

# DESIGN PATENTS

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## **ABOUT THIS TEXT**

This text is intended to be a relatively complete introduction to the law of design patents for those already familiar with utility patent law. It is also intended to provide a current summary of the principles of design patent law.

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## What Are Design Patents?

Design patents are a form of intellectual property for ornamental product designs (*i.e.*, designs not dictated by function). Design patents have increased in popularity in recent years, spurred by decisions of the Court of Appeals for the Federal Circuit that increased the value of design patents, as well decisions of the U.S. Supreme Court that diminished the value of utility patents.

The main characteristics of U.S. design patents are that:

- design patents can only be issued for the designs for “articles of manufacture” (or portions thereof);
- protected designs are required to be ornamental (*i.e.* not dictated by function);<sup>1</sup>
- design patents are issued by the United States Patent & Trademark Office (“USPTO”) through an examination process;
- design patents are enforceable for a limited term (currently 14 years after issuance, likely to be extended to 15 years);<sup>2</sup>
- protected designs must be novel and non-obvious;<sup>3</sup>
- the scope of rights is defined by a single claim, which is usually expressed by a short written phrase and one or more drawings;<sup>4</sup>
- infringement of a design patent is judged by assessing the confusion of an ordinary observer between an accused design and the claimed design;<sup>5</sup>
- damages for infringement of a design patent can be much more extensive than for infringement of a utility patent.<sup>6</sup>

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<sup>1</sup> See § III.B, *infra*.

<sup>2</sup> The term is currently 14 years, but will likely be extended to 15 years by pending legislation. See S. 3486 - Patent Law Treaties Implementation Act of 2012, § 102. The bill passed the Senate on Sept. 22, 2012 and the House on Dec. 5, 2012.

<sup>3</sup> See § III, *infra*.

<sup>4</sup> See § I.C.4, *infra*.

<sup>5</sup> See § II, *infra*.

<sup>6</sup> See § IV, *infra*.

## A. Governing Law

Design patents are governed by sections 171, 172, 173 and 289 of Title 35. Section 171 forms the basis for design patent protection, and states in its entirety that:

“Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”<sup>7</sup>

Of note here is that a design must be “new”,<sup>8</sup> “original”<sup>9</sup> and “ornamental”<sup>10</sup>. A design must also be “for an article of manufacture”.<sup>11</sup> The patenting of a design is “subject to the conditions and requirements” of Title 35.<sup>12</sup> Moreover, the provisions of Title 35 relating to “patents for inventions” apply, “except as otherwise provided”.

Section 172 provides that Paris convention (section 119) priority is limited to 6 months for design patents, and that the benefit of a provisional application filing date cannot be claimed.<sup>13</sup>

Section 173 provides that “[p]atents for designs shall be granted for the term of fourteen years from the date of grant”, although legislation pending at the date of this writing would extend this to fifteen years from the date of issuance.<sup>14</sup> Having the issue date as the trigger necessarily excludes all consideration of patent term adjustment.

Section 289 defines acts of infringement for a design patent. These are

“(1) appl[ying] the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2)

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<sup>7</sup> 35 U.S.C. § 171.

<sup>8</sup> *See* § III.C, *infra*.

<sup>9</sup> *See* § III.A, *infra*.

<sup>10</sup> *See* § III.B, *infra*; *c.f.* footnote 249, *infra*.

<sup>11</sup> *See* § I.C.4(b), *infra*.

<sup>12</sup> *See* 35 U.S.C. § 171.

<sup>13</sup> *See* 35 U.S.C. § 172.

<sup>14</sup> 35 U.S.C. § 173.

sell[ing] or expos[ing] for sale any article of manufacture to which such design or colorable imitation has been applied....”<sup>15</sup>

Section 289 also provides that the infringer “shall be liable to the owner to the extent of his total profit, but not less than \$250”.<sup>16</sup> However, the owner can also be granted “any other remedy which an owner of an infringed patent has under the provisions of [Title 35]”, as long as the design patent owner does not “twice recover the profit made from the infringement.”<sup>17</sup>

Prosecution of design patent application is governed by 37 C.F.R. §§ 1.151 – 1.155. These sections govern the form of applications and their prosecution, but make other portions of 37 C.F.R. applicable.<sup>18</sup> The rules are accompanied by Chapter 15 of the Manual of Patent Examination and Procedure (“MPEP”).

## **B. Design Patents Compared With Other Forms Of Intellectual Property.**

Design patents offer protection that is distinct from, but may overlap with, the protection of other common forms of intellectual property. This section provides a brief comparison of the main similarities and differences with utility patents, copyrights, trademarks / trade dress rights, and industrial designs.

### **1. Comparison Of Design Patents With Utility Patents.**

Design patents bear numerous similarities with utility patents. Both kinds of patents are issued through an examination process at the USPTO. Indeed, design patent law incorporates much of utility patent law through the action of 35 U.S.C. § 171.<sup>19</sup> For example, design patents must meet the requirements of 35 U.S.C. §§ 102, 103 and 112, although the nature of a design patent requires a relatively unique application of these sections.<sup>20</sup>

There are a number of important differences, however, which are listed here:

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<sup>15</sup> 35 U.S.C. § 289.

<sup>16</sup> 35 U.S.C. § 289.

<sup>17</sup> 35 U.S.C. § 289.

<sup>18</sup> See 37 C.F.R. § 1.151 (“The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.”).

<sup>19</sup> See 35 U.S.C. § 171 (“Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”) (emphasis added).

<sup>20</sup> See § III, *infra*.

- Subject Matter Eligibility. Utility patents are directed to useful inventions, whereas design patents are directed to “ornamental” (non-functional) designs.<sup>21</sup> This might appear to make design and utility patents mutually exclusive. However, the tests for “utility” and “ornamentality” are not complementary, hypothetically allowing valid utility patent claims that exactly describe a valid ornamental design patent claim.<sup>22</sup>
- Term. Utility patents have a term that is 20 years from the U.S. filing date, with a complex set of rules for term extension and adjustment.<sup>23</sup> Design patents expire 14 years from the date of issuance,<sup>24</sup> with no adjustment or extension.
- Claims And Infringement / Novelty. Utility patent claims are expressed in writing. Design patents are limited to a single claim, which states the article of manufacture and, while it can make reference to a description, always makes reference to drawings.<sup>25</sup> The drawings limit the scope of the claims.<sup>26</sup> Accordingly, design patent infringement and novelty are not (usually) decided by an element-by-element comparison with a written claim as with a utility patent, but rather by a visual evaluation of the overall design with the accused product or prior art, thereby assessing the deception of an ordinary observer.<sup>27</sup> This visual evaluation has a certain level of equivalence analysis built-in.<sup>28</sup>

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<sup>21</sup> See *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009).

<sup>22</sup> See § III.B *infra*.

<sup>23</sup> See generally 35 U.S.C. § 154.

<sup>24</sup> See 35 U.S.C. § 173. Legislation pending as of the date of this writing will likely extend the term to 15 years. See S. 3486 - Patent Law Treaties Implementation Act of 2012, § 102.

<sup>25</sup> See MPEP § 1502.01(C). (Ed. 8, Rev. 5, Aug. 2006).

<sup>26</sup> See *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1302-03 (Fed. Cir. 2010).

<sup>27</sup> See § II *infra*.

<sup>28</sup> See § II.B.2(a) *infra*.



- Claim Construction. Courts often construe utility patent claims, but are discouraged from construing design patent claims verbally except in limited cases.<sup>29</sup>
- Obviousness. The framework for analyzing the obviousness of a design patent claim is stricter than for utility patent claims. A case for obviousness of a design patent claim must begin with a primary reference that is “basically the same as” the claimed design.<sup>30</sup> Secondary references are combined if obvious to a designer of ordinary skill.<sup>31</sup> The combination that results is tested against the claims from the perspective of the ordinary observer, who is usually different than the ordinary designer.<sup>32</sup>
- Damages. The damages available for infringement are significantly different. Owners of design patents claim all damages available to owners of utility patents,<sup>33</sup> but can also make use of the special provisions of 35 U.S.C. § 289. This section entitles the owner to “the extent of [the infringer’s] total profit”.<sup>34</sup> This profit is not subject to apportionment (a reduction based on the fact that the design may be only partly responsible for the profit).<sup>35</sup> This feature of design patents can make them a useful complement to utility patents for profitable products.
- Priority. Design patent applications can not be filed as PCT applications,<sup>36</sup> cannot claim the benefit of the filing date of a provisional application,<sup>37</sup> and can only claim the Paris convention benefit of a foreign filing if the U.S. application is filed within 6 months of the foreign filing.<sup>38</sup>

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<sup>29</sup> See *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1302 (Fed. Cir. 2010).

<sup>30</sup> See § III.D.1(b), *infra*.

<sup>31</sup> See § III.D.1(c), *infra*.

<sup>32</sup> See § III.D.1(d), *infra*.

<sup>33</sup> See 35 U.S.C. § 289.

<sup>34</sup> 35 U.S.C. § 289.

<sup>35</sup> See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1443 (Fed. Cir. 1998).

<sup>36</sup> See MPEP § 1502.01(E). (Ed. 8, Rev. 5, Aug. 2006).

<sup>37</sup> See MPEP § 1502.01(G). (Ed. 8, Rev. 5, Aug. 2006).

<sup>38</sup> See MPEP § 1502.01(F). (Ed. 8, Rev. 5, Aug. 2006).

- Maintenance fees. Maintenance fees are not required for design patents.<sup>39</sup>
- RCEs. Requests for Continued Examination (RCEs) are not available for design patent applications. Continuing Prosecution Applications, however, are only permitted for design patent applications.<sup>40</sup>
- Publication. Design patent applications are not published.<sup>41</sup> Therefore, design patent applications are effectively not subject to third-party submissions under 35 U.S.C. § 122, and cannot claim damages under 35 U.S.C. § 154(d).<sup>42</sup>
- Application Form. Compared to a utility application, a design patent application contains very little written description.<sup>43</sup>

There is no mutual exclusivity between design and utility patents for the same product—both forms of protection may be obtained if the requirements are met.<sup>44</sup>

## 2. Comparison Of Design Patents With Copyrights.

The Court of Customs and Patent Appeals called design patents “a hybrid which combines in itself features of both a patent and a copyright”.<sup>45</sup> This description was, however, more aspirational than real. In fact, design patents have relatively few features in common with copyrights.<sup>46</sup>

The similarities can be summed up by saying that design patents and copyrights are both term-limited and are both for nominally non-functional subject matter. Further similarities are difficult to find, however, and even these similarities are deceptive. For example, while the term

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<sup>39</sup> See MPEP § 1502.01(B). (Ed. 8, Rev. 5, Aug. 2006).

<sup>40</sup> See MPEP § 1502.01(H) and (I). (Ed. 8, Rev. 5, Aug. 2006).

<sup>41</sup> See 35 U.S.C. § 122(b)(2)(a)(iv); MPEP § 1502.01(J). (Ed. 8, Rev. 5, Aug. 2006).

<sup>42</sup> Pending legislation (S. 3486) likely to pass will allow for international design applications that will be published, “creat[ing] the prospect of provisional rights under 35 U.S.C. 154(d)(1). . . .” D. Crouch, *A Mark-Up and Commentary on the Patent Law Treaties Implementation Act of 2012* (Draft), p. 5, <http://www.patentlyo.com/plt.pdf>.

<sup>43</sup> See 37 C.F.R. § 1.154(b). (Ed. 8, Rev. 5, Aug. 2006).

<sup>44</sup> MPEP § 1502.01. (Ed. 8, Rev. 5, Aug. 2006).

<sup>45</sup> *In re Mogen David Wine Corp.*, 328 F.2d 925, 928-29 (CCPA 1964).

<sup>46</sup> See generally Brown, R. S. Jr., “*Copyright-Like Protection for Designs*” (1989), Faculty Scholarship Series. Paper 2693, [http://digitalcommons.law.yale.edu/fss\\_papers/2693](http://digitalcommons.law.yale.edu/fss_papers/2693).

of a copyright is often life-of-the author plus a number of years that itself verges on a healthy human lifespan,<sup>47</sup> the term of a design patent is only 14 years from issuance.<sup>48</sup> And while the test for non-functionality (*i.e.* “ornamentality”) in design patents has become quite permissive in recent years,<sup>49</sup> the test for non-functionality in copyrights is quite strict. A design patent is non-functional if its design is not “dictated by function”.<sup>50</sup> A copyright for a designed article is non-functional if the design is “separable” from the functional aspects<sup>51</sup>—a test that has been difficult to meet for designs in articles of manufacture.<sup>52</sup>

Design patents differ in numerous other ways from copyrights. Design patents protect against the application of a design to an article for sale, or the sale of such an article.<sup>53</sup> Copyrights protect (simplistically speaking) against reproduction of the copyrighted work.<sup>54</sup> Copyrights enjoy a quick registration system with minimal examination.<sup>55</sup> Design patents must undergo an examination process that can take more than a year before the rights are enforceable.<sup>56</sup> Copyrights must be for original works,<sup>57</sup> whereas designs must be not only original, but also novel and non-obvious.<sup>58</sup> The monetary remedy provisions are also

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<sup>47</sup> See generally United States Copyright Office, “Duration of Copyright”, Circular 15a.

<sup>48</sup> See 35 U.S.C. § 173. This term is likely to be extended to 15 years, see footnote 24, *supra*.

<sup>49</sup> See § III.B, *infra*.

<sup>50</sup> See § III.B, *infra*.

<sup>51</sup> See 17 U.S.C. § 101 (1988).

<sup>52</sup> See Brown, R. S. Jr., “Copyright-Like Protection for Designs”, pp. 310-11 (1989), Faculty Scholarship Series. Paper 2693, [http://digitalcommons.law.yale.edu/fss\\_papers/2693](http://digitalcommons.law.yale.edu/fss_papers/2693).

<sup>53</sup> See 35 U.S.C. § 289.

<sup>54</sup> See 17 U.S.C. §§ 106 through 122.

<sup>55</sup> See 17 U.S.C. § 410.

<sup>56</sup> See § I.D, *infra*.

<sup>57</sup> See 17 U.S.C. § 102.

<sup>58</sup> See § III, *infra*.

substantially different.<sup>59</sup> These differences have led to calls for the legislative creation of copyright-like design protection.<sup>60</sup>

There is no mutual exclusivity between design patents and copyrights—if a designer can obtain both forms of protection, there is no requirement to elect one or the other.<sup>61</sup>

### 3. Comparison Of Design Patents With Trade Dress And Trademark Rights

Design patents mimic (and modify) certain concepts from trademark / trade dress law, making the two forms of protection at least abstractly related. Between the two, trade dress rights are the most apt point of comparison for design patents and indeed, are often asserted together with a design patent.<sup>62</sup>

The abstract relation between design patents and trade dress rights can be seen in the respective tests for infringement. A design patent is infringed if “an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.”<sup>63</sup> An infringement claim for trade dress (in the Ninth Circuit, *e.g.*), requires the plaintiff to show that “the asserted trade dress (1) is not functional, (2) is inherently distinctive or has acquired distinctiveness through a secondary meaning, and (3) is likely to cause confusion with the defendant’s products.”<sup>64</sup>

These tests have similarly worded elements that express themselves in different ways. For example, the trade dress requirement of *non-functionality* is also a nominal requirement of design patent validity. In fact, some litigants have attempted, with marginal success, to use the existence of a design patent as evidence of non-functionality of trade dress rights in a related design.<sup>65</sup> However, trade dress is functional if the trade dress is “primarily functional”,<sup>66</sup> and

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<sup>59</sup> Compare 35 U.S.C. § 289 with 17 U.S.C. §§ 504-505.

<sup>60</sup> See, *e.g.*, Brown, R. S. Jr., “*Copyright-Like Protection for Designs*” (1989), Faculty Scholarship Series. Paper 2693, [http://digitalcommons.law.yale.edu/fss\\_papers/2693](http://digitalcommons.law.yale.edu/fss_papers/2693); See, *e.g.*, D. Goldenberg, “*The Long and Winding Road: A History of the Fight Over Industrial Design Protection in the United States*”, 45 J. COPYRIGHT SOC’Y U.S.A. 21 (1997-1998).

<sup>61</sup> See *In Re Yardley*, 493 F.2d 1389, 1394 (CCPA 1974) (“Congress has not provided that an author-inventor must elect between securing a copyright or securing a design patent.”).

<sup>62</sup> See, *e.g.*, *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1467 (Fed. Cir. 1997); *Shop\*TV, Inc., v. Bed Bath & Beyond, Inc.*, Case No. 09-cv-00057-REB-CBS, Slip Op. at 30 (D.Co. Jan. 19, 2010).

<sup>63</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010).

<sup>64</sup> *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407-08 (Fed. Cir. 1997).

<sup>65</sup> See *In the matter of the application of World’s Finest Chocolate, Inc.*, 474 F.2d 1012, 1014-15 (CCPA 1973) (“The board’s reference to appellant’s now-expired design patent fails to

non-functionality must be proven by the plaintiff in the first instance.<sup>67</sup> For a design patent, in contrast, functionality is present only if the design is “dictated by function”—a much more difficult standard if one is interested in invalidating the patent.<sup>68</sup> Functionality of a design patent must be also proven by a defendant, who must meet the clear-and-convincing evidence standard.<sup>69</sup> These strictness of the non-functionality requirement in trademark and trade dress law, as compared with the looseness of that standard with design patents, may be rationalized based on the potentially perpetual protection of trademark rights as versus the limited term of a design patent.<sup>70</sup>

Further, the owner of a design patent is under no obligation to prove the second prong of trade dress infringement: distinctiveness / secondary meaning.<sup>71</sup> Indeed, the design patent owner need not even compete in the relevant market.<sup>72</sup> Because of this, the evaluation of the final prong (“confusion”, or “*deception*” in design patent parlance) is quite different between trade dress and design patent infringement. Trade dress infringement focuses on a likelihood of actual consumer confusion,<sup>73</sup> whereas design patent infringement is premised on a hypothetical,

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lend support to a finding of either no distinctiveness in fact or nonregistrability even if de facto distinctiveness is present. The mere existence of design patent rights is independent of, and immaterial to, the ownership of trademark rights.”); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485 (Fed. Cir. 1984) (“Smith argues that the existence of a design patent, now expired, for part of the configuration now in issue is sufficient proof of distinctiveness to rebut the prima facie case of functionality. The existence of a design patent may be some evidence of non-functionality [citations omitted] However, as the TTAB said in *Honeywell* after the CCPA remanded the case to it, ‘the fact that a device is or was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark’”); *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240 (Fed. Cir. 1986).

<sup>66</sup> See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

<sup>67</sup> See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407-08 (Fed. Cir. 1997).

<sup>68</sup> See § III.B, *infra*.

<sup>69</sup> See § III, *infra*.

<sup>70</sup> See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1580 (Fed. Cir. 1995) (“Moreover, patent law, not trade dress law, is the principal means for providing exclusive rights in useful product features. As the Court recognized in *Qualitex*, extending trademark/trade dress law to protect functional features might create perpetual, patent-like rights in unpatented or unpatentable items.”).

<sup>71</sup> See § II.B.2(b)(iii), *infra*.

<sup>72</sup> See § II.B.2(b)(ii), *infra*.

<sup>73</sup> See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407-08 (Fed. Cir. 1997).

objective deception, indicated by similarities between the claimed design and the relevant features of the accused product.<sup>74</sup> Design patent deception, because it is hypothetical and focuses on the claimed design, cannot be foreclosed by other features that would distinguish competitive products. For example, it is not relevant to design patent infringement whether a product that copies a patented design is elsewhere conspicuously marked with the manufacturer's trademark, unless the trademark visually interferes with the patented design to such an extent that the test for infringement is not met.<sup>75</sup> While such marking could eliminate the potential for confusion in a trade dress setting, it would not for a design patent.<sup>76</sup> Actual confusion in the market can still, however, be evidence of design patent infringement.<sup>77</sup>

As with copyrights, there is no mutual exclusivity between trademark and trade dress rights and design patents. If a designer can get both forms of rights, no law will require an election between the two.<sup>78</sup> State law unfair competition / misappropriation claims may, however, be precluded, if the actions complained of invade the province of federal design patent law.<sup>79</sup>

#### 4. Comparison Of Design Patents With Industrial Designs

Before one can compare anything with “industrial designs”, it is necessary to understand what “industrial designs” are. Industrial design protection is a form of intellectual property that is found in various countries (although not in the U.S.), and in various forms. The traits most commonly associated with industrial design protection are (1) protection for the designs used for articles of manufacture for a limited term; (2) the protection being obtainable via a copyright-like registration system, not a patent-like examination system; (3) the rights being governed by a

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<sup>74</sup> See § II.B, *infra*.

