A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard

Jason J. Du Mont*

TABLE OF CONTENTS

I. INTRODUCTION 532
II. THE MAJOR IMPACT OF THE EARLY PATENT COMMISSIONERS: MERGER OF SUBJECT MATTER & SCOPE FROM 1842 TO 1871 536
A. *Commissioner Ellsworth: The Act of 1842* 539
B. *Commissioners Foote, Hodges & Fisher: The Act of 1861* 546
1. Commissioner Foote: *Crane* 551
2. Acting Commissioner Hodges: *Solomon* 555
3. Commissioner Fisher: *Bartholomew* 556
C. *Commissioners Fisher & Duncan: The Act of 1870* 560
III. FRUSTRATED COMMISSIONERS, LEGISLATIVE OVERSIGHT & JUDICIAL EXPANSION: FROM 1871-1902 568
A. *Commissioner Leggett & The Revised Statutes: Invented and/or Produced?* 568
1. Commissioner Mortimer Leggett: *Parkinson & Weinberg* 568
2. The Revised Statutes: A Typographical Error? 573
B. *The Catchall Section* 578
C. *The Supreme Court's Revolving Door* 582
IV. THE ERA OF INVENTION & NONBVIOUSNESS: FROM 1902-PRESENT 588
A. *The 1902 Act: Invention's New Approaches* 588
B. *The 1952 Act: A Nonobvious Framework* 595
1. A Utility Patent Standard? 595
2. New Standard, Same Problems: Learning From the Past 598
a. Viewpoint 600

---

* Jason John Du Mont. LivSafe IP Law Program Fellow & Adjunct Professor of Law, Chicago-Kent College of Law. I would like to thank Graeme Dinwoodie, Scott Barfuss, Manuel Kleinemenke, Edward Lee, Sarah Harding, Mickie Piatt, Nancy Marder, Mark Janis, David Simon, Christopher Seaman, David Schwartz, Joshua Sarnoff, Sebastian Napoli, Timothy Holbrook, Christopher Buccafusco, Felice Batlan, Christopher Carani and the participants of the 2009 Works in Progress Intellectual Property (WIPIP) conference at Seton Hall University School of Law for their thoughtful comments on earlier drafts of this paper. I am especially indebted to Maribel Nash, Chicago-Kent College of Law, for her excellent research throughout this project and for coordinating joint support with Matthew Braun and James Martin at the Law Library of Congress, Kevin McClure and Lucy Moss at Chicago-Kent College of Law, Rod Ross, Kenneth Kato, and Janet Davis at the U.S. National Archives & Records Administration in Washington D.C., Jordan Griffin at the Rhode Island Historical Society, Stephen Spence at the U.S. National Archives & Records Administration in Kansas City, and Elise Keller at the U.S. Court of Appeals for the 6th Circuit.

b. Combinations of Prior Art 604
V. CONCLUSION 609

I. INTRODUCTION

In *Egyptian Goddess v. Swisa*,[1] the Federal Circuit recently ruled that the ordinary observer test is the sole test for determining design patent infringement, and it advised district courts they need not provide detailed verbal descriptions for design patents during claim construction. Many commentators heralded this decision as ushering in a new era for design protection in the United States.[2] While its holding should make it easier to enforce design patents,[3] the origin of its issues lies much deeper than claim construction verbalization or its test for infringement. Rather, the fundamental problem is that design patents simply cannot be viewed through the same substantive lens as utility patents.[4] Indeed, many of the issues in *Egyptian Goddess* and throughout the history of American design patent jurisprudence result from courts blindly forcing or tweaking substantive and procedural laws from the utility patent context to fit the peculiar nature of designs.[5] Consequently, design

1. Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678-79 (Fed. Cir. 2008) (en banc) (holding the ordinary observer test is the only test that courts can use when determining design patent infringement; rejecting the application of the point of novelty test; advising district courts that detailed verbal descriptions were not required for claim construction of design patents; and placing the burden of producing prior art on the defendant).

2. *See, e.g.*, Dion Bergman & Elizabeth Morris, *Re-Designing Designs*: *The Recent Egyptian Goddess Case Has Brought a Relative Backwater of IP Protection into the Mainstream*, INTELLECTUAL PROP. TODAY, Feb. 25, 2009, at 4 (describing Egyptian Goddess's pro-patentee holding as breathing new life into design law).

3. *See* Perry J. Saidman, Egyptian Goddess *Exposed!: But Not In the Buff(er)*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 859, 884-85 (2008) (characterizing the Federal Circuit's decision in *Egyptian Goddess* to abolish the point of novelty test and claim construction verbalization as eliminating two major weapons for alleged infringers, but pointing out that "point of novelty-like" arguments may still have some relevance in the application of the ordinary observer test).

4. *See generally* Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1132-41 (2008) (arguing for the sui generis protection of industrial designs based on a copyright paradigm, in part, because of the following deficiencies in the traditional patent paradigm: (1) design is a creative process, not an inventive process; (2) the novelty and nonobvious requirements are incompatible to designs; and (3) current registration and examination procedures are too slow and costly).

5. *See generally* Note, *Patents-Designs-Applicability of Mechanical Patent Law to Design Patent Questions*, 22 GEO. WASH. L. REV. 624, 626 (1954) (blaming this phenomenon on: "(1) improper research on the part of counsel representing the parties plus passive acceptance by the court of law as presented to it, and (2) a belief on the part of both court and counsel that the history, functions, and standards of design patents permit a direct and complete analogy between mechanical and design patents" (citing Raymond L. Walter, *A Ten Year Survey of Design Patent Litigation*, 35 J. PAT. OFF. SOC'Y 389 (1953)).

patent protection has witnessed dramatic pendulum swings between under and over-protection with more frequency than any other area of intellectual property law.[6] This pattern will continue to repeat itself until Congress decouples certain utility patent requirements from design patents.[7]

One of these substantive requirements is nonobviousness.[8] As a major hurdle to the grant of all patents, the nonobviousness requirement is one of the main levers used by the Patent Office and courts to deny design patent protection.[9] Unfortunately, this bar to patentability enjoys a history that is nearly as obtuse as design law generally.[10] The nonobviousness requirement, now codified in § 103 of the 1952 Patent Act, traces much of its genesis to the Supreme Court's opinion in *Hotchkiss v. Greenwood*.[11] The prevailing view of courts before *Hotchkiss* was that the subject matter of a utility patent need only be new[12] and useful, no matter how simple or obvious the innovation.[13] In the now infamous "doorknob case" the Court stated:

---

6. *See generally* Jerome H. Reichman, *Design Protection and the New Technologies: The United States Experience In a Transnational Perspective*, 19 U. BALT. L. REV. 6, 123 (1989) (arguing that the cyclical pattern of under and over protection of industrial design occurs both domestically and internationally regardless of which intellectual property regime it has been forced into).

7. *See* Note, *Protection For The Artistic Aspects of Articles of Utility*, 72 HARV. L. REV. 1520, 1522 (1959) (finding courts have a difficult time providing guidance in the field of designs for the application of the invention or nonobviousness requirements because of their difficulty "relating to designs a concept primarily applicable to mechanical ideas").

8. 35 U.S.C. § 103 (2006).

9. *See* Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1650-51 (2003).

10. *See* Matthew Nimetz, *Design Protection*, 15 COPYRIGHT L. SYMP. 79, 123 (1965) (noting that "the jargon of invention does not mix easily with the rhetoric of aesthetics").

11. 52 U.S. 248, 267 (1850). Although the Supreme Court in *Hotchkiss* might have been the first to articulate coherently the doctrinal moorings of our modern obviousness standard, many scholars trace its U.S. origins back to some of Thomas Jefferson's early writings. *See* Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 6-9 (1966); Giles S. Rich, *Laying the Ghost of the "Invention" Requirement*, 1 AIPLA Q.J. 26, 28 (1972) ("The invention is so unimportant *and obvious* that it ought not to be the subject of an exclusive right." (citing 5 THE WRITINGS OF THOMAS JEFFERSON at 279 (P.L. Ford ed., London, G.P. Putnam's Sons 1895))). *But see* EDWARD C. WALTERSCHEID, THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE 341-43 (2002) (arguing the Supreme Court's reliance on Thomas Jefferson's views in *Graham* was misguided) [hereinafter WALTERSCHEID I].

12. However, it should be noted that in the context of utility patents, courts often applied the novelty requirement more expansively during this time. Kenneth J. Burchfiel, *Revising the "Original" Patent Clause: Pseudohistory in Constitutional Construction*, 2 HARV. J.L. & TECH. 155, 191-92 (1989). Indeed, the *Hotchkiss* Court's invention requirement can be conceptualized as an outgrowth of the contemporary novelty requirement. *See* Edmund W. Kitch, *Graham v. John Deere Co.: New Standards for Patents* (1964), *reprinted in* THE SUPREME COURT AND PATENTS AND MONOPOLIES 161, 171 (Philip B. Kurland ed., 1975); P.J. Federico, *Commentary on the New Patent Act*, 75 J. PAT. & TRADEMARK OFF. SOC'Y 161, 180 (1993) [hereinafter Federico I]. Unlike today's novelty standard, which requires each element of the claimed invention to be identically disclosed in

> [U]nless more ingenuity and skill in applying the old method . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of an inventor.[14]

This language, forged from the ambiguous rubric of "invention,"[15] spawned a century's worth of efforts to define just how far beyond novelty a patentee must go.[16]

---

a single prior art reference, "novelty could be defeated by a prior invention having one or more elements not identical but merely equivalent to the elements of the claimed process, composition or device." Burchfiel, *supra*, at 191. This pre-1952 Act standard is commonly referred to as "substantial novelty." *Id.*; EDWARD C. WALTERSCHEID, TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW AND ADMINISTRATION 1798-1836 386 (1998) (pointing to language in bills before the first patent act that required priority determinations where the "inventions or discoveries . . . shall appear to be *substantially the same*, both in principle and execution") (emphasis added) [hereinafter WALTERSCHEID II]. According to historian Edward Walterscheid, the patent board under the 1790 Act developed the following rules for determining whether an invention was "substantially the same, both in principle and execution," and therefore not novel: (1) a new use of an old machine; (2) a change in material; and (3) a change in form or shape. WALTERSCHEID II, *supra*, at 387; *see* Kenneth J. Burchfiel, *supra*, at 197 (describing how "issues of change of form or proportions were subsumed under the substantial novelty inquiry"). Similar to the application of the modern requirement, novelty was applied much more restrictively to design patents until 1871 when Mortimer Leggett became commissioner. *See* discussion *infra* Part III(A)(1).

13. *See* Earle v. Sawyer, 8 F. Cas. 254, 255-56 (C.C.D. Mass. 1825) (No. 4,247) (requiring an invention under the Act of 1793 to be new, useful, and not known or used before, and calling the defendant's argument for an elevated threshold of invention little more than creating ambiguous, "artificial obscurity"). *See generally* Frank D. Prager, *Standards of Patentable Invention from 1474 to 1952*, 20 U. CHI. L. REV. 69, 79 (1952).

14. *Hotchkiss*, 52 U.S. at 266.

15. The Court articulated this standard as requiring invention, in part, because of the statutory language of the patent act at the time. *See* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836) (stating "[t]hat any person or persons having *discovered or invented* any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their *discovery or invention* . . . ." may apply for a patent) (emphasis added). This term's origin actually stems from language in the U.S. Constitution. *See* U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and *Inventors* the exclusive Right to their respective Writings and Discoveries") (emphasis added); *see also* A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147, 154-56 (1959) (Douglas, J., concurring); Burchfiel, *supra* note 13, at 164. Moreover, "invention" can be found, in some form, in the subject matter eligibility section of every patent act the United States has ever enacted. *Compare* 35 U.S.C. § 101 (2006), *with* Act of Mar. 3, 1897, ch. 391, § 4886, 29 Stat. 692 (1897), *and* Rev. Stat. § 4886 (1874), *and* Act of July 8, 1870, ch. 230, § 24, 16 Stat. 198, 201 (1870), *and* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836), *and* Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318, 318-21 (1793), *and* Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, 109-10 (1790). Yet, scholars debate whether "invention" was an intended patentability requirement from the patent acts or the Constitution. *See generally* WALTERSCHEID I, *supra* note 11, at 335-43.

Indeed, only forty years after *Hotchkiss*, a weary Supreme Court lamented that invention simply could not be defined.[17]

Framed as a condition to patentability by the 1952 Patent Act,[18] rather than the rubric of invention, it is now clear that the nonobviousness requirement applies to both utility and design patents.[19] However, a careful review of the history of the early design patent acts suggests that the application of this requirement to design patents was not foreordained, nor does it remain appropriate today. Indeed, this Article will demonstrate why the rubric of invention was likely never intended to apply to design patents at all. Drawing from seldom-viewed personal letters, drafts of bills, and patent commissioner decisions from the 19th century, this Article contends that the nonobviousness requirement was actually forced on design patents through an odd series of administrative, legislative, and judicial mishaps. It is clear from the countless number of design bills proposed since these events that industrial design protection does not fit within the strict confines of utility patent precedent. Applying a historical lens, this Article establishes yet another basis for policy makers to free design patents from the unworkable and inappropriate nonobviousness requirement.

Part II of this Article chronicles how the early Patent Office commissioners inadvertently laid the foundation for the application of invention's rubric to designs by eroding distinctions in subject matter and scope between design and utility patents. Prior to this development, design patents' substantive requirements were treated differently than those of utility patents. From 1842 through the enactment of the 1870 Patent Act, the Patent Office and courts did not require designs to be the product of invention. Rather, they were granted and adjudicated based on little more than novelty.[20] This low threshold of patentability, coupled with increasing numbers of

---

16. Over the course of the next century, the Supreme Court alone referred to inventiveness as requiring everything from "that impalpable something" to "a flash of creative genius." *Compare* McClain v. Ortmayer, 141 U.S. 419, 427 (1891), *with* Cuno Eng'g Corp. v. Automatic Devices Corp., 314 U.S. 84, 91 (1941). *See also* Stefan A. Riesenfeld, *The New United States Patent Act in The Light of Comparative Law*, 102 U. PA. L. REV. 291, 306-07 (1954). Justice Jackson noted, in a frustratingly toned dissent, the inadequacies of the tests for invention employed by the Patent Office and Supreme Court: "It would not be difficult to cite many instances of patents that have been granted, improperly I think, and without adequate tests of invention by the Patent Office. But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this Court for striking them down so that the only patent that is valid is one which this Court has not been able to get its hands on." Jungerson v. Ostby & Barton Co., 335 U.S. 560, 572 (1949) (Jackson, J., dissenting); *see also* Rich, *supra* note 11, at 30.

17. *See McClain*, 141 U.S. at 427 ("The truth is the word [invention] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not").

18. *See* Rich, *supra* note 11, at 34; Giles S. Rich, *Principles of Patentability*, 42 J. PAT. OFF. SOC'Y 75, 89 (1960).

19. *See* 35 U.S.C. § 171 (2006). Part IV(B) *infra* discusses this in much greater detail.

20. For simplicity, throughout this paper I will refer to novelty in its modern (*i.e.*, identical) form and I will note when it is being applied expansively. *See* discussion *supra* note 12.

fraudulently cloaked design patents sought for purely functional innovations, led to rampant abuse by design patent applicants. Those who could not meet the substantive requirements for a utility patent simply applied for a design patent instead. Additionally, because marking conventions at the time did not distinguish between design and utility patents, the public had no idea which type of protection a manufacturer was claiming.

Part III details how the Commissioner of Patents impulsively sought to correct these abuses by equating design patents to utility patents and applying the same substantive standards to both. Placing new weight on the statute's language—which granted design patent protection to applicants who, by their "own industry, genius, efforts, and expense, ha[ve] invented *or* produced any new and original design for a manufacture"[21]—the Commissioner's decisions proclaimed that design and utility patents must both be produced by inventive genius. Nearly thirty years after *Hotchkiss*, this was the first time that the rubric of invention had spread from utility to design patents. Its application gained even more traction when, in what can only be described as a typographical error in the Revised Statutes, the statutory language of the design section was altered to grant design protection to applicants who had "invented *and* produced any new and original design[s]" under the same conditions.[22]

Part III further demonstrates how courts breathed new life into another section of the design statute in order to impose the requirement of invention on design patents. This so-called catchall section simply applied the regulations and provisions governing utility patents to designs. Although it was merely intended to apply limitations related to prosecution and enforcement, it became the perfect back door for courts to apply utility patent precedents, like the invention requirement, to designs.

Part IV of this Article concludes by reviewing the role that invention and nonobviousness have played as requirements for design patent protection in the 20th century. It shows how the haphazard adoption of the nonobviousness requirement for all patents in the 1952 Patent Act removed any discretion that courts had in applying the common-law doctrine of invention and preserved the confusion surrounding industrial design protection.

II. THE MAJOR IMPACT OF THE EARLY PATENT COMMISSIONERS: MERGER OF SUBJECT MATTER & SCOPE FROM 1842 TO 1871

The early Patent Office commissioners had an enormous impact on the development of the patent law and its practice. The role of Commissioner of Patents was created at the same time as the modern Patent Office, under the 1836 Act.[23] Prior to this Act, from 1793 to 1836, patents were granted through a system of

21. Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870) (emphasis added).

22. Rev. Stat. § 4929 (1874) (emphasis added).

23. *See* Act of July 4, 1836, ch. 357, § 1, 5 Stat. 117, 118 (1836).

registration,[24] which many felt produced a "mass of worthless and conflicting patents, . . . excessive litigation[,] and many cases of fraud and extortion."[25] Congress reacted by reinstituting substantive examination[26] under a radically different administration than the first patent act.[27] The passage of the 1836 Act,[28] along with a fire that completely destroyed the Patent Office a few months later,[29] sparked a rebirth for patent law in the U.S.[30] As the new face of its administration, the Commissioner of Patents was perfectly positioned to strongly influence the development of the new laws.[31] Indeed, the Commissioner was the single highest appellate body within the Patent Office from 1836 to 1927,[32] and his decisions became the main lens through which the new laws were interpreted by manufacturers, patent examiners, and courts. These decisions were normally given great weight because they generally reflected the uniform practice of the Patent Office and provided insight regarding the intent of

---

24. P. J. Federico, *The Patent Act of 1793*, 18 J. PAT. OFF. SOC'Y 77, 81 (1936) (stating that the omission of the clause, "if they shall deem the invention or discovery sufficiently useful and important," from the 1793 Patent Act, made the process of granting a patent purely clerical) [hereinafter Federico II]. *See generally* WALTERSCHEID II, *supra* note 12, at 243-80 (detailing the administrative practices of the Patent Office under the 1793 Act); William I. Wyman, *Dr. William Thornton and the Patent Office to 1836*, 18 J. PAT. OFF. SOC'Y 83, 90 (1936) (describing the acquisition of a patent from 1793 to 1836).

25. William I. Wyman, *The Patent Act of 1836*, 18 J. PAT. OFF. SOC'Y 91, 91-92 (1936). *See generally* WALTERSCHEID II, *supra* note 12, at 305-31 (describing the public and private views of the patent system from 1793 to 1836).

26. Congress believed the only way these effects could be mitigated was to examine each claim for its merit before granting a patent. Wyman, *supra* note 25, at 94. As a result, the Act of 1836 "created a systematic examination method of granting patents, established the Patent Office as a distinct and separate bureau, placed it in charge of a chief to be called the Commissioner of Patents, and provided a complete organization to make effective the American plan of predetermining the validity of the invention before the grant." *Id.* at 95.

27. *Compare* Act of July 4, 1836, ch. 357, § 7, 5 Stat. 117, 119 (1836), *with* Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, 109-10 (1790).

28. Daniel Preston, *The Administration and Reform of the U.S. Patent Office*, 5 J. EARLY REPUBLIC 331, 348-49 (1985) (attributing the 1836 Act's passage to dominant Jacksonian ideologies in government during this time)).

29. *See* William I. Wyman, *Homes of the Patent Office*, 18 J. PAT. OFF. SOC'Y 123, 130 (1936).

30. *See* Wyman, *supra* note 25, at 97 ("So marked was its [(1836 Act)] success, so closely related to the progress of American industry, so intimately identified with and provocative of the genius of invention, that the so-called American method of granting patents became the standard practice for the whole world to admire. The only notable exception to this trend, the only highly progressive and powerful state which adheres in entirety to the old 'registration' system, is France.").

31. *See generally* W. W. Cochran et al., *Organization and Functions of Patent Office*, 18 J. PAT. OFF. SOC'Y 209, 210-11 (1936) (describing the Commissioner of Patents' role as the head of the administrative and judicial functions of the Patent Office).

32. *See* P. J. Federico, *Evolution of Patent Office Appeals* (pt. 2), 22 J. PAT. OFF. SOC'Y 920, 941 (1940) [hereinafter Federico III].

the law.[33] Moreover, from 1869 until the turn of the 20th century, they were more readily available than most judicial opinions.[34] The commissioners not only helped interpret the patent law, but they also were heavily involved in its legislation. Indeed, they frequently suggested revisions in their annual reports to Congress,[35] and some commissioners even played active roles on Congressional Patent Committees throughout its numerous amendments.[36] More importantly, much of the evolution of design patent law before the 20th century can be attributed to the enormous impact of the early patent commissioners.

From 1842 to 1869 patent commissioners and courts treated the substantive requirements for design patents as separate and distinct from their utility patent counterparts.[37] It was the compartmentalization of these two regimes that kept the widespread rubric of invention in utility patents from spreading to designs. During this time, however, the Patent Office and courts struggled with the issue of functionality in design. Today, design patents are not granted to designs that are "dictated by function alone."[38] This doctrine, however, did not fully develop until the

---

33. *See* WILLIAM D. SHOEMAKER, PATENTS FOR DESIGNS 21 (1929) ("A construction given to a statute by the uniform practice of the Patent Office for many years is entitled to much weight, being a construction adopted by a coordinate branch of the Government") (citing Cheney Bros. v. Weinreb, 185 F. 531, 532 (1910)).

34. The Patent Office began publishing the Commissioner's decisions in 1869. William I. Wyman, *Samuel Sparks Fisher*, 2 J. PAT. OFF. SOC'Y 490, 497-98 (1920) [hereinafter Wyman II]. By congressional mandate, these decisions were circulated to most cities and major libraries across the country. *See* Act of July 8, 1870, ch. 230, § 20, 16 Stat. 198, 200 (1870). *See generally* CHARLES H. DUELL, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, S. DOC. NO. 138, xi (1901) [hereinafter Annual Report for 1900] (describing this process and how these reports became The Official Gazette of the United States Patent Office in 1872). As a result, before the West Publishing Company started its national reporter series in 1887, the Commissioner's decisions were often more accessible than judicial opinions from other districts. *See generally* Erwin C. Surrency, *Law Reports in the United States*, 25 AM. J. LEGAL HIST. 48, 62 (1981) (describing West Publishing Company's national reporter as "[t]he most significant event in the publication of reports during these decades"). After 1887, however, the citation to commissioner decisions in judicial opinions was not as prevalent as citation to other judicial opinions. This decline was also likely attributable to the lack of major revisions in the patent law, the legislative changes to the commissioner's role, and the general distrust of the Patent Office and monopolies during this time. *See generally* Federico I, *supra* note 13, at 164-65 (describing the 1790, 1793, 1836 & 1870 Acts as the major amendments to the patent law since the 1952 Act); Federico III, *supra* note 32 (detailing the appellate structure of the Patent Office from 1870 to 1939).

35. *See infra* notes 53, 83-86, 282, 343, 347.

36. *See infra* notes 186, 188.

37. *See, e.g.*, *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* HECTOR T. FENTON, THE LAW OF PATENTS FOR DESIGNS 225, 234 (Philadelphia, William J. Campbell 1889).

38. *See* Bonito Boats v. Thunder Craft Boats, 489 U.S. 141, 148 (1989); discussion *infra* Part II(B). Today, *de facto* functionality simply means that the design performs a function. *See* Perry J. Saidman, *Functionality and Design Patent Validity and Infringement*, 91 J. PAT. & TRADEMARK

design patent act began to resemble its modern form.[39] As a result of its discordant treatment, the Patent Office and courts often impermissibly merged the subject matter and scope of protection granted to utility and design patents. Indeed, this merger eventually led one commissioner to decree that all patents must exhibit the exercise of inventive genius.[40] This Section will discuss this movement by tracing the merger of utility and design patent standards, resulting ultimately in the application of the nonobviousness requirement to designs.

A. *Commissioner Ellsworth: The Act of 1842*

In the United States, industrial design protection has always been an afterthought.[41] It took half a century after the first federal patent and copyright acts were passed before design protection was even proposed.[42] Many scholars attribute the impetus for the first act to Henry Ellsworth's,[43] Commissioner of Patents, annual

---

OFF. SOC'Y 313, 316 (2009). Alternatively, *de jure* functionality is a legal conclusion that the article's design is "dictated by function alone," and it is therefore ineligible for a design patent. *See id.* (applying *Bonito Boats*, 489 U.S. at 148). When speaking of *de jure* functionality, I will indicate that the article's design was dictated solely by its function or by function alone. However, it is also commonly articulated as requiring the design to be primarily non-functional. *See, e.g.*, Rosco, v. Mirror Lite. Co., 304 F.3d 1373, 1378 (Fed. Cir. 2002); Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1567 (Fed. Cir. 1996). While the Federal Circuit seems to use these terms synonymously (*i.e.*, primarily and solely functional), its locution could lead to different holdings. For clarification, I will use the terms *de facto* and *de jure* throughout this paper; however, they did not carry the same meaning during this period of time.

39. *See* Act of May 9, 1902, ch. 783, 32 Stat. 193 (1902).

40. *See Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 34, at 256.

41. This has not been the case in other countries. *See* FENTON, *supra* note 37, at 7 (receiving statutory protection in France in 1737 and England in 1787). According to professors Brad Sherman and Lionel Bently, in England, design law was actually the first intellectual property regime to develop into its modern form. BRAD SHERMAN & LIONEL BENTLY, THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW 163 (1999) (refuting the common claim that design protection was the "stepchild" of patent and copyright law).

42. *Compare* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842), *with* Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, 109-10 (1790), *and* Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (1790).

43. Henry L. Ellsworth was the first Commissioner of Patents and played an enormous role in shaping the structure and processes of the Patent Office as we know it. William I. Wyman, *Henry L. Ellsworth: The First Commissioner of Patents*, 1 J. PAT. OFF. SOC'Y 524, 524 (1919) [hereinafter Wyman III]. Because examination was significantly different under the first patent act from 1790 to 1793, when the 1836 Patent Act revived examination under Commissioner Ellsworth, he had an enormous opportunity to influence the development of the law and operation of the Patent Office. *See generally* P. J. Federico, *Operation of the Patent Act of 1790*, 18 J. PAT. OFF. SOC'Y 237 (1936) (describing substantive examination from 1790 to 1793) [hereinafter Federico IV]; Letter from Thomas Jefferson to Henry Knox (July 22, 1791), *reprinted in* Claude A. LeRoy, *Examination in 1791*, 19 J. PAT. OFF. SOC'Y 363 (1937).

congressional Patent Office report for 1841.[44] However, the legislative history is not entirely clear on this point. Indeed, a year prior to Ellsworth's report,[45] the Senate and House of Representatives received a petition from a large number of manufacturers and mechanics in the U.S. requesting some form of protection for designs.[46] In the letter, the petitioners argued:

> [T]he frequent ornamental and other improvements which are and can be made in articles of manufacture have rendered necessary a *registration* of new designs and patterns; that ornamental and useful changes can, in many cases, be made in the design and form of articles of manufacture, for which no patent can be obtained; that the said new designs and patterns often require a considerable expenditure of time and money, and can be made use of by any person so disposed, in such a manner as to undersell the inventor or proprietor.[47]

While the petitioners called for design protection by manner of *registration*, they did not request that it be protected under the aegis of the patent system.[48] In an attempt to use international law to advance domestic change, they also pointed out that Great Britain's Parliament recently passed legislation to protect designs,[49] and they could "confidently affirm that the articles manufactured by them would equal any others in beauty, if new designs and patterns were secured by registration."[50] These British laws notably granted copyright protection—upon registration and deposit—to new

---

44. 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 (1948); *see* HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 74, at 2 (1842) [hereinafter Annual Report for 1841].

45. Because the Commissioner's annual report covered 1841, it was not actually filed until 1842. *See* Annual Report for 1841, *supra* note 44.

