new and useful” before the enumeration.⁶⁶ This change then suggested that “useful” was meant as a series modifier (just like “new”) and, in a utilitarian, functional sense, applicable to all of the enumerated categories of things, not just to “useful art” as in the 1790 Act.⁶⁷ Thus, the inclusion of “new and useful” as a series modifier in 1793 implied the exclusion of fine arts and objects whose purpose and creative advance was ornamental, by employing that most important of interpretive tools, *expressio unius est exclusio alterius*, or “by stating one thing the alternatives are excluded.”⁶⁸ This created a perceived need in some legislators for some *other* enactment to cover designs that were not then protected by copyright as “writings” of “authors,”⁶⁹ which perceived need was not affected when the 1836 Patent Act restored “discovered” and otherwise preserved the categories set out in the 1793 Act.⁷⁰

In 1842, when Congress created protection for designs, it chose the various categories described above but included the category of “a manufacture” preceded by “new and original design for,” as well as the category of “any article of manufacture” preceded alternately by “any new and original impression to be placed on,” “any new and useful pattern . . . or otherwise fixed on,” or “any new and original shape or configuration of”⁷¹ It is unclear why Congress adopted the differing terminology of “manufacture” and

66. Act of February 21, 1793, ch. 11, § 1, 1 Stat. 317–19.

67. See, e.g., *Lockhart v. United States*, 136 S. Ct. 958, 962–68 (2016) (applying the “rule of the last antecedent” rather than the “series qualifier” canon of construction to a statute); *id.* at 965 (“This Court has long acknowledged that structural or contextual evidence may ‘rebut the last antecedent inference.’ . . . [T]his Court declined to apply the rule of the last antecedent where ‘[n]o reason appears why’ a modifying clause is not ‘applicable as much to the first and other words as to the last’ and where ‘special reasons exist for so construing the clause in question.’ . . . [T]his Court declined to apply the rule of the last antecedent where ‘there is no reason consistent with any discernable purpose of the statute to apply’ the limiting phrase to the last antecedent alone Likewise . . . the Court suggested that the rule would not be appropriate where the ‘modifying clause appear[s] . . . at the end of a single, integrated list.’ ” (quoting *Jama v. Immigration and Customs Enforcement*, 543 U.S. 335, 345, 344 n.4 (2005), *Porto Rico Railway, Light & Power Co. v. Mor*, 253 U.S. 345 348 (1920), and *United States v. Bass*, 404 U.S. 336, 341 (1971)). In the current context, the last shall be first. *Matthew* 20:16 (King James).

68. See, e.g., *Barnhart v. Peabody Coal Co.*, 537 U.S. 149, 168 (2003) (“As we have held repeatedly, the canon *expressio unius est exclusio alterius* does not apply to every statutory listing or grouping; it has force only when the items expressed are members of an ‘associated group or series,’ justifying the inference that items not mentioned were excluded by deliberate choice, not inadvertence.”); see Kaplan, *supra* note 63.

69. See *Menell & Corren, supra* note 1, at 9–12; *Du Mont & Janis, supra* note 15, at 854–55, 864–65.

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

71. Act of Aug. 29, 1842, ch. 263, sec. 3, 5 Stat. 543, 543–44.

“article of manufacture,” although it may have been to distinguish designs that applied to an entire category of manufactures from designs applying to particular instantiations (embodiments) of a manufacture (a particular “article”).⁷² Or perhaps it was just a function of bad drafting. But there is no indication that anything significant was meant by adding “article of” to “manufacture” that would distinguish these categories, and there is also no indication that the term “useful” as applied to patterns was meant to mean anything other than a referent to the functional utility of the object for which pattern (as ornamentation) was the protectable feature of the object (as patent law already protected the useful functions, subject to the much more developed standards for inventions).⁷³ Being functionally “useful” thus was a necessary, inherent character of an “article of manufacture” or of an “art, machine, manufacture, or composition of matter,” to which the patent law (both for designs and inventions) applied.⁷⁴

The 1861 Patent Act did not change the “new and useful” before “patterns” for “articles of manufacture.”⁷⁵ In 1870, when Congress substantially revised the Patent Act, including addressing designs, it essentially kept the same prior eligible category terminology both for inventions and for designs, although it kept “useful” between “new” and “original shape or configuration of any” before “article of manufacture.”⁷⁶ The 1887 Patent Act adopted a particular damages remedy for infringement for “articles of manufacture,”⁷⁷ but without any suggestion of a change to the meaning of “article of manufacture.”⁷⁸ And, as described by Menell and Corren, the

72. It is also possible that the longer phrase “article of manufacture” was simply carried over without attention from the English copyright act on which the 1842 Act was based. *See* Du Mont & Janis, *supra* note 15, at 860–61.