<sup>75</sup> See § II.B.2(b)(iii), *infra*.

<sup>76</sup> See § II.B.2(b)(iii), *infra*.

<sup>77</sup> See § II.B.2(b)(i), *infra*.

<sup>78</sup> See *In re Mogen David Wine Corp.*, 328 F.2d 925, 929 (CCPA 1964) (“In my opinion registration as a design and registration as a trademark are not mutually exclusive, and it is not a fatal objection to an application to register something that is claimed as a trademark that the subject matter of the application is capable of being registered as a design.”); *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (CCPA 1974).

<sup>79</sup> See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1979) (“By offering patent-like protection for ideas deemed unprotected under the present federal scheme, the Florida statute conflicts with the ‘strong federal policy favoring free competition in ideas which do not merit patent protection.’”; *Grand General Accessories Manufacturing v. United Pacific Industries Inc.*, Case No. CV 08-07078 DDP (VBKx), Slip Op. at 15, *et seq.* (C.D. Cal. June 11, 2009).

workable non-functionality standard; and usually (4) the rights having no requirement (or at most a relatively limited requirement) of non-obviousness.

(a) European “Community Designs”

As one example, the European Community has industrial design protection (embodied in “Community Designs”), created by a Council regulation.<sup>80</sup> The Regulation protects “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”.<sup>81</sup> Community Designs must be novel (their features must not differ only in immaterial details from the prior art)<sup>82</sup> and must have “individual character”, meaning that “the overall impression [a design] produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public”.<sup>83</sup> There is, however, no requirement for non-obviousness as such. There is a loose non-functionality requirement, expressed (in part) as “not solely dictated by [the product’s] technical function”.<sup>84</sup> Exceptions from protection are made to deal with relatively tricky replacement part market issues.<sup>85</sup>

Community Designs can be unregistered or registered. Unregistered designs, as the name implies, have a limited form of protection as soon as they are “made available to the public”.<sup>86</sup> This protection lasts for three years,<sup>87</sup> and can only be enforced in cases of actual copying.<sup>88</sup> Registering a design allows it to be enforced in the absence of evidence of actual copying, and increases the term. A registered design is protected for twenty-five years from the date of the filing of the application, but with a requirement for renewal every five years.<sup>89</sup> Registration is

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<sup>80</sup> See Council Regulation (EC) No 6/2002 (Dec. 12, 2001), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:32002R0006:EN:NOT>. See also the implementing Commission Regulation (EC) No 2245/2002.

<sup>81</sup> Art. 3(a) of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>82</sup> Art. 5 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>83</sup> Art. 6 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>84</sup> Art. 8 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>85</sup> See e.g., Arts. 4(2) and 110 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>86</sup> See Art. 11 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>87</sup> See Art. 11 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>88</sup> See Art. 19(2) of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

<sup>89</sup> See Art. 12 of Council Regulation (EC) No 6/2002 (Dec. 12, 2001).

done with the Office for Harmonisation in the Internal Market (“OHIM”), located in Alicante, Spain.<sup>90</sup>

(b) Efforts For Industrial Design Protection In the U.S.

The U.S. does not have industrial design protection similar to the European Community Design.<sup>91</sup> This is not due to lack of effort or motivation. Judge Giles Rich, one of the most active proponents of industrial design legislation, described the motivation for such legislation in a (now somewhat outdated) 1976 letter as follows:

“Those who were faced with the task of revising and codifying the patent statutes in 1950 were well aware that design patents were a big problem for various reasons: the kind of protection given by the statute to inventions of the ‘utility’ type (processes, machines, manufactures, compositions of matter --- see 35 USC 100-101) were not appropriate to ornamental designs; design patents were mostly not upheld by the courts and hence were not respected by competitors; good lawyers advised their clients against bothering with them and other lawyers misled clients into thinking they were obtaining real protection by design patents. Efforts had been made for generations prior to 1950 to devise more suitable protection – usually as some form of ‘design copyright’.<sup>92</sup>

Numerous bills have been introduced since 1898 to implement some form of copyright-like industrial design protection.<sup>93</sup> Current legislation entitled “Patent Law Treaties Implementation Act of 2012”<sup>94</sup> implements the Hague Agreement Concerning the International Registration of Industrial Designs, but does not address the majority of criticisms leveled against current U.S. design protection. Rather, the bill principally allows an International Design

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<sup>90</sup> See <http://oami.europa.eu/ows/rw/pages/index.en.do>.

<sup>91</sup> See *Lee v. Dayton-Hudson Corporation*, 838 F.2d 1186, 1188 n.3 (Fed. Cir. 1988).

<sup>92</sup> Statement of Hon. Giles S. Rich, U.S. Court of Appeals, Federal Circuit, Washington, DC, Attachment B, Letter to Hon. Robert W. Kastenmeier of April 20, 1976, p. 23 during the hearings on *The Industrial Innovation and Technology Act: Hearings on S. 791 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*. 100th Cong., 1st Sess. 22 (1987) (emphasis in original).

<sup>93</sup> See, e.g., D. Goldenberg, “*The Long and Winding Road: A History of the Fight Over Industrial Design Protection in the United States*”, 45 J. COPYRIGHT SOC'Y U.S.A. 21, pp. 25, *et seq.* (1997-1998).

<sup>94</sup> Currently S. 3486, which passed the Senate on Sept. 22, 2012 and the House on Dec. 5, 2012.



Application to serve as a design patent application in the United States.<sup>95</sup> It has previously been possible, however, to claim § 119 priority to non-U.S. applications and registrations filed under various treaty systems to which the U.S. was not a party.<sup>96</sup>

### C. The Design Patent And Design Patent Application

A typical design patent contains a title, bibliographic information similar to a utility patent, a claim, a description, and drawings. The issued patent results from an application that typically has 1-2 pages of written text, together with the drawing sheets. The portions of the application are described in the following sections.

#### 1. Title

A design patent has a title, which is subject to stricter requirements than a utility patent title. A design patent title must state the article of manufacture to which the design applies.<sup>97</sup> The purpose is to focus the Examiner's search. The title does not limit the scope of the claims, however,<sup>98</sup> which must themselves recite the article of manufacture.<sup>99</sup> Nevertheless, the title and claim must correspond.<sup>100</sup> The title might, however, have a practical influence in determining the scope of prior art for obviousness purposes or in assessing infringement. If the title is not sufficiently specific (e.g. "Covering"), the USPTO should require correction.<sup>101</sup> It is not unusual for the title of a design patent to begin and end with the article of manufacture (e.g. "Shoe").

Titles can also state the environment in which the article is used, with the MPEP example being "doors for cabinets, houses or the like", where "doors" constitute the article, and "cabinets, houses or the like" are the environment in which the article is used.<sup>102</sup> The phrase "and the like" is not objectionable if applied to the environment, but is objectionable if applied to the article.<sup>103</sup>

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<sup>95</sup> See S. 3486, §§381-390.

<sup>96</sup> See MPEP § 1504.10. (Ed. 8, Rev. 5, Aug. 2006).

<sup>97</sup> See 37 C.F.R. § 1.153 ("The title of the design must designate the particular article.").

<sup>98</sup> See MPEP § 1503.01.I. (Ed. 8, Rev. 5, Aug. 2006).

<sup>99</sup> See § I.C.4(b), *infra*.

<sup>100</sup> See MPEP § 1503.01.I. (Ed. 8, Rev. 5, Aug. 2006).

<sup>101</sup> See MPEP § 1503.01.I. (Ed. 8, Rev. 5, Aug. 2006).

<sup>102</sup> See MPEP § 1503.01.I. (Ed. 8, Rev. 5, Aug. 2006).

<sup>103</sup> See MPEP § 1503.01.I. (Ed. 8, Rev. 5, Aug. 2006).

## 2. Preamble

A design patent application typically contains a preamble,<sup>104</sup> which names the inventor, the title of the invention, and provides a brief description of the nature and intended use of the article, usually by making reference to the later disclosure. A typical preamble might read “BE IT KNOWN THAT I, [inventor], a citizen of [country], have invented a new, original and ornamental design for a [article of manufacture] of which the following is a specification, reference being had to the accompanying drawings forming a part hereof.” The preamble is not repeated verbatim in the issued patent, but rather used to populate the bibliographic information.

## 3. Design Patent Description

A design patent is not required to have any written description.<sup>105</sup> When a description is present, it can modify the scope of the claim in ways somewhat more direct than is possible in a utility patent (short of providing definitions for utility patent claim terms). In fact, it is not unusual for a design patent claim to recite “[t]he ornamental design for [article of manufacture], as shown and described.”

There are several reasons why a written description can be advantageous. First, a written description can make clear that certain sets of drawings relate to separate embodiments, effectively allowing for different scopes of the lone claim.<sup>106</sup> Second, within these embodiments, the specification can make clear that certain embodiments are dependent on the disclosure of other embodiments.<sup>107</sup> Third, a written description can describe the views taken on by the drawings, to avoid confusion as to the relationship between drawings.<sup>108</sup> Examiners may, in fact, require such descriptions, including specification of the angle of a particular view (*e.g.* “left side elevation view”). A written description in a design patent application can also provide material that claims or disclaims portions of the design not shown in the figures, to provide antecedent basis for later amendments during prosecution. The USPTO may require removal of these statements before issuance.<sup>109</sup>

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<sup>104</sup> See 37 C.F.R. § 1.154(b)(1).

<sup>105</sup> See 37 C.F.R. § 1.153(a) (“No description, other than a reference to the drawing, is ordinarily required.”); *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1464 (Fed. Cir. 1997) (“A design patent contains no written description; the drawings are the claims to the patented subject matter.”); MPEP § 1503.01.II. (Ed. 8, Rev. 5, Aug. 2006).

<sup>106</sup> See MPEP § 1504.05 (“The specification should make clear that multiple embodiments are disclosed and should particularize the differences between the embodiments.”). (Ed. 8, Rev. 5, Aug. 2006).

<sup>107</sup> See MPEP § 1504.05 (Ed. 8, Rev. 5, Aug. 2006).

<sup>108</sup> See MPEP § 1503.01.II. (Ed. 8, Rev. 5, Aug. 2006).

<sup>109</sup> See MPEP § 1503.01. (Ed. 8, Rev. 5, Aug. 2006).

It is also permissible to include statements about the nature of the article of manufacturing, the non-limiting nature of broken lines or portions of the article not shown in the drawings.<sup>110</sup> Examiners may, in fact, object if such statements are not present.

#### 4. Design Patent Claims

A design patent has a single claim, which should not be numbered.<sup>111</sup> The claim must be directed to a single design concept, which can, however, have multiple embodiments. The claim will usually state “[t]he ornamental design for”, followed by the article of manufacture, followed by the phrase “as shown” or the phrase “as shown and described”, possibly with terms such as “substantially” before “as shown”.<sup>112</sup>

##### (a) Limitation To A Single Inventive Concept

A design patent must be directed to a single inventive concept. If a design patent is not so limited, the USPTO is required to issue a restriction requirement.<sup>113</sup> A design patent can, however, claim multiple *embodiments* of the same design concept.<sup>114</sup> If this is done, the applicant should use the description to state which of the drawings represent which embodiments.<sup>115</sup> Separate embodiments are not separately claimed (there is only one claim), but rather provide different scopes of coverage within the same claim.

In order to be allowable in the same design patent, separate embodiments would have to fail an obviousness-type double patenting challenge if claimed in separate patents.<sup>116</sup> That is, the embodiments must be patentably indistinct from one another.<sup>117</sup> An admission of such

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<sup>110</sup> See MPEP § 1503.01. (Ed. 8, Rev. 5, Aug. 2006).

<sup>111</sup> See 37 C.F.R. § 1.153(a) (“More than one claim is neither required nor permitted.”).

<sup>112</sup> See 37 C.F.R. § 1.153(a).

<sup>113</sup> See MPEP § 1502.01(D).

<sup>114</sup> See *In re Rubinfeld*, 270 F.2d 391, 395 (CCPA 1959) (“For the reasons given, we are of the opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved, and a blanket rejection on the ground of ‘multiplicity,’ without considering such circumstances, is not proper.”).

<sup>115</sup> See MPEP § 1504.05 (Ed. 8, Rev. 5, Aug. 2006).

<sup>116</sup> See MPEP § 1504.05. (Ed. 8, Rev. 5, Aug. 2006).

<sup>117</sup> See MPEP § 1504.05.II.(A). (Ed. 8, Rev. 5, Aug. 2006).

patentable indistinctness is not sufficient to retain embodiments in the same patent<sup>118</sup>—rather, the applicant must *demonstrate* indistinctness.

Design patents that manage to issue with a single embodiment having inconsistent views (and hence multiple designs) are subject to attack on definiteness grounds.<sup>119</sup>

(b) Claimed Article Of Manufacture

A design patent claim must begin with a text phrase that designates an article of manufacture to which the claimed design is applied.<sup>120</sup> This designation limits the scope of protection.<sup>121</sup> The article recited in the claim should be consistent with the article recited in the title.<sup>122</sup>

The article of manufacture needs to be singular.<sup>123</sup> However, it can expressly recite similar articles with a phrase such as “or the like”,<sup>124</sup> and it can be made up of component parts. So, for example, it would be possible to recite a “cutlery set” as the article of manufacture, even though the set is composed of multiple parts. It would not, however, be possible to recite “knives, forks or spoons”, without specifying a single entity (such as a “set”) in the claim.<sup>125</sup>

The article of manufacture must be readily recognizable—invented names are likely to be rejected as indefinite.<sup>126</sup> The claim need not be directed to a design for the entirety of a recognizable article as sold, however. Designs applied to portions of articles are protectable.<sup>127</sup>

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<sup>118</sup> See MPEP § 1504.05.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>119</sup> See § III.E, *infra*.

<sup>120</sup> See 37 C.F.R. § 1.153(a).

<sup>121</sup> See *In re Schnell*, 1931 CCPA LEXIS 42, 32 (CCPA 1931).

<sup>122</sup> See MPEP § 1503.02.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>123</sup> See MPEP § 1504.01.(b). (Ed. 8, Rev. 5, Aug. 2006).

<sup>124</sup> See *In re Schnell*, 1931 CCPA LEXIS 42, 32 (CCPA 1931).

<sup>125</sup> See MPEP § 1504.01.(b). (Ed. 8, Rev. 5, Aug. 2006).

<sup>126</sup> See MPEP § 1504.04.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>127</sup> See *Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 16 (N.D. Cal. Dec. 2, 2011) (“Additionally, in design patents, the patentee need not claim an entire article of manufacture.”); *In re Zahn*, 617 F.2d 261, 267 (CCPA 1980),

(c) Drawings

The design patent drawings are of “decisive importance” in assessing the scope of the claims.<sup>128</sup> A design patent will often have more than one drawing for a particular embodiment. It is the collection of limiting elements from all drawings of an embodiment that forms the drawing portion of the design claim for that embodiment.<sup>129</sup> In other words, where multiple drawings are present for an embodiment, one cannot prove infringement by simply matching individual figures with corresponding portions of an accused article.<sup>130</sup>

The determination of the limiting elements of a drawing is relatively straightforward. Limiting elements are shown in solid lines.<sup>131</sup> Non-limiting elements (used to provide context for the design) are shown in broken lines.<sup>132</sup> The non-limiting nature of broken lines can be modified to some extent by description in the design patent.<sup>133</sup> For example, broken lines can be limiting where they represent stitching, other naturally broken linear elements, or fold lines.<sup>134</sup> It is best to specify the effect of broken lines in the written description, although this is not strictly necessary where broken lines are non-limiting.<sup>135</sup> To the extent other markings are used to show limiting or non-limiting features, this needs to be made clear in the written description.

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<sup>128</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010).

<sup>129</sup> *See Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1326 (Fed. Cir. 2012).

<sup>130</sup> *See Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1326 (Fed. Cir. 2012).

<sup>131</sup> *See* MPEP § 1503.02.II (Ed. 8, Rev. 5, Aug. 2006).

<sup>132</sup> *See* MPEP § 1503.02.II (Ed. 8, Rev. 5, Aug. 2006); *Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1317 (Fed. Cir. 2012).

<sup>133</sup> *See* MPEP § 1503.02.II (Ed. 8, Rev. 5, Aug. 2006).

<sup>134</sup> *See* MPEP § 1503.02.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>135</sup> *See Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 17 (N.D. Cal. Dec. 2, 2011) (“The D’677 patent is different from the D’087 in one key respect - the D’677, unlike the D’087, does not contain a statement explaining the use of broken lines in the design patent. Thus, unlike the D’087 patent, the broken lines in the D’677 patent may not, at least theoretically, indicate unclaimed aspects of the article of manufacture. *See Unique Indus., Inc. v. 965207 Alberta Ltd.*, 722 F. Supp. 2d 1, 10 n.2 (O.O.C. 2009) (noting that broken lines may be considered part of the claimed design, ‘if it is not clear that the inventor intended to exclude those portions from the claim’). In this case, however, the broken lines used in the D’677 patent likely indicate unclaimed aspects of the design. Unlike other cases in which a court has found that broken lines indicate something other than an unclaimed aspect of the design, there is no reasonable alternative interpretation of the broken lines in this patent.”)

Unlike utility patent drawings, broken lines should not be used to show hidden features.<sup>136</sup> Non-limiting broken lines should also generally not cross over solid lines or other portions of the claimed design. When such a crossover happens it can lead to confusing inferences about what is claimed.<sup>137</sup> It is therefore important to explain the significance of such broken lines in a description, or to separate drawings such that the cross-over does not occur.<sup>138</sup>

The surface contour of a design, where relevant, should be indicated. It is very typical in design drawings to indicate 3-D contour through shading. It is also possible to limit the design claim by indicating the use of color or material on a surface.<sup>139</sup> Such limiting surface treatments can be shown in full lines (such as with hatching), and should be explained in the description as representing a particular surface treatment. Colors can follow recognized color designation hatching schemes, can be explained as follows “[t]he claimed surface of the article is illustrated with a color designation for the color red.”). Reflective surfaces are typically shown with oblique lining.<sup>140</sup>

#### **D. Examination Of Design Applications**

Design patent applications are filed with the USPTO, and currently receive application serial numbers in the form 29/####,###. The applications are assigned to one of four art units (2911 – 2914), depending on the classification of the application.<sup>141</sup> These art units together have 64 Examiners as of the date of this writing.

Design patent prosecution can be expected to be faster than utility prosecution (about 1-2 years for unappealed cases). It is quite common for designs to receive restriction requirements, and for continuation applications to receive double patenting rejections before an allowance. In USPTO Fiscal Year 2011, 21,356 design patents were granted.<sup>142</sup>

One of the principal strategic considerations in design patent prosecution is how to amend the design claim such that there is support in the original application or a parent

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<sup>136</sup> See MPEP § 1503.02.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>137</sup> See MPEP § 1503.02.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>138</sup> See MPEP § 1503.02.III. (Ed. 8, Rev. 5, Aug. 2006).

<sup>139</sup> See MPEP § 1503.02.IV. (Ed. 8, Rev. 5, Aug. 2006).

<sup>140</sup> See *Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1331, n.5 (Fed. Cir. 2012).

<sup>141</sup> A listing of classes and art units is provided (current as of October, 2012) at <http://www.uspto.gov/patents/resources/classification/caau.pdf>.

<sup>142</sup> See *Design Patents, January 1987 -- December 2011, A Patent Technology Monitoring Team Report*, United States Patent & Trademark Office, March, 2012, p. A1-1.

application. To the extent a design is copied there will usually some modification intended to bring the accused article outside—if only just barely—the scope of the design claim.