46. JORDAN L. MOTT ET AL., PETITION OF A NUMBER OF MANUFACTURERS AND MECHANICS OF THE UNITED STATES, PRAYING THE ADOPTION OF MEASURES TO SECURE TO THEM THEIR RIGHTS IN PATTERNS AND DESIGNS, S. DOC. NO. 154 (1841) [hereinafter MANUFACTURERS' PETITION].

47. *Id.* (emphasis added).

48. *Id.*

49. *See* An Act to Secure to Proprietors of Designs for Articles of Manufacture the Copyright of such Designs for a Limited Time, 1839, 2 & 3 Vict., c. 17 (Eng.) [hereinafter Designs Registration Act]; *see also* An Act for Extending the Copyright of Designs for Calico Printing to Designs for Printing other Woven Fabrics, 1839, 2 & 3 Vict., c. 13 (Eng.) (arising automatically following publication of the design) [hereinafter Copyright of Designs Act]; SHERMAN & BENTLY, *supra* note 41, at 64. However, the British had granted design protection to new and original patterns for printing linens, cottons, calicos, or muslins since 1787. An Act for the Encouragement of the Arts of Designing and Printing Linens, Cottons, Calicoes and Muslins, by Vesting the Properties thereof in the Designers, Printers and Proprietors for a Limited Time, 1787, 27 Geo. III, c. 38 (Eng.) [hereinafter Calico Printers Act].

50. MANUFACTURERS' PETITION, S. DOC. NO. 154 (1841). *See generally* ARTHUR J. PULOS, AMERICAN DESIGN ETHIC 134 (1983) (attributing U.S. manufacturers' requests for design protection to entwined trade between the U.S. and Great Britain).

and original designs.[51] Nevertheless, the petitioners' request for design protection is paradoxical, given the propensity of U.S. manufacturers, at the time, to copy foreign designs.[52]

Commissioner Ellsworth's Annual Report for 1841 echoes many of the same sentiments in the manufacturers' petition, such as competition with other nations that have design laws and the larger issue of pirating designs.[53] Although he seemed to envision this form of protection for "new and original"[54] designs somewhere between copyright and patent protection,[55] he might have inadvertently precluded this by later stating:

> All this could be effected by simply authorizing the Commissioner to issue patents for these objects, *under the same limitations and on the same conditions as govern present action in other cases*. The duration of the patent might be seven years, and the fee might be one-half of the present fee charged to citizens and foreigners, respectively.[56]

---

51. Designs Registration Act, 1839, 2 & 3 Vict., c. 17, § 1 (Eng.). *See generally* discussion *supra* note 49.

52. PULOS, *supra* note 50, at 134. Indeed, import tariffs made this practice quite economical for U.S. manufacturers. *Id.* Perhaps they were now so good at copying designs that they needed protection from each other? *See* Annual Report for 1841, *supra* note 44, at 2 (hinting at the piracy of patterns "at home and abroad").

53. Annual Report for 1841, *supra* note 44, at 2.

54. The requirement that the design be "new and original" was not in the manufacturers' petition. *See* MANUFACTURERS' PETITION, S. DOC. NO. 154 (1841). Rather, the term "original" appears in Ellsworth's Annual report. Annual Report for 1841, *supra* note 44, at 2. While the originality requirement did not make its way into the U.S. Copyright Act until 1909, scholars have traced its copyright origins in the U.S. to an 1839 decision by Justice Story. *See* Gray v. Russell, 10 F. Cas. 1035, 1037-39 (C.C.D. Mass. 1839) (No. 5,728); *see also* Burrow-Giles Lithographic v. Sarony, 111 U.S. 53, 58 (1884). *See generally* Dale P. Olson, *Copyright Originality*, 48 MO. L. REV. 29, 35-42 (1983) (tracing the historical development of the originality requirement in copyright law). However, this term was most likely taken from the British design acts that the Commissioner and petitioners alluded to in their communications to Congress. *See* Designs Registration Act, 1839, 2 & 3 Vict., c. 17, § 1 (Eng.); Copyright of Designs Act, 1839, 2 & 3 Vict., c. 13, § 1 (Eng.). Indeed, the terms "new and original" even appear in the first British design act. Calico Printers Act, 1787, 27 Geo. III, c. 38, § 1 (Eng.) (granting protection to "every Person who shall invent, design and print, or cause to be invented, designed and printed, and become the Proprietor of any *new and original* Pattern or Patterns for printing Linens, Cottons, Callicoes [sic], or Muslins") (emphasis added).

55. *See* Annual Report for 1841, *supra* note 44, at 2 ("It may well be asked, if authors can so readily find protection in their labors, and inventors of the mechanical arts so easily secure a patent to reward their efforts, why should not discoverers of designs, the labor and expenditure of which may be far greater, have equal privileges afforded them?"); *see also* WILLIAM EDGAR SIMONDS, THE LAW OF DESIGN PATENTS 182-83 (New York, Baker, Voorhis & Co. 1874).

56. Annual Report for 1841, *supra* note 44, at 2 (emphasis added).

Perhaps the most significant source of confusion surrounds the middle portion of this quote. What did Commissioner Ellsworth mean when he suggested that design protection could be granted "under the same limitations and on the same conditions as govern present action"? Were designs supposed to be subject to the same grounds for patentability? The most plausible answer is that he was referring to limitations related to the acquisition of these new rights, such as claiming, filing, and general prosecution practice. When read as a whole, this is also the only place in the report that addresses how these new rights could be effectuated.[57] Although the legislative history from the first design act is sparse, the report, petition, and contemporary British design laws[58] can account for most of its language and scope.[59]

Less than a year after the Commissioner's letter, on August 29, 1842, Congress enacted the first statute authorizing patent protection for designs.[60] It provided protection to citizens who by "their own industry, genius, efforts, and expense, may

---

57. *Id.* (describing the types of designs that should be protected but failing to describe with any specificity how these rights should be obtained).

58. The subject matter and terms of art in the Act bear a strong resemblance to those used in the British design acts at the time. *Compare* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842), *with* Ornamental Designs Act, 1842, 5 & 6 Vict., c. 100, § 3 (Eng.), *and* Designs Registration Act, 1839, 2 & 3 Vict., c. 17, § 1 (Eng.), *and* Copyright of Designs Act, 1839, 2 & 3 Vict., c. 13 (Eng.). *See also* discussion *supra* note 54 and *infra* note 126 (discussing the origins of the term "original" and the role of functionality in British design laws).

59. Upon the suggestion of Senator Wright, the Act was restricted to citizens or those who intended to become citizens of the United States. CONG. GLOBE, 27th Cong., 2d Sess. 840 (1842).

60. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842), provided in part:

> §3 *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor [sic], and who shall desire or obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor [sic], as in the case now of application for a patent: *Provided,* That the fee in such cases which by the now existing laws would be required of the particular applicant shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

have invented or produced any new and original design for a manufacture."[61] It also adopted the term, fee, and subject matter advocated in Commissioner Ellsworth's annual report.[62] He had suggested that protection last seven years, cost half a utility patent, and apply to certain articles of manufacture (*e.g.*, protecting designs for textiles, metals, busts, statutes, general shapes or configurations for articles of manufacture, etc.).[63] Unfortunately the legislative history for this Act does not reveal why Congress adopted the terminology "invented or produced,"[64] but it is clear that Congress envisioned the design patent standard differently than the utility patent standard. Under the general patent act, utility patents were available to any person who "*discovered or invented* any new and useful art, machine, manufacture, or composition of matter."[65] Moreover, utility patents did not have to be created by "industry, genius, efforts, and expense."[66] This emphasis on the mode of creation and the amount of effort necessary to qualify for a design or utility patent was not unique to the patent system at the time. Rather, similar analogies can be drawn to classic interpretations of the originality requirement in early American copyright law.[67] Although the language of the utility and design patent statutes differed from each other, Congress did not provide any parameters for distinguishing the "discovery or invention" required for utility patents from the "production or invention" required for design patents. Consistent with the Commissioner's annual report, the 1842 Act also included a so-called catchall section, which adopted the patent act's regulations and provisions related to obtaining and protecting utility patents that were not inconsistent with the 1842 Act.[68] This section operated as shorthand for the Act's drafters, saving them from reproducing the claiming, prosecution, and enforcement sections from the utility patent statute.[69]

While Commissioner Ellsworth might have envisioned design protection somewhere between copyright and patent, the question of where exactly it fell in the spectrum ultimately came to rest with the Patent Office.[70] Most scholars attribute the

---

61. *Id.*

62. *Compare id.*, *with* Annual Report for 1841, *supra* note 44, at 2.

63. Annual Report for 1841, *supra* note 44, at 2.

64. Hudson, *supra* note 44, at 380-81.

65. *See* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836) (emphasis added).

66. *Compare* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836), *with* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842).

67. *See* Joseph S. Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 469-70 (2009). *But see* Feist Publ'n, Inc. v. Rural Telephone Serv. Co., 499 U.S. 340, 351-54 (1990) (rejecting these "sweat of the brow" and "industrious collection" doctrines as substitutes for the originality requirement).

68. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842).

69. *Id.*

70. Stephen Ladas dubbed the incorporation of design into the U.S. patent regime a "historical accident." 2 STEPHEN P. LADAS, PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 830 (1975) (attributing the inclusion of design protection in the

incorporation of design protection into the patent regime to three things.[71] First, the most concrete proposal came from the Commissioner of Patents. Since Congress had adopted the subject matter advocated in his annual report, why not also adopt the "simple" procedure that he suggested.[72] As the first commissioner under the 1836 Patent Act—which among other things, revived substantive examination for the first time since 1793—Commissioner Ellsworth was in the perfect role to ensure that this new form of protection was being appropriately granted.[73] Second, the designs applied to articles of manufacture, which were already within the province of patent law, rather than to the "purely intellectual products" of copyright law.[74] And lastly, there was no central copyright depository or registration at the time.[75]

One overlooked but congressionally persuasive reason for incorporating design protection in the patent regime is that it would also drive revenue into the federal government.[76] At the time, each copyrighted work only generated 50 cents for the district court that it was deposited in—essentially paying the clerk to store, record, and transmit the work to the Secretary of State—but it did not generate any money for the U.S. treasury.[77] By comparison, a granted design patent brought at least fifteen dollars directly into the treasury or Patent Office.[78] Indeed, the senator that introduced the bill in 1842 described it as "intended to apply the rights of patents to

---

U.S. patent system to the Commissioner's suggestion and the lack of a central copyright system for registration and deposit). The French system of design protection was the first to incorporate design into the modern industrial property regime by 1806. *Id.* at 829. This system required compliance with numerous patent-like formalities. *Id.* at 830. By comparison, although the British are attributed with the first legislation protecting designs, protection under the 1787 Act treated designs like artistic property. *Id.* at 829. However, by the Act of 1839, the British also began adopting the same patent-like formalities as the French. *Id.* Indeed, the French system had an enormous influence on the development of design protection throughout Europe. *Id.* at 830.

71. Hudson, *supra* note 44, at 383; *see also* Debra D. Peterson, *Seizing Infringing Imports of Cinderella's Slippers: How* Egyptian Goddess *Supports U.S. Customs and Border Protection's Enforcement of Design Patents*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 888, 891-92 (2008).

72. Annual Report for 1841, *supra* note 44, at 2.

73. *See* discussion *supra* note 43.

74. Hudson, *supra* note 44, at 383.

75. *Id.*

76. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842) (costing half a utility patent).

77. *See* Act of Feb. 3, 1831, ch. 16, § 4, 4 stat. 436, 437 (1831). *See generally* discussion *infra* note 87.

78. *See Information: To Persons Having Business to Transact at the Patent Office* 7 (1836) (photolithographic reproduction reprinted in 1884), *reprinted in* RULES OF PRACTICE: U.S. PATENT OFFICE (1899) (compilation held by Cornell University Library) [hereinafter RULES OF PRACTICE]. A US citizen that applied for a utility patent paid at least $30.00 into the US treasury or Patent Office for each application. *Id.* (assuming it was granted without appeal). After successful petition to the Commissioner, if the patent was not granted $20.00 was refunded to the applicant. *Id.* at 8. By comparison, design patent fees were exactly half of utility patents. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842).

new objects, and thereby bring additional revenue into the patent department."[79] Unfortunately for the treasury, very few design patents were ever granted pursuant to the 1842 Act.[80] It is unknown whether this was the result of stringent examination or limited applications. Additionally, little is understood about the patentability of designs under the 1842 Act because Patent Office decisions were not published until 1869,[81] and there were only three reported cases involving design patents granted under the Act.[82] Although this time period under the 1842 Act can be characterized as relatively quiet, in comparison to utility patents, two different patent commissioners' annual reports reveal frustration with this new form of protection.[83] By 1851, Commissioner Thomas Ewbank even called for removing design prosecution from the Patent Office altogether.[84] Instead of protecting designs for articles of manufacture under patent law, and designs for engravings under copyright law,[85] he proposed a single, unified registry for all designs.[86] Likely reflecting his view that the new regime should follow a copyright model, Commissioner Ewbank also argued the registry should be handled by the district courts[87] because placing "it in this Office gives it too much the prestige of a patent."[88]

---

79. CONG. GLOBE, 27th Cong., 2nd Sess. 833 (statement of Sen. Kerr). However, the bill also contained another section for renewing patents granted before the 1836 Act that would also generate revenue for the Patent Office. *See* Act of Aug. 29, 1842, ch. 263, § 2, 5 Stat. 543 (1842).

80. FENTON, *supra* note 37, at 2.

81. WILLIAM EDGAR SIMONDS, A DIGEST OF PATENT OFFICE DECISIONS 1869-1879 v (Washington, D.C., W.H. & O.H. Morrison 1880); *see also* LEVIN H. CAMPBELL, THE PATENT SYSTEM OF THE UNITED STATES, SO FAR AS IT RELATES TO THE GRANTING OF PATENTS: A HISTORY 47-48 (Washington, D.C., McGill & Wallace 1891); Wyman II, *supra* note 34, at 497-98.

82. *See* Root v. Ball & Davis, 20 F. Cas. 1157 (C.C.D. Ohio 1846) (No. 12,035); Sparkman v. Higgins & Co., 22 F. Cas. 879 (C.C.S.D.N.Y. 1846) (No. 13,209); Booth v. Garelly, 3 F. Cas. 883 (C.C.S.D.N.Y. 1847) (No. 1,646). None of the cases dealt with challenges to the validity of the patents, beyond derivation issues or the on-sale bar.

83. *See* THOMAS EWBANK, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, S. DOC. NO. 55, at 11 (1853) [hereinafter Annual Report for 1852]; THOMAS EWBANK, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, S. DOC. NO. 118, at 16 (1852) [hereinafter Annual Report for 1851]; EDMUND BURKE, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, H.R. EX. DOC. NO. 54, at 11 (1848) (attributing the stimulation of new beautiful forms to "our present imperfect law of designs").

84. Annual Report for 1852, *supra* note 83, at 11; Annual Report for 1851, *supra* note 83, at 16 ("It is believed that a registry law might be beneficially substituted for the law relating to designs. It would be more comprehensive, and better calculated to secure the objects sought, than the law at present in force."). *See generally* N.J. Brumbaugh, *Thomas Ewbank*, 2 J. PAT. OFF. SOC'Y 3, 4 (1919) (describing the notoriously verbose nature of his annual reports).

85. Apr. 29, 1802, ch. 36, § 2, 2 Stat. 171, 171 (1802).

86. *See* Annual Report for 1852, *supra* note 83, at 11 ("These incongruities indicate such a want of systematic legislation as to warrant the hope that they may be wiped from the statute-book by the enactment of a registry law covering all these objects. The registry should be in the district court as now; to make it in this Office gives it too much the prestige of a patent.").

87. *See generally* Act of Feb. 3, 1831, ch. 16, § 4, 4 Stat. 436, 437 (1831) (requiring deposit of the title of the book, engraving, map, chart, musical composition, print, or cut with the clerk's

B. *Commissioners Foote, Hodges & Fisher: The Act of 1861*

About a month before the Civil War began, Congress made some minor changes to the design patent act when it passed the Act of 1861,[89] effectively repealing portions of the 1842 Act.[90] However, the design section was only one small portion of the 1861 Act.[91] Rather, Congress's goal was to improve the practice of the Patent Office by, among other things, giving it subpoena power,[92] changing its internal

---

office of the district court where the author resides, prior to publication, in order to receive any benefit under the Act); R. Anthony Reese, *Innocent Infringement in U.S. Copyright Law: A History*, 30 COLUM. J.L. & ARTS 133, 137 (2007) (describing copyright protection formalities from 1790 to 1909).

88. Annual Report for 1852, *supra* note 83, at 11.

89. The Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861), provided in part:

> Sec. 11. *And be it further enacted,* That any citizen or citizens, or alien or aliens; having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue, or bas relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their application for a patent therefore, and who shall desire to obtain an exclusive property or right therein to make, use, sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor [sic] as in the case not of application for a patent, for the term of three and one half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application: *Provided,* That the fee to be paid in such application shall be, for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided,* That the patentees of designs under this act, shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patents shall expire, upon the same terms and restrictions as are not provided for the extension of letters-patent.

See generally Comments on the New Patent Law, SCI. AM., Mar. 23, 1861, at 185 (finding that the changes will "open[] a very wide field not only for the protection, but also for the display of the esthetic talent of our people, and will, no doubt, attract much attention. We consider it a valuable change, and one that will stimulate the taste of the fine arts and afford a constantly widening field for the encouragement of artists and inventors.").

90. *See* WILLIAM L. SYMONS, THE LAW OF PATENTS FOR DESIGNS 5 (1914).

91. *See generally* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861).

92. *See id.* § 1.

appellate process,[93] increasing salaries for some of its officials,[94] and updating its fee structure.[95] In fact, it was the alternation of the fees and terms for utility and design patents that likely necessitated including the design section in the 1861 Act.[96] For utility patents, the Act changed the fee structure and term of protection from fourteen to seventeen years.[97] And design patents went from a fixed seven-year term to a three-and-half, seven, or fourteen-year term that was elected during prosecution and subject to different fees.[98] The Act also made some slight changes to the subject matter that was eligible for protection—removing "new and original design[s] for the printing of woolen, silk, cotton or other fabrics."[99] However, the most notable

---

93. *See id.* § 2.

94. *See id.* §§ 2, 4.

95. *See id.* §§ 10, 11.

96. The bill did not contain a substantive design portion when it was first read before the Senate (*i.e.*, Committee of the Whole). CONG. GLOBE, 36th Cong., 1st Sess. 1699-1700 (1860). Design patents were only referenced in a section that proposed changing the fees of numerous services at the Patent Office. *Id.* at 1700 (charging fifteen dollars for the application of a design patent). *Id.* Indeed, when the bill was read before the Senate, Senator Simmons proposed striking out the fee for designs because they were not protected under the bill. Senator Bigler had to point out that designs were protected "under the old law." *Id.* The substantive design section of the bill was later added by the House Committee on Patents after it was reported to the House for concurrence. *See id.* at 2407, 2834; S. 10, 36th Cong. § 11 (1860) (as reported by H. Comm. on Patents, May 28, 1860) (writing the substantive design section in hand with a note that it was to be added before § 11 and deleting the fifteen dollar application fee from the previous section because it was now included in the substantive section) (on file at The National Archives, Records of the U.S. House of Representatives, Record Group 233).

The impetus for the design section's inclusion was likely the culmination of the Senator's statements and a memorial that was referred to the House Committee on Patents while the bill was being considered. *See* CONG. GLOBE, 36th Cong., 1st Sess. 2834 (1860) (statement of Rep. Niblack). The memorial requested different terms of protection for designs. *See id.* ("It insisted that patents for designs of wallpaper, and such like things, which are only temporary in their character, ought to be issued for a shorter period of time than they are now issued for; and that patents for designs for stoves and iron works, and other iron work, ought to be issued for a longer period than seven years."). *Id.* After consulting with the Commissioner of Patents, the Committee proposed an amendment that included the substantive design section with different electable terms and associated costs. *Id.* This section of the bill is almost identical to the version that was eventually signed into law in the following Congressional session, except that it still provided protection to "any new and original design for the printing of woolen, silk, cotton, or other fabrics." *Compare* S. 10, 36th Cong. § 11 (as reported by H. Comm. on Patents, Jun. 11, 1860), *with* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861).

97. *Compare* Act of Mar. 2, 1861, ch. 88, § 16, 12 Stat. 246, 249 (1861) (requiring separate filing and grant fees for utility patents), *with* Act of July 4, 1836, ch. 357, § 9, 5 Stat. 117, 121 (1836) (requiring filing fees, but no grant fees for utility patents).

98. Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 249 (1861). Design patents granted under the 1842 Act could also now be extended another seven years to reach a maximum of fourteen years. *Id.*

99. *Id. But see* SIMONDS, *supra* note 55, at 179 (describing this difference as "more apparent

distinction between the two acts is the absence of any catchall section, as included in the Act of 1842, which might have made the regulations and provisions from utility patents applicable to designs.[100] The most likely explanation for the omission of the catchall section was that the 1861 Act now specified most of the terms in the 1842 Act that were made by reference to the general patent laws.[101] For example, instead of specifying the fee for a design patent, the 1842 Act provided that it was "one half the sum" of "the now existing laws."[102] Now that the 1861 Act expressly included these details (*e.g.*, $10.00, $15.00, or $30.00 depending on the elected term), the catchall section was no longer needed.[103]

---

than real" because the subject matter was included in another class); Hudson, *supra* note 44, at 384 (arguing this subject matter was still "plainly … included under the head of 'any new and useful pattern, print or picture to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture.'"). According to Senator Bigler, in conference committee:

> The House had amended the bill by putting in an entire new section, providing for patents for designs not only upon statutory and various patterns, but upon fabrics. The Senate was unwilling to agree to so much of the section as related to designs for patterns, regarding it as too complicated.

CONG. GLOBE, 36th Cong., 2nd Sess. 1248. Unfortunately, the legislative history for the 1861 Act does not reveal why the Senate perceived designs for fabrics to be new. This class of designs was explicitly protected in the 1842 Act. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842) (protecting "any new and original design for the printing of woolen, silk, cotton, or other fabrics"); *see also* discussion *supra* note 96.

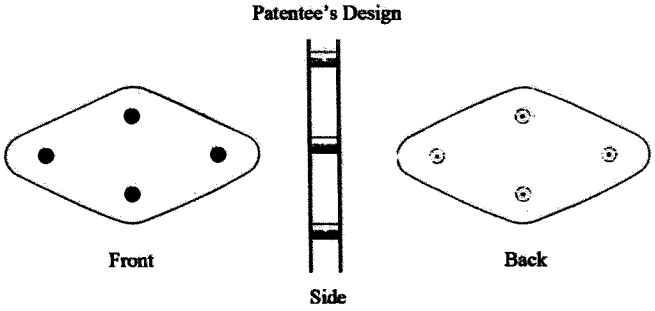
100. *See* discussion *supra* Part II(A). The legislative history from the 1861 Act does not reveal why the catchall section was not included from the 1842 Act. Moreover, the catchall section was not included, nor was it discussed, in any of the drafts for this bill. *See* discussion *supra* notes 96, 99. The only phrase from the Act of 1861 that sounds anything like the catchall section in the Act of 1842, unquestionably, refers to the procedural aspects of utility patents related to extending the terms of utility patents under the Act of 1836. *Compare* The Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861) (stating "[t]hat the patentees of designs under this act, shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patents shall expire, *upon the same terms and restrictions as are now provided for the extension of letters-patent*") (emphasis added), *with* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842) (stating "[t]hat the fee in such cases which by the now existing laws would be required of the particular applicant shall be one half the sum, and that the duration of said patent shall be seven years, and that *all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section*") (emphasis added). *See also* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 124 (1836) (detailing the process for extending a utility patent for up to seven years in certain cases).

101. *Compare* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861), *with* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842).

102. *See* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842).

103. The only alternative explanation is that the clause was omitted by mistake. Given the intense scrutiny of the bill and the Commissioner's involvement with the amended design portion, it is unlikely that its deletion was a mistake. *See* discussion *supra* note 96.

In *Wooster v. Crane*, the Circuit Court for the Southern District of New York was the first court to give judicial construction to the Act of 1861.[104] At issue, was the validity of a design patent for "a reel for containing ruffles, ladies' dress-trimmings, and other goods."[105]



The reel[106] was made from "two parallel disks of pasteboard [in the shape of a rhombus, and] connected by four bits of wood, on which the ruffle . . . [was] wound, between the pasteboard sides."[107] The court's analysis focused on the rhombus shaped pasteboard because "the reel itself, as an article of manufacture, [was] conceded to be old and not the subject of a patent."[108] Although the exact rhombus shape had never been applied to reels, the court found for the defendant because it was a well-known "mathematical figure" that was commonly applied to other articles of manufacture.[109] Interpreting the statute's language, the court stated:

> [A]lthough it does not require utility in order to secure the benefit of its provisions, [it] does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, . . . be held to require that the shape or configuration sought to be secured, shall at least be new and original as applied to articles of manufacture.[110]

---

104. Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 37, at 19.

105. *Id.* at 20.

106. Reel, U.S. Patent No. D1,834 (issued Oct. 20, 1863) (diagrams of the front, middle, and back of the patented reel design).

107. Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 37, at 20.

108. *Id.*

109. *Id.* at 21.

110. Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 37, at 21. During this time, many antebellum courts disagreed about the interpretation of the utility requirement for mechanical (*i.e.*, utility) patents. *Compare* Lowell v.

The court also proclaimed that the only "advantage" of its shape was its incidental use as a trademark.[111] This use for design patents as a substitute for federal trademark protection is worth noting because some applicants prior to the 1870 Act, which granted federal trademark protection for the first time, sought design patents to fill in the gap.[112]

Although *Wooster* was decided well after *Hotchkiss*, the court did not require the design to be the result of invention, nor did it employ any of its associated phraseology. It placed weight on the language of the statute that required a certain level of "production," or labor, and not "invention."[113] Moreover, it lowered the patentability hurdle by modifying the statute's language, which required the design to be created by "industry, genius, efforts, *and* expense," to only whether it was created by "industry, effort, genius, *or* expense."[114] Although the court seemed to treat these initial terms of the statute as substantive requirements, it did little more than recite them.[115] It is significant, however, that the court discussed the design's manner of

---

Lewis, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568) (interpreting the utility requirement negatively as not "frivolous or injurious to the well-being, good policy, or sound morals of society"), *with* Wayne v. Holmes, 29 F. Cas. 473, 476 (C.C.S.D. Ohio 1856) (No. 17,303) (modifying *Lowell* to include the positive utility requirement that the invention benefit society by, among other things, increasing performance or lowering costs).

111. *Id.* Special attention is called to "advantage" here because this word from the opinion was equated to utility in a later decision by Commissioner Fisher. *See* discussion Part II(B)(3).

112. At the time, many felt that the common-law protection afforded to trademarks was inadequate. *See generally Ex parte* King, 1870 Dec. Comm'r Pat. 109 (1870), *reprinted in* FENTON, *supra* note 37, at 246. Indeed, the extremely low patentability threshold for designs made this process quite easy. *See id.*; *Ex parte* Whyte, 1871 Dec. Comm'r Pat. 260 (1871), *reprinted in* FENTON, *supra* note 37, at 260. However, some administrations were particularly guarded against using the patent system to grant trademark-like protection to designs. Indeed, the Patent Office rules chapter on designs from 1867 explicitly stated that "[t]rade marks, merely, are not patentable. There must be some new design, such as is contemplated by section 75, to authorize a patent." RULES AND DIRECTIONS FOR PROCEEDINGS IN THE PATENT OFFICE § 76, at 21 (1867), *reprinted in* RULES OF PRACTICE, *supra* note 78. Early notes from the House Committee on Patents dealing with the 1870 Act also provide some insight into this relationship. Before trademark protection was given its own chapter in the 1870 Act, an early draft of the bill shows that it was actually added to the design chapter of the bill—making chapter three the "Design Patent and Trade Mark" section of the Act. H.R. 1714, 41st Cong. § 69 (as reported by H. Comm. on Patents, April 7, 1870) (draft on file at The National Archives, Records of the U.S. House of Representatives, Record Group 233) (adding trademark protection to the design patent chapter of the patent and copyright portion of the Revised Statutes draft that was provided to the Committee on Patents by the first Commission for the Revised Statutes).

113. Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 34, at 20-21; *see* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861) (granting protection to citizens who by "their own industry, genius, efforts, and expense, may have invented or produced any new and original design").

