VOLUME 138 DECEMBER 2024 NUMBER 2

HARVARD LAW REVIEW

© 2024 by The Harvard Law Review Association

ARTICLES

THE COUNTERFEIT SHAM

Sarah Fackrell

CONTENTS

INTRODUCTION 472
I. THE LAW 475
  A. The "Counterfeit" in U.S. IP Law 475
  B. The U.S. Design Patent 480
  C. The (Limited) Overlap 486
II. THE COUNTERFEIT NARRATIVE IN DESIGN PATENT LAW & POLICY 487
  A. In Congress 487
  B. In Enforcement Actions 490
  C. Among Academics and Practitioners 500
III. THE LEGAL & LOGICAL DISCONNECT 502
  A. Design Patent Infringement ≠ Counterfeiting 503
  B. There Is No Necessary Link Between Design Patents and Safety 514
IV. THE LARGER COUNTERFEIT NARRATIVE 517
  A. We've Seen This Before 518
  B. What's Really Going On? 519
V. WHY COUNTERFEIT RHETORIC MATTERS 526
VI. LESSONS & IMPLICATIONS 529
  A. Be Careful with the Word "Counterfeit" When Discussing Design Patents 529
  B. We Should Not Import the Term "Counterfeiting" into Design Patent Law 529
CONCLUSION 530

THE COUNTERFEIT SHAM

Sarah Fackrell[*]

There's a new front in the IP rhetoric wars. Plaintiffs in "Schedule A" cases tell judges that they need to secretly seize the assets of hundreds of defendants all at once in order to defeat the machinations of nefarious foreign "counterfeiters" — even in cases where no counterfeiting (or even plain trademark infringement) is alleged. Proponents of bills that would allow Customs and Border Protection to seize products that might infringe design patents try to equate those products with "counterfeits," invoking the specter of counterfeit drugs to suggest that design patent infringement threatens the health and safety of U.S. citizens. Although design patent infringers may sometimes also be counterfeiters, these two legal offenses are actually and meaningfully different. Unlike counterfeiting, design patent infringement does not require the use of any trademarks or any likely consumer confusion. Even if we're discussing "counterfeiting" in the more colloquial sense, a competitor need not identically copy a product — or do anything deceptive at all — in order to infringe a design patent. A product that infringes a design patent is not necessarily more dangerous or harmful than any other product. For these reasons and others, the direct equation of design patent infringement to counterfeiting is false and the appeal to fear is fallacious. This Article argues that policymakers, judges, and other decisionmakers should not fall for this sham.

INTRODUCTION

There's a new front in the intellectual property (IP) rhetoric wars. In the past, we've seen inflammatory words like "theft" and "piracy" applied to various acts of infringement.[1] The specter of "counterfeiting" is frequently — and it seems, increasingly — invoked in discussions of U.S. design patent law and policy.[2] "Counterfeiting" is a term of art in U.S. IP law.[3] It refers specifically to "the act of producing or selling a product with a sham trademark that is an intentional and calculated

* Professor of Law, Chicago-Kent College of Law. The author previously published under the name Sarah Burstein. Thanks to Barton Beebe, Jocelyn Bosse, Rebecca Curtin, Eric Goldman, Joseph Glannon, Camilla Hrdy, Sapna Kumar, Jake Linford, J. Janewa Osei-Tutu, Nicholson Price, Lisa Ramsey, Jason Rantanen, Alexandra Roberts, Linda Sandstrom Simard, Cathay Y. N. Smith, Lorianne Updike Toler, and Rebecca Tushnet for comments on earlier drafts of this Article. Earlier versions of this project were presented at the Intellectual Property Scholars Conference, the New York University School of Law Innovation Policy Colloquium, the M3 IP Scholars Workshop, the Boston University School of Law IP Workshop, the Suffolk University Law School Annual Intellectual Property & Innovation Conference, and the Suffolk University Law School "Bookends" Workshop; thanks to all of the participants in those conferences and workshops for their comments and suggestions. Thanks also to Lauren C. Meoli for research assistance and to Tiffany Souza and Jean Wagner for library support. Finally, thanks to Mike Lissner and the Free Law Project for free docket tracking.

[1] *See infra* Part IV, pp. 517–26.

[2] *See infra* Part II, pp. 487–502. This is the author's impression, not an empirical assertion regarding timing or frequency.

[3] *See infra* section I.A, pp. 475–79.

reproduction of the genuine trademark."[4] But a design patent isn't a trademark.[5] It's a totally different type of IP right.[6]

Why would someone try to conflate design patent infringement with counterfeiting? Because it's a powerful rhetorical device. After all, "commercial counterfeiting has no apologists and no redeeming features."[7] Few would disagree "that intellectual property law should be used to its fullest extent to suppress" things like "counterfeit pharmaceuticals, counterfeit aerospace spare parts, and counterfeit food."[8] Thus, the word "counterfeiting" tends to evoke a stronger emotional reaction than the word "infringing."

This type of emotional appeal may be necessary to convince judges and policymakers to grant design patent owners extraordinary benefits and remedies. It may also help disguise measures that benefit private rightsholders as ones that prevent public harms.[9] Indeed, we've seen a similar rhetorical playbook used before by supporters of increased copyright protections.[10] But those who write, advocate for, and make patent law and policy aren't always aware of copyright literature and policy debates (and vice versa). This Article aims, in part, to bridge that gap.

This is not a matter of mere linguistic imprecision; it's a case of strategic conflation.[11] The problem here is not just that some people are using the word "counterfeit" outside of its specific legal meaning when

---

[4] 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:10 (5th ed. 2024); *see also infra* section I.A, pp. 475–79.

[5] At least, it doesn't have to be. For a discussion of when and how these regimes can overlap, see *infra* section I.C, pp. 486–87.

[6] *See infra* section I.B, pp. 480–86

[7] Christopher Wadlow, *"Including Trade in Counterfeit Goods": The Origins of TRIPS as a GATT Anti-Counterfeiting Code*, 2007 INTELL. PROP. Q. 350, 350.

[8] Barton Beebe, *Shanzhai, Sumptuary Law, and Intellectual Property Law in Contemporary China*, 47 U.C. DAVIS L. REV. 849, 872–73 (2014).

[9] *Cf.* J. Janewa Osei-Tutu, *Private Rights for the Public Good?*, 66 SMU L. REV. 767, 769 (2013) (discussing similar arguments made with respect to trademarks and copyrights).

[10] *See infra* section IV.A, pp. 518–19. The attempts to link copyright infringement — as well as unregistered trademark infringement — with counterfeiting continue. *See, e.g.*, Complaint ¶¶ 2–3, 7, 30, Art Ask Agency v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-02163 (N.D. Ill. Apr. 6, 2023), ECF 1 (using the word "counterfeit" liberally in a case alleging copyright and regular trademark infringement, even though the plaintiff did not mention — let alone assert — any registered trademarks); Complaint ¶ 1, Liforme Ltd. v. Individuals, Corps., Ltd. Liab. Cos., P'ships & Unincorporated Ass'ns Identified on Schedule A to the Complaint, No. 1:23-cv-14195 (N.D. Ill. Sept. 27, 2023), ECF 1 ("This action has been filed by Plaintiff to combat online counterfeiters who trade upon Plaintiff's reputation and goodwill by selling and/or offering for sale products in the United States in connection with Plaintiff's copyright, specifically Plaintiff's U.S. Copyright Office Registration No. VA2-311-816 (the 'LIFORME Copyright' or 'LIFORME Copyright Registration') . . . ."); *see also* Complaint ¶¶ 23–24, Antsy Labs, LLC v. Stress Cube, LLC, No. 2:17-cv-09146 (C.D. Cal. Dec. 21, 2017), ECF 1 (alleging infringement of an unregistered trade dress).

[11] Of course, some users of counterfeit rhetoric may be merely copying other, more strategic, actors. But even when a particular user is not acting with subjectively strategic intent, their use of counterfeit rhetoric may still be confusing and harmful.

they talk about design patents.[12] The problem is that some people seem to be using the word counterfeit strategically to try to conflate design patent infringement with the worst kind of intentional IP infringement — actual counterfeiting. In some cases, the use of counterfeit rhetoric seems to be an explicit (and fallacious) appeal to fear, attempting to link design patent infringement to the most dangerous kinds of actual counterfeiting such as intentionally selling unsafe car parts or fake drugs.

This Article argues that commentators, policymakers, and judges should not fall for this sham rationale. Additionally, because the words "counterfeit" and "counterfeiting" are so rhetorically loaded, we should reject the suggestions — made by certain legal academics — that we import the concept of counterfeiting into design patent law.[13] And whenever it is used in good faith, the word "counterfeiting" should be clearly and prominently defined.

This Article will use the word "counterfeiting" by itself only in this strict, U.S. term of art sense unless otherwise noted. When additional clarity seems helpful or necessary, this Article will use the phrase "actual counterfeiting" to describe the same. Defined this way, the word "counterfeit" means something different than it does in everyday English, where it is often used to refer to something that is "made in imitation of something else with intent to deceive."[14] This Article will refer to this type of activity as "colloquial counterfeiting."

This Article will use the phrase "counterfeit rhetoric" to refer to situations where the words "counterfeit" or "counterfeiting" are used but where there is no actual counterfeiting at issue.[15] Counterfeit rhetoric can occur in discussions of any form of IP.[16] But it may be especially pernicious in connection with design patent law because it is an area of IP that isn't taught (at least not in significant depth) at most law schools

---

[12] At least, outside of its specific legal meaning under U.S. law. International usage varies. For more on this, see *infra* note 26 and accompanying text.

[13] *See infra* section VI.B, pp. 529–30.

[14] *See Counterfeit*, MERRIAM-WEBSTER, http://www.merriam-webster.com/dictionary/counterfeit [https://perma.cc/7W73-VFZ9]. At least one article has suggested that this definition should be used in the context of design patents. *See* Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 254 (2011) ("A counterfeit represents a nearly exact duplicate of an item sold with the intent to be passed off as the original." (citing the Merriam-Webster definition of "counterfeit")).

[15] So, for example, if a plaintiff alleged that the sale of a particular product constituted both actual counterfeiting and design patent infringement, they would not be engaging in counterfeit rhetoric if they described the accused product as a "counterfeit." But the plaintiff would be engaging in counterfeit rhetoric if they alleged only design patent infringement and had no colorable claim for actual counterfeiting.

[16] *E.g.*, Plaintiff's Complaint for Patent Infringement ¶¶ 33–34, Lead Creation, Inc. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 8:23-cv-00049 (M.D. Fla. Jan. 6, 2023), ECF 1 (using counterfeit rhetoric in a utility patent case); Complaint for Damages and Injunctive Relief ¶¶ 11, 28, Gorge Design Grp., LLC v. Syarme, No. 2:20-cv-01384 (W.D. Pa. Sept. 15, 2020), ECF 2 (same).

and one which is likely to be less well-understood by practicing attorneys, judges, and lawmakers. These audiences might not know, for example, that a design patent may only cover a small and insignificant portion of a product's overall design.[17] That means a product can infringe a design patent without being a replica.[18]

This Article proceeds in six Parts. Part I provides a brief background of the relevant law, including an explanation of the often misunderstood test for design patent infringement. Part II identifies some ways that counterfeit rhetoric has been used in the context of design patent law and policy, including the (still largely unknown) phenomenon of "Schedule A" litigation.[19] Part III explains why there is no necessary legal or logical connection between design patent infringement and counterfeiting — or safety. Part IV situates the contemporary design patent counterfeit narrative in the larger context of IP lobbying and policy. Part V explains why counterfeit rhetoric matters, especially in the context of design patents. Part VI discusses some additional lessons and implications.

I. THE LAW

This Part explains the technical, legal definition of "counterfeit" under U.S. law. It then surveys the basics of U.S. design patent law, including an explanation of the often-misunderstood infringement test set forth in *Gorham Co. v. White*.[20] It then discusses the limited range of overlap between actual counterfeiting and design patent infringement.

A. The "Counterfeit" in U.S. IP Law

In everyday English, the word "counterfeit" is sometimes used as a synonym for "fake" or even "artificial."[21] But in U.S. IP law, the term "counterfeit" is a defined term of art. The U.S. trademark act (generally

---

[17] *See infra* section III.A.2.a.i, pp. 503–07.

[18] *See infra* section III.A.2.a.i, pp. 503–07.

[19] Because the defendants in these cases are usually listed on a document called "Schedule A," judges and others have started referring to them as "Schedule A cases." *E.g.*, Zorro Prods., Inc. v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-05761, 2023 WL 8807254, at *2 (N.D. Ill. Dec. 20, 2023) ("The factories churning out fake goods are rivaled by the factories of law firms churning out Schedule A case after Schedule A case."). In an important essay, Eric Goldman identifies and describes this phenomenon. *See* Eric Goldman, *A SAD Scheme of Abusive Intellectual Property Litigation*, 123 COLUM. L. REV. F. 183, 184 (2023). While Goldman focuses on trademark Schedule A cases, *see id.* at 185, this Article will focus on patent Schedule A cases.

[20] 81 U.S. (14 Wall.) 511 (1872).

[21] *See, e.g.*, Carl Franzen, *People Are Making and Selling Counterfeit Jellyfish in China*, POPULAR SCI. (May 9, 2016), http://www.popsci.com/people-are-making-and-selling-counterfeit-jellyfish-in-china [https://perma.cc/S5WG-S5GU] (discussing arrests of "three people accused of making and selling artificial jellyfish"); *id.* (noting that the suspects, "including a 'master' jellyfish counterfeiter," made the fake jellyfish out of "sodium alginate, calcium chloride and aluminum sulfate").

referred to as the Lanham Act[22]) defines a "counterfeit" as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark."[23]

This is not a universal definition. As noted above, in everyday English, the word "counterfeit" is often used more broadly, to describe something that is "made in imitation of something else with intent to deceive."[24] This definition might be used, for example, in reference to "counterfeit currency."[25] Complicating matters even further, the word "counterfeit" and its cognates may be used differently in other languages and in other legal systems.[26] Importantly, this means that cross-jurisdictional reports or discussions of counterfeits should be carefully scrutinized; a reader should not assume the word counterfeit means the same thing in every place and in every context.[27]

Returning to the Lanham Act definition, it is important to note that it applies only to marks that have been registered with the U.S. Patent and Trademark Office (USPTO).[28] The Lanham Act defines the word "mark" to "include[] any trademark, service mark, collective mark, or certification mark"[29] and "trademark" to:

> include[] any word, name, symbol, or device, or any combination thereof —
>
> (1) used by a person, or
>
> (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

---

[22] 15 U.S.C. §§ 1051–1141n; *see* Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 368 n.7 (1999) (noting that the federal trademark statute "is more popularly known as the Lanham Act, after its principal sponsor, Representative Fritz G. Lanham").

[23] 15 U.S.C. § 1127. A mark does not have to be registered to be protected by the Lanham Act but registration provides the mark owner with a number of important and powerful benefits. *See* Matal v. Tam, 137 S. Ct. 1744, 1752–53 (2017).

[24] *See* MERRIAM-WEBSTER, *supra* note 14.

[25] *See id.* (listing "counterfeit money" as an example of the use in the previously quoted definition).

[26] *See, e.g.*, Clark W. Lackert, *International Efforts Against Trademark Counterfeiting*, 1988 COLUM. BUS. L. REV. 161, 165 n.18 ("Careful analysis of the WIPO [counterfeiting] proposals, however, reveals difficulties in translation. For example, one of the most problematic terms to translate is 'counterfeiting' itself. The French 'contrefaçon' and the Spanish 'contrahacer' do not carry the same intentional nature as the English word. Indeed, in some languages the terms 'infringement' and 'counterfeiting' are synonymous, with no indication as to the intentional nature of the latter."). Notably, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, uses the word "counterfeit" only in connection to trademarks — not with copyrights, patents, or designs — and defines "counterfeit trademark goods" as "any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark." *Id.* at art. 51 n.14.

[27] This linguistic ambiguity can also be exploited by those who use counterfeit rhetoric, because they can use the word "counterfeit" in a way that they know (or should know) will mislead their audience but then claim that they meant to use the word in a different sense if challenged.

[28] 15 U.S.C. § 1127. This definition "requires a closer degree of similarity than is required for traditional trademark infringement or unfair competition." MCCARTHY, *supra* note 4, § 25:10.

[29] 15 U.S.C. § 1127.

> to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.[30]

In 1995, the U.S. Supreme Court reasoned that because "human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive"[31] and interpreted this provision to cover not just word marks and logos[32] but also colors.[33] In 2000, the Court further extended that reasoning to rule that trademark law could also protect product designs.[34] Trademarks for product designs, along with trademarks for packaging, are often referred to as "trade dress."[35] Notably, however, trademark protection is only available for a product design when: (1) the design is

---

[30] *Id.*

[31] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162 (1995) (interpreting the definition of "trademark" in 15 U.S.C. § 1127).

[32] *Id.* "[B]efore the 1940s, 'the subject matter of trademark [protection] was much narrower [than today] (it included only "technical trademarks," which were words or devices (logos) that did not in any way describe the goods, their geographic origin, etc.)' and 'claims of trademark infringement could only be asserted against direct competitors.'" Pamela Samuelson, John M. Golden & Mark P. Gergen, *Recalibrating the Disgorgement Remedy in Intellectual Property Cases*, 100 B.U. L. REV. 1999, 2009 n.49 (2020) (alteration in original) (quoting Email from Mark McKenna, John P. Murphy Found. Professor of L., Notre Dame L. Sch., to Pamela Samuelson, Richard M. Sherman Distinguished Professor of L., Univ. of California, Berkeley Sch. of L. (Feb. 20, 2020) (on file with the Boston University Law Review)); *see also* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1862 (2007) ("At some point in the late nineteenth century, American courts . . . divided the universe of distinguishing marks into 'technical trademarks,' which were protected in actions for trademark infringement, and 'trade names,' which could only be protected in actions for unfair competition."); *id.* at 1909 ("Trademark law in the nineteenth century was predominantly concerned with word marks and, on occasion, with labels applied to goods.").

[33] *Qualitex*, 514 U.S. at 162 (noting that "[t]he [lower] courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread)" and asking: "If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?" (citing The trademark consists of the distinctly shaped contour, or confirmation, and design of the bottle as shown, Registration No. 696,147; The mark comprises the musical notes G, E, C played on chimes, Registration No. 523,616; The mark comprises the musical notes G, E, C played on chimes, Registration No. 916,522; *In re* Clarke, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990))).

[34] *See* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000) (concluding that "trade dress constitutes a 'symbol' or 'device' for purposes of the relevant sections" of the Lanham Act); *see also id.* (noting that "trade dress" is a term for a category of things "that originally included only the packaging, or 'dressing,' of a product, but in recent years [had] been expanded by many Courts of Appeals to encompass the design of a product"). The Court has distinguished between at least two types of trade dress — product packaging, which can be inherently distinctive, and product design, which cannot. *See id.* at 212–15.

[35] *See id.* at 209.

not functional;[36] and (2) the trade dress has acquired secondary meaning.[37]

The Lanham Act gives the owner of a registered mark a civil cause of action against anyone who:

> use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . .[38]

If an "identical . . . or substantially indistinguishable" mark "is applied to or used in connection with the goods or services for which the mark is registered," that user may also be subject to criminal liability.[39] Notably, this definition requires that the counterfeiter's product be a *type* of product for which the mark is registered.[40] And neither the criminal law nor the Lanham Act requires that the counterfeit good *look* the same as the registrant's product.[41]

Both civil and criminal counterfeiting require that the offending use be "likely to cause confusion, or to cause mistake, or to deceive."[42] Notably, the relevant type of "confusion" here is confusion as to the source

---

[36] *See* TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 29 (2001) (referring to "the well-established rule that trade dress protection may not be claimed for product features that are functional" (citing *Qualitex*, 514 U.S. at 164–65; Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 775 (1992))). Readers should be careful not to assume that "functional" means the same thing in both trademark and design patent law. *See* Sarah Burstein, Commentary, Faux Amis *in Design Law*, 105 TRADEMARK REP. 1455, 1456 (2015) ("'[F]unctional' does not mean the same thing in design patent law as it does in trademark law.").

[37] *Wal-Mart*, 529 U.S. at 216. In practice, however, the USPTO may presume that a product design has secondary meaning if it has been sold for more than five years. *See* 15 U.S.C. § 1052(f).

[38] 15 U.S.C. § 1114(1)(a).

[39] 18 U.S.C. § 2320(f)(1)(A) (defining the term "counterfeit mark" for the purposes of the Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, 98 Stat. 2178 (codified at 18 U.S.C. § 2320)).

[40] *See* United States v. Edwards, No. 2:16-cr-20070, 2019 WL 5196614, at *2 n.1 (D. Kan. Oct. 15, 2019) (reading 18 U.S.C. § 2320(f)(1)(A) as requiring the "mark [be] used in connection with goods that, by virtue of being identical with or substantially indistinguishable from *a mark actually registered and in use for the type of good trafficked*, 'is likely to cause confusion, to cause mistake, or to deceive'" (emphasis added)); United States v. Park, 164 F. App'x 584, 584–86 (9th Cir. 2006) (rejecting the defendant's argument that "the government offered no evidence that . . . those marks were registered for the types of goods and services which were being sold" because "[t]he government introduced the complaint from the prior civil action, which stated that Chanel and Louis Vuitton registered and used trademarks for items like those later found in [the defendant's] Gift Shop").

[41] *See* 18 U.S.C. § 2320(f)(1); 15 U.S.C. § 1114(1)(a). That is not to say that the appearance of the accused product can never impact the question of whether or not a defendant is liable for counterfeiting. Rather, the point is that visual similarity of the product is not a necessary element in every case of counterfeiting. If, for example, the famous stylized NIKE logo is stitched on a shoe that does not look like any existing Nike shoe, consumers might still think that it is a new Nike product.

[42] 15 U.S.C. § 1114(1)(a); 18 U.S.C. § 2320(f)(1)(iv).

(or "origin") of the goods.[43] So, for the purposes of counterfeiting, the relevant question is "who *produced* this product?" not "who came up with this product design or concept?"[44]

Thus, "counterfeiting," as properly understood in the context of U.S. IP law, "is the act of putting someone else's exact [registered] trademark on products that were not produced or authorized by the trademark holder."[45] Defined in this manner, counterfeiting has been aptly described as "a uniquely pernicious form of trademark infringement."[46] It is arguably the worst form of IP infringement. Consumers should be able to rely on registered trademarks to tell them what they are buying.[47] If they take a pill labeled TYLENOL, they should be able to trust that they are taking the same medicine they've previously purchased under that name, not a different drug — or something even more dangerous, like rat poison. The idea that relying on a medicine label could be dangerous (or even fatal) is terrifying. This is what gives the counterfeit narrative so much rhetorical power.[48]

---

43 *See* Arcona, Inc. v. Farmacy Beauty, LLC, 976 F.3d 1074, 1079 (9th Cir. 2020) ("Section 1114 was 'intended to protect consumers against deceptive designations of the origin of goods, not just to prevent the duplication of trademark.'" (quoting Westinghouse Elec. Corp. v. Gen. Cir. Breaker & Elec. Supply Inc., 106 F.3d 894, 899 (9th Cir. 1997))).

44 *See* Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 31 (2003) ("We think the most natural understanding of the 'origin' of 'goods' — the source of wares — is the producer of the tangible product sold in the marketplace . . . ."). As will be discussed below, this is very different from the "deception" standard used in the design patent infringement test. *See infra* section I.B, pp. 480–86.

45 Ann Bartow, *Counterfeits, Copying and Class*, 48 HOUS. L. REV. 707, 739 (2011) (citing 15 U.S.C. §§ 1114(1), 1127 (2006); 18 U.S.C. § 2320(e)(1) (2006)).

46 S. REP. NO. 98-526, at 2 (1984), *reprinted in* 1984 U.S.C.C.A.N. 3627, 3628; *see also Arcona*, 976 F.3d at 1079 ("[A] counterfeit claim is . . . 'the "hard core" or ["]first degree" of trademark infringement' . . . ." (quoting Gibson Brands, Inc. v. John Hornby Skewes & Co., No. 2:14-cv-00609, 2016 WL 7479317, at *5 (C.D. Cal. Dec. 29, 2016))).

