

Design Patents: An Alternative When the Low Standards of Copyright are Too High?

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I. INTRODUCTION

The standard for copyright protection is notoriously low – the work must be independently created by the author and possess a minimal degree of creativity.¹ Nonetheless, even with that generous standard, the courts and the Copyright Office recognize that certain works do not contain even that minimum level of creativity such that they are categorically refused copyright protection. Blank forms, and other forms that do not convey information, fall within this category.²

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¹ Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 345 (1991).

² 37 C.F.R. § 202.1(c) (2006).

In contrast, and for good reason, the standard for design patent protection is much more burdensome. Design patents protect new, original, ornamental, and non-obvious designs.³ This more difficult standard, which generally subsumes the copyright standard, would lead one to assume that anything failing the low copyright standard would not be eligible for design patent protection. Then again, one might be wrong. The Patent and Trademark Office has issued design patents for blank forms and recent case law has either upheld design patent protection for blank forms or declined to categorically refuse such protection.⁴

This article explores the blank forms doctrine in copyright law, the overlap between copyright and design patent protection, why the law's refusal to protect blank forms under copyright law is necessarily inconsistent with the law's protection of blank forms via design patents, and possible judicial, Congressional, or administrative solutions to resolve this inconsistency.

II. COPYRIGHT PROTECTION (OR LACK THEREOF) FOR BLANK FORMS

A. General Requirements for Copyright Protection

The Copyright Act of 1976 provides that "[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁵ In 1991, the Supreme Court noted that "[t]he *sine qua non* of copyright is originality" and "[t]o qualify for copyright protection, a work must be original to the author."⁶ Original, in the context of copyright, means only that the work was independently created and "*that it possesses at least some minimal degree of creativity.*"⁷ To reemphasize this point, the Court reminded us that "[t]o be sure, the requisite level of creativity is extremely low; even a slight amount will suffice" and that "[t]he vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be."⁸ But even this generous standard does not permit all works to enjoy copyright protection. There still exists a "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent."⁹ One such category is the white pages telephone directory.¹⁰ The Supreme Court found that the white pages publisher did not satisfy the minimum level of creativity because it was "devoid of even the slightest trace of creativity."¹¹ Another category of works that fail to meet this modicum of creativity is blank forms.

³ 35 U.S.C. §§ 103, 171 (2000). The non-obvious requirement is carried over from the utility patent context from § 171's clause stating that "[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." *Id.* at § 171.

⁴ See *infra* Part III.B.

⁵ 17 U.S.C. § 102(a) (2000).

⁶ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (emphasis in original).

⁷ *Id.* (emphasis added).

⁸ *Id.*; or as metaphorically stated "The creative spark need not create a shock, but it must at least be perceptible to the touch." William Patry, *Can Our Current Conception of Copyright Law Survive the Internet Age?*, 46 N.Y.L. SCH. L. REV. 201, 208 (2002-2003).

⁹ *Feist*, 499 U.S. at 359.

¹⁰ *Id.* at 364.

¹¹ *Id.* at 362.

B. The Blank Forms Doctrine

The denial of copyright protection to blank forms has had and currently has more than its fair share of problems. What started off as a simple conclusory statement by the Supreme Court in 1879 has spawned well over one hundred years of debate on the ability to copyright blank forms. As the courts have been unable to agree on exactly what the blank form doctrine is, it is difficult to clearly state the rule without exploring its origins, the Copyright Office's regulation based upon the doctrine, and the courts' subsequent interpretations thereof.

1. *The History of the Blank Forms Doctrine*

In 1879, the Supreme Court decided *Baker v. Selden*,¹² which is understood, and arguably misunderstood, as the origin of the blank forms doctrine. In *Baker*, Charles Selden had prepared a book entitled *Selden's Condensed Ledger, or Bookkeeping Simplified*.¹³ This book exhibited and explained a system of bookkeeping by means of an introductory essay and attached forms consisting of ruled lines and headings illustrating the system and showing how to use and carry out the bookkeeping method.¹⁴ The defendant, Baker, was accused of using a similar bookkeeping system, but with a different arrangement of the columns and headings.¹⁵ Selden contended that "the ruled lines and headings, given to illustrate the system, [were] a part of the book, and, as such, [were] secured by the copyright; and that no one [could] make or use similar ruled lines and headings, or ruled lines and headings made and arranged on substantially the same system, without violating the copyright."¹⁶ Importantly, the Court found that the validity of this contention was "really the question to be decided in this case."¹⁷

To answer this question, the Court drew "a clear distinction between the book, as such, and the art which it is intended to illustrate" and noted that this "proposition is so evident, that it requires hardly any argument to support it."¹⁸ Despite the clarity of this proposition, the Court spent a large portion of its opinion explaining the difference between obtaining a patent for a system and securing copyright protection for the explanation of the system.¹⁹ The Court also repeatedly noted that the description of a system in a book is entitled to copyright, but this does not lay the foundation for an exclusive right to the system itself.²⁰

Despite the Court's tremendous focus on the copyright law not protecting the underlying system, the Court's holding was peculiar:

The conclusion to which we have come is, that blank account-books are not the subject of copyright; and that the mere copyright of Selden's book did not confer

¹² *Baker v. Selden*, 101 U.S. 99 (1879).

¹³ *Id.* at 99-100.

¹⁴ *Id.* at 100.

¹⁵ *Id.*

¹⁶ *Id.* at 101.

¹⁷ *Id.*

¹⁸ *Id.* at 102.

¹⁹ *Id.* at 102-104.

²⁰ *Id.* at 103-105 ("The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before But as embodied and taught in a literary composition or book their essence consists only in their statement. This alone is what is secured by copyright.").

upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book.²¹

The peculiarity of the Court's holding is that it finds that the accounting forms, rather than the bookkeeping system, were not the subject of copyright. This holding is consistent with the Court's framing of the issue as whether the ruled lines and headings (i.e. the blank forms) were entitled to copyright protection.²² Therefore, the idea/expression dichotomy it spent so much time explaining could not be the basis for the Court's holding. However, the Court did not provide any additional reasoning supporting its holding.

Two rationales are suspected. One is that the blank forms were not sufficiently creative to be original and deserving of copyright protection. The other is that the blank forms are so closely related to the system, that the system is incapable of being expressed in any way other than the blank forms. When this occurs, the system and expression merge into one and neither are capable of copyright protection. The merger doctrine provides that when there is "only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself," then even the expression is not protected by copyright law.²³ The merger doctrine was produced as a corollary maxim based on the idea/expression dichotomy.²⁴

The merger rationale is unlikely. Because the Court initially found that Baker used a different arrangement of the columns and headings, this suggests that the basis of the Court's holding was not a merger between the idea and the expression, but something else. This leaves the lack of creativity rationale. But the Court never cites any authority or even sets forth a rule of law supporting this conclusion. It is from this uncertain holding that the blank forms doctrine and its accompanying morass was born.

2. Subsequent Interpretations of the Blank Forms Doctrine

a. Copyright Office Regulations

The Copyright Office, which registers copyrightable works, has, since 1899, had regulations regarding material not subject to copyright. The current regulation, promulgated in 1956, provides:

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

(c) Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and

²¹ *Id.* at 107.

²² *See supra* notes 16-17 and accompanying text.

²³ *Kregos v. Associated Press*, 937 F.2d 700, 705 (2nd Cir. 1991); *see also Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-679 (1st Cir. 1967) (finding that permitting copyright protection to such expressions would be to "recognize copyright as a game of chess in which the public can be checkmated.").

