

Past and Current Trends in the Evolution of Design Protection Law— A Comment[†]

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As you may have surmised, industrial design has posed the intellectual property world's single most complicated puzzle—one that has evolved over two hundred years—and I'm not going to sort it out in a twenty minute comment.¹ Today we heard a lot about the diversity of the domestic design laws, which the European Commission must try to reconcile in its overall efforts to harmonize national intellectual property laws. I will try to show you that there is a unifying thread beneath the surface.

I. A RECURRING CYCLICAL PATTERN

If we go back in time—twenty, fifty, or even a hundred years—and if we exclude the unregistered design law that the United Kingdom enacted in 1988,² you will find all of the existing com-

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1. See generally J.H. Reichman, *Design Protection and the Legislative Agenda*, 55 LAW & CONTEMP. PROBS. 281 (1992) [hereinafter Reichman, *Legislative Agenda*]; J.H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6 (1989-1990), abridged version reprinted in 30 INDUS. PROP. 220 (pt. 1), 257 (pt. 2) (1991) and in LA PROPRIÉTÉ INDUSTRIELLE 228 (pt. 1), 271 (pt. 2) (1991) [hereinafter Reichman, *Designs and New Technologies*]; J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 DUKE L.J. 1143 [hereinafter Reichman, *Design Before 1976*]; 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 (1983-1984) [hereinafter Reichman, *Comparative View*].

2. See Copyright, Designs and Patents Act, 1988, 2 Eliz. 2, ch. 48, §§ 213-264 (U.K.).

ponents of this international scheme already out there. But, as in the game of musical chairs, we also find most of today's players occupying different positions at different times. If you think, "Country A firmly holds a certain position today," you only have to look back fifty years earlier to see that same country was likely to have embraced somebody else's position then, and that the "somebody else"—Country B—is likely to have moved on to still another position thirty to fifty years later.

From a worldwide perspective, we thus find a recurring cyclical pattern that swings from states of chronic underprotection to states of chronic overprotection, and then back to underprotection once again. This two hundred-year-old cyclical pattern continues to unfold before our eyes.

The initial condition of underprotection typically stems from the full patent approach, which the United States still adheres to; Switzerland is also one of the last few countries, plus maybe Ireland, to follow the full patent model. Very few designs ever qualify for protection under a full patent approach because patent law imposes a nonobviousness standard, whereas commercial designs normally partake of small variations upon themes already known to the prior art. Such variations, though commercially valuable, seldom constitute an "inventive step" away from the prior art.

Historically, many countries tried to rectify the underprotection characteristic of a full patent model by opening their copyright laws to industrial designs, and France remains the most prominent adherent to this "unity of art" approach. However, copyright law inevitably overprotects product designs to such a degree that, outside of France, legislators soon tended to fall back on some form of industrial property protection once again—especially a modified patent approach—which, however, also breeds new states of underprotection. The recurring cyclical pattern can thus be summarized in the following terms:

Traditionally, the right to copyright protection is premised on a claim that certain industrial designs are entitled to legal recognition as art in the historical sense. The [adverse] economic repercussions of such recognition flow principally from the industrial character of the material sup-

port in which ornamental designs are embodied. The incidence of these repercussions upon any given system varies with the extent to which the claim to recognition as art is itself given effect. As copyright protection for designs of useful articles expands, the . . . [anticompetitive] effects of this expansion on the general products market induce countervailing pressures to reduce the scope of protection acquired in the name of art. As protection in copyright law correspondingly contracts, pressure for recognition of industrial art as a legally protectable form of industrial property normally increases. The tendency of industrial property law to breed still further instances of underprotection [that is, in sui generis laws built on modified patent principles] or overprotection [that is, in unfair competition laws sounding in the misappropriation rationale] then fosters renewed pressures for the regulation of industrial art within the framework of the laws governing literary and artistic property.³

And so it goes, round and round across the world's intellectual property system, from one generation to the next without breaking the cyclical pattern. Chronic underprotection in industrial property law leads to chronic overprotection in artistic property law, which in turn inspires further reactive reforms of industrial property law tending to reinstate levels of underprotection that will foster renewed appeals to copyright law.