47 *Cf.* Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 517 (2008) (noting that "[t]he currently dominant explanation [of why trademark infringement is harmful] uses the language of economics: confusion about source or sponsorship harms producers by decreasing their incentives to invest in consistent quality and harms consumers by deceiving them into buying unwanted and inferior products"). There is another major normative theory of trademarks — producer reward. *See* Alexandra J. Roberts, *Mark Talk*, 39 CARDOZO ARTS & ENT. L.J. 1001, 1007 (2021) ("Trademark law is said to have two main goals — consumer protection and producer reward."). Under this theory, counterfeiting is uniquely harmful because the counterfeiter directly appropriates the value the producer has built up in the mark. *See id.* at 1008.

48 *See* Osei-Tutu, *supra* note 9, at 769 ("The suggestion that increased enforcement of intellectual property rights benefits the public has been particularly compelling in the context of counterfeit medicines due to the intimation that there is some health and safety benefit to the public." (citing EXEC. OFF. OF THE PRESIDENT, COUNTERFEIT PHARMACEUTICAL INTER-AGENCY WORKING GROUP REPORT TO THE VICE PRESIDENT OF THE UNITED STATES AND TO CONGRESS 1 (2011), https://trumpwhitehouse.archives.gov/sites/whitehouse.gov/files/omb/IPEC/Pharma_Report_Final.pdf [https://perma.cc/AC9L-Z74G])); *id.* at 771 ("Given the appeal of the counterfeit medicines narrative, pharmaceutical companies and other intellectual property-reliant industries, such as the music and film industries, promulgate the self-serving view that increased public enforcement of intellectual property rights has a salutary effect, not only for private companies, but for all of us.").

B. The U.S. Design Patent

In the United States, there are three types of patents — utility patents, plant patents, and design patents.[49] Design patents are available for "any new, original and ornamental design for an article of manufacture," subject to the requirements of the Patent Act.[50] An "article of manufacture" is "a thing made by hand or machine."[51] So design patents are available for qualifying designs for manufactured products, including packaging and component parts of larger products.[52] Compared to utility patents (the ones that protect technical innovations), design patents can be obtained quite easily, cheaply, and quickly.[53]

While the purpose of trademark law is to protect consumers and to reward those who produce quality goods and services,[54] the purpose of design patent law is to promote the decorative arts.[55] Given these different goals, it is not surprising that these regimes have very different tests for infringement.[56]

---

[49] 35 U.S.C. § 101 (utility patents); *id.* § 161 (plant patents); *id.* § 171 (design patents); *see also* U.S. DEP'T OF COM., U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 201 (9th ed. rev. 07.2022, Feb. 2023) [hereinafter MPEP] (listing the three types of patents).

[50] 35 U.S.C. § 171(a). For more on these requirements, see Sarah Burstein, *Is Design Patent Examination Too Lax?*, 33 BERKELEY TECH. L.J. 607, 613–24 (2018) [hereinafter Burstein, *Lax*] (explaining the current tests for novelty, nonobviousness, and ornamentality); Sarah Burstein, *Uncreative Designs*, 73 DUKE L.J. 1437, 1490 (2024) [hereinafter Burstein, *Uncreative*] (discussing the statutory requirement of originality).

[51] Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 435 (2016). For a critique of the Supreme Court's interpretation, see Sarah Burstein, *The "Article of Manufacture" in 1887*, 32 BERKELEY TECH. L.J. 1, 83 (2017).

[52] *See, e.g.*, Product Packaging, U.S. Patent No. D941,680 (issued Jan. 25, 2022); Vehicle Windshield, U.S. Patent No. D992,475 (issued July 18, 2023). Importantly, the phrase "article of manufacture" is not a synonym for "useful article," as the latter phrase is defined in the Copyright Act. *See* Burstein, *Uncreative*, *supra* note 50, at 1447–48 ("The Supreme Court has interpreted the phrase 'article of manufacture' to mean 'simply a thing made by hand or machine.' Notably, under this definition, an 'article of manufacture' is not a synonym for 'useful article' in the copyright sense." (footnotes omitted)); *see also* 17 U.S.C. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'").

[53] *See* Sarah Burstein & Saurabh Vishnubhakat, *The Truth About Design Patents*, 71 AM. U. L. REV. 1221, 1265–71 (2022) (showing that design patent grant rate has been very high in recent years); Burstein, *Lax*, *supra* note 50, at 611 (arguing "that the U.S. Court of Appeals for the Federal Circuit has made it nearly impossible for the USPTO to reject any design patent claim — regardless of how ordinary, banal, or functional the claimed design might be"); Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 124 (2016) (estimating that "a single design patent application costs approximately $5,000").

[54] *See* Roberts, *supra* note 47, at 1007.

[55] Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 524 (1872). ("The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts.").

[56] *See* Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 177 (2015) (explaining that the design patent test "is one of visual similarity, not a test of actual deception or trademark-like likelihood of confusion").

The test for trademark infringement, like the test for counterfeiting, focuses on consumer confusion in the marketplace.[57] It involves the consideration of multiple factors, such as the similarity of the marks (including similarities in sight, sound, and meaning), how and where the plaintiff's and defendant's products are sold, and how careful the relevant consumers are likely to be in making purchasing decisions.[58] In other words, the factfinder must look to how the relevant products are actually sold in the actual marketplace.

By contrast, the test for design patent infringement involves the consideration of only one factor — visual similarity.[59] A design patent is infringed if a "hypothetical ordinary observer who is conversant with the prior art"[60] would think that the accused product looks "the same" as the claimed design.[61] How similar must it look? According to the Supreme Court's decision in *Gorham Co. v. White*, it must look so similar that "an ordinary observer, giving such attention as a purchaser usually gives" would "purchase one supposing it to be the other."[62] In other words — very similar.

These points are well-established in design patent law. However, those who aren't familiar with design patent law sometimes get confused about what the "ordinary observer" standard means and how it should be applied. Therefore, this section will explain what the *Gorham* language means and how it is applied today.

1. Confusion over Gorham. — In *Gorham*, the Supreme Court held:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.[63]

To readers who are familiar with contemporary trademark law, this may sound like the Supreme Court set forth a test of consumer confusion.[64]

---

[57] *See* 15 U.S.C. §§ 1114(1)(a), 1125(a).

[58] *See* MCCARTHY, *supra* note 4, § 23:19 (explaining "foundational factors" as described in the Restatement); *see also id.* §§ 24:31–:43 (laying out the specific tests used by each circuit).

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

[60] *Id.*

[61] *Id.* at 672; *see also id.* at 681 ("The question before this court under the standard we have set forth above is whether an ordinary observer, familiar with the prior art . . . designs, would be deceived into believing the Swisa buffer is *the same* as the patented buffer." (emphasis added)).

[62] Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 528 (1872).

[63] *Id.*

[64] To readers who are familiar with contemporary copyright law, this formulation may sound like the contemporary "substantial similarity" standard for copyright infringement. But the tests are not the same. *See* Sarah Burstein, *How Design Patent Law Lost Its Shape*, 41 CARDOZO L. REV. 555, 564 (2019) [hereinafter Burstein, *Lost Its Shape*]. It does appear, however, that copyright law may have borrowed the phrase "substantial similarity" from design patent law. *See, e.g.*, Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946) (citing, inter alia, *Gorham*, 81 U.S. (14 Wall.) at 528 in support of the statement of the copyright infringement standard); Falk v. Donaldson, 57 F. 32, 35 (C.C.S.D.N.Y. 1893) (same). The author thanks Bruce Boyden for this insight and these citations.

It did not. When read in context, it is clear that *Gorham* sets forth a test of visual similarity, not a test of actual or likely consumer confusion.[65]

Before it made this statement of its holding, the Court had already decided that design patent infringement was a matter of visual similarity. The Court started its analysis by noting that "[t]he sole question" in *Gorham* was "one of fact. Has there been an infringement? Are the designs used by the defendant substantially the same as that owned by the complainants?"[66] To answer that question, the Court first had to decide what it meant for two designs to be substantially the same. The Court decided that "the true test of identity of design . . . must be *sameness of appearance*."[67] Having decided that "identity of appearance, or . . . sameness of effect upon the eye, is the main test of substantial identity of design,"[68] the Court went on to consider whether this visual similarity should be judged from the perspective of an expert or the perspective of an ordinary observer.[69] The Court picked the latter, again emphasizing that the test it was creating was a test of visual similarity.[70]

It was in this context that the Court held:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.[71]

To attorneys trained in contemporary trademark law, this sounds like a consumer confusion test. But the aforementioned context is important. And, in applying its new test, the Court conducted a visual comparison.[72] It did not inquire into how the products were sold in the market,

---

Copyright protection is also more limited than design patent protection in that it does require copying, does require minimal creativity, and has exceptions (such as fair use) that are absent in design patent law. Burstein, *Uncreative*, *supra* note 50, at 1445–46, 1452.

[65] At least not in the sense that we use the phrase "consumer confusion" in contemporary trademark law. *See* Burstein, *supra* note 56, at 177.

[66] *Gorham*, 81 U.S. (14 Wall.) at 524.

[67] *Id.* at 526 (emphasis added).

[68] *Id.* at 527 (citation omitted) (citing M'Crea v. Holdsworth [1871] 6 Ch App. 418 (Eng.)).

[69] *Id.* ("If, then, identity of appearance, or . . . sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that *the appearance should be the same* to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer." (emphasis added) (citation omitted) (citing M'Crea v. Holdsworth [1871] 6 Ch App. 418 (Eng.))).

[70] *Id.* at 527–28 (rejecting the view that the perspective should be that of an expert because "[t]here never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them. No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived").

[71] *Id.* at 528.

[72] *Id.* at 529 ("*Comparing the figure or outline of the plaintiffs' design* with that of the White design of 1867, it is apparent there is no substantial difference." (emphasis added)); *see also id.* at 530–31 (talking at even greater length about the appearances).

the channels of trade, the distinctiveness of the claimed design, whether there was actual confusion, or other factors that go into the contemporary trademark "likelihood of confusion" inquiry.[73] Instead, the Court stated:

> [W]hatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the *same in general appearance and effect, so much alike* that in the market and with purchasers they would pass for the same thing — *so much alike* that even persons in the trade would be in danger of being deceived.[74]

This passage emphasizes yet again that the test is not whether the ordinary observer is confused (or deceived) in the trademark sense, but whether the designs are "the same in general appearance and effect."[75] But what does it mean to be "the same"? How similar do the designs need to be? So similar that an observer "would be in danger of being deceived."[76] In other words, the "deception" standard is not a measure of the actual or likely conditions in a marketplace but a measure of the requisite level of visual similarity.

To understand the *Gorham* standard, it's also important to note that, while U.S. trademark rights are based on use of the mark in commerce,[77] design patents have never been subject to a working requirement.[78] While a trademark owner must participate in the marketplace in order to maintain its rights,[79] a design patent owner does not have to make, sell, or license any product at all.[80] If a design patent owner does not have to participate in the marketplace, the test for infringement cannot depend on marketplace confusion or substitution.[81]

---

[73] *Compare id.*, *with* sources cited *supra* note 58 (discussing those factors).

[74] *Gorham*, 81 U.S. (14 Wall.) at 531 (emphases added).

[75] *Id.*

[76] *Id.*

[77] *See* 2 MCCARTHY, *supra* note 4, § 16:18 ("[I]t is use in the marketplace, not federal registration, that creates a legally enforceable 'trademark' . . . .").

[78] "A working requirement is a provision of a national patent statute that states that an owner of a patent must practice his or her patented invention (i.e., to manufacture or import the invention) within the country that granted the patent." Marketa Trimble, *Patent Working Requirements: Historical and Comparative Perspectives*, 6 U.C. IRVINE L. REV. 483, 484 (2016) (noting that "[a] patent working requirement . . . is a component of many, though not all, national patent systems"). The United States "never required that U.S. nationals work their patents, but for a short period of time from 1832 to 1836 the U.S. Patent Act did include a working requirement for patent owners who were foreigners." *Id.* at 488; *see also* Cont'l Paper Bag Co. v. E. Paper Bag Co., 210 U.S. 405, 429 (1908). The first design patent act was passed in 1842. Act of Aug. 29, 1842, ch. 263, § 3, 5 Stat. 543, 543–44.

[79] *See* 2 MCCARTHY, *supra* note 4, § 16:18.

[80] Trimble, *supra* note 78, at 489.

[81] Indeed, actual marketplace conditions must sometimes be ignored in analyzing design patent infringement. *See, e.g.*, Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1324 (Fed. Cir. 2007) ("Under our case law, the ordinary observer test requires, as the district court recognized, the comparing of the accused and patented designs from all views included in the design patent, not simply those views a retail customer seeking to buy would likely see when viewing the

Indeed, the U.S. Court of Appeals for the Federal Circuit, which has exclusive appellate jurisdiction over cases involving design patent claims,[82] reads *Gorham* as setting forth a test of visual similarity. As the court has noted: "Likelihood of confusion as to the source of the goods is not a necessary or appropriate factor for determining infringement of a design patent."[83] In its en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*,[84] where the court reaffirmed that "the [*Gorham*] 'ordinary observer' test should be the sole test for determining whether a design patent has been infringed,"[85] the court restated that test as follows: "[I]nfringement will not be found unless the accused article 'embod[ies] the patented design or any colorable imitation thereof.'"[86] In other words, the accused product must *look* the same as the patented design.[87]

2. The Goddess *Test.* — In *Egyptian Goddess v. Swisa*, the Federal Circuit set forth a two-part framework for analyzing design patent infringement:

> In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear "substantially the same" to the ordinary observer, as required by *Gorham*. In other instances, when the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art . . . .[88]

---

product at the point of sale." (citing Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1379 (Fed. Cir.2002))), *abrogated on other grounds*, Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008); Lanard Toys Ltd. v. Dolgencorp LLC, 958 F.3d 1337, 1341 (Fed. Cir. 2020) ("The infringement analysis must compare the accused product to the patented design, not to a commercial embodiment." (citing Payless Shoesource, Inc. v. Reebok Int'l, Ltd., 998 F.2d 985, 990 (Fed. Cir. 1993); High Point Design LLC v. Buyer's Direct, Inc., 621 F. App'x 632, 642 (Fed. Cir. 2015))).

[82] *See* 28 U.S.C. § 1295(a).

[83] Unette Corp. v. Unit Pack Co., 785 F.2d 1026, 1029 (Fed. Cir. 1986); *see also* Braun Inc. v. Dynamics Corp. of Am., 975 F.2d 815, 828 (Fed. Cir. 1992) (noting that "purchasers' likelihood of confusion as to the source of a good is a necessary factor for determining trademark and trade dress infringement" but emphasizing that "a different quantum of proof applies to design patent infringement, which does not concern itself with the broad issue of consumer behavior in the marketplace" (citing Coach Leatherware Co. v. AnnTaylor, Inc., 933 F.2d 162, 168 (2d Cir. 1991); *Unette*, 785 F.2d at 1029)); Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 1000 (Fed. Cir. 2015) (upholding a jury instruction that said, in relevant part: "You do not need, however, to find that any purchasers actually were deceived or confused by the appearance of the accused Samsung products" (emphasis omitted)), *rev'd and remanded on other grounds*, 137 S. Ct. 429, 432 (2016).

[84] 543 F.3d 665 (Fed. Cir. 2008).

[85] *Id.* at 678.

[86] *Id.* (second alteration in original) (quoting Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1117 (Fed. Cir. 1998)).

[87] *See id.* at 682 (concluding, based on a visual analysis, that there was no infringement).

[88] *Id.* at 678. Note that the *Goddess* test is the sole test for design patent infringement. There is no separate doctrine of equivalents. *See* Minka Lighting, Inc. v. Craftmade Int'l, Inc., 93 F. App'x 214, 217 (Fed. Cir. 2004) ("The . . . test by its nature subsumes a doctrine of equivalents analysis." (citing Lee v. Dayton–Hudson Corp., 838 F.2d 1186, 1189–90 (Fed. Cir. 1988))).

So, at *Goddess* step one, "the claimed design and the accused design must be compared. If the designs don't look the same, when considered in a vacuum, there is no infringement as a matter of law."[89] If the designs are "not plainly dissimilar,"[90] the factfinder can move onto *Goddess* step two, where "the prior art may be used to narrow the presumptive scope of the patent."[91] Importantly, if the inquiry reaches step two, the prior art can only be used to narrow the presumptive scope of a design patent — not to broaden it.[92] It is the accused infringer's burden to produce examples of any narrowing prior art.[93] Therefore, "step two requires an informed and motivated defendant to work well."[94]

The level of visual similarity required to support a finding of design patent infringement is high.[95] But that does not mean that an infringer's entire product must look like a product made or sold by the patent owner. As noted above, there might not be any such product because a design patent owner need not make or sell any products at all.[96] And a design patent claim need not cover the entire design of a product.[97]

---

[89] Sarah Burstein, *Intelligent Design & *Egyptian Goddess*: A Response to Professors Buccafusco, Lemley & Masur*, 68 DUKE L.J. ONLINE 94, 98 (2019) (footnotes omitted) (noting that "[w]e might think of this step as setting forth the 'presumptive scope' of a design patent").

[90] *Id.* (quoting *Goddess*, 543 F.3d at 678).

[91] *Id.*

[92] *See Goddess*, 543 F.3d at 678 (explaining the role of the prior art); Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1337 (Fed. Cir. 2015) (rejecting a patent owner's attempt to use the prior art to broaden the scope of its patent); *see also* Burstein, *Lax*, *supra* note 50, at 612 ("[T]he prior art does not have to be considered by the factfinder in every case. The use of the prior art in the design patent infringement analysis is a one-way ratchet — it can be used to narrow the presumptive scope of a claim but cannot be used to broaden it."); Sarah Burstein, *We Need to Talk About the NDIL's Schedule-A Cases*, PATENTLY-O (Oct. 30, 2022), https://patentlyo.com/patent/2022/10/guest-post-about.html [https://perma.cc/7MVP-FYPL] ("[T]he expert appears to have relied on a theory — never adopted by, and in fact, specifically rejected by the Federal Circuit — that posits that a design patent may be entitled to a broader scope if it is 'far from' the prior art. That's not how design patent infringement works."). Some have suggested that the test is whether the accused design looks: (1) more like the claimed design; (2) or more like the closest prior art. *See, e.g.*, David Leason, *Design Patent Protection for Animated Computer-Generated Icons*, 91 J. PAT. & TRADEMARK OFF. SOC'Y 580, 592 (2009). That is incorrect. At all steps in the *Goddess* analysis the ultimate question remains the same: Does the accused product look the same as the patented design?

[93] *Goddess*, 543 F.3d at 678.

[94] Sarah Burstein, *Against the Design-Seizure Bill*, PATENTLY-O (Jan. 3, 2020), https://patentlyo.com/patent/2020/01/against-design-seizure.html [https://perma.cc/E9MT-ZUAC].

[95] For some visual examples of how the Federal Circuit has applied the "plainly dissimilar" standard, see Burstein, *supra* note 89, at 99–102.

[96] *See supra* note 78.

[97] For more on this point, see *infra* notes 209–13 and accompanying text. And technically, design patents are only available for designs for "articles of manufacture," not for all "products." *Compare* Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429, 435 (2016) ("An article of manufacture . . . is simply a thing made by hand or machine."), *with* KARL T. ULRICH & STEVEN D. EPPINGER, PRODUCT DESIGN AND DEVELOPMENT 2 (5th ed. 2011) (defining the term "product" as "something sold by an enterprise to its customers"). For more on the history and interpretation of this term of art, see generally Burstein, *supra* note 51.

A design patent applicant can "claim any 'visual characteristic[] embodied in or applied to an article' as a separate 'design.'"[98] This will be discussed in more detail below.[99] Importantly, a design patent covers only the actual shape or surface design shown in the drawings; it does not cover the larger product idea or concept.[100]

C. The (Limited) Overlap

Design patents and trademarks are different legal regimes with different purposes.[101] But there are two areas where the subject matter of design patents and trademark — that is, the things that can be protected by each regime — currently overlap. First, as noted above, product and packaging designs, or "trade dress," can now be registered as trademarks.[102] That was not always the case.[103] This extension of trademark law has been critiqued by scholars.[104] Nonetheless, and at least for the time being, packaging and product designs can be protected both by design patents and by trademarks.[105] Second, it is possible for a design

---

[98] Burstein, *Lost Its Shape*, *supra* note 64, at 556 (alteration in original) (quoting U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1502 (9th ed. rev. 08.2017, Jan. 2018)). This "anything goes" claiming regime, *id.* at 556, can be traced back to "a flawed decision built on poor logic, mis-framed issues, and ipse dixit," *id.* at 557 (referring to *In re* Zahn, 617 F.2d 261, 268 (C.C.P.A. 1980)). For a theory of how to better conceptualize a patentable design, see generally Sarah Burstein, *Whole Designs*, 92 U. COLO. L. REV. 181 (2021) [hereinafter Burstein, *Whole*].

[99] *See infra* section III.A.2.a.i, pp. 503–07.

[100] Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1332 (Fed. Cir. 2015) ("Ethicon's Design Patents cover only the specific ornamental conceptions of the features shown in their figures, and not the general concepts of an open trigger, a rounded button, and a fluted torque knob oriented in some configuration as part of an ultrasonic surgical device."); *see also* Burstein, *supra* note 89, at 111 n.67 ("Coleman appears to have been laboring under what I've referred to as 'the concept fallacy' in design patent litigation — *i.e.*, the mistaken belief that design patents protect general concepts, as opposed to just the claimed designs." (quoting Sarah Burstein, *Design Law*, TUMBLR (July 2, 2014), http://design-law.tumblr.com/post/90571053836/does-this-reflector-for-use-in-golfin-fringe [https://perma.cc/8P7Y-KJWS])).

[101] *See* Auto. Body Parts Ass'n v. Ford Glob. Techs., LLC, 930 F.3d 1314, 1320 (Fed. Cir. 2019) ("Trademarks and design patents serve different purposes . . . .").

[102] *See supra* notes 34–35 and accompanying text.

[103] *See* Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law's Secret Step Zero*, 75 STAN. L. REV. 1, 4 (2023) ("Trademark law was created with words and logos in mind, but it has more recently expanded to include other kinds of designs — particularly those courts generally refer to as 'trade dress.'" (quoting Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000))).

[104] *See, e.g.*, Glynn S. Lunney, Jr., *The Trade Dress Emperor's New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 HASTINGS L.J. 1131, 1134 (2000) (arguing that "[a]ny legitimate and serious reading of the Trademark Act of 1946 and its accompanying legislative history will reveal that Congress intended to exclude trade dress from the principal register and relegate it exclusively to the supplemental register"); Caitlin Canahai & Mark P. McKenna, *The Case Against Product Configuration Trade Dress*, *in* RESEARCH HANDBOOK ON TRADEMARK LAW REFORM 137, 140 (Graeme B. Dinwoodie & Mark D. Janis eds., 2021) (arguing that "the inclusion of product configuration trade dress as trademark subject matter was a mistake").

[105] The area of subject matter overlap, however, could and should be smaller. *See* Burstein, *Whole*, *supra* note 98, at 246.

patent applicant to claim a logo or stylized mark in certain circumstances — not as a logo or mark per se but as part of a surface design or graphical user interface.[106] Therefore, in some cases, a design patent may claim subject matter that is also protected (or protectable) by trademark law.

II. THE COUNTERFEIT NARRATIVE IN DESIGN PATENT LAW & POLICY

In recent years, counterfeit rhetoric has been used in discussions about design patents in Congress, in the courts, and elsewhere in the design patent community. This section will provide some examples of how counterfeit rhetoric has been used in these contexts.

A. *In Congress*

In December 2019, four senators introduced a bill that would have allowed U.S. Customs and Border Protection (CBP) to seize products that infringe design patents at the border.[107] The bill was called the "Counterfeit Goods Seizure Act of 2019."[108] But, as one reporter noted, there was a mismatch between the bill's title and its substance:

> The bill's title, which references counterfeiting, and substance, which allows customs to enforce design patents, might seem confusing to some. Design patent infringement and counterfeiting are not the same concepts and not all items that infringe a design patent are counterfeit. Additionally, brands can be victims of counterfeiting, even if they don't own any design patents.[109]

---

[106] *See, e.g.*, Brassiere, U.S. Patent No. D823,575 (issued July 24, 2018) (claiming a logo as a "design for a brassiere"). Note that in this example, the applicant could have used solid lines to claim the stylized word mark instead of — or in addition to — the logo. *See also* Display Screen or Portion Thereof with a Graphical User Interface, U.S. Patent No. D981,450 (issued Mar. 21, 2023) (claiming, essentially, just the Meta logo); Burstein, *supra* note 56, at 204 (explaining how the USPTO's rules for claiming "computer-generated icons" allow applicants to claim an element of a larger surface design simply drawing a dotted line around it (quoting MPEP, *supra* note 49, § 1504.01(a))). This is a descriptive point only; the question of whether applicants should be able to use design patents to protect logos and stylized word marks is beyond the scope of this Article.