²⁴ *Kregos*, 937 F.2d at 705.

the like, which are designed for recording information and do not in themselves convey information.²⁵

As noted, this is not a new regulation. In 1899, the Register of Copyrights' guidelines for obtaining copyright registration simply stated that blank forms were not copyrightable.²⁶ A few years later, new guidelines were promulgated elaborating on the denial of copyright protection to blank forms.²⁷ This guideline provided:

A single sheet, if a literary composition, may be termed a book in applying for copyright registration, but printed productions which are partly unfinished, or with arranged spaces to be filled in, such as blank forms, account books, ledgers, memorandum books, diaries, time and score books, etc., are not productions which can be designated "books" and registered as such for copyright protection.²⁸

Lastly, after the 1909 Copyright Act was passed, the Copyright Office was granted authority to issue regulations implementing the Copyright Act and it promulgated the following:

The term "book" cannot be applied to blank books for use in business or carrying out any system of transacting affairs such as record books, account books, memorandum books, diaries or journals, bank deposit and check books; forms of contracts or leases which do not contain original copyrightable matter; coupons; forms for use in commercial, legal, or financial transactions, which are wholly or partly blank and its value lies in their usefulness and not in their merit as literary compositions.²⁹

After the 1976 Copyright Act was enacted, the Copyright Office revisited its regulation on blank forms.³⁰ The re-examination was terminated in 1980 without amending the existing regulation.³¹ However, the explanation for maintaining the regulation did not shed much light on the basis for denying copyright protection to blank forms. The inquiry suggested that the problem may lie in originality or the idea/expression dichotomy, although most of the focus was on originality.³² For example, the inquiry termination found that "[a] work *which lacks even a minimal amount of original, creative expression* should be denied registration regardless of whether it embodied a new or original idea."³³ Further, the Copyright Office stated:

²⁵ 37 C.F.R. § 202.1(c) (2006).

²⁶ *Advanz Behavioral Mgmt. Resources, Inc. v. Miraflor*, 21 F. Supp. 2d 1179, 1186, n.8 (C.D. Cal. 1998) (citing Directions for Securing Copyrights 16-17 (1899), reproduced in Compilation of Regulations Concerning Copyright 1874-1956 (U.S. Copyright Office)).

²⁷ *Id.*

²⁸ *Id.* (citing Directions for Securing Copyrights 24 (1901), reproduced in Compilation of Regulations Concerning Copyright 1874-1956 (U.S. Copyright Office)).

²⁹ *Id.* (citing Rules and Regulations for the Registration of Claims to Copyright § 5 (1910)).

³⁰ *Id.* at 1186.

³¹ 45 Fed. Reg. 63297, 63297-63300 (September 24, 1980).

³² *See generally id.*

³³ *Id.* at 63298 (emphasis added).

The *Baker* case and its progeny are embodied in the longstanding practice of the Copyright Office to deny registration of a claim in a form designed merely to record information if that form *contains no original literary or artistic expression* (i.e., it is "blank"). If a work *does evidence at least an appreciable amount of such original, creative expression*, the Copyright Office will register a claim, regardless of whether or not the work also contains uncopyrightable elements designed for the simple recordation of information.³⁴

On the other hand, the inquiry also lends support to the idea/expression dichotomy as a basis for denying copyright protection to blank forms. Citing the House Report accompanying the 1976 Copyright Act, the Copyright Office determined that the 1976 Act maintained the idea/expression dichotomy.³⁵ Because of the Copyright Office's failure to enlighten the public or the judiciary and clarify the reasoning behind the denial of copyright protection to blank forms, we were left in no better position than where *Baker v. Selden* left us. The problem was further complicated by reintroducing the idea/expression rationale, rather than the merger doctrine.

b. The Blank Forms Doctrine Primarily Concerns Originality or Merger?

The cases interpreting *Baker v. Selden* and the Copyright Office's regulation denying copyright protection to blank forms do little to clarify whether the rule is about originality or merger.

In *Aldrich v. Remington Rand, Inc.*,³⁶ the plaintiff devised a bookkeeping system and expressed this system in a book.³⁷ The back of the plaintiff's book contained many forms illustrating his system.³⁸ The court determined that the principal question to be decided was whether the forms were copyrightable.³⁹

After quoting substantially from *Baker v. Selden*, the court held that "[p]laintiff's forms of themselves imparted no more information than the words 'credit' or 'debit' at the head of such columns as we ordinarily see in any system of simple bookkeeping."⁴⁰ The focus on the ordinary suggests that the problem was with originality.

But the court was not finished. It continued on to find the forms embodied in practice what the plaintiff taught and the plaintiff's forms could be used, modified, changed, improved, or made worse by the public without infringing.⁴¹ The court then asked, "How could the public appropriate the system identically, if it could not use the forms?"⁴² This language suggests that the problem was that the forms had merged with the underlying system.

Lastly, the court in *Aldrich* focused on the Copyright Office's regulation providing that books entitled to copyright protection could not be applied to:

³⁴ *Id.* (emphasis added).

³⁵ *Id.* ("[C]opyright may be claimed only in the 'expression' embodied in a work of authorship, and not in its 'idea,'" "[T]he basic dichotomy between copyrightable expression and uncopyrightable idea(s) remains unchanged.").

³⁶ *Aldrich v. Remington Rand, Inc.*, 52 F. Supp. 732 (N.D. Tex. 1942).

³⁷ *Id.* at 733.

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *Id.* at 734.

⁴¹ *Id.*

⁴² *Id.*

Blank books for use in business or in carrying out any system of transacting affairs, such as record books, account books, memorandum books, blank diaries or journals, bank deposit and check books; forms of contracts or leases which do not contain original copyrightable matter; coupons; forms for use in commercial, legal, or financial transactions, which are wholly or partly blank and whose value lies in their usefulness.⁴³

This regulation compounds the confusion of *Baker v. Selden*; it describes the reasoning for denying copyright protection as not containing *original* copyrightable matter, but also because the "value lies in their usefulness." Again, one must wonder whether the reasoning behind denying blank forms copyright protection was because they did not possess the requisite amount of creativity or because the idea and expression had merged. In the end, *Aldrich* did not help clarify the problem.

Almost thirty years later, the court in *Harcourt, Brace & World, Inc., v. Graphic Controls Corporation*,⁴⁴ was confronted with the following question: "Are printed answer sheets, created for use in conjunction with student achievement and intelligence tests and designed to be corrected by optical scanning machines, the proper subject of copyright?"⁴⁵ At issue were standardized test answer sheets. The court ultimately found that the answer sheets were entitled to copyright protection.

The court held that although the physical area for originality was limited by the requirements of the optical scanning machine, the answer sheets did meet the minimal degree of creativity required to be original.⁴⁶ The minimum level of creativity was apparently expressed by the division of the response positions across the page, the information asked for (e.g. name, age, date), a determination of whether the student should record on the face of the answer sheet, the symbolic code indicating what question is being asked and what possible alternative answer slots may be selected, the instruction explaining how to use the answer sheet in conjunction with an examination, and examples illustrating such use.⁴⁷ From these "expressions," the court found originality.⁴⁸ Although granting copyright protection to arguably blank forms, the court in *Harcourt, Brace & World* seized upon the originality issue of the blank forms doctrine and helped clarify the underlying problem.

Two years later in 1973, the court in *Time-Saver Check, Inc. v. Deluxe Check Printers, Inc.*⁴⁹ also strengthened the argument that the blank forms doctrine was about originality. In *Time-Saver Check*, the plaintiff designed and produced a book "related to printed commercial bank checks and attached separate duplicates used with carbon paper that [were] meant to be retained as accurate records of the checks that [were] written."⁵⁰ The books contained "several diagrams and illustrations of checks and various duplicate forms to be attached thereto and used

⁴³ *Id.* at 735-736.

⁴⁴ *Harcourt, Brace & World, Inc., v. Graphic Controls Corp.*, 329 F. Supp. 517 (S.D.N.Y. 1971).

⁴⁵ *Id.* at 518.

⁴⁶ *Id.* at 523 (noting that the limitations on the answer sheets concerned the shape and maximum number of response positions, whether they shall be set horizontally or vertically, the weight of the paper, the size of the sheet, and the number of lines per inch).

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Time-Saver Check, Inc. v. Deluxe Check Printers, Inc.*, 178 U.S.P.Q. 510 (N.D. Tex. 1973).

⁵⁰ *Id.* at 510.

with carbon paper."⁵¹ The book also contained "written descriptions and characterizations of the checks, the duplications, the method of binding and producing the marketable product, and the manner in which the check and the duplicate copy [were] to be used."⁵²

The *Time-Saver Check* court cited the Copyright Office's Circular 32 entitled "Blank Forms and Other Uncopyrightable Works" which stated that:

Blank forms and similar works, designed to record rather than to convey information, cannot be copyrighted. In order to be copyrightable, *a work must contain at least a certain minimum amount of original literary, pictorial, or musical material.*⁵³

Based upon this rule, the court found that the plaintiff's checks were "not of such a nature that they [were] entitled to protection under the Copyright Statute" because there was "nothing about them which [was] creative, original, or artistic."⁵⁴ Later, the court reiterated its holding when it stated that "[t]he checks and the forms for duplicate copies upon which plaintiff relies embody *no original creative artistic characteristics*, and are therefore not protected under copyright law."⁵⁵ The *Time-Saver Check* decision was another step forward in finding that a lack of originality is the problem with blank forms.

