THE USPTO'S ART TEACHER PATENT GAMBIT: HOW DESIGN PATENTS STEPPED ON COPYRIGHT'S TERRITORY

by Anish Wesley King[1]

The USPTO's January 2024 implementation of Category D design patent practitioner registration marks a watershed moment in intellectual property law. For the first time, art teachers and creative professionals can practice patent law without traditional STEM credentials, but only in a specific area: design patents. Design patents increasingly protect subject matter traditionally governed by copyright and trade dress. This short article looks into the Federal Circuit's systematic expansion of design patent scope, combined with the USPTO's recruitment of art-trained practitioners, and suggests this signals a potential fundamental restructuring of intellectual property boundaries. Copyright practitioners can no longer treat design patents as a specialized technical field irrelevant to their practice.

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INTRODUCTION: THE UNEXPECTED PATENT BAR REVOLUTION

On January 2, 2024, art teachers across America gained the right to prosecute patent applications—a development that appears to have gone largely unnoticed in art education communities.[2] The United States Patent and Trademark Office was actively recruiting those with art backgrounds to become design patent experts, signaling institutional recognition that design patents now operate substantially within copyright's constitutional domain. The Category D practitioner bar creates both opportunity and potentially a small crisis for copyright (and trade dress) practitioners who must navigate this territorial overlap. Why is the USPTO recruiting creative professionals into patent practice? What does this reveal about design patents' expansion into copyright's traditional territory? This article uncovers a systematic boundary collapse between Article I, Section 8's dual intellectual property clauses, where design patents increasingly protect "Science" through visual expression while patent law's instrumental logic encroaches on copyright's cultural commons.

The USPTO's Category D policy allows holders of degrees in art teacher education, fine arts, graphic design, and related creative fields to sit for the patent bar examination, fundamentally restructuring who can practice patent law, at least in the design patent area.[3] Director Kathi Vidal framed this expansion as opening "the USPTO's doors more broadly" to "bring more people into the innovation ecosystem," but the implications extend far beyond diversity metrics.[4] This article reveals three converging forces reshaping intellectual property law: the USPTO's institutionalization of artistic judgment within patent prosecution; the Federal Circuit's systematic expansion of design patent scope into territories traditionally governed by copyright law; and the practical collapse of doctrinal screens meant to channel creative expression between appropriate protection regimes. For copyright practitioners, this represents not merely procedural change but an existential challenge to copyright's domain over artistic and ornamental expression.

This article argues that the USPTO's Category D implementation represents not merely an administrative reform but a recognition that design patents have expanded into

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[2] As of November 2025, searches of art education professional forums and publications revealed no discussions of Category D opportunities.

[3] 88 Fed. Reg. 78,644, 78,647 (Nov. 16, 2023) (implementing Category D design patent practitioner bar under 37 C.F.R. § 11.6(d)).

[4] Press Release, U.S. Patent & Trademark Office, USPTO Moves Forward with Rulemaking to Create a Design Patent Practitioner Bar (May 15, 2023), https://www.uspto.gov/about-us/news-updates/uspto-moves-forward-rulemaking-create-design-patent-practitioner-bar.

copyright's constitutional domain, creating overlapping protection regimes that may undermine intellectual property law's premise that different types of creativity merit different forms of protection. The recruitment of art teachers to prosecute design patents institutionalizes what judicial decisions have accomplished incrementally, the transformation of design patents from a narrow protection for ornamental features of useful articles into a primary vehicle for protecting visual creativity in commercial contexts, regardless of whether copyright law permits such protection.

This article proceeds in four parts. Part I provides essential background by explaining what design patents are, how they differ from copyright and trade dress protection, and why these distinctions matter for intellectual property practitioners. Part II traces the historical path by which design patents have expanded their territorial reach into areas traditionally governed by copyright law. Part III examines the USPTO's Category D implementation in detail, analyzing the regulatory framework and its practical implications. Part IV explores how design patents have systematically encroached on copyright's domain through Federal Circuit jurisprudence, Graphical User Interface ("GUI") protection, and fashion industry developments. The article concludes by addressing what this transformation means for copyright practitioners and the future of intellectual property boundary rules.

I. DEFINING DESIGN PATENTS (VERSUS TRADE DRESS AND COPYRIGHT)

Before examining how design patents have expanded into copyright's traditional territory, practitioners unfamiliar with patent law need to understand what design patents protect and how they differ from copyright and trade dress. The United States intellectual property system employs different regimes for different types of creativity, but the boundaries between these regimes have become increasingly unstable. Design patents occupy a peculiar middle ground—protecting the ornamental appearance of useful articles through a patent system historically focused on technological innovation.

A. What Design Patents Protect

A design patent protects "any new, original and ornamental design for an article of manufacture."[5] Unlike utility patents, which protect how things work, design patents protect how things look. The subject matter is visual: the shape, configuration, surface ornamentation, or combination thereof that gives a manufactured item its distinctive appearance. Apple's iPhone design patents exemplify this protection — covering the rounded rectangular shape with rounded corners, the black glass front face, and the arrangement of icons on the home screen.[6]

The ornamental appearance must be embodied in an article of manufacture. Standing alone, a two-dimensional drawing or surface pattern cannot be design patented; it must be applied to a functional object. This requirement distinguishes design patents from copyright, which readily protects standalone artistic works. A fabric pattern can be

[5] 35 U.S.C. § 171(a).

[6] See U.S. Design Patent No. D593,087 (issued May 26, 2009) (iPhone home screen interface); U.S. Design Patent No. D618,677 (issued June 29, 2010) (rounded rectangular shape with rounded corners).

copyrighted as a pictorial work, but it can only be design patented when applied to a specific article like a handbag or piece of furniture.

Design patents require that the ornamental features be non-functional. As Professors Jeanne Fromer and Mark McKenna explain in their comprehensive analysis "Claiming Design," the Federal Circuit has held that "the design of a useful article is deemed to be functional when the appearance of the claimed design is 'dictated by' the use or purpose of the article."[7] This functionality doctrine mirrors copyright's useful articles doctrine and trademark's functionality bar, all attempting to channel purely functional features to utility patent law. However, as Professor Mark McKenna and Christopher Sprigman document in "What's In, and What's Out," these channeling doctrines often fail because different areas of intellectual property law employ inconsistent concepts of what counts as "functional."[8]

For entertainment industry practitioners, the key insight is that design patents protect visual creativity applied to useful objects — the aesthetic design of products rather than standalone artworks or the functional aspects of those products. When Christian Louboutin designs shoes with red lacquered soles, when Hermès creates the distinctive shape of the Birkin bag, or when Apple develops the visual appearance of the iPhone, these ornamental designs for useful articles fall within design patent's domain.

B. Why We Need Design Patent Protection

The theoretical justification for design patent protection has evolved significantly since Congress first authorized design patents in 1842. Originally, design patents addressed a gap in intellectual property coverage: copyright protected artistic works but not their application to useful articles, while utility patents protected technological advances but not aesthetic innovations. Design patents filled this void by protecting ornamental designs that enhanced the marketability and consumer appeal of manufactured goods.[9]

Modern economic justifications emphasize design's competitive significance. As Professor Christopher Buccafusco and colleagues explain in "Intelligent Design," product designs perform multiple functions beyond mere aesthetics — they shape consumer demand, facilitate product differentiation, and embody substantial creative investment.[10] In markets from consumer electronics to fashion, design has become a primary axis of competition. Apple's design patents on the iPhone generated over $533 million in damages in its litigation against Samsung, demonstrating the enormous commercial value of design innovation.[11]

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[7] Jeanne C. Fromer & Mark P. McKenna, Claiming Design, 167 U. PA. L. REV. 123, 128-32 (2018) (hereinafter "Claiming Design").