II. THE CYCLICAL PATTERN IN DOMESTIC LAW

We can illustrate this cycle in United States law, and it is worth taking a few minutes to do so. Start with *Mazer v. Stein*⁴ in 1954. Until then, all we had were design patents, only a few designs could formally qualify for legal protection, and the federal courts seldom enforced even issued design patents, so designers obtained virtually no protection at all. We had chronic underprotection. Under pressure from the Europeans, the Copyright Office persuad-

3. Reichman, *Legislative Agenda*, *supra* note 1, at 287 (quoting Reichman, *Designs Before 1976*, *supra* note 1, at 1143).

4. 347 U.S. 201 (1954).

ed the Supreme Court in *Mazer v. Stein* to open the door to copyright law, and the United States recognized “works of applied art” as copyrightable subject matter for the first time.

For one moment, it looked as though we might even embrace full copyright protection of commercial designs in the French manner, but in 1958, the Copyright Office said, “No, we don’t want that, we need a *sui generis* design law.” So, the Copyright Office (and later the Congress) endorsed the neo-Italian standard of separability⁵ and thereby shunted most three-dimensional product designs out of copyright law, except for a few that are intrinsically separable from their physical supports. For example, two-dimensional fabric designs still qualify for copyright protection as graphic art, and the statues of dancers in *Mazer* still qualify as sculpture even though they are embodied in lamps. But the bulk of all product configurations was supposed to go to a *sui generis* design law built on modified copyright principles.

It was a brilliant design law, too—I’ll talk about that in a second—it was a brilliant proposal; Register Fisher’s design law as put forward in the late 1950s was really elegant.⁶ It would have made a major contribution to the world’s empirical knowledge of this subject, and it might have helped us to avoid the present predicament of the European Community. But it did not get enacted. Chairman Kastenmeier’s subcommittee shot it down in 1976. So we never got a chance to test that design law, the first one to be carefully worked out on modified copyright principles.

Of course, we did not leave commercial designs in copyright law; on the contrary, section 101 of the 1976 Copyright Act shunted virtually all three-dimensional product designs to the design patent law. But few designs obtained protection there, owing to the nonobviousness criterion. Meanwhile, in the early 1960s, lawyers started appealing to state unfair competition laws for protection against slavish imitation (known as misappropriation), and

5. See 17 U.S.C. § 101 (1988) (definition of pictorial, graphic and sculptural works) (codifying Copyright Off. Reg. 202.10(c) of 1959); see generally Reichman, *Designs Before 1976*, *supra* note 1, at 1181-88.

6. See Reichman, *Designs Before 1976*, *supra* note 1, at 1186-1213.

state courts welcomed these refugees from intellectual property law with open arms.

That, however, led to the Supreme Court's *Sears-Compco* decisions⁷ in 1964. What was *Sears-Compco* about? At stake were invalidated design patents, whose owners turned to state law and said, "Save us, save us!" And the state courts did intervene against slavish imitation. But the Supreme Court said, "No, you can't do that because it interferes with federal patents for designs." So, for one moment, we had the prospect of massive overprotection in state unfair competition law, but the Supreme Court preempted that solution.

The pressure turned right back to copyright law, in the lamp design held copyrightable by a federal district court in *Esquire, Inc. v. Ringer*,⁸ on the eve of the 1976 Act. So, of course, Register Ringer had to persuade Chairman Kastenmeier to codify the separability doctrine and to eject the modified lamp design from copyright law under the neo-Italian doctrine of separability. The difference is that, in Italy, they have a sui generis design law on modified patent principles that Italian courts have softened and made relatively workable, while our standard of nonobviousness still renders design patents of limited availability.