Adding a semantic twist to the blank forms doctrine, the court in *Edwin K. Williams & Co., Inc. v. Edwin K. Williams & Co. East*⁵⁶ held that gasoline station record-keeping books were entitled to copyright protection.⁵⁷ The court found the books contained several pages of instructions followed by thirty-one pages of blank forms, one page for each day of the month.⁵⁸ The user was to fill in the day's transactions in the various boxes on the blank forms.⁵⁹ Some of the instructions showed the user how to fill in the forms and others showed the user how to operate his business.⁶⁰ The court recognized *Baker v. Selden* and noted that the Copyright Office's regulation prohibited copyright protection for blank forms that do not in themselves convey information.⁶¹ The court affirmed the district court's finding that the books at issue conveyed information.⁶²

The intriguing aspect of the Copyright Office's regulation and the *Edwin K. Williams* court's adherence to its language is that the issue was framed in terms of the conveyance of information rather than a lack of originality or the application of the merger doctrine. The failure to convey information adds another dimension to the quagmire of the blank forms doctrine. Are works failing to convey information merely a subset of those works lacking originality? Are these works a subset of those merging with their underlying idea because they can only be used for recording information?

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.* at 511 (emphasis added).

⁵⁴ *Id.*

⁵⁵ *Id.* (emphasis added).

⁵⁶ *Edwin K. Williams & Co., Inc. v. Edwin K. Williams & Co. East*, 542 F.2d 1053 (9th Cir. 1976).

⁵⁷ *Id.* at 1061.

⁵⁸ *Id.* at 1060.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.* at 1060-1061.

⁶² *Id.* at 1061.

The genesis of this part of the Copyright Office's regulation appears to be *Brown Instrument Co. v. Warner*,⁶³ where the court found that charts used to record temperature and pressure were incapable of copyright protection because the forms did not intend to communicate facts or ideas, but were intended solely for use in making records of facts.⁶⁴ The *Brown Instrument* court explained that because the forms were necessarily used with the associated machines, granting copyright protection to the forms would "in effect continue [plaintiff's] monopoly of its machines beyond the time authorized by the patent law."⁶⁵ Thus, the Copyright Office's regulation requiring blank forms to convey information appears to suggest that merger plays a part in the blank forms doctrine. Given its reliance on the Copyright Office's regulation and the historical context for it, *Edwin K. Williams* supports the notion that the blank forms doctrine is based on merger rather than originality.

In *John H. Harland Co. v. Clarke Checks, Inc.*,⁶⁶ the district court held the plaintiff's blank checks were not entitled to copyright protection.⁶⁷ However, its reasoning was far from clear. The court noted that *Baker v. Selden* was controlling and found that the plaintiff's checks actually represented a new system for recording checkbook entries and as such, was not subject to copyright protection.⁶⁸ This reasoning reintroduces and suggests that the problem lies in the idea/expression dichotomy. But later in its opinion, the district court found the plaintiff's checks did "not convey any additional information other than that which is contained in an ordinary bank check, which neither party contends is copyrightable. It contains no instructions other than specifying 'Pay To' and 'For' lines, as well as indicating spaces for the date and dollar amount."⁶⁹ This statement muddied the waters by suggesting that the reasoning for denying the blank checks copyright protection was that they lacked originality.

On appeal the Eleventh Circuit affirmed the district court's conclusion, but did not clarify this issue. The Eleventh Circuit first noted that "[i]t is well established that blank forms which do not convey information *or* contain original pictorial expression are not copyrightable."⁷⁰ After citing to the Copyright Office's regulation, the court held that the plaintiff's blank checks were "merely designed for recording information and [did] not convey information *or* contain original pictorial expression."⁷¹ Because the court separated conveying information from originality, it supports the notion that both merger and originality are the underlying problems with blank forms. The Eleventh Circuit's opinion did not contain a discussion of the idea/expression dichotomy, which helped refocus the rationale for the blank forms doctrine back to originality and merger rather than expanding the analysis as the district court had done – check to make sure there was no such discussion of idea/expression. However, the court's failure to separate the analysis lends little support to the reasoning behind its decision.

⁶³ *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir. 1947).

⁶⁴ *Id.* at 911.

⁶⁵ *Id.* Of course, this is not necessarily the case because if one independently created the forms, then there would be no copyright infringement because no actual copying would have taken place.

⁶⁶ *John H. Harland Co. v. Clarke Checks, Inc.*, 207 U.S.P.Q. 664 (N.D. Ga. 1980).

⁶⁷ *Id.* at 667.

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 971 (11th Cir. 1983) (emphasis added).

⁷¹ *Id.* at 972 (emphasis added).

In 1982, the court in *Januz Marketing Communications, Inc. v. Doubleday & Company, Inc.*⁷² found that charts used to record daily activities were not entitled to copyright protection.⁷³ The two charts at issue are pictured below as Figures 1 and 2.

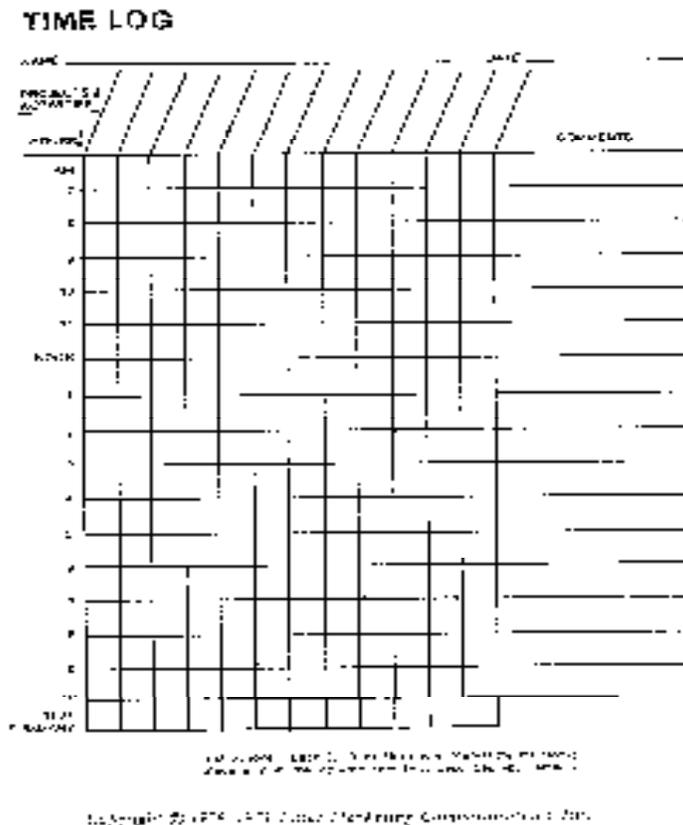


Figure 1

⁷² *Januz Mktg. Communications, Inc. v. Doubleday & Co.*, 569 F. Supp. 76 (S.D.N.Y. 1982).

⁷³ *Id.* at 81.

In 1990, the Ninth Circuit decided *Bibbero Systems, Inc. v. Colwell Systems, Inc.*⁷⁸ and held the plaintiff's blank forms used in medical billing, known as "superbills," were not entitled to copyright protection.⁷⁹ Each superbill contained simple instructions to the patient for filing insurance claims, boxes for patient information, simple clauses assigning insurance benefits to the doctor and authorizing release of patient information, and two lengthy checklists for the doctor to indicate the diagnosis and any services performed, as well as the applicable fee.⁸⁰

The court in *Bibbero* cited *Baker v. Selden* and the Copyright Office's regulation on blank forms and stated that blank forms are generally not copyrightable unless text is integrated with them.⁸¹ The court explained that when "a work consists of text integrated with blank forms, the forms have explanatory force because of the accompanying copyrightable textual material."⁸² The plaintiff argued that its superbills did convey information, but the court rejected this argument finding that "[a]ll forms seek only certain information, and, by their selection, convey that the information sought is important [and that t]his cannot be what the Copyright Office intended by the statement 'convey information.'"⁸³ The court described the superbill's purpose (before it is filled out) as recording information, rather than conveying information about the patient.⁸⁴ The court further found that although there was a great deal of printing on the face of the form – because there were many possible diagnoses and treatments – this did "not make the form any less blank."⁸⁵

The court found that the "text with forms" exception to the blank forms rule was inapplicable, because the instructions to the patient on how to file an insurance claim were "far too simple to be copyrightable as text in and of themselves."⁸⁶ In essence, the instructions were not original. And strictly speaking, although the instructions were not sufficiently original, this statement does not shed any light on whether the forms themselves lacked originality or whether the idea and expression had merged. Reading between the lines however suggests a problem with originality rather than merger.