[8] Mark P. McKenna & Christopher Jon Sprigman, What's In, and What's Out: How IP's Boundary Rules Shape Innovation, 30 HARV. J.L. & TECH. 491, 497-500 (2017) (hereinafter "What's In").

[9] Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 510-15 (2012) (explaining how product designs enhance marketability and consumer appeal).

[10] Christopher Buccafusco et al., Intelligent Design, 68 DUKE L.J. 75, 82-85 (2018).

[11] Jury Awards Apple $533 Million In Damages For Design Patent Infringement Based On Four-Factor Test, Lexology (May 30, 2018). See also Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 1001-02 (Fed. Cir. 2015).

The fast-fashion phenomenon illustrates design protection's economic stakes. When high-end designers invest months developing new collections, fast-fashion retailers can copy and mass-produce those designs within weeks. Without intellectual property protection, this copying erodes incentives for design innovation. Design patents offer protection unavailable through copyright (which often fails the separability test for useful articles) or trademark (which requires proof of secondary meaning and faces functionality bars).

However, the need for design patent protection remains contested. Some scholars argue that the fashion industry thrives despite minimal intellectual property protection, suggesting that rapid trend cycles and first-mover advantages provide sufficient incentives.[12] Others contend that design patents grant excessive monopoly power over aesthetics, limiting competition and consumer choice. These debates have intensified as design patents have expanded beyond their traditional domain.

C. How Did Design Patents Develop? The Path to Current Law

Design patent protection emerged from nineteenth-century patent law's struggle to accommodate aesthetic innovation. The Patent Act of 1842 first authorized design patents, motivated by domestic manufacturers' complaints that British competitors copied American designs. Congress extended patent protection to "any new and original design for a manufacture" for terms of seven or fourteen years.[13]

Early design patent doctrine borrowed heavily from copyright principles. Courts analogized design patents to copyright's protection of artistic works, even as they maintained the patent system's novelty and examination requirements. This dual heritage created conceptual tensions that persist today—design patents employ patent law's procedural framework while protecting subject matter closer to copyright's artistic domain.

The twentieth century saw design patents expand in scope and significance. The Patent Act of 1952 extended design patent terms to fourteen years and clarified that designs must be "ornamental" rather than functional. Courts developed the "ordinary observer" test for infringement, asking whether an observer would be deceived into thinking an accused product was the patented design.[14] This test differed from utility patent's technical claim analysis and copyright's substantial similarity test, creating yet another distinct infringement standard.

Professor Peter Menell and Ella Corren trace in "Design Patent Law's Identity Crisis" how design patents' hybrid nature — emerging from copyright-based protection but labeled as "patents" due to bureaucratic self-interest — has generated ongoing confusion about their proper role.[15] Design patents occupy an unstable middle ground between patent's technological focus and copyright's artistic domain.

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[12] Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 VA. L. REV. 1687, 1691-95 (2006).

[13] Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 544.

[14] Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) (hereinafter "Egyptian Goddess").

[15] Peter S. Menell & Ella Corren, Design Patent Law's Identity Crisis, 36 BERKLEY TECH. L.J. 101, 108-15 (2021) (hereinafter "Identity Crisis").

The Federal Circuit's creation in 1982 dramatically accelerated design patent expansion. As will be discussed in Part IV, the Federal Circuit's systematic broadening of design patent scope through cases like *Egyptian Goddess v. Swisa* and *LKQ Corp. v. GM Global Technology* has made design patents easier to obtain and enforce. This expansion has occurred largely without consideration of how broader design patent protection impacts copyright's domain over artistic expression.

D. Design Patents versus Copyright: Overlapping Protection for Visual Creativity

The relationship between design patents and copyright exemplifies intellectual property law's struggle to maintain coherent boundaries. Both regimes protect visual creativity, but they employ different standards, procedures, and theoretical frameworks. Understanding these differences is essential for practitioners navigating disputes over design copying.

Copyright protects "original works of authorship fixed in any tangible medium of expression," including pictorial, graphic, and sculptural works.[16] Protection attaches automatically upon creation and lasts for the author's life plus seventy years. The originality threshold is low — the work need only be independently created and possess minimal creativity. Copyright protects expression but not ideas, procedures, or functional elements.

Design patents protect ornamental designs for articles of manufacture. Protection requires filing an application, passing USPTO examination for novelty and non-obviousness, and paying fees. The protected term is fifteen years from grant. Design patents protect the overall visual impression of an article's appearance, not merely its expressive elements.

The critical distinction lies in the useful articles doctrine. Copyright's Section 101 provides that "pictorial, graphic, and sculptural features" of useful articles are copyrightable "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."[17] This separability test excludes from copyright protection designs that are inseparable from an article's function.

The Supreme Court's 2017 decision in Star *Athletica v. Varsity Brands* clarified copyright's separability test, holding that a feature is separable if it can be imagined as a two-dimensional or three-dimensional work of art separate from the useful article.[18] The Court found cheerleading uniform designs copyrightable because the chevrons and color blocks could exist as standalone designs on other surfaces. However, three-dimensional product shapes often fail this test.

Design patents avoid copyright's separability problem by explicitly protecting designs applied to useful articles. As Professors Jeanne Fromer and Mark McKenna explain in "Claiming Design," this creates overlapping protection for the same features.[19] A graphic design on a handbag might be copyrightable as a pictorial work while the

[16] 17 U.S.C. § 102(a).
[17] 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works").
[18] Star Athletica, L.L.C. v. Varsity Brands, Inc., 580 U.S. 405, 414-15 (2017).
[19] Claiming Design, *supra* note 7.

three-dimensional bag shape is design patented. Many companies pursue both forms of protection simultaneously — Apple obtained both design patents and copyrights for various iPhone features.

This overlap troubles scholars and courts alike. Copyright provides longer protection (life plus seventy years versus fifteen years) with lower entry barriers (automatic protection versus examination). Design patents provide stronger protection against independent creation and avoid copyright's substantial similarity requirement. The ability to claim both forms simultaneously creates what Fromer and McKenna term "full cumulation," allowing rights holders strategic advantages unavailable under either system alone.[20]

For practitioners, the key insight is that copyright and design patents increasingly protect overlapping subject matter despite theoretical distinctions. Fashion designs, product packaging, and graphical user interfaces can all claim protection under multiple regimes. This cumulation benefits rights holders but creates notice problems for competitors and channels creative effort in ways that may not serve innovation policy.

E. Design Patents versus Trade Dress: The Trademark Overlap

Trade dress protection under Section 43(a) of the Lanham Act creates additional overlap with design patents. Trade dress protects the overall appearance and image of a product or its packaging when that appearance identifies the product's source. Like trademarks, trade dress requires either inherent distinctiveness or secondary meaning plus non-functionality.[21]

The Supreme Court's decision in *Wal-Mart Stores v. Samara Brothers* distinguished product packaging (which can be inherently distinctive) from product design (which requires secondary meaning).[22] Product designs — the shape and configuration of the product itself — can only be protected as trade dress if they have acquired secondary meaning, e.g. consumers recognize the design as identifying a particular source.This secondary meaning requirement creates a significant hurdle for trade dress protection of product designs. Unlike design patents, which can protect new designs immediately upon issuance, trade dress requires extensive evidence that consumers associate the design with a particular manufacturer. The famous Hermès Birkin bag shape might acquire trade dress protection through decades of exclusive use and promotion, but a new product design cannot.

