The Origins of American Design Patent Protection

JASON J. DU MONT

MARK D. JANIS*

Many firms invest heavily in the way their products look, and they rely on a handful of intellectual property regimes to stop rivals from producing look-alikes. Two of these regimes—copyright and trademark—have been closely scrutinized in intellectual property scholarship. A third, the design patent, remains little understood except among specialists. In particular, there has been virtually no analysis of the design patent system's core assumption: that the rules governing patents for inventions should be incorporated en masse for designs.

One reason why the design patent system has remained largely unexplored in the literature is that scholars have never explained how and why the system came to exist. This Article seeks to provide that account. We show how technological innovation in early American manufacturing (especially in the cast-iron goods industry) created unprecedented opportunities for creativity in industrial design and a concomitant expansion in design piracy. We analyze manufacturers' lobbying efforts that led to the first American legislative proposals for design protection, and we connect those proposals to antecedents in British copyright and design registration legislation. We also explain how these early proposals were transmuted into design patent proposals, and we explore the idiosyncratic political circumstances that surrounded the eventual passage of the design patent bill. We conclude by reassessing the modern design patent regime in view of insights drawn from our historical account.

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INTRODUCTION

In the space of a few weeks in late 2011, automaker Daimler AG sued an Asian manufacturer for infringing patents on the diminutive "Smart Car";[1] Crocs, maker of the eponymous (and wildly popular) rubber-molded footwear, filed a patent infringement suit against Walgreens;[2] Kohler sued a rival for infringing patents on stainless steel sinks;[3] and Apple and Samsung continued their worldwide battle over smart phones and tablet computers.[4] High-stakes, high-tech patent lawsuits such as these have become the norm on civil dockets of many federal courts across the country. What differentiates these suits is that they involve patents on designs—that is, patents on a product's visual appearance, not merely on the inventive components that make it work.[5] There are many other recent examples, and

1. Complaint for Trademark and Trade Dress Infringement, Trademark Counterfeiting, Patent Infringement, Unfair Competition and Trademark Dilution, Daimler AG v. Shuanghuan Auto. Co., No. 2:11-cv-13588-MOB-MAR (E.D. Mich. Aug. 17, 2011).

2. Complaint for Patent Infringement, Crocs, Inc. v. Walgreen, Co., No. 1:11-cv-02954-MSK (D. Colo. Nov. 14, 2011).

3. Complaint, Kohler Co. v. Amerisink, Inc., No. 2:11-cv-00921-WEC (E.D. Wis. Oct. 3, 2011).

4. *See, e.g.*, Apple, Inc. v. Samsung Elec. Co., 678 F.3d 1314 (Fed. Cir. 2012).

5. *See, e.g.*, 1 MANUAL OF PATENT EXAMINING PROCEDURE 1502 (8th ed. rev. 2010) (specifying that, in the context of design patents, design refers to "the visual characteristics

application-filing trends suggest that intellectual property litigation over designs will become increasingly common worldwide.[6]

Design patent cases routinely deal with the products of technological innovation, but they also bring into confluence matters of consumer preference, aesthetics, and even art. For example, litigation between Apple and Samsung over the design of the iPad is as much about Steve Jobs's and Jonathan Ive's obsession with minute aspects of visual aesthetics as it is about touch-screen technology;[7] and it involves a claim that devices depicted in Stanley Kubrick's 1968 science fiction movie *2001: A Space Odyssey* so resemble the iPad that Apple's design protection should be declared invalid.[8]

Herein lies the problem. Intellectual property law has a fetish with categorization; design, by contrast, is holistic, amorphous, and multivariate.[9] It is little wonder that fitting intellectual property law to design has proven so difficult. After nearly two centuries of effort, there remain fundamental questions about how best to craft legislative schemes that will facilitate innovation in industrial design. The topic perennially appears on the U.S. legislative agenda, most recently in the form of proposals to create special protection for fashion designs.[10] A wider-ranging reexamination of design protection is underway in the United Kingdom.[11] The design protection debate is one of intellectual property law's most intractable,[12]

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embodied in or applied to an article").

6. *See* WORLD INTELLECTUAL PROP. ORG., WORLD INTELLECTUAL PROPERTY INDICATORS 153–80 (2011) (reporting statistics on industrial design protection).

7. *See, e.g.*, Nick Bilton, *Steve Jobs: Designer First, C.E.O. Second*, N.Y. TIMES (Oct. 6, 2011, 1:37 PM), http://bits.blogs.nytimes.com/2011/10/06/steve-jobs-designer-first-c-e-o-second/.

8. Eriq Gardner, *Is Apple's iPad Copied From '2001: A Space Odyssey'?*, HOLLYWOOD REP. (Aug. 25, 2011), http://www.hollywoodreporter.com/thr-esq/is-apples-ipad-copied-2001-227700 (providing a video clip from the movie scene at issue).

9. DISCOVERING DESIGN: EXPLORATIONS IN DESIGN STUDIES xiii, xvi (Richard Buchanan & Victor Margolin eds., 1995) (characterizing design as "the science of the artificial" and as "a new liberal art of industrial and technological culture"); ARTHUR J. PULOS, AMERICAN DESIGN ETHIC: A HISTORY OF INDUSTRIAL DESIGN TO 1940, at vii (1983) (referring to design as "the indispensable leavening of the American way of life"); *see also* Alice Rawsthorn, *What Defies Defining, but Exists Everywhere?; A Hint: It's Two Parts Creation and One Part 'Dastardly Plan*,*'* INT'L HERALD TRIB., Aug. 18, 2008, at 8 (quoting a design historian for the proposition that "[d]esign is to produce a design to design a design.").

10. Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011); BRIAN T. YEH, COPYRIGHT PROTECTION FOR FASHION DESIGN: A LEGAL ANALYSIS OF LEGISLATIVE PROPOSALS IN THE 111TH CONGRESS (2010) (discussing, inter alia, S. 3728, a fashion design protection bill that passed the Senate Judiciary Committee in 2010). On earlier efforts, see David Goldenberg, *The Long and Winding Road: A History of the Fight Over Industrial Design Protection in the United States*, 45 J. COPYRIGHT SOC'Y U.S.A. 21 (1997) (addressing proposals to enact new forms of design protection legislation in the twentieth century).

11. INTELLECTUAL PROP. OFFICE, IPO ASSESSMENT OF THE NEED FOR REFORM OF THE DESIGN INTELLECTUAL PROPERTY FRAMEWORK (2011).

12. *See, e.g.*, J.H. Reichman, *Past and Current Trends in the Evolution of Design Protection Law—A Comment*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 387, 387 (1993) ("[I]ndustrial design has posed the intellectual property world's single most complicated

engrossing decades of legislative effort in the United States alone.[13] This debate has become particularly heated and uncharacteristically mainstream following the massive verdict against Samsung,[14] the size of which may have been largely driven by the presence of the design patents.

In the United States, we have never settled on a satisfactory answer to a basic normative question: why should we use a *patent* system to protect industrial designs? One reason that this question has proven so confounding and persistent is that the antecedent historical question has not been adequately addressed: how (and why) did the United States decide to create a patent system for designs? In this Article, we answer this historical question. In doing so, we seek to provide a foundation for resolving the normative question.

Our historical analysis of the intersection between intellectual property law and design complements recent scholarly debates about design protection, but we have different objectives and a different orientation. First, we do not confine our discussion to the fashion industry, the focal point of recent scholarship.[15] We are more interested in examining how intellectual property regimes affect the industrial design enterprise in the vast majority of industries—literally everything, including the kitchen sink. Second, we orient our discussion around the design patent regime; our chief objective is to understand how that regime should operate as one paradigm among many others in contemporary design intellectual property. Scholars have written very little about the design patent system.[16]

In Part I, we describe the existing U.S. design patent system and situate it within the legal landscape of intellectual property protection for designs. We focus on two chief points: (1) the design patent system's traditionally plebeian status among U.S. intellectual property regimes, contributing to a persistent problem that we describe as design patent's identity crisis; and (2) the thesis that the design patent system originated as a historical accident.

In the remaining Parts, we offer a historical analysis of the design patent system's origins, aimed at discerning the role and identity of the design patent system and at critically evaluating the claim that design patent is an accidental intellectual property regime. Part II shows how technological advances in

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puzzle.").

13. *E.g.*, *In re* Nalbandian, 661 F.2d 1214, 1218 n.1 (C.C.P.A. 1981) (Rich, J., concurring) ("Fabulous amounts of time and effort have been poured into solving the design protection problem with, to date, no legislative solution.").

14. *See, e.g.*, Leo Kelion, *Apple Versus Samsung: Jury Foreman Justifies $1bn Verdict*, BBC NEWS (Aug. 30, 2012), http://www.bbc.co.uk/news/technology-19425052.

15. *See, e.g.*, C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147 (2009) (advocating a limited anti-copying right for fashion design); *cf.* Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1776 (2006) (arguing that "fashion's cyclical nature is furthered and accelerated by a regime of open appropriation" rather than a regime featuring stronger intellectual property protection).

16. Notable exceptions include Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* (Univ. of Mo. Sch. of Law Legal Studies Research Paper No. 2010-17, 2010), *available at* http://ssrn.com/abstract=1656590; Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531 (2010); Janice M. Mueller & Daniel Harris Brean, *Overcoming the "Impossible Issue" of Nonobviousness in Design Patents*, 99 KY. L.J. 419 (2010–2011).

antebellum American manufacturing created opportunities for manufacturers to incorporate design elements into mass-produced consumer goods and simultaneously triggered a design piracy problem. Part III chronicles the origin and evolution of legislative proposals that eventually matured into the design patent provisions, the first form of American intellectual property protection covering designs. We rely here on newly uncovered archival sources that reveal insights about the lobbying influence of prominent manufacturers, the political agendas of key intellectual property insiders, and connections with a legislative fight that degenerated into one of the most serious political crises in antebellum America, the fight over protectionist tariffs. We conclude in Part IV with some prescriptions for doctrinal change in modern design patent law, informed by our historical analysis.

I. MODERN PERCEPTIONS OF THE AMERICAN DESIGN PATENT SYSTEM

The design patent system has led a long but quiet life. Many observers have regarded it with ambivalence or written it off as an intellectual property lightweight. From the limited commentary about the design patent system, two themes emerge. First, some view the design patent system as having never developed a distinctive identity, a *raison d'être*. Second, some dismiss the design patent system as the product of historical accident. We discuss both views below, arguing that these are two primary obstacles to the development of a more fully theorized design patent system.

A. Design Patent's Identity Crisis

The design patent system is, first, a *patent* system. The U.S. design patent system is based primarily on three brief provisions that comprise Chapter 16 of the general (utility) patent statute.[17] These provisions impose the condition that designs be "ornamental" in order to warrant protection,[18] and they establish a fourteen-year term of protection (measured from the date of grant),[19] rules that are unique to design patents. In most other respects, however, the modern design patent system relies on substantive rules that were developed for patents on inventions—utility patent rules. Indeed, perhaps the most important design patent provision is Section 171's seemingly mundane incorporation clause, incorporating by reference "[t]he provisions of this title relating to patents for inventions . . . ."[20] That language, applied over the course of more than a century and a half of utility patent law evolution, has the effect of subjecting design patents to modern patent validity conditions such as the requirement for nonobviousness[21] and to the modern judicial

17. 35 U.S.C. §§ 171–73 (2006). A special remedies provision for design patent infringement is codified separately. *See* 35 U.S.C. § 289 (2006).

18. 35 U.S.C. § 171.

19. 35 U.S.C. § 173; *see also* Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, § 102, 126 Stat. 1527, 1532 (providing for a fifteen-year term).

20. 35 U.S.C. § 171; *see* Du Mont, *supra* note 16, at 578–82 (tracing the development and expansion of the incorporation clause from its inception in the 1842 Act to its modern incarnation).

21. 35 U.S.C. § 103 (2006).

framework for deciding questions of utility patent infringement.[22] It also guarantees that the complex provisions of the America Invents Act of 2011 apply to design patents, even though the policy basis for that legislation emanated entirely from debates over utility patent protection.[23]

Beyond its incorporation of substantive patent law rules, the design patent system is also very much a patent system from an institutional perspective. Like their utility patent counterparts, design patent applications are subject to substantive, pre-grant examination administered by the U.S. Patent and Trademark Office.[24] Design patent infringement matters are subject to the appellate jurisdiction of the Court of Appeals for the Federal Circuit—again, like utility patents.[25]

Yet, it would be a mistake to assume that the design patent right resembles the utility patent right in terms of sheer economic power. Even accounting for the recent design patent renaissance,[26] design patents as a group have never achieved

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22. That framework requires a construction of the patent's claims, deemed to be a pure question of law, followed by a rigorous comparison of each element of the construed claim to the product accused of infringement. *See, e.g.*, Absolute Software, Inc. v. Stealth Signal, Inc., 659 F.3d 1121, 1129 (Fed. Cir. 2011).

23. *See* Robert A. Armitage, *Understanding the America Invents Act and Its Implications for Patenting*, 40 AIPLA Q.J. 1 (2012) (cataloguing the provisions of the America Invents Act without mentioning their impact on design patents).

24. *See* MANUAL OF PATENT EXAMINING PROCEDURE, *supra* note 5, at ch. 1500.

25. 28 U.S.C. § 1295(a)(1) (2006) (appeals from district courts in cases arising under the patent laws); *id.* § 1295(a)(4)(A) (appeals from the U.S. Patent and Trademark Office with respect to rejected patent applications).

26. When the Federal Circuit reformulated the law of design patent infringement in *Egyptian Goddess, Inc. v. Swisa*, *Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc), predictions of a renaissance in design patent enforcement quickly followed. *See, e.g.*, James Juo, Egyptian Goddess*: Rebooting Design Patents and Resurrecting* Whitman Saddle, 18 FED. CIR. B.J. 429, 450 (2009) (predicting that the *Egyptian Goddess* decision "should strengthen design patents, especially those that have been drafted with careful attention to the novel features to be protected"); Myshala E. Middleton, Egyptian Goddess, Inc. v. Swisa, Inc.*: Design Patent Infringement Revolutionized by an Egyptian Goddess*, 17 U. BALT. INTELL. PROP. L.J. 179, 185 (2009) (*Egyptian Goddess* will serve to "streamline future design patent infringement cases."). In the time since *Egyptian Goddess*, the Federal Circuit has handed down important new design patent decisions at an unusual pace. *See, e.g.*, Richardson v. Stanley Works, Inc., 597 F.3d 1288 (Fed. Cir. 2010) (analyzing design patent functionality by assessing the functionality of individual design features rather than the design as a whole); Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294 (Fed. Cir. 2010) (applying the *Egyptian Goddess* infringement standard and remarking on claim construction); Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233 (Fed. Cir. 2009) (abandoning the point of novelty test as an element of the patentability analysis); Titan Tire Corp. v. Case New Holland, Inc., 566 F.3d 1372, 1384–85 (Fed. Cir. 2009) (debating, but not resolving, whether the standard for design patent obviousness should be modified in view of Supreme Court developments in the law of obviousness for utility patents). Filings for U.S. design patents have increased substantially, and this phenomenon is not confined to the United States. *See, e.g.*, WORLD INTELLECTUAL PROP. ORG., 2012 WORLD INTELLECTUAL PROPERTY INDICATORS 9 (2012), *available at* http://www.wipo.int/freepublications/en/intproperty/941/wipo_pub_941_2012.pdf (noting that design applications grew strongly in 2010–2011).

anything like the exclusionary power commonly attributed today to utility patents. In the late 1980s, courts had arguably narrowed design patents so substantially that Judge Rich remarked acerbically that "[d]esign patents have almost no scope."[27] Indeed, Jerry Reichman has argued that during the course of the twentieth century, design patents had become trivial, functioning as little more than evidence of title and of priority for filing foreign design applications.[28] Courts are likely to treat design patents more generously today—but, in a sense, this only adds to the ambivalence over the design patent's stature. Is it, and should it be, a *real* patent? Notwithstanding the incorporation of the utility patent rules and institutional framework, is the design patent a mysterious intellectual property right that simply wears the patent moniker? A fuller historical analysis of the origin of the design patent system could provide a foundation for answering these questions.

The emergence of copyright and trademark protection for designs has only further complicated the problem of carving out a role for the design patent. As we will discuss, when design patent protection was introduced in 1842, it was the sole form of American intellectual property protection for designs.[29] That is no longer true. Under current U.S. law, designers may seek protection for many types of designs under the copyright[30] and trademark[31] regimes and may hold those forms of protection concurrently with design patent protection.[32] In addition, vessel hull designers may secure a special form of design protection administered within the copyright system.[33]

As these forms of intellectual property protection developed, the domain of design patents became increasingly more difficult to discern. Commentators argued that the design patent system should give way in favor of one or more of these other regimes: that it should be abolished in favor of *sui generis* legislation,[34] that it

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27. *In re* Mann, 861 F.2d 1581, 1582 (Fed. Cir. 1988).