Once Register Ringer got Chairman Kastenmeier legislatively to exclude product configurations from copyright law in 1976, she expected them to obtain a short-term refuge in the pending sui generis design bill, built on modified copyright principles. But then, after twenty years of tinkering with Fisher's original bill, the House Subcommittee refused to adopt it. Chairman Kastenmeier balked.

As a result, we sent noncopyrightable product designs right back to design patent law, and to the credit of the Court of Appeals for the Federal Circuit, the design patent law has been revived, it

7. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

8. 414 F. Supp. 939 (D.D.C. 1976), *rev'd*, 591 F.2d 796 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979).

now works to the extent it can.⁹ But no matter how well it now works, you still only find a handful of designs that meet the statutory criterion of nonobviousness.

As the House Subcommittee saw it in 1976, the result should have been free competition in designs. Yet, any comparative expert in this field could have predicted that the United States federal courts were not going to sit there and tolerate rampant design piracy any more than courts in other countries had been willing to do. Hence, it comes as no surprise that, since the late 1970s, the federal appellate judiciary have converted section 43(a) of the Lanham Act into a judge-made design law, one that in some respects constitutes the most protectionist design law in the world. In effect, the federal courts have embraced the misappropriation doctrine popular in the state courts during the early 1960s and hidden it behind a spurious theory of "appearance trade dress."¹⁰

III. APPEARANCE TRADE DRESS: FROM *BONITO BOATS* TO *TWO PESOS*

But then the United States Supreme Court, in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,¹¹ launched another thunderbolt by reaffirming the spirit of *Sears-Compco* in 1989. True, *Bonito Boats* invalidated a state law that prohibited unauthorized reproduction of product configurations by the direct molding process, whereas the "appearance trade dress" decisions hide behind federal law deriving from the protection of unregistered marks under section 43(a) of the Lanham Act. Nevertheless, *Bonito Boats* appeared to reject both the misappropriation rationale as such and the misguided notion that trademark law could constitute an incentive to product innovation. Moreover, *Bonito Boats* invested a competitor's right to reverse engineer unpatented products with constitu-

9. See, e.g., Reichman, *Designs and New Technologies*, supra note 1, at 11-12, 45-56; Reichman, *Legislative Agenda*, supra note 1, at 284-86.

10. See generally Ralph S. Brown, *Design Protection: An Overview*, 34 *UCLA L. REV.* 1341, 1357-86 (1987); Reichman, *Designs and New Technologies*, supra note 1, at 81-123.

11. 489 U.S. 141 (1989).

tional underpinnings.¹² So, those of us who follow these things began to foresee some contraction in this facile use of section 43(a) of the Lanham Act to protect product configurations.

Then came an incredible development. In a monument to superficiality, the Supreme Court handed down another opinion, in the *Two Pesos*¹³ case, in which they implied that unregistered product designs could be protected under section 43(a) as trade dress without regard to secondary meaning if the designs in question were inherently distinctive. In other words, this decision assimilates every type of trade dress to trade marks and then blandly eliminates the requirement of secondary meaning for unregistered appearance trade dress that is inherently distinctive. Nowhere in the *Two Pesos* opinion was there the slightest awareness of a possible contradiction with the pro-competitive ethos of *Bonito Boats*, nor did the Court ever pause to consider why Congress had declined to pass a sui generis design law.

Let us skip over a number of minor quibbles with *Two Pesos* and focus instead on the principle defect of this opinion and, indeed, of earlier appellate decisions that kept assuring us that unregistered trade dress and unregistered trade marks should not be treated differently in order to avoid creating artificial distinctions between legal labels. This argument contains a grain of truth insofar as traditional trade dress is concerned. Because consumers do not purchase packaging or containers for their own sake, inherently distinctive marking of traditional trade dress may well carry a presumption of source indication.