In 1991, the Second Circuit, in *Kregos v. Associated Press*,⁸⁷ threw yet another twist into the blank forms labyrinth. The court was confronted with whether a blank form used to record statistics about baseball pitchers was entitled to copyright protection. The court paid its due deference to *Baker v. Selden* and noted that courts have split over the issue of whether "forms that include considerable blank space" are capable of copyright protection.⁸⁸ It acknowledged that "a form that conveys no information and serves only to provide blank space for recording information contains no expression or selection of information that could possibly warrant copyright protection."⁸⁹ But then the court made an interesting comment; it stated that copyright

⁷⁸ *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104 (9th Cir. 1990).

⁷⁹ *Id.* at 1105.

⁸⁰ *Id.*

⁸¹ *Id.* at 1106-1107.

⁸² *Id.* at 1107 (citing *Edwin K. Williams & Co. v. Edwin K. Williams & Co.-East*, 542 F.2d 1053, 1061 (9th Cir. 976)).

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Id.* at 1107-1108.

⁸⁶ *Id.* at 1108.

⁸⁷ *Kregos v. Associated Press*, 937 F.2d 700 (2nd Cir. 1991).

⁸⁸ *Id.* at 708 (contrasting, *inter alia*, *Bibbero* with *Harcourt, Brace & World*).

⁸⁹ *Id.*

protection is denied from the failure to convey information because if information is not conveyed, then the form fails to "satisfy even minimal creativity."⁹⁰

In the end, the court found that summary judgment in favor of the defendants was improper because it could not be determined, as a matter of law, that the plaintiff did not display sufficient creativity in selecting the columns and headings used on the pitching form.⁹¹

Kregos is important for two reasons. First, it found that the failure of blank forms to convey information was fatal because of originality, rather than merger. This stands opposite the origin of the Copyright Office's regulation concerning the conveyance of information – *Brown Instrument*, discussed *supra* – and completes the transformation from the merger argument in *Brown Instrument* through the murky period of the decisions in *John H. Harland* and *Januz* to the originality argument in *Kregos*.

The second reason *Kregos* is important is that it drew a distinction between the concept of merger and the blank forms doctrine. Earlier in its opinion, and in a different section with its own analysis, the *Kregos* court recognized that

The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.⁹²

The fact that the *Kregos* court distinguished this section from its blank forms discussion, coupled with the focus on originality in the blank forms section, strongly suggests that the blank forms doctrine is not about merger at all, but rather is purely about originality.⁹³

Having now explored the corridors of the historical maze constituting the blank forms doctrine, it is fitting that the most telling words come from a relatively modern case. As the court in *Advanz Behavioral Management Resources, Inc. v. Mirafior*⁹⁴ stated:

The blank forms rule is problematic. [It] has been criticized on a variety of grounds. It has been argued that the rule is an unwarranted extension of dicta contained in *Baker v. Selden*, that it lacks a consistent rationale, that it is inconsistent with the purposes of the Copyright Act, and that in light of interpretative guidelines issued by the Copyright Office after the 1976 revision of the Copyright Act there is no such rule. These criticisms are justified.⁹⁵

⁹⁰ *Id.* ("When the Copyright Office denies a copyright to scorecards or diaries that 'do not in themselves convey information,' it must be contemplating works with headings so obvious that their selection cannot be said satisfy even minimal creativity.").

⁹¹ *Id.* at 710.

⁹² *Id.* at 705.

⁹³ *See also* *ABR Benefits Services, Inc. v. NCO Group*, 52 U.S.P.Q.2d 1119, 1999 WL 695596 at *2 (E.D. Pa. Sept. 9, 1999) ("The restrained interpretation of the Blank Form Rule followed by the Third Circuit mandates that the relevant inquiry is whether [the forms] are sufficiently innovative and informative such that the Blank Form Rule does not apply.").

⁹⁴ *Advanz Behavioral Mgmt. Resources, Inc. v. Mirafior*, 21 F. Supp. 2d 1179 (C.D. Cal. 1998).

⁹⁵ *Id.* at 1183 (citations omitted).

The court also appropriately concluded that "[a]lthough its origin is clear, the theoretical basis of the blank forms rule is murky."⁹⁶

In *Advanz*, the plaintiff had developed blank medical forms, which are reproduced below as Figures 3 through 7.

MEDICAL SOCIAL SERVICE FOLLOW-UP

AGENCY: _____

BC: _____ Total Follow-Up Date: _____

Reason for Referral: Recommendation for case adjustment (1111) Assist with additional case management implementation of BSS, BSAW, L, R, or other program Provide services L, R Assist in utilization of support systems Counsel for reentry/return to state with DOJ APS referral Other _____

Reason patient being referred: Not on Appeal Not given Not BAC Other _____

Changes since last visit: Explain: _____

DISAGREEMENTS: None Disputed Disputed Disputed Disputed Disputed
 Appointments: _____

PROBLEMS ADDRESSED: _____

RECOMMENDATIONS: _____

ADDITIONAL RESOURCES PROVIDED: _____

OUTCOMES: _____

PLAN: _____

Follow Up: None Yes No Yes No Yes No Yes No Yes No Yes No Yes No

Signature & Title: _____ Date: _____

Supervisor & Title: _____ Date: _____

P. Name: _____ A/RW: _____ SOC Date: _____

Figure 3

⁹⁶ *Id.* at 1184.

MEDICAL SOCIAL SERVICE EVALUATION

AGENCY:

DATE: _____

Referral for Review: Adult Health Services Children's Health Family Support Geriatrics
 Home Planning/PCP Maternity/PCP All School Homeless/PCP
 Community Services Voluntary Health Voluntary Health Homeless/PCP
 Homeless Services Homeless/PCP Homeless/PCP Homeless/PCP

Referral by: Social Services Health Homeless/PCP Homeless/PCP

Priority: Urgent High Medium Low Other

Working Date on: DCI Homeless M Long-term

Agency: Home Homeless/PCP Homeless/PCP Homeless/PCP Homeless/PCP

Other: Homeless/PCP Homeless/PCP Homeless/PCP Homeless/PCP

Support Services: Home Homeless/PCP Homeless/PCP Homeless/PCP Homeless/PCP

Medical Management: Home Homeless/PCP Homeless/PCP Homeless/PCP

Financial Status: Home Homeless/PCP Homeless/PCP Homeless/PCP

Medical Insurance: Home Homeless/PCP Homeless/PCP Homeless/PCP

Program Status: Home Homeless/PCP Homeless/PCP Homeless/PCP

Physical Status: Home Homeless/PCP Homeless/PCP Homeless/PCP

Medical Status: Home Homeless/PCP Homeless/PCP Homeless/PCP

Adjustment to Health: Home Homeless/PCP Homeless/PCP Homeless/PCP

Medical Problems: Home Homeless/PCP Homeless/PCP Homeless/PCP

Additional Problems: _____

Interviewed: Home Homeless/PCP Homeless/PCP Homeless/PCP

Additional Information: _____

Referrals & Consultations (Include name & phone): _____

Comments: _____

Overall Goals: Home Homeless/PCP Homeless/PCP Homeless/PCP

Additional Goals: _____

File: _____

Follow Up: Home Homeless/PCP Homeless/PCP Homeless/PCP

Signature & Title: _____ Date: _____

Signature & Title: _____ Date: _____

Print Name: _____ V.22 2003/04

Figure 6

ground is for truly blank forms (i.e. those forms containing nothing more than blank spaces and are without any accompanying text or instructions). An example of such is shown below as Figure 8.