28. J.H. Reichman, *Design Protection After the Copyright Act of 1976: A Comparative View of the Emerging Interim Models*, 31 J. COPYRIGHT SOC'Y U.S.A. 267, 298 (1983).

29. *See infra* Part III.B–C.

30. Designers may be able to secure copyright protection for designs as pictorial, graphic, or sculptural works. 17 U.S.C. § 102(a)(5) (2006) (identifying pictorial, graphic, and sculptural works as a category of protectable work); 17 U.S.C. § 101 (2006) (supplying relevant definitions).

31. Designers may seek to register distinctive and nonfunctional designs as trade dress under the Lanham Act, 15 U.S.C. §§ 1051–1096 (2006), or may claim unregistered trade dress rights using Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2006).

32. *See In re* Yardley, 493 F.2d 1389, 1394 (C.C.P.A. 1974) (no requirement to elect between design patent protection and copyright protection); *In re* Mogen David Wine Corp., 372 F.2d 539, 545 (C.C.P.A. 1967) (no requirement to elect between design patent protection and registered trade dress protection); *In re* Mogen David Wine Corp., 328 F.2d 925, 930 (C.C.P.A. 1964) (same). *But cf.* Vessel Hull Design Protection Act, 17 U.S.C. § 1329 (2006) (providing that the issuance of a design patent terminates vessel hull design protection).

33. Vessel hull designs may be protected under the provisions of Chapter 13 in 17 U.S.C. GRAEME B. DINWOODIE & MARK D. JANIS, TRADE DRESS AND DESIGN LAW 566–72 (2010) (explaining the relevant provisions).

34. Daniel H. Brean, *Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 TEX.

should be converted to a copyright model,[35] and that it should be governed by unfair competition principles.[36]

This has not occurred; instead, the design patent system has lingered. In the copyright and trademark jurisprudence, the design patent system has become a handy foil. For example, in *Wal-Mart v. Samara Bros.*,[37] the Supreme Court cited the theoretical availability of design patent protection as one rationale for adopting an elevated standard of distinctiveness for product design trade dress protection.[38] Similarly, some judges hold up design patent protection as a preferred alternative to trade dress protection when invalidating trade dress protection on functionality grounds.[39] Earlier, in *Mazer v. Stein*,[40] the Court declared that the existence of design patent protection posed no obstacle to recognizing copyright protection for designs of useful articles because design patent protection was so uncertain.[41]

INTELL. PROP. L.J. 325, 379–81 (2008) (arguing that the design patent system should either be abolished or should be phased out and replaced with a system more akin to community design protection); Note, *Design Protection—Time to Replace the Design Patent*, 51 MINN. L. REV. 942, 959–61 (1967).

35. *See, e.g.*, Roy V. Jackson, *A New Approach to Protection for the Designs of New Products*, 38 J. PAT. OFF. SOC'Y 448, 449 (1956) (arguing that design patent protection should be converted to a system of "engineering copyright" or "copyright-design"); Henry D. Williams, *Copyright Registration of Industrial Designs*, 7 J. PAT. OFF. SOC'Y 540, 540 (1924) (arguing that the design patent laws are a "misfit" and have been "altogether insufficient"). *But cf.* Frank W. Dahn, *Designs—Patents or Copyrights*, 10 J. PAT. OFF. SOC'Y 297, 297 (1927) (discussing industrial design protection under the copyright and design patent systems, noting that "it is immaterial in a broad sense whether this be done by a copyright system or a patent system, so long as it is well done").

36. Rudolf Callmann, *Style and Design Piracy*, 22 J. PAT. OFF. SOC'Y 557 (1940) (arguing that courts need to apply common law unfair competition law in design cases); *see also* Cameron K. Wehringer, *Two for One: Trademarks and Design Patents*, 50 TRADEMARK REP. 1158 (1960) (discussing the overlap between trademarks and design protection).

37. 529 U.S. 205 (2000).

38. *Id.* at 215–16 (holding that product design trade dress cannot qualify as inherently distinctive as a matter of law). Similarly, Judge Easterbrook upheld the denial of a trade dress claim on the grounds that the table leg design at issue was not distinctive, commenting that the table manufacturer could have resorted to design patent or copyright protection to attempt to thwart copying. Bretford Mfg., Inc. v. Smith Sys. Mfg. Corp., 419 F.3d 576, 580 (7th Cir. 2005); *see also* Amy B. Cohen, *Following the Direction of TrafFix: Trade Dress Law and Functionality Revisited*, 50 IDEA: INTELL. PROP. L. REV. 593, 696 (2010) (arguing that design patent and copyright alone suffice to provide adequate protection for designs, and that design protection as trade dress under the Lanham Act should be eliminated). Additionally, aesthetic and utilitarian functionality doctrines can create insurmountable hurdles for those claiming trade dress protection. *See* Industria Arredamenti Fratelli Saporiti v. Charles Craig, Ltd., 725 F.2d 18, 19–20 (2d Cir. 1984).

39. *See, e.g.*, Jay Franco & Sons, Inc. v. Franek, 615 F.3d 855, 861 (7th Cir. 2010) ("Franek chose to pursue a trademark, not a design patent, to protect the stylish circularity of his beach towel. He must live with that choice." (citation omitted)); *see also* Jason J. Du Mont & Mark D. Janis, *Functionality in Design Protection Systems*, 19 J. INTELL. PROP. L. 261, 281–82 (2012) (comparing the use of the functionality doctrine in design patent law to its use in trade dress law).

40. 347 U.S. 201 (1954).

41. *Id.*; *see also* BARBARA RINGER, DRAFT: SECOND SUPPLEMENTARY REPORT OF THE

Decisions and commentary that attempt to capture the design patent system's purpose by articulating its incentives rationale likewise leave us with many questions about the nexus between the design and utility patent systems. The most venerable comments—those of the Supreme Court in 1870 in *Gorham Co. v. White*[42]—assert merely that the design patent provisions "were plainly intended to give encouragement to the decorative arts,"[43] a reference to the Constitution's intellectual property clause,[44] with a slight adaptation for designs.[45] This strikes us as a placeholder recitation that reveals very little about whether the design patent system was intended to be robustly patent-like, since analogous constitutional language would be used to justify a design copyright scheme. Yet more recent rulings merely absorb the *Gorham* incantation without question. Indeed, in its recent landmark ruling on design patent infringement, the en banc Court of Appeals for the Federal Circuit declared that the *Gorham* decision was "[t]he starting point for any discussion of the law of design patents."[46]

More recently, some scholars have shifted the focus to trademarks, exploring the connections between design patent protection and trademark incentive rationales. For example, Dennis Crouch has argued that design patents should be understood as an "alternative rule of evidence" for establishing trade dress rights.[47] Similarly, Barton Beebe has suggested that the primary purpose of design patents is to incentivize product differentiation—to encourage producers to create and maintain distinctiveness, which is reminiscent of the trademark system's function.[48] In the case of high-technology consumer goods, as Beebe points out, consumers cannot readily evaluate whether the components of the goods provide superior technological utility, so consumers rely instead on the visual characteristics of the products as symbols of the product's relative utility.[49] The *Gorham* Court hints at a

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REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 186 (1975) (indicating that design patents were believed to be "inadequate as a practical form of protection" at the time of *Mazer* due to perceived judicial hostility, high cost, and delay encountered in the examination process).

42. 81 U.S. (14 Wall.) 511, 524 (1871).

43. *Id.*

44. U.S. CONST. art. I, § 8, cl. 8 (authorizing Congress to create systems that would "promote the Progress of Science and useful Arts").

45. *Gorham*, 81 U.S. at 525 (further suggesting that "[t]he 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"). The Court did cite a prior British design copyright case in support of its design patent infringement standard. *Id.* at 526 (citing McCrea v. Holdsworth, [1866] 1 Q.B. 263 (Eng.)). We discuss the significance of British antecedents to American design patent law *infra* Part III.

46. Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc).

47. Crouch, *supra* note 16, at 48.

48. Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 862–64 (2010). Beebe sees much in common doctrinally between design patent and trademark. *Id.* at 863.

49. *Id.* at 864 (asserting that "[d]esign patents enable the designers of [high-technology consumer] products to convert the absolute utility that they have created into clearly demonstrable (and protectable) forms of relative utility, which may be the primary form of utility that high-technology consumers ultimately desire").

product differentiation rationale, asserting that the law presumes that the designer's act of "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."[50] Beebe goes further, asserting that design protection laws, including design patent laws, "are probably the clearest examples we have of the 'functional transformation' of intellectual property law into a body of law being used not simply to 'promote the Progress,' but also, and in tension with that goal, to preserve our system of consumption-based differentiation in the face of copying technology that threatens to undermine it."[51] For Beebe, this illustrates a broader distinction between "progressive" intellectual property (denoting intellectual property systems that seek to promote "progress" in the sense of advances in absolute utility) and sumptuary intellectual property (which merely strive to preserve differentiation among products).[52]

We have some sympathy for Beebe's argument, but for us it warrants closer historical scrutiny. Did the proponents of the original design patent system presume that industrial designers would supply "not so much beauty as distinction?"[53] Or is it more likely that designers historically have sought to supply both beauty and distinction, a combination that is very difficult to disaggregate? [54] And, if so, what does this tell us about shaping incentives through a design patent system?[55] Historical analysis has something to contribute here, even if it does not yield tidy answers.

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50. *Gorham*, 81 U.S. at 525. Further strands of this rationale can be seen in the Court's description of the substantial similarity test for infringement—finding infringement where, "in the eye of an ordinary observer, giving such attention as a purchaser usually gives, . . . the resemblance is such as to deceive such an observer, inducing him to purchase one [(i.e., the allegedly infringing design)] supposing it to be the other [(i.e., the patented design)]." *Id.* at 528.

51. Beebe, *supra* note 48, at 862.

52. *Id.* at 840.

53. *Id.* at 865.

54. In addition, as Beebe sees it, progressive intellectual property is oriented towards preventing substitutive copying, while sumptuary intellectual property seeks to prevent dilutive copying. *Id.* at 866–67. That may be true for high-end fashion designs, where, as Beebe points out, it seems unlikely that purveyors of luxury fashion items actually lose sales because ordinary consumers choose cheap counterfeits instead. *Id.* at 867. But we are not confident that this same generalization would have extended across many types of consumer goods manufacturers historically, where mimicry could plausibly have been both substitutive and dilutive.

55. For an argument that design patent rights and trademark rights supply comparable incentives, see Crouch, *supra* note 16, at 44 (asserting that design patent scope is so narrow that it could only provide low-level investment in design innovation and that consumer demand alone might extract this level of innovation). But these observations could point towards copyright incentives just as readily as they could point towards trademark incentives.

B. The "Historical Accident" Thesis

Lastly, on the rare occasions when courts and commentators have focused directly on the design patent system's genesis, they have tended to accept the proposition that the design patent system came about without deliberation. The eminent commentator Stephen Ladas dismissively characterized the passage of American design patent legislation as a "historical accident,"[56] and others seem to have accepted this view.[57] One historical commentary—and, until recently, the only account directed to the history of the design patent system—goes only a bit deeper. Thomas B. Hudson's *A Brief History of the Development of Design Patent Protection in the United States*[58] posits that the original design patent legislation passed because the Commissioner of Patents, Henry Ellsworth, recommended it in an annual Commissioner's Report to Congress presented in early 1842,[59] and, a few months later, Congress dutifully adopted Ellsworth's recommendation.[60] Hudson no doubt drew upon design patent treatises tracing back to the nineteenth century, which, likewise, presented the creation of the design patent system as an Ellsworth-inspired *fait accompli*, or simply cited the 1842 Act without any background.[61]

These summary explanations intrigued us. We sensed that there was more to be told[62] and that telling it would be important in light of the ultimate normative

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56. STEPHEN P. LADAS, II PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 830 (1975).

57. *See, e.g.*, Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1142 (2008); Richard W. Pogue, *Borderland—Where Copyright and Design Patent Meet*, 52 MICH. L. REV. 33, 62 (1953); Kenneth B. Umbreit, *A Consideration of Copyright*, 87 U. PA. L. REV. 932, 934 (1939) (asserting that "[t]he fact that the law of design patents is following the precedents of mechanical patents rather than of copyrights is an accident of administration" and urging that "[i]t is due to their name and to their subjection to the jurisdiction of the Patent Office").

58. 30 J. PAT. OFF. SOC'Y 380 (1948). In fairness to Hudson, his account aimed primarily at describing the evolution of the design patent system in the late nineteenth and early twentieth centuries, not at the factors that originally motivated Congress to enact design patent legislation.

59. *See infra* notes 182–93 and accompanying text. As we discuss, Ellsworth's report referred to the existence of design protection in "other nations," undoubtedly meaning the 1839 British copyright and design legislation. *See infra* note 185 and accompanying text.

60. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 (1842) [hereinafter Act of Aug. 29, 1842]; Hudson, *supra* note 58, at 381. Hudson does augment this account by briefly speculating why design patent protection took the form of patent protection, but he cites no support. *Id.* at 381–83. We analyze Hudson's conjectures *infra* Part III.B, questioning some but agreeing with others.

61. *See, e.g.*, HECTOR T. FENTON, THE LAW OF PATENTS FOR DESIGNS 1–2 (1889) (referencing the 1842 Act as the first design patent act without additional background); WILLIAM EDGAR SIMONDS, THE LAW OF DESIGN PATENTS 173 (1874) (same); WILLIAM LEONARD SYMONS, THE LAW OF PATENTS FOR DESIGNS 5 (1914) (same).

62. Here we found particularly important the work by Brad Sherman and Lionel Bently, showing that, in British law, early design legislation served as a prominent but little-appreciated prototype for the eventual crystallization of modern notions of property rights in intangibles and modern structures of intellectual property laws. BRAD SHERMAN & LIONEL BENTLY, THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW: THE BRITISH EXPERIENCE,

problem of defining a role for the design patent system in future debates about intellectual property protection for designs. We attempt to provide more lucid and more fully contextualized explanations in the analysis presented in the following Parts.

II. TECHNOLOGICAL INNOVATION, DESIGN PIRACY, AND THE ROOTS OF AMERICAN DESIGN PROTECTION

As we will show in this Part, the design patent regime emerged in response to the imperatives of technological innovation. We focus on the technological change in a leading antebellum American industry, the manufacture of cast-iron goods. We explain how technological innovation made it feasible for manufacturers to incorporate design features into mass-produced consumer goods, ushering in both the enterprise of American industrial design and the concomitant enterprise of American domestic design piracy.

A. Innovation and Design Piracy in American Antebellum Manufacturing

In the 1830s, American manufacturers produced cast-iron goods[63] directly from iron ore using large blast furnaces located near iron ore sources and navigable waterways.[64] Blast iron furnaces produced goods that were usually very coarse, heavy, and unrefined.[65] Furnace operators did not specialize in particular products, so they had little interest in developing ornamentation or aesthetically pleasing configurations for particular products.[66] Indeed, blast furnace operators were more concerned with the composition of the iron than the casting's aesthetics.

Jordan L. Mott, a leading New York manufacturer,[67] revolutionized the processes for producing cast-iron goods, and, in short measure, became a principal lobbyist for expanding American intellectual property protection, particularly with regard to designs.[68] Mott deserves mention as one of antebellum America's foremost entrepreneurs, and as one of its consummate patent system insiders—credentials that he sought to preserve for posterity by commissioning a painting that depicts him in the Great Hall of the Patent Office in imaginary conversation

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1760–1911, at 63–76 (1999).

63. An iron "cast" or "casting" is the actual shape or product that is created by pouring refined molten iron into a mold and allowing it to cool and solidify. *See* HUGH PHILIP TIEMANN, IRON AND STEEL 44–45 (1910).

64. *See generally* FREDERICK OVERMAN, THE MANUFACTURE OF IRON, IN ALL ITS VARIOUS BRANCHES 145–51 (1850) (depicting a typical blast furnace, fig. 49).

65. *See* IV JOHNSON'S NEW UNIVERSAL CYCLOPEDIA: A SCIENTIFIC AND POPULAR TREASURY OF USEFUL KNOWLEDGE 585 (Frederick A. P. Barnard & Arnold Guyot eds., 1878) [hereinafter JOHNSON'S NEW UNIVERSAL CYCLOPEDIA].

66. *See* DAVID R. MEYER, NETWORKED MACHINISTS: HIGH-TECHNOLOGY INDUSTRIES IN ANTEBELLUM AMERICA 110 (2006).

67. At one time, Mott's sprawling real estate holdings encompassed most of Brooklyn. *See* PROMINENT FAMILIES OF NEW YORK 420 (BiblioLife ed., 2009) (Lyman H. Weeks ed., 1897).