The problem, as I have said in other forums, is not what to do about trade dress, it is what to do about *product configurations* that are the oldest and most troublesome of the many marginal cases currently undermining the world's intellectual property system. Historically, product configurations received only limited protection in unfair competition law because positive intellectual property law mandates that unpatented, noncopyrightable industrial designs should compete in the open market unless rescued by sui generis

12. *Id.* at 159-64.

13. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992).

design laws. "The question is not whether trade dress should be assimilated to trademarks. It is how to protect product configurations . . . within a federal intellectual property system that has been artificially carved up into semi-autonomous subcultures each at war with the others."¹⁴

The tension between *Two Pesos* and *Bonito Boats* is thus palpable, and it causes one to wonder how the federal appellate courts will react to the introduction of this new and potentially very protectionist element into a developing area of the law. For example, given the logic of *Two Pesos*, Jerome Gilson¹⁵ asked me at the Marshall Conference some months ago, "Do we still need a design law?" But when I examined the early cases following *Two Pesos*, I was surprised by the amount of resistance to the protection of product configurations this decision may paradoxically have stirred up, at least at the appellate level, as one panel after another seems to rediscover the virtues of free competition and the limits on judicial activism implicit in *Bonito Boats*.

IV. THE POWER OF POSITIVE LABELING

After *Bonito Boats*, to be sure, there was already some rethinking of the functionality standard, with some federal appellate courts expressing fears that the relaxed functionality standards in vogue during the 1980s could produce serious anticompetitive effects. A number of these courts even began to reinstate a modified doctrine of aesthetic functionality.¹⁶

Judicial concern for a more rigorous standard of functionality

14. Reichman, *Designs and New Technologies*, *supra* note 1, at 116.

15. See 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 2.14 (1993).

16. See, e.g., *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176 (7th Cir. 1989); *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2d Cir. 1990), *cert. denied*, 111 S. Ct. 1622 (1991). But see *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.*, 999 F.2d 619 (2d Cir. 1993). A number of courts also rejected the notion of "secondary meaning in the making" before the Supreme Court eased the requirement of secondary meaning. See, e.g., *Cicena Ltd. v. Columbia Telecommunications Group*, 900 F.2d 1546, 1549-50 (Fed. Cir. 1990); *Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244 (8th Cir. 1990); *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131 (2d Cir. 1992).

continues to grow after *Two Pesos*.¹⁷ There is also some concern that the "inherently distinctive" standard should not apply unless the trade dress in question is at least suggestive, if not arbitrary or fanciful.¹⁸ Above all, a growing number of appellate decisions have compensated for the lack of a secondary meaning requirement by reinstating stricter tests of potential confusion at the infringement stage and by rediscovering the corrective power of proper labelling, especially labelling in the form of a competing trademark.¹⁹ In effect, these judicial panels are increasingly prone to ask, "How could there be a likelihood of confusion if the second comer's trademark was on the product, if it was clearly marked? Why doesn't clear labelling disculpate design imitation in the absence of a sui generis design law?" The Court of Appeals for the Federal Circuit, in particular, has taken pains to stress that dissimilarities with respect to packaging, labelling, and brand names would normally overcome any confusion arising from similarities in so-called appearance trade dress, i.e., product configurations.²⁰

Of course, there was labeling in the 1980s, but courts striving to convert section 43(a) into a general-purpose misappropriation law tended to ignore it in the presence of product simulation. In this regard, the recent line of cases, stressing either the arbitrary nature of the dress or a lack of confusion, is particularly striking because the Supreme Court itself appeared to ignore both the de-

17. See, e.g., *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 633-34 (3d Cir. 1992) (citing *Bonito Boats*, 489 U.S. 141); *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444 (Fed. Cir. 1993). But see *Abbott Labs. v. Mead Johnson & Co.*, 971 F.2d 6 (7th Cir. 1992).

