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Phantom Rules: The USPTO's Disruptive Denial of Trademark Protection in New Communicative Spaces

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Book Review: Research Handbook on Design Law. Henning Hartwig, ed.

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BOOK REVIEW*

*By Elisabeth Kasznar Fekete***

Research Handbook on Design Law. Henning Hartwig, ed. 2021. Pp. 556. \$339 (hardback); \$65 (eBook). Edward Elgar Publishing Limited, The Lypiatts, 15 Lansdown Road, Cheltenham, Glos GL50 2JA, UK.

Understanding the legal protection, licensing, and enforcement of designs requires a systematic approach to other legal fields, in particular competition law and consumer law, as design became an omnipresent factor in the sale of products in the last several decades. Dynamic and competitive markets require manufacturers' efforts to enhance their products' attraction power, both in physical retail settings and e-commerce. An expanded knowledge of trademarks and copyrights (as well as correlated areas such as marketing and branding) is essential to provide guidance on the scope, rules, and procedures concerning industrial designs, a category of intellectual property rights ("IPRs") defined by the World Intellectual Property Organization ("WIPO") as "the ornamental aspect of an article" that "may consist of three-dimensional features, such as the shape of an article, or two-dimensional features, such as patterns, lines or colors,"¹ protected under patent law as "design patents" in some jurisdictions and under industrial design law as a "registered design" in others.

The editor and authors of *Research Handbook on Design Law* attentively captured much more than legal concepts, analyzing the protection of designs from their origin to their functions, parameters, principles, and limits. Not forgetting to present how case law addresses issues such as authorship and use as well as issues of specific markets, among which the commerce of automobile spare parts has been one of the most discussed, this book addresses designs in a comprehensive way. The book does this mainly from the perspective of European Union ("EU") and United States ("U.S.") laws but also focuses on design-related international treaties.

Obtaining effective protection of designs, which, as mentioned above, can intersect with other forms of intellectual property rights,

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¹ *Industrial Designs*, World Intell. Prop. Org., <https://www.wipo.int/en/web/designs> (last visited Sept. 19, 2024).

including trademarks and copyrights, requires a multidisciplinary view of practical and legal measures, including prevention, injunctive relief in trials, equitable defenses, and exceptions.

Henning Hartwig, both the book's editor and one of its authors, is a specialized attorney and a member of the Expert Committee on Design Law of the German Association for the Protection of Intellectual Property. Hartwig has skillfully assembled the input of fifteen contributors from various jurisdictions, including Germany, Hungary, Switzerland, Poland, the United Kingdom, and the United States, with a variety of professional backgrounds. For instance, the experience of two human factors engineers with psychology, ergonomics, and biomechanics adds an even more relevant contribution to the book when they document the neuroscientific aspects of designs.

This treatise has sixteen chapters in five parts. Entitled "*FOUNDATIONS*," Part I of the book starts with Bernard Volken setting the fundamental boundaries of design law in Chapter 1, "*Requirements for design protection: global commonalities*," lecturing on (i) the definition of design—i.e., "*the form of appearance of a product or parts thereof*" and correlate terms;² (ii) the players interested in the financial rights associated with designs, including the designer and the holder of the rights; (iii) the international standardization of the form of representation of the design application; (iv) how the priority claim granted by the Paris Convention for the Protection of Industrial Property works for designs; and (v) validity of the applications according to novelty, individual character, and non-obviousness criteria as well as other related concepts such as copyright and patent basics.

Chapter 2, "*Trends in functionality jurisprudence: U.S. and E.U. design law*," provides an ample comparative analysis of the recent case law on functionality, mainly naming the differences between U.S. design patent law and EU design law, clearly explaining the main nuances of both jurisdictions regarding the application of the functionality doctrine—marked by a bifurcated approach in U.S. case law with the conflict of validity against scope functionality, in which the courts' focus shifts from direct inquiries into ornamentality. The chapter is well-illustrated by Jason J. Du Mont and Mark D. Janis with studies of cases such as *Ethicon* and *Sport Dimension v. The Coleman Co.*, discussing an approach delineating mostly the aesthetic aspect of designs, instead of solely their technical function.

In Chapter 3, "*Easier to see than to say: catching the elusive spirit of design in a net of words*," David Musker provides an overview of the challenges faced by judges to successfully compare two distinct designs, considering the difficult task of verbally

² Research Handbook on Design Law 2 (Henning Hartwig ed., 2021).

describing the imagery that composes the designs and the necessity of allaying the existing dichotomy between analyzing the designs at stake in a judicial case by their overall impression and dissecting their essential and unessential features.

Part II, titled “*METHODOLOGICAL PERSPECTIVES*,” opens with Chapter 4, “*Reciprocity in European design law*.” Discussing a series of examples of judicial decisions, the book’s editor, Henning Hartwig, now in an author role, examines the potential conflicts among the various interested parties regarding the rights on a design and explains the relationship between the parameters of prior art, validity, scope of protection, infringement, and degree of freedom of the designer, concluding that “it seems to be well accepted in European design law, but also in other countries overseas, that there is a clear interaction between scope of protection and infringement—the broader the scope, the higher the hurdle for the accused infringer to avoid infringement (and vice versa).”³ Further, Hartwig addresses the delicate balance of redefining and recreating a design, and the result of this change on the impression of the final consumers and the affected market sectors. To do so, Hartwig delivers an interesting analysis of the automotive market by studying the case of the Mercedes Benz S-CLASS automobile.

Anna Tischner delves into the technical definitions of fundamental concepts of the designers’ and design owners’ rights in Chapter 5, “*Design rights and designer’s rights in the EU*.” Among the principles discussed are personal interest versus ownership of the design, joint designership, design by commission, and transferring and licensing of design rights—with the author concluding that the autonomous character of these concepts poses a challenge to the application of design rights in the EU.