68. *See infra* Part II.

with Morse, Colt, Goodyear, and other legendary American inventors.[69] His vanity was not in question.

In the 1830s, Mott had begun producing the first practical coal-fired, cast-iron stoves and had sold them to customers in New York City.[70] At first, he did not make his own castings; instead, he bought them from blast furnace operators who produced them and shipped them to him for assembly.[71] Seeking to end his dependence on the blast furnace operators,[72] Mott built a small-scale cupola furnace in the city[73] and, after some experimentation, determined how to produce his own castings using pig iron.[74] Compared to cast-iron plates made directly from ore by blast furnaces, cupola furnaces produced thinner, lighter castings, but they were more susceptible to cracking when heated.[75] To overcome this problem, he incorporated curves, fluting, and other features aimed at enhancing heat dissipation.[76]

According to one account, Mott's innovative process "gained the attention of iron men, and before the close of the year cupola furnaces began to be erected, and

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69. The painting is *Men of Progress* by Christian Schussele, circa 1857. For background, see Henry Petroski, *Men and Women of Progress*, 82 AM. SCIENTIST 216, 216–17 (1994). At about that same time, President Buchanan asked Mott to become the Commissioner of Patents, but Mott ultimately declined. PROMINENT FAMILIES OF NEW YORK, *supra* note 67, at 420.

70. Mott had secured utility patent protection for an anthracite-burning coal, and he had determined how to use "pea-sized" coal (previously considered to be scrap) as stove fuel. 4 AMERICAN SUPPLEMENT TO ENCYCLOPEDIA BRITANNICA: A DICTIONARY OF ARTS, SCIENCES, AND GENERAL LITERATURE 606 (J.M. Stoddart ed., 1889); Stoves, U.S. Patent No. 7,096X (issued May 30, 1832). This innovation revolutionized the stove industry. JOHNSON'S NEW UNIVERSAL CYCLOPEDIA, *supra* note 65, at 585.

71. *See* 2 J. LEANDER BISHOP, A HISTORY OF AMERICAN MANUFACTURES FROM 1608 TO 1860, at 576–77 (3d ed. 1868) [hereinafter AMERICAN MANUFACTURES].

72. Mott became dissatisfied with the prices that blast furnace operators were charging him, according to at least one account. *Id.* at 577.

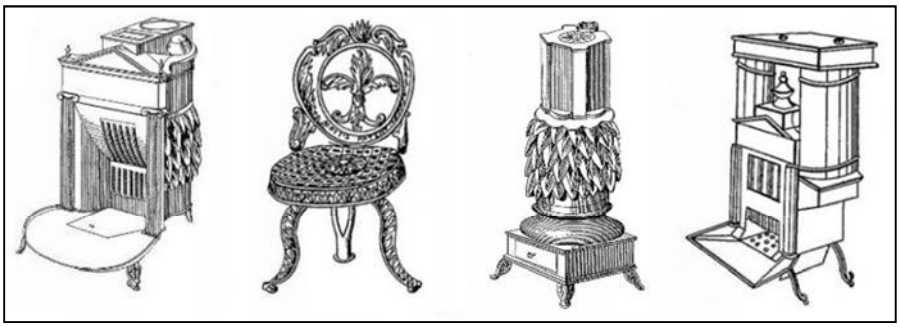
73. *See* William Dundas Scott-Moncrieff, *The Cupola Furnace and "Castings," in* GREAT INDUSTRIES OF GREAT BRITAIN 111 (Cassell & Co. ed., 1884) (describing the cupola furnace); AMERICAN MANUFACTURES, *supra* note 71, at 577 (describing the location of Mott's cupola furnace).

74. *See* AMERICAN MANUFACTURES, *supra* note 71, at 577.

75. *Id.* at 576–77.

76. *Id.* at 577 ("Mr. Mott made his plate patterns 'from edge to edge longer than a straight line,' by pannelling, curving, fluting, or other device."); Conversational Meeting of the Mechanics Institute, Reported for the American Repertory, Subject Stoves (Feb. 1840) (unpublished manuscript) (on file with the Columbia University Rare Book & Manuscript Library, Mott Family Papers, Box 2). Signed "Ed's Notes," this manuscript appears to have been produced during an interview with Jordan Mott while a member of the Mechanic's Institute. It notes that Mott's insight concerning the stove's surface area improved the iron's heat radiation properties to the point where they no longer had to line the stoves with brick. For an example of one of Mott's designs utilizing these techniques, see Stove & Fireplace, U.S. Patent No. 50 (issued Oct. 11, 1836) (Figs. 1–3) (utilizing separate concentric rings in scalloped, notched, and leaf patterns in order to dissipate heat but noting that their "ornament" was "merely a thing of fancy, or taste").

soon spread over the cities and villages of the Union."[77] Mott and others could now cast their own stoves on a commercial scale.[78] Subsequent advances in thin-casting techniques, among other factors,[79] facilitated explosive growth in the production of a wide array of additional cast-iron goods, including "kitchen utensils, sugar-kettles, bath-tubs, . . . cast-iron railings, fountains, and lawn ornaments."[80] Some of Mott's innovative stove and chair designs are depicted below.[81]



Once they adopted thin-casting techniques, Mott and other manufacturers suddenly found that a new and unexpected opportunity for innovation had opened to them. They could now add value to cast-iron consumer goods on a commercial scale by crafting innovative, distinctive designs. That is, by incorporating ornamentation, or by adopting daring new geometries for their products, they might lend their products aesthetic appeal and simultaneously provide consumers a basis for differentiating between competing products.

Iron goods manufacturers employed pattern makers who carved new patterns using soft woods, plaster, or soft metals;[82] casting molds were then made from the

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77. AMERICAN MANUFACTURES, *supra* note 71, at 577. Some evidence suggests that others in addition to Mott were experimenting with the use of cupola furnaces at the same time. *See* Jeremiah Dwyer, *Stoves and Heating Apparatus*, *in* 2 ONE HUNDRED YEARS OF AMERICAN COMMERCE 357, 361 (Chauncy M. Depew ed., 1895) (stating that Mott was "one of the first to use a cupola for remelting iron for stove manufacture").

78. *See, e.g.*, RUTH SCHWARTZ COWAN, MORE WORK FOR MOTHER: THE IRONIES OF HOUSEHOLD TECHNOLOGY FROM THE OPEN HEARTH TO THE MICROWAVE 60 (1983) (crediting Mott as the first to actually "make" stoves, instead of just assembling them).

79. *See* Charles Huston, *The Iron and Steel Industry*, *in* 1 ONE HUNDRED YEARS OF AMERICAN COMMERCE 320, 323 (Chauncey M. Depew ed., 1895) (noting that the growth of the railroad network profoundly affected the growth of the iron industry); F.W. TAUSSIG, THE TARIFF HISTORY OF THE UNITED STATES 57 (6th ed. 1914) (attributing U.S. iron industry growth in the 1830s principally to the introduction of anthracite coal-based smelting, replacing charcoal smelting).

80. VICTOR S. CLARK, HISTORY OF MANUFACTURES IN THE UNITED STATES: 1607–1860, at 504 (1916).

81. The featured design diagrams and their corresponding citations are listed from left to right: Stove & Fireplace, U.S. Patent No. 50 fig. 3 (issued Oct. 11, 1836); Cast-Iron Chair, U.S. Patent No. 5,317 fig. 1 (issued Oct. 2, 1847); Stove & Fireplace, U.S. Patent No. 50 fig. 2 (issued Oct. 11, 1836); and Parlor-Stove, U.S. Patent No. 508 fig. 1 (issued Dec. 7, 1837).

82. *See* ALONZO POTTER, THE PRINCIPLES OF SCIENCE APPLIED TO THE DOMESTIC AND

patterns.[83] According to contemporary observers, the pattern maker's design work was "almost entirely executed by hand, entailing a heavy expense and the consumption of considerable time."[84] Once made, the patterns could be used repeatedly, so they were of great value, so much so that some firms created fire-resistant "pattern houses" for their storage.[85] Advertisements began to emphasize the ornamental attributes of cast-iron goods,[86] and, for the first time, some cast-iron goods came to be perceived as works of art.[87]

The phenomenon was not confined to the cast-iron goods market. A more general enterprise of American industrial design was beginning to emerge. As Arthur Pulos points out, a consumer "could always depend on what his senses told him" about a product even if he found the mechanics of the product to be baffling.[88] Many manufacturers "began to pay particular attention to the notion that artistic values applied to utilitarian manufactures might also increase their saleability."[89]

Still, American cast-iron goods designers had no apparent, formal intellectual property mechanism available for capturing the value attributable to design. Copyright protection was an obvious candidate (at least as viewed in retrospect), but copyright protection did not embrace industrial creations, entirely omitting protection for three-dimensional useful articles until many decades later[90] and only affording protection in limited instances for surface ornamentation applied to two-

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MECHANIC ARTS, AND TO MANUFACTURES AND AGRICULTURE 214 (1860).

83. *See generally Babbage on the Economy of Manufactures*, 2 AM. RAILROAD J. & ADVOC. INTERNAL IMPROVEMENTS 353, 359 (1833) ("Patterns of wood or metal made from drawings are the originals from which the moulds for casting are made: so that, in fact, the casting itself is a copy of the mould, and the mould is a copy of the pattern."); 2 SUPPLEMENT TO SPONS' DICTIONARY OF ENGINEERING 618–72 (Ernest Spon ed., 1880) (detailing the casting process).

84. 4 AMERICAN SUPPLEMENT TO ENCYCLOPEDIA BRITANNICA, *supra* note 70, at 606.

85. Ellen Marie Snyder, *Victory over Nature: Victorian Cast-Iron Seating Furniture*, 20 WINTERTHUR PORTFOLIO 221, 224 (1985).

86. *See, e.g.*, Priscilla J. Brewer, *"We Have Got a Very Good Cooking Stove": Advertising, Design, and Consumer Response to the Cookstove, 1815–1880*, 25 WINTERTHUR PORTFOLIO 35, 43 (1990) (identifying an 1844 stove advertisement illustrating that the stove's appearance had become an important consideration in stove marketing); Snyder, *supra* note 85, at 227 (noting that trade catalogues for cast-iron products extolled their visual appearance and finding that even Mott's catalogue grandly boasted that it contained nothing that did "not possess some artistic merit").

87. Snyder, *supra* note 85, at 226 (referring to a perception of cast-iron's "aesthetic elevation" to art).

88. PULOS, *supra* note 9, at 133.

89. *Id.*

90. The Act of July 8, 1870, defined copyrightable subject matter to include "statuary, and . . . models or designs intended to be perfected as works of the fine arts." Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212. In 1909, Congress amended the provision substantially, deleting the "fine arts" language and providing that copyright protection could extend to all works of authorship. *See* Act of March 4, 1909, ch. 320, § 4, 35 Stat. 1075, 1076. Eventually, in *Mazer v. Stein*, 347 U.S. 201 (1954), the Supreme Court concluded that these changes extended copyright beyond the traditional fine arts to industrial designs such as the statuettes at issue in *Mazer*, which were intended to be used as bases for lamps. *Id.* at 213–14.

dimensional objects.[91] No federal trademark regime existed, and common law unfair competition precedents, which were sparse at the time, offered no clear basis for the protection of designs as trade dress.[92] Lastly, utility patent law protected industrial creations but not their visual aspects.[93] Indeed, writing with the benefit of hindsight, William Edgar Simonds averred that the classes of "intellectual productions" divided neatly into three: "books, maps, charts, cuts, engravings, prints, and musical compositions" (all protected by copyright at the time); "new and useful arts, machines, manufactures, and compositions of matter, and improvements thereon" (protectable under the utility patent regime); and "a third class to which no protection had been given, comprising . . . patterns, figures, or pictures to be woven into, or printed or impressed upon textile fabrics, as carpets, shawls[,] and dress goods."[94]

Our research suggests that, prior to 1836, some entrepreneurs were attempting to use the utility patent regime to obtain design protection *sub rosa*. From 1793 to 1836, the utility patent system did not subject patent applications to substantive examination prior to grant,[95] so patents could issue without ever having been scrutinized for compliance with substantive patentability requirements—including requirements for eligible subject matter. While stove makers were certainly using the utility patent system to protect technological innovations embodied in their

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91. In particular, Congress extended copyright protection to engravings and etchings in 1802. *See* Act of Apr. 29, 1802, ch. 36, § 2, 2 Stat. 171, 171 (extending copyright protection to "who[ever] shall invent and design, engrave, etch or work, or from his own works and inventions, shall cause to be designed and engraved, etched or worked, any historical or other print or prints").

92. *See, e.g.*, 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:62 (4th ed. 2009) (identifying the 1917 crescent wrench decision, *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299 (2d Cir. 1917), as the first true American product design trade dress case).

93. Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318, 319 [hereinafter Patent Act of 1793] (providing that utility patent protection extended to "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"). We have found no evidence of any argument to extend this language to ornamental design, except for a somewhat cryptic remark from the treatise writer Willard Phillips. Phillips claimed that the French Patent Law of 1791 rejected protection for "mere ornaments" as not the proper subject for utility patents and then asserted:

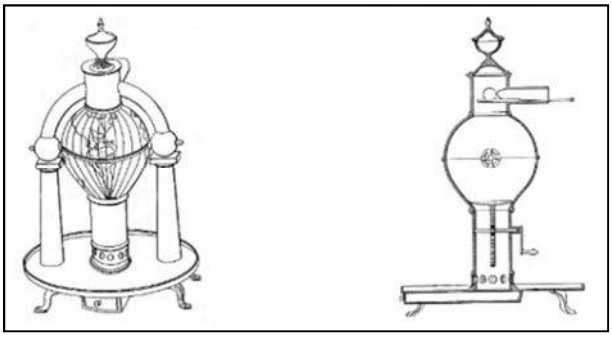
> [T]his appears to be a very questionable position, for it would never be contended in case of an invention of which a part was ornamental merely, that this part might be infringed with impunity; and there appears to be no more ground for yielding any more protection to ornamental parts in an original invention, than in an improvement, or in a case where a part of the invention was ornamental, than one which should be wholly confined to ornament.

WILLARD PHILLIPS, THE LAW OF PATENTS FOR INVENTIONS 135 (1836).

94. WILLIAM EDGAR SIMONDS, THE LAW OF DESIGN PATENTS 183 (1874). According to Simonds, design patent protection was intended for the benefit of this third, unprotected class. *Id.* at 184. As we have suggested throughout this paper, the creation of the design patent system was not quite so conceptually pure.

95. *See* EDWARD C. WALTERSCHEID, TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW AND ADMINISTRATION, 1798–1836, at 427 (1998).

cast-iron stoves, at least one stove maker attempted to use the utility patent regime to obtain the equivalent of design protection. Walter Hunt, one of the nineteenth century's most prolific inventors,[96] developed a globe-shaped heating stove that was said to permit radiated heat to be distributed equally in all directions.[97] Hunt filed a utility patent application that not only detailed the construction and functional advantages of the globe-shaped stove body but also included a drawing in which the stove's body was adorned with depictions of the continents (below, left).[98]



Hunt included three claims in the application, the first of which suggests that he may have been asserting exclusive rights over both the functional and the visual aspects of the stove:

> I claim the *style*, *general arrangement* and *fashion* of the above described Radiator or Globe Stove believing the peculiar advantages of said arrangement in the generating and equal diffusion of heat exclusively confined to the globe or spheroid form as a reservoir of fuel . . . which cannot be effected by the regular or cylindrical stove.[99]

An early advertisement for the stove not only highlights its useful features but also indicates that "[p]atterns may be seen at the [Globe Stove] office."[100] The patent drawings depict additional ornamentation, likewise suggesting that the Globe Stove was about more than merely functional advantages.[101] Hunt's example

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96. *See generally* JOSEPH NATHAN KANE, NECESSITY'S CHILD: THE STORY OF WALTER HUNT, AMERICA'S FORGOTTEN INVENTOR (1997). Hunt's pioneering work on sewing machines later figured prominently in massive patent litigation in that industry. *See* Adam Mossoff, *The Rise and Fall of the First American Patent Thicket: The Sewing Machine War of the 1850s*, 53 ARIZ. L. REV. 165, 187–90 (2011).

97. KANE, *supra* note 96, at 63.

98. Heating Stove, U.S. Patent No. 8,006X fig. 1 (issued Feb. 8, 1834) (Fig. 1, depicted on the left). The drawing on the right is Figure 2 from the patent, a partial cutaway view depicting the stove's interior construction.

99. *Id.* at 84–85 (claim 1) (emphasis added); *see also* KANE, *supra* note 96, at 63.

100. KANE, *supra* note 96, at 61 (reprinting an advertising sheet dated Nov. 1833 for "Hunt's Patent Radiator, or Globe Stove").