Trade dress protection also requires non-functionality. The Supreme Court's *TrafFix* decision held that features are functional if they are "essential to the use or purpose of the article or affect the cost or quality of the article."[23] This functionality doctrine aims to prevent trade dress from protecting features that belong in utility patent's domain. However, as Professors Mark McKenna and Christopher Sprigman document in "What's

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[20] *Id.*
[21] 15 U.S.C. § 1125(a).
[22] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210-15 (2000) (hereinafter "Wal-Mart").
[23] TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 32-33 (2001).

In, and What's Out," courts struggle to apply consistent functionality standards across intellectual property regimes.[24]

Design patents and trade dress can protect the same features simultaneously. The Louis Vuitton toile monogram is both trade dress (identifying Louis Vuitton as the source) and covered by design patents on luggage and handbags bearing the pattern. Christian Louboutin's red sole is protected as trade dress (with limitations) and could potentially be design patented in specific configurations. This overlap creates strategic opportunities—trade dress lasts potentially forever if maintained, while design patents provide broader protection for fifteen years.

Jeanne Fromer and Mark McKenna's scholarship on "Claiming Design" identifies serious problems with this overlapping protection.[25] Different claiming regimes (trade dress's verbal descriptions versus design patents' visual claims) create notice difficulties. Rights holders can strategically shift between forms of protection depending on the infringement context. The combination enables protection broader and longer-lasting than either regime intended.

For copyright practitioners entering design patent disputes, understanding trade dress provides crucial context. Many design patent assertions occur alongside trade dress claims. Defendants face multiple overlapping rights with different validity challenges and infringement standards. The Supreme Court's guidance that these regimes should channel different types of features to appropriate forms of protection has largely failed in practice.

F. Can You Have All Three? The Cumulation Problem

The short answer is yes — the same design features can be simultaneously protected by design patents, copyright, and trade dress. This "full cumulation" of rights creates significant advantages for rights holders and corresponding challenges for competitors.

The Manual of Patent Examining Procedure explicitly acknowledges overlap: "[t]here is an area of overlap between copyright and design patent statutes where the author/inventor can secure both a copyright and a design patent."[26] The foundational case *In re Yardley* definitively rejected the "election doctrine" that would have forced creators to choose between copyright and design patent protection.[27] *Yardley* involved a watch face featuring Vice President Spiro Agnew's caricature that already had copyright registration, establishing precedent for dual coverage.

Contemporary examples confirm systematic overlap. Apple's GUI design patents were valued at over $533 million in *Apple v. Samsung litigation*, demonstrating commercial significance of dual protection strategies.[28] Following *Star Athletica*, the Copyright Office registered Kanye West's Yeezy shoe designs in 2019 despite initial refusal, establishing precedent for fashion items receiving both copyright and design patent protection.[29] Historical examples include design patents D-243,821, D-243,824,

[24] What's In, *supra* note 8.
[25] Claiming Design, *supra* note 7.
[26] Manual of Patent Examining Procedure § 1512 (9th ed., rev. July 2022).
[27] In re Yardley, 493 F.2d 1389, 1394 (C.C.P.A. 1974).
[28] See *supra* note 10.
[29] Review Board of the U.S. Copyright Office, Yeezy Boost 350 Versions 1 & 2, Review Board Decision (May 8, 2019).

and D-243,920 that included copyright notices, demonstrating the USPTO's longstanding policy permitting dual protection under specific waiver conditions.[30]

Trade dress adds a third layer. The Federal Circuit in *In re Becton Dickinson* held that design patents can serve as evidence of non-functionality in trade dress cases, creating synergies between the regimes.[31] Fashion companies routinely pursue what practitioners call the "winning trio" of copyright, design patent, and trademark protection for signature designs.

However, as Christopher Buccafusco, Mark Lemley, and Jonathan Masur argue in "Intelligent Design," this cumulation creates serious policy problems.[32] Intellectual property law's doctrinal screens for channeling designs into appropriate regimes have failed. Designers obtain powerful protection over utilitarian aspects without demonstrating socially valuable contributions required by utility patent law. The notice problems compound when rights holders can assert overlapping rights using whichever claiming regime most benefits them.

Sarah Burstein's "How Design Patent Law Lost Its Shape" demonstrates that USPTO regularly grants design patents for designs below copyright's originality threshold.[33] This creates a ratchet effect — designs ineligible for copyright protection nonetheless receive design patent protection, expanding total intellectual property coverage beyond what either regime intended individually.For practitioners, the cumulation lesson is clear: comprehensive design protection requires considering all three regimes. Copyright protects separable artistic elements. Design patents protect integrated ornamental features. Trade dress protects source-identifying designs. The most valuable designs receive all three forms of protection, each providing complementary advantages.

II. THE PATH TO EXPANSION: GROWING INTEREST IN DESIGN PATENTS

Design patents have evolved from a relatively obscure corner of intellectual property law to a central concern for companies competing through visual product design. Understanding this transformation requires examining both empirical evidence of growing design patent use and scholarly literature documenting design patents' expanding role.

A. Empirical Evidence of Growth and Importance

Design patent filings have increased dramatically over recent decades. According to data compiled by David Schwartz and Xavier Giroud in their comprehensive empirical study of design patent litigation, design patent applications more than doubled from

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[30] Manual of Patent Examining Procedure § 1512 (9th ed., rev. July 2022) (noting that "[t]he files of design patents D-243,821, D-243,824, and D-243,920 show examples of an earlier similar procedure" regarding dual copyright and design patent protection).

[31] In re Becton, Dickinson & Co., 675 F.3d 1368, 1380 (Fed. Cir. 2012).

[32] Christopher Buccafusco et al., Intelligent Design, 68 DUKE L.J. 75, 78-82 (2018) (hereinafter "Intelligent Design").

[33] Sarah Burstein, How Design Patent Law Lost Its Shape, 41 CARDOZO L. REV. 555, 565-70 (2019) (hereinafter "How Design").

approximately 15,000 annually in the early 2000s to over 40,000 by 2015.[34] The USPTO granted approximately 35,000 design patents in 2023, continuing this upward trend.

More significantly, design patent litigation has surged. Schwartz and Giroud's comprehensive database of all lawsuits alleging design patent infringement from 2000 to 2016 reveals exponential growth.[35] Design patent cases increased from fewer than 50 per year in 2000 to over 350 per year by 2015. This litigation surge followed high-profile cases like *Apple v. Samsung*, where design patent damages exceeded $500 million, demonstrating design patents' commercial significance.

The industries filing design patents have also shifted. Traditionally dominated by furniture, housewares, and ornamental designs, design patents now protect consumer electronics, fashion accessories, automotive designs, and graphical user interfaces. Technology companies have become major design patent filers — Apple, Samsung, Microsoft, and Google collectively file thousands of design patents annually. Fashion houses like Louis Vuitton, Gucci, and Hermès increasingly rely on design patents to protect signature product features.

This growth reflects design's increasing importance to product competition. As Professor Christopher Buccafusco documents, consumers increasingly make purchasing decisions based on product aesthetics rather than purely functional considerations.[36] Companies invest substantially in industrial design, recognizing that visual appeal drives market success. Apple's design patents alone have been valued at over $2 billion in litigation contexts.

The growth also responds to legal developments making design patents more valuable. The Federal Circuit's *Egyptian Goddess* decision eliminated the "point of novelty" test, making design patents easier to enforce.[37] The Supreme Court's *Star Athletica* decision clarified copyright's separability test but left many product designs unprotectable, driving designers toward design patents.[38] Collectively, these developments have made design patents more attractive for protecting visual creativity.