[107] *See* S. 2987, 116th Cong. (2019); *see also* Press Release, Sen. Thom Tillis, Tillis, Coons, Cassidy & Hirono Introduce Bipartisan Legislation to Seize Counterfeit Products and Protect American Consumers and Businesses (Dec. 5, 2019), https://www.tillis.senate.gov/2019/12/tillis-coons-cassidy-hirono-introduce-bipartisan-legislation-to-seize-counterfeit-products-and-protect-american-consumers-and-businesses [https://perma.cc/J9QF-MLQZ] [hereinafter Seizure Press Release]. For an explanation of why this would be a bad policy, see Burstein, *supra* note 94. Proponents of these types of bills sometimes argue they will help small businesses. But as Leah Chan Grinvald has persuasively argued, these types of border-seizure measures are more likely to hurt small businesses than to help them. *See* Leah Chan Grinvald, *Resolving the IP Disconnect for Small Businesses*, 95 MARQ. L. REV. 1491, 1496, 1521–22 (2012).

[108] S. 2987 § 1.

[109] Rani Mehta, *Lawyers React to US Plans to Strengthen Design Patent Enforcement*, MANAGING IP (Jan. 14, 2020), https://www.managingip.com/article/2a5bqtj8ume32iy88ms5c/lawyers-react-to-us-plans-to-strengthen-design-patent-enforcement [https://perma.cc/H9L9-TEGH].

One of the bill's sponsors tried to link design patent infringement to counterfeiting as follows:

> While Customs and Border Protection has the authority to seize products that infringe copyrights and trademarks at the border, it lacks this same authority for products that infringe a design patent. *Counterfeiters exploit this loophole* by importing counterfeit products separately from labels containing an infringing trademark, only attaching the label once the counterfeit product has cleared customs. The Counterfeit Goods Seizure Act of 2019 closes this loophole by giving CBP the authority to seize counterfeit products that infringe design patents at the border.[110]

But a definition is not a loophole. A product without an offending label falls outside the legal definition of a "counterfeit" — unless, of course, it "is identical with, or substantially indistinguishable from" a registered trade dress.[111] But CBP can already seize products that infringe a registered trade dress.[112]

Nonetheless, supporters of the bill picked up on the "counterfeits without labels" theme. One asserted that counterfeiters were trying to evade CBP enforcement not just by "omitting labels" during importation but also by "cover[ing] or obscur[ing] the trademark and later remov[ing] the cover or the obscuring element after the goods clear Customs in order to complete the counterfeiting process."[113]

But even if counterfeit labels are sometimes added to or made visible on products after they are imported (then, and only then, making them "counterfeit goods"), the 2019 bill was not limited to — or even reasonably targeted at — such conduct. Instead, it would have empowered CBP to seize *any* "merchandise or packaging in which . . . design patent . . . protection violations are involved."[114] If actual counterfeiting were the real concern, the bill would not need to be this broad. And even if the bill's drafters meant to target counterfeiting in the colloquial sense, it would still be too broad.[115]

The 2019 bill's sponsors also made vague allusions to unspecified "safety risks" of "counterfeit goods" in support of their bill, in an apparent attempt to link things like knockoff shoes with things like fake drugs

---

[110] *See* Seizure Press Release, *supra* note 107 (emphasis added) (quoting Sen. Mazie Hirono).

[111] *See* 15 U.S.C. § 1127 (defining "counterfeit"); *supra* notes 34–35 and accompanying text.

[112] 19 C.F.R. § 133.21 (2023).

[113] Elizabeth Ferrill, *New Bill Would Empower U.S. Customs to Enforce Design Patents at U.S. Border to Combat Imported Counterfeit Goods*, IPWATCHDOG (Dec. 6, 2019, 7:15 AM), https://www.ipwatchdog.com/2019/12/06/new-bill-empower-us-customs-enforce-design-patents-us-border-combat-imported-counterfeit-goods/id=116821 [https://perma.cc/42NT-PJPP].

[114] S. 2987, 116th Cong. (2019); Dennis Crouch, *Counterfeit Goods Seizure Act of 2019*, PATENTLY-O (Dec. 5, 2019), https://patentlyo.com/patent/2019/12/counterfeit-goods-seizure.html [https://perma.cc/S6ZH-GDDK] (quoting the proposed statutory language).

[115] *See infra* section III.A.2, pp. 503–13.

in the minds of the public and their fellow legislators.[116] One of the sponsors suggested that the bill was necessary to prevent "[c]ounterfeit goods" from "lin[ing] the pockets of organized crime" but made no serious attempt to make any link between counterfeit goods — let alone organized crime — and design patent infringement.[117]

In its letter in support of the 2019 seizure bill, the International Trademark Association (INTA) averred that the bill would "help stem the flood of counterfeit goods entering the United States, and thus help protect consumers and U.S. brand owners alike."[118] INTA quoted some statistics from its own study of "counterfeit and pirated goods" but made no attempt to define "counterfeit" or to explain how that data might be relevant to the issue of design patent infringement or enforcement.[119] This maneuver — we might call it the "pivot-to-stats maneuver" — appears to be a popular one.[120] Essentially, the speaker: (1) refers to "counterfeiting" in a design patent discussion; (2) cites some statistics from a study that uses the word "counterfeiting"; and (3) never explains how (or if) the source they cite for the statistics defines the word "counterfeiting."[121] They jump straight to some scary-sounding statistics without any meaningful attempt to explain how or if those statistics might have anything to do with design patents.[122]

This lack of any serious effort to tie these statistics to design patent infringement would be bad enough even if the statistics seemed to be reliable. But there are reasons to question many of the studies and statistics that often get thrown around in discussions of "counterfeiting."[123]

---

[116] *See* Seizure Press Release, *supra* note 107 (quoting Sen. Chris Coons as saying that "[c]ounterfeit goods brought into the United States from overseas . . . pose serious safety risks" and Sen. Mazie Hirono as saying that "counterfeit products put the health and well-being of American consumers at risk"). This Article will use the word "knockoff" to refer to products that copy other products but that do not infringe any IP rights. Importantly, knockoffs are not counterfeits. *See* Julie Zerbo, *Protecting Fashion Designs: Not Only "What?" but "Who?,"* 6 AM. U. BUS. L. REV. 595, 601 n.30 (2017) (defining "knockoffs" as "unauthorized copies or imitations of a product" that "do not make use of legally protected intellectual property").

[117] *See* Seizure Press Release, *supra* note 107 (quoting Sen. Chris Coons).

[118] Letter from Etienne Sanz de Acedo, Chief Exec. Officer, Int'l Trademark Ass'n, to Sen. Thom Tillis, Chairman, S. Judiciary Subcomm. on Intell. Prop. & Sen. Chris Coons, Ranking Member, S. Judiciary Subcomm. on Intell. Prop. (Nov. 20, 2019), http://cdn.patentlyo.com/media/2019/12/Tillis-Coons-Design-Counterfeit-Seizure-Bill-11.20.19.pdf [https://perma.cc/T74J-LC6W] [hereinafter INTA Letter].

[119] *See id.*

[120] *See, e.g.*, *infra* notes 138–40 and accompanying text.

[121] *See, e.g.*, INTA Letter, *supra* note 118.

[122] *See id.*

[123] *See, e.g.*, Kenneth L. Port, *A Case Against the ACTA*, 33 CARDOZO L. REV. 1131, 1135–36 (2012) ("In the U.S. government and public media, the hyperbole regarding the negative effects of imitative commodities has become replete. . . . These numbers are suspicious. The claimants of these massive, fuzzy numbers make inaccurate assumptions about purchasing patterns. . . . [T]his fuzzy math and these fuzzy motivations are used to convince people that any amount of imitative commodities is bad, and that the public governments around the world need to enforce private

Finally, it is worth noting that design patent owners are not currently without any border-enforcement remedies. They can file complaints with the U.S. International Trade Commission (ITC).[124] The ITC has the power to enter blocking orders (enforced by CBP at the borders) against products that infringe design patents.[125] But bringing an ITC action isn't free. And it takes time. So the debate over the 2019 bill wasn't about whether design patent owners should be able to get border enforcement. It was about whether design patent owners should be able to get quicker border enforcement — paid by taxpayers.

B. In Enforcement Actions

Counterfeit rhetoric also appears in design patent enforcement actions. This section will provide some examples of how counterfeit rhetoric has been used in the federal courts.[126]

---

intellectual property rights."); *see also id.* at 1169 ("Although there seems to be some connection between terrorism and the manufacture of imitative commodities, the significance of that connection is as overstated as the raw data of imitative commodities."); *id.* at 1170 ("Commentators conclude that all imitative commodities in the world support terrorism, or more specifically, that buying an imitative commodity is supporting Al Qaeda. There is no real evidence that this is true."); Joe Karaganis, *Rethinking Piracy*, *in* MEDIA PIRACY IN EMERGING ECONOMIES 1, 37–38 (Joe Karaganis ed., 2011), https://www.ssrc.org/publications/media-piracy-in-emerging-economies [https://perma.cc/4Z5U-B5MM] ("Claims of connections between media piracy and narcotrafficking, arms smuggling, and other 'hard' forms of organized crime have been part of enforcement discourse since the late 1990s . . . . But we found no evidence of systematic links between media piracy and more serious forms of organized crime, much less terrorism, in any of our country studies."); Mike Masnick, *Hey NY Times: Can You Back Up the Claim of $200 Billion Lost to Counterfeiting?*, TECHDIRT (Aug. 2, 2010, 9:53 AM), https://www.techdirt.com/2010/08/02/hey-ny-times-can-you-back-up-the-claim-of-200-billion-lost-to-counterfeiting [https://perma.cc/W3TR-B6FP] ("Stephanie Clifford, reporter for the NY Times, can you give any evidence whatsoever to support the claim that you made in your article this past weekend that counterfeiting 'costs American businesses an estimated $200 billion a year?' I don't think that Clifford can, because that number has been thoroughly debunked time and time again. . . . [B]ack in 2008, Julian Sanchez famously went to hunt down the origins of the claim, and found that it was always totally made up." (emphasis omitted) (quoting Stephanie Clifford, *Economic Indicator: Even Cheaper Knockoffs*, N.Y. TIMES (July 31, 2010), https://www.nytimes.com/2010/08/01/business/economy/01knockoff.html?_r=2 [https://perma.cc/QUY7-L4TB])); Julian Sanchez, *750,000 Lost Jobs? The Dodgy Digits Behind the War on Piracy*, ARS TECHNICA (Oct. 7, 2008, 11:30 PM), https://arstechnica.com/tech-policy/2008/10/dodgy-digits-behind-the-war-on-piracy [https://perma.cc/UXU6-R648] ("If you pay any attention to the endless debates over intellectual property policy in the United States, you'll hear two numbers invoked over and over again, like the stuttering chorus of some Philip Glass opera: 750,000 and $200 to $250 billion. The first is the number of U.S. jobs supposedly lost to intellectual property theft; the second is the annual dollar cost of IP infringement to the U.S. economy. These statistics are brandished like a talisman each time Congress is asked to step up enforcement to protect the ever-beleaguered U.S. content industry. And both, as far as an extended investigation by Ars Technica has been able to determine, are utterly bogus.").

[124] Burstein & Vishnubhakat, *supra* note 53, at 1264–65.

[125] *Id.*

[126] Counterfeit rhetoric is not limited just to enforcement in the federal courts. Skull Shaver, LLC also made use of counterfeit rhetoric in a recent design patent complaint it filed in the ITC. Complaint, *In re* Certain Elec. Shavers, Inv. No. 337-TA-1230 (USITC Oct. 13, 2020) (terminated).

1. Samsung v. Apple. — Counterfeit rhetoric was used by several of the amici in *Samsung Electronics Co. v. Apple Inc.*[127] In that case, Apple accused Samsung of utility patent, design patent, and trademark infringement — but not counterfeiting.[128] Following the blockbuster verdict,[129] one issue on appeal was how to interpret 35 U.S.C. § 289, which sets forth a special "total profit" remedy for certain acts of design patent infringement.[130] The Federal Circuit concluded that § 289 entitles a design patent owner to the total profits of "the entire infringing product," no matter the scope of the infringed patent.[131]

While the case was on appeal at the Federal Circuit, a group of design educators submitted an amicus brief in support of Apple.[132] They argued that "strong protections for design patents and effective remedies for infringement are an indispensable tool for combatting *illicit counterfeiting* that injures the public welfare and robs industrial designers of the value of their work."[133] They asserted that "[c]ounterfeit goods can pose real health and safety concerns," raising the specter of "counterfeit

---

In that case, Skull Shaver alleged utility and design patent infringement and referred to at least some of the accused products as "counterfeit electric shavers," even when the accompanying photographs showed no use of anything that might qualify as a counterfeit mark. *Id.* ¶¶ 50–55, 107. And many of the accused products looked so markedly different from Skull Shaver's own product as to preclude any reasonable assertion of colloquial counterfeiting — let alone strong claims for design patent infringement. *See id.* at Exhibits 6A, 6B (disclosing accused products that differed from the claimed shape in ways that are not visually immaterial, including differences in the shape and proportions of the handle).

[127] 137 S. Ct. 429 (2016). For more on the background of this case and the issues appealed to the Supreme Court, see Burstein, *supra* note 51, at 16–25; Sarah Burstein, *The "Article of Manufacture" Today*, 31 HARV. J.L. & TECH. 781, 791–93 (2018).

[128] *See* Complaint, Apple Inc. v. Samsung Elecs. Co., No. 5:11-cv-01846 (N.D. Cal. Apr. 15, 2011), ECF 1 (not alleging counterfeiting); Amended Complaint, *Apple*, No. 5:11-cv-01846 (N.D. Cal. June 16, 2011), ECF 75 (same). Apple did state a claim for registered trade dress infringement. *See* Complaint, *supra*, at 28; Amended Complaint, *supra*, at 41. However, the Federal Circuit concluded that the claimed trade dresses were "functional and therefore not protectable." Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 994–96 (Fed. Cir. 2015), *rev'd and remanded*, 137 S. Ct. 429 (2016). This issue was not before the Supreme Court, which granted certiorari on only a single issue of design patent law. *See* Samsung Elecs. Co. v. Apple Inc., 136 S. Ct. 1453 (2016) (mem.) ("Petition for writ of certiorari to the United States Court of Appeals for the Federal Circuit granted limited to Question 2 presented by the petition."); Petition for a Writ of Certiorari at i, *Samsung*, 136 S. Ct. 1453 (No. 15-777), 2015 WL 10013702, at *i (presenting, as Question 2, "Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?").

[129] *See* Amended Verdict Form ¶ 22, *Apple*, No. 5:11-cv-01846 (N.D. Cal. Aug. 24, 2012), ECF 1931 (awarding Apple over $1 billion).

[130] *Apple*, 786 F.3d at 1001–02 (citing 35 U.S.C. § 289).

[131] *Id.* at 1002. In *Samsung*, the design patents that were found to be infringed covered various parts (but not the whole) of the Apple iPhone design. *See* Sarah Burstein, *The* Apple v. Samsung *Retrial: Breaking Down Apple's Design Patent Claims*, COMPAR. PAT. REMEDIES (May 15, 2018), http://comparativepatentremedies.blogspot.com/2018/05/the-apple-v-samsung-retrial-breaking.html [https://perma.cc/5QH6-8WVH].

[132] Brief of 26 Design Educators as Amici Curiae in Support of Appellee Apple Inc., Apple Inc. v. Samsung Elecs. Co., No. 14-01335 (Fed. Cir. Aug. 4, 2014), ECF 99 [hereinafter Design Educators' Brief].

[133] *Id.* at 3 (emphasis added).

smartphone batteries" that "were recalled because they overheated, causing burn and fire hazards" but making no serious effort to logically or legally connect such risks with the act or concept of design patent infringement.[134]

When the case reached the Supreme Court, other amici took up the "counterfeiting" flag.[135] For example, a group of companies that purported to "represent a cross-section of American industry engaged in the manufacture and sale of a wide variety of consumer products"[136] repeatedly used the word "counterfeit" in their brief in a way that seemed to conflate counterfeiting with design patent infringement.[137] The American Intellectual Property Law Association (AIPLA) argued that the special design patent remedy was "an important weapon in the arsenal of design-patent holders in the fight against counterfeit articles of manufacture,"[138] asserting — without any citation or support — that "many of the run-of-the-mill design patent cases are about counterfeiting."[139] It then rattled off some statistics about but made no attempt to tie those statistics to — or explain how they might be relevant to — the issue of design patent infringement.[140]

Apple also invoked some counterfeit rhetoric, asserting that if the Court overruled the Federal Circuit, it "would *empower counterfeiters* and producers of knock-offs, leading to reductions in investment in

---

[134] *Id.* at 22–23 (citing *Asurion Recalls Counterfeit BlackBerry®-Branded Batteries Due to Burn and Fire Hazards*, U.S. CONSUMER PROD. SAFETY COMM'N (Aug. 10, 2010), http://www.cpsc.gov/en/Recalls/2010/Asurion-Recalls-Counterfeit-BlackBerry-branded-Batteries-Due-to-Burn-and-Fire-Hazards [https://perma.cc/6DUR-N2ZF]).

[135] As noted above, the case did not involve any claims of counterfeiting. *See supra* note 128 and accompanying text (noting the case did not involve any claims of counterfeiting).

[136] Brief for Bison Designs, LLC et al. as Amici Curiae in Support of Respondent at 1, Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429 (2016) (No. 15-777), 2016 WL 4239198, at *1.

[137] *Id.* at 7, 24–25, 28–29 ("Thule depends upon effective U.S. design patent remedies to deter counterfeiters of its unique product designs," *id.* at 7; "Design patents are especially important to small companies, such as amicus Design Ideas, Ltd., who suffer from counterfeit lookalikes across their entire line of mesh basket products. Even small volume counterfeits can hurt its business. In 2011, it had a dispute with an importer, Idea Nuova, Inc., of New York, who sold 13,000 units of a product which clearly infringed several design patents," *id.* at 24–25 (italics omitted); "The total [design patent] profit rule was instrumental in convincing counterfeiters to stop their nefarious activities, and provided amicus with effective design patent enforcement without having to resort to litigation. For other competitors inclined to make and sell counterfeits, the total profit rule was a critical deterrent," *id.* at 28–29 (italics omitted)). In a footnote tucked deep in the brief, these amici seemed to admit they weren't using the word "counterfeit" in its technical sense. *See id.* at 15 n.24 ("While trademark anti-counterfeiting laws guard against those who are bold enough to also copy the trademark of the originator, they are ineffective against a copyist who is clever enough to omit the originator's trademark and simply copies the design/shape of the original design." (citing 18 U.S.C. § 232(c))).

[138] Brief of Amicus Curiae American Intellectual Property Law Ass'n in Support of Respondent at 3, *Samsung*, 137 S. Ct. 429 (No. 15-777), 2016 WL 4268252, at *3.

[139] *Id.* at 19.

[140] *See id.*

industrial design, an important sector of our national economy."[141] To support these assertions, Apple alluded only to arguments made by its "amici."[142] It made no attempt to explain how the issue of design patent damages might be relevant to counterfeiting, let alone how the Court's decision, either way, might "empower counterfeiters."[143] In the end, the Supreme Court rejected the proposition that a design patent owner is *always* entitled to the total profits from the defendant's entire end product.[144] But it left open the possibility that a design patent owner *might* be entitled to the total profits from the alleged infringer's entire end product, in appropriate circumstances.[145]

2. "Schedule A" Cases. — In the past decade or so, certain federal courts have received a barrage of complaints accusing large groups of online sellers of infringing various IP rights.[146] In these cases, the defendants are usually listed not on the face of the complaint itself but on a separate document, often labeled "Schedule A."[147] This document is

---

[141] Brief for Respondent at 27, *Samsung*, 137 S. Ct. 429 (No. 15-777), 2016 WL 4073686, at *27 (emphasis added).

[142] *See id.*

[143] *See id.* Later in the brief, Apple cited two amicus briefs in particular for the proposition that reversing the Federal Circuit "would remove a powerful deterrent to would-be infringers that can rapidly mass-produce counterfeit or knock-off products." *See id.* at 51 (citing, inter alia, Brief of Nike, Inc. as Amicus Curiae in Support of Neither Party at 8–10, *Samsung*, 137 S. Ct. 429 (No. 15-777); Brief of Amicus Curiae Industrial Designers Society of America in Support of Neither Party at 2, 11–15, *Samsung*, 137 S. Ct. 429 (No. 15-777)). But, as this sentence tacitly admits, counterfeits and knockoffs are two different things. And the Industrial Designers Society of America brief does not use the word "counterfeit," let alone say that design patents deter counterfeiting. *See generally* Brief of Amicus Curiae Industrial Designers Society of America, *supra*. The Nike brief mentions the word "counterfeit" twice, once in correctly defining what constitutes a counterfeit Nike shoe and once in a quotation. *See* Brief of Nike, Inc. as Amicus Curiae, *supra*, at 7 (citing 15 U.S.C. §§ 1116(d)(1)(A), 1117(b); 18 U.S.C. § 2320; WASH. REV. CODE § 9.16.030–.041); *id.* at 24 (quoting Ferrill & Tanhehco, *supra* note 14, at 259). After defining what a counterfeit shoe is, Nike then argues that it needs design patents for situations where there is no counterfeiting — that is, for shoes that "do not have a Swoosh or the Nike wordmark." *See id.* at 7–8. So these briefs do not support the connection Apple tried to draw between design patents and counterfeiting.

[144] *See Samsung*, 137 S. Ct. at 434.

[145] *See id.* The Court refused to say, however, what those circumstances might be. *Id.* at 436; *see* Burstein, *supra* note 127, at 791–93.

[146] These cases appear to target individuals and companies who have funds held by third-party platforms, most commonly sales sites such as Amazon, Walmart, AliExpress, and Etsy. *See, e.g.*, Complaint for Damages and Injunctive Relief at 1–2, Simply Mossy Art Inc. v. Individuals, P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:23-cv-06434 (S.D.N.Y. July 25, 2023), ECF 1 (suing sellers operating on "Amazon.com, Walmart.com, Etsy.com, and other[]" platforms, *id.* at 1); *see also* Schedule A, *Simply Mossy*, No. 1:23-cv-06434 (S.D.N.Y. July 25, 2023), ECF 1-1 [hereinafter Schedule A, *Simply Mossy*] (providing list of sellers sued). This litigation model has also been used to go after individuals and companies that operate on Facebook and YouTube. *See* Complaint at 1–2, Betty's Best, Inc. v. Facebook Advertisers Listed on Schedule A, No. 3:23-cv-04716 (N.D. Cal. Sept. 13, 2023), ECF 1; Complaint ¶ 5, Viral DRM LLC v. YouTube Uploaders Listed on Schedule A, No. 3:23-cv-04300 (N.D. Cal. Aug. 23, 2023), ECF 1.

[147] Goldman, *supra* note 19, at 184 & n.3 ("There are many variations, but a typical . . . complaint caption might refer to the defendants as 'the Individuals, Corporations, Limited Liability

usually filed, at least initially, under seal.[148] The plaintiffs often insist that they must keep the names of the defendants — and even sometimes their own names or patent numbers — secret, at least at the start of the case, in order to thwart the evasive efforts of nefarious counterfeiters.[149]

A number of judges, especially in the U.S. District Court for the Northern District of Illinois,[150] have allowed (and, in at least one judge's case, perhaps even encouraged) this practice.[151] These judges routinely grant Schedule A plaintiffs forms of relief that are supposed to be extraordinary, such as *ex parte* orders that freeze the defendants' assets before the defendants even know they have been sued.[152]

Companies, Partnerships, and Unincorporated Associations Identified on Schedule A Hereto,'" *id.* n.3). Some complaints use "Does" nomenclature. *See, e.g.*, Complaint at 1, Guo v. Does 1–181, As Identified in Exhibit 2, No. 1:23-cv-01271 (N.D. Ill. Mar. 1, 2023), ECF 1 [hereinafter Complaint, *Guo*]. Indeed, the oldest case in this format that the author has been able to find, to date, uses a "Does" styling. *See* Verified Complaint at 1, Deckers Outdoor Corp. v. Does 1–55 d/b/a The Aliases Identified on Schedule "A" & Does 56–500, No. 1:11-cv-00010 (N.D. Ill. Jan. 3, 2011), ECF 5 [hereinafter Verified Complaint, *Deckers*]. At least one complaint has styled the defendants as "Joes." *See* Complaint at 1, Jiangsu Huari Webbing Leather Co. v. Joes Identified in Schedule "A," No. 1:23-cv-02605 (S.D.N.Y. Mar. 28, 2023), ECF 1. In some districts, most notably the Southern District of New York, at least some plaintiffs appear to proceed by putting the defendants' aliases on the face of the complaint and filing the whole complaint under seal. *See, e.g.*, Complaint at i–ii, Smart Study Co. v. Acuteye-US, No. 1:21-cv-05860 (S.D.N.Y. Aug. 3, 2021), ECF 4 (trademark and copyright case); *see also* Complaint at 1, Jacki Easlick, LLC v. CJ Emerald, No. 2:23-cv-02000 (W.D. Pa. Nov. 20, 2023), ECF 2 [hereinafter Complaint, *Jacki Easlick*] (design patent case).