18. See, e.g., *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577 (2d Cir. 1993).

19. See, e.g., *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2d Cir. 1992); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815 (Fed. Cir. 1992); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993); see also *CJC Holdings Co. v. Wright & Lato, Inc.*, 979 F.2d 60, 65-66 (5th Cir. 1992) (stressing that when a design "was not protected by patent or copyright . . . a corporation normally has a right to make 'knock-off' copies"); *Merchant & Evans*, 963 F.2d 628.

However, courts will apply the confusion tests to consumers other than direct purchasers. See, e.g., *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985 (Fed. Cir. 1993) (stressing post-sale confusion).

20. See *L.A. Gear*, 988 F.2d 1117; *Braun*, 975 F.2d 815.

scriptive qualities of the restaurant decor in *Two Pesos* and the power of the second comer's own trade mark to rectify possible confusion owing to similarities of dress.

The most impressive of all the recent opinions is surely that of Judge Newman in *L.A. Gear, Inc. v. Thom McAn Shoe Co.*,²¹ one of the Federal Circuit's latest decisions concerning designs of athletic shoes, which was handed down early in 1993. While staunchly upholding a design patent on the shoes in question, Judge Newman issued a warning call to those courts that have blandly tried to convert section 43(a) of the Lanham Act into a judge-made design law. She admonishes that similarities of product configurations in and of themselves do not constitute a likelihood of confusion or of mistake, nor are they a form of deception. In the absence of these taints, the public enjoys an absolute right to copy unpatented, noncopyrightable useful articles. Even distinctive product designs cannot be shielded from copying if the second comer adequately dispels confusion by other means, and especially by prominent use of his or her own trade names and trademarks.²²

Above all, Judge Newman explicitly declared that *Sears-Compco* and *Bonito Boats*, taken together, prevent the federal courts from exceeding the Congressional mandate as to section 43(a) by judicially creating a new form of industrial design protection without legislative enactment of a sui generis design law.²³ In effect, by reading *Two Pesos* against *Bonito Boats*, the Federal Circuit has distilled the kind of analytical framework applicable to product configurations that is altogether lacking in the Supreme Court's own essay in *Two Pesos*.

Judge Newman's opinion also reveals the dilemma that confronts the courts when *Bonito Boats* and *Two Pesos* are read together. On the one hand, less demanding standards of eligibility make it easier to tolerate overprotection of product configurations in federal unfair competition law by expanding the "appearance

21. 988 F.2d 1117.

22. *Id.* at 1130-34; see also *Braun*, 975 F.2d 815; *CJC Holdings*, 979 F.2d at 65-66; *Coach Leatherware Co. v. Ann Taylor, Inc.*, 933 F.2d 162 (2d Cir. 1991).

23. *L.A. Gear*, 988 F.2d at 1117.

trade dress" heresy, as some judicial panels are still prone to do.²⁴ On the other hand, courts seeking to reinstate a more rigorous degree of competition in the spirit of *Bonito Boats* must close their eyes to the level of underprotection that results from design piracy under modern conditions, unless Congress decides to enact a sui generis design protection law to meet this challenge.²⁵

In short, trademark and unfair competition laws cannot substitute for a true design protection law, nor can they be used to stimulate innovation and product development without anti-competitive effects that are well known to legal historians. As Stephen Ladas pointed out, trademark and unfair competition laws lack the limitations and safeguards that positive intellectual property law establishes in order to balance the long-term public interest against short-term restraints on trade. To the extent that such laws attempt to remedy the perceived inadequacies of other legal disciplines, they set up a competing forum capable of furnishing longer and tougher forms of protection on softer conditions.²⁶ At the limit, the misappropriation branch of unfair competition law provides a ritual formula for suspending the rules of competition in favor of perpetual monopolies that are conferred on a hit-or-miss basis for reasons that vary with the outlook of single judges.