B. Scholarly Attention and Policy Debates

Academic literature on design patents has expanded alongside their commercial importance. Before 2000, design patent scholarship was sparse — a few articles addressed specific doctrinal issues, but comprehensive analysis was rare. The past two decades have produced substantial scholarly attention from leading intellectual property academics.

Professor Jeanne Fromer has been particularly influential. Her work examines design patents' role in protecting incremental innovation, the problems with design patent claiming practices, and the overlap between design patents and other intellectual property

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[34] David L. Schwartz & Xaviere Giroud, *An Empirical Study of Design Patent Litigation*, 72 ALA. L. REV. 417 (2020).

[35] *Id.*

[36] *Buccafusco, Making Sense, supra* note 8, at 1286.

[37] Egyptian Goddess, *supra* note 14.

[38] Star Athletica, L.L.C. v. Varsity Brands, Inc., 580 U.S. 405, 414-15 (2017) (hereinafter "Star Athletica").

regimes.[39] Her article "The Layers of Obviousness in Patent Law" analyzes how patent law evaluates incremental improvements, while "Claiming Design" (co-authored with Mark McKenna) comprehensively examines claiming practices across design patent, copyright, and trademark protection.[40]Sarah Burstein's scholarship provides a critical perspective on design patent expansion. Her article "How Design Patent Law Lost Its Shape" traces doctrinal collapse to *In re Zahn*, which created an "anything goes" regime contrary to 35 U.S.C. § 171.[41] "Uncreative Designs" demonstrates that USPTO regularly grants patents for designs below copyright's originality threshold.[42] Burstein argues that design patent law has strayed from its statutory foundations, providing protection for designs lacking genuine ornamental innovation.

Mark McKenna and Christopher Sprigman's "What's In, and What's Out" provides crucial context by examining how different intellectual property regimes define their boundaries.[43] They demonstrate that design patents, copyright, and trademark all attempt to channel functional features to utility patent law, but inconsistent definitions of "functionality" undermine these channeling efforts. When patent law cannot clearly articulate which features belong in its domain, other intellectual property regimes struggle to maintain coherent boundaries.

Christopher Buccafusco, Mark Lemley, and Jonathan Masur's "Intelligent Design" argues that intellectual property law's doctrinal screens have failed to channel designs appropriately.[44] They demonstrate that designers can obtain powerful protection over utilitarian aspects using design patents without meeting utility patent's rigorous standards. This undermines patent law's careful balance between incentivizing innovation and preserving competition.

Peter Menell and Ella Corren's "Design Patent Law's Identity Crisis" traces historical confusion from design patent law's origins in the British copyright regime.[45] The article demonstrates how design patents emerged from copyright-based protection for ornamental features but became confusingly labeled "design patents" due to bureaucratic self-interest rather than principled policy decisions.

Design patents protect valuable commercial designs, but the doctrinal frameworks governing their scope remain underdeveloped. The expansion into copyright's traditional territory has occurred without adequate consideration of how design patents should relate to copyright's cultural commons values.

C. International Developments and Competitive Pressures

Design patent expansion is not uniquely American. International developments have reinforced design's importance to intellectual property strategy. The European Union's design system provides both registered and unregistered design rights, with the latter

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[39] See Jeanne C. Fromer, The Layers of Obviousness in Patent Law, 22 HARV. J.L. & TECH. 75 (2008).
[40] Claiming Design, *supra* note 6.
[41] How Design, *supra* note 32.
[42] Sarah Burstein, Uncreative Designs, 73 DUKE L.J. 1437, 1440-45 (2024).
[43] What's In, *supra* note 8.
[44] Intelligent Design, *supra* note 10.
[45] Identity Crisis, *supra* note 15.

offering three years of protection automatically upon disclosure. This creates competitive pressure on United States companies to secure equivalent protection.[46]

The Hague Agreement allows international design registration that covers multiple countries through a single application. The U.S. joined this agreement in 2015, facilitating design patent protection across borders. Fashion companies particularly benefit — a single international application can secure design protection in dozens of countries simultaneously.

China's emergence as a major market has intensified design protection disputes. As documented by Jyh-An Lee and Jingwen Liu in "A Tale of Two Fashion Nations," Chinese law provides design patent protection but with different standards than U.S. law.[47] The non-obviousness test applies an "average consumer" perspective rather than a designer's viewpoint, potentially making Chinese design patents easier to obtain but harder to enforce. Chinese courts have increasingly recognized design rights as the government promotes domestic innovation.These international developments create strategic considerations for design-intensive companies. Global design protection requires navigating multiple legal regimes with varying standards and procedures. The expansion of design patents in the United States reflects not only domestic policy choices but also competitive pressures from abroad. When other jurisdictions provide strong design protection, U.S. companies seek equivalent protection domestically.

III. DECODING CATEGORY D: WHAT THE USPTO ACTUALLY DID

A. The Regulatory Framework: A Three-Stage Rulemaking Process

The USPTO's path to Category D began with systematic rulemaking spanning over a year, reflecting the agency's methodical approach to restructuring patent practitioner qualifications.[48] Understanding this process requires examining each stage of the rulemaking — the initial Request for Comments, the Notice of Proposed Rulemaking, and the Final Rule — to appreciate both the USPTO's stated rationales and the competing perspectives that shaped the ultimate policy.

1. Request for Comments (October 18, 2022)

The agency published its initial Request for Comments at 87 Fed. Reg. 63,044 on October 18, 2022,[49] under the title "Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office." This document posed fundamental questions about practitioner qualifications that would ultimately reshape patent practice.

The Request for Comments identified a problem: traditional patent bar requirements emphasize technical training in science and engineering fields, which may not align with

[46] Council Regulation 6/2002, 2002 O.J. (L 3) 1 (EC) (Community Design Regulation).
[47] Jyh-An Lee & Jingwen Liu, A Tale of Two Fashion Nations: Comparative Fashion IP Laws in the United States and China, 47 COLUM. J.L. & ARTS 207, 215-50 (2024) (hereinafter "A Tale").
[48] The USPTO's path to Category D began with systematic rulemaking spanning over a year.
[49] Request for Comments, Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office, 87 Fed. Reg. 63,044 (Oct. 18, 2022).

the expertise needed for design patent prosecution. The agency noted that design patent examination focuses on visual appearance and ornamental features rather than technological functionality. Examiners evaluate novelty and non-obviousness by comparing visual designs, not by analyzing scientific principles or engineering specifications.

The USPTO specifically asked whether individuals with degrees in industrial design, product design, graphic design, fine arts, and art teacher education should be eligible for design patent practice. The agency sought input on appropriate educational requirements, necessary competencies, and potential limitations on practice scope. Significantly, the USPTO asked whether such practitioners should be restricted to design patent matters only, foreshadowing the eventual Category D limitations.

This Request for Comments revealed the USPTO's recognition that design patents operate differently from utility patents. While utility patents protect technological innovations requiring scientific or engineering expertise to evaluate, design patents protect visual creativity better assessed by those trained in aesthetics and visual design. The agency's questions suggested openness to fundamentally restructuring patent practitioner qualifications.

2. Notice of Proposed Rulemaking (May 16, 2023)

Following public input, the USPTO published a Notice of Proposed Rulemaking at 88 Fed. Reg. 31,209 on May 16, 2023.[50] This document proposed specific regulatory changes implementing the new Category D practitioner bar. The proposed rules amended 37 C.F.R. § 11.6 to add Category D to the existing categories of patent practitioner qualifications.

The proposed rule specified that individuals with bachelor's, master's, or doctoral degrees in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education would be eligible to sit for the registration examination. Notably, the list included art teacher education — meaning secondary school art teachers with appropriate degrees could become patent practitioners.