Chapter 6, “*Enablement and indefiniteness in U.S. patents after In re Maatita and Ex parte Kaufman*,” analyzes U.S. case law with a view to explore whether a single two-dimensional view of a design that covers three-dimensional aspects of a design can satisfy the enablement and definiteness requirements, after the decisions of *In re Maatita* and *Ex parte Kaufman*. Both cases involved design patent applications filed before the USPTO for sneaker soles. Margaret Polson shares strategic thoughts with regard to the standards placed by the United States Patent and Trademark Office (“USPTO”) on the drawings that the applicant must submit with its application for a design patent, including an analysis of the drawings’ elements such as two-dimensional views of three-dimensional embodiments of the object, contours, and solid lines versus broken lines, since these elements can result in a broader or narrower claim scope.

³ *Id.* at 127.

Part III, “*ESTABLISHING AND ENFORCING PROTECTION*,” relies on broad research to ascertain the boundaries of the protection applicable to designs. Chapter 7 of the book, entitled “*Protection of designs on the basis of use*,” by Estelle Derclaye, approaches the relevant question of unregistered design protection in the EU and U.K. The following chapter, written by Henning Hartwig, explores the concept of the priority claim in the Community Design law system, again drawing comparisons between the EU and the U.S. legal systems.

Chapter 9, “*Enforcing design rights through Europe*,” addresses the “*fairly consistent but far from uniform*” enforcement of designs when infringed in the EU’s Member States.⁴ Annette Kur’s chapter covers key questions concerning applicable jurisdiction and substantive law compatible with international design infringement cases.

Part IV, titled “*CRITICAL ISSUES*,” raises three distinct, relevant topics of debate on design law. In Chapter 10, “*Protection of spare parts in design law: a comparative law analysis*,” Annette Kur and Ádám György consider the protection of spare parts, a field where IP law and competition law meet, and compare several jurisdictions and their approaches to the referred problem, which ranges from granting spare parts full and unrestricted protection to granting no protection at all. Tracy-Gene G. Durkin devotes Chapter 11 to “*Design protection for graphical user interfaces*,” by discussing design protection of graphical user interfaces, drawing interesting comparisons between distinct jurisdictions, and analyzing the cases of Samsung’s GALAXY and Apple’s iPhone interface designs. In Chapter 12, “*‘Mast-Jägermeister’ before the Court of Justice of the EU: what the outcome really means*,” Henning Hartwig analyzes the case *Mast-Jägermeister SE v. European Union Intellectual Property Office (EUIPO)*,⁵ in which the Court of Justice of the European Union (the “CJEU”) addressed the issue of the clarity of Mast-Jägermeister’s applications to register beakers as Community Designs.

Part V of the book, “*TRANSNATIONAL AND COMPARATIVE DIMENSIONS*,” starts with Chapter 13, “*International design law policies: present and future*,” by Robert Mirko Stutz. This chapter is particularly useful to readers of any jurisdiction, as it summarizes the global context of international registration under the Hague Agreement, Geneva Act, and Locarno Agreement regimes. This chapter describes the relationship of several countries with these treaties and the changes that the proposal for a Design Law Treaty would represent internationally.

⁴ *Id.* at 291.

⁵ Judgment of July 5, 2018, *Mast-Jägermeister SE v. European Union Intellectual Property Office (EUIPO)*, C-217/17 P, ECLI:EU:C:2018:534.

Attorneys and judges dealing with trademarks will find that Chapter 14, “*Three-dimensional trademarks and designs: comparison and conflict*,” written by Alexander von Mühlendahl, provides a valuable comparison of the registrability and scope of protection of trademarks and designs, and how these factors relate to each other, making it possible for the same object to be protected both as a three-dimensional trademark and as a design. Then, the author discusses the conflict possibilities that arise from the referred context—notably the conflict between an earlier design and a later trademark, and vice versa—using cases such as the VESPA motor scooter and CHANEL logo to address the matter.

The following chapter, “*Cross-border copyright protection in Europe*,” by Uma Suthersanen, contextualizes the copyright landscape in the EU, mainly regarding the history of harmonization of this IPR throughout the EU and the evolution of the CJEU’s jurisprudence understanding on the subject. Moreover, the text turns to a pertinent analysis about the CJEU’s approach to the relationship between the functionality of the protected product and society’s understanding of the product itself and what it serves.

In the closing chapter, “*How different is different? Modern neuroscience and its impact on design law*,” Charles Lee Mauro and Christopher Daniel Morley defend the thesis that “the business value of visual design is far more important than was previously assumed.”⁶ The authors treat the protection of visual design of products as a matter of science, which leads them to study the human mind and its tendency to make decisions regarding products based on the products’ visual design (neuroaesthetics). This multidisciplinary approach covers neuroscience and legal knowledge to bring about observations concerning how the visual design of products impacts human behavior, how our eyesight perceives and recognizes images, and how branding can impact and take advantage of this factor. Further, this chapter applies the above-mentioned concepts in the design litigation landscape, explaining how intellectual property infringement causes damage to the right holder in the form of the loss of a business opportunity. The authors also discuss how courts calculate the monetary value of such damages.

In summary, there is much to learn on design law from this authoritative 556-page compendium. Policy authorities, Industrial Property offices’ examiners, patent attorneys, trademark attorneys, judges, and any readers interested in the legal portrait of designs and on the interplay of designs with other IPRs will find that the photos, figures, and drawings of designs illustrating several chapters render this encyclopedic handbook even more useful.

⁶ *Id.* at 508.