V. COPYRIGHT-LIKE PROTECTION OF FUNCTIONAL DESIGNS

The need to enact a sui generis design law in the interest of our domestic design industries seems clear.²⁷ In this connection, our

24. See, e.g., *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.*, 999 F.2d 619 (2d Cir. 1993); *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063 (7th Cir. 1992); *Esercizio v. Roberts*, 944 F.2d 1235 (6th Cir. 1991), *cert. denied*, 112 S. Ct. 3028 (1992); see also *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165 (11th Cir. 1991) (antedating *Two Pesos*).

25. See *supra* notes 16-19. The design piracy left undeterred in *Bonito Boats* itself, where an innovative hull design was duplicated with no corresponding investment in research and development, gives cause for concern.

26. See, e.g., 2 STEPHEN P. LADAS, *PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION* 967-68 (1975). But see Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887 (approving the "appearance trade dress" approach).

27. See, e.g., Ralph S. Brown, *Copyright-Like Protection for Designs*, 19 U. BALT.

GATT negotiators have either jumped into, or been pushed into, accepting a provision in the Draft TRIPS Agreement that would almost certainly require the United States to adopt a *sui generis* design law, whether or not it retained the present design patent law on the books.²⁸ The problem is that, as Hugh Griffiths just informed us, the Commission of the European Communities is about to endorse some novel and fairly radical solutions; and my fear is that, once the United States began to consider reform proposals in earnest, the EC model might seem irresistible, especially if it was supported by certain lobbying groups already at work over here.

I refer particularly to the fact that the EC proposal would contain both a registered and an unregistered option, and that it would basically protect *both* aesthetically determined appearance designs *and* functionally determined appearance designs on modified copyright principles for a fairly long period of time. Most design laws, besides requiring registration, still protect only aesthetically determined product configurations for a relatively short period of time and exclude functionally determined designs altogether. The United Kingdom's unregistered design law, enacted in 1988, does protect both aesthetically and functionally determined designs for a relatively short period of time, although that country's registered design law, also amended in 1988, continues to protect only appearance designs and not functionally determined designs for a long period of time.²⁹

The EC proposal clearly contains some interesting features. One is the possibility of acquiring a year or two of protection against slavish imitation without any registration at all. Another interesting feature is the resort to modified copyright principles,

L. REV. 308 (1989-1990); William T. Fryer, III, *Industrial Design Protection in the United States of America—Present Situation and Plans for Revision*, 19 U. BALT. L. REV. 198 (1989-1990); Reichman, *Legislative Agenda*, *supra* note 1.

28. See J.H. Reichman, *The TRIPS Component of the GATT's Uruguay Round: Competitive Prospects for Intellectual Property Owners in an Integrated World Market*, 4 *FORDHAM INTELL. PROP., MEDIA & ENT. L.J.* 171 (1993) (discussing Articles 25-26 of the Draft Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods).

29. See, e.g., Christine Fellner, *The New United Kingdom Industrial Design Law*, 19 U. BALT. L. REV. 369 (1989-1990).

rather than to modified patent principles; although the EC proposal is much less clear in this regard than the United Kingdom's unregistered design right. In fact, there appears to be little consensus concerning the standards of eligibility applicable under the EC model.

But the EC proposal (and the United Kingdom's unregistered design right) both become radical the moment they seek to extend copyright-like protection to functionally determined designs that manifest no significant creative contribution; the EC proposal would confer an exorbitant term of protection as well. Such solutions turn the competitive ethos on its ear. Traditionally, every unpatented, noncopyrightable product innovation was subject to an absolute right in third parties to compete by lawful means of reverse engineering. In legal terms, this is what *Sears-Compco* and *Bonito Boats* continue to teach. Yet, every single product on the general products market carries a functional design, and both the United Kingdom's unregistered design right and the EC proposal would, in effect, protect virtually all save the most commonplace functional designs. The only certain exceptions, besides utterly commonplace designs, are for that rarity of rarities, the design whose functionality can only be achieved by one particular mode of implementation. Otherwise, both the United Kingdom's unregistered design right and the proposed EC model tend to override classical free-market premises and organize in their stead a system in which virtually every product sold on the products market comes freighted with the exclusive rights of intellectual property laws.