73. *See, e.g.*, Menell & Corren, *supra* note 1, at 11; Du Mont & Janis, *supra* note 15, at 854–55, 864–66.

74. *See, e.g.*, Menell & Corren, *supra* note 1, at 32–39; *cf.* Avia Group Intern., Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563 (Fed. Cir. 1988) (“[A] distinction exists between the functionality of an article or features thereof and the functionality of the particular design of such article or features thereof that perform a function. Were that not true, it would not be possible to obtain a design patent on a utilitarian article of manufacture”). Again, statues may (or may not) have been viewed as functionally useful. *See supra* notes 14–17 and accompanying text.

75. Act of Mar. 2, 1861, ch. 88, sec. 11, 12 Stat. 246, 248–49. The 1861 Act appears to have typographical errors, eliminating “P” and adding a comma before “any manufacture,” and eliminating “any” before “original design” in regard to the various kinds of statutes, while also removing the category of particular kinds of fabrics in favor of the generic “material.” *Id.*

76. Act of July 8, 1870, ch. 230, §§ 24, 71, 16 Stat 198, 209–10.

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

78. *See* Menell & Corren, *supra* note 1, at 26–28, 26 n.76 (citing, among others, Sarah Burstein, *The Article of Manufacture in 1887*, 32 BERKELEY TECH. L.J. 1, 3 (2017)).

continued inclusion of “useful” before only one of the categories of attributes for “articles of manufacture” created much judicial confusion, eventually leading to the removal of the modifiers “new, useful, and original” before “shape or configuration of an article of manufacture” in favor of “new, original, and ornamental designs for an” before “article of manufacture” in 1902.⁷⁹

Given this legislative history, one would have thought that limiting design protection in 1902 to designs for “articles of manufacture” would necessarily exclude designs for “machines,” as much as it would exclude designs for “compositions of matter” or “processes” (if one could create an intangible design), even if both are “manufactured” in the sense of not occurring in nature but by the hands of man.⁸⁰ At least by 1890, William Robinson in his magisterial treatise had described the distinction between a machine and a manufacture (or article thereof) as an “instrument . . . when set in motion, of producing, *by its own operation*, certain *predetermined* physical effects.”⁸¹ In contrast, “[a] manufacture is an instrument created by the exercise of mechanical forces and designed for the production of mechanical effects, *but not capable*, when set in motion, of attaining *by its own operation* to any predetermined result.”⁸² But again, the problem of providing statutorily unauthorized protection where judges think it is warranted got in the way. Most of this story of judicial vacillation over distinguishing manufactures from machines, and of treating parts of machines as manufactures under the design patent act rather than as things that simply were not covered (recall Benjamin Kaplan’s emphasis on lacuna), has already been told by Sarah Burstein and by myself elsewhere.⁸³

Here, I wish to note three important logical inferences from the statute, which the history created by these judges has ignored. First, providing protection for parts of machines as an “article of manufacture” fails to comport with the careful delineation of the terms defining the objects for

79. Act of May 9, 1902, ch. 783, sec. 4929, 32 Stat. 193; see Menell & Corren, *supra* note 1, at 24–28.

80. *Cf.* *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (“[T]he 1952 Act inform[s] us that Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” (citation omitted)).

81. ROBINSON, *supra* note 65, §§ 173, 175 at 257–59 (“A machine differs from all other mechanical instruments in that its rule of action resides within itself.”).

82. ROBINSON, *supra* note 65, § 182, at 269 (emphasis added); see also *id.* at 269–70 (“In this absence of ‘principle’ or ‘modus operandi’ lies the distinction between a manufacture and a machine,—the former requiring the constant guidance and control of some separate intelligent agent, the latter operating under the direction of that intelligence with which it was endowed by its inventor when he imposed on it its structural law.”).