[148] *See* Goldman, *supra* note 19, at 187–90. The author has found at least one of these cases where the list of defendants was not filed under seal. *See* Schedule A, *Simply Mossy*, *supra* note 146, at 2–6 (listing 104 defendants by online storefront aliases). These documents are sometimes — but not always — unsealed after a temporary restraining order issues. *See, e.g.*, Order Granting Motion to Unseal Case at 1, Jacki Easlick, LLC v. CJ Emerald, No. 2:23-cv-02000 (W.D. Pa. Dec. 8, 2023), ECF 32.

[149] *See, e.g.*, Complaint ¶¶ 1, 42, ABC Corp. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:23-cv-03301 (N.D. Ill. May 25, 2023), ECF 1 (accusing defendants of running a "counterfeiting operation," *id.* ¶ 9, but not accusing them of any trademark infringement, just design patent infringement). For more on how this Article cites cases initially filed pseudonymously, please see *infra* note 169.

[150] While the Northern District of Illinois appears to be the epicenter of this litigation phenomenon, there are also a significant number of Schedule A cases filed in the Southern District of Florida. *See* Goldman, *supra* note 19, at 195 ("Of the 3,217 dataset cases, 2,846 cases (over 88%) were filed in the Northern District of Illinois. The Southern District of Florida had 242 cases (7.5%). The remaining jurisdictions had less than 2% each."). The Southern District of New York also appears to be an important venue for Schedule A cases. *See, e.g.*, Jiangsu Huari Webbing Leather Co. v. Joes Identified in Schedule A, No. 1:23-cv-02605, 2024 WL 20931 (S.D.N.Y. Jan. 2, 2024); *see also* Sarah Burstein, *Sanctions & Schedule A*, PATENTLY-O (Jan. 23, 2024), https://patentlyo.com/patent/2024/01/burstein-sanctions-schedule.html [https://perma.cc/V8YK-SSDS] (discussing the *Joes* case).

[151] *See* Goldman, *supra* note 19, at 196 (noting that Judge Pacold has actually provided templates for plaintiffs to use in Schedule A cases).

[152] *See* Antsy Labs, LLC v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:21-cv-03289, 2022 WL 17176498, at *1 (N.D. Ill. Nov. 23, 2022) ("This case is one of hundreds filed in this District, in which brand owners sue large groups of online merchants (generically 'identified on Schedule A'), alleging theft of intellectual property. In this case, as in most of the other 'Schedule A' cases, the court entered a temporary

It appears that, early on, most (if not all) of these cases involved claims of trademark infringement.[153] Beginning in approximately 2019, however, some of these Schedule A cases started including claims of design patent infringement.[154] But even when these cases allege only design patent infringement — and not trademark infringement of any kind — they still often include counterfeit rhetoric in their complaints.

For example, in one recent design patent case involving snow brushes, the plaintiff defined the accused products as "Counterfeit Copies," then sprinkled that phrase liberally throughout the rest of the complaint.[155] In yet another case alleging infringement of a design patent

---

restraining order and asset freeze and, later a preliminary injunction against the defendant merchants.") (copyright case); *see also* Goldman, *supra* note 19, at 190 (describing some typical steps in a Schedule A case). As Judge Seeger has recently noted, there are reasons to doubt the propriety of asset freezes in Schedule A cases. *See* Zorro Prods., Inc. v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-05761, 2023 WL 8807254, at *4–5 (N.D. Ill. Dec. 20, 2023) (denying motion to seal because "[i]f you can't freeze it, you can't seal it," *id.* at *5). A judge may have the power to order an initial asset freeze where a plaintiff has a "lien or equitable interest" in certain funds and seeks an "equitable remedy." Grupo Mexicano de Desarrollo, S.A. v. All. Bond Fund, Inc., 527 U.S. 308, 310, 318–19 (1999) (quoting 11A CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 2941 (2d ed. 1995)). But as Judge Seeger noted, "Schedule A plaintiffs typically don't request and receive equitable monetary relief. Instead, Schedule A plaintiffs rush into court, request and receive an asset freeze, and obtain a default judgment. And then, the Schedule A plaintiffs ask district courts to unfreeze the money and award statutory damages, not equitable relief." *Zorro,* 2023 WL 8807254, at *4. There are additional reasons to doubt the propriety of these asset freezes in utility patent cases, where equitable disgorgement is not an available remedy, and in design patent cases, where the disgorgement remedy set forth in 35 U.S.C. § 289 might be best described as a hybrid remedy, not a purely legal or equitable one. *See generally* Burstein, *supra* note 51 (drawing lessons and implications for § 289 by examining its predecessor, the 1887 Act, which provided in its total profits provision that remedy was available "either by action at law or upon a bill in equity," *id.* at 58 (quoting Act of Feb. 4, 1887, ch. 105, 24 Stat. 387, 387)). But a full discussion of these issues is beyond the scope of this Article.

[153] *See, e.g.*, Verified Complaint, *Deckers*, *supra* note 147, ¶ 3. Plaintiffs continue to file Schedule A cases alleging trademark infringement and actual counterfeiting. For example, Harry Styles filed such a case in December 2022. Complaint ¶ 3, Styles v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:22-cv-07044 (N.D. Ill. Dec. 14, 2022), ECF 1 ("This action has been filed by Plaintiff to combat e-commerce store operators who trade upon Plaintiff's reputation and goodwill by offering for sale and/or selling unauthorized and unlicensed products, including apparel and other merchandise, using infringing and counterfeit versions of Plaintiff's federally registered trademarks . . . .").

[154] *See, e.g.*, Complaint ¶ 3, Fitness Anywhere LLC v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:19-cv-04155 (N.D. Ill. June 20, 2019), ECF 1 (alleging infringement of U.S. Patent No. D669,945).

[155] Amended Complaint ¶ 24, XYZ Corp. (Ningbo Yongjia Aiduo Auto Parts Manu Co.) v. Individuals, P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:22-cv-24270 (S.D. Fla. Jan. 12, 2023), ECF 7 ("Defendants offer to sell exact copies and/or confusingly similar copies to the claimed designs in Plaintiff's Patent (hereinafter referred to as the Defendants' 'Counterfeit Copies') through Internet based e-commerce stores operating under the Seller IDs."). For more on how this Article cites cases initially filed pseudonymously, please see *infra* note 169. The *Ningbo Yongjia* case was not an isolated example. *See, e.g.*, Complaint ¶ 18, Pat. Holder as Identified in Exhibit 1 v. Does 1–251, as Identified in Exhibit 2, No. 1:23-cv-01488 (N.D. Ill. Mar. 10, 2023), ECF 1 ("Defendants' sales of similar and substandard copies of Plaintiff's Products ('Counterfeit

for an air purifier, the plaintiff alleged that "[t]he Asserted Patent is being infringed by *a cabal of foreign counterfeiters* intent on exploiting unknowing online consumers."[156] The plaintiff then alleged that each defendant "has offered to sell and, on information and belief, has sold and continues to sell counterfeit and/or infringing products that violate Plaintiff's intellectual property rights ('Counterfeit Products')"[157] and proceeded to use variations of the word "counterfeit" throughout the complaint,[158] even though the complaint contained no allegations of trademark infringement — let alone actual counterfeiting.[159]

In another design patent case over "ring toys,"[160] the plaintiff referred to the defendants as "counterfeiters"[161] and attached, as the only publicly filed exhibit, a report on "counterfeit and pirated goods."[162] The attached report does not, however, mention design patents.[163] The plaintiff suggested the report was relevant because:

> Third-party service providers like those used by Defendants do not adequately subject new sellers to verification and confirmation of their identities, allowing counterfeiters and infringers such as Defendants to "routinely

---

Products') are in violation of Plaintiff's intellectual property rights and are irreparably damaging Plaintiff.").

[156] Complaint, *Guo*, *supra* note 147, ¶ 2 (emphasis added). This appears to be boilerplate language for the firm that filed the complaint. *Compare id.*, *with, e.g.*, Complaint ¶ 2, Beth Bender Holdings, LLC v. Does 1–107, as Identified in Exhibit 2, No. 1:21-cv-06602 (N.D. Ill. Dec. 10, 2021), ECF 1 (alleging that various design patents were "being infringed by a cabal of foreign counterfeiters intent on exploiting unknowing online consumers"). As this quote shows, there appears to be a vein of xenophobia running through at least some of these cases. *See* ANJALI VATS, THE COLOR OF CREATORSHIP: INTELLECTUAL PROPERTY, RACE, AND THE MAKING OF AMERICANS 115 (2020) (discussing how "[h]yperracial infringement constructed Americans as good intellectual property citizens who are innocent and hardworking victims preyed upon by bad intellectual property anti-citizens who pirated and counterfeited the nation's intellectual properties"). A full discussion of this issue, however, is beyond the scope of this Article.

[157] Complaint, *Guo*, *supra* note 147, ¶ 4.

[158] *See, e.g.*, *id.* ¶¶ 5–9.

[159] The plaintiff later redefined "Counterfeit Products" as "similar and substandard copies of Plaintiff's Products." *Id.* ¶ 19. The plaintiff also resumed the counterfeit rhetoric in its motion for a temporary restraining order. *See, e.g.*, Memorandum in Support of Plaintiff's *ex parte* Motion for Entry of a (1) Temporary Restraining Order, (2) Asset Restraining Order, (3) Expedited Discovery Order, and (4) Service of Process by Email and Publication at 1, Guo v. Does 1–181, as Identified in Exhibit 2, No. 1:23-cv-01271 (N.D. Ill. Mar. 9, 2023), ECF 10 ("The Defendants use online merchant platforms to virtually peddle to unknowing consumers goods that are low-quality, unlicensed counterfeits.").

[160] Defendant Splinter Woodworking Inc. d/b/a SWOOC Games' Answer & Affirmative Defenses at 9, Doe v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:23-cv-01355 (N.D. Ill. Mar. 31, 2023), ECF 35 (identifying the patent-in-suit as U.S. Patent No. D957,527, which claims a design for a "ring toy").

[161] Complaint ¶¶ 13, 22–25, Doe v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:23-cv-01355 (N.D. Ill. Mar. 6, 2023), ECF 1 (alleging only design patent infringement but referring to the defendants as "counterfeiters," *id.* ¶ 13).

[162] *Id.* at Exhibit 2 (reproducing OFF. OF STRATEGY, POL'Y & PLANS, U.S. DEP'T OF HOMELAND SEC., COMBATING TRAFFICKING IN COUNTERFEIT AND PIRATED GOODS: REPORT TO THE PRESIDENT OF THE UNITED STATES (2020) [hereinafter COMBATING TRAFFICKING]).

[163] *See id.*

> use false or inaccurate names and addresses when registering with these e-commerce platforms." *See* report on "Combating Trafficking in Counterfeit and Pirated Goods" prepared by the U.S. Department of Homeland Security's Office of Strategy, Policy, and Plans (Jan. 24, 2020) attached as Exhibit 2 and finding that on "at least some e-commerce platforms, little identifying information is necessary" for sellers similar to Defendants and recommending that "[s]ignificantly enhanced vetting of third-party sellers" is necessary.[164]

But we only have the plaintiff's word (at least in the publicly filed complaint) that the named defendants were, in fact, "counterfeiters" or "infringers." So it is far from clear that this report is actually relevant at all. Nonetheless, this report (and similar documents) appear to have been attached to Schedule A design patent complaints with some frequency.[165]

Counterfeit rhetoric appears to be playing at least some role in convincing judges to grant Schedule A plaintiffs extraordinary relief on a regular basis. In a recent decision, Judge Durkin stated:

> In this case, and the hundreds like it routinely filed in this District, plaintiffs join dozens or even hundreds of defendants in a single case, saving themselves thousands of dollars in filing fees. *Many judges in this District permit this form of filing because . . . it is the most efficient way to address the epidemic of counterfeit goods* being sold in the United States on the internet by defendants located outside the United States.[166]

---

[164] Complaint, *supra* note 161, ¶ 13 (emphasis omitted) (quoting Combating Trafficking, *supra* note 162, at 22, 35). The first quote appears in an article by Daniel Chow. Daniel C.K. Chow, *Alibaba, Amazon, and Counterfeiting in the Age of the Internet*, 40 NW. J. INT'L L. & BUS. 157, 186 (2020).

[165] For example, in a design patent case, the plaintiff attached three documents to its complaint. Complaint, ABC Corp. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:20-cv-02930 (N.D. Ill. May 18, 2020), ECF 1 (citing OFF. OF TRADE, U.S. CUSTOMS & BORDER PROT., INTELLECTUAL PROPERTY RIGHTS: FISCAL YEAR 2018 SEIZURE STATISTICS (2019); Chow, *supra* note 164; COMBATING TRAFFICKING, *supra* note 162). None of these documents used the phrase "design patent." It's also notable that although Chow's article is attached frequently to Schedule A complaints, he neither mentioned nor endorsed that litigation model. Instead, he proposed a number of measures that online platforms could take to promote transparency and deter the sale of counterfeit products. *See* Chow, *supra* note 164, at 188–95.

[166] Roblox Corp. v. Bigfinz, No. 1:23-cv-05346, 2023 WL 8258653, at *2 (N.D. Ill. Nov. 29, 2023) (emphasis added). In PACER, this case is styled as "Roblox Corporation v. The Individuals, Corporations, Limited Liability Companies, Partnerships, and Unincorporated Associations Identified on Schedule A Hereto." *Roblox Corporation v. The Individuals, Corporations, Limited Liability Companies, Partnerships, and Unincorporated Associations Identified on Schedule A Hereto (1:23-cv-05346)*, COURTLISTENER (May 20, 2024, 5:20 AM), https://www.courtlistener.com/docket/67684608/roblox-corporation-v-the-individuals-corporations-limited-liability [https://perma.cc/X9HC-C7NC]. It is not clear why Judge Durkin chose to restyle the caption for the purposes of this particular decision. But that choice may make this case more difficult to find for researchers and defense counsel who are interested in Schedule A litigation.

In this passage, Judge Durkin seemed to be referring to all Schedule A cases, not just ones involving claims of actual counterfeiting.[167] That would be consistent with his official court website, where Judge Durkin refers to all Schedule A cases as "Counterfeit Product Cases."[168] And, in what would become the Schedule A case to reach the Federal Circuit, Judge Durkin used the word "counterfeit" to describe the accused products,[169] even though that case did not allege any trademark or trade dress infringement — let alone actual counterfeiting.[170] And he's not alone. At least three other judges in the Northern District of Illinois have used the words "counterfeiting," "counterfeit," or "counterfeiters"

---

[167] *See Roblox*, 2023 WL 8258653, at *2. It should also be noted that in this case, the plaintiff alleged trademark infringement as well as actual counterfeiting. Complaint ¶¶ 28–34, *Roblox*, No. 1:23-cv-05346 (N.D. Ill. Aug. 11. 2023), ECF 1.

[168] The author has confirmed with Judge Durkin's deputy that, by "counterfeit cases," the judge means Schedule A cases. *See* E-mail from Emily Wall, Courtroom Deputy to J. Durkin, to author (June 1, 2023, 4:04 PM) ("[T]he procedure for 'counterfeit cases' is intended to apply to Schedule A-type cases.") (on file with the Harvard Law School Library). Specifically, under the heading "Counterfeit Product Cases," Judge Durkin states that he "will presumptively require a bond of $1,000 per defendant in counterfeit product cases. Plaintiffs should inform the Court of any circumstances that make such a bond inappropriate." *Judge Thomas M. Durkin*, U.S. DIST. CT. N. DIST. OF ILL., https://www.ilnd.uscourts.gov/judge-info.aspx?HztO2ip/uh7HVAKHYpZ4iA== [https://perma.cc/Y58H-LASP].

[169] This case, as some others that use the Schedule A model, raises difficult issues with respect to citation. The case is still styled on PACER as it was in the original complaint, with pseudonyms: "ABC Corporation I v. The Partnership and Unincorporated Associations Identified on Schedule 'A.'" *ABC Corporation I v. The Partnership and Unincorporated Associations Identified on Schedule "A" (1:20-cv-04806)*, COURTLISTENER (Oct. 18, 2024, 6:19 AM), https://www.courtlistener.com/docket/18424575/abc-corporation-i-v-the-partnership-and-unincorporated-associations [https://perma.cc/5SVR-YVLQ]; *see* Complaint at 1, ABC Corp. I v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:20-cv-04806 (N.D. Ill. Aug. 17, 2020), ECF 1 (listing the plaintiffs as "ABC Corporation I" and "ABC Corporation II"). The judge later ordered the plaintiffs to file an amended complaint under their real names. *See* Minute Entry, ABC Corp. I v. P'ship & Unincorporated Ass'ns Identified on Schedule "A," No. 1:20-cv-04806 (N.D. Ill. Sept. 4, 2020), ECF 36. From that point on, the district court and the parties appear to have restyled the case as "Hangzhou Chic Intelligent Technology Co.; and Unicorn Global, Inc., Plaintiffs, v. The Partnerships and Unincorporated Associations Identified on Schedule 'A', Defendants." *See, e.g.*, Hangzhou Chic Intelligent Tech. Co. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:20-cv-04806, 2022 WL 1028834, at *1 (N.D. Ill. Apr. 6, 2022) (Durkin, J.). However, on appeal, the Federal Circuit used the "ABC" styling. *See* ABC Corp. I v. P'ship & Unincorporated Ass'ns Identified on Schedule "A," 51 F.4th 1365, 1365–66 (Fed. Cir. 2022). To try to clarify this muddied record and others like it, this Article will, from this point forward, use the following styling for docket citations: "ABC Corp. I (Hangzhou Chic Intelligent Tech. Co.) v. P'ship & Unincorporated Ass'ns Identified on Schedule 'A.'" For court decisions that are published or made available on services like Westlaw or Lexis, this Article will use the official captions.

[170] *Compare Hangzhou Chic*, 2022 WL 1028834, at *1 ("Plaintiffs allege[d] that Defendants sell *counterfeit versions* of Plaintiffs' product." (emphasis added)), *with* Third Amended Complaint ¶¶ 41–56, ABC Corp. I (Hangzhou Chic Intelligent Tech. Co.) v. P'ship & Unincorporated Associations Identified on Schedule "A," No. 1:20-cv-04806 (N.D. Ill. Nov. 19, 2020), ECF 101 (alleging infringement of four design patents and zero trademarks).

in ways that seem to refer to all Schedule A cases.[171] In another district where a significant number of Schedule A cases are filed, the Southern District of Florida,[172] at least some judges seem to have imported language from actual counterfeiting cases about "the inherently deceptive nature of the counterfeiting business" into design patent cases, citing "the inherently deceptive nature of the infringing business" to justify asset restraints in design patent cases.[173] Therefore, it seems like efforts to conflate design patent infringement — and other causes of action — with counterfeiting have had some success in shaping the way the judges see all Schedule A cases, not just ones that allege actual counterfeiting.[174]

To the extent that these judges and advocates may be intending to use the word "counterfeiting" in its colloquial sense, there is still a mismatch, especially in light of the fact that the design patent infringement claims brought in Schedule A cases are often not particularly strong; many could even be characterized as frivolous.[175] One can hardly say

---

[171] *E.g.*, Chrome Cherry Ltd. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:21-cv-05491, 2021 WL 6752296, at *1 (N.D. Ill. Oct. 20, 2021) (Valderrama, J.) (stating, in a design patent case, that "[t]he Court is aware that some judges in this District have raised concerns regarding joinder in *these types of counterfeiting cases* brought against large numbers of online defendants" (emphasis added) (citing Estée Lauder Cosms. Ltd. v. P'ships & Unincorporated Ass'ns Identified on Schedule A, 334 F.R.D. 182 (N.D. Ill. 2020); Estée Lauder Cosms. Ltd. v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 20-cv-00845 (N.D. Ill. June 22, 2020), ECF 40 (Lee, J.)); Minute Entry at 1, Harai v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-15960 (N.D. Ill. Dec. 1, 2023), ECF 17 (Hunt, J.) (referring to "Schedule A counterfeit products cases" in a copyright case, *see* Complaint at 2, Harai v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-03398 (N.D. Ill. May 30, 2023), ECF 1); Zorro Prods., Inc. v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-05761, 2023 WL 8807254, at *2 (Dec. 20, 2023) (Seeger, J.) (seeming to refer to Schedule A cases generally as "lawsuits about foreign counterfeiters").

[172] *Patent Litigation in the S.D. Fla. and Schedule A Cases*, LEX MACHINA (Jan. 22, 2024), https://www.lexisnexis.com/community/insights/legal/lex-machina/b/lex-machina/posts/patent-litigation-in-the-s-d-fla-and-schedule-a-cases [https://perma.cc/K5U7-ARZP].

[173] *Compare* Gucci Am., Inc. v. Zhang, No. 1:11-cv-23380, 2011 WL 13319484, at *3 (S.D. Fla. Nov. 2, 2011) (Torres, J.) ("In light of the inherently deceptive nature of the counterfeiting business, and Defendants' blatant violation of the federal trademark laws, Plaintiffs have well-founded fears to believe Defendants will hide or transfer their ill-gotten assets beyond the jurisdiction of this Court unless those assets are restrained."), *with* Order Granting Preliminary Injunction at 5, XYZ Corp. v. Individuals, P'ships & Unincorporated Ass'ns Identified on Schedule "A," No. 1:23-cv-24163 (S.D. Fla. Jan. 11, 2024) (Ruiz, J.) ("In light of the inherently deceptive nature of the infringing business, and the likelihood that the Defendants have violated federal patent laws, the Plaintiff has good reason to believe the Defendants will hide or transfer their ill-gotten assets beyond the jurisdiction of this Court unless those assets are restrained."). But while actual counterfeiting is inherently deceptive, design patent infringement is not. *See infra* section III.A.2.b, pp. 511–13.

[174] *See, e.g.*, Order at 1, 2, 4, Roadget Bus. Pte. Ltd. v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:24-cv-00115 (N.D. Ill. Mar. 6, 2024), ECF 58 (Bucklo, J.) (applying a rule about "counterfeiting" in a copyright case (quoting Monster Energy Co. v. Wensheng, 136 F. Supp. 3d 897, 910 (N.D. Ill. 2015)).

[175] *See, e.g.*, Order at 2, Thousand Oaks Barrel Co. v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-03378 (N.D. Ill. July 20, 2023), ECF 45 (Daniel, J.) ("When asked

that defendants are acting with intent to deceive where they are not using the plaintiff's marks and where their products do not look like the claimed designs.[176] That's not counterfeiting. It's competition.[177]

C. Among Academics and Practitioners

Counterfeit rhetoric is also used elsewhere in the design patent community. One particularly dramatic example occurred at Design Day 2018. Design Day is an annual event hosted at the USPTO that is sponsored by organizations such as the Intellectual Property Owners Association (IPO) and the AIPLA.[178] While the USPTO states on the event website that "[a]ny legal opinions expressed at this event do not necessarily represent USPTO policy,"[179] a reasonable audience member might fairly believe that, by choosing someone to be a speaker at this event, the Agency has deemed — at a minimum — that the speaker is an expert with views worth listening to.[180] Indeed, speakers often advertise

---

whether the plaintiff's design patents, which show a round or cylindrical top, covered a hexagonal top offered by one of the defendants, the plaintiff's counsel claimed that they did. Given that shape-sorting toys intended for toddlers require one to distinguish between a circle and a hexagon, the plaintiff's argument is unconvincing."); *see also, e.g.*, Complaint, *Jacki Easlick*, *supra* note 147, at 4 (showing examples of accused products that do not infringe because they have different shapes); Complaint, *Liforme*, *supra* note 10, ¶¶ 21, 57 (showing an example of an accused product that does not infringe because it has different surface ornamentation); Complaint, Schedule B & Schedule C-1, Simply Mossy Art Inc. v. Individuals, P'ships, & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-06434 (S.D.N.Y. July 25, 2023), ECF 1, 1-2, 1-3 (including — in a rare unsealed Schedule A case, *see generally* Goldman, *supra* note 19 — a number of accused products that clearly do not infringe because they have different shapes and resemble the claimed design in concept only).