101. *See* '006X Patent fig.1; *see also The Globe Stove*, N.Y. COM. ADVERTISER, Nov. 7,

is particularly noteworthy because he eventually joined Mott in lobbying for design protection legislation, as we discuss in more detail below.[102]

The appropriability problem that was developing in the cast-iron goods industry was also plaguing the New England textile industry in America.[103] Design piracy became particularly widespread in the American textile industry in the 1830s.[104] Ornate calico prints produced at the New England factories of Francis Lowell (and fellow Boston Associates) had become so popular that they had "displace[d] the linseys, checks, and homespun plaids" that local artisans had traditionally sold.[105] As firms came to produce calico design patterns on an ever-expanding scale, competitors inevitably sought to mimic those patterns.[106] However, American intellectual property law provided no apparent recourse.

Intellectual property scholars will find this narrative familiar. It is a classic exemplar of the public goods problem of intellectual property lore.[107] Predictions of an intellectual property law response would fit amicably within Harold Demsetz's thesis for the emergence of private property rights.[108] An intellectual property response was predictable for another reason: an analogous situation had developed in Great Britain.

B. Design Piracy in Great Britain and the Intellectual Property Law Response

As American manufacturers came to realize, a similar saga of technological advance had spurred a legislative response in Great Britain. Cotton textile manufacturers in northern England and Scotland had adopted technological

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1833, at 2 ("[F]rom the beauty and perfection of some of the castings we have seen, it can be made as ornamental as need be desired.").

102. *See infra* Part III. Like Mott, Hunt manufactured stoves in New York City. *See* KANE, *supra* note 96, at 66 (noting that Hunt identified himself in city directories as a stove maker in New York City). Mott, in turn, was apparently familiar with Hunt's work on the globe-stove. *See, e.g.*, Coal-Stove, U.S. Patent No. 4,247 (issued Nov. 1, 1845) (noting his awareness of Hunt's globe-stove).

103. Indeed, the problem fits a classic pattern; it has been duplicated in many settings and has driven much intellectual property policy over the decades. *See, e.g.*, ADRIAN JOHNS, PIRACY (2009).

104. *See* PAUL E. RIVARD, A NEW ORDER OF THINGS: HOW THE TEXTILE INDUSTRY TRANSFORMED NEW ENGLAND 68–69 (2002) (characterizing design copying as standard practice).

105. CLARK, *supra* note 80, at 547.

106. Copying textile print patterns did require some skill. A would-be copyist had to be capable of decoding the pattern's elements, engraving them for rollers, and then determining the proper blend of dyes. RIVARD, *supra* note 104, at 68–69.

107. Indeed, analogous problems in the British textile industry had generated design legislation that took its cue from copyright law, and American lobbyists drew on the British experience to formulate their proposals, as we discuss further *infra* Part III.

108. *See* Harold Demsetz, *Toward a Theory of Property Rights*, 57 AM. ECON. REV. 347, 350 (1967) (positing that changes in technology or markets stimulate the creation and capture of emerging economic value through private property rights). We do not mean to suggest that the Demsetzian account provides a comprehensive explanation for the creation of the design patent system. As we show *infra* Part III, a number of domestic political factors also contributed to the enactment of the design patent provisions.

innovations in printer cylinders that enabled them to print patterns over continuous lengths of cloth, on a large scale, and at previously unheard-of rates.[109] However, these manufacturers quickly found that consumers preferred the patterns they associated with London-based manufacturers,[110] so they copied those patterns and used them to produce calico prints in quantities far exceeding their originators.[111] Not surprisingly, by the late 1700s, the London calico manufacturers were complaining to Parliament.[112] Because contemporary English copyright law protected engravers and authors but not textile pattern makers,[113] Parliament enacted new legislation, the Calico Printers' Act of 1787,[114] which conferred protection on persons "who shall invent, design, and print . . . any new and original pattern . . . for printing linens, cottons, callicos, or muslins."[115] By the early 1800s, an active debate in England about expanding the Act culminated in a radical new design protection system beginning in 1839.[116] We discuss its details below and explain how it came to be used as a model for American law.

III. DESIGN PATENT LAW'S AMBIVALENT LEGISLATIVE ANCESTRY

In view of the technological context that we have explored in Part II, we now turn to an analysis of the design patent system's legislative ancestry. Relying on newly uncovered source material, we describe the first proposal for American design protection legislation, which was styled as copyright legislation and borrowed heavily from British design copyright law. We then recount the disappearance of the first proposal and the emergence of a second—newly

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109. *See, e.g.*, Lara Kriegel, *Culture and the Copy: Calico, Capitalism, and Design Copyright in Early Victorian Britain*, 43 J. BRIT. STUD. 233, 238–39 (2004).

110. *See id.* at 239–40.

111. *Id.* at 240.

112. SHERMAN & BENTLY, *supra* note 62, at 63 n.3.

113. *See* Engraving Copyright Act, 1734, 8 Geo. 2, c. 13 (Eng.), *amended by* Engraving Copyright Act, 1766, 7 Geo. 3, c. 38 (Eng.), *amended by* Prints Copyright Act, 1777, 17 Geo. 3, c. 57 (Eng.).

114. An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Callicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors, for a limited Time, 27 Geo. 3, c. 38 (1787) (Eng.) [hereinafter Calico Printers' Act].

115. *Id.* § 1. Protection endured only for two months, a reflection of the staunch opposition that the northern cotton factories mounted. SHERMAN & BENTLY, *supra* note 62, at 63 n.3. Parliament initially enacted the Calico Printers' Act for only one year, *see* Calico Printers' Act § 3, but extended it successively. *See* An Act for continuing an Act made in the twenty-seventh Year of the Reign of his present Majesty, intituled [sic], *An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Callicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time*, 29 Geo. 3, c. 19 (1789) (Eng.), *made perpetual by An Act for amending and making perpetual an* Act made in the twenty-seventh Year of the Reign of his present Majesty, intituled [sic], *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*, 34 Geo. 3, c. 23 (1794) (Eng.).

116. *See infra* Part III.

characterized as patent legislation. We show why this new proposal likely sprang from considerations of bureaucratic self-interest, not from any perceived distinction between the relative merits of copyright and patent protection for designs. We conclude by showing that the ultimate passage of the design patent legislation likely resulted from external political forces—specifically, a protectionist surge advocated by the Whig Party and bitterly opposed by the Jacksonian Democrats.

A. The Mott and Ruggles Proposals: Design Patent's Genesis in British Design Copyright[117]

Stove manufacturer Jordan L. Mott set in motion the proposals that eventually grew into the design patent legislation. In February 1841, Mott, on behalf of himself and numerous signatories, petitioned Congress for design protection.[118] Noting that designs were not eligible for utility patent protection, Mott's petition argued that "improvements . . . in articles of manufacture ha[d] rendered necessary a *registration* of new designs and patterns."[119] These designs "require[d] a considerable expenditure of time and money, and c[ould] be . . . use[d] . . . by any person so disposed, in such a manner as to undersell the inventor or proprietor."[120] Above all, the petitioners did not call for copyright or patent protection but for a registration.[121]

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117. To our knowledge, scholars have never previously analyzed the Ruggles bill discussed in this section. Ruggles's introduction of both the petition on February 3, 1841, and the bill on February 27, 1841, were misclassified in the Congressional Globe's index under the heading "Patent Office, report of the Commissioner, showing operations of, for the past year," *see* CONG. GLOBE, 26th Cong., 2d Sess. index at 6 (1841), which may explain why previous researchers have not uncovered it.

118. *See* 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. 26-154 (2d Sess. 1841) [hereinafter MANUFACTURERS' PETITION]. It is not clear whether Jordan Mott was a Whig, or whether he was otherwise in a position to harness Whig political forces to press his proposal forward. We do know that Mott was not shy about lobbying prominent Whigs about intellectual property matters. In an 1851 debate over utility patent legislation, Mott corresponded with the nation's most prominent Whig, Henry Clay, receiving a polite but peremptory response. *See* Letter from Jordan L. Mott to Henry Clay (Jan. 24, 1851), *in* 10 THE PAPERS OF HENRY CLAY 848 (Melba Porter Hay ed., 1991). One year later, Mott was chosen to serve as an aid in the grand procession in New York City in observance of Henry Clay's death, *see Programme of Arrangements for the Funeral Ceremonies of the Late Hon. Henry Clay*, N.Y. DAILY TIMES, July 19, 1852, at 1, though we cannot say whether this indicates Mott's Whiggish tendencies or merely his substantial prominence in New York.

119. MANUFACTURERS' PETITION, *supra* note 118, at 1 (emphasis added).

120. *Id.* (estimating that it only cost the copier "one-hundredth of the expense which it has cost the original manufacturer"). Intellectual property scholars will recognize this as a classic invocation of the public goods problem. *See, e.g.*, WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 19–20 (2003) (providing a general discussion).

121. MANUFACTURERS' PETITION, *supra* note 118, at 1.

Moreover, after noting that fabric designers faced similar obstacles, the petitioners were quick to point out that Great Britain had recently passed such rights for their citizens.[122] They argued:

> Your petitioners believe that the manufacturers and mechanics of the United States are not surpassed by those of any other country, in the durability and utility of the articles manufactured by them; and they confidently affirm that the articles manufactured by them would equal any others in beauty, if new designs and patterns were secured by registration.[123]

Thus, design protection was cast not only as a problem of domestic free riding, but also as an international trade problem.[124]

Although the copy of Mott's petition reprinted in the U.S. Congressional Serial Set[125] includes only the text of the petition itself, additional archival research turned up a reproduction of the original that included the petitioners' signatures, including that of Walter Hunt, the inventor of the Globe Stove.[126] Some signatories also listed their occupations. A study of these signatories provides a rare glimpse into the grassroots politics of early American lobbying efforts in intellectual property. They were all male (not surprisingly) and all from the Northeast: predominantly New York and New Jersey, along with Connecticut, and the cities of Philadelphia and Boston. A few appear to have been Whigs,[127] but we are unable to determine whether the petitioners originated predominantly from Whig party rolls. Most who identified their occupation appear to have been tradesmen: a manufacturer, an engineer, a "designer in mechanics," three "mechanists," and various others.[128]

It is perhaps significant that some of the listed professions involved subject matter that lay at the margins of traditional copyright and patent regimes—and still

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122. *Id.* (citing An Act to secure to Proprietors of Designs for Articles of Manufacture the Copyright of such Designs for a limited Time, 2 Vict., c. 17 (1839) (Eng.) [hereinafter Designs Registration Act, 1839]).

123. *Id.*

124. *See supra* Part II (discussing this aspect of design patent's origins).

125. *See* MANUFACTURERS' PETITION, *supra* note 118, at 2 (identifying signatories only as "JORDAN L. MOTT and others").

126. Our appreciation to Kenneth Kato, Center for Legislative Archives, National Archives and Records Administration, for assistance in procuring the signature pages. Scans of the signature pages are on file with authors.

127. For example, J.W. Warren of Boston appears to have been a newspaper editor and Whig party member. *See* CHRISTIAN WATCHMAN, Mar. 3, 1837, § 18, at 9 (reporting on Warren's editorship of the *Christian Witness*); *Public Meeting*, N.Y. DAILY TIMES, Mar. 5, 1852, at 2 (listing Warren as a supporter of the Whig nomination of Daniel Webster for President). Andrew Anderson of Jersey City likewise may have been involved in Whig politics, at least as of the 1850s. *See Jersey City: Whig Primary Meeting*, N.Y. DAILY TIMES, Apr. 6, 1854, at 3.

128. One signatory was Joseph Priestley—not the famous scientist credited with the discovery of oxygen, who passed away in 1804, but perhaps an heir. For biographical background on the famous Priestley, see STEVEN JOHNSON, THE INVENTION OF AIR (2008).

does. For example, Isaac Edge, Jr., of Jersey City, was a renowned designer of fireworks displays.[129] Joseph E. Ebling of New York was a confectioner.[130]

Another signatory, Samuel Loomis of Connecticut, was probably from the famed Loomis family of furniture designers.[131] If so, this shows good foresight. Design protection (including by design patent) has proven especially important for furniture designers over the years.[132] Yet another signatory appears to have been an inventor of prosthetic limbs, which eventually obtained utility patent protection.[133]

Senator John Ruggles from Maine,[134] former chair of the Senate's Committee on Patents and the Patent Office,[135] presented Mott's petition to Congress[136] and, within weeks, followed up with a legislative proposal.[137] Ruggles was a logical sponsor for the legislation given his reputation as a leader in Congress on intellectual property matters, but he also may have had a family interest in the bill. John Ruggles's brother, Draper Ruggles,[138] was a partner in the largest cast-iron plow and agricultural implement company in the United States—Ruggles, Nourse & Mason.[139] In addition, the firm apparently had business connections with Mott, acting as a distributor for Mott's famous agricultural furnace.[140]

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129. *See* Classified Advertisement, *Edge's First Premium Fireworks*, N.Y. DAILY TIMES, June 29, 1854, at 5 (representative advertisement of the Edge family's displays); *Independence Day: Celebration of the "Glorious Fourth,"* N.Y. TIMES, July 5, 1854, at 1 (reporting that the Edge family had been hired by New York City for the July 4th fireworks celebration).

130. MANUFACTURERS' PETITION, *supra* note 118 (signature page).

131. Loomis furniture is on display in the Wadsworth Atheneum Museum of Art as examples of the Colchester/Norwich furniture style. *See American Decorative*, WADSWORTH ATHENEUM MUSEUM ART, http://www.thewadsworth.org/american-decorative/.

132. For a recent example from the design patent area, see *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365 (Fed. Cir. 2006).

133. William Selpho of New York. *See* Construction of Artificial Hands, U.S. Patent No. 18,021 (issued Aug. 18, 1857); Construction of Artificial Legs, U.S. Patent No. 14,836 (issued May 6, 1856).

134. For general biographical information on Ruggles, see 12 THE NATIONAL CYCLOPÆDIA OF AMERICAN BIOGRAPHY 230 (1904). Regarding the family's political prominence, see FRANCES COWLES, THE FAMILY OF RUGGLES 8–9 (1912).

135. CONG. GLOBE, 25th Cong., 1st Sess. 16 (1837) (noting Ruggles's position as Committee chair).

136. *See* CONG. GLOBE, 26th Cong., 2d Sess. 139 (1841). The petition was ordered for printing and referred to the Committee on Patents and the Patent Office. *Id.*

137. For promoting the progress of the useful arts, by securing the right of invention and copy-right to proprietors of new designs for manufactures, for limited times, S. 269, 26th Cong. (1841) [hereinafter Ruggles Design Bill]; CONG. GLOBE, 26th Cong., 2d Sess. 212 (1841) (reporting that Senator Ruggles "asked and obtained leave to introduce a bill granting copy-rights to inventors of designs, &c., which was read twice and referred to the Committee on Patents and the Patent Office").

138. HENRY RUGGLES, ANCESTRY OF JUDGE THOMAS RUGGLES, OF COLUMBIA FALLS, MAINE, AND JUDGE JOHN RUGGLES OF THOMASTON, MAINE 36–37 (1924) (Maine Historical Society). We are especially indebted to Jamie Kingman Rice, public services librarian at the Maine Historical Society, and Maribel Nash, reference librarian at the Pritzker Legal Research Center at Northwestern School of Law, for this point.

139. *See* CHARLES G. WASHBURN, INDUSTRIAL WORCESTER 132–33 (1917). *See generally* 2 J. LEANDER BISHOP, A HISTORY OF AMERICAN MANUFACTURES FROM 1608 TO 1860, at 701–

The bill was styled as a design *copyright* proposal. It proposed a "sole and exclusive copy-right" for the proprietor of any "new and original design"[141] for specified articles of manufacture.[142] The list of specified articles explicitly responded to the wishes of the iron and textile industries. It included "linen, cotton, calico, muslin, or other textile fabric,"[143] ornamentation on any article other than a textile fabric,[144] and the shape or configuration of any article not falling into the

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02 (1864) (providing some background on the partnership and their successor Oliver Ames & Sons' Agricultural Implement Manufactory). Draper Ruggles also figured in an important early utility patent infringement case. *See* Prouty v. Ruggles, 41 U.S. (16 Pet.) 336, 341 (1842) (espousing an all-elements rule for utility patent infringement). Draper Ruggles was likely the unnamed "brother" continually referred to in the Select Committee's investigation into Senator John Ruggles's activities with Henry C. Jones. *See* Hugh L. White, Senate Select Committee Report, S. DOC. NO. 25-377, at 9, 12, 16, 17, 19, 56, 68 (1838). According to the report, Ruggles allegedly sought to secure patent rights for a brother who lived in Worcester, Massachusetts, and who already had a half interest in a patented plough. *See id.* at 9. Although the exact plough is unknown, Draper Ruggles's iron manufactory in Worcester owned the patents to numerous ploughs and agricultural implements during this time, and the report is probably referring to Ruggles's ownership of Jethro Wood's patented plough. *See* WASHBURN, *supra*, at 132.