83. See Burstein, *supra* note 78, at 26–53; SARNOFF, *supra* note 33, at 9–11.

utility patent protection as separate categories, on the assumption that “article of manufacture” has the same meaning as “manufacture.” (Recall *expressio unius*, as well as the canon of statutory construction that use of the same terms in the same statute is meant to have the same meaning.⁸⁴) Congress was obviously aware of the utility patent enumeration throughout the history of design patent law when using the terms “manufacture” and “article of manufacture” in 1842 and ultimately settling in 1902 on “article of manufacture.” So, whole or parts of machines simply should be outside of the protection afforded by the Act, by *expressio unius* (even if the parts of machines are separately produced or sold). Second, even if parts of machines were to be included in design patent protection, nothing would thereby suggest that fragments of such “article of manufacture” machine parts (as subparts of parts of machines) should therefore be objects of protectable subject matter for designs.⁸⁵ And the reason for this is that the Court in *Gorham Manufacturing Company* was quite right when it said that a design is something that is understood as a whole.⁸⁶ Third, and perhaps most importantly, nothing in that history should suggest that the class of objects to be protected when they also embodied designs were to be non-functional by themselves, permitting protection based on the fact that they may have been separately produced and then assembled into a functional whole (as parts of an article of manufacture intended to function collectively by themselves or as subparts of parts of machines that then were further assembled into machines).

Nevertheless, as both Menell and Corren and as Sarah Burstein have traced, the Patent Office and the courts expanded protection by treating “articles of manufacture” to include separately manufactured or separately sold products that were only intended to function in conjunction with other products (whether part of and incorporated into a larger article of manufacture or as part of a machine).⁸⁷ Again, it is important to reiterate how and why this blurring of the lines happened. As Menell and Corren note, “inattentive *and protectionist* judicial opinions caused the standard to drift far from these holdings

84. See, e.g., *Est. of Cowart v. Nicklos Drilling Co.*, 505 U.S. 469, 479 (1992) (noting “the basic canon of statutory construction that identical terms within an Act bear the same meaning” (citing *Sullivan v. Stroop*, 496 U.S. 478, 484 (1990))).

85. See Burstein, *supra* note 9, at 620–22.

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

87. See Menell & Corren, *supra* note 1, at 62–82; Burstein, *supra* note 78, at 50–53; cf. SARNOFF, *supra* note 33, at 6–9 (explaining why separate production or sale alone does not and should not qualify a product as an “article of manufacture,” which requires functionality by itself of the product).

and into direct conflict with the clear language and intent of the 1902 design patent amendments⁸⁸

Changing our focus from categories of objects to categories of concepts and to the doctrines on which patent law is based that are inapplicable to designs, the Section 103 (which applies to both designs and inventions) requirement of “obviousness” should, and under *Nalbandian* is, to be determined from the vantage of “the *designer* of ordinary capability who designs articles of the type presented in the application.”⁸⁹ Yet, as we have seen, because of erroneous categorical reasoning tracing to *Gorham Manufacturing Company*, infringement under Section 271 and—at least since *Egyptian Goddess*—novelty under Section 102 are to be determined from the vantage of the “ordinary observer.”⁹⁰ Not only are such perspectives incompatible, particularly as obviousness under Section 103 requires evaluation in light of prior art under Section 102. But also, and more importantly for present purposes, the move to the ordinary observer viewpoint tends to provide protection where it would not otherwise exist and to find infringement where it would not otherwise be found to occur. After all, if both the ordinary observer and the skilled designer are aware of the prior art when viewing the design as a whole for the relevant comparisons, it is more likely that the former than the latter will view a departure as a sufficiently significant one for novelty, and then view the novelty as having been appropriated.⁹¹

This only highlights the difficulty of performing conceptual severability in the analysis of ornamental designs for functional products. But although that is the focus of Menell and Corren, it is not mine here. We need to extirpate illogic and overprotection by their roots if we are to keep design patents from claiming functional aspects. Some form of conceptual severability is required to identify as protectable *only* the aesthetic aspects of an article of manufacture. Because designs are viewed as a whole,⁹² we therefore need some form of abstraction, filtration, and imaginative reconstruction to evaluate the novel

88. Menell & Corren, *supra* note 1, at 7 (emphasis added).

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

90. *See supra* notes 37–55 and accompanying text.