[176] If judges are struggling to analyze design patent infringement, they should consider hiring special masters to help them, especially at the TRO stage. In any case, they should demand evidence of infringement by each and every defendant, no matter how many there are. If Schedule A plaintiffs are joining too many defendants to allow the judges sufficient time to review such submissions, they might consider following Judge Hunt's lead and capping the number of defendants they will allow in a Schedule A case. *See, e.g.*, Minute Entry, *supra* note 171, at 1 (allowing a Schedule A case "to proceed with no more than 40 defendants," to make the case "more manageable" and "less burdensome to plaintiffs, defendants, and the judicial system").

[177] Indeed, in many — if not most — of the design patent Schedule A cases this author has seen, at least some of the accused products are clearly not infringing at all, let alone counterfeits in any sense of that word. *See supra* notes 153–59 and accompanying text.

[178] *See Attend the 16th Annual Design Day*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/about-us/events/attend-16th-annual-design-day [https://perma.cc/CT5J-E6VT] (noting that, for Design Day 2023, "[t]he event is hosted by the USPTO and sponsored by Intellectual Property Owners Association (IPO) and American Intellectual Property Law Association (AIPLA)"). Past events have had additional sponsors. *E.g.*, *Design Day 2018– Alexandria, VA*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/about-us/events/design-day-2018 [https://perma.cc/DFG8-YGCD] ("This event is co-sponsored by the following: American Intellectual Property Law Association (AIPLA), the IP Law Section of the American Bar Association (ABA-IPL), the Intellectual Property Owners Association (IPO), the Industrial Designers Society of America (IDSA), the International Trademark Association (INTA), the International Association for the Protection of Intellectual Property (AIPPI), and the United States Patent and Trademark Office (USPTO).").

[179] *Attend the 16th Annual Design Day*, *supra* note 178.

[180] *See id.*

their participation in this event as evidence of their expertise and prominence in the field.[181]

At Design Day 2018, the well-known and respected design patent attorney Robert Katz[182] was one of the featured speakers.[183] During his presentation, Katz suggested that design patent infringement was linked to sex trafficking and terrorism.[184] Katz shared a slide saying that design patent infringers are "tied to terrorism," then listing three terrorist attacks that he described as being linked to counterfeit products.[185]

---

181 *See, e.g.*, Robert S. Katz & Bradley J. Van Pelt, *IP Alert: Highlights of Design Day 2018*, BANNER WITCOFF (May 4, 2018), https://bannerwitcoff.com/ip-alert-highlights-of-design-day-2018 [https://perma.cc/7VMX-5FFF] ("Several Banner & Witcoff attorneys and staff spoke at and/or attended Design Day 2018 at the U.S. Patent and Trademark Office. Design Day brings together design patent examiners, other USPTO representatives, design patent applicants, in-house and outside counsel, and others.").

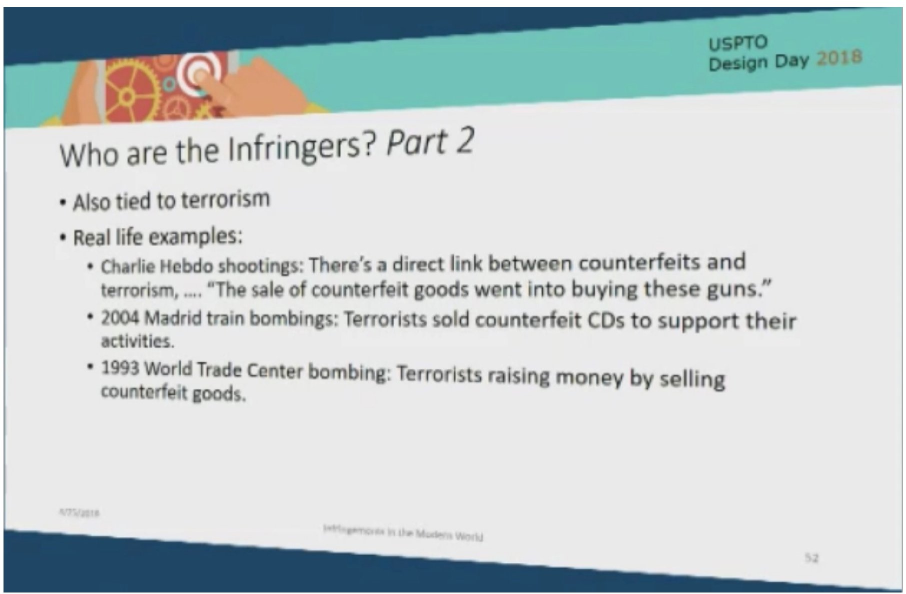
182 Katz's firm bio states: "Both nationally and internationally, Rob is considered one of the premier practitioners in the field of industrial designs, leading the way in the procurement and enforcement of design patents. . . . He is a frequent speaker on industrial design-related topics and has been invited to speak before industry and legal professional organizations on six continents." *Robert S. Katz*, BANNER WITCOFF, https://bannerwitcoff.com/people/rkatz [https://perma.cc/97TX-2P8L]. Banner Witcoff, where Katz is a principal shareholder, is a top design patent prosecution firm, with design patent clients such as Nike. *See, e.g.*, *Banner & Witcoff Becomes First Law Firm to Exceed 1,000 Design Patents in Single Year*, BANNER WITCOFF (Jan. 30, 2017), https://bannerwitcoff.com/banner-witcoff-becomes-first-law-firm-to-exceed-1000-design-patents-in-single-year [https://perma.cc/6D6B-9ECD] (listing Katz as the relevant attorney).

183 Mike Masnick, *When in Doubt, Blame Terrorists: Patent Attorney Claims Terrorists Are Infringing and Killing Jobs*, TECHDIRT (May 11, 2018, 9:30 AM), https://www.techdirt.com/2018/05/11/when-doubt-blame-terrorists-patent-attorney-claims-terrorists-are-infringing-killing-jobs [https://perma.cc/GN46-7VUG].

184 *Id.*

185 *Id.* As Mike Masnick noted in his coverage of this presentation, the alleged evidence linking these attacks to counterfeiting is questionable at best. *See id.*; *see also* Port, *supra* note 123, at 1169–70 ("The Federal Bureau of Investigation (FBI) has apparently established to its satisfaction that the primary source of funding for the group that carried out the plot in the 1993 World Trade Center bombing was a small t-shirt shop on Fifth Avenue in New York City that sold counterfeit or knockoff shirts. However, nowhere in the relevant FBI report are actual numbers used. This story, stated by the otherwise infallible FBI or not, seems to be too fantastic to be accurate." (footnotes omitted)). And even if there were strong evidence linking these attacks to counterfeiting, that still doesn't mean they were connected to design patent infringement.

Here is the slide:[186]



Katz asserted that "[m]ost of the time that people are using design patents, it's to stop activities like this."[187] He offered no evidence in support of this assertion and made no effort to tie any of these attacks to design patent infringement specifically.

III. The Legal & Logical Disconnect

As the previous Part has shown, attempts are sometimes made to link the concepts of design patent infringement and counterfeiting. This Part will explain how both actual counterfeiting and colloquial counterfeiting differ from design patent infringement and demonstrate that there is no necessary logical or legal link between them.[188]

---

[186] This screenshot was taken by the author, from the author's own recording of this part of Katz's presentation. A wider-angle view showing Katz in the frame is available at Masnick, *supra* note 183.

[187] *Id.* Based on the author's review of the recording, Katz said "that" rather than "when," so in that respect the quotation above differs from that in Masnick's article. This difference, however, does not change the quotation's meaning.

[188] This is not to say that design patent infringement and counterfeiting can never be linked in practice. A defendant might, of course, sell a product that infringes a design patent *and* bears a counterfeit trademark. The larger empirical question of how often this happens is beyond the scope of this Article. However, it is the author's anecdotal sense, based on years of reviewing complaints alleging design patent infringement, that such cases are rare — at least among cases that make it to federal court. And the point remains that design patent infringement and actual counterfeiting are not necessarily logically or legally linked.

A. Design Patent Infringement ≠ Counterfeiting

1. Design Patent Infringement Is Not the Same as Actual Counterfeiting. — As explained above, counterfeiting and design patent infringement are distinct legal causes of action.[189] The two regimes have different purposes.[190] They have different tests.[191] They are, quite simply, not the same.

It may be the case that the worst counterfeit products — the most dangerous or most deceptive — are the ones that closely resemble the overall appearance of the trademark registrant's product. But cracking down on design patent infringement would not solve the problem of look-alike counterfeits. That is because, as explained in the next section, design patent infringement is not a reliable proxy for overall visual similarity.

2. Design Patent Infringement Is Not the Same as Colloquial "Counterfeiting." — Even if we assume that some or all of these speakers are attempting to invoke the colloquial meaning of "counterfeit" — that is, something "made in imitation of something else with intent to deceive"[192] — there is still a conceptual mismatch. That is because, as the next two sections will show, design patent infringement can occur where two products look different overall and can be absent even when products look very similar.[193] Moreover, design patent infringement is a strict liability tort that does not require any intent at all, let alone an intent to deceive.[194]

(a) Design Patent Infringement Is Not a Reliable Proxy for Overall Visual Similarity. —

(i) A Product Can Look Different, Overall, And Still Infringe a Design Patent. — A design patent does not necessarily (or even usually) cover the entire design of a product.[195] A design patent applicant can claim: (1) a design for just the surface design that is applied to an article of manufacture; (2) a design for just the shape (or "configuration") of an article; or (3) the combination of both.[196] The applicant doesn't have to

---

[189] *See supra* Part I, pp. 475–87.

[190] *Compare* Arcona, Inc. v. Farmacy Beauty, LLC, 976 F.3d 1074, 1079 (9th Cir. 2020) (stating that the federal trademark law "was 'intended to protect consumers against deceptive designations of the origin of goods, not just to prevent the duplication of trademark'" (quoting Westinghouse Elec. Corp. v. Gen. Cir. Breaker & Elec. Supply Inc., 106 F.3d 894, 899 (9th Cir. 1997))), *with* Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 524 (1872) ("The acts of Congress which authorize the grants of patents for designs were plainly intended to give encouragement to the decorative arts.").

[191] *See supra* notes 57–62 and accompanying text.

[192] *See* MERRIAM-WEBSTER, *supra* note 14.

[193] *See infra* section III.A.2.a, pp. 503–11.

[194] *See infra* section III.A.2.b, pp. 511–13.

[195] *See, e.g.*, Bag, U.S. Patent No. D838,605 fig.1 (issued Jan. 22, 2019) (claiming only the handle of a bag as a design); Spectacles, U.S. Patent No. D980,309 figs.1, 4 (issued Mar. 7, 2023) (claiming only shapes of bolts and screws at hinges of eyeglasses).

[196] MPEP, *supra* note 49, § 1502; *see also* Burstein, *Lost Its Shape*, *supra* note 64, at 563 (noting that "the terms 'configuration' and 'shape' are generally used as synonyms in U.S. design law").

claim the whole shape, surface, or combination design.[197] When the applicant claims less than the whole design, they can claim any part or parts they like.[198] There is no requirement that a design patent claim be limited to "important, distinctive or otherwise salient" visual elements.[199]

In order to claim less than a whole design, the applicant uses broken lines to disclaim one or more parts of an article's overall shape or surface design.[200] When this drawing convention is used, the parts shown in broken lines "form[] no part of the claimed design."[201] These types of disclaimers are commonly depicted using dashed lines.[202] An applicant can also use broken lines to claim an area up to — but not including — a boundary that "does not exist in reality."[203] These types of boundary lines are commonly depicted using dot-dash lines.[204]

For example, in this patent, Apple claims as its design just one handle and a fragment of the top edge of a "bag"[205]:

---

[197] Burstein, *Lost Its Shape*, *supra* note 64, at 556 ("Today, the U.S. Patent and Trademark Office (USPTO) allows applicants to claim any 'visual characteristic embodied in or applied to an article' as a separate 'design.'" (quoting MPEP, *supra* note 49, § 1502)). For an argument that applicants should have to claim whole designs, see generally Burstein, *Whole*, *supra* note 98.

[198] *See* Burstein, *Lost Its Shape*, *supra* note 64, at 565.

[199] Burstein, *supra* note 53, at 116.

[200] *See* MPEP, *supra* note 49, § 1503.02(III) (explaining the uses of broken lines in design patent applications). The USPTO also allows some applicants to use different visual disclaimer conventions. *See* Burstein, *Lost Its Shape*, *supra* note 64, at 565 n.45. For more on design patent claiming, see SARAH BURSTEIN, SARAH R. WASSERMAN RAJEC & ANDRES SAWICKI, PATENT LAW: AN OPEN-ACCESS CASEBOOK 532–535 (2021), https://patentlawcasebook.com [https://perma.cc/MKS2-MQHZ].

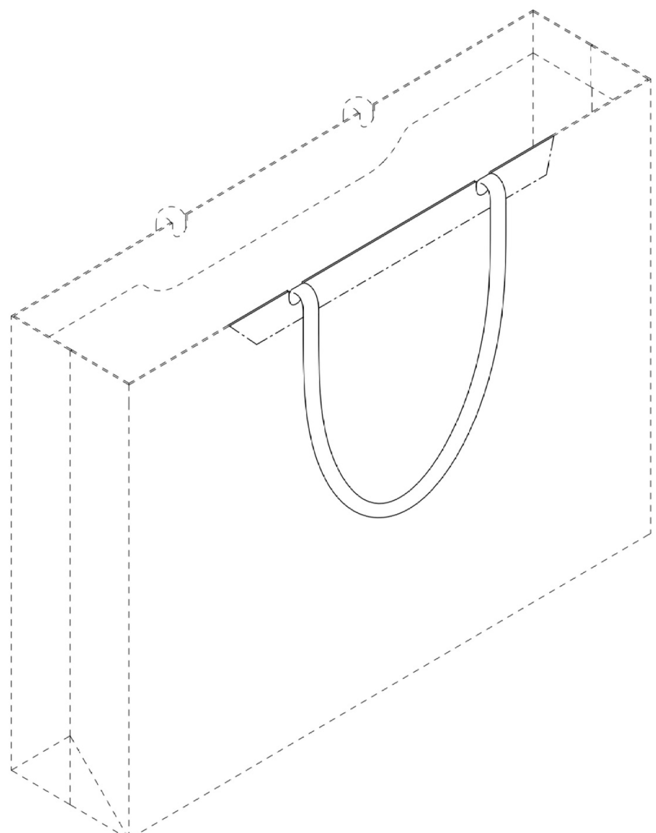
[201] MPEP, *supra* note 49, § 1503.02(III) ("The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. . . . Unclaimed subject matter must be described as forming no part of the claimed design . . . .").

[202] *See, e.g.*, *infra* note 205 and accompanying text.

[203] MPEP, *supra* note 49, § 1503.02(III) (noting that, in this case, "[i]t would be understood that the claimed design extends to the boundary but does not include the boundary").

[204] *See, e.g.*, *infra* note 205 and accompanying text.

[205] Bag, *supra* note 195, fig.1. The claim covers only the parts shown in solid lines. *See* MPEP, *supra* note 49, § 1503.01(III) ("Full lines in the drawing show the claimed design."). This Article will use the term "fragment" to mean a "physical part of an article that is not, and was not manufactured as, a complete article." *See* Burstein, *Lost Its Shape*, *supra* note 64, at 558 (setting forth this definition).



As can be seen here, the claimed design comprises part of the top edge of the bag as well as a single-looped handle extending from that edge.[206] The overall shape of the bag is disclaimed using dashed lines.[207] Dot-dash lines are used to show that the claimed fragment extends to, but does not include, a dividing line that does not appear in the larger design.[208]

Design patent applicants can also claim a design for the entire shape of an article that forms a component of a larger product.[209] For

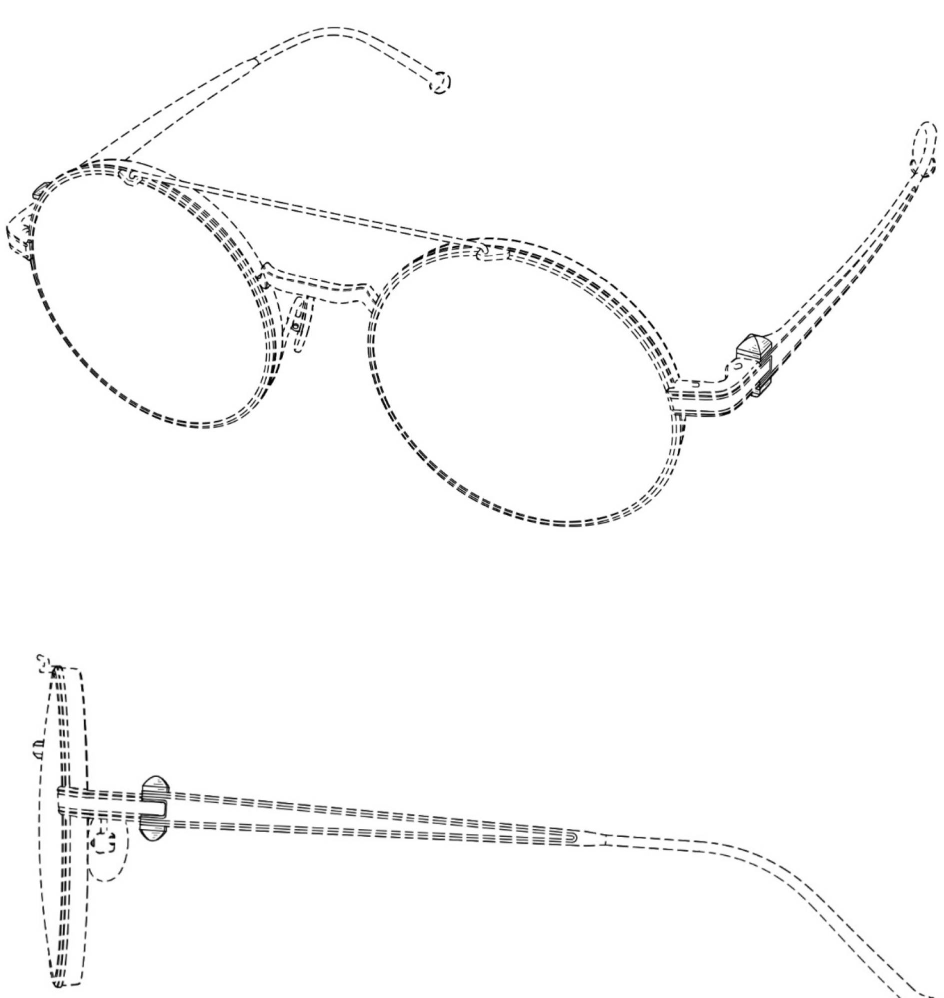
[206] *See* Bag, *supra* note 195, fig.1.

[207] *Id.* at 2 (disclaiming that "[t]he dashed broken lines in the figures show portions of the bag that form no part of the claimed design").

[208] *See id.* fig.1.

[209] This Article will use the term "component" to mean "an article that is joined with one or more others to form a composite article." *See* Burstein, *Lost Its Shape*, *supra* note 64, at 558; *see also id.* (defining "composite article" as "an article that is made from physically joining together one or more smaller articles").

example, in this patent, Cartier appears to be claiming just the shapes of the bolts and screws at the hinges of a larger pair of eyeglasses[210]:



This kind of disclaimer practice broadens the scope of the design patent claim because the test for infringement compares only "the patented design" (that is, the claimed design) to the accused product.[211] That means

[210] Spectacles, *supra* note 195, figs.1 & 4. For more examples of design patents that claim small parts of larger designs, see also Burstein, *Lost Its Shape*, *supra* note 64, at 597–98, 604–06, 611–12.

[211] Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) ("[W]e hold that the 'ordinary observer' test should be the sole test for determining whether a design patent has

that if the relevant part of the accused product looks the same as what is shown in solid lines, the patent is infringed — even if the claimed design covers only a small or insignificant design element.[212] The patent is infringed even if the accused product looks quite different, overall, from any product made or licensed by the patent owner.[213] So a pair of eyeglasses that looks very different from the eyeglasses made by Cartier could infringe the design patent shown above, as long as the screws and bolts look the same.[214] And unless the design patent uses color illustrations, the claim is not limited to any specific color or colors.[215] So, the bag patent shown above would be infringed by a bag that was a replica of an Apple Store bag (i.e., in the same shape, in white with gray handles). But it would *also* be infringed by white-and-pink bags, polka-dot bags, bags decorated with landscape paintings, bags shaped like hexagons, or any other number of bags that looked nothing like Apple's bags, save for the handle and edge shapes. Accordingly, design patent infringement is not a reliable proxy for overall visual similarity.

(ii) A Product Can Look Similar, Overall, But Not Infringe a Design Patent. — Because the standard of visual similarity required to support a finding of design patent infringement is high, and because design patent scope can vary, two products may look "similar" (in the lay meaning of that word) without infringing. For example, at the preliminary injunction hearing in *Apple, Inc. v. Samsung Electronics Co.*,[216] the trial judge famously "held up the [Apple] iPad and [accused Samsung] Galaxy Tab above her head and asked Samsung's counsel to distinguish the

been infringed. Under that test, as this court has sometimes described it, infringement will not be found unless the accused article 'embodies *the patented design* or any colorable imitation thereof.'" (emphasis added) (quoting Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116–17 (Fed. Cir. 1998)) (citing Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1319 (Fed. Cir. 2007))).

[212] *See* Burstein, *supra* note 53, at 116 (noting that "there is no requirement that the smaller portion or portions claimed in a [design patent application] represent an important, distinctive or otherwise salient design" element). For the purposes of this Article, I will use the word "'features' to refer to physical parts of a product; 'elements' to refer to visual sub-parts of a claimed design; and 'aspects' to refer to intangible attributes of an element, feature, product, or design." Burstein, *supra* note 89, at 109 (setting forth this terminology).

[213] *See* Burstein, *supra* note 51, at 11 ("[I]n analyzing infringement, the fact finder must compare the claimed portion of the design — i.e., whatever is shown in solid lines in the patent drawings — to the corresponding portion of the accused design. If the relevant portion looks 'the same,' in light of the prior art, the patent is infringed." (footnote omitted) (citing Hutzler Mfg. Co. v. Bradshaw Int'l, Inc., No. 1:11-cv-07211, 2012 WL 3031150, at *9–10 (S.D.N.Y. July 25, 2012); *Egyptian Goddess*, 543 F.3d at 672)). For one visual example of how adding broken lines can broaden a design patent claim, see Burstein, *Whole*, *supra* note 98, at 189–90.

[214] It may be that, in obtaining a patent for a commonly replaced eyeglass part, Cartier was more interested in cornering the repair market. But the larger point remains.

[215] *See* Burstein, *supra* note 53, at 113 (quoting MPEP, *supra* note 49, § 1503.02(V)).