140. *See Mott's Agricultural Furnace*, ME. FARMER, Jan. 8, 1846, at 1 (explaining that Mott's furnace could be purchased at the Ruggles, Nourse & Mason warehouse in Boston and including a drawing of a 22 gallon model); Advertisement, *Mott's Agricultural Furnace*, ME. FARMER, Oct. 15, 1846, at 1.

141. Although these terms were eventually adopted by the legislature, and even developed into the same novelty and originality standards that we think of today as distinguishing patent and copyright law, it is not clear what Senator Ruggles meant by "new and original." *See infra* note 164 and accompanying text (discussing their contemporary meanings under British law). Indeed, it took over a quarter of a century for this distinction to develop in U.S. law, and their meanings under both regimes were in flux during this time. *See* Kenneth J. Burchfiel, *Revising the "Original" Patent Clause: Pseudohistory in Constitutional Construction*, 2 HARV. J.L. & TECH. 155, 181–209 (1989) (tracing the novelty standard); Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 469–82 (2009) (tracing the originality standard); s*ee also* Baker v. Selden, 101 U.S. 99, 102 (1879) (distinguishing patent and copyright, in part, by novelty and one component of the modern originality standard, independent creation). Although the requirements have different meanings today, contemporary courts often used them interchangeably and across both regimes—broadly requiring the combined elements of a copyrightable work or a patentable invention to be produced by the author or inventor's intensive labor or creativity. *See* Miller, *supra*, at 469–75. Joseph Miller points out that "[t]he contemporary taboo against comparing originality [in copyright] to nonobviousness[, invention, or novelty (in patent)] is just that—contemporary." *Id.* at 471. The modern design patent act's retention of these terms (new and original) stands as one of the few fossilized reminders of patent and copyright's common history.

142. Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841).

143. *Id.* (offering protection "[f]or the pattern or print to be either worked, stamped, printed, or painted, into or on any article of manufactured linen, cotton, calico, muslin, or other textile fabric").

144. *Id.* (offering protection "[f]or the modelling [sic], or the casting, or the embossment, or the chasing, or engraving, or for any other kind of impression or ornament, on any article of manufacture not being a textile fabric").

previously mentioned categories.[145] The copyright term was one year,[146] except where the design was for ornamentation on an article "made of metal," the term was three years.[147]

Ruggles's bill provided that the proposed design copyright would only come into force upon registration.[148] However, registration would be issued only if, "on examination" by the Patent Office,[149] the design appeared to be "new and original,"[150] assuming that the applicant also paid the requisite filing fee[151] and complied with other formalities.[152] The registered rights-holder received a right to institute an infringement action against anyone who "shall adopt and use" the registered design during the term of the registration.[153]

Most of the concepts in Ruggles's bill, and even many of the key passages, were not original. They had been borrowed from Britain's dual copyright system for designs, enacted scarcely two years earlier.[154] One component of the dual system, the British Copyright of Designs Act (1839), extended copyright protection to new and original[155] patterns for printing "Linens, Cottons, Calicoes, or Muslins,"[156]—the same list that later appeared in Ruggles's proposal.[157] The other component, the Design Registrations Act (1839), protected three categories of subject matter: (1) any "Pattern or Print, to be either worked into or worked on, or printed on or painted on, any Article of Manufacture"; (2) designs "[f]or the Modeling, or the Casting, or the Embossment, or the Chasing, or the Engraving, or for any other Kind of Impression or Ornament, on any Article of Manufacture, not being a Tissue or textile Fabric"; and lastly (3) "the Shape or Configuration of any Article of Manufacture."[158] Ruggles borrowed this three-part structure and substituted the list of fabrics into the first category, converting the British dual system into a unified

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145. *Id.*

146. *Id.*

147. *Id.*

148. *Id.*

149. *Id.* § 4.

150. *Id.*; *see also supra* note 141 and accompanying text (discussing the "new and original" requirement).

151. Ruggles Design Bill, S. 269, 26th Cong. § 6 (1841).

152. *Id.* § 4.

153. *Id.* § 3. Recovery for infringement ranged from $20 to $200 and was contingent on marking. *Id.* Unfortunately, this innovation did not make its way into the 1842 Act. *See* Act of Aug. 29, 1842, *supra* note 60. Because of the palpable difficulty of proving that a defendant's profits from an infringing product were attributable to the protected design—and not other things like marketing or functionality—Congress eventually provided a minimum recovery for willful infringement in 1887. *See* Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387; *see also* Frederic H. Betts, *Some Questions Under the Design Patent Act of 1887*, 1 YALE L.J. 181, 182–83 (1892).

154. Designs Registration Act, 1839, 2 Vict., c. 17, § 1 (Eng.); An Act for Extending the Copyright of Designs for Calico Printing to Designs for Printing other Woven Fabrics, 2 Vict., c. 13 (1839) (Eng.) [hereinafter Calico Act, 1839].

155. *See infra* note 164.

156. Calico Act, 1839, 2 Vict., c. 13, §§ 1, 3 (Eng.) (additionally extending protection to "other Fabrics of a similar Nature," which included fabrics composed of wool, silk, or hair, and any mixture thereof).

157. Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841).

158. Designs Registration Act, 1839, 2 Vict., c. 17, § 1 (Eng.).

system of protection.[159] The British Design Registrations Act (1839) also served as Ruggles's source for the requirement of registration,[160] the duration (one to three years, depending on the subject matter),[161] the mandated range of damages,[162] and the exclusive right to use the design during its respective term of protection.[163] However, both acts notably required the design to be "new and original"[164]—a requirement that can be traced to embryonic British design protection from 1787.[165]

Thus, the earliest American design protection proposal was a direct descendant of British copyright and design registration law.[166] The one variation—and it is a

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159. *See* Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841) (providing the relevant language of the Ruggles bill).

160. Designs Registration Act, 1839, 2 Vict., c. 17, §§ 1, 8 (Eng.). The British had settled on a dual-component system because the British textile industry vehemently objected to a requirement for registration, claiming (among other things) that manufacturers were already printing identifying information on their textile products, rendering registration (and its associated costs) unnecessary. SHERMAN & BENTLY, *supra* note 62, at 67–69. Accordingly, the Copyright of Designs Act, applicable to textiles, called for no registration, in contrast to the Designs Registration Act. Apparently, American textile manufacturers made no similar plea to Ruggles.

161. Both the British legislation and Ruggles's proposal protected castings, models, chasings, and engravings made of metal or mixed metals for three years and all other designs for only one year. *Compare* Designs Registration Act, 1839, 2 Vict., c. 17, § 1 (Eng.), *with* Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841).

162. *Compare* Designs Registration Act, 1839, 2 Vict., c. 17, § 3 (Eng.) (guaranteeing £5.00 to £30.00 per offense), *with* Ruggles Design Bill, S. 269, 26th Cong. § 3 (1841) (guaranteeing $20 to $200 per offense and potentially including costs of suit).

163. *Compare* Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841) (granting "the sole and exclusive *copy-right* to use" (emphasis added)), *with* Designs Registration Act, 1839, 2 Vict., c. 17, § 1 (Eng.) (granting the "sole Right to use"). However, both Ruggles's bill and the British Designs Registration Act arguably granted broader protection than the corresponding British Calico Act for fabrics. *See* Calico Act, 1839, 2 Vict., c. 13, § 1 (Eng.) (limiting protection to the "sole Right and Liberty of printing and re-printing").

164. Unfortunately, their common origins shed little light on Ruggles's bill. Although the terms "new and original" can be found in numerous British copyright acts, similar to their U.S. development, they were often loosely interpreted synonymously. *See* LEWIS EDMUNDS, THE LAW OF COPYRIGHT IN DESIGNS 24 (1895) (noting that "[w]hether any distinction was intended to be made between these terms does not seem clear"); MICHAEL FYSH, RUSSELL-CLARKE ON COPYRIGHT IN INDUSTRIAL DESIGNS 36 (5th ed. 1974) (noting that even as of the 1970s, "[a]s to what distinction, if any, is to be drawn between the words new and original is doubtful"). Yet contrary to the United States, as these terms began to take on distinct meanings, contemporary British design acts were amended in a manner that reflected their pseudo-*copyright* origins—requiring the design to be new *or* original. Patents and Designs Act, 1907, 7 Edw. 7, c. 29, § 49 (Eng.) [hereinafter Patent and Designs Act]; *see also* EDMUNDS, *supra,* at 24 (pointing out that these terms should be construed without analogy to patents).

165. Calico Printers' Act, 1787, 27 Geo. 3, 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)). *See generally* HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 27-74 (1842) [hereinafter Ellsworth Report for 1841].

166. Ruggles may have been familiar with British copyright law as a result of his

crucial one—is that Ruggles's bill not only contemplated registration but also required that applications for protection be subjected to pre-grant examination, reminiscent of the procedures in place for American utility patents.[167]

The inclusion of an examination requirement was pure Ruggles. In his capacity as chair of the Senate's Select Committee on the affairs of the Patent Office,[168] Ruggles had championed the idea of establishing a system of pre-grant, substantive patent examination in the utility patent system. Under his guidance, the committee had produced the 1836 Patent Act,[169] still the most significant legislative reform in the history of the American patent system largely due to its implementation of pre-grant examination. It is no surprise that Ruggles, perhaps reflexively, would have included an examination requirement in his design protection proposal.

Moreover, in the 1836 Patent Act, Ruggles also laid the administrative foundation for a modern patent office that would carry out that pre-grant examination.[170] He was venerated, with considerable justification, as the "Father of the Patent Office."[171] He had worked closely on the 1836 Patent Act with Henry Ellsworth, the superintendent of the Patent Office who became the first Commissioner of Patents under the new administrative structure that the 1836 act provided,[172] and Charles Keller, the model room keeper who became the first examiner under the new act.[173] Indeed, Ruggles had been, and remained, intimately

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involvement in a debate over whether to extend U.S. copyright protection to British authors. *See* S. 32, 25th Cong. (1838) (extending U.S. copyright protection to residents of the United Kingdom, Ireland, and France upon print and publication in the U.S. simultaneously with its foreign issue, or within one month of its requisite deposit in any U.S. district court); S. REP. NO. 25-494, at 3–4 (1838) (report to accompany S. 32, recording Ruggles's views). In any event, few in Washington at the time could have claimed greater expertise with American intellectual property laws than Ruggles.

167. Ruggles Design Bill, S. 269, 26th Cong. §§ 1, 4 (1841).

168. CONG. GLOBE, 24th Cong., 1st Sess. 64 (1835). He was joined on the committee by Samuel Prentiss (Vermont) and Isaac Hill (New Hampshire). *Id.* The select committee was an ad hoc patent law reform committee formed at Ruggles's request. Ruggles had applied for a patent under the then-existing 1793 act and had become sufficiently frustrated over the act's delays and other deficiencies that he made a speech on the Senate floor calling for reform. *The Father of the Patent Office*, SCI. AM., May 9, 1891, at 295–96 (describing the speech based on Ruggles's notes).

169. Act of July 4, 1836, ch. 357, 5 Stat. 117 (1836).

170. *See generally* JOHN RUGGLES, REPORT WITH SENATE BILL NO. 239, S. REP. NO. 24-338 (1836) [hereinafter 1836 Patent Act Report]. Indeed, Ruggles similarly played a unique role laying the Patent Office's *physical* foundation after its destruction. *See* JOHN RUGGLES, REPORT WITH SENATE BILL NO. 107, S. REP. NO. 24-58 (1837).

171. *The Father of the Patent Office*, *supra* note 168, at 295.

172. We imagine that it is no coincidence that the first utility patent under the 1836 act regime was issued to Ruggles. Locomotive Steam-Engine for Rail and Other Roads, U.S. Patent No. 1 (issued July 13, 1836).

173. Charles Keller was appointed to the first examiner's role under the new act at the request of both Ellsworth and Ruggles and also served as the Patent Office's model room keeper. *See* Thaddeus Hyatt, *Charles M. Keller and the American Patent Office*, SCI. AM., May 21, 1859, at 310. While many commentators credit Ruggles and Ellsworth as the originators of the 1836 Patent Act, the two likely received a considerable amount of input from Keller. *Id.* Keller inherited the position from his father and had been advising patent applicants informally since Superintendent Pickett's administration. *Id.* Not only was

involved with the Patent Office.[174] When he left the Senate shortly after presenting Mott's petition and the proposed legislation, Ruggles was angling for an appointment as the next Commissioner of Patents.[175] The requirement for examination, which surely could best be carried out at the Patent Office, reflected Ruggles's past alliances and served his future aspirations.

Ruggles's proposed bill passed the Committee on Patents without amendment.[176] The committee's chairman and Ruggles's longtime colleague,[177] Senator Samuel Prentiss, reported it on March 3, 1841. Unfortunately for Ruggles, this was the last day of the congressional session. Likely a victim of its timing, the bill was tabled and ordered to be printed.[178] More importantly, because Ruggles had failed to win his reelection campaign two years earlier, this was also his last session in the Senate.[179]

Ellsworth's letter to the Secretary of State (John Forsyth) full of recommendations from Keller, but Ruggles also worked directly with Keller while drafting the bill. *See id.*; KENNETH W. DOBYNS, THE PATENT OFFICE PONY 99 (1997); Robert C. Post, *"Liberalizers" Versus "Scientific Men" in the Antebellum Patent Office*, 17 TECH. & CULTURE 24, 27 (1976); *see also* Letter from Henry Ellsworth, Superintendent of the Patent Office, to John Forsyth, Sec'y of State (Jan. 29, 1836) *reprinted in* 8 MECHANIC'S MAG. no. 4, Oct. 1836 at 175–82 (response to Senator Ruggles's questions from the select committee). Regardless of Keller or Ellsworth's impact on the act, Senator Ruggles is universally recognized as its tireless political sponsor.

174. Ruggles was even credited with being the first person on the scene attempting to save the Patent Office building when it caught fire in 1836. JOHN RUGGLES, REPORT WITH SENATE BILL NO. 107, S. REP. NO. 24-58 (1837) (providing a very detailed account of the destruction at the Patent Office); DOBYNS, *supra* note 173, at 107. If anything, Ruggles's involvement with the Patent Office may have been a bit too intimate. *See* HUGH L. WHITE, SENATE SELECT COMMITTEE REPORT, S. REP. NO. 25-377 (1838) (investigating whether Ruggles used undue influence to procure a reissued patent, explaining that Ruggles frequented the Patent Office and had close connections with Charles Keller, and hinting that he may have occasionally accessed the office's secret archives where caveats were held).

175. Letter from John Ruggles, U.S. Senator, to Daniel Webster, U.S. Sec'y of State (Apr. 24, 1841) (on file with Robert D. Farber University Archives & Special Collections Department, Brandeis University) (containing Ruggles's rather lavish recitation of his qualifications for the position, including, among other things, that "[i]n reconstructing a code of [American] patent law, I introduced new principles of acknowledged usefulness & importance; which have since been adopted in England"). We are indebted to Sarah Shoemaker, special collections librarian at Brandeis University, and Maribel Nash, reference librarian at the Pritzker Legal Research Center at Northwestern School of Law, for helping us unearth the letter. Ruggles procured several letters of recommendation and no doubt was surprised when the position went to Henry Ellsworth instead. *Id.* (containing the letters of recommendation).

176. CONG. GLOBE, 26th Cong., 2d Sess. 226 (1841).

177. Senator John Ruggles and Senator Samuel Prentiss served together intermittently since the first select committee was formed in 1835 to reform the existing patent registration system. *See, e.g.*, CONG. GLOBE, 25th Cong., 1st Sess. 16 (1837); CONG. GLOBE, 24th Cong., 1st Sess. 64 (1835).

178. CONG. GLOBE, 26th Cong., 2d Sess. 226 (1841) (noting that Ruggles's bill "was laid on the table and ordered to be printed").

179. Ruggles's departure from the Jacksonian Democrats likely played a key role in his failed reelection bid. *See Maine Senator*, THE PITTSFIELD SUN, Feb. 4, 1841, at 3 (citing

B. 1842 Ellsworth Report and Proposed Legislation: The Emergence of Quasi-Patent Concepts

Mott's lobbying efforts, however, continued into 1842. His petition was presented again in the Senate in March 1842,[180] and Ruggles's former colleague Senator Prentiss introduced legislation in April 1842.[181] The 1842 legislation, however, still bore indications of Ruggles's original conception of a design copyright regime with substantive pre-grant examination. Yet, it also had become infused with more patent law rhetoric, undoubtedly as a result of suggestions made by the man who had been granted the appointment that Ruggles so assiduously sought—Patent Commissioner Henry Ellsworth.