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

92. *Cf.* Mauro et al., *supra* note 57, at 12–13 (using neuroscience to describe how ordinary observers view designs as a whole, unlike experts); *id.* at 13 (“It is well understood, based on modern shape perception research, that the human information processing system produces a wide range of perceptual biases that impact how we view the world and make decisions. These biases have a profound impact on the finder of fact’s decision-making as they apply the OOT in infringement analysis.”).

aesthetic aspects of the designs as part of some kind of a whole article.⁹³ This would be something like how copyright law has to conceptually sever and abstract protected expression from the underlying ideas being expressed in writing, music, and painting⁹⁴ but also requires imaginative reconstruction because the protected expression cannot be compared directly to the allegedly infringing expression at the level of the whole design.

The important point to reiterate is just how far off course the 1842 Act (when combined with the 1952 Act's Section 103) and *Gorham* have taken us. They did so based on the idea of treating differently (by adopting different perspectives) the basic scope of protectable ornamental subject matter—what the design patent *claims* in regard to a design for an article of manufacture—depending upon which *particular* validity doctrine is applied.⁹⁵ And again, the reason for that departure from conceptual coherence and good sense is the unrequited love of private property as a means of inducing innovation (or of rewarding its creators).⁹⁶

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

94. *See, e.g.*, *Lotus Development Corp. v. Borland Intern., Inc.*, 49 F.3d 807, 814 (1st Cir. 1995) (“The *Altai* test involves three steps: abstraction, filtration, and comparison . . . [The abstraction] step enables courts to identify the appropriate framework within which to separate protectable expression from unprotected ideas.” (citing *Computer Assoc. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707 (2d Cir. 1992)), *aff’d*, 516 U.S. 233 (1996); *cf.* *Skidmore as Tr. for Randy Craig Wolfe Tr. v. Led Zeppelin*, 952 F.3d 1051, 1064 (9th Cir.) (“[B]ecause only substantial similarity in protectable expression may constitute actionable copying that results in infringement liability, ‘it is essential to distinguish between the protected and unprotected material in a plaintiff’s work.’ ” (citation omitted)), *cert. denied sub nom. Skidmore as Tr. for Randy Craig Wolfe Tr. v. Zeppelin*, 141 S. Ct. 453 (2020), *reh’g denied*, 141 S. Ct. 946 (2020).

95. *Cf. supra* note 40 and accompanying text (discussing axiomatic scope equivalency for validity doctrines and infringement).

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

III. DESIGN AS A WHOLE AND THE EXACERBATION OF FUNCTIONAL PROTECTION THROUGH PARTIAL DESIGN PATENTS

I refer the reader to my earlier discussion of how Judge Rich in *Zahn*⁹⁷ created partial design patents, contrary to the Patent Office's rejection of such protection,⁹⁸ by holding that "a design for an article of manufacture may be embodied in less than all of an article of manufacture"⁹⁹ I will just add three points.

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

[T]he board erred in treating the claim as directed to a drill tool and only to the shank portion of a tool—the article itself rather than the design for the article. That is the same flaw that persists in [the Patent Office's guidance], which speaks of the "designed article" and prohibits dotted lines therein, because, quoting what we said in *Blum*, "There are no portions of a design which are 'immaterial' or 'not important.'" We did not there speak of a "designed article" but of a design.... An article may well have portions which are immaterial to the design claimed."¹⁰⁰

Note how this conflicts with the "design as a whole" approach of *Gorham* and how the ordinary observer views the design for the article of manufacture as a whole.¹⁰¹ So, Judge Rich's approach was just dotted. More importantly, *Gorham's* holding was binding law that Judge Rich was obligated to follow and to apply faithfully. To quote Judge Rich himself: "It is mutiny. It is heresy. It is illegal."¹⁰²

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

98. *Id.* at 264 (rejecting the claim for an inseverable portion of the manufactured article, relying upon *In re Blum*, 374 F.2d 974 (C.C.P.A. 1967)).

99. *Id.* at 267.

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

101. *See supra* notes 41–50, 57, 93 and accompanying text.

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

Second, allowing partial (and fragment) design patents provides protection of smaller and smaller portions of overall designs for portions of some article of manufacture.¹⁰³ This treatment is presumably based on the view that separate sales or separate production make an “article of manufacture.” Instead, the determination of what is an article should be based on whether the “thing” (the ornamentation of which is to be considered for protection) performs *externally* imposed functions, as described by Robinson.¹⁰⁴ But under Judge Rich’s approach, it should not matter if the claim were to an inseverable portion of a machine, or to a part or to an inseverable portion of a part of a machine, because the rest of the machine could also be dotted out, leaving for design protection the fragment, part, or fragment of a part that is claimed. But the irony of this approach is that it clearly identifies the claimed protection as the “point of novelty” of the *overall* design, contrary to the later rejection of that approach in *Egyptian Goddess* for the *claimed* design,¹⁰⁵ given that the point of novelty approach reduced the potential for protection of the overall design. Apparently, you can’t have it both ways.