The proposed rule imposed significant limitations on Category D practitioners. They could practice only in design patent matters under proposed 37 C.F.R. § 11.5(b)(2).[51] They must identify themselves as "design patent attorneys" or "design patent agents" in all communications with the USPTO and clients. Their signatures on USPTO documents must include the word "design" adjacent to their names under proposed 37 C.F.R. § 1.4(d)(2)(ii).

These restrictions theoretically cabin Category D practice to an appropriate scope. Unlike traditional patent practitioners who can prosecute both utility and design patents, Category D practitioners would be specialists in design patents exclusively. The designation requirements ensure that clients and USPTO personnel can readily identify the practitioner's limited scope of authority.The Notice of Proposed Rulemaking also aligned Category D eligibility with USPTO design patent examiner hiring criteria. The agency explained that design patent examiners are selected based on their expertise in

[50] Notice of Proposed Rulemaking, Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office, 88 Fed. Reg. 31,209 (May 16, 2023).
[51] 37 C.F.R. § 11.5(b)(2) (2024).

visual design and aesthetics, not scientific or engineering knowledge. Creating a practitioner category matching examiner qualifications would align the expertise of those prosecuting applications with those examining them.

3. Final Rule and Implementation (November 16, 2023)

The USPTO received public comments on the proposed rule, with supporters emphasizing the policy would "improve design patent practitioner quality and representation" while critics worried about "confusion within the public" and "potential malpractice and ethical concerns."[52] After considering these comments, the USPTO published the final rule at 88 Fed. Reg. 78,644 on November 16, 2023,[53] with an effective date of January 2, 2024.

The final rule adopted the proposed regulations with minor modifications. The new 37 C.F.R. § 11.6(d) permits individuals with bachelor's, master's, or doctoral degrees in the specified design fields to sit for the patent registration examination.[54] The examination tests knowledge of design patent law and USPTO procedures but not the scientific and technical knowledge required for utility patents.

The practice limitations remain strictly enforced. Under 37 C.F.R. § 11.5(b)(2), Category D practitioners may practice only in design patent matters—they cannot prosecute utility patents, handle patent interferences, or represent clients in other patent proceedings.[55] The designation requirements under 37 C.F.R. § 1.4(d)(2)(ii) ensure clear identification of these limited practitioners.

The alignment between Category D eligibility and design patent examiner hiring criteria reflects coordinated USPTO policy to reshape design patent practice around artistic rather than technical expertise.[56] Design patent examiners need not have scientific or engineering degrees; they are selected for their ability to evaluate visual designs and ornamental features. Category D creates parallelism between examiner qualifications and practitioner qualifications.

B. Director Vidal's Stated Rationale and USPTO Justifications

Director Kathi Vidal provided the clearest explanation of the USPTO's rationale in the agency's May 15, 2023 press release: "By creating a separate design patent bar that better aligns with the backgrounds of those who practice in the design space, we will broaden participation before the USPTO while further securing the robustness and reliability of the intellectual property we grant."[57]

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[52] Public comments on Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office, Docket No. PTO-C-2022-0064, available at www.regulations.gov.
[53] Final Rule, Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office, 88 Fed. Reg. 78,644 (Nov. 16, 2023).
[54] 37 C.F.R. § 11.6(d) (2024).
[55] 37 C.F.R. § 11.5(b)(2) (2024); 37 C.F.R. § 1.4(d)(2)(ii) (2024).
[56] 88 Fed. Reg. 78,644, 78,647 (Nov. 16, 2023) (noting alignment between practitioner qualifications and examiner requirements).
[57] USPTO Press Release, *supra* note 3.

This statement reveals multiple policy objectives. First, the USPTO aims to "broaden participation" by removing barriers that excluded qualified design professionals from patent practice. Traditional requirements that patent practitioners hold degrees in engineering or science effectively barred graphic designers, industrial designers, and art teachers—precisely those individuals with expertise most relevant to design patent prosecution.

Second, the USPTO claims Category D will "further secure the robustness and reliability" of design patents. This suggests the agency believes that design patents will improve in quality when prosecuted by practitioners who understand visual design principles. An industrial designer can better articulate what makes a product design novel and non-obvious compared to prior art. A graphic designer understands how visual elements combine to create distinctive appearances. Art teachers trained in aesthetics and composition can evaluate ornamental features more effectively than engineers.

The USPTO's formal justification appears in the Federal Register Final Rule, where the agency explicitly states the policy aims to align practitioner qualifications with design patent examiner requirements.[58] The agency emphasized that "expanding the admission criteria of the patent bar encourages broader participation and keeps up with the ever-evolving technology and related teachings that qualify someone to practice before the USPTO."[59]

This language frames design as "technology" — a telling characterization suggesting the USPTO views ornamental design as a form of technological innovation. However, this framing sits uneasily with traditional distinctions between patent's technological domain and copyright's artistic realm. If design is "technology," then perhaps it belongs in patent law. But if design is artistic expression, then copyright law's cultural commons values should govern.

Notably, the USPTO framed Category D as addressing documented diversity failures within patent practice. The agency noted its commitment to "allow more under-represented groups to practice design patent law and aid more under-represented inventors."[60] This rationale reflects broader recognition that the patent bar suffers from significant diversity gaps, with racial minorities and women substantially underrepresented among registered practitioners.[61]

The diversity justification resonates because traditional patent bar requirements have systematically excluded many demographic groups. Requiring science or engineering degrees excludes individuals who studied art, design, or liberal arts — fields where women and minorities have historically had better representation than STEM fields. Category D potentially opens patent practice to more diverse practitioners.

However, the diversity rationale cannot fully explain Category D's creation. If diversity were the only concern, the USPTO could have eliminated technical degree requirements entirely or created categories for other non-technical specialties. The

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[58] 88 Fed. Reg. 78,644, 78,646-78,647 (Nov. 16, 2023).
[59] Id. at 78,647.
[60] *Id.* at 78,646.
[61] Elaine Spector & LaTia Brand, *Diversity in Patent Law: A Data Analysis of Diversity in the Patent Practice by Technology Background and Region*, 13 LANDSLIDE, Sept./Oct. 2020, at 1 (finding that racial minorities account for only 6.5 percent of USPTO registrations since 2000, and racially diverse women comprise just 1.7 percent of all registered patent practitioners).

specific focus on design patents suggests the agency recognized that design patent practice genuinely differs from utility patent practice in ways that make traditional requirements inappropriate.

C. Industry Adaptation and Market Response

Law firms have begun adapting recruiting strategies to accommodate Category D practitioners, though most job postings continue to require traditional engineering or science backgrounds. Several major firms have published analyses of Category D implementation, explaining the new practitioner category to clients and considering how to integrate design-trained practitioners into patent prosecution practices.[62]The market response has been cautious. Some firms express skepticism that art teachers and graphic designers can master patent law's complexities. Others see opportunity in recruiting practitioners with genuine design expertise who can better serve design-intensive clients. Fashion companies, consumer products manufacturers, and technology companies with substantial design patent portfolios may particularly value practitioners who understand industrial design principles.

Notably, specific recruiting materials targeting art-trained practitioners remain limited as of mid-2024. This suggests either that demand has not yet materialized or that firms are waiting to assess the quality of Category D practitioners before actively recruiting them. The first cohort of Category D practitioners began taking the registration examination in early 2024, so the market has not yet had time to evaluate their performance.

Some observers predict that Category D will primarily benefit design-intensive industries rather than creating a flood of new patent practitioners. Art teachers earning $53,000-$65,000 annually may find the prospect of doubling their income through patent practice attractive.,[63] However, the investment required — examination fees, preparation courses, study time averaging 150-300 hours[64] — and the limited scope of practice (design patents only) may deter many potential entrants.