In his annual Commissioner's Report to Congress for the year 1841,[182] published and referred to the Senate Committee on Patent and the Patent Office on March 8, 1842,[183] Ellsworth included three paragraphs recommending the protection "of new and original designs for articles of manufacture, both in the fine and useful arts."[184] After pointing out that other nations had granted such protection,[185] Ellsworth reiterated the rationale for protection that had been offered in Mott's petition:

BOSTON POST). While Ruggles was elected to the senate as a Jacksonian Democrat, he split ways with his party on several key issues. *See* LOUIS CLINTON HATCH, MAINE: A HISTORY (1919) 218 (noting that "[h]e served but one term as Senator, broke from his party on the sub-treasury question, and was retired from political life"); David J. Russo, *The Major Political Issues of the Jacksonian Period and the Development of Party Loyalty in Congress, 1830-1840*, 62 TRANSACTIONS AM. PHIL. SOC'Y, no. 5, at 3, 18, 41, 46 (1972) (describing Ruggles as a renegade Democrat and noting his departure from the party on the issues of slavery and the sub-treasury). By 1840, both Whigs and Conservatives were claiming Ruggles as a loyalist. *See* A POLITICAL REGISTER FOR 1840 4 (1840) (Whig); *United States Senator*, CHRISTIAN SECRETARY, Aug. 21, 1840, at 2 (Conservative); *Harrison or Whigs*, NEW WORLD, Jan. 23, 1841, at 61 (Harrison or Whigs); *Senator Ruggles*, JEFFERSONIAN REPUBLICAN, May 16, 1840, at 2 (noting that Ruggles "now goes for [Whig President] Harrison and reform"). In the end, however, it appears that he ultimately sided with the Conservatives and might have earned the moniker "Benedict Arnold" in return. *Maine Senator*, *supra*, at 3 (stating, "Ruggles must know that the English never respected or trusted Arnold much, after his treason, and now, in their retirement, they may have leisure to make some reflections upon that fact").

180. CONG. GLOBE, 27th Cong., 2d Sess. 272 (1842) (petition presented in March 1842 by Senator Daniel Sturgeon (Pennsylvania) from the Committee on Patents).

181. S. 220, 27th Cong. (1842).

182. Ellsworth Report for 1841, H.R. DOC. NO. 27-74 (1842). Hudson claims that the report is dated February 8, 1841, Hudson, *supra* note 58, at 380, but this appears to be an error—Ellsworth's annual report covered Patent Office operations in 1841 and therefore would not have been circulated until sometime in 1842. *See* Ellsworth Report for 1841, S. REP. NO. 27-169, at 1 (dated January 1842 by Ellsworth, referred for printing on February 7, 1842, and later referred to the Patent Committee on March 8, 1842).

183. *See* Ellsworth Report for 1841, S. REP. NO. 27-169, at 1.

184. *Id.* at 2.

185. *Id.* (asserting that "[o]ther nations have granted this privilege, and it has afforded mutual satisfaction alike to the public and to individual applicants").

> Competition among manufacturers for the latest patterns prompts to the highest effort to secure improvements, and calls out the inventive genius of our citizens. Such patterns are immediately pirated, at home and abroad. A patent [sic, pattern] introduced at Lowell,[186] for instance, with however great labor or cost, may be taken to England in 12 or 14 days, and copied and returned in 20 days more.[187]

To address this situation, Ellsworth asserted, legal protection should be extended to "new and original designs for a manufacture of metal or other material, or any new and useful design for the printing of woollen, silk, cotton, or other fabric,"[188] an adaptation of Ruggles's and Mott's language and a nod to the lobbying influence of the iron and textile industries. Ellsworth also suggested that protection be available for "a bust, statue, or bas-relief, or composition in alto or basso-relievo."[189] But this was not language from Ruggles's proposal, it was copyright language—specifically, language from British copyright law.[190]

However, the copyright language notwithstanding, Patent Commissioner Ellsworth made clear that he was not styling his proposal as a copyright proposal. Instead, he posited that the proposed protection "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."[191] The patent term could be seven years (half of the fourteen-year duration for utility patents),[192] and the application fee correspondingly could be half that charged for utility patent applications.[193]

From a modern vantage point, Ellsworth's allusion to patents may seem to be a dramatic shift away from Ruggles's copyright proposal. However, differences between the substantive rules in the respective regimes were slight at the time of Ellsworth's report. Even the respective terms of patent and copyright had been comparable until only a few years prior.[194]

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186. *See generally* RIVARD, *supra* note 104, at 59–65 (discussing the importance of Lowell, MA, to the textile industry).

187. Ellsworth Report for 1841, H.R. DOC. NO. 27-74, at 2.

188. *Id.*

189. *Id.*

190. An Act for Encouraging the Art of Making New Models and Casts of Busts, 1798, 38 Geo. 3, c. 71, § 1 (Eng.) (protecting any "new Model, Copy, or Cast, or any such new Model, Copy or Cast in Alto or Basso Relievo" of human or animal figures). Analogous protection for three-dimensional objects in U.S. copyright law did not come into effect until 1870. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (specifically including "any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, *statue, statuary, and of models or designs intended to be perfected as works of the fine arts*" (emphasis added)).

191. Ellsworth Report for 1841, H.R. DOC. NO. 27-74, at 2.

192. *Contra* Act of July 4, 1836, ch. 357, § 18, 5 Stat. 117, 124–25 (1836) (extending protection for another seven years, beyond the initial fourteen years, where the patentee failed to obtain reasonable remuneration through no fault of their own).

193. Ellsworth Report for 1841, H.R. DOC. NO. 27-74, at 2.

194. Until 1831, both initial terms were fourteen years; however, by renewal authors could double their copyright term. *Compare* Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124,

Moreover, other evidence suggests that Ellsworth's nonchalant reference to patents was motivated more by pragmatic political considerations than any perception that patent rules were preferable to copyright rules for protecting designs.[195] Under Ellsworth's proposal, fees of fifteen dollars for design protection would be paid into the Patent Office.[196] By contrast, antebellum copyright protection involved a mere fifty-cent fee, payable to the federal court in the district where the applicant resided and collected when the author deposited a copy of the work with the court before publication, prepublication deposit being a prerequisite of copyright protection at the time.[197]

Against the backdrop of a recessionary economy,[198] not to mention construction costs for a newly completed Patent Office building that ran four times higher than its appropriation,[199] a new revenue stream for the Patent Office would have been especially attractive. The *Congressional Globe*'s notation regarding floor commentary on the proposed legislation highlights the bill's revenue effects, reporting that the bill's sponsor (Kerr) "explained, at great length, that the bill was intended to apply the rights of patents to new objects, and thereby bring additional revenue into the patent department, and to protect rights of patentees."[200] Indeed, Senator Kerr would have been especially attuned to these revenue issues—he had previously chaired the Committee on Public Buildings,[201] which had oversight responsibility for the Patent Office rebuilding project and, as current chairman of

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124 (1790), *with* Patent Act of 1793, ch. 11, § 1, 1 Stat. 318, 318–21 (1793).

195. Likewise, pragmatic considerations apparently motivated design protection proponents in Britain to *avoid* placing British design protection under the auspices of the patent system. The bureaucracy of the British patent system was notoriously byzantine, and it was considered undesirable to subject design protection to those idiosyncrasies. SHERMAN & BENTLY, *supra* note 62, at 81–83.

196. Ellsworth's proposal suggested charging "*one half* of the present fee charged to citizens and foreigners, respectively." Ellsworth Report for 1841, H.R. DOC. NO. 27-74, at 2 (emphasis in original). Per contemporary utility patent fees (minimum $30), a granted design patent cost American citizens $15. *See* U.S. PATENT OFFICE, INFORMATION TO PERSONS HAVING BUSINESS TO TRANSACT AT THE PATENT OFFICE 7 (1836), *reprinted in* RULES OF PRACTICE: U.S. PATENT OFFICE (1899) (compilation held by Cornell University Library). Because of the 1836 Patent Act's discriminatory pricing, it would have been much more expensive for foreigners—$500 for the British and $300 for everybody else. *Id.*

197. *See* Act of Feb. 3, 1831, ch. 16, § 4, 4 Stat. 436, 437.

198. *See supra* Part II.

199. SCIENTIFIC AMERICAN REFERENCE BOOK 247 (Albert A. Hopkins & A. Russell Bond eds., 1905) (noting that Congress had appropriated about $100,000 for the construction in 1836 and that the building, completed in 1840, had cost over $400,000); *see also* S. 296, 24th Cong. (1836) (pertinent legislation proposed by John Ruggles).

200. CONG. GLOBE, 27th Cong., 2d Sess., at 833 (1842) (remarks of Senator Kerr). *See infra* note 226 (explaining Kerr's involvement). Of course, Ellsworth might have been able to achieve these revenue goals irrespective of the form of protection he proposed by providing that fees would be paid to the Patent Office even if the protection were more akin to copyright. For example, Ruggles's proposal would have given the Patent Office authority over the proposed design copyright system, and applicants would have paid $10 in application fees. Ruggles Design Bill, S. 269, 26th Cong. § 6 (1841).

201. CONG. GLOBE, 27th Cong., 2d Sess. 15 (1842).

the Patent Committee,[202] he had just two days prior to this commentary reported a bill proposing to expand the new Patent Office building.[203]

In addition, it is no surprise that Ellsworth, as Commissioner of Patents, would make a proposal to expand his own department's jurisdiction nor that he would do so in the context of his annual report.[204] And Ellsworth would have reasonably expected enormous deference from Congress.[205] The Senate committee on patents frequently solicited Ellsworth's recommendations[206] and frequently acted on them. The two pieces of patent legislation that passed between 1836 (when Ellsworth became Commissioner) and 1845 (when Ellsworth left the post) can be traced to recommendations he made in his annual reports.[207] These reports had a wide audience around the country, albeit probably for the agricultural statistics included in the report rather than the patent policy matters.[208]

One commentator, Thomas B. Hudson, has offered additional reasons purporting to explain why design protection was effectuated by patent rather than

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202. S. Journal, 27th Cong., 2d Sess. 399 (1842).

203. S. 290, 27th Cong. § 1 (1842); S. Journal, 27th Cong., 2d Sess. 524 (1842).

204. By 1839, Ellsworth had already successfully lobbied for the expansion of the Commissioner's evidentiary powers and pushed the Patent Office into the business of collecting agricultural statistics. Act of Mar. 3, 1839, ch. 88, §§ 9, 12, 5 Stat. 353, 354–55. Before leaving the Commissioner's role in 1845, Ellsworth even managed to help Samuel Morse obtain a large appropriation for further experimentation on the telegraph. HARRY KURSH, INSIDE THE U.S. PATENT OFFICE 26 (1959).

205. Ellsworth came from a family of great prominence in early American society. His father had been a Chief Justice of the U.S. Supreme Court, and his twin brother was a formidable judge and politician. *See* William I. Wyman, *Henry L. Ellsworth, The First Commissioner of Patents*, 1 J. PAT. OFF. SOC'Y 524, 524 (1919). But Ellsworth did not simply rest on his family's reputation. By the time that President Jackson made him Commissioner at the age of forty-five, he had already been a mayor in Connecticut (Hartford), run a large insurance company (Aetna), and even helped Jackson as one of his chief commissioners of Indian Affairs (overseeing the vast displacement of Native Americans in what many historians refer to as the "Trail of Tears"). *See* KURSH, *supra* note 204, at 26.

206. *See, e.g.*, Letter from Henry Ellsworth, U.S. Comm'r of Patents, to John Ruggles, U.S. Senator (Feb. 23, 1838), *reprinted in* H.R. REP. NO. 25-797, at 3–5 (1838) (responding to Ruggles's inquiry into whether further legislation was necessary for business at the Patent Office).

207. The design patent legislation was part of a larger 1842 Patent Act, and in that bill, five of the six sections were proposed in Ellsworth's report. *Compare* HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 27-74, at 2 (1842), *with* Act of Aug. 29, 1842, ch. 263, §§ 1, 3–6, 5 Stat. 543, 543–45. Likewise, eleven of the thirteen sections of the 1839 act derive from one of Ellsworth's annual reports. *Compare* Act of Mar. 3, 1839, ch. 88, 5 Stat. 353, *with* HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 25-80, at 2–4 (1839), *and* HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, S. DOC. NO. 25-105, at 2–6 (1838).

208. RICHARD R. JOHN, NETWORK NATION: INVENTING AMERICAN TELECOMMUNICATIONS 47 (2010) (arguing that the agricultural statistics ultimately drove the popularity of Ellsworth's annual reports); *The Commissioner of Patents,* OHIO CULTIVATOR, May 1, 1845, at 9 (lauding the importance of Ellsworth's annual reports and noting that it "makes a volume of greater interest than any other volume published periodically, in this country").

copyright, but these, too, strike us as unpersuasive. Hudson postulated that manufactured articles were closer to the subject matter of patents than the "intellectual products" of copyright law (e.g., books, maps, etc.).[209] But this explanation is incomplete; Ellsworth's proposal (and the design patent legislation as ultimately enacted) covered works of fine art (statues, for example), in addition to traditionally manufactured goods.[210] Hudson also speculates that the copyright system lacked a central depository at the time, unlike the patent system.[211] However, design legislation could have provided for a centralized depository at the Patent Office even if design protection took on the form of copyright protection. Indeed, the Patent Office had long been used as a repository of various copyrighted works during its tenure,[212] and this is essentially what Ruggles's proposal had done.[213]

In sum, the proposals that ultimately resulted in the first American design patent statute veered from a quasi-copyright proposal to a patent proposal for extrinsic reasons. Our research uncovered no evidence of any debate over the wisdom of the core idea that substantive utility patent law rules should govern a new design protection regime and no indication that drafters of the design patent statute were sufficiently prescient to foresee that copyright and utility patent jurisprudence would evolve along divergent paths in the decades to come.

Our historical analysis also demonstrates that claims that the design patent system originated as an historical accident are misleading. Design protection legislation came about in large part because Jordan Mott persisted in his lobbying efforts. And Ellsworth's adept maneuvering of the design protection scheme onto the Patent Office's turf was no accident.

On the other hand, the final chapter in the legislative odyssey of the 1842 design patent provisions does provide some support for the historical accident thesis. The design patent provisions passed during a political firestorm. The political forces that appear to have converged to make the design patent provisions a reality were transient and anomalous. We analyze these peculiar political circumstances below.

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209. Hudson, *supra* note 58, at 383.

210. Ellsworth Report for 1841, H.R. DOC. NO. 27-74 (1842), at 2.

211. Hudson, *supra* note 58, at 383.

212. Pamphlet from William Thornton, U.S. Superintendent of the Patent Office (Mar. 5, 1811), *reprinted in* AM. FARMER, Jan. 27, 1826, at 357–58 (explaining the process of acquiring a patent or copyright and noting that specimens of copyrighted works, like paper hangings and ornaments for rooms, could be deposited directly with the Patent Office or the Secretary of State in order to fulfill the deposit requirement). *See generally* 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); John Y. Cole, *Ainsworth Spofford and the Copyright Law of 1870*, *in* A CENTURY OF COPYRIGHT IN THE LIBRARY OF CONGRESS 3 (1970) (noting that storing the copies of these works was a point of frustration for numerous patent commissioners, since space was such a premium at the Patent Office).

213. *See supra* Part III.A.

C. Passage of the 1842 Act: Design Patent Protection and the Protectionist Surge

The Twenty-Seventh Congress received Commissioner Henry Ellsworth's report recommending design patent protection in March, and in April 1842 Senator Samuel Prentiss, a Whig from Vermont, introduced legislation.[214] It had no chance of progressing through the legislative process for a simple reason: the Twenty-Seventh Congress was utterly in deadlock.

The crisis in Congress in the spring of 1842 had its roots in a long-running feud between the Jacksonian Democrats and their emergent rivals, the American Whigs. Just over a year earlier, the Whig Party had gained a majority of seats in Congress and had finally captured the White House. The Whigs had won on a platform favoring aggressive protectionist tariffs,[215] arguing successfully that the free trade policies of the Jacksonian Democrats had triggered the Panic of 1837, a severe economic recession whose effects extended into the 1840s.[216] In early 1841, it appeared certain that the Whig legislative agenda, including the tariff legislation, would swiftly be enacted.[217]

Then, after only a month in office, President William Henry Harrison died. His successor, John Tyler of Virginia, was nominally a Whig but refused to cooperate

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214. S. 220, 27th Cong. (1842). We do not mean to suggest that the design patent system was purely the product of Whig partisanship. For example, both Ruggles and Ellsworth were (at one point) Jacksonian Democrats. FRANKLIN BOWDITCH DEXTER, 6 BIOGRAPHICAL SKETCHES OF THE GRADUATES OF YALE COLLEGE WITH ANNALS OF THE COLLEGE HISTORY 309–12 (1912) (offering brief biographical information); *supra* note 179.