[216] 920 F. Supp. 2d 1116 (N.D. Cal. 2013).

gadgets."[217] According to one courtroom report, "[t]he lawyers struggled to get it right."[218]

But the jury (quite correctly) found that Samsung's tablets did not infringe the asserted Apple design patent.[219] How can this be, if the products looked so similar? One reason is that the asserted tablet patent, U.S. Patent No. D504,889, did not actually cover the design of the Apple iPad. Instead, it disclosed an older, clunkier design[220]:

Here are some additional views[221]:

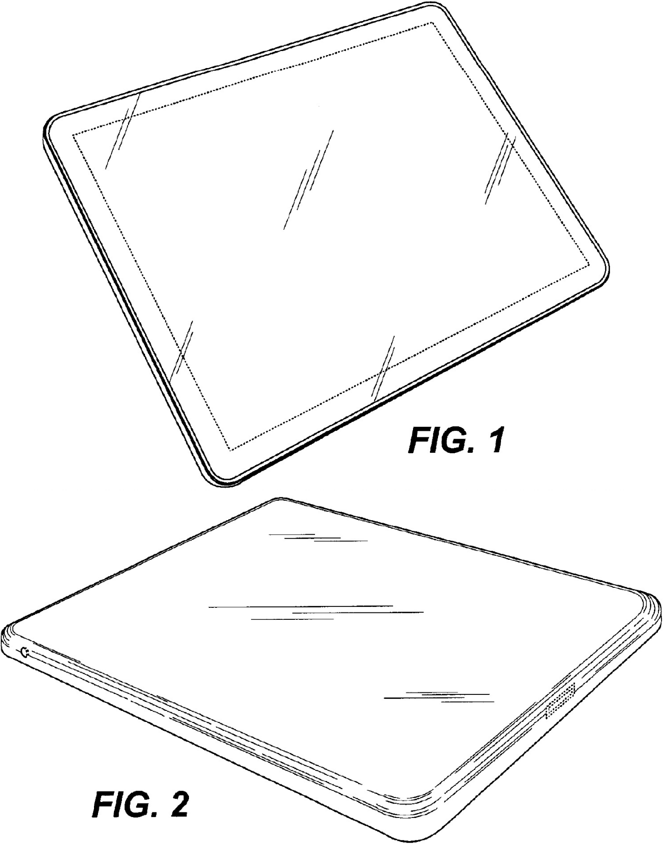
[217] Cecilia Kang, *As Apple and Samsung Vie over Tablet Patents, Judge at Center of a Tech Storm*, WASH. POST (July 18, 2012), https://www.washingtonpost.com/business/technology/as-apple-and-samsung-vie%20-over-tablet-patents-judge-at-center-of-a-tech-storm/2012/07/18/gJQAl8VeuW_story.html [https://perma.cc/G5SS-UQDM].

[218] *Id.*

[219] Amended Verdict Form, *supra* note 129, ¶ 8 (finding that U.S. Patent No. D504,889 was not infringed by either the Galaxy Tab 10.1 (WiFi) or Galaxy Tab 10.1 (4G LTE)).

[220] Electronic Device, U.S. Patent No. D504,889 fig.9 (issued May 10, 2005). This patent claim was filed on March 17, 2004, *see id.* col. 1 l. 22, and appears to claim the shape of an early iPad prototype. *See* Devin Coldewey, *Photos Emerge of 2004 iPad Prototype*, NBC NEWS (July 18, 2012, 7:35 PM), https://www.nbcnews.com/tech/gadgets/photos-emerge-2004-ipad-prototype-flna893404 [https://perma.cc/999E-UTXH] ("Court documents in the Apple vs. Samsung lawsuit have yielded photos of an iPad prototype dating back to 2004 or earlier. NetworkWorld found them among court document filings that were confidential until a recent legal action exposed them. . . . The device they show is definitely clunkier than the first real iPad, introduced in 2010 . . . ." (linking to Yoni Heisler, Opinion, *Earliest Known Photos of an Apple iPad Prototype*, NETWORKWORLD (July 18, 2012), https://www.networkworld.com/article/2222798/earliest-known-photos-of-an-apple-ipad-prototype.html [https://perma.cc/MT3X-DESR])). *See generally* Roger Fingas, *A Brief History of the iPad, Apple's Once and Future Tablet*, APPLE INSIDER (Apr. 3, 2018), https://appleinsider.com/articles/18/04/03/a-brief-history-of-the-ipad-apples-once-and-future-tablet [https://perma.cc/3SCS-49TJ] ("Work on the iPad itself actually traces back to 2004, when designer Jonathan Ive and others crafted a new tablet prototype.").

[221] Electronic Device, *supra* note 220, figs.1 & 2.



Note that the entire shape of the tablet is shown in solid lines, without any broken-line disclaimers.[222] And the oblique lines make the scope even narrower. As the district judge noted in construing this claim:

> The D'889 also includes oblique line shading on several of the figures. The oblique line shading in Figures 1-3 and Figure 9 depicts a transparent, translucent, or highly polished or reflective surface from the top perspective view of the claimed design, the top view of the claimed design, and the bottom perspective view of the claimed design.[223]

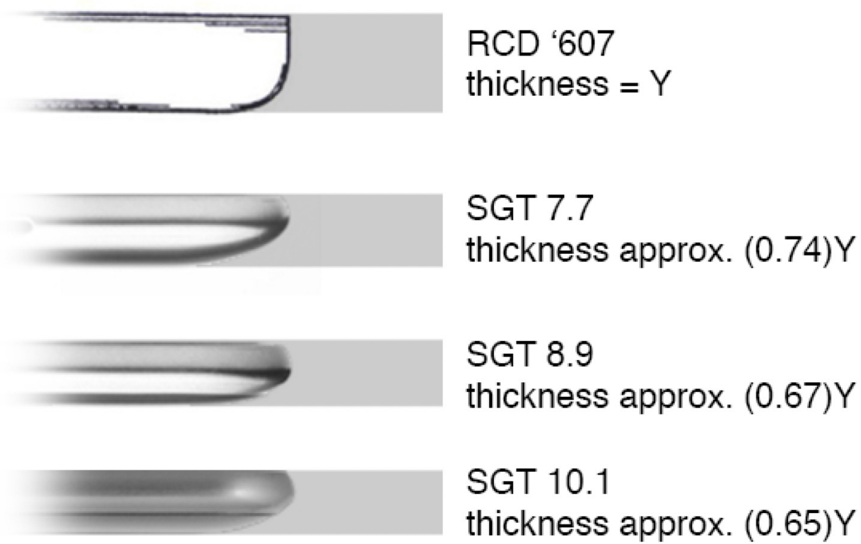
---

[222] *Id.* col. 2 l. 57 (using broken line disclaimer language only in connection with the depiction of a human shown in figure 9).

[223] Final Jury Instruction No. 43 at 59, Apple, Inc. v. Samsung Elecs. Co., No. 5:11-cv-01846 (N.D. Cal. Aug. 21, 2012), ECF 1903; *see also* Order Regarding Design Patent Claim Construction,

The accused tablets had rear surfaces that were matte.[224] So those tablets did not infringe.[225]

And even if the claim had not contained the oblique lines, the infringement claim should have failed because the claimed shape had totally different, much clunkier, proportions than the accused tablets. These differences are perhaps most easily seen in these comparison images, which were submitted by Apple's counsel in the U.K. case[226]:



The "SGT" labels indicate accused Samsung products.[227] The label "RCD" refers to Apple's Registered Community Design,[228] which has the same drawings as the U.S. design patent.[229] As the UK court noted,

No. 5:11-cv-01846, 2012 WL 3071477, at *9–10 (N.D. Cal. July 27, 2012) (construing the claimed design); *id.* at *6–7 ("The MPEP explains 'while surface shading is not required under 37 CFR 1.152, it may be necessary in particular cases to shade the figures to show clearly the character and contour of all surfaces of any 3-dimensional aspects of the design. . . . Oblique line shading must be used to show transparent, translucent and highly polished or reflective surfaces, such as a mirror.'" (quoting MPEP, *supra* note 49, § 1503.2(II))).

[224] *See* Apple, Inc. v. Samsung Elecs. Co., 920 F. Supp. 2d 1116, 1127 (N.D. Cal. 2013) ("Apple argues that, contrary to this Court's construction, the D'889 Patent does not require a shiny back surface, and thus, the Galaxy Tab 10.1, with its matte surface, infringes.").

[225] Amended Verdict Form, *supra* note 129, ¶ 8.

[226] Samsung Elecs. (UK) Ltd. v. Apple Inc [2012] EWCA (Civ) 1339 [43] (noting that this image comes from an exhibit submitted by Apple).

[227] *See id.*

[228] *See id.*

[229] *Compare* Registered Community Design No. R000181607–0001, at 55, *with* Electronic Device, *supra* note 220, figs.1, 2, 3, 4, 5, 6 & 8.

the accused products differ noticeably from the claimed design in both profile shapes and proportions.[230]

Accordingly, a product can look the same as a patentee's product without infringing the patentee's patent. Design patent infringement is not the same thing as overall visual similarity.

(b) Design Patent Infringement Does Not Require Intent to Deceive. — As noted above, the colloquial definition of "counterfeit" implies an intent to deceive.[231] And it is difficult to imagine actual counterfeiting occurring unintentionally.[232] Design patent infringement, on the other hand, requires no intent to deceive.[233]

You don't need to know a patent exists in order to infringe it.[234] You don't need to engage in any copying in fact.[235] You don't need to engage in any deceptive or inherently blameworthy behavior at all — let alone intend to deceive anyone about anything. All you need to do to infringe a design patent is make, use, offer to sell, or import an article that embodies a patented design.[236]

In some cases, a product may not even *be* infringing when it is first designed, produced, or sold. A sophisticated competitor can use the design patent system to write claims that cover existing products ex

---

[230] *See Samsung Elecs. (UK) Ltd.*, [2012] EWCA (Civ) at [43] ("By contrast with the crisp edge of the design, all three of the Samsung products have a side which curves a little *outwards* (so a bit bezel-like) before curving back in and under. And none of them have a vertical portion.").

[231] *See supra* note 24 and accompanying text.

[232] Recall that, for civil counterfeiting, "counterfeit" is defined as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." 15 U.S.C. § 1127. Although the Lanham Act contemplates that someone might possibly be liable for counterfeiting without intent or knowledge, *see* 15 U.S.C. § 1117(b), it seems unlikely in practice. And criminal counterfeiting requires that the proscribed acts be done "intentionally." 18 U.S.C. § 2320(a). Indeed, McCarthy defines "counterfeiting" as "the act of producing or selling a product with a sham trademark that is an *intentional and calculated* reproduction of the genuine trademark." MCCARTHY, *supra* note 4, § 25:10 (emphasis added).

[233] *See* 35 U.S.C. § 271; *see also* William J. Seymour & Andrew W. Torrance, *(R)evolution in Design Patentable Subject Matter: The Shifting Meaning of "Article of Manufacture*,*"* 17 STAN. TECH. L. REV. 183, 214 (2013) ("[P]atent infringement is a strict liability offense."). *See generally* Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665 (Fed. Cir. 2008) (en banc) (not mentioning any scienter requirement). As discussed *supra* section I.B.1, pp. 481–84, the test for design patent infringement is a test of visual similarity, *not* deception or confusion in the trademark sense.

[234] Of course, if you do know it exists, that may be relevant to the question of damages. *See* Halo Elecs., Inc. v. Pulse Elecs., Inc., 579 U.S. 93, 105 (2016) ("The subjective willfulness of a patent infringer, intentional or knowing, may warrant enhanced damages . . . .").

[235] *See* JEANNE C. FROMER & CHRISTOPHER JON SPRIGMAN, COPYRIGHT LAW: CASES & MATERIALS 214 (Version 5.0 2023) (distinguishing between "copying in fact" and "copying in law" in copyright and stating: "The element of 'copying in fact' is established by showing that the defendant actually used some elements of the plaintiff's work . . . . That is, the first part of the infringement tests asks whether, as a factual matter, the defendant copied from the plaintiff's work."). For more on how and why design patent infringement might occur without copying in fact, see *supra* notes 59–62 and accompanying text.

[236] *See* 35 U.S.C. § 271(a).

post.[237] So a product can be noninfringing when it is manufactured but infringing by the time it is sold. Or it can be noninfringing when introduced on the market and later become infringing. This means that even someone who intentionally designs around an existing design patent may still be caught in an infringing net.[238]

By linking design patent infringement with counterfeiting, those who seek increased design patent protection may be trying to insinuate that design patent infringers, like counterfeiters, are intentional wrongdoers — and perhaps that they are intentional wrongdoers who would have no qualms about selling shoddy or unsafe products.[239] As Patricia Loughlan noted, "it is in fact quite hard to think of a thief as any sort of good guy at all once you have begun thinking about him, even just impressionistically, as a thief."[240] Linking design patent infringement to counterfeiting immediately paints design patent infringers (or accused infringers) as bad guys, an impression that may be difficult for judges, policymakers, and others to shake.[241]

Some may argue that because design patent infringement requires a high degree of visual similarity, any infringement must be intentional. That may be true in cases where a design is creative and the patent covers the whole design. It may be difficult to infringe such a patent without copying in fact.[242] But not all design patents claim whole designs.[243] And even when they do, the Federal Circuit does not currently require patentable designs to rise to even the low standard of visual creativity required by the Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co*.[244] A design patent for an uncreative design

---

[237] *See* Burstein, *Costly Designs*, *supra* note 53, at 115–17 (explaining this ex post claiming strategy). For an example, see Perry J. Saidman, *The Crisis in the Law of Designs*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 301, 319–22 (2007).

[238] Designing around an existing patent is not, of course, legally or morally wrong. Indeed, we generally think that designing around a patent is a good thing.

[239] *See infra* section III.B, pp. 514–17.

[240] Patricia Loughlan, Opinion, *"You Wouldn't Steal a Car . . .": Intellectual Property and the Language of Theft*, 29 EUR. INTELL. PROP. REV. 401, 401 (2007).

[241] *See id.*

[242] On the concept of "copying in fact," see FROMER & SPRIGMAN, *supra* note 235, at 214–24. Of course, one can copy a product without knowing that the product is the subject of a design patent.

[243] *See supra* section III.A.2.a.i, pp. 503–07.

[244] 499 U.S. 340 (1991). *See id.* at 345 ("Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity."). In *Feist*, the Supreme Court was interpreting the Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended in scattered sections of the U.S. Code). But the word "original" also appears in the design patent statutory subject matter provision. *See* 35 U.S.C. § 171(a). And if, as the Supreme Court held, originality is a requirement of the Constitution, not just the Copyright Act, then it may well be a requirement for patents as well. *See Feist*, 499 U.S. at 346 ("Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution . . . ."); *see also* Burstein, *Uncreative*, *supra* note 50, at 1488–98 (discussing this issue in more detail and arguing that design owners should not be able "to use the design patent system to evade the low bar set by *Feist*," *id.* at 1488).

could be duplicated without any copying in fact.[245] Similarly, a design patent that claims a design for a small or functional (in the lay sense of the word) part of a larger design might be duplicated without copying.[246]

Even if someone does copy, they might not know the product is patented, might think the patent is invalid, or may have other reasons to believe their copying is legally justified. These beliefs won't get them off the hook for infringement but they are relevant to questions of general blameworthiness and intent.[247]

And there's nothing inherently — let alone legally — wrong with copying someone else's product design. As the Supreme Court noted in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*[248]:

> [I]n many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. As the Court has explained, copying is not always discouraged or disfavored by the laws which preserve our competitive economy.[249]

Not only is copying an unpatented product generally allowed but, as the Court also noted, "[a]llowing competitors to copy will have salutary effects in many instances."[250] So copying isn't inherently bad. And design patent infringement — whether it arises from copying or not — isn't inherently morally suspect.

---

[245] *Cf.* Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 705 (2003) ("[O]ne reason a sensible copyright regime would distinguish uncreative from creative work is that uncreative work introduces extraordinary problems of proof. Were two litigants to step forward with remarkably similar uncreative works, a court would find it virtually impossible to determine whether one copied from the other (impermissible infringement), or whether instead any similarity simply resulted from the fact that both works lack creativity.").

[246] For more on how the Federal Circuit has defined the concept of "functionality" in design patent law, see Burstein, *supra* note 36, at 1456–57.

[247] The question of knowledge is also relevant to arguments about deterrence. *See* Samuelson et al., *supra* note 32, at 2064 ("The deterrence justification is particularly weak when a defendant is unaware it is violating a design patent or has reasonable grounds to believe it is not infringing a valid patent.").

[248] 532 U.S. 23 (2001).

[249] *Id.* at 29 (citing Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 160 (1989)); *see also* Smith v. Chanel, Inc., 402 F.2d 562, 563, 567 (9th Cir. 1968) ("Since appellees' perfume was unpatented, appellants had a right to copy it, as appellees concede.").

[250] *TrafFix*, 532 U.S. at 29; *see also Bonito Boats*, 489 U.S. at 151 ("The attractiveness of [the patent] bargain, and its effectiveness in inducing creative effort and disclosure of the results of that effort, depend almost entirely on a backdrop of free competition in the exploitation of unpatented designs and innovations."); MCCARTHY, *supra* note 4, § 1:2 ("Imitating a successful commercial idea that is not protected by intellectual property is the essence of free competition. The second comer who imitates by offering an equivalent product or service at a lower price or with better quality is to be encouraged because legitimate imitation is essential in a competitive economy.").

B. There Is No Necessary Link Between Design Patents and Safety

Some who use the counterfeit rhetoric point to concerns about quality or safety.[251] For example, in a blog post supporting the border seizure bill, the well-known and respected design patent attorney Elizabeth Ferrill stated that:

> The U.S. Joint Strategic Plan [on IP Enforcement] also described the ramifications of these counterfeiting techniques. In addition to the large negative fiscal impact that counterfeit goods have on the U.S. economy, the report also noted that the goods may pose consumer safety concerns. For example, the Joint Strategic Plan reported on the risk to consumer health and safety posed by counterfeit versions of personal care products, consumer electronics, and automotive parts, *all of which are often protected by design patents*. According to the Plan, counterfeit personal care products (e.g., sunscreen, cosmetics, and perfume) often include dangerous contaminants (e.g., carcinogens and urine) or lack the effective ingredients (e.g., SPF). Likewise, counterfeit consumer electronics (e.g., power adapters, chargers, and devices) may fail or overheat leading to fire and electrocution risks. Counterfeit automotive parts (e.g., wheels, headlights, and windshields) often have higher failure and malfunction rates than genuine parts.[252]

---

[251] *See, e.g.*, Letter from Henry Hadad, President, Intell. Prop. Owners Ass'n (IPO) & Barbara A. Fiacco, President, Am. Intell. Prop. L. Ass'n (AIPLA) to Sens. Thom Tillis & Chris Coons (Dec. 5, 2019), https://cdn.patentlyo.com/media/2019/12/Joint-Letter_Counterfeit-Good-Seizure-Act.pdf [https://perma.cc/5NPG-GFLZ] ("Products incorporating knockoff and counterfeit designs are often not manufactured to the same quality and safety standards as a genuine product, posing usability problems and safety risks to the unsuspecting consumer."); David Brzozowski & Teresa Lavenue, *Bi-Partisan Legislation Would Permit U.S. Customs to Seize Counterfeits Infringing Design Patents*, MONDAQ (Jan. 2, 2020), https://www.mondaq.com/unitedstates/trademark/879148/bipartisan-legislation-would-permit-us-customs-to-seize-counterfeits-infringing-design-patents [https://perma.cc/U2SL-PLGK] (stating that the border seizure bill would "expand the breadth of counterfeit goods that U.S. Customs can seize, including potentially hazardous counterfeits such as personal hygiene items containing contaminates and consumer electronics that may fail when in use"). Some of these arguments may be, at least in part, a response to prior arguments that distinguish designer bags and films, on one hand, from unauthorized medicines. *See, e.g.*, Osei-Tutu, *supra* note 9, at 772 (noting that "the demands for state enforcement of private intellectual property rights are not limited to industries where there is some clear health and safety issue, but extend to a variety of intellectual property goods, ranging from designer bags to films" (citing Letter on Trans-Pac. P'ship Negotiations from Various Indus. Ass'ns to the President of the U.S. (May 8, 2012))).

[252] Ferrill, *supra* note 113 (emphasis added) (not citing any sources to support the empirical assertion at the end of the quote). In a blog post supporting the same bill, Perry Saidman made a similar point using eerily similar language. *See* Perry Saidman, *Legislation Introduced to Make Design Patents Enforceable at the U.S. Border, Like Copyrights and Trademarks*, DESIGN L. PERSPS. (Dec. 20, 2019), https://www.designlawperspectives.com/blog/legislation-introduced-to-make-design-patents-enforceable-at-the-us-border-like-copyrights-and-trademarks [https://perma.cc/N3NC-2FYQ] ("[C]ounterfeit consumer electronics (e.g., power adapters, chargers, and devices) may fail or overheat leading to fire and electrocution risks. Counterfeit automotive parts (e.g., wheels, headlights, and windshields) often have higher failure and malfunction rates than genuine parts."). The latter post also appears to copy another paragraph from Ferrill almost verbatim. *Compare* Ferrill, *supra* note 113 (paragraph starting with: "The infringement test for design patents was simplified in 2008 . . . ."), *with* Saidman, *supra* (paragraph starting with: "The infringement test for design patents was simplified in 2008 . . . ."). The link to the report Ferrill cited is broken now.

Ferrill thus seemed to be suggesting that because a report had discussed safety risks related to certain types of products and because those types of products "are often protected by design patents," that means that increasing design patent enforcement could promote safety.[253]

But there is no legal or logical link between design patents and safety. You don't need to make any product — let alone a safe one — to get a design patent. No one at the USPTO performs a quality or safety check of the applicant's product (if any) as a part of the patent examination process. A design patent is not, in any way, a guarantee of quality.[254] Signaling a producer's reputation for quality or safety is the role of trademark law, not design patent law.[255] If, for example, an airplane manufacturer were to develop a reputation for prioritizing profits over safety, consumers may decide to avoid (and airlines may decide to stop buying) airplanes made by that manufacturer.[256] But the fact that a given airplane is the subject of — or in some way infringes upon — a

---

See Ferrill, *supra* note 113 (linking to https://www.whitehouse.gov/sites/whitehouse.gov/files/omb/IPEC/2016jointstrategicplan.pdf). But it appears that she was referring to a document created by the Office of the Intellectual Property Enforcement Coordinator entitled "Supporting Innovation, Creativity & Enterprise: Charting a Path Ahead, U.S. Joint Strategic Plan on Intellectual Property Enforcement (FY 2017–2019)." The report does not clearly define what it means by "counterfeit" and largely seems to lump "counterfeit and infringing goods" into one large category. *See generally* OFF. OF THE INTELL. PROP. ENF'T COORDINATOR, SUPPORTING INNOVATION, CREATIVITY & ENTERPRISE: CHARTING A PATH AHEAD, U.S. JOINT STRATEGIC PLAN ON INTELLECTUAL PROPERTY ENFORCEMENT FY 2017–2019 (2016), https://obamawhitehouse.archives.gov/sites/default/files/omb/IPEC/2016jointstrategicplan.pdf [https://perma.cc/T7AX-K9RH].

[253] Ferrill, *supra* note 113.

[254] *Cf.* Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364, 1368 (Fed. Cir. 1999) ("Other agencies [i.e., agencies other than the Patent Office], such as the Federal Trade Commission and the Food and Drug Administration, are assigned the task of protecting consumers from fraud and deception in the sale of food products."); *In re* Watson, 517 F.2d 465, 476 (C.C.P.A. 1975) ("Congress has given the responsibility to the FDA, not to the Patent Office, to determine in the first instance whether drugs are sufficiently safe for use that they can be introduced in the commercial market . . . ."); *cf. also* Webber v. Virginia, 103 U.S. 344, 344–48 (1880) ("Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace, and general welfare of the community are promoted." *Id.* at 347–48.).

[255] *See, e.g.*, Jake Linford, *Placebo Marks*, 47 PEPP. L. REV. 45, 52–53 (2019) ("Trademark law allows the mark owner to internalize consumer goodwill (i.e. repeat custom) as the reward for truthfully signaling consistent product quality.") (footnote omitted); Aaron Perzanowski, *Unbranding, Confusion, and Deception*, 24 HARV. J.L. & TECH. 1, 18 (2010) ("Trademarks also influence product quality. If consumers can easily and consistently identify products based on source indicators, producers have greater incentives to maintain product quality.") (citing William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269–70 (1987)).

[256] *See* Elizabeth Chuck, *Some Nervous Travelers Are Changing Their Flights to Avoid Boeing Airplanes*, NBC NEWS (Mar. 23, 2024, 10:00 AM), https://www.nbcnews.com/news/us-news/travelers-changing-flights-avoid-boeing-airplanes-rcna144158 [https://perma.cc/JP3D-JYXS] (reporting that, "after a series of quality control incidents, starting with the dramatic door panel blowout on a Boeing 737 Max midair during an Alaska Airlines flight in January" 2024, some airline customers have changed their travel plans to avoid flying on Boeing airplanes). Of course, in this scenario, the travelers are not purchasers of the airplanes. But their choices may impact future purchasing decisions by airlines.

design patent does not, in and of itself, convey any similar type of safety-related information.[257]

Design patent infringement is not a sign of a lack of quality. If the visual similarity test is met, the product infringes — safe or unsafe, high quality or low quality.[258] Even if someone knowingly copies another person's product, that does not suggest (let alone prove) that the copier is more likely than others to make or sell unsafe products. Therefore, when counterfeit rhetoric is used to invoke concerns about safety, it constitutes a fallacious appeal to fear.