The long-term impact likely depends on whether Category D practitioners develop distinct expertise that clients value. If industrial designers bring insights that improve design patent quality or prosecution outcomes, demand will follow. If Category D practitioners merely perform the same work as traditional patent agents with different educational credentials, the market may not support significant Category D growth.

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[62] *See* Morrison & Foerster LLP, USPTO Issues Final Rule Creating Design Patent Practitioner Bar (Nov. 2023); Quarles & Brady LLP, USPTO Creates Design Patent Bar (Nov. 16, 2023).

[63] U.S. Bureau of Labor Statistics, Occupational Employment and Wages, Art, Drama, and Music Teachers, Postsecondary (May 2023); Patent agent and patent attorney compensation data compiled from multiple industry surveys, including AIPLA Economic Survey (2023). See also Patent Education Series, Patent Attorney Salary & Career Insights (Jan. 17, 2025) (reporting average patent attorney salary of $185,351 annually).

[64] Patent bar preparation program data from Wysebridge Patent Bar Review, PLI PATENT BAR REVIEW, and OmniPrep (2024); Wysebridge Patent Bar Review, 2024 USPTO Annual Patent Bar Exam: Year in Review & Report (Jan. 18, 2025) (reporting 2024 national pass rate of 49%, up from 46% in 2023; Wysebridge candidates achieved 80% pass rate in 2024, with historical average of 81% from 2012-2024).

IV. HOW DESIGN PATENTS STEPPED ON COPYRIGHT TERRITORY

The expansion of design patent protection into copyright's traditional domain did not result from legislative action or USPTO policy initiatives alone. Rather, systematic judicial decisions by the Federal Circuit broadened design patent scope, expanded subject matter eligibility, and lowered barriers to protection. This part examines three interrelated developments: the Federal Circuit's doctrinal expansion of design patent law, the explosion of GUI design patents protecting visual content previously considered copyright territory, and the fashion industry's embrace of design patents.

A. Federal Circuit's Systematic Expansion of Design Patent Scope

The Federal Circuit's systematic expansion of design patent scope has created unprecedented overlap with copyright's traditional domain. *Egyptian Goddess, Inc. v. Swisa, Inc.* eliminated the "point of novelty" test for design patent infringement, establishing that an ordinary observer familiar with prior art determines whether designs are substantially similar.[65] This shift made design patent infringement significantly easier to prove than copyright infringement, which requires proof of both actual copying and substantial similarity under *Feist Publications, Inc. v. Rural Telephone Service Co.*[66]The practical implications are profound. Under *Egyptian Goddess*, a plaintiff need not identify specific novel features of a design patent or prove the accused product copies those features. Instead, the plaintiff shows that an ordinary observer would be deceived into thinking the accused product was the patented design. This holistic comparison focuses on overall visual impression rather than detailed analysis of specific elements.The Federal Circuit's May 21, 2024 en banc decision in *LKQ Corp. v. GM Global Technology Operations LLC* fundamentally altered design patent law by overruling the 40-year-old *Rosen-Durling* test for obviousness.[67] The court held that requirements that primary references be "basically the same" and secondary references be "so related" "impose limitations absent from Section 103's broad and flexible standard" and are "inconsistent with Supreme Court precedent."[68] The decision adopted the *Graham* factors framework used for utility patents while maintaining that all references must be "analogous art."[69]

This decision makes design patents easier to obtain by relaxing the non-obviousness requirement. Under *Rosen-Durling*, design patent applicants faced significant hurdles in proving their designs non-obvious. The new standard borrows from utility patent law's more flexible approach, potentially allowing design patents on incremental variations that would have failed under prior standards. Critics worry this will flood the market with design patents covering trivial design variations.

Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories, Inc. further strengthened design patents by narrowing comparison prior art scope, holding that

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[65] Egyptian Goddess, supra note 13.
[66] Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).
[67] LKQ Corp. v. GM Global Tech. Operations LLC, 102 F.4th 1280, 1294 (Fed. Cir. 2024) (en banc).
[68] *Id.* at 1294.
[69] *Id.* at 1295-96.

"to qualify as comparison prior art, the prior-art design must be applied to the article of manufacture identified in the claim."[70] This limits invalidating references during infringement analysis, potentially expanding protection for surface ornamentation traditionally covered by copyright. A textile pattern that appears functional when applied to one article might be non-obvious when applied to a different article, even if visually identical.

These decisions collectively tilt design patent law toward broader protection and easier enforcement. *Egyptian Goddess* makes infringement easier to prove. *LKQ* makes design patents easier to obtain. *Columbia Sportswear* limits prior art available to challenge design patents. The combined effect dramatically expands design patent protection's practical reach.

B. GUI Design Patents' Explosive Growth: From Copyright to Patent Territory

The transformation of graphical user interface protection from copyright to design patent represents perhaps the clearest example of patent law's territorial expansion into copyright's domain. Following *Apple Inc. v. Microsoft Corp.*, which limited copyright protection for GUI elements, companies pivoted toward design patent protection for their interface designs.[71]Apple's foundational iPhone interface patents demonstrate this strategic shift. Design Patent D604,305 protects the grid of colorful icons arrangement, while D593,087 covers the interface with home button configuration.[72] These patents protect visual arrangements that would traditionally fall under copyright as pictorial and graphic works. The Supreme Court held in *Lotus Development Corp. v. Borland International* that menu command hierarchies constitute uncopyrightable methods of operation under Section 102(b), pushing software companies toward patent protection.[73]

The USPTO's November 17, 2023 Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images formalized this expansion by clarifying that computer icons and GUIs qualify for design patents when they are "integral and active components" of computer operation.[74] This guidance enables protection for dynamic visual content previously considered copyright territory.

The guidance specifies that design claims to computer-generated icons must be limited to icons "embodied in" or "applied to" a "display screen" or "portion thereof." The icons must be integral and active components of programmed computer-generated display screens, not merely abstract designs. This requirement ensures design patents protect functional interfaces rather than standalone artistic works — precisely the subject matter copyright law aims to protect.

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[70] Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1340, 1353 (Fed. Cir. 2023).
[71] Apple Inc. v. Microsoft Corp., 35 F.3d 1435, 1446 (9th Cir. 1994).
[72] U.S. Design Patent No. D604,305 (issued Sept. 2, 2008); U.S. Design Patent No. D593,087 (issued May 26, 2009).
[73] Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807, 815-16 (1st Cir. 1995), aff'd, 516 U.S. 233 (1996).
[74] Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, 88 Fed. Reg. 80,277, 80,278 (Nov. 17, 2023).

Design patents offer significant advantages over copyright for GUI protection. Copyright requires proof of copying, which defendants can rebut by showing independent creation. Design patents create strict liability — independent creation provides no defense. Copyright's substantial similarity test invites arguments that interfaces differ in numerous respects. Design patents' ordinary observer test focuses on overall visual impression, making similarity easier to establish.

The fifteen-year exclusivity period, while shorter than copyright's life-plus-seventy term, provides certainty and enforceability that copyright's fair use and idea-expression doctrines often undermine. GUI designers cannot predict with confidence what copyright protects, as courts inconsistently apply the merger doctrine, scenes à faire limitations, and functional element exclusions. Design patents provide clearer boundaries.

The shift from copyright to design patents for GUI protection troubles scholars. Professor Pamela Samuelson documents in multiple articles how software copyright has struggled with functionality exclusions.[75] When copyright proved inadequate for protecting functional interfaces, the natural solution within intellectual property law's divided structure was design patents. But design patents were not created to protect software interfaces—they protect ornamental designs for manufactured articles. Grafting design patents onto software creates doctrinal strain.