Amendments can be made, for example, by changing solid lines to broken lines, or *vice versa*. This is not considered by the USPTO to present new matter. As explained in the MPEP:

“an amendment that changes the scope of a design by either reducing certain portions of the drawing to broken lines or converting broken line structure to solid lines is not a change in configuration as defined by the court in *Salmon*. The reason for this is because applicant was in possession of everything disclosed in the drawing at the time the application was filed and the mere reduction of certain portions to broken lines or conversion of broken line structure to solid lines is not a departure from the original disclosure.”<sup>143</sup>

It may also be possible to remove surface ornamentation without introducing new matter. This was addressed in the case *In re Daniels*.<sup>144</sup> There, the court dealt with an application for a design patent filed by an alleged invention promotion scheme. The invention promoters may have received a disclosure appropriate for a utility patent, added arbitrary surface ornamentation (a drawing showing a leaf) to one of the figures, added several of the promoters as inventors, and filed a design patent application.<sup>145</sup> The inventor later filed a continuation application removing the surface ornamentation. The Federal Circuit held that:

“The leaf ornamentation in the parent application, superimposed upon the design of the leecher itself, does not obscure that design, which is fully shown in the parent application drawings. On the correct law, it must be concluded that Mr. Daniels possessed the invention that is claimed in the continuation application, and that he is entitled to claim priority under § 120.”<sup>146</sup>

#### 1. Expedited Examination

Design patents are allowed a special form of expedited examination, commonly referred to as the “rocket docket”.<sup>147</sup> This expedited examination allows a design application to receive

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<sup>143</sup> MPEP § 1504.04 (Ed. 8, Rev. 5, Aug. 2006).

<sup>144</sup> 144 F.3d 1452 (Fed. Cir. 1998).

<sup>145</sup> See *Ex parte Daniels*, 40 U.S.P.Q.2D (BNA) 1394 (BPAI 1996).

<sup>146</sup> *In re Daniels*, 144 F.3d 1452, 1457 (Fed. Cir. 1998).

<sup>147</sup> See 37 C.F.R. § 1.155.

special status at all stages of examination (including appeals and clerical handling).<sup>148</sup> Applications that qualify may issue in under six months. To qualify, an applicant must pay a fee (\$900 as of the date of this writing), conduct a search, submit an IDS with the search references, and state the field of the search.<sup>149</sup> A search conducted by a foreign patent office is acceptable.

Design patent expedited examination does not require the circumstances (such as illness) that must be demonstrated before a petition to make special can be granted for a utility patent application,<sup>150</sup> nor the detailed discussion of the references required by accelerated examination of a utility patent.<sup>151</sup> Design patent applications do not qualify for prioritized (Track I) examination.<sup>152</sup>

## 2. Post Issuance Proceedings

Design patents qualify for certificates of correction, reissues, ex parte reexamination and, assuming the other timing provisions of the statutes are met, inter partes review and post-grant review.<sup>153</sup> The term of a design patent is not extended by these proceedings.<sup>154</sup>

## II. Infringement

“Design patent infringement is a question of fact, which a patentee must prove by a preponderance of the evidence.”<sup>155</sup>

The acts that will infringe a design patent are somewhat debatable. Some are specified in 35 U.S.C. § 289.<sup>156</sup> This section makes it infringement to do either of the following:

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<sup>148</sup> See MPEP § 1504.30 (Ed. 8, Rev. 5, Aug. 2006).

<sup>149</sup> See 37 C.F.R. § 1.155(a).

<sup>150</sup> See MPEP § 708.02 (Ed. 8, Rev. 7, Sept. 2007).

<sup>151</sup> See MPEP § 708.02.VIII.(E) (Ed. 8, Rev. 7, Sept. 2007).

<sup>152</sup> See *Changes To Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act*, 76 Fed. Reg. 59050, 59052 (Sept. 23, 2011).

<sup>153</sup> See 35 U.S.C. § 171.

<sup>154</sup> See *Ex parte Lawrence*, 70 USPQ 326 (Comm’r Pat. 1946).

<sup>155</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010); see also *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

<sup>156</sup> See 35 U.S.C. § 289; *The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).



“(1) appl[y] the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or

(2) sell[] or expose[] for sale any article of manufacture to which such design or colorable imitation has been applied....”<sup>157</sup>

If these acts are committed, then the infringer is liable “to the owner to the extent of his total profit, but not less than \$250”.<sup>158</sup>

Note that the acts of infringement specified in 35 U.S.C. § 289 differ somewhat from those provided under 35 U.S.C. § 271(a) (make, use, offer to sell, sell, or import). “Making” and “selling” infringement would seem to be covered by both § 271(a) and § 289. “Offer to sell” infringement of § 271(a) is at least similar to, although perhaps narrower than, “exposure to sale” infringement of § 289. Section 289, however, lacks an express provision of liability for importation and use, although the Federal Circuit has at least once recited “use” as an infringing act under § 289.<sup>159</sup> Section 289 also lacks provisions for inducement of infringement (§ 271(b)), contributory infringement (§ 271(c)), kit exportation infringement (§ 271(f)), or product of a patented process infringement (§ 271(g))—noting that this latter provision will never apply in a design patent case.

Although the acts specified in § 289 do not include many of the acts specified in § 271, 35 U.S.C. § 171 makes “[t]he provisions of this title relating to patents for inventions” “apply to patents for designs, except as otherwise provided.”<sup>160</sup> If § 289 is not read as “otherwise providing” an exclusive definition of the acts infringement for design patents, then it is quite possible that § 271 applies in its entirety to design patents. Indeed, some courts have at least entertained liability for design patents under 35 U.S.C. § 271(a) and (b).<sup>161</sup> Where § 271 infringement is proven, there would be the further question of whether the prerequisites for the recovery of “total profit” under § 289 have been met. Such recovery may be limited to cases where one of the two acts of infringement specified in § 289 has been proven.

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<sup>157</sup> 35 U.S.C. § 289.

<sup>158</sup> 35 U.S.C. § 289.

<sup>159</sup> See *The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998) (“Infringement of a design patent is the unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof: 35 U.S.C. § 289.”) (emphasis added).

<sup>160</sup> 35 U.S.C. § 171.

<sup>161</sup> See, e.g., *Wing Shing Products (BVI), Ltd. v. Simatelex Manufactory Co., Ltd.*, 479 F. Supp. 2d 388, 407-08 (S.D.N.Y. March 29, 2007).

## A. Design Patent Claim Construction

Design patent claim construction involves an interpretation of the scope of protection as a matter of law.<sup>162</sup> It is carried out formally in litigation and less formally in proceedings before the USPTO.

### 1. Verbal Versus Pictorial Constructions

Design patent claim construction is usually a much simpler endeavor than utility patent claim construction. A typical design patent construction might be “the article of manufacture as shown in the drawings”.<sup>163</sup> In the drawings, the lines have particular meanings that affect the scope of the claims, explained in § I.C.4(c), *supra*. Elements in solid lines are usually considered limiting, and elements in broken lines are usually not considered limiting. As the Federal Circuit stated in *Contessa Food Products, Inc. v. Conagra, Inc.*:

“If features appearing in the figures are not desired to be claimed, the patentee is permitted to show the features in broken lines to exclude those features from the claimed design, and the failure to do so signals inclusion of the features in the claimed design.”<sup>164</sup>

The Federal Circuit has noted that it is usually not advisable for a court to provide a detailed verbal construction of the features in the drawings of a design patent claim, stating that:

“[a]s the Supreme Court has recognized, a design is better represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’ [citation omitted]....Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.”<sup>165</sup>

The risk inherent in a detailed verbal construction is that a court evaluating infringement and validity will slip into a utility-patent-like analysis. For a utility patent, the already written claims are tested element-by-element against accused instrumentalities. If a single element of a claim is missing from an accused instrumentality, the instrumentality does not literally infringe.

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<sup>162</sup> See *Bernhardt, L.L.C., v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1376 (Fed. Cir. 2004).

<sup>163</sup> E.g., *Rapha Products Group, LLC v. Skullcandy, Inc.*, Case No. 1:10-cv-3388-JEC, Slip Op. at 8 (N.D. Ga. Aug. 13, 2012).

<sup>164</sup> *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378 (Fed. Cir. 2002).

<sup>165</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (*en banc*).

This kind of analysis is fundamentally incorrect for design patents, where minor variations from the design are inconsequential, and it is the overall visual impression that dominates.<sup>166</sup> Thus, translating a pictorial representation of the design into words, although not itself incorrect, is the first step down a path leading to error. The Federal Circuit described this error in *Crocs, Inc. v. International Trade Commission*, stating:

“This case shows the dangers of reliance on a detailed verbal claim construction. The claim construction focused on particular features of the '789 patent design and led the administrative judge and the Commission away from consideration of the design as a whole. This error is apparent in the Commission’s explicit reference to two details required by the written claim construction but not by the '789 drawings: (1) a strap of uniform width, and (2) holes evenly spaced around the sidewall of the upper. As shown in Figure 1 of the '789 patent, the strap bulges to a greater width at the middle of the strap on the far left of the figure. Thus, the design figure does not require a strap of uniform width between the two round connectors. Also, as shown in Figure 4 of the 789 patent, the holes are not evenly spaced. Figure 4 shows a gap in the spacing (particularly towards the big toe). Nonetheless, the written claim description required uniform strap width and uniform hole spacing—contrary to the claimed invention. This error distorts the infringement analysis by the ordinary observer viewing the design as a whole.”<sup>167</sup>

However, verbal constructions of the claims are not *per se* error. The *en banc* Federal Circuit noted in *Egyptian Goddess, Inc. v. Swisa, Inc.* that:

“With that said, it is important to emphasize that a district court’s decision regarding the level of detail to be used in describing the claimed design is a matter within the court’s discretion, and absent a showing of prejudice, the court’s decision to issue a relatively detailed claim construction will not be reversible error... In this case, for example, the district court came up with a detailed verbal description of the claimed design. We see no inaccuracy in the court’s description, and neither party has pointed to any prejudice resulting from the court’s interpretation. Yet it is not clear that the considerable effort needed to fashion the verbal description

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<sup>166</sup> See § II.B.2(a), *infra*.

<sup>167</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1302 (Fed. Cir. 2010).

contributed enough to the process of analyzing the case to justify the effort.”<sup>168</sup>

In some cases, it may even be *advisable* to prepare a verbal claim construction.<sup>169</sup> For example, it can be advisable for a district court to explain the conventions of design patent drawings (*e.g.* that broken lines are usually not limiting).<sup>170</sup> Where a design has elements that are dictated by function, it may even be *necessary* for the court to sort out verbally the ornamental features of the design.<sup>171</sup>

## B. Ordinary Observer Test

In order to judge whether an accused design falls within the scope of a design claim, the so-called “ordinary observer” test is applied. This test was originally formulated by the Supreme Court in the 1871 case *Gorham Company v. White*:

“We hold, therefore, that if, 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

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<sup>168</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679-80 (Fed. Cir. 2008) (*en banc*).

<sup>169</sup> *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (*en banc*).

<sup>170</sup> *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (*en banc*) (“Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as describing the role of particular conventions in design patent drafting, such as the role of broken lines...assessing and describing the effect of any representations that may have been made in the course of the prosecution history...and distinguishing between those features of the claimed design that are ornamental and those that are purely functional....”).

<sup>171</sup> *See OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) (“Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent.”); *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010) (“Richardson fails to explain how a court could effectively construe design claims, where necessary, in a way other than by describing the features shown in the drawings. Richardson’s proposition that the claim construction should comprise nothing more than the drawings is simply another way of arguing that the court erred by identifying the functional elements of the patented article, and is therefore unavailing. We find no error in the court’s claim construction.”).

such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”<sup>172</sup>

Thus, under *Gorham*, infringement is determined through an objective evaluation by an “ordinary” observer. The ultimate litmus test is whether the ordinary observer would be deceived into purchasing the article with the accused design, supposing it to be the article with the patented design. In evaluating this deception, *Gorham* held that the ordinary observer must give “such attention as a purchaser usually gives”. In other words, neither a blind selection nor a forensic counterfeiting analysis, but something in between. The test focuses on the overall visual impression made by the two designs, and not a feature-by-feature comparison.<sup>173</sup>

*Gorham* is still quoted as good law today.<sup>174</sup> However, the modern ordinary observer test has evolved in several ways. First, although the term “deception” is still used, the test has been clarified to focus on a comparison of the patented design and claimed design, regardless of other product features that may remove a trademark-esque likelihood of confusion.<sup>175</sup> Second, there is less emphasis on the moment of purchase, and more emphasis on product’s entire life cycle after manufacturing.<sup>176</sup> Third, the prior art is expressly taken into account in the infringement analysis.<sup>177</sup>

A more modern formulation of the test was provided in *Richardson v. Stanley Works, Inc.*, where the Federal Circuit framed it as:

“[whether] an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design.”<sup>178</sup>

In the more modern test, the reference to the time of purchase has been removed, and the ordinary observer is expressly “familiar with the prior art designs”. While the *Richardson* opinion framed the comparison as between the claimed design and the accused *product*, other

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<sup>172</sup> *Gorham Company v. White*, 81 U.S. 511, 528 (1871).

<sup>173</sup> See *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303-04 (Fed. Cir. 2010).

<sup>174</sup> See, e.g., *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009).

<sup>175</sup> See § II.B.2, *infra*.

<sup>176</sup> See § II.B.2(d), *infra*.

<sup>177</sup> See § II.B.3, *infra*.

<sup>178</sup> See *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010).

panels of the Federal Circuit have focused on the accused *design*.<sup>179</sup> Reference to the accused design, as opposed to the accused product, takes emphasis off of elements of a product that extend beyond the claimed design.<sup>180</sup>

The next four sections discuss the characteristics of the “ordinary observer”, the evaluation of deception, the time of that evaluation, and the use of prior art in the infringement analysis.

### 1. Who Is The Ordinary Observer?

In evaluating infringement of a design patent, it is first important to understand the distinction between the “person of ordinary skill in the art” familiar to utility patent law, and the “ordinary observer” that is exclusive to design patent law. In design patent law, both the “person of ordinary skill in the art” and the “ordinary observer” have roles to play. In particular, questions of definiteness and enablement are judged from the perspective of the person of ordinary skill in the art,<sup>181</sup> whereas infringement and anticipation are judged from the perspective of the ordinary observer.<sup>182</sup> The issue of obviousness involves both the person of ordinary skill in the art and the ordinary observer.<sup>183</sup>

These two objective persons, however, can have very different characteristics. The “person of ordinary skill in the art” is a professional engaged in a trade, whereas the “ordinary observer” may not be. The distinction was discussed in the Federal Circuit’s decision in *Goodyear v. Hercules*:

“*Gorham* counsels against measuring the similarity of designs from the viewpoint of experts in design (‘Experts, therefore, are not the persons to be deceived.’). [citation omitted]. Rather, *Gorham* states, the similarity of designs should be measured

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<sup>179</sup> See, e.g., *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (“Even if the claimed design simply combines old features in the prior art, it may still create an overall appearance deceptively similar to the accused design.”); *Payless Shoesource, Inc. v. Reebok International Limited*, 998 F.2d 985, 990 (Fed. Cir. 1993) (“[p]roper application of the *Gorham* test requires that an accused design be compared to the claimed design, not to a commercial embodiment [citation omitted].”)

<sup>180</sup> See § II.B.2(b)(iii), *infra*.

<sup>181</sup> See e.g., *In re Joseph L. Berkman*, 642 F.2d 427, 430 (CCPA 1981) (“Berkman argues that one skilled in the art would readily recognize that the interior of the cases illustrated in the design drawings are inserts. We do not agree. There is nothing shown in the drawings to lead one of ordinary skill to such a conclusion.”).

<sup>182</sup> See §§ II.B.2 and III.C.2, *infra*.

<sup>183</sup> See § III.D.1(d), *infra*.

through 'the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, . . . that advantage of a market which the patent was granted to secure is destroyed.'"<sup>184</sup>

Ordinary observers are often consumers, who buy things like toys, tools, and clothing having patented designs. For such consumer articles, the definition of the ordinary observer as “purchaser” works well, if we ignore the multiple levels of distribution that happen in a typical chain of commerce. At the consumer level at least, the same individual often purchases and uses the article. Even if that were not the case, the consumer purchaser of an article generally has no more ability to discern minor differences between designs than does the user of the article.

Importantly, it is the *article accused of infringement* that defines the ordinary observer, not the *article recited in the patent claim*. In *Goodyear*, the district court had held the patent was limited to truck tires, and that the ordinary observer was a purchaser of truck tires (corresponding to the accused product).<sup>185</sup> The design patent owner argued that its patent was directed to retreads for tires *in general*, and that the ordinary observer should be a purchaser of tires *in general*.<sup>186</sup> The Federal Circuit held that the design patent was not limited to truck tires, but found that the ordinary observer was a purchaser of the product accused of infringement (*i.e.* a purchaser of truck tires).<sup>187</sup> In the court’s words:

“[T]he focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product. The accused tire, the Hercules Power Trac, is a truck tire. The district court correctly invoked the ordinary trucker or fleet operator who purchases truck

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<sup>184</sup> *The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).

<sup>185</sup> *See The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).

<sup>186</sup> *See The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).

<sup>187</sup> *See The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1116 (Fed. Cir. 1998).

tires, as the person from whose viewpoint deceptive similarity to the [claimed] design is determined.”<sup>188</sup>

*Goodyear* illustrates a potential issue in design patent law: for business-to-business products the definition of the observer as “purchaser” has the potential to be awkward. This is because the functions of “purchasing” and “using” articles can imply different levels of expertise, and are often separated in larger businesses. The case *Channell Comm. Prod. v. Broadband Prod.* (C.D. Cal. 2008)<sup>189</sup> is illustrative in this regard. There, the design patent was directed to a design for a wire connector used by telephone and cable companies. The parties agreed (and the district court on that basis held) that the ordinary observer was “a field technician engaged in wire installation, rather than a retail consumer.”<sup>190</sup> Although that person was certainly the user of the product, a case might have been made that field technicians are not *purchasers* in the average telephone or cable company. Rather, the “purchaser” might have been an engineer who chose the connector for its functional specifications, or the professional purchasing departments of the telephone and cable companies. The latter individuals might have had a different perspective on the design.

## 2. Evaluating The Deception Of The Ordinary Observer

Applying the “ordinary observer” test “requires a side-by-side view of the drawings of the [design patent claim] and the accused products.”<sup>191</sup> The Federal Circuit explained this in *Richardson v. Stanley Works*:

“In our recent *Crocs* decision, we set out in detail how an ordinary observer analysis could be conducted to determine infringement. [citation omitted] In analyzing whether a design patent on footwear was infringed, noting the various differences that could be found between the two pieces of footwear in question, we compared their overall effect on the designs. [citation omitted] We looked to ornamental elements such as the curves in the design, the strap assembly, and the base portion of the footwear. [citation omitted] We concluded that both the claimed design and the

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<sup>188</sup> *The Goodyear Tire & Rubber Company v. The Hercules Tire & Rubber Company, Inc.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).

<sup>189</sup> *Channell Commercial Corporation v. Broadband Products, Inc.*, Case No. EDCV 07-1228-VAP (JCRx) (C.D. Cal. August 6, 2008).

<sup>190</sup> *See Channell Commercial Corporation v. Broadband Products, Inc.*, Case No. EDCV 07-1228-VAP (JCRx), Slip Op. at 12-15 (C.D. Cal. August 6, 2008).

<sup>191</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1304 (Fed. Cir. 2010).



accused designs contained those overall ornamental effects, thereby allowing for market confusion. Id.<sup>192</sup>

In making the visual comparison between the claimed design and the accused design, the emphasis is on the *overall effect* of the two designs, and not on individual elements of the designs. As stated by the court in *Crocs*:

“Without a view to the design as a whole, the Commission used minor differences between the patented design and the accused products to prevent a finding of infringement. In other words, the concentration on small differences in isolation distracted from the overall impression of the claimed ornamental features.”<sup>193</sup>

Indeed, as discussed in the next section, if the overall impression of the claimed design and that of the accused product is the same, small differences between the two will not prevent infringement.<sup>194</sup>

#### (a) Doctrine Of Equivalents

The doctrine of equivalents in utility patent law is not readily transferable to design patent law. This is because 35 U.S.C. § 289 already provides for infringement by “colorable imitation”. “In providing for infringement by ‘colorable imitation,’ the statute recognizes that minor changes in a design are often readily made without changing its overall appearance.”<sup>195</sup> Because this scope of infringement is statutory, it might be thought to be separate from the equitable doctrine of equivalents, even though it already includes a scope of equivalents. As noted by the Federal Circuit in *Crocs*:

“The ordinary observer test applies to the patented design in its entirety, as it is claimed. [citation omitted] ‘[M]inor differences between a patented design and an accused article’s design cannot,

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<sup>192</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010) (emphasis added).

