A Teleological Approach to Design Patents for Digital Images

Lucas Osborn

Digital images are a strange fit in a statute relating to designs for articles of manufacture. The current USPTO approach makes any image on a screen eligible for design protection. This gives rise to competition and free speech concerns. As others have noted, U.S. design patent law does not have a private, noncommercial use exception or a fair use exception, meaning that any reproduction on a computer screen, even for news, commentary, or to advertise a physical product, might infringe. Some see no concerns with broad protections for digital images. Others argue that their lack of permanence should doom their eligibility. But I do not think that permanence can serve as a categorical requirement, if for no other reason than because traditional surface ornamentation on articles could, in some cases, be washed away or otherwise removed.

Instead, I argue that the concepts of permanence and fixation for digital works are better addressed under a concept of intended use for the digital image. Nondigital design law did not often contemplate intended uses because the use was generally plain from the nature of the claim. But digital icons raise categorically different concerns because, unlike their invariable predigital forbearers, computers are protean devices that provide a digital image with a host of potential contextual meanings and functions. Design law should force applicants for design patents for digital images to limit their claims to specific meanings and functions.