C. Fashion and Typography's Patent Turn

The fashion industry's embrace of design patents illustrates practical consequences of copyright's limitations in protecting useful articles. Despite the Supreme Court's *Star Athletica* decision establishing that copyright can protect separable design elements on useful articles,[76] fashion houses increasingly prefer design patents for protecting signature designs.Christian Louboutin holds 21 design patents for shoe designs, protecting iconic styles like spiked toe pumps despite the company's focus on trademark protection for red soles.[77] While Louboutin's trademark in the red sole provides source-identification protection, design patents protect the aesthetic design independent of trademark rights. Hermès's design patents cover the Birkin bag's distinctive shape and configuration. Louis Vuitton design patents protect handbag designs featuring the toile monogram pattern in three-dimensional form.The fashion industry prefers design patents despite copyright's longer term because design patents avoid separability challenges. Fashion designs often fail copyright's useful articles doctrine because ornamental and functional elements intertwine. *Star Athletica* clarified that surface decorations like cheerleading uniform chevrons are separable, but three-dimensional garment shapes remain problematic. A dress's silhouette simultaneously provides the functional purpose of covering the body and the aesthetic purpose of creating a pleasing appearance. Design patents protect this integrated design without requiring separability analysis.

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[75] Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493 (2017).

[76] Star Athletica, *supra* note 37.

[77] Analysis of Christian Louboutin design patent portfolio through USPTO database search. See also Sterne Kessler, What Louboutin's EU Trademark Win May Mean for Fashion IP (Aug. 17, 2023) (confirming "As of today, Christian Louboutin has successfully secured 21 design patents").

Design patents also provide stronger enforcement. Copyright requires proving actual copying and substantial similarity. Fast-fashion retailers can argue they independently created similar designs by following the same fashion trends. Design patents eliminate the copying requirement—strict liability applies. The ordinary observer test makes infringement easier to establish than copyright's substantial similarity analysis.

As Jyh-An Lee and Jingwen Liu document in their comparative study "A Tale of Two Fashion Nations," this shift toward design patents is occurring internationally, with Chinese fashion companies similarly embracing design patents to protect their innovations.[78] The Chinese non-obviousness standard, which evaluates designs from an "average consumer" perspective rather than a designer's viewpoint, creates different but parallel incentives for pursuing design patent protection.

Typography presents an even starker boundary collapse. U.S. law explicitly excludes typefaces from copyright protection under 37 C.F.R. § 202.1(e), forcing designers to seek design patents.[79] The first U.S. design patent, D1 issued in 1842, protected George Bruce's typeface design.[80] The USPTO has issued hundreds of design patents for typography designs that cannot receive copyright protection.[81]

Eltra Corp. v. Ringer confirmed this copyright exclusion, while *Adobe Systems, Inc. v. Southern Software, Inc.* clarified that only font software programs, not typeface designs, qualify for copyright.[82] This typography paradox reveals arbitrary intellectual property boundaries: typeface designs represent quintessential artistic expression yet copyright law excludes them while protecting far more utilitarian works.

The typography situation illustrates design patents' role as a safety valve for creativity that copyright excludes. When copyright cannot protect valuable creative work, design patents fill the gap. This might seem desirable—ensuring protection for deserving creativity. However, it undermines the carefully calibrated distinctions between intellectual property regimes. Design patents were not intended to protect all creativity excluded from copyright. Using them this way erodes the boundaries between patent and copyright law.

D. The Constitutional Stakes: When Art Teachers Prosecute Patents

The recruitment of art teachers as patent practitioners crystallizes a fundamental constitutional question. Article I, Section 8, Clause 8 grants Congress power "To 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."[83] The Supreme Court's foundational decision in *Baker v. Selden* established that copyright protects "Science" through authorial expression while patents protect "useful Arts" through inventive discoveries.[84]

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[78] A Tale, *supra* note 46.
[79] 37 C.F.R. § 202.1(e) (2024) ("typeface as typeface" excluded from copyright registration).
[80] U.S. Design Patent No. D1 (issued November 9, 1842).
[81] USPTO design patent database search revealing numerous typography-related design patents.
[82] Eltra Corp. v. Ringer, 579 F.2d 294, 299 (4th Cir. 1978); Adobe Sys., Inc. v. S. Software, Inc., No. C-95-20710 (N.D. Cal. 1998).
[83] U.S. Const. art. I, § 8, cl. 8.
[84] Baker v. Selden, 101 U.S. 99, 104-05 (1879).

When art teachers prosecute patents protecting visual creativity, traditional intellectual property categories collapse. Design patents increasingly protect "Science" through aesthetic expression rather than "useful Arts" through technological innovation. The Supreme Court in *Mazer v. Stein* permitted dual copyright and design patent protection, stating that "neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted."[85] However, *Mazer* contemplated limited overlap, not systematic territorial expansion.

The Federal Circuit's patent-centric expertise may explain consistent expansion of design patent scope without full consideration of copyright policy implications, including fair use, First Amendment concerns, and the copyright-patent balance Congress established. The court's composition of judges with primarily patent rather than copyright backgrounds may contribute to decisions that prioritize patent enforcement over copyright's cultural commons values.

Mark McKenna and Christopher Sprigman argue in "What's In, and What's Out" that patent law's inconsistency regarding its subject matter boundaries creates problems for other branches of intellectual property attempting to channel subject matter to patent's domain.[86] When patent law cannot clearly articulate what belongs in its jurisdiction, copyright and trademark law cannot effectively exclude material that should go to patent law. The result is overlapping, inconsistent protection across multiple regimes.

The Federal Circuit's emphasis on technological utility creates particular problems. Many design patents protect features whose utility is primarily psychological or phenomenological rather than technological. The *Juicy Whip* beverage dispenser designed to look like a pre-mix dispenser performs a psychological function — creating consumer desire through visual appearance.[87] Application of *Miller* measuring cups with fractional markings reduce mental strain on cooks attempting fractional recipes.[88] These patents protect mental or perceptual effects rather than technological advances.If design patents can protect any feature that "does something," then nearly any design qualifies. Visual designs always do something — they create aesthetic responses, shape consumer preferences, influence purchasing decisions. Defining utility this broadly eliminates meaningful boundaries between design patents' domain and copyright's traditional territory. The Category D implementation implicitly endorses this broad view by authorizing art teachers to prosecute design patents, suggesting the USPTO views ornamental designs as appropriately residing in patent law.

IMPLICATIONS AND CONCLUSION

A. What Art Teachers Should Know: Investment Analysis and Market Opportunities

Art teachers evaluating the Category D opportunity should conduct thorough cost-benefit analysis. Exam preparation requires 150-300 hours of study time, with

[85] Mazer v. Stein, 347 U.S. 201, 217 (1954).
[86] What's In, *supra* note 8.
[87] Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364, 1366-67 (Fed. Cir. 1999).
[88] In re Application of Miller, 418 F.2d 1392, 1396 (C.C.P.A. 1969).

quality preparation programs reporting 80-90 percent pass rates.[89] The total investment of approximately $2,500-$4,500 includes USPTO fees and preparation courses.[90] This represents a substantial commitment of time and money.

Market opportunities exist across multiple sectors. Fashion design patents show particular promise, with companies like Christian Louboutin building substantial portfolios of design patents protecting iconic product features.[91] Consumer electronics GUI protection represents another growth area, following Apple's success with foundational iPhone interface patents that have been valued at hundreds of millions of dollars in litigation.[92]

Typography and graphic design create opportunities for visually-trained practitioners, as the USPTO has issued hundreds of design patents for font designs that cannot receive copyright protection.[93] Industrial design of consumer products—furniture, housewares, packaging, and tools—continues to be a major area of design patent activity where practitioners with training in three-dimensional design can offer valuable expertise.