<sup>193</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303-04 (Fed. Cir. 2010).

<sup>194</sup> *See Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (“In assessing infringement, the patented and accused designs do not have to be identical in order for design patent infringement to be found. [citation omitted] What is controlling is the appearance of the design as a whole in comparison to the accused product.”).

<sup>195</sup> *Hercules Tire & Rubber Company, Inc. v. the Goodyear Tire & Rubber Company*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998).

and shall not, prevent a finding of infringement.’ [citation omitted].”<sup>196</sup>

If a design is not a “colorable imitation”, then it is not clear why infringement by a further extension of the claims through the doctrine of equivalents should be allowed. It is also difficult to imagine how a utility-patent-like doctrine of equivalents analysis would proceed. The analysis of visual similarity is exhausted by the statutory infringement test, and the “function-way-result” test lacks a sound policy footing for non-functional designs.

The scope of allowable colorable imitations that fall within the claimed design can vary, depending on whether the field is crowded with prior art.<sup>197</sup> This variation in equivalents is arguably captured by the ordinary observer’s express knowledge of the prior art, as explained in § II.B.3 below.

#### (b) What Is The Proper Comparison For Infringement?

Consider the following situation: A design patent claims a design for a shoe. The drawings show an entire shoe, but only a portion of the shoe is shown in solid lines, the remainder being shown in broken lines (not forming part of the claimed design). The owner of the patent sells a product having both the solid and broken-line portions of the shoe. A copyist creates a shoe that appropriates the solid-line portion of the design, but creates the remainder of the shoe in a way that varies remarkably from the portion of the claimed shoe shown in broken lines. In fact, the variations in the unclaimed portion of the design are such that there could never be actual confusion between the patent owner’s and the copyist’s respective commercial products. The copyist also conspicuously marks the shoe with its own trademark on a portion of the shoe outside of the claimed design. In this case, what is the proper comparison for design patent purposes?

This hypothetical illustrates a number of related questions in design patent law, including:

- What kinds of evidence can be used to prove or disprove design patent infringement?
- What is the relevance of the design patent owner’s products?

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<sup>196</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303 (Fed. Cir. 2010); see also *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (“In assessing infringement, the patented and accused designs do not have to be identical in order for design patent infringement to be found. [citation omitted] What is controlling is the appearance of the design as a whole in comparison to the accused product.”).

<sup>197</sup> See *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (“Where, as here, a field is crowded with many references relating to the design of the same type of appliance, we must construe the range of equivalents very narrowly.”).

- What is the relevance of actual marketplace confusion between products?
- Can a copyist escape infringement by appropriating the design, but adding unclaimed features (such as its own trademarked logo)?

These questions are discussed in the following sections.

(i) Evidence Used To Prove Or Disprove Design Patent Infringement.

Evidentiary presentations for design patent infringement can be relatively simple. For consumer articles, a patent owner need not submit more evidence than the design patent itself and the accused product.<sup>198</sup> In *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, for example, the Federal Circuit found that the patent and the accused product rose to the level of substantial evidence, upon which a denial of a motion for JNOV could be affirmed:

“The jury had before it a sample Catalina lamp accused of infringement, certainly very pertinent evidence on this issue. Catalina identifies no reason why its lamp alone does not provide substantial evidence of whether an ordinary observer would believe the patented lamp and the Catalina lamp to be substantially the same.”<sup>199</sup>

In non-consumer cases, there may be some risk in relying on a copy of the design patent and an example of the accused product. In *Channell Commercial Corporation v. Broadband Products, Inc.*, for example, the accused product was a connector used by telephone and cable company field technicians. The district court found that the lack of expert testimony made its analysis difficult:

“In *Braun*, the Federal Circuit upheld a jury’s finding that the design patent for the plaintiff’s hand-held electric blender had been infringed. [citation omitted]. The court noted that a jury, being ‘comprised of a sampling of ordinary observers, does not necessarily require empirical evidence as to whether ordinary observers would be deceived by an accused device’s design.’ [citation omitted]. Here, by contrast, the patent at issue does not involve a consumer product available for retail sale, and the parties

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<sup>198</sup> See *Braun Inc. v. Dynamics Corporation of America*, 975 F.2d 815, 821-22 (Fed. Cir. 1992).

<sup>199</sup> *Catalina Lighting, Inc. v. Lamps Plus, Inc.* 295 F.3d 1277, 1287 (Fed. Cir. 2002); *Braun Inc. v. Dynamics Corporation of America*, 975 F.2d 815, 821-22 (Fed. Cir. 1992) (“Nothing in *Gorham* suggests that, in finding design patent infringement, a trier of fact may not as a matter of law rely exclusively or primarily on a visual comparison of the patented design, as well as the device that embodies the design, and the accused device’s design.”).

have agreed that the ‘ordinary observer’ test should be applied from the perspective of a field technician. Plaintiff’s failure to adduce any evidence on this issue therefore hampers the Court’s ability to conduct such an analysis.”<sup>200</sup>

Additional evidence can come in a variety of forms. Expert testimony can be acceptable,<sup>201</sup> although the expert must be qualified to opine on the view of an ordinary observer—a somewhat counterintuitive qualification in practice, since it is arguable that the more traditional qualifications an expert has, the less able he or she is to render an opinion from the “ordinary observer’s” perspective.<sup>202</sup>

More direct evidence of confusion can also be presented. For example, survey evidence eliciting opinions on the similarity of designs<sup>203</sup> as well as evidence relating to actual accounts of confusion (similar to evidence used in trademark and trade dress actions) can also be presented.<sup>204</sup>

(ii) Relevance Of Patent Owner’s Products.

A patent owner’s commercial products are not *per se* relevant to design patent infringement.<sup>205</sup> In fact, it is possible to infringe a design patent even if the patent owner has no

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<sup>200</sup> *Channell Commercial Corporation v. Broadband Products, Inc.*, Case No. EDCV 07-1228-VAP (JCRx), Slip Op. at 14 (C.D. Cal. Aug. 6, 2008).

<sup>201</sup> *See Gorham Company v. White*, 81 U.S. 511, 530 (1871) (“Both the White designs we think are proved to be infringements of the Gorham patent. A large number of witnesses, familiar with designs, and most of them engaged in the trade, testify that, in their opinion, there is no substantial difference in the three designs, and that ordinary purchasers would be likely to mistake the White designs for the ‘cottagec (viz., that of the plaintiffs).”)

<sup>202</sup> *See, e.g., In re Nalbandian*, 661 F.2d 1214, 1215-16 (CCPA 1981) (“No affiant can be qualified as an expert ordinary observer who might, thereby, persuade the person who is deciding the matter that the latter’s judgment of the reaction of an ordinary observer is in error.”).

<sup>203</sup> *See OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406 (Fed. Cir. 1997) (“In the context of summary judgment, the survey evidence sufficiently establishes that consumers believe that the patented design and the accused balls look similar. The court therefore did not err by affording little probative weight to the expert’s testimony.”).

<sup>204</sup> *See* § II.B.2(b)(iii), *infra*.

<sup>205</sup> *See Payless Shoesource, Inc. v. Reebok International Limited*, 998 F.2d 985, 990 (Fed. Cir. 1993); *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1126 (Fed. Cir. 1993) (“Design patent infringement relates solely to the patented design, and does not require proof of unfair competition in the marketplace see *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029, 228 USPQ 933, 934 (Fed. Cir. 1986) or allow of avoidance of infringement by labelling.”).

commercial products embodying the claimed design.<sup>206</sup> As the Federal Circuit stated in *Unette Corp. v. Unit Pack Co., Inc.*:

“The holder of a valid design patent need not have progressed to the manufacture and distribution of a ‘purchasable’ product for its design patent to be infringed by another’s product....Concluding that a purchaser is unlikely to be confused by any similarity in a competitor’s product only serves to blur the otherwise clear line that exists between the test for infringement of a design patent and the ‘likelihood of confusion’ test for infringement of a trademark.”<sup>207</sup>

However, a direct comparison of an accused product with a product embodying the claimed design is also not necessarily error. In order to avoid error, the patent owner’s product and the claimed design should be substantially the same. In *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, the Federal Circuit noted that:

“[w]hen the patented design and the design of the article sold by the patentee are substantially the same, it is not error to compare the patentee’s and the accused articles directly [citation omitted]; indeed, such comparison may facilitate application of the Gorham criterion of whether an ordinary purchaser would be deceived into thinking that one were the other. It was in this context that the district court analyzed likelihood of confusion. No methodological error has been shown in this analysis.”<sup>208</sup>

(iii) Relevance Of Actual Consumer Confusion Between Products.

As discussed immediately above in § II.B.2(b)(ii), it is not necessary for the design patent owner to have an actual product embodying the claimed design before infringement can occur.

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<sup>206</sup> See *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988).

<sup>207</sup> *Unette Corporation v. Unit Pack Co., Inc.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986); *Payless Shoesource, Inc. v. Reebok International Limited*, 998 F.2d 985, 990 (Fed. Cir. 1993) (“Reebok maintains that the district court misapplied the Gorham test for design patent infringement because it compared the accused footwear with commercial embodiments of the patents, rather than with the claimed designs. Reebok alleges that, in doing so, the court improperly distinguished the accused footwear from the patented designs on the basis of features not in the claimed designs. We agree.”).

<sup>208</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1125-26 (Fed. Cir. 1993); see also *Braun Inc. v. Dynamics Corporation of America*, 975 F.2d 815, 820 n.8 (Fed. Cir. 1992); *Lee v. Dayton-Hudson Corporation*, 838 F.2d 1186, 1189 (Fed. Cir. 1988).

As a necessary consequence of this rule, the design patent owner is under no obligation to prove actual consumer confusion between commercial products, or confusion as to the source of a product, in order for design patent infringement to be found.<sup>209</sup>

However, actual confusion or lack of confusion in the marketplace can be evidence for or against design patent infringement.<sup>210</sup> This is because, during the evaluation of infringement, the factfinder must make a judgment of whether the accused design appropriates the claimed design under the modified *Gorham* test.<sup>211</sup> If consumers are—or are not—actually confused between a product embodying the patented design and an accused product, that may make the question of infringement more or less likely.<sup>212</sup>

Where the patent owner offers evidence of consumer confusion, it is well-advised to offer further evidence that ties the confusion to the overall design, but not to unclaimed features.<sup>213</sup> For example, if the design is a small part of a much larger product, it may be that similarities in the larger product are responsible for confusion that would not occur if the designs alone were placed side-by-side.<sup>214</sup> Conversely, evidence of confusion when only a portion of the claimed design is displayed may not be convincing.<sup>215</sup>

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<sup>209</sup> See *Unette Corporation v. Unit Pack Co., Inc.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986).

<sup>210</sup> See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406-07 (Fed. Cir. 1997).

<sup>211</sup> See § II.B.2, *supra*.

<sup>212</sup> See, e.g., *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406-07 (Fed. Cir. 1997) (“We agree with OddzOn that the exclusion of the ‘actual confusion’ evidence on relevance grounds was an abuse of discretion. Given the low threshold for relevancy, it is clear that the evidence was relevant. It has a ‘tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.’ Fed. R. Evid. 401. We find this error harmless, however, because it does not change the result of OddzOn’s appeal.”).

<sup>213</sup> See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406-07 (Fed. Cir. 1997).

<sup>214</sup> See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406-07 (Fed. Cir. 1997) (“[A]s the district court held, the ‘actual confusion’ evidence is of little probative value because it does not establish whether the balls were returned to OddzOn simply because they had a tail and fins or because they have an ornamental design similar to that of the patented design.”).

<sup>215</sup> See *Keystone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1451 (Fed. Cir. 1993) (“KeyStone also presented evidence of actual confusion between Stonewall and KeyStone products. However, confusion as to the wall is not relevant to a finding of infringement of a patent on a block.”).

When denying infringement, evidence of lack of confusion could be relevant. In such a case, the accused infringer would be well-advised to offer evidence that the lack of confusion is not accomplished by unclaimed portions of the accused product's design, or the simple fact that the accused products are directed toward different segments of the marketplace.<sup>216</sup>

Even if actual confusion (or lack thereof) is shown, it is not dispositive.<sup>217</sup> The factfinder must still apply the *Gorham* test in assessing infringement.

(iv) Relevance Of Additional Features Beyond The Claimed Design.

Many products, although they appropriate the claimed design, may have features beyond that claimed design. Even if these features are could distinguish the accused infringer's product in the marketplace, or are markedly different than the broken-line portions of the design drawings, the accused infringer will not have a good position under the *Gorham* test. In *Payless Shoesource, Inc. v. Reebok International Limited* the Federal Circuit explained that:

“[p]roper application of the *Gorham* test requires that an accused design be compared to the claimed design, not to a commercial embodiment [citation omitted]. [T]he record in the instant case clearly shows that the district court was improperly influenced by features extraneous to the claimed design and that its decision turned on those features. For example, the court found that the design of Payless' XJ 900 model was distinguishable from the design claimed in the '353 patent because the XJ 900 had additional black coloring and did not have the logo 'PUMP' that is printed on the orange basketball on the tongue of the Reebok shoe. Similarly, the court distinguished Payless' 'Attack Force 9160'

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<sup>216</sup> See *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1565 (Fed. Cir. 1988) (“Finally, LAG points to undisputed evidence that Avia's Model 750 shoe, made in accordance with the patent, and LAG's accused Models 584 and 588, are intended for different customers. The former are for tennis players; the latter are for children. That fact, per LAG, renders the products not ‘substantially the same,’ as necessary under *Gorham*. LAG's understanding of *Gorham* is grossly in error. To find infringement, the accused shoes need only appropriate a patentee's protected design, not a patentee's market as well. See *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1028, 228 USPQ 933, 934 (Fed. Cir. 1986) (“The products of the parties need not be directly competitive; indeed, an infringer is liable even when the patent owner puts out no product. A fortiori, infringement is not avoided by selling to a different class of purchasers than the patentee.”).

<sup>217</sup> See *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1464-65 (Fed. Cir. 1997) (“Although there was some evidence of consumer confusion, a reasonable jury could have found that the Siroflex mold design was not substantially the same and did not have substantially the same effect, and did not infringe the D '528 patent.”).

model from the '809 patent design because the 9160 'has an orange basketball on the tongue, which the Reebok shoe does not have.' [citation omitted]. None of those cited features, however, is part of the claimed designs and thus they may not serve as a valid basis for comparison in a design patent infringement analysis."<sup>218</sup>

Likewise, the fact that an accused product or its packaging is marked with a trademark correctly designating the product's source does not, as a matter of law, negate design patent infringement.<sup>219</sup> To avoid infringement, the accused infringer would have to place the mark so that it interferes with the accused product's design to such an extent that *Gorham* test cannot be met.<sup>220</sup>

### (c) The Role Of Functional Elements In The Comparison

The required proof of infringement can change if a court finds that some of the features are "functional". A feature is "functional" if the appearance of that feature is "dictated by function"<sup>221</sup> or "driven purely by utility".<sup>222</sup>

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<sup>218</sup> *Payless Shoesource, Inc. v. Reebok International Limited*, 998 F.2d 985, 990 (Fed. Cir. 1993).

<sup>219</sup> *See L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1126 (Fed. Cir. 1993) ("Design patent infringement relates solely to the patented design, and does not ...allow of avoidance of infringement by labelling.").

<sup>220</sup> *See, e.g., Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 25-26 (N.D. Cal. Dec. 2, 2011)("[A] logo's placement can be considered when logo placement and appearance are part of the style claimed in the patented designs....In this case, additional writing on the front face of the [accused product] alters the minimalist style conveyed in the overall design disclosed by the D'677 and D'087 patents....").

<sup>221</sup> *See Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 13 (N.D. Cal. Dec. 2, 2011).

<sup>222</sup> *See David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1294 (Fed. Cir. 2010) ("Richardson's multi-function tool comprises several elements that are driven purely by utility. As the district court noted, elements such as the handle, the hammer-head, the jaw, and the crowbar are dictated by their functional purpose. The jaw, for example, has to be located on the opposite end of the hammer head such that the tool can be used as a step. The crowbar, by definition, needs to be on the end of the longer handle such that it can reach into narrow spaces. The handle has to be the longest arm of the tool to allow for maximum leverage. The hammer-head has to be flat on its end to effectively deliver force to the object being struck. As demonstrated by the prior art, those are purely functional elements whose utility has been known and used in the art for well over a century.").



Note that if the appearance of the *entire design* is dictated by function, the design patent claim is invalid. This situation is discussed further in § III.B, below. The present section addresses the situation where the claimed design has ornamental aspects, and is thus valid, but also claims one or more features that are dictated by function.

The test for functionality of a feature (“dictated by function”) is generally not satisfied if alternate designs having the same function can be shown.<sup>223</sup> The “same function”, of course, is a slippery concept. All articles of manufacture have some function (even if only to please a human observer), and many features of these articles may have multiple functions. In a design patent, the “same function” means the same functional advantages achieved by a product bearing the patented design.

For example, suppose an article of manufacture falls into a class of articles with a known function. Because of a feature of its design claimed in a design patent, however, the patented article has a particular functional advantage not usually found in articles of the same class. If the attainment of this advantage dictates the claimed design feature, then the feature is functional. This is true even though articles of the same class usually do not have that advantage, and it would not be necessary to include the feature in order to achieve the functions normally associated with the articles of the same class. This was explained by the Federal Circuit in *OddzOn Products, Inc. v. Just Toys, Inc.* There, the patented product was a special kind of football, having a tail with stabilizing fins, like the shaft of an arrow. The Federal Circuit explained:

“OddzOn argues that the shape of a football with an arrow-like tail is an ornamental feature because ‘it is not required for a tossing ball.’ While OddzOn correctly states that there are many ways of designing ‘tossing balls,’ it is undisputed that the ball in question is specifically designed to be thrown like a football, yet travel farther than a traditional foam football. It is the football shape combined with fins on a tail that give the design these functional qualities. The tail and fins on OddzOn’s design add stability in the same manner as do the tail and fins found on darts or rockets. They are no less functional simply because ‘tossing balls’ can be designed without them.”<sup>224</sup>

The functional features of a design cannot serve to distinguish a design from an accused product. As stated by the Federal Circuit in *Richardson*:

“[W]e have made clear that a design patent, unlike a utility patent, limits protection to the ornamental design of the article. [citation omitted]. If the patented design is primarily functional rather than

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<sup>223</sup> See § III.B, *infra*.

<sup>224</sup> *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406 (Fed. Cir. 1997).

ornamental, the patent is invalid. [citation omitted] However, when the design also contains ornamental aspects, it is entitled to a design patent whose scope is limited to those aspects alone and does not extend to any functional elements of the claimed article.”<sup>225</sup>

The rule that protection does not “extend to any functional elements of the claimed article” is a bit counterintuitive for utility patent lawyers at first. For, if the functional elements are not part of the claim (like broken line elements), is the claim not broader? And if the functional elements are part of the claim, how is the claim “limit[ed]...to the ornamental design?”

In fact, functional elements effectively narrow the scope of a design patent monopoly, although it is not easy to analogize this to utility patent law. If a design claim contains functional elements, the patent owner must prove that “deception” under the *Gorham* test is caused by the ornamental features, not by the functional features. This was explained by the Federal Circuit in *OddzOn*:

“If...a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design. The patentee ‘must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental.’ *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825, 23 U.S.P.Q.2D (BNA) 1426, 1434 (Fed. Cir. 1992).”<sup>226</sup>

Claimed, functional features thus vary markedly from unclaimed features.<sup>227</sup> Unclaimed features are not part of the design patent infringement analysis.<sup>228</sup> Claimed, functional features, however, force an extra level of proof on the patent owner.

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<sup>225</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293-94 (Fed. Cir. 2010); *see also OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406 (Fed. Cir. 1997) (“[T]hese functional characteristics do not invalidate the design patent, but merely limit the scope of the protected subject matter. The district court’s claim construction, which we have approved, captures the overall ornamental quality of the design.”).