114. *Wooster*, 30 F. Cas. 612, *reprinted in* FENTON, *supra* note 34, at 20-21 (emphasis added). Additionally, it appears the court accidentally reordered the terms. *Id.*

115. *See id.*

production, as opposed to its end result. Nevertheless, courts and commentators during this time universally read *Wooster* as indicating a low order of patentability for designs.[116]

In sum, commissioners and courts from this early epoch in design law largely treated design patents' substantive requirements differently than those of utility patents.[117] The statutes were physically separate from one another because they were codified at different times and existed in different volumes of the Statutes at Large. They were also conceptually separate because of the dissimilarity in their methods of creation and purpose. Indeed, it was the compartmentalization of design protection—as a third form of protection between copyright and patent—that helped keep the rubric of invention in utility patents from spreading to designs.[118] However, the wall between design and utility patent standards would not last. Indeed, the following three sub-sections will briefly trace how three commissioners under the 1861 Act helped shatter that barricade and ultimately cleared a path for the invention requirement to move from utility to design patents.

1. Commissioner Foote: *Crane*

In his last decision as Commissioner of Patents, and the first published appellate commissioner decision dealing with design patents in 1869,[119] Commissioner Elisha Foote[120] chipped away at the perceived barrier between design and utility patents.[121] In *Crane*, [122] the applicant designed a paper box that contained compartments for holding ladies' furs.[123]

---

116. *See* SIMONDS, *supra* note 55, at 193.

117. *See id.*

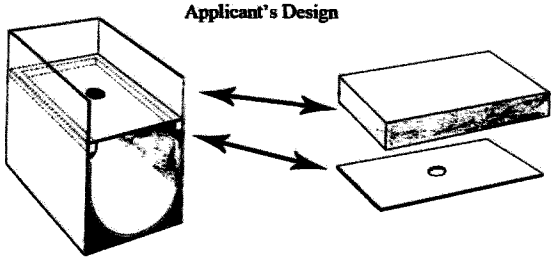
118. Although commissioners had complained about design protection's place in the patent regime, they all treated the substantive requirements for design protection differently than utility patents. *See Ex parte* Sellers, 1870 Dec. Comm'r Pat. 58 (1870), *reprinted in* FENTON, *supra* note 37, at 245.

119. *See generally* W.J. Wesseler, *Elisha Foote*, 2 J. PAT. OFF. SOC'Y 436, 443 (1920) (stating that "[s]ome of his decisions, in the early part of the year 1869, have the distinction of occupying the first pages of the first volume of the printed decisions of the Commission of Patents, although the law authorizing their publication was passed subsequent to this term of office.").

120. Commissioner Foote served on the Board of Examiners-in-Chief prior to his appointment as Commissioner. Before joining the Patent Office, he was a highly respected judge from the Court of Common Pleas of Seneca County. *Id.* at 436.

121. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, THE LAW OF DESIGN PATENTS, *supra* note 55, at 60-61. However, he was probably not the first to do so. *See Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 230 (stating "that there has never been, and is not now, any well defined or uniform practice either in the granting or refusal of design patents").

122. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 59. For clarification, although Jason Crane was the patentee in *Wooster v. Crane & Ex parte* Crane, both cases involved different designs. *Compare Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869),



After being denied a utility patent for not rising to the level of what the examiner termed a "new invention," the applicant sought a design patent.[124] However, this application was also rejected by the examiner and the Board of Examiners-in-Chief because they construed the Act as only covering "designs for ornament merely; something of an artistic character as contradistinguished to those of convenience or utility."[125] In other words, the Board rejected the application because the design did not possess ornamental features that could be distinctly separated from the underlying utilitarian article (*i.e.*, box) they were applied to. This approach to functionality was applied similarly in contemporary British design protection[126] and is closely

---

reprinted in SIMONDS, *supra* note 55, at 59, *with* Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 37, at 19.

123. *See* Fur-Set Box, U.S. Patent No. D3,491 (issued May 11, 1869) (including three cross-section views from the design patent that was ultimately granted).

124. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 60. Commissioner Foote seems to indicate that designs do not have to exhibit invention because he only placed the terms "new invention" in quotes at the beginning of the decision and he distinguished mechanical or utility patents as being "regarded as inventions." *Id.* at 60-61.

125. *Id.* at 60. According to the Board, this construction had been uniformly given to design patents since the Act of 1842. *Id.* This was later refuted by Commissioner Fisher. *See infra* Part II(B)(3).

126. *Compare* Copyright of Design Act, 1839, 2 & 3 Vict., c. 13 (Eng.), *and* Designs Registration Act, 1839, 2 & 3 Vict., c. 17 (Eng.), *with* An Act to Consolidate and Amend the Laws Relating to the Copyright of Designs for Ornamenting Articles of Manufacture, 1842, 5 & 6 Vict., c. 100, § 3 (Eng.) [hereinafter Ornamental Designs Act]. The distinction between ornamental and functional features became particularly important to British lawmakers after the passage of the Ornamental Designs Act 1842. *See* Ornamental Designs Act, 1842, 5 & 6 Vict., c. 100, § 3 (Eng.). Consequently, this Act was passed because many felt that the Designs Registration Act of 1839 impermissibly opened the door for protection to inventions whose subject matter should have been protected under the utility patent laws. *See* SHERMAN & BENTLY, *supra* note 41, at 80, 86-87; *see also* Designs Registration Act, 1839, 2 & 3 Vict., c. 17 (Eng.) (broadly granting protection to "the Shape or Configuration of any Article of Manufacture"). In order to avoid cumulative protection between both regimes, the British tried to distinguish the two by focusing on the purpose, use, and result of the design. *See* SHERMAN & BENTLY, *supra* note 41, at 86. "While patent law protected the use made of articles of manufacture, it was argued that design law was primarily concerned with their pattern,

analogous to the modern separability requirement for protecting designs as works of applied art in Copyright law.[127]

On appeal from the Board, Commissioner Foote noted that the statute "does not say 'ornamental' design, or 'artistic' shape or configuration, and I am unable to perceive any good reasons why designs for utility are not fairly and properly embraced within the statute, as well as those relating to ornamentation merely."[128] Underscoring the difficulty of distinguishing between what was utilitarian or merely for ornament,[129] he further stated:

> I can perceive no necessity for the distinction. There is a large class of improvements in manufactured articles that are not regarded as inventions, or as coming within the scope of general patent laws. They add to the market value and saleability [sic] of such articles, and often result from the exercise of much

---

shape and configuration." *Id.* As a result, in 1842, the Ornamental Designs Act was passed, which restricted protection to designs for the "ornamenting of any article of manufacture." Ornamental Designs Act, 1842, 5 & 6 Vict., c. 100, § 3 (Eng.). Thus, "[t]he design was always considered as different from the article of manufacture, or the substance to which it was to be applied." WALTER A. COPINGER, THE LAW OF COPYRIGHT IN WORKS OF LITERATURE AND ART 407 (J.M. Easton ed., 4th ed. 1904) (quotation omitted). However, this distinction was short lived.

While the Ornamental Designs Act of 1842—and theoretically the Designs Registration Act of 1839—restricted protection to designs for ornamenting articles of manufacture, the imprecise nature of this analysis led the British to adopt the Utility Designs Act in 1843. *See* An Act to Amend the Laws relating to the Copyright of Designs, 1843, 6 & 7 Vict., c. 65, § 2 (Eng.) [hereinafter Utility Designs Act]; SHERMAN & BENTLY, *supra* note 41, at 87-89. *See generally* THOMAS TURNER, ON COPYRIGHT IN DESIGN IN ART AND MANUFACTURERS 24 (London, F. Elsworth 1849) (describing how British citizens "abused" the early acts by trying to register useful articles and how that eventually led to the protection of articles of manufacture under a new act in 1843). The Utility Designs Act "provided protection both for 'the application of a new material or for the combination of parts whether external or internal or for the particular contrivance whereby the utility of any article is increased or a new one produced.'" SHERMAN & BENTLY, *supra* note 41, at 89 (quoting REPORT OF REGISTRAR OF DESIGNS 27-28 (1841)).

127. *See* Mazer v. Stein, 347 U.S. 201, 218 (1954). *Compare* Esquire, Inc. v. Ringer, 591 F.2d 796, 803 (D.C. Cir. 1978) (applying a physical separability standard), *with* Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993 (2d Cir. 1980) (applying a conceptual separability standard). However, the U.S. Copyright Office did not recognize copyright protection for industrial designs until 1948. *See* Jerome 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, 1149 (1983).

128. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 60.

129. Commissioner Foote stated:

> The line of distinction between what is useful and what is merely ornamental is, in some cases, very indefinite. By some it is said that any form or design that is most useful, is also most pleasing. It would be impossible, in the view of such persons, to make any improvement in utility that did not at the same time add to the ornamental and artistic.

Id.

> labor, genius, and expense. They promote the best interests of the country, as well as the creations of inventive talent. It seems to me to have been the intent of Congress to extend to all such cases a limited protection and encouragement. Whenever there shall be produced by the exercise of industry, genius, efforts and expense any new and original new design, form, configuration, or arrangement of a manufactured article, it comes within the provisions and objects of the act creating design patents, whatever be its nature, and whether made for ornament merely, or intended to promote convenience and utility.[130]

Without any further analysis, Commissioner Foote overruled the Board and granted the design patent for the box. Notably, the Commissioner analyzed the design's patentability as the overall arrangement or configuration of the article.[131] He did not try to separate the box's ornamental and functional elements. Nor did he treat separability either as a threshold requirement for a design patent, or as a starting point for a novelty analysis. Furthermore, the Commissioner placed emphasis on the language of the statute, requiring that the new design be produced by "industry, efforts, genius, and expense."[132] Similar to *Wooster*, design patentability seemed contingent upon its method of creation. However, he too did little more than recite the standard.

At its narrowest construction, *Crane* meant that a design for an article of manufacture could not be denied patentability for merely having (*i.e.*, *de facto*) functionality. In other words, applicants did not have to demonstrate that their design was merely ornamental or that it contained separable ornamental elements. As a class of inherently utilitarian articles, a narrower holding would vitiate shapes or configurations of articles of manufacture as a protectable class of design patents. However, as Professor Gerard Magliocca points out, *Crane* could also be read broadly to indicate that a design could meet the patentability requirements through a combination of its aesthetic and utilitarian features (*e.g.*, extending protection to *de jure* functional designs that are dictated solely by function).[133] Although the

---

130. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 60-61. The Commissioner's language here is very similar to language used by the Supreme Court in *Gorham* to justify design protection. *Compare Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 60-61, *with* Gorham Co. v. White, 81 U.S. 511, 525-27 (1871) (stating, "The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public"). *See also* John A. Dienner, *Protection of Industrial Designs*, 45 J. PAT. OFF. SOC'Y 673, 677 (1963) (finding that *Gorham* leads to "[t]he inescapable conclusion ... that the ornamental design applied to an article of manufacture has nothing to do with promotion of progress of science and useful arts, since it relates entirely to merchandising.").

131. *Ex parte* Crane, 1869 Dec. Comm'r Pat. 7 (1869), *reprinted in* SIMONDS, *supra* note 55, at 60-61.

132. *See* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861).

133. Gerard N. Magliocca, *Ornamental Design and Incremental Innovation*, 86 MARQ. L. REV. 845, 874-75 (2003).

Commissioner's reasoning kept him from making a superficial distinction between the box's ornamental and functional elements,[134] the unfortunate corollary of his broad language led to an overlap between the scope of protection for design and utility patents.[135]

2. Acting Commissioner Hodges: *Solomon*

Less than four months later, in *Solomon*, Acting Commissioner Hodges[136] applied *Crane's* reasoning to extend[137] the term of a design patent for an inkstand.[138] To show that the design patent's[139] value to the public merited an extension, the petitioner submitted affidavits that accounted for the inkstand's functional advantages.[140] Despite never differentiating between its functional and ornamental value, Hodges granted the extension based solely on the affidavits.[141] Applying *Crane*,[142] he reasoned that the design patent covered "not only the beauty of the inkstand in point of form, but also all those advantages in point of utility and convenience, which result from its configuration . . ..[s]ome of these are old, it is true, but the combination of the whole is new."[143] Although *Crane* properly taught that the article could have (*i.e.*, *de facto*) functionality, it did not explicitly extend the design

---

134. *See generally* Graeme B. Dinwoodie, *Federalized Functionalism: The Future of Design Protection in the European Union*, 24 AIPLA Q.J. 611, 626-28 (1996) (discussing the history of the integration of form and function in modern industrial designs).

135. Matthew Nimetz points out that "the effect of the grant was the same as it would have been under a regular patent: the box was nothing more than its shape, and if only Jason Crane can manufacture such a shape then Jason Crane possesses an absolute monopoly." Nimetz, *supra* note 10, at 118. *See* discussion *infra* Part II(C).

136. In 1869, Hodges was the acting commissioner between Elisha Foote and Samuel Fisher's administrations.

137. Under the Act of 1861, patentees could petition the Commissioner for a seven-year extension of their design patent from its expiration. *See* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861). The Act of 1870 repealed this practice for design patents granted under the Act of 1861 but extended it to patents granted under the Act of 1842. *See* Act of July 8, 1870, ch. 230, § 74, 16 Stat. 198, 210 (1870).

138. *Ex parte* Solomon, 1869 Dec. Comm'r Pat. 49 (1869), *reprinted in* FENTON, *supra* note 37, at 228.

139. Design for Inkstand, U.S. Patent No. D1,652 (issued Aug. 19, 1862).

140. *Id.* at 227-28.

141. *Id.* at 229. Accordingly, the petitioner could estimate the design patent's value by combining the utilitarian and aesthetic properties of the design. *Id.* at 228.

142. Before applying *Crane*, Hodges also characterized the practice of the Patent Office before *Crane* as issuing design patents solely for their artistic excellence. *Id.* at 227 ("The doctrine of the office has been, for a long time, that a patent for a design like the one before us could only be issued for articles possessed of artistic excellence, and that nothing else could be monopolized under such a patent.").

143. *Id.* at 228.

patent's scope of protection to those functional features.[144] Rather, Hodge's decision in *Solomon* was the first opinion to indicate this natural progression.

3. Commissioner Fisher: *Bartholomew*

In *Bartholomew*, Commissioner Samuel Fisher not only adopted the broad reading of *Crane*, but he also applied a much lower standard of patentability for designs than utility patents.[145] The decision begins by parsing the language of the 1861 Act into five separate subject matter classes for designs.[146] Commissioner Fisher believed that "[t]he first three of these classes . . . seem[ed] to refer to ornament only; the fourth, to ornament combined with utility, as in the case of trade-marks; and the fifth, to new shapes or forms of manufactured articles, which, for some reasons, were preferable to those previously adopted."[147] In this case, the applicant's eraser[148] fit into the fifth design class, as "[a] new and original shape or configuration of any article of manufacture."[149]

Applicant's Design



Next, Commissioner Fisher characterized the disputed questions under this class as follows: "(1) What variations may be claimed or covered by the patent, consistently with unity of design? (2) Is a new shape of an article of manufacture, whereby utility

144. However, if the Patent Office granted design patents to designs that were dictated solely by their function and had unique functional features that could not be carried out by other designs, they would be effectively extending the design patent's scope to those unique functional features. *See* discussion *infra* Part II (B)(3).

145. *See Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 229.

146. The five classes include: "(1) A new and original design for a manufacture; (2) An original design for a bust, statute, &c; (3) A new and original impression or ornament to be placed on any article of manufacture; (4) A new and useful pattern, print, or picture, to be worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture; [and] (5) A new and original shape or configuration of any article of manufacture." *Id.* at 230-31.

147. *Id.* at 231. The Act of 1861's plain language includes the word "useful" in the fourth class. *See* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861); *see also* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842) (including the word "useful" in the same class). However, it was not included in the language of the fifth class. *See* discussion *infra* note 203.

148. Rubber Eraser, U.S. Patent No. D3,810 (issued Jan 4, 1870) (two diagrams from the granted design patent).

149. *See* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861).

is secured, a subject of protection under this act? and (3) Is mechanical function of any kind covered by it?"[150]

Denying the applicant's broad design claim, the Board of Examiners-in-Chief characterized the scope of protection afforded to designs by the Patent Office as uniformly covering only the figure that was fixed in the patent.[151] Therefore, slight variations in protected designs were considered new and patentable.[152] The Commissioner, however, did not agree that the practice of the Patent Office or the courts had been so uniform. He reasoned that a new design "might be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form."[153] Because these patents cover designs that produce substantially the same appearance, and the law does not expressly restrict broad claiming for designs,[154] then it follows that design patents could "be granted for a new genus or class of ornaments, as well as for specific ornaments," so long as they are properly claimed.[155] Indeed, by allowing applicants to broadly claim their designs, Commissioner Fisher openly applied claim conventions from utility patents to designs, further blurring their demarcation.

Despite these similarities, he treated their patentability requirements much differently. Commissioner Fisher openly applied a much lower patentability standard for designs.[156] He believed, "From the nature of the subject matter, there must

---

150. *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 231.

151. *Id.* at 236-37.

152. *Id.* at 237.

153. *Id.* at 231. Commissioner Fisher is alluding to infringement under the doctrine of equivalents. Although the doctrine has evolved considerably since this time period, Edward Walterscheid traces it back to one of Justice Story's decisions over fifty years before *Bartholomew*. *See* WALTERSCHEID II, *supra* note 24, at 388-91 ("[I]n *Odiorne v. Winkley* Justice Story instructed the jury that 'the material question … is … whether a given effect is produced substantially by the same mode of operation and the same combination of powers, in both machines.'") (quoting Odiorne v. Winkley, 18 F. Cas. 581, 582 (C.C.D. Mass. 1814) (No. 10,432)). The infringement standard for design patents that was elucidated by the Supreme Court in *Gorham*—finding infringement where an ordinary observer perceives the designs to be substantially similar, but not necessarily identical—implicitly subsumes the doctrine of equivalents. *See* Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1189-90 (Fed. Cir. 1988). However, the substantial similarity standard for infringement has been applied since the first reported design patent case in 1846. Root v. Ball, 20 F. Cas. 1157, 1158 (C.C.D. Ohio 1846) (No. 12,035) ("[W]here ornaments are used for a stove, it is an infringement to adopt the design so as to produce, substantially, the same appearance.").

154. Modern design patent practice limits the scope of protection to what is displayed in the drawings. 5 ERNEST B. LIBSCOMB III, WALKER ON PATENTS 62 (3d ed. 1986). Thus, genus or class claiming is no longer possible for design patents. *Id.*

155. *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 234.

156. *Id.*

always be more latitude in the issue of patents for trifling changes of form or outline, since it is only necessary that such changes should constitute a new design to entitle them to a patent of this class."[157] Accordingly, the eraser's design was patentable as long as it was not substantially similar to another design.[158]

Analogous to the characterizations of the Patent Office in *Crane* and *Solomon*, the Board of Examiners-in-Chief also rejected the design application because the practice under the 1842 and 1861 Acts was uniformly understood to cover "articles making pretensions to artistic excellence, exclusively."[159] However, Commissioner Fisher again disagreed with this observation.[160] He reasoned:

> [D]enying that a new 'shape or configuration' of an article, whereby utility or convenience is promoted, is the proper subject of a patent, . . . the office would seem to have involved itself in the absurdity that if a design is useless it may be patented, whereas if it be useful it is entitled to no protection.
>
> ....
>
> Articles have been, and are being constantly, patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles.[161]

Adopting Commissioner Foote's reasoning in *Crane*, Commissioner Fisher held that this fifth class of new and original shapes or configurations must include new changes of form that increase the object's utility.[162] As a result, he allowed the design claim for a rubber eraser contingent upon a slight amendment to its wording.[163]

---

157. *Id.*

158. *Id.*

159. *Id.* at 234.

160. *Id.*

161. *Id.* at 234-35. Commissioner Fisher elaborated:

> Of this character are designs for axe-heads, for reflectors, for lamp shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added with great propriety that class of so-called "mechanical" patents granted for mere changes of form, such as plowshares, fan blowers, propeller blades, and others of like character.

Id. at 235. The Commissioner was likely just pointing out that design patents could be granted for articles that did not have separable ornamental features. However, similar to broad interpretations of *Crane*, Commissioner Fisher's statement could also be interpreted as indicating that it did not matter whether the design was dictated solely by function.

162. *Id.* at 236.

163. *Id.* at 237.

Unfortunately, neither *Bartholomew* nor *Crane* provided any qualitative measure for determining the design's utility.[164] When compounded by a novelty standard that granted patents for "trifling changes of form," there was no doctrinal counter balance for the expansion of design protection into the utility patent realm.[165] Indeed, there was nothing to stop applicants that could not meet the patentability standards for utility patents from simply applying for design protection. Despite this quagmire, Commissioner Fisher attempted to treat the considerations for design and utility patents differently. In a later decision, he explained: "I regard the eleventh section of the Act of 1861 as distinct from the remainder of the law[,] as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter."[166] As someone who was instrumental to the subsequent revision of the patent laws,[167] and who decided more appeals for design applications than all of the other commissioners before him combined, Commissioner Fisher notably confirmed the use of a lower patentability standard for design patents by only examining for novelty and ignoring whether the design was produced by industry, genius, efforts, or expense.[168] Although he may have eroded the distinctions between design and utility patents, Commissioner Fisher believed their patentability requirements were unique.[169] Moreover, despite being decided almost twenty years after *Hotchkiss*, no commissioners or courts had ever required design patents to exhibit invention or its rhetoric.[170]

---

164. *See* discussion *supra* note 110 and *infra* Part II(C).

165. *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 234. However, novelty was not always applied this narrowly. *See generally* discussion *supra* note 13.

166. *Ex parte* Sellers, 1905 Dec. Comm'r Pat. 58 (1905), *reprinted in* FENTON, *supra* note 34, at 245.

167. 6 SAMUEL S. FISHER ET AL., REPORTS OF CASES ARISING UNDER LETTERS PATENT FOR INVENTIONS, DETERMINED IN THE COURTS OF THE UNITED STATES xiii (Cincinnati, Robert Clarke & Co. 1874); Wyman II, *supra* note 34, at 503-04.

168. *See Ex parte* Sheppard, 1870 Dec. Comm'r Pat. 22 (1870), *reprinted in* FENTON, *supra* note 37, at 241; *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 229.

169. *See Ex parte* Sellers, 1905 Dec. Comm'r Pat. 58 (1905), *reprinted in* FENTON, *supra* note 37, at 245.

170. *See Ex parte* Sheppard, 1870 Dec. Comm'r Pat. 22 (1870), *reprinted in* FENTON, *supra* note 37, at 241-42 (referring the stove design to the Commissioner for improper claiming, the examiner stated in his rejection that "it is observed that a certain reasonable and proper latitude is given in judging what does and what does not breathe the spirit of the invention in any given case, and that mere colorable variation is to receive no more countenance or favor in an application for a patent for a design than it would in an application for a mechanical device;" however, Commissioner Fisher overruled the examiner stating that the design need only contain features that "are new, singly and in combination," regardless of how the design was claimed). The U.S. Supreme Court is the only known appellate court to interpret the Act of 1861. *See* Clark v. Bousfield, 77 U.S. 133, 139 (1869).

C. *Commissioners Fisher & Duncan: The Act of 1870*

As part of a larger antebellum reform favoring codification over the perceived uncertainty of the common law, and a disparity in state laws following the Civil War, Congress realized that the Nation's federal laws needed to be "simplified, arranged, and consolidate[d]."[171] In 1866, under the authority of Congress, President Andrew Johnson appointed three commissioners to perform this heavy task.[172] Although the weight of this duty proved to be too much for this group,[173] it managed to send drafts of the intellectual property sections to Congress before two of the three commissioners were replaced in 1870.[174] By congressional mandate, the Commission consolidated the Statutes at Large by removing those sections that had been overruled, and rearranged and simplified the remaining sections so that they were easier to comprehend.[175] However, they were instructed not to substantively change the law.[176] Because there were over twenty-five different amendments since the last major revision of the patent laws in 1836, this was no small task.[177]

While the Commission was assiduously wading through the remaining U.S. statutes, the Patent Office was struggling[178] to keep up with the influx of patent applications after the war[179] and was under significant judicial scrutiny for the patents it was granting.[180] Nevertheless, this problem was not unique to the Patent Office during the 1870s.[181] Rather, contemporary and modern scholars have long debated

---

However, this case did not address the patentability of the design with regard to novelty, originality, or invention. *Id.* at 140-41.

171. *See* Act of Jun. 27, 1866, ch. 140, § 1, 14 Stat. 74 (1866). *See generally* WILLIAM M. WIECEK, THE LOST WORLD OF CLASSICAL LEGAL THOUGHT 50-52 (1998).

172. *See* Henry L. Bryan, *The Genesis of an Act of Congress*, 7 LAW LIBR. J. 58, 60 (1915).

173. *See* CONG. GLOBE, 41st Cong., 1st Sess. 220-23 (1869) (discussing a bill—H.R. No. 9—that would extend the Commission's time to revise and consolidate the U.S. statutes).

174. *See* Bate Refrigerating Co. v. Sulzberger, 157 U.S. 1, 24 (1895).

175. *See* Act of Jun. 27, 1866, ch. 140, §§ 1-2, 14 Stat. 74, 74-75 (1866); *see also* discussion *infra* Part III(A)(2).

176. *See* Act of Jun. 27, 1866, ch. 140, §§ 1-2, 14 Stat. 74, 74-75 (1866).

177. *See* Lawrence C. Kingsland, *The United States Patent Office*, 13 LAW & CONTEMP. PROBS. 354, 362 (1948).

178. Many commentators blamed the Patent Office's inefficient procedural practices and the poor quality of the examining corps for the delay. *See also* Editorial, 1 J. PAT. OFF. SOC'Y 202 (1919) (finding that the number of new applications filed at the Patent Office jumped from 7,653 in 1860 to 21,276 in 1867 shortly after the Civil War). *See generally* Wyman II, *supra* note 34, at 503-04.

179. *See* KENNETH W. DOBYNS, THE PATENT OFFICE PONY: A HISTORY OF THE EARLY PATENT OFFICE 171 (1997) (finding a 20 to 40% increase in the total number of applications filed each year from 1863 to 1867).

180. *See generally* Frank D. Prager, *Trends and Developments in American Patent Law from Jefferson to Clifford (1790-1870)* (pt. 2), 6 AM. J. LEGAL HIST. 45, 58-61 (1962).

181. *See generally* Mark A. Lemley, *Rational Ignorance at the Patent Office*, 95 NW. U.L. REV. 1495, 1497 (2001).

whether it is better for society if the Patent Office allocates its limited resources to grant fewer "high quality" patents that have longer pendency rates or to grant more "low quality" patents with shorter pendency rates.[182] Although the Patent Office usually takes a position in the middle, after the Civil War the practice became slightly tilted towards one model and needed to be realigned to maintain the status quo.[183] Historically, much of the frustration from courts during this time towards so-called "low quality" patents was reflective of a much larger anti-monopoly sentiment that was growing throughout the country.[184] Because the Revised Statutes could not contain any substantive changes to the law, the Patent Office's realignment had to be separately provided by Congress before the comprehensive Revised Statutes were passed.[185]

In an attempt to improve examination at the Patent Office,[186] Congressman Thomas Jenckes, a former patent attorney and chairman of the House Committee on

---

182. The terms "high and low quality" patents are used here to indicate whether they will withstand judicial scrutiny. *See* Jay P. Kesan & Andres A. Gallo, *Why "Bad" Patents Survive in the Market and How Should We Change? – The Private and Social Costs of Patents*, 55 EMORY L.J. 61, 63, 115-16 (2006) (using the terms "bad" and "good" patents). Theoretically, "higher quality" patents take longer to examine but they fare better in court. The opposite is true of "low quality" patents.

183. However, patent practice in the United States has also gone through its share of extremes. From 1793 to 1836, it even reverted to a registration-like system. *See* discussion *supra* notes 24-26.

184. *See generally* Prager, *supra* note 180, at 60; Chauncey Smith, *A Century of Patent Law*, 5 Q.J. ECON. 44, 59-60 (1890). Some in the U.S. were so frustrated with the examination process that they publicly called for eliminating formal examination in favor of a registration system. *Our Patent System*, 17 AM. L. REG. 321, 321 (1869). Alternatively, many people, such as Commissioner Foote, called for stricter and more thorough examinations. *Id.* However, the U.S. was not the only country that was frustrated with its patent system at this time. In England, some groups even called for its abolition. *See* Mark D. Janis, *Patent Abolitionism*, 17 BERKELEY TECH. L.J. 899, 922-48 (2002) (discussing some of the major patent abolition themes in England during this time and their modern analogues).