However, art teachers must understand practice limitations and ongoing requirements. Category D practitioners cannot handle utility patents, trademark matters, or provide copyright services under their design patent registration.[94]

Successful Category D practice requires viewing the transition as career transformation rather than supplemental credentialing. The most successful practitioners will develop expertise in both design aesthetics and patent law, building bridges between creative and legal communities. Networking through the American Intellectual Property Law Association (AIPLA) or Intellectual Property Owners Association (IPO) before completing the exam helps establish professional connections.

Specialization in specific industries or design types can differentiate new practitioners in an increasingly competitive market. Fashion, consumer electronics, furniture, and automotive design represent the highest-opportunity sectors. Starting with part-time practice while maintaining teaching positions allows risk mitigation during market entry, though full commitment to developing dual expertise ultimately determines success.

B. Strategic Opportunities and Competitive Pressures for Copyright Practitioners

For copyright practitioners, the design patent expansion represents opportunity rather than threat, but only if copyright lawyers develop design patent literacy and offer clients comprehensive intellectual property strategies. Products protected by both copyright and design patents show enhanced licensing opportunities and stronger enforcement positions.

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[89] Patent bar preparation program data from Wysebridge Patent Bar Review, PLI Patent Bar Review, and OmniPrep (2024).
[90] *Id.*
[91] *See supra* note 77.
[92] *See* U.S. Design Patent No. D604,305 (issued Sept. 2, 2008); U.S. Design Patent No. D593,087 (issued May 26, 2009).
[93] USPTO design patent database search revealing numerous typography-related design patents.
[94] 37 C.F.R. § 11.6(d) (2024) (limiting Category D practitioners to design patent matters only).

The "winning trio" of copyright, design patent, and trademark protection has become the gold standard for design-driven products. Copyright's longer term (life plus seventy years) complements design patents' stronger but shorter (fifteen years) protection against independent creation. Trademark protection for distinctive product features can last indefinitely if properly maintained. Companies pursuing all three forms of protection gain strategic advantages unavailable under any single regime.

Law firms are expanding design patent practices, recognizing client demand for comprehensive intellectual property strategies. Copyright lawyers who develop design patent competency can offer enhanced value, particularly for fashion, consumer product, and technology clients. The complementary nature of protections — copyright for separable artistic elements, design patents for integrated ornamental features, trademark for source-identifying designs — creates cross-selling opportunities rather than cannibalization of copyright work.

However, Category D practitioners with art training may understand visual aesthetics better than traditional patent attorneys with engineering backgrounds. This creates competitive pressure. Client confusion about practitioner qualifications could emerge as art-trained practitioners enter the field offering design patent services. Copyright practitioners need design patent literacy to advise clients effectively about protection strategies and collaborate successfully with design patent specialists.

The practical reality is that design-intensive companies now need advice across multiple intellectual property regimes. A fashion company launching a new handbag line needs to know: Can the two-dimensional textile pattern be copyrighted? Can the three-dimensional bag shape be design patented? Can distinctive design features acquire trademark protection? How do these protections interact? What filing strategies maximize protection? Copyright practitioners who cannot answer these questions risk losing clients to full-service intellectual property firms.

C. Policy and Reform Implications

The copyright bar should engage actively in policy debates about Category D expansion and design patent scope, bringing copyright values of fair use, freedom of expression, and cultural commons into patent discussions. Future rulemaking participation opportunities exist as the USPTO evaluates Category D implementation and considers additional reforms. When the USPTO seeks comment on design patent examination guidelines or practice rules, copyright practitioners should participate to ensure copyright perspectives inform patent policy.

Scholars must theorize new frameworks for allocating protection between copyright and design patent regimes, moving beyond failed channeling doctrines toward principled boundaries based on innovation policy rather than historical accident. The current system evolved haphazardly, with design patents expanding opportunistically into spaces copyright could not reach. A rational intellectual property system would intentionally allocate subject matter based on which form of protection best serves innovation policy goals.

Legislative recommendations for principled intellectual property boundaries could address territorial clarification through Congressional action. Congress could amend the Patent Act to explicitly define design patents' relationship to copyright and trademark

law. Alternatively, Congress could create a *sui generis* design protection system outside patent law, as many European countries have done, providing protection tailored to fashion and industrial design's unique characteristics.[95]

The constitutional question becomes pressing: when art teachers prosecute patents protecting visual creativity, traditional intellectual property categories collapse, forcing reconsideration of Article I, Section 8's dual mandate. Copyright's constitutional purpose of promoting "Science" confronts patent law's parallel mandate to advance "useful Arts," with design patents emerging as the favored vehicle for protecting visual creativity in commercial contexts.

The Federal Circuit's patent-centric approach needs balancing from practitioners who understand copyright's social and cultural functions. Fair use allows commentary, criticism, and transformative use of copyrighted works. No equivalent doctrine limits design patents. Copyright law's idea-expression distinction ensures that functional elements and abstract concepts remain free for all to use. Design patent functionality doctrine attempts similar channeling but applies inconsistently. First Amendment values inform copyright's limitations on protection. Design patents receive no such constitutional scrutiny.

D. Copyright's Response to Patent's Artistic Turn

The convergence of Category D implementation, Federal Circuit expansion of design patent scope, and industry adoption patterns signals fundamental restructuring of intellectual property's boundaries. Copyright practitioners can no longer treat design patents as a specialized technical field irrelevant to their practice. Clients creating GUIs, fashion designs, typefaces, or applied art increasingly face strategic choices between copyright and design patent protection—or pursue both simultaneously despite theoretical channeling doctrines.

The recruitment of art teachers as patent practitioners crystallizes this transformation. When art educators qualify to prosecute patents while lacking technical training, and when design patents protect artistic expression copyright cannot reach, traditional intellectual property categories collapse. Copyright's constitutional purpose of promoting "Science" confronts patent law's parallel mandate to advance "useful Arts," with design patents emerging as the favored vehicle for protecting visual creativity in commercial contexts.

For the Journal of the Copyright Society readership, three imperatives emerge. First, copyright practitioners must develop design patent literacy to advise clients effectively about protection strategies. Understanding when designs qualify for dual protection, how to sequence filings for maximum advantage, and how to coordinate enforcement strategies becomes essential for comprehensive client service.

Second, the copyright bar should engage actively in policy debates about Category D expansion and design patent scope. Bringing copyright values of fair use, freedom of expression, and cultural commons into patent discussions could influence future rulemaking and judicial interpretation. The Federal Circuit's patent-centric approach

[95] *See* Council Regulation 6/2002, *supra* note 45 (establishing EU-wide sui generis design protection system separate from patent and copyright regimes).

needs balancing from practitioners who understand copyright's social and cultural functions.Third, scholars must theorize new frameworks for allocating protection between copyright and design patent regimes. Moving beyond failed channeling doctrines toward principled boundaries based on innovation policy rather than historical accident requires interdisciplinary collaboration between copyright and patent experts. The constitutional structure contemplates parallel but distinct systems for protecting "Science" and "useful Arts"—clarifying those boundaries serves both regimes' effectiveness.

Whether artistic expression retains a domain independent of patent law's instrumental logic depends on copyright law's response to this fundamental challenge to intellectual property's traditional architecture. The stakes extend beyond professional turf to the constitutional balance between systems meant to serve different aspects of human creativity and innovation. The Category D revolution has begun.