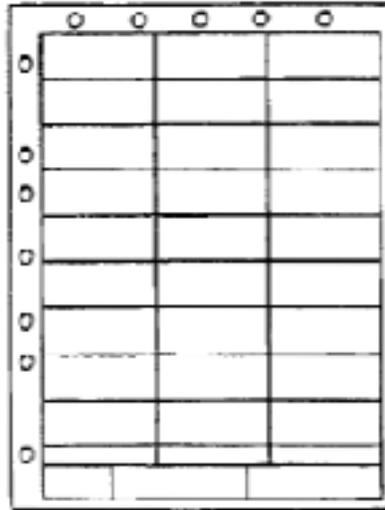


Figure 8

For those cases following the originality basis for the blank forms doctrine, truly blank forms fail to establish the minimum amount of creativity required to be original. For example, in *Kregos*, the court found that sufficient originality could exist in the blank pitching forms by means of the selection of the statistics to emphasize. Yet the *Kregos* court noted that "[o]f course, a form that conveys no information and serves only to provide blank space for recording information contains no expression or selection of information that would possibly warrant copyright protection."⁹⁹ Even a court that had found minimal creativity in a blank form would fail to grant copyright protection to truly blank forms. In fact, the *Advanz* court, which was highly critical of the blank forms doctrine, acknowledged that truly blank forms would not be deserving of copyright protection. The *Advanz* court stated "[p]erhaps *Baker* is best interpreted as authority for the proposition that neither a system nor an entirely blank form (such as ruled paper) is copyrightable in and of itself."¹⁰⁰

On the other hand, for those cases following the merger basis for the blank forms doctrine, truly blank forms fail thereunder too. Truly blank forms are designed for no other basis than to record information and implement an underlying system. Also, because they are truly blank, they convey no information and fail under the Copyright Office's regulation, regardless of the underlying rationale. With these thoughts in mind, we now turn to the equally intriguing world of design patents.

⁹⁹ *Kregos v. Associated Press*, 937 F.2d 700, 708 (2nd Cir. 1991).

¹⁰⁰ *Advanz*, 21 F. Supp. 2d at 1184.

III. DESIGN PATENT PROTECTION FOR BLANK FORMS

A. General Requirements for Design Patent Protection

Since 1842 and under the authority of the "Intellectual Property Clause" of the U.S. Constitution,¹⁰¹ Congress has afforded patent protection for designs.¹⁰² The current Patent Act provides protection to those who invent "any new, original and ornamental design for an article of manufacture."¹⁰³ In addition to these requirements, the design must also be nonobvious.¹⁰⁴ Each of these elements are explored in detail below.

1. Originality

Though rarely discussed by the courts, the concept of originality refers to only granting a patent to the inventor who actually invented the design. The originality requirement protects the true inventor and the public by preventing "one to harvest what another has sown."¹⁰⁵ One purpose of the originality requirement is to limit patent monopolies to those who have undertaken the efforts to produce the design and who wish to have the patent rights conferred upon them.¹⁰⁶

Similar to the originality requirement of copyright law, but less discussed, there is an associated creative spark necessary for design patent protection. As stated by the Ninth Circuit, "[although] it is difficult to characterize the inventive features necessary to a valid design patent, it is clear that there must be originality which is born of inventive genius. In other words, there must be more than mere mechanical skill and the completed article must rise above the ordinary."¹⁰⁷ The court then held that the design in question, a metal drawer handle, was not new and that "the small differences between the design in question and prior designs are well within the creative ability of the ordinary designer."¹⁰⁸ This was echoed years later when a district court noted that originality connotes something that has been created and it signifies something which is the converse of commonplace.¹⁰⁹ Or as characterized by one commentator, "[d]esign patents are supposed to reward a significant level of creativity."¹¹⁰

Although not discussed in the cases nearly as much as the originality requirement for copyright, the concept of design patent originality shares this common thread of creativity with the originality requirement for copyright.¹¹¹

¹⁰¹ U.S. Const., art. I, § 8, cl. 8.

¹⁰² Thomas B. Lindgren, *The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compro v. Day-Brite Lighting, Inc. and Sears, Roebuck & Co. v. Stiffel Co.*, 10 OKLA. CITY L. REV. 195, 202 (Summer 1985). This is the same Constitutional clause granting Congress the power to grant copyright protection.

¹⁰³ 35 U.S.C. § 171 (2000).

¹⁰⁴ *See id.* at § 103, which is incorporated by reference into § 171, which provides that "[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

¹⁰⁵ 1 Donald Chism, *Chism on Patents* § 2.01 (2006).

¹⁰⁶ *Id.*

¹⁰⁷ *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.*, 287 F.2d 228, 229-230 (9th Cir. 1961).

¹⁰⁸ *Id.* at 230.

¹⁰⁹ *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp. 1257, 1261 (S.D.N.Y. 1975).

¹¹⁰ Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1401 (June/August 1987).

¹¹¹ *See supra* Part II.A.

2. *New (or Novelty)*

Just as with originality, courts rarely give more than a fleeting nod of acknowledgement to the novelty requirement of design patents – instead diving headfirst into the non-functional and non-obvious requirements. The requirement that a design be new or novel "is tested by determining the impact of the design upon an ordinary observer. A design patent is novel when the average observer takes the new design for a different, and not a modified already existing design."¹¹² Stated another way, the design viewed as a whole must produce a new impression upon the eye.¹¹³

3. *Ornamental (or Non-Functional)*

One of the main issues, if not the main issue, concerning design patent invalidity is that of the ornamental and non-functional requirement. The ornamental requirement means that the design must not be governed solely by function.¹¹⁴ Thus, if the design claimed is dictated solely by the function of the article of manufacture, the design is invalid for want of being ornamental.¹¹⁵

It is important to note the distinction between the functionality of the article of manufacture and the functionality of the particular design of the article of manufacture.¹¹⁶ If this distinction were not drawn, then it would be impossible to obtain a design patent on utilitarian articles of manufacture, which is clearly not the case.¹¹⁷

One method of determining whether a design is functional is to see if alternative designs are available.¹¹⁸ If so, then a design may not be dictated solely by function.¹¹⁹ This test for functionality should sound familiar as it is similar to the test used for merger in the copyright context.¹²⁰

4. *Non-Obviousness*

The non-obviousness requirement for utility patents¹²¹ has been incorporated by reference into the design patent statute.¹²² The non-obvious bar in the Patent Act mandates that a patent not be granted when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

¹¹² Clark Equip. Co. v. Keller, 570 F.2d 778, 799 (8th Cir. 1978), *cert. denied*, 439 U.S. 825 (1978).

¹¹³ Horwitt, 388 F. Supp. at 1260.

¹¹⁴ Seiko Epson Corp. v. Nu-Kote Int'l, Inc., 190 F.3d 1360, 1368 (Fed. Cir. 1999).

¹¹⁵ Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566 (Fed. Cir. 1996).

¹¹⁶ Avia Group Int'l, Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563 (Fed. Cir. 1988).

¹¹⁷ *Id.*

¹¹⁸ *Best Lock*, 94 F.3d at 1566.

¹¹⁹ *Id.*; *see also* L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir. 1993) ("When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose."); *but see* PHG Technologies, LLC v. The St. John Cos., 2006 WL 3334937, *3-5 (Fed. Cir. Nov 17, 2006) (noting that although alternative designs are relevant, an inquiry should also be made as to whether the alternative designs could adversely affect the utility of the specified article).

¹²⁰ *See supra* notes 23-24 and accompanying text.

¹²¹ 35 U.S.C. § 103 (2000).

¹²² *Id.* at § 171; *see also* Chism, *supra* note 105 at § 23.03[6] (formerly § 1.04[2][f]).

invention was made to a person having ordinary skill in the art to which said subject matter pertains."¹²³

When assessing obviousness in the design patent context, the courts have openly admitted that this is a subjective determination.¹²⁴ To help determine whether a design is obvious, the following factors may be used: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art, when the invention was made; and (4) secondary indicia, such as commercial success and copying.¹²⁵

B. Blank Forms Receiving Design Patent Protection

Design patents have been granted to truly blank forms. In addition to Figure 8, *supra*, below are several drawings corresponding to design patents issued within the last two decades.