Some design patent infringers may, in fact, sell unsafe or low-quality products. But that does not mean that all (or even most) design patent infringers sell unsafe products or that there is any necessary logical or legal connection between design patent enforcement and consumer safety.[259]

* * *

All of this is not to say that there are never any acts of design patent infringement that also constitute counterfeiting — or any design patent infringers who are also counterfeiters (in either sense of the word).[260] Instead, the point here is that the counterfeiting and design patent infringement are not inextricably linked. If the problem is counterfeiting, Congress (and the courts) should deal with it directly. Because there is no necessary logical or legal connection between these two types of infringement, there is no guarantee that legislative or judicial interventions aimed at the lesser offense (design patent infringement) will have any effect on the frequency or magnitude of the worse offense (counterfeiting). To make an analogy to criminal law: Some trespassers may also be murderers. That does not mean the law should treat all trespassers as murderers. And it certainly does not justify the use of taxpayer funds

---

[257] Some may argue that there is a link because a producer may wish to use a design patent to "bootstrap" trade dress protection — that is, they may wish to use a design patent to obtain an artificial monopoly on the design that may allow the producer to develop secondary meaning. But the fact that some producers may wish to use this strategy does not change the reality of the pre-secondary-meaning marketplace.

[258] *See supra* notes 57–87 and accompanying text.

[259] The larger empirical question of how often products that infringe design patents are, actually, unsafe is beyond the scope of this Article. But those who suggest that there is, in fact, a connection should bear the empirical burden of proof.

[260] There almost certainly are some. But we need more than attorney *ipse dixit* to establish the actual or likely amount of overlap.

to guard every piece of private property,[261] which is basically what design patent owners are asking for with respect to border enforcement.[262]

IV. THE LARGER COUNTERFEIT NARRATIVE

The use of moralizing rhetoric in discussions of intellectual law and policy is, of course, not new. There are strong parallels in the way the word "counterfeit" is being used in discussions of design patent law with the way words like "theft" and "piracy" have been used in discussions of copyright law and policy. This kind of "[l]inkage, where words are repeatedly placed together or near to each other, is recognised by scholars of rhetoric as an important device by which the meanings associated with one word can become incorporated into or transferred to another."[263] As Patricia Loughlan notes, in discussions of copyright, "[t]he language of theft . . . reduces a difficult policy debate, with significant economic and cultural consequences, to a crude and simplistic moral drama."[264] We see the same thing with the use of counterfeit rhetoric in connection with design patents. When people refer to design patent infringement as "counterfeiting," they may not be making an express statement of law. But, by using a word that is also a legal term of art, they are "draw[ing] upon and mobilis[ing] the ordinary, almost instinctive response [of] ordinary people to dislike, disdain and despise the unauthorised user of [a design patent] as they would dislike, disdain and despise" an actual counterfeiter.[265]

The words "counterfeit" and "counterfeiting" themselves have shown up before in debates about copyright and trademark law and policy (and to a lesser extent, in discussions of utility patent protection for pharmaceuticals). But those involved in design patent law and policy may not be aware of that history and literature. One goal of this Article is to bridge that gap and to bring lessons learned in debates about other areas of IP into debates about design patent law.

---

[261] To be clear, I'm just making an analogy, not taking a position in the "is IP 'property'?" debate. *Compare, e.g.*, Adam Mossoff, *Introduction* to *Intellectual Property and Property Rights*, *in* INTELLECTUAL PROPERTY & PROPERTY RIGHTS, ix, ix (Adam Mossoff ed., 2013), *with* Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1032 (2005).

[262] It is true that Customs already polices copyright and trademark infringement. *See supra* note 113 and accompanying text. But that doesn't mean design patent owners are being unfairly excluded; it may simply mean we have too much border enforcement already. And even if border enforcement of registered trademarks and copyrights is a good policy, that doesn't mean the same is true for design patents. Because of the way the *Goddess* test works, *ex parte* procedures, such as border enforcement, are especially ill-suited to the adjudication of design patent claims. *See supra* note 94 and accompanying text.

[263] Loughlan, *supra* note 240, at 401 (footnote omitted) (citing BARRY BRUMMETT, RHETORIC IN POPULAR CULTURE 120 (2d ed. 2006)).

[264] *Id.* at 405.

[265] *Id.* at 403 ("When the background authoritative voice in the MPAA film quoted above intones that 'downloading a pirated film is stealing,' no statement of law is being made.").

A. We've Seen This Before

As Janewa Osei-Tutu has observed, those who sought to expand copyright and trademark protections have used arguments about counterfeiting — and, in particular, arguments about counterfeit medicines — to try to expand copyright and non-counterfeiting trademark protections in draft treaties like the Anti-Counterfeiting Trade Agreement[266] (ACTA) and Trans-Pacific Partnership[267] (TPP).[268] Using this kind of rhetoric, "[w]ealthy corporations are successfully making the case for increased state enforcement of intellectual property rights by effectively framing the issue of intellectual property enforcement as a health and safety issue in order to advance their commercial interests."[269] And:

> [I]n line with industry, the government narrative is that intellectual property rights are not the problem but, rather, that intellectual property is critical to the development and marketing of new medicines. . . . This narrative, which suggests that intellectual property is beneficial to the public, serves the interest of all intellectual property industries broadly, not just the pharmaceutical industry. Once the case for increased intellectual property enforcement is successfully made based on the dangers posed by counterfeit medicines, the argument is extended — often without merit — to other consumer and industrial products.[270]

We've seen a similar dynamic at play with the rhetoric of "piracy" and copyright.[271] Additionally, "some commentators have connected counterfeit medicines not only to petty criminals, but also to terrorist

---

[266] Oct. 1, 2011, 50 I.L.M. 243 (not in force).

[267] Feb. 4, 2016, https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/tpp-full-text [https://perma.cc/8RQ3-P55V] (not yet in effect, and signed but not ratified by the United States).

[268] *See* Osei-Tutu, *supra* note 9, at 770 (observing that "international intellectual property agreements, like the recent Anti-Counterfeiting Trade Agreement (ACTA), increasingly contemplate government monitoring and enforcement of these rights, and industry associations requested similar measures in the highly secretive Trans-Pacific Partnership (TPP) negotiations" (footnotes omitted)); *id.* at 769 ("[P]otential health risks from counterfeit medicines provide a powerful counter-narrative to the 'access to medicines' critique of intellectual property. The dangers created by counterfeit medicines thereby artificially bolster the case for public enforcement of private intellectual property rights." (footnotes omitted)).

[269] *Id.* at 771. Of course, ACTA and the TPP did not get enacted. But that does not mean we will not see similar arguments being made in the future.

[270] *Id.* at 784 (footnotes omitted) (citing OFF. OF THE U.S. TRADE REPRESENTATIVE, TRANS-PACIFIC PARTNERSHIP TRADE GOALS TO ENHANCE ACCESS TO MEDICINES 1 (2011), https://ustr.gov/sites/default/files/uploads/TPP%20Trade%20Goals%20to%20Enhance%20Access%20to%20Medicines.pdf [https://perma.cc/W4QK-VEKU]; James M. Cooper, *Piracy 101*, 36 CAL. W. INT'L L.J. 89, 100 (2005)). Although ACTA and the TPP did not ultimately become treaties, that doesn't mean this rhetoric doesn't matter. And these failures may be due, at least in part, to the critics who pointed out problems with their supporters' counterfeiting arguments. In any case, it's still worth discussing how big, sophisticated companies use the rhetoric of counterfeiting to try to sell private harms as public ones.

[271] *Cf.* Debora Halbert, *Intellectual Property Piracy: The Narrative Construction of Deviance*, 10 INT. J. SEMIOTICS L. 55, 71 (1997) (noting that piracy rhetoric creates a narrative where "multimillion dollar industries become the victims").

organizations, thus portraying intellectual property enforcement as a national security issue."[272] According to Susan Sell, at least part of this has been a result of a concerted effort to conflate "tales of exploding cell phones and toxic counterfeit drugs" and "unsubstantiated allegations of organized crime and even terrorist involvement" with things like copycat handbags and unauthorized DVDs.[273]

Similarly, the rhetoric discussed in this Article deliberately conflates design patent infringement with actual counterfeiting, in order to justify increased design patent protections based on an appeal to fear. Because there is no necessary logical or legal connection between design patent infringement and counterfeiting, this appeal to fear is fallacious.

B. *What's Really Going On?*

So what's really going on here? This section discusses some motivations that seem to underlie the use of counterfeit rhetoric in the design space.

1. IP Owners Want to Foist Enforcement Costs onto Taxpayers. — Sometimes, counterfeit rhetoric is used to try to shift IP enforcement costs to the public.[274] In general, private parties must pay to enforce

---

[272] Osei-Tutu, *supra* note 9, at 784 (citing Cooper, *supra* note 270, at 97; Beverley Earle, Gerald A. Madek & Christina Madek, *Combating the New Drug Trade of Counterfeit Goods: A Proposal for New Legal Remedies*, 20 TRANSNAT'L L. & CONTEMP. PROBS. 677, 687 (2012)). Others have noted similar rhetorical moves in other IP contexts. *See, e.g.*, Glyn Moody, *EU's Gallo Report: Rubbish Recycled*, OPEN . . . (Jan. 29, 2010), https://opendotdotdot.blogspot.com/2010/01/eus-gallo-report-rubbish-recycled.html [https://perma.cc/9VVR-U932] ("I've noted several times an increasingly popular trope . . . : since counterfeiting is often linked with organised crime, and because counterfeiting and copyright infringement are vaguely similar, it follows as surely as night follows day that copyright infringement is linked with organised crime. Well, that apology of an argument is now being recycled in the draft of the Gallo Report . . . .") (discussing Eur. Parliament Comm. on Legal Affs., *Draft Report on Enhancing the Enforcement of Intellectual Property Rights in the Internal Market* (Jan. 13, 2010), http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONSGML+COMPARL+PE-438.164+01+DOC+PDF+V0//EN&language=EN [https://perma.cc/Y5RS-V788]).

[273] Susan K. Sell, *The Global IP Upward Ratchet, Anti-Counterfeiting and Piracy Enforcement Efforts: The State of Play* (Am. U. Wash. Coll. of L. Joint PIJIP/TLS Rsch. Paper Series No. 2010-15), https://digitalcommons.wcl.american.edu/research/15 [https://perma.cc/93LQ-8JJY] ("At a CropLife America meeting on December 1, 2007, Dan Glickman, head of the Motion Picture Association, recommended that advocates underscore the danger of counterfeited and pirated goods. Through fearmongering, IP enforcement agenda advocates are constructing a big tent that includes all types of intellectual property: trademarks, patents, copyrights. . . . This campaign is characterized by strategic obfuscation; its message is intentionally misleading. For example, it is difficult to imagine a 'dangerous' counterfeit handbag, or a 'dangerous' DVD. The fearmongering ranges from tales of exploding cell phones and toxic counterfeit drugs, to unsubstantiated allegations of organized crime and even terrorist involvement.").

[274] *See* Osei-Tutu, *supra* note 9, at 768–69; *see also* Port, *supra* note 123, at 1179–80, 1182 ("In the end, the real issue is whether we should make the international enforcement of intellectual property rights against producers of imitative commodities a public, rather than a private, matter. To date, this has largely been conceived of as a private cause of action, where intellectual property rights holders sue to prevent the importation or distribution of imitative commodities." *Id.* at 1182.).

their own private rights.[275] But that is expensive.[276] By invoking "[t]he dangers [of] counterfeit medicines" and framing IP enforcement as a public safety issue that merits public support, IP owners and their supporters seek to "artificially bolster the case for public enforcement of private intellectual property rights."[277]

This appears to be a big part of what is happening in the debates about design patents and border enforcement.[278] For example, some of the sponsors of the 2019 seizure bill invoked some unspecified "safety risks" to "the health and well-being of American consumers."[279] This is a straightforward appeal to fear. But as explained here, that appeal to fear is fallacious.[280] When the counterfeit rhetoric is stripped away, all that is left is a naked attempt to get the public to pay for the private enforcement efforts of IP owners.[281]

2. IP Owners Want to Circumvent Due Process Protections. — It also appears that, at least sometimes, people use counterfeit rhetoric to justify or argue for circumventing the normal requirements of due process in order to obtain *ex parte* adjudications. Design patent owners might want to circumvent the procedures that normally protect due process values in order to save themselves money, to put undue pressure on their competitors, or for other reasons. In many cases, the suggestion seems to be that counterfeiting is — and the people who do it are — so bad that it justifies abandoning normal procedural safeguards.[282]

---

[275] Osei-Tutu, *supra* note 9, at 770 ("Intellectual property rights are private rights that are normally enforced by the rights holders.").

[276] *Id.* ("[M]onitoring and enforcing intellectual property rights is expensive.").

[277] *Id.* at 769; *see also id.* at 785 (noting that "the definition of 'counterfeit' medicines is not uniform"); *id.* at 769 n.16 (defining "[a] counterfeit medicine . . . as a fake or illegitimate version of a patented drug or a fake or illegitimate version of a generic drug").

[278] *Cf.* Grinvald, *supra* note 107, at 1528 (noting that the border-enforcement measures proposed in ACTA "would shift the costs of enforcement from the budgets of the trademark bullies onto the CBP"); Burstein, *supra* note 94 (discussing a design patent bill that would allow private design patent holders to transfer their enforcement costs to the public).

[279] Seizure Press Release, *supra* note 107 (quoting Sens. Coons and Hirono).

[280] *See supra* section III.B, pp. 514–17.

[281] *See* Osei-Tutu, *supra* note 9, at 771–72. Tellingly, many attorneys who wrote in support of the 2019 bill emphasized the potential cost savings for design patent owners. *See, e.g.*, Ferrill, *supra* note 113 (noting that CBP enforcement would make enforcement "faster and less expensive for the design rights holders"); Daniel S. Block & Deirdre M. Wells, *Senators Propose Bill to Strengthen Anti-Counterfeiting Toolkit with Design Patents*, STERNE KESSLER (Dec. 6, 2019), https://www.sternekessler.com/news-insights/client-alerts/senators-propose-bill-strengthen-anti-counterfeiting-toolkit-design [https://perma.cc/6HC9-2LG2] (stating that the seizure bill would "mak[e] it easier and less expensive to enforce design patents at the U.S. border").

[282] Indeed, Congress may have made just such a determination with respect to actual counterfeiting, when it passed the Trademark Counterfeiting Act of 1984. *See* Steven N. Baker & Matthew Lee Fesak, *Who Cares About the Counterfeiters? How the Fight Against Counterfeiting Has Become an* In Rem *Process*, 83 ST. JOHN'S L. REV. 735, 760 (2009) ("[T]he Senate Judiciary Committee, upon listing the Trademark Counterfeiting Act's safeguards, stated its belief 'that these safeguards are fully adequate to satisfy the constitutional requirements of due process, in light of the

For example, at least some Schedule A plaintiffs seem to be using counterfeit rhetoric to convince courts to grant them types of relief that are supposed to be extraordinary, such as *ex parte* temporary restraining orders (TROs) that include seizures of the defendants' assets without prior notice.[283] Once those assets are seized, a plaintiff may demand a disproportionate amount of those assets to settle the case.[284] Accordingly, the Schedule A model allows a plaintiff to extract more money from defendants than they would be able to in a full and fair adjudication. And it allows them to do so at a much lower cost.[285]

We also see this in the border-enforcement context. Supporters of design patent Customs seizures argue that it's too time consuming and expensive to seek an exclusion order at the ITC.[286] But cheap enforcement brings its own costs. For example, it may erode the accused infringer's right to due process.[287] And it may encourage overzealous enforcement — especially if there are no significant downsides to bringing weak or even frivolous claims.[288] The normal cost of bringing an enforcement action may act as a costly screen, pushing design patent

---

extraordinary bad faith exhibited by many commercial counterfeiters, and the need for effective means of stemming the current epidemic of counterfeiting.' We learn two important things from this statement: First, Congress was aware of the constitutional implications of seizing property pursuant to an ex parte order. Second, and perhaps more importantly, we learn that *Congress, aware of the potential constitutional pitfalls, considered the interests of trademark owners and the evils of counterfeiting to be sufficient to override those pitfalls*." (emphasis added) (footnote omitted) (quoting S. REP. NO. 98-526, at 8 (1984))).

[283] *See supra* section II.B.2, pp. 493–500; *see also* Gorge Design Grp. LLC v. Syarme, No. 2:20-cv-1384, 2020 WL 8672008, at *3 (W.D. Pa. Dec. 4, 2020) ("The Court holds that there is nothing exceptional about this case. In fact, this case has followed the same trajectory of many other cases in this District and in districts throughout the country in instances where a plaintiff discovers that its intellectual property has likely been pirated and identical or substantially similar knock-off products are being offered for sale from on-line platforms. To hold that this case is exceptional would topsy-turvy that term — elevating what is ordinary to extraordinary."), *aff'd sub nom.* Gorge Design Grp. LLC v. Xuansheng, No. 2021-1695, 2023 WL 2808069 (Fed. Cir. Apr. 6, 2023).

[284] *See, e.g.*, Appellant NeoMagic Corporation's Opening Brief, Gorge Design Grp. LLC v. Xuansheng, No. 2021-1695 (Fed. Cir. Oct. 25, 2021), ECF 19 ("Gorge still demanded payment of $9,500 for Gorge to release the over $300,000 of NeoMagic money that remained frozen (crippling NeoMagic's ability to do business)" where the record showed that the NeoMagic had only sold "a single unit of a $4.99 product."); Appellees' Brief, Gorge Design Grp. LLC v. Xuansheng, No. 2021-1695 (Fed. Cir. July 20, 2022), ECF 35 (not disputing these factual assertions).

[285] For example, as Eric Goldman notes, if a Schedule A plaintiff joins 200 defendants in a single case, it only pays a single filing fee of $402, as opposed to the $80,000 it could cost to file cases against each defendant separately. *See* Goldman, *supra* note 19, at 199. Additionally, because these cases appear to rarely — if ever — get to the discovery stage, the plaintiffs also avoid many of the costs incurred in a normal IP case.

[286] *See, e.g.*, Joint Letter from Henry Hadad, *supra* note 251 ("For design patents, CBP's authority is currently limited to enforcing exclusion orders issued by the U.S. International Trade Commission (ITC), which are rare and expensive to obtain.").

[287] *See, e.g.*, Grinvald, *supra* note 107, at 1534–36 (discussing some due process costs to border enforcement of trademarks).

[288] *See id.* at 1546 ("Without costs to enforcement, there would be no disincentive for abuse.").

owners to pursue only their strongest and most important claims.[289] Without that screen, and if judges remain unwilling to sanction parties who assert nonmeritorious claims,[290] the incentive to bring only strong claims is weakened — if not destroyed altogether.[291]

Quicker and cheaper enforcement can also raise error costs.[292] Design patent infringement is particularly ill-suited to *ex parte* adjudication because of the way the *Goddess* test works.[293] Even if an accused design is not "plainly dissimilar" to the claimed design when considered in the abstract, differences may appear when the designs are considered in the light of the prior art.[294] If there is no defendant present to direct the court (or the CBP) to the closest prior art, the likelihood of false positives — that is, incorrect findings of infringement — increases.[295] If judges are not already familiar with the standard of design patent infringement and there is no defendant to direct them to the relevant cases, judges may misapply the test in other ways.[296] Or the plaintiff may

---

289 *See generally* Jonathan S. Masur, *Costly Screens and Patent Examination*, 2 J. LEGAL ANALYSIS 687 (2010) (discussing the role of costly screens with respect to patent law).

290 *See, e.g.*, Jiangsu Huari Webbing Leather Co. v. Joes Identified in Schedule A, No. 1:23-cv-02605, 2024 WL 20931, at *6–7 (S.D.N.Y. Jan. 2, 2024) (refusing to sanction a plaintiff who, among other acts of "possible misconduct," *id.* at *6, brought numerous nonmeritorious claims of utility patent infringement against Schedule A defendants).

291 *See* Burstein, *supra* note 150. Yes, attorneys are still bound by Rule 11. But there is a difference between a claim that is weak and one that is frivolous. Even if Rule 11 serves as an effective deterrent to the filing of frivolous claims, the costly screen goes beyond that to also deter the assertion of weak claims. And that is a good thing. *See generally* Burstein, *supra* note 53.

292 *See* Mark P. McKenna, *Criminal Trademark Enforcement and the Problem of Inevitable Creep*, 51 AKRON L. REV. 989, 1021 (2017) (discussing situations in which the government has made mistakes, "many of which could have been avoided with a little due process").

293 *See supra* note 92.

294 Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) ("[W]hen the claimed and accused designs are not plainly dissimilar, resolution of the question whether the ordinary observer would consider the two designs to be substantially the same will benefit from a comparison of the claimed and accused designs with the prior art, as in many of the cases discussed above and in the case at bar. Where there are many examples of similar prior art designs, as in a case such as *Whitman Saddle*, differences between the claimed and accused designs that might not be noticeable in the abstract can become significant to the hypothetical ordinary observer who is conversant with the prior art.").

295 It is no answer to say "that customs will be able to make use of prior art cited on the face of the patent and could require a design patent owner to provide copies of the prior art as part of the regulations that it develops." Mehta, *supra* note 109 (reporting on comments made by Elizabeth Ferrill). While design patent examiners are experienced searchers, they have limited time to consider each design patent case. So there may be prior art that they miss. Accordingly, one cannot assume the prior art listed on the patent itself is the closest prior art. *See* Burstein, *supra* note 94.

296 *See, e.g.*, Memorandum Opinion and Order, Zhaoshi v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-04587 (N.D. Ill. Jan. 4, 2024), ECF 88. In this case, the court determined that some of the accused products were not plainly dissimilar. *See id.* at 1–2. The court was wrong. *See* Defendants' Motion to Dismiss the Complaint and Incorporated Memorandum of L. at 5, Zhaoshi v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:23-cv-04587 (N.D. Ill. Oct. 9, 2023), ECF 50 (showing that this accused product was, in fact, plainly dissimilar); Burstein, *supra* note 89, at 98 (citing *Egyptian Goddess*, 543 F.3d at 678; Ethicon Endo-Surgery,

submit an expert report that uses the wrong infringement standard.[297] Normally, we rely on the adversarial system to alert the courts to these kinds of mistakes. But in an *ex parte* proceeding, there is no defendant to point out these kinds of errors.

For example, in the first Schedule A case to reach the Federal Circuit, the court reversed the grant of the preliminary injunction because, among other reasons, "[e]ven a cursory review of the four accused products shows that they are different from each other, display features not found in the asserted patents, and lack features shown in the asserted patents."[298] In an appendix, the Federal Circuit included pictures of one of the accused products to show how different it was from the claimed designs.[299] Here is one view[300]:

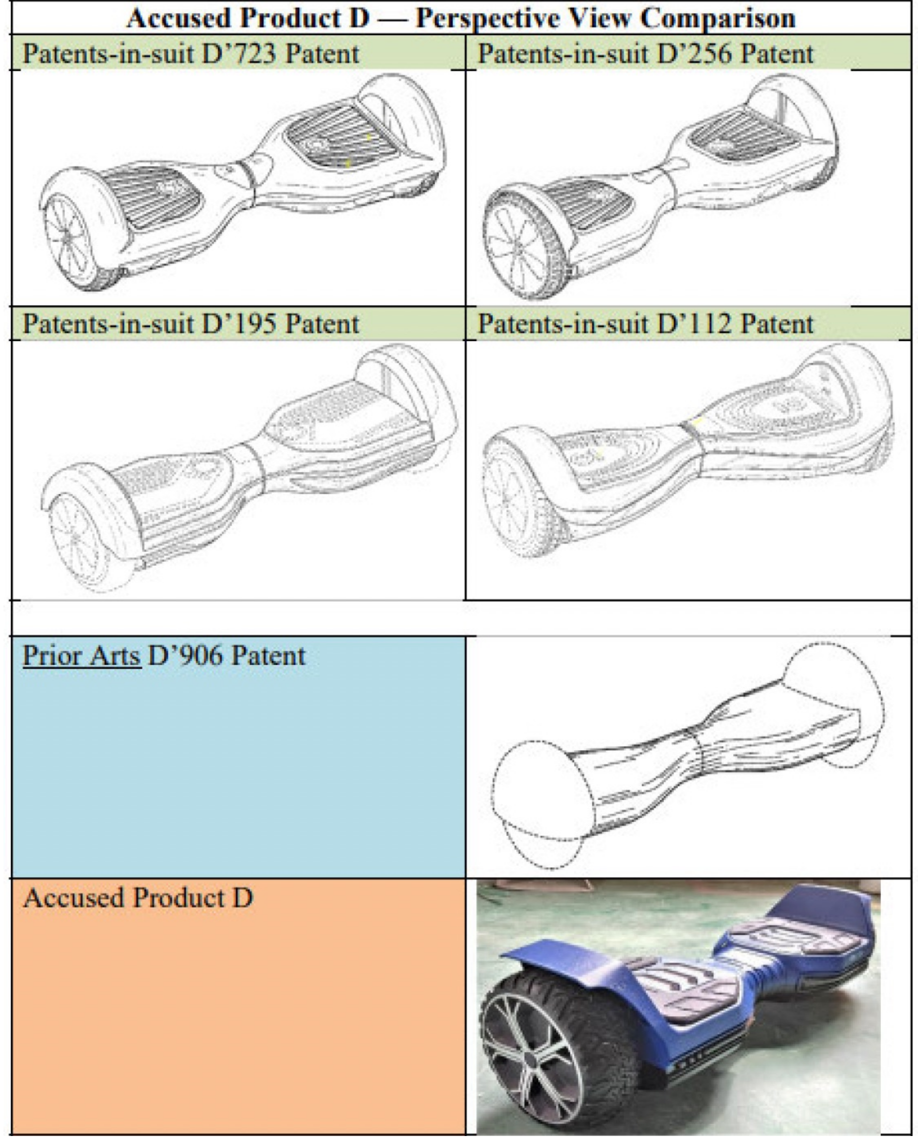
Inc. v. Covidien, Inc., 796 F.3d 1312, 1337 (Fed. Cir. 2015)) (explaining that, under the two-step test set forth in *Egyptian Goddess*, a design cannot infringe if it is plainly dissimilar to the patented design).