185. *See* Act of Jun. 27, 1866, ch. 140, §§ 1-2, 14 Stat. 74, 74-75 (1866); *see also* discussion *infra* Part III(A)(2).

186. One of the most important provisions of the 1870 Act gave the Commissioner the power to establish regulations governing practice before the Patent Office. Edwin M. Thomas, *Legislative Changes Since 1836*, 18 J. PAT. OFF. SOC'Y 103, 110-11 (1936); Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836). Although the commissioners had created rules for the Patent Office since its inception, informally from 1836 to 1839 and via Congressional authority in the 1839 and 1861 Acts, this power was extremely limited. *See* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861) (expanding the Commissioner's rulemaking authority to depositions and affidavits for cases before it and courts); Act of Mar. 3, 1839, ch. 88, § 13, 5 Stat. 353, 355 (1839) (providing the Commissioner of Patents with the authority to create evidentiary rules for cases before it); *see also Information: To Persons Having Business to Transact at the Patent Office* 1 (1836) (photolithographic reproduction reprinted in 1884), *reprinted in* RULES OF PRACTICE, *supra* note 78 (first set of Patent Office rules). *See generally* E.J. STODDARD, ANNOTATED RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE 2 (1920) (describing the expansion in rulemaking authority).

By 1870, Commissioner Fisher and Congressman Jenckes believed that the Commissioner of

Patents,[187] worked tirelessly with the Commissioner of Patents, Samuel Fisher,[188] the Librarian of Congress, Ainsworth Spofford,[189] and the House Committee on Patents to revise the draft of the Revised Statutes section covering intellectual property that was produced by the three commissioners.[190] Although the group had the Commission's report as a starting point, it was still not going to be easy to get the bill through Congress.[191] In addition to its amendments aimed at improving procedural

---

Patents needed stronger rule-making authority to help fill in procedural gaps in the law. *Id.* This allowed the Patent Office to react more quickly than waiting for Congress to pass needed changes. *Id.* As long as the rules were not inconsistent with the Patent Act, once they were approved by the Secretary of the Interior they had the same binding effect as laws. *See id.* These rules were the precursor to our modern *Manual of Patent Examining Procedure* ("MPEP").

187. Jenckes was a highly noted reformist in other areas as well. *See generally* Ari Hoogenboom, *Thomas A. Jenckes and Civil Service Reform*, 47 MISS. VALLEY HIST. REV. 636, 636 (1961).

188. Commissioner Fisher also had a reputation as a reformist at the Patent Office. Wyman II, *supra* note 34, at 491. Indeed before he even accepted the role of Commissioner of Patents, Fisher and Jenckes corresponded with each other about patent law reform numerous times. *See* John Y. Cole, *Ainsworth Spofford and the Copyright Law of 1870*, *in* A CENTURY OF COPYRIGHT IN THE LIBRARY OF CONGRESS 3 (1970). At the time, the Patent Office was in disarray. Its administration was unstable, its decisions were widely erratic, and its examiners were being openly accused of dishonesty and favoritism. Wyman II, *supra* note 34, at 492. Commissioner Fisher started by improving the examining corps. *Id.* at 492-93. Some of the Patent Office's widely erratic decisions were, in large part, due to the quality of the examiners—prior administrations had enforced a policy of political favoritism over merit. *Id.* at 494. However, Fisher's reformation of the office was not merely aimed at others. *Id.* at 497-98. He also sought to improve the transparency of the Commissioner's role by publishing his decisions in a weekly periodical. *Id.* Once he realized that he could no longer improve the office without wholesale changes to the laws, he started working meticulously with congressmen such as Jenckes. *Id.* at 503. *See generally To revise, consolidate, and amend the statutes relating to patents and copyrights: Minutes on H.R. 1714 Before the H. Comm. on Patents*, 41st Cong. 1, 3 (1870) (noting Commissioner Fisher's attendance during the first three of four meetings dated Mar. 30, 1870, Apr. 2, 1870, and Apr. 6, 1870, but not Apr. 13, 1870) (on file at The National Archives, Records of the U.S. House of Representatives, Record Group 233); IN MEMORIAM: SAMUEL S. FISHER 22-23 (Cincinnati, Robert Clarke & Co. 1874); Ainsworth R. Spofford, *The Copyright System of the United States-Its Origin and Its Growth*, *in* CELEBRATION OF THE BEGINNING OF THE SECOND CENTURY OF THE AMERICAN PATENT SYSTEM 145, 152 (Washington, D.C., Press of Gedney & Roberts Co. 1892); Wyman II, *supra* note 34, at 491 (noting that Fisher "was instrumental in obtaining remedial legislation and instituting reforms in the processes and conduct of the Office that were not only essential to correct manifest abuses that had been gradually acquired, but which placed it upon a higher plane of usefulness and efficiency than it had ever attained before"); Letter from Thomas Jenckes, House of Representatives, R.I., to Samuel Fisher, Commissioner, Patent Office (Apr. 14, 1870) (on file at Law Library of Congress).

189. Cole, *supra* note 188, at 3-4 (1970) (working with Jenckes and Fisher, Spofford staunchly advocated, among other things, moving the deposit of copyrighted works from the Patent Office to the Library of Congress).

190. *See generally* Wyman II, *supra* note 34, at 503-04.

191. *See* CONG. GLOBE, 41st Cong., 2nd Sess. 2679-80 (1870). Rep. Jenckes stated:

The bill [(H.R. 1714)] now reported from the Committee on Patents is based upon

matters at the Patent Office, the bill also contained provisions granting federal trademark protection for the first time.[192] Despite these obstacles, after a few revisions and a speech by Jenckes to Congress, that contemporary observers considered brilliant, the Act of 1870 was finally passed.[193]

The Act of 1870 took the single, long, and complexly worded section of the 1861 Act that granted design protection and simplified it by dividing it into six smaller sections.[194] Additionally, the new act: (1) abolished applicant citizenship

---

> the revision of the laws relating to patents and copyrights made by the commissioners of revision appointed under the statute authorizing a revision of the laws of the United States [(*i.e.*, the Commission)]. That revisal of these particular statutes was reported to this House early in this Congress and referred by the House to the Committee on the Revision of the Laws of the United States. It was examined by that committee and was found to embody all the provisions of existing law, in brief, clear, and precise language. They subsequently reported it to the House and recommended that it be referred to the Committee on Patents. In prospect of this proposed revision the Committee on Patents had already received numerous communications from those interested in the subject, and also numerous bills and petitions that had been filed in the House and referred to that committee, proposing various amendments to the existing laws . . . . The result of these hearings and discussions has been the adoption by the committee of certain propositions of amendment to these laws, which they have embodied in the bill now before the House.

Id.

192. *See generally* Act of July 8, 1870, ch. 230, § 78, 16 Stat. 198, 211 (1870).

193. *See generally* Benjamin V. Abbott, *The New Patent Law*, 2 ALB. L.J. 341 (1870).

194. Act of Act of July 8, 1870, ch. 230, §§ 71-76, 16 Stat. 198, 209-10 (1870), provided in part:

> Sec. 71. *And be it further enacted,* That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of wool[l]en, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print or picture, to be printed, painted, cast or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.
>
> Sec. 72. *And be it further enacted,* That the commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.
>
> Sec. 73. *And be it further enacted,* That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.
>
> Sec. 74. *And be it further enacted,* That patentees of designs issued prior to March two, eighteen hundred and sixty-one, shall be entitled to extension of their

discrimination;[195] (2) made design patents issued under the 1842 Act extendable for another seven years;[196] (3) reincorporated the catchall phrase from the 1842 Act;[197] and, (4) modified the subject matter that was eligible for protection.[198] Although the sections covering designs came in their own chapter after the general patent section, as codified, they were no longer separate from utility patents.[199] Indeed, this was the first time that design and utility patent protection had been enacted

---

respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one.

Sec. 75. *And be it further enacted,* That the following shall be the rates of fees in design cases:

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries.

Sec. 76. *And be it further enacted,* That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs.

195. The Act of 1870 allows anybody to apply for a design patent regardless of citizenship. Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870). However, the old acts required an applicant to be a citizen or an alien that resided in the U.S. for a year and who took an oath of his intention to become a citizen. *See generally Synopsis of the Amended Patent Law*, SCI. AM., July 23, 1870, at 55 ("This will enable foreign manufacturers to protect themselves against having their designs copied, which has hitherto been quite extensively practiced in this country, especially in the production of textile goods.").

196. Act of July 8, 1870, ch. 230, § 74, 16 Stat. 198, 210 (1870). This section made designs granted before 1861, pursuant to the 1842 Act, eligible for a term of up to fourteen years. However, it did not expressly make designs granted under the 1861 Act extendable, as the 1861 Act did. This led the Patent Office to the paradoxical result that designs granted under the 1842 Act were extendable, yet designs granted under the 1861 Act were not. SIMONDS, *supra* note 55, at 181. *But see Book Notices*, 1 CENT. L.J. 307, 317 (1874) (criticizing Simonds's treatise and arguing that design patents granted under the 1842 Act were not extendable because they would have expired before the 1870 Act since they could not be extended under the 1861 Act and they only had a seven year term).

197. *Compare* Act of July 8, 1870, ch. 230, § 76, 16 Stat. 198, 210 (1870) ("[A]ll the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs."), *with* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842) ("[A]ll the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.").

198. Although the subject matter was largely the same as the previous act, just worded more concisely, the Act of 1870 expressly restored protection to printing on woolen, silk, cotton, and other fabrics, and it included the term "useful" the article of manufacture class. *See* discussion *infra* note 203.

199. *See* Act of July 8, 1870, ch. 230, §§ 24, 71, 16 Stat. 198, 201, 209-10 (1870).

contemporaneously. The sections covering designs also injected a slight language change from previous acts; for the first time, the statute explicitly distinguished "patents for inventions and discoveries" from "patents for designs."[200] However, the Act of 1870 still extended protection to any person who by her "own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture."[201]

Likely applying Commissioner Fisher's decision in *Bartholomew*, the House Committee on Patents[202] made a slight modification to the 1870 Act's subject matter by including the word "useful" in the shape or configuration class for articles of manufacture, so that it now granted protection to "any new, *useful*, and original shape or configuration of any article of manufacture."[203] This slight change in wording

---

200. *See id.*, ch. 230, §§ 71, 73-76, 16 Stat. 198, 209-210.

201. *See id.* ch. 230, § 71, 16 Stat. 198, 209-10.

202. H.R. 1714, 41st Cong. § 72 (as reported by H. Comm. on Patents, Apr. 13, 1870) (on file at The National Archives, Records of the U.S. House of Representatives, Record Group 233). Indeed, the draft from the Commission for the Revised Statutes, which was the basis for the 1870 Act, did not include the word "useful" in any protectable design classes. STAFF OF H. COMM. ON THE REVISION OF THE LAWS, 41ST CONG., DRAFT OF THE STATUTES RELATING TO PATENTS AND COPYRIGHTS, REVISION OF THE UNITED STATES STATUTES, § 69, at 25 (1869) (on file at The National Archives, Records of the U.S. House of Representatives, Record Group 233) [hereinafter 1869 REVISED STATUTES DRAFT]. The draft provided in part:

> SECTION 69. Any citizen of the United States, or any alien who has resided therein one year, and taken the oath of his intention to become a citizen, who, by his own industry, genius, efforts and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto relievo, or bass relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print or picture, to be printed, painted, cast or otherwise placed on or worked into any article of manufacture; or any new and original shape or configuration of any such article, the same not having been known or used by others before his invention or production thereof, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

Id. This omission was odd because they were congressionally mandated not to substantively alter the laws while compiling the Statutes at Large for the Revised Statutes.

203. Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870) (emphasis added). Courts struggled mightily to understand this term's meaning and genesis following the 1870 Act. Indeed, the word "useful" became a major source of confusion for courts and the Patent Office until the Act of 1902. *See* FENTON, *supra* note 37, at 8. Unfortunately, there is very little legislative history for this Act. I propose two possible explanations for its genesis.

First, it is entirely possible that it was added by mistake. Indeed, the term "useful" was not only added to this class (covering the shape or configuration of articles of manufacture) but it was also omitted from another class from the 1861 Act (covering types of surface ornamentations). *Compare* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870), *with* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861). In the 1861 Act, there were three different classes for articles of manufacture. Two of these classes protected types of surface ornamentation applied to articles of manufacture, and the third class protected the actual shape or configuration of the article of manufacture. In the 1870 Act, the two classes from the 1861 Act for surface ornamentations of

officially sanctified the muddled overlap given to design and utility patents by the Patent Office and provided the perfect methodology for protecting trivial innovations.[204] Indeed, it cemented the shift from ornamentation to a mix of function and ornamentation in a quasi-utility model or petty patent manner.[205] This meant that applicants could comply with marginal requirements indicative of second-tier protection, yet receive first-tier patent rights.[206] Moreover, with no functionality doctrine and a low novelty bar, there was no doctrinal lever that could be used to limit

---

articles of manufacture were added together. Although the term "useful" was only in one of the 1861 Act classes, the term did not make it into the combined class in the 1870 Act. The third class, protecting the shape and configuration of articles of manufacture, also should have stayed constant from the 1861 to the 1870 Act. However, this is the class in the 1870 Act where the term "useful" ended up. Accordingly, it is entirely possible the term was just swapped. After all, both classes covered different aspects of articles of manufacture. It would have been easy to confuse the two. Unfortunately, this answer is probably too simple. The draft from the Commission for the Revised Statutes, which was the basis for the 1870 Act, did not include the word "useful" in any protectable design classes. *See* discussion *supra* note 202. Accordingly, the House Committee on Patents likely intended to add the term to the class protecting the shape or configuration of articles of manufacture. *Id.*

Second, it is most likely that the term was purposely added to one class based on the reasoning in *Bartholomew* and yet omitted in the other by mistake. Starting with the addition, we know that it was added by the House Committee on Patents, that Commissioner Fisher made several appearances while the bill was in committee, and that he was heavily involved with Congressman Jenckes during its drafting. *See* discussion *supra* Part II(C). Accordingly, the proper place to start is with his decisions. As discussed above, in *Bartholomew*, he effectively read this term into this class when he said that the reel in *Wooster* would have received protection if it had more utility. *See* discussion *supra* Part II(B)(3). Thus, *Bartholomew* supports adding the term to this class of articles of manufacture. Alternatively, the most likely reason why the term was removed is probably the most simple one. It was likely a drafting error. After all, this class was created by adding two classes together, and only one of the classes contained the term. Based on their congressional mandate not to substantively change the law, we know the term should be in the Commission for the Revised Statutes draft, yet it was not. *See* discussion *supra* note 202. Because there is no support in any commissioners' decisions, court opinions, or legislative history, it was likely a drafting or typographical error.

204. Magliocca, *supra* note 133, at 876. *See generally* J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, 94 COLUM. L. REV. 2432, 2456-59 (1994) (discussing some of the problems with utility model laws and other hybrid intellectual property regimes).

205. *See* W. B. HUTCHINSON, PATENTS AND HOW TO MAKE MONEY OUT OF THEM 25 (New York, D. Van Nostrand Co. 1899) ("Inventors frequently have an idea that they can procure design patents cheaply and that they will cover the same ground as a patent for a structure."). Although design patents' longest electable term was three years shorter than utility patents', they were 15% cheaper and effectively had the same rights. *See* Act of July 8, 1870, ch. 230, §§ 22, 68, 71, 73, 75 16 Stat. 198, 201, 209-10 (1870). Thus, design patents became a highly economic solution for industries that needed to file large numbers of applications and whose inventions had a shorter shelf life than utility patents (*e.g.*, stoves).

206. *See* Mark D. Janis, *Second Tier Patent Protection*, 40 HARV. INT'L L.J. 151, 155 (1999) (arguing, in part, that second tier protection slows the progress of downstream innovation by creating fragmented property rights that exhibit characteristics of anticommons property).

the expansion of this second tier protection. In other words, it cancelled any balance between the public and private domain that is achieved by lessening the rights associated with these forms of protection and ultimately impeded innovation.[207] Alternatively, the term "useful" might have been added to this class of designs to indicate they applied to useful articles. However, as an article of manufacture, this class already inherently applied to useful articles. Additionally, this was not the reading that contemporary courts and commissioners gave this section.

Consistent with the new language of the statute, Acting Commissioner of Patents, Samuel Duncan,[208] took the broad reasoning from *Bartholomew*, and almost completely merged the subject matter from design and utility patents in *Fenno*.[209] As an example of how design patents were being used at this time, the applicant applied for a design patent to cover a stove-pipe damper after his utility patent application was rejected in light of prior art.[210] Despite acknowledging that there was an inference the "applicant is now endeavoring to obtain covertly what he failed to accomplish by direct method upon the former application," Duncan gave little weight to the applicant's intentions.[211] Applying the statute, he believed that its new language "expressly implie[d] that utility [could] be the sole object had in view, in the invention or selection of the particular form to be impressed upon the manufacture."[212] Duncan also stated "that under the present statute, if a new, and at the same time useful shape be devised for a particular article of manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law."[213] He took this one step further by separately requiring the design to exhibit utility.[214] In other words, he required this class of designs to be new, original, and now useful.[215]

---

207. *See id.*

208. Following Commissioner Fisher's resignation, Duncan acted as commissioner for three months until Commissioner Leggett was sworn in. DOBYNS, *supra* note 179, at 179. Once Leggett became Commissioner, Duncan left the Patent Office to become law firm partners with Fisher. *Id.*

209. *See Ex parte* Fenno, 1871 Dec. Comm'r Pat. 52 (1871), *reprinted in* FENTON, *supra* note 37, at 250.

210. *Id.* at 251. The only difference between the applicant's stove-pipe damper and the prior art was the opening of its principal plate. *Id.* at 250. The patentee's opening was circular, whereas the prior art's was rectangular. *Id.*

211. Duncan merely noted that the specification should be amended to disclaim the mechanical construction of the stove-pipe damper and the claim confined to its special form. *Id.* at 251-52.

212. *Id.* at 252. *See* Act of July 8, 1870, ch. 230, § 71 16 Stat. 198, 210 (1870) (protecting "any new, useful, and original shape or configuration of any article of manufacture").

213. *See Ex parte* Fenno, 1871 Dec. Comm'r Pat. 52 (1871), *reprinted in* FENTON, *supra* note 37, at 252.

214. *Id.*; *see also* FENTON, *supra* note 37, at 8-9.

215. *See Ex parte* Fenno, 1871 Dec. Comm'r Pat. 52 (1871), *reprinted in* FENTON, *supra* note 37, at 252.

Duncan then remanded the case, in part, so that the examiner could determine whether the difference between the design and the prior art produced a useful result that the prior art did not.[216] Although Duncan's decision in *Fenno* never stated that the design's utility was protectable, when read in light of Commissioner Fisher's decision in *Bartholomew*—which openly applied a low novelty standard and failed to limit or define utility for design patents—the perceived barrier between design and utility patents was irrevocably shattered. Consequently, the stage was perfectly set for a severe backlash by the next commissioner.

III. FRUSTRATED COMMISSIONERS, LEGISLATIVE OVERSIGHT & JUDICIAL EXPANSION: FROM 1871-1902

Once the Patent Office started overlapping the subject matter and scope of design and utility patents, it was not long before the Patent Office and the courts began treating their substantive requirements similarly. The first new requirement to spread from utility to design patents was the demand that both be the product of invention. Up until the Act of 1870, all prior design acts applied a low threshold of patentability; in practice, they only required identical novelty.[217] This Section will demonstrate how courts placed new weight on the statutory language requiring that new and original designs be invented or produced, and expanded their interpretation of the statute's catchall section to include substantive requirements from utility patents.

A. *Commissioner Leggett & The Revised Statutes: Invented and/or Produced?*

1. Commissioner Mortimer Leggett: *Parkinson & Weinberg*

Although the Act of 1870 was initially interpreted in the same manner as the previous design acts, as requiring only novelty,[218] the new Commissioner of Patents would radically alter the landscape of design patents in the U.S. In *Weinberg*, Commissioner Mortimer Leggett[219] presided over an appeal from an examiner challenging whether color changes in surface ornamentation alone could form the proper subject of a design patent.[220] In an attempt to eliminate some of the trademark-like protection that he felt design patents were being used to serve,

---

216. *Id.* at 252-53.

217. *See, e.g.*, *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 234.

218. *See Ex parte* Fenno, 1871 Dec. Comm'r Pat. 52 (1871), *reprinted in* FENTON, *supra* note 37, at 252 (interpreting the Act of 1870, Acting Commissioner of Patents Samuel A. Duncan, held that the Act required the design to be new, original, and now useful).

219. *See generally* C. C. Reif, *Mortimer D. Leggett*, 2 J. PAT. OFF. SOC'Y 534 (1920).

220. *Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 37, at 255.

Commissioner Leggett held that the exercise of inventive genius was required for both design and utility patents.[221] He reasoned that, although the statute's language indicated that the original design need only be "invented or produced," the word "produced" was never intended to lower the standard for design patents.[222] Commissioner Leggett explained:

> The word "invent" had become so intimately associated with improvements in functional constructions and combinations, that the word "produced" was used in connection with the word "invention," merely to relieve it of this functional signification. When read in connection with the words "genius" and "original," as found in the statute . . ., the word "produced" is evidently used with a much higher signification than merely made or constructed; it means created. "Invented or produced," as used in this section of the law, means the exercise of a higher faculty than would have been indicated by "invented" alone.[223]

Applying this logic, design patents were now held to a higher standard than utility patents. They had to be produced by creative genius, which was somehow measured by their aesthetic effect.[224] So in a rather circular fashion, the design's method of creation was measured by its end result. On the other hand, by making the barometer for creative genius the aesthetic effect of the design, its method of creation became irrelevant. In a roundabout manner, Leggett was simply refocusing patentability on the design's aesthetics, as opposed to its utility. It is unfortunate, however, that he used "invention" as the mechanism for achieving this goal. Additionally, central to this analysis was a more nebulous comparison than past administrations had applied—the aesthetic effect.[225] This comparison was likely intended to provide a buffer from the prior art that was eroded by past administrations' application of an identical novelty requirement.[226] Moreover, it was expansive enough to act as a substitute for a cogent functionality doctrine.

---

221. *Id.* at 255-56.

222. *Id.* at 256. For comparison, the utility patent section grants patent protection to people that have "*discovered or invented* any new and useful art, machine, manufacture, or composition of matter." Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (1836) (emphasis added). Although *Hotchkiss* does not cite any authority for the invention requirement, some courts later held that it was a statutory requirement based on the term's appearance in the utility patent section. *See, e.g.*, Thompson v. Boisselier, 114 U.S. 1, 11 (1885); Ransom v. New York, 20 Fed. Cas. 286, 288 (C.C.S.D.N.Y. 1856) (No. 11,573). Therefore, by attacking the significance of the term "produced" in the design section, in *Weinberg* Commissioner Leggett was able to connect the term "invented" to the statutory requirement that had been recognized for utility patents. *See Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 37, at 256.

223. *Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 37, at 256.

224. *Id.*

225. *Id.* at 256; *see* discussion *infra* note 321.

226. *See, e.g.*, *Ex parte* Fenno, 1870 Dec. Comm'r Pat. 52 (1870), *reprinted in* FENTON, *supra*

Leggett's use of the invention requirement to achieve this goal eventually led back to focusing on the design's method of creation. Nonetheless, prior to his decision in *Weinberg*, no courts or commissioners gave the terms "industry," "genius," "efforts," and "expense" much weight. These early decisions unanimously adopted a lower threshold of patentability for designs than utility patents.[227] More than twenty years after *Hotchkiss*, *Weinberg* was the first time that the rubric of invention was applied to design patents.[228] Since past administrations treated design patents similar to utility patents, and the 1870 Act codified these sections together for the first time, it was logical that the patentability requirements from utility patents would begin to coalesce with designs. Yet despite past administrations' complaints about design's place in the patent regime, all of the commissioners tried to keep it as a separate form of protection between copyright and patent. Once that framework was shattered, the invention requirement provided a necessary doctrinal lever that the system needed to achieve balance.

Less than two weeks after *Weinberg* was decided, Commissioner Leggett expanded his reasoning in *Parkinson* when rejecting the applicant's claw hammer design. Similar to the examiner's rejection that was overruled in *Crane*, the hammer design application was also rejected on the basis that "function can form no part of a design patent."[229] While the Commissioner sustained the rejection, his analysis focused on the design's nominal aesthetic differences from standard tack and nail hammers at the time. He reasoned that design patent applicants "must do a little more than invent—[they] must produce, that is, create. Creative genius is demanded in giving existence to a new and original design."[230] In an often quoted[231] characterization of prior administrations, Commissioner Leggett also criticized the Patent Office's approach to design patentability as "not only liberal[,] but lax."[232] He

---

note 37, at 250; *Ex parte* Sheppard, 1870 Dec. Comm'r Pat. 22 (1870), *reprinted in* FENTON, *supra* note 37, at 241; *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 229; *Ex parte* Solomon, 1869 Dec. Comm'r Pat. 49 (1869), *reprinted in* FENTON, *supra* note 37, at 228. *But see* Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036), *reprinted in* FENTON, *supra* note 37, at 19 (in practice, however, applying a low patentability standard).

227. *Ex parte* Bartholomew, 1869 Dec. Comm'r Pat. 103 (1869), *reprinted in* FENTON, *supra* note 37, at 234.

228. Ultimately, the Commissioner did not hold that color could never form the sole basis for a design patent, but he was highly skeptical whether it could comply with the invention requirement. *Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 37, at 256.

229. *Ex Parte* Parkinson, 1871 Dec. Comm'r Pat. 251 (1871), *reprinted* FENTON, *supra* note 37, at 257.

230. *Id.* at 258-59.

231. *See, e.g.*, Northrup v. Adams, 18 F. Cas. 374, 375 (C.C.E.D. Mich. 1877) (No. 10,328); Rowe v. Blodgett & Capp Co., 112 F. 61, 62 (2d Cir. 1901); Whiting Mfg. Co. v. Alvin Silver Co., 283 F. 75, 80 (2d Cir. 1922); *In re* Faustman, 155 F.2d 388, 394 (C.C.P.A. 1946).

232. *Ex parte* Parkinson, 1871 Dec. Comm'r Pat 251 (1871), *reprinted in* FENTON, *supra* note 37, at 259.

believed that earlier commissioners had "opened the door to design patents far too widely."[233] Unfortunately, neither *Weinberg*[234] nor *Parkinson*[235] shed much light on what it meant for a design to be invented by creative genius. Additionally, no other commissioners' decisions and no other courts dealt directly with any novelty or invention challenges under the 1870 Act.[236]

Although Commissioner Leggett voiced strong views about design's place within the patent system, his underlying concerns were not unfounded. As commissioner, he recognized that legions of rejected utility patent applicants regularly turned around and filed design patent applications for the same products merely so they could mark them as "patented."[237] This was problematic because the old marking statutes did not require patentees to distinguish the type of patent protection they were claiming—simply marking the product "patented," and including the day and year of its grant was sufficient[238]—and Commissioner Leggett felt the public was being deceived into believing that the design patent covered more than just the product's aesthetics.[239] Indeed, the Commissioner in *Parkinson* stopped just shy of calling the applicant's claw-hammer design a fraudulently cloaked utility application.[240]

In addition to the public's confusion resulting from homogeneous marking conventions, courts and prior administrations also struggled to interpret the role of utility in design.[241] To effectively read the term "useful" out of the statute,

---

233. *Id.* It is surprising that he directly called attention to his "learned predecessor's" liberal stance on design patents not only because the practice did not originate with Commissioner Fisher, but because of the high regard in which he normally spoke about him. *See generally* IN MEMORIAM: SAMUEL S. FISHER 63 (Cincinnati, Robert Clarke & Co. 1874) (stating Commissioner Fisher had done "more to adapt the organization to the increased business of the office, more to establish uniformity in the practice and decisions of the office, and more to make such decisions and practice attainable and intelligible to the public, than had been done before. He ably discussed and satisfactorily settled many questions which had long vexed and harassed the office").

234. *Ex Parte* Parkinson, 1871 Dec. Comm'r Pat 251 (1871), *reprinted in* FENTON, *supra* note 37, at 255-56.

235. *Id.* at 257-59.

236. Although the Supreme Court decided *Gorham* after the 1870 Act was passed, the opinion of the Court only directly quotes the 1842 Act—referring to the 1861 Act as "reenact[ing] in substance the same things apparently, and mak[ing] some changes in the term of duration of the patent." Gorham Co. v. White, 81 U.S. 511, 512 (1871). Nevertheless, the Court did not directly address the validity of the design patent.