<sup>226</sup> *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

<sup>227</sup> *See Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995) (“If, as HTH now contends, the vertical ribs and upper protrusion were functional, not ornamental, features, HTH could have omitted these features from its patent application drawings. HTH did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it. *See In re Mann*, 861 F.2d 1581, 1582, 8 U.S.P.Q.2D (BNA) 2030, 2031 (Fed. Cir. 1988) (‘Design patents have almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings.’). Thus, because no other design is disclosed in the '620

This extra proof needs to be accounted for especially when evidence of infringement is provided beyond the design patent and the accused product. For example, evidence of actual confusion would not be particularly persuasive, unless there is some basis for concluding that the actual confusion is due to the ornamental elements of the design. The Federal Circuit addressed a similar issue in *OddzOn*:

“OddzOn next argues that the survey establishes not only overall similarity, but that the similarity is due to common ornamental features. Specifically, OddzOn argues that the various features identified by survey respondents, including the ends of the fins, the football shape, the rocket-like tail, and a ball in front with triangular fins in back, are ornamental ‘because they are not required for a tossing ball.’ Thus, OddzOn argues, the survey is sufficient to show infringement because it establishes that the common features are ornamental. We disagree. The survey fails to establish a link between the similarity reported by respondents and the patented ornamental aspects of the design. [T]he survey did not ask the respondents whether they believed that there was overall similarity apart from the fact that both the design and the accused products were essentially footballs with tails and fins.”<sup>229</sup>

It is easy to see how a patent owner can be caught off guard by a late *Markman* ruling that certain elements are functional.

(d) Features Not Visible At Certain Times

The issue of *when* an ordinary observer needs to be deceived arises when the accused product, or the ability to observe the accused product, changes over time. In such cases, the accused infringer may perceive an advantage in arguing that the “observation” must happen at a particular point in time, such as at the point of purchase or after installation.

The Federal Circuit addressed this question in *Keystone Retaining Wall Systems, Inc. v. Westrock, Inc.* There, the design claim was directed to a block that could be used to build a retaining wall. The claims included both a front face, visible after installation in a wall, and a rear portion, not visible after installation. The patent owner argued that the front face of the accused product appropriated the front face of the claimed design, and that the rear portion was not limiting, because it was not observable. The Federal Circuit held that:

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patent, we interpret the claim as being limited to a design that includes among its ornamental features triangular vertical ribs and an upper protrusion.”).

<sup>228</sup> See §0II.B.2(b)(iv), *supra*.

<sup>229</sup> *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406 (Fed. Cir. 1997).

“We agree that generally concealed features are not proper bases for design patent protection because their appearance cannot be a ‘matter of concern.’ [citation to *In re Stevens* omitted]. On the other hand, a design for an article that is hidden in its final use may be patentable because, during some point in its life, its appearance is a ‘matter of concern.’ [citation omitted]. However, as regards the patented block, there is no hidden portion. As a block, all parts of it are visible. When incorporated in a wall, it ceases to be visible as a block. KeyStone also owns patents on wall designs, but those patents are not in issue, the only issue here being infringement of a block design.”<sup>230</sup>

The Federal Circuit later explained its *Keystone* decision in *Contessa Food Products, Inc. v. Conagra, Inc.* as follows:

“[T]he underlying principle of *Keystone* is nonetheless apposite: for purposes of design patent infringement, the ‘ordinary observer’ analysis is not limited to those features visible during only one phase or portion of the normal use lifetime of an accused product. [citation omitted] Instead, the comparison must extend to all ornamental features visible during normal use of the product, i.e., ‘beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article.’ [citation omitted].”<sup>231</sup>

The argument that features not visible at certain points in time are not limiting arose from earlier CCPA cases. Those cases evaluated appeals from the rejection of design patent applications, and typically dealt with the question of whether features were truly “ornamental”. The most frequently cited of these is *In re Stevens*,<sup>232</sup> in which the CCPA affirmed a rejection of a design patent for a brush used in the cleaning head of a vacuum cleaner. The *Stevens* court held:

“Almost every article is visible when it is made and while it is being applied to the position in which it is to be used. Those special circumstances, however, do not justify the granting of a design patent on an article such as that here under consideration which is always concealed in its normal and intended use. The ornamental appearance of such an article is a matter of such little

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<sup>230</sup> *Keystone Retaining Wall Systems, Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450-51 (Fed. Cir. 1993).

<sup>231</sup> *Contessa Food Products, Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1380 (Fed. Cir. 2002).

<sup>232</sup> 173 F.2d 1015 (CCPA 1949).

concern that it cannot be said to possess patentability as a design. We are of opinion, therefore, that the rejection of appellant's claim was proper."<sup>233</sup>

*Stevens* dealt with ornamentality, while *Contessa* dealt with infringement. Notwithstanding this fact, the *Stevens* exclusion of "special circumstances" of visibility after manufacturing and before normal use would seem to be at odds with *Contessa*, which required analysis of all features visible after the completion of manufacturing and before ultimate loss of the article. This apparent conflict was resolved by the Federal Circuit in the case *In re Webb*:

"We read those cases [such as *Stevens*] to establish a reasonable general rule that presumes the absence of ornamentality when an article may not be observed. This is a sound rule of thumb, but it is not dispositive. [citation omitted]. In each case, the inquiry must extend to whether at some point in the life of the article an occasion (or occasions) arises when the appearance of the article becomes a 'matter of concern.' Here, we read the Board's decision to have established a per se rule under § 171 that if an article is hidden from the human eye when it arrives at the final use of its functional life, a design upon that article cannot be ornamental. The rule in *Stevens* does not compel the Board's decision. Instead, *Stevens* instructs us to decide whether the 'article such as here under consideration' – a hip stem implant – 'is always concealed in its normal and intended use.' The issue before us, then, is whether 'normal and intended use' of these prosthetic devices is confined to their final use. Although we agree that 'normal and intended use' excludes the time during which the article is manufactured or assembled, it does not follow that evidence that an article is visible at other times is legally irrelevant to ascertaining whether the article is ornamental for purposes of § 171. Contrary to the reasoning of the Examiner in this case, articles are designed for sale and display, and such occasions are normal uses of an article for purposes of § 171. The likelihood that articles would be observed during occasions of display or sale could have a substantial influence on the design or ornamentality of the article."<sup>234</sup>

The *Webb* court concluded by defining "normal and intended use" to be the "period in the article's life, beginning after completion of manufacture or assembly and ending with the

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<sup>233</sup> *In re Stevens*, 173 F.2d 1015, 1016 (CCPA 1949).

<sup>234</sup> *In re John D. Webb, Jr.*, 916 F.2d 1553, 1557 (Fed. Cir. 1990).

ultimate destruction, loss, or disappearance of the article”<sup>235</sup>—the same definition applied by the *Keystone* and *Contessa* decisions in the context of infringement.

### 3. Role Of Prior Art In Design Patent Infringement Analysis

As noted above in § II.B, the ordinary observer test requires that the ordinary observer be “familiar with the prior art designs”. This purpose of this requirement was explained by the Federal Circuit in *Crocs*:

“To show infringement under the proper test, an ordinary observer, familiar with the prior art designs, would be deceived into believing that the accused product is the same as the patented design. [citation omitted]. When the differences between the claimed and accused designs are viewed in light of the prior art, the attention of the hypothetical ordinary observer may be drawn to those aspects of the claimed design that differ from the prior art. [citation omitted]. If the claimed design is close to the prior art designs, small differences between the accused design and the claimed design assume more importance to the eye of the hypothetical ordinary observer. [citation omitted]. The ordinary observer, however, will likely attach importance to those differences depending on the overall effect of those differences on the design.”<sup>236</sup>

In other words, a design claim and an accused design may look similar to an ordinary observer at first glance. If, however, we give the ordinary observer experience with the closest prior art, the ordinary observer’s perception may change. If the prior art, the patented design and the accused design all have certain features in common, these features will become less apparent to an ordinary observer, and differences will receive more focus, just as a witness looking at a lineup of suspects will be drawn to distinct facial features, rather than to the fact that each of the suspects has the normal characteristics of a human being, *e.g.* being of approximately the same height, having a head, a torso, two eyes, etc.

It is not, however, mandatory that a court consider the prior art during the infringement analysis if the claimed design and the accused design are sufficiently different. The *en banc* Federal Circuit explained this in *Egyptian Goddess, Inc. v. Swisa, Inc.*:

“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

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<sup>235</sup> *In re John D. Webb, Jr.*, 916 F.2d 1553, 1558 (Fed. Cir. 1990).

<sup>236</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303 (Fed. Cir. 2010); *see also International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 675 (Fed. Cir. 2008) (*en banc*).

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, 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.”<sup>237</sup>

(a) Burden To Bring Forward Prior Art

Because prior art used in the infringement analysis has the effect of making infringement less likely, the Federal Circuit has placed the burden of production of such prior art on the accused infringer. In *Egyptian Goddess, Inc. v. Swisa, Inc.*,<sup>238</sup> the *en banc* court reasoned that:

“[A]lthough the approach we adopt will frequently involve comparisons between the claimed design and the prior art, it is not a test for determining validity, but is designed solely as a test of infringement. Thus, as is always the case, the burden of proof as to infringement remains on the patentee. However, if the accused infringer elects to rely on the comparison prior art as part of its defense against the claim of infringement, the burden of production of that prior art is on the accused infringer. ... Under the ordinary observer test, however, it makes sense to impose the burden of production as to any comparison prior art on the accused infringer. The accused infringer is the party with the motivation to point out close prior art, and in particular to call to the court’s attention the prior art that an ordinary observer is most likely to regard as highlighting the differences between the claimed and accused design. Regardless of whether the accused infringer elects to present prior art that it considers pertinent to the comparison between the claimed and accused design, however, the patentee bears the ultimate burden of proof to demonstrate infringement by a preponderance of the evidence.”<sup>239</sup>

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<sup>237</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (*en banc*).

<sup>238</sup> 543 F.3d 665 (Fed. Cir. 2008) (*en banc*).

<sup>239</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678-79 (Fed. Cir. 2008) (*en banc*).

As the *Egyptian Goddess* case makes clear, the ultimate burden of proving infringement is on the patent owner. Accordingly, the failure of the accused infringer to bring forward prior art is not an admission of infringement, but rather only a concession that knowledge of the prior art would not make infringement less likely.<sup>240</sup>

(b) Abrogated “Point Of Novelty” Test

For decades prior to 2008, a patent owner’s case for infringement was subject to a “point of novelty” test.<sup>241</sup> The “point of novelty” test required the patent owner to show that the accused design appropriated the “point of novelty” that distinguished the design patent claim from the prior art. The Federal Circuit has explained this test as follows:

“In applying the point of novelty test in the case of infringement, we looked at whether the accused design appropriated the points of novelty of the patented design. [citation omitted]. The points of novelty for the patented design were determined by comparing the patented design to the prior art designs. [citation omitted]. In the case of anticipation, we compared the patented design with the alleged anticipatory reference to see if it appropriated the points of novelty of the prior art reference. The points of novelty of the prior art reference were determined by looking to earlier prior art to determine the points of novelty in the anticipatory reference.”<sup>242</sup>

The “point of novelty” test was abrogated by the Federal Circuit’s 2008 *en banc* decision in *Egyptian Goddess*.<sup>243</sup> The *en banc* court identified a number of difficulties with the test, as exemplified in the following passage:

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<sup>240</sup> See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678-79 (Fed. Cir. 2008) (*en banc*).

<sup>241</sup> See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (*en banc*) (“However, in a series of cases tracing their origins to *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984), this court has held that proof of similarity under the ordinary observer test is not enough to establish design patent infringement. Rather, the court has stated that the accused design must also appropriate the novelty of the claimed design in order to be deemed infringing.”).

<sup>242</sup> *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238-39 (Fed. Cir. 2009).

<sup>243</sup> See *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (*en banc*) (“[W]e hold that the ‘point of novelty’ test should no longer be used in the analysis of a claim of design patent infringement. Because we reject the ‘point of novelty’ test, we also do not adopt the ‘non-trivial advance’ test, which is a refinement of the ‘point of novelty’ test. Instead, in accordance with *Gorham* and subsequent decisions, we hold that the ‘ordinary observer’ test should be the sole test for determining whether a design patent has been infringed. Under that



“[T]he point of novelty test has proved reasonably easy to apply in simple cases in which the claimed design is based on a single prior art reference and departs from that reference in a single respect. In such cases, it is a simple matter to identify the point of novelty and to determine whether the accused design has appropriated the point of novelty, as opposed to copying those aspects of the claimed design that were already in the prior art. However, the point of novelty test has proved more difficult to apply where the claimed design has numerous features that can be considered points of novelty, or where multiple prior art references are in issue and the claimed design consists of a combination of features, each of which could be found in one or more of the prior art designs. In particular, applying the point of novelty test where multiple features and multiple prior art references are in play has led to disagreement over whether combinations of features, or the overall appearance of a design, can constitute the point of novelty of the claimed design....”<sup>244</sup>

The court in *International Seaway* expanded on these difficulties in the context of anticipation, holding that *Egyptian Goddess* abrogated the test for both infringement and anticipation.<sup>245</sup>

The abrogation of the “point of novelty” test led directly to the inclusion of the phrase “having knowledge of the prior art” into the “ordinary observer” test, via a re-interpretation of the precedent establishing the “point of novelty” test. As explained by the Federal Circuit in *Egyptian Goddess*:

“We think, however, that *Litton* and the predecessor cases on which it relied are more properly read as applying a version of the ordinary observer test in which the ordinary observer is deemed to view the differences between the patented design and the accused

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test, as this court has sometimes described it, infringement will not be found unless the accused article ‘embod[ies] the patented design or any colorable imitation thereof.’ [citation omitted].”)

<sup>244</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 671 (Fed. Cir. 2008) (*en banc*).

<sup>245</sup> See *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) (“[A]pplying the point of novelty test in the context of anticipation, as in the context of infringement, creates the need to canvass the entire prior art to identify the points of novelty. In addition, eliminating the point of novelty test for anticipation ‘has the advantage of avoiding the debate over the extent to which a combination of old design features can serve as a point of novelty under the point of novelty test.’ [citation omitted]. Just as the problems deriving from the point of novelty test exist in both the infringement and anticipation contexts, the benefits of applying the refined ordinary observer test are identical in both.”).

product in the context of the prior art. When the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from the prior art. And when the claimed design is close to the prior art designs, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.”<sup>246</sup>

Although the “point of novelty” test is no longer required, the inclusion of the prior art within the viewpoint of the ordinary observer can lead to conclusions similar to those produced by the “point of novelty” test, without taking too much emphasis off the overall visual impression of the design. The *Egyptian Goddess* court observed that:

“If the accused design has copied a particular feature of the claimed design that departs conspicuously from the prior art, the accused design is naturally more likely to be regarded as deceptively similar to the claimed design, and thus infringing. At the same time, unlike the point of novelty test, the ordinary observer test does not present the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.”<sup>247</sup>

The abrogation of the “point of novelty” test also resolved the long-open question of whether a *combination* of features could be a “point of novelty”, even if each of the features was known in the prior art. The court in *Crocs* held:

“Even if the claimed design simply combines old features in the prior art, it may still create an overall appearance deceptively similar to the accused design. In that case, this court will uphold a finding of infringement. [citation omitted]. In other words, ‘the deception that arises is a result of the similarities in the overall design, not of similarities in ornamental features in isolation.’ [citation omitted].”<sup>248</sup>

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<sup>246</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 675 (Fed. Cir. 2008) (*en banc*).

<sup>247</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008) (*en banc*).

<sup>248</sup> *Crocs, Inc. v. International Trade Commission*, 598 F.3d 1294, 1303 (Fed. Cir. 2010).

### III. Validity

“To be patentable a design must be for an article of manufacture, must meet the criteria of being new, original, and ornamental, and must satisfy the other relevant requirements of Title 35....”<sup>249</sup> In *Bernhardt, L.L.C., v. Collezione Europa USA, Inc.*, the Federal Circuit noted that:

“In *Litton Systems, Inc. v. Whirlpool Corp.*, [citation omitted], we held that ‘the tests for determining the validity of a design patent issued pursuant to 35 U.S.C. § 171 are identical to those tests currently espoused by this court for determining the validity of a utility patent issued pursuant to 35 U.S.C. § 101.’”<sup>250</sup>

This statement can only be taken as true at a very general level (*i.e.* implying that §§ 102, 103 and 112 must be examined), because validity doctrines between design and utility patents are facially quite different. For example, a design patent can be found invalid if its design is dictated by function,<sup>251</sup> whereas a utility patent cannot be.

Like utility patents, issued design patents enjoy the presumption of validity.<sup>252</sup> This means that the design patent can only be proven invalid in court by clear and convincing evidence.<sup>253</sup>

The following sections review the principal requirements for design patent validity.

#### A. Originality

A design patent claim is required to be directed to an “original” design. “Originality” is not a proxy for novelty or non-obviousness—those requirements have separate bases in the

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<sup>249</sup> *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997). In an August 27, 2012, Patently-O post, Professor Hricik argues that § 101 is not a basis for a defense to infringement under 35 U.S.C. § 282. See D. Hricik “*Are the Courts Correct in Their Assumption that a Patent Issued on Non-patentable Subject Matter is Invalid?*”, <http://www.patentlyo.com/patent/2012/08/are-the-courts-correct-in-their-assumption-that-a-patent-issued-on-non-patentable-subject-matter-is-invalid.html> (Aug. 27, 2012). Professor Hricik might argue that the same logic applies to the originality and ornamentality requirements under § 171.

<sup>250</sup> *Bernhardt, L.L.C., v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1377 (Fed. Cir. 2004)

<sup>251</sup> See §III.B, *infra*.

<sup>252</sup> See *Rosco, Inc. v. Mirror Lite Company* 304 F.3d 1373, 1377 (Fed. Cir. 2002).

<sup>253</sup> See *Rosco, Inc. v. Mirror Lite Company* 304 F.3d 1373, 1377 (Fed. Cir. 2002).

statute. Because of this, it remains somewhat unclear what the “originality” requirement means in practice. The Federal Circuit in *International Seaway* described the requirement as follows:

“The originality requirement in § 171 dates back to 1842 when Congress enacted the first design patent law. The purpose of incorporating an originality requirement is unclear; it likely was designed to incorporate the copyright concept of originality—requiring that the work be original with the author, although this concept did not find its way into the language of the Copyright Act until 1909. [citation omitted]. In any event, the courts have not construed the word ‘original’ as requiring that design patents be treated differently than utility patents.”<sup>254</sup>

The MPEP directs examiners to reject claims for lack of originality if the patent owner is engaging in “simulation” of well-known objects or people:

“[A] claim directed to a design for an article which simulates a well known or naturally occurring object or person should be rejected under 35 U.S.C. § 171 as nonstatutory subject matter in that the claimed design lacks originality....It would also be appropriate, if the examiner has prior art which anticipates or renders the claim obvious, to reject the claim under either 35 U.S.C. § 102 or 103(a) concurrently.”<sup>255</sup>

Presumably, the well-known person or object would have to be prior art. If this is true, it is not clear whether there could be an instance where the claims were novel and non-obvious, but did not have originality.

## **B. Functional Versus Ornamental Nature**

A claimed design must be “ornamental”. “Ornamental” does not mean aesthetically pleasing,<sup>256</sup> rather, it means “not functional”. If a design patent claim is functional, the claim is

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<sup>254</sup> *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009).

<sup>255</sup> MPEP § 1504.01(d) (Ed. 8, Rev. 5, Aug. 2006).