297 *See infra* note 302.

298 *See* ABC Corp. I v. P'ship & Unincorporated Ass'ns Identified on Schedule "A," 52 F.4th 934, 944 (Fed. Cir. 2022); *see also* Burstein, *supra* note 92 (noting that "the panel was correct that, overall, the plaintiffs failed to prove they were likely to succeed on the merits").

299 *ABC Corp. I*, 52 F.4th at 947–52.

300 *See id.* at 949. The infringement claim did not fare any better in the other views. *See, e.g.*, *id.* at 947–52.



As can be seen in this image, the specific, overall shape of this accused product is plainly dissimilar from the shapes claimed in the asserted design patents. There is no infringement as a matter of law.[301]

[301] *Cf. Egyptian Goddess*, 543 F.3d at 678 (stating that if designs are "sufficiently distinct," there is clearly no design infringement).

But the district court granted the preliminary injunction anyway.[302] This kind of false positive is a significant problem.[303] It's true that judges get design patent infringement wrong in regular design patent infringement cases. But they're not doing it in secret. Or in bulk.[304]

3. IP Owners Want Other Forms of Extraordinary Relief. — In *Samsung v. Apple*, we saw counterfeit rhetoric being used to support arguments in support of an incredibly broad reading of 35 U.S.C. § 289 — that is, that a design patent owner should always get the "total

---

[302] Preliminary Injunction Order, ABC Corp. I v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:20-cv-04806 (N.D. Ill. Apr. 6, 2022), ECF 456. The court appears to have been led astray, at least in part, by an expert report submitted by the plaintiff. *See* Burstein, *supra* note 92. In that report, a "recently retired CEO of . . . a global product design consultancy" opined that "an ordinary observer would find the Accused Products to be substantially similar to the Claimed Designs." *See* Expert Declaration of Paul Hatch at 3, 26, Hangzhou Chic Intelligent Tech. Co. v. P'ships & Unincorporated Ass'ns Identified on Schedule A, No. 1:20-cv-04806 (N.D. Ill. Aug. 24, 2021), ECF 388 [hereinafter Hatch Report]; *see also ABC Corp. I*, 52 F.4th at 943 ("The district court appeared to rely on the infringement discussion in the Hatch reports . . . ."). Setting aside for a moment the question of whether expert reports are appropriate on the issue of infringement — which is supposed to be analyzed from the perspective of an ordinary observer, *Egyptian Goddess*, 543 F.3d at 678 — this expert used the wrong test for infringement, *see* Hatch Report at 16. Although he recited the correct one, *id.* at 5, he appeared to actually use an incorrect one, *see id.* at 16 (stating, without any citations or support, that: "The prior art is used to compare to the claimed design of the patent to find the scope of the design in the ordinary observer test. It is also used to compare the accused product to the claimed designs to evaluate if the accused product is closer to the claimed design than the prior art."). Hatch seemed to be under the mistaken impression that a design patent's scope is broadened where the claimed design is very different from the prior art. *See id.* ("The Cited Prior Art Show The Patents-In-Suit Have A Broad Scope."); *id.* at 17 ("The prior art is vastly different in many ways and therefore the '723 and '256 Patents enjoy a very broad scope."). That is not correct. *See* Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312, 1337 (Fed. Cir. 2015) (rejecting the patent owner's argument that the prior art can be used to broaden the scope of the claim).

[303] In *ABC Corp. I (Hangzhou Chic Intelligent Technology Co.) v. Partnership & Unincorporated Ass'ns Identified on Schedule "A,"* Judge Durkin did eventually reach the right result on infringement. *See* Hangzhou Chic Intelligent Tech. Co. v. Gyroor, No. 1:20-cv-04806, 2024 WL 148966, at *6, *8 (N.D. Ill. Jan. 12, 2024) (granting summary judgment of noninfringement). But that was after three and a half years of litigation, 686 docket entries, and the aforementioned Federal Circuit appeal. *See id.* And how much damage did the wrongful injunctions cause? How much time and money did the defendants who challenged the injunction have to spend litigating design patent infringement claims that were facially nonmeritorious? How many settlements was the plaintiff able to extract while the injunction was pending? Wrongful injunctions always cause damage, but when there are many defendants *and* their assets are frozen, the error costs are that much higher. Burstein, *supra* note 150 ("[A]s the defendants' submissions show, significant damage can be done in these cases, even in a short period of time."); *see, e.g.*, Hyponix Brands, Ltd.'s Memorandum in Support of Motion for Bond Damages, Sanctions, & Attorney Fees at 1, Jiangsu Huari Webbing Leather Co. v. Joes Identified in Schedule A, No. 1:23-cv-02605 (S.D.N.Y. May 1, 2023), ECF 50 (arguing plaintiff brought spurious infringement claims and "committed numerous acts of litigation misconduct"); Ninjasafe LLC's Memorandum in Support of Motion for Bond Damages, Sanctions, & Attorney Fees at 1, Jiangsu Huari Webbing Leather Co. v. Joes Identified in Schedule A, No. 1:23-cv-02605 (S.D.N.Y. May 2, 2023), ECF 55 (same).

[304] The lack of adversarial process in these cases leads to other serious errors, such as granting a TRO (with an asset freeze) against infringement of an expired design patent. *See* Temporary Restraining Order, Casio Comput. Co. v. Individuals, Corps., LLCs, P'ships & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-00895 (N.D. Ill. Feb. 15, 2023), ECF 23 (enjoining defendants from using a design claimed in an expired patent).

profits" from any infringing product a defendant sells, even if the patent is directed to only a small or insignificant part of the overall visual design.[305] The Supreme Court ultimately rejected that reading.[306] But throughout the case, counterfeit rhetoric helped provide a fig leaf of purported public interest to those who actually sought to protect private interests.

In a way, these arguments were also about making design patent enforcement cheaper. If a design patent owner could definitely recover a huge award at the end of a case, that would offset the litigation costs they would have to expend to get there. But perhaps more importantly, if a design patent owner could credibly threaten competitors with the certainty of a huge award at trial, the owner could likely get competitors to stop (or pay) without having to expend any litigation costs at all.[307] Even if the asserted design patent infringement claims were weak or frivolous, a targeted competitor would have to think twice about what an erroneous verdict would cost them. This is true even post-*Samsung*. Total-product rewards are not required but they are still possible. Therefore, design patent owners can still credibly threaten them.[308]

V. WHY COUNTERFEIT RHETORIC MATTERS

We've seen that counterfeit rhetoric doesn't always carry the day — for example, the 2019 seizure bill didn't become a law.[309] But that doesn't mean that it doesn't matter. It just means that counterfeit rhetoric isn't some kind of magic bullet. No legal argument always carries the day. Bills fail for all kinds of reasons. And a bill that fails at one point may be reintroduced successfully later.[310] Consider the 2019 seizure bill.[311] This wasn't the first time counterfeit rhetoric was used in support of design patent border control measures[312] and it seems unlikely to be the last — especially considering how many powerful

---

[305] *See supra* notes 127–45 and accompanying text.

[306] Samsung Elecs. Co. v. Apple Inc., 580 U.S. 53, 58–59 (2016) (declining to state "total profits" always means all profits from any infringing product).

[307] *See* Burstein, *supra* note 127, at 800 (discussing the *in terrorem* value of huge § 289 claims).

[308] *See id.* (noting that, "[i]n terms of empowering *in terrorem* threats," an open-ended approach that just throws the § 289 issue to the jury is "almost as bad as the *Apple/Nordock* rule").

[309] *See* S. 2987, 116th Cong. (2019) at § 1.

[310] *Frequently Asked Questions: Law Library of Congress*, LIBR. OF CONG. (July 11, 2024), https://ask.loc.gov/law/faq/334496?loclr=bloglaw [https://perma.cc/U8G5-3GR2].

[311] *See supra* section II.A, pp. 487–90.

[312] In 2008, Greg P. Brown, Counsel, Ford Global Technologies, invoked the specter of "counterfeiting" in arguing for a design registration system with rights that would be enforceable by Customs. *Customs Reauthorization: Strengthening U.S. Economic Interests and Security: Hearing Before the S. Comm. on Fin.*, 110th Cong. 34–38 (2008) (written testimony of Greg P. Brown, Counsel, Ford Global Technologies); *see also id.* at 9 (statement of the same).

supporters the bill had.[313] But even if this debate was over forever, it would still be worth analyzing how counterfeit rhetoric has been used in attempts to support bills in Congress.

And even though counterfeit rhetoric might not have carried the day with the 2019 bill, we have seen some evidence that it may be playing a role in convincing judges to allow the Schedule A litigation model.[314] The Schedule A model only works if judges choose to exercise their discretion in several key areas, perhaps most notably in granting *ex parte* asset-freezing injunctions. The judges are not required to issue these orders. They must be persuaded to do so. And counterfeit rhetoric seems to be one reason they keep doing so.[315] Even if counterfeit rhetoric is not used in a particular case, it is used often enough that it seems to be creating a halo of suspicion around all Schedule A cases.

Stepping back, it is important to see the role counterfeit rhetoric is playing in the various situations analyzed here. Design patent owners need a public harm story to attempt to justify certain self-serving legal or policy interventions, especially where there are important interests weighing against such interventions. Design patent owners who want to get the public to pay their enforcement costs need a reason to diverge from the general rule that IP owners must pay to enforce their own private rights and justify imposing those costs onto taxpayers.[316] Design patent owners who want to bring Schedule A cases have to convince judges that there is a good reason to bypass the defendants' constitutional due process rights.[317] Design patent owners who wanted courts to adopt a maximal view of § 289 have to convince them to abandon basic principles of proportionality.[318] In all of these cases, counterfeiting is offered as that critical (or at least one critical) counterweight to the competing interests. But design patent infringement isn't counterfeiting. So the story doesn't fit.

Because design patent law is one of the less widely understood areas of IP law, judges, policymakers, and others might not understand the differences between design patent infringement and

---

[313] *See* Elizabeth D. Ferrill & Eric A. Liu, *New Legislation Would Empower U.S. Customs to Seize Products Infringing Design Patents at the U.S. Border*, IPOWNERS Q. (Mar. 31, 2020), https://www.finnegan.com/en/insights/articles/new-legislation-would-empower-us-customs-to-seize-products-infringing-design-patents-at-the-us-border.html [https://perma.cc/L9GT-NVR5] (noting that "[c]ompanies such as Nike Inc., 3M Company, Wolverine Worldwide, Columbia Sportswear, Decker Brands, and professional associations, including the Footwear Distributors & Retailers of America, the Intellectual Property Owners Association, the International Trademark Association, and the American Intellectual Property Law Association" supported the bill, *id.* n.16).

[314] *See supra* notes 166–77 and accompanying text.

[315] As noted before, there may be other factors, including xenophobia, at play here. *See supra* note 156.

[316] *See* Osei-Tutu, *supra* note 9, at 770–71.

[317] *See* Grinvald, *supra* note 107, at 1534.

[318] *See* Burstein, *Lost Its Shape*, *supra* note 64, at 612–13 (discussing how the contemporary fragment claiming regime can lead to disproportionate damage awards under § 289).

counterfeiting — actual or colloquial. This may be different than what we've seen with allegations of theft and piracy in other IP contexts. When a copyright owner calls an accused infringer a "pirate," no one is likely to think that the defendant has literally committed an act of hostility on the high seas.[319] The audience would likely understand it is a rhetorical flourish, even if they are persuaded by it. Is the same true for design patents and counterfeiting? It seems less likely. For this reason, the use of counterfeit rhetoric seems meaningfully different than mere zealous advocacy. This is especially true where advocates use the terms "counterfeit" or "counterfeiting" without defining them.

And in some situations, design patent owners might be using counterfeit rhetoric to try to get a type of backdoor trade dress. In the past, concerns have been raised about people using trademark law protection to obtain a kind of "backdoor patent."[320] But perhaps we should be concerned about the opposite problem — are people using design patent law to get backdoor trademarks?

Consider again the 2019 seizure bill. As noted above, CBP can already seize products that infringe a registered trade dress.[321] So the bill, if enacted, would only be needed in cases where there is no registered trade dress. If a company owns a product design that is distinctive and nonfunctional, they could simply register the trade dress and take advantage of the existing enforcement mechanism. They wouldn't need any statutory amendment. That suggests that the 2019 bill was mainly aimed at designs that have not yet acquired distinctiveness (in which case they wouldn't have confused consumers) or that are functional (and were thus excluded from trade dress protection for policy reasons). In either case, it would seem like the bill was aimed — at least in part — at granting the benefits of trademark law to designs that didn't or couldn't qualify for trademark protection.[322] This is especially true with regard

---

[319] *Cf.* 18 U.S.C. § 1652 ("Whoever, being a citizen of the United States, commits any murder or robbery, or any act of hostility against the United States, or against any citizen thereof, on the high seas, under color of any commission from any foreign prince, or state, or on pretense of authority from any person, is a pirate, and shall be imprisoned for life.").

[320] *E.g.*, Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476 (2004) ("[I]n *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, the Court rejected a request to use trademark law to [effectively] extend a patent past its expiration. . . . An attempt to gain additional protections for an item that falls within the subject matter of patent law may be termed a 'backdoor patent.'" (footnotes omitted)).

[321] *See supra* note 112 and accompanying text.

[322] Some may argue that this is appropriate because it promotes doctrinal bootstrapping. *See generally* Dennis D. Crouch, *A Trademark Justification for Design Patent Rights* 8 n.31 (U. of Mo. Sch. of L. Legal Stud. Rsch. Paper Series, Research Paper No. 2010-17), http://ssrn.com/abstract=1656590 [https://perma.cc/96UJ-82NN] ("Doctrinal bootstrapping is the process of using rights granted under a first doctrine to aid in procuring rights under a second doctrine. . . . [D]esign patents are being used to help obtain trade dress protection over the same industrial design."). A full discussion of the concept of doctrinal bootstrapping is beyond the scope of this Article. But it's

to the latter category. If a design is functional in the way that excludes it from trade dress protection, we shouldn't grant it trademark-like rights without some compelling justification. Granting those rights merely because someone called the design a "counterfeit" would be insufficient — and circular.

VI. LESSONS & IMPLICATIONS

A. Be Careful with the Word "Counterfeit" When Discussing Design Patents

As this analysis shows, counterfeiting and design patent infringement are legally and logically separate topics. Judges, policymakers, defense counsel, and others should recognize the use of the word "counterfeit" in the design patent context might be a result of cross-jurisdictional definitional differences or deliberate rhetorical tactics.[323] Those who use the word "counterfeit" in good faith should define it, clearly and explicitly, to communicate their intended meaning.[324] And those who seek to use studies about "counterfeiting" should clarify how those studies define that term and clearly explain how, if at all, those statistics are relevant to design patent infringement.[325] Judges and others presented with such studies should view them with skepticism and push advocates to actually establish the relevance, if any, of such studies to design patents.

B. We Should Not Import the Term "Counterfeiting" into Design Patent Law

Some commentators have used or suggested using the term "counterfeiting" in connection with design patent law. In a 2013 article, Mark

---

worth noting here that granting trademark-like rights to design patent owners is different from allowing those owners to use their design patents to establish actual trademark rights.

[323] *See supra* notes 24–26 and accompanying text.

[324] Sell, *supra* note 273, at 20 ("First, one should insist that IP enforcement proponents define terms such as trademark counterfeiting and copyright piracy quite explicitly."); *see also* Charles R. McManis, *The Proposed Anti-Counterfeiting Trade Agreement (ACTA): Two Tales of a Treaty*, 46 HOUS. L. REV. 1235, 1247–48 (2009) ("Attacking the problem of counterfeiting and piracy without first defining the parameters of the problem to be addressed, however, creates a risk that some of the negotiating parties, or the private stakeholders for whom they speak, under the guise of combating one problem, such as trade in counterfeit or pirated goods, will attempt to combat another, more controversial problem, such as generic medicines or digital file-sharing — a phenomenon not entirely unknown to international intellectual property negotiations." (footnotes omitted)).

[325] *See* Port, *supra* note 123, at 1140 ("Before we shift the burden of enforcement of private intellectual property rights from private parties to public entities, we ought to gather and rely on better data. We ought not to simply vilify all imitative commodities. If the various federal governments are to be asked to come to the aid of some manufacturers who claim they are being imitated (as if that is a new and shocking occurrence) in the form of the ACTA, we need to have better, verifiable data that imitative commodities are doing the harm claimed."); *see also id.* at 1133–34 (stating that the author is "adopting the neutral term imitative commodities to describe what the literature and the press refer to as counterfeit goods or knockoffs, among other pejorative terms" (emphases omitted) (footnotes omitted) (citing CONSUMERS AND LUXURY: CONSUMER CULTURE IN EUROPE 1650–1850, at 164 (Maxine Berg & Helen Clifford eds., 1999))).

Janis and Jason Du Mont used the term to "refer[] to cases in which the accused design is identical to the patented design, and where the accused design is used in connection with" the same article of manufacture.[326] In a 2018 article, Janis suggested the creation of "a new concept" of "design patent counterfeiting."[327] Specifically, he suggested that this new concept would include using "a standard of comparison that is more exacting than the conventional infringement standard" and could require "that the article of manufacture associated with the patented and accused designs must be identical."[328]

But the standard for design patent infringement already requires a high degree of visual similarity,[329] though the accused design need not look like it was "struck from the same die."[330] And after Du Mont's and Janis's articles were published, the Federal Circuit ruled that design patent infringement always requires that the design be used in connection with the same article of manufacture.[331] So it is not clear what this conception of "counterfeiting" would really add to design patent law, especially in light of the larger counterfeit narrative discussed here.[332] We don't need another *faux ami* in design law.[333]

CONCLUSION

Actual counterfeiting is a real problem. But not all infringement is counterfeiting. Describing it as such is a real problem. It is particularly problematic in discussions of design patent law and policy. As this Article has explained, there is no necessary logical or legal connection

---

[326] Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107, 171 (2013).

[327] Mark D. Janis, *How Should Damages Be Calculated for Design Patent Infringement?*, 37 REV. LITIG. 241, 277–79 (2018).

[328] *Id.* at 278.

[329] *See supra* note 95 and accompanying text.

[330] Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 531 (1872); *see also* Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1243 (Fed. Cir. 2009) ("Just as 'minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement,' so too minor differences cannot prevent a finding of anticipation." (citation omitted) (quoting Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984))).

[331] *See In re* SurgiSil, LLP, 14 F.4th 1380, 1382 (Fed. Cir. 2021) ("A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract."); Curver Luxembourg, SARL v. Home Expressions Inc., 938 F.3d 1334, 1339 (Fed. Cir. 2019) ("Curver's argument effectively collapses to a request for a patent on a surface ornamentation design *per se*. . . . We decline to construe the scope of a design patent so broadly here merely because the referenced article of manufacture appears in the claim language, rather than the figures."). Prior to *Curver* and *SurgiSil*, Janis and Du Mont had suggested that design patents did protect designs *per se*, arguing that a "hypothetical patented daisy [screen] icon design" would be infringed if "replicated on a t-shirt without the design patent owner's authorization." Du Mont & Janis, *supra* note 326, at 171–72. But the Federal Circuit did not adopt that view.

[332] At worst, this kind of definition might not just be confusing — it might be used as a wedge to expand the scope of a design patent by requiring less visual similarity for "normal" infringement.

[333] *See* Burstein, *supra* note 36, at 1455 (discussing "words that appear the same in the key legal regimes (design patent, trademark, and copyright) but which can have problematically different meanings," such as "functional" and "ornamental").

between design patent infringement and actual counterfeiting.[334] Even when the word "counterfeit" is used in its colloquial sense, there is still a mismatch because design patent infringement does not always require product replication and never requires any intent to deceive.[335] Using the word "counterfeiting" in the context of design patents is, at best, confusing. At worst, it's a deliberate attempt to mislead that may be coloring how judges (and others) think about design patent issues and cases.

To be clear, the problem isn't merely that those who use counterfeit rhetoric are using the word "counterfeit" incorrectly. The problem is that they seem to be misusing the word "counterfeit" deliberately, to evoke the specter of dangerous and intentional malfeasance. Used in this way, counterfeit rhetoric is "an inaccurate and manipulative distortion of legal and moral reality."[336]

Judges, policymakers, and others should be skeptical when the words "counterfeit" or "counterfeiting" are used in connection with design patents. They should actively question how and why those terms are being used and realize that these terms may be being used as a rhetorical tactic, not as a factual description.[337] While these audiences may be likely to understand that talk of "piracy" is a rhetorical flourish in cases involving copyright, they might not necessarily understand that the same thing is happening when plaintiffs talk about "counterfeiting" in design patent cases.

Judges in Schedule A cases should be particularly careful. If they keep letting plaintiffs use the Schedule A model for design patent claims, they should consider hiring special masters to help them evaluate the merits of the infringement claims, especially at the TRO stage.[338] They should not let the aura of counterfeiting blind them to potential problems with the extraordinary forms of relief, such as *ex parte* asset freezes, that are regularly granted in these cases.[339] And, to counter the imbalances inherent in the Schedule A model and to encourage the filing of only meritorious claims, they should not hesitate to impose sanctions where defendants are wrongfully restrained.[340] If judges believe that

---

[334] *See supra* section III.A, pp. 503–13.

[335] *See supra* section III.A.2.b, pp. 511–13.

[336] *Cf.* Loughlan, *supra* note 240, at 402 (using the same phrase to describe rhetoric involving use of words like "theft" in the context of intellectual property).

[337] *See supra* note 7 and accompanying text.

[338] Burstein, *supra* note 150.

[339] *Id.* ("[A]s Judge Seeger has noted, 'Schedule A plaintiffs typically don't request and receive equitable monetary relief' at the end of their cases, even when equitable relief is available." (quoting Zorro Prods., Inc. v. Individuals, Corps., Ltd. Liab. Cos., P'ships, & Unincorporated Ass'ns Identified on Schedule A Hereto, No. 1:23-cv-05761, 2023 WL 8807254, at *4 (N.D. Ill. Dec. 20, 2023))).

[340] *Id.* ("If judges were willing to sanction plaintiffs — or at least shift fees — when Schedule A defendants were wrongfully restrained, that would do a lot to help level the playing field and incentivize the plaintiffs to bring better claims.").

the Schedule A model is necessary to combat counterfeiting, they should limit its use to cases that actually involve counterfeiting.

More broadly, those who use the words "counterfeit" or "counterfeiting" in good faith should always define it. Those who use it in connection with design patents should explain why they think it is a relevant concept, instead of pretending or suggesting the connection is obvious. Those who cite studies about counterfeits or counterfeiting in connection with design patents should disclose how those studies define those words. They should also clearly explain how they think that any such studies are relevant to design patents. Finally, in light of all of the rhetorical and historical baggage the word "counterfeiting" carries, we should not intentionally import that term into design patent law to create a doctrine or concept of "design patent counterfeiting."