215. The Whigs had been arguing for many years that "free trade was always linked with depression, while protection brought prosperity." Samuel Rezneck, *The Social History of an American Depression 1837–1843*, 40 AM. HIST. REV. 662, 670 (1935). Nevertheless, the Jacksonians maintained a policy of trade liberalization during their time in power, including much of the 1830s. Scott C. James & David A. Lake, *The Second Face of Hegemony: Britain's Repeal of the Corn Laws and the American Walker Tariff of 1846*, 43 INT'L ORG. 1, 9 (1989) (identifying four periods of antebellum tariff policy: increased protectionism from 1824–33; trade liberalization from 1833–42; a "brief but decided return to protection" from 1842–46; and the "political triumph of free trade principles" from 1846–61).

216. For background on the recession, see, e.g., Edward J. Balleisen, *Vulture Capitalism in Antebellum America: The 1841 Federal Bankruptcy Act and the Exploitation of Financial Distress*, 70 BUS. HIST. REV. 473, 479 (1996) (referring to two discrete economic downturns during this period, the Panic of 1837 and the Panic of 1839); PETER TEMIN, THE JACKSONIAN ECONOMY 148–55 (1969) (analyzing the causes of both crises). The Whigs succeeded—albeit temporarily—in blaming the recession in part on Jacksonian banking policies, which were unpopular in the West, and on British trade practices, which had caused cotton prices to plummet and had generated resentment in the South. *See* Rezneck, *supra* note 215, at 669; *The Protective Policy*, S. LITERARY MESSENGER, Apr. 1842, at 4 (offering an Anglophobic polemic for high tariffs). Whatever the cause, the consequences were severe: banks failed and early stock markets crashed, Peter L. Rousseau, *Jacksonian Monetary Policy, Specie Flows, and the Panic of 1837*, 62 J. ECON. HIST. 457, 457 (2002), and the U.S. Treasury was nearly bankrupted. 1 JERRY W. MARKHAM, A FINANCIAL HISTORY OF THE UNITED STATES 150 (2002).

217. MICHAEL F. HOLT, THE RISE AND FALL OF THE AMERICAN WHIG PARTY 69, 121 (1999).

with Whig legislative initiatives,[218] particularly the tariffs, which had long been unpopular in the South.[219] Incensed, the Whig congressional leadership dismissed Tyler from the party and settled in for a monumental power struggle with the administration, "contemptuously" dismissing Tyler's legislative proposals and bringing Washington to the verge of paralysis.[220]

For a time, Tyler refused to capitulate. The Whigs passed a legislative package that included tariff legislation; Tyler immediately vetoed it.[221] However, Tyler's position was unsustainable. The tariffs were a major source of federal government revenue, and the tariff deadlock had the potential to shut down the government.[222] Meanwhile, sectional differences were threatening to unravel the Whigs' fragile political coalition, and there were already signs that the electorate was growing impatient with Whig promises to pull the nation out of the recession.[223]

By August 1842, the sheer enormity of the threat to the government's fiscal stability convinced Tyler that he had no choice but to support a tariff program. For their part, the Whigs began to split up their legislative package, uncoupling the tariff proposal from another controversial proposal relating to the distribution of land revenues. While the disappearance of the land bill caused southern Whigs to withdraw support, the Whig tariff was sufficiently popular in depressed northern manufacturing areas that the Whigs were able to cobble together a flimsy coalition with some northern Democrats (for example, Pennsylvania Democrats whose constituents operated iron foundries, among others). On August 30, 1842, Congress passed the Whig tariff legislation, characterized by one historian as the Whigs' sole legislative triumph of the session.[224]

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218. For a concise recitation of events leading to Tyler's rupture with Clay and the Whig program, see SEAN WILENTZ, THE RISE OF AMERICAN DEMOCRACY 523–29 (2005).

219. Jacksonian Democrats had traditionally resisted high tariff rates on the ground that the tariffs harmed southern agrarian interests. Southern resistance to proposed tariffs in the early 1830s had precipitated the Nullification Crisis, in which South Carolina threatened to secede if the tariffs were not adjusted. *See* Adrienne Caughfield, *Tariff of 1828 (Tariff of Abominations)*, *in* 1 ENCYCLOPEDIA OF TARIFFS AND TRADE IN U.S. HISTORY 363, 363–64 (Cynthia Clark Northrup & Elaine C. Prange Turney eds., 2003); Robert Tinkler, *Tariff of 1832*, *in* 1 ENCYCLOPEDIA OF TARIFFS AND TRADE IN U.S. HISTORY, *supra*, at 365; *see also* Douglas A. Irwin, *Antebellum Tariff Politics: Regional Coalitions and Shifting Regional Interests*, 51 J.L. & ECON. 715, 730 (2008) (discussing the impact of the Tariff of 1832 on the South). The 1833 Compromise Tariff Act provided a tariff regime that was only slightly more favorable to the South. *See* TAUSSIG, *supra* note 79, at 110. For a concise discussion of the Nullification Crisis, see DANIEL WALKER HOWE, WHAT HATH GOD WROUGHT 395–410 (2007).

220. HOLT, *supra* note 217, at 137, 140.

221. *Id.* at 147.

222. *See id.* at 146–47. Adding further to the urgency of the situation, tariff reductions promulgated several years earlier during the Jackson administration were scheduled to come into effect in 1842. *Id.*

223. *Id.* at 140. Indeed, the Whigs fared so badly in state elections in the fall of 1841 that by December 1841, prominent Senator John Calhoun (South Carolina) chortled that "I now regard the Whigs as destroyed." *Id.*

224. *See id.* at 148.

In fact, there had been one other. The design patent legislation had lain dormant through the summer,[225] but Mott's petition returned to the Senate again in early August,[226] courtesy of Prentiss's replacement as chair of the Patent Committee, Whig Senator John L. Kerr from Maryland.[227] Senator Kerr also moved for the Senate to take up the Prentiss bill for consideration.[228] After two days of debate,[229] the Senate passed the bill and reported it to the House,[230] where it passed without discussion[231] the day before the passage of the tariff bill.

Although the historical evidence is largely circumstantial, we think it likely that, but for the momentum of the great tariff debate, the design patent legislation would have been shunted aside, another casualty of the partisan stalemate. It was the tariff debate that brought together northern industrial interests, and these happened to be the very same constituencies that stood to benefit most immediately from design patent legislation.[232] Senator Kerr, who had moved the Senate to consider Prentiss's design bill on August 3, 1842,[233] had also presented a petition a few months earlier from numerous manufacturers seeking increased iron tariffs.[234]

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225. In addition to the obstacles that resulted from the Whigs' fight with the Tyler administration, Senator Prentiss had resigned from the Senate a few days after introducing the design patent legislation in the spring. *See* CHARLES J.F. BINNEY, MEMOIRS OF JUDGE SAMUEL PRENTISS OF MONTPELIER, VT., AND HIS WIFE LUCRETIA (HOUGHTON) PRENTISS 12 (1883), *available at* http://archive.org/details/memoirsofjudgesa00binn.

226. CONG. GLOBE, 27th Cong., 2d Sess. 826 (1842) (petition presented in August 1842). Kerr's reintroduction of the petition was likely done for symbolic reasons (since it had been five months since Sturgeon's presentation to the same congressional session and he would ask Congress to take up consideration of Prentiss's bill the following day) or because of changes in the Senate's petition rules that also took place during this session. *See* Daniel Wirls, *"The Only Mode of Avoiding Everlasting Debate": The Overlooked Senate Gag Rule for Antislavery Petitions*, 27 J. EARLY REPUBLIC 115, 128–29 (2007) (discussing the Senate's evolving gag rules during this era that were intended to deal with the onslaught of antislavery petitions during this time). *See generally* Stephen A. Higginson, *A Short History of the Right to Petition Government for the Redress of Grievances*, 96 YALE L.J. 142, 156–58 (1986) (discussing the typical Congressional reception and consideration of petitions via committees during this gag rule era).

227. After Samuel Prentiss's abrupt retirement from the Senate, Kerr was appointed chair of the Senate's Patent Committee in June 1842. S. JOURNAL, 27th Cong., 2d Sess. 399 (1842).

228. CONG. GLOBE, 27th Cong., 2d Sess. 832–33 (1842).

229. Our research suggests that a provision imposing a citizenship requirement, and another relating to renewals for utility patents, were the only provisions debated. *See infra* note 243–44.

230. *See* CONG. GLOBE, 27th Cong., 2d Sess. 911–12 (1842).

231. *Id.* at 960.

232. The sentiment for protectionism dissipated almost as quickly as it arose. By 1844, the Democrats regained the White House, and President Polk immediately attacked the Whig tariff regime. *See* Robert P. Sutton, *Tariff of 1846 (Walker's Tariff)*, *in* 1 ENCYCLOPEDIA OF TARIFFS AND TRADE IN U.S. HISTORY, *supra* note 219, at 368–69; *see also* ROBERT W. MERRY, A COUNTRY OF VAST DESIGNS 205–07 (2009) (recounting Polk's first annual message to Congress).

233. CONG. GLOBE, 27th Cong., 2d Sess. 832–33 (1842). Prentiss had resigned from the Senate a few days after introducing the design legislation. Senator Kerr had been appointed

The political circumstances also suggest that it would have been expedient to characterize the design patent legislation itself as a protectionist measure.[235] There was some precedent for this characterization in existing elements of antebellum American intellectual property law.[236] For example, U.S. copyright protection at the time extended only to authors who were U.S. citizens,[237] and the 1790 Copyright Act expressly stated that the copying of foreign works was not forbidden.[238] The patent system likewise had included some discriminatory provisions—citizenship restrictions between 1793 and 1836[239] and discriminatory fees,[240] working requirements,[241] and prior art provisions afterwards.[242]

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chair of the Senate's patent committee on June 15, 1842. S. JOURNAL, 27th Cong., 2d Sess. 399 (1842).

234. CONG. GLOBE, 27th Cong., 2d Sess. 381 (1842) (presenting a "memorial from citizens of Maryland, asking that the tariff of duties on imported iron might be restored to what it was in 1839, with a view to protection: [which was] referred to the Committee on Manufactures" on April 1, 1842).

235. We use the term "protectionism" here in its nineteenth century sense: advocates of "protectionism" sought to use domestic legal regimes, including domestic intellectual property laws, to insulate domestic producers from foreign competition, while "free trade" adherents tended to lash out at the propagation and expansion of intellectual property regimes. Mark D. Janis, *Patent Abolitionism*, 17 BERKELEY TECH. L.J. 899, 941–48 (2002) (citing free trade principles as the main ideological influence underlying a movement in England in the 1860s to abolish patent protection). The modern dialectic of intellectual property and protectionism is just the opposite: countries that recognize and enforce intellectual property rights regimes at or above TRIPS-mandated minimums are frequently said to be acting in accord with free trade principles, while countries that derogate from those minimums engage in "protectionism." *See, e.g.*, Yiqiang Li, *Evaluation of the Sino-American Intellectual Property Agreements: A Judicial Approach to Solving the Local Protectionism Problem*, 10 COLUM. J. ASIAN L. 391 (1996) (using "protectionism" to describe the refusal of local Chinese government authorities to enforce intellectual property rights); *see also* Rochelle Cooper Dreyfuss & Andreas F. Lowenfeld, *Two Achievements of the Uruguay Round: Putting TRIPS and Dispute Settlement Together*, 37 VA. J. INT'L L. 275, 280 (1997) (noting that the GATT agreement generally disfavors "protectionism" but that GATT-TRIPS promotes intellectual property protection that itself may be deemed "protectionist," and concluding that even the modern vocabularies of intellectual property and international trade "sit in uneasy contrast").

236. There were also arguably some British precursors. For a suggestion that protectionist trade policy and intellectual property rights were intertwined in an earlier era in English law, see Thomas B. Nachbar, *Monopoly, Mercantilism, and the Politics of Regulation*, 91 VA. L. REV. 1313 (2005).

237. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (limiting copyright protection to U.S. citizens and residents); *id.* § 6 (limiting copyright infringement actions to those brought by U.S. citizens or residents). Congress eliminated the citizenship restriction in 1891, but imposed requirements for publication and manufacture in the United States. *See* Act of Mar. 3, 1891, ch. 565, 26 Stat. 1106.

238. Act of May 31, 1790, ch. 15, § 5, 1 Stat. at 125 (specifying that "nothing in this act shall be construed to extend to prohibit the importation or vending, reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a citizen of the United States"). *See generally* B. ZORINA KHAN, THE DEMOCRATIZATION OF INVENTION 261 (2005) (discussing the provision).

239. Patent Act of 1793, ch. 11, § 1, 1 Stat. 318, 318–21; *cf.* Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 [hereinafter Patent Act of 1836] ("any person or persons").

If design protection legislation was to be sold as a protectionist measure, what mattered was whether the legislation privileged American firms over foreign firms—and it did. Consistent with protectionist ambitions, the Senate amended the pending 1842 design patent legislation in order to limit design patent protection to citizens or aliens who resided in the United States and intended to become citizens.[243] In fact, the only amendment recorded in the *Congressional Globe* that we can tie directly to the design patent provisions involved the suggestion to restrict design patent protection to citizens.[244]

Viewed in its proper political context, Congress's decision to enact design patent legislation can be understood as an exercise implementing the Whig protectionist agenda, not a mere accident or a mere passive congressional response to Commissioner Ellsworth's proposal to incorporate utility patent rules. The citizenship provision was likely far more important to the ultimate passage of the legislation than the suggestion to incorporate patent law rules.[245]

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240. *See* Patent Act of 1836, § 9, 5 Stat. at 121 (imposing a $30 application fee for U.S. citizens, a $300 fee for most foreigners, and a $500 fee for British applicants).

241. *Id.* § 15 (allowing a defense against infringement in cases where the patentee was a foreigner and had "failed and neglected for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued").

242. *Compare id.* § 7, *with* Patent Act of 1793, § 1, 1 Stat. at 318–21, *and* Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, 109–10. *See generally* Margo A. Bagley, *Patently Unconstitutional: The Geographic Limitation on Prior Art in a Small World*, 87 MINN. L. REV. 679, 684, 696–700, (tracing the limitation's legislative history).

243. Predecessor proposals lacked a citizenship restriction. *Compare* S. 220, 27th Cong. § 3 (1842) ("person or persons"), *with* Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44 ("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").

244. CONG. GLOBE, 27th Cong., 2d Sess. 840 (1842) (recording that Senator Wright—presumably Silas J. Wright, a Van Buren Democrat from New York—suggested the citizenship restriction, and that Senator Huntington—apparently Jabez W. Huntington, a Whig from Connecticut—commented on the suggested amendment). The legislative package also included some utility patent provisions, and the relatively brief debate as recorded in the *Congressional Globe* appears to contain some erroneous references to bill section numbers, so it requires some careful reconstruction to determine whether certain aspects of the debate related to the design patent proposal. *See id.* (referring to citizenship amendments in "2d section," which should read "3d section").

245. Indeed, in 1870, when Congress lifted the citizenship restriction, *Scientific American* characterized the amendment as a great victory for the "advocates of the free trade system." *The New Patent Laws—Important Changes Affecting American and Foreign Manufacturers—Free Trade in Patents Now Fully Established*, 23 SCI. AM. 87, 87 (1870) (referring to Act of July 8, 1870, ch. 230, § 71, 16. Stat. 198, 209–10). During the subsequent (Forty-Second) Congress, the Senate even passed a bill that would have again restricted design patents to citizens. S. 583, 42d Cong. (1872) (reincorporating the citizenship restriction for design patents only). Describing the amendment, Senator Morrill (Vermont) bluntly stated, "The effect of this change is to allow Americans to copy any designs that are brought here from abroad, if they choose." CONG. GLOBE, 42d Cong., 2d Sess. 1036 (1872). The Senator also repeatedly referred to the design patent regime as copyright and even a design registration system while championing the bill. *See, e.g.*, *id.* at 817, 1036; *see also id.* at 1427 (recording Mr. Cox's attempt to refer the bill to the House's

IV. RETHINKING THE USE OF MODERN UTILITY PATENT RULES FOR DESIGN PATENTS

The American design patent system has had abundant time to establish itself since the era of Mott, Ellsworth, and Ruggles, but, as we have noted, it has never developed a clear identity. The cast-iron stove industry used the system heavily at the outset.[246] However, industry leaders quickly grew disenchanted with design patent protection and pressed for alternative forms of protection, ultimately without success.[247]

We do not prescribe the abolition of design patent protection, but we do advocate close scrutiny of its core assumption about the feasibility of incorporating utility patent rules. The starting point, then, should be the language in 35 U.S.C. § 171: the mandate that the "provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."[248] It is the modern statutory language responding to Ellsworth's rather cavalier pronouncement that the design patent system could be implemented "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."[249] This ostensibly lucid and often misunderstood provision has undergone very little change since its formulation in 1842.[250] As we discuss below, a comprehensive reevaluation of design patents' patent character might start with a reconsideration of design patent claiming practices and the concept of patentability of designs over the prior art. By retaining the incorporation clause as utility patent law diverged from copyright law, Congress has forced blind obedience to a principle that even Ellsworth might not have supported.