Figure 9¹²⁶

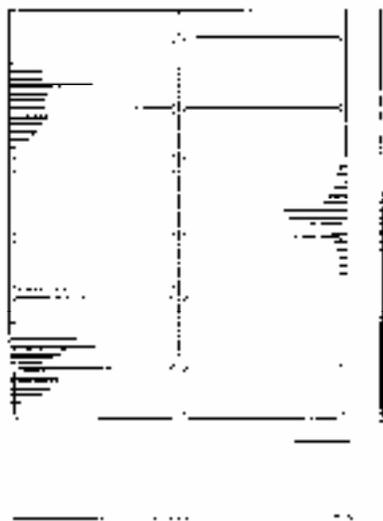


Figure 10¹²⁷

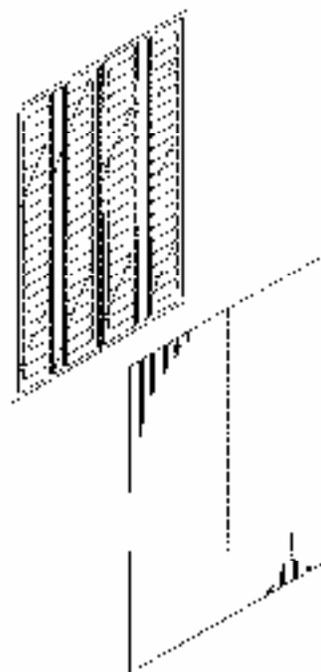


Figure 11¹²⁸

¹²³ 35 U.S.C. § 103(a) (2000). There appears to be a split amongst the circuits on the proper perspective to use in analyzing obviousness in the design patent context. *See Sidewinder Marine v. Starbuck Kustom Boats*, 597 F.2d 201, 208 (10th Cir. 1979). Some circuits view obviousness from the perspective of an "ordinary intelligent man" whereas others use the "worker of ordinary skill in the art" or "ordinary designer" standard. *Id.* This issue is beyond the scope of this article and because it does not affect the analysis of this article, I merely note it as a point of interest.

¹²⁴ Chism, *supra* note 105 at § 23.03[6] (formerly § 1.04[2][f]).

¹²⁵ Avia Group Int'l, Inc. v. L.A. Gear California, Inc., 853 F.2d 1557, 1563-1564 (Fed. Cir. 1988).

¹²⁶ U.S. Patent No. D473,264 (Apr. 15, 2003) (label form).

¹²⁷ U.S. Patent No. D448,404 (Sept. 25, 2001) (address label sheet).

¹²⁸ U.S. Patent No. D423,044 (Apr. 18, 2000) (tab compatible divider label sheet).

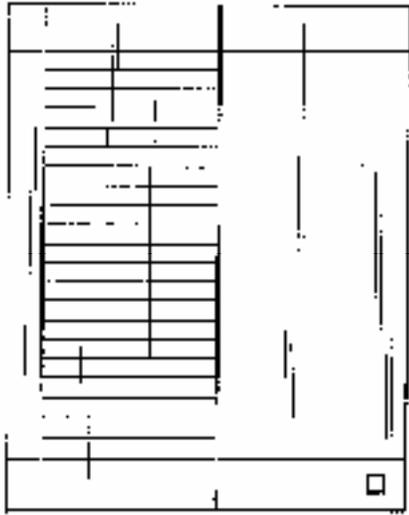


Figure 12¹²⁹

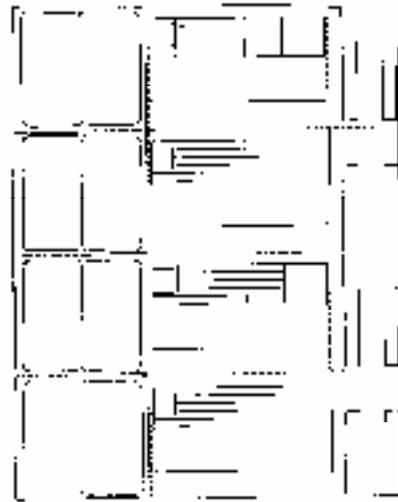


Figure 13¹³⁰

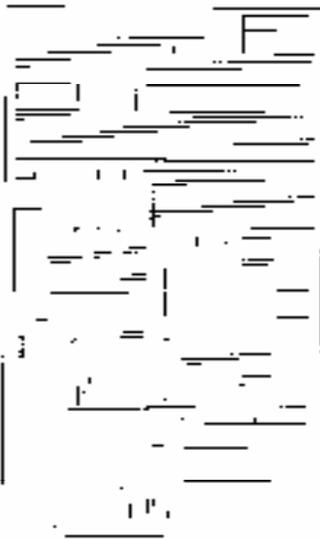


Figure 14¹³¹



Figure 15¹³²

The validity of the design patents pictured in Figures 9 through 15 have not been contested. However the validity of the design patent at issue in Figure 8 was recently litigated in

¹²⁹ U.S. Patent No. D312,654 (Dec. 4, 1990) (paper sheet).

¹³⁰ U.S. Patent No. D418,538 (Jan. 4, 2000) (multi-label mailing form sheet).

¹³¹ U.S. Patent No. D343,416 (Jan. 18, 1994) (business form).

¹³² U.S. Patent No. D415,792 (Oct. 26, 1999) (blank sheet for practicing writing).

PHG Technologies, LLC v. The St. John Companies.¹³³ In *PHG*, the plaintiff offered software products to hospitals for use in tracking patients and costs.¹³⁴ Along with this software, the plaintiff also sold labels used to record medical chart data and patient identification information.¹³⁵ At first, these two sets of labels were offered separately, but the plaintiff eventually combined these two to create the label shown in Figure 8.¹³⁶ The plaintiff applied for, and eventually obtained, design patents for the ornamental design for a label pattern for a medical label sheet.¹³⁷

The defendant, plaintiff's competitor, also sold medical patient identification labels and copied the plaintiff's labels under the belief that "hospitals buy medical labels based on their function, not their ornamentation."¹³⁸ After learning of the defendant's copying, the plaintiff sent a cease and desist letter, but the copying continued and litigation ensued.¹³⁹

Ruling on the plaintiff's motion for a preliminary injunction and the defendant's motion for partial summary judgment, the district court examined and upheld the validity of the design patents. The defendant argued that the design patents were invalid because the designs were primarily functional rather than ornamental.¹⁴⁰

The district court in *PHG* set forth the basic elements for design patents protection, but immediately seized upon the functionality argument.¹⁴¹ The purported ornamental features of the form were the size and placement of labels on the sheet, but the defendant argued that the placement of different-sized labels on the form was driven purely by function in label use and the cost of manufacture.¹⁴² After setting forth the test for functionality and noting that "[i]f there are several ways to achieve the function of the article of manufacture, the design is more likely to serve a primarily ornamental purpose," the court found there were "a multitude of ways to arrange different sizes of labels on an 8 ½ x 11 sheet."¹⁴³ The court also briefly addressed the novelty issue by finding that placing various sizes of labels at the bottom of the sheet is what distinguished the plaintiff's ornamental design from the prior art.¹⁴⁴ Presumably, this variation in the form was also not obvious to the "ordinary intelligent man" or the "ordinary designer."¹⁴⁵ The court did not address originality in reaching its conclusion.¹⁴⁶

The defendant appealed and the Federal Circuit vacated the preliminary injunction.¹⁴⁷ The Federal Circuit held that the district court had erred in concluding the plaintiff had met its burden of proving a likelihood of success of the merits.¹⁴⁸ The district court's error was that it

¹³³ *PHG Technologies, LLC v. The St. John Cos.*, 2005 WL 3301601 (M.D. Tenn. Dec. 5, 2005); *vacated by PHG Technologies, LLC v. The St. John Cos.*, 2006 WL 3334937 (Fed. Cir. Nov 17, 2006).

¹³⁴ *Id.* at *1.

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.* at *1-2.

¹³⁸ *Id.* at *2-3.

¹³⁹ *Id.* at *3.

¹⁴⁰ *Id.* at *5.

¹⁴¹ *Id.* at *4-5.

¹⁴² *Id.* at *5.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *See supra* note 123.

¹⁴⁶ The same court engaged in an identical analysis in a companion case involving the same plaintiff, but different defendants. *PHG Technologies, LLC v. Timemed Labeling Sys., Inc.*, 2006 WL 2670967 (M.D. Tenn. Sept. 18, 2006).