Third, and most importantly, because patent protection was provided by Judge Rich for parts of larger things, the infringement right then expands to cover anything incorporating the infringing design (assuming that it remains a “matter of concern” by being visible once so incorporated,¹⁰⁶ or even perhaps not if the article of manufacture is to be judged by what is separately sold or produced rather than what is functionally used).¹⁰⁷ This then permits a finding of design patent infringement when the *overall* article of manufacture is being repaired to its original appearance without “reconstruction,” but the part that is being repaired may then be considered “reconstructed” and that conduct is

103. See *supra* note 94.

104. See Burstein, *supra* note 78, at 65 (“It is true that, in 1887, an article of manufacture had to be a ‘product’ in the sense it had to be complete enough to be sold to someone. But that ‘someone’ did not have to be the ultimate or end consumer. It could be another manufacturer or artisan An item either was an ‘article of manufacture’ or it was not Thus, in 1887, an article of manufacture had to be a vendible item. But not all vendible items were articles of manufacture.” (citations omitted)); *supra* notes 81–87 and accompanying text; cf. Burstein, *supra* note 78, at 24 n.142 (“*Zahn* itself did not purport to interpret ‘article of manufacture,’ although some commentators have read it that way.”).

105. See *supra* notes 53–55, 91, and accompanying text.

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

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

then deemed infringing.¹⁰⁸ Thus, an owner's legal conduct has been converted to intellectual property "theft," even if the amount of damages may then be limited by apportionment to the part that is then considered the "article of manufacture" as to which he or she has to pay the "total profit."¹⁰⁹ In other words, Judge Rich's approach not only takes away the rights of the public, it also turns the public into the butt of the rhetorical joke that the public is the thief of others' property. And it does so even though Congress never contemplated as much, but rather defined total profits in regard to total articles. How "warped" and "frustrated" is that?¹¹⁰

IV. PARTIAL DESIGN PATENTS AS THEFT OF THE PUBLIC'S RIGHT OF REPAIR

I refer the reader to my discussion of how, under *Aro Manufacturing Co. v. Convertible Top Replacement Co.* (*Aro I*),¹¹¹ purchasers have the right in patent law to repair legally purchased automobiles (and other machines and manufactures), so long as they do not "reconstruct" those products as a whole.¹¹² The repair doctrine finds its source in the patent exhaustion doctrine. If an automobile is a machine (and it is), then it should not be the subject of a design patent unless and until Congress legislates protection of ornamental designs for "machines." As Sarah Burstein and I have discussed previously, and as noted above, the vacuum of legislative protection led the court to permit parts of machines to be treated as "articles of manufacture" by focusing on separate sale or production rather than on separate use. But *Zahn* then permits ever-smaller components of machines (or of articles of manufacture) to

108. See *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 346 (1961); *infra* Part IV.

109. 35 U.S.C. 289. Note the similarity to the problem in the utility patent context of determining the damages of a claim to an automobile containing a nonobvious windshield wiper, which is the only point of novelty. A claim to the wiper would base damages on the infringing wiper. But the claim to the car containing the wiper would base damages on the infringing car, without any larger inventive contribution by the inventor to the public than the wiper. See, e.g., *Seymour v. McCormick*, 57 U.S. (16 How.) 480, 490–91 (1853) ("By this doctrine even the smallest part is made equal to the whole, and 'actual damages' to the plaintiff may be converted into an unlimited series of penalties on the defendant. We think, therefore, that it is a very grave error to instruct a jury 'that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine or an improvement on a machine.'"). Avoiding such an unjust result of owing damages based on an infringing car rather than on an infringing wiper requires conceptual severability of the utility patent claim, which just isn't done. Cf., e.g., *Diamond v. Diehr*, 450 U.S. 175, 188 (1981) ("[C]laims must be considered as a whole.").