Committee on the Library—which handled copyright reform—and Congressman Myers's rejoinder that the bill did not refer to copyright and should be referred to the House's Committee on Patents). Although the House might have similarly supported the bill, the citizenship restriction was thrown into a much larger bill with several amendments that did not emerge from the House's Committee on Patents in time for regular order before the end of the session. *See* CONG. GLOBE, 42d Cong., 2d Sess. 4329–30 (1872); To amend an act entitled, "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," approved July eighth, eighteen hundred and seventy, H.R. 2857, 42d Cong. (1872) (line 105–07).

246. Indeed, the first reported design patent litigation involved stoves. Root v. Ball, 20 F. Cas. 1157 (D. Ohio 1846) (No. 12,035); *see also* Howell J. Harris, *"The Stove Trade Needs Change Continually": Designing the First Mass-Market Consumer Durable, c. 1830-1900* (working manuscript on file with authors).

247. We examine this debate in forthcoming work.

248. 35 U.S.C. § 171 (2006). This section is commonly referred to as an incorporation clause or more colloquially as a catchall.

249. *See* Du Mont, *supra* note 16, at 541 (citing HENRY L. ELLSWORTH, REPORT FROM THE COMMISSIONER OF PATENTS, H.R. DOC. NO. 74, at 2 (1842)).

250. Du Mont, *supra* note 16, at 541–43, 547–48, 564, 578–82, 587–88, 591, 596 (discussing this section's legislative history from the 1842 act through its modern embodiment and how it was used as the principal vehicle for justifying the application of the contemporary invention requirement and other utility patent standards).

A. Design Patent Claiming Practices

The patent claim shapes much of modern utility patent analysis.[251] Claim interpretation is the threshold step in all patentability and infringement analyses and has generated perhaps the most vibrant debates in contemporary patent law.[252] A synthesis of the canons of patent claim construction literally fills multiple volumes.[253] By virtue of the Section 171 incorporation clause, and cultural cross-fertilization between utility patent and design patent practices, each design patent includes a claim.[254] Accordingly, a mechanism exists for the deep inculcation of the utility patent claiming jurisprudence into design patent law.

Nonetheless, while design patent law is superficially indebted to utility patent law's claiming conventions, its commitment has been ad hoc. The concept of peripheral claiming has never quite penetrated design patent law. Design patent claims conventionally refer to the disclosure[255] (using language such as "as shown and described"[256]); that is, they resemble central claims as opposed to the peripheral claims of the present-day utility patent.[257] Since utility patent law has moved to peripheral claiming and design patent law seemingly has not, this raises a fundamental question about whether claim interpretation and infringement rules typically associated with peripheral claiming systems should carry over to the design patent regime.

Unfortunately, no coherent approach to this question has emerged from the case law. In *Gorham*, the Supreme Court adopted an infringement rule that is consistent with the notion of central claiming, in that it permitted infringement to be found when the claimed and accused designs were "substantially the same" as viewed from the perspective of the ordinary observer.[258] Over a period of decades, courts,

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251. *See* William Redin Woodworth, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 764 (1948).

252. *See, e.g.*, Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996); Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

253. *See, e.g.*, ANTHONY W. DELLER, PATENT CLAIMS (2d. ed. 1971); *see also* RIDSDALE ELLIS, PATENT CLAIMS (1949); ROBERT C. FABER, FABER ON MECHANICS OF PATENT CLAIM DRAFTING (6th ed. 2010).

254. 37 C.F.R. § 1.153(a) (2010).

255. Although design patents formerly included more detailed claims that resembled utility patents, advances in photography and the Supreme Court's decision in *Dobson v. Dornan*, 118 U.S. 10, 14 (1886) (emphasizing that a design patent's scope is best represented by its drawings), cemented a shift in design patent claiming towards the simple reference to the drawings that we see today.

256. 37 C.F.R. § 1.153(a) (requiring the claim to be "in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described"). For a modern example, the design patent covering Apple's iPad includes the following claim: "The ornamental design for a portable display device, as shown and described." Portable Display Device, U.S. Patent No. D-627,777, at [57] (filed Jan. 6, 2010).

257. Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. PA. L. REV. 1743, 1776 (2009); Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719, 796 (2009).

258. Gorham Co. v. White, 81 U.S. (14 Wall) 511, 528 (1871). There was no controversy over the substantial similarity formulation; the main issue was whether the ordinary observer

including the Federal Circuit, added a separate inquiry to the *Gorham* analysis,[259] requiring a showing that the accused design appropriated the "points of novelty" of the claimed design[260]—arguably bringing the design patent infringement analysis closer to the strict element-by-element analysis associated with literal infringement in peripheral claiming systems.[261] The Federal Circuit also held that the doctrine of equivalents—whose value is most evident in a peripheral claiming system—does apply to design patents,[262] although harmonizing it with the point of novelty test

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ordinary designer should be the putative viewer of the respective designs. *Id.* at 527.

259. *See* Egyptian Goddess, Inc. v. SWISA, Inc., 543 F.3d 665, 671 (Fed. Cir. 2008) (noting that the court had switched from treating the point of novelty inquiry conjunctively with *Gorham*, to treating it as a separate test). In support of the Federal Circuit's "conjunctive" approach, the *Egyptian Goddess* court cited *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1125 (Fed. Cir. 1993), and *Shelcore, Inc. v. Durham Indus., Inc.*, 745 F.2d 621, 628 n.16 (Fed. Cir. 1984). *Id.* For examples of its application as a separate test, the court cited *Lawman Armor Corp. v. Winner Int'l, LLC*, 437 F.3d 1383, 1384 (Fed. Cir. 2006), *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002), *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995), and *Unidynamics Corp. v. Automatic Prods. Int'l*, 157 F.3d 1311, 1323–24 (Fed. Cir. 1988). *Id.*

260. The point of novelty test required courts to identify the elements of the patented design that distinguished it from the prior art. *See* Lawman Armor Corp. v. Winner Int'l, LLC, No. CIV.A.02-4595, 2005 WL 354103, at *4–5 (E.D. Pa. Feb. 15, 2005) (identifying eight points of novelty from the prior art), *aff'd*, 437 F.3d 1383 (Fed. Cir. 2006). Infringement could only be found where the accused article included the protected design's point of novelty (or many points of novelty, as in *Lawman*). *See* Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984). It operated as a separate inquiry from *Gorham*'s substantial similarity test for infringement. *See Gorham*, 81 U.S. at 528. In tandem, these tests created an odd scenario where courts, on the one hand, viewed infringement as a generalist or ordinary observer when judging overall or substantial similarity, and on the other hand, then focused like an expert on its elements during a point of novelty analysis. *See* Winner Int'l Corp. v. Wolo Mfg. Corp., 905 F.2d 375, 376 (Fed. Cir. 1990) (asserting that "[t]o consider the overall appearance of a design without regard to prior art would eviscerate the purpose of the 'point of novelty' approach, which is to focus on those aspects of a design which render the design different from prior art designs"). For background on the Federal Circuit's pre-*Egyptian Goddess* approach to the point of novelty test, see Christopher V. Carani, *The New "*Extra-*Ordinary" Observer Test for Design Patent Infringement—On a Crash Course with the Supreme Court's Precedent in* Gorham v. White, 8 J. MARSHALL REV. INTELL. PROP. L. 354 (2009); Perry J. Saidman, *What Is the Point of the Point of Novelty Test for Design Patent Infringement?*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 401 (2008).

261. *See* Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 29–30 (1997). *But see* Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1372 (Fed. Cir. 2006) (holding that the district court did not err by factoring out the protected design's elements that it deemed functional, but that it committed a procedural error by discounting the design's functional elements in a manner that "convert[ed] the overall infringement test [(i.e., *Gorham*)] to an element-by-element comparison").

262. Minka Lighting, Inc. v. Craftmade Int'l, Inc., 93 Fed. App'x 214, 217 (Fed. Cir. 2004) (noting that *Gorham*'s "substantial similarity test by its nature subsumes a doctrine of equivalents analysis" (citing Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1190 (Fed. Cir. 1988) (recognizing that "it has long been recognized that the principles of equivalency are applicable under *Gorham*," but noting the inapplicability of *Graver Tank*'s function-way-

presented certain additional challenges.[263] However, more recently, the Federal Circuit ruled en banc in *Egyptian Goddess* that the *Gorham* analysis should govern design patent infringement, shorn of any point of novelty prong or as a separate test.[264] The court has not returned to the question of whether design patentees are entitled to invoke the doctrine of equivalents.

This vacillation between peripheral and central claiming orientations has not been confined to the law of infringement. In the wake of its *Egyptian Goddess* decision, the Federal Circuit revised its test for design patent anticipation, eliminating the point of novelty prong that it had added only a few years previously.[265] On the other hand, notwithstanding its newfound distaste for points of novelty, the Federal Circuit also quixotically reaffirmed[266] that it is proper to dissect a claimed design into its individual features—by vainly parsing the design's functional and ornamental elements—and to analyze them serially before applying *Gorham*'s test for infringement to the remaining ornamental elements,[267] a decision that perhaps is influenced by an orientation towards patent claiming and the tendency to conceive of claims as combinations of elements.[268]

The design patent system's awkward embrace of utility patent claiming concepts has also been evident in the Federal Circuit's approach to design patent claim construction. After a period during which the Federal Circuit routinely invoked

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result test to design patents))).

263. *See, e.g.*, *Sun Hill Indus.*, 48 F.3d at 1199 (refusing to apply the doctrine of equivalence where the point of novelty test had not been met).

264. *Egyptian Goddess*, 543 F.3d at 678 (abandoning the point of novelty test as an element of the infringement analysis).

265. Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir 2009) (concluding, in light of *Egyptian Goddess*, that the ordinary observer test was the sole test for anticipation); *id.* at 1239 (citing Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889) (invoking the axiom, "'[t]hat which infringes, if later, would anticipate, if earlier'")).

266. For pre-*Egyptian Goddess* Federal Circuit cases affirming *Richardson*'s approach, see, for example, OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed. Cir. 1997); Read Corp. v. Portec, Inc., 970 F.2d 816, 825–26 (Fed. Cir. 1992); *Lee*, 838 F.2d at 1188.

267. Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1294, 1295 (Fed. Cir. 2010) (noting that if the district court had not parsed out the design's ornamental aspects during claim construction that it would have erroneously given the patentee's "Stepclaw" design a claim scope that included "the utilitarian elements of his multi-function tool," but then attempting to reconcile this approach with *Amini*'s caution that "the deception that arises is a result of the similarities in the overall design [(*i.e.,* infringement)], not of similarities in ornamental features in isolation" (citing Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1371 (Fed. Cir. 2006)). While the elimination of the point of novelty test removed a substantial hurdle for design patentees, functionality's role in claim construction—as distinguished from a de jure functionality or validity inquiry—will likely emerge as the design patentee's new roadblock. *See* Brief of Amicus Curiae for Apple Inc. in Support of Plaintiff-Appellant's Petition for Rehearing En Banc, *Richardson*, 597 F.3d 1288 (No. 08-CV-1040); Brief of Amicus Curiae American Intellectual Property Law Association in Support of the Petition for Rehearing En Banc, *Richardson*, 597 F.3d 1288 (No. 08-CV-1040).

268. *Cf. Int'l Seaway Trading Corp.*, 589 F.3d at 1244–45 (Clevenger, J., dissenting in part) (noting how the majority's piecemeal application of the anticipation doctrine improperly focuses the fact finder on the design's individual elements, as opposed to its mandated comparison as a whole).

claim interpretation as a threshold analysis in design patent cases,[269] the court came to recognize the difficulties associated with calling for judges to translate design patent drawings into words as part of a claim construction exercise.[270] In *Egyptian Goddess*, the Federal Circuit discouraged courts from rendering verbal claim constructions in design patent cases,[271] a theme that it has reiterated more recently.[272] Yet the Federal Circuit did not wish to discard the entire panoply of claim construction tools, so it advised courts that they might still provide "guidance" to the fact finder by explaining the significance of statements made during the prosecution of the design patent, for example,[273] leaving open the question of which claim construction canons might likewise be retained under the rubric of "guidance."

Herculean efforts such as these to stuff design patents into a utility patent box look mildly ridiculous against the backdrop of the historical analysis that we have offered in prior sections of this paper. As we have shown, at the outset of the debates over U.S. design protection, there was no commitment whatsoever to a model of substantive patent rules, and at the close of the 1842 session, when the design patent legislation passed, there was virtually no indication that its passage represented a congressional judgment of the inherent superiority of substantive patent rules for designs. In any event, many of the claiming practices discussed above did not exist in 1842. A suggestion that the design patent system avoid the use of claims and associated claiming rules altogether would not have raised eyebrows in 1842 and perhaps should not today either.

B. Design Patentability Standards

Another distinguishing feature of modern utility patent jurisprudence is its heavy reliance on comparisons between the claimed invention and the prior art as the focus of the patentability analysis. This comparison is implemented through an elaborate rule set that defines conditions of both novelty and nonobviousness. These rules, as they operate today, would be virtually unrecognizable to those who originally pressed for design protection.

Nothing in the historical record commands that demonstrating differences from the prior art be the focal point of a protectability analysis for designs. If anything, the stove industry narrative suggests that Mott and fellow lobbyists would have objected to a design patent regime had they understood that it would come to entail patentability requirements in the nature of nonobviousness. One of us has detailed in other work the circuitous path by which obviousness analysis infiltrated the design patent regime; we need not reiterate those arguments here.[274] For the

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269. *See, e.g.*, Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1376 (Fed. Cir. 2002); Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995).

270. *See* Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294, 1302–03 (Fed. Cir. 2010) (noting the commission's overemphasis on its written claim construction caused it to improperly focus on the designs' elements, instead of their appearance as a whole).

271. Egyptian Goddess, Inc. v. SWISA, Inc., 543 F.3d 665, 679–80 (Fed. Cir. 2008).

272. *Crocs, Inc.*, 598 F.3d at 1302–03.

273. *Egyptian Goddess*, 543 F.3d at 680.

274. Du Mont, *supra* note 16.

purposes of this paper, we need merely observe that the Federal Circuit has not yet come to grips with the incorporation of the obviousness concept into the assessment of designs.[275] An argument that the entire exercise is conceptually flawed is consistent with the historical record of design patent's nonpatent origins.

The Federal Circuit's commentary in *International Seaway Trading Corp.*[276] may provide another illustration of the need to rethink design patentability standards in view of the historical record. Section 171 requires not only that designs be new, but also that they be "original," a requirement that has been included in design patent legislation since the outset[277] but was rapidly swamped by the novelty and nonobviousness requirements. In a rare commentary on the originality requirement, the court speculated that the requirement "likely was designed to incorporate the copyright concept of originality—requiring that the work be original with the author."[278] Yet, as the court acknowledged, the originality requirement was not codified in U.S. copyright law until 1909, whereas the design patent legislation was enacted in 1842.[279] In seeming resignation, the court concluded that the overriding analogy was to utility patents after all: "the courts have not construed the word 'original' as requiring that design patents be treated differently than utility patents."[280] Providing further credence to the Federal Circuit's frustration, our historical analysis provides reason to question the wisdom of keeping design patent protection in the thrall of modern patentability standards developed under utility patent law.

CONCLUSION

What should come next for the design patent system? We do not argue here that the design patent regime should be dismantled in favor of a *sui generis* design protection regime. We do conclude that the way forward for the modern design patent system is to ease the design patent system back towards its mixed heritage. Our historical analysis persuades us that modern policy debates about the design patent system have exaggerated utility patent law's grip on design patent jurisprudence. We conclude that Congress's decision to enact design patent legislation in 1842 (1) was not an implicit rejection of other (non-patent) forms of design protection, such as design registration, and (2) was not an endorsement of using modern utility patent rules to protect designs. Arguments for shifting design

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275. Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1243–44 (Fed. Cir. 2009); Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed. Cir. 1996) (setting forth an obviousness standard requiring a primary reference that has "basically the same" appearance as the claimed design, combinable with secondary references only if they are closely related to the primary reference).

276. 589 F.3d at 1239.

277. 35 U.S.C. § 171 (2006); Ruggles Design Bill, S. 269, 26th Cong. § 1 (1841) (granting protection to "new and original designs"). As discussed above, contemporary British design protection similarly required the design be new and original. *See supra* Part III.A.

278. *Int'l Seaway*, 589 F.3d at 1238.

279. *Id.*

280. *Id.*

patent rights away from the frame of modern substantive patent law, and towards other frameworks such as copyright or trademark, are in no way as radical as they might seem on first blush. Indeed, they are arguments that would, ironically enough, return the design patent debate to its original roots.