237. *Ex Parte* Parkinson, 1871 Dec. Comm'r Pat. 251 (1871), *reprinted in* FENTON, *supra* note 37, at 259.

238. Act of July 8, 1870, ch. 230, § 38, 16 Stat. 198, 203 (1870).

239. *Id.*

240. *Ex Parte* Parkinson, 1869 Dec. Comm'r Pat. 244 (1869), *reprinted in* FENTON, *supra* note 37, at 258-59.

241. *See, e.g.*, *Ex parte* Fenno, 1869 Dec. Comm'r Pat. 52 (1869), *reprinted in* FENTON, *supra* note 37, at 250.

Commissioner Leggett developed a strained interpretation of "utility" to adhere to the fundamental purpose of design protection.[242] He defined "utility" in terms of aesthetics.[243] Moreover, he revived the requirement, eliminated by *Crane*, that the design must be merely ornamental.[244] Although some courts eventually gave similarly strained readings to this term, many courts and commissioners went back and forth on this issue until the statute was finally amended in 1902.[245]

Like his predecessor, Commissioner Leggett was praised for reformation of the Patent Office during his administration.[246] However, he was also widely criticized for erratic decisions[247] concerning "questions of patentable novelty."[248] Knowing

---

242. *See generally* SIMONDS, *supra* note 55, at 193.

243. *See Ex parte* Parkinson, 1869 Dec. Comm'r Pat. 251 (1869), *reprinted in* FENTON, *supra* note 37, at 258. More specifically, Leggett defined the term "useful" as the "adaptation to producing pleasant emotions," which was measured by effect the design produced on the eyes. *Id.*

244. *See id.* (describing the design classes for articles of manufacture in the statute as only protecting ornamental articles, which were "articles used simply for decoration"). Indeed, Leggett's administration had an enormous effect on the development of this requirement. *See, e.g.*, *Ex parte* Seaman, 4 Off. Gaz. Pat. Office 691 (1872) (asking "[i]s its form, without reference to the function of the article, intended to be ornamental? [sic] and is the article itself a thing which may, for any practical purpose, have a merely ornamental configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?"), *reprinted in* FENTON, *supra* note 37, at 279; *Ex parte* Fairchild, 1873 Dec. Comm'r Pat. 45 (1873) (decided by John M. Thacher, Assistant Commissioner under Leggett) (finding the subject matter suitable for a design patent where it had no mechanical function), *reprinted in* FENTON, *supra* note 37, at 273; *Ex parte* T.B. Oglesby, 1873 Dec. Comm'r Pat. 35 (1873) (determining if the shape of the design was altered "for the purpose of improving its appearance merely, without changing its function or increasing its practical efficiency"), *reprinted in* FENTON, *supra* note 37, at 272; *Ex parte* T.B. Doolittle, 1872 Dec. Comm'r Pat. 176 (1872) (decided by John M. Thacher, Assistant Commissioner under Leggett) (describing the shapes or configurations that are patentable as designs as "mere fanciful ornamentation," and those that should be the subject of utility patents as "devised to serve a useful purpose"), *reprinted in* FENTON, *supra* note 37, at 266.

245. *See Ex parte* Parkinson, 1869 Dec. Comm'r Pat. 251 (1869), *reprinted in* FENTON, *supra* note 37, at 257, *overruled by Ex parte* Shoeninger, 15 Off. Gaz. Pat. Office 384 (1879), *reprinted in* FENTON, *supra* note 37, at 303 (finding "that such an extraordinary meaning as that adopted in Parkinson's case cannot fairly be imputed to the word useful in the statute seems to be fairly clear. In my opinion, the provision as it stood in the Acts of 1842 and 1861 covered designs which were ornamental, although they were at the same time useful; and the provision as it stands in the Act of 1870 covers designs which are useful, whether they are or not ornamental."), *overruled by Ex parte* Schulze-Berge, 42 Off. Gaz. Pat. Office 293 (1888); *reprinted in* FENTON, *supra* note 37, at 328-29 (applying the definition of useful from *Parkinson* and its progeny); *see also* Magliocca, *supra* note 133, at 878-79; *The Design Patent Law*, SCI. AM., Dec. 9, 1882, at 373.

246. *See generally* Reif, *supra* note 219, at 535.

247. *The Patent Office: Proposed Reorganization of the Department-Radical Changes-The Issue of Patents*, N.Y. TIMES, Mar. 13, 1872 (stating "[t]here is, of course, an entire lack of uniformity in the decisions, so that no matter what action attorneys desire of the Commissioner, they can find precedents for it, and that, too, very probably, under his own signature").

248. *The Commissionership of Patents*, SCI. AM., Oct. 17, 1874, at 241 (stating "some of his

there was potential to amend the patent statute again before it was adopted as part of the comprehensive Revised Statutes,[249] Commissioner Leggett devoted large sections of his annual reports to advocating procedural and substantive changes to the patent laws.[250] Indeed, his first two annual reports strongly lobbied for replacing design patent protection with a trademark-like registration system.[251] In his Annual Report for 1871, after discussing the marking problems and what he perceived to be a very low patentability threshold for design patents, the Commissioner wrote: "I am clearly of the opinion that the present mode of patenting designs is radically wrong, *injurious to real inventors* and the public, and not calculated 'to promote the useful arts.'"[252] He went so far as to call design patents "subversive of the fundamental object of the patent law."[253] Although past commissioners occasionally voiced their concerns about designs,[254] none came close to articulating this level of frustration. Given this environment, it is easy to understand why Commissioner Leggett advocated such a high standard of patentability for designs, in comparison to past administrations. The incorporation of the design act into the larger patent chapter of the 1870 Act also helped eliminate any perceived barriers or distinctions between the two standards. Although Commissioner Leggett applied invention to designs differently than he did to utility patents—equating invention to creative genius—his administration forever changed the way that design patents were viewed in the United States.

2. The Revised Statutes: A Typographical Error?

By 1873, the second three-year commission[255] appointed to revise and consolidate the federal statutes finally presented its report to Congress that was

---

rulings and decisions have been variable and peculiar, especially on questions of patentable novelty. At times, he has pronounced the most broad and liberal opinions in respect to the rights of inventors to receive patents, but they have been followed by recantations or reversals of these opinions").

249. *See* discussion *supra* Part II(C).

250. *See, e.g.*, MORTIMER D. LEGGETT, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, S. EXEC. DOC. NO. 58 (1874) [hereinafter Annual Report for 1873]; MORTIMER D. LEGGETT, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, H. EXEC. DOC. NO. 190 (1873) [hereinafter Annual Report for 1872]; MORTIMER D. LEGGETT, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, H. EXEC. DOC. NO. 86 (1872) [hereinafter Annual Report for 1871].

251. *See* Annual Report for 1871, *supra* note 250, at 86; Annual Report for 1872, *supra* note 250, at 190.

252. Annual Report for 1871, *supra* note 250, at 86 (emphasis added) (adding that "[v]ery many design patents, which cannot, under the law, be denied, are a fraud upon the public").

253. *Id.*

254. *See supra* notes 83-88.

255. The first commission was composed of Caleb Cushing, Charles James, & William Johnson, and the second commission was composed of Charles James, Benjamin Abbott, & Victor Barringer. *See* J. M. Jacobstein & Roy M. Mersky, *Introduction* to 2 REVISION OF THE UNITED STATES STATUTES AS DRAFTED BY THE COMMISSIONERS APPOINTED FOR THAT PURPOSE (1873) [hereinafter 1873 Revised Statutes Draft].

intended to be the basis for the Revised Statutes.[256] However, because the Joint Committee[257] overseeing the Revised Statutes felt that the Commission had overreached its mandate by making substantive changes to the law, it appointed a third-party to identify and remove the alterations from the Commission's report.[258] The Joint Committee knew that any substantive changes to the law might jeopardize its passage.[259] Given the enormous impact that Thomas Jefferson had on the development of the American patent system,[260] it was perhaps fitting that the third-party Congress turned to was named Thomas Jefferson Durant.[261] About nine months after being appointed, Durant completed his report for the Joint Committee and drafted the bill that became the Revised Statutes.[262] In 1874,[263] after Congress devoted several months of special evening sessions to amending the bill,[264] the Revised Statutes were finally signed into law by President Ulysses Grant.

The patent section of the Revised Statutes is almost identical in substance, phraseology, and order to the 1870 Act because the only amendment to the patent laws between 1870 and 1874 involved a minor change concerning the publication of the Patent Office's records.[265] However, there were a few modifications to the

256. *See* Ralph H. Dwan & Ernest R. Feilder, *The Federal Statutes – Their History and Use*, 22 MINN. L. REV. 1008, 1013 (1938).

257. *See* Act of Mar. 3, 1873, ch. 241, 17 Stat. 579 (1873).

258. *See* Dwan & Feilder, *supra* note 256, at 1013-14.

259. *Id.* ("It was the opinion of the joint committee that the commissioners had so changed and amended the statutes that it would be impossible to secure the passage of their revision.").

260. Graham v. John Deere Co., 383 U.S. 1, 6-9 (1965). *But see* Adam Mosoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent "Privilege" in Historical Context*, 92 CORNELL L. REV. 953, 960 (2007) (reevaluating the "historical myth" of the Jeffersonian story of patent law).

261. Dwan & Feilder, *supra* note 256, at 1013. Durant was "a well-known constitutional lawyer who had won laurels for his arguments in the *Slaughter-House Cases*." Erwin C. Surrency, *The Publication of Federal Laws: A Short Story*, 79 LAW. LIBR. J. 469, 478 (1987).

262. Dwan & Feilder, *supra* note 256, at 1014.

263. Although the Revised Statutes were passed in 1874, they are only an accurate reflection of the law up until Dec. 1, 1873, a month prior to the bill's introduction to the House. *Id.* at 1012. Indeed, there were several new statutes enacted into law between the Revised Statutes introduction to the House and its passage on Jun. 22, 1874. *Id.* This is why many scholars refer to these laws as the Revised Statutes of 1873 and not 1874.

264. Despite months of debate in the House, the Revised Statutes were passed by the Senate in only 40 minutes. *Id.* at 1015 n.38 (citing 67 CONG. REC. 12075 (1926) (statement of Rep. Fitzgerald)).

265. *Compare* Act of July 8, 1870, ch. 230, §§ 71-76, 16 Stat. 198, 209-10 (1870), *with* Rev. Stat. §§ 4929-4933. The only amendment to the patent laws discontinued the practice of printing issued patents in the year's Annual Report to Congress and instead ordered them to be printed for distribution as part of a compilation that would be deposited in each capital's library. CONG. GLOBE, 41st Cong., 3d Sess. 162 (1871). *See also The Patent Office Gazette*, SCI. AM., Aug. 10, 1871, at 82.

language covering design patents.[266] Indeed, the alteration of a single word in the Revised Statutes arguably eviscerated the old distinction between utility and design patents that courts and commissioners before Commissioner Leggett had observed. With the substitution of the word "or" for "and," the Revised Statutes extended protection to any person who by their "own industry, genius, efforts, and expense, has invented *and* produced any new and original design for a manufacture."[267] Previously, the statute granted protection to designs that were "invented *or* produced."[268] The alteration of this simple conjunction in the Revised Statutes now meant that "invention" and all of its baggage from utility patents applied to designs. Given design law's history, it seems fitting that the alteration was likely the result of a typographical error.[269]

At the time, the only precedent for changing the language of this section was Commissioner Leggett's administrative opinions.[270] According to its congressional mandate, however, the Commission was only supposed to compile and consolidate the Statutes at Large, changing the wording only where it was necessary for simplification.[271] The Commission was not supposed to change the law, nor was there anything in its mandate about taking administrative opinions into account.[272] Indeed, its report, which was presented to the Joint Committee for the Consolidation of the Revised Statutes, contains the same language as the Act of 1870—requiring that new and original designs be invented *or* produced by certain means, not invented *and* produced.[273] Although Durant likely revisited this section[274] because the

---

266. *Compare* Act of July 8, 1870, ch. 230, §§ 71-76, 16 Stat. 198, 209-10 (1870), *with* Rev. Stat. §§ 4929-4933. The fee structure in § 75 of the 1870 Act was combined with the utility patent fee section in § 4934 of the Revised Statutes. Additionally, the 1870 Act (§ 71) makes the grant of a design patent contingent upon "payment of the duty required by law" and the revised statutes (§ 4929) makes the grant contingent upon "payment of the fee."

267. Rev. Stat. § 4929.

268. *Compare* Rev. Stat. § 4929, *with* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10, *and* Act of Mar. 2, 1861, ch. 88, § 11, 12 Stat. 246, 248 (1861), *and* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842).

269. Professor Janice Mueller and Daniel Brean have also recently confirmed this suspicion. Janice M. Mueller & Daniel H. Brean, *Overcoming the "Impossible Issue" of Nonobviousness in Design Patents* 43-45 (University of Pittsburgh Legal Studies Research Paper Series, Working Paper No. 2009-30, 2009).

270. *See Ex parte* Weinberg, 1871 Dec. Comm'r Pat. 244 (1871), *reprinted in* FENTON, *supra* note 37, at 255-56; *Ex parte* Parkinson, 1869 Dec. Comm'r Pat. 251 (1869), *reprinted in* FENTON, *supra* note 37, at 257-59.

271. *See* Act of Jun. 27, 1866, ch. 140, § 2, 14 Stat. 74, 75 (1866). Similar to the Statutes at Large, the Commission was also supposed to notate the margins with the old statutes and court decisions that formed the foundation for each section.

272. More importantly, neither the Revised Statutes nor the Commission's report reference a single administrative decision, only case law. *See infra* note 275.

273. 1873 Revised Statutes Draft, *supra* note 255, vol. 2, tit. 63, § 44, at 19-20 (granting a design patent to "[a]ny person who, by his own industry, genius, efforts, and expense, has invented or

citations in the margins of the Revised Statutes are slightly different than those found in the Commission's report,[275] the new case listed in the margin of the Revised Statutes does not support the application of invention to design patents. There were also no other changes to the wording of this section that would have indicated that he intended to make any alterations.[276] Nor was there any discussion during the House's

---

produced any new and original design for a manufacture").

274. Durant also likely changed the catchall section back to the language used in the 1870 Act because the Commission's report contained a more flexible intent-based provision. *Compare* 1873 Revised Statutes Draft, *supra* note 255, vol. 2, tit. 63, § 48, at 20 ("The provisions of this Title expressed as being applicable to the obtaining or protection of patents for inventions or discoveries, shall apply to patents for designs; *except when a contrary intention appears*.") (emphasis added), *with* Rev. Stat. § 4933 ("All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries *not inconsistent* with the provisions of this Title, shall apply to patents for designs.") (emphasis added).

275. *Compare* 1873 Revised Statutes Draft, *supra* note 255, vol. 2, tit. 63, § 44, at 19 (citing Booth v. Garelly, 3 F. Cas. 883 (C.C.S.D.N.Y. 1847) (No. 1,646); Clark v. Bousfield, 77 U.S. 133 (1869); Wooster v. Crane, 30 F. Cas. 612 (C.C.S.D.N.Y. 1865) (No. 18,036)), *with* Rev. Stat. § 4929 (citing *Clark*, 77 U.S. at 133; Gorham Mfg. Co. v. White, 81 U.S. 511 (1871); *Booth*, 3 F. Cas. at 883; Root v. Ball, 20 F. Cas. 1157 (C.C.D. Ohio 1846) (No. 12,035), and omitting *Wooster*, 30 F. Cas. at 612).

276. The only additional (*i.e.,* intended) change in this section between the final version of the Revised Statutes and the Commission's report was the omission of a few bracketed words—"duty required by law." *Compare* Rev. Stat. § 4929 (reproduced *infra*) (emphasis added)

> Any person who, by his own industry, genius, efforts, and expense, has invented *and* produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the *fee prescribed*, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

with 1873 Revised Statutes Draft, vol. 2, tit. 63, § 44, at 19 (1873) (reproduced *infra*) (emphasis added)

> Any person who, by his own industry, genius, efforts, and expense, has invented *or* produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the [duty required by law] *fee prescribed*, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

However, this was bracketed by the Commission to indicate the old phraseology used in the 1870 Act. *See* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870). The Commission felt that it

evening sessions devoted exclusively to the Revised Statutes indicating this change. The Patent Office's own rules, which were usually updated at least twice a year, did not reflect the change in wording until five years after the Revised Statutes were adopted.[277] Therefore, the Patent Office either did not realize this section had been changed, or it thought it was a typographical error that would be corrected by Congress. Given the complex and voluminous nature of the Revised Statutes,[278] this assumption would not have been unreasonable because there were a myriad of typographical errors and other mistakes in the Revised Statutes.[279] Moreover, there were other typographical errors in this section of the Revised Statutes alone, such as changing the word "pattern" to "patent" in one of the protectable designs classes.[280]

---

should be omitted in lieu of the phrase indicated in italics—*fee prescribed. Compare* Rev. Stat. § 4929, *with* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870). Indeed, this practice of bracketing words that should be omitted from prior acts, and italicizing words that have been added, is commonly used when bills are being adopted that would amend or repeal a given law.

277. *Compare Rules of Practice In the United States Patent Office* § 24, at 4-5 (Dec. ed. 1879), *reprinted in* RULES OF PRACTICE, *supra* note 78, *with Rules of Practice In the United States Patent Office* § 79, at 23-24 (Aug. ed. 1878), *reprinted in* RULES OF PRACTICE, *supra* note 78, *and Rules of Practice In the United States Patent Office* § 79, at 23-24 (Sept. ed. 1875) (on file at Law Library of Congress), *and Rules of Practice In the United States Patent Office* § 79, at 23-24 (Apr. ed. 1875) (on file at Law Library of Congress) (reproduced *infra* note 298).

278. By the time the Commission began compiling the Statutes at Large it was already eighteen volumes long. Dwan & Feilder, *supra* note 256, at 1012.

279. Indeed, subsequent revisions were made for some of the most egregious mistakes. Dwan & Feilder, *supra* note 256, at 1014 ("[A]fter the revision had been enacted into law and while it was still on the press, sixty-nine errors were discovered. A statute was immediately enacted making corrections and supplying omissions, which was printed as an appendix in the same volume as the Revised Statutes of 1873. During the next few years one hundred eighty-three other errors plus one error in the corrections were discovered, and another statute correcting errors was enacted." (citing Act of Feb. 18, 1875, ch. 80, 18 Stat. 316 (1875); Act of Feb. 27, 1877, ch. 69, 19 Stat. 240 (1877)).

280. ALBERT H. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA 14 (4th ed. 1904). In his highly influential patent law treatise, Albert Walker, claimed:

> [The] original section [of the Revised Statutes] was almost a literal transcript of Section 71 of the consolidated Patent Act of 1870, except that in the latter the word 'pattern' is found in the connection in which the word 'patent' is printed in Section 4929. The change from 'pattern' to 'patent' was doubtless an error of the printers of the Revised Statutes. Those statutes were enacted as printed, and not as is the custom with shorter edicts, as engrossed in writing. The word patent' is meaningless in that connection, and patterns, though not mentioned in the section, were doubtless covered by its other provisions.

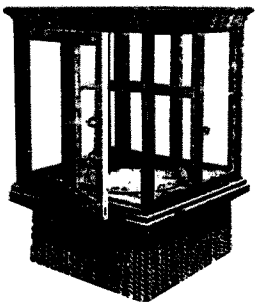
Id.; HUTCHINSON, *supra* note 205, at 25 (including the word "pattern" in parentheses next to the word "patent" for this class). *Compare* Rev. Stat. § 4929 (protecting "any new and original impression, ornament, *patent*, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture") (emphasis added), *with* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870) (including "any new and original impression, ornament, *pattern*, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture") (emphasis added). Additionally, the Commissions' draft reflected the language from the 1870 Act.

However, unlike some of the more egregious typographical errors, these seemingly minor alterations were never corrected in the numerous amendments to the Revised Statutes.[281]

B. *The Catchall Section*

Although Commissioner Leggett was the first to require design patents to exhibit invention, he never applied the same criteria for invention to utility and design patent applications. However, once the Patent Office[282] and courts started applying the rubric of invention to designs, it did not take long for the substantive criteria to merge. In *Northrup*, the Eastern District of Michigan helped supply a strong basis for this merger[283] when it invalidated a design patent for a provision or cheese-safe because the differences in size and molding from the prior art were well-known.[284]

Patentee's Design



1873 Revised Statutes Draft, *supra* note 255, vol. 2, tit. 63, § 44, at 19 (1873).

281. The only way to conclusively show that this alternation was a typo would be to additionally compare Durant's report or the bill that was introduced to the House (43d CONG. GLOBE, 1st Sess. 819 (1874)) to the printed version of the Revised Statutes. To add to the Revised Statutes' lore, however, nobody has known the location of these documents for quite some time. Jacobstein & Mersky, *Introduction* to 1873 Revised Statutes Draft, *supra* note 255, vol. 2 (1873) (citing 1 CHECKLIST OF UNITED STATES DOCUMENTS 1789-1909, at 1524-25 (3d ed. 1921)). It appears that these documents have been missing since the turn of the 20th century. *Id.* Indeed, countless searches performed during spring 2009 at the Library of Congress, National Archives, and Senate Library proved unsuccessful.

282. Due to the "special" nature of the law for designs, in his annual report for 1879, the Commissioner of Patents called for the establishment of a specialized examination division for designs and the appointment of a principal examiner to lead the unit. HALBERT E. PAINE, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, H. Exec. Doc. No. 33, at v (1880) [hereinafter Annual Report for 1879].

283. Northrup v. Adams, 18 F. Cas. 374 (C.C.E.D. Mich. 1877) (No. 10,328); *see also* W. Elec. Mfg. v. Odell, 18 F. 321, 323 (N.D.Ill. 1883).

284. Provision-Safe, U.S. Patent No. D8,704 (Oct. 5, 1875) (diagram from patent).

Citing to the catchall section,[285] Judge Henry Brown reasoned that because "[t]he same general principles of construction extend[ed] to both,"[286] that designs must also be produced by "the exercise of inventive faculty."[287] Accordingly, "Mere mechanical skill is insufficient. There must be something akin to genius."[288] On its face, this argument seems reasonable because the catchall section provides that: "All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs."[289] However, as discussed above, the legislative history of this section reveals that it was only intended to make the laws related to prosecution and enforcement applicable to designs.

This catchall section, which is almost identical to § 76 of the Act of 1870,[290] actually comes from the first design Act of 1842.[291] When read as a part of the initial

---

285. Rev. Stat. § 4933. The court also cites to the only design law treatise at the time for support. *Northrup*, 18 F. Cas. at 374 (citing SIMONDS, THE LAW OF DESIGN PATENTS, *supra* note 55, at 191-94). However, they misspelled his name—citing Simons. *Id.* Although Simonds did not advocate Leggett's seemingly harsh standard for designs, he did think that the standard should be more than mere production. SIMONDS, *supra* note 51, at 191-92. He argued that the word "genius" was introduced to the statute to indicate a higher order of patentability than mere production. *Id.* at 192-93. However it is not clear whether he also would have required designs to be "inventive," or whether he saw the word "genius" as simply a separate requirement for both designs and utility patents. *Id.* at 193.

286. *Northrup*, 18 F. Cas. at 374.

287. *Id.*

288. *Id.* Ignoring the Supreme Court's cautionary anti-dissection advice in *Gorham*, the *Northrup* decision also stated:

> If a combination of old designs be patentable at all, of which I have some doubt, the combination must be such as to produce a new appearance. If the effect produced be simply the aggregation of familiar designs, it would not be patentable.

Id.; *see also* Gorham Mfg. Co. v. White, 81 U.S. 511, 525 (1871) ("To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."). Similar to the analogous use doctrine for utility patents, this so-called "double use" test was often applied to preclude the patentability of designs that appeared to simply (1) apply a known design to a new article or (2) apply portions of other designs that did not cohesively create a new design (*i.e.*, *aggregation* of other designs). *See* SHOEMAKER, *supra* note 33, at 49-50 (describing this test also as the doctrine of combinations or elements); discussion *infra* Part IV(B)(2)(b). Both the analogous (*i.e.*, utility) and double (*i.e.*, design) use tests are representative of the broad application of the novelty requirement during this time. *See* discussion *supra* note 12 and *infra* note 304.

289. Rev. Stat. § 4933.

290. *Compare* Act of July 8, 1870, ch. 230, § 76, 16 Stat. 198, 210 (1870) ("*And be it further enacted*, That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs") (fully reproduced *supra* note 194), *with* Rev. Stat. § 4933 ("All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs").

291. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543-44 (1842) ("*Provided*, That the fee in

Act, it is clear from the lack of discussion concerning major issues such as filing requirements and remedies, that this phrase was added to the section so that the drafters did not have to reproduce the prosecution and enforcement provisions from the general patent act (*i.e.*, shorthand).[292] It was omitted from the Act of 1861 because many of these details were now included in the Act's plain language, instead of by reference.[293] When the Commission for the Revised Statutes began consolidating the Act of 1842 and the Act of 1861, it divided these acts into smaller, more comprehensible sections.[294] As a result of its inclusion in the Act of 1842, the catchall section ended up as one of six separate sections covering designs in the Act of 1870.[295] Indeed, this section was actually part of the draft that was sent by the Commission to the House Committee on Patents,[296] which meant that by congressional mandate it could have only reflected what the law was at the time.[297] Because the catchall section was not added by the House Committee on Patents to the Commission's draft, this section could only have been intended by its drafters to apply the prosecution and enforcement provisions from utility to design patents, as it did before the Act. The rules issued by the Patent Office during this time also gave the same construction to the catchall section.[298] Moreover, in light of Commissioner

---

such cases which by the now existing laws would be required of the particular applicant shall be one half the sum, and that the duration of said patent shall be seven years, and that *all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.*") (emphasis added) (fully reproduced *supra* note 60).

292. *See supra* Part I(A).

293. *See supra* Part II(B).

294. Essentially, the Commission's job was to take all of the volumes from the Statutes at Large and compile them—consolidating the laws that were still valid and removing those that had been repealed by subsequent acts.

295. *See* Act of July 8, 1870, ch. 230, § 76, 16 Stat. 198, 210 (1870).

296. 1869 REVISED STATUTES DRAFT, *supra* note 202, § 74, at 26; *see also* discussion *supra* note 274.

297. *See* Act of Jun. 27, 1866, ch. 140, §§ 1-2, 14 Stat. 74, 74-75 (1866). Paradoxically, it is odd that the Commission included it in their draft because the 1842 Act was effectively repealed by the 1861 Act. It is clear, however, that the Commission haphazardly added the elements from the 1842 and 1861 Acts together. For example, Congress had expressly refused to include "new and original design[s] for the printing of woolen, silk, cotton, or other fabrics" in the 1861 Act. *See* discussion *supra* note 99. Yet, the Commission's draft also reintroduced this class from the 1842 Act. 1869 REVISED STATUTES DRAFT, *supra* note 202, § 69, at 26.

298. *See generally* discussion *supra* note 186. Similar to the MPEP, the early rules were drafted by taking the patent act at the time and adding details, structure, and examples to each section. *See* STODDARD, *supra* note 112, at 2. Designs had their own chapter in the rules, just as they did in the larger patent act. *Id.* at 810. The April 1875 Patent Office rules are the closest known set of rules to the time the Revised Statues were passed. *Rules of Practice In the United States Patent Office* § 79, at 23-24 (Apr. ed. 1875). Its design portion provided in part:

> 79. A patent for a design may be granted to any person, whether citizen or alien, who, by his own industry, genius, efforts, and expense, has invented or produced any new and

Fisher's Patent Office opinions, which expressly envisioned design patents as separate and distinct from utility patents,[299] and his high level of involvement in the Act of 1870's passage,[300] it is not likely that the House Committee on Patents would have intended to apply the same substantive principles from utility patents. Although *Northrup* was not the first court to cite the catchall section,[301] prior to this opinion it

---

> original design for a manufacture, bust, statute, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any articles of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, upon payment of the duty required by law, and *other due proceedings had the same as in cases of inventions or discoveries.*
>
> 80. Patents for deigns are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect.
>
> 81. *The proceedings in applications for patents for designs are substantially the same as for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is held to be new. The claims also should be as distinct and specific as in the case of patents for inventions or discoveries.*
>
> 82. When the design can be sufficiently represented by drawings or photographs a model will not be required.
>
> 83. Whenever a photograph or an engraving is employed to illustrate the design, it must be mounted upon a thick Bristol-board or drawing-paper, ten by fifteen inches in size; and the applicant will be required to furnish ten extra copies of such photograph or engraving, (not mounted,) of a size not exceeding seven and a half inches by eleven. Negatives will no longer be required.
>
> Whenever the design is represented by a drawing, each of the ten copies must be made to conform as nearly as possible to the rules laid down for drawings of mechanical inventions.