¹⁴⁷ *PHG Technologies, LLC v. The St. John Cos.*, 2006 WL 3334937, *7 (Fed. Cir. Nov 17, 2006).

¹⁴⁸ *Id.*

had ignored evidence that the label's placement served a functional purpose and did not examine if the alternative designs would adversely affect the label's utility.¹⁴⁹ Although obviously not a favorable ruling for the plaintiff, the validity of the design patent is still in effect and sufficient evidence could be presented at trial to overcome the functionality flaw. Importantly, the Federal Circuit did not hold that truly blank forms are categorically denied design patent protection. Therefore, even if the design patent in *PHG* is eventually found to be invalid, the possibility for another truly blank form to receive design patent protection remains.

IV. A COMPARISON BETWEEN THE STANDARDS FOR COPYRIGHT AND DESIGN PATENT PROTECTION

Having explored the general requirements of copyrights and design patents and the historical developments of the blank forms doctrine, it will be helpful to compare a few additional significant similarities and differences between copyrights and design patents before exploring the inherent inconsistency in the law denying copyright protection to truly blank forms, but granting design patent protection.

A. Obtaining Protection and Withstanding Challenges to Validity

It is generally recognized that design patents are more difficult to obtain than copyrights. As Professor Wiley noted, courts confronted by the defense that a work is not sufficiently original "agree that copyright law demands less originality than does the law of patent."¹⁵⁰ Reemphasizing this point, another commentator once stressed that "[w]hat we now have is too easy protection of some designs through copyright. Other designs come into design patent, which, as coldly viewed by the courts, is too hard."¹⁵¹

The belief that design patents are more difficult to obtain is based not only upon the fact that copyright protection attaches automatically upon creation¹⁵² whereas to secure design patent protection, one must file a patent application¹⁵³ and pay the prescribed fees.¹⁵⁴ As described *supra*, design patent protection requires overcoming several hurdles – originality, novelty, non-obviousness, ornamental/non-functionality – but copyright only requires that a modicum of creativity be exercised and the work not be copied from someone else.

Another reason design patents are, and should be, harder to obtain is that design patent protection is broader than copyright protection.¹⁵⁵ Copyright only protects one from copying.¹⁵⁶ If one independently creates an identical work, then copyright infringement has not occurred.¹⁵⁷ "However, an inventor who produces something already patented infringes the patent regardless of his knowledge of its existence."¹⁵⁸ This wider scope of protection - the power to prohibit

¹⁴⁹ *Id.* at *5.

¹⁵⁰ John Shepard Wiley, Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119, 133 (Winter 1991).

¹⁵¹ Brown, *supra* note 110 at 1404.

¹⁵² 17 U.S.C. § 302(a) (2000) ("Copyright in a work created on or after January 1, 1978, subsists from its creation.").

¹⁵³ 37 C.F.R. § 1.41 (2004).

¹⁵⁴ *Id.* at § 1.17.

¹⁵⁵ *Schnadig Corp. v. Gaines Mfg. Co.*, 620 F.2d 1166, 1167-1168 (6th Cir. 1980). The broadness of design protection should not be confused with the duration of protection, in which copyright clearly provides more protection. Compare 35 U.S.C. § 173 (2000) with 17 U.S.C. §§ 302, 303 and 304 (2000).

¹⁵⁶ *Schnadig Corp.*, 620 F.2d at 1168, n.3.

¹⁵⁷ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-346 (1991).

¹⁵⁸ *Schnadig Corp.*, 620 F.2d at 1168, n.3.

unintentional copying - strengthens the rationale for imposing additional burdens upon design patents.

Finally, attacking a patent's validity is more difficult than attacking the validity of a copyright. A patent is presumed valid.¹⁵⁹ Invalidity of a design patent must be established by clear and convincing evidence.¹⁶⁰ On the other hand, when attacking the validity of a copyright, the copyright owner is only entitled to a presumption of validity when the work was registered with the Copyright Office within five years of its first publication.¹⁶¹ The Copyright Act further grants the court discretion to determine the weight to be given to the certificate of registration.¹⁶² Although the courts have not set forth a definitive standard for the burden of proof that the defendant must meet to force the burden back to the plaintiff, it appears that the courts do not require a clear and convincing standard as is required for design patents.¹⁶³ As the Third Circuit noted, "the burden on the defendant to rebut the presumption varies depending on the issue bearing on the validity of the copyright," but in some situations evidence must be presented, while in others it is only necessary to show that the Copyright Office erroneously applied the copyright laws in registering the work.¹⁶⁴ As to questions regarding the copyrightability of certain works, it has been suggested that the courts are in as good a position as the Copyright Office to consider these questions and that in these situations the presumption of validity "is of real little force."¹⁶⁵ Thus, the heightened standard for invalidating design patents is yet another reason why design patents are, and should be, more difficult to obtain than copyrights.

B. Infringement Standards

Another important similarity when comparing blank forms in the copyright context with those in the design patent context is the standard for determining infringement. In a copyright infringement action, the standard used to determine whether infringement has taken place is whether the alleged infringer's work is substantially similar to the alleged infringed work.¹⁶⁶ Determining substantial similarity is viewed from the perspective of an ordinary lay person.¹⁶⁷

For design patents, the standard for proving infringement requires "that the accused design is substantially the same as the claimed design" and "the criterion is deception of the ordinary observer, such that one design would be confused with the other."¹⁶⁸ Just as in the

¹⁵⁹ 35 U.S.C. § 282 (2000); *see also* *Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1562 (Fed. Cir. 1988).

¹⁶⁰ *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993); *see also* *Avia Group Int'l*, 853 F.2d at 1562.

¹⁶¹ 17 U.S.C. § 410(c) (2000).

¹⁶² *Id.*

¹⁶³ *See* *Express, LLC v. Fetish Group, Inc.*, 424 F. Supp. 2d 1211, 1219 (C.D. Cal. 2006) ("The presumption of validity orders the burden of proof[,] it does not create the same strong presumption of validity that attaches to patents.").

¹⁶⁴ *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668-669 (3rd Cir. 1990).

¹⁶⁵ *Id.* at 669 n.7 (citing *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 414 (2nd Cir. 1985)).

¹⁶⁶ *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 207-208 (3rd Cir. 2005).

¹⁶⁷ *Id.* at 208.

¹⁶⁸ *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124 (Fed. Cir. 1993); *see also* *Gorham Co. v. White*, 81 U.S. (14 Wall) 511 (1871); *Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988); *Horwitt v. Longines Wittnauer Watch Co.*, 388 F. Supp. 1257, 1263 (S.D.N.Y. 1975).

copyright context,¹⁶⁹ it is not necessary for the accused product and the product protected by a design patent to be identical; it is sufficient to show substantial similarity of appearance.¹⁷⁰

The similarity between the tests for infringement in the copyright and design patent contexts is striking. Although the test for design patent infringement leans toward confusion of the ordinary observer, the focus on substantial similarity between work draws copyright law and design patents law closer together, causing different treatment of similar subject matter to be questioned.

V. THE INCONSISTENCY

It should now be clear that a glaring inconsistency exists between the treatment of truly blank forms in the copyright and design patent contexts. Copyright's blank forms doctrine, whether based on a lack of originality or the merger doctrine, denies protection to truly blank forms.¹⁷¹ In contrast, design patents, based on the same Constitutional authority¹⁷² and maintaining the same general principles of originality and merger¹⁷³ affords protection to truly blank forms.¹⁷⁴ Despite the similarity of the rules governing these two fields and the underlying policies for those rules, the lack of parity in the treatment of truly blank forms is questionable and confusing.

This is not to say that copyright protection and design patent protection are or should be one in the same. In fact, the differences between the two disciplines has led to the conclusion that design patents are, and should be, more difficult to obtain.¹⁷⁵ Again, this raises the question of why design patents afford protection to truly blank forms, whereas copyright, with a low threshold for protection, refuses to extend to truly blank forms.

Consistency between the application of closely related legal rules sharing a common origin is not normally a hotly debated issue in the absence of a logical reason for treating the same situations differently. In the case of truly blank forms, there does not appear to be any logic in denying copyright protection, but granting design patent protection. The treatment of truly blank forms should be consistent under copyright and design patent laws. If different treatment were appropriate, it should be reversed so truly blank forms are protected by copyright, and unprotected by design patents.