In the past, countries willing to protect unpatented functional designs enacted utility model laws requiring standards of inventive activity that were only moderately less exigent than the nonobviousness standard of patent law.³⁰ Countries that protect

30. See, e.g., 2 LADAS, supra note 26, at 949-56; TERUO DOI, THE INTELLECTUAL PROPERTY LAW OF JAPAN 68-70 (1980); E. Hausser, *Utility Models: The Experience of the Federal Republic of Germany*, 26 INDUS. PROP. 314 (1987). However, the adoption of the Semiconductor Chip Protection Act of 1984 in the United States introduced legal protection of one class of functional designs under soft prerequisites, like those of copyright law, rather than under hard prerequisites, like those of patent law. See, e.g., J.H. Reichman, *Overlapping Proprietary Rights in University Generated Research*

utility models, including Germany, Italy, Japan, and a growing number of developing countries, seek to encourage small-scale innovation that is particularly suited to local conditions. These laws nonetheless require evidence of a significant innovative contribution³¹ because the external configuration of virtually every utilitarian product affects its functional efficiency or performance. Proposals to protect functional designs on much softer standards than those of utility model laws or, indeed, in return for no significant quantum of creative achievement whatsoever, constitute an unprecedented assault on the free-market principles that underlie both domestic and international trade.

Moreover, such proposals complicate an already difficult subject by casting fresh doubts on what exactly the sponsors of these legislative initiatives are trying to accomplish and why. If their object is to protect all innovative shapes or forms that have an industrial application, it begs the question as to why this type of innovation, but not others, should escape the price-setting function of the marketplace. If their concern is to encourage investment in innovation that remains particularly vulnerable to appropriation by free-riders, one wonders why other forms of incremental innovation that are at least as socially beneficial as functional designs should not be rescued from a similar fate.³² For example, why not protect unpatentable biogenetically altered organisms under a parallel *sui generis* regime? And why tolerate exorbitant protection of industrial literature (that is, computer programs) in copyright law, only to confine industrial art and functional designs generally to a *sui generis* regime?

The Case of Computer Programs, 17 COLUM.-VLA J.L. & ARTS 51, 110-116 (1992).

31. For a conceptual clarification of the pristine function of a utility model law before it degenerates into a petty patent law, see Jerome H. Reichman, *Electronic Information Tools—The Outer Edge of World Intellectual Property Law*, 24 INT'L REV. INDUS. PROP. & COPYRIGHT L. [I.I.C.] 451-55 (1993).

32. Cf. Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579, 580-89, 606-09 (1985).

VI. INCREMENTAL INNOVATION BEARING KNOW-HOW ON ITS FACE

I have elsewhere suggested that the real problem facing the design industries is the same problem that faces both computer software manufacturers and biogenetic engineers, namely, the difficulties of protecting *incremental innovation bearing know-how on its face*:³³

[M]uch of today's most advanced technology enjoys a less favorable competitive position than that of conventional machinery because the unpatentable, intangible know-how responsible for its commercial value becomes embodied in products that are distributed on the open market. A product of the new technologies, such as a computer program or an integrated circuit design, or even a biogenetically altered organism may thus *bear its know-how on its face*, a condition that renders it as vulnerable to rapid appropriation by second comers as any published literary or artistic work.

From this perspective, a major problem with the kinds of innovative know-how underlying important new technologies is that they do not lend themselves to secrecy even when they represent the fruit of enormous investment in research and development. Because third parties can rapidly duplicate the embodied information and offer virtually the same products at lower prices than those of the originators, there is no secure interval of lead time in which to recuperate the originators' initial investment or their losses from unsuccessful essays, not to mention the goal of turning a profit.

. . . .