Id. at 23-24 (emphasis added). For nonobviousness, the catchall section of the Act supports the application of Rule 81 and possibly the last portion of Rule 79. *See id.* Later annotated versions of the rules also gave the same construction to these rules—finding the catchall section as support for Rules 79 and 81. *See, e.g.*, *Rules of Practice in the United States Patent Office*, §§ 79, 81, at 26-27 (Jan. 2, 1903) (Commissioner Fredrick I. Allen). Notably, both of these sections only apply procedural rules from utility patents.

299. *See Ex parte* Sellers, 1870 Dec. Comm'r Pat. 58 (1870), *reprinted in* FENTON, *supra* note 37, at 245 ("I regard the eleventh section of the Act of 1861 as distinct from the remainder of the law as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter.").

300. *See* discussion *supra* notes 186, 188.

301. Although a few commissioners' opinions dealing with invention cite to this provision—largely as a recitation of the sections on design—none used it as a basis for merging the two standards. *See, e.g.*, Bennage v. Phillippi, 9 Off. Gaz. Pat. Office 1159 (1876), *reprinted in* FENTON, *supra* note 37, at 289.

was used only to apply statutes and precedent related to the prosecution and enforcement of utility patents.[302]

C. *The Supreme Court's Revolving Door*

While there were still some holdouts[303] after Justice Brown's decision in *Northrup* and the typographical error in the Revised Statutes, most courts required designs to meet an invention or heightened novelty requirement.[304] However, they all applied the new requirement differently. Some courts required invention, but recognized a much lower standard for designs.[305] Yet, other courts forced the same muddled precedent from utility patents onto designs.[306] As a result of these disparities, the issue was ripe for review by the Supreme Court.[307]

---

302. In *Dobson v. Doran*, the Supreme Court similarly cited to the catchall section to support applying the written description requirement from utility patents to designs. 118 U.S. 10, 14 (1886).

303. *See, e.g.*, Simpson v. Davis, 12 F. 144, 145 (C.C.E.D.N.Y. 1882) (reasoning that "[t]he amount of the novelty may be small, but the effect of the ornament must, to some extent at least, be new," yet also indicating that for purposes of an ornamentation requirement, the statutory language may play a role in its patentability by stating, "mere juxtaposition of old forms is doubtless sufficient to authorize a patents for an ornament when, by means of juxtaposition, accomplished by industry, genius, effort and expense, the old forms are made to become component parts of an ornament substantially new in its effect").

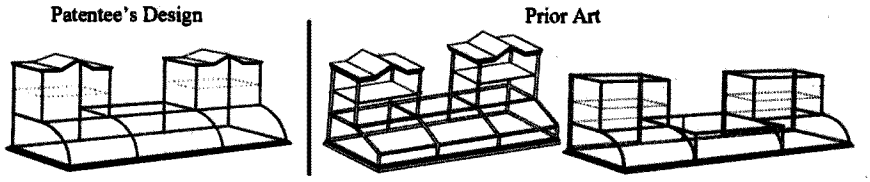
304. Indeed, most courts that did not expressly apply the invention requirement to designs began requiring designs to meet the same invention-like novelty bars from utility patents. *See* discussion *supra* note 288; *see, e.g.*, Post v. Richards Hardware Co., 26 Fed. Rep. 618 (C.C.D. Conn. 1886) (requiring novelty yet precluding patentability where the only difference between the patentee's design and the prior art was the substitution of one material for another); *Bennage*, 9 Off. Gaz. Pat. Office 1159 (1876), *reprinted in* FENTON, *supra* note 37, at 289 (applying the double use doctrine to declare a design patent for a miniature version of the Memorial Hall building invalid).

305. *See, e.g.*, Smith v. Stewart, 55 F. 481, 483 (C.C.E.D.Pa. 1893) (stating "[t]he invention in a majority of patented designs is very small, and of a low order. All the statute, as commonly interpreted, requires is the production of a new and pleasing design, which may add value to the object for which it is intended. The invention consists in the conception and production of this, however simple it may be."); Untermeyer v. Freund, 37 F. 342, 344-45 (C.C.S.D.N.Y. 1889) (acknowledging that "design patent[s] must necessarily relate to subject matter comparatively trivial" and finding that if the design "presents a different impression upon the eye from anything which precedes it, if it proves to be pleasing, attractive, and popular, if it creates a demand for the goods of its originator, even though it be simple, and does not show a wide departure from other designs, its use will be protected"); Redway v. Ohio Stove Co., 38 F. 582, 583 (C.C.S.D. Ohio 1889) (expressly requiring invention but recognizing that the invention need not be great—in practice, only applying a novelty standard by finding a "conventional design" inventive).

306. *See In re* Niedringhaus, 9 D.C. (2 MacArth.) 149 (D.C. 1875). In affirming the commissioner's design patent rejection, the Supreme Court of D.C. stated:

> The ingenuity and taste of workers in enamel are quite wonderful to all but those employed in it; but no one would imagine that these exhibitions of skill in giving beautiful forms or colors to their productions was the kind of invention to be protected by the law. They are the common efforts of person ordinarily skilled in the art.

In *Lehnbeuter v. Holthaus*, the Supreme Court was presented with an appeal concerning the validity of a design patent for a showcase.[308]



Comparing the patented design[309] to the prior art, [310] Justice William Woods stated: "The design patented by the complainants differs essentially from any other which has been called to our attention. . . . Whether it is more graceful or beautiful than older designs is not for us to decide. It is sufficient if it is new and useful."[311] Indeed, the Court flatly refused to apply anything beyond an identical novelty requirement.

The Court's holding made it clear that designs did not have to satisfy the invention requirement or any of its related rubric.[312] Unfortunately, Justice Woods's concise wording provided little insight into the Court's reasoning.[313] Despite several

---

Id.

307. Although the Supreme Court dealt with design patents in the past, it was never directly presented with this issue. *See* Clark v. Bousfield, 77 U.S. 133, 139 (1869); Gorham Co. v. White, 81 U.S. 511, 511 (1871). However, the Supreme Court's decision in *Gorham* was instructive on a number patentability issues. *See* 81 U.S. at 524-25. First, it emphasized that a design patent only protected the design's appearance, not the mode that it was made. And second, it held that infringement should be found where two designs are substantially similar to the ordinary observer. *See Gorham*, 81 U.S. at 528 (finding infringement "if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such to deceive such an observer, inducing him to purchase one supposing it to be the other"). During its discussion, however, the Court referred to the appearance as "the *invention*," and "the thing *invented or produced*." *Id.* Because the Court used both terms throughout the opinion, it was not clear after *Gorham* whether designs also had to exhibit invention. *See id.*

308. Lehnbeuter v. Holthaus, 105 U.S. 94 (1882).

309. Show-cases, U.S. Patent No. D8,814 (filed July 22, 1875) (issued Nov. 30, 1875) (diagram from patent on the far left).

310. Show-cases, U.S. Patent No. D8,813 (filed July 22, 1875) (issued Nov. 30, 1876) (diagram from patent in the middle); Show-cases and Stands, U.S. Patent No. D8,287 (filed Apr. 14, 1875) (issued Apr. 27, 1875) (diagram from patent on the far right). However, there were also other non-patented prior art references. *Lehnbeuter*, 105 U.S. at 95. Unfortunately, neither the district court's nor Supreme Court's records included images of the references.

311. *Id.* at 96.

312. *Id.*

313. Indeed, the opinion of the Court is only five paragraphs long. *Id.* at 96-97. Although the Supreme Court only applied the novelty requirement, it is not clear from the Supreme Court or the Eastern District of Missouri's record if the trial court ever actually required the design patent to evince a certain level of beauty or genius. *See* Transcript of Record at 7, Lehnbeuter v. Holthaus, 105

opportunities over the next decade, the Supreme Court never disturbed its holding in *Lehnbeuter*.[314]

Drowning in the deluge of lower courts that continued to apply the invention requirement to designs after *Lehnbeuter*, the Supreme Court finally surrendered in *Smith v. Whitman Saddle*.[315] Quoting a large section of Justice Brown's opinion in *Northrup*—which relied on the application of the catchall section to support applying the invention requirement to designs—the Supreme Court concluded that "[t]he exercise of inventive or originative faculty . . . [was] required."[316] Indeed, the Court used similar language and reasoning in *Hotchkiss* when applying the invention requirement to a utility patent.[317] In its patentability analysis of the horse saddle design, the Court explained:

> Nothing more was done in this instance . . . than to put the two halves of these saddles together in the *exercise of the ordinary skill of workmen of the trade*, and in the way and manner ordinarily done. The presence or the absence of the

---

U.S. 94 (1882) (No. 203); Transcript of Record, Lehnbeuter v. Holthaus, No. 1065 (C.C.E.D. Mo. Oct. 31, 1878) (unreported) (on file with The U.S. National Archives & Records Administration in Kansas City). However, the petitioner's brief before the Supreme Court paints the circuit court's decision as dependent upon the showcase's lack of beauty, artistic merit, or extraordinary genius. Brief of Petitioner-Appellant at 3, 4, 5, *Lehnbeuter*, 105 U.S. 94 (1882) (No. 203). While the respondent was represented at trial, there was no opposing counsel of record at the Supreme Court and no brief filed. *See Lehnbeuter*, 105 U.S. at 96.

314. In *N.Y. Belting & Packing Co.*, the first question presented to the Supreme Court in the petitioner's brief asked, "What is the degree of invention requisite to support a patent for a design?" Brief of Petitioner-Appellant at 3, N.Y. Belting & Packing Co. v. N.J. Car-Spring & Rubber Co., 137 U.S. 445 (1890) (No. 39). Instead of directly addressing the issue, the Supreme Court remanded the case so that the trial court could resolve whether the design was new. *N.Y. Belting & Packing Co.*, 137 U.S. at 450. Notably, the Court did not mention examining the design for invention. *See also* Dobson v. Hartford Carpet Co., 114 U.S. 439, 444 (1885) (equating "patents for inventions" to only utility patents and containing language that indicates "patents for inventions" are different than patents for designs).

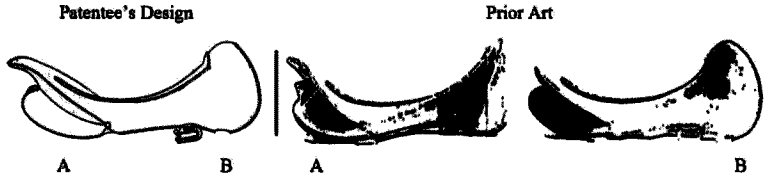
315. 148 U.S. 674, 679 (1893). This opinion was also recently cited in *Egyptian Goddess v. Swisa* as the genesis of the point of novelty test. 543 F.3d at 672. However, this form of infringement analysis existed long before *Smith v. Whitman Saddle Co. See* Crocker v. Cutter Tower Co., 29 F. 456 (C.C.D. Mass. 1886) (examining which elements of the design for an easel were old or new, and then basing infringement upon whether the claimed infringer's product contained those elements).

316. Smith v. Whitman Saddle Co., 148 U.S. 674, 679 (1893). Counsel for the appellant in this case was W.E. Simonds—author of the design treatise that was cited as support for the application of invention to designs in the *Northrup* opinion. *See id.* at 677. It should not come as a surprise that he included a large portion of the opinion in his brief before the Supreme Court. Brief of Petitioner-Appellant at 29, *Smith*, No. 13,780 (U.S. Oct. 15, 1889). However, he conveniently omitted the section where the court cited to his treatise—possibly because his name was misspelled, but more likely due to its dubious nature. *See id.* Simonds handled this case at the district court and once again on appeal to the Supreme Court after his term as Commissioner of Patents ended.

317. *Compare* Hotchkiss v. Greenwood, 52 U.S. 248, 267 (1850), *with Whitman Saddle Co.*, 148 U.S. at 679.

> central open slot was not material, and we do not think that the addition of a known cantle . . . was common, in itself involved *genius or invention, or produced a patentable design.*[318]

Analogous to its utility patent approach, the Court concluded that the horse saddle design[319] did not meet the invention requirement because it could be reconstructed by combining different halves of prior art saddle references (A+B = Patentee's Design).[320]



It is noteworthy that the Court applied such a piecemeal approach to the invention requirement given its past decisions' strong anti-dissection proclamations for infringement and novelty.[321] Additionally, it seems odd that the Court would pull and plug elements of designs in such a mechanical fashion. While the showcase design in

---

318. *Whitman Saddle Co.*, 148 U.S. at 681 (emphasis added).

319. Saddles, U.S. Patent No. D10,844 (filed Sept. 2, 1878) (issued Sept. 24, 1878) (diagram from patent on the far left).

320. Brief of Petitioner-Appellant, *Smith*, No. 13,780 (U.S. Oct. 15, 1889) (images located between pages thirty and thirty-one of the Appellant's brief). The Jenifer saddle is located in the middle and the Granger saddle is located on the far right. According to the Court, the patented design was largely a combination of the cantle/front of the Jenifer saddle (A) and the pommel/rear of the Granger saddle (B). *Whitman Saddle Co.*, 148 U.S. at 680. The Court did, however, recognize that the pommel/rear (B) of the Granger saddle was not entirely identical to the pommel/rear of the patented design. *Id.* at 682. Its drop was a little sharper or pronounced than the prior art's. *Id.* As a result of this difference, the Court did not invalidate the design patent. *Id.* Rather the Court held that if the accentuated drop of the saddle's pommel/rear (B) rendered the design patent patentable, there was no infringement because the accused infringer's saddle did not include the drop. *Id.* Accordingly, the Court's application of the invention requirement was arguably dicta.

321. *See* Dobson v. Dornan, 118 U.S. 10, 15 (1886) ("Undoubtedly the claim in this case covers the design as a whole, and not any part of it as a part; and it is to be tested as a whole, as to novelty and infringement."); Gorham Co. v. White, 81 U.S. 511, 526 (1871) ("We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect."). *But see* N.Y. Belting & Packing Co. v. N.J. Car-Spring & Rubber Co., 137 U.S. 445, 450 (1890) (focusing on one aspect of the design patent, the Court stated, "There is one feature of this patent which presents an interesting, if not a novel aspect.").

Lehnbeuter would not have survived this approach,[322] the Court reaffirmed its proclamation that utility could be a design patentability consideration for articles of manufacture.[323]

After *Whitman Saddle*, there was little doubt that design patents must exhibit invention. Nevertheless, it is unclear why the Supreme Court finally changed its stance on the application of invention to designs after all this time. When it decided *Lehnbeuter*, it was already distinctly in the minority. What changed during those eleven years? Did the Court undergo an ideological change, or was *Whitman Saddle* just representative of the idiosyncratic development of design patents?

The most likely reason for the Court's flip-flop was the makeup of its bench. Only four justices from *Lehnbeuter* were even alive when *Whitman Saddle* was decided.[324] Moreover, only three of those justices sat and participated in both

---

322. One might argue the patentee's showcase design consists of little more than the top portion of the first prior art reference and the lower portion of the second prior art reference. *See supra* notes 309, 310. Applying *Whitman Saddle*, the patentee's showcase would likely be invalidated as merely an exercise of the ordinary skill of a workman in the trade. *See Whitman Saddle Co.*, 148 U.S. at 681.

323. Although it is assumed that the Court was speaking of patentability, it is not entirely clear. After quoting a large segment of *Gorham* that described the legislative intent behind the 1842 Act as geared towards enhancing the appearances of designs, and not the manner they were produced, the Court noted that the design act had changed since *Gorham*. The Court stated:

> 'It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.' [quoting *Gorham*, 81 U.S. at 525.] This language was used in reference to ornamentation merely, and moreover the word 'useful,' which is in section 4929, was not contained in the act of 1842, under which the patent in *Gorham Co. v. White*, was granted. So that now where a new and original shape or configuration of an article of manufacture is claimed, *its utility may be also an element for consideration*." Lehnbeuter v. Holthaus, 105 U.S. 94 [(1882) (emphasis added)].

Whitman Saddle Co., 148 U.S. at 678. It is also worth noting that the Court's statement concerning the term "useful" is not entirely correct either. As noted above, the term "useful" can be found in the 1842, 1861, and 1870 Acts, as well as the Revised Statutes. *See* discussion *supra* notes 147, 198, 202-203. The term was just in another related class. *See* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544 (1842).

324. The four justices were Stephen J. Field, John M. Harlan, Horace Gray, and Samuel Blatchford. HENRY J. ABRAHAM, JUSTICES, PRESIDENTS, AND SENATORS: A HISTORY OF THE U.S. SUPREME COURT APPOINTMENTS FROM WASHINGTON TO CLINTON 350-51 (1999). When *Lehnbeuter* was decided in 1882, the Supreme Court's bench was comprised of the following justices: William B. Woods, Samuel F. Miller, Stephen J. Field, Joseph P. Bradley, John M. Harlan, Stanley Matthews, Samuel Blatchford, Horace Gray, and Morrison R. Waite. *Id.* Conversely, the bench in *Whitman Saddle* was comprised of justices: Melville W. Fuller, Stephen J. Field, John M. Harlan, Horace Gray, Samuel Blatchford, David J. Brewer, Henry B. Brown, George Shiras Jr., and Howell E. Jackson. *Id.* Only Justice Stephen J. Field sat and participated in *Gorham*, *Lehnbeuter*, and *Whitman Saddle Co.* *See generally Gorham*, 81 U.S. at 531 (Field, S., dissenting); *Lehnbeuter*, 105 U.S. 94; *Whitman Saddle Co.*, 148 U.S. 674.

decisions.[325] To clarify, Justice Horace Gray was a member of the Supreme Court when *Lehnbeuter* was decided; however, he did not sit or participate in the case because he was not a member of the Court when it was heard.[326] Yet, he might have been partially responsible for the Court's change. Indeed, Justice Gray notably decided a design patent case—while circuit riding[327] as a member of the Court between *Lehnbeuter* and *Whitman Saddle*—where he stated that design patents must be "the product of invention."[328]

While this decision is noteworthy, the most seismic shift to the bench came when *Northrup*'s author, Justice Henry Brown,[329] joined the Supreme Court a few years before *Whitman Saddle* was decided.[330] It should not be surprising that the Court's opinion in *Whitman Saddle* quoted nearly an entire paragraph from *Northrup*.[331] Most importantly, the quotation began with Justice Brown's understanding, based on the catchall section, that the laws applicable to designs did not "materially differ" from those applied to utility patents.[332] Although it is impossible to know whether Justice Brown is responsible for the Supreme Court's philosophical change towards design patents, the prominence of *Northrup*'s reasoning in the *Whitman Saddle*

However, Justice Samuel Blatchford had the most experience hearing design patents cases. Although Justice Blatchford was not a member of the Supreme Court of the U.S. when *Gorham Co.* was appealed, he was its trial court judge at the Circuit Court for the Southern District of New York. Gorham Mfg. Co. v. White, 10 F. Cas. 827 (C.C.S.D.N.Y. 1870) (No. 5,627), *rev'd* 81 U.S. at 531. Besides *Gorham*, Justice Blatchford also tried two other design patent cases before becoming an Associate Justice of the Supreme Court of the U.S. in 1882. *See* Jennings v. Kibbe, 10 F. 669 (C.C.S.D.N.Y 1882); Collender v. Griffith, 2 F. 206 (C.C.S.D.N.Y. 1880). As a member of the Supreme Court, he was on the bench for *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893), *N.Y. Belting v. N.J. Car-Spring & Rubber Co.*, 137 U.S. 445 (1890), *Dobson v. Dornan*, 118 U.S. 10, 12 (1886) (delivering the opinion of the Court), *Dobson v. Hartford Carpet Co.*, 114 U.S. 439, 440 (1885) (delivering the opinion of the Court), and *Lehnbeuter v. Holthaus*, 105 U.S. 94 (1882).

325. *See id.*

326. *See Lehnbeuter*, 105 U.S. at 97; D. GRIER STEPHENSON, THE WAITE COURT: JUSTICES, RULINGS, AND LEGACY 13 (2003).

327. *See generally* Joshua Glick, *On The Road: The Supreme Court and The History of Circuit Riding*, 24 CARDOZO L. REV. 1753 (2002) (providing background on the practice of circuit riding).

328. Foster v. Crossin, 44 F. 62, 63 (C.C.D. R.I. 1890) (concluding that the design patents for replica fork and spoon jewelry pins lacked novelty and originality). Notably, the decision also cites to *Northrup*. *Id.* at 64.

329. Justice Brown is best known for authoring the majority opinion in *Plessy v. Ferguson*, 163 U.S. 537, 540 (1896) (upholding the constitutionality of a Louisiana law that required "equal but separate accommodations for the white and colored races" (quoting La. Acts 1890, No. 111)).

330. ABRAHAM, *supra* note 324, at 351.

331. Smith v. Whitman Saddle Co., 148 U.S. 674, 679 (1893). The Court also quoted portions of *Gorham* and *Jennings v. Kibbe*. *Id.* at 678-80 (*Jennings* was decided by Justice Blatchford before he joined the Supreme Court's bench). Indeed, the Court even cited to *Foster*, which was authored by Justice Gray while circuit riding. *See* discussion *supra* note 328.

332. *Id.*

decision is strong evidence that his interpretation of the catchall section persuaded some members of the bench.[333] Indeed, *Northrup*'s interpretation of this section and the new language of the Revised Statutes gave courts and examiners all of the support they needed to apply invention and its muddled tests to designs.[334]

IV. THE ERA OF INVENTION & NONOBVIOUSNESS: FROM 1902-PRESENT

Although the invention requirement helped close the floodgates that were opened by a low order of patentability, the Patent Office and courts were still struggling to define where design patents fit in the larger pantheon of intellectual property. As a result of its hybrid nature and the difficulty of meeting the invention requirement, during the 20th century design protection eventually became splintered across all three core intellectual property regimes.[335] Despite these new options, design patents have generally remained the principal vehicle for industrial design protection.[336] The final part of this Article analyzes how Congress sought to realign the design patent regime with an amendment in 1902 to the Revised Statutes. More importantly, it focuses on the role that invention, and its replacement nonobviousness, played during this time. Lastly, it concludes by demonstrating how the haphazard adoption of the nonobviousness requirement for all patents in 1952, removed any discretion that courts had in applying the common-law doctrine of invention and preserved much of the confusion that surrounded its application to designs.

A. *The 1902 Act: Invention's New Approaches*

By 1902, Congress[337] sought to straighten out some of the confusion surrounding the protection of design functionality that was caused by the Patent

---

333. Consequently, the *Northrup* decision had such a large effect on design patent jurisprudence that it was still being cited by The Court of Customs and Patent Appeals after the 1952 Act was passed. *See In re* Glavas, 230 F.2d 447, 450 (C.C.P.A. 1956); *see also In re* Faustmann, 155 F.2d 388, 393 (C.C.P.A. 1946).

334. *See, e.g.*, Rowe v. Blodgett & Capp Co., 112 F. 61, 62 (2d Cir. 1901); Perry v. Hoskins, 111 F. 1002, 1002-03 (C.C.D. N.H. 1899); Cary Mfg. Co. v. Neal, 98 F. 617, 618 (2d Cir. 1899); Westinghouse Elec. v. Triumph Elec., 97 F. 99, 103 (6th Cir. 1899). *But see, e.g.*, Pelouze Scale & Mfg. Co. v. Am. Cutlery Co., 102 F. 916, 919 (7th Cir. 1900).

335. *See generally* Magliocca, *supra* note 133, at 850 (discussing this "ragged quilt of protection").

336. *See generally* Perry Saidman, *The Crisis in the Law of Designs*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 301, 303-04 (2007) (describing briefly the pros and cons of design protection under each regime).

337. In 1887, Congress also passed a bill that assessed a statutory minimum recovery of $250.00 in cases of willful design infringement. Act of Feb. 4, 1887, ch. 105, 24 Stat. 387 (1887). *See* Frederic H. Betts, *Some Questions Under the Design Patent Act of 1887*, 1 YALE L. J. 183 (1892) (questioning the constitutionality of the 1887 Act). Congress felt that the Supreme Court had rendered design patents worthless after its decision in *Dobson v. Hartford Carpet Co.*, 114 U.S. 439,

Office's and Supreme Court's decisions.[338] Similar to Great Britain's attempt in 1842,[339] Congress tried substituting the term "ornamental" for "useful"[340] in the design section of the Revised Statutes.[341] Under the new Act, "Any person who has invented any new, original, and ornamental design for an article of manufacture" may apply for design protection.[342] Patent Commissioner Fredrick Allen believed this amendment would reposition design patents in their proper philosophical place between mechanical patents and copyright protection.[343] Additionally, the drafters

---

444 (1885). *See* H.R. Rep No. 49-1966, at 1 (1886) ("It now appears that the design patent laws provide no effectual money recovery for infringement."); 49 CONG. REC. 834 (1887) (statement of Rep. Martin) ("Under the recent decision of the Supreme Court, it is quite impossible for him to recover anything by an action for damages in the case, or to protect himself by means of an injunction."). In its opinion, the Court required the design patentee to meet the same damages requirements for designs as it applied to utility patents. *Dobson*, 114 U.S. at 444-46 (quoting Garretson v. Clark, 111 U.S. 120, 121 (1884)). Accordingly, the patentee had to provide evidence that "separate[d] or apportion[ed] the defendant's profits and the patentee's damages between the patented feature and the unpatented features." *Id.* at 445. This manner of calculation required the patentee to not only provide evidence of the profits that resulted from the infringing product, but also to provide "reliable and tangible" evidence of the profits that were solely attributable to the infringing design. *Id.* Unfortunately, it was extremely difficult to provide this evidence without relying on conjecture or speculation because it was impossible to determine which sales were attributable to the design and which were attributable to the underlying product. According to the Committee on Patents, after the *Dobson* decision the number of design patents granted and filed each week dropped by "upwards of 50 per cent." H.R. Rep No. 49-1966, at 1.

338. *See* discussion *supra* Parts II(B), II(C), III(A)(1), III(C).

339. *See* discussion *supra* note 126.

340. *See* discussion *supra* notes 147, 203.

341. *See* Kelsey Martin Mott, *The Standard of Ornamentality in the United States Design Patent Law*, 48 A.B.A. J. 548, 550 (1962). Commissioner Allen and the original House and Senate bills actually suggested that "artistic" be used instead of "useful" in the statute. *See* S. Rep No. 57-1139, at 3 (1902).

342. Act of May 9, 1902, ch. 783, § 4929, 32 Stat. 193 (1902), provided in part:

> Sec. 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 31 of this title, obtained a patent therefor.

343. S. Rep No. 57-1139, at 3 (1902). In the report, Commissioner Allen stated:

> [I]f the present bill shall become a law the subject of design patents will occupy its proper philosophical position in the field of intellectual production, having upon the one side of it the statute providing protection to mechanical constructions possessing utility of mechanical function, and upon the other side the copyright law, whereby objects of art are protected, reserving to itself the position of protecting objects of new and artistic quality pertaining, however, to commerce,

updated this section to reflect the novelty requirements that were adopted for utility patents in 1897,[344] and they consolidated all of the individual classes of designs under the generic label "article of manufacture."[345] More importantly, the amendment also removed the language that many formalist judiciaries perceived as Congress's intent to indicate a lower threshold of patentability for designs, thus eliminating designs produced by industry, genius, efforts, and expense from the statute.[346] These changes had a drastic impact on the types of designs that were granted protection.[347] Perhaps illustrative of how design patents were granted at a lower patentability threshold, or on account of their functional attributes, from 1901 to 1902 the Patent Office had its largest drop in design patent grants—plummeting from 1,734 to 640 design patents granted.[348] Indeed, there was a prodigious degree of controversy concerning the perceived[349] subject matter changes and how the bill was passed.[350]

> but not justifying their existence upon functionality. If the design patent does not occupy this position there is no other well-defined position for it to take.

See also Annual Report for 1841, *supra* note 44, at 2. Indeed, Commissioner Allen attributed the decrease in design patent applications that year to amendments made in the 1902 Act. *See* F. I. ALLEN, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 342, at viii (1903).