<sup>256</sup> *See Seiko Epson Corporation v. Nu-Kote International, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999) (“Nor need the design be aesthetically pleasing. The ‘ornamental’ requirement of the design statute means that the design must not be governed solely by function, i.e., that this is not the only possible form of the article that could perform its function. [citation omitted] A design patent is for a useful article, but patentability is based on the design of the article, not the use. The design may contribute distinctiveness or consumer recognition to the design, but an absence of artistic merit does not mean that the design is purely functional.”).

invalid. “Invalidity due to functionality is an affirmative defense to a claim of infringement of a design patent, and must be proved by the party asserting the defense.”<sup>257</sup>

A design is functional if its overall appearance is “dictated by function”. This test is stringent: it does not easily allow for proof of functionality. As the Federal Circuit explained in *Rosco, Inc. v. Mirror Lite Company*:

“We apply a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where ‘the appearance of the claimed design is ‘dictated by’ the use or purpose of the article.’ [citation omitted].”<sup>258</sup>

Functional design patents are invalid because they do not meet the statute’s “ornamentality” requirement,<sup>259</sup> which in turn furthers the purpose of promoting the decorative arts. The Federal Circuit in *Avia Group International, Inc. v. L.A. Gear California, Inc.*, explained:

“[Defendant] correctly asserts that if a patented design is ‘primarily functional,’ rather than primarily ornamental, the patent is invalid. [citation omitted]. When function dictates a design, protection would not promote the decorative arts, a purpose of the design patent statute.”<sup>260</sup>

A patent owner can prove that a design patent claim is not functional by showing that there are alternate designs that provide the same function. The *Rosco* court explained as follows:

“The design must not be governed solely by function, i.e., that ‘this is not the only possible form of the article that could perform its function.’ [citation omitted] ‘When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.’ [citation omitted] That is, if other designs could produce the same

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<sup>257</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1122-23 (Fed. Cir. 1993).

<sup>258</sup> *Rosco, Inc. v. Mirror Lite Company*, 304 F.3d 1373, 1378 (Fed. Cir. 2002).

<sup>259</sup> 35 U.S.C. § 171.

<sup>260</sup> *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988).

or similar functional capabilities, the design of the article in question is likely ornamental, not functional.”<sup>261</sup>

This rule was arguably softened in *PHG Technologies, LLC, v. St. John Companies, Inc.*, where the Federal Circuit held:

“Our case law makes clear that a full inquiry with respect to alleged alternative designs includes a determination as to whether the alleged ‘alternative designs would adversely affect the utility of the specified article,’ such that they are not truly ‘alternatives’ within the meaning of our case law.”<sup>262</sup>

Testimonial evidence about the nature of the design can be provided.<sup>263</sup> A patent owner can attempt to show that the features of the design are unconnected with the functionality that the article provides. In *Rosco, Inc. v. Mirror Lite Company*, for example, the patent owner was able to show that the oval-shaped design did not provide the claimed superior (field-of-view and aerodynamic) functionality:

“The mere fact that the invention claimed in the design patent exhibited a superior field of view over a single predecessor mirror (here, the Bus Boy) does not establish that the design was ‘dictated by’ functional considerations, as required by *L.A. Gear*. The record indeed reflects that other mirrors that have non-oval shapes also offer that particular field of view. Similarly, nothing in the record connects the oval shape of the patented design with aerodynamics, and the record shows that other non-oval shaped mirrors have the same aerodynamic effect.”<sup>264</sup>

The Federal Circuit explained in *L.A. Gear, Inc. v. Thom McAn Shoe Company* that an accused infringer must prove that the design *as a whole* is functional:

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<sup>261</sup> *Rosco, Inc. v. Mirror Lite Company*, 304 F.3d 1373, 1378 (Fed. Cir. 2002); *see also Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997); *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

<sup>262</sup> *PHG Technologies, LLC, v. St. John Companies, Inc.*, 469 F.3d 1361, 1367 (Fed. Cir. 2006).

<sup>263</sup> *See Catalina Lighting, Inc. v. Lamps Plus, Inc.* 295 F.3d 1277, 1287 (Fed. Cir. 2002) (“According to Swanson, he could put the lights together at the top of the lamp or ‘within ninety degrees of each other and have the same function, but it would look terrible.’ Given Swanson’s testimony, the jury was presented with evidence that these features are not functional, but instead were aesthetic design choices.”).

<sup>264</sup> *Rosco, Inc. v. Mirror Lite Company*, 304 F.3d 1373, 1378-79 (Fed. Cir. 2002).

“In determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.”<sup>265</sup>

This requirement, however, does not preclude separate analysis of the functionality of the features of a design. In *Power Controls Corp. v. Hybrinetics, Inc.*, the Federal Circuit held as follows:

“In determining whether a design is primarily functional, the purposes of the particular elements of the design necessarily must be considered. [Defendant’s expert’s] affidavit properly explained why and how the various elements of the '580 patented package each served a particular functional purpose. This design is composed mainly of functional elements, and we hold that Hybrinetics’ showing that it is primarily functional is sufficient to preclude the grant of a preliminary injunction.”<sup>266</sup>

Where only portions of the claimed design are functional, then the patent is not invalid.<sup>267</sup> Instead, the functional portions of the claimed design place an extra burden on the patent owner in the proof of infringement, as discussed above in § II.B.2(c).

In *Berry Sterling Corporation v. Prescor Plastics, Inc.*, the Federal Circuit noted several other factors that might be relevant in assessing functionality:

“Other appropriate considerations [for evaluating functionality] might include: whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents; whether the advertising touts particular features of the design as having specific utility; and whether there are any elements in the design or an overall appearance clearly not dictated by function.”<sup>268</sup>

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<sup>265</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1123 (Fed. Cir. 1993).

<sup>266</sup> *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 239-240 (Fed. Cir. 1986).

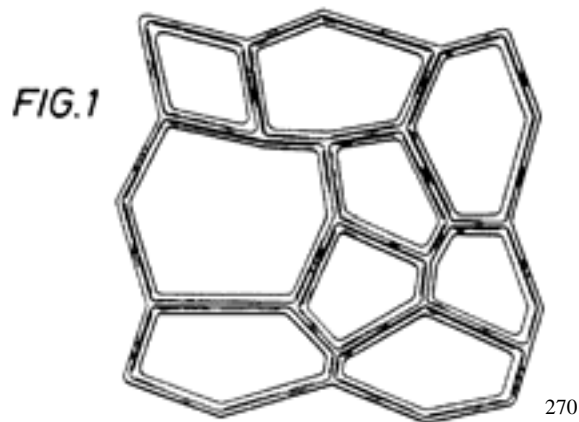
<sup>267</sup> *See David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010).

<sup>268</sup> *Berry Sterling Corporation v. Prescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997).

While the Federal Circuit discourages courts from construing verbally the features shown in the drawings of a design patent claim verbally (*see* §II.A.1, above), it has also recognized that it may be necessary to describe verbally the functional features. As stated in *Richardson v. Stanley Works, Inc.*:

“Although we proposed that the preferable course ordinarily will be for a district court not to attempt to construe a design patent claim, *id.*, we also emphasized that there are a number of claim scope issues on which a court’s guidance would be useful to the fact finder. [citation omitted] Among them, we specifically noted, is the distinction between the functional and ornamental aspects of a design.”<sup>269</sup>

One interesting problem relating to functionality was presented to the Federal Circuit in *Hupp v. Siroflex of America, Inc.* Hupp had a design patent on a mold for producing cement tiles that could be used in walkways. One of Hupp’s drawings, showing the mold absent filling material, is reproduced below:



While the arrangement of walkway tiles was certainly not functional (there being many ways to do so), the question in *Hupp* was whether *the mold for making walkway tiles* of a specific arrangement could be ornamental. The Federal Circuit held:

“The mold whose design is the subject of the D '528 patent serves the function of producing a simulated rock walkway, while the particular design of the mold is primarily ornamental. As the prior art shows, a variety of structures and tools, including molds, have been used to make concrete shapes, including walkways, of various designs. Since other designs have the same general use,

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<sup>269</sup> *David A. Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010).

<sup>270</sup> U.S. Design Pat. 342,528, Fig. 1.



and the aesthetic characteristics of Hupp’s design are not dictated by the function of the article, Hupp’s design is primarily ornamental within the meaning of the design patent law.”<sup>271</sup>

A claimed design can not be proven to be lacking ornamentality by showing that the claimed article is not exposed to viewing. In *Seiko Epson Corporation v. Nu-Kote International, Inc.*, for example, the court considered the ornamentality of a design for an ink cartridge, finding that:

“The district court reasoned that since the cartridge is not in view after its installation and during use in the printer, the consumer is not concerned with its design and thus that there can not be a valid design patent. The premise is incorrect. The validity of a design patent does not require that the article be visible throughout its use; it requires only that the design be of an article of manufacture and that the design meets the requirements of Title 35. [citations omitted]. The district court erred in holding that an article that is not exposed to view during use can not be the subject of a design patent.”<sup>272</sup>

### C. Anticipation

A design patent or application claim can be anticipated under 35 U.S.C. § 102, like a utility patent.<sup>273</sup> The case law principles implementing those sections are by default the same, departing when required by the nature of the design patent.

#### 1. Scope Of The Prior Art

Prior art, for example, is determined by the same rules as applied for utility patents.<sup>274</sup> For example, a design patent can be anticipated as easily by a public use or sale in the United States prior to the critical date,<sup>275</sup> as it can be by a patent or printed publication.

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<sup>271</sup> *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1461 (Fed. Cir. 1997).

<sup>272</sup> *Seiko Epson Corporation v. Nu-Kote International, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999).

<sup>273</sup> See *Bernhardt, L.L.C., v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1377 (Fed. Cir. 2004); *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1238 (Fed. Cir. 2009) (“Section 171 requires that the ‘conditions and requirements of this title’ be applied to design patents, thus requiring application of the provisions of sections 102 (anticipation) and 103 (invalidity).”).

<sup>274</sup> See *Bernhardt, L.L.C., v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1377 (Fed. Cir. 2004).

It is clear, for example, that utility patents can be prior art to design patents,<sup>276</sup> just as design patents can be prior art to utility patents.<sup>277</sup> As the CCPA explained in *In re Aslanian*:

“Although there are different statutory bases and standards for utility patents and design patents, no similar distinction exists when determining what constitutes relevant prior art for these two types of patents. Numerous decisions of this court have held that the teachings in utility patents are within the prior art to be considered when determining the patentability of designs even though the patentability of a design may not be predicated on utilitarian or functional considerations.”<sup>278</sup>

(a) Experimental Use Doctrine

The experimental use doctrine presents something of a special case. Experimentation, of course, implies that the person responsible for the design does not know how best to implement it. Because design patents are not intended to cover designs that are “dictated by function”, two questions are raised: (1) can experimentation on *functional* aspects of a product negate a use or sale that would otherwise qualify as prior art to a design patent claim? And if not, then (2) is there experimentation that can be performed on *non-functional* aspects of a design, such that the experimental use doctrine could be invoked (e.g. focus group evaluation on the aesthetic aspects of the design)?

The answers from case law are complex and somewhat counterintuitive. They are best reviewed chronologically. In the 1988 case *In re Mann*,<sup>279</sup> the Federal Circuit reviewed a rejection of a design patent application over a display at a trade show. The applicant argued that the article had not been displayed for its normal purpose, and therefore must have been displayed

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<sup>275</sup> See *Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.*, 141 F.3d 1073, 1075 (Fed. Cir. 1998) (“A claimed design is considered to be ‘on-sale,’ within the meaning of section 102(b), when an embodiment of the design was sold or offered for sale in this country more than one year before a filing date to which the claim is entitled (the critical date) and the sale or offer to sell was primarily for profit rather than for experimental purposes.”).

<sup>276</sup> See *In re Aslanian*, 590 F.2d 911, 913 (CCPA 1979).

<sup>277</sup> See *In re Aslanian*, 590 F.2d 911, 913-14 (CCPA 1979) (“In the reverse situation, numerous decisions have indicated that design patents can be properly cited as the basis for an anticipation rejection of claims in an application for a utility patent. [citations omitted]...[T]his court has stated that a drawing in a utility patent can be cited against the claims of a utility patent application even though the feature shown in the drawing was unintended or unexplained in the specification of the reference patent.”).

<sup>278</sup> *In re Aslanian*, 590 F.2d 911, 913 (CCPA 1979).

<sup>279</sup> 861 F.2d 1581 (Fed. Cir. 1988).

for an experimental purpose. Rather than simply holding that the applicant had not provided sufficient evidence of experimentation, the court appeared to hold that experimental use was *per se* not possible for a design. In the words of the court:

“We see no way in which an ornamental design for an article of manufacture can be subject to the ‘experimental use’ exception applicable in the case of functioning machines, manufactures, or processes. Obtaining the reactions of people to a design – whether or not they like it—is not ‘experimentation’ in that sense. In the case of a design, if market testing shows that it has no appeal and the design is changed, the result is a new and different design; the original design remains just what it was. Design patents have almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings.”<sup>280</sup>

The Federal Circuit’s holding in *Mann*, however, was distinguished in *Tone Brothers, Inc. v. Sysco Corporation*. There, the Federal Circuit found that public experimentation directed to the *functional* aspects of a product, the design of which was later patented, raised a genuine issue material fact as to public use. The court found that the *Mann* decision was limited to the situation where the public use was fundamentally *commercial* in nature. This allowed the court to find that:

“None of our cases have addressed the issue of whether experimentation involving the functional aspects of a product to which a design patent relates can be a non-public use. We do so today and hold that experimentation directed to functional features of a product also containing an ornamental design may negate what otherwise would be considered a public use within the meaning of section 102(b).”<sup>281</sup>

*Tone Bros.* was itself distinguished, however, in *Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.* In that case, the purported prior art event was a sale, not a public use. The Federal Circuit held:

“In *Tone Bros.* this court held that ‘public use’ under section 102(b) could be negated by experimentation directed at optimizing the functional aspects of an article while not addressing the ornamental aspects of its design. [citation omitted]. *Tone Bros.* is a ‘public use’ case. We see no reason to extend the analysis to the ‘on-sale’ context. ‘Public use’ and ‘on-sale’ bars, while they share the same statutory basis, are grounded on different policy

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<sup>280</sup> See *In re Mann*, 861 F.2d 1581, 1581 (Fed. Cir. 1988).

<sup>281</sup> *Tone Brothers, Inc. v. Sysco Corporation*, 28 F.3d 1192, 1199-1200 (Fed. Cir. 1994).

emphases. The primary policy underlying the ‘public use’ case is that of detrimental public reliance, whereas the primary policy underlying an ‘on-sale’ case is that of prohibiting the commercial exploitation of the design beyond the statutorily prescribed time period. Thus, in *Tone Bros.* the court merely distinguished between the display of a design to generate public interest versus the display of a design for experimental use. It concluded that the display was not contrary to the policy of detrimental public reliance because the display was for the sole purpose of experimentation. In contrast, Continental’s agreement with L&A Juice to sell the patented design is an explicit commercial exploitation of the claimed design outside of the generous one year grace period.”<sup>282</sup>

Thus, the experimental use doctrine in the context of design patents appears to be applicable only to public uses (not sales), and only where the experimentation is directed to functional aspects of the article embodying the design. It remains unclear whether those functional aspects must be claimed in the design patent, although the functional aspects were claimed in *Tone Bros.*<sup>283</sup>

## 2. Test For Anticipation

The test for anticipation is the same “ordinary observer” test used for infringement.<sup>284</sup> This test was reviewed in detail in §II.B. The rationale for applying the ordinary observer test was explained by the Federal Circuit in *International Seaway*:

“In light of Supreme Court precedent and our precedent holding that the same tests must be applied to infringement and anticipation, and our holding in *Egyptian Goddess* that the ordinary observer test is the sole test for infringement, we now conclude that the ordinary observer test must logically be the sole test for anticipation as well. In doing so, we will prevent an inconsistency from developing between the infringement and anticipation

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<sup>282</sup> *Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.*, 141 F.3d 1073, 1079 (Fed. Cir. 1998).

<sup>283</sup> *See Tone Brothers, Inc. v. Sysco Corporation*, 28 F.3d 1192, 1199 n.5 (Fed. Cir. 1994).

<sup>284</sup> *See International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009).

analyses, and we will continue our well-established practice of maintaining identical tests for infringement and anticipation.”<sup>285</sup>

There should, however, be a few differences between the “ordinary observer” test as applied to infringement and the test as applied to anticipation. These differences will likely arise due to two things. First, there will often be no actual product as prior art, which will of necessity modify all law tied to the existence of a product in the infringement context. Second, when considering infringement, the patent owner has the motivation to prove that the accused product falls within the scope of the claims. The opposite is true for anticipation. This will affect the assigned burdens of proof.

For example, in the context of infringement, it is the *accused product* that determines the characteristics of the “ordinary observer”.<sup>286</sup> In the context of anticipation over a prior art patent or printed publication, there is certainly no product. Rather, a reviewing court (or the USPTO) will have to determine a product from the paper prior art. Likewise, there will be little opportunity to present marketplace evidence (such as evidence of lack of actual confusion).

The ordinary observer’s knowledge of prior art also becomes interesting in the context of anticipation. In the infringement context, the existence of prior art with similar features to the claimed design lessens the likelihood of infringement, and thus the burden is on the accused infringer to provide that prior art. In the context of anticipation, the existence of similar prior art would make anticipation *less* likely. Thus, somewhat perversely, it could be in the patent owner’s interest to show that there are multiple close references, not just one. This should place the burden on the patent owner, not the accused infringer, to bring forth other sources of prior art.

A similarly counterintuitive consequence occurs in the consideration of functional elements. In the infringement context, the presence of functional elements in the claimed design forces the patent owner to prove that deception in the *Gorham* sense is caused by the ornamental features, not the functional features. If we apply this doctrine directly to anticipation, swapping the “accused product” for the prior art, then the presence of claimed, functional elements would make the proof of anticipation more difficult. An accused infringer would need to prove that deception in the *Gorham* sense is derived from the ornamental aspects of the design. This would give the patent owner an incentive to argue that its own design is functional for elements identically found in the prior art.

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<sup>285</sup> *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009).

<sup>286</sup> See §II.B.1, *supra*.

## D. Obviousness

Like a utility patent, a design patent must satisfy 35 U.S.C. § 103.<sup>287</sup> As explained in *Litton Systems, Inc. v. Whirlpool Corporation*, the general approach in determining obviousness is similar to that of a utility patent:

“Accordingly, 35 U.S.C. § 103 (and all the case law interpreting that statute) applies with equal force to a determination of the obviousness of either a design or a utility patent. Section 103 prohibits a patent from issuing when the ‘differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made \* \* \*.’ As in any analysis of the obviousness issue, we must consider the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art at the time the invention was made. [citation omitted]. In addition, so-called secondary considerations, such as commercial success, are relevant.”<sup>288</sup>

As will be seen in the following sections, however, the approach to evaluating obviousness of design patents is not identical to the approach with utility patents. Rather, obviousness in the context of design patents is based on “factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the Graham factors.”<sup>289</sup>

### 1. The *Durling* Test For Obviousness

The beginnings of the modern analysis of obviousness were formed by the CCPA near the end of that court’s tenure. There were two principal cases: *In re Nalbandian*<sup>290</sup> and *In re Rosen*.<sup>291</sup>

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<sup>287</sup> See *Walter E. Durling v. Spectrum Furniture Company, Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996) (“To obtain such a [design] patent, however, one must satisfy the patentability requirement of 35 U.S.C. § 103 (1994).”).

<sup>288</sup> *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423, 1441 (Fed. Cir. 1984).

<sup>289</sup> *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).

<sup>290</sup> 661 F.2d 1214 (CCPA 1981).

<sup>291</sup> 673 F.2d 388 (CCPA 1982).

(a) The Person Of Ordinary Skill: The Ordinary Designer

In *Nalbandian*, the CCPA reversed its prior precedent, holding that the correct perspective to apply in determining obviousness was that of the “ordinary designer”. The “ordinary designer” is different from the “ordinary observer” applied in the infringement and anticipation contexts.<sup>292</sup> In the words of the *Nalbandian* court:

“In *In re Laverne*, 53 CCPA 1158, 356 F.2d 1003, 148 USPQ 674 (1966), this court specifically rejected the interpretation generally given to the statutory language ‘one of ordinary skill in the art’ as referring to a designer.... Since the *Laverne* decision, the Second, Third, Tenth and District of Columbia circuits have specifically considered the ‘ordinary observer’ test set forth therein and rejected it. These circuits continue to interpret ‘one of ordinary skill’ as requiring obviousness to be tested from the viewpoint of the ‘ordinary designer.’... We believe it is appropriate to close this schism. Accordingly, with this case we hold that the test of *Laverne* will no longer be followed. In design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application.”<sup>293</sup>

In so holding, the *Nalbandian* majority noted a “problem of semantics”. This problem was related to the word “designer”, which implied the very work that went into creating patentable designs. In utility patent law, this would be the equivalent of defining a “person of ordinary skill” as an “*inventor* of ordinary skill”. The CCPA made clear, however, that it was not building the skill of original design into the obviousness analysis:

“The ‘ordinary designer’ means one who brings certain background and training to the problems of developing designs in a particular field, comparable to the ‘mechanic’ or ‘routinier’ in non-design arts. We do not have a name for that person in the design field other than ‘designer’ which is also the name we must use for the person who creates a patentable design.”<sup>294</sup>

As with utility patents, the “ordinary designer” is not imbued with hindsight knowledge of the design claim.<sup>295</sup>

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<sup>292</sup> See §§II.B.1 and III.C.2, *supra*.