. . . From a behavioral standpoint, investors in applied scientific know-how find the copyright paradigm attractive because of its inherent disposition to supply artificial lead

33. See J.H. Reichman, *Computer Programs as Applied Scientific Know-How: Implications of Copyright Protection for Commercialized University Research*, 42 VAND. L. REV. 639, 652-68, 714-17 (1989).

time to all comers without regard to innovative merit and without requiring originators to preselect the products that are most worthy of protection.³⁴

The long-term conclusion is that the world's intellectual property system needs a law to protect applied know-how far more than it needs another batch of sui generis design laws. In this respect, any sui generis design protection law, even if limited to appearance designs, represents merely one of numerous legal metaphors that legislators have used to provide indirect protection of unpatented, noncopyrightable know-how under a classical intellectual property system dominated by the patent and copyright paradigms. This topic, introduced in my recent studies, is more fully explored in a work in progress entitled *Legal Hybrids Between the Patent and Copyright Paradigms*.³⁵

Direct protection of applied know-how would require, however, a higher degree of consensus concerning legal means and economic ends than currently exists, and it has nothing to do with the automobile and tractor industries' thinly disguised demand for trade protection in the spare parts market.³⁶ Conferring exclusive rights on routine functional designs lacking any significant creative contribution cannot be reconciled with either the theoretical and economic underpinnings of classical intellectual property law or with the conceptual underpinnings of a new paradigm devised to protect incremental innovation bearing know-how on its face.

To the extent that an interim solution is needed, little harm would result from protecting appearance designs—but not functionally determined designs—on modified copyright principles for a

34. Reichman, *Designs and New Technologies*, *supra* note 1, at 137, 144 (citations omitted).

35. See J.H. Reichman, *Legal Hybrids Between the Patent and Copyright Paradigms*, in *INFORMATION LAW TOWARDS THE 21ST CENTURY* 325-49 (William F. Korthals Altes et al. eds., 1992) (conference proceedings containing excerpts from a work in progress).

36. See, e.g., Kenneth Enborg, *Industrial Design Protection in the Automobile Industry*, 19 U. BALT. L. REV. 227 (1989-1990); James F. Fitzpatrick, *Industrial Design Protection and Competition in Automobile Replacement Parts—Back to Monopoly Profits?*, 19 U. BALT. L. REV. 233 (1989-1990); William Thompson, *Product Protection Under Current and Proposed Design Laws*, 19 U. BALT. L. REV. 271 (1989-1990).

very short period of time. This was, in essence, the elegant American proposal of the 1950s—Register Fisher's proposal—which was far ahead of its time.³⁷ Such a law would not resolve all of the problems that need to be dealt with; but in my view, the deepest and most serious problems will require us to devise a third paradigm dealing with applied know-how that breaks with the mature patent and copyright paradigms. Indeed, a proper know-how law would not resemble the typical intellectual property model at all. Of this, more will be said when my research colleagues and I publish our ideas about the proper basis for protecting industrial literature, i.e., computer programs.³⁸

Meanwhile, as regards industrial art, the oldest and most perplexing hybrid subject matter in the world's intellectual property system, the first rule of thumb ought to be *primum non nocere*—first, do no harm. A design law that protects virtually all functional designs for a relatively long period of time, without requiring any appreciable creative contribution, fails this test. In the name of overcoming design piracy, it banishes honest competition to the margins of the system and multiplies spurious monopoly interests, just at a time when an integrated world market needs to rid itself of vestigial protectionist customs inherited from an anti-entrepreneurial political tradition.

37. See *supra* note 6 and accompanying text.

38. See Pamela Samuelson, Randall Davis, Mitchell Kapur & J.H. Reichman, *A Manifesto Concerning the Legal Protection of Computer Programs* (unpublished work in progress); see also Pamela Samuelson, *A Case Study on Computer Programs*, in *GLOBAL DIMENSIONS OF INTELLECTUAL PROPERTY RIGHTS IN SCIENCE AND TECHNOLOGY* 284-318 (Mitchel B. Wallerstein et al. eds., 1993).