VI. POTENTIAL SOLUTIONS

To bring copyright and design patent law into agreement over the treatment of truly blank forms, there appears to be two options: eliminate design patent protection for truly blank forms or expand copyright protection to truly blank forms. Each option has its own associated costs and benefits. This article does not seek to make a determination as to which option is best, but instead lays out the pros and cons of each choice in an effort to cause Congress, the Patent and

¹⁶⁹ *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2nd Cir. 1980) ("We have frequently held that where such substantial similarity is found, slight differences between a protected work and an accused work will not preclude a finding of infringement.").

¹⁷⁰ Lindgren, *supra* note 102 at 215.

¹⁷¹ *See supra* Part II.B.2.c.

¹⁷² U.S. Const., art. I, § 8, cl. 8.

¹⁷³ *See supra* Part III.A.1 and notes 118-120 and accompanying text.

¹⁷⁴ *See supra* Part III.B.

¹⁷⁵ *See supra* Part IV.A.

Trademark Office, the Copyright Office, or the courts to reevaluate the law's treatment of truly blank forms and judge what is an appropriate solution.

A. Eliminate Design Patent Protection for Blank Forms

One reason for prohibiting design patents for truly blank forms is that it is an easy rule to implement. As described above, truly blank forms are those forms containing nothing more than blank spaces and are without any accompanying text or instructions.¹⁷⁶ A regulation promulgated and adopted by the Patent Office or an amendment to the Patent Act based on the theories set forth in this article could be simple and straightforward. On the other hand, this leaves open the conundrum of what should be done about forms that are not truly blank. As seen in the copyright context, this has caused confusion and a circuit split over what type of blank forms are protected.¹⁷⁷

Another benefit of eliminating design patent protection for truly blank forms is that once these forms are created, they automatically enter the public domain. Thus, the public is free to use the forms, adapt them, and use them as a springboard for improvements.¹⁷⁸ These adaptations and improvements are the progresses of science and the useful arts that the Intellectual Property Clause of the Constitution strives for.¹⁷⁹ But to claim that elimination of design patents would effectuate this Constitutional provision would be to read the clause too narrowly. This Intellectual Property Clause provides that Congress shall have the power "[t]o promote the Progress of Science and useful Arts, *by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.*"¹⁸⁰ The prelude to promoting adaptations and improvements is that the author or inventor was given the opportunity to reap the benefits of the creation before it passed into the public domain. If truly blank forms were no longer provided design patent protection, then this prelude would not exist and the Intellectual Property Clause would not be effectuated.

Closely related to this point is that if design patent protection was no longer afforded to truly blank forms, then inventors would, in theory, have less incentive to develop these types of forms. Without the incentive of design patent protection, there would, in theory, be a decrease in the development of truly blank forms, from which the public would no longer be able to use, adapt, and improve. However, this theory must be balanced with the argument that blank forms are generally used in industries to help with efficiency and productivity and this is what really drives the creation of truly blank forms. Without empirical data or further research, the elimination or reduction of incentive is speculative.

Lastly, eliminating design patent protection for truly blank forms may lead to a decrease in patent infringement prosecution and litigation, thus freeing up administrative and judicial

¹⁷⁶ See *supra* Part II.B.2.c.

¹⁷⁷ See *supra* Part II.B.2.b.

¹⁷⁸ See Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966-967 (Fall 1990) ("[T]he very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea.").

¹⁷⁹ U.S. Const., art. I, sect. 8, cl. 8.

¹⁸⁰ *Id.* (emphasis added).

resources.¹⁸¹ However, with respect to design patent litigation, it should be noted that very little truly blank form design patent litigation has taken place.¹⁸²

B. Expand Copyright Protection to Truly Blank Forms

The other option to resolve the inconsistency is to expand copyright protection to truly blank forms. As discussed *supra*, the blank forms doctrine is already highly criticized and confusing.¹⁸³ The Ninth Circuit's decision in *Bibbero* compounds this and has been reluctantly followed by its district courts.¹⁸⁴ Expanding copyright protection to truly blank forms would moot the split amongst the circuits as to which forms convey information and which do not.

Just as eliminating design patent protection for truly blank form would be easy to implement, expanding copyright protection would be equally simple. But unlike the design patent solution, expanding copyright protection would not create new problems for blank forms that are not truly blank.¹⁸⁵

Opposite the argument made in support of and in criticism of denying design patent protection to truly blank forms is the argument that expanding copyright protection would provide an additional incentive for form creators to exercise their talents and create new forms.¹⁸⁶ The fact that some industries create truly blank forms as a matter of efficiency and productivity would not reduce the incentive to create new forms.¹⁸⁷ On the other hand, if copyright protection is expanded, then less works are placed in the public domain, which may delay creativity (e.g. transformation, adaptations, improvements), thus depriving the public good.¹⁸⁸ Of course, granting thin copyright protection to truly blank forms might provide some relief.¹⁸⁹

As discussed *supra*, there is already a fair amount of blank form copyright litigation that has taken place over the last century.¹⁹⁰ If copyright protection were expanded to truly blank forms (and blank forms generally), there could be an increase in blank forms litigation, thus draining more judicial resources. However, granting thin copyright protection to blank forms might also help in this regard.

Lastly, expanding copyright protection to truly blank forms might also have the effect of freeing up resources at the Copyright Office. If examiners were not required to engage a blank

¹⁸¹ See Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy* 12-13 (Oct. 2003) ("The PTO's resources also appear inadequate to allow efficient and accurate screening of questionable patent applications."). In 2005, there were 25,553 design patent applications filed of which 12,950 were granted. U.S. Patent Statistics Chart Calendar Years 1963-2005 *available at* http://www.uspto.gov/go/taf/us_stat.htm (last modified Sept. 25, 2006). There has been a steady increase in design patent applications over the last forty years. *Id.*

¹⁸² *But see supra* notes 133-149 and accompanying text.

¹⁸³ *See supra* Part II.B.2.b.

¹⁸⁴ *See generally* *Advanz Behavioral Mgmt. Resources, Inc. v. Mirafior*, 21 F. Supp. 2d 1179 (C.D. Cal. 1998); *Calyx Technologies, Inc. v. Ellie Mae, Inc.*, 2005 WL 2036918 (N.D. Cal. 2005).

¹⁸⁵ *See supra* note 177 and accompanying text.

¹⁸⁶ *See supra* Part VI.A.

¹⁸⁷ *Id.*

¹⁸⁸ *See supra* note 178 and accompanying text.

¹⁸⁹ *See Express, LLC v. Fetish Group, Inc.*, 424 F. Supp. 2d 1211, 1227 (C.D. Cal. 2006)("[T]hin copyright may be established where some small amount of creativity exists beyond the combination of standard elements, but not enough creativity to qualify for broad protection. 'Thin' copyright protection guards only against virtually identical copying.").

¹⁹⁰ *See generally supra* Part II.B.2.b.

forms analysis, which is admittedly confusing and burdensome, more time and money could be spent addressing other copyright concerns.

VII. CONCLUSION

The law should strive to be consistent and rational. Without these qualities, those living under it will fail to appreciate and respect it. The blank forms doctrine, with its vague underpinnings and muddled history has been interpreted inconsistently, but clearly prevents truly blank forms from being afforded copyright protection.

Design patents, on the other hand, have been freely granted to truly blank forms – a level where copyright protection does not extend. Given the general agreement that design patents are, and should be, more difficult to obtain, it appears that the law has turned itself completely backwards with respect to truly blank forms. This backwards state of affairs has produced an inconsistent and irrational result where copyright law, with its low threshold, rejects protection for truly blank forms whereas design patents, with its higher burden, accepts truly blank forms with open arms. There is no rational explanation for this inconsistency.

Fortunately, there are solutions. To harmonize copyright and design patent law with respect to truly blank forms, two options exist – eliminate design patent protection for truly blank forms or expand copyright protection to truly blank forms. The costs and benefits of each have been set forth and there are various methods for implementing the choice, whichever it may be. Ultimately, a choice should be made. Without one, the law will continue to be inconsistent and irrational, thus weakening society's appreciation and respect for the rule of law.