110. IT'S A WONDERFUL LIFE (Liberty Films 1946).

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

112. *Id.* at 346.

themselves be treated as “articles of manufacture” (and fragments to be protected even if not separately sold or produced). In turn, this permits an ever-smaller denominator in the reconstruction doctrine when considering the fraction repaired when restoring the original ornamental appearance of the article of manufacture. As the denominator is ever smaller, the portion needing repair is then held to be “reconstructed” (or a replacement part that is “made” without authority is protected) and thus constitutes an act of infringement under Section 271. Again, *Zahn* makes the ordinary consumer (or parts manufacturer) into a thief when exercising what would otherwise be their right to repair (and to make repair parts for) the products that consumers have legally purchased. Instead, design patent law should treat as an “article of manufacture” only a product that is functional by itself.¹¹³

I won’t say anything here about the bad environmental consequences of such a legal rule. (Whoops, I just did.) Nor will I discuss that the patent holders have already received the “full” reward to which they are entitled through the purchase price on the product embodying the patented design or invention.¹¹⁴ Rather, I want to focus on two points that relate to the problem of category errors and patent versus non-patent protection for designs.

First, and again, we would not have this particular set of problems were it not for the confusion created by placing design protection in patent law. We would not then be trying to figure out what the “article of manufacture” is for a design. And if we were to adopt *sui generis* protection for designs for useful products, we could then clearly specify that the protected object for which the design (and the design’s scope) is to be determined is a functional object and that both that object and the design are to be determined “as a whole.” Eliminating partial-design patent protection thus would avoid taking away the public’s rights to repair purchased products and to obtain new replacement parts to do so, without reconstruction of the product as a whole, when designs are only part of the functional products that a consumer purchases. But the public will continue to be prohibited from reconstruction of the whole, and

113. Of course, difficult line drawing will be needed to distinguish products that are intended to perform functions by themselves and should be treated as articles of manufacture (such as a mirror, even if it can be incorporated into a larger product) from articles that are intended to perform their functions only in regard to incorporation into a larger article of manufacture or a machine (which should not be considered functional by themselves, even if one can use a car mirror to shave with). But such line drawing can’t be any worse than what we already do with utility subject matter and claims under Section 101. *See* 35 U.S.C. § 101.

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

third parties from unauthorized making of the entirety of such purchased products (or enough of them as to constitute a reconstruction). That seems to strike a fair balance and to sufficiently protect design innovation incentives for society, just as much as it was back in 1850 when *Wilson v. Simpson* first created the repair “right” for patented products.¹¹⁵

Second, it is important to note that the Supreme Court’s recent *Impression Products* decision¹¹⁶ made exhaustion, and thus repair rights, a matter of *federal patent law policy*. Thus, the consumer repair right is not (and probably should never have been viewed as) a matter of a defeasible, default presumptive implied license against which explicit contracts for the purchase of patented products were to be written, and which rights might then be “voluntarily” waived in purchase contracts.¹¹⁷ Accordingly, contractual restrictions on federal patent law repair rights should be considered *preempted* by the

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

116. *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 137 S. Ct. 1523 (2017).

117. *See id.* at 1532–33 (“This Court accordingly has long held that, even when a patentee sells an item under an express [contractual] restriction, the patentee does not retain patent rights in that product.”). Nevertheless, I agree with Sean O’Connor that exhaustion *originated* as a doctrine of implied license, which *could* be defeated by express language in contracts, which are creatures of state law (even though federal common law of contracts for patented goods would make much more sense). *See* O’Connor, *supra* note 11, at 461–81. But we are no longer (if we ever were) living in a constitutional world of contractual protections *uber alles* (or even *uber mostes*). Compare, e.g., *Lochner v. State of New York*, 198 U.S. 45, 64 (1905) (finding a state labor protection law to be an arbitrary exercise of police power in violation of liberty protected by the due process clause of the U.S. Constitution, Amend. XIV, § 1), *with* *Stone v. Mississippi*, 101 U.S. (11 Otto) 814, 819–21 (1879) (“No legislature can bargain away the public health or the public morals. The people themselves cannot do it, much less their servants The contracts which the Constitution protects are those that relate to property rights, not governmental Certainly the right to suppress them is governmental, to be exercised at all times by those in power, at their discretion.”); *but cf.* *Home Bldg. & Loan Assn. v. Blaisdell*, 290 U.S. 398, 449(1934) (Sutherland, J., dissenting) (“If the contract impairment clause [U.S. CONST., Art. I, § 10, cl. 1], when framed and adopted, meant that the terms of a contract for the payment of money could not be altered in invitum by a state statute enacted for the relief of hardly pressed debtors to the end and with the effect of postponing payment or enforcement during and because of an economic or financial emergency, it is but to state the obvious to say that it means the same now.”); *see generally* Stephen A. Siegel, *Understanding the Nineteenth Century Contract Clause: The Role of the Property-Privilege Distinction and Takings Clause Jurisprudence*, 60 S. CAL. L. REV. 1 (1986). And at least since *Aro I*, we properly consider the public as having the “right” to repair their legally purchased, patented products without having to give up that right by contract (even if they would be willing to do so in exchange for a lower price or are compelled to do so as the quid pro quo for obtaining the product because the seller will not sell except on those conditions). As *federal* patent rights of repair effectuating federal patent policy, any such state-law-based *contractual* provisions purporting to restrict repair rights of purchasers through *contract* remedies should now be treated as preempted, just as much as such contractual “rights” to restrict consumer repair rights through *patent* remedies simply do not exist.