<sup>293</sup> *In re Nalbandian*, 661 F.2d 1214, 1215-16 (CCPA 1981).

<sup>294</sup> *In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981).

<sup>295</sup> See *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993) (“In applying the law of § 103 to the particular facts pertinent to the patented design,

Judge Rich, author of the overruled *Laverne* decision and noted advocate of a strengthened design patent system, felt it appropriate in a *Nalbandian* concurrence to “say a few kind words over the corpse”.<sup>296</sup> In so doing, he noted that the application of § 103 to design patents was more or less an accident of history:

“The real problem, however, is not whether the § 103 fictitious ‘person’ is an ordinary observer or an ordinary designer but with the necessity under Title 35 of finding unobviousness in a design....When work on revision of the patent statutes began in 1950, a deliberate decision was made not to attempt any solution of the ‘controversial design problem’ but simply to retain the substance of the existing design patent statute and attack the design problem at a later date, after the new Title 35 had been enacted.... Thus it was that the patentability of designs came to be subject to the new § 103 which was written with an eye to the kinds of inventions encompassed by § 101 with no thought at all of how it might affect designs. Therefore, the design protection problem was in no way made better; perhaps it was made worse.”<sup>297</sup>

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obviousness vel non is reviewed from the viewpoint of a designer of ordinary skill or capability in the field to which the design pertains. [citation omitted]. As with utility patents, obviousness is not determined as if the designer had hindsight knowledge of the patented design.”).

<sup>296</sup> *In re Nalbandian*, 661 F.2d 1214, 1218 (CCPA 1981) (Rich, J. concurring)

<sup>297</sup> *In re Nalbandian*, 661 F.2d 1214, 1218-19 (CCPA 1981) (Rich, J. concurring); see also Statement of Hon. Giles S. Rich, U.S. Court of Appeals, Federal Circuit, Washington, DC, Attachment A, Statement of Hon. Giles S. Rich before Congress on H.R. 323, H.R. 769, H.R. 5523, , p. 21 during the hearings on *The Industrial Innovation and Technology Act: Hearings on S. 791 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary* 100th Cong., 1st Sess. 22 (1987) (“This committee will appreciate the major problem this law presents if it will attempt in its own mind to figure out how, as a court, it would go about determining that any given completed ornamental design would be unobvious to a professional designer of ordinary skill or competence as a designer or would involve ‘invention’. Add to this the many former adjudications, including those of my own court, that the so-called ‘standard of invention,’ or the more recent decisions that there must be unobviousness, is the same for ornamental design inventions as it is for all others, -- engines, chemical compounds, processes and radio circuits. The situation is, and always has been, anomalous and very difficult of administration and adjudication. Patents for designs have been difficult to obtain and more difficult to sustain and many have felt it was not worth the effort and that the protection is illusory.”).



(b) Primary Reference That Is Basically The Same As The Claimed Design.

One year later, in the case *In re Rosen*, the CCPA reined in the obviousness doctrine. They did so by requiring that, for a combination to render the design patent claim obvious, a primary reference be provided that is “basically the same as” the patented design. In the words of the court:

“In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence—not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature,... [Emphasis added.] Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.”<sup>298</sup>

The primary reference must *not* fall within the claim scope under the ordinary observer test—otherwise it would anticipate the claim.<sup>299</sup> This seems to leave a range of designs that could qualify as primary references if they are different enough, but not too different.

To qualify as a primary reference, it is not sufficient for the reference to show an article of the same category. Rather, the article must convey basically the same distinctive visual appearance.<sup>300</sup> In *Apple, Inc., v. Samsung Electronics Co., Ltd.*, for example, the Federal Circuit held that tablet computer prior art could not serve as a primary reference although it had features common to many tablets:

“Fidler does not qualify as a primary reference simply by disclosing a rectangular tablet with four evenly rounded corners and a flat back. [citation omitted] Rather than looking to the

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<sup>298</sup> *In re Leon Rosen*, 673 F.2d 388, 391 (CCPA 1982).

<sup>299</sup> See §III.C, *supra*.

<sup>300</sup> *But see In re Carter*, 673 F.2d 1378, 1380 (CCPA 1982) (“The Carter and Geissmann references are both directed to infant garments of the same general type as appellant’s, namely, a combined shirt and nether garment of simple lines. Either reference would satisfy the Rosen requirement of an ornamental design basically the same as the claimed design. The design characteristics of these garments essentially lie in their shapes as they are without added decorative features.”).

‘general concept’ of a tablet, the district court should have focused on the distinctive ‘visual appearances’ of the reference and the claimed design. [citation omitted] When those visual impressions are compared, it becomes apparent that the Fidler reference, with or without the TC1000, cannot serve to render the D’889 patent invalid for obviousness.”<sup>301</sup>

(c) The *Durling* Test Synthesized

After *Nalbandian* and *Rosen*, the test for obviousness was synthesized by the Federal Circuit in *Durling v. Spectrum Furniture Company, Inc.*,<sup>302</sup> thereby becoming known as “the *Durling* test”. The *Durling* court articulated the test as follows:

“In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved [citations omitted]. More specifically, the inquiry is whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. [citations omitted]. Before one can begin to combine prior art designs, however, one must find a single reference, ‘a something in existence, the design characteristics of which are basically the same as the claimed design.’ [citations omitted]. Once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. [citations omitted]. These secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’ [citations omitted].”<sup>303</sup>

In other words, with *Durling*, obviousness based on a combination of references required:

- a primary reference that is “basically the same as” the claimed design;
- an assessment of whether a designer (“routinier”) of ordinary skill would have modified the primary reference (with or without secondary references);

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<sup>301</sup> *Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1332 (Fed. Cir. 2012).

<sup>302</sup> 101 F.3d 100 (Fed. Cir. 1996).

<sup>303</sup> *Walter E. Durling v. Spectrum Furniture Company, Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996); *see also Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1329-30 (Fed. Cir. 2012).

- if used, secondary references that are so related to the primary reference that the appearance of features of one suggest application of those features to another; and
- consideration of other *Graham* factors, such as objective evidence of (non-) obviousness.

(d) The Role Of The Ordinary Observer (Versus That Of The Ordinary Designer)

The Federal Circuit tweaked the test again in 2009 in the *International Seaway*<sup>304</sup> case. There, the court clarified that the perspective of the “ordinary designer” was used only to determine whether references should be combined. Once combined, however, the combination must be judged against the design patent claim using the ordinary observer test:

“For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art.”<sup>305</sup>

2. Reasons For Combining References

As with utility patents, finding all features of a design claim in separate prior art references does not invalidate the design claim. As stated by the Federal Circuit in *L.A. Gear, Inc. v. Thom McAn Shoe Company*:

“A reconstruction of known elements does not invalidate a design patent, absent some basis whereby a designer of ordinary skill would be led to create this particular design. The district court concluded that there was no teaching or suggestion in the prior art of the appearance of the claimed design as a visual whole. We discern no error in this conclusion or the premises on which it rests.”<sup>306</sup>

The concept of a “reason” to combine references is somewhat more difficult to grasp in a design patent context than a utility patent context. For utility patents, there are often functional considerations the lead directly to the conclusion that two references would have been obvious to

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<sup>304</sup> 589 F.3d 1233 (Fed. Cir. 2009).

<sup>305</sup> *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1241 (Fed. Cir. 2009).

<sup>306</sup> *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

combine. For designs, however, the considerations are often less effable. The Federal Circuit's test in *Durling* reflects this:

“These secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’”<sup>307</sup>

The requirement that secondary references be “so related to the primary reference that the appearance of features of one suggest application of those features to another” arose in the CCPA's case *In re Glavas*.<sup>308</sup> There, the condition was seen as a formulation of the analogous art test,<sup>309</sup> and might have been best viewed as a *necessary* condition for the combination, but not a *sufficient* one. More recently, however, the condition has taken on the character of a reason to combine secondary references with the primary references. For example, the CCPA held in the case *In re Carter* that:

“The examiner's selection of the Carter design as the basic reference was appropriate inasmuch as the shape of the elongated shirt, neck, sleeves and opening placket is nearly identical to the shape of these features in appellant's design. The main difference of appellant's design from Carter's is the shape of the flap or nether portion. The Geissmann design, however, is clearly so closely related that the adoption of features therein for modification of the Carter design would be readily suggested. Thus, we believe that it would have been obvious to one of ordinary skill in the art of designing such garments to modify the Carter design by adopting the tapered shape of Geissmann, without hindsight of appellant's design. Appellant relies on no aesthetic differences which would make it not obvious to do so.”<sup>310</sup>

The *Carter*-like treatment of analogous art as reason to combine held sway. The Federal Circuit went so far as to equate the *Glavas* test for non-analogous art with a suggestion to combine secondary and primary references in the case *In re Borden*. In the words of the court:

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<sup>307</sup> *Walter E. Durling v. Spectrum Furniture Company, Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996); *see also Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1329-30 (Fed. Cir. 2012).

<sup>308</sup> 230 F.2d 447 (CCPA 1956).

<sup>309</sup> *See In re Glavas*, 230 F.2d 447, 450 (CCPA 1956) (“The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”).

<sup>310</sup> *In re Carter*, 673 F.2d 1378, 1380 (CCPA 1982).

“In order for secondary references to be considered, however, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. [citations omitted] That is, the teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.’”<sup>311</sup>

The question of “relation to the primary reference” sets up a mini visual comparison with between the primary and secondary references. Consider the court’s reasoning in *Apple, Inc., v. Samsung Electronics Co., Ltd.*:

“Even assuming that Fidler qualified as a primary reference, the TC1000 secondary reference could not bridge the gap between Fidler and the D’889 design. First, while the TC1000 has a flat glass front, the screen area of that device is surrounded by a gray area that frames the screen. In addition, the perimeter of the TC1000 is encircled by a wide rounded-over metallic rim. And the screen area contains indicator lights in several places, unlike the minimalist design claimed in the D’889 patent. ‘[T]he teachings of prior art designs may be combined only when the designs are ‘so related that the appearance of certain ornamental features in one [design] would suggest the application of those features to the other.’” [citation omitted] The TC1000 is so different in visual appearance from the Fidler reference that it does not qualify as a comparison reference under that standard.”<sup>312</sup>

There is currently some question as to whether the Supreme Court’s decision in *KSR v. Teleflex* applies in the context of design patent obviousness analysis.<sup>313</sup> To the extent that prior decisions required a strict teaching, suggestion or motivation to combine references, there would

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<sup>311</sup> *In re Borden*, 90 F.3d 1570, 1574-75 (Fed. Cir. 1996) (emphasis added).

<sup>312</sup> *Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1331 (Fed. Cir. 2012).

<sup>313</sup> See *Titan Tire Corporation v. The Goodyear Tire & Rubber Company*, 566 F.3d 1372, 1384-85 (Fed. Cir. 2009); *Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 19 (N.D. Cal. Dec. 2, 2011) (“It appears to be an open question whether the obviousness test in *Durling* was altered by the Federal Circuit’s abandonment of the “point of novelty test” in *Egyptian Goddess*, and whether the Supreme Court’s decision in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), has any effect on the application of the *Durling* analysis. See *Titan Tire*, 566 F.3d at 1384 (recognizing that ‘it is not clear to what extent, if any, the doctrine applicable to obviousness should be modified to conform to the approach adopted by this court in *Egyptian Goddess*’ and that the application of *KSR* to design patents is ‘new and untested ground’). Despite these reservations, there are several reasons to apply the *Durling* test here.”).

seem to be good reason to apply *KSR*. However, the specific scenarios provided by *KSR* involve the concept of “predictability”,<sup>314</sup> which is not readily transferable to ornamental qualities.

This provokes a question: can references be combined or not combined based on functional considerations? The *Durling* test suggests not, because it requires “the *appearance* of certain ornamental features in one would suggest the application of those features to the other”.<sup>315</sup> Indeed, it is difficult at first to imagine how a functional motivation could render an ornamental feature obvious. One would presumably have to conclude that a primary reference lacks at least one functional and at least one ornamental feature, that the missing features are found in a secondary reference, that the functional advantage motivates combination, and that the ornamental feature “comes along for the ride”. Such a finding would have to be squared with the principle that “[a] finding of obviousness cannot be made without determining whether the invalidating prior art shows or renders obvious the ornamental features of the claimed design.”<sup>316</sup>

Functional considerations have, however, been taken into account by the Federal Circuit as *teachings away* from combination. For example, in the case *In re Haruna*, the court held:

“The Board determined that the teachings of Benne combined with the general knowledge that conventional disks have a narrow transparent region at their rims renders the claimed design obvious. However, this determination ignores the teachings in Benne that discourage a disk with the claimed design. As discussed above, the object of Benne is to conceal manufacturing defects in the outer zone of disks. [citation omitted]. Benne achieves this object by treating the surface of the outer zone to provide a matte finish, or a colored surface, or a pattern, or a combination thereof. [citation omitted]. Broadening the transparent region of conventional disks would defeat the purpose of Benne, because providing a transparent region would not conceal any defects, and would result in a large region in which any defects would be readily apparent. Thus, Benne teaches away from the claimed design”<sup>317</sup>

In advocating or finding obviousness, it is important for the accused infringer, court or USPTO to articulate the reasons to modify the primary reference.<sup>318</sup> That this may require

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<sup>314</sup> See, e.g., MPEP § 2143 (Ed. 8, Rev. 6, Sept. 2007).

<sup>315</sup> *Walter E. Durling v. Spectrum Furniture Company, Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996); see also *Apple, Inc., v. Samsung Electronics Co., Ltd.*, 678 F.3d 1314, 1329-30 (Fed. Cir. 2012).

<sup>316</sup> *Rosco, Inc. v. Mirror Lite Company*, 304 F.3d 1373, 1379 (Fed. Cir. 2002).

<sup>317</sup> *In re Tsutomu Haruna*, 249 F.3d 1327, 1335-36 (Fed. Cir. 2001).

<sup>318</sup> See, e.g., *Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 23-24 (N.D. Cal. Dec. 2, 2011) (“[I]t is not clear from Sherman’s declaration why it

something akin to a verbal claim construction—otherwise disfavored—is of no moment. As the *en banc* Federal Circuit explained in *Egyptian Goddess*:

“This court has required that in determining obviousness, a district court must attempt to ‘translate [the] visual descriptions into words’ in order to communicate the reasoning behind the court’s decision and to enable ‘the parties and appellate courts . . . to discern the internal reasoning employed by the trial court.’ [citation omitted]. Requiring such an explanation of a legal ruling as to invalidity is quite different from requiring an elaborate verbal claim construction to guide the finder of fact in conducting the infringement inquiry.”<sup>319</sup>

### 3. Analogous Art

The analogous art doctrine applies in design patent law. The scope of analogous art was articulated in the Federal Circuit’s decision in *Hupp v. Siroflex of America, Inc.*, as:

“[N]ot the universe of abstract design and artistic creativity, but designs of the same article of manufacture or of articles sufficiently similar that a person of ordinary skill would look to such articles for their designs.”<sup>320</sup>

It is worth noting that the *Hupp* formulation of analogous art does not exclude utility patents from the scope of prior art—these are most certainly used in obviousness contexts.<sup>321</sup> Rather *Hupp* states only that the utility patent must disclose a design. This is usually accomplished through the utility patent drawings.

The analogous art doctrine has a somewhat different role to play in design patent law than in utility patent law. In utility patent law, the analogous art doctrine serves as one constraint on the otherwise superhuman ability of the person of ordinary skill to recall prior art. In design patent law, however, that same function is also arguably fulfilled by the requirement to show a primary reference that is “basically the same as” the claimed design,<sup>322</sup> and secondary references

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would have been an obvious choice to import the prior art references from the tablet context into the cell phone field. It is possible that it would have been obvious to a designer skilled in the art to incorporate tablet-like screens into cell phone designs, but without more explanation or reasoning behind this decision, Samsung has not met its burden.”).

<sup>319</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 n.1 (Fed. Cir. 2008) (*en banc*).

<sup>320</sup> *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997).

<sup>321</sup> *See In re Aslanian*, 590 F.2d 911, 913 (CCPA 1979).

<sup>322</sup> *See* §III.D.1(b), *supra*.

that are “so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.”<sup>323</sup> Indeed, the latter principle was originally intended as a statement of the non-analogous art doctrine.<sup>324</sup> Under these pre-existing constraints, the analogous art doctrine essentially prevents only the application of prior art references, outside related articles of manufacture, that have coincidentally adopted a form quite similar to the claimed design.

#### 4. Objective Evidence Of Obviousness *Vel Non*

As noted above, objective considerations of non-obviousness apply in the design patent context.<sup>325</sup> There are, however, some natural differences from the use of objective evidence in utility patent law. First, because there is no protection for functional aspects of a claimed design, objective evidence relating to function is irrelevant. So one would not, for example, attempt to prove unexpected results flowing from a design, nor is a “long-felt need” likely to be present in all but the oddest of circumstances. Rather, objective evidence is far more likely to be related to commercial success, praise and copying.<sup>326</sup>

Second, the doctrine of nexus will require a causal relationship between the *ornamental* features of the claimed design and the commercial success, praise, and copying of products implementing the design. As stated by the Federal Circuit in *Litton Systems, Inc. v. Whirlpool Corporation*:

“[C]ommercial success, while relevant as showing the nonobviousness of an invention, presents a special difficulty in a design patent case. To be of value, evidence of commercial success must clearly establish that the commercial success is attributable to the design, and not to some other factor, such as a better recognized brand name or improved function. Although the Litton oven did meet with good commercial success, there is no evidence attributing this success to the Litton design. Thus, the evidence of commercial success is of no help to Litton in this case.”<sup>327</sup>

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<sup>323</sup> See §III.D.1(c), *supra*.

<sup>324</sup> See *In re Glavas*, 230 F.2d 447, 450 (CCPA 1956) (“The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.”).

<sup>325</sup> See §III.D, *supra*; see also *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

<sup>326</sup> See, e.g., *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed. Cir. 1993).

<sup>327</sup> *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423, 1443 (Fed. Cir. 1984).



## E. 35 U.S.C. § 112

“Design patents must comply with the requirements of 35 U.S.C. § 112”<sup>328</sup> When evaluating the claims for compliance with § 112, the viewpoint of the ordinary designer is applied.<sup>329</sup>

Because there is very little written description in a design patent, the usual problems have to do with enablement and indefiniteness. Moreover, because the majority of the disclosure in a design patent forms a part of the claim, the enablement and indefiniteness requirements are often interchangeable. That is, where the drawings contain a sufficiently serious inconsistency, the claim will be indefinite and also not enabled. For example, the MPEP states:

“[S]ince the drawing disclosure and any narrative description in the specification are incorporated into the claim by the use of the language ‘as shown and described,’ any determination of the scope of protection sought by the claim is also a determination of the subject matter that must be enabled by the disclosure. Hence, if the appearance and shape or configuration of the design for which protection is sought cannot be determined or understood due to an inadequate visual disclosure, then the claim, which incorporates the visual disclosure, fails to particularly point out and distinctly claim the subject matter applicant regards as their invention, in violation of the second paragraph of 35 U.S.C. 112. Furthermore, such disclosure fails to enable a designer of ordinary skill in the art to make an article having the shape and appearance of the design for which protection is sought.”<sup>330</sup>

One common application of § 112 in design cases occurs where several inconsistent drawings are presented. It is not *per se* improper to claim multiple embodiments of an overall design in a single application. It is, however, improper to claim more than one design. As the Federal Circuit explained in *Antonious v. Spalding & Evenflo Companies., Inc.*:

“A design patent may disclose more than one embodiment of a design. See *In re Rubinfield*, 47 CCPA 701, 270 F.2d 391, 395, 123 U.S.P.Q. (BNA) 210, 214 (CCPA 1959) (‘We are of the

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<sup>328</sup> *Antonious v. Spalding & Evenflo Companies., Inc.*, 1999 U.S. App. LEXIS 22984, \*20 (Fed. Cir. 1999).