344. *See* Act of Mar. 3, 1897, ch. 391, § 4886, 29 Stat. 692 (1897).

345. Act of May 9, 1902, ch. 783, § 4929, 32 Stat. 193 (1902).

346. *Compare* Act of May 9, 1902, ch. 783, § 4929, 32 Stat. 193 (1902), *with* Act of July 8, 1870, ch. 230, § 24, 16 Stat. 198, 201 (1870). *See* S. Dresner & Son, Inc. v. Doppelt, 120 F.2d 50, 51 (7th Cir. 1941) (stating, "[t]he word 'produced' which appeared in the earlier enactments has disappeared from the present Act, and there is no authority to substitute it for the word 'invented,' and thereby qualify the usual concept of invention").

347. *See* Annual Report for 1902, *supra* note 343, at viii (stating the intent of the 1902 Act was to "make clear the fact that mechanical devices of little importance unaccompanied by the development of new mechanical functions were not to be protected by design patents"); *Argument on H.R. 20172 To Amend The Patent Laws For Designs*, 59th Cong. 5 (1907) (statement of W. A. Bartlett) (commenting in 1907 to the House Committee on Patents that the design laws have been "emasculated" by recent changes that have drastically limited the scope of design patents).

348. W. W. Cochran et al., *Organization and Functions of Patent Office*, 18 J. PAT. OFF. SOC'Y 209, 233 (1936). These statistics are even more compelling if you consider that the bill was not proposed until the end of March and did not pass until May, thus only being law for about seven of twelve months in 1902. *See* Act of May 9, 1902, ch. 783, § 4929, 32 Stat. 193 (1902). Unfortunately, the Patent Office did not report the total number of design applications during this time, so it is unclear whether this drop was caused by Patent Office rejections or less filings.

349. I use the term "perceived" here because there was some debate initially whether all of the old classes were actually just consolidated into the "article of manufacture" class. *See generally In re* Schnell, 46 F.2d 203, 205-07 (C.C.P.A. 1931).

350. The chairman of the House Committee had asked for the Patent Law Association's input on the bill. Walter F. Rogers, *Patent Legislation in the Fifty-seventh Congress, First Session*, *reprinted in* Brief of Petitioner-Appellant, Eaton v. Lewis, No. 673 (U.S. May 5, 1904). However, the local patent bars never had an opportunity to submit their findings to Congress because the bill was inadvertently allowed to move forward. *Id.* at 3-4. Indeed, the bill was passed unanimously in the Senate and House without any substantive discussion at all. *Id.* at 2. After the Patent Law Association

Consequently, none of the aggrieved parties questioned the application of the invention standard and the removal of the language that might have indicated a lower patentability standard for designs.[351] Neither the House nor the Senate reports from the Committee on Patents that accompanied this bill discussed these changes at all.[352] The only potential discussion of these changes came by vague reference in the Senate's report to a letter from Commissioner Allen where he stated that "[t]he proposed statute further introduces the necessary prerequisites to obtaining a design patent, some of which were omitted from the existing statute and have been construed to be essential, by reason of section 4933"[353]—possibly applying the catchall section to support the application of invention, as in *Northrup* and *Whitman Saddle*. However, invention could not have been omitted from the statute because the typographical error in the Revised Statutes already made it a requirement.[354] One can only assume based on this reference and other language included from the *Northrup* and *Whitman Saddle* opinions, that the higher patentability standard (*i.e.*, invention versus the production of designs by industry, genius, efforts, and expense) was adopted because of the widespread belief that design patents now stood on the same level as utility patents.[355] Sparked by Commissioner Leggett's decisions,[356] this change was finally vitrified by the omission of these phrases in the 1902 Act.

---

contacted the House Committee chairman, he apologized for the oversight and contacted the Secretary of the Interior. *Id.* at 4. A brief was submitted by the members of the House Committee and the Patent Law Association to the Secretary of the Interior prior the bill's signature by the President. *Id.* As one might guess, over 90% of the Patent Law Association's members were opposed to the bill because of the perceived subject matter change. *Id.* The day after the brief was submitted to the Assistant Attorney General—to whom the matter was referred by the Secretary of the Interior—the bill was signed by the President. *Id.*; *see also* Harold Binney, *Present Status of the Law Relating to Designs*, 10 AM. LAWYER 396, 396 (1902).

351. Binney, *supra* note 347, at 396.

352. *See generally* H.R. Rep. No. 57-1661, at 1 (1902); S. Rep No. 57-1139, at 1 (1902) (including a letter from the Commissioner of Patents, F. I. Allen, to Senator Jeter C. Pritchard, chairman of the Committee on Patents). Although the Senate report contained language from the *Northrup* and *Whitman Saddle* opinions that might have supported the requirement of "inventive faculty," these incidental references were between sentences of the courts' discussion on utility. *See* S. Rep No. 57-1139, at 2.

353. S. Rep No. 57-1139, at 2. This paragraph in the Senate report also recognized that courts generally construed the prerequisites to the grant of a utility patent as necessary to designs; however, this reasoning was used to support the novelty changes to the design section that had already been adopted for utility patents in 1897. *Id.* at 2 (adding that "[i]n view of this section the courts have construed into the design patent law those prerequisites to the grant of patents which are found in section 4886, relating to mechanical patents, and it is to be presumed that by parity of reasoning the amendments introduced into section 4886 by the act of March 3, 1897, are all to be construed as necessary to be complied with for the grant of a design patent").

354. *See supra* Part III(A)(2).

355. *See* S. Rep No. 57-1139, at 2.

356. *See supra* Part III(A)(1).

After 1902 most courts universally required designs to be the product of invention or one of its closely analogous tests. As one might guess based on the diversity of forms that invention took when applied to utility patents, there was no widely accepted test for identifying invention in designs. However, there were several trends that started to emerge from this time that are closely analogous to today's standard. Unless the design was particularly simple,[357] courts usually began by comparing the claimed design to the prior art.[358] Although this process had been followed since the first design act, the Supreme Court's acknowledgement in 1885 that a design patent's subject matter was best represented by its drawings and illustrations effectively shifted lower courts' and examiners' focus from the written description and claim language to the design patent's figures.[359] As a result, genus claiming for designs began to wither away.[360] However, this change also helped remove some of the inherent uncertainty associated with translating the patentee's claim language into a visual design.[361] Finally, once the design patent was compared to the prior art, some courts asked whether the differences between the prior art and claimed design were merely the effort of a skillful mechanic[362] or designer.[363]

---

357. *See, e.g.*, Knapp v. Will & Baumer Co., 273 F. 380, 382 (2d Cir. 1921) (largely basing its invalidity holding on the notion that "[t]here are some standard forms and shapes that are known to every one [sic] and inherently open to any one [sic] to use").

358. *See, e.g.*, Crystal Percolator Co. v. Landers, Frary & Clark, 258 F. 28, 38 (D. Conn. 1919).

359. *See* Dobson v. Dornan, 118 U.S. 10, 14 (1886) ("Claiming 'the configuration of the design' is the same thing as claiming the design, or the figure, or the pattern. It is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration."). In modern terms, although *Dobson* was speaking of the written description requirement, its concerns were just as applicable to other patentability and infringement issues. *See id.* Indeed, three years after *Dobson* was decided the Patent Office formally stopped allowing genus claiming for design patents. *See* SYMONS, *supra* note 90, at 91-93 (citing *Ex parte* Gerard, 43 Off. Gaz. Pat. Office 1235 (1888)); discussion *supra* note 154. This change, however, was likely related to a larger shift from central to peripheral claiming following the 1870 Act. *See generally* Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, U. PA. L. REV. 1743, 1769 (2009); Joshua D. Sarnoff, *The Historic and Modern Doctrines of Equivalents and Claiming the Future, Part I (1790-1870)*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 371, 402 (2005).

360. *See* SYMONS, *supra* note 90, at 91-93 (citing *Ex parte* Gerard, 43 Off. Gaz. Pat. Office 1235 (1888)). While there are still ways of claiming broadly, today these methods are much more concrete. *See* Bruce A. Kugler & Craig W. Mueller, *A Fresh Perspective on Design Patents*, 38 COLO. LAW. 71, 75-76 (2009).

361. *See* N.Y. Belting & Packing Co. v. N.J. Car-Spring & Rubber Co., 137 U.S. 445, 450 (1890); discussion *supra* note 359. *See generally* SHOEMAKER, *supra* note 33, at 201-07. The Federal Circuit similarly addressed the difficult nature of translating designs into words during claim construction in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc).

362. *See, e.g.*, Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. 857, 864-65 (W.D. Mo. 1912) ("I do not think it required more than ordinary mechanical skill to make the alterations here apparent.").

Similar to the Supreme Court's reasoning in *Hotchkiss,* if the skillful mechanic or designer could have made the claimed design after viewing the prior art, then the design was not worthy of a patent. Some opinions from as early as 1905 reflect the same terms of art used today.[364] For example, in *Barnhart*, Commissioner Allen rejected a font design for "lack of invention, by reason of the mere obviousness of the changes relied upon to distinguish over prior designs."[365]

Although many courts used the legal construct of the skillful mechanic or designer[366] to determine whether the design was inventive, some courts used the viewpoint of the ordinary observer to make this determination.[367] Instead of determining whether the design was produced by ordinary skill, they considered whether the claimed design made a pleasing or beautiful enough impression on the eye such that it exhibited inventive genius.[368] This type of analysis gave judges immense latitude to insert their own personal aesthetic judgments. Although they already made aesthetic judgments when determining infringement and novelty, asking judges to analyze the beauty of designs lead to highly erratic decisions.[369] Moreover, the subjectivity of these determinations ran directly counter to the principles of aesthetic neutrality championed by Justice Holmes and the Supreme Court in copyright law by 1903.[370] It is paradoxical that copyright jurisprudence was

---

363. *See, e.g.*, *In re* Faustman, 155 F.2d 388, 393 (C.C.P.A. 1946); Kanne & Bessant, Inc. v. Eaglelet Mental Spinning Co., 54 F.2d 131, 133 (S.D.N.Y. 1931).

364. *See, e.g.*, *Ex parte* Barnhart, 115 Off. Gaz. Pat. Office 247 (1904).

365. *Id.* This was almost 50 years before similar language was codified in the nonobviousness requirement. 35 U.S.C. § 103.

366. *See, e.g.*, *In re* Warren, 194 F.2d 715, 717 (C.C.P.A. 1952) ("[A] design to be inventive must produce a substantially different aesthetic effect and requires a display of exceptional talent which is something more than that of the ordinary artisan or designer." (citing *In re* Hoffman, 58 F.2d 422, 423 (C.C.P.A. 1932)); Nat Lewis Purses, Inc. v. Carole Bags, Inc., 83 F.2d 475, 476 (2d Cir. 1936)); Mygatt v. Schaffer, 218 F. 827, 831 (2d Cir. 1914).

367. *See, e.g.*, *In re* Jabour, 182 F.2d 213, 215 (C.C.P.A. 1950) (finding that invention "def[ies] definition, and its determination resides as a subjective standard in the mind of the judge considered as an 'average observer'" (citing *In re* Johnson, 175 F.2d 791, 792 (C.C.P.A. 1949)); *In re* Park, 181 F.2d 255, 256 (C.C.P.A. 1950)).

368. *See, e.g.*, Sodemann Heat & Power Co. v. Kauffman, 275 F. 593, 599 (8th Cir. 1921) (reasoning "[w]e are unable to find any originality or any added beauty in the plaintiff's designs, or that they are so ornamental as to be akin to genius, and which can be said to arise to the level of invention"); Swank Prod. v. Silverman, 21 F. Supp. 927, 929 (D.R.I. 1938).

369. *See, e.g.*, Bolte & Weyer Co. v. Knight Light Co., 180 F. 412, 415-16 (7th Cir. 1910) ("The lamp under consideration utterly lacks in my judgment any approach to this standard [referring to genius]. In itself it is no ornament. No person of taste would choose it for a house decoration, unless it be to hide something of utility more undesirable in form."). *But cf.* E.S. Allen, *Design Patentability*, 9 J. PAT. OFF. SOC'Y 298, 302 (1926) (encouraging the Patent Office to use a grading system that would evaluate, among other things, the design's beauty as reflected in its harmony, rhythm, and balance).

370. *See* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903) ("It would

purposefully moving away from this type of qualitative requirement during the same time that design patent jurisprudence was headed towards it. This is likely why many courts that focused on the aesthetic values of designs also gave great weight to evidence indicating the design's popularity with the public.[371]

Because comparing the prior art to the claimed design encourages piecemeal deconstruction of the designs into their constituent elements, many courts emphasized making the comparison to the designs as a whole[372] or to their resultant effects.[373] Consequently, if courts could just add and subtract elements from the prior art, then no designs would warrant patents. In order to guard against this, for purposes of finding invention, courts often asked whether the elements, when added together, created a new distinctive appearance or effect.[374] On at least one occasion, the Court of Customs and Patent Appeals took this a step further by asking whether the prior art actually suggested the combination.[375] Similarly, when the claimed design was close to a piece of prior art, they examined whether the added, omitted, or substituted features substantially affected the overall appearance of the design.[376]

This era of design law can be characterized as almost universally requiring design patents to exhibit invention or applying novelty in an invention-like manner.[377] However, as with its application in utility patents, there was enormous diversity in the way this new standard was applied to designs.[378] Indeed, the lack of uniformity led

---

be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits."). Although Bleistein is a copyright case, the larger problems associated with making these types of aesthetic determinations also hold true in the design patent context. *See* discussion *infra* Part IV(B) (discussing aesthetic determinations under § 103 of the 1952 Act).

371. *See, e.g.*, General Gaslight Co. v. Matchless Mfg., 129 F. 137, 139 (C.C.S.D.N.Y. 1904); *see also* Glen Raven Knitting Mills v. Sanson Hosiery Mills, 189 F.2d 845, 853 (4th Cir. 1951) (assessing the most weight to the commercial success of the design when evaluating inventiveness but not focusing on aesthetics, like other courts).

372. *See, e.g.*, *In re* Jennings, 182 F.2d 207, 208 (C.C.P.A. 1950); Grelle v. City of Eugene, 221 F. 68, 69-70 (9th Cir. 1915); Graff, Washbourne & Dunn v. Webster, 195 F. 522, 523 (2d Cir. 1912).

373. *See, e.g.*, Macbeth-Evans Glass Co. v. Rosenbaum Co., 199 F. 154, 156-57 (W.D. Pa. 1912) (finding the resultant effect of the applicant's lamp shade, as compared to the prior art, to be a "pleasurable sensation of symmetrical beauty in contour and configuration").

374. *See, e.g.*, *In re* Faustmann, 155 F.2d 388, 393-94 (C.C.P.A. 1946).

375. *See, e.g.*, *In re* Kalter, 125 F.2d 715, 718 (C.C.P.A. 1942) ("Would the prior art references suggest doing what appellant has done?"). However, the *Kalter* court does not require this "suggestion" in the same manner as under the 1952 Act. *See* discussion Part IV(B)(2).

376. *See, e.g.*, *In re* Pearson, 70 F.2d 841, 842 (C.C.P.A. 1934).

377. *See* 1 ANTHONY W. DELLER, WALKER ON PATENTS 419 (1937).

378. *See id.* at 425; Raymond L. Walter, *A Ten Year Survey of Design Patent Litigation*, 35 J. PAT. OFF. SOC'Y 389, 393 (1953) (defining invention in the context of design patents as beyond the range of an ordinary designer, involving inventive faculty, and requiring a flash of inventive genius).

to copious House and Senate bills aimed at improving design protection during this time.[379]

B. *The 1952 Act: A Nonobvious Framework*

1. A Utility Patent Standard?

The last major revision[380] to the design patent laws occurred as part of the larger Patent Act of 1952.[381] Although the drafters were aware of the debate swirling around design patents, according to Judge Giles Rich—one of the principal architects of the Act—the drafters deliberately decided to "retain the substance of the existing design patent statute and attack the design problem at a later date, after the new Title 35 had been enacted."[382] Despite the Committee's intent to maintain the status quo, its focus on utility patents resulted in another setback for design protection.

Similar to the Revised Statutes, design patents were given their own chapter.[383] However, the six sections[384] from the Revised Statutes were consolidated into three in the 1952 Act because novelty was now separately codified for all patents,[385] design patents granted under the 1861 Act were no longer eligible for extension, and the

379. *See In re* Nalbandian, 661 F.2d 1214, 1218-19 n.1 (C.C.P.A. 1981) (Rich, J., concurring) (citing BARBARA A. RINGER, BIBLIOGRAPHY ON DESIGN PROTECTION 27-48 (1955) (detailing the legislative history of numerous design protection bills proposed from 1900 to 1953)); *see, e.g.*, *Registration of Designs: Hearing Before the Subcomm. of the S. Comm. on Patents*, 64th Cong. 69 (1917) (statement of John S. Thompson, president, Thompson Type Machine Co.) (calling for design registration bill S. 6925 to be passed, in part, because of the difficulties associated with determining what constitutes invention).

380. A minor amendment to § 4929 was passed in 1939 that changed the prior art, public use, and on-sale windows from two years to one. Act of Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212 (1939) (striking out the words "two years" and substituting the words "one year"). This amendment was needed so that the U.S. could comply with the Paris Convention. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 4, 21 U.S.T. 1583, 828 U.N.T.S. 305 (revised at Stockholm revision conference, July 14, 1967). In the 1952 Act, these novelty provisions were removed from the design and utility patent sections and collectively organized in § 102. 35 U.S.C. § 102(b) (2006).

381. Act of July 19, 1952, ch. 950, § 171, 66 Stat. 792, 805 (1952) (codified at 35 U.S.C. § 171 (2006)).

382. *In re* Nalbandian, 661 F.2d 1214, 1218-19 (1981) (Rich, J., concurring); *see also* Federico, *supra* note 34, at 202 (stating, the "[t]hree sections relating to patents for design have been placed in a chapter on Designs, without making any substantive changes").

383. *Compare* Rev. Stat. §§ 4929-4934, *with* 35 U.S.C. §§ 171-73 (2006) (reproduced *infra* note 386).

384. One of the major innovations from the 1870 Act was that it broke the single large sections from the 1842 and 1861 Acts into six smaller, more comprehendible sections. Act of July 8, 1870, ch. 230, §§ 71-76, 16 Stat. 198, 209-10 (1870).

385. 35 U.S.C. § 102. *But see* 35 U.S.C. § 172.

catchall section was incorporated into the subject matter section.[386] Under the new law, a design patent was still granted to "[w]hoever invents any new, original and ornamental design for an article of manufacture."[387] Additionally, this section incorporated a more restrictive version of the catchall section,[388] which provided: "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."[389] Most importantly, the 1952 Act also codified the invention requirement, in § 103, as a condition to patentability for all patents.[390] However, the Act did not expressly provide that § 103 was not applicable to patents for designs. As a result, although the catchall section was retained from past acts in order to theoretically maintain the status quo,[391] its restrictive language eliminated any discretion that judges had to manipulate the application of the invention requirement to design patents.[392] Indeed, as difficult as the application of

386. 35 U.S.C. §§ 171-73 provides in part:

§ 171. Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

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

§ 172. The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs. The right of priority provided for by section 119 (e) of this title shall not apply to designs.

§ 173. Patents for designs may be granted for the term fourteen years from the date of grant.

387. 35 U.S.C. § 171. Interestingly, in the first known preliminary draft of the bill that would eventually become the 1952 Act, the House Committee on the Judiciary reverted back to some of the old patentability language from the 1870 Act, granting design patents to "[a]ny person who has *invented or produced* any new, original, and ornamental design for an article of manufacture." STAFF OF H. COMM. ON THE JUDICIARY, 81ST CONG., PROPOSED REVISION AND AMENDMENT OF THE PATENT LAWS, PRELIMINARY DRAFT WITH NOTES §§ 93, 77 (1950) (emphasis added).

388. Under the Revised Statutes, regulations and provisions from inventions or discoveries did not apply to designs if they were inconsistent with the Title. *Compare* Rev. Stat. § 4933, *with* 35 U.S.C. § 171. Unfortunately, no courts from 1874 to 1952 expressly used this "inconsistent" language to support not requiring a design patent to exhibit invention.

389. 35 U.S.C. § 171 (1952). In this section and others, it is interesting that the drafters retained some of the language distinctions between utility and designs from the prior acts—distinguishing patents for inventions from patents for designs. *Id.*

390. 35 U.S.C. § 103(a) (1952).

391. *See In re* Rousso, 222 F.2d 729, 731 (C.C.P.A. 1955) (applying the catchall section from the 1952 Act in a similar last ditch effort, similar to the court in *Northrup*, to support the contention that designs must also exhibit invention).

392. *See id.* (citing the catchall section from § 171 and stating, "[n]o exception was made in the 1952 code for designs from the requirements for invention applicable to other patents, and so far as we are advised, no such exception has ever been made in any statute").

invention was before 1952, its common law development at least gave courts discretion to adapt the utility-based standard to designs.

Initially after the passage of the 1952 Act, many courts continued to apply the same tests for invention because they interpreted § 103 as merely a codification of existing law and not a revision.[393] However, after the Supreme Court clarified that § 103 was a codification of the *Hotchkiss* condition for patentability in 1965,[394] most courts adopted its application.[395] As codified, § 103 asks whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."[396] Unfortunately, it seems the drafters of the 1952 Act gave little thought to how § 103 would apply to patents for designs. Indeed, this was expressly acknowledged by one of its drafters, Judge Giles Rich, when he stated,

---

393. Early after the passage of Title 35, courts and commentators vehemently debated whether § 103 was a codification or a revision of existing precedent. Rich, *supra* note 11, at 35 ("Title 35 as a whole is a codification; but it is also specifically and officially described as a codification *and revision*"); *see also* Graham v. John Deere Co., 383 U.S. 1, 14-17 (1965) (stating § 103 "intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability"); Lyon v. Bausch & Lomb Optical Co., 224 F.2d 530, 536-37 (2d Cir. 1955) (stating that "§ 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for seventy or eighty years had continued to be regarded as authoritative").

394. *See Graham*, 383 U.S. at 17.

395. *See, e.g.*, Lancaster Colony Corp. v. Aldon Accessories, 506 F.2d 1197, 1197-98 (2d Cir. 1974); G. B. Lewis Co. v. Gould Prod. Inc., 436 F.2d 1176, 1178 (2d Cir. 1971); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 696 (2d Cir. 1961). There is still plenty of controversy concerning how this standard should be applied for both utility and design patents today. *See* KSR International Co. v. Teleflex Inc., 550 U.S. 398, 406-07 (2007). Up to this point, the Federal Circuit has avoided answering whether *KSR* applies to design patents. *See* Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372, 1384-85 (Fed. Cir. 2009). However, if the Supreme Court's past interpretations of the catchall section are any indicator of how the 1952 Act's catchall section should be applied, there is little doubt that *KSR* would be applicable. *See* discussion Parts III(B), III(C). Whether, or to what extent, it should be applicable are entirely different questions.

396. 35 U.S.C. § 103. The 1952 Act refers to utility patents as "patents for inventions," thus, partially retaining the statutory distinction from the 1870 Act and the Revised Statutes between "patents for designs" and "patents for inventions and discoveries." *See* Act of July 8, 1870, ch. 230, § 71, 16 Stat. 198, 209-10 (1870). It is odd that the drafters of § 103 used phraseology referring to a time of invention. *See* 35 U.S.C. § 103. On its face, this language suggests that § 103 might not apply to patents for designs. However, it is clear that courts have no discretion to decide whether § 103 is applicable to designs because of the restrictive language used in the catchall section of the new Act. *See In re Rousso*, 222 F.2d at 731. Furthermore, this distinction was arguably eviscerated by the typographical error in the Revised Statutes that made invention a statutory requirement. *See supra* Part III(A)(2).

> [T]he patentability of designs [be]came . . . subject to the new § 103[,] which was written with an eye to the kinds of inventions encompassed by § 101 [(*i.e.*, utility patents)] with no thought at all of how it might affect designs. Therefore, the design protection problem was in no way made better; perhaps it was made worse.[397]

2. New Standard, Same Problems: Learning From the Past

As long as one accepts design's place in the patent regime, most do not have a problem with the theoretical foundation for the nonobviousness requirement. Rather, it is the application of § 103 that commentators and designers take issue with.[398] Many feel that § 103's application to designs is simply too harsh.[399] As Professor Gerard Magliocca states, "most designs involve rearranging basic artistic elements (*e.g.*, colors, shapes, and materials) into a new pattern."[400] This new combination of basic artistic elements is almost always open to an obviousness attack, except in the rare circumstance when this combination creates an entirely new style.[401] Unfortunately, this expectation seems out of touch with the incremental nature of commercial design.[402]

Much like its predecessor, commentators also take issue with the subjectivity of the nonobviousness requirement's application to designs.[403] Although § 103 is also fairly subjective as applied to utility patents, it is more problematic for designs because of the inherently personal nature of aesthetic determinations.[404] Similar to the invention requirement, nonobviousness adds another layer to a novelty determination by asking whether the patentee's design is *different enough* from the prior art to warrant a patent.[405] This level of differentiation[406] is often difficult to

---

397. *In re* Nalbandian, 661 F.2d 1214, 1219 (C.C.P.A. 1981) (Rich, J., concurring).

398. *See* Dienner, *supra* note 130, at 676 (finding measurement completely subjective because it depends on the taste of the observer). *But cf.* Anthony E. Dowell, *Trade Dress Protection of Product Designs: Stifling the Progress of Science and the Useful Arts for an Unlimited Time*, 70 NOTRE DAME L. REV. 137, 138 (1994).

399. *See generally In re* Laverne, 356 F.2d 1003, 1006 (C.C.P.A. 1966), *overruled by In re* Nalbandian, 661 F.2d at 1216.

400. Magliocca, *supra* note 133, at 852.

401. *Id.*

402. *Id.*

403. *See* Dienner, *supra* note 130, at 676 (stating, "the matter of an ornamental design is completely subjective, that is, consists totally in the effect upon one of the senses, namely, sight, just as music produces its effect solely upon the ear").

404. Rains v. Niaqua, Inc., 406 F.2d 275, 278 (2d Cir. 1969) (stating, "[t]he entire concept of obviousness is, no doubt, 'an elusive one, especially when applied to elements of design'" (quoting Hygienic Specialties Co. v. H.G. Salzman, Inc., 302 F.2d 614, 618 (2d Cir. 1962))).

405. *In re* Bartlett, 300 F.2d 942, 944 (C.C.P.A 1962) ("Whether the design is unobvious is a question not unrelated to novelty, however, and the differences in degree and in kind which one can

enunciate—making appellate review challenging.[407] Complicating matters, objective evidence of nonobviousness (*i.e.*, secondary considerations) is rarely applicable in design cases.[408] Acknowledging their frustration with § 103, the Court of Customs and Patent Appeals stated that this determination "must finally rest on the subjective conclusion of each judge."[409]

As a result of the perceived subjectivity and severity of the nonobviousness requirement, the Court of Customs and Patent Appeals, and its successor, the Federal Circuit, have tried fine-tuning its application to designs. Given the circular nature of these issues over the first century of design protection, many of these methods have been employed by courts in the past to alleviate the effects of the invention requirement. Applying these teachings, this Section will conclude by tracing how courts adjusted (1) the viewpoint that the nonobviousness requirement is posed from and (2) the procedure for dealing with challenges based on combinations of prior art references.

---

observe are the only criteria of decision available to us.").

406. In order to be patentable, courts have held that this difference between the prior art and the applicant's design must be distinct or substantial, or in the alternative, that the differences must not be de minimis. *See, e.g.*, *In re* Chung, No. 94-3396, 2000 U.S. App. LEXIS 24916, at *8 (Fed. Cir. 2000) (finding de minimis changes between the applicant's design and the prior art); *Ex parte* Igarashi, 228 U.S.P.Q. 463 (B.P.A.I. 1985); *In re Blum*, 374 F.2d 904, 908 (C.C.P.A. 1967) (finding de minimis changes between the applicant's design and the prior art); *In re Bartlett*, 300 F.2d at 944 (finding the applicant's design created a "distinctly new and different impression"); *In re* Zemon, 205 F.2d 317, 320 (C.C.P.A. 1953) (holding that "[t]he difference must be a substantial and not a superficial one and the inventive concept must be present in the design applicant's drawing."). Regardless of how this distinction is quantified, it ultimately seems no less subjective.

407. *See In re* Braun, 275 F.2d 738, 740 (C.C.P.A. 1960) (finding that "[s]omething from the creativity of the artist impinges itself on our consciousness which we are unable to equate with the concept of obviousness").