Supremacy Clause of the U.S. Constitution,¹¹⁸ as contrary to and as conflicting with the “purposes and objectives” of federal (patent) policy,¹¹⁹ as articulated in *Aro I* and in *Impression Products*. Nothing should be viewed as to the contrary in the Supreme Court’s dicta regarding the ability to enforce prohibitions against repair under contract law¹²⁰ and to preserve restrictions on licensees in regard to making and sale authority (but apparently not use, which might then imply that the license was actually a restriction-prohibited sale).¹²¹ At a bare minimum, the Patent Act should not be understood to preempt any state laws that would prohibit contractual or licensing restrictions that would prevent legitimate purchasers from making repairs, on the misguided belief that such state laws conflict with the infringement rights that patent law protects (and to prevent state law from diminishing the value of the patent rights that create exclusive suppliers that can charge monopoly prices¹²²). State laws protecting federal repair rights do not create a “theft” of those purported infringement rights to prohibit repairs, even if such a restriction on the value of any contractual restrictions thereby prohibited would not amount to a compensable regulatory taking.¹²³ Rather, once we recognize that a federal patent policy exists to protect repair rights, states should be free to prohibit

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

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

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

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

122. *See, e.g.*, Promoting Automotive Repair, Trade, and Sales Act, S. 812, 115th Congress, 1st Sess. (2017) (PARTS Act); Promoting Automotive Repair, Trade, and Sales Act, H.R. 1879, 115th Congress, 1st Sess. (2017) (same).

123. *Cf.* Siegel, *supra* note 117, at 75–102 (discussing limits on takings claims by sovereign overriding of contract rights).

contracting to the contrary. In that way, states will effectuate federal patent policy rather than undermine it.

V. CONCLUSION

It is long past time to legislate protection from design patent infringement for both purchasers of and aftermarket manufacturers of automobile repair parts.¹²⁴ But it is also long past time to boldly go where no Congress has gone before, by correcting the mistakes of the past and removing designs from patent law and placing them in a *sui generis* regime (particularly given the overextension of copyright duration and protections). Perhaps such a result would *not* make Judge Rich roll over in his grave. After all, he bemoaned keeping designs within patent law.¹²⁵ And even if he would not get his wish to place design protection in copyright law, at least he would no longer suffer indigestion at having to stomach the category error of the nonobviousness of designs, as determined from the perspective of the designer of ordinary skill in the art. He thus could have the last laugh that *Nalbandian* would be legislated off the books.

Given the propensity of Congress and the courts to create and protect private property out of the public's right to copy or to independently make use of intangible designs, however, I do not expect such changes to happen in my lifetime. But I'm in the game for the long haul. Until then, perhaps Menell and Corren's fine contribution will at least induce Congress or the courts to clean up functionality doctrine (and apportionment of total profits) as much as can be done within the constraints of a patent system that should have nothing to do with designs but has been forced to live with them. That is unless we can convince the Supreme Court that such category blurring, creating property rights that protect private designers at the expense of the public, is unconstitutional under the Authors and Inventors (not Designers) Clause.¹²⁶

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

125. *See In re Nalbandian*, 661 F.2d 1214, 1218–19 (C.C.P.A. 1981) (en banc) (Rich, J., concurring) (discussing his 1952 Act and subsequent legislative efforts).

126. U.S. CONST., Art. I, § 8, cl. 8.