<sup>329</sup> See *Shop\*TV, Inc., v. Bed Bath & Beyond, Inc.*, Case No. 09-cv-00057-REB-CBS, Slip Op. at 12 (D.Co. Jan. 19, 2010) (“As the claimed specific volumetric capacity of the containers cannot be implemented and the scope of the D’219 patent claim cannot be determined by those having ordinary skill in the art, the court concludes that the D’219 patent claim is invalid as indefinite.”).

<sup>330</sup> MPEP § 1504.04 (Ed. 8, Rev. 5, Aug. 2006).

opinion that it cannot be stated as an invariable rule that a design application cannot disclose more than one embodiment of the design. Whether such disclosure is improper must depend upon the particular circumstances of the individual case involved.’); see also *In re Klein*, 987 F.2d 1569, 1570 n.1, 26 U.S.P.Q.2D (BNA) 1133, 1134 n.1 (Fed. Cir. 1993) (‘The drawings depict three slight variations on a single basic design. . . . No objection has been made to this not uncommon practice.’). The primary validity issue here, then, is whether the ‘056 and ‘308 patents each disclose one embodiment of one design, more than one embodiment of one design, or more than one design. As we discuss below, we are satisfied that the figures in each patent do not disclose more than one design. Therefore, the patents are not invalid for being indefinite.”<sup>331</sup>

In specific instances, written disclosure in the design patent can conflict with, or other render indefinite the drawings. For example, in *Shop\*TV, Inc., v. Bed Bath & Beyond, Inc.*, the design patent limited the claim to “containers of specific configuration and volumetric capacity”. Holding the claim indefinite, the district court reasoned:

“The D’219 patent consists of figures and a written description that limits the scope of the claimed design to ‘containers of specific configuration and volumetric capacity.’ The court has construed the D’219 patent as ‘[t]he design for a travel kit, used as a transparent, sealable receptacle for the included containers of specific configuration and volumetric capacity, as demonstrated in Figures 1 through 7.’” [citation omitted]. On its face, the D’219 patent is indefinite as to the meaning of ‘specific volumetric capacity.’ The D’219 patent does not set forth the ‘volumetric capacity’ of the containers described in Figures 1 through 7.”<sup>332</sup>

## F. Double Patenting

A design patent can be subject to double patenting invalidity.<sup>333</sup> As with utility patents and applications, a terminal disclaimer can be used to avoid obviousness-type double patenting.<sup>334</sup>

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<sup>331</sup> *Antonious v. Spalding & Evenflo Companies., Inc.*, 1999 U.S. App. LEXIS 22984, \*22-23 (Fed. Cir. 1999).

<sup>332</sup> *Shop\*TV, Inc., v. Bed Bath & Beyond, Inc.*, Case No. 09-cv-00057-REB-CBS, Slip Op. at 11 (D.Co. Jan. 19, 2010).

<sup>333</sup> See *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 628 (Fed. Cir. 1984).

<sup>334</sup> See MPEP § 1504.06.II; *In re Geiger*, 425 F.2d 1276, 1280 (CCPA 1970).

There are a few special considerations for design patent double patenting. The CCPA explained some of these in the case *In re Geiger*:

“In the area of double patenting, design patents present somewhat unique problems. The boundaries of the protection defined by the claims are not discernible by a reading of the claims alone. A visual analysis of the drawings is required. Thus, any standard ‘test’ as to whether the same subject matter is being claimed would be inappropriate. [citations omitted] Design patent claims are inextricably and directly related to the specific illustration shown in the drawings. In this case, as pointed out by the board, ‘the claims and the disclosures are commensurate.’ We think it reasonable and necessary, therefore, to conclude that the subject matter claimed in the application before us is not identical to the subject matter claimed in the patent. Having reached this conclusion, it follows that the Patent Office was in error in not recognizing the effect of the terminal disclaimer and the decision of the Board of Appeals must be reversed.”<sup>335</sup>

The question of whether the one-way test or two-way test for double patenting is applied is addressed in the same way it is for utility patents.<sup>336</sup>

A special issue occurs where double patenting is asserted between a design and a utility patent. Although awkward, this situation is possible, but “there is a heavy burden of proof on one seeking to show double patenting. Double patenting is rare in the context of utility versus design patents.”<sup>337</sup> The CCPA explained in *Carman Industries, Inc. v. Eugene A. Wahl*:

“As a matter of legal theory, double patenting between a design and a utility patent presents significant problems. Judicial and scholarly criticism has been leveled at the concept of applying double patenting between a design and a utility patent. Design and utility patents are based on different statutory provisions and involve different subject matter. The scope of protection afforded by each type of patent is different. It has been asserted that these differences entirely obviate double patenting in the design-utility setting. However, there exists CCPA precedent to the effect that a double patenting rejection of a pending design or utility patent

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<sup>335</sup> *In re Geiger*, 425 F.2d 1276, 1280 (CCPA 1970).

<sup>336</sup> See MPEP § 1504.06 (Ed. 8, Rev. 5, Aug. 2006).

<sup>337</sup> *Carman Industries, Inc. v. Eugene A. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983).

application can be sustained on the basis of a previously issued utility or design patent, respectively.”<sup>338</sup>

Where a design-utility double patenting challenge is made, the claims must cross-read under an obviousness standard. The *Carmen* court explained:

“[D]ouble patenting will be found in a design/utility situation if the two patents cross-read. Further, the precedent of this court supports a broader test of double patenting, encompassing the double patenting of obvious variations as well as of the same invention. However, rather than focusing on the point of novelty, we wish to clarify that double patenting is determined by analysis of the claims as a whole.”<sup>339</sup>

As emphasized in the MPEP, the double patenting rejection looks at the claim scope.<sup>340</sup> In a design-utility situation, this involves a comparison of the design claim with the utility patent claim, not the utility patent drawings.

#### **IV. Remedies**

Design patents offer a wider array of remedies for infringement than do utility patents. Equitable remedies are as available for design patents as they are for utility patents.<sup>341</sup> However, design patents have an additional economic remedy for infringement in 35 U.S.C. § 289, which allows for the recovery of the infringer’s total profit.

##### **A. Damages**

###### **1. 35 U.S.C. §§ 284 and 289**

There are two sections in title 35 relating to money damages. Section 289 is available only to owners of infringed design patents. Section 284 is the portion of title 35 governing damages for infringement of utility patents. However, “[a] design patentee may recover damages under 35 U.S.C. § 284 or under 35 U.S.C. § 289.”<sup>342</sup> This is because § 171 makes “provisions of this title relating to patents for inventions” applicable to designs, and because

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<sup>338</sup> *Carman Industries, Inc. v. Eugene A. Wahl*, 724 F.2d 932, 938-39 (Fed. Cir. 1983); see also *In re Thorington*, 418 F.2d 528, 532-33 (CCPA 1969).

<sup>339</sup> *Carman Industries, Inc. v. Eugene A. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983); see also *In re Anita Dembiczak*, 175 F.3d 994, 1002 (Fed. Cir. 1999).

<sup>340</sup> See MPEP § 1504.06 (Ed. 8, Rev. 6, Aug. 2006).

<sup>341</sup> See *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240 (Fed. Cir. 1986).

<sup>342</sup> *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1290 (Fed. Cir. 2002).

§ 289 states that “[n]othing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title”. A double recovery (e.g. under both sections) is prohibited,<sup>343</sup> because § 289 states that the patent owner “shall not twice recover the profit made from the infringement.”<sup>344</sup>

## 2. Infringer Profits Under 35 U.S.C. § 289.

Section 289 reads:

“Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$ 250, recoverable in any United States district court having jurisdiction of the parties. Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.”<sup>345</sup>

If the conditions of 35 U.S.C. § 289 are met, the design patent owner is entitled to collect damages “to the extent [of the infringer’s] total profit.” This is notably different from a “lost profits” remedy under § 284. Lost profits under § 284 focus on the *patent owner’s* profits,<sup>346</sup> and are limited to those which have been lost due to infringement.<sup>347</sup> Under § 289, in contrast, it is the *infringer’s* profit that is recoverable.<sup>348</sup> This recovery is not subject to proof of what would

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<sup>343</sup> See *Braun Inc. v. Dynamics Corporation of America*, 975 F.2d 815, 824 n.16 (Fed. Cir. 1992).

<sup>344</sup> 35 U.S.C. § 289.

<sup>345</sup> 35 U.S.C. § 289.

<sup>346</sup> See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1442 (Fed. Cir. 1998) (“[I]n *Aro Mfg. Co. v. Convertible Top Co.*, 377 U.S. 476, 507, 141 U.S.P.Q. (BNA) 681, 694, 12 L. Ed. 2d 457, 84 S. Ct. 1526 (1964)...[t]he Court interpreted § 284 as meaning that only the patentee’s losses can be recovered, ‘without regard to the question whether the defendant has gained or lost by his unlawful acts,’ thus removing the equitable remedy of the infringer’s profits from recovery under § 284.”)

<sup>347</sup> See *Central Soya Co. Inc. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1578-79 (Fed. Cir. 1983).

<sup>348</sup> See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1443 (Fed. Cir. 1998) (“The additional remedy created in 1887 for design patents was enacted to overcome the allocation

have been recovered but for infringement (an endeavor that might be criticized for speculation), but rather only to proof of revenue and costs. There is no requirement of willfulness or other scienter to recovery total profits.<sup>349</sup>

(a) No Requirement To Apportion Infringer's Total Profit

Furthermore, in sharp contrast to § 284, the infringer's total profit under § 289 is not apportioned.<sup>350</sup> This means that the patent owner does not need to prove that the design drove a specific percentage of the profit, as opposed to other features. This removes a significant obstacle that often lowers utility patent damage awards. The reason for the lack of apportionment was explained by the Federal Circuit in *Nike, Inc. v. Wal-Mart Stores, Inc.*:

“Apportionment presented particularly difficult problems of proof for design patentees, for the patentee was required to show what portion of the infringer's profit, or of his own lost profit, was due to the design and what portion was due to the article itself. A series of cases involving carpet designs brought matters to a head, leading to the separate remedy for design patent infringement. The cases involved the Dobson brothers, who were found to have infringed patented designs for carpets. The Supreme Court held that the Dobsons were liable for no more than ‘nominal damages’ of six cents because the patentees could not show what portion of their losses or the infringers’ profits was due to the patented design and what portion was due to the unpatented carpet. [citations omitted]. Legislative remedy, specific to design patents, soon followed...[A House Report on the legislation] explained that ‘it is expedient that the infringer's entire profit on the article should be recoverable,’ for ‘it is not apportionable,’ and ‘it is the design that sells the article.’ [citation omitted]. The Report drew analogy to

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problem for designs, and did not deplete the remedies available for either utility or design patent infringement. Further, the general damages statutes, which authorized recovery of the infringer's profits as well as the patentee's losses, continued in effect for both utility and design patents. Indeed, whether it was the 1946 or 1952 Act or the decision in *Aro Manufacturing* that eliminated recovery of infringer's profits in utility patent infringement, this remedy for design patents was unaffected.”).

<sup>349</sup> See *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1290 (Fed. Cir. 2002) (“The present version of § 289, which has been in effect since 1952, has no such ‘knowing’ requirement. *Lamps Plus* is therefore entitled to damages for *Catalina*'s infringement.”).

<sup>350</sup> See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998) (“The Act of 1887, specific to design patents, removed the apportionment requirement when recovery of the infringer's profit was sought...”); *Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: 11-CV-01846-LHK, Slip Op. at 9 (N.D. Cal. June 29, 2012).

trademark law, and ‘the good will the design has in the market.’ [citation omitted]. The Act of 1887, specific to design patents, removed the apportionment requirement when recovery of the infringer’s profit was sought....”<sup>351</sup>

(b) Accounting Of Infringer’s Profits.

The determination of the infringer’s total profit can be challenging, especially in a large and complex business that may not account for the profit attributable for each product. In general, some accounting method will have to be applied. This choice is made by the district court, and is reviewed for abuse of discretion.<sup>352</sup> The burden of proving revenue (usually using information discovered from the infringer) is likely to be allocated to the patent owner, whereas the burden of proving costs subtractable from revenue is likely to be allocated to the infringer.<sup>353</sup>

In *Nike, Inc. v. Wal-Mart Stores, Inc.*, the Federal Circuit confirmed the “total profit” language of § 289, in reviewing whether profit should be pre- or post- tax. In the words of the court:

“Nike points out that an award of only the infringers’ post-tax profits would leave the appellants in possession of their tax refunds, and that if the appellants still enjoy a profit the award can not be their ‘total profits’ as mandated by the statute. [citation omitted] The district court agreed with that position, as do we. The statute requires the disgorgement of the infringers’ profits to the patent holder, such that the infringers retain no profit from their wrong.”<sup>354</sup>

3. Interaction Between §§ 284 and 289.

Notably, section 289 states that “[n]othing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title.” This allows the design patent owner to pursue remedies under § 284. However, § 289 also limits such recovery, because the owner “shall not twice recover the profit made from the infringement.” This has led the Federal Circuit to conclude that a design patent owner cannot be awarded damages under § 284, if it has already been awarded the infringer’s profit under § 289

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<sup>351</sup> *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998).

<sup>352</sup> *See Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1447 (Fed. Cir. 1998) (“We review whether the district court’s methodology was an abuse of discretion and whether the district court’s factual findings were clearly erroneous.”).

<sup>353</sup> *See Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1447 (Fed. Cir. 1998)

<sup>354</sup> *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1447 (Fed. Cir. 1998).

for the same infringement. As stated by the Federal Circuit in *Catalina Lighting, Inc. v. Lamps Plus, Inc.*:

“When only a design patent is at issue, a patentee may not recover both infringer profits and additional damages under § 284. The last paragraph of § 289 states: Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement. 35 U.S.C. § 289 (1994) (emphasis added). ‘The purpose of this latter phrase is to insure that a patentee not recover both the profit of an infringer and some additional damage remedy from the same infringer, such as a reasonable royalty.’ [citations omitted].”<sup>355</sup>

A separate question arises when there is more than one design patent, or a design patent and a utility patent. In *Catalina Lighting*, the Federal Circuit held that the recovery of the infringer’s total profit under § 289 counted against any recovery under § 284, effectively disallowing separate recovery for the infringement of separate patents, where the infringer’s total profit under § 289 is greater than § 284 damages. The *Catalina Lighting* court reasoned as follows:

“Each sale constitutes an infringement of the '141 utility patent ...Likewise, the same sale constitutes an infringement of the '904 design patent....Lamps Plus is entitled to damages for each infringement, but once it receives profits under § 289 for each sale, Lamps Plus is not entitled to a further recovery from the same sale because the award of infringer profits under § 289 also constitutes ‘damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer.’ [citation omitted]. The reasonable royalty in this case was determined to be \$ 660,000, the minimum amount that Lamps Plus is entitled to receive under § 284. We have also determined that Lamps Plus can recover infringer profits of \$ 767,942, which is more than the reasonable royalty sought by Lamps Plus under § 284. Thus, the recovery of infringer profits resulting from the single act of selling lamps satisfies Lamps Plus’ entitlement under § 289 and more than satisfies its entitlement under § 284. [citation omitted] We therefore reverse the award of damages in the amount of \$ 758,275.37, based on a reasonable royalty plus prejudgment interest, and affirm the award of damages of infringer profits plus prejudgment interest in the amount of \$

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<sup>355</sup> *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1291 (Fed. Cir. 2002).



316,223.92 against Catalina and \$ 562,090.49 against Home Depot.”<sup>356</sup>

#### 4. The Marking Requirement For Design Patents.

The marking requirement of 35 U.S.C. § 287 is applicable to design patents, even when recovery is elected under § 289.<sup>357</sup> In *Nike, Inc. v. Wal-Mart Stores, Inc.*, the Federal Circuit reasoned that the use of the term “damages” in § 287 did not limit the marking requirement to recovery under § 284:

“We conclude that the term ‘damages’ as it appears in the marking statute is not limited to the recovery at law from which it arose, but includes recovery measured by the infringer’s profits, and continues to be so used although such recovery is now limited to design patent infringement. The statutory history establishes that the marking requirement has always applied, and continues to apply, to both recovery of the infringer’s profit under § 289, and recovery of damages, however measured, under § 284.”<sup>358</sup>

#### 5. Willful Infringement And Enhanced Damages Under § 289.

Section 284 allows a court to treble damages in cases of willful infringement. No such text is found in § 289. Section 289 also prevents the recovery of “twice” the infringer’s profit. This has led the Federal Circuit to hold that enhanced damages for willful infringement are not available if a design patent owner elects to recover the infringer’s profit under § 289. In *Braun Inc. v. Dynamics Corporation of America*, the court held:

“Assuming arguendo that there is substantial evidence that Waring willfully infringed Braun’s design, the district court nevertheless erroneously awarded Braun three times Waring’s total profit. Braun elected to recover Waring’s total profits under 35 U.S.C. § 289, not 35 U.S.C. § 284, which provides that a patentee may recover ‘damages adequate to compensate for the infringement which the court may increase . . . up to three times.’ Nothing in 35 U.S.C. § 289 authorizes an increase in a patentee’s total profit. In fact, 35 U.S.C. § 289 explicitly precludes a patentee from ‘twice recover[ing] the profits made from the infringement.’ [citation

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<sup>356</sup> *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1291 (Fed. Cir. 2002).

<sup>357</sup> See *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998) (“Upon review of statute, legislative history, policy, and precedent, we conclude that the marking requirement, § 287(a), applies to design patents whether remedy for infringement is sought under § 284 or § 289.”).

<sup>358</sup> *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1440 (Fed. Cir. 1998).

omitted]. As a result, by trebling Waring's total profit, the district court clearly exceeded its statutory authority."<sup>359</sup>

#### 6. Exceptional Cases And Attorney Fees Where § 289 Damages Claimed

It is possible to award attorney fees in a design patent case, even where the patent owner elects to recover damages under § 289.<sup>360</sup>

#### 7. Lost Patent Owner Profits Under § 284.

A patent owner seeking its own lost profits under § 284 for design patent infringement faces a special challenge. The *Panduit* test for lost profits lays out for factors for the recovery of lost profits (not strictly required in every case) including, among other things, the absence of suitable non-infringing alternatives.<sup>361</sup> A design patent should have non-infringing alternatives for the ornamental features of the design.

### **B. Injunctive Relief.**

Injunctive relief is as available for design patents as it is for utility patents.<sup>362</sup> The design patent owner will be required to prove the same factors under *Ebay v. MercExchange*<sup>363</sup> as a utility patent owner. Notably, there is no presumption of irreparable harm resulting from the finding of infringement under the "ordinary observer" test.<sup>364</sup>

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<sup>359</sup> *Braun Inc. v. Dynamics Corporation of America*, 975 F.2d 815, 823-24 (Fed. Cir. 1992).

<sup>360</sup> *See Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1567 (Fed. Cir. 1988).

<sup>361</sup> *See Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156 (6th Cir. 1978); *See Central Soya Co. Inc. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1578-79 (Fed. Cir. 1983) ("In holding that the patentee could recover damages for infringement in the form of lost profits, the trial court said: 'Plaintiff [Central Soya] must present affirmative proof of (1) demand for the patented product in the marketplace, (2) Plaintiff's production and marketing capacity to meet the demand, (3) the absence of acceptable non-infringing substitutes and (4) detailed computations on the loss of profits.' This statement was taken in substance from *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156, 197 USPQ 726, 729-30 (6th Cir. 1978) (authority and cases cited)...FN5. We do not address whether and how Central Soya could have proven lost profits other than by the Panduit test.").

<sup>362</sup> *See Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 240 (Fed. Cir. 1986).

<sup>363</sup> *See eBay Inc. v. Mercexchange, L.L.C.*, 547 U.S. 388, 391 (2006).

<sup>364</sup> *See Apple, Inc., v. Samsung Electronics Co., Ltd.*, Case No.: II-CV-01846-LHK, Slip Op. at 29 (N.D. Cal. Dec. 2, 2011).