408. In rare circumstances, courts might have evidence of commercial success, copying, or even licensing. Unfortunately, it is often difficult to demonstrate a clear nexus between this evidence and the new design. For example, commercial success is hard to prove because it is difficult to show that the product's success was due to its design and not other factors (*e.g.*, function, marketing, etc). *See, e.g.*, Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1564 (Fed. Cir. 1988); John Charles Designs, Inc. v. Queen Int. Design, Inc., 940 F. Supp 1516, 1521-22 (C.D. Cal. 1996). However, if the product has won any tradeshow awards for its design this might be strong evidence of nonobviousness.

409. *In re* Bartlett, 300 F.2d 942, 944 (C.C.P.A 1962). Although there may be certain truths in art and design that universally affect how this determination is made by layman and art critic alike, it does not seem reasonable to expect judges or juries to strike a proper balance between these metrics and their own personal taste. *See generally* Peter H. Bloch, *Seeking the Ideal Form: Product Design and Consumer Response*, 59 J. MARKETING 16, 21 (1995) (providing examples of universal truths such as the preference towards symmetric objects and unified designs).

a. Viewpoint

To ameliorate the harsh effects of § 103 on design patents, one place that courts turned was the viewpoint from which the question was asked. Although some evaluated invention from the ordinary intelligent person's perspective prior to the 1952 Act, nonobviousness's new framework was more rigid than its common law predecessor.[410] Indeed, § 103's language demands that nonobviousness be determined from the viewpoint of the person having ordinary skill.[411] Struggling to apply this new standard to a design patent application for a chair, Judge Rich in *Laverne* stated:

> [I]f we equate him [(*i.e.*, the person of ordinary skill in the art)] with the class of mechanics, as the examiner did, and refuse design patent protection to his usual work product, are we not ruling out, as a practical matter, all patent protection for ornamental designs for articles of manufacture? Yet the clear purpose of the design patent law is to promote progress in the art of industrial design and who is going to produce that progress if it is not the class of competent designers?[412]

As a result, the court decided to use the less critical viewpoint of the ordinary intelligent observer and ultimately reversed the board's § 103 rejection.[413] Although Judge Rich's desire to honor the congressional intent behind the Act seemed admirable,[414] and was reflective of the interpretation expressed in *Crane* and by the Supreme Court,[415] his interpretation of the nonobviousness requirement ignored § 103's plain language and overlooked Supreme Court precedent applying the requirement to utility patents.[416]

---

410. *See* 35 U.S.C. § 103.

411. *See, e.g.*, *In re* Laverne, 356 F.2d 1003, 1006 (1966). Under the 1902 Act, many courts similarly applied the invention requirement from the viewpoint of the ordinary observer. *See supra* note 367 and accompanying text.

412. *In re Laverne*, 356 F.2d at 1006.

413. *Id.* at 1006, 1007-08.

414. The old Court of Customs and Patent Appeals has been characterized by many commentators as pro-patentee. *See* Lawrence Baum, *Judicial Specialization, Litigant Influence, and Substantive Policy: The Court of Custom and Patent Appeals*, 11 LAW & SOC'Y REV. 823, 842 (1977) (largely attributing this change in direction to the Court's composition after 1956). Indeed, it is similarly argued that many of these philosophies carried over to the Federal Circuit. *See* Rochelle C. Dreyfus, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 17 (1989) (describing several instances where the Federal Circuit's decisions relied largely upon its interpretation of the patent statute's underlying philosophies).

415. *See* discussion *supra* note 130 and accompanying text.

416. Graham v. John Deere Company of Kansas City, 383 U.S. 1, 17-18 (1966).

Moreover, it is questionable whether this alteration would have promoted the progress of industrial design.[417] Designers might actually be more inclined than the "average Joe" to appreciate the skill and ingenuity required to create a design. Indeed, each seemingly simple line, shape, or material represents a complex network of underlying non-aesthetic choices that designers must make.[418] For instance, before product designers can begin the process of creating a new design, they must start by examining certain non-aesthetic constraints, such as performance objectives, ergonomics, production costs, legal, and marketing constraints.[419] Because it is impossible to balance perfectly all of these factors when creating a design, the designer must make certain tradeoffs.[420] Usually, the biggest constraint and the dominant feature of a product's design are its performance related objectives.[421] According to Peter Bloch's model of consumer response to product forms, the best designs optimize these constraints in a manner that produces an intended positive psychological response (*i.e.*, both cognitive[422] and affective[423]), so that the consumer responds by approaching the good [424] and eventually purchasing it.[425] When taken collectively, this larger mode of consumer response to product design not only

417. *See, e.g.*, Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co., 444 F.2d 295, 299 (9th Cir. 1970).

418. *See generally* Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 892 (1988) ("The designer's art focuses not on the creation of new and nonobvious techniques of this type, but on the use of old ones in well-known ways to develop useful products.").

419. Bloch, *supra* note 409, at 18-19. Bloch also adds the designer's constraints to this list. *Id.* This constraint includes professional goals and desires for self expression. *Id.*

420. *Id.* at 19.

421. *See id.* at 18; Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 739 (1983) ("At its most fundamental level, this consideration simply excludes any form that significantly interferes with the utility of the article."). *But see* JIM LESKO, INDUSTRIAL DESIGN: MATERIALS AND MANUFACTURING GUIDE 5 (2d ed. 2008) (emphasizing the importance of manufacturability and material selection in the industrial design process and redefining the old Bauhaus credo, "form follows function," as "'[f]orm is the resolution of function,' where function has two major components: (1) performance specification demands, including all user-friendly aspects, and (2) cost and manufacturability").

422. According to Bloch's theory, these cognitive responses include product related beliefs and categorization. Bloch, *supra* note 409, at 19-20. Common product related beliefs include the item's "durability, dollar value, technical sophistication, ease of use, sex role appropriateness, and prestige." *Id.* at 19. On the other hand, "[c]ategorization is based on the perceived similarity between a given product and exemplars of various product categories and sub-categories." *Id.* at 20.

423. Affective responses simply include the spectrum of positive and negative reactions consumers have to the product's aesthetics. *Id.*

424. These behavioral responses can be described on an approach-avoidance continuum. *Id.* According to Bloch, "[a]pproach behaviors reflect an attraction to a design and include spending time in a site and exploring it. Avoidance behaviors represent the opposite of approach responses." *Id.*

425. *See* Magliocca, *supra* note 133, at 852. However, these responses are also shaped by the consumer's individual tastes and preferences, and by other situational factors. Bloch, *supra* note 409, at 21.

illustrates that designers' aesthetic choices are not as limitless as courts may think, but also how product design lies at the nexus of traditional trademark, copyright, and patent considerations. Although this problem may be indicative of the larger issue concerning design's place in our intellectual property system, the eyes of an ordinary observer would likely be blind to the "inventive" manner in which designers juggle these complex considerations.[426]

Additionally, review of the circuits that applied the invention requirement from the perspective of the ordinary observer does not support the contention that courts were any less likely to invalidate or affirm the denial of a design patent. Of the twelve cases that were uncovered before 1952 that expressly[427] applied invention from the perspective of the average or ordinary observer, only four held the design patent not invalid or reversed the Patent Office's rejection.[428] Furthermore, if appeals from the Patent Office are subtracted, five of six patents were declared invalid.[429] Although it is difficult to compare the two standards because courts before the 1952 Act often focused on the design's method of creation or its beauty, there is no evidence that the ordinary observer's viewpoint was any less severe under the invention requirement. It is entirely plausible that relying on design experts who have a greater appreciation for the ostensibly "subtle" differences in the prior art, and who truly get at the heart of § 103's framework, might lead to more consistent outcomes.[430]

---

426. In comparison to the application of invention prior to the 1952 Act, § 103's application represents a larger shift towards analyzing the end result—instead of the process by which subject matter is created—when determining whether it warrants the grant of a patent. In the context of design patents, this can be unfortunate for seemingly simple or streamlined designs that before 1952 might have, in part, relied on these justifications to meet the invention requirement. This movement is likely part of a much larger shift in intellectual property away from labor or natural rights justifications towards more economic based calculations (*i.e.*, a "privilege" theory of intellectual property). *See generally* Mosoff, *supra* note 260, at 963.

427. There were several other cases that seemed to apply the invention requirement from the ordinary or average observer's perspective; however, I have only included decisions that expressly acknowledged this application.

428. *See* Zidell v. Dexter, 262 F. 145, 146 (9th Cir. 1920) (not invalid); Goudy v. Hansen, 247 F. 782, 784 (1st Cir. 1917) (invalid); *In re* Jabour, 182 F.2d 214, 215 (C.C.P.A. 1950) (Board's rejection affirmed); *In re* Park, 181 F.2d 255, 256 (C.C.P.A. 1950) (Board overruled); *In re* Johnson, 175 F.2d 791, 792 (C.C.P.A. 1949) (Board's rejection affirmed); *In re* Lobl, 75 F.2d 219, 220 (C.C.P.A. 1935) (Board overruled); *In re* Whiting, 48 F.2d 912, 914 (C.C.P.A. 1931) (Board's rejection affirmed); Seiberling Latex Prod. Co. v. Coe, 60 F. Supp. 140, 142 (D.D.C. 1945) (Commissioner's rejection overruled); J.H. Balmer Co. v. Bay Ridge Specialty Co., 20 F. Supp. 714, 716-17 (D.N.J. 1937) (invalid); Six-Way Corp. v. McCurdy & Co., 11 F. Supp. 734, 739 (D.N.Y. 1935) (invalid); Crystal Percolator Co. v. Landers, Frary & Clark, 258 F. 28, 39-40 (D. Conn. 1919) (Counted in study as "invalid" because the court's discussion focused entirely on the design's lack of invention, however, the design patent was ultimately held invalid or not infringed); Phoenix Knitting Works v. Rich, 194 F. 708, 712 (C.C. Ohio 1911) (invalid).

429. *See supra* note 428.

430. *But see* Peterson Mfg. Co. v. Central Purchasing Inc., 740 F.2d 1541, 1547-48 (Fed. Cir.

Returning to *Laverne*, the court's holding also placed it at odds with the majority of other circuits that applied § 103 from the perspective of the designer having ordinary skill.[431] As a result, the Court of Customs and Patent Appeals eventually overruled itself in 1981.[432] In *Nalbandian*, Judge Rich's concurring opinion gave the ordinary observer an appropriately toned eulogy where he, like past commissioners, advocated removing design protection from the patent regime.[433] Nonetheless, recent Federal Circuit case law indicates that the court might be headed back down this road again.[434]

1984). In *Peterson Mfg.* the court stated:

> In civil litigation involving a design, an expert's testimony is most helpful, as in the determination of obviousness with respect to any other type of invention, to explain the technology, the scope and content of the prior art, the differences between the prior art and the invention, and the level of skill in the art[; however, t]he *Nalbandian* standard does not and could not prohibit a district court from making its own conclusion on the legal issue of obviousness.

Id. See generally William T. Fryer, III, *Industrial Design Protection in the United States of America – Present Situation and Plans for Revision*, 70 J. PAT & TRADEMARK OFF. SOC'Y 820, 828 (1988) ("The simplicity of the basic issue and a judge's willingness to make the decision and not rely on experts have made the determination more unpredictable.").

431. Wallace R. Burke, *Evolution of the Unobviousness Standard: 35 U.S.C. § 103 For Design Patents*, 19 U. BALT. L. REV. 324, 330 (1989).

432. *See In re* Nalbandian, 661 F.2d 1214, 1216 (C.C.P.A. 1981). However, the Supreme Court has never conclusively ruled on this issue.

433. Judge Rich stated:

> *Laverne* thus being dead, I deem it appropriate, as the father of the so-called "ordinary observer" test (as applied to 35 U.S.C. § 103) to say a few kind words over the corpse.
>
> ... I was interested in retaining within the ambit of the patent system the made-for-hire products of "competent designers" so businessmen or corporations would find it economically advantageous to employ them, thus carrying out the objective of 35 U.S.C. § 171, to promote the ornamental design of articles of manufacture.
>
> ... It is probably true, as the majority says, that all this is just semantics and courts will, with phraseology of their own choosing, continue to find designs patentable or unpatentable according to their judicial "hunches."
>
> The real problem, however, is not whether the § 103 fictitious "person" is an ordinary observer or an ordinary designer but with the necessity under Title 35 of finding unobviousness in a design. The problem long antedates 1952 and its Patent Act and existed from the beginning, the pre-1952 test being the presence of "invention" in a design.

Id. at 1218 (Rich, J., concurring).

434. *See* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009). The Federal Circuit recently stated:

> For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application

b. Combinations of Prior Art

Similar to the application of the invention requirement, courts routinely invalidated designs whose elements could be individually located in the prior art and regrouped to form the design.[435] This dichotomized analysis frequently caused courts to focus on the design's constituent elements, instead of its overall design or effect.[436] Additionally, it often resulted in rather transient distinctions between designs that were nothing more than the sum of their known parts, and designs whose elements united to produce a new cohesive design.[437] To avoid this piecemeal approach, by 1942 the Court of Customs and Patent Appeals suggested reframing invention's "real question" as, whether "the prior art references suggest doing what [the] appellant has done."[438] Despite this crucial insight, it was not until after the 1952 Act that it started treating this "suggestion" as a requirement.[439]

In *Glavas*, the court was faced with an appeal from the Patent Office concerning a § 103 rejection based on several pieces of prior art.[440] Although the applicant's design was for a swimmer's float,[441] the Patent Office cited a life preserver,[442] body pillow,[443] baby supporter pillow,[444] razor blade sharpener,[445] bar of soap,[446] and two bottles[447] as prior art references.[448] Such a broad array of design and utility patent references squarely forced the court to address the proper scope of prior art for the application of nonobviousness to design patents (*i.e.*, analogous art doctrine). Acknowledging the unique nature of designs, the court held, "The question in design

---

of the ordinary observer test, not the view of one skilled in the art.

Id.

435. *See, e.g.*, Smith v. Whitman Saddle Co., 105 U.S. 674, 681 (1893).

436. *See* discussion *supra* note 288.

437. *See, e.g.*, Phoenix Knitting Works v. Rich, 194 F. 708, 712-13 (1911).

438. *In re* Kalter, 125 F.2d 715, 718 (C.C.P.A. 1942); *see also* Westinghouse Elec. V. Triumph Elec. Co., 97 F. 99, 103 (6th Cir. 1899) (hinting at a similar insight the court stated, "The difference in the curve at the bottom is one which would suggest itself to any workman, and does not involve that exercise of the inventive genius which is as necessary to support a design patent as a mechanical patent.").

439. *In re* Glavas, 230 F.2d 447, 450 (C.C.P.A. 1956).

440. *Id.*

441. Float, U.S. Patent No. D177,670 (filed April 1, 1950) (issued May 15, 1956).

442. Life-Preserver, U.S. Patent No. 715,938 (filed Aug. 19, 1901) (issued Dec. 16, 1902).

443. Pillow, U.S. Patent No. 1,386,652 (filed Jan. 20, 1921) (issed Aug. 9, 1921).

444. Baby Supporter, U.S. Patent No. 2,404,505 (filed June 13, 1944) (issued July 23, 1946).

445. Razor Blade Sharpener, U.S. Patent No. D96,071 (filed Mar. 30, 1935) (issued June 25, 1935).

446. Bar of Soap, U.S. Patent No. D51,395 (filed Aug. 10, 1912) (issued Oct. 16, 1917).

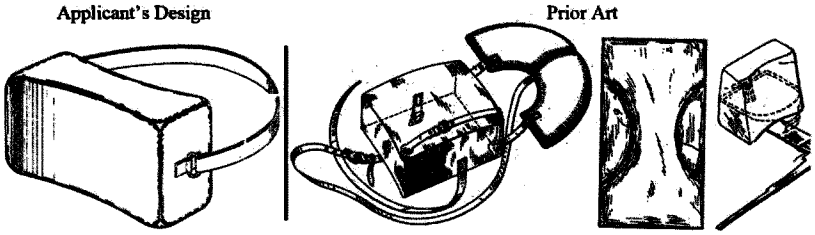
447. Glass Bottle, U.S. Patent No. D95,965 (filed Oct. 16, 1934) (issued June 18, 1935); Bottle, U.S. Patent No. D91,080 (filed Aug. 19, 1933) (issued Nov. 21, 1933).

448. *In re* Glavas, 230 F.2d 447, 448 (C.C.P.A. 1956).

cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would *suggest* the application of those features to the other."[449] However, if the combination of references required a "material[] modification of the basic form of one article in view of another," then the nature of the articles also became a factor.[450]

The court began its analysis with the references that were not "similar devices" (*i.e.*, the bottles, soap, and razor blade sharpener references).[451] Because the court reasoned that a "worker" would not likely turn to these devices when improving a swimmer's float, it noted that this reflected the remote nature of finding a suggestion to combine those features.[452] It then focused on the combinations suggested by the examiner and Board of Appeals.

The primary examiner had rejected the swimmer's float application (1) based on the life preserver reference (2), in view of the body pillow (3) and baby supporter pillow references (4).[453]



Although the court found the life preserver (2) and pillow references (3, 4) in a related art to the swimmer's float (1), it did not find a suggestion in the pillows to modify the life preserver reference in a manner that would produce the applicant's design.[454] The court then turned to the Board's rejection, which called for modifying the life

449. *Id.* at 450 (emphasis added).

450. *Id.*

451. *Id.*

452. *Id.* at 450-51.

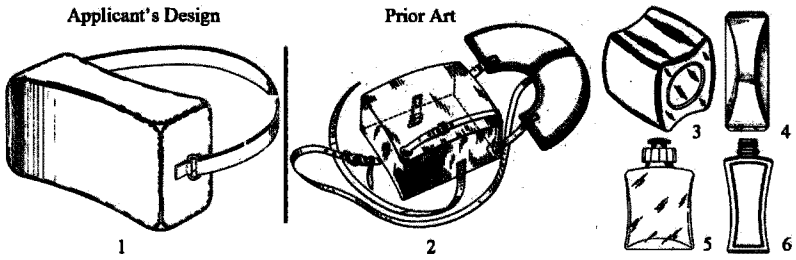
453. *Id.* at 449.

454. The court reasoned:

> The Patton patent shows a float pillow having opposite concavities in its narrow edge portions or, as the examiner described it, "concave portions on a knife edge margin." This would not suggest the broad concave upper and lower surfaces of appellant's float, which is clearly of an entirely different over-all appearance from Patton's pillow.
>
> While Knecht's pillow does have a broad concave surface, the opposite face of the pillow is necessarily flat so that it may rest firmly against a flat vertical wall. We see nothing therein which would suggest the opposite concave surfaces of appellant's float.

Id. at 451.

preserver (2) in view of the dissimilar devices (*i.e.*, the razor blade sharpener (3), soap (4), and two bottles (5, 6)).



Although the razor blade sharpener (3), soap (4), and bottles (5, 6) all taught the two concave sides that the pillows were missing, the court reiterated that the general appearance of these unrelated shapes did not suggest modifying the life preserver reference as the Board described.[455] The court appeared to place great weight on its assumption that a float designer would not look to these everyday items for a creative spark.[456] More importantly, the court chose which references were related based on their operation or purpose and not, as it declared, on their appearance.[457] While the suggestion requirement from *Glavas* seemed to guard against the mechanically reconstructive approach from *Whitman Saddle*, the court's brief analysis provided little insight for its application.[458] As a result of the missing suggestion in the prior art, it reversed the Patent Office's § 103 rejection.[459]

Less than six months after *Nalbandian* —where the Court of Customs and Patent Appeals overruled its application of § 103 through the eyes of the "ordinary intelligent person"[460]—the court began employing another tactic aimed at minimizing the severity and subjectivity of § 103 on designs.[461] In *Rosen*, the court presided over an appeal from the Patent Office concerning a § 103 rejection where the individual elements of the applicant's design could be found in four separate prior

455. *Id.*

456. The court's narrow application of these everyday items seems to run counter to the Supreme Court's approach to the application of the nonobviousness requirement to utility patents in *KSR*. KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 420 (2007) ("Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. ... A person of ordinary skill is also a person of ordinary creativity, not an automaton."). However, it should be noted that *Glavas* was decided only a few years after the 1952 Act was passed and ten years before the Supreme Court decided *Graham*. *See* Graham, 383 U.S. 1 (1966).

457. *In re* Glavas, 230 F.2d 447, 451 (C.C.P.A. 1956).

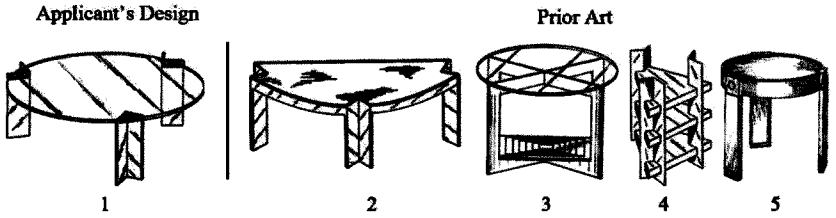
458. *See* discussion *infra* note 482.

459. *In re* Glavas, 230 F.2d at 451.

460. *In re* Nalbandian, 661 F.2d 1214, 1216 (C.C.P.A. 1981).

461. *See In re* Rosen, 673 F.2d 388, 390-91 (Fed. Cir. 1982).

art references.[462] Beginning with a basic desk reference (2),[463] the Board of Appeals rejected the coffee table design (1)[464] because it could be constructed by regrouping the round glass top (3),[465] V-shaped legs (4),[466] and equidistantly spaced legs (5)[467] from the prior art.[468]



Applying *Glavas*, the court stated that the references must be so related ornamentally that they suggest the application of one another's features.[469] However, it added a new element to *Glavas*'s test. The court required that one of the references, first, must be "basically the same as the claimed design."[470] Indeed, this single reference was "necessary whether the holding [was] based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references."[471] Beginning with a visual comparison of the applicant's design (1) and the primary reference (2), the court determined that the designs did not have the same visual characteristics.[472]

---

462. *Id.* at 390.

463. Desk, U.S. Patent No. D240,185 (filed Jan. 17, 1975) (June 8, 1976).

464. Table, U.S. Patent No. D268,555 (filed Feb. 7, 1978) (issued Apr. 12, 1983).

465. Table, U.S. Patent No. D239,487 (filed Dec. 17, 1973) (issued Apr. 13, 1976).

466. Display Stand Or The Like, U.S. Patent No. D183,617 (filed Mar. 21, 1957) (issued Sept. 30, 1958).

467. Table, U.S. Patent No. D234,068 (filed Jan. 22, 1973) (issued Jan. 14, 1975).

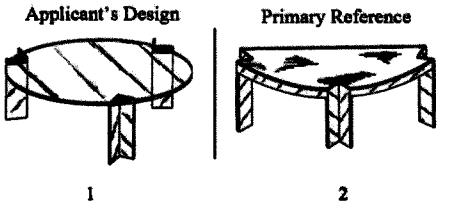
468. *See In re* Rosen, 673 F.2d 388, 390 (Fed. Cir. 1982).

469. *See, e.g.*, *id.* at 391.

470. *See id.* ("There must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness." (applying *In re Jennings*, 182 F.2d 207, 208 (C.C.P.A. 1950), which held: "In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence – not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature . . . .")).

471. *Rosen*, 673 F.2d at 391. *See generally* Julie H. Richardson et al., *U.S. Legal Standard For The Grant Of A Design Patent*, INTELLECTUAL PROP. TODAY, Aug. 1997, at 8.

472. *Rosen*, 673 F.2d at 391.



The applicant's design produced a visual impression of "lightness and suspension in space ... [, while the primary reference] embodie[d] a concept of confinement of space, resulting in a different overall appearance and aesthetic appeal."[473] As a result, the court reversed the Patent Office's rejection because there was no reference that was basically the same as the applicant's design.[474] Indeed, it never reached the issue of whether the modifications were suggested by the other references. Although *Glavas* and other decisions seemed to revolve around adding or subtracting from a (*i.e.*, primary) reference that was closer than others (*i.e.*, secondary references) to the applicant's design, the court never formally required a primary reference that was basically the same as the applicant's design.[475]

Unfortunately, there are still numerous issues with *Rosen's* application that need to be clarified, such as what it means for the primary reference to be "basically the same" as the applicant's design. The Federal Circuit has provided some sign posts for determining when the reference is not basically the same, such as: (1) where the reference needs a major modification to make it look like the claimed design;[476] and (2) where the court must revert to a design concept,[477] instead of the visual appearance as a whole[478] to find the references basically the same. However, it is still unclear whose viewpoint this is evaluated from. Based on *Nalbandian*[479] and the Statute's language,[480] it would be reasonable to assume that it is the person of ordinary skill. Yet, some cases suggest the proper viewpoint is the ordinary

473. *Id.*

474. *Id.* As a result of this case, primary references are commonly referred to as Rosen references. *See, e.g.*, *Ex parte* Plutsky, 41 U.S.P.Q.2d 1701 (B.P.A.I. 1996).

475. *See, e.g.*, *In re* Leslie, 547 F.2d 116, 120 (C.C.P.A. 1977); *In re* Boldt, 344 F.2d 990, 991 (C.C.P.A. 1965); *Jennings*, 182 F.2d at 208.

476. *See, e.g.*, Jore Corp. v. Kouvato, Inc., 117 F. App'x. 761, 763 (Fed. Cir. 2005) (citing *In re* Harvey, 12 F.3d 1061, 1063 (Fed. Cir. 1993)).

477. *See, e.g.*, Durling v. Spectrum Furniture Co., 101 F.3d 100, 104 (Fed. Cir. 1996) (citing *In re* Harvey, 12 F.3d 1061, 1064 (Fed. Cir. 1993)).

478. *See* Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372, 1383-84 (Fed. Cir. 2009) (cautioning courts from focusing on searching for a specific element, or point of novelty, in the primary reference); *In re* Borden, 90 F.3d 1570, 1574 (Fed. Cir. 1996). *But see* L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1124 (Fed. Cir. 1993) (stating "not only the individual elements, but the ornamental quality of the combination must be suggested in the prior art.").

479. *In re* Nalbandian, 661 F.2d 1214, 1216 (C.C.P.A. 1981).

480. 35 U.S.C. § 103.

observer.[481] There are, likewise, a host of questions related to the test's secondary references.[482] Although *Rosen* has never been overruled, rigid adherence to its test parallels other mandatory obviousness formulas that have.[483]

V. CONCLUSION

Since the codification of the nonobviousness requirement in 1952, the Patent Office and courts have struggled with its application to designs. Despite numerous attempts to align its application and legislative intent, courts have merely run out of ways to evade § 103's plain language. As the *sine qua non* of the patent regime, any reformation to design patent law should start with the nonobviousness requirement. Policy makers need only examine its history to understand why courts and the Patent Office struggle to apply this requirement to designs. The fundamental problem is that nonobviousness, along with its "inventive" predecessor, was never intended to apply to design patents in the first place. Rather, the framework for its application was laid by Patent Office Commissioners who expanded the scope and subject matter afforded to design patents until they created a muddled overlap between design and utility patents. Then, only through a peculiar series of administrative, legislative, and judicial mishaps did we arrive at the modern conclusion that design patents must meet the nonobviousness requirement. As a result, the U.S. has a system where the Patent Office and courts continually rely on the Statute's legislative intent to try and make up for the harsh effects of its application to designs. Until the nonobviousness requirement and its utility patent precedent are decoupled from design patent law, it will continue to afford too little or too much protection, and in doing so, will hold applicants and industries hostage to its erratic protection.

---

481. *See, e.g.*, Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009) (quoted *supra* note 434); Durling, 101 F.3d at 103 (stating the comparison can be done by a trial judge "instinctively").

482. Similar to the application of the analogous art requirement to utility patents, the court has restricted the references to "articles sufficiently similar that a person of ordinary skill would look to such articles for their designs." Hupp v. Siroflex of America, Inc., 122 F.3d 1456, 1462 (Fed. Cir. 1997). While it seems apparent the existence of a "suggestion" should be evaluated from the perspective of the ordinary designer, it is unclear just how close these references must be to the applicant's design.

483. Assuming they are strictly applied, the primary reference requirement and the requirement that the references be so similar ornamentally that they suggest the application of reciprocal features, would both likely be overruled as mandatory requirements under *KSR*. *See* KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 419 (2007) (overruling the rigid application of the TSM test, as applied to obviousness challenges with more than one reference). However, they still may be instructive under a *Graham* analysis. *See id.*